

THIS OPINION IS NOT A
PRECEDENT OF THE TTAB

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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Brody Chemical Company Inc.
v.
Tammy L. Goldthorpe f/k/a Tammy Price

Opposition No. 91204070
to Application Serial No. 85099334

David G. Bray of Dickinson Wright/Mariscal Weeks for Brody Chemical Company, Inc.

Nathan S. Winesett of Avery, Whigham & Winesett, P.A. for Tammy L. Goldthorpe f/k/a Tammy Price.

Before Quinn, Kuhlke and Taylor, Administrative Trademark Judges.

Opinion by Kuhlke, Administrative Trademark Judge:

Applicant, Tammy L. Goldthorpe f/k/a Tammy Price (hereinafter Applicant or Tammy Goldthorpe), seeks registration of the standard character mark SLIPPERY WIZARD (SLIPPERY disclaimed) for goods identified as “asphalt release agent,” in International Class 1 on the Principal Register.¹

¹ Serial No. 85099334, filed on August 3, 2010, based on allegations of first use and use in commerce on October 1, 2004 under Section 1(a) of the Trademark Act, 15 U.S.C. § 1051(a).

Opposer, Brody Chemical Company, Inc. (hereinafter Opposer or Brody Chemical), has opposed registration of Applicant's mark on the ground that Opposer, not Applicant, is the owner of the SLIPPERY WIZARD mark. See Section 1 of the Lanham Act, 15 U.S.C. § 1051 (emphasis added) ("The *owner* of a trademark used in commerce may request registration of its trademark... .") Applicant denied the salient allegations and asserted the affirmative defenses of (1) estoppel, based on the allegations that "Applicant reasonably and detrimentally relied upon the express and implied acts, deeds, representations, and promises of Opposer that induced Applicant to disclose proprietary trade secrets and the use and marketing of Applicant's SLIPPERY WIZARD mark and product" and (2) unclean hands, based on the allegations that "Opposer has willfully and fraudulently asserted that it adopted the SLIPPERY WIZARD mark and that it owns the mark in order to cease paying Licensor its rightful royalties ... [and] Opposer has acted unethically and in bad faith in an effort to fraudulently misappropriate Applicant's trade secrets and trademark rights."² Answer Second and Third Defenses.

² Applicant's first "affirmative defense" consists of allegations regarding her ownership of prior registrations for the marks CLEAR WIZARD and WHITE WIZARD for asphalt release agents pertinent to her assertion of prior rights. Such allegations are merely amplifications of Applicant's denials of Opposer's allegations. In her brief, Applicant argues essentially the *Morehouse* defense based on these prior registrations, wherein a plaintiff may not be damaged by registration of essentially the same already registered mark. *Morehouse Mfg. Corp. v. J. Strickland and Co.*, 407 F.2d 881, 160 USPQ 715, 717 (CCPA 1969). We note, however, that the pleading does not clearly set forth the *Morehouse* defense. Because it is not properly pleaded, we have not considered this defense. In any event, the differences in the marks would preclude this defense. *O-M Bread Inc. v. United States Olympic Committee*, 65 F.3d 933, 36 USPQ2d 1041, 1047 (Fed. Cir. 1995) (OLYMPIC and OLYMPIC KIDS not "essentially the same" or "legal equivalents"); *Mag Instrument*,

THE RECORD

By operation of the Trademark Rules the pleadings herein and the file of the opposed application are of record. Trademark Rule 2.122, 37 C.F.R. § 2.122. Opposer submitted the testimony with accompanying exhibits of John Curtis Liddiard, Opposer's CEO and owner (Liddiard Test.) and Buzz Butler, former employee of Opposer (Butler I Test.). In addition, Opposer submitted under a Notice of Reliance, Applicant's Response to Opposer's first set of Interrogatories.³

Applicant, Tammy Goldthorpe, submitted her testimony and the testimony of Matt Forsgren, Opposer's former national sales manager (Forsgren Test.), Dennis Brunetti, a third-party supplier, (Brunetti Test.); Buzz Butler (Butler II Test.); and Nancy Ayers, former employee of Opposer (Ayers Test.). In addition, Applicant submitted under Notice of Reliance, copies of Applicant's registrations for CLEAR WIZARD and WHITE WIZARD; TESS printouts of third-party registrations; Opposer's Responses to Applicant's Interrogatories; and excerpts from other court decisions, involving other matters with third parties.

