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OPINION OF THE FEDERAL CIRCUIT
(MAY 13, 2019)

UNITED STATES COURT OF APPEALS
FOR THE FEDERAL CIRCUIT

JAMES J. MAKSIMUK,

Appellant,

v.

CONNOR SPORT COURT INTERNATIONAL, LLC,

Appellee.

2019-1156

Appeal from the United States Patent and
Trademark Office, Trademark Trial and Appeal
Board in No. 92066311

Before: DYK, REYNA, and TARANTO,
Circuit Judges.

PER CURIAM

Connor Sport Court International, LLC holds Registration No. 2,479,328 for the word mark SPORT COURT associated with plastic, interlocking floor tiles in International Class 21. That registration issued in August 2001, and it has since become incontestable. *See* 15 U.S.C. § 1065. James J. Maksimuk also sells interlocking floor tiles through his company, CWF Flooring, Inc. Mr. Maksimuk petitioned the Trademark

Trial and Appeal Board for cancellation of Connor's '328 registration, arguing that the SPORT COURT mark is generic. The parties filed several motions before the Board, including Connor's motion for summary judgment based on claim preclusion. The Board granted Connor's motion and dismissed the cancellation petition with prejudice, and Mr. Maksimuk now appeals. We affirm.

I

In January 2017, Connor sued CWF Flooring in the U.S. District Court for the District of Utah, alleging (among other things) infringement of Connor's SPORT COURT trademark by one of the domain names for CWF Flooring, "plasticsportcourttiles.com." App. 34-38. Before the district court, Mr. Maksimuk attempted to appear on behalf of CWF Flooring, but the court informed him that corporations must be represented by counsel. App. 54-55, 57. CWF Flooring never hired counsel. When CWF Flooring failed to respond to the complaint, the court entered a default judgment against it on August 10, 2017. App. 60-63. Referring to five registrations, including the '328 registration, the court found that "[t]he Sport Court Marks are distinctive and not generic." App. 61. The court enjoined CWF Flooring from using the domain name at issue because it is confusingly similar to Connor's SPORT COURT mark.

CWF Flooring timely appealed the default judgment to the U.S. Court of Appeals for the Tenth Circuit. App. 65. But several days later, the Tenth Circuit abated CWF Flooring's appeal because the company was still not represented by counsel. App. 67-68. Mr. Maksimuk moved (among other things) to

appear on behalf of CWF Flooring, but the Tenth Circuit denied the motion. App. 70-71. When CWF Flooring failed to hire counsel by the deadline, the Tenth Circuit dismissed its appeal for failure to prosecute on October 12, 2017. App. 73-74.

In June 2017, while the district-court proceedings were still pending, Mr. Maksimuk petitioned the Trademark Trial and Appeal Board to cancel Connor's '328 registration.¹ App. 77-81. Mr. Maksimuk argued that the SPORT COURT mark is generic.² Connor moved for summary judgment in the fall of 2017, after the district court had entered its judgment, arguing that the district-court judgment precluded Mr. Maksimuk from raising genericness in the Board proceeding. The Board determined that claim preclusion barred Mr. Maksimuk's cancellation petition, granted Connor's motion for summary judgment, and dismissed the petition with prejudice on June 22, 2018. App. 11-17. Mr. Maksimuk filed his notice of appeal with the Board on July 5, 2018. After Mr. Maksimuk sent his appeal to two of our sister circuits, we eventually received it on October 25, 2018. We have exclusive jurisdiction

¹ The cover sheet for the cancellation petition lists CWF Flooring as the petitioner, but the petition itself lists Mr. Maksimuk as the petitioner. The Board assumed that the cover sheet reflected a clerical error, gave Mr. Maksimuk the benefit of the doubt that he was the proper petitioner, and granted his motion to amend the case caption accordingly. App. 10-11.

² Mr. Maksimuk also argued that the SPORT COURT mark is descriptive. But while incontestable marks may be challenged as generic, they may not be challenged as merely descriptive. *See* 15 U.S.C. § 1064(1), (3). Therefore, the Board read Mr. Maksimuk's petition as properly raising only the genericness issue. App. 7.

over appeals from the Board under 28 U.S.C. § 1295 (a)(4)(B).

