

**This Opinion is Not a  
Precedent of the TTAB**

Mailed: August 26, 2022

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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*The Four-Eighteen Project, Inc.*

*v.*

*Katherine Wallich and Dance Church Inc.*<sup>1</sup>

—  
Cancellation No. 92071853

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James C. Eschen and Patrick T. Reilly for Petitioner The Four-Eighteen  
Project, Inc.

Maria Čulić Anderson, Silas K. Alexander, and Morgan Robertson of  
Knobbe, Martens, Olson & Bear LLP, for Respondent  
Katherine Wallich.

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<sup>1</sup> The registration for DANCE CHURCH was assigned from Katherine Wallich to Dance Church Inc. on November 29, 2021. The assignment was recorded in the records of the U.S. Patent and Trademark Office (USPTO) on December 1, 2021 at Reel 007517/Frame 0754, during trial and well over two years following the institution of this cancellation proceeding. Dance Church Inc. was never added as an additional defending party to this proceeding. Neither party to this cancellation proceeding raised any issues relating to ownership of the registration. Accordingly, Dance Church Inc. has been joined as a party to this proceeding as Respondent. *See NSM Res. Corp v. Microsoft Corp.*, 113 USPQ2d 1029, 1031 (TTAB 2014); TRADEMARK TRIAL AND APPEAL BOARD MANUAL OF PROCEDURE (TBMP) § 512.01 (2022) (“When there has been an assignment of a mark that is the subject of, or relied upon in, an inter partes proceeding before the Board, the assignee may be joined or substituted, as may be appropriate, upon motion granted by the Board, or upon the Board’s own initiative.”).

Citations to the record or briefs are to the publicly available documents in TTABVUE, the Board’s electronic docketing system. *See, e.g., Turdin v. Trilobite, Ltd.*, 109 USPQ2d 1473, 1476 n.6 (TTAB 2014). The number preceding “TTABVUE” corresponds to the docket entry number; the number(s) following “TTABVUE” refer to the page number(s) of that particular docket entry, if applicable.

Before Adlin, Hudis, and Johnson,  
Administrative Trademark Judges.

Opinion by Johnson, Administrative Trademark Judge:

Until after her testimony period ended, Co-Respondent Katherine Wallich was the owner of record of the standard character registered mark DANCE CHURCH, issued on the Principal Register for “Education services, namely, providing classes and instruction in the field of dance,” in International Class 41 (the “Registration”).<sup>2</sup> Wallich is the Chief Executive Officer of Dance Church Inc. (“Respondent”), to which she assigned the registration.

In its Petition for Cancellation,<sup>3</sup> The Four-Eighteen Project, Inc. (“Petitioner” or “The Four-Eighteen Project”) seeks cancellation of the Registration under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), on the ground that the involved mark, as applied to the services identified in the Registration, so resembles Petitioner’s mark, DANCE CHURCH,<sup>4</sup> previously used in connection with “Dance events,” as to be likely to cause confusion, mistake, or to deceive. Petitioner’s application to register its mark was initially refused registration and thereafter suspended based on a likelihood of confusion with Respondent’s mark.<sup>5</sup>

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<sup>2</sup> Registration No. 5217293 was issued on June 6, 2017, from an underlying application filed on October 19, 2016, under Section 1(a) of the Trademark Act, 15 U.S.C § 1051(a), based on a claim of first use of the mark anywhere and in commerce since at least as early as December 21, 2010.

<sup>3</sup> Petition for Cancellation, 1 TTABVUE.

<sup>4</sup> On October 25, 2018, Petitioner filed an application to register the standard character mark DANCE CHURCH with the USPTO, Serial No. 88169615, under Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b), based upon Petitioner’s allegation of a bona fide intent to use the mark in commerce. In its application, Petitioner disclaims the exclusive right to use the word “DANCE.”

<sup>5</sup> See Feb. 5, 2019 Nonfinal Office Action in App. Serial No. 88169615, 31 TTABVUE 98-105; Sept. 6, 2019 Suspension Notice, 31 TTABVUE 133-35.

In her Answer,<sup>6</sup> Respondent denied the salient allegations of the Petition for Cancellation and asserted four purported affirmative defenses. (4 TTABVUE 4). Respondent's first purported "affirmative defense," that "Registrant reserves the right to amend its Answer to allege any defenses currently unknown to Registrant in the event that discovery of additional information indicates that they are appropriate," is improper under the Federal Rules of Civil Procedure because such a reservation would not give Petitioner fair notice of such defenses. *Philanthropist.com, Inc. v. Gen. Conf. Corp. of Seventh-Day Adventists*, 2021 USPQ2d 643, at \*4 n.6 (TTAB 2021), *aff'd mem.*, 2022 WL 3147202 (Fed. Cir. Aug. 8, 2022); *see also FDIC v. Mahajan*, 923 F. Supp. 2d 1133, 1141 (N.D. Ill. 2013) ("[A]ffirmative defenses that purport to reserve the right to add affirmative defenses at a later date ... are stricken because they are improper reservations under the Federal Rules.").

Respondent's next purported "affirmative defense" is that Petitioner does not set forth any specific facts supporting its alleged common law rights and its alleged first use dating to December 21, 2010. (4 TTABVUE 4). Inasmuch as Petitioner is asserting prior common law rights in DANCE CHURCH, it is Petitioner's burden to prove the acquisition of prior rights in the mark. Thus, we construe this "affirmative defense" as a mere amplification of Respondent's denial of Petitioner's pleaded claim and not as a separate defense as such. *See, e.g., Sabhnani v. Mirage Brands, LLC*, 2021 USPQ2d 1241, at \*4 n.5 (TTAB 2021) (affirmative defense that the "Petition for Cancellation fails to demonstrate that any

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<sup>6</sup> 4 TTABVUE.

confusion has occurred or is likely to occur” is “merely an amplification of Respondent’s denial of a likelihood of confusion”).

Respondent’s third purported “affirmative defense” (styled “Registrant’s Second Affirmative Defense”) challenges Petitioner’s standing. (4 TTABVUE 4). However, lack of “standing,” now known as “entitlement to a statutory cause of action,” is not an affirmative defense. Entitlement to a statutory cause of action is an element of Petitioner’s claim that it must prove as part of its case, not a defense. *Peterson v. Awshucks SC, LLC*, 2020 USPQ2d 11526, at \*1 n.3 (TTAB 2020) (citing *Lipton Indus., Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185, 189 (CCPA 1982) and *Blackhorse v. Pro Football, Inc.*, 98 USPQ2d 1633, 1637 (TTAB 2011)).

Respondent asserts laches as her last affirmative defense, alleging that Petitioner waited over eight years from Respondent’s date of first use in interstate commerce, December 21, 2010, and over two years from the date of registration, June 6, 2017, to seek cancellation of Respondent’s DANCE CHURCH mark. (4 TTABVUE 4). However, Respondent did not pursue this affirmative defense in her brief, so we deem it waived. *Alcatraz Media, Inc. v. Chesapeake Marine Tours Inc.*, 107 USPQ2d 1750, 1753 n.6 (TTAB 2013) (affirmative defense not argued in brief deemed waived), *aff’d mem.*, 565 F.App’x 900 (Fed Cir. 2014); *NT-MDT LLC v. Kozodaeva*, 2021 USPQ2d 433, at \*5 n.8 (TTAB 2021) (citing *Alcatraz Media*).

The case is fully briefed. Petitioner bears the burden of proving its Trademark Act Section 2(d) claim for cancellation by a preponderance of the evidence. *Metro Traffic Control, Inc. v. Shadow Network Inc.*, 104 F.3d 336, 41 USPQ2d 1369, 1372 (Fed. Cir. 1997); *West Fla. Seafood, Inc. v. Jet Rests., Inc.*, 31 F.3d 1122, 31 USPQ2d 1660,

1662 (Fed. Cir. 1994). Having considered the evidentiary record, the parties' arguments, and applicable authorities, for the reasons set forth below, we dismiss Petitioner's Section 2(d) claim, and the petition for cancellation overall, based on Petitioner's failure to establish proprietary rights in its asserted common law mark, DANCE CHURCH.

## **I. The Evidentiary Record**

The record consists of the pleadings and, by operation of Trademark Rule 2.122(b), 37 C.F.R. § 2.122(b), the file of Respondent's involved registration.<sup>7</sup> Additional evidence introduced into the record is listed below.

### **A. Petitioner's Evidence**

Petitioner submitted several notices of reliance,<sup>8</sup> introducing into the record:

1. Various documents in "Notice of Reliance 2" (18 TTABVUE 8-53):

- a. Registrant Katherine Wallich's Responses to Petitioner's First Set of Requests for Admissions (Nos. 1-4) (Ex. 1);
- b. Registrant Kathrine [sic] Wallich's Responses to Petitioner's First Set of Interrogatories (Nos. 1-5) (Ex. 2); and
- c. Excerpts from the transcript of the video discovery Deposition of Katherine Wallich, dated November 19, 2020 (Ex. 4);

2. the Transcript of the Nov. 24, 2020 video discovery Deposition of Jim Brown (with Exs. 1, 4, and 8) ("Notice of Reliance 3"), a volunteer who conceived of the Santa Cruz Dance Church and the "Dance Church" name (18 TTABVUE 54-108); and

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<sup>7</sup> Therefore, Petitioner did not need to introduce a copy of the file for the involved registration. *See* Petitioner's Notice of Reliance ("Petitioner's NoR"), 18 TTABVUE 22-31 ("Notice of Reliance 2," Ex. 3).

<sup>8</sup> All located at 18 TTABVUE.

3. two documents in “Notice of Reliance 4” (18 TTABVUE 109-27):

a. Cody-Leigh Mullin, *Dance Church Caters to Alternative Sunday Morning Crowd*, CITY ON A HILL PRESS (May 15, 2008),

<https://www.cityonahillpress.com/2008/05/15/dance-church-caters-to-alternative-sunday-morning-crowd/>; and

b. a printed copy of Petitioner’s Internet Dance Church subpage, <https://the418project.org/dance-church>, retrieved March 22, 2021.

In addition, Petitioner submitted the testimony declarations of:

1. James Brown (with Exs. 1-5) (“Brown Decl.”) (25 TTABVUE); and

2. Frederick Kuhn (“Kuhn Decl.”), a former volunteer for the Santa Cruz Dance Church (18 TTABVUE 2-4).

Petitioner also submitted a Rebuttal Notice of Reliance,<sup>9</sup> introducing into the record:

1. A copy of Petitioner’s Internet subpage for Dance Church, retrieved December 12, 2021 (Ex. 1, 34 TTABVUE 5-8);

2. the Internet homepage for the Santa Cruz Dance Church, located at [www.dancechurch.org](http://www.dancechurch.org), retrieved December 12, 2021 (Ex. 2, 34 TTABVUE 10-11);

3. a Dance Church “Facebook”<sup>10</sup> page at <https://groups.io/g/DanceChurch> (Ex. 3, 34 TTABVUE 13-14);

4. the WhoIs registration record for the “dancechurch.org” domain name as of December 12, 2021 (Ex. 4, 34 TTABVUE 16-17); and

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<sup>9</sup> 34 TTABVUE (“Petitioner’s Rebuttal NoR”).