STANDING

Opposer has established that it sells various products, including asphalt release agents. Liddiard Test. pp. 3:19-25; 12:16-18. Opposer has sold asphalt release agents under the mark SLIPPERY WIZARD. Liddiard Test. p. 15:4-22.

Inc. v. The Brinkmann Corp., 96 USPQ2d 1071 (TTAB 2010) (MAGNUM MAX "not substantially the same as" MAGNUM MAXFIRE).

³ Exhibits 2 and 3 and lines 13-18 of the Notice of Reliance were stricken by Board order on October 4, 2013. Exhibits 4 and 5, the file of the subject Application and the specimen of use submitted in support of the Application, are already of record pursuant to Trademark Rule 2.122(b).

Thus, Opposer has demonstrated that it possesses a real interest in this proceeding beyond that of a mere intermeddler, and a reasonable basis for the belief of damage. *Ritchie v. Simpson*, 170 F.3d 1092, 50 USPQ2d 1023 (Fed. Cir. 1999); *Lipton v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185, 189 (CCPA 1982). In view thereof, Opposer has established its standing.

OWNERSHIP

The Parties' Arguments

Opposer argues that Applicant “has never used SLIPPERY WIZARD to identify herself as the source or origin of any goods sold under that mark. Rather, since October of 2004 the SLIPPERY WIZARD mark has always and only identified Brody Chemical’s asphalt release products. Indeed, the very specimen that Goldthorpe submitted to the Trademark Office with her application in fact evidences Brody Chemical’s use of the SLIPPERY WIZARD mark and not her own.” Opp. Br. p. 1. Opposer asserts that Applicant never sold goods under the mark SLIPPERY WIZARD and at the time the mark was first used in commerce to identify an asphalt release product “she was employed by Brody Chemical.” Br. p. 3.

Applicant argues that she invented the asphalt release agent and “conceived of, adopted, and first used the SLIPPERY WIZARD mark.” App. Br. p. 6. Applicant asserts that the business relationship between Applicant and Opposer consisted of an oral license from Applicant to Opposer to use Applicant’s SLIPPERY WIZARD

mark and asphalt release agent formula, and Applicant controlled the use of the mark and quality of the product. *Id.*

Thus, resolution of this case depends on what the record reveals as to whether there was an oral license agreement between Applicant and Opposer or whether the product and name was developed in the course of Applicant's employment. Opposer's assertion that "resolution of this fact dispute is irrelevant" is incorrect. Opp. Br. p. 2. While it is true that trademark rights are acquired by actual use of a mark, that use may be through a licensee and the source may be anonymous. See 1 J. Thomas McCarthy, *McCarthy on Trademarks & Unfair Competition* § 3:7 (4th ed. 2014) ("However, the 'identification' function of marks does not mean that the consumer must know the identity of the manufacturer or distributor of the goods. Seeing the same mark on goods merely identifies to the buyer the fact that all such goods come from a common, even though anonymous, source."). Even if the name of the licensee rather than that of the owner appears on or in connection with the goods, the owner of a trademark is not required to apply its name to the goods. *W.R. Grace & Co. v. Wrap-on Company, Inc.*, 165 USPQ 473, 474 (TTAB 1970), *aff'd*, *Wrap-On Co., Inc. v. W.R. Grace & Co.*, 470 F.2d 1046, 176 USPQ 210 (CCPA 1973). Merely because a manufacturer's or distributor's name appears on a product does not necessarily make it the owner of the mark. *Weber Tackle Co. v. Del Mar Tackle Co., Inc.*, 179 USPQ 250, 253 (TTAB 1973).

The Evidence

The pertinent portions of Mr. Liddiard's testimony, Opposer's primary witness, are directly contradicted by the testimony of Applicant's five witnesses, including Opposer's own witness, Mr. Butler. The level of contradiction, culminating in a forged date on a material piece of evidence, as demonstrated below, renders Mr. Liddiard's testimony utterly unreliable. At a minimum, Opposer's evidence is incapable of meeting its burden to prove that Applicant is not the owner of the mark. Even under the most charitable review, that Opposer simply has a different or faulty memory, Applicant has more than rebutted Opposer's evidence.

