

THIS ORDER 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  
General Contact Number: 571-272-8500  
General Email: [TTABInfo@uspto.gov](mailto:TTABInfo@uspto.gov)

mbm

May 14, 2020

Opposition No. 91205049 (**Parent**)  
Opposition No. 91205093

*Productos Lacteos Tocumbo, S.A. DE C.V.*

*v.*

*PLM Operations, LLC<sup>1</sup>*

---

Opposition No. 91205466  
Opposition No. 91205468

*PLM Operations, LLC*

*v.*

*Productos Lacteos Tocumbo, S.A. DE C.V.*

Before Zervas, Dunn, and Hudis,  
Administrative Trademark Judges.

By the Board:

This proceeding now comes up on consideration of the motion of Productos Lacteos Tocumbo, S.A. DE C.V. (“Prolacto”) for summary judgment, filed November 29, 2019

---

<sup>1</sup> The caption has been changed to reflect the substitution of PLM Operations, LLC (“PLM”), for Paleteria La Michoacana, LLC. Paleteria La Michoacana, LLC filed a name change to Paleteria La Michoacana (Sub), Inc. on April 10, 2014. Reel/Frame 5258/0110. Paleteria La Michoacana (Sub), Inc. then assigned the entire interest in and to each of its marks and involved applications in these proceedings to PLM on April 8, 2016. Reel/Frame 5768/0404. PLM was substituted as the party in interest during the pendency of the Civil Action, discussed *infra*. For convenience, the Board refers to these parties as “PLM” in this order.

(24 TTABVUE), and the motion of PLM Operations, LLC (“PLM”) for partial summary judgment, filed December 2, 2019 (26 TTABVUE). On December 31, 2019, Prolacto filed a combined motion to strike PLM’s motion for partial summary judgment and a response thereto (28 TTABVUE).

### **I. Background of Prior Board Proceeding and Civil Action**

On April 27, 2007, in Cancellation No. 92047438, Prolacto petitioned to cancel Registration No. 3210304 (the “Prior Board Proceeding”) for the mark LA INDITA MICHOCANA and Design, as shown below, for “ice cream and fruit ice products, namely fruit bars” in International Class 30.<sup>2</sup>



On May 20, 2011, the Board granted Prolacto’s petition to cancel on the sole ground of likelihood of confusion, based on Prolacto’s prior use of its own Indian Girl design mark, as shown below (“Prolacto’s Indian Girl Design Mark”):<sup>3</sup>

---

<sup>2</sup> Registration No. 3210304, issued February 20, 2007. “The color dark pink appears in the wording ‘LA INDITA,’ the skirt, the girl’s veil and the ice cream; black appears in the girl’s hair, shoes, belt, the wording ‘MICHOCANA,’ the outline of the wording ‘LA INDITA’ and the outline of the girl; white appears on the girl’s shirt, skin and ice cream cone.”

<sup>3</sup> Prolacto summary judgment motion, 24 TTABVUE 64-70.



The Board also found a likelihood of confusion with respect to Prolacto's prior use of its marks LA MICHOACANA, LA MICHOACANA NATURAL and LA MICHOACANA NATURAL and Design.<sup>4</sup> The Board found, however, that there was no likelihood of confusion with respect to PLM's involved mark and Prolacto's Registration Nos. 3249113 and 2830401 for the mark LA FLOR DE MICHOACAN and LA FLOR DE MICHOACAN and Design, respectively.<sup>5</sup> The Board denied PLM's request for reconsideration on July 13, 2011.<sup>6</sup>

PLM filed a civil action in the United States District Court for the District of Columbia, entitled *Paleteria La Michoacana, Inc. v. Productos Lacteos Tocumbo S.A. de C.V.*, Civ. No. 1:11-cv-01623-RC (the "Civil Action"), seeking, inter alia, reversal of the Board's cancellation of PLM's Registration No. 3210304 and asserting other likelihood of confusion claims, as well as seeking determinations and remedies including: (1) a declaratory judgment of no likelihood of confusion as to PLM's LA INDITA MICHOACANA mark and Prolacto's marks based on their common use of the word "MICHOACANA"; (2) a finding of infringement by Prolacto's Indian Girl



---

<sup>4</sup> *Id.*

<sup>5</sup> *Id.*

<sup>6</sup> *Id.* at 72-85.



Design Mark of PLM’s marks  and  (“PLM’s Indian Girl Design Marks”, the subject of Registration Nos. 2905172 and 2968652); and (3) cancellation of Prolacto’s Registration No. 3249113 for the mark LA FLOR DE MICHOACAN and Design and Registration No. 2830401 for the mark LA FLOR DE MICHOACAN (together, the “LA FLOR DE MICHOACAN Marks”), only in the event the court finds likelihood of confusion between those marks and PLM’s marks on the ground that PLM has priority. Additionally, PLM pleaded that Prolacto had abandoned any rights it had in any of its marks through naked licensing. *Paeteria La Michoacana, Inc. et al. v. Productos Lacteos Tocumbo S.A. DE C.V.*, 188 F. Supp. 3d 22 (D.D.C. 2016).<sup>7</sup>

In the Civil Action, Prolacto asserted numerous counterclaims against PLM, including: (1) PLM’s infringement of Prolacto’s marks of Registration Nos. 3249113 and 2830401; (2) trademark infringement, unfair competition, passing off, false advertising, false association, and false designation under Section 43(a) of the Trademark Act, 15 U.S.C. § 1125(a); (3) common law trademark infringement; (4) dilution under Section 43(c) of the Trademark Act, 15 U.S.C. § 1125(c); and (5) cancellation of two of PLM’s registrations, Registration Nos. 2968652 and 2905172, on the grounds of fraud and abandonment. *Id.*

---

<sup>7</sup> Prolacto failed to attach a copy of the district court order or the court of appeals order with its motion for summary judgment. In the interest of deciding a fully briefed motion, the Board reviewed the decisions through a legal subscription service. However, Prolacto is ordered to file a copy of the district court decision and the court of appeals decision for the public record within ten days of this order, failing which the Board may consider appropriate sanctions.

