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

Proceeding	92047757
Party	Plaintiff Karen B. Donovan
Correspondence Address	David H.E. Bursik 401 Hamburg Turnpike, Suite 210 Wayne, NJ 07470 UNITED STATES dheb@bursik.com
Submission	Brief on Merits for Plaintiff
Filer's Name	David H.E. Bursik, Esq.
Filer's e-mail	dheb@bursik.com
Signature	/David H.E. Bursik, Esq./
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IN THE TRADEMARK TRIAL AND APPEAL BOARD

KAREN B. DONOVAN,	:	
Petitioner,	:	Cancellation No. 92047757
v.	:	Marks-2791896,2701247
	:	
COURTNEY L. BISHOP,	:	
Registrant.	:	

***BRIEF OF PETITIONER
IN SUPPORT OF CANCELLATION
WITH CERTIFICATE OF SERVICE***

David H.E. Bursik, Esq.
401 Hamburg Turnpike, Suite 210
Wayne, New Jersey 07470
Tel. 1-973-904-1040
Fax. 1-973-904-1050
Email-dheb@bursik.com
Attorney for Petitioner

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DESCRIPTION OF THE RECORD

The Record in this proceeding consists of the application and registration files for the MAJOR TAYLOR trademark Registration No. 2791896 and the MAJOR TAYLOR trademark Registration No. 2701247, See Petitioner's Notice of Reliance "PNOR" filed April 04/20/2008, and the Deposition Testimony of the Registrant Courtney L. Bishop, See PNOR 04/20/2008 and 08/03/2008, and the printed publication "The Extraordinary Career of a Champion Bicycle Rider" written by Andrew Ritchie, See PNOR 04/21/2008, and an email from Registrant dated May 29, 2000, See PNOR 08/03/2008.

STATEMENT OF THE ISSUES

1) Should Trademark Registration No. 2791896 and Trademark Registration No. 2701247 be cancelled based upon the trademark use underlying such registrations being unlawful?

2) Should Trademark Registration No. 2791896 and Trademark Registration No. 2701247 be cancelled based upon the applications for such registrations being fraudulently premised upon sworn statements which were known by applicant to be false and untrue?

RECITATION OF THE FACTS

Registrant Courtney L. Bishop filed an application on October 30, 2000 to register the MAJOR TAYLOR trademark in Class 35, which resulted in the issuance of U.S. Trademark Registration No. 2791896. See Petitioner's Notice of Reliance ("PNOR") filed 04/21/2008. Registrant Courtney L. Bishop filed an application on August 10, 2001 to register the MAJOR TAYLOR trademark in Class 36, which resulted in the issuance of U.S. Trademark Registration No. 2701247. Id.

The applications filed by Registrant Courtney L. Bishop for both of the MAJOR TAYLOR trademark registrations noted above were based upon a use of the Major Taylor trademark that was unlawful under Indiana State law and based upon the fraudulent submission of declarations by Courtney L. Bishop that were known

by Courtney L. Bishop to be false and untrue. For both of these reasons, both registrations should be cancelled.

Registrant Bishop is a resident of the State of Indiana. See Bishop Deposition Transcript at P5,L13-15 and P11,L7-17 and P12,L8-12 filed under Petitioner's Notice of Reliance ("PNOR") dated 4/20/2008. Except for two summers, Registrant Bishop has been a resident of Indiana since 1985. See PNOR 08/03/2008 and Deposition Transcript at P11,L7 to P12,L21.

Registrant Bishop admitted under oath in his deposition that he did not ask anyone for permission to use the Major Taylor name. See Bishop Deposition Transcript P19,L11-20 and P41,L11-17 filed under PNOR-04/20/2008. Bishop never had any contact with Major Taylor's descendant Sydney Brown. Id. at P19,L21 to P20,L2. Registrant Bishop is not a blood relative of Major Taylor. Id. at P37,L24 to P38,L3. Registrant Bishop knew that Major Taylor had been a living person and that Major Taylor had a living descendant. Id. at P33,L12-24.

