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

Proceeding	92047363
Party	Plaintiff Fey Industries, Inc. Fey Industries, Inc. ,
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M&G 14447.3USTB TRADEMARK

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

Fey Industries, Inc.,	)	
	)	Cancellation No. 92047363
Petitioner,	)	
	)	Mark: TRIMPAK
v.	)	
	)	Reg. No.: 3,206,104
Nexpak Corporation,	)	
	)	Filing Date: April 7, 2006
Registrant.	)	
	)	Registered: February 6, 2007

MEMORANDUM IN SUPPORT OF PETITIONER'S MOTION FOR SUMMARY JUDGMENT BASED ON RES JUDICATA

I. INTRODUCTION

Fey Industries, Inc., brought this cancellation proceeding to cancel Nexpak's registration of the mark TRIMPAK for "injection molded media storage container for holding a single optical media disc on a media disc retaining hub." Fey and Nexpak were engaged previously in a cancellation proceeding involving the identical word mark for essentially identical goods. That cancellation resulted in a final judgment in favor of Fey sustaining Fey's Petition for cancellation, and cancelling Nexpak's registration of the TRIMPAK mark.

Based on the prior judgment regarding the word mark TRIMPAK, Fey hereby seeks summary judgment that Registration No. 3,206,104 for the mark TRIMPAK is barred, as a matter of law, under the doctrine of res judicata.

II. UNDISPUTED FACTS

Registrant, Nexpak Corporation ("Nexpak"), has registered the mark TRIMPAK for "injection molded media storage container for holding a single optical media disc on a media disc

retaining hub" in International Class 9, Registration No. 3,206,104. Registrant's Answer ¶ 1. By this Petition, Petitioner, Fey Industries, Inc. ("Fey"), seeks to cancel Nexpak's registration based on a prior judgment between the parties denying Nexpak registration of the TRIMPAK mark.

Fey previously filed a petition to cancel a separate registration by Nexpak for the mark TRIMPAK for "plastic security containers for recorded media, namely, audio cassettes, video cassettes, compact disks, microdisks, minidisks, digital video disks, game cartridges and computer disks" in International Class 9. Registrant's Answer ¶ 19; Golla Decl. ¶ 2-3, Ex. A ¶ 1 (Petition for Cancellation, Cancellation No. 92045743), Ex. B (TARR status report for Registration No. 2,598,396). Nexpak's mark was registered on July 23, 2002 with Reg. No. 2,598,396 ("the '396 registration"). Registrant's Answer ¶ 19, Ex. B. In early 2005, an employee of Nexpak contacted Fey regarding Fey's use of the mark TRIMPAK, Registrant's Answer ¶ 16, and on April 27, 2006, Fey filed a petition for cancellation of the '396 registration. Registrant's Answer ¶ 19. The Cancellation proceeding was assigned Cancellation No. 92045743. *Id.*

Fey's petition for cancellation of the '396 registration was based upon Fey's rights in and to the word mark TRIMPAK, used in connection with "security containers for recorded media." Ex. A ¶ 3. Fey based its petition on a claim of likelihood of confusion and Fey's priority of adoption, use and advertising of the mark TRIMPAK. Registrant's Answer ¶ 19, Ex. A ¶¶ 6, 12-14.

The Board notified Nexpak of the Petition for Cancellation in a Notice mailed June 13, 2006, giving Nexpak forty days in which to Answer or otherwise plead. Golla Decl. ¶ 4, Ex. C (Notice of Filing of Petition for Cancellation). Nexpak's Answer was due July 23, 2006.

Nexpak never filed an Answer to Fey's Petition for Cancellation. Golla Decl. ¶ 5, Ex. D (Notice of Default).

On August 23, 2006, the Trademark Trial and Appeal sent a notice to Nexpak that default had been entered against it under Rule 55(a) of the Federal Rules of Civil Procedure because of its failure to file an Answer. *Id.* The Notice gave Nexpak twenty days to show cause why judgment should not be entered against it under Rule 55(b) of the Federal Rules of Civil Procedure. *Id.* Nexpak never responded to the Notice. Golla Decl. ¶ 6, Ex. E (Notice of Judgment by Default).

