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

Proceeding	92047910
Party	Defendant Estefan Enterprises, Inc.
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Submission	Motion to Dismiss - Rule 12(b)
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IN THE UNITED STATES PATENT AND TRADEMARK
OFFICE BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Cancellation No. 92047910

ROBERTO NOBLE,

Petitioner,

vs.

ESTEFAN ENTERPRISES, INC.,

Registrant.

EEI'S MOTION TO DISMISS PETITION TO CANCEL

Registrant, Estefan Enterprises, Inc. ("EEI"), pursuant to TBMP §503, hereby moves to dismiss Roberto Noble's ("Noble") Petition to Cancel. In support thereof, EEI states as follows:

I. Overview: The Petition for Cancellation is Legally Insufficient and Must Be Dismissed

Noble's Petition for Cancellation is legally insufficient in every respect and must be dismissed in its entirety. The two bases asserted by Noble for canceling EEI's BONGOS CUBAN CAFE mark--that it is "merely descriptive" and that the incontestable status of the mark was achieved through the filing of a "false" affidavit thus rendering the mark "fraudulently maintained"--both fail as a matter of law. As detailed below, any claim of mere descriptiveness has long since been waived by Noble's failure to assert that claim as a compulsory counterclaim in the ongoing Consolidated Proceedings between the parties, and by the failure to assert it within the 5-year statute of limitations. Noble's effort to simply file the waived claim as a separate petition is nothing more than an obvious back-door, very belated, and unauthorized effort to amend the claims pending

between the parties. In addition to Noble's absolute waiver of the descriptiveness claim, the USPTO previously determined during its review and examination process of the application for Registration No. 2,490,999, that "bongos" is an arbitrary term, and not merely descriptive.

Equally meritless and dismissible is Noble's claim that EEI is "fraudulently" maintaining its mark by having filed a "false" incontestability declaration. To the contrary, as detailed below, EEI's incontestability declaration was true and accurate in every respect. Without dispute, and as Noble well knows, there was no petition or counterclaim to cancel EEI's mark filed by anyone either at the time of the declaration or at any time during the five years after registration. Only such an affirmative claim for cancellation would have prevented incontestability. Noble cites proceedings in which EEI has enforced its rights against infringement, including by Noble. None of the proceedings included any claim or counterclaim to cancel EEI's mark. These proceedings have no bearing whatsoever on the incontestability of the mark, and Noble's careless allegations that the declaration was "false" and the mark thus "fraudulently" maintained are utterly incorrect and, as a matter of law, provide no support for his cancellation petition.

In the following sections we describe the background of the proceedings between EEI and Noble, the waiver and inapplicability of Noble's "mere descriptiveness" claim, and the lack of any legal basis for Noble's allegations of a "false" declaration and a "fraudulently" maintained mark. For all of these reasons the Petition for Cancellation is legally insufficient in its entirety, cannot be corrected by any amendment, and must be dismissed with prejudice.

II. Background of the TTAB Proceedings Between EEI and Noble

EEI is the owner of the mark BONGOS CUBAN CAFÉ, Registration No. 2490999 and U.S. Serial No. 78955663¹ for restaurant and bar services and Registration Nos. 2494542, 2498561, 2521175, 2523448, 2523449 and 2676897 for various clothing and souvenir items. The BONGOS CUBAN CAFE mark that is the subject of this petition, Registration No. 2490999, has been used continuously in interstate commerce since 1997 in connection with restaurant and bar services.

Noble is the owner of the mark COCO BONGO with whom EEI has been involved in litigation before the TTAB for the past six years in Consolidated Proceeding No. 9,1121,980 (the “Consolidated Proceeding”).² The claims pending before the TTAB in the Consolidated Proceeding include EEI’s claim to cancel Noble’s registration of its COCO BONGO mark and to prevent the registration of Noble’s COCO BONGO HOUSE OF ROCK AND POP mark based on EEI’s BONGOS CUBAN CAFÉ registration. Noble filed its U.S. trademark applications under Section 44(e) based on its preexisting Mexican trademark registration. Noble’s application was filed in 1999 and despite its claimed plans for “use” in the United States, EEI’s contention before the TTAB is that Noble failed to commence use in interstate commerce within the meaning of 15 U.S.C. § 1126 and has, therefore, abandoned the mark. In addition to abandonment and failure to commence use in interstate commerce, EEI’s cancellation and opposition proceedings

¹ Noble recently filed a Notice of Opposition (Opposition No. 91177695) claiming that EEI’s logo, which incorporates “Bongos Cuban Café” as a dominant part thereof is descriptive. Noble relies on the same arguments for descriptiveness in that matter as he is relying upon herein. EEI filed a Motion to Dismiss the Notice of Opposition which is pending before the Board.

² EEI and Noble are also parties to Opposition No. 91,174,160, which has been stayed pending the resolution of Consolidated Proceeding No. 91,121,980.

against Noble before the TTAB are based on the likelihood of confusion between the parties' respective marks.

II. Count II of Noble's Petition to Cancel Alleging that EEI's Mark is Merely Descriptive Must be Dismissed

A. Noble Has Waived the Claim that EEI's Mark is Merely Descriptive by Failing to File a Compulsory Counterclaim in the Parties' Consolidated Proceeding

Noble failed to raise the claim that EEI's BONGOS CUBAN CAFÉ mark is merely descriptive as a compulsory counterclaim in the Consolidated Proceeding at the time he filed his initial answer in that case on February 27, 2004 or at the time he filed his answer to EEI's amended petition to cancel on January 31, 2007. Trademark Rules 2.106(b)(2)(i) and 2.114(b)(2)(i) state that:

a defense attacking the validity of any one or more of the registrations pleaded in the [petition or opposition] shall be a compulsory counterclaim if grounds for such counterclaim exist at the time when the answer is filed. If grounds for a counterclaim are known to respondent when the answer to the [petition or opposition] is filed, the counterclaim shall be pleaded with or as part of the answer. If grounds for a counterclaim are learned during the course of the [cancellation or opposition] proceeding, the counterclaim shall be pleaded promptly after the grounds therefor are learned.

Id. No such counterclaim/petition was filed by Noble in the Consolidated Proceeding.

In this case, it is beyond peradventure that Noble was aware of the "grounds" for this claim almost 2 years ago when he cross-moved for summary judgment on October 11, 2005 on the basis (among others) that EEI's mark was "descriptive", which motion was ultimately denied by the Board. See Consolidated Proceeding DK# 47, 51 and 62.

Moreover, Noble cannot dispute that he was aware of the grounds for his "descriptiveness" claim at the time he filed his answer to EEI's Amended Petition to Cancel on January 31, 2007, because "descriptiveness" was alleged as an affirmative

defense in that same document. See Consolidated Proceeding DK # 101. Noble's knowledge and the waiver that results therefrom is well documented in the record before this tribunal.

Noble cannot circumvent the requirement to assert a known compulsory counterclaim by the mere expedient of filing a separate petition to cancel. See Trademark Board Manual of Procedure §313.01; Trademark Rules 2.106(b)(2)(i), 2.114(b)(2)(i); *Vitaline Corp. v. General Mills, Inc.*, 891 F.2d 273 (Fed. Cir. 1989) (“the rule requiring the pleading of *counter* claims is clearly violated by an assertion of the abandonment theory, not as a *counter* claim in the original proceeding, but as a purportedly new claim in a separate proceeding. The rule would be a nullity if the TTAB or we were to allow [petitioner] to pursue its petition for cancellation based solely on a claim of abandonment, under these circumstances”). Despite the clear requirements of the Rule, Noble failed to file a compulsory counterclaim on the basis of descriptiveness alleged in his Petition to Cancel or on any other basis. Until now, Noble has never challenged EEI’s rights in its BONGOS CUBAN CAFÉ registration.

