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TTAB

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
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WINTER

March 29, 2024

Opposition No. 91249965

Dino Danelli and Edward Brigati

v.

Beata Music LLC

Before Greenbaum, Goodman, and Lebow,
Administrative Trademark Judges.

By the Board:

I. Background

Dino Danelli, deceased, and Edward Brigati (Opposer(s)), and Beata Music LLC's (Applicant) individual members, Felix Cavaliere and Gene Cornish, were founding members of the musical performing group "The Rascals" aka "The Young Rascals."¹ Applicant seeks to register the wording THE RASCALS, in standard characters, for "jackets, jerseys, shirts, shorts, sweatshirts, t-shirts and headwear," in International

¹ See Notice of Opposition (Not. of Opp.), ¶ 6, 1 TTABVUE 5; and Answer, ¶ 6, 4 TTABVUE 3. Citations to the record or briefs in this order include citations to the publicly available documents on the Trademark Trial and Appeal Board Inquiry System (TTABVUE), the Board's electronic docketing system. To allow the Board and readers to easily locate materials in the record, the parties should cite to facts or evidence in the proceeding record by referencing the TTABVUE entry and page number, e.g., "1 TTABVUE 2," and not attach previously-filed evidence to their briefs. See TRADEMARK TRIAL AND APPEAL BOARD MANUAL OF PROCEDURE (TBMP) §§ 106.03, 801.01 and 801.03 (2023).

Class 25, and “entertainment services in the nature of live performances by a vocal and instrumental group,” in International Class 41.²

Prior to the institution of this proceeding, the parties were involved in a combined civil action, specifically, Civil Action No. 1:18-cv-06354 in the United States District Court for the Southern District of New York (“District Court” or “Prior Action”), captioned *Beata Music LLC, Plaintiff vs. Dino Danelli, Eddie Brigati, et al.*; and *Dino Danelli and Eddie Brigati, Counterclaim Plaintiffs vs. Beata Music LLC, Felix Cavaliere and Gene Cornish, Counterclaim Defendants*, in connection with their respective rights, if any, in THE RASCALS mark.³ This proceeding was suspended on November 25, 2019, and again on May 4, 2021, pending final determination of the Prior Action.⁴ Additionally, from May 4, 2022,⁵ to the date of this Order, this proceeding has remained suspended, except that one or more of the parties, or Opposer Danelli or his estate specifically, were required to respond to seven interim Board orders, including the following orders:

- a) Requiring Opposers to submit proof of service on Applicant of their May 4, 2022 and May 17, 2022 submissions to the Board;⁶
- b) Requiring the parties to clarify the attorney representation and service of submissions (to the Board) on Opposer Danelli or his estate;⁷ and

² Application Serial No. 87803534, filed February 20, 2018, under Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b).

³ Not. of Opp., ¶ 22, 1 TTABVUE 8.

⁴ 6 and 12 TTABVUE.

⁵ 13 TTABVUE 1.

⁶ 16 TTABVUE 1, mailed September 6, 2022.

⁷ 25 TTABVUE 2-5, mailed May 2, 2023.

- c) Extending the parties' deadline to September 30, 2023, to re-brief previous motions and submit documents,⁸ as required in the Board's July 26, 2023 order.⁹

This case now comes up on the following submissions: "Applicant's Response (filed September 29, 2023) to the Board's Order of July 26, 2023,"¹⁰ and Opposer Edward Brigati's¹¹ "Revised Opposition (filed September 30, 2023) to Issuance of Order to Resume,"¹² submitted in response to the same Board order of July 26, 2023. Applicant requests that the Board "dismiss" the opposition;¹³ and Opposer requests that the Board deny Applicant's application for registration of THE RASCALS mark.¹⁴ In both motions, the parties rely on orders issued by the District Court in the Prior Action.

⁸ 30 TTABVUE.

⁹ In view of previous inadequate briefing by both parties, the Board required the parties to submit or resubmit numerous documents and revised briefs in accordance with particular guidelines. 27 TTABVUE 3-5. The parties filed their respective responses to the Board's request for a status update on the Prior Action on April 13, 2023 (Opposer Brigati) and on April 21, 2023 (Applicant). 23-24 TTABVUE.

¹⁰ 32 TTABVUE. On October 5, 2022, Applicant filed a motion for issuance of a show cause order as to why judgment should not be entered on its behalf in view of the Memorandum Opinion and Order and Final Judgment Order issued on May 10, 2022 and May 31, 2022, respectively, in the civil action. 19 TTABVUE 3, 11 and 29. Although Applicant titled its subject submission, "Applicant's Response to the Board's Order of July 26, 2023," 32 TTABVUE, Applicant essentially renews its request for dismissal of the opposition. *Id.* at 8.

¹¹ As discussed *infra*, only Opposer Brigati remains in this proceeding.

¹² 31 TTABVUE.

¹³ 32 TTABVUE 8.

¹⁴ 31 TTABVUE 14. In response to Applicant's above-mentioned motion for issuance of a show cause order, Opposer Brigati opposed the motion and asserted that registration of the involved application should be denied based upon the findings set forth in the District Court's Memorandum Opinion and Order on Plaintiff's and Third-Party Defendants' (Second) Motion for Summary Judgment ("Prior Order") issued on May 10, 2022 in the same civil action. 20 TTABVUE 4. Opposer Brigati's submission filed on April 13, 2023 renewed his request to deny registration for the reasons discussed in its response to Applicant's motion for a show cause order. 23 TTABVUE 2. Likewise, in Opposer Brigati's subject motion, although titled, "Revised Opposition to Issuance of Order to Resume," 31 TTABVUE 2, Opposer Brigati renews his request that that Board deny registration based upon (i) the findings in the

II. Preliminary Matters

A. Opposition Dismissed with Prejudice against Opposer Danelli

On July 26, 2023¹⁵ and on August 28, 2023,¹⁶ respectively, the Board allowed the estate of Opposer Danelli¹⁷ to respond to the withdrawal of Danelli's former counsel and to show cause why the opposition should not be dismissed with prejudice as to Danelli based on the apparent loss of interest of Opposer Danelli's estate in this proceeding.¹⁸ No response from Danelli's estate was received to either order.¹⁹ In view thereof, the opposition is hereby **DISMISSED WITH PREJUDICE** only as to Opposer Dino Danelli.

Memorandum Opinion and Order in the Civil Action and (ii) the express abandonment and dismissal with prejudice of Felix Cavaliere's trademark application on March 19, 1991. 31 TTABVUE 14, referring to 23 TTABVUE 25-33.

¹⁵ 27 TTABVUE 1-2, mailed July 26, 2023. A courtesy copy of this order was also sent to Frances J. Harvey, an attorney identified by Danelli's prior counsel as Danelli's estate counsel at FHarvey@FJHlaw.net. *Id.* at 3; *see also* 26 TTABVUE 9.

¹⁶ 28 TTABVUE 1, mailed August 28, 2023.

¹⁷ On April 21, 2023, Applicant advised the Board that Dino Danelli passed away in December 2022. 24 TTABVUE 3. On May 17, 2023, Michael B. Kramer and Artemis Croussouloudis of Michael B. Kramer & Associates, prior counsel of Dino Danelli, confirmed the death of Mr. Danelli on December 15, 2022. *See* 26 TTABVUE 3; 27 TTABVUE 1.

¹⁸ 28 TTABVUE.

¹⁹ Similarly, in the Prior Action, the District Court noted that Defendant Danelli's counsel had lost contact with Danelli around November 2019, notwithstanding "dozens of attempts to reach him." 33 TTABVUE 132. "After the withdrawal of counsel, Danelli has not appeared in this case despite numerous attempts to reach him by the other parties and Orders of the Magistrate Judge." *Id.* at 132; *see also id.* at 141 ("Magistrate Judge provided multiple avenues for Danelli to communicate with the Court ..."). Thus, Danelli's counsel lost contact with Danelli within three months of the institution of this opposition.

B. Parties' Motions Construed as Cross-Motions for Summary Judgment

Both parties seek entry of judgment against the adverse party²⁰ on the basis of one or more orders issued by the District Court in the consolidated Prior Action, which allegedly determined, inter alia, (1) ownership of the RASCALS mark; (2) whether Applicant's members, Cavaliere and Cornish, were authorized to file the involved application; and (3) what rights, if any, Opposer Brigati has in THE RASCALS mark regarding "live performances by a vocal and instrumental group" and the sale of merchandise at those performances.²¹ Applicant submitted evidence with its motion; and Opposer Brigati relies on evidence previously submitted to the Board in support of his motion.²²

Where a motion styled as one to dismiss relies on matter outside the pleadings, the Board may construe the motion as one for summary judgment. *See Haider Capital*

²⁰ We have considered Opposer's brief and Applicant's evidence and brief (to the extent we discern its meaning, see *infra*), but address the record only to the extent necessary to support our analysis and findings, and do not repeat or address all of the parties' arguments or evidence. *Topco Holdings, Inc. v. Hand 2 Hand Indus., LLC*, 2022 USPQ2d 54, at *1 (TTAB 2022) (citing *Guess? IP Holder LP v. Knowluxe LLC*, 116 USPQ2d 2018, 2019 (TTAB 2015)). For purposes of this order, we presume the parties' familiarity with the pleadings, and the arguments and evidence submitted in connection with the subject motions.

²¹ In the First Claim for relief in Plaintiff's (Beata's) First Amended Complaint (¶ 53), Plaintiff sought, in part, "an order declaring that BEATA MUSIC LLC is the owner of the RASCALS mark pursuant to 15 U.S.C. Section 1501 for concert tours and merchandise sales at such concerts." 33 TTABVUE 52; *see also* 33 TTABVUE 1070. *See also* the discussion in the Board's order issued on July 26, 2023. 27 TTABVUE 3-4.

²² In support of his motion, Opposer Brigati refers to previously-submitted documents and a Board order, specifically: 19 TTABVUE 29, 21 TTABVUE 1-8 (Board order dated January 31, 2023), 23 TTABVUE 7-23, 23 TTABVUE 16-18, 23 TTABVUE 25-33, and 24 TTABVUE 10. Generally, evidence that a party wishes to have considered upon summary judgment must be submitted in connection with the summary judgment motion. *See Kellogg Co. v. Pack'Em Enter. Inc.*, 14 USPQ2d 1545, 1549 n.9 (TTAB 1990), *aff'd*, 951 F.2d 330, 21 USPQ2d 1142 (Fed. Cir. 1991). Therefore, Opposer's mere references to previously-submitted documents in the proceeding record have not been considered. Nonetheless, we note that the District

Holding Corp. v. Skin Deep Laser MD, LLC, 2021 USPQ2d 991, at *3-5 (TTAB 2021) (construing motion to dismiss as motion for summary judgment where basis is claim preclusion and moving party relies on matter outside of pleadings); *see also Selva & Sons, Inc. v. Nina Footwear, Inc.*, 705 F.2d 1316, 217 USPQ 641 (Fed. Cir. 1983). Additionally, although initial disclosures have not been served, a party need not serve initial disclosures prior to seeking summary judgment on the grounds of issue or claim preclusion, as in this case. Trademark Rule 2.127(e)(1), 37 C.F.R. § 2.127(e)(1); *see Zoba Int'l Corp. v. DVD Format/LOGO Licensing Corp.*, 98 USPQ2d 1106, 1108 n.4 (TTAB 2011).

