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



ROBERT J. GLOVSKY,
Petitioner,
v.
RICHARD A. SHAFFER,
Registrant.

06-21-2002
U.S. Patent & TMO/TM Mail Rpt Dt. #34

Cancellation Petition No. 31688

TRADEMARK TRIAL AND
APPEAL BOARD
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BRIEF OF REGISTRANT

Richard A. Shaffer ("Registrant") hereby submits this brief in opposition to Petitioner's petition to cancel the Registrant's registration of the mark THE MONEY EXPERTS, Registration No. 2,417,142, and in opposition to the Brief of Petitioner, filed May 23, 2002.

Description of the Record

The record consists of (1) the file of Registration No. 2,147,142 for the mark THE MONEY EXPERTS ("Registration File"); (2) the discovery deposition of Registrant Richard A. Shaffer, taken December 6, 2001 ("Shaffer Deposition"); and (3) the trial deposition of Petitioner Robert J. Glovsky, taken December 20, 2001 ("Glovsky Trial Deposition").

Recitation of Facts

I. Registrant's Use of the Mark.

1. Registrant's use of the mark THE MONEY EXPERTS (the "Mark") began in May or June of 1991 when he was asked by Boston radio station WHDH to co-host a radio show. The co-host was Petitioner Robert Glovsky. *Shaffer Deposition, p. 12, line 21 to p. 13, line 15.*

2. Registrant entered into a written agreement with WHDH concerning his participation in the radio show. *Shaffer Deposition*, p. 14, lines 7-9. Petitioner's employer, Tofias, Fleishman & Shapiro, Co. ("TF&S") entered into a written agreement with WHDH concerning the furnishing of Petitioner's services and participation in the radio show. *Glovsky Trial Deposition*, p. 10, lines 12-23; p. 20, lines 4-9. Shaffer's agreement with WHDH, as well as TF&S's agreement with WHDH, recited that the radio show's title would be the property of WHDH.

3. The radio show aired on WHDH with Registrant and Petitioner as co-hosts until 1994. *Shaffer Deposition*, p. 12, lines 19-20.

4. In 1995, the radio show moved to radio station WBNW. *Glovsky Trial Deposition*, p. 13, lines 5-6. Registrant and Petitioner remained as co-hosts of the show. *Shaffer Deposition*, p. 15, lines 22-24. The former station, WHDH, made no objection to the use of the Mark.

5. Registrant entered into a written agreement with WBNW concerning his participation in the radio show. *Shaffer Deposition*, p. 15, lines 19-21. Petitioner's employer, TF&S, entered into a written agreement with WBNW concerning the furnishing of Petitioner's services and participation in the radio show. *Glovsky Trial Deposition*, p. 13, lines 15-16. Shaffer's agreement with WBNW, as well as TF&S's agreement with WBNW, recited that the radio show's title would be the property of WBNW.

6. The radio show aired on WBNW with Registrant and Petitioner as co-hosts until late 1997 or early 1998. *Shaffer Deposition*, p. 17, lines 6-11. *Glovsky Trial Deposition*, p. 15, lines 13-16.

7. In 1995, the radio show moved to radio station WRKO. *Glovsky Trial Deposition*, p. 15, lines 16-23. Registrant and Petitioner remained as co-hosts of the show. Neither of the former stations, WHDH nor WBNW, made any objection to the use of the Mark.

8. Registrant entered into a written agreement with WRKO concerning his participation in the radio show. *Shaffer Deposition*, p. 21, lines 22-23. Petitioner's employer,

TF&S, entered into a written agreement with WRKO concerning the furnishing of Petitioner's services and participation in the radio show. *Glovsky Trial Deposition*, p. 22, line 23 to p. 23, line 5. Shaffer's agreement with WRKO, as well as TF&S's agreement with WRKO recited that the radio show's title would be the property of Registrant and Petitioner. *Shaffer Deposition Exhibit 4*, ¶15.

9. In the summer of 1999, the radio show stopped airing on WRKO when Glovsky decided to leave the show. *Glovsky Trial Deposition*, p. 17, lines 12-20; *Shaffer Deposition*, p. 22, lines 21-24.

10. In July of 1999, Registrant alone began hosting the radio show "The Money Experts" on New Hampshire station WSMN. He did so until September of 1999. *Shaffer Deposition*, p. 23, lines 16-20. None of the former stations, WHDH, WBNW or WRKO, made any objection to the use of the Mark, nor did Petitioner or TF&S make any objection to Registrant's use of the Mark.

11. In September of 1999, Registrant alone began hosting the radio show "The Money Experts" on the Boston station WTKK. *Shaffer Deposition*, p. 25, lines 13-15. None of the former stations, WHDH, WBNW, WRKO or WSMN, made any objection to Registrant's use of the Mark, nor did TF&S make any objection to Registrant's use of the Mark. Sometime in 2001 the name of the program was changed by the radio station due to a threatened lawsuit by Petitioner. *Shaffer Deposition*, p. 26, lines 4-12; 18-20; *Glovsky Trial Deposition*, p. 6, lines 17-20.

