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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
Correspondence Address	MARC A. KARLIN KARLIN & KARLIN, APLC 3701 Wilshire Blvd., Suite 1035 LOS ANGELES, CA 90010 UNITED STATES karlinlaw@msn.com
Submission	Defendant's Notice of Reliance
Filer's Name	Marc A. Karlin
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Date	10/06/2008
Attachments	Applicant's Notice of Reliance.pdf (21 pages)(515670 bytes)

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

----------x

CHRISTOPHER BROOKS,	:	
Opposer,	:	
v.	:	**Opposition No. 911602266**
CREATIVE ARTS BY CALLOWAY, LLC	:	
Applicant.	:	

----------x

APPLICANT'S NOTICE OF RELIANCE

Applicant Creative Arts by Calloway, LLC ("Applicant") hereby makes record and notifies Opposer of its reliance on the following:

1. Pursuant to Rule 2.122(a)-(f) of the Trademark Rules of Practice, and TBMP §705, the following stipulated evidence:

    a. Stipulation as to Facts and Agreement to Submit Opposer's Testimony by Affidavit, attached as Exhibit A.

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2. Pursuant to Rule 2.122(c) of the Trademark Rules of Practice, 37 C.F.R. §2.122(c), TBMP §704.05-06, §704.07, §704.12, and Fed. R. Evid. 401 and 801(d)(2), the following admissions against interest of Opposer:

a. Opposer's Brief filed with the United States Court of Appeal for the Second Circuit in *Creative Arts by Calloway, LLC v. Christopher W. Brooks*, No. 02-7050, attached here as Exhibit B, at 18-19, stating that "If a name, regardless of how famous it is, refers primarily to the individual it is not and cannot be protected as a mark. The only personal names that are protected as valid marks are those that have acquired 'secondary meaning' so that they are synonymous in the minds of the public with a specific ongoing business, or with the sole source of origin for all goods and services offered under the name."

This is relevant because it serves as an admission against interest that Opposer admits in a prior court proceeding with Applicant that the name of an artist is presumptively a personal name, and that to be protected as a trademark, personal names must have secondary meaning.

b. Opposer's Memorandum of Law in Support of Defendant's Motion for Summary Judgement and in Opposition to Plaintiff's Motion for Preliminary Injunction filed the United States District Court for the Southern District of New York in *Creative Arts by Calloway, LLC v. Christopher W. Brooks*, No. 01 CIV. 3192 (BDP), attached hereto as Exhibit C, at 11, stating that "It is black-letter law that personal names are merely descriptive and are protected only if, through usage, they have acquired distinctiveness and secondary meaning."

This is relevant because it serves as an admission against interest that Opposer admits in a prior court proceeding with Applicant that the name of an artist is presumptively a personal name, and that to be protected as a trademark, personal names must have secondary meaning.

c. Opposer's Memorandum of Law in Further Support of His Motion for Summary Judgment filed the United States District Court for the Southern District of New York in *Creative Arts by Calloway, LLC v. Christopher W. Brooks*, No. 01 CIV. 3192 (BDP), attached hereto as Exhibit D, at 5, stating that "In order for plaintiff to have a legally protectable right in 'Cab Calloway,' plaintiff must first establish that the name has acquired secondary meaning."

This is relevant because it serves as an admission against interest that Opposer admits in a prior court proceeding with Applicant that the name of an artist is presumptively a personal name, and that to be protected as a trademark, personal names must have secondary meaning.

Respectfully submitted,

Los Angeles, CA
October 6, 2008

KARLIN & KARLIN, APLC

By, _____

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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. 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

STIPULATION AS TO FACTS AND AGREEMENT
TO SUBMIT OPPOSER'S TESTIMONY BY AFFIDAVIT

Opposer Christopher Brooks ("Opposer") and Applicant Creative Arts by Calloway, LLC ("Creative Arts"), pursuant to 37 C.F.R. § 2.123 and TBMP §§ 501 and 705, hereby stipulate and agree that the sole issue before the Board in this opposition is whether Opposer can establish rights in THE CAB CALLOWAY ORCHESTRA prior to the filing date of the opposed application, which is July 23, 1999. For purposes of the opposition only, the parties further stipulate to the facts set forth in Exhibit A.

