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

Proceeding	91160266
Party	Plaintiff Christopher Brooks Mr. Christopher Brooks 83 Myrtle Boulevard Larchmont, NY 10538 UNITED STATES
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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 04/18950

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CHRISTOPHER BROOKS, :
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 Opposer, :
 :
 - v. - : Opposition No. 91/160,266
 :
 CREATIVE ARTS BY CALLOWAY, LLC, :
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 Applicant. :
 :
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MOTION FOR RECONSIDERATION OF
OPPOSER'S MOTION FOR SUMMARY JUDGMENT

Opposer, Christopher Brooks (“Opposer”), pursuant to 37 C.F.R. § 2.127(b) and TBMP § 518, hereby moves for reconsideration of his motion for summary judgment, filed in this Opposition on December 30, 2004, on the basis that, given the undisputed facts before the Board and the prevailing authorities, the Board was in clear error in reaching its November 23, 2005 decision denying summary judgment.

Opposer also requests pursuant to 37 C.F.R. §§ 2.117 and 2.127(d) and TBMP § 510 that the Board suspend any further proceedings in this action pending the resolution of this motion.

INTRODUCTION

In its opinion of November 23, 2005 denying Opposer’s motion for summary judgment, the Board devoted a single sentence to the merits of the motion, stating that “[a]t a minimum, there is a genuine issue of material fact as to the relatedness of opposer’s goods and services and those of applicant.” (Opinion at 2.) This finding, and the Board’s decision denying summary judgment which was expressly based on that finding (*id.*), are contrary to both fact and law. Applicant *expressly admitted* in its summary judgment papers that Opposer’s goods and services and the services set forth in its own Application are “identical or closely related.” (App.’s 7/8/05 Response to Opp.’s Statement of Undisputed Material Facts ¶ 30.) Given this clear admission, the Board could not properly find that an issue of material fact remained on this subject, nor could it properly rely on such a finding in denying summary judgment.

Even without Applicant’s admission, there can be no genuine dispute of material fact on whether the parties’ goods and services are related: Applicant’s proposed services are stated in detail (and limited to those) in its intent-to-use application, while Opposer’s goods and services are set forth in detail in his motion, supported by declarations and documentary evidence, and not disputed by Applicant. In such circumstances, the “relatedness” of Applicant’s services and

Opposer's goods and services is not properly a disputed issue of fact, but rather a matter of law for the Board to determine on the basis of the undisputed evidence.

In addition, the Board's refusal to consider the ten substantive pages of Opposer's reply brief because Opposer, solely for the Board's convenience, and not to evade any limitations on the length of his brief, included tables of contents and authorities with its brief (Opinion at 1-2) is not supported by the Code of Federal Regulations or the Trademark Trial and Appeal Board Manual of Procedure. The Board's refusal to consider this brief thus was another error of law.

Given that the Board failed to consider Applicant's own admission of relatedness in its summary judgment papers; given that, regardless of this admission, the Board improperly found a factual dispute regarding the relatedness of the parties' goods and services where none existed; given that the Board improperly failed to consider the important arguments set forth in Opposer's reply brief; and given that, had the Board taken all of the above into consideration, it could not have reached the decision it did in denying summary judgment, the Board should reconsider its November 23, 2005 decision and grant summary judgment in Opposer's favor.

STATEMENT OF FACTS

On December 30, 2004, Opposer Christopher Brooks, the eldest grandson of Cab Calloway, who was authorized by his grandfather to continue his musical legacy (Opp. Mot. for Summ. J., Ex. 14 at 11), moved for summary judgment in this action on the basis that there was no material dispute of fact that Applicant's use of its applied-for mark CAB CALLOWAY for the goods set forth in Application Serial No. 75/761,159 was likely to cause confusion with Opposer's own prior use of the mark THE CAB CALLOWAY ORCHESTRA in connection with his own goods and services. After several extensions of time, Applicant filed its opposition to that motion on July 1, 2005. On July 21, 2005, Opposer filed his reply brief, which consisted

of ten pages of substantive argument, as well as a cover page, a one-page table of contents, and a two-page table of authorities.

On November 23, 2005, the Board issued a two-and-a-half-page decision denying Opposer's motion, finding:

After reviewing the parties' arguments and evidence, we find that opposer has not met his burden of establishing that there are no genuine issues of material fact and that he is entitled to entry of judgment as a matter of law. At a minimum, there is a genuine issue of material fact as to the relatedness of opposer's goods and services and those of the applicant.

(Opinion at 2.) While the Board acknowledged that "we have identified only one genuine issue of material fact as a sufficient basis for denying the motion for summary judgment," it stated that this "should not be construed as a finding that this is necessarily the only issue which remains for trial." (*Id.* at n.2.) Nevertheless, the Board articulated no other dispute of material fact in the action, and no other reason for its decision.

