

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

JOE J. ALFARO, JR.)
)
)

Opposer,)
)
)
)
)

GUY A. HOFFMANN,)
)
)
)
)
)
)
)

Applicant,)
)
)
)
)
)
)
)

Opposition No.: 91155188

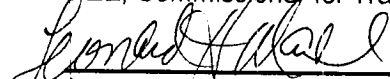
IN RE:
Serial No.: 78110344

Mark: SUPERFREAKS FUNKY
DISCO REVUE

APPLICANT'S MAIN BRIEF

CERTIFICATION UNDER 37 CFR § 1.8

I hereby certify that the document referred to as enclosed herein is being deposited with the United States Postal Service as first-class mail on this date, January 11, 2006, in an envelope addressed to: Box TTAB, NO FEE, Commissioner for Trademarks, 2900 Crystal Drive, Arlington, VA 22202-3513.



Leonard H. Mandel



01-19-2006

U.S. Patent & TMO/c/TM Mail Rcpt Dt. #72

TABLE OF CONTENTS

	Page
I. INTRODUCTION.....	1
II. DESCRIPTION OF THE RECORD.....	2
III. STATEMENT OF ISSUES.....	2
IV. STATEMENT OF FACTS.....	3
V. ARGUMENT.....	4
1. "UNCLEAN HANDS" is a Recognized Equitable Doctrine In Trademark Law..	4
2. Under California Law, Opposer's Registration of the Service Mark "THE SUPERFREAKS" Pursuant to Business and Professions Code 14240, 14241 and 14242 gave him additional protection under State Law for the service mark SUPERFREAKS causing injury to the Applicant.....	8
3. Relationship Between Federal Law and State Trademark Law – State Law Cannot Limit Federal Rights.....	9
4. CONCLUSION.....	10
CERTIFICATE OF SERVICE.....	11

TABLE OF AUTHORITIES

Page(s)

Federal Cases

<u>Davidoff Extension S.A. v. Davidoff Comercio E.</u> 17 USPQ2d 1514 (D.P.R. 1990).....	9
<u>Dollar Systems. V. Avcar Leasing Systems</u> 890 F2d165 (9 th Cir. 1989).....	6
<u>Ellen Burg v. Brockway, Inc.</u> 763 F2d 1091 (9 th Cir. 1985).....	6
<u>Fuddrucker's Inc. v. Doc's B. R. Others Inc.</u> 826 F2d 837 [40 USPQ2d. 1026 (9 th Cir. 1987).....	6
<u>Gaudiosi v. Mellon</u> 269 F2d 873 (3 rd Cir. 1959).....	7
<u>Keystone Driller Co. v. General Excavator Co.</u> 290 US 240 (1933).....	7
<u>Lawler v. Gilliam</u> 569 F2d 1263 (4 th Cir. 1978).....	8
<u>Monsanto Company v. Rohm & Haas Company</u> 456 F2d 592 (3 rd Cir. 1972).....	7
<u>Morton Salt Co. v. G.S. Suppiger Co.</u> 314 US 488 (1942).....	5
<u>Precision Instrument Manufacturing Co.. et al v. Automotive Maintenance Machinery Co.</u> 324 US 806 (1945).....	4
<u>Sears Roebuck & Co. v. Sears PLC</u> 744 F.. Supp. 1297 (D. Del. 1990).....	6
<u>Shaver v. Heller & Merz Co.</u> 108 F. 821 (8 th Cir. 1901).....	4
<u>Sparton Food Systems Inc. v. HFS Corp.</u> 2 USPQ2d 1063 (1987).....	9

Upjohn Co. v. Universal Wholesale Corp.
161 USPQ 558 (T.T.A.B. 1969).....9

Wells Fargo & Co. V. Stagecoach Properties, Inc.
685 F2d 302 (9th Cir. 1982).....7

