

This Opinion is Not a
Precedent of the TTAB

Mailed: May 31, 2023

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Kesa Incorporated
v.
Nancy L. Rojo

Cancellation No. 92075544

Marin Cionca of Cionca IP Law P.C.
for Kesa Inc.

William E. O'Brien of O'Brien Global Law
for Nancy L. Rojo.

Before Cataldo, Lynch, and Lebow,
Administrative Trademark Judges.

Opinion by Lynch, Administrative Trademark Judge:

I. Background and Evidentiary Record

Respondent Nancy L. Rojo was one of the founders of Petitioner,¹ now known as Kesa Incorporated,² and she previously served on its board and as its president.³ Subsequently, the parties engaged in a number of disputes,⁴ including the one at issue in this case involving the mark Petitioner used as its corporate logo from 2010 until mid-2021.⁵

Petitioner contends that Respondent did not own the mark and has never used it, and has filed a petition to cancel Registration No. 6099423 owned by Respondent:



electronic files in the nature of CAD drawings and renderings in International Class 9;

stationery; brochures in the fields of building construction, alarms, vault removal, and security; notebooks; paper CAD drawings and renderings in International Class 16;

¹ The parties apparently dispute whether she was the sole founder, 18 TTABVUE 2 (Rojo Declaration), or a co-founder, 21 TTABVUE 2-3 (Ardagna Declaration).

² When this proceeding began, Petitioner's corporate name was Construction Installation Maintenance Group, Inc. d/b/a CIM Group, Inc. During the course of the proceeding, it changed its name to KESA Incorporated. 15 TTABVUE 29-30 (Ardagna Deposition – Petitioner's corporate designee); 17 TTABVUE 17 (Certificate of Name Change). We have updated the case caption accordingly to identify KESA Incorporated as the petitioner.

³ 15 TTABVUE 69.

⁴ Respondent referred to being “forced out of the company in a hostile takeover.” 16 TTABVUE 161 (answer to Interrogatory No. 18). Petitioner's corporate designee stated that “[t]he board made a decision to remove her as president. To the best of my recollection, she was given a clerical position with the accounting department.” 15 TTABVUE 35 (Ardagna Deposition).

⁵ 15 TTABVUE 19 (Ardagna Deposition).

caps being headwear; jackets; shirts; women's blouses in International Class 25;

providing a website featuring information in the fields of ATM-banking building construction and installation and maintenance of security alarms in International Class 37; and

providing a website featuring information in the field of building security in International Class 45.⁶

Petitioner bases its petition on the grounds of Respondent's alleged non-ownership of the mark and Respondent's non-use of the mark at the time she filed the use-based application underlying her registration.⁷

Respondent asserts that she does own the mark and Petitioner's use was pursuant to an implicit license that inures to Respondent's benefit. In her Answer to the Petition to Cancel, Respondent admitted the following allegations:⁸

Until very recently, Respondent was a shareholder of Petitioner, as well as a board member.⁹

Sometime [] in 2010, the board of the Petitioner decided to adopt as its mark the CIM mark as shown in the '423 Registration. Respondent participated in that decision as a board member and also actively participated in the coordination with a marketing firm hired by Petitioner to

⁶ Registration No. 6099423 issued July 14, 2020 from an underlying application filed August 14, 2019 under Trademark Act Section 1(a), 15 U.S.C. § 1051(a), and alleges April 4, 2010 as the date of first use and May 29, 2010 as the date of first use in commerce. According to the description, "[t]he mark consists of a dark blue letter 'C' followed by a red plain letter 'T' followed by a dark blue letter 'M.'" The colors dark blue and red are claimed as a feature of the mark.

⁷ 1 TTABVUE. Petitioner's fraud claim was dismissed. 14 TTABVUE.

⁸ 5 TTABVUE 2-3 (Respondent's Answer).

