

THIS OPINION IS NOT A
PRECEDENT OF THE TTAB

Mailed:
November 4, 2013

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Cheryl Cooley

v.

Bernadette Cooper and Joyce Irby

Opposition No. 91189474
to Application Serial No. 77571759

Jack F. Scherer for Cheryl Cooley

Bernadette Cooper and Joyce Irby, *pro se*

Before Bucher, Greenbaum and Adlin, Administrative Trademark Judges.

Opinion by Adlin, Administrative Trademark Judge:

Joint applicants Bernadette Cooper and Joyce Irby (“applicants”) seek registration of the mark KLYMAXX, in standard characters, for “Entertainment, namely, live performances by a musical band.”¹ In her notice of opposition, Cheryl Cooley (“opposer”) alleges that she “is, and for many years has been, performing as Klymaxx, a live musical band.” Notice of Opposition (“NOO”) ¶ 1. More specifically,

¹ Application Serial No. 77571759, filed September 17, 2008 based on alleged first use dates of September 30, 2003.

opposer alleges that in 1981 the band Klymaxx, then consisting of opposer and six other individuals, including applicant Cooper, executed a recording agreement with Solar Records, Inc., and in 1985 the band, then consisting of opposer, both applicants and three other individuals, executed another recording agreement with Solar Records. *Id.* ¶¶ 2, 3. Then, in 1988, “both Applicants abandoned Klymaxx to pursue solo musical careers,” while the band Klymaxx, in a slightly different configuration, continued, and in 1990 recorded an album. *Id.* ¶¶ 5-7. At some point after 1990, “[f]or approximately 10 years, Klymaxx ceased performing.” *Id.* ¶ 8. In 2002, however, opposer “auditioned musicians” and “started rehearsing,” and “Opposer [again] performed as Klymaxx on May 17, 2003.” Since that time, opposer has performed under the name Klymaxx in at least two forms, including “Klymaxx featuring original guitarist Cheryl Cooley.” *Id.* ¶¶ 9-11. In the meantime, applicants’ “first performance as Klymaxx” since they left the band in 1988 “was on or after November 21, 2003.” *Id.* ¶ 12. As grounds for opposition, opposer alleges that “[a]pplicants are not now the owner of the alleged trademark sought to be registered,” and that use of applicants’ mark would be likely to cause confusion with opposer’s mark. *Id.* ¶ 15. Opposer further alleges that while they are not named plaintiffs, current or former Klymaxx members Lorena Stewart, Lynn Malsby and Robin Grider “join with Opposer in the within opposition.” *Id.*

In their answer, applicants deny the salient allegations in the notice of opposition and assert several affirmative defenses. However, applicants did not pursue or prove any of their defenses, which have accordingly been waived and will

be given no further consideration. *Miller v. Miller*, 105 USPQ2d 1615, 1616 n.3 (TTAB 2013); *Baroness Small Estates Inc. v. American Wine Trade Inc.*, 104 USPQ2d 1224, 1225 n.2 (TTAB 2012).

On June 20, 2013, ten days after opposer filed her rebuttal brief, applicant Cooper filed a motion to amend the involved application to name Cooper “as the sole applicant upon the absence and non-response of [joint applicant] Joyce Irby,”² to which opposer, but not applicant Irby, consented. On July 3, 2013, the Board issued an order deferring consideration of the motion until final decision, because neither an assignment of the application nor applicant Irby’s consent to the amendment are of record. On August 1, 2013, applicant Cooper filed a letter with the Board indicating that applicant Irby “has been non-responsive” and that as a result Cooper has been unable to settle this opposition. In the letter, Cooper states that she “would like to proceed with the Opposition and come to a settlement or be the sole applicant and let the Board decide.”

The Record

The record consists of the pleadings, the file of the involved application and opposer’s testimonial deposition of Ms. Cooley (“Cooley Tr.,” TTABVue Docket No. 19) and the exhibits thereto.

