

ESTTA Tracking number: **ESTTA744419**

Filing date: **05/04/2016**

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	CONSUELO ONGPAUCO-CAUTON		
Entity	Individual	Citizenship	PHILIPPINES
Address	10252 HADLEY AVENUE NORTHRIDGE, CA 91324 UNITED STATES		
Attorney information	Melvin N.A. Avanzado, Elaine W. Yu The Avanzado Law Firm 1880 Century Park East Suite 1100 LOS ANGELES, CA 90067 UNITED STATES mel@avanzadolaw.com, elaine@avanzadolaw.com Phone:3105529300		

Registration Subject to Cancellation

Registration No	4034365	Registration date	10/04/2011
Registrants	RONO, JUNE FRANCIS 1629 WHARTON ROAD SAN JOSE, CA 95132 UNITED STATES RONO, ASHLEY KIRSTEN C. 1629 WHARTON ROAD SAN JOSE, CA 95132 UNITED STATES RONO, JUSTIN CHRISTIAN C. 4034365 SAN JOSE, CA 95132 UNITED STATES		

Goods/Services Subject to Cancellation

Class 043. First Use: 2011/01/03 First Use In Commerce: 2011/01/03
All goods and services in the class are cancelled, namely: Fast-food restaurants


Grounds for Cancellation

Priority and likelihood of confusion	Trademark Act Sections 14(1) and 2(d)
Registrant not rightful owner of mark for identified goods or services	Trademark Act Sections 14(1) and 1
The registration is being used by, or with the permission of, the registrant so as to misrepresent the source of the goods or services on or in connection with which the mark is used	Trademark Act Section 14(3)

Fraud on the USPTO	Trademark Act Section 14(3); In re Bose Corp., 580 F.3d 1240, 91 USPQ2d 1938 (Fed. Cir. 2009)
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Related Proceedings	United States District Court, Northern District of California Case No. 4:15-cv-02669-JSW; Trademark Application Serial No. 86/528,183; Trademark Application Serial No. 85/951,658; Trademark Application Serial No. 86/490,510.
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Mark Cited by Petitioner as Basis for Cancellation

U.S. Application No.	85951658	Application Date	06/05/2013
Registration Date	NONE	Foreign Priority Date	NONE
Word Mark	THE ORIGINAL BARRIO FIESTA OF MANILA		
Design Mark			
Description of Mark	The mark consists of a design of a pot, with a lid, over flames and the stylized words The Original Barrio Fiesta of Manila.		
Goods/Services	Class 043. First use: First Use: 1987/08/15 First Use In Commerce: 1987/08/15 Restaurant services		

Attachments	85951658#TMSN.png(bytes) 2016-05-04 Petition to Cancel Caution FINAL with exhibits and POS.pdf(332818 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 Overnight Courier on this date.

Signature	/Elaine Yu/
Name	Elaine Yu
Date	05/04/2016

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

In the Matter of Registration No. 4,034,365
Mark: BARRIO FIESTA EXPRESS
Date Issued: October 4, 2011

CONSUELO ONGPAUCO-CAUTON,

Petitioner,

v.

JUNE FRANCIS RONO, ASHLEY KIRSTEN
C. RONO AND JUSTIN CHRISTIAN C.
RONO,

Registrants.

Cancellation No.

PETITION TO CANCEL

Petitioner Consuelo Ongpauco-Cauton (“Petitioner”), for her petition to cancel Registration No. 4,034,365, states as follows:

1. Petitioner is an individual with an address at 10252 Hadley Avenue, Northridge, California 91324.

2. By assignment dated December 8, 2014, June Francis Rono, Ashley Kirsten C. Rono and Justin Christian C. Rono (collectively, “Registrants”) became the current owners of the mark BARRIO FIESTA EXPRESS Registration No. 4,034,365 (the “‘365 Mark”) in the International Class 043 (fast food restaurants). The ‘365 Mark was issued on October 4, 2011. The alleged first use of BARRIO FIESTA EXPRESS for the ‘365 Mark was January 3, 2011.

