

This Opinion is Not a  
Precedent of the TTAB

Mailed: May 8, 2024

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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*The Plimsouls*  
*v.*  
*Edward David Munoz*

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Cancellation No. 92076883

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Chris Paparella, Michael J. Alan and Justin Ben-Asher of Steptoe LLP  
for The Plimsouls.

Tareef Chamaa of Chamaa Law LLC  
for Edward David Munoz.

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Before Adlin, English and Allard, Administrative Trademark Judges.

Opinion by Adlin, Administrative Trademark Judge:

This is an ownership dispute between Petitioner The Plimsouls, a new wave rock band formed in 1979, and one of its members, Respondent Edward David Munoz. More specifically, Respondent owns a registration for the mark THE PLIMSOULS, in standard characters, for “entertainment in the nature of live performances by a musical band,” in International Class 41 (the “Registration”).<sup>1</sup> Petitioner seeks to cancel the Registration, based, perhaps not surprisingly, on its prior use of the same

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<sup>1</sup> Registration No. 4940705, issued April 19, 2016.

mark (THE PLIMSOULS) for identical services (live performances by a musical group), as well as its use of THE PLIMSOULS for other goods and services such as musical sound recordings. Petitioner's grounds for cancellation are non-ownership, as well as likelihood of confusion and fraud.<sup>2</sup> In his second amended answer, Respondent denies the salient allegations in the petition for cancellation and asserts as an affirmative defense that Petitioner abandoned the involved/pleaded mark THE PLIMSOULS.<sup>3</sup>

**I. The Parties' Selection for and Participation in the Final Pretrial Conference Pilot ("FPCP"), and Stipulation to Utilize Accelerated Case Resolution ("ACR")**

In 2023, the Board announced its FPCP program,<sup>4</sup> and shortly thereafter this case was "identified as suitable for participation in a Final Pretrial Conference," due to "the breadth of the pleadings, as well as the fact-intensive nature of the parties' dispute." 34 TTABVUE 1, 2. The parties thus participated in a FPCP Orientation Conference. 37 TTABVUE.

However, rather than drafting a Final Pretrial Conference Order, as discussed during the Orientation Conference and contemplated by the FPCP, the parties

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<sup>2</sup> Petitioner effectively withdrew its dilution claim following the Final Pretrial Conference pilot Orientation Conference that is described below. *Compare* 37 TTABVUE 3-4 with 41 TTABVUE 29 n.108. 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.

<sup>3</sup> 18 TTABVUE. Respondent expressly withdrew his other true affirmative defenses following the Orientation Conference. *Compare* 37 TTABVUE 5-6 with 42 TTABVUE 60.

<sup>4</sup> Information about the FPCP may be found here: <https://www.uspto.gov/trademarks/trademark-trial-and-appeal-board/final-pretrial-conference-pilot>.

decided to resolve this case through ACR. *See* 37 TTABVUE 7 and 38 TTABVUE. Specifically, the parties elected “a summary bench trial procedure through summary judgment briefs, pursuant to TRADEMARK TRIAL AND APPEAL BOARD MANUAL OF PROCEDURE (“TBMP”) § 702.04(b).” 38 TTABVUE 2.

Thus, pursuant to the parties’ ACR Stipulation, “the TTAB may resolve on the papers any and all issues of material fact that may be presented.” *Id.* The parties further agreed that they may attach to declarations, affidavits or briefs: (1) “materials that, in a typical trial, could be submitted by notice of reliance;” and (2) “[d]ocuments produced in discovery.” *Id.* at 3. The Board approved the ACR stipulation, 39 TTABVUE, and, following our review of the ACR briefs and trial record, appreciates the parties’ efficiently and cooperatively streamlining this case.

## II. The ACR Record

The ACR record consists of the pleadings, and, by operation of Trademark Rule 2.122(b), 37 C.F.R. § 2.122(b), the file of Respondent’s involved Registration. In addition, Petitioner relies upon:

Declarations submitted with its original motion for summary judgment filed prior to this case being selected for the FPCP, from: its counsel Chris Paparella (“Paparella SJ Dec.”); and Plimsouls members David Pahoa (D. Pahoa SJ Dec.”), Louis Ramirez (“Ramirez SJ Dec.”) and Peter Case (“Case SJ Dec.”). 26 and 32 TTABVUE.<sup>5</sup>

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<sup>5</sup> The parties did not expressly stipulate to declarations and exhibits submitted with Petitioner’s original motion for summary judgment being part of the ACR record. However, not only did Respondent not object to consideration of that evidence, but it expressly “proceed[ed] as though [those declarations and exhibits] were filed as exhibits to” Petitioner’s ACR Brief. 42 TTABVUE 40 n.3. *See also* TBMP § 702.04(b) (cited in ACR Stipulation). *Cf. Hilson Rsch. Inc. v. Soc’y for Human Res. Mgt.*, 27 USPQ2d 1423, 1425 n.8 (TTAB 1993)

ACR Testimony Declaration of Kathryn Morrison Pahoā, Mr. Pahoā's widow ("Morrison Pahoā ACR Dec."). 41 TTABVUE 34-35.

ACR Testimony Declaration of Chris Paparella, and the exhibits thereto ("Paparella ACR Dec.") 41 TTABVUE 36-199.

ACR Rebuttal Testimony Declaration of Mr. Case ("Case Reb. Dec.") 43 TTABVUE 21-24.

ACR Rebuttal Testimony Declaration of Mr. Ramirez ("Ramirez Reb. Dec."). *Id.* at 25-28.

ACR Rebuttal Testimony Declaration of Mr. Paparella, and the exhibits thereto ("Paparella Reb. Dec."). *Id.* at 29-89.

Respondent introduced:

Testimony Declaration of Respondent Mr. Munoz, and the exhibits thereto ("Munoz ACR Dec."). 42 TTABVUE 3-6, 12-35.

Testimony Declaration of Tareef Chamaa, Respondent's attorney, and the exhibit thereto ("Chamaa ACR Dec."). *Id.* at 8-10.

