

This Opinion is Not a
Precedent of the TTAB

Hearing: May 26, 2016

Mailed: July 12, 2016

UNITED STATES PATENT AND TRADEMARK OFFICE

—
Trademark Trial and Appeal Board
—

Dina DiCenso and Eight of Swords, LLC

v.

Dave Wallin

—
Opposition No. 91208299
—

Howard S. Koh of Meister Seelig & Fein LLP,
for Dina DiCenso and Eight of Swords, LLC.

Aaron H. Pierce and Matthew C. Heerde of The Law Offices of Aaron H. Pierce,
for Dave Wallin.

—
Before Kuczma, Greenbaum and Adlin,
Administrative Trademark Judges.

Opinion by Greenbaum, Administrative Trademark Judge:

Dina DiCenso (“DiCenso”) and Eight of Swords, LLC (“the LLC”) oppose Dave Wallin’s (“Wallin”) application to register the mark



(TATTOO disclaimed) for

piercing services; Cosmetic tattooing services; Providing medical information and news about body art, namely, piercing, tattoos, scarification, subincision, castration through photos and videos; Tattoo parlors; Tattoo studios; Tattooing; Tattooing services in International Class 44.¹

As grounds for opposition, DiCenso and the LLC allege that: (1) the LLC, rather than Wallin, is the owner of the mark; (2) Wallin misrepresented the source of his services under Trademark Act Section 14(3), 15 U.S.C. § 1064(3); and (3) Wallin committed fraud on the USPTO by falsely declaring in his application that he is the owner of the mark.

In his answer, Wallin admitted that “Eight of Swords was formed to operate a tattoo studio, retail store and art gallery,”² and denied the other salient allegations. Wallin also asserted six “affirmative defenses,” most of which are merely amplifications of his denials (e.g., Wallin created the mark in his own behalf and licensed it to the LLC) or have been waived because Wallin failed to pursue them at trial (e.g., laches, acquiescence and estoppel).³ See *Alcatraz Media, Inc. v. Chesapeake Marine Tours Inc. dba Watermark Cruises*, 107 USPQ2d 1750, 1753 n.6 (TTAB 2013).

¹ Application Serial No. 85374056 was filed on July 18, 2011, based upon Applicant’s claim of first use on June 1, 2009, and first use in commerce on July 13, 2009. The application includes the following description of the mark: “The mark consists of the words ‘Eight of Swords Tattoo’. The first three words ‘Eight of Swords’ are displayed using a stylized font and the single fourth word ‘Tattoo’ is in a different and more plain text font.” Color is not claimed as a feature of the mark. Applicant seeks registration on the Principal Register.

² 6 TTABVUE 3, ¶ 3.

³ Wallin also asserted an affirmative defense of unclean hands, namely, that DiCenso has “sabotaged” Wallin and the LLC by filing “fraudulent state and federal tax returns on behalf of [the] LLC,” and that she “actively facilitated the eviction of [the] LLC, opened her own tattoo shop in the same location, and falsely advertised that Wallin worked for her in her new shop. 6 TTABVUE 6. However, this affirmative defense is not related to DiCenso’s claims in this proceeding, and therefore is not viable. See *Tony Lama Co., Inc. v. Anthony Di Stefano*,

This case is fully briefed, and an oral hearing was held on May 26, 2016.

I. Evidentiary Issues.

Each party objected to the admissibility of certain evidence, with Wallin objecting to an article posted on the WG Williamsburg-Greenpoint News website <http://thewgnews.com>⁴ as hearsay, and DiCenso objecting to an August 5, 2010 Order by Judge Demarest in the Supreme Court of the State of New York, Kings County⁵ because it is not a certified copy of a public record (*see* Fed. R. Evid. 902(4)), and Wallin's sketches of logos⁶ because Wallin failed to produce them in discovery although they were requested. We need not and do not rule on these objections because none of the objected-to material is outcome determinative,⁷ and we have not relied on any of it in reaching our decision.

206 USPQ 176, 179 (TTAB 1980) (“It might be emphasized, however, that the concept of unclean hands must be related to a plaintiff’s claim, and misconduct unrelated to the claim in which it is asserted as a defense does not constitute unclean hands.”).

⁴ 18 TTABVUE 91. Wallin also objects to the probative value of this article.

⁵ 27 TTABVUE 22. The Order bears the case caption “Dina Dicenso in the Matter of the Application as a Member, for the Dissolution of Eight of Swords LLC, A New York Limited Liability Co., Pursuant to Section 702 of the LLC Law Plaintiff(s) – against – David Wallin Defendant(s).” We discuss below the January 13, 2011 Order from Judge Demarest in this same litigation.

⁶ 27 TTABVUE 8.

