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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	04/17/2023
Attachments	4.17.2023 Motion for Judgment on the Pleadings, alternatively, Summary Judgment.pdf(261559 bytes) Exhibit 1 2006 Assignment in favor of Vidal Pulido.pdf(191568 bytes) Exhibit 2 2014 Assignment Vidal Pulido-Xopillyn SC.pdf(143371 bytes) Exhibit 3 2018 Assignment Xopillyn SC-JRC.pdf(323780 bytes)

**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**

Registered: February 11, 2020

Miguel Angel Vidal Pulido.
Petitioner,

v.

Jorge Ernesto Ramirez-Ceballos,
Registrant.

Cancellation No. 92075108

MOTION FOR JUDGMENT ON THE PLEADINGS
OR, ALTERNATIVELY, MOTION FOR SUMMARY JUDGMENT

COMES NOW Registrant Jorge Ernesto Ramirez-Ceballos, by and through its undersigned attorneys who respectfully present this a Motion for Judgment on the Pleadings or, alternatively, Motion for Summary Judgment on all pending claims, pursuant to Rule 12(c) and Rule 56 of the Federal Rules of Civil Procedure. This motion seeks to bring clarity and justice to a dispute that is unequivocally devoid of merit.

Petitioner's quest for cancellation is fundamentally flawed and unjustifiable. The crux of the matter lies in the undeniable truth that the Petitioner relinquished any and all rights to the BANDA MAGUEY trademark when he voluntarily assigned those rights in 2014. This pivotal fact is not a matter of contention; rather, it is an admission by the Petitioner himself, as evidenced in Second Amended Petition ¶7 (TTABVUE 21). Consequently, Petitioner's claim is baseless and should be dismissed as such.

Furthermore, Application Serial No. 88/900,353 for the mark BANDA MAGUEY in 2020, is a testament to the invalidity of his claims, as Petitioner has no rights over said mark. It is crucial to note that Registrant, Mr. Ramirez-Ceballos, lawfully acquired the rights to the BANDA MAGUEY word mark and subsequently applied for the registration of the **LA ORIGINAL BANDA MAGUEY !Y... PURO VILLA CORONA! Y SIGUE, Y SIGUE** design mark.

In light of the foregoing, we respectfully request that this Board dismiss this cancellation proceeding, as there are no genuine issues concerning the material fact that Petitioner's is not the owner of the BANDA MAGUEY word mark. Therefore, Registrant is entitled to judgment as a matter of law. The principles of justice, fairness, and the rule of law demand no less.

I. PERTINENT PROCEDURAL POSTURE AND BACKGROUND

1. On April 11, 2022, Registrant filed a motion to dismiss for failure to state a claim with respect to Petitioner's entitlement to a statutory cause of action and claim of fraud. (TTABVUE 17)

2. On August 30, 2022, the Board issued an order stating that "[w]here a motion styled as one to dismiss relies on matter outside the pleadings, the Board may construe the motion as one for summary judgment." However, since Respondent had "not yet filed an answer" nor served the initial disclosures upon Petitioner, "to the extent the Board considered Respondent's motion to dismiss for lack of entitlement as one for summary judgment, the Board would have denied the motion, without prejudice, as premature." The Board allowed Petitioner until September 20, 2022 to file and serve an amended petition to cancel and Registrant until October 11, 2022 to file and serve an answer. (TTABVUE 20)

3. On September 20, 2022, Petitioner filed a Second Amended Petition For Cancellation. (TTABVUE 21)

4. On October 11, 2022, Registrant filed the Answer to Second Amended Petition for Cancellation. (TTABVUE 22)

5. Subsequently, on December 12, 2022, the parties in this proceeding served upon each other the initial disclosures.

6. In light of the foregoing and since the revised trial schedule sets forth the due date for Plaintiff's pretrial disclosures for June 23, 2023, this motion is **timely**. *Shared, LLC v. Shared Space of Atlanta, LLC*, 125 USPQ2d 1143, 1144 (TTAB 2017).

7. Registrant respectfully request suspension of the trial schedule and time to answer discovery requests pending the final disposition of the instant motion. No prejudice to Petitioner is present.

II. UNDISPUTED RELEVANT AND MATERIAL FACTS

1. Banda Maguey is a Mexican musical group founded in 1990's by several individuals and offered services in the nature of live musical performances under the BANDA MAGUEY name and trademark. Second Amended Petition ¶2 (TTABVUE 21).

2. On August 8, 1997, U.S. Trademark Application Serial No. 75/346,810 was filed by several members of the Banda Maguey musical group to register the BANDA MAGUEY word mark. The application matured into U.S. Trademark Registration No. 2,198,067 (hereinafter "Reg. '067") on October 20, 1998. Second Amended Petition at paragraph 5 (TTABVUE 21).

3. Petitioner, Mr. Miguel Angel Vidal Pulido, used to be one of the members of the Banda Maguey musical group and, on December 11, 2006,¹ acquired the rights and title over the BANDA MAGUEY word mark, Reg. '067, through an assignment agreement (hereinafter "2006 Assignment").² Second Amended Petition ¶6 (TTABVUE 21). A true and correct copy of the 2006 Assignment is attached hereto as **Exhibit 1**.

4. On February 05, 2014, Petitioner transferred all rights, title and interests in and to the BANDA MAGUEY word mark, including all priority rights, to Xopillyn SC, a Mexican corporation, via an assignment agreement (hereinafter "2014 Assignment").³ Second Amended Petition ¶7 (TTABVUE 21). A true and correct copy of the 2014 Assignment is attached hereto as **Exhibit 2**.

5. After the acquisition of the rights, title and interests of the BANDA MAGUEY mark and business associated therewith in 2014, Xopillyn SC continued to conduct business and commercially exploit the BANDA MAGUEY word mark in connection with live musical performance services throughout the World, including without limitation, the United States.

