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

Proceeding no.	92075108
Party	Defendant Jorge Ernesto Ramirez-Ceballos
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Date	10/11/2022
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In re Registration No. 5,985,963

Trademark: **LA ORIGINAL BANDA MAGUEY !Y... PURO VILLA CORONA! Y SIGUE,  
Y SIGUE (design)**

Registered: February 11, 2020

Miguel Angel Vidal Pulido.

*Petitioner,*

v.

Jorge Ernesto Ramirez-Ceballos,

*Registrant.*

Cancellation No. 92075108

**ANSWER TO SECOND AMENDED PETITION FOR CANCELLATION**

Registrant Jorge Ernesto Ramirez-Ceballos (hereinafter “Registrant”), by and through its attorneys of record, hereby answers the Second Amended Petition for Cancellation (hereinafter “Petition”) filed by Petitioner Miguel Angel Vidal Pulido (hereinafter “Petitioner”) on September 20, 2022 against Registration No. 5,985,963 (hereinafter “the Registration”) as follows:

1. Registrant is without knowledge or information sufficient to form a belief as to the truth of the allegations set forth in Paragraph 1 of the Petition and therefore denies the same.
2. Registrant denies the allegations made in Paragraph 2 of the Petition as drafted.
3. Registrant is without knowledge or information sufficient to form a belief as to the truth of the allegations set forth in Paragraph 3 of the Petition and therefore denies the same.
4. The allegations of Paragraph 4 are vague and incomprehensible since there is no clear statement or indication of exactly which Mexican Partnership Petitioner is referring to. As such, Registrant is without knowledge or information sufficient to form a belief as to the truth of the allegations set forth in Paragraph 4 of the Petition and therefore denies the same.

5. Registrant denies the allegations made in Paragraph 5 of the Petition as drafted. Registrant admits that, according to USPTO records, a trademark application was filed with the USPTO on August 8, 1997 for the BANDA MAGUEY mark, which matured into US Registration No. 2,198,067 on October 20, 1998. Registrant affirmatively alleges that the trademark application for the BANDA MAGUEY mark was filed in the name of the following individuals: Martin G. Ibarra, Samuel Vidal, Francisco Ricardo Mendoza, Jose Luis Rosas, Luis Antonio Plasencia, Luis Gerardo Rosales and Nelson Alejandro Mendoza.

6. Registrant denies the allegations made in Paragraph 6 of the Petition as drafted. Registrant admits that an agreement titled Assignment of Trademark was executed transferring the entire rights and interests in and to the BANDA MAGUEY trademark, US Registration No. 2,198,067, to Mr. Miguel Angel Vidal Pulido. Registrant affirmatively alleges that, according to USPTO records, the assignment agreement was executed on December 11, 2006 and the following individuals were identified as Assignors: Martin G. Ibarra, Samuel Vidal, Francisco Ricardo Mendoza, Jose Luis Rosas, Luis Antonio Plasencia, Luis Gerardo Rosales and Nelson Alejandro Mendoza.

7. Registrant denies the allegations made in Paragraph 7 of the Petition as drafted. The allegations of Paragraph 7 are vague and incomprehensible since there is no clear statement or indication of exactly who were the “then-current members of Banda Maguey.” Registrant admits that Petitioner transferred the entire rights, title and interests in and to the BANDA MAGUEY mark, US Registration No. 2,198,067, to the Mexican entity Xopillyn SC by executing an agreement titled Assignment of Trademark on February 5, 2014.

8. Registrant denies the allegations made in Paragraph 8 of the Petition as drafted. Registrant affirmatively alleges that Xopillyn SC, represented by Mr. Jose Rosario Cisneros, legally

transferred the entire rights, title and interest in and to the BANDA MAGUEY trademark, US Registration No. 2,198,067, to Registrant Jorge Ernesto Ramirez Ceballos through the execution of an agreement titled Assignment of Trademark on March 23, 2018.

