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

Proceeding	91201830
Party	Plaintiff The Corps Group
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

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 MOTION FOR RECONSIDERATION

In its Motion for Reconsideration, Opposer explained that the Board's holding that the Georgia court did not find that the flight suit design was generic was directly contradicted by statements the judge made while granting a directed verdict in favor of Opposer. Afterburner provides no persuasive argument to the contrary and simply restates the Board's unsupported conclusion that the court used the term "generic" to mean "unadorned" or "plain". Afterburner focuses its opposition on two arguments that are fundamentally incorrect. First, Afterburner argues that Opposer's motion should be denied because it restates arguments made in Opposer's summary judgment motion, which is inaccurate. Second, despite clear precedent holding that generic marks can never be protectable, Afterburner argues that Afterburner could overcome a finding of genericness with evidence of acquired distinctiveness.

A. Opposer's Motion Is Not Reargument of Points from Its Summary Judgment Motion.

Opposer's Motion for Reconsideration focuses of the Board's determination that the Georgia court's used the term "generic" in a colloquial, rather than a legal sense, when it found that the flight suit design was generic. Although Opposer had noted in its Motion for Summary

Judgment that the court found the flight suit design to be generic, Opposer did not argue that the court's use of the term "generic" was a legal conclusion. Frankly, Opposer had no inkling that the Board might find the court's use of the term "generic" to be anything other than a legal conclusion, particularly when the court used that term in the context of a motion for a directed verdict on the ground that the asserted mark was generic. Thus, Opposer's Motion for Reconsideration, which explains why the court's use of the term "generic" was a legal conclusion, is not simply recycling arguments that Opposer made in its Summary Judgment Motion. Opposer's Motion for Reconsideration appropriately focuses on why the Board erred in holding that the issues before the Georgia court and before the Board are not identical. *See* Trademark Rule 2.127(b); *see also Steiger Tractor Inc. v. Steiner Corp.*, 3 USPQ2d 1708, 1709 (TTAB 1984) (granting motion for reconsideration that stressed certain evidence of record and made arguments based on the Board's issued opinion).

B. The Court Held that the Flight Suit Design Was Generic.

Afterburner argues that the court used the term "generic" to mean "plain" or "unadorned," rather than as a legal conclusion. However, even if one substitutes the term "plain" or "unadorned" into the court's statements where it used the term "generic," the result is the same. The court stated: "So what is it about a flight suit that itself, as a symbol, distinguishes the services of Afterburner from the services of anyone else?... A flight suit, a generic flight suit, is a flight suit...it is not a service mark." Borneman Decl. ¶ 8, Ex. A-5 at 1541:14-24. Substituting the terms "plain" or "unadorned" for "generic", the court would have stated that a "plain" or "unadorned" flight suit, such as the one that is the subject of the Application here, was not a service mark, such that the court granted a directed verdict of no infringement. Even under that reading, the court held that the flight suit design at issue was not capable of identifying a single source because, perhaps due to its unadorned nature, it cannot distinguish the services of

one company from the services of anyone else. This is consistent with the court's separate statement that there was "nothing; nothing, zero" about the flight suit that distinguishes the services of one company from another. Borneman Decl. ¶ 8, Ex. A-5 at 1541:14-24. The type of mark that is "by definition incapable of indicating a particular source of goods and/or services" is a generic mark. *See, e.g., In re Merrill Lynch, Pierce, Fenner & Smith, Inc.*, 828 F.2d 1567, 1569 (Fed. Cir. 1987).

The court, thus, unquestionably stated and held as a legal matter that the flight suit design was generic. As discussed in Opposer's opening brief, even if the Board believes the court's determination was wrong, the Board is precluded from reconsidering that determination under the collateral estoppel doctrine. *See Federated Dep't Stores v. Moitie*, 452 U.S. 294, 298 (1981) (the "consequences of a final, unappealed judgment on the merits [are not] altered by the fact that the judgment may have been wrong.").

C. Evidence of Acquired Distinctiveness Cannot Overcome a Finding that the Flight Suit Design Is Generic.

Afterburner incorrectly argues that even if the court held that the flight suit design was generic, collateral estoppel does not apply because Afterburner could overcome a genericness finding by submitting evidence of acquired distinctiveness. Generic marks cannot acquire distinctiveness. "Generic terms, by definition incapable of indicating source, are the antithesis of trademarks, and can never attain trademark status." *In re Merrill Lynch*, 828 F.2d at 1569 (citing *Dan Robins & Assocs., Inc. v. Questor Corp.*, 599 F.2d 1009, 1014 (C.C.P.A. 1979)). "Generic terms cannot be rescued by proof of distinctiveness or secondary meaning no matter how voluminous the proffered evidence may be." *In re Northland Aluminum Prods.*, 777 F.2d 1556, 1558 (Fed. Cir. 1985).

As a result, the Board routinely applies collateral estoppel based on a court's finding that the mark at issue is generic without considering the possibility of whether that mark could have acquired distinctiveness in the intervening time period. *See, e.g., STMicroelectronics, Inc. v. Nartron Corp.*, 2005 TTAB LEXIS 202 at *11-13 (TTAB 2005) (applying collateral estoppel in cancellation proceeding on issue of whether SMART-POWER was generic after district court held term was generic in infringement action); *Kegan v. Michael Wolff & Co.*, 2000 TTAB LEXIS 137, *9-11 (TTAB 2000) (applying collateral estoppel in opposition proceeding on issue of whether GUIDE was generic after district court held term was generic in infringement action). Therefore, if the Board reconsiders its decision and determines that the court held that the flight suit design was generic, collateral estoppel would apply despite any evidence Afterburner could present regarding acquired distinctiveness.

Because the court decided the identical issue raised in this proceeding, and, for the reasons explained in Opposer's Motion for Summary Judgment, the remaining factors were also satisfied, collateral estoppel should apply and summary judgment should be granted in favor of Opposer.

Dated: October 2, 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 Reconsideration has been sent via email, this 2nd day of October, 2017 to:

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