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

Proceeding	92061096
Party	Defendant Everett and Jones Barbeque - Jack London, LLC
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Date	10/03/2016
Attachments	ReplySJM.pdf(1063958 bytes)

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

Shirley A. Dicko,)	
)	Cancellation No. 92061096
Plaintiff,)	
vs.)	Registration No.: 3747512
)	
Everett and Jones Barbeque – Jack London,)	Filed: March 12, 2015
LLC,)	Mark: EVERETT AND JONES
)	
Defendant.)	

**DEFENDANT’S REPLY TO OPPOSITION TO
MOTION FOR SUMMARY JUDGMENT**

I. “Material” Facts

Although Plaintiff does not dispute any material fact proffered by Defendant in support of its contention that the doctrines of *res judicata* and collateral estoppel are applicable in the instant matter, including the facts that (i) Plaintiff alleged that *Defendant committed fraud in obtaining Reg. No. 3747512* for the *Everett and Jones* trademark in the prior CA Superior Court Action, and is similarly alleging that *Defendant committed fraud in obtaining Reg. No. 3747512* in the Cancellation Proceeding, (ii) Plaintiff’s *fraud claim* in the Cancellation Proceeding is based on substantially similar allegations and, hence, the same nucleus of operative alleged facts that were presented by Plaintiff in the CA Superior Court Action, and (iii) a seminal determinative issue that was before the CA Superior Court: namely, whether Defendant knowingly made false and misleading statements to the USPTO Examining Attorney with the intent to deceive the Examining Attorney into believing that Defendant was the owner of the *Everett and Jones* trademark *to obtain registration of the Everett and Jones trademark* on the Principal Register, is the same distilled issue that is now before the Board in the Cancellation

Proceeding, Plaintiff contends that other alleged material facts and, hence, issues *relating to an unpleaded claim*, i.e. entitlement to concurrent use registration of Defendant's *Everett and Jones* trademark, exist and, based thereon, *res judicata* and collateral estoppel are inapplicable in the instant matter.

Entitlement to concurrent use registration of Defendant's *Everett and Jones* trademark was not, however, plead by Plaintiff and, hence, is not before the Board in the Cancellation Proceeding.

Plaintiff expressly objects to Defendant's assertion of the alleged existence of other facts and/or issues relating to rights to concurrent use and/or concurrent use registration of the *Everett and Jones* trademark, and any assertion or contention proffered by Defendant in its Opposition relating to concurrent use rights and/or concurrent use registration of the *Everett and Jones* trademark.

Section 528.07(b) of the Trademark Trial and Appeal Board Manual of Procedure also prohibits such assertion(s) in opposition to a motion for summary judgment. Indeed, Section 528.07(b) provides that "[a] party may not defend against a motion for summary judgment by asserting the existence of genuine disputes of material fact as to an unpleaded claim or defense." TBMP § 528.07(b). See also *Perma Ceram Enterprises Inc. v. Preco Industries Ltd.*, 23 U.S.P.Q.2d 1134, 1135, n.2 (TTAB 1992) (The Court held that "[a] party may not avoid summary judgment by contending that genuine issues of material fact exist as to issues not raised in the pleading." No consideration was thus given to three unpleaded grounds asserted by opposer in response to applicant's motion for summary judgment); and *Blansett Pharmacal Co. v. Carmrick Laboratories Inc.*, 25 U.S.P.Q. 2d 1473, 1477 (TTAB 1992) (no consideration given to unpleaded Morehouse defense).

Any and all assertions relating to concurrent use rights in and to the *Everett and Jones* trademark and/or registration of the *Everett and Jones* trademark that are proffered by Defendant in its Opposition should accordingly be summarily dismissed and, hence, not considered by the Board in deciding Defendant's motion for summary judgment.

