

IN THE UNITED STATE PATENT & TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

JEFF BROWN,)	OPPOSITION NO.: 91181448
)	
Opposer,)	TRADEMARK: PATRIOT GUARD
)	RIDERS AND DESIGN
v.)	
)	APPLICATION NO.: 77/040379
PATRIOT GUARD RIDERS, INC.,)	
)	DATE FILED: NOVEMBER 9, 2006
Applicant.)	
)	

OPPOSER’S MOTION FOR SUMMARY JUDGMENT AND COMBINED BRIEF

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OPPOSER’S MOTION FOR SUMMARY JUDGMENT AND COMBINED BRIEF

Opposer Jeff Brown (“Opposer”) submits this Motion for Summary Judgment and Combined Brief pursuant to Federal Rule of Civil Procedure 56 and Trademark Rule of Practice 2.127. Opposer supports this motion with the Declarations of Courtney Bru and Opposer and evidence submitted therewith. Opposer requests that the Board suspend this Opposition pending resolution of this motion pursuant to Trademark Rule of Practice 2.127(d).

I. INTRODUCTION

Thousands of servicemen and women have made the ultimate sacrifice in support of this country’s “War on Terror.” The oft-overlooked reality of these sacrifices is experienced at regional airports, on local roadways and at graveside services as citizens honor heroes known only as friends and family members. One of the freedoms protected by these soldiers’ sacrifices is the freedom to express one’s political views and opinions. The members of the Westboro Baptist Church of Topeka, Kansas (“WBC”) rely upon these freedoms to express their own views regarding the nation’s fall from religious grace. WBC has engaged in a pattern of protest at and during the funerals of fallen soldiers, including the display of large, colorful signs reading “THANK GOD FOR DEAD SOLDIERS,” “GOD BLEW UP THE TROOPS” and “GOD

HATES AMERICA.”

As a veteran, Opposer was outraged by these protests and their impact on the families and friends of fallen soldiers. This outrage led him to create and organize the Patriot Guard Riders in November, 2005. When invited by the family, Patriot Guard Riders attend the funerals of fallen soldiers to show their respect and honor their service. When possible, they will visually shield friends and family from protests with their bodies, their bikes and American flags. To this day, Patriot Guard Riders organize rides to honor those who serve, and to peacefully minimize the interruption caused by protesters like WBC in its attempt to exploit the grief of friends and families of fallen soldiers to maximize its own message.

Opposer created the word mark “Patriot Guard Rider” and triangular, folded design to promote the organization and unify the organization’s membership. Opposer designed various goods displaying the mark, paid production costs with his personal funds and arranged for their sale online. Opposer paid all shipping costs to distribute the goods. Opposer operated the store via PGR STORE, LLC, an entity owned and operated by Opposer and his wife, Mrs. Bonnie Brown.

As the organization grew, a small leadership team was implemented. Although Opposer delegated duties within the organization, and granted the organization permission to use the mark he had developed for non-commercial purposes (to promote the interests of families of deceased military members and veterans), Opposer retained sole control over the use of the mark for the production and sale of goods. When the organization incorporated in the state of Oklahoma in February 2006, Opposer intended that PGR, Inc. would continue to have permission to use the mark for noncommercial purposes (i.e., services). Opposer continued to retain sole control over the use of the mark for commercial purposes (i.e., goods).

Shortly after incorporation, Opposer had reason to suspect Jason Wallin, a fellow Board of Directors member, of embezzling money from the organization and/or PGR, Inc. Opposer insisted on an investigation. His desire to flush out the culprit resulted in dissension and division within the Board of Directors. While Opposer was traveling on PGR, Inc. matters, and in an effort to divert suspicion regarding his own activities, Wallin convened a conference call and attempted to convince the Board that Opposer was engaged in “self-dealing” by diverting profits from the sale of merchandise, despite the fact that Wallin and other members had always been aware that the store was owned and operated for profit by Opposer. Although an independent audit ultimately cleared Opposer of any wrongdoing, the Board recorded a vote of “no confidence” in Opposer, and Opposer resigned on November 7, 2006, fearing that Wallin, who owned the domain and computer servers, would shut down the website, effectively bringing an end to the organization. Just days after Opposer’s resignation, the parties filed their respective trademark applications. PGR, Inc.’s accountant later confirmed that Opposer’s suspicions regarding Wallin had been well-founded, and that Wallin had diverted more than \$30,000 from the PGR for his personal use.

