

THIS OPINION IS NOT A
PRECEDENT OF THE TTAB

Hearing: Aug. 9, 2023

Mailed: January 31, 2024

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board
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Billy Stott
v.
Split Decision Music, LLC
—

Opposition No. 91249613
—

Glenn C. Romano, of the Law Office of Glenn C. Romano, Esquire,
for Billy Stott.

Carrie Ward of Earp Cohn, PC,
for Split Decision Music, LLC.

—
Before Shaw, Greenbaum, and Heasley, Administrative Trademark Judges.

Opinion by Heasley, Administrative Trademark Judge:

Applicant Split Decision Music, LLC seeks registration on the Principal Register of the mark SPLIT DECISION (in standard characters) for “entertainment services in the nature of live visual and audio performances, namely, musical rock band,” in International Class 41.¹

Opposer Billy Stott alleges in his Notice of Opposition that he, not Applicant, owns the SPLIT DECISION mark for the services of managing, promoting, and booking a

¹ Application Serial No. 88181842 was filed on Nov. 5, 2018, under Section 1(a) of the Trademark Act, 15 U.S.C. § 1051(a), based on Applicant’s claim of first use anywhere as of January 1, 1994 and use in commerce since at least as early as August 1, 2001.

musical act; that issuing a registration to Applicant is likely to create confusion under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d); and that Applicant committed fraud on the USPTO by applying to register his mark.² Applicant's Answer denies the salient allegations of the Notice of Opposition.³ Both parties' counsel submitted briefs and appeared at an oral hearing.

For the reasons that follow, we find that Applicant Split Decision Music, LLC owns the service mark SPLIT DECISION, and that Opposer Billy Stott has failed to prove that he owns any prior right in the term. We accordingly dismiss the opposition.

I. The Record

We have reviewed the entire record, which includes the following:

- The pleadings and, by operation of Trademark Rule 2.122(b), 37 C.F.R. § 2.122(b), Applicant's application file.

Opposer

- Applicant's application documents (20 TTABVUE 6);⁴
- Deposition of Douglas Moore, Oct. 13, 2020 (20 TTABVUE 50, 48 TTABVUE 5) with exhibits (21 TTABVUE);
- Declaration of Christian Zajac (22 TTABVUE);
- Declaration of Opposer, Billy Stott (25 TTABVUE);

² Notice of Opposition, 1 TTABVUE.

³ The Answer raises seven purported affirmative defenses. 8 TTABVUE 5-6. The first, alleging that the Notice of Opposition fails to state a claim upon which relief can be granted, is not an affirmative defense. *Shenzhen IVPS Tech. Co. Ltd. v. Fancy Pants Prods., LLC*, 2022 USPQ2d 1035, *3 n.5 (TTAB 2022). The second through sixth, raising the equitable defenses of laches, estoppel, waiver, acquiescence, and unclean hands, were not pursued in Applicant's brief and are thereby forfeited or impliedly waived. *CBC Mortgage Agency v. TMRR, LLC*, 2022 USPQ2d 748, *3 (TTAB 2022); *TiVo Brands LLC v. Tivoli, LLC*, 129 USPQ2d 1097, 1100-01 (TTAB 2019). And the seventh, alleging that any and all acts alleged to have been committed by Applicant were performed "with lack of knowledge and lack of willful intent," merely amplifies Applicant's denials. See *Topco Holdings, Inc. v. Hand 2 Hand Indus., LLC*, 2022 USPQ2d 54, *11 (TTAB 2022).

⁴ Introducing the file history for the involved Application was unnecessary, as that is automatically of record. Trademark Rule 2.122(b)(1), 37 C.F.R. § 2.122(b)(1). *ARSA Distrib., Inc. v. Salud Natural Mexicana S.A. de C.V.*, 2022 USPQ2d 887, *10 n.25 (TTAB 2022).

- Declaration of Philip Valentino (20 TTABVUE).

Applicant

- Deposition of Philip Valentino (29 TTABVUE);
- Deposition of Christian Zajac (29 TTABVUE 79);
- Deposition of Billy Stott, May 7, 2021 (30 TTABVUE);
- Deposition of Billy Stott, Oct. 30, 2020 (31 TTABVUE);
- Deposition of Doreen Stott (31 TTABVUE 6);
- Declaration of Mark Kirkner (33 TTABVUE);
- Declaration of Jimmy Abgarian (34 TTABVUE);
- Declaration of Jimmy Masiak (35 TTABVUE);
- Declaration of William Sirois (36 TTABVUE);
- Declaration of Thomas King (37 TTABVUE);
- Declaration of Mike Birchard (38 TTABVUE);
- Declaration of Jason Thomas (39 TTABVUE);
- Declaration of Douglas Moore (40 TTABVUE);
- Deposition of Billy Stott, Sept. 16, 2021 (52 TTABVUE 80);
- Deposition of Scott Kinka (53 TTABVUE 11).

Opposer Rebuttal

- Deposition of Douglas Moore, Oct. 13, 2020 (48 TTABVUE 5);
- Deposition of Raymond Pierson (48 TTABVUE 134);
- Deposition of Michael Birchard (48 TTABVUE 182);
- Deposition of Jason Thomas (48 TTABVUE 240);
- Deposition of Thomas King (48 TTABVUE 273);
- Declaration of Billy Stott (49 TTABVUE);
- Declaration of Scott Kinka (50 TTABVUE);
- Cross-examination deposition of Douglas Moore, Aug. 10 & Sept. 29, 2021 (54-55 TTABVUE);
- Cross-examination deposition of Jimmy Abgarian, July 15, 2021 (56 TTABVUE);
- Cross-examination deposition of Michael Birchard, July 14, 2021 (57 TTABVUE);
- Cross-examination deposition of Thomas King, July 22, 2021 (58 TTABVUE);
- Cross-examination deposition of Jimmy Masiak, Sept. 30, 2021 (60 TTABVUE);
- Cross-examination deposition of Raymond Pierson, July 14, 2021 (61 TTABVUE);
- Cross-examination deposition of William Sirois, Sept. 30, 2021, (62 TTABVUE);
- Cross-examination deposition of Jason Thomas, July 15, 2021 (63 TTABVUE).