The District Court found that PLM established it was then national senior user of both the “LA MICHOACANA” mark and its Indian Girl Design Marks. *Id.* at 87-88, 98-109. Notwithstanding this finding, the District Court found that the Indian girl design in PLM’s Registration No. 3210304, which PLM began using at a later date, was materially different from PLM’s Indian Girl Design Marks and, therefore, PLM was unable to rely on the earlier priority date for its Indian Girl Design Marks through the tacking doctrine. *Id.* at 56-60. In the absence of tacking, Prolacto had prior use of its Indian Girl Design Mark, but only with respect to PLM’s Registration No. 3210304. *Id.* at 60, 100. The District Court therefore affirmed the Board’s cancellation of Registration No. 3210304, on modified grounds. *Id.*

With respect to the remaining claims and counterclaims, the District Court found, in relevant part, the following: (1) PLM had prior use of its Indian Girl Design Mark and Prolacto’s Indian Girl Design Mark infringed PLM’s prior rights in its marks; and (2) PLM failed to establish that any of Prolacto’s marks had been abandoned due to naked licensing. *Id.* at 92-94, 107. Additionally, the District Court affirmed the Board’s finding of no likelihood of confusion with respect to PLM’s LA FLOR DE MICHOACAN Marks. *Id.* at 107-08. Inasmuch as PLM’s infringement claims against Prolacto’s LA FLOR DE MICHOACAN Marks were contingent upon a finding of a likelihood of confusion, the District Court dismissed the claims as moot. *Id.*

On appeal, the United States Court of Appeals for the District of Columbia Circuit affirmed the District Court’s decision. *Paeteria La Michoacana, Inc. v. Productos*

*Lacteos Tocumbo S.A. DE C.V.*, 743 Fed. Appx. 457, 128 USPQ2d 1172 (D.C. Cir. Aug. 10, 2018).

## II. Background to these Consolidated Board Proceedings

PLM seeks to register the mark LA INDITA MICHOACANA and Design, as shown below, for “Frozen confections, ice cream, ice cream bars, ice cream sandwiches, fruit ices, freezer pops, fruit ice bars” in International Class 30:<sup>8</sup>



On May 2, 2012, in Opposition No. 91205049, Pro lacto filed a notice of opposition opposing registration of Application No. 85393112 on the following grounds: deceptiveness pursuant to Section 2(a) of the Trademark Act, 15 U.S.C. § 1052(a); false suggestion of a connection pursuant to Section 2(a) of the Trademark Act, 15 U.S.C. § 1052(a); likelihood of confusion pursuant to Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d); the mark is primarily geographically deceptively

---

<sup>8</sup> Application Serial No. 85393112, filed August 9, 2011, based on an allegation of a bona fide intent to use the mark in commerce under Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b). The description of the mark is as follows: The mark consists of ‘LA INDITA MICHOACANA’ displayed in white in a stylized format. The words LA INDITA contains[sic] cream shadowing and is outlined in pink. The entire phrase ‘LA INDITA MICHOACANA’ is outlined in maroon. Displayed above the words is an image of a girl wearing a pink veil and a pink and white dress with green appliqué on the collar. The girl's hair is brown and is braided with a green ribbon on each braid. In the background are two snow-capped mountains shown in white, brown and green. The design of the girl, mountains and words are enclosed in a maroon circle.” “MICHOACANA” is disclaimed. The listed translation of “La Indita” is “little Indian girl.”

Opposition Nos. 91205049, 91205093, 91205466, and 91205468

misdescriptive pursuant to Section 2(e)(3) of the Trademark Act, 15 U.S.C. § 1052(e)(3); dilution pursuant to Section 43(c) of the Trademark Act, 15 U.S.C. § 1025(c); and fraud.

PLM also seeks to register the mark LA INDITA, in standard characters, for “Frozen confections, ice cream, ice cream bars, ice cream sandwiches, fruit ices, freezer pops, fruit ice bars” in International Class 30.<sup>9</sup>

On May 9, 2012, in Opposition No. 91205093, Prolacto filed a notice of opposition opposing registration of PLM’s LA INDITA mark on the following grounds: deceptiveness pursuant to Section 2(a) of the Trademark Act; false suggestion of a connection pursuant to Section 2(a) of the Trademark Act; likelihood of confusion pursuant to Section 2(d) of the Trademark Act; dilution pursuant to Section 43(c) of the Trademark Act; and fraud.

In each of these proceedings, PLM filed answers denying the salient allegations in the notice of opposition and asserting numerous affirmative defenses. PLM also asserted identical counterclaims to cancel Prolacto’s pleaded Registration Nos. 2830401 and 3249113 in each proceeding.

Specifically, PLM asserted the following counterclaims against Registration No. 2830401: priority only in the event the Board finds a likelihood of confusion; and abandonment based on non-use and naked licensing.

---

<sup>9</sup> Application Serial No. 85378387, filed July 22, 2011, pursuant to an allegation of a bona fide intent to use under Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b), 15 U.S.C. § 1051(b). The listed English translation of “La Indita” is “little Indian girl.”

Additionally, PLM asserted a counterclaim to cancel Prolacto's pleaded Registration No. 3249113 on the following grounds: priority only in the event the Board finds a likelihood of confusion; abandonment based on non-use and naked licensing; and nonuse as of the filing date of the underlying application.

