

THIS OPINION IS NOT A
PRECEDENT OF THE TTAB

Mailed:
May 15, 2018

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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Devil's Disciples MC

v.

Woodard

—
Opposition No. 91228868

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Sunita Koneru, Esq. for Devil's Disciples MC.

Matthew Saunders of Saunders & Silverstein LLP for Fred Woodard.

—
Before Lykos, Shaw and Lynch, Administrative Trademark Judges.

Opinion by Lykos, Administrative Trademark Judge:

On December 4, 2015, Fred Woodard, an individual residing in Epping, New Hampshire ("Applicant") filed an application under Section 1(a) of the Trademark Act, 15 U.S.C. § 1051(a), to register on the Principal Register the collective membership mark displayed below for "[i]ndicating membership in a motorcycle club" in U.S. Class 200:¹

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¹ Application Serial No. 86839103, alleging January 1966 as the date of first use anywhere and in commerce by group members.



The description of the mark is as follows: “The mark consists of a stylized human skeleton wearing a motorcycle helmet with motorcycle handlebars extending from the sides of the helmet, and sitting astride a motorcycle wheel viewed from the front.” Color is not claimed as a feature of the mark. In the application, Applicant averred that he believed that under 15 U.S.C. § 1051(a), he is “the owner of the collective membership mark sought to be registered;” that “he is exercising legitimate control over the use of the mark in commerce by the members in connection with the identified collective membership organization;” and that “the method of control” over the use of the mark by the members is “specified in the applicant’s bylaws or other written provisions.” The specimen submitted with the application, described as an “image of mark on the jacket of a member,” is reproduced below:



By way of its Amended Notice of Opposition, the operative complaint in this case, Devil's Disciples MC ("Opposer") opposes registration of Applicant's mark on the grounds: (1) that Applicant was not, and never was, the owner of the applied-for collective membership mark as of the filing date of the application; (2) that Applicant committed fraud in connection with the ex parte prosecution of the involved application when he stated that he was the "owner" of the applied-for mark; and (3) likelihood of confusion under Trademark Act Section 2(d), 15 U.S.C. § 1052(d), based on Opposer's previously used common law collective membership mark ("DDMC Skeleton Mark") displayed below for indicating membership in the Devil's Disciples Motorcycle Club:²

² As explained below, Opposer, via declaration testimony, properly authenticated this piece of evidence introduced during its testimony period.



Opposer's allegations include the following:³

1. On information and belief, applicant Fred Woodard is an individual with a mailing address of 287 Mast Road, Epping, New Hampshire 03042 ("Applicant").
2. On information and belief, 287 Mast Road, Epping, New Hampshire 03042 is the address of a motorcycle club called the Outlaws. On information and belief, Applicant is a current member of, or part of, the Outlaws.
3. Opposer is a five-decade-old plus motorcycle club named Devils Desciples, MC (motorcycle club) based in the Boston-Northeast United States area with chapters in Boston, Massachusetts, Leominster, Massachusetts, North Shore, Massachusetts, the state of Vermont, and the state of Rhode Island, and [is] currently comprised of approximately 35-40 members, not including Applicant Fred Woodard.
4. In or around 1963, Mr. John Wesley Johnson and Mr. Freddy Wallace (aka Renegade) (deceased) co-founded the Devils Desciples motorcycle club (Devils Desciples, MC).
5. Co-founder Mr. John Wesley Johnson is the current overseer of all the chapters of the Devil's Desciples motorcycle club (Devils Desciples, MC).

³ None of the exhibits submitted with Opposer's original or amended Notice of Opposition are part of the trial record. See Trademark Rule 2.122(c), 37 C.F.R. § 2.122(c).

6. In 1964, Devils Desciples co-founder Mr. Freddy Wallace created an oil painting of a human skeleton on a motorcycle bike wearing a helmet. ...

7. The helmet-wearing human skeleton on motorcycle image in the 1964 oil painting was/is the inspiration for what became the membership logo for the Devils Desciples motorcycle club (Devils Desciples, MC).

8. Devils Desciples, MC's mark is a design mark of a stylized human skeleton wearing a helmet with motorcycle handlebars extending from the side of the helmet and sitting astride a motorcycle wheel viewed from the front used in connection with membership in a motorcycle club ("DDMC Skeleton Mark"), ...

9. Since 1964, Opposer Devil's Desciples MC is and has been continuously using the DDMC Skeleton Mark ... in connection with membership in a motorcycle club.

10. Applicant Fred Woodard is not a current member of the Devil's Desciples motorcycle club (Opposer's motorcycle club).

11. On information and belief, Applicant Fred Woodard was a Devil's Desciples member of the Boston chapter from about 1974 to 1979 after which his membership was terminated when he was convicted and imprisoned for about 16 years. Upon returning from jail (on information and belief around 1996), Applicant Fred Woodard asked the Boston chapter of the Devil's Desciples motorcycle club to reactivate his membership. His membership was reactivated then and about a year later Applicant Fred Woodard was voted out of the Devil's Desciples motorcycle club (Opposer's motorcycle club) and his membership terminated.

12. Applicant Fred Woodward [sic] is not a member of Devil's Desciples MC nor is he authorized in any way to speak for or act on behalf of Devil's Desciples MC (Opposer's motorcycle club).

13. Applicant Fred Woodward [sic] is not the overseer of Devil's Desciples MC, and thus has absolutely no rights to Opposer's trademarks, logos, copyrights, products or properties, including the applied-for mark and the DDMC Skeleton Mark.