II. Background

Split Decision is a cover band—a band that plays songs previously recorded by other performers.⁵ It originated as a part-time, two-member band in Philadelphia in 1990 and became over time a five-member, full-time band that now performs in clubs and casinos, as well as at weddings, private parties, and corporate events, up and down the east coast of the United States.⁶

The band's name originated in 1990 when its two members, Christian Zajac (on guitar) and Scott Kinka (on keyboard), chose the name SPLIT DECISION for their band and performed under that name in “about two paying gigs per month at small bars in the Philadelphia area and earning about \$200.00 as a band per gig,” according to Zajac.⁷ That same year, the SPLIT DECISION band added three other members on drums, bass guitar, and saxophone.⁸

Split Decision's drummer knew Mr. Stott (who owned, managed, and played in another local band, The Rockets) and, with the two founding members' approval, asked Mr. Stott to hear the SPLIT DECISION band and, hopefully, agree to manage

⁵ Merriam-Webster.com 1/25/2024. “The Board may take judicial notice of dictionary definitions, including online dictionaries that exist in printed form or regular fixed editions. *Univ. of Notre Dame du Lac v. J.C. Gourmet Food Imps. Co.*, 213 USPQ 594 (TTAB 1982), *aff'd*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983); *In re Red Bull GmbH*, 78 USPQ2d 1375, 1377 (TTAB 2006).” *See also M/S R.M. Dhariwal (HUF) 100% EOU v. Zarda King Ltd. and Global Tech. & Trade Marks Ltd.*, 2019 USPQ2d 149090, *1 n.2 (TTAB 2019).

⁶ Jason Thomas decl. ¶ 10, 39 TTABVUE 3; William Sirois cross-examination dep. 11:13-17, 62 TTABVUE 14.

⁷ Christian Zajac decl. ¶¶ 1-3, 5, 22 TTABVUE 3; Zajac dep., 14:2-20, 29 TTABVUE 79. *See also* Scott Kinka rebuttal decl. ¶¶ 1-2, 4, 50 TTABVUE 2-3; Kinka cross-examination dep., 10:16-19, 53 TTABVUE 20.

⁸ Zajac decl. ¶ 2, 22 TTABVUE 2-3; Kinka rebuttal decl. ¶ 2, 50 TTABVUE 2.

it.⁹ Mr. Stott operated a sole proprietorship called Billy Stott productions, and somewhat later, another called Starfield Entertainment, through which he provided booking and management services.¹⁰

Mr. Stott acknowledges that prior to his association with the group, the two founding members, Messrs. Zajac and Kinka, created the band name SPLIT DECISION, performed under that name about twice a month, for about \$200 per performance, and recruited the three other band members.¹¹ In 1991, Mr. Stott conferred with the band members about whether to change the band's name, but he and the band members decided to retain the name SPLIT DECISION, as it was already in use and had garnered name recognition.¹² This much is fairly undisputed.

What the parties dispute is the extent of Mr. Stott's involvement in the band's operations from 1991 until they parted ways in 2018. The parties' views on this subject diverge sharply—Mr. Stott's tending toward self-aggrandizement and the band's trending toward self-determination. Their testimony, moreover, ranges from broad assertions in declarations (drafted with the assistance of counsel) to more

⁹ Kinka rebuttal decl. ¶6, 50 TTABVUE 3

¹⁰ Billy Stott decl. ¶¶ 1, 52, 25 TTABVUE 2, 10; Stott rebuttal decl. ¶ 1, 49 TTABVUE 2.

¹¹ Stott decl. ¶¶ 7, 8, 28, 25 TTABVUE 3, 7; Stott dep. 12:9-11, 31 TTABVUE 194, 71:4-6, 31 TTABVUE 253; Stott cross-examination dep. 14:11-18, 15:14-18, 52 TTABVUE 93-94. When a party claims a date earlier than the date it alleged when it filed its application, that is considered a change in position, contrary to the admission it made against interest at the time it filed the application; in these circumstances, its proof of the earlier date must be clear and convincing. *JNF LLC v. Harwood Int'l. Inc.*, 2022 USPQ2d 862, *9 (TTAB 2022). In this case, though, even though the Application claims later dates of first use and use in commerce, the parties agree, and do not dispute, that Zajac and Kinka began performing as SPLIT DECISION in 1990.

¹² Kinka cross-examination dep. 24:6-15, 35:13-36:18, 53 TTABVUE 34, 45-46, 48; Zajac decl. ¶¶ 12-14, 22 TTABVUE 4, Zajac dep. 32:3-14, 29 TTABVUE 97, Stott decl. ¶¶ 22-24, 51, 25 TTABVUE 5-6, 10.

qualified positions in depositions (where they were subject to questioning by opposing counsel). In the following section, we summarize that testimony. In so doing, we omit conclusory assertions of mark ownership, as that is the matter we must determine in the end, based on the weight of the evidence, not at the beginning, based on witnesses' assumptions. *See Interstate Brands Corp. v. Celestial Seasonings, Inc.*, 576 F.2d 926, 198 USPQ 151, 153 (CCPA 1978) (the Board, not a witness, must reach its own ultimate conclusion based on the entire record).

As Mr. Stott portrays it, when he met with the band in early 1991:

I said that I was not interested in getting them into a club or being a booking agent, I was not interested in being an outsider, that in order for them to achieve the success they wanted and what was comparable to what the Rockets had achieved, that would not merely be the manager for Split Decision, but that I required that I become a full and, non-performing member of Split Decision, that I must have complete artistic and creative control, including primary control over who was to be a musician in Split Decision and that Split Decision was from this point my band.¹³

I made it clear in 1991, when I joined Split Decision, that I owned Split Decision. I was to have complete artistic and creative control and own all intellectual property including the Split Decision band name. All of the then current band members acknowledged this. I also made this clear to all subsequent band members when I hired them.¹⁴

They all agreed and in early 1991, I became a member, manager and owner of Split Decision. I received a commission of 15% for my services as manager, producer and promoter of Split Decision.¹⁵

I had complete artistic and creative control of Split Decision.¹⁶

I also had complete control over band membership. I decided who had to

¹³ Stott decl. ¶ 12, 25 TTABVUE 4; *see also* Stott rebuttal decl. ¶ 5, 49 TTABVUE 3.

