

THIS OPINION IS NOT  
CITABLE AS PRECEDENT  
OF THE TTAB

UNITED STATES PATENT AND TRADEMARK OFFICE  
Trademark Trial and Appeal Board  
P.O. Box 1451  
Alexandria, VA 22313-1451

Mailed: June 30, 2005

Opposition Nos. 91152945  
91153093  
91153719  
91159969  
91159998  
91160041  
91160064

RA Brands, LLC

v.

FREDERIC REMINGTON TRUST 1861

Before Hairston, Grendel and Holtzman,  
Administrative Trademark Judges

By the Board.

These consolidated proceedings now come up on several motions: (1) opposer's motion for discovery sanctions in the form of default judgment, filed January 7, 2005; (2) applicant's request to vacate Board orders issued on July 6, 2004 and November 8, 2004,<sup>1</sup> and (3) applicant's renewed motion to dismiss, filed January 12, 2005, incorporated in applicant's response to opposer's motion for discovery sanctions in the form of default judgment.

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<sup>1</sup> This request is incorporated in "Applicant's Response to Opposer's Motion for Sanctions" filed January 21, 2005.

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Applicant's motion regarding previous Board orders.

At the outset, the Board would like to address applicant's request that the orders issued on July 6, 2004 and November 8, 2004 be vacated. As grounds for its request, applicant points out that these orders addressed potentially dispositive motions filed by applicant and should have been issued by a three-judge panel rather than by a single interlocutory attorney as provided for in 37 CFR § 2.127(c).

Applicant argues that TBMP § 102.03<sup>2</sup> requires such decision be rendered "by a panel of at least three Board judges." To the extent that these motions could have been dispositive, the better procedure was to have them decided by a three-judge panel. Although a request for reconsideration<sup>3</sup> of either of these decisions should have been filed within one month from the date thereof pursuant to 37 CFR § 2.127(b), the Board will exercise its discretion and grant the request to reconsider these orders. See TBMP § 518 (2d ed rev. 2004).

An error that applicant raises, in addition to the absence of a three-judge panel, is that the Board did not

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<sup>2</sup> Applicant's reference to § 102.03 is a reference to a section in the Trademark Trial and Appeal Board's Manual of Procedure (TBMP).

<sup>3</sup> While applicant has captioned its motion as one to vacate the prior decisions, it is more correctly a motion to reconsider those decisions as having been improperly issued.

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take judicial notice of its pending application files<sup>4</sup> and various opposition proceedings referenced in applicant's motion for judgment on the pleadings.

In support of its contention that the Board should have taken judicial notice, applicant cites to several paragraphs of the TBMP. The Board's November 8, 2004 order correctly described the judicial notice procedure as well as applicant's incorrect attempt to submit exhibits as evidence in support of its motion for judgment on the pleadings. Therefore, the Board's declining to take judicial notice of various other opposition proceedings and their content was correct.

Moreover, these motions are not well taken on the merits. It is noted that applicant in each of its motions to dismiss or its motion for judgment on the pleadings refers to a decision by the Board in Opposition No. 80,597 involving this applicant, the same mark and, according to applicant, a party in privity with the current opposer (and/or the opposer in another proceeding pending before the Board). The Board in that case dismissed the opposition as to certain classes and sustained it as to others.

Whether captioned as a motion to dismiss for failure to state a claim or a motion for judgment on the pleadings

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<sup>4</sup> The opposed application files are automatically of record pursuant to 37 CFR § 2.122(b).

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based on *res judicata*, the motion is not well taken. In sum, applicant's arguments appear to be that there can be no likelihood of confusion for two reasons: (1) the Board in a previous opposition proceeding, Opposition No. 91080597, found no likelihood of confusion in seven classes of goods before the Board at the time; and (2) that there can be no likelihood of confusion between the present goods and services of the parties because they are in different International classes and therefore are readily distinguishable. Applicant relies on a theory of collateral estoppel or *res judicata* in its first argument.

*Res judicata* is a doctrine of claim preclusion that operates between the parties simply by virtue of a final judgment on the merits by one court that merges the claim if the plaintiff prevails, or works as an absolute bar to a later identical suit, if the defendant prevails. See, Wright, Miller & Cooper, Federal Practice and Procedure: Jurisdiction § 4402. For the doctrine to apply, the final judgment must be entered on the merits, and the second suit must involve the same parties or their privies and the same cause of action. Collateral estoppel, or issue preclusion, differs from *res judicata*. Under collateral estoppel, once an issue is actually and necessarily determined by a court of competent jurisdiction, the determination will be conclusive in subsequent suits even if they are based on

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different causes of action or whether the subsequent litigation involves the same case or a different case. In this proceeding, claim preclusion is the applicable doctrine in that there is a final judgment on the merits, and the second suit involves the same parties or their privies<sup>5</sup> and the same cause of action, namely a likelihood of confusion between the marks and for the goods present in the prior proceeding. Thus, it would be under the doctrine of claim preclusion, that the second suit is barred or the judgment merged.