<sup>10</sup> Petitioner states that this evidence is from its Facebook page, however, the evidence does not feature the name “Facebook” anywhere on it, nor does it display the trade dress featured at most Facebook pages.

5. the Rebuttal Declaration of Laura Bishop, who has been the executive director of The Four-Eighteen Project since 2012 (34 TTABVUE 19-30, with Exs. 1-3).

**Petitioner’s Evidence: Evidentiary Issue**

As an initial matter, we strike the embedded links to the two YouTube videos proffered by Petitioner: “Founders of Dance Church, Second Edit” and “Berkeley Jam, Santa Cruz Dance Church, Santa Cruz Contact.” (18 TTABVUE 5-7) (styled “Notice of Reliance 1”). Providing only a web address or hyperlink, without the underlying material attached, is insufficient to introduce the underlying material into the record. *Chutter, Inc. v. Great Mgmt. Grp., LLC*, 2021 USPQ2d 1001, at \*32 n.67 (TTAB 2021) (article and accompanying video referenced by hyperlink inadmissible), *appeal docketed*, No. 22-1212 (Fed. Cir. 2021); Trademark Rule 2.122(e)(2), 37 C.F.R. § 2.122(e)(2); TBMP § 704.08(b); *see also Safer, Inc. v. OMS Invs., Inc.*, 94 USPQ2d 1031, 1039 (TTAB 2010) (a document obtained from the Internet must identify its date of publication or date that it was accessed and printed, and its source (e.g., the URL)). Accordingly, the two YouTube videos are not admissible because they were not properly made of record.

**B. Respondent’s Evidence**

Respondent submitted a Notice of Reliance,<sup>11</sup> introducing into the record:

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<sup>11</sup> 30 and 31 TTABVUE (“Registrant’s NoR”). Respondent also included “Registrant Kathrine Wallich’s Responses to Interrogatories Nos. 2, 3, and 4 to Petitioner’s First Set of Interrogatories (Nos. 1-5).” 30 TTABVUE 39-50. However, subject to certain exceptions which are not present here, Respondent cannot introduce its answers to interrogatories propounded by Petitioner. Trademark Rule 2.120(k)(5), 37 C.F.R. § 2.120(k)(5); TBMP § 704.10; *see Daniel J. Quirk, Inc. v. Village Car Co.*, 120 USPQ2d 1146, 1151 (TTAB 2016).

1. A copy of the Trademark Electronic Search System (TESS) record for Petitioner's DANCE CHURCH application, Serial No. 88169615, and the Trademark Status and Document Retrieval (TSDR) database printout for same. (30 TTABVUE 16-19);

2. Petitioner's Responses to Request for Admissions Nos. 1 and 3, from "Petitioner's Responses to Registrant's First Set of Requests for Admissions [sic] (Nos. 1-6)" (30 TTABVUE 21-26);

3. Petitioner's Responses to Interrogatories Nos. 10, 11, 12, 14, 15, and 16 from Registrant's First Set of Interrogatories (Nos. 1-19), dated February 9, 2020 (30 TTABVUE 28-37);

4. printed pages from Respondent's Dance Church Facebook page, published online at <https://www.facebook.com/dancechurchforever/>, accessed and printed on February 6, 2020. (30 TTABVUE 52-175);

5. printed pages from Katherine Wallich's personal Facebook page, published online at <https://www.facebook.com/kate.wallich/>, accessed and printed on October 26, 2021 (30 TTABVUE 177-81);

6. printed pages from Respondent's Dance Church Instagram page, published online at [https://www.instagram.com/dance\\_church/?hl=en](https://www.instagram.com/dance_church/?hl=en), accessed and printed on February 6, 2020 (30 TTABVUE 183-87);

7. portions of the December 21, 2020 discovery Deposition of Laura Bishop, Petitioner's Executive Director and FED. R. CIV. P. 30(b)(6) witness (30 TTABVUE 189-301, with Exs. 10-19);

8. portions of the November 24, 2020 discovery Deposition of Jim Brown (30 TTABVUE 303-50, with Exs. 21-23; 31 TTABVUE 2-27, with Exs. 24-26);



9. portions of the November 19, 2020 discovery deposition of Katherine Wallich (31 TTABVUE 29-81, with Exs. 28-36); and

10. the application file for Serial No. 88169615 for Petitioner's mark, DANCE CHURCH (31 TTABVUE 83-135).

In addition, Respondent submitted:

1. The Testimony Declaration of Katherine Wallich (32 TTABVUE 1-156, with Exs. 1- 4); and

2. the transcript of the Testimony Deposition of Frederick Kuhn, dated September 2, 2021 (35 TTABVUE 1-49, with Exs. 1-2).

## **II. The Parties**

### **A. Petitioner**

Petitioner The Four-Eighteen Project is an Internal Revenue Code Section 501(c)(3) nonprofit California corporation (1 TTABVUE 3; 30 TTABVUE 200-03), with a mission to “build community” and “provide a safe space for personal and artistic expression.” (30 TTABVUE 201). At all relevant times in this proceeding, Petitioner's primary place of business has been located at 418 Front Street in Santa Cruz, California.<sup>12</sup> (1 TTABVUE 3). Starting in 2000, “Dance Church,” where “[t]he DJ is the minister, the music is the sermon, [and] the dancers are the congregation” (25 TTABVUE 12), was held on Sunday mornings at Petitioner's building at 418 Front Street. (18 TTABVUE 66-67). Petitioner alleges “extensive common law rights” to the DANCE CHURCH mark “in the State of California and in more than one additional jurisdiction” at least as early as 2000, through use of the

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<sup>12</sup> In 2021, Petitioner learned that it had to move from the 418 Front Street property. See 34 TTABVUE 20.

mark in promotional flyers, a Facebook page, a Yahoo! Group, and a website created and maintained by the Santa Cruz Dance Church volunteers<sup>13</sup> who are not parties to this proceeding. (1 TTABVUE 4; 36 TTABVUE 7, 18-20).

### **B. Co-Respondent Katherine Wallich**

Co-Respondent Katherine (“Kate”) Wallich describes herself as “a very established choreographer.” (31 TTABVUE 50). Wallich, who has been profiled by various dance publications and other media outlets such as the *New York Times*, is an award-winning choreographer whose work has toured the United States. (31 TTABVUE 50-52). In December 2010, she began the “Sunday Morning Movement Practice,” best described as an “open-level” “inclusive dance class to multi-genre pop music,” at her studio in Seattle, Washington. (31 TTABVUE 33; 32 TTABVUE 4). In the beginning of 2011, she renamed that class “Dance Church.” (31 TTABVUE 36). Since that time, Wallich has promoted “Dance Church” on her personal Facebook page, her “dancechurchforever” Facebook page, and on her Dance Church Instagram page. (32 TTABVUE 4). As of October 2021, the “Dance Church” Instagram page, @dance\_church, had more than 44,000 followers. (32 TTABVUE 4). Since 2017, regularly scheduled and “pop-up” Dance Church classes have been hosted in Seattle, New York, Los Angeles, and other cities in the United States as well as in several foreign countries. (31 TTABVUE 46-47; 32 TTABVUE 4).

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<sup>13</sup> Throughout this opinion, we will refer to the various individuals who founded, and contributed in any way to the continued operation of, the Santa Cruz Dance Church collectively as the “Santa Cruz Dance Church volunteers” or simply, “the volunteers.”

### III. Entitlement to a Statutory Cause of Action<sup>14</sup>

Entitlement to a statutory cause of action is a requirement in every inter partes case. *Australian Therapeutic Supplies Pty. Ltd. v. Naked TM, LLC*, 965 F.3d 1370, 2020 USPQ2d 10837, at \*3 (Fed. Cir. 2020), *cert. denied*, 142 S. Ct. 82 (2021) (citing *Lexmark Int'l, Inc. v. Static Control Components, Inc.*, 572 U.S. 118, 125-26 (2014)). A party in the position of plaintiff may seek cancellation of a registration of a mark when doing so is within its zone of interests and it has a reasonable belief in damage that is proximately caused by registration of the mark. *Corcamore, LLC v. SFM, LLC*, 978 F.3d 1298, 2020 USPQ2d 11277, at \*6-7 (Fed. Cir. 2020), *cert. denied*, 141 S. Ct. 2671 (2021) (holding that the test in *Lexmark* is met by demonstrating: (1) a real interest in opposing or cancelling a registration of a mark, which satisfies the zone-of-interests requirement; and (2) a reasonable belief in damage proximately caused by registration of the mark).

The USPTO cited the DANCE CHURCH Registration as a potential bar to the registration of Petitioner's pleaded application for DANCE CHURCH under Section 2(d) of the Trademark Act. (31 TTABVUE 98-105; 31 TTABVUE 133-35). This is sufficient to prove Petitioner's commercial interest in the proceeding, and is a reasonable basis for Petitioner's belief of damage as well:

We regard the desire for a registration with its attendant statutory advantages as a legitimate commercial interest. To establish a reasonable basis for a belief that one is damaged by the registration sought to be

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<sup>14</sup> Our decisions have previously analyzed the requirements of Sections 13 and 14 of the Trademark Act, 15 U.S.C. §§ 1063 and 1064, under the rubric of "standing." We now refer to this inquiry as "entitlement to a statutory cause of action." Despite the change in nomenclature, our prior decisions and those of the U.S. Court of Appeals for the Federal Circuit interpreting "standing" under Sections 13 and 14 of the Trademark Act remain applicable. *Chutter*, 2021 USPQ2d 1001 at \*10 n.39 (citing *Spanishtown Enters., Inc. v. Transcend Res., Inc.*, 2020 USPQ2d 11388, at \*2 (TTAB 2020)).

cancelled, a petition may assert a likelihood of confusion which is not wholly without merit ... or, as here, a rejection of an application.

*Lipton Indus.*, 213 USPQ at 189. *See also Empresa Cubana Del Tabaco v. Gen. Cigar Co.*, 753 F.3d 1270, 111 USPQ2d 1058, 1062 (Fed. Cir. 2014) (“Because the USPTO refused Cubatabaco [sic] registration based on a likelihood of confusion with General Cigar’s Registrations, Cubatabaco has a real interest in cancelling the Registrations and a reasonable belief that the Registrations blocking its application are causing it damage.”). Thus, Petitioner has proven its entitlement to bring a statutory cause of action.

#### **IV. Does Petitioner Have Proprietary Rights in the DANCE CHURCH Mark?**

Both parties desire to use the identical mark for very similar services. Where parties lay claim to the same marks for essentially the same services, a likelihood of confusion is inevitable. This dispute centers on whether Petitioner has established prior rights in the DANCE CHURCH mark sufficient to justify cancellation on the ground of likelihood of confusion. *See, e.g., Nat’l Cable Television Ass’n, Inc. v. Am. Cinema Eds., Inc.*, 937 F.2d 1572, 19 USPQ2d 1424, 1429 (Fed. Cir. 1991) (priority and likelihood of confusion opinion that analyzes service mark use and analogous use).

