

ESTTA Tracking number: **ESTTA39572**

Filing date: **07/21/2005**

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

Proceeding	91160266
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Submission	REPLY MEMORANDUM IN FURTHER SUPPORT OF OPPOSER'S MOTION FOR SUMMARY JUDGMENT
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Attachments	91160266 Reply Memo.pdf (15 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.	:	
-----X	:	

**REPLY MEMORANDUM IN FURTHER SUPPORT
OF OPPOSER'S MOTION FOR SUMMARY JUDGMENT**

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Opposer, Christopher Brooks (“Opposer”), submits this memorandum in further support of his motion for summary judgment.

INTRODUCTION

In its opposition brief, Applicant does not dispute that Opposer commenced use of his mark THE CAB CALLOWAY ORCHESTRA prior to the filing date of Applicant’s intent-to-use application. Applicant also does not dispute that its applied-for mark is confusingly similar to Opposer’s prior-used mark THE CAB CALLOWAY ORCHESTRA. Applicant has not raised a single issue of material fact or introduced any evidence to contradict Opposer’s factual assertions concerning his continuous use of THE CAB CALLOWAY ORCHESTRA mark in connection with musical performances and sound and video recordings. Nor can Applicant point to any discovery that it took to refute any of the facts set forth in Opposer’s moving declaration.

Lacking even an iota of evidence to contradict the showing made by Opposer, Applicant instead resorts to two legally unsupportable arguments: (1) Opposer’s mark THE CAB CALLOWAY ORCHESTRA is not inherently distinctive, and Opposer therefore has no protectable common law rights in that mark, because he did not establish secondary meaning prior to Applicant’s filing date, and (2) in any event, Opposer’s rights are junior to Applicant’s common law rights in CAB CALLOWAY. Both of these arguments are severely flawed. First, as conceded by Applicant’s own intent-to-use application for CAB CALLOWAY, Opposer’s full mark THE CAB CALLOWAY ORCHESTRA is inherently distinctive for Opposer’s goods and services. Second, two federal courts have found in prior litigation between the parties that Applicant has no common law rights in CAB CALLOWAY as a mark, and Applicant has offered no evidence to the contrary. Accordingly, Opposer’s motion for summary judgment should be granted and Applicant’s application to register CAB CALLOWAY must be refused.¹

¹ In the discussion below, “Opp. Mem.” refers to Opposer’s December 30, 2004 Memorandum in Support of Opposer’s Motion for Summary Judgment. “Brooks Decl.” refers to the December 28, 2004 Declaration of Christopher Brooks in support of that motion, and “Opp. Ex. [1]-[25]” refers to the exhibits in support of that motion. “App. Mem.” refers to Applicant’s July 1, 2005 Memorandum in Opposition to Opposer’s Motion, “Langsam Decl.” refers to the June 24, 2005

ARGUMENT

I. OPPOSER'S MARK IS PROTECTABLE

A. Opposer's Mark THE CAB CALLOWAY ORCHESTRA is Inherently Distinctive for the Goods and Services He Offers Under That Mark

Applicant's argument that Opposer's mark THE CAB CALLOWAY ORCHESTRA is not inherently distinctive (App. Mem. at 7-9) is nothing more than an extended discussion concerning the protectability of personal names standing alone, and attempts to evade the facts of this case and Applicant's own actions. Notably, Applicant ignores the fact that its own intent-to-use application seeks to register CAB CALLOWAY for services similar or identical to the goods and services provided by Opposer under his mark, *not* on the ground that the term has acquired secondary meaning, but, presumably, on the basis that the mark is inherently distinctive for these services. *See* TMEP §1212 (if a mark is not inherently distinctive, it may be registered on the Principal Register only upon proof of acquired distinctiveness). If Applicant considers CAB CALLOWAY to be inherently distinctive for the provision of live music concerts and the sale of CDs and videotapes, why wouldn't THE CAB CALLOWAY ORCHESTRA also be inherently distinctive for the same or related goods and services? Applicant has no answer.

