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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
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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

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CHRISTOPHER BROOKS,	:	
Opposer,	:	
v.	:	**Opposition No. 91/1602266**
CREATIVE ARTS BY CALLOWAY, LLC	:	
Applicant.	:	

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APPLICANT'S TRIAL BRIEF

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I.

INTRODUCTION

The issue presented herein is as follows: Did Opposer Christopher Brooks ("Brooks" or "Opposer") establish sufficient prior rights in the mark THE CAB CALLOWAY ORCHESTRA to bar Applicant Creative Arts by Calloway, LLC's ("Applicant") registration of the mark CAB CALLOWAY. The answer, simply, is no. Priority alone is not a ground for opposition. As explained below, Opposer cannot establish either common law trademark rights or sufficient analogous rights created by use prior to July 23, 1999 to bar Applicant's registration of the mark CAB CALLOWAY. Moreover, Applicant, in response to Opposer's challenge, is permitted to "tack on" prior use of the common law trademark CAB CALLOWAY which predates Opposer's alleged date of first use, December 1998.

On July 23, 1999, Applicant, through its predecessor in interest, filed its intent-to-use (ITU) application at issue in this action, Serial No. 75/761,159 ("Application"), to register CAB CALLOWAY for various goods and services, including "distribution of pre-recorded music, drama, comedy and variety shows on videotapes, cassettes, digital video and audio discs and CD-ROM," "production and distribution of live music concerts, comedy, and dramatic series," and "production of videotapes and sound recordings, namely, photograph records, pre-recorded audio tapes, compact discs, videotapes, digital audio tapes, compact disc videos and laser discs."

Because the Application at issue is an ITU application, Applicant's filing date, July 23, 1999, is its priority date. Opposer's claim necessarily (and admittedly) falls under Section 2(d) of the Trademark Act, which requires that Opposer demonstrate either registration or common law trademark right that existed before July 23, 1999. Opposer asserts no such registration right, so he must establish a common law right to some CAB CALLOWAY mark (Opposer's mark of choice is THE CAB CALLOWAY ORCHESTRA). Additionally, Opposer cannot establish sufficient pre-July 23, 1999 analogous use or trade name use to bar Applicant's registration of CAB CALLOWAY.

At common law, CAB CALLOWAY—the name—is not inherently distinctive, and therefore is a trademark only if it has acquired secondary meaning identifying Opposer as the source of the goods and services at issue. Opposer has neither demonstrated secondary meaning nor anything from which acquired distinctiveness might be inferred prior to July 23, 1999, including use that is "analogous to trademark use." Indeed, much in the record indicates that CAB CALLOWAY identifies Mr. Brooks' deceased grandfather, Cab Calloway, not Mr. Brooks as the source of many musical performances.

The parties differ on whether personal name marks such as CAB CALLOWAY must acquire distinctiveness or are inherently distinctive from the date of first use. If Opposer is correct (which Applicant does not concede) that personal name marks are inherently distinctive, then he must lose as Applicant is the owner of common law rights

that predate Opposer's claimed first use of CAB CALLOWAY. Applicant's ownership of these common law rights, which are well documented herein, allow Applicant to tack these rights to its statutory priority date of July 23, 1999. In addition, because Applicant owns prior common law rights in the CAB CALLOWAY trademark and service mark, Opposer may not rely upon his use of THE CAB CALLOWAY ORCHESTRA to establish priority, as such use was unlawful.

In summary, Opposer has not met his burden of proof that, prior to July 23, 1999, he established either the requisite secondary meaning or sufficient analogous use or trade name use in the mark THE CAB CALLOWAY ORCHESTRA to bar Applicant's registration of CAB CALLOWAY. Moreover, Applicant's predecessor's use of the common law trademark CAB CALLOWAY predates Opposer's alleged first use of THE CAB CALLOWAY ORCHESTRA. Due to Opposer's failure to meet his burden of proof, judgment must be entered in favor of Applicant.

II.

DESCRIPTION OF THE RECORD.

A. Stipulation of the Parties.

On July 1, 2008, the parties filed a stipulation (approved by the Board by Order dated July 3, 2008, TTABVUE #40) agreeing that:

1. "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 item." (TTABVUE #41);

2. To the facts of the case other than that set forth above in Paragraph A(1) (See *id.*, Ex. A), and that Opposer's testimony (See *id,* Ex. B) and that of others could be introduced by affidavit (TTABVUE #39).

B. Opposer's Evidence.

Opposer's evidence consists almost entirely of documentation regarding his relationship to Cab Calloway and to business activities of The Cab Calloway Orchestra *after* July 23, 1999. Such evidence, as set forth in the Addendum attached hereto, is not relevant to this proceeding and should not be considered by the Board.

Opposer's evidence of the pre-July 23, 1999 activities of The Cab Calloway Orchestra is quite scant and certainly insufficient to met Opposer's burden of proof in this proceeding. Opposer has presented evidence of three (3) possible public performances of his musical group before July 23, 1999 (Affidavit of Opposer Christopher Brooks, dated June 30, 2008, together with exhibits, "Brooks Affidavit," TTABVUE #41, 60-68 and71-72), as well as evidence of the sales of a total of approximately twenty-five (25) copies of his CDs or videotapes, in the aggregate (Brooks Affidavit, 89-95). The Declarations of Opposer's three witnesses, Kuni Makami, Troy Burton and Monty Zullo (TTABVUE

#39), do not lend any additional support to Opposer's inadequate pre-July 23, 1999 activities. Opposer did not present any press or promotional literature that predates July 23, 1999.

