

ESTTA Tracking number: **ESTTA587655**

Filing date: **02/17/2014**

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

Petition for Cancellation

Notice is hereby given that the following party requests to cancel indicated registration.

Petitioner Information

Name	MTC, Inc.		
Entity	Corporation	Citizenship	Texas
Address	800 Dolorosa, Suite 204 San Antonio, TX 78207 UNITED STATES		

Attorney information	William B. Nash Haynes and Boone, LLP 112 E. Pecan, Suite 1200 San Antonio, TX 78205 UNITED STATES ipdocketing@haynesboone.com, jason.whitney@haynesboone.com, bill.nash@haynesboone.com, venisa.dark@haynesboone.com, dorothea.martinez@haynesboone.com Phone:210-978-7477
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Registrations Subject to Cancellation

Registration No	3575223	Registration date	02/17/2009
Registrants	Jose Nicholas Morales 16689 Weld County Road 13 Platteville, CO 80651 MXX Manual Morales 150 Wolfensberger Road Castle Rock, CO 80104 MXX		

Goods/Services Subject to Cancellation

Class 043. First Use: 1989/01/01 First Use In Commerce: 1989/01/01 All goods and services in the class are cancelled, namely: Bar and restaurant services
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Grounds for Cancellation

Priority and likelihood of confusion	Trademark Act section 2(d)		
Registration No	3629655	Registration date	06/02/2009
Registrants	Morales, Jose Nicholas 16689 Weld County Road 13 Platteville, CO 80651 MXX Morales, Manual 150 Wolfensberger Road Castle Rock, CO 80104		

	MXX
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Goods/Services Subject to Cancellation

Class 043. First Use: 1980/01/01 First Use In Commerce: 1980/01/01 All goods and services in the class are cancelled, namely: Restaurant and bar services
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Grounds for Cancellation

Priority and likelihood of confusion	Trademark Act section 2(d)
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Mark Cited by Petitioner as Basis for Cancellation

U.S. Registration No.	2210188	Application Date	03/14/1997
Registration Date	12/15/1998	Foreign Priority Date	NONE
Word Mark	LA MARGARITA		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 042. First use: First Use: 1981/05/00 First Use In Commerce: 1981/05/00 restaurant, bar, catering, and preparedtake-out food services		

Attachments	75257363#TMSN.gif(bytes) PetitionToCancel3575223and3629655.pdf(476166 bytes)
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Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/William Nash/
Name	William B. Nash
Date	02/17/2014

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

In re:

Reg. No. 3,575,223

Mark:



Reg. No. 3,629,655

Mark:



MTC, INC.,
Petitioner,

v.

JOSE NICHOLAS MORALES and
MANUAL MORALES,
Respondents.

Cancellation No.:

PETITION TO CANCEL

MTC, Inc. (“MTC”) files this Petition to Cancel U.S. Registration Nos. 3,575,223 and 3,629,655.

**I.
Facts**

A. MTC’s Federal Trademark Registration

1. MTC is a corporation, duly formed and existing under the laws of the State of Texas, having its principal place of business in Bexar County, Texas.

2. MTC owns the federally-registered trademark LA MARGARITA for “restaurant, bar, catering, and prepared take-out food services” (the “MTC Mark”), identified in U.S. Registration No. 2,210,188, which was filed March 14, 1997 and which registered December 15,

1998 (the “**MTC Registration**”). The MTC Registration has a date of first use of at least as early as May 1981. The MTC Registration is on the Principal Register under the Lanham Act. Attached as Exhibit A is a true and correct copy of the registration certificate for the MTC Registration.

3. On January 6, 2004, MTC filed Section 8 and Section 15 declarations for the MTC Registration. The U.S. Trademark Office accepted MTC’s Section 8 and Section 15 declarations on March 3, 2004. Accordingly, the MTC Registration is incontestable under Section 15.

4. As an incontestable registration, the MTC Registration provides:

[C]onclusive evidence of the validity of the registered mark and of the registration of the mark, of the registrant’s ownership of the mark, and of the registrant’s exclusive right to use the registered mark in commerce.

15 U.S.C. § 1115 (b).

5. The MTC Registration has been renewed, is in full force and effect, and is owned by MTC.

B. MTC’s State Trademark Registrations

6. In addition to its federal registration, MTC owns the Texas-registered trademark LA MARGARITA for “restaurant services,” identified in Texas Registration No. 5136617 (originally 51366), which was filed May 28, 1991 and which was registered November 1, 1991. Attached as Exhibit B is a true and correct copy of the Texas registration certificate.