6. In March 23, 2018, Registrant acquired the entire right, title and interest, including all priority rights, in and to the BANDA MAGUEY mark from Xopillyn SC, through an assignment agreement (hereinafter "2018 Assignment").⁴ Second Amended Petition ¶8 (TTABVUE 21). A true and correct copy of the 2018 Assignment is attached hereto as **Exhibit 3**.

¹ Petitioner erroneously claims that the assignment was executed on November 12, 2006; however, the assignment agreement clearly states the date of execution as December 11, 2006.

² The assignment was recorded in the U.S.P.T.O. on January 11, 2007 under Reel 3459 Frame 0516.

³ The assignment was recorded in the U.S.P.T.O. on September 12, 2014 under Reel 5361 Frame 0863.

⁴ The assignment was recorded in the U.S.P.T.O. on November 22, 2018 under Reel 6488 Frame 0001.

7. The BANDA MAGUEY mark is recognized throughout the World, including without limitation, the United States, and has been commercially exploited consecutively for over 25 years, by: 1) recording and releasing several albums; and 2) performing live musical concerts at venues throughout the United States.

8. For over 25 years, a great deal of time and money has been expended in building the musical group's recognition by the public as BANDA MAGUEY.

9. The BANDA MAGUEY mark and musical group have developed extensive goodwill throughout the United States.

10. Registrant has invested a substantial sum in advertising and promoting the BANDA MAGUEY mark and musical group throughout the United States.

11. The BANDA MAGUEY mark and musical group has garnered a most valuable reputation by dint of its promotional activities, advertising and by virtue of massive public interest and news coverage, as well as the excellence of its live musical performance services.

12. Since the acquisition of the rights, title and interests of the BANDA MAGUEY mark and business associated therewith in 2018, Registrant has advertised, promoted and engaged in live musical performance services under said mark and the **LA ORIGINAL BANDA MAGUEY !Y... PURO VILLA CORONA! Y SIGUE, Y SIGUE** mark in commerce throughout the World, including without limitation, the United States.

13. On January 15, 2019, Registrant filed a trademark application for the **LA ORIGINAL BANDA MAGUEY !Y... PURO VILLA CORONA! Y SIGUE, Y SIGUE** design mark, U.S. Application Serial No. 88/262,127, claiming ownership of U.S. Registration No. 2,198,067 for

BANDA MAGUEY word mark, which was in full force and effect.⁵ The application for **LA ORIGINAL BANDA MAGUEY !Y... PURO VILLA CORONA! Y SIGUE, Y SIGUE** matured into U.S. Trademark Registration No. 5,985,963 on February 11, 2020. Second Amended Petition ¶19 (TTABVUE 21).

14. On May 4, 2020, Petitioner filed Application Serial No. 88/900,353 for the BANDA MAGUEY mark in International Class 41 for “Entertainment, namely, live music concerts”. Second Amended Petition ¶20 (TTABVUE 21).

III. STATEMENT OF LAW FOR JUDGMENT ON THE PLEADINGS

A motion for judgment on the pleadings is designed to save the time and expense of a full trial when a party is able to demonstrate, prior to trial, that there is no genuine dispute of material fact to be resolved, and the moving party is entitled to judgment as a matter of law. *Media Online Inc. v. El Clasificado Inc.*, 88 USPQ2d 1285, 1288 (TTAB 2008); *see also* 5C C. Wright & A. Miller, Fed. Prac. & Proc. Civ. § 1369 (3d. ed. 2017).

A motion for judgment on the pleadings is a test solely of the undisputed facts appearing in all the pleadings, supplemented by any facts of which the Board may take judicial notice. TBMP § 504.02; *Kraft Group LLC v. Harpole*, 90 USPQ2d 1837, 1840 (TTAB 2009); *Land O'Lakes Inc. v. Hugunin*, 88 USPQ2d 1957, 1958 (TTAB 2008). For the purpose of this motion, all well-pleaded factual allegations of the non-moving party must be accepted as true, while those allegations of the moving party which have been denied (or which are taken as denied, pursuant to Fed. R. Civ. P. 8(b)(6), because no responsive pleading thereto is required or permitted) are deemed false. Conclusions of law are not taken as admitted.

⁵ Such registration was subject to Cancellation No. 92071438, which was granted by default on September 28, 2019, as Registrant did not receive notice in time to seek appropriate legal representation and appear before the TTAB.

All reasonable inferences from the pleadings are drawn in favor of the nonmoving party. *Id.*; *see also Media Online Inc. v. El Clasificado Inc.*, 88 USPQ2d 1285, 1288 (TTAB 2008). A judgment on the pleadings may be granted only where, on the facts as deemed admitted, there is no genuine issue of material fact to be resolved, and the moving party is entitled to judgment on the substantive merits of the controversy, as a matter of law. *Id.*

Registrant is submitting herewith documentary evidence regarding the chain of title for the BANDA MAGUEY mark, which are mentioned in Petitioner's pleadings and material to his claim of ownership and priority of use. As such, the documentary evidence should not be taken as matters outside the pleadings. However, should the Board deem these documents as such, Registrant respectfully requests this Board to treat this motion as a motion for summary judgment under Fed. R. Civ. P. 56, pursuant to TBMP § 504.03, and allow the submission of additional evidence in support of the arguments set forth herein.

IV. STATEMENT OF LAW FOR SUMMARY JUDGMENT

Summary judgment is appropriate "if the pleadings, the discovery and disclosure materials on file, and any affidavits show that there is no genuine issue as to any material fact and that the movant is entitled to judgment as a matter of law." Fed. R. Civ. P. 56(c). Registrant, as movant, must show there is an absence of evidence to support Petitioner's case. *See Celotex Corp. v. Catrett*, 477 U.S. 317, 325 (1986). Plaintiff must do more than simply show there is doubt as to the material facts; he must go beyond the pleadings and present evidence showing there is a genuine issue of material fact for trial. *Id.* at 324. Summary judgment procedure is available to the Trademark Trial and Appeal Board when appropriate. TBMP §528.01.

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V. ARGUMENT

For purposes of this motion **only**, assuming and taking all well-pleaded factual allegations as set forth by Petitioner as if they were true, does not lead to the legal conclusion drawn by Petitioner.