### **III. The Parties, Their Use of THE PLIMSOULS and Respondent's Registration of the Mark**

Peter Case, David Pahoā and Louis Ramirez founded the Plimsouls in California in 1979. 26 TTABVUE 31, 34, 36 (D. Pahoā SJ Dec. ¶ 2; Ramirez SJ Dec. ¶ 2; Case SJ Dec. ¶ 2). Respondent joined the band after the others, in late 1979, though he had

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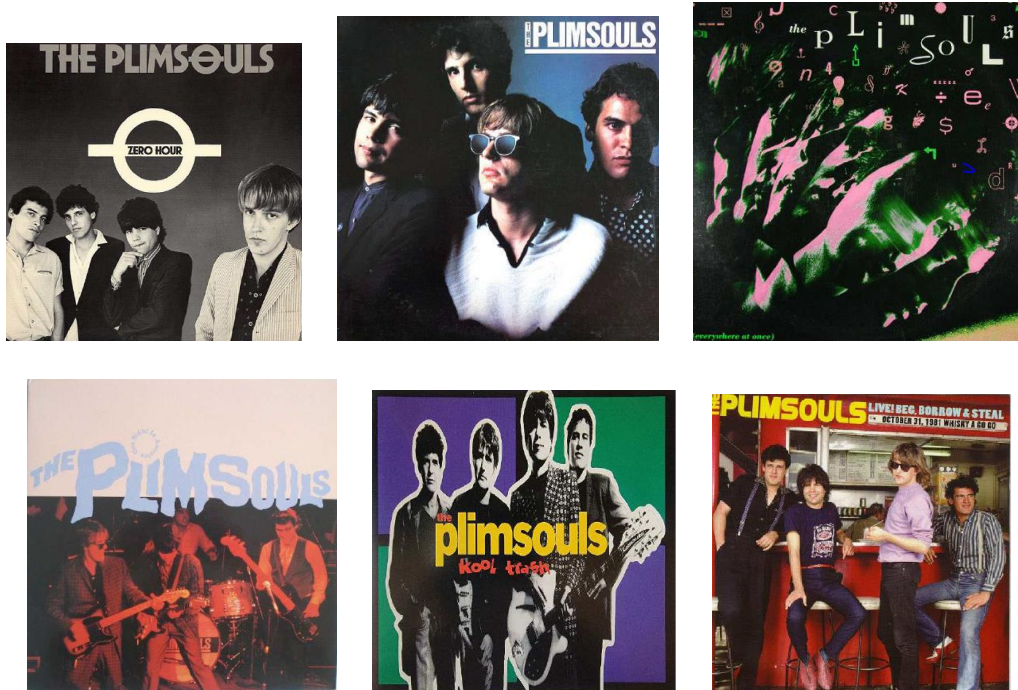
(construing party's failure to object to inadmissible evidence, and treatment of evidence as of record, as "a waiver of any objection" and as a result treating otherwise inadmissible evidence "as if properly of record"); *Midwest Plastic Fabricators Inc. v. Underwriters Labs Inc.*, 12 USPQ2d 1267, 1270 n.5 (TTAB 1989) (same); *Jeanne-Marc, Inc. v. Cluett, Peabody & Co., Inc.*, 221 USPQ 58, 59 n.4 (TTAB 1984) (same).

rehearsed with the band earlier than that, and is considered an “original member.” *Id.* at 36-38 (Case SJ Dec. ¶¶ 2, 6); *id.* at 57, 62 (Munoz Discovery Deposition Tr. 10, 19). All four members view the band as a “partnership.” *Id.* at 34 (Ramirez SJ Dec. ¶ 2) (“The Plimsouls is a partnership.”); *id.* at 37 (Case SJ Dec. ¶ 3) (“The Plimsouls do not have a written partnership agreement, but we have conducted ourselves as a partnership from our inception.”); *id.* at 32 (D. Pahoa SJ Dec. ¶ 3) (“I have reviewed Peter Case’s [SJ] Declaration ... Mr. Case’s Declaration is accurate and true.”); *id.* at 65 (Munoz Disc. Dep. Tr. 30) (“The partnership that was official, that was actually done, was Pete, Lou, Dave and I ... you have to get in a partnership for tax reasons, for business reasons. I mean, I think everybody knows this. And yeah, we had one.”).

From the band’s inception, Mr. Case has “always been the band’s guitarist, lead vocalist, and songwriter.” *Id.* at 36 (Case SJ Dec. ¶ 2); 43 TTABVUE 26 (Ramirez Reb. Dec. ¶ 3). He also “came up with the name the Plimsouls. The name was a play on the English word for sneakers – plimsolls.” 26 TTABVUE 37 (Case SJ Dec. 2). Mr. Pahoa played bass, Mr. Ramirez played drums and Respondent played lead guitar. *Id.* at 36 (Case SJ Dec. ¶ 2).

Respondent has always been an equal partner with Case, Pahoa and Ramirez. *Id.* at 37-38 (Case SJ Dec. ¶¶ 3, 6); *id.* at 67 (Munoz Disc. Dep. Tr. 32) (“I think everybody had an equal say. I don’t know. I don’t really know. It’s all conjecture, man.”). Similarly, although Mr. Ramirez for the most part stopped performing live with the

band in 1983,<sup>6</sup> he and the band’s other members “have received royalties on the sales or streams of the Plimsouls’ recordings from their creation through today,” and with one exception, “every Plimsouls release has featured all four original members, including in cover photographs,” as shown below:



*Id.* at 37-39, 133, 146, 148, 166, 193, 200 (Case SJ Dec. ¶¶ 6, 12 and Paparella SJ Dec. Exs. D, F, G, K, X, Z); 43 TTABVUE 23 (Case Reb. Dec. ¶ 9); 43 TTABVUE 26 (Ramirez Reb. Dec. ¶ 4).

The band’s first recording, released in 1981, was “a five-song EP titled *Zero Hour*” that “reached number 153 on the *Billboard* charts.” 26 TTABVUE 38 (Case SJ Dec. ¶ 8). Mr. Case wrote four of the five songs. *Id.* Next came *The Plimsouls*, a full-length album also released in 1981. That was followed by the album *Everywhere at Once* in

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<sup>6</sup> However, Mr. Ramirez has “played with the Plimsouls in a number of one off live performances over the years since 1983.” 43 TTABVUE 27 (Ramirez Reb. Dec. ¶ 7).

1983, which contained “A Million Miles Away,” the band’s most popular song, previously released as a single in 1982. That song, co-written by Mr. Case, reached number 62 on the *Billboard* charts. *Id.* (Case SJ Dec. ¶ 10). The Plimsouls were featured in the 1983 movie *Valley Girl*, in which they performed “A Million Miles Away,” among other songs. *Id.* (Case SJ Dec. ¶ 11).

After their “heyday” in the early 1980’s, the Plimsouls “have had alternating periods of activity and inactivity ... that is typical of bands that last as long as ours has.” *Id.* at 37 (Case SJ Dec. ¶ 5). Mr. Case described this as “a classic rock and roll pattern of a group that plays and records together for a period of time, then goes on a break, then reunites to pick up where they had left off, repeating that cycle multiple times.” *Id.* Respondent agrees, at least with respect to the Plimsouls specifically, testifying “[t]hat seems to be the way it works.” *Id.* at 98 (Munoz Disc. Dep. Tr. 90).

For example, at the end of 1984, the band played its last live show until reuniting for the first time about 10 years later. *Id.* at 39, 40 (Case SJ Dec. ¶¶ 13, 17); 42 TTABVUE 4 (Munoz ACR Dec. ¶¶ 6-8).<sup>7</sup> After that 1984 show Mr. Case “stepped away from the Plimsouls and began to focus on a solo career in which [he] could record and play folk-inflected music that was a departure from the rock music the Plimsouls played.” 26 TTABVUE 39 (Case SJ Dec. ¶ 13); 42 TTABVUE 4 (Munoz ACR Dec. ¶ 9).

