

TTAB

Ref. No. 21749.03

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In re: Applications Serial Nos. 76/295,724
Filed: August 6, 2001
For the Mark **BLUEMAN**
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BLUE MAN PRODUCTIONS, INC.,

Opposer,

v.

ERICH TARMANN,

Applicant

Opposition No. 154,055

**RESPONSE TO APPLICANT'S
MOTION TO STRIKE OPPOSER'S
NOTICE OF RELIANCE AND
MOTION TO DISMISS FOR
FAILURE TO PROSECUTE, FOR
JUDGMENT ON THE PLEADINGS
OR ALTERNATIVELY,
FOR SUMMARY JUDGMENT**

Box TTAB FEE
Assistant Commissioner for Trademarks
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Arlington, VA 22202-3513

Pursuant to Rule 2.127(a), Blue Man Productions, Inc. ("Opposer") hereby submits this combined Response to Applicant's Motion to Strike Opposer's Notice of Reliance, and Applicant's Motion to Dismiss for Failure to Prosecute, for Judgment on the Pleadings, or Alternatively, for Summary Judgment, both motions dated February 23, 2004.

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Factual Background

Opposer is the owner of the renowned and federally registered mark BLUE MAN GROUP in the United States, which has been used in connection with a wide variety of goods and services including many varieties of entertainment services throughout the United States.

Commencing long prior to March 6, 2000, Applicant's claimed first use date, Opposer has extensively promoted and advertised the sale of goods and services using its BLUE MAN GROUP mark, and has sold such goods and rendered such services in commerce in the United States. As a result of the extensive sales and promotion of its goods and services using its BLUE MAN GROUP mark, Opposer has built up highly valuable goodwill for its BLUE MAN GROUP mark, and has built a reputation for excellence and high quality. Opposer's advertising and promotional efforts have brought the BLUE MAN GROUP mark high recognition and visibility among consumers.

The BLUE MAN GROUP mark has been widely used by Opposer, the press and the public to identify Opposer and its products and services. Hundreds of examples of "printed publications" concerning the BLUE MAN GROUP mark were identified in Opposer's January 21, 2004 Notice of Reliance pursuant to Rule 2.122(e). Widespread recognition of the BLUE MAN GROUP mark has thereby been achieved. Based on this use and widespread fame, the BLUE MAN GROUP mark has become closely and uniquely identified and associated with Opposer. On August 6, 2001, Applicant Erich Tarmann filed an application to register BLUEMAN for "tobacco, smokers' articles, namely cigarettes" (Application Serial No. 76/295,724). Opposer believes that Applicant was aware of the BLUE MAN GROUP mark and selected BLUEMAN as a mark in order to exploit the national fame of the BLUE MAN GROUP

mark. Further, the goods covered by the Application are closely related to Opposer's goods and services associated with its BLUE MAN GROUP mark.

Applicant's BLUEMAN mark so resembles Opposer's BLUE MAN GROUP mark, so as to be likely, when applied to Applicant's goods, to cause confusion, to cause mistake, and to deceive because the public is likely to believe that Applicant's goods have their origin with Opposer and/or that such goods are approved, endorsed or sponsored by Opposer or associated in some way with Opposer. Opposer would thereby be injured by the granting to Applicant certificates of registration for Applicant's BLUEMAN mark.

The BLUE MAN GROUP mark is both famous and distinctive, and was so prior to March 6, 2000, Applicant's claimed first use date. Due to the national repute of the BLUE MAN GROUP mark, Applicant's BLUEMAN mark will dilute the distinctive quality of the BLUE MAN GROUP mark.

Opposer would be injured by the granting of such registration because it may tend to damage Opposer's valuable goodwill and reputation for excellence and high quality in the BLUE MAN GROUP mark. Opposer would be further injured by the granting of a certificate of registration because Applicant's mark is nearly identical to Opposer's BLUE MAN GROUP mark, and Applicant's BLUEMAN mark would falsely suggest a connection between Applicant's mark and Opposer.

