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

Proceeding	91209857
Party	Plaintiff Deford Bailey LLC
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Deford Bailey LLC,	)
Opposer,	) **Opposition No. 91209857**
	)
v.	) **Application Serial No. 85304626**
	)
Carlos Deford Bailey	) **Published in the Official Gazette on**
Applicant.	) **February 19, 2013**

OPPOSER'S REPLY IN FURTHER SUPPORT OF MOTION FOR SUMMARY JUDGMENT AND RESPONSE IN OPPOSITION TO APPLICANT'S MOTION FOR JUDGMENT ON THE PLEADINGS

Opposer, Deford Bailey LLC, submits this reply in further support of its motion for summary judgment and response in opposition to Applicant's Motion for Judgment on the Pleadings.

As an initial matter, Applicant contends that Opposer's Amended Notice of Opposition should be dismissed because Applicant has not filed a Motion for Leave to Amend. As the Board has since noted, Opposer filed its Amended Notice of Opposition pursuant to the Board's leave to do so; no motion was necessary, nor did Opposer file one or mislabel its Amended Notice of Opposition as a Motion for Leave to Amend.

Opposer amended its Notice of Opposition to add as a further basis for rejecting Applicant's application for registration of the mark DEFORD BAILEY that Applicant does not own the mark and is an admitted licensee of the mark in connection with harmonicas. This amendment, plus the other amendments in Opposer's Amended Notice of Opposition, correct all determined deficiencies of the Board.

Most notably, Opposer, as an owner of the name and likeness rights of DeFord Bailey, the admitted individual (a harmonica prodigy and former member of the Grand Ole Opry) whose

name Applicant intends to invoke with the mark DEFORD BAILEY that it seeks to register in connection with harmonicas, has standing to pursue this action. Opposer has pled and demonstrated that it has licensed the name in connection with the use of harmonicas, indeed, to one of Applicants. In a comparable case, *Stathopoulos v. MC MC S.R.L.*, 2010 TTAB LEXIS 321 (TTAB July 21, 2010), the Board held:

> Opposer's claim of damage is based on his assertion that he has authority to exercise the publicity rights in the name and likeness of the deceased Maria Callas. The record reflects that he exercises, through international licensing agencies, a degree of control over the commercial use of the wording MARIA CALLAS, and her likeness, for goods and/or services in various countries, including the United States, and that such use through licensees inures to the benefit of opposer. In view thereof, opposer has established facts that are sufficient to demonstrate that he possesses an interest in this proceeding that is beyond that of the general public. *See Lipton Indus., Inc. v. Ralston Purina Co*., 670 F.2d 1024, 213 USPQ 185, 188 (CCPA 1982). Moreover, opposer need not assert a proprietary right in the mark in order to have standing. *See Jewelers Vigilance Committee Inc. v. Ullenberg Corp*., 823 F.2d 490, 2 USPQ2d 2021, 2024 (Fed. Cir. 1987). Thus, we find that there is no genuine issue of material fact as to opposer's standing to bring this proceeding, and summary judgment with respect to this issue is granted.

Id. at **9-10.

Further, Applicant has admitted by its filing that it is not the owner of the mark, and it has failed to rebut with any proof Opposer's proof of the same. It is fundamental that the applicant must be the owner of the mark. *Holiday Inn v. Holiday Inns, Inc.*, 534 F.2d 312, n.6, 189 U.S.P.Q. 630, n.6 (C.C.P.A. 1976) ("One must be the owner of a mark before it can be registered."); T.M.E.P. § 1201.02(b) (1993) ("The applicant must be the owner of the mark for which registration is requested. If the applicant does not own the mark on the application filing date, the application is void."); *National Board for Cert. in Occup. Therapy v. American Occup. Therapy Assoc.*, 24 F. Supp. 2d 494, 49 U.S.P.Q.2d 1010 (D. Md. 1998) ("Only the owner of a trademark may register that mark with the Patent and Trademark Office."); *see also* 3 McCarthy on Trademarks and Unfair Competition 19:53 (4th ed.). Further:

> [a] person merely using the mark under license from the owner cannot be the valid applicant or registrant. In a license relationship, the licensor is the party who does the controlling and must be the applicant for registration. As Chief Judge Nies of the Federal Circuit noted, Lanham Act § 1 requires that only the owner of the mark apply for registration: "Nothing in section 5 [relating to licensing] confers a right to register on a non-owner."

Id. (citing, *inter alia*, T.M.E.P. § 1201.02; *In re Wilson Jones Co.*, 337 F.2d 670, 143 U.S.P.Q. 238 (C.C.P.A. 1964)).

Nowhere in its response to Opposer's motion for summary judgment has Applicant even attempted to argue that it owns the mark. Instead, it argues that the other two heirs to the name and likeness rights of DeFord Bailey, Sr. do not object to Opposer's registration. Applicant, however, has not submitted any record proof supporting this contention, nor has it taken any discovery in connection with this contention despite the opportunity to do so.

As for its failure to take discovery, as Applicant recognizes, Opposer filed its motion for summary judgment (rightfully, despite Applicant's suggestion otherwise) at the end of the discovery period. Despite ample opportunity to do so, Applicant took no discovery during that entire period, serving no written discovery requests and noticing no depositions. The only evidence Applicant has submitted in support of its contentions is the affidavit of Applicant's attorney, not even the declaration of either Applicant and certainly not the declarations of the other heirs.

