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

Proceeding	92071966
Party	Plaintiff Doorknob Grocery LLC dba Foragers Market
Correspondence Address	GINA DURHAM DLA PIPER LLP (US) 555 MISSION STREET SUITE 2400 SAN FRANCISCO, CA 94105 UNITED STATES TMDocket@dlapiper.com 415-836-2506
Submission	Opposition/Response to Motion
Filer's Name	Carissa Bouwer
Filer's email	gina.durham@dlapiper.com, carissa.bouwer@dlapiper.com, angie.andrade@dlapiper.com, tmfilings@dlapiper.com, aman- da.modesto@dlapiper.com
Signature	/Carissa Bouwer/
Date	04/28/2020
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
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Doorknob Grocery LLC dba Foragers Market, Petitioner, v. Forager Project, LLC, Respondent.	Opposition No. 92071966
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**DOORKNOB’S BRIEF IN OPPOSITION TO RESPONDENT’S
MOTION FOR JUDGMENT ON THE PLEADINGS**

Petitioner, Doorknob Grocery LLC dba Foragers Market (“Doorknob”), by and through counsel, files this Response in Opposition to Respondent Forager Project, LLC’s (“Respondent”) Motion for Judgment on the Pleadings (“Motion”) which was filed on April 8, 2020. For the reasons set out below, Respondent is not entitled to judgment in its favor.

I. INTRODUCTION

On January 24, 2017, Doorknob filed Opposition No. 91232433 to oppose Respondent’s application to register FORAGER (Serial No. 86779825) (the “’433 Opposition”). Respondent withdrew its application without Doorknob’s consent and the Trademark Trial and Appeal Board (“Board”) entered judgment against Respondent on November 14, 2018.

On January 11, 2018, Doorknob filed Cancellation No. 92067732 seeking to cancel Respondent’s registrations for FORAGER (Reg. No. 86975227) and FORAGER (Reg. No. 86109160) (the “’732 Cancellation”). On July 18, 2018, Respondent voluntarily surrendered both registrations without consent, and the Board entered judgment against Respondent on July 27, 2018.

On August 9, 2019, Doorknob filed the present cancellation seeking to cancel Respondent's Registration No. 4582966 for FORAGER PROJECT. Registration No. 4582966 which is the subject of the instant Petition has never been subject to a prior proceeding filed by Petitioner, and as such, the Board has never considered the merits of whether the FORAGER PROJECT mark is likely to cause confusion with the rights asserted by Doorknob in the instant action.

II. LAW AND ARGUMENT

After the pleadings are closed, but early enough not to delay trial, a party may move for judgment on the pleadings. Fed. R. Civ. P. 12(c). "Because Rule 12(c) provides judicial resolution at an early stage of a case, the party seeking judgment on the pleadings shoulders a heavy burden of justification." *Dist. No. 1, Pac. Coast Dist., Marine Engineers Beneficial Ass'n, AFL-CIO v. Liberty Mar. Corp.*, 933 F.3d 751 (D.C. Cir. 2019). In deciding a 12(c) motion, all factual allegations made by the non-moving party are accepted as true. *Beal v. Missouri Pac. R.R. Corp.*, 312 U.S. 45, 51, 61 S.Ct. 418, 85 L.Ed. 577 (1941). Importantly, the moving party must clearly establish that no genuine material issue of fact remains to be resolved. *Wager v. Pro*, 575 F.2d 882, 884 (D.C. Cir. 1976). Under the doctrine of claim preclusion, "a judgment 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." *Parklane Hosiery Co. v. Shore*, 439 U.S. 322, 326 n.5 (1979). A second suit will be barred by claim preclusion if: (1) the parties or their privies are the same; (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. *Jet Inc. v. Sewage Aeration Sys.*, 223 F.3d 1360, 55 USPQ2d 1854, 1856 (Fed. Cir. 2000).

