

This Opinion is Not a
Precedent of the TTAB

Mailed: October 25, 2022

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Clementvision, Inc.

v.

Robert Clement

Opposition No. 91256127

Michael B. Bressman of Vanderbilt Legal Clinic
for Clementvision, Inc.

Bruce H. Phillips of the Law Office of Bruce H. Phillips
for Robert Clement.

Before Greenbaum, Adlin and Larkin, Administrative Trademark Judges.

Opinion by Adlin, Administrative Trademark Judge:

This is an ownership dispute between Applicant Robert Clement, second cousin of legendary country music multi-hyphenate Jack Henderson Clement (“Cowboy Jack”), and Opposer Clementvision, Inc., a corporation Cowboy Jack owned and, upon his death, bequeathed to his children Kimberly Alison Clement Bolton (“Alison”) and Jack Sheldon Niles Clement (“Niles”). It has the makings of a country song.

I. The Pleadings

Applicant seeks registration of THE COWBOY ARMS HOTEL AND RECORDING SPA, in standard characters, for “musical recordings” in International Class 9, and “recording studio services; recording studios; audio recording and production; production of audio recording; production of musical sound recording; sound recording studios” in International Class 41.¹ In its notice of opposition, Opposer alleges: (1) prior use, during Cowboy Jack’s lifetime, of the “famous” mark Applicant now seeks to register, for overlapping services; (2) that Alison and Niles inherited Opposer and its assets, including the involved mark, from Cowboy Jack; and (3) that Opposer has used the involved mark continuously after Cowboy Jack’s death, including before the involved application’s filing date, “for services related to recording studios, musical production, and audio services.” As grounds for opposition, Opposer alleges that Applicant’s use of the involved mark would be likely to cause confusion with, and dilute (“through blurring and tarnishment”), Opposer’s identical mark previously-used for identical services.

In his answer, Applicant admits that Cowboy Jack used the involved mark continuously from the mid-1970s until his death for “services related to recording studio services,” that the mark is “famous,” and that Cowboy Jack owned Opposer and bequeathed it to Alison and Niles. Applicant otherwise denies the salient allegations in the notice of opposition. Applicant also asserted several affirmative

¹ Application Serial No. 88314592, filed February 25, 2019 under Section 1(a) of the Trademark Act, based on claimed first use dates of July 20, 1975.

defenses, some of which (“waiver,” equitable estoppel, laches and “unclean hands”) he did not pursue or prove at trial and are accordingly forfeited. *In re Google Techs. Holdings, LLC*, 980 F.3d 858, 2020 USPQ2d 11465 (Fed. Cir. 2020); *NT-MDT LLC v. Kozodaeva*, 2021 USPQ2d 433, at *5 n.8 (TTAB 2021). Applicant also asserted, tried and briefed the affirmative defense of abandonment, as well as a purported “affirmative defense” of non-ownership. While non-ownership is not a true affirmative defense, as explained below the parties agree that it is nevertheless the crux of this case, and the issue was tried by implied consent.

II. The Record

The record consists of the pleadings and, by operation of Trademark Rule 2.122(b), 37 C.F.R. § 2.122(b), the file of Applicant’s involved application. In addition, Opposer introduced:

Testimony Declaration of Kimberly Alison Clement Bolton, Opposer’s co-owner, Secretary and Treasurer, and the exhibits thereto (“Alison Dec.”). 7 and 8 TTABVUE.²

Testimony Declaration of Anna Brady, Manager, Business and Legal Affairs for the American Society of Composers, Authors and Publishers (“ASCAP”), and the exhibits thereto (“Brady Dec.”). 9 and 11 TTABVUE.

Testimony Declaration of Jack Sheldon Niles Clement, Opposer’s other co-owner (“Niles Dec.”). 10 TTABVUE.

Notice of Reliance on third-party registrations, official records, printed publications, Internet printouts and

² Citations to the record are to TTABVUE, the Board’s online docketing system. Specifically, the number preceding “TTABVUE” corresponds to the docket entry number(s), and any number(s) following “TTABVUE” refer to the page number(s) of the docket entry where the cited materials appear.

Applicant's discovery responses ("Opp. NOR"). 12 TTABVUE.

Rebuttal Testimony Declaration of Ms. Clement Bolton and the exhibit thereto ("Alison Reb. Dec."). 29 TTABVUE.

Rebuttal Testimony Declaration of Niles Clement ("Niles Reb. Dec."). 30 TTABVUE.

Rebuttal NOR on third-party registrations and Internet printouts ("Opp. Reb. NOR"). 31 TTABVUE.

Applicant introduced:

Testimony Declaration of Russ Zavitson, Chief Executive Officer of Zavitson Music Group, LLC ("ZMG"). 20 TTABVUE.

Oral cross-examination of Niles, and the exhibits thereto ("Niles Cross Tr."). 21 TTABVUE.

NOR on Internet printouts ("App. NOR"). 22 TTABVUE.

Testimony Declaration of Applicant Robert Lee Clement, and the exhibits thereto ("App. Dec."). 23 TTABVUE.

Oral cross-examination of Alison, and the exhibits thereto ("Alison Cross Tr."). 24 and 28 TTABVUE.

III. Relevant Facts

For the most part, the parties agree on the pertinent facts, but disagree as to their legal significance.

A. Cowboy Jack

"Cowboy Jack Clement was a famous songwriter, music producer, music publisher, studio owner, music engineer, and artist. Cowboy was a music star who wrote, recorded, published, engineered, and performed thousands of songs over his

50-plus year career. He was inducted into the Country Music Hall of Fame in 2013.”

7 TTABVUE 3 (Alison Dec. ¶ 6).

Cowboy Jack worked with Elvis Presley, Johnny Cash, Roy Orbison, Jerry Lee Lewis, Charley Pride, U2 and others. *Id.* at 3-4 (Alison Dec. ¶ 7). He worked with Sam Phillips at Sun Studio in Memphis, and discovered Jerry Lee Lewis, Charley Pride and Townes Van Zandt. *Id.* President Bill Clinton, First Lady Michelle Obama, Bono and Taylor Swift provided videotaped comments on Cowboy Jack’s legacy at a 2013 concert honoring him. *Id.*

B. Opposer and Cowboy Jack’s Other Music Businesses

Cowboy Jack established Opposer in 1959, originally calling it “Jack Music, Inc.” The company changed its name to “Clementvision” in 1990. *Id.* at 4 (Alison Dec. ¶ 9); 12 TTABVUE 53-55 (Opp. NOR Ex. H).


Opposer is a Nashville “music publishing and production company” which Alison and Niles inherited from Cowboy Jack after he died in 2013. Alison and Niles each now own 50% of Opposer. 7 TTABVUE 2-3, 23-27 (Alison Dec. ¶¶ 2-4 and Exs. 1, 2); 10 TTABVUE 5 (Niles Dec. ¶ 10). Opposer was not Cowboy Jack’s only company, however. In fact, Cowboy Jack

had a number of music companies and businesses, some of which were incorporated and some of which were not, that he operated together through his music business. Some of these were different publishing companies that he used with different performing rights organizations such as [ASCAP] and Broadcast Music, Inc. (“BMI”). These companies include Clement Family Songs (BMI), Company Store Music (BMI), and Cowboy Arms Music (ASCAP). All these companies were and are related to each other and with [Opposer], which was Cowboy Jack’s main company. [Opposer] has served as the primary music publishing and

production company and as the umbrella or hub for all the businesses. Basically, [Cowboy Jack] operated all of his music operations together and interchangeably and ran them as the [Opposer] organization with [Opposer] as the main company housing and overseeing all of his music business operations. Cowboy Jack ultimately owned all of the companies and businesses.

7 TTABVUE 4-5 (Alison Dec. ¶ 10); 10 TTABVUE 3-4 (Niles Dec. ¶ 5) (Opposer “was the main company for [Cowboy Jack’s] business and was like a holding company that housed and ran my father’s other businesses and companies ... [Opposer] housed all the businesses and was the principal company managing his businesses.”).