More fundamentally, Applicant has mischaracterized the issue in this opposition by ignoring Opposer's actual mark, THE CAB CALLOWAY ORCHESTRA, and his goods and services. While the name "Cab Calloway" may not be inherently distinctive to refer to the individual Cab Calloway or his goods and services, Opposer's mark THE CAB CALLOWAY ORCHESTRA *is* inherently distinctive as applied to Opposer's own goods and services.

CAB CALLOWAY, as used in Opposer's mark, is not the name of Opposer or a living person. Rather, it is a historical name. As noted by the leading trademark treatise, "Historical names that are widely recognized as such do not really fall into the classical 'personal name' category at all," and "do not suffer from the lack of inherent distinctiveness that is the basis for

Declaration of Cabella Calloway Langam in opposition to the motion, and "App. Ex. [1]-[12] or [A] refers to the exhibits in opposition to that motion.

requiring proof of secondary meaning.” 2 J. Thomas McCarthy, *McCarthy on Trademarks & Unfair Competition* § 13:25 (4th ed. 2005) (hereinafter “*McCarthy*”). Similarly, the Restatement (Third) of Unfair Competition § 14, comment *e* (1995), states that “[i]f a mark consists of the name of an historical or other noted person and is likely to be recognized as such by prospective purchasers, secondary meaning ordinarily will not be required.” *See also, e.g., Lucien Piccard Watch Corp. v. Since 1868 Crescent Corp.*, 165 U.S.P.Q. 459, 461 (S.D.N.Y. 1970) (DA VINCI not merely a surname).² Here, Applicant readily admits that Cab Calloway is a historical figure and noted person in American music. (*E.g.*, Langsam Decl. ¶¶ 2-7.) It is in this context that Opposer is using the name, and consumers readily will recognize this use of CAB CALLOWAY by Opposer in his full mark. Indeed, as noted by the district court in the prior litigation between the parties, “any literate jazz aficionado knows Cab Calloway is dead.” (Opp. Ex. 14 at 11).

Since CAB CALLOWAY is inherently distinctive as a historical name, Opposer’s full mark also is inherently distinctive as applied to his goods and services. Opposer’s mark THE CAB CALLOWAY ORCHESTRA includes the full name of a deceased historical person, Opposer’s grandfather, as well as THE and ORCHESTRA. Opposer uses this mark for a jazz band that performs musical works by various artists, as well as original songs and arrangements. (Brooks Decl. ¶ 6.) Consumers, confronted with Opposer’s use of the this mark for his goods and services, will not believe it merely describes Opposer (who is not named Cab Calloway), his band (which does not include Cab Calloway), or the music of that band (which is not limited to that of Cab Calloway), but rather will understand that it suggests a “legacy band” that plays a variety of jazz music *as a tribute to* Opposer’s grandfather, Cab Calloway. (*Id.* ¶¶ 5-6). As

² Even if CAB CALLOWAY were not a historical name, it still would not be considered by the public as “primarily merely a surname,” *see* 15 U.S.C. § 1052(e)(4), or even as a personal name, given its enormous rarity. According to U.S. Census records, the surname “Calloway” was possessed by .008% of the surveyed population in 1990, and the first name “Cab” was not one of the 1,219 most common first names in the sample. (Exs. 17-19.) The combination of CAB CALLOWAY therefore would be extraordinarily rare, and no secondary meaning would be required for the mark to be protected. *See* TMEP § 1211.01(a)(v).

such, it is protectable without evidence of secondary meaning.³ Even if the CAB CALLOWAY portion of Opposer's mark were considered a personal name, rather than properly as a historical name, Opposer's mark considered as a whole is distinctive. *See, e.g., In re Hutchinson Tech. Inc.*, 852 F.2d 552, 554 (Fed. Cir. 1988); *Lane Capital Mgmt., Inc. v. Lane Capital Mgmt., Inc.*, 192 F.3d 337, 346 (2d Cir. 1999) ("when the mark at issue is a composite mark consisting of personal names and additional words, the question becomes what the purchasing public would think when confronted with the mark as a whole"); *Estate of P.D. Beckwith, Inc. v. Comm'r of Patents*, 252 U.S. 538, 545-46 (1920) (commercial impression of a trademark is derived from it as a whole, so should be considered in its entirety). Applicant offers no authority to the contrary.