II. STATEMENT OF UNDISPUTED FACTS

1. Opposer created and designed the “Patriot Guard Rider” mark. (*See* Declaration of Courtney Bru; Ex. 2 (pp. 37: 16-24, 41: 4-7, 73: 7-10); Ex. 3 (pp. 92: 16-19, 99: 11); Ex. 4 (Resp. to Interrogs. 8, 24)).

2. Opposer created, designed and adopted the mark after the “Run for the Wall” bike event in May of 2005, and at least as early as October 27, 2005. (Ex. 4 (Resp. to Interrog. No. 3); Ex. 5; Ex. 6.)

3. Opposer founded the Patriot Guard Riders organization in late October or early November 2005 by sending out numerous emails to motorcycle organizations and clubs to

recruit them to the organization. Opposer received numerous responses to his emails. (Ex. 1 ¶ 3; Ex. 7.) One such response was from Jason Wallin, who joined the organization on or about November 9, 2005. (Ex. 1 ¶ 4; Ex. 8; Ex. 9 (Resp. to Req. for Adm. No. 5)).

4. Soon after, and with the assistance of new members, Patriot Guard Riders launched its website patriotguard.org. (Ex. 1 ¶ 5; Ex. 4 (Resp. to Interrog. No. 12); Ex. 10.)

5. At the time the organization launched patriotguard.org, Opposer granted the organization permission to use the mark “Patriot Guard Rider” on the website for noncommercial purposes only, to promote the interests of families of deceased military members and veterans. (Ex. 2 pp. 65: 24-25, 66: 1-2, 69: 18-25, 70: 1-3, 15-24, 74: 3-6, 120: 2-5) and Exhibit 4 (Resp. to Interrogs. Nos. 10, 25)).

6. Opposer’s license to the organization for use of the mark in connection with the services did not grant a license to use the mark for use in connection with the production and sale of goods, or for “commercial purposes.” Members could purchase goods displaying the mark from Opposer via the Internet. (Ex. 2 pp. 65: 24-25, 66: 1-2, 67: 6-10, 69: 18-25; Ex. 9 (Resp. to Req. for Adm. Nos. 11, 17)).

7. Opposer and Wallin had discussions wherein Opposer stated that Opposer owned the mark and would retain the right to use the mark for commercial purposes, including selling goods displaying the mark in Opposer’s online store. (Ex. 4 (Resp. to Interrog. No. 9)); Ex. 9 (Resp. to Req. for Adm. Nos. 11, 17); Ex. 11 pp. 18: 6-13, 24-25, 21: 6-13, 80: 9-16, 83: 5-9.)

8. On November 11, 2005, at his own expense, Opposer ordered production of 100 embroidered patches displaying the mark “Patriot Guard Rider.” These patches were displayed for sale on the website patriotguard.org along with information regarding method of purchase. (Ex. 1 ¶¶ 6-7; Ex. 4 (Resp. to Interrog. Nos. 14-16); Ex. 12.)

9. Additional goods displaying the mark “Patriot Guard Rider” were later designed and ordered into production by Opposer, at his own expense, including metal license plates (first use date of December 9, 2005), ornamental/lapel pins (first use date of December 14, 2005), cloth banners and/or fabric flags (first use date of November 29, 2005), hats and t-shirts (first use date of December 8, 2005) and additional embroidered patches (first use date of December 23, 2005). (Ex. 1 ¶ 8; Ex. 4 (Resp. to Interrog. No. 15); Ex. 5; Ex. 6; Ex. 9 (Resp. to Req. for Adm. No. 130).

10. Opposer has produced documentation of orders for goods displaying the “Patriot Guard Rider” mark dated November 28, 2005 (windshield banners), December 5, 2005 (armbands), December 30, 2005 (car flags). (Ex. 1, ¶¶ 9-11; Exs. 15-17.)

11. Opposer similarly processed all orders and paid all shipping costs relating to the sale of goods displaying the mark “Patriot Guard Rider.” (Ex. 1 ¶¶ 6, 11; Ex. 2 p. 125: 10-23; Ex. 4 (Resp. to Interrog. No. 15); Ex. 12.)

12. All goods displaying the “Patriot Guard Rider” mark were delivered to and warehoused at Opposer’s personal residence, located at 8321 South 8th Street, Broken Arrow, Oklahoma. (Ex. 1 ¶¶ 6, 11; Ex. 2 p. 126: 10-23; Ex. 12).

13. On or about February 13, 2006, Opposer’s wife, Mrs. Bonnie Brown, registered a limited liability company in the State of Oklahoma, PGR STORE, LLC. (Ex. 1 ¶ 12; Ex. 9 (Resp. to Req. for Adm. No. 124); Ex. 18.)