On July 1, 2008, Opposer presented his Notice of Reliance (TTABVUE #38), which, as with the exhibits attached to his affidavit (TTABVUE #41), demonstrated his relationship to Cab Calloway and the efforts of The Cab Calloway Orchestra *after* July 23, 1999.[1] Such evidence is neither relevant nor helpful, and seeks to cloud and distract from the issue presented herein: Did Opposer established sufficient rights, prior to July 23, 1999, in the mark THE CAB CALLOWAY ORCHESTRA to bar Applicant's registration of the mark CAB CALLOWAY.

C. Applicant's Evidence.

Applicant's Notice of Reliance (dated October 6, 2008, TTABVUE #45) consisted of the following:

a. Stipulation as to Facts and Agreement to Submit Opposer's Testimony by Affidavit (TTABVUE #41, attached as Exhibit A).

b 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 (TTABVUE #41, attached as Exhibit B), 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

[1] Opposer did include in his Notice of Reliance (TTABVUE #38, Ex. 13) the Declaration of Cabella Calloway Langsam, which Applicant will cite in this Brief.

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 as Opposer admitted 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 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) (TTABVUE #41, attached as Exhibit C), 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 since Opposer admitted 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.

d. 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) (TTABVUE #41, attached as Exhibit D), 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 as Opposer admitted 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.

Based upon the aforementioned statements, Opposer must be prevented in this proceeding, pursuant to the doctrine of judicial estoppel, from contending that the mark THE CAB CALLOWAY ORCHESTRA is inherently distinctive. (See, Opposer's Trial Brief, pp.18-21.) The doctrine of judicial estoppel may be invoked to prevent a party from asserting claims inconsistent with claims previously asserted by that party: "(A)bsent any good explanation, a party should not be allowed to gain an advantage in litigation on one theory, and then seek an inconsistent advantage by pursuing an incompatible theory." *New Hampshire v. Maine*, (2001) 532 U.S. 742, 749, 121 S.Ct. 1808, 1814. The doctrine of judicial estoppel is intended to protect the integrity of the judicial process and "to prevent parties from playing fast and loose with the courts." *Id.*

at 749-751. *Planet Hollywood, Inc. v. Hollywood Casino Corp.*, (N.D. ILL. 1999) 80 F.Supp.2d 815, 892, judicial estoppel prevents a party who benefits from the assertion of a certain position from subsequently adopting a contrary position in any other litigation. See also, TBMP §704.06, as well as, *Bakers Franchise Corp. v. Royal Crown Cola Co.*, (CCPA 1969), 404 F.2d 985, 160 USPQ 192, 193 (admission contained in pleading in one action may be evidence against pleader in another action.)

Finally, Applicant will rely upon the Second Circuit decision of *Creative Arts by Calloway, LLC v Brooks*, (2nd Cir. 2002) 48 Fed.Appx. 16, 2002 WL 31303241 (attached hereto and attached in the Appendix of Opposer's Trial Brief), as well as the Declaration of Cabella Calloway Langsam in Support of Applicant's Opposition to Opposer's Motion for Summary Judgment, attached to Opposer's Notice of Reliance (TTABVUE #38) at Exhibit 13 (pages 56-61). By the aforementioned, it is undisputed that Applicant's predecessor, Zulme Calloway, the widow of Cab Calloway, was the sole beneficiary under Cab Calloway's will for all common law trademark rights Cab Calloway obtained in his sound recordings during his long entertainment career. Cab Calloway's common law trademark rights, of course, predate any alleged use of the mark CAB CALLOWAY by Opposer.

The burden of proof rests with Opposer. The parties have agreed that Applicant's priority date is July 23, 1999. Since Opposer began using the mark THE CAB CALLOWAY ORCHESTRA without the benefit of registration, he must prove that prior

to July 23, 1999 he acquired common law rights to THE CAB CALLOWAY ORCHESTRA. Accordingly, Opposer is faced with the challenge of demonstrating that his pre-July 23, 1999 use of the mark THE CAB CALLOWAY ORCHESTRA resulted in the perception amount prospective purchasers that the mark CAB CALLOWAY was the designation of his goods and services. By any measure, no such showing has been made by Opposer in this proceeding, and Applicant respectfully requests that judgment be entered in its favor.

III.

STATEMENT OF THE ISSUES.

The issue presented herein is as follows: Did Opposer establish sufficient prior rights in the mark THE CAB CALLOWAY ORCHESTRA to bar Applicant Creative Arts by Calloway, LLC's registration of the mark CAB CALLOWAY. The answer, simply, is no. Priority alone is not a ground for opposition. Opposer cannot establish either common law trademark rights or sufficient analogous rights created by use prior to July 23, 1999 to bar Applicant's registration of the mark CAB CALLOWAY. Moreover, Applicant is permitted to "tack on" prior use by its predecessor of the common law mark CAB CALLOWAY, which was well prior to Opposer's alleged date of first use, in response to Opposer's challenge.

IV.

RECITATION OF APPLICANT'S FACTS.

Applicant is a Delaware limited liability company founded by its predecessor, Zulme Calloway, Cab Calloway's widow, and two of Cab Calloway's daughters, Chris Calloway and Cabella Calloway Langsam.

On July 23, 1999, applicant's predecessor filed intent-to-use application Serial No. 75/761,159 to register CAB CALLOWAY. The services in that application are "[r]etail stores, retail outlets and online retail stores services featuring compact discs, records, videotapes, cassettes, digital video and audio discs, and other home entertainment related products; distribution of pre-recorded comedies, musicals, and dramas on videotapes, cassettes, digital video and audio discs, CD-Rom; distribution of pre-recorded theatrical musicals, comedies and dramas on videotapes, cassettes, digital video and audio discs, CD-Rom; and distribution of pre-recorded music, drama, comedy and variety shows on videotapes, cassettes, digital video and audio discs and CD-Rom" in International Class 35 and "[e]ntertainment services in the nature of multimedia entertainment software publication 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 theatrical plays; production of radio and television programs; production of videotapes and sound recordings, namely, phonograph records, pre-recorded audiotapes, compact discs, videotapes, digital audiotapes, compact disc videos

and laser discs; production and distribution of motion pictures; production of comedies, musical and drama; scheduling television and radio programming; production of music, drama, comedy, and variety shows; theatrical production of musicals, comedies and dramas" in International Class 41.

