THIS OPINION IS NOT A
PRECEDENT OF THE TTAB

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

DUNN

Mailed: October 31, 2008

Opposition No. 91161547
Opposition No. 91161549
Opposition No. 91162055
Opposition No. 91162056
Opposition No. 91162339
Opposition No. 91162374
Opposition No. 91164389
Opposition No. 91165903
Opposition No. 91165910
Opposition No. 91165928
Opposition No. 91166141
Opposition No. 91166907
Opposition No. 91167717
Opposition No. 91168594
Opposition No. 91168798
Opposition No. 91169272

L.C. Licensing, Inc.

v.

Lancome Parfums et Beaute & Cie

Before Holtzman, Cataldo, and Ritchie de Larena,
Adminstrative Trademark Judges:

By the Board:

This consolidated case comes up on applicant's motion for summary judgment on the ground of res judicata in view of the district court's decision in the civil action between these parties. The motion has been fully briefed.

Before turning to the substantive issues, we address a procedural matter. In each consolidated opposition, opposer pleads its JUICY marks in support of its claims of likelihood of confusion and dilution.[1] Because of the sixteen months between the filing of the earliest and the latest opposition, the later filed oppositions plead marks not included in the earlier oppositions. Although proceedings have been consolidated, the pleadings for each case remain separate.

The Board notes that the long suspension of proceedings pending disposition of the district court action was followed by the Board's decision to construe the papers filed in connection with the submission of the district court's order as a fully briefed motion for summary judgment. As a result, opposer has had no opportunity to amend each notice of opposition to plead its current registrations for JUICY marks originally pleaded as pending applications in the later-filed oppositions. In these circumstances, for the purpose of determining applicant's motion for summary judgment, we will consider all marks

[1] Each notice of opposition is deficient inasmuch as the allegations regarding the dilution claim do not include an allegation that opposer's marks were famous at the time the opposed application was filed. *See Polaris Industries Inc. v. DC Comics,* 59 USPQ2d 1798, 1800 (TTAB 2000).

pleaded by opposer, even though each mark is not pleaded in each opposition.[2]

THE BOARD PROCEEDINGS

In bringing its claims of dilution and likelihood of confusion against applicant's JUICY marks (listed below) for cosmetics, and in some applications personal or beauty products, opposer has pleaded the marks JUICY, JUICY COUTURE (COUTURE disclaimed), JUICY JEANS (JEANS disclaimed), JUICY GIRL, and CHOOSE JUICY for clothing; and the mark JUICY COUTURE (COUTURE disclaimed) for jewelry and clothing, for luggage, tote bags, hand bags, beach bags, all purpose sport and carrying bags, umbrellas, shoulder bags, backpacks, toiletry kits sold empty, key cases, leather key chains, and wallets, for soaps, perfumery, essential oils for personal use, perfume, eau de toilette, body splash, body lotions, body scrubs, bath soaps, bath oils, bath and shower gels, skin moisturizers, lip gloss, body powder and for watches.[3]

Opp. No.	App. Ser. No.	Mark
91161547	76529289	JUICY STAY

[2] This decision affects only the motion for summary judgment. If this case goes to trial, no consideration will be given to unpleaded registrations. *Herbaceuticals Inc. v. Xel Herbaceuticals Inc.*, 86 USPQ2d 1572, 1576 n.4 (TTAB 2008).

[3] Opposer also pleads three applications subsequently abandoned for failure to file a statement of use (Application Serial Nos. 76376646, 76497677, and 76355508). No further consideration will be given to these applications.

