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TTAB

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

Mailed: February 2, 2016

Opposition No. 91221844

Haggar Clothing Co.

v.

*Merve Optik Sanayi Ve
Ticaret Anonim Sirketi*

**Before Seeherman, Taylor, and Shaw,
Administrative Trademark Judges.**

By the Board:

Merve Optik Sanayi Ve Ticaret Anonim Sirketi (hereafter “Applicant”) seeks to register the stylized mark MUSTANG (shown below) for “spectacle frames; optical goods, namely, eye glasses, eyeglass lenses, sunglasses, lenses for sunglasses, eyeglass cases, eyeglass chains and cords.”¹

MUSTANG

Haggar Clothing Co. (hereafter “Opposer”) opposes registration of the mark on the ground of likelihood of confusion under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), and on the basis that registration is barred under the doctrine of claim preclusion (*res judicata*).

¹ Application Serial No. 79104357, filed August 8, 2011, under Section 66(a) of the Trademark Act.

This case now comes up for consideration of Opposer's fully briefed motion (filed September 3, 2015) for partial summary judgment on whether Applicant's registration of the applied-for mark is barred by the doctrine of claim preclusion. Opposer asserts that in a prior opposition between the parties (Opposition No. 91185522) involving the stylized mark MUSTANG² (shown below),

Mustang

the Board granted as conceded Opposer's motion for summary judgment on its claim of likelihood of confusion, and entered final judgment and refused registration of Applicant's MUSTANG (stylized) mark; that this opposition involves the same parties and the same transactional facts as the prior opposition; and that registration of the applied-for mark is barred by claim preclusion.

Summary judgment is an appropriate method of disposing of cases in which there is no genuine dispute with respect to any material fact, thus leaving the case to be resolved as a matter of law. *See* Fed. R. Civ. P. 56(a). A party moving for summary judgment has the burden of demonstrating the absence of any genuine dispute as to a material fact, and that it is entitled to judgment as a matter of law. *See Celotex Corp. v. Catrett*, 477 U.S. 317, 323 (1986); *Sweats Fashions, Inc. v. Pannill Knitting Co. Inc.*, 833 F.2d 1560, 4 USPQ2d 1793, 1796 (Fed. Cir. 1987). A

² Opposer submitted a copy of the application with its motion. Application Serial No. 77201372 was filed June 8, 2007 under Section 1(b) of the Trademark Act, for "Spectacles, spectacle cases, sunglasses, frames for spectacles and sunglasses, contact lens and contact lens cases, eyewear accessories, namely, straps, neck cords and head straps which restrain eyewear from movement on a wearer and spectacle chains."

factual dispute is genuine if, on the evidence of record, a reasonable fact finder could resolve the matter in favor of the non-moving party. *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). Additionally, the evidence of record and all justifiable inferences that may be drawn from the undisputed facts must be viewed in the light most favorable to the non-moving party. *See Lloyd's Food Prods. Inc. v. Eli's Inc.*, 987 F.2d 766, 25 USPQ2d 2027 (Fed. Cir. 1993); and *Opryland USA*, 23 USPQ2d at 1472.

Initially, we note that there is no dispute that Opposer has standing to bring this opposition. With the subject motion, Opposer has submitted the declaration of its counsel (Elizabeth K. Stanley) to which is attached printouts from the USPTO TSDR database of its three asserted U.S. registrations for the mark MUSTANG (9 TTABVUE 23-50),³ thereby showing that it has a real interest in the proceeding. *See Lipton Indus., Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185 (CCPA 1982). We point out that Applicant has not challenged Opposer's standing.

Turning next to the merits of the motion, under the doctrine of claim preclusion or *res judicata*, the entry of a final judgment "on the merits" of a claim in a proceeding serves to preclude the relitigation of the same claim, cause of action, or defense in a subsequent proceeding that involves the same parties or their privies,

³ U.S. Reg. No. 802773 for MUSTANG (typed drawing), issued January 25, 1966 for "men's clothing-namely, slacks," Sections 8 & 15 Affidavit accepted, renewed January 25, 2006; U.S. Reg. No. 1871947 for MUSTANG (typed drawing), issued January 3, 1995 for "men's wear, namely, slacks," Sections 8 & 15 Affidavit accepted, renewed January 3, 2015; and U.S. Reg. No. 4605689 for MUSTANG in standard characters, issued September 16, 2014, for "clothing, namely, jeans and shirts."

