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THIS DECISION IS NOT
CITABLE AS PRECEDENT
OF THE TTAB

June 22, 2004
GDH/gdh

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Asiana International Co., Ltd.

v.

Michael L. Devitt

Opposition No. 91121977 to application Serial No. 75785132
filed on September 20, 1999

Gregory P. Goonan and Kevin L. Wheeler of Musick, Peeler &
Garrett LLP for Asiana International Co., Ltd.

Michael L. Devitt, *pro se*.

Before Seeherman, Hohein and Chapman, Administrative Trademark
Judges.

Opinion by Hohein, Administrative Trademark Judge:

Michael L. Devitt has filed an application to register



the mark "DIRT MASTER" and design, as reproduced below,

for "bicycles; bicycle parts, namely, bicycle frames, handlebars, forks, stems, bicycle safety pads, [and] racing number plates."¹

Asiana International Co., Ltd. has opposed registration on the ground of priority of use and likelihood of confusion. In particular, opposer alleges that it "is the assignee of trademark rights in the mark **DIRT MASTER and Design** from Cycle Sciences, Inc. ('Cycle Sciences')" and "has purchased the business and assets of Cycle Sciences"; that opposer "is the owner of the common law trademark **DIRT MASTER and Design** for use in connection with bicycles, bicycle frames, bicycle handlebars, and other bicycle parts"; that opposer "is the owner of U.S. Application No. 75808273 for the **DIRT MASTER and Design** trademark for use in connection with bicycles; bicycle frames; bicycle parts, namely wheels, brakes, chains, handlebars, and saddles; [and] bicycle accessories, namely bicycle pumps, bicycle racks for vehicles, and saddle covers for bicycles"; that opposer's "common law trademark has acquired extensive fame and notoriety in the United States"; that opposer "has used the mark **DIRT MASTER and Design** since December 1, 1997 in connection with the sale of bicycles, bicycle parts, and bicycle accessories"; that such use "has been valid and continuous"; that applicant's "actual date of first use" of his mark "is a date after December 1, 1997" rather than the date of September 11, 1973 which applicant alleges in his opposed application; and that applicant's mark "so resembles Opposer's mark as to cause confusion, mistake, and deception."

¹ Ser. No. 75785132, filed on September 20, 1999, which alleges a date of first use anywhere and in commerce of September 11, 1973. The word

As additional grounds for opposition, opposer alleges fraud and abandonment in that applicant's mark "was applied for in bad faith with knowledge of Opposer's prior and superior rights"; that applicant "knew he did not own any rights in or to the mark for which he seeks registration, but, nevertheless alleged ownership of the mark and swore that no one else had the right to use the same or similar mark in commerce"; that while applicant "swore that his date of first use of the mark was in 1973, ... Applicant knew he had ceased use and abandoned the mark several times since 1973 and that his actual date of first use of the mark was after December 1, 1997"; and that applicant "has abandoned his rights in the **DIRT MASTER and Design** trademark" in that applicant "has ceased using the mark and acted in a manner demonstrating an intent not to resume use."

Applicant, in his answer, has denied the allegations set forth in the notice of opposition.

The record consists of the pleadings; the file of the opposed application; and, as opposer's case-in-chief, the testimony of applicant, Michael L. Devitt, and a notice of reliance on applicant's answers to opposer's first set of interrogatories, applicant's answers to opposer's first set of requests for admissions, and certain documents consisting of copies of a manual or book and various magazines on the subject of bicycle motocross ("BMX").² Applicant, however, did not

"DIRT" is disclaimed.

² Opposer, with its notice of reliance, also submitted and seeks to rely on the documents produced by applicant in response to opposer's first set of requests for production of documents and the declaration,

introduce any evidence at trial in his behalf. Only opposer submitted a brief and neither party requested an oral hearing.