7. MTC also owns the Texas-registered trademark LA MARGARITA (stylized) for “restaurant, catering, and prepared take-out food services,” identified in Texas Registration No. 5648917 (originally 56489), which was filed on March 17, 1997 and which registered March 17, 1997. Attached as Exhibit C is a true and correct copy of the Texas registration certificate.

8. The Texas registration certificates for LA MARGARITA and LA MARGARITA (stylized) each constitute prima facie evidence of:

- (1) the validity of the registration;
- (2) the registrant’s ownership of the mark; and
- (3) the registrant’s exclusive right to use the mark in commerce in [Texas] in connection with the goods or services specified in the certificate, subject to any conditions and limitations stated in the certificate.

Tex. Bus. & Com. Code § 16.15(c).

9. The registrations in Exhibit B and Exhibit C have been renewed, are in full force and effect, and are owned by MTC.

C. MTC’s Use of LA MARGARITA

10. MTC began using the MTC Mark in commerce at least as early as May 1981.


11. MTC began using the MTC Mark in commerce at least as early as the opening of the LA MARGARITA Mexican restaurant in San Antonio, Texas.


12. MTC continues to use the MTC Mark today.

13. MTC has continuously used the MTC Mark to identify restaurant, bar, catering, and prepared take-out food services since at least as early as May 1981.

D. The Moraleses’ Trademark Registrations

14. The Trademark Applications and Registrations Retrieval (“**TARR**”) database identifies Jose Nicholas Morales and Manual Morales as the owners of record for the following federal registrations (the “**Morales Registrations**”):

Reg. No.	Mark	Services	Filed	Registered
3,575,223		Bar and restaurant services	Apr. 2, 2008	Feb. 17, 2009

Reg. No.	Mark	Services	Filed	Registered
3,629,655		Restaurant and bar services	Apr. 1, 2008	June 2, 2009

15. The Morales Registrations assert a date of first use in commerce for



and (the “Morales Marks”) of January 1, 1989 and January 1, 1980, respectively.

16. The website  appears at the bottom



of the specimen of use submitted for the mark.

17. The webpage located at <http://www.lasmargaritasrest.com/home.html> states that the “Las Margaritas Restaurant” was “founded by Morales-Ramos Family in 1983.”



18. On information and belief, the first use in commerce for occurred no earlier than 1983.

19. The Morales Registrations both disclaim, among other wording, the phrase FAMILY MEXICAN RESTAURANT.

20. In both of the Morales Registrations, the Trademark Attorney found the wording FAMILY MEXICAN RESTAURANT to “describe[] the nature of applicant’s establishment.”

21. According to the TARR database, the current correspondence addresses of record for Jose Nicholas Morales and Manual Morales are 16689 Weld County Road 13 Platteville, Colorado 80651 and 150 Wolfensberger Road Castle Rock, Colorado 80104, respectively.

II.

Cancellation Based on Likelihood of Confusion (15 U.S.C. § 1052(d))

22. MTC owns the MTC Registration.
23. The MTC Registration claims the MTC Mark.
24. MTC has not abandoned the MTC Mark or the MTC Registration.
25. The United States Patent and Trademark Office issued the MTC Registration in December 1998.
26. The Moraleses filed their federal trademark applications for the Morales Marks in April 2008, more than nine years after the United States Patent and Trademark Office issued the MTC Registration.
27. The Morales Registrations issued in 2009, more than ten years after the United States Patent and Trademark Office issued the MTC Registration.
28. The MTC Registration and the Morales Registrations identify identical services in part, including restaurant services and bar services.
29. The MTC Registration and the Morales Registrations identify overlapping services, at least in part.
30. The MTC Mark and the Morales Marks are highly similar in appearance, sound, connotation, and commercial impression.
31. The dominant portion of the MTC Mark is the word MARGARITA.
32. The dominant portion of the Morales Marks is the word MARGARITAS.
33. MARGARITAS is the plural form of MARGARITA.