⁷ Indeed, other than mentioning “Applicant’s Trial Exhibit (‘Applicant’s Ex.’) Nos. 1 through 7” in the description of the record in his brief (32 TTABVUE 7), Wallin does not even refer to any of the evidence to which DiCenso has objected, much less address the merits of the objections. Wallin relies only on the January 13, 2011 Order from Judge Demarest (which DiCenso also submitted).

II. The Record.

The record includes the pleadings, and, by operation of Trademark Rule 2.122(b), 37 C.F.R. § 2.122(b), the file of involved application Serial No. 85374056.

DiCenso introduced her trial testimony with associated exhibits, and a Notice of Reliance on portions of Wallin's discovery deposition and interrogatory responses.⁸

Wallin introduced his testimony deposition with associated exhibits, and a Notice of Reliance on several items, including DiCenso's responses to Wallin's document requests and interrogatories.⁹

III. Background.

In the spring of 2009, Wallin and DiCenso sought to open a tattoo studio¹⁰ where Wallin, a licensed tattoo artist, would perform tattooing services.¹¹ DiCenso, who had been one of Wallin's clients,¹² contributed approximately \$31,000 to \$32,000, virtually all of the start-up capital, as a loan to the business.¹³ DiCenso and Wallin considered names for the business, and on April 14, 2009, DiCenso sent an email to Wallin with several suggested names.¹⁴ As part of the start-up efforts, DiCenso searched for rental

⁸ 16-17 TTABVUE.

⁹ 22 TTABVUE. Most of the other items also were made of record as exhibits to the testimony of Wallin or DiCenso. In addition, on January 31, 2015, the Board granted DiCenso's motion to strike four exhibits that Wallin filed under Notice of Reliance (30 TTABVUE 3), and we have not considered them.

¹⁰ 18 TTABVUE 9-10; 23 TTABVUE 6-7, 62-65.

¹¹ 18 TTABVUE 9-11; 23 TTABVUE 8.

¹² 18 TTABVUE 9; 23 TTABVUE 6.

¹³ 18 TTABVUE 100-101; DiCenso testified that she contributed "about \$35,000," and Wallin contributed "very little. It was less than \$2,000." 18 TTABVUE 26.

¹⁴ 18 TTABVUE 12-14, 55; 23 TTABVUE 9-12.

property for the tattoo studio.¹⁵ After a May 7, 2009 offer to lease space failed,¹⁶ DiCenso found a second location. Around this time, Wallin suggested naming the business Eight of Swords¹⁷, and he designed the logo in the involved application.¹⁸ On May 20, 2009, the LLC was organized under the laws of the State of New York “to operate a tattoo studio, retail store and art gallery.”¹⁹ In connection therewith: DiCenso prepared the “Articles of Organization of Eight of Swords, LLC”²⁰; Wallin signed the Articles of Organization as “Member,” and was listed as the Registered Agent²¹; DiCenso personally paid the filing fee and filed the Articles of Organization in the N.Y.S. Department of State Division of Corporations and State Records²²; and DiCenso subsequently prepared and signed the “Certificate of Publication of Eight of Swords” as “Managing Member” of the LLC.²³ On May 21, 2009, DiCenso signed and personally guaranteed the lease, naming the LLC as the tenant.²⁴ Around the same time, DiCenso registered and personally paid for the eightofswordstatto.com and

¹⁵ 18 TTABVUE 12.

¹⁶ 18 TTABVUE 14-17, 57, naming Electric Tattoo LLC as the prospective tenant. However, no such entity was ever formed. 18 TTABVUE 16.

¹⁷ 18 TTABVUE 33; 23 TTABVUE 14, 24.

¹⁸ 23 TTABVUE 14-17.

¹⁹ 6 TTABVUE 3, ¶ 3. 18 TTABVUE 79.

²⁰ 18 TTABVUE 22.

²¹ 18 TTABVUE 79.

²² 18 TTABVUE 23-25, 82.

²³ 18 TTABVUE 28-29, 84.

²⁴ 18 TTABVUE 17-21, 60.

related domain names.²⁵ The Eight of Swords Tattoo shop opened for business in July 2009.²⁶

As is all too common in disputes like this, DiCenso and Wallin do not have a written agreement or any documentation confirming their business arrangement. However, DiCenso testified that Wallin “would tattoo, and he would do the art work for the logo, the merchandise that we were going to create, the clothing line, and some jewelry, and he also would try to help bring in tattoo artists, and deal with the tattoo artists.”²⁷ DiCenso and Wallin dispute the extent to which DiCenso was supposed to be involved with the business. DiCenso claims that Wallin “was my partner,”²⁸ and that she was to be responsible for “everything else including, managing the business, securing artists, organizing events, and handling day-to-day operations.”²⁹ Wallin confirms that DiCenso was “involved with me setting up the shop” and he “never denied that for a second.”³⁰ Wallin also confirms DiCenso “offered to loan me money to start up my business. She offered to help me walk through all the little hoops that had to be jumped through” in connection with setting up the business.³¹ Wallin

²⁵ 18 TTABVUE 29-31, 86.

