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UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451

Butler

Mailed: July 5, 2006

Opposition No. 91101367

Brothers Research Corporation

v.

**Dura Lube, LLC, as assignee of
Herman Howard, as assignee of
High Rev Products, LLC, as
assignee of Howe Laboratories,
Inc.¹**

**Before Hairston, Drost and Kuhlke, Administrative Trademark
Judges.**

By the Board:

Applicant seeks to register the mark DURA SHINE for "car polish."² As grounds for the opposition, opposer, in its original notice of opposition,³ alleges that applicant's mark, when used on the identified goods, so resembles opposer's previously used and registered marks DURAGLOSS for "vehicle

¹ Howe Laboratories, Inc. is the original applicant, and was the applicant of record at the time this opposition commenced. The Board, in an order dated September 21, 2005, joined all named parties as defendants inasmuch as all assignments occurred subsequent to the commencement of this proceeding. See TBMP §512 (2d ed. rev. 2004).

² Application Serial No. 74483527, filed on January 27, 1994, claiming a date of first use anywhere and a date of first use in commerce of 1993.

³ Opposer's amended notice of opposition will be discussed in more detail later in this order.

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polishes and waxes"⁴ and "vehicle polishes and cleaners; wheel and tire cleaners; rubber, vinyl and leather dressings; upholstery cleaners and conditioners; glass cleaners and protectants; all-purpose cleaning preparations; preparations for washing and cleaning vehicles; car care kits featuring polish and cleaner, upholstery dressings and preparations for washing and cleaning vehicles sold as a unit; and marine polishes and cleaners"⁵ as to be likely to cause confusion, mistake or to deceive.

Applicant, in its answer, denies the salient allegations of the notice of opposition.

This proceeding commenced on April 3, 1996 with the filing of the original notice of opposition. In view of the age of this case, a brief history is in order.

Background

On October 16, 1996, opposer moved for leave to amend its notice of opposition to include a claim of ownership of newly issued Registration No. 1995431 (issued August 20, 1996 and claiming a date of first use anywhere and first use in commerce of 1985), for the following mark:

⁴ Registration No. 1632845, issued on January 29, 1991, claiming a date of first use anywhere and a date of first use in commerce of April 28, 1975.

⁵ Registration No. 1946828, issued January 9, 1996, claiming a date of first use anywhere and a date of first use in commerce of April 28, 1975.



for "vehicle polishes and cleaners; wheel and tire cleaners; rubber, vinyl and leather dressings; upholstery cleaners and conditioners; glass cleaners and protectants; all-purpose cleaning preparations; preparations for washing and cleaning vehicles; car care kits featuring polish and cleaner, upholstery dressings and preparations for washing and cleaning vehicles sold as a unit." Opposer alleges priority of use and claims that likelihood of confusion also exists between applicant's mark and opposer's newly registered mark.

On October 21, 1996, opposer moved for summary judgment in its favor on its priority and likelihood of confusion claim. Before the due date for its response, applicant, on November 4, 1996, moved to suspend because the parties were involved in a civil action concerning the same marks that are the subject matter of this opposition.⁶ The Board, in an order dated January 6, 1997, granted applicant's motion to suspend proceedings in view of the court case and made the following additional determinations on other pending matters: granted opposer's

⁶ *Howe Labs., Inc. v. Brothers Research Corp.*, No. 3:96CV2211(WIG) (D. Conn.).

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motion (dated October 30, 1996) for leave to supplement its motion for summary judgment; granted opposer's motion (filed October 16, 1996) for leave to file an amended notice of opposition; and informed the parties that, upon resumption, time for applicant to answer the amended notice of opposition and file a response to opposer's motion for summary judgment will be reset, if appropriate.

Over the passage of time, the Board made numerous inquiries as to the status of the court case which occasioned suspension of the Board proceeding. Finally, on October 4 2004, the Board resumed proceedings, resetting discovery and trial dates. Notwithstanding resumption, the resetting of the time for applicant to file an answer to the amended notice of opposition and to file its response to opposer's motion for summary judgment was overlooked. Neither party brought such oversight to the attention of the Board.

In an order dated September 21, 2005, the Board, considering applicant's motion to substitute, joined the parties named in the captioning of this proceeding as party defendants, and articulated that dates remained as set in the October 4, 2004 resumption order.⁷ On October 7, 2005, opposer moved to reopen discovery arguing that, as a result of settlement (on damages) in the court case, applicant's subject mark was assigned to one of

⁷ In accordance with such resumption order, the only period remaining open at the time the Board issued its September 21, 2005 order was plaintiff's rebuttal testimony period.

opposer's affiliates and that "[n]ow it appears that Howe and its principal, Mr. Herman Howard, have made a series of subsequent and fraudulent assignments of the same mark..." On December 5, 2005, the Board granted opposer's fully briefed motion to reopen, resetting discovery and trial dates.

This case now comes up on opposer's fully briefed motion, filed February 21, 2006, for summary judgment on its claim of likelihood of confusion. Opposer's summary judgment motion relies both on the determination in the court case for its *res judicata* effect and a renewal of its original motion for summary judgment.

