THIS ORDER IS A PRECEDENT OF THE TTAB

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
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GMM

Mailed: August 1, 2017

Opposition No. 91201830

The Corps Group

v.

Afterburner, Inc.

Before Bergsman, Gorowitz, and Hightower,
Administrative Trademark Judges.

By the Board:

This proceeding comes before the Board for consideration of Opposer's April 7, 2017, fully-briefed motion for summary judgment under issue preclusion principles, and Applicant's contested motion for an extension of the discovery period.

For purposes of this order, we presume the parties' familiarity with the pleadings, the history of the proceeding, and the arguments and evidence submitted in support of and in opposition to the motion. In reaching our decision, all of the parties' arguments were carefully considered in light of the evidence of record, although we do not find it necessary to discuss all of them in our opinion. *See Guess? IP Holder L.P. v. Knowluxe LLC*, 116 USPQ2d 2018, 2018 (TTAB 2015).

1. Background

Applicant has filed a used-based application to register the following special form mark (the "Pilot Flight Suit")

for

> Business management consultancy services; executive search and placement services; personnel placement and recruitment;
>
> Providing seminars in motivational and management training; educational and entertainment services, namely, providing keynote motivational and educational speakers and providing personal and group coaching and learning forums in the field of leadership development.

in International Classes 35 and 41.[1]

The application contains the following description of the mark:

> Color is not claimed as a feature of the mark. The mark consists of a three-dimensional depiction of an entire pilot flight suit as worn by applicant's employees and contractors in rendering applicant's services. The broken lines in the drawing are not part of the mark but are merely intended to show the position of the mark.

During *ex parte* prosecution of the application, the Examining Attorney refused registration of the Pilot Flight Suit under Trademark Act Sections 1, 2, 3, and 45, 15 U.S.C. §§ 1051–1053, 1127, on the ground that it "does not function as a service mark to identify and distinguish Applicant's services from those of others and to indicate

[1] Application Serial No. 85094889, filed on July 28, 2010; amended on May 30, 2011, to claim acquired distinctiveness under Trademark Act Section 2(f), 15 U.S.C. § 1052(f).

the source of Applicant's services."[2] *See* Office Action dated November 20, 2010.[3] In response, Applicant amended the application to seek registration on the Principal Register with a claim of acquired distinctiveness under Trademark Act Section 2(f), 15 U.S.C. § 1052(f). Applicant's amendment was accepted, and the application was published for opposition with the Section 2(f) notation.

As grounds for opposition, Opposer alleges that Applicant's Pilot Flight Suit is not capable of distinguishing Applicant's services and, alternatively, has not acquired distinctiveness. Notice of Opposition ¶¶ 14–23 (1 TTABVUE 7–8). Applicant answered by denying the salient allegations in the notice of opposition.

2. Preliminary Matter: Unpleaded Claim

As an initial matter, we note that Opposer has not pleaded issue preclusion as a ground for opposition. Ordinarily, a party may not obtain summary judgment on an unpleaded claim or issue. *See* Fed. R. Civ. P. 56(a); TBMP § 528.07(a). Here, however, Applicant has not opposed the motion for summary judgment on that basis. Rather, both parties have argued the motion on its merits. Accordingly, solely for purposes of this motion, we deem Opposer's notice of opposition to have been amended by agreement of the parties to allege issue preclusion as a ground for opposition. *See Paramount Pictures Corp. v. White*, 31 USPQ2d 1768, 1772 (TTAB 1994), *aff'd mem.,*

[2] Sections 1–3 of the Trademark Act provide for the registration of service marks, which the Act defines in Section 45 to include "any word, name, symbol, or device, or any combination thereof [used or intended to be used] to identify and distinguish the services of one person, including a unique service, from the services of others and to indicate the source of the services, even if that source is unknown." 15 U.S.C. § 1127.

[3] The file of the involved application is automatically part of the evidentiary record on summary judgment. *See* Trademark Rule 2.122(b), 37 CFR § 2.122(b); TBMP § 528.05(a)(1) (June 2017).

108 F.3d 1392 (Fed. Cir. 1997); *Medtronic, Inc. v. Pacesetter Sys., Inc.*, 222 USPQ 80, 82 n.3 (TTAB 1984); TBMP § 528.07(a). We further deem Applicant to have denied Opposer's allegation of issue preclusion.

If Opposer wishes to assert issue preclusion at trial, however, it must submit an amended notice of opposition expressly pleading the claim. At the end of this order, we allow Opposer time to do so.

