

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451
General Contact Number: 571-272-8500

Baxley

Mailed: August 22, 2014

Opposition No. 91209857

Deford Bailey LLC

v.

Carlos Deford Bailey and Deford
Bailey III

Before Kuhlke, Lykos and Hightower,
Administrative Trademark Judges.

By the Board:

Carlos Deford Bailey (“Carlos”) and Deford Bailey III (“Bailey III”), as joint Applicants (collectively referred to as “Applicants”), filed an application to register the mark DEFORD BAILEY for “harmonicas” in International Class 15.¹

Deford Bailey LLC (“Opposer”) has filed a notice of opposition wherein it opposes registration of the involved mark on grounds of fraud, false suggestion of a connection with Opposer under Trademark Act Section 2(a), 15 U.S.C. §1052(a), and likelihood of confusion. Applicants, in their answer, deny the salient allegations of the notice of opposition and amplify those

¹ Application Serial No. 85304626, filed April 26, 2011, based on an assertion of use in commerce under Trademark Act Section 1(a), 15 U.S.C. § 1051(a), and alleging April 11, 2011 as the date of first use anywhere and date of first use in commerce. The application includes a statement that the mark does not identify a living individual. The record herein indicates that Applicants are brothers and grandsons of Deford Bailey.

denials with allegations concerning Carlos's musical performances under the name CARLOS DEFORD BAILEY since 1998 and the criminal record of one of Opposer's alleged principals.

On January 8, 2014, Opposer filed a motion for partial summary judgment on the ground that Carlos does not have a legitimate ownership interest in the involved mark. The Board, in a January 24, 2014 order, denied that motion on the ground that Opposer's motion was based on an unpleaded claim. The Board, in that order, further noted that each of Opposer's grounds for opposition was insufficiently pleaded and allowed Opposer until February 23, 2014 to file an amended notice of opposition.

On February 13, 2014, Opposer filed an amended notice of opposition and renewed its earlier motion for summary judgment based on its previously filed brief and evidence. Applicants, on March 14, 2014, incorporated into their brief in response to Opposer's motion for summary judgment a motion for judgment on the pleadings in which they allege that Opposer, in the amended notice of opposition, has failed to state a claim. In a March 28, 2014 order, the Board stated that "Opposer's combined reply brief in support of the motion for summary judgment and brief in response to the motion for judgment on the pleadings is due in accordance with Trademark Rules 2.119(c), 2.127(a) and 2.127(e)(1)."²

² The Board does not extend time to file reply briefs on motions. *See* Trademark Rules 2.127(a) and (e)(1). However, the Board generally does not enforce this policy when a reply brief in support of a motion is filed as part of a combined filing that also includes a brief in response to a motion.

Opposer's motion (filed April 4, 2014) to extend its time to file its combined brief in response to Applicants' motion and reply brief in support of the renewed motion for summary judgment is granted as conceded.³ See Trademark Rule 2.127(a). Opposer's combined brief is accepted.

In a June 20, 2014 order, the Board noted that Applicants are represented by the same attorney, Walter M. Benjamin, and indicated that, in this case: (1) the parties may have conflicting interests, and (2) Mr. Benjamin may be a fact witness in view of the alleged circumstances surrounding the filing of the involved application. In response thereto, Applicants submitted their written consent to Mr. Benjamin's continued representation.⁴ Accordingly, we will now consider the pending motions herein.

We turn first to Applicants' motion for judgment on the pleadings. Such motion is actually one to dismiss for failure to state a claim under Fed. R. Civ. P. 12(b)(6) and will be treated accordingly. A motion to dismiss for

³ The certificate of service in Applicants' combined brief in response to the renewed motion for summary judgment and in support of their motion for judgment on the pleadings states that Applicants served that combined brief by e-mail and facsimile on March 14, 2014. The Board presumes that the parties agreed to allow electronic service. See Trademark Rule 2.119(b)(6). Accordingly, Opposer's combined reply brief in support of the motion for summary judgment and brief in response to Applicants' motion was due by March 29, 2014. See Trademark Rules 2.119(c), 2.127(a), 2.127(e)(1). See also *McDonald's Corp. v. Cambridge Overseas Development Inc.*, 106 USPQ2d 1339 (TTAB 2013) (parties cannot stipulate to service by electronic means and retain five additional days afforded under Trademark Rule 2.119(c)). Because Opposer's motion to extend was filed after the expiration of time to act in response to Applicants' March 14, 2014 combined brief, the motion to extend was in fact one to reopen time to respond to the March 14, 2014 combined brief.