² On June 21, 2013, Cooper supplemented the motion, stating that “[a]pplicant asserts and parties consent that all papers served by Plaintiff in opposition and by Defendant party to the Application are deemed effective upon amendment of the Application.”

Applicants did not introduce any testimony or other evidence. Opposer and applicant Cooper filed briefs.³

Evidence and the Parties' Arguments

According to Ms. Cooley, her band Klymaxx's first performance after its hiatus was on May 17, 2003, under the name "Klymaxx featuring Cheryl Cooley," and the band has "continued to perform" under that name since that date. Cooley Tr. at 10. Prior to the band's May 17, 2003 performance, it received a cease and desist letter from applicant Irby. *Id.* at 10-11 and Ex. 8. According to the letter, "the name 'Klymaxx' is owned collectively by the original, individual members of that musical group, including" applicant Irby, and therefore opposer is "not the sole owner of the mark." *Id.* Ex. 8.

As for applicants' use of KLYMAXX, Ms. Cooley testified that in approximately 1987 applicant Cooper "no longer performed with the band, went on to do a solo career," and in approximately 1988 applicant Irby "was no longer performing with the band, had stopped performing with the band, going on –

³ Applicants were represented by counsel from the time they filed their answer through the close of trial. After trial, applicants' counsel filed a motion to withdraw, which the Board granted on January 8, 2013, prior to the due date for applicants' final brief. On February 6, 2013, applicant Irby indicated that she would represent herself in this proceeding, and on February 27, 2013, the Board reset the schedule for the parties' final briefs, sending a copy of its order to applicant Irby. On March 18, 2013, applicant Cooper indicated that she would also represent herself in this proceeding, and provided her (Cooper's) address of record, without serving applicant Irby, and it is unclear whether the Board thereafter sent its orders to both applicants or to Cooper only. In addition, applicant Irby may not have received applicant Cooper's final brief, motion to amend or other filings after March 18, 2013 (which were apparently not served on applicant Irby). However, given our disposition of the motion to amend, below, and because applicant Irby was aware of the briefing schedule but did not file a brief on her own behalf, her receipt or non-receipt of the post-March 18, 2013 filings and orders is not relevant.

traveling with the band, and had pursued her own solo career.” *Id.* at 9. Neither applicant gave Cooley any indication that she wished to return to the band. *Id.* at 10.

Although Ms. Cooley did not testify regarding her or applicants’ use of KLYMAXX prior to 2003, according to Ms. Cooley, “all the statements contained in” her notice of opposition, as well as in her responses to applicants’ interrogatories and requests for admission (copies of which are included as exhibits to Cooper’s testimonial deposition) are “true.” Cooley Tr. at 5, 7, 8 and Exs. 5, 6.⁴ While applicant’s interrogatories and requests for admission to which opposer responded are not of record, and opposer’s responses are therefore out of context, according to opposer’s response to applicant’s Request for Admission No. 1:

On or about January 1, 1981, the original members of KLYMAXX (“Original Members”) consisting of Cheryl Cooley, Bernadette Cooper, Denise Walk, Lorena Porter, Cheryl Ann McLennan, Lynn Malsby, and Myrtle Williams entered into an agreement with Solar Records, Inc. in which the Original Members warranted, represented and agreed that the Original Members had the sole and exclusive ownership of all right in and to the name KLYMAXX.

⁴ Generally, under Trademark Rule 2.120(j)(5), a party may not introduce or rely upon its own responses to an adversary’s written discovery requests. In this case, however, Ms. Cooley testified that opposer’s discovery responses are true, and applicants had the opportunity to cross-examine Ms. Cooley about the responses, which are attached as exhibits to Ms. Cooley’s deposition transcript. Moreover, under Trademark Rule 2.120(j)(6), nothing precludes the “reading or use” of interrogatory responses or admissions “as part of the examination or cross-examination of any witness during the testimony period of any party.”

