

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
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BUO

Mailed: November 18, 2014

Opposition No. 91208141

Goya Foods, Inc.

v.

Marquez Brothers Int'l, Inc.

Before Quinn, Taylor, and Gorowitz, Administrative Trademark Judges.

By the Board:

Marquez Brothers International, Inc. (“Applicant”) seeks to register the mark CASERA, for use in connection with “chorizo, longaniza, [and] deli meats, namely, hams, [and] turkey,” in International Class 29.¹

On November 21, 2012, Goya Foods, Inc. (“Opposer”) filed a notice of opposition against the registration of Applicant’s mark, alleging a likelihood of confusion between the applied-for mark and Opposer’s previously used and registered marks CASERA² and CASERITA³ in standard character format,

¹ Application Serial No. 85430918 filed on September 23, 2011, based upon Applicant’s assertion of a bona fide intention to use the mark in commerce under Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b). The application contains a translation statement indicating that the term CASERA translates into English as “domestic, homely, in a family way, or housekeeper.”

² Registration No. 2740494, issued July 22, 2003, from an application filed August 8, 2002, for “processed vegetables”; renewed, Sections 8 and 9 affidavit accepted on May 30, 2013.

under Trademark Act Section 2(d), 15 U.S.C. § 1052(d); and false suggestion of a connection under Trademark Act Section 2(a), 15 U.S.C. § 1052(a). Applicant filed its answer to the notice of opposition on December 28, 2012, admitting that: (1) Opposer is the owner of Registration Nos. 2740494 and 3040516; (2) the registrations are incontestable; and (3) the term CASERITA in the Spanish language is the diminutive equivalent of the term CASERA. Answer, ¶¶ 1, 3, 5, and 14. Applicant denied the remainder of the salient allegations asserted in the notice of opposition. Applicant also asserted in its answer six “affirmative defenses” alleging: (1) Opposer’s notice of opposition fails to state a claim upon which relief can be granted; (2) laches; (3) waiver; (4) estoppel; (5) priority; and (6) Opposer’s claim of likelihood of confusion is barred by the *Morehouse* doctrine.⁴

In an order issued June 14, 2013, the Board granted in part Opposer’s motion, filed January 4, 2013, to strike Applicant’s affirmative defenses. Applicant’s affirmative defenses asserting laches, waiver, estoppel, priority, and the *Morehouse* doctrine, were stricken. With respect to the first affirmative defense, failure to state a claim, the Board determined that while a sufficient claim of likelihood of confusion had been pleaded with respect to its pleaded registrations, thus compelling the grant of Opposer’s motion,

³ Registration No. 3040516, issued January 10, 2006, from an application filed June 14, 2004, for “chicken croquettes”; combined Sections 8 and 15 affidavit accepted and acknowledged on March 8, 2012.

⁴ *Morehouse Mfg. Corp. v. J. Strickland & Co.*, 407 F.2d 881, 160 USPQ 715 (CCPA 1969).

Opposer's claim of false suggestion of a connection was insufficiently pleaded. Therefore, the claim of false suggestion of a connection was stricken from Opposer's pleading.

Subsequently, Applicant, on July 2, 2013, filed an amended answer asserting two new affirmative defenses of acquiescence and estoppel, which Opposer contested through a motion to strike, which was in turn granted by the Board in its November 25, 2013 order, striking both newly asserted affirmative defenses.

This case now comes before the Board for consideration of Opposer's fully-briefed motion, filed June 12, 2014, alleging that viewing the evidence of record, including Applicant's responses to Opposer's First Set of Request for Admissions, "there can be no genuine dispute of a material fact. Opposer has priority; the parties marks (and in particular the identical mark CASERA) are confusingly similar; and the parties' respective goods are similar and related." Motion, p.3. Applicant's response to this motion, filed July 17, 2014:⁵ (1) requests leave to amend its admissions; (2) indicates that "[b]oth Parties to this proceeding are food purveyors and both market their goods to, *inter alia*, the Hispanic communities"; and "Goya's predecessors-in-interest were selling CASERA brand food products since 1979"; but (3) asserts that there has been no actual confusion despite over twenty-five years of

⁵ Despite the untimeliness of Applicant's response to the motion (inasmuch as July 12, 2014, fell on a Saturday, Applicant's response, pursuant to Trademark Rule 2.196, was due July 14, 2014), the Board, exercising its discretion, has chosen to decide the motion for summary judgment on its merits rather than grant it as conceded under Trademark Rule 2.127(a).

contemporaneous use of its allegedly similar marks CASERA, CASERO, and CASERITA.