Therefore, on December 3, 2002, Opposer filed a Notice of Opposition opposing the registration of Applicant's BLUEMAN mark. On January 21, before the close of Opposer's testimony period, Opposer submitted two notices of reliance and hundreds of pages of documentary evidence as testimony in support of its opposition. On February 23, 2004, before

the close of the time for the taking of Applicant's testimony, Applicant filed two motions, namely, a Motion to Strike Opposer's Notice of Reliance, and a Motion to Dismiss for Failure to Prosecute, for Judgment on the Pleadings, or Alternatively, for Summary Judgment. These motions should both be denied, as discussed seriatim below.

A. Motion to Strike Opposer's Notice of Reliance

1. Failure to Specify Relevance

Applicant contends that Opposer's Notice of Reliance pursuant to Trademark Rule 2.122(e) is objectionable because it "does not specify the 'relevance' of the listed items." This contention is contradicted by the Notice itself. The Notice of Reliance at issue clearly states that the listed items "are offered to show that Opposer's mark BLUE MAN GROUP, used in connection with entertainment services and related merchandise, [has] been the subject of numerous articles and broadcasts in publicly circulated media." Notice of Reliance at 1-2. *See* Rule 2.122(e) requires only that the notice "indicate generally the relevance of the material," and Opposer's Notice clearly satisfies that standard.

Should the TTAB conclude that this statement does not satisfy the requirement of Rule 2.122(e) that the relevance be indicated, this defect is curable and opposer should be allowed to cure. *See Weyerhaeuser Co. v. Katz*, 24 U.S.P.Q. 1230, 1233 (TTAB 1992); TTABMP Rule 533 (when a procedural objection is made to a notice of reliance, "if the Board finds that the notice is defective, but that defect is curable, the Board may allow the party which filed the notice of reliance time in which to cure the defect"). As such, if the TTAB concludes that the notice is defective, the TTAB should grant Opposer time and the opportunity to cure the defect. *Id.*

2. The Documents Identified By Opposer Are Printed Publications

Out of several hundred publications submitted by Opposer, Applicant contends that “numerous” of these items are not “printed publications” within the meaning of the Federal Rules of Evidence or the Rules of Practice of the United States Patent and Trademark Office.

Applicant only identifies with any specificity a few items, namely, a “List of Television and Radio Coverage,” press releases identified as “BLUE MAN GROUP – Live at Luxor,” and generally listed by Applicant, several news service bureau releases. As an initial matter, even if these few items are stricken, hundreds of documents which are indisputably “printed publications” would remain in the record and would provide compelling evidence in support of Opposer’s claims.

Additionally, the few items identified by Applicant do indeed qualify as “printed publications” because they were available to the general public from a third party. The vast majority of the press releases have been circulated by news services, or have otherwise been readily accessible to the public, and therefore they qualify as “printed publications.” See Rule 2122(e). To the extent that any of these documents do not qualify on their face as “printed publications,” Opposer will show in its rebuttal testimony period, which has yet to begin, that such publications otherwise qualify as “printed publications” under Rule 1.222(e).

Applicant also argues that many of the listed items should be stricken because they are not accompanied by any authenticating testimony. This contention is premature. Opposer’s rebuttal testimony period was set to begin at the end of April and close on May 6, 2004. Therefore, to the extent that the Board determines that any such authenticating testimony is needed, Opposer proposes to submit such testimony during its rebuttal period. In the alternative,

Opposer respectfully requests additional time for its initial testimony period to provide an opportunity to cure.

3. There Is No Hearsay Or Other Evidentiary Problem

Applicant's contention that "none of the documents in opposer's second Notice of Reliance overcomes the hearsay exclusion" is simply a re-hashing of its previous arguments regarding authenticating testimony and relevance and should be denied for the reasons previously stated. Further, these documents are not being used for a hearsay purpose, namely, proving the truth of what they say, and are entirely admissible as documentation of events and publicity. *See* Fed. R. Evidence 801(c).

Additionally, this claim is premature. As the TTAB has stated, the "Board does not read testimony and consider substantive objections to evidence or determine the probative value of evidence prior to final hearing." *Weyerhaeuser Co. v. Katz*, 24 U.S.P.Q. 1230, 1233.

Applicant's request that the TTAB depart from its practice of "reserve[ing] ruling on these types of questions [until] a final hearing," Applicant's Motion at 4, elucidates exactly the reason for the practice -- it is important, if not essential, to wait until after all testimony has been taken before determining whether there is a lack of authenticating testimony. Because Opposer's time for rebuttal testimony has not closed, the Board should continue its normal practice and allow Opposer the opportunity to submit testimony that would cure an evidentiary defect, if any.