However, before we determine whether Petitioner has prior rights in the DANCE CHURCH mark, we must determine whether Petitioner has **any** proprietary rights in the DANCE CHURCH mark. A party seeking cancellation of a registration under Trademark Act Section 2(d) must prove that it has proprietary rights in the term upon which it relies. *Otto Roth & Co. v. Universal Foods Corp.*, 640 F.2d 1317, 209 USPQ 40, 43 (CCPA 1981). A party may establish its own prior proprietary rights in a trademark through ownership of a registration, through actual use, or through use analogous to trademark use. *T.A.B. Sys. v. PacTel Teletrac*, 77 F.3d 1372, 37 USPQ2d 1879, 1881 (Fed. Cir. 1996),

*vacating Pactel Teletrac v. T.A.B. Sys.*, 32 USPQ2d 1668 (TTAB 1994). Here, because Petitioner has not pleaded or submitted any registrations, and because it did not plead analogous trademark use,<sup>15</sup> Petitioner must rely on its asserted common law rights, which must precede Respondent’s actual or constructive use of her mark. *WeaponX Performance Prods. Ltd. v. Weapon X Motorsports, Inc.*, 126 USPQ2d 1034, 1040-41 (TTAB 2018).

### **A. The Parties’ Arguments**

Respondent frames its principal argument as one of priority. (37 TTABVUE 17-18). Specifically, Respondent argues that Petitioner did not have rights in its DANCE CHURCH mark prior to Respondent’s December 21, 2010 date of first use because Petitioner was not the entity using the DANCE CHURCH mark for “dance events.” (37 TTABVUE 17-30). Respondent contends that the “Santa Cruz Dance Church Group,” referred to herein as the Santa Cruz Dance Church volunteers, was the entity that offered “Dance Church” classes before December 21, 2010, not The Four-Eighteen Project. Respondent also contends that the Santa Cruz Dance Church volunteers “never used DANCE CHURCH in such a way as to establish use analogous to trademark use<sup>16</sup> or in a way that would create public awareness of the mark as one that identifies a source of services.” (37 TTABVUE 19). Finally, to the extent that the volunteers may have

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<sup>15</sup> See discussion *infra* at n. 15.

<sup>16</sup> Respondent also argues that Petitioner did not plead analogous use in its Petition for Cancellation, and as a result, Petitioner should not now be allowed to rely on any rights allegedly acquired through the Santa Cruz Dance Church volunteers’ non-technical trademark use in order to establish priority over Registrant. 37 TTABVUE 17-21. Petitioner does not deny that it did not plead analogous use, arguing that it instead relies on the volunteers’ prior, actual intrastate service mark use to establish priority. See 38 TTABVUE 6-9. Because Petitioner did not assert analogous use in its Petition for Cancellation, this basis for claiming priority is waived. *Cent. Garden & Pet Co. v. Doskocil Mfg. Co.*, 108 USPQ2d 1134, 1142 (TTAB 2013).

established any common law rights in the DANCE CHURCH mark before December 21, 2010, Respondent argues that Petitioner cannot rely on those rights to assert priority since The Four-Eighteen Project and the Santa Cruz Dance Church volunteers were not, and are not, in privity. (37 TTABVUE 21-29).

Petitioner argues that Dance Church began in Santa Cruz, California under its “umbrella.” (36 TTABVUE 7). Specifically, Petitioner argues that Dance Church, which was started by the Santa Cruz Dance Church volunteers, usually has been held on Sunday mornings at its building on 418 Front Street in Santa Cruz since 2000 or 2001 (36 TTABVUE 7-8), and that the actual structure and control of Dance Church is irrelevant:

In Dance Church’s early days, some question may have arisen over that actual control. Jim Brown and Keri Syndulko started the group as a project for a class that Synkulko [sic] was taking. Rick Kuhn managed the Website, Facebook page, and Yahoo page. Later, Ted Merrill took over those duties. In 2011, Petitioner came to an agreement with a group, including Brown, calling itself the Dance Church Council regarding the division of Dance Church receipts.

None of the questions over who controlled what matter. [sic] *See Metro Traffic Control*, 41 USPQ2d at 1372, citing *West Fla. Seafood*, 31 USPQ2d at 1662-63. Separate corporate, business and personal entities operating as a single entity in the consuming public’s eyes may be treated as such for trademark purposes. *Id.*

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Similarly, neither who maintained the websites or the social-media groups and the relationship between the Dance Church Council and Petitioner is relevant. The public perceived a weekly Dance event at Petitioner’s location every week for two decades. During that time, that event has changed little. Regardless of the exact nature of Petitioner’s relationship with Kuhn, Merrill and the Dance Church Council, they were all referring to Petitioner’s event.

36 TTABVUE 20-21.

Furthermore, Petitioner argues that it and the Santa Cruz Dance Church volunteers are related companies, and “[i]f the Dance Church volunteers owned the mark, they assigned it to Petitioner.” (38 TTABVUE 13-18).

### **B. Witness Testimony About the Origins of Dance Church in Santa Cruz**

Since it is clear from the record that Petitioner did not make actual use of the DANCE CHURCH mark on or before December 21, 2010, and since Petitioner failed to plead analogous use in its petition, we focus on whether Petitioner and the Santa Cruz Dance Church volunteers were “related companies” prior to December 21, 2010, such that the volunteers’ prior use inured to Petitioner’s benefit. *Rocket Trademarks Pty Ltd. v. Phard S.p.A.*, 98 USPQ2d 1066, 1069 (TTAB 2011) (an owner of a mark may rely on a related company’s use of the mark). A related company is “any person whose use of a mark is controlled by the owner of the mark with respect to the nature and quality of the goods or services on or in connection with which the mark is used.” Trademark Act Section 45, 15 U.S.C. § 1127. We weigh the oral testimony and other evidence in the record as a whole, rather than consider each piece of evidence in isolation. *See, e.g., West Fla. Seafood*, 31 USPQ2d at 1663 (decision pertaining to priority).

#### **1. Testimony of James (“Jim”) Brown**

In 1999, Jim Brown was attending Friday night dances at The Four-Eighteen Project in Santa Cruz, but “wanted something in the daytime that had a stronger spiritual focus.” (25 TTABVUE 2). An acquaintance was attending an event on Sunday mornings called “Yoga Church.” (18 TTABVUE 57; 25 TTABVUE 2). Brown liked that idea. (18 TTABVUE 57; 25 TTABVUE 2). Shortly thereafter, he conceived of having a Sunday morning dance event that would “celebrate spirituality through dance.” (25 TTABVUE 2).

Brown shared his idea with a few friends, and together they formalized the structure — “specifically the flow of activities” — of the “dance church.” (18 TTABVUE 59; 25 TTABVUE 2). The group recruited a deejay, someone to build an altar, and someone to facilitate a closing circle. (18 TTABVUE 59). Dance Church launched shortly thereafter, “sometime between 2000 and 2001.” (18 TTABVUE 60). It was held at Petitioner’s building, 418 Front Street in Santa Cruz, California. (18 TTABVUE 66-67). Below is a promotional flyer for the Santa Cruz Dance Church. (25 TTABVUE 7). It was left at the front door of The Four-Eighteen Project “somewhere between 2002 and 2005.” (25 TTABVUE 7).



# DANCE CHURCH

**Sundays 9:00-11:15am**

- A DJ'd freestyle dance that starts with slow warmup inner-journey music, revving up to a rockin' boogie.
- Bring your joy, your sorrow. Something for the altar.
- Be in your own space, or connect with others.
- Ends with a circle for sharings and announcements.

**@The 418 Project**

**418 Front Street, across from Metro Central  
Santa Cruz**

**\$10 donation requested**

*"There is a community of the spirit. Join it, and feel the delight.  
Open your hands, if you want to be held. Sit down in this circle.  
Flow down and down in always widening rings of being."*

*—Rumi*

Brown attended Dance Church every Sunday morning for most of its first seven years of existence. (18 TTABVUE 62). During that time, Brown did not coordinate or organize Dance Church sessions; he “just danced and participated in the closing circle and altar building.” (18 TTABVUE 61). The deejay, the creators of the altar, and all others who contributed to each session were volunteers. (18 TTABVUE 68, 89). According to Brown, the altar is “a place of spiritual focus” that “continues to be newly created every ... dance. Different people volunteer to create the altar and the altars are composed of items that the creator feels are sacred.” (18 TTABVUE 68). Below is a photo, allegedly from the Dance Church Facebook page, showing Dance Church participants. (34 TTABVUE 2, 13).



When the Santa Cruz Dance Church first started, no one registered it as a business, a nonprofit, or any sort of formal entity. (18 TTABVUE 65). There were no formal agreements or records kept, except for weekly Dance Church donation deposit receipts. (18 TTABVUE 69, 73). Dance Church “was very informal and operated ... under the auspices of The 418 Project. ... Many of the people involved in managing The 418 Project ... were all participants in Dance Church.” (18 TTABVUE 65). There was never a list of

Santa Cruz Dance Church attendees, just a Santa Cruz Dance Church email list that was set up by another volunteer. (18 TTABVUE 69-70). Also, during those early years, Dance Church did not have any source of revenue or income other than donations collected at the door. (18 TTABVUE 89). The recommended donation was ten dollars per session. (18 TTABVUE 71). According to Brown, it was “simply agreed” that all of the contributions, which were not rent for using Petitioner’s facility, “would go to The 418.” (18 TTABVUE 73, 90).

Between 2004 and 2007, Brown was Petitioner’s Executive Director. (18 TTABVUE 80- 81; 25 TTABVUE 3). During that time, Petitioner promoted Dance Church in the free calendar of the local Santa Cruz newspaper (18 TTABVUE 79, 81). The sessions were also promoted through the Santa Cruz Dance Church’s fliers, the Santa Cruz Dance Church’s email list, Petitioner’s email list, as well as by word of mouth. (18 TTABVUE 79-82). As a result, Dance Church became “quite successful” and started paying the deejay, or “dj,” and the volunteers who worked the door. (18 TTABVUE 62, 66). Quarterly schedules of various dance classes held at The Four-Eighteen Project were posted at Petitioner’s headquarters while Brown was executive director. (25 TTABVUE 4). Below are schedules of classes for Fall 2003 and Winter 2004. (25 TTABVUE 9-10).



