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

Baxley

Mailed: September 19, 2008

Opposition No. **91178747**

Mine Design a d.b.a. of Amal
Flores

v.

Votivo, Ltd. and Votivo, LLC

Before Holtzman, Cataldo, and Ritchie de Larena,
Administrative Trademark Judges

By the Board:

Votivo, LLC, successor in interest to Votivo, Ltd.,
(collectively "applicant") seeks to register the mark
MANDARINE in standard character form for "bath salts and
hand lotion" in International Class 3.¹

¹ Application Serial No. 76613881, filed September 30, 2004 by Votivo, Ltd. ("Ltd."), based on an assertion of a bona fide intent to use the mark in commerce under Trademark Act Section 1(b), 15 U.S.C. Section 1051(b). The application includes a statement that the English translation of the French word "MANDARINE" is "MANDARIN" and a claim of acquired distinctiveness under Trademark Act Section 2(f), 15 U.S.C. Section 1052(f), based on its ownership of Registration No. 2728815 on the Principal Register for the same mark for related goods, namely, "skin soap, scented body spray, scented room spray, and incense," which was issued on June 24, 2003. During *ex parte* examination, Ltd. filed an amendment to allege use wherein it alleged January 7, 2005 as the date of first use anywhere and the date of first use in commerce. The application was published for opposition on June 5, 2007, and opposer filed his notice of opposition on August 3, 2007.

Mine Design a d.b.a. of Amal Flores ("opposer"), an individual, opposes registration of applicant's mark on grounds that the mark is "de jure functional" under Trademark Act Section 2(e)(5), 15 U.S.C. Section 1052(e)(5), and that it is generic for applicant's goods. In the answer thereto, applicant denied the salient allegations of the notice of opposition.² In addition, applicant asserted the following affirmative defenses: (1) that the notice of opposition "fails to state a claim upon which relief can be granted, and in particular, fails to state legally sufficient grounds for sustaining the opposition;"³ and (2) the opposition is subject to the doctrines of "res judicata and claim preclusion" because the involved mark was previously registered in Registration No. 2728815.

As an initial matter, with regard to the proposed functionality claim, we note that the mark at issue in this case consists entirely of wording in standard characters and that only utilitarian product features can be refused

² Ltd., the record owner of the involved application when this proceeding commenced, filed the answer in this proceeding on September 12, 2007. The involved application was assigned, along with Registration No. 2728815, to applicant in a document that was executed on September 28, 2007 and was recorded with the USPTO's Assignment Branch on October 31, 2007 at Reel 3650, Frame 0419. Applicant was joined as a party defendant in this case in a February 7, 2008 Board order.

³ We note, however, that the only context in which the Board will consider the sufficiency of opposer's pleading is a motion to dismiss under Fed. R. Civ. P. 12(b)(6). Otherwise, such "affirmative defense" will be given on consideration.

registration on the ground that they are, as a whole, functional, under Trademark Act Section 2(e)(5), 15 U.S.C. Section 1052(e)(5). See TMEP Section 1202.02(a) (5th ed. 2007). Accordingly, the proposed claim that the mark is *de jure* functional is unavailable in this case, and paragraphs 29-32 of the notice of opposition are hereby stricken.

This case now comes up for consideration of: (1) opposer's motion (filed February 6, 2008) for summary judgment on his pleaded claim of genericness; and (2) applicant's cross-motion (filed March 12, 2008) for summary judgment on the grounds that opposer lacks standing to oppose registration of applicant's mark because opposer has been "permanently enjoined" from using the involved mark and because the opposition is barred by the doctrine of *res judicata* or claim preclusion and/or the doctrine of collateral estoppel or issue preclusion. The motions have been fully briefed.

Inasmuch as applicant's cross-motion for summary judgment is based on opposer's alleged lack of standing to pursue this opposition, we will consider the cross-motion first. We note initially that Ltd. did not set forth in its answer the affirmative defenses upon which it relies as bases for that cross-motion. We further note that opposer has objected to applicant's cross-motion on that basis and that applicant did not subsequently seek leave of the Board

to amend its answer to add such affirmative defenses.⁴ Accordingly, notwithstanding that opposer responded on the merits to the cross-motion for summary judgment, these unpleaded affirmative defenses may not serve as bases for summary judgment. See *Greenhouse Systems Inc. v. Carson*, 37 USPQ2d 1748, 1750 n.5 (TTAB 1995).

In any event, the record indicates that the parties were involved in two earlier civil actions: (1) Case No. CV 03-6017-DT, styled *Votivo, Ltd. v. Mine Design*, filed in 2003 in the United States District Court for the Central District of California; and (2) Case No. CV 05-2942-DT, *Votivo, Ltd. v. Amal Flores d/b/a Mine Design*, filed in 2005 in the United States District Court for the Central District of California. Because neither civil action was actually litigated, the doctrine of collateral estoppel or issue preclusion does not apply. See *Polaroid Corp. v. C & E Vision Services Inc.*, 52 USPQ2d 1954 (TTAB 1999).

