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

Proceeding	92048266
Party	Defendant Zucrum Foods, L.L.C.
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In re registration of:

Registrant: Zucrum Foods, LLC
Registration No.: 2,476,161
Date of Issue: August 7, 2001
Mark: AZUCAR MORENA

MARQUEZ BROTHERS,)
INTERNATIONAL, INC.,)
)
 Petitioner,)
)
 vs.)
)
ZUCRUM FOODS, LLC,)
)
 Registrant.)
_____)

Cancellation No. 92048266

**REPLY BRIEF IN SUPPORT OF REGISTRANT’S CROSS-MOTION FOR PARTIAL
SUMMARY JUDGMENT REGARDING THE ISSUE OF GENERICNESS**

Registrant Zucrum Foods, LLC (“Registrant”), by and through his attorney of record, Robert Ted Parker, submits this reply brief in support of its Cross-Motion for Partial Summary Judgment Regarding the Issue of Genericness before the Trademark Trial and Appeal Board (“TTAB”). Registrant incorporates by reference all of its prior briefing as it relates to the substantive issues raised in Petitioner’s motion for summary judgment and set forth in Registrant’s cross-motion for partial summary judgment regarding the issue of genericness. To the extent the Board does not grant Registrant’s cross-motion for summary judgment, Registrant

has created questions of fact as it relates to Petitioner's motion for summary judgment, and at a bare minimum would be unduly prejudiced by the Board denying its request to re-open discovery—which request is grounded upon numerous bases. Registrant hereby incorporates by reference all prior motions, memorandums, and affidavits related to its motion to compel and 56(f) motion. Registrant respectfully asks the Board to consider all of those filings, with a particular focus on the unnecessary and undue prejudice that would result, especially in light of the agreements between counsel about the outstanding discovery to be completed (but which is only necessary if this Board does not grant Registrant's cross-motion.) For all the reasons previously set forth in Registrant's papers, this Board should grant Registrant's cross-motion for summary judgment.

Registrant hereby addresses and replies to two issues raised by Petitioner in its October 20, 2008 brief in opposition to Petitioner's cross-motion for summary judgment. First, Petitioner asserts that Registrant is somehow prohibited from offering into evidence for the Board's consideration other third-party applications and findings by the USPTO. (See Petitioner's Brief in Opposition to Cross-Motion for Partial Summary Judgment at p. 5.) Petitioner is simply wrong, and fails to cite any authority for such a proposition. In fact, the authority cited by Petitioner has no bearing to the procedural posture of this proceeding—and the idea that the evidence is inadmissible for the Board's consideration flies in the face of the rules as set forth in the TBMP.

Second, Petitioner argues that the Board should also not consider all of the evidence related to the English translations of "morena" as found in the USPTO records that supports the English translation of Registrant's mark. (*Id.* At p. 6) Such an assertion is also unfounded in law, and likewise contrary to the law as it relates to the analysis of the mark when certain words are disclaimed.

I.
LAW AND ARGUMENT

A. Trademark Applications and Office Actions Are Admissible and Relevant.

Contrary to Petitioner's assertion, it has failed to overcome the admissible evidence and prior ruling of the United States Patent and Trademark Office ("USPTO") that Registrant's mark "AZUCAR MORENA" is arbitrary as related to its goods and services. The USPTO, on September 11, 2008 analyzed and found that Registrant's mark "AZUCAR MORENA" is an arbitrary term in relation to Registrant's goods in registration number 2476161. (Parker Decl. Exh. B filed on 09/29/08) In that Office Action, the USPTO refused Applicant Interex Corporation's attempt to register the mark "MORENA DEL CAMPO." The USPTO analyzed the "MORENA DEL CAMPO" mark with an existing "LA MORENA MAS DULCE" mark *and Registrant's mark here, "AZUCAR MORENA,"* to determine the likelihood of confusion if applicant's "MORENA DEL CAMPO" mark was introduced into the marketplace. (*Id.*) The USPTO found that applicant's mark, "MORENA DEL CAMPO," would create a likelihood of confusion with Registrant's mark. (*Id.*) In refusing applicant's mark, the USPTO found that the phrase "MORENA DEL CAMPO" translates into "the brown field," and that Zucrum's mark here translates to "sugar beautiful dark-complexioned brunette Latin girl." (*Id.*) Accordingly, the USPTO found that "all of the respective marks incorporate the term MORENA which appears to be an arbitrary term in relation to the parties' respective goods." (*Id.*)

The USPTO went on to say that in analyzing a trademark application, "the overriding concern is not only to prevent buyer confusion as to the source of the goods, but to protect the registrant from adverse commercial impact due to use of a similar mark by a newcomer." (*Id.*) Accordingly, the USPTO refused applicant's "MORENA DEL CAMPO" mark in part because

Registrant's mark "AZUCAR MORENA" was an arbitrary term, and applicant's mark would cause confusion in the marketplace. (*Id.*).

