

**THIS OPINION IS NOT A  
PRECEDENT OF THE TTAB**

Mailed:  
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Bucher

UNITED STATES PATENT AND TRADEMARK OFFICE

**Trademark Trial and Appeal Board**

Nitelife of Santa Barbara

v.

Nite Life Car Club Association

Opposition No. 91188462  
against Serial No. 78864321

Victoria Carver of Carver Law for Nitelife of Santa Barbara.

W. Douglas English, III, of English & Associates for Nite  
Life Car Club Association.

Before Bucher, Cataldo and Wolfson, Administrative Trademark  
Judges.

Opinion by Bucher, Administrative Trademark Judge:

Nite Life Car Club Association seeks registration on  
the Principal Register of the following mark:



for goods identified as "blazers; denim jackets; fur coats and jackets; fur hats; hat bands; hats; jackets; leather jackets; light-reflecting jackets; t-shirts"<sup>1</sup> in International Class 25.

Registration has been opposed by Nitelife of Santa Barbara. Opposer claims to own common law rights in the mark "NITE LIFE SANTA BARBARA and design" that it described in its Notice of Opposition as follows: The mark consists of the words NITE LIFE: "'NITE' has a dagger through it from left to right and 'LIFE' has a dagger through it from right to left. The two daggers meet in the middle, below the words, at a rose."<sup>2</sup> As its grounds for opposition, opposer asserts that: (1) applicant is not the exclusive owner of the mark; (2) applicant's mark is identical to opposer's established common law trademark and is likely to cause confusion among consumers; (3) applicant has not used and does not use the mark for the goods claimed in its application; (4) applicant did not use the mark on the dates as claimed in its application; and (5) the

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<sup>1</sup> Application Serial No. 78864321 was filed on April 18, 2006 based upon claims of first use anywhere and first use in commerce at least as early as October 1, 1980.

<sup>2</sup> While opposer calls its common law mark the "NITE LIFE SANTA BARBARA and design" mark, and it notes later in the description that it "consists of the words NITE LIFE ...," it does not again mention the words SANTA BARBARA as being part of the composite.

application was fraudulent because of applicant's intentional material misstatements.

In addition to the pleadings and the file of the involved application, the record also includes materials that opposer placed into the record via Notices of Reliance of December 21 and December 26, 2009, namely applicant's responses to opposer's interrogatories and request for documents. Only opposer filed a brief.

Opposer, Nitelife of Santa Barbara, is an unincorporated association formed in Santa Barbara, CA in 1980 by approximately twelve persons. It is made up of low-rider and antique automobile enthusiasts who sponsor car shows and dances - often raising funds through such events for other community organizations such as La Casa de la Raza and youth sports associations. A flyer promoting an event on February 13, 1980, reflects the first use of the "Nite Life" mark contained in the record. The mark is the words "Nite Life Car Club" in obviously hand-drawn, calligraphic lettering:

Nite Life Car Club

The "crossed daggers under a red rose" logo (shown below) was approved by the founding members and made its first appearance during the year 1980. This design was contributed by one Jamie Maldonado, but was allegedly drawn by his former girlfriend (unnamed in the record), then an art student at the University of California at Santa Barbara (UCSB).



For later events (e.g., in 1983), flyers again showed hand-drawn versions of the name for the Nite Life Car Club of Santa Barbara:



From 1980 to the present, there are numerous articles in the record discussing community events sponsored by Nitelife (or Nite Life) of Santa Barbara, usually having

pictures of tricked-out low-rider or antique cars.<sup>3</sup> The record has copies of these articles, along with interesting pictures, in a variety of magazines such as Santa Barbara, Impalas, Lowrider, Streetlow, Blvd., and Street Customs.

In addition to different fonts and presentation styles, "Nite Life" versus "Nitelife," etc., the actual name of the organization changed in a variety of ways, including the occasional misspelling on the club's own flyers:



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<sup>3</sup> Some of the earliest press clippings are from spring 1982: "The [Low Rider Car Show] event was sponsored by the Nitelife Car Club ..." *Santa Barbara News Press*, May 16, 1982; "This past Saturday, May 8, witnessed the first annual Low Riders Show at the Eastside Library Parking lot presented by the Santa Barbara Public Library and the Nitelife Car Club of S.B. ..." *Santa Barbara News and Review*, May 16, 1982; Letter of May 17, 1982, from the Mayor of Santa Barbara, addressed to Larry Rosas, Jr. c/o the Nite Life Car Club of Santa Barbara, thanking the club for helping to make the Bicentennial Parade such a great event.

