

This Opinion is Not a
Precedent of the TTAB

Hearing: July 12, 2018

Mailed: July 19, 2018

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board
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UMG Recordings, Inc.

v.

Siggy Music, Inc.

—
Opposition No. 91200616
Cancellation No. 92053622
—

David Donahue and Jason D. Jones of Fross Zelnick Lehrman & Zissu, P.C,
for UMG Recordings, Inc.

Charles W. Grimes and Luca L. Hickman of Grimes LLC,
for Siggy Music, Inc.

—
Before Bergsman, Greenbaum and Coggins,
Administrative Trademark Judges.

Opinion by Bergsman, Administrative Trademark Judge:

Siggy Music, Inc. (“Defendant”) has registered on the Principal Register the mark J5 (typed drawing) for “clothing, namely, footwear, shoes, hats, caps, shirts and jackets,” in Class 25.¹

¹ Registration No. 3059241, registered February 14, 2006; first Section 8 declaration (6-year) accepted; Section 9 renewal application granted; second Section 8 (10-year) declaration has not been accepted. On August 15, 2016, Defendant filed a combined declaration of use and renewal for the registration. In an Office Action dated January 31, 2017, the USPTO informed Defendant that the Section 9 renewal application can be granted but that the

Defendant also filed an application to register on the Principal Register the mark J5 (standard characters)² for the goods listed below:

Colognes, perfumes and cosmetics, in Class 3;

Jewelry, in Class 14;

Books in the field of entertainment and musical performances; Calendars; Comic books; Gift cards; Musical greeting cards; Posters; Printed music books; Story books; Talking children's books, in Class 16;

Canvas shopping bags; Carrying cases; Gentlemen's handbags; Handbags; Handbags, purses and wallets; Keycases; Leather bags and wallets; Luggage; Purses, in Class 18;

Cups and mugs, in Class 21; and

Card games; Musical toys; Parlor games; Party games; Plush toys; Positionable toy figures; Toy action figures and accessories therefor; Toy cars; Toy furniture; Toy houses; Toy model guitars; Toy pianos; Toy record players; Toy watches, in Class 28.³

UMG Recordings, Inc. ("Plaintiff") filed a petition to cancel Defendant's registration and a notice of opposition to the registration of Defendant's application. Plaintiff claims ownership of Registration No. 2881064 for the mark JACKSON 5

Section 8 declaration of use required further explanation regarding Defendant's nonuse of the mark. In an Office Action dated June 25, 2018, the USPTO informed Defendant that the refusal to accept Defendant's Section 8 declaration was continued and that the registration will be cancelled if an acceptable explanation for nonuse is not filed by December 25, 2018.

² Prior to November 2, 2003, "standard character" drawings were known as "typed" drawings. The mark on a typed drawing had to be typed entirely in capital letters. A typed mark is the legal equivalent of a standard character mark.

³ Application Serial No. 77880243, filed November 24, 2009, under Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b), based upon Defendant's allegation of a bona fide intention to use the mark in commerce.

(typed drawing) for “musical sound recordings,” in Class 9,⁴ as well common law rights in the marks JACKSON 5, JACKSON 5IVE and J5 “in connection with musical sound recordings, among other related goods and services.”⁵

In the cancellation proceeding, Plaintiff petitioned to cancel Defendant’s registration on the following grounds:

- Defendant’s mark for clothing so resembles Plaintiff’s mark for musical sound recordings and other goods and services as to be likely to cause confusion under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d);⁶
- Defendant’s mark is likely to dilute the distinctiveness of Plaintiff’s marks under Section 43(c) of the Trademark Act, 15 U.S.C. § 1125(c); and
- Defendant has abandoned the use of its mark in connection with clothing.
- Defendant had not used the mark in commerce on any of the identified goods prior to filing the statement of use.⁷

Defendant, in its Answer, denied the salient allegations in the Petition for Cancellation. As affirmative defenses, Defendant alleges the following:

⁴ Registered September 7, 2004; renewed. Plaintiff disclaimed the exclusive right to use the numeral “5.”

⁵ Amended Petition for Cancellation ¶1 (38 TTABVUE 6); Notice of Opposition ¶1 (1 TTABVUE 3).

⁶ Plaintiff filed the Petition for Cancellation on February 11, 2011, prior to the fifth year anniversary of Defendant’s registration date, February 14, 2011.

⁷ December 4, 2014 order granting in part Plaintiff’s motion to amend its petition for cancellation (49 TTABVUE).

Plaintiff also alleged that the registration “is void because the purported assignment of the Application from [Defendant] to Scrusse Investments violated 15 U.S.C. § 1060(a)(1).” Amended Petition for Cancellation ¶12 (38 TTABVUE 6). Petitioner withdrew this claim in its brief. Petitioner’s Brief, p. 24 n.5 (134 TTABVUE 26).

- Plaintiff's claims are barred by laches, estoppel and acquiescence;
- Plaintiff has abandoned the use of JACKSON 5, JACKSON 5IVE and J5 in connection with any goods or services other than musical sound recordings;
- Plaintiff is contractually estopped from using JACKSON 5, JACKSON 5IVE and J5 in connection with any goods or services other than musical sound recordings; and
- Plaintiff has abandoned use of JACKSON 5IVE and J5 in connection with musical sound recordings.⁸

In the opposition proceeding, Plaintiff opposed the registration of Defendant's mark on the following grounds:

- Defendant's mark for the goods identified in the application so resembles Plaintiff's mark for musical sound recordings and other goods and services as to be likely to cause confusion under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d); and
- Defendant's mark is likely to dilute the distinctiveness of Plaintiff's marks under Section 43(c) of the Trademark Act, 15 U.S.C. § 1125(c).⁹

⁸ Defendant made other allegations in its Answer which were defenses to Plaintiff's claims. Defendant filed a counterclaim to cancel Plaintiff's pleaded registration on the ground of fraud, but withdrew it during the prosecution of the proceedings. 10 and 11 TTABVue in Opposition No. 91200616.

⁹ Plaintiff also alleged that Defendant's attempt to register J5 violates the settlement agreement between the parties. Because Plaintiff did not pursue this claim in its trial brief, it is waived. *Alcatraz Media, Inc. v. Chesapeake Marine Tours Inc.*, 107 USPQ2d 1750, 1753 (TTAB 2013) (petitioner's pleaded descriptiveness and geographical descriptiveness claims not argued in brief deemed waived), *aff'd*, 565 F. App'x 900 (Fed. Cir. 2014) (mem.); *Krause v. Krause Publ'ns, Inc.*, 76 USPQ2d 1904, 1906 n.2 (TTAB 2005).

Defendant, in its Answer, denied the salient allegations in the Notice of Opposition. As affirmative defenses, Defendant alleges the following:

- Plaintiff has abandoned the marks JACKSON 5, JACKSON 5IVE and J5 in connection with any goods or services other than musical sound recordings;
- Plaintiff is contractually estopped from using THE JACKSON-FIVE in connection with any goods or services other than musical sound recordings; and
- Plaintiff abandoned the marks JACKSON 5IVE and J5 in connection with musical sound recordings.

Proceedings were consolidated in the Board's May 9, 2012 order.¹⁰

I. The Record

The record includes the pleadings and, by operation of Trademark Rule 2.122(b), 37 C.F.R. § 2.122(b), Defendant's application and registration files.

The parties have stipulated to the following:

- Documents Defendant produced in response to Plaintiff's request for production of documents are Defendant's authentic business records;¹¹

¹⁰ 9 TTABVUE.

¹¹ 103 TTABVUE.

- Documents produced by third parties Bioworld Merchandising, Inc. and Remrylie Licensing, Inc. pursuant to subpoenas are authentic business records of those companies;¹²
- Defendant “gave an exclusive license to J5 Enterprises, LLC ... to exploit the J5 trademark in connection with clothing, footwear, and caps (the ‘Licensed Rights’);¹³
- “J5 Enterprises engaged Remrylie Licensing, Inc. ... to act on J5 Enterprises’ behalf to arrange for the exploitation of the Licensed Rights;¹⁴
- Remrylie acting on behalf of J5 Enterprises, added Licensed Rights to an overall merchandising and distribution agreement which Remrylie has with Bioworld Merchandising, Inc.;¹⁵
- Bioworld, acting on behalf of Remrylie, exercised the Licensed Rights by, among other things, causing the manufacture of clothing bearing the J5 trademark and distributing such clothing to retailers in the United States;¹⁶
- Documents produced by third party retailers Urban Outfitters, Inc., Macy’s Inc., Target Corporation, Forever 21, Inc., Hot Topic, Inc., and Pacific

¹² 106 TTABVUE.

¹³ *Id.*

¹⁴ *Id.*

¹⁵ *Id.*

¹⁶ *Id.*

Sunwear of California, Inc. pursuant to subpoenas are authentic business records of those companies.¹⁷

A. Plaintiff's testimony and evidence.

1. Testimony declaration of Brent LaBarge, Plaintiff's "Head of the Trademark Group in the Business and Legal Affairs Department";¹⁸
2. Testimony declaration of Harry Weinger, Vice President of A & R (Artists and Repertoire) for Universal Music Enterprises, an unincorporated division of Plaintiff;¹⁹
3. Notice of reliance on Plaintiff's pleaded registration printed from the USPTO electronic database showing the current status of and title to the registration;²⁰

¹⁷ 107 TTABVUE.

¹⁸ 104 TTABVUE.

¹⁹ 105 TTABVUE.

²⁰ 108 TTABVUE 5-12. Plaintiff also introduced copies of Registration No. 0965808 for the mark JACKSON 5IVE (stylized) (cancelled) and Registration No. 0965809 for the mark JACKSON 5 (typed drawing) (expired). 108 TTABVUE 14-21. A cancelled or expired registration has no probative value other than to show that it once issued, and it is not entitled to any of the statutory presumptions of Section 7(b) of the Trademark Act. *See Action Temporary Servs. Inc. v. Labor Force Inc.*, 870 F.2d 1563, 10 USPQ2d 1307, 1309 (Fed. Cir. 1989) ("a cancelled registration does not provide constructive notice of anything.") (citing *Anderson, Clayton & Co. v. Krier*, 478 F.2d 1246, 178 USPQ 46, 47 (CCPA 1973) (recognizing that whatever benefits a federal registration confers are lost when that registration is canceled)); *Kemi Organics, LLC v. Gupta*, 126 USPQ2d 1601, 1606 (TTAB 2018) ("Petitioner's cancelled registrations, however, are only evidence that the registrations issued, and are not evidence of use of the registered marks any time."). Accordingly, the cancelled and expired registrations are not probative of Plaintiff's ownership of the JACKSON 5IVE (stylized) and JACKSON 5 (typed drawing) marks, standing, or strength and fame of those marks.