Applicant is the owner of common law trademark rights in the designation CAB CALLOWAY in connection with certain goods and services that predate Opposer's alleged first use dates.[2] In his will, Cab Calloway transferred all his property, real personal and mixed, of whatever kind "including all royalties and residuals and other payments or rights to payment for the reproduction of my performances or any songs or lyrics or both in which I have any ownership or other rights" as well as all intellectual property rights he possessed to Zulme Calloway, Applicant's predecessor. (Declaration of Cabella Calloway Langsam in Support of Applicant's Opposition to Opposer's Motion for Summary Judgment, attached to Opposer's Notice of Reliance (TTABVUE #38) at Exhibit 13 (pages 56-61), hereinafter "Langsam Declaration," at ¶15, page 60.) Mrs. Calloway subsequently transferred the intellectual property rights she received to

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[2] In anticipation of Opposer's reply argument, such rights were not at issue in either the underlying District Court action or Second Circuit's 2002 decision (see, Appendix) and were never litigated. The underlying District Court action was limited to whether Applicant had service mark rights in CAB CALLOWAY originating during Cab Calloway's lifetime for entertainment services. The District Court held that Applicant did not have such service mark rights because Mr. Calloway's will did not transfer an ongoing business to Mrs. Calloway and Mrs. Calloway did not continue with Mr. Calloway's entertainment services after his death in 1994. Whether Applicant had trademark or service mark rights in other contexts was not at issue in the District Court action.

Applicant. (Langsam Declaration at ¶17, page 60; see also, *Creative Arts by Calloway, LLC v. Brooks, supra*, attached.)

Cab Calloway's recordings continue to be sold under the CAB CALLOWAY trademark to this day, and the trademark continues to identify the very recordings it identified during Mr. Calloway's lifetime. (Langsam Declaration, at ¶19, page 61.) As the owner of Mr. Calloway's intellectual property, Applicant is the owner of the CAB CALLOWAY trademark for sound recordings. Applicant's rights in the CAB CALLOWAY trademark for sound recordings predate Opposer's claimed first date of use in December 1998.

V.

ARGUMENT.

A. SECTION 2(d)

The Opposer's position is expressly based upon Section 2(d) of the Trademark Act. In this matter, Opposer must establish a common law trademark right in THE CAB CALLOWAY ORCHESTRA before July 23, 1999. This is so because the hallmark of a Section 2(d) opposition is that "the Opposer contends that Applicant's Mark so resembles either (1) Opposer's registered trademark or (2) Opposer's prior common law mark or trade name as to be likely to cause confusion." 3 *McCarthy on Trademarks and Unfair Competition* § 20:14 (4th Ed. Rel. 32, 12/2004). Although Opposer's remarks in his Trial Brief that he has made "sufficient use of THE CAB

CALLOWAY ORCHESTRA as a common law mark before the Application filing date to establish his prior rights" (Opposer's Trial Brief, p. 16), Opposer has conspicuously failed to demonstrate that possessed the requisite secondary meaning as of July 23, 1999.

Opposer asserts service mark rights in THE CAB CALLOWAY ORCHESTRA for live musical performances, and trademark rights in the mark for audio and video recordings of entertainment services.

Live Musical Performances

> "The crux of the secondary meaning doctrine is that the mark comes to identify not only the goods but the source of those goods. To establish secondary meaning, it must be shown that the primary significance of the term in the minds of a consuming public is not the product, but the producer (citations omitted)."

Ralston Purina Co. v. Thomas J. Lipton, Inc., 341 F. Supp. 129, 133 (S.D.N.Y. 1972). *See* TMEP § 1212, which quotes this text.

The ways secondary meaning may be proven for trademark application purposes are: (i) ownership of a prior Principal Register registration of the same mark with the same or closely related goods and services; (ii) five years "substantially exclusive and continuous" use under Section 2(f); and, (iii) "actual evidence." TMEP § 1212. This is a lesser standard than would be required of Opposer by the common law, although that makes no difference here, because Opposer does not meet either of the first two criteria. He must prove secondary meaning by "evidence" or not at all. TMEP § 1212.6 sets forth the evidentiary considerations by which secondary meaning may be established as

follows: (a) "Long Use of the Mark," (b) "Advertising Expenditures," (c) Affidavits or Declarations Asserting Recognition of Mark as Source Indicator, and (d) "Survey Evidence Market Research and Consumer Reaction Studies." Courts employ various lists, most of which encompass these factors, and sometimes, others.

Just looking at the TMEP list of "evidence" factors, it is evident Opposer has made no case for secondary meaning. Use, even assuming it is continuous from December 1998 to July 23, 1999, is no one's idea of "long" use, and there is no evidence of particularly widespread or frequent use during the critical period; there is no evidence of advertising expenditures prior to July 23, 1999; and there are no affidavits or declarations asserting recognition of CAB CALLOWAY as a source indicator for Opposer, surveys, market research or consumer reaction studies. In short, Opposer has not even made a credible attempt to establish secondary meaning.

