

**THIS OPINION  
IS NOT A PRECEDENT  
OF THE T.T.A.B.**

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

Lykos

Mailed: April 11, 2007

Opposition No. 91170990

Calavo Growers, Inc.

v.

Luis Calvo Sanz, S.A

Before Walters, Rogers, and Cataldo, Administrative  
Trademark Judges.

By the Board:

This case now comes up for consideration of opposer's motion (filed January 12, 2007) for summary judgment on its claim of *res judicata*. The parties have fully briefed the motion.<sup>1</sup>

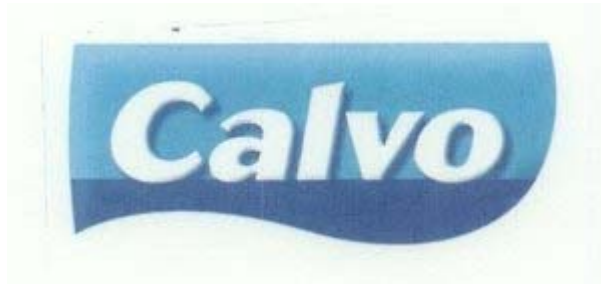
The Board has carefully reviewed the parties' respective arguments and accompanying exhibits, although the Board has not repeated the parties' arguments in this order.

I. *Background*

By way of background, on November 19, 2004, applicant applied to register the mark displayed below

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<sup>1</sup> Opposer has submitted a reply brief which the Board has exercised its discretion to consider. See Trademark Rule 2.127(a).



for "fish and canned fish" in International Class 29.<sup>2</sup>

Calavo Growers, Inc.<sup>3</sup> has opposed registration of applicant's mark on the grounds that applicant's applied-for mark (1) so resembles opposer's previously used and registered marks that it is likely to cause confusion, mistake, or deceive prospective consumers under Section 2(d) of the Lanham Act; (2) will dilute the distinctive quality of opposer's marks under Section 43(c) of the Lanham Act as amended; (3) is primarily merely a surname within the meaning of Section 2(e)(4) of the Lanham Act; and (4) is barred by the doctrine of *res judicata* based on the Board's determination in a prior proceeding involving opposer's predecessor in interest and applicant, Opposition No.

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<sup>2</sup> Application Serial No. 76621293, alleging a bona fide intention to use the mark in commerce. The color(s) blue and white is/are claimed as a feature of the mark with the following description: "The mark includes three shades of the color blue. The darkest shade of blue appears beneath the word "CALVO", while a lighter shade of blue surrounds the word "CALVO" and the lightest shade of blue is in the outermost top portion. The word "CALVO" appears in white letters surrounded by shading."

<sup>3</sup> In the notice of opposition, opposer has alleged that it is the successor-in-interest of Calavo Growers of California.

91122583, *Calavo Growers of California v. Luis Calvo Sanz, S.A.*.

The previous opposition involved applicant's application to register the mark displayed below



for "meat, fish, poultry and game; meat extracts; preserved, dried and cooked fruits and vegetables; jellies, jams; eggs, milk; edible oils; canned preserved meat and fish" in International Class 29.<sup>4</sup> In that case, opposer asserted claims of likelihood of confusion, dilution, and that applicant's mark is primarily merely a surname. See Opposer's Amended Notice of Opposition. On May 17, 2002, the Board entered default judgment against applicant, pursuant to Fed. R. Civ. P. 55(b) for applicant's failure to answer the amended notice of opposition.

On November 30, 2006, the Board, noting that the doctrine of *res judicata* serves to preclude in appropriate

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<sup>4</sup> Application Serial No. 75769566, filed August 6, 1999. The application contains the statement that the English translation of the term "CALVO" is "BALD" and that the drawing is lined for the color blue.

cases the relitigation of matters previously litigated, invited the parties to address this issue by way of a motion for summary judgment limited to the claim of *res judicata*. Opposer then filed the motion for summary judgment which is the subject of this order.

## II. *Opposer's Motion for Summary Judgment*

We will now discuss whether summary judgment is warranted in this case. Summary judgment is an appropriate method of disposing of cases in which there are no genuine issues of material fact in dispute, thus leaving the case to be resolved as a matter of law. See Fed. R. Civ. P. 56(c). A party moving for summary judgment has the burden of demonstrating the absence of any genuine issue of material fact, and that it is entitled to summary judgment as a matter of law. See *Celotex Corp. v. Catrett*, 477 U.S. 317, 106 S.Ct. 2548 (1986). The nonmoving party must be given the benefit of all reasonable doubt as to whether genuine issues of material fact exist, and the evidentiary record on summary judgment, and all inferences to be drawn from the undisputed facts, must be viewed in the light most favorable to the nonmoving party. See *Opryland USA, Inc. v. Great American Music Show, Inc.*, 970 F.2d 847, 23 USPQ2d 1471 (Fed. Cir. 1992). When the moving party's motion is supported by evidence sufficient to indicate that there is no genuine issue of material fact, and that the moving party

is entitled to judgment, the burden shifts to the nonmoving party to demonstrate the existence of specific genuinely-disputed facts that must be resolved at trial. The nonmoving party may not rest on the mere allegations of its pleadings and assertions of counsel, but must designate specific portions of the record or produce additional evidence showing the existence of a genuine issue of material fact for trial.

