

THIS DECISION IS NOT A
PRECEDENT OF THE
TTAB

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451
General Contact Number: 571-272-8500

GCP

Mailed: January 30, 2015

Cancellation No. 92057288
(Parent Case)
Cancellation No. 92058292

(The) Blues Foundation, Inc.

v.

Daniel S. Marolt

**Before Quinn, Mermelstein and Adlin,
Administrative Trademark Judges.**

By the Board:

Daniel S. Marolt (“Respondent”) owns the following two registrations:

1. Registration No. 2392429 for the mark BLUES HALL OF FAME, in typeset words, for “on-line retail store services in the field of books, cd's, shirts, hats, posters and musical equipment concerning blues musicians” in International Class 35;¹ and
2. Registration No. 4398094 for the mark CHICAGO BLUES HALL OF FAME, in standard characters, for “on-line retail store services featuring books, CDs, shirts, hats, posters and musical equipment concerning blues musicians all related to an open organization dedicated to honoring and inducting blues musicians and organizing induction ceremonies at live blues shows” in International Class 35.²

¹ Registered on the Supplemental Register on October 3, 2000, claiming March 31, 1999 as both the date of first use and the date of first use in commerce. Section 8 (10-year) affidavit accepted and Section 9 affidavit granted on September 18, 2010.

² Registered on the Supplemental Register on September 3, 2013, claiming June 29, 2009 as both the date of first use and the date of first use in commerce.

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(The) Blues Foundation, Inc. (“Petitioner”) seeks to cancel each of Respondent’s registrations on the ground of likelihood of confusion. In support of its asserted claim, Petitioner asserts prior common-law use of the mark BLUES HALL OF FAME in connection with recognizing outstanding blues entertainers and musicians. Petitioner also alleges that its pleaded BLUES HALL FAME mark acquired distinctiveness prior to Respondent’s use of either of its registered marks.

Respondent, in his answers, denies the salient allegations asserted in Petitioner’s petitions to cancel. Additionally, Respondent asserted various affirmative defenses, including that Petitioner “cannot show that its purported mark “BLUES HALL OF FAME,” to the extent it could be considered a trademark...has acquired secondary meaning such that the descriptive phrase could be protected at common law or otherwise.” *See* Respondent’s Answer, Affirmative Defense No. 4.

This case now comes before the Board for consideration of Petitioner’s motion (filed September 16, 2014) for partial summary judgment on two issues: (1) priority; and (2) more specifically, whether Petitioner’s pleaded BLUES HALL OF FAME mark acquired distinctiveness prior to Respondent’s first use of the marks in its involved registrations. The motion is fully briefed.

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Petitioner's Motion For Partial Summary Judgment

For purposes of this order, we presume the parties' familiarity with the pleadings, the history of the proceeding and the arguments and evidence submitted in support of and response to Petitioner's motion for partial summary judgment.

Summary judgment is an appropriate method of disposing of cases that present no genuine disputes of material fact, thus allowing the case to be resolved as a matter of law. *See* Fed. R. Civ. P. 56(c). The evidence must be viewed in a light favorable to the nonmoving party, and all justifiable inferences are to be drawn in the nonmovant's favor. *Lloyd's Food Products, Inc. v. Eli's, Inc.*, 987 F.2d 766, 25 USPQ2d 2027, 2029 (Fed. Cir. 1993); *Opryland USA Inc. v. The Great American Music Show, Inc.*, 970 F.2d 847, 23 USPQ2d 1471 (Fed. Cir. 1992).

Here, Petitioner, as the moving party, has the burden of demonstrating the absence of any genuine dispute of material fact, and that it is entitled to judgment as a matter of law. *See Celotex Corp. v. Catrett*, 477 U.S. 317 (1986); *Sweats Fashions Inc. v. Pannill Knitting Co. Inc.*, 833 F.2d 1560, 4 USPQ2d 1793 (Fed. Cir. 1987).

Petitioner relies on its common-law use of BLUES HALL OF FAME to prove priority. In order for a plaintiff to prevail on a claim of likelihood of confusion based on its ownership of common-law rights in a mark, the mark must be distinctive, inherently or otherwise, and the plaintiff must show

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priority of use. *See Otto Roth & Co. v. Universal Foods Corp.*, 640 F.2d 1317, 209 USPQ 40 (CCPA 1981). “Thus, even if something is *used* as a trademark, if it is not distinctive, the user does not have a trademark because he has no existing trademark rights.” *Id.* at 44.

Under the rule of *Otto Roth*, a party opposing registration of a trademark due to a likelihood of confusion with his own unregistered term cannot prevail unless he shows that his term is distinctive of his goods, whether inherently or through the acquisition of secondary meaning or through “whatever other type of use may have developed a trade identity.” *Otto Roth*, 640 F.2d at 1320, 209 USPQ at 43. The *Otto Roth* rule is applicable to trademark registration cancellation proceedings as well.

Towers v. Advent Software Inc., 913 F.2d 942, 16 USPQ2d 1039, 1042 (Fed. Cir. 1990).