According to the record, in 1973 applicant began using the mark "DIRT MASTER" and design in connection with bicycle parts and accessories while working as a sole proprietorship under the name of Devco Distribution, Co. Since that time, applicant's business under his mark has evolved into a part of the BMX portion of the bicycle industry. Applicant has continued making and selling bicycle parts and accessories under such mark, either as a sole proprietorship or while also employed by various companies in the bicycle field. Those firms have included SE Racing, a company which he and one of his sons restarted in 1989 and, two years later, changed the name thereof to Sports Engineering, Inc. ("Sports Engineering"). Approximately two

with an attached document entitled "ASSIGNMENT OF ALL ASSETS," of Shin Peng Lee. It is pointed out, however, that under Trademark Rule 2.120(j)(3)(ii), "[a] party which has obtained documents from another party under Rule 34 of the Federal Rules of Civil Procedure may not make the documents of record by notice of reliance alone, except to the extent that they are admissible by notice of reliance under the provisions of §2.122(e)." Since the exception provided by the latter pertains, in pertinent part, only to the introduction by notice of reliance of "[p]rinted publications, such as books and periodicals, [which are] available to the general public in libraries or of general circulation among members of the public or that segment of the public which is relevant under an issue in a proceeding," materials such as invoices and advertising literature are not proper subject matter for a notice of reliance and therefore do not form part of the record herein. As to the declaration, which seeks to authenticate the document attached thereto, the admissibility thereof is governed by Trademark Rule 2.123(b), which specifies in relevant part that, "[b]y written agreement of the parties, the testimony of any witness or witnesses of any party, may be submitted in the form of an affidavit [or declaration] by such witness or witnesses." Inasmuch as such evidence is not proper subject matter for introduction by means of a notice of reliance, it forms no part of the record herein. We hasten to add, however, that even if the evidence which is not properly of record herein were to be considered, the result in this proceeding would be the same since, for instance, such evidence does not serve to establish opposer's standing or its priority.

years later, Chinese investors from Taiwan bought out the original investors in such company and acquired a majority stock ownership interest therein, with applicant retaining a minority stock ownership interest (which was without any financial control). Shortly thereafter, which was around 1994, such investors formed a new company called Cycle Science, Inc. ("Cycle Science"), with applicant retaining a minority stock ownership interest therein and acting as product development manager, shop manager and general manager.³ Applicant continued in such capacity until the fall of 1999, when the majority ownership investors informed him that they were selling Cycle Science and that, since his services were no longer needed, his employment was terminated as of September 1999.

While applicant, after his employment was terminated, associated himself with another bicycle industry veteran and attempted to purchase Cycle Science, such offer was refused. Applicant, however, also made an offer to purchase the existing shop equipment from Cycle Science, which offer was accepted. Thereafter, from about January 2000, applicant operated as a sole proprietorship under the name "Dirt Master" until, in May 2001, he incorporated his business, which according to his testimony is currently known as Alliant Bicycle Co., Inc. Applicant consequently denies that all of the assets of Cycle Science were purchased by opposer, Asiana International Co., Ltd. and further

³ In addition, at one time applicant served as a vice president of such corporation and, at another time, served as its secretary.

denies that the assets which opposer did purchase from Cycle Science included rights to the "DIRT MASTER" mark.

Applicant created the "DIRT MASTER" mark with the intent of developing a mark which conveyed the idea of dirt being fun in the sense that the mark was to be used on a product that allows the user thereof to be a master of the dirt. Applicant first used such mark in 1973 in connection with bicycle handlebars, grips, number plates, stems, apparel items, fenders and safety pads, and expanded use thereof to bicycle forks in 1974 and bicycle frames in 1975. Applicant has promoted the mark by sponsoring riders at bicycle competitions and through some magazine advertising and displays at trade shows. Applicant, beginning in 2000, has also used the mark in connection with services which he offers to schools and school districts and which feature performances by professional bicycle riders that encourage a clean and drug-free lifestyle. Applicant uses and has used the "DIRT MASTER" and design mark by applying it to stickers affixed to his goods and, in some instances, has packaged his products in bags with header cards bearing the mark.

