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

In the Matter of Application Serial No. 75/761,159
Mark: CAB CALLOWAY
Opposer's Ref: CWBK 01/00500

CHRISTOPHER BROOKS,

Opposer,

- v. -

CREATIVE ARTS BY CALLOWAY, LLC,

Applicant.

Opposition No.



04-13-2004

U.S. Patent & TMOfr/TM Mail Rcpt Dt. #22

NOTICE OF OPPOSITION

Opposer, Christopher Brooks, an individual residing at 83 Myrtle Boulevard, Larchmont, NY 10538, believes that he would be damaged by the issuance of a registration for the trademark CAB CALLOWAY as applied for in intent to use Application Serial No. 75/761,159 ("Applicant's Mark"), and therefore opposes the same. As grounds for its opposition, Opposer, by its attorneys Fross Zelnick Lehrman & Zissu, P.C., alleges as follows:

1. Since at least as early as 1998, and prior to any date upon which Applicant can rely, Opposer, the grandson of the internationally famous jazz musician Cab Calloway, at his grandfather's request, has used the mark THE CAB CALLOWAY ORCHESTRA in the United States for live musical performances, and is continuing to do so. Audio and video recordings of the orchestra's performances have been offered by sale by Opposer. These products all bear the mark THE CAB CALLOWAY ORCHESTRA.

2. Both the U.S. District Court for the Southern District of New York and the Second Circuit Court of Appeals have recognized Opposer's use of the mark THE CAB CALLOWAY ORCHESTRA in connection with live performances since 1998, as well as in connection with compact discs and video tapes. See decisions in *Creative Arts by Calloway, LLC v. Brooks*, 01 Civ. 3192 (CLB) (S.D.N.Y. Dec. 11, 2001), *aff'd*, No. 02-7050, 2002 WL 31303241 (2d Cir. Oct. 11, 2002), attached as Exhibits A and B, respectively.

3. Opposer has invested a substantial amount of time, effort and money in promoting the mark THE CAB CALLOWAY ORCHESTRA. As a result, THE CAB CALLOWAY ORCHESTRA mark has become distinctive of Opposer's goods and services and has come to represent enormous goodwill for Opposer.

4. On July 23, 1999, Applicant filed Application Serial No. 75/761,159 to register the mark CAB CALLOWAY. As published, this intent to use application covers "[r]etail stores, retail outlets and on-line retail store services featuring compact discs, records, video tapes, cassettes, digital video and audio discs, and other home entertainment related products; distribution of pre-recorded comedies, musicals and dramas on video tapes, cassettes, digital video and audio discs, CD-ROM; distribution of pre-recorded theatrical musicals, comedies and dramas on video tapes, cassettes, digital video and audio discs, CD-ROM; and distribution of pre-recorded music, drama, comedy and variety shows on video tapes, cassettes, digital video and audio discs and CD-ROM" in International Class 35, and "[e]ntertainment services in the nature of multimedia entertainment software production services, scheduling of programs on a global computer network; production and distribution of live music concerts, comedy, and dramatic series; production of live music concerts and live theatrical plays; production of radio and television programs; production of videotapes and sound recordings, namely, phonograph

records, pre-recorded audio tapes, compact discs, videotapes, digital audio tapes, compact disc videos, and laser discs; production and distribution of motion pictures; production of comedies, musicals and dramas; scheduling television and radio programming; production of music, drama, comedy and variety shows; theatrical production of musicals, comedies and dramas” in International Class 41.

5. The only date on which Applicant can rely for purposes of priority is the filing date of July 23, 1999, which is after Opposer commenced use of the mark THE CAB CALLOWAY ORCHESTRA. Indeed, as noted by the Southern District of New York, as of 2001 Applicant had not made any use of Applicant’s Mark. (Ex. A; see Ex. B.)