34. LAS MARGARITAS is the plural form of LA MARGARITA.
35. MARGARITAS is highly similar to MARGARITA.
36. LAS MARGARITAS is highly similar to LA MARGARITA.
37. The wording FAMILY MEXICAN RESTAURANT in the Morales Marks is descriptive.
38. The wording FAMILY MEXICAN RESTAURANT in the Morales Marks does not serve to distinguish the source of restaurant services or bar services.
39. Consumers are not likely to rely upon the wording FAMILY MEXICAN RESTAURANT in the Morales Marks to distinguish restaurant services or bar services.
40. The design elements in the Morales Marks do not serve to distinguish the source of restaurant services or bar services.
41. Consumers are not likely to rely upon the design elements in the Morales Marks to distinguish restaurant services or bar services.
42. The Morales Marks so resemble the MTC Mark as to be likely, when used on or in connection with restaurant services or bar services, to cause confusion, or to cause mistake, or to deceive.
43. The Morales Registrations should be cancelled because the Morales Marks so resemble the MTC Mark, which was registered with the United States Patent and Trademark Office long before the applications for the Morales Marks were filed, as to be likely, when used on or in connection with restaurant services or bar services, to cause confusion, or to cause mistake, or to deceive.
44. MTC is being damaged by the continued registration of the Morales Registrations.

PRAYER

WHEREFORE, MTC, Inc. believes it is being damaged by the continued registration of U.S. Registration Nos. 3,575,223 and 3,629,655, and respectfully prays for cancellation of those registrations.

Dated: February 17, 2014.

Respectfully submitted,

HAYNES AND BOONE, LLP

/s/ Bill Nash /s/

William B. Nash, Reg. No. 33,743
Jason W. Whitney, Reg. No. 67,408
112 E. Pecan Street, Suite 1200
San Antonio, Texas 78205
Telephone: (210) 978-7000
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Email: jason.whitney@haynesboone.com

**ATTORNEYS FOR PETITIONER,
MTC, INC.**

CERTIFICATE OF SERVICE

This is to certify that a true and correct copy of the foregoing and any attachments has been served by U.S. First Class Mail, postage prepaid, this February 17, 2014 at the following correspondence addresses of record:

Jose Nicholas Morales
16689 Weld County Road 13
Platteville, Colorado 80651

Manual Morales
150 Wolfensberger Road
Castle Rock, Colorado 80104

/s/ Bill Nash /s/

William B. Nash

Exhibit A

Int. Cl.: 42

Prior U.S. Cls.: 100 and 101

United States Patent and Trademark Office

Reg. No. 2,210,188

Registered Dec. 15, 1998

**SERVICE MARK
PRINCIPAL REGISTER**

LA MARGARITA

M.T.C., INC. (TEXAS CORPORATION)
800 DOLOROSA, SUITE 204
SAN ANTONIO, TX 78207

FIRST USE 5-0-1981; IN COMMERCE
5-0-1981.
SEC. 2(F).

FOR: RESTAURANT, BAR, CATERING, AND
PREPARED TAKE-OUT FOOD SERVICES, IN
CLASS 42 (U.S. CLS. 100 AND 101).

SER. NO. 75-257,363, FILED 3-14-1997.

RICHARD KIM, EXAMINING ATTORNEY

Exhibit B



The State of Texas
Secretary of State

CERTIFICATE OF TRADEMARK OR SERVICE MARK REGISTRATION

FOR

LA MARGARITA

REGISTRATION NUMBER 051366

The undersigned, as Secretary of State of the State of Texas, by virtue of the authority vested in the Secretary by **CHAPTER 16, TEXAS BUSINESS AND COMMERCE CODE** hereby issues this Certificate of Trademark or Service Mark Registration and attaches hereto a copy of the application for registration. Such registration is effective for a term of ten years from the date of registration of the application and shown below.

DATED: 11-01-91



John Hannah Jr
Secretary of State

Exhibit C



The State of Texas

SECRETARY OF STATE

CERTIFICATE OF TRADEMARK OR SERVICE MARK REGISTRATION

FOR

LA MARGARITA & DESIGN

REGISTRATION NUMBER 56489

The undersigned, as Secretary of State of Texas, by virtue of the authority vested in the Secretary by CHAPTER 16, TEXAS BUSINESS AND COMMERCE CODE hereby issues this Certificate of Trademark or Service Mark Registration and attaches hereto a copy of the application for registration. Such registration is effective for a term of ten years from the date of registration of application shown below.

DATED: March 17, 1997



Antonio O. Garza, Jr.
Secretary of State