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

Mailed: July 1, 2005

Cancellation Nos. 92043579  
92043899

Kurt M. Markva

v.

Entrepreneur Media, Inc.

Before Quinn, Grendel and Kuhlke, Administrative Trademark  
Judges.

Kuhlke, Administrative Trademark Judge:

Two petitions for cancellation have been filed against  
registrations for the mark ENTREPRENEUR. Cancellation No.  
92043579 was filed on July 26, 2004 against Registration No.  
2263883, for the mark ENTREPRENEUR (standard character form)  
for "advertising and business services, namely, arranging  
for the promotion of the goods and services of others by  
means of a global computer network and other computer online  
services providers; providing business information for the  
use of customers in the field of starting and operating  
small businesses and permitting customers to obtain  
information via a global computer network and other computer

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online service providers and web advertising services namely providing active links to the websites of others" in class 35.<sup>1</sup> This petition to cancel has been brought on the grounds that "the term 'entrepreneur' is descriptive and precludes registration as a trademark and service mark under Trademark Act §2(e)(1) without a showing of secondary meaning under Trademark Act §2(f) ... [and respondent] did not provide evidence that its use of 'entrepreneur' had acquired distinctiveness as applied to such services before [the subject registration] issued on the Principal Register" and that it is "a generic term" that "petitioner has the equal right to use ...for business and advertising services."

Cancellation No. 92043899 was filed on October 20, 2004 against Registration No. 1453968, for the mark ENTREPRENEUR (standard character form) for "paper goods and printed matter; namely magazines, books and published reports pertaining to business opportunities" in class 16.<sup>2</sup> This

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<sup>1</sup> Registration No. 2263883 filed on November 13, 1995 issued on July 27, 1999 alleging a date of first use and use in commerce of July 1992.

<sup>2</sup> Registration No. 1453968 filed May 14, 1985 issued on August 25, 1987 Section 8 affidavit accepted, Section 15 affidavit acknowledged, and alleging a date of first use and use in commerce of May 19, 1983 for the class 9 goods and May 2, 1978 for the class 16 goods. This is, in fact, a petition for partial cancellation, inasmuch as the fee paid is for one class and the petition clearly sets forth that it is against the goods listed in class 16 and not the goods listed in class 9, namely, "computer programs and program user manuals all sold as a unit."

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petition to cancel has been brought on the ground that "the term 'entrepreneur' ... "has become generic as applied to its goods" inasmuch as "it is the common descriptive name that identifies the group to whom [respondent] directs its goods."

These proceedings now come up for consideration of the following motions: (1) respondent's separate motions to dismiss each petition, filed on September 20, 2004 and January 3, 2005 respectively and converted by the Board into motions for summary judgment; (2) petitioner's motions filed on October 20, 2004 and February 8, 2005 to consolidate these proceedings; and (3) petitioner's request, filed on February 8, 2005, for reconsideration of the Board's February 1, 2005 order in Cancellation No. 92043899 to treat the motion to dismiss as one for summary judgment. The motions have been fully briefed.

*Petitioner's Motion to Consolidate*

Inasmuch as these proceedings involve the same parties and common questions of law and fact, it is appropriate to consolidate these proceedings pursuant to Fed. R. Civ. P. 42(a).

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, for example, Wright &

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Miller, *Federal Practice and Procedure: Civ.2d* §2383 (2004);  
*Regatta Sport Ltd. v. Telux-Pioneer Inc.*, 20 USPQ2d 1154  
(TTAB 1991) (Board's initiative).

Accordingly, petitioner's motion is granted and Cancellation Nos. 92043579 and 92043899 are hereby consolidated and may be presented on the same record and briefs.

The Board file will be maintained in Cancellation No. 92043579 as the "parent" case, but all papers filed herein must include the proceeding numbers of the consolidated cases, in ascending order.

*Petitioner's Request for Reconsideration in Cancellation No. 9204343899*

Petitioner requests that the Board reconsider its decision in the order dated February 1, 2005 wherein the Board stated:

Upon further review of this proceeding, the Board notes that respondent's motion to dismiss includes matters outside the pleadings. Accordingly, the Board will treat said motion as one for summary judgment.

