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

Proceeding	92063654
Party	Defendant Skawa Innovation Kft.
Correspondence Address	THOMAS P Oâ##CONNELL Oâ##CONNELL LAW OFFICE 1026A MASSACHUSETTS AVENUE ARLINGTON, MA 02476 UNITED STATES Primary Email: tpo@oconnellusa.com Secondary Email(s): diane@oconnellusa.com 781-643-1845
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 pre-clusion, or lack of jurisdiction. The deadline for pretrial disclosures for the first testimony period as originally set or reset: **04/22/2021**
Filer's Name	Thomas P. O'Connell
Filer's email	tpo@oconnellusa.com
Signature	/Thomas P. O'Connell MA Bar 567644/
Date	09/03/2020
Attachments	92063654_Motion_Summary_Judgment_vf.pdf(149798 bytes) 92063654_Motion_Summary_Judgment_Exhibits.pdf(839200 bytes)

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

Cancellation No.:	92/063,654
Registration No.	4,766,628
Registration Date:	07/07/2015
Owner:	Skawa Innovation Kft.
Mark:	Easyling
International Classes:	035, 041, 042

SMARTLING, INC.
Petitioner,

v.

SKAWA INNOVATION KFT.,
Respondent.

SKAWA INNOVATION KFT.'S MOTION FOR SUMMARY JUDGMENT

COMES NOW Respondent Skawa Innovation Kft. (hereinafter "Respondent" or "Skawa") hereby respectfully moving this Honorable Trademark Trial and Appeal Board for an Order entering summary judgment in Respondent's favor pursuant to Rule 56 of the Federal Rules of Civil Procedure and 37 C.F.R. § 2.127 on all grounds alleged in the Amended Petition for Cancellation of Petitioner Smartling, Inc. (hereinafter "Petitioner" or "Smartling") and dismissing the above-identified Cancellation proceeding with prejudice.[1]

Petitioner's claim for cancellation of the same registration for the same mark has already been litigated to final judgment between the same parties in a United States District Court of

[1] Respondent has filed and served its Answer and Affirmative Defenses (31 TTABVUE), and Respondent certifies that the parties have held their mandatory settlement and discovery conference in accordance with Fed. R. Civ. P. 26(f) and 37 C.F.R. § 2.120(a)(1)–(a)(2). It is understood that, "[w]hen any party timely files a potentially dispositive motion, including, but not limited to, a motion to dismiss, a motion for judgment on the pleadings, or a motion for summary judgment, the case is suspended by the Trademark Trial and Appeal Board with respect to all matters not germane to the motion and no party should file any paper which is not germane to the motion except as otherwise may be specified in a Board order." 37 C.F.R. § 2.127(d).

competent jurisdiction. Petitioner's claim for cancellation is barred by the doctrines of *res judicata* and *collateral estoppel,* the very essence of which being to prevent such collateral attacks on prior judgments, to conserve the resources of adjudicative bodies, and to relieve parties of the cost and vexation of multiple lawsuits. Since relitigation of a previously-litigated claim is barred, Petitioner's Amended Petition for Cancellation, which seeks to relitigate a claim already fully and fairly litigated before a United States District Court, should be dismissed.

I. Background

On July 24, 2014, Smartling filed Civil Action No. 14-cv-13106-ADB (the "Civil Action") in the United States District Court for the District of Massachusetts. Ex. A: USDC-MA ECF No. 1. On November 4, 2015, Smartling filed a First Amended Complaint where it sought as Count IV "Cancellation of the Easyling Mark." Ex. B: USDC-MA ECF No. 25. With Count IV, "Smartling ask[ed] the Court to cancel the Easyling mark [Registration No. 4,766,628] pursuant to 15 U.S.C. § 1119 because the Smartling mark is senior to the Easyling mark and the Defendants' use of the Easyling mark creates significant consumer confusion."