Further, because we allowed each party additional time to submit revised briefs and appropriate documents in support of their cross-motions, it is appropriate to consider the parties' motions as seeking summary judgment without allowing time for additional briefing or submission of evidence. *See* Fed. R. Civ. P. 12(d), applicable to this proceeding under Trademark Rule 2.116(a), 37 C.F.R. § 2.116(a); *see also Chutter, Inc. v. Great Concepts, LLC*, 119 USPQ2d 1865, 1870 n.9 (TTAB 2016) (Board sua sponte entered summary judgment in favor of non-movant after parties were informed that Board would entertain question of res judicata pursuant to Fed. R. Civ. P. 56 and Trademark Rule 2.127(e) and were given opportunity to present evidence and argument on that question); *Unrock Network, LLC v. Sulpasso*, 115 USPQ2d 1409, 1410 n.5 (TTAB 2015) (motion to dismiss considered as one for

Court's Prior Order on Plaintiff's and Third-Party Defendants' (Second) Motion for Summary Judgment and the Final Judgement Order, both cited by Opposer, were submitted by Applicant in its October 2, 2023 submission. *See* 33 TTABVUE 1062, 1081-1083.

summary judgment where it asserts claim preclusion); *cf. Hoffenberg v. Hoffman & Pollok*, 288 F.Supp.2d 527, 534 (S.D.N.Y. 2003) (internal citation omitted) (where both parties have filed exhibits in support of and opposition to a motion to dismiss, “a party cannot complain of lack of a reasonable opportunity to present all material relevant to a motion for summary judgment”).

Accordingly, because (i) we allowed each party additional time to submit revised briefs and appropriate documents in support of their cross-motions, and (ii) we identified specific areas of applicable case law that were previously not briefed, i.e., claim or issue preclusion, and referred the parties to TBMP § 101 to review applicable statutes, the Trademark Rules of Practice, Federal Rules, and decisional law applicable to Board proceedings,²³ the parties have had a reasonable opportunity to present all material pertinent to their cross-motions. *See Libertyville Saddle Shop Inc. v. E. Jeffries & Sons, Ltd.*, 22 USPQ2d 1594, 1596 (TTAB 1992).²⁴ In view of the foregoing, and to foster judicial economy, we construe the parties’ cross-motions for summary judgment and will consider them as such.

Additionally, although neither party responded directly to the adverse party’s subject motion, because we allowed the parties time to submit revised briefs in connection with their opposing positions regarding the effect of the Prior Action, pursuant to our discretion under Trademark Rule 2.127(a), 37 C.F.R. § 2.127(a), we

²³ 27 TTABVUE 4-5.

²⁴ Moreover, insofar as the parties’ cross-motions seeks entry of judgment, which necessarily involves a determination of the merits of the case prior to trial, it is highly unlikely that the parties did not understand that the Board would construe their motions as seeking summary judgment.

will not treat the parties' motions as conceded, but rather will decide each motion on its merits.

C. Applicant's Nearly Incomprehensible Brief

As mentioned, we allowed each party additional time to submit revised briefs in support of their cross-motions. We note with extreme disfavor the brief submitted by Applicant in response to the Board's order, which is barely comprehensible. Specifically, the brief is rife with misspellings, incomplete and/or non-sensical sentences; it includes abbreviated references to a document that was not clearly identified and a citation thereto was not provided; and Applicant referred to cases without sufficient argument to connect them to material fact at issue.²⁵ The relief sought by Applicant is not clear until the last full paragraph of the brief. In view of

²⁵ By way of example, Applicant's brief begins as follows:

In response to the board's order serves the following brief explanation of this cast [sic] excuses been extensively litigated and we had apologizes [sic] to extent that it's violence [sic] have assumed some knowledge of that litigation which it has lived with for several years. The basic facts of the case are laid out in the motion for summary judgment filed by Beata on the claims by Eddie Brigati opposer here no sparks [sic] are substantiated on the attached paper they're quoted below so that the board can understand the context of this matter.

32 TTABVUE 2. Additionally, later in the motion, Applicant states:

In a subsequent motion on Beata's affirmative rights, the Court found that neither Danelli nor Brigati had any rights in the mark.

Since the court since the court entered these motions fiada has performed cavalry and corners [sic] [Cavaliere and Cornish] have performed As the rascals. Attached here too.

Plaintiffs have toured extensively following that issue. As shown in the Declaration of Eric Bjorgum, Exhibit A, there have been multiple shows as "The Rascals." There has been no confusion or allegations of confusion. Thus, at the very least, Beata is establishing common law rights after the litigation.

32 TTABVUE 7.

the foregoing, and noting the distinct difference in format between Applicant's instant submission and "Applicant's Notice of Resolution of Related Proceeding [sic] and Requires [sic] for Entry of Judgment in Favor of Applicant," submitted on January 31, 2023,²⁶ and its briefs submitted to the District Court in the Prior Action, we find it more likely than not that Applicant's most recent submission to the Board was partially AI-assisted.

In view of the foregoing, in accordance with Office policy,²⁷ we consider the USPTO's Rules of Practice, specifically, 37 C.F.R. § 11.18(b)(2), which provides that by presenting a signed document to the Office under 37 C.F.R. § 11.18(a), including to the Trademark Trial and Appeal Board, the practitioner is, in relevant part, certifying that (emphasis added):

To the best of the party's knowledge, information and belief, formed **after an inquiry reasonable under the circumstances**,

- (i) The paper is not being presented for any improper purpose, such as to harass someone or to cause unnecessary delay or needless increase in the cost of any proceeding before the Office;
- (ii) The other legal contentions therein are warranted by existing law or by a nonfrivolous argument for the extension, modification, or reversal of existing law or the establishment of new law;
- (iii) The allegations and other factual contentions have evidentiary support or, if specifically so identified, are likely to have evidentiary support after a reasonable opportunity for further investigation or discovery; and

²⁶ 19 TTABVUE.

²⁷ See "USPTO clarifies guidance to judicial Boards on holding parties responsible for the misuse of AI in legal proceedings," published February 6, 2024, <https://www.uspto.gov/subscription-center/2024/uspto-clarifies-guidance-judicial-boards-holding-parties-responsible>.

(iv) The denials of factual contentions are warranted on the evidence, or if specifically so identified, are reasonably based on a lack of information or belief.

“Simply assuming the accuracy of an AI tool is not a reasonable inquiry.”

See, e.g., Mata v. Avianca Inc., ___ F.Supp.3d ___, No. 22-CV-1461, 2023 WL 4114965, at *15-16 (S.D.N.Y. June 22, 2023) (emphasis added). Failure to comply with the foregoing and related rules may subject the practitioner to sanctions, including striking the offending paper, precluding the party or practitioner from submitting a paper, or from contesting an issue, affecting the weight given to the offending paper, terminating the proceeding, and, in cases of knowing and willful violations, criminal liability under 18 U.S.C. § 1001. 37 C.F.R. § 11.18(b).

Given the near unintelligible nature of Applicant’s submission, we will not attempt to guess or construe the meaning or purpose of most of the content of the document. “Judges are not like pigs, hunting for truffles buried in briefs.” *United States v. Dunkel*, 927 F.2d 955, 956 (7th Cir. 1991). Rather, we shall consider only the facts and arguments that are clearly discernable, including the declaration submitted with Applicant’s evidence and acceptable materials attached thereto.

III. Cross-Motions for Summary Judgment

A. Legal Standard for Cross-Motions for Summary Judgment

Summary judgment is an appropriate method of disposing of cases in which there is no genuine dispute with respect to any material fact, thus allowing the case to be resolved as a matter of law. *See* Fed. R. Civ. P. 56(a). A party moving for summary judgment has the burden of demonstrating the absence of any genuine dispute as to

a material fact, and that it is entitled to judgment as a matter of law. *See Celotex Corp. v. Catrett*, 477 U.S. 317, 323 (1986); *Sweats Fashions, Inc. v. Pannill Knitting Co. Inc.*, 833 F.2d 1560, 4 USPQ2d 1793, 1796 (Fed. Cir. 1987). A factual dispute is genuine if, on the evidence of record, a reasonable fact finder could resolve the matter in favor of the non-moving party. *See Opryland USA Inc. v. Great Am. Music Show Inc.*, 970 F.2d 847, 23 USPQ2d 1471, 1472 (Fed. Cir. 1992); *Olde Tyme Foods, Inc. v. Roundy's, Inc.*, 961 F.2d 200, 22 USPQ2d 1542, 1544 (Fed. Cir. 1992). The burden of demonstrating the absence of a genuine dispute on summary judgment is greater than the evidentiary burden at trial, which is a preponderance of the evidence, and which permits appropriate inferences to be drawn from the evidence of record. *See, e.g., Gasser Chair Co. v. Infanti Chair Mfg. Corp.*, 60 F.3d 770, 34 USPQ2d 1822, 1824 (Fed. Cir. 1995) (moving party must establish no genuine dispute of material fact as to each element of claim or defense for which summary judgment is sought).

Further, the evidence of record must be viewed in the light most favorable to the non-moving party, and all justifiable inferences must be drawn from the undisputed facts in favor of the non-moving party. *See Lloyd's Food Prods. Inc. v. Eli's Inc.*, 987 F.2d 766, 25 USPQ2d 2027, 2029 (Fed. Cir. 1993); *Opryland USA*, 23 USPQ2d at 1472. We may not resolve genuine disputes as to material facts and, based thereon, decide the merits of the proceeding. Rather, we may only ascertain whether any material fact is genuinely disputed. *See Lloyd's Food Prods.*, 25 USPQ2d at 2029; *Olde Tyme Foods*, 22 USPQ2d at 1542; *Meyers v. Brooks Shoe Inc.*, 912 F.2d 1459, 16 USPQ2d 1055, 1056 (Fed. Cir. 1990) ("If there is a real dispute about a material fact

or factual inference, summary judgment is inappropriate; the factual dispute should be reserved for trial.”).

However, where the non-moving party will bear the burden of proof at trial on a dispositive issue, such as entitlement to a statutory action, the moving party may discharge its burden by showing that there is an absence of evidence to support the non-moving party’s case. *Celotex Corp. v. Catrett*, 477 U.S. at 325; *Copelands’ Enters. Inc. v. CNV Inc.*, 945 F.2d 1563, 20 USPQ2d 1295, 1298 (Fed. Cir. 1991). In that case, the summary judgment motion may properly be made in reliance solely on the “pleadings, depositions, answers to interrogatories, and admissions on file” and “requires the non-moving party to go beyond the pleadings and by her own affidavits, or by the depositions, answers to interrogatories, and admissions on file, designate specific facts showing that there is a genuine [dispute] for trial.” *Celotex*, 477 U.S. at 324.

The mere fact that cross-motions for summary judgment on a claim have been filed does not necessarily mean that there is no genuine dispute as to a material fact, or that trial is unnecessary. *See Drive Trademark Holdings LP v. Inofin*, 83 USPQ2d 1433, 1437 (TTAB 2007); *Fishking Processors Inc. v. Fisher King Seafoods Ltd.*, 83 USPQ2d 1762, 1764 (TTAB 2007); *Univ. Book Store v. Univ. of Wisconsin Bd. of Regents*, 33 USPQ2d 1385, 1389 (TTAB 1994). Each party has the initial burden of demonstrating the absence of any genuine disputes as to any material fact with respect to its own motion. *See Celotex Corp. v. Catrett*, 477 U.S. at 323; *Sweats Fashions*, 4 USPQ2d at 1795-96; *Univ. Book Store*, 33 USPQ2d at 1389.

B. Parties' Claims and Affirmative Defenses

A decision on summary judgment necessarily requires a review of the operative pleadings. *Asian & W. Classics B.V. v. Selkow*, 92 USPQ2d 1478, 1478 (TTAB 2009). Generally, only well pleaded issues may be the basis for a grant of summary judgment. *Id.* at 1480 (citing *Intermed Commc'ns, Inc. v. Chaney*, 197 USPQ 501, 503 n.2 (TTAB 1977) (“If a claim has not been properly pleaded, one cannot obtain summary judgment thereon”)); *Consol. Foods Corp. v. Berkshire Handkerchief Co.*, 229 USPQ 619, 621 (TTAB 1986). In view thereof, we turn first to consider the parties' claims and affirmative defenses.