II

The Lanham Act grants parties in cancellation proceedings the right to appeal to this court: “[A] party to a cancellation proceeding . . . who is dissatisfied with the decision of the Director or Trademark Trial and Appeal Board[] may appeal to the United States Court of Appeals for the Federal Circuit. . . .” 15 U.S.C. § 1071(a)(1). It further indicates how the dissatisfied party must initiate the appeal:

When an appeal is taken to the United States Court of Appeals for the Federal Circuit, the appellant shall file in the United States Patent and Trademark Office a written notice of appeal directed to the Director, within such time after the date of the decision from which the appeal is taken as the Director prescribes, but in no case less than 60 days after that date.

Id. § 1071(a)(2). The U.S. Patent and Trademark Office has promulgated a regulation interpreting the latter statutory provision: “The notice of appeal . . . must be filed with the Director no later than sixty-three (63) days from the date of the final decision of the Trademark Trial and Appeal Board or the Director.” 37 C.F.R. § 2.145(d).

Connor argues that we do not have jurisdiction over Mr. Maksimuk’s appeal because it was not filed within the 63 days prescribed by regulation. More specifically, Connor argues that Mr. Maksimuk was 62 days late because his deadline to submit his appeal

to this court was August 24, 2018, but we did not receive it until October 25, 2018. But the statutory and regulatory provisions quoted above say nothing about when this court must receive the notice of appeal. Rather, the statute says that the appellant must file “a written notice of appeal directed to the Director” by the Director-set deadline. 15 U.S.C. § 1071(a)(2) (emphasis added). And the Director’s regulation repeats that the notice of appeal “must be filed with the Director” within 63 days. 37 C.F.R. § 2.145(d) (emphasis added). Because Mr. Maksimuk filed his notice of appeal only a couple of weeks after the Board issued its decision, he did what the relevant statutory and regulatory provisions require.

The Federal Rules of Appellate Procedure do not bar our review of Mr. Maksimuk’s appeal. The relevant rule states that “[r]eview of an agency order is commenced by filing, within the time prescribed by law, a petition for review with the clerk of a court of appeals authorized to review the agency order.” Fed. R. App. P. 15(a)(1) (emphasis added). But Connor points to no source of law, besides the already-discussed provisions, that prescribes such a time limit. We hold that we have jurisdiction to hear this appeal.³

³ Mr. Maksimuk appears to have violated this court’s own Rule 15(a)(1):

To appeal a decision of the . . . Trademark Trial and Appeal Board . . . under 15 U.S.C. § 1071(a), the appellant must file in the Patent and Trademark Office a notice of appeal within the time prescribed by law. Notwithstanding Rule 25(b)(1), the appellant must simultaneously send to the clerk of court one paper copy of the notice and pay the fee set forth in Federal Circuit Rule 52.

III

We turn now to the claim-preclusion issue. Claim preclusion, historically known as *res judicata*, prevents a party from litigating a matter that should have been litigated in an earlier proceeding. *See generally* 18 Charles Alan Wright et al., Federal Practice and Procedure § 4402 (3d ed. 2018). Claim preclusion applies when three elements are met: “(1) there is identity of parties (or their privies); (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.” *Nasalok Coating Corp. v. Nylok Corp.*, 522 F.3d 1320, 1324 (Fed. Cir. 2008) (quoting *Jet, Inc. v. Sewage Aeration Systems*, 223 F.3d 1360, 1362 (Fed. Cir. 2000)). When wielded against the defendant from the first action, claim preclusion applies “only if (1) the claim or defense asserted in the second action was a compulsory counterclaim that the defendant failed to assert in the first action, or (2) the claim or defense represents what is essentially a collateral attack on the first judgment.” *Id.* (citing *Baker v. Gold Seal Liquors, Inc.*, 417 U.S. 467, 469 n.1 (1974)). Claim preclusion can apply against the defendant even if the first judgment was a default judgment. *Id.* at 1329-30 (collecting cases). We review de novo the Board’s determination that claim preclusion bars Mr.

Fed. Cir. R. 15(a)(1) (emphasis added). But our rules are not jurisdictional. *Cf. Hamer v. Neighborhood Hous. Servs. of Chi.*, 138 S. Ct. 13, 20 n.9 (2017) (“In cases not involving the timebound transfer of adjudicatory authority from one Article III court to another, we have additionally applied a clear-statement rule: A rule is jurisdictional if the Legislature clearly states that a threshold limitation on a statute’s scope shall count as jurisdictional.” (emphasis added) (cleaned up)). In the circumstances in this case, we proceed to consider the correctness of the Board’s decision.

Maksimuk's cancellation petition and its grant of summary judgment on that basis. *See id.* at 1323.

