

UNITED STATES PATENT AND TRADEMARK OFFICE  
Trademark Trial and Appeal Board  
P.O. Box 1451  
Alexandria, VA 22313-1451

BUO

Mailed: May 24, 2013

Opposition No. 91209637

ZakkWylde

v.

James A. Baltutis, Mark  
Ferguson

**Benjamin U. Okeke, Interlocutory Attorney:**

Pursuant to Fed. R. Civ. P. 26(f) and Trademark Rules 2.120(a)(1) and (2), the parties to this proceeding conducted a discovery conference by telephone on May 8, 2013. Applicants, by their submission, filed April 24, 2013, requested Board participation in the conference. Participating in the conference were opposer's attorney, Victor K. Sapphire, applicant James A. Baltutis,<sup>1</sup> *pro se*, Administrative Trademark Judge David M. Mermelstein, and Board interlocutory attorney Benjamin U. Okeke.

The Board advised Mr. Baltutis that parties would be well-advised to retain experienced trademark practitioners

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<sup>1</sup> Mr. Baltutis is representing the joint applicants in this proceeding-James Baltutis and Mark Ferguson. Mr. Baltutis indicated that counsel may be retained at a later date. Applicants are again encouraged to seek counsel. If counsel is retained by applicants an appearance should promptly be filed

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to represent them in Board proceedings. Applicants will be expected to comply with all applicable rules and procedures, including those relating to service of papers, as set forth in Trademark Rule 2.119, regardless of whether applicants retain counsel.<sup>2</sup>

The parties indicated that there is no other pending litigation between them, or any third parties, concerning these marks in federal court or before the Board. The parties have engaged in settlement talks, including an additional oral proposal made during the call, but have not reached an agreement.

A. Standard Protective Order

The Board reminded the parties of the automatic imposition of the Board's standard protective order in this case. Trademark Rule 2.116(g). The standard protective order is online at: <http://www.uspto.gov/trademarks/process/appeal/guidelines/stndagmnt.jsp>.

The Board also reminded the parties of the unique issue raised by confidential documents designated "for attorney's eyes only" in a proceeding involving a *pro se* defendant: if applicants represent themselves, they may be precluded from receipt of discovery documents so designated. At the same

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with the Board, indicating the new correspondence information for applicants' retained counsel.

<sup>2</sup> Information for parties representing themselves is provided at the end of this order.

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time, the parties were cautioned that designation of any confidential documents should be in good faith, and only when necessary to protect confidential matter. If the parties wish to add or modify any provisions of the standard protective order, they may negotiate an amended protective agreement, subject to Board approval.<sup>3</sup>

B. Pleadings

The Board reviewed the pleadings with the parties. Opposer, Zakk Wylde, opposes registration of the mark THE BLACK LABEL ORDER TBLO:



Application Serial No. 85541606, filed by James A. Baltutis and Mark Ferguson, as joint applicants, for use in connection with various articles of clothing, including, t-shirts, shirts, jackets, pants, sweatshirts, hats, caps and footwear.

Opposer has asserted likelihood of confusion under Section 2(d) of the Trademark Act, 15 U.S.C. 1052(d), as its

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<sup>3</sup> The Board noted, however, that the factual background suggests that the likelihood of a dispute over confidential documents is minimal given that the parties appear to have been affiliated during the time periods that form the basis of the claims presented.

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ground for opposition. Opposer's ESTTA-generated coversheet also indicates grounds of deceptiveness under Section 2(a), false suggestion of a connection under Section 2(a), dilution under Section 43(c), and fraud on the USPTO. The claim of deceptiveness is inappropriate given the factual background of this proceeding, and is accordingly **STRICKEN** from the notice of opposition and will be given no further consideration.<sup>4</sup> The claims of false suggestion of a connection, dilution and fraud are not supported by the facts presented in the body of the notice of opposition.<sup>5</sup>

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<sup>4</sup> A claim of deceptiveness refers to marks that consist of or include matter that misdescribes the character of the goods. That is not the case here. A mark is deceptive if: (1) the term misdescribes the character, quality, function, composition or use of the goods; (2) prospective purchasers are likely to believe that the misdescription actually describes the goods; and (3) the misdescription is likely to affect a significant portion of the relevant consumers' decision to purchase. *In re Spirits Int'l*, N.V., 563 F.3d 1347, 90 USPQ2d 1589 (Fed. Cir. 2009).

