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

Proceeding	92065406
Party	Plaintiff Plaza Izalco, Inc.
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In the Matter of:

Registration No.: 4,581,604
Registered: August 4, 2014
Trademark: KOFAL

_____)	
Plaza Izalco, Inc.,)	
)	Cancellation No. 92065406
Petitioner,)	
v.)	
)	
Pharmadel, LLC,)	
)	
Registrant.)	
_____)	

**PETITIONER’S RESPONSE IN OPPOSITION TO
TO RESPONDENT’S MOTION FOR SUMMARY JUDGMENT**

Petitioner, Plaza Izalco, Inc. (“Petitioner”), by and through its undersigned counsel and pursuant to Rule 56 of the Federal Rules of Civil Procedure and TBMP § 528, respectfully submits this Response in Opposition (“Opposition”) to Registrant Pharmadel, LLC’s (“Registrant”), Renewed Motion for Summary Judgment (the “Motion”) (Document 24).

INTRODUCTION AND BACKGROUND INFORMATION

On or around March 27, 1990, Petitioner’s president, Mr. Juan Ventura (“Mr. Ventura”), along with his siblings, including, *inter alia*, Mr. Miguel Ventura, incorporated an entity in and under the laws of the District of Columbia under the legal name Tienda Izalco, Inc. (“Tienda 1”). See **Exhibit A**, attached hereto and incorporated herein by such reference. Tienda 1 provided convenience store related services and products at a retail store located in the District of Columbia. Products offered at the convenience store location, included, *inter alia*, healthcare related products and specifically an analgesic balm under the trademark “COFAL” (“COFAL”).

Mark”), which was then manufactured, marketed, and distributed by Laboratorios Cofala, S.A., an entity located and incorporated under the laws of the Country of Costa Rica (“LC”).

LC had offered its analgesic balm under the COFAL Mark since as early as May 15, 1972 in Costa Rica and owned Costa Rica Trademark Registration No. 44385 for the COFAL Mark reflecting such first usage. On November 1, 1994, LC was granted U.S. Trademark Registration Ser. No. 1,860,634 for the COFAL Mark in International Class 005 for *pharmaceutical preparations; namely, lotion for joint and muscle aches* by the United States Patent and Trademark Office, which was later canceled on November 11, 2001. See **Exhibit B**, attached hereto and incorporated herein by such reference.

On or around May 3, 1994, Mr. Ventura, along with his siblings, including, *inter alia*, Mr. Miguel Ventura, incorporated an entity in and under the laws of the District of Columbia under the legal name Tienda Izalco Columbia Road, Inc. (“Tienda CR”). See **Exhibit C**, attached hereto and incorporated herein by such reference. Tienda CR was a business expansion of the Tienda 1 business model into a secondary location and equally provided convenience store related services and products at a retail store located in the District of Columbia. Similar to Tienda 1, Tienda CR offered LC’s analgesic balm under the COFAL Mark.

In or around 1994, Mr. Ventura, along with his siblings, including, *inter alia*, Mr. Miguel Ventura, incorporated an entity in and under the laws of the Commonwealth of Virginia under the legal name Tienda Izalco 2, Inc. (“Tienda 2”). See **Exhibit D**, attached hereto and incorporated herein by such reference. Similar to Tienda CR, Tienda 2 was a business expansion of the Tienda 1 business model into the Commonwealth of Virginia and provided convenience store related services and products at a retail store located in the Commonwealth of Virginia.

Similar to Tienda 1 and Tienda CR, Tienda 2 offered LC's analgesic balm under the COFAL Mark.

In or around 1995, Mr. Ventura, along with a close friend, incorporated an entity in and under the laws of the Commonwealth of Virginia under the legal name Damas Bodega, Inc. ("Damas"). See **Exhibit E**, attached hereto and incorporated herein by such reference. Similar to Tienda 2, Damas was a business expansion of the Tienda 1 business model into the Commonwealth of Virginia and provided convenience store related services and products at a retail store located in the Commonwealth of Virginia. Similar to Tienda 1, Tienda 2, and Tienda CR, Damas offered LC's analgesic balm under the COFAL Mark.

On or around September 9, 1999, Mr. Ventura independently incorporated Petitioner in and under the laws of the Commonwealth of Virginia. See attached **Exhibit F**, attached hereto and incorporated herein by such reference. Similar to Tienda 2 and Damas, Petitioner was a business expansion of the Tienda 1 business model into the Commonwealth of Virginia and provided convenience store related services and products at a retail store located in the Commonwealth of Virginia. Similar to Tienda 1, Tienda 2, Tienda CR, and Damas, Petitioner offered LC's analgesic balm under the COFAL Mark. From at least as early as 1990 through 2005, Tienda 1, Tienda 2, Tienda CR, Damas and/or Petitioner offered LC's analgesic balm under the COFAL Mark to the general public in the United States.

In or around 2004, in an effort to increase the distribution potential of healthcare products imported and distributed by Petitioner, specifically, an analgesic balm under the COFAL Mark, Petitioner entered into a joint venture with Mr. Horacio Carballo ("Mr. Carballo"), an individual

with ties to the Hispanic community¹. In or around 2004, Mr. Carballo allegedly created a legal entity under some variation of “Products”. In or around May 20, 2005, Mr. Carballo replaced the previous entity by incorporating an entity in and under the laws of State of Maryland under the legal name Latin Products Distributor, Inc. (“LPD”). See attached **Exhibit G**, attached hereto and incorporated herein by such reference.

Up until 2004, Mr. Carballo employed the assistance of several parties through a variety of business ventures, including, *inter alia*, president of Registrant, Mr. Evelio Velasquez (“Mr. Velasquez”). In or around August 26, 2004, Mr. Velasquez, in furtherance of his partnership with Mr. Carballo, organized an entity in and under the laws of State of Delaware under the legal name Central America Distributors, LLC (“CAD”). See attached **Exhibit H**, attached hereto and incorporated herein by such reference. Shortly thereafter,

In or around late 2005, Mr. Carballo and Mr. Ventura, had a falling out with respect to their joint venture and any business relationship between the parties ceased. Immediately thereafter, specifically still in or around 2005, Petitioner approached LC in an effort to purchase or license the COFAL Mark. LC informed Petitioner that it was free to operate under its COFAL Mark, including for distribution purposes in the United States, and LC’s presence in the United States ultimately ceased.

In early 2006, Petitioner began manufacturing its own healthcare products for distribution, including, *inter alia*, a new analgesic balm under the COFAL Mark. In a retaliatory effort, on September 23, 2006, Mr. Carballo filed an application for the trademark “COFAL Pharmaceutical Preparation Cream Analgesic For Muscles [sic] Pain” in International Class 005

¹ Additional information as to Mr. Carballo and the parties herein is set forth in Petitioner’s Rule 26(a) Disclosures served upon Registrant, attached hereto and incorporated herein for the sole purposes of Registrant’s Motion. See TBMP § 528.05(c).

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