

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

**UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451**

WINTER

Mailed: March 7, 2012

Opposition No. 91196016 (parent)

Carlos Ramirez

v.

Fredrick J. Staves

and

Opposition No. 91198643

Fredrick J. Staves

v.

Carlos Ramirez

**Before Taylor, Lykos, and Shaw,
Administrative Trademark Judges.**

By the Board:

These consolidated opposition proceedings now come before the Board for consideration of the motion for summary judgment filed by Frederick Staves (hereafter "Staves") on May 27, 2011.¹ Before addressing this motion, it is first

¹ It is noted that initial disclosures were due in Opp. No. 91196016 on November 19, 2010, and that initial disclosures were due on May 28, 2011, in Opp. No. 91198643. When these proceedings were consolidated on March 14, 2011, the trial schedule of Opp. No. 91198643 was adopted for the consolidated proceedings. Although Staves does not state in his motion that he served his initial disclosures prior to filing the subject motion, Staves asserted in his revised motion to compel opposer's

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necessary to review the nature of each party's asserted claims and defenses in each of the opposition proceedings.

Claims in Each Proceeding

In Opposition No. 91196016, opposer, Carlos Ramirez (also referred to in this order as "Ramirez"), objects to the registration of the mark MAJESTICS CAR CLUB (stylized) as set forth in application Serial No. 77729569 and shown below, filed by Staves for use in connection with "customized printing of company names and logos for promotional and advertising purposes on the goods of others."²



As a basis for his opposition, Ramirez claims, in relevant part,³ that he, as a representative of the Majestics Organization, has been using the mark MAJESTICS continuously

initial disclosures that he had provided his initial disclosures to Ramirez (see unnumbered page 1, amended motion to compel filed on November 24, 2010). Further, attached to the declaration of Ramirez' counsel, Gordon E. Gray, III, is a copy of Staves' email claiming that he had made all of his disclosures (see Gray dec., ¶3). In view of the foregoing, we find that Staves' motion for summary judgment is timely under Trademark Rule 2.127(e)(1).

² Staves' application is based on his *bona fide* intent to use the mark in commerce under Section 1(b) of the Trademark Act. The application includes a disclaimer of the wording "CAR CLUB."

³ Ramirez also asserts that Staves does not have a *bona fide* intent to use the mark with customized printing services (see notice of opposition, ¶¶ 13-16).

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"on or in connection with its services and goods" since 1977 (¶¶ 5-6); that he is "a senior user" of the MAJESTICS mark in the United States (¶7); that Staves' mark is nearly identical to the design mark used by Ramirez and the Majestics Organization (¶11); and that registration to Staves should be refused because the applied-for mark is likely to cause confusion among consumers (¶12). Ramirez does not specifically allege that he is the owner of the MAJESTICS mark. See Section 1(a) of the Trademark Act, 15 U.S.C. § 1051(a).

Staves' purported "answer"⁴ to Ramirez' notice of opposition includes twenty-three paragraphs containing one or more factual allegations and arguments, fifteen pages of exhibits, and "bulky"⁵ submissions comprising a DVD-ROM and

⁴ Staves' "answer" neither admits nor denies Ramirez' allegations, nor does Staves state that he is without knowledge or information sufficient to form a belief as to the truth of Ramirez' allegations. In view thereof, Staves "answer" is improper and is not accepted. See Fed. R. Civ. P. 8(b); and Trademark Rules 2.106(a) and 2.116(a). Staves will be allowed time to serve an amended answer, as necessary, at the conclusion of this order.

⁵ Exhibits pertaining to either an ESTTA or a paper submission, such as Staves' answer, must be filed via ESTTA or on paper and must comply with the requirements for a paper or ESTTA submission. See Trademark Rule 2.126; and TBMP §§ 106.03 and 110.09(c)(3) (3d ed. 2011). The filing of either a compact disc, a CD-ROM, or a recorded DVD, such as Staves' submission, is not permissible. Exhibits that are large, bulky, valuable, or breakable should be photographed or otherwise reproduced so that an appropriate paper or digitized image of the exhibits can be filed with the Board in lieu of the originals.

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copies of three magazines.⁶ At the close of Staves' submission, Staves argues that based on the evidence he has provided, which assertedly shows that "the MAJESTICS design Logo belongs to [Staves] who is the President of all the chapters of the MAJESTICS CAR CLUB" (response to notice of opp., p. 6), Ramirez' opposition should be denied and Staves' mark should be allowed to register.

