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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91196926
Party	Plaintiff GMA Accessories, Inc.
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

-----X
GMA ACCESSORIES, INC.,

Opposer,

Opposition No. 91196926

against –

**BRIEF IN SUPPORT OF
RECONSIDERATION**

DORFMAN-PACIFIC CO.,

Applicant.
-----X

Mark: CAPPELLI STRAWORLD
Serial No.: 77-965, 616
Class (es): 18, 25

BACKGROUND

1. On February 2, 2011, Opposer filed a motion for summary judgment.
2. Opposer alleged in this motion that the prior order in the action *GMA Accessories, Inc. v. Cappelli Strawworld, Inc.*, Cancellation No. 92044972 (hereinafter “2005 Proceeding”), which resulted in the cancellation of the mark CAPPELLI, precluded Dorfman-Pacific Co. (Cappelli Strawworld's successor) from registering the mark CAPPELLI STRAWORLD in the instant matter.
3. On April 4, 2011, the Trademark Trial and Appeal Board (the “Board”) denied GMA’s motion. In its decision, the Board correctly cited the standard for *res judicata*. The Board reiterated that for claim preclusion based on a judgment in which the claim was not litigated, “there must be (1) an identity of the parties or their privies, (2) a final judgment on the merits of the prior claim, and (3) the second claim must be based on the same transactional facts as the first and should have been litigated in the prior case.” See *April 4, 2011 Decision*.

4. The Board incorrectly concluded that “because Opposer did not specify any particular goods or services for which it alleged prior use of CAPELLI in the 2005 Proceeding, there is a genuine dispute of material fact with respect to whether this proceeding is based on the same set of transactional facts as the 2005 Proceeding.” *Id.*

ARGUMENT

5. A request for reconsideration under *Trademark Rule 2.127(b)* provides an opportunity for a party to point out any error the Board may have made in considering the matter initially. The motion should be limited to a demonstration that based on the facts before it and the applicable law, the Board’s ruling is in error and requires appropriate change. *The Delta Western Group, LLC v. Ruth’s Chris Streak House*, 2006 WL 2558858 (TTAB 2006) (citing *TBMP* § 543). In *Delta*, the Board denied respondent’s request for reconsideration as it found that the respondent reiterated its arguments it previously made in its filings. Here, Opposer points out that the Board has made an error in its determination whether the present proceeding is based on the same set of transactional facts as the 2005 Proceeding, and this is a permissible use of a motion for reconsideration. See *Maui Visitors Bureau v. Richard L. Lowe & Cherie Lee Moreland*, 2003 WL 23002737 (TTAB 2003) (granting opposer’s motion for reconsideration); *Arden Savoy Partners LLC v. The Savoy Hotel Limited*, 2003 WL 21653640 (TTAB 2003) (same).

6. The test used for the purpose of determining whether or not the prior order is *res judicata* in a later suit is “whether the evidence necessary to prove one cause of action would establish the other.” *Jet, Inc. v. Sweage Aeration Systems*, 223 F.3d 1360, 1363 (Fed. Cir. 2000) (citing *Kratville v. Runyon*, 90 F.3d 195, 197-98 (7th Cir. 1996)).

7. In *Jet, Inc.*, the court applied this test and concluded that a finding in an opposition proceeding is not *res judicata* in a cancellation proceeding because a cancellation proceeding had a different standard of proof, indeed a higher standard of proof. *Jet, Inc.*, at 1364-65

8. The present proceeding is based on the same set of transactional facts as the 2005 Proceeding because the proofs that governed cancellation of the mark in the first proceeding are the equivalent to the proofs needed here. *Id.* Applying the *Jet, Inc.* test here results in a finding of *res judicata*.

9. The statute in the 2005 Proceeding which governed the cancellation of the CAPPELLI mark on the supplemental register states, "Whenever any person believes that such person is or will be damaged by the registration of a mark on the supplemental register...which would be likely to cause dilution by blurring...such person may apply to the Director to cancel such registration." *15 U.S.C. 1092*.