Opposer's claimed mark is THE CAB CALLOWAY ORCHESTRA, which comprises what is surely one of the most common articles in the language ("the"), the generic term "orchestra" and "Cab Calloway," which Opposer admits is the name of the "Internationally famous jazz musician Cab Calloway." (Opposer's Trial Brief, p. 9.) Plainly, the only matter of any trademark consequence in Opposer's claimed mark is the name CAB CALLOWAY. Indeed, the parties have stipulated that the claim marks THE CAB CALLOWAY ORCHESTRA and CAB CALLOWAY are "nearly identical in appearance, sound, connotation, and commercial impression." (TTABVUE #41, pp.3-

6.)

Evidence (or lack thereof) aside, given the relatively brief period of use by Opposer, it is highly unlikely that Opposer's association with the CAB CALLOWAY mark has supplanted the original meaning of the name.

Audio Recordings

There is an additional problem with audio recordings. Until July 23, 1999, there was only one recorded album by THE CAB CALLOWAY ORCHESTRA; the second recording was not sold until after July 23, 1999. (Brooks Affidavit, TTABVUE #41, p.10.) At that point, the name was merely descriptive of the artist performing on the recording, and did not function as a trademark. *In re Spirer*, 225 USPQ 693 (TTAB 1985).

> It is well settled that the title to a *series* of records or books is able to function . . . a trademark . . . The reason is that the name for a series, at least while it is still being published, as a trademark function indicating that each book of the series comes from the same source as the others. The name of the series is not descriptive of any one book and each book has its individual name or title . . .
>
> In conclusion, just showing the name of the recording group on a record will not by itself enable that name to be registered as a trademark. Where, however, the owner of the mark controls the quality fo the goods, and where the name of that recording group has been used numerous times on different records and has therefore come to represent an assurance of quality to the public, then it may be registered as a trademark since it functions as one.

In re Polar Music Int'l AB, 714 F.2d 1567, 1572, 221 USPQ 315, 318 (Federal Cir.

1983).

Video Recordings

Similarly, Opposer has only identified one video recording alleged to have been distributed prior to July 23, 1999, so there is no series from which THE CAB CALLOWAY ORCHESTRA could acquire trademark significance.

Based upon Opposer's extremely limited activity prior to July 23, 1999, it would be impossible for Opposer to demonstrate the requisite secondary meaning considering that: (1) the potential purchasers of CAB CALLOWAY entertainment services are nationwide (actually, worldwide), diverse and very numerous; (2) Opposer was the second (after Cab Calloway and his successors) to use the name CAB CALLOWAY for goods and services, and, by July 1999, Opposer had hardly eclipsed Cab Calloway; and, (3) Opposer offers no significant evidence (*e.g.*, surveys, extensive press or references) that by July 23, 1999 CAB CALLOWAY had come to mean, in the collective mind of the purchasing public, the activity and services of Opposer.

B. CAB CALLOWAY IS NOT INHERENTLY DISTINCTIVE.

Opposer attempts to avoid the rigor of the foregoing analysis by simply stating THE CAB CALLOWAY ORCHESTRA is inherently distinctive of Opposer's goods and services. (Opposer's trial brief, pp. 18- 21.) His only cognizable authority for saying so is *Michael Sachs, Inc. v. Cordon Art B.V.*, (2000) 56 USPQ 2d 1132. What

this authority explains is that the name of an artist (in that case, a painter) "may function as a trademark." 56 USPQ 2d at 1137. "As a general comment, we would point out that the name of an artist, in addition to identifying the artist, may serve a trademark function if it identifies the source of a product and distinguishes it from the goods of another." 56 USPQ 2d at 1135, n. 8. In other words, the name of an artist serves a trademark function only if it identifies the source and distinguishes the artist's goods from those of another. If it does not do those things, it is not a trademark, it is just a name – without secondary meaning, which is the issue here.

> Personal names (surnames and first names) have been placed by the common law into that category of non-inherently distinctive terms which require proof of secondary meaning for protection . . .
>
> [Personal names] acquire legally protected status only after they have had such an impact upon a substantial part of the buying public as to have acquired "secondary meaning," that is, the public has come to recognize the personal name as a symbol that identifies and distinguishes the goods and services of only one seller.

2 *McCarthy on Trademarks and Unfair Competition* § 13.2 (4th Ed., Rel. 44, 3-2007.)[3]

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[3] Similarly, see: "Personal names, including both names and surnames, are not considered to be inherently distinctive and are therefore protectable as trademarks . . . ***only upon proof of secondary meaning***. Thus, the first person who adopts a particular person's name to identify the person's goods, services or business obtains no rights in the designation unless consumers have in fact come to recognize the name as a symbol that distinguishes the products for businesses of that person from those of other." *Restatement (Third) of Unfair Competition,* § 14, Comment *e.* (Emphasis added.)
See also: "Just as with descriptive terms, a trademark or trade name that consists of a personal name (first name, surname, or both) is entitled to legal protection only if it attains secondary meaning." 1 Gilson, *Trademark Protection and Practice* § 3.02[4][d].

The conclusion Opposer trumpet is that "the name of an artist is presumptively not merely descriptive." 56 USPQ 2d at 1137. The name of an artist, however, is presumptively a personal name, and the authority is unanimous that to be protected as a trademark, personal names must have secondary meaning. Opposer himself repeatedly emphasized that point to the Courts in earlier litigation against Appellant.

> 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 that name.[4]
>
> 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.[5]
>
> In order for plaintiff to have a legally protectable right in "CAB CALLOWAY," Plaintiff must first establish that the name has acquired secondary meaning.[6]

In flagrant disregard of stated Board practice, Opposer attempts to rely upon two unpublished decisions, *In re St. Clair Apparel, Inc.* and *Remos v. Feierman*, simply noting in his citations that each is "non-precedential" as the attached unpublished decisions state on their front pages, "THIS DISPOSITION IS NOT CITABLE AS

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[4] See, Applicant's Notice of Reliance (dated October 6, 2008), TTABVUE #45, Ex. B.

