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

Cataldo

Mailed: August 16, 2005

Cancellation No. 92044209

Samuel Rosenblatt and Helene
Rozenblat d/b/a Eres

v.

Eres

Before Quinn, Chapman and Kuhlke,
Administrative Trademark Judges.

By the Board:

Petitioners, Samuel Rosenblatt and Helene Rozenblat, d/b/a Eres, have petitioned to cancel the registration of respondent, Eres, a French company, for the mark shown below for "swim wear, beachwear, pants, shirts, dresses, blouses, T-shirts, jumpsuits, shorts, sleepwear, loungewear, lingerie, body suits and underwear" in Class 25.¹



In their petition to cancel, petitioners assert priority and likelihood of confusion as a ground for cancellation of

¹ Registration No. 2,320,998 was issued on February 22, 2000, reciting 1920 as the date of first use and 1969 as the date of first use in commerce on the goods.

respondent's mark. In its answer, respondent denies the salient allegations contained in the petition to cancel. In addition, respondent pleads certain affirmative defenses, including that petitioners' claim is barred by res judicata.

This case now comes before the Board for consideration of respondent's motion for summary judgment on the ground of claim preclusion.² The motion is fully briefed.

Summary judgment is an appropriate method of disposing of cases in which there are no genuine issues of material fact in dispute, 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 the absence of any genuine issue of material fact. See *Celotex Corp. v. Catrett*, 477 U.S. 317 (1986); and *Sweats Fashions Inc. v. Pannill Knitting Co.*, 833 F.2d 1560, 4 USPQ2d 1793 (Fed. Cir. 1987). A factual dispute is genuine if, on the evidence of record, a reasonable finder of fact could resolve the matter in favor of the non-moving party.

² As a preliminary matter, we note that respondent asserts res judicata as the ground for its summary judgment motion. The phrase "res judicata" refers to the effects of a prior judgment that may include the principles of claim preclusion and/or issue preclusion. See 18 Wright, Miller & Cooper, *Federal Practice and Procedure: Jurisdiction* §4402 (1981 and 2001 Supplement). In this case, respondent grounds its summary judgment motion on the doctrine of claim preclusion. See *Vitaline Corp. v. General Mills Inc.*, 891 F.2d 273, 13 USPQ2d 1172 (Fed. Cir. 1989). Accordingly, we have not considered the question of whether petitioners' cause of action is barred by the doctrine of issue preclusion.

See Opryland USA Inc. v. Great American Music Show Inc., 970 F.2d 847, 23 USPQ2d 1471 (Fed. Cir. 1992); and *Olde Tyme Foods Inc. v. Roundy's Inc.*, 961 F.2d 200, 22 USPQ2d 1542 (Fed. Cir. 1992). The evidence must be viewed in a light most favorable to the non-movant, and all justifiable inferences are to be drawn in the non-movant's favor. See *Lloyd's Food Products Inc. v. Eli's Inc.*, 987 F.2d 766, 25 USPQ2d 2027 (Fed. Cir. 1993); and *Opryland USA, supra*.

As to respondent's summary judgment motion, the parties do not dispute the following facts: On October 5, 1976, Registration No. 1,049,649 was issued to Madame Irene Pinkus for the mark shown below for "bathing suits, beachwear and women's sportswear-namely, tunics, coats, dresses, skirts, and pants."



On May 29, 1979, Samuel Rosenblatt commenced a cancellation proceeding against Registration No. 1,049,649, (Cancellation No. 12,342). In an order issued on January 14, 1986, the Board denied the petition to cancel after a trial on the merits. Mr. Rosenblatt appealed the Board's decision to the United States District Court of Appeals for the Federal Circuit. On November 19, 1986, the Federal Circuit affirmed the Board's order denying the petition to cancel.

Respondent essentially argues in its motion that Samuel Rosenblatt, petitioner in the earlier cancellation proceeding, is one of the petitioners herein; that the petitioners in the two cancellation actions thus are in privity; that respondent herein has obtained its rights in the mark at issue by assignment from Madame Irene Pinkus, respondent in the earlier cancellation; that the respondents in the two cancellation actions thus are in privity; that the earlier cancellation was decided by the Board in a final decision on the merits which was affirmed by the Federal Circuit; that the two cancellation actions involve the same transactional facts; and that, as a result, petitioners are barred by the doctrine of claim preclusion from bringing the instant cancellation proceeding.

Petitioners, in turn, argue that respondent has failed to meet its burden of demonstrating the absence of genuine issues of material fact regarding (1) the claim of privity between Madame Irene Pinkus and Eres; (2) the differences between the marks in the registrations subject to the two cancellation actions; and (3) the differences between the goods recited in the registrations at issue in the two cancellation actions.

Respondent argues in reply that it has made a clear showing of privity between Madame Pinkus and Eres; that there was a final judgment against a party in privity with

petitioners in the earlier cancellation action; that the marks in the two proceedings are legally equivalent; and that the goods involved in both proceedings are legally equivalent.