4. Notice of reliance on third-party registrations purportedly to show that the goods and services of the parties are related;²¹
5. Notice of reliance on a copy from the USPTO Assignment Branch of the assignment of the application that became Registration No. 3059241 involved herein to Scruse Investments, Inc. from Futurist Entertainment, Inc.;²²
6. Notice of reliance on a copy from the USPTO Assignment Branch of the assignment of Registration No. 3059241 involved herein to Defendant from Scruse Investments, Inc.;²³
7. Notice of reliance on excerpts from the discovery deposition of Sigmund Jackson, Defendant's President;²⁴
8. Notice of reliance on Defendant's supplemental responses to Document Request No. 87 stating that "there are no responsive, non-privileged documents";²⁵

²¹ 109 TTABVUE 6-29.

²² 109 TTABVUE 30-33.

²³ 109 TTABVUE 35-38.

²⁴ 111 TTABVUE 7-96. The portions of the Jackson deposition designated as confidential are posted on 110 TTABVUE.

²⁵ 111 TTABVUE 98-101. Plaintiff also proffered the response to document request No. 88 identifying the responsive documents that have been produced. However, responses to document production requests are admissible solely for the purpose of showing that a party has stated that there are no responsive documents. *See City Nat'l Bank v. OPGI Mgmt. GP Inc./Gestion OPGI Inc.*, 106 USPQ2d 1668, 1674 n.10 (TTAB 2013); *ShutEmDown Sports Inc. v. Lacy*, 102 USPQ2d 1036 n.7 (TTAB 2012). Accordingly, the response to document request No. 88 is given no consideration.

9. Notice of reliance on Defendant's supplemental response to Interrogatory No. 28;²⁶
10. Notice of reliance on documents produced by Defendant and stipulated as authentic;²⁷
11. Notice of reliance on documents produced in response to subpoenas *duces tecum* by third parties Bioworld Merchandising, Inc., Remyrlie Licensing, Inc., Urban Outfitters, Inc., Macy's Inc., Forever, Inc., Hot Topic, Inc. and Pacific Sunwear of California, Inc. that have been stipulated as authentic business records;²⁸
12. Notice of reliance on documents printed from the Internet purportedly to show the fame of Plaintiff's marks;²⁹
13. Notice of reliance on printed publications purportedly to show the fame of Plaintiff's marks;³⁰ and

²⁶ 111 TTABVUE 103-107.

²⁷ 113 TTABVUE. The documents designated as confidential are posted on 112 TTABVUE. Some of the documents posted on 112 and 113 TTABVUE are totally or partially illegible. It is the responsibility of the party making submissions to the Board via the electronic database to ensure that the testimony or evidence has, in fact, been properly made of record. *See Weider Publ'ns, LLC v. D&D Beauty Care Co.*, 109 USPQ2d 1347, 1350-51 (TTAB 2014); *Alcatraz Media*, 107 USPQ2d at 1758 n.16 ("the onus is on the party making the submissions to ensure that, at a minimum, all materials are clearly readable by the adverse party and the Board"); *Hard Rock Cafe Licensing Corp. v. Elsea*, 48 USPQ2d 1400, 1404 (TTAB 1998) ("It is reasonable to assume that it is opposer's responsibility to review the documents it submits as evidence to ensure that such submissions meet certain basic requirements, such as that they are legible and identified as to source and date."). We have given illegible evidence probative value to the extent that we can read and understand what it says.

²⁸ 115 TTABVUE. The documents designated confidential have been posted on 114 TTABVUE.

²⁹ 116 TTABVUE.

³⁰ 117 TTABVUE.

14. Rebuttal testimony declaration of Brent LaBarge, “Head of the Trademark Group in the Business and Legal Affairs Department” of Plaintiff.³¹

B. Defendant’s testimony and evidence.

1. Notice of reliance on excerpts from the discovery deposition of Sigmund Jackson purportedly which should in fairness be considered so as to not make misleading what was offered by Plaintiff;³²
2. Testimony declaration of Sigmund Jackson;³³ and
3. The cross-examination testimony of Sigmund Jackson.³⁴

II. Background

In the 1960’s, the Jackson brothers Michael, Jermaine, Toriano, Marlon and Sigmund Jackson began performing together as a musical group under the name the JACKSON 5.³⁵ Plaintiff’s predecessor-in-interest (jointly referred to as “Plaintiff”) signed the Jackson brothers to a contract on March 11, 1969.³⁶ The March 1969 recording contract, as well as the 1980 Settlement Agreement and Mutual Release, discussed more fully below, include provisions regarding the ownership of the marks

³¹ 129 TTABVUE. The portions of the LaBarge rebuttal testimony declaration designated as confidential are posted on 128 TTABVUE.

³² 120 TTABVUE. The portions for the Jackson deposition designated as confidential are posted on 119 TTABVUE.

³³ 122 TTABVUE. The portions of the Jackson testimony declaration designated as confidential are posted on 121 TTABVUE.

³⁴ 132 TTABVUE. The portions of the Jackson cross-examination deposition designated as confidential are posted on 131 TTABVUE.

³⁵ Jackson Testimony Decl. ¶¶2-3 (122 TTABVUE 2); Weinger Testimony Decl. ¶8 (105 TTABVUE 4).

³⁶ Weinger Testimony Decl. ¶7 (105 TTABVUE 4); Jackson Testimony Decl. ¶7 (122 TTABVUE 3).

at issue herein. Both documents were designated as confidential in their entirety. Fed.R.Civ.P. 26(c)(7) protects confidential, trade secret, and commercially sensitive information by allowing a party to limit the access to trade secret or other confidential information or by permitting the information to be revealed only in a designated way. The Advisory Committee Notes to the 1970 Amendment explain that the Rule does not provide complete immunity against disclosure; rather, in each case, the need for privacy must be weighed against the need for disclosure. Therefore, in rendering our decision, we will not be bound by the parties' designation. *See* Trademark Rule 2.116(g), 37 C.F.R. § 2.116(g) ("The Board may treat as not confidential that material which cannot reasonably be considered confidential, notwithstanding a designation as such by a party."); *RxD Media, LLC v. IP Application Dev. LLC*, 125 USPQ2d 1801, 1804 n.9 and 1806 nn. 13-15, 25 (TTAB 2018) (Board not bound by parties' improper designation of material as confidential). Board proceedings are designed to be publicly available and the improper designation of materials as confidential thwarts that intention. It is more difficult to make findings of fact, apply the facts to the law, and write decisions that make sense when the facts may not be discussed. The Board needs to be able to discuss the evidence of record, unless there is an overriding need for confidentiality, so that the parties and a reviewing court will know the basis of the Board's decisions. The provisions of the recording contract and settlement agreement regarding the ownership of the trademarks are not confidential. In this

regard, we note that in at least two books that are publicly available, the ownership of the trademarks were discussed.³⁷

For our purposes, the pertinent parts of the 1969 recording contract are summarized below:³⁸

- The Jackson brothers granted Plaintiff the exclusive right to their individual “name[s]” “in any manner and for any purpose reasonably related to the phonograph record business,” including “commercial tie-ups, merchandising, endorsements and by-products advertising or publicizing phonograph records and/or any other products, commodities or services;”³⁹
- The Jackson brothers granted Plaintiff the same rights in the collective name of the group – THE JACKSON FIVE – as set forth above;⁴⁰
- Plaintiff owns all right, title and interest in the fictitious character name THE JACKSON FIVE, as well as any other fictitious character name the Jackson brothers use;⁴¹

³⁷ Sharon Davis, *MOTOWN: THE HISTORY*, p. 173 (Guinness Books 1988) (117 TTABVUE 38) (“Gordy [Plaintiff’s principal] also continued to own the name the Jackson 5. The settlement also provided full usage by Motown of all Michael Jackson and Jackson 5 records recorded while they were signed to Motown.”); David Bianco, *HEAT WAVE: THE MOTOWN FACT BOOK*, p. 151 (Popular Culture, Inc. 1988) (117 TTABVUE 49) (“The lawsuit between Motown and CBS/Epic concerning the Jacksons is settled at the appellate court level. The name ‘Jackson 5,’ remains the property of Berry Gordy and Motown.”).

³⁸ Jackson Testimony Dep., Exhibit B (131 TTABVUE 194) (confidential).

³⁹ Jackson Testimony Dep. Exhibit B, Section 6 (131 TTABVUE 198).

⁴⁰ Jackson Testimony Dep. Exhibit B, Section 15(A) (131 TTABVUE 201).

⁴¹ Jackson Testimony Dep., Exhibit B, Section 16 (131 TTABVUE 201).

- Plaintiff has the “absolute and unencumbered right to assign, lease, license or otherwise transfer in whole or in part any or all of [Plaintiff’s] rights under this agreement, included [sic] but not limited to the products of your services and the right to require [the Jackson brothers] to render services.”⁴²

Defendant testified that pursuant to the above-noted agreement, Plaintiff owned all rights to the “Jackson 5 name,” as well as any group name under which the Jackson brothers performed.⁴³

Pursuant to the above-noted contract, Plaintiff and the Jackson brothers used the marks JACKSON 5, JACKSON 5IVE and J5 in connection with musical performances, sound recordings and merchandise, including t-shirts and board games.⁴⁴ When the Jackson brothers’ contract with Plaintiff expired in the mid-1970’s, the Jackson brothers signed with Epic Records and ceased to perform and record under the JACKSON 5 name and mark. Nevertheless, Plaintiff continues to sell recordings under the JACKSON 5 mark that the group had recorded while under contract with Plaintiff.⁴⁵

The relationship between Plaintiff and the Jackson brothers did not end well. There were several lawsuits. Finally, in 1980 Plaintiff and several parties, including Defendant’s President Sigmund Jackson as one of the Jackson brothers, entered into

⁴² Jackson Testimony Dep. Exhibit B, Section 17 (131 TTABVUE 201).

⁴³ Jackson Testimony Dep., p. 13 (132 TTABVUE 15).

⁴⁴ Weinger Testimony Decl. ¶¶12-16 and Exhibits 1 and 2 (105 TTABVUE 4-6 and 14-27).

⁴⁵ Weinger Testimony Decl. ¶¶17-25 and Exhibits 3 -6 (105 TTABVUE 6-8 and 29-70).

a Settlement Agreement and Mutual Release.⁴⁶ For our purposes, the pertinent parts of the Settlement Agreement and Mutual Release are summarized below:⁴⁷

- Section 4(C)(1) provides that Plaintiff retains the right to “rerelease” albums or single recordings recorded by the Jackson brothers musical group or any of the Jackson brothers individually prior to March 11, 1976 pursuant to the March 11, 1969 contract (“Old Product”);⁴⁸
- Sections 5(A) and (B) provide that Plaintiff may release any recording or master recorded prior to March 11, 1976 by the Jackson brothers musical group or any of the Jackson brothers individually but not previously released, including new “Best-of” albums (“New Product”);⁴⁹
- Section 7(A) provides that the Jackson brothers “waive and relinquish their right to use the name “The Jackson-Five””;⁵⁰ and
- Section 7(B) provides that Plaintiff “may use the name ‘Jackson-Five’ only in respect to selling, advertising, or otherwise promoting, licensing, distributing, or otherwise disposing of the Old Product, and the New Product.”⁵¹

⁴⁶ Jackson Testimony Decl. ¶¶9-10 (122 TTABVUE 3 and 121 TTABVUE 4).

