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

Proceeding	91201830
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
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THE CORPS GROUP, Opposer, v. AFTERBURNER, INC. Applicant.	In re Application Serial No. 85/094,889 Mark: Pilot Flight Suit Design  Published: August 30, 2011 Opposition No. 91201830

REPLY IN SUPPORT OF OPPOSER THE CORPS GROUP'S MOTION FOR SUMMARY JUDGMENT

Notwithstanding Afterburner's efforts to obfuscate the issue, the issue of whether collateral estoppel precludes Afterburner from arguing here that its flight suit design is a protectable service mark is straightforward. The Georgia court held that the flight suit is "generic" and "is not a service mark" and granted a motion for directed verdict on Afterburner's claim for infringement of the flight suit. The only possible interpretation of the court's holding is that the flight suit is not protectable. Therefore, as discussed in The Corps Group's opening brief and below, Afterburner is collaterally estopped from arguing that the identical flight suit design is protectable and the Board should refuse to register the flight suit design.

I. The Georgia Court Decided the Identical Issue.

Afterburner does not dispute that the Georgia court held that the flight suit design "is not a service mark." Afterburner also does not dispute that it has applied to register the flight suit the same flight suit design as a service mark. Yet, Afterburner incomprehensibly argues that there is no "identity of issues" here because, even though the Georgia court held the flight suit

design was not a service mark, the Georgia court did not specifically decide whether the flight suit design is capable of distinguishing Afterburner's services or whether the mark had acquired distinctiveness. However, the distinction Afterburner attempts to draw between whether a mark is a service mark and whether the mark is capable of distinguishing the applicant's services is a false distinction. Tellingly, Afterburner cites no authority for the proposition that there is any such distinction.

One criterion for federal registration of a service mark is that the mark must have become distinctive of the applicant's goods in commerce. 15. U.S.C. § 1052(f). The Lanham Act defines a trademark as any "word, name, symbol, or device…used by a manufacturer or merchant to identify his goods and distinguish them from those manufactured or sold by others." 15. U.S.C. § 1127. Thus, one basis for determining that a mark is not a protectable service mark is that it does not or is not capable or distinguishing the applicant's services from the services of others. In the Georgia litigation, The Corps Group explicitly argued that the flight suit design did not distinguish Afterburner's services and had not acquired distinctiveness and it moved for a directed verdict with respect to the claim for infringement of the flight suit design on precisely that basis. Borneman Decl., Ex. A-4 at 951:14-18; 952:8-13. The parties each presented evidence regarding whether prospective customers associated the flight suit exclusively with Afterburner, including evidence regarding third parties who wore flight suits while making presentations. Borneman Decl., Ex. A-5 at 1539:13-154:8. After hearing these arguments and considering this evidence, the Georgia court held that the flight suit design "is not a service mark" and granted a directed verdict with respect to Afterburner's claim for infringement of the flight suit design. *Id.* at 1541:14-24.

In *International Order of Job's Daughters v. Lindeburg & Co.*, 727 F.2d 1087, 1089 (Fed. Cir. 1984), the Federal Circuit affirmed the Board's application of collateral estoppel and cancellation of registrations based on the Ninth Circuit's determination that the purported marks were "not trademarks". After the Ninth Circuit held that the purported trademarks were "functional aesthetic components of the product, not trademarks," the defendant filed a petition with the USPTO requesting cancellation of a registration for one mark because it was "not capable of functioning as a trademark." *Id.* The court affirmed the Board's finding that the determination that the marks were "not trademarks" precluded any argument by the registrant that its mark was capable of functioning as a trademark. *Id.* at 1091. Similarly, the Georgia court's holding that the flight suit design was "not a service mark" is the equivalent of a finding that the design is not capable of functioning as a trademark.

II. The Georgia Court Was Not Required to Issue Particularized Findings Supporting Its Holding that the Mark Was Not Protectable.

Afterburner's argument that collateral estoppel does not apply because the Georgia court did not issue particularized findings is unfounded. There is no requirement for the court to issue particularized findings. The only requirements are that the issues be identical, the issue must have been actually litigated, the determination of the issues must have been necessary to the judgment, and the party had a full and fair opportunity to litigate the issue. *See Jet, Inc. v. Sewage Aeration Sys., 223 F.3d 1360, 1365-66 (Fed. Cir. 2000); Larami Corp. v. Talk To Me Programs Inc.*, 36 U.S.P.Q.2d 1840, 1843-44 (TTAB 1995). As detailed in The Corps Group's opening brief and herein, each of those requirements is satisfied here.

To the extent that Afterburner opines that the judge may have been confused or made a mistake when he held that the flight suit design was not a service mark, Afterburner had an opportunity to seek reconsideration of and appeal that ruling. Although The Corps Group

appealed other aspects of the court's rulings, Afterburner never raised any issue relating to the specific determination by the court that the flight suit design was not protectable as a service mark on appeal. Afterburner had a full and complete opportunity to litigate this issue and should not be given a second bite at the apple in this proceeding.

The Georgia court's ruling that the flight suit design was not a service mark precludes Afterburner from relitigating the same issue here. Afterburner's suggestion that the court's statement that the flight suit design was "not a service mark" could have meant that the flight suit design was not a service mark but instead was a registrable trade dress, Opposition at 10, is nonsensical. After holding that the flight suit "is not a service mark," the court granted a directed verdict in favor of defendants that there was no infringement of the flight suit. If the judge's statement had meant that the flight suit was a registrable trade dress, he would not have granted a directed verdict in favor of defendants on the issue.

III. Conclusion

Because the only reasonable interpretation of the Georgia court's holding that the flight suit design is "not a service mark" is that the proposed mark is not protectable as a trademark, collateral estoppel applies here. The Board should therefore refuse registration of Applicant's mark.

Dated: May 22, 2017

Respectfully submitted,

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CERTIFICATE OF SERVICE

I hereby certify that a copy of the foregoing Reply in Support of Motion for Summary Judgment has been sent via email and first class mail, postage pre-paid, this 22nd day of May, 2017 to:

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