9. Registrant denies the allegations made in Paragraph 9 of the Petition. The allegations of Paragraph 9 are vague and incomprehensible since there is no clear statement or indication of exactly who were the “owners of Xopillyn.” Registrant affirmatively alleges that Mr. Jose Rosario Cisneros was authorized under Mexican Law to act on behalf of Xopillyn SC. Registrant also affirmatively alleges that Petitioner’s knowledge and consent or the knowledge and consent of the alleged “owners of Xopillyn” was not necessary for the validity of said assignment agreement.

10. Registrant denies the allegations made in Paragraph 10 of the Petition. The allegations of Paragraph 10 are vague and incomprehensible since there is no clear statement or indication of exactly who were the “owners of Xopillyn.” Registrant affirmatively alleges that he entered into an agreement with Xopillyn SC whereby he legally acquired and received all the rights, title and interest over the BANDA MAGUEY mark, US Registration No. 2,198,067. Registrant categorically denies that any acts related to said assignment agreement were false, knowingly false and/or fraudulent.

11. Registrant denies the allegations made in Paragraph 11 of the Petition as drafted. Registrant admits the Petitioner filed a Petition for Cancellation against the BANDA MAGUEY mark, US Registration No. 2,198,067, Cancellation proceeding no. 92071438. Registrant affirmatively alleges that he did not receive any documents by mail or email regarding said cancellation proceeding except for the Notice of Default Judgment and was unable to timely retain legal representation.

12. Registrant denies the allegations made in Paragraph 12 of the Petition. Registrant affirmatively alleges that in 2014 Petitioner assigned all the rights, title and interest in and to the BANDA MAGUEY trademark registrations, both in US and Mexico, to Xopillyn SC. Also, Registrant affirmatively alleges that Petitioner's claims of ownership and rights to the BANDA MAGUEY mark are knowingly false and made with the intent to deceive the USPTO and this Board into the wrongful cancellation of the LA ORIGINAL BANDA MAGUEY ! Y... PURO VILLA CORONA! Y SIGUE, Y SIGUE trademark registration.

13. Registrant denies the allegations made in Paragraph 13 of the Petition.

14. Registrant denies the allegations made in Paragraph 14 of the Petition drafted. The allegations of Paragraph 14 are vague and incomprehensible since there is no clear statement or indication of exactly who are "Banda Maguey's other members." Registrant affirmatively alleges that Petitioner's claim of use of the BANDA MAGUEY mark for over 25 years is knowingly false and made with the intent to deceive the USPTO and this Board.

15. Registrant denies the allegations made in Paragraph 15 of the Petition. The allegations of Paragraph 15 are vague and incomprehensible since there is no clear statement or indication of exactly who are "Banda Maguey's members." Registrant affirmatively alleges that since 2018 he legally acquired the rights, title and interest in and to the BANDA MAGUEY mark, including the extensive goodwill and reputation associated with the same, throughout the United States and Mexico.

16. Registrant denies the allegations made in Paragraph 16 of the Petition as drafted. The allegations of Paragraph 16 are vague and incomprehensible since there is no clear statement or indication of exactly who are "Banda Maguey's members." Registrant affirmatively alleges that any sum of money, time and effort spent by Petitioner in connection with Registrant's BANDA

MAGUEY mark is unauthorized, illegal and fraudulent and is made knowingly, with the intent to deceive consumers and benefit from Registrant's goodwill and reputation. Registrant also affirmatively alleges that Mexican authorities have barred Petitioner from continuing the illegal, unauthorized and fraudulent use of Registrant's BANDA MAGUEY mark in Mexico's commerce and ordered the imposition of serious penalties should he fail to comply.

17. Registrant denies the allegations made in Paragraph 17 of the Petition. Registrant affirmatively alleges any expenditures made by Petitioner for promotional activities and advertisements for the BANDA MAGUEY mark are made without Registrant's authorization as blatant attempt to usurp Registrant's rights over the BANDA MAGUEY mark.

