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Filing date: **11/30/2022**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding no.	91277548
Party	Defendant Creative Security Technology
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Attachments	11302022_MSJ_Bitvision.pdf(200868 bytes)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

For the trademark "BITVISION" (Application No. 90136472);
Published in the Official Gazette on May 24, 2022

Hangzhou Hikvision Digital Technology Co., LTD Opposer v. Creative Security Technology Applicant	)	Opposition No. 91277548

APPLICANT'S RESPONSE TO OPPPOSER HANGZHOU HIKVISION DIGITAL TECHNOLOGY CO'S MOTION FOR SUMMARY JUDGEMENT

Applicant, Creative Security Technology ("Applicant") in response to opposer Hangzhou Hikvision Digital Technology ("Opposer")'s Motion for Summary Judgement ("Motion"), would respectfully show the board as follows:

I. INTRODUCTION

Opposer's cross motion for summary judgment in this matter, claiming there are no genuine issues of material fact with regard to likelihood of confusion under Trademark Act Section 2(d) (15 U.S.C. § 1052(d)) and that summary judgment in its favor is appropriate. **This is not the case.** A review of applicable law and the facts of this case strongly supports Applicant's position that the use of BITVISION for security devices for others is not likely to cause confusion with the use of the marks relied on by the Opposer for the goods and services for which those marks are used and registered. At the very least, genuine disputes exist concerning

material facts crucial to determination of this opposition. As such, this Board should deny Opposer's Motion and allow this matter to continue on the merits.

II. FACTUAL BACKGROUND

On July 22, 2022, Opposer filed a notice of opposition opposing the application of Applicant's design mark "BITVISION" (Serial No. 90136472), for all goods in class 009, i.e., closed circuit TV systems for security and surveillance, namely, cameras, switchers, monitors, microphones, and recorders. Opposer's Notice of Opposition alleges priority and likelihood of confusion—in violation of Trademark Act Section 2(d), claim preclusion and void *ab initio*.

III. ARGUMENT

Summary Judgment is only appropriate where there is no genuine issue as to any material fact, and the moving party is entitled to judgment as a matter of law. Fed. R. Civ. P. 56; *Celotex Corp. v. Catrett*, 477 U.S. 317, 322-23 (1986). For a dispute to be genuine, the court must be satisfied that evidence exists upon which the finder of fact could reasonably find for the party opposing the motion. *Anderson v. Liberty Lobby, Inc.*, 477 U.S. 242, 248-52 (1986). In determining summary judgment motions, this Court's function is not to weigh the evidence and determine the truth of the matter, but to determine only whether there is a genuine issue for trial. As such, a court considering a motion for summary judgment must view all facts and draw all reasonable inferences from the evidence before it in a light most favorable to the non-moving party. *Anderson*, 477 U.S. at 255.

In a motion for summary judgment, the burden is on the moving party to establish that there are no genuine issues of material fact in dispute, and that it is entitled to judgment as a matter of law. Fed. R. Civ. P. 56(a); *Anderson*, 477 U.S. at 256. Further, a party asserting that a fact cannot be or is genuinely disputed must support the assertion by: (A) citing to particular

parts of materials in the record, including depositions, documents, electronically stored information, affidavits or declarations, stipulations (including those made for purposes of the motion only), admissions, interrogatory answers, or other materials; or (B) 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). Creative Security Technology (hereinafter "Applicant"), as the non-moving party, need only come forward with appropriate evidence demonstrating that there is a pending dispute of material fact. *Anderson*, 477 U.S. at 250.

A. Material Facts for Likelihood of Confusion Are Genuinely Disputed

As will be discussed in more detail below, Opposer makes many unsupported allegations in its brief that fail to establish a likelihood of confusion in this case. Indeed, likelihood of confusion is a question of fact, typically reserved for the jury. *Bd. of Regents of Univ. of Wis. Sys. v. Phx. Int'l Software, Inc.*, 453 F.3d 448, 455 (7th Cir. 2011). As such, a court may only grant summary judgment if no reasonable jury, looking at the seven factors as a whole, could conclude that there is a likelihood of confusion. *Sorensen v. WD-40 Co.*, 792 F.3d 712, 726 (7th Cir. 2015) (emphasis added) (citations omitted). Therefore, when all of these factors are viewed in the light most favorable to Applicant, summary judgment is not appropriate.

a. **Opposer's trademark and Applicant's trademark are dissimilar in many ways**

As an initial matter, the Board must determine if an issue of fact exists regarding the similarity of the Applicant's mark and any of the marks relied on by the Opposer. Applicant's mark consists of design mark, 

, (the "Applicant's Mark"). Opposer claims ownership of the mark Hikvision for closed circuit security devices.

First, the Board will note the Opposer's marks all include, HIKVISION , all capital with red and gray coloring scheme. As to Opposer's design mark, the design element contributes significantly to the commercial impression of the registered mark and the Applicant's Mark has no equivalent to that design component. As to, Bitvision , the Applicant's Mark has no component similar in sight, sound or meaning to the word HIKIVISION. Finally, the Applicant's Mark has no element equivalent to opposers mark. Indeed, a comparison of the Applicant's Mark for and Opposer's marks evidences a low degree of similarity. Therefore, the first du Pont factor weighs against a finding of similarity of marks. Determining the degree of similarity of Opposer's marks to the Applicant's Mark requires a finding of fact. *See, Bose Corp. v. QSC Audio Prods.*, Inc., 293 F. 3d 1367, 1370 (Fed. Cir. 2002). At the very least, Applicant has presented material issues of disputed fact related to the similarity of the Applicant's Mark and the commercial impression, sight, sound, and meaning of each of Opposer's marks and the dispute as to this material fact precludes summary judgment.