The Board further noted in this order that:

Petitioner filed his response to the motion before the Board issued the initial suspension order, but well after the Board had suspended related case 92043579. The September 23, 2004 Board order in the related case informed the parties that the Board would treat respondent's motion to dismiss as one for summary judgment because respondent relied on matters outside the pleadings. The evidence in each proceeding appears to include identical items. Thus, petitioner was on notice that the Board likely would treat respondent's

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motion to dismiss in the instant proceeding as one for summary judgment.

Petitioner requests that the Board "reconsider treatment of registrant's motion to dismiss as a motion for summary judgment." In support of this request, petitioner argues that "registrant's motion to dismiss depends on the application of res judicata regarding the genericness issue" and "if the Board finds that petitioner is not in privity with Scott Smith [third party in the civil action] then no amount of genericness evidence submitted by petitioner will be sufficient to overcome the application of res judicata regarding the Ninth Circuit Court decision." Further, he states that "he has yet to expend the necessary expense for gathering and presenting his evidence and arguments regarding genericness"; therefore, "before the Board determines whether or not he has standing, it is prejudicial to require petitioner to bear the burden of time and expense for gathering, analyzing, and presenting such evidence until the Board assures him that he does have standing." In addition, he argues that the timing of the order is "prejudicial to petitioner because he has already presented evidence and arguments concerning the questions of privity and standing." He goes on to state that he has filed "a motion to consolidate" this proceeding with Cancellation No. 92043579 wherein he "has presented evidence in his pleading for Cancellation No. 92043579 such that a reasonable fact

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finder could decide the question of genericness in favor of petitioner."

A motion for reconsideration is a device that may be used to demonstrate, that, based on the facts before it and the applicable law, the Board's ruling is in error and requires appropriate change. TBMP § 518 (2d ed. rev. 2004).

The operative issue here is whether petitioner should "reasonably have recognized the possibility that the motion to dismiss might be converted into one for summary judgment or was taken by surprise and deprived of a reasonable opportunity to meet the facts outside the pleadings."

*Hoffenberg v. Hoffman & Pollok*, 288 F.Supp.2d 527, 534 (S.D.N.Y. 2003). Where both parties have filed exhibits, affidavits, counter-affidavits, etc. in support of and opposition to a motion to dismiss, a "party cannot complain of lack of a reasonable opportunity to present all material relevant to a motion for summary judgment." *Id.* See also, *United Parcel Serv., Inc. v. California Public Utils. Comm'n*, 839 F.Supp. 702, 704 (N.D.Cal. 1993) reversed on other grounds 77 F.3d 1178 (9<sup>th</sup> Cir. 1996) ("Conversion is proper where the parties have notice that the matter may be considered as a motion for summary judgment, and such notice is implied to parties that submit matters beyond the pleadings for consideration."); Wright & Miller, 5C *Federal*

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*Practice and Procedure: Civ.3d § 1366 (2005) and cases cited therein.*

By way of background, in Cancellation No. 92043579 the Board issued a suspension order on September 23, 2004 and converted respondent's motion to dismiss into a motion for summary judgment in view of materials attached to the motion. Petitioner, in that case, filed its response on October 20, 2004, the same day it filed its petition in Cancellation No. 92043899. On January 3, 2005, respondent filed a similar motion to dismiss in Cancellation No. 92043899 supported by the same documents attached to the motion in Cancellation No. 92043579. In fact, respondent noted in its motion that the Board converted the motion to dismiss in Cancellation No. 92043579 into a motion for summary judgment and "anticipates the Board may choose to do the same here." On January 19, 2005, petitioner filed its response to respondent's motion and on January 25, 2005 the Board initially suspended proceedings pending determination of the "motion to dismiss." Thereafter, the Board issued its order "converting" the motion to dismiss into one for summary judgment.

Under these circumstances, we find that petitioner could "reasonably have recognized the possibility that the motion to dismiss might be converted into one for summary judgment" and was not "taken by surprise." In view thereof,

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we find no error in the Board's February 1, 2005 order. Accordingly, petitioner's request for reconsideration is denied.

