

THIS ORDER IS A
PRECEDENT OF THE
TTAB

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451
General Contact Number: 571-272-8500

Mailed: May 31, 2018

Opposition No. 91191633

Piano Wellness, LLC

v.

Charlotte K. Williams

By the Trademark Trial and Appeal Board:

This case is before the Board on Opposer's request that, pursuant to the June 29, 2017, final judgment of a U.S. District Court in *Piano Wellness, LLC v. Williams*, No. 1:11-cv-01601-NLH-AMD (D.N.J.), the Commissioner of Trademarks transfer the application at issue to Opposer.

1. Background

Opposer filed a Notice of Opposition on August 24, 2009, to Applicant's application to register KEYBOARD WELLNESS.COM alleging, *inter alia*, likelihood of confusion and asserting common law rights in the marks PIANO WELLNESS, PIANO WELLNESS SEMINAR, and KEYBOARD WELLNESS SEMINAR and ownership of a pending application for KEYBOARD WELLNESS SEMINAR in International Class 41. 1 TTABVUE. Opposer later moved to suspend this proceeding based on the pendency of the civil action mentioned above. 16 TTABVUE. The district court complaint which Opposer submitted along with its motion to suspend alleged that

Opposer had obtained Registration No. 3777126 for PIANO WELLNESS SEMINAR on the Principal Register and Registration No. 3713595 for KEYBOARD WELLNESS SEMINAR on the Supplemental Register. *See* 16 TTABVUE 3-4. Pursuant to Trademark Rule 2.117(a), 37 C.F.R. § 2.117(a), on March 29, 2011, the Board suspended this proceeding pending the final determination of the District Court. 18 TTABVUE.

On July 11, 2017, Opposer filed a copy of the District Court's June 29, 2017, judgment in the civil action. 36 TTABVUE. On September 19, 2017, Opposer filed a certified copy of the District Court's findings of fact and conclusions of law that accompanied and resulted in the judgment in the civil action. 38 TTABVUE.

The District Court, *inter alia*, (1) found that "the trademark 'KEYBOARD WELLNESS.COM', together with the associated goodwill, is rightly the property of Piano Wellness, LLC"; (2) directed "the Commissioner of Trademarks to transfer the application to register such trademark (Application Serial No. 77/703300) to Piano Wellness, LLC"; (3) permanently enjoined Charlotte K. Williams from "asserting any claims of ownership in and to, or right to display or use," the KEYBOARD WELLNESS.com mark; and (4) entered judgment "in favor of Piano Wellness, LLC and against Charlotte K. Williams." 36 TTABVUE 5. We have reviewed the Docket Report for the civil action on PACER (*i.e.*, the federal government website for accessing court electronic records) and determined that no appeal was filed from the District Court's June 29, 2017, judgment. It therefore is final.

2. Discussion

The District Court's direction to the Commissioner of Trademarks to "transfer the application" to plaintiff exceeds the court's statutory authority to rectify the register under Section 37 of the Trademark Act, which is limited to registrations, not pending applications. 15 U.S.C. § 1119. Section 37 provides:

In any action involving a registered mark the court may determine the right to registration, order the cancelation of registrations, in whole or in part, restore canceled registrations, and otherwise rectify the register *with respect to the registrations* of any party to the action. Decrees and orders shall be certified by the court to the Director, who shall make appropriate entry upon the records of the Patent and Trademark Office, and shall be controlled thereby. (Emphasis added.)

All of the actions Section 37 authorizes the USPTO to take, upon court order in a case involving a federal registration, concern registrations. The agency may, upon order, effectuate "the cancelation of registrations, in whole or in part, restore canceled registrations, and otherwise rectify the register with respect to the registrations of any party to the action." *Id.* See also, *Pinnacle Pizza Co. v. Little Caesar Enters., Inc.*, 395 F. Supp. 2d 891, 905 (D.S.D. 2005) ("[Section 37] is limited to cancellation of registered marks, not trademark applications."); *Dunn Comp. Corp. v. Loudcloud, Inc.*, 133 F. Supp. 2d 823, 831, 57 USPQ2d 1626, 1633 (E.D. Va. 2001) ("Because this case does not involve any registered marks, no federal jurisdiction exists to order or cancel a registration under [Section 37]."); *Johnny Blastoff Inc. v. L.A. Rams Football Co.*, 48 USPQ2d 1385, 1386 (W.D. Wis. 1998) ("this court is without authority to direct [the USPTO] to grant or deny the pending applications"), *aff'd on other grounds*, 188 F.3d 427 (7th Cir. 1999)).