B. **Claim is Not Barred by Res Judicata.**

"[U]nder the doctrine of claim preclusion or res judicata, a judgement 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 Sys.*, 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). "[S]ubject to certain well-known exceptions, the general rule is that '[w]hen an issue of fact or law is actually litigated and determined by a valid and final judgment, and the determination is essential to the judgment, the determination is conclusive in a subsequent action between the parties, whether on the same or a different claim.'" *B&B Hardware, Inc. v. Hargis Indus.*, 575 U.S. 138, 148, 113 USPQ2d 2045, 2051 (2015) (quoting Restatement 2d of Judgments § 27, p. 250 (1980)).

Expressly required by the general rule of preclusion is that, to preclude subsequent litigation of an issue, the issue determined must be essential to the judgment in the prior proceeding; when the issue is determined but is not essential to the judgment in the prior proceeding, preclusion is not appropriate. See Restatement 2d of Judgments § 27 (1980). In other words, "[i]f issues are determined but the judgment is not dependent upon the determinations, relitigation of those issues in a subsequent action between the parties is not precluded. Such determinations have the characteristics of dicta and may not ordinarily be subject of an appeal by the party against whom they were made. In these circumstances, the interest in providing an opportunity for a considered determination, which if adverse may be the subject of an appeal, outweighs the interest in avoiding the burden of relitigation." See Comment (h) to Restatement 2d of Judgments § 27 (emphasis added).

An express exception to the general rule of preclusion is that, preclusion is avoided if "the party against whom preclusion is sought could not, as a matter of law, have obtained review of the judgment in the initial action." Restatement 2d of Judgments § 28(1) (1980) (emphasis added). "[T]he availability of review for the correction of errors has become critical to the application of the preclusion doctrine. If the review is unavailable because the party who lost on the issue obtained judgment in his favor, the general rule of § 27 is inapplicable by its own terms. … The exception in Subsection (1) applies only when review is precluded as a matter of law." Comment (a) to Restatement 2d of Judgments § 28; see also 18 Wright, Miller, & Cooper, Federal Practice & Procedure § 4421 at 203 (1981).

The prior opposition proceedings were never adjudicated on the merits; they were obtained by default. The opposer cannot prove that Applicant was ever informed of the prior proceedings and is unable to reply on *res judicata.* A Federal Circuit ruled in 2010: When

applying res judicata to bar causes of action that were not before the court in the prior action, due process of law and the interest of justice require cautious restraint. Restraint is particularly warranted when the prior action was dismissed on procedural grounds. . . . Precedent cautions that res judicata is not readily extended to claims that were not before the court, and precedent weighs heavily against denying litigants a day in court unless there is a clear and persuasive basis for that denial.

The necessary predicate for application of res judicata or claim preclusion is that the claim to be barred must arise out of the same facts. There is no preclusion where, as here, that element is plainly not met.

C. **Caselaw Does Not Require Preclusion.**

No preclusion lies where the prior determination of an issue was not essential to the judgment or could not be appealed by the party against whom preclusion is sought. Case law, as well as the case cited by Opposer in its motion do not require a different result. None of them involve these two critical aspects of the doctrine of res judicata.

In *International Nutrition Co. v. Horphag Research, Ltd.*, 220 F.3d 1325, 55 USPQ2d 1492 (Fed. Cir. 2000), the issue was whether a previous petition to cancel a registration was filed by a party in privity with the petitioner in a subsequent petition to cancel the same registration, and, therefore, barred that latter's petition. Whether a first determination was essential to a judgment in a previous case or whether the previous petitioner had a right to appeal the first determination were not questions at-issue.

In *B.F Goodrich Co. v. Fritz Muller "Coroplast" K.G.,* 138 USPQ 319 (TTAB 1963), the result of a first filed cancellation barred the petitioner from seeking a second petition to cancel the same registration. The only issue in the first proceeding was likelihood of confusion, and the

Board held that a second petition to cancel could not be pursued where the Board found that no likelihood of confusion existed. Again, whether the first determination was essential to the judgment or whether Goodrich had a right to appeal the first determination were not at-issue.

In *Miller Brewing Co. v. Coy International Corp*., 230 USPQ 675 (TTAB 1986), the issue was whether an application for a new design mark filed by Coy International should be barred by res judicata because it was nearly identical to a previous design mark refused registration for likelihood of confusion during an opposition proceeding sustained by the Board. The first opposition proceeding ended with Coy International abandoning its previous design mark with Miller's consent. Again, whether the first determination was essential to the judgment or whether Coy International had a right to appeal did not present themselves.

CONCLUSION

For the foregoing reasons, Applicant respectfully requests that the Board deny Opposer's Cross Motion for Summary Judgment. Applicant further requests that the Board grant Applicant's Motion for Summary Judgment.

Respectfully submitted,

Dated: November 30, 2022

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CERTIFICATE OF SERVICE

I hereby certify that a true and complete copy of the foregoing Applicant's Response to Opposer's Motion for Summary Judgment has been served with Opposer's Attorneys by forwarding said copy on November 30, 2022 via email to:

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