Mailed: December 9, 2014

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

David S. Beasley

v.

William H. Howard d/b/a The Ebonys

Cancellation No. 92057071

David S. Beasley, *pro se*.

William H. Howard, d/b/a The Ebonys, *pro se*.

Before Zervas, Ritchie and Adlin, Administrative Trademark Judges.

Opinion by Ritchie, Administrative Trademark Judge:

This is a cancellation proceeding in which Mr. David S. Beasley (Petitioner) seeks to cancel Registration No. 4170469, owned by Mr. William H. Howard, d/b/a The Ebonys (Respondent), for The Ebonys,[1] in standard character format, on the Principal Register, for "entertainment services in the nature of live performances by singing vocalists; entertainment in the

[1] Registered on the Principal Register on July 10, 2012, alleging dates of first use on April 17, 1998, and first use in commerce in 2003.

nature of vocal musical group; live performances by a musical group," in International Class 41.

The sole pleaded ground for cancellation is fraud.[2] Specifically, Petitioner alleges that he is an original member of the group The Ebonys, which "continu[es] to receive quarterly royalty statements." (petition at para. 1, 2). He further alleges that Respondent is not an "original member" and did not perform "any original live recordings." *Id.,* at para 3. Petitioner alleges that he "continues to manage goods and services involving the name "The Ebonys" and that he "never relinquished in writing or verbally his rights of [sic] the 'The Ebonys' name to registrant, any other individual and/or group to provide profit to themselves for services or goods." *Id.* at paras. 5, 6. Finally, petitioner alleges that he "continues with on-going projects as an original member/owner of 'The Ebonys." *Id.,* at para. 7.

Respondent filed an answer denying the salient allegations of the petition and setting forth some purported "affirmative defenses," including that "Petitioner failed to disclose that The Ebonys was resurrected with new members in 1997 and the Registrant and the Petitioner were members of that resurrected group." (Answer, affirm. def, 4.c.).

[2] With his initial petition to cancel, Petitioner checked off several grounds for cancellation on the ESTTA cover sheet but did not include a petition elucidating the grounds. In his amended petition, filed July 8, 2013, the sole ground stated was fraud. Since no other grounds were pursued nor pleaded with particularity, we consider any such grounds to have been waived. Furthermore, based on the lack of proper briefing and evidence, we do not find that any other claims were tried by implied consent.

Petitioner filed a paper during his briefing period through ESTTA, the Board's electronic filing system, titled "Amended Petition to Cancel." The ESTTA cover sheet identified the paper filed as "Brief on the Merits for Plaintiff." Petitioner's paper was not accompanied by a motion for leave to amend. Because Petitioner filed the paper during its briefing period and because the ESTTA cover sheet identified the filing as a "Brief," we treat the filing as Petitioner's brief.

The Record

Pursuant to Trademark Rule 2.122(b); 37 C.F.R. § 2.122(b), the record in this case includes the pleadings and the file of the involved registration. The parties both made submissions during their trial periods,[3] and Petitioner during his rebuttal period. These consist of the following:

During Petitioner's Trial Period:

1. A state service mark registration issued by the State of New Jersey for The Ebonys, listing Petitioner as owner, with the filing date listed as March 7, 2003;
2. Management contract between Petitioner and Lynn Gross, d/b/a Octagon Development Group, dated November 14, 2004;

[3] Petitioner submitted his Initial Disclosures, and Respondent submitted his Pretrial Disclosures, which need not be filed. However, since they were submitted during the respective trial periods, we construe them as notices of reliance. We note also that Petitioner attached several items to his petition and his amended petition. However, unless otherwise properly introduced into the record during trial, exhibits to pleadings are not evidence for that party, with one exception not applicable here. *See* Trademark Rule 2.122(c); 37 C.F.R. § 2.122(c)

3. Management contract between Petitioner, as "Owner of The Ebonys," and Forrest Finney and Michael Mackintosh, dated October 1, 2007;
4. A letter from Jeff Gandel of Royalty Recovery to Clarence Vaughan, dated September 14, 2010;
5. A letter to Royalty Recovery, Inc., from Petitioner and others, dated September 14, 2010;
6. A letter from Philadelphia Records, dated August 19, 2013;
7. A Royalty Statement for the period ending June 30, 2013, for "The Ebonys" c/o David Beasley, from Philadelphia International Records; and
8. A flyer advertising a concert by Ebony's Revue; printed from http://mail.aol.com on October 5, 2013.

During Respondent's Trial Period:

1. A copy of Respondent's involved registration and information from the underlying application file;
2. A copy of an article from *The Philadelphia Inquirer*, undated;
3. A copy of an article from *The Times*, dated April 17, 1998;
4. An autographed photograph of The Ebonys;
5. A copy of a ticket printed from *Ticketmaster.com* for The Ebonys, dated October 10, 2000;
6. A flyer advertising The Ebonys performing on December 31, 2003;
7. A flyer advertising Ebony's [undated];

8. A printout advertising "The Big Show" DVD featuring The Ebonys; printed from oldies.com, undated;
9. A ticket and flyer advertising The Ebonys, featuring William "SMOKE" Howard at The Firehouse Café, September 10, 2011;
10. A flyer advertising The Ebonys dated October 27, 2012;
11. A flyer advertising The Ebonys, dated September 14, 2013; and
12. A copy of an article from *What's Inside*; Spring/Summer 2012, Vol. 1, Issue 9.