Id. Ex. 5; *see also, id.* Ex. 6 (Opposer’s Response to Interrogatory No. 2).⁵ Furthermore, “[t]o the best of Opposer’s knowledge, no corporation, limited liability company or any other legal entity was formed pursuant to the laws of any jurisdiction, in which Opposer and Applicants had or have any joint ownership interest.” *Id.* Ex. 5 (Opposer’s Response to Request for Admission No. 3); *see also id.* Ex. 6 (Opposer’s Response to Interrogatory No. 2) (“[o]ther than the Solar Agreement, to the best of Opposer’s knowledge, there does not exist any written agreement between Opposer, on the one hand and Applicants, on the other; to the best of Opposer’s knowledge, Applicants and Opposer did not form any entity to be utilized for their mutual benefit”).

During Ms. Cooley’s deposition, opposer also introduced as an exhibit a copy of applicant’s responses to opposer’s interrogatories. *Id.* at 8-9 and Ex. 7. Therein, applicants claim that their first live performance “using Klymaxx” was on November 23, 2003. *Id.* (Applicants’ responses to Interrogatories Nos. 4 and 5).

In support of opposer’s claim that Klymaxx members Malsby, Grider and Stewart “join with Opposer” in this proceeding, opposer introduced a February 26, 2009 letter which Ms. Malsby addressed to the Office, with copies apparently sent to Grider and Stewart.⁶ The letter states that Stewart and Malsby “worked with, rehearsed with, traveled with and financially supported the endeavors of Klymaxx”

⁵ As is often the case with bands, Klymaxx’s composition and number of members changed over time.

⁶ Prior to its submission with the Cooley deposition transcript, the letter was not part of the file of either the involved application or this proceeding, and Ms. Cooley did not testify that Ms. Malsby actually sent the letter to the Office’s examining operation, the Board or anywhere else.

before applicants' claimed date of first use. *Id.* at 6 and Ex. 3. According to the letter, applicants "are free individuals and as they are no longer under contract with Klymaxx ... we question their proposed 'ownership' of this business name." *Id.* The letter argues that applicants "are free to either: Negotiate with the other members of Klymaxx to have all six (6) original members once again trademark the name or Tour as Ms. Cooper and/or Ms. Irby formerly of Klymaxx." *Id.* The letter concludes with a request that the Office refuse registration of applicants' involved mark "as it is an attempt to trade off the good name of Klymaxx, established by six (6) people, not the lone two applicants." Included with the letter are documents and other materials related to Klymaxx and its members, all from 2003-2004, including:⁷

- a November 13, 2003 invoice which the letter alleges is for "rentals of stage clothing" for the taping of the VH1 program "Bands Reunited," and an illegible car rental invoice which the letter alleges is dated November 16, 2003 and for "transportation in Atlanta for rehearsals";
- an advertisement from *LA Weekly* promoting a November 23, 2003 performance by "Klymaxx The Original Members," at The Roxy in West Hollywood;
- an "Agency Statement" dated May 21, 2004 which, according to the letter, relates to an "Atlanta GA Gig, 8/7/04";

⁷ The letter indicates that it includes a DVD of an episode of VH1's "Bands Reunited" program, presumably about Klymaxx, which aired in February 2004. However, there is no DVD in the record of this proceeding. In any event, given the state of the record in this proceeding, as discussed herein, it appears highly unlikely that the DVD would impact our ultimate decision.