⁹ ¶ 2, 1 TTABVUE 4.

create the new look of the CIM mark, as shown in the ‘423 Registration.’¹⁰

Upon information and belief, Respondent filed on August 14, 2019 with the USPTO the trademark application (‘her application’) that matured into the ‘423 Registration, while [R]espondent was still a board member of the Petitioner.¹¹

Upon information and belief, Respondent claims April 04, 2010 as her first use date of the CIM mark.¹²

She otherwise denied the salient allegations, and included a list of “Affirmative Defenses.”¹³ Failure to state a claim upon which relief can be granted is not a true affirmative defense, and we do not consider it as such. *John W. Carson Found. v. Toilets.com, Inc.*, 94 USPQ2d 1942, 1949 (TTAB 2010) (“The asserted defense of failure to state a claim is not a true affirmative defense because it relates to an assertion of the insufficiency of the pleading of opposer’s claim rather than a statement of a defense to a properly pleaded claim.”). Respondent did not pursue the other pleaded affirmative defenses at trial, and we therefore consider them waived. *See Alcatraz Media, Inc. v. Chesapeake Marine Tours, Inc.*, 107 USPQ2d 1750, 1753 n.6 (TTAB 2013), *aff’d*, 565 Fed. App’x 900 (Fed. Cir. 2014) (mem.); TRADEMARK TRIAL AND APPEAL BOARD MANUAL OF PROCEDURE (TBMP) § 801.01 (2022) (“If a party fails to reference a pleaded claim or affirmative defense in its brief, the Board will deem the claim or affirmative defense to have been waived”).

¹⁰ ¶ 3, *id.*

¹¹ ¶ 4, *id.*

¹² ¶ 5, *id.*

¹³ 5 TTABVUE 3.

The file of the challenged registration is part of the record pursuant to Trademark Rule 2.122(b), 37 C.F.R. § 2.122(b). Both parties submitted testimony, and Respondent submitted a notice of reliance. Petitioner introduced: the deposition transcript, with exhibits, of Joe Ardagna, Petitioner's acting president and chairman of the board, who testified in both his personal capacity and on behalf of Petitioner;¹⁴ the deposition transcript, with exhibits, of Respondent;¹⁵ the rebuttal declaration of Joe Ardagna;¹⁶ and the rebuttal declaration of Samy Mizrahi, Petitioner's board member.¹⁷ Respondent introduced: the affidavit, with exhibits, of Respondent;¹⁸ and under notice of reliance, Petitioner's responses to requests for admission, screenshots from Petitioner's website, and Petitioner's certificate of name change (from CIM Group, Inc. to Kesa Incorporated) from the Secretary of State of Nevada.¹⁹

The parties fully briefed the case.

II. Entitlement to a Statutory Cause of Action

Entitlement to a statutory cause of action must be established 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 U.S. 82 (2021)

¹⁴ 15 TTABVUE. Federal Rule of Civil Procedure 30(b)(6) provides for corporate depositions, whereby the named organization designates one or more representatives to testify on its behalf.

¹⁵ 16 TTABVUE.

¹⁶ 21 TTABVUE 2-3.

¹⁷ 21 TTABVUE 4-5.

¹⁸ 18 & 19 TTABVUE; confidential exhibits at 20 TTABVUE.

¹⁹ 17 TTABVUE.

(citing *Lexmark Int'l, Inc. v. Static Control Components, Inc.*, 572 U.S. 118, 125-26, 109 USPQ2d 2061, 2067 n.4 (2014)). A party in the position of plaintiff may oppose registration of a mark or petition to cancel a registration when it demonstrates an interest falling within the zone of interests protected by the statute, 15 U.S.C. §§ 1063 & 1064, and a reasonable belief in damage that is 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).

Here, Petitioner must demonstrate a real interest in the proceeding and a reasonable belief of damage from Respondent's registration. *Australian Therapeutic Supplies*, 2020 USPQ2d 10837 at *3; see also *Empresa Cubana Del Tabaco v. Gen. Cigar Co.*, 753 F.3d 1270, 111 USPQ2d 1058, 1062 (Fed. Cir. 2014); *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1727 (Fed. Cir. 2012). "A belief in likely damage typically can be shown by establishing a direct commercial interest." *AT&T Mobility LLC v. Thomann & Dormitus Brands LLC*, 2020 USPQ2d 53785, at *14 (TTAB 2020). Neither Petitioner nor Respondent addressed this issue in briefing the case.

Petitioner formed in 2003 and did business under the trade name CIM Group, Inc.²⁰ until mid-2021. From 2003 to 2010, Petitioner used a different logo than the one depicted in the registration, but including the same letters CIM in the same

²⁰ See 17 TTABVUE 17 (Petitioner's admissions); 15 TTABVUE 11-12 (Respondent's counsel stating that the petitioner in this proceeding is "the CIM Group, Inc., also known as Construction Installation and Maintenance Group, Inc.").

colors, which Respondent designed for the company.²¹ Petitioner then “refreshed” the logo in 2010 with a new design, the one in the registered mark at issue.²² Respondent, who was “president, treasurer, chairman of the board” in 2010,²³ described the “refresh” as follows:

In 2010, I had a medical condition that was very dire. And while I was under medication and had surgery, my mark was changed from what was trademarked to what you're seeing now. When I came back to work and saw it, after all the money that was spent on proofing and changing all the letterhead, the dye markings, the shirts, the magnetic posters for the trucks, **I went ahead and took it** as they changed my original mark, and it was still my mark.