Thus, “when business was conducted by one of the companies, communications between the business parties often referred interchangeably between Cowboy Jack’s companies and [Opposer]. There were common officers and employees among the businesses.” 7 TTABVUE 5 (Alison Dec. ¶ 11). Perhaps not surprisingly, Opposer’s letterhead identifies some of these other businesses, including Cowboy Arms Music, as shown below:


ClementVision

Clement Family Songs (BMI)
Company Store Music (BMI)
Cowboy Arms Music (ASCAP)

JOHNNY'S CASH AND CHARLEY'S PRIDE (New Lyrics)
(Cy Coben)

IF I HAD JOHNNY'S CASH AND CHARLEY'S PRIDE
I WOULDN'T HAVE A BUCK OWEN ON MY CAR
I'D DRIVE DOTTIE WEST TO ALABAMA
AND GET NEWTON JUICED IN A BAR
SEEIN' BOBBY BARE IS GIVIN' NELSON THE WILLIES
AND IT STARTED EDDIE RAVEN 'BOUT MICKEY'S GILLEYS

I'D WALK DOWN CHRISTY LANE IN A CRYSTAL GAYLE
TO WATCH BILLY'S SWAN DIVE SAVE HER
AND I'D HOLD BOBBY'S GOLD BURRO SO BILLY JOE COULD SHAVE 'ER
I'D MAKE CHARLIE RICH MOE BANDY'S LAWN AND I'D CON HUNLEY TOO
IF I HAD JOHNNY'S CASH, CHARLEY'S PRIDE AND YOU

IF I HAD JOHNNY'S CASH AND CHARLEY'S PRIDE
I'D BUY EDDIE'S RABBITT FARM
AND I'D FLUSH JOHNNY'S PAYCHECK DOWN OLIVIA NEWTON'S JOHN
ON BARBARA'S MANDRELLIN I'D PLAY TUNES TENDER
'BOUT HOW BILLY CRASHED HIS CRADDOCK INTO FREDDY'S FENDER
I'D WIN AN EMMYLOU FOR THE TV SHOW
JERRY'D REED THE DOLLY PART ON
AND I'D HAVE LARRY'S GATLIN GUN GO BOOM
AND GET RONNIE'S MIL-SAP STARTIN'


I'D DRIVE CONWAY TWITTY
MAKE MERLE HAGGARD
THAT'S WHAT I'D DO
IF I HAD JOHNNY'S CASH, CHARLEY'S PRIDE AND YOU

Copyright 1984 **Cowboy Arms Music**

ClementVision, Inc. / P.O. Box 120477 / Nashville, TN 37212 / (615) 383-0330

CVSN001165

Id. at 31 (Alison Dec. Ex. 3). Similarly, royalty-related correspondence from Opposer addresses agreements to which Cowboy Arms Music is a party, and royalty-related correspondence to Cowboy Arms Music is sent care of Opposer, as shown below:


Clementvision

Clement Family Songs (BMI)
Company Store Music (BMI)
Cowboy Arms Music (ASCAP)

FAX MEMO - PAGE ONE OF ONE PAGE February 24, 1995

TO: Terje Engen, Sonet Norway

FAX: 4722551705

FROM: Bob Webster, Clementvision Nashville

FAX: 615-292-5685

RE: ROYALTY STATEMENT FOR P/E DECEMBER 31, 1994

With reference to the Agreement dated December 9, 1992, between Sonet Music and Cowboy Arms Music, we acknowledge your right to collect one hundred percent (100%) of the mechanical royalties, paying seventy-five percent (75%) to Cowboy Arms Music, retaining twenty-five percent (25%) for benefit of Sonet Music. We further acknowledge that performance royalties are split in the same manner except the societies will pay the Cowboy Arms Music portion directly to us via ASCAP.

Please advise if any further clarification is needed.

April 21, 1995

RE: AGREEMENT OF DECEMBER 9, 1992

Please see Page 2, Paragraph 2, Sub-Paragraph (a)

THE HARRY FOX AGENCY, INC. FROM JUNE 1, 1992 - JUNE 30, 1992

PUBLISHER'S REPORT OF AGREEMENTS ISSUED

COWBOY ARMS MUSIC, INC.
% CLEMENT VISION, INC.
P.O. BOX 120477
NASHVILLE TN 37212

LICENSE NUMBER	RELEASE DATE/ PAYMT %	MANUFACTURER/ R A T E	RECORD NUMBERS	A R T I S T S
AS LONG AS THERE'S YOU (K.S. TAYLOR, MARK HOWARD)				
N178146	1992	FLYING FISH RECORDS		GINGER BOATWRIGHT
	50.	STATUTORY	FF 70550-1	LP CO
BACK HOME TO YOU (GINGER BOATWRIGHT, MARK HOWARD)				
N157319	1992	FLYING FISH RECORDS		GINGER BOATWRIGHT
	50.	STATUTORY	FF 70550-1	LP CO
LICENSE COUNT: 2				

Id. at 35, 37 (Alison Dec. Ex. 4). Opposer has filed applications to register Cowboy Arms Music's copyrights. *Id.* at 57-65 (Alison Dec. Ex. 5).

In 1980 or earlier, Cowboy Jack "published and licensed music under the name Cowboy Arms Music," and in 1990 he "changed the name of one of his music

publishing companies from Jando Music, Inc. (“Jando”), which he established in 1967, to Cowboy Arms Music Inc.” *Id.* at 6 (Alison Dec. ¶ 13). *See also* 10 TTABVUE 4 (Niles Dec. ¶ 7) (“My father did not use Cowboy Arms only for the name of his home and studio. One of his music publishing businesses was Cowboy Arms Music. Cowboy Arms Music began publishing songs at least as early as the 1980s.”); 12 TTABVUE 84 (Opp. NOR Ex. I).

C. Cowboy Jack’s Home and Recording Studio

Over 50 years ago, Cowboy Jack purchased a home at 3405 Belmont Boulevard in Nashville. He built a recording studio in the home, and in the 1970s began calling the recording studio THE COWBOY ARMS HOTEL AND RECORDING SPA, which was sometimes referred to as COWBOY ARMS, THE COWBOY ARMS and THE SPA. 7 TTABVUE 5-6 (Alison Dec. ¶ 12); 21 TTABVUE 14 (Niles Cross Tr. 13). The studio was not just for recording; it was also a musician hangout. 7 TTABVUE 5-6 (Alison Dec. ¶ 12); 10 TTABVUE 4 (Niles Dec. ¶ 6) (“Songwriters and artists would come to the Cowboy Arms to spend time with Cowboy Jack brainstorming ideas, writing, recording, performing, reminiscing, and enjoying each other’s company.”). Opposer owned and operated the studio. 21 TTABVUE 8 (Niles Cross Tr. 7).

Cowboy Jack transferred ownership of his home to Opposer (at the time still called Jack Music) in 1989. 7 TTABVUE 6-7, 80-85 (Alison Dec. ¶ 15 and Ex. 9). “In 2011, a fire significantly damaged the 3405 Belmont Property, destroying much of the home and studio, including many master music recordings, memorabilia, and property located inside. The home and studio were rebuilt and repaired.” *Id.* at 7 (Alison Dec. ¶ 15).

D. Cowboy Jack’s Will, and Sale of the Home and Recording Studio

As indicated, Cowboy Jack died in 2013. The lede of The Tennessean’s Cowboy Jack obituary was: “Whimsical maverick Jack Clement – singer, producer, ringleader, writer of classic songs, discoverer of stars and member of the Country Music Hall of Fame – died Thursday at his Nashville home.” 12 TTABVUE 88 (Opp. NOR Ex. J).

The obituary specifically highlighted Cowboy Jack’s home studio:

Mr. Clement's home studio on Belmont Boulevard drew towering musical figures such as Cash, Prine, Wagoner, Parton, Hartford and songwriting hero Townes Van Zandt, and that studio - called The Cowboy Arms & Recording Spa - was a meeting ground for generations of Nashville musicians who shared Mr. Clement's irreverent appreciation of laughter and song. Among music types, dreamers, poets and clowns, keys to Mr. Clement’s house were as common as guitar picks, and as valued as gold records.

Id. at 88-89.

Cowboy Jack’s will named Alison and Niles as his “primary beneficiaries,” and with minor exceptions,³ each of them “received and split 50/50 all of” Cowboy Jack’s “property, assets and belongings,” including Opposer and Cowboy Arms Music. 7 TTABVUE 7-8 and 8 TTABVUE 88-89, 95-97 (Alison Dec. ¶¶ 16-17, 19 and Exs. 10, 12); 10 TTABVUE 2, 5 (Niles Dec. ¶¶ 2, 9); 21 TTABVUE 12 (Niles Cross Tr. 11). Applicant admits that Alison and Niles “inherited complete ownership of [Opposer] from [Cowboy Jack].” 12 TTABVUE 143 (Applicant’s response to Request for Admission No. 2). According to Alison, she and Niles also inherited “all of the

³ The exceptions included a 25% portion of the proceeds from sale of the home, and a temporary royalty stream. 7 TTABVUE 7-8 (Alison Dec. ¶¶ 16-17).

intellectual property, including the Cowboy Arms name and mark,” as well as “Cowboy Jack’s publicity rights.” 7 TTABVUE 7-8 (Alison Dec. ¶ 17).

Cowboy Jack’s will appointed Applicant, Cowboy Jack’s second cousin, and Kent Harrell, Cowboy Jack’s accountant, as co-executors and co-personal representatives of the estate. *Id.* at 9 (Alison Dec. ¶ 22); 23 TTABVUE 2 (App. Dec. ¶ 2); 28 TTABVUE 9 (Alison Cross Tr. 8). During probate, before Alison and Niles inherited Opposer, Applicant and Harrell “as the Co-Executors, became and served as the sole shareholders of [Opposer] and elected themselves as the sole board members and appointed themselves as the officers of [Opposer].” 7 TTABVUE 9 (Alison Dec. ¶ 22). After Harrell died, Applicant became the estate’s sole executor, as well as sole shareholder, board member and President of Opposer, “until the estate closed in 2016.” *Id.*

Thus, before the estate closed, Alison and Niles “were not able to control [Opposer] (even though [they] inherited it) or use any of the estate’s intellectual property, including the Cowboy Arms mark.” *Id.* at 10 (Alison Dec. ¶ 23). In fact, while Alison and Niles “wanted to make the studio at the 3405 Belmont Property available for recordings to generate some money during the probate,” Applicant did not allow them to do so. *Id.* (Alison Dec. ¶ 24); *see also* 10 TTABVUE 5 (Niles Dec. ¶ 9) (“The probate of Cowboy Jack’s estate was unfriendly ... I was living and working in the 3405 Belmont Property at the time of my father’s death and during the early part of the probate period, Applicant did not allow me to use the studio to finish some projects

and to try to bring in new clients, which I thought would bring some money into the estate.”).