6. The mark that Applicant seeks to register is nearly identical in sound, meaning and commercial impression to Opposer’s mark THE CAB CALLOWAY ORCHESTRA, and will be used on services closely related to the goods and services in connection with which Opposer uses his mark. Based on the similarities of the parties’ marks and the goods and services offered under the marks, the public is likely to associate the services offered by Applicant under the mark CAB CALLOWAY with Opposer or with Opposer’s goods, or to believe that Applicant’s services are sponsored, endorsed or licensed by Opposer, or that there is some relationship between Applicant and Opposer.

7. Any use of Applicant’s Mark by Applicant is likely to cause confusion, cause mistake or deceive the public, and cause the public to believe that the services offered under Applicant’s Mark emanate from or are otherwise sponsored by or endorsed by Opposer, in violation of Section 2(d) of the Lanham Act, 15 U.S.C. § 1052(d).

8. Opposer will be harmed by issuance of a registration for Applicant's Mark because such registration is inconsistent with Opposer's prior use of and common law rights in the mark THE CAB CALLOWAY ORCHESTRA.

By reason of the foregoing, Opposer will be damaged by the registration of Applicant's Mark by Applicant.

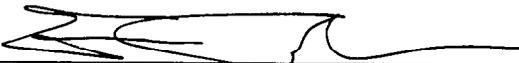
WHEREFORE, it is respectfully requested that this opposition be sustained and that the registration sought by Application Serial No. 75/761,159 be denied.

The Opposition fee in the amount of \$ 600.00 for one application covering two classes is filed herewith. If for any reason this amount is insufficient, it is requested that Opposer's attorneys' Deposit Account No. 23-0825-0576900 be charged with any deficiency.

This paper is filed in duplicate.

Dated: New York, New York
April 13, 2004

Respectfully submitted,
FROSS ZELNICK LEHRMAN
& ZISSU, P.C.

By: 

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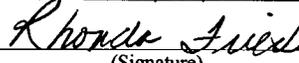
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EXHIBIT A

COPY

UNITED STATES DISTRICT COURT
SOUTHERN DISTRICT OF NEW YORK

-----X
CREATIVE ARTS BY CALLOWAY, LLC,

Plaintiff,

01 Civ 3192 (CLB)

- against -

Memorandum & Order

CHRISTOPHER W. BROOKS,

Defendant.

-----X
Brieant, J.

Plaintiff has applied for a preliminary injunction against Defendant in this action for service mark infringement, unfair competition, service mark dilution, unfair business practices and injunctive relief arising out of the Federal Trademark Act of 1946, as amended, 15 U.S.C. § 1051, *et seq.*, including but not limited to 15 U.S.C. § 1125(a) (The Lanham Act) and the common law and statutes of the State of New York. The action seeks to forbid Defendant from using the name of the world renowned entertainer Cab Calloway, who died November 18, 1994.¹

Defendant seeks summary judgment pursuant to Rule 56 F.R.Civ.P. on the grounds that Plaintiff has no ownership rights to the claimed service mark. The motions were argued and fully submitted on November 16, 2001.

¹ Plaintiff is a Delaware Limited Liability Company. Its principles are Zulme Calloway, widow of the late Cab Calloway, Chris Calloway, Cabella Calloway Langsam, and Andrew Langsam. Andrew is the husband of Cabella Calloway, who with her sister Chris is a daughter of Cab Calloway, but not of Zulme.

The Court has subject matter jurisdiction pursuant to 28 U.S.C. §§ 1331, 1338(a) and § 1367. For the reasons set forth below, Plaintiff's motion for a preliminary injunction is denied and Defendant's motion for summary judgment is granted.