We find by these allegations that Ramirez' seeks to assert priority in the mark MAJESTICS and a claim of likelihood of confusion.

In Opposition No. 91198643, opposer, Fredrick J. Staves, *pro se* (not represented by counsel), objects to the registration of the mark MAJESTICS (stylized) as set forth in application Serial No. 77662861 and shown below, filed by Carlos Ramirez for use in connection with "social club services, namely, arranging, organizing, and

⁶ As will be discussed later in this order, the materials submitted by Staves with his answer will not be considered with respect to either the subject motion or at trial. With the exception of a plaintiff's pleaded registrations, which may be filed along with the petition to cancel or notice of opposition, evidentiary materials should not be filed with the Board at any time other than at the assigned time for submitting evidence, *i.e.*, with a movant's summary judgment motion or during a party's assigned testimony period. See Trademark Rules 2.122(c) and 2.122(d)(1). *Cf. Equine Touch Foundation Inc. v. Equinology Inc.*, 91 USPQ2d 1943, 1945 (TTAB 2009).

hosting social events, get-togethers, and parties for club members.”⁷



As a basis for his opposition, Staves alleges, in part, that he, “as a representative of the Majestic’s Car Club and President of the Compton, CA. Chapter of the Majestic’s [sic] Car Club’s mark,” has been using the MAJESTICS CAR CLUB mark “in commerce and for use continuously since 1996” (¶5); that he is a senior user of the MAJESTICS CAR CLUB mark in the United States (¶7); that Ramirez has provided a false date of first use in commerce (¶7); that Staves “does not know Applicant, and is aware that [Ramirez] has not provided use in commerce in connection with these or any other services since his alleged date of use in 1977” (¶7); that Ramirez’ mark so resembles Staves’ mark that it is likely to cause confusion among consumers (¶12); that Ramirez has not been a member of the Majestics Car Club for twenty years (¶14); and that Ramirez does not have a bona fide intent to use the mark in connection with any of the services in International Class 41 because he has no authority to use the Majestics Car Club name and logo (¶13).

⁷ Ramirez’ application, which is filed under Section 1(a) of the Trademark Act, is based on allegations of his use of the applied-for mark anywhere and in commerce since 1977.

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In response to Staves' notice of opposition, Ramirez denied virtually all of Staves' allegations, and asserted eight affirmative defenses, including failure to state a claim for which relief may be granted, lack of standing, unclean hands, and fraud.⁸

In view of Staves' factual allegations, we find that Staves has set forth the following claims in his opposition:

- (i) that Ramirez has no authority to use the applied-for MAJESTICS mark and, accordingly, has no *bona fide* intent to use the mark;
- (ii) that Ramirez has not used the mark MAJESTICS mark in commerce;
- (iii) that Staves is a senior user of the MAJESTICS CAR CLUB mark; and

⁸ Insofar as the pleading of Ramirez' affirmative defenses includes no facts on which the defenses are based, said defenses are legally insufficient. "A complaint must contain sufficient factual matter, accepted as true, to state a claim to relief that is plausible on its face." *Ashcroft v. Iqbal*, 556 U.S. 662 (2009), quoting *Bell Atlantic Corp. v. Twombly*, 550 U.S. 544, 570 (2007). Additionally, fraud must be pleaded with specificity. See Fed. R. Civ. P. 9(b) and Trademark Rule 2.116(a); and *In re Bose Corp.*, 580 F.3d 1240, 91 USPQ2d 1938, 1941 (Fed. Cir. 2009). Further, the defenses of waiver, acquiescence and/or laches are generally unavailable in an opposition proceeding. See, e.g., *National Cable Television Association v. American Cinema Editors Inc.*, 937 F.2d 1572, 19 USPQ2d 1424, 1432 (Fed. Cir. 1991); *Coach House Restaurant Inc. v. Coach and Six Restaurants Inc.*, 934 F.2d 1551, 19 USPQ2d 1401, 1404-05 (11th Cir. 1991); and *Turner v. Hops Grill & Bar Inc.*, 52 USPQ2d 1310, 1312 n.3 (TTAB 1999) ("the U.S. Court of Appeals for the Federal Circuit has held that in trademark opposition and cancellation proceedings, laches begins to run when the mark in question is published for registration").

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(iv) that there is a likelihood of confusion between the parties' applied-for marks.

Notably, Staves has not specifically alleged that he is the owner of or otherwise entitled to use the MAJESTICS CAR CLUB mark in commerce. See Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b).