14. As evidenced in Application Serial No. 86/839,103, Applicant seeks to register a collective membership mark

consisting of a stylized human skeleton wearing a motorcycle helmet with motorcycle handlebars extending from the sides of the helmet, and sitting astride a motorcycle wheel viewed from the front for “indicating membership in a motorcycle club” in International Class 200. Applicant filed Application Serial No. 86/839,103 on December 4, 2015. ...

15. The specimen submitted by Applicant in Application Serial No. 86/839,103 is an image (on a motorcycle jacket) known to motorcycle clubs as a patch which indicates membership in a particular motorcycle club (“patch”)

16. As evidenced by Applicant’s specimen, the applied-for mark is part of a larger image (part of a patch) which consists of the applied-for mark (helmet-wearing human skeleton figure on a motorcycle bike) and four flames surrounding the figure with the words DEVIL’S DESCIPLES M.C. ? on the flames (the word DEVIL’S on the upper left flame, the word DESCIPLES on the upper right flame, M.C. on the lower left flame, and ? (a question mark) on the lower right flame).

17. As evidenced by his 1964 oil painting ..., Devil’s Desciples’ co-founder Mr. Freddy Wallace originally created this four-flame design (four flames surrounding the helmet-wearing human skeleton figure with the words DEVIL’S DISCIPLES M.C. ? on the flames).

18. In or about 1964, the full image of the DDMC Skeleton Mark (helmet-wearing human skeleton sitting on motorcycle bike) and the four flames surrounding the figure became, evolved into, Opposer Devil’s Desciples MC’s patch.

19. Opposer Devil’s Desciples MC is and has been continuously using the DDMC Skeleton Mark ... and its patch in connection with membership in a motorcycle club since 1964.

4 TTABVUE 2-5.

In his Answer, Applicant denied the salient allegations of the Amended Notice of Opposition with the exception of the following: he admitted allegation no. 4 (that “[i]n or around 1963, Mr. John Wesley Johnson and Mr. Freddy

Wallace (aka Renegade) (deceased) co-founded the Devils Disciples motorcycle club”), and he admitted allegation no. 11 in part (that Applicant’s “membership in Devil’s Disciple commenced in 1974” and that he was “convicted and imprisoned for about 16 years”). 6 TTABVUE 3. Applicant also asserted the affirmative defenses of “unclean hands, acquiescence, laches, and/or estoppel,” none of which were pursued at trial or argued in his brief; accordingly, these affirmative defenses are deemed waived. 6 TTABVUE 10. *See Alcatraz Media Inc. v. Chesapeake Marine Tours Inc.*, 107 USPQ2d 1750, 1753 n.6 (TTAB 2013), *aff’d mem.*, 565 F. App’x 900 (Fed. Cir. 2014). In addition, Applicant asserted the affirmative defense of failure to state a claim upon which relief may be granted. Insofar as Applicant neither filed a formal motion to dismiss pursuant to Fed. R. Civ. P. 12(b)(6) during the interlocutory phase of this proceeding, nor argued this asserted affirmative defense in his brief, it is also deemed waived. *See id.*

The case is now briefed and presented to us for a decision on the merits. Opposer, as plaintiff in this proceeding, bears the burden of proof by a preponderance of the evidence.

I. The Record⁴

Pursuant to Trademark Rule 2.122(b), 37 C.F.R. § 2.122(b), the record includes Applicant's application file⁵ and the pleadings.

Opposer submitted under notice of reliance (filed July 25, 2017), Applicant's Responses to Opposer's First Set of Requests for Production of Documents and Things, Response to Request No. 3. In addition, Opposer introduced the following testimony declarations:⁶

Declaration of John Wesley Johnson ("Johnson Decl."), co-founder, member and "current overseer of all chapters" of Opposer Devil's Disciples Motorcycle Club, with attached Ex. A (photo of 1964 original oil painting painted by Opposer's co-founder Renegade), Ex. B. (photo of Opposer's DDMC Skeleton Mark patch) and Ex. C ("DDMC 1% Bylaws");

Declaration of Bobby Lee ("Lee Decl."), a member of Opposer's motorcycle club;

Declaration of Pat Politano ("Politano Decl."), a member of Opposer's motorcycle club;

Declaration of John Dulian ("Dulian Decl."), a member of Opposer's motorcycle club;

Declaration of Eddie Ryan ("Ryan Decl."), a member of Opposer's motorcycle club; and

Declaration of Richard Boyd ("Boyd Decl."), a member of and "current regional president and treasurer" of Opposer's motorcycle club.

⁴ Parallel citations to the record in this opinion are to the TTABVue docket entry number and the electronic page number where the document or testimony declaration appears. *See Turdin v. Trilobite, Ltd.*, 109 USPQ2d 1473, 1476 n.6 (TTAB 2014).

⁵ As such, Opposer's submission under notice of reliance of the specimen in the involved application file was superfluous.

⁶ Counsel for Applicant filed with the Board a "Notice of Election to Take Oral Cross-Examination" of several of Opposer's witnesses. No oral deposition transcripts of any purported cross-examination testimony were submitted with the Board.

Applicant introduced the following testimony declarations:

Declaration of Fred Woodard, Applicant, a member and former President of the Devil's Disciples Motorcycle Club ("Woodard Decl.") with attached Ex. A ("DDMC Bylaws"); Ex. B (cease and desist letter dated April 18, 2014 from Applicant's attorney to Supersport USA located in Malden, MA); Ex. C (cease and desist letter dated December 4, 2015 from Applicant's attorney to Supersport USA); and Ex. D (cease and desist letter dated December 4, 2015 from Applicant's attorney to John Wesley Johnson and Charles Tringale); and

Declaration of Eric Ayre ("Ayre Decl."), "President of the Mother Charter of the Devil's Disciples Motorcycle Club."