1) Opposer Brigati's Pleaded, Construed and Unavailable Claims

a. Entitlement to a Cause of Action (previously “Standing”²⁸)

To sufficiently plead entitlement to a statutory cause of action, a plaintiff must allege: (1) an interest falling within the zone of interests protected by the statute and (2) a reasonable belief in damage proximately caused by the registration of the mark. Entitlement to a statutory cause of action, formerly referred to as “standing” by the Federal Circuit and the Board, must be established by the plaintiff in every inter partes case. *See Corcamore, LLC v. SFM, LLC*, 978 F.3d 1298, 2020 USPQ2d 11277, at *7 (Fed. Cir. 2020); *Australian Therapeutic Supplies Pty. Ltd. v. Naked TM, LLC*,

²⁸ Our decisions previously analyzed the requirements of Trademark Act Sections 13 and 14, 15 U.S.C. §§ 1063-64, under the rubric of “standing.” Following the Supreme Court's direction in *Lexmark Int'l, Inc. v. Static Control Components, Inc.*, 572 U.S. 118, 125-26 (2014), we now refer to this inquiry as entitlement to a statutory cause of action. Despite the change in terminology, our prior decisions and those of the Federal Circuit interpreting Sections 13 and 14 remain equally applicable. *See Spanishtown Enters., Inc. v. Transcend Resources, Inc.*, 2020 USPQ2d 11388, at *2 (TTAB 2020).

965 F.3d 1370, 2020 USPQ2d 10837, at *3 (Fed. Cir. 2020), *cert. denied*, 142 S. Ct. 82 (2021) (citing *Lexmark Int'l, Inc. v. Static Control Components, Inc.*, 572 U.S. 118, 109 USPQ2d at 2067 n.4; *Empresa Cubana Del Tabaco v. Gen. Cigar Co.*, 753 F.3d 1270, 111 USPQ2d 1058, 1062 (Fed. Cir. 2014)). A party in the position of plaintiff may oppose registration of a mark where such opposition is within the zone of interests protected by the statute, 15 U.S.C. § 1063, and the party has a reasonable belief in damage that is proximately caused by registration of the mark. *Corcamore*, 2020 USPQ2d 11277, at *6-7.

Opposer Brigati has adequately pleaded his entitlement to a statutory cause of action by asserting joint ownership of his pleaded registrations. He also alleges, “[t]he Band Members Marks trademark registrations are active and were renewed July 2015.”²⁹ *See, e.g., Cunningham v. Laser Golf Corp.*, 22 USPQ2d F.2d 943, 55 USPQ2d 1842, 1844 (Fed. Cir. 2000) (party’s ownership of pleaded registration established “standing”).

Applicant denied the salient allegations in its Answer. Additionally, Applicant argues in its motion, “[b]ased on the Court’s prior rulings, this Opposition should be dismissed, and the Application proceed to registration.”³⁰ We construe Applicant’s arguments as a defense of issue preclusion based on the decisions and findings of the District Court, which it submitted with its cross-motion. *See infra*, Section III.C. of

²⁹ Not. of Opp., ¶¶ 16-17, 1 TTABVUE 6-7.

³⁰ 32 TTABVUE 7.

this order. We address below whether there is a genuine dispute of material fact as to Opposer Brigati's entitlement.

b. Likelihood of Confusion Claim Construed as a Lack of Bona Fide Intent to Use Claim

Opposer identifies likelihood of confusion and "non-ownership" as its claims on the ESTTA cover sheet to the Notice of Opposition. Opposer also alleges in the pleading, "Opposers and Applicant, along with its members Cavaliere and Cornish, are currently litigating [in the Prior Action] who is the owner of Applicant's Mark ... Opposers submit that Applicant's Mark should be rejected because the same issues are already before the Court in the NY Action" (emphasis added).³¹

In view of these and related allegations in the Notice of Opposition, we find that which party owns the mark or has the right to register the THE RASCALS mark, rather, than likelihood of confusion, is the actual issue raised by Opposer in his pleading. *See Wonderbread 5 v. Gilles*, 115 USPQ2d 1296, 1302 (TTAB 2015) ("when both parties are relying upon activities the two conducted in concert with one another, each in an attempt to establish prior rights in a mark over the other, the dispute centers on ownership of the mark") (citing *Nahshin v. Prod. Source Int'l*, 107 USPQ2d 1257, 1258 (TTAB 2013) ("Although the proceeding was brought on the ground of priority/likelihood of confusion, the actual issue in this matter is ownership of the mark ...").

³¹ Not. of Opp., ¶¶ 22, 27, 1 TTABVUE 8-9.

However, the opposed application is based on Applicant's bona fide intent to use the mark under Section 1(b), 15 U.S.C. § 1051(b). There is no statutory requirement that the filer of an intent-to-use application be the owner of the mark at the time it files an intent-to-use application; rather, the filer avers that: "The signatory believes that the applicant is entitled to use the mark in commerce. The applicant has a bona fide intention to use the mark in commerce on or in connection with the goods/services in the application." Therefore, because an allegation or statement of use has not been filed in connection with the opposed application, a claim that an applicant was not the rightful "owner" of the mark when the application was filed is not available when the application, as originally filed in this case, is not based on use of the mark in commerce. *See Hole In 1 Drinks, Inc. v. Michael Lajtay*, 2020 USPQ2d 10020, at *5 (TTAB 2020) (citing *Norris v. PAVE: Promoting Awareness, Victim Empowerment*, 2019 USPQ2d 370880 *4 (TTAB 2019)). Thus, to the extent Opposer Brigati alleges that Applicant is not the owner of THE RASCALS mark, there is no statutory basis for Opposer's claim. *See Hole In 1 Drinks*, 2020 USPQ2d 10020 at *6; *Norris v. PAVE*, 2019 USPQ2d 370880, at *4-5.

Accordingly, because both the likelihood of confusion and lack of ownership claims are unavailable,³² those claims are construed as a lack of bona fide intent to use THE

³² Opposer's likelihood of confusion claim is also unavailable in this case because Opposer Brigati cannot demonstrate priority to support the claim. As discussed *infra*, there is no genuine dispute as to the material fact that Opposer Brigati jointly owns with Cavaliere and Cornish the pleaded trademark registrations for the marks RASCALS and YOUNG RASCALS for musical recordings. Because Opposer Brigati is not the sole owner of the pleaded registered marks, those registrations cannot form a basis for priority as title does not reside solely in Opposer Brigati. *See, e.g., Chemical New York Corp. v. Conmar Form Sys., Inc.*, 1 USPQ2d 1139, 1142 (TTAB 1986) ("[I]nasmuch as opposer Chemical Bank is not the

RASCALS mark. *See id.* *See also M.Z. Berger & Co. v. Swatch AG*, 787 F.3d 1368, 114 USPQ2d 1892, 1898 (Fed. Cir. 2015) (“Because a bona fide intent to use the mark in commerce is a statutory requirement of a valid intent-to-use trademark application under [Trademark Act] Section 1(b), the lack of such intent is a basis on which an opposer may challenge an applicant’s mark.”).

Further, we note that in response to Brigati’s arguments in his motion that Applicant had no bona fide intent to use the RASCALS mark,³³ Applicant does not object on the basis that Opposer’s motion was based on an unpleaded claim. *See Asian and W. Classics B.V. v. Selkow*, 92 USPQ2d at 1480 (petitioner cannot obtain summary judgment on an insufficiently pleaded fraud claim). Instead, as well as we can discern, Applicant responded on the merits of Opposer’s lack of bona fide intent to use claim by arguing that Cavaliere and Cornish have continued to perform as

owner of the registrations, and hence cannot rely on them herein..., it was incumbent upon Chemical Bank to prove priority of use in order to prevail upon its claim under Section 2(d)”; *Yamaha Int’l Corp. v. Stevenson*, 196 USPQ 701, 702 (TTAB 1979) (opposer could not rely on 7(b) presumptions where registration is owned by its parent company); *Fuld Bros., Inc. v. Carpet Tech. Serv. Inst., Inc.*, 174 USPQ 473, 476 (TTAB 1972) (only the registrant can rely upon the prima facie presumptions afforded a registration under Section 7(b)); *see also* TBMP Section 704.03(b)(1)(B) (“[T]he § 7(b) presumptions accorded to a registration on the Principal Register accrue only to the benefit of the owner of the registration, and hence come into play only when the registration is made of record by its owner.”); *cf. Conolty v. Conolty O’Connor NYC LLC*, 111 USPQ2d 1302, 1309-10 (TTAB 2014) (one individual in a partnership is not considered the owner of a mark, “Applicant therefore owns at most only a partial interest in the mark”). Because Opposer Brigati cannot demonstrate priority, an amendment to the Notice of Opposition to correct the likelihood of confusion claim with respect to the goods in International Class 25 and services in International Class 41 would be futile. *See* Fed. R. Civ. P. 15(a)(2); *see also Foman v. Davis*, 371 U.S. 178, 182 (1962) (“futility of amendment” is a reason to deny a Rule 15(a) motion); *Dragon Bleu (SARL) v. VENM, LLC*, 112 USPQ2d 1925, 1929 n.10 (TTAB 2014) (“But leave to replead is inappropriate here. ... [W]e can perceive no theory by which the recited facts could be plausibly alleged to constitute fraud.”); *Am. Express Mktg. & Dev. Corp. v. Gilad Dev. Corp.*, 94 USPQ2d 1294, 1297 (TTAB 2010).

³³ 31 TTABVUE 4-5; *see also id.* at 10, 12-13.

THE RASCALS since the District Court issued its orders in the Prior Action.³⁴ Additionally, Applicant submitted evidence with its motion intending to show, “at the very least, Beata is establishing common law rights after the litigation.”³⁵

Accordingly, we construe the Notice of Opposition as having been amended to include the lack of bona fide intent to use claim for purpose of the instant motion. *See NPG Records, LLC v. JHO Intellectual Property Holdings, LLC*, 2022 USPQ2d 770, at *14 n. 28 (TTAB 2022) (pleadings deemed amended where nonmoving party did not object to motion on improperly pleaded claim and treated motion on its merits); *Hole In 1 Drinks*, 2020 USPQ2d 10020 at *6; *Intermed Commc’ns, Inc. v. Chaney*, 197 USPQ at 503 (pleading deemed amended where nonmoving party did not object to motion as seeking judgment on unpleaded claim); TBMP § 528.07(a). We also deem the lack of bona fide intent to use the mark claim to be denied by Applicant.

c. Contractual Estoppel

The ESTTA cover sheet to the Notice of Opposition states, “Registration barred by terms of a settlement agreement and a pending court action in the SDNY.”³⁶ In the Notice of Opposition, Opposer Brigati alleges specifically that the putative assignment of Cavaliere and Cornish’s trademark rights to Applicant in or about January 2018, was a “major decision” under the Agreement and, therefore, was

³⁴ 32 TTABVUE 7-8.

³⁵ *Id.* *See also* Declaration of Opposer Brigati’s counsel, Eric Bjorgum, and exhibits thereto. 32 TTABVUE 9-14.

³⁶ 1 TTABVUE 2.

improper without the consent of the majority of members of the Band.³⁷ In particular, Opposer Brigati alleges, “Cavaliere and Cornish assigned interests and rights of trademarks to [Applicant] that they did not have the right to give to their wholly owned LLC to the exclusion of the Opposers.”³⁸ For the same reason, Opposer Brigati alleges that Applicant’s subsequent filing of the application³⁹ was prohibited under the Agreement.⁴⁰ In view thereof, Opposer Brigati asserts in the Notice of Opposition, “Applicant’s Mark should be rejected because ... it is barred by the terms of the 1992 Settlement Agreement in that Beata’s members cannot register Applicant’s Marks, through Beata, without the consent of the Opposers; and ... because Applicant and Opposers are litigating Applicant’s right to register Applicant’s Mark in the NY Action.”⁴¹

We construe the foregoing allegations pertaining to the 1992 Settlement Agreement as setting forth a claim of contractual estoppel. *See Kimberly-Clark Corp. v. Fort Howard Paper Co.*, 772 F.2d 860, 227 USPQ 36, 38 (Fed. Cir. 1985) (Board has

³⁷ Not. of Opp., ¶¶ 11-12, 28, 30, 1 TTABVUE 6, 10.

