

ESTTA Tracking number: **ESTTA546888**

Filing date: **07/03/2013**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91209637
Party	Defendant James A. Baltutis, Mark Ferguson
Correspondence Address	JAMES A BALTUTIS PO Box 464 Burbank, CA 91503-0464 UNITED STATES jim@conceptsinconcert.com
Submission	Answer and Counterclaim
Filer's Name	James A. Baltutis
Filer's e-mail	jim@conceptsinconcert.com
Signature	/James A. Baltutis/
Date	07/03/2013
Attachments	TBLOAMENDEDEDANSWER7313.pdf(347317 bytes )

Registration Subject to the filing

Registration No	3518532	Registration date	10/14/2008
Registrant	Wylde, Zakk P.O. Box 1787 Canyon Country, CA 91386 UNITED STATES		

Goods/Services Subject to the filing

Class 025. First Use: 2005/07/18 First Use In Commerce: 2005/07/18

All goods and services in the class are requested, namely: Clothing, namely, shirts, panties, lingerie, underpants, undershirts, t-shirts, bras, brassieres, camisoles, halter tops, gloves, bandannas, aprons, cloth jackets, jerseys; headwear, namely, hats, and caps, all of the foregoing associated with the well-known entertainer Zakk Wylde

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In the Matter of Trademark Application Serial No. 85541606  
Published in the *Official Gazette* February 05, 2013

Zakk Wylde,

Opposer,

v.

Mark Ferguson DBA All Access Entertainment  
LLC

and

James A. Baltutis DBA Concepts In Concert  
Applicants.

Opposition No. 91209637

Mark:

**THE BLACK LABEL  
ORDER TBLO (and Design)**

**ANSWER TO AMENDED NOTICE OF OPPOSITION, AFFIRMATIVE DEFENSES,  
AND COUNTERCLAIM**

The following is the Answer of Applicants Mark Ferguson DBA All Access Entertainment LLC and James A. Baltutis DBA Concepts In Concert, having a business address at PO Box 464, Burbank, California 91503 (hereinafter "Applicant"), owners of Federal Trademark Application Serial No. 85541606 for the mark THE BLACK LABEL ORDER TBLO (hereinafter "Applicant's Mark"), to the Amended Notice of Opposition filed on June 13, 2013 by Zakk Wylde (hereinafter "Zakk Wylde or "Opposer"), and assigned Opposition No. 91209637.

1. Applicant admits the allegations of Paragraph 1 of the Amended Notice of Opposition.
2. Applicant admits the allegations of Paragraph 2 of the Amended Notice of Opposition.
3. Applicant is without knowledge or information sufficient to form a belief as to the truth of allegations contained in paragraph 3 of the Amended Notice of Opposition. Since Applicant can neither admit nor deny the paragraph as written, Applicant must deny.

4. Applicant admits that Black Label Society has appeared on national television in live performance. Applicant is without knowledge or information sufficient to form a belief based to the truth of the remaining allegations of Paragraph 4 and therefore denies the same.
5. On information and belief, Applicant can only admit Opposer has “co-written” and published in 2012 an autobiography, “Bringing Metal to the Children. Applicant is without knowledge or information sufficient to form a belief based to the truth of the remaining allegations of Paragraph 5 and therefore denies the same.
6. Applicant is without knowledge or information sufficient to form a belief as to the truth of allegations contained in paragraph 6 of the Amended Notice of Opposition. Since Applicant can neither admit nor deny the paragraph as written, Applicant must deny.
7. Applicant is without knowledge or information sufficient to form a belief as to the truth of allegations contained in paragraph 7 of the Amended Notice of Opposition. Since Applicant can neither admit nor deny the paragraph as written, Applicant must deny.
8. Applicant is without knowledge or information sufficient to form a belief as to the truth of allegations contained in paragraph 8 of the Amended Notice of Opposition. Since Applicant can neither admit nor deny the paragraph as written, Applicant must deny.
9. Applicant is without knowledge or information sufficient to form a belief as to the truth of allegations contained in paragraph 9 of the Amended Notice of Opposition. Since Applicant can neither admit nor deny the paragraph as written, Applicant must deny.
10. Applicant admits the allegation of Paragraph 10 of the Amended Notice of Opposition that Opposer is the owner of U.S Registration 3518532 for BLACK LABEL SOCIETY. On information and belief, Applicant denies the allegation in Paragraph 10 of the Amended Notice of Opposition that Opposer’s alleged Mark is currently in connection

with all of the goods cited by Opposer in Class 025.