Preliminary matters addressed

Before turning to the merits of opposer's summary judgment motion, the Board addresses some procedural matters.

The Board first notes that opposer's present motion for summary judgment, having been filed long after the opening of the first testimony period in this case, is technically untimely. See Trademark Rule 2.127(e)(1). Nonetheless, because opposer relies on the doctrine of issue preclusion in support of its motion (discussed in more detail, *infra*), the Board will consider the motion for summary judgment. See *Lukens, Inc. v. Vesper Corp.*, 1 USPQ2d 1299, 1300 n.2 (TTAB 1986), *aff'd*, *Vesper Corp. v. Lukens, Inc.*, 831 F.2d 306 (Fed. Cir. 1987).

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As discussed above, opposer's amended notice of opposition differs from the original only by adding a third registration upon which opposer seeks to rely. Inasmuch as applicant has not been provided an opportunity to answer, opposer's reliance on this third registration (No. 1995431) will not be considered by the Board except to the extent it was part of the judgment entered by the district court (discussed in more detail, *infra*).

Petitioner's summary judgment motion

In support of its motion for summary judgment, opposer argues that the parties engaged in extensive and contentious litigation before the district court; that the court decided the issue of likelihood of confusion in opposer's favor; that, after such determination, the parties went to trial with respect to damages only; and that, as part of the settlement agreement on the damages issue, Howe assigned the DURA SHINE mark to opposer's affiliated company (Contract Filling and Packaging, Inc.), along with the associated goodwill and the application for registration therefor. Opposer argues that both parties maintained that the facts were so clear and undisputed that they cross moved for summary judgment before the district court; and that the court's decision in opposer's favor on the issue of likelihood of confusion was "exhaustive and sound." Opposer contends that applicant (or any party acting through applicant) cannot plausibly maintain that it has the right to register the same

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mark that was contractually assigned to opposer's affiliated company as a part of the settlement agreement on damages in the court case. Opposer also requests that its pending motion for summary judgment (filed October 21, 1996) be considered in the event that the determinations made by the district court are deemed insufficient in any way.

Opposer's motion is accompanied, in part, by a declaration from its president introducing a copy of the assignment, evidencing an execution date of April 4, 2000, of the DURA SHINE mark from Howe Laboratories, Inc, The Media Group, Inc. and American Direct Marketing, Inc. to Contract Filling and Packaging, Inc.; the district court's decision in *Howe Laboratories, Inc. v. Brothers Research Corporation*, No. 3:96CV2211(WIG) (D. Conn. June 15, 1999); and a complete copy of opposer's October 21, 1996 summary judgment motion.⁸

In response, applicant (Dura Lube, LLC) argues that it purchased the DURA SHINE mark in 2005; that it had no knowledge of any activity prior thereto with respect to the mark, including the district court case and any purported earlier assignment of

⁸ Opposer did not introduce status and title copies of its pleaded registrations with either the October 21, 1996 or February 21, 2006 motion for summary judgment. Nor did opposer submit status and title copies of the pleaded registrations with either the original or amended notice of opposition. See Trademark Rule 2.122(d); and TBMP §528.05(d) (2nd ed. rev. 2004). While opposer's president (see the October 21, 1996 summary judgment motion) states that opposer is the owner of the pleaded registrations, and plain photocopies of such registrations are accompanying exhibits, the declaration is silent as to status of the registrations. See TBMP §528.05(b) (2d ed. rev. 2004).

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the mark; that the assignor did not provide applicant with any copies of filings or records; and that applicant learned of the opposition through its own due diligence review but "as a non-party, had no access to the Board's records."⁹ Applicant argues that it did review the USPTO assignment records to ascertain if an assignment has been recorded and found no assignment. Thus, applicant, relying on Trademark Act §10(a)(4), argues that, because it had no notice, it was a good faith purchaser of the DURA SHINE mark; that the earlier assignment to opposer is void; and that a genuine issue of material fact exists as to whether applicant should be bound by the earlier actions of its predecessor with respect to the mark.

Applicant's response is accompanied by the declaration of its chief financial officer in support of applicant's recited circumstances giving rise to its acquisition of the mark; a copy of the USPTO's abstract assignment records for application Serial No. 74483572 for the DURA SHINE mark; and executed copies of the Trademark Assignment Agreement concerning the DURA SHINE mark and application therefor between Herman S. Howard as assignor and applicant as assignee.

⁹ The Board notes in passing that its records are public. Indeed, for over three years now, including the year 2005, such records may be accessed on-line. No fee is charged for such access. Older records which are not available on-line are available for inspection at the USPTO. See TBMP §120 (2d ed. rev. 2004) for more information on access to files.

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In reply, opposer argues that ownership of the DURA SHINE mark is irrelevant, contending that, even if applicant is a good faith purchaser, this opposition is based on whether likelihood of confusion exists between the parties' respective marks. Opposer points out that applicant never mentions likelihood of confusion or offers any evidence or arguments with respect to likelihood of confusion in any attempt to create a genuine issue of material fact about likelihood of confusion.