*Respondent's Motions for Summary Judgment*

As a preliminary matter, the Board notes that these motions were brought and argued, to a certain extent, under the standard of Fed. R. Civ. P. 12(b)(6). Under that standard, we find that petitioner has set forth allegations sufficient to plead standing and the claims of genericness, descriptiveness, and lack of acquired distinctiveness in Cancellation No. 92043579 and genericness in Cancellation No. 92043899.

Specifically, petitioner has alleged, inter alia, in Cancellation No. 92043579 that: (1) petitioner is an entrepreneur specializing in congressional outreach, federal marketing, public relations, and community outreach [and] provides general strategic advice for entrepreneurial clients needing to go through the legislative and regulatory process; (2) petitioner recently began a consulting and lobbying business that requires certain business and advertising services to be conducted over the [Internet] [and] petitioner's mark ENTREPRENEURGR-IP informs his target group of entrepreneurs of his government resource and intellectual property information services; 3) petitioner is one who has a sufficient interest in using the descriptive



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term "entrepreneur" in its business [and the subject registration] for the mark ENTREPRENEUR is for advertising and business services conducted on the Internet; 4) petitioner believes that [the subject registration] is inconsistent with petitioner's equal right to use the descriptive and generic term on similar goods and/or services; 5) petitioner believes that registrant's mark ENTREPRENEUR should be cancelled because it is descriptive and generic when applied to its advertising and business services over the Internet to the same target group of entrepreneurs; 6) entrepreneur is defined as a "person who organizes, operates, and assumes the risk for a business venture" and as "one who organizes, manages, and assumes the risks of a business or enterprise" and no equivalent word exists for "entrepreneur"; 7) petitioner is an entrepreneur, he offers business and advertising services to a target group of entrepreneurs, the same group of entrepreneurs for which registrant offers its business and advertising services for sale [and] as such, "entrepreneur" and "entrepreneurs" are descriptive and generic terms and thus are unregistrable under the Trademark Act §2(e)(1); 8) registrant did not prove acquired distinctiveness for its descriptive mark during prosecution of its application for registration [and] registrant's mark did not achieve secondary meaning pursuant to Trademark Act §2(f).

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Petitioner has alleged, inter alia, in Cancellation No. 92043579 that: 1) registrant's mark has become generic as applied to its goods as it is the common descriptive name that identifies the group to whom registrant directs its goods, namely, entrepreneurs; 2) registration of its mark is inconsistent with petitioner's equal right to use the term on similar goods or services as a generic designation; 3) registrant uses the word "entrepreneur" generically to describe the target group to whom it directs its goods and services; 4) petitioner has standing to request cancellation of registrant's mark in that he is a self-employed entrepreneur who is the sole principal in a Virginia organized entity engaged in the business of consulting and lobbying on behalf of small entrepreneurial clients; 5) petitioner conducts certain business and advertising services informing his target group of entrepreneurs of his government resource and intellectual property information services; 6) petitioner is in a position to have a right to use of the term "entrepreneur," which is generic as applied to registrant's goods and/or services, and there is no other word that can be used to describe the group of purchasers of his goods and/or services.

In order to establish its standing to object to the registration of an allegedly merely descriptive or generic term, a plaintiff need only show that it has a real interest

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in the proceeding because it is one who has a present or prospective right to use the term descriptively in its business. See *Binney & Smith Inc. v. Magic Marker Industries, Inc.*, 222 USPQ 1003 (TTAB 1984). See also *Plyboo America Inc. v. Smith & Fong Co.*, 51 USPQ2d 1633 (TTAB 1999). The allegations enumerated above clearly set forth a "real interest" in the proceedings. Moreover, petitioner has sufficiently set forth allegations of descriptiveness, lack of acquired distinctiveness and genericness.