In fact, in response to EEI’s Motion to Dismiss Opposition No. 91177695, which also raises the issue of untimeliness for failure to assert a compulsory counterclaim, Noble admits that he made the deliberate and conscious “decision not to seek a formal, affirmative counterclaim of any kind to date in the prior consolidated proceedings.” See Opposition No. 91177695 DK # 6. Noble clearly could have brought a counterclaim to cancel EEI’s registration on the basis of descriptiveness had he wanted to, but made the voluntary choice not to do so. Accordingly, Noble has waived his right to file this

Petition to Cancel based on the purported descriptiveness of EEI's BONGOS CUBAN CAFÉ mark.

Further, although Noble claims in footnote 1 of his Petition that he "acted diligently and swiftly in asserting this Petition to Cancel shortly following its recent discovery" of EEI's Combined Affidavit of Use and Incontestability, that declaration was filed 8 months ago and Noble offers no reason for this delay. The affidavit of incontestability is a matter of public record with the Trademark Office and inasmuch as the parties have been litigating before the Trademark Board for years, it is simply not credible that Noble would not be aware of any or all of EEI's filings with the USPTO. Moreover, EEI moved to amend its petition to cancel against Noble in the Consolidated Proceedings in March, 2007 to assert a claim for Noble's fraudulent Section 8 and 15 Affidavit, which no doubt alerted Noble to the time period for EEI to file its own Combined Affidavit of Use and Incontestability. Indeed, in November, 2006 – one month prior to the five-year anniversary of EEI's BONGOS CUBAN CAFÉ registration – Noble's counsel filed a declaratory action against EEI in the name of Noble's purported licensee, including the specific allegation that EEI's BONGOS CUBAN CAFÉ was registered for less than five years, an obvious reference to the incontestability period. See Exhibit "F" to Noble's Petition to Cancel at ¶12.

B. Noble's Petition is Effectively an Untimely and Futile Motion for Leave to Amend in the Consolidated Proceeding

Noble's Petition to Cancel is in reality an untimely and futile motion to amend the pleadings in the Consolidated Proceeding, which would be denied by the Board. TMBP Rules 507.02(a) and (b) provide in relevant part:

507.02(a) Timing of Motion to Amend Pleading. In general the timing of a motion for leave to amend under Fed. R. Civ. P. 15(a) plays a large role in the Board's determination of whether the adverse party would be prejudiced by allowance of the proposed amendment. A long and unexplained delay in filing a motion to amend a pleading (when there is no question of newly discovered evidence) may render the amendment untimely.

507.02(b) Timing of Motion to Amend to Add Counterclaim. The timing of a motion for leave to amend is particularly important in the case of a motion for leave to amend to assert a counterclaim for cancellation of one or more of the plaintiff's pleaded registrations. Counterclaims to cancel pleaded registrations in Board proceedings are governed by 37 CFR §§ 2.106(b)(2)(i) and 2.114(b)(2)(i). As provided therein, if grounds for the counterclaim are known to the defendant when its answer to the complaint is filed, the counterclaim should be pleaded with or as part of the answer. If, during the proceeding, the defendant learns of grounds for a counterclaim to cancel a registration pleaded by the plaintiff, the counterclaim should be pleaded promptly after the grounds therefor are learned.

(Emphasis added).

A motion for leave to amend to file counterclaim by Noble in the Consolidated Proceeding would be denied as untimely by the Board as Noble was aware of the issues raised long before the instant Petition to Cancel, as previously set forth, and with no explanation for the delay. *See Int'l Finance Corporation v. Bravo Co.*, 64 USPQ2d 1597, 1604 (TTAB 2002) (motion for leave to amend denied where movant provided no explanation for two-year delay in seeking to add new claim); *Trek Bicycle Corp. v. StyleTrek Ltd.*, 64 USPQ2d 1540, 1541 (TTAB 2001) (motion to amend opposition denied where it was filed eight months after filing of notice of opposition, with no explanation for the delay, and appeared to be based on facts within opposer's knowledge at the time opposition was filed).

Moreover, if the allowance of the amendment would be futile, the amendment will be denied. *See Foman v. Davis*, 371 U.S. 178, 182 (1962); *W.R. Grace & Co. v. Arizona Feeds*, 195 U.S.P.Q. 670, 671 (TTAB 1977). As EEI argues in Section I (c)(d)

and (e) and Section II *supra*, Noble’s petition to cancel should be dismissed on various grounds and, therefore, an amendment would be futile.

C. EEI’s BONGOS CUBAN CAFÉ Mark is Incontestable and Cannot be Challenged on the Ground that it is Merely Descriptive

EEI’s Registration No. 2,490,999 for BONGOS CUBAN CAFÉ has become incontestable as a matter of law, by virtue of its continuous use for five years since the date of registration. 15 U.S.C. § 1065; See Notice of Acceptance of Section 8 and 15 for BONGOS CUBAN CAFÉ mark. As a result, its validity cannot be challenged on the ground that it is merely descriptive. *See Park N’ Fly*, 469 U.S. at 662; 15 U.S.C. § 1115(b). “With respect to incontestable marks, however, § 33(b) provides that registration is *conclusive* evidence of the registrant’s exclusive right to use the mark, subject to the conditions of § 15 and the seven defenses enumerated in § 33(b) itself. Mere descriptiveness is not recognized by either § 15 or § 33(b) as a basis for challenging an incontestable mark.” *Id.*

D. Noble’s Descriptiveness Claim is Barred by the Statute of Limitations

Moreover, Noble’s claim of descriptiveness is barred by the statute of limitations contained in 15 U.S.C. §1064. Section 14 of the Lanham Act, 15 U.S.C. §1064, provides a 5-year limitations period to cancel a mark on the basis of descriptiveness (among other bases). 15 U.S.C. § 1064(a); *Park 'N Fly, Inc. v. Dollar Park and Fly, Inc.*, 469 U.S. 189, 197 (1985). The Supreme Court has explained that “[w]ithout regard to its incontestable status, a mark that has been registered five years is protected from cancellation except on the grounds stated in §§ 14(c) and (e) [of the Lanham Act]. Pursuant to § 14, a mark may be canceled on the grounds that it is merely descriptive

only if the petition to cancel is filed within five years of the date of registration." *Park 'N Fly*, 469 U.S. at 197 (citing § 14(a) and 15 U.S.C. § 1064(a)).

Had Noble chosen to, he could have opposed EEI's registrations during the 30 days after initial approval when the applications were published specifically for that purpose, or he could have filed a petition to cancel EEI's mark as a compulsory counterclaim in the context of the parties' pending proceedings before the TTAB. See Trademark Board Manual of Procedure §313.01; Trademark Rules 2.106(b)(2)(i), 2.114(b)(2)(i); *Vitaline Corp. v. General Mills, Inc.*, 891 F.2d 273 (Fed. Cir.1989). No such petition was filed, and the statute of limitations on any claim of descriptiveness has run.