<sup>5</sup> To state a claim of false suggestion of a connection under Trademark Act Section 2(a), opposer must allege facts from which it may be inferred (1) that applicant's mark points uniquely to opposer as an entity -- i.e., that applicant's mark is opposer's identity or "persona;" (2) that purchasers would assume that goods sold under applicant's mark are connected with opposer; and (3) either (a) that opposer was the prior user of applicant's mark, or the equivalent thereof, as a designation of its identity or "persona", or (b) that there was an association of the mark with opposer prior in time to applicant's use. See *Miller Brewing Co. v. Anheuser-Busch Inc.*, 27 USPQ2d 1711, 1712-13 (TTAB 1993).

A claim of dilution under Section 43(c) of the Trademark Act requires a showing that: (1) opposer's distinctive mark would be blurred or tarnished by use of applicant's similar mark; (2) opposer's mark is famous; and (3) opposer's mark became famous prior to the earliest date of use (or constructive use) claimed by applicant. See 15 U.S.C. 1125(c); *Trek Bicycle Corp. v. StyleTrek Ltd.*, 64 USPQ2d 1540 (TTAB 2001).

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However, opposer is allowed **TWENTY DAYS** from the mailing date of this order to file an amended notice of opposition repleading these claims as appropriate. See Fed. R. Civ. P. 15(a); TBMP Section 507. If opposer fails to appropriately amend its notice of opposition within the allowed time period, the claims of false suggestion of a connection, dilution and fraud will be stricken from the notice of opposition.<sup>6</sup> If opposer does file an amended pleading pursuant to this order, applicants are allowed **TWENTY DAYS** from the service of opposer's amended pleading in which to file an amended answer.

***Standing***

Opposer has pleaded ownership of Registration Nos. 2367010, 3518532 and 3677873 for the mark BLACK LABEL SOCIETY, all in standard character format, for use in

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Finally, in an opposition alleging fraud an opposer must allege the elements of fraud with particularity in accordance with Fed. R. Civ. P. 9(b). Under Rule 9(b), together with Fed. R. Civ. P. 11 and USPTO Rule 11.18, "the pleadings [must] contain explicit rather than implied expression of the circumstances constituting fraud." *Asian and Western Classics B.V. v. Selkow*, 92 USPQ2d 1478 (TTAB 2009) citing *King Auto., Inc. v. Speedy Muffler King, Inc.*, 667 F.2d 1008, 212 USPQ 801, 803 (CCPA 1981). Opposer must identify a specific false statement of material fact that applicants made in filing the involved application and that such false statement was made with the intent to deceive the USPTO into issuing a registration. See *In re Bose Corp.*, 580 F.3d 1240, 91 USPQ2d 1938 (Fed. Cir. 2009). Opposer's submission of its coversheet, and nothing more regarding the allegation of fraud, falls well-short of this requirement.

<sup>6</sup> The Board is doubtful of opposer's ability to plead that the mark points uniquely to opposer as its persona as necessary for a claim of false suggestion, or to plead the level of fame

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connection with goods that overlap with those identified in applicant's involved application, namely, t-shirts, [cloth] jackets, hats and caps. Through these allegations, opposer has adequately pleaded a real interest in the outcome of this proceeding and has therefore adequately alleged its standing to bring this opposition. See, e.g., *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842 (Fed. Cir. 2000); *Lipton Indus., Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185 (CCPA 1982); *Giersch v. Scripps Networks Inc.*, 90 USPQ2d 1020, 1022 (TTAB 2009).