We now turn to our review of the motions under the summary judgment standard in view of the attached materials. The summary judgment motion is a pre-trial device to dispose of cases in which the "pleadings, depositions, answers to interrogatories, and admissions of fact, together with the affidavits, if any, show that there is no genuine issue as to any material fact and that the moving party is entitled to judgment as a matter of law." Fed. R. Civ. P. 56(c). The moving party has the burden of establishing the absence of any genuine issues of material fact and that it is entitled to judgment as a matter of law. *Id.* All doubts as to whether any factual issues are genuinely in dispute must be resolved against the moving party and all inferences must be viewed in the light most favorable to the non-moving

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party. See *Olde Tyme Foods Inc. v. Roundy's Inc.*, 961 F.2d 200, 22 USPQ2d 1542 (Fed. Cir. 1992).

Respondent's arguments in Cancellation No. 92043579 fall into two categories: 1) petitioner does not have standing because petitioner "does not plead a real commercial interest in his own mark or a reasonable basis for his belief that he would be damaged by the existence of [respondent's] registration" [because he] "has no previous or legitimate interests in his newly crafted 'mark'"; and 2) petitioner has no valid grounds because of the "decision [by the Court of Appeals for the Ninth Circuit in a civil action between respondent and a third party] as to the non-genericness of [respondent's] ENTREPRENEUR marks [and] [t]he District Court's decision [on remand], following a trial on the merits, established that the mark ENTREPRENEUR has acquired a secondary meaning."

In support of its motion, respondent submitted under the declaration of Michele D. Johnson: 1) status and title copies of its Registration No. 1453968 for the mark ENTREPRENEUR and Registration No. 2263883, the subject registration; 2) a copy of the "Findings of Fact and Conclusions of Law," entered June 24, 2003, by the U.S. District Court for the Central District of California, in *Entrepreneur Media, Inc. v. Smith*, Case No. CV 98-3607; 3) a copy of the "Judgment and Permanent Injunction" entered

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September 11, 2000, in *Entrepreneur Media, Inc. v. Smith*; and 4) a copy of the "Judgment and Permanent Injunction" following a bench trial, entered July 10, 2003, in *Entrepreneur Media, Inc. v. Smith*. In addition, respondent submitted with its reply brief, for the first time, various articles and web pages from the Internet supported by the declaration of Michele Johnson.

The crux of respondent's argument is that petitioner is in some way associated with Scott Smith, a third party, who was a party to a civil action brought by and decided in favor of respondent and the decision in that civil action has a preclusive or precedential effect on this proceeding. Respondent supports its argument that there is an association between petitioner and Scott Smith by comparing the recitation of services in petitioner's pending application with an application filed by Scott Smith and noting the timing of petitioner's business activities and the filing of this petition. Further, respondent provided evidence of an intellectual property protection coalition co-founded by petitioner and Scott Smith in 2004.

Petitioner responds that: 1) he has standing inasmuch as damage is presumed in the case of a petitioner who has a sufficient interest in using the descriptive term in his business and petitioner is such a plaintiff; and 2) respondent's attempt to raise "the issue of res judicata as

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a bar to petitioner's right...to cancel [respondent's] registrations for the mark ENTREPRENEUR based on genericness and/or descriptiveness is unavailing inasmuch as petitioner was not a party or in privity with a party to the prior civil action.

In support of his response, petitioner, Kurt Markva, submitted a declaration attesting to his prior occupations and current business activities accompanied by several exhibits, including an article from the New York Times discussing respondent's enforcement efforts. In addition, attached to the petition for cancellation are approximately 400 pages of various allegedly generic or descriptive uses of the term ENTREPRENEUR.<sup>3</sup>

In reply, respondent argues that petitioner failed to satisfy his burden of raising facts for trial. Further, respondent argues that res judicata is not relevant. Rather the issue is that "the Ninth Circuit has ruled as a matter of law that ENTREPRENEUR is not generic, and that decision is controlling precedent on the precise issue in this petition [and] [t]he Board is not permitted to disregard circuit precedent." Respondent further argues that the Board "should not substitute its judgment for the federal

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<sup>3</sup> We consider this matter before the Board on summary judgment inasmuch as it was attached to the petition for cancellation, expressly referred to in the petition for cancellation and brought into issue by respondent's arguments in its moving brief. See *Rose v. Bartel*, 871 F.2d 331 (3d Cir. 1989).

