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UNITED STATES DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

TTAB



In the Matter of:
Registration No. 2,092,391
Dated: September 2, 1997

LA TAPATIA NORCAL, INC.)
)
Petitioner,)
)
v.)
)
LA TAPATIA TORTILLERIA, INC)
)
Registrant/Respondent)

Cancellation No. 92041003

**ANSWER & COUNTERCLAIM
OF RESPONDENT LA TAPATIA
TORTILLERIA, INC.**



10-18-2004
U.S. Patent & TMOfc/TM Mail Rcpt Dt. #72

Commissioner for Trademarks
P.O. Box 1451
Alexandria, Virginia 22313-1451

REGISTRANT'S ANSWER TO THE PETITION FOR CANCELLATION

In response to the Petition for Cancellation activated by the Board effective September 11, 2004, the Registrant/Respondent LA TAPATIA TORTILLERIA, INC. ("Respondent"), answers the petition identified above as follows:

- 1 Respondent admits the allegations of paragraph 1 of the Petition.
2. In response to the allegations of paragraph 2 of the Petition, Respondent admits only that petitioner La Tapatia Norcal, Inc. ("Petitioner") is a California corporation formed in 1987, and denies each and every remaining allegation in said paragraph.
3. Respondent admits the allegations of paragraph 3 of the Petition.
4. In response to the allegations of paragraph 4 of the Petition, Respondent admits only that an Order on issues related to the termination of marital status was filed in the Fresno County Superior Court on May 21, 1993, that the Order speaks for itself, and denies each and every remaining allegation in said paragraph.

5. In response to the allegations of paragraph 5 of the Petition, Respondent denies the allegations of said paragraph.

6. In response to the allegations of paragraph 6 of the Petition, Respondent admits only that application serial number 74/502,436 was filed on March 21, 1994, but denies the each and every remaining allegation of said paragraph.

7. In response to the allegations of paragraph 7 of the Petition, Respondent denies the allegations of said paragraph.

8. In response to the allegations of paragraph 8 of the Petition, Respondent denies the allegations of said paragraph.

9. In response to the allegations of paragraph 9 of the Petition, Respondent is without sufficient knowledge or information to form a belief as to the truth of the allegations, and on that basis denies each and every allegation.

10. In response to the allegations of paragraph 10 of the Petition, Respondent is without sufficient knowledge or information to form a belief as to the truth of the allegations, and on that basis denies each and every allegation.

11. In response to the allegations of paragraph 11 of the Petition, Respondent is without sufficient knowledge or information to form a belief as to the truth of the allegations, and on that basis denies each and every allegation.

12. In response to the allegations of paragraph 12 of the Petition, Respondent is without sufficient knowledge or information to form a belief as to the truth of the allegations, and on that basis denies each and every allegation.

13. In response to the allegations of paragraph 13 of the Petition, Respondent is without sufficient knowledge or information to form a belief as to the truth of the allegations, and on that basis denies each and every allegation.

14. In response to the allegations of paragraph 14 of the Petition, Respondent denies the allegations of said paragraph.

15. In response to the allegations of paragraph 15 of the Petition, Respondent denies the allegations of said paragraph.

AFFIRMATIVE DEFENSES

In further response to the Petition for Cancellation, the Respondent asserts that:

1. The Petitioner has failed to allege facts sufficient to support cancellation of the subject registration (2,092,391).

2. The Petitioner has no rights to the LA TAPATIA mark outside of the geographic territory of Northern California described as: that part of the State of California north of a line generally described as beginning at the California/Nevada state line and running due west from the Nevada border to the intersection of State Highway 99 and Monte Vista Avenue, then in a generally southwest direction in a straight line to the intersection of Interstate Highway 5 and Fink Road, then in a generally southeast direction along Interstate Highway 5, then due west through the intersection of County Road G13 and State Highway 25 to the Pacific Ocean.

