

UNITED STATES PATENT AND TRADEMARK OFFICE  
Trademark Trial and Appeal Board  
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Mailed: December 9, 2015

Opposition No. **91192412 (parent)**

*Triumph International, Inc.*

*v.*

*Melissa Johnson*

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Opposition No. 91192500  
Opposition No. 91197565

*Triumph International, Inc.  
and The Special Administrators  
of the Michael J. Jackson  
Estate*

*v.*

*Heal the World Foundation*

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Opposition No. 91192578  
Opposition No. 91195491  
Opposition No. 91195725

*The Special Administrators of  
the Michael J. Jackson Estate*

*v.*

*Melissa Johnson*

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Opposition No. 91193804

*Triumph International, Inc.  
and The Special Administrators  
of the Michael J. Jackson  
Estate*

*v.*

*United Fleet*

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Opposition No. 91198506

*The Executors/Michael J.  
Jackson Estate*

*v.*

*Heal the World Foundation*

(as consolidated)

**Before Cataldo, Taylor, and Gorowitz  
Administrative Trademark Judges:**

This case comes before the Board for consideration of the parties' responses to the Board's September 2, 2015, order allowing them an opportunity to explain why these consolidated oppositions should not be terminated in the manners set forth in the Board's order.

**Background**

The Board suspended proceedings pending the final disposition of a civil action in the United States District Court for the Central District of California in which John G. Branca and John McClain, Special Administrators of the Estate of Michael

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J. Jackson, and Triumph International, Inc., were plaintiffs and Applicants Heal the World Foundation and United Fleet were defendants.<sup>1</sup> 4 TTABVUE 4.

On May 15, 2015, Opposers informed the Board that the United States District Court for the Central District of California issued an amended judgment in the civil proceeding; that the United States Court of Appeals for the Ninth Circuit affirmed the district court's denial of Applicant Heal The World Foundation's Rule 60(b) motion seeking relief from the amended judgment; and that the district court's amended judgment was final, non-reversible, and non-appealable. 21 TTABVUE 3.

The district court's amended judgment provided, in relevant part:

Defendants [Heal the World Foundation] and [United Fleet] and Melissa Johnson shall transfer to the Estate (or its designee, e.g., Triumph) all registered trademarks owned but not limited to, HEAL THE WORLD and its variations, MJ, and GONE TOO SOON. *Defendants HTWF and TUF and Melissa Johnson shall, at the direction of the Co-Executors in their sole and unfettered discretion, either transfer to the Estate or abandon or withdraw all applications for trade marks [sic] filed in the United States or any other jurisdiction, including, but not limited to, MICHAEL, MJ, MICHAEL JACKSON, MICHAEL JACKSON'S HEAL THE WORLD FOUNDATION, KING OF POP, MICHAEL'S ARMY, THRILLER, and MAKE THAT CHANGE.*

Amended Judgment, ¶ 3(c) (emphasis added), at 22 TTABVUE 44. The amended judgment further provided that if the defendants failed to execute the documents necessary to effectuate the required transfer or abandonment within the proscribed time, then The Estate is appointed the defendants' attorney in fact for purposes of

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<sup>1</sup> *Branca v. Heal the World Found.*, Case No. CV-09-07084, in the United States District Court for the Central District of California Western Division.

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signing such documents. Amended Judgment, ¶ 3(d), at 22 TTABVUE 45. The amended judgment also indicated that “[a]ll references to Melissa Johnson throughout this Judgment pertain to her capacity as an agent, officer, or representative of Defendants, *not to her personal capacity.*” Amended Judgment, ¶ 3(c) (emphasis added), at 22 TTABVUE 44.

Pursuant to the amended judgment, Mr. Branca, Co-Executor of the Estate of Michael J. Jackson, in his capacity as “attorney in fact” for Applicants, executed various abandonments and assignments of the involved applications, which were then filed with the Board or recorded in the U.S. Patent and Trademark Office Assignment Branch, as appropriate.

When the Board resumed these consolidated proceedings following the disposition of the civil litigation, it noted that the entry of judgment against Applicants in those oppositions in which the subject applications had been abandoned and dismissal as moot of those oppositions in which the subject applications had been assigned to Opposer Triumph International appeared appropriate. *See* 24 TTABVUE. The Board deferred taking such actions at that time, however, in order to allow any party to show cause why the oppositions should not be terminated as further described in its order.