Customers for applicant's "DIRT MASTER" products are independent bicycle retailers, although the end users of his goods are kids who like to ride bicycles. Originally, applicant sold his products from a van to bike shops in Los Angeles County and areas of California north thereof, while another person, who later lost interest after a couple of years, sold applicant's goods in a territory ranging from Orange County and areas of California south thereof to Arizona and southern Nevada,

including Las Vegas. At present, however, applicant sells his goods only by telephone. During the first few years in which he sold his "DIRT MASTER" bicycle parts, applicant spent around \$5,000 a year to advertise or otherwise promote his goods.

Thereafter, he spent very little on advertising and promoting such products until the years 2000 and 2001, in which he spent approximately \$20,000 annually on advertising and promotion.

Gross sales of such products during those years have been in the range of approximately \$20,000 to \$30,000 per year. Although previous sales have varied from "very strong" (i.e., in the range of thousands of units of handlebars, number plates and safety pad sets) in the first several years to between hundreds of units in some years⁴ and almost nothing in others,⁵ applicant maintains

⁴ Among other things, applicant's sales declined, beginning in the late 1970s, to hundreds of units of BMX products annually as he also became involved in skateboard activities. Nonetheless, because he maintained a machine shop in his garage, he was able to manufacture BMX products according to the demand therefor. Applicant, in particular, testified that during the time in the 1980s and 1990s that he was involved with SE Racing (which, as noted earlier, became Sports Engineering), "the Dirtmaster stuff was kind of like my personal thing out of the garage" since, as to the BMX products he made, "it was just ... [a] few dealers that wanted that stuff" and no one at SE Racing objected to his selling such goods as a sideline. (Devitt dep. at 24.)

⁵ In particular, with respect to the period from 1989 to 1994, Mr. Devitt testified as to his sales of "DIRT MASTER" goods as follows:

Q. Just out of [goods you made in] the garage?

A. Yeah. And to be honest with you, there may be a year or two when nothing happened, because it was purely when the mood would strike me when I would make this stuff in the garage. And whenever I would make any of that stuff, I always had a few people who would buy it. But it wasn't like I was aggressively producing Dirtmaster to compete with the stuff we were making at Sports Engineering.

Q. Would it be accurate to say that maybe from '89 to '94 there really wasn't much Dirtmaster stuff going on because you were involved in Sports Engineering?

that he has never stopped using the "DIRT MASTER" mark and, in particular, denies that he did not use such mark from December 1994 to December 1997. (Devitt dep.⁶ at 15.)

Applicant concedes, nonetheless, that from 1997 until 1999, he permitted Cycle Science to use his "DIRT MASTER" and design mark on a temporary basis in connection with the manufacturing and marketing of a line of bicycles. Specifically, applicant admits that during that three-year period, Cycle Science, with his permission, sold BMX goods under such mark and used the mark in its brochures and other literature. As evidence of his grant of permission to use the mark, applicant insists that, while not transferring ownership thereof to Cycle Science, he drafted and executed, on or about July of 1998, what he refers to as a "licensee agreement," which is entitled "Assignment of Logo Useage"⁷ [sic] and provides in relevant part as follows:

I, Michael L. Devitt, ... [d]o hereby grant ... "Non-Exclusive" rights to the use of the "Dirtmaster" logo and image designed, owned and used by myself for apparel and bicycle parts and accessories, commencing in 1973. Said image and logo will be used by Cycle

A. There was not as much, yeah.

(Id. at 33.)

⁶ The deposition repeatedly refers to the subject mark as "Dirtmaster."

⁷ Specifically, with respect to such document, applicant testified that:

Q. Do you know if it was a license or an assignment?

A. It was a license agreement ... --I drafted it personally.

(Id. at 72.)