Petitioner's seeks the cancellation of Registrant's **LA ORIGINAL BANDA MAGUEY !Y... PURO VILLA CORONA! Y SIGUE, Y SIGUE** design mark on grounds of (i) priority over the BANDA MAGUEY word mark, Reg. '067; and, (ii) likelihood of confusion due to the similarity of the marks and identified services.

Registrant's position is that he acquired all the rights, title and interest in and to the BANDA MAGUEY word mark, Reg. '067, and subsequently applied-for and obtained a trademark registration for the **LA ORIGINAL BANDA MAGUEY !Y... PURO VILLA CORONA! Y SIGUE, Y SIGUE** design mark.

Clearly, the asserted ground for cancellation and posture of this cancellation proceeding, as presented by the parties, is that of an "ownership" case.

Therefore, one only needs to look at the chain of title for the BANDA MAGUEY word mark, which is recorded with the USPTO. The rest are unsubstantiated theories that are false, irrelevant and most importantly, are not within the jurisdiction of the TTAB.⁶

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⁶ The TTAB is an administrative adjudicatory entity of limited jurisdiction. The Board is empowered to determine only the right to register. Trademark Act §§ 17, 18, 20 and 24 (15 U.S.C. §§ 1067, 1068, 1070, and 1092) See Conolty v. Conolty O'Connor NYC LLC, 111 USPQ2d 1302, 1309 (TTAB 2014); Blackhorse v. Pro-Football, Inc., 111 USPQ2d 1080, 1082-83 (TTAB 2014). The Trademark Board is not authorized to decide who is entitled to the use or exclusive use of a mark or to decide questions of trademark infringement or unfair competition. See, Seculus Da Amazonia v. Toyota Jidosha, 66 U.S.P.Q.2d 1154, n.5, 2003 WL 648117 (TTAB 2003); The Board of Trustees of the University of Alabama v. Pitts, 107 U.S.P.Q.2d 2001, 2020, 2013 WL 4397047 (TTAB 2013)

Judicial Notice

Registrant requests this Honorable Board take judicial notice of the documents showing the chain of title for the BANDA MAGUEY word mark, Reg. 2,198,067, consisting of three (3) separate and independent Trademark Assignment Agreements. See **Exhibit 1** (2006 Assignment where Petitioner gains ownership), **Exhibit 2** (2014 Assignment where Petitioner transfers ownership) and **Exhibit 3** (2018 Assignment where Registrant gains ownership).

1. *There is no genuine issue of material fact surrounding Petitioner's non-ownership of the BANDA MAGUEY word mark*

There is no genuine issue of material fact surrounding Petitioner's surrender, abandonment and transfer of all trademark rights in and to the BANDA MAGUEY as of the execution of the 2014 Assignment. "An assignment seeks to transfer the trademark owner's rights in the mark to an assignee, thus giving the assignee the benefit of the assignor's priority over third persons in the use of the designation." Restatement (Third) of Unfair Competition § 29 (1995). All courts follow the rule that after a valid assignment, the assignee acquires all of the legal advantages of the mark that the assignor enjoyed, including priority of use. 3 McCarthy on Trademarks and Unfair Competition § 18:15 (5th ed.)

An assignment divests the assignor of all its trademark rights. Therefore, the title acquired by the assignee is superior. 3 McCarthy on Trademarks and Unfair Competition § 18:15 (5th ed.); see also *Replegle v. Air-Way Co.*, 287 F. 765, 767 (App. D.C. 1923) ("By use in connection with the business the assignee acquires the title abandoned by the assignor, and the title is of that exclusive character which is entitled to protection even against such assignor."). **An assignor obviously cannot turn around and continue use of the trademark which he has sold to another, otherwise he would keep both the purchase**

price and the trademark which was sold for that price. (emphasis added) 3 McCarthy on Trademarks and Unfair Competition §18:15 (5th ed.); *see also Guth v. Guth Chocolate Co.*, 224 F. 932, 934 (C.C.A. 4th Cir. 1915) (“Stripped of all pretenses, what he really seeks to do is to keep for himself the essential thing he sold, and also keep the price he got for it.”); *Levitt Corp. v. Levitt*, 593 F.2d 463, 468, 201 U.S.P.Q. 513 (2d Cir. 1979) (“To protect the property interest of the purchaser, then, the courts will be especially alert to foreclose attempts by the seller to ‘keep for himself the essential thing he sold, and also keep the price he got for it,’ ” *quoting Guth v. Guth Chocolate Co.*); *Dovenmuehle v. Gildorn Mortg. Midwest Corp.*, 871 F.2d 697, 701, 10 U.S.P.Q.2d 1550 (7th Cir. 1989).

The well-pleaded facts summarized above establish that the BANDA MAGUEY word mark was and has been used in commerce since or around 1994. When the mark was first used, it was necessarily owned by the members of the musical group. The BANDA MAGUEY word mark was registered with the USPTO and all the links in the chain of title were recorded with the USPTO Assignment Recordation Branch. According to such documents and the parties’ allegations, Petitioner was listed as the owner of the BANDA MAGUEY word mark, Reg. ‘067, from December 11, 2006 to February 5, 2014. On the later date, Petitioner signed a trademark assignment agreement transferring the BANDA MAGUEY word mark to the Mexican entity Xopillyn SC, which was represented in said act by Mr. Jose Rosario Cisneros. *See Exhibit 2.* Neither of the parties dispute the validity of such transaction nor the fact that Mr. Jose Rosario Cisneros was authorized to execute an assignment agreement on behalf of Xopillyn SC. Further, after reading the content of said assignment, any reasonable trier of fact can conclude that Petitioner did not retain or reserve any rights or establish any conditions subsequent. As such, Xopillyn SC acquired all the rights and interests in and to

the BANDA MAGUEY word mark, including all priority rights, **free and clear** and continued the business of providing entertainment services under said mark.

