

THIS OPINION IS NOT A
PRECEDENT OF THE TTAB

Mailed: November 6, 2017

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Unique Casting Partners LLC

v.

Kathleen Duncan d/b/a Unique Casting

Cancellation No. 92056074

Juliet Alcoba of Alcoba Law Group, P.A.
for Unique Casting Partners LLC.

Kathleen Duncan, *pro se*.

Before Ritchie, Adlin and Masiello, Administrative Trademark Judges.

Opinion by Adlin, Administrative Trademark Judge:

Kathleen Duncan d/b/a Unique Casting (“Respondent”), who is representing herself *pro se*, is a pawn broker and owner of Brass Balls Pawn & Jewelry in Winston-Salem, North Carolina. She also claims to have been involved in different capacities in the entertainment business, and is identified in Office records as the sole owner of a registration for the mark UNIQUE CASTING in standard characters for “employment services in the nature of talent casting in the fields of music, video, and

films” (the “Registration”).¹ In its amended petition for cancellation, Unique Casting Partners LLC of Miami Beach, Florida (“Petitioner”) pleads ownership of an application to register an identical mark for identical services. Perhaps not surprisingly, this case is essentially an ownership dispute between two of the parties which claim rights in the UNIQUE CASTING mark.

While the record indicates that several other individuals and entities also claim rights in, or to have used, the mark, none of them are parties to this proceeding. Perhaps the most relevant of these nonparties is Ed Arenas, who was associated with Petitioner’s predecessors-in-interest for many years. Specifically, Mr. Arenas worked for a Florida business named Unique Castings, Inc. (“UCI”), which did business as UNIQUE CASTING, from the 1980’s through 2000. After Mr. Arenas formed his own company, Ed Arenas Island Casting, Inc., that company purchased UCI, including its unregistered UNIQUE CASTING mark for casting services, in 2000. In 2010, Mr. Arenas and Respondent jointly filed the application which matured into the involved Registration as individual co-applicants,² but currently, as indicated, Respondent is identified in Office records as the Registration’s sole owner.

¹ Registration No. 3865864, issued October 19, 2010 from an intent to use application filed January 29, 2010. The Statement of Use which led to issuance of the Registration asserts first use dates of January 1, 1985. The registration previously also included goods in Class 25, but Respondent specifically requested that this Class be deleted from the registration in her Sections 8 and 15 declaration, which Respondent filed while this case was being tried. The Registration includes a disclaimer of CASTING.

² The original TEAS Plus application listed both Respondent and Arenas as individuals “DBA Unique Casting,” with Respondent’s address being in North Carolina and Arenas’s in Florida. However, the original application also identified Respondent as “a corporation of North Carolina” and Arenas as “a corporation of Florida.” A subsequent Examiner’s Amendment clarified that “[b]oth applicants are individuals with U.S. citizenship.”

As grounds for cancellation, Petitioner alleges fraud based on Respondent's recordation of documents with the Office's Assignments Recordation Branch which resulted in Mr. Arenas being deleted from Office Records as an identified co-owner of the Registration. Other allegations focus on the application that resulted in the Registration. Petitioner specifically alleges that:

Respondent "did not assist in the casting of any of the motion pictures" identified in the specimen submitted with her Statement of Use";

Respondent and Arenas "submitted sham proof that the mark was being used in commerce ... with the specific intent to deceive the USPTO ...";

Neither Respondent nor Arenas "used the mark in conjunction with employment services for casting talent before or after they were issued a notice of allowance ...";

Respondent "did not create or assist in the generation of goodwill of the UNIQUE CASTING trademark" prior to filing the Statement of Use;

Based on "false" documentation (a Brass Balls Pawn & Jewelry pawn ticket), Respondent filed "invalid" documentation ("meeting minutes" from Respondent's North Carolina business known as "Unique Casting") "with the intent to deceive the USPTO to support Registrant's theory that the mark had transferred from prior owner Arenas to Duncan on April 4, 2010;" and

"[T]he improper assignment [recordation] was made in an attempt to 1) commandeer ownership of the trademark after Petitioner informed Registrant Petitioner had an ownership interest in the federally registered trademark and to 2) deceive the USPTO."

19 TTABVUE 4-6³ (Amended Petition for Cancellation ¶¶ 7-18). In her amended answer, Respondent denies the salient allegations in the amended petition for cancellation.

The Record

The record consists of the pleadings, and, by operation of Trademark Rule 2.122(b), the file of the involved Registration. In addition, Petitioner introduced:

Testimony deposition of George Grafas, Petitioner's Managing Member, and the exhibits thereto. 66, 69 TTABVUE.

Testimony deposition of Joseph Louis Zapert, who provides web design and development and IT services for Petitioner, and the exhibits thereto. 66, 70, 74 TTABVUE.