Statues

California Business and Professions Code 14240 – 14242.....8

Lanham Act.....9

Other

McCarthy Trademarks and Unfair Competition Fourth Edition (2002).....9

Pomeroy, A Treatise on Equity Jurisprudence.....8

Story's Equity Jurisprudence (14th Ed.).....7

Witkin, Summary of California Law, 10th Edition (2005).....8

I. INTRODUCTION

Applicant, Guy a.. Hoffmann, submits this brief in support of his application seeking to register the name SUPERFREAKS mark his own name. On February 22, 2002,, Mr. Hoffmann filed an application with this Board. On September 7, 2002 Opposer, Joe J. Alfaro, Jr. with actual knowledge that Applicant, Guy A. Hoffmann had filed this application, willfully, wrongfully, fraudulently unlawfully and with "unclean hands" obtained a Certificate of Registration from the Secretary of State of the State of California pursuant to California Business and Professions Code Section 14240, 14241 and 14242 for a service mark, the SUPERFREAKS. After obtaining said certificate from the Secretary of State of the State of California, Opposer, after the proposed Registration of Applicant was published in December 17, 2002, opposed Applicant's registration.

The answer of Applicant, Guy A. Hoffmann to the Amended Notice of Opposition of September 21, 2004, filed with this Board plead as an affirmative. defense "Unclean Hands" in Opposer, Joe J. Alfaro's, Jr. obtaining said SUPERFREAKS when this proceeding before the Board was then pending. Thus, the "Unclean Hands" Doctrine is clearly at issue.

Opposer's conduct in attempting to seek an unfair advantage against Applicant Vis a Vis the use of the name SUPERFREAKS by attempting to gain rights under California State Law and in disrespect and contempt to this Board is deceitful, dishonest, wrongful and indicates Opposer, Joe J. Alfaro, Jr. appear before this Board with "Unclean Hands" in opposing applicant's request to register SUPERFREAKS mark in his own name.

Opposer's opposition to Applicant's proposed registration should be denied because of his "Unclean Hands" and this Board should register the SUPERFREAKS mark in the name of Applicant, Guy a. Hoffman.

II. DESCRIPTION OF THE RECORD

The record of this proceeding consists of the file for the opposed application, Serial No. 78110344 and the pleadings of both parties.

Applicant agrees with Opposer's characterization of the evidence submitted by Opposer with one notable exception, Exhibit 11 of Opposer, Joe J. Alfaro's testimony on February 24, 2005, the purported e-mail from Applicant. A careful reading of the transcript indicates objection to the receipt of exhibit 11 were duly made on grounds that no foundation was laid to show the e-mail came from Applicant the witness Opposer, Joe J. Alfaro, Jr. did not have personal knowledge of said e-mail, that Opposer, Joe J. Alfaro's testimony was based on hearsay. (J. Alfaro, Tr. at 18:17-25, 29: 1-25, 30: 1-25).

Opposer, Joe J. Alfaro, Jr. did not have David Wayne Hickory who purportedly had personal knowledge of the e-mail, exhibit 11 testify at a deposition. Accordingly, the testimony regarding exhibit 11 is not properly in evidence and must be disregarded and the arguments made by Opposer with regard to exhibit 11 like wise disregarded. See Opposer's main brief, page 11, paragraph 3 alleging Applicant's sole motive for filing his registration application was to harass and vex the opposer.

III. STATEMENT OF ISSUES

Whether the "Unclean Hands" doctrine nullifies the opposition of Joe J. Alfaro, Jr. to the registration of Applicant, Guy A. Hoffmann of the Service Mark, SUPERFREAKS before this Board where Opposer on September 7, 2002, with actual knowledge of the

pending application by Applicant, Guy A. Hoffmann filed a registration of a service mark "THE SUPERFREAKS" with the Secretary of State, State of California pursuant to California Business and Professions Code 14240 – 14242 declaring "to his/her best knowledge and belief no other person, firm, corporation, union or association has the right to use said Mark in this state, either in identical form or in such near resemblance thereto as might be calculated to deceive or confuse".

IV. STATEMENT OF FACTS

In as much as Applicant did not submit any testimony through depositions and Opposer, Joe Alfaro, Jr. took depositions of himself, Elva Handler, Eric Handler and Danny Alfaro, Applicant does not challenge Opposer's Statement of Facts except with the following items and conclusions drawn thereto:

On page 7 of Opposer's brief, Opposer alleges that Applicant sent an e-mail to a Mr. Hickum, exhibit 11. For reasons previously stated, this evidence was clearly hearsay, properly objected to at the deposition of Opposer and should be disregarded by the Board. The argument of Opposer that (1) applicant did not consider the SUPERFREAKS band (or name) to be his, and (2) he did not actually intend to use the SUPERFREAKS name in the future should likewise be disregarded.