3. Petitioner is the owner, operator and franchisor of restaurants in the United States which serve Filipino food under the mark THE ORIGINAL BARRIO FIESTA OF MANILA. Petitioner uses the mark THE ORIGINAL BARRIO FIESTA OF MANILA for “Restaurant” services in International Class 042. Petitioner has used THE ORIGINAL BARRIO

FIESTA OF MANILA mark continuously since at least as early as 1987 in California. Petitioner owns the mark THE ORIGINAL BARRIO FIESTA OF MANILA which was registered with the California Secretary of State on October 3, 2001 under Registration No. 55,400 and renewed through October 2, 2016. Petitioner's restaurants are also known by the short form mark BARRIO FIESTA. Petitioner has used the logo in Exhibit "A" containing THE ORIGINAL BARRIO FIESTA OF MANILA mark since 1987 (the "BF Restaurant Logo").

4. Petitioner is the daughter of Sixta-Evangelista Ongpauco who first used the BARRIO FIESTA mark in the Philippines in or about 1958. Petitioner is one of eight children of Mrs. Ongpauco. These children opened and operated their own restaurants using the BARRIO FIESTA mark. By the 1980s, BARRIO FIESTA had approximately 30 restaurants in the Philippines owned and operated by one or more of the Ongpauco children. BARRIO FIESTA has attained secondary meaning in the Philippines for restaurant services and has been recognized as one of the iconic brands of the Philippines.

5. In or about 1987, Petitioner's sister, Corazon Ongpauco-Tamayo, opened the first BARRIO FIESTA Restaurant in the United States – specifically in Los Angeles, California ("Barrio Fiesta – Los Angeles"). Barrio Fiesta – Los Angeles used THE ORIGINAL BARRIO FIESTA OF MANILA mark, and the BF Restaurant Logo, the first use of that mark and any BARRIO FIESTA related mark in the United States.

6. In or about 1993, Petitioner and her husband, Cesar Cauton, took over Barrio Fiesta – Los Angeles from Corazon Ongpauco-Tamayo. Petitioner thereby obtained the rights to THE ORIGINAL BARRIO FIESTA OF MANILA mark and the stylized depiction of that mark in the BF Restaurant Logo from her sister.

7. In or about 1999, Petitioner moved Barrio Fiesta – Los Angeles to Glendale, California. Petitioner continued to use THE ORIGINAL BARRIO FIESTA OF MANILA mark and BF Restaurant Logo signage at the Glendale location. Petitioner operated this BARRIO FIESTA Restaurant at the Glendale location until about summer 2005.

8. In or about 2001, Petitioner opened another BARRIO FIESTA Restaurant in Lakewood, California. Petitioner used the same signage and marks as THE ORIGINAL BARRIO FIESTA OF MANILA signage and marks used in Barrio Fiesta – Los Angeles. Petitioner closed this restaurant location in or about 2004.

9. Shortly after Petitioner closed the BARRIO FIESTA Restaurant at the Glendale location in or about early 2006, Petitioner opened a BARRIO FIESTA Restaurant in Eagle Rock, California (“Barrio Fiesta – Eagle Rock”). Barrio Fiesta – Eagle Rock used THE ORIGINAL BARRIO FIESTA OF MANILA mark and the BF Restaurant Logo. In or about 2010, Petitioner closed Barrio Fiesta – Eagle Rock with the intent to relocate the BARRIO FIESTA Restaurant back to Glendale, California. Subsequently, this new Barrio Fiesta restaurant opened, and continues to do business, in Glendale under a different owner to whom Petitioner authorized to operate that restaurant.

10. In or about January 2013, Petitioner opened a BARRIO FIESTA Restaurant in North Hills, California (“Barrio Fiesta – North Hills”). Petitioner continues to operate Barrio Fiesta – North Hills to this day. Barrio Fiesta – North Hills has used – and continues to use – THE ORIGINAL BARRIO FIESTA OF MANILA mark and the BF Restaurant Logo.

11. Well before Registrants registered the ‘365 Mark, members of the Ongpauco family obtained numerous registrations and attempted other registrations of BARRIO FIESTA related marks. There have also been a number of proceedings arising from BARRIO FIESTA related marks that preceded Applicants’ ‘365 Mark.