Background

The following facts are undisputed or assumed for the purpose of the motions. The dispute arises out of the legacy of the great Cab Calloway, the world-renowned jazz musician, singer, composer and entertainer. Cab Calloway, born Cabell Calloway, III on December 25, 1907, was known for songs such as "Minnie the Moocher," appearances in musicals such as *Porgy and Bess*, and regular performances at The Cotton Club. Cab Calloway performed solo, with a small ensemble under the name "Cab Calloway and the Cab Jivers," and with big bands under the name "Cab Calloway and The Hi De Ho Orchestra," "Cab Calloway and His Famous Orchestra," and "Cab Calloway and The Cotton Club Orchestra." Cab Calloway, a resident of Westchester County in this District, survived by his widow, Zulme Calloway and several children and grandchildren, including his eldest grandson, Defendant Christopher Brooks. Zulme Calloway, who is not the grandmother of Mr. Brooks, was the residuary legatee of Cab Calloway, and acquired thereby whatever intellectual property rights Mr. Calloway possessed at the time of his death.

Plaintiff was established in December 2000 for the purpose of managing, promoting, licensing and otherwise dealing with all of the rights associated with the name, likeness, voice

and intellectual property rights belonging to Cab Calloway.

Defendant Christopher W. Brooks, of Larchmont, New York, is a graduate of New England Conservatory of Music and a professional musician, who performs as leader of THE CAB CALLOWAY ORCHESTRA.

Plaintiff claims that beginning in 1928, and continuously until his death in 1994, Cab Calloway used, among others, the unregistered, common law mark "CAB CALLOWAY" to identify his entertainment services. Zulme Calloway claims she has used the "Cab Calloway" mark continuously from the date of Cab Calloway's death in 1994. On July 23, 1999, Mrs. Calloway requested registration of this mark with the United States Patent and Trademark Office, which remains pending. She claims to have assigned the mark to Plaintiff on January 22, 2001. This action was filed April 16, 2001.

In 1998, Defendant started his orchestra dedicated to honoring the musical legacy of his grandfather Cab Calloway. Since December 1998, Defendant has performed over 150 concerts using the name "THE CAB CALLOWAY ORCHESTRA." Advertisements in connection with these concerts adopted the mark "THE CAB CALLOWAY ORCHESTRA." Defendant's orchestra plays the music of Cab Calloway in the style of Cab Calloway. In addition, Defendant has released two compact discs and a videotape. On occasion he used the name "Calloway Brooks" in connection with his entertainment services. Mr. Brooks performed with his grandfather on more than twenty-five occasions beginning in 1978, and some of the musicians

working with Mr. Brooks' orchestra also performed with Cab Calloway. *See* Brooks Decl., Doc. 12 ¶ 9.

Mrs. Zulme Calloway claims that she first became aware in late 2000 that Defendant was performing publicly under the name "THE CAB CALLOWAY ORCHESTRA." On December 10, 2000, an attorney representing Mrs. Calloway issued the customary cease and desist letter, asserting that she had a common law service mark, "CAB CALLOWAY." (Ex. F to Proposed Order to Show Cause, Doc. 8) Defendant rejected the demand and continues to solicit business and perform under the name "THE CAB CALLOWAY ORCHESTRA," occasionally adding "*Directed by Calloway Brooks.*"

The Complaint alleges four claims for common law service mark infringement, federal unfair competition in violation of 15 U.S.C. §1125,² service mark dilution, unfair business practices, and seeks temporary, preliminary, and permanent injunctive relief. Plaintiff seeks to restrain Defendant's use of the mark "CAB CALLOWAY" or any other designation such as "THE CAB CALLOWAY ORCHESTRA," from otherwise infringing on the mark and from the sale and selling and rendering services under the mark, as well as compensatory damages,

² Title 35, U.S.C. § 1125(a) provides: "Any person who, on or in connection with any goods or services, or any container for goods, uses in commerce any word, term, name, symbol, or device, or any combination thereof, or any false designation of origin, false or misleading description of fact, or false or misleading representation of fact, which is likely to cause confusion, or to cause mistake, or to deceive as to the affiliation, connection, or association of such person with another person, or as to the origin, sponsorship, or approval of his or her goods, services, or commercial activities by another person...shall be liable in a civil action by any person who believes that he or she is or is likely to be damaged by such act."

corrective advertising costs and costs of the suit including fees.