B. Applicant Has Failed to Contest Any of Opposer's Evidence of Secondary Meaning

While it is not necessary for Opposer to show secondary meaning in his inherently distinctive mark THE CAB CALLOWAY ORCHESTRA for it to be protectable, Opposer has in fact introduced extensive evidence of secondary meaning. (*E.g.*, Brooks Decl. ¶¶ 2, 7-10, 12-14; Opp. Exs. 1, 4-6, 12.) Accordingly, as a matter of undisputed fact, Opposer also has proven secondary meaning in its mark. Despite Applicant's discussion of the subject (App. Mem. 3-7), it has failed to dispute or contradict any of Opposer's evidence of secondary meaning.

II. APPLICANT DOES NOT HAVE PRIOR COMMON LAW RIGHTS IN CAB CALLOWAY

Applicant and its predecessor have repeatedly changed their tune about when they acquired trademark or service mark rights to CAB CALLOWAY. First they flip-flopped on the basis of the application at issue, changing it from intent-to-use to actual use and back again until finally conceding – after admittedly making false statements of actual use – that the application should proceed only on an intent-to-use basis. (*E.g.*, App. Ex. A at ¶¶ 13, 15-16, 25-26). When Applicant advised the Examiner in 2002 that its application was to be based solely on an intent-

³ *See also* U.S. Reg. Nos. 2,677,799 (THE DUKE ELLINGTON ORCHESTRA), 2,459,428 (COUNT BASIE ORCHESTRA), 2,438,337 (THE TOMMY DORSEY ORCHESTRA). All of these appear to have been registered without the PTO requiring any proof of secondary meaning.

to-use, it never suggested that it had common-law rights in the mark. After all, how could it when two federal courts had found the very opposite? Yet now, in a desperate attempt to avoid summary judgment, Applicant again asserts prior rights in CAB CALLOWAY as a mark.

A. Applicant Has Already Been Found to Have No Common Law Rights

As noted in Opposer's initial brief (Opp. Mem. at 10), "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." *Mother's Restaurant Inc. v. Mama's Pizza, Inc.*, 221 U.S.P.Q. 394, 397 (Fed. Cir. 1983). This requires that (1) an issue is identical to one decided in the first action, (2) the issue was actually litigated in the first action, (3) the resolution of the issue was essential to a final judgment in the first action, and (4) the party to be precluded had a full and fair opportunity to litigate the issue in the first action. *Shell Petroleum, Inc. v. United States*, 319 F.3d 1334, 1338 (Fed. Cir. 2003); see *Mother's Restaurant*, 221 U.S.P.Q. at 397-99.

Here, Applicant concedes that the basis of the court's prior decision was that Applicant "had no *service* mark rights in CAB CALLOWAY in connection with *entertainment services*." (App. Ex. A ¶ 21.) However, the court's holding actually was broader. The district court stated that "[t]he issue is whether [Applicant] 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 [Opposer]." (Opp. Ex. 14 at 6.) It noted that "[t]here is no evidence that [Cab Calloway] had or exercised any common law service mark in his name," that "the court finds no evidence of such rights in the extensive submissions in this case,"⁴ and that Applicant's predecessor "made no use of the alleged service mark since Cab Calloway's death in

⁴ By way of example, Applicant argued in the district court that "Cab Calloway used [CAB CALLOWAY] [in] connection with his entertainment services during his lifetime," that "Cab Calloway's entertainment services . . . continue to be sold to the public in the form of recordings of his music and his performances" and that "[Applicant] has . . . assumed the license for the sale of clothing bearing Cab Calloway's image." (Opp. Ex. 24 at 7, 11.) Applicant also argued in the appeals court, for example, that "Cab Calloway used his name on his recordings and compositions that were sold to the public," and that "Cab Calloway's entertainment services, such as the sale of his recordings, survive his death." (Opp. Ex. 25 at 3-4.)