Requests for Admission

Requests for admission (“RFAs”) require a party to admit to or deny factual assertions and are a means of reducing issues for trial. Fed. R. Civ. P. 36(a); TBMP § 407.02 (2014). An admission in response to an RFA “conclusively establishe[s]” the matter that is the subject of that request. Fed. R. Civ. P. 36(b). “This conclusive effect applies to those admissions made affirmatively and those established by default, even if the matters admitted relate to material facts that defeat a party’s claim.” *Am. Automobile Ass’n v. AAA Legal Clinic of Jefferson Crooke, P.C.*, 930 F.2d 1117, 19 USPQ2d 1142, 1144 (5th Cir. 1991) (citing *United States v. Kasuboski*, 834 F.2d 1345, 1350 (7th Cir. 1987)); see also *Fram Trak Indus. Inc. v. WireTracks LLC*, 77 USPQ2d 2000, 2005 (TTAB 2006) (“Respondent failed to respond to petitioner’s requests for admission and failed to file a motion to amend or withdraw those admissions. Accordingly, those requests for admission are deemed admitted and conclusively established.”).

Upon motion under Fed. R. Civ. P. 36(b), the Board may permit withdrawal or amendment of admissions when: (1) the presentation of the merits of the proceeding will be subserved by their withdrawal, and (2) the propounding party fails to satisfy the Board that withdrawal or amendment will prejudice that party in maintaining its action on the merits. Fed. R. Civ.

P. 36(b); *Giersch v. Scripps Networks, Inc.*, 85 USPQ2d 1306, 1308-09 (TTAB 2007) (motion to withdraw effective admissions granted).

Inasmuch as Opposer stipulates to this motion, Applicant's motion to withdraw its admission is **GRANTED**, and applicant's response to Opposer's Request for Admission No. 4⁶ is withdrawn, and the request for admission is considered denied.

Summary Judgment

Generally, a party may not file a motion for summary judgment until the party has made its initial disclosures.⁷ Trademark Rule 2.127(e)(1); *Qualcomm, Inc. v. FLO Corp.*, 93USPQ2d 1768, 1769-70 (TTAB 2010). Applicant alleges that Opposer's motion for summary judgment is premature inasmuch as Opposer "failed to serve its initial disclosures on [Applicant] prior to or concurrently with its Motion for Summary Judgment." App. Br., p.10. However, Opposer, in its reply brief, maintained that its initial disclosures were served on Applicant on January 20, 2014; in support, Opposer, as an exhibit to the declaration of John M. Rannels, attached a copy of the cover letter and Opposer's initial disclosures, including a certificate of service dated January 20, 2014.

⁶ This admission requested that Applicant "[a]dmit that Applicant has never used the mark CASERA on longaniza sold in the United States."

⁷ This general rule has two exceptions (neither applicable in this case): 1) a motion asserting lack of jurisdiction by the Trademark Trial and Appeal Board; or 2) a motion asserting claim or issue preclusion. Trademark Rule 2.127(e)(1); *Zoba Int'l Corp. v. DVD Format/LOGO Licensing Corp.*, 98 USPQ2d 1106, 1108 n.4 (TTAB 2011).

The Board finds no basis to doubt the service of Opposer's initial disclosures, and therefore we reject Applicant's contentions regarding the timeliness of Opposer's motion for summary judgment; we will decide the motion on its merits.