Therefore, I decided to license my mark so that if the company did break apart, I still had my trademark licensed under my name, as I created the original logo. They changed my logo without my authorization while I still own 60 percent of the company. Therefore, the logo is still my property, creative property.²⁴

As noted above, in 2021, Petitioner changed its name to Kesa Incorporated.²⁵ Mr. Ardagna confirmed that although Petitioner previously used the registered mark on

²¹ 16 TTABVUE 43-45 (Rojo Deposition); *see also id.* at 164, 191.

²² 15 TTABVUE 20-26 (Ardagna Deposition); *id.* at 34-35.

²³ 16 TTABVUE 69 (Rojo Deposition).

²⁴ 15 TTABVUE 33-34 (Rojo Deposition, emphasis added). While we do not find the factual dispute material to the issues in this case, we note that Petitioner disputes Respondent’s contention that she was a 60% shareholder. 15 TTABVUE 37-38 (Ardagna Deposition); 21 TTABVUE 3 (Ardagna Rebuttal Declaration).

²⁵ 15 TTABVUE 29-30; *id.* at 51-52; 17 TTABVUE 17 (Petitioner’s admission of the name change in May 2021).

the goods and services listed in Respondent's registration,²⁶ Petitioner no longer does so, as it has transitioned to use of a new logo featuring its new name, Kesa.²⁷

Nonetheless, Petitioner maintains that it still has a commercial interest in the registered mark for several reasons. First, it continues to display the CIM name and logo on its website, which informs users that Petitioner was "formerly known as CIM Group, Inc."²⁸ Second, Petitioner continues to use @cimgroupinc on its internal email exchange server,²⁹ and third, it displays the "CIM Group" logo on the side of Petitioner's 24-foot trucks.³⁰ When asked how Petitioner "is being harmed in this matter by [Respondent's] use of the CIM mark," Mr. Ardagna responded:

Because it's an asset of the corporation, and we still refer to it on our website. It's an asset of this corporation, and this corporation still uses it. This corporation still uses CIM Group in its exchange server. The corporation still uses it on the side of our bobtails [trucks]....³¹

Petitioner has established its entitlement to a statutory cause of action in this case. Despite Petitioner's name change, it continues to display CIM on its trucks and Petitioner's website prominently displays the challenged mark on its website, noting that it was "formerly known as CIM Group Inc." and emphasizing that it remains the

²⁶ 15 TTABVUE 27-28, 35, 42, 44 (Ardagna Deposition).

²⁷ 15 TTABVUE 43-45 (Ardagna Deposition).

²⁸ 15 TTABVUE 30-34 & Exhibit 9 (Ardagna Deposition) *id.* at 45-46.

²⁹ Mr. Ardagna also testified that some "folks ... e-mail us to the CIM address," even after the name change. 15 TTABVUE 31.

³⁰ 15 TTABVUE 33 (Ardagna Deposition); *id.* at 47-48.

³¹ 15 TTABVUE 49-50 (Ardagna Deposition).

same business that has existed “for over 20 years.”³² Also, Petitioner is a competitor or potential competitor of Respondent, who indicated in her deposition that she formed “a shadow business” in case Petitioner’s business “was breaking up.”³³ These facts suffice to show Petitioner’s direct commercial interest in the proceeding. *AT&T Mobility LLC v. Dormitus Brands LLC*, 2020 USPQ2d 53785, at *21-27 (TTAB 2020) (after name change, ongoing use of old name on contracts, leases, and licenses sufficed to show trade name use for purposes of establishing standing); *see also Books on Tape, Inc. v. Booktape Corp.*, 836 F.2d 519, 5 USPQ2d 1301, 1302 (Fed. Cir. 1987) (competitor has standing to challenge registration); *Poly-America, L.P. v. Illinois Tool Works Inc.*, 124 USPQ2d 1508, 1512 (TTAB 2017) (for standing on descriptiveness, genericness, and functionality, “[a] petitioner is required only to be in a position to have a right to use the mark in question”).