In addition, pursuant to 37 C.F.R. § 2.123 and TBMP §§ 501 and 705, the parties hereby stipulate that Opposer's testimony on the issue of priority may be submitted by affidavit, and the parties stipulate to the admission into evidence without objection of the affidavit attached hereto as Exhibit B, and the exhibits thereto, as part of Opposer's testimony in these proceedings.

Certificate of Mailing
I hereby certify that this correspondence is being deposited with the United States Postal Service via Express Mail No. EV 368951166 US addressed to the United States Patent and Trademark Office, Trademark Trial and Appeal Board, P.O. Box 1451, Alexandria, VA 22313-1451 on:

July 1, 2008 (Date of Deposit)	Mario Ortiz (Signature)
Mario Ortiz (Printed name of person mailing paper or fee)	July 1, 2008 (Date of Signature)

{F0306192.1 }

Dated: New York, New York
~~June 2008~~
July 1, 2008

Respectfully submitted,

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[P0300192.1] 1

EXHIBIT A

STIPULATION AS TO FACTS OF THE CASE

1. Opposer Christopher Brooks ("Opposer") is the eldest grandson of the internationally famous jazz musician Cab Calloway, who died in 1994.

2. Opposer performs and has performed with his musical ensemble THE CAB CALLOWAY ORCHESTRA (the "Orchestra") in the United States.

3. Opposer is the sole proprietor, musical director, and lead performer of the Orchestra.

4. Opposer uses THE CAB CALLOWAY ORCHESTRA in connection with the Orchestra's live musical performances in the United States and has used it continuously from the date of adoption.

5. Opposer uses THE CAB CALLOWAY ORCHESTRA in connection with the sale of compact discs and videotapes in the United States and has used it continuously from the date of adoption.

6. Applicant Creative Arts by Calloway, LLC ("Creative Arts") is a Delaware limited liability company founded by its predecessor, Cab Calloway's widow, Zulme Calloway, and Cab Calloway's daughters Chris Calloway and Cabella Calloway Langsam.

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

8. 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.

9. The earliest priority date upon which Applicant can and does rely for the services set forth in the Application, and for purposes of this opposition, is the date it filed the Application, July 23, 1999.

10. On April 16, 2001, Applicant filed suit against Opposer in the U.S. District Court for the Southern District of New York, seeking to enjoin Opposer's use of THE CAB CALLOWAY ORCHESTRA. Applicant's suit was dismissed by that court on summary judgment on December 11, 2001, *Creative Arts by Calloway, LLC v. Brooks*, No. 01 Civ. 3192 (CLB) (S.D.N.Y. Dec. 11, 2001) (mem.), and the decision was affirmed on appeal by the U.S. Court of Appeals for the Second Circuit on Oct. 11, 2002. *Creative Arts by Calloway, LLC v. Brooks*, No. 02-7050, 2002 WL 31303241 (2d Cir. Oct. 11, 2002).

11. THE CAB CALLOWAY ORCHESTRA and CAB CALLOWAY, considered in their entirety, are nearly identical in appearance, sound, connotation, and commercial impression.

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

13. There is and has been no consent, agreement or assignment between the parties with respect to the use of ownership of their respective marks.

14. Should Opposer establish that its use of THE CAB CALLOWAY ORCHESTRA created rights that existed prior to July 23, 1999, then any application granted to Applicant for CAB CALLOWAY for the services set forth in its application would cause a likelihood of confusion with THE CAB CALLOWAY ORCHESTRA for the goods and services he offers for sale or sells in connection with that term.

Exhibit “B”

02-7050

In the

United States Court of Appeals

for the Second Circuit

CREATIVE ARTS BY CAL, d/b/a C.A.B. CALLOWAY, LLC,

Plaintiff-Appellant,

-against-

CHRISTOPHER W. BROOKS, d/b/a THE CAB CALLOWAY ORCHESTRA,

Defendant-Appellee.

ON APPEAL FROM THE UNITED STATES DISTRICT COURT
FOR THE SOUTHERN DISTRICT OF NEW YORK

BRIEF FOR DEFENDANT-APPELLEE

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services. 15 U.S.C. § 1127 (definitions of "trademark" and "service mark"); *see Pirone*, 894 F.2d at 583 (purpose of a trademark is to designate source of a product). Unlike a personal name which merely identifies a person, and therefore cannot exist independent of the person, a trademark identifies and refers to the goodwill of a commercial enterprise. *See, e.g., Marshak v. Green*, 746 F.2d 927, 929 (2d Cir. 1984) ("[a] trade name or mark is merely a symbol of goodwill . . . . [t]here are no rights in a trademark apart from the business with which the mark has been associated"). By way of example, Michael Jordan, Paul Newman and Kenny Rogers are all personal names identifying well-known celebrities and entertainers. Yet those names also are trademarks serving to identify commercial enterprises: respectively, a chain of steakhouses, a line of food products, and a fast food franchise. By way of contrast, Cab Calloway never identified a business.