II. Registrant's Application for Registration of the Mark.

1. In the summer of 1999, the Registrant, Richard A. Shaffer, filed an application for registration of the mark the MONEY EXPERTS, and recited the goods and services as "[a] radio program dealing with finance/investment/real estate related issues." *Registration File*.

2. The application was received by the Patent and Trademark Office ("PTO") and

given a filing date of July 16, 1999. *Registration File*.

3. The application was filed as an intent-to-use application after the Registrant had contacted the PTO, told the PTO representative the history of his use of the Mark, and requested their advice as to the correct basis of filing. *Shaffer Deposition, pp. 28-30*.

4. Subsequently, on November 18, 1999, the PTO issued Office Action 1 refusing registration, *inter alia*, on the basis that the Mark was descriptive under Trademark Act Section 2(e)(1), 15 U.S.C. Section 1052(e)(1). *Registration File*. The Office Action made clear that the Registrant had the opportunity to respond. *Registration File*.

5. Upon receipt of the Office Action, the Registrant contacted the Examining Attorney, explaining the history of the use of the Mark in connection with radio shows, and subsequently filed a response to the Office Action, submitting evidence of secondary meaning. *Registration File*. Registrant's response was received by the PTO on May 16, 2000. *Registration File*.

6. With the response to the Office Action filed May 16, 2000, Registrant submitted a Statement of Use, reciting a "Date of First Use Anywhere" as May or June, 1991 (with an asterisk), and reciting a "Date of First Use in Commerce" as May or June, 1991 (with an asterisk). *Registration File*. The Registrant's asterisk specifically denoted that "First Use, with co-host. First use as host, July, 1999." *Registration File*.

7. On August 4, 2000, after receiving the form from the PTO, Registrant filed a Declaration under 37 C.F.R Section 2.20 (the "Declaration"). *Shaffer Deposition, p. 32, lines 17-24; Registration File*. Prior to signing the Declaration, Shaffer again spoke at length with the Examining Attorney regarding the history of the radio show and asked the Examining Attorney whether he was within his rights signing the Declaration, and was assured that he was. *Shaffer Deposition, p. 35, lines 14-19*.

8. The Mark was published for opposition on October 10, 2000. No opposition was filed by any party during the opposition period. *Registration File*.

9. Registration No. 2,417,218 for the mark THE MONEY EXPERTS was issued on January 2, 2001. *Registration File.*

Argument

Petitioner seeks cancellation of the mark THE MONEY EXPERTS. The petition should be denied, as the Petitioner lacks standing, and/or Petitioner abandoned the Mark.

I. The Petitioner Lacks Standing.

Petitioner has no standing to maintain this action. There are two separate bases for Petitioner's lack of standing.

A. Petitioner Did Not Acquire Rights in the Mark.

The Lanham Act establishes a standing requirement. Section 14 states, in relevant part:

A petition to cancel a registration of a mark, stating the grounds relied upon, may . . . be filed as follows by any person who believes that he is or will be damaged . . . by the registration of the mark on the principal register . . .

Petitioner must prove "two judicially-created requirements in order to have standing - the [petitioner] must have a 'real interest' in the proceedings and must have a 'reasonable' basis for his belief of damage. *Richie v. Simpson*, 50 U.S.P.Q.2d 1023 (Fed. Cir. 1999). *See also* TBMP §303.03 ("that it has a real interest in the case, that is a personal interest in the outcome of the proceeding").

Although the Registrant and Petitioner co-hosted the radio show "The Money Experts" from 1991 through mid-1999, Petitioner's services were furnished to the various radio stations through his employer, Tofias, Fleishman & Shapiro, Co. ("TF&S"). Any use of the Mark by the co-hosts, and any rights therefrom, would accrue to the parties contracting with the radio stations, *i.e.*, Registrant and TF&S. Petitioner therefor, has no 'real interest' in the proceeding.

Although the 1998 written agreements with WRKO recited that "Shaffer (Registrant) and Robert J. Glovsky (Petitioner) shall own the rights to the name," the WRKO written agreements were between WRKO and Registrant. There was a separate written agreement between WRKO and TF&S. Thus although the written agreements would be binding as between WRKO and

Registrant, and WRKO and TF&S, arguably this does not establish any rights in the Mark, or agreement regarding ownership of the Mark, as between Registrant and Petitioner. Again, if rights accrued to the co-hosts, such rights accrued to TF&S and Registrant, the contracting entity and contracting person providing the services to the radio stations.

None of the radio stations that broadcast the show and purportedly claimed contractual rights in the Mark has made any objection to Registrant's registration of the Mark. TF&S, the entity that provided Petitioner's services as a co-host for the shows, has not made any objection to the Registrant's registration of the Mark. Petitioner has not provided any evidence or otherwise demonstrated that TF&S assigned to him any rights in the Mark it may have acquired through the provision of Petitioner's services as co-host, nor rights to litigate this matter on TF&S's behalf. *Glovsky Trial Deposition, p. 26, lines 14 to p. 27, line 7.* Without such assignment of rights to Petitioner from TF&S, Petitioner lacks standing.

