

ESTTA Tracking number: **ESTTA288072**

Filing date: **06/04/2009**

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

Proceeding	91180232
Party	Plaintiff NKOTB, Inc.
Correspondence Address	Peter D. Rosenthal, Esq. Roberts Ritholz Levy Sanders Chidekel & Fields LLP 235 Park Avenue South, 3rd Floor New York, NY 10003 UNITED STATES prosenthal@robritlew.com
Submission	Other Motions/Papers
Filer's Name	Peter D. Rosenthal
Filer's e-mail	prosenthal@robritlew.com,
Signature	/Peter D. Rosenthal/
Date	06/04/2009
Attachments	Memorandum of Law in Response to OSC 6-4-09.pdf ( 16 pages )(722699 bytes )



attached hereto as Exhibit A (“Rosenthal Dec.”), and all exhibits annexed thereto, and all other pleadings, documents and proceedings submitted or taken in this matter, Opposer respectfully requests that the Board: (i) find good cause that this proceeding remain open for decision on the merits; and (ii) so order the Stipulation and adopt the trial briefing schedule set forth therein (the “Modified Trial Schedule”).

Opposer has contemporaneously filed the Stipulation with the Board. The Stipulation, which is consented to by both parties, requests the reopening of, and sets forth proposed closing dates for, each testimony period for the Board’s approval.

The Board should find cause to proceed with the opposition on the Modified Trial Schedule set forth in the Stipulation. Opposer has not lost interest in its opposition. There is no dispute that neither party will be prejudiced if the Board keeps the proceeding open and adopts the Modified Trial Schedule, as both parties have consented to such action. It is also clear that any defect in the parties’ compliance with the Board’s initial trial schedule (the “Initial Schedule”) is the result of excusable neglect. The Initial Schedule contains an apparent typographical error, in that it does not state a time period for the closing of plaintiff’s (Opposer’s) testimony period, and could not, by its terms, provide for the complete adjudication of the Opposition. Finally, as the opposition raises a number of meritorious bases for the Board to dismiss the ‘224 application that are supported by incontrovertible facts, the interests of justice compel the Board to grant the relief requested.

## **BACKGROUND**

More than twenty years ago, five young musical artists – Jonathan Knight, Jordan Knight,

Joey McIntyre, Danny Wood and Donnie Wahlberg (collectively the "Group") - began recording, performing, promoting and otherwise commercially exploiting their musical performances and recordings in the United States and worldwide under the mark NEW KIDS ON THE BLOCK (the "Mark"). Notice of Opposition ("Opp."), ¶ 1. The Group developed into a musical phenomenon and one of the most successful entertainment groups in the world. The Group has sold tens of millions of records and CDs under the Mark, its concerts have been performed under the Mark in front of millions of fans in the United States and worldwide, and tens of millions of Dollars of merchandise bearing the Mark have been and continue to be sold under the Opposer's authority and control. Numerous television appearances over that same 20 year period have bolstered the fame and name recognition of the Group and the Mark to millions around the globe. *Id.*

The NEW KIDS ON THE BLOCK Mark became and still is known worldwide as the name of the Group. Opposer is the Group's current corporate operating entity with exclusive rights in the NEW KIDS ON THE BLOCK Mark. Opp., ¶ 5. As a result of the Group's and Opposer's considerable investment of energy, time and money, the NEW KIDS ON THE BLOCK Mark has become famous, acquired substantial goodwill and become an extremely valuable proprietary right of Opposer. Opp., ¶ 6.

### **PROCEDURAL HISTORY**

The instant opposition proceeding commenced with a notice of opposition, filed by Opposer on October 23, 2007, against Applicant's trademark application, serial no. 78/697,224 ("the '224 application") for the identical mark NEW KIDS ON THE BLOCK for "series of

musical sound recordings" and "entertainment in the nature of on-going television programs in the field of music and variety; entertainment services, namely, providing a television program in the field of music and variety via a global computer network; entertainment, namely live performances by musical bands."

Opposer asserts the following grounds for opposition: (1) a likelihood of confusion under Section 2(d) of the Lanham Act, 15 U.S.C. §1052(d); (2) dilution under Section 43(c) of the Lanham Act, 15 U.S.C. §1125(c); (3) deception in falsely suggesting a connection with Opposer under Section 2(a) of the Lanham Act, 15 U.S.C. §1052(a); and (4) fraud in the '224 application.