III. Non-Ownership

“One must be the owner of a mark before it can be registered.” *Huang v. Tzu Wei Chen Food Co.*, 849 F.2d 1458, 7 USPQ2d 1335, 1336 (Fed. Cir. 1988) (quoting *Holiday Inn v. Holiday Inns, Inc.*, 534 F.2d 312, 189 USPQ 630, 635 n.6 (CCPA 1976)); *see also* Trademark Act Section 1(a), 15 U.S.C. § 1051(a) (“[t]he owner of a trademark used in commerce” may apply for its registration). “[A]n application filed by one who is not the owner of the mark sought to be registered is a void application.” *Hollywood Casino LLC v. Chateau Celeste, Inc.*, 116 USPQ2d 1988, 1992 (TTAB 2015) (quoting

³² 17 TTABVUE 12 (Kesa website screenshots). The screenshots themselves do not show the URL and date, but they are provided in the notice of reliance, *id.* at 2.

³³ 16 TTABVUE 28-32 (Rojo Deposition).

In re Tong Yang Cement Corp., 19 USPQ2d 1689, 1690 (TTAB 1991)). The owner of a mark is the entity that controls the nature and quality of the goods or services sold under the mark. See generally *Noble House Home Furnishings, LLC v. Floorco Enters., LLC*, 118 USPQ2d 1413, 1421 (TTAB 2016).

According to Petitioner, at the time Respondent filed the application underlying her challenged registration, Petitioner owned the mark. Petitioner points out that the company retained a marketing firm to create the logo in the registered mark (which Respondent admitted in her Answer³⁴), for the company's use and benefit, and had used it for nine years by the time Respondent applied to register it.³⁵ Petitioner introduced invoices from the marketing firm that designed the logo in the registered mark, addressed to Mr. Ardagna, "CIM Group, Inc." for "CIM Group branding...."³⁶ Mr. Ardagna testified that Petitioner's adoption of the logo in the registered mark was "decided by the board of directors."³⁷ Although Respondent at that time was Petitioner's "acting president, board of director member, and also an officer of the company,"³⁸ she was out on disability at the time of the final decision."³⁹ Mr. Ardagna also testified that even after Respondent returned to work around the time of the adoption of the logo in the registered mark, Respondent did not claim any rights in it

³⁴ 5 TTABVUE.

³⁵ 15 TTABVUE 21-25, 34 (Ardagna Deposition).

³⁶ 15 TTABVUE 77-79 (Exhibit 7, Ardagna Deposition).

³⁷ 15 TTABVUE 23, 25 (Ardagna Deposition).

³⁸ 15 TTABVUE 35 (Ardagna Deposition).

³⁹ 15 TTABVUE 25 (Ardagna Deposition).

– “[s]he never mentioned it to myself or any of the other board of directors, to the best of my knowledge.”⁴⁰ Petitioner offered testimony that it used the registered mark “continuously since 2010,” was using the mark at the time Respondent applied to register it, and that “[i]t was on our shirts, our website, our stationery, faxes. It was on everything, yes, sir; vans, vehicles, everything.”⁴¹ When asked who owns the registered mark, Mr. Ardagna stated, “I believe it’s the corporation. It’s asset [sic] of the corporation.”⁴²

Respondent’s explanation in her declaration of the ownership situation was:

As creator of the CIM logo, sole founder, and majority shareholder of the Corporation, I determined that I would license the term that I created to the Corporation.

□As the rightful owner of the trademark CIM, I had every right to file for registration of the mark CIM that is designated with the registration number 6,099,423. When I filed the trademark application, I knew myself to be the rightful owner of the mark and sought to protect my rights by filing a trademark application and protect myself from the appropriation of the trademark by those who sought to oust me from the Corporation.

□I have never assigned my rights in the trademark to the Corporation.⁴³

Her explanation of the ownership situation in her deposition was muddled. Starting with the previous CIM logo that the company used from 2003 to 2010, she testified:

⁴⁰ 15 TTABVUE 25 (Ardagna Deposition).

⁴¹ 15 TTABVUE 34-35 (Ardagna Deposition).

⁴² 15 TTABVUE 34 (Ardagna Deposition).

⁴³ 18 TTABVUE 4 (Rojo Declaration).