In fact, in applicant's amended answer of December 2, 2009, to opposer's amended notice of opposition in the current proceeding, applicant notes that the evidence of record shows that both parties have used the mark "in a variety of forms." Those listed for opposer include all of the following, both with and without the crossed daggers imagery: **NITELIFE, NITE LIFE, NITELIFE CAR CLUB, NITELIFE SANTA BARBARA, NITE LIFE SANTA BARBARA, NITE LIFE SANTA BARBARA CAR CLUB, NITE LIFE OF SANTA BARBARA, NITE LIFE CAR CLUB OF SANTA BARBARA, NITE LIFE CAR CLUB ASSOCIATION, NITE LIFE CAR CLUB,** and as seen above, **NIGHTLIFE CAR CLUB.** In its answer to the Notice of Opposition, applicant admits that applicant and opposer were the same party in the 1980's and 1990's (§ 1) and that applicant's mark incorporates a design that is identical to the design in opposer's mark (§ 8).

Of the original group of twelve individuals who formed Nitelife of Santa Barbara, at least two persons -- Frank Favela and Augie Trejo -- remain a part of the Santa Barbara group to the present. This group, according to applicant, may now have dwindled to four or fewer active members. Among the founding members was one Edmundo "Mundo" Rosas who resides in Ventura. According to an invoice in the record, Edmundo Rosas got a jacket personalized for himself at

A.T.Z. Monogramming on March 16, 1982, having the Nitelife logo on the back of the jacket and his specific information on the front, namely, fourteen letters spelling out "66 Chevy" and "Edmundo." The record also shows a plaque of appreciation given to Lorenzo Rosas, Sr., from the "Nite Life Car Club" on February 12, 1983. The totality of the record supports a finding that opposer operated consistently as Nitelife (or Nite Life) of Santa Barbara through the time that the record closed in this case.

By late-2003, Mr. Rosas decided to continue club meetings down in Ventura with fellow Santa Barbara club members living in Ventura County. According to applicant's initial answer, "[s]aid members did not 'resign' from the original group formed in Santa Barbara. The Santa Barbara Group continued to use Nitelife Santa Barbara with the crossed dagger design, and the Ventura Group used the very similar Nite Life Ventura with the identical crossed dagger design." Answer, ¶ 3.

Applicant, Nite Life Car Club of Ventura County, like Nitelife of Santa Barbara, is an unincorporated association. However, the entity did receive an Employee Identification Number (EIN) from the Internal Revenue Service (IRS) on January 22, 2004. On May 7, 2004, Edmundo Rosas was issued a fictitious business name statement from

the Ventura County Clerk, on which Mr. Rosas had listed trade names for "Nite Life Car Club Ventura County"<sup>4</sup> and "Night Life." The record also contains a "Seller's Permit" issued by the Sales and Use Tax Department of the California State Board of Equalization dated September 4, 2004. These documents were all mailed "c/o Edmundo Rosas."

Substantially all of the events referring to Nitelife Car Club of Ventura have taken place since 2004.<sup>5</sup> Flyers from 2004 to 2009 (when the record closed in this case) reflect the following presentations:

**NITE LIFE VENTURA**



**NITE LIFE VENTURA COUNTY**

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<sup>4</sup> Opposer notes, significantly, that this is different from the name of applicant in this trademark application, namely, "Nite Life Car Club Association."

<sup>5</sup> An article allegedly appearing in the December 1984 edition of Lowrider magazine entitled "Evening in the Mix" did mention "The City Life Car Club of Ventura County." However, this seems to be an aberrant reference not confirmed by other documentary evidence in the record. Otherwise, the record shows the Ventura group having events of April 11, 2004 (Easter Fiesta); October 2, 2004 (La Casa de la Raza Car Show and Dance); March 23, 2005, (Easter Bash #2); August 13, 2005 (Cancer Society and La Casa de la Raza); April 16, 2006 (3<sup>rd</sup> Annual Easter Bash); September 30, 2007 (Autumn Fest); November 11, 2007 (support for toy drive of Infinite Car Club, Oxnard); December 2, 2007 (Knights of Columbus Christmas party, Feed the Need, Show and Shine); May 24, 2008 (cancer victim fund-raiser); June 14, 2008 (5<sup>th</sup> Annual Bash); and April 12, 2009 (6<sup>th</sup> Annual Easter Bash).



The instant opposition is not the first litigation before the United States Patent and Trademark Office undertaken by these competing interests.

One Daniel R. ("Danny") Trejo (not the Hollywood actor!), who applicant claims joined opposer's association as late as 1987, applied on November 12, 2003, for the Nitelife of Santa Barbara logo [reflecting the common law mark



described in the current opposition] in his own name - not that of the Santa Barbara association.<sup>6</sup> That earlier opposition<sup>7</sup> was brought by Edmund Rosas, an individual, d.b.a. "Nite Life Ventura, d.b.a. Nite Life Car Club Association." When Mr. Trejo failed to file an answer to the opposition, Mr. Rosas prevailed based upon a default judgment against Mr. Trejo.

