

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

CACIQUE, INC.,)	
)	
Opposer,)	
)	
v.)	Opposition No. 91/183,603
)	Mark: LA CACICA
VIRMAX LIMITED,)	Serial No. 76/681,489
)	
Applicant)	
)	

**CACIQUE, INC'S MOTION FOR SUMMARY JUDGMENT AND
SUPPORTING MEMORANDUM OF LAW**

Pursuant to Rule 56 of the Federal Rules of Civil Procedure and Trademark Rule 2.116, Opposer, Cacique, Inc. (hereinafter "Cacique" or "Opposer") respectfully moves for summary judgment on its claim of likelihood of confusion in Count I of the Opposition, and requests that registration be denied to the mark LA CACICA, which is the subject of U.S. Application Serial No. 76/681,489, filed in the name of Virmax Limited (hereinafter "Applicant") for coffee in Class 030. Opposer relies on the pleadings, the record of the USPTO and the Declarations of Ju Chang, Tirso Iglesias, III and the Declaration Report of Dr. R. B Butters Professor Emeritus –English Duke University English Department, filed herewith and incorporated herein by reference. This Motion for Summary Judgment is being timely filed since Opposer's testimony period has not yet commenced. 37 C.F.R. 2.127(E)(1); TBMP 528.02.

1. PRELIMINARY STATEMENT

Opposer has been continuously using the *CACIQUE* mark and variant marks containing *CACIQUE* since at least as early 1973. Opposer is the owner of numerous *CACIQUE* and variant trademark registrations including:

1. **EL CACIQUE**: Reg. No. 1152572 issued on April 28, 1981 for cheese first sold in June 1973;
2. **CACIQUE**: Reg. No. 2915613 issued on January 4, 2005 for dairy products; namely cream first sold in 1980 ;
3. **CACIQUE**: Reg. No. 3,662,558 issued on August 4, 2009 for horchata first sold in 1996; drinkable yogurt, cheese and meat first sold in 1973; and cake made of corn first sold in 1996;
4. **CACIQUE**: Reg. No. 3,859,152 issued on October 12, 2010 for preparation of food and beverages first offered in 1973;
5. **EL CACIQUE and design**: Reg. No. 1215056 issued on November 2, 1982 for sausage first sold in September 1980;
6. **CACIQUE RANCHERO QUESO FRESCO PART SKIM MILK CHEESE**: Reg. No. 3745734 issued on February 9, 2010 for dairy products excluding ice cream, ice milk and frozen yogurt first sold in 2001;
7. **CACIQUE; CREMA SALVADORENA; GRADE A SALVADORAN STYLE SOUR CREAM**: Reg. No. 3574825 issued on February 17, 2009 for dairy products excluding ice cream, ice milk and frozen yogurt first sold in 1999; and
8. **CACIQUE FAMILY RESERVE**: Reg. No. 2963684 issued on June 28, 2005 for dairy products, namely cheese first sold in 1995.

During the 39 years of use of its family of *CACIQUE* trademarks, Opposer has publicly sold enormous quantities of branded goods on a nationwide basis through grocery stores, convenience stores, bodegas, supermarkets and other outlets. The commercial success of Opposer's *CACIQUE* brand products for the last 39 years is due to the successful advertising and marketing efforts by Opposer, and the public's

recognition and acceptance of the brand resulting in huge and continuous volumes of sales. By virtue of this extensive usage of the *CACIQUE* brand for such a long time Opposer has built up substantial and valuable goodwill in the *CACIQUE* family of brands recognized by consumers long before Applicant's 2002 alleged date of first use and long before Applicant's 2007 filing date.

On September 4, 2007, Applicant filed Serial No. 76/681,489 for the mark *LA CACICA* for coffee claiming use in commerce as of November 30, 2002. Opposer timely opposed that application on several grounds including the grounds that *LA CACICA* is likely to cause confusion with Opposer's registered *CACIQUE* marks for related and complementary food products. Opposer's likelihood of confusion claim warrants summary judgment as there are no genuine issues of material fact and there is a likelihood of confusion as a matter of law between *CACIQUE* and *LA CACICA*. Opposer's prior use and registrations establish its priority.