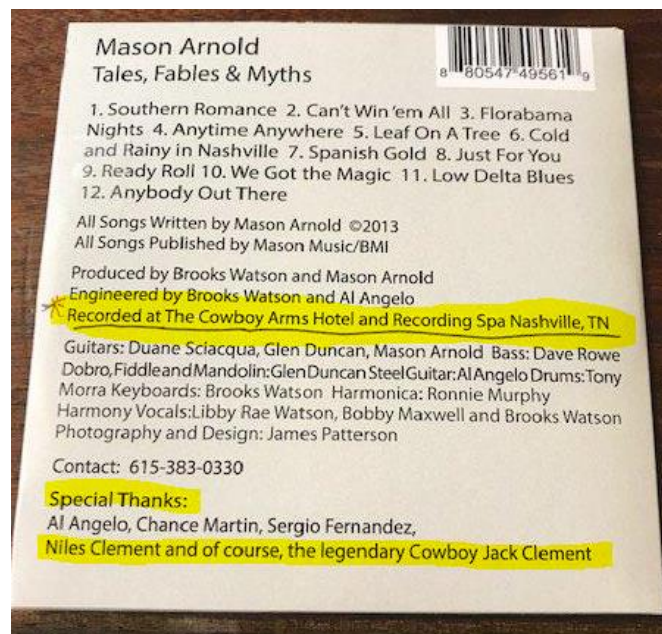
In any event, while the surrounding circumstances are not clear from the record, “[a]t some point by early 2014, the decision was made to sell the 3405 Belmont Property.” *Id.* (Alison Dec. ¶ 25). Applicant offered to buy the home “for \$1,025,000, plus \$175,000 for the studio,” but Alison and Niles objected. *Id.* at 10-12, 90-126 (Alison Dec. ¶¶ 25 and 26 and Exs. 13 and 14); 10 TTABVUE 6 (Niles Dec. ¶ 14). Later that year, the house and certain personal property, including pianos and studio equipment, were sold to Beverly Miller for a total of \$1 million, with the house being sold for \$925,000 and the personal property being sold for \$75,000, and Applicant signing “the sales and settlement documents” as President of Opposer. 7 TTABVUE 11, 101-126 (Alison Dec. ¶¶ 25-26 and Ex. 14).

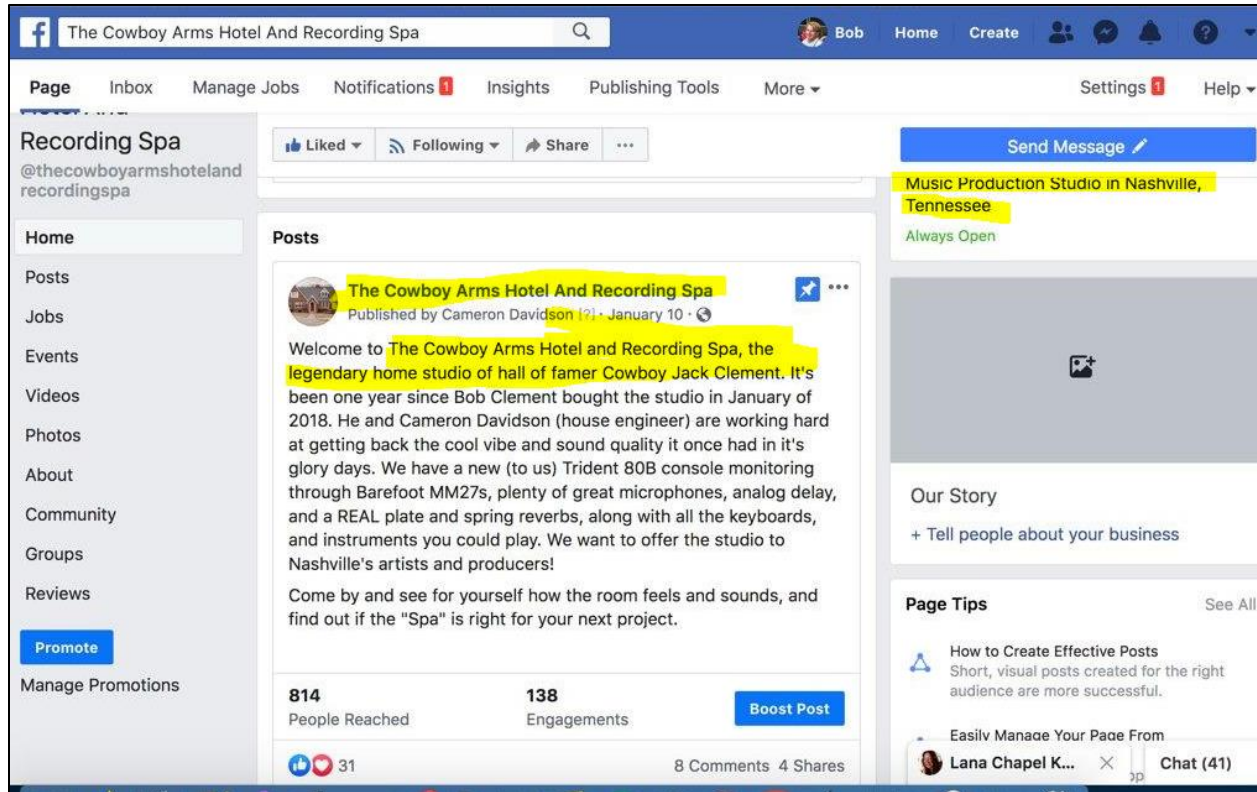
“At no time as part of the sale of the 3405 Belmont Property did [Applicant] discuss with Niles or [Alison] the sale of The Cowboy Arms Hotel and Recording Spa name.” *Id.* at 11 (Alison Dec. ¶ 27). “The sales document for the 3405 Belmont Property does not mention The Cowboy Arms Hotel and Recording Spa name,” nor does the Bill of Sale for the accompanying personal property. *Id.* Alison and Niles “never had any intention to transfer The Cowboy Arms Hotel and Recording Spa name or any intellectual property.” *Id.* at 12, 90-16 (Alison Dec. ¶ 28 and Exs. 13 and 14); 10 TTABVUE 7 (Niles Dec. ¶¶ 16-17). Alison, Niles and Opposer are unaware of any transfer of the involved mark to Beverly Miller or anyone else; they “never

transferred The Cowboy Arms Hotel and Recording Spa mark.” 29 TTABVUE 3, 5-6 (Alison Reb. Dec. ¶¶ 5, 10); 30 TTABVUE 2-5 (Niles Reb. Dec. ¶¶ 3, 4, 8).

Alison learned in March 2018 that at some point after Cowboy Jack’s old home at 3405 Belmont was sold to Beverly Miller, Applicant bought the property for himself. 7 TTABVUE 17 (Alison Dec. ¶ 42). In fact, according to Applicant, in September 2017 Mr. Zavitson “asked whether I was interested in purchasing the Property,” following which Applicant purchased the property in January 2018. 23 TTABVUE 5 (App. Dec. ¶ 22).

Applicant then began providing recording studio services at Cowboy Jack’s home studio “identifying the Studio and the services provided there at all times using the [involved] Mark.” 23 TTABVUE 6 (App. Dec. ¶ 24). The specimens of use Applicant submitted in support of his involved application refer to both Cowboy Jack’s studio and Cowboy Jack as “legendary,” and in one, Applicant publicly thanks Niles, as shown below:





See also 23 TTABVUE 6-7, 82, 86 (App. Dec. ¶ 28 and Ex. I).

Applicant admits that he “did not inherit any tangible or intangible property, including any intellectual property, from [Cowboy Jack].” 12 TTABVUE 144 (Applicant’s response to Request for Admission No. 4). At the same time, however, Applicant testifies that “[a]t no point in the [home/studio] selling process or the Sale itself did Alison or Niles object to the purchaser acquiring or using the Mark in connection with the Studio or the Property.” 23 TTABVUE 5 (App. Dec. ¶ 19).

Alison did “object,” after the fact, to Applicant’s eventual acquisition of the home and property, and told Applicant that “it was wrong for him to be in that house,” and that Cowboy Jack “would not want [Applicant] owning and doing business” there. 7 TTABVUE 17 (Alison Dec. ¶ 42). The following month, Alison “obtained the domain

name for the website, the cowboyarmshotelandrecordingspa.com.” *Id.* at 17, 201-203 (Alison Dec. ¶ 43 and Ex. 28).