Furthermore, the facts and pleadings show that Registrant entered into an agreement with the last listed registrant of the BANDA MAGUEY word mark, Xopillyn SC, represented by Mr. Rosario Cisneros; and, subsequently, Registrant applied-for and obtained a trademark registration for the **LA ORIGINAL BANDA MAGUEY !Y... PURO VILLA CORONA! Y SIGUE, Y SIGUE** design mark subject to this cancellation proceeding. If anything, the record and pleadings show that, in filing the application for the **LA ORIGINAL BANDA MAGUEY !Y... PURO VILLA CORONA! Y SIGUE, Y SIGUE** design mark, Registrant acted with the legitimate belief that he owned the entire rights, title and interest in and to the BANDA MAGUEY mark, including U.S. Reg. '067. Therefore, no reasonable basis in fact exists to sustain an allegation that Registrant acted fraudulently or made false and fraudulent statements in order to acquire proprietary rights and priority over the BANDA MAGUEY word mark or in filing the application for the **LA ORIGINAL BANDA MAGUEY !Y... PURO VILLA CORONA! Y SIGUE, Y SIGUE** design mark.

The record shows the utter absurdity of Petitioner's claim that he has used the BANDA MAGUEY word mark "consecutively for over 25 years" and that he has any "ownership right" and/or "priority" over said mark. The 2014 Assignment divested Petitioner's rights over the BANDA MAGUEY word mark and transferred the same to Xopillyn SC, as a title of such exclusive character that is entitled to protection even against Petitioner. These rights were subsequently acquired by Registrant and Petitioner's attempts to regain and keep said rights for himself must be foreclosed by this Board.

The law is clear and the contracts assigning trademark rights are binding. Both prevent Petitioner from asserting a claim against Xopillyn SC and Registrant for their use of the BANDA MAGUEY word mark. 3 McCarthy on Trademarks and Unfair Competition § 18:15 (5th ed.); *see also* Restatement (Third) of Unfair Competition § 34, comment b (1995) (An assignment is binding so as to prevent the assignor from asserting an infringement claim against the assignee's use of the mark.)

2. *There is no genuine question of material fact that Application 88/900,353 is void ab initio and, thus, Petitioner is not entitled to bring this cancellation*

In its August 30, 2022 order, the Board found that since the amended petition to cancel alleged that Petitioner “filed application Serial No. 88/900,353 for the BANDA MAGUEY, ownership was sufficiently pleaded.” (TTABVUE 20) However, the Board also acknowledged that Registrant’s assertions as to Petitioner’s lack of ownership presented issues on the merits of Registrant’s defenses to Petitioner’s claim of priority. However, since the assertions were made in a Motion to Dismiss and such motions can solely test the sufficiency of the pleadings, the Board did not address them. By the same token, the Board stated that Registrant’s Motion to Dismiss relied on matter outside the pleadings, and, thus, it had to be construed as a motion for summary judgment, which was premature as Registrant had not yet served the initial disclosures to Petitioner..

Now, in a more advanced stage of the proceedings, Registrant submits and maintains that, based on the circumstances presented in this case, Application Serial No. 88/900,353 is void *ab initio*, and cannot be considered by this Board as sufficient to establish entitlement to a statutory cause of action.

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a. Application Serial No. 88/900,353 is void ab initio

Pursuant to Section 1(a)(1) of the Trademark Act, 15 U.S.C. § 1051(a)(1), only “[t]he owner of a trademark used in commerce may request registration of its trademark ...” *Holiday Inn v. Holiday Inns, Inc.*, 534 F.2d 312, 189 USPQ 630, 635 n.6 (CCPA 1976) (“One must be the owner of a mark before it can be registered.”); *In re Deister Concentrator Co.*, 289 F.2d 496, 129 USPQ 314, 320 (CCPA 1961) (“Under section 1, only ‘[t]he owner of a trademark’ can apply for registration.”). Therefore, “[a]n application filed by one who is not the owner of the mark sought to be registered is a void application.” *In re Tong Yang Cement Corp.*, 19 USPQ2d 1689, 1690 (TTAB 1991) (citing *In re Techsonic Indus., Inc.*, 216 USPQ 619 (TTAB 1982)); see also *Huang v. Tzu Wei Chen Food Co.*, 849 F.2d 1458, 7 USPQ2d 1335 (Fed. Cir. 1988) (affirming Board’s holding that an application was void *ab initio* because the applicant was not the owner of the mark on the filing date); *Great Seats Ltd. v. Great Seats Inc.*, 84 USPQ2d 1235, 1239 (TTAB 2007) (“In a use-based application under Trademark Act Section 1(a), only the owner of the mark may file the application for registration of the mark; if the entity filing the application is not the owner of the mark as of the filing date, the application is void *ab initio*.”)

Here, the undisputed facts establish that Petitioner willfully transferred the BANDA MAGUEY word mark to a third-party in 2014. In spite of this, Petitioner claims to be the owner of said trademark and to possess priority rights since 1994. Notwithstanding, the record is clear and shows exactly who owned the BANDA MAGUEY word mark and when. Simply put, Petitioner assigned all the rights to the BANDA MAGUEY word mark and was not the owner of said mark on May 4, 2020, the filing date for Application Serial No. 88/900,353. Despite this, Petitioner chose to submit a declaration under penalty of perjury falsely

claiming to be the owner of the BANDA MAGUEY word mark. Thus, Application Serial No. 88/900,353 is void *ab initio*.