¹⁴ Stott decl. ¶ 74, 25 TTABVUE 15; *see also* Stott rebuttal decl. ¶ 49, 49 TTABVUE 12.

¹⁵ Stott decl. ¶ 13, 25 TTABVUE 4.

¹⁶ Stott decl. ¶ 15, 25 TTABVUE 4.

leave and had the final decision on who would become a band member.¹⁷

I had total control over which songs the members of Split Decision would perform.¹⁸

I was responsible for creating a “brand” around the Split Decision trademark through various promotional and marketing efforts, and in developing and producing the look and sound of the band.¹⁹

At deposition, he was asked how he claimed to have acquired ownership of the SPLIT DECISION brand:

Q. But there was no assignment of the trademark Split Decision from Christian Zajac to Billy Stott?

A. A legal paper?

Q. Correct.

A. No.²⁰

...

Q. Now you claimed you owned the name. How did you receive ownership of the name Split Decision?

A. Well, from the beginning I said I was unwilling to be an outsider, I needed to be a member of the band, a primary member of the band, and that’s what I would be from start to finish because of my knowledge and investment of time.²¹

Asked to explain his claimed status as a “full, non-performing primary band member,” and to explain how this differed from other roles, such as a manager, he testified in a rambling, discursive manner about how he helped the band members

¹⁷ Stott decl. ¶ 16, 25 TTABVUE 5.

¹⁸ Stott decl. ¶ 18, 25 TTABVUE 5.

¹⁹ Stott decl. ¶ 51, 25 TTABVUE 10; *see also* Stott rebuttal decl. ¶ 4, 49 TTABVUE 3.

²⁰ Stott dep. 72:7-12, 31 TTABVUE 254.

²¹ Stott dep. 71:16-22, 31 TTABVUE 253.

reach their goals of improving their performances and their success at venues.²²

At length he was asked to specify the services he provided to the band:

Q. ... So what specific services did you provide to meet these goals?

A. First, I had to address the personnel musically, primarily, and several guys I had to let go. I additionally auditioned and it became an eight- piece band in the basement. Arranged music, selected the songs, developed an image based on who they naturally were.²³

Ultimately, he was asked about his role:

Q. So you can't really distinguish between a band manager and a full, non-performing, primary band member?

A. They're both one in the same²⁴

As for personnel decisions:

Q. Was the decisions on personnel a mutual decision or was it your final decision?

A. There was mutual input. And in a band, the personalities and chemistry and a potential new member and his personality or maybe track record was all discussed, and then I would make the decision in the best interest of the band -- or the brand.

Q. So it wasn't a team decision; is that correct?

A. Ultimately a logical, it was a mutual decision, but I didn't say let's

²² Stott cross-examination dep. 35:1-39:24, 52 TTABVUE 114-18.

²³ Stott dep. 13:14-21, 31 TTABVUE 195.

²⁴ Stott cross-examination dep. 40:14-19, 52 TTABVUE 119.

raise a hand over it. I don't know.²⁵

Asked why he received a commission, like a booking agent, not a band member or owner, he answered, simply, “[b]ecause that’s the way I was compensated,” after allowing for certain expenses.²⁶

The two original band members, Christian Zajac and Scott Kinka, agree that Mr. Stott, “as the primary member of Split Decision since 1991,”²⁷ made significant contributions to the band’s development, promotion, and popularity in the early part of that decade. According to Mr. Kinka:

Billy was extremely hands-on with the development of the brand “Split Decision”. Billy Stott trained us how to work crowds and to develop a fan base. He showed us how to work crowds by getting names and addresses for our mailing lists. We would then send out gig dates on mailing list cards. He also had posters made, scheduled band shots with photographers and produced a promotional band video for both clubs and weddings.²⁸

As Mr. Kinka later testified, though, these contributions were more in the nature of a manager: “An agent books you. A manager assists you in, in the development of the product.”²⁹ He further testified that the name SPLIT DECISION was already created prior to Mr. Stott’s association with the band, and that there was no agreement, written or otherwise, with Mr. Stott regarding ownership of the band’s name:

Q. Did, did you agree that Billy should own the name?

²⁵ Stott cross-examination dep. 112:4-18, 52 TTABVUE 191.

²⁶ Stott dep. 20:15-17; 30 TTABVUE 23.

²⁷ Zajac decl. ¶ 30, 22 TTABVUE 6.

²⁸ Kinka decl. ¶ 18, 53 TTABVUE 6-7; *see also* Kinka decl. ¶ 10, 53 TTABVUE 5, Kinka cross-examination dep. TTABVUE 23, 27, 37-40.

²⁹ Kinka cross-examination dep. 31:10-11, 53 TTABVUE 41.

A. I didn't -- I, I agreed that it was the name of the band, and I agreed that, I would, to be frank, it would not have even occurred to me that a name would have an owner because the name was attached to the band.³⁰

According to the other original band member, Mr. Zajac, "Split Decision never would have made it out of my grandmother's basement [where the band rehearsed] without him."³¹ But he acknowledged:

Q. Was Mr. Stott ever your employer?

A. No.³²

The band's founding members, Zajac and Kinka, left the SPLIT DECISION band in 1994 and 1998, respectively.³³ During their tenures, dozens of different members joined and left the band.³⁴ The two original members were present at the new band members' auditions, and had input about the replacements.³⁵

Mr. Stott estimates that "Split Decision has had approximately thirty different band members over the years."³⁶ As the band evolved and matured in the late 1990's, his influence and perceived role waned. He was asked:

Q. Did you tell new members joining the band that you were a full and primary, non-performing member of Split

³⁰ Kinka cross-examination dep. 40:1-8, 53 TTABVUE 50. *See also* Kinka cross-examination dep. 53 TTABVUE 28, 79.

³¹ Zajac dep. 29:25-30:3, 29 TTABVUE 94-95.

³² Zajac dep. 18:12-13, 29 TTABVUE 83.

³³ Zajac decl. ¶ 1, 22 TTABVUE 2; Kinka decl. ¶ 1, 53 TTABVUE 4.

³⁴ Zajac decl. ¶ 32, 22 TTABVUE 6-7.

³⁵ Zajac dep. 26:2-7, 29 TTABVUE 91.

