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

Proceeding	91160266
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I. INTRODUCTION

In its February 17, 2009 trial brief (“App. Tr. Br.”), Applicant Creative Arts by Calloway, LLC (“Applicant”) has not contested, or offered any evidence contesting or disputing, any of the following: (i) it filed its now-opposed Application Serial No. 75/761,159 (“the Application”) to register the mark CAB CALLOWAY on an intent-to-use basis without claiming or offering any evidence of acquired distinctiveness; (ii) it has stipulated and agreed 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;” and (iii) prior to July 23, 1999 Opposer Christopher Brooks (“Opposer”) used the mark THE CAB CALLOWAY ORCHESTRA in commerce in connection with his entertainment services, audio recordings, and video recordings, held his company out to the public as THE CAB CALLOWAY ORCHESTRA, and advertised and promoted his orchestra as THE CAB CALLOWAY ORCHESTRA.

These uncontroverted facts establish Opposer’s prior use of THE CAB CALLOWAY ORCHESTRA and, *a fortiori*, that registration of Applicant’s mark must be denied. Faced with this result, out of desperation Applicant has asserted two legally and factually flawed arguments: (1) although THE CAB CALLOWAY ORCHESTRA mark *was* in fact used by Opposer for his goods and services prior to July 23, 1999, Opposer has not established priority because that mark is not inherently distinctive and did not acquire distinctiveness prior to July 23, 1999, and (2) Applicant has priority based on its predecessor(s) purported common law use of CAB CALLOWAY as a mark. But the first argument, if true, would require the Patent & Trademark Office to refuse registration to the very application at issue in this opposition, as it would mean that Applicant’s own applied-for mark, CAB CALLOWAY, cannot be registered on an intent-to-use basis, since use would be required to show the requisite secondary meaning. Applicant’s

second argument is even more desperate. First, Applicant has failed to introduce evidence of this alleged prior common law use, or the dates of such use, let alone evidence sufficient to meet the “clear and convincing” standard required by the Board where a party claims a priority date earlier than that alleged in its application.¹ Second, such use is *irrelevant* to this proceeding, as Applicant already has stipulated that “the *sole issue* before the Board” is whether Opposer’s rights are prior to “*the filing date of the . . . application . . . July 23, 1999.*” (Stipulation as to Facts and Agreement to Submit Opposer’s Testimony by Affidavit, dated and filed July 1, 2008, TTABVUE # 41 at 1) (emphasis added). Third, this very issue has been litigated and the courts have found that no such common law rights exist. *Creative Arts by Calloway, LLC v. Brooks*, No. 02-7050 2002 WL 31303241, at *2 (2d Cir. Oct. 11, 2002) (Opp. Tr. Br., App. A).

Accordingly, judgment should be entered in Opposer’s favor, and the Application must be refused registration under Section 2(d) of the Lanham Act, 15 U.S.C. § 1052(d).

II. APPLICANT’S OBJECTIONS TO OPPOSER’S EVIDENCE

In an Addendum to its brief (App. Tr. Br. at 29-30), Applicant has objected to the introduction into evidence of certain exhibits to (i) Opposer’s Affidavit of Christopher Brooks (TTABVUE #41, at 8-95) and (ii) Opposer’s Notice of Reliance (“Opp. Notice”) (TTABVUE #38, at 1-93). Applicant is prohibited from objecting to any of the exhibits to the Affidavit of Mr. Brooks, given its stipulation “to the admission into evidence *without objection* of [that] affidavit . . . *and the exhibits thereto*, as part of Opposer’s testimony in these proceedings.” (Stipulation as to Facts and Agreement to Submit Opposer’s Testimony by Affidavit, dated and filed July 1, 2008, TTABVUE # 41, at 1.) As for Exhibits 3-11 to Opposer’s Notice of Reliance,

¹ *E.g., Hydro-Dynamics, Inc. v. George Putnam & Co.*, 1 U.S.P.Q.2d 1772, 1773-74 (Fed. Cir. 1987); *see also Elder Mfg. Co. v. Int’l Shoe Co.*, 92 U.S.P.Q. 330, 332 (C.C.P.A. 1952) (such evidence of priority “should not be characterized by contradictions, inconsistencies, and indefiniteness, but should carry with it conviction of its accuracy and applicability”).