Motion for Summary Judgment

• *The Parties' Arguments*

Staves requests that the Board grant summary judgment against Ramirez, dismiss Ramirez' opposition against Staves' application, and "dismiss" Ramirez' application for the MAJESTICS mark in application Serial No. 77662861. As the basis for his motion, Staves essentially argues that Ramirez presented no proof or evidence during the initial disclosure or discovery phase of this proceeding showing that Ramirez has "ever used the Majestics name or logo in Commerce, or that he has been a member of the Majestics Car Club since 1977" (motion at 1, ¶1; and motion at 2, ¶5), or that he has "any rights to claim the MAJESTICS name and logo" (motion at 2, ¶3; see also ¶13 at 4). Staves also contends that Ramirez' "proof of [his] right to obtain the Majestics name and designed [sic] mark" is not credible (motion at 4, ¶¶ 13-14). Thus, the bases for Staves' motion for summary judgment are (i) that Ramirez has never used the MAJESTICS name or logo, or that he has not been a member of the club

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since 1977; and (ii) that Ramirez has no authority to use the MAJESTICS design mark. Staves also requests that the Board grant summary judgment in his favor because Ramirez has refused to answer Staves' interrogatories and requests for admission and has refused to provide documents in response to Staves' document requests (motion at 2, ¶5).⁹

In support of his motion, Staves has submitted numerous documents,¹⁰ including (i) copies of the parties' respective responses to each other's document requests, requests for admission, and interrogatories (Exh. A); (ii) a copy of Staves' registration of "Majestics Car Club" as a fictitious

⁹ Staves' assertion in paragraph five of his motion, that is, that Ramirez has refused to answer Staves' interrogatories and requests for admission, is inconsistent with paragraph four of his motion and exhibits attached thereto which, together, show that Ramirez actually did respond to certain of Staves' discovery requests.

Additionally, to the extent Staves argues that Ramirez improperly refused to respond to Staves' discovery requests, and requests that the Board grant summary judgment in his favor as a sanction for Ramirez' asserted failure to respond to Staves' discovery, such a request is premature and will not be considered. See Trademark Rule 2.120(g)(1), 37 C.F.R. § 2.120(g)(1) (requiring failure to comply with previous discovery order before sanctions may be imposed).

¹⁰ In further support of his motion, Staves states that he has submitted to the Office "already" magazines with photos and articles "about Applicant and him being the President of the Compton chapter of the Majestics Car Club," photographs and a DVD, presumably related to Staves and the Majestics Car Club (motion at 3, ¶¶ 3-4). These items were submitted with Staves' answer to the notice of opposition, not as attachments to the subject motion. In view thereof, and as explained in footnote 6 of this order, they will not be considered. See *Kellogg Co. v. Pack'Em Enterprises Inc.*, 14 USPQ2d 1545, 1549 n.7 (TTAB 1990) (evidentiary materials "identified," i.e., relied upon, as supporting a motion for summary judgment usually must be submitted with the motion), *aff'd*, 951 F.2d 330, 21 USPQ2d 1142 (Fed. Cir. 1991). See also TBMP § 528.05(a)(1) (3d ed. 2011).

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business name owned by Staves in two California counties (Exh. B); (iii) an unexecuted copy of the "Rules and Regulations" of the Majestics Car Club, which states in paragraph "(14)" that "The Compton Majestic Chapter owns the Majestic Name, Logo, and Trademark," and seventeen declarations of fifteen Majestic Club chapter officers from various cities (Exh. C); and (iv) copies of three advertisements for Majestics Car Club events (Exh. D). Fourteen of the declarations state that Ramirez is not a member of the Majestic Car Club and has no authority to use the Majestics name or logo.¹¹ Two of the same declarants (Daniels and Wilson) state in separate statements that Staves will resume his post as president of the Compton chapter in 2012, after he is released from prison, and that he has been a part of the decision-making with respect to the Compton Chapter of the Majestics Club and/or the addition of other chapters to the club.¹²

In opposition, Ramirez argues, *inter alia*, that he, as a member of the SoCal chapter of the Majestics Car Club, has continuously used the MAJESTICS mark in conjunction with a

¹¹ See the declarations of Daniels, Durham, Frazier, Freeze, Gomez, Gonzalez, Gutierrez, Molina, Peek, (Jose) Ramirez, Rice, Thomas, Torres, and Wilson (motion, Exh. C). Only the submission of Todd Land, asserted President of the Glendale chapter, states that Carlos Ramirez has not been a member of his particular chapter.