While Respondent recalls Mr. Case telling the other Plimsouls members/partners at the beginning of this original “period of inactivity” that “you guys can have the

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<sup>7</sup> According to Respondent, Mr. Case “left the band in October of 1983,” but “agreed to play several live shows with the band in California and Texas in the summer of 1984 with a different drummer, Charlie Quintana.” 42 TTABVUE 3 (Munoz ACR Dec. ¶¶ 4, 5).

name,” Mr. Case recalls telling the three other members/partners that he “was going to pursue a solo career” and that he “had no objection to” them “continuing to perform as the Plimsouls.” 26 TTABVUE 39 (Case SJ Dec. ¶ 14); *id.* at 79-81 (Munoz Disc. Dep. Tr. 48, 52, 53); 42 TTABVUE 4 (Munoz ACR Dec. ¶ 9). According to Mr. Case:

I said I might even write songs for them and I suggested another singer who I thought would be a good fit for the band. I was only one member of the Plimsouls partnership. I did not believe it was right for me to try to prevent my three bandmates from continuing to earn a living as the Plimsouls. However, I never intended to give [Respondent] the rights to the Plimsouls band and name to the exclusion of myself and Messrs. Pahoa or Ramirez. Nor do I believe I had the right to do that. The Plimsouls name has always belonged to the Plimsouls partnership and not to me or any individual band member.

26 TTABVUE 39 (Case SJ Dec. ¶ 14). Respondent testified that when Mr. Case allegedly said “you guys can have the name,” he “probably meant everybody,” meaning the three remaining band members. *Id.* at 81 (Munoz Disc. Dep. Tr. 53).

Despite Mr. Case’s offers, the band then “went on an extended hiatus.” *Id.* at 40 (Case SJ Dec. ¶ 15). Nonetheless, while on hiatus it released a live album in 1988, and in 1992 released another album, *The Plimsouls Plus* (a combination of the band’s first EP and first album) and re-released *Everywhere at Once* on compact disc. *Id.* (Case SJ Dec. ¶ 16). “Furthermore, as has been the case throughout our history, all four Plimsouls collected royalties on our music during this period.” *Id.*

In late 1994, “the Plimsouls ended our hiatus from playing live and recording because we were given the opportunity to have a song featured on the soundtrack for the movie *Speed*. Therefore, we re-recorded our hit single, ‘A Million Miles Away.’”



*Id.* at 40 (Case SJ Dec. ¶ 17). In addition, Mr. Case “began composing new songs for the Plimsouls.” *Id.*

In February 1995, “the Plimsouls played our first live show since our 1985 New Year’s Eve performance.” *Id.* (Case SJ Dec. ¶ 18). Mr. Case told *AMP Magazine* that the band “kept playing after that, and still play whenever we feel like it: no sense in breaking up a perfectly good rock and roll band twice!” *Id.* at 40, 129 (Case SJ Dec. ¶ 18 and Paparella ACR Dec. Ex. C). In fact, the band “continued playing live shows throughout 1995 and 1996.” *Id.* at 41 (Case SJ Dec. ¶ 19). According to Respondent, “[t]he band performed live as The Plimsouls from 1995 to 1997 with Clem Burke,” of Blondie, as the drummer. 42 TTABVUE 4 (Munoz ACR Dec. ¶ 11).<sup>8</sup>

The band released its third studio album, *Kool Trash*, on a French label in the United States in 1998. 26 TTABVUE 41 (Case SJ Dec. ¶ 20). Mr. Case wrote 10 new songs on the album, one of which Respondent co-wrote. *Id.* The band’s lineup on the

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<sup>8</sup> Respondent testified that “[a] second partnership was formed as ‘The Plimsouls’ in 1995 with the partners consisting of [Respondent], Peter Case, David Pahoia and Clem Burke. The second partnership was dissolved in 2000.” 42 TTABVUE 4, 5 (Munoz ACR Dec. ¶¶ 11, 23). None of the other witnesses mentioned a “second partnership.” Rather, as explained herein, they maintain that the one and only band partnership consisted of Respondent, Case, Pahoia and Ramirez. The accuracy of Respondent’s testimony about a “second partnership” is ultimately not relevant to Petitioner’s claims or Respondent’s defense, especially because the band’s makeup after Mr. Burke joined it was the same regardless of whether there was only the original partnership the parties agree existed, or whether there was also a “second partnership” as alleged by Respondent. Even if the alleged “second partnership” filed the tax return introduced through Respondent’s declaration, *id.* at 4, 33 (Munoz ACR Dec. ¶ 11 and Ex. G), that would be similarly irrelevant. Not only is it signed only by a paid tax preparer, a certified public accountant, as opposed to anyone in the Plimsouls, it identifies the date the “business started” as January 1, 1995, which is 16 years after the Plimsouls formed. Respondent points out that the “final return” box on the return is checked, but does not explain what that checked box signifies. The document is otherwise unexplained, and includes no indication that the “second partnership” dissolved in 2000, much less that the original partnership ever dissolved, even though Respondent cites the tax return as proof of the alleged dissolution. *Id.* at 4 (Munoz ACR Dec. ¶ 11).

album was the same as the original Plimsouls, except that Mr. Burke played drums rather than Mr. Ramirez. *Id.* In 1997, “the Plimsouls played our last show before another extended break that ended in 2005.” *Id.* (Case SJ Dec. ¶ 21); 42 TTABVUE 4 (Munoz ACR Dec. ¶ 12).

Between 2005-2007 the band played “a number of live performances.” 26 TTABVUE 41 (Case SJ Dec. ¶ 22). It “then took another break from performing.” *Id.*

During its “breaks from performing,” the band has continued pursuing its business interests. Specifically, it: releases recordings in new digital formats including compact disc and electronic downloads; licenses its music for streaming; manages its copyrights; and collects royalties. *Id.* at 37-38, 41-42, 150-164 (Case SJ Dec. ¶¶ 4, 6, 23-27 and Paparella SJ Dec. Exs. H, I). For example, in 2019, the band’s partners, including Respondent, executed Notices of Termination of certain copyrights to Sony Music Entertainment and Universal Music Group, as shown below, and filed those Notices with the U.S. Copyright Office:

**VIA CERTIFIED MAIL  
RETURN RECEIPT REQUESTED**

February 14, 2019

Sony Music Entertainment  
25 Madison Ave  
New York, NY 10010

As successor-in-interest to Planet Records, Inc.

**RE: NOTICE OF TERMINATION UNDER 17 U.S.C. § 203 and 37 C.F.R. § 201.10**

Dear Sir or Madam:

The undersigned persons are the authors of the works listed on Schedule A annexed hereto. Pursuant to 17 U.S.C. § 203 and 37 C.F.R. § 201.10, we are hereby serving notice of our intention to terminate the grant or transfer of copyrights and the rights of the copyright proprietor in the works listed below. To the best of our knowledge and belief, this notice has been signed by the only persons whose signatures are necessary to terminate the grant under 17 U.S.C. § 203.

