

This Opinion is Not a
Precedent of the TTAB

Mailed: December 4, 2014

UNITED STATES PATENT AND TRADEMARK OFFICE

—
Trademark Trial and Appeal Board
—

Carlos Ramirez v. Fredrick James Staves

—
Opposition No. 91196016
against Serial No. 77729569
—

Gordon E. Gray III of the Gray Law Firm,
for Carlos Ramirez.

Frederick James Staves, *pro se*.¹

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

Opinion by Lykos, Administrative Trademark Judge:

On May 5, 2009, Frederick James Staves (“Applicant” or “Staves”) applied to register on the Principal Register the stylized mark displayed below



¹ Applicant was advised to secure the services of legal counsel familiar with Board proceedings but has chosen to appear *pro se* in this matter. Interlocutory Order dated March 14, 2011; 16 TTABVUE 5.

TTABVUE refers to the Board’s publicly available online docket sheet. For the citations to the record in TTABVUE throughout the decision, the number preceding “TTABVUE” corresponds to the docket entry number; the number(s) following “TTABVUE” refer to the TTABVUE page number(s) of that particular docket entry.

for “[c]ustomized printing of company names and logos for promotional and advertising purposes on the goods of others” in International Class 40.² Applicant has disclaimed the wording “CAR CLUB” apart from the mark as shown.

By his first amended complaint, Carlos Ramirez (“Opposer” or “Ramirez”)³ opposed the registration of Applicant’s mark on the ground of likelihood of confusion under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), with Opposer’s previously used and registered mark displayed below



for “[c]ar accessories, namely, car plaques” in International Class 20.⁴ In relevant part, Opposer alleges the following:

3. Opposer, Carlos Ramirez (hereinafter “Ramirez”) is, and has been since 1977, a member of an organization named, Majestics Car Club. The Majestics Car Club is a club and unincorporated associated.[sic] In particular, Ramirez is a member of the Majestics Car Club parent organization referred to as “SoCal” (hereinafter “SoCal”).

² Application Serial No. 77729569, filed May 5, 2009 pursuant to Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b), alleging a bona fide intent to use the mark in commerce. The description of the mark is as follows: “The mark consists of the wording ‘MAJESTICS’ in a stylized font, with smaller stylized wording reading ‘CAR CLUB’ beneath.” Color is not claimed as a feature of the mark.

³ Although Ramirez named Majestics Car Club – SoCal (“SoCal”) as a joint opposer in his amended pleading, SoCal was never joined as a party plaintiff to this proceeding. See Opposer’s Amended Pleading, 26 TTABVUE and Interlocutory Order dated June 10, 2014 44 TTABVUE 2.

⁴ Registration No. 4109381, issued March 6, 2012 from an application filed on February 19, 2010, alleging October 4, 2011 as the date of first use anywhere and October 26, 2009 as the date of first use in commerce. The description of the mark is as follows: “The mark consists of [t]he stylized word ‘majestics’ with a stylized underline.” Color is not claimed as a feature of the mark.

4. SoCal provides social club services, namely arranging, organizing and hosting social events, get-togethers, and parties for club members and automobile enthusiasts under the mark “MAJESTICS.” SoCal also sells car plaques to its members for display in their cars.

5. SoCal, as the parent organization, supervises and controls a number of MAJESTICS chapters throughout the United States and World, including but not limited to the chapter in Compton, California.

6. Currently, the Compton chapter (hereinafter “Compton”) is attempting to gain control of the Majestics Car Club by, *inter alia*, falsely claiming that it is the parent organization for the Majestics Car Club, opening new unauthorized chapters, demanding that chapters and their members pay dues to Compton in exchange for the right to use the name MAJESTICS, display Majestics car plaques in members’ cars and to hold Majestics events such as car shows, picnics, and dances and other social events.

7. Applicant’s intent-to-use application is part of Compton’s scheme to gain control of the MAJESTICS name and to extract money out of the membership of the Majestics Car Club.

