

THIS OPINION
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OF THE TTAB

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

COHEN

Mailed: July 12, 2013

Opposition Nos. 91208247 (parent)
91208248
91209749
91209750

Plaor, LLC

v.

Hollywood Casino Corporation

**Before Bucher, Wolfson and Masiello, Administrative
Trademark Judges**

By the Board:

Hollywood Casino Corporation ("applicant") seeks registration of the marks HOLLYWOOD POKER, HOLLYWOOD POKER TOUR, HOLLYWOOD POKER OPEN and HPO, each in standard characters, for "conducting live poker games and tournaments; casino services,"¹ (collectively, "applicant's marks").

¹ Application Serial No. 85498773 for HOLLYWOOD POKER, filed December 19, 2011, under Trademark Act Section 1(a), 15 U.S.C. § 1051(a), claims dates of first use in commerce and anywhere of August 2009, disclaims POKER and includes a distinctiveness limitation statement "as to 'HOLLYWOOD.'"

Application Serial No. 85563891 for HOLLYWOOD POKER TOUR, filed March 8, 2012, under Trademark Act Section 1(b), 15 U.S.C. § 1051(b), based on an assertion of a *bona fide* intent to use the mark in commerce, disclaims POKER TOUR and includes a distinctiveness limitation statement "as to 'HOLLYWOOD.'"

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Plaor, LLC ("opposer") filed its notice of opposition to the registration of applicant's marks on the ground of likelihood of confusion under Trademark Act Section 2(d), 15 U.S.C. § 1052(d), based on opposer's alleged prior rights in the mark HOLLYWOOD POKER for "live poker and tournaments via the internet" and hosting "live 'in person' poker tournament events."

I. CONSOLIDATION

It has come to the Board's attention that the parties are involved in Opposition Nos. 91209749 and 91209750 concerning marks at issue in Consolidated Opposition No. 91208247. When cases involving common questions of law or fact are pending before the Board, the Board may order the consolidation of the cases. Consolidation is discretionary with the Board, and may be ordered upon motion granted by the Board, or upon stipulation of the parties approved by the Board, or upon the Board's own initiative. See Fed. R. Civ. P. 42(a); TBMP § 511 (2013). Inasmuch as the parties to Consolidated Opposition No. 91208247 are the same as the

Application Serial No. 85727812 for HOLLYWOOD POKER OPEN, filed September 13, 2012, under Trademark Act Section 1(a), 15 U.S.C. § 1051(a), claims dates of first use in commerce and anywhere of March 12, 2010, disclaims POKER OPEN and includes an acquired distinctiveness claim to the mark.

Application Serial No. 85775528 for HPO, filed November 9, 2012, under Trademark Act Section 1(a), 15 U.S.C. § 1051(a), claims dates of first use in commerce and anywhere of September 6, 2012.

Opposition Nos. 91208247, 91208248, 91209749 and 91209750 parties in Opposition Nos. 91209749 and 91209750 and the proceedings involve common questions of law and fact, the Board finds that further consolidation of the proceedings is appropriate. Consolidation will avoid duplication of effort concerning the factual issues and will thereby avoid unnecessary costs and delays.

Accordingly, **Opposition Nos. 91209749 and 91209750** are hereby consolidated with **Consolidated Opposition No. 91208247** and may be presented on the same record and briefs. Except as otherwise noted herein, the record will be maintained in **Opposition No. 91208247** as the "parent" case. Notwithstanding the foregoing, applicant should file a separate answer for each proceeding. Thereafter, the parties should no longer file separate submissions in connection with each proceeding, but should instead file only a single copy of each paper in the parent case. Each submission filed should bear the numbers of all consolidated proceedings in ascending order, and the parent case should be designated as the parent case by following it with: "(parent)," as in the case caption set forth above.

Consolidated cases do not lose their separate identity because of consolidation. Each proceeding retains its separate character and requires entry of a separate

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judgment. The decision on the consolidated cases shall take into account any differences in the issues raised by the respective pleadings and a copy of the final decision shall be placed in each proceeding file. See 9A Wright, Miller, Kane & Marcus, *Fed. Prac. & Proc. Civ.* § 2382 (3d ed. 2012).

II. SUMMARY JUDGMENT

This case now comes up for consideration of applicant's motion for summary judgment² (filed January 8, 2013 in Consolidated Opposition No. 91208247, and April 22, 2013 in Opposition Nos. 91209749 and 91209750) based on 1) lack of jurisdiction based on opposer's alleged lack of standing and 2) claim preclusion based on a prior Board decision. The motions are fully briefed.