Applicant failed to file an answer.

On December 21, 2007, the Board issued a notice of default and ordered Applicant to show cause why a default judgment should not be entered against it.

On January 18, 2008, Applicant filed a response to the order to show cause and an answer to the notice of opposition.

The Board vacated the notice of default on January 31, 2008.

On March 27, 2008, Applicant's former attorney filed a request to withdraw as attorney.

On April 14, 2008, the Board granted the request to withdraw, suspended the proceedings and ordered Applicant to appoint new counsel or to file a paper stating that Applicant chose to represent itself. Applicant notified the Board that it chose to represent itself.

On May 14, 2008, the Board issued a scheduling order (the "Initial Scheduling Order") which reset the dates in the opposition and stated:

"In view thereof, proceedings herein are resumed and discovery and trial dates are reset as indicated below:

DISCOVERY PERIOD TO CLOSE: August 11, 2008

30-day testimony period for party  
in position of defendant to close: November 9, 2008

30-day testimony period for party  
in position of defendant to close: January 8, 2009

15-day rebuttal testimony period  
to close: February 22, 2009"

The scheduling order of May 14, 2008 did not establish a "30-day testimony period for party in position of **plaintiff** to close."

### ARGUMENT

**Because: (i) No Party Will Be Prejudiced By Adoption Of The Modified Trial Schedule; (ii) Inactivity In The Proceeding Is The Result Of Excusable Neglect; And (iii) The Interests Of Justice Compel Resolving This Matter On The Merits; The Board Should Find Good Cause Not To Dismiss The Opposition**

This matter should be decided on its merits. "The courts and the Board are reluctant to grant judgments by default and tend to resolve doubt in favor of setting aside a default, since the law favors deciding cases on their merits." *Paolo's Assoc. L.P. v. Paolo Bodo*, 21 U.S.P.Q.2d 1899 (Comm'r 1990). It has historically been the Board's policy to decide cases on the merits, rather than on a technicality, whenever possible. *Thrifty Corp. v. Bomax Enterprises*, 228 U.S.P.Q. 62 (T.T.A.B. 1985).<sup>1</sup>

As set forth in TBMP § 801.02, "it is the policy of the Board not to enter judgment against a plaintiff, for failure to file a main brief in the case, where the plaintiff, in its response to

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<sup>1</sup> Indeed, the Board has already applied this policy in this matter, in Applicant's favor, by setting aside the notice of default previously issued against Applicant and thereby providing Applicant a second chance to file an answer. See, January 31, 2008 Board Notice. It would be manifestly unjust not to accord the same latitude to Opposer as it has to Applicant.

the show cause order, indicates that it has not lost interest in the case."

NKOTB has not lost interest in this opposition, as acknowledged by Applicant. *See*, Stipulation, ¶ 1. NKOTB has been diligently attempting to settle the opposition in a manner that avoids testimony and trials, but, to date, the parties have been unable to consummate a settlement. Rosenthal Dec., ¶¶ 8,9. Rather, Opposer relied on the Initial Scheduling Order in calendaring this matter. As the Initial Scheduling Order did not state a closing date for plaintiff's (Opposer's) testimony period, no such entry was made. Critically, Opposer has otherwise complied with the Board's orders and rules in all respects, and if the parties are unsuccessful in reaching a settlement, Opposer will adhere strictly to the Modified Trial Schedule.

NKOTB did not intentionally fail to file its trial brief.

**The Stipulation, Excusable Neglect and Lack of Prejudice  
Warrant Keeping The Opposition Open**

Because both parties have consented to the Modified Trial Schedule, granting the requested relief will not prejudice the Applicant.

TBMP § 509.02, in part, provides:

"If a motion to extend or a motion to reopen is made with the consent of the nonmoving party, the motion may be filed either as a stipulation with the signature of both parties, or as a consented motion in which the moving party states that the nonmoving party has given its oral consent thereto. **Ordinarily, a consented motion to extend or reopen will be granted by the Board.**" (Emphasis added).