Defendant moved on June 14, 2001 for summary judgment on the grounds that (1) Plaintiff lacks valid trademark or service mark rights sufficient to bring its claims; and (2) that even if Plaintiff has trademark or service mark rights, Defendant's use of the term "THE CAB CALLOWAY ORCHESTRA" constitutes permissible fair use. Lastly, Defendant argues that Plaintiff's claim is nothing more than a right of publicity claim, which does not exist under New York law.

Summary Judgment

Rule 56(c) F.R.C.P. provides that "judgment sought shall be rendered forthwith if the pleadings, depositions, answers to interrogatories, and admissions on file, together with the affidavits, if any, show that there is no genuine issue as to any material fact and that the moving party is entitled to a judgment as a matter of law." The moving party bears the burden of showing the absence of a genuine issue of material fact. The movant's burden will be satisfied if it can point to the absence of evidence to support an essential element of the non-moving party's claim. *Goenaga v. March of Dimes Birth Defects Fund*, 51 F.3d 14, 18 (2d Cir. 1995).

Once the movant has met the burden, "an adverse party may not rest upon the mere allegations or denials of the adverse party's pleading, but the adverse party's response, by affidavits or as otherwise provided...must set forth specific facts showing that there is a genuine issue for trial." Rule 56(e) F.R.C.P. To satisfy this standard, the adverse party must do "more

than simply show that there is some metaphysical doubt as to material facts.” *Matsushita Elec. Indus. Co. v. Zenith Radio Corp.*, 475 U.S. 574, 586, 106 S.Ct. 1348, 1356 (1986); *Kalb v. Wood*, 38 F.Supp.2d 260, 268 (S.D.N.Y. 1999, J. Parker) (stating that a party opposing summary judgment must produce “some affirmative indication that his version of the relevant events is not fanciful”).

In evaluating the record to determine whether there is a genuine issue as to any material fact, “the evidence of the non-movant is to be believed and all justifiable inferences are to be drawn in his favor.” *Anderson v. Liberty Lobby*, 477 U.S. 242, 255, 106 S.Ct. 2505, 2513 (1986); *see also Allen v. Coughlin*, 64 F.3d 77, 80 (2d Cir. 1995). However, “[w]here a plaintiff cannot make a threshold showing of rights in its mark, courts have not hesitated to grant summary judgment.” *Black & Decker Corp. v. Dunsford*, 944 F.Supp. 220, 228 (S.D.N.Y. 1996) (granting summary judgment where mark found not protectable as matter of law).

Analysis

In 1927, Cab Calloway’s name was just another name in the phone book. However, during a long productive professional life, Mr. Calloway created a style and legend that resonates in the music world. The issue is whether Plaintiff has shown by evidence that “CAB CALLOWAY” became a service mark, and if so, whether that service mark is now owned by Plaintiff, and if so, whether it holds rights superior to Mr. Calloway’s grandson, a musician in his own right.

When Cab Calloway died in 1994, he had no registered trade- or service mark in his name. There is no evidence that he had or exercised any common law service mark in his name. Personal names are merely descriptive, and are protected as a mark only if, through usage, they have acquired distinctiveness and secondary meaning. See *Pirone v. MacMillon, Inc.*, 894 F.2d 579, 583 (2d Cir. 1990); *Abraham Zion Corp. v. Lebow*, 761 F.2d 93, 104 (2d Cir. 1985). Like trademarks, common law rights are acquired in service marks by adopting and using the mark in connection with services rendered. *Hanover Milling Co. v. Metcalf*, 240 U.S. 403, 36 S.Ct. 357, 60 L.Ed. 713 (1915). "The term service mark means any word, name or symbol...used by a person...to identify and distinguish the services of one person, including a unique service, from the services of others and to indicate the source of the services, even if that source is unknown." 15 U.S.C. § 1127; see also *Dial-A Mattress*, 841 F.Supp. at 1348 ("A service mark serves to identify a particular service as being the labors of a unique, though anonymous source."). In such cases, the user may accrue property rights in the descriptive terms, but only from such time as he or she can establish secondary meaning in the relevant market. See *Dial-A-Mattress*, 841 F.Supp. 1339, 1347 (E.D.N.Y. 1994) citing *Abercrombie & Fitch Co. v. Hunting World, Inc.*, 537 F.2d 4, 10-11 (2d Cir. 1976). Such public recognition may justify protection under the Lanham Act. See *Thompson Med. Co. v. Pfizer, Inc.*, 753 F.2d 208, 215 (2d Cir. 1985); see also *EMI Catalogue Partnership v. Hill, Holliday, Connors, Cosmopolos, Inc.*, 228 F.3d 56, 62 (2d Cir. 2000) (Unregistered, or common law, trademarks and service marks are protected by Section 43(a)).