At the deposition of Opposer, Joe J. Alfaro, Jr., Mr. Alfaro testified that:

- (1) He claimed to have the right to the name of SUPERFREAKS since October 15, 1999 (J. Alfaro, Tr. at 55:25-56:1-2).
- (2) He had his sister Elva Handler speak to an attorney, Christopher J. Connolly on September 12, 2002, who sent a "Cease and Desist" letter to Applicant demanding that Applicant cease and desist the use of "THE SUPERFREAKS" and threatening Applicant with perjury for filing the application with this Board, (See Exhibit #6 of Elva Handler's deposition. (J. Alfaro, Tr. at 57:12-27, 58:3-6.)

- (3) He knew of the time Attorney Connolly was contacted by his sister, Elva Handler that Applicant, Guy A. Hoffmann had filed his application before this Board. (J. Alfaro, Tr. at 58:3-6.)
- (4) He filed on September 7, 2002, a registration of a service mark, THE SUPERFREAKS with the Secretary of State, State of California actually knowing that pending before this board was an application for the mark SUPERFREAKS by Guy A. Hoffmann (J. Alfaro, Tr. at 58:12-19.)
- (5) He admitted that in his application to the Secretary of State, he declared "that he has read the above and foregoing application and knows the contents thereof and that the facts are true and correct, and that the three specimens of the mark submitted are true and correct. And to his best knowledge and belief, no other person, firm, corporation, union, or association has a right to cease said mark in this state, either in identical form or in such near resemblance thereof as might be calculated to deceive or confuse. (J. Alfaro, Tr. p.37:14-37), where Exhibit #5, the registration of THE SUPERFREAKS to the Secretary of State, State of California was received in evidence by stipulation of the parties.
- (6) He offered no explanation for waiting approximately three years from October 15, 1999, before filing a request for a Service Mark for the SUPERFREAKS from the Secretary of State, State of California, after Guy A. Hoffmann filed his application before this Board other than he had no idea about trademarks and service marks and was completely ignorant in this area. (J. Alfaro, Jr. at 59:25, 60:1-13.)

V. ARGUMENT

1. "Unclean Hands" Is A Recognized Equitable Doctrine In Trademark Law.

The principle that "he who comes into equity must do so with "Clean Hands" does not repel all sinners from courts of equity...the iniquity which will repel him must have an immediate and necessity relation to the equity for which he sues. Shaver v Heller & Merz Co., 108 F. 821, 834 (8th cir. 1901).

In Precision Instrument Manufacturing Co. et al v. Automotive Maintenance Machinery Co. 324 U.S. 806 (1945), a patent infringement and breach of contract suit,

Justice Murphy discussed "Clean Hands" and found plaintiff's conduct to be "Unclean Hands" justifying dismissal.

Justice Murphy stated:

The Guiding Doctrine in this case is the equitable maxim that "He who comes into equity must come with clean hands". This maxim is far more than a mere banality. It is a self-imposed ordinance that closes the doors of a court of equity to one tainted with inequitableness or bad faith relative to the matter in which he seeks relief, however, improper may have been the behavior of the defendant. That Doctrine is rooted in the historical concept of Court of Equity as a vehicle for affirmatively enforcing the requirements of conscience and good faith. This presumption poses a refusal on its part to be "The Abettor of Iniquity" ... Thus while "Equity Does Not Demand that its Suitors Shall Have Led Blameless Lives," as to other matters, it does require that they shall have acted fairly and without fraud or deceit as to the controversy in issue... 324 U.S. 814-815.

