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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
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July 8, 2005

Commissioner for Trademarks
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Alexandria, VA 22313-1451

Re: Christopher Brooks v. Creative Arts by Calloway, LLC
Opposition No. 91160266 (CAB CALLOWAY)



Dear Sir/Madam:

I am writing in reference to Applicant's Motion in Opposition to Opposer's Motion for Summary Judgment, which was filed by First Class mail on July 1, 2005 in the above-referenced matter. Enclosed please find Exhibit A ("Applicant's Response to Opposer's Statement of Undisputed Material Facts") to APPLICANT'S MEMORANDUM IN OPPOSITION TO OPPOSER'S MOTION FOR SUMMARY JUDGMENT, which inadvertently was not included with the paper filing on July 1, 2005.

Please contact me with any questions.

Very truly yours,

Cynthia Johnson Walden

cc: Barbara A. Solomon, Esq.
Evan Gourvitz, Esq.

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EXHIBIT A

**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

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

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**APPLICANT'S RESPONSE TO OPPOSER'S
STATEMENT OF UNDISPUTED MATERIAL FACTS**

Applicant, Creative Arts By Calloway, LLC ("Applicant" and "Creative Arts") hereby responds to the Statement of Undisputed Material Facts submitted by Opposer, Christopher Brooks, ("Opposer"). For the convenience of the Board and the parties, each numbered paragraph of Opposer's Statement of Undisputed Material Facts is quoted in full immediately preceding Applicant's response thereto.

1. Opposer, who uses the stage names Calloway Brooks or C. Calloway Brooks, is the eldest grandson of the internationally famous jazz musician Cab Calloway, who died in 1994.

Response: Undisputed, noting that Opposer's given name, Christopher Williams Brooks, does not include the word Calloway.

2. Opposer is a 1980 Dean's List graduate of the New England Conservatory of Music who, from 1978 to 1993, repeatedly performed professionally with his grandfather at venues ranging from private parties to the Kennedy Center and Lincoln Center.

Response: As for the first clause of the sentence, admit for the purpose of summary judgment as the fact is not material to the outcome of the opposition. Applicant does not have information sufficient to confirm or deny the first clause of this sentence, however, the evidence submitted by Opposer does not show that Opposer *repeatedly* performed with Cab Calloway. Rather, the evidence shows that Opposer and Cab Calloway appeared on the same stage on three occasions: (1) at Coppin State College in Baltimore, (2) at Kennedy Center, and (3) at Jordan Hall in Boston. Applicant requires discovery to take a position on whether Opposer repeatedly performed with Cab Calloway.

3. A full-time musician, Mr. Brooks performs with his musical ensemble THE CAB CALLOWAY ORCHESTRA.

Response: Undisputed. Applicant does not dispute this allegation. However, Applicant points out that Opposer also regularly performs under band names other than THE CAB CALLOWAY ORCHESTRA such as the Cab Jivers.

4. Mr. Brooks is the sole proprietor, musical director and lead performer of the Orchestra.

Response: Undisputed.

5. Since December 1998, and prior to any date upon which Applicant can rely, Opposer has been using the mark THE CAB CALLOWAY ORCHESTRA continuously with the Orchestra's live musical performances.

Response: Applicant requires discovery to take a position on this proposed statement of fact. Opposer proffers three documents entitled "Agreements[s] Between Sponsor and Artist" as evidence that Opposer allegedly has used the mark THE CAB CALLOWAY ORCHESTRA continuously since 1998. These agreements are not evidence of service mark usage. Further, the agreements specifically state "Artist is not liable for failure to appear or perform on the schedules [sic] date in the event of illness, sever weather, or other extreme or unusual conditions beyond artist control....The program is subject to change." These agreements do not even remotely show continuous service mark usage of THE CAB CALLOWAY ORCHESTRA from 1998. Even if Opposer did perform as he alleges at the Sleepy Hollow Country Club in Scarborough, New York, there is no evidence, other

than Opposer's word, that he used the service mark THE CAB CALLOWAY ORCHESTRA in connection with that performance. In the civil litigation between the parties, Opposer submitted evidence that he also performs under band names other than The Cab Calloway Orchestra such as the Cab Jivers. Moreover, while the advertisements attached as Exhibit 4 to Opposer's declaration do show (infringing) service mark use, the advertisements do not show use of THE CAB CALLOWAY ORCHESTRA in 1998 or 1999.