Opposer's family of *CACIQUE* marks for related and complementary goods enjoy great public notoriety and goodwill. Applicant's coffee is closely related and complementary to Opposer's beverage, food and dairy products. The marks are: (1) phonetically and visually strikingly similar; (2) mean the same; and (3) create the same commercial impression. Further, their channels of trade and target markets are the same. Coffee and Mexican-style cheese, sausage cream, horchata and drinkable yogurt are often purchased for use together for breakfast and other meals which further enhances the likelihood of confusion. Applicant's applied for product is coffee. The uncontroverted facts demonstrate that, as a matter of law, *LA CACICA* for coffee is likely to cause confusion with Opposer's mark, *EL CACIQUE/CACIQUE*. Opposer respectfully

requests the Trademark Trial and Appeal Board enter summary judgment against Applicant on Opposer's Count 1 claim.

II. STATEMENT OF UNCONTROVERTED FACTS

A. Opposer's ownership and use of CACIQUE

Since 1973 Opposer has adopted and used *CACIQUE* as its brand for its family of *CACIQUE* food and beverage products including, cheese, cream, horchata (rice drink), drinkable yogurt and sausage. Valuable common law rights have been generated and earned over 39 years of continuous and substantially exclusive use of *CACIQUE* in commerce. (Chang ¶ 4), (Iglesias ¶3). Opposer's trademark enjoys great commercial success and is available at many regional and national retail stores including Wal Mart, COSTCO, Ralphs, Publix, Kroger, Albertsons to name a few. (Iglesias ¶7).

1. Opposer's federal registrations cover a large variety of food and beverage products. Four (4) of the Opposer's eight (8) federal registrations were issued by the U.S. Patent and Trademark Office prior to 2007 and before the Applicant's 2007 filing date. (Chang ¶2).

2. Opposer has spent and continues to spend substantial time and money branding, packaging, advertising and promoting its *CACIQUE* products. For the five (5) years preceding the filing date of Applicant's September 2007 application to register *LA CACICA*, Opposer has expended approximately fifty million dollars (\$50,000,000.00) on promotion, packaging and advertising for its *CACIQUE* branded line of products. (Iglesias ¶8).

B. The Application for LA CACICA

Applicant filed its trademark application to register *LA CACICA* for coffee on September 4, 2007 alleging first use of its mark in commerce at least as early as November 30, 2002.

III. ARGUMENT

A. Summary Judgment Standard

Summary judgment is appropriate where there are no genuine disputes of material fact, thus allowing the case to be resolved as a matter of law. Fed. R. Civ. P. 56(a). The party seeking summary judgment bears the burden of demonstrating the absence of any genuine dispute as to any material fact, and that it is entitled to a judgment under the applicable law. See *Celotex Corp. v. Catrett*, 477 U.S. 317, 323 (1986). In deciding a motion for summary judgment, “[t]he evidence of the non-movant is to be believed, and all justifiable inferences are to be drawn in his favor.” *Boston Scientific Corp. v. Johnson & Johnson*, 647 F.3d 1353, 99 USPQ2d 1001 (Fed. Cir. 2011) quoting *Anderson v. Liberty Lobby, Inc.*, 477 U.S. 242, 255, 106 S. Ct. 2505, 91 L.Ed.2d 202 (1986). A dispute is genuine only if, on the entirety of the record, a reasonable jury could resolve a factual matter in favor of the non-movant. *Sweats Fashion, Inc. v. Pannill Knitting Co.*, 833 F.2d 1560, 1562, 4 USPQ2d 1793, 1795 (Fed. Cir. 1987). The purpose of summary judgment is one of judicial economy, that is, to save the time and expense of a useless trial where no genuine issue of material fact remains. *Pure Gold, Inc. v. Syntex (USA) Inc.*, 739 F.2d 624, 626, 222 USPQ 741, 743 (Fed. Cir. 1984). Resolution of *inter partes* trademark proceedings via summary judgment is to be encouraged. *Phoenix Closures Inc. v. Yen Shaing Corp.*, 9 USPQ2d 1891, 1892 (TTAB 1988). It is not enough for the non-movant to simply demur in response to a motion for

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