Mailed:
January 6, 2009

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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Karen B. Donovan
v.
Courtney L. Bishop

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Cancellation No. 92047757

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David H. E. Bursik, Esq. for Karen B. Donovan.

Clifford W. Browning of Krieg DeVault LLP for Courtney L. Bishop.

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Before Zervas, Bergsman and Wellington, Administrative Trademark Judges.

Opinion by Bergsman, Administrative Trademark Judge:

Karen B. Donovan ("petitioner") has filed a petition to cancel the registered mark MAJOR TAYLOR and design, shown below, for the following services:

1. "Financial and insurance underwriting services pertaining to fund raising associations, foundations, charitable not for profit organizations covering activities

held within the normal scope of operations for these organizations, namely fundraisers," in Class 36;[1] and,

2. "Retail store and/or on-line computerized ordering services featuring bicycles, bicycle equipment, bicycle clothing, shoes and apparel; promoting bicycle sports, bicycle competitions and/or events of others," in Class 35.[2]

As grounds for cancellation, petitioner has alleged that Courtney L. Bishop ("respondent") committed fraud during the prosecution of his applications for registration by attesting that "no other person, firm, corporation, or association has the right to use the above identified mark in commerce," when at the time he signed the declarations, respondent knew that the statement was not true. In addition, petitioner has alleged that respondent's use of his mark is not in lawful commerce. Specifically, petitioner has asserted that the Indiana State Code relating to the right of publicity prohibits the commercial use of the name of a deceased individual without the written consent of the estate of the deceased person; that respondent is an Indiana resident; and that because respondent did not obtain the written consent of Major

[1] Registration No. 2701247, issued March 25, 2003. Respondent stated that "'Major Taylor' does not represent a living individual."

[2] Registration No. 2791896, issued December 9, 2003. Respondent stated that "[t]he name of the mark does not identify a living individual."

Taylor's estate, respondent's use of his mark is in violation of the Indiana State Code, and therefore the mark is not used in lawful commerce.

Respondent denied the salient allegations in the petition for cancellation.

Evidentiary Issue

During her rebuttal testimony period, petitioner submitted the following evidence:

1. A notice of reliance on the declaration of Lynne Tolman, an employee of the Major Taylor Association, purportedly to authenticate an e-mail from respondent;

2. A notice of reliance on the declaration of Linda Fink, an employee of the Major Taylor Velodrome, regarding respondent's visits to the Major Taylor Velodrome; and,

3. A notice of reliance on the declarations of Dallas C. Brown, purportedly the grandson of Major Taylor, and petitioner, purportedly the great granddaughter of Major Taylor.

In his brief, respondent objected to the above-noted notices of reliance on the grounds that the declarations were improper rebuttal and because respondent did not stipulate to the introduction of testimony by affidavit or declaration.

Trademark Rule 2.123(b), 37 CFR §2.123(b), reads, in pertinent part, as follows:

> By written agreement of the parties, the testimony of any witness or witnesses of any party may be submitted in the form of an affidavit by such witness or witnesses. The parties may stipulate in writing what a particular witness would testify to if called, or the facts in the case of any party may be stipulated in writing.

Petitioner has failed to submit a written agreement between the parties establishing that her testimony may be submitted in the form of declarations. Accordingly, respondent's objection to declarations proffered by petitioner is sustained.

Moreover, we agree with respondent that the testimony in the declarations constitutes improper rebuttal. Introducing facts supporting petitioner's standing and respondent's knowledge regarding prior use of the name MAJOR TAYLOR were elements of petitioner's case-in-chief. The only evidence that respondent introduced was selected parts of his discovery deposition which respondent proffered to clarify his use of the name MAJOR TAYLOR, his knowledge of the use of the name by others, and his search for someone to authorize his use of the name "so as to make not misleading what was offered by" petitioner. Trademark Rule 2.120(j)(4), 37 CFR §2.120(j)(4). Simply put, respondent did not submit any evidence that petitioner's declarations rebutted.

In view of the foregoing, respondent's objection to the declarations submitted by notice of reliance during petitioner's rebuttal testimony period is sustained and the declarations have not been considered.

The Record

By operation of Trademark Rule 2.122, 37 CFR §2.122, the record includes the pleadings and the registration files for respondent's mark.[3] The record also includes the following testimony and evidence:

A. Petitioner's Evidence.

1. A notice of reliance on respondent's discovery deposition, with attached exhibits;[4]

2. A notice of reliance on excerpts from a book entitled Major Taylor: The Extraordinary Career of a Champion Bicycle Rider; and,

3. A notice of reliance on respondent's answers to petitioner's interrogatory No. 1.

B. Respondent's Evidence.

As noted above, respondent submitted a notice of reliance on portions of his discovery deposition which he contends should be considered so as to make those portions filed by petitioner complete and not misleading.

[3] Accordingly, it was unnecessary for petitioner to file a notice of reliance on portions of the registration files and respondent's answer to the petition for cancellation.
[4] In addition to the notice of reliance, petitioner submitted a complete copy of the deposition transcript.