E. Opposer’s Post-Probate Activities

After Cowboy Jack passed away, during the probate period his “estate received royalties and royalty statements from ASCAP for Cowboy Arms Music.” *Id.* (Alison Dec. ¶ 29). In 2016, after the probate period ended, the estate closed, and Alison and Niles gained control of Opposer, ASCAP royalties and royalty statements were sent to Opposer, and Opposer still receives these royalties and royalty statements today. *Id.*; 9 TTABVUE 4-5 and 11 TTABVUE 8-600 (Brady Dec. ¶¶ 8-12 and Exs. A and B) (“Cowboy Arms has regularly received royalty payments from ASCAP for performances of works in the Cowboy Arms catalog since at least November 2009, including specifically: (i) for periods prior to August 8, 2013; (ii) for periods between August 8, 2013 and February 22, 2016; and (iii) for periods since February 22, 2016.”). Alison and Niles “registered Cowboy Arms Music songs with ASCAP in 2019. Cowboy Arms Music also received royalties from HFA [The Harry Fox Agency] since 2014 through as recently as 2019, and Cowboy Arms Music is listed in BMI’s catalog.” 7 TTABVUE 12 (Alison Dec. ¶ 9).⁴

Alison and Niles hoped to do more with Opposer and the intellectual property they claim to have inherited from their father in the years after gaining control of Opposer, but Alison’s husband and Niles both “faced significant health issues” at that time,

⁴ HFA “is one of the largest providers and collectors of mechanical license fees for music publishers,” and BMI, like ASCAP, is a performance rights organization. 7 TTABVUE 4, 9 (Alison Dec. ¶¶ 10, 20).

and were cared for by Alison, making it difficult for Opposer to pursue its plans. *Id.* at 12-13 (Alison Dec. ¶ 30); 10 TTABVUE 8 (Niles Dec. ¶ 19). Nevertheless, Opposer, Alison and Niles “never intended to discontinue using” the involved mark. 7 TTABVUE 13. (Alison Dec. ¶ 31).

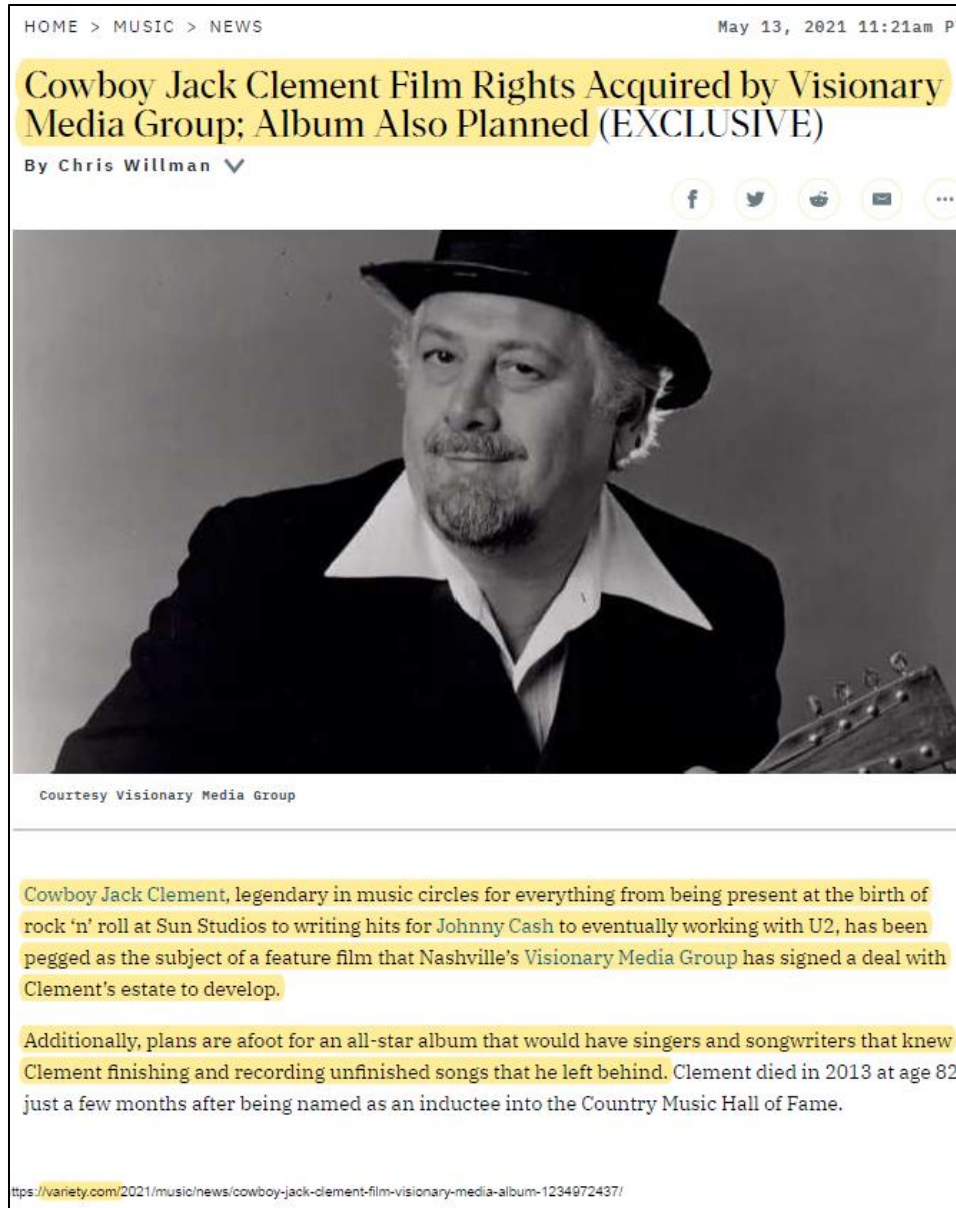
In fact, their plans included “releasing albums, selling merchandise on [their] Cowboy Arms Hotel and Recording Spa website, creating a radio show, starting a podcast, and more.” *Id.* (Alison Dec. ¶ 32). Some of these plans are set forth in a “Stewardship Plan and Proposal” called “The Estate & Legacy of Cowboy Jack Clement,” prepared by The Gordon Law Group. *Id.* at 152-160 (Alison Dec. Ex. 16). The document lists the estate’s “memorabilia” such as correspondence, awards, instruments and clothing, as well as “intellectual property,” such as “master recordings,” a “publishing catalog” and “master films.” *Id.* at 157 (Alison Dec. Ex. 16). Among the materials that survived the 2011 fire at the 3405 Belmont property are “some 1800 individual master reels, hard drives, DAT tapes, and video recordings,” as shown below:



Id. at 160, 189-90 (Alison Dec. Exs. 16 and 21). *See also* 8 TTABVUE 177-79 (Alison Dec. Ex. 18).

Opposer plans “to release albums from these ‘lost’ Cowboy Arms recordings under the Cowboy Arms mark.” 7 TTABVUE 15 (Alison Dec. ¶ 36). Alison and Niles have worked on the lost recordings at a studio in Opposer’s current office (Alison’s home) which they have called THE COWBOY ARMS HOTEL AND RECORDING SPA, i.e., the mark Applicant seeks to register. *Id.* (Alison Dec. ¶ 37); 28 TTABVUE 28-29 (Alison Cross Tr. 27-28). Opposer “also had discussions with a media and technology company about making a film about Cowboy Jack.” 7 TTABVUE 15 (Alison Dec. ¶ 38).

It appears that Opposer’s efforts may be coming to fruition. In May 2021 entertainment publication VARIETY reported that Cowboy Jack’s family, “represented by daughter Alison Clement,” sold the rights to a film about Cowboy Jack, as shown below:



31 TTABVUE 146-47 (highlighting added). The article states:

Cowboy Jack Clement, legendary in music circles for everything from being present at the birth of rock 'n' roll at Sun Studios to writing hits for Johnny Cash to eventually working with U2, has been pegged as the subject of a feature film that Nashville's Visionary Media Group has signed a deal with Clement's estate to develop. Additionally, plans are afoot for an all-star album that would have singers and songwriters that knew Clement finishing and recording unfinished songs that he left behind.

Id. at 146. *See also id.* at 152-53 (article from THE BOOT) (“Cowboy Jack Clement is heading to the big screen. A feature-length biopic on the singer, songwriter and producer is on the way, with an added bonus of 25 previously unreleased songs.”).

F. Applicant’s and ZMG’s Use of the Home, the Original Studio and the Involved Mark

“ZMG has operated music recording studios,” including in Cowboy Jack’s former home at 3405 Belmont. 20 TTABVUE 2 (Zavitson Dec. ¶ 3). As ZMG’s CEO Mr. Zavitson explains it, Beverly Miller, who acquired the home in 2014, “was a business associate of ZMG when ZMG operated the studio. Ms. Miller owned the premises located at 3405 Belmont ... during that time, and ZMG operated the Studio with permission from Ms. Miller.” *Id.* (Zavitson Dec. 4). Applicant describes Ms. Miller as Mr. Zavitson’s “partner.” 23 TTABVUE 4 (App. Dec. ¶ 16).