We conclude that the Board did not err in determining that claim preclusion bars Mr. Maksimuk's cancellation petition. The Board rightly determined, on the facts here, that Mr. Maksimuk is in privity with CWF Flooring because he is its founder, owner, and CEO and he controlled the earlier district-court litigation. App. 12-13 (citing *Kreager v. Gen. Elec. Co.*, 497 F.2d 468, 472 (2d Cir. 1974)). The Board also correctly determined that there was an earlier final judgment on the merits of a claim, *i.e.*, the district court's default judgment. App. 14. And the Board properly concluded that the cancellation petition amounted to a collateral attack on the district court's judgment, which specifically stated that Connor's SPORT COURT mark is "distinctive and not generic." App. 15 (quoting App. 61). Therefore, we agree with the Board that the elements of claim preclusion are met here.

We see no special circumstances demanding a departure from the generally applicable standards of claim preclusion. Mr. Maksimuk argues that the Board's claim-preclusion analysis is flawed because he was denied due process during the district-court proceedings when he was not allowed to appear on CWF Flooring's behalf. But besides making unfounded accusations that the district court was biased against him, Mr. Maksimuk has not explained to us why he did not have an opportunity to raise his due-process concerns before the district court or the Tenth Circuit. Regardless, there is no due-process violation.

The federal courts have maintained for generations that corporations must be represented by counsel. *E.g.*,

Rowland v. Cal. Men's Colony, Unit II Men's Advisory Council, 506 U.S. 194, 201-02 (1993) (“It has been the law for the better part of two centuries . . . that a corporation may appear in the federal courts only through licensed counsel.” (citing *Osborn v. Bank of the United States*, 22 U.S. (9 Wheat.) 738, 829 (1824))); *Tal v. Hogan*, 453 F.3d 1244, 1254 & n.8 (10th Cir. 2006). Both the district court and the Tenth Circuit timely informed Mr. Maksimuk of the longstanding rule that corporations must be represented by counsel. App. 54-55, 57, 67-68. Mr. Maksimuk cannot complain that he was denied a full and fair opportunity to litigate his claim because of a technicality he did not know about. Accordingly, we discern no denial of due process in the district-court proceedings that would make claim preclusion inappropriate here.

IV

We have considered the parties' remaining arguments but find them unpersuasive. We therefore affirm the decision of the Trademark Trial and Appeal Board.

No costs.

AFFIRMED

**DECISION OF THE TRADEMARK
TRIAL AND APPEAL BOARD
(JUNE 22, 2018)**

UNITED STATES PATENT AND
TRADEMARK OFFICE
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451
General Contact Number: 571-272-8500

JAMES J. MAKSIMUK
(by correction from CWF Flooring, Inc.)

v.

CONNOR SPORT COURT INTERNATIONAL, LLC

Cancellation No. 92066311

Before: KUHLMKE, BERGSMAN and GOODMAN,
Administrative Trademark Judges.

By the Board:

On June 13, 2017, Petitioner filed a petition to cancel Respondent's Registration No. 2479328, issued August 21, 2001 (renewed), for the mark SPORT COURT in typed form for "plastic interlocking floor tiles" in International Class 21, on grounds that the mark is generic and, if not generic, then merely descriptive.¹ Because the petition to cancel was filed

¹ On May 22, 2017, Mr. Maksimuk also filed a petition to cancel Respondent's Registration Nos. 1100976 and 1155586. In a

more than five years after the issuance of the registration at issue, the ground that the mark is merely descriptive is unavailable. *See* Trademark Act Section 14(3), 15 U.S.C. § 1064(3). Accordingly, we treat the petition to cancel as seeking cancellation solely on the ground of genericness.

The following motions are pending herein: (1) Respondent's renewed motion (filed November 29, 2017) for summary judgment on the ground of *res judicata* based on previous litigation styled *Connor Sport Court Int'l, LLC, v. CWF Flooring, Inc.*, Case No. 2:17-cv-00042, filed in United States District Court for the District of Utah (10 TTABVUE);² (2) Petitioner's motion (filed December 10, 2017) to correct the caption of this proceeding (13 TTABVUE); and (3) Respondent's motion (filed March 2, 2018, 18 TTABVUE) to strike Petitioner's February 7, 2018 submission (17 TTABVUE) on the ground that it is an impermissible surreply in connection with the renewed motion for summary judgment.

June 6, 2017 order, the Board stated that the May 22 filing was not accompanied by the required filing fee and therefore would receive no consideration.