3. Since at least 1944, Respondent or its predecessors have been and Respondent is now using the mark LA TAPATIA in connection with the sale of tortillas and other Mexican food products throughout the United States with the exception of Northern California. Said use has been valid and continuous since said date of first use and has not been abandoned. The LA TAPATIA mark of Respondent is symbolic of extensive good will and consumer recognition built up by Respondent through substantial amounts of time and effort in advertising and promotion. In view of these facts Respondent asserts that it has priority of use.

4. Even if Petitioner has priority of use in Northern California, Petitioner has continually and knowingly acquiesced to Respondent's use of the mark LA TAPATIA elsewhere.

5. On or about April 7, 2003, Petitioner and Respondent entered into a Mutual Release and Settlement Agreement (the "Agreement") under the terms of which the within Cancellation Proceeding (No. 92041003) was to be suspended, and ultimately dismissed by Petitioner.

COUNTER CLAIM

In further response to the Petition, the Respondent asserts the following counter-claim:

1. On or about April 7, 2003, Petitioner and Respondent entered into a Mutual Release and Settlement Agreement (the "Agreement") which resolved all issues between them with regard to the ownership and territorial use of the LA TAPATIA mark.

2. Pursuant to the Agreement, Petitioner agreed to suspend the within Cancellation Proceeding (No. 92041003) pending completion of two concurrent use applications for the LA TAPATIA mark filed by Petitioner (Nos. 76/515,435 and 76/515,436), to which Respondent has consented.

3. Both of said applications (Nos. 76/515,435 and 76/515,436) are currently active and pending before the Office, and each of said applications only affects the geographic territory consisting of "that part of the State of California north of a line generally described as beginning

at the California/Nevada state line and running due west from the Nevada border to the intersection of State Highway 99 and Monte Vista Avenue, then in a generally southwest direction in a straight line to the intersection of Interstate Highway 5 and Fink Road, then in a generally southeast direction along Interstate Highway 5, then due west through the intersection of County Road G13 and State Highway 25 to the Pacific Ocean, provided however, that the City of Turlock, California, as is now and hereafter legally bounded, is not and never shall be part of such geographic territory and excluding the remainder of the United States.”

4. Pursuant to the Agreement, Petitioner has agreed to dismiss the within Cancellation Proceeding (No. 92041003) upon completion of first and second concurrent use applications by Petitioner and cooperation by Respondent.

5. Respondent has cooperated with Petitioner, and has otherwise fully complied with its duties and obligations under the Agreement.

6. Petitioner and Respondent have sought and obtained a suspension and several continuances of the within Cancellation Proceeding. However, by notice mailed on May 10, 2004, the TTAB re-activated this matter, effective September 11, 2004.

7. Petitioner has not obtained a further suspension of the within Cancellation Proceeding, requiring this answer by Respondent.

8. Wherefore, Respondent pleads this counter claim, and petitions to have the within Cancellation Proceedings dismissed.


RELIEF REQUESTED

The Respondent requests that this Cancellation Proceeding be dismissed.

To the extent that the filing of this paper requires payment of any fees, the Office is authorized to pay or refund such fees from deposit account 502429.

Dated: October 12, 2004.

Respectfully Submitted,

By 

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Attorneys for Respondent

Certificate of Mailing 37 CFR § 2.197

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail, postage prepaid, in an envelope addressed to:

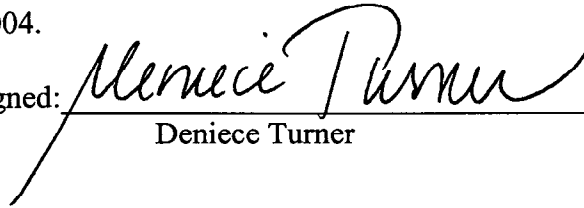
Commissioner for Trademarks
BOX TTAB
P.O. Box 1451
Alexandria, Virginia 22313-1451

and

R. Dennis Claessens, Esq.
Owen Wickersham & Erickson, P.C.
455 Market Street, 19th Floor
San Francisco, California 94105

on October 12, 2004.

Signed:

A handwritten signature in cursive script that reads "Deniece Turner". The signature is written over a horizontal line that extends to the right.

Deniece Turner

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