**Priority**

Because opposer has pleaded ownership of its registrations, and in the absence of a counterclaim for cancellation, opposer need not plead (or prove) his priority of use for the mark BLACK LABEL SOCIETY as used on the goods and services recited in his registrations. (At trial, opposer must properly make of record status and title copies of the pleaded registrations.) See Trademark Rule 2.122(d)(1); *King Candy Co. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108 (CCPA 1974). However, whether or not opposer can establish prior use of its claimed common-law marks THE BLACK LABEL ORDER for fan club services, and the "skull design" for use in connection with "entertainment-related goods and services, including without

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necessary to establish dilution, and cautions opposer to consider

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limitation apparel goods," remains an issue to be determined on the merits based on the evidence of record.<sup>7</sup> Notice of Opposition, ¶ 22. Moreover, if opposer wishes to rely on prior use of the "skull design" mark it must further amend its notice of opposition to provide fair notice of its intent to so rely by identifying each good and service being claimed for use in connection with that mark. See TBMP Section 506.01 (purpose of pleadings is to provide fair notice of the claims and defenses asserted). See Fed. R. Civ. P. 15(a); TBMP Section 507. Opposer's use of the phrase "including without limitation" in identifying goods and services for which it is claiming prior use is inappropriate because it is open-ended, and does not give applicants notice of opposer's alleged rights. See *id.*

***Likelihood of Confusion***

Opposer also contends that applicants' applied-for mark THE BLACK LABEL ORDER TBLO closely resembles opposer's BLACK LABEL SOCIETY, THE BLACK LABEL ORDER, and "skull design" marks, and that its use in connection with the goods recited in applicants' identification of goods would "cause

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carefully whether to maintain these claims.

<sup>7</sup> Because the goods in the subject application and in opposer's pleaded registrations are identical—at least in part—opposer may find it unnecessary to prove his ownership of common-law rights in the BLACK LABEL ORDER mark for goods or services not covered by his registrations. See *In re La Peregrina Ltd.*, 86 USPQ2d 1645, 1647 (TTAB 2008).

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confusion, mistake, or deception" with opposer's mark.

Notice of Opposition, ¶¶ 22, 24, 25 and 30.

Inasmuch as opposer has alleged that registration of applicants' mark is likely to cause confusion, it appears that opposer's claim of likelihood of confusion is sufficiently pleaded.<sup>8</sup>

**Answer**

In their answer, applicants denied the salient allegations of the notice of opposition. The Board noted that the "answer" to paragraph 21 of the notice of opposition, presented substantial argument regarding the merits of the case. Applicants are reminded that an answer should merely state whether the claims of the complaint are admitted or denied, or that applicants are without sufficient information to admit or deny. See 37 CFR § 2.106(b)(1) and 37 CFR § 2.114(b)(1); Fed. R. Civ. P. 8(b); *Hewlett-Packard Co. v. Olympus Corp.*, 931 F.2d 1551, 18 USPQ2d 1710, 1713 (Fed. Cir. 1991). Thus the arguments in applicants' answer will be given no consideration.

(Applicant will have an opportunity to argue the merits of

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<sup>8</sup> To state a claim of likelihood of confusion under Trademark Act Section 2(d), opposer must merely allege facts from which it may be inferred that applicants' applied-for mark so resembles opposer's previously used or registered marks that it is likely that a potential consumer would be confused or mistaken or deceived as to the source of the services of the applicant and opposer. See 15 U.S.C. § 1052(d); *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973); see also TMEP § 1207.01.

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the case at trial or in connection with a dispositive motion.)

Additionally, applicants pleaded twenty-four "affirmative defenses."<sup>9</sup>

Affirmative defenses, like claims in a notice of opposition, must be supported by enough factual background and detail to fairly place the opposer on notice of the basis for the defenses. See *IdeasOne Inc. v. Nationwide Better Health Inc.*, 89 USPQ2d 1952, 1953 (TTAB 2009); *Ohio State Univ. v. Ohio Univ.*, 51 USPQ2d 1289, 1292 (TTAB 1999) (primary purpose of pleadings "is to give fair notice of the claims or defenses asserted"). A party must allege sufficient facts beyond a tender of 'naked assertion[s]' devoid of 'further factual enhancement,' to support its claims. *Ashcroft v. Iqbal*, 556 U.S. 662, 663 (2009), quoting *Bell Atl. Corp. v. Twombly*, 550 U.S. 544, 570 (2007).