It is undisputed that Ms. Goldthorpe was affiliated with Opposer on two separate occasions. From approximately 1999 to 2000/2001 she was a sales representative for Opposer. Goldthorpe Test. p. 32:18. From 2001 through 2003 she worked with RCAI, a third party. Goldthorpe Test. p. 34:13, 16. Applicant became affiliated with Opposer again from 2004 through 2011. Goldthorpe Test. pp. 32:20; 33:16. It is this later relationship that is relevant to the issue of ownership of the SLIPPERY WIZARD mark. Throughout his testimony, Mr. Liddiard characterizes Ms. Goldthorpe as merely an employee. Mr. Liddiard testifies that he hired Applicant when she was "getting divorced." Liddiard Test. p. 6:6-11. However, as her testimony and documentary evidence establish, she divorced in 2001. Goldthorpe Test. p. 21:7-24, Exh. 19. Therefore, at best, Mr. Liddiard's statement could only refer to her prior employment with Opposer not the subsequent arrangement that began in 2004, the time period relevant to this case.

Mr. Liddiard testifies that Opposer paid Applicant as an employee not as a contractor. Liddiard Test. pp. 8:20-25; 9:1. He further stated that Buzz Butler became her sales manager and trained Applicant. Liddiard Test. p. 12:3-4. However, Buzz Butler testified that, while he was the national sales manager for Opposer from 1991 through 1996 or 1997, he was the regional manager in Montana in 2003-2005 and was not involved in management in Opposer's central office. Butler II Test. pp. 9:18-25; 10:6-10, 25; 11:1-9. Clearly these dates do not coincide with Applicant's second affiliation with opposer beginning in 2004. Mr. Butler also testifies that Opposer paid Applicant a \$1.00 "override" per gallon on every sale of SLIPPERY WIZARD product that was sold by others in the company. Butler II Test. pp. 13:24-25; 14:1-8. While Mr. Liddiard testifies that she was paid as an employee, the testimony of Mr. Butler and the pay stub in Exhibit No. 6 make clear that Applicant received a small portion as a wage and the remainder was a payment other than wages. Butler II Test. pp. 26-27, Exh. No. 6.

Mr. Liddiard testifies regarding the genesis of the name as follows:

Once we decided to add a new product other than our current Asphalt release, we were going to come up with a new name. Well, Asphalt Release, that's the generic name for it, so we had to come up with something different. And so in a manager's meeting, as I recall, there was myself, Buzz Butler, and I think that's it. Just the two of us were in a management meeting, and we were trying to think of a name. And I think it was Buzz that came up with the name. He just said Slippery Wizard, and we went, "okay. That will work as a secondary name for a second product for Asphalt Release." ... She – I didn't even have a conversation with Tammy about the name for the product. We just decided to add a secondary product. It needed a name to go on the price list, and so we came up with – I came up with a formula, we costed it. I needed a name to put it on the formula – on the price list, so Buzz and I thought of a name by – I still look back, and I think it

was Buzz that said Slippery Wizard. And I went, “Yeah, that sounds okay. Let’s go with that.” And we did it.

Liddiard Test. p. 13:23-25; 14:1-10, 24-25; 15:1-9.

He further testifies that Ms. Goldthorpe had no involvement in the selection of the SLIPPERY WIZARD name and mark. Liddiard Test. p. 14:13.

This testimony is breathtaking in its “inaccuracy.” As noted above, Mr. Butler testifies that at that time (2004) he was the regional manager in Montana and was not involved in management in the main office. More specifically, he testifies that he did not come up with the name SLIPPERY WIZARD and was in no way involved in the creation or adoption of the name, and that Applicant was the one who came up with the name and that she brought the formula to opposer. Butler II Test. pp. 43:18-25; 44:1-3, 21-25. He does not remember hiring Applicant. Butler II p. 45:3-9. He testifies that employees and customers associated Applicant as the source of the SLIPPERY WIZARD product. Butler II Test. p. 47:1-4.

Mr. Liddiard testifies that he “came up with the formula” for the product and Applicant did not give it to him. Liddiard Test. p. 15:3. He testifies that a Mr. Steve Madsen had suggested using cooking grease for an asphalt release agent and Mr. Liddiard, or his company, developed the product. Liddiard Test. pp. 20-21. However, Ms. Goldthorpe submitted the assignment agreement she entered into with Mr. Madsen recognizing her invention and ownership of the formula for the asphalt release product. Goldthorpe Test p. 11:6-12, Exh. No. 15. This is corroborated by Mr. Forsgren’s testimony that Steve Madsen and Ms. Goldthorpe

“manufactured, sold, delivered asphalt release” in 2003 and that it was Ms. Goldthorpe’s product. Forsgren Test. pp. 21-22.