Discovery deposition of Respondent and the exhibits thereto. 67 TTABVUE.

Notice of Reliance on Respondent's written responses to Petitioner's discovery requests. 71 TTABVUE.⁴

Notice of Reliance on official records. 76 TTABVUE.

Respondent introduced:

Notice of Reliance on a document entitled "Illegal Hacking by Grafas, Zapert & Sinaiakin of Duncan's Emails, Computers and Phones." 79 TTABVUE.

³ Citations to the record refer to TTABVUE, the Board's online docketing system. Specifically, the number preceding "TTABVUE" corresponds to the docket entry number, and any number(s) following "TTABVUE" refer to the page number(s) of the docket entry where the cited materials appear.

⁴ Petitioner also introduced its own responses to written discovery requests, 72 TTABVUE, but except under circumstances inapplicable here, a party may not rely on its own discovery responses and we have therefore given them no consideration. Trademark Rule 2.120(k)(5).

Notice of Reliance on a document entitled “Repetitive Pattern of Premeditated Abuse, Harassment & Terrorization of Duncan by Grafas.” 80 TTABVUE.

Notice of Reliance on a document entitled “Grafas’ Breaches of Contract,” which appears to consist of official records. 81 TTABVUE.

Notice of Reliance on a document entitled “Harassment by Grafas.” 82 TTABVUE.

Notice of Reliance on a document entitled “Joe Zapert Perjury.” 83 TTABVUE.

Notice of Reliance on a document entitled “Benay Sinaikin Casting Scam History.” 84 TTABVUE.⁵

Notices of Reliance on official records, Internet printouts and a printed publication. 85 TTABVUE 19; 86 TTABVUE 36-37, 42-63, 65-78 and 80-94; 87 TTABVUE 8-22, 26-30, 32, 34-46, 56, 58-67, 74-75, 78-90, 92-93, 95, 99, 101-118, 120-123, 125-126, 130-134, 136, 138-140, 146-149, 154-155, 160, 174, 185, 187-191, 194-196, 212-217, 234-235 and 258; 88 TTABVUE 4, 6, 8, 10, 12, 14, 16, 38-40, 42-43, 53-57, 73-74, 77, 79-80, 102, 107-109, 125, 127-129, 132-135, 137, 141, 144 and 151-164; 90 TTABVUE 7.⁶

Relevant Facts of Record

⁵ While at least major portions of the documents Respondent submitted at 79-84 TTABVUE would normally be inadmissible under Trademark Rule 2.122, Petitioner failed to object to these materials, despite objecting to Respondent’s introduction of other evidence, 92 TTABVUE, and at times addressed these materials during trial. We have therefore considered these documents to have been stipulated into the record. *See e.g., Bayer Consumer Care AG v. Belmora LLC*, 110 USPQ2d 1623, 1627 (TTAB 2014), *rev’d on other grounds*, 84 F.Supp.3d 490, 115 USPQ2d 1032 (E.D. Va. 2015), *vacated and remanded*, 819 F.3d 697 (4th Cir. 2016); *Hilson Research Inc. v. Society for Human Resource Management*, 27 USPQ2d 1423, 1425 n.8 (TTAB 1993).

⁶ The majority of the evidence submitted with Respondent’s Notices of Reliance at 85-90 TTABVUE was stricken as inadmissible by the Board’s order of March 3, 2017 and has not been considered. 99 TTABVUE. None of the materials which were stricken would change our decision.

Neither party introduced testimony from Mr. Arenas or anyone else who may have detailed, first-hand knowledge of UCI's or Ed Arenas Island Casting's pre-2011 activities, service mark usage, ownership, contracts, etc. Moreover, Respondent's testimony is in many respects incomplete, unclear and self-contradictory. Therefore, the record in this proceeding is replete with crucial evidentiary gaps, and resulting uncertainty.

In any event, in the mid-1980s Yonit Hamer a/k/a Yonit Duchman controlled UCI, which operated under the name "Unique Casting." Ed Arenas was the company's camera operator, and, according to Mr. Grafas, Ms. Duchman's protégé. 66 TTABVUE 8, 11, 14-15. Mr. Arenas worked for UCI and Ms. Duchman through 2000, when Ed Arenas Island Casting, Inc., a corporation Mr. Arenas controlled, purchased UCI's casting business and related assets. *Id.* at 47-48; 69 TTABVUE 37-48. Among the assets transferred to Ed Arenas Island Casting was the UNIQUE CASTING mark for casting services. 69 TTABVUE 43-45, 47.⁷

In 2004, Mr. Arenas entered into some type of relationship with Respondent, who now claims to operate a casting business in Winston-Salem, North Carolina under the name "Unique Casting" ("UCNC"). 67 TTABVUE 7, 18. By 2010, Mr. Arenas owed Respondent \$10,000. 66 TTABVUE 28-29; 67 TTABVUE 13. According to Respondent, "Ed Arenas borrowed ten grand from me, and the collateral was Unique Casting. And I trademarked it to protect my interest. I paid for the trademark and I

⁷ While it is not clear from the record whether or to what extent UCI survived after Ed Arenas Island Casting acquired UCI's casting business, we presume that as a result of UCI's assignment of the UNIQUE CASTING mark, UCI no longer used that mark post-acquisition.