Furthermore, the statements under penalty of perjury made in Application Serial No. 88/900,353 state that Petitioner is entitled to use the mark in commerce and that the information set forth in the application is true. However, the pleadings in the Second Amended Petition clearly demonstrate that Petitioner is well aware and informed of the changes of ownership of the BANDA MAGUEY word mark. As such, Petitioner knows that he is not entitled to use the BANDA MAGUEY mark in commerce. A fact which is undisputed and material for a judgment in this proceeding, as well as the registration of the mark in Application 88/900,353. Accordingly, not only is Application 88/900,353 void *ab initio*, but Petitioner's statements therein, as well as his allegations in Second Amended Petition, are knowingly false and made intentionally and knowingly to deceive both the USPTO and the TTAB.

b. Petitioner is not entitled to bring this cancellation

Petitioner has the burden of establishing that he is entitled by the Lanham Act to bring this cancellation proceeding, and he has not and cannot satisfy this burden. At the pleading stage, all that is required is that a plaintiff allege facts sufficient to show it has an interest within the zone of interests protected by statute, i.e., a "real interest" and damage proximately caused by registration, i.e., a "reasonable basis" for its belief that it would suffer some kind of damage if the mark is registered. *See* TBMP § 309.03(b) To plead a zone of interest protected by statute, referred to in prior case law as a "real interest," plaintiff must allege a "direct and personal stake" in the outcome of the proceeding. *Id.* The allegations in

support of plaintiff's belief of damage proximately caused by registration must have a reasonable basis "in fact." *Id.*

Petitioner's void and fraudulent trademark application cannot provide entitlement to a statutory cause of action. Petitioner cannot show that his entitlement to petition to cancel is within the zone of interests protected by the Lanham Act. Petitioner cannot possibly have a direct and personal stake in the outcome of this proceeding, as he possesses no rights in and to the BANDA MAGUEY mark since 2014. Likewise, no reasonable basis in fact can be alleged to support Petitioner's claim that the continued registration of the **LA ORIGINAL BANDA MAGUEY !Y... PURO VILLA CORONA! Y SIGUE, Y SIGUE** design mark has caused or will cause him any damage, since he is not the legitimate owner of the BANDA MAGUEY word mark. Rather, both the pleadings and facts serve to show that Petitioner's unauthorized use of the mark in connection with live musical performances after the 2014 Assignment is in clear derogation and violation of BANDA MAGUEY word mark as an asset, and constitutes both **trademark infringement** and **breach of contract**. 3 McCarthy on Trademarks and Unfair Competition § 18:15 (5th ed.). Accordingly, Petitioner's brazen and unsubstantiated attempt to cancel Registrant's entirely valid trademark registration for the **LA ORIGINAL BANDA MAGUEY !Y... PURO VILLA CORONA! Y SIGUE, Y SIGUE** design mark should not be entertained further by this Board.

In light of all the foregoing, Petitioner cannot prevail on the issues of ownership, priority and likelihood of confusion. Petitioner cannot even show entitlement to bring this cancellation. Thus, Registrant is entitled to judgment as a matter of law.

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VI. CONCLUSION AND PRAYER FOR RELIEF

In view of all the foregoing, deeming all the well-pled facts as true, there are no genuine issues of material fact that could be inferred that would support the allegations that Petitioner is the owner and can claim priority of use of the BANDA MAGUEY word mark. Simply put, both the pleadings and evidence show that: (i) Petitioner voluntarily and willfully transferred the entire rights, including priority, in and to the BANDA MAGUEY word mark to a third-party in 2014; (ii) Registrant entered into an agreement with the last listed owner of the BANDA MAGUEY word mark and continued use of said mark and business in commerce; (iii) in filing the application for the **LA ORIGINAL BANDA MAGUEY !Y... PURO VILLA CORONA! Y SIGUE, Y SIGUE** design mark, Registrant acted with the legitimate belief that he owned the entire rights, title and interest in and to the BANDA MAGUEY mark, including U.S. Reg. '067; (iv) Application Serial No. 88/900,353 for the BANDA MAGUEY mark is void *ab initio*; and, thus, (v) Petitioner lacks entitlement to a statutory cause of action.

Therefore, since Petitioner cannot validly and legitimately claim ownership and priority of use of the BANDA MAGUEY mark, it follows that there can be no likelihood of confusion with Registrant's **LA ORIGINAL BANDA MAGUEY !Y... PURO VILLA CORONA! Y SIGUE, Y SIGUE** design mark. The claims in the Second Amended Petition are inevitably destined to fail as a matter of law. Accordingly, Registrant is entitled to entry of judgment against Petitioner.

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WHEREFORE, Registrant Jorge Ernesto Ramirez Ceballos respectfully submits this Board should GRANT this motion for judgment on the pleadings or, in the alternative, GRANT summary judgment in favor of Registrant; and, dismiss the Petition for Cancellation with prejudice.

Respectfully submitted,

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Dated: April 17, 2023

Attorneys for Registrant

CERTIFICATE OF TRANSMITTAL

I hereby certify that a true copy of the foregoing **MOTION FOR JUDGMENT ON THE PLEADINGS OR, ALTERNATIVELY, MOTION FOR SUMMARY JUDGMENT** is being electronically filed with the TTAB via ESTTA and served by email upon Petitioner's attorney of record on this 17th day of April, 2023.

By: /Alice M. Cabrera/
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EXHIBIT 1

TRADEMARK ASSIGNMENT

Electronic Version v1.1
 Stylesheet Version v1.1

SUBMISSION TYPE:	NEW ASSIGNMENT
NATURE OF CONVEYANCE:	ASSIGNS THE ENTIRE INTEREST AND THE GOODWILL

CONVEYING PARTY DATA

Name	Formerly	Execution Date	Entity Type
martin g ibarra		12/11/2006	INDIVIDUAL: MEXICO
SAMUEL VIDAL		12/11/2006	INDIVIDUAL:
FRANCISCO RICARDO MENDOZA		12/11/2006	INDIVIDUAL: MEXICO
JOSE LUIS ROSAS		12/11/2006	INDIVIDUAL: MEXICO
LUIS ANTONIO PLASENCIA		12/11/2006	INDIVIDUAL: MEXICO
LUIS GERARDO ROSALES		12/11/2006	INDIVIDUAL: MEXICO
NELSON ALEJANDRO MENDOZA		12/11/2006	INDIVIDUAL: MEXICO

RECEIVING PARTY DATA

Name:	MIGUEL ANGEL VIDAL
Street Address:	ZARAGOZA 93
City:	VILLA CORONA
State/Country:	MEXICO
Postal Code:	44680
Entity Type:	INDIVIDUAL: MEXICO

