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Mailed: 26 JUN 2002  
Paper No. 28  
AD

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board  
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Ramex Records, Inc.  
v.  
C. Jose Alfredo Guerrero

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Opposition No. 111,215  
to application Serial No. 75/100,640  
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Walter R. Brookhart of Shook, Hardy & Bacon L.L.P. for  
Ramex Records, Inc.

Cheryl L. Hodgson of Probstein, Weiner and Hodgson for C.  
Jose Alfredo Guerrero.

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Before Seeherman, Bucher, and Drost, Administrative  
Trademark Judges.

Opinion by Drost, Administrative Trademark Judge:

C. Jose Alfredo Guerrero (applicant) has applied to  
register the mark LOS CADETES DE LINARES on the Principal  
Register for goods ultimately identified as a "series of

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pre-recorded cassettes and compact discs containing music" in International Class 9."<sup>1</sup>

Ramex Records, Inc. (opposer) has opposed registration on the ground that applicant's mark, when used on or in connection with the identified goods, so resembles opposer's mark LOS CADETES DE LINARES previously used in the United States, and not abandoned, for cassette tapes, compact discs, and videos, featuring audio and/or video recordings of musical performances and entertainment services and providing live musical performances by a group as to be likely to cause confusion, or to cause mistake or to deceive.<sup>2</sup> Also,

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<sup>1</sup> Serial No. 75/100,640, filed May 2, 1996. As amended, the application alleges a date of first use at least as early as 1960 and a date of first use in commerce at least as early as 1986. The application includes a translation of the mark as "The Cadets from Linares." The word "Linares" is disclaimed.

<sup>2</sup> While opposer in its Notice of Opposition refers to an application it allegedly owns (Serial No. 75/205,197 filed November 27, 1996) for goods and services in International Classes 9 and 41, this application has not been made of record. ABC Moving Company, Inc. v. Brown, 218 USPQ 336, 338 (TTAB 1983) ("[P]etitioner has alleged standing in this case by virtue of its application having been refused by the Examining Attorney in view of respondent's registration. While this is a proper allegation of standing in view of the holding in Lipton Industries, Inc. v. Ralston Purina Co., 213 USPQ 185 (CCPA 1982), respondent has denied the allegation based on insufficient knowledge and information as to the truth of said allegation. Petitioner has offered no evidence of the facts relating to its application and rejection thereof because of respondent's registration and we conclude that petitioner has failed to prove its standing in this case to be heard on any issue"). See also Doctor Vinyl & Associates v. Repair-It Industries, Inc., 220 USPQ 639, 641, n.1 (TTAB 1983) ("In its brief, opposer refers to its pending applications for

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opposer alleges that applicant made "false statements concerning the date of first use, the date of first use of the mark in commerce, the continuity of use of the mark and the ownership of the mark" that "constitute fraud in the application and fraud on the United States Patent and Trademark Office." Opposition, p. 8.

Applicant has denied the salient allegations of the notice of opposition.

The Record

The record consists of the file of the involved application; the trial testimony deposition, with accompanying exhibits, of Emilio V. Garza, opposer's president; the trial testimony depositions, with accompanying exhibits, of applicant, C. Jose Alfredo Guerrero (a.k.a. Jose Alfredo Guerrero de la Cerda) taken on April 26 and June 21, 2000<sup>3</sup>; the trial testimony deposition with exhibit of Michael Perlstein<sup>4</sup>, an attorney who specializes in entertainment law; opposer's submission of applicant's answers to three

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registration of DR. VINYL and indicates that these applications were suspended pending the outcome of this proceeding. However, neither the application files or the facts concerning them are part of the record of this proceeding. Consequently, the reference to them in opposer's brief has not been considered").

<sup>3</sup> The Guerrero and Garza depositions were conducted with the help of a Spanish interpreter.

<sup>4</sup> Opposer has moved to strike this testimony. We deny this motion, as discussed infra.

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interrogatories; and excerpts from a book entitled *The Billboard Guide to Tejano and Regional Mexican Music*, by Raymond Burr (1999).<sup>5</sup>

Both parties have filed briefs. An oral hearing was requested, but both parties subsequently waived oral argument.

Facts

(1) Applicant was born in Linares, in Nuevo Leon, Mexico. Guerrero, April 26 deposition, p. 8.

