

ESTTA Tracking number: **ESTTA29394**

Filing date: **03/30/2005**

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

Proceeding	91160266
Party	Defendant CREATIVE ARTS BY CALLOWAY, LLC CREATIVE ARTS BY CALLOWAY, LLC 405 REGENCY CT HOCKESSIN, DE 19707
Correspondence Address	WILLIAM R. GOLDEN, JR. KELLY DRYE & WARREN 101 PARK AVENUE NEW YORK, NY 10178
Submission	Reply in Support of Motion
Filer's Name	Cynthia Johnson Walden
Filer's e-mail	walden@fr.com, scott@fr.com, escott@fr.com
Signature	/cynthia johnson walden/
Date	03/30/2005
Attachments	Document0006.pdf (9 pages)

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

In the Matter of Application Serial No. 75761159
Mark: CAB CALLOWAY
Applicant: CREATIVE ARTS BY CALLOWAY, LLC

----- X
CHRISTOPHER BROOKS, :
 :
 : Opposer :
 :
 : v. : Opposition No. 91160266
 :
 CREATIVE ARTS BY CALLOWAY, LLC, :
 :
 : Applicant. :
-----X

**APPLICANT'S REPLY TO OPPOSER'S MEMORANDUM
IN OPPOSITION TO APPLICANT'S MOTION TO SUSPEND**

Applicant hereby responds to Opposer's Memorandum in Opposition to Applicant's Motion to Suspend.

As an initial matter, it is important to note that in addition to the reasons set forth in Applicant's Motion to Suspend, the reason Applicants require a "time-out" at this time is that, as a result of maneuvers of highly-skilled trademark attorneys,¹ Opposer stands on the brink of securing the name and reputation of a great man for his own gain, and possibly revenge, depriving that man's wife, the intended beneficiary of his estate, of what was intended to be hers. This forum can only determine the trademark registration

¹ Fross Zelnick Lehrman & Zissu P.C. claims to be "the largest law firm in the world specializing exclusively in trademark, copyright and unfair competition law." Unquestionably, it is also one of the most adept at these specialties. We intend no criticism of the firm in representing Opposer. An attorney's obligation is to represent its clients vigorously and skillfully, which the Firm unquestionably has done.

aspects of what is a much broader legal dispute, complicated by the emotions of a divided, extended family. While there is much more to this matter than mere trademark law, it is significant that what Opposer is seeking is the Board's imprimatur on his continued deception of the public.

The genesis of this controversy is the fabulous entertainer Cab Calloway. "[D]uring a long productive professional life, Mr. Calloway created a style and legend that resonates in the music world."² The "great Cab Calloway [was a] world-renowned jazz musician, composer and entertainer."³

Cab Calloway died November 18, 1994, leaving a widow (Zulme), three daughters from his marriage to Zulme, Cabella Calloway Langsam, Chris Calloway and Cecilia Eulaelia Calloway,⁴ and a grandson, Christopher Brooks, among other relatives.⁵ A few months before his death, Mr. Calloway and Zulme purported to assign "the exclusive worldwide right in perpetuity to market, merchandise, advertise and sell products and services of every kind and nature embodying [Mr. Calloway's] name, likeness, voice, caricature, etc."⁶ These rights, whatever they were, were recaptured by

² *Creative Arts by Calloway v. Brooks*, S.D.N.Y. 01 Civ. 3192 Mem. & Order dated December 31, 2001 [contained in Exhibit A to Opposer's Memorandum in Opposition], p. 6.

³ *Id.* p. 2.

⁴ Zulme, Cabella, Chris and Cabella's Husband, Andrew Langsam, M.D., are the principals of Applicant Creative Arts by Calloway, Inc., which was established in December 2000 to manage, promote, license and otherwise deal with the rights associated with the name, likeness, voice and intellectual property rights belonging to Cab Calloway. *Id.*, footnote 1 and pp. 2-3.

⁵ Whether Mr. Brooks' grandmother was ever married to Mr. Calloway is disputed.

⁶ *Id.*, p. 9. Cab Calloway's estate challenged this assignment of the rights associated with the business of marketing Cab Calloway's name, likeness and voice in the California courts for seven years (ultimately succeeding in recapturing the rights.)

Mrs. Calloway in 2000.⁷ Mrs. Calloway was already the residuary legatee of all of Mr. Calloway's property, real, personal and mixed, of whatever kind, "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"⁸ and "whatever intellectual property rights Mr. Calloway possessed at the time of his death."⁹

In 1998, Christopher Brooks organized a band and appropriated the name "The Cab Calloway Orchestra," purportedly at the "request" of his grandfather. We are aware of no documentation of any such "request," other than reports of Mr. Brooks' repeated statements to that effect. Mr. Brooks has allegedly performed more than 150 concerts under the name THE CAB CALLOWAY ORCHESTRA, and has released two compact discs and a video of his performances. Mr. Brooks has even gone so far as to add "Calloway" to his given name (which is "Christopher William Brooks") by using the assumed names "Chris Calloway", "Chris Calloway Brooks", "C. Calloway Brooks", "Christopher Calloway Brooks" and "Calloway Brooks", in connection with his leadership of the orchestra to aggravate his appropriation of the Calloway name and, no doubt, enhance misunderstanding.¹⁰

Mr. Brooks claims to have performed at times with his grandfather. If that is correct, he was the second descendent known as "Chris" to do so. "Chris Calloway," in jazz music circles is generally understood to mean Mr. Calloway's daughter, who is a

⁷ *Id.*, p. 10. Alternatively, the transfer failed (see *Id.* pp. 9-10), and the rights passed with the Estate to Mrs. Calloway, although Opposer's position appears to be that they somehow vanished.