⁴ Applicants' response does not include proof of service upon Opposer, as required by Trademark Rule 2.119(a). If Opposer did not receive a copy of that response it is available online at <http://ttabvueint.uspto.gov/ttabvue/>.

failure to state a claim tests the sufficiency of a complaint. *See* TBMP § 503.01 (2014). That is, “[a] motion made under Rule 12(b)(6) challenges the legal theory of the complaint, not the sufficiency of any evidence that might be adduced.” *Advanced Cardiovascular Systems Inc. v. SciMed Life Systems Inc.*, 988 F.2d 1157, 26 USPQ2d 1038, 1041 (Fed. Cir. 1993).

To survive such a motion, Opposer need only allege sufficient factual matter as would, if proved, establish that (1) it has standing to maintain the proceeding, and (2) a valid ground exists for opposing or cancelling the mark. *Lipton Industries, Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185, 187 (CCPA 1982). Specifically, “a complaint must contain sufficient factual matter, accepted as true, to state a claim to relief that is plausible on its face.” *Ashcroft v. Iqbal*, 556 U.S. 662, 129 S.Ct. 1937, 1949-50 (2009), *quoting Bell Atlantic Corp. v. Twombly*, 550 U.S. 544, 570 (2007). In deciding such a motion, “the Board ... must accept as true all material allegations of the complaint, and must construe the complaint in favor of the complaining party.” *Jewelers Vigilance Committee, Inc. v. Ullenberg Corp.*, 823 F.2d 490, 2 USPQ2d 2021, 2023 (Fed. Cir. 1987). Whether or not Opposer can prove the pleaded allegations is a matter to be determined after the introduction of evidence at trial (or in connection with a proper motion for summary judgment). *See Flatley v. Trump*, 11 USPQ2d 1284, 1286 (TTAB 1989).

Turning to Opposer’s standing to maintain this proceeding, the starting point for a standing determination in an opposition proceeding is Trademark

Act Section 13(a), 15 U.S.C. § 1063(a), which provides that “[a]ny person who believes that he would be damaged by the registration of a mark upon the [P]rincipal [R]egister may ... file an opposition in the Patent and Trademark Office, stating the grounds therefor...” Trademark Act Section 13 establishes a broad class of persons who are proper Opposers; by its terms, the statute only requires that a person have a belief that he would suffer some kind of damage if the mark is registered, i.e., the Opposer must have both a real, personal interest in the outcome of the proceeding and a reasonable basis for a belief of damage. *See, e.g., Universal Oil Prods. Co. v. Rexall Drug & Chem. Co.*, 463 F.2d 1122, 1123, 174 USPQ 458, 459 (CCPA 1972). There is no requirement that actual damage be pleaded and proved to establish standing or to prevail in an opposition proceeding. *See Ritchie v. Simpson*, 170 F.3d 1092, 50 USPQ2d 1023, 1025 (Fed. Cir. 1999). However, Opposer must plead, and later prove, an interest in the proceeding beyond that of a mere intermeddler. *See American Vitamin Products Inc. v. Dow Brands Inc.*, 22 USPQ2d 1313, 1314 (TTAB 1992).

In paragraphs 1-3, 11, 13, and 14 of the amended notice of opposition, Opposer alleges that: (1) Deford Bailey (“Bailey”), the first African-American to perform at the Grand Ole Opry, was a harmonica virtuoso who died in 1982 and was inducted into the Country Music Hall of Fame in 2005; (2) Opposer is “a successor in interest to the name and likeness rights of [Bailey];” (3) one of the original members of Opposer was Deford Bailey Jr.

(“Bailey Jr.”), who assigned his interest in and to the marks DEFORD BAILEY and DEFORD BAILEY SR. to Opposer before his death in 2013; (4) Opposer and Bailey’s other two children, Christine Lamb and Dezoral Thomas, own the rights of publicity and name and likeness rights of Bailey; and (5) Opposer has previously licensed the rights to use the mark DEFORD BAILEY in connection with harmonicas, t-shirts, and other commercial products. These allegations are sufficient to plead a real, personal interest in the outcome of the proceeding and a reasonable basis for a belief of damage. Accordingly, we find that Opposer has sufficiently pleaded its standing to oppose registration of Applicants’ mark.