³⁸ Not. of Opp., ¶ 18, 1 TTABVUE 7.

³⁹ At Not. of Opp., ¶ 29, 1 TTABVUE 10, Opposer states that in the Prior Action, he alleged that Beata’s “attempt[] to **use** the RASCALS Mark for live performances and merchandising without the consent of Opposers ... breached the 1992 Settlement Agreement” (emphasis added). As will be discussed *infra*, to the extent issues related to use of THE RASCALS mark were addressed in the Prior Action, or may be alleged in this opposition, issues related to use of a mark do not fall within the Board’s jurisdiction. *See, e.g., Person’s Co. v. Christman*, 900 F.2d 1565, 14 USPQ2d 1477, 1481 (Fed. Cir. 1990) (Board cannot adjudicate unfair competition issues); *General Mills Inc. v. Fage Dairy Processing Indus. SA*, 100 USPQ2d 1584, 1591 (TTAB 2011) (no authority to determine the right to use, or the broader questions of infringement, unfair competition, damages or injunctive relief).

⁴⁰ Not. of Opp., ¶¶ 18, 29, 1 TTABVUE 7, 10.

⁴¹ Not. of Opp., ¶ 31, 1 TTABVUE 10.

jurisdiction to consider whether an agreement between the parties constitutes an independent basis for sustaining the opposition).

As noted, Applicant denied the salient allegations in its Answer. Additionally, Applicant argues in its motion, “[b]ased on the Court’s prior rulings, this Opposition should be dismissed, and the Application proceed to registration.”⁴² We construe Applicant’s arguments as both a denial of Opposer’s claim of contractual estoppel and a defense of issue preclusion based on the decisions and findings of the District Court, which it submitted with its cross-motion. *See infra*, Section III.C. of this order.

d. Claim Preclusion (“Res Judicata”) based on Withdrawal with Prejudice of Prior Application for the Same Mark; Invalid Assignment and Application

In his motion for summary judgment, Opposer Brigati argues that Applicant’s registration is prohibited under the doctrine of “res judicata” (also “claim preclusion.”). Specifically, Brigati explains that on April 29, 1988, Cavaliere filed a previous trademark application (“Prior Application”) for the mark The Rascals for “entertainment services in the nature of live performances by a vocal and instrumental group,” Serial No. 73725548;⁴³ Danelli filed an opposition (“Prior Opposition”) to the Prior Application on July 13, 1989;⁴⁴ and the application was abandoned after Cavaliere filed an express abandonment with prejudice.⁴⁵ Opposer Brigati states that Danelli consented to the withdrawal of the application in the Prior

⁴² 32 TTABVUE 7.

⁴³ 31 TTABVUE 11.

⁴⁴ *Id.*

⁴⁵ *Id.*

Proceeding “upon the condition that it is withdrawn with prejudice.”⁴⁶ Based on these allegations, and citing to *Wells Cargo, Inc. v. Wells Cargo, Inc.*, 606 F.2d 961, 203 USPQ 564 (CCPA 1979), Opposer Brigati contends that by withdrawing the Prior Application with prejudice, “Cavaliere had no ability himself or through a controlled entity to seek trademark protection for the very class that was contained in his withdrawn application with prejudice⁴⁷ ... the withdrawal is binding on Beata.”⁴⁸

Thus, Opposer alleges that, under the doctrine of claim preclusion, Cavaliere had no rights in THE RASCALS mark to assign to Applicant in view of the prior judgment against him; Cavaliere could not assign trademark rights to Applicant; and therefore, Applicant’s filing of the application THE RASCALS mark was invalid. We find this claim to be sufficiently pleaded. *See Clorox Co. v. Chem. Bank*, 40 USPQ2d 1098, 1106 (TTAB 1996) (as to invalid assignment); and *Miller Brewing Comp. v. Coy Int’l Corp.*, 230 USPQ 675, 677-78 (TTAB 1986) (as to claim preclusion); *see also Wells Cargo*, 203 USPQ at 963 (by withdrawing its application with prejudice, ... Appellant was estopped from proceeding with its instant application by the doctrine of res judicata. ... Alternatively, the [B]oard treated [the original applicant’s] withdrawal and Opposer’s consent thereto as creating a settlement agreement which barred Appellant, as [the original applicant’s] successor-in-interest, from registering WELLS CARGO.”).

⁴⁶ 31 TTABVUE 11.

⁴⁷ *Id.* at 12.

⁴⁸ *Id.* at 14.

Applicant does not object to Opposer's motion on the basis that claim preclusion is an unpleaded claim. Further, Applicant submitted the following documents:

- a copy of the TESS printout regarding Prior Application Serial No. 73725548 for the mark THE RASCALS, filed on April 29, 1988, by Felix Cavaliere DBA The Rascals, and abandoned on February 22, 1991;⁴⁹
- a copy of a TSDR printout regarding Prior Application Serial No. 73725548, stating in part, "Abandoned after publication because applicant filed an express abandonment;" and stating in part, that Opp. No. 91080806 ("Prior Proceeding"), captioned *Dino Danelli v. Felix Cavaliere*, was abandoned on February 22, 1991;⁵⁰
- a copy of a two-page TTABVUE printout regarding Opp. No. 91080806, including opposition history;⁵¹ and
- a copy of the Notice of Opposition in Opp. No. 91080806.⁵²

In view thereof, for purpose of the instant motion, we construe the Notice of Opposition as having been amended to include the ground of claim preclusion. *See Paramount Pictures Corp. v. White*, 31 USPQ2d 1768, 1772 (TTAB 1994) (pleading deemed amended where nonmoving party did not object to motion as seeking judgment on unpleaded claim), *aff'd mem.*, 108 F.3d 1392 (Fed. Cir. 1997). We also deem this claim to be denied by Applicant.

2) Applicant's Affirmative Defenses

Applicant denies the salient allegations in the Notice of Opposition and, by way of "Affirmative Defenses," alleges "failure to state a claim," "lack of standing," and

⁴⁹ 33 TTABVUE 592.

⁵⁰ *Id.* at 593; *see also id.* at 596-597 (showing opposition history).

⁵¹ *Id.* at 599-600.

⁵² *Id.* at 22-24.

waiver, acquiescence or estoppel, due to Opposer Brigati's alleged failure to participate in live performances, and unclean hands, alleging that Opposer "induced Applicant into performing."⁵³

To the extent Applicant asserts that Opposer did not state a claim upon which relief can be granted, we addressed Opposer's claims, *supra*, and have stricken those claims that are unavailable in this proceeding. In any event, "failure to state a claim" is not a true affirmative defense because it only relates to the sufficiency of a pleading, rather than a statement of a defense to a properly pleaded claim. *See Hornblower & Weeks Inc. v. Hornblower & Weeks Inc.*, 60 USPQ2d 1733, 1738 n.7 (TTAB 2001).

Lack of statutory entitlement also does not constitute an affirmative defense. Statutory entitlement is an element of Opposer's claim, which must be proved as part of Opposer's case. *See, e.g., Shenzhen IVPS Tech. Co. v. Fancy Pants Prods., LLC*, 2022 USPQ2d 1035, at *3 n.5 (TTAB 2022); *see also Empresa Cubana Del Tabaco*, 2022 USPQ2d 1242, *5 n.14 (Lack of entitlement to a statutory cause of action is not a true affirmative defense because it is an essential part of a plaintiff's case and must be proven.); *Blackhorse v. Pro Football Inc.*, 98 USPQ2d 1633, 1637 (TTAB 2011). In view thereof, to the extent Applicant asserts "lack of standing" as an affirmative defense, it will also be given no consideration.

a. "Waiver / Acquiescence / Estoppel"

Turning first to the pleaded equitable defenses of acquiescence and estoppel, these defenses, like laches, are generally not available in opposition proceedings because

⁵³ Answer ¶¶ 34-35, 4 TTABVUE 6.

these defenses start to run from the time the mark is published for opposition, not from the time of knowledge of use of the mark. *See Lincoln Logs, Ltd. v. Lincoln Pre-Cut Log Homes, Inc.*, 971 F.2d 732, 23 USPQ2d 1701, 1703 (Fed. Cir. 1992) (Laches and estoppel are “tied to a party’s registration of a mark, not to a party’s use of the mark”); *Nat’l Cable Television Ass’n Inc. v. Am. Cinema Editors Inc.*, 937 F.2d 1572, 19 USPQ2d 1424, 1432 (Fed. Cir. 1991) (“In an opposition or cancellation proceeding the objection is to the rights which flow from registration of the mark.”); *Panda Travel, Inc. v. Resort Option Enters., Inc.*, 94 USPQ2d 1789, 1797-98 (TTAB 2009) (laches begins to run from publication date, and when an opposition is timely filed, there can be no laches defense based on opposer's knowledge of prior use); *Barbara’s Bakery Inc. v. Landesman*, 82 USPQ2d 1283, 1292 n.14 (TTAB 2007) (defenses of laches, acquiescence or estoppel generally not available in opposition proceeding).

Because Opposers Brigati and Danelli timely filed a Notice of Opposition against Serial No. 87803534, the affirmative defenses of estoppel and acquiescence are not available in this proceeding. In view thereof, these two defenses are **STRICKEN WITH PREJUDICE** from Applicant’s Answer. *See* Fed. R. Civ. P. 12(f)(1)(1).

Regarding Applicant’s alleged defense of waiver, the Board generally assumes that the defendant is attempting to assert a defense based on “estoppel by agreement” or “contractual estoppel,” *i.e.*, that a prior agreement between the parties estops the plaintiff from filing the present opposition or cancellation. *See, e.g., M-5 Steel Mfg. Inc. v. O’Hagin’s Inc.*, 61 USPQ2d 1086, 1095 (TTAB 2001), and cases cited therein. Alternatively, the defending party may allege that the plaintiff actually agreed to the

defendant's use and registration of the mark at issue. *See Conolty v. Conolty O'Connor NYC LLC*, 111 USPQ2d at 1310 (rejecting waiver defense where applicant failed to show that opposer agreed to applicant's use or registration of the opposed mark).

