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

Proceeding	91256384
Party	Plaintiff United Cerebral Palsy, Inc.
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Submission	Motion for Summary Judgment **Yes**, the Filer previously made its initial disclosures pursuant to Trademark Rule 2.120(a); OR the motion for summary judgment is based on claim or issue preclusion, or lack of jurisdiction. The deadline for pretrial disclosures for the first testimony period as originally set or reset: **04/07/2021**
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Signature	/Brian J. Winterfeldt/
Date	09/15/2020
Attachments	Memo of Law in Support of Motion for Partial Summary Judgment.pdf(433944 bytes) Statement of Undisputed Facts in Support of Motion for Partial Summar y Judgement.pdf(140967 bytes) Rome Decl in Support of Motion for Partial Summary Judgment.pdf(103292 bytes) Exhibits A-F.PDF(3465821 bytes) Certificate of Service in Support of Motion for Partial Summary Judgm ent.pdf(80773 bytes)

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

In the Matter of Application Serial No. 79/214,470
Published in the Official Gazette on February 11, 2020

United Cerebral Palsy, Inc., Opposer, v. Bernardo Moya, Applicant	Opposition No.: 91/256,384

SUPPLEMENTAL MEMORANDUM OF LAW IN SUPPORT OF OPPOSER'S MOTION FOR PARTIAL SUMMARY JUDGMENT

Opposer United Cerebral Palsy, Inc., respectfully submits this supplemental memorandum of law in support of its motion for partial summary judgment as to Count III of its Notice of Opposition pursuant to Rule 56(e) of the Federal Rules of Civil Procedure and Rule 2.116 of the Trademark Rules of Practice. Fed. R. Civ. P. 56; 38 CFR § 2.116. This memorandum, along with the supplemental evidence, declaration and briefing submitted herewith, are filed pursuant to the Board's Orders dated August 20 and 21, 2020, converting Opposer's Motion for Judgment on the Pleadings under Rule 12(c) of the Federal Rules of Civil Procedure. 6 TTABVUE 2; 9 TTABVUE 2. Opposer requests that the Board sustain the Opposition and refuse registration of the mark B THE BEST YOU LIFE WITHOUT LIMITS (Stylized) ("Applicant's Opposed Mark"), which is the subject of Application Serial No. 79/214,470 (the "Application"), in Classes 9, 16 and 41.

PRELIMINARY STATEMENT

As explained in Opposer's Motion for Judgment on the Pleadings, Opposer respectfully requests that the Board determine whether two versions of Applicant's mark make the same,

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continuing commercial impression, in which case the Board may simply sustain the Opposition as to nearly all of the Classes in the Application. The Applicant previously sought registration covering slightly broader rights in its mark with respect to a narrower set of goods and services (the "Abandoned Application"). Opposer timely and successfully opposed the Abandoned Application in opposition number 91/220,915 (the "Prior Opposition"). The Applicant here seeks registration covering slightly narrower rights in the same mark with respect to a broader and overlapping set of goods and services. Consequently, Opposer has been forced to bring the same claims based on the same underlying facts as in the Prior Opposition. The Applicant has admitted all of this, except that the marks are the same. The Board is well equipped, however, to make that determination for itself. Neither the Board nor Opposer should be forced to expend resources on a dispute that has already been litigated. Applicant is not entitled to a second bite at the apple. Granting this motion will resolve the majority of the issues in this Opposition. Opposer respectfully submits that basic principles of law and equity weigh strongly in its favor and requests that the Board hold that its prior judgment regarding likely confusion and dilution as to Classes 9, 16 and 41 bars re-litigation of the same claims here.

ARGUMENTS

I. OPPOSER IS ENTITLED TO SUMMARY JUDGMENT AS TO *RES JUDICATA* BY CLAIM PRECLUSION

It is appropriate for the Board to grant Opposer's motion for summary judgment as to Classes 9, 16 and 41 based on Count III of the Notice of Opposition for *res judicata* by claim preclusion. Rule 56(a) of the Federal Rules of Civil Procedure provides that summary judgment shall be granted if the movant shows that there is no genuine dispute as to any material fact and the movant is entitled to judgment as a matter of law. *See Virgin Islands Port Auth. v. United States*, 922 F.3d 1328, 1333 (Fed. Cir. 2019). A factual assertion is "material" when it is capable

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of affecting the substantive outcome of the litigation. *Sci. Drilling Int'l, Inc. v. Gyrodata, Inc.,* Opp. Nos. 91/159,448, 91/159,448, 8 TTABVUE 5 (TTAB. 2004). A dispute is "genuine" only if the supported by sufficiently admissible evidence such that a reasonable trier-of-fact could find for the nonmoving party. *See Morgan v. Federal Home Loan Mortg. Corp.*, C.A.D.C.2003, 328 F.3d 647 (Fed. Cir. 2003), ("A dispute is "genuine," for purposes of summary judgment, only if the evidence is such that a reasonable jury could return a verdict for the nonmoving party.")