even when the prior judgment resulted from default, consent of the parties, or dismissal with prejudice. *See Lawlor v. Nat'l Screen Serv. Corp.*, 349 U.S. 322, 326 (1955); *Chromalloy Am. Corp. v. Kenneth Gordon, Ltd.*, 736 F.2d 694, 222 USPQ 187, 189 (Fed. Cir. 1984); and *Flowers Indus. Inc. v. Interstate Brands Corp.*, 5 USPQ2d 1582 (TTAB 1987). A subsequent claim will be barred by claim preclusion if: “(1) there is identity of parties (or their privies); (2) there has been an earlier final judgment on the merits of a claim; and (3) the second claim is based on the same set of transactional facts as the first.” *Jet Inc. v. Sewage Aeration Sys.*, 223 F.3d 1360, 55 USPQ2d 1854, 1857 (Fed. Cir. 2000), *reh'g* and *reh'g en banc denied* (Sept. 28, 2000) (citing *Parklane Hosiery Co. v. Shore*, 439 U.S. 322, 326 n.5 (1979)).

- *Identity of the Parties*

Opposer argues that Applicant is in privity with the applicant in the prior opposition insofar as that applicant merely changed its company structure in January 2011 from a limited company to an incorporated company, as indicated in its name, *i.e.*, from LIMITED to ANONIM, as shown below:

Merve Optik Sanayi Ve Ticaret **Limited** Sirketi

Merve Optik Sanayi Ve Ticaret **Anonim** Sirketi

Opposer also points out that the addresses in Turkey for each company are “fundamentally identical,” and that the principals “overlap.” In support of the foregoing assertions, Opposer submitted (with Ms. Stanley’s declaration) the following materials:

- (i) a printout from the USPTO TSDR database showing the “owner address” for the prior application (9 TTABVUE 52);
- (ii) a copy of a Hoover’s report and a OneSource Company summary report (dated August 24, 2015) concerning Applicant (9 TTABVUE 165-173);
- (iii) a printout from the “D&B Worldbase” on the prior applicant (9 TTABVUE 174-175); and
- (iv) a copy of an excerpt from the Trade Registry Gazette of Turkey, written in Turkish (9 TTABVUE 161-163).

These documents show the following:

- (1) the address of the prior applicant is “Senlikoy, Akasya Sokak NO: 4/1 Florya, Bakirkoy-Istanbul, Turkey,” and the address of Applicant in this proceeding is “No. 4/1 Senlikoy Mahallesi, Akasya Sokak, Florya Bakirkoy, 34153 Istanbul, Turkey.”
- (2) the two applicants share principals, *i.e.*, Ali Demirel, Hikmet Demirel, Arif Mahmut Demirel, and Mucteba Fatih Demirel are the Chairman, Vice Chairman, and Directors, respectively, of Applicant in this proceeding; and Ali Demirel, Arif Mahmut Demirel, Omer Fahrettin Demirel, and Mucteba Fatih Demirel are managers of the prior applicant.

Additionally, in response to Applicant’s contention that “it is mere supposition to assume that because the two entities appear to have the same address that the companies are related or in privity,” Opposer provided with its reply brief the following documents:

(i) an English translation⁴ of the previously submitted January 6, 2011 issue of the Trade Registry Gazette of Turkey, which shows that the “Former Trade Name” of Applicant is “Merve Optik Sanayi Ve Ticaret Limited Sirketi,” and that there was a change in the type of company. Additionally, all five persons listed above as managers of the prior applicant are identified to be the founding shareholders of Applicant (12 TTABVUE 22, 25). The declaration of the translator accompanies the translation (12 TTABVUE 21).

(ii) the declaration of Isilay Simsek Cengiz, an attorney from Turkey, who attests that the issue of the Trade Registry Gazette referred to *supra* is a true and correct copy of Issue No. 7724 and was accessed from The Union of Chambers and Commodity Exchanges of Turkey at www.ticaretbicil.gov.tr on August 24, 2015; Mr. Cengiz states that on December 15, 2010, the prior applicant converted from a limited company to a joint stock company and is now trading under the name of Applicant; that Applicant assumed all the assets and liabilities of the prior applicant upon transfer (¶ 3); and that Applicant is the successor to the prior applicant (¶ 4).

As noted, Applicant has merely argued that Opposer did not demonstrate that the two applicants are the same or in privity. Applicant did not actually state that the two entities are not the same or not in privity, nor did it provide any evidence to this effect.

⁴ There was no objection to Opposer’s submission of the translation.