Thus, the Stipulation alone warrants granting the parties' request to reopen the testimony periods and to reset the trial briefing schedule. *See, Stiefel Laboratories, Inc. v. Vetgen, L.L.C.*, 2000 WL 158731 \* 9, n. 4 (T.T.A.B. February 11, 2000)(reference to granting stipulation to reopen testimony periods)(not citable as precedent); *see also, Miss World (Jersey) Ltd. v. R&D*

*Promotions, Inc.*, 2004 WL 2032253 \*2 (T.T.A.B. September 8, 2004)(granting uncontested motion to reopen discovery period) (not citable as precedent). This is the first request of this kind by either party.

A testimony period may be reopened upon a showing of excusable neglect. *See* Fed. R. Civ. P. 6(b)(2); TBMP §509.01. A determination of excusable neglect is an equitable determination that must take account of all relevant circumstances surrounding the party's omission. Relevant factors in this determination include (1) the danger of prejudice to the non-movant, (2) the length of the delay and its potential impact on judicial proceedings, (3) the reason for the delay, and (4) whether the movant acted in good faith. *Pioneer Investment Services Co. v. Bunswich Associates Ltd. Partnership*, 507 U.S. 380 (1993); *Pumpkin Ltd. v. The Seed Corps*, 43 U.S.P.Q.2d 1582 (TTAB 1997).

**(1) Applicant Has Stipulated to Reopening Testimony Periods**

Because Applicant has joined with Opposer in requesting approval of the Modified Trial Schedule, it is clear that Applicant will not be prejudiced. Reopening the testimony period would also be helpful to Applicant, as it has not taken any trial testimony. Thus, there is no danger of prejudice to Applicant.

In contrast, Opposer would be prejudiced if denied the opportunity to present its case. NKOTB has brought this opposition to protect its famous NEW KIDS ON THE BLOCK Mark, and as set forth in the Notice of Opposition, there are numerous meritorious bases supporting the opposition.

**(2) Opposer's Delay Was Attributed to Reliance on the Initial Scheduling Order**

The concept of excusable neglect is an "elastic concept," not strictly limited to omissions caused by circumstances beyond the control of the moving party. *Pumpkin Ltd. v. The Seed Corps.*, 43 U.S.P.Q.2d 1582 (T.T.A.B. 1997). The Board must determine whether the party seeking to reopen the time for taking an action has acted reasonably, i.e., in a manner which, while technically improper, is nonetheless excusable.

Opposer has not previously taken testimony, filed a trial brief or requested a modification to the Initial Scheduling Order because the Initial Scheduling Order did not specify a closing date for Opposer's testimony period. Opposer's conduct is not the result of willful misconduct or gross neglect, but instead resulted from mechanical reliance on the Initial Scheduling Order. Rosenthal Dec., ¶¶ 5,6.

**(3) Reopening the Testimony Periods Will Not Substantially Impact The Proceeding**

The reopening of the testimony periods will not have any significant impact on the timing of this opposition. The parties had never previously requested an extension of the discovery period or of the testimony periods. The opposition is less than two years old and if the Board approves the Modified Trial Schedule, this proceeding will almost certainly be completed in less than three years. *Cf.* John M. Murphy, "Playing the Numbers: A Quantitative Look at Section 2(d) Cases Before the Trademark Trial and Appeal Board", Trademark Reporter, 94 TMR 800 (2004) (reporting 60% of TTAB cases taking more than three years to reach resolution and 22% taking more than four).

The accompanying stipulation also requests that the Board suspend the opposition for

thirty (30) days from the date of the order granting the request so that the parties can continue to work on possible settlement. Thus, the suspension may obviate the need to take testimony and/or file trial briefs, in which case the proceeding will conclude even more quickly.

**(4) NKOTB Has Acted In Good Faith**

Opposer has made no prior request for any extension of any period. *See, e.g., American Vitamin Products Inc. v. Dow Brands Inc.*, 22 USPQ2d 1313 (TTAB 1992). Opposer expeditiously acted after receiving the Order to Show Cause by timely responding thereto. Opposer immediately contacted Applicant regarding the Stipulation, prepared the Stipulation for Applicant's review and signature and contemporaneously filed the same herewith.

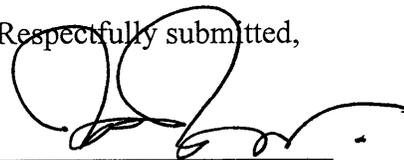
There is nothing in the record that would indicate any bad faith attempt by Opposer to delay this proceeding.