Applicants' sixteenth, seventeenth, eighteenth, twenty-first, twenty-second, and twenty-third "affirmative defenses" are insufficiently pleaded. See Fed. R. Civ. P.

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<sup>9</sup> Applicant's twenty-fourth "affirmative defense" is merely a reservation of rights to assert any additional defenses that may become applicable during these proceedings. That is neither an affirmative defense, nor is it effective to reserve such rights. The assertion of any additional claim or defense is governed by Fed. R. Civ. P. 15, whether or not the right to do so has been "reserved."

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12(b)(6). Applicants merely state the defenses without any factual background to support these defenses.

Regarding applicants' sixteenth and twentieth "affirmative defenses" asserting the equitable doctrines of estoppel, waiver, acquiescence and laches, these defenses are severely limited in opposition proceedings, as they begin to run from the time the mark is published for opposition, not from the time of knowledge of use. See *Bausch & Lomb Inc. v. Karl Storz GmbH & Co. KG*, 87 USPQ2d 1526, 1531 (TTAB 2008) (conduct which occurs prior to publication of application for opposition generally cannot support a finding of equitable estoppel); *Barbara's Bakery Inc. v. Landesman*, 82 USPQ2d 1283, 1292 n.14 (TTAB 2007) (defenses of laches, acquiescence or estoppel generally not available in opposition proceeding). Therefore, applicants' alleged actual use of the mark since 2010 without contention by opposer is immaterial to this proceeding.

Applicants' fifteenth, seventeenth, and nineteenth "affirmative defenses" alleging the ornamental nature, loss of rights through naked licensing, and abandonment of opposer's registered marks are **STRICKEN**. The Board will not entertain a defense that attacks the validity of a registration pleaded by a plaintiff unless the defendant timely files a counterclaim. See 37 CFR § 2.106(b); TBMP §§ 311.02(b) and 313 et. seq. (regarding filing

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counterclaims); *Nasalok Coating Corp. v. Nylok Corp.*, 522 F.3d 1320, 86 USPQ2d 1369, 1373 n.3 (Fed. Cir. 2008).

Finally, "affirmative defenses" one through fourteen merely amplify applicants' denials and provide fuller notice of how applicants intend to defend this opposition. See *Ohio State Univ.*, 51 USPQ2d at 1292. Although they are not proper affirmative defenses, we need not strike them.

Accordingly, applicants are allowed **TWENTY DAYS** from the filing of any amended notice of opposition to file an amended answer addressing the cited deficiencies in the answer and "affirmative defenses," or asserting any appropriate counterclaims. If applicants fail to address these issues, the cited affirmative defenses will be stricken from the answer.

Finally, both parties are informed that the exhibits attached to their respective pleadings will not be considered. See Trademark Rule 2.122(c). Therefore, the Board will not consider the parties' exhibits to be a part of the record. If the parties want to rely on this evidence in support of a motion or at trial, they must properly submit the evidence at the appropriate time.

C. Stipulations/Filings

The parties agreed to service of submissions by email. The parties provided the following email addresses:

Papers may be served on opposer at the following email addresses:

vsapphire@cblh.com, trademarks@cblh.com.

Papers may be served on applicants at the following email address:

jim@conceptsinconcert.com.

The parties are reminded that when papers are served by email, they are not entitled to the extra five days for response after service by mail that is allowed under 2.119(c).

The parties are urged to file all submissions through the Board's Electronic System for Trademark Trials and Appeals (ESTTA), available online at:

<http://estta.uspto.gov>.<sup>10</sup> Throughout this proceeding, the parties should review the Trademark Rules of Practice and the Trademark Board Manual of Procedure ("TBMP"), online at: <http://www.uspto.gov/trademarks/process/appeal/index.jsp>.

