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

Proceeding	91209857
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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
)	
-vs-)	APPLICATION SERIAL NO. 85304626
)	
CARLOS DEFORD BAILEY and)	Published in the Official Gazette on
DEFORD BAILEY III, Applicants.)	February 19, 2013

OPPOSER'S TRIAL BRIEF

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1. Introduction

This is a family dispute over the right to use the name of Deford Bailey, a world-renowned harmonica virtuoso and first African American performer on the Grand Ole Opry, in connection with the sale of harmonicas. On one side of the dispute are Applicants, Carlos Deford Bailey and DeFord Bailey III, the grandsons of Deford Bailey, who have applied for registration of the pending mark, DEFORD BAILEY, in connection with harmonicas (Serial No. 85304626). On the other side of the dispute is the Opposer, Deford Bailey LLC, the sole surviving member of which is Shemika Wiley, the great-granddaughter of Deford Bailey, who formed the LLC with Deford Bailey's son and heir, Deford Bailey, Jr.

Opposer opposes Applicant's registration on the grounds that Opposer, and not Applicants, owns the right to use the mark and name DEFORD BAILEY in connection with the sale of harmonicas. Applicant Carlos Bailey has admitted to signing a license agreement with Opposer acknowledging 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. In addition, Applicant's registration would cause likelihood of confusions and a false connection with the legacy of Deford Bailey, Sr. in violation of Sections 2(a) and 2(d) of the Trademark Act.

For these reasons, Applicants' application should not register.

2. Description of the Record

The evidence of record in this matter consists of the following:

1. The January 29, 2015, testimony deposition of Carlos Lamont Bailey, Sr. (“Carlos Bailey Depo.”);
2. The January 29, 2015, deposition testimony of Deford Bailey III (“Deford Bailey III Depo.”);
3. The January 29, 2015, deposition testimony of Shemika Wiley (“Wiley Depo.”); and
4. The other pleadings contained in the Board’s file.

3. Statement of the Facts

This proceeding involves a family dispute over ownership of the trademark DEFORD BAILEY in connection with harmonicas. Deford Bailey (referred to hereinafter as “Deford Bailey, Sr.”) was a living individual who died in 1982. (Wiley Depo. p. 7, lines 13-14.) He is renowned as the first African-American performer at the Grand Ole Opry in Nashville, Tennessee, and was the very first member of the Grand Ole Opry. (Carlos Bailey Depo. p. 8, lines 5-23, Deford Bailey III Depo. p. 8, lines 1-4.) Deford Bailey, Sr. was a harmonica virtuoso (Carlos Bailey Depo. p. 8, lines 24-25, p. 9, lines 1-4, Deford Bailey III Depo. p. 8, lines 5-7, Wiley Depo. p. 8, lines 12-25), dubbed the “Harmonica Wizard” by George D. Hay, the radio announcer for WSM, the Nashville radio station that broadcasts the Grand Ole Opry. (Carlos Bailey Depo. p. 9, lines 4-13.) Deford Bailey, Sr. was inducted posthumously into the Country Music Hall of Fame in 2005. (Deford Bailey III Depo. p. 8, lines 18-20, Wiley Depo. p. 9, lines 2-10.) By mayoral proclamation, December 14 is Deford Bailey Day in Nashville, Tennessee. (Carlos Bailey Depo. p. 79, lines 17-25.) Because of Deford Bailey, Sr.’s great fame and legacy,

the public associates the name Deford Bailey with the harmonica. (Deford Bailey III Depo. p. 8, lines 10-17.)

As Applicants admit, the sole heirs of Deford Bailey, who died intestate, were his children, Deford Bailey, Jr., Christine Craig, and Dezoral Thomas. (Carlos Bailey Depo. p. 11, lines 18-24, p. 12, lines 2-4, p. 82, lines 20-23, Deford Bailey III Depo. p. 8, lines 21-25, p. 9, lines 8-10, Wiley Depo. p. 10, lines 2-25, p. 11, lines 1-5.)