The action taken by the USPTO is certainly admissible evidence, and Petitioner has provided no authority to the contrary. In fact, third-party applications, third-party registrations, and their file histories are admissible evidence for consideration by the Board. "A party to a proceeding before the Board may introduce ... a copy of an application that is not the subject of the proceeding..." TBMP § 704.03(b)(2); 37 CFR § 2.122(e). "A party in an *inter partes* proceeding before the Board may introduce as part of its evidence in the case, a registration owned by a party not involved in the proceeding." 704.03(b)(1(B); 37 CFR sec. 2.122(e). Certainly evidence admissible at trial is admissible at the summary judgment stage. The September 11, 2008 Office Action was evidence was properly put before the Board for its consideration as Exhibit B to the declaration of Robert "Ted" Parker filed on September 29, 2008, and which Office Action is part of the official record of the USPTO.

B. Petitioner's assertion regarding the inadmissibility of an applicant's "collateral attack" of other registrations in an ex parte examination is inapplicable because Petitioner is not an "applicant"; this is an inter partes proceeding, and Registrant is in fact relying on the USPTO findings – not attacking it.

Petitioner cites to 15 U.S.C. § 1057(b), the TMEP, and a string of cases found therein as support for its position that the September 11, 2008 Office Action finding Registrant's mark to be arbitrary is irrelevant. Petitioner's citation to 15 U.S.C. § 1057(b) is a bit perplexing, and flies in the face of what Petitioner argues. The Petitioner states, "The examining attorney's presumption is not evidence that Registrant's ... registration is valid." (Petitioner's Opposition Brief at p. 5) However, 15 U.S.C. § 1057(b) stands for the very basic, but ever important legal premise, that with a registration comes the presumption and *prima facie* evidence that a mark is valid, the registration is valid, the registrant owns the mark, and that the registrant enjoys

exclusive use of the mark with the specified goods. For Petitioner to state that the hearing examiner in the September 11, 2008 Office Action somehow misunderstood the presumption of validity that flows to a registrant appears to be a basic misunderstanding of trademark law.

Although Petitioner accurately cites a proposition found in the TMEP that “collateral attacks” on registrations are not relevant during an ex parte examination, that is not the fact pattern here. Petitioner is not an “applicant.” Petitioner is a competitor in the marketplace who is seeking to cancel Registrant’s mark in order to trade on the goodwill already associated with AZUCAR MORENA in the United States, a market that petitioner wants to enter.

In *In re Pollio Dairy Products*, the court refused to allow an applicant, while challenging its refusal of registration, to attack other registrations. Instead, the applicant was required to bring a petition to cancel rather than such a “collateral attack.” 8 U.S.P.Q. 2d 2012, 2014-15 (TTAB 1988). In *In re Dixie Restaurants*, Dixie was “merely attempting to circumvent the statutory requirement that arguments that a mark has been abandoned be brought in a cancellation proceeding” by collaterally attacking another registration while it appealed its own mark’s refusal. 105 F3d 1405, 1407 (Fed. Cir. 1997). Similar factual scenarios occurred in the other cases cited by Petitioner. Such a factual scenario is not occurring here.

Here, Registrant is not attacking anything. It is citing to admissible, persuasive, and consistent evidence of the validity of its registration. Further, the Petitioner is not an applicant of a mark at issue in an ex parte examination, but instead *has brought* a petition to cancel in an inter partes proceeding. Petitioner’s citation to those “collateral attack” authorities is not on point; and as previously set forth – such evidence of other third-party applications is admissible and relevant.

C. Petitioner Mischaracterizes Registrant's Evidence of Other "Morena" Marks and the Board Should Consider the English Translation of "Morena."

Registrant offered other third-party registrations incorporating the word English translation of "morena" to not only show that no alleged fraud occurred at the USPTO, but also as further evidence that the English translation of "morena" supports that Registrant's entire mark is not descriptive of Registrant's goods. Instead, it is arbitrary as found by the USPTO.

