

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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Robert J. Glovsky  
v.  
Richard A. Shaffer

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Cancellation No. 31,688

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Brett N. Dorny for Robert J. Glovsky.

Jerry Cohen for Richard A. Shaffer.

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Before Hanak, Walters and Chapman, Administrative Trademark Judges.

Opinion by Hanak, Administrative Trademark Judge:

Robert J. Glovsky (petitioner or Glovsky) seeks to cancel Registration No. 2,417,142 owned by Richard A. Shaffer (registrant or Shaffer). This registration, which issued on the Principal Register on January 2, 2001, is for the mark THE MONEY EXPERTS and it covers the following services: "entertainment services, namely, providing a radio program in the field of finance, investments and real estate issues."

In his petition for cancellation which was filed on February 9, 2001, petitioner Glovsky alleges that from September 1991 through June 1999, he and registrant Shaffer

together co-hosted a Boston radio show called THE MONEY EXPERTS. This show was initially carried by radio station WHDH, later by radio station WBNW and later still by radio station WRKO, all located in Boston. Continuing, Glovsky alleges that initially all rights to the name of the radio show (THE MONEY EXPERTS) were owned by WHDH and later WBNW. With regard to the final radio station (WRKO) which broadcasted this co-hosted program THE MONEY EXPERTS, Glovsky alleges that for the first time the co-hosts (himself and registrant Shaffer) "owned the title THE MONEY EXPERTS instead of the broadcasting radio station." (Petition paragraph 5). Glovsky further asserts that in June 1999 when WRKO dropped THE MONEY EXPERTS radio show, he and Shaffer also ended their relationship as "co-hosts." Glovsky further alleged that from July 1999 to December 2000, he actively pursued various radio stations in an attempt to get a new version of THE MONEY EXPERTS aired with himself as the sole host. In January 2001, Glovsky succeeded in having radio station WBIX agree to broadcast a show entitled THE MONEY EXPERT (singular) with Glovsky as the sole host. However, when his first solo radio show actually aired on WBIX on January 8, 2001, it was called THE BOB GLOVSKY SHOW, although during the course of this show Mr. Glovsky often referred to himself as "the former

co-host of THE MONEY EXPERTS radio program." (Petition paragraph 22). As specific grounds for cancellation, Glovsky alleges that Shaffer filed the trademark application which matured into Registration No. 2,417,142 listing Shaffer as the sole owner of the mark THE MONEY EXPERTS, when in point of fact Shaffer knew that petitioner Glovsky and possibly certain radio stations were co-owners of the mark THE MONEY EXPERTS.

In his answer, Shaffer denied the pertinent allegations of the petition. However, Shaffer conceded that he and Glovsky "co-hosted a Boston-based radio show called THE MONEY EXPERTS" commencing in 1991. (Answer paragraph 1).

The record in this case consists of the depositions with exhibits of petitioner Glovsky and registrant Shaffer. Both parties filed briefs. Neither party requested a hearing.

By way of background, it may be useful to review the file history of application Serial No. 75/753,218 which matured into Registration No. 2,417,142 which is the subject of this cancellation proceeding. The application was filed on July 16, 1999 as an intent-to-use application. In the first Office Action, the Examining Attorney refused registration on the basis that the mark THE MONEY EXPERTS

was merely descriptive pursuant to Section 2(e)(1) of the Trademark Act of applicant's services which were subsequently identified as "entertainment services, namely, providing a radio program in the field of finance, investments and real estate related issues." In response, Shaffer filed a Trademark/Service Mark Allegation of Use alleging a date of first use anywhere of May 1991. In addition, Shaffer filed evidence in support of his claim that the mark THE MONEY EXPERTS had become distinctive of his services pursuant to the provisions of Section 2(f) of the Trademark Act. One piece of evidence was a declaration signed by Mr. Shaffer and dated August 4, 2000 which stated as follows: "The mark has become distinctive of the services through the applicant's [Shaffer's] substantially exclusive and continuous use in commerce for at least the five years immediately before the date of this statement." The evidence of acquired distinctiveness persuaded the Examining Attorney, and, as previously noted, Registration No. 2,417,142 for the mark THE MONEY EXPERTS was issued to registrant Shaffer pursuant to the provisions of Section 2(f) on January 2, 2001.

Our primary reviewing Court has made it clear that "the [trademark] statute requires only that the application be filed in the PTO by the owner. No authority has been

cited for excusing non-compliance with 15 U.S.C. § 1051. Neither the Board nor the Courts can waive this statutory requirement." Huang v. Tzu Wei Chen Food, 849 F.2d 1458, 7 USPQ2d 1335, 1336 (Fed. Cir. 1988). The foregoing proposition is true regardless of whether the application was initially filed as a use based application or as an intent-to-use application. American Forests v. Sanders, 54 USPQ2d 1860, 1862 (TTAB 1999), aff'd Fed. Cir. March 10, 2000 (unpublished). See also 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. One must be the owner of a mark before it can be registered."); 2 J. McCarthy, McCarthy on Trademarks and Unfair Competition Section 19:53 at page 19-89 (4<sup>th</sup> ed. 2002) ("The applicant must be the owner of the mark.").

As previously noted, the application was filed in the name of registrant Richard A. Shaffer as the sole owner of the mark THE MONEY EXPERTS. Indeed, registrant Shaffer specifically checked the box titled "Individual - Citizen of (Country)" and then filled in the words "U.S. citizen." Immediately beneath this box is a box entitled "Partnership," which registrant Shaffer did not check.

