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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 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

CHRISTOPHER BROOKS, Opposer, - v. - CREATIVE ARTS BY CALLOWAY, LLC, Applicant.	Opposition No. 91/160,266

MOTION FOR RECONSIDERATION OF THE BOARD'S
DECEMBER 21, 2006 ORDER DENYING SUMMARY JUDGMENT

Opposer, Christopher Brooks ("Opposer"), pursuant to 37 C.F.R. § 2.127(b) and TBMP § 518, hereby timely moves for reconsideration of the Board's December 21, 2006 order denying Opposer's December 30, 2004 motion for summary judgment on the basis that the Board's order is clearly erroneous and ignored undisputed facts and irrefutable law.

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.

PRELIMINARY STATEMENT

This action involves an unfortunate dispute among certain family members of jazz great Cab Calloway over the right to use marks consisting of or including CAB CALLOWAY for certain goods and services. Because (as both a federal district court and appellate court have found) Cab Calloway had no rights in this mark to pass to any of his heirs or descendants, the rights of the litigants in this opposition depends entirely on their own uses of the marks at issue.

While Opposer, Cab Calloway's oldest grandson, recognizes that the Board already has considered his motion for summary judgment and motion for reconsideration of the Board's original basis for denying summary judgment, reconsideration of the Board's latest decision nevertheless is merited here. The sole basis for the Board's new decision – that "there is a genuine issue of material fact regarding priority" because Applicant may have licensed rights to use the CAB CALLOWAY mark to a school for certain entertainment services – finds **no** factual support. Indeed, not only is there no evidence that supports this determination before the Board on Opposer's summary judgment motion, Applicant's own admissions *prove* that no such license existed, and accordingly there can be no genuine disputed factual issue on this point. Moreover, the issue now raised by the Board was conclusively resolved by the courts in the prior litigation between the parties. Under these circumstances, reconsideration is necessary and proper.

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 REACHING ITS DECEMBER 21, 2006 DECISION IN THIS ACTION

In its December 21, 2006 opinion, the Board held that, based on the facts and law before it, "opposer's request for reconsideration is granted to the extent that we find there is no genuine issue of material fact that opposer's pleaded goods and services and applicant's involved services are 'identical or closely related.'" (12/21/06 Opinion at 3.) However, it also found that

> this proceeding is not amenable to summary disposition because genuine issues of material fact remain with respect to the issue of priority. Applicant has alleged and has submitted evidence purporting to show prior use of the involved mark through The Cab Calloway School of the Arts, asserted by applicant to be its licensee, in connection with musical, concert and theatrical productions. This is sufficient to raise a genuine issue of material fact concerning priority.

(*Id.*)

This new finding – that there is a genuine issue about whether Applicant has priority through the licensing of its mark for certain entertainment services ("musical, concert and theatrical productions") – is the sole issue on this motion for reconsideration. And this finding, which itself is the sole basis for the denial of summary judgment, is contrary to both fact and law.

A. Applicant Introduced No Evidence That It or Its Predecessors Licensed the CAB CALLOWAY Mark to the School

Throughout the almost five-year prosecution of its application, the litigation of its previous civil lawsuit against Opposer, and the litigation of this opposition, Applicant repeatedly shifted position on its past use of the CAB CALLOWAY mark – initially applying on an intent-to-use basis (thereby vitiating any claim of prior rights), amending to allege use after deciding to bring a trademark infringement action against Opposer in civil court, and again changing back to intent-to-use (and thus no priority) after two federal courts found that it had not made any use of the mark, and after the claims of use in its application were proven to be false. (*See* App. 7/8/05 Resp. to Opp. Statement of Undisputed Material Facts ¶¶ 13-17, 20-22, 25-26.) Only *after* its ITU application had been published, and only *after* Opposer filed his motion for summary judgment (Opp. 12/30/04 Mem. in Support of Mot. for S.J.), did Applicant once again attempt to claim prior use, this time through a "licensee," The Cab Calloway School of the Arts (the "School"), which it not only failed to mention as a licensee at any stage in the prosecution of its application, but actually conceded was *not* a licensee in the prior litigation between the parties.