Mr. Liddiard further testifies that he put the information in the tech sheet on the product attached as Exhibit 3. Liddiard Test. p. 17. However, Ms. Goldthorpe testified she created Exhibit 3 and used prior marketing materials she utilized when she sold the precursor product under the name ASA-12 through RCAI, a third party. Goldthorpe Test. p. 12:19-25; 13:1-23, Exh. No. 17.

Mr. Liddiard testifies that Applicant was not paid “overrides” until after the 2006 agreement in Exhibit 4. Liddiard Test. p. 31:21-25. However, a 2005 pay stub entered under Mr. Butler’s testimony clearly shows “override” payments.⁴ Butler II Test. pp. 25-26. Exh. No. 6.

Mr. Liddiard describes a written 2006 agreement between Opposer and Applicant as an agreement to compensate Applicant for training other sales representatives for the product outside of Applicant’s territory. Liddiard Test. pp. 34-35, Exh. No. 4. Ms. Goldthorpe describes it as memorializing the existing oral license agreement whereby she would receive a royalty on all sales made by other sales representatives. Goldthorpe Test. pp. 24-25. This is also Mr. Butler’s general understanding of the agreement. Butler II Test. p. 19:4-15 (“... this was kind of a confirmation, how I was told, on what she had already been receiving as far as her override on that particular product, on Slippery Wizard”); Id. pp. 24:14-25 (“Q.

⁴ We further note that, Opposer did not take out taxes on the “override” payments. Ms. Goldthorpe explains that Opposer only took out taxes for income resulting from sales other than SLIPPERY WIZARD. Goldthorpe Test. pp. 29:1-4; 30:23; 31:1-4. The sales proceeds from Applicant’s sales of the product were included in the “regular commission income” to Applicant. Goldthorpe Test. p. 31:16-19.

According to that contract, is she required to train others to receive that dollar per gallon? A. No. Q. Does she get it as a matter of course: A. Yes.”). The pertinent portions are set forth below:

1. Commissions will be paid at 50% of Gross Margin.
2. For each gallon of Slippery Wizard sold, not including her own sales, Tammy will receive an override of \$1.00 per gallon.
3. Brody agrees to split all airfare charges incurred by Tammy for travel to and from locations to train and assist other Sales Reps in regards to the Slippery Wizard products.

Finally, Mr. Liddiard testifies that Applicant signed a sales representative agreement with Opposer in 2004 and entered it as Exhibit No. 1. Liddiard Test. p. 7:18-23, Exh. No. 1. However, Mr. Forsgren, who was the person who brought Applicant in to work with Opposer in 2004, states that she refused to sign the agreement. Forsgren Test. p. 40. Applicant states she did not sign a sales representative agreement in 2004 and that the sales representative agreement is from her prior employment with Opposer, as demonstrated by the listed home address which was awarded to her ex-husband by the divorce decree in 2001. Goldthorpe Test. p. 20:2; 6-8, Exh. 19. More seriously, she states that the October 2004 date on that paper is a forgery. Goldthorpe Test. p. 20:18. She asserts that the handwriting for the date is different from her handwriting in other parts of the document (which it appears to be),⁵ and attributes it to another one of Opposer’s

⁵ These are copies of the signature dates from Exhibit 4, the 2006 agreement, and Exhibit 1, the sales representative agreement.

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employees. Goldthorpe Test. p. 20:20-22. Opposer did not address this serious allegation on cross examination, submit rebuttal testimony or respond to it in the reply brief. Nor did Opposer's attorney seek to withdraw the exhibit. Opposer did, however, during the cross examination of another witness, Mr. Forsgren, confirm that in 2004 Applicant would not sign a sales representative agreement and that Mr. Liddiard was informed that Applicant was not comfortable signing the sales representative agreement. Forsgren Test. pp. 40:24; 41:6-13. In view thereof, we find this date to be a forgery and accord Exhibit No. 1 no probative value.

In view of these contradictions and the tampering with evidence, as noted above, we find Mr. Liddiard's testimony unreliable.