[5] TTABVUE #45, Ex. C.

[6] TTABVUE #45, Ex. D.

PRECEDENT OF THE T.T.A.B."

TBMP § 101.03 makes it even clearer:

> "Decisions that are designated by the Board as "citable as precedent" or "for publication in full" are citable as precedent. Decisions which are not so designated, or which are designated for publication only in digest form are not citable as authority . . . "

Recently, *In re Polo Int'l., Inc.*, 51 USPQ 2d 1061, 1063 n.3 (TTAB 1999) ruled:

> "Applicant, although acknowledging that it was a non-precedential case, nevertheless referred in its brief to [one such case]. The Board disregards citation to any non-precedential decisions (unless, of course, it is asserted for res judicata, law of the case or other such issues)."

Granted that personal names which are not primarily merely surnames will be accepted for registration, published, and if not opposed and used, registered. However, that departure from the common law benefits applicants, not opposers. Under Section 2(d), Opposer chosen weapon in this proceeding, he must assert a prior registration or common law right. He has no prior registration, so he is bound by the common law which, as Opposer pointed out repeatedly in prior litigation between the parties, demands secondary meaning before personal names may be asserted as trademarks.

As stated above, Applicant's priority date for purpose of this dispute is July 23, 1999, which is the filing date of its application that is being opposed. See Section 7(c) of the Trademark Act, 15 U.S.C. § 1057(c). Section 7(c) requires Opposer, if he is to prevail, to demonstrate that prior to July 23, 1999,

he "has used the mark." The meaning of this statutory requirement is crucial: "A party who alleges a use prior to an opponent's constructive use date must prove its priority under the traditional rules of common law trademark priority." 2 *McCarthy on Trademarks and Unfair Competition*, § 16:17 (4th Ed. Rel. 47, 9-2008). Thus to prevail, Opposer must establish that prior to July 23, 1999, CAB CALLOWAY had come in the public mind to identify his goods and services. Opposer thus far has neither recognized, nor attempted to shoulder, his burden of proof that as of July 23, 1999 the primary meaning of CAB CALLOWAY to the purchasing public was his services. Proof of this critical, legally required fact has not been attempted by Opposer in his Trial Brief. In the evidence he has presented to the Board, Opposer focuses mainly on his non-relevant activities well past Applicant's priority date of July 23, 1999.

Opposer receives no benefit from the registration documents of other entities (see, Opposer's Notice of Reliance, TTABVUE #38, Exhibits 14 and 15), as the marks subject to those documents were registered. Opposer must meet his burden of proof under the common law, not under the process of registration.

C. OPPOSER DOES NOT RECEIVE ANY ASSISTANCE FROM THE HISTORICAL NAMES DOCTRINE.

As stated in *McCarthy* regarding historical names:

> Historical names that are widely recognized as such do not really fall into the classical "personal name" category at all: 'The law permits the adoption as a trademark of the name of a person who has achieved and distinction, *provided the name is not descriptive of the quality or character of the article . . .* " (Emphasis added.)

2 *McCarthy on Trademarks and Unfair Competition*, §13.25 (4TH ed., Rel. 38, 6-2006). At common law, the above-referenced restriction regarding historical names plainly applies to Opposer, who employed CAB CALLOWAY to describe the quality and character of his services (which, purportedly, was largely compromised of Cab Calloway's music, played and performed in Cab Calloway's style).

The *Restatement* contains a similar prohibition:

> If a name consists of the name of an historical figure or other noted person and is likely to be recognized as such by prospective purchasers, secondary meaning will ordinarily not be required, *unless consumers are likely to believe that the name person is connected with the goods, service or business . . .* (Emphasis added)

Restatement (Third) of Unfair Competition, § 14, Comment *e* (1995).

The decision in *Lucien Piccard Watch Corp. v. Since 1868 Crescent Corp.*, (S.D.N.Y. 1970) 314 F.Supp. 329, 165 USPQ 459, does not lend any support to Opposer. The court, in *Lucien*, said the name DA VANCI "is clearly

fanciful and arbitrary as applied to plaintiff's wares, since it does not describe their kind, qualities, properties or place of manufacture." No such distinction can be made successfully here concerning Opposer's activities and CAB CALLOWAY.

D. OPPOSER DID NOT ESTABLISH PRIOR PROPRIETARY USE OF MARK THE CAB CALLOWAY ORCHESTRA.

Opposer cannot establish prior proprietary use of THE CAB CALLOWAY ORCHESTRA in a manner to bar Applicant's registration of CAB CALLOWAY under Section 2(d). A mark on which a Section 2(d) claim rests must be distinctive. See, *Otto Roth & Company, Inc. v. Universal Foods Corp.*, (CCPA 1981) 640 F.2d 1317, 209 USPQ 40. As set forth above, despite his claim to the contrary, Opposer's mark THE CAB CALLOWAY ORCHESTRA is not inherently distinctive.