91161549	76529288	JUICY LAST
91162055	76520367	JUICY TOUCH
91162056	76520368	JUICY & FRESH
91162339	76521232	JUICY
91162374	76562916	JUICY CRAYON
91164389	76546370	JUICY STYLE
91165903	76605582	JUICY DROPS
91165910	76605582	JUICY DESSERT
91165928	76562912	JUICY VERNIS (VERNIS disclaimed)
91166141	79000781	JUICY WEAR
91166907	76587764	JUICY JUICE
91167717	76597755	JUICY TUBES POP
91168594	76605581	JUICY MACARON
91168798	78594270	JUICYWOOD
91169272	78594277	JUICY GELEE (GELEE disclaimed)

THE DISTRICT COURT ACTION

On April 19, 2006, the United States District Court for the Southern District of New York issued a decision entering judgment for defendant in the trademark infringement case *Juicy Couture, Inc. and L.C. Licensing, Inc. v. L'Oreal USA, Inc. and Luxury Products, LLC* (04 CIV 7203 (DLC)). The court's order noted that the complaint filed September 9,

2004 alleged seven claims, including trademark infringement and sought, among other remedies, an injunction preventing defendant from using JUICY alone or in combination with another word or phrase that means apparel or has an apparel connotation. Following the close of discovery, plaintiff substantially narrowed its claims to infringement of its registered marks JUICY, JUICY COUTURE and CHOOSE JUICY for clothing and its common law t-shirt slogans by defendant's mark JUICY WEAR for lipstick and by defendant's Juicy Gossip and Juicy Pop promotional activities in 2003 and 2004.

In its decision, because plaintiff failed to show that its t-shirt slogans are perceived as an indicator of source, the court limited consideration of the infringement issue to whether defendant's mark JUICY WEAR for lipstick and its Juicy Gossip and Juicy Pop promotional activities in 2003 and 2004 infringed opposer's registered marks for JUICY, JUICY COUTURE, and CHOOSE JUICY for clothing. The court applied the eight-factor balancing test to determine likelihood of confusion introduced in *Polaroid Corp. v. Polarid Elecs. Corp.*, 287 F.2d 492 (2nd Cir. 1961). The count found that, while several of the *Polaroid* factors favored plaintiff, the most significant factors in its determination were the lack of similarity between the marks as they are presented in the marketplace and defendant's lack of bad faith in adopting its mark. As a result the

court held that there was no basis to find that defendant's JUICY WEAR mark is likely to cause confusion with opposer's marks JUICY, JUICY COUTURE, and CHOOSE JUICY for clothing.

The court also held that, if the court were to find a likelihood of confusion, defendant's affirmative defense of laches would bar plaintiff's claim for injunctive relief, and that, because opposer withdrew its claims regarding defendant's use of the marks JUICY TUBES, JUICY ROUGE, JUICY TUBES POP, JUICY VERNIS, and JUICY CRAYON on the eve of trial, under the doctrine of waiver, defendant would be entitled to judgment in its favor with regard to all claims based on defendant's use of those marks.[4]

On October 24, 2006, the court issued an order noting that L'Oreal USA, Inc. and its Lancome Division, and Luxury Products, LLC were substituted as defendants by stipulation, that the court's earlier order determined that plaintiff failed to carry its burden on any of the claims, and inasmuch as the parties waived their right to appeal from any aspect of the court's order or judgment, judgment was entered in favor of defendant dismissing plaintiff's complaint in its entirety with prejudice.

DISCUSSION

[4] The court found defendant was not entitled to judgment based on the affirmative defense of equitable estoppel because defendant did not show any misrepresentation by plaintiff.

Under the doctrine of res judicata, or claim preclusion, a judgment on the merits in a prior suit bars a second suit involving the same parties or their privies based on the same cause of action. *Mayer/Berkshire Corp. v. Berkshire Fashions Inc.*, 424 F.3d 1229, 76 USPQ2d 1310, 1312 (Fed. Cir. 2005), *citing Parklane Hosiery Company, Inc. v. Shore*, 439 U.S. 322, 326 n.5 (1979). A second suit will be barred by claim preclusion if: (1) there is identity of parties (or their privies); (2) there has been an earlier final judgment on the merits of a claim; and (3) the second claim is based on the same set of transactional facts as the first. *Id., citing Jet, Inc. v. Sewage Aeration Systems,* 223 F.3d 1360, 55 USPQ2d 1854 (Fed. Cir. 2000). A trademark infringement action in the district court is not automatically of preclusive effect in an inter partes proceeding before the Board, because a claim for trademark infringement may not be based on the same transactional facts, or the facts relevant to infringement may not be sufficiently applicable to trademark registration to warrant preclusion. *Id.*

Here, it is clear that the parties to the consolidated opposition were also parties to the civil action, and that the civil action resulted in a final judgment on the merits of the claim. As to the third factor, at the outset we address applicant's contention that the Board need not

compare the claims at issue in the two proceedings because opposer has already agreed that the civil action would be dispositive of the Board proceedings between the parties. Specifically, applicant argues that opposer should be bound by its stipulation that the Board suspend proceedings pending the disposition of the civil action because the civil action may have a bearing on these proceedings.