PROPERTY NUMBERS Total: 1

Property Type	Number	Word Mark
Registration Number:	2198067	BANDA MAGUEY

CORRESPONDENCE DATA

Fax Number: (210)697-1664
Correspondence will be sent via US Mail when the fax attempt is unsuccessful.
 Phone: 210 697 1664
 Email: mygabogados@infosel.net.mx
 Correspondent Name: ALEJANDRO R. MALACARA
 Address Line 1: 82 chapel hill circle
 Address Line 4: san antonio, TEXAS 78240

OP \$40.00 2198067

DOMESTIC REPRESENTATIVE

Name: ALEJANDRO R. MALACARA
Address Line 1: 82 CHAPEL HILL CIRCLE
Address Line 4: SAN ANTONIO, TEXAS 78240

NAME OF SUBMITTER:	MIGUEL ANGEL VIDAL
Signature:	/MIGUEL ANGEL VIDAL/
Date:	01/11/2007

Total Attachments: 2
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source=banda maguey assigment222#page2.tif

Assignment of Trademark

THIS AGREEMENT, MADE AS OF THIS 11 DAY OF DECEMBER 2006, BY AND BETWEEN IBARRA TORRES JOSE MARTIN GERARD, LUIS ANTONIO PLASENCIA, SAMUEL VIDAL PULIDO, FERNANDO GUARDADO ROSALES, FRANCISCO RICARDO MENDOZA, NELSON ALEJANDRO MENDOZA JOSE LUIS MENDOZA ROSAS AND FRANCISCO JAVIER BUENO HERNANDEZ CITIZENS OF MEXICO PARTNERSHIP PRINCIPAL PLACE OF BUSINESS AT ZARAGOZA #93 VILLA CORONA JALISCO MEXICO LEGALLY ("HEREINAFTER ASSIGNORS"), AND MIGUEL ANGEL VIDAL PULIDO PRINCIPAL PLACE OF BUSINESS AT CALLE FRANCISCO #112 cp. 45730 VILLA CORONA JALISCO MEXICO (HEREINAFTER ASSIGNEES")

LEGAL BASIS Assignment of Marks

Assignability of Marks in Applications and Registrations

Extract from 15 U.S.C. §1060(a). A registered mark or a mark for which an application to register has been filed shall be assignable with the good will of the business in which the mark is used, or with that part of the good will of the business connected with the use of and symbolized by the mark. Notwithstanding the preceding sentence, no application to register a mark under section 1(b) shall be assignable prior to the filing of an amendment under section 1(c) to bring the application into conformity with section 1(a) or the filing of the verified statement of use under section 1(d), except for an assignment to a successor to the business of the applicant, or portion thereof, to which the mark pertains, if that business is ongoing and existing. In any assignment authorized by this section, it shall not be necessary to include the good will of the business connected with the use of and symbolized by any other mark used in the business or by the name or style under which the business is conducted. Assignments shall be by instruments in writing duly executed...

*Extract from 37 C.F.R. §3.1. *** Assignment means a transfer by a party of all or part of its right, title and interest in a patent or patent application, or a transfer of its entire right, title and interest in a registered mark or a mark for which an application to register has been filed*

WITNESSETH

WHEREAS, Assignors are the OWNERS of inter alia US REGISTRATION 2,198,067 BANDA MAGUEY international Class 041 for ENTERTAINMENT SERVICES NAMELY LIVE PERFORMANCES BY MUSICAL BAND

WHEREAS, Assignee recognizes and acknowledge that the Trademark Registration is in force in the Patent & Trademark Office in Washington DC.

WHEREAS, Assignee owns the trademarks registrations 444788, maguey class 41; 518327 Banda Maguey class 41, in force in the Mexican institute of Industrial property.

WHEREAS, Assignor hereby sells, assigns, transfers, and sets over Assignee the following Trademark registration

Registration	TRADEMARK	CLASS
2,198,067	BANDA MAGUEY	041

WHEREAS Assignor's right, title is interest in and to the hereinabove mentioned trademark registration.

NOW THEREFORE, in consideration of the premises and the terms and conditions hereinafter set forth, and for other good and valuable consideration, the receipt and sufficiency of which are hereby acknowledged, the parties agree as follows:


1. - Assignors hereby further Sells, assigns, transfers, and sets over unto Assignee, the above registration in United States of America of assignor's entire right, title and interest in and to said trademark.
2. - Assignors further conveys to Assignee the above Trademark of all priority rights resulting from the above-identified trademark
3. - Assignors agrees to execute all papers, give any required testimony und perform other lawful acts, at Assignees expense, as Assignee may require to enable Assignee to perfect Assignee's interest, and to acquire, hold, enforce, convey, and uphold the validity of said trademark registration and reissues and extensions thereof, and Assignee's interest therein.
4. - This Agreement shall not be altered or modified without the written consent of the parties.

In testimony whereof the parties sign on the date below.


