

**THIS DISPOSITION
IS NOT CITABLE AS PRECEDENT
OF THE T.T.A.B.**

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

Lykos

Mailed: October 25, 2006

Cancellation No.92045643

International Flora
Technologies, Ltd.

v.

Desert Whale Jojoba Company,
Inc.

Before Hohein, Grendel and Walsh, Administrative Trademark
Judges.

By the Board:

International Flora Technologies, Ltd. ("petitioner")
seeks to cancel Desert Whale Jojoba Company, Inc.'s
("respondent") registration for the mark JOJOBASOMES for
"skin soaps, essential oils for personal use, cosmetics, and
hair lotions" in International Class 3.¹ As grounds for
cancellation, petitioner alleges that respondent's
registered mark so resembles petitioner's previously used
and registered marks that it is likely to cause confusion,
mistake, or deceive prospective consumers under Section 2(d)

¹ Registration No. 3038816, issued on January 10, 2006, alleging
June 1, 2002 as the date of first use anywhere and in commerce.

of the Lanham Act. In the petition for cancellation, petitioner has pleaded ownership of the following registered marks:

METASOMES for "chemical additives for use in the manufacture of cosmetics" in International Class 1;²

FLORASOMES for "chemicals, namely, wax esters in microspherical form for use in the manufacture of cosmetics and lubricants" in International Class 1;³

JOJOBEBADS for "hydrogenated jojoba wax for use in cosmetics" in International Class 1;⁴ and

JOJOBUTTER for "jojoba oil for use in the manufacture of cosmetics and sun care products" in International Class 3;⁵

In its answer, respondent denied the salient allegations and asserted various affirmative defenses, including that the doctrine of *res judicata* bars petitioner's claims in this proceeding.

² Registration No. 2579871, issued June 11, 2002, alleging May 15, 2000 as the date of first use anywhere and in commerce.

³ Registration No. 2233871, issued March 23, 1999, alleging November 21, 1997 as the date of first use anywhere and in commerce, Section 8 affidavit accepted and Section 15 affidavit acknowledged.

⁴ Registration No. 1529171, issued March 14, 1989, alleging April 29, 1988 as the date of first use anywhere and in commerce. Section 8 affidavit accepted and Section 15 affidavit acknowledged.

⁵ Registration No. 1194173, issued on April 27, 1982, alleging December 14, 1979 as the date of first use anywhere and December 27, 1979 as the date of first use in commerce. Section 8 and 9 affidavits granted, and Section 15 acknowledged.

This case now comes up for consideration of respondent's motion (filed May 4, 2006) for summary judgment on the ground of claim preclusion, or *res judicata*.⁶ The basis for respondent's motion for summary judgment is the final order issued by the Board in Opposition No. 91157402, *International Flora Technologies, Ltd. v. Desert Whale Jojoba Company, Inc.*.

By way of background, petitioner had previously opposed registration of respondent's mark in Opposition No. 91157402. In the opposition proceeding, petitioner (who was in the position of opposer in that case) challenged respondent's application under Section 2(d) of the Trademark Act alleging that respondent's applied-for mark may be viewed as a combination of elements of petitioner's previously used and registered marks thereby causing a likelihood of confusion with prospective consumers. The notice of opposition further alleged that the parties' goods and services are substantially the same and marketed to the same customers. Petitioner relied on its ownership of registrations for the marks METASOMES, FLORASOMES, JOJOBEBEADS and JOJOBUTTER (the same registrations pleaded in this cancellation proceeding) and on its use of each of these

⁶ Respondent has submitted a reply brief which the Board has considered because it clarifies the issues herein. Consideration of a reply brief is discretionary on the part of the Board. See Trademark Rule 2.127(a).

marks prior to respondent's first use of its applied-for a mark as asserted in each registration.

The Board dismissed the opposition, finding that petitioner failed to sustain its burden of proof. More specifically, the Board noted that petitioner did not introduce any evidence during its assigned testimony period, and failed to properly establish its ownership of, and the current status of, its pleaded registrations. Instead, petitioner attached various exhibits to its main brief, including printouts of its pleaded registrations from the USPTO database. As the Board explained:

Opposer's pleading did not make its registrations of record in the manner prescribed by Trademark Rule 2.122(d), 37 C.F.R. § 2.122(d). Nor did the answer admit opposer's ownership of the registrations and their continuing validity. Thus proper introduction of the registrations was a matter to be completed at trial. . . .