18. Registrant denies the allegations made in Paragraph 18 of the Petition.

19. Registrant denies the allegations made in Paragraph 19 of the Petition. Registrant admits that he filed Application Serial No. 88/262,127 for LA ORIGINAL BANDA MAGUEY ! Y... PURO VILLA CORONA! Y SIGUE, Y SIGUE (design) mark, in International Class 41, for "Entertainment services in the nature of presenting live musical performances," which matured into US Registration No. 5,985,963 on February 11, 2020.

20. Registrant denies the allegations made in Paragraph 20 of the Petition as drafted. Registrant affirmatively alleges that Petitioner assigned the rights, title and interest in and to the BANDA MAGUEY mark to Xopillyn SC in 2014 and, thus, his claims of use of the BANDA MAGUEY mark for over 25 years, ownership of a senior mark and priority use are knowingly false and made with the clear intent to deceive this Board. Registrant also affirmatively alleges that Petitioner's trademark application for the BANDA MAGUEY mark, US Application Serial No. 88/900,353, is fraudulent and must be denied registration by the USPTO.

21. Registrant denies the allegations made in Paragraph 21 of the Petition. Registrant affirmatively alleges that Petitioner's fraudulent trademark application for the BANDA MAGUEY mark, US Application Serial No. 88/900,353, is a duplicate of Registrant's BANDA MAGUEY mark, U.S. Registration No. 2,198,067. Also, Registrant affirmatively alleges that US Application Serial No. 88/900,353 is nothing more than Petitioner's blatant, fraudulent attempt to usurp Registrant's trademark rights and intentionally and knowingly deceive the USPTO and this Honorable TTAB into the wrongful cancellation of Registrant's LA ORIGINAL BANDA MAGUEY ! Y... PURO VILLA CORONA! Y SIGUE, Y SIGUE (design) trademark registration.

22. Registrant denies the allegations made in Paragraph 22 of the Petition.

23. Registrant denies the allegations made in Paragraph 23 of the Petition.

24. Registrant denies the allegations made in Paragraph 24 of the Petition.

#### **Count I: Likelihood of Confusion**

25. Paragraph 25 of the Petition does not contain any allegations which require a responsive pleading; otherwise, Registrant denies the same.

26. Registrant denies the allegations made in Paragraph 26 of the Petition. Registrant affirmatively alleges that Petitioner assigned and transferred the entire rights, title and interest in and to the BANDA MAGUEY mark, including the goodwill associated therewith and all priority rights resulting therefrom, to a third-party in 2014. Therefore, Petitioner is barred from claiming prior use of the BANDA MAGUEY mark.

27. Registrant denies the allegations made in Paragraph 27 of the Petition. Registrant affirmatively alleges that Petitioner's trademark application for the BANDA MAGUEY mark, US Application Serial No. 88/900,353 is fraudulent and was filed as a blatant attempt to deceive this Board into the wrongful cancellation of Registrant's LA ORIGINAL BANDA MAGUEY ! Y...

PURO VILLA CORONA! Y SIGUE, Y SIGUE (design) mark. Moreover, Registrant affirmatively alleges that Petitioner is intentionally and without authorization using Registrant's BANDA MAGUEY mark in US commerce to confuse and deceive the consuming public into believing that he is the owner of said mark and/or source of origin of Registrant's live musical performance services.

28. Registrant denies the allegations made in Paragraph 28 of the Petition. Registrant affirmatively alleges that Petitioner is intentionally and without authorization using Registrant's BANDA MAGUEY mark in connection with identical services as those offered by Registrant and through the same channels of trade used by Registrant in order to deliberately defraud and confuse consumers and usurp Registrant's trademark rights.

29. Registrant denies the allegations made in Paragraph 29 of the Petition. Registrant affirmatively alleges that Petitioner is intentionally and without authorization using Registrant's BANDA MAGUEY mark to deliberately defraud and confuse consumers, deceive this Honorable Board and usurp Registrant's trademark rights.