8. Ramirez, a longtime member and officer of SoCal, has been licensed and authorized by SoCal to use the MAJESTICS mark and to secure trademark applications for the MAJESTICS mark for a variety of goods and services including car plaques and arranging, organizing, and hosting social events, get together, and parties for club members and automobile enthusiasts. Mr. Ramirez is also the record owner of U.S. Trademark Reg. 4,109.381[sic] for car accessories, namely, car plaques.

...

12. Opposers, Ramirez and SoCal, have been using the MAJESTICS mark in commerce continuously since 1977 and 1973 respectively.


13. Opposers, Ramirez and SoCal, have continuously used, advertised and promoted the MAJESTICS trademark on or in connection with their goods and services since 1977 and 1973 respectively.

Opposer also asserted a claim that Applicant lacked a *bona fide* intent to use the mark in commerce when the application was filed. Insofar as Opposer has not argued this claim in his brief, in accordance with the Board’s usual practice we find

this claim to have been waived by Opposer.⁵ See e.g., *Knight Textile Corp. v. Jones Investment Co.*, 75 USPQ2d 1313, 1314 n.4 (TTAB 2005).

In his answer, Applicant denied the salient allegations therein.

I. *Procedural Background*

The instant “parent” opposition was previously consolidated with “child” Opposition No. 91198643, *Frederick J. Staves v. Carlos Ramirez*, against Ramirez’s application Serial No. 77663861, filed February 4, 2009 for the stylized mark  for “Social club services, namely, arranging, organizing, and hosting social events, get-togethers, and parties for club members” in International Class 41. In the “child” opposition, Staves, as plaintiff, by way of his amended notice of opposition, alleged, in relevant part, that (1) Ramirez lacked the authority to use his applied-for mark; (2) that Ramirez had not used his applied-for mark in commerce; (3) that Staves is the senior user; and (4) that a likelihood of confusion exists between the parties’ marks. See March 28, 2012 Amended Notice of Opposition; 27 TTAVUE and Interlocutory Order dated December 20, 2012; 33 TTABVUE 3-4. However, the “child” opposition was dismissed with prejudice on June 10, 2014 for Staves’ failure to prosecute. Interlocutory Order dated June 10, 2014 (citing Trademark Rules 2.127(a) and 2.132(a)); 44 TTABVUE 10. Shortly thereafter and just prior to briefing in this case, on July 15, 2014, application Serial No. 77663861 matured into Registration No. 4565858. However, as discussed further below, Ramirez’s

⁵ Opposer is reminded that under the doctrine of *res judicata*, claims based on the same transactional facts as a prior claim in which a final judgment has been rendered and which should have been litigated in the earlier case are barred from a subsequent suit. See *Sharp Kabushiki Kaisha v. Thinksharp, Inc.*, 448 F.3d 1368, 79 USPQ2d 1376, 1378 (Fed. Cir. 2006).

Registration No. 4565858 was neither pleaded nor made of record in the instant proceeding.

II. *Applicant's Late-Filed Brief*

Before turning to the substance of this appeal, the Board must first address Opposer's motion to strike Applicant's appeal brief as untimely. The Board allowed Applicant time to demonstrate the requisite excusable neglect for his failure to timely file an appeal brief, and to explain the discrepancy between the date he certified by his signature that he had mailed the brief and the postmarked date of his brief. Board Order dated November 5, 2014; 50 TTABVUE. In response thereto, Applicant asserts that he had retained and paid legal counsel to draft and file his appeal brief and was under the mistaken impression that "the brief was taken care of." Applicant's Response to Board's November 20, 2014 Order; 51 TTABVUE 1. Applicant further asserts that he did not learn that his appeal brief was never filed until well after the deadline had passed. *Id.* As to the discrepancy in the dates, Applicant states that after he became aware that no brief was filed, he "quickly" sent in the brief he had previously already written himself which had an earlier date, and as such, the discrepancy in dates was an "honest mistake." *Id.*