The Board's opinion also stated that it had not considered Opposer's reply brief, although it considered the rebuttal evidence submitted therewith. (*Id.* at 1-2.) The Board advised that because "[O]pposer's reply brief consists of ten pages of argument preceded by three pages consisting of a table of contents and a table of authorities," "if such tables are included, they are considered in the page count of the brief. See Trademark Rule 2.127(a); *Saint-Gobain Corp. v. Minnesota Mining and Manufacturing Co.*, 66 USPQ2d 1220 (TTAB 2003)." (*Id.* at 1.)

ARGUMENT

I. STANDARD FOR RECONSIDERATION

37 C.F.R. § 2.127(b) states that "[a]ny request for reconsideration . . . of an order or decision issued on a motion must be filed within one month from the date thereof." "Generally, the premise underlying a motion for reconsideration . . . under 37 C.F.R. § 2.127(b) is that, based

on the facts before it and the prevailing authorities, the Board erred in reaching the order or decision it issued.” TBMP § 518 (citations omitted). “[T]he motion should be limited to a demonstration that based on the facts before it and the applicable law; the Board’s ruling is in error and requires appropriate change.” *Id.* (citations omitted).

II. THE BOARD MISAPPLIED THE FACTS AND LAW IN DENYING OPPOSER’S SUMMARY JUDGMENT MOTION

“In deciding a motion for summary judgment, the function of the Board is not to try issues of fact, but to determine instead if there are any genuine issues of material fact to be tried.” TBMP § 528.01 (citations omitted). Here, the Board’s decision was in error and requires reversal since, on the record before the Board it was undisputed that the parties’ goods and services were related, and therefore there was no genuine issue of fact in dispute. Since there were no disputed issues of fact, summary judgment should have been entered.

A. There is No Dispute of Material Fact on the Only Issue Cited for Denial of Opposer’s Motion for Summary Judgment

1. Applicant conceded the relatedness of the goods and services at issue in this Opposition

In its opinion, the only basis for the Board’s denial of Opposer’s motion was that “there is a genuine issue of material fact as to the relatedness of opposer’s goods and services and those of the applicant.” (Opinion at 2.) However, Applicant conceded as “[u]ndisputed” in its response to Opposer’s Statement of Undisputed Material Facts that “Opposer’s goods and services” on the one hand, and “the services set forth in [Applicant’s] Application,” on the other hand, “are identical or closely related.” (App.’s 7/8/05 Response to Opp.’s Statement of Undisputed Material Facts at ¶ 30.)¹ Given this express admission against interest by Applicant

¹ See also *id.* at ¶¶ 19 (undisputed that Applicant admitted in prior judicial action that likelihood of confusion existed between Applicant’s use of CAB CALLOWAY “used in connection with entertainment services” and Opposer’s use of THE CAB CALLOWAY ORCHESTRA “used in

in its papers opposing Opposer's summary judgment motion, *see* TBMP § 704.06(b) (“[s]tatements in a brief have no evidentiary value, except to the extent that they may serve as admissions against interest”), the Board's finding that there was an issue of material fact on this issue was in error and requires reconsideration.

2. There can be no dispute of material fact about whether the parties' goods and services are related

Even without Applicant's admission, which is determinative on the issue, there is no actual material dispute of fact on the relatedness of the parties' respective goods and services. Applicant's proposed services are not in dispute, but are detailed (and limited to those set forth) in its intent-to-use application. (App. Serial No. 75/761,159.)² Similarly, Opposer's goods and services are not in dispute, but are detailed in his memorandum (*E.g.*, Opp. Mot. for Summ. J. at 8), supported by declarations and documentary evidence (*e.g.*, *id.*, Exs. 3-4, 7-11, Brooks Decl. ¶¶ 7-8, 11-13), and not contested by Applicant. (*E.g.*, App.'s 7/8/05 Response to Opp.'s Statement of Undisputed Material Facts ¶¶ 3, 7, 10, 11.) Thus, the question of whether the parties' respective goods and services are “related” is *not* a dispute of material fact, but rather is a matter of law for the Board to determine based on this undisputed evidence. *See Toho Co. v. Sears, Roebuck & Co.*, 645 F.2d 788, 790-91 (9th Cir. 1981) (where nature of goods undisputed, relatedness of goods is a matter of law) (citing *J.B. Williams Co. v. Le Conte Cosmetics, Inc.*, 523 F.2d 187, 190-93 (9th Cir. 1975)).

connection with goods and entertainment services”); 31 (undisputed that Applicant stated in prior action that Opposer was using THE CAB CALLOWAY ORCHESTRA “in connection with goods and services which are the same or related to the services of [Applicant]”).