In reaching our decision, we have not considered any statements made by either party in their briefs that are unsupported by evidence in the record.⁷ See *Saul Zaentz Co. v. Bumb*, 95 USPQ2d 1723, 1725 n.7 (TTAB 2010). Likewise, we have not considered any allegations in the Amended Notice of Opposition unsupported by trial evidence.

II. Background – Collective Membership Marks

The crux of this dispute centers on ownership of Applicant's applied-for collective membership mark. Section 45 of the Trademark Act, 15 U.S.C. § 1127, defines "collective mark" as "a trademark or service mark"

- (1) used by the members of a cooperative, an association, or other collective group or organization, or
- (2) which such cooperative, association, or other collective group or organization has a bona fide intention to use in commerce and applies to register on the principal register established by this [Act], and includes marks indicating membership in a union, an association, or other organization.

⁷ For example, we have not considered Applicant's references to third-party registrations in its brief.

Collective membership marks, unlike trademarks or service marks, do not indicate commercial origin of goods or services. *See id.* Rather, the sole purpose of a collective membership mark is to indicate that the user of the mark is a member of a particular organization. *Id.* *See also In re Code Consultants Inc.*, 60 USPQ2d 1699, 1700 (TTAB 2001); *Constitution Party of Tex. v. Constitution Ass'n USA*, 152 USPQ 443 (TTAB 1966); *Ex parte The Supreme Shrine of the Order of the White Shrine of Jerusalem*, 109 USPQ 248, 249 (Comm'r Pat. 1956). “There is no limitation in the [statutory] definition that only a collective group, association or organization can own or register a collective membership mark.” *In re Stencel Aero Eng'g Corp.*, 170 USPQ 292, 293 (TTAB 1971). Section 4 of the Trademark Act, 15 U.S.C. § 1054, provides the authority for the registration of collective and certification marks by “persons” exercising legitimate control over their use, even in the absence of an industrial or commercial establishment. “Persons” includes juristic persons as well as individuals exercising legitimate control. *See In re Kurowski*, 2001 WL 935837, *3 (Ser. No. 75757611, Aug. 17, 2001 TTAB) (non-precedential) (“[T]here is no reason why an individual cannot be the owner of the [collective membership] mark, provided he or she controls the group and the use of the mark by the group’s members.”); *see also In re Stencel Aero Eng'g Corp.*, 170 USPQ at 293 (“It is true that applicant is not a collective group or organization in the sense that it is composed of members rather than stockholders but as applicant points out, the definition simply requires that the mark be used by members of the

association.”). Thus, a collective mark is owned by a collective entity or “person” even though the mark is used by the members of the collective. Trademark Act Section 45, 15 U.S.C. § 1127.

“A collective membership mark may comprise an individual letter or combination of letters, a single word or combination of words, a design alone, a name or nickname, or other matter that identifies the collective organization or indicates its purpose.” TRADEMARK MANUAL OF EXAMINING PROCEDURE (“TMEP”) § 1304.01 (Oct. 2017). A collective membership mark may consist of an object, such as a flag, or may be a part of articles of jewelry, such as lapel pins or rings. *Id.* Shoulder, sleeve, pocket, or similar patches, or lapel pins, whose design constitutes a membership mark and which are authorized by the parent organization for use by members on garments to indicate membership, are also acceptable uses. *Id.*

With this background in mind, we proceed to our analysis of standing and Opposer’s claims.

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), *cert. denied*, 135 S. Ct. 1401 (2015). Our primary reviewing court, the U.S. Court of Appeals for the Federal Circuit, has enunciated a liberal threshold for determining standing, namely that a plaintiff must demonstrate that it possesses a “real interest” in a

proceeding beyond that of a mere intermeddler, and “a reasonable basis for his belief of damage.” *Empresa Cubana Del Tabaco*, 111 USPQ2d at 1062 (citing *Ritchie v. Simpson*, 170 F.3d 1902, 50 USPQ2d 1023, 1025-26 (Fed. Cir. 1999)). A “real interest” is a “direct and personal stake” in the outcome of the proceeding. *Ritchie v. Simpson*, 50 USPQ2d at 1026.

According to the record, Opposer is a motorcycle club founded in 1963 by Mr. Johnson and an individual known as Renegade who is now deceased. Johnson Decl. ¶¶2, 3 (10 TTABVUE 2). In 1964, Renegade created an oil painting of a human skeleton on a motorcycle bike wearing a helmet that became the inspiration for Opposer’s collective membership DDMC Skeleton Mark. *Id.* at ¶¶7, 8, Ex. A (authenticated photograph of Renegade’s original 1964 oil painting) and Ex. B (authenticated photograph of Opposer’s common law mark or “patch”) (10 TTABVUE 3, 8-11); Lee Decl. ¶5 (10 TTABVUE 19); Politano Decl. ¶4 (10 TTABVUE 35); Dulian Decl. ¶4 (10 TTABVUE 31). Ryan Decl. ¶4 (10 TTABVUE 37). Opposer presented testimony from several members explaining that a “patch” is a motorcycle club’s “key/vital/chief item/article to indicate membership in a club” and that “[a] club’s patch is typically worn on a member’s jacket.” Johnson Decl. ¶ 5 (10 TTABVUE 3); *See also* Lee Decl. ¶4 (10 TTABVUE 18); Dulian Decl. ¶3 (10 TTABVUE 30); Politano Decl. ¶3 (10 TTABVUE 24); Ryan Decl. ¶3 (10 TTABVUE 36). Mr. Johnson testified that he and other members of Opposer’s motorcycle club have been using Opposer’s DDMC Skeleton Mark in the form of a patch worn on the back of a jacket