Further, there are other dates, in addition to the July 23, 1999 filing date, on which Applicant may rely upon for establishing prior trademark and service mark rights in the CAB CALLOWAY designation in connection with goods and services that were not at issue in the prior litigation including: (1) educational services in the field of the arts; (2) entertainment services in the nature of live musical and theatrical performance; (3) clothing; and (4) sound recordings. Declaration of Cabella Calloway Langsam, ¶¶ 3, 9, 10, 11, 12, 18, Exs. 1, 5, 6, 7, 12. Applicant must be allowed to develop the record during the testimony period to further establish its prior rights.

6. The Orchestra has performed professionally hundreds of times throughout the United States at venues ranging from New York to Illinois to California, including at such world-famous venues as Carnegie Hall, Lincoln Center and Birdland.

Response: Applicant requires discovery to take a position on this statement of fact. The evidence submitted in support of such performances does not show use of THE CAB CALLOWAY ORCHESTRA prior to Applicant's filing date, nor does it show use of the THE CAB CALLOWAY ORCHESTRA service mark hundreds of times prior to Applicant's filing date, or even that The Cab Calloway Orchestra has performed hundreds of times throughout the United States.

7. The Orchestra performs songs written and/or recorded by Cab Calloway, jazz standards by a variety of other artists, and Opposer's original songs and arrangements.

Response: Undisputed.

8. The Orchestra's performances have been advertised and promoted nationwide, including through Opposer's website, and have received favorable notices.

Response: Applicant requires discovery to take a position on this statement of fact. Applicant does not dispute that Opposer currently promotes The Cab Calloway Orchestra on his website. The advertisements for and reviews of Opposer's performances submitted by Opposer are not for any performances occurring before Applicant's filing date of July 23, 1999, nor is there any evidence that they were distributed nationwide prior to July 23, 1999.

9. Since at least as early as 1999, and prior to any date upon which Applicant can rely, Opposer has been using the mark THE CAB CALLOWAY ORCHESTRA continuously in connection with the sale of compact discs and videotapes.

Response: Applicant requires discovery to take a position on this statement of fact. Applicant does not dispute that since sometime in 1999 Opposer has made sporadic sales of compact discs and videos that have born that mark THE CAB CALLOWAY ORCHESTRA. In addition, Applicant must be afforded the opportunity to establish that, through its predecessors in interest, Applicant owns trademark and service mark rights in the CAB CALLOWAY mark in connection with various goods and services that predate Opposer's alleged first use of the mark THE CAB CALLOWAY ORCHESTRA.

10. Opposer has released two different compact discs to date, and roughly 2,000 copies have been sold throughout the United States.

Response: Opposer has only demonstrated the sale of at most twenty compact discs prior to Applicant's July 23, 1999 filing date.

11. Opposer has sold roughly 300-400 copies of his videotape to date throughout the United States.

Response: Opposer has only demonstrated the sale of at most six videotapes prior to Applicant's July 23, 1999 filing date.

12. Applicant is a Delaware limited liability company founded by its predecessor, Cab Calloway's third wife and widow Zulme Calloway, and her relatives to manage whatever rights she acquired (by will or otherwise) in Cab Calloway's name, likeness, voice and intellectual property.

Response: Disputed, only with respect to the characterization of Zulme Calloway as Cab Calloway's third wife. Zulme Calloway was Mr. Calloway's second wife.

13. On July 23, 1999, Applicant's predecessor filed intent-to-use application Serial No. 75/761, 159 (the "Application") to register CAB CALLOWAY.

Response: Undisputed.

14. The services in the Application are "[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.

Response: Undisputed.

15. On February 20, 2001, Applicant's predecessor filed an amendment to the Application to allege use of the mark on "all the goods/services listed in the Application/Notice of Allowance," claiming a first use date of January 1, 1928 and a first use in commerce date of January 1, 1929.

Response: Undisputed for present purposes.

16. The amendment was false, since it asserted use of the mark since 1928 on items such as “on-line retail store services featuring compact discs...video tapes [and] digital video and audio discs” (e.g., *id.*, 10/3/00 Action Letter) that clearly did not exist as of the claimed date of first use.

Response: Undisputed; however, Applicant denies any implication that Applicant intended to defraud the Trademark Office.