Works: See Schedule A

Name of Author(s): **Peter Case, David Pahoa, Eddie Munoz, Louie Ramirez**

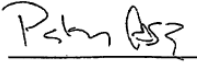
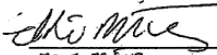

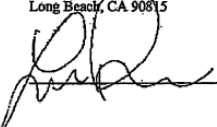
Copyright Date: See Schedule A

Copyright Registration No: See Schedule A

Effective Date of Termination: See Schedule A

Grant Hereby Terminated: The grant or transfer of copyright interests in and to the sound recordings identified in the attached Schedule A, including without limitation the right of publication, as set forth in the recording agreement dated on or about April 8, 1980, between the members of the recording group called the Plimsouls and Planet Records, Inc.

Name(s)/Address(es) of Person(s) Executing Termination:

<b>Peter Case</b> 5758 Geary Blvd., #365 San Francisco, CA 94121	<b>Eddie Munoz</b> 3 Walton Street Toms River, NJ 08753
	
<b>David Pahoa</b> 23939 Califa St. Woodland Hills, CA 91367	<b>Louie Ramirez</b> 1980 Vuelta Grande Ave. Long Beach, CA 90815
	

Schedule A					
Work	Author	Publication Date	Copyright Registration No	Termination Notice Date	Effective Date of Termination
The Plimsouls	Peter Case, Eddie Munoz, David Pahoa, Louie Ramirez	February 20, 1981	SR000025841	February 14, 2019	February 15, 2021
Wish, Hush/Zero Hour/Down Main Ladder	Peter Case, Eddie Munoz, David Pahoa, Louie Ramirez	May 11, 1981	SR000026833	February 14, 2019	February 15, 2021
Now/When You Find Out (Instrumental)	Peter Case, Eddie Munoz, David Pahoa, Louie Ramirez	February 18, 1981	N/A	February 14, 2019	February 15, 2021

*Id.* at 42, 49, 50, 207-229 (Case SJ Dec. ¶¶ 25, 26 and Paparella SJ Dec. ¶¶ 27, 28 and Exs. AA and BB).

Messrs. Case and Ramirez intend to again perform together as The Plimsouls, and have discussed “future live shows.” 26 TTABVUE 35 (Ramirez SJ Dec. ¶ 5); 43 TTABVUE 24 (Case Reb. Dec. ¶ 13); 43 TTABVUE 28 (Ramirez Reb. Dec. ¶ 16). Mr. Pahoa also discussed future live performances with Case and Ramirez, and intended to perform with them, but he passed away in September 2023. 26 TTABVUE 32 (D. Pahoa SJ Dec. 6); 41 TTABVUE 35 (Morrison Pahoa ACR Dec. ¶ 5); 43 TTABVUE 22 (Case Reb. Dec. ¶ 3) (Mr. Pahoa’s “wife Kathy and his five children inherited his ¼

interest in the Plimsouls partnership”). Plimsouls members have performed at various venues in the recent past, including as part of *Valley Girl* reunion shows, as shown below:



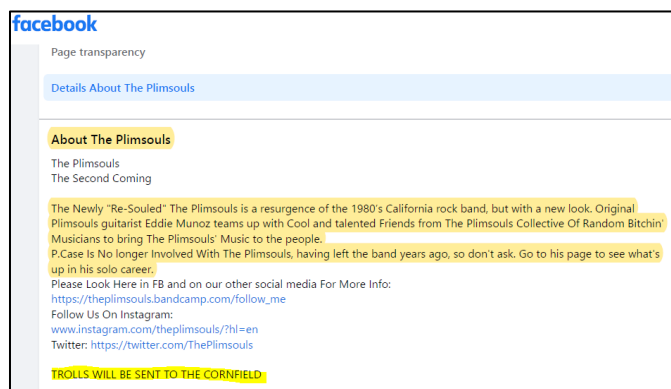
43 TTABVUE 22, 24, 27, 28, 30, 89 (Case Reb. Dec. ¶¶ 4, 13; Ramirez Reb. Dec. ¶¶ 6, 13, 15; Paparella Reb. Dec. ¶ 7 and Ex. T).

Respondent did not contact Mr. Case or Mr. Ramirez before applying to register THE PLIMSOULS. 26 TTABVUE 42 (Case SJ Dec. ¶ 28); *id.* at 35 (Ramirez SJ Dec. ¶ 4); *id.* at 108 (Munoz Disc. Dep. Tr. 106). However, he discussed the matter in “several phone conversations” with Mr. Pahoa, and Mr. Pahoa told Respondent that “he should not file the application because the Plimsouls name belonged to the Plimsouls partnership, not to any individual member.” 26 TTABVUE 32 (D. Pahoa SJ Dec. ¶ 4); *id.* at 107 (Munoz Disc. Dep. Tr. 104).

When asked why he applied for registration of THE PLIMSOULS, Respondent testified that he was “frustrated” because the band was “being offered shows continuously since 2007,” but “they were completely turned down by Peter Case.” *Id.* at 105-06 (Munoz Disc. Dep. Tr. 102-03). Respondent did not attempt to discuss his frustration with Mr. Case because Respondent knew “where he stood, so. He did not want to play in the Plimsouls. I already understood that.” *Id.* at 108 (Munoz Disc. Dep. Tr. 106). Since the involved Registration issued, Respondent has played Plimsouls songs as “The Plimsouls” with musicians other than Mr. Case, Mr. Pahoa or Mr. Ramirez, explaining “You know, after 40 years, no one cares who’s in a band. And you know this. No one even remembers who’s in the band from 40 years ago.” *Id.* at 115-16 (Munoz Disc. Dep. Tr. 118-19).

In August 2016 Mr. Case learned that Respondent “was playing live shows with other musicians under the name ‘The Plimsouls,’ which included playing the Plimsouls original songs, many of which I wrote. I also learned that [Respondent] had obtained a trademark registration on the Plimsouls name.” 26 TTABVUE 43 (Case SJ Dec. ¶ 30). Mr. Case then sent Respondent a text objecting to his use and registration of THE PLIMSOULS. *Id.*

Respondent has “Plimsouls” pages on social media that tout his “Plimsouls” group as opposed to the original Plimsouls band, as shown below:



*Id.* at 50, 51, 244-251 (Paparella SJ Dec. ¶¶ 32, 33 and Exs. FF and GG) (highlighting added). As shown, Respondent’s Plimsouls Facebook page states:

“The Newly ‘Re-Souled’ The Plimsouls is a resurgence of the 1980’s California rock band but with a new look. Original Plimsouls guitarist Eddie Munoz teams up with Cool and Talented Friends from The Plimsouls Collective Of Random Bitchin’ Musicians to bring The Plimsouls’ Music to the people. P.Case Is No longer involved With The Plimsouls, having left the band years ago, so don’t ask ... TROLLS WILL BE SENT TO THE CORNFIELD.