Registrant cited third party registrations for marks containing "morena" to show that no fraud had been perpetrated on the USPTO as to the English definition of the Spanish word "morena." The Registrant did not procure the mark fraudulently and Petitioner falls woefully short of meeting the standard of proof for fraud. Petitioner alleges that the USPTO somehow was unaware of the various English translations for "AZUCAR MORENA." Petitioner fails to acknowledge that it was the USPTO itself that brought to the light an English translation of "sugar brown." Petitioner further fails to acknowledge that the USPTO fully considered and analyzed the issue and allowed the mark to register.

The meaning of Registrant's mark cannot be understood by a literal translation from Spanish into English. "Morena" used alone translates into "dark-complexioned" or "sun-tanned." However, when the word "morena" is used as a noun and combined with another word, "morena" means a dark-complexioned brunette girl of Latin descent. (Jorge Decl at ¶5 filed on 09/29/08) The USPTO was fully aware of this and accepted this translation when the mark was originally registered. The USPTO was not only fully aware of this English translation, but has since repeatedly accepted these translations in other registrations and trademark applications. (See Parker Decl. at ¶2 and Exhibit A filed on 09/29/08)

Evidence of the translation of "morena" is relevant to show that Registrant's mark is not generic. It is true that marks are to be compared in their entireties for purposes of likelihood of

confusion. However, it is not improper to give more or less weight to a particular feature of a mark. *In re Dixie Rests.*, 100 F.3d 1405 (court upheld focus on word “delta” where “café” was disclaimed); *In re National Data Corp.*, 753 F.2d 1056, 1058 (Fed. Cir. 1985) (“there is nothing improper in stating that, for rational reasons, more or less weight has been given to a particular feature of a mark”). Disclaimed matter is typically less significant or less dominant when comparing marks. One feature of a mark may be more significant in creating a commercial impression. Registrant had disclaimed “azucar” in its registration. Just as in *In re Dixie Restaurants*, it is proper for the Board to look to the English translation of “morena” when “azucar” has been disclaimed. (See for e.g. “La Morena” –the English translation is “dark skinned” or “brunette female; ” “Bella Morena” – the English translation is “beautiful dark-haired/dark-featured woman;” La Morena Mas Dulce –the English translation is “the sweetest beautiful brunette Latin girl;” “Mi Morena” – the English Translation is “my brunette.” – Parker Decl. Exhibit A filed on 09/29/08).

II. **CONCLUSION**

Registrant respectfully requests this Board to deny Petitioner’s motion for summary judgment and grant Registrant’s cross-motion for summary judgment.

Respectfully submitted this 4th day of November, 2008.

K&L GATES, LLP

By Robert Ted Parker
Robert Ted Parker
Attorney for Registrant Zucrum Foods, LLC

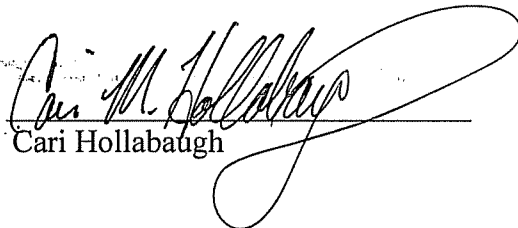
CERTIFICATE OF SERVICE

Cari Hollabaugh, hereby certify that a true and complete copy of the foregoing document: **Reply Brief in Support of Registrant's Cross-Motion for Summary Judgment Regarding the Issue of Genericness**, was served on Attorneys for Registrant on November 4, 2008 by enclosing a copy of said documents in an envelope addressed as set forth below and by causing such envelope to be delivered as indicated below:

Addressee: Gregory N. Owen
Owen, Wickersham & Erickson, P.C.
455 Market Street, Suite 1910
San Francisco, CA 94105

- BY MAIL: A true and correct copy of such document was placed in a sealed envelope, addressed as shown above, and such correspondence was deposited, with postage fully prepaid, in a United States Post Office mail box at Spokane, WA on the same day in the ordinary course of business.
- BY PERSONAL SERVICE: A true and correct copy of such document was placed in a sealed envelope, addressed as shown above and the undersigned caused such envelope to be delivered by hand to the offices of the addressee.
- BY FACSIMILE: Such document was faxed to the facsimile transmission machine with the facsimile machine number stated above. Upon completion of the transmission, the transmitting machine issued a transmission report showing the transmission was complete and without error.
- BY ELECTRONIC MAIL: Such document was transmitted to the e-mail address listed above. The e-mail was not returned as undeliverable

I declare, under penalty of perjury, that the foregoing is true and correct and is executed
November 4, 2008 at Spokane, Washington.


Cari Hollabaugh

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