⁴⁷ Jackson Testimony Decl. Exhibit 1 (121 TTABVUE 13-28) (confidential).

⁴⁸ 121 TTABVUE 15. For reasons not relevant to this decision, the interests of Jermaine Jackson differ from the other Jackson brothers with respect to the Settlement Agreement and Mutual Release.

⁴⁹ 121 TTABVUE 16.

⁵⁰ 121 TTABVUE 17.

⁵¹ 121 TTABVUE 17.

Defendant concedes that the Settlement Agreement and Mutual Release does not provide that the Jackson brothers collectively or individually own or have the right to use the trademark J5 or any other marks.⁵²

III. Standing

Standing is a threshold issue that must be proven by the plaintiff in every inter partes case. *See Empresa Cubana Del Tabaco v. Gen. Cigar Co.*, 753 F.3d 1270, 111 USPQ2d 1058, 1062 (Fed. Cir. 2014); *John W. Carson Found. v. Toilets.com Inc.*, 94 USPQ2d 1942, 1945 (TTAB 2010). Plaintiff has established its standing by properly introducing into evidence its pleaded registration. *See, e.g., Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1844 (Fed. Cir. 2000); *N.Y. Yankees P'ship v. IET Prods. & Servs., Inc.*, 114 USPQ2d 1497, 1501 (TTAB 2015). Once a plaintiff has established its standing for one ground, it has the right to assert any other grounds. *See Poly-America, L.P. v. Illinois Tool Works, Inc.*, 124 USPQ2d 1508, 1512 (TTAB 2017); *Corporacion Habanos SA v. Rodriquez*, 99 USPQ2d 1873, 1877 (TTAB 2011) (because petitioners alleged standing as to at least one ground, primarily geographically deceptively misdescriptive, they may assert any other legally sufficient claims including those under Section 2(a), the Pan American Convention and fraud); *Enbridge, Inc. v. Excelerate Energy LP*, 92 USPQ2d 1537, 1543 n.10 (TTAB 2009).

Defendant argues to the contrary that Plaintiff does not have standing because the Settlement Agreement and Mutual Release discussed above limits Plaintiff's

⁵² Jackson Testimony Dep., pp. 14-15 (132 TTABVUE 16-17).

rights to THE JACKSON-FIVE trademark in connection with musical sound recordings and that all other trademarks relating to the Jackson brothers belong to the Jackson brothers.⁵³ Defendant reasons, in essence, that because the Settlement Agreement and Mutual Release limits Plaintiff's rights to the use of THE JACKSON-FIVE in connection with musical sound recordings, and all of the other marks relating to the Jackson brothers, including J5, belong to Defendant, Plaintiff is contractually estopped from bringing this consolidated proceeding.⁵⁴ Defendant's arguments are not well taken. The Settlement Agreement and Mutual Release does not exclusively appropriate rights to the J5 trademark or any other marks to the benefit of Defendant or the Jackson brothers collectively or individually. Also, the Settlement Agreement and Mutual Release does not prohibit Plaintiff from protecting its exclusive right to use its JACKSON-FIVE trademark for musical sound recordings from other marks that are likely to cause confusion, nor does it prohibit Plaintiff from using the mark JACKSON 5 or J5 for musical sound recordings. For example, one of the issues in these proceedings is whether Defendant's use of the mark J5 in connection with clothing and other products so resembles Plaintiff's registered mark JACKSON 5 for musical sound recordings as to be likely to cause confusion.

⁵³ Defendant's Brief, p. 22 (137 TTABVUE 23) (confidential).

⁵⁴ Defendant's Brief, pp. 22-29 (137 TTABVUE 23-30)

IV. Nonuse of Defendant's registered mark J5 as of the deadline for filing a Statement of Use

"It is clear that an applicant cannot obtain a registration under Section 1 of the Trademark Act for goods or services upon which it has not used the mark. 15 U.S.C. § 1051." *Grand Canyon W. Ranch, LLC v. Hualapai Tribe*, 78 USPQ2d 1696, 1698 (TTAB 2006). The Trademark Act provides that "[t]he term 'use in commerce' means the bona fide use of a mark in the ordinary course of trade, and not made merely to reserve a right in a mark." 15 U.S.C. § 1127; *see also Christian Faith Fellowship Church v. Adidas AG*, 841 F.3d 986, 120 USPQ2d 1640, 1642 (Fed. Cir. 2016) (providing an overview of the statutory use in commerce requirement); *Paramount Pictures Corp. v. White*, 31 USPQ2d 1768, 1773-75 (TTAB 1994) (reviewing the legislative history), *aff'd unpub'd*, 108 F.3d 1392 (Fed. Cir. 1997). The Trademark Act further specifies that a trademark shall be deemed to be in use in commerce when the goods bearing the mark "are sold or transported in commerce." 15 U.S.C. § 1127.

Defendant's registration for the mark J5 for "clothing, namely, footwear, shoes, hats, caps, shirts and jackets," was registered on February 14, 2006. However, Mr. Jackson testified that Defendant launched the J5 clothing collection in August 2010, that before the August 2010 launch, neither Defendant, nor its predecessors-in-interest, had ever used the J5 mark in commerce, and that the August 2010 launch was the first time Defendant, or its predecessors-in-interest, used the J5 mark.⁵⁵ In fact, in his discovery deposition, Mr. Jackson testified the t-shirt submitted as a

⁵⁵ Jackson Testimony Dep., pp. 21 and 24-25 (132 TTABVUE 23 and 26-27).

specimen of use as part of the statement of use underlying the registration “w[as] never out in the market for sale.”⁵⁶ Defendant made approximately 15 t-shirts which were given away.⁵⁷ In his testimony declaration, Mr. Jackson failed to testify as to when Defendant first used the J5 mark⁵⁸ and there is no other evidence demonstrating Defendant’s use of J5 at or near the time the registration issued. Nevertheless, Defendant argues that it attempted to market products under the J5 mark.

Q. What was Futurist Entertainment?

A. It was a company I had in Beverly Hills, an office staff of ten people - - twelve people. It was a company where we had a record label. We signed artists. Futurist Records was the record label. We made merchandising with the company, all kinds of Jackson 5, J5, Jackson merchandising we put up. It was sort of a dot-com company at the time, but when the dot-com fell down, the company fell as well at that time. But we never did sell any merchandising from that company.

Q. Were you offering merchandise under those - - the J5 and Jacksons and Jackson 5 on the Internet?

A. Yes, yes.

* * *

Q. You have no evidence that Futurist Entertainment ever offered any J5 merchandise for sale, do you?

⁵⁶ Jackson Discovery Dep., p. 138 (110 TTABVUE 71) (confidential). This testimony was designated improperly as confidential.

⁵⁷ Jackson Discovery Dep., p. 139 (110 TTABVUE 72) (confidential). This testimony was designated improperly as confidential.

⁵⁸ 121 and 122 TTABVUE.

- A. No. We didn't offer anything for sale. We made it for sale, but we never sold anything from it.
- Q. But you have no evidence that it was even offered for sale do you?
- A. Not that I can think of. I don't know. I'm not sure.⁵⁹

Mr. Jackson's testimony is not persuasive. *See Jim Dandy Co. v. Martha White Foods, Inc.*, 458 F.2d 1397, 173 USPQ 673, 676 (CCPA 1972) (rejecting proffered showing of use in commerce based on witness testimony that was "far from clear and definite"). In addition, we cannot ignore Defendant's lack of any records or other documentation showing use of the J5 trademark at or near the time Defendant filed the statement of use.

In view of the foregoing, we find that Defendant failed to make use of the mark in commerce prior to the expiration of time (as extended) for filing its statement of use,⁶⁰ and the petition to cancel Defendant's registration on that ground is granted.⁶¹

⁵⁹ Jackson Testimony Dep., pp. 24-25 (132 TTABVUE 26-27).

⁶⁰ Because a Notice of Allowance issued March 12, 2002, and Defendant sought and was granted five extensions of time to file a statement of use, the deadline for filing a statement of use was March 12, 2005, five days after Defendant filed such statement. *See Embarcadero Techs. v. Delphix Corp.* 117 USPQ2d 1518, 1526 (TTAB 2016); TMEP § 1109.16(a) (Oct. 2017). Here, the additional five days are of no consequence as we find that Defendant failed to make use of the mark in commerce at or near the time it filed the statement of use – including through March 12, 2005. To the extent there is any question with regard to the extra five days, the Board will deem the pleadings to be amended to conform to the proof where an issue has been tried by the implied consent of the parties. *See Fed. R. Civ. P. 15(b)*.

⁶¹ Defendant's equitable affirmative defenses of laches, estoppel and acquiescence do not apply against a claim of nonuse. *Cf. Linville v. Rivard*, 41 USPQ2d 1731, 1733 n.4 (TTAB 1996), *aff'd on other grounds*, 133 F.3d 1446, 45 USPQ 1374 (Fed. Cir. 1998) (equitable defenses do not apply against an abandonment claim).

V. Abandonment of Defendant's J5 trademark

Although our determination regarding nonuse suffices to grant the petition to cancel, given the broader nature of the parties' dispute, we also reach the issue of abandonment.

The Trademark Act provides for the cancellation of a registration if the registered mark has been abandoned. *See* Section 14 of the Trademark Act, 15 U.S.C. § 1064.

Under Section 45 of the Trademark Act, 15 U.S.C. § 1127, a mark is considered abandoned when "its use has been discontinued with intent not to resume such use."

The definition of abandonment is found in this provision, as follows:

A mark shall be deemed to be "abandoned" if either of the following occurs:

(1) When its use has been discontinued with intent not to resume such use. Intent not to resume may be inferred from circumstances. Nonuse for 3 consecutive years shall be prima facie evidence of abandonment. "Use" of a mark means the bona fide use of such mark made in the ordinary course of trade, and not made merely to reserve a right in a mark.

...

15 U.S.C. § 1127.

Because registrations are presumed valid under the law, the party seeking their cancellation bears the burden of proving a prima facie case of abandonment 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); *Cerveceria Centroamericana S.A. v. Cerveceria India Inc.*, 892 F.2d 1021, 13 USPQ2d 1307, 1309 (Fed. Cir. 1989); *Exec. Coach Builders, Inc. v. SPV Coach Co.*, 123 USPQ2d 1175, 1180-81 (TTAB 2016). If

the petitioner presents a prima facie case of abandonment, the burden of production, i.e., going forward, then shifts to the trademark holder to rebut the prima facie showing with evidence. *Cerveceria India Inc.*, 13 USPQ2d at 1311.