*Id.* at 245.

Mr. Case “understands” that “fans of the Plimsouls have unwittingly bought tickets to live performances by Mr. Munoz’s band under the false impression that the genuine Plimsouls were going to perform. Many of those fans have expressed their

displeasure upon learning the Mr. Munoz’s ‘Plimsouls’ were a fake ....” *Id.* at 44 (Case SJ Dec. ¶ 34). Mr. Case had his attorney send a cease and desist letter to Respondent demanding that Respondent stop using THE PLIMSOULS, but Respondent “persisted,” leading to the filing of this proceeding. *Id.* at 34, 241-42 (Case SJ Dec. ¶ 35 and Paparella SJ Dec. Ex. EE). Mr. Case, Mr. Pahoia and Mr. Ramirez authorized the Plimsouls to file the petition for cancellation, and the three of them, as well as Ms. Morrison Pahoia and the Pahoas’ children continue to support that decision following Mr. Pahoia’s death. *Id.* at 31 (D. Pahoia SJ Dec. ¶ 2); *id.* at 34 (Ramirez SJ Dec. ¶ 2); *id.* at 44 (Case SJ Dec. ¶ 35); 41 TTABVUE 35 (Morrison Pahoia ACR Dec. ¶ 6).

#### **IV. 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) (citing *Lexmark Int’l, Inc. v. Static Control Components, Inc.*, 572 U.S. 118, 125-26 (2014)). To establish entitlement to a statutory cause of action, a plaintiff must demonstrate: (i) an interest falling within the zone of interests protected by the statute; and (ii) a reasonable belief in damage proximately caused by continued registration of the involved mark. *Corcamore, LLC v. SFM, LLC*, 978 F.3d 1298, 2020 USPQ2d 11277, at \*4 (Fed. Cir. 2020).

There can be no doubt that as a general matter a band is entitled to seek cancellation of a registration for its own name, especially when that registration is owned by another performer that plays not only the same type of music, but the same exact songs. *See e.g. Wonderbread 5 v. Patrick Gilles*, 115 USPQ2d 1296, 1301 (“As

an entity that uses the mark WONDERBREAD 5 in rendering live musical performances and in social media to identify itself, Petitioner has shown that it is not a mere intermeddler, but has a real interest” in opposing registration of WONDERBREAD 5 for live musical performances.). *See also Fuji Medical Instruments Mfg. Co., v. Am. Crocodile Int’l Grp., Inc.*, 2021 USPQ2d 831, at \* 5-6 (TTAB 2021); *UVeritech, Inc. v. Amax Lighting, Inc.*, 115 USPQ2d 1242, 1245 (TTAB 2015) (“The dispute over ownership of the mark also establishes standing.”).

Respondent argues, however, that Petitioner has not “produced any evidence to show that it is a firm or corporation organized under the law of California or any other state or foreign country,” and “has not produced evidence sufficient to prove that it is a subsisting partnership under California law.” 42 TTABVUE 50-51. Furthermore, “[w]hile The Plimsouls may have been a partnership perhaps even with a written partnership agreement, in the early 1980s, when The Plimsouls was actively performing live and releasing recorded music that partnership ended when Mr. Case left the band in 1983 or 1984.” *Id.* at 51.<sup>9</sup> We are not persuaded.

As Respondent himself points out, *id.*, under California law, “the association of two or more persons to carry on as coowners a business for profit forms a partnership, whether or not the persons intend to form a partnership.” Cal. Corp. Code § 16202(a). *See also Wonderbread 5*, 115 USPQ2d at 1302 (citing Cal. Corp. Code § 16202(a)); *Eng v. Brown*, 21 Cal.App.5th 675, 694 (2018). Furthermore, “[a] person who receives

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<sup>9</sup> Respondent’s argument that Petitioner is not entitled to a statutory cause of action is in large part based on his theory that Petitioner abandoned the band’s trademark/service mark THE PLIMSOULS. We address Respondent’s abandonment defense in the following section.



a share of the profits of a business is presumed to be a partner in the business.” Cal. Corp. Code § 16202(c)(3). *See also Eng*, 21 Cal.App.5th at 694.

Here, four persons, including Respondent, associated in California to carry on a for-profit business (band) that profited from live musical performances and musical sound recordings. 26 TTABVUE 31, 32, 34, 36, 37, 65 (D. Pahoia SJ Dec. ¶¶ 2, 3; Ramirez SJ Dec. ¶ 2; Case SJ Dec. ¶¶ 2, 3; Munoz Disc. Dep. Tr. 30). All four band members, Messrs. Case, Pahoia, Ramirez and Respondent, continue to receive shares of the band’s profits. *Id.* at 37-39 (Case SJ Dec. ¶¶ 6, 12; 43 TTABVUE 23, 26 (Case Reb. Dec. ¶ 9; Ramirez Reb. Dec. ¶ 4). Thus, the four of them are partners under California law, and the absence of a formal partnership agreement (at least in this record) is immaterial.

Respondent’s argument that the partnership dissolved, 42 TTABVUE 51, is unsupported by any evidence. In fact, while Respondent argues, *id.*, that the partnership dissolved “by the express will to dissolve and wind up the partnership business of at least half the partners” under Cal. Corp. Code § 16801(1), there is no evidence that any of the partners, including Respondent himself, expressed the “will to dissolve and wind up the partnership business.”

Indeed, Mr. Case’s decision to “step away from” the band to focus on his solo career was not an expression of his “will to dissolve and wind up the partnership.” It was an artistic decision to play a different type of music without the band, not a business decision to “dissolve and wind up” a successful band that continued to earn profits after its heyday, and during Mr. Case’s repeated and sometimes long, but temporary,

breaks. 26 TTABVUE 37 (Case SJ Dec. ¶ 6) (“Down through the years and continuing to today, we have never stopped pursuing the Plimsouls’ business as a rock and roll band ....”). In fact, Respondent claims that when Mr. Case left the band he told Respondent that “the remaining members of the band,” could use the name THE PLIMSOULS. 42 TTABVUE 4 (Munoz ACR Dec. ¶ 9); 32 TTABVUE 16-17 (Munoz Disc. Tr. 53-54). Similarly, while Mr. Ramirez stopped regularly performing with the band early in its existence, he never expressed his “will to dissolve and wind up the partnership,” which is not surprising because he continued to earn royalties from it. *Id.* at 34 (Ramirez SJ Dec. ¶ 2) (“The Plimsouls is a partnership. Its partners are Mr. Case, Mr. Pahoia, [Respondent] and me.”); *id.* at 39 (Case SJ Dec. ¶ 12) (“In late 1983, Mr. Ramirez stopped performing live with the Plimsouls. However, he has remained part of the band for all other purposes ... Mr. Ramirez continues to receive royalties from the Plimsouls’ released music.”).<sup>10</sup>