Cancellation No. 92056074

did all of the trademark paperwork.” 67 TTABVUE 13. Respondent claims that this loan, secured by “Unique Casting” as “collateral,” is reflected in the pawn ticket depicted below which Brass Balls Pawn & Jewelry Inc. issued to Mr. Arenas:

Pawnbroker/ Creditor Brass Balls Pawn & Jewelry Inc 2128 South Main Street Winston Salem, NC 27127				Pawn/Buy PAWN	Original # 1006663	Ticket Number 101190
Pledgor/Seller EDWIN RENE ARENAS 1825 WEST AVENUE BAY #8 MIAMI BEACH, FL 33139				Date Made 1/04/10	Time Made 09:24 AM	Date Due / Maturity Date 2/03/2010
AMOUNT FINANCED. The amount of cash given directly to you.				\$9999.99		
FINANCE CHARGE. The dollar amount the credit will cost you.				\$300.00		
TOTAL OF PAYMENTS. Amount required to redeem pawn on Maturity Date.				\$10299.99		
ANNUAL PERCENTAGE RATE. The cost of your credit as a yearly rate.				31.42%		
PAYMENT SCHEDULE 1 @				\$10299.99		
PREPAYMENT. If you pay off early, you will not be entitled to a refund of part of the finance charge.						
STATED VALUE. Unless otherwise agreed, "stated value" is the same as the Amount Financed stated above.				\$9999.99		
Interest + Pawnbroker Fee = Finance Charge				\$200.00 + \$100.00 = \$300.00		
2.00% + 1.00% = 3.00%						
See your contract document for any additional information concerning non-payment, default, and prepayment refunds or penalties.						
THE ITEM PAWNEE IS REDEEMABLE ONLY BY THE BEARER OF THIS TICKET OR BY IDENTIFICATION OF THE PERSON MAKING THE PAWN. ANY PERSONAL PROPERTY PLEDGED TO A PAWNBROKER WITHIN THIS STATE IS SUBJECT TO SALE OR DISPOSAL WHEN THERE HAS BEEN NO PAYMENT MADE ON THE ACCOUNT FOR A PERIOD OF 60 DAYS PAST MATURITY DATE OF THE ORIGINAL CONTRACT. NO FURTHER NOTICE IS NECESSARY. THE INTEREST AND PAWNBROKER'S FEE ARE DEEMED EARNED ON THE DATE OF THE LOAN. YOU WILL NOT BE ENTITLED TO A REFUND OF ANY PORTION OF THOSE CHARGES. The contract is renewable for periods of 30 days each if agreed upon by both parties, as outlined by Chapter 91A of the General Statutes of N.C. In the event, the pledged item(s) are lost or damaged while in our possession, it shall be our responsibility to replace the lost or damaged goods with merchandise of like kind and equivalent value. In the event we and you cannot agree as to replacement, we will reimburse you in the same amount of the "STATED VALUE" set out in this contract. THE PLEDGOR OF THE ITEM(S) ATTESTS THAT IT IS NOT STOLEN, HAS NO LIENS OR ENCUMBRANCES, AND IS THE PLEDGOR'S TO SELL OR PAWN, and you are representing that you are at least 18 years of age. You also represent that you have been given a copy of this contract, and consent to the sale or disposal of this property according to the terms set forth herein.						
TOTAL DUE Amount required to redeem pawn		Until 2/03/2010	Until 3/05/2010	Until 4/04/2010	X <i>Edwin Arenas</i> Pledgor's Signature Store Copy Type #10-9305-1	
\$10299.99		\$10574.99	\$10849.99			
© NCL1 - Te Recorder Call JMT Co. Pawn Manager 704-873-4472						
PLAINTIFF'S EXHIBIT Crawford Lmw 8-5-16						

67 TTABVUE 16-17; 69 TTABVUE 84. The pawn ticket indicates that on January 4, 2010, in exchange for \$9,999.99, which Brass Balls Pawn & Jewelry Inc. paid in cash, Mr. Arenas assigned Brass Balls Pawn & Jewelry “a security interest in the following items: name ‘UNIQUE CASTING’ to be trademarked under G&S IC 015, US 022 039 wearable garments & G&S IC 035, US 100 101 102 employment services in the nature of talent casting in the fields of music, video and films.” 67 TTABVUE 13; 69 TTABVUE 84. The pawn ticket also sets forth a finance charge and interest to be paid by Arenas, in addition to the original principal of \$9,999.99, within 60 days of the maturity date of February 3, 2010, failing which the pledged property “is subject to

sale or disposal.” Mr. Arenas did not make the required payment by the deadline, and during her discovery deposition, Respondent claimed that as a result the pawn transaction resulted in the transfer of “Unique Casting” to Respondent:

16 Q. See, Ms. Duncan, why, if you identify that what you
17 wanted to protect is the name, right, and that's what
18 you were listing as what was being transferred to, why
19 didn't you include the business as well?

