

This Opinion is Not a
Precedent of the TTAB

Mailed: May 1, 2019

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Joyce K. Thomas

v.

Chicago Basketball League Corporation

Opposition No. 91228767

Joyce K. Thomas (*pro se*).

R. Peter Spies of Dineff Trademark Law Limited,
for Chicago Basketball League Corporation.

Before Zervas, Kuczma and Ritchie,
Administrative Trademark Judges.

Opinion by Zervas, Administrative Trademark Judge:

Chicago Basketball League Corporation (“Applicant”) seeks to register the mark



for “Entertainment in the nature of basketball games; Entertainment services in the nature of live professional minor-league basketball games” in International Class 41 on the Principal Register.¹ Opposer alleges the following non-ownership claim in her Notice of Opposition:

4. The Opposer is author, creator of the Windy City Groove mark and owner of the US Copyright Registration Number VA 1-999-894 (attached here as Exhibit A) with a November 5, 2014 Date of First publication for this mark. The effective date of copyright registration is December 23, 2015 for the design of the mark shown in the CBLC Application Serial No 86819750.

5. Opposer (Thomas) designed the mark “Wind City Groove” for use in the Midwest Professional Basketball Association (“MPBA”). Thomas and her husband (C. Edward Schumer) are co-owners of the MPBA. Thomas granted usage rights for this mark exclusively to the MPBA.

8. Thomas began exploration of text layout for “Groove” on September 7, 2014 (see attached exhibit B). The nickname “Groove” was first discussed September 11, 2014 by the MPBA management team including Thomas, Schumer and Craig Fata (see attached Exhibit C). Thomas began the actual design work for the logo in mid October 2014 (see attached Exhibit D).

11. Discussions began in late October 2014 regarding potential ownership by Applicant of the Windy City Groove team. From the start, terms of the discussion provided that the MPBA would maintain ownership of all intellectual property of all teams in the league even

¹ Application Serial No. 86819750, filed November 13, 2015 under Section 1(a) of the Trademark Act, 15 U.S.C. § 1051(a), claiming first use and first use in commerce on August 1, 2014. Applicant disclaimed the term “WINDY CITY” and entered the following description of the mark in the application record:

The mark consists of the wording “WINDY CITY GROOVE” in stylized lettering with two borders underneath the Chicago skyline. The wording “WINDY CITY” appears above the letters “O” in “GROOVE”. The first letter “O” in “GROOVE” is replaced by a basketball. A horizontal line runs through the word “GROOVE” and behind the basketball.

after an agreement was reached. No contractual agreements were ever finalized.

12. On November 6, 2015 the Applicant severed their relationship with and withdrew from the MPBA per their attorney.

16. In summation, the mark Windy City Groove was not created as work for hire and Opposer never transferred ownership to the Applicant. Their use was permissive through November 6, 2014 when they left the league and Thomas retained ownership of the mark throughout their usage.²

Opposer's brief identifies "No Bona Fide Use in Commerce on Filing Date of Statement of Use" as an additional issue for decision in this case. Applicant, however, never filed a Statement of Use; the application was filed under Section 1(a) of the Trademark Act based on use in commerce. Also, "No Bona Fide Use in Commerce on Filing Date of Statement of Use" was not pleaded and is not identified as an issue in the Board's August 5, 2016 order which indicates that the only sufficiently pleaded claim in the Notice of Opposition was Opposer's non-ownership claim,³ and is not an issue mentioned in the Board's September 22, 2017 order stating, "the Board indicated [in its August 5, 2016 order] that the proceeding would go forward solely on the remaining claim of non-ownership."⁴ Applicant objected to our consideration of any claim other than the one raised in the Notice of Opposition.⁵ Thus, we give no

² Testimony identifies this date as November 5, 2015. Second Schumer Decl. ¶ 3(G), 27 TTABVUE 5.

³ 6 TTABVUE 6.

⁴ 19 TTABVUE 4.