This maxim necessarily gives wide range to the Equity Court's use of discretion in refusing to aid the unclean litigant. It is "Not bound by formula or restrained by any limitation that tends to trammel the free and just exercise or discretion. Accordingly, one's misconduct need not necessarily have been of such a nature as to be punishable as a crime or as to justify legal proceedings of any character. Any willful act concerning the cause of action which rightfully can be said to transgress equitable standards of conduct is sufficient cause for the invocation of the maxim by the Chancellor. 324 U.S. 815. See Morton Salt Co. v. G. S. Suppiger Co. 314 U.S. 488 (1942) finding "Unclean Hands" in a patent infringement action. When presented with a claim of "Unclean Hands", the court is

primarily concerned with protecting its own integrity, and in not abetting the inequitable conduct of a plaintiff with respect to the matter in litigation.

Sears Roebuck & Co. v. Sears plc 744 F Supp. 1297, 1309 (D.Del. 1990) (a trademark and trade name infringement suit.)

To prevail on an "Unclean Hands" defense, the defendant must demonstrate that the plaintiff's conduct is inequitable and that the conduct relates to the subject matter of its claims. Equity requires that those seeking its protection shall have acted fairly and in without fraud or deceit as to the controversy in issue. Fuddrucker's Inc. v. Doc's B. R. Others Inc., 826 F2d 837 [4 USPQ2d 1026].(9th Cir.1987).

In applying the doctrine of unclean hands, what is material is not that the plaintiff's hands are dirty, but that he dirtied them in acquiring the right he now asserts, or that the manner of dirtying renders inequitable the assertion of the such rights against the defendants. Equity requires that those seeking its protection shall have acted fairly and without fraud or deceit as to the controversy in issue. Ellenburg v. Brockway, Inc. 763 F2d 1091 (9th Cir. 1985).

The application of the unclean hands doctrine raises primarily a question of fact. It is fundamental to the operation at the doctrine that the alleged misconduct by the plaintiff relate directly to the transaction concerning which the complaint is made. Dollar Systems v. Avcar Leasing Systems 890 F2d. 165 (9th Cir. 1989).

Courts of Equity do not make the quality of Suitors the test. They apply the maxim requiring clean hands only where some unconscionable act of one coming for relief has immediate and necessary relation to the equity that he seeks in respect of the matter in litigation. They do not close their doors because of plaintiff's misconduct whatever its

character, that has no relation to anything involved in the suit, but only for such violations of conscience as in some measure affect the equitable relations between the parties in respect of something brought before the court for adjudication. Keystone Driller Co. v. General Excavator Co. 290 U.S. 240 (1933) (Patent infringements suits where the U.S. Supreme Court found "Unclean Hands" on part of the Plaintiff.)

Bad intent is the essence of the defense of "Unclean Hands." Wells Fargo & Co. v. Stagecoach Properties, Inc. 685 F2d 302 (9th Cir. 1982) (an appeal from the Trademark Trial and Appeal Board by an unsuccessful applicant for registration of a symbol.)

Courts are concerned primarily with their own integrity in the application of the clean hands maxim and even though not raised by the parties the court will of its own motion apply it. The clean hands maxim gives wide sweep to the equity court's exercise of discretion. Gaudiosi v. Mellon, 269 F2d 873 (3rd Cir. 1959.)

Patent infringement suit resulted in declaration of patent invalidity where unclean hands doctrine applied to misrepresentation in connection with application for the patent. Monsanto Company v. Rohm & Haas Co., 456 F2d 592 (3rd Cir. 1972) citing Story's Equity Jurisprudence (14th Ed.) vol 1, §99 in footnote 11.

"Misconduct which will bar relief in a court of equity need not necessarily be of such a nature as to be punishable as a crime or to constitute the basis of a legal action. Under this maxim, any willful act in regard to the matter to the matter in litigation, which could be condemned and pronounced wrongful by honest and fair-minded men, will be sufficient to make the hands of the applicant unclean."

The defense of unclean hands requires the defendant to show that he himself has been injured by the plaintiff's conduct. Lawler v. Gilliam 569 F2d 1263 (4th Cir. 1978) citing J. Pomery, a Treatise on Equity Jurisprudence as 399 in footnote 7

Exactly what is the "Unclean Hands" of Opposer claimed by Applicant? The Fraudulent, Deceitful Act By Opposer To Attempt To Gain An Unfair Advantage of filing a registration of the Service Mark, THE SUPERFREAKS with the Secretary of State of California while this action involving the same service mark was pending before this Board which Opposer actually knew of. This unethical and dishonest act by Opposer injured the Applicant and showed contempt and disrespect to this Board.