My design was created in 2003. It was changed later on in 2003, and then it was trademarked,^[44] and the CFO at that time did not want to pay for the trademark to be kept up, and it died. So, therefore -- therefore, I licensed the mark - - I didn't license the mark. I gave the permission for the company to use the logo as if the company was mine 60 percent to use for the company.⁴⁵

Turning to the logo design in the registered mark at issue in this case, she went on to testify (as previously also excerpted above in connection with statutory entitlement):

In 2010, I had a medical condition that was very dire. And while I was under medication and had surgery, my mark was changed from what was trademarked to what you're seeing now. When I came back to work and saw it, after all the money that was spent on proofing and changing all the letterhead, the dye markings, the shirts, the magnetic posters for the trucks, I went ahead and took it as they changed my original mark, and it was still my mark.

Therefore, I decided to license my mark so that if the company did break apart, I still had my trademark licensed under my name, as I created the original logo. They changed my logo without my authorization while I still own 60 percent of the company. Therefore, the logo is still my property, creative property.⁴⁶

In another explanation of the ownership situation, in answering Petitioner's interrogatories, Respondent stated that she "licensed the registered CIM mark to Petitioner in 2010 after she created it. The Petitioner used the licensed mark at its business location. Since the license to Petitioner has ended, Registrant is intending

⁴⁴ The record reflects the filing of a trademark application for the previous CIM logo that went abandoned. 16 TTABVUE 164-91 (Rojo Deposition, Exhibit 3).

⁴⁵ 16 TTABVUE 33 (Rojo Deposition).

⁴⁶ 16 TTABVUE 33-34 (Rojo Deposition).

to use the CIM mark from her address....”⁴⁷ At her deposition, when asked about this interrogatory answer, she stated that the answer was “not correct.”⁴⁸ When asked when the license “ended,” she clarified, “[t]hey never licensed it.”⁴⁹ Respondent stated in answer to other interrogatories that:

... Sometime in 2010, [Respondent] again redesigned the logo and the parties agreed to adopt the new logo. Over the next several years, a dispute arose over the ownership of the logo. Ultimately, [Respondent] elected to file an application for registration of the mark with the Patent and Trademark Office, as the Petitioner was unwilling to compensate her [Respondent] for the cost of creating the logo and for filing for trademark protection.

...

[Respondent] first became aware of the use of the CIM mark when she created it and licensed it to Petitioner April 4, 2010.⁵⁰

Respondent affirmed this assertion in her deposition:

Q. ... I mean, this response [to Interrogatory No. 7], to me, means you applied [to register the mark] because they [Petitioner] didn't want to pay you for the cost of creating the logo; is that correct?

A. Yes.⁵¹

Respondent claims that the company's use was pursuant to a license, but she acknowledged in her deposition that no oral or written license agreement was made:⁵²

⁴⁷ 16 TTABVUE 156 (Interrogatory No. 1).

⁴⁸ 16 TTABVUE 50 (Rojo Deposition).

⁴⁹ 16 TTABVUE 51 (Rojo Deposition).

⁵⁰ 16 TTABVUE 159 (Interrogatory Nos. 7 & 8).

⁵¹ 16 TTABVUE 62 (Rojo Deposition).

⁵² 16 TTABVUE 42-43 (Rojo Deposition).

Q. ... Ms. Rojo, is there a licensing agreement between you and the company for this CIM logo that is in dispute here? Is there a licensing agreement?

A. No. I just did that because I was 60 percent owner, and I did it out of the goodness of my heart and for the goodness of the company. So there was no licensing; there was no fee. I did it as long as I was with the company.

Q. Did you ever tell the board of the company that you are the owner of the CIM trademark and you are just licensing to the company? Did you ever tell the board?

A. They all knew I created the logo. [Discussion ensued about the prior version of the logo]

Q. Thank you. Ms. Rojo, going back to the licensing issue, did the company ever pay you a royalty fee or licensing fee for licensing the CIM logo to the company?

A. No. I did not ask for one.⁵³

In explaining why she did not inform anyone associated with Petitioner about the underlying application for the challenged registration, Ms. Rojo stated, “Since the logo was my creation from the beginning, I was 60 percent owner, and I decided what to do with it. I did not have to inform anyone of such an action.”⁵⁴ She also testified:

I put it in my name, the registration, because I felt the company was breaking up and there would be no more Construction Installation and Maintenance, and I wanted my logo in my name so I could use it further. The company no longer had my permission to use the mark I created since the inception of the company in 2003.⁵⁵

⁵³ 16 TTABVUE 42-45 (Rojo Deposition).