Abandonment is a question of fact. *See Stock Pot Rest., Inc. v. Stockpot, Inc.*, 737 F.2d 1576, 222 USPQ 665, 667 (Fed. Cir. 1984). Thus, any inference of abandonment must be based on proven fact. Section 45 of the Trademark Act. *See also Cerveceria India Inc.*, 13 USPQ2d at 1310 (“The protection due the registrant is provided by requiring that the inference have an adequate foundation in proven fact. Whenever an inference is based on pure speculation and ‘there is no basis ... to *infer nonuse*,’ a prima facie case of abandonment must fail.”) (quoting *P.A.B. Produits et Appareils de Beaute v. Satinine Societa in Nome Collettivo di S.A. e. M. Usellini*, 570 F.2d 328, 332-33, 196 USPQ 801, 804-05 (CCPA 1978)); *Stetson v. Howard D. Wolf & Assoc’s*, 955 F.2d 847, 21 USPQ2d 1783, 1785 (2d Cir. 1992) (A party claiming that a mark has been abandoned must show “non-use of the mark by the legal owner and no intent by that person or entity to resume use.”).

Proof of non-use for three consecutive years, however, constitutes prima facie evidence of abandonment, because it supports an inference of lack of intent to resume use. Section 45 of the Trademark Act; *see also On-line Careline Inc. v. Am. Online Inc.*, 56 USPQ2d at 1476 (“The party seeking cancellation establishes a prima facie case of abandonment by showing proof of nonuse for three consecutive years.”); *Emergency One, Inc. v. Am. FireEagle, Ltd.*, 228 F.3d 531, 56 USPQ2d 1343, 1346

(4th Cir. 2000) (“Proof of three consecutive years of non-use thus creates a presumption — a mandatory inference of intent not to resume use.”).

Defendant’s Registration No. 3059241 for the mark J5 for clothing involved herein registered on February 14, 2006. As noted in the discussion above, Defendant did not use that mark in commerce until August 2010 or until 4½ years after registration. The gap of nonuse between the registration date and Defendant’s August 2010 launch date for the J5 collection establishes a prima facie case of abandonment based on at least three consecutive years of nonuse. Thus, the burden of going forward and rebutting the prima facie showing, with evidence, shifts to Defendant.

In its brief, Defendant points out that Sigmund Jackson testified that Futurist Entertainment, Inc., Defendant’s predecessor-in-interest, offered certain merchandise for sale over the Internet under various marks, including J5.⁶² However, the testimony on which Defendant relies was discussed and quoted in the previous section of this decision and is vague, inconclusive and contradictory. So is the testimony in Mr. Jackson’s discovery deposition:

Q. But has any clothing bearing the J5 trademark that emanates from one of your companies ever been offered to the public?

A. I’m not sure.

Q. As –

A. I don’t want to say yes. I’m not really sure.

Q If you needed to find out, what would you do?

⁶² Defendant’s Brief, p. 39 (138 TTABVUE 40) (citing Jackson Testimony Dep., p. 24 (132 TTABVUE 26)).

A. As far as any J5 or Jackson 5 merchandise sales to -
-

Q. J5.

A. J5? I'm not sure.⁶³

Defendant also references its efforts to commercialize the J5 trademark in February 2009, citing an email exchange between representatives of the parties. However, the email exchange refers to performances by the Jackson brothers, not licensing J5 clothing.⁶⁴

In essence, Defendant's evidence in its defense to the abandonment claim are unsubstantiated assertions of vaguely defined efforts to market or license J5 products which are insufficient to establish an intent to resume use. *See Yazhong Investing Ltd. v. Multi-Media Tech Ventures, Ltd.*, 124 USPQ2d 1526, 1539 (TTAB 2018); *see also Emergency One Inc. v. Am. FireEagle Ltd.*, 56 USPQ2d at 1348 ("Once the challenger shows discontinued use, the owner must produce evidence of intent to resume use 'within the reasonably foreseeable future.' ... Of course, what is meant by the 'reasonably foreseeable future' will vary depending on the industry and the particular circumstances of the case ... it might be reasonable for a fire truck manufacturer to spend five or six years considering the reintroduction of a brand, even though the same passage of time would be unreasonable for a maker of a more ephemeral product, say potato chips."). Simply put, there is no credible evidence that

⁶³ Jackson Discovery Dep., p. 136 (111 TTABVUE 69); *see also* Jackson Discovery Dep., p. 158 (111 TTABVUE 80 (Defendant offered for sale "very little" or "not much at all" in the way of clothing bearing the mark J5 because the witness was not really sure).

⁶⁴ Defendant's Brief, p. 41 (138 TTABVUE 42) (citing Jackson Testimony Dep. Exhibit 30 (112 TTABVUE 101-104)).

Defendant or its predecessors made any use of the J5 trademark apart from a few vaguely described and unsuccessful attempts at licensing the mark which fall short of rebutting the prima facie case of abandonment.

The evidence in this case does not show serious negotiations toward execution of any license agreement. Defendant's efforts were neither consistent nor sustained, and assertions concerning the potential use of the mark at some unknown point in the future are insufficient to show an intent to resume use, especially where the record does not show that there ever was use of the mark in commerce on the goods in the registration. *Rivard v. Linville*, 133 F.3d 1446, 45 USPQ2d 1374, 1376-77 (Fed. Cir. 1998); *Imperial Tobacco Ltd. v. Philip Morris Inc.*, 899 F.2d 1575, 14 USPQ2d 1390, 1396 (Fed. Cir. 1990); *Azeka Bldg. Corp. v. Azeka*, 122 USPQ2d 1477, 1487-88 (TTAB 2017); *Auburn Farms Inc. v. McKee Foods Corp.*, 51 USPQ2d 1439, 1443-45 (TTAB 1999). *See also Emergency One Inc. v. Am. FireEagle Ltd.*, 56 USPQ2d at 1347-48 ("Requiring the owner to have an intent to use the mark in the reasonably foreseeable future ensures that valuable trademarks are in fact used in commerce as the Lanham Act intends, rather than simply hoarded or warehoused.").

Quite simply, the record is devoid of any evidence showing that Defendant either used the mark during the statutory period, or had a clear intent to resume (or even begin) use or a specific and consistent plan to resume (or begin) use on clothing within the reasonably foreseeable future following February 14, 2006. Accordingly, we find that Defendant abandoned the J5 mark for clothing and that there has been nonuse

of the mark from its registration date through August 2010⁶⁵ with no intent to resume use.⁶⁶

VI. Likelihood of Confusion

In the event that our decision granting the petition to cancel Respondent's registration is reversed on appeal, we include the mark J5 for clothing in our likelihood of confusion analysis.

A. Priority

Because Plaintiff's pleaded registration is of record, priority is not at issue with respect to the mark JACKSON 5 for musical sound recordings identified in its pleaded registration. *Mini Melts, Inc. v. Reckitt Benckiser LLC*, 118 USPQ2d 1464, 1469 (TTAB 2016) (citing *King Candy Co. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108, 110 (CCPA 1974)).

Because Plaintiff has not registered JACKSON 5IVE or J5, Plaintiff must rely on its common law rights. In its brief, Plaintiff argues that Defendant's products are related to Plaintiff's musical sound recordings.⁶⁷ In view thereof, we focus our analysis on those products.⁶⁸

⁶⁵ Evidence of subsequent use or intent to resume use after the three-year period of nonuse does not rebut the presumption of abandonment. *See Cervceria India Inc.*, 13 USPQ2d at 1313

⁶⁶ Defendant's equitable affirmative defenses of laches, estoppel and acquiescence do not apply against abandonment. *Linville v. Rivard*, 41 USPQ2d at 1733 n.4.

⁶⁷ Plaintiff's Brief, p. 39 (134 TTABVUE 41).

⁶⁸ As noted above, Plaintiff alleged that it used the JACKSON 5, JACKSON 5IVE and J5 "in connection with musical sound recordings, among other related goods and services." Notice of Opposition ¶1 (1 TTABVUE 3); Petition for Cancellation ¶1 (1 TTABVUE 3).

Section 2(d) of the Trademark Act permits an opposer or petitioner to file an opposition or cancellation on the basis of ownership of “a mark or trade name previously used in the United States ... and not abandoned.” Because Plaintiff based its opposition and cancellation in part on its unregistered JACKSON FIVE and J5 trademarks, Plaintiff must establish proprietary rights in those pleaded common-law marks. *See Herbko Int’l Inc. v. Kappa Books Inc.*, 308 F.3d 1156, 64 USPQ2d 1375, 1378 (Fed. Cir. 2002) (to establish priority, plaintiff must show proprietary rights in a mark that produces a likelihood of confusion). These proprietary rights may arise from prior trademark or service mark use, prior use as a trade name, prior use analogous to trademark or service mark use, or any other use sufficient to establish proprietary rights. *Id.*; *see, e.g., Nat’l Cable Television Ass’n Inc. v. Am. Cinema Editors, Inc.*, 937 F.2d 1572, 19 USPQ2d 1424, 1429 (Fed. Cir. 1991) (canceling mark based on petitioner’s prior use of trade name); *Knickerbocker Toy Co. v. Faultless Starch Co.*, 467 F.2d 501, 175 USPQ 417, 422 (CCPA 1972) (permitting reliance on copyrighted appearance of stuffed rag doll in opposition and cancellation proceedings).

Plaintiff’s acquisition of its purported rights in its common law marks must precede Defendant’s actual or constructive use of its mark. *RxD Media, LLC v. IP Application Dev. LLC*, 125 USPQ2d 1801, 1808 (TTAB 2018). In other words, because unregistered marks are not entitled to the presumptions established under Sections 7(b)-(c) of the Trademark Act, it is Plaintiff’s burden to demonstrate that it owns a trademark that was used prior to Defendant’s first use or constructive use of its mark

and not abandoned. *Syngenta Crop Prot. Inc. v. Bio-Chek LLC*, 90 USPQ2d 112, 1119 (TTAB 2009) (“applicant may rely without further proof upon the filing date of its application as a ‘constructive use’ date for purposes of priority”); *Life Zone Inc. v. Middleman Grp. Inc.*, 87 USPQ2d 1953, 1960 (TTAB 2008) (while either party may rely on the filing date of its application as a “constructive use date” for purposes of priority, where the opposer’s filing date was later in time it provided the opposer “no basis for ... priority”).

For the application subject to the opposition, because there is no testimony or evidence regarding Defendant’s use of the mark J5 in connection with the goods listed in its application, Defendant may rely on the filing date of its application, November 24, 2009, as its priority date. *See Larami Corp. v. Talk to Me Programs Inc.*, 36 USPQ2d 1840, 1845 (TTAB 1995) (parties may rely on constructive use filing dates for purposes of priority); and *Zirco Corp. v. Am. Tel. & Tel. Co.*, 21 USPQ2d 1542, 1543-45 (TTAB 1991) (constructive use in Section 7(c) of the Trademark Act establishes nationwide priority rights from the filing date of the application)). Moreover, as noted above, for purposes of completeness, in the event there is an appeal and the reviewing court reverses our finding that Defendant’s registration should be cancelled, we include the filing date of the application underlying Defendant’s registration, i.e., February 22, 2001, for use of J5 in connection with clothing.