IBARRA TORRES JOSE MARTIN GERARD

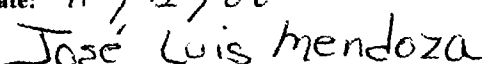
Date: 11/12/06


SAMUEL VIDAL PULIDO,

Date: 11/12/06 

FRANCISCO RICARDO MENDOZA,

Date: 11/12/06


JOSE LUIS MENDOZA ROSAS

Date 11/12/06

ASSIGNORS


, LUIS ANTONIO PLASENCIA,

date: 11-12-06


FERNANDO GUARDADO ROSALES,

Date: 11-12-06

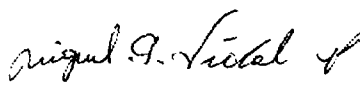

NELSON ALEJANDRO MENDOZA

Date: 11-12-06


FRANCISCO JAVIER BUENO

Date: 11-12-06

ASSIGNEES



MIGUEL ANGEL VIDAL PULIDO

DATE: 11-12-06

EXHIBIT 2

TRADEMARK ASSIGNMENT COVER SHEET

Electronic Version v1.1
Stylesheet Version v1.2

ETAS ID: TM316894

SUBMISSION TYPE:	NEW ASSIGNMENT		
NATURE OF CONVEYANCE:	ASSIGNMENT OF THE ENTIRE INTEREST AND THE GOODWILL		
CONVEYING PARTY DATA			
Name	Formerly	Execution Date	Entity Type
miguel angel vidal		02/05/2014	INDIVIDUAL: MEXICO
RECEIVING PARTY DATA			
Name:	XOPILLYN SC		
Street Address:	ZARAGOZA 93		
City:	VILLA CORONA		
State/Country:	MEXICO		
Postal Code:	44680		
Entity Type:	CORPORATION: MEXICO		
PROPERTY NUMBERS Total: 1			
Property Type	Number	Word Mark	
Registration Number:	2198067	BANDA MAGUEY	
CORRESPONDENCE DATA			
Fax Number:			
<i>Correspondence will be sent to the e-mail address first; if that is unsuccessful, it will be sent using a fax number, if provided; if that is unsuccessful, it will be sent via US Mail.</i>			
Email:	alejandro.malacara57@gmail.com		
Correspondent Name:	JOSE ROSARIO CISNEROS		
Address Line 1:	ZARAGOZA 63		
Address Line 4:	VILLA CORONA, MEXICO 44680		
NAME OF SUBMITTER:	JOSE ROSARIO CISNEROS		
SIGNATURE:	/JOSE ROSARIO CISNEROS/		
DATE SIGNED:	09/12/2014		
Total Attachments: 3			
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source=assignment banda maguey#page2.tif			
source=assignment banda maguey#page3.tif			

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Assignment of Trademark

This Agreement, made as of this 5 day of February 2014, by and between MIGUEL ANGEL VIDAL with its principal place of business at Zaragoza 93 Villa Corona Jalisco México 44680. ("hereinafter Assignor), and Xopilyn SC represented by SR. JOSE ROSARIO CISNEROS GUTIERREZ with its principal place of business at Zaragoza 93 Villa Corona Jalisco México 44680 ("hereinafter Assignee")

LEGAL BASIS Assignment of Marks

Assignability of Marks in Applications and Registrations

Extract from 15 U.S.C. §1060(a). A registered mark or a mark for which an application to register has been filed shall be assignable with the good will of the business in which the mark is used, or with that part of the good will of the business connected with the use of and symbolized by the mark. Notwithstanding the preceding sentence, no application to register a mark under section 1(b) shall be assignable prior to the filing of an amendment under section 1(c) to bring the application into conformity with section 1(a) or the filing of the verified statement of use under section 1(d), except for an assignment to a successor to the business of the applicant, or portion thereof, to which the mark pertains, if that business is ongoing and existing. In any assignment authorized by this section, it shall not be necessary to include the good will of the business connected with the use of and symbolized by any other mark used in the business or by the name or style under which the business is conducted. Assignments shall be by instruments in writing duly executed...

*Extract from 37 C.F.R. §3.1. *** Assignment means a transfer by a party of all or part of its right, title and interest in a patent or patent application, or a transfer of its entire right, title and interest in a registered mark or a mark for which an application to register has been filed*

WITNESSETH

WHEREAS, Assignor is the OWNER of inter alia US REGISTRATION 2,198,067 in international Class 041

WHEREAS, Assignee recognizes and acknowledge that the Trademark Registration is in force in the Patent & Trademark Office in Washington DC.

WHEREAS, Assignor hereby sells, assigns, transfers, and sets over Assignee the following Trademark registration

REGISTRATION	TRADEMARK	CLASS
2,198,067	BANDA MAGUEY	041

WHEREAS Assignor's right, title is interest in and to the hereinabove mentioned trademark registration.

NOW THEREFORE, in consideration of the premises and the terms and conditions hereinafter set forth, and for other good and valuable consideration, the receipt and sufficiency of which are hereby acknowledged, the parties agree as follows:

1. - Assignor hereby further Sells, assigns, transfers, and sets over unto Assignee, the above registration in United States of America of assignor's entire right, title and interest in and to said trademark.

2. - Assignor further conveys to Assignee the above Trademark of all priority rights resulting from the above-identified trademark


3. - Assignor agrees to execute all papers, give any required testimony und perform other lawful acts, at Assignees expense, as Assignee may require to enable Assignee to perfect Assignee's interest, and to acquire, hold, enforce, convery, and uphold the validity of said trademark registration and reissues and extensions thereof, and Assignee's interest therein.

4. - This Agreement shall not be altered or modified without the written consent of the parties.

In testimony whereof the parties have hereunto set its hand on the date below.

ASSIGNEE

ASSIGNOR


NAME: MIGUEL ANGEL VIDAL
DATE:

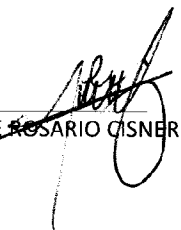

NAME: SR. JOSE ROSARIO CISNEROS GUTIERREZ
DATE:

EXHIBIT 3

TRADEMARK ASSIGNMENT COVER SHEET

Electronic Version v1.1
Stylesheet Version v1.2

ETAS ID: TM499276

SUBMISSION TYPE:	NEW ASSIGNMENT		
NATURE OF CONVEYANCE:	ASSIGNMENT OF THE ENTIRE INTEREST AND THE GOODWILL		
CONVEYING PARTY DATA			
Name	Formerly	Execution Date	Entity Type
XOPILLIN S.C.		03/23/2018	Corporation: MEXICO
RECEIVING PARTY DATA			
Name:	JORGE ERNESTO RAMIREZ- CEVALLOS		
Street Address:	ZARAGOZA 124 - A		
City:	SAN PEDRO TLAQUEPAQUE		
State/Country:	MEXICO		
Postal Code:	45200		
Entity Type:	INDIVIDUAL: MEXICO		
PROPERTY NUMBERS Total: 1			
Property Type	Number	Word Mark	
Registration Number:	2198067	BANDA MAGUEY	
CORRESPONDENCE DATA			
Fax Number:			
<i>Correspondence will be sent to the e-mail address first; if that is unsuccessful, it will be sent using a fax number, if provided; if that is unsuccessful, it will be sent via US Mail.</i>			
Email:	alejandro.malacara57@gmail.com		
Correspondent Name:	ALEJANDRO MALACARA O		
Address Line 1:	PASEO SAN ATURO 763		
Address Line 4:	ZAPOPAN, MEXICO 45019		
NAME OF SUBMITTER:	JORGE ERNESTO RAMIREZ-CEVALLOS		
SIGNATURE:	/JORGE ERNESTO RAMIREZ-CEVALLOS /		
DATE SIGNED:	11/22/2018		
Total Attachments: 3			
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source=assignment banda maguey#page2.tif			
source=assignment banda maguey#page3.tif			

