

This Opinion is not a
Precedent of the TTAB

Mailed: January 14, 2016

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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Deford Bailey LLC
v.
Carlos Deford Bailey and Deford Bailey III

—
Opposition No. 91209857
to Application Serial No. 85304626

—
Amy J. Everhart of Everhart Law Firm PLC¹ for
Deford Bailey LLC.

Walter M. Benjamin for Carlos Deford Bailey and Deford Bailey, III

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Before Cataldo, Shaw and Lynch,
Administrative Trademark Judges.

Opinion by Lynch, Administrative Trademark Judge:

Carlos DeFord Bailey and DeFord Bailey, III (“Applicants”) seek registration on the Principal Register of the mark DEFORD BAILEY (in standard characters) for

¹ We grant the Request to Withdraw as Counsel filed by Opposer’s counsel, Maria A. Spear, arising out of her departure from Everhart Law Firm PLC. The ongoing representation of Opposer by lead counsel Amy J. Everhart satisfies the requirements of Rule 11.116(b)(1), 37 C.F.R. § 11.116(b)(1).

harmonicas in International Class 15 (“Application”).² DeFord Bailey LLC (“Opposer”) opposes registration based on Trademark Act Section 2(a) false association and Section 2(d) likelihood of confusion, 15 U.S.C. §§ 1052(a), (d), as well as fraud and non-ownership of the mark, as reflected in the Amended Notice of Opposition.³ In their Amended Answer, Applicants denied the salient allegations in the Amended Notice of Opposition and alleged several affirmative defenses.⁴ Applicants unsuccessfully moved for judgment on the pleadings, and Opposer unsuccessfully moved for summary judgment.⁵ Opposer submitted testimony and other evidence and a trial brief.⁶ Because Opposer has not pursued its pleaded fraud claim in its brief or submitted evidence relating thereto at trial,⁷ we deem Opposer to have waived this claim. *See Alcatraz Media Inc. v. Chesapeake Marine Tours Inc.*, 107 USPQ2d 1750, 1753 (TTAB 2013) (petitioner found to have waived claims not argued before the Board). Applicants failed to submit evidence or a trial brief, and we therefore deem its asserted affirmative defenses waived. *See Harry Winston, Inc. v. Bruce Winston Gem Corp.*, 111 USPQ2d 1419, 1422 (TTAB 2014) (pleaded affirmative defenses not pursued in the brief considered waived); *Research in Motion Ltd. v. Defining Presence Marketing Group Inc.*, 102 USPQ2d 1187, 1189-90 (TTAB 2012) (affirmative defenses not pursued at trial considered waived).

² Application Serial No. 85304626, filed April 26, 2011, includes a claim of first use in commerce on April 11, 2011.

³ 8 TTABVUE.

⁴ 20 TTABVUE.

⁵ 17 TTABVUE.

⁶ 29 TTABVUE; 32 TTABVUE.

⁷ 32 TTABVUE at 17 n.3 (brief acknowledges inability to prove fraud).

I. Standing

The Trademark Act allows for an opposition to a registration by anyone “who believes that he would be damaged by the registration of a mark.” 15 U.S.C. § 1063. The party seeking to oppose registration must prove two elements: (1) that it has standing, and (2) that there is a valid ground to prevent the registration of the opposed mark. *Young v. AGB Corp.*, 152 F.3d 1377, 47 USPQ2d 1752, 1754 (Fed. Cir. 1998). Opposer must prove standing by showing a real interest in the outcome of the proceeding and a reasonable basis for believing that it would suffer damage if the mark is registered. *See* 15 U.S.C. § 1063; *Ritchie v. Simpson*, 170 F.3d 1092, 50 USPQ2d 1023, 1025-26 (Fed. Cir. 1999). Opposer’s status as a successor in interest to rights in the name “DeFord Bailey” as well as the proof that Opposer has licensed the use of the name suffice to establish its real interest in the outcome of this opposition as well as a reasonable belief that it would be damaged by the registration of the mark. *See Jewelers Vigilance Committee Inc. v. Ullenberg Corp.*, 823 F.2d 490, 2 USPQ2d 2021, 2023-24 (Fed. Cir. 1987) (Opposer’s members interest in continuing use of the name sought to be registered sufficed to establish standing, even in the absence of a proprietary interest in the mark).