Pursuant to the contract that the Jackson brothers signed with Plaintiff, Plaintiff acquired the exclusive right to the Jackson brothers’ individual names, the group

name THE JACKSON FIVE, and any other fictitious name used by the Jackson brothers for use in the music business including merchandising products.⁶⁹ Sigmund Jackson concedes that Plaintiff owned all rights to the “JACKSON 5 name” and any group name under which the Jackson brothers performed.⁷⁰ Harry Weinger, Vice President of A & R (Artists and Repertoire) for Universal Music Enterprises, an unincorporated division of Plaintiff, testified that the marks JACKSON 5, JACKSON 5IVE or J5 appeared on all album covers released by Plaintiff for the JACKSON 5 musical group between 1969 and 1975.⁷¹

In view of the foregoing, we find that Plaintiff used the marks JACKSON 5IVE and J5 in connection with musical sound recordings before any date on which Defendant may rely.

B. Defendant’s abandonment affirmative defense

Because Section 2(d) of the Trademark Act provides that a plaintiff may file an opposition or cancellation on the basis of ownership of “a mark or trade name previously used in the United States ... and not abandoned,” we now take up

⁶⁹ Jackson Testimony Dep. Exhibit B, Sections 6, 15(a), and 16 (131 TTABVUE 198, 201); *see also* Jackson Discovery Dep., p. 61 (111 TTABVUE 31) (Jackson 5 performances were authorized by defendant); Jackson Discovery Dep., p. 62 (111 TTABVUE 32) (Plaintiff did everything during the contract).

⁷⁰ Jackson Testimony Dep., p. 13 (132 TTABVUE 15). Even though the original recording contract refers to “THE JACKSON FIVE,” the Jackson testimony deposition refers to “Jackson 5” and there is no correction in the errata sheet. Nevertheless, because the original recording contract encompasses all names under which the Jackson brothers performed, it includes JACKSON FIVE, JACKSON 5IVE, JACKSON 5, and J5.

⁷¹ Weinger Testimony Decl. ¶¶10, 12, 14, and 15 (105 TTABVUE 4-5).

Defendant's affirmative defense that Plaintiff abandoned its use of JACKSON 5IVE or J5 in connection with musical sound recordings.

Defendant did not pursue its affirmative defense of abandonment in its brief and, therefore, it is deemed waived.⁷² *Alcatraz Media*, 107 USPQ2d at 1753 (respondent's affirmative defense of failure to state a claim not argued in brief deemed waived); *Swiss Watch Int'l Inc. v. Fed'n of the Swiss Watch Indus.*, 101 USPQ2d 1731, 1734 n.4 (TTAB 2012) (affirmative defenses deemed waived where no mention of them in trial brief); *Barbara's Bakery Inc. v. Landesman*, 82 USPQ2d 1283, 1292 (TTAB 2007) (where applicant did not argue the affirmative defense of equitable estoppel in her brief, the affirmative defense was given no consideration).

Nevertheless, the record shows that Plaintiff has continuously used the marks JACKSON 5IVE and J5 in connection with musical sound recordings. First, Defendant has conceded that Plaintiff has continuously sold musical recordings bearing the "JACKSON 5" in the United States over the last 40 years.⁷³ While it is not clear from the Sigmund Jackson discovery deposition what marks are encompassed by the "JACKSON 5" mark referred to in the deposition, because Plaintiff is limited to selling recordings made by the Jackson brothers prior to March 1976,⁷⁴ and because Plaintiff owned all rights to the "Jackson 5 name," as well as any group name under which the Jackson brothers performed,⁷⁵ we construe the

⁷² "Statement of Issues," Defendant's Brief, pp. 11-12 (138 TTABVUE 12-13).

⁷³ Jackson Discovery Dep., p. 53 (111 TTABVUE 30).

⁷⁴ 121 TTABVUE 15 and 16.

⁷⁵ Jackson Testimony Dep., p. 13 (132 TTABVUE 15).2

testimony as referring to any variation of “JACKSON FIVE,” including JACKSON 5IVE and J5.

Second, Harry Weinger testified that Plaintiff has continued to sell musical sound recordings under the marks JACKSON 5IVE and J5 since 1993.⁷⁶

C. Likelihood of Confusion

Our determination under Section 2(d) is based on an analysis of all of the probative facts in evidence that are relevant to the factors bearing on the issue of likelihood of confusion. *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973) (“*du Pont*”) cited in *B&B Hardware, Inc. v. Hargis Indus., Inc.*, 135 S. Ct. 1293, 113 USPQ2d 2045, 2049 (2015); see also *In re Majestic Distilling Co.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). We have considered each *du Pont* factor that is relevant or for which there is evidence of record. See *M2 Software, Inc. v. M2 Commc’ns, Inc.*, 450 F.3d 1378, 78 USPQ2d 1944, 1947 (Fed. Cir. 2006); *ProMark Brands Inc. v. GFA Brands, Inc.*, 114 USPQ2d 1232, 1242 (TTAB 2015) (“While we have considered each factor for which we have evidence, we focus our analysis on those factors we find to be relevant.”). In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods or services. See *In re Chatam Int’l Inc.*, 380 F.3d 1340, 71 USPQ2d 1944, 1945-46 (Fed. Cir. 2004); *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976) (“The fundamental

⁷⁶ Weinger Testimony Decl. ¶¶18-21 and Exhibits 3-5 (105 TTABVUE 6-8 and 29-63).

inquiry mandated by § 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks.”); *see also In re i.am.symbolic, llc*, 866 F.3d 1315, 123 USPQ2d 1744, 1747 (Fed. Cir. 2017) (“The likelihood of confusion analysis considers all *DuPont* factors for which there is record evidence but ‘may focus ... on dispositive factors, such as similarity of the marks and relatedness of the goods’”) (quoting *Herbko Int’l*, 64 USPQ2d at 1380).

A. The strength and fame of Plaintiff’s mark.

In determining the strength of a mark, we consider both its inherent strength, based on the nature of the mark itself, and its commercial strength, based on marketplace recognition of the mark. *See In re Chippendales USA, Inc.*, 622 F.3d 1346, 96 USPQ2d 1681, 1686 (Fed. Cir. 2010) (“A mark’s strength is measured both by its conceptual strength (distinctiveness) and its marketplace strength (secondary meaning).”); *Top Tobacco, L.P. v. N. Atl. Operating Co., Inc.*, 101 USPQ2d 1163, 1171-72 (TTAB 2011) (the strength of a mark is determined by assessing its inherent strength and its commercial strength); *Tea Board of India v. Republic of Tea Inc.*, 80 USPQ2d 1881, 1899 (TTAB 2006); 2 J. Thomas McCarthy, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 11:83 (5th ed. June 2018 update) (“The first enquiry focuses on the inherent potential of the term at the time of its first use. The second evaluates the actual customer recognition value of the mark at the time registration is sought or at the time the mark is asserted in litigation to prevent another’s use.”). Market strength is the extent to which the relevant public recognizes

a mark as denoting a single source. *Tea Board of India v. Republic of Tea Inc.*, 80 USPQ2d at 1899.

1. The inherent strength of Plaintiff's trademark JACKSON 5 and variations thereof.

The mark JACKSON 5 and variations thereof used in connection with musical sound recordings thereof are inherently distinctive. As noted above, Plaintiff has made of record its pleaded JACSKON 5 registration which is not subject to a counterclaim for cancellation. The registration is "prima facie evidence of the validity of the registered mark and of the registration of the mark, of the owner's ownership of the mark, and of the owner's exclusive right to use the registered mark in commerce on or in connection with the goods or services specified in the certificate." Section 7(b) of the Trademark Act, 15 U.S.C. § 1057(b).

In assessing the inherent strength of Plaintiff's marks, we note that there is no testimony or evidence regarding the number and nature of similar marks in use on similar goods or services or third-party registrations consisting in whole, or in part, of the name "Jackson," the numeral "5" or variations thereof. *See Juice Generation, Inc. v. GS Enters. LLC*, 794 F.3d 1334, 115 USPQ2d 1671, 1675 (Fed. Cir. 2015) (the extent of third-party use or registrations may indicate that a term carries a suggestive or descriptive connotation and is weak for that reason).

2. The commercial strength of Plaintiff's marks.

Plaintiff alleges that its marks “have become and currently are famous.”⁷⁷ Fame, if it exists, plays a dominant role in the likelihood of confusion analysis because famous marks enjoy a broad scope of protection or exclusivity of use. A famous mark has extensive public recognition and renown. *Bose Corp. v. QSC Audio Prods. Inc.*, 293 F.3d 1367, 63 USPQ2d 1303, 1305 (Fed. Cir. 2002); *Recot Inc. v. M.C. Becton*, 54 USPQ2d at 1897; *Kenner Parker Toys, Inc. v. Rose Art Indus. Inc.*, 963 F.2d 350, 22 USPQ2d 1453, 1456 (Fed. Cir. 1992).

“[L]ikelihood of confusion fame ‘varies along a spectrum from very strong to very weak.’” *Joseph Phelps Vineyards, LLC v. Fairmount Holdings, LLC*, 857 F.3d 1323, 122 USPQ2d 1733, 1734 (Fed Cir. 2017) (quoting *Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondée en 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1694 (Fed. Cir. 2005) (quoting *In re Coors Brewing Co.*, 343 F.3d 1340, 68 USPQ2d 1059, 1063 (Fed. Cir. 2003))). Fame may be measured indirectly by the volume of sales and advertising expenditures for the goods and services identified by the marks at issue, “the length of time those indicia of commercial awareness have been evident,” widespread critical assessments and through notice, by independent sources, of the products identified by the marks, as well as the general reputation of the products and services. *Bose Corp. v. QSC Audio Prods. Inc.*, 63 USPQ2d at 1305-06, 1309. Although raw numbers of product sales and advertising expenses sometimes suffice

⁷⁷ Notice of Opposition ¶1 (1 TTABVUE 3); Amended Petition for Cancellation ¶1 (38 TTABVUE 6).

to prove fame, raw numbers alone may be misleading. Some context in which to place raw numbers may be necessary (*e.g.*, the substantiality of the sales or advertising figures for comparable types of products or services). *Id.* at 1309.

Finally, because of the extreme deference that we accord a famous mark in terms of the wide latitude of legal protection it receives, and the dominant role fame plays in the likelihood of confusion analysis, it is the duty of the party asserting that its mark is famous to clearly prove it. *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1720 (Fed. Cir. 2012), citing *Leading Jewelers Guild Inc. v. LJOW Holdings LLC*, 82 USPQ2d 1901, 1904 (TTAB 2007).

