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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Southeastern Dermatology, PA

Serial No. 86187997

Matthew H. Swyers of The Trademark Company,
for Southeastern Dermatology, PA

Giancarlo Castro, Trademark Examining Attorney, Law Office 110,
Chris A. F. Pedersen, Managing Attorney.

Before Zervas, Shaw and Hightower,
Administrative Trademark Judges.

Opinion by Hightower, Administrative Trademark Judge:

Southeastern Dermatology, PA ("Applicant") seeks registration on the Principal Register of the mark RESTORE LIFT, in standard characters and with "LIFT" disclaimed, for "Cosmetic and plastic surgery, namely, a minimally invasive face/neck lift done under local anesthesia" in International Class 44.[1]

The Trademark Examining Attorney has refused registration on the ground that the applied-for mark is merely descriptive of Applicant's services pursuant to

[1] Application Serial No. 86187997 was filed on February 7, 2014, based on Applicant's claim of first use anywhere and use in commerce since at least as early as 2010.

Trademark Act Section 2(e)(1), 15 U.S.C. § 1052(e)(1). The Examining Attorney also asserts that the Board's prior adjudication of Applicant's identical application is dispositive under the doctrine of res judicata, collateral estoppel, or stare decisis.

After the Examining Attorney made the refusal final, Applicant appealed. We find that this appeal is barred by claim preclusion and affirm the refusal to register.

Under the doctrine of claim preclusion, previously known as res judicata,[2] "'a judgment on the merits in a prior suit bars a second suit involving the same parties or their privies based on the same cause of action.'" *In re Bose Corp.*, 476 F.3d 1331, 81 USPQ2d 1748, 1752 (Fed. Cir. 2007) (quoting *Parklane Hosiery Co. v. Shore*, 439 U.S. 322, 326 (1979)).

Our primary reviewing court has warned that "[c]aution is warranted in the application of preclusion by the PTO, for the purposes of administrative trademark procedures include protecting both the consuming public and the purveyors." *Mayer/Berkshire Corp. v. Berkshire Fashions Inc.*, 424 F.3d 1229, 76 USPQ2d 1310, 1314 (Fed. Cir. 2005). We have, however, applied claim preclusion where an applicant had already been refused registration for the same mark and goods in a prior ex parte proceeding, and the applicant did not demonstrate a change of circumstances so as to justify not applying preclusion based on the prior judgment. *In re Anderson*, 101 USPQ2d 1912, 1916 (TTAB 2012); *see also In re Honeywell Inc.*, 8 USPQ2d 1600, 1601-02 (TTAB 1988) ("In general, there is nothing to preclude an applicant from attempting a second time in an ex parte proceeding to register a

[2] *Senju Pharm. Co. v. Apotex Inc.*, 746 F.3d 1344, 110 USPQ2d 1261, 1263 (Fed. Cir. 2014).

particular mark if conditions and circumstances have changed since the rendering of the adverse final decision in the first application.").

On July 8, 2013, we issued a final judgment on the merits affirming the refusal on the ground of mere descriptiveness of application Serial No. 85543229, which was filed by Applicant on February 15, 2012 for the identical mark and services involved here. Applicant makes no argument that any conditions or circumstances have changed since our previous decision. Indeed, although the Examining Attorney asserted the prior adjudication in both the initial and final Office actions, Applicant did not address it at all, either during examination or in its appeal brief.[3]

Considering the record in its entirety, we find that the prerequisites for claim preclusion have been satisfied. All questions of fact and law have been determined and no circumstances have changed since our previous ruling. Therefore, the doctrine of claim preclusion applies and precludes relitigation of the issue of descriptiveness under Section 2(e)(1) of RESTORE LIFT for Applicant's services.

Decision: The refusal to register Applicant's mark is affirmed.

[3] Applicant submitted identical arguments and evidence in support of both applications. *Compare* September 4, 2012 Response to Office Action, application Serial No. 85543229, *with* September 5, 2014 Response to Office Action, application Serial No. 86187997. Evidence attached to both responses was printed on September 4, 2012; only the dates the responses were signed differ. Applicant's appeal briefs also are substantially identical.