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

Proceeding	91215657
Party	Defendant GoYoGo Frozen Yogurt LLC
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In the Matter of Trademark Application Serial No. 86060111
For the mark:

Filed September 10, 2013

In the Matter of Trademark Application Serial No. 86037364
For the mark: GoYoGo Frozen Yogurt
Our Ingredients, Your Creation
Filed August 14, 2013

GOYA FOODS, INC., Opposer, v. GOYOGO FROZEN YOGURT LLC, Applicant.	Opposition No. 91215657

RESPONSE OF APPLICANT TO OPPOSER'S MOTION TO STRIKE THE FIRST, SIXTH AND SEVENTH SEPARATE DEFENSES

GoYoGo Frozen Yogurt LLC ("GoYoGo Frozen Yogurt" or "Applicant") responds to the motion of Goya Foods, Inc. ("Goya Foods") to strike certain separate defenses as follows:

Preliminary Statement

As part of its response to this opposition, GoYoGo Frozen Yogurt has rightfully asserted a series of separate defenses. The defenses include whether Goya Foods has failed to state a claim for which relief can be granted; that the products of GoYoGo Frozen Yogurt are sold in channels of commerce different from products of Goya Foods, refuting to the express pleading of Goya Foods to the contrary; and that GoYoGo Frozen Yogurt before the filing of the opposition

and continuing today, has used its marks in commerce, which repudiates the allegations of Goya Foods that GoYoGo Frozen Yogurt foisted a fraud upon the Trademark Office when the applications were filed. Goya Foods takes issue with these three defenses, and before discovery commences, Goya Foods looks to dismiss the three separate defenses.

The motion fails because the defenses are a necessary part of notice pleading. The defenses show Goya Foods what to expect based on the allegations made by Goya Foods. Next, as discussed more fully below, the defenses are triggered by express statementS made by Goya Foods in the opposition about GoYoGo Frozen Yogurt. In other words, GoYoGo Frozen Yogurt is squarely addressing the allegations.

When all is said and done, the separate defenses are appropriate and there is no prejudice to Goya Foods.

ARGUMENT

THE SEPARATE DEFENSES MEET THE STANDARD FOR NOTICE PLEADING

In its zeal to engage in wasteful motion practice,[1] Goya Foods has lost its way off the litigation path. That is to say, pleadings, which include answers, are notice documents. See, e.g., *Ohio State University v. Ohio University*, 51 USPQ2d 1289, 1292 (TTAB 1999) (primary purpose of pleadings "is to give fair notice of the claims or defenses asserted."); *Harsco Corp. v. Electrical Sciences, Inc.*, 9 USPQ2d 1570, 1571 (TTAB 1988) ("Under the Federal Rules of Civil Procedure the function of pleadings is to give fair notice of the claim asserted--preferably,

[1] It is considered wasteful because parties who seek to strike affirmative defenses implicitly encourage the adversary to engage in another round of motion practice under Fed. R. Civ. P. 15.

as provided by Fed. R. Civ. P. 8(a)(2), in a form which contains "a short and plain statement of the claim.").

The amplifications of denials by way of separate defenses "are permitted by the Board because they serve to give the plaintiff fuller notice of the position which the defendant plans to take in defense of its right to registration." TBMP § 311.02(d); see also cases cited therein, including *Order of Sons of Italy in America v. Profumi Fratelli Nostra AG*, 36 USPQ2d 1221, 1223 (TTAB 1995) (motion to strike third affirmative defense denied because it was an amplification of a denial, giving fuller notice of the claim); *Textron, Inc. v. Gillette Co.*, 180 USPQ 152, 153 (TTAB 1973) (denying motion to strike paragraph an answer which amplified applicant's denial and provided opposer with fuller notice of applicant's defense).

"Motions to strike in general are viewed with disfavor and matter will not be stricken unless it clearly has no bearing on the issues involved." *Order Sons of Italy in America v. Marofa S.A.*, 38 USPQ2d 1602, 1603 (TTAB 1996). *See also Harsco Corp.*, 9 USPQ2d at 1571 ("Motions to strike are not favored and matter will not be stricken unless it clearly has no bearing upon the issues under litigation.") (citing cases); *Harjo v. Pro Football, Inc.*, 30 USPQ2d 1828, 1830 (TTAB 1994) ("[T]he Board may grant a motion to strike from a pleading any insufficient defense. However, motions to strike are not favored and a defense will not be stricken if the insufficiency of the defense is not clearly apparent, or if it raises factual issues that should be determined on a hearing on the merits"); TBMP § 506.01.

Under Fed. R. Civ. P. 12(f), affirmative defenses may be stricken only if they present an "insufficient defense, or any redundant, immaterial, impertinent, or scandalous matter." Here, none of Applicant's affirmative defenses should be stricken because they meet the requirements of Fed. R. Civ. P. 12(f).

