

This Opinion is not a
Precedent of the TTAB

Mailed: April 5, 2016

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

—
(The) Blues Foundation, Inc.

v.

Daniel S. Marolt

—
Cancellation Nos. 92057288 and 92058292
of Registration Nos. 2392429 and 4398094

—
Adam J. Eckstein of Martin, Tate, Morrow & Marston PC,
for (The) Blues Foundation, Inc.

T.C. Johnston of Internet Law, for Daniel S. Marolt.

—
Before Quinn, Kuczma and Adlin,
Administrative Trademark Judges.

Opinion by Kuczma, Administrative Trademark Judge:

(The) Blues Foundation, Inc. (“Petitioner”) filed petitions for cancellation of
Registration Nos. 2392429¹ for the typed mark BLUES HALL OF FAME and

¹ Registration No. 2392429 was registered on the Supplemental Register on October 3, 2000, for: “On line retail store services in the field of books, cd’s, shirts, hats, posters and musical equipment concerning blues musicians,” claiming first use and use in commerce on March 31, 1999. This Registration has been renewed.

4398094² for the standard character mark CHICAGO BLUES HALL OF FAME, both of which are owned by Respondent, Daniel Marolt (“Respondent”).³

Pursuant to Section 24 of the Trademark Act, 15 U.S.C. § 1092, Petitioner alleges priority of use and likelihood of confusion under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), between its unregistered mark BLUES HALL OF FAME for providing recognition in the form of awards to individuals who have had a significant impact on or made a major contribution to the blues music industry, and Respondent’s marks BLUES HALL OF FAME and CHICAGO BLUES HALL OF FAME.

Respondent denies the salient allegations in the Petitions for Cancellation and asserts several Affirmative Defenses including that Petitioner uses BLUES HALL OF FAME in a non-trademark manner, the term lacks secondary meaning, and Petitioner therefore does not have priority, and laches.⁴

² Registration No. 4398094 was registered on the Supplemental Register on September 3, 2013, 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,” based on claimed first use and use in commerce on June 29, 2009.

³ On March 3, 2014, the Board granted Petitioner’s unopposed Motion to Consolidate Cancellation Nos. 92057288 and 92058292 as the parties to the respective proceedings are the same and the proceedings involve common questions of law or fact.

⁴ Applicant’s “defenses” of lack of likelihood of confusion, different classification of goods and services, bad faith, unclean hands, estoppel and waiver were either not raised, or just summarily mentioned, in his brief (Defendant Dan Marolt’s Final Brief p. 27 (55 TTABVUE 28)), so they are deemed waived. *Corporacion Habanos S.A. v. Guantanamera Cigars Co.*, 86 USPQ2d 1473, 1474 n.2 (TTAB 2008) remanded *Guantanamera Cigars Co. v. Corporacion Habanos, S.A.*, 729 F.Supp.2d 246, 98 USPQ2d 1078 (D.D.C. 2010).

I. Evidentiary Issues

Before turning to the merits, we first address Petitioner's evidentiary objections. Petitioner objects to various corrections to Mr. Marolt's testimony deposition set forth in Mr. Marolt's Errata sheet.⁵

We agree with Petitioner that most of the alterations to Mr. Marolt's testimony set forth on the Errata sheet (53 TTABVUE 183-185) are substantive in nature and therefore will not be considered.⁶ "[M]aterial changes in the text are not permitted -- the transcript may not be altered to change the testimony of the witness after the fact." TBMP § 703.01(n). Additionally, Petitioner had no opportunity to cross-examine Mr. Marolt regarding the alterations. *See Entex Industries, Inc. v. Milton Bradley Co.*, 213 USPQ 1116, 1117 n.2 (TTAB 1982) (change in testimony from "...designing that type of game..." to "...designing that Simon Says type of game..." was substantive in nature and not permitted).

⁵ The corrections to Mr. Marolt's testimony deposition were set forth in a list of corrections attached to the end of his transcript. This is not an effective method of correction as "the list of corrections is likely to be overlooked and/or disregarded." Trademark Board Manual of Procedure (TBMP) §703.01(p) (2015).

Moreover, the July 15th, 2015 date written above Mr. Marolt's signature on the deposition transcript (53 TTABVUE 157) appears to be erroneous as Mr. Marolt and his counsel signed the Errata sheet and its certificate of service on July 14, 2015 (53 TTABVUE 185-186). While the submission of Mr. Marolt's signatures on two different dates is puzzling, it does not affect the substance of Petitioner's objections.

⁶ For example, Mr. Marolt's attempted alteration of his testimony to note that the t-shirts do not appear on Exhibit 2 (53 TTABVUE 184), is not admissible. Moreover, Respondent's contention that the Notice of Reliance for Exhibit 2 "is really the website itself, not the screenshots," (55 TTABVUE 10), means that it was Respondent's responsibility to ensure that the evidence submitted in Exhibit 2 reflected the content of his website.

However, Respondent's alteration requested with respect to his testimony found at page 57, lns. 14-15, of his testimony deposition, is permissible as Mr. Marolt states under oath that this alteration is requested due to a transcription error. (53 TTABVUE 185).

Petitioner also objected to Respondent's Trial Exhibit No. 11 introduced during Mr. Marolt's testimony deposition.⁷ To the extent Petitioner admitted that Respondent could have introduced by notice of reliance the parts of Trial Exhibit No. 11 that were screen shots of websites and a newspaper article, containing information sufficient to identify their source and date of the publication, pages 13-16 and 19 of Exhibit 11 are admitted. (53 TTABVUE 237-240, 243). However, such pages are considered to be printed publications which "are admissible and probative only for what they show on their face, not for the truth of the matters contained therein." TBMP §704.08(a). The remaining pages of Exhibit 11 are not admissible.⁸ Mr. Marolt did not take the screen shots of the webpages shown (notably, the webpages did not bear dates of publication and/or the location from which they were obtained), did not know who took the photographs offered in the exhibit, and testified that he received the citation letter sent by Kentucky State Representative W. Keith Hall from either the third-party shown as the addressee or the third-party's wife.⁹

⁷ Marolt Testimony Dep. pp. 89:23-90:6, 139:22-144:1. (53 TTABVUE 90-91, 140-145).

⁸ Marolt Testimony Dep. Exhibit 11 (53 TTABVUE 225-236, 241-242).

⁹ Marolt Testimony Dep. p. 142:16-23 (53 TTABVUE 143).

II. The Record

The record includes the pleadings and, by operation of Trademark Rule 2.122(b), 37 C.F.R. § 2.122(b), Respondent's registration files for Registration Nos. 2392429 and 4398094.