3. The Pleadings

Consideration of a motion for summary judgment necessarily requires a review of the pleadings to determine the legal sufficiency of the claims. *See* Fed. R. Civ. P. 56(a); *Asian & Western Classics B.V. v. Lynne Selkow*, 92 USPQ2d 1478, 1478 (TTAB 2009).

We note first that the ESTTA-generated cover sheet of the notice of opposition lists as grounds for opposition likelihood of confusion under Trademark Act Section 2(d), 15 U.S.C. 1052(d), and genericness. Upon review of the notice of opposition, we find that Opposer has not pleaded a claim of likelihood of confusion. Although the content of the ESTTA cover sheet is read in conjunction with the notice of opposition as an integral component, *PPG Indus. Inc. v. Guardian Indus. Corp.*, 73 USPQ2d 1926, 1928 (TTAB 2005), the mere mention of a ground on the cover sheet is insufficient to constitute a claim. *Embarcadero Techs. Inc. v. RStudio Inc.*, 105 USPQ2d 1825, 1827 n.2 (TTAB 2013); *see also* Fed. R. Civ. P. 8(a). We therefore *sua sponte* dismiss the putative Section 2(d) claim. *See* Fed. R. Civ. P. 12(f); *NSM Res. Corp. v. Microsoft Corp.*, 113 USPQ2d 1029, 1039 n.19 (TTAB 2014). At the end of

this order, we allow Opposer time to submit an amended notice of opposition to sufficiently plead a Section 2(d) claim, if possible, failing which the reference to the claim on the ESTTA cover sheet to the notice of opposition will be given no further consideration.[4]

With respect to the genericness claim listed on the ESTTA cover sheet, we construe this as referring to the first ground in the notice of opposition, namely, that Applicant's Pilot Flight Suit is not capable of distinguishing Applicant's services. *See* Notice of Opposition ¶¶ 14–15 (1 TTABVUE 7). This claim is sufficiently pleaded, as is Opposer's additional claim set forth in the notice of opposition (but not on the ESTTA cover sheet) that the Pilot Flight Suit is not inherently distinctive and has not acquired distinctiveness. *Id*. at ¶¶ 16–19 (1 TTABVUE 7–8).

In the notice of opposition, Opposer also alleges as separate grounds for opposition that to the extent the Pilot Flight Suit has acquired distinctiveness: "many other entities have been advertising and making corporate team-building presentations using flight suits for years"; and Applicant's Pilot Flight Suit has not acquired distinctiveness throughout the entire United States. *Id*. at ¶¶ 20–23 (1 TTABVUE 8). These allegations are not valid claims in their own right, and we will not consider them as such. However, to the extent Opposer alleges in paragraphs 20 through 23 that Applicant's use of the Pilot Flight Suit has not been substantially

[4] To allege a valid ground for opposition under Section 2(d), Opposer must allege that it has valid proprietary rights that are prior to those of Applicant, and that Applicant's mark, as used with the applied-for services, so resembles Opposer's mark as to be likely to cause confusion. *See Nike, Inc. v. Palm Beach Crossfit Inc.*, 116 USPQ2d 1025, 1030 (TTAB 2015) (citing 15 U.S.C. § 1052(d) and *Otto Roth & Co. v. Universal Foods Corp.*, 640 F.2d 1317, 209 USPQ 40 (CCPA 1981)).

exclusive or widespread, these allegations amplify Opposer's claim that the Pilot Flight Suit has not acquired distinctiveness and provide Applicant with further notice of the factual bases for that claim. Thus, although the allegations in these paragraphs do not constitute distinct claims, we need not strike them.

4. The Prior Civil Action

Because issue preclusion forms the basis of Opposer's motion for summary judgment, we must necessarily review the circumstances and outcome of the prior civil action between the parties.

Applicant and Opposer were in reverse positions as parties to Civil Action No. 09-CV-2844, in the Superior Court of Forsyth County, State of Georgia, styled *AfterBurner, Inc. v. The Corps Group* (the "civil action").[5] Applicant, as plaintiff in the civil action, asserted thirteen claims, including claims of false designation of origin and unfair competition under Trademark Act Section 43(a), 15 U.S.C. § 1125(a); deceptive trade practices under Georgia's Uniform Deceptive Trade Practices Act, OCGA §10-1-372; and common law unfair competition. *See* Third Amended Complaint ¶¶ 190–204, 225–228, and 229–235 (29 TTABVUE 65–68 and 71–73). Applicant alleged that Opposer infringed Applicant's unique and distinctive trade dress, "consisting of fighter pilot themed concepts and fighter pilot imagery" – including the Pilot Flight Suit worn by persons providing Applicant's services – and pleaded ownership of involved application Serial No. 85094889 for the Pilot Flight

[5] On December 14, 2011, the Board suspended proceedings pending the final disposition of the civil action. *See* 6 TTABVUE.