II. *Res Judicata*

Plaintiff, citing *Neil Norman, Ltd. v. William Kasper & Co.*, 149 Cal. App. 3d 942 (1983), speciously contends that “[r]es judicata [is] inapplicable ...because the factual circumstances had materially changed since the CA Superior Court Action.” The alleged materially changed factual circumstances relate to Plaintiff's alleged concurrent use rights in and to the *Everett and Jones* trademark that are evidenced by Plaintiff's filing of a *defective*¹ concurrent use trademark application, i.e. No. 86820463, on November 14, 2015 (during pendency of the Cancellation Proceeding) to register the *Everett and Jones* trademark.

Plaintiff further contends that (i) “[t]he CA Superior Court lacked the authority to determine the respective concurrent [use] rights of the parties,” citing *J&D Home Improvement, Inc. v. Basement Doctor, Inc.*, 247 F. Supp. 2d 575, 65 U.S.P.Q. 2d 1958 (D. Del. 2003), and (ii) “[t]he right to use a trademark [which was actually litigated and finally determined by the CA Superior Court] is not the same as the right to register a trademark” and, hence, “[t]he two claims are not identical.”

¹ App. No. 86820463 does not meet the requirements of Section 2.42 of the Code of Federal Registrations. App. No. 86820463 is devoid of a verified statement indicating (1) the geographic area in which Plaintiff is using Defendant's *Everett and Jones* trademark in commerce, OR (2) the geographic areas in which Defendant is using its *Everett and Jones* trademark in commerce, OR (3) the time periods of such use by Defendant, as mandated by 37 C.F.R. § 2.42.

Plaintiff's contentions are flawed and/or meritless for at least the following reasons:

First, as discussed in detail above, entitlement to concurrent use registration of the *Everett and Jones* trademark was not plead by Plaintiff in the Cancellation Proceeding. Thus, TBMP § 528.07(b) prohibits Defendant from asserting the existence of other facts and/or issues relating to alleged concurrent use rights in and to the *Everett and Jones* trademark and/or concurrent use registration of the *Everett and Jones* trademark in support of any contention and, particularly, to support Defendant's contentions that (i) "factual circumstances had materially changed since the CA Superior Court Action" and (ii) the claim in the CA Superior Court Action is not the same claim before the Board in the Cancellation Proceeding.

Second, contrary to Plaintiff's contention, the CA Superior Court *did* have the authority to determine the respective concurrent use rights of Plaintiff and Defendant. Indeed, the U.S. Court of Appeals for the Third Circuit, reviewing the decision of the U.S. District Court in *J&D Home Improvement, Inc. v. Basement Doctor, Inc.*, supra, held that "a court may determine that concurrent [use] registration is appropriate (and thereby direct the PTO to issue concurrent registrations)... in the context of actions which courts already have subject matter jurisdiction." *J&D Home Improvement, Inc. v. Basement Doctor, Inc.*, 70 U.S.P.Q. 2d 1250 (3d. Cir. 2004). Accord *Old Dutch Foods, Inc. v. DanDee Pretzel & Potato Chip Co.*, 477 F. 2d 150, 155-56 (6th Cir. 1973)

Section 1052 of the U.S Code also provides that "concurrent use registration may be issued by the Director when a court of competent jurisdiction has finally determined that more than one person is entitled to use the same or similar marks in commerce." 15 U.S.C §1052(d).

Section 1207 of the Trademark Trial and Appeal Board Manual of Procedure also provides that entitlement to concurrent use registration can be based on "a decree of a court of

competent jurisdiction... reflecting a final determination of the rights of the concurrent user.”

TBMP § 1207.04(c)(1).

Thus, since the CA Superior Court had subject matter jurisdiction over the matters before the Court, the CA Superior Court had the authority to determine the respective concurrent use rights of Plaintiff and Defendant².