Additionally, Petitioner submitted¹⁰:

1. Jon Hornyak (member of Blues Foundation (p. 27:9-12)) Testimony Deposition and Exhibits (41 TTABVUE);
2. David Less (Executive Director of Blues Foundation 1993-1996 (pp. 7:20-21, 9:25-11:5, 57:18-20), member of Blues Foundation to about 2014 (p. 61:11-14)) Testimony Deposition and Exhibits (46 TTABVUE);
3. Jim O'Neal (founder of Living Blues magazine, member of Blues Foundation Board of Directors in 1980's for 3 years) (pp. 5:11-14 and p. 41)) Testimony Deposition and Exhibits (47 TTABVUE);
4. Jay Sieleman (Executor Director of Blues Foundation 2003-"present" (p. 6:11-17)) Testimony Deposition and Exhibits (42-45 TTABVUE);
5. Jeffrey Syracuse (employee of Broadcast Music Incorporated, member of Blues Foundation Board of Directors since 2012 (pp. 5:8-17, 14:1-9)) Testimony Deposition (50 TTABVUE);
6. Arthur Tipaldi (member of Blues Foundation Board of Directors 1993-2000 and 2002-2008, editor of Blues Music Magazine (pp. 5:16-6:3, 8:17-9:6, 21:3-7)) Testimony Deposition and Exhibits (48 TTABVUE);

¹⁰ Petitioner notes that "As of September 14, 2015, the electronic filings of testimony and exhibits on TTABVUE are incomplete and, on some pages, inaccurate depictions of the exhibits. Therefore, citations to the factual record will be to TTABVUE where the page number depicts an accurate and complete copy of the record. Otherwise, citations to the factual record will be to the Testimony Transcript name, e.g., Wax Dep. [page #]:[line#] – [page #]:[line #], or to the Trial Exhibit Number, e.g., Plaintiff's Trial Exhibit [#]." Petitioner indicated it would file a corrected brief with citations to TTABVUE for each Testimony Transcript and electronic filing, after it confirmed that the electronic filings are complete and accurate. Petitioner Brief p. 8 (52 TTABVUE 9). Although no corrected brief has been filed, Petitioner's identification system sufficiently identifies the evidence on which it relies.

7. William Arthur Wax (retired radio programmer and program director Member of Blues Foundation Board of Directors 2007-2013 (p. 19:2-13)) Testimony Deposition (49 TTABVUE);
8. Notice of Reliance on Website for the Mississippi Blues Trail, Petitioner's Exhibit 2 (17 TTABVUE);
9. Notice of Reliance on Website for BMI, Petitioner's Exhibit 15 (18 TTABVUE);
10. Notice of Reliance on Websites for the Blues Hall of Fame Tour, Petitioner's Exhibit 23 (19 TTABVUE);
11. Notice of Reliance on Various Articles that Reference The Blues Hall of Fame, Petitioner's Exhibit 28 (20 TTABVUE);
12. Notice of Reliance on Blues Access No. 28 Winter 1997 and Its Statement of Circulation, Petitioner's Exhibit 29 (21 TTABVUE);
13. Notice of Reliance on www.blues.org, Petitioner's Exhibit 30 (22 TTABVUE); and,
14. Notice of Reliance on Respondent's Answers to Interrogatory Responses, Exhibit 31 (23 TTABVUE).

Respondent submitted¹¹:

1. Daniel S. Marolt (manager and founder of Respondent's Blues Hall of Fame) Testimony Deposition and Exhibits [only pp. 13-16 and 19 of Exhibit 11 (53 TTABVUE 237-240, 243) are admitted as addressed in section I. above)] (53 TTABVUE);
2. Notice of Reliance on blueshalloffame.com/.org, home page and category index pages, Exhibit 2 (25 TTABVUE);
3. Notice of Reliance on blueshalloffame.com webpages 2002 and 2003- from archive.org, Exhibit 3 (26 TTABVUE);

¹¹ Respondent's "Notice of Reliance on Google Search Results re B.B. King Death Referencing Blues Foundation Hall of Fame" (32 TTABVUE), did not contain a copy of Exhibit 15. Because Exhibit 15 was not attached to the Notice of Reliance it is not part of the record. TBMP § 704.08(b).

4. Notice of Reliance on Chicago Blues Hall of Fame Pages Redirected from chicagoblueshalloffame.org, Exhibit 4 (27 TTABVUE);
5. Notice of Reliance on New York Blues Hall of Fame Pages Redirected from newyorkblueshalloffame.org, Exhibit 5 (28 TTABVUE);
6. Notice of Reliance on Blues Hall of Fame Ceremony at B.B. King's Bar & Grill May 31, 2015 (from bbkingblues.com website), Exhibit 12 (29 TTABVUE);
7. Notice of Reliance on Websites and Publications by and About Blues Foundation Inductees Which Reference Their Induction into "Blues Foundation(s) Hall of Fame," Exhibit 13 (30 TTABVUE);
8. Notice of Reliance on Various Third-Party Online References to "Blues Foundation(s) Hall of Fame," Exhibit 14 (31 TTABVUE);
9. Notice of Reliance on Blues Foundation Recent Uses of "Blues Foundation Hall of Fame" (from websites), Exhibit 16 (33 TTABVUE);
10. Notice of Reliance on Ebony Magazine Blues Hall of Fame 1973-1976, Exhibit 17 (34 TTABVUE);
11. Notice of Reliance on Websites of Third-Party Uses of "Blues Hall of Fame," Exhibit 18 (35 TTABVUE);
12. Notice of Reliance on blueshalloffame.com Merchandise Pages 2002 and Present, Exhibit 19 (36 TTABVUE);
13. Notice of Reliance on Blues Foundation Responses to Requests for Admission, Exhibit 20 (37 TTABVUE);
14. Notice of Reliance on Blues Foundation Responses to Interrogatories, Set One, Exhibit 21 (38 TTABVUE);
15. Notice of Reliance on Blues Foundation Responses to Interrogatories, Set Two, Exhibit 22 (39 TTABVUE); and
16. Notice of Reliance on Blues Foundation Trademark Registrations, Exhibit 23 (40 TTABVUE).

III. Background

Petitioner is The Blues Foundation of Memphis, Tennessee, a non-profit corporation founded in 1980 with the stated mission of preserving blues music history and celebrating blues excellence.¹² In order to promote the blues, Petitioner established the Blues Music Awards, the Blues Hall of Fame, the International Blues Challenge Competition, Keeping the Blues Alive Awards, and the Blues in the Schools programs.

Since its formation, Petitioner has hosted its annual Blues Hall of Fame award dinner program honoring those people who have made a significant contribution to blues music by performing, recording or documenting the blues. The dinner is followed the next day by The Blues Music Awards, formerly known as the W.C. Handy Awards,¹³ given by Petitioner in recognition of the finest in blues performances and recordings. Additionally, Petitioner's Blues Hall of Fame music museum was scheduled to open in Memphis in May 2015.