1994, except to apply for a trademark registration.” (*Id.* at 7-9). It concluded that “[Applicant] has failed to present *any evidence* which would justify a finding by a trier of fact that *it or its assignors* owned or used *any common law service mark* at the time this case was filed.” (*Id.* at 10) (emphasis added). The appeals court affirmed. (Opp. Ex. 15 at 1-2.) Accordingly, Applicant now is precluded from challenging the court’s finding that it had no common law rights as of its filing date. *E.g., Shell Petroleum*, 319 F.3d at 1338; *Mother’s Restaurant*, 221 U.S.P.Q. at 397-99.

B. Applicant Cannot Dispute that Opposer Commenced His Use of THE CAB CALLOWAY ORCHESTRA Prior to the Application Filing Date

While Applicant claims that the issue of whether Opposer has a common law right earlier than Applicant’s filing date was not litigated (App. Mem. at 10-11), the parties clearly litigated and addressed the very issue present in this motion, namely “whether [Applicant] holds rights superior to [Opposer].” (Opp. Ex. 14 at 6.) Since priority was the heart of the civil litigation, and since the very facts now relied on by Applicant were addressed in that litigation (*see* section (C)(1)-(3) below), Applicant had a full and fair opportunity to dispute Opposer’s date of first use. Accordingly, Applicant now is precluded from challenging the court’s finding that Opposer commenced its own use in 1998. *E.g., Shell Petroleum*, 319 F.3d at 1338.

Indeed, it is a matter of undisputed fact that by Applicant’s filing date Opposer had common law rights in his mark THE CAB CALLOWAY ORCHESTRA. Applicant concedes, as it must, that Opposer sold both CDs and videos bearing the mark THE CAB CALLOWAY ORCHESTRA prior to Applicant’s filing date for its application. (App. Ex. A ¶¶ 9-11.) In fact, Opposer has provided extensive evidence of his use of THE CAB CALLOWAY ORCHESTRA as a mark prior to Applicant’s filing date, including his undisputed sworn declaration, performance contracts, and sales receipts for CDs and videos. (Brooks Decl. ¶¶ 7, 11-13; Opp. Exs. 3, 7-11). This evidence is sufficient for this motion. TBMP §§ 528.05(b) (clear, convincing, uncontradicted statements in declaration made on personal knowledge admissible); 528.05(e) (materials admissible if competent, relevant, and authenticated by proper declaration).

While Applicant seeks to contest Opposer's priority for his entertainment services (App. Ex. A ¶¶ 5, 18), it has offered no evidence contradicting the dates set forth in Opposer's declaration and exhibits, and its reliance on mere denials and conclusory assertions is insufficient to defeat summary judgment. *See* TBMP § 528.01.⁵

C. Applicant Cannot Rely on Any Use of the CAB CALLOWAY Mark Prior To Its Application Filing Date

Even if issue preclusion did not prevent Applicant from asserting prior rights, the arguments it makes in an attempt to show it obtained common law rights in CAB CALLOWAY as a service mark for "education services and the production of concerts and plays," and as a trademark for "clothing" and "sound recordings" (App. Mem. 13-19), are without any merit.⁶

1. Applicant Cannot Assert Service Mark Rights in CAB CALLOWAY for Education Services or the Production of Concerts and Plays

Applicant claims common law service mark rights in CAB CALLOWAY for "education services" and "the production of concerts or plays" merely because a performing arts school in Wilmington Delaware "sought permission from Mr. Calloway to use his name in the name of the school," and uses "the name Cab Calloway School of the Arts." (App. Mem. at 14.)