12. On or about October 29, 1986, The Manila Restaurant, Inc. registered the service mark BARRIO FIESTA with the State of California. This service mark registration number 28689 was for restaurant services. The service mark application for BARRIO FIESTA states that the service mark was first used anywhere in 1958 and first used in California in December 4, 1985. Petitioner is informed and believes that this 1986 California registration was the first registration involving any mark related to BARRIO FIESTA.

13. On or about April 23, 1990, The Manila Restaurant, Inc. assigned the BARRIO FIESTA service mark to Corazon Ongpauco-Tamayo, her husband Manuel Tamayo, and Sixta-Evangelista Ongpauco. Each individual had a one-third interest in the service mark. Petitioner obtained the rights to the BARRIO FIESTA service mark when she obtained Barrio Fiesta – Los Angeles from her sister and when Sixta-Evangelista Ongpauco passed away.

14. In or about June 1987, Manuel Tamayo filed an application with the United States Patent and Trademark Office (“USPTO”) to register the service mark THE ORIGINAL BARRIO FIESTA OF MANILA. The application was given the serial number 73/668,717 and was to be for restaurant services under International Class 042 (the “‘717 Application”). The ‘717 Application alleges that the first use of THE ORIGINAL BARRIO FIESTA OF MANILA mark was in 1958 and the first use of the mark in commerce was December 4, 1985. The ‘717 Application was deemed abandoned in or about March 1988.

15. On or about September 1, 1992, the USPTO issued a trademark registration to Barrio Fiesta International, Inc. (“BFI”), registration number 1,712,454 for the mark BF THE ORIGINAL BARRIO FIESTA OF MANILA (the “‘454 Mark”). Petitioner is informed and believes that BFI’s principals were (and are) her brother, Reynaldo Ongpauco, and her niece, Marjorie Baretto. BFI’s application alleged a first use of the ‘454 Mark (BF THE ORIGINAL BARRIO FIESTA OF MANILA) in commerce on August 1, 1990.

16. In or about July 9, 2013, Petitioner filed a petition for cancellation with the USPTO to cancel the ‘454 Mark on abandonment grounds. On or about April 12, 2015, the USPTO granted Petitioner’s petition for cancellation. On or about September 18, 2015, cancellation number 92/057,510 issued and thereby canceled the ‘454 Mark.

17. On or about June 5, 2013, Petitioner applied to register the mark THE ORIGINAL BARRIO FIESTA OF MANILA under International Class 043 for restaurant services with the USPTO. Petitioner’s application has the serial number 85/951,658 (Petitioner’s “‘658 Application”). As alleged above, Petitioner has used BARRIO FIESTA and the BF Restaurant Logo depicted in Exhibit A in restaurants since 1987. The USPTO has refused to

grant the '658 Application on the ground it could create a likelihood of confusion with Registrants' '365 Mark (BARRIO FIESTA EXPRESS) for "fast-food restaurants." Petitioner intends to proceed with its '658 Application through this petition to cancel the '365 Mark in light of the prior use and other facts alleged herein.

18. Petitioner is informed and believes that Registrants purchased a restaurant in Milpitas, California in 2011 and are using THE ORIGINAL BARRIO FIESTA OF MANILA mark owned by Petitioner, including the BF Restaurant Logo depicted in Exhibit A hereto. Petitioner is further informed and believes that Registrants used the BF Restaurant Logo and Petitioner's mark as an exemplar in their application for the '365 Mark. Although Registrants claim ownership of '365 Mark (BARRIO FIESTA EXPRESS), Petitioner is informed and believes that Registrants use THE ORIGINAL BARRIO FIESTA OF MANILA mark owned by Petitioner (including the BF Restaurant Logo), not the '365 Mark, in the Milpitas restaurant. Petitioner is informed and believes that Registrants are successors in interest to a restaurant originally opened by Petitioner's brother, Reynaldo. However, Petitioner is informed and believes that Registrants have attempted to wrongfully (and fraudulently) expand their rights to BARRIO FIESTA related marks by and through their registration of the '365 Mark and through the use of the BF Restaurant Logo in support of their application for the '365 Mark.