During Petitioner's Rebuttal Period:

1. Letter from Kenneth Gamble of Philadelphia International Records to Petitioner, dated May 12, 2014; and
2. Letter from Philadelphia International Records dated March 3, 2014, and attached W-9, signed by Petitioner.

Much of this material submitted by both parties is not suitable for the notice of reliance procedure. *See* Rule 2.122(e); 37 C.F.R. § 2.122(e) (permitting notice of reliance on official records, or printed publications "available to the general public in libraries or of general circulation"); and *Safer Inc. v. OMS Investments Inc.,* 94 USPQ2d 1031, 1039 (TTAB 2010) (permitting notice of reliance on Internet printouts that identify the date of publication or date accessed as well as the website address). We note, however, that neither party objected to the other's submissions, and their consideration does not affect the outcome of our decision. Accordingly, we

may include them in our analysis. *See Morgan Creek Productions Inc. v. Foria Int'l Inc., 91 USPQ2d 1134, 1136* (TTAB 2009) (although materials were not properly made of record, parties treated them as such, and thus Board deemed the parties to have stipulated the materials into the record); *Alfacell Corp. v. Anticancer Inc.*,71 USPQ2d 1301 (TTAB 2004) (evidence not properly made of record deemed stipulated into the record because it was treated as such by the parties).

Standing

To establish standing, a petitioner must establish a "personal interest in the outcome of the proceeding" as well as "a reasonable basis for belief of damage." *See Books on Tape Inc. v. The Booktape Corp.*, 836 F.2d 519, 5 USPQ2d 1301, 1302 (Fed. Cir. 1987) (petitioner, as a competitor of respondent, "clearly has an interest in the outcome beyond that of the public in general and has standing"). "A belief in likely damage can be shown by establishing a direct commercial interest." *See Cunningham v. Laser Golf Corp.,* 222 F.3d 943, 55 USPQ2d 1842, 1844 (Fed. Cir. 2000).

We must assess whether a plaintiff is a mere intermeddler or has real interest in the case. *See Ritchie v. Simpson,* 170 F.3d 1092, 50 USPQ2d 1023 (Fed. Cir. 1999); *Lipton Indus. Inc. v. Ralston Purina Co.,* 670 F.2d 1024, 213 USPQ 185 (CCPA 1982). Under this liberal standard, Petitioner has shown that he has a reasonable belief of damage and a real interest in this proceeding, because Respondent admits that Petitioner was a member of The

Ebonys, and the record includes Petitioner's New Jersey service mark registration. Therefore Petitioner is not a mere intermeddler, and he has established his standing. *Id.;* 15 U.S.C. § 1064.

Fraud

The only ground alleged in the amended petition for cancellation is fraud. Petitioner alleges that the group The Ebonys was formed in 1969 and consisted of several vocalists, which included Petitioner, but did not include Respondent. (petition at para. 1). The amended petition further alleges that The Ebonys was signed to a record deal and "continu[es] to receive quarterly royalty payments." *Id.* at para. 2; and that Respondent "was not and is not an original member or performed on any original live recordings of The Ebonys singing/performing group." *Id.,* at para. 3. The amended petition further alleges that Petitioner registered The Ebonys with the State of New Jersey in 1997. *Id.,* at 4.

The Court in *In re Bose Corp*., 476 F.3d 1331, 91 USPQ2d 1938, 1939 (Fed. Cir. 2009), set out the relevant standard for proving fraud:

> "Fraud in procuring a trademark registration or renewal occurs when an applicant knowingly makes false, material representations of fact in connection with his application." *Torres v. Cantine Torresella S.r.l.,* 808 F.2d 46, 48 [1 USPQ2d 1483] (Fed. Cir. 1986). A party seeking cancellation of a trademark registration for fraudulent procurement bears a heavy burden of proof. *W.D. Byron & Sons, Inc. v. Stein Bros. Mfg. Co.,* 377 F.2d 1001, 1004 [153 USPQ 749] (CCPA 1967). Indeed, "the very nature of the charge of fraud requires that it be proven 'to the hilt' with clear and convincing

> evidence. There is no room for speculation, inference or surmise and, obviously, any doubt must be resolved against the charging party." *Smith Int'l, Inc. v. Olin Corp.,* 209 USPQ 1033, 1044 (TTAB 1981).

Petitioner has failed to submit evidence showing that Respondent made a false, material representation of fact in connection with his trademark application, and that he did so with the intent to deceive the Trademark Office. The claim thus fails.

Decision: The petition to cancel is dismissed.