As grounds for opposition, Opposer has sought to plead claims of (1) fraud in paragraphs 4-8 based on the filing of the involved application with Carlos and Bailey III named as joint Applicants, notwithstanding that Bailey III did not authorize the filing of the application; (2) nonownership based on Carlos’s entering into a name and likeness licensing agreement with Opposer on April 18, 2012, wherein Carlos agreed that he “shall not make any claim of ownership or interest in or to” the “name DEFORD BAILEY” in paragraphs 9-10; (3) false suggestion of a connection with Opposer under Trademark Act Section 2(a), 15 U.S.C. § 1052(a), in paragraphs 11-12; and (4) likelihood of confusion under Trademark Act Section 2(d), 15 U.S.C. § 1052(d), in paragraph 13, based on prior licensing of the DEFORD BAILEY mark “in connection with harmonicas, T-shirts, and other commercial products.”

We turn first to the fraud claim. To plead such a claim, Opposer must allege that Applicants, in attempting to procure a trademark registration, knowingly made specific false, material representations of fact in connection with the application with the intent of obtaining a registration to which they were otherwise not entitled. *See In re Bose Corp.*, 580 F.3d 1240, 91 USPQ2d 1938 (Fed. Cir. 2009). Knowledge and intent may be alleged generally. *See* Fed. R. Civ. P. 9(b); *DaimlerChrysler Corp. v. American Motors Corp.*, 94 USPQ2d 1086 (TTAB 2010). “Materiality” of any false application statement is determined in the context of whether the false statement is critical to the Trademark Examining Attorney’s decision to approve a mark for publication. *See In re Bose Corp.*, 91 USPQ2d at 1941; *First Int’l Servs. Corp. v. Chuckles Inc.*, 5 USPQ2d 1628, 1634 (TTAB 1988). Because a use-based application may properly be filed only by the owner of a mark, the identification of the Applicant(s) in an application is material to the issuance of a registration. *See* Trademark Act Section 1(a), 15 U.S.C. § 1051(a); TMEP § 1201 (April 2014) (“an application based on use in commerce must be filed by the owner of the mark”).

Opposer’s fraud claim is set forth as follows:

4. On April 26, 2011, without seeking consent from the Heirs, Carlos Bailey, a grandson of Deford Bailey, filed with the United States Patent and Trademark Office Application Serial No. 85304626 for registration of the mark DEFORD BAILEY in the category of “harmonicas.” Counsel of record for Applicant, Walter M. Benjamin, filed this application on behalf of Deford Bailey III despite the fact that Deford Bailey III had never

spoken to Mr. Benjamin and did not authorize him to represent him or file the application on his behalf.

5. In actuality, Deford Bailey III did not join Carlos Bailey in filing the trademark application at issue. Attached is a true and correct copy of a letter from Deford Bailey III to Mr. Benjamin dated June 2, 2011, stating:

I understand that you have filed a federal trademark application on my behalf for the mark DEFORD BAILEY. I have never spoken with you or authorized you to represent me or file a trademark application on my behalf. I demand that you immediately withdraw the application.

Attached hereto as Exhibit B is a true and correct copy of a Declaration signed by Deford Bailey III in which he states under oath: “I have never met or communicated with Mr. Benjamin and did not authorize him to file the application on my behalf or represent me in connection with any legal matters.”

6. Mr. Benjamin was notified of this issue in correspondence dated May 26, 2011, and June 27, 2011, but has not withdrawn the application.

7. By filing the application on behalf of Deford Bailey III with no authorization to do so, Mr. Benjamin filed a false and fraudulent trademark application. He confirmed this fraud by his failure to withdraw the application despite an express request to do so by Deford Bailey III.