Apparently, Opposer bases his claim for prior proprietary use of THE CAB CALLOWAY ORCHESTRA on three (3) contracts signed for public performances[7], the diminutive sales of twenty-five compact discs and videotapes and the purported distribution of a press packet that has not been produced. Such analogous use can only succeed, however, where the analogous use is of such a nature and extent to create public identification of the target term with

---

[7] Which were not executed under the name THE CAB CALLOWAY ORCHESTRA.

the opposer's goods and services. "Nevertheless, the activities claimed to create such an association must reasonably be expected to have a substantial impact on the purchasing public before a later user acquires proprietary rights." *T.A.B. Systems v. Pactel Teletrac*, (Fed. Cir. 1996) 77 F.3d 1372, 1375, 37 USPQ 2d 1879.[8] Opposer's limited pre-July 23, 1999 evidence markedly fails to demonstrate that his use of THE CAB CALLOWAY ORCHESTRA was perceived by prospective purchasers as proprietary (*i.e.*, source-indicating) rather than descriptive. Where, as here, the opposer's indirect evidence falls short of supporting the critical inference of identification in the mind of the consuming public, courts have not been hesitant to reject an analogous use opposition. *Id.*; See also, *Old Swiss House, Inc. v. Anheuser-Busch, Inc.*, (CCPA 1978) 569 F.2d 1130, 196 USPQ 808.

Opposer's pre-July 23, 1999 evidence also falls short of demonstrating trade name use sufficient under Section 2(d) to bar Applicant's registration of CAB CALLOWAY. Opposer's three (3) performance contracts are not unequivocal evidence that he used the name THE CAB CALLOWAY ORCHESTRA in a manner which identified his services to the public. Of note, the check registers presented by Opposer (Brooks Affidavit, Ex. 2), are in his

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[8] See also, "[B]efore a prior use becomes analogous use sufficient to create proprietary rights, the petitioner must show prior use sufficient to create an association in the minds of the purchasing public between the mark and petitioner's goods." *Malcolm Nicol & Co. v. Witco Corp.*, (Fed. Cir. 1989) 881 F.2d 1063, 1065, 11 USPQ 2d 1638.

personal name, Christopher W. Brooks, and not in the name of THE CAB CALLOWAY ORCHESTRA.

Given that Opposer's extremely limited pre-July 23, 1999 activity concerning THE CAB CALLOWAY ORCHESTRA is insufficient to establish prior proprietary rights, Opposer cannot bar Applicant's registration of CAB CALLOWAY on the basis of this doctrine.

E. APPLICANT'S PRIOR COMMON LAW TRADEMARK USE PREDATES OPPOSER'S ACTIVITY.

Applicant is the owner of common law trademark and service mark rights in the designation CAB CALLOWAY in connection with certain goods and services that predate Opposer's alleged first use dates. In his will, Cab Calloway transferred all his property, real personal and mixed, of whatever kind "including all royalties and residuals and other payments or rights to payment for the reproduction of my performances or any songs or lyrics or both in which I have any ownership or other rights" as well as all intellectual property rights he possessed to his widow, Zulme Calloway, Applicant's predecessor. (Declaration of Cabella Calloway Langsam in Support of Applicant's Opposition to Opposer's Motion for Summary Judgment, attached to Opposer's Notice of Reliance (TTABVUE #38) at Exhibit 13 (pages 56-61), hereinafter "Langsam Declaration," at ¶15, page 60.) Mrs. Calloway subsequently transferred the intellectual property rights she received to Applicant. (Langsam

Declaration at ¶17, page 60; See also, Appendix, *Creative Arts by Calloway, LLC v. Brooks,* (2nd Cir. 2002) 48 Fed.Appx. 16, 2002 WL 31303241.) Cab Calloway's recordings continue to be sold under the CAB CALLOWAY trademark to this day, and the trademark continues to identify the very recordings it identified during Mr. Calloway's lifetime. As the owner of Mr. Calloway's intellectual property, Applicant is the owner of the CAB CALLOWAY trademark for sound recordings. Applicant's rights in the CAB CALLOWAY trademark for sound recordings predate Opposer's claimed first date of use in December 1998. (Langsam Declaration, ¶19, page 61.)

Applicant's prior common law rights are relevant for two reasons. First, Applicant may, for priority purposes, tack its prior use of the CAB CALLOWAY mark, and mark that the legal equivalent thereto, in connection with services "substantially identical" to services identified in its Application. *Van Dyne-Crotty, Inc. v. Wear-Guard Corp.*, (Fed. Cir. 1991) 17 USPQ2d 1866, 1868. Second, Opposer may not rely on unlawful use of THE CAB CALLOWAY ORCHESTRA mark to establish priority.

When an artist controls the quality of the recordings, and releases multiple albums bearing the name of the artist, the artist's name functions as a trademark owned by the artist. *In re Polar Music Int'l AB, supra,* 714 F.2d at 1572. Over the course of Cab Calloway's sixty-plus year career, Mr. Calloway released

numerous recordings bearing his name. (Langsam Declaration, ¶3, page 57.) As a result, CAB CALLOWAY became a trademark identifying Cab Calloway's recorded music.

As a well-known band leader, Cab Calloway exercised creative control over the music he recorded and was ultimately responsible for the sound of the recorded music. (Langsam Declaration, ¶¶ 4, 5, page 57). In addition, Mr. Calloway authored or co-authored, and arranged, many of the songs he recorded. *Id.* As the person responsible for the quality of the sound of the songs being recorded, Mr. Calloway owned the trademark right in the CAB CALLOWAY designation in connection with sound recordings.

The District Court's ruling (subsequently upheld by the Second Circuit, see Appendix) does not apply to the transfer of the CAB CALLOWAY trademark for sound recordings. Mr. Calloway's recordings continue to be sold under the CAB CALLOWAY trademark to this day and the trademark continues to identify the very recordings it identified during Mr. Calloway's lifetime. As a result, the CAB CALLOWAY trademark presently symbolizes the very goodwill it symbolized when Mr. Calloway was alive. As the owner of Mr. Calloway's intellectual property, Applicant is the owner of the CAB CALLOWAY trademark for sound recordings. Applicant's rights in the Cab Calloway trademark for sound recordings predate Opposer's first use date of

December 1998.