E. The USPTO Has Already Determined that
"BONGOS" is a Suggestive Mark

The Petition should further be dismissed because the USPTO has, during its review and examination process of the BONGOS CUBAN CAFÉ application for Registration No. 2,490,999, already deemed that "bongos" is an arbitrary term. The USPTO specifically stated in its Office Action dated February 27, 1997 that the "term BONGOS serves as the arbitrary source identifying term in the applicant's mark." EEI was required to disclaim "Cuban Café" and not "Bongos." Furthermore, the USPTO approved EEI's mark without requiring proof of secondary meaning.³

³ EEI vehemently denies that its mark is descriptive just because some of the music played at Bongos Cuban Café may include bongo drums as part of its instrumentation, or that EEI ever testified as such in any proceeding, but inasmuch as that is factual, EEI has not included any argument in this regard in this motion. EEI would not want its lack of refutation as any agreement or concession of these blatantly false allegations.

IV. Count I of Noble's Petition to Cancel for "Fraud" in the Maintenance of U.S. Registration No. 2,490,999 is Premised Upon Complete Misstatements of Law and Must be Dismissed

A. EEI's BONGOS CUBAN CAFÉ Registration was not Maintained Through Fraud

Noble claims "fraud" in the maintenance of EEI's BONGOS CUBAN CAFÉ registration, alleging that EEI's Combined Affidavit of Use and Incontestability Under Sections 8 and 15 was "false." On their face, these allegations are incorrect and a complete misstatement of the law. Noble supports these scurrilous claims merely by listing various proceedings, including the Consolidated Proceedings that were ongoing before the PTO at the time EEI's affidavit of incontestability was filed – *none* of which included any claim or petition for the cancellation of EEI's BONGOS CUBAN CAFÉ mark. Noble pointedly ignores that, consistent with all of the rules cited above requiring a petition to cancel or counterclaim and forbidding any collateral attack on the validity of a registration, the USPTO holds that only the pendency of such an affirmative cancellation action will prevent a mark from achieving incontestable status:

No Adverse Decision or Pending Proceeding Involving Rights in the Mark. The §15 affidavit must state that there has been no final decision adverse to the owner's claim of ownership of the mark for the goods or services, or to the owner's right to register the mark or to keep the mark on the register. It must also state that there is no proceeding involving these rights pending in the USPTO or in a court and not finally disposed of. 15 U.S.C. §§1065(1) - 1065(3); 37 C.F.R. §§2.167(d) and (e). If the USPTO finds facts contrary to either of the foregoing statements, the USPTO will not acknowledge receipt of the §15 affidavit. See TMEP §1605. (The USPTO does not consider a proceeding involving the mark in which the owner is the plaintiff, and there is no counterclaim involving the owner's rights in the mark, to be a "proceeding involving these rights" that would preclude the filing or acknowledgment of a §15 affidavit.)

Trademark Manual of Examining Procedure Rule §1605.04. The Manual makes clear that any action pending before the PTO or in the courts is not an action that prevents incontestable status where the registration that is the subject of the incontestability affidavit is not the subject of an affirmative claim, i.e. to cancel. The assertion of mere defenses to the enforceability of a registered trademark are simply insufficient to prevent incontestable status.

In none of the proceedings listed by Noble, including the Consolidated Proceeding, nor in any other proceeding, was there any counterclaim or petition to cancel EEI's BONGOS CUBAN CAFÉ registration, and none of the actions precluded the filing of or conflicted with the statements made in the Section 15 affidavit. Noble's careless allegations of "fraud" and a "false" affidavit are simply wrong.⁴ The following constitutes a "snapshot" of each of the actions that were pending as of the date EEI filed its declaration of incontestability on January 31, 2007.

Estefan Enterprises Inc. v Bongo, S.A. de C.V. and Noble, Consolidated Action No. 92042251

The Consolidated Proceedings pending before the TTAB as of January 31, 2007, the date of EEI's declaration of incontestability, included claims by EEI seeking to cancel Noble's COCO BONGO mark and opposing Noble's registration of his COCO BONGO HOUSE OF ROCK AND POP mark. Noble had not filed any counterclaims against the registrations of EEI's BONGOS CUBAN CAFÉ mark. See Answer to EEI's Amended Notice of Opposition and Answer to EEI's Amended Petition to Cancel attached hereto

⁴ Noble also fails to mention that he filed a declaration of incontestability for his COCO BONGO mark despite the fact that an affirmative cancellation proceeding directed to his registration had been pending for 5 years at the time he filed his declaration. EEI has raised this violation, among others, by Noble with the TTAB by seeking leave to amend its petition to cancel Noble's mark in the Consolidated Proceeding, which has not yet been ruled on. See Consolidated Proceeding DK #103.

as Exhibits “A” and “B”, respectively. The affirmative defenses raised by Noble in this proceeding at that time were that the mark is generic, merely descriptive, has become diluted, has been abandoned, and was insufficiently used to maintain federal rights. See Exhibit “B” hereto. Such defenses have no effect as they are impermissible collateral attacks on EEI’s registration. *See, e.g.*, Trademark Rules 2.106(b)(2)(i), 2.114(b)(2)(i); Trademark Rules 2.106(b)(2)(ii); TBMP § 311.02(b); TBMP § 313.01. *See also Food Specialty Co. v. Standard Products Co.*, 406 F.2d 1397 (C.C.P.A. 1969) (the validity of the registration of a mark may be tested only by a cancellation proceeding); *W.R. Grace & Co. v. Arizona Feeds*, 195 U.S.P.Q. 670, 671 (TTAB 1977) (defense attacking validity of registration must be raised by way of counterclaim for cancellation).

Estefan Enterprises, Inc. v. Coco Bongo Grill and Bar, Inc., Case No. 6:06-cv-742, United States District Court for the Middle District of Florida

Based on the USPTO's own interpretation of 15 U.S.C. §1065 (1)- (3) and 37 C.F.R. §2.167 (d) and (e), this infringement action brought by EEI to enforce its rights has no effect on the incontestable status of EEI’s mark. Specifically, there was no counterclaim brought by defendant in that case to cancel EEI’s registration. See Exhibit “J” to Noble’s Petition to Cancel. It is clear from the Board’s Manual that affirmative defenses alone, whether filed in the TTAB or in the courts, are insufficient as a matter of law to prevent or interfere with the incontestable status of a mark.