8. Mr. Benjamin’s filing violates the following applicable sections of the regulations governing attorney conduct in connection with federal trademark applications: First, when an attorney signs a document in a representative capacity and submits it to the U.S. Patent and Trademark Office (“Trademark Office”), his signature constitutes a representation to the Trademark Office that he is authorized to represent the person or entity on whose behalf he acts. 37 C.F.R. § 2.17(b). Further, by presenting such signed application to the Trademark Office, the attorney is certifying that “all statements made therein of the party’s own knowledge are true, all statements made therein on information and belief are believed to be true, and all statements made therein are made with the knowledge that whoever, in any

matter within the jurisdiction of the Office, knowingly and willfully falsifies, conceals, or covers up by any trick, scheme, or device a material fact, or knowingly and willfully makes any false, fictitious, or fraudulent statements or representations, or knowingly and willfully makes or uses any false writing or document knowing the same to contain any false, fictitious, or fraudulent statement or entry, shall be subject to the penalties set forth under 18 U.S.C. § 1001 and any other applicable criminal statute, and violations of the provisions of [such] section may jeopardize the probative value of the paper.” 37 C.F.R. § 11.18(b). Finally, violations of this requirement may jeopardize the validity of the application. 37 C.F.R. § 2.193(f).

Although Opposer did not use the wording “intent to deceive,” Opposer has set forth a legally sufficient fraud claim based on the allegedly unauthorized filing of the involved application naming Bailey III as one of the joint applicants. Because the amended notice of opposition asserts that a known misrepresentation, on a material matter, was made in an application to procure a registration, we find that the element of intent has been generally pled. *See DaimlerChrysler Corp.*, 94 USPQ2d at 1088-89.

Regarding Opposer’s nonownership claim, we find that Opposer has set forth a legally sufficient claim of Carlos’s nonownership of the involved mark based on Carlos’s entering into a name and likeness licensing agreement with Opposer on April 18, 2012, wherein Carlos agreed that he “shall not make any claim of ownership or interest in or to” the “name DEFORD BAILEY.” *See Trademark Act Section 1(a)*. In addition, Opposer has pleaded a legally sufficient claim under Trademark Act Section 2(d) based on its prior licensing of the rights to use the mark DEFORD BAILEY in connection with harmonicas and T-shirts. *See Trademark Act Section 2(d); King Candy Co. v.*

Eunice King's Kitchen, Inc., 182 USPQ 108 (CCPA 1974). To the extent that Opposer intends to rely on prior licensing of the rights to use the DEFORD BAILEY mark on “other commercial products,” Opposer has failed to provide fair notice as to the specific nature of those products and has therefore failed to set forth a Section 2(d) claim based thereon.

Regarding Opposer’s claim of false suggestion of a connection, Opposer must plead that (1) Applicants’ mark is the same or a close approximation of Opposer’s previously used name or identity (as opposed to Opposer’s pleaded marks); (2) Applicants’ mark would be recognized as such, in that it points uniquely and unmistakably to Bailey; (3) Opposer is not connected with the goods sold by Applicants under the mark; and (4) Opposer’s name or identity is of sufficient fame or reputation that when Applicants’ mark is used on its goods, a connection with Bailey would be presumed. *See Petróleos Mexicanos v. Intermix SA*, 97 USPQ2d 1403, 1405 (TTAB 2010); *Boston Red Sox Baseball Club LP v. Sherman*, 88 USPQ2d 1581, 1593 (TTAB 2008). Opposer sets forth a legally sufficient false suggestion of a connection claim in paragraphs 11-12 of the amended notice of opposition.

Based on the foregoing, we find that Opposer’s amended notice of opposition sets forth a claim upon which relief can be granted. Applicants’ motion for judgment on the pleadings is therefore denied.

We will now consider Opposer’s renewed motion for partial summary judgment. By such motion, Opposer seeks entry of summary judgment on the

ground that Carlos admitted signing a licensing agreement with Opposer acknowledging that he does not have any right to the name DEFORD BAILEY and that he shall make no claim of ownership of interest in the name. Accordingly, Opposer contends that entry of partial summary judgment is appropriate.

As supporting evidence, Opposer has submitted copies of a name and likeness licensing agreement with Opposer on April 18, 2012, wherein Carlos agreed that he “shall not make any claim of ownership or interest in or to” the “name DEFORD BAILEY” and Applicants’ responses to Opposer’s requests for admission wherein Applicants admit that Carlos signed the name and likeness licensing agreement.