14. On February 21, 2006, the Patriot Guard Riders organization was incorporated as a not for profit corporation in the state of Oklahoma under the name “Patriot Guard Riders, Inc.” (Ex. 1 ¶ 13; Ex. 9 (Resp. to Req. for Adm. No. 125; Ex. 19.) PGR, Inc. adopted a Board of Directors structure.

15. Opposer intended that the permission granted to the organization to use the mark for noncommercial purposes would transfer to PGR, Inc. (Ex. 2 pp. 67: 6-10, 69: 18-25, 70: 1-3.)

16. In February 2006, Opposer began working with John Jacobs, an attorney, to register the mark “Patriot Guard Riders.” (Ex. 1 ¶ 14; Ex. 2 p. 18: 17-25; Ex. 21.)

17. Opposer worked with John Jacobs to grant others a license for the mark “Patriot Guard Riders.” (Ex. 1 ¶ 15; Ex. 21.)

18. Jacobs advised Opposer to set forth the oral license to PGR, Inc. in writing, formalizing the arrangement between the parties. *Id.*

19. In late 2006, Opposer began to suspect the PGR Treasurer, Jason Wallin, was stealing funds from the PGR. In early November 2006, Jason Wallin organized a conference call with all Board members, except Opposer. Although the Board knew that Opposer was traveling at the time, and although no Board conference calls were previously made without notice to each Board member, no effort was made to contact Brown. The Board recorded a vote of no confidence in Opposer by a 3-2 margin. Soon after, on November 7, 2006, Brown resigned as President of PGR, Inc., fearing that Wallin, who owned the domain and computer servers, would shut down the website, effectively bringing an end to the organization. (Ex. 2 pp. 120: 21-25, 121: 1-7; Ex. 3 pp. 74: 9-25, 75: 1-9.)

20. Jeff Brown believed that an application to register the trademark “Patriot Guard Rider” had been filed on his behalf by attorney John Jacobs months before his resignation in November 2006, as evidenced by his expression of that belief to others. (Ex. 1 ¶¶ 16-17; Ex. 2 p. 18: 17-25; Ex. 3 p. 44: 7-9; Ex. 20 p. 82: 12-14; Ex. 23; Ex. 24.)

21. In fact, Opposer’s application was not filed until November 9, 2006. (Ex. 7.)

22. In Application No. 77/041,061, as amended, Opposer claims ownership of the mark “Patriot Guard Rider” in connection with “[a]ssociation services, namely, promoting the interests of **families of deceased military members and families of deceased veterans.**” (Emphasis original). The application states a first use date of “[a]t least as early as 10/27/2005” and a first use in commerce date of “[a]t least as early as 11/09/2005.” (Id.)

23. In addition, Brown claims ownership of the mark “Patriot Guard Rider” in connection with a variety of goods, including metal license plates, ornamental pins, cloth banners (motorcycle banner), fabric flags (vehicle mounted flag), hats (baseball-type cap), short- and long-sleeved t-shirts, embroidered patch. The application states a first use date of “[a]t least as early as 10/27/2005” and a first use in commerce date of “[a]t least as early as 11/09/2005” for each good. Id.

24. The application was filed by Opposer as an “Individual.” Id. Opposer did not intend to file the application on behalf of PGR, Inc. Bru Decl., ¶ 2 and Exhibit A (pp. 47: 11-13 and 48: 2-5)

25. A few hours before Application No. 77/041,061 was filed on behalf of Opposer, Jason Wallin filed Trademark Application Serial No. 77/040,379 on behalf of PGR, Inc. PGR, Inc. claims ownership of the mark “Patriot Guard Riders Riding With Respect,” and submitted a drawing consisting of “a yellow field with a blue and white folded American flag and blue text.” (Ex. 25.)

26. Application No. 77/040,379, filed by Wallin, seeks registration of the mark in connection with “[o]rganizing and conducting support groups in the field of **MILITARY AND MILITARY FAMILY SUPPORT**” (emphasis original) and provides a first use date of “[a]t least as early as 11/11/2005,” and a first use in commerce date of “[a]t least as early as

06/01/2006.” (Id.)

27. PGR, Inc. initially submitted a t-shirt from the Sturgis motorcycle event as the specimen for Application No. 77/040,379. (Ex. 26.) When that specimen was rejected for failure to show use in connection with the services in the application, PGR, Inc. submitted a photograph of a lapel pin bearing the mark “Patriot Guard *Rider* ‘Riding With Respect.’” (Ex. 26; Ex. 27.) This specimen consists of a photograph of the lapel pin manufactured and sold by the Opposer, in which “Rider” appeared in the singular rather the plural as in the drawing submitted by the Applicant. The “s” from the “Riders” portion of the ‘379 mark was omitted, and did not match the drawing submitted with the Application. (Ex. 28.)