When the moving party's motion is supported by evidence sufficient to indicate that there is no genuine dispute as to any material fact, as Opposer has done here, the burden shifts to the nonmoving party to demonstrate the existence of specific genuinely-disputed facts that must be resolved at trial. The nonmoving party may not rest on the mere allegations of its pleadings and assertions of counsel, but must designate specific portions of the record or produce additional evidence showing the existence of a genuine issue of material fact for trial. In general, to establish the existence of disputed facts requiring trial, the nonmoving party "must point to an evidentiary conflict created on the record at least by a counterstatement of facts set forth in detail in an affidavit by a knowledgeable affiant." *Octocom Sys. Inc. v. Houston Computers Servs. Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1786 (Fed. Cir. 1990). Applicant has not provided any evidence that would indicate that there is a genuine dispute as to relationship between the applicant in the prior proceeding and the applicant in this proceeding.

In view of the foregoing evidence, we find that there is no genuine dispute that it is the same Opposer in the two proceedings, and that the applicants are either identical or in privity. The first element to demonstrate claim preclusion is therefore satisfied.

- *Earlier Final Judgment on the Merits of a Claim*

Opposer argues that the prior adjudication between the parties operates as a final judgment on the merits for purposes of claim preclusion. Applicant does not disagree that "such a decision by the Board can serve as the basis upon which claim

preclusion may rest,” rather, Applicant suggests that the Board should carefully consider applying claim preclusion in this case “when the Board did not reach a decision on the merits.” In reply, Opposer maintains that the judgment was on the merits and that Applicant has mischaracterized the Board’s prior order.

The record shows that Opposer’s motion for summary judgment (filed October 19, 2009, in the prior opposition) sought entry of judgment against the prior applicant on Opposer’s claim of likelihood of confusion; that on January 11, 2010, the motion was granted as conceded; and that judgment was entered in favor of Opposer (9 TTABVUE 65, 147).

It is not necessary for issues to have been actually litigated in order for claim preclusion to apply. Claim preclusion applies “even when the prior judgment resulted from default, consent, or dismissal with prejudice.” *Flowers Indus. Inc. v. Interstate Brands Corp.*, 5 USPQ2d at 1583. In view thereof, we find that there was an earlier final judgment on the merits. The second element to demonstrate claim preclusion is therefore satisfied.

- *The Second Claim Is Based on the Same Set of Transactional Facts as the First.*

The Court of Appeals for the Federal Circuit has described “transaction” as referring to “the same nucleus of operative facts”, and held that a common set of transactional facts is to be identified “pragmatically.” *Jet, Inc.*, 55 USPQ2d at 1856. *See also* Restatement (Second) of Judgments Section 24 (1982) (defining “claim” as encompassing rights and remedies arising out of the same set of transactional facts)

(cited in *Chromalloy Am. Corp. v. Kenneth Gordon, Ltd.*, 222 USPQ at 189-90). “[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). Further, “[t]he Board, in applying the Restatement’s analysis⁵ in determining whether two opposition proceedings, against two applications, involve the same “claim” for purposes of the claim preclusion doctrine, has looked to whether the 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.” *Id.* Therefore, we must first consider whether the applied-for mark in this proceeding and the mark in the prior opposition are the same mark in terms of commercial impression.

The proper test for determining whether two marks have the same commercial impression, for purposes of the claim preclusion doctrine, is the test used to

⁵ Section 24 of the Restatement describes the concept of a claim as follows:

(1) When a valid and final judgment rendered in an action extinguishes the plaintiff’s claim pursuant to the rules of merger or bar ... the claim extinguished includes all rights of the plaintiff to remedies against the defendant with respect to all or any part of the transaction, or series of connected transactions, out of which the action arose.

(2) What factual grouping constitutes a “transaction”, and what grouping constitutes a “series,” are to be determined pragmatically, giving weight to such considerations as whether the facts are related in time, space, origin or motivation, whether they form a convenient trial unit, and whether their treatment as a unit conforms to the parties’ expectations or business understanding or usage.

determine whether or not “tacking” is allowed, *i.e.*, whether the marks are legal equivalents. *Id.* at 1895. The previous mark must be indistinguishable from the mark in question; the consumer should consider both as the same mark; and they must create “the same, continuing commercial impression.” *Hana Fin., Inc. v. Hana Bank*, 113 USPQ2d 1365, 1367 (2015) (internal quotation marks and citations omitted). *See also Be Sport, Inc. v. Al-Jazeera Satellite Channel*, 115 USPQ2d 1765, 1768 (TTAB 2015) (“where there are material differences, the commercial impression is not the same; the commercial impression is the same, however, where the differences are immaterial.”).