Sigmund Jackson concedes that the JACKSON 5 mark is famous and, in fact, “is one of the most famous trademarks in connection with recordings in the United States.”⁷⁸ Defendant’s draft marketing materials⁷⁹ refer to the JACKSON FIVE as “a world-wide recognised [sic] name,”⁸⁰ the J5 mark as “famous,”⁸¹ and that “[t]he Jackson 5’s contribution to music and forever lasting legacy can not be abtained.”⁸²

In addition, Plaintiff introduced the following evidence to establish the fame of the JACKSON 5 marks:

⁷⁸ Jackson Discovery Dep., pp 51-53 and 52 (111 TTABVUE 28-30).

⁷⁹ Jackson Discovery Dep., pp. 185-194 (110 TTABVUE 89-91) identifying documents SIGM 617-645 as a mock-up of merchandise.

⁸⁰ “The J5 Collection Official Merchandise,” 112 TTABVUE 22. This document was designated improperly as confidential.

⁸¹ “The J5 Collection Official Merchandise,” 112 TTABVUE 22. This document was designated improperly as confidential.

⁸² “The J5 Collection Official Merchandise,” 112 TTABVUE 18. This document was designated improperly as confidential.

- Plaintiff released “somewhere around 12 or 14 albums” under the agreement with the Jackson brothers which all sold well;⁸³
- “Just about all” of the albums reached gold and platinum status;⁸⁴
- Since 2000, Plaintiff has released approximately 100 digital and three dozen physical JACKSON 5 products, including remastered sound recordings, previously unreleased sound recordings and reissues in a variety of formats;⁸⁵
- Plaintiff “curates and maintains an official JACKSON 5 artist site on Spotify that draws 3,500,000 monthly listeners;⁸⁶
- Plaintiff has sold tens of millions of albums in the United States under the JACKSON 5 marks since 1969;⁸⁷
- Since 2000, twenty-five years after the Jackson brothers’ last recorded performance, Plaintiff has sold approximately 2.8 million albums, 6.1 million standalone tracks, and 600 million streams under the JACKSON 5 marks, generating nearly \$26 million in revenue;⁸⁸
- JACKSON 5 marks received, and continue to receive, unsolicited media coverage, including in prominent newspapers and magazines such as

⁸³ Jackson Discovery Dep., p. 32 (110 TTABVUE 17).

⁸⁴ Jackson Discovery Dep., p. 33 (110 TTABVUE 18).

⁸⁵ Weinger Decl. ¶20 (105 TTABVUE 7).

⁸⁶ Weinger Decl. ¶20 (105 TTABVUE 7).

⁸⁷ Weinger Decl. ¶25 (105 TTABVUE 8).

⁸⁸ Weinger Decl. ¶25 (105 TTABVUE 8).

*Rolling Stone, Billboard, The Boston Globe, The Chicago Tribune, The Washington Post, The Dallas Morning News, The South Florida Sun-Sentinel, The Chicago Sun-Times, and USA Today, as well as in several books;*⁸⁹

- The JACKSON 5 musical group was inducted into the Rock N’ Roll Hall of Fame in 1997;⁹⁰ and
- The JACKSON 5 musical group is featured in the musical *Motown The Musical*, currently touring the United States after a run on Broadway from April 2013 through January 2015.⁹¹

Because the evidence regarding the commercial strength of the marks refers to JACKSON 5IVE or JACKSON 5 but not J5, we find that the marks JACKSON 5IVE and JACKSON 5 are famous. However, the evidence does not support finding that J5 is famous or commercially strong.

B. The similarity or dissimilarity of the marks.

We now turn to the *du Pont* likelihood of confusion factor focusing on the similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression. *du Pont*, 177 USPQ at 567. “Similarity in any one of these elements may be sufficient to find the marks confusingly similar.” *In re Davia*, 110 USPQ2d 1810, 1812 (TTAB 2014); accord *Krim-Ko Corp. v. Coca-Cola Bottling*

⁸⁹ 116 TTABVUE 5-7 and 16-23 and 117 TTABVUE 6-91.

⁹⁰ Weinger Decl. ¶ 22 (105 TTABVUE 8).

⁹¹ Weinger Decl. ¶23 (105 TTABVUE 8).

Co., 390 F.2d 728, 156 USPQ 523, 526 (CCPA 1968) (“It is sufficient if the similarity in either form, spelling or sound alone is likely to cause confusion.”) (citation omitted).

“The proper test is not a side-by-side comparison of the marks, but instead ‘whether the marks are sufficiently similar in terms of their commercial impression’ such that persons who encounter the marks would be likely to assume a connection between the parties.” *Coach Servs.*, 101 USPQ2d at 1721; *see also* *Midwestern Pet Foods, Inc. v. Societe des Produits Nestle S.A.*, 685 F.3d 1046, 103 USPQ2d 1435, 1440 (Fed. Cir. 2012); *San Fernando Elec. Mfg. Co. v. JFD Elec. Components Corp.*, 565 F.2d 683, 196 USPQ 1, 3 (CCPA 1977); *Spoons Rests. Inc. v. Morrison Inc.*, 23 USPQ2d 1735, 1741 (TTAB 1991), *aff’d mem.*, 972 F.2d 1353 (Fed. Cir. 1992). The proper focus is on the recollection of the average customer, who retains a general rather than specific impression of the marks. *Geigy Chem. Corp. v. Atlas Chem. Indus., Inc.*, 438 F.2d 1005, 169 USPQ 39, 40 (CCPA 1971); *L’Oreal S.A. v. Marcon*, 102 USPQ2d 1434, 1438 (TTAB 2012); *Winnebago Indus., Inc. v. Oliver & Winston, Inc.*, 207 USPQ 335, 344 (TTAB 1980); *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106, 108 (TTAB 1975). Because the goods at issue are musical sound recordings and, as discussed below, clothing and other collateral merchandise sold to promote musical groups, the average customer is an ordinary consumer who listens to music and is a music fan.⁹²

⁹² Defendant’s target market is fans of the JACKSON 5. Jackson Discovery Dep., p. 230 (110 or 111 TTABVUE 95).

Defendant's mark is J5 in standard character form. One of Plaintiff's marks is J5 in a logo format reproduced below:⁹³



An example of the J5 logo used on a musical sound recording is reproduced below:⁹⁴



Marks presented in standard characters are not limited to any particular depiction. The rights associated with a mark in standard characters reside in the wording, and not in any particular display. Thus, Defendant seeks registration of a mark that might be depicted in any manner, regardless of the font style, size, or color, and might at any time in the future be displayed in a manner similar to Plaintiff's J5

⁹³ Weinger Decl. ¶14 (105 TTABVUE 5).

⁹⁴ Weinger Decl. Exhibit 3 (105 TTABVUE 29).

mark. *In re Viterra Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1909-11 (Fed. Cir. 2012); *Citigroup Inc. v. Capital City Bank Grp., Inc.*, 637 F.3d 1344, 98 USPQ2d 1253, 1259 (Fed. Cir. 2011); *Squirtco v. Tomy Corp.*, 697 F.2d 1038, 216 USPQ 937, 939 (Fed. Cir. 1983) (rejecting argument that for purposes of determining whether two marks are similar, a mark in a typed drawing (equivalent to modern standard character format) is distinct from such mark in a logo format; “[b]y presenting its mark in a typed drawing, a *difference* cannot legally be asserted by that party” (emphasis in original)).

Accordingly, the J5 marks are identical.

Plaintiff also asserts the JACKSON 5 mark in its pleaded registration, as well as a JACKSON 5IVE logo. The JACKSON 5IVE logo is reproduced below:⁹⁵



An example of the JACKSON 5IVE logo used in connection with musical sound recordings is reproduced below:⁹⁶

⁹⁵ Weinger Decl. ¶15 (105 TTABVUE 5).

⁹⁶ Weinger Decl. Exhibit 3 (105 TTABVUE 33).



Mr. Weinger testified that “[f]rom the early days of the JACKSON 5 musical group’s success, the American public used ‘J5’ as a shorthand way to refer to [Plaintiff’s] JACKSON 5 mark.”⁹⁷

[Plaintiff] reinforced the significance of the J5 mark by featuring “J5” on the costumes worn by its JACKSON 5 musical group during live television performances and by using the term “J5” on album covers and other merchandise.⁹⁸

Likewise, Sigmund Jackson testified that J5 is a reference to the Jackson 5.⁹⁹

Q. So J5 is the Jackson 5?

A. Yes.

* * *

Q. Do you think consumers recognize J5 to mean the same thing as the Jackson 5?

⁹⁷ Weinger Decl. ¶13 (105 TTABVUE 4).

⁹⁸ Weinger Decl. ¶14 (105 TTABVUE 5).

⁹⁹ Jackson Discovery Dep., p. 122 (111 TTABVUE 59).

* * *

A. It all depends. Some fans do and – and some fans don't.

Q. But would you agree that there are at least some fans of the Jackson 5 musical group who would recognize the band as J5?

* * *

A. Some. Yeah, some.¹⁰⁰

Examples of J5 on a costume and on the drum kit are reproduced below:¹⁰¹



During the prosecution of the application involved in the opposition, Sigmund Jackson submitted a declaration stating that Defendant was authorized to secure a registration for the mark J5 for the applied for goods “as an indicator of secondary source or sponsorship of the JACKSON 5 mark associated with the our vocal group,

¹⁰⁰ Jackson Discovery Dep., p. 123 (111 TTABVUE 60).

¹⁰¹ Weinger Decl. Exhibit 3 (105 TTABVUE 18 and 23).

registration number 965,809.”¹⁰² Statements made in an application may be used as evidence against the applicant as an admission against interest. *See Daniel J. Quirk Inc. v. Village Car Co.*, 120 USPQ2d 1146, 1149 n.14 (TTAB 2016) (statements made in affidavit filed in connection with respondent’s office action response constitute admissions against interest and fall within hearsay exception under Fed. R. Evid. 801(d)(2)); *Mason Eng’g & Design Corp. v. Mateson Chem. Corp.*, 225 USPQ 956, 961 n.5 and n.11 (TTAB 1985) (date of first use asserted by opposer in its application may be considered as admission against interest; in evaluating “Morehouse” type defense, Board relied on specimens and other materials in applicant’s application as evidence of the nature of applicant’s services to find that those services were not “substantially identical” to the goods in applicant’s subsisting registration). In other words, Defendant told the USPTO that the mark J5 intended to be used on the goods is associated with Plaintiff’s mark JACKSON 5IVE (stylized) for “entertainment services rendered by a vocal group.” *In re Paramount Pictures Corp.*, 213 USPQ 1111, 1112 (TTAB 1982) (“[t]he ‘ornamentation’ of a T-shirt can be of a special nature which is [sic] inherently tells the purchasing public the source of the T-shirt, not the source of manufacture but the secondary source.”).

