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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91205468
Party	Plaintiff Paleteria La Michoacana LLC
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

PALETERIA LA MICHOACANA, LLC,

Opposer,

vs.

PRODUCTOS LACTEOS TOCUMBO, S.A. DE
C.V.,

Applicant.

Opposition No. 91205468

Application No.: 85/408,561

Mark: LA MICHOACANA NATURAL
and design

**OPPOSER'S NOTICE OF NON-OPPOSITION TO APPLICANT'S MOTION TO
CONSOLIDATE AND SUSPEND PENDING INTER PARTES PROCEEDINGS**

On August 3, 2012, Applicant Productos Lacteos Tocumbo, S.A. de C.V. ("Applicant") in the above-captioned proceeding filed a motion before the Trademark Trial and Appeal Board ("TTAB") to consolidate Opposition Proceeding Nos. 91205093, 91205049, 91205466, and 91205468. Concurrently, Applicant filed a motion to suspend Opposition Proceeding Nos. 91205093 and 91205049 pending disposition of the action in United States District Court for the District of Columbia, Case No. 11-cv-01623 ("District Court Action"), in which Paleteria La Michoacana, Inc. and Opposer Paleteria La Michoacana, LLC ("Opposer") seek judicial review and reversal of the TTAB's decision to cancel U.S. Registration No. 3,210,304 in Cancellation Proceeding No. 92047438.¹ Although Applicant did not formally file a motion to suspend Opposition Proceeding Nos. 91205466 and 91205468, Applicant has requested that the Board suspend and consolidate all four pending *inter partes* proceedings in its motion papers in

¹ U.S. Registration No. 3,210,304 for the mark LA INDITA MICHOACANA with an Indian girl design was assigned by registrant Paleteria La Michoacana, Inc. to Paleteria La Michoacana, LLC during the pendency of Cancellation Proceeding No. 92047438.

Opposition Proceeding Nos. 91205093 and 91205049 and during the Board-moderated phone conference on August 6, 2012.

While Opposer disagrees with many of the untrue factual assertions and characterizations of the District Court Action contained in Applicant's motions, after reviewing the law relating to suspension and consolidation, Opposer can agree to consolidate and suspend Opposition Proceeding Nos. 91205049, 91205466, and 91205468 on the grounds that litigation over the subject marks in each of these proceedings—Opposer's LA INDITA MICHOACANA and mountain girl design mark in Proceeding No. 91205049, Applicant's LA MICHOACANA word mark in Proceeding No. 91205466, and Applicant's LA MICHOACANA NATURAL and butterfly design mark in Proceeding No. 91205468—raises a common question of whether the term MICHOACANA in each subject mark is descriptive of a certain style of ice cream products. This question will be addressed in the District Court Action, where Opposer has appealed the TTAB's finding that the LA INDITA MICHOACANA and Indian girl design mark in Registration No. 3,210,304 and Applicant's LA MICHOACANA, LA MICHOACANA NATURAL, and LA MICHOACANA NATURAL and butterfly design marks—all used in connection with ice cream—are confusingly similar in appearance, sound, meaning, and commercial impression *to the extent* that each mark contains the word "Michoacana."

With respect to Opposition Proceeding No. 91205093, which involves Opposer's LA INDITA word mark, Opposer consents to suspension and consolidation of this proceeding with Proceeding Nos. 91205049, 91205466, and 91205468 albeit on grounds different from those stated by Applicant. Contrary to Applicant's suggestion, the TTAB made no findings of fact or law in Cancellation Proceeding No. 92047438 regarding LA INDITA as a stand-alone term, unconnected to other words or designs. In fact, the TTAB stated clearly that its finding of


likelihood of confusion centered on (a) the overlapping MICHOACANA term in the LA INDITA MICHOACANA design mark and Applicant's MICHOACANA-based marks, and (b) the similarity of the designs in the LA INDITA MICHOACANA and Indian design mark and Applicant's Indian girl design mark. Therefore, the unresolved issues in the pending appeal have no effect on the registrability of Opposer's LA INDITA word mark. Suspension and consolidation of this particular proceeding with the other actions is appropriate only to the extent that Opposer has asserted compulsory cancellation counterclaims in Proceeding No. 91205093 against Applicant's registrations for its LA FLOR DE MICHOACAN and LA FLOR DE MICHOACAN and butterfly design marks, which have been inexplicably cited against Opposer's LA INDITA application even though the word "la" is the only basis of similarity between the marks, and such counterclaims are based in part on the failure of the MICHOACAN term to function as trademark.

For the foregoing reasons, Opposer agrees to suspend and consolidate Opposition Proceeding Nos. 91205093, 91205049, 91205466, and 91205468 given that the common question of whether MICHOACAN or MICHOACANA is a protectable designation is an issue that will be addressed in the District Court Action and therefore meets the low threshold for consolidation and suspension under TTAB precedent. In agreeing to suspend and consolidate these four proceedings, Opposer in no way concedes that its LA INDITA word mark and LA INDITA MICHOACANA and mountain girl design mark are similar with respect to each other or to Applicant's LA MICHOACANA word mark and LA MICHOACANA NATURAL and design mark.

Respectfully submitted,

Dated: August 23, 2012

By:



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PROOF OF SERVICE BY MAIL

I am employed with the law firm of Morrison & Foerster LLP, whose address is 425 Market Street, San Francisco, California, 94105; I am not a party to the within cause; I am over the age of eighteen years and I am readily familiar with Morrison & Foerster's practice for collection and processing of correspondence for mailing with the United States Postal Service and know that in the ordinary course of Morrison & Foerster's business practice the document described below will be deposited with the United States Postal Service on the same date that it is placed at Morrison & Foerster with postage thereon fully prepaid for collection and mailing.

I further declare that on August 23, 2012, I served copies of:

APPLICANT'S NOTICE OF NON-OPPOSITION TO OPPOSER'S MOTION TO CONSOLIDATE AND SUSPEND PENDING INTER PARTIES PROCEEDINGS


on the following by placing a true copy thereof enclosed in a sealed envelope addressed as follows for collection and mailing at Morrison & Foerster LLP, 425 Market Street, San Francisco, California, 94105, in accordance with Morrison & Foerster's ordinary business practices:

Stephen L. Anderson
Anderson & Associates
27247 Madison Avenue, Suite 121
Temecula, CA 92590

I declare under penalty of perjury under the laws of the State of California that the above is true and correct.

Executed at San Francisco, California, this 23rd day of August, 2012.

Lorna Simpson
(typed)



(signature)

Opposition No. 91205468