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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Robert Kaufhold
v.
Robert P. Yeomans

Opposition No. 91160771
to application Serial No. 78148652

Jeffrey I.D. Lewis of Patterson Belknap Webb & Tyler LLP for Robert Kaufhold.

Robert P. Yeomans, pro se.

Before Seeherman, Rogers and Drost, Administrative Trademark Judges.

Opinion by Drost, Administrative Trademark Judge:

On July 30, 2002, Robert P. Yeomans (applicant) applied to register the mark THE UNDEAD in typed or standard character form on the Principal Register for "entertainment namely, live performances by a musical band" in Class 41. The application contains allegations of a date of first use anywhere of May 19, 1976, and a date of first use in commerce of July 4, 1977.

On May 26, 2004, opposer Robert Kaufhold, who also is known by his stage name of Bobby Steele, filed a notice of

opposition. Opposer alleges that he "has since December 1980 used in the United States the mark 'THE UNDEAD' to provide entertainment services in the nature of musical performances. Opposer has continually and substantially used the mark 'THE UNDEAD' throughout the United States and the world in identical form until the present time" and that "Applicant did not first use the mark 'THE UNDEAD' in commerce until after Opposer's first use of the mark in December 1980." Notice of Opposition at 2. Opposer goes on to assert that applicant's "alleged 'THE UNDEAD' mark and Applicant's use of the mark are sufficiently similar to the Opposer's mark and use of the mark so as to cause confusion, to cause mistake or to deceive the public as to the origin of Applicant's services bearing that mark." Notice of Opposition at 3.

Applicant has denied the salient allegations of the notice of opposition. Applicant's answer was the last paper applicant filed in this proceeding.

The Record

The record consists of the pleadings; the file of the involved application; and the testimony deposition, with exhibits, of opposer.[1]

[1] Opposer also submitted a notice of reliance on opposer's first set of interrogatories and his request for production of documents, to which he alleges applicant has not responded. On August 17, 2005, opposer's motion to compel discovery was denied as untimely. Failure to respond to interrogatories and document

Discussion

An opposer must have "a 'real interest' in the outcome of a proceeding in order to have standing." Ritchie v. Simpson, 170 F.3d 1092, 50 USPQ2d 1023, 1025 (Fed. Cir. 1999). "To establish a reasonable basis for a belief that one is damaged by the registration sought to be cancelled, a petition may assert a likelihood of confusion which is not wholly without merit." Lipton Industries v. Ralston Purina Co., 670 F.2d 1024, 213 USPQ 185, 189 (CCPA 1982).[2] In this case, opposer has alleged that he has used the same mark as applicant, THE UNDEAD, in association with musical performance services since prior to applicant's filing date. Therefore, opposer asserts a likelihood of confusion and he has standing to oppose the application. Intersat Corp. v. International Telecommunications Satellite Organization, 226 USPQ 154, 156 n.5 (TTAB 1985) (Opposer, "in its notice of opposition, has alleged a date of first use prior to the filing date of the involved application. Thus, [opposer] has alleged priority of use sufficient for purposes of pleading").

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production requests does not have the same evidentiary effect as failure to respond to requests for admissions, i.e., the interrogatory and/or document production request is not deemed "admitted" in the manner that a failure to respond to a request for admission is. Accordingly, these mere requests for discovery will not be treated as part of the record.

[2] Because of the linguistic and functional similarities of the opposition and cancellation provisions of the Lanham Act, "we construe the requirements of those two sections of the Lanham Act consistently." Ritchie, 50 USPQ2d at 1025 n. 2.

Opposer, as plaintiff in the opposition proceeding, has the burden of proving, by a preponderance of the evidence, his asserted grounds of priority and likelihood of confusion. See Cerveceria Centroamericana, S.A. v. Cerveceria India Inc., 892 F.2d 1021, 13 USPQ2d 1307, 1309 (Fed. Cir. 1989). See also Cunningham v. Laser Golf Corp., 222 F.3d 943, 55 USPQ2d 1842, 1848 (Fed. Cir. 2000).

In this case, the issue of whether there is a likelihood of confusion is relatively simple, and we will address this issue first. Applicant seeks to register the mark THE UNDEAD without any design or stylization for entertainment involving live performances by a musical band. In likelihood of confusion cases, we analyze the facts as they relate to the relevant factors set out in In re Majestic Distilling Co., 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). See also In re E. I. du Pont de Nemours & Co., 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973); and Recot, Inc. v. Becton, 214 F.3d 1322, 54 USPQ2d 1894, 1896 (Fed. Cir. 2000).