We will next consider whether opposer's standing is barred under the doctrine of *res judicata* or claim preclusion. While the second civil action was in the

⁴ Opposer's contention that *Votivo, LLC* is in default because it did not file its own answer following its joinder as a party defendant herein is incorrect. As the assignee of the involved application, applicant stands in the shoes of assignor *Ltd.*, which timely files an answer. See *CBS Inc. v. Man's Day Publishing Company, Inc.*, 205 USPQ 470 (TTAB 1980). Accordingly, *Ltd.*'s answer serves as applicant's responsive pleading. The Board notes in addition that, in the February 7, 2008 order in which *Votivo, LLC* was joined as a party defendant, the Board did

discovery period and opposer's appeal of the district court's entry of default judgment and permanent injunction against him to the United States Court of Appeals for the Ninth Circuit was pending in the first civil action,⁵ the parties entered into a settlement agreement. Under the terms of that agreement, the parties agreed to "dismiss their claims against [each] other" and that opposer would not use the MANDARINE mark so long as that mark remains registered. Settlement agreement at paragraphs 1 and 3. The parties filed a stipulation with the district court to dismiss "all claims and counterclaims" in the second civil action "with prejudice." However, the stipulation that the parties filed with the court of appeals in the first civil action sought dismissal of the appeal only and does not expressly asks that all claims in that case be dismissed.

In view of the discrepancy between the actions that the parties appear to have agreed to take in the settlement agreement with regard to their district court litigation and the action that the parties took by way of the stipulation to dismiss the first civil action that they filed with the court of appeals, we find that there are genuine issues of

not set time for Votivo, LLC to file an answer because a new answer was unnecessary.

⁵ The permanent injunction, in relevant part, "permanently enjoined and restrained [opposer] from" using the involved MANDARINE mark "or any term ... that is confusingly or substantially similar" thereto on "any ... scented products for

material fact regarding whether, under the doctrine of *res judicata* or claim preclusion, opposer lacks standing to pursue this opposition. In particular, there are genuine issues of material fact as to whether the settlement agreement is effective to dismiss the claims in the first civil action; and, if it is not, as to the effect of that agreement on the earlier permanent injunction. In view thereof, applicant's cross-motion for summary judgment is denied.

We will next consider opposer's motion for summary judgment on the ground of genericness. With regard to opposer's standing to maintain this proceeding, we find that opposer has failed to meet his burden of showing that there is no genuine issue of material fact that he has a present or prospective right to use the term MANDARINE or its asserted equivalent "mandarin" descriptively or generically in his business. See *Binney & Smith Inc. v. Magic Marker Industries, Inc.*, 222 USPQ 1003 (TTAB 1984). Moreover, as to the merits, we find that opposer has failed to meet his burden of showing that there is no genuine issue of material fact that the involved MANDARINE mark or its asserted equivalent "mandarin" is understood by the relevant public

household or personal care use." Permanent injunction at paragraph 1(d).

primarily to refer to "bath salts and hand lotion."⁶ See *H. Marvin Ginn Corp. v. International Association of Fire Chiefs, Inc.*, 782 F.2d 987, 228 USPQ 528, 530 (Fed. Cir. 1986). In view thereof, opposer's motion for summary judgment is denied.⁷

Proceedings herein are resumed. Discovery and testimony periods are reset as follows.

DISCOVERY PERIOD TO CLOSE:	October 10, 2008
Plaintiff's 30-day testimony period to close:	January 8, 2009
Defendant's 30-day testimony period to close:	March 9, 2009
Plaintiff's 15-day rebuttal testimony period to close:	April 23, 2009

In each instance, a copy of the transcript of testimony together with copies of documentary exhibits, must be served on the adverse party within thirty days after completion of the taking of testimony. Trademark Rule 2.125.

⁶ Applicant asserts in its brief in opposition to the motion for summary judgment and in support of its cross-motion for summary judgment that its involved mark is "suggestive" and "inherently distinctive." However, by seeking registration of the involved mark under Trademark Act Section 2(f), 15 U.S.C. Section 1052(f), applicant has conceded the mark's lack of inherent distinctiveness. See *Yamaha Int'l Corp. v. Hoshino Gakki Co., Ltd.*, 840 F.2d 1572, 6 USPQ2d 1001 (Fed. Cir. 1988).

⁷ The fact that we have identified only a few genuine issues of material fact as sufficient bases for denying the motions for summary judgment should not be construed as a finding that these are necessarily the only issues which remain for trial.

The parties should note that the evidence submitted in connection with their motions for summary judgment is of record only for consideration of those motions. To be considered at final hearing, any such evidence must be properly introduced in evidence during the appropriate trial period. See *Levi Strauss &*

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Briefs shall be filed in accordance with Trademark Rule 2.128(a) and (b). An oral hearing will be set only upon request filed as provided by Trademark Rule 2.129.

Co. v. R. Josephs Sportswear Inc., 28 USPQ2d 1464 (TTAB 1993);
Pet Inc. v. Bassetti, 219 USPQ 911 (TTAB 1983).