continuously since 1964 to designate membership in its motorcycle club; that “[f]or over 50 years, [Opposer] has expended time and money to safeguard the goodwill of its DDMC Skeleton Mark patch”; and that the mark is not personal to any one member. Johnson Decl. ¶¶9-11 (10 TTABVUE 3). His testimony regarding member use is corroborated by Lee, Ryan, Dulian and Politano, members of the club since 1964. Lee Decl. ¶6 (10 TTABVUE 19); Dulian Decl. ¶5 (10 TTABVUE 31); Politano Decl. ¶5 (10 TTABVUE 25); Ryan Decl. ¶5 (10 TTABVUE 37). The documentary evidence further shows a resemblance between Opposer’s common law DDMC Skeleton Mark and Applicant’s applied-for collective membership mark.

Thus, based on Opposer’s declaration testimony and documentary evidence, we find that Opposer has demonstrated a “direct and personal stake” as well as “a reasonable basis for [its] belief” that it would be damaged by registration of Applicant’s proposed collective membership mark. In view thereof, Opposer has established its standing.

IV. Ownership

First we consider Opposer’s claim that Applicant’s application is void *ab initio* because he was not the owner of the mark at the time his use-based application was filed. It is Opposer’s burden as plaintiff in the proceeding to establish non-ownership by a preponderance of the evidence. *See, e.g., Metro Traffic Control, Inc. v. Shadow Network Inc.*, 104 F.3d 336, 41 USPQ2d 1369,

1372 (Fed. Cir. 1997); *UVeritech, Inc. v. Amax Lighting, Inc.*, 115 USPQ2d 1242, 1245 (TTAB 2015).

“The owner of a collective membership mark exercises control over the use of the mark ...” TMEP § 1304.02(a)(i). Under 15 U.S.C. §§ 1051(a) and 1054, and 37 C.F.R. § 2.44(a)(4)(i), to establish a basis under Section 1(a) of the Trademark Act, the applicant of a collective membership mark must:

Submit a statement specifying the nature of the applicant’s control over the use of the mark by the members (37 C.F.R. § 2.44(a)(4)(i)(A));

Specify the date of the applicant’s members’ first use of the mark anywhere to indicate membership in the collective organization (37 C.F.R. § 2.44(a)(4)(i)(B));

Specify the date of the applicant’s members’ first use of the mark in commerce (37 C.F.R. § 2.44(a)(4)(i)(B));

Submit one specimen for each class, showing how a member uses the mark in commerce (37 C.F.R. §§ 2.44(a)(4)(i)(C), 2.56(b)(3)); and

Submit a verified statement that the applicant believes the applicant is the owner of the mark; that the mark is in use in commerce; that the applicant is exercising legitimate control over the use of the mark in commerce; that to the best of the signatory’s knowledge and belief, no other persons except members have the right to use the mark in commerce, either in the identical form or in such near resemblance as to be likely, when used on or in connection with the collective membership organization of such other persons, to cause confusion or mistake, or to deceive; that the specimen shows the mark as used in commerce by the applicant’s members; and that the facts set forth in the application are true (15 U.S.C. §§ 1051(a)(3)(C), 1054; 37 C.F.R. § 2.44(a)(4)(i)(D) (emphasis added.)).

Accordingly, as per the language in the statute and Trademark Rules, only the “owner” who is “exercising legitimate control over the use of the mark in commerce” may file an application to register a collective membership mark. *Cf. Huang v. Tzu Wei Chen Food Co.*, 849 F.2d 1458, 7 USPQ2d 1335, 1336 (Fed. Cir. 1988) (affirming Board’s holding that an application was void *ab initio* because the applicant was not the owner of the mark on the filing date); *Holiday Inn v. Holiday Inns, Inc.*, 534 F.2d 312, 189 USPQ 630, 635 n.6 (CCPA 1976) (“It is fundamental that ownership of a mark is acquired by use, not by registration.”); *Great Seats Ltd. v. Great Seats Inc.*, 84 USPQ2d 1235, 1239 (TTAB 2007) (“In a use-based application under Trademark Act Section 1(a), only the owner of the mark may file the application for registration of the mark; if the entity filing the application is not the owner of the mark as of the filing date, the application is void *ab initio*.”). Typically, in cases where an individual and organization have either a prior or current relationship, in the absence of a formal agreement governing ownership of the mark, and where both the departing member and the remnant group claim ownership of the mark, the question of ownership of a trademark or service marks hinges on “(1) the parties’ objective intentions or expectations; (2) who the public associates with the mark; and (3) to whom the public looks to stand behind the quality of goods or services offered under the mark.” *Lyons v. Am. Coll. of Veterinary Sports Med. & Rehab.*, 859 F.3d 1023, 123 USPQ2d 1024, 1028 (Fed. Cir. 2017) (citing *Wonderbread 5 v. Gilles*, 115 USPQ2d 1296, 1305 (TTAB 2015)). Under the

similar factual scenario presented here, we see no reason why this framework for resolving ownership disputes of trademark and service marks would not also apply to collective membership marks in assessing ownership and legitimate exercise of control. *See* 15 U.S.C. 1054 (“Applications and procedure [for collective membership marks] shall conform as nearly as practicable to those prescribed for the registration of trademarks”).