(2) Applicant and his brother, Homero Guerrero, formed a musical group in Mexico in the late 1950's and called the group "Cadetes." Guerrero, April 26 deposition, pp. 19 and 29.

(3) Applicant left the group in 1960 because he played the guitar and it was necessary to bring in an accordionist. Guerrero, June 21 deposition, pp. 11 and 14.

(4) When applicant played with his brother Homero, the group "used only Cadetes" as the name for the group. Guerrero, April 26 deposition, p. 29.

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<sup>5</sup> Both parties have submitted exhibits with the depositions that appear to be in Spanish without an English translation. We have not considered these exhibits except to the extent that they are explained in the testimonial depositions. See Wright and Graham, *Federal Practice and Procedure* (1977), § 5075 ("[I]f a party puts in evidence the whole of an encoded writing, he

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(5) Because the brothers were from Linares, Mexico, they were sometimes referred to by others as "the Cadetes de Linares." Guerrero, April 26 deposition, p. 85.

(6) In 1968, Homero Guerrero and Samuel Zapata recorded records for Del Valle Productions in which they were identified as "Los Cadetes de Linares." Guerrero, June 21 deposition, pp. 11 and 22 and Ex. 9 and 10; Guerrero, April 26 deposition, p. 45 and Ex. 5.

(7) These records were sold in the United States. Guerrero, June 21 deposition, pp. 23 and 57-58.

(8) From 1974 until 1982, Homero Guerrero and Guadalupe (a.k.a. Lupe) Tijerina made 15 recordings for opposer Ramex Records under the name "Los Cadetes de Linares." Guerrero, April 26 deposition, p. 36; Garza deposition, p. 31 and Ex. 4.

(9) Homero Guerrero and Lupe Tijerina signed an Artist Contract with Ramex Records sometime prior to July 26, 1977. Garza deposition, pp. 100-101 and 104 and Garza Ex. 5, 6, and 15.

(10) Paragraph 7(a) of this agreement permitted opposer to use the name "Los Cadetes de Linares" in "advertising, trade and promotion in connection with" the recordings made pursuant to the agreement. Garza Ex. 15.

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should only be held to have introduced the part of it that he

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(11) Ramex sold "Los Cadetes de Linares" recordings made during the years 1974 to 1982 throughout the United States and Mexico. Garza Deposition, p. 39.

(12) Ramex continues to sell recordings of Homero Guerrero and Lupe Tijerina under the mark "Los Cadetes de Linares" in the United States and Mexico. Garza Deposition, p. 39.

(13) On July 26, 1977, Homero Guerrero and Lupe Tijerina signed a document containing the following statement: "we Homero Guerrero and Guadalupe Tijerina, 'members of the Norteno<sup>6</sup> (Northern) Musical group: LOS CADETES DE LINARES," authorize Mr. Emilio V. Garza, sole owner of RAMEX RECORDS, CO., to register in his own name, or in the name of his company, our Group with the Secretary of Public Education of the Mexican Republic, as well as in any country where our music has acceptance." Garza Ex. 5 and 6.

(14) Homero Guerrero and Lupe Tijerina also appeared in 17 movies as "Los Cadetes De Linares." Guerrero, April 26 deposition, p. 60.

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has had translated for the jury").

<sup>6</sup> The original language of this document is in Spanish. The translator noted that Norteno refers to music originating from the northern part of the Republic of Mexico.

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(15) Applicant did not participate in the 1968 Del Valle recordings with Homero Guerrero and Samuel Zapata. Guerrero, April 26 deposition, p. 45.

(16) Applicant did not participate in the Ramex recordings with his brother, Homero Guerrero, and Lupe Tijerina. Guerrero, April 26 deposition, pp. 36-37; Guerrero, June 21 deposition, p. 57.

(17) There are no documents of any contractual agreements between applicant and either Homero Guerrero or Lupe Tijerina recognizing any ownership by applicant of the mark "Los Cadetes de Linares." Guerrero, April 26 deposition, p. 68.

(18) In February 1982, Homero Guerrero died in an auto accident. Guerrero, April 26 deposition, p. 14.

(19) Within one year of Homero's death, Rosendo Cantu replaced Homero Guerrero, and Rosendo Cantu's and Lupe Tijerina's first recording was produced at the beginning of 1983. Garza deposition, pp. 137-138.