Entry of summary judgment is appropriate only where there are no genuine disputes as to any material facts, thus allowing the case to be resolved as a matter of law. Fed. R. Civ. P. 56(a). In deciding motions for summary judgment, the Board must follow the well-established principles that, in considering the propriety of summary judgment, all evidence must be viewed in a light favorable to the non-movant, and all justifiable inferences are to be drawn in the non-movant's favor. The Board may not resolve disputes of material fact; it may only ascertain whether such disputes exist. *See Lloyd's Food Prods. Inc. v. Eli's Inc.*, 987 F.2d 766, 25 USPQ2d 2027 (Fed. Cir. 1993); *Opryland USA Inc. v. Great Am. Music Show Inc.*, 970 F.2d 847, 23 USPQ2d 1471 (Fed. Cir. 1992); *Olde Tyme Foods Inc. v. Roundy's Inc.*, 961 F.2d 200, 22 USPQ2d 1542 (Fed. Cir. 1992).

In support of its motion for summary judgment Opposer introduced: (1) the declaration of its Vice President of Sales and Marketing, Conrad Colon, which includes as exhibits: (i) copies of records from the Trademark Electronic Search System ("TESS"), showing current status and title of Opposer's pleaded Registration Nos. 2740494 ("the '494 registration") and 3040516 ("the '516 registration"); and (ii) printouts from third-party websites

showing use of both parties' various goods in single dishes or recipes, including recipes for "chorizo croquettes" and "longaniza croquettes," Colon Dec., ¶ 10, and Exhibits 1-4; and (2) the declaration of Opposer's counsel John M. Rannels, which includes as exhibits: (i) copies of third-party applications and registrations retrieved from TESS, showing use of a single mark to identify the types of goods found in both the involved application and Opposer's pleaded registrations; and (ii) Applicant's responses to Opposer's requests for admission. Rannels Dec., Exhibits 1-2.

Under Rule 56(a), the movant has the initial burden of demonstrating that there is no genuine dispute of material fact. *See Celotex Corp. v. Catrett*, 477 U.S. 317 (1986); *Sweats Fashions Inc. v. Pannill Knitting Co. Inc.*, 833 F.2d 1560, 4 USPQ2d 1793 (Fed. Cir. 1987).

Opposer's standing has been established by its filing of current status and title copies of its pleaded registrations. These registrations and the goods listed therein suffice to establish a direct commercial interest, and therefore Opposer's standing to bring this proceeding. *See Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1844 (Fed. Cir. 2000); *Lipton Indus., Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185, 189 (CCPA 1982); *Edwards Lifesciences Corp. v. VigiLanz Corp.*, 94 USPQ2d 1399, 1408 (TTAB 2010).

Furthermore, by properly making its pleaded registrations of record, Opposer has removed Section 2(d) priority as an issue in this proceeding as to

the marks and goods covered by those registrations. *See King Candy Co. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108, 110 (CCPA 1974).

In a likelihood of confusion analysis, two key factors are the degree of similarity of the parties' marks and the degree to which their respective goods or services are related. *See In re Viterra Inc.*, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012); *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973).

With regard to Opposer's pleaded marks and Applicant's involved mark, there can be no genuine dispute that the mark shown in the '494 registration, CASERA, is identical to the involved mark, CASERA. Opposer argues with respect to its CASERITA mark, that "it is merely the diminutive form of CASERA" and is therefore "highly similar" to the applied-for mark.

Opposer then indicates that its motion for summary judgment "rel[ies] upon its common law rights in its CASERA mark for goods not set forth in [its] registrations, namely for the additional goods, rice and olives and in its CASERITA mark for ham croquettes and tamales." Applicant contests that "[t]hese goods are not listed in the description of goods for any of Opposer's registrations and Opposer did not plead these common law uses of its marks in its Notice of Opposition." App. Br., p.10. Our review of the notice of opposition filed by Opposer confirms Applicant's contention, and reveals no such pleading. Indeed, paragraph 1 of the notice of opposition states, "Opposer is the owner of the marks CASERITA and CASERA, (collectively

‘Opposer’s Marks’) as a [sic] trademarks applied to *croquettes* and *processed vegetables* respectively.” Notice of Opposition, ¶ 1 (emphasis added). Paragraph 5 of the notice of opposition, the only other paragraph that identifies any marks claimed by Opposer, simply lists the pleaded registrations.

