

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board

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September 2, 2020

Opposition No. 91254690 (**Parent**)

Opposition No. 91255498

Sony Pictures Television Inc.

v.

El Pollo Regio IP, LLC

Opposition No. 91256291

El Pollo Regio IP, LLC

v.

Sony Pictures Television Inc.

Mary Beth Myles, Interlocutory Attorney:

This proceeding now comes before the Board for consideration of Sony Pictures Television Inc.'s ("Sony") motions to strike certain affirmative defenses in El Pollo Regio IP, LLC's ("El Pollo Regio") answer in Opposition Nos. 91254690 and 91255498. The motions are fully briefed.

The Board has considered the parties' arguments but addresses the record only to the extent necessary to set forth the Board's analysis and findings, and does not repeat or address all of the parties' arguments.

I. Background

El Pollo Regio filed intent-to-use applications for the following marks for POLLO REGIO and design, as shown below:

Serial No. 88112977¹:



Serial No. 88336253²:



¹ Filed September 11, 2018 pursuant to section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b), for “[c]atering services; Restaurant and catering services; Restaurant services; Restaurant services, including sit-down service of food and take-out restaurant services” in Class 43 and “[s]hirts; T-shirts; Graphic T-shirts; Short-sleeved shirts” in Class 25. The description of the mark states that “[t]he mark consists of two stylized chickens, each wearing a cowboy hat, an apron, and boots and featured standing in the foreground with respect to a circle; above the circle is the word ‘Pollo’ and beneath the circle is the word ‘Regio’.” “POLLO” is disclaimed in Class 43.

² Filed March 12, 2019, pursuant to section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b), for “[r]estaurant services; Restaurant services, including sit-down service of food and take-out restaurant services” in Class 43 and “[s]hirts; Graphic T-shirts; Short-sleeved shirts; T-shirts” in Class 25. The description of the mark states that “[t]he mark consists of two stylized chickens, each wearing a cowboy hat, an apron, and boots and featured standing in the foreground with respect to a shaded circle; above the circle is the stylized word ‘POLLO’ and beneath the circle is the stylized word ‘REGIO’. The rectangular shaped background is for shading purposes only and is not claimed as a feature of the mark.” “POLLO” is disclaimed.

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Sony opposed Application Serial No. 88112977 on March 16, 2020, in Opposition No. 91254690. Sony opposed Application Serial No. 88336253 on April 27, 2020, in Opposition No. 91255498. The pleaded grounds for both oppositions is likelihood of confusion under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), dilution by blurring under Section 43(c) of the Trademark Act, 15 U.S.C. § 1125(c), and false suggestion of a connection under Section 2(a) of the Trademark Act, 15 U.S.C. § 1052(a). In support of its allegations, Sony pleaded ownership of common law rights in the mark LOS POLLOS HERMANOS and design, shown below, in connection with, inter alia, t-shirts, pop-up restaurants, and restaurant delivery services:



See Opp. No. 91254690, 1 TTABVUE 5; Opp. No. 91255498, 1 TTABVUE 5.

On September 17, 2019, Sony filed an intent-to-use application to register the LOS POLLOS HERMANOS and design mark.³ The mark published for opposition on

³ Application Serial No. 88619704, filed pursuant to section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b) for “restaurant services, namely, providing food and beverages for delivery by others.” The description of the mark states, “[t]he mark consists of a circular background in yellow containing the words ‘LOS POLLOS HERMANOS’ in uppercase stylized red lettering trimmed in blue, surrounding a royal blue circular background with navy blue trim. Within are two animated white chickens with white and black eyes, yellow beaks and orange appearing on the tops of their heads with red appearing beneath the beaks and with the entire chicken designs trimmed in black standing back to back. The chicken on the left has a opened mouth and red tongue and is holding a yellow hat and is wearing a scarf in red, green and yellow, stripped pants in yellow and black with a black belt and brown shoes with white highlights and shading. The chicken on the right is holding a yellow hat and is wearing a

February 11, 2020, and El Pollo Regio opposed it on June 10, 2020. Opp. No. 91256291, 1 TTABVUE. As grounds for its opposition, El Pollo Regio pleaded likelihood of confusion based on ownership of multiple POLLO REGIO-formative word and design marks used and registered in connection with shirts and restaurant services, as well as its application Serial Nos. 88112977 and 88336253. *Id.* at 11-16. Sony filed its answer in Opposition No. 91256291 on July 20, 2020. 4 TTABVUE.