## Schedule Of Classes Fall 2003

Monday	10:00 ~ 12:00	Baby Jam	Faustine & Jeff	458-2240
	5:00 ~ 6:00	Brazilian Drum	Papiba Godinho	423-7536
	6:00 ~ 7:30	Samba	J'Ann Rains	423-4008
	7:45 ~ 9:15	African	Alassane Kane	462-9581
Tuesday	12:00-3:00	Community Bodywork Center		239-8577
	5:00-6:00	Beg/Int Afr Drumming	Salif Kone	246-2314
	6:00 ~ 7:30	Capoeira	Papiba Godinho	423-7536
	7:30-9:00	Afr Dance Step by Step	JJ LaMedi ca	246-2314
Wednesday	12:00-3:00	Community Bodywork Center		239-8577
	5:00 ~ 6:00	Kids Capoeira	Papiba Godinho	423-7536
	6:00 ~ 7:30	Capoeira	Papiba Godinho	423-7536
	7:30 ~ 9:00	West African	Toni Koranteng	661-0737
Thursday	9:00 ~ 11:30	Dance Church	Collective	466-9770
	12:00-3:00	Community Bodywork Center		239-8577
	5:00 ~ 6:00	Brazilian Drum	Papiba Godinho	423-7536
	6:00 ~ 7:30	Samba	Marsea Marquis	426-7563
	7:30 ~ 9:00	Capoeira	Papiba Godinho	423-7536
Friday	10:00-11:30	Bellydance Workout	Rica Smith	457-2098
	4:30 ~ 5:30	Kids Capoeira	Papiba Godinho	423-7536
	7:00-8:30	Contact Improv	Keri, Ryan and guests	239-8577
	8:30-1:00	Community Dance Jam	Collective	466-9770
Saturday	11:30 ~ 1:00	African	Mandjou Kone	325-8423
Sunday	9:00 ~ 11:30	Dance Church	Collective	466-9770
	11:30 ~ 1:00	African	Mandjou Kone	325-8423

Most classes all levels, ongoing, drop in \* Prices Vary \* Contact teachers for more information

**The Four-Eighteen Project 418 Front St Santa Cruz CA 95060 831-466-9770 [www.four-eighteen.org](http://www.four-eighteen.org)**



## Schedule Of Classes Winter 2003

### Monday

7:00-8:00	Yoga	Evernus	466-0447
8:30-9:30	Yoga	Monica	420-0432
10:00-12:00	Baby Jam	Faustine & Jeff	458-2240
5:00-6:00	Brazilian Drum	Papiba Godinho	423-7536
6:00-7:30	Samba	J'Ann Rains	423-4008
7:45-9:15	African	Alassane Kane	462-9581

### Tuesday

6:00-7:30	Capoeira	Papiba Godinho	423-7536
7:30-9:45	Aerial	Miranda Janeschild	429-2241
9:45-1:00	Live Music	Doug/Pete	466-9770

### Wednesday

5:00-6:00	Kids Capoeira	Papiba Godinho	423-7536
6:00-7:30	Capoeira	Papiba Godinho	423-7536
7:30-9:00	West African	Toni Koranteng	661-0737

### Thursday

9:00-11:00	Dance Church	Collective	466-9770
5:00-6:00	Brazilian Drum	Papiba Godinho	423-7536
6:00-7:30	Samba	Marsea Marquis	
7:30-9:00	Capoeira	Papiba Godinho	423-7536

### Friday

7:00-8:00	Yoga	Evernus	466-0447
9:30-11:00	Improv	Nita Little Nelson	457-2744
4:30-5:30	Kida Capoeira	Papiba Godinho	423-7536
5:30-7:00	West African	Alseng Seremah	239-1175
7:30-9:00	Modern/Contact	Miranda Janeschild	429-2241

### Saturday

10:00-11:30	Pilates (no class in Dec.)	Teren Ellison	466-9770
11:30-1:00	African	Mandjou Kone	466-9770

### Sunday

9:00-11:30	Dance Church	Collective	466-9770
11:30-1:00	African	Mandjou Kone	466-9770

THE FOUR-EIGHTEEN PROJECT 418 FRONT ST SANTA CRUZ 95060

831-466-9770 [www.four-eighteen.org](http://www.four-eighteen.org)

Sometime between 2007 and 2009, Brown and several other Santa Cruz Dance Church volunteers formed the Dance Church Council (“DCC”) to “find a better way to manage [Dance Church’s] resources.” (18 TTABVUE 63). According to Brown, “[b]efore the council formed, there was no governing structure for Dance Church. We had – we had a coordinator who coordinated the DJs. We had a – we had a coordinator who coordinated the – the people working the front—the – the door. And that was really it. It was quite a self-organizing system.” (18 TTABVUE 94).

The first agenda item for the DCC was to negotiate a fiscal sponsorship<sup>17</sup> agreement between Petitioner and the Santa Cruz Dance Church volunteers. (18 TTABVUE 73). Under the agreement, shown below (which we note is unsigned),<sup>18</sup> seventy-five percent of the proceeds from Dance Church sessions went to Petitioner and twenty-five percent of the proceeds were held, by Petitioner, for the Santa Cruz Dance Church volunteers to “invest in charitable purposes associated with ... [Dance Church].” (18 TTABVUE 74). The initial

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<sup>17</sup> We take judicial notice of the definition of “fiscal sponsorship.” “A fiscal sponsorship describes a relationship between a nonprofit organization with 501(c)(3) tax-exempt status and a project conducted by a separate organization, group, or individual that does not have 501(c)(3) status. Fiscal sponsorship permits the exempt sponsor to accept funds restricted for the sponsored project on the project’s behalf. The sponsor, in turn, accepts the responsibility to ensure funds are properly spent to achieve the project goals. This arrangement is useful for new charitable endeavors that want to ‘test the waters’ before deciding whether to form an independent entity or another temporary project or coalition looking for a neutral party to administer funds.” INVESTOPEDIA (<https://www.investopedia.com/terms/f/fiscalagent.asp>) (last accessed July 12, 2022). The Board may take judicial notice of definitions from online industry specific encyclopedias such as *Investopedia*, which is an online investment encyclopedia. *DIB Funding, Inc. v. Luma*, 2020 TTAB LEXIS 335, at \*6 n.14 (TTAB July 2, 2020); *E. W. Bank Co. v. The Plubell Firm LLC*, 2016 WL 5219824, at \*13 n.23 (TTAB Sept. 8, 2016); see FED.R.EVID. 201(b)(2) (“Kinds of Facts That May Be Judicially Noticed”) and (c)(1) (“Taking Notice”).

<sup>18</sup> According to Petitioner’s Executive Director, the agreement was executed on September 1, 2011. 30 TTABVUE 257-58.

term of that evergreen agreement was September 1, 2011 through August 31, 2012.

(18 TTABVUE 293- 94).

### Agreement between The 418 Project and Dance Church

This agreement (hereby known as "the agreement" or "this agreement") stipulates and documents the conditions by which The 418 Project (hereinafter known as "The 418") will act as fiscal agent of Dance Church for the period beginning September 1, 2011 and continuing until August 31, 2012.

This agreement will renew automatically each year with identical terms. If either party wishes to change the terms of the agreement, it is incumbent upon them to initiate negotiations prior to the renewal of the agreement.

Article 1: The 418 agrees to the following:

Section 1. To serve as a fiscal agent of Dance Church and to accept the responsibilities of that standing, as stipulated by laws of the State of California. This includes provision of separate line items in The 418's budget and expense processes, invoicing services and payment of expenses through The 418's bookkeeping systems.

Section 2. To provide support and assistance, as required or requested by the Dance Church, in providing any documentation that may be required to secure grants or other financing.

Section 3. To provide liability insurance as allowed under The 418's general liability insurance policy.

Section 4. To issue reimbursement checks or payment of invoices within two weeks of receipt of request and supporting documentation.

Article 2: The Dance Church agrees to the following:

Section 1. To comply with The 418's by-laws.

Section 2. To comply with the requirements of The 418's IRC Sec. 501(c)(3) status.

Section 3. To contribute to The 418 75% of revenues from Dance Church events on Sunday mornings at The 418's facilities. All other income will be deposited with The 418 to be used solely by Dance Church for purposes that meet the requirements of this agreement.

Section 4: Dance Church will submit a budget to The 418 for fiscal year 2012 by December 1, 2011.

Section 5: Dance Church will submit all invoices to The 418 for payment or reimbursement within 30 days of the date expense was incurred.

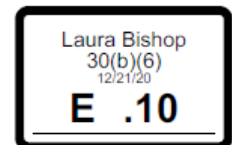
Section 6: Dance Church will submit all monies received to The 418 for deposit within 7 day sof the date monies were received.

Section 7. At the request of The 418 board of directors, Dance Church will submit to The 418 Executive Director within four weeks a one page written report. This report will describe all significant activities undertaken by the Dance Church during the previous six months.

Section 8. Dance Church will note in all of its advertising that its activities are cosponsored by The 418 and/or will identify Dance Church as an affiliate of The 418.

Section 9. Dance Church will not operate with a deficit.

Section 10: Dance Church will pay any increase in The 418's insurance cost caused by the activities of Dance Church.



Agreement between The 418 Project and Dance Church

Section 11: Dance Church will give The 418's Executive Director no less than 30 days' notice prior to using The 418's tax ID number for grants or when seeking donations.

Article 3: Termination

Section 1. The termination of this agreement can be made by the Executive Officers of The 418's Board of Directors, or by Dance Church, with no less than ninety days notice to the other party before termination. Accounts and monies outstanding at the time of termination are still subject to the requirements of this agreement.

Section 2. In the event that The 418 is unable to, or does not comply with the terms of this agreement, this will be viewed as a termination of the agreement and The 418 will forward the balance of any monies received from Dance Church as a result of this agreement to the Dance Church's new fiscal agent within a reasonable period of time not to exceed 60 days. Dance Church's new fiscal agent must be an IRC Sec. 501(c)(3) organization. In the event 60 days is insufficient to close Dance Church accounting, an interim agreement may be negotiated between Dance Church and The 418.

Section 3. In the event that Dance Church is unable to, or does not, comply with the terms of this agreement, this will be viewed as a termination of the agreement and Dance Church will notify all Grantors (legal entities that have given restricted funds under contract) within a reasonable period of time not to exceed sixty days of such dissolution. With approval from grantors, The 418 will forward the balance of monies designated for Dance Church to Dance Church's new fiscal agent within sixty days from the date of the dissolution. Dance Church's new fiscal agent must be an IRC Sec. 501(c)(3) organization. In the event 60 days is insufficient to close Dance Church accounting, an interim agreement may be negotiated between Dance Church and The 418. Otherwise, monies will be returned to grantors.

The undersigned are the responsible representatives of the aforementioned parties and enter into this contract with the full endorsement of our Corporations, if applicable, and an understanding of the stipulations of this agreement. Our Corporations, if applicable, hereby accept the terms of this agreement.

\_\_\_\_\_  
Chairperson - DANCE CHURCH

\_\_\_\_\_  
Officer – The 418 Project

\_\_\_\_\_  
Date

\_\_\_\_\_  
Date

I certify that I have received a copy of the current By-laws of The 418 Project.