Respondent is a blues fan living in San Diego, CA. He is a retired construction estimator and has played at blues jams for many years.¹⁴ Respondent decided to start his own "Blues Hall of Fame," first purchasing and setting up several domain names including *blueshalloffame.com* and *blueshalloffame.org* in late 1998 or early 1999.¹⁵

¹² Jay Sieleman Testimony Dep. p. 92 (43 TTABVUE 94).

¹³ Jon Hornyak Testimony Dep. p. 10:8-14 (41 TTABVUE 12); Jay Sieleman Testimony Dep. p. 44:5-8 (42 TTABVUE 46); Jim O'Neal Testimony Dep. pp. 39:12-40:1 (47 TTABVUE 41-42).

¹⁴ Daniel S. Marolt Testimony Dep. pp. 5:13-16, 6:7-7:3 (53 TTABVUE 6, 7-8).

¹⁵ Daniel S. Marolt Testimony Dep. pp. 9:15-10:21 (53 TTABVUE 10-11).

The purpose of his website(s) is to honor all blues artists in the United States and around the world. In late February or early March 1999, he obtained a business license for his Blues Hall of Fame.¹⁶

On April 16, 1999, Respondent filed an application to register BLUES HALL OF FAME on the Principal Register, later amending his application to seek a Supplemental Register registration on June 19, 2000. On October 3, 2000, he received involved Registration No. 2392429 for “On line retail store services in the field of books, CD’s, shirts, hats, posters and musical equipment concerning blues musicians.”

Around 2012, Respondent purchased the domain name CHICAGO BLUES HALL OF FAME. On March 27, 2013, Respondent filed an application to register CHICAGO BLUES HALL OF FAME on the Principal Register, which was also later amended to seek a Supplemental Register registration, on July 9, 2013. On September 3, 2013, he received involved Registration No. 4398094 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.”

¹⁶ Daniel S. Marolt Testimony Dep. pp. 10:22-11:1, 14:9-12, 15:5-8, 30:7-16, 32:3-8 (53 TTABVUE 11-12, 15, 16, 31, 33). Apparently, Respondent’s efforts is a “project of an umbrella company called United Charitable Programs” which is “like an incubator of nonprofit organizations, and they allow smaller operations to just work under their nonprofit license.” Respondent has been underneath the nonprofit company since “... October 2001. ...And [he] just rolled the ... operation into these other names that they’ve established.” Daniel S. Marolt Testimony Dep. pp. 40-41 (53 TTABVUE 41-42).

Respondent admits that CHICAGO BLUES HALL OF FAME is not entitled to a Principal Register registration because “[i]t’s merely descriptive terms.”¹⁷

Respondent’s Blues Hall of Fame has around 200 “Ambassadors” who often nominate artists to his Blues Hall of Fame.¹⁸ His Blues Hall of Fame has about 1000 inductees, and has presented around 700 induction certificates since its inception.¹⁹ Respondent gives inductees certificates bearing his Blues Hall of Fame logo (bearing the registration symbol ®) developed in January 2002.²⁰

IV. Standing

Standing is a threshold issue that must be proven by the plaintiff in every *inter partes* case. *Ritchie v. Simpson*, 170 F.3d 1092, 50 USPQ2d 1023, 1025 (Fed. Cir. 1999); *Lipton Industries, Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185, 189 (CCPA 1982). To establish standing in a cancellation, a petitioner must show both “a real interest in the proceedings as well as a ‘reasonable basis’ for his belief of damage.” *Ritchie v. Simpson*, 50 USPQ2d at 1025.

Petitioner has used the term “Blues Hall of Fame” since at least as early as 1980.²¹ Therefore, Petitioner is not a mere intermeddler. It has established a reasonable basis

¹⁷ Daniel S. Marolt Testimony Dep. p. 47:17-23 (53 TTABVUE 48).

¹⁸ Daniel S. Marolt Testimony Dep. p. 26:14-16 (53 TTABVUE 27).

¹⁹ Daniel S. Marolt Testimony Dep. p. 35:2-8 (53 TTABVUE 36).

²⁰ Daniel S. Marolt Testimony Dep. pp. 23:4-23, 36:14-37:2, 116:6-14 (53 TTABVUE 24, 37-38, 117) and Exhibit 3-3 (26 TTABVUE 7).

²¹ Additionally, Petitioner owns a pending application to register the mark BLUES HALL OF FAME (Serial No. 86027579), which has been refused registration based on a likelihood of confusion with the BLUES HALL OF FAME and CHICAGO BLUES HALL OF FAME marks in Respondent’s Supplemental Register registrations (pursuant to Trademark Act § 2(d), 15

for a belief that it will be damaged by Respondent's Registrations by asserting prior use of BLUES HALL OF FAME and a likelihood of confusion. *Ritchie v. Simpson*, 50 USPQ2d at 1025; *Lipton Industries, Inc. v. Ralston Purina Co.*, 213 USPQ at 189.

V. Likelihood of Confusion Claim

In order to prevail on its § 2(d) claim, Petitioner must establish: 1) prior proprietary rights in the term BLUES HALL OF FAME; and 2) that use of Respondent's marks would be likely to cause confusion with that term. *Herbko Int'l Inc. v. Kappa Books, Inc.*, 308 F.3d 1156, 64 USPQ2d 1375, 1378 (Fed. Cir. 2002); *King Candy Co. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108, 110 (CCPA 1974); *Avtex Fibers Inc. v. Gentex Corp.*, 223 USPQ 625, 626 (TTAB 1984).

Petitioner does not own any federal trademark registrations for BLUES HALL OF FAME. "Under the rule of *Otto Roth*, a party opposing [or seeking to cancel] 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 [or services], whether inherently or through the acquisition of secondary meaning or through 'whatever other type of use may have developed a trade identity.'" *Towers v.*

U.S.C. § 1052(d)). *Empresa Cubana Del Tabaco v. Gen. Cigar Co.*, 753 F.3d 1270, 111 USPQ2d 1058, 1062 (Fed. Cir. 2014); *SaddleSprings Inc. v. Mad Croc Brands Inc.*, 104 USPQ2d 1948, 1950 (TTAB 2012); *ShutEmDown Sports Inc. v. Lacy*, 102 USPQ2d 1036, 1041 (TTAB 2012) (standing shown by evidence that plaintiff's application was refused registration in view of defendant's registration). See Respondent's Exhibit 22 unnumbered pages 3-4, and numbered pages Marolt-Ex. 22 - 5-6, (39 TTABVUE 3-4, 11-12); Jay Sieleman Testimony Dep. pp. 130:12-131:5 (42 TTABVUE 132-133); Petitioner's Brief pp. 27-28, 37 (52 TTABVUE 28-29, 38); Defendant Dan Marolt's Final Brief pp. 6-7, 26, 40 (55 TTABVUE 7-8, 27, 41).

While a copy of Petitioner's application does not appear in the record, both parties' references to the application also lend support to Petitioner's standing.