2. Under California Law, Opposer's Registration of the Service Mark "THE SUPERFREAKS" pursuant to Business and Professions Code 14240, 14241 and 14242 gave him additional protections under state law for the Service Mark SUPERFREAKS causing injury to the applicant.

Witkin, Summary of California Law, 10th Edition (2005) in Personal Property states:

A Service Mark may be registered in the same manner as a trademark. (§81 p102).

Trademarks are protected in several ways:

- (1) The registration procedure to evidence the mark (prima face evidence of ownership of the mark (§85 p107).
- (2) An action for damages for infringement (B.&P.C. 14340(a)).
- (3) An injunction against infringement (§82 p102-103).

Thus Opposer's action diminished Applicant's rights in the State of California with regard to the Service Mark SUPERFREAKS since Opposer could utilize these protections against Applicant.

3. **Relationship Between Federal Law and State Trademark Law – State Law**
Cannot Limit Federal Rights

Professor McCarthy, Trademarks and Unfair Competition, Fourth Edition (2002)

States:

State Trademark Law and Registrations cannot override rights provided by Federal Law for Federal Registrations. That is, when state rules conflict with federal law, the Federal Trademark preempts state rules. Page 22-6.

The Lanham Act effects a limited preemption of state law, resolving the conflict in favor of the Federal Registrant's Rights. Page 22-7

The Lanham Act does not preempt all state law pertaining to trademarks. Spartan Food Systems Inc. v. HFS Corp. 2 USPQ2d 1063 (1987).

State registration without more is incompetent in opposition proceeding to establish actual use of a mark. Upjohn Co. v. Universal Wholesale Corp. 161 USPQ 558 (T.T.A.B. 1969)

The policy to provide protection of federally registered marks used in Interstate Commerce, may not be defeated or obstructed by state law and if state law conflicts with the policy it 'Must Yield to the Superior Federal Law' Davidoff Extension S.A. v. Davidoff Comercio E. Industrial 17 USPQ2d 1514 (D.P.R. 1990).

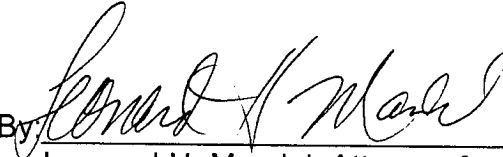
Regardless of the preemption by the Lantham Act of State Law, Opposer's conduct was an attempt obtain an unfair advantage against the Applicant while this proceeding was pending.

VI. CONCLUSION

The "Unclean Hands" doctrine has been clearly shown here. Opposer offered little or no justification for his ethically questionable conduct herein at his sworn deposition. He attempted to gain an unfair advantage against Applicant with regard to the Service Mark SUPERFREAKS. Rather than merely filing an opposition to the registration before this board, Opposer acted in a deceitful, dishonest and fraudulent manner. This board must protect its own integrity as well as protecting the Applicant from Opposer's misconduct. Opposer's opposition should be dismissed and Applicant be permitted to register SUPERFREAKS Mark in his own name.

Opposer's request that this Board sanction Applicant is ludicrous indeed. Opposer's conduct of "Unclean Hands" is an act of dishonesty. If sanctions are appropriate, Opposer is the one to be sanctioned.

Respectfully submitted:

By: 

Leonard H. Mandel, Attorney for Applicant
3034 N. 151st Lane
Goodyear, Arizona 85338
Telephone: (623) 935-3519

Dated: January , 2006

CERTIFICATION OF SERVICE

I hereby certify that, on January // , 2006, a true and correct copy of the foregoing APPLICANT'S MAIN BRIEF was served on Opposer's counsel, via First Class Mail, postage prepaid, at the following address:

Richard A. Clegg, Esq.
Seltzer Caplan McMahon Vitek
A Law Corporation
750 B. Street, Suite 2100
San Diego, California 92101



Leonard H. Mandel