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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91241413
Party	Plaintiff B.A.C.A. International, Inc.
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Attachments	Opposer_s Motion to Amend Notice of Opposition Opp. No. 91241413.pdf(360090 bytes)

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

B.A.C.A. INTERNATIONAL, INC., a Utah
nonprofit corporation,

Opposer,

v.

KEEPERS OF THE CHILDREN, a
Colorado nonprofit corporation,

Applicant.

Opposition No. 91241413

Application No. 87723497

MOTION TO AMEND NOTICE OF OPPOSITION

Pursuant to Federal Rule of Civil Procedure 15(a)(2), 37 C.F.R. § 2.107(a), and TMPB §§ 507.01 and 527.07(a), Opposer moves the Board for leave to amend Opposer's Notice of Opposition to assert as an additional basis for denial of the Application that the Application was not filed in the name of the owner of the mark sought to be registered, as required by Sections 1(a)(1) and 3 of the Trademark Act, 15 U.S.C. §§ 1051(a)(1) and 1053, 37 C.F.R. §2.71(d), and TMEP 803.01, and that the Application is therefore void as a matter of law and cannot be cured or revived by amendment. Opposer is simultaneously filing a motion for summary judgment on this basis. *See* TBMP § 528.07(a) ("Generally, a party that seeks summary judgment on an unpleaded issue may simultaneously move to amend its pleading to assert the matter.")

STATEMENT OF FACTS

1. On May 29, 2018, Opposer B.A.C.A. International, Inc. filed a Notice of Opposition, and the Board instituted this proceeding [ttabvue-91241413-OPP-1; ttabvue-91241413-OPP-2.]
2. On July 6, 2018, Applicant Keepers of the Children, a Colorado corporation, filed its Answer to Notice of Opposition. [ttabvue-91241413-OPP-4.]

3. The service mark application at issue in this proceeding, U.S. Application Serial Number 87723497 (the “Application”), was filed on December 16, 2017, by and on behalf of Applicant Keepers of the Children, a Colorado corporation. [Combined Individual Deposition of Robert C. Henson and Rule 30(b)(6) Deposition of Applicant Keepers of the Children (“Henson Dep.”), excerpts and certain exhibits of which are attached as Exhibit A to Opposer’s Motion for Summary Judgment (ttabvue-91241413-OPP-10), at 226:3-17 and Dep. Ex. 36.]

4. The Application seeks to register the mark Keepers of the Children (the “Mark”) in standard characters for “[p]romoting public awareness of the need for advocacy and support for victims of child abuse,” in International Class 35. *Id.*

5. The Application lists Applicant as the owner of the Mark. *Id.*

6. On February 20, 2019, Opposer took the combined individual discovery deposition Robert C. Henson (“Henson”) and Rule 30(b)(6) discovery deposition of Applicant, in which Henson testified on behalf of himself and Applicant that he, not Applicant, is the owner of the Mark that is the subject of the Application. [Henson Dep., at 135:4-20 and 226:2 - 227:19, and Dep. Exs. 4 and 36.]

7. Henson also testified that he and Applicant are parties to a Trademark License Agreement dated September 20, 2018, in which Henson is identified as the “Licensor,” Applicant is identified as the “Licensee,” and the recitals stated, among other things, that Henson desired to grant to Applicant, and Applicant desired to receive from Henson, “an exclusive, royalty free and revocable license to use the [Keepers of the Children] Mark in connection with promoting public awareness of the need for advocacy and support for victims of child abuse and related uses (the ‘Goods and Services’);” and that “this Agreement formalizes an unwritten understanding between the parties regarding Licensee’s use of the Mark in connection with the Goods and Services entered into on December 12, 2017 (the ‘Effective Date’).” [Henson Dep., at 167:15 - 169:24 and Dep. Ex. 23.]

8. Section 1 of the Trademark License Agreement states: “Grant of License. Subject to the provisions of this Agreement and for the consideration of ten dollars (\$10.00), the receipt of which is hereby acknowledged, Licensor [Henson] agrees to grant Licensee [Applicant] an exclusive, royalty free and revocable license to use the Mark in connection with the Goods and Services for the Term of this Agreement.” [Dep. Ex. 23 to Henson Dep., at p. 1.]