⁵ Applicant's Brief at 6, 39 TTABVUE 7.

further consideration to a putative claim of “No Bona Fide Use in Commerce on Filing Date of Statement of Use.”

Applicant, in its amended answer, denied the salient allegations of the Notice of Opposition.⁶ The parties have fully briefed the proceeding.

I. The Record

In addition to the pleadings, the record automatically includes the involved application file pursuant to Trademark Rule 2.122(b)(1), 37 C.F.R. §2.122(b)(1).⁷ The parties submitted the following evidence during their assigned testimony periods:

A. Opposer’s trial submissions:

- Opposer’s First Notice of Reliance submitting a copy of Copyright Registration No. VA 1-999-894, effective December 23, 2015, for “Windy City Groove” (Exhibit 1).⁸
- Opposer’s Second Notice of Reliance submitting Exhibits 2-10, 14 and 15 consisting of printouts of webpages.⁹

⁶ 7 TTABVUE 2–5.

⁷ Opposer attached exhibits to its Notice of Opposition. Trademark Rule 2.122(c)(2) provides, “[e]xcept as provided in paragraph (d)(1) of this section, an exhibit attached to a pleading is not evidence on behalf of the party to whose pleading the exhibit is attached, and must be identified and introduced in evidence as an exhibit during the period for the taking of testimony.” The exception does not apply here, and the exhibits are not part of the evidentiary record. *See TRADEMARK TRIAL AND APPEAL BOARD MANUAL OF PROCEDURE (“TBMP”)* §§ 317 and 704.05(a) (June 2018).

⁸ 22 TTABVUE 24.

⁹ 22 TTABVUE 114-166. The Board’s April 17, 2018 order (26 TTABVUE) struck Exhs. 11-13 to Opposer’s Second Notice of Reliance as not being appropriate submissions through the notice of reliance procedure. The Board’s order also struck Exhs. A-E and H-K to Opposer’s early-filed “Trial Brief” submitted on December 22, 2017 (22 TTABVUE), but allowed Opposer to resubmit them with exhibits under an appropriate declaration. Exhibits F, G, L, M and N are declarations by Messrs. Schumer, Fata and Hollaway; the Board did not strike these declarations.

- First (June 30, 2017)¹⁰ and Second (December 14, 2017)¹¹ Declarations of C. Edward Schumer, Opposer's husband and owner of MPBA, and exhibits.
- First (June 28, 2017)¹² and Second (December 14, 2017)¹³ Declarations of Craig Fata, Associate Commissioner and Chief Communications Officer of MPBA, and exhibits.
- Declaration of Steve Hollaway, Chief Technology Officer of MPBA, and exhibits.¹⁴

B. Applicant's trial submissions:

- Declaration of LaChelle Sanders,¹⁵ wife of Steven Sanders, Owner of Chicago Basketball League Corporation and exhibits, including Opposer's Responses to Applicant's Interrogatories.¹⁶
- Declaration of Damon Stewart, the Sanders' commercial attorney, and single exhibit.¹⁷
- Declaration of Claudia Gunter, a partner in Panther Training, a selected service provider for MPBA's inaugural season (no exhibits).¹⁸

C. Opposer's rebuttal submissions:

- Opposer's Third Notice of Reliance submitting an Internet article.¹⁹

¹⁰ 22 TTABVUE 50-56 (resubmitted with exhibits at 28 TTABVUE).

¹¹ 22 TTABVUE 68-75 and 22 TTABVUE 95-102 (resubmitted with exhibits at 27 TTABVUE).

¹² 22 TTABVUE 43-48 (resubmitted with exhibits at 30 TTABVUE).

¹³ 22 TTABVUE 77-87 and 22 TTABVUE 103-113 (resubmitted with exhibits at 29 TTABVUE).

¹⁴ 22 TTABVUE 89-94 (resubmitted with exhibits at 31 TTABVUE).

¹⁵ 32 TTABVUE 132-137.