Applicant questions the ownership rights of Opposer and the validity of the license Applicant Carlos Bailey signed. Applicant suggests that, if it could pursue discovery on such issues or have more time to submit affidavits, it would prove that Opposer does not have ownership rights and that the license is invalid. Applicant, however, again, has had every opportunity to take discovery and submit affidavits and has not done so. A motion for summary judgment is a pretrial device intended to save the time and expense of a full trial when the

moving party is able to demonstrate, prior to trial, that there is no genuine dispute of material fact, and that it is entitled to judgment as a matter of law. *Hershey Chocolate & Confectionery Corp. v. Wiesen*, 2013 TTAB LEXIS 628, **4-5 (TTAB Dec. 27, 2013) (citing Fed. R. Civ. P. 56(a); *Celotex Corp. v. Catrett,* 477 U.S. 317, 106 S. Ct. 2548, 91 L. Ed. 2d 265 (1986); *Opryland USA Inc. v. Great American Music Show Inc.,* 970 F.2d 847, 23 USPQ2d 1471 (Fed. Cir. 1992); *Sweats Fashions Inc. v. Pannill Knitting Co. Inc.,* 833 F.2d 1560, 4 USPQ2d 1793 (Fed. Cir. 1987)). Applicant should not be entitled at this juncture to reopen discovery to engage in a fishing expedition.

Opposer has submitted record evidence that Applicant Carlos Bailey has admitted to signing a license agreement with Opposer acknowledging that he does not have any right to the name DEFORD BAILEY and shall make no claim of ownership or interest in the name, and that a license from Opposer is required to use the name in connection with the sale of harmonicas. (Previously submitted Declaration of Amy J. Everhart, Ex. 1 (Opposer's Requests for Admission) & Ex. A thereto (Name and Likeness License Agreement), and Ex. 2 (Applicant's Response to Opposer's Request for Admission No. 5).) Applicant has failed to rebut this proof with any record proof of its own and thus summary judgment should be granted in favor of Opposer.

> If the moving party is able to meet this initial burden, the burden shifts to the nonmoving party to demonstrate the existence of specific genuinely disputed facts that must be resolved at trial. The nonmoving party may not rest on mere allegations or assertions but must designate specific portions of the record or produce additional evidence showing the existence of a genuine dispute of material fact for trial. Should the nonmoving party fail to raise a genuine dispute of material fact as to an essential element of the moving party's case, judgment as a matter of law may be entered in the moving party's favor.

Hershey Chocolate & Confectionery Corp., 2013 TTAB LEXIS 628, **4-5.

> It is incumbent on the party against whom the motion is asserted to come forward with countervailing affidavits or evidence showing that there is an issue of fact or law. That is, a party opposing a motion for summary judgment cannot merely rely upon the allegations of its pleading and hold back its evidence.

3 McCarthy on Trademarks and Unfair Competition 20:132 (4th ed.) (citing *Spin Physics, Inc. v. Matsushita Electric Industrial Co.*, 168 U.S.P.Q. 605 (T.T.A.B. 1970); *Wilson Sporting Goods Co. v. Northwestern Golf Co.*, 172 U.S.P.Q. 182 (T.T.A.B. 1971 (motion for summary judgment granted for cancellation petitioner where registrant offered no counter affidavits); *Conde Nast Publications, Inc. v. Miss Quality, Inc.*, 170 U.S.P.Q. 364 (T.T.A.B. 1971); *Franz Volkl Ohg v. Volkl 7 Co. KG*, 173 U.S.P.Q. 765 (T.T.A.B. 1972) (summary judgment granted for opposer where applicant did not respond with affidavits). Applicant has proven no dispute as to any material fact in this instance because Applicant has failed to come forth with any evidence to rebut Opposer's evidence of its own standing and Applicant's non-ownership of the mark and acknowledgement of Opposer's ownership.

As for Applicant's attempt to create a factual issue as to "[w]here Deford Bailey III authorized the filing of the subject trademark registration," Opposer has not moved for summary judgment on its fraud claim. Even if it had, the only evidence Applicant submits in support of its contention that Deford Bailey III did authorize the filing is the Affidavit of counsel of record; Opposer has submitted the declaration of Deford Bailey III himself stating he did not authorize the filing. The self-serving affidavit of counsel of record, the very individual accused of submitting the application without authorization, is not sufficient to create a material question of fact. Notably, Applicant has failed to come forth with an affidavit of Deford Bailey III acknowledging his authorization. Even if Applicant did so now, such affidavit would contradict the only declaration of record stating the exact opposite.

Applicant's penultimate "disputed fact" is not a disputed fact at all but instead essentially a request for an extension of time to take discovery or obtain affidavits in support of its argument. As set forth above, Applicant's time to submit its affidavits was in conjunction with the filing of its response. Applicant has failed to secure affidavits from purportedly one of the Applicants himself as well as the two other heirs that Applicant suggests do not oppose the filing. Further, as stated above, Applicant has not bothered to take any discovery to this point, and it should not be granted a further opportunity to do so at this juncture. Opposer has submitted a signed document by one of Applicants acknowledging Opposer as one of the heirs to the name and likeness rights. Opposer has made no effort to notice the depositions of either member of the Opposer LLC, either DeFord Bailey Jr. while he was living or Shemika Wiley, nor has Opposer requested documents, information or admissions from Opposer or anyone else.

Finally, the question whether the other heirs' permission is required for this opposition actually only underscores Opposer's position, acknowledging that it is the heirs, and not Applicants, who own the DEFORD BAILEY name and likeness rights and whose rights (along with Opposer) will be affected if Applicant is permitted to register the mark.

CONCLUSION

For the reasons stated herein, summary judgment should be granted in favor of Opposer on its Amended Notice of Opposition, Applicant's motion for judgment on the pleadings should be denied, and Applicants' application, Serial No. 85304626, should be rejected.

Respectfully submitted,

Deford Bailey LLC, the Opposer

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Date: April 4, 2014

CERTIFICATE OF SERVICE

The undersigned certifies that the foregoing document was served via electronic mail on this 4th day of April, 2014.

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