Advent Software Inc., 913 F.2d 942, 16 USPQ2d 1039, 1041 (Fed. Cir. 1990), *citing Otto Roth & Co. v. Universal Food Corp.*, 209 USPQ at 43; *see also Hoover Co. v. Royal Appliance Mfg. Co.*, 238 F.3d 1357, 57 USPQ2d 1720, 1721 (Fed. Cir. 2001); *Weatherford/Lamb Inc. v. C&J Energy Services Inc.*, 96 USPQ2d 1834, 1838 (TTAB 2010); *Threshold.TV Inc. v. Metronome Enterprises Inc.*, 96 USPQ2d 1031, 1036-37 (TTAB 2010). It is equally clear that if Petitioner’s alleged mark is not distinctive — does not identify source — then there is no basis upon which to compare such a designation with Respondent’s mark to determine whether confusion as to source is likely. *Otto Roth & Co. v. Universal Foods Corp.*, 209 USPQ at 44.²²

We begin by looking at the meaning of the term BLUES HALL OF FAME. The term “blues” is defined as:

2. (used with a singular verb) Jazz.
 - a. a song, originating with American blacks, that is marked by the frequent occurrence of blues notes, and that takes the basic form, customarily improvised upon in performance, of a 12-bar chorus consisting of a 3-line stanza with the second line repeating the first.

²² Claiming it has “valid grounds” for cancelling Respondent’s registrations, Petitioner moves to amend its pleadings to conform to the evidence pursuant to Fed. R. Civ. P. 15(b). Petitioner’s Brief p. 38, fn. 5 (52 TTABVUE 39). Rule 15(b) of the Federal Rules of Civil Procedure provides that “when an issue not raised by the pleadings is tried by the parties’ express or implied consent, it must be treated in all respects as if raised in the pleadings.” Implied consent to the trial of an unpleaded issue can be found only where the nonoffering party: (1) raised no objection to the introduction of evidence offered in support of the issue; and (2) was fairly apprised that the evidence was being offered in support of the issue. *See, Morgan Creek Productions Inc. v. Foria Int’l Inc.*, 91 USPQ2d 1134, 1138 (TTAB 2009); TBMP § 507.03(b). Respondent objects to Petitioner’s “motion” to amend its pleadings to conform to the evidence. (55 TTABVUE 30-31). Moreover, Petitioner failed to provide any support for adding new claims (*i.e.*, Respondent’s nonuse of its marks prior to “applying” for registration renders his registrations void *ab initio* (52 TTABVUE 39); use of Blues Hall of Fame by Respondent was not “lawful use” (52 TTABVUE 42); or abandonment (52 TTABVUE 44)). None of these issues were tried by consent, express or implied. Accordingly, Petitioner’s motion is denied.

b. the genre constituting such songs

dictionary.reference.com/browse/blues Dictionary.com. Unabridged. Random House Dictionary, © Random House, Inc. 2016.

2. black folk music characterized by minor harmonies, typically slow tempo, and melancholy words

3. the form of jazz that evolved from this

4. a song or composition in this style

www.collinsdictionary.com/dictionary/american/blues © Collins 2016

2: a song often of lamentation characterized by usually 12-bar phrases, 3-line stanzas in which the words of the second line usually repeat those of the first, and continual occurrence of blue notes in melody and harmony.

www.merriam-webster.com/dictionary/blues. © 2015 Merriam-Webster, Incorporated.

The definition of “hall of fame” is:

1. [COUNTABLE] AMERICAN a place where people go to learn about a particular sport or activity and the famous people who do it

2. [SINGULAR] the group of people who are most famous for doing a particular activity

www.macmillandictionary.com/dictionary/american/hall-of-fame © Macmillan Publishers Limited 2009-2016

1. a memorial in New York City containing busts and tablets honoring celebrated Americans

2. any similar memorial honoring a renowned achiever in a particular sport or other activity

www.collinsdictionary.com/dictionary/american/hall-of-fame © Collins 2016

1. a structure housing memorials to famous or illustrious individuals usually chosen by a group of electors

www.merriam-webster.com/dictionary/hall%20of%20fame © 2015 Merriam-Webster, Incorporated.

Based on the foregoing definitions,²³ “Blues” is a type of song or music, and “hall of fame” is either a building honoring famous people, or a group of famous people.

²³ The Board may take judicial notice of dictionary definitions, *Univ. of Notre Dame du Lac v. J.C. Gourmet Food Imp. Co.*, 213 USPQ 594, 596 (TTAB 1982), *aff'd*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983), including online dictionaries that exist in printed format or have regular fixed editions. *In re Red Bull GmbH*, 78 USPQ2d 1375, 1378 (TTAB 2006).

Thus, “Blues Hall of Fame” is a descriptive phrase meaning either a structure honoring people famous for blues music, or a group of people who are famous for blues music.²⁴

It is Petitioner’s burden to demonstrate that its BLUES HALL OF FAME designation has acquired distinctiveness prior to the earliest date upon which Respondent can rely. *See Towers v. Advent Software, Inc.*, 16 USPQ2d at 1041 *citing Otto Roth*, 209 USPQ at 43; *Threshold.TV Inc. v. Metronome Enterprises Inc.*, 96 USPQ2d at 1037-38. Petitioner concedes as much.²⁵

Since its founding in 1980, Petitioner has given out a Blues Hall of Fame award.²⁶ While Ebony Magazine previously had a Black Music Hall of Fame that gave awards within the blues category, its awards program only lasted a few years during the 1970’s and was not around when Petitioner issued its first Blues Hall of Fame awards.²⁷

²⁴ *See In re Gold’s Gym Enterprises Inc.*, 3 USPQ2d 1716, 1717 (TTAB 1987) (“applicant, according to its identification, maintains and conducts an exhibition displaying outstanding individuals and events in the sport of bodybuilding. In view of the dictionary definition of the term ‘hall of fame’ made of record by the Examining Attorney, supra, we think the term BODYBUILDING HALL OF FAME clearly indicates that applicant’s exhibition features individuals who have acquired fame or illustriousness in the world of bodybuilding. We think the term sought to be registered when used in connection with applicant’s services, readily describes a significant feature of the recited services and no degree of thought or imagination is necessary to discern the nature of them.”).

²⁵ Petitioner’s Brief pp. 45-46 (52 TTABVUE 46-47).

²⁶ Jim O’Neal Testimony Dep. pp. 32:24-33:3 (47 TTABVUE 34-35).

²⁷ Jim O’Neal Testimony Dep. pp. 9:21-10:2 (47 TTABVUE 11-12); *also see* Respondent’s Notice of Reliance on Ebony Magazine Blues Hall of Fame 1973-1976 Exhibit 17 (34 TTABVUE 2-9) which lists “BLUES” as the category and “Hall of Fame” as the selection in the “BLUES” category; David Less Testimony Dep. 41:16-42:1 (46 TTABVUE 43-44).