¹⁶ 32 TTABVUE 36-40. Ms. Sanders states that she was involved in the negotiations with the MPBA and Mr. Schumer, and the marketing and management of the WINDY CITY GROOVE and Chicago Force Basketball teams. 32 TTABVUE 132.

¹⁷ 33 TTABVUE.

¹⁸ 34 TTABVUE.

¹⁹ 35 TTABVUE.

- Third Declaration of Mr. Schumer (dated July 17, 2018) and exhibits.²⁰
- Opposer’s Declaration and exhibits.²¹

II. Opposer’s Evidentiary Objections

Applicant objects to testimony from each of Opposer’s declarants.²² Applicant’s objections are overruled because the stated objections are largely directed to the weight of the testimony. We have considered the declarations in their entirety, and have considered Applicant’s objections in weighing the probative value of the declarants’ statements.

III. Standing

A threshold issue in every inter partes case is the plaintiff’s standing to challenge registration. *See Empresa Cubana Del Tabaco v. Gen. Cigar Co.*, 753 F.3d 1270, 111 USPQ2d 1058, 1062 (Fed. Cir. 2014); *John W. Carson Found. v. Toilets.com Inc.*, 94 USPQ2d 1942, 1945 (TTAB 2010). Section 13 of the Trademark Act permits an opposition by “[a]ny person who believes that he would be damaged by the registration of a mark upon the principal register” 15 U.S.C. § 1063. To establish its standing, Opposer must demonstrate that it possesses a “real interest” in this proceeding beyond that of a mere intermeddler, and a “reasonable basis” for its belief of damage. “A ‘real interest’ is a ‘direct and personal stake’ in the outcome of the proceeding.” *Exec. Coach Builders, Inc. v. SPV Coach Co.*, 123 USPQ2d 1175, 1179

²⁰ 36 TTABVUE.

²¹ 36 TTABVUE 31.

²² 39 TTABVUE 28 et seq.

(TTAB 2017) (quoting *Ritchie v. Simpson*, 170 F.3d 1092, 50 USPQ2d 1023, 1026 (Fed. Cir. 1999)). “A claim of likelihood of confusion that ‘is not wholly without merit,’ including prior use of a confusingly similar mark, may be sufficient ‘to establish a reasonable basis for a belief that one is damaged.’” *Id.* (quoting *Lipton Indus., Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185, 189 (CCPA 1982)).

The Board stated in its August 5, 2016 order that “Opposer has sufficiently pleaded her standing to bring this action by pleading ownership and prior use of ‘the Windy City Groove mark ... for use in the Midwest Professional Basketball Association,’ i.e., ownership of a similar mark for use with services that are alleged to overlap with those identified in the subject application,” citing to Paragraphs 4-5 of the Notice of Opposition.²³ The Board advised Opposer in its September 22, 2017 order that “standing is an essential element of a plaintiff’s case that must be both pleaded and ultimately proved,” citing *Lipton Indus., Inc. v. Ralston Purina Co.*, 213 USPQ at 185 (“A [plaintiff’s] allegations alone do not establish standing ... [and] it does not follow that the facts affording a party standing, which as pleaded are sufficient as a matter of law, do not have to be proved by that party.”) and *Nobelle.com LLC v. Qwest Commc’ns Int’l Inc.*, 66 USPQ2d 1300, 1303 (TTAB 2003) (standing must be proved).²⁴

Opposer has not addressed her standing in her main brief, leaving it for us to search through the record to locate evidence that would establish her standing. We

²³ 6 TTABVUE 4.

²⁴ 19 TTABVUE 7.

look to Opposer's evidence submitted with her case-in-chief and not in rebuttal, because standing is an element that Opposer must prove in making her case. *Lipton Indus., Inc. v. Ralston Purina Co.*, 213 USPQ at 189 ("The facts regarding standing, we hold, are part of a petitioner's [or Opposer's] case and must be affirmatively proved."); *see also Hester Indus. Inc. v. Tyson Foods Inc.*, 2 USPQ2d 1645, 1647 (TTAB 1987) (Opposer failed to prove its case-in-chief during time allowed for doing so and Board refused to consider evidence offered during rebuttal that supported the case-in-chief). A failure to prove the essential element of its standing at trial results in a judgment on the merits.