In support of its present position, Applicant asserted in its opposition to Opposer's motion for summary judgment that "the [S]chool, as a *licensee* of Applicant (including its predecessor in interest), has continuously operated under the name Cab Calloway School of the Arts," and that "[t]he school holds a *license* to, and does in fact, provide a variety of services under the CAB CALLOWAY service mark including . . . producing and presenting live music concerts, live theatrical plays, and live musicals . . ." (App. 7/1/05 Mem. in Opp. to Mot. for S.J. at 14) (emphasis added). It also asserted in its Response to Opposer's statement of undisputed facts that "Applicant's *licensee* The Cab Calloway School of the Arts, which adopted the name The Cab Calloway School of the Arts in 1993, has used the CAB CALLOWAY designation

under license in connection with a variety of products and services including . . . the production and presentation of concerts and theatrical performances . . ." (App. 7/8/05 Resp. to Opp. Statement of Undisputed Material Facts ¶ 27) (emphasis added).

However, these assertions are not supported by any evidence provided to the Board. Indeed, there is no cite to *any* affidavit, declaration, or other evidence to support Applicant's claim of a license for *any* entertainment services. As noted by the Board in its December 21, 2006 order, "in considering the propriety of summary judgment, all *evidence* must be viewed in a light favorable to the non-movant." (12/21/06 Order at 3-4) (emphasis added). Yet the Board apparently overlooked the fact that Applicant offered nothing more than mere *assertions*, which do not constitute evidence and are unsupported by evidence, and that consideration of such assertions on summary judgment is not proper. *E.g.*, Fed. R. Civ. P. 56(e); TBMP § 528.01 ("[t]he burden of the moving party may be met by showing . . . 'that there is an *absence of evidence* to support the nonmoving party's case' . . . the nonmoving party *may not rest on mere denials or conclusory assertions*, but rather must proffer *countering evidence*, *by affidavit or as otherwise provided* in Fed. R. Civ. P. 56, showing that there is a genuine factual dispute for trial") (emphasis added).

Not only has Applicant failed to proffer evidence to create a genuine issue of fact, it actually has admitted that there is no evidence to support its spurious claim of licensing entertainment services. In the Declaration of Cabella Calloway Langsam – the basis, along with certain exhibits discussed below, for all of Applicant's statements concerning a "license" – Ms. Langsam, the daughter of Cab Calloway's widow, did not actually state that Applicant had licensed the right to use CAB CALLOWAY to the School. Rather, she stated that

> In recognition of Cab Calloway's involvement with the school and to honor his status as an international jazz icon, the Red Clay School District sought Cab

> Calloway's permission to name the school 'Cab Calloway School of the Arts.' Cab Calloway authorized the school to use his name as the name of the school.

(Langsam 6/24/05 Decl. in Opp. to S.J. Motion ("Langsam Decl") ¶ 9). This was an honorarium, just like Louis Armstrong International Airport in New Orleans, John F. Kennedy International Airport in New York, or the J. Edgar Hoover FBI Building in Washington D.C. – not a license.

Indeed, there is no evidence of a written license, an oral license, the terms of any license, any quality control, or any other indicia of a valid license in the record. *See, e.g.*, Jerome Gilson, 2 *Trademark Protection & Practice* § 6.03[1] (2006) ("[a] trademark license should define in writing all of the rights and obligations of the parties. Among the topics ordinarily covered are the identification of the parties to the agreement, enumeration of the trademarks and the associated products or services, requirements as to correct trademark usage and explanatory legends, trademark policing, royalties, quality control requirements, term, assignability, and termination rights"). Applicant has not provided *any* documentary evidence of any license, or any other authorization, permitting the School to use CAB CALLOWAY as a mark. Rather, it offers only copies of articles showing Cab Calloway's appearance at the dedication ceremony for the school, a proclamation noting the Calloway family as a "Founder" of the School, a printout from the school's website noting that the School was named "in [Cab Calloway's] honor," various articles about the School and its students, an order form for clothing bearing the School's name, and examples of such clothing and school signage. (Langsam Decl., Exs. 4-7.) None of this creates a license, or even creates a material dispute of fact over whether a license existed.