For the reasons explained below, we find that the doctrine of *res judicata* applies to this case.

Under the doctrine of *res judicata* (or claim preclusion), the entry of a final judgment "on the merits" of a claim (i.e., cause of action) in a proceeding serves to preclude the relitigation of the same claim in a subsequent proceeding between the parties or their privies, even in those cases where the prior judgment was the result of a default or consent. See *Lawlor v. National Screen Service Corp.*, 349 U.S. 322, 75 S.Ct. 865, 99 L.Ed. 1122 (1955); *Chromalloy American Corp. v. Kenneth Gordon, Ltd.*, 736 F.2d 694, 222 USPQ 187 (Fed. Cir. 1984); and *Flowers Industries, Inc. v. Interstate Brands Corp.*, 5 USPQ2d 1580 (TTAB 1987). A second suit is barred by *res judicata* or claim preclusion if

- (1) the parties (or their privies) are identical;

(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.

*Jet, Inc. v. Sewage Aeration Systems*, 223 F.3d 1360, 55 USPQ2d 1854, 1856 (Fed. Cir. 2000).

*A. The Parties (or Their Privies) are Identical*

No genuine issue of material fact exists regarding the first factor of the res judicata analysis -- that the present opposition involves the same parties or their privies as the prior opposition. Opposer has submitted evidence in the form of a declaration from Bruce Spurrell, Director of Purchasing and Risk Management for opposer, attesting that opposer is the successor-in-interest of Calavo Growers of California, the plaintiff in the prior case. Specifically, Mr. Spurrell asserts that opposer acquired all the rights, title, and interest of the Calavo Growers of California (including the CALAVO trademark registrations and applications) pursuant to a merger and reorganization of the companies. Para. 3, Spurrell Declaration. Applicant has submitted no evidence to rebut the assertions contained therein.

*B. There Has Been an Earlier Final Judgment on the Merits of a Claim*

With regard to the second factor of the *res judicata* analysis, there is no genuine issue of material fact that there has been an earlier final judgment on the merits of a claim. As noted *inter alia*, the Board entered default judgment against applicant in the prior opposition. It is well established that a default judgment can operate as a final judgment on the merits for *res judicata*. See *International Nutrition Co. v. Horphag Research Ltd.*, 55 USPQ2d 1492 (Fed. Cir. 2000) and cases cited therein; see generally *Wright, Miller & Cooper*, 18A Federal Practice and Procedure Civil 2d § 4440 (1999).

C. *The Second Claim is Based On the Same Set of Transactional Facts as the First*

It is undisputed that the subsequent claims are based on the same set of transactional facts as the first. There is no genuine issue of material fact that the claims asserted by opposer in both proceedings are identical.

In addition, it is undisputed that the literal element of the marks at issue are identical. Applicant's slight modification to the design element of its current application cannot serve to avoid *res judicata*. *Miller Brewing Company v. Coy International Corporation*, 230 USPQ 675 (TTAB 1986) ("*Miller Brewing*") provides an apt illustration of this principle. In *Miller Brewing*, the Board found that the doctrine of *res judicata* applied to an

applicant's second mark because the second mark differed from the first mark only insignificantly, and applicant had abandoned the application for the first mark resulting in a judgment against the applicant. In reaching its determination, the Board emphasized that it did not "wish to encourage losing parties to insignificantly modify their marks after an adverse ruling and thereby avoid the *res judicata* effect of the prior adjudication." See also *Aromatique Inc. v. Lang*, 25 USPQ2d 1359 (TTAB 1992).

Lastly, there is no genuine issue of material fact that the goods of applicant's present application are merely a narrowed version of the goods from applicant's prior application. Applicant cannot avoid the estoppel effect of a prior decision by filing a second application that contains a narrower definition of the goods that were "fully encompassed" in the previous application. See *J.I. Case Co. v. F.L. Industries, Inc.*, 229 USPQ 697 (TTAB 1986).

In sum, there is no genuine issue of material fact that the requisite elements for *res judicata* have been satisfied. In view thereof, opposer's motion for summary judgment is granted on its claim of *res judicata*. The opposition is sustained, and registration of applicant's mark is refused.

The Board notes, however that applicant, in its answer to the notice of opposition, counterclaimed to cancel five of opposer's pleaded registrations on the grounds that the



mark CALAVO has become generic for the goods and services identified therein, and that the registrations were fraudulently procured from the USPTO.

In view thereof, applicant is allowed until twenty (20) days from the mailing date of this order to indicate whether it would like to proceed on the counterclaims, failing which said counterclaims shall be dismissed.