

Opposition No. 91161914
Answer and Counterclaim
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COUNTERCLAIM

In the matter of Opposer's cited registration, Registration No. 2,048,911 for the mark CANCUN, Applicant has learned through Opposer's recent responses to discovery requests that such registration may have been improper under Section 2(a) of the Trademark Act, and, as Applicant believes it will be damaged by the above-identified registration, therefore counterclaims to cancel such registration.

The grounds for cancellation are as follows:

1. Opposer filed for registration of the mark CANCUN upon the Principal Register in connection with tequila on February 27, 1996, was approved for publication by the examining attorney without comment, and achieved registration on April 1, 1997.
2. The primary significance of the word 'Cancun' is that of the name of a geographical location, an island off the northeastern coast of Quintana Roo, Mexico.
3. Indeed, the only meaning of the word 'Cancun' is as the name of a geographical location.
4. The geographical location of Cancun and its environs are noted by consumers as being a source of alcoholic beverages.
5. On information and belief, Opposer's adoption and use of the word 'Cancun' as a mark is based upon Cancun's reputation as a source of alcoholic beverages.

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6. On information and belief, Opposer's products are neither bottled, shipped nor distributed from Cancun, nor from anywhere on the Yucatan Peninsula.
7. On information and belief, there exists no relationship between Opposer and the geographical location of Cancun.
8. On information and belief, there exists no relationship between Opposer and the entire Yucatan Peninsula.
9. On information and belief, Opposer's CANCUN mark consists of a geographical indication which identifies a place other than the origins of its goods.
10. On information and belief, Opposer's CANCUN mark consists of matter which is deceptive and misleading to consumers.
11. If Opposer is permitted to maintain Registration No. 2,048,911, Opposer would continue to have at least a prima facie right to the use of the mark CANCUN in connection with such products. Registration No. 2,048,911 would thus be a source of damage and injury to Applicant.

WHEREFORE, Applicant prays that the Notice of Opposition be dismissed, that Registration No. 2,048,911 be canceled, and that this opposition be sustained in favor of Applicant.

BRIAN R. GIBBONS
Attorney at Law

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Respectfully submitted,

Brian Gibbons

Brian R. Gibbons
Attorney for Applicant

3/2/05
Date

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CERTIFICATE OF SERVICE

I hereby certify that a true and accurate copy of the foregoing document is being deposited with the United States Postal Service as first class mail, postage prepaid, in an envelope addressed to Carol L. B. Matthews, Holland & Knight LLP, 2099 Pennsylvania Ave. NW, Suite 100, Washington, D.C. 20037 this 2nd day of March, 2005.

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CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Commissioner for Trademarks, P.O. Box 1451, Alexandria, VA 22313-1451 on the date shown below:

By: *Brian Gibbons*

Print Name: Brian Gibbons

Date of Mailing: March 2, 2005

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BRG05-136

March 2, 2005
Via U.S. Mail

Box TTAB – Fee
Commissioner for Trademarks
P.O. Box 1451
Alexandria, VA 22313-145

Re: Opposition No. 91161914

Dear Sir or Madam:

Attached is a duplicate copy of Applicant's Answer and Counterclaim, along with a credit card authorization form for payment of the filing fee. (While Applicant is aware that duplicate filings are disfavored, this is submitted for purposes of paying the filing fee, as that is unable to be done through on-line filing.)

Should you have any questions, please do not hesitate to contact me.

Sincerely,



Brian Gibbons, Esq.

BRG/ras



03-07-2005