

**THIS OPINION IS NOT A
PRECEDENT OF THE TTAB**

Mailed:
April 12, 2011
Bucher

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

100 Blacks in Law Enforcement Who Care, Inc. and
100 Blacks Who Care, Inc.

v.

100 Blacks in Law Enforcement Who Care

Opposition No. 91190175
against Serial No. 77626835

Noel Leader, *pro se*, for 100 Blacks in Law Enforcement Who
Care, Inc. and 100 Blacks Who Care, Inc.

Conor F. Donnelly, for 100 Blacks in Law Enforcement Who
Care.

Before Bucher, Zervas and Kuhlke, Administrative Trademark
Judges.

Opinion by Bucher, Administrative Trademark Judge:

The applicant of the involved application is now listed
as 100 Blacks in Law Enforcement Who Care, an unincorporated
association in New York State. On December 4, 2008, Marquez
Claxton, an individual citizen, filed an application for
registration on the Principal Register of the mark **100 Blacks
in Law Enforcement Who Care** (*in standard character format*) for

services recited as "association services, namely, promoting the interests of civil rights" in International Class 35.¹

Registration has been opposed by two affiliated New York corporations, 100 Blacks In Law Enforcement Who Care, Inc. ("100 Blacks") and 100 Blacks Who Care, Inc. ("100 Blacks Who Care"), sharing a mailing address at 593 Vanderbilt Avenue in Brooklyn, NY. Opposers claim to own common law rights in the mark **100 Blacks in Law Enforcement Who Care** for services such as advocating for civil and human rights on behalf of citizens of New York State, for educational seminars and other informational public services. In addition to alleging priority of use and likelihood of confusion, opposers also allege a likelihood of dilution and that applicant is not the rightful owner of the mark.²

The opposition was timely filed via the Board's electronic filing system (ESTTA) on May 13, 2009. In its answer of June 19, 2009, applicant denied the salient

¹ Application Serial No. 77626835 was filed on December 4, 2008 based upon claims of first use anywhere and first use in commerce at least as early as January 1, 1993. In an examiner's amendment of March 12, 2009, applicant was changed from Mr. Marquez Claxton to 100 Blacks in Law Enforcement Who Care, an unincorporated association. This was applicant's name at the time the mark was published for opposition, so the name of defendant/applicant in the Board's caption above no longer includes the name of Mr. Claxton.

² While the Notice of Opposition contains terms like "false premise" (¶6) and "false statement" (¶8), we construe these charges as part-and-parcel of the overall allegation that applicant is not the rightful owner of the contested mark.

allegations of opposers' pleadings and asserted seventeen "affirmative defenses."³

On September 2, 2009, the Board approved the withdrawal of opposers' counsel. When opposers failed to respond to a show cause order of October 20, 2009, the opposition was dismissed with prejudice. Opposers stated in their motion for reconsideration of January 4, 2010 that they had not received several Board orders. Hence, the Board set aside the dismissal order of December 7, 2009, and reset trial dates.

According to the Board's order of March 4, 2010, opposers' trial period was to end on September 2, 2010. On August 23, 2010, opposers filed a document entitled "Opposers' 30-Day Trial Brief on Merits and Law." The brief refers to four affidavits dated June 23, 2009 [i.e., of Noel Leader, Vernon Wells, Joel Ottley and Cliff Hollingsworth] as attachments. However, opposers did not file any of the affidavits and they were not referenced in the contents of Exhibits A through D.⁴ In filing its "Appeal Brief" on

³ We construe many of these allegations in paragraphs numbered 11 through 27 as further explication of applicant's answer. Other statements that may well fall into the category of "affirmative defenses" appear to have been waived as they are not maintained in applicant's final brief.

⁴ This ESTTA filing of seventeen pages included the cover sheet (1), brief (8), Ex. A - NYS registration data (2), Ex. B - website (1), Ex. C - second website (2) and Ex. D - opposer's cease-and-desist letter to applicant of February 27, 2009 (3).

November 1, 2010, the last day of its trial period, applicant filed a copy of an affidavit of June 1, 2009, of Marquez Claxton - the original signatory and applicant. Then, with opposers' "rebuttal brief" of December 16, 2010, opposer filed three of the four affidavits of June 23, 2009 [i.e., of Vernon Wells, Joel Ottley and Cliff Hollingsworth].⁵

Suffice it to say that very little about this "trial" follows the procedures anticipated by our rules. However, inasmuch as both parties have submitted the totality of their evidence in this case as attachments to their respective briefs, in a parallel fashion and without any objections, we consider all the exhibits, including the copies of three affidavits from another proceeding dated June 23, 2009, and submitted to the United States Patent and Trademark Office on December 16, 2010, as stipulated into the record by the parties hereto.