As per the admissions in his Answer to the Amended Notice of Opposition, it is undisputed that “[i]n or around 1963, Mr. John Wesley Johnson and Mr. Freddy Wallace (aka Renegade) (deceased) co-founded the Devils Desciples motorcycle club”); that Applicant’s “membership in the Devil’s Desciples motorcycle club commenced in 1974”; and that Applicant was “convicted and imprisoned for about 16 years.” Answer ¶¶4, 11. It is also undisputed that the inspiration for the involved collective membership marks originated with a painting by a deceased member affiliated with Opposer. Johnson Decl. ¶¶7 and 8, Ex. A (authenticated photograph of Renegade’s original 1964 oil painting); Opposer’s Notice of Reliance, Applicant’s Responses to Opposer’s First Set of Requests for Production of Documents and Things, Response to Request No. 3 (Applicant has “no such documents” which “refer to or relate to the conception” of its applied for mark, 9 TTABVUE 5). Otherwise, the facts of this case are highly disputed with the parties presenting diametrically opposed testimony. For this reason, we have made liberal use of direct excerpts from each party’s testimony. *See, e.g., UVeritech v. Amax Lighting*, 115 USPQ2d at 1245 (“The

parties dispute each other's account of certain relevant facts, so we have made liberal use of quotes from the testimony.”).

In lieu of taking a testimony deposition, Opposer submitted the testimony of its co-founder, Mr. Johnson, in declaration form. In pertinent part, it states as follows:

12. Applicant Fred Woodard does not control our DDMC Skeleton Mark Patch. The DDMC Skeleton Mark patch does not inure to Applicant Fred Woodard.

* * *

18. Applicant Fred Woodard is not a current member of the Devil's Disciples motorcycle club and has not been a member of the Devil's Disciples motorcycle club since 1997.

19. Applicant Fred Woodard joined the Devil's Disciples motorcycle club in 1974, 10 years after our club had already adopted and was continuously using its DDMC Skeleton Mark patch.

20. Applicant Fred Woodard was a member of the Devil's Disciples motorcycle club from about 1974-1979.

21. Fred Woodard was not a member of the Devil's Disciples motorcycle club during his incarceration and his DDMC Skeleton Mark patch was revoked.

22. After prison, Applicant Fred Woodard was again a member of the Devil's Disciples motorcycle club for a brief period of time around 1996/1997 until he was terminated shortly thereafter for trying to rob me.

23. In 1997, Applicant Fred Woodard tried to rob me in my home. Bobby Lee, a Devil's Disciples motorcycle club member, was at my home when Applicant Fred Woodard tried to rob me.

24. Bobby Lee witnessed when Applicant Fred Woodard tried to rob me in my home in 1997.

25. Trying to rob me was a violation of our club bylaws/rules and was an automatic kick-out from the club. Bobby Lee took

Applicant's DDMC Skeleton Mark patch from Applicant Fred Woodard for trying to rob me.

26. Applicant Fred Woodard was automatically terminated from the Devil's Disciples motorcycle club for trying to rob me and his membership was automatically revoked/terminated.

27. Applicant Fred Woodard has not paid club dues to the Devil's Disciples motorcycle club (DDMC) since his termination in 1997. Applicant Fred Woodard has not attended meetings since his termination in 1997.

28. The Devil's Disciples motorcycle club has never designated Applicant Fred Woodard to control the awarding and distribution of its DDMC Skeleton Mark patch. Applicant Fred Woodard has absolutely no rights in or the DDMC Skeleton Mark patch. Applicant Fred Woodard has absolutely no authorization to award, distribute or revoke the DDMC Skeleton Mark patch.

29. The Devil's Disciples motorcycle club would never grant rights or give control of its DDMC Skeleton Mark patch to someone who tried to rob a DDMC member.

10 TTABVUE 4-6. Johnson's testimony is corroborated by several members of Opposer's motorcycle club as well as Opposer's current President/Treasurer – all presented their testimony in declaration form. *See* Lee, Politano, Dulkan, Ryan, and Boyd Declarations. 10 TTABVUE 18-46. In addition, several members stated that Opposer's club has an "unwritten rule" regarding attendance at funerals of members and that they have not seen Applicant attend such events. Politano Decl. ¶¶13 and 22 (10 TTABVUE 26, 27); Dulkan Decl. ¶¶13 and 22 (10 TTABVUE 32, 33); Ryan Decl. ¶¶13 and 22 (10 TTABVUE 38, 39); Boyd Decl. ¶¶12 and 16 (10 TTABVUE 43, 44).

As with Opposer, Applicant presented his testimony via declaration. As illustrated below, his testimony contradicts Opposer's in certain key respects:

4. I have been a member of the Devil's Disciples Motorcycle Club (the "Club") since 1971.
5. I served as Club President from 2005 to 2010.
6. I am the oldest living active member the Club who has maintained a continuous active membership.
7. Because of my longstanding active Club membership, I am considered a Charter Member.
8. My Charter Member status confers me certain privileges and a great deal of authority. The Club members consider me the patriarch of the Club.
9. Because of my Charter Member status, I may attend meetings at any Club charter.
10. I have consistently attended Club meetings throughout my membership, except during the time when my membership was suspended from 1975 through 1991 while I was incarcerated.
11. The Club has granted me the authority to control the awarding and distribution of Club membership patches bearing the [design] mark that is the subject of the Application ("Applicant's Mark") to individuals who meet all Club membership requirements and are deemed qualified to become members of and represent the Club (individually and collectively, the "Membership Patch").
12. The Club has granted me the authority to revoke the Membership Patch from individuals who are no longer fit for Club membership.
13. Because the Club has granted me control over the awarding, distribution, and revocation of the Membership Patch, the Club has determined that I should be deemed the applicant for purposes of registration of Club trademarks, including Applicant's Mark.
14. In or around 2005, Joe Chase joined the Club.