which Applicant claims are “not relevant to Opposer’s Section 2(d) opposition based on his pre-July 23, 1999 activities,” (App. Tr. Br. at 29), these exhibits provide, among other things, evidence of Opposer’s continuous and unbroken use of his mark THE CAB CALLOWAY ORCHESTRA in connection with his goods and services from the time of his first use to the present, which is entirely relevant to this proceeding. *See, e.g.*, 15 U.S.C. § 1052(d) (trademark shall be refused registration if it “so resembles . . . a mark or trade name previously used . . . and not abandoned”). As for Exhibits 14 and 15, which Applicant claims are “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” (App. Tr. Br. at 30), Applicant offers no reason why this is a meaningful distinction. Indeed, these exhibits are relevant, as they provide evidence of the distinctiveness of marks that include both the name of a famous historical band leader and the word ORCHESTRA, and the Board expressly permits the introduction of such third-party registrations and their file histories. *See* TBMP § 704.03(b)(1)(B). Accordingly, none of Applicant’s objections are well-taken.

III. ARGUMENT

A. **Opposer Does Not Have to Show Secondary Meaning to Prove His Rights in THE CAB CALLOWAY ORCHESTRA**

Applicant’s brief starts from the unsupported legal argument that to prevail Opposer must show that THE CAB CALLOWAY ORCHESTRA obtained “the requisite secondary meaning as of July 23, 1999.” (*E.g.*, App. Tr. Br. at 13.) In making this claim, Applicant first conveniently ignores the fact that Opposer’s mark is THE CAB CALLOWAY ORCHESTRA, not CAB CALLOWAY, as Applicant repeatedly suggests. (*E.g.*, App. Tr. Br. at 2, 20, 22.) Applicant then compounds its error by ignoring well-settled case law establishing that Opposer’s entire

composite mark is inherently distinctive (*see* Opposer’s January 16, 2009 Trial Brief (“Opp. Tr. Br.”) at 18-21), and therefore that his priority is established by his common law use.

Further, Applicant wholly ignores the facts and law that even if Opposer did not have common law trademark or service mark rights in his mark THE CAB CALLOWAY ORCHESTRA as of July 23, 1999, he has proven sufficient prior trade name use and use analogous to trademark use to prevail. (*See* Opp. Tr. Br. at 21-24.)

1. The Mark THE CAB CALLOWAY ORCHESTRA is Inherently Distinctive

Applicant’s entire argument on distinctiveness is premised on its false claim that Opposer’s mark is CAB CALLOWAY. From this erroneous foundation, Applicant argues that CAB CALLOWAY, not THE CAB CALLOWAY ORCHESTRA, “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.” (App. Tr. Br. at 2.) Applicant’s legal argument proceeds from the same foundation, as does its conclusion that for Opposer to prevail he must prove that the name “Cab Calloway” has acquired secondary meaning. (*Id.* at 16-22). Leaving aside that this is an admission that Applicant’s own applied-for mark, CAB CALLOWAY, is not registrable on an intent-to-use basis as it lacks evidence of secondary meaning, Applicant’s argument intentionally and deceptively misstates what is at issue in this opposition. Opposer is not claiming rights in CAB CALLOWAY as a mark. Rather, as Applicant well knows, Opposer claims rights in THE CAB CALLOWAY ORCHESTRA as a mark as used in connection with his *own* goods and services and *not* to refer, as Applicant itself apparently does, to Cab Calloway’s recordings or performances. Applicant points to no law and no case holding that such a composite mark can be protected only on a showing of secondary meaning. Indeed, the case law,

unrefuted and undistinguished by Applicant, holds that such a mark is inherently distinctive.

(See Opp. Tr. Br. at 18-21.)

While Applicant claims that Opposer's "only cognizable authority" for asserting inherent distinctiveness is *Michael Sachs, Inc. v. Cordon Art B.V.* (App. Tr. Br. at 16), in fact, in its brief Opposer cited to a variety of cases and other authorities in support of five interrelated and unchallenged propositions: (i) the PTO allowed Applicant's application for the wholly personal name CAB CALLOWAY to proceed to registration on an intent-to-use basis without requiring proof of secondary meaning (Opp. Tr. Br. at 18); (ii) the Board repeatedly has held that a personal name mark that is not merely a surname is inherently distinctive (*id.* at 19-20); (iii) a historical name is considered to be inherently distinctive (*id.* at 20); (iv) Opposer's mark THE CAB CALLOWAY ORCHESTRA must be considered in its entirety (*id.* at 20-21); and (v) the PTO has registered very similar marks, such as COUNT BASIE ORCHESTRA and TOMMY DORSEY ORCHESTRA, without requiring any proof of secondary meaning (*id.* at 21 n.5).

