

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

Baxley

Mailed: May 13, 2004

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") applied 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.<sup>1</sup> Sports Machine, Inc. d/b/a Bike Source ("opposer") opposed registration thereof 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 Cancellation No. 92030578 ("the cancellation proceeding")

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<sup>1</sup> 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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between the parties.<sup>2</sup> In the cancellation proceeding, opposer sought to cancel applicant's Registration No. 1887592 for the mark BIKESOURCE in the following stylized form

**BIKESOURCE**

for identical services 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).<sup>3</sup> 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.<sup>4</sup>

On November 20, 2003, the Board issued a decision in the present proceeding wherein it granted applicant's motion (filed March 12, 2003) to enter judgment against opposer based on the doctrine of *res judicata*, i.e., claim preclusion, in view of the Board's decision in the

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<sup>2</sup> In the November 14, 2001 order, the Board also denied opposer's motion to consolidate this proceeding and the cancellation proceeding. Although the Board indicated that the proceedings at issue involved common issues of law and fact, the Board declined to consolidate the proceedings because they were in different procedural phases.

<sup>3</sup> 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.

<sup>4</sup> In particular, the Board found that BIKESOURCE in the stylized form at issue 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).

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cancellation proceeding. In that decision, the Board converted applicant's motion to one for summary judgment, deemed the pleadings amended by agreement of the parties to set forth an affirmative defense based on the doctrine of *res judicata*, and entered judgment against opposer on that basis.<sup>5</sup>

On December 19, 2003, opposer filed a request for reconsideration of that decision. Applicant filed a brief in opposition thereto.

In support of its request for reconsideration, opposer contends that, when the Board denied opposer's motion to consolidate the above-captioned opposition and the cancellation proceeding at issue, it presumed that the Board would separately adjudicate the issues in the respective proceedings; that, because the Board treated applicant's motion to enter judgment as one for summary judgment, the Board's decision to dismiss this case with prejudice goes beyond the relief requested by applicant; and that the Board, by dismissing this opposition, has denied opposer its right to pursue its Section 2(e)(1) claim herein.

In opposition to opposer's request for reconsideration, applicant contends that opposer's presumption that the respective proceedings would be adjudicated separately is

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<sup>5</sup> Applicant also requested resumption of proceedings herein. However, because the Board entered judgment in applicant's favor in the November 20, 2003 order, that request was deemed moot.

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without basis; that opposer has not been deprived of its right to pursue its claim because it already litigated that claim in the cancellation proceeding; that opposer's evidence in the cancellation proceeding dealt with the alleged descriptiveness of the mark BIKESOURCE and not with any stylization of that mark; that opposer admitted in its motion to consolidate the proceedings that the issues in the respective proceedings were the same; and that opposer's dissatisfaction with the Board's dismissal of its opposition and its apprehension regarding applicant's possible future actions do not warrant reconsideration of that dismissal. Accordingly, applicant asks that the Board deny opposer's request for reconsideration.

Motions for reconsideration, as provided in Trademark Rule 2.127(a), permit a party to point out any error the Board may have made in considering the matter initially. After reviewing the parties' arguments, we find that opposer has failed to persuade us that entry of judgment herein was in error.

The Board is puzzled as to the basis for opposer's presumption that the proceedings at issue would be adjudicated separately, particularly in view of the November 14, 2001 order, which stated that suspension of this case was appropriate to "avoid duplication of effort and inconsistent results." November 14, 2001 order at 3.

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Separate adjudication of this proceeding would clearly lead to repetition of effort by both the Board and the parties. Further, by seeking to relitigate that claim herein, opposer appears to seek inconsistent results.

However, in view of the fact that applicant sought entry of judgment under TBMP Section 510.02(b) against opposer based on the defense of *res judicata* in view of the final determination of the cancellation proceeding, opposer's motion for reconsideration is granted to the extent that we will deem applicant's motion as one for judgment pursuant to TBMP Section 510.02(b) on the ground that this opposition is barred by the doctrine of *res judicata*, and not as one for summary judgment under Fed. R. Civ. P. 56.<sup>6</sup>

Our primary reviewing court, the Court of Appeals for the Federal Circuit, has stated that it is guided by the analysis set forth in the Restatement (Second) of Judgments, Section 24 (1982) in determining whether a plaintiff's claim in a particular case is barred by the doctrine of *res judicata*. See *Chromalloy American Corp. v. Kenneth Gordon (New Orleans), Ltd.*, 222 USPQ 187, 189-90 (Fed. Cir. 1984).