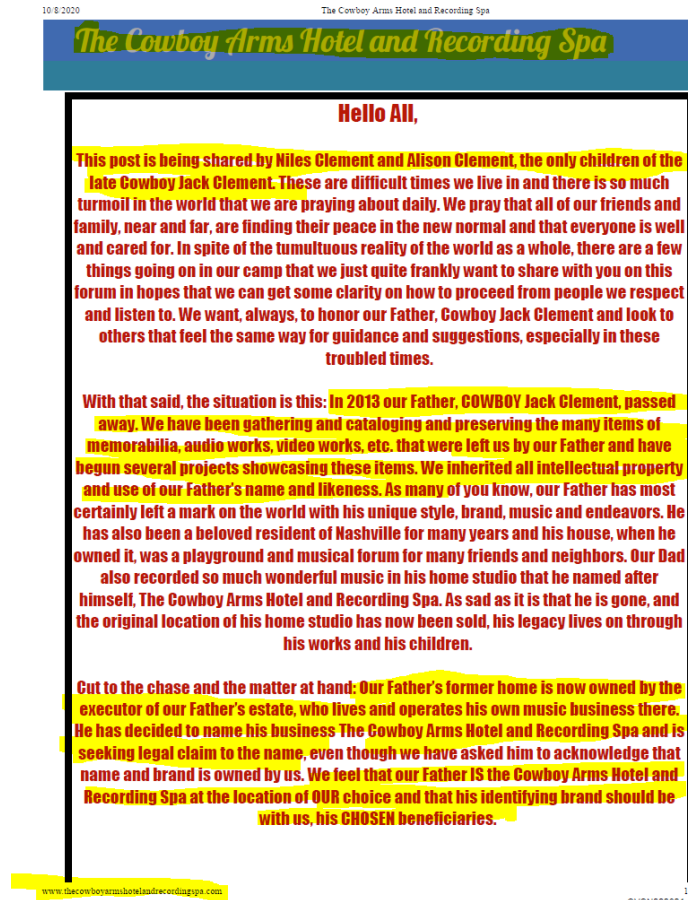
It appears that ZMG did not take over operation of Cowboy Jack’s home studio through serendipity. To the contrary, Mr. Zavitson “encouraged Ms. Miller to purchase the Studio **because of its famous history and name.**” 20 TTABVUE 3 (Zavitson Dec. ¶ 6) (emphasis added). Perhaps not surprisingly, ZMG and Mr. Zavitson “always used the name ‘The Cowboy Arms Hotel and Recording Spa’ to identify the Studio during the time ZMG operated the studio with permission from Ms. Miller.” *Id.* at 2 (Zavitson Dec. ¶ 5). In fact, “[d]uring the time that ZMG operated the Studio, ZMG granted Chance Martin p/k/a Alamo Jones permission to broadcast his well-known radio program on XM’s Outlaw Country from the Studio and to use the name ‘The Cowboy Arms Hotel and Recording Spa.’” *Id.* at 3 (Zavitson Dec. ¶ 7).

SiriusXM's Facebook page promoted a live John Prine performance from THE COWBOY ARMS HOTEL AND RECORDING SPA during this time:



22 TTABVUE 6 (highlighting added). The Facebook post is referring to Cowboy Jack's original studio at 3405 Belmont that Cowboy Jack called THE COWBOY ARMS HOTEL AND RECORDING SPA, and that ZMG used with Beverly Miller's "permission," not the studio Opposer uses in Alison's home that is also called THE COWBOY ARMS HOTEL AND RECORDING SPA.

Prior to Applicant's purchase of the 3405 Belmont house from Beverly Miller, Alison was unaware that Applicant, ZMG or any other person or company was using the involved mark. 7 TTABVUE 17-18 (Alison Dec. ¶ 43). Alison and Niles have "made public our objections to [Applicant] referring to his business as The Cowboy Arms Hotel and Recording Spa," including on their website, as shown below:



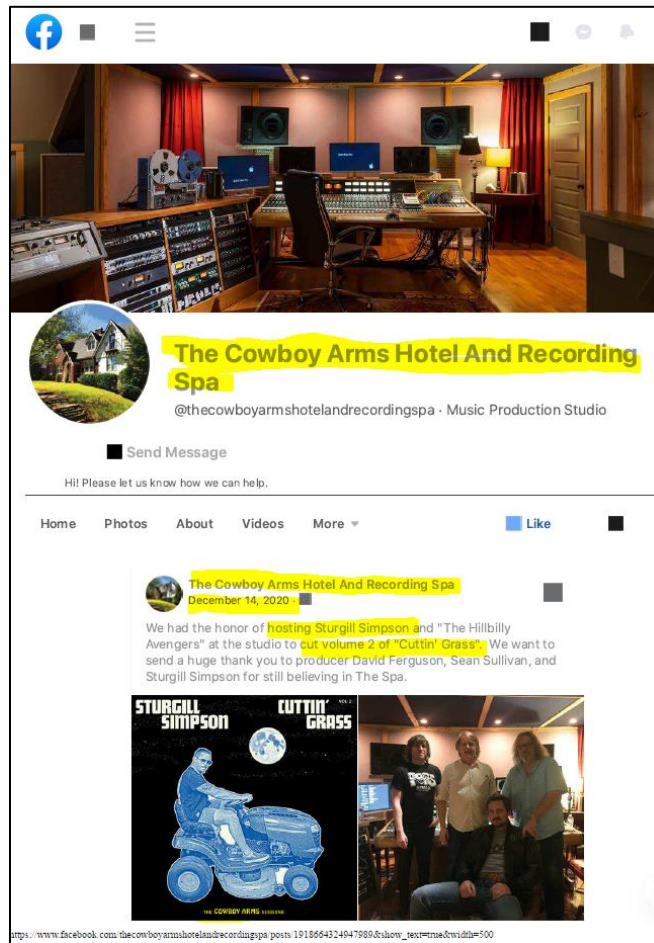
Id. at 18, 206-07 (Alison Dec. ¶ 44 and Ex. 29) (highlighting added). The website post states:

Our father's former home is now owned by the executor of our Father's estate, who lives and operates his own music business there. He has decided to name his business The Cowboy Arms Hotel and Recording Spa and is seeking legal claim to the name, even though we have asked him to acknowledge that name and brand is owned by us. We feel that our Father IS the Cowboy Arms Hotel and Recording Spa at the location of OUR choice and that his identifying brand should be with us, his CHOSEN beneficiaries.

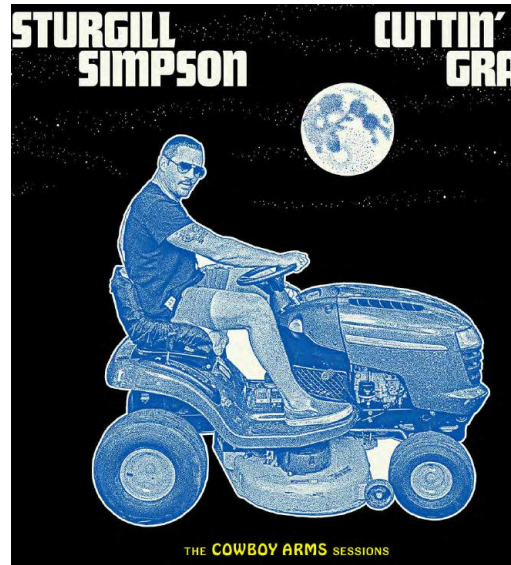
Id. at 206.

While Applicant is now using the involved mark THE COWBOY ARMS HOTEL AND RECORDING SPA, portions of the consuming public and the media seem to

perceive the mark as identifying Opposer rather than Applicant. For example, in December 2020, country star Sturgill Simpson recorded Volume 2 of his “Cuttin’ Grass” album at Applicant’s 3405 Belmont studio, as shown below:



31 TTABVUE 155 (highlighting added). As shown at the bottom center of the album cover, the album is subtitled “THE **COWBOY ARMS SESSIONS**”:



Id. at 185 (highlighting added). However, the media apparently perceives the subtitle as a reference to Cowboy Jack and his studio services offered under the mark THE COWBOY ARMS HOTEL AND RECORDING SPA. 31 TTABVUE 164 (THE TENNESSEAN article about the album stating “David Ferguson produced ‘Vol. 2,’ named after Cowboy Jack Clement’s Cowboy Arms Hotel and Recording Spa in Nashville.”); 31 TTABVUE 167 (article about the album in “savingcountrymusic.com” stating “Named after the infamous Cowboy Arms Hotel and Recording Spa where Country Music Hall of Famer and producer ‘Cowboy’ Jack Clement plied his craft for many years”).

IV. Opposer’s Entitlement to a Statutory Cause of Action

Entitlement to a statutory cause of action is a requirement in every inter partes case. *Australian Therapeutic Supplies Pty. Ltd. v. Naked TM, LLC*, 965 F.3d 1370, 2020 USPQ2d 10837, at *3 (Fed. Cir. 2020), *cert. denied*, 142 S.Ct. 82 (2021) (citing *Lexmark Int’l, Inc. v. Static Control Components, Inc.*, 572 U.S. 118, 125-26 (2014)).

A plaintiff may oppose registration of a mark when doing so is within the zone of interests protected by the statute and it 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, at * 6-7 (Fed. Cir. 2020), *cert. denied*, 141 S.Ct. 2671 (2021) (holding that the test in *Lexmark* is met by demonstrating a real interest in opposing or cancelling a registration of a mark, which satisfies the zone-of-interests requirement, and a reasonable belief in damage by the registration of a mark, which demonstrates damage proximately caused by registration of the mark).

Here, Opposer's current and planned uses of the mark THE COWBOY ARMS HOTEL AND RECORDING SPA for musical production and recording studio services establish that it is entitled to oppose registration of Applicant's identical mark for overlapping services. 7 TTABVUE 8-9, 12, 13-16 (Alison Dec. ¶¶ 19-20, 29, 32-41); *Syngenta Crop Prot. Inc. v. Bio-Chek LLC*, 90 USPQ2d 1112, 1118 (TTAB 2009) (testimony that opposer uses its mark "is sufficient to support opposer's allegations of a reasonable belief that it would be damaged ..."); *Am. Vitamin Prods. Inc. v. Dow Brands Inc.*, 22 USPQ2d 1313, 1314 (TTAB 1992) (petitioner was entitled to seek cancellation on ground of abandonment because it "is engaged in the manufacture and sale of goods which are related to those identified in the subject registrations," and intended to be offered under a mark identical to respondent's).