Applicant's Answer left no genuine dispute of material fact to be resolved regarding the claim preclusion pled by Opposer and Applicant's registration constitutes a collateral attack on the Board's final judgment in the Prior Opposition. Opposer respectfully submits that it is entitled to a judgment as a matter of law as to claim preclusion and requests that registration of the Application be refused as to Classes 9, 16 and 41.

II. REGISTRATION OF THE APPLICATION IS PRECLUDED BY A PRIOR JUDGMENT ON THE MERITS IN AN OPPOSITION TO THE SAME MARK UNDER THE SAME CLAIMS BETWEEN THE SAME PARTIES, WHICH APPLICANT SEEKS TO ATTACK HERE

Res Judicata by claim preclusion, as pled in Count III of the Notice of Opposition, bars relitigation of Counts I and II as they apply to Classes 9, 16 and 41, which were previously litigated to the Board by the same parties to a final judgment. Section 19 of The Lanham Act specifically states that "[i]n all *inter partes* proceedings equitable principles . . . may be considered and applied." 15 USC § 1069. *Res judicata* is a judicially created doctrine that the Board has adopted as governing its proceedings. *See Foodland, Inc. v. Foodtown Super Markets, Inc.,* 138 USPQ 591, 593 (TTAB 1963) (citing *Vitaline Corp. v. Gen. Mills, Inc., 8*91 F.2d 273, 274–75 (Fed. Cir. 1989)). It can flow from an *inter partes* decision by the Board if there is: (1) an identity of parties; (2) 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. *Standard Int'l Mgmt., LLC*, v. *One Step Up, LTD*, Opp. No. 91/243,645, 14 TTABVUE 5 (TTAB 2019) (citing *Jet, Inc. v. Sewage Aeration Sys.*, 223 F.3d

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1360, 1362 (Fed. Cir. 2000)). Claim preclusion operates against a defendant if its claim or defense is a collateral attack on a prior judgment *Nasalok Coating Corp. v. Nylok Corp.*, 522 F.3d 1320,1324 (citing *Baker v. Gold Seal Liquors, Inc.,* 417 U.S. 467, 469 (1974)).

A. The Parties in this Opposition and the Prior Opposition are Identical

The parties in this Opposition and the Prior Opposition are identical. *See* Supplemental Statement of Undisputed Facts In Support of Opposer's Motion for Partial Summary Judgment, submitted herewith, ("SUF") ¶ 1; *compare* Supplemental Declaration of David Rome in Support of Opposer's Motion for Partial Summary Judgment dated September 15, 2020, submitted herewith, ("Rome Declaration"), Ex. A *with* 1 TTABVUE 1. Therefore, there is no genuine dispute of material fact as to the first element of claim preclusion.

B. Final Judgment on the Merits was Rendered in the Prior Opposition

The Board rendered a final judgment on the merits sustaining the Prior Opposition and refusing registration of the Abandoned Application. *See* SUF ¶ 6, Rome Decl., Ex. E. "[W]hether 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." *The Urock Network, LLC v. Sulpasso*, 9 TTABVUE 6, 115 USPQ2d 1409 (TTAB 2015) (holding that dismissal for failure to prosecute is a final judgment on the merits for the purposes of claim preclusion); *see also* *Morris v. Jones*, 329 US 545, 550-51 (1947) (holding that "[a] judgment of a court having jurisdiction of the parties and of the subject matter operates as *res judicata*, in the absence of fraud or collusion); *Maksimuk v. Connor Sport Court Int'l, LLC*, 771 Fed. Appx. 1001, 1004 (Fed. Cir. 2019), *cert. denied*, 140 S. Ct. 906, 205 L. Ed. 2d 460 (2020), *reg. denied*, 140 S. Ct. 2557, 206 L. Ed. 2d 490 (2020) (holding that "[c]laim preclusion can apply against the defendant even if the first judgment was a default judgment"); *La Fara Importing Co. v. F. Lli de Cecco di Filippo Fara S. Martino S.p.a.*, 8 USPQ 2d 1143, 1146 (TTAB 1988) (holding that "[i]ssue preclusion operates only as to

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