A. Standing

As a preliminary matter, applicant alleges opposer has no standing to bring Opposition Nos. 91208247 and 91208248 because Plaor LLC does not exist as a corporation in Nevada as opposer noted in those notices of opposition; and that

²As noted in the Board's order dated January 22, 2013 in Consolidated Opposition No. 91208247, applicant's motion to dismiss pursuant to Fed. R. Civ. P. 12(b)(1) and 12(b)(6) is a motion for summary judgment and will be treated as such. See TBMP § 503.04. Pursuant to the same analysis, the motions to dismiss in Opposition Nos. 91209749 and 91209750 filed pursuant to Fed. R. Civ. P. 12(b)(1) and 12(b)(6) are likewise, motions for summary judgment and will be treated as such.

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therefore, the oppositions at hand are barred by lack of Board jurisdiction based on opposer's alleged lack of standing.

Opposer indicates that applicant's claim of lack of standing is based on a "typo" and that opposer inadvertently indicated Nevada as its state of incorporation instead of Delaware and that therefore, applicant's "challenge is meritless."

When the plaintiff in a Board *inter partes* proceeding misidentifies itself or the mark or registration upon which it relies in the complaint, if the plaintiff can establish to the Board's satisfaction that this misidentification was merely a non-substantive mistake, the Board may allow amendment of the complaint, pursuant to Fed. R. Civ. P. 15(a), to correct the misidentification and/or to substitute the proper party in interest. See *Mason Engineering & Design Corp. v. Mateson Chemical Corp.*, 225 USPQ 956, 957 n.3 (TTAB 1985); *Airbrook, Inc. v. La Citrique Belge, Naamloze Vennootschap*, 184 USPQ 505, 505-06 (TTAB 1974); TBMP § 512.04. A mistake by misidentification means a mistake in the form of the opposer's name or its entity type, not the naming of a different existing legal entity that is not in privity with the party that should have been named. See Trademark Rule 2.120(b); TBMP § 303.05(c).

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Inasmuch as opposer indicates it inadvertently misidentified its state of incorporation as Nevada instead of Delaware in Opposition Nos. 91208247 and 91208248 and opposer identifies its state of incorporation as Delaware in Opposition Nos. 91209749 and 91209750, applicant's motion for summary judgment based on lack of standing in Opposition Nos. 91208247 and 91208248 is **DENIED**. Further, the pleadings in Opposition Nos. 91208247 and 91208248 are hereby deemed to be amended, pursuant to Rule 15 of the Federal Rules of Civil Procedure, to recite opposer's correct state of incorporation.

B. Claim Preclusion

Background

In Opposition No. 91167327,³ applicant opposed application Serial No. 78342160 filed by Bosko Djordjevic ("Djordjevic") for the mark HOLLYWOOD POKER for "providing computer games that may be accessed by users on a global computer network." In Opposition No. 91170003,⁴ applicant opposed Djordjevic's application Serial No. 78506200 for the design mark depicted below:

³ Opposition No. 91167327 was filed October 21, 2005.

⁴ Opposition No. 91170003 was filed March 24, 2006.



for "retail store services, including mail order and on-line retail store services, all featuring clothing, books, gift items and memorabilia." In Opposition No. 91170005,⁵ applicant opposed Djordjevic's application Serial No. 78470500 for the mark HOLLYWOOD POKER CLUB for "mail order and on-line retail store services all featuring clothing, books, gift items and memorabilia." (Opposition Nos. 91167327, 91170003, and 91170005 are collectively referred to as the "prior oppositions"). The prior oppositions were based on a likelihood of confusion with, *inter alia*, HOLLYWOOD CASINO, HOLLYWOOD MARQUEE, and HOLLYWOOD SCREEN TEST. Djordjevic withdrew each of his applications without consent. Consequently, the Board sustained the prior oppositions and refused registrations to Djordjevic.

In the oppositions before us, applicant alleges that opposer obtained its alleged rights in HOLLYWOOD POKER from Djordjevic and therefore the parties are in privity; that the present oppositions are a "collateral attack on the judgment" of the prior oppositions; and that therefore, the

⁵ Opposition No. 91170005 was filed March 24, 2006.

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oppositions at hand are barred by claim preclusion and applicant's motion for summary judgment should be granted and the oppositions dismissed.

Opposer alleges that its oppositions are not barred by claim preclusion as the marks at issue in this proceeding are different from the marks at issue in the prior oppositions; and that therefore, given the difference in the claims adjudicated and the transactional facts of the prior oppositions, applicant's motion for summary judgment should be denied.