² Respondent filed a first motion for summary judgment on the ground of *res judicata* on October 17, 2017 (5 TTABVUE). The Board, in an October 25, 2017 order (6 TTABVUE), denied that motion without prejudice because it was based on an unpleaded defense. Respondent then filed a motion for leave to file an amended answer on October 30, 2017 (7 TTABVUE), which the Board granted as conceded in a November 28, 2017 order (9 TTABVUE).

I. Motion to strike denied

Trademark Rule 2.127(a) allows a nonmovant one brief in response to a motion. Trademark Rule 2.127 (e)(1) allows a nonmovant until thirty days from the date of service of the brief in support of the motion for summary judgment to file a brief in response thereto. Based on the foregoing, Petitioner was allowed until December 28, 2017 to file one brief in response to Respondent's renewed motion for summary judgment. After the November 29, 2017 filing of the renewed motion for summary judgment, the parties filed the following relevant documents herein:

- 13 TTABVUE: Petitioner's motion (filed December 10, 2017) to amend the caption of this proceeding;
- 14 TTABVUE: Petitioner's response (filed December 14, 2017) to the Board's December 8, 2017 suspension order (12 TTABVUE);
- 16 TTABVUE: Respondent's combined reply brief (filed February 2, 2018) in support of the motion for summary judgment and brief in response to the motion to amend the caption; and
- 17 TTABVUE: Petitioner's brief (filed February 7, 2018) in response to the renewed motion for summary judgment.

In a one-page response to the Board's December 8, 2017 suspension order (14 TTABVUE), Petitioner, in the context of seeking action on the motion to amend the caption, timely argued in opposition to the

motion for summary judgment,³ but did not otherwise respond to the motion.

The Board, in a January 13, 2018 order (15 TTABVUE), indicated that it would consider Petitioner's response to the suspension, notwithstanding the lack of proof of service thereof, and set time for remaining permissible briefing of the pending motions. Under Rule 2.127(a), Petitioner was limited to filing a reply brief in connection with the motion to amend the caption. Nonetheless, Petitioner filed a brief in response to the motion for summary judgment (17 TTABVUE), instead of a reply brief in support of the motion to amend the caption.

Because Petitioner's brief in response to the motion for summary judgment was filed more than thirty days after the service of the motion for summary judgment, that brief in response is untimely. Although the brief in response does not include a showing that Petitioner's failure to timely file it was caused by excusable neglect (see Fed. R. Civ. P. 6(b)(1)(b); *Pioneer Inv. Servs. Co. v. Brunswick Assocs. L.P.*, 507 U.S. 380 (1993); *Pumpkin, Ltd. v. Seed Corps*, 43 USPQ2d 1582 (TTAB 1997)), we elect to exercise our discretion to consider it. Based on the foregoing, the motion to strike is denied.

II. Motion to amend the caption

The ESTTA cover form for the petition to cancel identifies CWF Flooring, Inc. ("CWF") as Petitioner

³ In particular, Petitioner contends that *res judicata* is inapplicable because CWF Flooring and James J. Maksimuk are different entities.

(1 TTABVUE 1).⁴ Because the text of the petition to cancel states that “[t]he PETITIONER is James J. Maksimuk” (1 TTABVUE 2), Petitioner asks that the caption be corrected to identify Mr. Maksimuk as plaintiff.

In opposition, Respondent contends that the proposed correction is futile because correcting the caption will not prevent application of the doctrine of *res judicata* in this case because Mr. Maksimuk was in privity with CWF Flooring, Inc. when the district court entered its final judgment (16 TTABVUE 2-3).

When the plaintiff in a Board *inter partes* proceeding misidentifies itself in the complaint, if the plaintiff can establish to the Board’s satisfaction that this misidentification was merely a non-substantive mistake, the Board may allow amendment of the complaint, pursuant to Fed. R. Civ. P. 15(a), to correct the misidentification. *See Mason Eng. & Design Corp. v. Mateson Chem. Corp.*, 225 USPQ 956, 957 n.3 (TTAB 1985) (deeming pleadings amended to recite opposer’s correct name); TBMP § 512.04 (June 2017).

Whether this proceeding is barred by the doctrine of *res judicata* is not at issue in the motion to correct the caption of this proceeding. Because the text of the petition to cancel makes clear that Mr. Maksimuk is the intended Petitioner herein, we treat Petitioner’s identification of CWF Flooring, Inc. in the ESTTA cover form⁵ as a clerical error. Petitioner’s motion to

⁴ Petitioner submitted a filing fee for a single petitioner in a single class. *See* Trademark Rule 2.6(a)(16)(ii).