³⁶ Stott decl. ¶ 77, 25 TTABVUE 16

Decision?

A. Not in those specific words.

Q. Why not?

A. Quite frankly it was common knowledge prior to that.³⁷

From the late 1990s on, the band members thought and acted otherwise—more independently of Mr. Stott. A member of the band from 1999 through 2005 testified that during his tenure, Mr. Stott did not handle the band’s finances, did not select its songs, did not direct its style of play, and did not select its wardrobe; rather, he testified, Stott was considered the band’s booking agent.³⁸

The five current members of SPLIT DECISION agree with that assessment.

- **Douglas Moore** joined the band in 1997.³⁹ He avers under oath that “Billy Stott did not make the decision to offer me membership into Split Decision. The current band members mutually agreed that I should join the band....”⁴⁰ Doug Moore is now the band leader, by agreement of the band’s five members, not Stott.⁴¹

Moore further avers that:

Since I have been with Split Decision, it has been the band members, and not Billy Stott who was never a band member—never alone “primary band member”, who decided who could be in Split Decision.⁴²

Billy Stott’s role with the band from the time of my audition for Split Decision through his separation with the band in October 2018 was that of a “booking agent” for Split Decision. Billy Stott represented Split Decision

³⁷ Stott cross-examination dep. 41:8-15, 52 TTABVUE 120; *see also* Stott rebuttal decl. ¶ 16, 49 TTABVUE 5.

³⁸ Jimmy Abgarian decl. ¶¶ 2-7, 13-14, 34 TTABVUE 2-3.

³⁹ Moore dep. 48 TTABVUE 28; Moore cross-examination dep. 54 TTABVUE 32.

⁴⁰ Moore decl. ¶ 4, 40 TTABVUE 3

⁴¹ Moore decl. ¶ 17, 40 TTABVUE 6. *See also* Pierson cross-examination dep. 65:14-20, 61 TTABVUE 68, 72.

⁴² Moore decl. ¶ 6, 40 TTABVUE 3.

for bookings through his agencies Starfield Entertainment and Billy Stott Productions.⁴³

Billy Stott has never professionally trained me in music or in business. Since I have been with Split Decision, I have never witnessed Billy Stott provide such personal training to any of the band members of Split Decision.⁴⁴

Since I joined Split Decision in 1997, Billy Stott never had artistic control of the music the band played, the clothing the band wore, or the band's stage show. Members of the band made these determinations and not Billy Stott.⁴⁵

- **Raymond Pierson**, who joined the band in 1998, is of like mind, averring that Mr. Stott just booked gigs for the band; that the terms “manager” and “agent” meant the same thing; that Mr. Stott did not provide input regarding the band's songs; and that he did not provide training. All his responsibility really entailed was picking up the phone, answering the phone, and booking the band.⁴⁶

- **Mike Birchard**, who joined SPLIT DECISION in 2005, avers that:

Billy Stott was not at my audition and did not ask me to join the band.⁴⁷

Since I have been a member of Split Decision, Billy Stott did not recruit band members.⁴⁸

Since I joined the band, Billy Stott was not involved in the day-to-day operations for the Split Decision band.⁴⁹

⁴³ Moore decl. ¶ 5, 40 TTABVUE 3. Moore later explained, “There’s a lot of things you can manage. You can manage the bookings, you can manage the songs, you can manage many things. He managed the bookings and that’s what he did to book the band.” 24:2-5, Moore cross-examination dep. 54 TTABVUE 28.

⁴⁴ Moore decl. ¶ 8, 40 TTABVUE 4.

⁴⁵ Moore decl. ¶ 9, 40 TTABVUE 4.

⁴⁶ Pierson cross-examination dep. 61 TTABVUE 26, 32, 37, 44, 46, 51, 123-25, 143, 170-71.

⁴⁷ Birchard decl. ¶ 3, 38 TTABVUE 2-3.

⁴⁸ Birchard decl. ¶ 13, 38 TTABVUE 3-4.

⁴⁹ Birchard decl. ¶ 4, 38 TTABVUE 3.

Billy Stott was not a member of the band, Split Decision. Billy Stott was the booking agent for Split Decision and paid a commission for his services.⁵⁰

Mr. Birchard's deposition testimony is even more emphatic:

Q. During the time that you were a member of Split Decision who managed the band?

A. We managed ourselves.

Q. So Billy Stott was never a manager of your band?

A. Never.⁵¹

...

Billy never picked songs for Split Decision. Billy had no input on what we did on stage.⁵²

...

A. Billy didn't have any final say in anything we did.⁵³

- **Thomas King**, who joined in 2011, avers that:

Billy Stott had nothing to do with me joining Split Decision. To the contrary, Billy Stott tried to advise the band members against bringing me in, saying it was not a good idea because he did not like how I looked. ... However, the Split Decision band members ignored him because they liked me and the way I played so they asked me to join.⁵⁴

Since I have been a member of Split Decision, the Split Decision band members, and not Billy Stott, decided where the band would play. Doug Moore, the band leader, would contact the other band members through text message to determine if we were available or wanted to play a gig.⁵⁵

Billy Stott was not a member of the band, Split Decision. From the time I joined the band through Billy Stott's departure in 2018, Billy Stott's role with the band was that of a booking agent.⁵⁶

⁵⁰ Birchard decl. ¶ 5, 38 TTABVUE 3.

⁵¹ Birchard dep. 33:17-22, 48 TTABVUE 214

⁵² Birchard cross-examination dep. 35:9-10, 57 TTABVUE 38.

⁵³ Birchard cross-examination dep. 39:4-5, 57 TTABVUE 42

⁵⁴ King decl. ¶ 4, 37 TTABVUE 2-3.

⁵⁵ King decl. ¶ 8, 37 TTABVUE 3.

⁵⁶ King decl. ¶ 3, 37 TTABVUE 2.

At deposition, he added:

Q. ... So have you ever heard of a nonperforming band member?

A. No.⁵⁷

...