28. Jeff Brown filed his Notice of Opposition on December 21, 2007 on the grounds of priority and likelihood of confusion and fraud. (Ex. 30.)

29. On January 29, 2008, during the course of this Opposition, PGR, Inc. filed a Trademark Application Serial No. 77/383,586 claiming ownership of the mark “Patriot Guard Riders,” without claim to any particular font, style, size or color. (Ex. 31.)

30. Application No. 77/383,586 claims ownership of the mark “Patriot Guard Riders” in connection with “[o]rganizing and conducting support groups in the field of combat veterans and their families.” The Application states a first use date of 11/09/2005 and a first use in commerce date of 11/09/2005. (Id.)

31. Application No. 77/383,586 also claims ownership of the mark “Patriot Guard Riders” in connection with a variety of goods, including ornamental pins, commemorative coins, cloth banners, fabric flags, hats, short-sleeved and long-sleeved t-shirts, sweatshirts, “doo-rags,” embroidered patches for clothing and armbands. The earliest first use date for any of these goods is 11/29/2005; the latest first use date for any of these goods is 12/23/2005. The first use

dates are identical to those set forth in Opposer's Application No. 77/041,061. Each of the specimens submitted in connection with Application No. 77/383,586 display the mark "Patriot Guard Riders" in connection with the phrase "Standing for Those Who Stood for Us." (Id.) It is undisputed that PGR, Inc. did not use the mark in commerce at least as early as 11/29/2005, as claimed in the application. In fact, the phrase "Standing for Those Who Stood for Us," which appears on the specimens purporting to support use in commerce in the '586 application, was not used until November or December of 2006, after Opposer resigned from the Board of Directors. (Ex. C pp. 26: 18-25, 27:1-14; Ex. 11 p. 20: 8-13.)

32. After Opposer's resignation, Opposer negotiated with the PGR, Inc. Board of Directors to reduce the previously granted oral license to writing, to restore Opposer's status as founder emeritus, and to restore the link to Opposer's stores to the organization's website. These efforts were unsuccessful. (Ex. 1 ¶ 18; Ex. 2 p. 77: 11-17; Ex. C pp. 91: 23-24, 92: 1-2; Ex. 20 p. 105: 6-14; Ex. 32.)

33. During that time, PGR, Inc. Board of Directors members made various statements on behalf of the Board, as follows:

a. "Sierge, we only have permission to use the PGR logo on the Web site. No permission given for anything else. Respects, Ed [Mueller]. (Ex. 3 pp. 88: 14-25, 89: 1-7; Ex. 33.)

b. "Forbidden design elements include the copy written logo that Jeff Brown drew as we only have permission to use it on the website but not in marketing material." (Ex. 3 p. 89: 15-25; Ex. 34.)

c. "The logo was approved for the Web site, but approval for merchandising was turned down." (Ex. 3 p. 92: 6-21; Ex. 35.)

d. “The logo which appears on the top of our web page is owned by Jeff Brown. He has given us the permission to continue to use it only on our web site, and not for merchandising any product.” (Ex. 3 pp. 93: 19-25, 94: 1-2; Ex. 35.)

e. “The BOD did not accept [Opposer’s] terms, and took a chance, and filed for a trademark on the current Logo.” (Ex. 4 p. 94: 6-25, 95: 1-25; Ex. 36; Ex. 39 (Resp. to Interrog. No. 5).)

f. “1. Jeff created the concept of PGR National and the PGR Store; 2. Jeff designed the logo and the merchandise it appears on; 3. Jeff and his wife are the sole owners of the ‘PGR Store;’ . . . 11. Jeff has offered the PGR the use of the logo and the name Patriot Guard Riders for use on our website only, for a period of one year; 12. Jeff has made it very clear that this excludes the PGR from being able to use the logo or name in connection with any merchandising; . . . 17. The BOD is now working on creating a new logo....” (Ex. 3 pp. 97: 5-25, 98: 1-25, 99: 1-2; Ex. 37.)

36. Opposer continued to sell merchandise displaying the mark “Patriot Guard Rider.” Opposer has continuously sold such merchandise since November of 2006. (Ex. 2 p. 7: 5-11.)

37. In December of 2006, PGR, Inc. launched its own online store to sell merchandise displaying the mark “Patriot Guard Rider.” (Ex. 11 p. 22: 4-6; Ex. 20 p. 107: 20-24.)