⁵ Contrary to Petitioner’s apparent belief, the Board does not enter information in ESTTA cover forms. The filing party enters that information.

correct the caption of this proceeding is therefore granted, and the caption of this proceeding is hereby amended to identify Mr. Maksimuk as petitioner and party plaintiff.

III. Motion for Summary Judgment Granted

Under the doctrine of *res judicata* (or claim preclusion), the entry of a final judgment “on the merits” of a claim (*i.e.*, cause of action) in a proceeding serves to preclude the relitigation 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 (1955); *Chromalloy Am. Corp. v. Kenneth Gordon, Ltd.*, 736 F.2d 694, 222 USPQ 187 (Fed. Cir. 1984); *Flowers Indus., Inc. v. Interstate Brands Corp.*, 5 USPQ2d 1580 (TTAB 1987). More specifically, in the circumstances presented by the case at hand, “[c]laim preclusion refers to the effect of a judgment in foreclosing litigation of a matter that never has been litigated, because of a determination that it should have been advanced in an earlier suit. Claim preclusion therefore encompasses the law of merger and bar.” *Migra v. Warren City School Dist. Bd. of Educ.*, 465 U.S. 75, 77 n.1 (1984); *Nasalok Coating Corp. v. Nylok Corp.*, 522 F.2d 1320, 86 USPQ2d 1369, 1371 (Fed. Cir. 2008).

Regarding whether the parties in this proceeding and the parties in the prior civil action are legally equivalent, we find initially that there is no genuine dispute that Respondent was the plaintiff in the earlier civil action and that Mr. Maksimuk was in privity with CWF when judgment was entered in the civil

action. The basis for applying preclusion against him herein rests on his being the founder (16 TTABVUE 7), “owner” (10 TTABVUE 42) and “CEO” (10 TTABVUE 46 and 56) of CWF, the defendant in the prior civil action. *See e.g., Kraeger v. General Electric Co.*, 497 F.2d 468, 472 (2d. Cir. 1974) (president and sole shareholder of a corporation bound by the corporation’s defeat in an action that he effectively controlled); *Vitronics Corp. v. Conceptronc, Inc.*, 27 USPQ2d 1046, 1049 (D.N.H. 1992) (founder and CEO of corporation in privity with corporation); *John W. Carson Foundation v. Toilets.com Inc.*, 94 USPQ2d 1942, 1947 (TTAB 2010) (president and sole owner of corporation in privity with corporation).

Section 39 of the Restatement (Second) of Judgments (1982) states the applicable black-letter law: “A person who is not a party of an action but who controls or substantially participates in the control of the presentation on behalf of a party is bound by the determination of issues decided as though he were a party.” *See also* 18A C. Wright, A. Miller & E. Cooper, Fed. Prac. & Proc. Juris. § 4451 (April 2018 update). The record herein indicates that Mr. Maksimuk fully controlled CWF’s case in the civil action⁶ by

⁶ The Board notes the following procedural history in the civil action:

- Following receipt of the service copy of the complaint in the civil action (10 TTABVUE 14-33), Mr. Maksimuk, appearing *pro se* on behalf of CWF, sent an email on April 27, 2017 to the magistrate judge in the United States District Court for the District of Utah in which CWF requested an extension of time to answer (10 TTABVUE 35-36).

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- Mr. Maksimuk, however, was informed in an April 27, 2017 response from the magistrate judge's law clerk that any such request must be in the form of a motion filed on the docket by an attorney (10 TTABVUE 35).
 - In a June 6, 2017 notice from the district court, CWF and Petitioner were advised that CWF, as a corporation, "cannot appear except through counsel" and that Mr. Maksimuk was "previously notified by Magistrate Judge Paul M. Warner to that effect. Absent proper appearance through counsel, the court cannot deal with the Motion for Stay of Proceedings, forwarded to chambers via e-mail from James Maksimuk on June 6, 2017." (10 TTABVUE 38).
 - After CWF failed to retain an attorney to represent it in the civil action in accordance with the district court's local rules and failed to file an answer or other response to the complaint, the district court entered default judgment against CWF in an August 10, 2017 decision (10 TTABVUE 41-44, 17 TTABVUE 14-17). In that decision, CWF

was permanently enjoined from using the plasticsportcourttiles.com domain name in connection with the marketing or sale of flooring products and services, including redirecting visitors from plasticsportcourttiles.com to other internet domains having websites marketing or selling flooring products or services . . . [and] from using an internet domain name containing the term 'sport court,' 'sports court,' 'sport courts,' or any variation thereof in connection with the marketing or sale of flooring products and services, including redirecting visitors from such a domain to other internet domains having websites marketing or selling flooring products or services.

