

UNITED STATES PATENT AND TRADEMARK OFFICE  
Trademark Trial and Appeal Board  
P.O. Box 1451  
Alexandria, VA 22313-1451  
General Contact Number: 571-270-8500

wbc

Mailed: July 23, 2016

Cancellation No. 92061096

*Shirley A. Dicko*

*v.*

*Everett and Jones Barbeque –  
Jack London, LLC*

**By the Trademark Trial and Appeal Board:**

On January 27, 2016, the Board issued a show cause order requesting the parties provide the Board with an explanation as to whether the court actions, which occasioned the suspension of this proceeding, are finally determined and if so, how, if at all, the decisions in these court actions may have a bearing upon this proceeding. On March 31, 2016, having found the parties had still not been provided an explanation of how the final decision in the civil action in Superior Court of California, styled *Shirley Everett-Dicko v. Everett and Jones Barbeque-Jack London, LLC, et al*, case no. RG12634726 and any related appeals, has a bearing on this Board proceeding, the Board ordered the parties to explain how the civil action has a bearing on this Board proceeding. On April 10, 2016, Petitioner responded to the Board order and Respondent filed its response on April 22, 2016.<sup>1</sup>

---

<sup>1</sup> The Board has considered the parties' submissions and presumes the parties' familiarity with the factual bases for the filings and does not recount them here, except as necessary to explain the Board's order. *See Guess? IP Holder L.P. v. Knowlux LLC*, 116 USPQ2d 2018, 2019 (TTAB

Petitioner argues that while the civil action is finally determined, it “has no bearing on this proceeding.” In its response, Respondent requests this proceeding be dismissed arguing that Petitioner’s claim of fraud is barred under the doctrines of claim and issue preclusion based on the judgment in the civil action. In support of their respective arguments, Petitioner and Respondent both included copies of Petitioner’s amended complaint in the civil action and a copy of the court’s judgment dated April 9, 2015.

The Board notes that the court’s judgment, reads, in pertinent part, that:

Defendants, and each of them, moved for non-suit pursuant to California Code of Civil Procedure § 581c and said motion was GRANTED by the court with respect to claims for relief numbers 1,2,3,4,6,7,8 and with respect to the claim for Injunctive Relief in the 10<sup>th</sup> cause of action. After the granting of said motions ...

Neither party has provided the Board with a copy of the noted motion nor the court’s order granting the motion. Further, at 20 TTABVUE pp. 2-14, the Petitioner provided the Board with copies of its *Objection to (Proposed) Judgment After Trial by Court*, its *Notice of Motion for Clarification, Amendment, or Reconsideration of Tentative Ruling Order*, but has not provided the Board with a copy of the court’s order, if any, regarding these filings. In short, there are a number of documents, which appear to be pertinent to the Board’s review of whether the judgment in the civil action has a bearing on this proceeding, that are not a part of the record in this proceeding.

---

2015) (“[T]here is no requirement that the Board’s order repeat or discuss irrelevant arguments.”).

In view thereof, to the extent Respondent seeks dismissal of this proceeding based on claim and/or issue preclusion, Respondent's motion is **denied** without prejudice.<sup>2</sup>

Notwithstanding the foregoing, inasmuch as Respondent has not filed an answer to Petitioner's November 5, 2015 amended petition to cancel,<sup>3</sup> but has argued that this proceeding should be dismissed under the doctrines of claim and/or issue preclusion, relying on matters outside of the pleadings, the Board hereby construes Respondent's arguments as seeking relief under summary judgment based on the doctrines of claim and/or issue preclusion. Accordingly, the Board hereby orders Respondent to re-brief its arguments as a motion for summary judgment, by **August 30, 2016**, in regard to the issue of whether the doctrines of claim and/or issue preclusion are applicable to this proceeding, pursuant to Fed. R. Civ. P. 56 and Trademark Rule 2.127(e), 37 C.F.R. § 2.127(e). The parties may present any material relevant to such motion. Petitioner is allowed until **September 30, 2016** to serve and file such brief evidence, and/or affidavits as appropriate under Federal Rule 56(e)(3) and Trademark Rule 2.127(e)(1), in response to Respondent's claim that the petition for cancellation is barred under the doctrines of claim and/or issue preclusion. The time for Respondent to file a reply brief, if any, shall be in accordance with Trademark Rule 2.127(e)(1).

---

<sup>2</sup> Pending review of the Board's motion for summary judgment, the show cause order is hereby discharged.

<sup>3</sup> Petitioner filed an amended petition to cancel on November 5, 2016 alleging fraud as its sole ground for cancellation, which is Petitioner's operative pleading. The Board notes Petitioner makes reference to Section 2(d), likelihood of confusion, in the petition to cancel but has not properly pleaded this claim, nor does it appear Petitioner has attempted to plead likelihood of confusion as a separate claim. In any event, the Board notes Respondent's registration is older than five years. *See* TBMP § 307.02(a) ("a petitioner may not seek to cancel a Principal Register registration over 5 years old on the ground of likelihood of confusion.").

It is incumbent upon the parties to provide the Board with a *complete* record regarding the judgment in the civil action such as copies of motions and court orders pertaining to the judgment,<sup>4</sup> to explain whether and/or how they have a bearing upon this proceeding, and to explain why the judgment in the civil action provides a basis to grant and/or dismiss the petition to cancel.

Proceedings remain suspended except as noted above. Any paper filed during the pendency of this motion which is not relevant thereto will be given no consideration. *See* Trademark Rule 2.127(d), 37 C.F.R. § 2.127(d).

---

<sup>4</sup> In particular, the Board orders the parties to provide the Board with a copy of the noted California Code of Civil Procedure § 581c motion and related order, discussed above.