### **Applicants’ Response**

In response to the Board’s September 2, 2015, order, Applicants contend that the district court’s judgment does not bind Melissa Johnson in her individual capacity; that the district court’s judgment is “unlawful” to the extent that the court’s ruling

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enforced a memorandum of understanding<sup>2</sup> that purportedly bound Ms. Johnson, despite the fact that Ms. Johnson was not a party (in her individual capacity) to the prior civil action; and that these consolidated oppositions involve Melissa Johnson, United Fleet, and Heal the World Foundation whereas only United Fleet and Heal the World Foundation were subject to the district court's judgment.<sup>3</sup> Applicants also argue for the first time that insofar as the district court's judgment pertains to Ms. Johnson only in her capacity as an agent, officer, or representative of the defendants in the civil litigation, and not to her personal capacity, it should not be given effect by the Board because on July 29, 2009 — more than two years prior to the district court's amended judgment — Melissa Johnson, Heal The World Foundation, and United Fleet purportedly entered into a “co-ownership agreement” by which they co-own the marks and applications collectively, and therefore Ms. Johnson personally owns a one-third interest in the subject marks and applications, thereby excluding them from, and effectively negating, the district court's judgment.<sup>4</sup>

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<sup>2</sup> The memorandum of understanding has not been submitted to the Board.

<sup>3</sup> Applicants contend that these proceedings should remain suspended pending the outcome of their malpractice suit against the attorneys who represented them in the concluded civil action. The Board, having previously determined that the malpractice suit will have no bearing on these proceedings, has given these arguments no further consideration.

<sup>4</sup> The Board notes, however, that the USPTO records do not reflect co-ownership of the subject applications. For each application, the USPTO records list as “applicant” only one of the three defendants, Heal the World Foundation, United Fleet, *or* Melissa Johnson. Further, the co-ownership agreement was never recorded against any of the applications. As far as the USPTO records are concerned, each of the subject applications is owned by a single applicant.

### **Decision**

Applicants' arguments regarding the co-ownership agreement and the "lawfulness" of the district court's judgment are not well taken. The district court ruled in Opposers' favor in the civil litigation, and gave Mr. Branca the authority to execute the transfers or abandonments of the subject applications. We have no authority to modify the court's judgment or construe it in a manner that would undermine its plain meaning and effect. If Applicants contend that the court's judgment is "unlawful," or otherwise inappropriate, their remedy lies with the district court or the court of appeals.<sup>5</sup>

On the other hand, we agree with Applicants that the district court's amended judgment does not bind Ms. Johnson in her personal capacity because the amended judgment explicitly says so. Accordingly, that part of the Board's September 2, 2015, order addressing Opposition No. 91192578 and subject application Serial No. 77789656 is **vacated**. The Trademark Office records indicate that this application was filed by Melissa Johnson, an individual, and remains in her name. It therefore appears that this application is not encompassed by the district court's ruling because it has at all times been personally owned by Ms. Johnson, and not by Heal the World or United Fleet. Consequently, Opposers were without authority to act as attorney-in-fact for Ms. Johnson when they filed an abandonment of the application on her behalf. *See* 7 TTABVue 3. That abandonment will not be entered.

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<sup>5</sup> Notably, the purported 2009 co-ownership agreement was executed long prior to the district court's October 27, 2011, amended judgment, and the district court's decision made clear that its judgment applied to Ms. Johnson in her official capacity but not her personal capacity.

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In view of the assignments or abandonments of the other applications executed by Mr. Branca as attorney in fact, the remaining oppositions are terminated as follows.

**Opposition No. 91192412**

In view of the assignment of subject application Serial No. 77515451 from United Fleet to Triumph International,<sup>6</sup> the opposition is **dismissed as moot**.

**Opposition No. 91192500**

The opposition is **dismissed as moot** solely with respect to application Serial No. 77773906 in view of the assignment of the application from Heal the World Foundation to Triumph International.<sup>7</sup>

**Judgment is entered** against Heal the World Foundation with respect to the remaining applications (Serial Nos. 77781986, 77800165, and 77800167) in view of the August 1, 2011, abandonment of the applications without Opposers' written consent (*see* 7 TTABVue 3). Trademark Rule 2.135.

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<sup>6</sup> An assignment of the '451 Application from Melissa Johnson to United Fleet was executed on August 14, 2009, and recorded in the USPTO Assignment Branch on August 14, 2009, at Reel/Frame 4044/0870. Therefore, this application was the property of United Fleet when the district court rendered its judgment requiring the application be assigned or abandoned. United Fleet subsequently assigned the application to Opposer Triumph International, Inc., on July 27, 2011 and the assignment was recorded with the USPTO on August 1, 2011 at Reel/Frame 4595/0014.