Analysis

Summary judgment is an appropriate method of disposing of cases in which there are no genuine disputes as to any material fact, thus leaving the case to be resolved as a matter of law. See Fed. R. Civ. P. 56(c). The party moving for summary judgment has the initial burden of demonstrating that there is no genuine dispute of material fact remaining for trial and that it is entitled to judgment as a matter of law. See *Celotex Corp. v. Catrett*, 477 U.S. 317 (1987); *Sweats Fashions Inc. v. Pannill Knitting Co. Inc.*, 833 F.2d 1560, 4 USPQ2d 1793 (Fed. Cir. 1987). A factual dispute is genuine if, on the evidence of record, a reasonable fact finder could resolve the matter in favor of the non-moving party. See *Opryland USA Inc. v. Great Am. Music Show Inc.*,

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970 F.2d 847, 23 USPQ2d 1471, 1472 (Fed. Cir. 1992); *Olde Tyme Foods, Inc. v. Roundy's, Inc.*, 961 F.2d 200, 22 USPQ2d 1542, 1544 (Fed. Cir. 1992). Evidence on summary judgment must be viewed in a light favorable to the non-movant, and all justifiable inferences are to be drawn in the non-movant's favor. See *Lloyd's Food Prods., Inc. v. Eli's, Inc.*, 987 F.2d 766, 25 USPQ2d 2027, 2029 (Fed. Cir. 1993); *Opryland USA*, 23 USPQ2d at 1472. The Board may not resolve genuine disputes as to material facts; it may only ascertain whether genuine disputes as to material facts exist. See *Lloyd's Food Prods.*, 25 USPQ2d at 2029; *Olde Tyme Foods*, 22 USPQ2d at 1542.

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." *Jet, Inc. v. Sewage Aeration Systems*, 223 F.3d 1360, 55 USPQ2d 1854, 1856 (Fed. Cir. 2000), quoting *Parklane Hosiery Co. v. Shore*, 439 U.S. 322, 326 n. 5 (1979). For claim preclusion, there must be:

- (1) an identity of the parties or their privies,
- (2) a final judgment on the merits of the prior claim, and
- (3) the second claim must be based on the same transactional facts as the first and should have been litigated in the prior case.⁶

⁶ In other words, where the factual allegations in the original action could give rise to a claim, that claim should be brought

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See Sharp Kabushiki Kaisha v. ThinkSharp, Inc., 448 F.3d 1368, 79 USPQ2d 1376, 1378 (Fed. Cir. 2006). In determining whether two proceedings involve the same claim for purposes of claim preclusion, the Board has looked to whether "the mark involved in the first proceeding is the same mark, in terms of commercial impression, as the mark involved in the second proceeding, and whether the evidence of likelihood of confusion between [the marks] would be identical to the evidence of likelihood of confusion" between the second marks. *Institut National Des Appellations d'Origine v. Brown-Forman Corp.*, 47 USPQ2d 1878, 1875 (TTAB 1998). Application of *res judicata* or claim preclusion in proceedings involving different marks turns on whether the marks "differed from each other in more than minor, insignificant ways." *Id.* The fact that two marks might be similar enough to each other, in terms of commercial impression, to be deemed to be confusingly similar under a likelihood of confusion analysis is not "a sufficient basis for finding that the applications to register [the marks]

in the original action. *See Orouba Agrifoods Processing Co. v. United Food Import*, 97 USPQ2d 1310, 1314 (TTAB 2010); *see also, Nasalok Coating Corp. v. Nylok Corp.*, 522 F.3d 1320, 86 USPQ2d 1369, 1371 (Fed. Cir. 2008) ("Claim preclusion refers to 'the effect of foreclosing any litigation of matters that never have been litigated, because of a determination that they should have been advanced in an earlier suit.'").

Opposition Nos. 91208247, 91208248, 91209749 and 91209750 should be deemed to be a single 'claim,' for claim preclusion purposes." *Id.*

In this case, on the record presented, we find that there are genuine disputes as to material facts remaining for trial. The parties do not dispute that there is an identity of the parties or their privies between the current oppositions and the prior oppositions. Further, the parties do not dispute that there was a final judgment in the prior oppositions.⁷ However, there is, at a minimum, a genuine dispute as to whether the current oppositions will be based on the same set of transactional facts as the prior oppositions and whether the claims raised in the current oppositions should have been litigated in the prior oppositions.

Applicant relied upon the marks HOLLYWOOD CASINO, HOLLYWOOD MARQUEE, and HOLLYWOOD SCREEN TEST in support of its claims in the prior oppositions, and did not rely upon applicant's marks at issue herein (i.e., HOLLYWOOD POKER, HOLLYWOOD POKER TOUR, HOLLYWOOD POKER OPEN and HPO). In fact, applicant filed the prior oppositions in 2005 and 2006, well prior to the alleged dates of use or filing dates

⁷ "Default judgment can operate as res judicata in appropriate circumstances." *Sharp Kabushiki Kaisha v. ThinkSharp, Inc.*, 79 USPQ2d at 1378, citing *Morris v. Jones*, 329 U.S. 545, 550-51 (1947).