Although the length of the delay in filing the brief was not inconsequential, and the reasons set forth by Applicant for his untimeliness fell within Applicant's control, based on the record before us it appears that Applicant acted in good faith. *See Pioneer Inv. Servs. Co. v. Brunswick Assocs. L.P.*, 507 U.S. 380 (1993) (The excusable neglect determination must take into account all relevant circumstances surrounding the party's omission or delay, including the danger of prejudice to the

nonmovant, the length of the delay and its potential impact on judicial proceedings, the reason for the delay, including whether it was within the reasonable control of the movant, and whether the movant acted in good faith.). *See also Pumpkin Ltd. v. The Seed Corps*, 43 USPQ2d 1582 (TTAB 1997) (adoption of Supreme Court's excusable neglect analysis set forth in *Pioneer*, 507 U.S. at 393-95. Further, we see no prejudice to Opposer in considering the brief. *See id.* In view of the circumstances noted above, the Board finds that Applicant has demonstrated the requisite excusable neglect and we have considered Applicant's brief. *See Fed. R. Civ. P. 6(b)(1)(B)*. Opposer's motion to strike is therefore denied.

III. *The Record*

The record includes the pleadings, and pursuant to Trademark Rule 2.122(b), Applicant's application file. Opposer filed a notice of reliance consisting of a printout obtained from the USPTO Trademark Electronic Search System ("TESS") database showing the current status of and title to his pleaded Reg. No. 4109381 (Exhibit 24) as well as various printed publications obtained from third-party websites (Exhibits 16a, 16b, 16c, and 25). Opposer also introduced his own testimony deposition with Exhibits 2-8, 10-15, and 21-22 attached thereto, and the testimony deposition of Roderick Robinson, co-founder of the Majestics Car Club.

Applicant submitted no evidence.⁶ Nonetheless, Opposer, as plaintiff in this proceeding, bears the burden of establishing his standing and Section 2(d) claim by a preponderance of the evidence.

⁶ In his brief, Opposer, "in an abundance of caution" objected to Applicant's submission of materials with Applicant's pretrial disclosures filed with the Board on September 10, 2013. Opposer's objection is unnecessary. As previously explained by the Board, the exhibits

IV. *Standing*

Because Opposer has properly made his pleaded Registration No. 4109381 of record, we find that Opposer has established his standing to oppose registration of Applicant's mark. *See Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842 (Fed. Cir. 2000); and *Lipton Industries, Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185 (CCPA 1982).

V. *Section 2(d) Claim*

We will now consider Opposer's Section 2(d) claim.

A. *Priority*

Applicant argues that Opposer has failed to present "undisputed testimony that he has continuously used the Majestics Mark since 1977," and that he, not Opposer, had the authority to use the mark in question. Applicant's Brief, p. 6; 46 TTABVue 6.

In light of Opposer's proof of ownership of a valid and subsisting federal registration, Applicant's arguments are of no avail. To prevail on a likelihood of confusion claim brought under Trademark Act Section 2(d), a party must first prove that it owns "a mark registered in the Patent and Trademark Office or a mark or trade name previously used in the United States ... and not abandoned" Trademark Act Section 2, 15 U.S.C. § 1052. Here, priority is not in issue in view of Opposer's ownership of his valid and subsisting Registration No. 4109381 for the goods identified therein of "Car accessories, namely, car plaques." *See King Candy*,

submitted with Applicant's pretrial disclosures fail to meet the requirements of a notice of reliance and will not be considered. *See Trademark Rules 2.012(j)(8) and 2.122(e)*. Interlocutory Order dated June 10, 2014, n.4; 44 TTABVue 10.