Applicant argues that the cursive font and the elongated bar crossing the letter “t” in the prior mark create a different commercial impression from the applied-for stylized mark. We disagree and find the Board’s analysis in *Miller Brewing Co. v. Coy Int’l Corp.*, 230 USPQ 675 (TTAB 1986), to be persuasive. In *Miller Brewing*, the Board considered whether the two word and design marks shown below created the same commercial impression:

- *Applied-for Mark:*



- *Prior Mark:*



In that case, the new, applied-for mark added the terminology “CASK NO. 32” and included additional sheaves of grain next to the oval design. The Board determined that the two marks created substantially the same commercial impression, the minor alterations did not rise to the level of creating a new mark, and the two designs represented one transaction or a series of connected transactions for purposes of *res judicata*. *Id.* at 678. Here, the change to the font of the mark MUSTANG is similar, with both marks evoking substantially the same commercial impression. The stylization of Applicant’s prior and applied-for marks is minimal, and the minor alteration to the prior mark does not rise to the level of a new mark. *See also Aromatique Inc. v. Lang*, 25 USPQ2d 1359 (TTAB 1992) (although there were slight differences in typeface and capitalization, the two marks created virtually identical commercial impressions and “the very minor alterations to the mark involved ... do not rise to the level that we can consider them to create a new mark sufficient, under the circumstances, to allow applicant to seek registration herein”). *Cf. S & L Acquisition Co. v. Helen Arpels Inc.*, 9 USPQ2d 1221, 1226 (TTAB 1987) (“there can be no doubt that ‘ADRIEN ARPEL’ whether represented in block form or stylized lettering is the single dominant commercial impression of both marks engendering the same and continuing commercial impression”); *In re Pickett Hotel Co.*, 229 USPQ 760, 763 (TTAB 1986) (“The style of lettering is also insignificant, in that it is clearly not so distinctive as to create any separate commercial impression in the minds of purchasers of appellant’s services.”). In sum,

neither font at issue is so stylized that Applicant's current mark evokes a different commercial impression from its prior mark.

With respect to the goods set forth in each application (repeated below), the doctrine of *res judicata* is applicable not only with respect to an identical description of goods as had been previously litigated, but with respect to all goods that could be said to be encompassed by that prior description. *See Gen. Elec. Co. v. Raychem Corp.*, 204 USPQ 148, 150 (TTAB 1979) (citing *Toro Co. v. Hardigg Indus., Inc.*, 549 F.2d 785, 193 USPQ 149 (CCPA 1977)).

- *Prior application:*

"Spectacles, spectacle cases, sunglasses, frames for spectacles and sunglasses, contact lens and contact lens cases, eyewear accessories, namely, straps, neck cords and head straps which restrain eyewear from movement on a wearer and spectacle chains."

- *Current application:*

"Spectacle frames; optical goods, namely, eye glasses, eyeglass lenses, sunglasses, lenses for sunglasses, eyeglass cases, eyeglass chains and cords."

Thus, the identification of "spectacle frames" in the current application is the same as "frames for spectacles" in the prior application; "eye glasses" is the same as "spectacles"; "sunglasses" is the same; "eyeglass cases" is the same as "spectacle cases"; "eyeglass chains" is the same as "spectacle chains"; and "eyeglass cords" is the same as "neck cords which restrain eyewear from movement on a wearer." Although "eyeglass lenses" and "lenses for sunglasses," which are in the identification of the second application, are not specifically listed in the first application, because such lenses are an integral part of "spectacles" and

“sunglasses,” the identification of goods in the second application must be viewed as substantially the same. An applicant cannot avoid the estoppel effect of the decision of a prior disposition by insignificantly changing its identification of goods. *See J.I. Case Co. v. F.L. Indus., Inc.*, 229 USPQ 697, 700 (TTAB 1986). In view of the foregoing, we find there is no genuine dispute that the marks and goods are part of the same transaction, and that the evidence of likelihood of confusion would have been the same in this case as it would have been in the prior proceeding. Thus, the third element for demonstrating claim preclusion is also satisfied.

Finally, the Board does not wish to encourage losing parties to insignificantly modify their marks after an adverse decision and thereby avoid the preclusive effect of the prior adjudication. *J.I. Case*, 229 USPQ at 700 (citing *Miller Brewing*, 230 USPQ at 678). *See also Institut National Des Appellations d’Origine v. Brown-Forman Corp.*, 47 USPQ2d at 1894.

In sum, there is no genuine dispute of material fact regarding the requisite elements for claim preclusion (*res judicata*) and we find that Opposer is entitled to judgment as a matter of law.

Accordingly, Opposer’s motion for summary judgment is granted on the ground of claim preclusion (*res judicata*), judgment is hereby entered against Applicant, and the opposition is sustained.