10. The statute which governs the opposition to the registration of a mark in the instant matter states, "Any person who believes that he would be damaged by the registration of a mark upon the principal register, including the registration of any mark which would be likely to cause dilution by blurring...may file an opposition in the Patent and Trademark Office..." *15 U.S.C. 1063*.

11. Since these statutes are substantially identical, the proofs necessary to prove one cause of action must satisfy the other. The question is not whether plaintiff's proofs would have been adequate in the first proceeding. The question is whether the evidence needed to support a cause of action would support the other. *Jet, Inc., supra* at 1363.

12. The Board went on to say that “genuine disputes exist as to whether CAPPELLI STRAWORLD, at issue in this proceeding; is the same mark, in terms of commercial impression, as the mark CAPPELLI, which was at issue in the 2005 Proceeding.” *Decision* at 7.

13. This was erroneous because it is well-settled that adding another word or name to a single word mark is not sufficient to overcome a likelihood of confusion between two separate marks under Section (d) of the Lanham Act. See e.g. *Coca Cola Bottling Co. v. Joseph E. Eagram & Sons, Inc.*, 526 F.2d 556, 188 USPQ 105 (C.C.P.A 1975) (“BENGAL” and “BENGAL LANCER”); *Lilly Pulitzer, Inc. v. Lilli Ann Corp.*, 376 F.2d 324, 153 USPQ 406 (C.C.P.A 1967)(“THE LILY” and “LILY ANN”); *In re El Torito Restaurants Inc.*, 9 USPQ2d 2002 (TTAB 1988) (“MACHO” and “MACHO COMBOS”); *In re United States Shoe Corp.*, 229 USPQ 707 (TTAB 1985) (“CAREER IMAGE” and “CREST CAREER IMAGES”); *In re Corning Glass Works*, 229 USPQ 65 (TTAB 1985) (“CONFIRM” and “CONFIRMCELLS”); *In re Riddle*, 225 USPQ 630 (TTAB 1985) (“ACCUTUNE” and “RICHARD PETTY’s ACCU TUNE”); *In re Cosvetic Laboratories, Inc.*, 202 USPQ 842 (TTAB 1979) (“HEAD START” and “HEAD START COSVETIC”). TMEP Section 1207.01(b)(iii). *In re Denisis*, 225 U.S.P.Q. 624 (TTAB 1985); *CFM Majestic, Inc. v. NHC, Inc.*, 93 F.Supp.2d 942 (N.D. Ind. 2000); *Trident Seafoods Corp. v. Triton Fisheries, LLC.*, 2000 WL 33675750 at *6 (D. Alaska June 30, 2000); *Physicians Formula Cosmetic, Inc v West Cabot Cosmetics* 857 F.2d 80, 82 (2d Cir. 1988); *Wynn Oil Company v. Thomas*, 239 F.2d 1183 (6th Cir. 1988); 3 McCarthy on Trademarks §§ 23:55-23:56 at 23-164 through 23-169.

14. In determining whether a mark would be likely to cause confusion, courts will consider whether the marks themselves are similar in appearance, sound, connotation and commercial impression. *In re. E.I. Dupont de Nemurs & Co.*, 476 F.2d 1357 (CCPA 1973).

15. The mark at issue in the 2005 Proceeding (“CAPPELLI”) and the mark at issue in the current opposition proceeding (“CAPPELLI STRAWORLD”) are not sufficiently different so as to avoid the application of *res judicata*. See *Miller Brewing Co. v. Coy International Corp.*, 230 USPQ 675, 678 (TTAB 1986) (stating that the Board “does not wish to encourage losing parties to insignificantly modify their marks after an adverse ruling and thereby avoid the *res judicata* effect of a prior adjudication.”)

16. Wherefore, it is respectfully requested that the Board reconsider and grant Opposer’s motion for summary judgment.

Dated: New York, NY
April 18, 2011

Respectfully submitted,
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Mark: CAPPELLI
STRAWORLD
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CERTIFICATE OF SERVICE

I, Jeffrey I. Scott , hereby certify that this paper (Brief in Support of Reconsideration) is being deposited with the United States Postal Service on April 18, 2011, postage pre-paid, addressed to the following:

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