Science Inc. for the purpose of manufacturing and marketing a line of bicycles for the retail dealer trade.

This "Non-Exclusive" right will be granted for a period of one (1) year with automatic one (1) year renewals, except for the following:

- The Dirtmaster logo shall revert back to Devitt (myself) upon any change in ownership[,] dissolution of the corporation, or my separation or removal from the corporation for any reason.
- All rights to this logo are to be inherited by my sons, Robert and Matthew Devitt[,] upon my death. Any consideration received for said logo and image use after my death is also to be paid directly to them.

Because, as noted previously, applicant was terminated by Cycle Science in September 1999, the right of Cycle Science to use applicant's mark terminated, according to applicant, either in September 1999 or, as applicant also testified, by the end of December 1999. Applicant, in view thereof, orally informed the board of directors of Cycle Science that such company could no longer use the mark and that he would be using it for his own business in a manner consistent with how he had been using it since 1973. Among other things, he emphatically testified that:

Q. After you got your [discharge] notice [from Cycle Science] did you tell them, "I'm taking my stuff with me"? "Taking my Dirtmaster mark, I'm taking these other marks"--

A. Absolutely--no, the other marks I didn't. They weren't mine. They belonged to Cycle Science.

Q. So you told them you were taking the Dirtmaster mark.

A. No question about it.

(Id. at 62.)

However, during the time he was employed at Cycle Science, applicant "was really responsible for all of the manufacturing, a heck of a lot of the marketing decisions, and virtually all of the product development and design." (Id. at 46.) According to applicant, Cycle Science "was such a small company that everybody wore multiple different hats." (Id. at 49.) But, when specifically asked during his deposition whether he had transferred his rights in the "DIRT MASTER" mark to Cycle Science, his answer was a categorical denial:

Q. At some point you transferred your rights to the Dirtmaster mark to Cycle Science.

A. That never happened.

(Id. at 41.) Instead, according to applicant, the only marks that were transferred to Cycle Science were six or seven other marks, including "SE RACING," "LANDING GEAR," "PK RIPPER," "QUADANGLE," "TEAM PRODUCTS" and "FLOVAL FLYER" but not including "DIRT MASTER," which were transferred from Sports Engineering. In particular, he adamantly testified with respect thereto that:

Q. Who created the other trademarks, the SE Racing, Landing Gear?

A. Me.

Q. All these other ones?

A. Myself and Scot [Breithaupt at Sports Engineering].

Q. Were there licenses for these marks that you gave to Cycle Science?

A. No. No. They were the property of Sports Engineering, Inc., and they became the property of Cycle Science when they took over everything from Sports Engineering, Inc.

Q. Why didn't Dirtmaster do the same thing? Why --

A. It was never part of Sports Engineering from the get-go. It was never part of SE Racing. It was a totally separate entity. It had nothing to do with it.

(Id. at 51-52.) Nevertheless, Cycle Science was permitted by applicant to use the "DIRT MASTER" mark, as noted previously, "when we decided to build this hard-core off-road product line."

(Id. at 45.) Specifically, "around ... mid- to late '97," Cycle Science decided "to create a product line that would be hard-core dirt jumping, street-thrashing bikes" and that such line "would be Dirtmaster bikes." (Id.)

As to the marks acquired by Cycle Science from Sports Engineering, applicant indicated that, sometime in 1997, the majority stockholders in Cycle Science "knew that some of the trademarks were vulnerable, because they weren't formally registered," and that, as to "a couple of them" that had been registered, "the time was going to expire." (Id. at 52.) With respect thereto, applicant further stated that:

And I found out about them hiring this [patent attorney] guy and doing this after the fact, when they had already done it. And ultimately there was some glitches, and they asked me about it and had me contact this attorney who was really--just a worthless pea brain as a patent attorney, to tell you the truth. But I had to really jack him up to get him to do the work and get it done in a timely fashion and do all that stuff.