The most illuminating testimony on this question of whether Ms. Goldthorpe owned the formula and the mark and whether an oral license existed between the parties comes from Mr. Forsgren, Opposer's former national sales manager. Mr. Forsgren was the person who, on behalf of Opposer, negotiated the arrangement with Applicant concerning this product and mark. Mr. Forsgren worked for Opposer from 2002-2006. Forsgren Test. p. 6:1-9. By 2003 he was Opposer's national sales manager. Forsgren Test. p. 7:6-8. He worked directly under Opposer's owner, Mr. Jon Liddiard. Forsgren Test. p. 13. In 2003, Opposer did not have an asphalt release product. Forsgren Test. p. 8:3-6. Mr. Forsgren looked for asphalt release products to satisfy customer demand and found the product Tammy

We further note the sales representative agreement has an additional date, wherein the number 19 for the year is crossed out.

5th day of October, ~~19~~ 2004.

Goldthorpe was selling through RCAI, a third party. Forsgren. p. 11:3-8. Mr. Forsgren was in charge of finding new products and new sales representatives for opposer. Forsgren Test. p. 11:23-24. This included licensing third-party products. Forsgren Test. p. 12:14-18. Mr. Forsgren included the SLIPPERY WIZARD asphalt release agent as a product owned by another, specifically, Tammy Goldthorpe. Forsgren Test. p. 15:1-11. He explains that “a lot” of products in opposer’s catalog were not owned by Opposer. Forsgren Test. p. 16:8-23. Mr. Forsgren testifies succinctly about the ownership of the SLIPPERY WIZARD product as follows:

Q. Is this product owned by Brody Chemical?

A. No.

Q. Whose product is it?

A. Tammy’s.

Q. Is it sold by Brody Chemical?

A. Yes. Forsgren p. 17:6-11. ...

Q. Was SLIPPERY WIZARD one of the new products that you brought in, as manager, for Brody Chemical to sell?

A. Yes.

Q. Whose product was SLIPPERY WIZARD?

A. Tammy’s.

Forsgren Test. p. 20:10-16.

As set forth below, Mr. Forsgren describes in detail the circumstances surrounding Applicant’s and Opposer’s arrangement concerning the asphalt release product sold under the SLIPPERY WIZARD mark.

Q. Was Slippery Wizard one of the new products that you brought in, as manager, for Brody Chemical to sell?

A. Yes.

Q. Whose product was Slippery Wizard?

A. Tammy’s.

...

Q. Where was she [Applicant] when you became national sales manager in 2003?

- A. She was working in Salt Lake.
- Q. What – did she have her own business?
- A. Yes.
- Q. Did she have a colleague?
- A. Yes.
- Q. Who was that?
- A. Steve Madsen.
- Q. Where was their business?
- A. Off California Avenue on the west side of Salt Lake.
- Q. What did they do?
- A. They manufactured, sold, delivered asphalt release.
- Q. Do you know Steve Madsen?
- A. Yes.
- Q. What is his specialty?
- A. Blending chemicals, water treatment, sales, delivery.
- Q. Is he a chemist?
- A. I don't know if he has a chemical degree, but that's how I've always known him as blending formulas for water treatment and other products.
- Q. Were they involved with RCAI [third party distributor]?
- A. Yes.
- Q. Were they involved with a product called ASA-12?
- A. Yes.
- Q. Was it your understanding that ASA-12 was Tammy Goldthorpe's product?
- A. Yes.
- Q. Did you want to bring in the ASA-12 product?
- A. Yes.
- Q. Did you attempt to get Tammy Goldthorpe to license her ASA-12 product to Brody Chemical?
- A. Yes.
- Q. When did you start trying to get Tammy's product?
- A. Made contact about the product in the spring of 2003.
- Q. Was she interested?
- A. She wasn't – she wasn't extremely interested at that time.
- Q. Did you continue to negotiate with her?
- A. Yes. I kept in touch with her and kept after her over the course of the next year to see if she would be interested in bringing her product over.
- Q. Did you represent that she would be paid royalties to license her product?
- A. Yes.
- Q. Is this what she asked for?
- A. Yes.
- Q. Did she want to use the ASA-12 mark?