V. Opposer's Ownership Claim and Applicant's Abandonment Defense

As indicated, Opposer's pleaded claims are likelihood of confusion and dilution, Applicant's remaining defense is abandonment and Applicant also alleges that Opposer does not own the involved mark. 1 TTABVUE 6-8 (Notice of Opposition

¶¶ 19-29); 4 TTABVUE 7-8, 10 (Answer ¶¶ 43-48, 58-59). The parties and the record have made clear, however, that ownership is the crux of this case. Indeed, Applicant does not dispute that Opposer owned the involved mark prior to Cowboy Jack's death, but alleges that Opposer assigned or abandoned that mark thereafter. 4 TTABVUE 2, 3 (Answer ¶¶ 4, 5); 35 TTABVUE 8, 14, 18-22, 24-25.

More specifically, the record shows that Opposer was the first to use the involved mark for musical recordings and audio recording services. 7 TTABVUE 5-6 (Alison Dec. ¶ 12); 21 TTABVUE 14 (Niles Cross Tr. 13). In his Trial Brief, Applicant agrees: "The Mark is a fanciful name dreamed up by Niles and Alison's father, legendary songwriter, record producer, and Country Music Hall of Fame member Jack Clement ('Decedent')." 35 TTABVUE 5 (Applicant's Trial Brief at 4).⁵ And, according to Applicant's Trial Brief: (1) "[b]oth parties agree that [Cowboy Jack] started using the Mark in interstate commerce to identify the Studio sometime around 1975;" (2) ZMG did not begin using THE COWBOY ARMS HOTEL AND RECORDING SPA mark until June 2014 at the earliest, when Ms. Miller purchased the property; and (3) Applicant did not begin using the mark until "after" his January 2018 purchase of the 3405 Belmont property from Ms. Miller. 35 TTABVUE 5-7.

In his Trial Brief, Applicant frames his non-ownership claim and abandonment defense as alternatives, rather than as interlinked, as follows:

Applicant respectfully submits the Board should find,
based on the record in this case, that the Mark became

⁵ Moreover, in a Facebook post submitted as a specimen with Applicant's involved application, Applicant refers to the studio as "the legendary home studio of hall of famer Cowboy Jack Clement." Substitute Specimen submitted with October 24, 2019 Office Action response; 23 TTABVUE 6-7, 86 (App. Dec. ¶ 28 and Ex. I).

distinctive many years prior to Decedent's death, that the public came to identify the Studio as the source of recording services provided there to iconic recording artists, and that the Mark has been in continuous use to identify the Studio since no later than 1975. The Board should further find that Opposer transferred the Mark to Ms. Miller in June, 2014, that she transferred the Mark to Applicant in January, 2018, and that Applicant has the right to a federal registration for the Mark.

In the event the Board determines that Opposer did not transfer the Mark to Ms. Miller, Applicant respectfully submits that it should find that Opposer abandoned the Mark, that Applicant acquired rights in the Mark through his use of the Mark in interstate commerce in connection with the goods and services he provides at the Studio, and that Applicant has the right to a federal registration for the Mark.

35 TTABVUE 8.

For its part, Opposer wholeheartedly agrees that this case is about ownership of the mark. Indeed, Opposer opens its Trial Brief as follows: "This case involves a **family dispute concerning ownership of a trademark** created by and forever closely tied to a country music icon." 34 TTABVUE 7 (emphasis added); *see also id.* ("This opposition proceeding concerns the ownership of the Mark."). Later in its Trial Brief, Opposer points out that the parties "both claim ownership of a mark originating from the exact same source – Cowboy Jack," and argues that "Applicant's registration of the Mark will confuse the public **about who owns the Mark and is associated with and in control of Cowboy Jack's legacy and business.**" 34 TTABVUE 24-25 (emphasis added).

More to the point, each party also introduced ownership evidence in support of its position. Specifically, Applicant submitted evidence regarding the chain of title of the

3405 Belmont property, and Opposer submitted evidence that it never assigned the involved mark. Neither party objected to the other's introduction of evidence on the question of ownership, and both were apprised that the evidence related to ownership. Indeed, ownership was first raised at the outset of this case, in Applicant's answer, as a purported "affirmative defense." 4 TTABVUE 10 (Answer ¶ 58) ("Applicant was the true owner of the mark").

Therefore, even if ownership was not expressly pled through Applicant's non-ownership "affirmative defense," as we have repeatedly done in similar circumstances, we find here that the question of ownership is the heart of this case and that it was tried by implied (if not express) consent under Fed. R. Civ. P. 15(b)(2). *See e.g., UVeritech, Inc. v. Amax Lighting, Inc.*, 115 USPQ2d 1242, 1244-45 (TTAB 2015); *Conolty v. Conalty O'Connor NYC, LLC*, 111 USPQ2d 1302, 1304-05 (TTAB 2015); *Nahshin v. Product Source Int'l LLC*, 107 USPQ2d 1257, 1258 (TTAB 2013); TBMP § 507.03(b).

We consider Applicant's abandonment defense first, however, because even though it is framed as Applicant's "alternative" position, if successful, the defense would effectively resolve this case. *Cf. W. Fla. Seafood, Inc. v. Jet Rests., Inc.*, 31 F.3d 1122, 31 USPQ2d 1660, 1666 (Fed. Cir. 1994) (finding, in likelihood of confusion case, that the respondent's "abandonment allegation is, in effect, in the stance of a defense to a prior use assertion"). Indeed, if Opposer abandoned the mark, it would be available for anyone else to adopt and use, and thus own, and there is no dispute that Applicant started using the involved mark himself after Opposer allegedly abandoned

it. *Cf. Azeka Bldg. Corp. v. Azeka*, 122 USPQ2d 1477, 1483 (TTAB 2017) (“when a mark is abandoned, as Applicant claims in this case, it becomes available for others to adopt and use as a trademark”).

A. Applicant’s Abandonment Defense

Under Section 45 of the Act, 15 U.S.C. § 1127, a mark is considered abandoned when “its use has been discontinued with intent not to resume such use,” and “[n]onuse for 3 consecutive years shall be prima facie evidence of abandonment.” “Use” of a mark “means the bona fide use of such mark made in the ordinary course of trade, and not merely to reserve a right in a mark.” 15 U.S.C. § 1127. Applicant “bears at minimum a burden of coming forth with some evidence of abandonment” to establish its defense *Kemi Organics, LLC v. Gupta*, 126 USPQ2d 1601, 1605 (TTAB 2018) (quoting *W. Fla. Seafood*, 31 USPQ2d at 1666).

Thus, if Applicant “can show three consecutive years of nonuse, it has established a *prima facie* showing of abandonment, creating a rebuttable presumption that [Opposer] has abandoned the mark without intent to resume use.” *ShutEmDown Sports Inc. v. Lacy*, 102 USPQ2d 1036, 1042 (TTAB 2012). Applicant bears the burden of proof to establish its case by a preponderance of the evidence. *See On-Line Careline, Inc. v. Am. Online, Inc.*, 229 F.3d 1080, 56 USPQ2d 1471, 1476 (Fed. Cir. 2000); and *Cerveceria Centroamericana, S.A. v. Cerveceria India, Inc.*, 892 F.2d 1021, 13 USPQ2d 1307, 1309 (Fed. Cir. 1989). If Applicant makes a prima facie case of abandonment, the burden of production, i.e., of going forward, shifts to Opposer to rebut the prima facie showing with evidence, but “[t]he burden of persuasion remains with [Applicant] to prove abandonment by a preponderance of the evidence.”

ShutEmDown Sports, 102 USPQ2d at 1042. *See also Crash Dummy Movie, LLC v. Mattel, Inc.*, 601 F.3d 1387, 94 USPQ2d 1315, 1316 (Fed. Cir. 2010) (discussing the burden of proof in the context of an abandonment defense).⁶

Here, Applicant has not introduced any evidence that there was a three year long period of nonuse (or any period of nonuse). Applicant argues, however, that Opposer “concedes” that it “did not use the Mark for a period of three years.” 35 TTABVUE 25. Applicant is incorrect. Opposer concedes nothing of the kind, and has introduced evidence to the contrary.

For example, a primary aspect of Opposer’s business is to collect royalties on songs it owns or in which it has rights, and it has done so continuously since before Cowboy Jack’s death, including the periods before and after the 3405 Belmont property was sold to Ms. Miller and then by Ms. Miller to Applicant, and before and after Applicant filed the involved application. 7 TTABVUE 12 (Alison Dec. ¶ 29); 9 TTABVUE 4-5 and 11 TTABVUE 8-600 (Brady Dec. ¶¶ 8-12 and Exs. A and B).⁷ In any event, Applicant has failed to introduce evidence of nonuse, and Opposer has not admitted nonuse; thus, Applicant has failed to meet his burden.

⁶ Thus, Applicant’s argument that Opposer bears “the burden of proof to show that [it has] not abandoned the Mark,” 35 TTABVUE 25, is not well taken.

⁷ Opposer registered Cowboy Arms Music songs (“On My Way Back Home” and “Talking Pickup Truck Blues”) with ASCAP in 2019, and “has received royalty payments from ASCAP as recently as March 2021.” 7 TTABVUE 12 (Alison Dec. ¶ 29); 9 TTABVUE 4-5 (Brady Dec. ¶¶ 9, 11). Opposer also received royalties from HFA between 2014-2019. 7 TTABVUE 12 (Alison Dec. ¶ 29). The most distinctive part of both COWBOY ARMS MUSIC and THE COWBOY ARMS HOTEL AND RECORDING SPA is COWBOY ARMS.