**CONCLUSION**

For the reasons stated above, Opposer respectfully requests that a judgment not be entered against it in this opposition, and that the testimony periods in this proceeding be reopened, and the trial schedule be reset, pursuant to the Stipulation.

Dated: June 4, 2009

Respectfully submitted,



Peter D. Rosenthal  
Roberts Ritholz Levy Sanders  
Chidekel & Fields LLP  
235 Park Avenue South, 3rd Floor  
New York, NY 10003  
(212) 448-1800  
Attorney for Opposer  
NKOTB, Inc.

**EXHIBIT A**

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

In the matter of USPTO Application Serial No. 78697224  
For the mark NEW KIDS ON THE BLOCK  
Published in the Official Gazette on June 26, 2007

NKOTB, Inc. ("Opposer")	)	
	)	
vs.	)	Opposition No. 91180232
	)	
SM Productions ("Applicant")	)	
	)	

**DECLARATION IN SUPPORT OF  
OPPOSER'S MEMORANDUM OF LAW IN RESPONSE TO  
THE BOARD'S ORDER TO SHOW CAUSE  
AND IN SUPPORT OF  
STIPULATION TO ADOPT A MODIFIED TRIAL SCHEDULE**

I, PETER D. ROSENTHAL, declare the following:

1. I am Senior Counsel with the law firm of Roberts Ritholz Levy Sanders Chidekel & Fields LLP (the "Firm") and the attorney of record for Opposer in this proceeding.
2. I submit this Declaration in support of Opposer's response to the TTAB's May 5, 2009 order to show cause why this proceeding should not be dismissed with prejudice against Opposer.
3. Annexed hereto as Exhibit 1 is a true copy of the TTAB's May 14, 2008 order advising that the Applicant is representing itself ordering the resumption of the proceeding and resetting the discovery and trial dates (the "May 14 Order").
4. In resetting the trial dates, The May 14 Order did not establish a date for the 30-day testimony period for party in position of plaintiff (i.e., Opposer) to close.
5. Following receipt of TTAB orders and similar matters, it is the Firm's policy and practice that a Firm employee (typically the attorney of record, a trademark

paralegal or legal assistant) calendar the relevant actions and dates in the Firm docketing system, with periodic reminders sent in advance of the applicable dates.

6. Following receipt of the May 14 Order, the relevant actions and dates were entered into the Firm docketing system exactly as they appeared therein; consequently no reminders of the applicable deadline regarding the close of plaintiff's testimony period were communicated to the Firm attorneys.

7. At no point has Opposer conceded or lost interest in this proceeding.

8. Opposer and Opposer's counsel have continually before, during and after the discovery and trial periods in this proceeding, sought out and communicated with numerous stated representatives and purported assignees of Applicant and their respective counsel regarding settlement or other disposition or resolution of this case.

9. The persons to whom Opposer and Opposer's counsel have conducted and/or addressed communications and negotiations regarding this matter include the following:

(1) the late Richard "Dick" Scott, who upon information and belief, was one of the two original general partners of Applicant;

(2) Denny Marte, who upon information and belief is the other original general partner of Applicant;

(3) Brett H. Green, Esq., New City, NY, who upon information and belief was previously Applicant's attorney of record in this proceeding and is presently counsel for Denny Marte;

(3) Stuart Wachs, Esq., of Fogel & Wachs PC, Larchmont, NY, who upon information and belief also served as counsel for Applicant in this proceeding;

(4) Torsten Siefert, Esq. of Kiso & Siefert, Hamburg, Germany, who upon information and belief, is counsel for UR Star Entertainment GmbH of Köln, Germany ("UR Star"), and who represented to the undersigned on numerous occasions that UR Star is the assignee of Applicant's rights with regard to the NEW KIDS ON THE BLOCK mark, including the application that is the subject of this proceeding, and two foreign applications for such mark;

(5) Nathan Smith, Esq. of Dechert LLP, London, UK, who upon information and belief are Applicant's European counsel and attorneys of record for the Applicant's European Community Trade Mark application and registration;

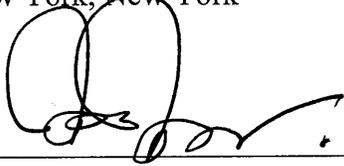
(6) John "Furqan" Raschke, who upon information and belief is the sole heir of the late Richard "Dick" Scott and one of Applicant's general partners; and

(7) Evan Krauss, Esq., of Gray Krauss LLP, New York, NY, who upon information and belief is counsel to John "Furqan" Raschke.