11. Applicant is without knowledge or information sufficient to form a belief as to the truth of allegations contained in paragraph 11 of the Amended Notice of Opposition. Since Applicant can neither admit nor deny the paragraph as written, Applicant must deny
12. Applicant admits the allegation of Paragraph 12 of the Amended Notice of Opposition that Opposer is the owner of U.S Appl. Ser. No. 86600717 for BLACK LABEL COMEDY HOUR. On information and belief, Applicant denies the allegation in Paragraph 12 of the Amended Notice of Opposition that Opposer's alleged Mark is currently in connection with all of the goods cited by Opposer.
13. Applicant is without knowledge or information sufficient to form a belief as to the truth of allegations contained in paragraph 13 of the Amended Notice of Opposition. Since Applicant can neither admit nor deny the paragraph as written, Applicant must deny.
14. Applicant denies the allegations of Paragraph 14 of the Amended Notice of Opposition and demands strict proof thereof.
15. Applicant admits the allegations of Paragraph 15 of the Amended Notice of Opposition.
16. Applicant admits the allegations of Paragraph 16 of the Amended Notice of Opposition.
17. Applicant denies the allegations of Paragraph 17 of the Amended Notice of Opposition and demands strict proof thereof.
18. Applicant denies the allegations of Paragraph 18 of the Amended Notice of Opposition and demands strict proof thereof.
19. Applicant denies the allegations of Paragraph 19 of the Amended Notice of Opposition as phrased and demands strict proof thereof.
20. Applicant denies the allegations of Paragraph 20 of the Amended Notice of Opposition and demands strict proof thereof.

21. Applicant denies the allegations of Paragraph 21 of the Amended Notice of Opposition as phrased and demands strict proof thereof.
22. Applicant denies the allegations of Paragraph 22 of the Amended Notice of Opposition and demands strict proof thereof.
23. Applicant denies the allegations of paragraph 23 that they “misappropriated the words THE BLACK LABEL ORDER from Opposer” and that the design elements of Applicants mark are a prominent feature of Opposer’s BLACK LABEL SOCIETY live performances and merchandising. Applicant admits the remaining allegation of paragraph 23 as written by the Opposer in the Amended Notice of Opposition, that “Applicant has used the identical skull design for many years prior to the alleged date of first use in interstate commerce as stated in the ‘606 Appl.’”
24. Applicant denies the allegations of Paragraph 24 of the Amended Notice of Opposition and demands strict proof thereof.
25. Applicant denies the allegations of Paragraph 25 of the Amended Notice of Opposition and demands strict proof thereof.
26. Applicant denies the allegations of Paragraph 26 of the Amended Notice of Opposition and demands strict proof thereof.
27. Applicant denies the allegation of Paragraph 27 of the Amended Notice of Opposition as phrased and demands strict proof thereof.
28. Applicant denies the allegations of Paragraph 28 of the Amended Notice of Opposition and demands strict proof thereof.
29. Applicant denies the allegations of Paragraph 29 of the Amended Notice of Opposition and demands strict proof thereof.
30. Applicant denies the allegations of Paragraph 30 of the Amended Notice of

Opposition and demands strict proof thereof.

31. Applicant denies the allegations of Paragraph 31 of the Amended Notice of Opposition and demands strict proof thereof.
32. Applicant denies the allegations of Paragraph 32 of the Amended Notice of Opposition and demands strict proof thereof.
33. Applicant denies the allegation of Paragraph 33 of the Amended Notice of Opposition and demands strict proof thereof.
34. Applicant admits the allegations of Paragraph 34 of the Amended Notice of Opposition.
35. Applicant denies the allegation of Paragraph 35 of the Amended Notice of Opposition and demands strict proof thereof.
36. Applicant denies the allegation of Paragraph 36 of the Amended Notice of Opposition and demands strict proof thereof.
37. Applicant denies the allegation of Paragraph 3 of the Amended Notice of Opposition and demands strict proof thereof.
38. Applicant denies the allegation of Paragraph 38 of the Amended Notice of Opposition and demands strict proof thereof.
39. Applicant denies the allegation of Paragraph 39 of the Amended Notice of Opposition and demands strict proof thereof.
40. Applicant denies the allegations of Paragraph 40 of the Amended Notice of Opposition and demands strict proof thereof.
41. Applicant denies the allegations of Paragraph 41 of the Amended Notice of Opposition and demands strict proof thereof.
42. Applicant denies the allegation of Paragraph 42 of the Amended Notice of Opposition and demands strict proof thereof.