Prolacto seeks to register the mark LA MICHOACANA, in standard characters, for the following:<sup>10</sup>

- “Blank or partially printed paper labels; Bottle wrappers of cardboard or paper; Boxes of cardboard or paper; Boxes, cartons, storage containers, and packaging containers made of paper or cardboard; Cardboard cartons; Containers for ice made of paper or cardboard; Packaging containers of paper; Paper cartons for delivering goods; Paper take-out cartons for food; Storage containers made of paper” in International Class 16;
- “Beverage glassware; Cups; Ice cream scoops; Paper and plastic cups” in International Class 21;
- “Baseball caps and hats; Cap visors; Caps; Jerseys; Pants; Polo shirts; Shirts; Short-sleeved or long-sleeved t-shirts; Sport shirts; T-shirts; Visors” in International Class 25;
- “Beverages having a milk base; Dairy products excluding ice cream, ice milk and frozen yogurt; Dairy-based snack foods excluding ice cream, ice milk and frozen yogurt; Milk drinks containing fruits; Milk products excluding ice cream, ice milk and frozen yogurt” in International Class 29;
- “Coffee based beverages; Cones for ice cream; Edible fruit ices; Flavorings for beverages; Frozen yoghurt; Fruit ice; Fruit ice bar; Ice candies; Ice cream; Ice cream desserts; Ice cream drinks; Ice-cream cakes” in International Class 30;
- “Bottled drinking water; Flavored waters; Frozen fruit beverages; Fruit beverages; Fruit juices and fruit drinks; Fruit-based beverages; Ice cream soda; Smoothies; Sorbets in the form of beverages” in International Class 32;

---

<sup>10</sup> Application Serial No. 85405347, filed August 23, 2011, pursuant to Section 1(a) of the Trademark Act, 15 U.S.C. § 1051(a). The listed translation of “LA MICHOACANA” is “the woman from ‘Michoacana.’”



- “Retail ice cream store services” in International Class 35;
- “Distribution services, namely, delivery of dairy products, ice-cream, flavored waters and bottled drinking waters” in International Class 39; and
- “Ice cream parlors; Ice cream shop services in the nature of a restaurant” in International Class 43.

Prolacto also seeks to register the mark LA MICHOACANA NATURAL and Design, as shown below:<sup>11</sup>



The application seeks registration in connection with the following goods and services:

- “Blank or partially printed paper labels; Bottle wrappers of cardboard or paper; Boxes of cardboard or paper; Boxes, cartons, storage containers, and packaging containers made of paper or cardboard; Cardboard cartons; Containers for ice made of paper or cardboard; Packaging containers of paper; Paper cartons for delivering goods; Paper take-out cartons for food; Storage containers made of paper” in International Class 16;
- “Beverage glassware; Cups; Ice Cream scoops; Paper and plastic cups” in International Class 21;

---

<sup>11</sup> Application Serial No. 85408561, filed August 26, 2011, pursuant to Section 1(a) of the Trademark Act, 15 U.S.C. § 1051(a). The word “NATURAL” and the design of an ice cream bar on a stick are disclaimed. The listed English translation of “LA MICHOACANA NATURAL” is “the natural woman from Michoacan.” The description of the mark is as follows: “The mark consists of the words ‘LA MICHOACANA’ in stylized letters, above the word ‘NATURAL’. At the center of the mark, there is an ice cream bar on a stick. All the words are encircled by a broken oval-shaped ring, which features a butterfly in the opening at the upper right corner.”

- “Baseball caps and hats; Cap visors; Caps; Jerseys; Pants; Polo shirts; Shirts; Short-sleeved or long-sleeved t-shirts; Sport shirts; T-shirts; Visors” in International Class 25;
- “Beverages having a milk base; Dairy products excluding ice cream, ice milk and frozen yogurt; Dairy-based snack foods excluding ice cream, ice milk and frozen yogurt; Milk drinks containing fruits; Milk products excluding ice cream, ice milk and frozen yogurt” in International Class 29;
- “Bottled drinking water; Flavored waters; Frozen fruit beverages; Fruit beverages; Fruit juices and fruit drinks; Fruit-based beverages; Ice cream soda; Smoothies; Sorbets in the form of beverages” in International Class 32;
- “Distribution services, namely, delivery of dairy products, ice-cream, flavored waters and bottled drinking waters” in International Class 39; and
- “Ice cream parlors; Ice cream shop services in the nature of a restaurant” in International Class 43.

On June 6, 2012, PLM filed separate notices of opposition opposing registration of Application Serial Nos. 85405347 and 85408561 on the following grounds: likelihood of confusion; the marks are merely descriptive; fraud; genericness; abandonment; and nonuse.

On September 5, 2012, the Board consolidated Opposition Nos. 91205049, 91205093, 91205466, and 91205468 and suspended proceedings pending disposition of the Civil Action.<sup>12</sup>

On April 4, 2019, in response to a status inquiry from the Board, Prolacto advised that the Civil Action had been concluded and filed a contemporaneous motion for summary judgment.<sup>13</sup>

---

<sup>12</sup> 11 TTABVUE.

<sup>13</sup> 16, 17 TTABVUE.

On September 30, 2019, the Board denied the motion for summary judgment without prejudice as premature, because the Board had not lifted the suspension.<sup>14</sup> The Board lifted the suspension based on the civil action, but again suspended the proceedings for sixty days to allow either party to file a timely motion for summary judgment.

It was then brought to the Board's attention that PLM and Prolacto are both parties to Opposition No. 91245908 and Cancellation Nos. 92070644 and 92070670, each of which had been suspended pending disposition of pending motions. The Board therefore suspended Opposition Nos. 91205049, 91205093, 91205466, and 91205468 pending disposition of the pending motions and advised the parties that the Board would consider consolidation and reset dates upon resumption.<sup>15</sup>

On November 29, 2019, before the Board formally lifted the suspension or reset dates, Prolacto again filed a motion for summary judgment.<sup>16</sup> On December 2, 2019, PLM filed its own motion for summary judgment.<sup>17</sup> Although both motions were filed before the Board formally lifted the suspension, in the interests of efficiency and under the Board's inherent authority to manage its own docket, we consider the motions for summary judgment at this juncture.