20 A. That is the business.

21 Q. The name is the business?

22 A. You want to get technical about it, and I understand
23 that, because that's what a lawyer's job is. However,
24 I definitely owned the business. I mean, I had been
25 working with Ed since 2004.

67 TTABVUE 17. According to Respondent, the pawn ticket gave her the right to file the application which matured into the involved registration:

5 Q. When you went to -- when you prepared that application,
6 did you prepare it because he -- you prepared it
7 because you were protecting your interest?

8 A. Absolutely.

9 Q. But he gave you permission to do so?

10 A. Of course. I wouldn't give him ten grand and not have
11 some sort of collateral.

Id. at 20.

Respondent testified that she owned the UNIQUE CASTING mark “in full” in 2010. *Id.* at 52. However, Respondent also indicated during discovery that the only documents exchanged between her and Mr. Arenas were the pawn ticket and “business documentation with Pawn ticket wherein Ed Arenas Purchased Unique Casting from Yonit Duchman.” 71 TTABVUE 7.⁸ The “business documentation” is the purchase agreement, assignment and assumption agreement and accompanying documentation pursuant to which Ed Arenas Island Casting purchased UCI. 69 TTABVUE 37-48. In other words, the pawn ticket is the only document which could conceivably support Respondent’s claim that she owns “Unique Casting” and the UNIQUE CASTING mark, because the documents concerning Ed Arenas Island Casting’s purchase of UCI are from 2000, years before Respondent met Mr. Arenas and years before Respondent claims any transfer of ownership occurred. *Id.*

While Respondent filed the application based on an alleged intent to use the mark, less than seven months later she filed a Statement of Use claiming first use dates of January 1, 1985, with an original specimen consisting of UCI’s logo, shown below:



⁸ We may rely on written responses to requests for production. *Calypso Technology Inc. v. Calypso Capital Management LP*, 100 USPQ2d 1213, 1217 n.8 (TTAB 2011); *L.C. Licensing Inc. v. Berman*, 86 USPQ2d 1883, 1886 n.5 (TTAB 2008).

Cancellation No. 92056074

August 10, 2010 (original) Statement of Use in the Registration file. In fact, Respondent claims that she was entitled to rely on UCI's and Ed Arenas Island Casting, Inc.'s prior use of the mark, which dates from the 1980's, to support the application she jointly filed with Mr. Arenas: "I don't have to establish use, because I wound up buying Yonit's business that she sold to Ed, from Ed. That's – that's the chain. So what my understanding is, is that you just needed to show that Unique Casting was in business and doing work during that time." 67 TTABVUE 132. After the Office found the original specimen depicted above to be unacceptable because it "consists of the mark itself without any context as to the manner of use," Respondent submitted the following substitute specimen, a printout from UCI's web page:

Unique Casting [us]

 IMDbPro.com offers expanded company and employee contact details for over 30,000 companies in the entertainment industry as well as representation listings for over 80,000 individuals, including actors, directors, and producers.
[Click here for a free trial!](#)

More information for this company is available on on [IMDbPro](#).

Contact: [Available only on IMDbPro](#)
Branches: [Available only on IMDbPro](#)

Staff

Name	Branch	Occupation
Available only on IMDbPro		

Filmography as: [Miscellaneous Company](#)

Miscellaneous Company - filmography

1. [Full Grown Men](#) (2006) ... *Casting (Florida)*
2. [Transporter 2](#) (2005) ... *Extras Casting*
3. [Eve's Dropping In](#) (2003) ... *Casting*
4. [Stardom](#) (2000) ... *Casting (Florida)*
5. [Chains of Gold](#) (1991) ... *Extras Casting*
6. [Otto - Der Außerfriesische](#) (1989) ... *Casting (USA/Miami)*
7. [Scarecrows](#) (1988) ... *Casting (Florida)*
8. [Broadcast News](#) (1987) ... *Casting (Miami)*
9. [The Whoopee Boys](#) (1986) ... *Casting (Florida)*
10. [The Mean Season](#) (1985) ... *Casting (Miami)*



1825 West Avenue / unit #8
Miami Beach FL 33139-1441
(305) 532-0226 / (786) 256-9806 cel
info@uniquecasting.com
Affiliated Websites: www.EdArenas.com
[\[Email Instructions\]](#) | [\[Company Private Email Login\]](#) | [\[Company Control Panel\]](#)

| [HOME](#) |

[sub_sitemap.htm](#)