- an Artist Engagement Contract for an August 8, 2004 performance at the Baton Rouge, LA River Center;
- what the letter refers to as a “Load In docket” for the Baton Rouge River Center performance as well as two additional performances in Shreveport, LA and Jackson, MS on August 5 and 6, 2004;
- an illegible document from TravelCenters of America which the letter alleges is a “gas receipt for tour bus – 8/9/04 – during return to Atlanta from Baton Rouge”;
- a flyer promoting an August 6 concert at the Mississippi Coliseum by a number of acts including “The All Female Group Klymaxx,” which includes a picture of the band comprised of six women, and which the letter alleges was for a performance in 2004 (the flyer does not include the year of the performance);
- a July 29, 2004 “Outgoing Wire Transfer Notice” from Washington Mutual Bank reflecting a payment from Ms. Malsby to applicant Irby, which the letter refers to as an “advance;” and
- a copy of Ms. Malsby’s boarding pass for an August 9 flight from Atlanta to Los Angeles, which the letter alleges is for a “return from Atlanta 8/9/04.”

*Id.*⁸

In her brief, opposer argues that her first use of KLYMAXX after the band’s hiatus was on May 17, 2003, which predates applicants’ first use of the mark on November 23, 2003. Opposer’s Brief at 2. Opposer also appears to argue, at least

⁸ While Ms. Malsby’s letter clearly states that she intended to “join with Opposer” in this proceeding, some of the materials submitted with the letter raise certain questions. For example, the *LA Weekly* advertisement is for a November 23, 2003 performance by “Klymaxx The Original Members” at The Roxy in West Hollywood. This is the same date on which applicants claim to have first used KLYMAXX after the band’s hiatus, and applicants claim to have used the mark at the “Roxy Theater, Hollywood California.” Did Cooper and/or Irby perform with opposer at the Roxy on that date? And why did Irby receive a wire transfer from Ms. Malsby the following year?

implicitly, that there is a likelihood of confusion between the parties' KLYMAXX marks. Furthermore, opposer argues that "[a]pplicants cannot establish sole ownership" of the mark in the involved application. *Id.* at 3-4.

Applicant Cooper filed applicants' brief on her own, given applicant Irby's purported nonresponsiveness, as explained in applicants' motion to amend the involved application. In the brief, applicant Cooper explains that she and opposer discussed and were amenable to a settlement agreement under which, *inter alia*, the involved application would be withdrawn, and applicants and opposer would agree that none of them could register KLYMAXX alone, but could register, as applicable, KLYMAXX FEATURING BERNADETTE COOPER, KLYMAXX FEATURING JOYCE IRBY or KLYMAXX FEATURING CHERYL COOLEY.⁹ Applicants' brief concludes as follows: "At the present time, applicant Bernadette Cooper, individually, agrees to the Stipulation of Settlement with Opposer, however, Co-Applicant Joyce Irby, individually, has refused the Stipulation of Settlement. Therefore, Applicants', (sic) collectively, can no longer represent their application for the Mark, KLYMAXX, under Serial Number 77/571,759."¹⁰

⁹ Applicant Cooper attached to her brief an unsigned document entitled "Stipulation of Settlement" which is untimely and has accordingly been given no consideration. Trademark Rule 2.123(l) ("Evidence not obtained and filed in compliance with [the Trademark Rules] will not be considered.").

¹⁰ It is unclear from the record whether applicant Irby in fact considered and then "refused" the Stipulation of Settlement, or whether she never considered it, because she became "nonresponsive" prior to applicant Cooper and opposer agreeing to the proposed settlement.

Opposer argues in her reply brief that applicants have “no objection” to withdrawal of the application, by virtue of applicant Cooper’s willingness to enter into the settlement agreement and applicant Irby’s “default.”

Standing

Opposer has established her use of the mark KLYMAXX for live musical performances. Cooley Tr. at 10. Applicant seeks registration of that mark for the same services. Accordingly, opposer has standing. *Automedx, Inc. v. Artivent Corp.*, 95 USPQ2d 1976, 1978 (TTAB 2010); *Giersch v. Scripps Networks, Inc.*, 90 USPQ2d 1020, 1022 (TTAB 2009) (“Petitioner has established his common-law rights in the mark DESIGNED2SELL, and has thereby established his standing to bring this proceeding.”); *Syngenta Crop Prot. Inc. v. Bio-Chek LLC*, 90 USPQ2d 1112, 1118 (TTAB 2009) (testimony that opposer uses its mark “is sufficient to support opposer’s allegations of a reasonable belief that it would be damaged ...” where opposer alleged likelihood of confusion).

