

This Opinion is Not a
Precedent of the TTAB

Mailed: January 22, 2015

UNITED STATES PATENT AND TRADEMARK OFFICE

—
Trademark Trial and Appeal Board

—
In re Seacret Spa International LTD

—
Serial No. 78811559

—
On Request for Reconsideration

—
Albert L. Schmeiser and Sean K. Enos of Schmeiser Olsen & Watts LLP,
for Seacret Spa International LTD.

Matthew Galan, Trademark Examining Attorney, Law Office 113,
Odette Bonnet, Managing Attorney.

—
Before Bucher, Taylor and Masiello,
Administrative Trademark Judges.

Opinion by Taylor, Administrative Trademark Judge:

Secret Spa International (“Applicant” or “Secret Spa”) sought registration on the Principal Register of the stylized mark **SEACRET** for “[p]roducts containing ingredients from the Dead Sea, namely, non-medicated skin care preparations, namely, moisturizers, facial cleansers, facial peels, masks, lotions, creams, scrubs, soaps, nail care preparations, hand creams, cuticle oils; [and] after shave” in International Class 3.

On December 3, 2014, this panel of the Board issued a decision affirming the Trademark Examining Attorney's refusal to register the stylized mark **SECRET** under Section 2(d) of the Trademark Act of 1946, 15 U.S.C. § 1052(d), on the ground that Applicant's applied-for mark so resembles the registered marks SECRET (standard characters) and **SECRET** (stylized), registered respectively in connection with "[b]ody spray" and "[p]ersonal deodorant" (both in Class 3), that there is a likelihood of confusion as to the source of sponsorship or the goods.

Applicant timely filed a request for reconsideration of the Board's decision pursuant to Trademark Rule 2.144. Applicant also requested that the Board grant a rehearing prior to its reconsideration and decision on Applicant's request "due to the importance of the legal issue involved herein." Req. for recon. p. 1.

As a preliminary matter, the Board has considered Applicant's request for a rehearing but has determined that a rehearing of this matter is unwarranted. Furthermore, while we agree with Applicant that the matters at issue in this case, as in all cases, are of importance, Applicant is not relying on novel legal theories, nor are the facts of this case so complicated that additional argument is needed. Rather, as more fully discussed *infra*, Applicant merely disagrees with the Board's application of the law to the facts of the case.

Turning then to Applicant's request for reconsideration, the premise underlying a request for reconsideration of a Board decision in an *ex parte* appeal is that "based on the evidence of record and the prevailing authorities, the Board erred in reaching the decision it issued." TBMP § 543 (2014). The request may not be used to

introduce additional evidence, nor should it be devoted simply to a reargument of the points presented in the requesting party's brief on the case. *See Amoco Oil Co. v. Amerco, Inc.*, 201 USPQ 126 (TTAB 1978). Rather, the request normally should be limited to a demonstration that, based on the evidence properly of record and the applicable law, the Board's ruling is in error and requires appropriate change. *See, e.g., Steiger Tractor Inc. v. Steiner Corp.*, 221 USPQ 165 (TTAB 1984), *reh'g granted*, 3 USPQ2d 1708 (TTAB 1984).

Applicant's request for reconsideration is "primarily based on the Boards [sic] decision stating that, 'Opposition No. 91174407 between Applicant and Registrant (as Opposer) concerning application Serial No. 78598113 (now Registration No. 4147147) ... has no *res judicata*, collateral estoppel or *stare decisis* effect on this proceeding.'" Req. for recon. p.1. Applicant asserts that a final judgment on the merits was rendered in connection with Opposition No. 91174407 and particularly maintains that the Board did not give proper consideration to the preclusive effects of *stare decisis* with regard to that judgment in rendering its decision in this proceeding. Therefore, Applicant requests the Board to modify its decision and reverse the refusal to register.

A prior adjudication, including a decision of the Trademark Trial and Appeal Board, against an applicant may be dispositive of a later application for registration of the same mark on the basis of the same facts and issues, under the doctrines of *res judicata*, collateral estoppel, or *stare decisis*. *See generally* TMEP § 1217 and the authorities cited therein. As noted in our prior decision, and by way of background,

Applicant states that in Opposition No. 91174407 between it and Registrant (as Opposer) concerning application Serial No. 78598113 (now Registration No. 4147145) for the mark SEAcet,¹ “Registrant failed to file a [required] response and the opposition was dismissed with prejudice.” Br. p. 7. For the reasons explained below, we remain of the view that no preclusive effect attached to the prior opposition vis-à-vis this *ex parte* proceeding.

