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

Proceeding	91160266
Party	Plaintiff Mr. Christopher Brooks Mr. Christopher Brooks 83 Myrtle Boulevard Larchmont, NY 10538 UNITED STATES
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Date	04/05/2005
Attachments	Memorandum in Oppositon to Applicant's New Basis for Motion to Suspend.pdf (6 pages)

**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 04/18950

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CHRISTOPHER BROOKS,	:	
	:	
Opposer,	:	
	:	Opposition No. 91/160,266
- v. -	:	
	:	
CREATIVE ARTS BY CALLOWAY, LLC,	:	
	:	
Applicant.	:	
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**MEMORANDUM IN OPPOSITION TO
APPLICANT'S NEW BASIS FOR MOTION TO SUSPEND**

Opposer, Christopher Brooks, hereby submits this memorandum in opposition to the new ground for a "time-out"¹ raised by Applicant for the first time in its Reply Memorandum.

On February 22, 2005, Applicant moved to extend its deadline to respond to Opposer's pending summary judgment motion for six months. In its original motion Applicant claimed illness, purported settlement negotiations, and the departure of co-counsel. (App. Mot. at 1-2.) Now, since Applicant seems capable of assisting with the litigation, settlement is unlikely, and new counsel has been retained, Applicant has in mid-course offered a wholly new justification for its request. Amidst venomous, unjustified personal attacks on Opposer and his family and mischaracterizations of the facts of and legal determinations in the parties' prior litigation,

¹ Applicant still seems to be confused about whether the "time-out" (App. Reply at 1) it seeks is a suspension under TBMP § 510.03(a) or an extension under TBMP § 509.01(a). (E.g., App. Reply at 9 ("a *suspension* to provide a reasonable *extension* of time to answer Opposer's motion

Applicant now claims that it needs a “reasonable extension of time to answer Opposer’s motion for summary judgment” because of “exceedingly thorny” legal issues that Applicant’s co-counsel apparently was unable to address adequately in the prior litigation. (App. Reply at 4-5, 8-9.) Essentially, Applicant now seeks an extension of time to attempt to figure out how to evade its own admissions, and the preclusive effects of its two losses in the prior litigation in the U.S. federal courts. This is not the proper basis for a suspension or extension.²

ARGUMENT

Applicant has abused its right to file a reply brief by using the opportunity to make *ad hominem* attacks on Opposer and to argue against two federal court decisions that Applicant lost. The U.S. Court of Appeals for the Second Circuit made it abundantly clear that Opposer has been using the mark THE CAB CALLOWAY ORCHESTRA since 1998, and that this use *cannot be challenged* by Applicant. (Opp. Mot. for Summ. J., Ex. 15.) Moreover, the courts made clear findings that Opposer acquired his rights in the mark THE CAB CALLOWAY ORCHESTRA through use, and with his grandfather’s blessing. (*E.g., id.*, Ex. 14 at 11 (“[t]here is ample evidence to show that Cab Calloway wanted his professionally-trained grandson to continue his legacy.”)) Confronted by these facts, Applicant’s counsel has chosen to throw a tantrum, complete with name-calling and complaints that it somehow is not fair that Applicant twice lost the prior litigation. Such behavior is inappropriate, and counsel knows it.

. . . is merited”) (emphasis added).) Since this matter already has been suspended, it seems clear that this is a request for a six-month extension of time, and should be judged under that standard.

² Since Applicant has raised this new basis for its motion for the first time on reply, Opposer respectfully requests that the Board exercise its discretion and choose not to consider Applicant’s reply memorandum. *See* TBMP § 502.02. If the Board nevertheless considers Applicant’s reply, Opposer respectfully requests that the Board also consider this memorandum in opposition.

The new basis for Applicant’s request is completely bogus. Applicant has advised that it needs additional time to figure out a way to relitigate issues already determined by two federal courts in prior litigation between the parties. (App. Reply at 1, 4-5, 8-9; *see* Opp. Mot. for Summ. J., Exs. 14, 15.) But it is clear that the issues litigated and determined by these courts prior to this opposition cannot be relitigated. *See, e.g., Mother’s Restaurant Inc. v. Mama’s Pizza, Inc.*, 221 U.S.P.Q. 394, 397 (Fed. Cir. 1983) (“issues which are actually and necessarily determined by a court of competent jurisdiction are conclusive in a subsequent suit involving the parties to the prior litigation . . . a party who has litigated an issue and lost should be bound by that decision and cannot demand that the issue be decided over again”) (citations omitted). What Applicant describes as “exceedingly thorny” legal issues such as “preclusion” (App. Reply at 5, 8) actually are quite simple and straightforward – just not in Applicant’s favor.³

As to the prior justifications for seeking an extension of time, as Applicant’s revised submission makes clear, none justify the requested relief.