This substitute specimen reflects casting services UCI performed in the 1980's, decades before Respondent met Mr. Arenas or had any involvement with a business

named “Unique Casting.” In her Trial Brief,⁹ Respondent confirms that the use asserted in her Statement of Use was UCI’s use. 102 TTABVUE 3 (“Unique Casting’s date of first use was January 1, 1985 and there has been continued use by Kathleen Duncan.”); *id.* at 12 (“Respondent did submit specimens showing the mark in commerce, screenshots showing the mark used in employment services for talent casting and screenshots of some motion pictures which Unique Casting had cast since 1985.”).

At the time Respondent was prosecuting the application which matured into the involved Registration, Mr. Arenas and Ed Arenas Island Casting were having financial and other difficulties. Ultimately, in 2011, Mr. Grafas, who had known Mr. Arenas since 1986, moved to Florida to help both Mr. Arenas and Ed Arenas Island Casting. 66 TTABVUE 8-13. According to Mr. Grafas, Mr. Arenas made a “pitch for me to be his producer and to help him get his life and the business in order, which then later turned into me becoming the owner of the company and me, like, handling all of the business of the company because there was no company prior to me getting there. It was just some casting work that he was getting infrequently.” *Id.* at 13-14. At the time, Ed Arenas Island Casting was operating out of Mr. Arenas’s apartment, at the same address listed on the website which Respondent submitted as a specimen with her Statement of Use. *Id.* at 16.

⁹ While Respondent filed her Trial Brief late, we have exercised our discretion to consider it for clarification given the gaps in the record.

Mr. Grafas formed Petitioner in 2011. On March 3, 2011, Mr. Arenas entered into an agreement to become one of Petitioner's executives. *Id.* at 17-27 and 69 TTABVue 8-20. Simultaneously, Petitioner entered into a Promissory Note with Grafas, personally guaranteed by Mr. Arenas, pursuant to which Petitioner agreed to pay \$150,000 to Grafas over time, failing which Grafas would become owner of Ed Arenas Island Casting and its trademarks (by virtue of Mr. Arenas's personal guarantee). Ultimately, Mr. Arenas left Petitioner, stopped working with Mr. Grafas, and there was a default on the promissory note, leading to Petitioner's acquisition of Ed Arenas Island Casting and its UNIQUE CASTING mark, and Petitioner's continuation of the business, still under the name "Unique Casting." *Id.* at 27-28.

Mr. Grafas disputes Respondent's claim to owning the ULTIMATE CASTING mark, or any portion thereof.

But he [Mr. Arenas] never, in all of that time that I worked with him or spoke with him, did he ever mention that Kathleen Duncan was a casting director, that he ever mentioned that she was in the casting business, that she was his partner, that he had a North Carolina affiliation with a casting company with Unique Casting, with Kay Duncan or her boyfriend Darryl Baldwin. Darryl Baldwin is not a casting director. He is an actor and stunt double, who is her boyfriend. Neither he or she (sic) were casting directors. She wanted to be a casting director. She wanted to have a casting company

I mean, he [Mr. Arenas] told me that he had – Unique Casting was his company and his trademark. He never said anything about Kay Duncan being the co-owner of the Unique Casting trademark. But then it turned out that she went and filed the trademark for him, and she did this on his behalf. And then the relationship of him and her, like, came out after the fact.

Id. at 29-30.

The following year, on April 3, 2012, Respondent, by herself, without Mr. Arenas' involvement, recorded a document bearing on the involved Registration with the Office's Assignment Branch. The coversheet indicates that the "nature of conveyance" is a "change of name," with Mr. Arenas being the "conveying party" and Respondent being the "receiving party." The supporting document submitted with the coversheet is reproduced below:

Unique Casting Meeting Minutes

Subject	Ed Arenas Unique Casting Exec Termination & Change of Name re: Unique Casting Trademark	Date	04/03/2012
Facilitator	Kathleen Duncan	Time	12:00 pm
Location	2128 S. Main Street Winston-Salem, NC 27127	Scribe	Kathleen Duncan
Attendees	Kathleen Duncan; Darryl Baldwin		

Key Points Discussed

No.	Topic	Highlights
1.	Ed Arenas Unique Casting executive termination	Confirmation of Ed Arenas Unique Casting executive termination
2.	Change of owner name re: Trademark	Ed Arenas to be removed from Trademark
3.		
4.		
5.		

Action Plan

No.	Action Item(s)	Owner	Target Date
1.	Termination of Ed Arenas Executive	Kathleen Duncan	04/03/2012
2.	Removal of Ed Arenas from Unique Casting Trademark	Kathleen Duncan	04/03/2012
3.			
4.			
5.			