In the instant proceeding there is no commonality in the cause of action because, at a minimum, the goods involved in the present oppositions are different from those involved in the previous opposition.<sup>6</sup> Accordingly, the Board's decision in the prior opposition proceeding has no preclusive effect on this proceeding.

Applicant's argument that there can be no likelihood of confusion because the subject goods and services are in different International classes fails. The classification of goods or services is not relevant or conclusive in

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<sup>5</sup> We are assuming, arguendo, that there is a privity of ownership of the marks and that therefore the parties are the same.

<sup>6</sup> In Opposition No. 91080597 the involved applications were for cosmetics; eyeglasses and sunglasses; umbrellas and leather goods; clothing; carbonated apple cider and uncarbonated water; and cigarette cases. The presently opposed applications involve tequila; backpacks; plastic parts for cars; entertainment services; glass bottles and figurines; ribbons and embroidery; and business paper products.

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determining likelihood of confusion. As applicant should be aware, the classification system is used for administrative purposes by the Office to group like goods and services together. See 15 U.S.C. § 1112 and 37 CFR § 6.1. On the other hand, a determination of a likelihood of confusion is based on an analysis of all of the probative facts in evidence that are relevant to the factors set out in *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973), one factor being the similarity/dissimilarity between the goods. Additionally, the test here is not whether opposer's and applicant's goods are likely to be confused. Rather, the test is whether purchasers are likely to be confused as to source, connection or sponsorship of the goods. The goods or services do not have to be identical or even competitive in order to determine that there is a likelihood of confusion. The inquiry is whether the goods are related, not identical. See *Safety-Kleen Corp. v. Dresser Indus., Inc.*, 518 F.2d 1399, 1404, 186 USPQ 476, 480 (CCPA 1975). It is sufficient that the goods or services of the applicant and opposer are related in some manner and/or that the circumstances surrounding their marketing are such that they are likely to be encountered by the same persons under circumstances that would give rise to the mistaken belief that they originate from the same source. Thus, whether there is a likelihood of confusion,

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whether opposer's and applicant's goods are readily distinguishable is the matter to be determined in this proceeding and is not a decision that can be made summarily and without evidence under the circumstances in this case.

In light of the above, we have reviewed both the July 6 and November 8, 2004 decisions and hereby ratify the conclusions reached in those decisions. Applicant's motions to dismiss and for judgment on the pleadings were properly denied. Accordingly, applicant's request to vacate those orders is hereby denied.

Opposer's motion for discovery sanctions  
In the form of default judgment.

Opposer's motion, filed January 7, 2005, is based on applicant's lack of cooperation and compliance with previous Board orders to respond to outstanding discovery. Applicant has responded by challenging the legality of the previous Board orders; by contending that it has responded to opposer's discovery requests; and that these matters should be dismissed as there is no conceivable possibility of a similarity between the goods and services of the parties because they are all in different classes.

A summary of the relevant background may be helpful.

Previous Board statements regarding discovery.

Applicant, Frederic Remington Trust 1861, filed eight applications to register the mark FREDERIC REMINGTON in connection with numerous goods and services. After the

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applications were published for opposition, opposer timely filed a notice of opposition for each of the published applications. Opposition proceedings were instituted and, based on the identity of the marks being opposed, the Board, by order dated July 6, 2004, consolidated the proceedings between these parties under Opposition No. 91152945.

In that July 6, 2004 order, the Board discussed an attachment requesting an extension of time to answer discovery that pertained to another proceeding. Applicant was advised therein of its duty in discovery. On June 30, 2004, opposer filed its first motion to compel discovery. In a September 13, 2004 order, the Board granted opposer's motion to compel and applicant was allowed thirty days to provide full responses to opposer's discovery, without objection. Further, applicant was warned that a deliberate refusal to cooperate in discovery was a sanctionable matter and the parties were urged to cooperate, and trial dates were reset. On October 12, 2004, opposer filed its first motion for sanctions for applicant's continued failure to comply with Board rules and orders. Finally, by Board order dated November 8, 2004, in dealing with several confusing filings,<sup>7</sup> and opposer's motion for sanctions, the Board

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<sup>7</sup> Applicant had filed a "notice" that opposer's discovery was invalid because it was unnecessary due to "res judicata" issues it raised in its motion for judgment on the pleadings.



