

ESTTA Tracking number: **ESTTA1030970**

Filing date: **01/23/2020**

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 has filed a petition to cancel the registration indicated below.

**Petitioner Information**

Name	Hungry Mexican LLC		
Entity	limited liability company	Citizenship	Montana
Address	206 S. 11th St. Livingston, MT 59047 UNITED STATES		

Correspondence information	Antoinette M. Tease Antoinette M. Tease, P.L.L.C. PO Box 1902 Billings, MT 59103 UNITED STATES toni@teaselaw.com 4062949000
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**Registration Subject to Cancellation**

Registration No.	5446240	Registration date	04/17/2018
International Registration No.	NONE	International Registration Date	NONE
Registrant	Vont Vivant Productions, S.A. de C.V. Col. Anzures, Miguel Hidalgo Gutemberg No. 60, Interior 9 Mexico City, 11590 MEXICO		

**Goods/Services Subject to Cancellation**


<p>Class 029. First Use: 0 First Use In Commerce: 0 All goods and services in the class are subject to cancellation, namely: Canned beans; Canned vegetables; Dried vegetables; Edible oils and fats; Eggs; Fish, preserved; Frozen fruits; Frozen vegetables; Fruit preserves; Jellies and jams; Legume-based spreads; Legume salads; Meat; Meat extracts; Meat preserves; Meat, poultry and game; Cooked meat dishes; Dried meat; Extracts of meat; Hamburger; Prepared meat; Preserved, dried andcooked fruit and vegetables; Processed meat; Sausage meat; Sliced meat</p>
<p>Class 030. First Use: 0 First Use In Commerce: 0 All goods and services in the class are subject to cancellation, namely: Baking powder; Beverages with a tea base; Bread and pastry; Burritos; Cereal bars; Chocolate; Cocoa-based beverages; Cocoa; Coffee-based beverages; Coffee and coffee substitutes; Confectionery made of sugar; Flour; Honey; Ice; Ice creams; Molasses syrup; Mustard; Pancakes; Pasta; Preparations made from cereals, namely, processed cereals, breakfast cereals, biscuits, tarts, cakes made with cereal,cereal based energy bars, high-protein cereal bars; Processed corn; Rice; Sago;Salad dressings; Salt; Sauces; Seasonedcoating for meat, fish, poultry; Spices; Sugar; Tacos; Tapioca; Tea; Toasted corn kernels;</p>

Tortillas; Vinegar; Yeast; Beverages with a chocolate base
Class 043. First Use: 0 First Use In Commerce: 0 All goods and services in the class are subject to cancellation, namely: Bar services; Catering services; Coffee and juice bar services; Providing banquet and social function facilities for special occasions; Providing temporary accommodation; Restaurant services; Serving of food and drink/ beverages; Snack-bar services

### Grounds for Cancellation

Priority and likelihood of confusion	Trademark Act Sections 14(1) and 2(d)
Abandonment	Trademark Act Section 14(3)

### Mark Cited by Petitioner as Basis for Cancellation

U.S. Application No.	88609589	Application Date	09/09/2019
Registration Date	NONE	Foreign Priority Date	NONE
Word Mark	HUNGRY MEXICAN		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 030. First use: First Use: 2014/03/18 First Use In Commerce: 2014/03/18 Salsa Class 043. First use: First Use: 2014/12/17 First Use In Commerce: 2014/12/17 Restaurant services		

Attachments	88609589#TMSN.png( bytes ) Petition to cancel 01-23-20.pdf(97141 bytes )
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Signature	/Antoinette M. Tease/
Name	Antoinette M. Tease
Date	01/23/2020

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

HUNGRY MEXICAN LLC,	)	
	)	Proceeding No. _____
Petitioner,	)	
	)	Trademark: TWO HUNGRY
v.	)	MEXICANS (stylized)
	)	
VONT VIVANT PRODUCTIONS, S.A.	)	Registration No. 5446240
DE C.V.,	)	
	)	Registration Date: April 17, 2018
Registrant.	)	
_____	)	

PETITION TO CANCEL

HUNGRY MEXICAN LLC, a Montana limited liability company with its principal place of business at 206 S. 11<sup>th</sup> St., Livingston, Montana, U.S.A. 59047 (the “Petitioner” or “Hungry Mexican”), has been and believes it will continue to be damaged by the registration of the mark covered by U.S. Trademark Registration No. 5446240 and hereby seeks cancellation of this registration.

To the best of Petitioner’s knowledge, the name and address of the current owner of the registration are: Vont Vivant Productions, S.A. de C.V., a Mexican sociedad anonima (sa de cv), with its principal place of business at Col. Anzures, Miguel Hidalgo Gutemberg No. 60, Interior 9, Mexico City, Mexico 11590.

The grounds for cancellation are as follows:

1. Hungry Mexican sells four kinds of salsa and has been in business since 2009. Hungry Mexican also owns and operates a taco shop in Livingston, Montana. Hungry Mexican has been using the HUNGRY MEXICAN mark in interstate commerce

for salsa since at least as early as March 18, 2014 and for restaurant services since at least as early as December 17, 2014.

2. On September 9, 2019, Hungry Mexican filed a federal trademark application (Serial No. 88609589) for the HUNGRY MEXICAN standard character mark. This application covers “salsa” in Class 030 and “restaurant services” in Class 043.

3. On December 17, 2019, the examining attorney issued an Office Action refusing registration of the HUNGRY MEXICAN mark based in part on U.S. Trademark Reg. No. 5446240 for a stylized version of the TWO HUNGRY MEXICANS mark:



The latter registration covers various food products in Classes 029 and 030, as well as restaurant and other services in Class 043.