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court of appeals for the Ninth Circuit" that "ENTREPRENEUR is not generic," but if the Board does, then "[n]one of [petitioner's] evidence gives rise to any inference to the contrary, and thus [petitioner] is entitled to judgment as a matter of law." Finally respondent argues, that petitioner "has failed to come forward with specific evidence showing that there is a genuine issue" as to secondary meaning and "no evidence that the ENTREPRENEUR mark is descriptive and that [respondent] failed to produce to the Patent & Trademark Office evidence of secondary meaning."

Respondent's arguments in Cancellation No. 92043899 fall into the same two general categories but slightly evolved, specifically: 1) petitioner does not have standing because "he is prevented by court order from using his mark [ENTREPRENEURGR-IP inasmuch as] [t]he permanent injunction entered after the [prior third party case] forbids [the third party] and all persons in active concert or participation with [the third party] from using any mark that 'is a colorable imitation' of or 'likely to cause confusion' with...[respondent's] family of ENTREPRENEUR marks" and petitioner is "in active concert with [the third party]"; therefore, he lacks a real commercial interest in his own mark or a reasonable basis for his belief that he would be damaged by the existence of the subject registration; and 2) "[t]he Ninth Circuit has previously and

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specifically held that [respondent's] ENTREPRENEUR mark in Class 16 is not generic [and] [t]he Board is bound by this controlling and on-point circuit court precedent."

Petitioner's response is essentially the same as his response to the motion in Cancellation No. 92043579. Petitioner adds that in addition to lack of privity res judicata cannot apply because the discussion of non-genericness appearing in a footnote of the decision by the Court of Appeals for the Ninth Circuit is dictum.

In reply, respondent, for the first time in briefing the motions for these two proceedings, clarifies that its argument is based on stare decisis not res judicata stating that "[b]ecause the Ninth Circuit has previously rejected the entire basis for [petitioner's] Petition, and [petitioner] wholly fails to demonstrate that the previous decision was erroneous, the petition must be dismissed."

A review of the prior litigation is in order. The prior civil action was between respondent, Entrepreneur Media, Inc. (EMI), as plaintiff, and a third party, Scott Smith (Smith), as defendant. It is not clear what the exact claims were in the civil action inasmuch as the pleadings are not of record; however, it is clear that EMI alleged that Smith infringed "EMI's federally registered trademark 'ENTREPRENEUR' by using the word 'entrepreneur' in connection with his public relations company." *Entrepreneur*



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*Media, Inc. v. Smith*, 279 F.3d 1135 (9<sup>th</sup> Cir. 2002).<sup>4</sup> The United States District Court for the Central District of California (District Court) granted summary judgment in favor of EMI. The exact nature of the summary judgment decision is unknown inasmuch as there is no order of record that explains the District Court's decision. On appeal to the Ninth Circuit that decision was affirmed in part, reversed in part, and remanded for a trial on the merits. The Court affirmed the grant of summary judgment to EMI "on the question whether Smith infringed EMI's trademark by his use of the mark 'Entrepreneur Illustrated' on the cover of that publication" and reversed and remanded as to all other issues. *Id.* In its analysis of likelihood of confusion between the parties' marks the Court looked at several factors including the strength of EMI's mark and concluded that "its mark is weak." It is unclear if this finding pertains to EMI's use of ENTREPRENEUR in connection with advertising and business services and, in fact, Registration No. 2263883 had not issued at the time the civil action was filed and does not appear to be a part of the Ninth Circuit's decision. The description of EMI's marks include the mark ENTREPRENEUR for use in connection with a magazine, computer programs, trade show exhibitions, seminars and

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<sup>4</sup> The Board notes that although the Ninth Circuit opinion was not made of record, it is a published decision.