El Pollo Regio filed its answer in Opposition No. 91254690 on April 24, 2020, and filed its answer in Opposition No. 91255498 on June 5, 2020. Both answers contained identically-pleaded affirmative defenses of waiver, acquiescence, and laches. Opp. No. 91254690, 4 TTABVUE 6; Opp. No. 91255498, 4 TTABVUE 5. On May 12, 2020, Sony filed a motion to strike the affirmative defenses of waiver, acquiescence, and laches in Opposition No. 91254690. 5 TTABVUE. On June 22, 2020, Sony filed a motion to strike the same affirmative defenses in Opposition No. 91255498. 5 TTABVUE.

II. Sua Sponte Consolidation

As an initial matter, when cases involving common questions of law or fact are pending before the Board, the Board may order consolidation of the cases. *See* Fed. R. Civ. P. 42(a); *Regatta Sport Ltd. v. Telux-Pioneer Inc.*, 20 USPQ2d 1154, 1156 (TTAB 1991); *Estate of Biro v. Bic Corp.*, 18 USPQ2d 1382, 1384 n.3 (TTAB 1991). In determining whether to consolidate proceedings, the Board will weigh the savings in

scarf in blue, red and yellow, beige and brown stripped pants with a black belt and brown shoes all having black and white shading and trim.” “POLLOS” is disclaimed.

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time, effort, and expense that may be gained from consolidation against any prejudice or inconvenience that may be caused thereby.

Consolidation is discretionary with the Board and may be ordered upon motion granted by the Board, or upon stipulation of the parties approved by the Board, or upon the Board's own initiative. *See, e.g., Hilson Research Inc. v. Society for Human Resource Management*, 27 USPQ2d 1423, 1424 n.1 (TTAB 1993); *Regatta Sport Ltd.*, 20 USPQ2d at 1156.

Opposition Nos. 91254690, 91255498, and 91256291 involve the same parties and marks, and common questions of law or fact. Accordingly, the Board orders consolidation of these cases. *See Fed. R. Civ. P. 42(a); Regatta Sport Ltd.*, 20 USPQ2d at 1156; and *Estate of Biro*, 18 USPQ2d at 1384 n.3. The consolidated cases may be presented on the same record and briefs. *See Helene Curtis Indus. Inc. v. Suave Shoe Corp.*, 13 USPQ2d 1618, 1619 n.1 (TTAB 1989); *Hilson Research*, 26 USPQ2d at 1424 n.1.

The Board file will be maintained in Opposition No. 91254690 as the “parent case.” A single copy of all motions and submissions should be filed, and each submission should be filed in the parent case only, but caption the proceeding numbers, listing and identifying the “parent case” first.⁴

Despite being consolidated, each proceeding retains its separate character and requires entry of a separate judgment. The decision on the consolidated cases shall

⁴ The parties should promptly inform the Board of any other Board proceedings or related cases within the meaning of Fed. R. Civ. P. 42, so that the Board can consider whether further consolidation is appropriate.

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take into account any differences in the issues raised by the respective pleadings; a copy of the decision shall be placed in each proceeding file.

III. Motion to Strike

Sony moves to strike the affirmative defenses of waiver, acquiescence, and laches from Applicant's answers in Opposition Nos. 91254690 and 91255498.⁵ Opp. No. 91254690, 4 TTABVUE, Fourth, Fifth, and Sixth Affirmative Defense; Opp. No. 91255498, 4 TTABVUE, First, Second, and Third Affirmative Defense. Inasmuch as the affirmative defenses and motions to strike are largely identical, the Board addresses both motions together.

A. Legal Standard

The Board may strike from a pleading any insufficient defense, or any redundant, immaterial, impertinent, or scandalous matter. Fed. R. Civ. P. 12(f); *Am. Vitamin Prods. Inc. v. Dow Brands Inc.*, 22 USPQ2d 1313, 1314 (TTAB 1992); TRADEMARK TRIAL AND APPEAL BOARD MANUAL OF PROCEDURE (TBMP) § 506.01 (2020). Motions to strike are not favored, and as such, a defense will not be stricken as insufficient if the insufficiency is not clearly apparent, or if it raises factual issues that should be determined on the merits. TBMP § 506.01. The primary purpose of the pleadings, under the Federal Rules of Civil Procedure, is to give fair notice of the claims or defenses asserted. *Ohio State University v. Ohio University*, 51 USPQ2d 1289, 1292 (TTAB 1999). Thus, the Board, in its discretion, may decline to strike even