II. Background

The record consists of: the pleadings; the file of the opposed application, trademark application Serial No. 85304626 and the testimony depositions of Shemika Wiley, DeFord Bailey, III, and Carlos Lamont Bailey, Sr., and accompanying exhibits. Applicants submitted no evidence in this proceeding.

Although one of the Applicants bears the name DeFord Bailey, III, and the other uses the name Carlos DeFord Bailey, the parties agree that the reference in the applied-for mark DEFORD BAILEY refers to DeFord Bailey, Sr., a harmonica virtuoso inducted into the Country Music Hall of Fame and remembered as the first African American performer on the Grand Ole Opry.⁸ He died in 1982. Applicants are two of his grandsons,⁹ and Opposer is an LLC of which his great granddaughter is the sole member.¹⁰

DeFord Bailey, Sr. apparently died intestate and unmarried. His three children were his sole heirs, one of whom was DeFord Bailey, Jr., father of Applicants and grandfather of Opposer's sole member.¹¹ Before his death in 2013, DeFord Bailey, Jr., son of the famous harmonica player, formed the Opposer LLC with his granddaughter, Shemika Wiley, and held a 90% interest, while she held a 10% interest.¹² An agreement entitled "Intellectual Property Assignment" and the LLC Operating Agreement signed by DeFord Bailey, Jr. both provided that he assigned

⁸ 29 TTABVUE at 119, 147, 191, 194.

⁹ *Id.* at 190-191.

¹⁰ *Id.* at 10.

¹¹ *Id.* at 12-14, 108-110, 190-191, 194-195.

¹² *Id.* at 17-18.

to the LLC all intellectual property rights he had in the name DEFORD BAILEY.¹³ When DeFord Bailey, Jr. died, his will also provided that any intellectual property rights he had were transferred to the LLC.¹⁴ Upon his death, the LLC exercised a right in the LLC Operating Agreement for it to buy out his interest, leaving Shemika Wiley as the sole member of the LLC.¹⁵

On April 18, 2012, one of the Applicants, Carlos Bailey, signed a “Name and Likeness Licensing Agreement” with the LLC to sell t-shirts and harmonicas bearing DeFord Bailey’s name.¹⁶ As part of the agreement, Applicant Carlos Bailey agreed that he did “not have any right, title or interest in or to” the name DeFord Bailey and the associated goodwill.¹⁷ The evidence indicates he sold some harmonicas at a rose garden event honoring DeFord Bailey, Sr. and paid the LLC the 20% licensing fee required under the agreement.¹⁸ Carlos Bailey testified that he calculated the fee based on “what was read on that first page that I read about the licenses that day,”¹⁹ though shortly before that he had testified regarding the licensing agreement, “I didn’t read this.”²⁰ Carlos Bailey’s trial testimony indicates that the rose garden event marked his first sale of a harmonica bearing the applied-

¹³ *Id.* at 287 (Intellectual Property Assignment), 277-285 (LLC Operating Agreement);

¹⁴ 29 TTABVUE at 292-295.

¹⁵ *Id.* at 289-290.

¹⁶ *Id.* at 298-300, 196-202; *see also id.* at 336 (admitted to signing the agreement in response to Opposer’s Request for Admission).

¹⁷ 29 TTABVUE at 298.

¹⁸ *Id.* at 202-203.

¹⁹ *Id.* at 203.