The parties agree that consumers refer to Plaintiff’s products as indicating J5 because they will shorten JACKSON 5 or JACKSON 5IVE to J5. “[U]sers of language

¹⁰² March 11, 2010 Response to Office Action in Application Serial No. 77880243 (TSDR 3). Citations to the USPTO TSDR database are to the downloadable .pdf format.

Registration No. 0965808 is for the mark JACKSON 5IVE (stylized) owned by Motown Record Corporation, Plaintiff’s predecessor-in-interest. 108 TTABVUE 14-15.

have a universal habit of shortening full names – from haste or laziness or just economy of words. Examples are: automobile to auto; telephone to phone; necktie to tie; gasoline service station to gas station.” *In re Abcor Dev. Corp.*, 588 F.2d 511, 200 USPQ 215, 219 (CCPA 1978) (J. Rich, concurring).

[C]ompanies are frequently called by shortened names, such as Penney’s for J.C. Penney’s, Sears for Sears and Roebuck (even before it officially changed its name to Sears alone), Ward’s for Montgomery Ward’s, and Bloomies for Bloomingdales.

Marshall Field & Co. v. Mrs. Fields Cookies, 25 USPQ2d 1321, 1333 (TTAB 1992).
See also In re Mighty Leaf Tea, 601 F.3d 1342, 94 USPQ2d 1257, 1260 (Fed. Cir. 2010) (affirming Board decision that ML is likely to be perceived as a shortened version of ML MARK LEES, and noting that “the presence of an additional term in the mark does not necessarily eliminate the likelihood of confusion if some terms are identical”); *Giant Food, Inc. v. Nation’s Foodservice, Inc.*, 710 F.2d 1565, 218 USPQ 390, 395 (Fed. Cir. 1983) (“Although the record does not indicate that applicant’s business is commonly referred to as ‘Giant’, it does indicate that people have called it by that name, omitting the word ‘Hamburgers’. Thus, in a conversation between two consumers in opposer’s area about a place of business called ‘Giant’, there likely would be confusion about which ‘Giant’ they were talking about.”); *Fiserve, Inc. v. Elec. Transaction Sys. Corp.*, 113 USPQ2d 1913, 1919 (TTAB 2015) (consumers will perceive PMONEY and an abbreviation of POPMONEY); *Big M Inc. v. The U.S. Shoe Co.*, 228 USPQ 614, 616 (TTAB 1985) (“we cannot ignore the propensity of consumers to often shorten trademarks and, in the present case, this would be accomplished by dropping the ‘T.H.’ in referring to registrant’s stores [T.H. MANDY].”).

Although Defendant's mark J5 differs from Plaintiff's marks JACKSON 5 and JACKSON 5IVE in appearance and sound, the marks have the same meaning and engender the same commercial impression. When we factor in the strength of Plaintiff's JACKSON 5 and JACKSON 5IVE marks, we find that the similarities outweigh the dissimilarities.

C. The similarity or dissimilarity and nature of the goods.

We readily acknowledge that Plaintiff's musical sound recordings are different than the various products listed in Defendant's registration and application. The test here is not, however, whether the goods are likely to be confused. Rather, the test is whether purchasers are likely to be confused as to source, connection or sponsorship between the providers of the products. As often stated, it is not necessary that the goods be similar or competitive, or even that they move in the same channels of trade to support a holding of likelihood of confusion. It is sufficient that the respective goods are related in some manner, or that the conditions and activities surrounding the marketing of the goods are such that they would or could be encountered by the same persons under circumstances that could, because of the similarities of the marks used therewith, give rise to the mistaken belief that they originate from or are in some way associated with the same producer. *See Hilson Research Inc. v. Soc'y for Human Resource Mgmt.*, 27 USPQ2d 1423 (TTAB 1993); *Nat'l Football League v. Jasper Alliance Corp.*, 16 USPQ2d 1213, 1215 (TTAB 1990). When viewed in this light, we find that there is a likelihood that consumers will be confused into mistakenly

believing that Defendant's products are somehow sponsored by or associated with Plaintiff.

Sigmund Jackson testified that it is common for record companies to sell merchandise featuring group names to promote the sale of records.¹⁰³ Thus, Defendant selected the goods in the application because "all of the other groups were doing the same thing, too, so that's what I wanted to do."¹⁰⁴ In other words, those were the types of products that other musicians were exploiting in connection with their names and trademarks.¹⁰⁵ Likewise, Plaintiff sold t-shirts bearing the JACKSON 5 mark at concerts.¹⁰⁶ Also, Plaintiff sold or distributed a JACKSON 5 board game that displayed the J5 logo.¹⁰⁷

Plaintiff introduced copies of four third-party registrations, and a set of six third-party registrations for one mark, to show that the goods of the parties are related. Third-party registrations based on use in commerce that individually cover a number of different goods may have probative value to the extent that they serve to suggest that the listed goods are of a type that may emanate from the same source. *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783, 1785-1786 (TTAB 1993); *In re Mucky Duck Mustard Co. Inc.*, 6 USPQ2d 1467, 1470 n.6 (TTAB 1988), *aff'd mem.* 864 F.2d 149 (Fed. Cir. 1988).

¹⁰³ Jackson Testimony Dep., pp. 19-20 (132 TTABVUE 21-22).

¹⁰⁴ Jackson Discovery Dep., p. 167 (111 TTABVUE 84).

¹⁰⁵ Jackson Discovery Dep., pp. 167-68 (111 TTABVUE 84-85).

¹⁰⁶ Jackson Discovery Dep., pp. 61-62 (111 TTABVUE 31-32).

¹⁰⁷ Jackson Discovery Dep., p. 67-68, 70 (111 TTABVUE 33-35).

The registrations, with relevant portions of the identifications, are listed below.¹⁰⁸

Mark	Reg. No.	Goods
JUSTIN BIEBER	4396533	Cosmetics Jewelry Prerecorded discs, tapes, and downloads featuring musical performances Handbags, purses, wallets and luggage Clothing Plush toys and musical toys
1D ONE DIRECTION	4500147	Sound storage media featuring musical recordings Books relating to musical recordings, performances and groups Clothing Plush toys, action figures, toy cars
FLEETWOOD MAC	3066017	Musical sound recordings Posters and souvenir books about a music group, its history and performances Plastic key chains Mugs Clothing Plush toys
RIHANNNA	4183528 3621108 4190900 3776317 4246201 3730038	Perfume Musical sound recordings Jewelry Posters and tour books Purses and tote bags Clothing

Defendant argues that “the goods are sufficiently different such that confusion is unlikely. Musical sound recordings are completely dissimilar from the clothing

¹⁰⁸ 109 TTABVUE 6-29.

identified in [Defendant's] J5 trademark registration or application.”¹⁰⁹ However, the Board, in another case, stated the following, which is equally appropriate in this case:

The licensing of commercial trademarks for use on “collateral” products (such as clothing, glassware, linens, etc.), which are unrelated in nature to those goods or services on which the marks are normally used, has become a common practice in recent years. *See: General Mills Fun Group, Inc. v. Tuxedo Monopoly, Inc.*, 204 USPQ 396, 400 [where we stated that such use is a matter of common knowledge and “has become a part of everyday life which we cannot ignore”], *affirmed* 648 F.2d 1335, 209 USPQ 986, 988 (CCPA 1981) [where the Court of Customs and Patent Appeals noted that “collateral product” use is a matter of textbook discussion (see J. Gilson, *Trademark Protection and Practice* §5.05[10] (1980) and frequent commentary (see Grimes and Battersby, *The Protection of Merchandising Properties*, 69 T.M. Rep. 431 (1979) and references cited therein)].

In re Phillips-Van Heusen Corp., 228 USPQ 949, 951 (TTAB 1986); *see also L.C. Licensing Inc. v. Berman*, 86 USPQ2d 1883, 1889 (TTAB 2008) (“It is common knowledge, and a fact of which we can take judicial notice, that the licensing of commercial trademarks on ‘collateral products’ has become a part of everyday life.”); *Turner Entm’t Co. v. Nelson*, 38 USPQ2d 1942, 1945 (TTAB 1996) (“It is common knowledge, and in the present case, undisputed that video games, t-shirts, beach towels, caps and other logo-imprinted products are used as promotional items for a diverse range of goods and services.”).

“The crux of the issue before us is whether the respective goods sold ... under the marks are sufficiently related in the minds of the common purchasers to result in a

¹⁰⁹ Defendant's Brief, p. 36 (138 TTABVUE 37).

likelihood of confusion.” *Berghoff Rest. Co. v. Washington Forge, Inc.*, 225 USPQ 603, 608 (TTAB 1985). In this case, Plaintiff’s famous marks JACKSON 5 and JACKSON 5IVE and its other mark J5 are for musical sound recordings while Defendant is using J5 on clothing and intends to use it on other products all of which may be used in connection with collateral or merchandising items to promote musical sound recordings. Consumers will associate such use on collateral or merchandising items as emanating from the same source as musical sound recordings. *See In re Jackson Int’l Trading Co.*, 103 USPQ2d 1417, 1419 (TTAB 2012) (“[I]t is commonplace for performers . . . to expand their product lines to incorporate a diverse set of goods to capitalize on the renown of their names and brands.”); *UMG Recordings, Inc. v. O’Rourke*, 92 USPQ2d 1042, 1049-50 (TTAB 2009) (consumers familiar with “famous music industry marks” when confronted with a similar mark on clothing items would think the famous musical mark was being exploited on “collateral products”).

- D. Established, likely-to-continue channels of trade and buyers to whom sales are made.

Defendant’s descriptions of goods have no restrictions or limitations and, accordingly, we must presume that those goods will move in all normal channels of trade and be sold to all classes of consumers. *See Citigroup Inc. v. Capital City Bank Grp. Inc.*, 98 USPQ2d at 1261; *CBS Inc. v. Morrow*, 708 F.2d 1579, 218 USPQ 198, 199 (Fed. Cir. 1983); *Paula Payne Prods. Co. v. Johnson Publ’g Co.*, 473 F.2d 901, 177 USPQ 76, 77 (CCPA 1973). This includes music fans in general and specifically fans of the Jackson brothers who purchase Plaintiff’s musical sound recordings. *See In re Hughes Furniture Indus., Inc.*, 114 USPQ2d 1134, 1137 (TTAB 2015) (“Applicant’s

broadly worded identification of ‘furniture’ necessarily encompasses Registrant’s narrowly identified ‘residential and commercial furniture.’”).

Defendant argues that the goods are sold through different channels of trade,¹¹⁰ but does not provide any evidentiary support for its position and it fails to address the presumption established by our case law.

In view thereof, we find that the channels of trade factor is neutral, but the classes of consumers are the same.

