

**THIS OPINION IS NOT
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AS PRECEDENT OF
THE TTAB**

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
2900 Crystal Drive
Arlington, Virginia 22202-3513

Baxley

Mailed: November 20, 2003

Opposition No. 91122948

SPORTS MACHINE, INC. d/b/a
BIKE SOURCE

v.

MIDWEST MERCHANDISING, INC.

Before Bucher, Bottorff and Holtzman,
Administrative Trademark Judges.

By the Board:

Midwest Merchandising, Inc ("applicant") seeks to register BIKESOURCE in typed form ("the involved mark") for "retail store outlets featuring bicycles, bicycle accessories and replacement parts, and apparel relating to bicycling" in International Class 35.¹

Registration has been opposed by Sports Machine, Inc. d/b/a Bike Source ("opposer") on the ground that the involved mark is merely descriptive of applicant's services under Trademark Act Section 2(e)(1), 15 U.S.C. Section 1052(e)(1).

On November 14, 2001, the Board issued an order wherein it suspended proceedings herein pending final disposition of

¹ Application Serial No. 76035008, filed April 20, 2000, alleging March 15, 1991 as the date of first use and first use in commerce.

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Cancellation No. 92030578 ("the cancellation proceeding") between the parties. In the cancellation proceeding, opposer sought to cancel applicant's Registration No. 1887592 for the mark BIKESOURCE in the following stylized form

BIKESOURCE

also for "retail store outlets featuring bicycles, bicycle accessories and replacement parts, and apparel relating to bicycling" on the ground that such mark is merely descriptive of applicant's services under Trademark Act Section 2(e)(1), 15 U.S.C. Section 1052(e)(1).² On December 31, 2002, the Board issued a final decision on the merits in the cancellation proceeding wherein it denied opposer's petition to cancel. In particular, the Board found that BIKESOURCE in the stylized form set forth *supra* is "suggestive rather than merely descriptive" of applicant's services. *Sports Machine, Inc., d/b/a BikeSource v. Midwest Merchandising, Inc.* at 15 (TTAB, Cancellation No. 92030578, December 31, 2002).

This case now comes up for consideration of applicant's combined motion (filed March 12, 2003) to resume proceedings

² Registration No. 1887592, issued April 4, 1995 and reciting March 15, 1991 as the date of first use and date of first use in commerce.

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herein and to enter judgment against opposer on the affirmative defense of *res judicata*, i.e., claim preclusion. The motion has been fully briefed.³

In support of its motion, applicant contends that this proceeding should be resumed inasmuch as the Board issued a final decision wherein the Board denied opposer's petition to cancel in the cancellation proceeding and no appeal of that decision was filed; that this opposition proceeding involves the same issue as the cancellation proceeding; that the Board decided in the cancellation proceeding that the mark BIKESOURCE in the stylized form set forth *supra* is not merely descriptive under Trademark Act Section 2(e)(1), 15 U.S.C. Section 1052(e)(1); that, as part of its decision in the cancellation proceeding, the Board determined that BIKESOURCE, regardless of stylization, was not merely descriptive; and that, while the Board's decision in the cancellation proceeding involved the mark BIKESOURCE in stylized form, the analysis regarding whether BIKESOURCE in typed form is merely descriptive would produce the same result. Accordingly, applicant contends that opposer is

³ Applicant's reply brief is eleven pages in length. Inasmuch as it exceeds the ten-page limit for reply briefs on motions in Board *inter partes* proceedings, it has not been considered. See Trademark Rule 2.127(a); and *Saint-Gobain Corp. v. Minnesota Mining and Manufacturing Co.*, 66 USPQ2d 1220 (TTAB 2003). Further, Rule 2.127(a) expressly prohibits the filing of sur-reply briefs in connection with motions in Board *inter partes* proceedings. Accordingly, opposer's sur-reply brief and applicant's response thereto have received no consideration.

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precluded from pursuing a claim that BIKESOURCE is merely descriptive and, therefore, asks that judgment be entered in applicant's favor in the above-captioned proceeding. As exhibits in support of its motion, applicant included copies of the final decision in the cancellation proceeding, opposer's motion (filed July 9, 2001) to consolidate this proceeding and the cancellation proceeding, and the Board's November 14, 2001 order wherein it denied the motion to consolidate and suspended this proceeding pending final determination of the cancellation proceeding.