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for applicant's marks at issue herein. As there is no evidence to the contrary on the record presented, it does not appear that the facts in the prior oppositions could give rise to a claim based on applicant's marks as those marks were, as alleged in applicant's applications, neither in use nor filed before the USPTO at the time of filing the prior oppositions.

Additionally, a genuine dispute exists as to whether applicant's marks, at issue in this proceeding, are different "in more than minor, insignificant ways" from the marks HOLLYWOOD CASINO, HOLLYWOOD MARQUEE and/or HOLLYWOOD STUDIO TEST, allegedly owned by applicant, which were at issue in the prior oppositions. *Id.* at 1894-95.

Applicant's alleged services in the prior oppositions were generally described as "casino services," while opposer's goods and services were generally described as computer games and retail store services. In the current oppositions, both opposer's and applicant's services are related to poker games and tournaments. Thus, a genuine dispute exists as to whether the goods and services at issue in the prior oppositions would constitute the same set of transactional facts as the current oppositions.

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In view thereof, applicant's motion for summary judgment⁸ based on claim preclusion is hereby **DENIED**.

III. MOTION TO AMEND NOTICES OF OPPOSITION

Turning to opposer's motion for leave to amend the notices of opposition, opposer seeks to amend its notices of opposition to add claims of estoppel, waiver and acquiescence.

Pursuant to Fed. R. Civ. P. 15(a), a party may amend its pleading only by written consent of every adverse party or by leave of the Board; and leave must be freely given when justice so requires. See TBMP § 507.02. The Board liberally grants leave to amend pleadings at any stage of a proceeding when justice so requires, unless entry of the proposed amendment would violate settled law or be prejudicial to the rights of the adverse party or parties. See *Black & Decker Corp. v. Emerson Electric Co.*, 84 USPQ2d 1482, 1486 (TTAB 2007). Where the moving party seeks to add a new claim or defense, and the proposed pleading thereof is legally

⁸ Evidence submitted in connection with the motion for summary judgment is of record for purposes of that motion only. To be considered at trial, the parties must make all evidence properly of record during their testimony periods. See *Levi Strauss & Co. v. R. Josephs Sportswear Inc.*, 28 USPQ2d 1464 (TTAB 1993); *Pet Inc. v. Bassetti*, 219 USPQ 911 (TTAB 1983); *American Meat Institute v. Horace W. Longacre, Inc.*, 211 USPQ 712 (TTAB 1981); TBMP § 528.05(a). Furthermore, the fact that we have identified certain genuine disputes as to material facts should not be construed as a finding that these are necessarily the only disputes which remain for trial.

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insufficient, or would serve no useful purpose, the Board normally will deny the motion for leave to amend. See *Leatherwood Scopes International Inc. v. Leatherwood*, 63 USPQ2d 1699 (TTAB 2002); *Polaris Industries v DC Comics*, 59 USPQ2d 1798 (TTAB 2001); *Trek Bicycle Corp. v. StyleTrek Ltd.*, 64 USPQ2d 1540 (TTAB 2001); TBMP § 507.02.

Additionally, a signed copy of the proposed amended pleading should accompany a motion for leave to amend a pleading. See TBMP § 507.01.

Inasmuch as opposer seeks to assert equitable defenses as grounds for opposition, the proposed amended pleadings would be legally insufficient. Estoppel, waiver and acquiescence are equitable defenses that cannot be asserted as grounds for opposition. See *Leatherwood Scopes International Inc. v. Leatherwood*, *supra*; *University Book Store v. University of Wisconsin Board of Regents*, 33 USPQ2d 1385, 1401 n.39 (TTAB 1994); TBMP § 309.03(c). In view thereof and as opposer has not included a signed copy of the proposed amended pleading, opposer's motion for leave to amend its notices of opposition is **DENIED**.

IV. DATES

Proceedings herein are resumed. Disclosure, discovery, trial and other dates are hereby reset as follows:

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Time to Answer ⁹	8/10/2013
Deadline for Discovery Conference	9/9/2013
Discovery Opens	9/9/2013
Initial Disclosures Due	10/9/2013
Expert Disclosures Due	2/6/2014
Discovery Closes	3/8/2014
Plaintiff's Pretrial Disclosures Due	4/22/2014
Plaintiff's 30-day Trial Period Ends	6/6/2014
Defendant's Pretrial Disclosures Due	6/21/2014
Defendant's 30-day Trial Period Ends	8/5/2014
Plaintiff's Rebuttal Disclosures Due	8/20/2014
Plaintiff's 15-day Rebuttal Period Ends	9/19/2014

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.

⁹ As noted above, applicant should file a separate answer, or otherwise respond, to each of the respective notices of opposition.