¹² See the Daniel and Wilson declarations dated January 23, 2011, also in Exhibit C.

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wide variety of goods and services since 1973, and that it is Staves, not Ramirez, who has failed to provide any evidence showing that he has used the MAJESTICS CAR CLUB mark in commerce. Contrary to Staves' assertions, Ramirez contends that the SoCal chapter, rather than the Compton chapter of Majestics Car Club, is the oldest or parent organization. In addition, Ramirez alleges that he has been a member of SoCal since 1977,¹³ and based on that date, asserts that he has prior rights in the MAJESTICS mark. Ramirez also mentions that Staves has not attended a meeting of the Compton chapter since 2001, when he was assertedly convicted and imprisoned for drug trafficking. In support of these assertions, Ramirez has provided the declarations of Giovanni "Little John" Bertoldi, the asserted founder of the Majestics Car Club, Carlos Ramirez (opposer/applicant), Wayne "Honcho" Day, Rodrick Robinson, and Calvin Parker. Also attached to Ramirez' response is the declaration of his counsel, Gordon E. Gray III, which refers, *inter alia*, to Staves' email regarding his initial disclosures.

- *Evidentiary Matters*

Before considering the subject motion for summary judgment, we will address Ramirez' objections to the

¹³ The Board notes that Ramirez argues that he has been a member of the Majestics Car Club and has continuously used the MAJESTICS mark since 1973 and that he has been a member of the club continuously since 1977 (response at 2 and 3; declaration of Carlos Ramirez, ¶¶ 3 and 5).

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evidence attached to Staves' motion.

o Evidence that is not self-authenticating

We turn first to Ramirez' request that the Board exclude Exhibits B, C, and D, which comprise a copy of Staves' asserted registration of the Majestic Car Club name, an unexecuted copy of asserted Rules and Regulations of the Majestic Car Club, and copies of three advertising fliers which refer to events sponsored by the Majestics Car Club. Ramirez contends that these exhibits are not admissible because there is no evidence that the asserted Majestic Car Club Rules were ever adopted by any club chapters, and said Rules and Staves' other evidence are not authenticated.

A wide variety of evidence may be submitted in support of a motion for summary judgment. *See generally*, TBMP § 528.05(a)(1) (3d ed. 2011). Materials which are not self-authenticating in nature may nonetheless be admissible, if competent and relevant, provided they are properly authenticated by an affidavit or declaration pursuant to Fed. R. Civ. P. 56(e). *Id.* Affidavits may be submitted as long as they (1) are made on personal knowledge; (2) set forth such facts as would be admissible in evidence; and (3) show affirmatively that the affiant is competent to testify to the matters stated therein. *See* Fed. R. Civ. P. 56(c)(4). *See also* TBMP § 528.05(b) (3d ed. 2011). In lieu of an affidavit, a party may submit a declaration meeting

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the requirements of Trademark Rule 2.20, 37 C.F.R. § 2.20. *Taylor Brothers, Inc. v. Pinkerton Tobacco Co.*, 231 USPQ 412, 415 n.3 (TTAB 1986).

Here, there is no affidavit or declaration under Trademark Rule 2.20 to support the authenticity of the documents in Exhibits B, C and D specified above. In view thereof, the identified exhibits or parts thereof will not be considered insofar as they do not meet the Board's requirements for admissibility of evidence for summary judgment motions.

o Declarations

(1) Ramirez contends that the seventeen declarations of Staves' witnesses should be excluded because they are not properly executed in writing, as required under 28 U.S.C. § 1746. Specifically, each declaration was signed using the electronic signature format, *i.e.*, *"/John Doe/,"* provided for in Trademark Rule 2.193(c)(1). Ramirez contends that Staves has misused the electronic signature rules of the Office, and that the declarations are essentially unsigned and, thus, are inadmissible.

Although declarations under Trademark Rule 2.20 and unsworn declarations under 28 U.S.C. § 1746 must be personally "signed" by the actual person designated as the signatory, the signature may comprise either a handwritten signature signed in permanent ink by the person named as the

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signatory, or an electronic signature as set forth in Trademark Rule 2.193(c)(1), which is manually entered by the named signatory. See Trademark Rule 2.193(a)(2); and TBMP § 106.02 (3d ed. 2011). Insofar as there is no evidence of record indicating that the persons named in the declarations did not personally "sign" the unsworn declarations under 28 U.S.C. § 1746, the submitted declarations are not deficient with respect to the signature format and must be accepted.¹⁴

(2) Ramirez' also objects to certain declarations, asserting that they lack foundation with respect to the allegations therein. For instance, Ramirez points out that both Angelito Daniel(s)¹⁵ and Darwin Wilson state in their longer declarations that "Staves has been a member for over 30 years," but neither declarant claims to have been a member for thirty years, nor have they produced documents that support the assertion. Ramirez also objects to Robert Molina's declaration because the amount of time that he asserts that he has been an active member of the club is unclear.