In response, opposer contends that it does not object to resumption of this proceeding. With regard to applicant's motion for judgment on the affirmative defense of *res judicata*, however, opposer contends that entry of judgment is premature because the Board's denial of its petition to cancel in the cancellation proceeding is not dispositive of this proceeding; and that the fact that the Board found in the cancellation proceeding that BIKESOURCE in the stylized form set forth *supra* was not merely descriptive does not necessarily mean that BIKESOURCE in typed form is not merely descriptive. Accordingly, opposer asks that the Board deny applicant's motion for judgment and resume proceedings herein. As an exhibit in support of its brief, opposer included a copy of its motion to consolidate this proceeding and the cancellation proceeding.

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Inasmuch as applicant's motion relies upon matters outside the pleadings, it is actually a motion for summary judgment, and will be treated accordingly. Cf. TBMP Sections 503.04 and 504.03.

We note initially that, inasmuch as the cancellation proceeding was not finally determined until shortly before applicant filed its motion for summary judgment, applicant could not allege as an affirmative defense of *res judicata* based on the Board's decision in the cancellation proceeding in its answer (filed July 11, 2001), and that applicant did not move for leave to amend its answer herein to allege such an affirmative defense after the final determination of the cancellation proceeding. A party may not obtain summary judgment on an issue that has not been pleaded. See Fed. R. Civ. P. 56(a) and 56(b); *S Industries Inc. v. Lamb-Weston Inc.*, 45 USPQ2d 1293, 1297 (TTAB 1997). However, inasmuch as the parties, in briefing applicant's motion, have addressed the issue of *res judicata* on its merits, and opposer did not object to the motion on the ground that it is based on an unpleaded issue, the Board hereby deems applicant's answer to have been amended, by agreement of the parties, to allege an affirmative defense of *res judicata*. See *Paramount Pictures Corp. v. White*, 31 USPQ2d 1768, 1772 (TTAB 1994); TBMP Section 528.07(a).

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The "[a]pplication of *res judicata* [claim preclusion] requires a prior final judgment on the merits by a court or other tribunal of competent jurisdiction; identity of the parties or those in privity with the parties; and a subsequent action based on the same claims that were raised, or could have been raised, in the prior action."

International Nutrition Co. v. Horphag Research Ltd., 220 F.3d 1325, 1328, 55 UPSQ2d 1492, 1494 (Fed. Cir. 2000).

After careful review of the record we find that the doctrine of *res judicata* is applicable in this proceeding. Opposer does not dispute that a final determination was reached in the cancellation proceeding, and that the same parties were involved in the cancellation proceeding. Thus, the remaining issue is whether this proceeding is based on the same claim as the cancellation proceeding.

In evaluating the similarity of the claims, the Board looks to whether the mark involved in this subsequent proceeding is the same mark, in terms of commercial impression, as the mark in Registration No. 1887592, the mark in the cancellation proceeding. See *Polaroid Corp. v. C & E Vision Services Inc.*, 52 USPQ2d 1954, 1957 (TTAB 1999). The involved mark consists of the word BIKESOURCE in typed form,⁴ while the mark in Registration No. 1887592

⁴ Because the involved mark is in typed form, it is not restricted to any specific form of presentation. See *In re Fisher Tool Co., Inc.*, 224 USPQ 796 (TTAB 1984).

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consists of BIKESOURCE in minimally stylized block capital letters and includes no additional elements, such as a design or border. As such, the involved mark and the mark in Registration No. 1887592 are considered to have the same commercial impression. See *Squirtco v. Tomy Corporation*, 697 F.2d 1038, 1041, 216 USPQ 937, 939 (Fed. Cir. 1983).

Further, the involved application and Registration No. 1887592 contain identical recitations of services. Thus, the evidence of descriptiveness would be identical. Accordingly, we conclude that the claim that opposer is asserting herein is identical to the one that it asserted unsuccessfully in the cancellation proceeding and that opposer is not entitled to relitigate that claim.

In view thereof, applicant's motion for summary judgment on the affirmative defense of *res judicata* is hereby granted.⁵ The opposition is dismissed with prejudice, and judgment in applicant's favor is hereby entered.

⁵ Accordingly, applicant's motion to resume proceedings is moot.