However, Mr. Grafas denied that Mr. Arenas was working with Respondent or UCNC at the time of the meeting minutes or beforehand:

No, it doesn't make any sense at all. This is ridiculous, and it's false. It's entirely false. First of all, he was never working for her. He didn't have a relationship with her. She didn't have any minutes of any meeting. This was just fabricated, and this is what she wrote on the documents and sent to the USPTO. But she, you know, Ed did not work for her. He never worked for her. He never worked with her ...

I'm saying ever. I don't think that he had ever – she's not a casting director. She never was a casting director. She has never casted anything before in her life. Ever. She has never worked as a casting director. She has never generated a single penny, a dollar as being paid as a casting director

I asked her if she wanted the \$10,000 that was lent to her in order for me to pay for whatever it was that she paid for the trademark. I told her to send me a copy of the check, and I'll reimburse her for it, and she can transfer the trademark to me. She didn't want to transfer the trademark with me. She wanted to be co-owner. She wanted to be on the trademark and wanted to have a business relationship with me in order for her to do film and TV work. And she felt that she was obliged to stay on it ... It's just that she was wanting to coerce me in order to work with her to help her set up her office and to cast out of there

66 TTABVUE 55-57. At the time, Respondent's letterhead included "an old logo from Unique Casting that Ed used in 2005, '6, and '7. That was the original logo for the company." *Id.* at 62.

According to Mr. Zapert, in 2012, after recording the "meeting minutes" with the Assignment Branch, Respondent successfully used the Registration, which post-recording identified her as its sole owner, to convince Facebook and a domain name

registrar to disable Petitioner's Facebook page and domain name based on alleged trademark infringement. 66 TTABVUE 128, 130-31. While Petitioner was ultimately able to "recover" its Facebook page and domain name, Respondent continued "to file complaints, which would result in Facebook disabling it again and we would provide evidence again and it would come back to us ... it was disruptive to our business, we eventually removed the word 'unique' from the page." *Id.* at 128-31.

**Whether a Claim of Nonownership
Was Pleaded or Tried by Implied Consent**

While the amended petition for cancellation's primary focus is Respondent's alleged fraud, Petitioner's underlying allegations, on which the fraud claim is based, and which are subsumed by the fraud claim, are essentially that Respondent does not own the UNIQUE CASTING mark:

"Duncan did not assist in the casting of any of the motion pictures relied upon in the specimen submitted ... to demonstrate use in commerce in August 10, 2010 nor in September 7, 2010 [the dates Respondent submitted the specimens and substitute specimens supporting her Statement of Use]."

Neither Duncan nor Arenas "used the mark in conjunction with employment services for casting talent before or after they were issued a notice of allowance from the USPTO."

"Registrant did not offer services under the mark" in 2010.

Respondent's only interest in the application is "as collateral for a loan received by Arenas from Duncan," but Respondent nevertheless recorded an assignment suggesting "that the trademark was transferred to Duncan in her sole capacity April 3, 2012"

The pawn ticket “cannot be recognized as a valid transfer of the goodwill associated with the trademark for it is an assignment in gross and is invalid.”

19 TTABVUE 4-5 (Amended Petition for Cancellation ¶¶ 7, 9, 11, 12, 13). These allegations effectively plead a claim of nonownership.

For her part, Respondent acknowledges that she was required to be using UNIQUE CASTING at the time she filed her Statement of Use. 67 TTABVUE 110 (“All I have to show is that we – that Unique Casting was in operation at that time.”). However, Respondent does not claim that she herself was using UNIQUE CASTING when she filed the Statement of Use, nor has she presented any evidence demonstrating her use of the mark for casting services specifically, either before or after filing the Statement of Use. Rather, she claims she was entitled to rely on her alleged predecessors-in-interests’ use: “I don’t have to establish use, because I wound up buying Yonit’s business that she sold to Ed, from Ed. That’s – that’s the chain. So what my understanding is, is that you just needed to show that Unique Casting was in business and doing work during that time.” 67 TTABVUE 132. Similarly, in her Trial Brief, Respondent confirms that the use of the mark claimed in the Statement of Use was UCI’s and Ed Arenas Island Casting’s use long ago. 102 TTABVUE 3, 12. Respondent’s claim that UCI’s and Ed Arenas Island Casting’s use of the UNIQUE CASTING mark inured to her benefit is apparently why she also claims to own the UNIQUE CASTING mark. *Id.* at 6 (“Respondent is the *rightful owner* through true and correct succession to Unique Casting which had been in use since the early 1980s, at a time when Respondent was not involved with Unique Casting.”) (emphasis

added). Again, however, Respondent has presented no evidence to demonstrate her own use of the UNIQUE CASTING mark for casting services at any time.