Suit.[6] *Id.* at ¶¶ 21, 24, and 27. Specifically, Applicant alleged that it used the Pilot Flight Suit and other fighter-pilot-themed trade dress in connection with a "Veteran-owned management training and consulting firm that provides keynote addresses, corporate teambuilding events, executive leadership training, strategic business planning consulting and human capital placement services," (*id.* at ¶¶ 2 and 21), and that Opposer infringed Applicant's Pilot Flight Suit and fighter-pilot-themed trade dress by using fighter pilot suits for services "very similar to, if not exactly the same as, [Applicant's] services, including keynote addresses, corporate teambuilding events, executive leadership training and strategic business planning consulting services for businesses." *Id.* at ¶¶ 47, 50, and 190–200.

Following a jury trial, Opposer moved for a directed verdict on the claims relating to Applicant's fighter-pilot-themed trade dress and Pilot Flight Suit,[7] and the parties argued the motion in open court. *See* Transcript of April 1, 2014 hearing, pp. 1528:22–1529:11 (29 TTABVUE 274). During the hearing on the motion, Applicant's trial counsel clarified for the court that its claims related to both the Pilot Flight Suit alone[8] and the fighter-pilot-themed trade dress, which Applicant's counsel described as more broadly including additional fighter-pilot-themed imagery. *Id.* at p. 1539:4–10.

[6] In addition to Opposer, three individuals also were named as defendants. For purposes of this order, we need only refer to Opposer.

[7] The trial court initially denied Opposer's motion for a directed verdict (*see* 29 TTABVUE 274), but subsequently permitted Opposer to renew the motion.

[8] During the hearing, at times the attorneys and the court referred to the Pilot Flight Suit alone as "the service mark."

At the conclusion of oral argument, the court, ruling from the bench, denied Opposer's motion for a directed verdict with respect to the fighter pilot themed trade dress, but granted the motion as to the Pilot Flight Suit, stating:

> I go back to the definition of service mark: "A service mark is in the word, name, symbol or device or combination used to identify and distinguish the services of one person, including a unique service, from the services of others." So what is it about a flight suit that itself, the symbol, distinguishes the services of [Applicant] from the services of anybody else? I'm talking about what kind of services, and your argument is, well, it's the kind -- no. The definition is the symbol itself. What is it about the symbol that distinguishes the services of one versus – and there is nothing; nothing, zero. A flight suit, a generic flight suit, is a flight suit. It is about the symbol itself, it's not -- it is not a service mark and it is -- motion for directed verdict granted as to the service mark, not trade dress.

Transcript 1541:9–24 (29 TTABVUE 286).

5. Summary Judgment Standard

Summary judgment is appropriate where the movant demonstrates that there is no genuine dispute as to any material fact and that it therefore is entitled to judgment as a matter of law. *See* Fed. R. Civ. P. 56(c); *Celotex Corp. v. Catrett*, 477 U.S. 317 (1987); *Sweats Fashions Inc. v. Pannill Knitting Co. Inc.*, 833 F.2d 1560, 4 USPQ2d 1793 (Fed. Cir. 1987). A factual dispute is genuine if, on the evidence of record, a reasonable fact finder could resolve the matter in favor of the non-movant. *See Opryland USA Inc. v. Great Am. Music Show Inc.*, 970 F.2d 847, 23 USPQ2d 1471, 1472 (Fed. Cir. 1992); *Olde Tyme Foods, Inc. v. Roundy's, Inc.*, 961 F.2d 200, 22 USPQ2d 1542, 1544 (Fed. Cir. 1992). The party seeking judgment in its favor carries the burden of proof. *Celotex*, 477 U.S. at 323–24.

Evidence on summary judgment must be viewed in a light favorable to the non-movant, and all justifiable inferences are to be drawn in the non-movant's favor. *See Lloyd's Food Prods., Inc. v. Eli's, Inc.*, 987 F.2d 766, 25 USPQ2d 2027, 2029 (Fed. Cir. 1993); *Opryland USA,* 23 USPQ2d at 1472. The Board may not resolve genuine disputes as to material facts; it may only ascertain whether genuine disputes as to material facts exist. *See Lloyd's Food Prods.*, 25 USPQ2d at 2029; *Olde Tyme Foods*, 22 USPQ2d at 1542.