While Plaintiff asserts that Cab Calloway had such common law service mark rights during his life, the Court finds no evidence of such rights in the extensive submissions in this

case. Assuming that Cab Calloway had some property interest in his own name, an owner of a trademark or service mark may not assign the rights to that mark "in gross." See 15 U.S.C. § 1060; see also *Marshak v. Green*, 746 F.2d 927, 929 (2d Cir. 1984); *Defiance Button Machine Co. v. C&C Metal Products Corp.*, 759 F.2d 1053, 1059 (2d Cir. 1985) ("The mark ceases to be enforceable against others when the owner assigns the mark without the goodwill associated with the mark."). "Since goodwill is inseparable from the business with which it is associated, this requirement of the transfer of goodwill restates the common-law rule that a trademark can only be transferred with the business or part of the business which it symbolizes." *Avon Shoe Co., Inc. v. David Crystal, Inc.*, 171 F.Supp. 293, 301 (S.D.N.Y. 1993). A bequest by will is the same as an assignment. No ongoing business being conducted by Mr. Calloway at his death, passed to his widow under the will. The will (Ex. A to Proposed Order to Show Cause, Doc. 8) does not purport to bequeath a service mark. Clause SECOND of the will reads in relevant part as follows:

SECOND: I give, devise and bequeath all of my property and estate, real, personal and mixed, or whatever kind and wheresoever situate, which I shall own at my death or in any way be entitled to at my death or to which my estate shall become entitled to receive after my death, as follows:
(A) To my wife, Zulme NcNeal Calloway, if she survives me, including all royalties and residuals or other payments or rights to payment for the reproduction of my performances or any songs or lyrics or both in which I have any ownership or other rights.

The grant of royalties and residuals for past performance cannot be enlarged by construction to constitute the assignment or bequest of a service mark, especially when there is no ongoing business or goodwill being transferred therewith. "Without the transfer of some business with

which the mark has been used, the assignment is a void assignment in gross and conveys no title to the assignee.” *Avon Shoe*, 171 F.Supp. at 301 quoting *Nettie Rosenstein Inc. v. Princess Pat, Ltd.*, 220 F.2d 444, 453 (2d Cir. 1955); *Landers, Frary & Clark v. Universal Cooler Corporation*, 85 F.2d 46, 47 (2d Cir. 1936). Cab Calloway transferred no goodwill or business in his will. Cab Calloway had not provided in his will for the continuance of his orchestra or other entertainment services.

