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UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
P.O. Box 1451
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Skoro

Mailed: October 29, 2008

Cancellation No. 92048605

Joro Companies, Inc. dba RID-
O-VIT

v.

Trashbusters Inc.

**Before Hohein, Rogers and Cataldo,
Administrative Trademark Judges.**

By the Board:

Trashbusters Inc. owns Registration No. 2659120 for the mark 1 800 RID-OF-IT,¹ for "custom trash hauling" in International Class 39. On December 8, 2007, Joro Companies, Inc., d/b/a RID-O-VIT, (hereinafter "Joro") filed a petition to cancel the registration, claiming a likelihood of confusion with the mark in its predecessor's, Michael Saya, (hereinafter "Saya") now cancelled Registration No. 1886345 for RID-O-VIT and Design² for "contract truck hauling" in International Class 39, and its own common law

¹ Issued December 10, 2002, claiming dates of first use anywhere of August 2001 and first use in commerce of November 2001. "1 800" is disclaimed.

² Issued March 28, 1995, claiming dates of first use anywhere and first use in commerce of September 9, 1992; cancelled under Section 8 on April 4, 2002.

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trademark rights since 1994³ for "contract truck hauling, trash and recycling pickup; and rental of dumpsters".⁴

This case now comes up on respondent's motion for summary judgment, filed June 30, 2008. As grounds for its motion, respondent alleges claim preclusion.⁵ Petitioner filed its opposition to respondent's motion on August 4, 2008, and respondent filed a reply.

In support of its motion for summary judgment, respondent asserts that the decision in Cancellation No. 92042608, "Michael J. Saya v. Trashbusters Inc.," provides the basis for the application of claim preclusion. Respondent argues that the previous cancellation involved the same claim, namely a likelihood of confusion between the

³ Petitioner claims that Mr. Saya is a predecessor in interest for purposes of tacking on to the dates of use from 1994 until its own use of the mark began in 2000, based on an exclusive license agreement.

⁴ On April 16, 2006, a co-founder of petitioner and also described as its chief executive officer, Wendy R. Pollicemi, filed a trademark application, as an individual, Serial No. 78862431, for the mark RID-O-VIT for "commercial waste services, namely, contract truck hauling, trash and recycling pickup, rental of dumpsters" in Class 39; claiming dates of first use anywhere and first use in commerce of March 2, 1994. Examination thereof has been suspended pending determination of this cancellation proceeding.

⁵ The deadline for the parties' settlement and discovery conference as well as the deadline for the parties to exchange initial disclosures, see Trademark Rules 2.120(a)(2) and 2.120(a)(3), both preceded the filing of the motion for summary judgment. The record does not reveal whether respondent made initial disclosures prior to the filing of the motion for summary judgment, but a motion based on claim preclusion is considered an exception to the rule that otherwise bars filing of a motion for summary judgment prior to making initial disclosures. See Trademark Rule 2.127(e)(1).

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same marks; that the present petitioner, as a licensee of Mr. Saya, was and is in privity and thus there is an identity of the parties; and that while the prior proceeding was dismissed with prejudice as a sanction for failure to comply with a Board order granting a motion to compel, the judgment was a final judgment on the same pleaded claim, thereby barring relitigation of the claim in this cancellation proceeding.

To establish its allegation that the claims involved are identical, respondent submitted a copy of the petition to cancel in the previous proceeding, to demonstrate that both cancellation proceedings involve the same registration owned by respondent and the same claims of priority and likelihood of confusion; and a copy of the final order wherein the earlier proceeding was dismissed with prejudice.

To establish its allegation that the parties are the same, in particular, the party in the position of plaintiff is identical or in privity with petitioner, respondent has provided a copy of the exclusive license agreement entered into between petitioner Saya and petitioner Joro, executed on July 7, 2000.⁶

⁶ This license agreement provides for petitioner's exclusive use of the mark in the State of New York in connection with the identified services. Petitioner also submitted a fully executed copy of this agreement.

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In its opposition to the motion for summary judgment, petitioner argues that Joro is not "substantially identical" to Saya; that the transactional facts are not the same because Joro's services have expanded and are "significantly different" from Saya's; and that abandonment and descriptiveness claims were not raised in the first cancellation proceeding.

Under the doctrine of claim preclusion, the entry of a final judgment "on the merits" of a claim (or cause of action) in a proceeding will preclude the relitigation of the same claim in a later proceeding that involves the same parties or their privies. Claim preclusion also extends to those claims or defenses that could have been raised in the prior action. *See Chromalloy American Corp. v. Kenneth Gordon, Ltd.*, 736 F.2d 694, 222 USPQ 187 (Fed. Cir. 1984); *see also, Jet, Inc. v. Sewage Aeration Systems*, 223 F.3d 1360, 55 USPQ2d 1854 (Fed. Cir. 2000), *reh'g and reh'g en banc* denied, 2000 U.S. App. LEXIS 26699 (Fed. Cir. 2000); and *Flowers Industries Inc. v. Interstate Brands Corp.*, 5 USPQ2d 1580 (TTAB 1987).

Because Joro was an exclusive licensee of Saya during the prior proceeding, because the claim of a likelihood of confusion asserted by Saya against Trashbusters in the prior proceeding is the same as a claim asserted here, and because the June 9, 2005 judgment dismissed the prior proceeding

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with prejudice, the principles of claim preclusion apply in this case.

A review of the evidence shows that the two cancellation proceedings involve the same claim, even though Joro has included two sentences in its petition that allege abandonment by respondent and that respondent's mark is merely descriptive. Respondent argues that these latter two issues could have been raised in the prior proceeding and that neither respondent's use of the mark or its services has changed which only now give rise to new grounds for a petition. Petitioner responds that these grounds arise from different transactional facts, which is the correct focus of the test for preclusion⁷, rest on different proofs and, therefore, are not precluded. Respondent counters that because these issues could have been raised in the prior proceeding, they are equally barred in this proceeding under the doctrine of claim preclusion.

Both proceedings involve challenges to Trashbusters registration of the mark 1 800 RID-OF-IT based on a

⁷ Petitioner cites *Acumed LLC v. Stryker Corp.*, 525 F.3d 1319, 86 USPQ2d 1950 (Fed. Cir. 2008) in support of the proposition that for claim preclusion the test is whether the transactional facts are the same between the "claims", not whether the "claims" in the second action could have been raised in the first action. This case is inapposite. The Federal Circuit had before it a patent infringement case and the "claims" referred to are patent claims. The Court did state that claim preclusion issue is particular to patent law and defined "transactional fact" in patent infringement as the "structure of the device in issue" (Id. at 1955). In trademark cancellation proceedings, transactional facts and claim preclusion are broader concepts.

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likelihood of confusion with petitioner's RID-O-VIT registration. The evidence further shows that petitioner, Joro, was a licensee of Saya on July 7, 2000, during the litigation of Cancellation No. 92042608; the final decision in that case issued on June 9, 2005; and the cancellation resulted in final judgment against petitioner, Saya, and in favor of respondent herein, Trashbusters Inc.

Based on our finding that the parties involved in Cancellation No. 92042608 and this proceeding are the same, that the act or occurrence involved in both cases is the same, and that judgment has been entered in the prior proceeding against petitioner, respondent is entitled to judgment as a matter of law based on claim preclusion and, accordingly, its motion for summary judgment is hereby granted.

The petition to cancel is hereby dismissed.