43. Applicant denies the allegation of Paragraph 43 of the Amended Notice of Opposition.

44. Applicant admits the allegation of Paragraph 44 of the Amended Notice of Opposition and notes that the USPTO examination of Applicant's mark as referenced, is ongoing.

45. Applicant denies the allegations of Paragraph 45 of the Amended Notice of Opposition.

46. Applicant denies the allegations of Paragraph 46 of the Amended Notice of Opposition.

47. Applicant denies the allegations of Paragraph 47 of the Amended Notice of Opposition.

48. Applicant denies the allegation of Paragraph 48 of the Amended Notice of Opposition.

### **AFFIRMATIVE DEFENSES**

To further answer the Amended Notice of Opposition, Applicant asserts that:

#### **AFFIRMATIVE DEFENSE NO. 1:**

Applicant's THE BLACK LABEL ORDER TBLO & Design mark, U.S. Application Number 85541606 is distinctively different in appearance, sound, connotation, and mental impression from the standard character marks alleged by Opposer in the Amended Notice of Opposition, and is unlikely to suggest a false connection with regard to Opposer's alleged standard character marks.

#### **AFFIRMATIVE DEFENSE NO. 2:**

Applicant's THE BLACK LABEL ORDER TBLO & Design mark, U.S. Application Number 85541606 does not point uniquely and unmistakably to Opposer's identity or alleged persona.

#### **AFFIRMATIVE DEFENSE NO. 3:**

Applicant's THE BLACK LABEL ORDER TBLO & Design mark, U.S. Application Number 85541606 is not the same name, or identifier as allegedly used by the Opposer. Nor does it falsely suggest a connection to Opposer's alleged institution i.e., fan club.

AFFIRMATIVE DEFENSE NO. 4

Applicant's THE BLACK LABEL ORDER TBLO & Design mark, U.S. Application Number 85541606 is marketed to a select consumer group that Opposer is not targeting, and therefore has no claim to. Additionally, "BLACK LABEL" is a common phrase used in commerce by third parties in relation to providing goods of stature, high-end quality, and price point marketed at affluent customers who are willing to pay a premium for the goods and services similarly offered by the Applicant. Opposer's goods are marketed to a different demographic of customers than that of Applicant's.

AFFIRMATIVE DEFENSE NO. 5:

Opposer's claim of extensive, continuous and longstanding substantially exclusive use of the "skull design" it allegedly claims to have priority rights for in the Amended Notice of Opposition is not a valid claim, because Opposer fails to identify each good and service in connection with the said "skull design," as required (See Fed. R. Civ.P. 15(a); TBMP Section 507).

AFFIRMATIVE DEFENSE NO. 6:

Opposer's claim of extensive, continuous and longstanding substantially exclusive use of the "skull design" in Opposer's Amended Notice of Opposition is questionable, considering another far more famous, and internationally well-known recording artist called Thirty Seconds To Mars, fronted by musician, songwriter and actor Jared Leto, holding U.S. Registration Number 3746782, has used essentially the same skull design on their recorded music named in Class 009 of their registration, and on goods and services named in Class 025 of their registration. These usages of the "skull design" are in the same class of goods and services as Opposer's U.S. Registration Number 3518532, and demonstrate the usage of the "skull design" as indicated by Opposer is not substantially exclusive.

AFFIRMATIVE DEFENSE NO. 7:

Opposer's claim of extensive, continuous and longstanding substantially exclusive use of the skull design depicted in Exhibit "A" in Opposer's Amended Notice of Opposition should not be considered, as it's use is ornamental on Opposer's goods, and it is not a design feature of Opposer's U.S. Registration Number 3518532.