In other words, far from being surprised by Petitioner's evidence and arguments regarding use and ownership, Respondent presented similar evidence and made similar arguments herself. She also claimed ownership of the Registration when she recorded "meeting minutes" with the Office's Assignment Branch. Neither party objected to the other's evidence or arguments regarding ownership or use. And at bottom the parties' dispute is essentially about ownership, i.e. whether or not Respondent owns the mark UNIQUE CASTING for casting services. Accordingly, under Fed. R. Civ. P. 15(b)(2) and TBMP § 507.03(b), we find that even if Petitioner did not separately plead a claim of nonownership, this claim was tried by implied consent. As we stated in *Nahshin v. Product Source International LLC*, 107 USPQ2d 1257 (TTAB 2013) in analogous circumstances:

Although the proceeding was brought on the ground of priority/likelihood of confusion, the actual issue in this matter is ownership of the mark NIC-OUT/NIC OUT in the United States, as the cigarette filters that respondent sells under the mark NIC OUT are the same filters that petitioner arranged to have manufactured under the mark NIC-OUT.

Id. at 1258;¹⁰ *John Anthony, Inc. v. Fashions by John Anthony, Inc.*, 209 USPQ 517 (TTAB 1980) (although Opposer pleaded only priority and likelihood of confusion,

"[t]he basic question to be determined in this case is whether the mark "JOHN

¹⁰ Whereas the respondent in *Nahshin* objected to consideration of a nonownership claim, Respondent in this case not only did not object but in fact effectively argued the same issue.

ANTHONY” is owned by opposer or by applicant”). *Cf. Wonderbread 5 v. Gilles*, 115 USPQ2d 1296, 1302 (TTAB 2015) (“when 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”).

Standing

Petitioner uses the mark in the Registration, for the same types of casting services identified in the Registration. 66 TTABVUE 8-9, 52, 74, 81 and Exs. C, H. This establishes its standing. *See Empresa Cubana Del Tabaco v. Gen. Cigar Co.*, 753 F.3d 1270, 111 USPQ2d 1058, 1062 (Fed. Cir. 2014); *Ritchie v. Simpson*, 170 F.3d 1092, 50 USPQ 1023 (Fed. Cir. 1999); *Lipton v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185, 189-190 (CCPA 1982); *Automedx, Inc. v. Artivent Corp.*, 95 USPQ2d 1976, 1978 (TTAB 2010); *Giersch v. Scripps Networks, Inc.*, 90 USPQ2d 1020, 1022 (TTAB 2009) (“Petitioner has established his common-law rights in the mark DESIGNED2SELL, and has thereby established his standing to bring this proceeding.”). Furthermore, Petitioner has standing because Respondent used the involved Registration in support of her challenge to Petitioner’s Facebook page and domain name.

Does Respondent Own the Mark in the Registration?

It is settled that “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 Industries, Inc.*, 216 USPQ 619 (TTAB 1982)). *See also*, 15 U.S.C. § 1051(a); *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). Here, where the underlying application was based on an alleged intent to use, Mr. Arenas and Respondent, who filed the application, must have had a good faith intention to use the mark. *American Forests v. Sanders*, 54 USPQ2d 1860 (TTAB 1999), *aff'd*, 232 F.3d 907 (Fed. Cir. 2000) (finding intent to use application filed by Barbara Sanders void *ab initio* because “the true entity which had a bona fide intent to use the mark LEAF RELEAF and design was not Barbara Sanders an individual, but rather was a partnership consisting of Stephen Sanders and Barbara Sanders”). And, when a statement of use is filed, the filer(s) must own the mark. *In re Columbo Inc.*, 33 USPQ2d 1530, 1531 (Commr. Pat. 1994) (“If the party who filed the Statement of Use was not the owner of the mark at the time of filing, the applicant cannot provide a substitute verification by the true owner unless there is time remaining in the statutory period for filing the Statement of Use.”); *see also* TMEP 1109.10 (2017) (“The party filing the statement of use must be the owner of the mark at the time of filing. This is a statutory requirement that must be satisfied before the expiration of the deadline for filing the statement of use ... if the party who files a statement of use was not the owner of the mark at the time of filing, and no time remains in the statutory period for filing the statement of use, the application is abandoned.”).

Whether we assess Respondent’s claimed ownership of the mark in the Registration at the time she filed the Statement of Use on behalf of both herself and Mr. Arenas, or at the time she recorded the “meeting minutes” with the Assignment Branch which resulted in Mr. Arenas being deleted as an identified owner of the

Registration in Office records, the conclusion is the same – Respondent did not own and does not own the mark.

Turning first to the filing of the Statement of Use, Mr. Arenas, as opposed to Ed Arenas Island Casting, Inc., had no rights in the UNIQUE CASTING mark to assign or in which to grant a security interest. That is, the evidence of record indicates that Ed Arenas Island Casting, rather than Mr. Arenas himself, acquired the UNIQUE CASTING service mark from UCI, and there is no evidence that the mark was later assigned at any time prior to Mr. Arenas entering into the pawn transaction. 66 TTABVUE 47-48; 69 TTABVUE 37-48. In other words, Mr. Arenas did not own the UNIQUE CASTING service mark, and therefore could not assign a security interest therein.

