UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451

BUO

Mailed: November 25, 2013

Opposition No. 91208141

Goya Foods, Inc.

v.

Marquez Brothers
International, Inc.

Benjamin U. Okeke, Interlocutory Attorney:

The Board issued an order on June 14, 2013, granting in part opposer's motion to strike all of applicant's affirmative defenses from its original answer filed December 28, 2013. On July 2, 2013, applicant filed an amended answer asserting three "affirmative defenses" – acquiescence, estoppel, and that there is no likelihood of confusion.[1] Now before the Board is opposer's second motion to strike, filed July 18, 2013, challenging applicant's newly asserted affirmative defenses of acquiescence and estoppel.

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[1] As stated in the Board's June 14, 2013 order, applicant's argument that there is no likelihood of confusion between opposer's marks and its applied-for mark is merely an amplification of applicant's denials; and while not a proper affirmative defense this statement would not be stricken. *See Ohio State Univ. v. Ohio Univ.*, 51 USPQ2d 1289, 1292 (TTAB 1999).

The Board presumes the parties' familiarity with the factual background and arguments with respect to this motion, particularly in light of the Board's previous consideration of a similar motion in this matter. Therefore, the Board will only recount the facts and arguments as necessary to discuss this motion.

The Board notes that applicant filed its amended answer without first seeking leave from the Board to do so, as required by Fed. R. Civ. P. 15(a)(2). The Board, however, in its discretion considered applicant's proposed amendment. Applicant's amended answer is accepted and is now applicant's operative pleading in this case. Applicant should not file any further amendments to its pleadings without first seeking leave from the Board by contacting the assigned interlocutory attorney by telephone. Any further proposed amendments to applicant's pleadings that do not reflect the leave of the Board will not be considered.

Acquiescence

Applicant alleges that opposer's marks and goods have coexisted with applicant's marks and goods identified in its Registration Nos. 1934691 and 3720632 for thirty years without contention. Applicant further alleges that opposer has "acknowledged and accepted on record the coexistence of

the marks and prior registrations," by citing to the registrations to support a proposition in a motion for summary judgment filed by opposer in an unrelated proceeding.[2]

"Acquiescence is a type of estoppel that is based upon the plaintiff's conduct that *expressly* or by *clear implication* consents to, encourages, or furthers the activities of the defendant," that is not objected to. *Nahshin v. Prod. Source Int'l LLC*, 107 USPQ2d 1257, 1263 (TTAB 2013) (emphasis added), *citing Panda Travel, Inc. v. Resort Option Enters., Inc.*, 94 USPQ2d 1789, 1797 fn. 21 (TTAB 2009); *Christian Broad. Network Inc. v. ABS-CBN Int'l*, 84 USPQ2d 1560, 1573 (TTAB 2007).

While opposer may have "acknowledged" the coexistence of its marks with the marks in applicant's prior registrations, this is insufficient to plead that opposer ever *consented* to, let alone *encouraged* or *furthered*, respondent's registration of the mark involved herein for use with the subject goods. Accordingly, we find that the facts pleaded by applicant do not support the affirmative defense of acquiescence. Therefore, opposer's motion to strike applicant's first affirmative defense alleging

[2] Opposer cited to the '691 and '632 registrations in reference to a disputed translation of the term "casera," in its motion for summary judgment filed on December 11, 2012, in Opposition No. 91198986.

acquiescence is **GRANTED;** and applicant's first affirmative defense alleging acquiescence is **STRICKEN**.

Estoppel

Applicant does not specify the type of "estoppel" it is asserting as its second affirmative defense. However, from the facts provided to support its defense the Board construes applicant's assertion as an assertion of equitable estoppel. However, the factual background of any "inaction" on opposer's part that applicant has pleaded in its amended answer does not relate to the subject application, nor does it rise to the level of equitable estoppel. Opposer did not delay in asserting its rights against the subject mark, as the notice of opposition was filed within the set opposition period for the subject application. It is because of the unique nature of opposition proceedings before the Board that equitable defenses such as laches and estoppel are nearly impossible to sufficiently plead, let alone prove. Indeed, it appears that applicant's amended answer was simply a thinly-veiled re-assertion of its *Morehouse* defense, which was previously stricken by the Board's June 14, 2013 order.

Applicant's references to its prior registrations, and arguments regarding opposer's acceptance of the coexistence of its marks with the marks in those registrations, seems

to imply that no further damage could be caused to opposer by the registration of the subject application. This is the basis for a prior registration or *Morehouse* defense. *See O-M Bread, Inc. v. U.S. Olympic Comm'n*, 65 F.3d 933, 36 USPQ2d 1041, 1045 (Fed. Cir. 1995); *Morehouse Mfg. Corp. V. J. Strickland And Co.*, 407 F.2d 881, 160 USPQ 715 (CCPA 1969). However, for the reasons stated in the prior order, this defense is inappropriate given the factual background of this case.[3]

Accordingly, opposer's motion to strike applicant's second affirmative defense is **GRANTED**; and applicant's second affirmative defense alleging estoppel is **STRICKEN**.

Proceedings are resumed and conferencing, disclosure, discovery and trial dates are reset as follows:

Deadline for Discovery Conference	**12/16/2013**
Discovery Opens	**12/16/2013**
Initial Disclosures Due	**1/15/2014**
Expert Disclosures Due	**5/15/2014**
Discovery Closes	**6/14/2014**
Plaintiff's Pretrial Disclosures	**7/29/2014**
Plaintiff's 30-day Trial Period Ends	**9/12/2014**
Defendant's Pretrial Disclosures	**9/27/2014**

[3] While the mark applied for by applicant may be substantially the same as the marks in its prior registrations, the goods identified in those registrations are not substantially the same as the goods identified in the present application. *See Teledyne Techs. Inc. v. Western Skyways Inc.*, 78 USPQ2d 1203, 1209 (TTAB 2006) *aff'd unpub*, 208 Fed. Appx. 886, 887 (Fed. Cir. Dec. 6, 2006) (*Morehouse* defense fails where goods in the involved registration are clearly different from those in prior registrations).

Defendant's 30-day Trial Period Ends	**11/11/2014**
Plaintiff's Rebuttal Disclosures	**11/26/2014**
Plaintiff's 15-day Rebuttal Period Ends	**12/26/2014**

In each instance, a copy of the transcript of testimony together with copies of documentary exhibits, must be served on the adverse party within thirty days after completion of taking of testimony. Trademark Rule 2.125.

Briefs shall be filed in accordance with Trademark Rule 2.128(a) and (b). An oral hearing will be set only upon request filed as provided by Trademark Rule 2.129.