### **AFFIRMATIVE DEFENSES**

Registrant expressly reserves the right to plead additional affirmative and other defenses should any defense be revealed by discovery in this case. As and for its affirmative and other defenses, Registrant states as follows:

#### **First Affirmative Defense**

Registrant affirmatively alleges that the Petition for Cancellation is barred by the doctrine of estoppel. Paragraph 7 of the Second Amended Petition for Cancellation expressly alleges that in 2014 Petitioner assigned the rights in the Maguey Registration to Xopillyn SC. The trademark assignment agreement between Petitioner and Xopillyn SC, which was recorded with the USPTO



Assignment Recordation Branch, clearly states that Petitioner assigned the entire rights and interest in the BANDA MAGUEY mark, U.S. Registration No. 2,198,067, including the goodwill associated therewith and all priority rights resulting therefrom. The validity of this agreement is undisputed and is a material fact in this case.

In view of the foregoing, Petitioner is barred from asserting ownership and priority rights over the BANDA MAGUEY mark. Petitioner is also precluded from claiming that Registrant's LA ORIGINAL BANDA MAGUEY ! Y... PURO VILLA CORONA! Y SIGUE, Y SIGUE (design) mark is a source of damage, harm or injury.

### **Second Affirmative Defense**

Registrant affirmatively alleges that as a result of Petitioner's own acts, Petitioner transferred and assigned the rights in and to the BANDA MAGUEY mark, including the right to pursue this Petition for Cancellation, to the Mexican corporation Xopillyn SC in 2014.

### **Third Affirmative Defense**

Registrant affirmatively alleges that Petitioner is not the owner of the BANDA MAGUEY mark and, thus, is not entitled to a statutory cause of action seeking the cancellation of Registrant's LA ORIGINAL BANDA MAGUEY ! Y... PURO VILLA CORONA! Y SIGUE, Y SIGUE (design) trademark registration.

### **Fourth Affirmative Defense**

Registrant affirmatively alleges that the Petition for Cancellation is barred by the doctrine of unclean hands and fraud based upon Petitioner false claims of ownership and prior use of Registrant's BANDA MAGUEY mark and the illegal and unauthorized use of Registrant's BANDA MAGUEY mark in US commerce in connection with live musical performance services to intentionally cause confusion and defraud the public. Moreover, Petitioner filed a fraudulent

trademark application for the BANDA MAGUEY mark, US Application Serial No. 88/900,353, as blatant and intentional attempt to deceive this Honorable Board into the wrongful cancellation of the LA ORIGINAL BANDA MAGUEY ! Y... PURO VILLA CORONA! Y SIGUE, Y SIGUE (design) mark.

**Fifth Affirmative Defense**

Registrant affirmatively alleges that the Petition for Cancellation is barred by the doctrine of laches. Petitioner unreasonably delayed in asserting ownership rights and prior use of the BANDA MAGUEY mark. Petitioner's delay in claiming ownership and prior use is inexcusable and causes significant, material prejudice to Registrant.

**Sixth Affirmative Defense**

Registrant affirmatively alleges that the real controversy in this case is not likelihood of confusion, but rather pertains to contract law and the validity of an assignment agreement between the Mexican corporation Xopillyn SC and a Mexican citizen, Mr. Jorge Ernesto Ramirez Ceballos regarding the BANDA MAGUEY trademark. Therefore, TTAB lacks jurisdiction to resolve the real issue presented in this case and the petition for cancellation must be dismissed.

**WHEREFORE**, Registrant requests that this Second Amended Petition for Cancellation be dismissed with prejudice.

Dated this 11<sup>th</sup> day of October, 2022.

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*Attorneys for Registrant*

**CERTIFICATE OF TRANSMITTAL**

I hereby certify that a true copy of the foregoing **ANSWER TO SECOND AMENDED PETITION FOR CANCELLATION** is being electronically filed with the TTAB via ESTTA and served by email upon Petitioner's attorney of record on this 11<sup>th</sup> day of October, 2022.

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