Even if Applicant had established a three year period of nonuse, or otherwise met his burden to make a prima facie case of abandonment, which he has not, Opposer's evidence would establish its intent to resume use. Indeed, Opposer found a new location for its recording studio (Alison's home) after Applicant took over Cowboy Jack's studio at 3405 Belmont. 7 TTABVUE 15 (Alison Dec. ¶ 37); 28 TTABVUE 28-29 (Alison Cross Tr. 27-28). Opposer intends to release albums and "lost recordings," sell merchandise and perhaps create a radio show or podcast. 7 TTABVUE 13, 15 (Alison Dec. ¶¶ 32, 36). It has also had what are apparently successful negotiations, at least thus far, to make a film about Cowboy Jack. *Id.* at 15 (Alison Dec. ¶ 38); 31 TTABVUE 146-47, 152-53. These are exactly the types of activities which have been found to establish an intent to resume use. *See Crash Dummy Movie*, 94 USPQ2d at 1317-18 (continuous "product development activities," including negotiations to offer product under the mark, whether successful or not, showed intent to resume use, holding: "Although Mattel did not ultimately enter into the KB Toys agreement, no evidence suggests that Mattel rejected the business opportunity because it decided to abandon the marks."); *Peterson v. Awshucks SC, LLC*, 2020 USPQ2d 11526 at *16-17 (TTAB 2020) ("Respondent's efforts to find a new location for the restaurant," and reopening at the new location "demonstrates that Respondent maintained an intent to resume use of the mark").

"Intent to resume use in abandonment cases has been equated with a showing of special circumstances which excuse" nonuse. *Imperial Tobacco Ltd. v. Philip Morris, Inc.*, 899 F.2d 1575, 14 USPQ2d 1390, 1395 (Fed. Cir. 1990). Thus, "[i]f a mark

owner's nonuse is excusable, it has overcome the presumption that its nonuse was coupled with an intent not to resume use." *Exec. Coach Builders., Inc. v. SPV Coach Co., Inc.* 123 USPQ2d 1175, 1198 (TTAB 2017).

Here, any nonuse by Opposer would be excusable. Indeed, following Cowboy Jack's death, Niles and Alison's husband both had "significant health issues" and Alison cared for both of them. 7 TTABVUE 12-13 (Alison Dec. ¶ 30); 10 TTABVUE 8 (Niles Dec. ¶ 19). Moreover, Niles and Alison desired to use the involved mark but were blocked by Applicant, acting as executor of Cowboy Jack's will and self-appointed temporary President of Opposer. 7 TTABVUE 10 (Alison Dec. ¶¶ 23-24); 10 TTABVUE 5 (Niles Dec. ¶ 9). Thus, any nonuse was the result of "special circumstances" and "outside causes." *P.A.B. Produits Et Appareils de Beaute v. Satinine SNC di S.A. e.M. Usellini*, 570 F.2d 328, 196 USPQ 801, 806 (CCPA 1978) ("the inference of abandonment is readily rebutted by a showing that such nonuse was due to special circumstances which excuse the same and not due to any intention to abandon the mark"); *Miller Brewing Co. v. v Oland's Breweries [1971] Ltd.*, 548 F.2d 349, 192 USPQ 266, 267 (CCPA 1976). *See generally ARSA Dist., Inc. v. Salud Natural Mexicana S.A. de C.V.*, 2022 USPQ2d 887 (TTAB 2022); TMEP § 1604.11 (2022) (in context of Section 8 affidavit, nonuse resulting from "illness" is "often excusable").

Thus, even if Applicant had made out a prima facie case of abandonment, Opposer has established an intent to resume use. Applicant has not established its abandonment defense.

B. Does Applicant Own the Mark?

“[O]nly the owner of the mark may file an application” to register it. *Wonderbread 5 v. Gilles*, 115 USPQ2d 1296, 1303 (TTAB 2015); *see also In re Deister Concentrator Co.*, 289 F.2d 496, 129 USPQ 314, 320 (CCPA 1961). Thus, “an application filed by one who is not the owner of the mark sought to be registered is a void application.” *In re Tong Yang Cement Corp.*, 19 USPQ2d 1689, 1690 (TTAB 1991) (citing *In re Techsonic Indus., Inc.*, 216 USPQ 619 (TTAB 1982)). *See also* 15 U.S.C. § 1051(a); *Lyons v. Am. Coll. of Veterinary Sports Med. & Rehab.*, 859 F.3d 1023, 123 USPQ2d 1024, 1027 (Fed. Cir. 2017) (“[R]egistration by one who did not own the mark at the time of filing renders the underlying application void ab initio.”) (citations omitted); *Huang v. Tzu Wei Chen Food Co., Ltd.*, 849 F.2d 1458, 7 USPQ2d 1335 (Fed. Cir. 1988); *Great Seats, Ltd. v. Great Seats, Inc.*, 84 USPQ2d 1235, 1239 (TTAB 2007) (“In a use-based application under Trademark Act Section 1(a), only the owner of the mark may file the application for registration of the mark; if the entity filing the application is not the owner of the mark as of the filing date, the application is void ab initio.”); Trademark Rule 2.71(d), 37 C.F.R. § 2.71(d) (“An application filed in the name of an entity that did not own the mark as of the filing date of the application is void.”).

“In cases such as this where the parties have either a prior or current relationship, the question of [which party] is, in fact, the owner of the mark ‘must be determined on a case by case basis dependent on the particular facts adduced in each case.’” *Wonderbread 5*, 115 USPQ2d at 1303 (quoting *In re Briggs*, 229 USPQ 76, 77 (TTAB 1986). Generally, however, 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.

While we recognize that this case does not involve an ownership dispute "between a departing member and the remnant group," as the *Lyons* case did, we do not believe the factual differences between this case and *Lyons* render the *Lyons* test inapplicable here. In fact, the *Lyons* factors are substantially similar to and in some ways subsume those applied in other types of ownership disputes. *Cf. Veritech, Inc. v. Amax Lighting, Inc.*, 115 USPQ2d 1242, 1249 (TTAB 2015); *Wrist-Rocket Mfg. Co. v. Saunders*, 379 F.Supp. 902, 183 USPQ 17 (D. Neb. 1974), *aff'd in part and rev'd in part*, 516 F.2d 846, 186 USPQ 5 (8th Cir. 1975). At the same time, we recognize that the facts of this case are sui generis and we therefore do not apply the *Lyons* factors mechanically or exclusively; rather, they guide our analysis of the record. *CBC Mortgage Agency v. TMRR, LLC*, 2022 USPQ2d 748, at *17 (TTAB 2022).

Opposer bears the burden of proving by a preponderance of the evidence that Applicant does not own the involved mark. *Wonderbread 5*, 115 USPQ2d at 1302.

1. The Parties' Objective Intentions or Expectations

As shown above, Opposer did not intend or expect that Applicant would ever own the involved mark. Nor did its predecessor-in-interest, Cowboy Jack.

There is no dispute that Cowboy Jack "created" the mark, and used it, through Opposer, for most of his adult life. Indeed, as Applicant puts it, "[b]oth parties agree that [Cowboy Jack] started using the Mark in interstate commerce to identify the

Studio sometime around 1975.” 35 TTABVUE 5. Opposer has also established, and Applicant does not dispute, that Opposer owned the 3405 Belmont property, including the recording studio that the mark identifies, at the time Cowboy Jack died. 7 TTABVUE 4, 6-7, 80-85 (Alison Dec. ¶ 9, 15 and Ex. 9); 12 TTABVUE 53-55. 21 TTABVUE 8 (Niles Cross Tr. 7).

Opposer’s intentions and expectations are reflected in its former owner Cowboy Jack’s will. There is no dispute that pursuant to that will Alison and Niles became Opposer’s co-owners, and thus the owners of the home and the studio inside the home that their father built, made iconic under the involved mark and assigned to Opposer. Applicant admits that Alison and Niles “inherited compete ownership of [Opposer] from [Cowboy Jack].” 12 TTABVUE 143 (response to Request for Admission No. 2).

While Cowboy Jack’s will apparently omitted specific mention of Opposer’s intellectual property, such as the involved mark, that silence shows that Cowboy Jack intended and expected that Alison and Niles would inherit Opposer’s intellectual property as part of their inheritance. Indeed, with minor and irrelevant exceptions, Alison and Niles “received and split 50/50 **all** of [their] father’s property, assets and belongings.” 7 TTABVUE 7 (Alison Dec. ¶ 16) (emphasis added); 10 TTABVUE 2, 5 (Niles Dec. ¶ 2). This includes Opposer, and thus Opposer’s intellectual property. As Cowboy Jack and Opposer intended and expected, and as Cowboy Jack directed in his will, Alison and Niles became owners of Opposer, its 3405 Belmont property, and its studio.

Applicant nonetheless contends that even though Alison and Niles “received and split 50/50” all of Cowboy Jack’s assets, including Opposer, “Opposer transferred the Mark to Ms. Miller in June, 2014,” and Ms. Miller “transferred the Mark to Applicant in January, 2018.” 35 TTABVue 8. To the extent Applicant intended to acquire the involved mark through these transactions, trademark law makes the intended result impossible under these circumstances, and even if Applicant expected that a trademark could be transferred through the mere sale of a residence, any such expectation would have been unreasonable, for at least three reasons.