Furthermore, Messrs. Case, Ramirez and Pahoia (prior to his death) discussed performing live together in the future. 26 TTABVUE 35 (Ramirez SJ Dec. ¶ 5); *id.* at 32 (D. Pahoia SJ Dec. 6); 43 TTABVUE 24 (Case Reb. Dec. ¶ 13); 43 TTABVUE 28 (Ramirez Reb. Dec. ¶ 16). Messrs. Pahoia and Ramirez appeared together as “Plimsouls” fairly recently, in 2021 at the Viper Room’s “Return to the Valley”

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<sup>10</sup> As Petitioner points out, Respondent contends that the partnership dissolved when Mr. Case left the band and Mr. Ramirez stopped performing live, but Respondent “does not explain why a partnership that dissolved in early 1984 was filing tax returns in the late 1990s.” 43 TTABVUE 10. Nor does Respondent explain how the alleged “second partnership” relates to Petitioner or this case.

celebration of all things *Valley Girl*. 43 TTABVUE 22, 24, 27, 28, 30, 89 (Case Reb. Dec. ¶¶ 4, 13; Ramirez Reb. Dec. ¶¶ 6, 13, 15; Paparella Reb. Dec. ¶ 7 and Ex. T).<sup>11</sup>

In short, Petitioner has used THE PLIMSOULS for live musical performances over the years, plans to continue doing so, and in any event has been an ongoing for-profit concern (partnership) that has collected royalties on its songs and recordings for the last 40+ years. There is no evidence that the Plimsouls partnership ever dissolved. The band is entitled to request cancellation of the involved registration for its name.

## V. Abandonment

We consider Respondent's abandonment defense first, before Petitioner's non-ownership claim, because 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 Petitioner abandoned its THE PLIMSOULS mark, it would be available for anyone else to adopt and use, and thus own, and there is no dispute that

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<sup>11</sup> Respondent points out that the royalty statements and Notices of Termination of copyrights Petitioner introduced identify the individual band members rather than The Plimsouls partnership. 42 TTABVUE 52. We find this unremarkable, and irrelevant to the question of the partnership's existence, because the individuals are the authors of the copyrighted material and the recipients of the royalties. That Plimsouls members earn money from and contribute copyrighted material to the partnership does not suggest that the partnership does not exist. Similarly, the tax return Respondent cites in support of his claim that the Plimsouls partnership dissolved – a return that is not signed by any Plimsouls members or explained – indicates nothing of the kind. Neither the royalty statements, the Notices of Termination of copyrights, nor the tax return dissolve, express an intention to dissolve, or evidence, the dissolution of the Plimsouls partnership.

Respondent started using the involved mark himself after Petitioner 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”).

Under Section 45 of the Act, 15 U.S.C. § 1127, a mark is 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.” *See also Exec. Coach Builders, Inc. v. SPV Coach Co.*, 123 USPQ2d 1175, 1180-81 (TTAB 2017) (“There are two elements to a nonuse abandonment claim: nonuse of the mark and intent not to resume use. ... Introduction of evidence of nonuse of a mark for three consecutive years constitutes a prima facie showing of abandonment and triggers a rebuttable presumption that a mark was abandoned without intent to resume use.”) (citations omitted); *ShutEmDown Sports Inc. v. Lacy*, 102 USPQ2d 1036, 1042 (TTAB 2012). “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.

Thus, if Respondent “can show three consecutive years of nonuse, [he] has established a *prima facie* showing of abandonment, creating a rebuttable presumption that [Petitioner] has abandoned the mark without intent to resume use.” *ShutEmDown Sports*, 102 USPQ2d at 1042. *See also Azeka*, 122 USPQ2d at 1485 (addressing abandonment raised as an affirmative defense). Respondent bears the burden of proof to establish his 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 Respondent makes a prima facie case of abandonment, the burden of production, i.e., of going forward, shifts to Petitioner to rebut the prima facie showing with evidence, but “[t]he burden of persuasion remains with [Respondent] 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).

Here, Respondent argues that Petitioner abandoned the involved/pleaded mark THE PLIMSOULS because “none of the members of The Plimsouls besides [Respondent] have performed live under that name since 2007<sup>12</sup> and they have not engaged in any commercial activity at all with respect to the mark since they released an album in 2012 ....” 42 TTABVUE 57. We disagree, notwithstanding that there have been multiple three year periods in which the Plimsouls did not perform live, because the group was still using the mark for, *inter alia*, a number of recordings, and earning royalties from those recordings.

Indeed, Respondent’s claim that Petitioner has “not engaged in any commercial activity” under THE PLIMSOULS since 2012 is belied by the record. The band has continued since that time to license its music for streaming, manage its copyrights and collect royalties. 26 TTABVUE 37-38, 41-42, 49, 50, 150-164, 207-229 (Case SJ

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<sup>12</sup> On the very next page of his ACR Trial Brief Respondent contends that “[n]one of the members of the Plimsouls other than [Respondent] have performed live under THE PLIMSOULS name since at least 2012.” 42 TTABVUE 58. Whether Respondent intended to date the last live Plimsouls performance as 2007 or 2012 is not relevant to our decision for the reasons explained below.

Dec. ¶¶ 4, 6, 23, 25-27 and Paparella SJ Dec. ¶¶ 27, 28 and Exs. H, I, AA and BB). In fact, the band has continuously sold its recordings since releasing its first EP in 1981. *Id.* at 37-38, 41-42 (Case SJ Dec. ¶¶ 4, 6, 23, 25-27).

Courts have repeatedly found that these types of activities by musical groups disprove claims of abandonment. *See e.g. Homme v. Kyuss Lives, Inc.*, Case No. CV 12-02009 SJO (DTRx), 2012 WL 13012719 (C.D. Cal. 2012); *Marshak v. Treadwell*, 58 F.Supp.2d 551 (D. N.J. 1999), *aff'd* 240 F.3d 184 (3d Cir. 2001); *Kingsmen v. K-Tel Intern. Ltd.*, 557 F.Supp. 178, 220 USPQ 1045 (S.D.N.Y. 1983); *HEC Enters., Ltd. v. Deep Purple, Inc.*, 213 USPQ 991 (C.D. Cal. 1980). The courts' reasoning is, essentially, that "a musical group's recordings and live performances" are so closely related as to be "parts of a single business enterprise in the public mind," such that the continued use on recordings overcomes a claim of abandonment for live performances. *Marshak*, 58 F.Supp.2d at 574.<sup>13</sup>

In *Marshak* the Court applied this reasoning to an abandonment claim against a musical group, and held as follows:

A successful musical group does not abandon its mark unless there is proof that the owner ceased to commercially exploit the mark's secondary meaning in the music

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<sup>13</sup> As the relevant jury instruction in *Marshak* put it, "[a] change in the kind of goods or services marketed under the trademark is not an abandonment of the trademark owner's priority if prospective purchasers are likely to perceive the new product as originating from the same source as the former product." *Id.* Here, while Petitioner has had several periods of longer than three years in which it did not perform live as THE PLIMSOULS, the question is whether the continued sale and streaming of Petitioner's recorded music throughout these periods would lead consumers encountering another "Plimsouls" group performing live, such as Respondent's, to perceive Respondent's group as originating from the same source as Petitioner's band.

industry. It is insufficient merely to prove that the group stopped performing and recording new songs. In this case, Marshak had the burden to prove that Treadwell stopped using the mark in connection with the continued sale of original Drifters recordings. Marshak adduced no such evidence; indeed, it was stipulated that the original Drifters recordings have been played on the radio and sold in record stores, without interruption, for the past 40 years.