---

<sup>14</sup> 22 TTABVUE.

<sup>15</sup> 23 TTABVUE.

<sup>16</sup> 24 TTABVUE.

<sup>17</sup> 26 TTABVUE.

### **III. PLM's Motion for Partial Summary Judgment and Prolacto's Motion to Strike PLM's Motion for Partial Summary Judgment**

Prolacto filed its motion for summary judgment on claim and issue preclusion based upon the Prior Board Proceeding and the Civil Action. PLM filed its own motion for summary judgment on the same issues, namely, claim and issue preclusion. PLM then filed a separate response to Prolacto's summary judgment motion on the same issue on December 30, 2019.<sup>18</sup>

A brief in response to a motion for summary judgment or a cross-motion for summary judgment on the same issue is limited to twenty-five pages.<sup>19</sup> Trademark Rule 2.127(a), 37 C.F.R. § 2.127(a) ("Neither the brief in support of a motion nor the brief in response to a motion shall exceed twenty-five pages in length in its entirety, including table of contents, index of cases, description of the record, statement of the issues, recitation of the facts, argument, and summary."). *See also* TRADEMARK TRIAL AND APPEAL BOARD MANUAL OF PROCEDURE (June 2019) (TBMP) §§ 528.01-528.02 and authorities cited therein. "[O]ne cannot subvert the [page] limit by filing both a brief in opposition and a separate brief in support of a cross-motion, when both address the same issue." *Cooper Techs. Co. v. Denier Electric Co.*, 89 USPQ2d 1478, 1479 (TTAB 2008). The combined length of PLM's cross-motion and response to Prolacto's motion is, at a minimum, forty-nine pages in length. Accordingly, PLM has exceeded the total

---

<sup>18</sup> 27 TTABVUE.

<sup>19</sup> Upon the filing of Prolacto's motion for summary judgment, proceedings were suspended with respect to all matters not germane to the summary judgment motion. Trademark Rule 2.127(d), 37 C.F.R. § 2.127(d). Accordingly, although not styled as such, PLM's December 2, 2019 motion is considered a cross-motion for summary judgment.

number of pages allowed under Trademark Rule 2.127(a) by filing a separate cross-motion and response on the same issue. In view thereof, we have given PLM's December 2, 2019 motion for summary judgment no consideration.<sup>20</sup>

Accordingly, Prolacto's motion to strike PLM's motion for partial summary judgment is **moot**.<sup>21</sup> We exercise our discretion, however, to consider PLM's response to Prolacto's motion for summary judgment, inasmuch as the response is twenty-four pages and in view of the potentially dispositive nature of the motion.<sup>22</sup>

#### **IV. Prolacto's Motion for Summary Judgment**

Prolacto moves for summary judgment in each of these consolidated proceedings on the doctrines of claim and issue preclusion based on the Prior Board Proceeding and the Civil Action. Additionally, Prolacto alleges that PLM's claim that Prolacto's

---

<sup>20</sup> Although we give no consideration to PLM's motion for partial summary judgment, we note that PLM's reply brief in support thereof, filed January 21, 2020, also exceeds the 10-page limit for reply briefs set forth in Trademark Rule 2.127(a).

<sup>21</sup> Prolacto's motion to strike was based, in part, on the fact that PLM's December 2, 2019 filing exceeded twenty-five pages, including the notice of motion and signature block. PLM argued that neither the notice of motion nor the signature block should count toward the twenty-five page limit. In view of the fact that PLM's cross-motion and response clearly exceeded the twenty-five page limit of Trademark Rule 2.127(a), we need not and do not decide whether the December 2, 2019 filing, standing alone, exceeded the twenty-five page limit. We note, however, that it is unnecessary for a party to file a separate notice of motion and brief in support of a motion and PLM should not do so in future filings. Additionally, inasmuch as we have given the December 2 filing no consideration, we do not reach Prolacto's alternative arguments for moving to strike the brief or evidence attached thereto.

<sup>22</sup> For the same reasons explained above, to the extent PLM's response to Prolacto's motion for summary judgment can be construed as seeking entry of summary judgment in PLM's favor as the nonmoving party—or judgment in its favor based on its separately filed partial summary judgment motion—the request is given no consideration.

involved marks are merely descriptive are barred under the doctrine of judicial estoppel and that other courts have found Prolacto's mark to be distinctive.<sup>23</sup>

In this case, the deadline for serving initial disclosures has not yet passed and there is no indication in Prolacto's motion that it served initial disclosures prior to or contemporaneously with its summary judgment motion. A party may not file a motion for summary judgment until it has served initial disclosures unless the motion is based upon claim or issue preclusion. Trademark Rule 2.127(e)(1). A motion for summary judgment on any other ground would be premature.<sup>24</sup> Accordingly, to the extent Prolacto seeks summary judgment on any ground other than the doctrines of claim or issue preclusion, the motion is premature and will be given no consideration.