Zulme Calloway, following the death of her husband, did not continue that business. She has made no use of the alleged service mark since Cab Calloway’s death in 1994, except to apply for a trademark registration in 1999. In the context of this case, collecting royalties due the estate for prior performances does not rise to the level of using a service mark. The will did not contemplate that Mrs. Calloway would continue in the position of directing the band, and there is no evidence that she was capable of doing so. On May 20, 1994, Cab Calloway and his wife executed an agreement entitled “An Amendment to Option Purchase Agreement, dated October 28, 1993” which purported to grant to Sawmill Entertainment Corporation and Ron Rainey Management, Inc., not parties to this litigation, “the exclusive worldwide right in perpetuity to market, merchandise, advertise, promote and sell produces and services of every kind and nature embodying your name, likeness, voice, caricature, etc.” There is no mention of a service mark in the original agreement or the amendment. The parties contemplated a book and motion picture. To the extent that Cab Calloway did provide for continued management of his entertainment

services, he did so by this agreement, and not by his will.³ While litigation was pending between itself and Zulme Calloway, but before executing the assignment to her, Calloway Entertainment on March 15, 2000 advised Mr. Brooks in writing that it “did not oppose” his use of the name “The Cab Calloway Orchestra.” Exs D and E, Doc. 12. The Court finds no relevance in this, as Calloway Entertainment had nothing to convey.

Plaintiff has failed to present any evidence which would justify a finding by a trier of the fact that it or its assignors owned or used any common law service mark at the time this case was filed.

In any event, Defendant’s use of the name “Cab Calloway” constitutes fair use. The fair use defense to federal claims of infringement is set forth in Section 33(b)(4) of the Lanham Act, 15 U.S.C. § 1115(b)(4). Summary judgement has been granted based on this defense in cases involving both federal infringement and unfair competition claims and state law claims. *See Car-Freshner Corp. v. S.C. Johnson & Son, Inc.*, 70 F.3d 267 (2d Cir. 1995). The section bars such claims if “the use of the name...is descriptive of and used fairly and in good faith only to describe the goods or services of such party...” A party asserting such defense need only show that defendant has used the mark in its descriptive sense, and in good faith. *See Cosmetically*

³ By a settlement agreement on July 5, 2000, Zulme Calloway and her guardian ad litem, who is also Defendant’s aunt, acquired from Calloway Entertainment, Inc., successor of Sawmill and Rainey all the rights surrendered by Mr. Calloway on May 20, 1994. Neither this settlement agreement nor the assignment issued September 18, 2000 pursuant thereto purport to assign a service mark. There is no evidence that on the date of the settlement Calloway Entertainment was operating an orchestra, or using a service mark as part of an ongoing business, or that it had any goodwill.

Sealed Industries v. Chesebrough-Pond's USA Co., 125 F.3d 28 (2d Cir. 1997); *Car Freshner*, 70 F.3d at 269-70. Defendant has done so.

Defendant Christopher Brooks gave public performances with his grandfather Cab Calloway. There is ample evidence to show that Cab Calloway wanted his professionally-trained grandson to continue his legacy. There are numerous legacy bands bearing the name of deceased musicians, such as THE CAB CALLOWAY ORCHESTRA. Examples of other legacy bands are: *The Tommy Dorsey Orchestra*, *The Count Basie Orchestra*, *The Duke Ellington Orchestra*, and *The Glenn Miller Orchestra*. This practice is permitted by law, and serves a public purpose to preserve an artist's stamp on history.

Defendant's advertising does not cause confusion among the public: any literate jazz aficionado knows Cab Calloway is dead, and will understand that his grandson is trying to perpetuate his music through concerts and compact discs. There is also no merit to the Plaintiff's contention that Defendant's music is bad, or that it will jeopardize the economic value of Plaintiff's residuals. If this were so, the great Cab Calloway himself never would have performed publicly with his grandson.

There is no assignable right of publicity attributable to a decedent under New York law. Cf. *Estate of Elvis Presley v. Russen*, 513 F.Supp 1339 (D.N.J. 1981).

The action lacks merit.

Conclusion

For the foregoing reasons, the Court grants Defendant's motion for summary judgment and denies Plaintiff's motion for preliminary injunction.

The Clerk shall file a final judgment.

SO ORDERED.

Dated: White Plains, New York
December 11, 2001

CHARLES L. BRIEANT

Charles L. Briant, U.S.D.J.

EXHIBIT B

This case was not selected for publication in the Federal Reporter.