38. As a result, both parties currently offer their goods and services over the Internet to the general public and in particular individuals participating as Patriot Guard Riders. (Id; Ex. 1 ¶ 19.)

39. PGR, Inc. does not dispute prior use by Opposer, but maintains that the use of the ‘Patriot Guard *Rider*’ mark in connection with the PGR STORE, LLC or otherwise insures to the

benefit of the Applicant. (Ex. 29.)

40. During deposition testimonies, PGR, Inc. also claimed ownership of the mark because “it was created for an organization that was to operate under that name,” (Perry – 30:10-19) and due to “love of the PGR.” (Ex. 3 p. 30: 10-19; Ex. 20 pp. 97: 20-25, 98: 1-16.)

III. STANDARD OF REVIEW

Summary judgment “should be rendered if the pleadings, the discovery and disclosure materials on file, and any affidavits show that there is no genuine issue as to any material fact and that the movant is entitled to judgment as a matter of law.” Fed. R. Civ. P. 56(c); Trademark Trial and Appeal Board Manual of Procedure § 528.01, 2d Ed. (Mar. 2004). The movant bears the initial burden of demonstrating that no genuine issue of material fact exists. *Celotex Corp. v. Catrett*, 477 U.S. 317, 323 (1986). A factual dispute is genuine only if, based upon the evidence in the record, a reasonable fact finder could resolve the matter in favor of the nonmovant. *See e.g., Opryland USA, Inc. v. Great American Music Show Inc.*, 970 F.2d 847, 850, 23 USPQ2d 1471, 1472 (Fed. Cir. 1992). The Board need not try issues of fact when considering a motion for summary judgment; it need only determine whether there exist any genuine issues of material fact. *See e.g., Dyneer Corp. v. Automotive Prods. PLC*, 37 USPQ 1251, 1254 (TTAB 1995).

“When the moving party’s motion is supported by evidence sufficient to indicate that there is no genuine issue of material fact, and that the moving party is entitled to judgment, the burden shifts to the nonmoving party to demonstrate the existence of specific genuinely-disputed facts that must be resolved at trial.” *Hurley Int’l LLC v. Paul Volta et al.*, 82 USPQ2d 1339, 1343 (TTAB 2007). “The nonmoving party may not rest on the mere allegations of its pleadings and assertions of counsel, but must designate specific portions of the record or produce additional evidence showing the existence of a genuine issue of material fact for trial.” *Id.* PGR therefore “must point to an evidentiary conflict created on the record at least by a

counterstatement of facts set forth in detail in an affidavit by a knowledgeable affiant.” *Octocom Sys. Inc. v. Houston Computer Servs. Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1786 (Fed. Cir. 1990). Failure to carry this burden justifies the entry of summary judgment. *See e.g., Celotex Corp. v. Catrett*, 477 U.S. 317, 322-24 (1986).

IV. ARGUMENTS AND AUTHORITIES

The marks in Opposer’s application and those used by PGR, Inc. are confusingly similar. In fact, they are virtually identical. The undisputed facts, supported by the evidence attached hereto, show that there is no dispute as to priority of use by the Opposer. Instead, the question is whether the Opposer’s first use inured to the benefit of the Applicant. Opposer states that he owns the mark ‘Patriot Guard Rider,’ and that he licensed the mark to PGR, Inc. and its predecessor organization for use in connection with association services, namely, promoting the interests of families of deceased military members and veterans. Use by a licensee inures to the benefit of the licensor.

Further, Opposer maintains that Applicant committed fraud when it submitted Applications 77/383,586 and 77/040,379 to the Patent and Trademark Office.

These issues are properly resolved on summary judgment, as there exists no evidence in the record that Opposer’s use of the mark has been anything other than entirely consistent with his intent to license PATRIOT GUARD RIDER to PGR, Inc. for use in connection with the services provided by the organization.

A. Jeff Brown has standing to pursue this Opposition.

Opposer Jeff Brown is the owner of Application No. 77/041,061, filed November 9, 2006, through which he seeks registration of the mark “Patriot Guard Rider.” Opposer would be damaged by the registration of the Applicant’s mark(s) on the Principal Register, and thus is entitled to oppose the registration of Applicant’s mark(s). *See* 15 U.S.C. § 1063; 37 C.F.R. §§

2.101 through 2.107; TBMP §§ 303 *et seq.*

B. The undisputed facts show there exists no question of fact regarding priority of use, and that there is likelihood of confusion as between the marks used by both parties.