In 2011, an artist interested in installing an exhibit at the Nashville International Airport commemorating Deford Bailey, Sr. and his musical legacy contacted the Bailey family to request permission. (Wiley Depo. p. 17, lines 13-25, p. 18, lines 1-25, p. 19, lines 1-4.) Members of the Bailey family attended the event. Just prior to that event, an unrelated third party and stranger to the Deford Bailey family who happens to share the surname Bailey, Ron Bailey (Wiley Depo. p. 16, lines 23-25, p. 17, lines 1-2), approached Applicant Carlos Bailey, Deford Bailey, Jr.'s son (Carlos Bailey Depo. p. 7, lines 24-25; p. 8, lines 1-2, p. 11, lines 1-25) and a musician with an Internet presence, with a proposal to create and sell harmonicas using the name and likeness of Deford Bailey, Sr. Carlos Bailey understood that he could not grant such permission without the approval of the heirs, so he invited Ron Bailey to the event at the airport. Ron Bailey met with the family after that event and made his proposal. (Wiley Depo. p. 15, lines 17-25.) Ron Bailey's original intention was that the heirs would apply for the trademark. The family members did not agree to do so, as a number of them were wary of the stranger who appeared to be attempting to exploit their legacy for his own profit, and a dispute arose among the family members regarding the trademark proposal that to this day is unresolved. (Wiley Depo. p. 15, lines 17-25, p. 16, lines 1-10, p. 17, lines 13-25, p. 18, lines 1-25, p. 19, lines 1-4.)

Carlos Bailey met separately with Ron Bailey after the airport meeting and agreed to partner with him to sell harmonicas using the name and likeness Deford Bailey. Because the heirs had not agreed to sign on to the project, Carlos Bailey convinced another of Deford Bailey, Jr.'s sons, Deford Bailey III (Deford Bailey III Depo. p. 7, lines 17-19), to be a co-applicant on the trademark application. When asked why he included Deford Bailey III in the business venture, Carlos Bailey testified: "We actually needed DeFord to file a trademark with me because I explained to him what a trademark was and what we could do with the trademark and how we can keep the legacy of the family going of DeFord Bailey, and he agreed to do that. And since I wasn't a DeFord, I needed my brother to — I needed to include him in that in order for us to get a trademark where it would be legal." (Carlos Bailey Depo. p. 30, lines 1-20.) In fact, there is no evidence in the record that Deford Bailey III ever used the mark in commerce on his own.

On April 26, 2011, an application was filed with the United States Patent and Trademark Office, Application Serial No. 85304626, for registration of the mark DEFORD BAILEY (the "Mark") in the category of "harmonicas" filed in the names of Carlos Deford Bailey¹ and Deford Bailey III. (Carlos Bailey Depo. p. 7, lines 15-17.) Both Applicants now admit, however, that they did not file the application to refer to their own names but to exploit the famous name and legacy of Deford Bailey, Sr., the Harmonica Wizard. (Deford Bailey III Depo. p. 18, lines 4-19.)

Q And why did you want to, in the first place, use DeFord Bailey to sell

¹ Carlos Bailey testified at his deposition that his legal name is not Carlos Deford Bailey; it is Carlos Lamont Bailey, Sr. (Carlos Bailey Depo. p. 6, lines 16-20.) His use of the name Carlos Deford Bailey in the application comports with his attempt to link his name with the Deford Bailey legacy.

harmonicas, the name?

A. That's a famous name. He's known throughout the world. He's worldwide.

Q. Who is he?

A. My grandfather, DeFord Bailey, Sr.

(Carlos Bailey Depo. 30, lines 21-25, p. 31, line 1.)

Q. Do you have an understanding as to why Ron Bailey reached out to you to use DeFord Bailey on harmonicas?

A. Well, he knew that we could pull this off by using DeFord Bailey.

Q. What was it about the name that made him want to use it in connection with harmonicas, if you know?

A. He's a legacy. He's an icon of country music.

Q. Again, he being?

A. DeFord Bailey, Sr. He's an icon of country music. He was the first to ever perform on the Grand Ole Opry. So that meant a lot to him. And something he had an idea of doing. I thought it was a good idea.

(Carlos Bailey Depo. p. 31, lines 2-17.)

Indeed, while both Applicants are musicians, neither Carlos Deford Bailey nor Deford Bailey III has ever achieved fame anywhere near the level of their famous grandfather, Deford Bailey, Sr., if they could be said to have achieved fame at all (Deford Bailey III Depo. p. 45, lines 16-25, p. 46, lines 1-6), and neither has ever been known for playing the harmonica.

(Carlos Bailey p. 11, lines 6-10, p. 71, lines 18-25, Deford Bailey III Depo. p. 8, lines 8-9.)

Although, according to Carlos Bailey, Ron Bailey remains a partner in the project to this day, his name was not included in the application, presumably, as can be inferred from Carlos Bailey's testimony, because he does not carry the name Deford Bailey or any form of it.