First, there is absolutely no evidence to support Applicant’s contention, and Applicant’s mere “[a]ttorney argument is no substitute for evidence.” *Cai v. Diamond Hong, Inc.*, 901 F.3d 1367, 127 USPQ2d 1797, 1799 (Fed. Cir. 2018)) (quoting *Enzo Biochem, Inc. v. Gen-Probe Inc.*, 424 F.3d 1276, 1284, 76 USPQ2d 1616, 1622 (Fed. Cir. 2005)); see also *In re U.S. Tsubaki, Inc.*, 109 USPQ2d 2002, 2006 (TTAB 2014) (finding that there was no proof to support the statements in the record by counsel). While “an assignment in writing is not necessary to pass rights in a trademark,” and oral testimony may be sufficient to establish that there was an assignment, the oral testimony must be “clear and uncontradictory.” *Diebold, Inc. v. Multra-Guard, Inc.*, 189 USPQ 119, 124 (TTAB 1975). Here there is no oral testimony that the trademark was assigned, much less “clear and uncontradictory” testimony, nor is there any documentary or other evidence showing that the involved mark was assigned to Ms. Miller or Applicant.

Second, “the common law rights in a mark will be presumed to have passed, absent contrary evidence, with the sale and transfer of the business with which the mark has been identified.” See *Loma Linda Food Co. v. Thomson & Taylor Spice Co.*, 279 F.2d 522, 126 USPQ 261, 262 (CCPA 1960) (agreement that “does not specifically mention the trademark,” but transferred an entire business, found “quite sufficient to evidence and effectuate the intention of the parties to transfer the trademark”); *Sales Analysis Inst., Inc. v. Sales Training, Inc.*, 181 USPQ 341, 345 (TTAB 1973); *Sun Valley Co. Inc. v. Sun Valley Mfg. Co.*, 167 USPQ 304, 309 (TTAB 1970) (*citing, e.g., Clark Equip. Co. v. The Baker-Lull Corp.*, 288 F.2d 926, 129 USPQ 220 (CCPA 1961)). See also *Uptown Grill, L.L.C. v. Camellia Grill Holdings, Inc.*, 920 F.3d 243, 248 (5th Cir. 2019) (“When a business is sold as a ‘going concern, trademarks and the good will of the business ... are presumed to pass with the sale of the business.”) (quoting 3 MCCARTHY ON TRADEMARKS & UNFAIR COMPETITION § 18.37 (5th ed. 2019)); *Yellowbook, Inc. v. Brandeberry*, 708 F.3d 837, 105 USPQ2d 1901, 1905 (6th Cir. 2013) (“ownership of trademarks impliedly passes with ownership of a business, without express language to the contrary”). In other words, it does not matter that Cowboy Jack’s will did not mention Opposer’s trademarks specifically; those marks presumptively passed along with Opposer and its associated goodwill to Alison and Niles. Applicant has introduced no evidence to the contrary.

Third, Applicant’s theory that Cowboy Jack bequeathed Opposer in its entirety to Alison and Niles, 12 TTABVUE 143 (Response to Request for Admission No. 2), but “transferred the Mark to Ms. Miller,” 35 TTABVUE 8, is a legal impossibility. Indeed,

if, as Applicant apparently contends, Opposer was bequeathed to Alison and Niles, without the involved mark, while the involved mark was somehow transferred to Ms. Miller apart from Opposer's business (which now belongs to Alison and Niles), the purported assignment to Ms. Miller would have been "in gross" and thus invalid. *VISA, U.S.A., Inc. v. Birmingham Trust Nat'l Bank*, 696 F.2d 1371, 216 USPQ 649, 651-52 (Fed. Cir. 1982) ("a mark may be transferred only in connection with the transfer of the goodwill of which it is a part. A naked transfer of the mark alone – known as a transfer in gross – is invalid."); *Warner-Lambert Pharm. Co. v. General Foods Corp.*, 164 USPQ 532, 533 (TTAB 1970) ("It is fundamental that to effect a valid transfer of title to a mark it must be accompanied by the business with which the mark has been associated."). *See also Haymaker Sports, Inc. v. Turian*, 581 F.2d 257, 198 USPQ 610, 613 (CCPA 1978) ("Notwithstanding that the agreement recited pro forma that goodwill was transferred along with the mark, Block and Moran never played an active role in the business of Avon, never used the mark themselves, and never acquired any tangible assets or goodwill of Avon. Therefore, we conclude that, as a matter of substance, the assignment was invalid as an assignment in gross, rendering the latter assignment to Turian also invalid.").⁸

⁸ We decline Applicant's invitation to "infer that Russ Zavitsen believed when he recommended to Beverly Miller that she buy the Property that the famous name was part of the offering made in the listing. It is also reasonable to infer that Ms. Miller may have relied on the listing to believe that the Mark was impliedly part of the sale." 35 TTABVue 19. There is no basis upon which to draw the proposed inferences, nor would Mr. Zavitsen's or Ms. Miller's "beliefs" result in a trademark assignment, much less an assignment in gross, which would have been legally impermissible.

In short, the evidence all points in one direction: Cowboy Jack bequeathed his music businesses, including Opposer (which owns the involved mark) to Alison and Niles. We presume this transfer to include all associated trademarks and service marks, and Applicant has not rebutted the presumption. Indeed, as explained above, Applicant's theory that the involved mark was transferred to Ms. Miller and then to Applicant has no evidentiary support whatsoever.⁹

2. Who the Public Associates With the Involved Mark

Cowboy Jack and Opposer used the service mark THE COWBOY ARMS HOTEL AND RECORDING SPA for approximately 38 years before Cowboy Jack passed away. There is no dispute that during that time the public associated the mark with Cowboy Jack, a Country Music Hall of Fame member who the parties agree was "legendary" and "iconic." There is no evidence whatsoever that in the year following Cowboy Jack's death the public suddenly disassociated the mark from Cowboy Jack, whose music continued to be popular, and in that short period of time somehow came to associate the mark with Ms. Miller or ZMG, or later Applicant.

Moreover, there is evidence that despite ZMG and Applicant using the mark for the recording studio at 3405 Belmont, the public nevertheless continued to associate the mark with Cowboy Jack and his services. 31 TTABVUE 164, 167. In fact,

⁹ Applicant seems to posit that the involved service mark was somehow attached to and part of the 3405 Belmont property, rather than Opposer's recording studio business. 35 TTABVUE 23-24. This is incorrect. *See generally Stockpot, Inc. v. Stock Pot Rest., Inc.*, 220 USPQ 52, 57 (TTAB 1983), *aff'd* 737 F.2d 1576, 222 USPQ 665 (Fed. Cir. 1984) ("While we agree that location is frequently an important part of the goodwill of a restaurant mark, location in this sense obviously does not mean a particular building on a particular plot of land. Indeed a valid transfer of a service mark does not require the transfer of any physical or tangible assets as long as there is a transfer of the goodwill to which the mark pertains.").

Applicant himself apparently contributed to the public continuing to associate the involved mark with Cowboy Jack and Opposer, even after Applicant started doing business in the 3405 Belmont studio, because Applicant promoted the studio's and his own connection to Cowboy Jack. 23 TTABVue 6-7, 82, 86 (App. Dec. ¶ 28 and Ex. I). *See Lyons*, 123 USPQ2d at 1031 (finding that "the relevant public looks to the College, not Lyons," in part because "the College, not Lyons, is listed on the AVMA's website regarding the VSO bearing the mark").

C. To Whom the Public Looks to Stand Behind the Quality of the Services

Because Cowboy Jack and Opposer used the mark for so much longer than Applicant, and had so much more success than Applicant, the public will look to Opposer, Cowboy Jack's business now run by his children, to stand behind the quality of the services provided under the involved mark. Applicant is a relative unknown, and even if he were not, because he shares Cowboy Jack's last name and associates his services with Cowboy Jack, 23 TTABVue 6-7, 82, 86 (App. Dec. ¶ 28 and Ex. I), the public would likely believe that Cowboy Jack or Opposer continue to stand behind the quality of the services offered under the involved mark.¹⁰

VI. Conclusion

Cowboy Jack's children inherited from him both Opposer and Cowboy Jack's other assets. There is no evidence that Applicant inherited anything from Cowboy Jack,

¹⁰ Even if the evidence did not conclusively establish that Alison and Niles own Opposer and thus the involved mark, to prevail on its non-ownership claim, Opposer need not establish Opposer's ownership of the mark or Alison's and Niles's ownership of Opposer. Opposer need only establish that Applicant does not own the mark. *Conolty*, 111 USPQ2d at 1302. It has done so.

that Opposer assigned anything to Applicant, or, more to the point, that Applicant ever acquired or owns the involved mark.

Decision: The notice of opposition is sustained.¹¹

¹¹ Because we have resolved this proceeding on Opposer's non-ownership claim, we need not and do not reach Opposer's other claims. *Yazhong Inv. Ltd. v. Multi-Media Tech Ventures, Ltd.*, 126 USPQ2d 1526, 1540 (TTAB 2018); *Multisorb Tech., Inc. v. Pactiv Corp.*, 109 USPQ2d 1170, 1171 (TTAB 2013).