Furthermore, Respondent did not obtain anything, not even a security interest, by operation of the pawn ticket. Only Brass Balls Pawn & Jewelry (if anyone) did. While Respondent claims to own Brass Balls Pawn & Jewelry Inc. as a “sole proprietor,” she also made clear that Brass Balls Pawn & Jewelry is a North Carolina corporation, i.e. a separate juristic “person,” rather than Respondent’s “doing business as” name. 67 TTABVUE 71-72. While Respondent may perceive herself and Brass Balls Pawn & Jewelry as one and the same, and perhaps even as “earlier and later manifestations of the same single continuing commercial enterprise,” *Great Seats*, 84 USPQ2d at 1239-40, the evidence reveals that they are not, as both Respondent and Brass Balls Pawn & Jewelry existed separately on August 10, 2010 when the Statement of Use was filed. Only Brass Balls Pawn and Jewelry acquired

whatever may have transferred through the pawn transaction, and there has been no subsequent transfer of anything Brass Balls Pawn and Jewelry may have acquired.

Furthermore, Respondent has no use of her own which would support the Statement of Use. She claims that the casting services offered under the UNIQUE CASTING mark are provided by UCNC, even though she concedes that she and UCNC have no licensing or other agreement between them. 67 TTABVUE 27, 72. In other words, Respondent herself is not the source of any casting services, and in any event there is not even any evidence of record that UCNC or Brass Balls Pawn & Jewelry ever provided casting services, much less Respondent. In short, Respondent's apparent belief that her claimed ownership of Brass Balls Pawn & Jewelry and UCNC is enough for her to claim ownership of any rights they may have to the UNIQUE CASTING mark is incorrect, including because there is no evidence that either Brass Balls Pawn & Jewelry or UCNC have any rights in UNIQUE CASTING either. *See Great Seats*, 84 USPQ2d at 1239-43.

Indeed, in order for a service mark assignment or grant of a security interest to be valid, the assignment or grant must include the goodwill associated with the mark. Here, neither the pawn ticket nor any other evidence suggests, much less proves, that any goodwill was transferred to Respondent or Brass Balls Pawn & Jewelry, and therefore any assignment was in gross, or "naked," and as a result invalid. *VISA, U.S.A., Inc. v. Birmingham Trust National Bank*, 696 F.2d 1371, 216 USPQ 649, 651 (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”); *Cf. Haymaker Sports, Inc. v. Turian*, 581 F.2d 257, 198 USPQ 610 (CCPA 1978) (security interest found to be invalid assignment in gross).¹¹

Turning to Respondent’s recordation of UCNC’s purported “meeting minutes,” that did not result in Respondent becoming the owner of either the mark or the Registration.¹² The minutes are not an assignment of anything, much less a service mark assignment including associated goodwill. Neither UCNC nor Respondent had any ownership interest in either the mark or the Registration for the reasons already stated, and therefore they had nothing to “assign” or in connection with which to effect a “change of name.” Moreover, there is no evidence whatsoever that Mr. Arenas was ever UCNC’s employee or that UCNC had any authority or power over Mr. Arenas, while there is evidence to the contrary, and therefore UCNC had no basis upon which to limit or terminate Mr. Arenas’s trademark rights, any more than it could limit or terminate a complete stranger’s trademark rights. 66 TTABVUE 55-57. In short, the meeting minutes do nothing to vest title in Respondent.

Conclusion

¹¹ It appears that Respondent filed the Statement of Use on her own, without Mr. Arenas’s participation. Because co-applicants Respondent and Mr. Arenas “are in fact separate legal entities, any action taken with respect to a registration by less than all of the owners must be supplemented with an affidavit or declaration (37 C.F.R. Section 2.20) by each of the co-owners, ratifying the facts stated in the [filing].” *Cf. In re Murray No. 91-94*, 21 USPQ2d 1937, 1940 (Commr. Pat. 1991) (addressing a renewal filed by less than all of the registration’s co-owners). Mr. Arenas did not file any supplemental affidavit or declaration prior to the deadline for filing the statement of use or thereafter.

¹² Options for owners of registrations faced with improperly filed changes of name or assignments are set forth in TMEP 503.06(c) (2017).

Cancellation No. 92056074

Petitioner has established by a preponderance of the evidence that Respondent does not own the mark in the Registration.

Decision: The petition to cancel is granted on the ground of nonownership and Registration No. 3865864 will be cancelled in due course.¹³

¹³ Having granted the petition to cancel, there is no need to consider petitioner's fraud claim.