Q. You mentioned in that initial meeting with Ron Bailey at the airport, or

after the airport, he included your father, Christine, and Dezoral in his request, correct? Do you have an understanding why he included those three?

A. They was the heirs of DeFord Bailey, Sr.

Q. So, is it your understanding he felt he needed their permission?

A. Well, actually, he wanted them on the trademark application.

(Carlos Bailey, p. 78, lines 9-20.)

DeFord Bailey III's testimony on whether he had actual knowledge of the trademark application at the time it was filed in his name was confusing and inconsistent. On one hand he acknowledges signing an application that was faxed to his attorney. He testified, however, that he did not know what he was signing at the time. (Deford Bailey III Depo. p. 20-22.) When confronted by his father, Deford Bailey, Jr., after the application was filed, he informed him that he was unaware of it and did not authorize the application to be filed in his name. He agreed to and did sign a letter asking Walter Benjamin, the attorney who filed the application, to withdraw it, and he signed a declaration to that effect. (Exs. 8-9.) When asked about those documents in his deposition, however, first he denied that they contained his signature. Only when confronted with a signature on the trademark application that he testified to signing (Ex. 10) and being asked to compare the signatures did he change his testimony and acknowledge that he had signed the declaration and the letter (Exs. 8-9). (Deford Bailey III Depo. p. 23, lines 4-25, p. 24, lines 1-25, p. 25, lines 1-6, p. 26, lines 3-25, p. 27, lines 1-6, p. 40, lines 11-25, p. 41, lines 1-25, p. 42, lines 1-25, p. 43, lines 1-9, Exs. 8-10.)

On June 28, 2011, shortly after the airport meeting, with no knowledge that Carlos Bailey and Ron Bailey had moved forward with their trademark plans, Deford Bailey, Jr., who was elderly and wished to make plans for the day when he was no longer living, especially in light of the recent third-party threat to his father's name and likeness rights, retained an attorney and,

along with his granddaughter, Shemika Wiley, formed a limited liability company, DeFord Bailey LLC. (Wiley Depo. p. 13, lines 24-25, p. 14, line 1-6, p. 15, lines 17-25, p. 21, lines 13-25, p. 22, lines 1-15, Ex. 1.) They wished to start a company to ensure Deford Bailey, Sr.'s rights were kept within the family and to have a formal presence visible to third parties wishing to seek a license to use the name and likeness. (Wiley Depo. p. 16, lines 11-20.) They proposed the plan to the other two heirs, Christine Craig and Dezoral Thomas, who initially were interested in being included, but who ultimately did not sign on. (Wiley Depo. p. 19, lines 5-22, p. 23, lines 2-17, p. 76, lines 1-11.)

Deford Bailey Jr. and Shemika Wiley signed an operating agreement for the LLC in June 2011. (Wiley Depo. p. 13, lines 6-20, p. 22, lines 16-25, p. 23, lines 1-4, p. 25, lines 17-25, p. 26, lines 12, 23-25, p. 27, line 1, Ex. 2.) Shemika Wiley had a particularly close relationship with her grandfather, Deford Bailey, Jr., as the oldest granddaughter of 30 grandchildren, and, because she was someone he had commonly relied on heavily in the past, Deford Bailey, Jr. had tapped her to preserve his interests in his father's legacy. (Wiley Depo. p. 12, lines 21-25, p. 13 lines 1-5, p. 20, lines 6-25, p. 21, lines 1-12.) In the Operating Agreement and a concurrent Intellectual Property Assignment, Deford Bailey, Jr. transferred 100% of his share in the rights to Deford Bailey's name and likeness to the limited liability company. (Wiley Depo., p. 27, lines 15-25, p. 28, lines 1-14, Exs. 2 and 3.) The two original members of the limited liability company were Deford Bailey, Jr. and Shemika Wiley. (Wiley Depo. p. 14, lines 15-25, Ex. 2.) Deford Bailey, Jr. died in September 2013. (Deford Bailey III Depo. p. 7, lines 20-21, Wiley Depo. p. 10, lines 6-12.) Pursuant to the terms of the operating agreement of the limited liability

company, Shemika Wiley became the sole surviving member.² (Wiley Depo. p. 15, lines 1-14, p. 29, lines 12-25, p. 30, lines 1-25, p. 31, lines 1-20, Exs. 2, 4.)