Additionally, in its motion for summary judgment, Prolacto alleges that PLM violated Fed. R. Civ. P. 11.<sup>25</sup> To the extent Prolacto is seeking sanctions under Fed. R. Civ. P. 11, the argument is not well taken. Any motion for Rule 11 sanctions must be filed separately from any other filing and must comply with the safe harbor

---

<sup>23</sup> In support of its summary judgment motion, Prolacto attaches a decision from the U.S. District Court for the Western District of North Carolina, *La Michoacana Natural, LLC v. Luis Maestre et al.*, Case No. 3:17-cv-00727, and a decision from the U.S. District Court for the Middle District of Florida, *Prolacto Mich Florida, LLC v. La Mejor Michoacana Ice Cream Inc. and Miguel*, 2:17-cv-658. Prolacto appears to attach these decisions to support its contention that its LA MICHOCACANA marks are distinctive. Prolacto does not appear to argue that these decisions should be given preclusive effect against PLM in these proceedings, nor is it clear that they could serve as the basis for claim or issue preclusion. PLM was not a party to either proceeding. Moreover, PLM asserts that the North Carolina action is still ongoing. 27 TTABVUE 20-21. Accordingly, neither decision appears to support the application of claim or issue preclusion to these proceedings.

<sup>24</sup> Moreover, a party may not move for summary judgment on an unpleaded claim or defense. Fed. R. Civ. P. 56(a); *see also* TBMP § 528.07(a) and cases cited therein.

<sup>25</sup> 24 TTABVUE 16.

provision of Fed. R. Civ. P. 11(c)(2). 37 C.F.R. § 11.18(c) (“Violations of any of paragraphs (b)(2)(i) through (iv) of this section are, **after notice and reasonable opportunity to respond...**”) (emphasis added); *see also See Penthouse Digital Media Productions Inc. v. Cloudstreet Inc.*, 98 USPQ2d 1496, 1499 n.6 (TTAB 2010) (“[A] motion for Rule 11(c) sanctions that violates Fed. R. Civ. P. 11(b) may result in entry of Rule 11(c) sanctions against the party that files such a motion.”). Accordingly, there is no motion for Rule 11 sanctions properly before the Board, and therefore Prolacto’s request for sanctions is given no consideration. *Cf. Lewis Silkin LLP v. Firebrand*, 129 USPQ2d 1015, 1020 (TTAB 2018) (noting that a Rule 11 motion “is a serious accusation of misconduct with specific procedural requirements, and should not be employed as a throwaway argument reflecting a party’s belief that the adverse party will be unable to prove its claims (or defenses).”). Thus, to the extent Prolacto’s motion seeks Fed. R. Civ. P. 11 sanctions, the motion is **denied**, without prejudice, as procedurally deficient.<sup>26</sup>

Finally, Prolacto’s motion includes a request for an oral hearing. Pursuant to Trademark Rule 2.127(a), an oral hearing will not be held on a motion except on order by the Board. The Board rarely grants requests for oral hearing on motions. *See*

---

<sup>26</sup> Further, “Rule 11 motions should not be made ... to test the legal sufficiency or efficacy of allegations in the pleadings...” Advisory Committee Notes to 1993 Amendments to Fed. R. Civ. P. 11; 5A Charles A. Wright & Arthur R. Miller, *Federal Prac. and Proc.* § 1335 (4th ed. 2020) (“Rule 11 should not be used to raise issues as to the legal sufficiency of a claim or defense that more appropriately can be disposed of by a motion to dismiss, a motion for judgment on the pleadings, a motion for summary judgment, or a trial on the merits.”); *see also Blue v. U.S. Dep’t of the Army*, 914 F.2d 525, 535 (4th Cir. 1990), *cert. denied sub nom., Chambers v. U.S. Dep’t of the Army*, 499 U.S. 959 (1991) (“[C]laims that are plainly meritless should be disposed of early in the course of litigation through summary judgment or other pretrial motion.”).

TBMP § 502.03 and authorities cited therein. We find that the issues presented in Prolacto's motion do not necessitate an oral hearing and therefore **deny** the request.

#### **A. Summary Judgment Standard**

Summary judgment is appropriate where the movant shows that there is no genuine dispute as to any material fact and that it is entitled to judgment as a matter of law. Fed. R. Civ. P. 56(a). A party asserting that a fact cannot be or is genuinely disputed must support its assertion by either (1) citing to particular parts of materials in the record, or (2) showing that the materials cited do not establish the absence or presence of a genuine dispute, or that an adverse party cannot produce admissible evidence to support the fact. Fed. R. Civ. P. 56(c).

A movant for summary judgment carries the burden of proof in regard to its motion. *See Celotex Corp. v. Catrett*, 477 U.S. 317, 323-24 (1986). In deciding the motion, the function of the Board is not to try issues of fact, but to determine if there are any genuine disputes of material fact to be tried. *See* TBMP § 528.01 and cases cited therein. *See, e.g., Chutter, Inc. v. Great Concepts, LLC*, 119 USPQ2d 1865, 1867 (TTAB 2016) (citing *Lloyd's Food Prods., Inc. v. Eli's, Inc.*, 987 F.2d 766, 25 USPQ2d 2027, 2029 (Fed. Cir. 1993) and *Olde Tyme Foods, Inc. v. Roundy's, Inc.*, 961 F.2d 200, 22 USPQ2d 1542, 1542 (Fed. Cir. 1992)). When the moving party has supported its motion with sufficient evidence that, if unopposed, indicates there is no genuine dispute of material fact, the burden then shifts to the non-moving party to demonstrate the existence of a genuine dispute of material fact to be resolved at trial. *Enbridge, Inc. v. Excelerate Energy LP*, 92 USPQ2d 1537, 1540 (TTAB 2009).



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 Am. Music Show, Inc.*, 970 F.2d 847, 23 USPQ2d 1471, 1472 (Fed. Cir. 1992).