² *See Octocom Sys. Inc. v. Houston Computer Servs. Inc.*, 16 U.S.P.Q.2d 1783, 1787 (Fed. Cir. 1990) (“The authority is legion that the question of registrability of an applicant's mark must be decided on the basis of the identification of goods set forth in the application regardless of what

B. There is No Other Basis for Denying Opposer's Motion

In its opinion, the Board stated that while it had “identified only one genuine issue of material fact as a sufficient basis for denying the motion for summary judgment, this should not be construed as a finding that this is necessarily the only issue which remains for trial.” (Opinion at 2 n.2.) Nevertheless, the Board articulated no other issue of material fact in its opinion. *See Packard Press, Inc. v. Hewlett-Packard Co.*, 227 F.3d 1352, 1358 (Fed. Cir. 2000) (“[i]n order for correct appellate review to occur . . . the Board must take care to express clearly both the facts as it finds them and the law that it applies to those facts”); *see also Champagne Louis Roederer, S.A. v. Delicato Vineyards*, 148 F.3d 1373, 1376-79 (Fed. Cir. 1998) (concurring opinion) (Board should explain with reasonable precision not only factual findings but theory underlying its conclusion). *Cf. Gechter v. Davidson*, 116 F.3d 1454, 1457 (Fed. Cir.1997) (“[n]ecessary findings must be expressed with sufficient particularity to enable [the Federal Circuit], without resort to speculation, to understand the reasoning of the [Patent] Board, and to determine whether it applied the law correctly and whether the evidence supported the underlying and ultimate fact findings “like a district court opinion, a Board opinion must contain sufficient findings and reasoning to permit meaningful appellate scrutiny”). Accordingly, since (as noted in section (A) above) the only issue of material fact identified by the Board is not actually in dispute, there is no factual or legal basis for the Board’s decision to deny Opposer’s motion for summary judgment.

the record may reveal as to the particular nature of an applicant’s goods, the particular channels of trade or the class of purchasers to which sales of the goods are directed”).

III. THE BOARD MISAPPLIED THE LAW IN FAILING TO CONSIDER OPPOSER'S REPLY BRIEF BECAUSE OF ITS LENGTH

The Board's decision also stated that because "[O]pposer's reply brief consists of ten pages of argument preceded by three pages consisting of a table of contents and a table of authorities," "if such tables are included, they are considered in the page count of the brief. See Trademark Rule 2.127(a); *Saint-Gobain Corp. v. Minnesota Mining and Manufacturing Co.*, 66 U.S.P.Q.2d 1220 (TTAB 2003)." (Opinion at 1.) Accordingly, the Board did not consider Opposer's July 21, 2005 reply brief. (*Id.* at 1-2.) This was an error of law.

Despite the Board's citation to the rule, Trademark Rule 2.127(a) does not address tables of contents or tables of authorities at all – rather, it states in relevant part only that "a reply brief shall not exceed 10 pages in length" and that "Exhibits submitted in support of or in opposition to the motion shall not be deemed to be part of the brief for purposes of determining the length of the brief." 37 C.F.R. § 2.127(a). By contrast, Trademark Rule 2.128(b), which governs *final hearing* briefs, refers to the brief "in its entirety," and expressly states that tables of contexts, indexes of cases, and the like are included in the fifty-five-page limit for main briefs, and the twenty-five-page limit for reply briefs. 37 C.F.R. § 2.128(b). In other words, when tables of contents and tables of authorities are to be considered in the length of a brief, the relevant rules and regulations explicitly say so.³

While the *Saint-Gobain* decision counted tables of contents and authorities in determining the length of briefs supporting and opposing a summary judgment motion, the

³ Moreover, the T.T.A.B. follows the Federal Rules of Civil Procedure "wherever applicable and appropriate," except as otherwise provided in the Trademark Rules of Practice, TBMP § 101.02; see 37 C.F.R. § 2.116(a), and the Federal Rules do not have any rule governing whether tables of contents or tables of authorities are included in the length of a brief. In practice, federal courts almost invariably require tables of contents and tables of authorities, and do not count them in the overall length of a brief.

opinion did not cite to any statute, regulation, or rule that supported this holding. Rather, it merely inferred this limitation from 37 C.F.R. §§ 2.127(a) and 2.128(b), neither of which addresses how tables of contents and authorities for briefs on summary judgment motions should be considered. *Saint-Gobain*, 66 U.S.P.Q.2d at 1221-22; *see* 37 C.F.R. §§ 2.127(a), 2.128(b). The provision of the Trademark Trial and Appeal Board Manual of Procedure governing the length of summary judgment briefs, TBMP § 502.02(b), is similarly devoid of any discussion of this issue.