While Applicant claims that Opposer's citation to non-precedential cases is "[i]n flagrant disregard of stated Board practice" (App. Tr. Br. at 18-19), it seems unaware that, as Opposer noted in his trial brief (Opp. Tr. Br. at 20, n.4) the Board now permits citation of such cases for "whatever persuasive value [they] might have." (USPTO 1/23/07 Official Gazette Notice.)

Applicant's rejoinder to Opposer's five arguments lacks both substance and credibility. To avoid having point (i) used to deny its own Application, which was filed without evidence of secondary meaning, Applicant suggests that personal names can be registered without secondary meaning but cannot be the basis of an opposition absent secondary meaning. (App. Tr. Br. at 19.) Applicant offers to authority for this claim, however, and it is directly contradicted by *Remos v. Feierman*, Opp. No. 114,000, 2001 WL 388787, at *7 (T.T.A.B. Apr. 7, 2001) (non-precedential)

("[w]e see no logical basis for holding that a personal name mark which is inherently distinctive for registration purposes must nonetheless be shown to have acquired secondary meaning before it can be relied upon by an opposer in an opposition proceeding").

As for point (ii), Applicant's sole rebuttal is its claim that certain arguments Opposer made in the parties' prior litigation before the federal courts concerning *Applicant's* claim of rights to CAB CALLOWAY as a mark somehow judicially estops Opposer from arguing that his mark THE CAB CALLOWAY ORCHESTRA for an orchestra that does not include the deceased Mr. Calloway, and that plays music by various composers (*e.g.*, Brooks Aff. ¶ 5, *see also id.*, Ex. 1 at 38 (selected repertoire)) is inherently distinctive. (App. Tr. Br. at 6-8, 19.) Opposer already has explained in his trial brief that those prior statements are inadmissible in this opposition. (Opp. Tr. Br. at 8-9.) Applicant has failed to address these evidentiary issues.

Even if the statements were admissible, they would not give rise to judicial estoppel. For judicial estoppel to apply Opposer must have adopted a position in this action inconsistent with his position in the prior litigation. (*See* App. Tr. Br. at 7-8.) But where is the inconsistency? In the prior federal action between the parties Opposer argued that Applicant's or its predecessors' use of CAB CALLOWAY *to refer to the individual Cab Calloway or his works* did not create protectable rights *under the law of the Second Circuit* without a showing of secondary meaning. (Opp. Tr. Br. at 19 n.3.) The argument has nothing to do with the claim Opposer asserts here – that his mark THE CAB CALLOWAY ORCHESTRA used in connection with Opposer's own goods and services is inherently distinctive. The positions taken by Opposer relate to two different marks used by two different entities for two different purposes. The determination by the federal court that Applicant had no trademark rights in the name Cab Calloway is not and

would not be inconsistent with the Board's determination that Opposer has rights in THE CAB CALLOWAY ORCHESTRA for his own goods and services.

Applicant essentially leaves unchallenged point (iii), that historical names used as marks generally do not require a showing of secondary meaning. Instead, Applicant claims that this rule does not apply here because Opposer's mark describes "the quality and character of his services." (App. Tr. Br. at 21.) Yet Opposer's mark does not merely describe Opposer (who is not named Cab Calloway), his band (which does not include Cab Calloway, who has been dead for fifteen years), or the music of Opposer's orchestra (which is not limited to the music of Cab Calloway). At most, the mark suggests a "legacy band" that plays various music *as a tribute to* Cab Calloway. (See Opp. Mem. at 21.) Accordingly, the general rules about historic name marks applies here, and affords protection to Opposer's mark without evidence of secondary meaning.