17. On April 16, 2001, Applicant filed suit against Opposer in the United States District Court for the Southern District of New York.

Response: Undisputed.

18. In the Civil Action, Applicant did not dispute that Opposer had been using THE CAB CALLOWAY ORCHESTRA in connection with his entertainment services since 1998, and in connection with his compact discs and videotapes since 1999.

Response: When Opposer began using THE CAB CALLOWAY ORCHESTRA was not at issue in the litigation, was not litigated, and was not material to the outcome of the case.

19. In the Civil Action, Applicant admitted that a likelihood of confusion exists between Applicant’s alleged mark CAB CALLOWAY used in connection with entertainment services and Opposer’s mark THE CAB CALLOWAY ORCHESTRA used in connection with goods and entertainment services.

Response: Undisputed.

20. Applicant’s suit was dismissed by the U.S. District Court for the Southern District of New York on summary judgment on December 11, 2001.

Response: Undisputed.

21. The basis for the dismissal was that as of the time of the suit Applicant had no rights in and had made no use of CAB CALLOWAY as a mark.

Response: Disputed. The basis of the dismissal was that Applicant had no *service* mark rights in CAB CALLOWAY in connection with *entertainment services* because Mr. Cab Calloway’s will did not transfer an ongoing business to Ms. Zulme Calloway (“Cab Calloway had not provided in

his will for the continuation of his orchestra or other entertainment services”) and Zulme Calloway did not continue Mr. Calloway’s entertainment services after his death (“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.”). *See Creative Arts by Calloway, LLC v. Brooks*, No. 01 Civ 3192 (CLB) (S.D.N.Y. Dec. 11, 2001) (Memorandum & Order, p. 9). The district court also held that Opposer’s use of “Cab Calloway” in the designation THE CAB CALLOWAY ORCHESTRA was a descriptive fair use, not a service mark use. *Id.* at pp. 10-11. Whether Applicant had rights in contexts other than Mr. Calloway’s entertainment services was not at issue in the suit.

22. The decision was affirmed on appeal by the U.S. Court of Appeals for the Second Circuit on Oct. 11, 2002.

Response: Applicant does not dispute that the judgment was affirmed. The Second Circuit did note, however, that Opposer’s use of the designation THE CAB CALLOWAY ORCHESTRA was not a descriptive fair use.

23. Both the district court and appeals court in the Civil Action found that Opposer had commenced his use of THE CAB CALLOWAY ORCHESTRA for entertainment services in 1998.

Response: Disputed. The appeals court made no findings. With respect to any statements made by the district court, the issue of Opposer’s first use was not at issue in the Civil Action, was not litigated in the Civil Action, was not material to the outcome of the Civil Action, and is not precluded from determination in another action. At most, the district court’s statements regarding Opposer’s use of THE CAB CALLOWAY ORCHESTRA was dicta with no preclusive effect.

24. Both the district court and the appeals court in the Civil Action acknowledge Opposer’s use of THE CAB CALLOWAY ORCHESTRA as a mark in connection with live musical performances since 1998, as well as Opposer’s sale of compact discs and videotapes of his performances.

Response: Disputed. The appeals court made no findings. In addition, dispute to the extent Opposer is asserting that the date Opposer first began using THE CAB CALLOWAY ORCHESTRA in connection with live musical performances, compact discs, and videotapes was an issue in the Civil

Action, was litigated in the Civil Action, and was material to the outcome of the Civil Action. The date of Opposer's first use was not at issue in the Civil Action, was not litigated in the Civil Action, was not material to the outcome of the Civil Action, and is not precluded from determination in another action. Moreover, the district court's only reference to Opposer's compact discs and a videotape is "Defendant has released two compact discs and a videotape." *See Creative Arts by Calloway, LLC v. Brooks*, No. 01 Civ 3192 (CLB) (S.D.N.Y. Dec. 11, 2001) (Memorandum & Order, p. 3).

25. Applicant filed an amended statement of use for the Application on October 24, 2002, claiming use of the mark on all of the services in the Application except "[r]etail stores, retail outlets and on-line retail services," and claiming first use and first use in commerce dates of January 1, 1929.

Response: Undisputed.

26. On December 17, 2002, Applicant requested that its amendment to allege use be withdrawn and that the Application once again proceed to publication in connection with all services exclusively as an intent-to-use application under Section 1(b) of the Lanham Act.

Response: Undisputed.

