

TTAB

Docket No. 455-002

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

KURT M. MARKVA,)	
)	Cancellation No. 92/043,899
Petitioner,)	
)	
V.)	
)	
ENTREPRENEUR MEDIA, INC.,)	
)	
Registrant.)	

**PETITIONER’S OPPOSITION TO
ENTREPRENEUR MEDIA’S MOTION TO DISMISS**

Pursuant 37 CFR 2.127(e), Petitioner, Kurt M. Markva (“Markva”), hereby responds to oppose Registrant’s motion to dismiss under Fed. R. Civ. P. 12(b), and based on the following. Markva requests the Board to deny Registrant’s motion to dismiss and to allow the proceedings to continue to completion.

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Introduction

In its motion to dismiss, Registrant alleges that the Petitioner is Scott Smith’s “business associate” with whom Petitioner “teamed up ... to file a petition to cancel EMI’s” Registration No. 2,263,883 for ENTREPRENEUR in Class 35, and the “pair has now taken the next step, by filing this petition to cancel Registrant’s Registration No. 1,453,968 for ENTREPRENEUR in Class 16. Registrant alleges that Petitioner is an intermeddler and recounts Smith’s litigation with Registrant in the U.S. District Court for the Central District of California. Registrant urges the Board to find this Court decision as res judicata against Petitioner in this proceeding. For this to occur, Registrant must prove that Smith is in privity with Petitioner with respect to his ENTREPRENEURPR mark that was



involved in the court decision. Registrant must prove that Petitioner was involved in Smith's mark, or that Smith was involved with selection of Petitioner's proposed ENTREPRENEURGR-IP mark that is involved in the current proceeding. Registrant has failed to prove these things.

As shown below, Petitioner became a self-employed entrepreneur in February 2004 after being employed on Capitol Hill in Washington, D.C. for 11 and half years, and working for more than a year with a well-known public relations firm. This experience has prepared him to be the sole principal of a Virginia LLC that handles government resources and intellectual property matters for his entrepreneurial clients. Petitioner is in a position to have a right to use the generic word "entrepreneur" with respect to his business, and to file an intent-to-use application for registration of his proposed trademark. Petitioner has no rights in Smith's ENTREPRENEURPR mark and Smith has no rights in Petitioner's ENTREPRENEURGR-IP mark. For no transfer of rights in, nor a license to use, their respective marks have occurred orally or in writing. Therefore, Petitioner is not in privity with Smith with respect to either of their respective marks. So res judicata regarding the Ninth Circuit Court decision does not apply to this proceeding.

Petitioner's Denials

Petitioner denies that his business association with Smith in the dormant Intellectual Property Protection Coalition (IPPC) or that any of Registrant's Exhibits F-I introduced in Cancellation 92/043,579 give any ownership interest or establish a privity relationship with Petitioner regarding the selection of Petitioner's mark, or that Petitioner is an intermeddler in this proceeding.

Petitioner denies that Smith had any participation in the selection of Petitioner's mark, or that Smith was involved in any way with Petitioner's first or second petitions to cancel Registrant's

registrations so as to have filed the petitions in association with Smith.

Petitioner denies that the Ninth Circuit Court's decision applies to Petitioner because he is not, and was not at any time, in privity with Smith with respect to his ENTREPRENEURGR-IP mark or to Smith's ENTREPRENEURPR mark. So the Court "holding" regarding genericness therefore applies only to Smith and his mark in which Petitioner has no common interest.

Petitioner Is Not In Privity With Scott Smith

Section 206.02 of the Trademark Trial and Appeal Board Manual of Procedure (TBMP) states:

In the field of trademarks, the concept of privity generally includes, *inter alia*, the relationship of successive ownership of a mark (e.g., assignor, assignee) and the relationship of "related companies" within the meaning of Sections 5 and 45 of the Act, 15 U.S.C. §§ 1055 and 1127.

Section 512.01 of the TBMP states:

When there has been an assignment of a mark that is the subject of, or relied upon, in an inter partes proceeding before the Board the assignee may be joined or substituted, as may be appropriate, upon motion granted by the Board, or upon the Board's own initiative.

Section 5 of the Trademark Act, 15 U.S.C. §1055, states, in part, as follows:

Where a registered mark or a mark sought to be registered is or may be used legitimately by related companies, such use shall inure to the benefit of the registrant or applicant for registration, and such use shall not affect the validity of such mark or of its registration,

provided such mark is not used in such manner as to deceive the public.

Section 45 of the Act, 15 U.S.C. §1127, defines "related company" as follows:

The term "related company" means any person whose use of a mark is controlled by the owner of the mark with respect to the nature and quality of the goods or services on or in connection with which the mark is used.

Petitioner and Smith Are Not Related Companies

Either a natural person or a juristic person may be a related company. 15 U.S.C. §1127. So when a mark's owner who is a natural person is being used by a related company who is also a natural person, the related natural person's use inures to the owner's benefit. The owner of the mark controls the nature and quality of its mark that is being used by the related company. Smith is the sole owner of his ENTREPRENEURPR mark that Petitioner has never used as a "related company," and Petitioner is the sole owner of his ENTREPRENEURGR-IP mark that Smith has never used as a "related company." Petitioner is not in privity with Smith. Registrant does not prove otherwise.

Although two unrelated entities having similar marks were made defendants in civil actions brought by the owner of the mark in question, and they shared the same objection to registration to the mark, the two unrelated entities were not in privity. *In re Cooper*, 209 USPQ 670, 671 (Comm'r 1980). Petitioner and Smith may be business associates in a dormant business, but any comments in articles or e-mails from the Internet are irrelevant to the issue of privity in these proceedings. For their business association does not make them successors-in-interests to their respective marks, nor related companies that use the respective marks to enure to the benefit of the respective owners within the meaning of Sections 5 and 45 of the Act.

For the foregoing reasons, Petitioner and Smith are not in privity for res judicata to apply.

Petitioner and Smith Do Not Hold Successive Rights in ENTREPRENEURPR Mark

In the decision of *International Nutrition Co. v. Horphag Research Ltd.*, 220 F.3d 1325, 55 USPQ2d 1492, 1495 (Fed. Cir. 2000), the Court states:

Application of res judicata requires a prior final judgment on the merits by a court or other tribunal of competent jurisdiction; identity of the parties or those in privity with the parties; and a subsequent action based on the same claims that were raised, or could have been raised, in the prior action. *See Amgen, Inc. v. Genetics Inst.*, 98 F.3d 1328, 1331, 40 USPQ2d 1524, 1526 (Fed. Cir. 1996); *McCandless v. Merit Sys. Protection Bd.*, 996 F.2d 1193, 1197-98 (Fed. Cir. 1993)....

A variety of relationships between two parties can give rise to the conclusion that a nonparty to an action is "in privity" with a party to the action for purposes of the law of judgments, which is simply a shorthand way of saying that the nonparty will be bound by the judgment in that action. *See* 18 Charles Alan Wright et al., *Federal Practice and Procedure* §§ 4448-62 (1981). One situation in which parties have frequently been held to be in privity is when they hold successive interests in the same property. *See, e.g., Litchfield v. Crane*, 123 U.S. 549, 551 (1887) (defining privity to include a "mutual or successive relationship to the same rights of property"). Thus, a judgment with respect to a particular property interest may be binding on a third party based on a transfer of the property in issue to the third party after judgment. *See Restatement (Second) of Judgments* § 43 (1982) ("A judgment in an action that determines interests in real or

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