Also left unchallenged by Applicant is point (iv), the long-standing rule that "a composite mark is tested for its validity and distinctiveness by looking at it as a whole, rather than dissecting it into its component parts." *E.g.*, 2 J. Thomas McCarthy, *McCarthy on Trademarks & Unfair Competition* § 11.27 (4th ed. 2008), at 11-69. While Applicant has chosen to chop off those parts of Opposer's mark it finds inconvenient, and to focus its argument on a mark that Opposer is not using, the fact that Opposer's mark is THE CAB CALLOWAY ORCHESTRA, and *not* CAB CALLOWAY by itself, cannot be ignored.²

² While Applicant correctly notes (App. Tr. Br. at 14) that the parties have stipulated that the marks THE CAB CALLOWAY ORCHESTRA and CAB CALLOWAY are "nearly identical in appearance, sound, connotation, and commercial impression," (Stip. of Facts ¶ 11), this is for purposes of addressing likelihood of confusion, and is not a concession that Opposer's composite mark and Applicant's shorter mark are identical or equally distinctive.

Finally, on the issue of prior similar marks that proceeded to registration without proof of secondary meaning, point (v), Applicant cannot dispute the records of the Patent & Trademark Office, so instead argues that “Opposer receives no benefit from the registration documents of other entities.” (App. Tr. Br. at 20.) While it is true that third-party registrations are not *conclusive* on the issue of distinctiveness since “[t]he Board must decide each case on its own merits,” *e.g.*, *In re Nett Designs, Inc.*, 57 U.S.P.Q.2d 1564, 1566 (Fed. Cir. 2001), the Board may consider the fact that, as noted in Opposer’s trial brief, both COUNT BASIE ORCHESTRA and TOMMY DORSEY ORCHESTRA were registered for similar goods and services without proof of secondary meaning. (Opp. Tr. Br. at 21 n.5.) *See also* TBMP § 704.03(b)(1)(B) (admission into evidence of third-party registration). There is no reason, and certainly Applicant has supplied none, for the Board to treat Opposer’s mark THE CAB CALLOWAY ORCHESTRA differently.

In sum, Applicant has offered no fact or argument on the issue in this case: whether THE CAB CALLOWAY ORCHESTRA mark is inherently distinctive. Under all applicable law, it is.

2. Opposer Has Shown Trade Name Rights and Analogous Use Rights in THE CAB CALLOWAY ORCHESTRA

Of course, as previously discussed (Opp. Tr. Br. at 15, 21-24), to prevail Opposer does not need to show prior trademark or service mark rights in THE CAB CALLOWAY ORCHESTRA. As an alternative, he may show “proprietary rights aris[ing] from . . . prior use as a trade name, prior use analogous to trademark or service mark use, or any other use sufficient to establish proprietary rights.” *E.g.*, *Herbko International, Inc. v. Kappa Books, Inc.*, 64 U.S.P.Q.2d 1375, 1378 (Fed. Cir. 2002); TMBP § 309.03(c)(A). Here, despite Applicant’s claims to the contrary, he has done so.

a. Trade Name Rights

On the issue of trade name use, Applicant offers nothing in response to Opposer's original argument (Opp. Tr. Br. at 22-23) except the conclusory statement, made without benefit of legal authority, that three contracts Opposer provided as evidence of such use are not "unequivocal evidence" that "he used the name THE CAB CALLOWAY ORCHESTRA in a manner which identified his services to the public." (App. Tr. Br. at 23.) Applicant fails to explain why, in the absence of any evidence to the contrary, these three contracts for performances by THE CAB CALLOWAY ORCHESTRA (*see* Opp. Tr. Br. at 22-23) do *not* serve as unequivocal evidence of such use, nor does applicant address the *other* evidence Opposer provided of his trade name use – including his sworn affidavit and the declarations of his witnesses (which, among other things, attested to Opposer's early performances under the name THE CAB CALLOWAY ORCHESTRA), as well as two bills Opposer received that were addressed to "Chris Brooks, Cab Calloway Orchestra." (*See id.*)

As Opposer noted in his trial brief (at 22-23),

[n]othing more than trade name use is required to bar the registration of a mark. . . . To establish trade name use, an organization need only to have used a name. . . . in a manner that identifies the company by that name. . . . to the public. . . . no particular formality of adoption or display is necessary to establish trade name identification.