While Applicant claims that this school is "a licensee of Applicant (including its predecessor in interest)" (App. Mem. 14-15), it has offered *no evidence of any license to the school by Applicant or its predecessors of CAB CALLOWAY as a mark for any goods or services*. Even Applicant's declaration does *not* refer to a trademark or service mark license, but states only that "Cab Calloway authorized the school to use his name as the name of the school"

⁵ Applicant's claim that it now needs discovery (App. Ex. A ¶¶ 5-6, 8-9) is too little too late. Opposer's claimed first use date was pleaded in his Notice of Opposition. Applicant cannot seek discovery now, after the discovery period has closed, and after it deliberately chose to forego any discovery to challenge that allegation. *See* TBMP § 509.01 (to reopen time, must file motion showing failure to act due to excusable neglect); Fed. R. Civ. P. 6(b); *see also* TBMP § 528.06.

⁶ Applicant claims that it must "be allowed to develop the record during the testimony period to further establish its prior rights" in connection with these goods and services. (App. Ex. A ¶ 5.) This request is particularly inappropriate given the almost six months Applicant had to prepare its response to Opposer's summary judgment motion, and to prepare supporting exhibits.

and that “Cab Calloway and his successors in interest also authorized the [school] to sell various clothing items, school supplies, and other products” bearing the school’s name. (Langsam Decl. ¶¶ 9, 12.) In fact, in her deposition in the prior litigation Ms. Langsam admitted that there was *no* written agreement between Applicant or its predecessors with the school, and that the school actually chose this name by a vote of the student body to which Cab Calloway merely gave his assent. (Opp. Ex. 20 at 32-33, *see id.* at 38.)⁷

The use of the “Cab Calloway” name by the school is simply an honorarium. It does not have a single hallmark of a license necessary for the use of a mark to inure to Applicant’s benefit. *See, e.g., Central Fidelity Banks, Inc. v. First Bankers Corp. of Florida*, 225 U.S.P.Q. 438, 440 (T.T.A.B. 1984); TMEP § 1201.03(f). Indeed, Applicant has no more of a trademark or service mark license with the school than the estates of the Rev. Martin Luther King, Jr., John F. Kennedy, or Ronald Reagan do with the many schools that have named themselves after those historical personages.⁸

2. Applicant Cannot Assert Trademark Rights in CAB CALLOWAY for Clothing, and Any Such Rights Are Irrelevant to this Opposition

Applicant also contends that it owns common law rights in the CAB CALLOWAY mark for clothing. (App. Mem. at 15.) This has no relevance to this opposition proceeding, which is based on a likelihood of confusion between Opposer’s use of his mark THE CAB CALLOWAY ORCHESTRA for entertainment services and prerecorded media and the services in Applicant’s application, which do not include clothing.

⁷ While Opp. Ex. 20 initially was marked confidential, Applicant’s counsel later confirmed in a May 30, 2001 letter that Applicant did not designate any part of the deposition as confidential.

⁸ Even if the school had been licensed to use “Cab Calloway” in its name, the mere fact that the school may offer student plays, concerts, or musicals, in the promotion of which “Cab Calloway School of the Arts” is used descriptively to identify the school itself (App. Ex. 6), no more gives Applicant service mark rights for “entertainment services” than it has acquired trademark rights for books merely because the school may include the “Cab Calloway School of the Arts” library. Furthermore, “educational services” are irrelevant to this opposition.

Even so, it is clear that no such common law rights in CAB CALLOWAY for clothing exist. To the extent that Applicant claims rights through a license to the Cab Calloway School of the Arts, as discussed above, that school's use of the Cab Calloway name on any products is not based on a license from Applicant, and does not accrue to Applicant's benefit. To the extent that Applicant claims rights through a license its predecessor granted to Gear Ink. (Opp. Mem. at 15), Applicant raised these rights in the prior litigation (*e.g.*, Opp. Ex. 21 ¶¶ 12-14; Ex. 22 ¶ 20)). The owner of Gear Ink. declared that his company "does not have a written agreement with [Applicant], with [Applicant's predecessor] or with any third party," does "not submit our shirts to anyone for approval," and has never seen a copy of any prior agreement. (Opp. Ex. 23 ¶¶ 3-4.) Thus, again there is no license through which Applicant can claim a benefit.

