

**This Opinion is Not a
Precedent of the TTAB**

Mailed: May 16, 2019

UNITED STATES PATENT AND TRADEMARK OFFICE

—
Trademark Trial and Appeal Board
—

Julie A. Moreno
v.
Pro Boxing Supplies, Inc.
—

Opposition No. 91214580
Opposition No. 91214877
Cancellation No. 92058878
(Consolidated Cases)
—

David D. Spencer of The Spencer Law Office,
for Julie A. Moreno.

R. Joseph Trojan of Trojan Law Offices,
for Pro Boxing Supplies, Inc.

—
Before Bergsman, Greenbaum and Larkin,
Administrative Trademark Judges.

Opinion by Greenbaum, Administrative Trademark Judge:

On October 7, 2017, Julie A. Moreno (“Moreno”), the plaintiff in each proceeding, filed a Request for Reconsideration¹ of the September 8, 2017 Final Decision, which was designated a precedent of the Board (“Final Decision”).² The Request for

¹ 43 TTABVUE.

² *Moreno v. Pro Boxing Supplies, Inc.*, 124 USPQ2d 1028 (TTAB 2017).

Reconsideration has been fully briefed. For the reasons discussed below, we deny the Request for Reconsideration.

The purpose of reconsideration is to point out errors made by the Board in rendering its final decision. Trademark Rule 2.129(c), 37 C.F.R. § 2.129(c). Reconsideration may not be used to introduce into the record additional evidence or to reargue points presented in the requesting party's brief on the case. Rather, the request normally should be limited to a demonstration that, based on the record evidence and the applicable law, the Board's ruling is in error and requires appropriate change. *See* Trademark Trial and Appeal Board Manual of Procedure ("TBMP") §§ 543 and 804 (June 2018) and cases cited therein.

I. Background

Pro Boxing Supplies, Inc. ("Pro Boxing"), the defendant in each proceeding, owns a registration for the standard character mark CASANOVA,³ and two applications to register design marks featuring the word CASANOVA, for boxing gloves and assorted boxing equipment in International Class 28.⁴ Moreno claimed priority and likelihood of confusion under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), based on rights accrued under common law through prior use of the mark CASANOVA by Deportes Casanova, a foreign third party, and use by herself, as exclusive licensee of

³ Reg. No. 4350212 issued on June 11, 2013 (filed October 22, 2012), claiming December 31, 1993, as the date of first use anywhere and use in commerce.

⁴ Application Serial Nos. 85885946 and 85886437 were filed on March 25, 2013 and March 26, 2013, respectively. Both applications are based upon Pro Boxing's claim of first use anywhere and use in commerce since at least as early as January 30, 2003.

Deportes Casanova's intellectual property in the United States.⁵ The license, dated July 23, 2013,⁶ grants Moreno the exclusive right to use the mark CASANOVA and a design mark that includes the word CASANOVA, and to protect the marks by "all appropriate legal means."⁷

In the Final Decision, the Board reviewed its precedent concerning the standing of licensors and licensees, and determined that Moreno had standing to bring the proceedings because she was an exclusive licensee of Deportes Casanova.⁸ However, Moreno's Section 2(d) claim failed because she did not use the licensed mark CASANOVA before Pro Boxing's constructive first use dates, and after reviewing Board precedent, the Board found that as a mere licensee, with no ownership rights in the licensed mark, Moreno could not establish priority based on her licensor's alleged prior common law use.⁹ Accordingly, the Board dismissed the oppositions and denied the petition for cancellation.¹⁰

II. Moreno's Arguments

Relying on the decisions of our primary reviewing court in *Jewelers Vigilance Comm., Inc. v. Ullenberg Corp.*, 823 F.2d 490, 2 USPQ2d 2021 (Fed. Cir. 1987)

⁵ 1 TTABVUE 5-8, ¶¶ 4, 5, 9-11. References to the record are to the TTABVUE file in Opposition No. 91214877, which the Board designated the "parent case." See April 3, 2014 Board Order, 7 TTABVUE 3.

⁶ Moreno submitted a copy of the license agreement as Ex. B to the testimony of Ambar Gonzalez. A. Gonzalez Test., 12 TTABVUE 28.

⁷ *Id.*

⁸ *Moreno*, 124 USPQ2d at 1033-1034.

⁹ *Id.* at 1034-1036.

¹⁰ *Id.* at 1036.

(“*Jewelers Vigilance I*”) and *Jewelers Vigilance Comm., Inc. v. Ullenberg Corp.*, 853 F.2d 888, 7 USPQ2d 1628 (Fed. Cir. 1988) (“*Jewelers Vigilance II*”), Moreno argues that the Board erred in finding that use of a mark by the controlling trademark owner does not inure to the benefit of the licensee. According to Moreno, the *Jewelers Vigilance* decisions

are strong authority and statements by the Federal Circuit that Plaintiff Moreno need not prove a proprietary right in the Deportes Casanova mark she seeks to defend. These decisions mean that Moreno, like the plaintiff JVC who relied on the priority of the unregistered DEBEERS mark for priority, may assert not just her own rights (including priority rights) but those of Deportes Casanova of Mexico City as well.