Ownership

The record in this proceeding is replete with crucial evidentiary gaps, and, as a result, it is impossible to answer many of the questions commonly posed to determine which competing party is the owner of a disputed trademark. *See e.g., Rick v. Buchansky*, 609 F.Supp. 1522, 226 USPQ 449 (S.D.N.Y.), *appeal dismissed*, 770 F.2d 157 (2d Cir. 1985) (assessing competing claims to the mark VITO AND THE SALUTATIONS for a musical group); *Wrist-Rocket Manufacturing Co. v. Saunders*, 379 F.Supp. 902, 183 USPQ 17 (D. Neb. 1974), *aff’d in part and rev’d in*

part, 516 F.2d 846, 186 USPQ 5 (8th Cir. 1975) (considering various facts in determining ownership dispute over WRIST ROCKET trademark); Pamela S. Chestek, “Who Owns the Mark? A Single Framework for Resolving Trademark Ownership Disputes,” 96 Trademark Rptr. 681 (2006) (proposing a framework for resolving trademark ownership disputes based in large part on the factors considered in *Wrist-Rocket*). For example:

- because neither the Solar Agreement nor any other agreement between the parties is of record, it is unclear whether there are any contractual rights relating to the ownership, use or registration of the KLYMAXX trademark and service mark;
- while opposer is not aware of any “corporation, limited liability company or other legal entity ... in which Opposer and Applicants had or have any joint ownership interest,” that does not mean that there is no such entity which owns or has the right to control the use of the KLYMAXX mark; *cf. Rare Earth, Inc. v. Hoorelbeke*, 401 F.Supp. 26, 187 USPQ 291 (S.D.N.Y. 1975) (assessing which faction of Rare Earth, a broken-up band, controlled the band’s corporation, Rare Earth, Inc.);¹¹
- the record is devoid of any evidence regarding which, if any, of the parties has or had the right to control the parties’ band(s) or any band’s use of the KLYMAXX mark; *cf. Marshak v. Treadwell*, 240 F.3d 184, 57 USPQ2d 1764 (3d Cir. 2001) (addressing ownership of the mark THE DRIFTERS for a musical group, which had been assigned to the group’s manager, following which former members of the group began using the mark in

¹¹ In *Rare Earth*, the Court noted “that trademarks and trade names associated with musical performing groups present potentially difficult legal problems. Imagine, for example, a group which lawfully acquires the ‘Beatles’ trademark and performs without one or more of John, Paul, George or Ringo or ‘Jimmy Dorsey’s Orchestra’ without Jimmy Dorsey. Could the corporate owner of the ‘Rolling Stones’ mark replace the present members of the group and continue to sell out Madison Square Garden? In short, can the public consciousness of and secondary meaning acquire[d] by a performing group’s trade name survive personnel changes?” *Rare Earth*, 187 USPQ at 299 n.19.

competition with the manager's band) and *Rick v. Buchansky*, 226 USPQ at 451, 454-55 (finding that group's manager owned VITO AND THE SALUTATIONS mark because, *inter alia*, he handled promotional and financial matters for the group, made personnel decisions, selected its songs, taught vocal and dance technique, paid group's expenses, and "functioned much like the producer of a theater company or owner of a sports team");

- there is no evidence regarding who "conceived" of the KLYMAXX mark or paid for the band's advertising and promotion, or which, if any, of the group's members' names or likenesses were featured in KLYMAXX's promotional materials; *cf. Rick v. Buchansky*, 226 USPQ at 449; and

- there is no evidence regarding whether the relevant public associates the mark KLYMAXX with one or more of its current or former members, or whether the relevant public instead associates the mark with a style of music or performance, regardless of which individuals make up the band at any particular time; *cf. The Five Platters, Inc. v. Purdie*, 419 F.Supp. 372, 193 USPQ 411, 421, 424 (D. Md., 1976) (plaintiff not guilty of unclean hands "by presenting its group as the original Platters when in fact none of the persons now performing in the group were members in the 1950's," and finding that THE PLATTERS "has been and continues to be known as the hallmark identifying and distinguishing plaintiff's style and rendition of music" rather than a group comprised of particular or original members).