\_\_\_\_\_  
Chairperson – DANCE CHURCH      \_\_\_\_\_  
Date



Brown does not recall there being any agreement, formal or informal, between the Santa Cruz Dance Church volunteers and Petitioner that restricted or limited how the volunteers could use the DANCE CHURCH mark. (18 TTABVUE 77). He does not recall any discussions regarding ownership of the DANCE CHURCH mark, nor does he recall transferring any rights he might have had in the DANCE CHURCH mark to Petitioner. (18 TTABVUE 91-92). He did not think he had any rights in the DANCE CHURCH mark: “My intention wasn’t ... to hold any rights. I was creating something for the community, not for myself.” (18 TTABVUE 92).

In 2011, Brown left the DCC. (25 TTABVUE 5). According to Brown, at some point after he left, “The 418 Project and Dance Church decided to ... remerge and end the fiscal sponsorship agreement and just have ... Dance Church be a program of The 418 Project.” (18 TTABVUE 74-75). He does not think Petitioner exercised any formal control over the Santa Cruz Dance Church volunteers, but also admits that he’s “not clear what formal control would look like.” (18 TTABVUE 75). “Certainly The 418 Project had authority. You know, they ... controlled the space so they could have ... controlled the time or accessibility or the cost or any of those things, but ... I don’t have a memory of that ever happening.” (18 TTABVUE 75).

## **2. Testimony of Laura Bishop**

Laura Bishop is Petitioner’s Executive Director and FED. R. CIV. P. 30(b)(6) witness. She started “associating” with Petitioner in early 2005, left for a brief period, and returned as Executive Director in 2012. (30 TTABVUE 202, 254). She was on the board of The Four-Eighteen Project in 2011, when she recalls the fiscal sponsorship agreement between Petitioner and the Santa Cruz Dance Church volunteers being executed.

(30 TTABVUE 255). To Petitioner's knowledge, the fiscal sponsorship agreement is the sole agreement between Petitioner and the volunteers, and is still in effect. (30 TTABVUE 257-58).

Ms. Bishop testified that the Santa Cruz Dance Church started as "this ...volunteer event benefitting The Four Eighteen Project, and as it grew it became a larger and larger source of funds for The Four Eighteen Project ... . So that's when the Dance Church Committee was formed, that's when the fiscal sponsorship was formed." (30 TTABVUE 204). In her opinion, Dance Church events have become more organized over time but the nature of them have not changed. (30 TTABVUE 195). To Petitioner, "more organized" means "the idea of there being a committee [the DCC] and the idea of there being hosts and greeters." (30 TTABVUE 195). A wide variety of people of all ages attend the Santa Cruz Dance Church, but there is no attendance sheet for the sessions. (30 TTABVUE 196- 97). People seeking information about Dance Church can go to Dance Church's Facebook page, join the Dance Church email group, or read Petitioner's newsletter. (30 TTABVUE 197).

The DanceChurch.org website, which is separate from Petitioner's website, was created "a while ago" by the Santa Cruz Dance Church volunteers. (30 TTABVUE 214-15). It is not operated or maintained by Petitioner. (30 TTABVUE 215, 241, 274-75). Petitioner did not have a specific marketing or branding strategy for Dance Church, but "Dance Church had its own kind of volunteer entity identity and then there's also at the same time there is how Dance Church exists as kind of the beating heart of The Four Eighteen. So as years have gone by there's been more and more cooperation and coordination between them." (30 TTABVUE 231-32). Petitioner currently promotes Dance Church on its webpage, and

“at times” on its Instagram page, but Bishop is unsure for how long this promotional activity has occurred. (30 TTABVUE 217-18). Petitioner has not spent much money marketing or advertising Dance Church, so no financial breakdown is available. (30 TTABVUE 234-35). However, Dance Church is responsible for about \$25,000 of Petitioner’s yearly donation revenue. (30 TTABVUE 239-40). The Santa Cruz Dance Church volunteers never paid a rental fee to Petitioner. (30 TTABVUE 241).

Bishop recalls that Petitioner first considered filing a trademark application for DANCE CHURCH in 2016 because “we valued the program. We really had acknowledged that it was our core program and we thought it was time that we should trademark it.” (30 TTABVUE 207). However, Petitioner did not file its application until October 2018 because “it was just part of our maturation process.” (30 TTABVUE 212).

Until the spring of 2021, the Dance Church website and mailing list were maintained by the Santa Cruz Dance Church volunteers. (34 TTABVUE 19-20). According to Bishop, because the web pages and mailing list “had always furthered The 418 Project’s mission for and vision of Dance Church,” Petitioner allegedly “never felt a need to make clear whether [the website and mailing list] belonged to those volunteers individually or as a group or to The 418 Project as an organization.” (34 TTABVUE 19-20).

At the same time, around the spring of 2021, Petitioner’s board of directors felt compelled to make some changes. Since Petitioner had to move its offices from Four- Eighteen Front Street, it also seized the opportunity to widen its outreach to younger people and “members of historically underserved communities.” (34 TTABVUE 20). Petitioner announced unilateral changes to aspects of Dance Church, including the type of music that was played during the sessions. (34 TTABVUE 20). “Many of Dance Church’s

more senior volunteers, including those who maintained its websites and mailing lists, were unhappy with any new direction.” (34 TTABVUE 20, 23-29). At that point, Petitioner felt compelled to “make clear to the particular volunteers that they were just that and that Dance Church was a program of The 418 Project.” (34 TTABVUE 20). In response, some of the founding volunteers quit Dance Church. (34 TTABVUE 21, 23-29). The email messages of record demonstrating the discontent — and confusion — are reproduced below.

**Re: Let's make this a friendly separation**

R R <rusellerev@gmail.com>

Tue 6/29/2021 12:52 AM

To: Laura Bishop <laura@the418project.org>

Cc: Ted Merrill <dancer@embuild.org>; Adelman Gabrielle <Gigi@adelman.com>; Mark Schneider <mark@globalrecruiter.com>; beverly chang <beverlychang@hotmail.com>; Anahata Neuman <theauthenticityworkshop@gmail.com>; Kenneth Adelman <Adelman@Adelman.COM>; Michael Logue <drummedicine@gmail.com>; Scott Young <scottcoyo@gmail.com>; Sara Parker <sparker95060@gmail.com>; gspeed66@gmail.com <gspeed66@gmail.com>; Dennis Wheeler <gaza@gazabowen.com>; Stan Grindstaff <stan.grindstaff@gmail.com>; Abby Pistoni Community@The418Project.org <community@the418project.org>; Jim Brown <jim@artscouncilsc.org>; Paul Hoffman <paul.hoffman@gmail.com>; Theo <Theo@coyotedreams.com>; owlswan free eagle <owlswanfree@gmail.com>

Dear people,

I am saddened by how this time of coming back from Covid has commenced for us all.

I can imagine this happening in a very different way. If indeed one were writing to a dear one, (as you, Laura, start all your public letters) one might consider something more inviting and inclusive. In your mission to reach further out, it seems that you have forgotten to treat those close in with respect. What feels confusing to me is that as volunteers of Dance Church -- committed to serving the vision of community we created TOGETHER -- have been producing this magical event week after week, year after year, we have been gradually pushed out, pushed aside in our efforts to create a bridge with the 418 that is sustainable and inclusive. We tried with the open board meeting. Thank you to those of you who listened. We tried with mediation. Thank you (especially to Mark and) to those who spoke their truth. And thanks so much to Bev for working to be a liaison between Dance Church and the 418 (or whatever you're calling yourself now). What makes me feel so sad is that we used to be a WE. It was us who got the new building! (Special thanks to Laura and the Adelmans!) It was US creating a new reality, a model community center for people to feel included as part of growing something important. WE were the 418 Project. And yet, in these last few months it has felt more like us and them, like THEY bought the building and are creating the new space, and WE have been left out. I hear that community input is a priority here, and still we, the community, have not been invited to that table. At the mediation event I spoke that what I wanted was an invitation. I feel sad that I/we never received that, though we, the Dance Church community volunteers continued to produce the event called Dance Church in good faith that we might be invited back. Instead, we were actually informed (indirectly) that Dance Church would be happening in the new space next week. There was no invitation, no request to work together to create this important event. What I see happens when people don't feel appreciated or wanted is they leave. So, clearly your actions have spoken more loudly than your words. We have felt not needed or wanted by the 418, though quite the contrary with our dance community; we have felt very appreciated. And this dance community is who I am in service to.

I am writing this letter mostly to appreciate all the volunteers who have been working to make this thing called Dance Church happen, in some form or another. Along with my appreciation I would like to include a bit of information/education. One of the things I've heard Laura ask a lot is "Am I missing something?" I would say yes, you are. What I would say has been missing is the empathy

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<sup>19</sup> 34 TTABVUE 23-24. RR ("Russelle Revenaugh") is a longtime Dance Church volunteer. 34 TTABVUE 20.

and kindness and appreciation that volunteers need in order to continue working for something. I (as a core volunteer of DC) would like to model what could have worked, what might have made a huge difference, if only WE had the skills. I can imagine an invitation something like this:

**Hello Dear Ones,**

We recognize that you have been producing this event that we all hold dear (for different reasons) and we thank you! What has been created by the volunteers of Dance Church is a beautiful thing with a heart of its own. And though you might have guessed from our actions that we no longer want to have you serve this community in the way that you have been, we would like to honor you for all that you have done. In fact, we would really appreciate your **community input** at this time as we strive to create a new version of the beautiful thing you have created and run for us all these years. Since diversity and inclusion are at the top of our priority list now, we want to include YOU all in creating more diversity in this amazing community we share. Please join us for a brainstorming event next week and for a community dance the week after in order to move and be moved TOGETHER, since we all hold somatic expression as a high priority. Let's create this thing together; we need you, and we want to make a few changes. How can we work together to **create equitable outcomes** for our greater community? Our goal is to commence Dance Church in the new space in July. Is that something you might be willing/ready to get behind? Here's everything we know that might help to make that possible. And since you all voted a few years back to allocate all the Dance Church funds to the 418 Project, we will be happy to rent a space for you to dance in the meantime. Is there any other support you need to make this event happen, since you are the ones doing that every week? Thanks so much for handling that! We have a lot on our plates trying to get the new space together and dealing with legal and logistical matters. You are dear to us. You are the heart of this art community, and we know that.

You get the picture, right? Or, maybe you don't. Any ONE of these statements could have gone a long way toward our working together. Though it seems now that perhaps your intention all along was to have us go away so you could start the new Dance Church you have paid so much to trademark, without emotional expressions in the closing circle. Well, that is why some of us won't be joining you to celebrate our interdependence this 4th of July, sadly. I'm feeling very sad about many of the choices that have been made along this journey to build bridges as we come back from Covid to a new reality. It could have been SO different and SO beautiful!

I'm hoping we can all continue to learn from this experience and to continue to grow and perhaps to actually work together one day soon.