West Florida Seafood Inc. v. Jet Restaurants Inc., 31 U.S.P.Q.2d 1660, 1665 (Fed. Cir. 1994)

(citations and internal quotation marks omitted). Moreover, to serve as a bar to registration, a trade name need *not* be inherently distinctive, nor must it have acquired any secondary meaning. *E.g.*, *Alfred Electronics v. Alford Mfg. Co.*, 142 U.S.P.Q. 168, 172 (C.C.P.A. 1964). Here, not only did Opposer publicly use the trade name THE CAB CALLOWAY ORCHESTRA, including in fully-executed contracts for the services of his Orchestra (*see* Opp. Tr. Br. at 23-24) – the

public used that trade name as well, including in bills Opposer received (*id.* (noting bills addressed to “Chris Brooks, Cab Calloway Orchestra”)), all before July 23, 1999. Applicant offers no evidence to overcome this showing of prior trade name rights, a showing that mandates judgment in favor of Opposer.

b. Analogous Use Rights

Applicant completely misapprehends Opposer’s “prior use analogous to trademark or service mark use” argument (Opp. Tr. Br. at 23-24), believing that it is based on Opposer’s contacts for services, sales of CDs and videotapes, and distribution of a press packet. (App. Tr. Br. at 22.) These uses establish trademark rights. Opposer’s analogous use rights, on the other hand, are based on his use of THE CAB CALLOWAY ORCHESTRA in advertising materials and on recordings designed to promote Opposer’s services and to create a public identification between Opposer and the mark THE CAB CALLOWAY ORCHESTRA. *E.g., T.A.B. Sys. v. Pactel Teletrac*, 37 U.S.P.Q.2d 1879, 1881 (Fed. Cir. 1996) (“the fact finder may infer the fact of identification on the basis of indirect evidence regarding the opposer’s use of the word or phrase in advertising brochures, catalogs, newspaper ads, and articles in newspapers and trade publications”). Again, Applicant has offered no evidence that Opposer’s cited advertising or promotional uses did not occur and did not create the requisite public identification as of July 23, 1999.

B. Opposer Has Proven the Priority of His Rights in THE CAB CALLOWAY ORCHESTRA

1. Opposer Has Proven His Priority

Bafflingly, while Applicant accepts and acknowledges Opposer’s evidence of pre-July 23, 1999 activities under the mark THE CAB CALLOWAY ORCHESTRA, and even admitted in its summary judgment papers in this action that Opposer had used THE CAB CALLOWAY

ORCHESTRA mark in connection with CDs and videos prior to the Application filing date (Opp. Notice, Ex. 12 at ¶¶ 9-11), it still argues that this undisputed use is insufficient to meet Opposer's burden of proof. (*E.g.*, App. Tr. Br. at 4-5.)

Applicant's claim of insufficiency appears to be premised on the false assumption that Opposer was obligated to show secondary meaning in THE CAB CALLOWAY ORCHESTRA in order to prove his rights in that mark. As set forth in Section (A) above and Opposer's trial brief, this is incorrect. This undisputed record of use of THE CAB CALLOWAY ORCHESTRA as a trademark and service mark, trade name, and in a manner analogous to trademark use prior to July 23, 1999, Applicant's intent-to-use application filing date, more than meets Opposer's burden of proof and is sufficient for Opposer to prevail. *See, e.g.*, 15 U.S.C. § 1052(d) (trademark shall be refused registration if it "so resembles . . . a mark or trade name previously used in the United States by another and not abandoned . . ."); *see also, e.g., Menashe v. V Secret Catalogue, Inc.*, 409 F. Supp. 2d 412, 424 (S.D.N.Y. 2006) (where party has made *bona fide* use of mark in commerce, even a "single use suffices to prove priority if the proponent demonstrates that his subsequent use was 'deliberate and continuous,'" and "[t]he later filing of an ITU application by another party does not defeat these use-based rights").

2. Applicant May Not "Tack On" Alleged Earlier Common Law Use

a. Applicant Has Stipulated to Its Priority Date, July 23, 1999

In a last-ditch effort to avoid defeat, Applicant now claims – without benefit of any evidence – that it may "'tack on' prior use of the common law trademark CAB CALLOWAY which predates Opposer's alleged date of first use, December 1998." (App. Tr. Br. at 1, 9, 25.) Leaving aside both the lack of evidence in the record of such common law use and the issue of unfair surprise to Opposer (by raising this issue without identifying it during its testimony

period, thereby preventing Opposer from being able to take testimony or offer rebuttal evidence), having stipulated that “the sole issue before the Board” in this opposition is whether Opposer’s rights are prior to “the filing date of the . . . application . . . July 23, 1999” (Stipulation as to Facts and Agreement to Submit Opposer’s Testimony by Affidavit, dated and filed July 1, 2008, TTABVUE # 41 at 1), Applicant may not now renege on its word and undo that stipulation.