There is no dispute that Petitioner used BLUES HALL OF FAME well before Respondent began using the same term. Petitioner's use of BLUES HALL OF FAME began with its founder, Joe Savarin, around 1980. Mr. Savarin had the concept to form "an organization called The Blues Foundation" that included hosting a Blues award ceremony and a Blues Hall of Fame.²⁸ Thus, from its beginning, Petitioner had a Blues Hall of Fame award.²⁹

Petitioner uses the term BLUES HALL OF FAME as the name of its award given to persons recognized by others in the Blues community for achieving a lifetime of excellence.³⁰ As reported in the Winter 1980-81 issue of Living Blues magazine, Petitioner welcomed the first members into its Blues Hall of Fame in 1980.³¹ Every year from 1980 to the present, Petitioner has held a dinner honoring those people admitted to its Hall of Fame for that year. Petitioner's Blues Hall of Fame induction is a ceremony taking place the night before its Blues Music Awards and is not open to the general public. All of the attendees to the Blues Hall of Fame induction ceremony are Petitioner's invited guests.³² A biography and official summary of each

²⁸ Jim O'Neal Testimony Dep. pp. 12:17-13:10 (47 TTABVUE 14-15).

²⁹ Jim O'Neal Testimony Dep. pp. 32:24-33:3 (47 TTABVUE 34-35).

³⁰ Jay Sieleman Testimony Dep. p. 92:16-23 (42 TTABVUE 94) David Less Testimony Dep. p. 17:7-13 (46 TTABVUE 19).

³¹ Jim O'Neal Testimony Dep. pp. 17:10-18:4 and Exhibit 21 (47 TTABVUE 19-20, 58-59). The circulation of Living Blues was about 5,000 subscribers and the magazine was shared with additional readers. Jim O'Neal Testimony Dep. p. 18:21-23 (47 TTABVUE 20).

³² Jay Sieleman Testimony Dep. pp. 41:15-20, 57:15-25 (42 TTABVUE 43, 59); Notice of Reliance on Blues Foundation Responses to Interrogatories, Set Two, Interrogatory No. 65 Exhibit 22-13, 14 (39 TTABVUE 19-20).

Hall of Fame inductee for that year is included in its Blues Music Awards program.³³ Today, Petitioner's Blues Hall of Fame is well established; it is the pinnacle of achievement for blues artists.³⁴ Additionally, the grand opening of Petitioner's Blues Hall of Fame museum was scheduled for May 8, 2015.³⁵

Although the Blues Music Awards ceremonies were initially locally oriented (*i.e.*, more attendees from the Memphis area), by 1985, word had gotten out and people from other parts of the country started to attend the awards.³⁶ The program for The 6th Annual Blues Awards Show (in 1985) featured the "Blues Hall of Fame Inductees from 1980 through 1984" listing the people inducted into the Blues Hall of Fame during those years.³⁷ As of 1996, and for each year back to 1980, Petitioner's Blues Awards program listed the incoming members of the Blues Hall of Fame; there was no other Blues Hall of Fame in existence during that time.³⁸ In 1999 and 2000, the Blues Hall of Fame induction was held in Washington, D.C. Before that time, the Blues Hall of Fame inductions were held in Memphis and Los Angeles.³⁹

³³ Jay Sieleman Testimony Dep. pp. 47:9-18, 52:13-17 (42 TTABVUE 49, 54); David Less Testimony Dep. p. 39:3-6 (46 TTABVUE 41).

³⁴ Jim O'Neal Testimony Dep. pp. 36:23-37:5 (47 TTABVUE 38-39).

³⁵ Jay Sieleman Testimony Dep. p. 92:12-15 (42 TTABVUE 94).

³⁶ Jim O'Neal Testimony Dep. pp. 21:21-22:6 (47 TTABVUE 23-24).

³⁷ Jim O'Neal Testimony Dep. p. 42:1-18, Exhibit 22 (47 TTABVUE 44, 80).

³⁸ David Less Testimony Dep. pp. 39:3-39:6, 41:16-42:1 (46 TTABVUE 41, 43-44); Arthur Tipaldi Testimony Dep. p. 29:6-14 (48 TTABVUE 31); Jim O'Neal Testimony Dep. Exhibit 22 (47 TTABVUE 80).

³⁹ Arthur Tipaldi Testimony Dep. pp. 20:18-25; 21:8-14; 25:18-26:8 (48 TTABVUE 22, 23, 27-28).

Over the years, Petitioner and third parties have promoted the Blues Hall of Fame. For example, one of Plaintiff's witnesses and former Board member, William Arthur Wax, a retired radio programmer and program director,⁴⁰ first learned about Petitioner's Blues Hall of Fame in the late 1980's through his subscription to the Living Blues magazine which ran periodic articles about inductions into Petitioner's Blues Hall of Fame.⁴¹ When Mr. Wax was employed as a disc jockey in Columbia, Missouri from 1986 to 1988, he talked about the "new names that [were] inducted into the Blues Hall of Fame..." on the air and "would do a [radio] show playing the music of the artists that had been inducted into the Blues Hall of Fame." While those audiences were "probably about ... 3[,000] or 4,000 listeners," he moved on to Washington, D.C. and began doing a daily radio show there called the "Blues Plate Special," which had approximately 20,000 listeners. Each year, the Blues Plate Special did two or three shows about that year's Blues Hall of Fame inductees.⁴²

From a booth at the House of Blues "centerpiece" pavilion located on the grounds of the 1996 Atlanta Summer Olympics, Petitioner sold merchandise and memberships, and distributed copies of its programs from its 1996 "Handy" awards, which mentioned the "Blues Hall of Fame." For years, Petitioner went to the Beale Street Festival in Memphis and the Chicago Blues Festival and distributed brochures

⁴⁰ Mr. Wax was on the Board of Directors of the Blues Foundation from 2007-2013, serving as Chairman from 2011-2013. At the time of his testimony he was a current member of Petitioner's Board. William Arthur Wax Testimony Dep. pp. 5:8-13, 19:2-13 (49 TTABVUE 7, 21).

⁴¹ William Arthur Wax Testimony Dep. p. 7:24-8:7 (49 TTABVUE 9-10).

