

UNITED STATES PATENT AND TRADEMARK OFFICE  
Trademark Trial and Appeal Board  
P.O. Box 1451  
Alexandria, VA 22313-1451  
General Contact Number: 571-272-8500

Mailed: October 1, 2014

Opposition No. 91215657

Goya Foods, Inc.

v.

GoYoGo Frozen Yogurt LLC

**Robert H. Coggins,  
Interlocutory Attorney:**

Now before the Board is opposer's motion (filed June 2, 2014) to strike three of applicant's affirmative defenses.<sup>1</sup> The motion is fully briefed.

Motion to Strike

Opposer moves to strike applicant's first, sixth, and seventh defenses from the answer. The Board addresses each "defense" in turn.

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<sup>1</sup> Opposer incorrectly states that "to the extent the motion requires the Board to look beyond the pleadings, the motion may be considered a motion for partial summary judgment...." Motion, p. 1. Such a motion would be premature. *See Qualcomm, Inc. v. FLO Corp.*, 93 USPQ2d 1768, 1769-70 (TTAB 2010) (motion for summary judgment denied as premature where movant had not yet served initial disclosures).

A. First defense

Inasmuch as applicant's first defense is that opposer "fails to state a cause of action for which relief can be granted," it would normally be considered, essentially, a defense of failure to state a claim upon which relief can be granted under Fed. R. Civ. P. 12(b) and it would therefore normally be necessary to look at the sufficiency of opposer's entire pleading to determine whether opposer's standing and grounds are sufficiently pleaded. *See Order of Sons of Italy in America v. Profumi Fratelli Nostra AG*, 36 USPQ2d 1221, 1222 (TTAB 1995) (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). *See also Lipton Industries, Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185, 187 (CCPA 1982) (in order to withstand the defense of failure to state a claim, an opposer need only allege such facts in the notice of opposition as would, if proved, establish that (1) it has standing, and (2) a valid ground exists for opposing the subject application). However, opposer's motion challenges applicant's first defense only to the extent of testing the sufficiency of opposer's standing; the motion does not seek to test the sufficiency of any ground for opposition.<sup>2</sup> *See Motion*, pp. 2-4. Inasmuch as opposer argues the issue of its "real interest" and fails to argue

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<sup>2</sup> This is not the only curiosity with opposer's motion. The relief sought includes, alternatively, either striking applicant's counterclaims or resetting the time in which to answer the counterclaim. *See Motion*, p. 6. However, inasmuch as there is no counterclaim pleaded in the answer, such relief is inappropriate and unavailable.

in its primary brief that any of its grounds are valid,<sup>3</sup> the Board will address in detail only opposer's standing. Notwithstanding this treatment, the Board has reviewed the entire notice of opposition and notes that each of the four grounds for opposition (i.e., priority and likelihood of confusion, dilution, fraud, and that applicant did not have a *bona fide* intent to use the marks in connection with the identified services as of the filing dates of the applications) is sufficiently pleaded.<sup>4</sup>

Opposer must allege facts in the notice of opposition which, if ultimately proven, would establish that opposer has a real interest in the proceeding and a reasonable basis for the belief that it will be damaged by the issuance of a registration. *Herbko Int'l v. Kappa Books, Inc.*, 308 F.3d 1156, 64 USPQ2d 1375 (Fed. Cir. 2002); *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1848 (Fed. Cir. 2000); *Ritchie v. Simpson*, 170 F.3d 1092, 1098, 50 USPQ2d 1023, 1025-26 (Fed. Cir. 1999).

Opposer claims ownership of twenty registrations for marks comprised wholly or in part of GOYA or GOYO for food items, food-related services, and other goods. *See* ESTTA cover sheet, and Notice, para. 10. Opposer also

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<sup>3</sup> It is not until opposer filed its reply brief in support of the motion to strike that opposer raises the issue of the sufficiency of any ground, and then it is only the ground of priority and likelihood of confusion. Although the issue is raised in the reply, it is not argued or analyzed by opposer in any detail. Inasmuch as the grounds are ignored by opposer in the primary brief on the motion and only a single ground is summarily treated by opposer in the reply, the Board is not inclined to spend its resources making opposer's case where opposer has made no effort.

<sup>4</sup> Applicant's arguments in the brief in opposition as to priority and likelihood of confusion and dilution have no merit.

alleges that it will be damaged by registration of the subject marks, which are comprised in part of the term GOYOGO, and that registration and use of the subject marks by applicant are likely to cause confusion in violation of Trademark Act § 2(d), 15 U.S.C. § 1052(d). See ESTTA cover sheet, and Notice, paras. 1, 18-20, and 41. These allegations, read in conjunction with the other allegations in the complaint, demonstrate that opposer has a real interest in this opposition proceeding and thus, if proved, would establish its standing. *Cunningham v. Laser Golf Corp.*, *supra*, 55 USPQ2d at 1844 (registrations sufficient to establish direct commercial interest and standing). In view thereof, opposer has sufficiently pleaded its standing.<sup>5</sup> Inasmuch as opposer has sufficiently pleading standing and four valid grounds, the motion to strike is **granted, in part**, as to the first defense.