With genuine love and gratitude,  
Ruselle

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<sup>20</sup> *Id.*



**Re: Let's make this a friendly separation**

Kenneth Adelman <Adelman@Adelman.COM>

Mon 6/28/2021 4:05 PM

To: Paul Hoffman <paul.hoffman@gmail.com>

Cc: Merrill Ted <dancer@embuild.org>; Laura Bishop <laura@the418project.org>; Adelman Gabrielle <Gigi@adelman.com>; Schneider Mark <mark@globalrecruiter.com>; beverly chang <beverlychang@hotmail.com>; Ruselle Revenaugh (DC) <rusellerev@gmail.com>; Anahata Neuman (DC) <theauthenticityworkshop@gmail.com>; Michael Logue <drummedicine@gmail.com>; Scott Young <scottcoyo@gmail.com>; Sara Parker (DC) <sparker95060@gmail.com>

Paul, it appears that you have some of your own opinions about the right to the mark "Dance Church". I would strongly suggest that you find your own trademark attorney to give you advice on the matter.

The Dance Church mark has been used by The 418 Project since 2001. A few years ago a commercial dance school that I will refer to as "Wallich" (the owner's name) registered the trademark "Dance Church" and subsequently demanded that The 418 Project stop infringing on their trademark. The right to use a trademark does not come from \*registering it\*, but rather from \*using it\*. The 418 Project subsequently filed a legal action to cancel their trademark registration based on our prior use. The evidentiary part of the litigation is concluding, and it will be in front of a judge shortly for a decision. While nothing is certain, Wallich was not able to present any evidence of use prior to our use. The 418 Project has sworn testimony from many of our early Dance Church organizers that the name was, and has always been, a project of The 418 Project.

Dance Church is a valuable trademark of The 418 Project and we will defend it against any misuse, be it by Kate Wallich or any other party. We already have legal counsel who is assisting us in this matter.

Ken

> On Jun 28, 2021, at 7:49 AM, Paul Hoffman <paul.hoffman@gmail.com> wrote:

>

> I disagree with Ted about "Dance Church (418)" being a thing, so I don't see why the 418 needs to be a Facebook admin. If the 418 chooses to name their Sunday morning dance something that is not confusing (and for which they actually own the legal rights...), I could see them posting messages about it on the Facebook page just like other dance organizers do. (I haven't been on Facebook since last November, so I don't know what is and is not being allowed on the Dance Church page, so what I just said might be unrelated to reality.)

>

> On Sun, Jun 27, 2021 at 8:01 PM Ted Merrill <dancer@embuild.org> wrote:

> (adding Paul Hoffman to the thread)

>

> Hi Ken,

> I have nothing to do with the facebook page.

> To my understanding, the admins of the page do not consider it to be a Dance Church asset.

> I.e., it is about Dance Church but not owned by Dance Church (if Dance Church could actually own anything).

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<sup>21</sup> 34 TTABVue 26-27. Kenneth ("Ken") Adelman is a longtime Dance Church volunteer and the

> I think the admins of the page would be willing to have both Dance Church (418) and the new dance jam use the facebook page in harmony,  
> We can all, i hope, work out the names so that it does not confuse the members of our dance community.  
> Love, -Ted  
>  
>  
>  
>  
> On Sun, Jun 27, 2021 at 5:16 PM Kenneth Adelman <Adelman@adelman.com> wrote:  
>  
>  
>> On Jun 27, 2021, at 4:34 PM, Ted Merrill <dancer@embuild.org> wrote:  
>>  
>> Dear volunteers and staff at the 418,  
>>  
>> Thanks for all the good years at 418 Front St.  
>> Thanks to Mark and then Beverly for trying to see if a separation could be avoided.  
>> I totally wish the 418 project the best of luck with it's new vision regarding Dance Church.  
>> If it turns out to be something i like, I'll be happy to join in.  
>>  
>> I hereby resign all duties related to Dance Church.  
>> If you have any questions as to the email list, web site, or other Dance Church assets in your possession, please ask and i'll try to give helpful answers.  
>  
> Could you please make me an admin/owner of the Facebook "DC (Dance Church)" group?  
>  
> Ken  
>

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### 3. Testimony of Frederick (“Rick”) Kuhn

Frederick Kuhn is an actor, writer, producer, video artist, and former Santa Cruz Dance Church dancer and volunteer. (35 TTABVUE 27-28, 42, 45). He started participating regularly in Santa Cruz Dance Church events sometime in 2002, and provided volunteer videography services to Dance Church from 2002 until approximately 2012. (35 TTABVUE 42). Kuhn edited the videos he took for Dance Church and showed them at a 2011 event to celebrate its ten year anniversary, which was not held at

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husband of the president of Petitioner’s board of directors. 34 TTABVUE 20-21. Paul Hoffman and Ted Merrill are also longtime Santa Cruz Dance Church volunteers. 30 TTABVUE 296.

<sup>22</sup> 34 TTABVUE 26-27.



Petitioner's building. (35 TTABVUE 15-16). He later uploaded the videos to YouTube. (35 TTABVUE 15).

Kuhn testified that in 2003, he created and purchased the DanceChurch.org domain name and redirected that domain to the page for the Santa Cruz Dance Church Yahoo! Group. (35 TTABVUE 23- 24). Around the same time, Kuhn says that he "gifted" the DanceChurch.org domain to Petitioner, but he has not produced any evidence supporting such a gift. (35 TTABVUE 24). Nevertheless, he recalls that Petitioner did not require, or direct, him to maintain the DanceChurch.org website or the Yahoo! Group, nor did Petitioner direct him as to what content should be put on the DanceChurch.org site or the Yahoo! Group page. (35 TTABVUE 24- 25).

However, Kuhn then testified that he initiated and maintained, until 2015, the DanceChurch.org website, and moderated, until 2019, the Dance Church Yahoo! Group under Petitioner's "aegis," with Petitioner providing "help and support" and "suggestions" for both the website and the Yahoo! Group. (35 TTABVUE 29- 31, 43). Kuhn further testified that he moderated the Dance Church Facebook group from 2009 until 2019, again under Petitioner's "aegis," which he understood to mean that Petitioner could post content to the Dance Church Facebook page "in collaboration with the Dance Church group." (35 TTABVUE 26-27, 31, 43). Below are cropped printed copies of the DanceChurch.org Yahoo! Group page as of Aug. 2, 2011, from archive.org (25 TTABVUE 12-13) and the Dance Church Facebook page as of November 2020 (30 TTABVUE 280).

DanceChurch · DanceChurch.org

- [Home](#)
- [Links](#)
- [Calendar](#)


Members Only

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- [Post](#)
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- [Database](#)
- [Polls](#)
- [Members](#)
- [Promote](#)
- [Groups Labs \(Beta\)](#)
- [Chat](#)

Info [Settings](#)

Group Information

Members: 481  
 Category: [New Age](#)  
 Founded: Aug 10, 2003  
 Language: English

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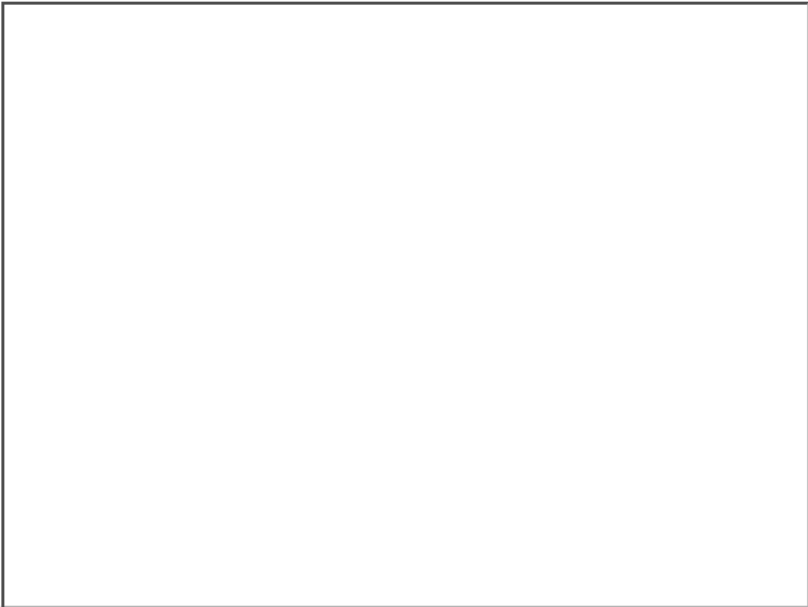
Home

[Join This Group!](#)

Activity within 7 days: **3** New Members - **23** New Messages - [New Questions](#)

Description

The DJ is the minister, the music is the sermon, the dancers are the



congregation.

Since 2001, a spiritual dance jam has occurred every Sunday morning from 9 to 11:30 AM at the 418 Project, 418 Front Street in Santa Cruz, California. In its tenth year, Santa Cruz Dance Church added a Saturday service at the same time and place. Periodic sessions are also offered in other Santa Cruz County locations. Plenty of opportunities to join the congregation.

Suggested donation is \$10. All are welcome.

Request a subscription to the eGroup by sending e-mail to [DanceChurch-owner@yahoogroups.com](mailto:DanceChurch-owner@yahoogroups.com) or by going to the web site at <http://DanceChurch.org> and clicking on "Join This Group."

See you on Sunday!

### Message History

	Jan	Feb	Mar	Apr	May	Jun	Jul	Aug	Sep	Oct	Nov	Dec
2011	90	73	119	103	118	93	86	5				
2010	89	61	105	120	154	90	70	91	115	114	106	85
2009	64	50	84	77	182	94	63	81	81	59	96	46
2008	34	35	28	19	17	32	23	16	36	54	54	38
2007	8	16	12	30	18	19	5	35	9	23	18	16
2006	10	3	18	4	8	10	1		4	2	8	11
2005		17	15	6	13	4	9	7	1	3	8	6
2004	2	10	30	37	25	13	9	22	3	5	7	3
2003								12	1	6	18	5

### Yahoo! Answers [What's this?](#)

#### What is Yahoo! Answers?

Yahoo! Answers, a new Yahoo! community, is a question and answer exchange where the world gathers to share what they know...and make each other's day. People can ask questions on any topic, and help others out by answering their questions.