After nearly five years of litigation, the Civil Action went to a full trial by jury, and the jury rendered a verdict against Smartling and in favor of Respondent on all counts. Ex. C: USDC-MA ECF No. 150. Based on the jury's verdict, the United States District Court entered the following judgment on June 27, 2019: "Judgment is entered in favor of Defendant Skawa Innovation Ltd. *on all counts*." Ex. D: USDC-MA ECF No. 154 (emphasis supplied). Respondent Skawa thus prevailed on all counts, including Count IV by which Smartling brought its claim for cancellation of Registration No. 4,766,628 for the mark EASYLING. No appeal has been taken. The judgment of the District Court is final.

Just weeks after losing on its claim for cancellation in the District Court, Smartling filed a "Motion to Re-Open Proceedings" in this action and then an amended petition for cancellation seeking *again* to litigate the claim for cancellation of the EASYLING registration that it had just lost. 14 and 26 TTABVUE. As in the Civil Action, Smartling seeks the cancellation of Skawa's Registration No. 4,766,628 for the EASYLING mark. 1 and 26 TTABVUE. The District Court concluded, Petitioner now "seeks the same cancellation of Defendant's registration that it sought in [the District Court] action". 20 TTABVUE.

With its Amended Petition for Cancellation, Smartling added allegations of "NONUSE," "ABANDONMENT," and "NO BONA FIDE INTENT TO USE THE MARK IN CONNECTION WITH ALL LISTED SERVICES" to "LIKELIHOOD OF CONFUSION" in support of its claim for cancellation. Each such basis either was asserted or could have been asserted in the Civil Action, including at the time Smartling filed its amended complaint.

II. The Summary Judgment Standard.

Pursuant to Rule 56 of the Federal Rules of Civil Procedure, 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." Fed. R. Civ. P. 56(a). "Summary judgment procedure is properly regarded, not as a disfavored procedural shortcut, but rather as an integral part of the Federal Rules as a whole." *Celotex Corp. v. Catrett*, 477 U.S. 317, 327 (1986). The purpose of summary judgment is to promote efficiency and judicial economy. TBMP § 528.01. "[A]s a general rule, the resolution of Board proceedings by means of summary judgment is to be encouraged." *Univ. Book Store v. Univ. of Wis.*, 33 USPQ2d 1385, 1389 (TTAB 1994). In response to a summary judgment motion, the non-moving party "may not rest on mere denials or

conclusory assertions, but rather must proffer countering evidence. . . that there is a genuine factual dispute for trial." TBMP § 528.01, citing Fed. R. Civ. P. 56.

III. Undisputed Material Facts.

There is not a genuine issue to be tried relative to at least the following material facts:

1. On July 24, 2014, Smartling filed Civil Action No. 14-cv-13106-ADB in the United States District Court for the District of Massachusetts. Ex. A: USDC-MA ECF No. 1; Exhibit I: Affidavit of Counsel.

2. On November 4, 2015, Smartling filed its First Amended Complaint in the Civil Action seeking as Count IV "Cancellation of the Easyling Mark." Ex. B: USDC-MA ECF No. 25.

3. With Count IV of the Civil Action, Smartling sought "Cancellation of the Easyling Mark," Respondent's Registration No. 4,766,628 for the trademark Easyling, pursuant to 15 U.S.C. § 1119. Id.

4. After nearly five years of litigation, the Civil Action proceeded to trial by jury, and the jury rendered a verdict against Smartling on all counts. Ex. C: USDC-MA ECF No. 150.

5. The United States District Court entered the following judgment on June 27, 2019 for Respondent and against Petitioner: "Judgment is entered in favor of Defendant Skawa Innovation Ltd. *on all counts*." Ex. D: USDC-MA ECF No. 154. (Emphasis supplied.)

6. Count IV for "Cancellation of the Easyling Mark" was one of the "all counts" of the District Court judgment. Exs. C and D.

7. No appeal was taken, and the judgment of the District Court in favor of

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