Respondent fails to put forth a valid basis for claim preclusion. In its answer to the instant Petition to Cancel, Respondent disputes Doorknob's claim that Respondent's Registration for FORAGER PROJECT creates a likelihood of confusion with Doorknob's asserted trademark rights. But, in the past proceedings initiated by Doorknob against Respondent's other filings for FORAGER, namely the '732 Cancellation and the '433 Opposition, Respondent did not

ultimately dispute Doorknob's confusion claims on the merits and allowed judgment to be entered *against* Respondent. As such, the instant Petition is not based on the same set of transactional facts as the earlier claims and, therefore, Petitioner's claim is not barred by claim preclusion. Respondent's motion should not be well-taken as it is nothing more than a request that it be given a pass on the currently contested registration for FORAGER PROJECT because it previously abandoned its filings for FORAGER.

1. The Claims Are Not Based On The Same Set Of Transactional Facts

Respondent alleges that because the marks at issue in the '732 Cancellation contain one overlapping term with the mark in the present cancellation, the present claim arises from the same set of transactional facts. However, this position is without legal support and stretches the idea of what constitutes the same set of transactional facts too far to justify barring Petitioner's claim.

Respondent's Motion focuses extensively on the fact that Petitioner could have asserted the claim in the present cancellation previously. However, just because another claim may have been ripe at the same time a different claim was asserted, does not mean that the claims arise out of the same transactional facts. *Commissioner v. Sunnen*, 333 U.S. 591, 597-598 (1948). In this regard, the *Chutter* case cited by Respondent actually undermines Respondent's position. In *Chutter*, the court clearly delineates between claims that are based on the same set of transactional facts and claims that were ripe and "could have been raised" but not based on the same set of transactional facts. *Chutter, Inc. v. Great Concepts, LLC*, 119 U.S.P.Q. 2d 1865, 2016 WL 6819243 *4 (2016). The "'could have been raised' language ...does not refer to any claim whatsoever that was ripe when an earlier proceeding was filed or became ripe during the pendency of an earlier proceeding. Instead, it refers to the assertion 'of a different cause of action or theory of relief' based on 'the same transactional facts' as earlier asserted." *Id.* Thus, whether the claim asserted in the instant Petition was ripe at the time Petitioner filed the prior '732 Cancellation is of no consequence because the trademarks at issue in prior proceedings (FORAGER) are different from the trademark in the present cancellation proceeding

(FORAGER PROJECT) resulting in a present claim that is not based on the same set of transactional facts.

Where the claims involve two distinct marks, the Board has found that claim preclusion is not appropriate because the claims or causes of action are different. *United States Olympic Committee v. Bata Shoe Co.*, 225 USPQ 340, 342 (TTAB 1984) (abandonment of application without consent in previous opposition does not operate as collateral estoppel or claim preclusion in subsequent cancellation proceeding between same parties since the two cases involve two distinct marks); *In re Communications Technology Corp.*, 182 USPQ 695, 696 (TTAB 1974) (judgment against applicant in prior opposition between applicant and owner of cited registration is not conclusive of likelihood of confusion and does not operate as estoppel in subsequent application for a distinctly different mark).

The claim in the present cancellation involves a different trademark than was at issue in prior proceedings between the parties. As a result, the present claim is not based on the same set of transactional facts, there is no claim preclusion, and Respondent's Motion for Judgment on the Pleadings should be dismissed.

Dated: April 28, 2020

Respectfully submitted,

DLA PIPER LLP (US)

By: 

Gina Durham

Gina Durham, Esq.
Carissa Bouwer, Esq.
DLA Piper LLP (US)
555 Mission Street, Suite 2400
San Francisco, CA 94105
Telephone: (415) 836-2506

Attorneys for Petitioner



Doorknob Grocery LLC dba Foragers
Market

CERTIFICATE OF ELECTRONIC SERVICE

The undersigned hereby certifies that one copy of the foregoing BRIEF IN
OPPOSITION TO RESPONDENT’S MOTION FOR JUDGMENT ON THE PLEADINGS, was
served on the Respondent via electronic mail addressed to Respondent at:

Andrea LaFrance
alafrance@bhfs.com, jobermeyer@bhfs.com,
dntrademarkdocket@bhfs.com, mfrancis@bhfs.com,
alafrance@bhfs.com, arodrigues@bhfs.com

this 28th day of April 2020.

By: / *Amanda Modesto* / _____
Amanda Modesto