A. Billy Stott was not manager when I was there. Billy Stott was the booking agent and he did the booking.⁵⁸

- **Jason Thomas**, the most recent member, originally was in The Rockets, the band owned and operated by Mr. Stott.⁵⁹ When Douglas Moore offered him a position in SPLIT DECISION in 2016, Mr. Stott disapproved of the move.⁶⁰ Stott denies it, but the weight of testimony evinces his strenuous opposition. As Mike Birchard put it, Stott was furious about the band hiring Jason Thomas from the Rockets.⁶¹ And as Douglas Moore testified, “It was apparent that Billy Stott did not want Jason to leave The Rockets. However, it was not Billy Stott’s decision to make. Jason Thomas joined Split Decision upon approval of its band members, not Billy Stott, and the addition of Jason has contributed to Split Decision’s current success.”⁶²

Jason Thomas affirmed that:

Billy Stott’s responsibility with Split Decision was that of a booking agent, but Billy Stott did not provide the final decision for gigs. Billy Stott would have to confirm with Doug Moore if the band wanted to do a gig before Billy Stott could book it.⁶³

⁵⁷ Thomas King cross-examination dep. 27:6-8, 58 TTABVUE 30.

⁵⁸ Thomas King cross-examination dep. 52:8-10, 58 TTABVUE 55.

⁵⁹ Jason Thomas decl. ¶¶ 5-7, 39 TTABVUE 3.

⁶⁰ Thomas cross-examination dep. 33:3-16, 95:3-15, 63 TTABVUE 36, 98.

⁶¹ Birchard cross-examination dep. 57 TTABVUE 64.

⁶² Moore decl. ¶ 7, 40 TTABVUE 4.

⁶³ Thomas decl. ¶ 12, 39 TTABVUE 3.

He continued:

Q. And why would Billy have to confirm with Doug Moore?

A. Because Billy worked for the band. He couldn't tell the band what to do.⁶⁴

...

A. He [Stott] couldn't require the band to do anything. He cannot -- he never told the band to do anything. He was hired by the band.⁶⁵

In 2015, the band members authorized their leader, Douglas Moore, to form Applicant, Split Decision Music, LLC, in the State of New Jersey in order to conduct the SPLIT DECISION band's business affairs.⁶⁶ After it was formed, Applicant Split Decision Music, LLC paid the band members for their performances as independent contractors.⁶⁷ Applicant Split Decision Music, LLC paid Opposer Stott his commissions as an independent contractor, and issued Form 1099 tax forms to him.⁶⁸

The parties parted ways on October 24, 2018, when Douglas Moore, acting at the five current band members' behest, sent Mr. Stott an email terminating his services.⁶⁹ Since then, Mr. Stott has not used the SPLIT DECISION mark.⁷⁰ The five band members—Douglas Moore, Ray Pierson, Michael Birchard, Thomas King, and Jason

⁶⁴ Thomas cross-examination dep. 68:12-15, 63 TTABVUE 71.

⁶⁵ Thomas cross-examination dep. 65:2-4, 63 TTABVUE 68.

⁶⁶ Moore decl. ¶ 19, 40 TTABVUE 6; Moore dep. ex. 1, 21 TTABVUE 2-3 (certificate of Formation, Nov. 12, 2015); King decl. ¶ 13, 37 TTABVUE 4; Birchard decl. ¶ 8, 38 TTABVUE 3; Pierson cross-examination dep. 72:19-24, 61 TTABVUE 75.

⁶⁷ Birchard decl. ¶ 8, 38 TTABVUE 3; Moore dep. 17:11-18:1, 48 TTABVUE 21-22.

⁶⁸ Moore decl. ¶ 15, 40 TTABVUE 6.

⁶⁹ Moore decl. ¶¶ 32-33, 40 TTABVUE 9; Stott decl. ex. 19, 25 TTABVUE 118.

⁷⁰ Moore decl. ¶ 39, 40 TTABVUE 10; Stott dep. 88:2-10, 31 TTABVUE 270; Doreen Stott dep. 31 TTABVUE 21-23, 27.

Thomas—have continued performing as the cover band SPLIT DECISION.⁷¹ The band members authorized Applicant Split Decision Music, LLC to file the subject Application to register SPLIT DECISION, and executed assignments to it.⁷²

III. Entitlement

“Any person who believes that he would be damaged by the registration of a mark upon the principal register ... may ... file an opposition in the Patent and Trademark Office, stating the grounds therefor...” 15 U.S.C. § 1063(a). A plaintiff is entitled to oppose registration of a mark where his opposition is within the zone of interests protected by the statute and the plaintiff has a reasonable belief in damage that would be proximately caused by registration of the mark. *Corcamore, LLC v. SFM, LLC*, 978 F.3d 1298, 2020 USPQ2d 11277, *4-7 (Fed. Cir. 2020); *Advance Magazine Publishers, Inc. v. Fashion Elecs., Inc.*, 2023 USPQ2d 753, *2 (TTAB 2023).

A dispute over ownership of a mark satisfies these requirements, and establishes Opposer’s entitlement to bring a statutory cause of action. *Fuji Med. Instr. Mfg. Co., Ltd. v. Am. Crocodile Int’l. Grp., Inc.*, 2021 USPQ2d 831, *11 (TTAB 2021) (citing *UVeritech, Inc. v. Amax Lighting, Inc.*, 115 USPQ2d 1242, 1244 (TTAB 2015)). Applicant does not contest Opposer’s entitlement in its brief. Opposer has accordingly proven his statutory entitlement to oppose, which extends to all his grounds for opposition. *Mars Generation, Inc. v. Carson*, 2021 USPQ2d 1057, *7 (TTAB 2021).

⁷¹ Birchard decl. ¶ 5, 38 TTABVUE 3, Moore decl. ¶ 37, 40 TTABVUE 10, Pierson cross-examination dep. 61 TTABVUE 110.

⁷² Birchard decl. ¶ 15, 38 TTABVUE 4 (all band members agreed Applicant LLC should own the mark); Moore decl. ¶¶ 25, 40, ex. 8: 40 TTABVUE 7-8, 10, 166-75 (recorded assignments to Split Decision Music LLC).