In a motion for summary judgment, the moving party has the burden of establishing the absence of any genuine issues of material fact and that it is entitled to judgment as a matter of law. See Fed. R. Civ. P. 56(c). A genuine issue with respect to a material fact exists if sufficient evidence is presented that a reasonable fact finder could decide the question in favor of the non-moving party. See *Opryland USA Inc. v. Great American Music Show, Inc.*, 970 F.2d 847, 23 USPQ2d 1471 (Fed. Cir. 1992). Thus, all doubts as to whether any factual issues are genuinely in dispute must be resolved against the moving party and all inferences must be viewed in the light most favorable to the non-moving party. See *Olde Tyme Foods Inc. v. Roundy's, Inc.*, 961 F.2d 200, 22 USPQ2d 1542 (Fed. Cir. 1992).

The Board, at the outset, agrees that it does not have to decide the ownership issue of application Serial No. 74483572 for the mark DURA SHINE. In its reply, opposer, at least for purposes of its summary judgment motion, submits that, even if

applicant is a good faith purchaser of the mark and application, likelihood of confusion exists between the parties' respective marks as a matter of law. Thus, assuming for purposes of this summary judgment motion, that the assignment to applicant is valid, applicant, as a successor in interest, stands in the shoes of its assignor and derived only those rights that its predecessor had in the mark. See *Educational Development Corporation v. Educational Dimensions Corporation*, 183 USPQ 492 (TTAB 1974); and McCarthy, J. Thomas, 2 McCarthy on Trademarks and Unfair Competition §18:15 (4th ed. 2006).

Accordingly, as a matter of law, applicant is bound by the determinations made in the earlier adjudication of trademark rights between opposer and applicant's predecessor-in-interest.

The Board now looks at the decision in the civil action. Howe Laboratories brought suit against Brothers Research seeking a declaratory judgment of Howe's right to use the mark DURA SHINE. Brothers' counterclaim included a count of trademark infringement. Each party moved for summary judgment in its favor. The court stated the issue as "... whether Brothers' DURAGLOSS mark is likely to be confused with Howe's DURA SHINE mark."¹⁰ In his thirty-eight page decision, entering judgment in

¹⁰ The court, in its opinion, recognized that "Brothers owns three United States trademark registrations for the DURAGLOSS mark." The court also was aware of this opposition proceeding: "After the DURA SHINE mark was published for opposition, Brothers filed a Notice of Opposition and Howe replied. ... Before the due date of Howe's response to Brothers' PTO motion for summary judgment, Howe began this Declaratory Judgment action."

favor of Brothers on the issue of likelihood of confusion,¹¹ the district court judge made the following determinations: 1) Brothers' DURAGLOSS mark is relatively strong due to both its inherent and acquired strength; 2) the marks DURAGLOSS and DURA SHINE are similar and project very similar commercial impressions; 3) the involved goods are the same; 4) there has been "significant credible evidence of actual confusion which affects the purchasing and selling of the goods in question"; 5) there was insufficient evidence to find that Howe acted in bad faith; 6) that the parties sometimes share the same channels of trade and that the products involved are relatively inexpensive leading the Court to conclude that ordinary purchasers do not exercise a great deal of care.

Under the doctrine of collateral estoppel, or issue preclusion, if an issue is actually and necessarily determined by a court of competent jurisdiction, that determination is conclusive in a subsequent suit involving the same issue. The requirements which must be met for issue preclusion are:

- (1) identity of issues in a prior proceeding;
- (2) the issues were actually litigated;
- (3) the determination of the issues was necessary to the resulting judgment; and
- (4) the party defending against preclusion had a full and fair opportunity to litigate the issues.

¹¹ More specifically, the court granted Brothers' motion for summary judgment and denied Howe's motion for summary judgment.

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See Mayer/Berkshire Corp. v. Berkshire Fashions Inc., 424 F.3d 1229, 76 USPQ2d 1310 (Fed. Cir. 2005); *Jet Inc. v. Sewage Aeration Systems*, 223 F.3d 1360, 55 USPQ2d 1854 (Fed. Cir. 2000); and *Larami Corp. v. Talk To Me Programs Inc.*, 36 USPQ2d 1840, 1843-1844 (TTAB 1995).

The issue of likelihood of confusion between the marks DURAGLOSS and DURA SHINE for "car polish" (the only item in applicant's identification of goods) was raised, litigated and fully adjudicated by the district court. Applicant does not dispute this. Determination of the issue was necessary and essential to the resulting judgment and the parties were fully represented before the court.¹² Priority in Brothers' favor is implicit in the court's grant of Brothers' motion for summary judgment on the issue likelihood of confusion.

Accordingly, under the doctrine of collateral estoppel, there being no genuine issue of material fact with respect to priority and likelihood of confusion, opposer's motion for summary judgment is granted. Judgment is hereby entered against applicant and the opposition is sustained.¹³

¹² In this case, the present applicant was fully represented by its predecessor-in-interest.

¹³ In view of the decision rendered herein, the need for applicant to answer the amended notice of opposition is deemed moot.