I can't remember his name right now, but that involved the marks SE Racing, PK Ripper, Landing Gear, [and] I believe Quadangle were the marks that they instituted the action to get that taken care of.

It happened without any consultation with me of any kind And then because the guy was dragging his feet, I had to build a fire under him to get it done, blah-blah-blah.

So ... I got to believe if they thought they owned that [Dirtmaster] mark or whatever, that they would have certainly done the same thing with that mark, and they didn't.

(Id. at 52-53.) As to why applicant had not previously sought to register the mark which is the subject of this proceeding, applicant specifically testified that:

Q. Why didn't you trademark the Dirtmaster mark at any time?

A. I didn't need to.

Q. Why not?

A. Why? It was never challenged. Nobody ever gave me a hard time about it. I had used it since 1973.

(Id. at 53.)

Although applicant also testified that during the time he worked at Cycle Science "I never did not make bike parts out of my garage" (id. at 46) since "I still had a lathe and a mill in my garage" (id. at 47) with which to produce such goods, he added that the parts he made consisted of just "a few handlebars" and "a few forks," with "a few" being a "[v]ery small number" (e.g., "[p]robably 20, 30 forks"). (Id.) While applicant sold

some of those goods and gave away others, he further testified as follows:

Q. Were they Dirtmaster stuff or just your stuff?

A. Just my stuff. They didn't have a Dirtmaster label on them, as I recall.

Q. [In] 1997, Cycle Science starts using Dirtmaster. That was the first time Dirtmaster had been used for maybe three to five years?

A. That's conceivable. I can't verify that.

(Id.) Applicant also testified, with respect thereto, that:

Q. You said before you were always making stuff out of your garage. Were you making Dirtmaster product out of the garage during the time that Cycle Science was using the Dirtmaster mark?

A. No.

Q. So from '97 until at least Cycle Science--

A. Stopped.

Q. --stopped, you weren't making Dirtmaster stuff.

A. No. No. We were making it at Cycle Science.

Q. At Cycle Science.

A. Yeah.

(Id. at 60-61.)

According to applicant, the first products which Cycle Science made with the "DIRT MASTER" and design mark attached thereto "were probably frames and forks." (Id. at 48.) In any event, while produced by Cycle Science, the product which it sold

with the "DIRT MASTER" and design mark thereon was essentially "100 percent" the design or invention of applicant. (Id. at 60.) Applicant received no royalties from Cycle Science for the use of such mark, however, testifying that:

Q. So you said earlier that you provided Cycle Science with a nonexclusive license. Did they compensate you in any way for that?

A. No. I didn't want anything for that. We were ... going to make Dirtmaster stuff, and I was thrilled to death to do it.

(Id. at 54.) Nonetheless, there is no indication in the record as to the volume of sales by Cycle Science of "DIRT MASTER" bicycles and bicycle parts during the years from 1997 to 1999 and, according to applicant, it only advertised such products once in that period of time and did not otherwise promote the mark. Such lack of advertising and promotion, in applicant's opinion, was the principal reason for the ultimate failure by Cycle Science to achieve marketplace success in the bicycle industry and its business decision to discharge its employees, including applicant.

Moreover, when specifically asked as to whether Cycle Science was subsequently bought out by opposer, applicant stated initially that the buyers thereof were the individual Chinese investors in Cycle Science, testifying as follows:

Q. Who bought out Cycle Science? Who purchased at least the assets of Cycle Science?

A. You'll have to ask the Chinese. It's ... the Lees. Elsa Huang is Michael Lee's wife. Asiana International is her

little trading company that she has next door to their house in Feng Yeng

(Id. at 61.) When particularly asked, however, about opposer and an unspecified document, which presumably mentions opposer even though the document was never identified and introduced as an exhibit to the deposition, applicant further testified that:

Q. Is it fair to say that the entity that bought out Cycle Science is Asiana?

A. I don't know. And I'm being 100 percent candid about that. It says Asiana, but how do I know? What documentation is there? What kind of anything is there? I don't know.