IV. Discussion and Analysis

Musical groups frequently give rise to trademark ownership disputes. *See, e.g., Wonderbread 5 v. Gilles*, 115 USPQ2d 1296 (TTAB 2015). This case is no exception. Although Opposer’s Notice of Opposition claims likelihood of confusion and fraud, the parties’ dispute centers on ownership of the SPLIT DECISION mark, which in turn depends upon priority of use in commerce. *Lyons v. Am. Coll. of Veterinary Sports Med. and Rehab.*, 859 F.3d 1023, 123 USPQ2d 1024, 1028 (Fed. Cir. 2017). “[W]hen both parties are relying upon activities the two conducted in concert with one another, each in an attempt to establish prior rights in a mark over the other, the dispute centers on ownership of the mark.” *Wonderbread 5*, 115 USPQ2d at 1302. Ownership “must be determined on a case by case basis dependent on the particular facts adduced in each case.” *Id.* at 1303 (citing *In re Briggs*, 229 USPQ 76, 77 (TTAB 1986)), *cited in CBC Mortg. Agency v. TMRR, LLC*, 2022 USPQ2d 748, *16 (TTAB 2022).

As plaintiff in this proceeding, it is Opposer’s burden to establish prior ownership by a preponderance of the evidence. *Wonderbread 5*, 115 USPQ2d at 1302 (citing *Metro Traffic Control, Inc. v. Shadow Network Inc.*, 104 F.3d 336, 41 USPQ2d 1369, 1372 (Fed. Cir. 1997)), *cited in CBC Mortg.*, 2022 USPQ2d 748, at *17. “It is well established that, in opposition proceedings, the burden of proof rests on the opposer.” *Spireon, Inc. v. Flex Ltd.*, 71 F.4th 1355, 2023 USPQ2d 737, *6 (Fed. Cir. 2023) (citing *Real Foods Pty Ltd. v. Frito-Lay N. Am., Inc.*, 906 F.3d 965, 128 USPQ2d 1370, 1374 (Fed. Cir. 2018)).

Since Opposer Stott portrays himself as performing different roles—manager and “primary, non-performing member” of Split Decision—we consider each perspective in turn.

A. Manager versus Group

When band managers and band members differ over who owns the bands’ service marks, the case law resolving these ownership disputes falls into two general groupings.

The first, advocated by Opposer Stott, is exemplified by *Rick v. Buchansky*, 609 F. Supp. 1522, 226 USPQ 449 (SDNY 1985). In that case, a musical “doo-wop” group was formed in 1961 at the instigation of David Rick, its manager, who proposed that the group perform as “Vito and the Salutations.” *Id.* at 450. The court found that Rick did not act simply as an agent for the group; he functioned more like the producer of a theater company:

[W]ho must constantly find new performers to fill established roles without substantially altering the nature of the show itself. So Rick, as manager and promoter of ‘Vito and the Salutations,’ conceived of the group’s performance as an ‘act’ in which each member played a particular role. As individuals left the group, others were found to replace them and to assume their respective parts.

...

It is estimated that at least ten persons...played the role of ‘Vito’ in ‘Vito and the Salutations’ during the 1960s and 1970s.

...

While the Court would not go so far as to endorse plaintiff’s characterization of himself as the artistic wellspring of “Vito and the Salutations,” it remains clear that he was far from a mere booking agent. Records adduced at trial demonstrate that Rick paid many if not most of the group’s recording, travel and clothing expenses. In addition to arranging for studio recording time and scheduling the group’s live

performances, Rick was responsible for the group's personnel decisions and oversaw the style and substance of the group's "act."

Id. at 451.

Moreover, Rick obtained a federal registration for VITO AND THE SALUTATIONS, which the court considered "prima facie evidence of the validity of the mark and of the owner's exclusive right to use the mark in commerce." *Id.* at 453. The court accordingly found that Rick, the manager, owned the mark.

We agree with Applicant, however, that this case is more akin to the second kind of case: *Bell v. Streetwise Records, Ltd.*, 640 F. Supp. 575, 231 USPQ 281 (D. Mass. 1986). In that case, a singing group began performing for nominal amounts of money in the Boston local entertainment market under the name New Edition. *Id.* at 285. They refused efforts to change their name, and continued to perform as New Edition. *Id.* at 284. An ownership dispute arose between the group and Streetwise Records, the record company that produced and marketed the group's first albums. Streetwise contended that they were a "concept group," like The Monkees or Menudo, whose performers are cast to fill roles created by entities that conceived both the concept and name. *Id.* at 286 n. 18 *cited in Wonderbread 5*, 115 USPQ2d at 1306 n. 14.

The court, however, found that New Edition was never a concept group. *Id.* Contrasting New Edition with Vito and the Salutations, the court found that "they were not, as defendants contend, replaceable actors in a play...." *Id.* at 286. "It is settled law that ownership of a mark is established by priority of appropriation." *Id.* at 285. "[T]hey existed and performed as New Edition long before [Streetwise released their first album]." *Id.* at 286. "[T]he norm in the music industry is that an artist or group generally owns its own name." *Id.* "The 'goods' therefore are the entertainment

services they provide. They and no one else controlled the quality of those services. They own the mark.” *Id.* at 287, *quoted in Wonderbread 5*, 115 USPQ2d at 1306.

Here, as in *Bell*, the group SPLIT DECISION performed publicly twice a month for a nominal amount—\$200 per performance—before the members ever met Mr. Stott. They retained the name they had chosen, SPLIT DECISION, and perform under it to this day. Mr. Stott made undeniably significant contributions during the group’s early years, but as it matured over the course of time it came to control its own music, clothing, performances, and publicity. The group and no one else controls the quality of its services. The group owns the service mark.

Opposer Stott nevertheless claims to own the trade names of the bands with which he worked, such as The Rockets and, as here, Split Decision.⁷³ He points to a “Management Agreement” he had certain members of The Rockets and Split Decision sign in or about 2010, providing in pertinent part:

Term. The respective duties and obligations of the contracting parties shall be for a period commencing upon execution of this Agreement and ending (3) three years later.

...

Musician acknowledges that the names of the bands and that the trade secrets and confidential information are owned and shall continue to be owned solely by the Manager.

...

The provisions of this Section 4 shall survive the expiration of termination of the remainder of this Agreement.

...

This agreement constitutes the sole and only Agreement of the contracting parties and supersedes any prior understandings or written or oral agreement between the parties respecting is subject matter.⁷⁴

⁷³ Stott dep. 46:1-3, 31 TTABVUE 228. Stott decl. ¶ 76, 25 TTABVUE 15-16. Stott rebuttal decl. ¶¶ 17, 51, 49 TTABVUE 5-6, 13.