9. Section 5 of the Trademark License Agreement states: “Licensor Ownership. Licensee [Applicant] acknowledges that Licensor [Henson] is the owner of all rights, title and interest in and to the Mark. Licensee [Applicant] agrees that it shall do nothing inconsistent with such ownership and that all use of the Mark by Licensee [Applicant] shall inure to the benefit of, and on behalf of, Licensor [Henson]. Licensee [Applicant] further agrees not to attack the validity of the Mark or this Agreement.” [Dep. Ex. 23 to Henson Dep., at p. 5.]

10. Opposer has filing simultaneously with this Motion to Amend Notice of Opposition Opposer’s Motion for Summary Judgment. [ttabvue-91241413-OPP-10.] As shown in Opposer’s Motion for Summary Judgment, the Application at issue in this proceeding is void *ab initio* because it was not filed in the name of the owner of the Mark. *See id.*

ARGUMENT

“[T]he Board liberally grants leave to amend pleadings at any stage of a proceeding when justice so requires, unless entry of the proposed amendment would violate settled law or be prejudicial to the rights of the adverse party or parties. . . . This is so even when a plaintiff seeks to amend its complaint to plead a claim other than those stated in the original complaint,” TBMP § 507.02; *accord* Fed. R. Civ. P. 15(a) (a motion to amend should be “freely” granted “when justice so requires”); *Embarcadero Technologies, Inc. v. Delphix Corp.*, 117 U.S.P.Q.2d 1518, 1523 (TTAB 2016) (“Trademark Rule 2.115, 37 C.F.R. § 2.115, and Fed. R. Civ. P. 15(a) encourage the

CERTIFICATE OF SERVICE

I hereby certify that, on March 14, 2019, I caused a true and correct copy of the foregoing

OPPOSER’S MOTION TO AMEND NOTICE OF OPPOSITION to be served by e-mail on:

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/s/Gregory M. Hess _____

EXHIBIT A

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

B.A.C.A. INTERNATIONAL, INC.,

Opposer,

v.

KEEPERS OF THE CHILDREN,

Applicant.

Opposition No. 91241413

AMENDED
NOTICE OF OPPOSITION

B.A.C.A. International, Inc. (“Opposer”), a charitable corporation organized and existing under the laws of the State of Utah with its principal place of business at 51 West Center St., No. 144, Orem, UT 84057, believes it will be damaged by registration on the Principal Register of the mark shown in Application Serial No. 87723497 and hereby opposes registration of the above-identified application on the following grounds:

1. Opposer is a charitable corporation dedicated to fighting child abuse. At The present time, Opposer has chapters in 47 states (including in Colorado where Applicant was formed) and several other countries (mostly in Europe), and has temporary chapters and forming efforts in several other places.

2. Opposer is now and for many years has been engaged in the promotion, advertising and distribution of services, including (among other services) the services of promoting public awareness of the need for preventing and addressing the physical, sexual and emotional abuse of children and providing support to victims of such abuse,

as well as promoting public awareness of the need for advocacy and support for victims of child abuse ("Opposer's Services").

3. Opposer uses various trademarks and service marks in executing and further developing its mission. At least as early as September 1997, Opposer adopted the KEEPERS OF THE CHILDREN mark and began to use that mark to advertise Opposer's Services, including Opposer's Services of promoting public awareness of the need for advocacy and support for victims of child abuse. Opposer also began use of the KEEPERS OF THE CHILDREN mark on various goods that are now and have continuously been used since at least as early as 2005 as a mark to advertise Opposer's Services. Opposer's KEEPERS OF THE CHILDREN mark has attained considerable value and secondary meaning because of Opposer's substantial and exclusive use of that term over the last many years.

4. Opposer and its chapters and members have committed significant time, effort, and financial resources toward developing and maintaining a reputation for excellence in accomplishing Opposer's mission of helping abused children. Opposer has extensively advertised and caused to be advertised throughout the United States and abroad its marks, including its KEEPERS OF THE CHILDREN mark, to identify its services.

5. Opposer advertises its KEEPERS OF THE CHILDREN services in numerous ways. For example, Opposer and chapters of Opposer (under license) distribute products that bear Opposer's KEEPERS OF THE CHILDREN mark. These items are then used or worn by individual members of Opposer (and others), usually in close association with other marks of Opposer (such as Opposer's registered BIKERS AGAINST CHILD ABUSE and B.A.C.A. marks). Examples of various products and other

advertisements of Opposer's use of the KEEPERS OF THE CHILDREN mark are shown in Exhibit 1, which contains a collection of photographs and art work prepared under Opposer's control and license. As can be seen from the attachments, in many of these uses the KEEPERS OF THE CHILDREN mark is closely associated with one or more of Opposer's other marks, such as B.A.C.A. (see U.S. Service Mark Registration No. 2827542), BIKERS AGAINST CHILD ABUSE (see U.S. Service Mark Registration No. 3771437), and other marks of Opposer.