Applicant also incorrectly asserts that the documents submitted by Opposer must demonstrate "actual dilution," relying on *Moseley, et al. v. V Secret Catalogue, Inc.*, 537 U.S. 418 (2003) for that proposition. However, the TTAB has already ruled that "a plaintiff that establishes its ownership of a distinctive and famous mark may prevail upon a showing of

likelihood of dilution” in a TTAB proceeding. *The NASDAQ Stock Market, Inc. v. Antartica, S.r.l.*, Opposition No. 91121204 to application Serial No. 75/546,122 filed on September 1, 1998, 2003 TTAB LEXIS 391, *56 (TTAB June 30, 2003). The TTAB reviewed the Court’s decision in *Moseley* and concluded that:

Section 13 allows oppositions by any person "who believes that he *would be* damaged ... including as a result of dilution," and Section 14 allows cancellation actions "by any person who believes that he *is or will be damaged*, including as a result of dilution..." (emphasis added [by TTAB]). The inescapable conclusion is that Congress intended to limit judicial relief under the FTDA to cases where dilution has already occurred but to allow cases involving prospective dilution to be heard by the Board. We see no holding or statement in *Moseley* that runs counter to this conclusion.

Id. at *57-58 (underscoring added). Indeed, the Solicitor General of the United States was clear in his *amicus* filing on this issue that in contrast to a proceeding seeking judicial relief, “a person may complain to the PTO about the possibility of dilution before the dilution has occurred.”

Brief for the United States as *Amicus Curiae* Supporting Petitioners In Part at 15, *Moseley, et al. v. V Secret Catalogue, Inc.*, 537 U.S. 418 (2003). Thus, as the TTAB has decided, and as echoed by the Solicitor General of the United States, an opposer before the PTO need not show actual dilution, but only the likelihood of dilution. Therefore, Applicant’s contentions to the contrary are incorrect as a matter of law.

4. The Documents Were Published In A Relevant Time Period

Applicant contends that because its adoption and use of the BLUEMAN mark occurred in 1997 with registration of the mark in a foreign country under the Madrid Protocol, and because the United States acceded to the Protocol in 2003, documents subsequent to 1997 are not relevant to the opposition proceeding. Aside from this evidentiary objection being unripe, as stated above, it is flatly wrong as a matter of law. The United States’ new and amended rules under the

Madrid Protocol became effective on November 2, 2003, and therefore as a baseline, Applicant cannot use those rules to tack back to its foreign application prior to that date.

Moreover, the Protocol does not alter the dates of use in the United States. Applicant has cited absolutely no authority in support of its assertion that it should be allowed to claim a use date 3 years prior to the date of any actual use in the United States. Applicant concedes that its first use in the United States was, at the earliest, March 6, 2000. Applicant's Motion at fn. 5. Therefore, if there can be any date prior to November 2, 2003 after which documents cease to be relevant, March 6, 2000 would be the operative date.

B. Motion To Dismiss For Failure To Prosecute, For Judgment On The Pleadings, Or Alternatively, For Summary Judgment

1. Opposer Has Prosecuted And Offered Meaningful Evidence

Applicant moves to dismiss pursuant to Rule 2.132(b), which allows a motion to dismiss to be filed if "no evidence other than a copy or copies of Patent and Trademark Office records is offered" by the other party. This motion is both untimely and unsupported by the facts.

Rule 2.132(c) states that a motion to dismiss under Rule 2.132(b) "must be made before the opening of the testimony period of the moving party . . ." Pursuant to stipulation of the parties, Applicant's testimony period was set to open on February 21, 2004. Applicant filed this motion February 23, 2004, two days later. Even assuming that February 21, 2004 is not the correct date (because it is a Saturday), February 23, 2004 would, at the earliest, be the first day of Applicant's testimony period and therefore not "before [its] opening." Accordingly, Applicant's motion is untimely.