Mr. Schumer stated in his first and second declarations that "Joyce Thomas maintains ownership of each mark and licenses its usage to the MPBA" and Opposer created, and is the owner of, the mark shown in Applicant's application.²⁵ Mr. Hollaway testified that "[i]t is the MPBA business practice for team logos to be designed by Joyce Thomas through her business Joyce Thomas Designs with Joyce Thomas maintaining ownership of the mark and licensing its usage to the MPBA."²⁶ Applicant admitted in its Answer that Opposer designed the "Windy City Groove mark" and is the owner of a copyright registration for the design of the mark shown in Applicant's application.²⁷ Messrs. Schumer and Hollaway's testimony and Applicant's admissions establish that Opposer has a real interest in this proceeding and a reasonable basis for her belief of damage from registration of Applicant's mark,

²⁵ 27 TTABVUE 2; Second Schumer Decl. ¶ 2(A), 27 TTABVUE 2.

²⁶ Hollaway Decl. ¶ 6, 31 TTABVUE 4.

²⁷ Answer ¶¶ 4-5, 7 TTABVUE 2 - 3.

and thus has standing. *See Empresa Cubana Del Tabaco v. Gen. Cigar Co.*, 111 USPQ2d at 1062.

IV. Non-Use

Pursuant to Section 1(a)(1) of the Trademark Act, 15 U.S.C. § 1051(a)(1), only “[t]he owner of a trademark used in commerce may request registration of its trademark” Accordingly, only the owner of the mark may file an application. *Holiday Inn v. Holiday Inns, Inc.*, 534 F.2d 312, 189 USPQ 630, 635 n.6 (CCPA 1976) (“One must be the owner of a mark before it can be registered.”); *In re Deister Concentrator Co.*, 289 F.2d 496, 129 USPQ 314, 320 (CCPA 1961) (“Under section 1, only ‘The owner of a trademark’ can apply for registration.”). Therefore, “[a]n application filed by one who is not the owner of the mark sought to be registered is a void application.” *In re Tong Yang Cement Corp.*, 19 USPQ2d 1689, 1690 (TTAB 1991) (citing *In re Techsonic Indus., Inc.*, 216 USPQ 619 (TTAB 1982)); *see also Huang v. Tzu Wei Chen Food Co.*, 849 F.2d 1458, 7 USPQ2d 1335 (Fed. Cir. 1988) (affirming Board’s holding that an application was void ab initio because the applicant was not the owner of the mark on the filing date); *Great Seats Ltd. v. Great Seats Inc.*, 84 USPQ2d 1235, 1239 (TTAB 2007) (“In a use-based application under Trademark Act Section 1(a), only the owner of the mark may file the application for registration of the mark; if the entity filing the application is not the owner of the mark as of the filing date, the application is void ab initio.”); Trademark Rule 2.71(d), 37 CFR § 2.71(d) (“An application filed in the name of an entity that did not own the mark as of the filing date of the application is void.”).

“To acquire ownership of a trademark it is not enough to have invented the mark first ...; the party claiming ownership must have been the first to actually use the mark in the sale of goods or services.” *Sengoku Works Ltd. v. RMC Intern., Ltd.*, 96 F.3d 1217, 40 USPQ2d 1149, 1151 (9th Cir. 1996), *as modified*, 97 F.3d 1460 (9th Cir. 1996); *see also Parham v. Pepsico, Inc.*, 927 F. Supp. 177, 40 USPQ2d 1060 (E.D. N.C. 1995), *aff’d*, 86 F.3d 1151 (4th Cir. 1996) (plaintiff had no trademark rights to assert because she only had an idea for using the word “crystal” as a trademark and never sold any product or service using that word as a mark); *La Maur Inc. v. Int’l Pharm. Corp.*, 199 USPQ 612 (TTAB 1978) (conception of mark and discussion with others does not establish priority). “Thus, a ... concept for a new trademark does not in itself establish protectable trademark rights.” 2 J. THOMAS McCARTHY, McCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 16.11 (5th ed. 2017).²⁸