15. In or around 2008, Mr. Chase's membership in the Club was revoked when he was kicked out of the Club for violating the Club Bylaws.

16. Per the Club Bylaws, Mr. Chase was required to return his Membership Patch upon revocation of his membership. Specifically, the Club Bylaws prescribe, "Member if leaving the club, needs to return all club property." The Membership Patch is considered Club property, not the property of the individual member. Attached hereto as Exhibit A [12 TTABVUE 8-11] is a true and correct copy of the Club Bylaws.

17. Mr. Chase did not return his Membership Patch to the Club.

18. After being kicked out of the Club, Mr. Chase went into hiding. While in hiding, Mr. Chase began duplicating the Membership Patch without authorization from the [sic] myself or the Club.

19. Mr. Chase began establishing an unauthorized Devil's Disciples Motorcycle Club (the "DDMC"), using the unauthorized duplicated Membership Patch.

20. To build membership in the DDMC, Mr. Chase recruited ex-members of the Club whose memberships had been revoked, and awarded them the unauthorized duplicated Membership Patch. Among the ex-members who joined the DDMC were Bobby Lee and John Wesley Johnson.

21. Mr. Johnson was an original member of the Club. In the early 1980s, however, Mr. Johnson left the Club and moved to Alaska. Mr. Johnson severed all ties with the Club while in Alaska. Mr. Johnson did not return to New Hampshire until in or around 2001.

22. Upon his return, Mr. Johnson joined the DDMC. Mr. Chase awarded Mr. Johnson the unauthorized duplicated Membership Patch.

23. The DDMC's and Mr. Chase's unauthorized duplication and use of the Membership Patch has led to significant confusion about which motorcycle club is the legitimate Devil's Disciples Motorcycle Club.

24. On behalf of the Club, I have taken several steps to stop the unauthorized use of Applicant's Mark. For example, on April 18, 2014 and December 4, 2015, I sent demand letters to the Malden, Massachusetts-based screen-printing and embroidery company Supersport USA on behalf of the Club via Saunders & Silverstein LLP. It had come to the Club's attention that Supersport USA was printing unauthorized duplicates of the Membership Patch for individuals who were not Club members. The letter dated April 18, 2014 demanded that Supersport USA only print the Membership Patch upon the request of myself or other Club members who were expressly authorized to place those orders. Because Supersport USA continued to print orders for non-Club members, the letter dated December 4, 2015 demanded that Supersport USA entirely cease printing the Membership Patch. Attached hereto as Exhibits B and C [12 TTABVUE 12-17] are true and correct copies of the letters to Supersport USA.

25. On December 4, 2015, I sent a demand letter [to] Charles Tringale and Mr. Johnson on behalf of the Club via Saunders & Silverstein LLP, demanding that they stop using Applicant's Mark in any way, including printing unauthorized duplicates of the Membership Patch. A true and correct copy of the letter to Mr. Tringale and Mr. Johnson is attached hereto as Exhibit D [12 TTABVUE 18-20].

26. The Club and I wanted to stop the unauthorized use of Applicant's Mark and duplication of the Membership Patch because we were concerned about the negative effect the DDMC and the unauthorized Membership Patch were having on the Club's reputation. We were afraid that such unauthorized use would cause individuals and other motorcycle clubs to question the Club's status as the original and legitimate Devil's Disciples Motorcycle Club. Similarly, we were afraid that that individuals and other motorcycle clubs would think that the DDMC was the legitimate Devil's Disciples Motorcycle Club, when that is not the case.

27. To further establish control over Applicant's Mark, the Club and I decided to apply to register Applicant's Mark with the United States Patent and Trademark Office. Because we had not yet been able to establish the Club as a legally organized entity, and because I have the authority to control the Membership Patch

bearing Applicant's Mark, the Club decided that I would be named as the Applicant.

28. The DDMC and other splinter groups calling themselves "Devil's Disciples Motorcycle Club" and using Applicant's Mark without authorization are harming the Club's reputation and causing confusion as to which is the original, legitimate club. That is why we filed the Application.

12 TTABVUE 2-6. His testimony is corroborated by Eric Ayre, President of the Mother Charter of the Devil Disciples Motorcycle Club. *See* Ayre Decl., 13 TTABVUE 2-4.

There is no written agreement between the parties covering the collective membership mark at issue. Instead, both parties presented dueling sets of bylaws authenticated by each of their respective witnesses. Johnson Decl. Ex. C ("DDMC 1% Bylaws") (10 TTABVUE 13-17); Woodard Decl. Ex. A ("DDMC Bylaws") (9 TTABVUE 8-11).

