

ESTTA Tracking number: **ESTTA637768**

Filing date: **11/07/2014**

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

Proceeding	91213743
Party	Plaintiff Be Sport, Inc.
Correspondence Address	CONNIE L ELLERBACH FENWICK & WEST LLP 801 CALIFORNIA STREET MOUNTAIN VIEW, CA 94041-1990 UNITED STATES trademarks@fenwick.com, cellerbach@fenwick.com, mjansen@fenwick.com
Submission	Opposition/Response to Motion
Filer's Name	Connie L. Ellerbach
Filer's e-mail	trademarks@fenwick.com
Signature	/cle1087/
Date	11/07/2014
Attachments	Opp to Motion for Summary Judgment.pdf(23167 bytes)

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

In the matter of
Trademark Application Serial No. 85/639,289
Mark: BEIN SPORT

Be Sport, Inc.,)	
)	
Opposer,)	
)	
vs.)	Opposition No. 91213743
)	
Al-Jazeera Satellite Channel,)	
)	
Applicant.)	
)	

**OPPOSER BE SPORT, INC.’S OPPOSITION TO APPLICANT’S
MOTION FOR SUMMARY JUDGMENT**

Although it is self-evident that Applicant’s BEIN and BEIN SPORT marks convey different commercial impressions, Applicant Al-Jazeera Satellite Channel’s Motion for Summary Judgment cursily asserts otherwise in its futile attempt to dismiss this Opposition under the doctrine of *res judicata* because of the prior dismissal with prejudice of Opposition No. 91212091 involving Applicant’s BEIN mark. Applicant’s Motion should be denied. The mark at issue here, BEIN SPORT, is sufficiently different, and conveys a distinct commercial impression, such that, as a matter of law, the two Oppositions involve distinct transactional facts that render *res judicata* inapplicable. To find otherwise would deprive Opposer Be Sport, Inc. of a full and fair opportunity to oppose the BEIN SPORT application on the merits.

BACKGROUND FACTS

Be Sport applied to register its BE SPORT mark (U.S. Serial No. 85413573) on September 1, 2011. *See* MSJ Ex. 2. Applicant filed its applications for the BEIN SPORT (U.S. Serial No. 85639289) and BEIN marks (U.S. Serial No. 85639445) on May 31, 2012. *See* MSJ Ex. 1. The BEIN mark was published for opposition on February 19, 2013, and the BEIN

SPORT mark was published for opposition on July 30, 2013. Be Sport instituted Opposition No. 91212091 on August 19, 2013. Opposition No. 91212091 was brought by Be Sport against Applicant's application to register its BEIN mark on the basis that Be Sport's application of its BE SPORT mark has priority over Applicant's BEIN mark and that there was a likelihood of confusion between the two marks. *See* MSJ Ex. 3.

Applicant's BEIN SPORT mark was published for opposition on July 30, 2013, and Be Sport filed this opposition on November 27, 2013, also on the basis that Be Sport's BE SPORT mark had priority over the BEIN SPORT mark and that there was likelihood of confusion between the BEIN SPORT and BE SPORT marks.

Applicant moved to involuntarily dismiss Opposition No. 91212091 on July 31, 2014. *See* MSJ Ex. 4. Be Sport did not oppose the dismissal and the Board dismissed Opposition No. 91212091 with prejudice on September 2, 2014. *See* MSJ Ex. 5.

On October 3, 2014, Applicant filed its Motion for Summary Judgment arguing that the Board's decision against Be Sport in Opposition No. 91212091, in which Be Sport opposed the application for registration of the BEIN mark, precludes Be Sport from maintaining the present Opposition under the doctrine of *res judicata*. The Motion was originally rejected by the Board as Applicant had not pled *res judicata* as a defense. Later that same day, Applicant refiled the present Motion in conjunction with a Motion to Amend Answer to add the defense.¹ Be Sport filed its Opposition to the Motion to Amend on October 23, 2014.

ARGUMENT

Summary judgment is only appropriate where the moving party demonstrates that there are no genuine issues as to any material facts, and that it is entitled to judgment as a matter of law. *See* Fed. R. Civ. P. 56(c). The evidence must be viewed in a light favorable to the

¹ As of the date of this filing, the Board has not yet decided whether or not Applicant may amend its Answer to plead a *res judicata* defense. Be Sport accordingly has opposed this Motion for Summary Judgment on the merits. Be Sport maintains, for the reasons set forth in its Opposition to Motion to Amend Answer and addressed in the present Opposition, that the *res judicata* defense is futile and that Applicant's Motion to Amend Answer should be denied on that basis.

nonmoving party, and all justifiable inferences are to be drawn in the nonmovant's favor. *Opryland USA Inc. v. The Great Am. Music Show, Inc.*, 970 F.2d 847, 849 (Fed. Cir. 1992). Summary judgment here should be denied. Applicant's sole ground for seeking summary judgment is that, as a result of the judgment in Opposition No. 91212091, Be Sport's present Opposition should be barred under the doctrine of *res judicata*. Yet Applicant's marks—BEIN SPORT and BEIN—are too dissimilar for the judgment in the prior Opposition to have any preclusive effect here.