To the extent Applicant needed to retain new counsel, as Applicant’s reply brief concedes, “[s]uccessor counsel have been retained and are appearing now.” (App. Reply at 5.) Usually, in the case of a withdrawal of counsel, after a request to withdraw is granted the Board suspends proceedings for 30 days, TBMP § 510.03(a), not for the six months requested here.⁴ While Applicant claims a need for extra time for counsel to familiarize itself with the record and address a variety of “very complicated” legal issues (App. Reply at 5-6), it offers no authority suggesting that it should be entitled to an extraordinary six-month extension to do so. Indeed, as

³ In any case, it is unclear what Applicant expects to prove, since its own application is based on an intent-to-use, and since it acknowledges Opposer’s “rather obvious” use of the mark THE CAB CALLOWAY ORCHESTRA as a mark since 1998. (*E.g.*, App. Reply at 3, 5 n.14.)

⁴ Prior counsel does not yet appear to have moved to withdraw, as required by TBMP § 116.05.

evidenced by the discussion in its reply memorandum (*Id.* at 1-5), counsel already seems to have familiarized itself with the very simple facts of the case – presumably with the help of Applicant’s long-time counsel Marc Karlin, who still appears to be involved in the opposition. (*See id.* at 5.) Simply put, Applicant has an intent-to-use application, Opposer has prior rights, the marks are almost identical, and the parties’ goods and services overlap.

Settlement also provides no basis for the relief sought. Opposer already has said that he does not consent to an extension or suspension on the basis of settlement discussions. *See MacMillan Bloedel Ltd. v. Arrow-M Corp.*, 203 U.S.P.Q. 952, 953 (T.T.A.B. 1979) (order suspending proceedings for settlement vacated once it came to Board’s attention that other party objected to suspension on such basis). Indeed, given Applicant’s surprising, unwarranted, and factually inaccurate personal attacks on Opposer and his branch of the Calloway family in its reply brief, settlement clearly is less likely than ever at this time.

Finally, the argument that the illness of two of its four members precludes Applicant from preparing its case also seems to be moot. Though it appears that at least one of Applicant’s two ill members has recovered (App. Reply at 6, 8), it is clear from the detailed discussion of the purported facts of the case in Applicant’s reply brief that, regardless of whether these members have sufficiently recovered, or are likely to do so at any time in the near future, counsel now has the assistance necessary to prepare its response to the pending summary judgment motion.

CONCLUSION

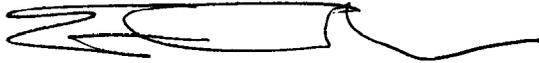
Applicant now has had more than three months to respond to Opposer’s motion for summary judgment. Faced with an undisputed record proving Opposer’s priority, as well as Applicant’s own admissions of likelihood of confusion, and the decisions of two federal courts finding that Applicant does not have and never had superior trademark rights, Applicant has

chosen not to respond to the summary judgment motion, instead launching lengthy personal attacks against Opposer in the guise of a request for more time. For the reasons set forth above, the Board should deny Applicant's motion in its entirety and enter judgment for Opposer on its unopposed motion for summary judgment. In the event the Board does decide to suspend this matter, or to grant Applicant a further extension of time to respond to Opposer's motion for summary judgment, this extension should be for no more than 30 days, and in any event should be less than the six months requested by Applicant.

Dated: New York, New York
April 5, 2005

Respectfully submitted,

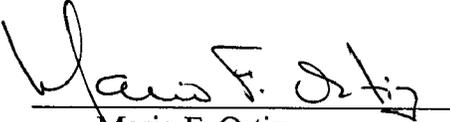
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CERTIFICATE OF SERVICE

I hereby certify that a true and correct copy of the MEMORANDUM IN OPPOSITION TO APPLICANT'S NEW BASIS FOR MOTION TO SUSPEND was served via first class mail to Cynthia Johnson Walden, Esq., Fish and Richardson, P.C., 225 Franklin Street, Boston MA 02110-2804, attorneys for Applicant Creative Arts by Calloway, LLC, on this 5th day of April, 2005.


Mario F. Ortiz