6. Proper use of Opposer's marks is imperative to Opposer's mission. If Opposer cannot control use of its marks, unsuspecting children may come into contact with, and believe they are safe around, individuals who are not associated with Opposer or have complied with Opposer's quality control standards.

7. Due to these efforts and the widespread use of Opposer's Services by the public, including by law enforcement and social services agencies in the states and countries in which Opposer has chapters, the KEEPERS OF THE CHILDREN mark, together with Opposer's other names, marks, and logos, have become associated in the mind of the public with trustworthy child abuse prevention services and related materials. Opposer has thereby built up, now owns, and is the beneficiary of, valuable goodwill, represented in significant part by its KEEPERS OF THE CHILDREN mark. Opposer's KEEPERS OF THE CHILDREN mark has become famous with respect to Opposer's Services.

8. On December 12, 2017, an individual named Robert C. Henson filed Articles of Incorporation for a Nonprofit Corporation with the Secretary of State of the State of Colorado to form a corporation with the corporate name of Keepers of the Children. That corporation is the Applicant in Application Serial No. 87723497, the application that is the

subject of this Notice of Opposition. Later that same day, Mr. Henson filed a Statement of Correction Correcting the Principal Office Address of Applicant with the Colorado Secretary of State. Until November 2017, Mr. Henson was a long-standing member of Opposer. As such, when filing the corporate formation documents, Mr. Henson was familiar with Opposer's KEEPERS OF THE CHILDREN mark and with Opposer's Services.

9. On December 16, 2017, Applicant filed Application Serial No. 87723497 (the "Application"), which is the subject of this Notice of Opposition, and the Application was signed by Mr. David Sands, Applicant's President. The Application seeks to register the mark Keepers of the Children in standard characters for "[p]romoting public awareness of the need for advocacy and support for victims of child abuse," in International Class 35. The Application lists Applicant as the owner of the mark.

10. Contrary to what is stated in the Application, Applicant is not the owner of the Keepers of the Children mark. Applicant and its Vice President, Mr. Henson, both maintain that Mr. Henson, not Applicant, is the owner of the Keepers of the Children mark.

11. In addition, Applicant and Mr. Henson are parties to a written Trademark License Agreement dated September 20, 2018 (the "Trademark License Agreement"), in which Mr. Henson is identified as the "Licensor," Applicant is identified as the "Licensee," and the recitals stated, among other things, that Mr. Henson desired to grant to Applicant, and Applicant desired to receive from Mr. Henson, "an exclusive, royalty free and revocable license to use the [Keepers of the Children] Mark in connection with promoting public awareness of the need for advocacy and support for victims of child abuse and related uses (the 'Goods and Services');" and that "this Agreement formalizes an unwritten

understanding between the parties regarding Licensee's use of the Mark in connection with the Goods and Services entered into on December 12, 2017 (the 'Effective Date')."

12. Section 1 of the Trademark License Agreement states: "Grant of License. Subject to the provisions of this Agreement and for the consideration of ten dollars (\$10.00), the receipt of which is hereby acknowledged, Licensor [Mr. Henson] agrees to grant Licensee [Applicant] an exclusive, royalty free and revocable license to use the Mark in connection with the Goods and Services for the Term of this Agreement."

13. Section 5 of the Trademark License Agreement states: "Licensor Ownership. Licensee [Applicant] acknowledges that Licensor [Mr. Henson] is the owner of all rights, title and interest in and to the Mark. Licensee [Applicant] agrees that it shall do nothing inconsistent with such ownership and that all use of the Mark by Licensee [Applicant] shall inure to the benefit of, and on behalf of, Licensor [Mr. Henson]. Licensee [Applicant] further agrees not to attack the validity of the Mark or this Agreement."

14. The Application is therefore void ab initio and should be refused under Sections 1(a)(1) and 3 of the Trademark Act, 15 U.S.C. §§ 1051(a)(1) and 1053, and under 37 C.F.R. § 2.71(d) and TMEP § 803.01, because the Application was not filed in the name of the owner of the Keepers of the Children mark, whether the mark is owned by Mr. Henson, as he and Applicant claim, or the mark is owned by Opposer.