Marrero Enterprises, Inc. v. Estefan Enterprises, Inc., Case No. 06-CIV-81036, United States District Court for the Southern District of Florida

This declaratory action was filed by Noble’s attorney, Mr. Santucci, in the name of Noble’s alleged licensee, Marrero Enterprises of Palm Beach, Inc., one month before the 5-year "incontestability" period expired, and specifically states within it: “This is an

action solely for a declaration of non-infringement.” See Exhibit “F” to Noble’s Petition to Cancel at ¶ 3.⁵ There is, again, no claim or other request for cancellation of EEI’s registration. Based on the USPTO’s own interpretation 15 U.S.C. §1065 (1)- (3) and 37 C.F.R. §2.167 (d) and (e) as to what actions can prevent incontestable status, the Marrero action seeking a declaration of non-infringement falls precisely in the same category as an infringement action brought by EEI to enforce its rights. Marrero simply filed its declaratory action before EEI filed an enforcement action (because EEI thought it had a settlement with Marrero prior to Noble injecting himself into that matter). *See Public Service Commission v. Wycoff Co.*, 344 U.S. 237 (1952) (“In this case, as in many actions for declaratory judgment, the realistic position of the parties is reversed.”). Indeed, the “claims” raised by Marrero in that case are the very defenses he would have raised had EEI filed its infringement action first as evidenced by affirmative defenses he has filed in response to EEI’s counterclaim for infringement in that case. See Exhibit “C” hereto. Significantly, had Marrero chosen to, he could have coupled his claim for declaratory relief with a separate claim for cancellation and a prayer for such relief. *See McCarthy’s on Trademarks and Unfair Competition*, § 30:110; *see e.g., Zide Sport Shop of Ohio, Inc. v. Ed Tobergte Associates, Inc.*, 16 Fed.Appx. 433 (6th Cir. 2001). He simply chose not to, and nothing about that matter precluded incontestability status for EEI’s mark or rendered EEI’s incontestability declaration “false”.

Given the nature of the foregoing actions pending at the time EEI filed its

⁵ Marrero has reinforced this fact in various other filings with the Court in that same action. See DK # 45 (“Marrero simply seeks a declaratory judgment of non-infringement and [sic] as to the scope of EEI’s rights to prevent Marrero’s use of the marks at issue”) and DK # 49 (“Marrero’s sole claim in this action is for a declaratory judgment”).

Declaration of Incontestability and given the fact that there were no claims pending to cancel EEI's BONGOS CUBAN CAFÉ registration, EEI's Declaration clearly was not false and did not contain any misrepresentations. Since falsity is a threshold precondition to a fraud claim⁶, the claim can proceed no further and Count I of Noble's Petition to Cancel based on fraud should be dismissed.

B. As a Matter of Law, the District Court's Interlocutory Order Denying Summary Judgment Has No Effect

Also totally devoid of merit, is Noble's argument that an interlocutory order of a district court entered in the case of *Estefan Enterprises, Inc. v. Coco Bongo Grill and Bar, Inc.*, Case No. 6:06-cv-742 determined "conclusively" that EEI's mark is not incontestable and that EEI's mark is not suggestive and has not acquired secondary meaning. To the contrary, there was nothing "conclusive" at all determined by the subject order, even between the parties to that action, let alone as to any third parties. An order denying a motion for summary judgment has no preclusive effect whatsoever and, like any interlocutory order, may be revised or altered by the court at any time prior to judgment. See, e.g., Rule 54(b), Fed.R.Civ.P.; *Freeman v. Kohl & Vick Machine Works, Inc.*, 673 F.2d 196, 201 (7th Cir.1982) ("[W]e hold that ... an order [denying summary judgment] is interlocutory without res judicata effect and is thus subject to revision by the district court."); *Kirby v. P.R. Mallory & Co., Inc.*, 489 F.2d 904, 912 (7th Cir.1973)

⁶ If falsity is shown (which is not the case here), in order to support a mark's cancellation petition there must also be a showing of *scienter*--an intent to defraud. See *Metro Traffic Control, Inc. v. Shadow Network Inc.*, 104 F.3d 336 (Fed. Cir. 1997) (statements made in the oath are not fraudulent unless made with the intent to mislead the PTO); *Far Out Productions, Inc. v. Oskar*, 247 F.3d 986 (9th Cir. 2001) (§ 15 affidavit could not be fraudulent if the affiant had a good faith belief that a prior decision was irrelevant to the affiant's claim of ownership of the mark).

(order denying summary judgment is an interlocutory decree without preclusive effect).⁷

And of course, inconsistently, Noble has not mentioned the Board's order in the Consolidated Proceedings denying his motion for summary judgment on these same grounds as being "conclusive" of anything. Consolidated Proceeding DK# 47, 51, 62.

CONCLUSION

On the basis of all of the foregoing, Registrant, Estefan Enterprises, Inc., respectfully requests this Board's entry of an Order dismissing Noble's Petition for Cancellation with prejudice.

Respectfully submitted,
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⁷ This action, discussed previously in Section IV(A) *supra*, was an infringement action brought by EEI in which there was no counterclaim asserted to cancel EEI's registration, as would be necessary to impact on incontestability status. The case settled subsequent to the court's interlocutory summary judgment denial and the defendant has changed its name from Coco Bongo to Coco Café. As a result, there was no opportunity to obtain a final order on this issue. The district court incorrectly stated in the order that the infringement action itself precluded incontestability based upon a misapplication of *Sizzler Family Steak House v. Western Sizzler Steak House, Inc.*, 793 F.2d 1529 (11th Cir. 1986), overlooking the fact that *Sizzler* did involve a petition for cancellation of the mark, unlike the infringement action in that case or any of the proceedings involving Noble.

CERTIFICATE OF MAILING

I HEREBY CERTIFY that the foregoing has been sent via U.S. Mail to
Michael Santucci, Esq., Silverman Santucci, LLP, 500 West Cypress Creek Road,
Suite 500, Fort Lauderdale, Florida 33309 on this 13th day of September, 2007.

By: s/Karen L. Stetson
Karen L. Stetson

5. Applicant is without knowledge sufficient to form a belief as to the allegations contained in paragraph 5 of the Amended Notice of Opposition, and therefore denies same.

6. Applicant is without knowledge sufficient to form a belief as to the allegations contained in paragraph 6 of the Amended Notice of Opposition, and therefore denies same.

7. Applicant is without knowledge sufficient to form a belief as to the allegations contained in paragraph 7 of the Amended Notice of Opposition, and therefore denies same.

8. Applicant is without knowledge sufficient to form a belief as to the allegations contained in paragraph 8 of the Amended Notice of Opposition, and therefore denies same.

9. Applicant is without knowledge sufficient to form a belief as to the allegations contained in paragraph 9 of the Amended Notice of Opposition, and therefore denies same.

10. Applicant is without knowledge sufficient to form a belief as to the allegations contained in paragraph 10 of the Amended Notice of Opposition, and therefore denies same.

11. Applicant admits that it has filed an application to register the mark "COCO BONGO HOUSE OF ROCK & POP and Design" for use in connection with "discotheques". Applicant admits that the mark was published for opposition in the Official Gazette on October 17, 2000 at page TM 269. Applicant admits that the filing basis for the application is pursuant to section 44(e) of the Lanham Act, 15 U.S.C. §1126(e). Applicant denies the remaining allegations of Paragraph 11 of the Amended Notice of Opposition.

12. Applicant admits that it filed an application in Mexico on February 19, 1998 and filed its application in the United States on August 3, 1999. Applicant notes that footnote 1 of Paragraph 12 of the Amended Notice of Opposition was stricken pursuant to the Board's Order of February 5, 2004, page 4, and therefore the allegations contained therein are irrelevant.

13. Applicant admits that Applicant's "COCO BONGO HOUSE OF ROCK & POP" discotheque features music. Applicant is without knowledge sufficient to form a belief as to the allegation that said music is consistent with Opposer's definition of the terms "pop music and/or Latin-themed music and dancing", and therefore denies same.