### **B. Standing**

Prolacto, as plaintiff in Opposition Nos. 91205049 and 91205093, must establish that there is no genuine dispute of material fact as to its standing, which is a threshold issue that must be pleaded and proved by the plaintiff in every inter partes case. *See Empresa Cubana Del Tabaco v. Gen Cigar Co.*, 753 F.3d 1270, 111 USPQ2d 1058, 1062 (Fed. Cir. 2014); *Ritchie v. Simpson*, 171 F.3d 1092, 50 USPQ2d 1023, 1025-26 (Fed. Cir. 1999). Prolacto's motion for summary judgment is completely devoid of any discussion of its standing. Nevertheless, for purposes of this motion only, we find that there is no genuine dispute of material fact as to Prolacto's standing based on its position as defendant in the Civil Action.<sup>27</sup> *See Domino's Pizza, Inc. v. Little Caesar Enters., Inc.*, 7 USPQ2d 1359, 1363-64 (TTAB 1988) (finding standing where opposer was defendant in a civil action between the parties regarding the same mark).

### **C. Claim and Issue Preclusion**

---

<sup>27</sup> Each plaintiff must maintain its standing throughout this proceeding and affirmatively prove its standing at trial as an element of its case-in-chief. *See Lipton Indus., Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185, 189 (CCPA 1982); *Apollo Med. Extrusion Techs., Inc. v. Med. Extrusion Techs., Inc.*, 123 USPQ2d 1844, 1848 (TTAB 2017).

Under the doctrine of claim preclusion, the entry of a final judgment “on the merits” of a claim (i.e., the cause of action) in a proceeding “prevents litigation of all grounds for, or defenses to, recovery that were previously available to the parties, regardless of whether they were asserted or determined in the prior proceeding.” *Brown v. Felsen*, 442 U.S. 127, 131 (1979) (superseded by statute on other grounds).

For claim preclusion to be applied against a party who was plaintiff in the first case, the following factors must be present:

- (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 Sys.*, 223 F.3d 1360, 55 USPQ2d 1854, 1856 (Fed. Cir. 2000).

Where the party against whom claim preclusion is asserted was a defendant in a prior proceeding, claim preclusion applies only if: (1) the claim or defense asserted in the second action was a compulsory counterclaim that the defendant failed to assert in the first action; or (2) the claim or defense represents what is essentially a collateral attack on the judgment in the first case. *Nasalok Coating Corp. v. Nylok Corp.*, 522 F.3d 1320, 86 USPQ2d 1369, 1372 (Fed. Cir. 2008).

Under the doctrine of issue preclusion, re-litigation of the same issue is barred in a later action. *See B&B Hardware, Inc. v. Hargis Indus., Inc.*, 135 S. Ct. 1293, 113 USPQ2d 2045, 2051 (2015). In order for issue preclusion to apply, the following requirements must be met:

- (1) Identity of an issue in the current and prior proceeding;
- (2) Actual litigation of that issue in the prior proceeding;

- (3) That determination was necessary in entering judgment in the prior proceeding; and
- (4) That the party with the burden of proof on that issue in the second proceeding had a full and fair opportunity to litigate the issue in the prior proceeding.

*See NH Beach Pizza LLC v. Cristy's Pizza Inc.*, 119 USPQ2d 1861, 1864 (TTAB 2016).

Whether issue preclusion applies is a question of law and, where “the facts material to issue preclusion are not in dispute,” summary judgment may be appropriate. *Id.* at 1863.

Prolacto’s motion for summary judgment is based, in large part, on the decision in the Board’s Prior Proceeding granting Prolacto’s claim of likelihood of confusion and cancelling PLM’s Registration No. 3210304 for the mark LA INDITA MICHOACANA and Design. The final decision of the Board may be appealed to the Court of Appeals for the Federal Circuit or to a U.S. District Court with appropriate jurisdiction. *See* Trademark Act Sections 21(a)(1) and 21(b)(1), 15 U.S.C. §§ 1071(a)(1) and 1071(b)(1); Trademark Rule 2.145, 37 C.F.R. § 2.145.

In this instance, PLM sought appeal of the Board’s decision by filing an action in the United States District Court for the District of Columbia. The proceeding involved a de novo review and a full trial, including additional claims and counterclaims and evidence brought before the District Court. As a result, the District Court was “largely unable to ‘meaningfully defer’ to the TTAB’s factual findings.” *Paleteria La Michoacana, Inc.*, 188 F. Supp. 3d at 37. On appeal, the Court of Appeals for the District of Columbia Circuit affirmed the decision of the District Court. In view of the foregoing, the Board’s judgment in the Prior Board Proceeding does not retain its

preclusive effect because it is not a “final” judgment. *See also* 18A Fed. Prac. & Proc. Juris. § 4432 (3d ed. 2020) and cases cited therein.

Accordingly, to the extent Prolacto seeks summary judgment on the grounds that PLM’s claims or defenses are barred by the doctrines of claim or issue preclusion based on the decision in the Prior Board Proceeding, the motion is **denied**.

We turn next to consideration of the application of the doctrines of claim or issue preclusion based on the Civil Action. As an initial matter, we note that the motion for summary judgment was filed in a consolidated case consisting of four separate proceedings, each of which involves different marks, goods and services, claims and counterclaims. Additionally, the parties are in different postures in these proceedings. Prolacto’s summary judgment motion does not sufficiently distinguish among the marks and claims at issue in each proceeding. Rather, Prolacto asserts indiscriminately that all claims in all proceedings should be resolved in its favor. An appropriate analysis of the application of the doctrines of claim or issue preclusion requires a review of the specific proceedings, claims, and marks at issue in each of these consolidated proceedings.

**1) Prolacto’s Claims in Opposition Nos. 91205049 and 91205093**

The parties do not dispute that Opposition Nos. 91205049 and 91205093 involve the same parties as the Civil Action (or in the case of PLM, its predecessor in interest) for purposes of claim preclusion. *See Urock Network, LLC v. Sulpasso*, 115 USPQ2d 1409, 1411 (TTAB 2015). Additionally, the District Court’s decision was affirmed on

appeal, and the decision in the Civil Action therefore constitutes a final judgment for purposes of claim preclusion.

