

**United States Department of Commerce
Patent and Trademark Office
Trademark Trial and Appeal Board**
2900 Crystal Drive
Arlington, VA 22202-3513

CEW

THIS DISPOSITION IS NOT
CITABLE AS PRECEDENT OF THE
TTAB 4/21/00

Cancellation No. 27,343

Wild Pigs Motorcycle
Club

v.

R & R Enterprises

Before Cissel, Hairston and Walters, Administrative
Trademark Judges.

Opinion by Walters, Administrative Trademark Judge:

Wild Pigs Motorcycle Club filed its petition to cancel the registration of the mark shown below for newsletters and for various items of clothing.¹ The petition was filed against "R & R Enterprises and Wild Pigs, Inc." and the cancellation proceeding was so instituted. However, we note that the records of the United States Patent and Trademark Office (PTO) indicate title of the registration in R & R Enterprises.

¹ Registration No. 2,096,230 issued to R & R Enterprises on September 16, 1997, in International Classes 16 and 25. The registration includes a disclaimer of the flag of the United States apart from the mark as shown.

Cancellation No. 27,343



This case comes up now on petitioner's motion for summary judgment and petitioner's motion for default judgment against respondent Wild Pigs, Inc.

We consider, first, petitioner's motion for default judgment. Petitioner alleges that, while respondent R & R Enterprises has filed its answer to the petition to cancel, respondent Wild Pigs, Inc. has failed to file its answer. Respondent R & R Enterprises, in its response to the motions before us, alleges that it is the owner of the registration at issue herein; that neither the mark nor the registration has been assigned to Wild Pigs, Inc.; and that Wild Pigs, Inc. is a motorcycle club that respondent has authorized to use the mark. While these allegations are not supported by a declaration or affidavit, they are

consistent with the records of the PTO, which, as indicated above, show ownership of this registration in the name of R & R Enterprises, a partnership composed of Raymond E. Bynum III and Raul G. Camarena.

Since a cancellation proceeding before the Board addresses the narrow issue of the validity of the registration, such a proceeding may be instituted only against the owner of that registration. The proper procedure is for the Board to institute a cancellation or opposition proceeding against the owner of record in the PTO. The Board will join or substitute parties upon submission of proper evidence of change of ownership of the registration.

In this case, the Board erred in instituting the cancellation proceeding against Wild Pigs, Inc. as there is no evidence in the PTO records or in this record indicating that Wild Pigs, Inc. is an owner of this registration. Thus, the institution of this cancellation proceeding is vacated as to Wild Pigs, Inc., as it is not a proper party, and Wild Pigs, Inc. is stricken as a respondent. The caption of this case is amended as indicated above. Both petitioner's motion for default judgment and its motion for summary judgment against Wild Pigs, Inc. are denied as moot.

We turn now to petitioner's motion for summary judgment against R & R Enterprises. As grounds, petitioner asserts collateral estoppel (issue preclusion) based on a civil action in the Superior Court of California, Santa Clara County, No. CV749333, Wild Pigs Motorcycle Club v. Wild Pigs, Inc. Petitioner further asserts that respondent cannot establish use of the mark in commerce and that respondent filed a fraudulent trademark application. In support of its motion, petitioner has submitted a copy of the trademark application in this case; interrogatory answers from the civil proceeding; excerpts from a transcript of the civil proceeding; a document entitled "Wild Pigs Motorcycle Club National By-Laws"; and a copy of a court paper entitled "Statement of Decision" in the aforementioned civil proceeding, and signed on March 30, 1998, by The Honorable Leonard B. Sprinkles.

In response to petitioner's motion, respondent contends that summary judgment is not warranted on the basis of either res judicata (i.e., claim preclusion) or collateral estoppel (i.e., issue preclusion).

It is well established that a party is entitled to summary judgment when it has demonstrated that there are no genuine issues as to any material fact, and that it is entitled to judgment as a matter of law. Fed. R. Civ. P.

56(c); *See Celotex Corp. v. Catrett*, 477 U.S. 317, 106 S. Ct. 2548 (1986). To establish that a factual dispute is genuine, the nonmoving party need only present evidence from which the fact finder might return a verdict in its favor. *See Opryland USA Inc. v. Great American Music Show Inc.*, 970 F.2d 847, 23 USPQ2d 1471 (Fed. Cir. 1992); *Old 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 nonmovant, and all justifiable inferences are to be drawn in the nonmovant's favor. *Lloyd's Food Products Inc. v. Eli's Inc.*, 987 F.2d 766, 25 USPQ2d 2027 (Fed. Cir. 1993); *Opryland USA, supra*.

The first question before us on petitioner's motion for summary judgment is whether collateral estoppel applies in this case in view of the "Statement of Decision" of the Superior Court of California, Santa Clara County, No. CV749333.