Q. For the purpose of these--

A. I don't know whether it's Sunrise. I don't know whether it's the Lee family. I don't know if it's Elsa Huang. I don't know if it's Asiana International Limited. I don't have a clue.

(Id. at 66.)

In addition, while no purchase agreement or other document purporting to transfer any ownership interest in the mark "DIRT MASTER" from Cycle Science to opposer was ever properly made of record, applicant testified as follows that he had no knowledge with respect thereto:

Q. The purchase of Cycle Science assets, the document that is the actual purchase agreement, carves out the Dirtmaster mark, is that correct, as to your knowledge?

A. To my knowledge, I never saw a document that--you're saying the purchase of Cycle Science of--excuse me. Rephrase the question. What was it? I missed it.

Q. The purchase of Cycle Science assets--

A. By?

Q. Asiana, who we're referring to right now.

A. That document I have never seen.

(Id. at 69-70.) However, while acknowledging that ownership of the "DIRT MASTER" mark is disputed, applicant maintains that he is the only person presently using such mark in the bicycle industry:

Q. At some point you mentioned that there was a dispute between yourself and someone else concerning the Dirtmaster mark and who owned it. Who was the someone else that your dispute--

A. That would have been Elsa Huang or the other stockholders who were always represented by Elsa.

Q. And did you request that any purchase of Cycle Science's assets explicitly exclude the Dirtmaster mark?

A. No. To my knowledge, no.

Q. These are tough questions. Do you know if anyone else is using the Dirtmaster mark today, other than yourself?

A. Not in the bicycle industry.

....

Q. Do you know if Asiana is using the Dirtmaster mark?

A. To my knowledge, no.

(Id. at 70-71.) Applicant's current use of the "DIRT MASTER" mark is in connection with "[c]omplete bicycles, bicycle frames, bicycle forks, [and] apparel items." (Id. at 74.)

Turning first to the issue of abandonment (since opposer devotes almost all of its brief thereto), opposer maintains that, as to "the mark 'Dirtmaster and Design' (the 'Subject Mark')" which applicant seeks to register "for use in connection with bicycles and bicycle parts," "it is Opposer, not Applicant, who owns all right, title and interest in and to the Subject Mark and has priority with respect to the Subject Mark." Opposer, in particular, asserts in its brief that, according to the record:

Applicant used the term "Dirtmaster" in connection with the sale of bicycle parts on an intermittent and sporadic basis from 1973 through 1989. The evidence in this case shows that Applicant stopped using the Dirtmaster term altogether in 1989. Thereafter, in 1994, Applicant became employed by a company called Cycle Science On or about December 1, 1997, the Cycle Science corporate entity began using the Dirtmaster mark in connection with the offer for sale and sale of [bicycle] products On October 1, 1999, Cycle Science--which on that date owned all rights to the Dirtmaster mark--assigned all right, title and interest in and to the Subject Mark to Opposer.

Applicant's employment with Cycle Science was terminated in early September 1999. [Subsequently,] ... Applicant in his individual name filed the application that is the subject of this proceeding However, as shown by the evidence, Applicant did not own any rights in or to the Subject Mark at the time he filed his application Instead, because of its exclusive and continuous use of the Subject Mark from and after December 1, 1997, Cycle Science owned all rights to the Subject Mark in September 1997. Those rights then were assigned to Opposer on October 1, 1999. Consequently, Opposer owns all right, title and interest to the Subject Mark and has priority with respect to such mark[.]

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Relying, further, upon Section 45 of the Trademark Act, 15 U.S.C. §1127, which in relevant part provides that "[n]onuse for three consecutive years shall be prima facie evidence of abandonment" of a mark, and insisting that "[h]ere, Applicant's own testimony establishes that he did not use the Subject Mark for a period of five years, from 1989 through 1994" (underlining in original), and that "[i]n fact, it was not until 1997 when the Subject Mark was used again--but by Cycle Science, not Applicant," opposer "submits [that] the only conclusion possible on the evidence here is that Applicant long ago abandoned any rights he may have had individually to the Subject Mark."