6. Decision

Issue preclusion bars the re-litigation of the same issue in a second action, notwithstanding the fact that the claims in the two proceedings may differ.[9] *B&B Hardware, Inc. v. Hargis Indus., Inc.*, 136 S. Ct. 1293, 113 USPQ2d 2045, 2051 (2015); *Jet, Inc. v. Sewage Aeration Sys.*, 223 F.3d 1360, 1365-66, 55 USPQ2d 1854, 1858-59 (Fed. Cir. 2000). The application of issue preclusion requires: (1) identity of an issue in the current and prior proceedings; (2) actual litigation of that issue in the prior proceeding; (3) that determination of the issue was necessary in entering judgment in the prior proceeding; and (4) that the party with the burden of proof on that issue in the second proceeding had a full and fair opportunity to litigate the issue in the prior proceeding. *See NH Beach Pizza LLC v. Cristy's Pizza Inc.*, 119 USPQ2d 1861, 1864 (TTAB 2016) (citing *Montana v. United States*, 440 U.S. 147, 153-54 (1979)). A

[9] Findings of fact by state courts have been found to give rise to issue preclusion. *See, e.g.*, *Mother's Rest., Inc. v. Mama's Pizza, Inc.*, 723 F.2d 1566, 221 USPQ 394, 397 (Fed. Cir. 1983); *Midland Coop., Inc. v. Midland Int'l Corp.*, 164 USPQ 579 (CCPA 1970).

deficiency as to any one of the necessary four factors will prevent the application of issue preclusion. Accordingly, we focus on the first factor.

Issue preclusion, as distinguished from claim preclusion, does not include any requirement that the claim (or cause of action) be the same: "[w]hen an issue of fact or law is actually litigated and determined by a valid and final judgment, and the determination is essential to the judgment, the determination is conclusive in a subsequent action between the parties, whether in the same or a different claim." *Int'l Order of Job's Daughters v. Lindeburg & Co.*, 727 F.2d 1087, 220 USPQ 1017, 1019 (Fed. Cir. 1984) (quoting Restatement (Second) of Judgments § 27 (1980)); *Mother's Rest.,* 221 USPQ at 397.

Upon the record before us, however, there are genuine disputes of material fact regarding whether the issues decided by the trial court are identical to the issues in this proceeding.

Although the Georgia court ruled that the Pilot Flight Suit did not identify and distinguish Applicant's services and was not a service mark, it is not evident from the court's ruling that it considered, let alone decided, whether or not Applicant's Pilot Flight Suit is capable of functioning as a source identifier. In this regard, the court did not address whether or not the Pilot Flight Suit could acquire distinctiveness as a mark.

Moreover, the court's reference to the statutory definition of a service mark[10] as the basis for determining that the Pilot Flight Suit was not a service mark essentially mirrors the USPTO Examining Attorney's initial refusal of registration of the Pilot Flight Suit under Trademark Act Sections 1, 2, 3 and 45, 15 U.S.C. §§ 1051–1053, 1127, on the ground that it "does not function as a service mark to identify and distinguish Applicant's services from those of others and to indicate the source of Applicant's services." As discussed above, Applicant was able to overcome the Examining Attorney's statutory refusal by amending the application to seek registration under Section 2(f) based on a claim of acquired distinctiveness.

By seeking registration of the Pilot Flight Suit on the Principal Register under Trademark Act Section 2(f),[11] Applicant has conceded that the Pilot Flight Suit is not inherently distinctive. *See, e.g., Yamaha Int'l Corp. v. Hoshino Gakki Co.*, 840 F.2d 1571, 6 USPQ2d 1001, 1005 (Fed. Cir. 1988) (where an applicant seeks a registration based on acquired distinctiveness under Section 2(f), "the statute accepts a lack of inherent distinctiveness as an established fact"). Thus, the issues before the Board in this proceeding are whether or not the Pilot Flight Suit is capable of identifying the source of the services recited in the involved application, and, if so, whether the Pilot Flight Suit has acquired distinctiveness as a source identifier. The ruling of the Georgia court did not address either of these issues.

[10] Although the court did not specifically cite 15 U.S.C § 1127 in its bench ruling, it is clear from the transcript that the court was quoting the statutory definition of a service mark set forth in that section of the Trademark Act.

[11] We point out that the Section 2(f) claim was not filed in the alternative. *See* Trademark Manual of Examining Procedure § 1212.02(c) (April 2017).