Based on the record before us, we find that Opposer has failed to meet its burden of proving by a preponderance of the record that Applicant did not own and "exercise legitimate control" over his applied-for collective membership mark as of the filing date of his application. We acknowledge that the record shows that the co-founder of Opposer's motorcycle club personally conceived of the inspiration for the design of Applicant's mark. However, in the face of conflicting statements made by each side regarding use and control of the mark over its members and the dueling sets of bylaws, it is difficult to assess the "parties' objective intentions or expectations." *See Lyons v. Am. Coll. of Veterinary Sports Med. & Rehab.*, 123 USPQ2d at 1028. The statements made

by Applicant in his testimony declaration that he, not Opposer, was authorized to control the applied-for collective membership mark, could certainly be challenged as self-serving. Opposer, however, elected not to cross-examine Applicant, making it difficult for the Board to assess the credibility of Applicant's statements. *Compare Tao Licensing, LLC v. Bender Consulting Ltd.*, 125 USPQ2d 1043, 1053 (TTAB 2017) (Board noted that cross-examination testimony regarding statements made in testimony declaration undermined witness' credibility.). In addition, had Opposer cross-examined Applicant and Mr. Ayre, it could have asked probing questions concerning the existence of more objective indicia of ownership such as costs incurred in printing membership patches, invoices documenting such costs, or revenue (if any) realized from the sale of patches to members. Equally problematic, there is nothing in the record to suggest that the bylaws submitted by either party are publically available, making it difficult for the Board to ascertain which party the public associates the mark with and which party exercises control of the mark. The only evidence of public efforts to police the collective membership mark consist of the cease and desist letters sent by Applicant to an unrelated third-party and Opposer's witness Mr. Johnson in his capacity as an individual (along with another individual named Mr. Tringale whose testimony we do not have before us), evidence weighing in Applicant's favor.

In view thereof, we dismiss Opposer's ownership claim for failure to meet the requisite burden of proof.

V. Fraud Claim

Fraud in procuring a trademark registration occurs only when an applicant knowingly makes a false, material representation with the intent to deceive the USPTO. *In re Bose Corp.*, 580 F.3d 1240, 91 USPQ2d 1938, 1941 (Fed. Cir. 2009). Opposer's fraud claim is based on the premise that Applicant's statements in his application that he "is the owner of the collective membership mark sought to be registered; ... no other persons, except for the members, and, if applicable, concurrent users, have the right to use the mark in commerce... and that such willful false statements and the like may jeopardize the validity of the application or any registration resulting therefrom..." and that "applicant controls the use of the mark by the members as specified in the applicant's bylaws or other written provisions" are false. In light of our dismissal of Opposer's ownership claim, Opposer's fraud claim has been rendered moot.⁸

VI. Section 2(d) Claim

We direct our attention now to the remaining claim in this case, Opposer's Section 2(d) claim.

A. Priority

To prevail on a likelihood of confusion claim brought under Trademark Act Section 2(d), a party must first prove that it owns "a mark registered in the Patent and Trademark Office or a mark or trade name previously used in the

⁸ Even if we were to consider Opposer's fraud claim on the merits, it would be dismissed. Nothing in the record suggests that Applicant intended to deceive the USPTO.

United States ... and not abandoned” Trademark Act Section 2(d), 15 U.S.C. § 1052(d). Insofar as Opposer has not pleaded and proved ownership of a previously registered mark for similar services, priority is at issue. Thus the question before us is whether Opposer has proved ownership and prior common law use of its DDMC Skeleton Mark by a preponderance of the evidence before any date upon which Applicant may rely. *See Embarcadero Techs., Inc. v. RStudio, Inc.*, 105 USPQ2d 1825, 1834 (TTAB 2013) (citing *Hydro-Dynamics Inc. v. George Putnam & Co. Inc.*, 811 F.2d 1470, 1 USPQ2d 1772, 1773 (Fed. Cir. 1987)). Applicant in his brief has focused solely on the issue of priority to argue that Opposer has failed to meet its burden of proving its Section 2(d) claim. However, Applicant failed to present any evidence at trial to establish his alleged January 1966 date of first use of the applied-for mark as set forth in his application. *See* Trademark Rule 2.122(b)(2); 37 C.F.R. § 2.122(b)(2) (“The allegation in an application for registration, or in a registration, of a date of use is not evidence on behalf of the applicant or registrant; a date of use of a mark must be established by competent evidence.”). Applicant must therefore rely on his December 4, 2015 filing date as his constructive use date. *See Syngenta Crop Prot. Inc. v. Bio-Chek LLC*, 90 USPQ2d 1112, 1119 (TTAB 2009); *Levi Strauss & Co. v. R. Josephs Sportswear Inc.*, 36 USPQ2d 1328, 1332 (TTAB 1994) (an application filing date for a use-based application can establish constructive first use of a mark). Opposer must demonstrate ownership and use of its pleaded common law mark prior to this date. *See Giersch v. Scripps Networks*

Inc., 90 USPQ2d 1020, 1023 (TTAB 2009). *See also Otto Roth & Co. v. Universal Foods Corp.*, 640 F.2d 1317, 209 USPQ 40 (CCPA 1981).

As noted above in the discussion regarding standing, the record shows that Opposer's co-founder created an oil painting that became the inspiration for Opposer's collective membership mark; that certain members of Opposer's motorcycle club have been using the DDMC Skeleton Mark in the form of a patch worn on the back of a jacket continuously since 1964 to designate membership; that for the past 50 years, Opposer has spent time and money safeguarding the goodwill of the mark, and that the mark is not personal to any one member. As such, Opposer, through its testimony and documentary evidence, has established by a preponderance prior proprietary rights in its common law collective membership mark (i.e., the DDMC Skeleton Mark) well before Applicant's constructive date of first use.