The doctrine of collateral estoppel (i.e., issue preclusion), serves to preclude the relitigation by the parties or their privies of issues actually and necessarily determined by a court of competent jurisdiction, whether or not the prior proceeding involved the same claim as the subsequent proceeding. The requirements that must be met are:

- (1) the issue to be determined must be identical to the issue involved in the prior action;
- (2) the issue must have been raised, litigated and actually adjudged in the prior action;
- (3) the determination of the issue must have been necessary and essential to the resulting judgment; and
- (4) the party precluded must have been fully represented in the prior action.

Larami Corp. v. Talk To Me Programs, Inc., 36 USPQ2d 1840, 1843-1844 (TTAB 1995), citing *Lukens Inc. v. Vesper Corporation*, 1 USPQ2d 1299 (TTAB 1986), *aff'd* Appeal No. 87-1187 (Fed. Cir., September 18, 1987). See also, *Lawlor v. National Screen Service Corp.*, *supra*; *Chromalloy American Corp. v. Kenneth Gordon, Ltd.*, *supra*; *Mother's Restaurant Inc. v. Mama's Pizza Inc.*, 723 F.2d 1566, 221 USPQ 394 (Fed. Cir. 1983); and *International Order of Job's Daughters v. Lindeburg & Co.*, 72 F.2d 1087, 220 USPQ 1017 (Fed. Cir. 1984).

None of these requirements are met in this case and, thus, petitioner is not entitled to summary judgment on the basis of collateral estoppel, or issue preclusion.

The decision in the civil action expressly does not address any trademark issues and, further, respondent was neither named nor represented in the California civil action, nor is there any evidence that respondent herein is in privity with defendant in the civil action.

To the extent that petitioner also seeks summary judgment on the grounds of fraud and abandonment, petitioner's motion is not well taken as petitioner has provided insufficient evidence in support of these grounds. Thus, there remain genuine issues of material fact with respect to fraud or abandonment.

On the other hand, respondent has referred to the decision of the Board in Opposition No. 96,968 and asked that both petitioner's motions and this cancellation proceeding "be given the same fate as the opposition." Opposition No. 96,968 was filed by petitioner herein against respondent herein and involved the application from which the instant registration issued. The opposition was dismissed with prejudice for opposer's failure to take testimony. The petition to cancel is almost identical, word-for-word, to the notice of opposition in that prior proceeding. Petitioner has simply added a sentence to paragraph 5 alleging the assignment of the registration to Wild Pigs, Inc., which issue we address above; and petitioner has added an allegation that the registration was obtained fraudulently, contending that registrant knowingly made false statements in its application regarding its dates of use.

Thus, we address, *sua sponte*, the issue of res judicata, or claim preclusion, and determine whether the prior opposition proceeding precludes this proceeding, either entirely or in part. Under the doctrine of res judicata (i.e., claim preclusion), the entry of a final judgment "on the merits" of a claim (i.e., cause of action) in a proceeding serves to preclude the relitigation of the same claim in subsequent proceedings between the parties or their privies, even in those cases where prior judgment was the result of a default or consent. See, *Lawlor v. National Screen Service Corp.*, 349 U.S. 322, 75 S.Ct. 865, 99 L.Ed. 1122 (1955); *Chromalloy American Corp. v. Kenneth Gordon, Ltd.*, 736 F.2d 694, 222 USPQ 187 (Fed. Cir. 1984); and *Flowers Industries, Inc. v. Interstate Brands Corp.*, 5 USPQ2d 1580 (TTAB 1987). These are exactly the facts before us. With the possible exception of the fraud allegation, the parties and the claims are identical in both the prior opposition and in this cancellation proceeding. The issues of priority of use and likelihood of confusion and of abandonment were, respectively, alleged and denied in the opposition proceeding. Accordingly, the subsequent dismissal of the opposition estops applicant from pleading those same issues as a ground for cancellation of opposer's registration. Further,

petitioner's allegation of fraud, based upon petitioner's assertion regarding the dates of use stated in the application underlying the registration in this case, is based on events occurring before the prior opposition proceeding and is likewise barred under the doctrine of res judicata in view of the judgment dismissing Opposition No. 96,968 with prejudice. *Bacardi & Company, Limited v. Ron Castillo, S.A.*, 178 USPQ 242, 244-255 (TTAB 1973). See also *La Fara Importing Co. v. F. Lli de Cecco di Filippo Fara S. Martino S.p.a.*, 8 USPQ2d 1143, 1146 (TTAB 1988).

Therefore, the petition to cancel herein fails to allege any valid grounds for cancellation of the registration and we grant summary judgment, *sua sponte*, in favor of respondent.

Decision: Petitioner's motion for default judgment and for summary judgment against Wild Pigs, Inc. is denied as moot; and petitioner's motion for summary judgment against respondent R & R Enterprises is denied. However, we grant summary judgment, *sua sponte*, in favor of respondent on the basis of *res judicata*. Thus, the petition to cancel is dismissed with prejudice.

R. F. Cissel

P. T. Hairston

C. E. Walters
Administrative Trademark Judges
Trademark Trial and Appeal Board