Under the doctrine of claim preclusion, the entry of a final judgment on the merits of a claim in a proceeding serves to preclude the relitigation of the same claim in a subsequent proceeding between the parties or their privies, even in those cases where the prior judgment was the result of default. See *Treadwell's Drifters Inc. v. Marshak*, 18 USPQ2d 1318 (TTAB 1990). Thus, a second suit is barred by claim preclusion if (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 claim. See *Jet, Inc. v. Sewage Aeration Systems*, 223 F.3d 1360, 55 USPQ2d 1854 (Fed. Cir. 2000).

We begin by determining whether petitioners' claim in the instant cancellation is based upon the same set of transactional facts as the claim asserted by Mr. Rosenblatt in Cancellation No. 12,342. In evaluating the similarity of the claims, we have "looked to whether the mark involved in the first proceeding is the same mark, in terms of commercial impression, as the mark in the second

proceeding." See *Institut National Des Appellations d'Origine v. Brown-Forman Corp.*, 47 USPQ2d 1975 (TTAB 1998).

In this case, we find that there is no genuine issue of material fact that the mark, ERES TOP SHOP (in stylized form), at issue in Cancellation No. 12,342, is too different from respondent's mark, ERES (in stylized form), at issue herein, to be considered part of the same transaction or series of transactions. See *Polaroid Corp. v. C. & E. Vision Services Inc.*, 52 USPQ2d 1954 (TTAB 1999).

Specifically, we find no genuine issue that the absence of the wording "TOP SHOP" from respondent's mark in the instant cancellation causes the ERES mark challenged herein to have a commercial impression different from that of the prior mark.³ With respect to the goods recited in each registration, we find no genuine issue that the identification of goods in Registration No. 2,320,998, at issue herein, is not fully encompassed by the identification in the earlier Registration No. 1,049,649. That is, the "shirts, blouses, T-shirts, jumpsuits, shorts, sleepwear, loungewear, lingerie, body suits and underwear" recited in the later registration fall outside the scope of the goods

³ The parties will note that our comparison herein of the commercial impression of respondent's involved marks is only for purposes of determining whether petitioners' cause of action is barred by claim preclusion. Our decision herein does not compare petitioners' asserted mark with that in respondent's challenged registration for purposes of determining petitioners' likelihood of confusion claim.

recited in the earlier registration. Further, the "tunics, coats, and skirts" recited in the earlier registration fall outside the scope of the goods recited in the later registration.

As such, we find no genuine issue that the marks and goods involved in the two cancellation proceedings are not part of the same transaction, and the third element of issue preclusion is not satisfied. Thus, the present claim asserted by petitioners is not the same as the claim previously asserted by Mr. Rosenblatt and cannot, as a matter of law, be precluded by the doctrine of claim preclusion.

In view thereof, respondent's motion for summary judgment is denied.⁴

If the Board concludes, upon motion for summary judgment, that there is no genuine issue of material fact, but that it is the nonmoving party, rather than the moving party, which is entitled to judgment as a matter of law, the Board may, in appropriate cases, enter summary judgment *sua sponte* in favor of the nonmoving party (even though there is no cross-motion for summary judgment). *See, for example,*

⁴ The parties should note that the evidence submitted in connection with the motion for summary judgment 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 their appropriate trial periods. *See Levi Strauss & Co. v. R. Joseph Sportswear Inc.*, 28 USPQ2d 1464 (TTAB 1993).

Accu Personnel Inc. v. Accustaff Inc., 38 USPQ2d 1443, 1446 (TTAB 1996); and *The Clorox Company v. Chemical Bank*, 40 USPQ2d 1098 (TTAB 1996).

In this case, we have determined that as a matter of law respondent cannot prevail upon the theory of claim preclusion. Accordingly, we hereby enter summary judgment, sua sponte, in favor of petitioner on the issue of claim preclusion.⁵

Proceedings herein are resumed, and trial dates, beginning with the close of the discovery period, are reset as indicated below. 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. See Trademark Rule 2.125.

DISCOVERY TO CLOSE:	January 31, 2006
Thirty-day testimony period for party in position of plaintiff to close	May 1, 2006
Thirty-day testimony period for party in position of defendant to close	June 30, 2006

⁵ The decision herein on summary judgment is interlocutory in nature. The time for seeking judicial review of this decision shall expire two months from the date on which a final order is entered in this case. Any appeal prior to that time is premature. See *Copelands' Enterprises, Inc. v. CNV, Inc.*, 887 F.2d 1065, 12 USPQ2d 1563 (Fed. Cir. 1989).

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Fifteen-day rebuttal
testimony for party in
position of plaintiff to close August 14, 2006

Briefs shall be filed in accordance with Trademark Rule
2.128(a) and (b). An oral hearing will be set only upon
request filed as provided by Trademark Rule 2.129.