Oral Hearing: March 26, 2015 Mailed: September 6, 2017

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Momentum Development LLC

Serial No. 85826122

Pankaj S. Raval for Momentum Development LLC.

Rudy R. Singleton, Trademark Examining Attorney, Law Office 102,
Mitchell Front, Managing Attorney.

Before Quinn, Kuhlke,[1] and Wolfson,
Administrative Trademark Judges.

Opinion by Wolfson, Administrative Trademark Judge:

Momentum Development LLC ("Applicant") seeks registration on the Principal Register of the mark JORDAN MAXWELL (in standard characters) for

> Digital media, namely, pre-recorded video cassettes, digital video discs, digital versatile discs, downloadable audio and video recordings, DVDs, and high definition digital discs featuring talks, lectures and presentations by Russell Joseph Pine a.k.a. Jordan Maxwell,

in International Class 9.[2]

[1] Judge Kuhlke is substituted for Judge Bucher who has retired from Federal service.

[2] Application Serial No. 85826122 was filed on January 17, 2013, under Section 1(a) of the Trademark Act, 15 U.S.C. § 1052(a), based upon Applicant's allegation of first use and first use in commerce of the mark on October 16, 2009.

The Trademark Examining Attorney refused registration of Applicant's mark under Trademark Act Section 2(c), 15 U.S.C. § 1052(c), on the ground that the mark comprises the pseudonym "Jordan Maxwell," which name identifies a living individual whose written consent to Applicant's registration of the mark is not of record.

When the refusal was made final, Applicant filed a request for reconsideration and a notice of appeal to the Board. When the request for reconsideration was denied, the appeal resumed and has been fully briefed. An oral hearing was held on March 26, 2015.

Background of Proceedings

On January 17, 2013, Momentum Development, LLC filed the present application for the mark JORDAN MAXWELL, with a claim that Jordan Maxwell's consent "is made of record."[3] In support of its claim, Applicant attached a document entitled "Assignment of Intellectual Property" executed on March 30, 2010, by "Russell Joseph Pine, aka Jordan Maxwell" in favor of "Josef Dolezal" as "Buyer."[4]

The Examining Attorney refused registration under Section 2(c) and required Applicant to provide (1) a statement that "JORDAN MAXWELL identifies the pseudonym/stage name of Joseph Pine, a living individual whose consent is of record" and (2) a written consent in favor of Momentum Development, LLC signed by Mr. Pine. Although the identification statement was made of record, Applicant did not

[3] TEAS Plus New Application, January 17, 2013.

[4] *Id.*, at "original pdf file" link. The assignment was also submitted as part of Applicant's May 16, 2014 Request for Reconsideration, TSDR 12.

provide any documentation beyond that which it had filed with its original application, and the Examining Attorney made his refusal final. Following the issuance of the final refusal, Applicant filed a request for reconsideration, which was denied. Thereafter, proceedings resumed and Applicant and the Examining Attorney filed their appeal briefs. An oral hearing was held on March 26, 2015.

Following the oral hearing, the Board remanded the case to consider whether the named applicant, Momentum Development LLC, owned the application when it was filed on January 17, 2013 or whether it was in fact owned by Josef Dolezal, in which case it would be considered void *ab initio.* On April 21, 2015, Josef Dolezal filed a *nunc pro tunc* assignment, assigning the application as of January 1, 2013 to Momentum Developments LLC.[5] The filing was incomplete however; it referred to an "Exhibit A"[6] that was not attached and which was not provided until April 20, 2017 (two years later), by which time the application had been abandoned for failure to respond to an Office Action. Following abandonment, Applicant filed a Petition to Revive with the Director, together with a copy of Exhibit A. The Petition to Revive was granted, the application reinstated, and the case was returned to the Examining Attorney to consider the *nunc pro tunc* assignment. The Examining Attorney accepted the assignment as proof of Momentum's proper status as of the filing date and

[5] Although the application was filed in the name of Momentum Development LLC, the assignment listed the company as Momentum Developments LLC (adding an "s" to Development). This addition was later clarified as being in error. The proper name of the company is Momentum Development LLC. *See* Request for Reconsideration October 4, 2013.