A. The First Separate Defense

A party is permitted to assert in the answer the defense of "failure to state a claim upon which relief can be granted." Fed. R. Civ. P. 12(b). Here, Goya Foods wrongly asserts that by virtue of having standing to oppose the application, that alone is sufficient to strike the "failure to state a claim" defense. The fact that an opposer has standing is by itself insufficient. See, e.g., *Harjo*, 30 USPQ2d at 1830-1833 (on a motion to strike an affirmative defense for failure to state a claim, the Board considered two issues: whether the petitioner has standing **and** whether the petition has set forth statutory grounds).

In support of its argument, Goya Foods relies on *Order Sons of Italy in American v. Morofa S.A.*, 38 USPQ2d 1602 (TTAB 1996). That case, however, is distinguishable for several reasons. There, the applicant sought to use the mark COSA NOSTRA for restaurants, pizzerias and other food services. *Id.* at 1603. But opposer asserted that the use of the mark COSA NOSTRA was disparaging and disreputable. *Id.* When the applicant raised the "failure to state a claim" defense, the opposer sought to strike the defense. *Id.* The Board granted the motion because the opposer "set forth sufficient allegations to establish, if proven, that opposer has standing to bring this proceeding **and** to support a pleading of disparagement, contempt, and/or disrepute under Section 2(a) of the Trademark Act." *Id.* (emphasis added). See also *Order of Sons of Italy in America v. Profumi Fratelli Nostra Ag*, 36 USPQ2d 1221, 1223 (TTAB 1995) ("Regarding the pleaded ground opposer has specifically pleaded what the opposer organization is and what it does; and that applicant's use of its mark on its goods will disparage the individual members of opposer as well as bring the Order as an institution of contempt or disrepute."). Likewise, in *Ritchie v. Simpson* – also cited by Goya Foods – the Federal Circuit held that the

opposer had standing **and** the mark that applicant sought to register was disparaging to Ritchie. 170 F.3d 1092, 1098 (Fed. Cir. 1999).

Goya Foods never asserts in its opposition that Applicant's marks are contemptuous or disparaging to Goya Foods; accordingly, the authority that it cites is unavailing. Putting that aside, the aforementioned cases bring to light that in order to successively strike an affirmative defense, or defeat a motion to dismiss, the opposer is required to (1) show standing **and** (2) show that there is a valid statutory ground for opposing the application. *Order of Sons of Italy,* 36 USPQ2d at 1222; *Harjo*, 30 USPQ2d at 1830; *Fair Indigo LLC v. Style Conscience*, 85 USPQ2d 1536, 1538 (TTAB 2007).

While "failure to state a claim" may not be a "true affirmative defense," *Hornblower & Weeks Inc. v. Hornblower & Weeks Inc.*, 60 USPQ2d 1733, 1738 n.7 (TTAB 2001), nonetheless, it is well established that this defense may be used to test the sufficiency of the opposer's pleading in advance of the trial. *Order of Sons of Italy*, 36 USPQ2d at 1222.

There is no question that "standing" is an element of Goya Foods' claim, and that Goya Foods will need to prove that it has standing. *Blackhorse v. Pro Football Inc.*, 98 USPQ2d 1633, 1637 (TTAB 2011). But Goya Foods has further to go: it also needs to set forth valid grounds to prevail in its opposition. *Order of Sons of Italy,* 36 USPQ2d at 1222; *Harjo,* 30 USPQ2d at 1830; *Fair Indigo,* 85 USPQ2d at 1538.

Assuming *arguendo* that Goya Foods' pleading is sufficient to establish standing, Goya Foods' pleading is deficient in that it does not properly plead "likelihood of confusion" or "dilution." To the extent that Applicant's separate defenses raise factual issues, the motion to strike an affirmative defense cannot be granted. *Harjo*, 30 USPQ2d at 1830 (the Board will not

strike an affirmative defense that "raises factual issues that should be determined on a hearing on the merits.").

Under Count I, Goya Foods asserts that there is a "likelihood of confusion." The opposition simply states that "Applicant's Mark [*sic*] is confusingly similar to Opposer's Mark [*sic*] and trade name." However, nowhere in the opposition does Goya Foods assert that a single one of the Goya Foods marks listed in the opposition (e.g. "GOYA"; "SI SE GOYA TIENNE QUE SER BUENO") are the same in sight, sound, meaning, and commercial impression as "GoYoGo Frozen Yogurt Our Ingredients Your Creation" or . *Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondee en 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1691 (Fed. Cir. 2005).

Likewise, Goya Foods' pleading of its dilution cause of action is at best overly broad conclusory statements. Goya Foods merely states that its pleaded name and marks are "distinctive and famous." (Opposition at ¶13.) Certainly Goya Foods has not pleaded that any of its marks are "distinctive and famous" for self-serve frozen yogurt products and services. Nor has Goya Foods pleaded that there is a likelihood that the Goya Foods marks would be confused by another mark, such as "GoYoGo Frozen Yogurt Our Ingredients Your Creation" or "independent of the consideration of the relatedness of the goods." *Recot, Inc. v. M.C. Becton*, 214 F.3d 1322, 1328, 54 USPQ2d 1894, 1898 (TTAB 2000).