14. Applicant denies the allegations contained in Paragraph 14 of the Amended Notice of Opposition.

15. Applicant denies the allegations contained in Paragraph 15 of the Amended Notice of Opposition.

16. Applicant denies the allegations contained in Paragraph 16 of the Amended Notice of Opposition.

17. Applicant denies the allegations contained in Paragraph 17 of the Amended Notice of Opposition.

18. Applicant denies the allegations contained in Paragraph 18 of the Amended Notice of Opposition.

19. Applicant denies the allegations contained in Paragraph 19 of the Amended Notice of Opposition.

20. Applicant admits that if Applicant is granted the registration herein opposed, it would thereby obtain at least a

prima facie exclusive right to the use of the mark "COCO BONGO HOUSE OF ROCK & POP and Design". Applicant denies that said registration would be a source of damage and injury to Opposer. Applicant denies the remaining allegations of Paragraph 20 of the Amended Notice of Opposition.

21. Applicant denies the allegations contained in the WHEREFORE clause of the Notice of Opposition.

22. Applicant denies any and all allegations of the Notice of Opposition not specifically admitted herein.

AFFIRMATIVE DEFENSES

1. The Amended Notice of Opposition fails to state a claim upon which relief may be granted.

2. Opposer lacks standing to oppose.

3. Applicant maintains senior rights in the "COCO BONGO HOUSE OF ROCK & POP and Design" mark as applied for, as well as its numerous related marks, including, without limitation the mark "COCO BONGO", Registration No. 2,347,247.

4. Applicant's "COCO BONGO HOUSE OF ROCK & POP and Design" goods and services and Opposer's mark(s) have co-existed without any known instances of actual confusion.

5. Opposer has had actual knowledge of Applicant's use of "COCO BONGO HOUSE OF ROCK & POP and Design" for many years, but has taken no action to object thereto, which inaction Applicant has relied upon, such that Opposer's action is barred by laches.

6. Opposer has not and could not suffer any damage by reason

of Applicant's registration of "COCO BONGO HOUSE OF ROCK & POP and Design" since, there is no likelihood of confusion.

7. Applicant has used its mark in the United States and such no abandonment has occurred.

8. Applicant maintains superior rights to the mark "COCO BONGO HOUSE OF ROCK & POP and Design" under the "well-known" and "famous marks" doctrine.

9. Applicant maintains superior rights to the mark "COCO BONGO HOUSE OF ROCK & POP and Design" under the application of 15 U.S.C. 1126(b) and (h), and the Paris Convention for the Protection of Industrial Property, Article 6bis.

10. Opposer has failed to join an indispensable party.

11. Any application or registration for which Opposer will or could rely is void.

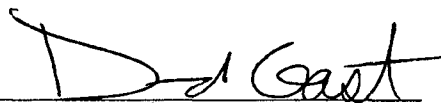
12. Any application or registration for which Opposer will or could rely is abandoned.

13. Any trademarks rights upon which Opposer will or could rely have been abandoned.

WHEREFORE, Applicant prays that the Opposition be dismissed with prejudice.

Dated: March 8, 2003

By:

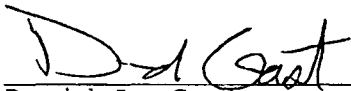

John Cyril Malloy, III
Florida Bar No. 964,220
David A. Gast
Florida Bar No. 176,567
MALLOY & MALLOY, P.A.
2800 S.W. 3rd Avenue
Miami, Florida 33129
Telephone: (305) 858-8000
Facsimile: (305) 858-0008
Email: dgast@malloylaw.com

CERTIFICATE OF SERVICE

I HEREBY CERTIFY that a true and correct copy of the foregoing was served on the following via United States mail, postage pre-paid this 8th day of March, 2004:

Karen L. Stetson, Esq.
BROAD AND CASSEL, P.A.,
201 South Biscayne Boulevard, Suite 3000
Miami, Florida 33131

Respectfully submitted,

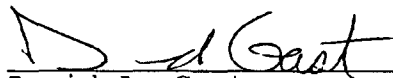
By: 
David A. Gast
Florida Bar No. 176,567

CERTIFICATE OF MAILING

I HEREBY CERTIFY that an original and one copy were deposited by United States Postal Service as first class mail in an envelope addressed to the following this 8th day of March, 2004:

Commissioner for Trademarks
Attn: T.T.A.B., "Box TTAB"
2900 Crystal Drive
Arlington, Virginia 22202-3514

Respectfully submitted,

By: 
David A. Gast
Florida Bar No. 176,567

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

-----X

ESTEFAN ENTERPRISES, INC.

Petitioner/Petitioner,
91121980

Petition to Cancel No.:

vs.

Cancellation No.: 92042251

Registration No.: 2,347,247

BONGO, S.A. de C.V. and ROBERTO NOBLE,

Registrants/Registrants.

-----X

**ANSWER TO ESTEFAN ENTERPRISES, INC.'S FIRST AMENDED PETITION
TO CANCEL REGISTRATION NO. 2,347,247**

Registrant ROBERTO NOBLE and BONGO, S.A. de C.V. (hereinafter "Registrant"), hereby file their Answer to ESTEFAN ENTERPRISES, INC.'s First Amended Petition To Cancel Registration No. 2,347,247, and further allege:

1. Registrant is without knowledge of the allegations contained in this paragraph and therefore, in an abundance of caution, denies same.
2. Registrant denies the allegations contained in this paragraph.
3. Registrant admits that Bongo, S.A. de C.V. assigned its entire interest in the COCO BONGO mark to Grupo Industrial Hotelero, C.V. Registrant denies that said assignment took place on April 1, 2005. Registrant admits that Grupo Industrial Hotelero, C.V. assigned its entire interest in the COCO BONGO mark to ROBERTO NOBLE. Registrant denies that said assignment took place on May 10, 2005. Registrant admits that Roberto Noble is the current owner of the COCO BONGO mark and U.S. Registration Number 2,347,247.

4. Registrant is without knowledge of the allegations contained in this paragraph and therefore, in an abundance of caution, denies same.

5. Registrant is without knowledge of the allegations contained in this paragraph and therefore, in an abundance of caution, denies same.

6. Registrant is without knowledge of the allegations contained in this paragraph and therefore, in an abundance of caution, denies same.

7. Registrant is without knowledge of the allegations contained in this paragraph and therefore, in an abundance of caution, denies same.

8. Registrant is without knowledge of the allegations contained in this paragraph and therefore, in an abundance of caution, denies same.

9. Registrant is without knowledge of the allegations contained in this paragraph and therefore, in an abundance of caution, denies same.

10. Registrant denies the allegations contained in this paragraph.

11. Registrant admits the allegations contained in this paragraph.

12. Registrant admits the allegations contained in this paragraph.

13. Registrant admits the allegations contained in this paragraph.

14. Registrant admits only that the application which matured into the subject Registration was filed after Petitioner's filing of its application one of its applications for one of its BONGOS CUBAN CAFÉ marks. Registrant denies the remaining allegations contained in this paragraph.

15. Registrant denies the allegations contained in this paragraph.

16(1).¹ Registrant denies the allegations contained in this paragraph.

16(2). This basis for cancellation was stricken from the First Amended Petition to Cancel by the Board's Order of January 11, 2007 and therefore requires not response. Registrant nonetheless denies the allegations contained in this paragraph in an abundance of caution.

17. This basis for cancellation was stricken from the First Amended Petition to Cancel by the Board's Order of January 11, 2007 and therefore requires not response. Registrant nonetheless denies the allegations contained in this paragraph in an abundance of caution.