Applicant has not set forth any allegations of "contractual estoppel." Affirmative defenses, like claims in a notice of opposition or petition for cancellation, must be supported by enough factual background and detail to fairly place the plaintiff on notice of the basis for the defenses. *See IdeasOne Inc. v. Nationwide Better Health Inc.*, 89 USPQ2d 1952, 1953 (TTAB 2009); *Ohio State Univ. v. Ohio Univ.*, 51 USPQ2d 1289, 1292 (TTAB 1999) (primary purpose of pleadings "is to give fair notice of the claims or defenses asserted"); *Midwest Plastic Fabricators Inc. v. Underwriters Lab. Inc.*, 5 USPQ2d 1067, 1069 (TTAB 1987) (pleading of unclean hands insufficient as answer did not include "specific allegations of conduct by petitioner that, if proved, would prevent petitioner from prevailing on its claim; instead, the allegations of the fourth affirmative defense are either unclear, non-specific, irrelevant to the pleading of unclean hands, or merely conclusory in nature"). "A party must allege sufficient facts beyond a tender of 'naked assertion[s]' devoid of 'further factual enhancement,' to support its claims." *Ashcroft v. Iqbal*, 556 U.S. 662, 663 (2009) (quoting *Bell Atl. Corp. v. Twombly*, 550 U.S. 544, 570 (2007)). In view thereof, this defense is **STRICKEN** from Applicant's Answer. *See* Fed. R. Civ. P. 12(f)(1)(1).

b. Unclean Hands

Although Opposer Brigati did not address whether Applicant's affirmative defenses are sufficiently pleaded, we find Applicant's defense of unclean hands based

on the allegation that Opposers “induced Applicant into performing,” to be insufficiently pleaded. The phrase, “induced Applicant into performing,” is insufficient to provide adequate notice to either the Board or to Opposer Brigati as to why unclean hands would apply in this proceeding. *See, e.g., Midwest Plastic Fabricators Inc.*, 5 USPQ2d at 1069 (defense of unclean hands found insufficient where it included no specific allegations of conduct that, if proven, would prevent plaintiff from prevailing on its claims); *Tony Lama Co., Inc. v. Di Stefano*, 206 USPQ 176, 179 (TTAB 1980) (the concept of unclean hands must be related to a plaintiff’s claim; misconduct unrelated to the claim against which it is asserted as a defense does not constitute unclean hands). Accordingly, the unclean hands defense is also **STRICKEN** from Applicant’s Answer. *See* Fed. R. Civ. P. 12(f)(1).

c. Reservation of Rights

Applicant’s reservation of the right to amend its answer to add additional affirmative defenses, Answer ¶ 36, *id.* at 7, is insufficient to provide adequate notice to Opposer, and will not be given any consideration. *See Philanthropist.com, Inc. v. Gen. Conf. Corp. of Seventh-Day Adventists*, 2021 USPQ2d 643, at *4 n.6 (TTAB 2021), *aff’d per curiam*, 2022 WL 3147202, No. 21-2208 (Fed. Cir. Aug. 8, 2022); *see also* Fed. R. Civ. P. 12(f)(1).

3) Summary of Remaining Claims and Defenses

In accordance with the foregoing orders, we turn to Opposer Brigati’s motion for partial summary judgment on two of his pleaded or construed claims, namely, claim preclusion and lack of bona fide intent to use the mark, and Applicant’s cross-motion

on its construed defense of issue preclusion in connection with Opposer's statutory entitlement and contractual estoppel claim. None of Applicant's other putative pleaded affirmative defenses will be considered.

C. Summary Judgment Record

In accordance with the Board's order issued on July 26, 2023, Applicant submitted copies of the following documents:⁵⁴

(i) the January 5, 1990 court order regarding the parties' settlement agreement in *Dino Danelli and Gene Cornish v. Felix Cavaliere, et al.* (89 Civ. 3033);⁵⁵

(ii) the April 9, 1992 Settlement Agreement involving all members of The Rascals, regarding litigation in United States District Court for the Southern District of New York, *Brigati v. Cavaliere*, 90 Civ. 6988 (KMW)⁵⁶ and *Cornish and Danelli v. Cavaliere*, 91 Civ. 1928 (KMW);⁵⁷

(iii) the District Court order ("Stipulation and Order of Discontinuance") for consolidated proceedings 90 Civ. 6988 (KMW) and 91 Civ. 1928 (KMW);⁵⁸

(iv) any agreements, documents or correspondence related to the withdrawal of application Serial No. 73725548 by Felix Cavaliere; Applicant submitted only a copy of Trademark Status and Document Retrieval ("TSDR") and Trademark Electronic Search System ("TESS") printouts showing abandonment of that application;⁵⁹

⁵⁴ The original deadline for the required submission was September 15, 2023. 27 TTABVUE 4. The deadline was extended to September 30, 2023. 30 TTABVUE. Applicant's submission of the required documents on Monday, October 2, 2023 was timely. *See* Trademark Rule 2.196, 37 C.F.R. § 2.196. As noted, *supra* footnote 22, Opposer did not submit any documents in the form requested by the Board; rather, Opposer merely refers to previously-submitted documents.

⁵⁵ 33 TTABVUE 2-6.

⁵⁶ See Complaint in 90 Civ. 6988-KMW, *Brigati v. Cavaliere*, 33 TTABVUE 650.

⁵⁷ 33 TTABVUE 7-19.

⁵⁸ *Id.* at 20-21.

⁵⁹ *Id.* at 25-27.

(v) all proceeding documents in Opposition No. 91080806;⁶⁰

(vi) copies of all relevant documents in Prior Action; and

(vii) Complaint and First Amended Complaint in Case 2:18-cv-01536-R-SKx previously pending the U.S. District Court, Central District of California Western Division, between *Beata Music LLC v. Dino Danelli, Eddie Brigati, et al.*

In response to Board requests (vi) and (vii), Applicant submitted the following documents:

- a) Complaint⁶¹ and First Amended Complaint in Case No. 2:18-cv-01536-R-SKx in the U.S. District Court Central District of California Western Division, between *Beata Music LLC v. Danelli, Brigati and DOES 1-10, inclusive*;⁶²
- b) Transfer Order in Case No. 2:18-cv-01536-R-SKx, granting defendants' motion to transfer to the U.S. District Court of the Southern District of New York, stating transfer "would not require the Plaintiff to refile its Complaint ...," Case No. 1:18-cv-06354-JGK.⁶³
- c) Danelli and Brigati's Answer with Counterclaims in Case No. 1:18-cv-06354-JGK to first amended complaint;⁶⁴
- d) Third-Party Complaint for breach of contract by Third-Party Plaintiffs *Danelli and Brigati v. Cavaliere and Cornish*;⁶⁵

⁶⁰ Applicant submitted a copy of the Notice of Opposition, 33 TTABVUE 22-24, as well as TESS and TTABVUE printouts on the opposed application and the history of the opposition proceeding (see *infra*, subparagraph(j) pertaining to Applicant's (First) Motion for Summary Judgment in the Prior Action).

⁶¹ 33 TTABVUE 28.

⁶² *Id.* at 43.

⁶³ *Id.* at 60, 62.

⁶⁴ *Id.* at 64, 76, 80-85 (*see also id.* at 880).

⁶⁵ *Id.* at 86, 131 (*see also id.* at 690, 903).

- e) Plaintiff and Counterclaim Defendant Beata Music's Answer to Defendants' and Counterclaim Plaintiffs' Danelli and Brigati's Counterclaims and Affirmative Defenses;⁶⁶
- f) Order of Discontinuance (based on settlement), dated December 20, 2018, in Case No. 18-cv-06354-JGK, with allowance to reopen within 30 days;⁶⁷
- g) Third Party Defendants' (Cavaliere and Cornish) Answer to Third-Party Plaintiffs' (Danelli and Brigati) Complaint and Affirmative Defenses;⁶⁸
- h) Scheduling Order, Case No. 18-cv-06354-JGK, March 2, 2020;⁶⁹
- i) Memorandum and Opinion and Order on Plaintiff's Motion to Dismiss (re Danelli), dated January 20, 2021;⁷⁰
- j) First Motion for Summary Judgment filed by Counter-Defendant Beata Music, LLC and Third-Party Defendants Cavaliere and Cornish regarding Brigati's "Cross-Claims" (as Third-Party Plaintiff) and Brigati's Counterclaims (filed May 22, 2021).⁷¹

Additionally, Applicant submitted the following documents in connection with its

(First) Motion for Summary Judgment in the Prior Action:

- a) Declaration of Eric Bjorgum in support of Motion for Summary Judgment, with exhibits;⁷²

⁶⁶ 33 TTABVUE 99-106.

⁶⁷ *Id.* at 109.

⁶⁸ *Id.* at 110, 118.

⁶⁹ *Id.* at 121.

⁷⁰ *Id.* at 129, 133, 142-143 (referred to by the District Court as "Beata I."). *Id.* at 1063. The record of the Prior Action shows that this order was issued in connection with the Motion to Dismiss for Lack of Prosecution Counterclaims and Cross-Claims and Motion to Strike Answer and Enter Default, filed by Beata Music, LLC, Felix Cavaliere, and Gene Cornish on November 13, 2020 (entry no. 103), and Beata, LLC's motion for Entry of Default as to Dino Danelli for failure to otherwise defend per FRCP 55(a), filed November 15, 2020 (entry no. 105). 33 TTABVUE 1101.

⁷¹ *Id.* at 144-177.

⁷² *Id.* at 178, 182-224.

- b) Declaration of Felix Cavaliere in support of summary judgment motion, with exhibits,⁷³ including:
 - i. Printed record of settlement hearing in 89 Civ. 3033, January 5, 1990 in *Danelli and Cornish, Plaintiffs, v. Cavaliere, et al.*;⁷⁴
 - ii. Settlement Agreement dated April 9, 1992, between Brigati, Cornish, Danelli, and Cavaliere;⁷⁵
- c) Stipulation and Order of Discontinuance in 90 Civ. 6988 (*Brigati v. Cavaliere*) and 91 Civ. 1928 (*Cornish and Danelli v. Cavaliere*), in the United States District Court, Southern District of New York, executed on April 13, 1992;⁷⁶
- d) Declaration of Obi Steinman in support of summary judgment motion, with exhibits;⁷⁷
- e) Declaration of Gene Cornish in support of summary judgment motion;⁷⁸
- f) Memorandum of Law in Opposition to Motion for Summary Judgment filed by Counter-defendant Beata Music LLC and Third-Party Defendants (Beata, Cavaliere and Cornish);⁷⁹
- g) Declaration of Michael B. Kramer (Opposer Brigati's counsel) in opposition to motion for summary judgment, and exhibits 1-44,⁸⁰ including Articles of Organization for Beata Music LLC, demand letter to Applicant's counsel (Bjorgum and Karish), Complaint in *Danelli and Cornish, Plaintiffs, v. Cavaliere, Beccia and ICM, Inc.*, Case No. 89 Civ. 3033 in the United States District Court, Southern District of New York;⁸¹

⁷³ 33 TTABVUE 225, 234.

⁷⁴ *Id.* at 236.

⁷⁵ *Id.* at 242-254.

⁷⁶ *Id.* at 255.

⁷⁷ *Id.* at 257-318.

⁷⁸ *Id.* at 319.

⁷⁹ *Id.* at 746-769.

⁸⁰ *Id.* at 325, 334-707; *see also id.* at 372, 375.

⁸¹ *Id.* at 505-15; *see also* related affidavits of parties, *id.* at 517-584.

- h) Brigati Affidavit in opposition to Motion for Summary Judgment;⁸²
- i) Brigati's Rule 56.1 Response to Beata Music, Cavaliere and Cornish's Statement of Material Facts;⁸³
- j) USPTO TESS printouts (updated June 8, 2021) regarding pleaded registrations in this proceeding, No. 1919353 for the mark YOUNG RASCALS for "musical sound recordings," and No. 1917707 for the mark RASCALS for "musical sound recordings";⁸⁴
- k) Notice of Opposition in Opposition No. 91080806, *Danelli v. Cavaliere*;⁸⁵
- l) TESS printout regarding application Serial No. 73725548, abandoned February 22, 1991, filed by Cavaliere, and Opposition No. 91080806, *Danelli v. Cavaliere*;⁸⁶ and
- m) Memorandum Opinion and Order dated January 6, 2022, Beata's (First) Motion for Summary Judgment granted; and Brigati's counterclaims dismissed.⁸⁷

Applicant submitted the following documents related to its (Second) Motion for Summary Judgment or issued in the Prior Action subsequent to that motion:

- a) Order in Case No. 1:18-cv-06354-JGK, dated March 8, 2022, requiring Plaintiff to file a motion for summary judgment;⁸⁸

⁸² 33 TTABVUE 708-720.

⁸³ *Id.* at 721-745.

⁸⁴ *Id.* at 586-590.

⁸⁵ *Id.* at 22-24.

⁸⁶ *Id.* at 592-600.

⁸⁷ *Id.* at 770-97 (referred to by the District Court as "Beata II," *id.* at 1062).