As noted above, opposers' pleadings herein contain three grounds for refusing applicant registration:

⁵ This ESTTA filing of twenty-one pages included the cover sheet (1), brief (6), Ex. A - NYS registration data [same documents as Ex. A to August 23, 2010 ESTTA filing above] (3), Ex. B - three affidavits (7), Ex. C - Copies of organizational flyers from 1997-98 (3), and certificate of service page (1). While each of the identically-worded affidavits of Messrs. Wells, Ottley and Hollingsworth refer to "Noel Leader[']s Affidavit," we cannot find such an affidavit anywhere in this record.

(1) priority and likelihood of confusion; (2) likelihood of dilution; and (3) that applicant is not the rightful owner of the mark.

This case has similarities to earlier Board cases involving naming disputes among feuding members of extended family businesses, aging pop bands, or religious organizations riven by theological schisms. The common factor in all of these disputes involves at least two different factions having a common history and fighting over a single, long-shared mark.

In this case, the common history dates to the mid-1990s when a group of African American law enforcement professionals in New York City formed a group they called **100 Blacks in Law Enforcement Who Care**. While Messrs. Wells, Ottley and Hollingsworth refer to Marquez Claxton, the original applicant herein, as a "former" and "removed" member of opposer, 100 Blacks in Law Enforcement Who Care, Inc., Mr. Claxton refers to opposers as "...a small group of disgruntled members, led by Noel Leader [who] decided that they did not like the direction in which the organization was proceeding and instead of forming a new group, they have and are attempting to appropriate the organization that began [in the '90s]."

The webpage that applicant submitted as its specimen of use in the involved application has the same URL (e.g., www.100blacksinlawenforcement.org) as the homepage reproduced in opposers' Exhibit B to its main brief. In fact, the verbiage and images captured on the respective screenprints appear to be exactly the same:

The screenshot shows the homepage of the website <http://www.100blacksinlawenforcement.org/>. The header features a logo with two hands holding a globe and the text "100 BLACKS IN LAW ENFORCEMENT WHO CARE" alongside a collage of African American faces. A navigation bar includes links for HOME, PRESS, CALENDAR, PHOTOS, CONTACT, and FORUM. The main content area is divided into two columns. The left column contains sections for "HISTORY" and "MISSION". The right column contains sections for "100 BLACKS HELPFUL TIPS", "ADDITIONAL LINKS", "100 BLACKS WORKSHOPS", and "100 BLACKS ON TV".

HISTORY

"100 Blacks" was founded in 1995 by a core group of concerned African Americans representing a variety of professions within the field of law enforcement. The number of those men and women who wanted to participate in being part of a social solution instead of a passive problem quickly grew to 100 and beyond. These individuals all shared a sense of community, cultural and professional pride. This pride was accompanied by an unfulfilled desire to "give back" in some meaningful way. Through skillful organization and administration, 100 Blacks in Law Enforcement Who Care was born. In that first year, \$10,000 in grant monies was collected from the membership and distributed to needy individuals and organizations all over the City of New York.

MISSION

- 1) To fulfill our moral mandate to our creator, to enhance and cultivate the blessings that have been bestowed upon us.
- 2) To serve as a model organization for individuals and other professionals in our communities so that we can again take our rightful place on the stage of history as a free, proud, and productive people.
- 3) To offer (via non repayable grants) a minimum of \$1,000 a month to a worthy cause in the African American community
- 4) To be the vanguard for justice on the behalf of those who traditionally have no voice in society
- 5) To vigorously challenge racism, sexism and all of the debilitating ism's that retard the growth of today's global community
- 6) To economically empower our people by pooling our resources
- 7) To uplift our people through education

WE VOW TO NEVER STOP UNTIL VICTORY IS WON!