¹⁴ Staves is reminded, however, that Title 35 of the United States Code (including Trademark 2.20 regarding declarations in lieu of oaths) pertains specifically to the USPTO and, therefore, is preferred to 28 U.S.C. § 1746, which is a statute of general application relating to verification on penalty of perjury.

¹⁵ In one declaration, the declarant is identified as "Angelito Daniel," and in the other, he is identified as "Angelito Daniels."

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As discussed *supra*, declarations or affidavits in support of or in response to a motion for summary judgment must be made on the personal knowledge of the declarant. Fed. R. Civ. P. 56(c)(4).

On review, we note that in their respective shorter declarations, Wilson states that he has been active in the club for twelve years, and Daniel(s) states that he has been an active member of the club for twenty years. However, there are no allegations in the declarations regarding how these members know that Staves has been a member for thirty years when the declarants have been members for much shorter periods of time. Although not raised by Ramirez, we observe the same deficiency with respect to the declarations of David Freeze, Terry Peek, and Luis Torres, who state that they have been club members for three, two and two years, respectively. Similarly, the foundation for Molina's statement that Ramirez is not a member of the club is unclear insofar as his declaration refers only to "2" without a stated period of time during which he has been a member of the Majestics Car Club. It is also unclear how Torres and Molina, the asserted President and Vice President of the Miami Chapter of the Majestics Car Club, and Freeze, who is the asserted President of the North Carolina Chapter of the club and the Southeast Region President for North Carolina, Central Florida, Daytona Beach, and Miami, would

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have personal knowledge regarding Staves' membership in a Compton, California chapter of the club. In view of the foregoing, the statements of Daniels, Wilson, Molina, Freeze, Peek and Torres, regarding the Staves' membership in the Majestic Club are excluded for failing to set forth an adequate foundation for the assertions in their declarations.

(3) Ramirez also requests that ten of fifteen declarations should be excluded because only five of the declarants (*i.e.*, Daniels, Wilson, Peek, Torres and Freeze) were disclosed by Staves in either his initial disclosures, supplementary initial disclosures, or in his responses to Ramirez' discovery requests.

Fed. R. Civ. P. 26(a)(1), applicable to this proceeding under Trademark Rule 2.116(a), does not obligate a party to disclose the name of every witness that may have discoverable information about its claims or defenses or to conduct an exhaustive search for all information or potential witnesses that could be used at trial. Rather, a party must disclose each individual likely to have discoverable information that the disclosing party may use to support its claims or defenses. *See Great Seats, Inc. v. Great Seats, Ltd.*, 100 USPQ2d 1323 (TTAB 2011). *See also Byer Calif. v. Clothing for Modern Times Ltd.*, 95 USPQ2d 1175, 1178 (TTAB 2010); and *Jules Jurgensen/Rhapsody Inc. v.*

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Baumberger, 91 USPQ2d 1443, 1444 n.1 (TTAB 2009). However, if the identity of the witness is known when initial disclosures are made, and the relevant knowledge of the witness is known, then a party may have to disclose the identity of the witness when making initial disclosures, even if the party has no plans at that time to rely on testimony from the witness. *Great Seats*, 100 USPQ2d at 1326 n.5.

With respect to nine of the ten declarations to which Ramirez objects based on lack of proper notice, *i.e.*, the submissions of Durham, Frazier, Gomez, Gonzalez, Gutierrez, Molina, (Jose) Ramirez, Rice, Thomas, we note that initial disclosures were due in Opposition No. 91196016 on November 19, 2010, and that the submissions of those witnesses are dated November 10, 15, 16, 17, or November 18, 2010. It is quite likely that Staves knew that those nine witnesses had discoverable information inasmuch as their submissions are dated within days before the initial disclosure deadline. Further, Staves' responses to Ramirez' interrogatories (motion, Exh. A), which were served on Ramirez on January 23, 2011, refer primarily to Compton chapter members Angelito Daniel, Darwin Wilson and Terry Peek. The other club members who provided declarations dated November 2010, were not mentioned; and Todd Land was also not identified. Land's declaration is dated

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February 7, 2011, within two weeks of the date on which Staves served his interrogatory responses.