A. The Two Oppositions Are Not Based on the Same Transactional Facts

Res judicata, or claim preclusion, applies only where: (1) the identity of the parties or their privies are the same, (2) there has been a final judgment on the merits of the prior claim, and (3) the claim in the later-filed action is based on the same transactional facts as the first case and that 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 Sys.*, 223 F.3d 1360, 1362 (Fed Cir. 2000). Applicant cannot establish that the present Opposition is based on the same transactional facts as the prior Opposition as the marks in question, BEIN and BEIN SPORT, are too dissimilar to convey "the same commercial impression." Accordingly, as a matter of law, Applicant is not entitled to summary judgment based on the earlier dismissal.

To determine whether two opposition proceedings "involve the same 'claim' for purposes of the claim preclusion doctrine," the Board, following section 24(2) of the Restatement (Second) of Judgments looks to whether:

[T]he mark involved in the first proceeding is the same mark, in terms of commercial impression, as the mark involved in the second proceeding, and whether the evidence of likelihood of confusion between the opposer's mark and the applicant's first mark would be identical to the evidence of likelihood of confusion between the opposer's mark and the applicant's second mark. The Board has also looked to whether the applicant's second mark differed from the first mark only in minor, insignificant ways which suggested that the applicant, in filing the second application, was merely attempting to avoid the preclusive effect of the previous judgment entered against it.

Institut Nat'l Des Appellations D'Origine v. Brown-Forman Corp., 47 U.S.P.Q.2d 1875, 1896 (T.T.A.B. 1998) (citing *Metromedia Steakhouses v. Pondco II*, 28 U.S.P.Q.2d 1205 (T.T.A.B. 1993) and *Miller Brewing Co. v. Coy Int'l Corp.*, 230 U.S.P.Q. 675 (T.T.A.B. 1986)).

Applicant's Motion makes only the most conclusory assertions that its two marks convey the same commercial impression. MSJ at 7. It instead argues that the BEIN SPORT mark "does not rise to the level of a new and different mark" because of the inclusion of the disclaimed term SPORT. *Id.* This argument fails for two reasons. First, to avoid preclusion the marks need not be "new and different." Instead, as *D'Origine* makes clear, *res judicata* is only applicable when the marks are "the same mark, in terms of commercial impression." 47 U.S.P.Q.2d at 1896. Second, Applicant's focus on the disclaimed word SPORT is a red herring. A prosecutorial decision in the trademark registration proceedings to disclaim any rights to a particular term would have no effect on *a consumer's* impression of the entire mark, the relevant test here.

a. BEIN and BEIN SPORT Do Not Convey the Same Commercial Impression

It is readily apparent that Applicant's BEIN and BEIN SPORT marks are sufficiently dissimilar as to convey different commercial impressions obviating Applicant's *res judicata* defense. Although both marks contain "BEIN," the BEIN SPORT mark creates a distinct commercial impression through the inclusion of the word SPORT. The second mark distinctly evokes the sense of a person's participation or interest in sporting and athletic events. The standalone BEIN mark conveys no such impression and, at most, conveys a sense of a person's presence (*i.e.*, to "be in the moment"). Similarly distinct marks have been found to not convey sufficiently similar commercial impressions in this context. *See, e.g., id.* (*res judicata* defense was futile as the mark in the prior Opposition, MIST AND COGNAC, created a different commercial impression than the mark at issue, CANADIAN MIST AND COGNAC); *Chromalloy Am. Corp. v. Kenneth Gordon, Ltd.*, 736 F.2d 694, 697-98 (Fed. Cir. 1984) (claim preclusion not applicable because the LADY GORDON mark was a "different mark" from the

GORDON and GORDON OF NEW ORLEANS marks at issue in a prior infringement proceeding).

The inclusion of the “SPORT” suffix also renders the BEIN SPORT mark far more similar in sound, look and meaning to Be Sport’s own BE SPORT mark. Accordingly, the evidence of likelihood of confusion “between the opposer's mark and the applicant's first mark” would not be “identical to the evidence of likelihood of confusion between the opposer’s mark and the applicant’s second mark.” *D’Origine*, 47 U.S.P.Q.2d at 1896. Indeed, preclusion is only a viable defense where the evidence of confusion would be *identical*. See, e.g., *Metromedia Steakhouses*, 28 U.S.P.Q.2d at 1208 (*res judicata* not applicable where the “evidence relating to the issue of likelihood of confusion with the first mark would not be *precisely the same* as the evidence with respect to likelihood of confusion with the second mark”) (emphasis supplied).

Preclusion is inappropriate even if BEIN and BEIN SPORT would “be confusingly similar under a likelihood of confusion analysis.” *D’Origine*, 47 U.S.P.Q.2d at 1895. And this result does not change simply because Applicant “adopted its . . . marks at or about the same time,” and “intended that the two marks be used for the exact same goods, and that applicant intended that the two marks be used interchangeably by sellers and purchasers of the goods and understood as synonyms or equivalents.” *Id.* Instead, in this context, the proper test to determine whether two oppositions are based on the same transactional facts is whether the “marks involved in the prior proceeding and in the pending proceeding differ from each other in more than minor, insignificant ways.” *Id.* The inclusion of word SPORT, a descriptive term that identifies the very nature of Applicant’s goods and services (as well as Be Sport’s), is far more than a “minor, insignificant” difference.

