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

Proceeding	91208141
Party	Defendant MARQUEZ BROTHERS INTERNATIONAL, INC.
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

GOYA FOODS, INC., Opposer, vs. MARQUEZ BROTHERS INTERNATIONAL, INC., Applicant.	Opposition No. 91208141 Mark: CASERA Ser. No. 85430918

APPLICANT'S RESPONSE TO OPPOSER'S SECOND MOTION TO STRIKE APPLICANT'S AFFIRMATIVE DEFENSES

Applicant, Marquez Brothers International, Inc., ("Applicant") hereby responds to Opposer Goya Foods, Inc.'s ("Opposer") motion to strike Applicant's first and second affirmative defenses set forth in Applicant's Amended Answer to Opposer's Notice of Opposition.

Response

It is well-established that a motion to strike is not favored. The Board may decline to strike even objectionable pleadings where their inclusion will not prejudice the adverse party, but rather will provide fuller notice of the basis for a claim or defense. *See* Fed. R. Civ. P. 12(f) and TMBP § 506. Indeed, Applicant's remaining affirmative defenses provide fuller notice.

Applicant amended its Answer to conform with the Board's request for additional facts in support of its affirmative defenses. As the Board stated in its June 14th Decision, "[a]ffirmative defenses, like claims in a notice of opposition, must be supported by enough factual background and detail to fairly place the opposer on notice of the basis for the defenses." The Board also acknowledged in its Decision, with regard to Applicant's equitable defenses, that "there is no strict rule that these defenses cannot be raised in an opposition given appropriate circumstances"

and "opposer may well have taken some action ***prior to*** or during prosecution of the subject application that may have given applicant the impression that opposer did not intend to assert its rights against the application." [Emphasis added]. It is under this guidance and framework that Applicant's affirmative defenses are appropriate.

The circumstances pertaining to the marks at issue are anomalous and the long history of coexistence significant. The history of coexistence of Applicant and Opposer's marks ***prior to*** prosecution of the subject application should not be ignored, as Opposer would have it. Rather the relationship of Applicant's marks and goods and Opposer's marks and goods provide the appropriate circumstances that make the equitable affirmative defenses connected to thirty years of uninterrupted coexistence worthy of consideration.

For Applicant's enumerated affirmative defenses to be applicable to the matter at hand and notice to be fairly given, Applicant has alleged that Opposer engaged in conduct and failed to act for decades, which contributed to Applicant's decision to file the subject application. Applicant has included in paragraphs 1(i) though 1(vi) of Applicant's Amended Answer to Notice of Opposition discussion of Applicant and Opposer's applications and registrations to show, (1) how far back the history of coexisting marks, applications, and registrations actually goes, and (2) how the mark and goods in the subject application are not far removed from Applicant's marks and goods listed in its prior registrations – marks and goods Opposer has never once objected to. Applicant, offering its core product lines under its marks, uninterrupted by Opposer for over thirty years, relied on Opposer's conduct and longstanding acquiescence as an indication that it did not intend to assert its rights against Applicant.

Opposer claims that the prior registrations cited by Applicant are irrelevant. The additional facts regarding the cited third-party opposition proceeding, discussed in paragraph

1(vii), illustrate how even Opposer has acknowledged and accepted on record the coexistence of the marks and prior registrations. These are facts that Opposer, for good reason, has chosen not to mention in any of its briefings. The outcome of the third-party opposition proceeding is not important to this case. What is relevant is that Opposer selectively highlighted Applicant's prior registrations as evidence to support its own position that *other* "casero" and "casera" marks (all for food and beverage products) already existed on the register and that such marks share the same or similar meaning as Opposer's mark. Such conduct ***prior to*** prosecution of the subject application solidifies the impression that Opposer would not assert its rights against Applicant's long-used mark for non-competing goods and is appropriate to consider in this context as it has bearing upon the issues under litigation.

Applicant is alleging that it will be prejudiced by the conduct of Opposer, which it relied upon in filing its application and has presented facts to support this allegation. Over the course of *decades*, Applicant had been led to believe, by the conduct of Opposer toward Applicant's marks and other third-party marks, that use of Applicant's mark for goods that did not compete with Opposer's goods would not be objectionable to Opposer.

Conclusion

Motions to strike are not favored, and matter will not be stricken unless it clearly has no bearing upon the issues under litigation. See, e.g., *FRA S. p . A. v. Surg-O-Flex of America, Inc.*, 415 F. Supp. 421, 427 (S.D.N.Y. 1976); *Leon Shaffer Golnick Advertising, Inc. v. William G. Pendil Marketing Co., Inc.*, 177 USPQ 401, 402 (TTAB 1977). Notice to the Board and Opposer of the above defenses and relevant facts in support of those defenses are appropriate here and undoubtedly have bearing upon the issues under litigation. Accordingly, Opposer's motion

should be denied.

Dated: August 7, 2013

Respectfully submitted,

OWEN, WICKERSHAM & ERICKSON, P.C.

By _____

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CERTIFICATE OF SERVICE

I hereby certify that a copy of the foregoing **APPLICANT'S RESPONSE TO OPPOSER'S SECOND MOTION TO STRIKE APPLICANT'S AFFIRMATIVE DEFENSES** was sent to attorneys for Opposer this day by first class mail, postage prepaid, to the following address:

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Dated: August 7, 2013

J. O'Hara

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