<sup>7</sup> The assignment was executed on July 27, 2011, and recorded on August 1, 2011 at Reel 4595 Frame 0014.

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**Opposition No. 91193804**

**Judgment is entered** is entered against United Fleet in view of the August 1, 2011, abandonment of application Serial No. 77812740 without Opposers' written consent.<sup>8</sup> Trademark Rule 2.135.

**Opposition Nos. 91197565**

**Judgment is entered** against Heal The World Foundation in view of the August 1, 2011, abandonment of Application Serial No. 77873819 without Opposers' written consent (*see* 7 TTABVUE 4). Trademark Rule 2.135.

**Opposition No. 91195491**

**Judgment is entered** against Heal The World Foundation in view of the August 1, 2011, abandonment of application Serial No. 77784571 without Opposers' written consent<sup>9</sup> (*see* 7 TTABVUE 3). Trademark Rule 2.135.

**Opposition No. 91195725**

**Judgment is entered** against Heal The World Foundation in view of the August 1, 2011, abandonment of application Serial No. 77926289 without Opposers' written consent (*see* 7 TTABVUE 3). Trademark Rule 2.135.

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<sup>8</sup> The abandonment was filed in Opposition No. 91193804, where it appears in the docket for that case at 11 TTABVUE 2. It does not appear in the record for the parent opposition.

<sup>9</sup> Although this application was filed by Melissa Johnson, an assignment of the subject application from Melissa Johnson to Heal the World Foundation was executed on August 19, 2009, and recorded in the USPTO Assignment Branch on August 20, 2009, at Reel 4049 Frame 0566. Therefore, this application was the property of Heal The World Foundation when the district court rendered its judgment and thus is subject to the court's ruling that the application be assigned or abandoned.

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**Opposition No. 91198506**

**Judgment is entered** against Heal The World Foundation in view of the August 1, 2011, abandonment of application Serial No. 77800279 without Opposers' written consent.<sup>10</sup> Trademark Rule 2.135.

**Proceedings Resumed**

The Board file in these consolidated proceedings has been maintained in Opposition No. 91192412 as the "parent" case. In view of the dismissal of that opposition, **the Board file will now be maintained in Opposition No. 91192578.** Because this is the only remaining opposition, all submissions should be filed in Opposition No. 91192578 and bear the case caption for that proceeding alone, *i.e.*, *The Special Administrators of the Michael J. Jackson Estate v. Melissa Johnson*, Opposition No. 91192578. All submissions relevant to Opposition No. 91192578 that were filed in Opposition No. 91192412 during the time the latter case was the parent case, will be deemed part of the record in Opposition No. 91192578.

Proceedings in Opposition No. 91192578 are resumed and dates are reset as follows.

Applicant's Time to Answer	<b>1/15/2016</b>
Deadline for Discovery Conference	<b>2/14/2016</b>
Discovery Opens	<b>2/14/2016</b>
Initial Disclosures Due	<b>3/15/2016</b>
Expert Disclosures Due	<b>7/13/2016</b>
Discovery Closes	<b>8/12/2016</b>
Plaintiff's Pretrial Disclosures	<b>9/26/2016</b>

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<sup>10</sup> The abandonment was filed in Opposition No. 91198506, where it appears in the record for that case at 7 TTABVUE 2. It does not appear in the record for the parent opposition.

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Plaintiff's 30-day Trial Period Ends	<b>11/10/2016</b>
Defendant's Pretrial Disclosures	<b>11/25/2016</b>
Defendant's 30-day Trial Period Ends	<b>1/9/2017</b>
Plaintiff's Rebuttal Disclosures	<b>1/24/2017</b>
Plaintiff's 15-day Rebuttal Period Ends	<b>2/23/2017</b>

In each instance, a copy of the transcript of testimony together with copies of documentary exhibits, must be served on the adverse party within thirty days after completion of the taking of testimony. Trademark Rule 2.125.

Briefs shall be filed in accordance with Trademark Rules 2.128(a) and (b). An oral hearing will be set only upon request filed as provided by Trademark Rule 2.129.

Although Opposition No. 91192578 will proceed, the judgments entered in Opposition No. 91193804, Opposition No. 91197565, Opposition No. 91195491, Opposition No. 91195725, Opposition No. 91198506, and Opposition No. 91192500 (with respect to abandoned Serial Nos. 77781986, 77800165, and 77800167) are final and the time for filing an appeal runs from the mailing date of this order. *See* Trademark Rule 2.145; TMBP § 901.