⁷⁴ Stott decl. ex. 16, 25 TTABVUE 107-11.

Mr. Stott acknowledges the generic nature of the Management Agreement:

Q. Is there anything in this document that specifies Split Decision?

A. No, it was a comprehensive [sic] to any of the bands that or the tradenames, I believe.

Q. Okay. So this was just like a generic contract you would use for those bands?

A. For the individual members, yes.⁷⁵

Opposer's reliance on the Agreement is misplaced, however. To begin with, the band's rights in SPLIT DECISION predate the Agreement by two decades. *See Wonderbread 5*, 115 USPQ2d at 1302 (it is Opposer's burden to establish **prior ownership** by a preponderance of the evidence). This extends to the band's service mark and trade name. As noted, "the norm in the music industry is that an artist or group generally owns its own name." *Bell*, 231 USPQ at 286. *See also Boogie Kings v. Guillory*, 188 So.2d 445, 151 USPQ 133, 135 (La. App. 1966), (proprietary interest in the trade name The Boogie Kings vested in the band, as an unincorporated association. "The person or organization first appropriating the name or having the legal right to use it, therefore, has a proprietary interest in that name....").

The Management Agreement does not provide for an assignment of these service mark or trade name rights to Opposer. It merely provides a generic acknowledgement of whatever band names Opposer Stott owned. He undeniably owned The Rockets' name.⁷⁶ Jason Thomas signed it as a member of The Rockets, not SPLIT

⁷⁵ Stott dep. 57:6-12, 31 TTABVUE 239.

⁷⁶ Stott decl. ¶ 1, 25 TTABVUE 2; Moore decl. ¶ 21, 40 TTABVUE 7.

DECISION.⁷⁷ It appears from the record that one of the Agreements, with Ray Pierson, is unsigned by Mr. Stott.⁷⁸ And the record contains no such agreement with band member Thomas King.

In any event, as the SPLIT DECISION band members correctly declared:

A. Billy never owned Split Decision. He owned the Rockets, he may have owned maybe another one of his band names, but, no, he never owned the name Split Decision.⁷⁹

A. That clause did not apply to us. He can't continue to own something he never owned.⁸⁰

...
That part of the contract didn't apply to us. He can't continue to own us because he never owned us in the first place.⁸¹

The band members at all times retained their prior rights in SPLIT DECISION.

Opposer's reliance on a fictitious name registration is similarly unavailing. In 2011, Opposer filed a fictitious name application with the Pennsylvania Department of State Corporation Bureau.⁸² As a noted commentator has observed, however, "the fact that defendant merely filed a fictitious name registration with a county or state clerk is entitled to little, if any, weight in litigation over the corporate or fictitious name. It certainly cannot provide a defense against a proven senior user." 1

⁷⁷ Thomas cross-examination dep. 26:22-27:11, 63 TTABVUE 29-30; Stott cross-examination dep. 143:17-24, 52 TTABVUE 222.

⁷⁸ 32 TTABVUE 17.

⁷⁹ Birchard cross-examination dep. 46:9-12, 57 TTABVUE 49.

⁸⁰ Moore cross-examination dep. 124:3-4, 54 TTABVUE 128.

⁸¹ Moore cross-examination dep. 17:9-12, 55 TTABVUE 18.

⁸² Stott rebuttal decl. ex. 11, 49 TTABVUE 50-52.

MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 9:9 (5th ed. Dec. 2023). *Cf. Foxtrap, Inc. v. Foxtrap, Inc.*, 671 F.2d 636, 215 USPQ 1105, 1108 n.7 (D.C. Cir. 1982) (Pennsylvania corporation) (“But this circuit, following the general rule, has declined to accord any weight to a state agency’s general acceptance of a corporate name.”), *cited in* 1 MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 9:8. In this case, as in *Bell* and *Boogie Kings*, the band is the senior user, in which proprietary rights vest.

B. Departing Member versus Remaining Group

For the sake of completeness, we also consider Opposer’s portrayal of himself as the “primary, non-performing member” of the group. Generally, there are three main factors to be considered in ownership disputes surrounding service marks as between a departing member and the remnant group: (1) the parties’ objective intentions or expectations; (2) who the public associates with the mark; and (3) to whom the public looks to stand behind the quality of goods or services offered under the mark. *Lyons*, 123 USPQ2d at 1028, *cited in CBC Mortg.*, 2022 USPQ2d 748, at *16 and 2 MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 16:39.50.

These factors effectuate the fundamental purposes of trademark law, which are to secure to the user of a mark the good will it has developed in the public mind, to secure to the public the ability both to identify and distinguish the user’s goods or services from those of others, and to hold the user responsible for the consistency and quality of those goods or services. *See generally BellSouth Corp. v. DataNational Corp.*, 60 F.3d 1565, 35 USPQ2d 1554, 1557 (Fed. Cir. 1995) (“The primary function of a trademark is to identify and distinguish the goods or services of one source from those sold by all others”).

We recognize that the facts of the present case differ in some respects from those in *Lyons*. Nonetheless, we believe that “the *Lyons* factors are substantially similar to and in some ways subsume those applied in other types of ownership disputes....” *CBC Mortg.*, 2022 USPQ2d 748, at *17.

When Mr. Stott began working with the group’s founders, Zajac and Kinka, he expressly stated his intention to be the “primary, non-performing member” of the group. But as the years passed, he admitted, he did not tell new members that, subjectively believing that it was common knowledge.⁸³ By the late 1990s, the group did not regard him as a band member at all.⁸⁴ As band leader Doug Moore put it:

Q. So even though the original member of Split Decision, and as verified, it’s [sic] Billy Stott was made a member of Split Decision in 1991, are you now stating that he was never a member?

A. I am stating that.⁸⁵

As another band member put it:

Q. So have you ever heard of a nonperforming band member?

A. No.⁸⁶

Stott was asked how he held himself out to industry professionals, such as club owners, with whom the band would book gigs:

Q. Now, did you ever hold yourself out to be a member of the band to other industry professionals, for example, club owners?

A. I would have no reason to.

⁸³ Stott cross-examination dep. 41:8-15, 52 TTABVUE 120.