"The Court concluded in Beata II that Brigati's breach of contract claim with respect to the 1990 agreement failed as a matter of law because (1) Brigati failed to offer any evidence of damages, and (2) Brigati was neither a party to the 1990 agreement nor an intended third-party beneficiary of that agreement. See 2022 WL 61862, at *5. "Brigati therefore has no enforceable rights arising from the 1990 agreement ... res judicata would prevent Danelli from asserting against Cavaliere or Cornish any claim relating to the 1990 agreement that was, or could have been, raised in this action." 33 TTABVUE 1076-77.

⁸⁸ *Id.* at 1012-13.

- b) BEATA MUSIC's (Second) Motion for Summary Judgment filed on March 22, 2022;⁸⁹
- c) Brigati declaration in opposition to Motion for Summary Judgment;⁹⁰
- d) Opposition to Beata Music's Second Motion for Summary Judgment;⁹¹
- e) Memorandum Opinion and Order on (Second) Motion for Summary Judgment, dated May 10, 2022, considered second motion for summary judgment on Beata's claims and its motion for attorneys' fees;⁹²
- f) Final Judgment Order in Case No. 1:18-cv-06354-JGK, dated May 31, 2022;⁹³ and
- g) Civil Docket for Case No. 1:18-cv-06354-JGK.⁹⁴

We have reviewed the Docket Report for the civil action submitted by Applicant and determined that no appeal was filed from the District Court's May 10, 2022 Final Judgment Order. It therefore is final. *Piano Wellness, LLC v. Williams*, 126 USPQ2d 1739, 1740-41 (TTAB 2018).

D. Motions for Partial Summary Judgment

Opposer Brigati seeks summary judgment on his lack of bona fide intent to use the mark claim and claim preclusion in connection with Cavaliere's previous trademark application for the same mark that was abandoned with prejudice. With respect to his statutory entitlement, Opposer Brigati also argues that the District

⁸⁹ 33 TTABVUE 1014.

⁹⁰ *Id.* at 1032-39.

⁹¹ *Id.* at 1040-60.

⁹² *Id.* at 1062-1069, 1069-78.

⁹³ *Id.* at 1081-83.

⁹⁴ *Id.* at 1084-1114.

Court's determination that Brigati has no rights in THE RASCALS mark in connection with live performances does not preclude Brigati from filing this opposition under issue preclusion.⁹⁵ Because Applicant asserts its construed defense of issue preclusion in connection with both Opposer's statutory entitlement and its contractual estoppel claim, for judicial efficiency, we address Opposer's entitlement and Applicant's defense in the same section of this order.

1) Opposer's Statutory Entitlement

In every Board inter partes case, the plaintiff must first demonstrate that it is entitled to a statutory cause of action under Sections 13 or 14 of the Trademark Act. To establish such statutory entitlement, the plaintiff must demonstrate a real interest in the proceeding and a reasonable belief of damage. *Australian Therapeutic Supplies Pty. Ltd. v. Naked TM, LLC*, 965 F.3d 1370, 2020 USPQ2d 10837 at *3 (Fed. Cir. 2020); *see also Corcamore, LLC v. SFM, LLC*, 2020 USPQ2d 11277, at *6-7 (discussing the application of the zone-of-interests and proximate causation test under *Lexmark Int'l, Inc. v. Static Control Components, Inc.*; *Empresa Cubana Del Tabaco v. Gen. Cigar Co.*, 753 F.3d 1270, 111 USPQ2d 1058 (Fed. Cir. 2014); *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1727 (Fed. Cir. 2012); *Ritchie v. Simpson*, 170 F.3d 1092, 50 USPQ2d 1023, 1025 (Fed. Cir. 1999).

Opposer Brigati pleaded his entitlement to a statutory cause of action by asserting joint ownership of the RASCALS Mark and the YOUNG RASCALS Mark, and that “[t]he Band Members Marks trademark registrations are active and were renewed

⁹⁵ 32 TTABVUE 3-7.

July 2015.”⁹⁶ In its Answer to those allegations, “Applicant admits that certain Registrations are jointly owned” and “that certain marks were renewed in [sic] July 15.”⁹⁷ No other trademark registrations are identified in the Notice of Opposition.⁹⁸

We construe Applicant’s Answer as admissions that the pleaded registrations are jointly owned and that said registrations were renewed in July 2015. *See Viacom Int’l Inc. v. Komm*, 46 USPQ2d 1233, 1235 n.4 (TTAB 1998) (noting that the Answer was not “couched in the normal language for an answer[, t]he Board advised the parties that it would construe the response as an admission of the allegations of paragraphs 1-9 of the notice, and a denial of the allegations of paragraphs 10 and 11.”); *Freedom Savings and Loan Ass’n v. Am. Fidelity Assurance Co.*, 222 USPQ 71, 72 n.3 (TTAB 1984) (“we construe applicant’s equivocal admission in paragraph (4) of its answer as an admission of opposer’s ownership of this registration.”).

Additionally, Applicant submitted with its motion to dismiss a copy of the District Court’s Memorandum Opinion and Order in the Prior Action⁹⁹ on Applicant’s (as Plaintiff in the Prior Action) first motion for summary judgment, in which the District Court made, inter alia, the following factual findings:

⁹⁶ Not. of Opp., ¶¶ 16-17, 1 TTABVUE 6-7.

⁹⁷ Answer ¶¶ 16 and 17 (first sentence and phrase, respectively), 4 TTABVUE 4.

⁹⁸ We note that Applicant, as Plaintiff and Counterclaim-Defendant in the Prior Action, similarly admitted that the trademarks THE RASCALS and YOUNG RASCALS were registered. Answer to Counterclaims, ¶¶ 16-17, 33 TTABVUE 89, 101.

⁹⁹ *Beata Music LLC, Plaintiff v. Danelli, Brigati, et. al, Defendants, and Danelli and Brigati, Third-Party Plaintiffs, v. Cavaliere and Cornish, Third-Party Defendants*, 18-cv-634 (JGK), 2022 WL 61862, *3 (S.D.N.Y. January 6, 2022); *see also* 33 TTABVUE 770. We note that Opposer Brigati submitted and referred to said order in its May 17, 2023 submission to the Board. 26 TTABVUE 4, 11.

The four original band members—Brigati, Cornish, Danelli, and Cavaliere—formed a “pass through” partnership in New Jersey that distributes the revenue from the groups publishing and performance rights. ... **This partnership also owns the rights to the RASCALS and YOUNG RASCALS marks for musical sound recordings.** ...¹⁰⁰
The parties agree that the Young Rascals partnership, of which Brigati is a member, owns trademarks in the RASCALS and YOUNG RASCALS marks for musical sound recordings.¹⁰¹

Applicant’s evidence may be relied on by Opposer for any purpose, and we may consider Applicant’s evidence for whatever probative value it may have in connection with Opposer’s motion for summary judgment. *See* Trademark Rule 2.122(a), 37 C.F.R. § 2.122(a); *see also* *Nazon v. Ghiorse*, 119 USPQ2d 1178, 1181 n.6 (TTAB 2016) (“Once evidence is properly of record, it may be relied on by any party for any purpose.”); *cf.* TBMP § 704.07 (Board may consider materials where adverse party does not object or itself treats the materials as being of record). Additionally, the District Court recognized “[t]hat Brigati continues to receive royalties from the group’s recorded music”¹⁰²

Applicant does not dispute the factual findings of the District Court that the four band members, including Brigati, own the registrations for musical recordings. *Cf.* *Threshold.TV, Inc. & Blackbelt TV, Inc. v. Metronome Enter., Inc.*, 96 USPQ2d 1031, 1034 (TTAB 2010) (Applicant’s objection to the California district court’s memorandum and order is overruled because applicant itself relies on this memorandum and order in its brief.).

¹⁰⁰ 33 TTABVUE 774 (emphasis added).

¹⁰¹ *Id.* at 785; *see also* note 11 at 33 TTABVUE 788 (“All parties agree that the Young Rascals partnership owns the YOUNG RASCALS mark for musical sound recordings.”).

¹⁰² 33 TTABVUE 787.

In view of Applicant's admissions and above-identified factual findings made by the District Court, and because the Board must give deference to the determinations of the District Court, we find there is no genuine dispute that Opposer Brigati is one of the joint owners of the pleaded registrations for the RASCALS and YOUNG RASCALS marks. *See DaimlerChrysler Corp. v. Maydak*, 86 USPQ2d 1945 (TTAB 2008) (To the extent that a civil action in a Federal district court involves issues in common with those in a proceeding before the Board, the decision of the Federal district court is binding upon the Board.).

We note, however, Applicant argues that Brigati is precluded from opposing registration of THE RASCALS mark by issue preclusion because the District Court in the Prior Action determined that Brigati had abandoned his rights in the RASCALS mark.¹⁰³ In particular, the District Court determined, in part, that "Brigati has abandoned his interest in the RASCALS mark,"¹⁰⁴ and Brigati "has [no] enforceable rights in the RASCALS mark."¹⁰⁵

We disagree with Applicant's contention that issue preclusion applies in this instance. On the contrary, for the reasons discussed below, we find there is no genuine dispute as to the material fact that certain of the District Court's determinations in the Prior Action were **not** necessary in entering judgment against Brigati in the Prior Action and, therefore, issue preclusion does not apply to this proceeding.

¹⁰³ 32 TTABVUE 7-8.

¹⁰⁴ *Id.* at 788.

¹⁰⁵ *Id.* at 1074.

Under the doctrine of issue preclusion, re-litigation of the same issue is barred in a later action. *See B&B Hardware, Inc. v. Hargis Indus., Inc.*, 113 USPQ2d 2045, 2051 (2015); *Mayer/Berkshire Corp. v. Berkshire Fashions, Inc.*, 424 F.3d 1229, 76 USPQ2d 1310, 1312 (Fed. Cir. 2005); *NH Beach Pizza LLC v. Cristy's Pizza Inc.*, 119 USPQ2d 1861, 1863 (TTAB 2016). Issue preclusion generally refers to the effect of a prior judgment in foreclosing successive litigation of an issue of fact or law actually litigated and resolved in a valid court determination essential to the prior judgment, whether or not the issue arises on the same or a different claim. *New Hampshire v. Maine*, 532 U.S. 742, 748-49, 121 S. Ct. 1808, 1814 (2001) (citing Restatement (Second) of Judgments §§ 17, 27, pp. 148, 250 (1980)).

In order for issue preclusion to apply on summary judgment, the moving party must establish that there is no genuine dispute of material fact regarding the four elements set forth below:

- (i) Identity of an issue in the current and prior proceeding;
- (ii) Actual litigation of that issue in the prior proceeding;
- (iii) That determination was necessary in entering judgment in the prior proceeding; and
- (iv) That the party with the burden of proof on that issue in the second proceeding had a full and fair opportunity to litigate the issue in the prior proceeding.

See NH Beach Pizza, 119 USPQ2d at 1864 (citing *Montana v. United States*, 440 U.S. 147, 153-54 (1979)); *see also Parklane Hosiery*, 439 U.S. at 326 n.5 (1979). Whether issue preclusion applies to bar an action is a question of law. *Levi Strauss & Co. v. Abercrombie & Fitch Trading Co.*, 719 F.3d 1367, 107 USPQ2d 1167, 1171

(Fed. Cir. 2013). Accordingly, when the facts material to issue preclusion are not in dispute, summary judgment is appropriate. Fed. R. Civ. P. 56(a). *NH Beach Pizza*, 119 USPQ2d at 1863.