THIS SUMMARY ORDER WILL NOT BE PUBLISHED IN THE FEDERAL REPORTER AND MAY NOT BE CITED AS PRECEDENTIAL AUTHORITY TO THIS OR ANY OTHER COURT, BUT MAY BE CALLED TO THE ATTENTION OF THIS OR ANY OTHER COURT IN A SUBSEQUENT STAGE OF THIS CASE, IN A RELATED CASE, OR IN ANY CASE FOR PURPOSES OF COLLATERAL ESTOPPEL OR RES JUDICATA.

Please use FIND to look at the applicable circuit court rule before citing this opinion. Second Circuit Rules § 0.23. (FIND CTA2 s 0.23.)

United States Court of Appeals,
Second Circuit.

CREATIVE ARTS BY CALLOWAY, L.L.C., d/b/a C.A.B.
Calloway, L.L.C., Plaintiff-
Appellant,

v.

Christopher BROOKS, d/b/a The Cab Calloway Orchestra,
Defendant-Appellee.

No. 02-7050.

Oct. 11, 2002.

Marc A. Karlin, Karlin & Karlin, Los Angeles, California,
for Plaintiff- Appellant.

Barbara A. Solomon, Fross, Zelnick, Lehrman & Zissu,
New York, New York, for Defendant-Appellee.

Present JACOBS and POOLER, Circuit Judges, and BAER,
District Judge. [FN*]

FN* The Honorable Harold Baer, Jr., United States
District Judge for the Southern District of New
York, sitting by designation.

SUMMARY ORDER

****1** Appeal from judgment of the United States District Court for the Southern District of New York (Charles L. Bricant, Judge) granting Defendant's motion for summary judgment and denying Plaintiff's motion for a preliminary injunction.

***17 ON CONSIDERATION WHEREOF, IT IS HEREBY ORDERED, ADJUDGED, AND DECREED that the judgment of the District Court be and it hereby is AFFIRMED.**

This trademark infringement action arises out of Defendant-Appellee Christopher Brooks' use of the name "Cab Calloway." Cab Calloway, born Cabell Calloway III on December 25, 1907, was a jazz musician who performed solo, with a small ensemble under the name "Cab Calloway and The Cab Jivers," and with big bands under the names "Cab Calloway and The Hi De Ho Orchestra," "Cab Calloway and His Famous Orchestra," and "Cab Calloway and The Cotton Club Orchestra." Cab Calloway died November 18, 1994 and was survived by his widow, Zulme Calloway, and several children and grandchildren, including Brooks, his oldest grandson from an earlier marriage.

Both Zulme Calloway and Brooks have sought to preserve the musical legacy of Cab Calloway. In 1998, Brooks formed "The Cab Calloway Orchestra," which plays vintage Cab Calloway songs using the original arrangements. Brooks also performs with smaller ensembles, titled "The Cab Calloway Band," "The Cab Calloway Duo (or Trio)," or "Calloway Brooks and The Cab Jivers." Brooks, who sometimes uses the stage names "Calloway Brooks" or "Christopher Calloway Brooks," has performed over 150 concerts and, between 1999 and 2001, released two compact discs and a video tape of his performances.

Zulme Calloway and several other relatives formed Creative Arts by Calloway, L.L.C. ("Creative Arts") on December 25, 2000. The Calloway family created Creative Arts to manage the rights associated with Cab Calloway's name, likeness, voice, and intellectual property. Creative Arts maintains that Cab Calloway's will transferred his trademark rights in the name "Cab Calloway" to Zulme Calloway, who subsequently transferred them to Plaintiff-Appellant.