Inc. v. Eunice King's Kitchen, Inc., 496 F.2d 1400, 182 USPQ 108 (CCPA 1974). As to Applicant's contention that Opposer lacks the requisite authority to use his registered mark, such statements amount to a collateral attack on Opposer's registration which claim should have been brought via a counterclaim to cancel said registration. See Trademark Rule 2.106(b)(2)(i) ("A defense attacking the validity of any one or more of the registrations pleaded in the opposition shall be a compulsory counterclaim if grounds for such counterclaim exist at the time when the answer is filed. If grounds for a counterclaim are known to the applicant when the answer to the opposition is filed, the counterclaim shall be pleaded with or as part of the answer. If grounds for a counterclaim are learned during the course of the opposition proceeding, the counterclaim shall be pleaded promptly after the grounds therefor are learned).

That being said, in his brief Opposer also seeks to rely on Registration No. 4565858 for services identified as "Social club services, namely, arranging, organizing, and hosting social events, get-togethers, and parties for club members" to establish priority. As noted above, the underlying application which matured into that registration was the subject of the consolidated "child" opposition proceeding. However, because this registration was neither pleaded nor made of record via notice of reliance in this case, Opposer cannot rely on this registration. In other words, the fact that the registration was the subject of the child opposition and matured into registration prior to trial does not make the registration of record in

the instant proceeding.⁷ Therefore, in discussing the issue of likelihood of confusion below, we have limited our analysis to the goods identified in 4109381 of “Car accessories, namely, car plaques.”

B. Likelihood of Confusion

The remaining issue in this case is likelihood of confusion. We base our determination under Section 2(d) on an analysis of all of the probative evidence of record bearing on a likelihood of confusion. *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973) (“*du Pont*”). *See also, In re Majestic Distilling Company, Inc.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). “Not all of the *du Pont* factors are relevant to every case, and only factors of significance to the particular mark need be considered.” *In re Mighty Leaf Tea*, 601 F.3d 1342, 1346, 94 USPQ2d 1257, 1259 (Fed. Cir. 2010). For example, the Board can “focus ... on dispositive factors, such as similarity of the marks and relatedness of the goods.” *Herbko Int’l, Inc. v. Kappa Books, Inc.*, 308 F.3d 1156, 1164, 64 USPQ2d 1375, 1380 (Fed. Cir. 2002) (citation omitted). Such is the case here where we focus our analysis on the first two *du Pont* factors.

Initially we consider the first *du Pont* likelihood of confusion factor regarding the similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression. *Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1691 (Fed.

⁷ In addition, Opposer argues in his brief that he “presented undisputed testimony that he has used the MAJESTICS mark continuously since 1997.” Opposer’s Brief, p. 8; 45 TTABVUE 9. However, to the extent, if any, Opposer seeks also to rely on prior common law usage to establish priority, this is unnecessary in light of our above comments.

Cir. 2005). “The proper test is not a side-by-side comparison of the marks, but instead ‘whether the marks are sufficiently similar in terms of their commercial impression’ such that persons who encounter the marks would be likely to assume a connection between the parties.” *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1721 (Fed. Cir. 2012) (citation omitted). The focus is on the recollection of the average purchaser, who normally retains a general rather than a specific impression of trademarks. *In re Jack B. Binion*, 93 USPQ2d 1531 (TTAB 2009); *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106 (TTAB 1975).

Both parties’ marks are comprised, either in whole or in part, of the word MAJESTIC in virtually the same stylized lettering. Indeed, we observe that the similarity in font style is striking insofar as each could be described as heavy and angular with square proportions, reminiscent of a Gothic style of writing. We further observe that the design element consisting of a scrolled line under the word MAJESTICS is drawn in almost an identical manner.

That being said, our analysis cannot be predicated on dissection of the involved marks. *See Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 110 USPQ2d 1157, 1161 (Fed. Cir. 2014). Rather, we are obliged to consider the marks in their entireties. *Id.* *See also, Franklin Mint Corp. v. Master Mfg. Co.*, 667 F.2d 1005, 212 USPQ 233, 234 (CCPA 1981) (“It is axiomatic that a mark should not be dissected and considered piecemeal; rather, it must be considered as a whole in determining likelihood of confusion.”). Nonetheless, there is nothing improper in stating that, for rational reasons, more or less weight has been given to a particular

feature of a mark, provided the ultimate conclusion rests on a consideration of the marks in their entireties. *Stone Lion*, 110 USPQ2d at 1161.