Third, Defendant asserts *Neil Norman, Ltd.* for the proposition that the doctrine of *res judicata* “does not apply where there are changed conditions and new facts which *were not in existence at the time of the prior judgment...*” (emphasis added). In the instant matter, even if, *in arguendo*, Plaintiff were allowed to assert the existence of other facts and/or issues relating to alleged concurrent use rights in and to the *Everett and Jones* trademark (as purported evidenced by Plaintiff’s filing of concurrent use trademark application No. 86820463), the alleged new facts relating thereto *were* in existence at the time of the prior judgment. Indeed, Plaintiff’s allegations in the CA Superior Court Complaint, as well as the March 23, 2015 Transcript of Proceedings of the Superior Court Action, attached as Exhibit E to Plaintiff’s Opposition, unequivocally reflect that issues relating to Plaintiff’s first and continued use of the *Everett and Jones* trademark, and alleged ownership thereof, i.e. issues relating to concurrent use rights, were actually presented and litigated by Plaintiff in the CA Superior Court Action.

Further, in *Neil Norman, Ltd.*, the Court specifically found that, although the changed conditions and new facts were in existence at the time of the prior judgment, *res judicata* did not apply against Neil Norman, Ltd., since Neil Norman, Ltd. *was not aware* of the changed conditions and new facts at the time of the prior judgment.

² It cannot be reasonably disputed that the CA Superior Court had subject matter jurisdiction over the matters before the Court

The *Neil Norman, Ltd.* Court's reasoning was based on *Sutphin v. Speik*, 15 Cal. 2d 195 (1940), which found that *res judicata* was applicable where an issue in question *could have been litigated in a prior action*. Indeed, the *Neil Norman, Ltd.* Court acknowledged that "Norman by its negligence could not withhold the issue from the first lawsuit and then litigate it at some later point." *Neil Norman, Ltd.*, 149 Cal. App. at 947.

In the instant matter, it cannot be reasonably disputed that Plaintiff was aware of issues relating to her alleged concurrent use rights in and to the *Everett and Jones* trademark, during, if not before instituting the Superior Court Action. Indeed, as indicated above, issues relating to Plaintiff's first and continued use of the *Everett and Jones* trademark, and alleged ownership thereof, i.e. issues relating to concurrent use rights, were actually presented and litigated by Plaintiff in the CA Superior Court Action.

Further, since the CA Superior Court had the authority to determine any alleged concurrent use rights of Plaintiff in and to the *Everett and Jones* trademark, any additional issues relating thereto could have and should have been litigated during the CA Superior Court Action.

Thus, even if, *in arguendo*, Plaintiff were allowed to assert that factual circumstances had changed since the CA Superior Court Action based on Plaintiff's filing of concurrent use trademark application No. 86820463, the alleged changed factual circumstances would not be sufficient to bar the application of *res judicata* in the instant matter.

Fourth, contrary to Plaintiff's contention, the *claims* in the CA Superior Court Action and Cancellation Proceeding are the same. Indeed, as indicated above, Plaintiff does not dispute the fact that Plaintiff alleged that Defendant committed fraud *in obtaining Reg. No. 3747512* for the *Everett and Jones* trademark in the prior CA Superior Court Action, and is similarly alleging that Defendant committed fraud *in obtaining Reg. No. 3747512* in the Cancellation Proceeding.

Thus, the *fraud claims* in the CA Superior Court Action and Cancellation Proceeding are the same.

Defendant thus again respectfully submits that since it is undisputed that (1) there is identity of parties, i.e. the identical parties that were before the CA Superior Court are before the Board in the Cancellation Proceeding, (2) there has been an earlier final judgment on the merits of the same claim, i.e. the CA Superior Court has rendered a valid and final judgment on *the same fraud claim*; and (3) the fraud claim in the Cancellation Proceeding is based on the *same nucleus of operative alleged facts* that were before the CA Superior Court (and fully litigated by Plaintiff), Plaintiff is bound by the CA Superior Court judgment and barred from re-litigating the same "fraud" claim in the Cancellation Proceeding, under the doctrine of *res judicata*.

III. Collateral Estoppel

Plaintiff similarly contends that "collateral estoppel is inapplicable because the factual circumstances had materially changed since the CA Superior Court Action" by virtue of Plaintiff's filing of concurrent use trademark application No. 86820463.