²⁰ *Id.* at 199.

for DEFORD BAILEY mark, but at one point, he recalled the year being 2011 rather than the 2012 date indicated on the licensing agreement.²¹

The Application, filed April 26, 2011, includes a claim of first use in commerce on April 11, 2011. It bears the electronic signatures of Walter Benjamin, the attorney representing the two joint Applicants, as well as of Carlos DeFord Bailey and DeFord Bailey, III.²² However, the record includes a June 2, 2011 letter to Walter Benjamin bearing the handwritten signature of Applicant DeFord Bailey, III²³ that states as follows:

I understand that you have filed a federal trademark application on my behalf for the mark DEFORD BAILEY. I have never spoken with you or authorized you to represent me or file a trademark application on my behalf. I demand that you immediately withdraw the application.

In addition, the record includes a June 2, 2011 declaration of DeFord Bailey, III signed under penalty of perjury stating that, “I have never met or communicated with Mr. [Walter] Benjamin and did not authorize him to file the application [Serial No. 85304626] on my behalf or represent me in connection with any legal matters.”²⁴ DeFord Bailey, III gave conflicting trial testimony regarding whether he actually signed the letter and declaration, at one point indicating that the

²¹ *Id.* at 207; *see also id.* at 196 (describing the “Rose Garden” event taking place April 20, 2012).

²² We note that the record includes a single page exhibit potentially identified as the last page of the Application, 29 TTABVUE at 314, containing handwritten signatures of both Applicants. This document was not submitted to the USPTO and does not show the applied-for mark. Rather, the Application record reflects that the Application was submitted electronically using the USPTO’s TEAS Plus form, and included only electronic signatures between forward slashes.

²³ 29 TTABVUE at 310.

²⁴ 29 TTABVUE at 312.

documents did not contain his signature, but later conceding that they might but he had not read them before signing.²⁵ At another point, after comparing his signatures on several documents, he definitively changed his testimony and admitted that he signed the letter and declaration, but stated that “I wasn’t aware of what I was signing.”²⁶ Furthermore, in another section of internally inconsistent trial testimony, DeFord Bailey, III stated at one point that he did engage Mr. Benjamin in connection with the trademark application, but then later testified about that same issue that “somebody said I signed off, which I didn’t realize I had signed off on.”²⁷ Still later, he testified that he recalled physically signing the trademark application.²⁸

Regarding use of the applied-for mark, Carlos DeFord Bailey testified that he first received harmonicas bearing the applied-for mark in March 2011 but for a while he held back on selling them and just “gave those away.”²⁹ The first sale occurred “at the rose garden” event, for which he paid licensing fees to Opposer.³⁰ Though some sales may have taken place later, the total number of DEFORD BAILEY harmonicas sold by Carlos Bailey totaled either 15 or no more than 22.³¹

²⁵ *Id.* at 124-128, 147-150.

²⁶ *Id.* at 143-144.

²⁷ *Id.* at 120-121, 123.

²⁸ *Id.* at 128.

²⁹ *Id.* at 207.

³⁰ *Id.* at 207.

³¹ *Id.* at 209 (“15 in all”); *Id.* at 230 (“Probably 20 or 22”).

He sold no other products under the applied-for mark.³² DeFord Bailey, III never sold any harmonicas.³³

III. Analysis

The factual record clearly shows that the applied-for mark refers to DeFord Bailey, Sr. In addition to the admissions by Applicants in their testimony, the file record of the Application includes the following statements by Applicants that “DEFORD BAILEY” does not identify a living individual, but an individual who is now deceased. DeFord Bailey was a master of the harmonica. He was an American country music star from the 1920’s until 1941, and the first performer on the Grand Old Opry.”³⁴ Applicants trace any claimed interest in the name DEFORD BAILEY used on harmonicas through their father, DeFord Bailey, Jr. based on his status as an heir of DeFord Bailey, Sr.³⁵ However, Applicants’ father, DeFord Bailey, Jr., appears to have unequivocally intended to assign his rights to Opposer, as indicated by his Intellectual Property Assignment, the LLC Operating Agreement he signed, and his Last Will and Testament.

Moreover, Applicant Carlos Bailey signed a “Name and Likeness Licensing Agreement” conceding that he does “not have any right, title or interest in or to” the name DeFord Bailey and the associated goodwill.³⁶ In his testimony, he implied a

³² *Id.* at 208.