To simplify matters and save both time and expense, parties litigating an opposition not only may stipulate to some or all of the facts at issue, *e.g.*, 37 C.F.R. § 2.123(b) (“the facts in the case of any party may be stipulated in writing”), they are encouraged to do so. *E.g.*, *Target Brands, Inc. v. Hughes*, 85 U.S.P.Q.2d 1676, 1678 (T.T.A.B. 2007) (noting with approval parties’ stipulation to “the entire record in this case” “in light of the savings in time and expense for the parties as well as the judicial economy afforded the Board thereby”). Here, the parties have entered just such a stipulation, submitted to the Board, *see* TBMP § 501.02 (“even in the case of a stipulation that does not have to be filed, the better practice is to reduce the stipulation to writing, in order to avoid any misunderstanding between the parties as to the existence and terms thereof”), confirming that the *only* priority date Applicant can assert is July 23, 1999. Regardless of whether, in light of the extensive evidence of prior use Opposer has introduced into the record, Applicant now regrets its decision to do so, it cannot ignore that stipulation.

b. Even If It Had Not Stipulated to Its Priority Date, Applicant is Barred by Collateral Estoppel

Even if the parties had not entered into a formal stipulation that prohibits Applicant from asserting a priority date before July 23, 1999, Applicant is barred from asserting prior common law rights in CAB CALLOWAY by the doctrine of collateral estoppel.

As the Federal Circuit has noted, “issues which are actually and necessarily determined by a court of competent jurisdiction are conclusive in a subsequent suit involving the parties to

the prior litigation.” *Mother’s Restaurant Inc. v. Mama’s Pizza, Inc.*, 221 U.S.P.Q. 394, 397 (Fed. Cir. 1983). For collateral estoppel to apply (1) the issue must be identical to one decided in the first action, (2) the issue must have been litigated in the first action, (3) the resolution of the issue must have been essential to a final judgment in the first action, and (4) the party to be precluded must have had a full and fair opportunity to litigate the issue in the first action. *Shell Petroleum, Inc. v. United States*, 319 F.3d 1334, 1338 (Fed. Cir. 2003); see *Mother’s Restaurant*, 221 U.S.P.Q. at 397-99.

Here, in a prior trademark infringement lawsuit brought by Applicant against Opposer, Applicant claimed prior rights in the mark CAB CALLOWAY based on a testamentary transfer from Cab Calloway to Applicant’s predecessor. *Creative Arts by Calloway*, 2002 WL 31303241, at *1 (Opp. Tr. Br., App. A.) The U.S. Court of Appeals for the Second Circuit, in a decision Applicant asks the Board to rely on (App. Tr. Br. at 8), held that “any trademark assignment to [Applicant’s predecessor] would have been invalid.” *Creative Arts by Calloway*, 2002 WL 31303241, at *2 (Opp. Tr. Br., App. A.) Among the reasons given were that at the time of his death Cab Calloway was not operating a going concern whose goodwill could be transferred, that Cab Calloway’s activities were not organized as a business that could have been transferred, and that the name itself did not distinguish goods or services exclusively from a single source, as various record companies own the rights to the masters of Cab Calloway’s songs, and Applicant owned no rights to any of Cab Calloway’s public appearances. (*Id.* at *1-2.) This determination, fully litigated by Applicant, was fundamental to the final judgment issued by the court. Yet now Applicant is seeking to have the Board essentially reverse the prior determination by the Court of Appeals and to hold that Applicant is the owner of the CAB CALLOWAY trademark for sound recordings because rights in that mark were transferred from Cab Calloway to Zulme Calloway,

and then from Zulme Calloway to Applicant. (App. Tr. Br. at 11-12, 24-27.) While Applicant now contends that the Court's decision was limited to *service mark* rights (App. Tr. Br. at 11, n.2), the language of the Second Circuit, noted above, is not so limited. According to the Court, no assignment of rights occurred from Cab Calloway to Applicant's predecessor.

