

THIS OPINION IS NOT A
PRECEDENT OF THE TTAB

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

wellington

Mailed: March 13, 2007

Cancellation No. 92042996

Nixalite of America, Inc.

v.

Bird Barrier America, Inc.

Before Bucher, Drost, and Mermelstein
Administrative Trademark Judges.

By the Board:

This petition for cancellation was filed on September 9, 2003, to cancel Registration No. 2526442 for BIRD BARRIER, in typed form, for use in connection with "pest control devices, namely non-electric metal wire attached to a structure for deterring birds from landing and perching" in Class 6.¹ As the sole ground for its petition, petitioner alleges that "bird barrier" is a generic term "used by the relevant trade or industry for all goods in a particular category and does not distinguish the goods of any party from that of any other party." Petitioner also

¹ Registration No. 2526422 registered on the Supplemental Register on January 8, 2002, with a disclaimer of the term "BIRD" and claiming June 30, 1993, as the date of first use and use in commerce.

pleads its standing by alleging that it "needs to use the term 'Bird Barrier' as the generic name for certain goods that are sold by petitioner, in order to compete effectively in the relevant trade and market."

Respondent, in its answer, denies the salient allegations of the petition to cancel.

This case now comes up on the petitioner's motion (filed May 5, 2006) for summary judgment on the genericness ground. Petitioner notes that the Board found the term BIRD BARRIER generic in a previous opposition proceeding between these parties,² and now contends that respondent is collaterally estopped from relitigating the issue of genericness in this proceeding.

Respondent filed the following one paragraph response to the summary judgment motion:

In the decision of the TTAB attached to the petitioner's motion, the ttab construed and treated the "goods" in the tm application there at issue as being limited to a single metal spikes product which both petitioner and respondent manufacture and sell. The description of goods in the tm registration at issue here is exactly the same. Accordingly, assuming the ttab would again limit its analysis and construction of the goods here at issue to the same metal spikes product as in the earlier decision, respondent agrees that the doctrine of "issue preclusion" would apply.

² Opposition No. 91122927, against registration of application Serial No. 75631260 (BIRD BARRIER and design, BIRD disclaimed). The goods in respondent's earlier application were identical to those set out in the registration involved in this proceeding.

While respondent's statement is not entirely clear, because the above response does not rebut petitioner's summary judgment or to the extent that it is purposely intended as a concession of this proceeding, the motion for summary judgment is granted as conceded. Fed. R. Civ. P. 56 and Trademark Rule 2.127(a).

Although we conclude that respondent has conceded the summary judgment motion, we consider the summary judgment motion on its merits and, as explained further below, grant the motion on this basis as well.

In support of its motion, petitioner argues that respondent is collaterally estopped from asserting that "bird barrier" is not generic when used in conjunction with the goods identified in respondent's registration. Specifically, petitioner argues that under the doctrine of issue preclusion the Board should find that the term BIRD BARRIER is generic for respondent's identified goods on the basis of the finding by Board in *Nixalite of America, Inc. v. Bird Barrier America, Inc.*, Opposition No. 91122927. The United States Court of Appeals for the Federal Circuit affirmed the Board's decision in Appeal No. 04-1524 (April 8, 2005). Petitioner concludes that it is entitled to judgment as a matter of law.

Petitioner's motion is supported by copies of the Board's final decision in Opposition No. 91122927 and the

decision issued by the Court of Appeals for the Federal Circuit affirming the Board's decision in the opposition proceeding.

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).

Under the doctrine of collateral estoppel, or issue preclusion, if an issue is actually and necessarily determined against a party by a court of competent jurisdiction, that determination is conclusive in a subsequent suit involving the same issue and party. The requirements which must be met for issue preclusion are: (1) the issue to be determined must be identical to the issue involved in the prior action; (2) the issue must have been raised, litigated and actually adjudged in the prior action; (3) the determination of the issue must have been necessary and essential to the resulting judgment; and (4) the party precluded must have been fully represented in the prior action. See, e.g., *Mother's Restaurant Inc. v.*

Cancellation No. 92042996

Mama's Pizza, Inc., 723 F.2d 1566, 221 USPQ 394, 397 (Fed. Cir. 1983); and *Larami Corp. v. Talk To Me Programs Inc.*, 36 USPQ2d 1840, 1843-1844 (TTAB 1995), citing *Lukens Inc. v. Vesper Corporation*, 1 USPQ2d 1299 (TTAB 1986), aff'd Appeal No. 87-1187 (Fed. Cir. Sept. 18, 1987).

Petitioner, as opposer in the opposition, opposed respondent's registration of the mark BIRD BARRIER (with a design) without a disclaimer of the term "Bird Barrier." After full consideration of the parties' submissions, including trial briefs, and an oral hearing, the Board sustained the opposition and found the term "Bird Barrier" to be generic for the "pest control devices, namely non-electric metal wire attached to a structure for deterring birds from landing and perching" in Class 6.

We find that the issue involved in the prior opposition proceeding is identical to the issue to be determined in this cancellation, namely, whether the term "Bird Barrier" is generic for "pest control devices, namely non-electric metal wire attached to a structure for deterring birds from landing and perching" in Class 6. In view thereof, the issue of genericness was actually raised, litigated and adjudged, it was necessary and essential to the opposition proceeding, and respondent (as applicant therein) was fully represented in that proceeding.

Inasmuch as the requirements for the application of issue preclusion have been met, we find that the term "bird barrier" is generic as used in connection with respondent's identified goods.

Accordingly, petitioner has met its burden on summary judgment. There is no genuine issue as to any fact that would be material to the question of genericness, and petitioner is entitled to judgment on this question as a matter of law. Petitioner's motion for summary judgment is, therefore, granted, and judgment is entered against respondent on the ground of genericness.

Registration No. 1190527 will be cancelled in due course.

* * *