Based upon the testimony of registrant Shaffer himself, Shaffer was not as of the application filing date (July 16, 1999) or at any pertinent time the sole owner of the mark THE MONEY EXPERTS. At page 16 of his deposition, Shaffer testified that "the contract said that the station [WBNW] retained the right" to the title THE MONEY EXPERTS. The contract to which Mr. Shaffer was referring is Exhibit 3 to his deposition and it is entitled "Artist's Agreement." This agreement dated January 1, 1996 is between Back Bay Broadcasters, Inc. (the owner of radio station WBNW) and registrant Shaffer. This Artist's Agreement in Section IIA provides that Shaffer acknowledges that the title of the show THE MONEY EXPERTS is, "and shall remain, both while this Agreement shall be in effect and at all times thereafter, the Company's [Back Bay Broadcasters, Inc.] exclusive property."

Shaffer has also conceded that he was never the exclusive user of the mark THE MONEY EXPERTS, and that he owned this title (mark) with petitioner Glovsky. (Shaffer deposition pages 35 and 48). Finally, in an agreement dated January 9, 1997 signed by representatives of radio station WRKO and registrant Shaffer, there appears the following sentence in paragraph 5: "Shaffer and [petitioner] Robert Glovsky shall own the rights to the

name THE MONEY EXPERTS without limitation." (Shaffer Exhibit 4).

Hence, even if we look simply to the testimony of registrant Shaffer, it is clear that at no time was Shaffer the sole owner of the mark THE MONEY EXPERTS. At a minimum, a co-owner of the mark was and is petitioner Glovsky. Whether radio stations WHDH or WBNW still retain any ownership interest in the title THE MONEY EXPERTS is an issue that this Board need not address. This is because whether these stations do or do not have any continuing ownership interest in no way changes the fact that registrant Shaffer is not and has never been the sole owner of the mark THE MONEY EXPERTS.

One final comment is in order. At pages 5 and 6 of his brief, Shaffer argues that petitioner Glovsky lacks standing to bring this cancellation proceeding. Shaffer alleges that "there are two separate basis for petitioner's lack of standing." (Registrant's brief page 5). First, registrant Shaffer contends that petitioner Glovsky did not acquire any rights in the mark THE MONEY EXPERTS because "petitioner's services were furnished to the various radio stations through [petitioner's] employer." (Registrant's brief page 5). However, Shaffer has simply failed to provide any evidence demonstrating that petitioner

Glovsky's employment deprived Glovsky of the right to be a co-owner of the mark THE MONEY EXPERTS. Moreover, at page 5 of his brief, registrant Shaffer concedes that in addition to the January 9, 1997 agreement between himself and WROK where Shaffer acknowledged that he and Robert Glovsky "shall own the rights in the names THE MONEY EXPERTS without limitation," there were additional agreements in 1998 between WRKO and registrant Shaffer where again registrant Shaffer acknowledged that "Shaffer and Robert J. Glovsky shall own the rights to the name [THE MONEY EXPERTS]." (Petitioner's brief page 5). Finally, at page 29 of his deposition, Glovsky testified that his employer never acquired rights in the mark THE MONEY EXPERTS.

The second prong of Shaffer's standing argument is really an unpled affirmative defense, namely, that petitioner Glovsky abandoned the mark THE MONEY EXPERTS. Because abandonment is an affirmative defense, it should have been pled. Respondent Shaffer did not plead this defense, and therefore the defense fails on this ground alone. Moreover, the defense lacks any merit. It is true that from June 1999, when Glovsky ceased his relationship with WRKO and Shaffer, to December 2000, Glovsky was not involved with any radio show. By the same token, Glovsky's

testimony demonstrates that throughout the year 2000, he was in active negotiations with radio station WBIX to host a radio show entitled THE MONEY EXPERT (singular). This show commenced airing in January 2001, albeit under the name THE BOB GLOVSKY SHOW. This is because on January 5, 2001 registrant Shaffer sent to Glovsky a cease and desist letter demanding that Glovsky not use the mark THE MONEY EXPERTS or anything similar thereto under threat of legal action. This January 5, 2001 letter referenced Shaffer's ownership of Registration No. 2,417,142 which just issued on January 2, 2001. Glovsky ceased his plans to use the title THE MONEY EXPERT as a result of this threat of litigation by registrant Shaffer. Instead, Glovsky took prompt action in filing his cancellation petition on February 9, 2001.

Obviously, abandonment requires more than a mere cessation of use. Abandonment, for the purposes of this case, requires not only a cessation of use, but also an "intent [on Glovosky's part] not to resume such use." See Section 45 of the Trademark Act. Based upon the fact that subsequent to June 1999 Glovsky actively solicited various radio stations to allow him to host a show called THE MONEY EXPERT, and the additional fact that Glovsky was successful in his efforts in just eighteen months by commencing a show

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on WBIX demonstrates that Glovsky had no intent to abandon the mark THE MONEY EXPERTS. The fact that his intention was to present this mark in a singular form because he was now the only host as opposed to a co-host with Shaffer is of no consequence. There is no meaningful distinction between the marks THE MONEY EXPERTS and THE MONEY EXPERT. Moreover, the fact that rather than face the prospects of litigation, Mr. Glovsky changed the name of the show but at the same time immediately commenced this cancellation proceeding only further demonstrates that he had no intention to abandon use of the mark THE MONEY EXPERT(S).

Decision: The petition to cancel is granted on the basis that the application which matured into Registration No. 2,417,142 was not filed in the name of the owner of the mark and thus was void ab initio.