Opposer's evidence shows that he is also using the mark THE UNDEAD or UNDEAD on services involving live musical performances by a band. See Kaufhold dep. at 18 ("A. I was the one that started the band. Q. You chose the name The Undead? A. Right."). See also Kaufhold Ex. 4, *The Village Voice*, May 20-26, 1981 ("May 27 The UNDEAD" at Hotsville in

Passaic, NJ); *Philadelphia Inquirer*, June 19, 1981 Nightlife section ("OMNI's 907 Walnut St. 925-7799. Tonight the Undead"); *Intelligencer-Journal* (Lancaster, PA), August 4, 1989 ("And this rotten world is descending on Lancaster, as Steele and his punk band The Undead give an all-ages concert Sunday at the Chameleon Club").

We add that we must consider the services as they are identified in the application. Octocom Systems, Inc. v. Houston Computers Services Inc., 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990) ("The authority is legion that the question of registrability of an applicant's mark must be decided on the basis of the identification of goods set forth in the application regardless of what the record may reveal as to the particular nature of an applicant's goods [or services], the particular channels of trade or the class of purchasers to which the sales of goods [or services] are directed"). Here, the services are not simply legally identical, they appear to be actually identical because both applicant's and opposer's bands are punk rock bands. See Kaufhold dep. at 5 ("Q. What type of music do you play? A. Punk rock.") and 220 ("What's your understanding of the type of music that the applicant's Undead band plays? A. It's punk rock."). Therefore, inasmuch as both applicant and opposer are using the same mark (THE UNDEAD) on the same services (live musical performances by a band), there is no

question that there is a likelihood of confusion in this case.

Because there is a likelihood of confusion, the next critical question is which party has priority of use. Inasmuch as opposer is relying on his common law rights, we will look to the evidence to determine when he first used the mark in association with live musical performance services. Opposer alleges that he used the mark THE UNDEAD on entertainment services in the nature of musical performances since at least December 1980. According to opposer, he was a member of the band called "The Misfits" until "early October of 1980." Kaufhold dep. at 17. Opposer then formed a new band:

> A. I was the one who started the band.
>
> Q. You chose the name The Undead?
>
> A. Right.
>
> Q. And you came up with the name?
>
> A. I came up with the name.
>
> Q. And you played live shows under that name in the early '80s?
>
> A. We started playing live shows under that name in late January of '81.

Kaufhold dep. at 18.

Opposer explained that "we did it at a venue, it was called the A7 club. At the time, it was basically a little-known speakeasy." Kaufhold dep. at 19. The venue was in

New York City "on the corner of Avenue A and 7th Street." Kaufhold dep. at 20. Opposer's 1981 planner (Kaufhold Ex. 2) contains an entry for the A7 concert on January 30, 1981 (K00024, K00026). Opposer also submitted a flyer advertising that concert. Kaufhold Ex. 3 ("L.E.S.R.M.A.S. presents The Undead w/ Bobby Steele[3]… the A7 Club FRI JAN 30"). Opposer's evidence indicates his band ("The Undead") has continued to play concerts since that time. Among the venues the band played that first year are Knups in Bergen, New Jersey, on March 13, 1981 (Kaufhold dep. at 28; Kaufhold Ex. 2 (K00059)) and Omni's in Philadelphia, Pennsylvania on June 19, 1981. Kaufhold Ex. 4 (K00161).

Opposer's band has continued to play in numerous venues over the years. See, e.g., Kaufhold dep. at 111 (1985 - Anthrax Gallery in Connecticut); 122 (1988 – West Coast Tour, Washington D.C., Virginia Beach); 127 (1989 – "some East Coast tours, a Midwest tour, and another West Coast tour"); 134 (1991 - "we did an East Coast tour. And then, in the summertime, we embarked on a tour that was to cover almost the entire Midwest and the South); 147 (1993 – "We did touring mostly down in – up and down the East Coast in the U.S."); 155 (1997 – I did quite a few tours… the East Coast from New York down as far south as Tampa, Florida");

[3] As indicated earlier, opposer testified that "I also go by the stage name of Bobby Steele." Kaufhold dep. at 4.

165 (1999 – "… toured the West Coast from Portland, Oregon all the way down to San Diego"); 170 ("2001, was the year we finally were able to get a connection where we were able to tour Europe"); and 173 (2002 – "we did an East Coast tour"). See also Kaufhold Ex. 27 (*Intelligencer-Journal* (Lancaster, PA) – review of 1989 performance); Ex. 36 (*Hit List*, Nov/Dec 1999 (Review of performance in 1998); and Ex. 37 (Information on 2001 European tour).