Revisiting first the applicability of *res judicata*, or claim preclusion, this doctrine protects against relitigation of a previously-adjudicated claim between the same parties or their privies based on the same cause of action. *In re Bose Corp.*, 476 F.3d 1331, 81 USPQ2d 1748 (Fed. Cir. 2007) (stating that application for registration of speaker design is barred by Federal Circuit’s 1985 decision affirming refusal of registration of the same mark for the same goods on the ground that the proposed mark was functional). A plaintiff is barred by *res judicata* from bringing a second action if: “(1) there is identity of parties (or their privies); (2) there has been an earlier final judgment on the merits of a claim; and (3) the second claim is based on the same set of transactional facts as the first.” *Levi Strauss & Co. v. Abercrombie & Fitch Trading Co.*, 719 F.3d 1367, 1372, 107 USPQ2d 1167, 1171 (Fed. Cir. 2013) (quoting *Jet, Inc. v. Sewage Aeration Sys.*, 223 F.3d 1360, 1362, 55 USPQ2d 1854, 1856 (Fed. Cir. 2000)). In this case, there is no identity of parties, because this is an

¹ The goods identified in that registration are “Skin care products containing ingredients from the Dead Sea, namely, facial cream, facial peeling milk, facial mud mask, non-medicated facial serum, eye gel, anti-wrinkle cream, mud soap, mineral soap, after shave, hand cream, salt facial scrub, body cream with salt, non-medicated foot cream and body lotion.”

ex parte matter and the cited registrant is not a party to this proceeding. Accordingly, the doctrine is not applicable. *Cf. In re Alfred Dunhill Ltd.*, 224 USPQ 501, 503 n.7 (TTAB 1984) (The Board noted, *inter alia*, that since the proceeding was an *ex parte* case, to which the cited registrant was not a party, the doctrine of *res judicata* does not apply.)²

We also find the related principal of collateral estoppel inapplicable. Collateral estoppel, or issue preclusion, applies where: "(1) a prior action presents an identical issue; (2) the prior action actually litigated and adjudged that issue; (3) the judgment in that prior action necessarily required determination of the identical issue; and (4) the prior action featured full representation of the estopped party." *Stephen Slesinger Inc. v. Disney Enter. Inc.*, 702 F3d 640, 644, 105 USPQ2d 1472, 1474 (Fed. Cir. 2012). *See also Levi Strauss & Co. v. Abercrombie & Fitch Trading Co.*, 107 USPQ2d at 1171. The prior proceeding did not present issues identical to those in this case. Although we recognize that slight differences in a mark or in an identification of goods or services will not avoid application of the doctrines of *res judicata* or collateral estoppel, *see In re Orion Research Inc.*, 669 F.2d 689, 205 USPQ 688 (CCPA. 1980); *Miller Brewing Co. v. Coy Int'l Corp.*, 230 USPQ 675

² Applicant has relied on the unpublished opinion issued in connection with Cancellation No. 92050739 styled *Orouba Agrifoods Processing Company v. United Food Import*. Although parties may cite to non-precedential cases, the Board does not encourage the practice. *Corporacion Habanos SA v. Rodriguez*, 99 USPQ2d 1873, 1875 n.5 (TTAB 2011). *See also In re Luxuria s.r.o.*, 100 USPQ2d 1146, 1151 n.7 (TTAB 2011) (parties may cite to non-precedential decisions, but they are not binding on the Board and because they have no precedential effect, the Board will generally not discuss them in other decisions). In any event, Applicant's reliance on that opinion is misplaced. While Applicant is correct that a default judgment can give rise to *res judicata*, unlike that proceeding and as just stated, there is no identity of parties in this matter.

(TTAB 1986), as we stated, albeit somewhat differently, in our prior decision, the stylization of Applicant's mark in the prior proceeding substantially differs from the stylization in this case. The mark in the application that was the subject of the prior opposition, SEAcRet, with its upper- and lower-case letters, creates a different overall commercial impression from the mark at issue here, i.e., SEACRET. Moreover in the prior opposition, no issues were actually litigated, judgment having been entered due to Opposer/Registrant's failure to file a final brief on the case.

Last, the doctrine of *stare decisis* provides that when a court has once laid down a principle of law as applicable to a certain set of facts, it will adhere to that principle and apply it to all future cases, where the facts are substantially the same, regardless of whether the parties and properties are the same. *In re Johanna Farms Inc.*, 8 USPQ2d 1408, 1410 (TTAB 1988). The doctrine does not apply here. First, the facts at issue in the two proceedings are not substantially the same because the marks sought to be registered are facially different. Further, the Board did not lay down a principle of law applicable to such facts in deciding Opposition No. 91174407. Rather, and contrary to Applicant's view of *stare decisis*, judgment was entered based upon the Board's adherence to established precedent regarding the effect of a procedural default by opposer.

For the foregoing reasons, and for the reasons given in our original opinion, we find that there is no preclusive effect of Opposition No. 91174407 on this proceeding, and adhere to our decision issued on December 3, 2014.

The request for reconsideration is denied.