Likelihood of confusion is determined on a case-by-case basis and is aided by the application of the factors set forth in *In re E.I. duPont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 363 (CCPA 1973):

1. The similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation, and commercial impression;
2. The similarity or dissimilarity and nature of the goods or services as described in an application or registration or in connection with which a prior mark is in use;
3. The similarity or dissimilarity of established, likely-to-continue trade channels;
4. The conditions under which and buyers to whom sales are made, i.e., ‘impulse’ vs. careful, sophisticated purchasing;
5. The fame of the prior mark (sales, advertising, length of use);
6. The number and nature of similar marks in use on similar goods;
7. The nature and extent of any actual confusion;
8. The length of time during and conditions under which there has been concurrent use without evidence of actual confusion;
9. The variety of goods on which a mark is or is not used (house mark, ‘family’ mark, product mark);
10. The market interface between applicant and the owner of a prior mark...;
11. The extent to which applicant has a right to exclude others from use of its mark on its goods;
12. The extent of potential confusion, i.e., whether *de minimus* or substantial;
13. Any other established fact probative of the effect of use.

It is well settled that “any one of the factors may control a particular case.” *In re Dixie Restaurants, Inc.*, 105 F.3d 1405, 1406-07, 41 USPQ2d 1531, 1533 (Fed. Cir. 1997). In any likelihood of confusion analysis, two key considerations are the similarity between the marks and the similarities between the goods. *Federated Foods, Inc. v. Fort Howard Paper Co.*, 192 USPQ 24, 29 (CCPA 1976). The “ultimate question [is] whether relevant consumers are likely to believe that the products or services offered by the parties are affiliated in some way.” *Homeowners Group, Inc. v. Home Mktg. Specialists Inc.*, 78 F.3d 1111, 1116 (6th Cir. 1996).

Both Applicant and Opposer have requested registration of the mark as a word mark. *See*

e.g., In re RSI Sys., LLC, 88 USPQ2d 1445, 1448 (TTAB 2008) (noting that “if one of the marks comprises both a word and a design, then the word is normally accorded greater weight because it would be used by purchasers to request the goods or services”). *See also Anderson Corp. v. Therm-O-Shield Int’l, Inc.*, 226 USPQ 431 (TTAB 1985) (noting that the dominant portion of the mark is the way purchasers would refer to goods or services). All of the marks in question contain some version, singular or plural, of the distinctive term “Patriot Guard Rider,” and are for purposes of comparison, nearly identical. The specimens submitted by each party reveal that the parties have utilized an identical design element in connection with the word mark comprised of a triangular blue, yellow and white design. The marks are not only confusingly similar on the face of the applications, but they are used in a nearly identical manner in commerce.

When the parties claim ownership in identical marks, it is only “necessary that the goods in question be related in some viable manner and be marketed or marketable in a way that might lead purchasers to encounter both parties’ goods and to ascribe to them a common origin because of the identity of the marks.” *Merritt Foods v. Assoc. Citrus Packers, Inc.*, 222 USPQ 255, 256 (TTAB 1984). The parties have requested registration in connection with substantially identical services, namely, organizing and providing support services to military family members. Applicant also seeks registration of the mark in connection with a variety of goods. “[E]ven if the goods in question are different from, and thus not related to, one another in kind, the same goods can be related in the mind of the consuming public as to the origin of the goods. It is this sense of relatedness that matters in the likelihood of confusion analysis.” *Recot, Inc. v. Becton*, 214 F.3d 1322, 1327, 54 USPQ2d 1894, 1897 (Fed. Cir. 2000).

Both parties make their goods and/or services available for sale and/or consumption via the Internet to parties interested in motorcycle activities and/or missions to assist fallen or

disabled soldiers and their families. When both parties offer their goods and services over the Internet to the general public, the parties will be found to utilize identical channels of trade. *Apple Computer v. TVNET.net, Inc.*, Opposition No. 91168875, slip op. at 12 (August 28, 2007) (precedential).

Applicant has offered to stipulate that “there would be likely confusion, mistake or deception between its mark, “PATRIOT GUARD RIDERS RIDING WITH RESPECT,” identified in United States Trademark Application No. 77/040,379 in connection with the stated services, and Brown’s mark “PATRIOT GUARD RIDER,” identified in United States Trademark Application No. 77/041,061 in connection with the stated goods and services,” though its offer was “dependent upon Brown being able to prove that the parties’ use of the respective marks was contemporaneous, *i.e.*, if Brown can prove that his use of the mark “Patriot Guard Rider” was done on his own behalf, as an individual, rather than on behalf of PGR.”

The parties have focused upon these *DuPont* factors during the discovery period. Thus, the Opposition rests upon whether Opposer’s license of PATRIOT GUARD RIDERS to PGR, Inc. inured to the benefit of PGR, INC. rather than to the Opposer.