Applicants have argued in the past that Deford Bailey Jr. did not have the mental capacity to sign the documents assigning his rights to the LLC. The LLC operating agreement and Intellectual Property Assignment were executed by Deford Bailey Jr. in 2011. (Exs. 2 and 3.) Both Applicants testified that any decline they observed in Deford Bailey Jr. did not occur until 2013. (Deford Bailey III, p. 62, lines 7-14.) Further, they both admit that they were not present for the signing of those documents and were unfamiliar with the circumstances of the signing, including whether Deford Bailey Jr. was represented by counsel and whether the documents were read to him, and neither has contested the will. In fact, the attorney who prepared the operating agreement explained it fully to him before he signed it. (Wiley Depo. p. 27, lines 2-12.)

Upon learning of the pending trademark application and when the window opened to do so, on March 20, 2013, Deford Bailey LLC (also referred to herein as “Opposer”) filed a Notice of Opposition, alleging that, because of Opposer’s ownership of and interest in the Mark, approval of Applicants’ application for registration of the Mark is likely to confuse and deceive consumers.

² Deford Bailey, Jr. reaffirmed the transfer of intellectual property rights, including his rights to his name and likeness and Deford Bailey, Sr.’s name and likeness, to the LLC in his Last Will and Testament. Neither Carlos Bailey nor Deford Bailey III has contested the will. (Wiley Depo. p. 32, lines 18-25, p. 33, lines 1-25, p. 34, lines 1-25, p. 35, lines 1-25, p. 36, lines 9-21, Ex. 5.)

Applicant Carlos Bailey has not only acknowledged Opposer's ownership interest in the Mark in connection with harmonicas but has entered into a license agreement with Opposer for use of the Mark in connection with harmonicas and has paid Opposer license fees for such use. On or about April 18, 2012, wishing to use the Mark to sell harmonicas at a rose garden tribute event to Deford Bailey, Sr., Carlos Bailey sought permission from Shemika Wiley on behalf of Opposer and executed a written Name and Likeness Licensing Agreement with Opposer (the "License Agreement"). (Carlos Bailey Depo. p. 13, lines 2-13, p. 14, lines 2-11, 24-25, p. 15, lines 1-25, p. 16, lines 1-25, p. 17, lines 1-25, p. 18, line 1, Wiley Depo. p. 37, lines 1-25, p. 38, lines 1-11, p. 38, lines 2-25, p. 39, lines 1-25, Exs. 6, 11, 12.) Carlos Bailey acknowledges that he is able to read and that he was not forced to sign the Agreement, nor was he forced to sell the harmonicas that the License Agreement permitted him to sell. (Carlos Bailey Depo. p. 18, lines 5-21, Wiley Depo. p. 40, lines 1-25, p. 41, lines 1-25.)

The License Agreement provides, in relevant part:

WHEREAS, the parties desire that CB [Carlos Bailey] pay Licensor [Opposer] for the use of DeFord Biley's name and likeness in connection with CB's marketing, sale, and distribution of products bearing the DeFord Bailey name, specifically, t-shirts and harmonicas.

1.1 "Licensed Property" means the name DEFORD BAILEY and the goodwill appurtenant thereto.

1.2 "Products" means the t-shirts and harmonicas marketed, sold, distributed, displayed, and/or produced by or for CB in existence as of the Effective Date [April 18, 2012] or created thereafter.

2.1 Grant of License. Licensor hereby grants to CB the non-exclusive license and right to use the Licensed Property in connection with the Products.

2.2 Reservation of Rights. Use of Licensed Property, and the goodwill associated therewith, shall inure solely to Licensor. Except for the license granted hereunder and as otherwise provided herein, (a) as between the parties, Licensor retains any right, title and interest in and to the Licensed Property, and (b) CB acknowledges and agrees that it will not have any right, title or interest in or to the Licensed Property, and CB shall not make any claim of ownership or interest in or to such Licensed Property.

3 Fees. CB shall pay Licensor royalties equal to twenty percent (20%) of the gross receipts derived from the sale of the Products.

(*Id.*)

Carlos Bailey sold nine to ten harmonicas at the event. In accordance with the License Agreement, he paid Opposer \$40 (20% of the \$200) in license fees. (Carlos Bailey Depo., p. 18, lines 9-10, p. 19, lines 8-25, p. 20, lines 1-25, p. 21, lines 1-2, p. 26, lines 6-9, Wiley Depo. p. 40, lines 24-25, p. 41, lines 1-21.)