In this case, Petitioner has conceded that its pleaded BLUES HALL OF FAME mark is not inherently distinctive, *see* p. 14 of Petitioner’s motion for partial summary judgment. Additionally, Petitioner has conceded that, in order to succeed in this consolidated case, Petitioner must establish that secondary meaning existed as to its pleaded BLUES HALL OF FAME mark prior to Respondent’s first use of his involved marks.³ *Id.*

³ Both of Respondent’s subject marks are registered on the Supplemental Register. Under Section 27 of the Trademark Act, a Supplemental Register registration does not constitute an admission that the registered mark has not acquired distinctiveness. However, the general rule has not changed that a registrant owner of a Supplemental Register registration impliedly admits that the registered term was descriptive at least at the time of the registrant’s first use of the term. 1 J.T. McCarthy, *Trademarks and Unfair Competition*, Section 19:8F (2d ed. 1984). *See also* Richard L. Kirkpatrick, *The Supplemental Register Under The Trademark Law Revision Act: Additions, Deletions and Omissions*, 79 TMR 248, 251-52 (1989). That is to say, there is nothing in Section 27 to prevent a Supplemental Register registration from being deemed an admission that the subject matter is not *inherently* distinctive.

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In other words, the priority contest in this case is not solely a question of who used the mark first chronologically. Rather, the test is which party first achieved secondary meaning in its merely descriptive mark. *See* 2 J.T. McCarthy, *Trademarks and Unfair Competition*, Section 16:34 (4th ed. 2014).

Acquired distinctiveness is a question of fact, *see Hoover Co. v. Royal Appliance Mfg. Co.*, 238 F.3d 1357, 57 USPQ2d 1720 (Fed. Cir. 2001), but that does not preclude entry of summary judgment if it is shown that, on this record, there is no genuine dispute as to that fact. After reviewing the arguments and supporting evidence, and drawing all inferences with respect to the motion in favor of Respondent as the nonmoving party, we find that the evidence submitted by Petitioner in support of its motion for partial summary judgment only establishes use of a descriptive term, but fails to establish the lack of a genuine dispute of material fact regarding priority because the evidence of acquired distinctiveness is insufficient.

In view thereof, Petitioner's motion for partial summary judgment with regard to the issue of priority of acquired distinctiveness is hereby **DENIED**.⁴

Petitioner should be aware that its burden of demonstrating acquired distinctiveness at trial increases with the level of descriptiveness of its

⁴ Respondent, in response to Petitioner's motion for partial summary judgment, requested judgment in its favor on the issue of priority of acquired distinctiveness. Respondent's request is **denied** for the same reasons set forth herein. Further, the parties should note that the evidence submitted in connection with Petitioner's motion for partial summary judgment and response thereto is of record only for consideration of the motion. *See infra*. To be considered at final hearing, any such evidence must be properly introduced in evidence during the appropriate trial period. *See Levi Strauss & Co. v. R. Josephs Sportswear Inc.*, 28 USPQ2d 1464 (TTAB 1993); *Pet Inc. v. Bassetti*, 219 USPQ 911 (TTAB (1983).

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pleaded mark; a more descriptive term requires more evidence of secondary meaning. *In re Steelbuilding.com*, 415 F.3d 1293, 75 USPQ2d 1420, 1424 (Fed. Cir. 2005). In determining whether secondary meaning has been established, the Board may examine copying, advertising expenditures, sales success, length and exclusivity of use, unsolicited media coverage, and consumer studies (linking the name to a source). *Id.* On this list, no single factor is determinative. A showing of secondary meaning need not consider each of these elements. Rather, the determination examines all of the circumstances involving the use of the mark. *See Thompson Med. Co., Inc. v. Pfizer Inc.*, 225 USPQ 124 (Fed. Cir. 1985).⁵

Trial Schedule

These consolidated proceedings are resumed. Trial dates for this consolidated case are reset as follows:

Plaintiff's Pretrial Disclosures Due	2/16/2015
Plaintiff's 30-day Trial Period Ends	4/2/2015
Defendant's Pretrial Disclosures Due	4/17/2015
Defendant's 30-day Trial Period Ends	6/1/2015
Plaintiff's Rebuttal Disclosures Due	6/16/2015
Plaintiff's 15-day Rebuttal Period Ends	7/16/2015

⁵ Petitioner should also be mindful that the length of use of a mark alone may not be sufficient to establish acquired distinctiveness. *See, e.g., In re White Jasmine LLC*, 106 USPQ2d 1385, 1396 (TTAB 2013). In addition, to the extent Petitioner relies on evidence at trial similar to that introduced in support of its motion, it would be useful to provide specifics, for example: (1) how many people actually attend its annual music awards on a yearly basis; (2) the number of people to whom it sends its brochure who subscribe to the Blues Access and Blues Review publications; and (3) the number of people who receive its newsletters and press releases. Evidence from disinterested parties, covering each of the years in which Petitioner alleges trademark use, is also useful.

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In each instance, a copy of the transcript of testimony, together with copies of documentary exhibits, must be served on the adverse party within thirty days after completion of the taking of testimony. Trademark Rule 2.125.

Briefs shall be filed in accordance with Trademark Rules 2.128(a) and (b). An oral hearing will be set only upon request filed as provided by Trademark Rule 2.129.