(10 TTABVUE 43).

Mr. Maksimuk, again appearing *pro se* on behalf of CWF, appealed that default judgment to the United States Court of Appeals for the Tenth Circuit, but that appeal was dismissed on October 12,

attempting to represent CWF *pro se* therein in contravention of local rules. In view thereof, we find that there is no genuine dispute that privity exists between Mr. Maksimuk, Petitioner in this proceeding, and CWF, the defendant in the prior civil action, for *res judicata* purposes. Accordingly, there is no genuine dispute that the parties in this case and the civil action are legal equivalents.

Further, there is no genuine dispute of material fact that there was a final judgment on the merits of a claim in the civil action. The United States District Court for the District of Utah entered default judgment in the civil action after CWF refused to hire an attorney. In its decision entering such judgment, the district court found that “the Sport Court marks [including Respondent’s involved Registration No. 2479328] are distinctive and not generic” and that CWF’s use of the domain plasticsportcourttiles.com infringed Respondent’s SPORT COURT marks (10 TTABVUE 42-43). Further, the United States Court of Appeals for the Tenth Circuit dismissed CWF’s appeal of that default judgment after CWF failed to hire an attorney to appear on its behalf. Although Petitioner asserts in his brief in response to the motion for summary judgment that he intends to file a petition for writ of certiorari with the Supreme Court in this case (17 TTABVUE 5), his time for so filing had lapsed by the time he filed the brief in response. *See* Sup Ct. R. 13.1 (a petition for writ of certiorari is timely when it is filed within 90 days after entry of a judgment by a United States Court of Appeals). The record herein does not indicate that any such petition was filed.

2017, after CWF failed to retain an attorney to represent it in that appeal (10 TTABVUE 54).

We now consider whether the cancellation proceeding is based on the same set of transactional facts as the civil action. Where, as in this case, a party seeks to preclude a defendant in the first action from bringing certain claims as plaintiff in a second action, the rules of defendant preclusion apply. *See Nasalok Coating Corp. v. Nylok Corp.*, 522 F.3d 1320, 86 USPQ2d 1369, 1372 (Fed. Cir. 2008). A defendant in the first action is precluded from bringing such claims in a subsequent proceeding only if: (1) the claim or defense asserted in the second action was a compulsory counterclaim that the defendant failed to assert in the first action; or (2) the claim or defense represents what is essentially a collateral attack on the first judgment. *Id.*

Regarding the first basis for applying defendant claim preclusion, Trademark Act Section 37, 15 U.S.C. § 1119, allows a trademark infringement defendant to assert a counterclaim to cancel the registration. However, our primary reviewing court has determined that a claim that a trademark registration is invalid is not a compulsory counterclaim to a claim of trademark infringement brought in a federal district court.⁷ *See id.*, 86 USPQ2d at 1373.

We turn then to the second basis for applying claim preclusion against defendants—where the effect of the later action is to collaterally attack the judgment

⁷ By contrast, in Board opposition and cancellation proceedings, a defense attacking the validity of a registration pleaded in a cancellation action is a compulsory counterclaim if grounds for the counterclaim existed at the time when the answer is filed or are learned during the course of the proceedings. *See* Trademark Rules 2.106(b)(3) and 2.114(b)(3); *Jive Software, Inc. v. Jive Commc'ns, Inc.*, 125 USPQ2d 1175, 1177 (TTAB 2017).

of the first action. Here, the district court's default judgment in the infringement action included the determination that Respondent's "Sport Court Marks are distinctive and not generic." 10 TTABVUE 41-42. Allowing Petitioner to challenge the validity of the involved registration for the mark SPORT COURT for "plastic interlocking floor tiles" upon which the prior judgment was based on the ground of genericness would allow Petitioner to collaterally attack the judgment of the first action.