On April 16, 2001, Creative Arts filed suit against Brooks, alleging that his use of the name "Cab Calloway" constitutes: 1) common law service mark infringement; 2) unfair competition in violation of the Lanham Act, 15 U.S.C. § 1125(a); 3) service mark dilution in violation of New York General Business Law §§ 368-c, d; and 4) unfair business practices in violation of New York General Business Law §§ 349, 350. Creative Arts also sought a preliminary injunction to prohibit Brooks from doing business as "The Cab Calloway Orchestra." The district court granted Brooks summary judgment on Creative Arts' claims in their entirety, and denied Creative Arts' motion for a preliminary injunction, on the grounds that: 1) there is no evidence that Cab Calloway had a common law service mark in his name, as there is no evidence that the name ever acquired secondary meaning; 2) assuming Cab Calloway had such a mark, he did not transfer it in conjunction with an ongoing business, rendering any assignment invalid; and 3) Brooks' use of the name "Cab Calloway" is protected as fair use. Creative Arts appeals the district court's judgment.

(Cite as: 48 Fed.Appx. 16, 2002 WL 31303241 (2nd Cir.(N.Y.)))

**2 Regardless of whether the name "Cab Calloway" acquired secondary meaning during the performer's lifetime, Creative Arts cannot prevail because any trademark assignment to Zulme Calloway would have been invalid. A trademark is merely a symbol of goodwill and cannot be sold or assigned apart from the goodwill it symbolizes. Marshak v. Green, 746 F.2d 927, 929 (2d Cir.1984) (citing Lanham Act, § 10, 15 U.S.C.S. § 1060). As goodwill is inseparable from the underlying business with which it is associated, rights in a trademark cannot be transferred "in gross," or apart from an ongoing business. *18 See *id.* ("There are no rights in a trademark apart from the business with which the mark has been associated; they are inseparable."). See also Berni v. International Gourmet Restaurant, Inc., 838 F.2d 642, 646-47 (2d Cir.1988). Moreover, the assignee must continue to offer products or services that are "substantially similar" to those of the assignor. Marshak, 746 F.2d at 930. See also Visa U.S.A., Inc. v. Birmingham Trust Nat. Bank, 696 F.2d 1371, 1376 (Fed.Cir.1982) ("[T]he transfer of goodwill requires only that the services be sufficiently similar to prevent consumers of the service offered under the mark from being misled from established associations with the mark.") (internal quotation marks omitted).

In the instant case, Cab Calloway was not operating a going concern at the time of his death, precluding the transfer of a mark. Creative Arts argues that Cab Calloway was in the business of marketing his entertainment services. "Entertainment" may be considered a service in connection with the law of service marks. See Smith v. Montoro, 648 F.2d 602, 605 (9th Cir.1981) (citations omitted); Estate of Presley v. Russen, 513 F.Supp. 1339, 1363 n. 31 (D.N.J.1981) (citations omitted). However, Cab Calloway's activities were not organized as a business that could have been transferred to his widow.

Creative Arts argues that Cab Calloway transferred his entertainment business to Zulme Calloway, because retailers continue to sell his music and audiences can watch his television and movie appearances. However, it is undisputed that various record companies own the rights to the masters of Cab Calloway's songs, and there is no evidence that Creative Arts owns the rights to any of Cab Calloway's public appearances.

The Court has considered Creative Arts' remaining arguments on this issue and finds them to be without merit. As there is no evidence that Cab Calloway operated a going concern at the time of his death, the Court need not reach the issue whether Brooks' use of the name "Cab Calloway" constitutes fair use. We note, however, that it is doubtful Brooks' naming of his orchestra would fall within this Court's jurisprudential definition of fair use, as he apparently is using the name "Cab Calloway" as part of his

own trademark, "The Cab Calloway Orchestra." See Cosmetically Sealed Indus., Inc. v. Chesebrough-Pond's USA Co., 125 F.3d 28, 30 (2d Cir.1997) ("The defense [of fair use] permits others to use protected marks in descriptive ways, but not as marks identifying their own products.") (citing Car-Freshner Corp. v. S.C. Johnson & Son, Inc., 70 F.3d 267, 270 (2d Cir.1995)).

48 Fed.Appx. 16, 2002 WL 31303241 (2nd Cir.(N.Y.))

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