The Weighing of Credibility

Applicants argued in their Answer to the Notice of Opposition that the credibility of Shemika Wiley, the sole remaining member of Opposer, should be questioned, alleging that she has been convicted of three felonies, including drug trafficking and attempted murder. (Ex. 7, paragraph 18.) Shemika Wiley has never been convicted of attempted murder or even charged with such crime, and that allegation is pure fabrication, which both Applicants acknowledge (and which both acknowledge was a falsehood in their filing). (Wiley Depo. p. 50, lines 18-25, p. 51, lines 1-9, Carlos Bailey Depo. p. 32, 17-25, p. 33, 1-25, p. 34, 1-25, p. 35, 1-19, Deford Bailey III Depo. p. 31, lines 11-23, p. 32, lines 5-6, lines 8-25, p. 33, lines 1-25, p. 34, lines 1-13.) She does acknowledge that she has two convictions of introduction of contraband into a penal facility years ago, but explains:

Q. ...I have never murdered nobody, attempted to murder nobody, or none of

that. I was in my late 20s. And yes, I made a bad choice. And I did try to take some marijuana into a prison to my cousins, and I got charged twice with intro of contraband into a penal facility. And then I did, you know, do my time for that. And that was it. I mean, that was years ago. Now I'm a stay-at-home mom. I'm married. I'm in the church. I mean, my whole life has changed. I don't even think on that level anymore. So that was then and this is now.

Q How old were you then?

A I was in my late 20s. That happened back 1999, 2000. I'm 43 now. That was years ago.

(Wiley Depo. p. 51, lines 2-22.)

In fact, in weighing the credibility of the parties in this case, Opposer submits that it is Applicants whose credibility should be seriously questioned, having admitted to the falsehood set forth above among other inconsistencies in testimony as described above and, indeed, the entire motivation for their selection of the named applications (and how Carlos Bailey identified himself) in this application.

4. Argument

4.1 Applicants' Mark Should Not Register Because Applicants Have No Ownership Interest in the Mark.

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.

Applicant Carlos Bailey admitted that he signed a Name and Likeness license with Opposer in 2012. In that Agreement, he acknowledged Opposer's ownership of the name DEFORD BAILEY and its appurtenant goodwill. He acknowledged that he must have a license to use the name in connection with sale of harmonicas. Finally, he acknowledged that he had no interest in the name, and he agreed not to make any claims of ownership or interest in the name himself. By these admissions, Applicant Carlos Bailey has conceded that he had no right to file his application Serial No. 85304626 for the Mark in connection with harmonicas and that he does not have a legitimate ownership interest in the Mark.

Deford Bailey III, likewise, has conceded that he was not an heir to the name and likeness rights of Deford Bailey, Sr., but that his father, Deford Bailey, Jr., and his aunts, Christine Craig, Dezoral Thomas, were the sole heirs. His brother, Carlos Bailey, concurs. Both Applicants would have had to receive rights from their father or one of the other heirs, and no evidence in the record establishes that such has occurred. To the contrary, the evidence establishes that the Applicants' father, Deford Bailey, Jr., transferred his rights to Deford Bailey Sr.'s name and likeness to Opposer, in fact confirming this in three separate documents: 1) the LLC operating agreement (Exhibit 2), the Intellectual Property Assignment (Exhibit 3), and 3) Deford Bailey,

Jr.'s Last Will and Testament (Exhibit 5). No evidence in the record suggests that these documents are anything but valid. Further, the fact that Carlos Bailey acknowledged Opposer's rights and paid Opposer license fees for use of the Mark in connection with harmonicas, further supports the fact that Opposer is the exclusive owner of Deford Bailey Jr.'s rights. Deford Bailey III acknowledges that he specifically intended to invoke the name of his grandfather, Deford Bailey, Sr., and not his own name, in applying for registration of the Mark, and he has not suggested that he made any separate use of the Mark apart from the use of Carlos Bailey, who acknowledged his use was required to be licensed pursuant to the License Agreement. In fact, Deford Bailey III testified to no separate use of the Mark in commerce at all, and there is no record evidence of any separate use of the Mark by Deford Bailey III separate and apart from the use by Carlos Bailey.

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)).

For lack of ownership alone, Applicants' application for registration should be denied.³

4.2 Registration and Continued Use of the Mark Would Falsely Suggest a Connection with Deford Bailey, Sr. and Cause a Likelihood of Confusion in Contravention of Sections 2(a) and 2(d) of the Trademark Act.

Section 2(a) of the Trademark Act prohibits registration of a mark that “consists of or comprises matter which may...falsely suggest a connection with persons, living or dead, institutions, beliefs, or national symbols, or bring them into contempt, or disrepute.” 15 U.S.C. § 1052(a). To establish a claim under this section, 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 Deford Bailey, Sr.; (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).

