

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451

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Mailed: January 3, 2011

Opposition No. 91163697

Tonya S. Vaughan

v.

International Star Registry
of Illinois, Ltd.

**Before Zervas, Walsh and Cataldo, Administrative Trademark
Judges**

By the Board:

This matter comes up on applicant's motion for summary judgment (filed February 12, 2010) on the ground of *res judicata* based on the Board's decision in a prior consolidated Board proceeding between the parties.¹ The motion is fully briefed.

Background of the Prior Proceedings

As *res judicata* forms the basis of applicant's motion for summary judgment, we must necessarily review the circumstances and outcome of the prior consolidated Board proceeding.

¹ The prior Board proceeding is consolidated Opposition Nos. 91157178 (filed July 14, 2003) and 91158299 (filed October 20, 2003).

International Star Registry of Illinois, Ltd. ("ISR") instituted opposition proceedings against Tonya S. Vaughan ("Vaughan") for two applications incorporating the terms NAME A STAR, i.e., application Serial Nos. 76448314 and 76448315.² As grounds for the oppositions, ISR asserted that the phrase NAME A STAR is merely descriptive of Vaughan's goods and services, that the phrase has not acquired distinctiveness and that, alternatively, the phrase is a generic designation for the goods and services. The opposition proceedings were consolidated on January 29, 2004.

² Application Serial No. 76448314 for NAME A STAR in typed form on the Principal Register under Section 2(f) for "printed publications, namely, certificates of registration, charts, printed sheets and registers all identifying celestial stars as named by persons dedicating a celestial star as a personal gift, charts and printed sheets identifying celestial bodies, and essays regarding celestial bodies and astronomy" in International Class 16, and "novelty gift registry services, namely, registering celestial stars with names selected by customers and providing personalized certificates of registration as gifts" in International Class 35, filed on September 10, 2002 and claiming first use anywhere and in commerce on December 25, 1978.

Application Serial No. 76448315 for NAME A STAR and design on the Principal Register claiming Section 2(f) in part as to NAME A STAR for "Printed publications, namely, certificates of registration, charts, printed sheets and registers all identifying celestial stars as named by persons dedicating a celestial star as a personal gift, charts and printed sheets identifying celestial bodies, and essays regarding celestial bodies and astronomy" in International Class 16, and "novelty gift registry services, namely, registering celestial stars with names selected by customers and providing personalized certificates of registration" in International Class 35, filed on September 10, 2002, and claiming first use anywhere and in commerce on October 7, 1999 for the goods in Class 16 and October 7, 1999 for the services in Class 35.

On August 20, 2008, ISR filed a motion for summary judgment asserting that there are no genuine issues of material fact that NAME A STAR is generic or so highly descriptive that it could not acquire distinctiveness. On January 29, 2009, the Board issued its decision finding that NAME A STAR is a generic designation for Vaughan's goods and services, and further noted that even if Vaughan should prevail on any appeal that NAME A STAR is not generic, there is no genuine issue of material fact that NAME A STAR has not acquired distinctiveness as a mark in connection with said goods and services.

Background of Current Proceeding

On December 27, 2004, Vaughan filed a notice of opposition against ISR's application for INTERNATIONAL STAR REGISTRY NAME A STAR and design³ on the ground of priority and likelihood of confusion based on what Vaughan describes as "long-prior and protectable rights in her Name A Star

³ Application Serial No. 76415083 seeking registration on the Principal Register for "Prints and publications, namely, booklets, brochures, charts, and sheets identifying celestial bodies, pertaining to astronomy and for persons having an interest in astronomy and topics related thereto, and printed certificates and charts used to name a star with the customer's selected name, books and directories listing and cataloging the stars that have been named" in International Class 16, and "Mail order, telephone and on-line retail store services featuring printed publications, booklets, brochures, charts and sheets identifying celestial bodies and their locations and information pertaining to astronomy; mail order, telephone and on-line retail store services featuring printed certificates and charts used to name a star with the customer's selected name and books and directories listing and cataloging the stars that have been named" in International Class 35, filed June 6, 2002, with a date

trade name and her NAME A STAR mark" relating to "star-registration goods and services," specifically "registering dedication names selected by customers together with a specific star assigned to the dedication name, and providing personalized Certificates of Registration in a portfolio together with star charts and other printed material about the assigned star and about stars and celestial bodies, and compilations of star dedications in registers." *Notice of Opposition*, paras. 4, 5 and 16.

In an answer filed February 18, 2005, ISR denied the salient allegations of the complaint and pleaded genericness and mere descriptiveness/lack of secondary meaning as affirmative defenses.