A party may tack the earlier use of one mark on to the later use of a mark that is legally equivalent to the earlier-used mark. *Van Dyne-Crotty, Inc., supra.* In addition, a party may tack prior use of a mark for certain goods and services on to use of the same mark for other goods and services if the two sets of goods and services are "substantially identical." *Big Blue Prods., Inc. v. Int'l Business Machines Corp.*, (TTAB) 19 USPQ2d 1072, 1075.

Applicant holds common law rights in the trademark CAB CALLOWAY for sound recordings. The recitation of services in the Application also includes "production of video tapes and sound recording." Because the production of sound recordings are substantially identical to sound recordings themselves, Applicant may rely on its prior rights in the CAB CALLOWAY trademark for sound recordings for purposes of establishing priority in this proceeding.

In addition to the argument set forth above, "[T]he Board may, in determining priority or use, refuse to give a party the benefit of use that was not lawful. *Big Blue Prods., Inc., supra.* If Opposer adopted THE CAB CALLOWAY ORCHESTRA mark when CAB CALLOWAY already had been appropriated by Applicant or its predecessor, Opposer's use would not be lawful. *See id.* at 1076.

VI.

CONCLUSION.

For the reasons set forth above, Applicant Creative Arts by Calloway, LLC respectfully requests that Board overrule deny Opposer's Opposition, and enter judgment in favor of Applicant.

Respectfully submitted,

Los Angeles, CA
February 17, 2009

KARLIN & KARLIN, APLC

By, _____

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ADDENDUM

Applicant submits the following objections to Opposer's evidence:

Applicant objects to the following Exhibits to the Affidavit of Opposer Christopher Brooks to be Submitted as Trial Testimony, dated June 30, 2008 (TTABVUE #41):

1. All documents attached as Exhibit 1 which are dated post July 23, 1999, as these documents are not relevant to Opposer's Section 2(b) opposition based upon his pre-July 23, 1999 activities.
2. Exhibit #3 to the Affidavit of Opposer Christopher Brooks on the grounds that same constitutes inadmissible hearsay.

Applicant objects to the following Exhibits to Opposer's Notice of Reliance, dated and filed July 1, 2008, TTABVUE #38:

1. Exhibit 3 is not relevant to Opposer's Section 2(d) opposition based upon his pre-July 23, 1999 activities;
2. Exhibit 4 is not relevant to Opposer's Section 2(d) opposition based upon his pre-July 23, 1999 activities;
3. Exhibit 5 is not relevant to Opposer's Section 2(d) opposition based upon his pre-July 23, 1999 activities;

4. Exhibit 6 is not relevant to Opposer's Section 2(d) opposition based upon his pre-July 23, 1999 activities;

5. Exhibit 7 is not relevant to Opposer's Section 2(d) opposition based upon his pre-July 23, 1999 activities;

6. Exhibit 8 is not relevant to Opposer's Section 2(d) opposition based upon his pre-July 23, 1999 activities;

7. Exhibit 9 is not relevant to Opposer's Section 2(d) opposition based upon his pre-July 23, 1999 activities;

8. Exhibit 10 is not relevant to Opposer's Section 2(d) opposition based upon his pre-July 23, 1999 activities;

9. Exhibit 11 is not relevant to Opposer's Section 2(d) opposition based upon his pre-July 23, 1999 activities;

10. Exhibit 14 is not relevant to Opposer's Section 2(d) opposition based upon his pre-July 23, 1999 activities as this document concerns a registered, not common law, trademark;

11. Exhibit 15 is not relevant to Opposer's Section 2(d) opposition based upon his pre-July 23, 1999 activities as this document concerns a registered, not common law, trademark.

APPENDIX

C
This case was not selected for publication in the Federal Reporter.

United States Court of Appeals, Second Circuit.
CREATIVE ARTS BY CALLOWAY, L.L.C., d/b/a C.A.B. Calloway, L.L.C., Plaintiff-Appellant,
v.
Christopher BROOKS, d/b/a The Cab Calloway Orchestra, Defendant-Appellee.
No. 02-7050.

Oct. 11, 2002.

Marc A. Karlin, Karlin & Karlin, Los Angeles, California, for Plaintiff-Appellant.
Barbara A. Solomon, Fross, Zelnick, Lehrman & Zissu, New York, New York, for Defendant-Appellee.

Present JACOBS and POOLER, Circuit Judges, and BAER, District Judge.[FN*]

FN* The Honorable Harold Baer, Jr., United States District Judge for the Southern District of New York, sitting by designation.

SUMMARY ORDER

**1 Appeal from judgment of the United States District Court for the Southern District of New York (Charles L. Brieant, Judge) granting Defendant's motion for summary judgment and denying Plaintiff's motion for a preliminary injunction.

*17 **ON CONSIDERATION WHEREOF, IT IS HEREBY ORDERED, ADJUDGED, AND DECREED** that the judgment of the District Court be and it hereby is **AFFIRMED.**

This trademark infringement action arises out of Defendant-Appellee Christopher Brooks' use of the name "Cab Calloway." Cab Calloway, born Cabell Calloway III on December 25, 1907, was a jazz musician who performed solo, with a small ensemble under the name "Cab Calloway and The Cab Jivers," and with big bands under the names "Cab Calloway and The Hi De Ho Orchestra,""Cab Calloway and His Famous Orchestra," and "Cab Calloway and The Cotton Club Orchestra." Cab Calloway died November 18, 1994 and was survived by his widow, Zulme Calloway, and several children and grandchildren, including Brooks, his oldest grandson from an earlier marriage.