²⁶ 18 TTABVUE 26-27; 23 TTABVUE 9.

²⁷ 18 TTABVUE 11.

²⁸ 18 TTABVUE 10.

²⁹ 18 TTABVUE 11.

³⁰ 23 TTABVUE 66.

³¹ 23 TTABVUE 67.

denies, however, that DiCenso ever was interested in owning the shop, and contests her claim to having business and legal expertise.³²

On April 23, 2010, DiCenso petitioned the Supreme Court of the State of New York, Kings County, to dissolve the LLC, which Wallin opposed. On January 13, 2011, Judge Demarest denied DiCenso's petition, and ruled that Wallin was the "sole managing member" of the LLC and the LLC's majority owner. In particular, the court ruled that DiCenso's interest in the LLC "is minimal, and ... is certainly less than 20%, and may be as little as 1% to 5%." The court also ruled that unless Wallin permits DiCenso's "day-to-day participation on the premises," DiCenso "does not have authority to go to the business and run it or manage it in any way at all."³³ However, DiCenso "is entitled to 30% of the revenue from the merchandise sold and 30% of the revenue generated from guest artists generated at EIGHT OF SWORDS, LLC."³⁴ On July 18, 2011, Wallin filed the involved application.³⁵

³² 23 TTABVUE 66-67.

³³ The parties represent that the court's decision was affirmed on appeal, but neither party made the affirmance of record. The parties also mention another lawsuit by DiCenso against Wallin and the LLC in the same New York State court (1 TTABVUE 1 n.1; 6 TTABVUE 6), but there is nothing of record pertaining thereto. At oral hearing, the parties represented that the pending New York litigation has no bearing on the issues before this Board.

³⁴ 18 TTABVUE 99.

³⁵ Wallin used funds from the LLC to pay his attorney to file the application. 18 TTABVUE 36-37, 97; 23 TTABVUE 56-57. In addition, around June 23, 2010, approximately two months after DiCenso commenced the action for dissolution, the LLC paid the filing fee to obtain a copyright registration for the involved mark. 18 TTABVUE 34-36, 95; 23 TTABVUE 54-56.

IV. Standing.

Standing is a threshold issue that must be proven in every *inter partes* case. *See Empresa Cubana Del Tabaco v. Gen. Cigar Co.*, 753 F.3d 1270, 111 USPQ2d 1058 (Fed. Cir. 2014) cert denied, 135 S. Ct. 1401 (2015); *Lipton*, 213 USPQ at 189 (CCPA 1982). To establish standing in an opposition, an opposer must show that it has a “real interest,” i.e., a direct and personal stake, in the outcome of the opposition. *See Ritchie v. Simpson*, 170 F.3d 1092, 50 USPQ2d 1023 (Fed. Cir. 1999); *Jewelers Vigilance Committee, Inc. v. Ullenberg Corp.*, 823 F.2d 490, 2 USPQ2d 2021 (Fed. Cir. 1987).

DiCenso has established that she is a co-founder of, continues to have at least a minimal ownership interest in, and is due revenues from, the LLC. As such, DiCenso has shown that she is not a mere intermeddler, but has a real interest, that is to say, “a direct and personal stake” in the outcome of this proceeding. *See Ritchie v. Simpson*, 50 USPQ2d at 1027. DiCenso therefore has established her standing, and given our decision herein, we need not address the LLC’s standing to oppose Applicant’s application.³⁶

V. Ownership Claim.

Pursuant to Section 1(a)(1) of the Trademark Act, 15 U.S.C. 1051(a)(1), only “[t]he owner of a trademark used in commerce may request registration of its trademark....”

³⁶ As DiCenso correctly notes, although DiCenso and the LLC both are parties to this proceeding, only one of them needs to prevail for the opposition to be sustained against Wallin. *See e.g., Chemical New York Corp. v. Conmar Form Sys., Inc.*, 1 USPQ2d 1139, 1144 (TTAB 1986) (sustaining opposition on the basis of the claim of one of three joint opposers). In this decision, we focus, as did the parties, on DiCenso’s claims as a named opposer.

