

Goodman

**THIS OPINION IS NOT
A PRECEDENT OF
THE TTAB**

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

Mailed: May 24, 2012

Opposition No. 91202371

Embotelladora Aga Del
Pacífico, S.A. de C.V.

v.

Jose Alfonso Serrano Gonzalez

Before Grendel, Wellington, and Kuczma, Administrative
Trademark Judges.

By the Board:

This case now comes up on opposer's motion, filed
February 16, 2012, for summary judgment on res judicata and
collateral estoppel grounds based on the Board's prior
decision in Opposition No. 91175952 which involved the
parties. The motion is fully briefed.

In a motion for summary judgment, the moving party has
the burden of establishing the absence of any genuine
disputes of material fact and that it is entitled to
judgment as a matter of law. See Fed. R. Civ. P. 56(a).
The evidence must be viewed in a light favorable to the
nonmoving party, and all justifiable inferences are to be
drawn in the nonmovant's favor. *Lloyd's Food Products Inc.
v. Eli's Inc.*, 987 F.2d 766, 25 USPQ2d 2027, 2029 (Fed. Cir.
1993).

We turn first to the question of whether this opposition is subject to claim preclusion. For claim preclusion to apply, there must be (1) an identity of 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. *Parklane Hosiery Co. v. Shore*, 439 U.S. 322, 327 n.5 (1979); *Jet Inc. v. Sewage Aeration Syst.*, 223 F.3d 1360, 55 USPQ2d 1854, 1856 (Fed. Cir. 2000). "[T]he Board [has] defined the 'claims' involved, for res judicata purposes, as the applicants' claims, as asserted in their applications, of entitlement to registration of their marks." *Institut National Des Appellations d'Origine v. Brown-Forman Corp.*, 47 USPQ2d 1875, 1894 (TTAB 1998).

We find claim preclusion inapplicable due to the different set of transactional facts present in this proceeding. Specifically, we find that in view of the addition of design elements, the involved mark in this



proceeding  is a different mark than the CABALLITO CERRERO mark involved in the parties' prior proceeding. See e.g., *Institut National Des Appellations*

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d'Origine v. Brown-Forman Corp., 47 USPQ2d 1894-1895 (claim preclusion inapplicable in that applicant's MIST AND COGNAC mark is a different mark, in terms of commercial impression, from CANADIAN MIST AND COGNAC mark).

In view thereof, opposer's motion for summary judgment is denied with respect to claim preclusion.

We turn next to the question of whether this opposition is subject to issue preclusion. In order for issue preclusion to apply, the following requirements must be met: 1) the issue to be determined must be identical to the issue involved in the prior litigation; 2) the issue must have been raised, litigated and actually adjudged in the prior action; 3) the determination of the issue must have been necessary and essential to the resulting judgment; and 4) the party precluded must have been fully represented in the prior action. *Mother's Restaurant Inc. v. Mama's Pizza, Inc.*, 723 F.2d 1566, 221 USPQ 394, 397 (Fed. Cir. 1983).

Opposer has not supported its motion by arguing the specific issues in this proceeding that should be precluded based on the final decision in Opposition No. 91175952. Rather, opposer directs the Board generally to the prior proceeding, arguing that "each and every issue required to reject Applicant's application for CABALLITO CERRERO was painstakingly reviewed, considered and decided in favor of Opposer." While we find that opposer, for the most part,

has not adequately identified the issues it believes are subject to preclusive effect to support its motion, we nonetheless do find issue preclusion with respect to the similarity or dissimilarity of the goods, *Dupont* Factor number 2, inasmuch as each party's goods remain the same.¹ We otherwise deny the remainder of opposer's motion for summary judgment on the basis of issue preclusion.

In summary, opposer's motion for summary judgment is denied with respect to claim preclusion, granted in part with respect to issue preclusion on the issue of similarity or dissimilarity of the goods, and denied as to the remainder.

Proceedings are resumed.

Dates are reset as follows:

Expert Disclosures Due	9/15/12
Discovery Closes	10/15/12
Plaintiff's Pretrial Disclosures	11/29/12
Plaintiff's 30-day Trial Period Ends	1/13/13
Defendant's Pretrial Disclosures	1/28/13
Defendant's 30-day Trial Period Ends	3/14/13
Plaintiff's Rebuttal Disclosures	3/29/13
Plaintiff's 15-day Rebuttal Period Ends	4/28/13

In each instance, a copy of the transcript of testimony together with copies of documentary exhibits, must be served

¹ See Final Decision in Opposition No. 91175952 at page 15 "it is nonetheless clear that tequila and soft drinks may be viewed to some extent as complementary, and thus associated with each other in the minds of a substantial portion of the public."

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on the adverse party within thirty days after completion of the taking of testimony. Trademark Rule 2.125.

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