Courtney Bishop admitted in his deposition testimony that he knew that Major Taylor's descendant, a daughter, was living at the time that Courtney Bishop decided to begin using the Major Taylor name, and that he did not ask permission from Courtney Bishop to use the name. Id. at P19,L11-17. Courtney Bishop further admitted that he knew that Major Taylor's

daughter was living at the time that he submitted his application for trademark registration. Id. at P33,L19-24.

Registrant Courtney L. Bishop obtained the issuance of Trademark Registration No. 2791896 and Trademark Registration 2701247 based upon his sworn declarations that no one else had the right to use this name in commerce. As described below, Registrant Bishop knew that such statements were false and untrue at the time that he filed his declarations.

Registrant Bishop submitted his sworn declaration dated October 25, 2000 in support of the trademark registration Serial Number 76,155250 which resulted in Trademark Registration No. 2,791,896. See PNOL dated 04/21/2008. Registrant Bishop also submitted his sworn declaration dated August 9, 2001 in support of the trademark registration Serial Number 76,297,098 which resulted in Trademark Registration No. 2,701,247. See PNOL dated 04/21/2008. These declarations are referred to herein as "the Bishop Declarations".

Bishop stated in the Bishop Declarations that no other person had the right to use the Major Taylor trademark in commerce. Id. When Bishop signed the Bishop Declarations and filed them with the U.S. Trademark Office in order to secure the issuance of Trademark Registrations 2,791,896 and 2,701,247, he knew that the statements were false and untrue. Bishop admitted in his deposition that prior to submitting these sworn

declarations in 2000 and 2001, he knew that Major Taylor had a living descendant, and that the name was already in use by an association and that the name was used by a bicycle velodrome in Indiana. See Bishop Deposition Transcript at P13,L5-8; P13,L15 to P16,L16; P19,L11-20; P29,L13-17; P34,L19 to P35,L6 filed under PNOR-04/20/2008. Bishop admitted that at the very time when he submitted his applications for registration, he knew that Major Taylor had been a living person and that he had a living descendant. Id. at P33,L1-5 and L12-24.

Registrant Bishop admitted that when he researched the name Major Taylor, he read a book about Major Taylor entitled "The Extraordinary Career of a Champion Bicycle Racer" written by Andrew Ritchie. Id. at P13,L15 to P16,L16. The Ritchie book informed Registrant Bishop about Major Taylor's family and living descendants. See PNOR-04/21/2008 and book pages cited therein and printed publication Testimony of Plaintiff filed on 04/21/2008.

Registrant Bishop admitted in his deposition that he read the Ritchie book about Major Taylor in the 1990s. Id. at P16,L9-13. Notwithstanding that he had this knowledge and awareness of Major Taylor's family in the 1990s, Registrant Bishop fraudulently submitted false declarations to the U.S. Trademark Office in 2000 and 2001 that no one else had the right to use the Major Taylor name.

Prior to submitting either sworn declaration to the U.S. Trademark Office, Registrant Bishop sent out an email confirming that he knew of an organization was using the Major Taylor name, in addition to his awareness of the velodrome and Major Taylor's family. On May 29, 2000, Registrant Bishop sent an email to a Major Taylor organization in which he noted that he "heard about [the Major Taylor] organization on the net". See PNOR-08/03/2008 and PNOR-08/04/2008.

Accordingly, Registrant Bishop knew that Major Taylor family descendants were living and that an association was already using the Major Taylor name and that an Indiana velodrome was already using the Major Taylor name when he fraudulently submitted two sworn certifications that no one else had the right to use the name.

ARGUMENT

POINT ONE

**REGISTRATIONS ARE VOID
AND SHOULD BE CANCELLED
FOR LACK OF LAWFUL USE**

Lawful use in commerce is required to establish trademark rights which are premised upon use in commerce pursuant to 15 U.S.C. §1051(a)(1). See Creagri, Inc. v. USANA Health Sciences, Inc., 474 F.3rd 626(9th Cir. 2007); United Hosporus, Ltd. v. Mdlnd Fumigant, Inc., 205 F.3d 1219, 1225(10th Cir 2000); In re Midwest Tennis & Track Co., 29 U.S.P.Q.2d 1386, n.2, 1993 WL 562977(1993); Clorox Co. v. Armour-Dial, Inc., 214 U.S.P.Q.400, 401, 1976 WL 21138(1976); In re Stellar Int'l, Inc., 159 U.S.P.Q. 48, 51, 1968 WL 8159(1968). The Court in Creagri, supra, noted that the government did not extend the benefits of trademark protection to a person based upon the person's actions that were unlawful.

