

ESTTA Tracking number: **ESTTA291435**

Filing date: **06/23/2009**

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

Proceeding	92051037
Party	Plaintiff CASA LATINO REAL ESTATE CORP.
Correspondence Address	Mitchell P. Novick, Esq. Law Offices Of Mitchell P. Novick 623 Eagle Rock Avenue, Suite 407 West Orange, NJ 07052 UNITED STATES mnovick@mitchellnovick.com
Submission	Motion to Amend Pleading/Amended Pleading
Filer's Name	Mitchell P. Novick
Filer's e-mail	mnovick@mitchellnovick.com
Signature	/mitchell p. novick/
Date	06/23/2009
Attachments	1573conc.mot.pdf ( 2 pages )(54677 bytes ) 1573canc2.pet.pdf ( 6 pages )(61129 bytes )



Registrant to respond to the Amended Petition is hereby extended through and until August 3, 2009.

Respectfully submitted,

LAW OFFICES OF MITCHELL P. NOVICK

By:           /mitchell p. novick/            
MITCHELL P. NOVICK, ESQ.

Dated: June 23, 2009

Counsel for Petitioner  
CASA LATINO REAL ESTATE CORP.  
623 Eagle Rock Avenue, Suite 407  
West Orange, New Jersey 07052  
Phone: 973/744-5150  
Fax: 973/744-2227  
Email: mnovick@mitchellnovick.com

Consented as to #1 above:

CANTOR COLBURN LLP

By:           /daniel e. bruso/            
DANIEL E. BRUSO, ESQ.

Counsel for Registrant  
CASA LATINO LICENSING LLC  
20 Church Street  
22nd Floor  
Hartford, Connecticut 06103-3207  
Phone: (860) 286-2929  
Fax: (860) 286-0115  
Email: DBruso@CantorColburn.com

Dated: June 23, 2009

We hereby stipulate as to #2 above:

LAW OFFICES OF MITCHELL P. NOVICK

CANTOR COLBURN LLP

By:           /mitchell p. novick/            
MITCHELL P. NOVICK, ESQ.  
Counsel for Petitioner

By:           /daniel e. bruso/            
DANIEL E. BRUSO, ESQ.  
Counsel for Registrant

Dated: June 23, 2009

Dated: June 23, 2009

1892-1573



follows:

1. Petitioner, established in April 2006, is a well-known provider of real estate agency and real estate brokerage services ("Petitioner's Services").
2. Since at least as early as May 2006, Petitioner has used the name and mark CASA LATINO REAL ESTATE CORP. in connection with Petitioner's Services.
3. Upon information and belief, as a result of the long, extensive, and widespread use, advertising, and promotion of the name and mark CASA LATINO REAL ESTATE CORP. on and in association with Petitioner's Services, consumers have become accustomed to associate such name and mark substantially exclusively with Petitioner.
4. Upon information and belief, as a result of the long, extensive, and widespread use, advertising, and promotion of the name and mark CASA LATINO REAL ESTATE CORP. on and in association with Petitioner's Services, the name and mark CASA LATINO REAL ESTATE CORP. has acquired substantial goodwill and is an asset of enormous value.

REGISTRATION NO. 3,488,702 WAS OBTAINED FRAUDULENTLY

5. Registrant filed an application with the United States Patent and Trademark Office ("USPTO") to register CASA LATINO for use with "Real estate agencies; Real estate brokerage" in Class 36 on April 24, 2006 ("Subject Application"). The Subject Application

was assigned Serial No. 78/868,547. The Subject Application was filed using the USPTO's electronic filing system.

6. As part of the Subject Application, Registrant declared under oath, being warned that willful false statements, and the like, may jeopardize the validity of the Subject Application, that the date of first use anywhere of the mark which is the subject of this application, in connection with all the services identified in this application, was at least as early as January 1, 2006.
7. Upon information and belief, Registrant was not using the mark CASA LATINO on all the services identified in the Subject Application, at least as early as January 1, 2006.
8. Upon information and belief, Registrant did not begin using the mark CASA LATINO on all the services identified in the Subject Application until after the filing of the Subject Application.
9. Upon information and belief, such declaration was made in bad faith and in an attempt to perpetrate a fraud upon the USPTO because Registrant knew or should have known when it filed the application that it was not using the mark CASA LATINO in connection with all the services identified in application Serial No. 78/868,547, at least as early as January 1, 2006.
10. Reasonably relying on the truth of such materially false statement, the USPTO approved application Serial No. 78/868,547, for registration, resulting in Registration No. 3,488,702 issuing on August 19, 2008 ("Subject Registration").

11. Upon information and belief, the conduct of Registrant constitutes fraud on the USPTO and therefore the Subject Registration should be canceled.

LIKELIHOOD OF CONFUSION

12. Upon information and belief, any use by Registrant of the mark CASA LATINO on the services identified in the Subject Application did not begin until after the Petitioner commenced using the name and mark CASA LATINO REAL ESTATE CORP. in connection with Petitioner's Services.
13. Petitioner has continuously used in commerce its name and mark CASA LATINO REAL ESTATE CORP. in connection with Petitioner's Services prior to any use by Registrant of the mark CASA LATINO on the services identified in the Subject Application.
14. Upon information and belief, the services that are identified in the Subject Registration are related or virtually identical to Petitioner's Services offered in connection with its name and mark CASA LATINO REAL ESTATE CORP.
15. Upon information and belief, the services that are identified in the Subject Registration will be encountered by the same or similar class of purchasers who are familiar with and interested in the services offered by Petitioner in connection with its name and mark CASA LATINO REAL ESTATE CORP. Additionally, upon information and belief, the channels of trade for the respective products overlap.

16. Upon information and belief, the marks that is identified in the Subject Registration so resembles Petitioner's previously used name and mark CASA LATINO REAL ESTATE CORP. as to be likely to cause confusion, mistake, or deception. Consumers are likely to believe that there is a connection between Petitioner and Registrant and are likely to be confused, mistaken, and deceived in to believing that the services of Registrant and provided, sponsored, licensed, or approved by Petitioner or believe that Petitioner and Registrant respective goods emanate from the same source; and/or that Petitioner is in some other fashion connected or associated with Registrant when it is not, thereby creating damage to Petitioner within the meaning of 15 U.S.C. 1064.
17. Upon information and belief, for the foregoing reasons, the contemporaneous use and continued registration by Registrant of the Subject Registration is likely to cause consumer confusion, mistake, and deception under 15 U.S.C. 1052(d) and 15 U.S.C. 1125(a).
18. Upon information and belief, Petitioner will be damaged by the continued registration of the Subject Registration because such registration would support and assist Registrant in the confusing, misleading, and/or deceptive use of Registrant's alleged marks which are the subject of this Cancellation, and would give color of exclusive statutory rights to Registrant in violation and degradation of Petitioner's prior rights. Therefore, continued registration of the Subject Registration is damaging to Petitioner's common law mark for its name and mark



CASA LATINO REAL ESTATE CORP.

WHEREFORE, Petitioner respectfully requests that this Amended Petition be granted and that registration of the mark shown in Registration No. 3,488,702 be in all respects canceled.

Dated: June 23, 2009

Respectfully submitted,

LAW OFFICES OF MITCHELL P. NOVICK

By:           /mitchell p. novick/            
MITCHELL P. NOVICK, ESQ.

Counsel for Petitioner  
CASA LATINO REAL ESTATE CORP.  
623 Eagle Rock Avenue, Suite 407  
West Orange, New Jersey 07052  
Phone: 973/744-5150  
Fax: 973/744-2227  
Email: mnovick@mitchellnovick.com

1892-1573