*Id.* at 575. In affirming, the Third Circuit, in a decision written by then-Circuit Judge Alito, quoted with favor the District Court's holding that "[a] successful musical group does not abandon its mark unless there is proof that the owner ceased to commercially exploit the mark's secondary meaning in the music industry." *Marshak v. Treadwell*, 240 F.3d 184, 57 USPQ2d 1764, 1775 (3d Cir. 2001).

Similarly, in *Kingsmen* the Court found no abandonment based on facts similar to those established in this case:

We find that defendants have failed to show either non-use or intent to abandon. Even though plaintiffs disbanded their group in 1967 and ceased recording new material, there is no evidence suggesting that they failed to use the name Kingsmen during the period from 1967 to the present to promote their previously recorded albums. Moreover, the fact that these individuals continue to receive royalties for Kingsmen recordings flies in the face of any suggestion of intent to abandon use of the name Kingsmen. These plaintiffs have no more abandoned their right to protect the name of Kingsmen than have The Beatles, The Supremes or any other group that has disbanded and ceased performing and recording, but continues to collect royalties from the sale of previously recorded material. We must reject defendants' contentions that the name Kingsmen has been abandoned to the public domain.

*Kingsmen*, 220 USPQ at 1049.

In *Marshak v. Schaffner*, Case No. 11 CIV. 1104 (DLC), 2012 WL 1658393, at \*5 (S.D.N.Y. 2012), the Court found that the mark in question remained in use because its owner “continues to sell recordings by The Marvelettes under the mark, and continues to license the group’s music for radio play.” It also rejected the argument that while the mark’s owner “owns the rights to use the mark in connection with the sale of recorded performances, Motown abandoned its use of the mark in connection with live musical performances.” The Court’s rejection of this argument was based on “trademark first principles.” *Id.* at \*5-6. Specifically, Marvelettes recordings offered by one party and live “Marvelettes” performances offered by another would both “draw upon the same source of consumer goodwill,” the group’s original recordings and performances, making consumer confusion likely. *Id.* at 6. Furthermore, the Court rejected the proposition that “one group member could unilaterally abandon the group’s rights in the mark at the expense of the other group members.” *Id.* at 7.

Perhaps even more closely analogous to this case is *HEC*, in which a former member of DEEP PURPLE formed his own band also called DEEP PURPLE (or NEW DEEP PURPLE). The Court found that the plaintiff, the original DEEP PURPLE, continued to use its mark by offering a “new compilation of recordings,” considering the release of previously unreleased recordings and receiving offers to perform live. *HEC*, 213 USPQ at 993. Like the original DEEP PURPLE, here THE PLIMSOULS have continued to release, distribute and sell recordings, and field offers to perform live, and Plimsouls music is still sold and streamed, generating revenue for the partnership.



In short, Petitioner has not abandoned the involved and pleaded mark THE PLIMSOULS. *Marshak v. Schaffner*, 2012 WL 1658393 at \*5 (“Rights in a mark signifying a singing group are not abandoned by the owner upon the group’s disbandment, so long as the owner continues to receive royalties from the sale of the group’s previously recorded material.”).<sup>14</sup>

## VI. Ownership

The crux of this case is which party owns the mark THE PLIMSOULS, because “only the owner of the mark may file an application” to register it. *Wonderbread 5*, 115 USPQ2d at 1303; *see also In re Deister Concentrator Co.*, 289 F.2d 496, 129 USPQ 314, 320 (CCPA 1961). 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 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

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<sup>14</sup> Here, of course, despite its repeated and long “breaks,” Petitioner has not disbanded.

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. *See also UVeritech*, 115 USPQ2d at 1249 (setting forth “several relevant factors” to consider in resolving ownership disputes when “there is a neglect of formalities in defining the business relationship between the parties”).<sup>15</sup> Petitioner bears the burden of proving by a preponderance of the evidence that Respondent does not own THE PLIMSOULS. *Wonderbread 5*, 115 USPQ2d at 1302.

#### **A. The Parties’ Objective Intentions and Expectations**

The record is crystal clear that the parties intended to form, and jointly benefit from, a partnership (band) consisting of Case, Ramirez, Pahoa and Respondent Munoz. 26 TTABVUE 32, 34, 37 (Ramirez SJ Dec. ¶ 2; Case SJ Dec. ¶ 3; D. Pahoa SJ

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<sup>15</sup> The parties in *UVeritech* did not have a written agreement. *UVeritech*, 115 USPQ2d at 1245.

Dec. ¶ 3). As Respondent admits, “[t]he partnership that was official, that was actually done, was Pete, Lou, Dave and I.” *Id.* at 65 (Munoz Disc. Dep. Tr. 30).

Not only was Respondent an original partner and bandmember with Messrs. Case, Ramirez and Pahoā, but he concedes that all of them “had an equal say.” *Id.* at 67 (Munoz Disc. Dep. Tr. 67). All four partners/bandmembers, including Respondent, also earned profits from their partnership and received equal billing on album covers. *Id.* at 37-40, 133, 146, 148, 166, 193, 200 (Case SJ Dec. ¶¶ 6, 12, 14, 16 and Paparella SJ Dec. Exs. D, F, G, K, X, Z); 43 TTABVUE 23, 26 (Case Reb. Dec. ¶ 9; Ramirez Reb. Dec. ¶ 4).

Respondent cannot reasonably or seriously dispute that he and his three partners/bandmates objectively intended and expected that the band would own the mark THE PLIMSOULS. Indeed, Respondent has not only continued to earn royalties from the band’s partnership since he registered THE PLIMSOULS in his own name, but has also affirmatively joined with his partners in managing the band’s copyrights since that time. 26 TTABVUE 42, 49, 50, 207-229 (Case SJ Dec. ¶¶ 25, 26 and Paparella Dec. ¶¶ 27, 28 and Exs. AA and BB).

In other words, Respondent had and continues to have his cake (royalties from the band). But he cannot eat it too (exclusively own the band’s mark), when the record reveals the parties’ joint intention and expectation since 1979 that they would own the mark THE PLIMSOULS together, in partnership.