The Board expects all parties appearing before it to comply with the Trademark Rules of Practice and where applicable, the Federal Rules of Civil Procedure, which may be found online at: <http://www.law.cornell.edu/rules/frcp/>.

D. Accelerated Case Resolution (ACR)

Board proceedings can be modified to streamline discovery or trial procedures. The parties were informed of several stipulations that may be made to more efficiently

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<sup>10</sup> If the parties have questions about or need assistance with ESTTA, they may call the Board at (571) 272-8500 or (800) 786-9199 (toll free) from 8:30 a.m. until 5:00 p.m. EST.

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conduct this proceeding, including: stipulating to facts, e.g. dates of use; limiting the number of interrogatories, document requests, and depositions allowed during the proceeding; stipulating that discovery depositions may be taken by telephone or video conference; or that the parties may submit declarations or affidavits in lieu of oral testimony at trial.

It appears to the Board that opposer's likelihood of confusion claim is relatively straightforward. At least a portion of the goods appear to be legally identical, leaving the similarity of the marks and the fame alleged by opposer as the major issues to be decided. Accordingly, this claim may be well-suited for Accelerated Case Resolution (ACR).

The parties may review the Board's website regarding ACR at:

[http://www.uspto.gov/trademarks/process/appeal/TTAB\\_ACR\\_Options.jsp](http://www.uspto.gov/trademarks/process/appeal/TTAB_ACR_Options.jsp); and

[http://www.uspto.gov/trademarks/process/appeal/Accelerated Case Resolution ACR notice from TTAB webpage 12 22 11.pdf](http://www.uspto.gov/trademarks/process/appeal/Accelerated_Case_Resolution_ACR_notice_from_TTAB_webpage_12_22_11.pdf).

The parties expressed an interest in the possibility of pursuing ACR after discovery has opened. If the parties agree to pursue ACR after exchange of disclosures or discovery, they should notify the interlocutory attorney,

preferably within **SIXTY DAYS** from the opening of the discovery period.<sup>11</sup>

E. Contested Motions

The parties were reminded that they are expected to cooperate during the discovery process. See *HighBeam Mktg. LLC v. Highbeam Research LLC*, 85 USPQ2d 1902 (TTAB 2008); *Sunrider Corp. v. Raats*, 83 USPQ2d 1648, 1654 (TTAB 2007) (parties have a duty to cooperate in resolving discovery issues). The Board requires a good-faith effort, including a telephone conference between the parties, to attempt to resolve all discovery issues, prior to filing a motion seeking relief from the Board. See TBMP Section 408.01(c). The parties are also encouraged to review TBMP Section 414, regarding generally discoverable matters.

Similarly, the parties should attempt to confer prior to filing any other non-dispositive motion, and the non-moving party's consent to the requested relief should be stated in the motion if given. If either party believes it necessary to file an *unconsented* non-dispositive motion to extend or suspend in this case, the moving party must contact the Board interlocutory attorney assigned to the case by telephone upon filing so that the motion can be

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<sup>11</sup> If the parties need more information, or would like to discuss ACR options, a telephone conference with the interlocutory attorney can be arranged.

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resolved promptly by telephone conference, if the Board deems it appropriate.

F. Schedule

The schedule will be reset if, or when, amended pleadings are filed. The next significant due date will be the date the parties' initial disclosures are due. See Fed. R. Civ. P. 26(a)(1)(A)(i) and (ii) regarding required initial disclosures. Neither the service of discovery requests nor the filing of a motion for summary judgment (except on the basis of res judicata or lack of Board jurisdiction) should occur until the parties have exchanged their initial disclosures as required by Fed. R. Civ. P. 26(f). See Trademark Rules 2.120(a)(3) and 2.127(e)(1).

