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

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|------------------------|---|
| Proceeding | 91208141 |
| Party | Plaintiff Goya Foods, Inc. |
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| Submission | Motion to Strike |
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| Date | 01/04/2013 |
| Attachments | Motion to Strike.pdf (8 pages)(18672 bytes) |

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
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| GOYA FOODS, INC. | : | Opposition No.: 91208141 |
| | : | |
| Opposer, | : | |
| | : | |
| v. | : | |
| | : | Mark: CASERA |
| MARQUEZ BROTHERS INTERNATIONAL, | : | Ser. No. 85430918 |
| INC. | : | |
| | : | |
| Applicant. | : | |
| | : | |
| -----X | | |

MOTION TO STRIKE AFFIRMATIVE DEFENSES

Opposer, GOYA FOODS, INC. (“Opposer”) hereby moves to strike affirmative defenses of Applicant MARQUEZ BROTHERS INTERNATIONAL, INC. (“Applicant”) as plead in its Answer to Notice of Opposition.

This motion is timely made within the time prescribed in Fed. R. Civ. P. 12(c). Insofar as the motion falls under Fed. R. Civ. P. 12(f), the Board has discretion to hear same at this time. And, to the extent the motion requires the Board to look beyond the pleadings, the motion may be considered a motion for partial summary judgment pursuant to Fed. R. Civ. P. 56(c).

Granting this motion will be helpful in narrowing and limiting issues in this proceeding, thereby also serving as a guide in conducting discovery. As stated in 2A Moores Federal Practice paragraph 12.21[3]:

Although courts are reluctant to grant motions to strike, where a defense is legally insufficient, the motion should be granted in order to save the parties unnecessary expenditure in time and money in preparing for trial.

APPLICANT'S AFFIRMATIVE DEFENSES SHOULD BE STRICKEN

A motion to strike the defense of failure to state a claim upon which relief can be granted may be used by the plaintiff to test the sufficiency of its pleading. *Rooibos Limited v. Forever Young (Pty) Limited and Virginia Burke-Watkins*, 2003 TTAB LEXIS 65, 11-12 (Trademark Trial & App. Bd. Feb. 13, 2003). Accordingly, in determining whether to strike affirmative defenses, it will be necessary to look at the sufficiency of petitioner's pleading. *Id.*

FIRST AFFIRMATIVE DEFFENSE

As a first affirmative defense, the Notice of Opposition fails to state a claim upon which relief can be granted to Opposer.

At the pleading stage, Opposer must allege facts in its Notice of Opposition demonstrating its real interest in the proceeding. Those facts must thereafter be proved by Opposer as part of its case. *Ritchie v. Simpson*, 170 F.3d 1092, 50 USPQ2d 1023, 1025 (Fed. Cir. 1999).

To plead a real interest a plaintiff must allege a "direct and personal stake" in the outcome of the proceeding. *Id.* at 1026. The allegations in support of the plaintiff's belief of damage must have a reasonable basis "in fact." *Id.* at 1927 (citing *Universal Oil Products. v. Rexall Drug & Chemical Co.*, 463 F.2d 1122, 174 USPQ 458-459-60 (CCPA 1972) and stating that the belief of damage alleged by plaintiff must be more than a subjective belief).

Applicant's asserted defense therefore questions sufficiency of Opposer's pleading, similarly to a motion to dismiss for failing to plead a cause of action under Rule 12(b). As such, Rule 12(b) permits an applicant to assert this defense and "it necessarily follows that a plaintiff may utilize this assertion to test the sufficiency of the defense in

advance of trial by moving . . . to strike the ‘defense’ from the defendant's answer.”
Order of Sons of Italy in America v. Profumi Fratelli Nostra AG, 36 USPQ2d 1221, at 1222-1223 (TTAB 1995), citing *S.C. Johnson & Son Inc. v. GAF Corporation*, 177 USPQ 720 (TTAB 1973).

The following factors set forth in *Order of Sons of Italy* govern a motion to strike a defense of failure to state a claim upon which relief may be granted.

1. To withstand a motion to dismiss for failure to state a claim upon which relief can be granted, an Opposer need only allege such facts as would, if proved, establish that (1) Opposer has standing to maintain the proceeding, and (2) a valid ground exists for opposing registration.
2. For purposes of determining a motion to dismiss for failure to state a claim upon which relief can be granted, all of Opposer’s well-pleaded allegations must be accepted as true, and the Notice of Opposition must be construed in the light most favorable to Opposer.
3. Dismissal for insufficiency is appropriate only if it appears certain that Opposer is entitled to no relief under any set of facts which could be proved in support of its claim.
4. The standing question is an initial inquiry directed solely to establishing the personal interest of the plaintiff. An Opposer need only show “a personal interest in the outcome of the case beyond that of the general public.”

Opposer, in its Notice of Opposition, established its standing, and thus the sufficiency of its pleading, and has alleged, *inter alia*, the following:

· Opposer is now and for many years prior to any date which may be claimed by Applicant, engaged in the use of Opposer’s Mark on and in association with Opposer’s Goods and is the owner of registrations therefor. (Not. Opp. ¶¶ 3).

· Applicant’s Mark is confusingly similar to Opposer’s Marks and goods of Applicant and Opposer are substantially related in part and generally related in part, and Applicant's intended use of Applicant’s Mark in connection with its goods is without the consent or permission of Opposer. (Not. Opp. ¶¶ 11[*sic*] 13).

The registration of Applicant's Mark to Applicant will cause the relevant purchasing public to erroneously assume and thus be confused, misled, or deceived, that Applicant's Goods are made by, licensed by, controlled by, sponsored by, or in some way connected, related or associated with Opposer, all to Opposer's irreparable damage. (Not. Opp. ¶ 18).