⁵⁴ 16 TTABVUE 33 (Rojo Deposition).

⁵⁵ 16 TTABVUE 32 (Rojo Deposition).

Respondent conceded that she supported the application underlying the challenged registration with specimens of Petitioner's use, with Ms. Rojo referring to Petitioner as "the company that I owned 60 percent of at that time."⁵⁶ Nonetheless, she also briefly took the position that she was using the mark herself, explaining the application as part of "a shadow business" as follows:

Q. Yes. So my question is were you using it at the time you applied -- at the time you applied for this registration in 2019, were you using the mark?

A. Yes.

Q. How were you using the mark?

A. In starting a shadow business.⁵⁷

However, in followup testimony, she clarified that the use she relied on for the application actually was Petitioner's, but she believed she was entitled to claim it because of her alleged 60% interest in the business.⁵⁸ Once again in her Brief, however, Respondent takes the position that there was "an implied license."⁵⁹

Mr. Ardagna testified that there was no license agreement, that Petitioner never paid a license fee, and that Petitioner viewed the mark as a corporate asset.⁶⁰

Respondent cites caselaw for the proposition that an implied license existed, but that same caselaw explains that an implied license must arise "from the parties'

⁵⁶ 16 TTABVUE 30 (Rojo Deposition).

⁵⁷ 16 TTABVUE 28 (Rojo Deposition).

⁵⁸ 16 TTABVUE 30-31 (Rojo Deposition).

⁵⁹ 23 TTABVUE 4.

⁶⁰ 15 TTABVUE 38 (Ardagna Deposition).

conduct evidencing their actual mutual intent to create such enforceable limitations.”⁶¹ Regardless of what her subjective intent may have been, Respondent points to no conduct evidencing that intent, and we find no indication in the record that Petitioner intended to license the logo in the registered mark. Instead, the record reflects behavior consistent with corporate ownership – that Petitioner paid a design firm to create the logo and adopted it through its corporate procedures.⁶² Mr. Ardagna testified that Petitioner’s board approved the logo in the registered mark, and Respondent did not then claim that the logo was hers.⁶³

Relying on *In re Briggs*, 229 USPQ 76 (TTAB 1986), Respondent asserts that because she “created the logo” – although apparently her creation was a previous version of the CIM logo, and not the registered mark at issue – and because she allegedly “was the majority shareholder and president of the corporation,” “she remains the owner and is the proper party to apply for registration.”⁶⁴ However, her various explanations about her alleged ownership and license are inconsistent, illogical, and out of step with the law governing trademark ownership. Her ownership and license claims are further undermined by her failure to communicate any indication of them to Petitioner and the absence of any documentation supporting such claims. *See Lyons v. Am. College of Veterinary Sports Med. & Rehab.*, 859 F.3d 1023, 123 USPQ2d 1024, 1029 (Fed. Cir. 2017) (denying ownership claim in part

⁶¹ 23 TTABVUE 10 (Respondent’s Brief, quotation omitted).

⁶² 5 TTABVUE (Respondent’s Answer); 15 TTABVUE 21-25, 34 (Ardagna Deposition).

⁶³ 15 TTABVUE 25 (Ardagna Deposition).

⁶⁴ 23 TTABVUE 11 (Respondent’s Brief).

because, “At no point did [the former founder and member of a committee] communicate to any of the other committee members her belief that she owned the mark, any prior use of the mark, or any objection to the committee naming the VSO after the mark.”).

Respondent’s emphasis in her Brief on her alleged ownership of the copyright in an earlier version of the CIM logo as an indication that she is the true owner of the registered mark at issue, is misplaced. “[I]t is the prevailing law that ownership of a copyright confers no trademark rights on the copyright owner.... That is to say, [Respondent] owns no trademark rights in the term ... simply by virtue of [her alleged] ownership of a copyright....” *Clamage Indus. Ltd. v. Glendinning Cos., Inc.*, 175 USPQ 362, 363 (TTAB 1972); *see also Moke Am. LLC v. Moke USA, LLC*, 2020 USPQ2d 10400, at *38 n.48 (TTAB 2020), *rev’d on other grounds*, Civ. No. 3:20cv400 mem. op. (E.D. Va. May 3, 2023) (“[O]wnership of a copyright in a design does not, without more, establish that the copyright owner owns any trademark rights in marks that include the design.”).