Although cases involving questions of intent typically pose questions of fact, pursuant to Federal Rule of Civil Procedure 56, the nonmovant must “proffer more than conclusory testimony or affidavits” to disprove allegations of intent. *Medinol Ltd. v. Neuro Vasx, Inc.*, 2003 WL 21189780, slip. op. at * 5, 67 USPQ2d 1205 (TTAB 2003). “An averment of no intent . . . is little more than a denial in a pleading.” *Id.* The TTAB has previously stated that

The appropriate inquiry is therefore not into the registrant’s subjective intent, but rather into the objective manifestations of that intent. ‘We recognize that it is difficult, if not impossible, to prove what occurs in a person’s mind, and that intent must often be inferred from the circumstances and related statement made by that person.’

Id. See also *ITC Ltd. v. Punchgini, Inc.*, 482 F.3d 135, 82 USPQ2d 1414, 1422 (2d Cir. 2007)

(noting that the “summary judgment rule would be rendered sterile...if the mere incantation of intent or state of mind would operate as a talisman to defect an otherwise valid motion”).

The record evidence unequivocally demonstrates that Opposer created the mark “Patriot Guard Riders,” extended an oral license to the PGR organization and corporation, and that both Opposer and the PGR organization and corporation acted consistently with this arrangement until after Opposer’s resignation from the Board of Directors. It is well settled that a trademark license may be either express or implied. *Dawn Donut Co. v. Hart’s Food Stores, Inc.*, 267 F.2d 358, 368 (2d Cir. 1959). An implied license-in-fact “arises out of the objective conduct of the parties, which a reasonable man would regard as indicating that an agreement has been reached.” *Allen-Myland v. Int’l Bus. Machines Corp.*, 746 F. Supp. 520, 549 (E.D. Pa. 1990). The essential characteristics of an implied license are “[p]ermission to use the trademarks coupled with the exercise of reasonable control over such use.” *Villanova Univ. v. Villanova Alumni Educational Foundation, Inc.*, 123 F. Supp. 2d 293, 307 (E.D. Pa. 2000). Opposer granted PGR organization an implied-in-fact license to use the mark for noncommercial purposes, and intended that the implied-in-fact license would transfer to PGR, Inc. at the time of incorporation. Applicant’s objective conduct indicates that such an agreement had been reached. By personally designing and arranging for the production of goods, and by maintaining a position of leadership within the PGR organization and corporation, Opposer exercised “reasonable control” over the use of the mark. (Ex. 2 p. 121: 17-25.)

It is well settled that “[w]here an individual adopts and uses a mark and later orally licenses its use to a corporation of which he or she is the president, the individual, not the corporation, is the owner of the mark...” 2 J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition* § 16:36 (4th ed. 2003). See *Monorail Car Wash, Inc. v. McCoy*, 178 USPQ

434, 438 (TTAB 1973) (finding that corporate officer owned and used the mark in his individual capacity where he originated the mark, developed the goods, arranged for their manufacture, solicited orders for shipments, personally delivered shipments and caused the trademark application to be filed); *In re Briggs*, 229 USPQ 76, 77 (TTAB 1986) (finding that corporate officer owned and used the mark in his individual capacity where he adopted and used the mark, granted the corporation an oral license and directed the activities of the organization, thereby ensuring the quality of the services rendered under the mark).

C. The undisputed facts show that Applicant committed fraud in connection with the filing of its application(s).

There is no dispute and no genuine issue of fact that in its first application, the ‘379 application, Applicant only claimed use of the mark on services, filing specimens that did not show use of the mark in connection with the services and did not match the Applicant’s claimed mark. Applicant later filed substitute specimens (a photograph of one of the pins manufactured by the Opposer, worn on a jacket) that still did not match the mark as filed nor support use of the filed mark in connection with the services identified. These substitute specimens show the term “Rider” in its singular form, although the Applicant’s drawing contains the term in its plural form, “Riders.” In the Applicant’s second application, the ‘586 application, the specimens bearing the tag line “Standing For Those Who Stood For Us” purport to support use in commerce of various goods and services at least as early as 11/09/2005, but testimony given by Applicant clearly establishes that this tag line was not developed nor used in commerce until late November or early December of **2006**.