[Hide this tip](#)

### Questions in All Categories

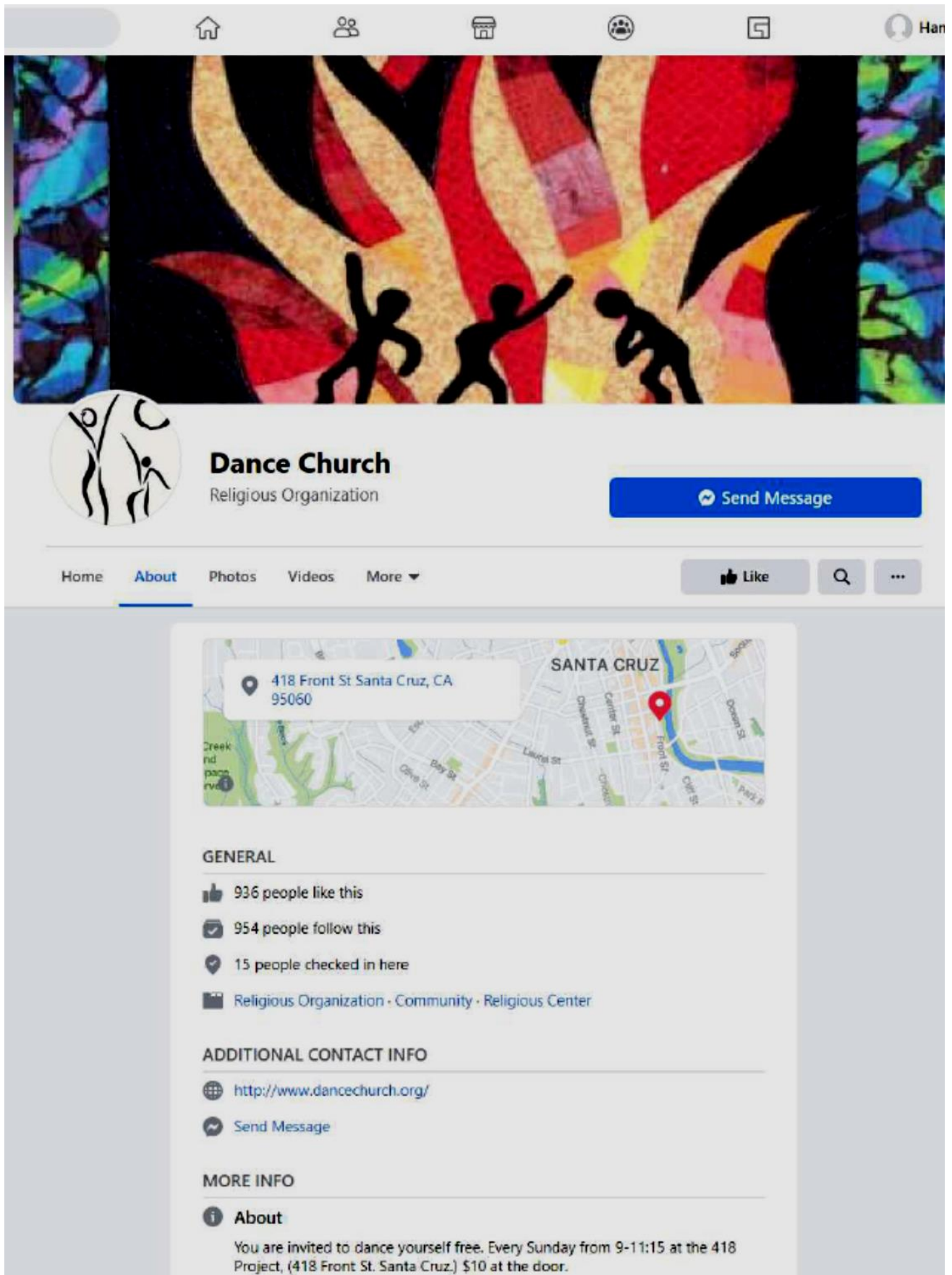
Questions are currently unavailable.

-----  
**Want to help answer other questions? Go to [Yahoo! Answers](#)**

### Group Email Addresses

Related Link: <http://www.facebook.com/group.php?gid=58470451795>  
Post message: [DanceChurch@yahoogroups.com](mailto:DanceChurch@yahoogroups.com)  
Subscribe: [DanceChurch-subscribe@yahoogroups.com](mailto:DanceChurch-subscribe@yahoogroups.com)  
Unsubscribe: [DanceChurch-unsubscribe@yahoogroups.com](mailto:DanceChurch-unsubscribe@yahoogroups.com)  
List owner: [DanceChurch-owner@yahoogroups.com](mailto:DanceChurch-owner@yahoogroups.com)

[Join This Group!](#)



The image shows a screenshot of a Facebook profile for "Dance Church". At the top, there is a navigation bar with icons for home, friends, a church, a group, a post, and a profile. The profile picture is a circular logo with stylized figures. The cover photo is a vibrant, abstract painting with silhouettes of dancers. Below the cover photo, the name "Dance Church" is displayed in bold, followed by "Religious Organization" and a blue "Send Message" button. A navigation menu includes "Home", "About" (which is selected), "Photos", "Videos", and "More". To the right of the menu are buttons for "Like", a search icon, and a three-dot menu. The main content area features a map of Santa Cruz, CA, with a red pin at "418 Front St Santa Cruz, CA 95060". Below the map, the "GENERAL" section lists: "936 people like this", "954 people follow this", "15 people checked in here", and "Religious Organization · Community · Religious Center". The "ADDITIONAL CONTACT INFO" section includes the website "http://www.dancechurch.org/" and a "Send Message" button. The "MORE INFO" section has an "About" link. The "About" text reads: "You are invited to dance yourself free. Every Sunday from 9-11:15 at the 418 Project, (418 Front St. Santa Cruz.) \$10 at the door."

**Dance Church**  
Religious Organization

418 Front St Santa Cruz, CA 95060

**GENERAL**

- 936 people like this
- 954 people follow this
- 15 people checked in here
- Religious Organization · Community · Religious Center

**ADDITIONAL CONTACT INFO**

- <http://www.dancechurch.org/>
- Send Message

**MORE INFO**

**About**

You are invited to dance yourself free. Every Sunday from 9-11:15 at the 418 Project, (418 Front St. Santa Cruz.) \$10 at the door.

Kuhn has never been employed by Petitioner, he has not been a party to any contract or other agreement with Petitioner, and he has never had any reporting obligations or duties to Petitioner. (35 TTABVUE 13-15). Generally, he is not “personally familiar” with the relationship between Petitioner and the Santa Cruz Dance Church volunteers. (35 TTABVUE 21). He testified that he is aware, based on an interview with Dance Church co-founder and volunteer Syndulko, of an original agreement between Petitioner and the Santa Cruz Dance Church volunteers, but he does not know the content of that agreement. (35 TTABVUE 18). He is not aware of any contract or agreement between Petitioner and the Santa Cruz Dance Church volunteers that limited where Dance Church could meet, the types of events Dance Church could hold, or how the DANCE CHURCH mark or name could be used. (35 TTABVUE 18-20).

Kuhn stopped regularly attending Dance Church events “around 2016.” (35 TTABVUE 15). He last attended a Dance Church event in 2021. (35 TTABVUE 16).

**C. Petitioner and the Santa Cruz Dance Church Volunteers Are Not Related Companies.**

In short, Petitioner argues that it and the Santa Cruz Dance Church volunteers are related companies. (38 TTABVUE 14-16). The evidence compels us to conclude otherwise.

After our review of what can be best characterized as inconsistent or contradictory testimony offered by witnesses Bishop and Kuhn, after weighing all of the evidence, we find that Petitioner and the Santa Cruz Dance Church volunteers (and by extension, the DCC), were never related companies within the meaning of Section 45 of the Trademark Act. As Petitioner is relying on alleged prior common law rights to establish the Santa Cruz Dance Church volunteers as a “related company,” and not its pending intent-to-use

application to register DANCE CHURCH, Section 5 of the Trademark Act, 15 U.S.C. § 1055, is inapplicable here, because Section 5 pertains to the assertion of registrations or pending applications to establish priority. Petitioner claims it first used the DANCE CHURCH mark, through the actions of the Santa Cruz Dance Church volunteers, in the year 2000. Petitioner's pending application to register DANCE CHURCH was filed in 2018, long after Respondent's December 21, 2010 priority date.

First, there was no express trademark or service mark license, or any assignment of rights, between Petitioner and the Santa Cruz Dance Church volunteers. The only contract between Petitioner and the volunteers was a "fiscal sponsorship agreement" dated September 1, 2011 — nearly nine months after Respondent's December 21, 2010 priority date — that was silent as to the use of the DANCE CHURCH name or mark, or the provision of services relating thereto.

Much of the documentary evidence and deposition testimony supports a finding that Petitioner itself did not use the DANCE CHURCH mark on or before Respondent's priority date, December 21, 2010. "The related companies doctrine requires a showing of a substantial relationship between [the parties]." *Secular Orgs. For Sobriety, Inc. v. Ullrich*, 213 F.3d 1125, 54 USPQ2d 1851, 1855 (9th Cir. 2000) (where there was no control exerted by plaintiff over defendant's predecessors, no agreements binding plaintiff and defendant's predecessors, no financial connections between plaintiff and defendant's predecessors, and only "loose connections," plaintiff and defendant were not related companies, so defendant's use of marks did not inure to benefit of plaintiff) (citing 15 U.S.C. § 1055). For companies to be considered "related," the Lanham Act "does not expressly require formal corporate control." *Estate of Coll-Monge v. Inner Peace Movement*, 524 F.3d 1341,

86 USPQ2d 1598, 1602 (D.C. Cir. 2008). “Instead, the statute requires control over only the ‘use of a mark . . . with respect to the nature and quality of the goods or services,’ (internal citation omitted), which may include not only corporate control but also licensing agreements and other types of oversight.” *Id.* (citing 2 J. Thomas McCarthy, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 18:51 (4th ed. 2005) (term “related” “is not limited to control of a company in general” but “simply refers to control over the ‘nature and quality of the goods and services in connection with which the mark is used.’”) (other citations and internal citations omitted)). *See also In re Pharmacia Inc.*, 2 USPQ2d 1883, 1884 (TTAB 1987) (use of a mark by a sister corporation does not automatically inure to the other sister corporation; there must be sufficient facts in the record relative to common ownership as well as control over the nature and quality of the goods and services). The United States Court of Appeals for the Federal Circuit has construed the statutory requirement of “control” to mean “such control as is practicable under all the circumstances of the case,” which is a question of fact. *Midwest Plastic Fabricators, Inc. v. Underwriters Labs., Inc.*, 906 F.2d 1568, 15 USPQ2d 1359, 1363 (Fed. Cir. 1990).

Despite Santa Cruz Dance Church founding member and volunteer Jim Brown’s employment as Petitioner’s Executive Director from 2004 through 2007, most of the evidence of record supports a finding that the Santa Cruz Dance Church volunteers and the services offered under the DANCE CHURCH mark were not operated or controlled by Petitioner prior to Respondent’s December 21, 2010 priority date.

According to Brown, whose testimony we find to be particularly probative, it was the inherent nature of Dance Church to eschew any formality: no one registered Dance Church as a business, nonprofit, or any sort of formal entity; no attendance records were kept; and

the deejay, creators of the altar, door attendants, and session contributors were “coordinated” by other Santa Cruz Dance Church volunteers. Brown described Dance Church as a “self-organizing system.”

Initially, Dance Church had no source of revenue or income other than voluntary donations collected at the door; it was “simply agreed” among the volunteers that all of the contributions would go to Petitioner since Dance Church paid no rent or fees to Petitioner for using its facilities. And even though the group met at Petitioner’s 418 Front Street building for many years, the Santa Cruz Dance Church volunteers and Petitioner never executed a lease. When Dance Church started to become profitable, the volunteers started paying their fellow volunteers who served as deejays and door attendants.