ISR's Motion for Summary Judgment

Through its motion, ISR seeks summary judgment on the ground of *res judicata* based on the Board's decision in the consolidated proceeding. ISR argues that "[t]he only grounds for the instant opposition are Vaughan's asserted trademark rights in 'name a star' and the Opposition Petition raises no claim against other wording or design features of ISR's mark at issue," that "the issue of no assertable trademark rights held by Vaughan has already been resolved" and that Vaughan "is estopped and barred from relitigating its contention that it has protectable

of first use anywhere and in commerce of June 1999. Applicant

trademark rights in 'name a star' as a matter of law, since this factual issue and the legal claims of Vaughan were already litigated and decided against Vaughn [sic]."

Applicant International Star Registry of Illinois, Ltd.'s Motion for Summary Judgment on Grounds of Res Judicata ("Motion for Summary Judgment"), pp. 2-3.

In response, Vaughan argues that "the Board in that prior decision did not find that present Opposer 'has no assertable proprietary or trademarks rights' in her 'Name A Star' trademark, 'Name A Star' service mark and 'Name A Star' trade name" and that "the assertability of present Opposer's 'Name A Star' trademark/service marks [and] 'Name A Star' trade name against the registration of a mark which includes the 'name a star' words, with disclaimer, was not before the Board in the prior oppositions and not decided in the prior Decision. Trade names are not subject to federal registration and therefore there no [sic] possible construction of the Board's prior Decision that could expand that decision to encompass the assertability of present Opposer's 'Name A Star' trade name against registration of a mark which includes the 'name a star' words with disclaimer." *Opposer's Response in Opposition to Applicant's Motion for Summary Judgment on Grounds of Res Judicata ("Opposer's Response")*, pp. 2-3. Vaughan further

has disclaimed NAME A STAR.

argues that ISR "apparently intends to seek a post-publication amendment of the application underlying this opposition to remove that disclaimer [and therefore the] disposition of the present Opposition against the registration of a mark which includes the 'name a star' words with disclaimer, even if favorable to Applicant, will have no preclusive effect on an opposition if and when the underlying application is republished for opposition in a form without the disclaimer." *Opposer's Response*, p. 3.

In rebuttal, ISR points out that "[i]t is the established law that '[a] user cannot acquire rights in a generic designation as a trademark, [sic] trade name, collective mark, or certification mark' (citing Restatement of the Law, Third, Unfair Competition § 15(a)) and that the addition of "a common company or corporation entity designator to generic wording cannot make the designation capable of identifying a source and distinguishing it from others." *Applicant, International Star Registry of Illinois, Ltd.'s Reply Brief for Summary Judgment* ("Reply Brief"), p. 6.

Decision

Summary judgment is an appropriate method of disposing of cases in which there are no genuine issues of material fact in dispute and the moving party is entitled to judgment as a matter of law. See Fed. R. Civ. P. 56(c). The party

moving for summary judgment bears the initial burden of demonstrating the absence of any genuine issue of material fact and that it is entitled to judgment as a matter of law. *See Celotex Corp. v. Catrett*, 477 U.S. 317 (1986). A factual dispute is genuine if, on the evidence of record, a reasonable fact finder could resolve the matter in favor of the non-moving party. *See Opryland USA Inc. v. Great American Music Show Inc.*, 970 F.2d 847, 23 USPQ2d 1471, 1472 (Fed. Cir. 1992); and *Olde Tyme Foods, Inc. v. Roundy's, Inc.*, 961 F.2d 200, 22 USPQ2d 1542, 1544 (Fed. Cir. 1992).

The evidence must be viewed, however, in a light most favorable to the non-moving party, and all reasonable inferences are to be drawn in the non-movant's favor. *Lloyd's Food Products, Inc. v. Eli's, Inc.*, 987 F.2d 766, 25 USPQ2d 2027, 2029 (Fed. Cir. 1993); *Opryland USA, supra*. The Board may not resolve issues of material fact; it may only ascertain whether issues of material fact exist. *See Lloyd's Food Products*, 987 F.2d at 766, 25 USPQ2d at 2029; and *Olde Tyme Foods*, 961 F.2d at 200, 22 USPQ2d at 1542.

In its motion for summary judgment, ISR asserts *res judicata* and thereby seeks a dismissal of the opposition based on the Board's decision in a related consolidated proceeding between the parties. Although ISR asserts both claim preclusion and issue preclusion, we do not find claim preclusion appropriate here as the transactional facts

giving rise to ISR's claims of genericness, mere descriptiveness and lack of secondary meaning against the marks in Vaughan's now-abandoned applications are not the same as the transactional facts upon which Vaughan bases her claim of likelihood of confusion in this proceeding.⁴ See, e.g., *Domino's Pizza Inc. v. Little Caesar Enterprises Inc.*, 7 USPQ2d 1359 (TTAB 1988) (no claim preclusion in opposition asserting mere descriptiveness based on civil action where applicant, as the plaintiff in the civil action, charged opposer with infringement and mere descriptiveness was raised as a defense). Not only are the claims different but Vaughan's trademark applications are not at issue in this proceeding.