Applicant’s reliance on *Miller Brewing*, the sole case it cites, is inapposite. See MSJ at 8. In *Miller Brewing*, *res judicata* was applied against an applicant who, after a judgment had been entered against it, filed a new application for a second mark that differed in minor and insignificant ways in an effort to avoid the preclusive effect of that judgment. 230 U.S.P.Q. at

676–77. No such gamesmanship occurred here. Applicant filed both applications the same day and the present Opposition was initiated long before the judgment issued in Opposition No. 91212091. Where such evasive tactics are absent, the Board has declined to follow *Miller Brewing*. See, e.g., *Zachary Infrastructure, LLC v. Am. Infrastructure, Inc.*, 101 U.S.P.Q.2d 1249 (T.T.A.B. 2011) (opposer’s reliance on *Miller Brewing* misplaced as the second-filed application was “not filed as a means of evading a prior adverse judgment”); *Sharp Kabushiki Kaisha v. Thinksharp, Inc.*, 448 F.3d 1368, 1371 (Fed. Cir. 2006) (affirming *res judicata* inappropriate and noting the Board declined to apply *Miller Brewing* as “the separate applications were not filed in order to evade a prior adverse judgment.”)

b. Applicant’s Disclaimer of SPORT Does Not Obviate the Differences in Commercial Impressions Conveyed by the Marks

In an effort to avoid the significant differences between its two marks, Applicant’s motion focuses on the irrelevant fact that both parties have disclaimed the word SPORT in their respective marks. Without citation to any authority, Applicant concludes that the term SPORT “has no trademark significance whatsoever” rendering its inclusion in the Application at issue an “insignificant” change over its BEIN mark. See MSJ at 7–8. Applicant is wrong. Although neither party, as a result of the disclaimers, has any claim to the word SPORT apart from the applied for marks, that does not require reading SPORT out of the marks for the purposes of preclusion analysis. Instead, as the test is similarity of consumer’s commercial impression of the marks, the marks should be evaluated in their entirety. See, e.g., *D’Origine*, 47 U.S.P.Q.2d at 1877, 1894–95 (*res judicata* not applicable as the mark in the prior Opposition, MIST AND COGNAC, created a different commercial impression than the mark at issue, CANADIAN MIST AND COGNAC, and where both CANADIAN and COGNAC had been disclaimed).

And because of the inclusion of the word SPORT in the mark at issue in this Opposition, the likelihood of confusion analysis between the two Oppositions is necessarily different. Indeed, “[t]he disclaimed elements of a mark . . . are relevant to the assessment of similarity”

given that likelihood of confusion is “evaluated from the perspective of the purchasing public.” See *Shen Mfg. Co., Inc. v. Ritz Hotel, Ltd.*, 393 F.3d 1238, 1243 (Fed. Cir. 2004) (citing *In re Shell Oil Co.*, 992 F.2d 1204, 1206 (Fed. Cir. 1993) and *In re Nat’l Data Corp.*, 753 F.2d 1056 (Fed. Cir. 1985)). Accordingly, in this Opposition, Be Sport is entitled to a full and fair opportunity to analyze its own BE SPORT mark against Applicant’s BEIN SPORT mark. Were Applicant correct, and disclaimed terms have “no trademark significance,” the absurd result would be a likelihood of confusion analysis as between BE, as Be Sport’s mark, and BEIN, as Applicant’s.

CONCLUSION

Given that the marks at issue in the two Oppositions are sufficiently different as to convey distinct commercial impressions, Applicant’s motion for summary judgment based on the *res judicata* defense should be denied.

DATED: November 7, 2014

Respectfully submitted,

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Connie Ellerbach, Esq.
Mary E. Milionis, Esq.
Attorneys for Opposer
FENWICK & WEST LLP
Silicon Valley Center
801 California Street
Mountain View, CA 94041
Telephone: 650-988-8500

PROOF OF SERVICE BY MAIL

I declare that:

I am employed in the County of Santa Clara, California. I am over the age of eighteen years and not a party to the within cause; my business address is Silicon Valley Center, 801 California Street, Mountain View, California 94041. On the date set forth below, I served **BE SPORT, INC.'S OPPOSITION TO APPLICANT'S MOTION FOR LEAVE TO AMEND ANSWER**, on the interested parties in this action by placing a true copy thereof in a sealed envelope with postage thereon fully prepaid, and causing it to be placed for U.S. First Class Mail delivery by the U.S. Postal Service, which envelope was addressed as follows:

Kevin G. Smith
Sughrue Mion, PLLC
2100 Pennsylvania Ave NW, Suite 800
Washington, DC 20037-3202

I declare under the penalties of perjury that the above is true and correct, and that this declaration was executed at Mountain View, California this 7th day of November, 2014.

/Debbie Shaw/ _____
Debbie Shaw