18. This basis for cancellation was stricken from the First Amended Petition to Cancel by the Board's Order of January 11, 2007 and therefore requires not response. Registrant nonetheless denies the allegations contained in this paragraph in an abundance of caution.

19. This basis for cancellation was stricken from the First Amended Petition to Cancel by the Board's Order of January 11, 2007 and therefore requires no response. Registrant nonetheless denies the allegations contained in this paragraph in an abundance of caution.

20. Registrant denies the allegations contained in this paragraph.

All allegations not specifically admitted above are denied.

AFFIRMATIVE DEFENSES

21. As his First Affirmative Defense, Registrant alleges that all or part of

¹ ESTEFAN ENTERPRISES, INC.'S First Amended Petition to Cancel contains two allegations numbered "16." For purposes of the Answer, Registrant shall refer to these allegations sequentially as paragraphs "16(1)" and "16(2)."

Petitioner's alleged mark BONGO'S CUBAN CAFE, which is the basis of its Petition to Cancel, is generic, and thus incapable of functioning as a mark. Petitioner therefore has no standing to maintain an action to oppose the subject application.

22. As his Second Affirmative Defense, Registrant alleges that all or part of Petitioner's alleged mark BONGO'S CUBAN CAFE, which is the basis of its Petition to Cancel, is merely descriptive of the goods and services provided in connection therewith, and thus incapable of functioning as a mark. Petitioner therefore has no standing to maintain an action to oppose the subject application.

23. As his Third Affirmative Defense, Registrant alleges that the term "BONGOS," which is the only term not expressly disclaimed by Petitioner, has become diluted as a result of its widespread use in the restaurant, nightclub and entertainment industries, a fact admitted by Petitioner in prior federal litigation.

24. As his Fourth Affirmative Defense, Registrant alleges that Petitioner has abandoned its rights, if any, in its alleged marks, by failing to continuously use and police same.

25. As his Fifth Affirmative Defense, Registrant alleges that Petitioner is collateral estopped from maintaining the herein Petition to Cancel proceeding in that issues central to Petitioner's Petition to Cancel have already been decided by the U.S. District Court in and for the Southern District of Florida and the 11th Circuit Court of Appeals in the case of Michael Caruso & Co., Inc. v. Estefan Enterprises, Inc., 994 F. Supp. 1454 (S.D. Fla. 1998), *aff'd without opinion*, 166 F.3d 353 (11th Cir. 1998).

26. As Sixth Affirmative Defense, Registrant alleges that Petitioner's acquiescence in enforcing its alleged rights in the mark BONGOS CUBAN CAFÉ bars it

from maintaining the herein Petition to Cancel proceeding.

27. As his Seventh Affirmative Defense, Registrant alleges that neither registration, nor use, of the Registrant's mark as alleged in the subject application, will create a likelihood of confusion with any of Petitioner's alleged marks.

28. As his Eighth Affirmative Defense, Registrant alleges that Petitioner has not used some or all of its alleged marks on the goods or services asserted in bona fide commerce. Petitioner therefore has no standing to maintain an action to oppose the subject application.

29. As his Ninth Affirmative Defense, Registrant alleges that Petitioner has not used its alleged marks in interstate commerce and therefore has no federal rights to assert. As a result, Petitioner has no standing to maintain an action to oppose the subject application.

30. As his Tenth Affirmative Defense, Registrant alleges that some or all of the federal registrations alleged to be owned by Petitioner were obtained by fraud in that the corresponding marks were not used in interstate commerce.

31. As his Eleventh Affirmative Defense, Registrant alleges that Petitioner is not likely to be, damaged by Registrant's continued maintenance of the subject Registration, and any confusion or damage which might be possible would be *de minimus*.

32. As his Twelfth Affirmative Defense, Registrant alleges that Petitioner is estopped by its own actions which are inconsistent with its claims of likelihood of confusion herein. Namely, Petitioner either owned or licensed the operation of a restaurant, bar and retail souvenir business under its alleged mark in the Mexico City

airport, a jurisdiction in which Petitioner undeniably has priority of right over Petitioner to use his COCO BONGO marks.

33. As his Thirteenth Affirmative Defense, Registrant alleges that he has priority of right over Petitioner to use his COCO BONGO marks for the goods and services at issue.

34. As his Fourteenth Affirmative Defense, Registrant alleges that some or all of Petitioner's alleged marks upon which its claim of priority depends are either no longer in use, or have been abandoned.

35. As his Fifteenth Affirmative Defense, Registrant alleges that he has used the mark which is the subject of the Registration Number 2,347,247 in qualifying commerce on his own, and through his licensees and predecessor-in-interest BONGO S.A. de C.V., Grupo Industrial Hotelero, S.A. and Marrero Enterprises, Inc.

WHEREFORE, Registrant respectfully requests that the Board grant no relief to Petitioner by reason of its First Amended Petition to Cancel Registration No. 2,347,247, and grant such further relief as the Board deems just and proper.

Respectfully submitted,

Law Offices of
SILVERMAN SANTUCCI, LLP
Attorneys for ROBERTO NOBLE
And BONGO S.A. de C.V.
500 West Cypress Creek Road
Suite 500
Fort Lauderdale, Florida 33309
Phone: (954) 351-7474
Fax: (954) 351-7475
MIS@500Law.com

By: s/Michael I. Santucci
Michael I. Santucci, Esquire
Florida Bar Number: 0105260

CERTIFICATE OF SERVICE

The undersigned hereby certifies that a copy of the foregoing has been served on this 31st day of January, 2007, by first class and by TTAB electronic mail to Karen Stetson, Esq., PO Box 403023, Miami, Florida 33140.

By: s/Michael I. Santucci
Michael I. Santucci, Esquire

**UNITED STATES DISTRICT COURT
SOUTHERN DISTRICT OF FLORIDA
WEST PALM BEACH DIVISION**

CASE NO. 06-81036-CIV-RYSKAMP/VITUNAC

MARRERO ENTERPRISES OF
PALM BEACH, INC.,
a Florida corporation

Plaintiff,

vs.

ESTEFAN ENTERPRISES, INC.
a Florida corporation,

Defendant.

**MARRERO'S ANSWER AND AFFIRMATIVE DEFENSES
TO EEI'S COUNTERCLAIM**

COMES NOW, Plaintiff MARRERO ENTERPRISES OF PALM BEACH, INC.,
and hereby answers ESTEFAN ENTERPRISES, INC.'s ("EEI") Counterclaim, (Docket #
32) and alleges:

MARRERO hereby re-alleges and incorporates by reference all allegations set
forth in its Complaint in this action, as if fully set forth herein.

THE PARTIES

1. MARRERO is without knowledge of the allegations contained in this
paragraph and therefore, in an abundance of caution, denies same.
2. MARRERO admits the allegations contained in this paragraph.

EXHIBIT "C"

NATURE OF ACTION

3. MARRERO admits that the causes of action EEI purports to allege arise under the federal and Florida authority alleged. MARRERO denies the validity of said causes of action and denies that its use of the COCO BONGO mark violates any rights of EEI. MARRERO denies all other allegations contained in this paragraph.

JURISDICTION AND VENUE

4. MARRERO admits that this Court has subject matter jurisdiction over the claims EEI has purported to allege. MARRERO denies all other allegations contained in this paragraph including the amount in controversy alleged.