Plaintiff Moreno respectfully requests that the Board reconsider its decision in light of the *Jewelers Vigilance* decisions. If a trade association, with a more attenuated relationship to a mark than a licensee, does not have to own the rights to succeed in an opposition, why should a licensee?¹¹

III. Analysis

We see no error in the Final Decision. We find, instead, that Moreno has misinterpreted the *Jewelers Vigilance* decisions, and that the decisions are distinguishable on their facts.

The Federal Circuit decided *Jewelers Vigilance I* on the issue of standing, which is not in question here.¹² In particular, in *Jewelers Vigilance I*, the Federal Circuit found that opposer Jewelers Vigilance Committee (“JVC”), a trade association of

¹¹ 43 TTABVUE 5.

¹² “Moreno has standing because she is the exclusive licensee of Deportes Casanova.” *Moreno*, 124 USPQ2d at 1036. See *id.* at 1033-1034 for an extensive discussion of Moreno’s standing.

jewelers and a recognized industry “watchdog,” had standing to pursue a Section 2(d) claim¹³ based on asserted prior use by JVC’s member jewelers of the name and slogan of a third party to promote the members’ jewelry, even though JVC did not have a proprietary interest in the name or slogan. *Jewelers Vigilance I*, 2 USPQ2d at 2024.

Following a remand to the Board (in *Jewelers I*) and a second appeal by JVC to the Federal Circuit, the Federal Circuit in *Jewelers II* again remanded the case to the Board, and directed the Board to grant summary judgment in favor of JVC. *Jewelers Vigilance II*, 7 USPQ2d at 1633. In doing so, the Federal Circuit specifically found that “Ullenberg does not dispute the facts JVC asserted in its pleading,” including that the member jewelers had priority in the name and slogan based on common law use by the member jewelers prior to Ullenberg’s first use. *Id.* at 1629-1630. Thus, unlike the present case, there was no dispute as to the priority of JVC’s members over Ullenberg.

A “trade association” is a noun defined as “an association of tradesmen, businessmen, or manufacturers in a particular trade or industry for the protection and advancement of their common interests.”¹⁴ Accordingly, when a trade association brings a proceeding before the Board for asserted injury to its members, the trade association essentially stands in the shoes of its members, and it may assert the

¹³ The Federal Circuit also allowed JVC to pursue a claim of a false suggestion of a connection under Section 2(a) of the Trademark Act, 15 U.S.C. § 1052(a).

¹⁴ We take judicial notice of the Merriam-Webster dictionary entry for “trade association,” accessed February 21, 2018 at merriam-webster.com. See *Univ. of Notre Dame du Lac v. J.C. Gourmet Food Imps. Co.*, 213 USPQ 594 (TTAB 1982), *aff’d*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983); *In re Red Bull GmbH*, 78 USPQ2d 1375, 1377 (TTAB 2006).

rights of its members even if it has no proprietary rights of its own to assert. *See Jewelers Vigilance I*, 2 USPQ2d at 2024. The underlying logic simply does not apply in the present situation, where Moreno seeks to assert the purported proprietary rights of her licensor. As the Board explained in *Holmes Prods. Corp. v. Duracraft Corp.*, 30 USPQ2d 1549, 1552 (TTAB 1994), where a plaintiff sought to expand the “proprietary rights” language of *Jewelers Vigilance* to a different set of facts:

In the second opinion rendered in that case [*Jewelers Vigilance II*, citation omitted], (a decision on the merits), the Court made it clear that “ordinarily, a person should not be heard on a third party’s rights, that is, allowed to sue to vindicate the rights of another.” 7 USPQ2d at 1631. The reason the plaintiff in the *Jewelers Vigilance* case was able to assert the rights of a third party was that “the trade association convincingly established that it was not a mere intermeddler in asserting a claim predicated on a third party’s name and had sound reasons for fearing damage to itself and its members if Ullenberg’s mark were registered. In sum, JVC asserted its own claim which happened to involve the proprietary rights of a third party.” *Id.*

Although some commentators have criticized the Court’s opinion for its allowing opposers to rely on third parties’ trademarks [citation omitted], we think it would be inappropriate to read the language of the opinion so broadly. The statements must be read in the context of the factual situation before the Court; and that factual situation included a plaintiff which was able to establish its legitimate interest in preventing likelihood of confusion. Specifically, the plaintiff’s interest was to see that the continued use of the DEBEERS mark by its members was protected against a potential claim by applicant, a junior user of the DEBEERS mark, of a right to exclusive use of the DEBEERS mark and likelihood of confusion.

By contrast, Moreno is an individual, not an industry “watchdog” or a representational organization like JVC, which exists to protect the common interest

of its members. Accordingly, we reiterate that “as a mere licensee, she cannot assert the purported priority rights of her licensor, non-party Deportes Casanova.” *Moreno*, 124 USPQ2d at 1036. Instead, consistent with the prior Board decisions discussed in the Final Decision (*id.* at 1035), *Moreno* must prove her own priority. *See, e.g., Chicago Bears Football Club Inc. v. 12th Man/Tennessee LLC*, 83 USPQ2d 1073 (TTAB 2007) (joint plaintiffs licensor and licensee each proved their own priority).

IV. Conclusion

In sum, *Moreno* has not demonstrated that, based on the evidence properly of record and the applicable law, the Final Decision is in error.

Decision: *Moreno*’s Request for Reconsideration is denied.