Therefore, paragraph 1, the only paragraph that can be construed as alleging “common law” rights in the marks, does not allege use with the “additional goods” now claimed by Opposer, but simply with croquettes and processed vegetables.⁸ The allegations in a notice of opposition must “include enough detail to give the defendant fair notice of the basis for each claim.” *See Bell Atlantic Corp. v. Twombly*, 550 U.S. 554, 570 (2007).

Further, a party may not obtain summary judgment on an issue that has not been pleaded. *See Fed. R. Civ. P. 56(a); Asian and Western Classics B.V. v. Lynne Selkow*, 92 USPQ2d 1478, 1480 (TTAB 2009). Accordingly, the Board will not rely on any claims relating to Opposer’s alleged common law usage of its marks in determining this motion for summary judgment, and will only consider those goods found in Opposer’s pleaded registrations.

Opposer avers that “[t]he goods recited in the application in issue (chorizo, longaniza, deli meats namely, hams, turkey) are often combined with and used with the goods sold by Goya under Goya’s identical CASERA

⁸ Further, any pleading of common law rights by Opposer is insufficiently pleaded in the notice of opposition as written, inasmuch as Opposer failed to indicate that it began its common law usage of the marks on the claimed goods prior to Applicant’s filing date.

mark,” and that “there are many traditional dishes/recipes that combine such products.” Motion, p.7-8. In support of this proposition, Opposer cites the printouts attached to the Colon Declaration showing third-party websites featuring recipes for “traditional” dishes combining various goods offered by the parties, including “Oven Baked Jambalaya” (can of whole peeled tomatoes and ham), “Paella with Seafood, Chicken, and Chorizo” (can of whole tomatoes and chorizo sausage), and “Tomato & Chorizo Rice” (can of cherry tomatoes, roasted peppers from a jar and chorizo sausages).

The Board previously noted in *In re Davia* that “[t]here is, of course, no *per se* rule that all food products appearing in the same recipe be considered related for Section 2(d) purposes.” 110 USPQ2d 1810, 1816 (TTAB 2014). While the Board found the goods in that case to be related, the holding in that case, being fact-intensive, is not particularly applicable to a motion for summary judgment inasmuch as such a holding would require the Board to make findings of material fact. Nonetheless, by this standard it cannot be concluded that the goods involved herein are related simply as a result of their contemporaneous use in several recipes.

Additionally, Opposer cites the 87 copies of “Section 1A trademark registrations/applications,” attached as exhibits to the Rannells Declaration, to show that the goods listed therein illustrate that the goods of the parties often emanate from a single source.

However, “pending applications are not evidence of anything except that the applications were filed on a certain date.” *Nike Inc. v. WNBA Enters. LLC*, 85 USPQ2d 1187, 1201 (TTAB 2007). Moreover, even third-party registrations are entitled to little weight in a likelihood of confusion analysis inasmuch as “[t]he existence of these marks on the register is not evidence of what happens in the marketplace or that customers are familiar with [the marks.]” *Id.* 1200-01 (citing *AMF Inc. v. Am. Leisure Prods., Inc.*, 177 USPQ 268, 269 (CCPA 1973) (“little weight is to be given such registrations in evaluating whether there is likelihood of confusion.”)).