B. Opposer Introduced Admissions That Opposer and Its Predecessors Did Not License the CAB CALLOWAY Mark to the School

Why did Applicant not introduce evidence of a license to the School to use the CAB CALLOWAY mark? Because no such evidence exists, or could exist.

As the Board noted in its original decision on Opposer's summary judgment motion, while it did not consider Opposer's reply brief, it *did* consider the exhibits to that brief. (11/23/05 Order at 2) ("that brief has received no consideration, but we have considered the rebuttal evidence submitted therewith"). One of those exhibits – the transcript of the deposition of Applicant's 30(b)(6) witness Cabella Calloway Langsam in the earlier civil action between the parties – includes Applicant's admission that it and its predecessors never granted *any* license to the School to use the CAB CALLOWAY mark in connection with *any* goods or services:

> Q: Are you aware of something called the Cab Calloway School of the Arts?
>
> A: I definitely am.
>
> . . . .
>
> Q: When was the school established under that name?
>
> A: Under that name? 1994 – '93, I'm sorry.
>
> Q: While your father [Cab Calloway] was alive?
>
> A: My father was alive, correct.
>
> Q: Did he grant any type of license to the school district or whomever to use the name Calloway?
>
> A: The school district came to him and asked him if it would be all right if they named the school. *Actually it was done by vote, by the student body. The student body was given various different names to choose from, and the students chose Cab Calloway to have as the name of the school.*

(Opp. 7/21/05 Gourvitz Reply Decl. ("Gourvitz Decl"), Ex. 20 (Langsam Depo.) at 32-33.) In other words, rather than involving any sort of license, grant, consent, or formal authorization from Cab Calloway (Applicant's purported predecessor), the school was named The Cab Calloway School by its students. Mr. Calloway simply accepted the honor bestowed upon him, and nothing more.

In fact, Ms. Langsam's own testimony makes the lack of a license crystal clear:

Q: Was there any type of written agreement [with the school]?

A: No. . . .

(*Id.* at 33.) A few minutes after discussing the School, she was expressly asked:

Q: Other than Gear, Inc. [a t-shirt manufacturer],[1] are you aware of *anyone else who has a license or permission* to use Cab Calloway's name or likeness on merchandise?

A: Not on merchandise, no.

Q: On anything else?

A: Not that I can think of.

(*Id.* at 38) (emphasis added). This express statement by Applicant under oath in 2001 – that there was no license granted for the use of the CAB CALLOWAY mark for anything except t-shirts (combined with its prior express written declarations that its application was based on an intent to use, rather than use) – closes the door on any possible genuine issue of material fact precluding summary judgment.

C. Two Courts Previously Found That Opposer and its Predecessors Never Made Use of the CAB CALLOWAY Mark, Which Must Be Conclusive on the Issue Here

As discussed in Opposer's summary judgment motion (Opp. 12/30/04 S.J. Mem. at 9-10), both the U.S. District Court for the Southern District of New York and the U.S. Court of Appeals for the Second Circuit found that neither Applicant nor its predecessors had made *any* use of CAB CALLOWAY as a mark as of 2001, three years after Opposer acquired rights in his own

[1] The possibility of a license by one of Applicant's predecessors to Gear Ink to use Cab Calloway's name and likeness on t-shirts (*e.g.*, Langsam Decl. ¶ 18, Ex. 12) has no bearing on this action, since those goods are unrelated to any of the goods and services at issue in Applicant's application or this opposition.

mark THE CAB CALLOWAY ORCHESTRA. In fact, Applicant conceded in its response to Opposer's statement of undisputed facts that the basis of the district court's decision was that Applicant "had no *service* mark rights in CAB CALLOWAY in connection with *entertainment services*." (App.'s 7/8/05 Resp. to Opp. Statement of Undisputed Material Facts ¶ 21.) This admission must preclude a finding of any genuine issue of material fact on the issue of priority.