Further, Section 18(2) of the Restatement (Second) of Judgments makes clear that a defense that could have been interposed cannot later be used to attack the judgment of the first action. Although Petitioner contends that he was denied due process because he was not allowed to participate in the civil action, the record clearly indicates that the default judgment was entered by the district court and the appeal was dismissed by the court of appeals as a direct result of CWF's refusal to hire an attorney despite multiple warnings from the district court and the court of appeals. CWF and Mr. Maksimuk were repeatedly advised by the district court of the requirement that CWF hire an attorney in the civil action (10 TTABVUE 35, 38, and 42; 17 TTABVUE 14-17). Likewise, CWF and Mr. Maksimuk were repeatedly advised that CWF must be represented by an attorney in CWF's appeal before the United States Court of Appeals for the Tenth Circuit (10 TTABVUE 48, 51-52 and 54). *See Tal v. Hogan*, 453 F.3d 1244, 1254 (10th Cir. 2006) ("It has been our longstanding rule that a corporation must be represented by an attorney to appear in federal court."). Notwithstanding this repeated advice, CWF chose not to hire an attorney in the civil action and

was thus not permitted to file submissions or appear in court therein.

Bearing in mind that the petition to cancel was filed on June 13, 2017, after entry of default and prior to entry of default judgment in the civil action,⁸ there is no genuine dispute that the allegations set forth in the petition to cancel existed at the time of the civil action and could have been—and should have been—raised as a counterclaim in the civil action. *See Urock Network, LLC v. Sulpasso*, 115 USPQ2d 1409, 1412 (TTAB 2015). In sum, there is no genuine dispute of material fact that the requisite elements of *res judicata* have been satisfied.

Based on the foregoing, Respondent's motion for summary judgment is hereby granted. The petition to cancel is dismissed with prejudice.

⁸ Filing the petition to cancel instead of pursuing the counterclaim in the civil action was essentially an attempt to raise that claim in a forum where Petitioner could appear without an attorney.

**ORDER OF THE TENTH CIRCUIT
(AUGUST 22, 2017)**

UNITED STATES COURT OF APPEALS
FOR THE TENTH CIRCUIT

CONNOR SPORT COURT INTERNATIONAL, LLC,
a Delaware limited liability company,

Plaintiff-Appellee,

v.

CWF FLOORING, INC., d/b/a
plasticsportcourttiles.com, d/b/a sporttiles.pro, a
California corporation,

Defendant-Appellant.

No. 17-4130

This matter is before the court sua sponte upon review of the district court docket. Corporate entities may not appear pro se in this court and must be represented by counsel. *Tal v. Hogan*, 453 F.3d 1244, 1254 (10th Cir. 2006). Because Appellant CWF Flooring, Inc. does not have counsel at this time, proceedings in this appeal are ABATED.

Within 21 days from the date of this order, an attorney must file an entry of appearance on behalf of Appellant, along with a motion to lift the abatement. The appeal will be dismissed for failure to prosecute if an entry of appearance and motion to lift the abate-

ment are not filed by the deadline. *See* 10th Cir. R. 42.1.

Unless and until an entry of appearance has been filed on behalf of Appellant, any filings shall be served on CWF Flooring, Inc. at the following address:

CWF Flooring, Inc.
c/o James J. Maksimuk, CEO
38325 6th Street East
Palmdale, CA 93550

Entered for the Court

/s/ Elisabeth A. Shumaker
Clerk

by: Lindy Lucero Schaible
Counsel to the Clerk

**DEFAULT JUDGMENT
(AUGUST 10, 2017)**

IN THE UNITED STATES DISTRICT COURT FOR
THE DISTRICT OF UTAH, CENTRAL DIVISION

CONNOR SPORT COURT INTERNATIONAL, LLC,
a Delaware limited liability company,

Plaintiffs,

v.

CWF FLOORING, INC., d/b/a
plasticsportcourttiles.com, d/b/a sporttiles.pro, a
California corporation,

Defendant.

Case No. 2:17-cv-00042-BSJ

Before: Bruce S. Jenkins,
United States District Judge

This matter comes before the Court on Plaintiff Connor Sport Court International, LLC's ("CSCI") Motion for Entry of Default Judgment against Defendant CWF Flooring, Inc. d/b/a plasticsportcourt tiles.com d/b/a sporttiles.pro ("CWF") under Federal Rule of Civil Procedure 55(b)(2). After considering the arguments and authorities submitted by the Plaintiff, the Court finds as follows:

1. The Complaint, including attachments, and an original summons were properly served on CWF on February 9, 2017.

2. This Court has personal jurisdiction over CWF and subject matter jurisdiction over the matters in controversy between CSCI and CWF. Venue in this judicial district is proper.