Plaintiff further contends that the issue sought to be precluded is not identical to the issue that was before the CA Superior Court, since "Plaintiff's concurrent use application rights had not yet arisen because she had not filed [the] concurrent use application" and, hence, issues relating thereto, such as "whether Plaintiff's concurrent use rights entitle her to a restricted or unrestricted registration" of the *Everett and Jones* trademark, were not before the CA Superior Court³.

³ Collateral estoppel should not be barred where a party (and specifically Plaintiff herein) merely withholds or reformulates issues raised in a prior proceeding to establish a material change in circumstances that were not in existence at the time of the prior judgment. Otherwise, there would be no end to litigation between the parties.

Plaintiff's contentions are similarly flawed and/or meritless for at least the following reasons:

First, as indicated above, since entitlement to concurrent use registration of Defendant's *Everett and Jones* trademark was not plead by Plaintiff in the Cancellation Proceeding, TBMP § 528.07(b) prohibits Defendant from asserting the existence of other facts and/or issues relating to alleged concurrent use rights and/or concurrent use registration of the *Everett and Jones* trademark to defend against Defendant's motion for summary judgment.

Second, contrary to Plaintiff's contention, the issue sought to be precluded *is* the same issue that was before and actually litigated and finally determined by the CA Superior Court; namely, whether Defendant knowingly made false and misleading statements to the USPTO Examining Attorney with the intent to deceive the Examining Attorney into believing that Defendant was the owner of the *Everett and Jones* trademark ***to obtain Reg. No. 3747512***.

Plaintiff also does not dispute the facts that the noted issue was actually litigated and finally determined by the CA Superior Court, and is the same seminal issue that is before the Board in the Cancellation Proceeding⁴.

Indeed, as previously submitted, in the CA Superior Court Action, Plaintiff alleged, *inter alia*, "On all four of the U.S. trademark applications [including U.S. App. No. 77/556,026] Defendants [including Everett and Jones Barbeque-Jack London, LLC] knowingly made willful false and misleading statements to the Examining Attorney in the United States Patent and Trademark Office with the intent to deceive the U.S. trademark Examining Attorney into believing that Defendants were the sole and exclusive owners of the trademarks [including the

⁴ Plaintiff merely contends that "concurrent use rights were not actually litigated or finally determined in the CA Superior Court Action."

Everett and Jones trademark] **to fraudulently obtain...U.S. trademark registrations on the Principal Register...**" (CA Superior Court Complaint, ¶¶ 56 and 58 of 4th cause of action).

In the Cancellation Proceeding, Plaintiff similarly alleges that "Defendant made the misrepresentation that it was the owner of Plaintiff's U.S. Registration No. 2612132 which was material to the determination by the USPTO to grant the registration at issue and the misrepresentation was made by the Defendant with the intent **to deceive the USPTO into issuing the registration**" (¶ 5 of Plaintiff's Second Amended Petition for Cancellation)⁵.

Although the allegations in the CA Superior Court Action and Cancellation Proceeding are worded slightly differently, the allegations are so woven together as to constitute the same "distilled" issue; namely, whether Defendant knowingly made false and misleading statements to the USPTO Examining Attorney with the intent to deceive the Examining Attorney into believing that Defendant was the owner of the *Everett and Jones* trademark and obtain registration of the *Everett and Jones* trademark on the Principal Register.

Since it is undisputed that (1) a seminal "determinative" issue that was before the CA Superior Court is the same issue that is before the Board in the Cancellation Proceeding; namely, whether Defendant knowingly made willful false and misleading statements to the USPTO Examining Attorney with the intent to deceive the Examining Attorney into believing that Defendant was the owner of the *Everett and Jones* trademark and fraudulently obtain registration of the *Everett and Jones* trademark, is the same issue that is before the Board in the Cancellation Proceeding, (2) the noted issue was actually litigated, adjudged and finally determined in the CA Superior Court Action, (3) determination of the noted issue was also necessary to the final judgment rendered by the CA Superior Court, and (4) Plaintiff had a fair opportunity to litigate

⁵ Plaintiff's assertion that "Defendant committed fraud on the PTO in maintaining the *Everett and Jones* registration", was thus neither alleged in the CA Superior Court Action, nor the instant Cancellation Proceeding.

the issue in the CA Superior Court Action, Defendant again respectfully submits that Plaintiff is precluded, i.e. barred, from re-litigating the same issue in the Cancellation Proceeding, under the doctrine of collateral estoppel.