As the *Biggs* case emphasizes, trademark ownership rests on who controls the nature and quality of the services under the mark. *Biggs*, 229 USPQ at 77; *see also Noble House Home Furnishings*, 118 USPQ2d at 1421. In this case, Petitioner, not Respondent, performed that function in 2019 when Respondent filed the application. In *Biggs*, by contrast, the individual applicant, ultimately deemed to be the proper owner, had adopted and used the mark prior to the incorporation of the corporation that used the mark for the individual applicant who later served as president and

chairman of the board. *Biggs*, 229 USPQ at 77. The record in *Biggs* thus reflected that the individual applicant “continuously exercised control over the nature and quality of the services,” and orally licensed it to the corporation, which was confirmed by a corporate affidavit. *Id.* at 77-78. No analogous situation exists in the case before us, where at the time the application was filed, only Petitioner used the mark, no oral or written license existed, and we have no indication that Respondent, rather than Petitioner, controlled the nature and quality of Petitioner’s services under the mark. Respondent perhaps mistakenly assumed that her alleged creative work in designing the previous version of the CIM logo gave rise to rights in the later version of the CIM logo in the registered mark. This mistaken assumption and her subjective view of fairness, however, do not form a legitimate basis for an implied license by Petitioner.

To the extent Respondent intended to lay claim to the mark for, as she put it, a potential “shadow business” in the event that Petitioner “did break apart,” the substantive framework for evaluating ownership also points to Petitioner’s, not Respondent’s ownership in 2019. *See Lyons v. Am. College of Veterinary Sports Med. & Rehab.*, 859 F.3d 1023, 123 USPQ2d 1024 (Fed. Cir. 2017). She relied on specimens of Petitioner’s use rather than her own in applying for registered mark.⁶⁵ Here, the parties’ objective intentions and expectations evidenced by the Petitioner’s corporate development, adoption and use of the mark reflect corporate ownership of the mark. “[W]hatever secret reservations [Respondent] may have harbored [about ownership] were not reflected in her interactions with [Petitioner],” and her objectively

⁶⁵ 16 TTABVUE 30 (Rojo Deposition).

manifested expectations control. *Id.* at 1029. Finally, the public associated Petitioner, not Respondent, with the use of the CIM logo in the registered mark in 2019.⁶⁶ And Petitioner, not Respondent, stood behind the services offered under the mark. *Id.* at 1028.⁶⁷

Respondent was not the owner of the mark when she filed the application to register it, as required under Section 1(a) of the Trademark Act. “Neither the Board nor the courts can waive this statutory requirement.” *Tzu Wei Chen Food Co.*, 7 USPQ2d at 1336. Therefore, the application underlying Respondent’s registration was void ab initio.

IV. Non-Use

Although Respondent’s non-ownership alone suffices to grant the petition to cancel, we briefly address Petitioner’s non-use claim as well. If it is shown that a registrant made no provable use in commerce of its mark as of the filing date of its underlying use-based application, the resulting registration is invalid for non-use under Section 1(a) of the Act, 15 U.S.C. § 1051(a). *ShutEmDown Sports Inc. v. Lacy*, 102 USPQ2d 1036, 1045 (TTAB 2012); *see also Tao Licensing, LLC v. Bender Consulting Ltd.*, 125 USPQ2d 1043, 1064 (TTAB 2017) (explaining that non-use provides an “independent basis to cancel Respondent’s registration.”). In such cases, the underlying application is deemed void ab initio, and so too is the resulting

⁶⁶ 15 TTABVUE 30-31 (Ardagna Deposition).

⁶⁷ Respondent’s Brief includes arguments that Petitioner “abandoned use of the mark” and “has no residual goodwill,” due to its name change to Kesa Incorporated in 2020-21. 23 TTABVUE 14-15. However, the claim of non-ownership here does not depend on current ownership of the mark by Petitioner, and we need not address those issues.

registration. *ShutEmDown Sports*, 102 USPQ2d at 1045. Because Respondent never used the mark as an individual, and because for the reasons explained above, she was not entitled to rely on Petitioner's use, her "registration..., which is based on an allegation of such use, is invalid and should be cancelled." *Smith v. Coahoma Chemical Co. Inc.*, 264 F.2d 916, 121 USPQ 215, 217 (CCPA 1959). Therefore, the application underlying Respondent's registration was void ab initio for this reason as well.

Decision: The petition to cancel Registration No. 6099423 is granted.