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

Proceeding	92063668
Party	Defendant June Francis, Ashley Kirsten C, Justin Christian C Rono
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

BARRIO FIESTA MANUFACTURING CORPORATION, Petitioner, v. JUNE FRANCIS RONO, ASHLEY KRISTEN C. RONO, AND JUSTIN CHRISTIAN C. RONO, Registrants.	Cancellation No. 92063668 In the Matter of Registration No. 4,034,365 Mark: BARRIO FIESTA EXPRESS Date Issued: October 4, 2011

REGISTRANTS' OBJECTION TO PETITIONER'S REQUEST FOR THE APPLICABILITY OF COLLATERAL ESTOPPEL IN SUPPORT OF ITS MOTION FOR SUMMARY JUDGMENT

On or around May 8, 2017 (entered as Docket # 31), Petitioner filed what ostensibly appeared to be a Notice of Granting of Summary Judgment in Favor of Northridge Foods International, LLC. in the related federal lawsuit entitled *Barrio Fiesta, LLC v. Northridge Foods International, Inc.*, United States District Court for the Northern District of California, Case Number 4:15-cv-02669 (the "Federal Lawsuit"). However, the notice goes beyond a simple notice. That document is requesting the court to apply collateral estoppel based on that accompanying order. This is inappropriate.

A. The Board Should Not Consider Papers Which Are Not Germane To The Motion For Summary Judgment

Pursuant to the Board's Suspension Order (entered as Docket # 25), the parties should not file and the Board will not consider documents which are not germane to the pending motion for summary judgment. Docket Entry # 31 is not germane to the pending motion for summary judgment and therefore should not be considered by the Board.

B. Collateral Estoppel Is Not Appropriate In This Instance

Collateral estoppel only applies where: "(1) a prior action presents an identical issue; (2) the prior action actually litigated and adjudged that issue; (3) the judgment in that prior action necessarily required determination of the identical issue; and (4) the prior action featured full representation of the estopped party." *Stephen Slesinger Inc. v. Disney Enter. Inc.*, 702 F3d 640, 644, 105 USPQ2d 1472, 1474 (Fed. Cir. 2012). See also *Levi Strauss & Co. v. Abercrombie & Fitch Trading Co.*, 719 F.3d at 1371 (2011), 107 USPQ2d at 1171; *In re Anderson*, 101 USPQ2d 1912, 1916 (TTAB 2012). (Emphasis added).

The Court of Appeals for the Federal Circuit has warned that the USPTO should use caution in applying res judicata based on an infringement action, because infringement actions and Board proceedings are "different causes of action [that] may involve different sets of transactional facts, different proofs, different burdens and different public policies. Registrability is not at issue in infringement litigation, and although the likelihood of confusion analysis presents a 'superficial similarity,' differences in transactional facts will generally avoid preclusion." *Mayer/Berkshire Copr. V. Berkshire Fashions, Inc.*, 424 F.3d 1229, 1232 (2005), 76 USPQ2d at 1313, citing *Jet, Inc. v. Sewage Aeration Systems*, 223 F.3d 1360, 1364-65 (2000), 55 USPQ2d at 1857. See also *Nasalo*k *Coating Corp v. Nylok Corp.* 522 F.3d 1320, 1324 (2008), 86 USPQ2d at 1372.

The parties in the related Federal Lawsuit and the parties to this cancellation proceeding are not the same and the issues at play are not identical. The Federal Lawsuit involved an issue of trademark infringement by Northridge Foods International, LLC. The Federal Lawsuit did not address the validity of Registrants' trademark nor did it make any finding which can be a basis for cancellation in the instant proceedings. Simply put, registrability is not an issue in infringement litigation. For these reasons the Board should not apply collateral estoppel.

Date: May 8, 2017

SAC Attorneys, LLP

/S/JAMES CAI

James Cai, Esq.
Attorney for Registrants

CERTIFICATE OF SERVICE

I hereby certify that a true copy of the foregoing REGISTRANTS' OBJECTION TO PETITIONER'S REQUEST FOR THE APPLICABILITY OF COLLATERAL ESTOPPEL IN SUPPORT OF ITS MOTION FOR SUMMARY JUDGMENT was served on counsel for Petitioner on May 8, 2017, by sending the same via EMAIL and US MAIL, to:

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/S/ DANNY BAEZ
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