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UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, Virginia 22 313-1451

Lykos

Mailed: August 4, 2006

Cancellation No. 92041636

Dan Warren

v.

Keith Rosenberg

Before Quinn, Rogers and Cataldo, Administrative Trademark Judges.

By the Board:

Petitioner seeks to cancel respondent's registrations for the mark TRIP THEORY for "phonograph records featuring music, pre-recorded audio-cassettes featuring music, and compact discs featuring music" in International Class 9¹ and "entertainment, namely, live music performances" in International Class 41.² The petition for cancellation includes the following relevant allegations:

1. Registrant and Attorney at the time of filing did willfully and knowingly submit misleading

¹ Registration No. 2490596, issued September 18, 2001, alleging October 1996 as the date of first used anywhere and June 1997 as the date of first use in commerce.

² Registration No. 2551619, issued March 26, 2002, alleging October 1996 as the date of first used anywhere and May 1997 as the date of first use in commerce.

information, misrepresented the facts and falsified documents in order to defraud the US and Patent and Trademark Office to cancel registration of the above marks. Registrant and present Attorney deliberately withheld evidence pertaining to registrants [sic] filing procedures and both willfully and knowingly submitted misleading and perjurious information to the court. Based on this information a temporary injunction and a partial summary judgment was issued against me in a lawsuit that I filed in a Broward County, Florida court over these marks. The order was issued on the basis that Keith Rosenberg owned the rights to the said it [sic] marks by himself. Petitioner has suffered irreparable harm professionally as a result of this action.

3. On September 24, 1999 a disagreement occurred between us and the partnership was dissolved. Registrant immediately portrayed himself as sole owner of Trip Theory alleging his procurement of the trademarks as early as October of 1996. Registrant has publicly flaunted this claim via e-mail and other means to promoters, the musical community and the general public including many of our fans for the reason to deceive all interested parties that I [sic] nothing to do with the project. An example of this is provided which is dated 8/3/99. This fraudulent utilization and claim of the marks before acquiring actual registration is a direct conflict of the Lanham Act. This conduct began in September 1999 although the actual registration was not acquired until 2000 and 2001.

5. . . . Rosenberg's lone ownership of the marks is both unjust and patently wrong. Although I am not denying Keith Rosenberg has coownership of these marks, I however have been denied my rights to both marks. The cancellation of his registrations as sole owner is a just and equitable resolution.

On April 11, 2003, respondent filed a motion for summary judgment, arguing that the doctrine of *res judicata* bars petitioner's claims in this proceeding based on an

order issued by a Florida state court in civil litigation involving the parties.³ Insofar as an appeal was then currently pending of the state court decision, the Board denied respondent's motion for summary judgment as premature. The Board then suspended proceedings in this case pending final determination of the appeal. On April 19, 2005, the Board was notified of the Florida court's final judgment, as well as the order dismissing petitioner's appeal of the lower court's judgment. Thereafter, on July 5, 2005, the Board allowed the parties time to file any appropriate motions related to the civil proceedings.

On August 4, 2005, petitioner filed a motion requesting that the Board resume proceedings herein and reset respondent's time for filing an answer to the petition for cancellation. In response thereto, on August 29, 2005, respondent filed a communication which the Board has construed as a motion for summary judgment based on the Florida court's order because it relies on matters outside the petition for cancellation, and the parties have treated the motion as such. See TBMP § 503.04 (2d ed. rev. 2004) and cases cited therein. Petitioner has contested the

³ *John Dan Warren, p/k/a Dan Warren v. Keith Rosenberg individually and doing business as "TRIP THEORY" and Dana Brown, Case No. 01019237.*

motion for summary judgment.⁴

The basis for respondent's motion for summary judgment is the final order issued by the Florida state court. By way of background, the court made the following findings in a preliminary order granting respondent's motion for summary judgment in the state court action:

1. In the Fall of 1996, Rosenberg created the trademark/service mark "Trip Theory." He acquired ownership by appropriating use of such trademark in interstate commerce in that ROSENBERG developed a marketing plan, merchandise, music and entering into a business relationship with a Georgia Corporation by the name of INTERSOUND MUSIC ("Intersound") for purposes of funding and distributing recorded music of Rosenberg under the name "Trip Theory."

2. The Court finds no evidence that Rosenberg agreed to or did in fact transfer to Warren any ownership rights in "Trip Theory."

3. Further, the Court finds insufficient evidence, as a matter of law, to show that Rosenberg and Warren entered into and/or formulated a partnership under §620-et.seq. Fla.Stat. (2001).

