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

Proceeding	92049349
Party	Plaintiff Edward B. Beharry & Company, Ltd.
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UNITED STATES PATENT AND TRADEMARK OFFICE
TRADEMARK TRIAL AND APPEAL BOARD

Edward B. Beharry & Co. Ltd.,	)	
	)	Opposition No. 92,049,349
PETITIONER,	)	
	)	MARK: CHAMPION
vs.	)	
	)	Registration No. 3,051,908
AFN Broker, LLC	)	
	)	
REGISTRANT.	)	

PETITIONER, EDWARD B. BEHARRY & CO. LTD.'S
OPPOSITION TO DEFENDANT'S MOTION FOR SUMMARY JUDGMENT

AND

MOTION UNDER RULE 56(f) FOR DISCOVERY ON THE ISSUE OF PRIVITY

In its Motion, Defendant AFN argues that Beharry's Petition for Cancellation of Registration No. 3,051,908 is barred by the doctrine of res judicata. AFN alleges that "Plaintiff seeks to cancel the registration on the same grounds asserted in the [earlier] Opposition, namely abandonment." AFN's motion must be denied. Abandonment was neither pled nor litigated in the earlier Opposition. Accordingly there has been no "earlier final judgment on the merits of the claim" of abandonment.

Moreover, the facts do not show that AFN is in privity with the defendant (Universal) in the Opposition upon which AFN bases its arguments. These disputed material issues of fact preclude summary judgment as to whether AFN is in privity with the defendant (Universal) in the earlier Opposition. At minimum, Beharry is entitled discovery under Federal Rules 26 and 56(f) to learn the basis for AFN's claim that it is entitled to rely on a prior proceeding regarding another party. In any event, summary judgment must be denied because res judicata could not

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preclude a claim of abandonment that may be based on events that occurred after the conclusion of the earlier action.

A. Background

On October 1, 1997, Beharry filed a Notice of Opposition against Application No. 74/707,614, which was then owned by an entity called Universal Foods & Merchandising Co. ("Universal"). As evidenced by the Notice of Opposition, which is attached as Ex. A, Beharry, as its grounds for the Opposition alleged it had been using the CHAMPION mark since 1961 and that Universal's adoption of the same CHAMPION mark would be likely to cause consumer confusion. *See,* Ex. A. Notably absent from the Notice of Opposition is any allegation by Beharry that the mark had been abandoned by Universal, nor was the Notice of Opposition ever amended to include a claim of abandonment. In fact, the final decision issued by the Board dismissing the Opposition expressly states:

> In addition, opposer seeks a reopening of discovery so that it can take discovery in connection with applicant's alleged abandonment of the involved CHAMPION mark. ***However, opposer did not plead an abandonment claim in its notice of opposition and did not file a motion for leave to file an amended notice of opposition to add such a claim.***

D.E. 29 (AFN's Motion for Summary Judgment) at Ex. 1, ftn. 2 (emphasis added).

After the 1997 Notice of Opposition was filed, the parties engaged in extensive rounds of settlement discussions. Various drafts of settlement agreements were exchanged between the parties. On July 27, 2004 the parties moved for an extension of time, advising the Board that they were engaged in settlement discussions. In response, the Board suspended the matter for six months and advised the parties that if the Board receives no word from the parties as to the progress of the settlement, it would issue an order resuming the proceedings. The parties continued to discuss settlement during and after the suspension. See *e.g.,* Ex. B, letter dated

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March 3, 2005. On March 11, 2005 the Board, after receiving no notification that the matter had settled, resumed the proceedings and reset the trial calendar.

On April 7, 2005, counsel for Beharry contacted Universal's counsel to follow-up on a letter sent on March 3, 2005 regarding the latest settlement proposal. During this call, Universal's counsel indicated that he had been unable to get in contact with his foreign client, and speculated that Universal may be out of business. At this point, Beharry had invested several years and substantial effort to try to settle this matter, and hoped that a settlement could still be salvaged. But after counsel's subsequent efforts to communicate with his client proved unsuccessful, Beharry could wait no longer, and on November 1, 2005 moved the Board to reopen discovery so that it could formally inquire whether the Applicant was still in business and/or had abandoned its use of the mark. Beharry alternatively contended that the failure of Applicant to respond for over six months provided good cause for an entry of an Order to Show Cause for default judgment.

On December 21, 2005, the Board denied Beharry's motion to reopen discovery and entered judgment against Beharry. In doing so, the Board noted that discovery on the issue of abandonment would be futile because Beharry had not pled abandonment in its Notice of Opposition. Ex. A; D.E. 29 (AFN's Motion for Summary Judgment) at Ex. 1, ftn 2. The Board further stated that because counsel's communications with his client, Universal, were unsuccessful "it appears unlikely that opposer could obtain responses to any new discovery requests." D.E. 29, Ex. 1 at 4. The Board also noted that "the events upon which opposer relies in support of its motion to reopen [i.e., discovering Universal may be out of business] occurred roughly seven years after the close of discovery herein." *Id.* The matter was terminated without

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amendment to the Notice of Opposition to add a claim of abandonment, and without any discovery permitted on the issue of abandonment. Abandonment was never litigated.

Meanwhile, (but unbeknown to Beharry) during much of the earlier Opposition (as now recounted by AFN), Universal purportedly did not even own the CHAMPION mark. As alleged in AFN's Motion to Substitute Party (D.E. 23, filed July 21, 2009), Universal, on May 5, 1992, entered into an agreement to assign its rights in the mark to an individual named Robert Latchman, and on October 20, 1999 did allegedly assign such rights. D.E. 23. AFN's motion further alleges that on March 21, 2001, Latchman assigned the rights in the mark to an entity called Worldwide Management, LLC ("Worldwide"). *Id.* On March 22, 2003 Worldwide assigned rights in the mark back to Latchman. *Id.* On October 19, 2004, Latchman assigned rights in the mark to a separate entity called Quest Summit LLC ("Quest"). *Id.* Finally, on November 20, 2006, Quest assigned the mark to AFN.

All of these non-disclosed assignments, and alleged changes in ownership of the CHAMPION mark supposedly occurred while the Opposition was pending against Universal.[1] Yet, Universal never notified the Board of any change in ownership, never amended its Answer to reflect a change in ownership or new parties-in-interest, and never supplemented its discovery responses. *See,* TBMP 408.03 and Fed. R. Civ. P. 26(e).[2] Universal's counsel through the conclusion of the Opposition on December 21, 2005, never advised Beharry (or its counsel) that Universal had purportedly long since relinquished all rights to the mark – most likely because counsel was unaware of the change in ownership. Instead, Universal, through its counsel continued to actively participate and defend the Opposition up to, and including, its last filing on

[1] The only exception is the transfer to AFN, which allegedly occurred eleven months after the Opposition terminated.
[2] Beharry's discovery requests are part of the record in the *Universal* Opposition, and are incorporated herein. Opposition No. 91,108,091 at D.E. 31.

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