In another earlier proceeding involving these competing parties, applicant (i.e., the Ventura group who is also applicant herein) filed its Intent to Use application Serial

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<sup>6</sup> Application Serial No. 76559200 for "social clubs for low-rider and automobile enthusiasts" in International Class 45. No claim is made to the exclusive right to use the words "Santa Barbara" apart from the mark as shown.

<sup>7</sup> Although Opposition No. 91165738 was timely filed against Serial No. 76559200, the Office had to cancel an inadvertently issued Registration No. 2918594.

Number 78344503 for **NITE LIFE** on December 22, 2003.<sup>8</sup> The goods were identified as "clothing *sold only by the applicant's association*, namely, coats, jackets, T-shirts, blazers, and hats," in International Class 25. The current opposer (i.e., the Santa Barbara group) also opposed the '503 application in Opp. No. 91166528, in a proceeding entitled "Nite Life of Santa Barbara v. Nite Life Car Club Association." This time, judgment was entered against the current opposer (i.e., the Santa Barbara group) for failing to prosecute. Applicant then submitted the following specimen with its

statement of use on March 30, 2007, claiming first use anywhere and first use in commerce at least as



early as October 1, 1980. This resulted in Registration No. 3415520 being issued to Nite Life Car Club Association on April 22, 2008.

As noted above, opposer's amended pleadings herein contain five alternative grounds for refusing applicant registration: (1) applicant is not the exclusive owner of

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<sup>8</sup> Perhaps not coincidentally, this was just weeks after Danny Trejo filed for the Nitelife of Santa Barbara logo.

the alleged mark; (2) opposer has priority of use and there is a likelihood of confusion; (3) applicant has not, and still does not, use the applied-for mark for the identified goods; (4) applicant did not use the mark on the dates as claimed in the application; and (5) the application was fraudulent because of applicant's intentional material misstatements.

This case has similarities to earlier Board cases involving naming disputes among feuding members of family businesses, aging pop bands or religious organizations riven by theological schisms. The common factor in such disputes has involved two different factions fighting over a single, long-shared mark. In this case, it is two very loosely-affiliated associations in neighboring towns in the Central Valley of coastal California, each made up of a mere handful of low-riders. The marks in contention include the words "Nite Life"/"Nitelife" and/or an identical design of two daggers and a rose. The issue before us is who is identified by this mark - or perhaps, "these marks" - and hence, whether the Ventura group is actually the rightful owner of the applied-for trademark.

Arguably, this determination is made more difficult because of the contradictory positions taken by applicant. When comparing the pleadings among the various

proceedings in which applicant has appeared before the Board (as plaintiff or defendant), applicant is certainly not a paragon of consistency. For example, while ¶ 3 of applicant's initial answer herein said that the Ventura group's "members did not 'resign' from the original group formed in Santa Barbara," in Opposition No. 91165738 applicant (as opposer in that proceeding) refers to itself as consisting of "former members" of the Santa Barbara club represented by opposer herein.<sup>9</sup> Significantly, while no one alleges that there was a Nite Life Car Club in Ventura in the early 1980's, applicant readily claims it has used the mark since 1980.

Weighing the evidence as a whole, it seems clear that opposer was the unincorporated association that first used the mark in Santa Barbara in 1980, and has used it continuously since then. The record confirms that it was not until 2003-2004 that Edmundo Rosas made overt efforts to create the separate entity that is now applicant, and to seek trademark protection for the new Ventura club. That these small, loose associations of individuals remain unincorporated encourages some fudging of the facts. Mr.

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<sup>9</sup> ¶ 3 of the Notice of Opposition in Opp. No. 91165738 says: "Opposer, Nite Life Ventura, is an association made up of former members of Nite Life Santa Barbara, an association located in Santa Barbara, which began as early as 1980."

Rosas, on behalf of applicant, claims usage back to 1980 through the Santa Barbara group, while admitting elsewhere that applicant represents a splintering of that original Santa Barbara group.

After filing a timely opposition in September 2005 against applicant's **NITE LIFE** mark, opposer's failure to follow through with the prosecution of that action means that applicant is the owner of a registration for the term **NITE LIFE** for "clothing sold only by the applicant's association, namely, coats, jackets, T-shirts, blazers, and hats," in International Class 25. In the absence of any cancellation proceeding against this extant registration, we must accord this applicant (the Ventura group) *qua* registrant all the presumptions of Section 7 of the Lanham Act. While the parties did not raise this issue, for the sake of completeness, we consider whether the existence of this registration bars opposer from pursuing this opposition. We hold that it does not. Although this prior registration may be viewed as injurious to opposer, the *Morehouse* doctrine<sup>10</sup> applies only if the two marks are