E. The nature and extent of any actual confusion.

Defendant contends that because there are no reported instances of actual confusion over the past decade in which the parties have been concurrently using their marks, there is no likelihood of confusion.¹¹¹ The absence of any reported instances of confusion is meaningful only if the record indicates appreciable and continuous use by Defendant of its mark for a significant period of time in the same markets as those served by Plaintiff under its marks. *Citigroup Inc. v. Capital City Bank Grp., Inc.*, 94 USPQ2d 1645, 1660 (TTAB 2010), *aff’d*, 637 F.3d 1344, 98 USPQ2d 1253 (Fed. Cir. 2011); *Gillette Canada Inc. v. Ranir Corp.*, 23 USPQ2d 1768, 1774 (TTAB 1992). In other words, for the absence of actual confusion to be probative, there must have been a reasonable opportunity for confusion to have occurred. *Barbara’s Bakery*, 82 USPQ2d at 1287 (the probative value of the absence of actual confusion depends upon there being a significant opportunity for actual confusion to

¹¹⁰ Defendant’s Brief, p. 36 (138 TTABVUE 37).

¹¹¹ Defendant’s Brief, p. 36 (138 TTABVUE 37).

have occurred); *Red Carpet Corp. v. Johnstown Am. Enters. Inc.*, 7 USPQ2d 1404, 1406-1407 (TTAB 1988); *Central Soya Co., Inc. v. North Am. Plant Breeders*, 212 USPQ 37, 48 (TTAB 1981) (“the absence of actual confusion over a reasonable period of time might well suggest that the likelihood of confusion is only a remote possibility with little probability of occurring”).

Because Defendant has not used its mark on the goods listed in its application, there has not been an opportunity for confusion to have occurred with those goods. On the other hand, Mr. Jackson testified that Defendant launched the J5 clothing line in August 2010.¹¹² However, the institution of these proceedings in February 2011 have stymied Defendant’s marketing efforts.¹¹³ Nevertheless, it appears that between July 2012 and April 2014, Defendant through licensees made sales through retailers, including but not limited to Gap, Inc., Macy’s and Target.¹¹⁴ As best we can determine, only t-shirts have been offered for sale, sales have been modest and the geographic marketing area for the products is undefined. There is no testimony or evidence regarding the advertising for Defendant’s clothing products. However, one webpage from PACSUN advertises a “JACKSON 5 Tee” from “The J5 Collection” for \$18.99 marked down from \$23.00.¹¹⁵ It is unlikely that consumers are going to

¹¹² Jackson Testimony Dep., pp. 21 and 24-25 (132 TTABVUE 23 and 26-27).

¹¹³ Defendant’s Brief, p. 19 (138 TTABVUE 20).

¹¹⁴ Jackson Testimony Decl. ¶¶27-39 and Exhibits 2-12 (121 TTABVUE 7-10 and 29-151) (confidential). Because the sales figures have been designated confidential, they only may be referred in general terms.

¹¹⁵ Jackson Testimony Decl. Exhibit 11 ¶ (121 TTABVUE 146). Although this exhibit is designated confidential, there is nothing confidential about it. *See* Trademark Rule 2.116(g), 37 C.F.R. § 2.116(g) (“The Board may treat as not confidential that material which cannot reasonably be considered confidential, notwithstanding a designation as such by a party.”).

register complaints about inexpensive t-shirts from which incidents of confusion might be identified.

Under these circumstances, we find that the *du Pont* factor relating to no evidence of actual confusion is neutral.

F. Analyzing the factors.

Because the marks J5 are identical and Plaintiff's famous marks JACKSON 5IVE and JACKSON 5 are similar to Defendant's mark J5, and the goods are related and are offered to the same classes of consumers, we find that Defendant's mark J5 for clothing and for the goods listed in its application is likely to cause confusion with Plaintiff's registered mark JACKSON 5 for musical sound recordings and Plaintiff's common law marks JACKSON 5IVE (stylized) and J5 (stylized) for musical sound recordings.

VII. Laches

Defendant asserted the affirmative defenses of laches, estoppel and acquiescence to Plaintiff's likelihood of confusion claim against the cancellation of its registration for the mark J5 for clothing. Laches is an available equitable defense in a cancellation proceeding based upon a likelihood of confusion. *Nat'l Cable Television Ass'n Inc. v. Am. Cinema Editors, Inc.*, 19 USPQ2d at 1431; *Ava Ruha Corp. v. Mother's Nutritional Ctr., Inc.*, 113 USPQ2d 1575, 1580 (TTAB 2015). "In order to prevail on the affirmative defense of laches, Respondent is required 'to establish that there was undue or unreasonable delay [by petitioner] in asserting its rights, and prejudice to [respondent] resulting from the delay.'" *Ava Ruha Corp.*, 113 USPQ2d at 1580

(quoting *Bridgestone/Firestone Research Inc. v. Automobile Club de l'Ouest de la France*, 245 F.3d 1359, 58 USPQ2d 1460, 1462 (Fed. Cir. 2001)).

Defendant argues that Plaintiff's delay in filing the petition for cancellation on February 11, 2011 (three days before the fifth anniversary of the registration date) constitutes undue or unreasonable delay. In the alternative, Defendant argues that because the parties met in 2009 to discuss Defendant licensing Plaintiff to use the J5 trademark, Plaintiff's delay in filing the petition to cancel until February 2011 constitutes undue or unreasonable delay.¹¹⁶ With respect to the negotiations between the parties, Sigmund Jackson testified as follows:

I remember sitting with [Plaintiff] and talking about doing a whole album and all kinds of merchandising and things of that nature. I just wanted to make sure that we had everything. When the album was released, I was going to release all of these items under the J5 trademark at the same time with the tour. But we could never get an agreement together with [Plaintiff], and we could never come to terms, and it fell apart. And the next thing I knew, [Plaintiff] instituted these proceedings to try to take away my rights in the J5 mark.¹¹⁷

Plaintiff argues, inter alia, that between 2009 and continuing through the February 2011, the parties were negotiating a possible business relationship which would have resolved the trademark dispute and that, therefore, any delay in filing the petition for cancellation does not constitute undue or unreasonable delay.¹¹⁸

¹¹⁶ Defendant's Brief, p. 30 (138 TTABVUE 31).

¹¹⁷ Jackson Testimony Decl. ¶26 (122 TTABVUE 7).

¹¹⁸ Plaintiff's Brief, p. 22 (140 TTABVUE 24).

As discussed above, Defendant did not start using its J5 mark until August 2010. Thus, before Defendant starting using the mark through the time that Plaintiff filed the petition for cancellation, the parties were negotiating to settle their business and trademark dispute. Under these circumstances, Plaintiff did not unduly or unreasonably delay in filing the petition for cancellation. *See Kehoe Component Sales, Inc. v. Best Lighting Prods., Inc.*, 796 F.3d 576, 115 USPQ2d 1900, (6th Cir. 2015) (negotiations to resolve the dispute do not count for the running of a laches defense); *Siegerist v. Blaw-Knox Co.*, 414 F.2d 375, 163 USPQ 74 (8th Cir. 1969) (delay was excused since “the parties attempted to engage in conciliatory negotiations rather than rush headlong toward litigation”); *Margaret Wendt Found. Holdings, Inc. v. Roycroft Assocs.*, 84 USPQ2d 1690 (W.D.N.Y. 2007) (several years of negotiations rebuts a presumption of laches); *E. & J. Gallo Winery v. Gallo Cattle Co.*, 12 USPQ2d 1657, 1676 (E.D. Cal. 1989), *aff’d as modified*, 955 F.2d 1327, 21 USPQ2d 1824 (9th Cir. 1992), *opinion amended and superseded*, 967 F.2d 1280 (9th Cir. 1992) (delay in commencement of suit to accommodate settlement negotiations does not count towards laches).

Moreover, Defendant failed to show that it was prejudiced by Plaintiff’s purported delay. For example, Defendant did not start using the J5 mark until August 2010 and thereafter licensees made sales through retailers, including but not limited to Gap, Inc., Macy’s and Target.¹¹⁹ In fact, Defendant, in its brief, did not argue that it was

¹¹⁹ Jackson Testimony Decl. ¶¶27-39 and Exhibits 2-12 (121 TTABVUE 7-10 and 29-151) (confidential).

prejudiced by Plaintiff's purported delay in filing the petition for cancellation or how it was prejudiced.

Defendant's laches affirmative defense is denied.

VIII. Estoppel or acquiescence

Defendant argues that Plaintiff acquiesced to Defendant's use and registration of J5 for clothing because Plaintiff failed to object to Defendant's use and registration of that mark even though Defendant used the mark since 2009 and that during the negotiations between the parties Plaintiff never claimed that Plaintiff owned the J5 trademark or that Defendant did not own the J5 trademark.¹²⁰

"Acquiescence is a type of estoppel that is based on the plaintiff's conduct that expressly or by clear implication consents to, encourages, or furthers the activities of the defendant." *Nashin v. Prod. Source Int'l LLC*, 107 USPQ2d 1257, 1263 (TTAB 2013) (quoting *Panda Travel, Inc. v. Resort Option Enter., Inc.*, 94 USPQ2d 1789, 1797 fn. 21 (TTAB 2009)); see also *Christian Broadcasting Network Inc. v. ABS-CBN Int'l*, 84 USPQ2d 1560, 1573 (TTAB 2007).

While Defendant contends that Plaintiff expressed an interest in licensing the J5 trademark,¹²¹ there is no supporting documentation or corroborating witness testimony. Plaintiff, on the other hand, denies that it sought to license the J5 trademark and asserts that Defendant approached it regarding a license to use album

¹²⁰ Defendant's Brief, pp. 30-31 (138 TTABVUE 31-32).

¹²¹ Defendant's Brief, pp. 9, 29-31 (138 TTABVUE 10, 30-32); Jackson Testimony Decl. ¶11 (122 TTABVUE 6).

cover art on various merchandise, including clothing.¹²² Plaintiff's documentation corroborates Mr. LaBarge's testimony.

In view of the foregoing, Defendant has failed to prove that Plaintiff expressly consented to, encouraged, or furthered Defendant's belief that Plaintiff consented to Defendant's use and registration of the J5 trademark. Defendant's affirmative defense of estoppel or acquiescence is denied.

IX. Dilution

Because we found that Defendant's mark is likely to cause confusion with Plaintiff's marks, we need not address Plaintiff's dilution claims. *See Multisorb Tech., Inc. v. Pactiv Corp.*, 109 USPQ2d 1170, 1171 (TTAB 2013).

Decision: The petition to cancel Registration No. 3059241 is granted on the grounds that Defendant did not make use of the mark prior to expiration of time for filing a statement of use, that Defendant abandoned the mark, and that the registered mark is likely to cause confusion with Plaintiff's marks.

The Notice of Opposition is sustained on the ground that Defendant's mark is likely to cause confusion with Plaintiff's marks.

¹²² LaBarge Rebuttal Testimony Decl. ¶¶5-7 and Exhibits 60 and 61 (128 TTABVUE 2-3, 6-10) (confidential). Although this testimony is designated confidential, there is nothing confidential about it. *See* Trademark Rule 2.116(g).