

UNITED STATES PATENT AND TRADEMARK OFFICE  
Trademark Trial and Appeal Board  
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General Contact Number: 571-272-8500

WINTER

Mailed: July 18, 2016

Opposition No. 91226185

*Twentieth Century Fox Film Corporation*

*v.*

*Kind Distribution LLC*

**BY THE TRADEMARK TRIAL AND APPEAL BOARD:**

This case now comes up for consideration of Applicant's fully briefed motion (filed March 4, 2016) to dismiss Opposer's claim under the doctrine of claim preclusion (*res judicata*).<sup>1</sup>

For purposes of this order, the Board presumes the parties' familiarity with the parties' arguments made in connection with the subject motion.

To withstand a motion to dismiss for failure to state a claim upon which relief can be granted, a plaintiff (here, Opposer) need only allege sufficient factual content that, if proved, would allow the Board to conclude, or to draw a reasonable inference, that (1) the plaintiff has standing to maintain the proceeding,<sup>2</sup> and (2) a valid ground

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<sup>1</sup> Applicant's motion does not address Opposer's claims under Sections 2(d) and 43(c) of the Trademark Act, 15 U.S.C. §§ 1052(d) and 1127; therefore, said claims will not be addressed in this order.

<sup>2</sup> Applicant does not challenge Opposer's standing in its motion.

exists for opposing or cancelling the registration. *Doyle v. Al Johnson's Swedish Restaurant & Butik Inc.*, 101 USPQ2d 1780 (TTAB 2012) (citing *Young v. AGB Corp.*, 152 F.3d 1377, 47 USPQ2d 1752, 1754 (Fed. Cir. 1998)); *Order of Sons of Italy in Am. v. Profumi Fratelli Nostra AG*, 36 USPQ2d 1221, 1222 (TTAB 1995); and TBMP § 503.02 (2016). Specifically, a complaint “must contain sufficient factual matter, accepted as true, to ‘state a claim to relief that is plausible on its face.’” *Ashcroft v. Iqbal*, 556 U.S. 662, 678 (2009) (quoting *Bell Atlantic Corp. v. Twombly*, 550 U.S. 544, 570 (2007)). In particular, the claimant must allege well-pleaded factual matter and more than “[t]hreadbare recitals of the elements of a cause of action, supported by mere conclusory statements.” *Iqbal*, 556 U.S. at 678 (citing *Twombly*, 550 U.S. at 555).

Additionally, all well-pleaded, material allegations in the complaint are accepted as true and construed in favor of the complaining party. *See, e.g., Ritchie v. Simpson*, 170 F.3d 1092, 50 USPQ2d 1023, 1027 (Fed. Cir. 1999); *Doyle*, 101 USPQ2d at 1782. Further, a motion to dismiss under Rule 12(b)(6) must challenge the legal theory of the complaint, not the sufficiency of the evidence or whether extrinsic evidence would prevent Opposer from proving its claim. *See, e.g., Advanced Cardiovascular Systems Inc. v. SciMed Life Systems Inc.*, 988 F.2d 1157, 26 USPQ2d 1038, 1041 (Fed. Cir. 1993); *Libertyville Saddle Shop Inc. v. E. Jeffries & Sons Ltd.*, 22 USPQ2d 1594, 1597 (TTAB 1992) (A motion to dismiss is a test solely of the legal sufficiency of the plaintiff's pleadings ... [and] does not involve a determination of the merits of the case). *See also* TBMP §§ 503.01 and 503.02.

With respect to a claim under the doctrine of claim preclusion or *res judicata*, the plaintiff must allege (and ultimately prove) that there is “(1) an identity of the 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 [or could] have been litigated in the prior case.” *Sharp Kabushiki Kaisha v. Thinksharp, Inc.*, 448 F.3d 1368, 79 USPQ2d 1376, 1378 (Fed. Cir. 2006); *Jet Inc. v. Sewage Aeration Sys.*, 55 USPQ2d 1854, 1856 (Fed. Cir. 2000) (quoting *Parklane Hosiery Co. v. Shore*, 439 U.S. 322, 326 n.5 (1979)). As to the second requirement, default judgments can give rise to *res judicata*. See *Int’l Nutrition Co. v. Horphag Research, Ltd.*, 220 F.2d 1325, 55 USPQ2d 1492, 1492 (Fed. Cir. 2000); *Orouba Agrifoods Processing Co. v. United Food Import*, 97 USPQ2d 1310, 1313 (TTAB 2010).

The Board finds the following allegations in the notice of opposition to be relevant to Opposer’s claim under the doctrine of claim preclusion. Specifically, Opposer alleges the following:

19. On June 28, 2011, Kind Distribution LLC [a New York limited liability company] filed an intent-to-use Application Serial No. 85357919 for the mark PLANET OF THE VAPES & Design ... for “smokeless cigarette vaporizer pipe; tobacco grinders; lighters for smokers; tobacco jars” in International Class 34 (the “First PLANET OF THE VAPES Application”). The signatory to Application Serial No. 85357919 was Patrick Bissen (“Bissen”). ...

20. ... [O]n January 18, 2012, Opposer filed Opposition No. 91203417 against the First PLANET OF THE VAPES application.

21. On March 13, 2012, the Board issued a notice of default in Opposition No. 91203417 finding that Applicant failed to file an Answer by February 27, 2012, and allowing Applicant thirty days to respond.

22. On April 27, 2012, the Board issued a judgment by default in Opposition No. 91203417 sustaining the opposition and refusing registration of the First PLANET OF THE VAPES application.