AFFIRMATIVE DEFENSE NO. 8:

Opposer has lost any actual or potential rights to the mark-at-issue by virtue of its naked license and/or naked assignment. Correspondence exists that outlines Opposer's relationship with Applicant, via "permission" from the official licensor (Bravado) of Opposer's U.S. Mark, Registration Number 3518532, at the time. Based on information and belief from Opposer, Applicant believed that Bravado was in possession of the Opposer's master license of U.S. Registration Number 3518532, particularly in regards to Class 025 in the registration. Applicant obtained not only permission from Opposer, but also permission from Bravado to utilize Opposer's name and likeness in a marketing arrangement between the entities. No restrictions, quality control measures, style or usage guides, or any other specific instructions were provided to Applicant either from Bravado or Opposer. This relationship between Applicant's company and Bravado was an effort to promote the Opposer in a more effective and unique way than Bravado was capable of- or willing to do- under certain circumstances. This came to fruition as a result of the Applicant's predecessor in a similar role failing to deliver all the business components requested of them from Opposer, as well as failing to offer Opposer's fans all they had promised them under the terms of their purchase. As such, and with no restrictions placed on Applicant by Opposer, or Opposer's presumed master licensor Bravado, Applicant proceeded to create a business entity, doing business under the BLS Nation name, independently of both Opposer and Bravado and with its own capital

investment. Applicant proceeded to invest money, time and other resources at substantial loss, while and building components of what would eventually pivot into Applicant's The Black Label Order TBLO after a change in name only. Applicant then formalized the subsequent endorsement relationship with Opposer, even offering Opposer part ownership of the business, of which the Opposer declined, citing their presumed liability if someone were to "get hurt" during the course of business operations, preferring Applicant's companies handled it independently of Opposer, which they did so admirably. This correspondence, and subsequent arrangement shows the Opposer's willingness to proceed under the conditions and term agreed upon with Applicant, while also demonstrating a lack of control over Opposer's alleged Black Label Society mark and its usage. Additionally, it points out Opposer's inclination to profit from Bravado's naked licensing and assignment of their alleged Black Label Society mark to the Applicant for usage prior to, and after the Applicant's creation of The Black Label Order mark as a business entity independent of both Opposer and Bravado. Applicant, even while possessing a no restriction license, ironically chose not to use any pre-existing names or art elements that were granted in the creation of The Black Label Order, contrary to claims made in the Opposer's Amended Notice of Opposition. This goodwill gesture was made not only in order to avoid any possible erosion with Opposer's core-brand, but to build a platform of premium goods and services not offered by Opposer, independent and without conflict in respect to Bravado and Opposer and with cooperation of both. This further example of this business relationship with Opposer illustrates Applicant's due diligence regarding its own brand protection, and preservation, while creating a mark that would not be confused with and/or compete with any existing intellectual property allegedly owned by Opposer and his licensor.

AFFIRMATIVE DEFENSE NO. 9:

Opposer has lost rights to its U.S. Registration Number 3518532 in Class 025, by virtue of its naked license and/or naked assignment. Applicant has, on information and belief discovered multiple instances of Opposer's failure to exercise adequate quality control over a licensee's use of Opposer's U.S. Registration Number 3518532 for Black Label Society in reference to GS Class 025. These failures by the Opposer to police and maintain stringent quality control over their intellectual property date as far back as 2004. Ironically, Opposer has included one such glaring instance, relating to a failed licensing arrangement with "357 Customs" in their Amended Notice of Opposition as depicted in their Exhibit "A." On Applicant's information and belief, it is clear that the Opposer, after collecting advance monies in the sum of \$50,000.00, collaborated on, and introduced to their fans and customers, products that were not consistent with Opposer's official licensed merchandiser's product and quality which bore their name, with regards to look and feel, and price point. Opposer then failed to maintain adequate quality control of his name, likeness, and reputation it related to the agreement with 357 Customs, the creation and promotion of goods and services of which fall into the G&S Class 25 of Opposer's current registration, and also as they were marketed via his own properties, such the official website controlled by Opposer. This failure is clearly demonstrated on Opposer's own website, of which Applicant has obtained from that time period, which has Opposer promoting and advertising said goods and promotions for nearly a half year. After a breakdown in the agreement, based on, and by Opposer's own admittance of their failure to adequately police their own licensing arrangement effectively, created chaos amongst those who purchased products and never received them, even though they were endorsed by, positioned on Opposer's official website and elsewhere. Opposer, to save face with his fan base, went so far as to place the entire blame on 357 Customs for the oversight, as far reaching as that may sound, and subsequently filed a lawsuit on June 14,