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workshops. In determining whether the mark was descriptive or suggestive, the court ruled out the possibility that it was generic by noting in a footnote that "'ENTREPRENEUR' does not state the general name of EMI's product - a magazine - and therefore does not fit within the generic category." *Id.* at 1141 n. 2 citing *Kendall-Jackson Winery, Ltd. V. E. & J. Gallo Winery*, 150 F.3d 1042 (9<sup>th</sup> Cir. 1998) (case involved a grape leaf design for wine). This statement only pertains to use in connection with a magazine. In addition, the court does not discuss evidence or argument presented regarding any alleged genericness of the word ENTREPRENEUR used as title for a magazine. The court went on to find that "the mark 'ENTREPRENEUR' as applied to EMI's magazine and to computer programs and manuals falls within the descriptive category." Further, the court states that it "describes both the subject matter and the intended audience of the magazine and programs." The court noted that "the incontestable status of EMI's mark serves as conclusive proof that the mark has secondary meaning." *Id.* at 1142 n. 3. This statement relates to the goods listed in Registration No. 1453968, namely magazines and computer programs. However, the court went on to review evidence of descriptiveness of the term in analyzing the scope of protection to be accorded EMI's "incontestable" trademark ENTREPRENEUR and essentially found that genuine

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issues of material fact remained for trial on the issue of the strength of EMI's mark, i.e., the scope of protection.

On remand the District Court, after a bench trial, found in favor of EMI on the infringement claim. In the "Findings of Fact" the court found that: 1) EMI uses its mark ENTREPRENEUR in connection with several magazines and on its web site; 2) EMI has an incontestable registration for ENTREPRENEUR (Registration No. 1453968) and a registration for ENTREPRENEUR for advertizing and business services (Registration No. 2263883) and other registrations for marks that include the term ENTREPRENEUR; and 3) EMI is "well-known for its Entrepreneur magazine, as well as for the other magazines and services it produces and provides." In its "Conclusions of Law" the court found that: 1) EMI's mark was "strong enough to support a finding of likelihood of confusion"; 2) both parties "used their marks in connection with printed publications geared for small businesses...[i]n addition, both companies provide public relations services...[t]hus, the goods are related"; 3) [b]ecause [EMI] has an incontestable registration for the mark ENTREPRENEUR, this court must conclusively presume that ENTREPRENEUR has acquired secondary meaning; 4) "[b]ased on the foregoing analysis, Smith's use of the marks...has caused and will continue to cause a likelihood of confusion with [EMI's] registered mark ENTREPRENEUR."

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To the extent respondent was arguing for the application of issue preclusion, respondent has not established that issue preclusion applies inasmuch as genuine issues of material fact remain as to any possible privity between Scott Smith, the party in the civil action, and petitioner in these proceedings.

With regard to the argument that the prior decision may have a stare decisis effect on these proceedings, our primary reviewing court has stated: "Only after the factual issues are resolved appropriately in the second case can stare decisis on the ultimate legal conclusion respecting "validity" be invoked where the same controlling facts are found in each case... No precedent eliminates the need for independent factfinding in the second trial before stare decisis applies." *Mendenhall v. Cedarapids, Inc.*, 5 F.3d 1557, 1571 (Fed. Cir. 1993). See also *Marshak v. Sheppard*, 666 F.Supp. 590, 598 (S.D.N.Y. 1987) (prior finding of validity of a trademark may be overcome if defendant "present[s] 'persuasive new evidence' of invalidity and demonstrate[s] that there is a 'material distinction' between the cases"); *Gately v. Com. Of Mass.*, 2 F.3d 1221 (1<sup>st</sup> Cir. 1993) ("As stare decisis is concerned with rules of law, however, a decision dependent upon its underlying facts is not necessarily controlling precedent as to a subsequent analysis of the same question on different facts

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and a different record"); *Application of Ruscetta*, 45 C.C.P.A. 968, 255 F.2d 687 (CCPA 1958) ("...undue liberties should not be taken with court decisions, which should be construed in accordance with the precise issue before the court, and that a fertile principle established in one case to another case in which the facts are essentially different and the principle has no application whatsoever"); *U.S. v. Rembrandt Electronics, Inc.*, 64 C.C.P.A. 1, 542 F.2d 1154 (CCPA 1976) ("Departures from precedent are not favored, but stare decisis must give way when restudy of the facts and issues clearly shows error in earlier opinions"); McCarthy, J. Thomas, McCarthy on Trademarks and Unfair Competition, Section 32:93 (4<sup>th</sup> ed. database updated 2005) ("Where res judicata cannot be applied because of the different lineup of parties in the second suit, the rule of stare decisis that a prior finding that a mark is valid compels a finding of validity in the second action in the absence of a showing that the prior holding was manifestly erroneous.").