In fact, Chief Administrative Trademark Judge J. David Sams only announced on December 5, 2005 – after the Board rendered its decision in this action – that the Board intends to propose to amend T.T.A.B. rules to “make clear” that a table of contents, index of cases, description of the record, statement of the issues, recitation of facts, argument and summary count against the twenty-five-page limit for a brief in support of or in response to a motion and the ten-page limit for a reply brief. (Gourvitz Decl., Ex. A at 5.) This proposal for a new rule attests to the absence of any such established rule at the present time, and makes the application of isolated, unsupported decisional law such as *Saint-Gobain* – especially retroactively, before a rule to this effect is introduced – completely untenable.

The Board’s failure to consider Opposer’s July 21, 2005 reply brief in its entirety materially affected the Board’s decision on Opposer’s summary judgment motion. Specifically, in its decision the Board stated that “Applicant is entitled to prove an earlier use of the CAB CALLOWAY mark in connection with the recited services in International Classes 35 and 41 than its intent-to-use application filing date.” (Opinion at 2 n.2.) To the extent this was a basis for denying summary judgment in Opposer’s favor, then had the Board considered Opposer’s reply brief it would have determined, as a matter of law, that none of the alleged prior uses of

CAB CALLOWAY cited by Applicant in these classes in its opposition to Opposer's summary judgment motion were service mark uses accruing to the benefit of Applicant or its predecessors, or otherwise establishing use of the CAB CALLOWAY mark. (Opp. Reply Br. at 7-10.) See *Hydro-Dynamics, Inc. v. George Putnam & Co.*, 811 F.2d 1470, 1472-73 (Fed. Cir. 1987) (proof of earlier use than filing date of intent-to-use application must be clear and convincing, and not characterized by contradiction, inconsistencies, and indefiniteness);⁴ TBMP § 528.01 (nonmoving party "may not rest on mere denials or conclusory assertions, but rather must proffer countering evidence . . . showing that there is a genuine factual dispute for trial").

Even if the Board were correct that Opposer's addition of tables of contents and authorities violated a current, valid rule, the remedy – striking the entire brief because three non-substantive pages preceded the text of the brief – was inappropriate. Rather, the Board should have stricken the table of contents and table of authorities, or, at worst, stricken the last three pages of the brief. See, e.g., *Columbus-Am. Discovery Group v. Atlantic Mut. Ins. Co.*, 56 F.3d 556, 574 n.23 (4th Cir. 1995); *Davis v. King County*, No. C02-2440 (RSM), 2005 WL 3278006, at *4 (W.D. Wash. Dec. 2, 2005). Since the table of contents and authorities contained no additional argument, the refusal to consider the substance of Opposer's reply brief was unfairly punitive, illogical, and had the consequence of prejudicing the Board in its decision-making and thwarting the interests of justice. Accordingly, and for the reasons set forth above, the Board should consider Opposer's reply brief in its entirety, or at worst strike three pages of the brief.

⁴ Even without considering Opposer's reply brief, given Applicant's undisputed, repeated changes of the basis of its Application from intent-to-use to use and back, depending on the needs of the moment (see App.'s 7/8/05 Response to Opp.'s Statement of Undisputed Material Facts at ¶¶ 13-16, 25-26), this standard is, in any event, impossible for Applicant to meet.

CONCLUSION

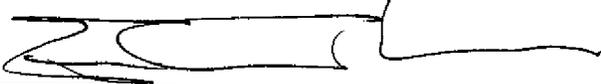
For the reasons set forth above, the Board should reconsider its November 23, 2005 decision and (i) reconsider the previously-overlooked admission by Applicant that the parties' respective goods and services are related; (ii) reconsider the question of the relatedness of the parties' respective goods and services on the basis of the other facts of record; (iii) consider the arguments set forth in Opposer's July 21, 2005 reply brief, and (iv) regardless of whether it considers the arguments in that brief, 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
December 22, 2005

Respectfully submitted,

FROSS ZELNICK LEHRMAN & ZISSU, P.C.

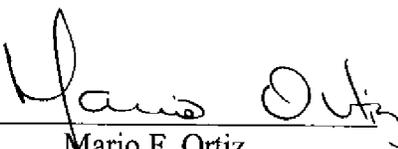
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CERTIFICATE OF SERVICE

I hereby certify that true and correct copy of the MOTION FOR RECONSIDERATION OF OPPOSER MOTION FOR SUMMARY JUDGMENT and the DECLARATION OF EVAN GOURVITZ IN SUPPORT OF OPPOSER'S MOTION FOR RECONSIDERATION OF ITS MOTION FOR SUMMARY JUDGMENT with Exhibit A, 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 22nd day of December 2005.



Mario F. Ortiz