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UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451
General Contact Number: 571-272-8500

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Mailed: March 28, 2018

Cancellation No. 92066765

Ing. Khachatur Mkrtchyan

v.

Biostar Technology International LLC

Before Kuhlke, Lykos, and Larkin, Administrative Trademark Judges.

By the Board:

This case comes up on Respondent's motion for summary judgment on claim preclusion, alleging that Petitioner, acting pro se, filed a second, identical petition to cancel Registration No. 5011919 the day after his first petition to cancel Registration No. 5011919 was dismissed with prejudice in another cancellation proceeding. The motion is contested.

RELEVANT FACTS

On August 2, 2016, Registration No. 5011919 issued to Biostar Technology International LLC, a limited liability company of California, for the mark



(USA disclaimed) for “computer software and hardware for use in measuring the frequency of energy emitted by the human body” alleging January 6, 2005 as its date of first use anywhere and in commerce.

(i) Cancellation No. 92066217

On May 31, 2017, Petitioner, an individual and citizen of the Czech Republic acting pro se, filed a petition to cancel Registration No. 5011919. The ESTTA petition to cancel summary form pleaded ownership of a pending Trademark Act Section 66 application for the mark shown below



for “measuring devices for range measuring feeble current electromagnetic fields” and “radiological apparatus for medical purposes, radiotherapy apparatus” (application Serial No. 79196312 with a constructive use filing date of July 4, 2016, the international registration date¹), and listed the grounds for

¹ Contrary to his allegation, Petitioner’s constructive use priority date is not the May 25, 2015 filing date of its Czech Republic trademark application. Pursuant to Trademark Act Section 67:

The holder of an international registration with a request for an extension of protection to the United States shall be entitled to claim a date of priority based on a right of priority within the meaning of Article 4 of the Paris Convention for the Protection of Industrial Property if— (1) the request for extension of protection contains a claim of priority; and (2) the date of international registration or the date of the recordal of the request for extension of protection to the United States is not later than 6 months after the date of the first regular national filing (within the meaning of Article 4(A)(3) of the Paris Convention for the Protection of Industrial Property) or a subsequent application (within the meaning of Article 4(C)(4) of the Paris Convention for the Protection of Industrial Property).

Petitioner’s July 4, 2016 international registration date is later than 6 months after the May 25, 2015 filing date of its Czech Republic trademark application. Accordingly, Petitioner’s constructive use priority date is the date of its international registration. Trademark Act Section 66(b); Trademark Rule 7.26.

cancellation as priority and likelihood of confusion, ownership, misrepresentation of source, and fraud on the USPTO. The ESTTA summary form was accompanied by 46 numbered allegations and 19 exhibits.² Petitioner essentially argues that he has used the mark since 2006, has registered it internationally, and had a prior relationship with Respondent, who was his U.S. distributor and registered a slight variation on Petitioner's mark after the relationship terminated. The petition to cancel was instituted as Cancellation No. 92066217.

On July 13, 2017, in lieu of an answer, Respondent filed a motion to dismiss the petition to cancel for failure to state a claim for relief and because the petition to cancel was impermissibly filed by a foreign attorney. No opposition thereto having been filed, on August 22, 2017, the Board granted the motion to dismiss, and dismissed the petition to cancel with prejudice.

(ii) Cancellation No. 92066765

On August 22, 2017, the day after Cancellation No. 92066217 was dismissed with prejudice, instead of filing a motion to set aside the judgment in that proceeding³, Respondent filed the identical petition to cancel

² Petitioner, who refers to the exhibits as evidence in the petition to cancel, is advised that, while exhibits to the pleadings are allowed for informational purposes, the exhibits attached to a pleading are not evidence on behalf of the party to whose pleading the exhibits are attached. The exhibits attached to the pleading will be given no consideration by the Board. If a party wishes to rely on the exhibits as trial evidence, the exhibits must be identified and introduced in evidence during the period for the taking of testimony. *See* Trademark Rule 2.122(c).

³ Pursuant to Fed. R. Civ. P. 60(b), a party may move the Board for relief from final judgment based on mistake, inadvertence, surprise or excusable neglect. The motion must be filed within a year of the entry of the judgment. Fed. R. Civ. P. 60(c).

Registration No. 5011919, which was instituted as Cancellation No. 92066765. On October 6, 2017, in lieu of an answer, Respondent filed the instant motion for summary judgment contending that Petitioner is precluded from pleading claims which were or could have been addressed in the prior proceeding. Pursuant to Trademark Rule 2.127(e)(1), a motion asserting claim or issue preclusion is an exception to the rule that a party may not file a motion for summary judgment until the party has served its initial disclosures.

APPLICABLE LEGAL PRINCIPLES

Summary judgment is an appropriate method of disposing of cases in which there is no genuine dispute with respect to any material fact, thus leaving the case to be resolved as a matter of law. *See* Fed. R. Civ. P. 56(a); *Celotex Corp. v. Catrett*, 477 U.S. 317, 323 (1986). The evidence of record and all justifiable inferences that may be drawn from the undisputed facts must be viewed in the light most favorable to the non-moving party. *See Lloyd's Food Products Inc. v. Eli's Inc.*, 987 F.2d 766, 25 USPQ2d 2027 (Fed. Cir. 1993).