19. Petitioner is informed and believes that Registrants' affiliate corporation and non-exclusive licensee, Barrio Fiesta LLC, filed litigation against the United States distributor of Barrio Fiesta Manufacturing Corporation ("BFMC"). BFMC was started in 1987 by Petitioner's brother, Bonifacio E. Ongpauco, Jr. to manufacture and import into the United States certain Barrio Fiesta branded food products. BFMC has imported such Barrio Fiesta branded food products into the United States since at least 1987, including distribution of packaged food products to BARRIO FIESTA branded restaurants in the United States owned by the Ongpauco family. At all relevant times, BFMC had the consent and authority from all members of the Ongpauco family (including Petitioner) to manufacture and distribute BARRIO FIESTA branded food products in the Philippines and the United States. BFMC has used a

version of the BARRIO FIESTA logo and mark owned and created by the Ongpauco Family since 1958. Examples of BFMC's version of the BARRIO FIESTA logo and mark are contained in Exhibits "B" and "C" (the "BFMC Logos").

20. Petitioner is informed and believes that the mark BARRIO FIESTA and any mark using any variation of that mark in the United States (including but not limited to the BFMC Logos and the BF Restaurant Logo depicted in Exhibits A, B & C hereto) is associated with the more famous BARRIO FIESTA mark in the Philippines. The BARRIO FIESTA brand and mark, and the restaurants in the Philippines using that brand and mark, are an iconic brand in the Philippines. Using that famous mark and logo, Petitioner and her family have owned and operated BARRIO FIESTA restaurants in the United States continuously since 1987. In the United States, all of Petitioners' BARRIO FIESTA restaurants, as well as those operated by her family, expressly associate themselves with the history of the BARRIO FIESTA brand and name arising from the restaurants in the Philippines, including the use of the BF Restaurant Logo.

21. Petitioner alleges that the factors recognized in the 2004 decision of the Ninth Circuit Court of Appeals involving the famous foreign mark "GIGANTE" in supermarkets apply here with respect to the famous foreign mark, BARRIO FIESTA. *Grupo Gigante S.A. de C.V. v. Dallo & Co.*, 391 F.3d 1088, 1093 (9th Cir. 2004). Namely,

a. The BARRIO FIESTA mark originated in the Philippines and has been used continuously in the United States since 1987, achieving "a certain level of fame for that mark within the United States." Thus, the "territoriality principle no longer serves to deny priority to the earlier foreign user." *Grupo Gigante S.A. de C.V.*, 391 F.3d at 1093.

b. Petitioner alleges that any mark in the United States that uses BARRIO FIESTA in whole or in part would "promote consumer confusion and fraud" if such use is not associated with or approved by the Ongpauco family and the famous mark which originated in the Philippines. *Grupo Gigante S.A. de C.V.*, 391 F.3d at 1094

(“There can be no justification for using trademark law to fool immigrants into thinking that they are buying from the store they liked back home.”).

c. Petitioner alleges that BARRIO FIESTA has achieved such fame and secondary meaning in the Philippines that Petitioner and the Ongpauco family who created the mark and brand in that country have gained “exclusive rights” to BARRIO FIESTA related marks in the United States. *Grupo Gigante S.A. de C.V.*, 391 F.3d at 1095.

22. In addition, Petitioner has developed extensive goodwill with respect to Petitioner’s BARRIO FIESTA marks since Petitioner’s Barrio Fiesta – Los Angeles opened in 1987. Petitioner has spent significant sums for advertisement and promotion of the services sold in connection with the BARRIO FIESTA brand and mark in restaurants. Accordingly, as a result of the advertisement and promotion of Petitioner’s marks, along with the high quality of the services sold in connection with Petitioner’s marks, Petitioner has developed a valuable reputation for Petitioner’s marks.

23. Petitioner is informed and believes that Registrants claim ownership of all BARRIO FIESTA related marks in the United States based on their 2011 registration of the ‘365 Mark.

24. Petitioner is damaged and will continue to be damaged by Registrants’ ‘365 Mark because Registrants are using this mark to misrepresent the source of their restaurant services, including Registrants’ fraudulent use of the BF Restaurant Logo in their application for the ‘365 Mark, and has caused confusion with the restaurant services and valuable marks created and used by Petitioner’s family in the Philippines (since 1958) and in the United States (since 1987).