Applicant is entitled to conduct discovery to support the validity of these affirmative defenses. Even assuming that Goya Foods has sufficiently pleaded its claims, Goya Foods will not be prejudiced by the inclusion of Applicant's "failure to state a claim" defense. Indeed, Goya Foods has provided no evidence that it will be prejudiced, particularly at this stage when

discovery has not even commenced. Thus, Goya Foods' motion to strike this defense should be denied.

B. The Sixth Separate Defense

Next, GoYoGo Frozen Yogurt offers as a separate defense that its products are sold in channels of commerce different from the Goya Foods marks. In so opposing this separate defense, Goya Foods states "[s]uch defense is unintelligible and do [*sic*] not present an adequate defense."

As a preliminary matter, Fed R. Civ. P. 8(b) only requires that a party to state its defenses "in short and plain terms." Assuming the genuineness of Goya Foods' assertion that this defense is "unintelligible," Goya Foods could have filed a motion for a more definitive statement pursuant to Fed. R. Civ. P. 12(e) and TBMP § 505 *et seq.* (3d ed. rev. 2012). Yet, it did not. Goya Foods' failure to even make this motion speak volumes.

In any event, Applicant's sixth defense is raised, in part, by the allegations of Goya Foods which alleges on information and belief that GoYoGo Frozen Yogurt promotes its products "through the same channels of trade" as Goya Foods. (Opposition at ¶16.)

The "channels of commerce" is one of the factors set forth in *Application of E.I. DuPont DeNemours & Co.*, 476 F.2d 1357, 1361 (C.C.P.A. 1973). This channel of commerce factor looks to whether the services travel in the same channels of trade and are sold to the same class of purchasers. *Stone Lion Capital Partners, L.P. v. Lion Capital LLP*, 746 F.3d 1317, 1320 (2014) (quoting *In re Smith & Mehaffey*, 31 USPQ2d 1531, 1532 (TTAB 1994)). This factor asks such questions as, "Are the services or goods described in the application identical?" "If there are any competing products, are they marketed in the same channels of trade and sold to the same classes of purchasers?" See *Coach Services, Inc. v. Triumph Learning LLC*, 668 F.3d 1356,

1370-71 (Fed. Cir. 2012). The answer to these and other questions is best left to until after the close of discovery, which has not yet commenced. Thus, Goya Foods' motion to strike the sixth affirmative defense must be denied.

C. The Seventh Separate Defense

Finally, and perhaps most incredibly, Goya Foods takes issue with the separate defense that the GoYoGo Frozen Yogurt marks have been and continue be used in commerce. In a single sentence, Goya Foods seeks to strike the seventh defense by asserting "that the Applicant's marks have been and continue to be used in [c]ommerce is not a defense."

Not only does Goya Foods fail to cite authority in its support of this argument, but Goya Foods apparently overlooks its own allegations in the opposition, namely that counts III and IV expressly allege, among other things: "Applicant knowingly did not have a bona fide intent to use Applicant's Mark [*sic*] as Applicant has not taken steps to commence use [of] its Mark [*sic*] on Applicant's Services." (Opposition at ¶27.) "Applicant's Applications are void ab initio as Applicant had no good faith bona fide intent to use Applicant's Marks for Applicant's Services." (Opposition at ¶36.)

GoYoGo Frozen Yogurt, on the other hand, by virtue of the separate defense is putting Goya Foods on notice that GoYoGo Frozen Yogurt has and continues to use the marks. That is as classic a defense as one might find. Indeed, the "[o]pposer has the initial burden of demonstrating by a preponderance of the evidence that applicant lacked a bona fide intent to use the mark on identified goods." *Boston Red Sox Baseball Club Limited Partnership v. Brad Francis Sherman*, 88 USPQ2d 1581, 1587 (TTAB 2008). See also *Research in Motion Limited v. NBOR Corporation*, 92 USPQ2d 1926, 1930 (TTAB 2009) ("Opposer has the burden of demonstrating a preponderance of the evidence that applicant lacked a bona fide intent to use the

mark on the identified goods."). Unquestionably, whether an applicant had a bona fide intent to use a mark **requires** discovery. *Id.* at 1930-31; *Diageo North America, Inc. v. Captain Russell Corp.*, Opposition No. 92103745 (June 12, 2013) [not precedential], 2013 WL 5407296 at * 5.

GoYoGo Frozen Yogurt has every right to raise as an affirmative defense that its marks have been and continue to be used in commerce, and that it had a bona fide intent to use the marks in question. Thus, Goya Foods' motion to strike the seventh defense should be denied.

CONCLUSION

For all of the reasons stated more fully above, the motion of Goya Foods to strike certain defenses of GoYoGo Frozen Yogurt should be denied.

Respectfully submitted,

June 23, 2014

By: _____
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CERTIFICATE OF SERVICE

I, Dennis F. Gleason, certify that on June 23, 2014, a copy of the response of applicant was served by email on

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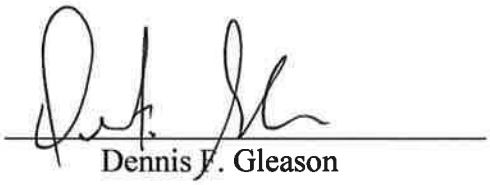
June 23, 2014



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