For its part, Applicant’s contentions generally advance the argument that “[t]he Parties have been concurrently using their respective CASERA/CASERO/CASERITA marks in interstate commerce since at least as early as 1987.”⁹ App. Br., p.7. However, while there is no evidence of actual confusion in the record, the Board is not convinced from the record presented that there is sufficient evidence of actual marketplace interface between the marks that would lead to an opportunity for actual confusion. See *Cunningham*, 55 USPQ2d at 1847; *Nike*, 85 USPQ2d at 1202.¹⁰ An

⁹ The Board will construe this argument as a discussion of the eighth *DuPont* factor regarding the length of time during and conditions under which there has been concurrent use of similar marks without evidence of actual confusion,” *In re E. I. du Pont De Nemours*, 177 USPQ at 567; and not an attempt by Applicant to rehash its already stricken *Morehouse* defense. As such, this argument will only be considered in the context of the likelihood of confusion analysis and with respect to the other relevant *DuPont* factors.

¹⁰ In fact, despite Applicant’s arguments, it is not necessary to show actual confusion in order to establish likelihood of confusion. See *Hunter Indus., Inc. v. Toro Co.*, 110 USPQ2d 1651 (TTAB 2014) (citing *Giant Food, Inc. v. Nation’s Foodservice, Inc.*, 710 F.2d 1565, 1571, 218 USPQ 390, 396 (Fed. Cir. 1983)).

absence of any instances of actual confusion may be a meaningful component in a likelihood of confusion analysis if “the record indicates appreciable and continuous use by applicant of its mark for a significant period of time in the same markets as those served by opposer under its marks.” *See Citigroup Inc. v. Capital City Bank Group Inc.*, 94 USPQ2d 1645, 1660 (TTAB 2010), *aff’d*, 98 USPQ2d 1253 (Fed. Cir. 2011).

Finally, Applicant’s argument regarding Opposer’s failure to address “many of the *du Pont* factors,” is unavailing. A determination of likelihood of confusion does not require an analysis of every *du Pont* factor, indeed “any one of the factors may control a particular case.” *See Syndicat Des Proprietaires Viticulteurs De Chateauneuf-Du-Pape v. Pasquier DesVignes*, 107 USPQ2d 1930 (TTAB 2013) (*quoting In re Majestic Distilling Co., Inc.*, 315 F.3d 1311, 65 USPQ2d 1201, 1204 (Fed. Cir. 2003)).

Based upon the evidence made of record, and drawing any inferences, as we must, in a light favorable to Applicant, we conclude that Opposer has failed to discharge its burden of showing that there are no genuine disputes of material fact, and that it is entitled to judgment on the issue of likelihood of confusion.

Despite Opposer’s proffered evidence, the Board cannot conclude that the goods offered by Opposer and Applicant are related in such a way as to establish a likelihood of confusion. At a minimum, there are genuine disputes as to the degree of the relatedness of the parties’ goods, and the extent to

which an absence of actual confusion in spite of alleged long-term concurrent use may mollify any likelihood of confusion.¹¹

In light of the foregoing Opposer's motion for summary judgment is **GRANTED** in part, as to opposer's standing and priority for the marks and goods shown in the pleaded registrations; but is otherwise **DENIED**.¹² The proceeding is resumed upon the following schedule:

Discovery Closes	11/22/2014
Plaintiff's Pretrial Disclosures	1/6/2015
Plaintiff's 30-day Trial Period Ends	2/20/2015
Defendant's Pretrial Disclosures	3/7/2015
Defendant's 30-day Trial Period Ends	4/21/2015
Plaintiff's Rebuttal Disclosures	5/6/2015
Plaintiff's 15-day Rebuttal Period Ends	6/5/2015

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

¹¹ The fact that we have identified only certain genuine disputes as to material facts should not be construed as a finding that these are necessarily the only disputes which remain for trial.

¹² The parties should note that the evidence submitted in connection with the motion for summary judgment is of record only for consideration of that motion. To be considered at final hearing, any such evidence must be properly introduced in evidence during the appropriate trial period. See *Levi Strauss & Co. v. R. Josephs Sportswear Inc.*, 28 USPQ2d 1464 (TTAB 1993); *Pet Inc. v. Bassetti*, 219 USPQ 911 (TTAB 1983); *American Meat Institute v. Horace W. Longacre, Inc.*, 211 USPQ 712 (TTAB 1981).