Applicant's mark includes additional literal elements, namely the wording CAR CLUB. However, given the relatively small size of the wording CAR CLUB in relation to the larger, heavily stylized term MAJESTIC, it more likely that prospective consumers encountering Applicant's stylized mark will overlook the smaller sized wording CAR CLUB. We therefore find that because the word MAJESTIC is the dominant feature of Applicant's mark, the involved marks are far more similar than dissimilar in sound, appearance, connotation and commercial impression. In view of the forgoing, the first *du Pont* factor favors a finding that confusion is likely.

Now, we turn to a comparison of the parties' respective goods and services as they are identified in the application and registration at issue. *See Stone Lion*, 110 USPQ2d at 1161; *Octocom Sys., Inc. v. Houston Computers Servs. Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990). *See also, Hewlett-Packard Co. v. Packard Press Inc.*, 281 F.3d 1261, 62 USPQ2d 1001 (Fed. Cir. 2002). At the outset we note that this case involves a comparison of services and goods. Nonetheless, it is well recognized that confusion may be likely to occur from the use of the same or similar marks for goods, on the one hand, and for services involving those goods, on the other. *See, e.g., In re Hyper Shoppes (Ohio), Inc.*, 837 F.2d 463, 6 USPQ2d 1025 (Fed. Cir. 1988) (holding BIGG'S (stylized) for retail grocery and general merchandise store services and BIGGS and design for furniture likely to cause confusion); *In re H.J. Seiler Co.*, 289 F.2d 674, 129 USPQ 347 (CCPA 1961) (holding

SEILER's for catering services and SEILER'S for smoked and cured meats likely to cause confusion); *In re United Serv. Distribs., Inc.*, 229 USPQ 237 (TTAB 1986) (holding mark consisting of a design featuring silhouettes of a man and woman used in connection with distributorship services in the field of health and beauty aids and mark consisting of a design featuring silhouettes of a man and woman used in connection with skin cream likely to cause confusion); *In re Phillips-Van Heusen Corp.*, 228 USPQ 949 (TTAB 1986) (holding 21 CLUB for various items of clothing and THE "21" CLUB (stylized) for restaurant services likely to cause confusion); *In re U.S. Shoe Corp.*, 229 USPQ 707 (TTAB 1985) (holding CAREER IMAGE (stylized) for retail women's clothing store services and CREST CAREER IMAGES (stylized) for uniforms likely to cause confusion); *Steelcase Inc. v. Steelcare Inc.*, 219 USPQ 433 (TTAB 1983) (holding STEELCARE INC. and design for refinishing of furniture, office furniture, and machinery and STEELCASE for office furniture and accessories, likely to cause confusion); *Corinthian Broad. Corp. v. Nippon Elec. Co., Ltd.*, 219 USPQ 733 (TTAB 1983) (holding TVS for transmitters and receivers of still television pictures and TVS for television broadcasting services likely to cause confusion). In this case, the customized printing services on the goods of others identified in the involved application are not restricted to any particular product. As such, Applicant's "[c]ustomized printing of company names and logos for promotional and advertising purposes on the goods of others," could encompass the printing of "company names and logos" for Opposer's identified goods consisting of "car plaques." This is further reinforced by the fact that Applicant's mark includes the wording "CAR CLUB," making it more likely that consumers will mistakenly

believe that Applicant's custom printing services are for car plaques originating from Opposer. This second *du Pont* factor also weighs in favor of finding a likelihood of confusion.

In the present case, the first two *du Pont* factors discussed above favor a finding of likelihood of confusion. Accordingly, we find that Opposer has proved his standing, as well as priority and likelihood of confusion under his Section 2(d) claim by a preponderance of the evidence.

Decision: The opposition is sustained.