(20) Opposer has sold recordings by Lupe Tijerina and Rosendo Cantu under the mark "Los Cadetes de Linares" in the United States and Mexico since 1982 through the date of the deposition. Garza deposition, pp. 43-44.

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(21) Applicant did not begin using the name "Los Cadetes de Linares" until after his brother's death in 1982. Guerrero, April 26 deposition, p. 29.

(22) Applicant did not record his first commercial recording until 1985 in Mexico. This record was not sold in the United States. Guerrero, April 26 deposition, p. 47.

(23) Applicant subsequently recorded other albums in Mexico. It is not clear if these recordings were sold in the United States. Guerrero, April 26 deposition, pp. 48-49 ("Q. Was it sold in the United States? A. No. I don't know").

(24) Applicant did not perform in the United States any earlier than 1988. Guerrero, June 21 deposition, pp. 58-60.

(25) After Homero Guerrero's death, opposer has continued to produce records up to the date of the deposition under the mark "Los Cadetes de Linares" with Rosendo Cantu and others substituted for the late Homero Guerrero. Garza deposition, p. 43.

(26) Rosendo Cantu performed with the group "Los Cadetes de Linares" from the end of 1982 or early 1983 to 1991 and then returned to the group around 1996. Garza deposition, p. 163.

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(27) Los Cadetes de Linares recordings produced by opposer were sold in both the United States and Mexico. Garza deposition, p. 44.

(28) Opposer has produced approximately 25 albums under the mark "Los Cadetes de Linares" since the death of Homero Guerrero. Garza deposition, p. 44 and Ex. 4.

(29) Both opposer and applicant have been aware of each other's use of the mark "Los Cadetes de Linares" since at least 1991. Guerrero, June 21 deposition, pp. 60-62.

(30) "Los Cadetes de Linares" or variations of that name are used by artists other than opposer and applicant. Homero Guerrero's son performs under the name "Los Cadetes de Linares of Homero, Jr." and distributes recordings through a major distributor of records in the United States (BMG). Garza deposition, pp. 89 and 144 and Ex. 10 and 11.<sup>7</sup> Applicant has admitted that "there are many groups that go by Cadetes de Linares." Guerrero, April 26 deposition, p. 93. Opposer acknowledges that "[t]here are other groups that are using the name Cadetes or the name Nuevos Cadetes de Linares." Garza deposition, p. 68. See also Garza

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<sup>7</sup> In response to an interrogatory, opposer has indicated that: "Ramex Records has granted a license to the son of Homero Guerrero to use the mark." Garza Ex. 20, p. 15.

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deposition, pp. 81-82 and Ex. 9 (Recording entitled "Rosendo Cantú y Los Cadetes de Linares"); Garza deposition, p. 76 (Chewy Vega, a former member of "Los Cadetes de Linares" continued to perform after he left Ramex using the name "Cadetes de Linares").

(31) Opposer has never filed a lawsuit or sent a "cease and desist" letter to any third party concerning the unauthorized use of the words "Los Cadetes de Linares." Garza deposition, p. 100).

Standing

"Applicant does not dispute that under the liberal rules of the Trial Board, Ramex has standing to oppose the pending application." Applicant's Br. at 16. We agree. However, applicant further argues that the opposition "must fail since Ramex has no proprietary interest in the mark." Id. To the extent that this is another way to attack opposer's standing to bring this proceeding, we will briefly discuss the standing issue. We will discuss the specific issue of whether opposer must have a proprietary interest to prevail in this proceeding in the priority section of the opinion.

Opposer's evidence demonstrates that it has been producing recordings since 1974 for a group composed of various artists called "Los Cadetes de Linares." Garza

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deposition, pp. 18, 39, and 43 and Ex. 4. Furthermore, opposer has introduced evidence that in 1977 the members of the group at that time permitted the registration of the name "Los Cadetes de Linares" in the name of Mr. Garza or his company, opposer. Garza Exhibits 5 and 6.