3. CSCI manufactures and sells flooring products and flooring installation services. CSCI owns several trademarks in connection with its products and services, all of which are valid, subsisting, and incontestable pursuant to 15 U.S.C. § 1065 (collectively, the "Sport Court Marks"):

Registration No.	Registration Date	Trademark
1,100,976	August 29, 1978	SPORT COURT
1,155,586	May 26, 1981	SPORT COURT
1,727,818	November 10, 1981	SPORT COURT
1,177,220	October 27, 1992	SPORT COURT
2,479,328	May 29, 2001	SPORT COURT

4. The Sport Court Marks are distinctive and not generic.

5. CWF markets and sells flooring for residential and commercial use and is a direct competitor to CSCI.

6. CWF owns and maintains the domain plastic sportcourttiles.com, which redirects internet users to

CWF's commercial web site selling flooring products at sporttiles.pro.

7. On April 27, 2017, in response to CWF's owner—who is not an attorney—asking for additional time to respond to the Complaint, the magistrate judge informed CWF that the company cannot proceed pro se and needed to be represented by an attorney in this case.

8. On May 18, 2017, entry of default was recorded against CWF due to its failure to answer or otherwise respond to the Complaint.

9. On June 6, 2017, in response to a motion to stay proceedings submitted by CWF's owner, the Court informed CWF that the company cannot appear except through counsel.

10. On June 22, 2017, during a hearing on CSCI's Motion for Entry of Default Judgment, the Court informed CWF's owner that the company needed to be represented by an attorney and gave CWF until July 25, 2017 to find local counsel.

11. As of August 4, 2017, CWF has not retained an attorney to represent it in this case in accordance with the local rules for the United States District Court for the District of Utah, nor has it answered or otherwise responded to the Complaint.

12. As stated on the record by counsel for Plaintiff, all other forms of relief in the way of damages are withdrawn.

Therefore, it is ADJUDGED that:

CWF's actions infringe CSCI's Sport Court Marks in violation of 15 U.S.C. § 1114 because the plastic

sportcourttiles.com domain is confusingly similar to the SPORT COURT marks.

CWF's actions infringe CSCI's common law trademark rights in the Sport Court Marks in violation of 15 U.S.C. § 1125 because the plasticsportcourttiles.com domain is confusingly similar to the SPORT COURT marks.

Furthermore, it is ORDERED that:

CWF is hereby permanently enjoined from using the plasticsportcourttiles.com domain name in connection with the marketing or sale of flooring products and services, including redirecting visitors from plasticsportcourttiles.com to other internet domains having websites marketing or selling flooring products or services.

CWF is hereby permanently enjoined from using an internet domain name containing the terms "sport court," "sports court," "sport courts," or any variation thereof in connection with the marketing or sale of flooring products and services, including redirecting visitors from such a domain to other internet domains having websites marketing or selling flooring products or services.

CSCI shall file a bill of costs and a motion for attorney's fees in accordance with DUCivR 54-2.

The Court shall retain jurisdiction of this matter for purposes of the interpretation, amendment, or enforcement.

/s/ Honorable Bruce S. Jenkins
United States District Judge

Dated: August 10th, 2017

**ORDER OF THE FEDERAL CIRCUIT
DENYING PETITION FOR REHEARING
(JULY 15, 2019)**

UNITED STATES COURT OF APPEALS
FOR THE FEDERAL CIRCUIT

JAMES J. MAKSIMUK,

Appellant,

v.

CONNOR SPORT COURT INTERNATIONAL, LLC,

Appellee.

2019-1156

Appeal from the United States Patent and
Trademark Office, Trademark Trial and Appeal
Board in No. 92066311

Before: PROST, Chief Judge, NEWMAN, LOURIE,
DYK, MOORE, O'MALLEY, REYNA, WALLACH,
TARANTO, CHEN, HUGHES, and STOLL,
Circuit Judges.

PER CURIAM

Appellant James J. Maksimuk filed a petition for rehearing en banc. The petition was first referred as a petition for rehearing to the panel that heard the appeal, and thereafter the petition for rehearing

en Banc was referred to the circuit judges who are in regular active service.

Upon consideration thereof,

IT IS ORDERED THAT:

The petition for panel rehearing is denied.

The petition for rehearing en Banc is denied.

The mandate of the court will issue on July 22, 2019.

FOR THE COURT

/s/ Peter R. Marksteiner
Clerk of Court

July 15, 2019
Date