⁸ *Id.*, p. 8.

⁹ *Id.*, p. 2.

¹⁰ *Id.*, p. 2; see also p. 1 of the Appellate opinion which is part of Exhibit A.

renowned performer in her own right, and who performed with her father for more than 30 years. Chris Calloway has performed music written and/or recorded by her father for many years (and prior to Mr. Brooks doing so) and she regularly performs live concerts throughout the United States and internationally celebrating her father's music and his legacy. Chris Calloway is a Managing Partner of Applicant.

The suit on which the present motion is premised was brought by the present Applicant to restrain Mr. Brook's usurpation of the "Cab Calloway" legacy. In broad outline, it was a claim for common law service mark infringement of the CAB CALLOWAY name. The attorney for the estate is a very able litigation and commercial attorney, but not the equal of Mr. Brooks' counsel at the technical intricacies of trademark law. As a result, the Court held that there were no service mark rights in the CAB CALLOWAY name because it was descriptive, without secondary meaning¹¹ (despite the facts that, in the Court's words, it identified "a style and legend that resonates in the music world" and is "world-renowned"; Mr. Calloway continued to perform until five months before his stroke, and that his recorded performances continued to be sold -- indeed they have been sold to this day.) Nevertheless, the Court found (without trial) that "[n]o ongoing business being conducted by Mr. Calloway at his death, passed to his widow under the will."¹² The Court noted, but did not adopt (or reject), the argument of Mr. Brooks' counsel that "Plaintiff's claim is nothing more than a right of publicity claim, which does not exist under New York law."¹³ The Court also found that Mr.

¹¹ *Id.*, p. 7.

¹² *Id.*, p. 8. The decision appears to focus primarily on whether the name CAB CALLOWAY was in use as a service mark for the entertainment services of "directing the band" by Mrs. Calloway following her husband's death.

¹³ *Id.*, p. 5.

Brooks' use of "Cab Calloway" was a "fair use" under Section 33(b)(4) of the Trademark Act.¹⁴

The result is that Mr. Brooks remains free to continue his employment of the CAB CALLOWAY name in connection with his so-called "legacy" orchestra. The most likely public expectation, formed by the extremely well-known Estate of Elvis Presley model or the other "legacy" bands, will be that the presently existing CAB CALLOWAY Orchestra is authorized by the Calloway Estate and/or a continuation of an ongoing band. It is not; it is an unsanctioned recreation four years after Mr. Calloway's demise.

Now, Mr. Brooks is on the verge of preventing the entity created to preserve and honor Cab Calloway's legacy and reputation by Mr. Calloway's wife and two acknowledged daughters from registering CAB CALLOWAY as a trademark. Applicant is in dire straits, facing the prospect of losing Mrs. Calloway's inheritance to a usurper. Mr. Brooks, however, continues to benefit from the CAB CALLOWAY name.

Under the circumstances, a recess to permit Applicant and its new attorneys to develop an orderly plan to salvage whatever is salvageable from the sorry situation is not unreasonable. Opposer attacks three bases for the motion. We address them briefly.

1. CHANGE IN COUNSEL

Successor counsel have been retained and are appearing now. To level the playing field, however, will require time to locate and review the voluminous past record, and addressing several very complicated issues, not the least of which is the extent of preclusion as a result of the earlier litigation. Applicant's general counsel, Mr. Karlin, is not a trademark specialist and Applicant requires the assistance of experienced trademark

¹⁴ *Id.*, pp. 10-11. That holding was vacated on appeal on the rather obvious ground that Mr. Brooks' use of CAB CALLOWAY was a trademark, not a "non-trademark", use as is required by Section 33(b)(4).

counsel to respond comprehensively to the potentially dispositive summary judgment motion. Applicant's request for suspension of the proceedings to permit additional time to prepare a response to the summary judgment motion while its new counsel familiarizes itself with the voluminous record in this matter is reasonable and is made in good faith.