[6] This document was subsequently revealed to be the same Assignment dated March 30, 2010, from Russell Pine that Applicant relies upon as providing Pine's written consent to registration of the subject application.

accordingly returned the case to the Board for consideration of the Section 2(c) refusal. On July 5, 2017, the Board resumed proceedings.

In addition to the *nunc pro tunc* assignment, which has not been recorded, two assignments have been made and recorded against the subject application. On August 14, 2013, Momentum Developments LLC re-assigned the application to Josef Dolezal.[7] On March 25, 2016, Josef Dolezal re-assigned the application to Momentum Development LLC.[8]

Section 2(c) Consent to Register

We now turn to the refusal under Section 2(c). Section 2(c) of the Trademark Act, 15 U.S.C. § 1052(c), prohibits the registration of any mark that "[c]onsists of or comprises a name … identifying a particular living individual except by his written consent." The Section 2(c) bar to registration pertains to marks containing not only full names, but also surnames, shortened names, nicknames, and pseudonyms, so long as the name in question does, in fact, "identify" a particular living individual. *In re Sauer*, 27 USPQ2d 1073, 1074 (TTAB 1993), *aff'd*, 26 F.3d 140 (Fed. Cir. 1994).

The rationale behind Section 2(c) is:

> to protect living individuals from the commercial exploitation of their names, except where those living individuals agree to such exploitation as evidenced by the written consent by the individual to the applicant's use and registration of his name as a mark.

[7] Recorded at Reel/Frame 5091/0206. Because the wrong application Serial No. was entered on the assignment cover sheet, Applicant refiled the assignment on September 23, 2013, this time with the correct mark listed on the cover sheet. The second filing is recorded at Reel/Frame 5116/0270.

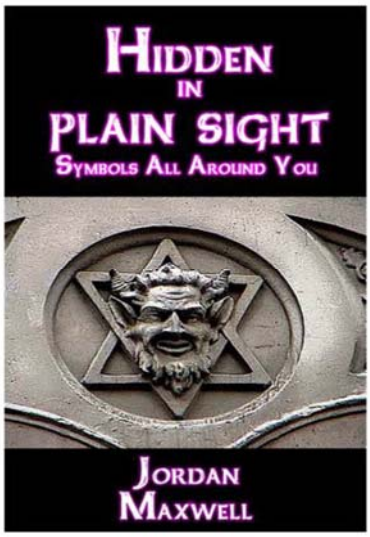
[8] Recorded at Reel/Frame 5758/0360. Applicant is encouraged to record the *nunc pro tunc* assignment.

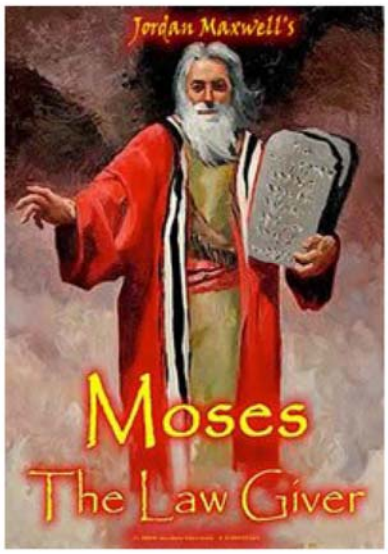
Nike, Inc. v. Palm Beach Crossfit Inc., 116 USPQ2d 1025 (TTAB 2015) (citing *Ceccato v. Manifattura Lane Gaetano Marzotto & Figli S.p.A.*, 32 USPQ2d 1192, 1194 (TTAB 1994)).