...

25. On April 20, 2015, Kind Distribution, LLC, [a Texas limited liability company] filed use-based Application Serial No. 86603079 ... for the mark PLANET OF THE VAPES (standard characters) for “herbal grinders; herbal storage containers” in International Class 34 and “retail sale services featuring vaporizers and herbal grinders; retail sale services featuring vaporizer accessories, smokeless inhalers, herbal storage containers, vaporizable concentrate storage” in Class 35 (the “Third PLANET OF THE VAPES Application”) ... The signatory to the Third PLANET OF THE VAPES Application was also Bissen.

26. On November 19, 2015, Applicant amended the goods and services identification of Application Serial No. 86603079 to “Grinders for smoking herbs; Storage containers for smoking herbs” in Class 34 and “Direct to consumer and online retail store services featuring vaporizer accessories, smokeless inhalers, herbal storage containers, vaporizable concentrate storage, vaporizers and herbal grinders” in Class 35.

...

38. Applicant is precluded from registering Applicant’s PLANET OF THE VAPES mark under the doctrine of res judicata or claim preclusion.

39. On January 18, 2012, Opposer filed Opposition No. 91203417 against the First PLANET OF THE VAPES Application, asserting likelihood of confusion and dilution claims.

40. On April 27, 2012, the Board issued a final judgment by default in Opposition No. 91203417 sustaining the opposition and refusing registration of the First PLANET OF THE VAPES Application Serial No. 86603079 because Applicant failed to file an answer.

41. This proceeding involves identical parties or their privies because Opposition No. 91203417 was between Opposer and Applicant’s predecessor (Kind Distribution LLC, a limited liability company of New York). Further, Opposition No. 91203417 involved the same claims and transactional facts that are involved in this opposition.

42. Accordingly, Applicant is precluded from registering the virtually identical PLANET OF THE VAPES mark in the Third PLANET OF THE VAPES application covering identical and/or overlapping goods and services.

Applicant argues that Opposer's claim is insufficient because it does not allege facts upon which the Board could determine that the transactional facts involved in the two opposition proceedings are the same. In particular, Applicant contends that the marks in the two proceedings are not legal equivalents, that the goods and services identified in the later application are very different from the goods in the earlier application, and that as a matter of law, *res judicata* does not apply. At a minimum, Applicant contends that the claim cannot survive as to the services in International Class 35.

As noted *supra*, a motion to dismiss is a test solely of the legal sufficiency of the plaintiff's pleadings and does not involve a determination of the merits of the case. Here, Applicant is arguing the merits of Opposer's *res judicata* claim, rather than focusing on whether the pleading is sufficient. Moreover, the Board finds that Opposer has sufficiently pleaded claim preclusion insofar as Opposer alleges that (i) there are two proceedings at issue which involve the same parties or a party in privity with one of the parties (¶¶ 19, 25, and 41), (ii) there is a prior judgment on the same claims (¶¶ 22, 39, 40, and 41), and (iii) the second claim is based on the same transactional facts as the first claim (¶ 41). Whether or not Opposer can prove the pleaded allegations is a matter to be determined after the introduction of evidence at trial (or in connection with a proper motion for summary judgment). See *Flatley v. Trump*, 11 USPQ2d 1284, 1286 (TTAB 1989). In view of the foregoing, Applicant's motion to dismiss is **denied**.<sup>3</sup>

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<sup>3</sup> To the extent Applicant sought to have the Board consider the merits of Opposer's *res judicata* claim, such a request is properly before the Board as a motion for summary

Proceeding Resumed; Trial Dates Reset

This proceeding is resumed. Trial dates are reset as shown in the following schedule:

<b>Time to Answer</b>	<b>8/17/2016</b>
<b>Deadline for Discovery Conference</b>	<b>9/16/2016</b>
<b>Discovery Opens</b>	<b>9/16/2016</b>
<b>Initial Disclosures Due</b>	<b>10/16/2016</b>
<b>Expert Disclosures Due</b>	<b>2/13/2017</b>
<b>Discovery Closes</b>	<b>3/15/2017</b>
<b>Plaintiff's Pretrial Disclosures Due</b>	<b>4/29/2017</b>
<b>Plaintiff's 30-day Trial Period Ends</b>	<b>6/13/2017</b>
<b>Defendant's Pretrial Disclosures Due</b>	<b>6/28/2017</b>
<b>Defendant's 30-day Trial Period Ends</b>	<b>8/12/2017</b>
<b>Plaintiff's Rebuttal Disclosures Due</b>	<b>8/27/2017</b>
<b>Plaintiff's 15-day Rebuttal Period Ends</b>	<b>9/26/2017</b>

**IN EACH INSTANCE**, a copy of the transcript of testimony, together with copies of documentary exhibits, must be served on the adverse party **WITHIN THIRTY DAYS** after completion of the taking of testimony. See Trademark Rule 2.125, 37 C.F.R. § 2.125.

Briefs shall be filed in accordance with Trademark Rules 2.128(a) and (b), 37 C.F.R. §§ 2.128(a) and (b). An oral hearing will be set only upon request filed as provided by Trademark Rule 2.129, 37 C.F.R. § 2.129.



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judgment. While such a motion can be filed prior to the service of initial disclosures (*see* Trademark Rule 2.127(e)(1)), Applicant's motion was not identified as such, nor was it accompanied by any materials in support of such a motion. In view thereof, it would not have been proper to construe Applicant's motion to dismiss as a summary judgment motion.