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<sup>6</sup> We note, however, that parties commonly raise the doctrine of *res judicata* by way of a motion for summary judgment. See, e.g., *Metromedia Steakhouses Inc. v. Pondco II Inc.*, 28 USPQ2d 1205 (TTAB 1993).

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Section 24 of the Restatement describes the concept of a claim as follows:

(1) When a valid and final judgment rendered in an action extinguishes the plaintiff's claim pursuant to the rules of merger or bar ... the claim extinguished includes all rights of the plaintiff to remedies against the defendant with respect to all or any part of the transaction, or series of connected transactions, out of which the action arose.

(2) What factual grouping constitutes a "transaction", and what grouping constitutes a "series", are to be determined pragmatically, giving weight to such considerations as whether the facts are related in time, space, origin or motivation, whether they form a convenient trial unit, and whether their treatment as a unit conforms to the parties' expectations or business understanding or usage.

The Board, in applying the Restatement's analysis, has stated that such application "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." *Polaroid Corp. v. C & E Vision Services Inc.*, 52 USPQ2d 1954, 1957 (TTAB 1999).

Opposer has not disputed that a final determination on the merits was reached in the cancellation proceeding, and that the same parties were involved in the cancellation proceeding. However, opposer contends that the marks in the respective proceedings are not the same because the mark in

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this proceeding is in typed form, while the mark in the cancellation proceeding was stylized.

The Board disagrees. Applicant's typed mark as presented herein must be accorded "all reasonable manners in which it could be depicted," and is thus presumed to include the stylized form in which it appears in the registration that was involved in the cancellation proceeding. *INB National Bank v. Metrohost*, 22 USPQ2d 1585, 1588 (TTAB 1992); *In re Fisher Tool Co., Inc.*, 224 USPQ 796 (TTAB 1984). In view of the minimal stylization and lack of any additional elements of applicant's registered mark, such as a design or background, the marks at issue are legal equivalents in that the wording BIKESOURCE, whether represented in typed form or stylized lettering, creates the commercial impression of both marks. See *S & L Acquisition Co. v. Helene Arpels Inc.*, 9 USPQ2d 1221 (TTAB 1987). As such, the proceedings at issue are considered part of a single transaction or a series of transactions within the Restatement's concept of a claim.

Although the Board found in *Polaroid Corp. v. C & E Vision Services Inc.*, 52 USPQ2d 1954, 1957 (TTAB 1999) and *Metromedia Steakhouses Inc. v. Pondco II Inc.*, 28 USPQ2d 1205 (TTAB 1993), that defendants' marks in typed form were sufficiently different from their stylized presentations of those marks to render inapplicable the doctrine of *res*

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*judicata*, the stylizations at issue in those cases included additional significant design and/or background elements. However, no such additional elements are present in applicant's stylized presentation of its mark. The minimally stylized font in which applicant's registered mark is depicted does not add to or change the commercial impression of the typed form mark; the two are legal equivalents.

Further, given the legal equivalence of the two marks, the evidence of descriptiveness in the respective proceedings would be essentially identical, a fact which further supports the application of the doctrine of *res judicata*. See *Miller Brewing Company v. Coy International Corporation*, 230 USPQ 675 (TTAB 1986). Indeed, a review of the decision in the cancellation proceeding indicates that opposer's evidence in support of its Section 2(e)(1) claim therein pertained solely to the wording BIKESOURCE, and that the Board's analysis and decision likewise were based on the wording alone. It was not the stylization of the mark that served as the basis for the Board's finding that the mark is not merely descriptive, but rather the non-descriptiveness of the wording itself. For the foregoing reasons, opposer's opposition is barred by the doctrine of *res judicata*.



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In view thereof, opposer's motion for reconsideration is otherwise denied. The entry of judgment against opposer herein stands.