Although opposer has asked in its reply brief that the Board take judicial notice of its registrations, we deny this request. It is well settled that the Board does not take judicial notice of USPTO records. See *Beech Aircraft Corp. v. Lightning Aircraft Co.*, 1 USPQ2d 1290, 1293 (TTAB 1986) (Board refused to take judicial notice of petitioner's pleaded and rejected, application for purposes of establishing petitioner standing). . . .

Thereafter, the opposed application matured into the registration that is the subject of this proceeding.

We now turn to a review of the parties' respective arguments. In its motion for summary judgment, respondent argues that the requisite elements of doctrine of

res judicata have been satisfied insofar as the parties in the prior opposition and this case are the same; that the claims from both proceedings are the same -- namely that respondent's mark is confusingly similar to petitioner's previously used marks; that petitioner pleaded ownership of the same registered marks in both cases; and that the Board's determination constitutes a prior final judgment on the merits.

In response thereto, petitioner contends that the prior opposition was dismissed on procedural grounds and not the merits, and therefore the doctrine of *res judicata* is not applicable to the instant cancellation proceeding; and that petitioner should not be penalized in this case for failing to comply with technical requirements regarding the introduction into evidence of its pleaded registrations.

In reply, respondent contends that contrary to petitioner's assertion, the final determination issued in the opposition proceeding constitutes a decision on the merits.

Under the doctrine of *res judicata*, the entry of a final judgment "on the merits" of a claim (i.e., cause of action) in a proceeding serves to preclude the re-litigation of the same claim in a subsequent proceeding between the parties or their privies, even in those cases where the prior judgment was the result of a default or consent. See

Lawlor v. National Screen Service Corp., 349 U.S. 322, 75 S.Ct. 865, 99 L.Ed. 1122 (1955); *Chromalloy American, supra*; and *Flowers Industries, supra*. A second suit is barred by res judicata or claim preclusion if:

- (1) the parties (or their privies) are identical;
- (2) there has been 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.

Jet, Inc. v. Sewage Aeration Systems, 223 F.3d 1360, 55 USPQ2d 1854, 1856 (Fed. Cir. 2000).

After reviewing the notice of opposition in Opposition No. 91157373 and the petition to cancel herein, we find that the doctrine of claim preclusion, or *res judicata*, is applicable in this proceeding. The same parties have been involved in the respective proceedings. Further, a final judgment on the merits was issued in the opposition proceeding in the April 29, 2005 order dismissing the opposition. Lastly, both proceedings challenged respondent's eligibility to register the mark JOJOBASOMES based on a likelihood of confusion with petitioner's registered marks METASOMES, FLORASOMES, JOJOBEBADS and JOJOBUTTER. The likelihood of confusion claims are asserted in a virtually identical manner in each case. Compare the following excerpts from each pleading:

Because the mark sought to be registered is a combination of major portion of [International Flora Technologies, Ltd.'s] already registered marks, and because both [sic] [International Flora Technologies, Ltd.] and the applicant supply substantially the same goods and services to the same customer base, a mark comprising a combination of the major portions of the major portions of [sic] numerous [International Flora Technologies, Ltd.] registered trademarks will create a high likelihood of confusion as the source of goods.

. . .

Paragraph 10 of the Notice of Opposition.

Because the JOJOBASOMES mark is a combination of major portions of [International Flora Technologies, Ltd.'s] registered marks, and because both [International Flora Technologies, Ltd.'s] and Registrant supply substantially similar goods and services to the same customers, a mark comprising a combination of the major portions of several of [International Flora Technologies, Ltd.'s] registered trademarks create a high likelihood of confusion as the source of goods and services.

Paragraph 42 of the Petition to Cancel.

Petitioner's contention that the final determination issued in the opposition proceeding does not constitute a judgment on the merits is unavailing. As noted *inter alia*, courts have long held that even default judgments give rise to *res judicata*. See *International Nutrition Co. v. Horphag Research Ltd.*, 55 USPQ2d 1492, 1494 (Fed. Cir. 2000) and cases cited therein. See generally *Wright, Miller & Cooper*, 18 A Federal Practice and Procedure Civil 2d § 4440 (1999). As explained above, the Board found that petitioner failed to sustain its burden of proof in the opposition, a finding which constituted a decision on the merits of the case.

Accordingly, respondent's motion for summary judgment is hereby granted. The petition to cancel is hereby dismissed.