I declare under penalty of perjury that the foregoing is true and correct.

Executed on June 4, 2009

New York, New York

A handwritten signature in black ink, appearing to read "Peter D. Rosenthal", written over a horizontal line.

Peter D. Rosenthal

**EXHIBIT 1**

(See attached)

UNITED STATES PATENT AND TRADEMARK OFFICE  
Trademark Trial and Appeal Board  
P.O. Box 1451  
Alexandria, VA 22313-1451

TDC

Mailed: May 14, 2008

Opposition No. 91180232

NKOTB, Inc.

v.

SM Productions

**Linda Skoro, Interlocutory Attorney**

On April 14, 2008, applicant was allowed thirty days to appoint new counsel, or to file a paper stating that applicant chooses to represent itself.

On May 12, 2008, applicant filed a response indicating that it chooses to represent itself.

In view thereof, proceedings herein are resumed and discovery and trial dates are reset as indicated below:

DISCOVERY PERIOD TO CLOSE:	<b>August 11, 2008</b>
30-day testimony period for party in position of defendant to close:	<b>November 9, 2008</b>
30-day testimony period for party in position of defendant to close:	<b>January 8, 2009</b>
15-day rebuttal testimony period to close:	<b>February 22, 2009</b>

In each instance, a copy of the transcript of testimony together with copies of documentary exhibits, must be served

on the adverse party within thirty days after completion of taking of testimony. Trademark Rule 2.125.

Briefs shall be filed in accordance with Trademark Rule 2.128(a) and (b). An oral hearing will be set only upon request filed as provided by Trademark Rule 2.129.

**NEWS FROM THE TTAB:**

The USPTO published a notice of final rulemaking in the Federal Register on August 1, 2007, at 72 F.R. 42242. By this notice, various rules governing Trademark Trial and Appeal Board inter partes proceedings are amended. Certain amendments have an effective date of August 31, 2007, while most have an effective date of November 1, 2007. For further information, the parties are referred to a reprint of the final rule and a chart summarizing the affected rules, their changes, and effective dates, both viewable on the USPTO website via these web addresses:

<http://www.uspto.gov/web/offices/com/sol/notices/72fr42242.pdf>

[http://www.uspto.gov/web/offices/com/sol/notices/72fr42242\\_FinalRuleChart.pdf](http://www.uspto.gov/web/offices/com/sol/notices/72fr42242_FinalRuleChart.pdf)

By one rule change effective August 31, 2007, the Board's standard protective order is made applicable to all TTAB inter partes cases, whether already pending or commenced on or after that date. However, as explained in the final rule and chart, this change will not affect any case in which any protective order has already been approved or imposed by the Board. Further, as explained in the final rule, parties are free to agree to a substitute protective order or to supplement or amend the standard order even after August 31, 2007, subject to Board approval. The standard protective order can be viewed using the following web address:

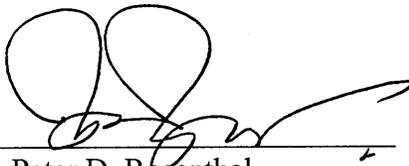
<http://www.uspto.gov/web/offices/dcom/ttab/tbmp/stndagmnt.htm>

CERTIFICATE OF SERVICE

The undersigned hereby certifies that a true and complete copy of the foregoing OPPOSER'S MEMORANDUM OF LAW IN RESPONSE TO THE BOARD'S ORDER TO SHOW CAUSE AND IN SUPPORT OF STIPULATION TO ADOPT A MODIFIED TRIAL SCHEDULE has been served on SM Productions by mailing said copy on June 4, 2009 via first class U.S. mail, postage prepaid, to its address of record, namely:

SM Productions  
151 1<sup>st</sup> Ave., Suite 176  
New York, NY 10003

Dated: New York, New York  
June 4, 2009

By:   
Peter D. Rosenthal