- A. No.
- Q. Did she want to come up with a different mark to use with this asphalt release product?
- A. Yes.
- Q. What mark did she choose?
- A. Slippery Wizard.
- Q. Had you ever heard the mark Slippery Wizard before?
- A. No.
- Q. And you heard this mark from Tammy Goldthorpe?
- A. Yes.
- Q. Was this prior to October of 2004?
- A. Yes.
- Q. Did you approach Jon Liddiard about licensing Tammy Goldthorpe's product?
- A. Yes.
- Q. Was he interested?
- A. Yes.
- Q. Did you tell him about the mark Slippery Wizard?
- A. Yes.
- Q. What happened then?
- A. He made fun of the name, called it Slippery Lizard, and didn't know how that name would go over. But that's the name she had chose, so –
- Q. Did he still want to sell the product?
- A. Yes.
- Q. Did he suggest a royalty amount for Tammy Goldthorpe's product?
- A. No.
- Q. Who suggested a royalty amount?
- A. She did, Tammy.
- Q. What amount?
- A. A dollar a gallon on every gallon sold as a royalty.
- Q. Did Brody Chemical make a counteroffer?
- A. Yes. He offered \$0.50 a gallon.
- Q. Did Tammy Goldthorpe accept this?
- A. No.
- Q. Did she reject it?
- A. Yes.
- Q. Did she counteroffer?
- A. Yes, back at the original dollar a gallon.
- Q. Did Brody Chemical agree to the dollar per gallon?
- A. Yes.
- Q. Did Jon agree to the dollar per gallon?
- A. Yes.
- ...
- Q. Did she want to sell and promote her Slippery Wizard product?

A. Yes.

Q. Did you tell her that Brody Chemical had the ability to blend her Slippery Wizard product?

A. Yes.

Q. Did you tell her that Brody Chemical had the ability to package and ship her Slippery Wizard product?

A. Yes.

Q. Did you propose a royalty to Tammy Goldthorpe on behalf of Brody Chemical to allow Brody Chemical to make and sell the Slippery Wizard product and use the Slippery Wizard mark?

A. Yes.

Q. What was it?

A. A dollar a gallon override on every gallon sold.

Q. Did she orally accept this royalty?

A. Yes.

W. Were these terms accepted by Brody Chemical?

A. Yes.

Q. Were they accepted by Jon Liddiard?

A. Yes.

Forsgren Test. pp. 20 - 26:1-4

Mr. Forsgren further testified that Applicant controlled the composition, formula, nature and quality of the product sold by Brody Chemical, as well as the advertising of the product. Forsgren Test. p. 33:5-11. Finally, he testified that customers associated Applicant as the source of the SLIPPERY WIZARD product.

This testimony is corroborated by the other witnesses. For example, Ms. Ayers was a sales representative for Opposer and testified that it was her understanding that Applicant was the owner of the SLIPPERY WIZARD product and that Opposer would be selling Applicant's product. Ayers Test. p. 7:13-23. When she needed information about the SLIPPERY WIZARD product she would ask Applicant "[b]ecause it's her product and she would know." Ayers Test. p. 10:5-6. Dennis Brunetti, affiliated with a third party, Renegade Oil, supplied an

ingredient to Tammy Goldthorpe since approximately 2003. Brunetti Test. pp. 4:11-13; 7:12-17. Mr. Brunetti describes the relationship with Opposer, Brody Chemical, as follows:

Brody Chemical would place their orders on their own through their purchasing people, and we would – we, Renegade Oil, would deliver the product to Brody. But it was my understanding that Tammy was the influence or the person behind it. Tammy didn't place every order; but at the time, Tammy was working for RCAI [a third party] and then went to Brody after that.

Brunetti Test. p. 7:3-8.

Of course, Applicant is a biased witness; however, her testimony is in alignment with Mr. Forsgren's testimony. Ms. Goldthorpe testified that she had a license agreement with Opposer, Brody Chemical, which covered her asphalt release agent product and accompanying trademark SLIPPERY WIZARD. Goldthorpe Test. p. 5:7-16. It is her position that Opposer is in breach of that license agreement. Goldthorpe Test. at 5:17-22. She testified that she invented the formula for the product in 2002 before she was involved with Opposer. Goldthorpe Test. pp. 8:22-25; 9:1-13. She invented the formula in 2002 and consulted with Steve Madsen, to develop the product. Goldthorpe Test. p. 9:1; 10:4-6. Mr. Madsen executed an assignment of all rights to the formula to Applicant on April 12, 2011. Goldthorpe Test. p. 10:24-25; Exh. No. 15. Applicant sold an asphalt release product under the mark ASA-12 through RCAI, a third party, prior to Applicant's association with Opposer. Goldthorpe Test. p. 12:9-12. Applicant wrote all the brochures connected with the SLIPPERY WIZARD product. Goldthorpe Test. p. 13:13-20. In 2003, Matt Forsgren, Opposer's former employee, approached