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through its inherent authority to sanction a party,<sup>8</sup> informed applicant that it was barred from filing any further "potentially dispositive" motions unless and until it either (1) obtained counsel to represent it or (2) obtained prior leave of the Board to file a motion and that leave would not be granted until it was clear that applicant had responded to all outstanding discovery requests without objection, and applicant was ordered to respond to all outstanding discovery within 30 days of the mailing date of that order. Trial dates were once again reset with discovery scheduled to close on February 15, 2005.

Opposer's current motion for discovery sanctions.

On November 29, 2004, applicant finally provided discovery responses to opposer. However, according to opposer, opposer had served two sets of discovery, one on June 4, 2003 in Opposition No. 91152945 and one on October 5, 2004 for the remaining seven oppositions. Applicant has not yet responded to the June 4, 2003 discovery and the responses received on November 29, 2004 were non-responsive, consisting of objections to opposer's discovery requests, prompting opposer to file this second motion for sanctions on January 7, 2005.

In its response to opposer's motion for sanctions, applicant fails to address, not only its delay in providing

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<sup>8</sup> See TBMP § 527.03 (2d ed. rev. 2004) and cases cited therein.

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discovery responses, but also their unresponsive nature. Rather, it argues that its previously filed and decided motions to dismiss and motion for judgment on the pleadings were improperly decided; that opposer is not entitled to sanctions because opposer has no related goods to those of applicant and opposer "has no 'genuine' likely hood [sic] of sustaining its oppositions...."

A review of applicant's discovery responses shows them to be clearly insufficient. In response to virtually all 15 interrogatories and 27 requests for production of documents, applicant stated:

"The applicant objects on the grounds the information is irrelevant and is not calculated to lead to the discovery of admissible evidence, based upon TTAB finding that FREDERIC REMINGTON® is a distinguished mark from REMINGTON® and/or REMINGTON® has no like goods/services which would cause confusion"

or

"Object to on grounds of vagueness, irrelevance, invasive of privilege of trade secrets."

[emphasis in original]. Applicant has failed to take this matter seriously and to comply with the Federal Rules of Civil Procedure, the Board rules and Board orders.

Trademark Rule 2.120(g) provides, in relevant part, that if a party fails to comply with an order of the Board relating to discovery, the Board may make any appropriate order, including the entry of default judgment as provided in Fed.

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R. Civ. P. 37(b). However, default judgment is a harsh remedy which would be justified where no less drastic remedy would be effective and where there is a strong showing of willful evasion. As such, the reason for failure to provide answers to discovery may be considered and the Board may refrain from imposing such sanctions when it seems unfair to do so.

In these proceedings opposer has diligently pursued discovery and the Board has been more than patient with applicant.

It is clear that applicant has not complied with previous Board orders requiring applicant to respond to opposer's discovery requests and finally to respond without objection. Nevertheless, taking into consideration applicant's pro se status and its apparent confusion regarding the legal issues involved in these proceedings which may have led applicant to erroneously believe that any discovery was unnecessary, and since it is the Board's policy to resolve the proceedings before it on the merits wherever it is possible to do so, the Board will exercise its discretion and allow applicant one final opportunity to comply with the order.

Applicant is cautioned, however, that this flexibility will not be extended further by the Board, which reserves the right to hold parties, whether or not they are

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represented by counsel, responsible for understanding and adhering to the rules.

We want to make it crystal clear at this point that any prior litigation between these parties, any prior decision allowing for registration of a FREDERIC REMINGTON mark, and any class that goods are put in does not preclude this opposer from having a full trial on the merits of its claims against the presently pending applications. To do so, it is imperative that applicant cooperate in the discovery process and refrain from filing any further potentially dispositive motions without prior leave of the Board.

Accordingly, opposer's motion for discovery sanctions in the form of dismissal is denied without prejudice. Applicant is allowed **THIRTY DAYS** from the mailing date of this order to answer **ALL OUTSTANDING DISCOVERY WITHOUT OBJECTION**. This includes all discovery served in each of the individual proceedings prior to consolidation.

Applicant is warned that the Board will not tolerate any further attempts to delay this case or to frustrate opposer's right to obtain discovery. Applicant is advised that its failure to comply fully and completely with this order will, upon motion by opposer, result in the entry of default judgment against applicant.

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Trial dates are hereby reset, including discovery<sup>9</sup>, as indicated below.

Discovery period to close:	<b>9/30/2005</b>
30-day testimony period for party in position of plaintiff to close:	<b>12/29/2005</b>
30-day testimony period for party in position of defendant to close:	<b>2/27/2006</b>
15-day rebuttal testimony period to close:	<b>4/13/2006</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. Trademark Rule 2.125.

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

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<sup>9</sup> On March 23, 2005 applicant filed a "Motion for Leave to Compel Discovery and Order". This motion is denied as untimely in that it was filed while proceedings were suspended, and will be given no further consideration. Parties are required to make good faith efforts to work out discovery disputes before coming to the Board.