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<sup>10</sup> The *Morehouse* doctrine holds that opposer cannot be damaged within the meaning of Section 13 of the Trademark Act, by the issuance to applicant of a second registration, when applicant already has an existing, unchallenged registration of the same mark for the same goods and/or services. See *Morehouse Mfg. Corp. v. J. Strickland & Co.*, 407 F.2d 881, 160 USPQ 715 (CCPA

"substantially identical." Furthermore, in addition to the fact that the doctrine does not extend to different marks, the protected claim is limited to the clothing items listed in the registration (e.g., coats, jackets, T-shirts, blazers, and hats), not to any other clothing items that may possibly fall into a zone of expansion. Finally, given the wording of the identification of goods in the registration, applicant's protected claim is only these five items when sold through the narrow trade channels of applicant's members. Hence, the existence of this earlier registration does not bar the current proceeding. The involved application is for a composite mark that includes the "crossed daggers under a red rose" imagery as well as additional items of clothing moving in an unrestricted marketplace.

The trial phase of this proceeding represents the first time that applicant's claims of use on any clothing items, sold at any point in time and moving through any channels of trade, have been tested on the merits through *inter partes* litigation. Opposer takes the position that applicant has appropriated and used the "Nite Life"

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1969); *O-M Bread, Inc. v. U.S. Olympic Comm'n*, 65 F.3d 933, 36 USPQ2d 1041, 1045 (Fed. Cir. 1995); and TBMP §311.02(b) (2d ed. rev. 2004).

designation as a trade name, and has used applicant's claimed Ventura County logo as a service mark, but that applicant has failed to provide for the record any evidence of use with clothing. While the application file shows applicant's applied-for mark on jackets, caps and accompanying hangtags, applicant has allegedly failed to provide any more evidence of its sales of clothing items despite opposer's repeated requests for the production of such evidence, and interrogatory requests designed to lead to invoices, sales records and other such documentation. At best, opposer argues that a single, undated photograph of applicant's applied-for mark emblazoned across a t-shirt cannot meet the statutory definition of use in commerce. We agree. Other than the application specimens, the record contains no documentary evidence of applicant's *bona fide* use of the mark on clothing items in International Class 25. Moreover, in reviewing applicant's responses to opposer's discovery requests, this Board found itself as annoyed as was opposer with circuitous, run-on sentences of meaningless but turgid prose mashed into long, non-responsive answers. It seems to be more of a litigation strategy for a party wanting to obscure the merits of opposer's case rather than provide proper responses to the discovery to which opposer was entitled.

We find that traditional concepts of priority, likelihood of confusion, first use dates, implied contracts, uncontrolled licensing, abandonment of the mark, etc., are of little help in resolving this dispute. Applicant's claiming 1980 as its first date of use of the applied-for mark is a literal impossibility. As documented in this record, applicant's uses of the words NITELIFE and the crossed dagger logo a score of years later (and an equal number of years after opposer's adoption) should not in any way create for applicant its own mark with its own first use date, i.e., ownership of this substantially identical source indicator. We find, on this record, as a matter of trademark law, that opposer, Nitelife of Santa Barbara, is the owner of, at the very least,<sup>11</sup> the crossed dagger logo -- irrespective of applicant's irrelevant charge that opposer cannot produce a copyright from the artist. Despite the fact that the Santa Barbara group adopted its mark in 1980 and has demonstrated continuous use since then, Edmundo Rosas has set up "Nite Life Car Club Ventura County" and litigates

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<sup>11</sup> As noted above, we are constrained by the presumptions afforded applicant under Section 7 of the Lanham Act in holding that opposer holds exclusive trademark rights to the words "Nite Life."



to wrest opposer's ownership right away from the Santa Barbara group -- a group that has been decidedly less successful than the Ventura group in recent litigation before this tribunal.

In some filings herein, Mr. Rosas and his group seem to suggest that the Santa Barbara and Ventura groups are co-owners of these trademarks and service marks. Under this theory of ownership, Mr. Rosas apparently has concluded that the parties, together, could grow the organization by searching out more NITELIFE chapters across Central California, if not throughout the rest of these United States. However, when not arguing for a "live-and-let-live" attitude toward opposer, Mr. Rosas and his counsel have the temerity to claim exclusive use for the new Ventura group over these disputed marks, while denying such rights for their former compatriots in the Santa Barbara group.

In conclusion, we find that applicant is not the exclusive owner of the crossed dagger logo; that there is little credible evidence applicant ever used the applied-for mark for the identified goods; and that applicant could not possibly have used its applied for mark as early as 1980. We do not reach the questions of priority/likelihood of confusion or whether applicant has intentionally offered material misrepresentations in its

dealing with the United States Patent and Trademark  
Office or this Board.

*Decision:* For the reasons stated above, the opposition  
is hereby sustained, and registration to applicant is  
refused.