

ESTTA Tracking number: **ESTTA63547**

Filing date: **01/25/2006**

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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Attachments	91160266 Reply Memorandum.pdf (7 pages)

Opposer, Christopher Brooks (“Opposer”), pursuant to 37 C.F.R. § 2.127(b) and TBMP § 518, submits this memorandum in further support of his motion for reconsideration of the Board’s denial of summary judgment.

ARGUMENT

In its Memorandum in Opposition to Opposer’s Motion for Reconsideration, Applicant does not dispute, and therefore concedes, the admission in its summary judgment papers that the parties’ respective goods and services in this action are related. (*See* App. Mem.; App. 7/8/05 Response to Opp. Statement of Undisputed Material Facts ¶ 30.) Since this eliminates the only issue of material fact cited by the Board as a basis for denying Opposer’s summary judgment motion (Opinion at 2), Applicant instead spends much of its memorandum trying to reargue the merits of that motion. (App. Mem. 2-5.) This effort is improper, but in any event is unavailing.

I. THE BOARD DID NOT DETERMINE THAT PRIORITY WAS AN ISSUE OF MATERIAL FACT PRECLUDING SUMMARY JUDGMENT

Despite its failure to dispute or contradict any of Opposer’s evidence on the issue of priority in Opposer’s motion for summary judgment, Applicant now contends that priority is an issue of material fact that must be determined at trial. (*Id.* at 2-5). Applicant disingenuously claims that the Board recognized in its opinion that priority remained a disputed issue of material fact. This is simply false. The Board expressly said in its opinion that it had “identified *only one* genuine issue of material fact as a sufficient basis for denying the motion for summary judgment.” (*Id.* at 2 n.2) (emphasis added). That one issue was “the relatedness of opposer’s goods and services and those of applicant” (*id.* at 2) – an issue that is not actually in dispute, but was conceded by Applicant in its own summary judgment papers. (App. 7/8/05 Response to Opp. Statement of Undisputed Material Facts ¶ 30.)

In any event, despite Applicant's present attempt to offer what amounts to an improper surreply to Opposer's summary judgment motion, there can be no dispute of material fact that Opposer has priority for goods and services that strongly overlap with those in the Application. Applicant *admitted* in its summary judgment papers that Opposer sold CDs and videotapes bearing his mark prior to the date of Applicant's intent-to-use application. (*Id.* at ¶¶ 9-11.) While Applicant again tries to dispute Opposer's first use date for his entertainment services (App. Mem. 2-4) – but, tellingly, *not* with his first use date for his CDs and videotapes – it has not offered any evidence contradicting *any* of the first use dates for *any* of Opposer's goods or services set forth in his declaration and exhibits in support of his summary judgment motion. (*See* Brooks S.J. Decl. ¶¶ 7, 12-13; Exs. 3, 8-11.) Applicant's reliance on mere denials and conclusory assertions to the contrary is insufficient to defeat summary judgment. TBMP § 528.01; *see also* TBMP §§ 528.05(b) (clear, convincing, uncontradicted statements in declaration made on personal knowledge admissible); 528.05(e) (materials admissible if competent, relevant, and proper authenticated by declaration).

While, in an attempt to thwart summary judgment, Applicant claimed use of CAB CALLOWAY prior to the date of its intent-to-use application in its opposition to Opposer's motion for summary judgment (App. S.J. Mem. at 13-19), and while it again raises these alleged uses in its present memorandum (App. Mem. 4-5), there also can be no dispute of material fact that these uses either (i) were not by or licensed by Applicant or its predecessor, do not constitute trademark use, and do not inure to Applicant's benefit (*e.g.*, school plays, concerts, and musicals at the Cab Calloway School of the Arts and sound recordings), or, (ii) at best, deal with goods and services (*e.g.*, education services and t-shirts) that are irrelevant to the goods and services at issue in this action. (*See* App. S.J. Mem. at 13-19.) Indeed, Applicant admitted in 2001 – years

after Opposer commenced his own use of his mark – that Applicant and its predecessor had no written agreement with the Cab Calloway School, and that the school had simply chosen its name to honor Mr. Calloway; that it and its predecessor had not granted record companies the right to use Cab Calloway’s name for sound recordings; and that, in fact, no one other than a small t-shirt manufacturer *ever* had been granted a license or permission to use Cab Calloway’s name. (Opp. S.J. Ex. 20 at 32-33, 38, 86-88.)¹

Accordingly, the issue of priority cannot serve to defeat Opposer’s motion for summary judgment or the motion for reconsideration.

II. THE BOARD MISTAKENLY ASSERTED THAT THERE WAS AN ISSUE OF MATERIAL FACT AS TO THE RELATEDNESS OF THE PARTIES’ GOODS

Applicant concedes, as it must, that the Board stated in its opinion “[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.” (App. Mem. at 5; Opinion at 2.) As noted above, this statement by the Board was erroneous in light of Applicant’s admission in its summary judgment papers that the parties’ goods and services in this action are related. (App. 7/8/05 Response to Opp.’s Statement of Undisputed Material Facts ¶ 30.) Since, given this admission, Applicant cannot argue that a genuine issue of material fact remains on the question of relatedness, it tries to “explain” the Board’s error by claiming that when the statement is considered in conjunction with a footnote addressing the prior litigation between the parties (Opinion at 2 n.2), the Board meant only that there was a genuine issue of material fact as to whether the parties’ goods and services in their prior litigation are the same as their goods and services in this action, and hence as to whether the prior litigation should have a preclusive effect. (App. Mem. at 5-6.)

¹ The Board noted in its opinion denying summary judgment that, while it would not consider Opposer’s reply brief, it did consider Opposer’s evidence, such as Ex. 20. (Opinion at 1-2.)

Applicant's argument is not supported by the plain language of the Board's opinion, and defies both logic and common sense. It seems self-evident that the first footnote in the opinion was not intended to explain or amplify any statement in the body of the decision, but rather was intended to make the separate and unrelated point that, since it believed it was unclear whether the services in Applicant's application were at issue in the prior action, the Board would not give the prior action preclusive effect on summary judgment here.

Applicant also suggests that summary judgment is inappropriate because the Board said in its opinion 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.) However, as noted in Opposer's initial memorandum in support of this reconsideration motion (Opp. Mem. at 6), since the only issue of material fact actually *identified* by the Board is not actually in dispute, but in fact was conceded by Applicant, there is no factual or legal basis in the Board's opinion supporting its decision to deny Opposer's motion for summary judgment.

CONCLUSION

For the reasons set forth above and in Opposer's prior memorandum and its supporting materials, the Board should reconsider its November 23, 2005 decision and (i) reconsider the overlooked admission by Applicant that the parties' respective goods and services in this action 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
January 25, 2006

Respectfully submitted,

FROSS ZELNICK LEHRMAN & ZISSU, P.C.

By:

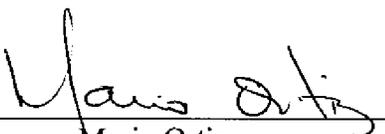


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CERTIFICATE OF SERVICE

I hereby certify that true and correct copy of the REPLY MEMORANDUM IN SUPPORT OF MOTION FOR RECONSIDERATION OF OPPOSER'S MOTION FOR SUMMARY JUDGMENT, 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 25TH day of January 2006.


Mario Ortiz