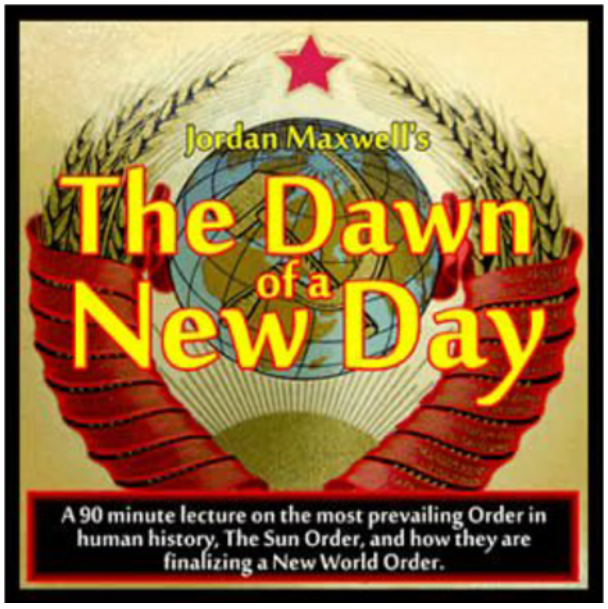
Whether consent to registration is required depends on whether the public would recognize and understand the mark as identifying a particular living individual. "A consent is required only if the individual bearing the name in the mark will be associated with the mark as used on the goods or services, either because: (1) the person is so well known that the public would reasonably assume a connection between the person and the goods or services; or (2) the individual is publicly connected with the business in which the mark is used." *In re Nieves & Nieves LLC*, 113 USPQ2d 1639 (TTAB 2015) (citing *In re Hoefflin*, 97 USPQ2d 1174, 1176 (TTAB 2010)); *see also Martin v. Carter Hawley Hale Stores, Inc.*, 206 USPQ 931, 933 (TTAB 1979); *Krause v. Krause Publ'ns Inc.*, 76 USPQ2d 1904, 1909-10 (TTAB 2005).

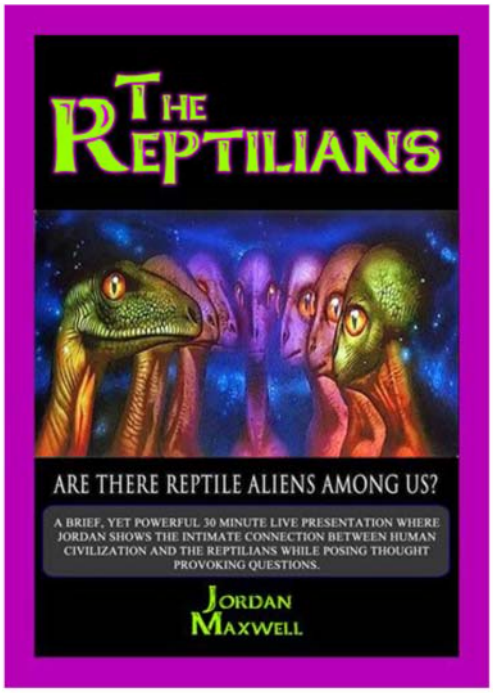
In the present case, the record fails to show that opposer is so well-known by the public in general that the mark JORDON MAXWELL would automatically lead to an assumption on the part of the public that the mark referred to Russell Joseph Pine, aka Jordon Maxwell. However, Applicant has shown that within the field in which Jordan Maxwell's name is used on digital media, there is a public association of the goods with the persona. Applicant submitted copies of seventeen DVD presentation covers that identify JORDAN MAXWELL either as author or as a speaker, such as:[9]

[9] August 14, 2013 Response to Office Action, TSDR 5, 11, 12, 13, 15.


HIDDEN
IN
PLAIN SIGHT
SYMBOLS ALL AROUND YOU
JORDAN
MAXWELL


Jordan Maxwell's
Moses
The Law Giver


Jordan Maxwell's
The Dawn
of a
New Day
A 90 minute lecture on the most prevailing Order in human history, The Sun Order, and how they are finalizing a New World Order.



Based on the evidence of record, we find that the pseudonym JORDAN MAXWELL is publicly connected with the business or field of digital media featuring Russell Joseph Pine (aka Jordan Maxwell) such that a connection between the individual known as JORDAN MAXWELL and the goods would be assumed. This is reinforced by the fact that the identification of goods of the application refers directly to Jordan Maxwell's connection with the cassettes, discs, recordings and DVDs listed therein.

We next consider the second prong of the test under Section 2(c), that is, whether Russell Joseph Pine has given his written consent to Momentum Development LLC to register his pseudonym JORDAN MAXWELL.