Setting aside the issue of whether petitioner was fully apprised of respondent's argument based on stare decisis, in particular in view of the manner in which it was originally framed in connection with the lack of standing argument hinging on a relationship between Scott Smith and petitioner, under these circumstances, this issue may be better presented at trial in order to fully assess whether

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or not "new evidence" presents a "material distinction between the cases" such that a finding of validity would be overcome. Particularly with regard to Cancellation No. 92043579 involving the registration for the advertising and business services, it is not completely clear from the District Court's decision alone that secondary meaning was found as to that particular mark used in connection with the services as recited in the registration, that the secondary meaning was achieved prior to issuance of the registration and, if it is not inherently distinctive and did not register under section 2(f) of the Trademark Act, if that is grounds for cancellation. *Cf. Kellogg Co. v. Pack'Em Enterprises Inc.*, 14 USPQ2d 1545 (TTAB 1990) affirmed on other grounds 21 USPQ2d 1142 (Fed. Cir. 1991).

Even as to Cancellation No. 92043899, the discussion as to non-genericness appears to be based on the Ninth Circuit's understanding of genericness in the field of magazines as a matter of law, rather than on a fact-finding determination. In that regard, we direct the parties to the decision of our primary reviewing court, the Court of Appeals for the Federal Circuit, on the issue of genericness as it pertains to magazine titles, *H. Marvin Ginn Corp. v. International Association of Fire Chiefs, Inc.*, 782 F.2d 987, 228 USPQ 1141 (Fed. Cir. 1986) wherein the court stated:

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Having reviewed the decisions regarding the genericness and registrability of magazine titles, we conclude that in such cases, as in most trademark cases, it is difficult to postulate any general rule. The approach to the issue presented here, then, must be on a case-by-case basis. Thus, in examining the question of genericness of a magazine title, the two-step inquiry outlined above is the appropriate test. First, what is the class of publications or magazines at issue? Second, is the title understood by the relevant public to refer primarily to that class of magazines?

In finding that the title "FIRE CHIEF" is not generic for magazines, the court stated that the class of magazines at issue was directed to the field of fire fighting and noted that no record evidence suggested that the relevant portion of the public refers to a class of fire fighting publications as "Fire Chief" and that the term "Fire Chief," is neither the name of the fire-fighting industry nor about the fire-fighting industry.

After careful consideration of the parties' arguments and evidence, we find that respondent has not met its burden. At a minimum, genuine issues of material fact remain for trial with regard to the effect of the prior litigation, both as to privity and stare decisis, and with regard to the facts underlying petitioner's standing.<sup>5</sup>

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<sup>5</sup> Respondent's request in its reply brief in Cancellation No. 92043579 for discovery under Fed. R. Civ. P. 56(f) is procedurally flawed; respondent brought the summary judgment motion and may not request further discovery in support of its summary judgment motion. See Fed. R. Civ. P. 56(f). The rule is not designed to provide moving parties an opportunity to bolster their already filed motion, but rather to allow the opposing party to obtain essential information in order to respond.

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In view of the above, respondent's motions for summary judgment are denied.

Proceedings in Cancellation Nos. 92043579 and 92043899 are resumed, respondent is allowed until **THIRTY DAYS** from the mailing date of this order to file an answer in each proceeding, and dates are reset for these consolidated proceedings as indicated below.

DISCOVERY PERIOD TO CLOSE:	<b>December 17, 2005</b>
Thirty-day testimony period for party in position of plaintiff to close:	<b>March 17, 2006</b>
Thirty-day testimony period for party in position of defendant to close:	<b>May 16, 2006</b>
Fifteen-day rebuttal testimony period to close:	<b>June 30, 2006</b>

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