B. Likelihood of Confusion

Having established priority, we are left with the issue of likelihood of confusion. We base our determination under Section 2(d) on an analysis of all of the probative evidence of record bearing on a likelihood of confusion. *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973) ("*du Pont*"). *See also, In re Majestic Distilling Co.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). Special considerations apply, however, with regard to the likelihood of confusion analysis of collective membership marks since neither goods nor services are involved. As explained in the seminal case on

this issue, *Carefirst of Md., Inc. v. FirstHealth of the Carolinas, Inc.*, 77 USPQ2d 1492, 1512-13 (TTAB 2005) (footnote and citation omitted):

Although the ultimate inquiry is the same, the analysis under Section 2(d) with respect to collective membership marks is somewhat different from that with respect to trademarks or service marks. The trademark or service mark analysis typically involves a determination of likelihood of confusion among purchasers or users as to the source of goods or services. However, a collective membership mark does not involve purchasers of goods or services. The sole purpose of a collective membership mark is to indicate membership in an organization. While goods and services may be provided by members of an organization, a collective membership mark, as used or displayed by the members of an organization, serves only to identify the fact that such members belong to the collective organization and to inform relevant persons of the members' association with the organization.

The Board further elaborated on the precise meaning of "relevant persons:"

The term "relevant persons," for purposes of a collective membership mark, would not consist of "purchasers," but rather those persons or groups of persons for whose benefit the membership mark is displayed.

Id. at 1513 (citation omitted). The "relevant persons" in this case are motorcycle enthusiasts who are likely to join or who are already members of a motorcycle club. Thus, the issue before us is whether such "relevant persons" are likely to believe that there is some connection between Opposer and Applicant. *See Leading Jewelers Guild Inc. v. LJOW Holdings LLC*, 82 USPQ2d 1901, 1905 (TTAB 2007). Here, Applicant's identification "[i]ndicating membership in a motorcycle club" is identical to the nature of Opposer's prior common law use of its collective membership mark. This weighs heavily in favor of finding a likelihood of confusion.

We turn now to our comparison of Applicant's applied-for mark and Opposer's common law mark, shown below, respectively:



In general, we evaluate “the similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression.” *Palm Bay Imps. Inc. v. Veuve Cliquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1691 (Fed. Cir. 2005) (quoting *du Pont*, 177 USPQ at 567). Our analysis cannot be predicated on dissection of the involved marks. *Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 110 USPQ2d 1157, 1161 (Fed. Cir. 2014). Rather, we are obliged to consider the marks in their entireties. *Id.* See also *In re Nat'l Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985); *Franklin Mint Corp. v. Master Mfg. Co.*, 667 F.2d 1005, 212 USPQ 233, 234 (CCPA 1981) (“It is axiomatic that a mark should not be dissected and considered piecemeal; rather, it must be considered as a whole in determining likelihood of confusion.”). However, there is nothing improper in stating that, for rational reasons, more or less weight has been

given to a particular feature of a mark, provided the ultimate conclusion rests on a consideration of the marks in their entireties. *In re Nat'l Data Corp.*, 224 USPQ at 751.

With this in mind, we find that overall, the marks are strikingly similar in appearance and commercial impression. Opposer's common law mark is comprised of a forward facing, stylized representation of a human skeleton wearing a motorcycle helmet atop a one-dimensional depiction of a motorcycle. Notably, motorcycle handlebars project upward out of each side of the helmet. In lieu of skeletal arms and legs, four stylized flames surround the skeleton with the word "Devil's" inside the upper left flame, "Disciples" inside the upper right flame, "M.C." inside the lower left flame and a question mark inside the lower right flame. Given its prominent location in the center, the dominant feature of Opposer's mark is this uniquely stylized human skeleton sitting astride a motorcycle. Applicant's proposed mark consists entirely of an identical depiction of the dominant element in Opposer's mark. The only distinction in Applicant's applied-for mark is the omission of the flames and wording. This slight difference fails to obviate overall visual similarity.⁹ In comparing design elements, "a side-by-side comparison is not the proper test since that is not the ordinary way that purchasers will be exposed to the marks in the commercial

⁹ We are obligated to compare Applicant's mark to Opposer's common law mark as Applicant's mark appears on the drawing page of the application. *See* Trademark Rule 2.52, 37 C.F.R. § 2.52 ("A drawing depicts the mark sought to be registered."). Nonetheless, we take note of the fact that the display of Applicant's mark on his specimen includes the same additional wording and designs found in Opposer's common law mark.

marketplace. Rather, it is the similarity of the overall impression engendered by the marks which must determine whether confusion as to source is likely.” *In re United Serv. Distribs., Inc.*, 229 USPQ 237, 239 (TTAB 1986). In addition, because Applicant has not claimed color as a feature of his applied-for design mark, if registered, he could use his mark with any color scheme, including one identical to that depicted in Opposer’s mark. *See In re Data Packaging Corp.*, 453 F.2d 1300, 172 USPQ 396, 397 (CCPA 1972). Thus in comparing the marks overall, what will be remembered is the skeleton figure atop a one-dimensional view of a motorcycle with handle bars projecting from helmet. This critical *du Pont* factor also weighs in favor of finding a likelihood of confusion.

In sum, the “relevant persons” are motorcycle enthusiasts who are likely to join or who are already members of a motorcycle club. Keeping in mind that where the collective membership indicators are identical, the degree of similarity between the marks necessary to support a determination that confusion is likely declines, *cf. Bridgestone Ams. Tire Operations, LLC v. Fed. Corp.*, 673 F.3d 1330, 102 USPQ2d 1061, 1064 (Fed. Cir. 2012), we find that the “relevant persons” are likely to believe that there is a connection between Applicant and Opposer. As such, Opposer has proved its Section 2(d) claim by a preponderance of the evidence.

Decision: The opposition is sustained on Opposer’s Section 2(d) claim. Opposer’s ownership claim is dismissed; accordingly, Opposer’s fraud claim is dismissed as moot.