Opposer's band has also made numerous recordings during this period. Beginning with "9 Toes Later," opposer indicated that his band, The Undead, released the following recordings over the years: "Verbal Abuse," "Never Say Die!," "Act Your Rage," "Dawn of the Undead," "Life Slayer," "Invisible Man," "Evening of Desire," "There's a Riot in Tompkins Square," and "To Death." Kaufhold dep. at 186-87; Kaufhold Ex. 39. One of opposer's songs, "Evening of Desire," was used in the movie "Welcome to the Dollhouse." Kaufhold dep. at 151.

We conclude that opposer has established a date of first use of January 30, 1981, when his band played at the A7 Club in New York City.[4]

[4] In this case, the mark THE UNDEAD is inherently distinctive and, therefore, opposer does not have to show that its mark has acquired distinctiveness. Towers v. Advent Software Inc., 913 F.2d 942, 16 USPQ2d 1039, 1041 (Fed. Cir. 1990) (A "party opposing registration of a trademark due to a likelihood of confusion with his own unregistered term cannot prevail unless he

Next, we must determine the priority date for applicant. "The dates of use alleged in applicant's applications are not evidence of such use, nor are applicant's specimens evidence on applicant's behalf." Baseball America Inc. v. Powerplay Sports Ltd., 71 USPQ2d 1844, 1847 n. 10 (TTAB 2004). Therefore, inasmuch as applicant has submitted no evidence, he is entitled to rely only on the filing date of his application as his constructive use date (July 30, 2002). Id. at 1847. Inasmuch as this date is substantially later than opposer's date of priority of January 30, 1981, we would normally conclude at this point that opposer has priority.

However, as a result of the evidence that opposer has submitted, we must determine if *opposer* has established an earlier priority date *for applicant*. Early in his deposition, opposer responded to several questions about applicant.

> Q. And, just briefly, do you know Robert Yeomans?
>
> A. Not personally, but I do currently know of him.
>
> Q. Okay. Do you know where he's based?
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> A. Currently, I understand he's based in Los Angeles. But, originally, he was in San Francisco.

Kaufhold dep. at 6.

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shows that his term is distinctive of his goods, whether inherently or through the acquisition of secondary meaning").

Despite his initial statement that indicated that he did not personally know applicant, opposer subsequently testified differently:

> Do you understand that he also goes by the name Sid Terror?
>
> A. Yes.
>
> Q. When did you first hear of the applicant?
>
> A. When I first heard of him was when we played with the Dead Kennedys. And after the show –
>
> Q. Let me just clarify that. That was sometime in mid-'81, late '81?
>
> A. Right, that was – yeah, that was mid-'81.
>
> Q. Okay.
>
> A. And after the show, we were hanging out with the Dead Kennedys in the dressing room, and we were kind of like, you know, just having a conversation. And Jello Biafra[5] just, like – just, like, mentioned that, you know – you know, there's a band – there's a band in San Francisco called The Undead. And did you know that?
>
> I was, like, no. He said, you know, I wouldn't expect you to, you know. And that was about the extent of it, was just, like, you know, there's this other band out there, you know.
>
> Q. So, before Jello Biafra told [you] about him, you hadn't heard of him?
>
> A. No.
>
> Q. So, were you surprised to learn that there was another punk – well, let me ask you a question.
>
> What's your understanding of the type of music that the applicant's Undead band plays?
>
> A. It's punk rock.

[5] Jello Biafra is the "lead singer of the Dead Kennedys." Kaufhold dep. at 65.

> Q. Okay. And were you surprised to learn in mid-1981 that there was another punk band named the Undead?
>
> A. I was a little surprised because I had been keeping -– you know, I felt that I had been keeping up on things, you know, keeping [up] on what bands were there. You know, I had been reading about the San Francisco scene. I had met other people from San Francisco.
>
> And I never heard anything about this until Jello had mentioned it to me. So, to me it was kind of a surprise that there was anybody. You know, I wouldn't have been surprised if I hadn't done – if I hadn't been so, like, involved in the scene and known so many of the bands.
>
> But I was just surprised that, like, that I hadn't heard of this band.

Kaufhold dep. at 220-21.

Opposer then went on to testify about additional contacts with applicant.