An opposer must have "a 'real interest' in the outcome of a proceeding in order to have standing." Ritchie v. Simpson, 170 F.3d 1092, 50 USPQ2d 1023, 1025 (Fed. Cir. 1999). "To establish a reasonable basis for a belief that one is damaged by the registration sought to be cancelled, a petition may assert a likelihood of confusion which is not wholly without merit." Lipton Industries v. Ralston Purina Co., 670 F.2d 1024, 213 USPQ 185, 189 (CCPA 1982).<sup>8</sup> Opposer's evidence that it has either been assigned the mark or that it produces and distributes recordings for a group named "Los Cadetes de Linares" in the United States since 1974 establishes opposer's standing to bring this opposition proceeding.

SGA's claims of priority of use, coupled with its pleading of likelihood of confusion, constitute a legally sufficient pleading of SGA's claim that it has a real interest in the proceeding and, therefore, standing to pursue the opposition. See Lipton Industries, Inc. v. Ralston Purina Co., 670 F.2d 1024, 213 USPQ 185 (CCPA 1982). This is so

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<sup>8</sup> Because of the linguistic and functional similarities of the opposition and cancellation provisions of the Lanham Act, "we construe the requirements of those two sections of the Lanham Act consistently." Ritchie, 50 USPQ2d at 1025 n. 2.

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even if SGA's use of the two pleaded marks is as a licensee or distributor for WSC, for a plaintiff may have standing in a case brought under Section 2(d) of the Trademark Act even if it does not claim ownership of the assertedly similar mark, or the right to control its use. See J.L. Prescott Co. v. Blue Cross Laboratories (Inc.), 216 USPQ 1127 (TTAB 1982) (opposer that had assigned mark and obtained exclusive license from assignee held to have standing); See also, Universal Oil Products Co. v. Rexall Drug and Chemical Co., 463 F.2d 1122, 174 USPQ 458 (CCPA 1972); BRT Holdings Inc. v. Homeway Inc., 4 USPQ2d 1952 (TTAB 1987); Chemical New York Corp. v. Conmar Form Systems, Inc., 1 USPQ2d 1139 (TTAB 1986); and Yasutomo & Co. v. Commercial Ball Pen Co., Inc., 184 USPQ 60 (TTAB 1974).

William & Scott Co. v. Earl's Restaurants Ltd., 30 USPQ2d 1870, 1873 n.2 (TTAB 1994).

Opposer's Objections

Opposer has objected to the testimony of applicant's expert witness, Michael Perlstein. Opposer seeks to have the testimony excluded because applicant failed to identify the witness in response to a discovery request. Furthermore, opposer argues that the testimony should be excluded because, when the witness was identified in the notice of deposition, "no address was given in the notice and there was not a general description sufficient to identify the witness or the particular class or group to which the witness belonged." Motion to Strike, p. 8. Applicant argues that "substantial justification existed for the failure to disclose Mr. Perlstein's testimony under Rule 26, since it was not until the testimony of

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Mr. Garza that the need to provide rebuttal testimony arose. Based upon the surprise and outlandish position taken by Ramex records in this proceeding, applicant has a right to rebut this testimony in its [sic] own case." Opposition to Motion to Strike, p. 7. In effect, applicant argues that Mr. Garza's testimony was surprising when he testified that the paper Homero Guerrero and Lupe Tijerina signed in 1977 authorizing Mr. Garza or opposer to register their group's name resulted in their becoming employees of opposer who could be fired or replaced.

The timing and circumstances of applicant's disclosure of his witness to opposer does not support opposer's request that the testimony of the witness be excluded. The record indicates that applicant did not engage his expert witness until after opposer's witness, Mr. Garza, testified. This provides support for applicant's explanation that the need for and decision to have Mr. Perlstein testify as an expert witness was not made until opposer's testimony. This also is an acceptable explanation as to why the witness was not identified during discovery.

Similarly, opposer's objections as to the formal requests of the notice of taking testimony are

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procedural. Opposer appeared at the deposition and cross-examined the witness and it does not point to any material prejudice as a result of these objections. In a case where there were allegations of inadequate notice concerning the testimony of a witness, the Board permitted the testimony.

In this regard, our reading of the record fails to show any material prejudice to registrant since it did receive advance oral notice that there would be a substitute for the Beech Aircraft employee originally named as a witness and the substitute would also be a Beech employee (whose name was not made known until the day of the deposition). Registrant had a full opportunity for cross-examination of the witness and appears to have exercised it. Of course, it could have requested an extension or postponement if it felt that the circumstances of the substitution left it inadequately prepared to deal with the evidence of petitioner's use of the term LIGHTNING which the Beech employees (original and substitute) were being called upon to document").