⁵ Applicant pleaded waiver, acquiescence, and laches as its fourth, fifth, and sixth affirmative defenses in Opposition No. 91254690 and as its first, second, and third affirmative defenses in Opposition No. 91255498.

objectionable pleadings where their inclusion will not prejudice the adverse party, but rather will provide fuller notice of the basis for a claim or defense. *Id.*; *Harsco Corp. v. Elec. Sciences Inc.*, 9 USPQ2d 1570, 1571 (TTAB 1988).

B. Decision

For its affirmative defenses of waiver, acquiescence, and laches, El Pollo Regio pleads only that Sony “is barred from opposing Applicant’s use of and application for its POLLO REGIO mark” under the doctrine of each defense. Opp. No. 91254690, 4 TTAVUE 6; Opp. No. 91255498, 4 TTABVUE 5. These bald, conclusory allegations are legally insufficient because they do not provide Opposer with fair notice of the factual bases for the defenses. Fed. R. Civ. P. 8(b)(1) and 12(f); *see e.g., IdeasOne Inc. v. Nationwide Better Health Inc.*, 89 USPQ2d 1952, 1953 (TTAB 2009); *Fair Indigo LLC v. Style Conscience*, 85 USPQ2d 1536, 1538 (TTAB 2007); *Midwest Plastic Fabricators, Inc. v. Underwriters Labs. Inc.*, 5 USPQ2d 1067, 1069 (TTAB 1980); *see also* TBMP § 311.02(b) (“The elements of a defense should be stated simply, concisely, and directly. However, the pleading should include enough detail to give the plaintiff fair notice of the basis for the defense.”).

In its opposition brief in both proceedings, El Pollo Regio makes additional allegations that purportedly support the merits of its affirmative defenses. Opp. No. 91254690, 7 TTAVUE 5-7; Opp. No. 91255498, 7 TTABVUE 5-8. Specifically, El Pollo Regio argues that Sony was aware of El Pollo Regio’s claims to its applied-for marks as early as 2018 yet took no legal action until filing the oppositions at issue. *Id.* As these allegations are not pleaded in El Pollo Regio’s answers, they can be given no

consideration in determining the sufficiency of its pleadings. *Cf. Libertyville Saddle Shop Inc. v. E. Jeffries & Sons Ltd.*, 22 USPQ2d 1594, 1597 (TTAB 1992) (A motion to dismiss is a test solely of the legal sufficiency of the plaintiff's pleadings ... No matters outside the pleadings are considered.).

Even if the allegations in El Pollo Regio's briefs were considered however, they would not suffice to plead these affirmative defenses. The affirmative defenses of laches and acquiescence are generally not applicable in opposition proceedings because these defenses start to run from the time the mark is published for opposition, not from the time of knowledge of use. *See Nat'l Cable Television Ass'n Inc. v. Am. Cinema Editors Inc.*, 937 F.2d 1572, 19 USPQ2d 1424, 1432 (Fed. Cir. 1991) ("In an opposition or cancellation proceeding the objection is to the rights which flow from registration of the mark."); *Panda Travel, Inc. v. Resort Option Enters., Inc.*, 94 USPQ2d 1789 (TTAB 2009) (laches begins to run from publication date and when an opposition is timely filed, there can be no laches defense based on opposer's knowledge of prior use); *Barbara's Bakery Inc. v. Landesman*, 82 USPQ2d 1283, 1292 n.14 (TTAB 2007); *Bausch & Lomb Inc. v. Karl Storz GmbH & Co. KG*, 87 USPQ2d 1526, 1531 (TTAB 2008); *Krause v. Krause Publ'ns., Inc.*, 76 USPQ2d 1904, 1914 (TTAB 2005). *See also* TBMP § 311.02(b).

As further regards acquiescence, it is well-settled that "[a]cquiescence and estoppel require some affirmative act by opposer which led applicant to reasonably believe that opposer would not oppose applicant's **registration** of its mark." *DAK Indus. Inc. v. Daiichi Kosho Co. Ltd.*, 25 USPQ2d 1622, 1625 (TTAB 1993) (emphasis

added). El Pollo Regio does not allege that Sony represented that it would not oppose registration of El Pollo Regio's marks. Rather, El Pollo Regio argues that Sony "delayed filing this opposition proceeding" after learning of El Pollo Regio's **use** of its marks in 2018. Opp. 91255498, 7 TTABVUE 7.