2006 (Case No. BC353738) in the SUPERIOR COURT OF THE STATE OF CALIFORNIA FOR THE COUNTY OF LOS ANGELES. This lawsuit states in clear terms Opposer's own failure to police the licensor's products bearing Opposer's names and likeness, and promotion of such items which typically are found in Class 025 registrations, including Opposer's. This legal document establishes the first clear example of Opposer's ignorance of the procedures it must follow to protect its own intellectual property, and shield their trademark from possible cancellation in the future. In another example, long after Opposer's mark obtained U.S. Registration Number 3518532 in regards to Class 025 of the registration, the Applicant's own customer service department was often contacted by Opposer's fans who purchased product from other companies who had entered licensing arrangements with the Opposer primarily for products in GS Class 025 of their "Black Label Society" U.S. Registration Number 3518532, mark. Examples of these customer service issues are in relation to quality and fit of products, previously unreturned customer service calls, and non-delivery of items ordered from the official online store. In nearly all instances, the Applicant's worked diligently to assist all of the competitor's customers who had issues by fast tracking their claims to the correct person at the competing company, which came at Applicants time and great expense. Little or no assistance was offered to the Applicant by the Opposer in regards to such issues; however Opposer gained significant goodwill with fans as a result of these efforts. Applicant did this to preserve goodwill between Opposer as a paid endorser of Applicant's products, and his relationship with his fans, as it would further benefit the Applicant's notoriety as a company that in Opposer's words, "Got It Done." Eventually Opposer realized the value of this goodwill by Applicant, and subsequently applauded Applicant in return for Applicant stepping up and protecting its brand when Opposer, and its related licensees, failed to so on certain occasions. Additionally, other

examples of Opposer's habitual naked licensing arrangements can be presented, along with Opposer's consistent failure as owners of their mark to maintain the quality of goods their customer has come to expect, during the discovery process. These "arrangements" include wide permission to use Opposer's marks in a loose fashion to promote goods and services with a leather company, a company that handles merchandise (and events) and more.

AFFIRMATIVE DEFENSE NO. 10:

Opposer's claims in its Amended Notice of Opposition are barred to the extent he has forfeited or abandoned his alleged intellectual property. Applicant was shocked to learn on July 13, 2012 Opposer had posted a message on his public verified Twitter account, of which he has many fans "following" him for news and information letting "it be known in no uncertain terms that BLACK LABEL SOCIETY," and himself "were no longer affiliated" with Applicant's business, naming THE BLACK LABEL ORDER TBLO property in particular, all while currently engaged in an ongoing business relationship with Applicants as a paid endorser of their product.

AFFIRMATIVE DEFENSE NO. 11:

Opposer's Amended Notice of Opposition and each cause of action therein are barred in whole or in part by the doctrine of waiver. Applicant has multiple correspondences with Opposer's acting manager and at the time self-described "head of merchandising" for Opposer that confirms the relationship with Applicant's business in clear terms, indicating Opposer does not own The Black Label Order TBLO. This further demonstrates Opposer has no standing now, prior or in the future in regards to ownership of the Applicant's The Black Label Order TBLO business, intellectual property, or mark.

AFFIRMATIVE DEFENSE NO. 12:

Opposer is barred by the Doctrine of Unclean Hands. Applicant has observed and

documented many instances of Opposer misleading Applicant's customer base through false and defaming statements made via online social media posts controlled by Opposer. These harmful statements have falsely suggested wrongdoing by Applicant, while also presenting misleading information to a confused customer base that they would soon be "grandfathered" into an alleged new and improved business that had yet to be created by Opposer. Defamatory, groundless, misleading and more, those statements have caused great damage to Applicant's business, and subsequently damaged years of goodwill between Applicant's The Black Label Order TBLO business, and their customers while creating an improper restraint of trade in the process. Additionally, Opposer has yet to deliver on its promise of creating its alleged new business at the time of this filing, further misleading customers of Applicant's and creating an atmosphere of confusion around Applicant's business.

