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

Proceeding	92058956
Party	Plaintiff SoCal Maico
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Submission	Other Motions/Papers
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Date	08/07/2015
Attachments	Response to OSC In Re Dismissal - Motion to Resume and Reset.pdf(20030 bytes)

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7 BEFORE THE UNITED STATES PATENT AND TRADEMARK OFFICE
8 TRADEMARK TRIAL AND APPEAL BOARD

9 SoCal MAICO,

10 Petitioner

11 vs.

12 578539 B.C. Ltd.

13 Respondent.

) **Opposition No. 92058956**
)
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)
)

) **RESPONSE TO OSC In Re DISMISSAL**
)
)

) **MOTION TO RESUME PROCEEDINGS**
) **AFTER SUSPENSION FOR CIVIL CASE**
) **DETERMINATION AND REQUEST TO**
) **RESET DISCOVERY AND TRIAL**
) **DATES**
)
)
)
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14 **TO RESPONDENT AND THE BOARD:**

15 **PETITIONER**, responds to the Board’s Order to Show Cause as to why
16 this case should not be dismissed. Petitioner moves the Board to continue the aforementioned
17 cancellation proceeding, now that Respondent has filed with this Board his Motion to Resume
18 Proceedings along with the Order Dismissing the Civil Action in Federal Court, said Civil
19 Action being the reason for the suspension of this Board’s cancellation proceeding. Petitioner
20 consents to Respondent’s Motion to Resume and will show good cause to continue said
21 cancellation proceeding.

22 Petitioner urges the Board to review the Judge Morrow’s Federal Order to
23 observe that no matters have been decided upon nor has the Federal Court made any ruling on
24

1 said Federal Case. The Federal Case was dismissed in its entirety. There have been no rulings
2 that affect this Board's jurisdiction, either through issue or claim preclusion or res judicata, to
3 prevent this Board from hearing this cancellation proceeding.

4 Good cause in continuing with this Cancellation Proceeding is found in
5 that the Federal Court has not made any ruling upon the Mark in question which would cause a
6 ruling of the TTAB to be moot in light of issue or claim preclusion by the Federal Court over the
7 TTAB's cancellation proceeding. The Board has been cautioned by the Federal Court of
8 Appeals as "[c]aution is warranted in the application of preclusion by the PTO," see
9 *Mayer/Berkshire Corp. v. Berkshire Fashions, Inc.*, 424 F.3d 1229, 76 USPQ2d 1310, 1314
10 (*Fed. Cir. 2005*), although "it is within the Board's discretion to apply preclusion where it is
11 warranted. " *Parklane Hosiery Co., Inc. v. Shore*, 439 U.S. 322 (1979). The application of the
12 doctrine of claim preclusion is appropriate when:

- 13 (1) there is an identity of parties or their privies;
14 (2) there was an earlier final judgment on the merits of a claim; and
15 (3) the second claim is based on the same set of transactional facts as the first and should
16 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 Systems*, 223 F.3d 1360, 55 USPQ2d 1854,
1856 (*Fed. Cir. 2000*).

17 There has not been any final judgment on the merits on any of the Federal
18 claims which alone will fail the doctrine test. Additionally, the Federal Case and this Board's
19 cancellation proceeding do not follow same guidelines for proving liability nor does a final
20 judgment in Federal Court automatically act as claim preclusion as the CAFC has found that
21 "neither issue preclusion nor claim preclusion [of the Federal Court ruling] was applicable to the
22 TTAB proceedings. *Levi Strauss & Co. v. Abercrombie & Fitch Trading Co.*, 107 USPQ2d 1167
23 (*Fed. Cir. 2013*). Furthermore, the CAFC has concluded that Board's decision [of dismissal]
24

1 cannot be affirmed on the alternative ground of claim preclusion because the TTAB proceedings
2 and the district court action do not involve the same transactional facts, "pragmatically judged."
3 the CAFC's decisions in Jet (supra) and Mayer/Berkshire (supra) are right on point: both cases
4 held that the "array of differences in transactional facts conclusively demonstrates that claim
5 preclusion cannot serve to bar" the TTAB proceedings.

6
7 Having shown that good cause exists to continue this cancellation
8 proceeding, and since there were no motions pending before this Board prior to the suspension of
9 the proceeding, the Petitioner hereby requests that the Board reset the Schedule for Discovery
10 and Trial along with the statutorily mandated deadlines regarding disclosures.

11
12
13 Respectfully submitted,

14 /Ken Dallara/
15 Ken Dallara, Esq,
16 Attorney for Petitioner SoCal MAICO

Dated : August 7, 2015

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CERTIFICATE OF SERVICE

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3 1) I hereby certify that a copy of the Motion to Resume Proceeding and Resetting of
4 Discovery Dates was caused to be transmitted to the Trademark Trial and Appeal Board via the
ESTTA electronic filing system on 8/7/2015.

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6
7 2) I hereby certify that a copy of the Motion to Resume Proceeding and Resetting of
8 Discovery Dates was served upon aftmentioned counsel by depositing it with the United States
Post Office, postage prepaid, on 8/7/2015 via First Class Mail to the following recipient:

9
10 Law Office of Paul W. Reidl
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12 Half Moon Bay, California 94019

13
14
15 By : ____/Ken Dallara/_____
16 Ken Dallara, Esq - Attorney for Petitioner – SoCalMAICO