Finally, El Pollo Regio appears to conflate waiver with laches. "Waiver" typically refers to "estoppel by agreement" or "contractual estoppel," i.e., that a prior agreement between the parties estops Sony from filing the present opposition. *See, e.g., M-5 Steel Mfg. Inc. v. O'Hagin's Inc.*, 61 USPQ2d 1086, 1095 (TTAB 2001), and cases cited therein. El Pollo Regio has not set forth any allegations to indicate that there was a prior agreement between the parties regarding its registration of its mark.

Accordingly, Sony's motion to strike El Pollo Regio's affirmative defenses of waiver, acquiescence, and laches in Opposition Nos. 91254690 and 91255498 is **granted**. Applicant's fourth, fifth, and sixth affirmative defenses in Opposition No. 91254690 and its first, second, and third affirmative defenses in Opposition No. 91255498 are **stricken**.

IV. Summary; Trial Dates Reset

Sony's motion is **granted**. El Pollo Regio's affirmative defenses of waiver, laches, and acquiescence will be given no further consideration. Opposition Nos. 91254690, 91255498 and 91256291 are consolidated. Opposition No. 91254690 is the parent.

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Upon consolidation, the Board will reset dates for the consolidated proceeding, usually by adopting the dates as set in the most recently instituted of the cases being consolidated. Remaining dates are reset as follows:

Deadline for Discovery Conference	9/21/2020
Discovery Opens	9/21/2020
Initial Disclosures Due	10/21/2020
Expert Disclosures Due	2/18/2021
Discovery Closes	3/20/2021
Pretrial Disclosures Due for Party in Position of Plaintiff in Opposition Nos. 91254690 and 91255498	5/4/2021
30-day Trial Period Ends for Party in Position of Plaintiff in Opposition Nos. 91254690 and 91255498	6/18/2021
Pretrial Disclosures Due for Party in Position of Defendant Opposition Nos. 91254690 and 91255498 and in Position of Plaintiff in Opposition No. 91256291	7/3/2021
30-day Trial Period Ends for Party in Position of Defendant in Opposition Nos. 91254690 and 91255498, and in Position of Plaintiff in Opposition No. 91256291	8/17/2021
Pretrial Disclosures Due for Rebuttal of Party in Position of Plaintiff Opposition Nos. 91254690 and 91255498 and in Position of Defendant in Opposition No. 91256291	9/1/2021
30-day Trial Period Ends for Rebuttal of Party in Position of Plaintiff in Opposition Nos. 91254690 and 91255498, and in Position of Defendant in Opposition No. 91256291	10/16/2021
Pretrial Disclosures Due for Rebuttal of Party in Position of Plaintiff in Opposition No. 91256291	10/31/2021
15-day Trial Period Ends for Rebuttal of Party in Position of Plaintiff in Opposition No. 91256291	11/30/2021
Opening Brief for Party in Position of Plaintiff in Opposition Nos. 91254690 and 91255498 Due	1/29/2022
Combined Brief for Party in Position of Defendant in Opposition Nos. 91254690 and 91255498 and Opening Brief as Plaintiff in Opposition No. 91256291 Due	2/28/2022
Combined Rebuttal Brief for Party in Position of Plaintiff Opposition Nos. 91254690 and 91255498 and Brief as Defendant in Opposition No. 91256291 Due	3/30/2022

Rebuttal Brief for Party in Position of Plaintiff in Opposition No. 91256291 Due	4/14/2022
Request for Oral Hearing (optional) Due	4/24/2022

Generally, the Federal Rules of Evidence apply to Board trials. Trial testimony is taken and introduced out of the presence of the Board during the assigned testimony periods. The parties may stipulate to a wide variety of matters, and many requirements relevant to the trial phase of Board proceedings are set forth in Trademark Rules 2.121 through 2.125. These include pretrial disclosures, matters in evidence, the manner and timing of taking testimony, and the procedures for submitting and serving testimony and other evidence, including affidavits, declarations, deposition transcripts and stipulated evidence. Trial briefs shall be submitted in accordance with Trademark Rules 2.128(a) and (b). Oral argument at final hearing will be scheduled only upon the timely submission of a separate notice as allowed by Trademark Rule 2.129(a).