Around the same time, the Santa Cruz Dance Church volunteers organized the DCC to better manage the growing monetary donations collected by Dance Church. It was the DCC that approached Petitioner about entering into a “fiscal sponsorship” of Dance Church. But on November 21, 2010, one month before Respondent’s priority date, the DCC explored having Dance Church sessions held at locations other than at Petitioner’s headquarters. (25 TTABVUE 5, 17).

Finally, according to Brown, there was no agreement, formal or informal, between Petitioner and the Santa Cruz Dance Church volunteers that restricted or limited how the volunteers could use the DANCE CHURCH mark or name. The volunteers created promotional flyers without input from Petitioner. Petitioner advertised, sporadically, Dance Church in the free calendar of the local Santa Cruz newspaper. But the Dance Church email listserv, which was used to communicate with Santa Cruz Dance Church volunteers, attendees, and members of the public generally, was created and managed by



a Santa Cruz Dance Church volunteer not acting on behalf of Petitioner, and not taking direction from Petitioner. And as late as November 21, 2010, the DCC considered changing the name of Dance Church to address public “negativity” and “confusion” surrounding the word “church,” but eventually declined to do so. (25 TTABVUE 5, 17).

Moreover, the quarterly schedule of classes, on which Petitioner’s name, logo, and website are prominently featured, does not include any information about the specific classes offered at Petitioner’s headquarters: the fees for each class varied, and consumers were required to call particular instructors directly (at various telephone numbers) for any information about the classes. Therefore, despite his opinion that Petitioner had “authority” solely because it “controlled the space” where Dance Church met, overall, we find that Brown’s testimony strongly supports a conclusion that Petitioner did not exert sufficient (or perhaps any) legitimate control over the Santa Cruz Dance Church volunteers and the nature and quality of the services they provided under the DANCE CHURCH mark, nor did Petitioner exert the type of de facto control over the Santa Cruz Dance Church volunteers and the nature and quality of the services they provided under the DANCE CHURCH mark sufficient to support a conclusion that Petitioner and the volunteers were related companies prior to Respondent’s priority date of December 21, 2010. *See, e.g., Secular Orgs. For Sobriety*, 54 USPQ2d at 1855; *see also In re Pharmacia*, 2 USPQ2d at 1884.

In contrast, we find the testimony of Rick Kuhn to be contradictory, and therefore, less probative than Brown’s testimony. *See B.R. Baker Co. v. Lebow Bros.*, 150 F.2d 580, 66 USPQ 232, 236 (C.C.P.A. 1945) (Oral testimony, if sufficiently probative, may suffice to prove priority, but such testimony “is obviously strengthened by corroborative

documentary evidence, and it should not be characterized by contradictions, inconsistencies, and indefiniteness, but should carry with it conviction of its accuracy and applicability.”) (citation omitted). Kuhn testified that he initiated and maintained, until 2015, the DanceChurch.org website, and moderated, until 2019, the Dance Church Yahoo! Group under Petitioner’s “aegis,” with Petitioner providing “help and support” and “suggestions” for both the website and the Yahoo! Group. Kuhn also testified that he moderated the Dance Church Facebook group from 2009 until 2019, again under Petitioner’s “aegis.” However, Kuhn also testified that he, without input or any direction from Petitioner, made and maintained editorial decisions about content for the DanceChurch.org website and the Yahoo! Group. And although he testified that he gifted the DanceChurch.org domain to Petitioner in 2003, the record lacks any documentary evidence of such a gift. The record shows that Petitioner registered the DanceChurch.org domain on April 4, 2016. (34 TTABVUE 16-17).

We ascribe even less probative value to the testimony of Laura Bishop, Petitioner’s Executive Director and 30(b)(6) witness. Her testimony was rife with contradictions and inconsistencies. Bishop generally portrays Dance Church (as well as actions undertaken on its behalf) as simply a “volunteer event benefitting The Four Eighteen Project.” But her testimony does corroborate Brown’s testimony with respect to the following facts: the DanceChurch.org website, which is separate from Petitioner’s website, is not operated or maintained by Petitioner; there is no attendance sheet for Dance Church sessions; the Santa Cruz Dance Church volunteers never paid a rental fee to use Petitioner’s building; the Santa Cruz Dance Church listserv is maintained by Santa Cruz Dance Church volunteers; Petitioner has no marketing or branding strategy for Dance Church; and

longtime Santa Cruz Dance Church volunteers stopped participating in 2021 when Petitioner announced that it wanted to make changes to core aspects of Dance Church, including the music that was played during the sessions.

In fact, email communications in the record from 2021 demonstrate that the longtime Santa Cruz Dance Church volunteers viewed Dance Church as a collective “community,” not a program owned and controlled by Petitioner. Although Bishop characterized the need for a fiscal sponsorship agreement as the result of Dance Church becoming a “larger and larger source of funds for The Four Eighteen Project,” under the facts of this case, we find the existence of a fiscal sponsorship agreement between Petitioner and the Santa Cruz Dance Church volunteers does not support a finding that Petitioner controlled, or had the right to control, the activities of the volunteers, or that they were “related companies.”

For the same reasons, we find that there was no implied license between Petitioner and the Santa Cruz Dance Church volunteers for use of the DANCE CHURCH mark either. *Cf. Sock It To Me, Inc. v. Fan*, 2020 USPQ2d 10611, at \*6 (TTAB 2020) (oral license between individual applicant and family business whose CEO was applicant’s daughter-in-law was a valid license with adequate quality control and not a naked license; “[a]n informal, rather than formal, system of quality control may suffice. ... This holds true especially where the licensor and licensee have a close working relationship, such as a familial relationship.”); *In re Raven Marine, Inc.*, 217 USPQ 68 (TTAB 1983) (where applicant argued that use of a mark by another company pursuant to an oral license inured to applicant’s benefit, Board found that the other company was not a “related company,” nor did use inure to applicant’s benefit in the absence of an agreement providing for proper and effective controls by applicant over the use of the trademarks and nature and quality

of the services rendered thereunder). *See also Dept. of Parks and Recreation for the State of Cal. v. Bazaar Del Mundo Inc.*, 448 F.3d 1118, 78 USPQ2d 1887, 1895-99 (9th Cir. 2006) (Minimal control and supervision was an insufficient basis to support inference of implied licensing agreement between defendant entrepreneur and plaintiff State of California for use of CASA DE BANDINI and CASA DE PICO as marks in operation of a restaurant at a state-owned historic park, where plaintiff did not control or supervise the quality of food and services, which were the most critical aspects of building goodwill and value in the provision of restaurant services.).

Specifically, in *Sock It To Me*, the applicant, who manufactured socks in China under the SOCK IT UP mark, communicated oral instructions to her daughter-in-law on a daily basis, detailing how to use the same SOCK IT UP mark on the socks that her daughter-in-law's company offered for sale in the United States. In addition, applicant orally communicated to her daughter-in-law, also on a daily basis, sourcing, manufacturing, and quality control information so that the SOCK IT UP branded-socks that were offered in the United States would meet stringent quality standards. *See id.* at \*5-6. The Board found that the relationship between applicant and the daughter-in-law, along with the control applicant exercised over the nature and quality of the socks marketed by the American company under the SOCK IT UP mark, was sufficient to find applicant to be a licensor, and the American company to be a licensee as well as a "related company" within the meaning of Section 5 of the Trademark Act.

In contrast, here, the record does not reflect that Petitioner exerted similar (if any) quality control over the actions of the Santa Cruz Dance Church volunteers when the volunteers offered classes under the DANCE CHURCH mark. Consequently, we find that

Petitioner and the Santa Cruz Dance Church volunteers were not “related companies,” since Petitioner did not legitimately control, or have the right to control, the actions of the Santa Cruz Dance Church volunteers, or the nature and quality of the services offered by the volunteers under the name “Dance Church,” prior to Respondent’s priority date of December 21, 2010.

**D. Petitioner and the Santa Cruz Dance Church Volunteers Are Not In Privity.**

Petitioner also contends that it is “in privity with the Dance Church volunteers, so that their use of the mark inured to it.” (38 TTABVUE 13).

“Privity” is defined as “the connection or relationship between two parties, each having a legally recognized interest in the same subject matter (such as a transaction, proceeding, or piece of property); mutuality of interest.”<sup>23</sup> In practice, “[w]hat constitutes ‘privity’ varies, depending on the purpose for which privity is asserted.” *Warren Dist., Inc. v. Royal Purple, LLC*, 115 USPQ2d 1667, 1668 (TTAB 2015) (citing *Shamrock Techs. Inc. v. Med. Sterilization Inc.*, 903 F.2d 789, 14 USPQ2d 1728, 1732 (Fed. Cir. 1990)). “In trademarks, the concept of privity generally includes, **inter alia**, the relationship of successive owners of a mark (e.g., assignor and assignee, or survivor of a merger) and the relationship shared by ‘related companies’ within the meaning of Sections 5 and 45 of the Trademark Act.” *Id.* (italics in original) (citing *Int’l Nutrition Co, v. Horphag Research Ltd.*, 220 F.3d 1325, 55 USPQ2d 1492, 1495 (Fed. Cir. 2000) (transfer of rights in mark controls question of whether two entities are in privity), and *Renaissance Rialto Inc. v. Boyd*, 107 USPQ2d 1083, 1087 (TTAB 2013) (entities were not in privity; “[A]cquisition of another’s right to

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<sup>23</sup> *Privity*, BLACK’S LAW DICTIONARY (11th ed. 2019).

oppose, independent of a transfer of rights to a trademark and its associated goodwill, is an insufficient basis upon which to claim the benefit of the transferor's personal privilege in an extension of time to oppose an application.”)).

As discussed previously, Petitioner, on its own, did not create a legally recognized interest in the DANCE CHURCH mark on or before December 21, 2010. Petitioner and the volunteers did not enter into a license (express or implied) or assignment of the DANCE CHURCH mark on or before December 21, 2010. Petitioner did not plead analogous use. Therefore, we find that Petitioners and the Santa Cruz Dance Church volunteers are not in privity.

## **V. Conclusion**

The evidence of record demonstrates that Petitioner and the Santa Cruz Dance Church volunteers are not “related parties” as that term is defined in Section 45 of the Trademark Act: Petitioner did not control the volunteers' use of the DANCE CHURCH mark on or before December 21, 2010, and Petitioner did not use the DANCE CHURCH mark on its own, without the volunteers, on or before December 21, 2010. Nor are Petitioner and the Santa Cruz Dance Church volunteers in privity. Petitioner therefore has failed to establish proprietary rights in the asserted mark DANCE CHURCH. Consequently, Petitioner cannot prevail on its sole claim of likelihood of confusion.

**Decision:** The Petition for Cancellation is denied.