In arguing that Mr. Calloway acquired trademark rights in the name Cab Calloway, Creative Arts incorrectly assumes that the mere fame of a personal name automatically creates a trademark. This is not the law. If a name, regardless of how famous it is, refers primarily to the individual it is not and cannot be protected as a mark. The only personal names that are protected as valid marks are those that no longer primarily identify the individual but instead have acquired a "secondary meaning" so that they are synonymous in the minds of the public with a specific ongoing business, or with the sole source of origin for all goods or services offered

under the name. *Pirone*, 894 F.2d at 583; *Yarmuth-Dion*, 835 F.2d at 993; *Abraham Zion Corp. v. Lebow*, 761 F.2d 93, 104 (2d Cir. 1985); *see also* 15 U.S.C. § 1127 (definitions of "trademark" and "service mark"). Put another way, a personal name may be protected as a trademark only if it has come to symbolize "a particular business, product or company." *Dallas Cowboy Cheerleaders, Inc. v. Pussycat Cinema, Ltd.*, 604 F.2d 200, 203 n.5 (2d Cir. 1979); *accord Cairns v. Franklin Mint Co.*, 107 F. Supp. 2d 1212, 1222 (C.D. Cal. 2000) (to acquire trademark rights in a celebrity name, the name must "no longer primarily identify the individual . . . but instead identify plaintiff's [business]").

This Circuit, in *Thompson Medical v. Pfizer*, 753 F.2d 208 (2d Cir. 1985), held that a party seeking to prove secondary meaning, as Creative Arts is required to do here, must meet "vigorous evidentiary requirements." *Id.* at 217. The burden is on Creative Arts to show that a "significant number" of consumers identify the name Cab Calloway with a particular manufacturer or source. *See Papercutter, Inc. v. Fay's Drug Co., Inc.*, 900 F.2d 558, 564 (2d Cir. 1990); *Thompson Med.*, 753 F.2d at 217. Evidence to prove secondary meaning includes consumer studies and surveys, sales success and advertising expenditures, none of which were offered into evidence by Creative Arts. *Thompson Med.*, 753 F.2d at 217; *Ideal World Mktg.*, 15 F. Supp. 2d at 245; *Black & Decker*, 944 F. Supp. at 226. Here, like the personal name "Lebow" in *Abraham Zion*, no secondary meaning can be

Exhibit “C”

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IN THE UNITED STATES DISTRICT COURT
FOR THE SOUTHERN DISTRICT OF NEW YORK

CREATIVE ARTS BY CALLOWAY, LLC, a Delaware limited liability company, d/b/a C.A.B. CALLOWAY, LLC, Plaintiff, v. CHRISTOPHER W. BROOKS, an individual, d/b/a THE CAB CALLOWAY ORCHESTRA, Defendant.	01 CIV. 3192 (BDP)

MEMORANDUM OF LAW IN SUPPORT OF DEFENDANT'S MOTION FOR SUMMARY JUDGMENT AND IN OPPOSITION TO PLAINTIFF'S MOTION FOR A PRELIMINARY INJUNCTON

associated with goodwill personal and unique to him. Because the goodwill in the name cannot be transferred, the rights in the name "Cab Calloway" also cannot be transferred, and the "Cab Calloway" name does not survive as a trademark owned by the artist's heirs or successors. *Accord Blakely v. Sousa*, 47 A. 286, 288 (Pa. 1900) ("the name of an artist, an author, [or] a musician . . . has never been regarded as a trade name and, as such, salable. The value of the names of such persons depends entirely upon their personal reputation, skill and experience, and is indissolubly connected or associated with the owner.") As such, plaintiff obtained no rights in the "Cab Calloway" name and therefore cannot proceed with its claims.