VI. Conclusion

Defendant accordingly again respectfully requests that its Motion for Summary Judgment be granted.

Date: October 3, 2016

Respectfully submitted,

By: _____

Ralph C. Francis, Esq.
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Alameda, CA 94501
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E-mail: ref@francislaw.com
*Attorneys for Defendant, Everett and
Jones Barbeque – Jack London, LLC*

ELECTRONIC FILING CERTIFICATE

I hereby certify that Everett and Jones Barbeque – Jack London, LLC's Reply to Plaintiff's Opposition to Motion for Summary Judgment was submitted to the United States Patent & Trademark Office electronically via ESTTA on October 3, 2016.

By: _____
Ralph C. Francis, Esq.

CERTIFICATE OF SERVICE

I hereby certify that a true and correct copy of Everett and Jones Barbeque – Jack London, LLC's Reply to Plaintiff's Opposition to Motion for Summary Judgment was served, via email to Plaintiff at everettandjonesbarbeque@gmail.com and deposited with the U.S. Postal Service on October 3, 2016 as First Class Mail, postage affixed, in an envelope addressed to Plaintiff at the following address:

Shirley A. Dicko
4121 Oak Hill Road
Oakland, CA 94605

By: _____
Ralph C. Francis, Esq.

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
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)	Cancellation No. 92061096
Plaintiff,)	
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Plaintiff expressly objects to Defendant's assertion of the alleged existence of other facts and/or issues relating to rights to concurrent use and/or concurrent use registration of the *Everett and Jones* trademark, and any assertion or contention proffered by Defendant in its Opposition relating to concurrent use rights and/or concurrent use registration of the *Everett and Jones* trademark.

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Plaintiff further contends that (i) “[t]he CA Superior Court lacked the authority to determine the respective concurrent [use] rights of the parties,” citing *J&D Home Improvement, Inc. v. Basement Doctor, Inc.*, 247 F. Supp. 2d 575, 65 U.S.P.Q. 2d 1958 (D. Del. 2003), and (ii) “[t]he right to use a trademark [which was actually litigated and finally determined by the CA Superior Court] is not the same as the right to register a trademark” and, hence, “[t]he two claims are not identical.”

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Plaintiff's contentions are flawed and/or meritless for at least the following reasons:

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Further, in *Neil Norman, Ltd.*, the Court specifically found that, although the changed conditions and new facts were in existence at the time of the prior judgment, *res judicata* did not apply against Neil Norman, Ltd., since Neil Norman, Ltd. *was not aware* of the changed conditions and new facts at the time of the prior judgment.

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Fourth, contrary to Plaintiff's contention, the *claims* in the CA Superior Court Action and Cancellation Proceeding are the same. Indeed, as indicated above, Plaintiff does not dispute the fact that Plaintiff alleged that Defendant committed fraud *in obtaining Reg. No. 3747512* for the *Everett and Jones* trademark in the prior CA Superior Court Action, and is similarly alleging that Defendant committed fraud *in obtaining Reg. No. 3747512* in the Cancellation Proceeding.

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III. Collateral Estoppel

Plaintiff similarly contends that "collateral estoppel is inapplicable because the factual circumstances had materially changed since the CA Superior Court Action" by virtue of Plaintiff's filing of concurrent use trademark application No. 86820463.