³ Opposer also alleged as its basis for its opposition fraud, specifically, that the application was submitted on behalf of Deford Bailey III without his knowledge or authorization. Although Deford Bailey III ultimately admitted signing a declaration in support of such claim, his testimony on the point was confusing and inconsistent. While the fact that he changed his testimony mid-course raises serious doubts as to the veracity of his testimony that he authorized the filing of the application, Opposer is unable to prove that fact definitively.

Applicants have conceded that they chose the Mark specifically to evoke the name, reputation, and image of Deford Bailey, Sr. Opposer, as the successor in interest to the name and likeness rights of harmonica virtuoso Deford Bailey, Sr., would be deprived of the right to use its intellectual property (the name DEFORD BAILEY) in connection with goods and services in the future. Applicants concede that they did not choose the mark DEFORD BAILEY in connection with harmonicas by happenstance but that they are attempting to exploit the fame of Deford Bailey as a harmonica virtuoso by use of his name in connection with the sale of harmonicas. Purchasers of harmonicas bearing the name DEFORD BAILEY, in light of Deford Bailey's fame in connection with this unique musical instrument, are likely to assume that harmonicas bearing the mark DEFORD BAILEY are connected with the Deford Bailey. Opposer, as a successor to the late Deford Bailey, Sr.'s rights to his name and likeness, thus would be injured by the false suggestion of this connection.

Applicants' Mark and the publicly known name of Deford Bailey, Sr., Deford Bailey, are one and the same. Applicants themselves concede that Deford Bailey is known worldwide as the Harmonica Wizard and that he has achieved great fame as a harmonica virtuoso. His achievements as an icon in country music, from his membership in the Grand Ole Opry to his induction into the Country Music Hall of Fame, firmly establish his fame and reputation. Indeed, that is precisely why Applicants wish to use the mark in connection with the particular product at issue. An applicant's intent is strong evidence that he will accomplish his purpose, and that the mark will be perceived by the public as referring to opposer. *See Dunkin' Donuts of America, Inc. v. Metallurgical Exoproducts Corp.*, 840 F.2d 917 (Fed. Cir. 1988).

The License Agreement itself establishes that Opposer has licensed the rights to use the mark DEFORD BAILEY in connection with harmonicas and T-shirts. Furthermore, a party

acquires a protectable interest in a name under Section 2(a) where the name claimed to be appropriated points uniquely and unmistakably to that party's personality or "persona." A party's interest in such a name or designation does not depend for its existence on the adoption and use of a technical trademark. Thus, an opposer in a proceeding of this character may prevail even if the name claimed to be appropriated has never been commercially exploited by the opposer in a trademark or trademark analogous manner. Similarly, even if there is no likelihood of confusion as to the source of the goods, even under a theory of sponsorship or endorsement, nevertheless an opposer's right to control the use of its identity may be violated. *Buffett v. Chi-Chi's, Inc.*, 226 U.S.P.Q. 428 (TTAB 1985) (citing *University of Notre Dame du Lac v. J.C. Gourmet Food Imports Co. Inc.*, 703 F.2d 1372 217 USPQ 505 (Fed. Cir. 1983), aff'g 213 USPQ 594 (TTAB 1982)).

For the same reasons, the registration and continued use of the mark DEFORD BAILEY by Applicants in connection with the applied-for goods is likely to cause confusion, deception, and mistake in violation of Trademark Act Section 2(d), 15 U.S.C. § 1052(d). A determination under Section 2(d) is based on an analysis of all of the probative facts in evidence that are relevant to the factors bearing on the likelihood of confusion issue. *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357 (CCPA 1973). In appropriate cases, a single du Pont factor may be dispositive of the likelihood of confusion analysis. *See Champagne Louis Roederer S.A. v. Delicato Vineyards*, 148 F.3d 1373 (Fed. Cir. 1999). Here, the marks at issue are identical, as is the category of goods. The fame of the mark Deford Bailey was firmly established long before Applicants applied for its registration.

5. Conclusion

For the reasons stated herein, Opposer has demonstrated sufficient grounds for the Board

to sustain the opposition and refuse registration to Application's application to register the DEFORD BAILEY mark.

Dated this 2nd day of October, 2015.

Respectfully submitted,

s/ Amy J. Everhart

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CERTIFICATE OF SERVICE

The undersigned certifies that the foregoing document was served via electronic mail and U.S. Mail, postage prepaid, on this 2nd day of October, 2015.

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