As held by the district court, the issue in the prior litigation was "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], Mr. Calloway's grandson, a musician in his own right." *Creative Arts by Calloway, LLC v. Brooks*, No. 01 Civ. 3192 (CLB) (S.D.N.Y. Dec. 11, 2001) mem. op. at 6 (previously submitted as Gourvitz Decl., Ex. 14). The Court found that there was "no evidence that [Cab Calloway] had or exercised any common law service mark in his name," "no evidence of such rights in the extensive submissions in this case,"[2] and that Applicant's immediate predecessor "made no use of the alleged service mark since Cab Calloway's death in 1994, except to apply for a trademark registration in 1999." *Id.* at 7-9. The court 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 [in 2001]." (*Id.* at 10) (emphasis added). The appeals court affirmed, noting that "Cab Calloway was not operating a going concern at the time of his death, precluding the transfer of a mark" and that "[t]he Court has considered [Applicant's] remaining arguments on this issue and finds them to be without merit." *Creative Arts by Calloway, LLC v. Brooks*, No. No. 02-7050, 2002 WL 31303241, at *2 (2d Cir.

[2] As noted above (at 6-7), the School and its use of the name CAB CALLOWAY was discussed in Applicant's deposition in this action.

Oct. 11, 2002) (previously submitted as Gourvitz Decl., Ex. 15). Given Applicant's admissions and these findings in the prior action between the parties, the Board cannot now find that there is a material dispute of fact about whether Applicant has priority over Opposer based on a nonexistent license for entertainment services. (12/21/06 Opinion at 3.) *E.g.*, *Mother's Restaurant Inc. v. Mama's Pizza, Inc.*, 221 U.S.P.Q. 394, 397-99 (Fed. Cir. 1983) (issues "actually and necessarily determined by a court of competent jurisdiction are conclusive in a subsequent suit involving the parties to the prior litigation").

The Board apparently overlooked or did not consider (1) Applicant's failure to introduce evidence of a license to the School for use of the CAB CALLOWAY mark in connection with entertainment services; (2) Applicant's express admissions that there never has been a license granted to the School or anyone else to use the CAB CALLOWAY mark in connection with any of the goods or services at issue in this opposition, (3) Applicant's express admission that the federal courts had found that as of 2001 (when it is undisputed Opposer already had begun use of his mark THE CAB CALLOWAY ORCHESTRA as a service mark) Applicant had no service mark rights in CAB CALLOWAY in connection with entertainment services, and (4) the conclusive effect of the courts' findings in the prior litigation between the identical parties that as of 2001 Applicant and its predecessors had no rights in the CAB CALLOWAY mark in connection with entertainment services. Had the Board taken these matters into consideration, it could not have reached the decision it did. Accordingly, the Board should reconsider its December 21, 2006 decision based on the actual and undisputed evidence. Since that evidence conclusively shows Opposer's prior rights in the mark THE CAB CALLOWAY ORCHESTRA, and given that all of the other likelihood of confusion factors considered favor Opposer, the Board must grant summary judgment in Opposer's favor.

CONCLUSION

Opposer has no objection to the activities of the School, and indeed even has performed jointly with students of the School. However, the School's own activities provide no basis for Applicant to claim prior rights in the CAB CALLOWAY mark over Opposer, Cab Calloway's eldest grandson, who has been using his mark THE CAB CALLOWAY ORCHESTRA for his own widely-acclaimed entertainment services since 1998.

For the reasons set forth above, the Board should reconsider its December 21, 2006 decision and (i) reconsider the previously-overlooked evidence that Applicant did not license the CAB CALLOWAY mark to the School; (ii) reconsider the question of priority on this basis, and on the basis of the federal courts' determinations on this issue; and (iii) 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 19, 2007

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 MOTION FOR RECONSIDERATION OF THE BOARD'SDECEMBER 21, 2006 ORDER DENYING 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 19th day of January 2007.

Mario F. Ortiz