Further, we do not interpret the court's ruling as holding that the Pilot Flight Suit is incapable of indicating source because it is generic. In this regard, we agree with Applicant that the court's statement that "[a] flight suit, a generic flight suit, is a flight suit" was not a legal determination that the Pilot Flight Suit is generic in the trademark sense but rather a colloquial use of the term to refer to the plain, unadorned nature of the Pilot Flight Suit. In this regard, we note that in arguing the motion for a directed verdict, Opposer's trial counsel similarly used the term "generic" as a synonym for "plain" or "unadorned," when he argued

> Well, this particular service mark application … it doesn't identify anything because it is as generic as anything you could imagine. It's this drawing of a flight suit, but it doesn't matter what color it is. It could be purple. It could be orange. That doesn't identify anybody. It doesn't have any markings on it. The truth is, there's no testimony that they ever tried to identify their business with a generic unmarked flight suit. All of their flight suits have a big Afterburner patch on it, so there should not be a claim on that.

Transcript pp. 1539:3–1540:8 (29 TTABVUE 283–84).[12]

Thus, we do not interpret the court's use of the term "generic" as a finding that the Pilot Flight Suit is incapable of identifying the source of Applicant's services.

In view of the above, and based on the record before us, Opposer has not demonstrated that there is no genuine dispute of material fact that the issue decided by the Georgia court is identical to the issues before the Board in this proceeding.

[12] In the notice of opposition, Opposer similarly uses the term "generic" in a manner seemingly intended as synonymous with "plain" or "unadorned." Specifically, Opposer alleges that "The alleged mark does not contain any distinctive designs or patterns on the flight suit. Rather the alleged mark is simply a generic flight suit." Notice of Opposition ¶ 1 (1 TTABVUE 4).

Because all of the elements of issue preclusion have not been met, Opposer's motion for summary judgment this **denied**.[13]

7. Resumption of Proceedings

Opposer is allowed until **August 25, 2017**, by which to file and serve an amended notice of opposition in which it may, to the extent warranted based on the facts and in view of this order, expressly plead issue preclusion and likelihood of confusion as grounds for opposition. If Opposer files an amended notice of opposition, Applicant is allowed until **September 19, 2017**, by which to file and serve an answer.

In view of the opportunity afforded to Opposer to amend its notice of opposition, fairness dictates that we also reset the discovery and trial periods. We have done so below. Accordingly, Applicant's contested motion for an extension of the discovery period is **denied without prejudice as moot**.

Proceedings are resumed on the following schedule.

Amended Notice of Opposition Due	**8/25/2017**
Answer Due	**9/19/2017**
Discovery Closes	**11/3/2017**
Plaintiff's Pretrial Disclosures	**12/18/2017**
Plaintiff's 30-day Trial Period Ends	**2/1/2018**
Defendant's Pretrial Disclosures	**2/16/2018**
Defendant's 30-day Trial Period Ends	**4/2/2018**
Plaintiff's Rebuttal Disclosures	**4/17/2018**
Plaintiff's 15-day Rebuttal Period Ends	**5/17/2018**

[13] The parties should note that the evidence submitted in connection with the motion for summary judgment is of record only for consideration of that motion. To be considered at final hearing, any such evidence must be properly introduced in evidence during the appropriate trial period. *See Land O' Lakes Inc. v. Hugunin*, 88 USPQ2d 1957, 1960 n.7 (TTAB 2008); *Univ. Games Corp. v. 20Q.net Inc.*, 87 USPQ2d 1465, 1468 n.4 (TTAB 2008); *Levi Strauss & Co. v. R. Josephs Sportswear Inc.*, 28 USPQ2d 1464 (TTAB 1993). Furthermore, the fact that we have identified certain genuine disputes of material fact sufficient to deny the motion should not be construed as a finding that these are necessarily the only issues which remain for trial.

The Federal Rules of Evidence generally apply to Board trials. Trial testimony is taken and introduced out of the presence of the Board during the assigned testimony periods. The parties may stipulate to a wide variety of matters, and many requirements relevant to the trial phase of Board proceedings are set forth in Trademark Rules 2.121 through 2.125. These include pretrial disclosures, the manner and timing of taking testimony, matters in evidence, and the procedures for submitting and serving testimony and other evidence, including affidavits, declarations, deposition transcripts and stipulated evidence. Trial briefs shall be submitted in accordance with Trademark Rules 2.128(a) and (b). Oral argument at final hearing will be scheduled only upon the timely submission of a separate notice as allowed by Trademark Rule 2.129(a).