There is also no way to determine whether the parties' bands' apparent hiatus from performing constituted an abandonment of the mark prior to opposer and applicants performing in 2003. *Cf. The Kingsmen v. K-Tel International Ltd.*, 557 F.Supp. 178, 220 USPQ 1045 (S.D.N.Y. 1983) ("Even though plaintiffs disbanded their group in 1967 and ceased recording new material, there is no evidence suggesting that they failed to use the name Kingsmen during the period

from 1967 to the present to promote their previously recorded albums. Moreover, the fact that these individuals continue to receive royalties for Kingsmen recordings flies in the face of any suggestions of intent to abandon use of the name Kingsmen.”).

Despite all of these evidentiary infirmities (and others),¹² applicant has not contradicted opposer’s assertion in a response to a request for admission, affirmed as “true” by Ms. Cooley during her deposition, that “the Original Members warranted, represented and agreed that the Original Members had the sole and exclusive ownership of all right in and to the name KLYMAXX.” To the contrary, applicants (and Ms. Malsby in her letter) appear to take the same position. In fact, applicant Irby’s cease and desist letter to opposer prior to opposer’s May 17, 2003 performance states that the mark “is owned collectively by the original, individual members of that musical group.”¹³ For her part, applicant Cooper’s desire to settle with opposer on the terms set out in applicant Cooper’s trial brief is consistent with the apparently undisputed position of all concerned that the band’s original members jointly owned the KLYMAXX mark. Furthermore, even if the KLYMAXX mark was abandoned prior to opposer and applicants performing under the mark in 2003, there is no dispute that as between the parties, opposer was the first to use the mark in that year (opposer performed on May 17, 2003 while applicants

¹² While applicants did not object to any of opposer’s evidence, some of it is arguably hearsay, and certain documents have not been authenticated. We base our decision herein only on admissible evidence which we find to be credible.

¹³ Even if portions of the cease and desist letter are considered hearsay, Irby’s statement about the ownership of the KLYMAXX mark is not. Fed. R. Evid. 801(d)(2).

performed on November 23, 2003). Cooley Tr. at 8-10 and Ex. 7. Accordingly, as between the parties, whether or not the mark was abandoned prior to 2003, applicants are not the first users or sole owners of the mark.

“In a use-based application under Trademark Act Section 1(a), only the owner of the mark may file the application for registration of the mark; if the entity filing the application is not the owner of the mark as of the filing date, the application is void ab initio.” *Great Seats, Ltd. v. Great Seats, Inc.*, 84 USPQ2d 1235, 1239 (TTAB 2007); *see also*, 15 U.S.C. § 1051(a); *Huang v. Tzu Wei Chen Food Co., Ltd.*, 849 F.2d 1458, 7 USPQ2d 1335 (Fed. Cir. 1988); Trademark Rule 2.71(d). Here, because applicants were not the sole owners of the KLYMAXX mark as of the filing date of the involved use-based application, but were instead, at most, co-owners of the mark with other band members, who have not provided their consent to applicants’ registration of the mark, the involved application is void *ab initio*, and we need not reach opposer’s claim of priority and likelihood of confusion.¹⁴

Decision: The opposition is sustained and registration of applicant’s mark is refused under Section 1(a) of the Trademark Act.

A copy of this decision has been mailed to the following:

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¹⁴ Applicant Cooper’s motion to amend the application is therefore moot.