The District Court, of course, may “determine the right to registration” of an applied-for mark, as it did here. But when it does so, and determines that ownership of a pending *application* should be **transferred**, the source of its authority to order the transfer is not Section 37, but rather its plenary power to order the parties to take the steps required to effectuate such **transfer**. Article III courts have broad powers over the parties’ actions, including the power to issue injunctive orders *in personam* directing that one or more of the parties before it take or refrain from taking certain actions, such as assigning or abandoning a trademark application that is pending in the USPTO. Here, for example, the court could direct Applicant to assign the application to Opposer and to record that assignment with the USPTO.¹ *Cf. Test Masters Educ. Servs., Inc. v. Singh*, 428 F.3d 559, 578, 76 USPQ2d 1865, 1876 (5th Cir. 2005) (“In order to enforce this court’s prior judgment, it was within the district court’s discretionary power to issue an injunction prohibiting [defendant] from pursuing registration of [certain marks] in the PTO, mandating that [defendant] withdraw his current application pending before the PTO, and enjoining him from refiling such application.”).

¹ The Board notes that courts have appointed the attorney for the prevailing party as the other party’s “attorney-in-fact,” where the other party is not represented by counsel, for the purpose of executing and recording the assignment of a trademark application to the prevailing party. In *Triumph Int’l, Inc. v. Johnson*, Opposition No. 91192412 (TTAB December 9, 2015) (non-precedential), the amended judgment in the civil action between the parties provided that if the defendants failed to abandon their trademark applications or assign the applications to the prevailing plaintiff within the time proscribed by the district court, then the plaintiff was authorized to do so as the defendants’ attorney-in-fact. *Id.*, pp. 3–4 (27 TTABVUE in the docket for Opp. No. 91192412). The relevant section of the court’s amended judgment is located in the Board’s electronic docket for that proceeding at 22 TTABVUE 45, ¶ 3(d).

There is, however, another mechanism by which the Board may give effect to the District Court's judgment. Under Section 18 of the Trademark Act, the Board may, upon motion of any party before it, amend the ownership of an application pursuant to the Board's authority to "register the mark or marks for the person or persons entitled thereto, as the rights of the parties ... may be established in the proceedings[.]" 15 U.S.C. § 1068. *See also 8440 LLC v. Midnight Oil Co.*, 59 USPQ2d 1541, 1542 (TTAB 2001) (Board has authority to amend the application to reflect the proper owner); *Chapman v. Mill Valley Cotton*, 17 USPQ2d 1414, 1415 n.2 (TTAB 1990) (same).

And as a third alternative, the Board may, upon motion, sustain the opposition—which would have the effect of abandoning the application—in view of the District Court's judgment permanently enjoining Applicant from using or claiming ownership of the mark KEYBOARD WELLNESS.com.

3. Conclusion

In view of the above, Opposer is allowed **THIRTY DAYS** from the mailing date of this order in which to: (1) inform the Board that it will seek additional relief from the District Court in the nature of an order directing Applicant to assign the subject application to Opposer; (2) move the Board to amend the application pursuant to Section 18 of the Trademark Act to identify Opposer as the owner in accordance with the judgment of the District Court; or (3) move the Board to sustain the opposition, thereby rendering the application abandoned, in view of the judgment of the District Court. In the event Opposer responds to this order by moving for amendment of the

application or that the opposition be sustained and the application abandoned, Applicant is allowed **TWENTY DAYS** from the date of service of such motion to show cause why the Board should not grant such motion in view of the judgment of the District Court. Proceedings shall remain **suspended** pending Opposer's response to this order, and, in the absence of a response, will resume thereafter.