Standing

A threshold question in every *inter partes* case is whether the plaintiff has established her standing. *See* TBMP § 309.03(b) (2d ed. rev. 2004). In a Board proceeding, the plaintiff is required to show that it has a "real interest," that is, a "direct and personal stake," in the outcome of the proceeding. *See Ritchie v. Simpson*, 170 F.3d 1092, 50 USPQ2d 1023, 1025 (Fed. Cir. 1999); and *Lipton Industries, Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185, 189 (CCPA 1982). In this regard, petitioner has made the following allegation:

> Petitioner is an individual and a resident of the State of Hawaii with a residential address of 51 Betio Place, Honolulu, Hawaii 96818. Petitioner is a great-granddaughter of Marshall W. ("Major") Taylor and is authorized with complete authority and responsibility to act on behalf of the estate of the deceased individual Marshall W. ("Major") Taylor (hereinafter referred to as "Major Taylor"), and to handle all affairs concerning the legacy, persona, memorabilia, records, images, likenesses, endorsements, trademarks, copyrights, and all manner of things relating to the deceased individual Major Taylor.[5]

[5] Petition for Cancellation, ¶1. As indicated above, respondent has denied the salient allegations of the petition for cancellation. Specifically, respondent stated that he was "without knowledge or information sufficient to form a belief as to the truth of the averments," and therefore he denied the allegations in paragraph No. 1.

This allegation alone does not conclusively establish petitioner's standing because standing is an element of petitioner's case which must be affirmatively proved. *Ritchie v. Simpson*, 50 USPQ2d at 1029; and *Lipton Industries, Inc. v. Ralston Purina Co.*, 213 USPQ at 189. Even though respondent had effectively denied the allegation corresponding to petitioner's standing, petitioner did not proffer any direct testimony to establish her standing.[6] Instead, petitioner relied on respondent's discovery deposition. Although, the following excerpts identified in petitioner's notice of reliance are the most relevant to the issue of standing, they make no reference to petitioner:

> A6. At the time when Registrant Bishop decided to start using the name Major Taylor, he was aware that Major Taylor had a living descendant. Page 19, Lines 11 to 20.
>
> A7. Registrant Bishop has never had any contact with Major Taylor's descendant Sydney Brown. Page 19, Lines 21 to Page 20, Line 2.
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> * * *
>
> A12. Prior to submitting an application for registration to the Trademark Office, Registrant Bishop knew that Major Taylor had a daughter named Sydney Brown. Page 33, Lines 1 to 5.

[6] When the defendant denies an averment in the complaint, the plaintiff is required to submit evidence to prove that fact. *See The Telex Corp. v. The Western Union Telegraph Co.,* 140 USPQ 498 (TTAB 1964) (where applicant's answer denied opposer's claim of title to the pleaded registration and opposer failed to offer evidence, the opposition was dismissed because opposer failed to sustain its burden of proof).

> A13. When Registrant Bishop submitted an application for registration of a Major Taylor trademark, he knew that Major Taylor had been a living person and that he had a living descendant. Page 33, Lines 12 to Line 24.[7]

Accordingly, respondent contends that petitioner failed to prove that she has standing to prosecute this cancellation proceeding.[8] Petitioner, relying on respondent's testimony set forth below, argues that respondent admitted that petitioner is the granddaughter of Sydney Brown, the daughter of Major Taylor.[9]

> Q. What contact with any other Major Taylor relatives other than Sydney Brown [did you have]?
>
> A. I did not initiate contacts with anyone. However, I did receive an email - - I take that back, I take that back. During the course of my - - during the course of establishing Team Major Taylor [a bicycle racing team], I wanted to do something to kind of give back, and I had sent out a couple of emails to, I want to say - - what was his name? I want to say it's Dallas Brown.
>
> Q. Sydney's son, Karen's father?
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> A. Right, was, I believe, a general in the United States Army. Trying to get some responses so that, you know, - - I had a few ideas.[10]

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[7] Notice of Reliance By Petitioner Upon Deposition Testimony of Registrant Courtney L. Bishop.
[8] Respondent's Brief, pp. 6 and 9.
[9] Petitioner's Reply Brief, pp. 4-6.
[10] Bishop Dep., p. 38. As indicated above, although petitioner only relied on portions of the Bishop deposition, she filed the entire deposition.

Setting aside the issue of whether petitioner may rely on an excerpt from respondent's discovery deposition that was not identified through a notice of reliance by either party, we do not find that respondent admitted that petitioner has standing to prosecute this proceeding.[11] First, petitioner has not laid the proper foundation that respondent is competent to testify regarding petitioner's relationship with Major Taylor. The Federal Rules of Evidence provide that "[a] witness may not testify to matter unless evidence is introduced sufficient to support a finding that the witness has personal knowledge of the matter." Fed. R. Evid. 602. Nowhere in the record does respondent testify regarding the basis of his knowledge of the Taylor family tree. In other words, we have no basis on which to infer that respondent has any knowledge regarding the descendants of Major Taylor.

Moreover, even if we accept that petitioner is Major Taylor's great granddaughter, it is possible that there are other descendants with an equal or greater claim to control the right of publicity in connection with Major Taylor's

[11] Because petitioner filed respondent's entire discovery deposition transcript and because respondent did not object to our consideration of those portions of the transcript that were not identified in petitioner's notice of reliance, we will consider the entire transcript as having been properly introduced into the record.

name which petitioner has alleged as her standing in her petition to cancel.

Finally, we do not find that respondent's testimony regarding the identity of petitioner is clear and specific. The testimony at issue is more of an aside or footnote than a direct admission or statement that petitioner is Major Taylor's great granddaughter and that she is authorized to control the right of publicity in connection with Major Taylor's name. Respondent was trying to recall who had sent him an email - - "I want to say it's Dallas Brown" - - and then identify that person, when petitioner's counsel interjected - - "Sydney's son, Karen's father?" To which respondent replied "Right," and continued with the thought he had started before counsel's interjection. The interjection and response appears to have been made in the midst of respondent's thought, and not in direct response to the question.

In view of the foregoing, we find that petitioner has failed to show that she has a direct personal interest in the outcome of this proceeding, and therefore she has not sustained her burden of proving that she has standing to prosecute this cancellation proceeding.

Decision: The petition for cancellation is dismissed with prejudice.