As set forth above, there is a substantial difference between the breadth of plaintiff's original complaint in the civil action – which sought an injunction precluding any use of JUICY by applicant in conjunction with apparel – and the claim actually litigated, which was limited to defendant's mark JUICY WEAR for lipstick and defendant's Juicy Gossip and Juicy Pop promotional activities in 2003 and 2004. Further, applicant cites to no authority for its apparent contention that opposer's stipulation to suspension of these proceedings pending the disposition of the civil action involving the parties automatically results in the determination of that civil action being dispositive of the issues herein. Accordingly, we reject applicant's contention that opposer's agreement to suspend this Board proceeding bars opposer's argument that the district court judgment should not be given preclusive effect in this consolidated proceeding.

In consideration of the civil action and this consolidated opposition, we find significant differences in the relevant transactional facts. In its oppositions, in addition to opposer's marks JUICY, JUICY COUTURE and CHOOSE JUICY considered in the civil action, opposer pleads the marks JUICY JEANS and JUICY GIRL. Moreover, while the three marks of opposer considered in the civil action were all used on apparel, in the oppositions, opposer's pleaded marks are used on a much wider range of goods, including goods which overlap with the cosmetics and personal and beauty products with which applicant's opposed marks are intended to be used. That is, unlike in the civil action where opposer pleaded marks were used only on apparel, in its oppositions, opposer pleads dilution and likelihood of confusion between the marks in the opposed applications and opposer's pleaded mark JUICY COUTURE as used on jewelry, luggage, tote bags, hand bags, beach bags, all purpose sport and carrying bags, umbrellas, shoulder bags, backpacks, toiletry kits sold empty, key cases, leather key chains, and wallets, watches, soaps, perfumery, essential oils for personal use, perfume, eau de toilette, body splash, body lotions, body scrubs, bath soaps, bath oils, bath and shower gels, skin moisturizers, lip gloss, and body powder.

The differences in the rights asserted in the civil action are not limited to opposer. In assessing likelihood

of confusion in the civil action, the court compared opposer's three pleaded marks only to applicant's mark JUICY WEAR. In the oppositions, the Board must compare opposer's five pleaded marks to applicant's sixteen different marks JUICY STAY, JUICY LAST, JUICY TOUCH, JUICY & FRESH, JUICY, JUICY CRAYON, JUICY STYLE, JUICY DROPS, JUICY DESSERT, JUICY VERNIS, JUICY WEAR, JUICY JUICE, JUICY TUBES POP, JUICY MACARON, JUICYWOOD, and JUICY GELEE. We also note that while the court addressed likelihood of confusion in view of applicant's use of its JUICY WEAR mark, none of the opposed applications is based on use in commerce. Some of the opposed applications are based on applicant's allegation of a bona fide intent to use the marks in commerce (Trademark Act Section 1(b), others on rights in a foreign registration for the same mark and goods Trademark Act Section 44(e), and some are based a request for extension of protection (Trademark Act Section 66(a)). In short, we find that the court's determination of no likelihood of confusion between opposer's three pleaded marks JUICY, JUICY COUTURE and CHOOSE JUICY used on apparel and applicant's mark JUICY WEAR used on lipstick does not address the same transactional facts involved in the determination of likelihood of confusion between opposer's five pleaded marks JUICY, JUICY COUTURE, CHOOSE JUICY, JUICY GIRL and JUICY JEANS, used on a wider range of goods, including lip gloss and other

cosmetics, and applicant's sixteen different marks, all used on cosmetics and personal and beauty products, none of which may yet be used in commerce.