⁴² William Arthur Wax Testimony Dep. pp. 9:16-10:3, 10:12-11:5 (49 TTABVUE 11-13).

that featured the BLUES HALL OF FAME; it also distributed the brochures in Des Moines, Iowa; the Poconos; Florida; and Eureka Springs, Arkansas.⁴³

It is clear that Petitioner has used the term BLUES HALL OF FAME to identify an award it gives out each year. However, Petitioner, and third parties, have used other terms to identify the award. For example, on the first page of its ballot for the 1979-80 W.C. Handy Blues awards, Petitioner's Hall of Fame awards are identified in large bold letters as "HALL OF FAME AWARDS."⁴⁴ Even in recent years, Petitioner continues to identify its "Hall of Fame" by various names. For example, Petitioner's website features an image of its new building having signage on the front center of the building identifying it as "The Blues Foundation Hall of Fame."⁴⁵ Petitioner also used "The Blues Foundation Hall of Fame" in its promotional pamphlets to raise funds for building its Blues Hall of Fame building.⁴⁶

The November/December 1990 edition of Living Blues magazine lists the W.C. Handy Awards for 1990 identifying the Blues Hall of Fame awards under the title HALL OF FAME;⁴⁷ the Summer 1994 edition of the Blues Revue Quarterly magazine

⁴³ David Less Testimony Dep. pp. 46:19-53:24, 56:14-17, Exhibit 18 (46 TTABVUE 48-55, 58, 136-137).

⁴⁴ Jim O'Neal Testimony Dep. p. 15:2-18 and Exhibit 20 (47 TTABVUE 17, 55).

⁴⁵ Respondent's Notice of Reliance on Blues Foundation Recent Uses of "Blues Foundation Hall of Fame" Exhibit 16 <http://www.donate-blueshalloffame.org/make-a-donation> 5/5/2015 (33 TTABVUE 7). The signage that was actually put up on the building says "The Blues Foundation" with "Blues Hall of Fame" spaced to the sides. Jay Sieleman Testimony Dep. pp. 11:23-12:10, Exhibit 3 (42 TTABVUE 13-14, 169).

⁴⁶ Jon Hornyak Testimony Dep. pp. 27:18-29:9 (41 TTABVUE 30-31).

⁴⁷ Petitioner's Notice of Reliance on Various Articles That Reference The Blues Hall of Fame Exhibit 28 Living Blues magazine November/December 1990 (20 TTABVUE 17).

has an announcement of Petitioner's awards identifying "W.C. Handy Award Winners, The Blues Hall of Fame and Keeping the Blues Alive Awards" while listing the "Hall of Fame Inductees";⁴⁸ and an article entitled "Keepers of the Blues Flame — Bobby 'Blue' Bland, Ahmet Ertegun receive Lifetime Achievement Awards from the Blues Foundation," mentions "the fourth annual Lifetime Achievement Awards and Hall of Fame induction from the Blues Foundation"⁴⁹

Likewise, numerous online and in-print articles about various blues performers admitted into Petitioner's Hall of Fame reference the "Blues Foundation(s) Hall of Fame." For example (emphasis added below):

"B.B. King is inducted into the first class of the **Blues Foundation Hall of Fame.**" ... "[Elmore James, an African American blues guitarist and singer] was elected to the **Blues Foundation's Hall of Fame** in 1980 and was later elected to the Rock & Roll Hall of Fame." ... "[Bill] Broonzy was inducted into the **Blues Foundation Hall of Fame** in 1980."⁵⁰

"Big Walter [Horton] died in 1981, and the following year he was inducted into the **Blues Foundation's Hall of Fame.**"⁵¹

⁴⁸ Arthur Tipaldi Testimony Dep. Exhibit 24 (48 TTABVUE 57).

⁴⁹ Petitioner's Notice of Reliance on Various Articles That Reference The Blues Hall of Fame Exhibit 28 Keepers of the Blues Flame Bobby "Blue" Bland, Ahmet Ertegun receive Lifetime Achievement Awards from the Blues Foundation November 11, 1998 L.A. Times (20 TTABVUE 49-50).

⁵⁰ Respondent's Notice of Reliance on Websites and Publications by and About Blues Foundation Inductees which Reference Their Inductions into "Blues Foundation(s) Hall of Fame" Exhibit 13, Rock and Roll Hall of Fame Museum B.B. King <https://rockhall.com/inductees/bb-king/timeline/> [4/8/2015]; "Big Bill" Broonzy, The Encyclopedia of Arkansas History & Culture, www.encyclopediaofarkansas.net/encyclopedia/entry-detail.aspx?entryID=2489 [4/7/2015]; Elmore James, African American Registry, www.aaregistry.org/historic_events/view/main-source-electric-guitar-elmore-james [4/8/2015] (30 TTABVUE 21, 32, 34).

⁵¹ Respondent's Notice of Reliance Exhibit 13, Blind Pig Records, Walter Horton, www.blindpigrecords.com/index.cfm?section=artists&artistid=31 © 2015 [4/8/2015] (30 TTABVUE 67).

“Mr. Speaker, Ray Charles was inducted into the **Blues Foundation’s Hall of Fame** in 1982 and was inducted into the Rock and Roll’s Hall of Fame in its inaugural year 1986.”⁵²

“[Ma Rainey] was inducted into several halls of fame including the **Blues Foundation’s Hall of Fame** in 1983, the Rock and Roll Hall of Fame in 1990, the Georgia Music Hall of Fame in 1992, and the Georgia Women of Achievement in 1993.” “Ma Rainey was inducted into the **Blue Foundation’s Hall of Fame** in 1990, the same year she was inducted into the Rock and Roll Hall of Fame.” “Rainey was inducted into the **Blues Foundation Hall of Fame** in 1983,”⁵³

“Big Mama Thornton dies of a heart attack July 25, 1984 That same year, she was inducted into the **Blues Foundation Hall of Fame**.”⁵⁴

“[Slim Harpo] Moore was inducted into the **Blues Foundation Hall of Fame** in 1985, and his song, ‘I’m a King Bee,’ was named to the Grammy Hall of Fame in 2008.”⁵⁵

“That honor was followed in 1986 with membership in the **Blues Foundation Hall of Fame**, and in 1988, Lead Belly’s work was honored by the Rock and Roll Hall of Fame.”⁵⁶

⁵² Respondent’s Notice of Reliance Exhibit 13, Congressional Record 13258 June 22, 2004-House Ray Charles (30 TTABVUE 76).

⁵³ Respondent’s Notice of Reliance Exhibit 13, Columbus Parks and Recreation Department, Ma Rainey Home “She was inducted into several halls of fame including the Blues Foundation’s Hall of Fame in 1983,” www.columbusga.org/parks/marainey/marainey.htm [4/12/2015]; Rock & Roll Hall of Fame and Museum Ma Rainey Biography rockhall.com/inductees/ma-rainey/bio/ “... was inducted into the Blue Foundation’s Hall of Fame in 1990, ...”; Ma Rainey in BlackHistoryNow “Rainey was inducted into the Blues Foundation Hall of Fame in 1983, ...” Jun 15th, 2011 [4/13/2015] (30 TTABVUE 84, 85, 87).

While these references cite different years for Ma Rainey’s induction into Petitioner’s Blues Hall of Fame, the years cited are well before Respondent began using Blues Hall of Fame.