Beech Aircraft Corporation v. Lightning Aircraft Company Inc., 1 USPQ2d 1290, 1291 (TTAB 1986).

Similarly, here we find that the record fails to show any material prejudice and opposer's motion to exclude the testimony of Mr. Perlstein is denied.<sup>9</sup>

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<sup>9</sup> Opposer's allegations about the witness's lack of knowledge of "Spanish artists and Spanish record companies" (Response to opposition to motion to strike, p. 5) and the office-sharing arrangements between the witness and applicant's counsel go to the weight of the testimony and not its admissibility. DiCarlo v. KellerLadders, Inc., 211 F.3d 465, 468 (8<sup>th</sup> Cir. 2000) (citations and internal quotation marks omitted) ("Determining the credibility of a witness is the jury's province, whether the

There are two other evidentiary matters. First, opposer in its reply brief raises several hearsay objections to applicant's exhibits. Inasmuch as these objections were not made in its opening brief, we view any objection as being waived. The probative weight to be accorded this evidence is a separate matter. Second, applicant's unopposed motion to take judicial notice of a stipulated judgment and complaint from the Central District of California is granted.

Likelihood of Confusion

Applicant has applied to register the mark LOS CADETES DE LINARES in block letters for a series of pre-recorded cassettes and compact discs containing music. Opposer has introduced evidence that since 1974 it has produced musical recordings under the mark LOS CADETES DE LINARES and that these recordings have been sold throughout the United States.<sup>10</sup> In effect, applicant and opposer are using virtually identical marks on the identical goods in the same geographic areas. There is no evidence of any

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witness is lay or expert ... An expert witness's bias goes to the weight, not the admissibility of the testimony, and should be brought out on cross-examination").

<sup>10</sup> Names of musical groups that appear on a series of different recordings can function as trademarks. In re Polar Music

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differences in the channels of trade or purchasers. Both applicant's and opposer's goods are marketed with Spanish language literature and the songs sometimes even have the same titles. Guerrero Ex. 34 and Garza Ex. 4 ("Pistoleros Famosos" and "La Venganza de Maria"). Therefore, under these circumstances, confusion is likely. In re E. I. du Pont de Nemours & Co., 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973) (Setting out thirteen factors to consider in likelihood of confusion determinations).

Priority

Because the marks and the goods are virtually identical, the critical issue in this case is priority. Applicant claims to have used the mark LOS CADETES DE LINARES on a series of prerecorded cassettes and compact discs containing music in a type of commerce that can be regulated by Congress in 1986. There is virtually no evidence to support the first use of the mark in commerce by applicant in that year for those goods.<sup>11</sup> Applicant

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International AB, 714 F.2d 1567, 221 USPQ 315, 318 (Fed. Cir. 1983).

<sup>11</sup> We cannot accept applicant's argument that "LOS CADETES DE LINARES was a family business, with rights in the name remaining with the two brothers who originated the business." Applicant's Br. at 20. Even applicant admits that when he played with his brother in Mexico, they were known simply as the Cadetes. Guerrero, April 26 deposition, pp. 24 and 29. Applicant had

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admitted that he did not use the mark "Los Cadetes de Linares" until after his brother's death in 1982.

Guerrero, April 26 deposition, p. 28. His first recording anywhere was not made until 1985. Guerrero, April 26 deposition, p. 47 ("Q. The first record that you ever recorded was in 1985. Is that your testimony? A. Yes."). Applicant acknowledges that the record was not sold in the United States. Id. ("Q. Okay. Was it sold in the United States? A. No. In Mexico.").