AFFIRMATIVE DEFENSE NO. 13:

The original Notice of Opposition was filed for an improper purpose, abuse of process execution. Applicant was dismayed to see that soon after the Opposer abruptly ended the endorsement deal with Applicant, they subsequently tried, and failed, to launch a replacement entity of their own called The Black Label Illuminati. After an overwhelming negative outcry from fans regarding the name, and lack of commitment by Opposer, the new business failed to materialize in a form the Opposer had promised. It was also around this time the Opposer filed the original Notice of Opposition. Through information and belief, this action was designed to restrain the Applicant's market for their goods and the consumer goodwill that Opposer so often relished in, based on Applicant's previous professional execution, capitol investment and sweat equity running Applicant's The Black Label Oder TBLO business.

AFFIRMATIVE DEFENSE NO. 14:

Opposer at one time was connected with Applicant's The Black Label Order TBLO business via an endorsement arrangement that was terminated by the Opposer. Since the end of the relationship, Applicant has distanced itself from Opposer through various strategic marketing initiatives, and cannot be held responsible for any lingering association post-endorsement agreement. Additionally, Opposer wrongfully continued to connect back to the Applicant's business, on social marketing initiatives like Facebook.com. This error, which continued to name Applicant's business as "official" falsely represented Applicant's business relationship with Opposer as an official endorser, long after Opposer ended the agreement with a calculated and public termination of the relationship. On information and belief it took until approximately February 2013, nearly one year after the Opposer's abrupt end of their relationship with Applicant, and just prior to the filing of the original Notice of Opposition, for them to fix this glaring oversight. With nearly one million Facebook "LIKE'S" i.e., FANS, it is quite clear any lingering confusion about Applicant's relationship with Opposer and related goods and services is likely due to Opposer's continued brand and marketing mismanagement. In an effort to distance itself from Opposer, the Applicant was not aware of this crucial error on Opposer's part, or would have taken the appropriate steps to have Opposer remedy via the appropriate methods immediately.

COUNTER CLAIM TO CANCEL REGISTRATION No. 3518532 in

INTERNATIONAL CLASS 025

1. Applicant repeats and realleges, as if fully set forth herein, each and every allegation contained in the foregoing paragraphs.
2. Applicant hereby seeks cancellation of Opposer's U.S Registration 3518532 issued October 14, 2008 for the work mark BLACK LABEL SOCIETY in International Class

025 for the application filed on July 18, 2005.

3. Applicant further denies that the Opposer's U.S Registration 3518532 is currently in connection with all of the goods cited by Opposer in Class 025.
4. Applicant reaffirms Opposer has lost any actual or potential rights to U.S Registration 3518532 in connection with Class 025 by virtue of its multiple instances of naked license and/or naked assignment.

PRAYER

WHEREFORE, Applicant prays that the Trademark Trial and Appeal Board dismiss the Amended Notice of Opposition with prejudice, cancels the Opposer's U.S. Registration Number 3518532 in Class 025, and permits registration of Applicant's Mark in Application Serial Number 85541606 in the United States Patent and Trademark Office.

Applicant has submitted the required fee in this filing.

Dated: July 3, 2013

Respectfully submitted,

By: /James A. Baltutis/

---

James A. Baltutis  
Mark Ferguson  
Applicants

PO Box 464  
Burbank CA 91503  
Phone: (818) 802-5176  
[jim@conceptsconcert.com](mailto:jim@conceptsconcert.com)

**CERTIFICATE OF SERVICE**

I hereby certify that a true and accurate copy of this ANSWER TO AMENDED NOTICE OF OPPOSITION has been served on the following by email to: vsapphire[at]cblh.com and trademarks[at]cblh.com on July 3, 2013, as agreed upon during the discovery conference on May 8, 2013. I am also submitting as a courtesy via First Class Mail, postage prepaid, to counsel for 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

Dated: July 3, 2013

By: /James A. Baltutis/

James A. Baltutis