Contrary, however, to opposer's contentions, it has not only failed to demonstrate a prima facie case of abandonment of the "DIRT MASTER" and design mark by applicant, but it has failed to establish its standing to bring this opposition on any ground, including abandonment. As to the former, it is settled that "[a]bandonment, being in the nature of a forfeiture, must be strictly proved." *Wallpaper Manufacturers, Ltd. v. Crown Wallcovering Corp.*, 680 F.2d 755, 214 USPQ 327, 332 (CCPA 1982). Moreover, with respect to use of a mark, "[t]here is ... no rule of law that the owner of a trademark must reach a particular level of success, measured either by the size of the market or by its own level of sales, to avoid abandoning a mark." *Person's Co. Ltd. v. Christman*, 900 F.2d 1565, 14 USPQ2d 1477, 1481 (Fed. Cir. 1990) [intermittent sales and small inventory do not necessarily imply abandonment]. Here, applicant's uncontroverted testimony is that he has continuously used the mark "DIRT

MASTER," including the logo form of the mark, i.e., "DIRT MASTER" and design which he seeks to register, in connection with BMX bicycle products which he made and sold from 1973 until sometime in 1994 when he began his employment with Cycle Science. Applicant, moreover, did not testify, as asserted by opposer, that he had ceased use of such mark during the period from 1989 until sometime in 1994 when he worked at first SE Racing and then at Sports Engineering; rather, his testimony was that he simply had fewer sales of "DIRT MASTER" bicycle products than he had been doing previously ("[t]here was not as much, yeah"). (Id. at 33.)

As to the three-year period spanning the years from December 1994 to before the commencement of use by Cycle Science of the "DIRT MASTER" mark in December 1997, applicant has specifically denied that he did not use such mark during that time frame.⁸ Moreover, his admission that he was not personally making and selling bicycle products under the "DIRT MASTER" mark was solely as to the time, beginning in late 1997, that Cycle Science was using such mark. The record is clear, however, that the use of the "DIRT MASTER" mark by Cycle Science was with applicant's express permission and, as of about July of 1998, was pursuant to a non-exclusive, annually renewable and royalty-free

⁸ While it is noted that, as indicated earlier, applicant testified that it was "conceivable" (id. at 47) that the mark had not been used for three to five years prior to the first use thereof by Cycle Science, it is clear from his further testimony that he simply does not have any documentation which could corroborate whether he was or was not using the mark during such time frame even though he maintains that he did not cease use thereof.

license from applicant to Cycle Science covering the use of the "DIRT MASTER" and design mark in connection with, *inter alia*, bicycle parts and accessories and the manufacturing and marketing of a line of bicycles for the retail dealer trade.

In view thereof, and inasmuch as there is nothing which indicates that applicant failed to maintain control over the nature and quality of the goods produced and sold by Cycle Science under the "DIRT MASTER" mark and logo, it is plain that the use by Cycle Science inured to the benefit of applicant in his individual capacity. See Section 5 of the Trademark Act, 15 U.S.C. §1055. Indeed, according to applicant, he was the one at Cycle Science who "was really responsible for all of the manufacturing, a heck of a lot of the marketing decisions, and virtually all of the product development and design" (*id.* at 46) concerning Cycle Science's use of the "DIRT MASTER" mark and logo. There simply is no proof of a three-year period of nonuse of such mark and logo by applicant and, thus, opposer has failed to demonstrate a case of *prima facie* abandonment by applicant.⁹ See Section 45 of the Trademark Act, 15 U.S.C. §1127; and *Stockpot, Inc. v. Stock Pot Restaurant, Inc.*, 220 USPQ 52, 59 (TTAB 1983) ["the inference of abandonment is not drawn ... [where] satisfactory quality was maintained, and, hence, no deception of purchasers occurred"], *aff'd*, *Stock Pot Restaurant*,

⁹ Even if, however, there had been proof of nonuse of the mark by applicant for a three-year period prior to the resumption of use thereof by Cycle Science in December 1997, such use by Cycle Science inured to applicant's benefit, as noted above, and is prior to any alleged succession by opposer to any asserted rights in the mark by Cycle Science.