However, that is not to say that the doctrine of issue preclusion is also inapplicable to this proceeding. Issue preclusion (also known as collateral estoppel) serves to preclude in a subsequent proceeding the relitigation of issues litigated in a prior proceeding between the parties (or their privies), notwithstanding the fact that the claims in the two proceedings may differ. See *Jet, Inc. v. Sewage Aeration Systems*, 223 F.3d 1360, 1365-66, 55 USPQ2d 1854,

⁴ A subsequent action is barred by claim preclusion 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. *Jet, Inc. v. Sewage Aeration Systems*, 223 F.3d 1360, 1362, 55 USPQ2d 1854, 1856 (Fed. Cir. 2000).

1858-59 (Fed. Cir. 2000). Issue preclusion requires: 1) identity of an issue in a prior proceeding; 2) that the identical issue was actually litigated; 3) that determination of the issue was necessary to the judgment in the prior proceedings; and 4) the party defending against preclusion had a full and fair opportunity to litigate the issue in the prior proceeding. *Id.*

The issues of genericness and secondary meaning in the designation NAME A STAR as it relates to star-registration services and goods relating thereto were actually litigated in the prior consolidated proceeding. Furthermore, the determination of the issues of genericness and secondary meaning were necessary to the summary judgment in the earlier consolidated proceeding. Finally, Vaughan, as applicant in the prior proceeding, was afforded a full and fair opportunity to litigate those issues therein. Thus, we focus the following discussion on whether there is an identity of issue between the proceedings.

Arguing against the application of any form of preclusion, Vaughan claims that "the assertability of [her] 'Name A Star' trademark/service marks [and] *trade name* against the registration of a mark which includes the 'name a star' words, with disclaimer, was not before the Board in the prior oppositions and not decided in the prior Decision" and further argues that "[t]rade names are not subject to

federal registration and therefore there [is] no possible construction of the Board's prior Decision that could expand that decision to encompass the assertability of [Vaughan's] trade name against registration of a mark which includes the 'name a star' words with disclaimer." *Opposer's Response*, p. 3 (emphasis in original). We disagree.

Because Vaughan has opposed ISR's application under Section 2(d) of the Trademark Act based on her "use of 'Name a Star' as a trademark and service mark for her goods and services, and as a trade name for her Name A Star business through which those goods and services were sold," Vaughan must first establish that she has a proprietary right in NAME A STAR. *See Fluid Energy Processing & Equipment Company v. Fluid Energy, Inc.*, 212 USPQ 28, 35 (TTAB 1981) ("absent the existence of a registration and the presumptions attendant thereto under Section 7(b), a party claiming to be aggrieved under Section 2(d) cannot prevail where he has not proved a prior and a proprietary right in the term or designation on which [he] relies"). In order to do so, Vaughan must establish that NAME A STAR in relation to her star-registration goods and services is neither generic nor merely descriptive without secondary meaning. This is the very issue that was litigated and adjudged in the prior consolidated proceeding. Accordingly, there is

identity of issues and we find that Vaughan is estopped from relitigating this issue in this proceeding.

While Vaughan makes much of the distinction between her use of NAME A STAR as a trademark/service mark and use thereof as a trade name, it is a distinction without a difference. Like trademarks and service marks, "trade names or portions thereof could be categorized in the four accepted categories of generic, descriptive, suggestive, and arbitrary or fanciful [and even though] a party may acquire common law or statutory rights in a descriptive term if it has acquired a secondary meaning signifying a single source, a generic term cannot be exclusively appropriated as a common law trademark or as a statutory trademark, regardless of its length of use and promotion." *Fluid Energy Processing & Equipment Company v. Fluid Energy, Inc.*, supra at 36. Therefore, in view of the finding in the previous consolidated proceeding that NAME A STAR is a generic designation for Vaughan's star-registration goods and services and since Vaughan is claiming in her complaint trade name rights for the same goods and services as were the subject of her prior applications, there is no genuine issue of material fact concerning Vaughan's lack of a proprietary right to NAME A STAR either as a mark or as a trade name for her goods and services.

Since Vaughan cannot establish any legal basis for her claim of damage or demonstrate any likelihood of confusion as to source, summary judgment is hereby **GRANTED** in favor of ISR and the opposition is **DISMISSED with prejudice**.⁵

* * *

⁵ We note that the issue of Vaughan's standing was not argued but had we reached the question of standing, we would find that there was none since, as a matter of law, Vaughan would be unable to prove such in this proceeding. See *Kelly Services Inc. v. Greene's Temporaries Inc.*, 25 USPQ2d 1460 (TTAB 1992) (plaintiff must plead and ultimately prove its standing).