Registrant Bishop is a resident of the State of Indiana. See Bishop Deposition Transcript at P5,L13-15 and P11,L7-17 and P12,L8-12 filed under Petitioner's Notice of Reliance ("PNOR") dated 4/20/2008. Except for two summers, Registrant Bishop has been a resident of Indiana since 1985. See PNOR 08/03/2008 and Deposition Transcript at P11,L7 to P12,L21. The Indiana Rights of Publicity statute prohibits making any commercial use of a person's actual or assumed name for 100 years after person's

death without having obtained written consent for such use from the estate of such person. See Indiana Consolidated Statutes IC 32-36-1 et seq.

Registrant Bishop admitted under oath in his deposition that he did not ask anyone for permission to use the Major Taylor name. See Bishop Deposition Transcript P19,L11-20 and P41,L11-17 filed under PNOR-04/20/2008. Bishop never had any contact with Major Taylor's descendant Sydney Brown. Id. at P19,L21 to P20,L2. Registrant Bishop is not a blood relative of Major Taylor. Id. at P37,L24 to P38,L3. Registrant Bishop knew that Major Taylor had been a living person and that Major Taylor had a living descendant. Id. at P33,L12-24.

Courtney Bishop admitted in his deposition testimony that he knew that Major Taylor's descendant, a daughter, was living at the time that Courtney Bishop decided to begin using the Major Taylor name, and that he did not ask permission from Courtney Bishop to use the name. Id. at P19,L11-17. Courtney Bishop further admitted that he know that Major Taylor's daughter was living at the time that he submitted his application for trademark registration. Id. at P33,L19-24.

POINT TWO

**REGISTRANT'S FRAUDULENT
MISREPRESENTATIONS IN APPLICATIONS
WARRANT CANCELLATION OF REGISTRATIONS**

Registrant Courtney L. Bishop obtained the issuance of Trademark Registration No. 2791896 and Trademark Registration 2701247 based upon his sworn declarations that no one else had the right to use this name in commerce. As described below, Registrant Bishop knew that such statements were false and untrue at the time that he filed his declarations.

If fraud can be shown in the procurement of a trademark registration, the entire resulting registration is void. See Medinol Ltd. v. Neuro Vasx Inc., 67 USPQ2d 1205, 1208 (TTAB 2003). Fraud in procuring a trademark registration occurs when an applicant for registration knowingly makes false, material representations of fact in connection with an application to register or post registration document. See Torres v. Cantine Torresella S.r.l., 808 F.2d 46, 1 USPQ2d 1483 (Fed. Cir. 1986); Standard Knitting, Ltd. v. Toyota Jidosha Kabushiki Kaisha, 77 USPQ2d 1917 (TTAB 2006); Medinol Ltd. v. Neuro Vasx Inc., 67 USPQ2d 1205, 1208 (TTAB 2003); Mister Leonard Inc. v. Jacques Leonard Couture Inc., 23 USPQ2d 1064, 1065 (TTAB 1992).

Proof of specific intent is not required, rather, fraud occurs when an applicant or registrant makes a false material representation that the applicant or registrant knew or

should have known was false. See Medinol, 67 USPQ2d at 1209 (quoting General Car and Truck Leasing Systems, Inc. v. General Rent-A-Car Inc., 17 USPQ2d 1398, 1400-01, (S.D. Fla. 1990). The TTAB noted that the appropriate inquiry is not into a person's subjective intent, but rather objective manifestations of that intent. See Leaseways, Inc., Canc. No. 14,870, 17 USPQ2d 1398, 1400-1401 (TTAB May 2, 1990).

Registrant Bishop submitted his sworn declaration dated October 25, 2000 in support of the trademark registration Serial Number 76,155250 which resulted in Trademark Registration No. 2,791,896. See PNOL dated 04/21/2008. Registrant Bishop also submitted his sworn declaration dated August 9, 2001 in support of the trademark registration Serial Number 76,297,098 which resulted in Trademark Registration No. 2,701,247. See PNOL dated 04/21/2008. These declarations are referred to herein as "the Bishop Declarations".