Accordingly, Applicant is precluded from challenging the finding of the U.S. Court of Appeals for the Second Circuit that Applicant did *not* acquire from Cab Calloway any common law rights in the mark CAB CALLOWAY, whether for "sound recordings" or any other goods or services. *E.g.*, *Shell Petroleum*, 319 F.3d at 1338; *Mother's Restaurant*, 221 U.S.P.Q. at 397-99.

**c. Even If It Had Not Stipulated to Its Priority Date
and Was Not Barred by Collateral Estoppel, Applicant
Has Not Offered Clear and Convincing Evidence of Prior Use**

Moreover, Applicant has not offered evidence sufficient to prove the prior common law use it now claims. As the Board has noted, when a party claims a first use date earlier than that set forth in its application it must prove that earlier date by *clear and convincing* evidence, *e.g.*, *Hydro-Dynamics*, 1 U.S.P.Q.2d at 1773-74, which "should not be characterized by contradictions, inconsistencies, and indefiniteness, but should carry with it conviction of its accuracy and applicability." *Elder Mfg.*, 92 U.S.P.Q. at 332. Here, Applicant has not met that standard.

Applicant appears to claim what it variously – and vaguely – describes as common law rights in the CAB CALLOWAY trademark and/or service mark that Cab Calloway owned and that were assigned by will to Applicant's predecessor. (App. Tr. Br. at 9, 11-12, 24-25.) Yet there is not one iota of evidence that such rights existed. Applicant's only evidence of its alleged ownership of these rights (*see id.* at 8) appears to be an earlier declaration – without exhibits – of its principal Cabella Langsam (which Opposer, not Applicant, included with his *own* Notice of

Reliance solely to show an admission against interest by Applicant). (Opp. Notice, Ex. 13.) For example, while Applicant claims that “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” (App. Tr. Br. at 12, 25), it offers no evidence that Mr. Calloway, or Applicant’s predecessor Zulme Calloway, or Applicant itself, owns the rights to those recordings, exercises any sort of control over those recordings, or that CAB CALLOWAY is used on those recordings in any sense other than to identify the artist. Indeed, the U.S. Court of Appeals for the Second Circuit once again found to the contrary, noting that “it is *undisputed* [by Applicant and Opposer] that various record companies” – *not* Applicant or its predecessors – “own the rights to the masters of Cab Calloway’s songs.” *Creative Arts by Calloway*, 2002 WL 31303241, at *2 (Opp. Tr. Br., App. A at 2) (emphasis added). Thus, other than conjecture, the “evidence” proffered is inconsistent with the findings of the federal court.

In sum, not only has Applicant not introduced “clear and convincing” evidence, not “characterized by contradictions, inconsistencies, or indefiniteness,” of its alleged prior common law trademark use of CAB CALLOWAY (*e.g.*, agreements showing Cab Calloway’s control over the use of the mark, evidence that CAB CALLOWAY functioned as a mark, specimens showing Applicant’s or Cab Calloway’s use of CAB CALLOWAY as a mark in connection with *any* goods or services at *any* time, evidence of the secondary meaning Applicant claims is necessary) – the little evidence it has cited, and in particular the decision of the Second Circuit, actually shows that it received no prior rights on which it can rely to claim a priority date earlier than its stipulated intent-to-use application date.

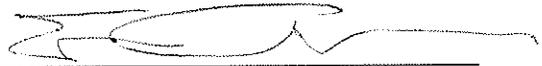
CONCLUSION

For the reasons set forth above and in Opposer's prior brief and supporting materials, Opposer respectfully requests that the Board sustain the Opposition and refuse registration of Application Serial No. 75/761,159 for Applicant's mark CAB CALLOWAY under Section 2(d) of the Lanham Act.

Dated: New York, New York
March 2, 2009

Respectfully submitted,

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CERTIFICATE OF SERVICE

I hereby certify that a true and correct copy of the **REPLY TRIAL BRIEF FOR OPPOSER** was served by first class, US postage prepaid and placed in a official depository under exclusive care and custody of the United States Postal Service within the State of New York upon:

Marc A. Karlin, Esq.
Karlin & Karlin, APLC
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on this 2ND day of March 2009.


MARIO ORTIZ