It is undisputed that Trademark Act Section 2(c) requires that a consent to register one's "name, portrait, or signature" must be in writing and be signed by the

individual whose consent is alleged. The only written document bearing a signature of Russell Joseph Pine is the "Assignment of Intellectual Property" signed March 30, 2010, by "Russell Pine aka Jordan Maxwell" before a Notary Public in California (the "2010 Assignment"). The 2010 Assignment, in pertinent part, contains the following preamble and provisions:

Assignment of Intellectual Property

This assignment of Intellectual Property dated as of March 30th, 2010 is made by Jordan Maxwell [also known as Russell Pine], [Seller], to, Josef Dolezal, [Buyer].

> **…**
>
> **3. Assignment of Rights**
> For valuable consideration (as set forth above), Seller assigns to Buyer all the Seller's right, title, and interest in any and all Intellectual Property including but not limited to copyrights, patents, trademarks, service marks, trade secrets, domain names, [www.jordanmaxwell.com, www.jordanmaxwell.org, www.jordanmaxwell.net, www.jordanmaxwell.info], and other related proprietary rights (the Intellectual Property) now owned or hereafter claimed by Seller.
>
> **4. Scope of Transferred Rights**
> This transfer of rights includes, but is not limited to, all registered, unregistered, or pending registrations, derivatives of the Intellectual Property, terms extensions, renewals, or foreign rights associated with the Intellectual Property. For any trademark or service mark rights that are being assigned, Seller also transfers to Buyer any goodwill associated with such marks.

> **5. Additional Documents**
> Seller has made a good faith effort to list in Attachment l the Intellectual Property being transferred. To the extent that Seller has failed to list such Intellectual Property, Seller will cooperate with Buyer to sign further papers to accomplish the transfer of rights. Seller will also cooperate with Buyer in the processing of any Intellectual Property applications, registrations, or prosecutions and will sign any further papers required to evidence this assignment.
>
> ….

The Assignment document refers to an "Attachment 1" that is incorporated as part of the complete document. Two provisions of Attachment 1 refer to trademarks. They are marked "A]" and "B]":

> A] Grant of Exclusive Ownership and Use Rights.
> *The Jordan Maxwell [seller] sells, grants, conveys and assigns to Josef Do[le]zal [buyer], exclusively for and throughout the world, in and for all languages, all Intellectual Property [including but not limited to all copyrights, trademark whether pending or otherwise in any computer and human languages whether now existing or subsequently developed]. All Seller rights, titles and interests including but not limited to all rights of the Seller under the laws of the United States or any state, or "Governmental Authority" [as defined in Section A.1 below]. The foregoing assignment of rights by the Seller to the Buyer is all inclusive and without reservation by Seller of any right, title, Interest or use, whether now existing or subsequently arising.*
>
> B] Grant of Exclusive Rights to Trademarks .
> *The Jordan Maxwell [seller] sells, grants, conveys and assigns to the Josef Dolezal [buyer], exclusively for and throughout the world, in and for all languages [including but not limited to computer and human languages whether now existing or subsequently developed] all Seller rights, titles and interests in and to any and all : Trademarks whether registered or not and the right to obtain registered trademarks in United States Patent and Trademark Office*

> *or in any other "Governmental Authority Office" throughout the world.*

The Examining Attorney contends that the 2010 Assignment cannot be read as providing Russell Pine's written consent because there is no explicit language of permission, such as "I consent to the registration of my name." Applicant agrees with this contention but argues Russell Pine's consent may be *implied* from the terms of the assignment since the assignment granted all rights in the mark JORDAN MAXWELL to Applicant. The Examining Attorney rebuts this contention by noting that the assignment document does not explicitly refer to JORDAN MAXWELL as a trademark or service mark, nor does it provide for Russel Pine to relinquish all rights to the mark and for the mark to be Applicant's property. He argues that "[g]iven the clear language of Section 2(c) requiring written consent to register, the Office cannot infer consent but instead must require evidence of explicit authorization by the individual named in the mark allowing the applicant to register the mark."[10]

In order for a written document that is not an explicit consent to satisfy the requirements of Section 2(c), there must be a relinquishment on the part of the individual granting consent, of the right to commercially exploit his or her name as a trademark or service mark, as well as an affirmance of property rights in favor of the party claiming to have received the consent. *In re D.B. Kaplan Delicatessen*, 225 USPQ 342 (TTAB 1985) (consent implied on basis of buy-out agreement between shareholders).

[10] Examining Attorney's brief, 9 TTABVUE 12.