In view of the proximity of the dates of the declarations and the dates on which Staves served his initial disclosures and discovery responses, we find that Staves improperly failed to disclose the identity of these ten witnesses. See *Great Seats, supra*. Accordingly, Ramirez' motion to exclude the proffered declarations of Durham, Frazier, Gomez, Gonzalez, Gutierrez, Land, Molina, (Jose) Ramirez, Rice, Thomas, is granted.

In view of the foregoing determinations with respect to Ramirez' evidentiary objections, we will only consider the discovery responses submitted by Staves (*i.e.*, Exh. A), for whatever probative value the responses may have. See Trademark Rule 2.127(e)(2).

In any event, as discussed below, the exclusion of Staves' evidence does not alter our conclusion regarding the merits of Staves' motion for summary judgment.

- *Discussion*

Summary judgment is an appropriate method of disposing of cases in which there is no genuine dispute as to any material fact and the movant is entitled to judgment as a matter of law. See Fed. R. Civ. P. 56(a). A party moving for summary judgment has the burden of demonstrating the absence of evidence to support the non-moving party's case,

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and that it is entitled to judgment as a matter of law. *Sweats Fashions Inc. v. Pannill Knitting Co.*, 833 F.2d 1560, 4 USPQ2d 1793, 1795-1796 (Fed. Cir. 1987), *citing Celotex Corp. v. Catrett*, 477 U.S. 317, 325 (1986). Moreover, on a motion for summary judgment, the function of the Board is not to resolve issues of fact but to determine, instead, if there is a genuine dispute with respect to material facts to be tried. A material fact is one that may affect the decision in the case. A genuine dispute with respect to a material fact exists if sufficient evidence is presented such that a reasonable fact finder could decide the question in favor of the non-moving party. *Lloyd's Food Products Inc. v. Eli's Inc.*, 987 F.2d 766, 25 USPQ2d 2027 (Fed. Cir. 1993); *Opryland USA Inc. v. Great American Music Show Inc.*, 970 F.2d 847, 23 USPQ2d 1471 (Fed. Cir. 1992); and *Olde Tyme Foods Inc. v. Roundy's Inc.*, 961 F.2d 200, 22 USPQ2d 1542 (Fed. Cir. 1992). Additionally, "the record must be viewed in a light favorable to the party opposing the motion, and all justifiable inferences are to be drawn in the non-movant's favor." *Barmag Barmer Maschinenfabrik AG*, 731 F.2d 831, 221 USPQ 561, 564 (Fed. Cir. 1984).

Staves requests that the Board grant summary judgment in his favor against Ramirez on the basis that Ramirez has not used the MAJESTICS mark and that Ramirez has no authority to use the MAJESTICS mark, dismiss Ramirez'

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opposition against Staves' application, deny registration to Ramirez' applied-for mark, and "grant" registration of his mark (motion at 4). In view of Staves' several requests, we construe Staves' motion as seeking summary judgment on his and Ramirez' respective claims of priority of use of the MAJESTICS or MAJESTICS CAR CLUB marks.

Based on our review of the pleadings in these consolidated proceedings, the parties' arguments, Staves' limited evidence (as discussed *supra*), and the evidence submitted by Ramirez, for the following reasons, we cannot grant summary judgment in favor of Staves.

We turn first to Staves' request that summary judgment be entered in his favor because Ramirez assertedly has no authority to use the MAJESTICS mark. After drawing all inferences in favor of Ramirez who is the non-movant, we find that Staves, as the party moving for summary judgment, has not met his burden to establish that there is an absence of any genuine dispute as to material facts with respect to his claim of priority, and that he is entitled to judgment as a matter of law. Specifically, the declarations submitted by Ramirez and the exhibits attached thereto are sufficient to show that genuine disputes exist, at a minimum,¹⁶ as to whether and/or how long Ramirez has been a

¹⁶The fact that we identify only a few material facts that are genuinely in dispute should not be construed as a finding that these are necessarily the only issues that remain for trial.

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member of the Majestic Car Club and has used the MAJESTICS mark, how long Staves has been a member of the Majestics Car Club and has actually used the MAJESTICS CAR CLUB mark, and as to which individual or entity has priority of use in their asserted marks.