## **B. Who Does the Public Associate With the Mark?**

The record is also crystal clear on this point. The public associates the involved/pleaded mark THE PLIMSOULS with the group, not just its lead guitarist Respondent.

The band adopted the mark in 1979, and the record shows that the group's use was exclusive until at least 2016, a period of at least 37 years. During those 37 years, all four Plimsouls were pictured, together, on album covers. 26 TTABVUE 38, 39, 133, 146, 148, 166, 193, 200 (Case SJ Dec. ¶¶ 6, 12 and Paparella SJ Dec. Exs. D, F, G, K, X, Z). *Cf. 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”).

The band has enjoyed a fair amount of media exposure, and in 100% of it the mark THE PLIMSOULS is used to identify the group as a whole (which at times has included Mr. Burke rather than Mr. Ramirez on drums). None of the articles made of record use THE PLIMSOULS to identify Respondent alone. *Id.* at 53, 124-131, 135-144, 172-192, 197-198.<sup>16</sup>

In fact, the only evidence of Respondent's use of THE PLIMSOULS apart from his bandmates was prepared by Respondent himself. It consists of Respondent's “Plimsouls” Facebook and Bandcamp pages. *Id.* at 244-251. There is no evidence indicating how many consumers may have been exposed to or interacted with these

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<sup>16</sup> The articles made of record generally focus most intently on Mr. Case, the band's songwriter and lead vocalist.

pages, but there is evidence that “fans have expressed their displeasure upon learning the [Respondent’s] ‘Plimsouls’ were a fake ....” 26 TTABVUE 44 (Case SJ Dec. ¶ 34). Obviously, if fans were displeased upon learning that Respondent’s “Plimsouls” were not the band they expected to see or hear, they did not associate the mark THE PLIMSOULS with Respondent. Rather, they associate the mark with Petitioner.

**C. To Whom the Public Looks to Stand Behind the Quality of Goods or Services Offered Under the Mark**

The public will look to Petitioner, the band they know from recordings, concerts, *Valley Girl* and press reports, to stand behind the quality of goods or services offered under THE PLIMSOULS. This is clear from Mr. Case’s testimony about receiving “numerous communications from fans and friends alike complaining about [Respondent’s] fake ‘Plimsouls’ and asking whether [Mr. Case] was involved with them.” *Id.*<sup>17</sup>

**D. Conclusion Regarding Ownership**

Because THE PLIMSOULS band/partnership owns the mark, Respondent, who is just one of the band’s members, does not. Respondent has at most a joint interest – with Case, Pahoa’s heirs and Ramirez – in the involved mark THE PLIMSOULS. *See*

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<sup>17</sup> By his conduct, specifically his decision to name his new band “The Plimsouls,” and his methods of promoting it, Respondent is effectively encouraging this public perception and tendency. On Facebook, Respondent calls his “Plimsouls” band “a resurgence of the 1980’s California rock band but with a new look,” and “The Second Coming” of THE PLIMSOULS. *Id.* at 245 (Paparella Ex. FF). While the Facebook page also states that “P. Case is No longer involved With The Plimsouls,” Respondent’s Facebook page as a whole nonetheless gives the impression that Respondent’s band is essentially the same group that fans remember from its 1980’s heyday, by calling Respondent’s “Plimsouls” a “resurgence ... but with a new look” and “The Second Coming.” This is clear from fans not complaining to Mr. Case until they “learned” that Respondent’s group was not THE PLIMSOULS.

*Conolty v. O'Connor NYC LLC*, 111 USPQ2d 1302, 1309 (TTAB 2014). Thus, Petitioner has established, by a preponderance of the evidence, that on the filing date of the use-based application underlying Respondent's involved Registration, Respondent did not solely own THE PLIMSOULS, and as a result Respondent's application was void *ab initio*. *Id.*; Trademark Rule 2.71(d), 37 C.F.R. § 2.71(d).

## VII. Likelihood of Confusion

Here, the parties agree that Petitioner was the first to use THE PLIMSOULS, in 1979. 42 TTABVUE 3 (Munoz ACR Dec. ¶¶ 2-3). Respondent did not seek to register the mark until 36 years later. Thus, Petitioner has priority.

There is also a likelihood of confusion, because the parties are using the same mark, THE PLIMSOULS, for competing musical groups. While Petitioner has not played live for some time, and Respondent's involved Registration identifies only "entertainment in the nature of live performances by a musical band," there can be little doubt that confusion is likely nonetheless.

As the cases cited in the Abandonment section above establish, Petitioner's sound recordings, which remain on sale, and Respondent's "Plimsouls" performances "draw upon the same source of consumer goodwill." *Marshal v. Schaffner*, 2012 WL 1658393, at \*5-6 (rejecting argument that "a single mark may be used to designate recorded performances of one origin and live performances of an entirely different origin"); *Marshak v. Green*, 746 F.2d 927, 223 USPQ 1099, 1100 (2d Cir. 1984) ("Entertainment services are unique to the performers ... If another group advertised themselves as VITO AND THE SALUTATIONS, the public could be confused into thinking that they were about to watch the group identified by the registered trade

name.”). Thus, in *HEC*, even though the original DEEP PURPLE “decided to cease presenting live performances in concert for the time being, and to pursue their separate interests,” the Court found “a likelihood of confusion as to the true source” of “New” Deep Purple’s live performances. *HEC Enters.*, 213 USPQ at 992, 993.

Here, there is a likelihood of confusion between the mark Respondent seeks to register and Petitioner’s pleaded identical mark, as both are used for musical groups. *See Wonderbread 5*, 115 USPQ2d at 1301-02 (“when the parties are claiming rights in the same mark for the same goods or services, likelihood of confusion is inevitable”).

### **VIII. Conclusion**

Petitioner has not abandoned its mark THE PLIMSOULS because the band’s music has remained on sale and has been otherwise distributed in various ways throughout the band’s 45-year existence. Respondent is one of the Plimsouls, and he and his bandmates in the original Plimsouls have collected and continue to collect royalties on the band’s music, and have continued to pursue their joint business interests in other ways. There is no evidence that Respondent’s relatively recent formation of his own “Plimsouls” group with different bandmates has altered the public’s association of the mark THE PLIMSOULS with Petitioner. Rather, just as *Messrs. Case, Ramirez and Paho* and Respondent intended when they formed the Plimsouls in 1979, the mark has always identified their group, based on the group’s music, and live and filmed performances. This explains why consumers have complained to Petitioner after mistaking Respondent’s band for Petitioner and being

disappointed as a result. Petitioner owns the mark THE PLIMSOULS, Respondent does not, and Respondent's use of that mark will only cause further confusion.<sup>18</sup>

**Decision:** The petition to cancel is granted on the grounds of non-ownership and likelihood of confusion.

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<sup>18</sup> We need not reach Petitioner's fraud claim. *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).