“Fraud in procuring a trademark registration . . . occurs when an applicant knowingly makes false, material representations of fact in connection with his application.” *Torres v. Cantine Torresella S.r.l.*, 808 F.2d 46, 48, 1 USPQ2d 1483 (Fed. Cir. 1986). An application will

be considered fraudulent when the applicant “knew or should have known” that material information set forth therein was not true. *Id.* at 48. To prove fraud, the Opposer must establish (1) a false statement, (2) made with knowledge, actual or constructive, of its falsity, (3) that is material to the examining attorney’s decision to approve the application. *American Flange & Manufacturing Co., Inc. v. Rieke Corp.*, 80 USPQ2d 1397, 1416, 2006 WL 1706438 (TTAB 2006).

Application Serial No. 77/040,379 filed by PGR contains numerous material false statements. Statements regarding the use of the mark on goods and/or services are material to the issuance of a registration. *Hurley Int’l LLC*, 82 USPQ2d at 1344. Statements regarding specimens submitted in support of an application are also material to registration. *Id.* at 1346. The initial specimen submitted in connection with Application No. 77/040,379 was a black Sturgis t-shirt. When that specimen was refused by the Examining Attorney for failure to show the mark used in connection with the services identified in the application and because the mark on the specimens did not match the mark in the drawing, the Applicant identified a second specimen, a “patch.” The specimen was in fact one of the Opposer’s lapel pins bearing the mark “Patriot Guard Rider” (in the singular) along with the triangular design and the tag line “Riding With Respect.” Those pins were not in use until 12/14/2005, as shown in the Opposer’s application and thus could not support a first use date of 11/11/2005. Applicant knew or should have known this fact based upon its knowledge of the Opposer’s trademark application, which sets forth use dates. This evidence was material to the examiner’s approval of the mark.

Finally, PGR, Inc.’s Application No. 77/040,379 was fraudulently filed because (1) Opposer was using the same mark at the time Jason Wallin signed the oath, (2) Opposer had legal rights superior to PGR Inc.’s rights, (3) as a licensee, PGR, Inc. knew that Opposer had

rights in the mark superior to those of PGR, Inc., knew that a likelihood of confusion would result from Applicant's use of its mark and/or had no reasonable basis for believing otherwise, and (4) by failing to disclose these facts to the Patent and Trademark Office, PGR, Inc. intended to procedure a registration to which it was not entitled. *See e.g., Ohio State Univ. v. Ohio Univ.*, 51 USPQ2d 1289, 1999 WL 517202 (TTAB 1999). Opposer has been using the mark in connection with goods and services since November of 2005, long before PGR, Inc. filed its application. Opposer developed the mark, was first to use it, and therefore had legal rights superior to those of PGR, Inc. This knowledge is best demonstrated by the fact that Applicant operated for a significant period of time with clear (and outwardly expressed) knowledge that it had been given a license and did not have ownership or rights to use the mark in a commercial context. *See Marshak v. Treadwell*, 58 F. Supp. 2d 551, 561-68 (D.N.J 1999). Applicant's statements indicating its understanding that it served as a licensee of Opposer undermine any effort on behalf of PGR, Inc. to claim a reasonable belief that PGR, INC. owned the mark in question. In addition, PGR, Inc. made objective statements giving rise to an inference that it was attempting to obtain registration of the mark owned by Opposer.

In order to negate fraudulent intent, Applicant must present evidence that it had "an honest and good faith belief" that it owned the mark "Patriot Guard Riders." *Kemin Indus., Inc. v. Watkins Prods., Inc.*, 192 U.S.P.Q.2d 327, 1976 WL 21132 (TTAB 1976). No such evidence exists.

In sum, the record is entirely devoid of evidence indicating that PGR was anything but a licensee of the Opposer, and had no ownership in the mark "Patriot Guard Riders" or any variation thereof. The record contains no sufficient evidence, defined as objective indicia of Opposer's intent, that he acted on behalf of PGR, Inc. at the time he designed, ordered and paid

for production, or during his distribution of the goods and services contained in his application. The record contains no evidence that Opposer had given Applicant a license to use the mark for anything beyond the association services. In fact, testimony given by Applicant clearly established that the Applicant knew that Opposer had superior rights in the mark and never intended to give PGR, Inc. permission to use the mark on anything other than association services.

V. CONCLUSION

There exists no objective, legally sufficient evidence that the marks are not confusingly similar, that Opposer has priority, or that raises a genuine issue of material fact as to Applicant's fraudulent conduct in filing both the '379 and '586 applications. Accordingly, registration of both the '379 and the '586 applications filed by PGR, Inc. must be denied.

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CERTIFICATE OF SERVICE

The undersigned hereby certifies that on the 22nd day of January, 2009, a true and correct copy of the above and foregoing was sent via electronic delivery to DMarr@trexlaw.com and that on the 23rd day of January, 2009, mailed, with proper postage thereon, to:

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