- **Third Issue Preclusion Factor**

- **Ambiguity**

In the District Court’s Memorandum Opinion and Order on Applicant’s (as Plaintiff in the Prior Action) first motion for summary judgment¹⁰⁶ regarding Brigati’s claims, the District Court determined, inter alia, that Brigati’s breach of contract claim pertaining to the 1992 Settlement Agreement¹⁰⁷ “fails for the independent reason that the 1992 agreement does not address live performances and it does not supersede the 1990 agreement.”¹⁰⁸ To reach its conclusions, the District Court focused primarily on the single paragraph in the 1992 agreement that provides: “all major decisions (i.e. those involving decisions not in the normal course of business such as decisions involving audits and litigation) shall be made by a majority vote of Brigati, Cornish, Danelli and Cavaliere.”¹⁰⁹ The District Court stated as follows:

That provision does not apply to these circumstances. First, Brigati has offered no evidence that **the use of the RASCALS mark or the use of Brigati’s likeness** constitute “major decisions” akin to audits and litigation, as distinguished from “decisions in the normal course of

¹⁰⁶ 33 TTABVUE 770.

¹⁰⁷ In addressing Brigati’s breach of contract claim pertaining to the 1990 Stipulation Agreement, “[t]he terms of the 1990 agreement address only how Danelli, Cornish, and Cavaliere may use The Rascals name.” Brigati was not a party thereto and failed to establish that he was an intended beneficiary, and he cannot enforce that agreement. 33 TTABVUE 781-82.

¹⁰⁸ 33 TTABVUE 782.

¹⁰⁹ *Id.* at 783; *see also id.* at 11 (subparagraph (iii)).

business (e.g. involving non-exclusive licenses of Rascals assets¹¹⁰.)” Moreover, the provision Brigati relies on is inoperative because at no relevant time was there a business advisor, a written notice of any decision, or a vote by any of the band members-which would have been required within ten days of any notice. **Brigati seeks to fall back on New York partnership law, but New York partnership law is inapplicable because the band members’ partnership, the Young Rascals, was formed under New Jersey law.**¹¹¹

Initially, the District Court’s order is ambiguous because elsewhere in the order, it recognized that in the choice-of-law provision of the agreement, the parties had identified New York law.¹¹²

Next, the order is ambiguous because the District Court only mentions, “the use of the RASCALS mark or the use of Brigati’s likeness,” as not being a “major decision.” It does not state specifically whether filing an application for a trademark registration by only two of the four band members is a “major decision,” which is inconsistent with its other finding, discussed *infra*, that all four band members, including Brigati, own the trademark registrations for RASCALS and THE RASCALS. Further, the Court did not take into account that subparagraph (iii), discussed above, was part of section “c.,” in which all band members agreed that “**all decisions**” concerning the commercial exploitation of The Rascals assets shall be made as follows”¹¹³ *Cf. Meem-Haskins Coal Corp. v. Central Fuel Corp.*, 137 F.2d

¹¹⁰ This example refers to subparagraph 2.c.(ii) of the 1992 Settlement Agreement (Administration of the Rascals Assets). 33 TTABVUE 243.

¹¹¹ *Id.* at 783 (emphasis added).

¹¹² *Id.* at 778. *See also* Agreement, Section 7 (“Governing Law and Arbitration”), 33 TTABVUE 250.

¹¹³ *Id.* at 244 (emphasis added).

242, 58 USPQ 605, 608-09 (CCPA 1943) (“[I]t often happens that by virtue of the conduct of the parties, more than one may use a trade-mark, but only one can have ownership of it in a trade-mark registration sense.”); *Durango Herald Inc. v. Riddle*, 719 F. Supp. 941, 11 USPQ2d 1052, 1055 (D. Colo. 1988) (“one partner may not exploit the unique assets of the joint venture to the detriment of the other ... Both Herald and Riddle have reciprocal duties not to use the primary asset of the ‘DIRECTORY PLUS’ joint venture for their individual benefit in a manner which burdens or injures only the other party”).

As regards the 1992 Settlement Agreement, the foregoing ambiguities in the District Court’s order are alone sufficient to find that issue preclusion is inapplicable. *See City of Cleveland v. Cleveland Elec. Illuminating Co.*, 538 F.Supp. 1227, 1230 (N.D. Ohio 1980) (“[I]t cannot reasonably be denied that serious ambiguity exists with respect to the actual findings underlying the Appeal Board’s decision.... It is equally apparent that collateral estoppel cannot properly obtain where, as here, the underlying decision in the prior proceeding is entirely ambiguous as to the factual findings necessary to support it. ... In view of the manifest ambiguities permeating the resolution of the Appeal Board, as described above, the Court is constrained to emphasize once again its unwillingness to ‘become a party to this administrative chaos;’ holding that doctrine of collateral estoppel did not require that conclusive effect.”) *see also U.S. Bank, Nat. Ass’n v. First Am. Title Ins. Co.*, 944 F.Supp.2d at 394 (E.D. Pa. 2013) (“If even one element is not present, a court should not apply

issue preclusion to the case.”) (citing *United States v. School District of Ferndale*, 577 F.2d 1339, 1349-50 (6th Cir. 1978)).

○ **Multiple Bases for Order**

The District Court also determined that Brigati’s breach of contract claims failed because Brigati did not provide a damages calculation, as required, nor did he explain why he failed to provide the requisite calculation.¹¹⁴ Because Brigati neither demonstrated why he failed to provide any calculation of damages, nor demonstrated that he was capable of doing so, pursuant to the sanctions provisions of Fed. R. Civ. P. 37(c)(1), the District Court precluded Brigati from offering any damages evidence.¹¹⁵ In view thereof, the District Court stated that Brigati’s breach of contract claim failed as a matter of law.¹¹⁶ Similarly, Brigati’s false designation of origin claim under Trademark Act Section 43(a), 15 U.S.C. § 1125(a), also failed because the District Court determined that Brigati could not establish “statutory standing” in view of his inability to demonstrate either commercial or reputational damages.¹¹⁷

Therefore, for purposes of determining whether issue preclusion applies to this opposition, regardless of the factual findings identified by Applicant on which the District Court partly based its decision to dismiss Brigati’s breach of contract and false designation of origin claims, the District Court explicitly identified more than

¹¹⁴ 33 TTABVUE 779-780.

¹¹⁵ *Id.* at 780.

¹¹⁶ *Id.*

¹¹⁷ *Id.* at 793.

one “independent reason”¹¹⁸ for dismissing those claims. “[W]here the court in the prior suit has determined two issues, either of which could independently support the result, then neither determination is considered essential to the judgment. Thus, collateral estoppel will not obtain as to either determination.” *In re Microsoft Corp. Antitrust Litig.*, 355 F.3d 322, 328 (4th Cir. 2004) (citing *Ritter v. Mount St. Mary’s Coll.*, 814 F.2d 986, 993 (4th Cir.1987)); *see also U.S. Bank, Nat. Ass’n v. First Am. Title Ins. Co.*, *U.S. Bank, Nat. Ass’n v. First Am. Title Ins. Co.*, 944 F.Supp.2d 386, 394 (E.D. Pa. 2013), *aff’d sub nom. U.S. Bank Nat. Ass’n v. First Am. Title Ins. Corp.*, 570 F. App’x 209 (3d Cir. 2014) (If issues are determined but the judgment is not dependent upon the determinations, relitigation of those issues in a subsequent action between the parties is not precluded. Such determinations have the characteristics of dicta, and may not ordinarily be the subject of an appeal by the party against whom they were made.) (citing Restatement (Second) of Judgments § 27 cmt.h. (1982)); *Comair Rotron, Inc. v. Nippon Densan Corp.*, 49 F.3d 1535, 33 USPQ2d 1929, 1931 (Fed. Cir. 1995) (issue preclusion did not apply because finding of infringement was not essential to the damages decision in prior action).

In view of the foregoing, we find no genuine dispute as to the material fact that the third factor for issue preclusion is not fulfilled with respect to Opposer’s contractual estoppel claim.

¹¹⁸ 33 TTABVUE 781, 793.

- **First Issue Preclusion Factor**

As regards the first issue preclusion factor, namely, whether the involved issue in the current and prior proceeding are identical, for the following reasons, we find that the issue of whether Brigati has a continuing right in the RASCALS mark is not the same in the Prior Action and in this proceeding. Specifically, the District Court considered facts and legal issues not involved in Board proceedings. For instance, in Board proceedings, the plaintiff is not required to plead or prove actual damages. *See Books on Tape Inc. v. Booktape Corp.*, 836 F.2d 519, 5 USPQ2d 1301 (Fed. Cir. 1987); *Jewelers Vigilance Committee Inc. v. Ullenberg Corp.*, 823 F.2d 490, 2 USPQ2d 2021 (Fed.Cir.1987); *Int'l Order of Job's Daughters v. Lindeburg & Co.*, 727 Fed.2d 1087, 220 USPQ 1017 (Fed. Cir. 1984). In further contrast to Board proceedings, in considering Brigati's trademark infringement claim in the first summary judgment order and Applicant's (as Plaintiff in the Prior Action) claim seeking a declaratory judgment for lack of trademark infringement¹¹⁹ in the second summary judgment order, it is clear that the District Court's analysis of Brigati's common law rights in the RASCALS mark was related solely to whether Brigati **used** THE RASCALS over the years by **performing** in connection with the mark. For instance, the Court concluded, "Brigati cannot establish deliberate and continuous use of the RASCALS mark after he left the band in 1970."¹²⁰ In making these findings the District Court explicitly stated in its decision it was not deciding the right to register and leaving that to the Board.¹²¹

¹¹⁹ By its first claim, Applicant sought a declaratory judgment that Applicant is the owner of the RASCALS mark; the District Court denied summary judgment on Applicant's first claim,

Our conclusion regarding the limited scope of the District Court’s findings is supported by the final decision in which the District Court stated, “neither Dino Danelli nor Eddie Brigati has any enforceable rights in the RASCALS mark **for live performances**” and “Beata’s **use** of the RASCALS mark for **live performances** and the sale of merchandise at those performances does not constitute false designation of origin with respect to Brigati or Danelli.”¹²² As previously discussed, the false designation of origin finding in the district court decision was based on Brigati’s inability to demonstrate either commercial or reputational damages; in Board proceedings, a plaintiff is not required to plead or prove actual damages.

The Board is not authorized to determine the right to use, nor may it decide broader questions of infringement or unfair competition. *See FirstHealth of the Carolinas Inc. v. CareFirst of Md. Inc.*, 479 F.3d 825, 81 USPQ2d 1919, 1921 (Fed. Cir. 2007). The Board is empowered to determine only the right to register. *See* Trademark Act Sections 17, 18, 20 and 24, 15 U.S.C. §§ 1067, 1068, 1070, and 1092;

finding that issues of fact remain regarding whether Cavaliere had any common law rights in the RASCALS mark for live performances to assign to Applicant and whether any such rights survive today. 33 TTABVUE 1073. In its fifth claim, Applicant sought a finding of “dilution” due to Danelli and Brigati impeding Cornish and Cavaliere’s opportunities to perform, 33 TTABVUE 55, which was dismissed without prejudice. 33 TTABVUE 1075. In its sixth claim, Applicant sought a declaratory judgment regarding “the rights of the parties when Cavaliere and Cornish play under the name ‘The Rascals,’ vis-à-vis Danelli’s claimed rights under the 1990 Settlement Agreement and Brigati’s claimed rights. Amended Complaint (First – Sixth Claims for Relief), ¶¶ 48-55, 33 TTABVUE 51-56. Applicant also sought injunctive relief. *Id.* at 56-57.

¹²⁰ 33 TTABVUE 788; *see also id.* at 129, 1072.

¹²¹ 33 TTABVUE 796.