Accordingly, only the owner of the mark may file an application. *In re Wella A.G.*, 787 F.2d 1549, 229 USPQ 274, 277 (Fed. Cir. 1986) (C.J. Nies concurring) (“Under section 1 of the Lanham Act, only the *owner* of a mark is entitled to apply for registration.”) (emphasis in original); *Holiday Inn v. Holiday Inns, Inc.*, 534 F.2d 312, 189 USPQ 630, 635 n.6 (CCPA 1976) (“One must be the owner of a mark before it can be registered.”); *In re Deister Concentrator Co. Inc.*, 289 F.2d 496, 129 USPQ 314, 320 (CCPA 1961) (“Under section 1, only ‘The owner of a trademark’ can apply for registration.”). Therefore, “[a]n application filed by one who is not the owner of the mark sought to be registered is a void application.” *In re Tong Yang Cement Corp.*, 19 USPQ2d 1689, 1690 (TTAB 1991) (citing *In re Techsonic Indus., Inc.*, 216 USPQ 619 (TTAB 1982)). *See also Huang v. Tzu Wei Chen Food Co. Ltd.*, 849 F.2d 1458, 7 USPQ2d 1335 (Fed. Cir. 1988) (affirming Board’s holding that an application was void *ab initio* because the applicant was not the owner of the mark on the filing date); *Great Seats Ltd. v. Great Seats Inc.*, 84 USPQ2d 1235, 1239 (TTAB 2007) (“In a use-based application under Trademark Act Section 1(a), only the owner of the mark may file the application for registration of the mark; if the entity filing the application is not the owner of the mark as of the filing date, the application is void *ab initio*.”); Trademark Rule 2.71(d) (“An application filed in the name of an entity that did not own the mark as of the filing date of the application is void.”).

Wallin’s position is best summed up in his brief

Wallin conceived of and designed the Mark in his individual capacity before the LLC was formed, and then licensed the mark to the LLC when he opened the Eight of Swords tattoo shop. Mr. Wallin’s intent at all times was to maintain control and ownership of the mark, and thus Mr.

Wallin, as the LLC's sole managing member and majority owner, controlled the LLC's services under the Mark. Under Section 5 of the Lanham Act, the LLC's use of the Mark inured to Mr. Wallin, and he personally owns the Mark. Ms. DiCenso's opposition is little more than an attempt to re-litigate the New York State courts' holdings that her interest in the LLC was "minimal," and that she had "no authority to ... run [the LLC] or manage it in any way at all."³⁷

Based on the testimony and the evidence of record, we find that Wallin created the name "Eight of Swords" and its accompanying design before the LLC was formed. However, such activities do not automatically mean that Wallin was the owner of the mark, or the source of the services sold thereunder, and we do not agree with Wallin that he undertook these activities "in his individual capacity." Rather, we view the activities of each party prior to the July 20, 2009 opening of the business as a typical collaboration between two individuals who jointly are starting a business, i.e., a partnership or joint venture: Wallin was to be primarily responsible for performing tattoo services, but DiCenso found and leased the rental property for the business, prepared the paperwork to formalize the legal entity, and loaned the business virtually all of the start-up capital, among other things. While DiCenso's ownership interest is "minimal" and she is not authorized to manage the LLC's current operations, the New York Supreme Court determined that her interest is more than 0%, and Wallin's is less than 100%.

There is no evidentiary support for Wallin's repeated assertions that he licensed the mark to the LLC or that he obtained sole ownership rights through any such

³⁷ 32 TTABVUE 12.

purported license. Wallin testified that he never signed a license agreement with the LLC,³⁸ and the record is devoid of any details concerning a purported oral license.

In addition, Wallin's assertion that he "was the sole managing member and majority owner" of the LLC when he "determined that the LLC would license the Mark from Wallin"³⁹ is contrary to evidence of record: DiCenso signed the LLC's May 20, 2009 lease⁴⁰ and the June 17, 2009 Certificate of Publication⁴¹ as a "Managing Member" of the LLC, and the January 13, 2011 Order from Judge Demarest,⁴² which proclaimed Wallin "the sole managing member" and majority owner of the LLC, is not retroactive to the May 20, 2009 formation of the LLC, and it does not mention a license of the mark by Wallin to the LLC.

VI. Conclusion.

In sum, we find that DiCenso has made a prima facie case that Wallin was not the owner of the mark when he filed the application, and Wallin has not rebutted this case. There simply is no evidence that Wallin individually owned the mark when he filed the application. The application therefore is void *ab initio*.⁴³

Decision: The opposition is sustained.

³⁸ 23 TTABVUE 30.

³⁹ 32 TTABVUE 14.

⁴⁰ 18 TTABVUE 60.

⁴¹ 18 TTABVUE 84.

⁴² 18 TTABVUE 99.

⁴³ As a result, we need not and do not reach the grounds of misrepresentation of source or fraud.