⁸⁴ Moore decl. ¶ 6, 40 TTABVUE 3. Birchard decl. ¶ 5, 38 TTABVUE 3. King decl. ¶ 3, 37 TTABVUE 2.

⁸⁵ Moore cross-examination dep. 44:12-16, 54 TTABVUE 48.

⁸⁶ Thomas King cross-examination dep. 27:6-8, 58 TTABVUE 30.

Why would I?

...

Q. Did you tell club owners that you were a member of the band?

A. A non-performing member of the band, I truthfully don't believe I ever used that verbiage.⁸⁷

According to Philadelphia nightclub manager Jimmy Masiak, who managed several venues at which SPLIT DECISION performed over the course of 20 years, Billy Stott merely acted as a booking agent for the band.⁸⁸ And from 2015, on, band leader Doug Moore handled most of the bookings.⁸⁹ The band's promotional posters also listed Stott separately, as the band's manager, not as a member. For example:



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⁸⁷ Stott cross-examination dep. 52 TTABVUE 121-22.

⁸⁸ Masiak decl. ¶¶ 1-3, 35 TTABVUE 2.

⁸⁹ Masiak decl. ¶ 6, 35 TTABVUE 3; Masiak dep. 14:8-14, 60 TTABVUE 17.

⁹⁰ Moore dep. ex. 3, 54 TTABVUE 409.

So, based on the objective evidence, Opposer Stott did not hold himself out to club owners or patrons as a member, much less a “primary, nonperforming member” of SPLIT DECISION. And after the band terminated his services in October 2018, he has had no involvement with SPLIT DECISION:

Q. Are you still involved with the band, Split Decision, currently?

A. Umm, no.⁹¹

...

Q. So can you tell me how you're currently using the trademark Split Decision today?

A. Currently, my trademark is being used by the members that chose to no longer be managed by me.

Q. Just to clarify for the record, you are not currently using the trademark Split Decision; is that correct?

A. Currently using, no. Am I currently using it? No.⁹²

As a result, the relevant members of the public—club owners and patrons—will look to the band members to perform as Split Decision and stand behind the quality of their performances. They would not look to Opposer, whose participation was terminated in 2018, over five years ago, who has no further role in managing or booking the band, and who has not attempted to field another band under the mark SPLIT DECISION. As in *Lyons*, “the indicia of ownership” point to the SPLIT DECISION band members, not Opposer. *Lyons*, 123 USPQ2d at 1027. The band members’ actions, undertaken in concert, establish their collective ownership of the

⁹¹ Stott dep. 24:16-18, 31 TTABVUE 206.

⁹² Stott dep. 88:2-10, 31 TTABVUE 270. *See also* Doreen Stott dep. 31 TTABVUE 22-23 (Split Decision is not featured on any of the Stott websites or social media platforms).

mark. Their band leader testified, “It’s owned collectively from the five of us, not individually.”⁹³

The five band members, in turn, authorized their band leader, Doug Moore, to apply to register the SPLIT DECISION mark on their behalf via the band’s limited liability company, Applicant Split Decision Music, LLC.⁹⁴ The five band members later signed nunc pro tunc assignments memorializing their prior agreement to have the LLC apply to register the mark.⁹⁵ “Nunc pro tunc’, literally speaking, means now for then. A nunc pro tunc assignment in practice and as meant in law is an assignment made now of something which was previously done, to have effect as of the former date.” *Hotel Corp. of Am. v. Inn Am., Inc.*, 153 USPQ 574, 578 (TTAB 1967). “The lateness of the execution of a nunc pro tunc assignment is not controlling if it does in fact reflect what actually occurred or was intended to occur on the past date.” *Rite Aid Corp. v. Rite-Way Discount Corp.*, 182 USPQ 698, 700 n.3 (TTAB 1974) *aff’d* 508 F.2d 828, 184 USPQ 351 (CCPA 1975). “However, the motivation for a sale is irrelevant and senior user status may be properly achieved by assignment in anticipation or in the midst of litigation.” *Dial-A-Mattress Operating Corp. v. Mattress Madness, Inc.*, 841 F. Supp. 1339, 33 USPQ2d 1961, 1967 n.10 (EDNY 1994). The

⁹³ Moore cross-examination dep. 72:23-34, 55 TTABVUE 73.

⁹⁴ Birchard decl. ¶ 15, 38 TTABVUE 4 (all band members agreed Applicant LLC should own the mark); King cross-examination dep. 86:11-20, 58 TTABVUE 89 (band members intend that Applicant LLC own and register the mark); *accord* Pierson dep. 26:16-27:4, 48 TTABVUE 159-60; Pierson cross-examination dep. 106:10-12, 108:19-23, 61 TTABVUE 109, 111; Thomas cross-examination dep. 74:5-11, 63 TTABVUE 77.

⁹⁵ Moore decl. ¶¶ 25, 40, ex. 8: 40 TTABVUE 7-8, 10, 166-75 (recorded assignments to Split Decision Music LLC). King decl. ¶ 16, 37 TTABVUE 4. Pierson cross-examination dep. 123:5-19, 61 TTABVUE 126 (band members agreed prior to filing application); Birchard cross-examination dep. 77:14-17, 57 TTABVUE 80 (assignment documented what band members agreed to); *accord* Thomas cross-examination dep. 82:22-83:3, 63 TTABVUE 85-86.

assignments were, moreover, recorded with the USPTO. *See* 15 U.S.C. § 1060(a)(3) (recordation of an assignment constitutes prima facie evidence of its execution).

From either perspective—be it manager versus group or departing member versus remaining group—the group, through its limited liability company, Applicant Split Decision Music, LLC, owns the service mark SPLIT DECISION.

V. Conclusion

Based on the record before us, we find that Opposer has failed to meet his burden of proving by a preponderance of the evidence that Applicant does not own the registered mark SPLIT DECISION. Opposer has also failed to establish that he has prior ownership rights in SPLIT DECISION, which is an essential predicate to a Section 2(d) claim. And given that his fraud claims are predicated on his claims of rightful ownership of the mark, Opposer has not proven that Applicant committed fraud in the course of applying to register the mark SPLIT DECISION.

Decision: The opposition to registration of the mark SPLIT DECISION in Application Serial No. 88181842 is dismissed.