Bishop stated in the Bishop Declarations that no other person had the right to use the Major Taylor trademark in commerce. Id. When Bishop signed the Bishop Declarations and filed them with the U.S. Trademark Office in order to secure the issuance of Trademark Registrations 2,791,896 and 2,701,247, he knew that the statements were false and untrue. Bishop admitted in his deposition that prior to submitting these sworn declarations in 2000 and 2001, he knew that Major Taylor had a

living descendant, and that the name was already in use by an association and that the name was used by a bicycle velodrome in Indiana. See Bishop Deposition Transcript at P13,L5-8; P13,L15 to P16,L16; P19,L11-20; P29,L13-17; P34,L19 to P35,L6 filed under PNOR-04/20/2008. Bishop admitted that at the very time when he submitted his applications for registration, he knew that Major Taylor had been a living person and that he had a living descendant. Id. at P33,L1-5 and L12-24.

Registrant Bishop admitted that when he researched the name Major Taylor, he read a book about Major Taylor entitled "The Extraordinary Career of a Champion Bicycle Racer" written by Andrew Ritchie. Id. at P13,L15 to P16,l6. The Ritchie book informed Registrant Bishop about Major Taylor's family and living descendants. See PNOR-04/21/2008 and book pages cited therein and printed publication Testimony of Plaintiff filed on 04/21/2008.

Registrant Bishop admitted in his deposition that he read the Ritchie book about Major Taylor in the 1990s. Id. at P16,L9-13. Notwithstanding that he had this knowledge and awareness of Major Taylor's family in the 1990s, Registrant Bishop fraudulently submitted false declarations to the U.S. Trademark Office in 2000 and 2001 that no one else had the right to use the Major Taylor name.

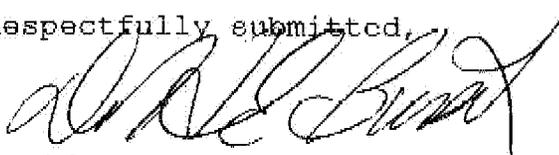
Prior to submitting either sworn declaration to the U.S. Trademark Office, Registrant Bishop sent out an email confirming that he knew of an organization was using the Major Taylor name, in addition to his awareness of the velodrome and Major Taylor's family. On May 29, 2000, Registrant Bishop sent an email to a Major Taylor organization in which he noted that he "heard about [the Major Taylor] organization on the net". See PNOR-00/03/2008 and PNOR-08/04/2008.

Accordingly, Registrant Bishop knew that Major Taylor family descendants were living and that an association was already using the Major Taylor name and that an Indiana velodrome was already using the Major Taylor name when he fraudulently submitted two sworn certifications that no one else had the right to use the name.

SUMMARY

Accordingly, based upon the Registrant's use of the Major Taylor trademark being unlawful under Indiana State law, Trademark Registration No. 2791896 and Trademark Registration 2701247 should be cancelled. Additionally, based upon the fraudulent sworn declarations which Registrant Bishop submitted in order to obtain the issuance of Trademark Registration No. 2791896 and Trademark Registration 2701247, both of these registrations should be cancelled.

Respectfully submitted,



Date: October 2, 2008

David H.E. Bursik, Esq.
401 Hamburg Turnpike, Suite 210
Wayne, New Jersey 07470
Tel. 1-973-904-1040
Fax. 1-973-904-1050
Email-dheb@bursik.com
Attorney for Petitioner

CERTIFICATE OF SERVICE

I hereby certify that today I served a copy of the within document upon counsel for Registrant:

Clifford W. Browning, Esq.
Krieg DeVault
One Indiana Square
Suite 2800
Indianapolis, Indiana 46204-2079
Tel. 1-317-636-4341

by depositing same, postage fully pre-paid, for first class regular U.S. mail delivery of same, and by emailing a pdf copy of same to him.

I certify that the foregoing statements made by me are true. I am aware that if such statements are willfully false, I am subject to punishment.



David H.E. Bursik, Esq.

Executed on this
2nd day of October, 2008
in Wayne, New Jersey.