Plaintiff further contends that the issue sought to be precluded is not identical to the issue that was before the CA Superior Court, since "Plaintiff's concurrent use application rights had not yet arisen because she had not filed [the] concurrent use application" and, hence, issues relating thereto, such as "whether Plaintiff's concurrent use rights entitle her to a restricted or unrestricted registration" of the *Everett and Jones* trademark, were not before the CA Superior Court³.

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Everett and Jones trademark] **to fraudulently obtain...U.S. trademark registrations on the Principal Register...**" (CA Superior Court Complaint, ¶¶ 56 and 58 of 4th cause of action).

In the Cancellation Proceeding, Plaintiff similarly alleges that "Defendant made the misrepresentation that it was the owner of Plaintiff's U.S. Registration No. 2612132 which was material to the determination by the USPTO to grant the registration at issue and the misrepresentation was made by the Defendant with the intent **to deceive the USPTO into issuing the registration**" (¶ 5 of Plaintiff's Second Amended Petition for Cancellation)⁵.

Although the allegations in the CA Superior Court Action and Cancellation Proceeding are worded slightly differently, the allegations are so woven together as to constitute the same "distilled" issue; namely, whether Defendant knowingly made false and misleading statements to the USPTO Examining Attorney with the intent to deceive the Examining Attorney into believing that Defendant was the owner of the *Everett and Jones* trademark and obtain registration of the *Everett and Jones* trademark on the Principal Register.

Since it is undisputed that (1) a seminal "determinative" issue that was before the CA Superior Court is the same issue that is before the Board in the Cancellation Proceeding; namely, whether Defendant knowingly made willful false and misleading statements to the USPTO Examining Attorney with the intent to deceive the Examining Attorney into believing that Defendant was the owner of the *Everett and Jones* trademark and fraudulently obtain registration of the *Everett and Jones* trademark, is the same issue that is before the Board in the Cancellation Proceeding, (2) the noted issue was actually litigated, adjudged and finally determined in the CA Superior Court Action, (3) determination of the noted issue was also necessary to the final judgment rendered by the CA Superior Court, and (4) Plaintiff had a fair opportunity to litigate

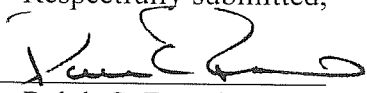
⁵ Plaintiff's assertion that "Defendant committed fraud on the PTO in maintaining the *Everett and Jones* registration", was thus neither alleged in the CA Superior Court Action, nor the instant Cancellation Proceeding.

the issue in the CA Superior Court Action, Defendant again respectfully submits that Plaintiff is precluded, i.e. barred, from re-litigating the same issue in the Cancellation Proceeding, under the doctrine of collateral estoppel.

VI. Conclusion

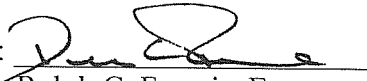
Defendant accordingly again respectfully requests that its Motion for Summary Judgment be granted.

Date: October 3, 2016

Respectfully submitted,
By: 
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Attorneys for Defendant, Everett and Jones Barbeque – Jack London, LLC

ELECTRONIC FILING CERTIFICATE

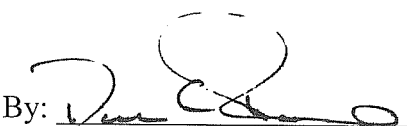
I hereby certify that Everett and Jones Barbeque – Jack London, LLC's Reply to Plaintiff's Opposition to Motion for Summary Judgment was submitted to the United States Patent & Trademark Office electronically via ESTTA on October 3, 2016.

By: 
Ralph C. Francis, Esq.

CERTIFICATE OF SERVICE

I hereby certify that a true and correct copy of Everett and Jones Barbeque – Jack London, LLC's Reply to Plaintiff's Opposition to Motion for Summary Judgment was served, via email to Plaintiff at everettandjonesbarbeque@gmail.com and deposited with the U.S. Postal Service on October 3, 2016 as First Class Mail, postage affixed, in an envelope addressed to Plaintiff at the following address:

Shirley A. Dicko
4121 Oak Hill Road
Oakland, CA 94605

By: 
Ralph C. Francis, Esq.