Applicant's next record was recorded in 1986. Guerrero, April 26 deposition, p. 48. Applicant does not remember the title of that record. Id. He also could not state that the record was sold in the United States. Guerrero, April 26 deposition, p. 49 ("Q. Was it sold in the United States? A. No. I don't know"). His first

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little material involvement with his brother's group after he left other than to help buy some equipment. Garza, April 26 deposition, p. 87. Applicant had no contractual agreements with his brother Homero, Lupe Tijerina, or Ramex showing an ownership interest in the mark. Guerrero, April 26 deposition, p. 68. Applicant also had no document written by his brother saying applicant could have the mark if he died and there is no evidence of a will or any legal document showing applicant acquired the mark by inheritance. Guerrero, April 26 deposition, p. 80. Therefore, the record does not support applicant's argument that he somehow was a silent partner with his brother in the group "Los Cadetes de Linares" for the twenty-year period between when he left the group "Cadetes" and his brother's death in 1982. During that time his brother recorded with two record companies and with two different musicians. There is little, if any, evidence from that period to show that applicant was recognized as a member of the group or an owner of the mark "Los Cadetes de Linares."

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musical performance in the United States was not earlier than 1988. Guerrero, June 26 deposition, pp. 58-60.

An applicant in an opposition proceeding is not required to prove use in order to prevail, but without evidence of prior use, an applicant is limited to the application's filing date. Columbian Steel Tank Company v.

Union Tank and Supply Company, 277 F.2d 192, 125 USPQ 406, 407 (CCPA 1960) ("Appellee's application alleges February 1, 1946 as the date of first use of its mark but in the absence of testimony appellee must be restricted to its filing date of June 29, 1956, as the board correctly held").<sup>12</sup> However, applicant has submitted evidence that one of his records with GAS Records and others with Zacatecas Records were released in the United

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<sup>12</sup> Opposer has also argued that "knowing and material misrepresentations relating to Applicant's dates of use, both anywhere and in commerce, further support a refusal to register." Opposer's Br. at 46, n.3. A fraud claim must be proved "to the hilt." Stocker v. General Conference Corp. of Seventh-Day Adventists, 39 USPQ2d 1385, 1391 (TTAB 1989). Here, we cannot find that fraud has been proven. One of the elements of fraud is that the knowingly false misrepresentation must be material. An erroneous date of first use could not result in the allowance of an application that would otherwise not be allowed. The "date of use alleged by applicant in its application, even if false, cannot be said to constitute fraud on the Office." Georgia-Southern Oil Inc. v. Richardson, 16 USPQ2d 1723, 1726-27 (TTAB 1990). For examination purposes, a mark which is the subject of a Section 1(a) application must have been used in commerce only as of the filing date of the application. As discussed herein, opposer has not shown that

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States beginning in 1996. Guerrero, June 21 deposition, pp. 47-53 and Ex. 34-43.<sup>13</sup> Accordingly, we find that applicant made use of the mark in commerce on records at least as early as 1996. Even if the record did not support when applicant first used his mark for pre-recorded cassettes and compact discs containing music in a type of commerce that Congress can regulate, applicant would still be able to rely on the filing date of his application as his date of first use in commerce.

Opposer, on the other hand, has established that it has been producing recordings under the mark "Los Cadetes de Linares" since 1974. See Garza deposition, pp. 39 and 43-44, Ex. 4, 8, and 21, pp. 9-10. These records have been sold in the United States. Garza deposition, pp. 43-44. Opposer called as its only witness its president, Emilio V. Garza. "[O]ral testimony, if sufficiently probative, is normally satisfactory to establish priority of use in a trademark proceeding." Powermatics, Inc. v. Globe Roofing

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applicant's use in 1996 was subsequent to applicant's filing date.

<sup>13</sup> We note that applicant in his deposition states that "here is a company in the United States in 1986" apparently referring to the recording in Ex. 37. However, Exhibit 37 has a copyright date of 1996 so apparently the reference should be to 1996 instead of 1986.

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Products Co., 341 F.2d 127, 144 USPQ 430, 432 (CCPA 1965).

Such testimony should "not be characterized by contradictions, inconsistencies and indefiniteness but should carry with it conviction of its accuracy and applicability." B.R. Baker Co. v. Lebow Bros., 150 F.2d 580, 66 USPQ 232, 236 (CCPA 1945). National Blank Book Co. v. Leather Crafted Products, 218 USPQ 827, 828 (TTAB 1983) ("It was incumbent upon opposer in attempting to prove the date of first use of 1968 either to have a witness testify from personal knowledge that the mark 'ESP' was in use as of 1968 or, if no such person was still employed by opposer, to prove the date of first use by authenticating business records"). Besides opposer's president's testimony, applicant acknowledges that opposer produced recordings by his brother and Lupe Tijerina under the name "Los Cadetes de Linares" between 1974 and 1982 and that opposer continued "issuing records under the name Los Cadetes de Linares" from his brother's death until the present time. Guerrero, June 21 deposition, pp. 65-66. This record supports a determination that opposer has been using the mark prior