The Board again thanks the parties for their participation in the conference. As a final matter, the Board reminds the parties of their duty to conduct themselves with decorum and courtesy and encourages open communication between the parties during this proceeding. Trademark Rule 2.192; *MySpace Inc. v. Mitchell*, 91 USPQ2d 1060, 1062 n.4 (TTAB 2009).

Proceedings are otherwise **SUSPENDED** pending the filing of amended pleadings by the parties. Dates will be reset upon resumption.

**PRO SE INFORMATION**

A. Representation

The Board notes that applicants currently represent themselves *pro se*, i.e. without assistance from a licensed attorney. It should be noted that, while Patent and Trademark Rule 11.14 permits any party to represent itself, it is advisable for a person who is not acquainted with the technicalities of the procedural and substantive law involved in an opposition proceeding to secure the services of an attorney who is familiar with such matters. The Patent and Trademark Office cannot aid in the selection of an attorney. In addition, as the impartial decision maker, the Board may not provide legal advice, though it may provide general procedural information.

B. Nature of Board Proceedings

An opposition proceeding before the Board is similar in many ways to a civil action in a Federal district court. There are pleadings (notice of opposition, answers, and, sometimes, a counterclaim), a wide range of possible motions; discovery (a party's use of discovery depositions, interrogatories, requests for production of documents and things, and requests for admission to ascertain the facts underlying its adversary's case), a trial, and briefs, followed by a decision on the case. Unlike the case in a civil proceeding, the Board does not preside at the taking

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of testimony. Rather, all testimony is taken by deposition during the assigned testimony, or trial, periods, and the written transcripts, together with any exhibits, are then filed with the Board. No paper, document, or exhibit will be considered as evidence in the case unless it has been introduced in evidence in accordance with the applicable rules.

C. Electronic Resources

All parties may refer to the Trademark Trial and Appeal Board Manual of Procedure ("TBMP"), the Trademark Act, and the Trademark Rules of Practice, all available on the USPTO website, [www.uspto.gov](http://www.uspto.gov). The TTAB homepage provides electronic access to the Board's standard protective order, and answers to frequently asked questions. Other useful resources include the ESTTA filing system<sup>12</sup> for Board filings and TTABVUE for status and prosecution history.

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<sup>12</sup> Use of electronic filing with ESTTA—as the parties have done so far—is strongly encouraged. This electronic file system operates in real time and provides filers with confirmation that the filing has been received. When papers are filed through ESTTA the papers must still be served on the other party to the proceeding.

If the parties have questions about or need assistance with ESTTA, they may call the Board at (571) 272-8500 or (800) 786-9199 (toll free) from 8:30 a.m. until 5:00 p.m. (EST).

While electronic filing is preferred, papers may also be filed by mail. The parties should refer to TBMP §§ 107-111 for information on filing by mail. If ESTTA filing is not possible for any reason, the filer should submit its papers by mail, with a certificate of mailing. See TBMP § 110 et. seq.

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Compliance with the Trademark Rules of Practice, and where applicable the Federal Rules of Civil Procedure, is expected of all parties before the Board, whether or not they are represented by counsel.

D. Service of Papers

Trademark Rule 2.119(a) and (b) require that every paper filed in the Patent and Trademark Office in a proceeding before the Board must be served upon the attorney for the other party, or the other party itself, if unrepresented, and proof of such service must be made before the paper will be considered by the Board. Consequently, copies of all papers which applicants may file in this proceeding must be accompanied by a signed statement indicating the date and manner in which such service was made. The statement, whether attached to or appearing on the paper when filed, will be accepted as *prima facie* proof of service.

The following is an example of an acceptable Certificate of Service:

**Certificate of Service**

The undersigned certifies that a copy of the attached <describe filing> was served, by first class mail, upon opposer at the following address:

Victor K. Sapphire, Esq.  
Novak Druce Connolly Bove + Quigg LLP  
333 S Grand Avenue, 23<sup>rd</sup> Floor  
Los Angeles, CA 90071,

on <insert date>.

/James A. Baltutis/