In *Kaplan Delicatessen*, the two original shareholders of the corporation entered into a "buy-out" agreement whereby the one for whom the corporation was named, Donald Kaplan, relinquished his rights in the service mark D.B. KAPLAN'S DELICATESSEN to the corporation, which had applied to register the mark for restaurant services. The Board found that Donald Kaplan's consent to registration was implied in the terms of the buy-out agreement. Specifically, under the agreement, Donald Kaplan relinquished any and all rights to use the mark in a subsequent business venture and agreed that the mark belonged to the applicant corporation as its property. The Board explained:

> In the present case, Donald Kaplan has indicated in writing that the trade name and service mark "D. B. Kaplan Delicatessen" and any name or mark confusingly similar thereto is the property of D. B. Delicatessen, Inc., the applicant herein, and that Donald Kaplan cannot use it in any subsequent business. We disagree with the Examining Attorney that the foregoing agreement is simply a consent to use and does not constitute a consent to register. Kaplan clearly has relinquished to applicant corporation all rights in the mark "D. B. Kaplan Delicatessen" which comprises his name and has agreed that he cannot use it in any subsequent business. We think that these provisions are beyond a mere "consent to use" situation and that a reasonable reading of this provision clearly implies that consent to applicant's registration of the mark was contemplated.

We also find that the terms of the 2010 Assignment between Russell Pine and Josef Dolezal are beyond a mere "consent to use" situation. In paragraph "B]," Russell Pine assigns to Josef Dolezal "all Seller rights, titles and interests in and to any and all : Trademarks whether registered or not and the right to obtain registered trademarks in United States Patent and Trademark Office…." In paragraph "A],"

Russell Pine agrees that this assignment is "all inclusive and without reservation by Seller of any right, title, Interest or use, whether now existing or subsequently arising." By these terms, Russell Pine has expressly acknowledged that his marks, including the mark JORDAN MAXWELL, is the property of Josef Dolezal and that no rights have been reserved by Mr. Pine. Despite the fact that the mark JORDAN MAXWELL is not specifically identified in the agreement, we find that it is the intended property subject to the assignment. The only intellectual property mentioned in the agreement are the "jordanmaxwell" domain names,[11] each of which is essentially the name JORDAN MAXWELL plus "www" and the top level domain name indicator. Moreover, the fact that Russell Pine asserts that he "has made a good faith effort to list in Attachment 1 the Intellectual property being transferred," but no additional property has been listed, supports that JORDAN MAXWELL is one of, if not the only, trademark assigned under the agreement. Finally, Applicant contends that Josef Dolezal has been using the pseudonym JORDAN MAXWELL since March 30, 2010 on a series of DVDs bearing the name (see above representative covers, which Applicant contends were produced by Josef Dolezal "and sold exclusively through www.JORDANMAXWELL.com"[12]).

To read the assignment as failing to evidence consent would essentially eviscerate the purpose of the 2010 Assignment, and have a deleterious impact on policy involving assignment of trademarks as intellectual property. The effect would be to

[11] The domain names are: "www.jordanmaxwell.com," "www.jordanmaxwell.org," "ww[sic].jordanmaxwell.net," and "www.jordanmaxwell.info."

[12] August 14, 2013 Response to Office Action, TSDR 1.

render the assignment to Josef Dolezal essentially worthless, because he (and Momentum Development LLC as his assignee) would be unable to register the trademark that had been assigned to him as his property and where he was given the express right to register the trademark ("right to obtain registered trademarks").

Although the record shows that Applicant and Mr. Pine have been involved in a lawsuit in California,[13] the legitimacy of the assignment is not in dispute in this *ex parte* proceeding, nor is there any evidence of record to contravene the intent to consent to registration or render the assignment ambiguous or indefinite.[14]

Accordingly, we conclude that this record supports a finding that Russell Joseph Pine, aka Jordan Maxwell, has given his written consent to Applicant's use and registration of JORDAN MAXWELL, and that on the basis of the record before us, the refusal of registration is not well taken.

Decision: The refusal to register is reversed.

[13] May 16, 2014 Request for Reconsideration, TSDR 5.
[14] We note that on a different record developed in an *inter partes* proceeding, a different result could be reached.