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to even applicant's earliest claimed date of first use of the mark in commerce (1986).<sup>14</sup>

The only remaining question concerns whether opposer's status somehow negated his earlier use because this use was either that of an infringer or a party without any rights in the mark. We do not agree with applicant that opposer was an infringer or a distributor without any rights in the mark. We have already determined that a distributor or licensee has standing to bring an opposition proceeding. Now we must decide whether opposer may prevail on its claim of likelihood of confusion and priority. The issue is whether opposer has superior rights to the rights of applicant, not to any third party. Marshak v. Sheppard, 666 F. Supp. 590, 3 USPQ2d 1829, 1836 (S.D.N.Y. 1987) (footnote omitted):

Sheppard further argues that Marshak's assignors could obtain no rights in the name "The Drifters" because, upon joining Treadwell's Drifters, each signed employment contracts in which they waived all such rights. These arguments miss the mark, however, because they could only accrue, if at all, to Treadwell's benefit, not to Sheppard's. Sheppard argues that the rights to "The Drifters" were lodged in the group's manager, Treadwell, and the corporation he set up to control the group's assets. In this case, however, when only Marshak's and

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<sup>14</sup> As discussed previously, the record supports a much later date of first use in commerce for applicant.

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Sheppard's rights are at stake, these arguments are irrelevant.

We do not need to determine whether the paper (Garza Ex. 5 and 6) in which Homero Guerrero and Lupe Tijerina<sup>15</sup> authorized Mr. Garza or opposer to "register in his own name, or in the name of his company, our Group" was a valid assignment of all rights, title and interest in the mark from the musicians to opposer. Nor do we have to determine what rights opposer may have vis-à-vis third parties concerning the use of the mark or even if opposer is entitled to register the mark in its own name.

First, we start by noting that it has been recognized that the manager and promoter of a group may be the owner of the group's mark. See Rick v. Buchansky, 609 F. Supp. 1522, 226 USPQ 449, 456 (S.D.N.Y. 1985). Also, when a member leaves a group, it has been held that "he took no rights in the service mark with him, Rather, the mark remained with the original group. Paul Robi, therefore, had nothing to assign to [his wife]. Reed who founded the group and is the only person who has remained and performed with it from its inception, retains the right to use of the service mark." Robi v. Reed, 173

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<sup>15</sup> Neither side called Lupe Tijerina as a witness in this proceeding. Mr. Garza testified that "[t]he name belonged to both." Garza deposition, p. 120. Applicant points out that

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F.3d 736, 50 USPQ2d 1315, 1317 (9<sup>th</sup> Cir. 1999).

Similarly, when Homero Guerrero died there is no evidence that any rights in the mark were transferred by way of inheritance. On the other hand, opposer has been involved with the group "Los Cadetes de Linares" for more than a quarter of a century. Opposer has produced recordings since 1974 for the group known as "Los Cadetes de Linares" and it has continued to produce recordings for this group. One of the agreements between Homero Guerrero and Lupe Tijerina and Ramex Records contains the following provision:

You agree to cooperate fully in any controversies or litigation which may be required to prevent the distribution of records not authorized pursuant to the terms of this agreement or to prevent the use of your name, likeness or biographical material in contravention of the rights granted to Company hereunder. Company may take such steps or institute such legal proceedings in Company's name or in the name of you and Company jointly, as Company may deem suitable.

Garza. Ex. 15, ¶ 8.

Opposer produced more than one million recordings of the group "Los Cadetes de Linares" between 1974 and 1986. Garza deposition, p. 50. After the death of Homero Guerrero in 1982, opposer continued to distribute recordings for the group "Los Cadetes de Linares" with

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this testimony resulted after the witness conferred with his counsel. Applicant's Br. at 23 n. 4.