³³ *Id.* at 136.

³⁴ February 1, 2012 Response to Office action at 3.

³⁵ 29 TTABVUE at 110, 118-119.

³⁶ 29 TTABVUE at 298.

desire to avoid being bound by the terms of this contract because he claimed not to have read it before signing it and had a misimpression as to its duration. However, he clearly admitted to signing it, reading at least some of the terms, and paying license fees under it.³⁷ See *Lutz Superdyne, Inc. v. Arthur Brown & Bro., Inc.*, 221 USPQ 354, 362 (TTAB 1984) (noting that it generally is appropriate to honor an agreement between parties as to the question of ownership of a trademark); *Weber Tackle Co. v. Del Mar Tackle Co.*, 179 USPQ 250, 253 (TTAB 1973) (actions recognizing another's rights in a mark weigh against a claim of ownership). We therefore deem it appropriate to hold him bound by his clear contractual representation that he claims no right, title or interest in the applied-for mark. Therefore, he cannot properly claim ownership of the applied-for mark.

Turning to Applicant DeFord Bailey, III, his representations about the Application and the applied-for mark remain contradictory and muddled. The record includes documents signed by him stating that he was unaware of the Application at issue and had not authorized its filing.³⁸ He then gave conflicting testimony about whether he signed those documents.³⁹ After initial repeated denials, he ultimately admitted that he did sign them⁴⁰ but claimed that he may have done so only because of a request by his father.⁴¹ As to the Application itself,

³⁷ *Id.* at 203, 298-300.

³⁸ 29 TTABVUE at 310, 312.

³⁹ *Id.* at 124-128, 143-144, 147-150.

⁴⁰ *Id.* at 144.

⁴¹ *Id.* at 149.

the file record shows that it was filed electronically, and contained electronic signatures using the method of names appearing in between forward slashes. The signatures on the Application by Mr. Benjamin, Carlos Bailey, and DeFord Bailey, III are required to have been “[p]ersonally enter[ed]” in accordance with Trademark Rule 2.193(c)(1). 37 C.F.R. § 2.193(c)(1). DeFord Bailey, III offered testimony casting doubt as to whether he actually signed the Application, whether he authorized its filing in advance, and if so, whether he knew and understood what he was signing.⁴² He testified that he never met the attorney who filed the trademark application until the testimony deposition and stated twice that his first phone conversation with the attorney took place after the Application was filed.⁴³ DeFord Bailey, III responded to a question about how he authorized Mr. Benjamin to file the Application by stating “By being DeFord Bailey and I had signed off – somebody said I signed off, which I didn’t realize I had signed off on.”⁴⁴ Overall, we find that DeFord Bailey, III’s testimony regarding the Application and the applied-for mark lacks reliability, reflects that he made no use of the applied-for mark in connection with the use-based Application or otherwise,⁴⁵ shows that he relies only on the use by Carlos to support rights in the applied-for mark, and ultimately fails to support his joint ownership of the applied-for mark. Based on his testimony, coupled with the documentary evidence in which, after the filing of the Application, he disavowed

⁴² *Id.* at 119-129.

⁴³ *Id.* at 120-121.

⁴⁴ *Id.* at 121-122.

⁴⁵ *Id.* at 136.

any knowledge of it or involvement in it, we conclude that DeFord Bailey, III cannot properly claim ownership of the applied-for mark.

In sum, neither Carlos Bailey nor DeFord Bailey, III can claim ownership of the mark DEFORD BAILEY. In view of our determination to sustain the opposition on the ownership claim, we need not reach the merits of Opposer's claims of likelihood of confusion and false suggestion of a connection. *See Starbucks U.S. Brands, LLC v. Ruben*, 78 USPQ2d 1741, 1755 (TTAB 2006); *American Paging, Inc. v. American Mobilphone, Inc.*, 13 USPQ2d 2036, 2040 (TTAB 1989), *aff'd* without opinion, 17 USPQ2d 1726 (Fed. Cir. 1990).

Decision: The opposition is sustained and registration to Applicants is refused.