5. MARRERO admits the allegations contained in this paragraph.

GENERAL ALLEGATIONS

6. MARRERO admits that the records of the United States Patent and Trademark Office (“USPTO”) indicate that EEI is the owner of U.S. Registration Number 2,490,999 and U.S. Application Serial Number 78/955,663. MARRERO specifically denies EEI’s claim of ownership thereof and of the alleged marks associated therewith, and specifically denies the validity of the alleged marks, Registration and Application. MARRERO denies all other allegations contained in this paragraph.

7. MARRERO is without knowledge of the allegations contained in this paragraph and therefore, in an abundance of caution, denies same.

8. MARRERO is without knowledge of the allegations contained in this paragraph and therefore, in an abundance of caution, denies same.

9. MARRERO denies the allegations contained in this paragraph.

10. MARRERO admits that it is operating a bar and nightclub under the name COCO BONGO and that it is operating an Internet website under the registered domain name www.cocobongowpb.com. MARRERO denies that said mark or domain name is confusingly similar to EEI's BONGOS CUBAN CAFÉ mark. MARRERO denies all other allegations contained in this paragraph.

11. MARRERO admits that it has adopted, advertised and used the wording BONGO as part of its mark to identify its services. MARRERO denies all other allegations contained in this paragraph.

12. MARRERO admits that it commenced use of the mark COCO BONGO at least as early as the year 2000. MARRERO denies all other allegations contained in this paragraph.

13. MARRERO admits that EEI sent letters to MARRERO as represented by the copies attached to the Counterclaim as Exhibit "C" thereto, that said letters were received by MARRERO and/or its attorneys and agents, and that the copies attached to the Counterclaim are true and correct copies thereof. MARRERO also admits that it has not ceased use of the COCO BONGO mark, and that MARRERO has filed the instant declaratory judgment action. MARRERO denies that the COCO BONGO mark is infringing upon any right of EEI. MARRERO denies all other allegations contained in this paragraph.

COUNT ONE

14. MARRERO re-alleges and incorporates by reference all allegations set forth in paragraphs 1-13 above as if fully set forth herein.

15. MARRERO admits that the records of the United States Patent and Trademark Office (“USPTO”) indicate that EEI is the owner of U.S. Registration Number 2,490,999. MARRERO specifically denies EEI’s claim of ownership thereof and of the alleged marks associated therewith, and specifically denies the validity of the alleged mark and Registration. MARRERO denies all other allegations contained in this paragraph.

16. MARRERO denies the allegations contained in this paragraph.

17. MARRERO denies the allegations contained in this paragraph.

18. MARRERO admits its use of COCO BONGO in connection with its bar and nightclub is without permission or authority of EEI. MARRERO however denies that EEI has any right to give or deny such permission or authority, denies that said use is likely to cause confusion, mistake or deceive. MARRERO denies all other allegations contained in this paragraph.

19. MARRERO denies the allegations contained in this paragraph.

20. MARRERO denies the allegations contained in this paragraph.

COUNT TWO

21. MARRERO re-alleges and incorporates by reference all allegations set forth in paragraphs 1-13 above as if fully set forth herein.

22. MARRERO admits that it has used the designation COCO BONGO in connection with its bar and nightclub in commerce. MARRERO denies all other allegations contained in this paragraph.

23. MARRERO admits that a legal remedy exists to remedy the type of harm EEI has purported to allege, but denies EEI's entitlement to any such relief. MARRERO denies all other allegations contained in this paragraph.

COUNT THREE

24. MARRERO re-alleges and incorporates by reference all allegations set forth in paragraphs 1-13 above as if fully set forth herein.

25. MARRERO denies the allegations contained in this paragraph.

26. MARRERO denies the allegations contained in this paragraph.

27. MARRERO admits that a legal remedy exists to remedy the type of harm EEI has purported to allege, but denies EEI's entitlement to any such relief. MARRERO denies all other allegations contained in this paragraph.

COUNT FOUR

28. MARRERO re-alleges and incorporates by reference all allegations set forth in paragraphs 1-13 above as if fully set forth herein.

29. MARRERO denies the allegations contained in this paragraph.

30. MARRERO denies the allegations contained in this paragraph.

MARRERO denies all allegations contained in the Counterclaim and Affirmative Defenses which are not specifically admitted.

MARRERO'S AFFIRMATIVE DEFENSES TO EEI'S COUNTERCLAIM

15. As its First Affirmative Defense, MARRERO alleges that EEI's U.S. Registration No. 2,490,999, upon which its Counterclaim is based, was obtained and/or maintained through fraud, and is therefore invalid, void and subject to cancellation.

A. Specifically, EEI has committed fraud in the maintenance of said Registration by filing with the United States Patent and Trademark Office (“USPTO”) a Combined Affidavit of Use and Incontestability Under Sections 8 & 15 of the Lanham Act relative to said Registration, on January 31, 2007 which knowingly contained material misrepresentations of fact. The affidavit of incontestability was filed by EEI’s President Frank Amadeo in which he falsely declared under threat of punishment by fine, imprisonment or both under 18 U.S.C. § 1001, that:

“There has been no final decision adverse to the owner's claim of ownership of such mark for such goods and/or services, or to the owner's right to register the same or to keep the same on the register; and there is no proceeding involving said rights pending and not disposed of either in the U.S. Patent and Trademark Office or in the courts.”

B. EEI, and specifically Mr. Amadeo, were well aware of the existence of the instant action in which EEI’s various rights in the mark BONGOS CUBAN CAFÉ are being challenged when they filed the Combined Affidavit of Use and Incontestability. The Complaint in this action was served upon Mr. Amadeo’s office at EEI’s headquarters in Miami Beach, Florida on November 15, 2006.

C. EEI, and specifically Mr. Amadeo, were well aware of the existence of the following additional pending actions in which EEI’s various rights in the mark BONGOS CUBAN CAFÉ are being challenged when they filed the Combined Affidavit of Use and Incontestability:

(i). Estefan Enterprises, Inc. v. Roberto Noble, Opposition No. 91174160 which is an administrative Opposition Action seeking to oppose the federal registration of the mark COCO BONGO HOUSE OF ROCK AND POP by ROBERTO NOBLE based upon Plaintiff EEI’s ownership of U.S. Registration No. 2,490,999 for the mark BONGOS CUBAN CAFÉ. The affirmative defenses in that action include allegations that EEI’s subject

mark and Registration have been abandonment and that EEI's subject Registration is void. The action was filed on February 13, 2001, and is currently pending before the USPTO's Trademark Trial and Appeal Board.

(ii). *Estefan Enterprises, Inc. v. Bongo, S.A. de C.V.*, Cancellation No. 92042251 which is an administrative Cancellation Action seeking the cancellation of the U.S. Registration No. 2,347,247 directed to the mark COCO BONGO owned by ROBERTO NOBLE based upon Plaintiff EEI's ownership of U.S. Registration No. 2,490,999 for the mark BONGOS CUBAN CAFÉ. The affirmative defenses in that action include allegations that the mark is generic, merely descriptive, has become diluted, has been abandoned, was insufficiently used to maintain federal rights, that EEI has committed fraud on the USPTO concerning the subject Registration, and that EEI is barred from enforcement of the subject registration because of the U.S. District Court's opinion in the case of *Michael Caruso & Co., Inc. v. Estefan Enterprises, Inc.*, 994 F. Supp. 1454 (S.D. Fla. 1998). The action was filed on June 20, 2003 and is currently pending before the USPTO's Trademark Trial and Appeal Board.