27. The earliest priority date upon which Applicant can rely for the services set forth in the Application is the date it filed the Application, July 23, 1999.

Response: Disputed. Applicant, by and through its predecessor, does have certain rights in the CAB CALLOWAY mark that predate July 23, 1999, the exact dates and quantum of which will have to be established by further evidence. For instance, Applicant's licensee The Cab Calloway School of the Arts in Wilmington, Delaware, which adopted the name The Cab Calloway School of Arts in 1993, has used the CAB CALLOWAY designation under license in connection with a variety of products and services including shirts, jackets, school supplies, the production and presentation of concerts and theatrical performances, and education services, among other things. Langsam Decl. ¶¶ 9-12, Exs. 5-7.

28. The parties' marks considered in their entirety are nearly identical in appearance, sound, connotation and commercial impression.

Response: Undisputed.

29. In the Civil Action, Applicant stated that Opposer's mark THE CAB CALLOWAY ORCHESTRA is "deceptively similar or identical" to its own alleged mark CAB CALLOWAY, and that THE CAB CALLOWAY ORCHESTRA is a "variation or permutation" of CAB CALLOWAY.

Response: Undisputed.

30. Opposer's goods and services and the services set forth in the Application are identical or closely related.

Response: Undisputed.

31. Applicant stated in the Civil Action that Opposer is using THE CAB CALLOWAY ORCHESTRA "in connection with goods and services which are the same or related to the services of [Applicant]."

Response: Undisputed.

32. Opposer uses the mark THE CAB CALLOWAY ORCHESTRA in connection with entertainment services and prerecorded media—specifically, live musical performances, compact discs, and videotapes.

Response: Undisputed.

33. Purchasers of Opposer's goods and services are not any more sophisticated than the average consumer, and may include people who attend a concert on impulse when passing by a venue where Opposer is performing, or choose to buy a compact disc or videotape after seeing Opposer perform.

Response: Undisputed.

34. Opposer's goods and services are relatively inexpensive.

Response: Undisputed.

35. Opposer and his orchestra have earned roughly \$1 million in connection with his use of the mark THE CAB CALLOWAY ORCHESTRA for the Orchestra and for the sale of compact discs and videos over the course of six years.

Response: Opposer has offered no documentary support for this proposed statement of fact. Opposer has performed under a variety of names, only one of which is The Cab Calloway Orchestra, and has not offered any documentary evidence that the amount of the money he has allegedly earned is derived from his unauthorized use of the mark THE CAB CALLOWAY ORCHESTRA. Applicant requires discovery to take any position on this proposed statement of fact.

36. The Orchestra has broadcast nationally as part of the entertainment at the Preakness Stakes horse race, and recently performed a version of the “Jeopardy” theme in radio promotions for that television game show that were distributed nationally.

Response: Applicant requires discovery to take any position on this proposed statement of fact.

37. The Orchestra has received substantial media coverage.

Response: The evidence does not show that the Orchestra has received *substantial* media coverage, as Opposer has proffered only six new articles. Applicant requires discovery to take any position on this proposed statement of fact.

38. No third parties are using marks similar to THE CAB CALLOWAY ORCHESTRA for similar goods or services.

Response: Applicant’s licensees make use of the mark CAB CALLOWAY in connection with various goods and services including clothing, educational services, and the production of musical concerts and theatrical performances. Langsam Decl., ¶¶ 9-12, 18, Exs. 5-7, 12.

39. Applicant has not yet made any use of CAB CALLOWAY as a mark.

Response: Disputed. See Langsam Decl., ¶¶ 9-12, 18, Exs. 5-7, 12.

40. There is and has been no consent, agreement or assignment between the parties.

Response: Undisputed.

41. There would be substantial potential confusion if Applicant were allowed to register CAB CALLOWAY for services similar or identical to the goods and services offered by Opposer under the mark THE CAB CALLOWAY ORCHESTRA.

Response: Applicant does not deny that the parties' claimed marks are confusingly similar. Applicant maintains, however, that the substantial potential for confusion is based on Opposer's infringing use.

CERTIFICATE OF SERVICE

The undersigned hereby certifies that a copy of the foregoing EXHIBIT A to APPLICANT'S MEMORANDUM IN OPPOSITION TO OPPOSER'S MOTION FOR SUMMARY JUDGMENT, has this 8th day of July 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.
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