The forgoing allegations are specifically set forth in Opposer's pleading and, if proven, Opposer establishes standing and shows entitlement to relief. Applicant's first defense is insupportable as a matter of law, and thus should be stricken.

SECOND AFFIRMATIVE DEFENSE

As a second affirmative defense, Opposer's claims for relief are barred by the doctrine of laches.

Laches is an affirmative defense which must be specifically pleaded under Fed. R. Civ. P. 12(b). Notwithstanding the fact that Applicant provides no explanation of this defense - The defense is not available, because laches cannot start to run prior to the date a mark is published for opposition. *See National Cable Television Association, Inc. v. American Cinema Editors Inc.*, 19 USPQ2d 1424 (Fed. Cir. 1991). The mark at issue published for opposition on July 24, 2012.

Because Opposer timely filed its notice of opposition, Applicant is precluded from asserting laches in this case. *See Id.*

THIRD AFFIRMATIVE DEFENSE

As a third affirmative defense, Opposer has waived any claims against Applicant arising out of the matters alleged in the Notice of Opposition.

FOURTH AFFIRMATIVE DEFENSE

As a fourth affirmative defense, Opposer is estopped from asserting any claims against Applicant arising out of the matters alleged in the Notice of Opposition

In above combined Nos. 3 and 4, Applicant plainly asserts waiver and estoppel as generally “arising out of matters alleged in the Notice of Opposition”. Applicant does not submit any evidence or argument regarding such defenses.

Because Applicant’s defenses lack any support, they must be stricken. *See Iredale Mineral Cosmetics v. Pbi Group*, 2011 TTAB LEXIS 243 (Trademark Trial & App. Bd. Aug. 9, 2011); *see also Bose Corp. v. GoldWave Inc.*, 2008 TTAB LEXIS 668 (Trademark Trial & App. Bd. Feb. 25, 2008)(“While, under the rubric of ‘AFFIRMATIVE DEFENSES,’ applicant has also pleaded that the opposition is...’barred by the doctrines of laches, waiver and/or estoppel,’ no further consideration will be given to such allegations inasmuch as they are not only insufficiently pleaded but, in any event, are lacking in any evidentiary support in the record.”)

Furthermore, because Applicant’s answer already denies the “matters alleged in the Notice of Opposition” its alleged affirmative defenses are merely arguments in furtherance of its denial of opposer’s likelihood of confusion – and should be stricken as such. *See below Arguments re Fifth Affirmative Defense; see also Miguel Torres, S.A. v. Complejo Indus. RM, S.A. de C.V.*, 2011 TTAB LEXIS 171 (Trademark Trial & App. Bd. May 17, 2011)(“Applicant’s answer also asserts three ‘affirmative defenses’ but they consist essentially of arguments in furtherance of applicant’s denial of opposer’s likelihood of confusion allegations. We have considered them as such.”).

FIFTH AFFIRMATIVE DEFENSE

As a fifth affirmative defense, there is no likelihood of consumer confusion, mistake or deception between Opposer’s CASERITA or CASERA marks and Applicant’s CASERA mark, as evidenced by the Parties’ concurrent use of their respective marks in connection with Class 29 goods....

Opposer alleges in its Opposition that "...by virtue of prior use, mistake or deception as to the source of origin of the goods will arise and will injure and damage the Opposer and its goodwill." (Not. Opp. ¶ 17). In its answer, Applicant already denied the "allegation at Paragraph 19 (incorrectly numbered as Paragraph 17)" and simply restates the denial under the label of an Affirmative defense, which is inappropriate.

Because the defense is redundant and or is a restatement of the denial in the answer, it should be stricken. *See Order of Sons of Italy in America v. Profumi Fratelli Nostra AG*, 36 USPQ2d 1221, 1223 (TTAB 1995) (defense stricken as redundant, that is, as nothing more than a restatement of a denial in the answer and does not add anything to that denial); *see also, AutoZone Parts, Inc. v. MS Motorsports, LLC*, 2012 TTAB LEXIS 479 (Trademark Trial & App. Bd. Dec. 11, 2012)("Although applicant did argue that confusion is not likely (Fifth and Seventh defenses), these are not affirmative defenses at all, but simply denials of opposer's claims"); *see also Miguel Torres, S.A. v. Complejo Indus. RM, S.A. de C.V.*, 2011 TTAB LEXIS 171 (Trademark Trial & App. Bd. May 17, 2011)("Applicant's answer also asserts three "affirmative defenses" but they consist essentially of arguments in furtherance of applicant's denial of opposer's likelihood of confusion allegations. We have considered them as such.").

SIXTH AFFIRMATIVE DEFENSE

As a sixth affirmative defense, Opposer's claims are barred or must fail in part because, to the extent that Opposer is, *arguendo*, successful in demonstrating that there is a likelihood of confusion between the Parties' marks, Applicant has priority over Opposer's CASERA mark by virtue of its use of CASERO since as early as 1977.

Applicant alleges it has a mark for CASERO that supports priority of its instant application over the Opposition Proceeding herein. The instant mark being opposed for registration however is CASERA (not CASERO). Asserting a different mark to support

CERTIFICATE OF SERVICE

I hereby certify that a copy of the foregoing MOTION TO STRIKE was sent to attorneys for Applicant this day by e-mail and first class mail, postage prepaid, to the following address:

Gregory Owen (gowen@owe.com)
Kathleen Letourneau (kel@owe.com)

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Dated: January 4, 2013

/Jason DeFrancesco/

Jason DeFrancesco