B. Petitioner Abandoned the Mark.

In mid-1999, Petitioner terminated his participation in the radio show. Registrant immediately sought another radio station to air the show, and beginning in July 1999 and ending in September 1999, "The Money Experts" show aired on WSMN, with Registrant as sole host. Immediately subsequent to that use, "The Money Experts" show moved to and began airing on WTKK, with Registrant as sole host. Registrant continues to host the show on WTKK to this day, however, the station changed the name of the show sometime in 2001 after it received a letter from the Petitioner threatening a lawsuit.. *Shaffer Deposition, p. 26, lines 6-20.*

Petitioner abandoned any right he may have had in and to the Mark when he left the show in mid-1999. The Registrant immediately continued use of the Mark. Petitioner made no objection to Registrant's application for trademark registration of the Mark, including during the period for opposition after publication of the Mark. Petitioner's lack of objection the trademark application for the Mark demonstrates his intention to abandon the Mark. For the foregoing reasons, Petitioner lacks standing to object to registration of the Mark.

II. Registrant's Evidence of Secondary Meaning is Sufficient.

Petitioner argues that the evidence submitted by Shaffer was insufficient to establish evidence of acquired distinctiveness under Section 2(f) of the Trademark Act. Registrant's submissions are sufficient.

In his response to the Office Action, filed May 16, 2000, Registrant submitted to the PTO articles and other submissions showing use of the Mark in connection with the radio show. *Registration File*. On August 4, 2000, Registrant filed the Declaration. *Registration File*. The Declaration form was provided to him by the Examining Attorney. Prior to signing the Declaration, Shaffer spoke at length with the Examining Attorney regarding the history of the radio show and asked the Examining Attorney whether he was within his rights signing the Declaration, and was assured that he was. *Shaffer Deposition*, p. 32, lines 17-24; p. 35, lines 14-19; p. 36, line 9 to p. 36, line 21.¹ After speaking with the Registrant on several occasions, and after reviewing the submitted evidence of secondary meaning, the PTO approved the application for the Mark to proceed to publication and registration.

That the Mark was registered in the PTO by acceptance of proof of secondary meaning under §2(f) constitutes a strong administrative presumption that the Mark is in fact distinctive and a valid trademark. *Evelyn Wood Reading Dynamics Institutes, Inc. v. Zimmerman*, 134 U.S.P.Q. 475 (N.D. Cal. 1962). Although Petitioner argues that "multiple entities" used the Mark over a number of years, and therefore the Mark could not have acquired distinctiveness, the constant users of the Mark since 1991 were the co-hosts, Registrant and Petitioner. The radio stations have waived any rights they may have had in the Mark. The rights accrued to the co-hosts accrued to

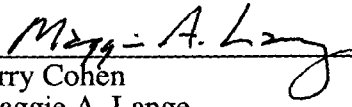
¹ During the application process, Shaffer spoke with the Examining Attorney on several occasions, giving her information on the history of the show, seeking and following what he believed to be her direction and advice regarding what to file. There was no intention to conceal information from the PTO, including information regarding the co-host situation (See Statement of Use, where Shaffer specifically recited that the first use was "with co-host" in 1991, *Registration File*), nor the fact that contracts existed in regards the radio show. *Shaffer Deposition*, p. 44, lines 10-23.

those that contracted to provide the services of the co-hosts, i.e., the Registrant and Petitioner's employer, TF&S. TF&S has not objected to Registrant's use and registration of the Mark. As set forth above, Petitioner lacks standing. The presumption that the Mark is in fact distinctive and a valid trademark should be made, and as no other entity that may have had rights in the Mark have objected, the Registration should be deemed valid.

For all the foregoing reasons, Registrant requests that the petition to cancel the registration of the mark THE MONEY EXPERTS, Registration No. 2,147,142, be denied.

RICHARD SHAFFER,
By his attorneys,

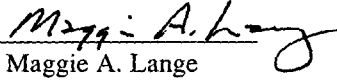
Date: June 19, 2002



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CERTIFICATE OF MAILING

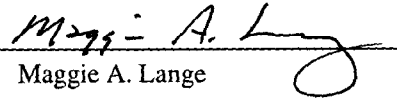
I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Assistant Commissioner of Patents & Trademarks, Box TTAB, 2900 Crystal Drive, Arlington, Virginia 20222 on this 19 day of June, 2002.



Maggie A. Lange

CERTIFICATE OF SERVICE

I hereby certify that a copy of this pleading is being served by first-class mail, on Petitioner's attorney of record, Brett N. Dorny, Esq., Mintz, Levin, Cohn, Ferris, Glovsky and Popeo, P.C., One Financial Center, Boston, MA 02111, on this 19 day of June, 2002.



Maggie A. Lange