(iii). *Estefan Enterprises, Inc. v. Coco Bongo's Grill and Bar, Inc.*, Case No. 6:06-cv-00742-GAP-KRS which is an action filed by EEI for false designation of origin, and various forms of trademark infringement and unfair competition. The Defendant in that action, filed its Answer on July 17, 2006 (*Docket # 18*) and is challenging the validity of EEI's rights in the mark BONGOS CUBAN CAFÉ, and corresponding U.S. Registration No. 2,490,999, and has alleged that EEI is estopped from asserting any rights therein. This action is currently pending before the U.S. District Court for the Middle District of Florida, Orlando Division.

16. As its Second Affirmative Defense, MARRERO alleges that despite the USPTO's current record of the status of U.S. Registration No. 2,347,247, which was the result of fraud, as alleged in Paragraph 15 above, on June 4, 2007, the U.S. District Court for the Middle District of Florida has recently ruled that EEI's U.S. Registration No. 2,347,247 is not incontestable in the case of *Estefan Enterprises, Inc. v. Coco Bongo's Grill and Bar, Inc.*, Case No. 6:06-cv-00742-GAP-KRS, (*Docket # 88*) because of the fact that said District Court action was pending at the time when EEI filed its Combined

Affidavit of Use and Incontestability relative to said Registration on January 31, 2007. EEI's U.S. Registration No. 2,347,247 and corresponding mark are therefore not incontestable, and EEI is estopped from making any claim of incontestability as to its marks or Registration.

17. As its Third Affirmative Defense, MARRERO alleges that the term "BONGOS," which is the only term contained in the mark BONGOS CUBAN CAFÉ which not expressly disclaimed by EEI, has become diluted as a result of its widespread use in the restaurant, nightclub and entertainment industries, a fact admitted by EEI in prior federal litigation.

18. As its Fourth Affirmative Defense, MARRERO alleges that EEI has abandoned its rights, if any, in its alleged marks, by failing to adequately police same.

19. As its Fifth Affirmative Defense, MARRERO alleges that EEI is estopped from maintaining the herein Counterclaim proceeding in that issues central to EEI's Counterclaim have already been decided by the U.S. District Court in and for the Southern District of Florida and the 11th Circuit Court of Appeals in the case of Michael Caruso & Co., Inc. v. Estefan Enterprises, Inc., 994 F. Supp. 1454 (S.D. Fla. 1998), *aff'd without opinion*, 166 F.3d 353 (11th Cir. 1998), namely: 1) the weakness of the terms BONGO and BONGOS as a source identifiers due to: a) widespread third party use of said terms in connection with restaurant and nightclub services; and b) the fact that the terms BONGO and BONGOS are common English words for a drum commonly used in Cuban music; and 2) That: "...The mere fact that both marks incorporate a form of the common word "bongo" does not render the marks similar...."

20. As its Sixth Affirmative Defense, MARRERO alleges that EEI's

acquiescence in enforcing its alleged rights in the mark BONGOS CUBAN CAFÉ and the term BONGO bars it from maintaining its alleged Counterclaim.

21. As its Seventh Affirmative Defense, MARRERO alleges that its use, of the COCOBONGO and COCO BONGO marks as alleged in the Complaint and Counterclaim, will not create a likelihood of confusion with any of EEI's alleged marks.

22. As its Eighth Affirmative Defense, MARRERO alleges that EEI has not made the requisite use of some or all of its alleged marks in qualifying commerce necessary to acquire rights thereto. EEI therefore has no standing to maintain the alleged Counterclaim.

23. As its Ninth Affirmative Defense, MARRERO alleges that EEI has not continued to make sufficient use of some or all of its alleged marks in qualifying commerce necessary to maintain rights thereto. EEI therefore has no standing to maintain the alleged Counterclaim.

24. As its Tenth Affirmative Defense, MARRERO alleges that some or all of the federal registrations alleged to be owned by EEI were obtained by fraud in that the corresponding marks were not sufficiently and continuously used in interstate commerce.

25. As its Eleventh Affirmative Defense, MARRERO alleges that EEI is not likely to be, damaged by MARRERO's continued use of the COCOBONGO and COCO BONGO marks, and any confusion or damage which might be possible would be *de minimus*.

26. As its Twelfth Affirmative Defense, MARRERO alleges that EEI is estopped by its own actions which are inconsistent with its claims of likelihood of confusion herein. Namely, EEI either owned or licensed the operation of a restaurant,

bar and retail souvenir business under the mark BONGOS CUBAN CAFÉ in the Mexico City airport, a jurisdiction in which EEI has priority of right over EEI to use its COCO BONGO marks.

27. As its Thirteenth Affirmative Defense, MARRERO alleges that he has priority of right over EEI to use its COCO BONGO marks for the goods and services at issue.

28. As its Fourteenth Affirmative Defense, MARRERO alleges that EEI is estopped and bound by the opinion and findings set forth in the Order Denying Summary Judgment rendered in the case of *Estefan Enterprises, Inc. v. Coco Bongo's Grill and Bar, Inc.*, Case No. 6:06-cv-00742-GAP-KRS, (Docket # 88).

29. As its Fifteenth Affirmative Defense, MARRERO alleges that all or part of EEI's alleged mark BONGO'S CUBAN CAFE, which is the basis of its Counterclaim, is merely descriptive of the goods and services provided in connection therewith, and thus incapable of functioning as a mark. EEI therefore has no standing to maintain an action to oppose the subject application.

30. As its Sixteenth Affirmative Defense, MARRERO alleges that all or part of EEI's alleged mark BONGO'S CUBAN CAFE, which is the basis of its Counterclaim, is descriptive of one or more of the characteristics, qualities and/or features of the services provided in connection therewith, and is therefore weak and afforded little protection if any.

31. As its Seventeenth Affirmative Defense, MARRERO alleges that EEI has failed to state a claim upon which attorneys' fees or any other relief can be granted under § 501.204, *Fla.Stat.* as to any alleged acts of MARRERO which occurred prior to the

effective date of the amendment to § 501.204, *Fla.Stat.* which abolished the requirement that a claimant thereunder be a “consumer” as previously defined therein.

WHEREFORE, MARRERO respectfully requests that this Honorable Court grant no relief to EEI and by reason of its Counterclaim, award attorneys fees and costs to MARRERO and grant such further relief as the Board deems just and proper.

Respectfully submitted,

Trial Counsel for Plaintiff:

SILVERMAN SANTUCCI, LLP
500 West Cypress Creek Road
Suite 500
Fort Lauderdale, Florida 33309
Telephone: (954) 351-7474
Facsimile: (954) 351-7475

By: s/Michael I. Santucci
Michael I. Santucci, Esquire
Florida Bar Number: 0105260
mis@500law.com

CERTIFICATE OF SERVICE

The undersigned hereby certifies that a copy of the foregoing has been served on this 9th day of July, 2007, by first class mail to Karen Stetson, Esq., P.O. Box 403023, Miami, Florida 33140.

s/Michael I. Santucci
Michael I. Santucci, Esquire
Florida Bar Number: 0105260