4. Prior to receiving the above-referenced Office Action, counsel for Hungry Mexican conducted research regarding the TWO HUNGRY MEXICANS mark and could find no evidence that this mark was in use in the United States. The undersigned counsel contacted the attorney of record for the Registrant and was unable to obtain confirmation from him that the mark is in use.

5. After paying counsel for the Registrant the sum of one thousand three hundred fifty dollars (\$1350.00) to cover his fees, Hungry Mexican obtained a Trademark

Consent Agreement from Registrant. Hungry Mexican filed a response to the Office Action on December 21, 2019 and included a copy of this agreement.

6. On January 2, 2020, the examining attorney issued a second Office Action refusing to enter the consent agreement because it did not provide sufficient detail as to the arrangements proposed by the parties to avoid confusion. In response to this Office Action, the undersigned counsel contacted Registrant's counsel and was again told that he could not confirm that the TWO HUNGRY MEXICANS mark was in use in the United States. As such, Hungry Mexican is petitioning to cancel Reg. No. 5446240 on the basis of abandonment. The applicant would note that the filing basis for Reg. No. 5446240 is 44E, and there is no specimen on file with the USPTO for this mark.

7. On January 21, 2020, Registrant offered to sell its purported trademark rights to Hungry Mexican for the sum of eight thousand dollars (\$8000.00).

8. Hungry Mexican seeks cancellation of Registration No. 5446240 for the mark TWO HUNGRY MEXICANS on the basis of abandonment and priority of use. Because this registration issued less than five years ago, it is still subject to challenge on the basis of priority of use.

COUNT I  
(ABANDONMENT)  
(15 U.S.C. §1064(3))

9. Hungry Mexican incorporates by reference paragraphs 1–8 above as if fully set forth herein.

10. For the reasons set forth above, which include both the research conducted by Hungry Mexican and its interactions with counsel for Registrant, Hungry Mexican

believes that the TWO HUNGRY MEXICANS mark has been abandoned or, in the alternative, that it has never been in use in the United States.

11. Upon information and belief, Registrant has not used and/or is no longer using the TWO HUNGRY MEXICANS mark that is the subject of Reg. No. 5446240.

12. In view of Registrant's abandonment of the TWO HUNGRY MEXICANS mark that is the subject of U.S. Trademark Registration No. 5446240, Registrant is not entitled to continued registration of the mark pursuant to Section 14(3) of the Lanham Act, 15 U.S.C. § 1064(3), and, as such, Registrant's registration should be canceled.

COUNT II  
(PRIORITY OF USE AND LIKELIHOOD OF CONFUSION)  
(15 U.S.C. §1052(d))

13. Hungry Mexican incorporates by reference paragraphs 1–12 above as if fully set forth herein.

14. As noted above, Hungry Mexican has been using the HUNGRY MEXICAN mark in connection with salsa since at least as early as March 18, 2014 and since at least as early as December 17, 2014 for restaurant services.

15. U.S. Trademark Application No. 87435450 for the mark TWO HUNGRY MEXICANS was filed on May 3, 2017, with a claimed priority date of February 23, 2017. As such, Hungry Mexican has priority of use.

16. According to the examining attorney, the marks HUNGRY MEXICAN and TWO HUNGRY MEXICANS are confusingly similar, and the goods and services covered by the respective filing are related. Hungry Mexican agrees that the goods/services are either identical or related and that the marks would be deemed

confusingly similar if the TWO HUNGRY MEXICANS mark were in use within the United States.<sup>1</sup>

17. Upon information and belief, the mark covered by U.S. Trademark Registration No. 5446240 has caused actual confusion, mistake and deception among consumers of salsa and restaurant services and/or would cause actual confusion, mistake and deception among consumers of salsa and restaurant services if it were in use in the United States.

18. Hungry Mexican has invested a substantial amount of time, effort and money in creating goodwill surrounding the HUNGRY MEXICAN mark and promoting and selling its goods and services in connection with such mark.

19. Registrant has no license, consent or permission from Hungry Mexican to use or register the TWO HUNGRY MEXICANS mark for food products or restaurant services.

20. The continuous registration of the mark covered by U.S. Trademark Registration No. 5446240 is causing injury to Hungry Mexican, its business, reputation and goodwill, and will continue to cause injury to Hungry Mexican, its business, reputation and goodwill until the registration is canceled.

\* \* \*

WHEREFORE, Hungry Mexican prays that this Petition To Cancel be sustained in its entirety in favor of Hungry Mexican and that Registration No. 5446240 be

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<sup>1</sup> The prior consent agreement was based on Hungry Mexican's understanding that the mark was not in use in the United States.

canceled. Hungry Mexican submits herewith a payment to cover its filing fee of \$400.00, as required by 37 C.F.R. § 2.6(a)(16).

Dated: January 23, 2020

Respectfully submitted,

/Antoinette M. Tease/

Antoinette M. Tease  
ANTOINETTE M. TEASE, P.L.L.C.  
Attorney for Petitioner  
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Billings, MT 59103  
(406) 294-9000



**CERTIFICATE OF SERVICE**

I hereby certify that a true and correct copy of the foregoing PETITION TO CANCEL is being served on January 23, 2020, by deposit of same in the United States Mail, first class postage prepaid, in an envelope addressed to Justin R. Young, counsel for the Registrant, at:

DINEFF TRADEMARK LAW LIMITED  
160 N. WACKER DRIVE  
CHICAGO, ILLINOIS UNITED STATES 60606

/Antoinette M. Tease/  
Antoinette M. Tease