Accordingly, on October 25, 2006, the Trademark Trial and Appeal Board entered judgment sustaining Cancellation No. 92045743 and adjudging that Nexpak was not entitled to the registration for the TRIMPAK mark shown in the '396 registration. *Id.*

On April 7, 2006, only a short time after it contacted Fey about Fey's use of the mark TRIMPAK, Nexpak filed another application for the mark TRIMPAK for "injection molded media storage container for holding a single optical media disc on a media disc retaining hub" in International Class 9. Registrant's Answer ¶ 9, Golla Decl. ¶ 7, Ex. F (TARR status report for Registration No. 3,206,104). The second TRIMPAK application was assigned Serial No. 78/856,796 (the '796 application). *Id.* The '796 application published for opposition in the Official Gazette on November 21, 2006, five months after Fey filed a Petition for Cancellation of the '396 registration, and one month after the cancellation of the '396 registration. Ex. F. The '796 application was granted Registration No. 3,206,104 on February 26, 2007, and is the subject of this Cancellation proceeding. *Id.*

III. ARGUMENT

A. Standards of Law

The granting of a motion for summary judgment is appropriate when there is no genuine issue of material fact and the moving party is entitled to judgment as a matter of law. Fed. R. Civ. P. 56(c).

Under the doctrine of claim preclusion, a final judgment on the merits bars relitigation of the same claim between the same parties. *Brown v. Felsen*, 442 U.S. 127, 131 (1979); *Parklane Hosiery Co. v. Shore*, 439 U.S. 322, 327 n.5 (1979).

"Claim preclusion may operate between the parties simply by virtue of a final judgment, even though there was no trial or hearing, so long as the parties might have had their controversies determined if they had presented all their evidence and the Court had applied the law thereto." *U.S. Olympic Committee v. Bata Shoe Co., Inc.*, 225 USPQ 340, 341-42 (TTAB 1984) (citing *Wells Cargo, Inc. (Elkart, Indiana) v. Wells Cargo, Inc. (Reno, Nevada)*, 606 F.2d 961, 203 U.S.P.O. 564 (CCPA 1979)).

B. Cancellation No. 92045743 Ended In A Final Judgment

Default judgment was entered against Nexpak when it failed to Answer Fey's Petition for Cancellation. Nexpak never contested or otherwise appealed the judgment entered against it. Default judgment is a final judgment for the purposes of claim preclusion. *Wells Cargo, Inc. (Elkhart, Indiana) v. Wells Cargo, Inc. (Reno, Nevada)*, 606 F.2d 961, 203 USPQ 564, 566 (CCPA 1979); *Domino's Pizza Inc. v. Little Caesar Enterprises Inc.*, 7 USPQ2d 1359, 1360 (TTAB 1988).

Thus, the judgment that Nexpak is not entitled to a registration for the TRIMPAK mark is final and will have preclusive effect in this case if it involves the same general claim.

C. This Cancellation Proceeding Involves The Same Claim As In Cancellation 92045743.

The Court of Appeals for the Federal Circuit looks to the *Restatement (Second) of Judgments* (1982) in determining what preclusive effect should be given a prior judgment in subsequent litigation. *The Young Engineers v. U.S. International Trade Commission*, 721 F.2d 1305, 219 USPQ 1142 (Fed. Cir. 1983); *Chromalloy American Corp. v. Kenneth Gordon, Ltd.*, 736 F.2d 694, 222 USPQ 187 (Fed. Cir. 1984). Section 24 of the *Restatement* describes the concept of "claim" for the purposes of claim preclusion 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 (see §§ 18, 19), 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.