With respect to the court's decision on defendant's affirmative defenses, we find that the court's finding that waiver and laches would preclude entry of judgment for plaintiff does not mandate entry of judgment for applicant in this consolidated proceeding or in any of the individual oppositions. As to waiver, the court's finding that plaintiff, by withdrawing its claims regarding defendant's marks JUICY TUBES POP, JUICY VERNIS, and JUICY CRAYON on the eve of trial, waived its right to bring the same claims in other proceedings does not bar the instant oppositions to those marks which, as discussed, bring different claims. As to laches, the court found that plaintiff's delay in taking action is properly measured from the time it first became aware of defendant's use of the term JUICY tubes in 2001. In an opposition proceeding, laches normally cannot begin to run until the applicant's mark is published for opposition. *National Cable Television Association Inc. v. American Cinema Editors Inc.*, 937 F.2d 1572, 19 USPQ2d 1424, 1432 (Fed. Cir. 1991). Inasmuch as opposer promptly filed its notice of opposition after each of applicant's marks was published for opposition, laches is inapplicable here.

The Board's primary reviewing court has long held that res judicata is not applicable "where it is apparent that all the questions of fact and law involved in the second proceeding were not determined in the previous proceedings." *Mayer/Berkshire Corp. v. Berkshire Fashions Inc.*, at 1314, *quoting Litton Industries, Inc. v. Litronix, Inc.*, 577 F.2d 709, 198 USPQ 280 (CCPA 1978). Because the district court's judgment in the civil action between the parties has no preclusive effect on this consolidated proceeding, applicant's motion for summary judgment is denied.[5]

Proceedings herein are resumed, and opposer is allowed until thirty days from the mailing date of this order to file an amended notice of opposition in each consolidated proceeding, failing which this consolidated proceeding will go forward on the original notices of opposition. Applicant is allowed until thirty days from the date of service of any amended notice of opposition to file its answer.

Discovery and trial dates are reset below.

[5] The parties are reminded that evidence submitted in connection with a motion for summary judgment is of record only for purposes of that motion. *See* TBMP §528.05(a). The summary judgment evidence will not form part of the evidentiary record to be considered at final hearing unless it is properly introduced in evidence during the appropriate trial period. *See Levi Strauss & Co. v. R. Josephs Sportswear Inc.*, 28 USPQ2d 1464 (TTAB 1993).

DISCOVERY PERIOD TO CLOSE:	**May 1, 2009**
Thirty-day testimony period for party in position of plaintiff to close:	**July 30, 2009**
Thirty-day testimony period for party in position of defendant to close:	**September 28, 2009**
Fifteen-day rebuttal testimony period to close:	**November 12, 2009**

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 Rules 2.128(a) and (b). An oral hearing will be set only upon request filed as provided by Trademark Rule 2.129.

***

The USPTO published a notice of final rulemaking in the Federal Register on August 1, 2007, at 72 F.R. 42242. By this notice, various rules governing Trademark Trial and Appeal Board inter partes proceedings are amended. Certain amendments have an effective date of August 31, 2007, while most have an effective date of November 1, 2007. For further information, the parties are referred to a reprint of the final rule and a chart summarizing the affected rules, their changes, and effective dates, both viewable on the USPTO website via these web addresses:
http://www.uspto.gov/web/offices/com/sol/notices/72fr42242.pdf
http://www.uspto.gov/web/offices/com/sol/notices/72fr42242_FinalRuleChart.pdf

By one rule change effective August 31, 2007, the Board's standard protective order is made applicable to all TTAB inter partes cases, whether already pending or commenced on or after that date. However, as explained in the final rule and chart, this change will not affect any case in which any protective order has already been approved or imposed by the Board. Further, as explained in the final rule, parties are free to agree to a substitute protective order or to supplement or amend the standard order even after August 31,

2007, subject to Board approval. The standard protective order can be viewed using the following web address: http://www.uspto.gov/web/offices/dcom/ttab/tbmp/stndagmnt.htm