Upon careful consideration of the parties' arguments and evidence, and drawing all reasonable inferences in favor of PLM as the nonmoving party, we find, however, that Prolacto has not met its burden on summary judgment in establishing that there is no genuine dispute of material fact with respect to the third claim preclusion element, i.e., that the claims in these proceedings are based on the same set of transactional facts. *See id.* At a minimum, a genuine dispute of material fact remains as to the similarities of the marks in the Civil Action and these proceedings for purposes of claim preclusion.

With respect to PLM's Serial No. 85393112 (the subject of Opposition No. 91205049), the involved composite mark is different from the mark at issue in the Civil Action. The two marks at issue are shown side-by-side below:



Although both marks contain the words "LA INDITA MICHUACANA," the font, color, and position of the words are different. The mark in the Civil Action included the full image of an Indian Girl holding an ice cream cone, while the mark at issue in Opposition No. 91205049 contains only the shoulders and head of a girl, facing a

different direction and with different hair, facial features, and clothing. Additionally, the involved mark is encased in a circle with images of mountains in the background. The marks are therefore different and claim preclusion is inapplicable. *See Institut National Des Appellations d'Origine v. Brown-Forman Corp.*, 47 USPQ2d 1875, 1894-95 (TTAB 1998) (claim preclusion not applicable where marks were different).

With respect to PLM's Application Serial No. 85378387 (the subject of Opposition No. 91205093), the involved mark is a standard character mark for the phrase LA INDITA. The claims at issue in the Civil Action were premised on Prolacto's purported prior use of its own Indian Girl design, not use of the words "LA INDITA." Prolacto has therefore not met its burden of establishing that the claims are based on the same set of transactional facts in light of the differences in the marks.

For the same reasons, with respect to the doctrine of issue preclusion, we find that Prolacto has not met its burden of establishing that the issues in the prior proceeding are the same as those at issue in these proceedings. At a minimum, we find that the differences in the involved marks preclude a finding that any of the claims or defenses are barred under the doctrine of issue preclusion. *Polaroid Corp. v. C & E Vision Services Inc.*, 52 USPQ2d 1954, 1957 (TTAB 1999) (Issue actually adjudicated is not identical based on differences between 'applicant's mark POLAREX in typed form' and 'applicant's marks which either (a) have design elements in addition to the highly stylized term POLAREX, or (b) include certain terms and design elements in addition to the highly stylized term POLAREX.'). Additionally, with respect to Opposition No. 91205093, Prolacto has not met its burden of establishing that PLM's use or

registration of the phrase “LA INDITA” was actually litigated in the Civil Action, let alone necessary in entering judgment.

In view of the foregoing, Prolacto’s motion for summary judgment is **denied** with respect to its assertion of claim or issue preclusion on Prolacto’s claims in Opposition Nos. 91205049 and 91205093.

**D. PLM’s Counterclaims in Opposition Nos. 91205049 and 91205093**

PLM has asserted counterclaims to cancel Prolacto’s Registration Nos. 2830401 and 3249113 on numerous grounds in each of these proceedings, including abandonment due to uncontrolled or “naked” licensing.<sup>28</sup> The abandonment counterclaims based on naked licensing are identical to the claims asserted by PLM in the Civil Action against the same registrations.<sup>29</sup> Each claim arose from the same pleaded set of transactional facts, i.e., that Prolacto failed to police third party use by purported licensees. The District Court found that Prolacto had not abandoned its rights in any of its marks due to naked licensing. *Paleteria La Michoacana, Inc.*, 188 F. Supp. 3d at 92-94.

In its response to Prolacto’s motion for summary judgment, PLM does not contest that the district court judgment precludes the counterclaims being relitigated in this

---

<sup>28</sup> 4 TTABVUE 9-10 in Opposition No. 91205049 and 4 TTABVUE 9-10 in Opposition No. 91205093.

<sup>29</sup> 8 TTABVUE 68 (“PLM is informed and believes and on that basis alleges that [Prolacto] abandoned use of [its LA MICHOACANA NATURAL and Design mark, LA FLOR DE MICHOACAN Marks, Indian Girl Design Mark, and LA MICHOACANA mark] prior to filing of the cancellation action.”); ¶¶ 37-39 of Counterclaim in Opposition Nos. 91205049 and 91205093 (“[PLM] is informed and believes, and on that basis alleges, that [Prolacto] has abandoned use of its LA FLOR DE MICHOACAN mark due to [Prolacto’s] failure to exercise sufficient control over any such use of such mark by its alleged licensees...”).

proceeding. More specifically, PLM does not dispute that the parties (or their privies) are the same, that the claims arose from the same transactional facts, or that the Civil Action constitutes a final judgment on the merits of the identical claims. Therefore, there is no genuine dispute of material fact that the district court judgment bars its counterclaims of abandonment due to naked licensing.

In view of the foregoing, Prolacto's motion for summary judgment is **granted** to the extent that PLM's counterclaims to cancel Prolacto's Registration Nos. 2830401 and 3249113 on the grounds of abandonment due to naked licensing are barred by the doctrine of claim preclusion. Inasmuch as we find the claims are barred by claim preclusion, we need not and do not reach Prolacto's alternative argument that the counterclaims are barred by the doctrine of issue preclusion.