B. Plaintiff Cannot Show Secondary Meaning In The Term "Cab Calloway."

Assuming for purposes of argument that the transfer by will of rights in the personal name of Mr. Calloway can withstand scrutiny, plaintiff still has no viable common law rights in "Cab Calloway." It is black-letter law that personal names are merely descriptive and are protected only if, through usage, they have acquired distinctiveness and secondary meaning. *See Pirone v. MacMillan, Inc.*, 894 F.2d 579, 583 (2d Cir. 1990); *Abraham Zion Corp. v. Lebow*, 761 F.2d 93, 104 (2d Cir. 1985); *see also* 2 *McCarthy* § 13:2 at 13-3, 13-4. Here, as a matter of law, plaintiff cannot show that the name "Cab Calloway" has acquired the requisite secondary meaning to support plaintiff's claims. *See Black & Decker Corp. v. Dunsford*, 944 F. Supp. 220, 228 (S.D.N.Y. 1996) (granting summary judgment where mark had not acquired secondary meaning).

A mark or trade name acquires secondary meaning when "the name and the business have become synonymous in the mind of the public, submerging the primary meaning of the term in favor of its meaning as a word identifying that business." *Pirone*, 894 F.2d at 583 (citation omitted); *see also Cairns v. Franklin Mint Co.*, 107 F. Supp. 2d 1212, 1222 (C.D. Cal.

Exhibit “D”

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IN THE UNITED STATES DISTRICT COURT
FOR THE SOUTHERN DISTRICT OF NEW YORK

CREATIVE ARTS BY CALLOWAY, LLC, a Delaware limited liability company, d/b/a C.A.B. CALLOWAY, LLC, Plaintiff, v. CHRISTOPHER W. BROOKS, an individual, d/b/a THE CAB CALLOWAY ORCHESTRA, Defendant.	01 CIV. 3192 (BDP)

DEFENDANT'S MEMORANDUM OF LAW IN FURTHER SUPPORT OF HIS MOTION FOR SUMMARY JUDGMENT

consisted of Mr. Calloway's personal services that had been preserved on CDs, records, and videos. This is not a business that can be transferred. As such, there could be no valid assignment, by will or otherwise, of the "Cab Calloway" name as a service mark. *Coffey v. Metro-Goldwyn-Mayer Corp.*, 289 N.Y.S. 882 (N.Y. Sup. Ct. 1936); Def.'s Mem. at 9-11. The *Russen* case does not hold to the contrary.

III. PLAINTIFF HAS NOT ESTABLISHED SECONDARY MEANING IN "CAB CALLOWAY" AS A MARK.

Even assuming that rights in the name "Cab Calloway" passed by Mr. Calloway's will and were validly assigned to plaintiff, that does not give plaintiff the right to pursue its claims.[4] In order for plaintiff to have a legally protectable right in "Cab Calloway," plaintiff must first establish that the name has acquired secondary meaning. *See, e.g., Pirone v. MacMillan, Inc.*, 894 F.2d 579, 583 (2d Cir. 1990); Pl.'s Opp. Mem. at 9-11. Secondary meaning requires that consumers who see the name "Cab Calloway," whether on a record, in connection with the name of defendant's orchestra, on a tee-shirt or otherwise associate these products *not* with Mr. Calloway but with plaintiff. *Abraham Zion Corp. v. Lebow*, 761 F.2d 93, 104 (2d Cir. 1985); *Black & Decker Corp. v. Dunsford*, 944 F. Supp. 220, 226 (S.D.N.Y. 1996).

Plaintiff has the burden of proving that a "significant number" of prospective purchasers identify "Cab Calloway" as a trademark or service mark of plaintiff. *Papercutter, Inc. v. Fay's Drug Co.*, 900 F.2d 558, 564 (2d Cir. 1990); *Thompson Med. Co. v. Pfizer, Inc.*, 753 F.2d 208, 217 (2d Cir. 1985). In this Circuit, evidence relevant to determining if secondary meaning exists

[4] As an aside, plaintiff now contends that it obtained the rights at issue from a settlement with Calloway Entertainment, whose predecessors allegedly received a grant of rights from Mr. Calloway. (Pl.'s Opp. Mem. at 5.) Plaintiff's reliance on this transfer vitiates its claims that rights in the "Cab Calloway" name passed by will, since, for such a transfer from Calloway Entertainment to have any validity, it would require that at the time of his death Mr. Calloway no longer possessed the rights to his name.

CERTIFICATE OF SERVICE

I hereby certify that one (1) copy of the following:

Applicant's Notice of Reliance

were served upon Opposer's counsel via Federal Express for overnight delivery, as indicated, this sixth of October 2008, upon the following:

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Date: October 6, 2008

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