25. Petitioner prays that the ‘365 Mark be canceled on the grounds that (a) the famous foreign mark BARRIO FIESTA was first used in the Philippines in or about 1958, (b) the Ongpauco family, and Petitioner specifically, has used in the United States the same BARRIO FIESTA mark created in the Philippines since 1987 in restaurants, (c) the Ongpauco

family and its successors have used the BARRIO FIESTA mark in the United States in packaged food products since 1987, (d) Registrants' application for the '365 Mark was based on fraud when they used the BF Restaurant Logo depicted in Exhibit A to deceive the USPTO into believing that their application for a BARRIO FIESTA EXPRESS mark was based on ownership of the BF Restaurant Logo depicted in Exhibit A and related marks and (e) the '365 Mark creates confusion with the Ongpauco family created and owned BARRIO FIESTA marks in the United States and in the Philippines, including the BARRIO FIESTA marks owned by Petitioner, the BFMC Logos and BF Restaurant Logo.

26. Petitioner hereby appoints Melvin N.A. Avanzado of The Avanzado Law Firm, A Professional Law Corporation, with offices at 1880 Century Park East, Suite 1100, Los Angeles, California 90067, as her attorneys to prosecute this cancellation proceeding and to transact all business in and before the United States Patent and Trademark Office in connection herewith.

DATED: May 4, 2016

THE AVANZADO LAW FIRM


By: 
Melvin N.A. Avanzado
Attorneys for Petitioner
Consuelo Ongpauco-Cauton

EXHIBIT A

EXHIBIT A



EXHIBIT B

EXHIBIT B



EXHIBIT C

EXHIBIT C



PROOF OF SERVICE

I am employed in the County of Los Angeles, State of California. I am over the age of 18 years and am not a party to the within action. My business address is 1880 Century Park East, Suite 1100, Los Angeles, California 90067. On the date set forth below, I caused the foregoing document(s) described as

PETITIONER CONSUELO ONGPAUCO-CAUTON'S PETITION TO
CANCEL REGISTRATION NO. 4,034,365

to be served on the interested parties in this action as follows by placing

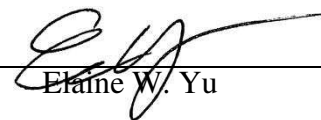
the original a true copy thereof enclosed in sealed envelopes addressed as stated below:

June Francis Rono
Ashley Kirsten C. Rono
Justin Christian C. Rono
1629 Wharton Road
San Jose, California 95132

SEE ATTACHED SERVICE LIST

- BY MAIL:** I sealed and placed such envelope for collection and mailing to be deposited in the mail on the same day in the ordinary course of business at Los Angeles, California. The envelope was mailed with postage thereon fully prepaid. I am readily familiar with this firm's practice of collecting and processing correspondence for mailing. It is deposited with the U.S. Postal Service on that same day in the ordinary course of business.
- BY FEDERAL EXPRESS:** I caused such envelope to be placed for collection and delivery on this date in accordance with standard Federal Express delivery procedures.
- BY ELECTRONIC MAIL:** I personally delivered such envelope by electronic mail to the addressee(s) shown above.
- BY FAX:** In addition to service by mail, I transmitted a copy of the foregoing document(s) this date via telecopier to the facsimile numbers shown above.
- BY PERSONAL SERVICE:** I personally delivered such envelope by hand to the addressee(s) shown above.
- [State] I declare under penalty of perjury under the laws of the State of California that the above is true and correct.
- [Federal] I declare that I am employed in the office of a member of the Bar of this Court at whose direction the service was made. I declare under penalty of perjury that the foregoing is true and correct.

Executed on May 4, 2016 at Los Angeles, California.



Elaine W. Yu

SERVICE LIST

COUNSEL OF RECORD/OFFICE ADDRESS	CONTACT NUMBERS/EMAIL	PARTY REPRESENTED
James Cai, Esq. Andrew Watters, Esq. Marc Guèdenet, Esq. SAC Attorneys, LLP 111 North Market Street, Suite 1020 San Jose, California 95113	(408) 436-0789 Telephone (408) 436-0758 Facsimile jcai@sacattorneys.com awatters@sacattorneys.com mguedenet@sacattorneys.com	Registrants June Francis Rono Ashley Kirsten C. Rono Justin Christian C. Rono