B. Sixth defense

Applicant's sixth defense states that "[t]he products sold [by applicant] under the [subject] GoYoGo Marks are sold in channels of commerce different from the [goods and services sold by opposer under the pleaded] Goya Marks." As noted above, opposer has pleaded priority and likelihood of confusion under § 2(d) as one of the grounds for opposition. See ESTTA cover sheet; and Notice, Count I, p. 10. The third factor under the *du Pont* test for likelihood of confusion under § 2(d) is the similarity or dissimilarity of established, likely-to-continue trade channels. *In re E. I. du Pont de Nemours*

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<sup>5</sup> Whether opposer can prove the allegations of its standing and of each ground for opposition remains a matter for trial.

& Co., 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973). In analyzing the issue of likelihood of confusion, the Board may consider all of the facts in evidence relevant to the factors enumerated in *du Pont*. See *Giersch v. Scripps Networks, Inc.*, 90 USPQ2d 1020, 1025 (TTAB 2009).

While it is true, as opposer states, that the subject applications do not include a trade channel restriction and it must be presumed that applicant's services are or will be rendered in all normal channels of trade to all of the usual customers of self-serve frozen yogurt shops, there has been no determination as to whether the parties' respective goods and services are different or noncompetitive. See, e.g., *Electronic Design & Sales Inc. v. Electronic Data Systems Corp.*, 954 F.2d 713, 21 USPQ2d 1388, 1391 (Fed. Cir. 1992). The sixth defense is construed as an amplification of applicant's denial of opposer's ground of likelihood of confusion and serves to apprise opposer with greater particularity of at least one position which applicant is taking in the defense of its right of registration --that is, that the trade channels for applicant's services are dissimilar to the trade channels for opposer's goods and services. See *Sons of Italy*, 36 USPQ2d at 1223; and *Textron, Inc. v. The Gillette Co.*, 180 USPQ 152, 153 (TTAB 1973).

It is curious that opposer seeks to strike this "defense" from the answer when opposer itself specifically alleges in the notice of opposition (at para. 16) that applicant promotes its services through the same channels of trade as opposer. It follows that since opposer makes this specific allegation,

if the Board were to strike applicant's sixth defense, the Board would be justified in *sua sponte* striking paragraph 16 from the notice of opposition; however, the Board declines to strike either. In view thereof, the motion to strike is **denied, in part**, as to the sixth defense.<sup>6</sup>

C. Seventh defense

Applicant's seventh defense states that "[t]he [subject] GoYoGo Marks have been and continue to be used in commerce." As noted above, opposer has pleaded as one of the grounds for opposition that applicant did not have a *bona fide* intent to use the marks in connection with the identified services as of the filing dates of the applications. *See* Notice, Count IV, pp. 12-13. Opposer supports this claim by further alleging that "[a]pplicant has taken no steps to begin commercial use of [the subject] marks either prior to or subsequent to the filing of [the subject] applications." Notice, para 38. Similarly, the pleaded ground of fraud rests on applicant's *bona fide* intent to use. *See* Notice, Count III, pp. 11-12.

It once again strikes the Board as curious that opposer seeks to remove from the answer a "defense" that is directly related to matter opposer itself specifically alleges in the notice of opposition. The seventh defense appears

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<sup>6</sup> In denying the motion as to the sixth defense (and seventh defense, *see infra*), the Board notes that motions to strike are not favored, and matter will not usually be stricken unless it clearly has no bearing upon the issues of the case. *See Harsco Corp. v. Electrical Sciences Inc.*, 9 USPQ2d 1570 (TTAB 1988). Since a primary purpose of the answer is to give fair notice of defenses asserted, the Board, in its discretion, may decline to strike even objectionable matter where its inclusion will not prejudice opposer but rather will provide a fuller notice of the basis for denying a claim. *See* TBMP § 506.01 (2014).

to be in reply to opposer's Counts III and IV. Moreover, the seventh defense is an amplification of applicant's specific denial of paragraph 38, and is relevant to issue of applicant's *bona fide* use. *See, e.g., L'Oreal S.A. v. Marcon*, 102 USPQ2d 1434, 1443 (TTAB 2012) (objective evidence that applicant can use the mark, is using the mark, has capacity to offer identified services, and whether applicant has undertaken any concrete activities in preparation for use of the applied-for marks in connection with the services can all be relevant to question of *bona fide* intent to use). In view thereof, the motion to strike is **denied, in part**, as to the seventh defense.

Schedule

Proceedings are resumed. Dates are reset on the following schedule.

Deadline for Discovery Conference	10/24/2014
Discovery Opens	10/24/2014
Initial Disclosures Due	11/23/2014
Expert Disclosures Due	3/23/2015
Discovery Closes	4/22/2015
Plaintiff's Pretrial Disclosures	6/6/2015
Plaintiff's 30-day Trial Period Ends	7/21/2015
Defendant's Pretrial Disclosures	8/5/2015
Defendant's 30-day Trial Period Ends	9/19/2015
Plaintiff's Rebuttal Disclosures	10/4/2015
Plaintiff's 15-day Rebuttal Period Ends	11/3/2015

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 the taking of testimony. Trademark Rule 2.125. Briefs shall be filed in accordance with Trademark Rules 2.128(a) and

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(b). An oral hearing will be set only upon request filed as provided by Trademark Rule 2.129.