2. ILLNESS OF APPLICANT'S PRINCIPAL AND PRIMARY MEMBER

As set forth in the Motion to Suspend and the supporting Declaration of Cabella Calloway Langsam, Applicant has been unable to devote the necessary attention and energy to this matter recently in view of the significant demands associated with dealing with and caring for the serious illness of two of Applicant's four members. Applicant is comprised of four individuals: Cab Calloway's wife, Zulme; Cab Calloway's daughter Chris Calloway; and Cab Calloway's daughter Cabella Calloway Langsam and her husband Andrew Langsam. Cab Calloway's wife, Zulme Calloway, is almost 90 years old and has been ill. Chris Calloway has been and continues to be seriously ill, and in the past couple of months her illness has taken a particularly heavy toll. Cabella Calloway Langsam is the primary caregiver to both Zulme and Chris. Andrew Langsam, whom Opposer suggests is readily available to help extensively with this case, is a Board Certified Trauma Emergency Physician at the Christiana Hospital in Newark, Delaware - he works long hours, can see hundreds of patients in a work day, is often "on call", and does not have the ability to adequately assist with the preparation of the response.

Opposer's suggestion that Applicant's reluctance to include the specific, personal details of the serious medical conditions of Zulme and Chris Calloway is because these conditions do not exist is misguided and it is demonstrative of the mean-spirited and opportunistic manner in which Opposer has thus far managed to steal from Cab

Calloway's wife and rightful heir the benefit of his bequest to her of the "exclusive worldwide right in perpetuity to market, merchandise, advertise and sell products and services of every kind and nature embodying (Mr. Calloway's) name, likeness, voice, caricature, etc." It is understandable that two seriously ill women did not want to put their detailed private medical records on public record. If counsel for Mr. Brooks or the Board seriously question their illnesses, we are willing to disclose that information to them, provided the information will remain confidential to the Board and Mr. Brooks' counsel.

Despite her poor health, Chris Calloway entertained a request by Mr. Brooks to meet to discuss possible resolution in New York and Mr. Brooks insisted that Chris Calloway be a participant in these settlement discussions. Despite her own physical discomfort and present condition, Chris Calloway was willing to attempt to move forward with this meeting - resolving this matter was that urgent to her. She subsequently declined when Mr. Brooks would not permit either (i) attendance by attorneys, or (ii) a reporter to be present to transcribe what was said.

3. SETTLEMENT NEGOTIATIONS

Settlement negotiations were and have been ongoing for the past several months. In fact, on February 16, 2004, the eve of the February 20, 2005 deadline for Applicant's response to the summary judgment motion, Opposer's attorney contacted Applicant's attorney regarding settlement. The undersigned are not fully apprised of the present status or prospects for these settlement discussions, but even Opposer says only that they are not "meaningful." The Gourvitz Declaration attached to Opposer's opposition sets forth some of the details of the chronology of the settlement discussions that have taken

place in this matter over the past several months, including reference to a March 8, 2005 letter regarding a proposed settlement meeting. The Gourvitz Declaration neglects to mention that the March 8, 2005 letter from Mr. Karlin indicating the dates Chris Calloway could be available for a meeting was in response to a request from Opposer to have a meeting to discuss settlement.

CONCLUSION

Applicant's new counsel have been retained, and are proceeding to gather the prior record, evidence and address the legal issues, several of which are exceedingly thorny. This trademark application and opposition are but parts of a much larger, and very complex, picture, that will require careful consideration and analysis before the next steps can be taken.

Opposer, meanwhile, is continuing to lead his CAB CALLOWAY Orchestra in concerts, and Applicant's attempt to register CAB CALLOWAY is stalled by this Opposition. Mr. Brooks will not be prejudiced. Applicants, on the other hand, if required to move precipitously and while handicapped by the demands of dealing with and recovering from the serious illness of two of the individuals whose input in this matter is crucial, well might make a misstep when one more would be fatal to their cause.

For the reasons set forth above, Applicant's motion for a six month suspension of the proceedings and the deadline to file its answer to the summary judgment motion was made in good faith and is supported by good cause pursuant to TBMP Sect. 510.03(a).

In the interests of justice, it is submitted that a suspension to provide a reasonable extension of time to answer Opposer's motion for summary judgment is merited.

Respectfully submitted,

FISH & RICHARDSON P.C.

Dated: March 30, 2005

By Cynthia Johnson-Walden

Cynthia Johnson-Walden
225 Franklin Street
Boston, MA 02110-2804
Telephone: (617) 542-5070
Facsimile: (617) 542-8906

Anthony L. Fletcher
153 East 53rd Street, 52nd Floor
New York, NY 10022-4611
Telephone: (212) 765-5070
Facsimile: (212) 258-2291

Attorneys for Applicant,
CREATIVE ARTS BY CALLOWAY, LLC

CERTIFICATE OF SERVICE

The undersigned hereby certifies that a copy of the foregoing APPLICANT'S REPLY TO OPPOSER'S MEMORANDUM IN OPPOSITION TO APPLICANT'S MOTION TO SUSPEND has this 30th day of March 2005 been mailed by prepaid first class mail to the below-identified Attorney at his/her place of business:

Barbara A. Solomon, Esq.
Evan Gourvitz, Esq.
Fross Zelnick Lehrman & Zissu, P.C.
866 United Nations Plaza
New York, NY 10017

Cynthia Johnson-Walden