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Assignment of Trademark

THIS AGREEMENT, MADE AS OF THIS 23 DAYS OF MARCH, 2018 BY AND BETWEEN XOPILLYN SC. HEREINAFTER REPRESENTED BY MR JOSE ROSARIO CISNEROS PRESIDENT & CEO ADDRESS ZARAGOZA 93 VILLA CORONA JALISCO 45730 MEXICO ("HEREINAFTER ASSIGNOR"), AND JORGE ERNESTO RAMIREZ-CEBALLOS ADDRESS ZARAGOZA 124 - A SAN PEDRO TLAQUEPAQUE JALISCO MEXICO 45200 ("HEREINAFTER ASSIGNEE")

LEGAL BASIS Assignment of Marks

Assignability of Marks in Applications and Registrations

Extract from 15 U.S.C. §1060(a). A registered mark or a mark for which an application to register has been filed shall be assignable with the good will of the business in which the mark is used, or with that part of the good will of the business connected with the use of and symbolized by the mark. Notwithstanding the preceding sentence, no application to register a mark under section 1(b) shall be assignable prior to the filing of an amendment under section 1(c) to bring the application into conformity with section 1(a) or the filing of the verified statement of use under section 1(d), except for an assignment to a successor to the business of the applicant, or portion thereof, to which the mark pertains, if that business is ongoing and existing. In any assignment authorized by this section, it shall not be necessary to include the good will of the business connected with the use of and symbolized by any other mark used in the business or by the name or style under which the business is conducted. Assignments shall be by instruments in writing duly executed....

Extract from 37 C.F.R. §3.1. *** Assignment means a transfer by a party of all or part of its right, title and interest in a patent or patent application, or a transfer of its entire right, title and interest in a registered mark or a mark for which an application to register has been filed

WITNESSETH

WHEREAS, Assignee recognizes and acknowledge that the Trademark Registration is in force in the Patent & Trademark Office in Washington DC.

WHEREAS, Assignor hereby sells, assigns, transfers, and sets Trademark registration

REGISTRATION NUMBER	TRADEMARK	CLASS
2,198067	BANDA MAGUEY	041

WHEREAS Assignor's right, title is interest in and to the hereinabove mentioned trademark registration.

NOW THEREFORE, in consideration of the premises and the terms and conditions hereinafter set forth, and for other good and valuable consideration, the receipt and sufficiency of which are hereby acknowledged, the parties agree as follows:

1. - Assignor hereby further Sells, assigns, transfers, and sets over unto Assignee, the above registration in United States of America of assignor's entire right, title and interest in and to said trademark.
2. - Assignor further conveys to Assignees the above Trademark of all priority rights resulting from the above-identified trademark.
3. - Assignor agrees to execute all papers, give any required testimony and perform other lawful acts, at Assignees expense, as Assignee may require to enable Assignee to perfect Assignee's interest, and to acquire, hold, enforce, convey, and uphold the validity of said trademark registration and reissues and extensions thereof, and Assignee's interest therein.
4. - This Agreement shall not be altered or modified without the written consent of the parties.

In testimony whereof the parties have hereunto set its hand on the date below.

ASSIGNOR

ASSIGNEE

XOPILLYN S.C.

JOSE ROSARIO CISNEROS

PRESIDENT & CEO

JORGE ERNESTO RAMIREZ-CEBALLOS



United States Patent and Trademark Office

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Word Mark BANDA MAGUEY

Translations There is no known English translation of the term "MAGUEY". The English translation of the term "BANDA" is "band".

Goods and Services IC 041. US 100 101 107. G & S: entertainment services, namely, live performances by a musical band. FIRST USE: 19910400. FIRST USE IN COMMERCE: 19940500

Mark Drawing Code (1) TYPED DRAWING

Serial Number 75346810

Filing Date August 8, 1997

Current Basis 1A

Original Filing Basis 1A

Published for Opposition July 28, 1998

Registration Number 2198067

Registration Date October 20, 1998

Owner (REGISTRANT) Banda Maguey composed of Ernesto Solano Perez, Ibarra Torres Jose Martin Gerard, Luis Antonio Placencia, Samuel Vidal Pulido, Miguel Angel Vidal Pulido, Fernando Guardado Rosales, Francisco Ricardo Mendoza, Nelson Alejandro Mendoza, Jose Luis Mendoza Rosas, Francisco Javier Bueno Hernandez, citizens of Mexico PARTNERSHIP MEXICO ZARAGOZA #93 VILLA CORONA JALISCO MEXICO 45730

(LAST LISTED OWNER) XOPILLYN SC CORPORATION MEXICO ZARAGOZA 93 VILLA CORONA MEXICO 44680

Assignment Recorded ASSIGNMENT RECORDED

Attorney of Record Mark H. Pfleger

Disclaimer NO CLAIM IS MADE TO THE EXCLUSIVE RIGHT TO USE "BANDA" APART FROM THE MARK AS SHOWN

Type of Mark SERVICE MARK

Register PRINCIPAL

Affidavit Text SECT 15. SECT 8 (6-YR). SECTION 8(10-YR) 20091005.

Renewal 1ST RENEWAL 20091005

Live/Dead Indicator LIVE