Opposer is identified as “act[ing] as Chief Creative Officer of the MPBA.”²⁹ Mr. Schumer, Opposer’s husband, is the owner of the MPBA.³⁰ At least six teams, including the Windy City Groove, played at an inaugural basketball tournament event in Chicago on November 16, 2014, an event which was designed to recruit players for all of the six teams.³¹ “The league began play in January 2015”³² Evidently, at least two teams, The Chicago Force and The Windy City Groove,

²⁸ Opposer’s brief at 5-6, 47 TTABVUE 9-10.

²⁹ Second Schumer Decl. ¶ 2, 22 TTABVUE 68.

³⁰ *Id.* at ¶ 4, 22 TTABVUE 68.

³¹ *Id.* at ¶ 4, 22 TTABVUE 74.

³² First Schumer Decl. ¶ 6(E), 22 TTABVUE 55.

participated in “the 2014/15 season” of the MPBA.³³ On November 6, 2015, Applicant informed Mr. Schumer of its withdrawal from the MPBA.³⁴ There is no information in the trial record about seasons after “the 2014/15 season” including what teams participated, if any.

Opposer maintains that she is the owner of the mark. She alleged that “the mark Windy City Groove was not created as work for hire and Opposer never transferred ownership to the Applicant,”³⁵ and argues that “Opposer (Thomas) designed the mark WINDY CITY GROOVE to be licensed for use in the ... [MPBA] with Thomas retaining ownership of the mark,”³⁶ and “[a]s the original author of this work, the copyright vests with Joyce Thomas from the date of its fixed form and it has never been transferred to another entity in whole or in part by any means of conveyance or by operation of law.”³⁷ Mr. Schumer’s testimony makes clear that the MPBA does not claim ownership (“The MPBA never owned the Windy City Groove mark”).³⁸

Opposer relies on *inter alia* the declaration of her husband to establish her ownership claim. Mr. Schumer testified:

3) It is the MPBA business practice for team logos to be designed by Joyce Thomas through her business Joyce Thomas Designs. Joyce Thomas maintains ownership of each mark and licenses its usage to the MPBA.

³³ Sanders Decl. ¶ 16, 32 TTABVUE 136.

³⁴ First Schumer Decl. ¶ 7, 22 TTABVUE 55.

³⁵ Notice of Opposition ¶ 16, 1 TTABVUE 6.

³⁶ Opposer’s Brief at 10, 38 TTABVUE 15.

³⁷ Opposer’s Brief at 5, 38 TTABVUE 10-11.

³⁸ *Id.*, 22 TTABVUE 51.

- (A) Joyce Thomas developed the mark Windy City Groove and continues to own the copyright.
- (B) Joyce Thomas never transferred the ownership of the Windy City Groove mark in whole or in part by any means of conveyance or by operation of law to the MPBA.
- (C) Joyce Thomas was not employed by the MPBA to create the mark.
- (D) It was not a work made for hire. There was no written and signed instrument between Joyce Thomas and the MPBA that the design would be considered a work made for hire. No monies were offered or exchanged for the creation of the mark.
- (E) The MPBA never owned the Windy City Groove mark, and so could never transfer the ownership of the Windy City Groove mark in whole or in part by any means of conveyance or by operation of law to the CBLC.
- (F) The final fixed form of the Windy City Groove logo was first used when it was uploaded to the MPBA website and Facebook page on November 5, 2014.³⁹

Opposer's evidence supporting her case-in-chief does not indicate that Opposer ever used the mark for any services. Opposer notably relies on Messrs. Hollaway's and Fata's testimony that the mark was first publicly displayed on November 5, 2014 when Mr. Hollaway uploaded the mark to the www.theMPBA.com website⁴⁰ and when Mr. Fata placed the mark on the MPBA and "Windy City Groove Professional Basketball" Facebook pages.⁴¹ Both Mr. Hollaway and Mr. Fata have positions with the MPBA, were not employed by Opposer, and there is no evidence that they uploaded the mark on Opposer's behalf, or even at her instruction. In addition, it

³⁹ First Schumer Decl. ¶ 3, 22 TTABVUE 51.