Applicant about licensing her asphalt release product and when she agreed in 2004, she came up with a new name SLIPPERY WIZARD. Goldthorpe Test. pp. 17-19. Ms. Goldthorpe testifies that she controlled the composition and formula of the product and the nature and quality of the product. Goldthorpe Test. p. 27:14-23. Finally, as discussed *supra*, Ms. Goldthorpe testified that she did not sign a sales representative agreement with Opposer in 2004 and the October 2004 date on Exhibit No. 1 is a forged date on the 1999 agreement she signed during her prior employment with Opposer. Goldthorpe Test. p. 20:1-2, 14-18. She asserts the handwriting belongs to Collette Jacobson. Goldthorpe Test. p. 20:19-24.

Findings of Fact

The testimony of Opposer's national sales manager stands unrebutted and corroborated. It is clear and unequivocal. Applicant developed the product and came up with the mark SLIPPERY WIZARD to use with her product. Opposer licensed use of Applicant's asphalt release agent and paid her a royalty on the sale of that product. We further find that Applicant controlled the nature and quality of the product. The oral license agreement entered into between Opposer and Applicant in 2004 was memorialized in the 2006 written agreement.

Application of Law to the Facts

The record establishes that Applicant owns the mark SLIPPERY WIZARD. Opposer argues that there is no contemporaneous written agreement; however, this is not dispositive, licenses may be oral. *John Anthony, Inc. v. Fashions by John Anthony, Inc.*, 209 USPQ 517 (TTAB 1980) (oral license between employer (licensee)

and former employee (licensor)). *See also The Nestle Company Inc. v. Nash-Finch Co.*, 4 USPQ2d 1085 (TTAB 1987) (written license not required); *W.R. Grace & Co. v. Wrap-on Company, Inc.*, 165 USPQ 473 (receipt of royalties from licensee sufficient to establish licensor as the owner). Opposer argues only Opposer used the mark, Applicant never did. However, Opposer's use of the mark, as the licensee, inured to the benefit of Applicant, the licensor and owner of the mark. Further, as explained *supra*, the fact that the source is anonymous inasmuch as Applicant's name was not used in connection with the sale of the goods also does not strip Applicant of its ownership. *See* 1 J. Thomas McCarthy, *McCarthy on Trademarks & Unfair Competition* §§ 3:7; 3:9. *See also* 2 J. Thomas McCarthy, *McCarthy on Trademarks & Unfair Competition* § 15:8 and cases cited therein. Opposer further contends that its mark BRODY CHEMICAL appears with the mark SLIPPERY WIZARD. However even if the name of the licensee rather than that of the owner appears on or in connection with the goods, the owner of a trademark is not required to apply its name to the goods. *W.R. Grace & Co. v. Wrap-on Company, Inc.*, 165 USPQ 473.

Opposer quotes the following passage from McCarthy's treatise in support of its position:

Ownership as between employer and employee will depend upon who first used the term as a mark and who the mark identifies. If an employee designs a mark in the course of employment and the employer uses it, it would seem clear that the employer is the "owner" of the mark. But if a person was in business and sold a product under a mark, and then entered into employment under an agreement to assign to the employer all marks developed as an employee, the employee, not the employer is the owner of the pre-employment mark.

Opp. Br. p. 3, *quoting*, 2 J. Thomas McCarthy, *McCarthy on Trademarks & Unfair Competition* § 16:36 at 16-73 (4th ed. 2012).

The record shows that Applicant did not design the mark “in the course of employment” but rather rebranded her asphalt release product in anticipation of bringing in the product to be sold through Opposer with royalties paid to Applicant. While the multifaceted relationship between Applicant and Opposer may have included an employer/employee relationship, that does not preclude the additional relationship described in detail by Mr. Forsgren and confirmed by Applicant’s pay stubs wherein wages are listed separately from the “other” income which represents the royalties paid to Applicant for sales by others of her SLIPPERY WIZARD product.

The preponderance of the evidence supports Applicant’s position that Applicant owns the mark and Opposer was simply the licensee while Applicant was affiliated with Opposer. Thus, Opposer’s use of the SLIPPERY WIZARD mark inured to Applicant’s benefit.

Opposer has the burden of proof in this proceeding establishing that Applicant is not the owner of the mark SLIPPERY WIZARD and it has failed to meet this burden. In view of our decision on the ownership claim, we do not reach the affirmative defenses of estoppel and unclean hands.

Decision: The Opposition is dismissed.