In response, Applicants contend that there are genuine disputes as to whether Bailey Jr. had the right to grant any rights to Bailey’s name and likeness to the exclusion of Bailey’s other heirs; whether Bailey Jr. was competent to grant any rights to Bailey’s name and likeness to Opposer; whether Bailey Jr. in fact granted any rights to Bailey’s name and likeness; what happened to Bailey Jr.’s right to Bailey’s name after Bailey Jr. died; whether the other heirs, Christine Lamb and Dezoral Thomas, consent to Applicants’ registration of the involved mark; whether Opposer was entitled to license anything to Carlos; and whether the licensing agreement, which was entered into one year after the filing of the application, has an impact

upon the involved application.⁵ Applicants' only evidence in response to the motion for summary judgment is an affidavit from Applicants' attorney in which he avers that he has a document signed by Carlos and Bailey III authorizing him to represent Applicants in connection the filing of the involved application; that he has represented Applicants herein; and that he has "spoken to both Applicants on several occasions by telephone." In reply, Opposer contends that Applicants have failed to rebut Opposer's proof of Carlos's nonownership of the involved application with any proof of their own.

The Board notes initially that Opposer's motion for summary judgment relates entirely to Carlos's right to seek registration of the involved mark. Accordingly, granting such motion would result only in entry of partial summary judgment against Carlos and would not be dispositive of this case regarding Bailey III's rights in the involved mark.

Summary judgment is an appropriate method of disposing of cases in which there are no genuine issues of material fact in dispute. *See* Fed. R. Civ. P. 56(c). The party moving for summary judgment has the initial burden of demonstrating both that there is no genuine issue of material fact remaining for trial and that it is entitled to entry of judgment as a matter of law. *See Celotex Corp. v. Catrett*, 477 U.S. 317 (1987); *Sweats Fashions Inc. v. Pannill*

⁵ Although Applicants contend that, "if Applicants had an[] extension of time, they could bring forward affidavits to refute the claims of the proposed Amended Notice of Opposition," Applicants did not move for discovery under Fed. R. Civ. P. 56(d) prior to responding to the renewed motion for summary judgment. *See* Trademark Rule 2.127(e)(1) and TBMP § 528.06.

Knitting Co. Inc., 833 F.2d 1560, 4 USPQ2d 1793 (Fed. Cir. 1987). The nonmoving party must be given the benefit of all reasonable doubt as to whether genuine issues of material fact exist, and the evidentiary record on summary judgment, and all inferences to be drawn from the undisputed facts, must be viewed in the light most favorable to the nonmoving party. *See Opryland USA, Inc. v. Great American Music Show, Inc.*, 970 F. 2d 847, 23 USPQ2d 1471 (Fed. Cir. 1992).

After reviewing the parties' arguments and Opposer's evidence we find that Opposer has not met its initial burden of establishing that there is no genuine dispute as to any material fact and that it is entitled to entry of judgment as a matter of law. Notwithstanding Opposer's submission of a licensing agreement between itself and Carlos regarding use of Deford Bailey's name and likeness on t-shirts and harmonicas and Applicants' admission that Carlos signed the licensing agreement, Opposer has not filed any evidence establishing its acquisition of rights in the unregistered DEFORD BAILEY mark through a chain of title from Bailey to Bailey Jr. to Opposer. *Cf.* Patent and Trademark Rule 3.73(b) (assignee must establish its ownership of a trademark application or registration to take action in a trademark matter). Therefore, bearing in mind that we must resolve any reasonable inferences in favor of Applicants as the nonmovants, we find that there are, at a minimum, genuine disputes of material fact regarding if and how Opposer acquired trademark rights in the DEFORD BAILEY mark,

what, if any, rights in that mark Opposer acquired, and Opposer's authority to license that mark. In view thereof, Opposer's motion for summary judgment is hereby denied.

Proceedings herein are resumed. Applicants are allowed until twenty days from the mailing date set forth in this order to file an answer to the amended notice of opposition. Remaining dates are otherwise reset as follows.

Plaintiff's Pretrial Disclosures Due	10/5/2014
Plaintiff's 30-day Trial Period Ends	11/19/2014
Defendant's Pretrial Disclosures Due	12/4/2014
Defendant's 30-day Trial Period Ends	1/18/2015
Plaintiff's Rebuttal Disclosures Due	2/2/2015
Plaintiff's 15-day Rebuttal Period Ends	3/4/2015

In each instance, a copy of the transcript of testimony, together with copies of documentary exhibits, must be served on the adverse party within thirty days after completion of the taking of testimony. Trademark Rule 2.125. Briefs shall be filed in accordance with Trademark Rules 2.128(a) and (b). An oral hearing will be set only upon request filed as provided by Trademark Rule 2.129. If either of the parties or their attorneys should have a change of address, the Board should be so informed promptly.