Inc. v. Stockpot, Inc., 737 F.2d 1576, 222 USPQ 665 (Fed. Cir. 1984).

Furthermore, even if a case of prima facie abandonment had been shown, opposer would still not be entitled to relief on such ground, or on any of the other pleaded grounds for opposition, inasmuch as it has not shown a direct commercial or other real interest that it believes will be damaged by the registration which applicant seeks and, thus, has failed to establish its standing to bring this proceeding. See, e.g., Cunningham v. Laser Golf Corp., 222 F.3d 943, 55 USPQ2d 1842, 1844 (Fed. Cir. 2000); and Young v. AGB Corp., 152 F.3d 1377, 47 USPQ2d 1752, 1754-55 (Fed. Cir. 1998). In particular, there is a failure of proof that opposer, as alleged in the notice of opposition, succeeded to any interest which Cycle Science may have had in the "DIRT MASTER" mark. That is, contrary to the argument in its brief, opposer has failed to establish by a preponderance of the evidence that Cycle Science had any rights in the "DIRT MASTER" mark, either as the owner and/or user thereof, which were subsequently acquired by opposer on or about October 1, 1999 and continued to subsist. Instead, the record shows that, by either September 1999 or no later than December 1999, the right to use such mark by Cycle Science had reverted, pursuant to the license agreement with applicant, back to applicant following the termination of his employment with Cycle Science in September 1999. Furthermore, aside from the fact that opposer failed to properly make of record a purported assignment,

as of October 1, 1999, from Cycle Science to opposer of the former's alleged ownership of the "DIRT MASTER" mark, it is pointed out that even if such an assignment had been properly introduced, the record is clear that at all relevant times since 1973, ownership of such mark has been by applicant rather than SE Racing, Sports Engineering or Cycle Science.

Specifically, the record is plain that applicant never transferred his ownership of the "DIRT MASTER" mark, including the logo form thereof, to Cycle Science ("[t]hat never happened" (id. at 41), according to applicant's testimony); that applicant only licensed the use thereof to Cycle Science; and that, upon the termination of his employment with such company in September 1999, the use of the "DIRT MASTER" mark reverted back to applicant as the owner thereof. Furthermore, the record reveals that SE Racing, which later became Sports Engineering, had no ownership rights therein which were transferred to Cycle Science upon the formation of Cycle Science in 1994; that applicant does not know who purchased any assets (other than shop equipment, which he and another bicycle industry veteran bought) of Cycle Science; and that applicant in any event denies that any assets which opposer may have purchased from Cycle Science included rights to the "DIRT MASTER" mark. Thus, opposer has failed to establish its standing to bring this proceeding on any ground, including abandonment.

In view thereof, it is obvious that opposer has also failed to demonstrate its asserted priority of use of the "DIRT MASTER" and design mark and thus the ground of priority of use

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and likelihood of confusion with applicant's mark cannot succeed. Finally, as to the ground of fraud, there is no proof whatsoever that applicant, in connection with his involved application, made a knowingly false claim to be the owner of the "DIRT MASTER" and design mark or should have known that his claim of ownership thereof was false. Instead, as indicated previously, the record establishes that at all relevant times, applicant has in fact been the owner of the "DIRT MASTER" and design mark with respect to bicycles and bicycle parts, namely, frames, handlebars, forks, stems, safety pads and racing number plates.

Decision: The opposition is dismissed.