15. Opposer has been using the KEEPERS OF THE CHILDREN mark since well prior to the filing date of Applicant's Certificate Of Incorporation, since well prior to any use by Applicant of the "Keepers of the Children" term, and also since well prior to the date on which Applicant filed Application Serial No. 87723497. As a result, as between Opposer's mark and Mr. Henson's alleged mark, Opposer's mark has priority.

16. Mr. Henson's alleged Keepers of the Children mark sought to be registered by Applicant is identical to Opposer's KEEPERS OF THE CHILDREN mark in spelling and in common pronunciation. The services for which Applicant is licensed by Mr. Henson to use the Keepers of the Children mark, as recited in the Trademark License Agreement and in Application Serial No. 87723497, are substantially similar to, if not identical to, at least some of Opposer's Services. Members of the public recognize Opposer as the supplier of Opposer's Services in connection with the KEEPERS OF THE CHILDREN mark. Such individuals would likely assume that Applicant's services offered in association with the term "Keepers of the Children" originated with Opposer.

17. Opposer has built a valuable goodwill in the KEEPERS OF THE CHILDREN mark used in connection with Opposer's Services. If Applicant is permitted to register and use the term KEEPERS OF THE CHILDREN in connection with the services set forth in Application Serial No. 87723497, confusion would likely result. Members of the public familiar with Opposer's Services offered under the KEEPERS OF THE CHILDREN mark would believe that Applicant's services offered under the "Keepers of the Children" term are, contrary to fact, associated with, endorsed by, or in some way related to Opposer, or actually are the services of Opposer. Any fault or defect in connection with services offered by Applicant would reflect upon and seriously injure the reputation that has been established for Opposer's Services. Moreover, consumers and members of the public who are familiar with Opposer's KEEPERS OF THE CHILDREN mark would confuse Applicant's use of the "Keepers of the Children" term with services being offered by Opposer, and might seek to use or obtain Applicant's services in the belief that they are

using or obtaining Opposer's Services. This confusion would result in a loss of opportunity for Opposer to provide services, and would damage Opposer's reputation.

18. Opposer's use of the KEEPERS OF THE CHILDREN mark in the United States continuously since prior to any use by Applicant (indeed, since prior to the existence of Applicant) creates common law rights in Opposer, which rights are superior to any rights of Applicant in the "Keepers of the Children" term.

19. Mr. Sands was formerly a member of Opposer. On information and belief, at the time of filing Application Serial No. 87723497, Mr. Sands knew of Opposer's longstanding use of the KEEPERS OF THE CHILDREN mark for Opposer's Services. On information and belief, when Mr. Sands filed that application, he was required to assert under 18 U.S.C. § 1001 that "To the best of signatory's knowledge and belief, no other persons, except, if applicable, concurrent users, have the right to use the mark in commerce, either in the identical form or in such near resemblance as to be likely, when used on or in connection with the goods/serves of such other persons, to cause confusion or mistake, or to deceive." Because of Mr. Sands's prior knowledge of Opposer's superior rights to use the mark KEEPERS OF THE CHILDREN for Opposer's Services, Mr. Sands's assertions made when filing Application Serial No. 87723497 were false and were made in violation of 18 U.S.C. § 1001. The present application is therefore void or invalid ab initio.

20. Applicant is not now and never was entitled to registration on the Principal Register of the alleged mark depicted in Application Serial No. 87723497 for the services specified therein.

21. Applicant's services are related to (or even identical to) Opposer's Services and the "Keepers of the Children" term is confusingly similar to Opposer's KEEPERS OF THE

CHILDREN mark. The “Keepers of the Children” term, when used in association with Applicant's services, is likely to cause confusion, mistake or deception with Opposer's Services offered under an identical mark. Thus, registration of the “Keepers of the Children” term by Applicant is also precluded under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d). Moreover, registration by Applicant of the “Keepers of the Children” term would create rights inconsistent with Opposer's right to use its KEEPERS OF THE CHILDREN mark.

22. If Applicant is granted the registration herein opposed, Applicant would have prima facie exclusive rights to Applicant's “Keepers of the Children” term and all confusingly similar marks, thus placing Applicant in a position to harass, annoy, damage and injure Opposer and recipients of Opposer's Services.

23. Opposer would be therefore damaged by registration of the mark shown in Applicant's Application Serial No. 87723497.

WHEREFORE, Opposer requests that registration of the “Keepers of the Children” term, as depicted in Application Serial No. 87723497, be denied and that this Opposition be sustained.

Dated: March 14, 2019.

Respectfully submitted,

/Gregory M. Hess/
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