⁵⁴ Respondent’s Notice of Reliance Exhibit 13, Texas State Historical Association, Thornton, Willie Mae [Big Mama] tshaonline.org/handbook/online/articles/fthpg Uploaded on June 15, 2010 [4/14/2015] (30 TTABVUE 98).

⁵⁵ Respondent’s Notice of Reliance Exhibit 13, Know LA Encyclopedia of Louisiana, Slim Harpo (James “Slim Harpo” Moore) www.knowla.org/entry/1191/ Published November 16, 2011 [4/14/2015] (30 TTABVUE 106).

⁵⁶ Respondent’s Notice of Reliance Exhibit 13, Texas State Historical Association, Huddie [Leadbelly] Ledbetter tshaonline.org/handbook/online/articles/fle Uploaded on June 15, 2010 [4/14/2015] (30 TTABVUE 111).

“[Jay ‘Hootie’ McShann] was inducted into the **Blues Foundation’s Hall of Fame** in 1987 and received a Pioneer Award from the Rhythm and Blues Foundation in 1996.”⁵⁷

“1988 ... Johnny [Winter] is inducted into the **Blues Foundation Hall of Fame**.”⁵⁸

“Memphis Slim’ was inducted into the **Blues Foundations’ Hall of Fame** in 1989.”⁵⁹

“[Arthur ‘Blind’ Blake] was inducted into the **Blues Foundation’s Hall of Fame** in 1990.”⁶⁰

“Johnny Shines died on April 20, 1992, the same year he was inducted into the **Blues Foundation’s Hall of Fame**.”⁶¹ ... “1992 was particularly eventful year, seeing [Lowell Fulson] inducted into the **Blues Foundation Hall of Fame** as an artist, and winning Blues Foundation Music Award for Traditional Album of the Year for *Hold On*.”⁶²

“Edwards was inducted into the **Blues Foundation’s Hall of Fame** in 1996.”⁶³

⁵⁷ Respondent’s Notice of Reliance Exhibit 13, Jazz Pioneer Jay McShann Dies at 90 jazztimes.com/articles/23539-jazz-pioneer-jay-mcshann-dies-at-90 12/08/06 [4/20/2015] (30 TTABVUE 117).

⁵⁸ Respondent’s Notice of Reliance Exhibit 13, Johnny Winter Biography www.johnnywinter.com/about/ © 2010 [4/20/2015] (30 TTABVUE 120).

⁵⁹ Respondent’s Notice of Reliance Exhibit 13, Sunnyside Records Memphis Slim (John Chatman) www.sunnysiderecords.com/artist.php?id=247 [4/20/2015] (30 TTABVUE 135).

⁶⁰ Respondent’s Notice of Reliance Exhibit 13, Arthur “Blind” Blake www.findagrave.com/cgi-bin/fg.cgi?page=gr&GRid=6428540 Record added 2002. [4/20/2015] (30 TTABVUE 139).

⁶¹ Respondent’s Notice of Reliance Exhibit 13, African American Registry, Johnny Shines www.aaregistry.org/historic_events/view/johnny-shines-tennessee-bluesman [4/20/2015] Copyright, African American Registry, 2000 to 2013 (30 TTABVUE 144).

⁶² Respondent’s Notice of Reliance Exhibit 13, Lowell Fulson’s “Them Update Blues” is Great Blues, October 30, 2014 www.chicagoblues.com/lowell-fulsons-update-blues-great-blues [4/14/2015] (30 TTABVUE 147).

⁶³ Respondent’s Notice of Reliance Exhibit 13, *Variety* Bluesman David ‘Honeyboy’ Edwards Dies August 29, 2011, <http://variety.co/2011/music/news/bluesman-david-honeyboy-edwards-dies-1118041947/> (30 TTABVUE 152).

“In 1997 [Charles Brown] was inducted into the **Blues Foundation’s Blues Hall of Fame.**”⁶⁴ ... “[Brownie McGhee] was inducted into the **Blues Foundation’s Hall of Fame** in 1997.”⁶⁵ ... “In 1997, [Koko Taylor] was inducted into the **Blues Foundation’s Hall of Fame.**”⁶⁶

These quotes come from a wide variety of different sources (published after Respondent registered its BLUES HALL OF FAME mark in 2000), each identifying Petitioner’s Hall of Fame as “Blues Foundation(s) Hall of Fame.” They demonstrate how third parties and the media commonly identify Petitioner’s Hall of Fame to the public.⁶⁷

Additionally, some third parties utilize “Blues Hall of Fame” in connection with their own recognition of blues performers, musicians and supporters. For example, the record reflects use of the following names around the country: Arizona Blues Hall of Fame, Cleveland Blues Hall of Fame, Louisiana Blues Hall of Fame, Minnesota Blues Hall of Fame, OK [Oklahoma] Blues Hall of Fame and Sac [Sacramento] Blues Hall of Fame.⁶⁸

⁶⁴ Respondent’s Notice of Reliance Exhibit 13, Alligator Records Charles Brown www.alligator.com/artists/Charles-Brown/ © 2015 [4/10/2015] (30 TTABVUE 150).

⁶⁵ Respondent’s Notice of Reliance Exhibit 13, Walter Brown “Brownie” McGhee-Born November 30, 1915 in Knoxville, TN Died February 16, 1996 in Oakland, CA <http://bluegillzzpond.com/deep-pond> [4/10/2015] (30 TTABVUE 157).

⁶⁶ Respondent’s Notice of Reliance Exhibit 13, Alligator Records Koko Taylor <http://alligator.com/artists/Koko-Taylor> [4/10/2015] (30 TTABVUE 159).

⁶⁷ For additional examples of third-party use of “Blues Foundation(s) Hall of Fame” see Respondent’s Notice of Reliance on Various Third-Party Online References to “BLUES FOUNDATION(S) HALL OF FAME” Exhibit 14 (31 TTABVUE 6).

⁶⁸ Respondent’s Notice of Reliance on Websites of Third-Party Uses of “Blues Hall of Fame” Exhibit 18 (35 TTABVUE 5, 7-8, 10, 11, 12, 13, 16).

As noted above, Petitioner must show that its use of BLUES HALL OF FAME has acquired distinctiveness. In order to establish acquired distinctiveness, or secondary meaning, Petitioner must show that “in the minds of the public, the primary significance of [BLUES HALL OF FAME] is to identify the source of the [services] rather than the [services] itself.” *Inwood Labs., Inc. v. Ives Labs.*, 456 U.S. 844, 214 USPQ 1, 4 n. 11 (1982); *Coach Services Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1729 (Fed. Cir. 2012); *In re Dial-A-Mattress Operating Co.*, 240 F.3d 1341, 57 USPQ2d 1807, 1812 (Fed. Cir. 2001).