Further, Staves' summary judgment motion necessarily relies on a claim that he has a proprietary interest in, is entitled to use, or is the owner of the MAJESTIC CAR CLUB mark, and that his interest in the mark was obtained prior to either the filing date of Ramirez' application for registration or Ramirez' date of first use of the mark. See *Herbko International Inc. v. Kappa Books Inc.*, 308 F.3d 1156, 64 USPQ2d 1375, 1378 (Fed. Cir. 2002); *Otto Roth & Co., Inc. v. Universal Corp.*, 640 F.2d 1317, 209 USPQ 40, 43 (CCPA 1981); *Miller Brewing Co. v. Anheuser-Busch Inc.*, 27 USPQ2d 1711, 1714 (TTAB 1993). As such, to the extent Staves' motion relies on a claim that he (and not Ramirez) has a proprietary interest in the MAJESTIC CAR CLUB mark and thus, that he has a *bona fide* intent to use said mark, Staves' summary judgment motion is premature because, as we noted earlier in this order, Staves does not claim in his notice of opposition that he is the owner of, is entitled to register or otherwise has a proprietary interest in the MAJESTICS CAR CLUB mark; instead; he only states that he is *a member of* the Majestics Car Club. A party may not obtain

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summary judgment on an unpleaded ground or defense. See Fed. R. Civ. P. 56(a) and 56(b). See also *S. Industries Inc. v. Lamb-Weston Inc.*, 45 USPQ2d 1293, 1297 (TTAB 1997); *Giant Food, Inc. v. Standard Terry Mills, Inc.*, 229 USPQ 955, 961 (TTAB 1986).

Accordingly, in view of the foregoing, Staves' motion for summary judgment is denied.¹⁷

Both Parties Fail to Allege Ownership of a Proprietary Interest in Their Respective Marks

As discussed, Staves does not allege in his pleading that he owns a proprietary interest in the MAJESTIC CAR CLUB mark or is otherwise entitled to register the mark. Likewise, Ramirez does not assert that he owns his applied-for mark or otherwise has a proprietary interest in the MAJESTICS mark. In fact, we note that Ramirez alleges in his pleading that he has been "engaged in an organization named 'Majestics,'" and that he is a representative of the Majestics Organization (Ramirez ¶¶ 3, 5). Similarly, Staves alleges that he is a member and a representative of the

¹⁷ The parties should note that the evidence submitted in connection with the motion for summary judgment is of record only for consideration of the motion. Any such evidence to be considered at final hearing must be properly introduced in evidence during their appropriate trial periods. See *Levi Strauss & Co. v. R. Joseph Sportswear Inc.*, 28 USPQ2d 1464 (TTAB 1993); *Pet Inc. v. Bassetti*, 219 USPQ 911 (TTAB 1983); *American Meat Institute v. Horace W. Longacre, Inc.*, 211 USPQ 712 (TTAB 1981).

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Majestic Car Club (Staves ¶¶ 3, 5). In view of the parties' allegations and the evidence submitted with or in response to Staves' summary judgment motion, it appears that the MAJESTICS mark, as assertedly used by Ramirez, may be a collective membership mark, rather than a service mark. Similarly, the MAJESTICS CAR CLUB mark, which Staves alleges he has a *bona fide* intention to use in connection with the services described in his application, may be a collective service mark.

A collective *membership mark* is a mark that is used solely to indicate that the user of the mark is a member of a particular organization. See *Constitution Party of Texas v. Constitution Ass'n USA*, 152 USPQ 443 (TTAB 1966). In contrast to a trademark or service mark, membership marks are not used in business or trade; and they do not indicate commercial origin of goods or services. See *Ex parte The Supreme Shrine of the Order of the White Shrine of Jerusalem*, 109 USPQ 248 (Comm'r Pats. 1956). See generally, TMEP § 1304 (8th ed. 2011). The owner of a collective membership mark is normally the "cooperative, an association or other collective group or organization," whose members use the mark. See Section 45 of the Trademark Act, 15 U.S.C. § 1127. Therefore, the application to register the membership mark must be made by the collective organization that controls or intends to control use of the