100 BLACKS HELPFUL TIPS

IF STOPPED IN THE STREET BY POLICE...
DO NOT reach into your pockets....
[read more ...](#)

WHEN THE POLICE KNOCK AT YOUR DOOR...
IF the police knock at your door and ask to come in, you do not have to....
[read more ...](#)

ADDITIONAL LINKS

- USEFUL LINKS
- FOUNDERS

100 BLACKS WORKSHOPS

Want to attend a survival workshop? Fill out a form and select from several workshops and become informed!
[Click for Form](#)

100 BLACKS ON TV

Watch 100 Blacks in Law Enforcement Who Care... **every Tuesday from 8pm - 9pm** on the

For more than fifteen years, 100 Blacks in Law Enforcement Who Care was not an incorporated entity. It apparently operated in this fashion into the calendar year 2008. Then in November 2008, Mr. Noel Leader filed in his own name for a New York State service mark registration for **100 Blacks in Law Enforcement Who Care**. Weeks later, in December 2008, Mr. Marquez Claxton filed the involved application with the United States Patent and Trademark Office for the identical mark, **100 Blacks in Law Enforcement Who Care**, for substantially the same services. Then in February 2009, Mr. Leader's group incorporated 100 Blacks in Law Enforcement Who Care, Inc., with the New York State Division of Corporations. In March 2009, Leader's group had their then-retained legal counsel send a cease-and-desist letter to Mr. Claxton. In May 2009, the Notice of Opposition initiating this proceeding was filed.

It is clear from the totality of the record that individuals such as Eric Adams, Noel Leader and Vernon Wells were involved at the inception of this organization in the mid-1990s. Mr. Leader's prominent and continuous role in the organization over the past fifteen years is not contested by applicant. While there is nothing in the record to corroborate Mr. Claxton's claim to being asked to join the organization in 1995, we accept as fact that Mr.

Claxton was an active member of the organization for more than a dozen years, and served into 2008 as a public spokesperson for the organization of which Mr. Leader remained as a key executive officer.

Since the dramatic parting of the ways in 2008/2009, it seems the founders / officers / members of the group have split into two camps. The opposers, under the leadership of Mr. Leader, include Eric Josey, Clifton L. Hollingsworth, Jr., Vernon C. Wells, Joel A. Ottley and Terrance Wansley. Those associated with Mr. Claxton include Thomasina Sams Riddick, Graham Weatherspoon, Todd Taylor and Jerome L. Rice. In one indication of the contentiousness of the relationship between these groups, the June 2009 affidavits of Messrs. Wells, Ottley, Hollingsworth and Claxton appear to have been executed when opposers sought an order from the Kings County Supreme Court prohibiting Mr. Claxton from identifying himself publicly as a member of 100 Blacks in Law Enforcement Who Care™.

Although the name of New York State Senator Eric Adams appears prominently on Mr. Claxton's webpage as "Founder Emeritus," there are no indications in this record that Mr. Adams has publicly thrown his support behind either of the dueling parties to this litigation. Accordingly, Mr. Leader appears to be one of the co-founders who has provided

continuous leadership of this group from its birth to the present. Mr. Leader was the force behind the incorporation of 100 Blacks in Law Enforcement Who Care, Inc., as a for-profit corporation in New York State committed to civil rights advocacy. On the other hand, applicant appears to have used a screenprint from one of the opposer's websites as its specimen of record in the involved application.

Weighing the evidence as a whole, we find that opposers have established by a preponderance of the evidence that they have a clear historical lineage to the earliest days of the informal association known as 100 Blacks in Law Enforcement Who Care. We are faced with the identical mark used in connection with identical services over a relatively long period of shared history. Hence, we find that traditional concepts of priority, likelihood of confusion, first use dates, dilution, etc., are of little help in resolving this dispute. Therefore, we focus our decision on the issue of ownership.

Applicant, by way of Mr. Claxton's personal affidavit, claims 1993 as its first date of use of the applied-for mark. Inexplicably, this alleged period of use beginning in 1993 includes a two-year period when an informal, unincorporated entity was allegedly operating prior to 1995, the year in which Mr. Claxton alleges he was first invited

to join the organization. He is also tacking onto more than a dozen years of shared history (1995 - 2008) with an organization allegedly founded by Messrs. Adams, Wells and Leader.

Without any other evidence corroborating Mr. Claxton's claims to first use as of 1993, applicant's involved application entitles it to claim December 4, 2008, as its priority date. Of course, this is more than a dozen years after the phrase 100 Blacks in Law Enforcement Who Care was adopted and first used. However, this shared history should not in any way create for applicant its own mark with its own first use date, i.e., ownership of this identical source indicator.

Accordingly, we find on the totality of this record, as a matter of trademark law, that opposer, 100 Blacks in Law Enforcement Who Care, Inc., is the owner of the mark **100 Blacks in Law Enforcement Who Care**. In view thereof, opposers have proven their claim that applicant is not the rightful owner of the mark.

Decision: The opposition is sustained, and registration to applicant is hereby refused.