4. Rosenberg filed and obtained two federal trademarks for the name "Trip Theory," each one indicating that Rosenberg first began commercial exploitation of "Trip Theory" in September of 1996. Warren was aware the United States Patent and Trademark Office issued to Rosenberg the aforementioned trademarks and Warren has not instituted any action to contest the validity of

⁴ Petitioner also moved for default judgment against respondent for failure to timely answer the petition for cancellation. Petitioner's motion for default judgment is denied. Petitioner is reminded that the Board previously set aside the technical default against respondent on April 13, 2004. In addition, since proceedings were suspended, the time for respondent to file an answer to the petition for cancellation has been tolled.

such trademarks. Therefore, these trademarks are presumptively valid.

5. The evidence is insufficient as a matter of law to establish a basis of an oral partnership between Rosenberg and Warren.

6. There are no genuine issues of material fact resolved, and the Defendant/Counter-Plaintiff is entitled to Summary Judgment as a matter of law.

The final order, issued on October 4, 2004, sets forth a permanent injunction against petitioner as described below:

1. WARREN, together with his Agents, Assignees, Attorney's and Employees "collectively WARREN" are hereby permanently enjoined from use exploitation and public dissemination of the trade name "TRIP THEORY" or any reasonable facsimile thereof, which is the sole and exclusive property of ROSENBERG, including but not limited to use of "THEORY OF TRIP THEORY". WARREN is further permanently enjoined and prohibited from use of the Web address triptheory@AOL.com and www.the real trip.com which WARREN shall forthwith transfer to ROSENBERG. WARREN shall take no further action to interfere with or dilute ROSENBERG'S exclusive ownership and enjoyment of the name TRIP THEORY.

Respondent argues that all issues related to the ownership of the trademark registrations in the instant cancellation proceeding were fully litigated in the Florida state court; that the court entered a final judgment in respondent's favor declaring that he is the owner of the trademark; and that as such, the doctrine of *res judicata* bars petitioner's claims in the instant cancellation proceeding.

In opposition thereto, petitioner argues that the doctrine of *res judicata* does not apply insofar as the

instant proceeding involves the cancellation of two trademark registrations; that both petitioner and respondent had equal rights in the mark in question by virtue of their respective use; and respondent made false statements before the Office in applying for his registration by stating that no other person had the right or claim to use his applied-for mark.

Before we consider whether summary judgment is appropriate in this case based on either the doctrines of *res judicata* or *collateral estoppel*, we will consider the question of whether petitioner has the proper standing to bring this cancellation proceeding.

Standing is a threshold issue that must be proven by a plaintiff in every inter partes case, *Ritchie v. Simpson*, 170 F.3d 1092, 50 USPQ2d 1023 (Fed. Cir. 1999) and *Lipton Industries, Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185 (CCPA 1982). The purpose of the standing requirement, which is directed solely to the interest of the plaintiff, is to prevent litigation when there is no real controversy between the parties. *Lipton Industries, Inc.*, 213 USPQ at 189. In the case of a petition to cancel, the standing requirement of a plaintiff has its statutory basis in Section 14 of the Act which provides that "any person who believes he is or will be damaged ... by the registration of a mark on the principal register ..." may file a petition to

cancel. To establish standing, it must be shown that the plaintiff has a "real interest" in the outcome of a proceeding; that is, plaintiff must have a direct and personal stake in the outcome of the cancellation. *Ritchie*, 50 USPQ2d at 1023. Facts regarding legitimate personal interest are a part of the plaintiff's case and must be proved. *Lipton Industries*, 213 USPQ at 189.

In this case, we find that petitioner lacks a "real interest" in the TRIP THEORY mark. Under the terms of the court's final order, petitioner cannot establish that he has a right to use the TRIP THEORY mark or trade name since he is permanently enjoined from "use exploitation and public dissemination of the trade name "TRIP THEORY" or any reasonable facsimile thereof" The court also made the finding that the mark or trade name "TRIP THEORY" is the sole and exclusive property of respondent.

Insofar as petitioner is prohibited by the terms of the permanent injunction from using the mark or trade name TRIP THEORY or any variation thereof, petitioner, as a matter of law, lacks the requisite standing to bring a petition to cancel against the involved registrations. Moreover, in its final order, the court specifically provided "WARREN shall take no further action to interfere with or dilute ROSENBERG'S exclusive ownership and enjoyment of the name TRIP THEORY."

We therefore find, *sua sponte*, that respondent is entitled to judgment as a matter of law. Judgment is entered against petitioner based on his lack of standing; and the petition to cancel is denied.

In view of our finding of petitioner's lack of standing, we need not consider respondent's motion for summary judgment on the issues of whether any claims which might arguably be found to have been stated in the petition for cancellation are barred by the doctrines of *res judicata* or *collateral estoppel*.