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.” *Jet Inc. v. Sewage Aeration Sys.*, 223 F.3d 1360, 55 USPQ2d 1854, 1856 (Fed. Cir. 2000) (*quoting Parklane Hosiery Co. v. Shore*, 439 U.S. 322, 326 n.5 (1979)). For claim preclusion to apply, there must be (i) identity of parties (or their privies); (ii) an earlier final judgment on the merits of a claim; and (iii) a second claim based on the same set of transactional facts

as the first. There is no dispute here that both the parties and the transactional facts in the two cancellations are identical.

Petitioner, acting pro se, does not agree that the prior cancellation ended with a final judgment on the merits of a claim, but contends that it was dismissed “on procedural grounds.” Petitioner argues that he is entitled to a hearing on his substantive claims and, by virtue of his exhibits to the pleadings, already has proven these claims.⁴ Both arguments reflect a fundamental misunderstanding on Petitioner’s part both as to the nature of Board proceedings, and the grounds for Respondent’s motion.

A cancellation action before the Board is not an informal proceeding. Instead, it is similar to a civil action in a Federal district court.⁵ As noted above,

⁴ While Petitioner states that he has made efforts to educate himself about Board litigation, those efforts have not been successful. The Board’s rules and case law make clear that petitions to cancel follow the rules of the federal courts in requiring the proper pleading of legally sufficient claims; that evidence on the merits of the claim will only be considered in a timely motion for summary judgment or after the conclusion of trial and briefing as set forth in the Board’s scheduling order; that the failure to respond to a motion may result in that motion being granted as conceded; and that the proper remedy for a party against which judgment has been entered based on mistake is not to file another proceeding on the identical grounds, but to file a motion to set aside the judgment. Strict compliance with the Trademark Rules of Practice and, where applicable, the Federal Rules of Civil Procedure, is expected of all parties before the Board, whether or not they are represented by counsel. *McDermott v. San Francisco Women’s Motorcycle Contingent*, 81 USPQ2d 1212, 1212 (TTAB 2006), *aff’d unpub’d*, 240 Fed. Appx. 865 (Fed. Cir. July 11, 2007), *cert. denied*, 552 U.S. 1109 (2008).

⁵ In a Board inter partes proceeding such as a cancellation, there are pleadings, a wide range of possible motions; discovery (a party’s use of discovery depositions, interrogatories, requests for production of documents and things, and requests for admission to ascertain the facts underlying its adversary’s case), a trial, and briefs, followed by a decision on the case. The Board does not preside at the taking of testimony. Rather, all testimony is taken out of the presence of the Board during the assigned testimony, or trial, periods, and the written transcripts thereof, together with any exhibits thereto, are then filed with the Board.

the exhibits submitted with the petition will not be considered by the Board in its final decision. No paper, document, or exhibit will be considered as evidence in the case unless it has been introduced in evidence in accordance with the applicable rules. It is strongly recommended that all parties to Board proceedings obtain a U.S. attorney familiar with trademark matters to represent the party's interest.

Respondent's motion is grounded in the judicial doctrine, followed by the courts and the Board, that a party is not allowed to bring multiple proceedings when all claims could have been addressed in one proceeding. Fed. R. Civ. P. 41 (b) states "If the plaintiff fails to prosecute or to comply with these rules or a court order, a defendant may move to dismiss the action or any claim against it. Unless the dismissal order states otherwise, a dismissal under this subdivision (b) and any dismissal not under this rule—except one for lack of jurisdiction, improper venue, or failure to join a party under Rule 19—operates as an adjudication on the merits." More specifically, the doctrine of claim preclusion does not require that a claim was actually litigated in a prior proceeding so long as the court (or the Board) determines that a claim could have been litigated in the prior proceeding. *See Lawlor v. National Screen Service Corp.*, 349 U.S. 322, 327 (1955) ("It is of course true that the 1943 judgment [which issued without findings pursuant to a settlement agreement]

dismissing the previous suit ‘with prejudice’ bars a later suit on the same cause of action.”).

In a recent case, in response to the same argument made here that the first proceeding, dismissed after the plaintiff failed to submit evidence during its testimony period, was decided on a “technical procedure,” the Board explained that “whether the judgment in the prior proceeding was the result of a dismissal with prejudice or even default, for claim preclusion purposes, it is a final judgment on the merits.” *Urock Network, LLC v. Sulpasso*, 115 USPQ2d 1409, 1411 (TTAB 2015). *See also Orouba Agrifoods Processing Co. v. United Food Imp.*, 97 USPQ2d 1310, 1313 (TTAB 2010) (motion for summary judgment on claim preclusion granted because “While petitioner claims that the Board did not reach ‘the substantive merits’ of the prior opposition proceeding, the Board’s February 12, 2008 order dismissed petitioner’s notice of opposition with prejudice, and entered judgment against petitioner.”). Here, the Board dismissed the prior cancellation with prejudice, and entered judgment against Petitioner, a final judgment on the merits of the cancellation.

Accordingly, we find that there is no genuine dispute of material fact, and that Petitioner’s claims in this proceeding are barred by claim preclusion. Accordingly, Respondent’s motion for summary judgment is hereby GRANTED, and the petition for cancellation is hereby dismissed, with prejudice.⁶

⁶ Inasmuch as Respondent’s motion for summary judgment is granted, the Board will not address Respondent’s alternative motions to dismiss and for sanctions.