⁴⁰ Hollaway Decl. ¶ 5, 31 TTABVUE 4.

⁴¹ Fata Decl. ¶ 10, 30 TTABVUE 6.

appears that it was not contemplated that Opposer would **own** the team bearing the WINDY CITY GROOVE mark; Mr. Schumer testified that “[d]uring the months of September and October 2014 conversations were ongoing about the Sanders entry into the league with ownership of their existing team the FORCE and the possibility of managing a second Chicago team to be owned and financed by the league.”⁴²

We consider then whether Opposer ever licensed use of the mark to the MPBA or to Applicant. Mr. Fata testified that “[i]t is the MPBA business practice for team logos to be designed by Joyce Thomas through her business Joyce Thomas Designs with Joyce Thomas maintaining ownership of the mark and licensing its usage to the MPBA.”⁴³ The record contains no signed agreements (such as licenses) pertaining to the subject mark, or any other mark, demonstrating this business practice.⁴⁴ There is no evidence of any fees paid to Opposer by Applicant (or any other entity), including for use of a mark. We find no basis for an implied license by Opposer to Applicant or to the MPBA.

We also consider who controlled the nature and quality of the services provided under the mark, if at all. As explained by Judge Nies in a concurring opinion in *In re Wella A.G.*, 787 F.2d 1549, 229 USPQ 274, 278 (Fed. Cir. 1986), “the one entity which controls the nature and quality of the goods [or services] sold under the mark is the owner,” (emphasis in original); *see also* Trademark Act §§ 5 and 45, 15 U.S.C. §§ 1055

⁴² First Schumer Decl. ¶ 5(A), 22 TTABVUE 52.

⁴³ First Fata Decl. ¶ 11, 22 TTABVUE 47.

⁴⁴ Mr. Schumer testified that “[t]he league began play in January 2015 with no executed league agreement or signed contracts.” First Schumer Decl. 6(E), 22 TTABVUE 55.

and 1127. Opposer does not include any evidence regarding her efforts to maintain the nature and quality of the services offered under the mark. She does include evidence of the MPBA's efforts though; Mr. Schumer testified:

2) From it's [sic] inception, the MPBA has intended to control all of the league's team logos and intellectual property in order to insure quality and continuity.

- (A) Ownership of a team or an interest in a team was intended to include a licensed agreement as to the policies regarding intellectual property and other league guidelines.
- (B) These policies were being advanced as the league formed to insure continuity of the league identity and so team names and logos would be static as the league developed.
- (C) League policy is for a team to be charged a one-time license fee when joining the league. Annual league fees are also charged for administrative costs, marketing costs, and support services such as television production, league meetings and events, and assorted other items.⁴⁵

Opposer does not identify any expenses she incurred in connection with the mark, and the only evidence she submitted regarding expenses is Mr. Schumer's limited testimony regarding expenses covered by the MPBA for officiating fees, uniform fees, "Play-by-Play/TV talent," "TV/Streaming fees," other "unreimbursed expenses" and an unexplained "license fee," presumably to the MPBA.⁴⁶ To be clear, Opposer does not state that any of these expenses were paid by or to Opposer.

In sum, Opposer argues that she is the true owner of the subject mark. In view of the foregoing, however, we find that the evidence Opposer adduced at trial in her

⁴⁵ First Schumer Decl. ¶ 2, 22 TTABVUE 50.

⁴⁶ First Schumer Decl. ¶ 8(A), 22 TTABVUE 56.

case-in-chief fails to establish prima facie that Applicant is not the owner of the applied-for mark. Opposer has thus not met her burden of proof and Opposer's claim is dismissed.

Decision: Opposer's non-ownership claim is dismissed.