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mark and, thus, owns or is entitled to use the mark through its members. See Section 4 of the Trademark Act, 15 U.S.C. § 1054; and *In re Stencel Aero Engineering Corp.*, 170 USPQ 292 (TTAB 1971). See also TMEP § 1301.04 (The application for registration of a collective membership mark may not be made by a mere member). Therefore, it is only the collective organization itself, as the owner of the collective membership mark (or the entity that is entitled to control the use of the mark through its members), that may bring a claim on behalf of the association of members. See, e.g., *Leading Jewelers Guild, Inc. v. LJOW Holdings, LLC*, 82 USPQ2d 1901 (TTAB 2007). Cf. *F.R. Lepage Bakery, Inc. v. Roush Bakery Products Co.*, 851 F.2d 351, 355-56, 7 USPQ2d 1395 (Fed. Cir. 1988), *modified, remanded*, 863 F.2d 43, 9 USPQ2d 1335 (Fed. Cir. 1988) ("If the organization assigns the mark to an individual company, that individual cannot assert collective mark rights. ... Such an assignment "causes the registration ... to become a misrepresentation indicating that the owner is a 'group or organization,' which it is not ...[w]hat the statute does not permit cannot be finagled by agreements between private parties"). See generally, 3 MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 19.101 (4th ed., 2012 update).

Similarly, with respect to a collective *trademark or service mark*, the collective organization itself generally

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neither sells goods nor performs services under the mark, but it advertises or promotes the goods or services sold by its members under the collective mark. In addition, members of the organization can use the collective trademark or service mark to identify and distinguish their own goods or services as emanating from a member of a collective organization. See *id.* at § 19:99, citing *Prof'l Golfers Ass'n v. Bankers Life & Casualty Co.*, 514 F.2d 665, 186 USPQ 447 (5th Cir. 1975) (the PGA mark is used by its members in professional golf shops, at tournaments and in the sale of services to "guarantee the quality of service provided by members"). However, no one member can own the mark. See TMEP § 1303. Rather, like the collective membership mark, the collective organization or entity holds the title to the collectively used trademark or service mark for the benefit of all members of the group and, thus, the organization must apply to register the mark. Accordingly, only the collective organization can bring a claim involving the collective trademark or collective service mark. See *Leading Jewelers* and *Lepage*, *supra*.

ORDER:

In view of the foregoing, the parties are allowed until **THIRTY DAYS** from the mailing date of this order to amend their respective complaints to include an appropriate allegation of ownership, right to use, or other proprietary

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interest in their asserted marks that would entitle them to bring their claims. Alternatively, the parties may submit a brief explaining why they have standing to bring their respective oppositions. See, e.g., *Fair Indigo LLC v. Style Conscience*, 85 USPQ2d 1536, 1538 (TTAB 2007); *McDermott v. San Francisco Women's Motorcycle Contingent*, 81 USPQ2d 1212 (TTAB 2006) (opposer must plead "a direct and personal stake in the outcome of the opposition" and set forth a reasonable basis for his belief in damage), citing *Ritchie v. Simpson*, 170 F.3d 1092, 50 USPQ2d 1023, 1025 (Fed. Cir. 1999). Failure by each opposer to perfect his pleading, or otherwise explain how he has standing, will result in dismissal of his opposition.

With respect to any submission in response to the foregoing order, the parties are reminded that under 37 C.F.R. § 11.18, by submitting any pleading, written motion or other paper to the Board, each party is *certifying* that to the best of that party's knowledge, information and belief, formed after an inquiry reasonable under the circumstances, *whether represented by counsel or not*, that such pleading, motion or paper is not being submitted for an improper purpose; that the legal contentions therein are warranted by existing law or by a nonfrivolous argument for the extension, modification, or reversal of existing law or the establishment of new law; and that the allegations and

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other factual contentions have evidentiary support or, if specifically so identified, are likely to have evidentiary support after a reasonable opportunity for further investigation or discovery. See Trademark Rule 2.193(f), 37 C.F.R. § 2.193(f); and 37 C.F.R. § 11.18.

Should the Board find that either party has committed sanctionable conduct with respect to any forthcoming assertion of ownership or a proprietary interest in the MAJESTIC mark(s), the Board has authority to enter other appropriate sanctions, up to and including the entry of judgment. See Fed. R. Civ. P. 11; and Trademark Rule 2.116(a). See, e.g., *Central Mfg. Inc. v. Third Millennium Technology, Inc.*, 61 USPQ2d 1210, 1213 (TTAB 2001) ("The authority to sanction a *pro se* party is manifestly clear, and the Supreme Court has held that the Rule 11 certification standard for a party is the same as that for an attorney"). See also TBMP § 527.01 (3d ed. 2011) and authorities cited therein.

Should either party submit an amended pleading in response to this order, the adverse party will be allowed time to submit an amended answer thereto, which must comply with Fed. R. Civ. P. 8(b) and Trademark Rule 2.106(a).

These proceedings are otherwise **SUSPENDED**.

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