Both Zulme Calloway and Brooks have sought to preserve the musical legacy of Cab Calloway. In 1998, Brooks formed "The Cab Calloway Orchestra," which plays vintage Cab Calloway songs using the original arrangements. Brooks also performs with smaller ensembles, titled "The Cab Calloway Band," "The Cab Calloway Duo (or Trio)," or "Calloway Brooks and The Cab Jivers." Brooks, who sometimes uses the stage names "Calloway Brooks" or "Christopher Calloway Brooks," has performed over 150 concerts and, between 1999 and 2001, released two compact discs and a video tape of his performances.

Zulme Calloway and several other relatives formed Creative Arts by Calloway, L.L.C. ("Creative Arts") on December 25, 2000. The Calloway family created Creative Arts to manage the rights associated with Cab Calloway's name, likeness, voice, and intellectual property. Creative Arts maintains that Cab Calloway's will transferred his trademark rights in the name "Cab Calloway" to Zulme Calloway, who subsequently transferred them to Plaintiff-Appellant.

On April 16, 2001, Creative Arts filed suit against Brooks, alleging that his use of the name "Cab Calloway" constitutes: 1) common law service mark infringement; 2) unfair competition in violation of the Lanham Act, 15 U.S.C. § 1125(a); 3) service mark dilution in violation of New York General

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Business Law §§ 368-c, d; and 4) unfair business practices in violation of New York General Business Law §§ 349, 350. Creative Arts also sought a preliminary injunction to prohibit Brooks from doing business as "The Cab Calloway Orchestra." The district court granted Brooks summary judgment on Creative Arts' claims in their entirety, and denied Creative Arts' motion for a preliminary injunction, on the grounds that: 1) there is no evidence that Cab Calloway had a common law service mark in his name, as there is no evidence that the name ever acquired secondary meaning; 2) assuming Cab Calloway had such a mark, he did not transfer it in conjunction with an ongoing business, rendering any assignment invalid; and 3) Brooks' use of the name "Cab Calloway" is protected as fair use. Creative Arts appeals the district court's judgment.

**2 Regardless of whether the name "Cab Calloway" acquired secondary meaning during the performer's lifetime, Creative Arts cannot prevail because any trademark assignment to Zulme Calloway would have been invalid. A trademark is merely a symbol of goodwill and cannot be sold or assigned apart from the goodwill it symbolizes. *Marshak v. Green,* 746 F.2d 927, 929 (2d Cir.1984) (citing Lanham Act, § 10, 15 U.S.C.S. § 1060). As goodwill is inseparable from the underlying business with which it is associated, rights in a trademark cannot be transferred "in gross," or apart from an ongoing business. *18 See *id.* ("There are no rights in a trademark apart from the business with which the mark has been associated; they are inseparable."). *See also Berni v. International Gourmet Restaurant, Inc.,* 838 F.2d 642, 646-47 (2d Cir.1988). Moreover, the assignee must continue to offer products or services that are "substantially similar" to those of the assignor. *Marshak,* 746 F.2d at 930. *See also Visa U.S.A., Inc. v. Birmingham Trust Nat. Bank,* 696 F.2d 1371, 1376 (Fed.Cir.1982) ("[T]he transfer of goodwill requires only that the services be sufficiently similar to prevent consumers of the service offered under the mark from being misled from established associations with the mark.") (internal quotation marks omitted).

In the instant case, Cab Calloway was not operating a going concern at the time of his death, precluding the transfer of a mark. Creative Arts argues that Cab Calloway was in the business of marketing his entertainment services. "Entertainment" may be considered a service in connection with the law of service marks. *See Smith v. Montoro,* 648 F.2d 602, 605 (9th Cir.1981) (citations omitted); *Estate of Presley v. Russen,* 513 F.Supp. 1339, 1363 n. 31 (D.N.J.1981) (citations omitted). However, Cab Calloway's activities were not organized as a business that could have been transferred to his widow.

Creative Arts argues that Cab Calloway transferred his entertainment business to Zulme Calloway, because retailers continue to sell his music and audiences can watch his television and movie appearances. However, it is undisputed that various record companies own the rights to the masters of Cab Calloway's songs, and there is no evidence that Creative Arts owns the rights to any of Cab Calloway's public appearances.

The Court has considered Creative Arts' remaining arguments on this issue and finds them to be without merit. As there is no evidence that Cab Calloway operated a going concern at the time of his death, the Court need not reach the issue whether Brooks' use of the name "Cab Calloway" constitutes fair use. We note, however, that it is doubtful Brooks' naming of his orchestra would fall within this Court's jurisprudential definition of fair use, as he apparently is using the name "Cab Calloway" as part of his own trademark, "The Cab Calloway Orchestra." *See Cosmetically Sealed Indus., Inc. v. Chesebrough-Pond's USA Co.,* 125 F.3d 28, 30 (2d Cir.1997) ("The defense [of fair use] permits others to use protected marks in descriptive ways, but not as marks identifying their own products.") (citing *Car-Freshner Corp. v. S.C. Johnson & Son, Inc.,* 70 F.3d 267, 270 (2d Cir.1995)).

C.A.2 (N.Y.),2002.

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CERTIFICATE OF SERVICE

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

APPLICANT'S TRIAL BRIEF

were served upon the following via U.S. Mail, as indicated, this seventeenth day of February 17, 2009, upon the following:

Barbara A. Solomon, Esq.
Evan Gourvitz, Esq.
Fross, Zelnick, Lehrman & Zissu, P.C.
866 United Nations Plaza
New York, NY 10017

Date: February 17, 2009

KARLIN & KARLIN
A PROFESSIONAL LAW CORP.

BY, _____
MARC A. KARLIN