> Q. Have you ever met the applicant, Robert Yeomans?
>
> A. Yes.
>
> Q. When?
>
> A. In, I believe it was April of '82, we did a West Coast tour. And one of the shows we booked was in San Francisco at a club called The on Broadway. And I kind of thought it would be amusing, and through a mutual friend, contacted the applicant. And we arranged to have his band be the opening act for my band. So that we had a two-night run at The on Broadway. So, the second night, we would have his band be the opening act.
>
> And just because it would be – I thought it would be amusing to just see it, like, a marquee that said The Undead with The Undead. And I was also trying to rent a copy of the movie – the 1950s movie The Undead so the marquee could also say, plus special feature The Undead.
>
> Q. So you played two nights with applicant's Undead?
>
> A. No. We played one night with them…

> Q. And they opened for you?
>
> A. They opened for us…
>
> Q. Now, in this show you played along with applicant's Undead, were there any complaints from him?
>
> A. No.
>
> Q. Did you guys get along?
>
> A. We got along well. We were photographed together. There were numerous local, like, fanzines that were there that wanted to photograph us together. So, you know, we were quite entertained with ourselves the whole night just, you know, over the whole thing.

Kaufhold dep. at 237-40.

Opposer subsequently testified that he met applicant again in 1989 in a club but there was no discussion of applicant's band. Kaufhold dep. at 241. The only other contact was a "topic line" on opposer's website in 2002 apparently from applicant that said "Bobby Steele used his influence to steal The Undead name." Kaufhold dep. at 242.

The testimony that opposer and applicant played at least one concert together ("The Undead with The Undead") is certainly perplexing from a trademark perspective. However, we are unable to draw any conclusions that undermine opposer's claim of priority. We have already determined that opposer's priority date is January 30, 1981. Opposer's testimony that he was aware of applicant's band several months later and that he played a concert with applicant the following year does not prove that applicant had used his

mark before opposer's priority date of January 30, 1981.[6] Applicant has submitted no evidence, and the record does not support a finding, that applicant used the mark prior to opposer's priority date.[7] See, e.g., Corporate Document Services Inc. v. I.C.E.D. Management Inc., 48 USPQ2d 1477

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[6] Inasmuch as applicant has not participated in this case beyond his answer, no issues have been developed concerning applicant's and opposer's relationship more than twenty years ago. We do point out that even if there were an argument that opposer implicitly consented to applicant's use of his mark, under the facts of this case, this does not appear to be sufficient to avoid confusion. In re Opus One Inc., 60 USPQ2d 1812, 1821 n. 13 (TTAB 2001) (In a case involving the issue of whether a registrant impliedly consented to applicant's use and registration of its mark, the board held that "[w]e will not impute such a consent or agreement to registrant in the absence of explicit documentary evidence thereof. There is no indication in the record that applicant ever sought to obtain a consent or agreement from registrant…"). Also, opposer "was clearly under no duty to attack appellee's right to use the mark if it did not choose to do so, on penalty of being deprived of the right to oppose an application to register. It could not take the latter action, of course, until after [applicant] applied for registration and the application was published for the purpose of opposition." National Cable Television Association Inc. v. American Cinema Editors Inc., 937 F.2d 1572, 19 USPQ 1424, 1431 (Fed. Cir. 1991). We would be particularly reluctant in this case to read any acquiescence into opposer's actions inasmuch as the marks and services here are identical and applicant's application is geographically unrestricted. Reflange Inc. v. R-Con International, 17 USPQ2d 1125, 1131 (TTAB 1990) ("Even a well-taken defense of acquiescence would not preclude a judgment for plaintiff if it is determined that confusion is inevitable, and confusion between identical marks used for identical goods is inevitable").

[7] We add that we have no evidence of the extent of applicant's use of the mark. Because of this lack of evidence, we cannot conclude that there has been an extensive period of overlapping use where actual confusion could occur and did not. Compare In re General Motors Corp., 23 USPQ2d 1465, 1471 (TTAB 1992) ("The absence of any known incident of actual confusion in an extensive period of contemporaneous use of the marks is strong evidence that confusion is not likely to occur in the future"). Furthermore, opposer has alleged that there have been recent instances of actual confusion. Kaufhold Ex. at 48. In addition, the identical nature of the marks and services argues against a conclusion of no confusion even with contemporaneous use.

(TTAB 1998) (Applicant established use in Texas prior to opposer's use). Therefore, opposer has shown by the preponderance of the evidence that he has priority.

Furthermore, inasmuch as we have already concluded that confusion is likely when the same marks THE UNDEAD are both used on entertainment involving live musical performances by a band, and opposer has priority, opposer must prevail.

Decision: The opposition to the registration of application No. 78148652 is sustained.