An applicant may not register a mark which had been denied registration in a previous opposition proceeding: the two applications concern the same claim. *Miller Brewing Co. v. Coy Intern. Corp.*, 230 USPQ 675 (TTAB. 1986). In *Miller Brewing*, the applicant had filed two applications for different design marks, with the same wording, for beer (the second mark also contained minor additional wording). When the first application published for opposition, Miller Brewing Corporation opposed it. The applicant subsequently filed an abandonment of the opposed application. Because the abandonment was filed without Miller's consent, the Board entered judgment against applicant pursuant to Trademark Rule 2.135. *Id.* at 676-77. In a later

opposition filed against the second application, Miller filed a motion for summary judgment that it was entitled to judgment as a matter of law under the doctrine of res judicata. *Id.*

Applying Section 24 of the Restatement, the Board found that the mark sought to be registered and the mark at issue in the prior opposition constituted a "transaction or series of transactions within the meaning of the Restatement." *Id.* at 678. The Board observed that the second mark evolved out of the original mark, and that the facts of the two cases formed a "convenient trial unit" given that the evidence relating to the issue of likelihood of confusion in the two cases was identical. *Id.* Accordingly, the Board held that its judgment entered in the first opposition operated as claim preclusion so as to bar applicant's application. *Id.*

The Board has repeatedly followed its ruling in *Miller Brewing*. See, e.g., *Aromatique Inc. v. Lang*, 25 USPQ2d 1359, 1361 (TTAB 1992) ("Applicant's two marks create virtually identical commercial impressions and the very minor alterations to the mark involved herein 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"). See also *Royal Caribbean Cruises, Ltd. v. Royal Caribbean Jamaican Bakery, Inc.*, 2005 TTAB LEXIS 138, 9 (nonprecedential) ("The minor alterations in the second mark, as compared to the first mark, do not create a new mark sufficient to allow applicant to seek registration in view of the earlier judgment.")

Miller Brewing is directly applicable to the instant case; the present cancellation occurs at a later point in the life of the trademark. As in *Miller Brewing*, the Board previously entered judgment against the registrant Nexpak in a prior proceeding when the registrant abandoned its trademark without the consent of the petitioner. Nexpak then tried to escape from the effects of

the prior judgment with a second application for the same or similar mark for the same or similar goods. In fact, while the applicant in *Miller Brewing* had two applications for slightly different marks, one evolving out of the other, Nexpak's registrations were both for the identical mark TRIMPAK, one stylized and one in block letters.

Moreover, the goods identified in the second registration fall well within the scope of the goods identified in the first registration: the prior goods were identified as "plastic security containers for recorded media, namely, audio cassettes, video cassettes, compact disks, microdisks, minidisks, digital video disks, game cartridges and computer disks", whereas the instant goods are "injection molded media storage container for holding a single optical media disc on a media disc retaining hub." As the Board noted in *General Electric Company v. Raychem Corporation*, 204 USPQ 148 (TTAB 1979), a party cannot avoid the preclusive effect of a prior final judgment merely by limiting the scope of its proposed mark if the actual goods are identical. ("Since applicant could have, in fact, restricted its description of goods in the first proceeding, but did not, and, rather, went forward on the broad identification of goods, the Board is of the view that res judicata is applicable as to all goods encompassed by the prior identification on which applicant was actually using the mark at the time of the prior proceeding.") *Id.* at 150.

Under these circumstances, the evidence relating to the issue of likelihood of confusion with respect to the first mark is identical to that which would be presented with respect to the second mark. Consequently, under *Miller Brewing*, the facts in the two cases form a convenient trial unit for purposes of the *Restatement*, Section 24(2), and claim preclusion applies.

IV. CONCLUSION

For the foregoing reasons, Petitioner respectfully requests that summary judgment be entered against Registrant, canceling Registration No. 3,206,104, based on claim preclusion.

Respectfully submitted,

FEY INDUSTRIES, INC.

By its attorney,

7-3-07
Date

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CERTIFICATE OF SERVICE

I hereby certify that a copy of the foregoing MEMORANDUM IN SUPPORT OF PETITIONER'S MOTION FOR SUMMARY JUDGMENT BASED ON RES JUDICATA has been served on counsel for Registrant by first class mail, postage prepaid, this 3rd day of July, 2007 as follows:

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