Evidence of acquired distinctiveness can include the length and exclusivity of use of the mark, advertising expenditures, consumer studies, sales success, unsolicited media coverage, and attempts to plagiarize. There are undoubtedly other types of evidence that would also be relevant to a claim of secondary meaning. *See Coach Services Inc. v. Triumph Learning LLC*, 101 USPQ2d at 1729; *In re Steelbuilding.com*, 415 F.3d 1293, 75 USPQ2d 1420, 1424 (Fed. Cir. 2005); *Threshold.TV Inc. v. Metronome Enterprises Inc.*, 96 USPQ2d at 1038-39.

Despite the fact that Petitioner used BLUES HALL OF FAME for many years prior to Respondent’s adoption and use of the same term,⁶⁹ the evidence of record does not persuade us that the public has either come to associate the highly descriptive designation BLUES HALL OF FAME only with Petitioner, or recognizes the

⁶⁹ While Respondent introduced testimony and documentary evidence to support his claimed dates of first use of BLUES HALL OF FAME and CHICAGO BLUES HALL OF FAME, because Petitioner has not established that it has acquired distinctiveness in BLUES HALL OF FAME, we need not consider Respondent’s priority evidence.

designation as a mark identifying services provided only by Petitioner. *Universal Foods Corp. v. Otto Roth & Co., Inc.*, 215 USPQ 1140, 1145 (TTAB 1982) (“Brie Nouveau” seems to be one of several terms -- “Brie Nouveau,” “Nouveau,” “Ile De France 60 percent,” “Double Creamy Brie”-- by which the product is called for); *Fluid Energy Processing & Equipment Co. v. Fluid Energy, Inc.*, 212 USPQ at 36 (trade name use of “FLUID ENERGY” held insufficient to support § 2(d) claim, since opposer failed to establish distinctiveness (*i.e.*, proprietary rights) in the term “FLUID ENERGY”); *Antillian Cigar Corp. v. Benedit Cigar Corp.*, 218 USPQ 187, 189 (TTAB 1983) (no evidence showing that “Antillian” has acquired a secondary meaning).

To the contrary, third parties have also used BLUES HALL OF FAME to identify their own endeavors. Rather than showing BLUES HALL OF FAME has acquired significance as a trademark, such evidence supports a lack of trademark distinctiveness. *See Levi Strauss & Co. v. Genesco, Inc.*, 742 F.2d 1401, 222 USPQ 939, 940-41 (Fed. Cir. 1984) (“When the record shows that purchasers are confronted with more than one (let alone numerous) independent users of a term or device, an application for registration under Section 2(f) cannot be successful, for distinctiveness on which purchasers may rely is lacking under such circumstances.”). *See also, Hoover Co. v. Royal Appliance Manuf’g Co.*, 57 USPQ2d at 1722 (opposer presented no evidence showing how consumers actually perceive the merely descriptive slogan and only minimal evidence of the use of the slogan); *In re Meyer & Wenthe, Inc.*, 267 F.2d 945, 122 USPQ 372, 376 (CCPA 1959) (it was incumbent upon applicant to submit proof that its mark is distinctive, not only to experts in the field, but to

purchasing public); *Ayoub, Inc. v. ACS Ayoub Carpet Serv.*, ___ USPQ2d ___, Opp. No. 91211014, slip. op. at 32 (TTAB March 31, 2016) (widespread use of the surname Ayoub is inconsistent with claim of acquired distinctiveness); *Racine Industries Inc. v. Bane-Clene Corp.*, 35 USPQ2d 1832, 1839-40 (TTAB 1994) (while use of the term was continuous, could not be said to have been substantially exclusive).

Although we have considered all of the evidence with respect to acquired distinctiveness, this evidence must be weighed against the highly descriptive nature of the term BLUES HALL OF FAME as applied to Petitioner's award and its services rendered in connection therewith. Given that this term is so highly descriptive, Petitioner's burden of proving acquired distinctiveness is very high, thus, much more evidence is necessary to show that the designation has become distinctive of Petitioner's services.

Distinctiveness means that the primary meaning of the term BLUES HALL OF FAME is as a designation of source rather than of a characteristic, that is, that its primary meaning, in the field in which it is used by Petitioner, is as a designation of source rather than of a characteristic of its services. While there is no dispute that Petitioner used the term BLUES HALL OF FAME well before Respondent, Petitioner has failed to establish that the designation BLUES HALL OF FAME has acquired distinctiveness as a source-indicator of Petitioner for providing award recognition to individuals who have had a significant impact on or made a major contribution to the blues music industry. Rather, the term BLUES HALL OF FAME is a highly descriptive term which identifies a significant feature of the services, if not the

services themselves.⁷⁰ *See, e.g., In re Steelbuilding.com*, 75 USPQ2d at 1424 (“the applicant’s burden of showing acquired distinctiveness increases with the level of descriptiveness; a more descriptive term requires more evidence of secondary meaning.” ... “The proposed mark is highly descriptive. Therefore, applicant had the burden to show a concomitantly high level of secondary meaning.”); *In re Boston Beer Co. L.P.*, 198 F.3d 1370, 53 USPQ2d 1056 (Fed. Cir. 1999) (claim based on annual sales under the mark of approximately eighty-five million dollars, and annual advertising expenditures in excess of ten million dollars, not sufficient to establish acquired distinctiveness in view of highly descriptive nature of mark); *In re Bongrain Int’l (American) Corp.*, 894 F.2d 1316, 13 USPQ2d 1727, 1729 (Fed. Cir. 1990) (the greater degree of descriptiveness the term has, the heavier the burden to prove it has attained secondary meaning); *Perma Ceram Enterprises Inc. v. Preco Indus. Ltd.*, 23 USPQ2d 1134, 1138 (TTAB 1992) (where the mark relied upon by a plaintiff in support of its priority of use and likelihood of confusion claim is merely descriptive, then the plaintiff must establish priority of acquired distinctiveness in order to prevail on the Section 2(d) claim).

We have considered all of the evidence made of record pertaining to whether Petitioner has acquired distinctiveness in BLUES HALL OF FAME, including the evidence and/or arguments not specifically discussed in this opinion. We find that

⁷⁰ Petitioner’s long use of BLUES HALL OF FAME would be strong evidence against a finding that the term BLUES HALL OF FAME could ever become distinctive of Respondent’s services. *See McCormick & Co. v. Summers*, 354 F.2d at 668, 148 USPQ 272, 276 (CCPA 1966).

Petitioner has failed to carry that burden. Its failure to prove its ownership of proprietary rights in BLUES HALL OF FAME means that it cannot prevail on its claim under § 2(d) of the Trademark Act. *Otter Products LLC v. BaseOneLabs LLC*, 105 USPQ2d at 1256. Therefore, Petitioner's priority and likelihood of confusion claims are dismissed in this consolidated proceeding.

Decision: Cancellation Proceeding Nos. 92057288 and 92058292 on the ground of likelihood of confusion are dismissed.