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the remaining member, Lupe Tijerina, and other musicians. Throughout this period, opposer has been active in the business affairs of the group. Garza deposition, pp. 11-15. Opposer provides artistic directors "who are the ones who qualify - who approve or disapprove of what's going to be recorded to make sure that we obtain what the Ramex label wants." Id. at 11. Opposer has "control over the members of each group." Id. at 14. Clearly, regardless of whether opposer is the owner of the mark, it is not an intermeddler and it has a real interest in preventing applicant from obtaining a registration for his mark.

Next, we look at whether this interest is sufficient to prevail in this proceeding. There is no requirement that an opposer own or use the mark in order to prevent another party from using the mark or even that it have a proprietary interest in the mark. See National Cable Television Association Inc. v. American Cinema Editors Inc., 937 F.2d 1572, 19 USPQ2d 1424, 1428 (Fed. Cir. 1991) ("Moreover, even without use directly by the claimant of the rights, the courts and the Board generally have recognized that abbreviations and nicknames of trademarks or names used only by the public

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give rise to protectable rights in the owners of the trade name or mark which the public modified").

The Federal Circuit has expressly held that:

Ordinarily, a person should not be heard on a third party's rights, that is, allowed to sue to vindicate the rights of another. Here, however, the trade association convincingly established that it was not a mere intermeddler in asserting a claim predicated on a third party's name and had sound reasons for fearing damage to itself and its members if Ullenberg's mark were registered. In sum, JVC asserted its own claim which happened to involve the proprietary rights of a third party.

Jewelers Vigilance Committee Inc. v. Ullenberg Corp., 853 F.2d 888, 7 USPQ2d 1628, 1631 (Fed. Cir. 1988).

In Jewelers Vigilance, the Federal Circuit specifically rejected the applicant's argument that Otto Roth & Co. v. Universal Foods Corp., 640 F.2d 1317, 209 USPQ 40 (CCPA 1981), required that the opposer must have a proprietary interest in a mark in order to prevail under Section 2(d). "The Otto Roth analysis does mean that someone must have proprietary rights in the name DEBEERS, but such rights need not reside in the opposer if the opposer otherwise has standing to bring the opposition." Id. at 1632.

In Jewelers Vigilance, a third party who was not using the mark prevailed in an opposition proceeding.

The admissions and undisputed evidence of record support only a conclusion that the mark Ullenberg seeks to register for diamonds is likely to cause

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confusion with the admittedly famous mark DEBEERS. No dispute is raised with respect to the alleged fact that the name DEBEERS has an established trade identity in the United States in connection with diamonds. We note particularly the factors of the fame of DEBEERS as a source for diamonds, the unusual nature of the name, and the identity of Ullenberg's goods with those associated with DBCM. The record also conclusively establishes that JVC and its members will be damaged if such confusion occurs.

Id. at 1633.

As the licensee and distributor of recordings for a musical group, opposer, at a minimum, would be damaged if others used the virtually identical name for the recordings of a different group. Garza deposition, p. 67 (The use of the name "Los Cadetes de Linares" by both opposer and applicant "has created confusion among our clients and our distributors. They wonder, 'Well, which is which?'"). Under the original agreement, opposer is at least a licensee that had the right to bring this action to protect the name of the group. See Garza Ex. 15, ¶ 8. Nothing in the record indicates that it no longer has the right to protect the name of the group "Los Cadetes de Linares."

In addition, opposer has been producing and distributing these recordings prior to applicant's first use of the mark in commerce. It is undisputed that Homero Guerrero and Lupe Tijerina were the members of the

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group "Los Cadetes de Linares." Opposer continues to produce recordings with the only surviving member of the group who recorded with Homero Guerrero from 1974. It is difficult to see how opposer can be an infringer of any rights applicant may have inasmuch as applicant's use postdates opposer's. The rights to the name "Los Cadetes de Linares" originally belonged to the group consisting of Homero Guerrero and Lupe Tijerina. These rights were subsequently either assigned to opposer or remained with the reconstituted group.

Under Jewelers Vigilance, opposer must show that someone has proprietary rights in the mark and that it will be damaged by the applicant's registration of its mark. Here, either opposer owns the rights to the mark or the group whose recordings opposer distributes owns the mark. In either case, opposer will be damaged if applicant is permitted to register the virtually identical mark for the same goods. Therefore, we conclude that opposer has established its priority sufficient to prevail on the ground of likelihood of confusion.

Decision: The opposition is sustained and registration to applicant is refused.