To the extent Prolacto moves for summary judgment on PLM's remaining counterclaims in each of these proceedings, the motion is **denied**, without prejudice. Although Prolacto asserts generally that the claims were either asserted and litigated or could have been asserted in the Civil Action, Prolacto makes arguments only with respect to the naked licensing claim, addressed above. As the party moving for summary judgment, Prolacto bears the burden of establishing no genuine dispute of material fact remains and that it is entitled to judgment as a matter of law on each of these counterclaims. Prolacto has not done so here.<sup>30</sup>

---

<sup>30</sup> We note that Prolacto asserted its Registration Nos. 2830401 and 3249113 as a basis for its likelihood of confusion claims in Opposition Nos. 91205049 and 91205093. PLM's counterclaims are contingent on the Board finding a likelihood of confusion with respect to Prolacto's subject registrations. The District Court affirmed the Board's finding that PLM's mark did not infringe Prolacto's LA FLOR DE MICHOACAN Marks. 188 F. Supp. 3d at 107-08. Prolacto offers no explanation as to why the District Court's finding of no likelihood of



**E. Opposition Nos. 91205466 and 91205468**

Turning next to Opposition Nos. 91205466 and 91205468, upon careful consideration of the parties' arguments and evidence, and drawing all reasonable inferences in favor of PLM as the nonmoving party, we find that Prolacto has failed to meet its burden of establishing there is no genuine dispute of material fact and that Prolacto is not entitled to judgment as a matter of law under the doctrines of claim or issue preclusion. Based on the present record, we find, at a minimum, that a genuine dispute of material fact remains as to the identity of the goods and services involved for purposes of claim or issue preclusion.<sup>31</sup>

The Civil Action involved Prolacto's common law rights in its LA MICHOACANA and LA MICHOACANA NATURAL marks for use in connection with paletas and paleterias,<sup>32</sup> while the involved applications in these proceedings consist of numerous goods and services in various classes, which do not appear to have been part of the Civil Action. At a minimum, a genuine dispute of material fact remains as to the identity of the goods and services and whether that difference bars the application of

---

confusion warrants a finding, as a matter of law, in favor of Prolacto's likelihood of confusion claims with respect to its LA FLOR DE MICHOACAN Marks.

<sup>31</sup> The fact that we have identified certain genuine disputes of material fact should not be construed as a finding that the affirmative defense of claim or issue preclusion may not ultimately apply, or that this is the only dispute that remains for trial. Additionally, the parties should note that the evidence submitted in connection with a motion for summary judgment or opposition thereto is of record only for consideration of that motion. Any such evidence to be considered at final hearing must be properly introduced in evidence during the appropriate trial period. *See Levi Strauss & Co. v. R. Joseph Sportswear Inc.*, 28 USPQ2d 1464 (TTAB 1993); *Pet Inc. v. Bassetti*, 219 USPQ 911 (TTAB 1983).

<sup>32</sup> *Paleteria La Michoacana, Inc.*, 188 F. Supp. 3d at 64-83 (detailing Prolacto's use of its marks in connection with paleterias).

claim or issue preclusion in these proceedings. *See Mayer/Berkshire Corp. v. Berkshire Fashions Inc.*, 424 F.3d 1229, 76 USPQ2d 1310, 1314 (Fed. Cir. 2005) (no claim or issue preclusion with broader identification of goods); *Nina Ricci, S.A.R.L. v. E.T.F. Ent., Inc.*, 889 F.2d 1070, 12 USPQ2d 1901, 1904 n.1 (Fed. Cir. 1989) (prior proceeding determining likelihood of confusion with respect to shoes and belts did not preclude likelihood of confusion claim for clothing line); *La Fara Imp. Co. v. F. Lil De Cecco Di Filippo Fara S. Martina S.P.A.*, 8 USPQ2d 1143, 1146 (TTAB 1988) (no claim preclusion for goods not in registration in prior proceeding); *Litton Ind. Inc. v. Litronix, Inc.*, 577 F.2d 709, 198 USPQ 280 (CCPA 1978) (fact that previous proceeding involved application to register different goods fatal to collateral estoppel).<sup>33</sup>

Accordingly, Prolacto's motion for summary judgment on the defenses of claim and issue preclusion in Opposition Nos. 91205466 and 91205468 is **denied**.

Notably, we do not regard the issues pleaded in these proceedings as appropriate for disposition by summary judgment. The parties therefore are barred from bringing motions for summary judgment on the pleaded issues. In addition, the Board having

---

<sup>33</sup> Although it appears that Prolacto's services in International Classes 35, 39, and 43 are all related to ice cream, Prolacto did not meet its burden in establishing that there is no genuine dispute of material fact as to the identity of the goods and services for claim or issue preclusion. Moreover, Prolacto's argument regarding the application of claim or issue preclusion against PLM's claims against its involved applications lacks any legal support. The District Court found that PLM is the national senior user of 'La Michoacana' and its Indian Girl Design Marks and that it is [Prolacto] who is the junior user," that "MICHOACANA' and 'LA MICHOACANA' are descriptive of a type of product that is understood in the minds of consumers to have originated in the Mexican state of Michoacán" and that Prolacto failed to establish secondary meaning. 188 F.Supp.3d at 83-85. It is entirely unclear how the Civil Action could serve to preclude PLM from asserting its pleaded claims in these proceedings.

addressed Prolacto's arguments in this order, Prolacto is barred from bringing another motion based on claim or issue preclusion. However, PLM may bring a motion seeking summary judgment on claim or issue preclusion. Should extraordinary circumstances arise that warrant relief from this bar, the prospective movant may seek permission to file a motion for summary judgment from the Board attorney assigned to these proceedings. Any motion for summary judgment (except a motion by PLM on claim or issue preclusion) filed without permission will be given no consideration.

As provided above, Prolacto is ordered to file a copy of the district court decision and the court of appeals decision within **ten days** of this order, failing which the Board may consider appropriate sanctions.

#### **V. Further Suspension**

As noted above, Prolacto and PLM are also party to Opposition Nos. 91249913 and 91245908. Prolacto filed motions in Opposition Nos. 91249913 and 91245908 to further consolidate all of these proceedings. Accordingly, these consolidated proceedings are **suspended** pending consideration of Prolacto's motions to consolidate in Opposition Nos. 91249913 and 91245908.