3. Applicant Cannot Assert Trademark Rights in CAB CALLOWAY for Sound Recordings

Finally, Applicant alleges that it has common law trademark rights in the CAB CALLOWAY mark for sound recordings, again allegedly acquired through Cab Calloway. (Opp. Mem. 15-17.) Because it cannot, Applicant does not claim or provide evidence that it or its predecessors own, control, or license any products (*e.g.*, CDs) sold to the public bearing the CAB CALLOWAY mark. (*See id.*) Applicant also does not offer any evidence that it or its predecessors licensed the mark CAB CALLOWAY in connection with sound recordings, or even used CAB CALLOWAY in connection with sound recordings other than descriptively to refer to the musician himself. (*See id.*) Rather, Applicant claims *only* that Cab Calloway controlled the sound of the recordings he made. (*Id.*) This is not evidence of use of CAB CALLOWAY as mark, let alone use sufficient to create common law trademark rights in CAB CALLOWAY for sound recordings. *E.g.*, 2 *McCarthy* § 16:11 ("[t]o acquire ownership of a trademark, one must actually *use the mark in the sale of goods or services*") (emphasis added).

Again, Applicant raised this issue in the prior litigation, stating that "Cab Calloway sold hundreds of thousands of recordings of his compositions and performances" and that "[t]he sale of Cab Calloway's recordings continue to this day." (Opp. Ex. 22 ¶¶ 16-17.) However, it

conceded in deposition that it had not actually granted record companies that use CAB CALLOWAY on their recordings any permission to do so. (Opp. Ex. 20 at 86-88, *see id.* at 38.)

CONCLUSION

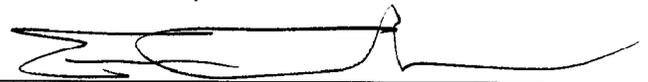
Two federal courts already have held that Cab Calloway did not, and Applicant does not, have common law rights in CAB CALLOWAY as a mark. Applicant has admitted as much, filing its application based on intent to use. In contrast to Applicant's non-use, it cannot be disputed that Opposer has made continuous use of his mark THE CAB CALLOWAY ORCHESTRA in connection with his performances and recordings since prior to Applicant's intent-to-use application filing date. It cannot be disputed that Opposer's mark and Applicant's alleged mark are confusingly similar and are or are intended to be used on related goods. And, as a matter of law, it cannot be disputed that Opposer's mark is inherently distinctive and, as such, was afforded protection as of his date of first use in 1998.

Given these undisputed facts, and for the reasons set forth in Opposer's original brief in support of this motion and in this reply brief, the Board should grant summary judgment to Opposer and deny registration to Applicant's intent-to-use Application Serial No. 75/761,159 to register CAB CALLOWAY under Section 2(d) of the Lanham Act, 15 U.S.C. § 1052(d).

Dated: New York, New York
July 21, 2005

Respectfully submitted,

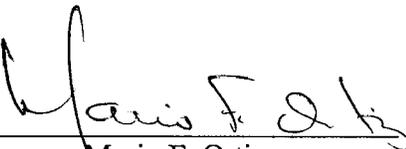
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CERTIFICATE OF SERVICE

I hereby certify that true and correct copy of the REPLY MEMORANDUM IN FURTHER SUPPORT OF OPPOSER'S MOTION FOR SUMMARY JUDGMENT and the REPLY DECLARATION OF EVAN GOURVITZ IN SUPPORT OF OPPOSER'S MOTION FOR SUMMARY JUDGMENT with Exhibits 17 -25, was served via first class mail, to Cynthia Johnson Walden, Esq., Fish & Richardson P.C., 225 Franklin Street, Boston, MA 02110-2804 attorneys for applicant Creative Arts by Calloway, LLC, on this 21st day of July 2005.



Mario F. Ortiz