Even assuming Applicant's motion to dismiss were found to be timely, it still fails on the merits. Opposer has indeed submitted voluminous evidence and documentation to show the

strength and fame of its mark. As set forth in Opposer's Notice of Reliance, Opposer has since 1988 been the subject of extensive press coverage in leading national publications such as Vanity Fair, The New York Times, Details, The Village Voice, New York Magazine, Business Week, People, Playboy, Time, The New Yorker, Esquire, TV Guide, Vogue, Cosmopolitan, GQ, Child, Billboard, and the major newspapers of many large U.S. cities. Opposer has been featured on the cover of Rolling Stone, the Times Square video billboard in New York City, The Tonight Show with Jay Leno, Live with Regis & Kathie Lee, Entertainment Tonight, the Grammy Awards broadcast, CBS Sunday Morning and The Simpsons. In addition, Opposer has been featured in a series of television advertisements for Intel, which have aired to hundreds of millions of viewers.

In the light of such overwhelming evidence, Opposer respectfully submits that the strength and fame of its mark have been established sufficiently to withstand dismissal on dilution grounds, and in view of the near-identity of sight, sound and meaning of the parties' respective marks Opposer respectfully submits that it has presented more than a colorable case of likelihood of confusion as well.

2. Opposer Need Only Show The Likelihood of Dilution

As stated in Section A(3) above, the TTAB has already ruled that "a plaintiff that establishes its ownership of a distinctive and famous mark may prevail upon a showing of likelihood of dilution" in a TTAB proceeding. *The NASDAQ Stock Market, Inc. v. Antartica, S.r.l.*, Opposition No. 91121204 to application Serial No. 75/546,122 filed on September 1, 1998, 2003 TTAB LEXIS 391, *56 (TTAB June 30, 2003). Therefore, for the reasons in Section A(3) above, Applicant's argument that the opposition should be dismissed for failure to show actual dilution is legally incorrect.

3. Applicant Is Not Entitled to Summary Judgment

Applicant contends that it is entitled to summary judgment because “opposer neither pleaded nor produced evidence of “actual” dilution, harm, or injury. Applicant’s Motion at 8. Though Applicant flatly concedes that “[t]here is a ‘likelihood’ of dilution, harm, or injury to opposer,” Applicant, quite incorrectly, contends that nonetheless under *Moseley*, it is entitled to summary judgment. Applicant’s Motion at 8.

As stated above, *Moseley* did not alter the standard required to oppose the registration of Applicant’s BLUEMAN mark, which is a showing of a “likelihood” or “possibility” of dilution. *The NASDAQ Stock Market, Inc. v. Antartica, S.r.l.*, Opposition No. 91121204 to application Serial No. 75/546,122 filed on September 1, 1998, 2003 TTAB LEXIS 391, *56 (TTAB June 30, 2003). Therefore, not only does Opposer not need to show “actual dilution,” but what Opposer need show, namely a “likelihood” of dilution, Applicant has conceded exists. In such a case, summary judgment should certainly not be granted, at least in favor of the Applicant.

Further, the Board may also use its discretion to deny Applicant’s summary judgment motion as untimely. Rule 2.127(e)(1) states that a “motion for summary judgment, if filed, should be filed prior to the commencement of the first testimony period” and allows the Board to deny as untimely any motion filed thereafter. Because the first testimony period was that of Opposer, which began in December of 2003, this motion is almost three months late. Applicant has provided no excuse or justification for its failure to meet the Rules guidelines. Therefore, the Board should exercise its discretion and deny Applicant’s motion for summary judgment as untimely.

Conclusion

For the foregoing reasons, both Applicant's Motion to Strike Opposer's Notice of Reliance, and Applicant's Motion to Dismiss for Failure to Prosecute, for Judgment on the Pleadings, or Alternatively, for Summary Judgment, should be denied.

Dated: New York, New York
March 15, 2004

Respectfully submitted,

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CERTIFICATE OF SERVICE

The undersigned hereby certifies that a copy of the foregoing RESPONSE TO APPLICANT'S MOTION TO STRIKE OPPOSER'S NOTICE OF RELIANCE AND MOTION TO DISMISS FOR FAILURE TO PROSECUTE, FOR JUDGMENT ON THE PLEADINGS OR ALTERNATIVELY, FOR SUMMARY JUDGMENT was served on Applicant on March 15, 2004 by mailing a copy thereof via first-class mail, postage prepaid, addressed as follows:

Lawrence Harbin, Esq.
McIntyre, Harbin & King LLP
500 Ninth Street SE
Washington, DC 20003



Antonio Borrelli