¹²² Final Judgment Order in Case No. 1:18-cv-06354-JGK, dated May 31, 2022, *id.* at 1081-1082 (emphasis added).

see also Person's Co. v. Christman, 14 USPQ2d at 1481 (Board cannot adjudicate unfair competition issues); *Gen. Mills Inc. v. Fage Dairy Processing Indus. SA*, 100 USPQ2d at 1591 (no authority to determine the right to use, or the broader questions of infringement, unfair competition, damages or injunctive relief); *McDermott v. San Francisco Women's Motorcycle Contingent*, 81 USPQ2d 1212, 1216 (TTAB 2006) (“[T]he Board’s jurisdiction is limited to determining whether trademark registrations should issue or whether registrations should be maintained.”). The Board may consider a contract, its construction, or its validity in determining the right to register. *See Selva & Sons, Inc. v. Nina Footwear, Inc.*, 217 USPQ at 647; *Bausch & Lomb Inc. v. Karl Storz GmbH & Co. KG*, 87 USPQ2d 1526, 1530-31 (TTAB 2008); *M-5 Steel Mfg. Inc. v. O'Hagin's Inc.*, 61 USPQ2d at 1094-95.

Additionally, other than finding, “[t]he parties agree that the Young Rascals partnership, of which Brigati is a member, owns trademarks in the RASCALS and YOUNG RASCALS marks for musical recordings,”¹²³ the District Court made no findings of fact, nor did it issue any orders or decisions regarding whether the applied-for mark in this proceeding could be registered. In fact, the District Court stated explicitly, “[t]he Court takes no position on how the Trademark Trial and Appeal Board should dispose of Beata’s intent-to-use trademark application for the RASCALS mark for live performances and related clothing.”¹²⁴ The District Court also stated, “The Trademark Trial and Appeal Board can address this issue [of

¹²³ 33 TTABVUE 785.

¹²⁴ Memorandum Opinion and Order dated January 6, 2022, granting Beata’s (First) Motion for Summary Judgment, 33 TTABVUE 796.

Cavaliere's prior application] in the first instance in determining whether to grant Beata's trademark application."¹²⁵

Likewise, although the District Court recognized Brigati's ownership right of the RASCALS and YOUNG RASCALS registrations,¹²⁶ it did not consider whatsoever Opposer's Brigati's presumptive rights in connection with those registrations. Under Trademark Act Section 7(b), 15 U.S.C. § 1057(b), a certificate of registration of a mark upon the Principal Register is prima facie evidence of the validity of the registered mark, the identified owner's ownership of the mark, and the owner's exclusive right to use the mark in commerce on or in connection with the goods or services specified in the certificate of registration. These presumptions under Section 7(b) accrue only to the benefit of the owner or owners of those registrations. *See Massey Junior Coll., Inc. v. Fashion Inst. of Tech.*, 492 F.2d 1399, 181 USPQ 272 (CCPA 1974); *see also Fluid Energy Processing & Equip. Co. v. Fluid Energy, Inc.*, 212 USPQ 28, 35 (TTAB 1981) (“[A]bsent the existence of a registration and the presumptions attendant thereto under Section 7(b) ... a party claiming to be aggrieved under Section 2(d) cannot prevail where he has not proved a prior and proprietary right in the term or designation on which it relies.”).

In view of the foregoing, we find no genuine dispute as to the material fact that the first factor for issue preclusion is not fulfilled because the facts at issue in the Prior Action and this proceeding are different. *See Montana v. U.S.*, 440 U.S. 147, 159

¹²⁵ 33 TTABVUE 796.

¹²⁶ *Id.* at 774.

(1979) (“[C]hanges in facts essential to a judgment will render collateral estoppel inapplicable in a subsequent action raising the same issues.”); *Levi Strauss & Co. v. Blue Bell, Inc.*, 778 F.2d 1352, 1357 228 USPQ 346, 349 (9th Cir.1985) (en banc) (“Similarity between issues does not suffice: collateral estoppel is applied only when the issues are identical. ... If different facts are in issue in a second case from those that were litigated in the first case, then the parties are not collaterally estopped from litigation in the second case.”).

Based on our application of the issue preclusion factors to this matter, we find that the District Court’s alternative determinations (i.e., that Brigati had abandoned any trademark rights or had no enforceable rights in the RASCALS marks, as opposed to its final determination that Brigati does not have “any enforceable rights in the RASCALS mark for live performances”) were not essential and necessary to the final judgment in the Prior Action, and that the factual issues involved in the Prior Action and in this proceeding are not identical. Further, Applicant has failed to demonstrate the absence of any genuine dispute as to any material fact showing that issue preclusion applies to the District Court’s findings regarding Brigati. We, therefore, conclude as a matter of law that Brigati is not precluded from pursuing this opposition by the findings of the District Court in the Prior Action and that Opposer’s contractual estoppel claim and claim preclusion claims are not barred by issue preclusion. Accordingly, Applicant’s motion for partial summary judgment on its defense of issue preclusion is **GRANTED**, *sua sponte*, in favor of Opposer Brigati. *See* Fed. R. Civ. P. 56(f)(1).

- **Order regarding Statutory Entitlement**

Because Opposer Brigati’s opposition is not barred by issue preclusion, in view of the District Court’s findings regarding Brigati’s financial interest in the musical recordings made by the Rascals and his joint ownership interest in the pleaded registrations for RASCALS and YOUNG RASCALS marks, we find there is no genuine dispute as to the material fact that Brigati has a direct personal commercial interest in the RASCALS mark and in this proceeding, and that he has demonstrated his entitlement to a statutory cause of action. *See, e.g., Meenaxi Enter., Inc. v. Coca-Cola Co.*, 38 F.4th 1067, 1072 (Fed. Cir. 2022) (citing *Lexmark Int’l*) (the zone-of-interest “test is not especially demanding, ... requir[ing] an allegation of “injury to a commercial interest in reputation or sales.”); *Herbko Int’l v. Kappa Books*, 308 F.3d 1156, 64 USPQ2d 1375, 1377 (Fed. Cir. 2002) (“In most settings, a direct commercial interest satisfies the ‘real interest’ test.”); *UVeritech, Inc. v. Amax Lighting, Inc.*, 115 USPQ2d 1242, 1244 (TTAB 2015) (a dispute over ownership of a mark establishes entitlement to bring a statutory cause of action).

Further, once statutory entitlement is sufficiently alleged (and established) for one claim it is established for all claims. *Corporacion Habanos SA v. Rodriquez*, 99 USPQ2d 1873, 1877 (TTAB 2011); *Enbridge, Inc. v. Excelerate Energy LP*, 92 USPQ2d 1537, 1543 n.10 (TTAB 2009) (citing *Liberty Trouser Co., Inc. v. Liberty & Co., Ltd.*, 222 USPQ 357, 358 (TTAB 1983)).

2) Contractual Estoppel

As noted supra, Opposer Brigati alleges that the putative assignment of Cavaliere and Cornish's trademark rights to Applicant was a "major decision" under the parties' 1992 Settlement Agreement and, therefore, was improper without the consent of the majority of members of the Band.¹²⁷ For the same reason, Opposer Brigati alleges that Applicant's subsequent filing of the opposed application was prohibited under the Agreement.¹²⁸ In view thereof, Opposer Brigati asserts that registration should be refused. As discussed, Applicant argued that the District Court's findings bar Opposer Brigati's claims under issue preclusion, and we have determined that, as a matter of law, issue preclusion does not affect Opposer Brigati's claims. In view thereof, and given that Applicant submitted all relevant orders issued by the District Court in the Prior Action and both parties rely on those documents, for judicial economy, we address Opposer Brigati's contractual estoppel claim. *See* Fed. R. Civ. P. 56(f)(2).

"[W]hether a mark otherwise entitled to registration is, nevertheless, **barred** therefrom by an agreement between the parties ... [is an issue] within the jurisdiction of the [B]oard and may constitute an independent basis for sustaining the opposition" *Kimberly-Clark Corp. v. Fort Howard Paper Co.*, 227 USPQ at 38 (emphasis original). The Board may consider "the agreement, its construction, or its validity if necessary to decide the issues properly before [the Board] ... including the issue of

¹²⁷ Not. of Opp., ¶¶ 11-12, 28, 30, 1 TTABVUE 6, 10.

¹²⁸ Not. of Opp., ¶¶ 18, 29, 1 TTABVUE 7, 10.

estoppel.” See *M-5 Steel Mfg. Inc. v. O’Hagin’s Inc.*, 61 USPQ2d at 1095 (quoting *Selva & Sons, Inc. v. Nina Footwear, Inc.*, 217 USPQ at 647). Construction of a contract is a question of law and therefore, resolution of the meaning and interpretation of a contract is appropriate on summary judgment. *Bausch & Lomb Inc.*, 87 USPQ2d at 1530.

The 1992 Settlement Agreement contains a choice-of-law-clause stating that the agreement shall be construed in accordance with the laws of New York.¹²⁹ We accordingly look to that jurisdiction for precedent on substantive, non-trademark issues. “It is well settled that [t]he interpretation of an unambiguous contractual provision is a function for the court ..., and [t]he proper inquiry in determining whether a contract is ambiguous is whether the agreement on its face is reasonably susceptible of more than one interpretation ... To be entitled to summary judgment, the moving party has the burden of establishing that its construction of the [contract] is the only construction [that] can fairly be placed thereon.” *Centerline/Fleet Hous. P/ship, L.P.–Series B v. Hopkins Ct. Apts., LLC*, 195 A.D.3d 1375, 1376-77, 151 N.Y.S.3d 272 (2021 N.Y. Slip. Op. 03677) (internal citations omitted).

Here, under Section 2 of the Settlement Agreement (titled “Administration of the Rascals Assets”),¹³⁰ the four band members specifically agreed, inter alia, “that all

¹²⁹ 33 TTABVUE 778.

¹³⁰ *Id.* at 8.

decisions concerning the commercial exploitation¹³¹ of The Rascals assets shall be made” in a certain manner, as set forth in Subsections 2.c.(i)-(iii).¹³²

Further, under subsection 2c.(ii), it is unambiguous that the band members’ designated Business Adviser¹³³ would decide “all decisions in the normal course of business (e.g., involving non-exclusive licenses of Rascals assets).”¹³⁴ Likewise, pursuant to subsection 2.c.(iii), it is unambiguous that “all major decisions (i.e., [those involving audits and litigation]) shall be made by a majority vote of Brigati, Cornish, Danelli and Cavaliere”¹³⁵ The inverse of the example provided in subsection 2.c.(ii) of the agreement also is not reasonably susceptible of more than one interpretation, specifically, any decision involving an exclusive license of a

¹³¹ We take judicial notice of the definition of “exploit,” which means “to make productive use of: utilize or to get value or use from.” See Definition of exploit, <https://www.merriam-webster.com/dictionary/exploiting>, © 2024 Merriam-Webster, Incorporated, accessed March 28, 2024. See, e.g., *Boston Red Sox Baseball Club LP v. Sherman*, 88 USPQ2d 1581, 1590 n.8 (TTAB 2008) (judicial notice taken of definition from the Merriam-Webster Online Dictionary); *In re Red Bull GmbH*, 78 USPQ2d 1375, 1378 (TTAB 2006); see also *Univ. of Notre Dame du Lac v. J. C. Gourmet Food Imps. Co.*, 213 USPQ 594, 596 (TTAB 1982), *aff’d*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983); *Syngenta Crop Protection, Inc. v. Bio-Chek LLC*, 90 USPQ2d 1112, 1117 (TTAB 2009).

¹³² 33 TTABVUE 9-11.

¹³³ Although the District Court found that there has been no business manager since 1993, and that the provision (Subsection 2.c.(iii)) is “inoperative,” 33 TTABVUE 774 n.4 and 783, this statement is another alternative finding that was not necessary to the determination. The unambiguous wording of the agreement indicates that the business manager was a conduit for decision-making, not a condition-precedent for the band members to make “major decisions.” “Courts may not by construction add or excise terms, nor distort the meaning of those used and thereby make a new contract for the parties under the guise of interpreting the writing.” *Dysal, Inc. v. Hub Properties Tr.*, 92 A.D.3d 826, 827, 938 N.Y.S.2d 642, 644 (2012) (internal citation omitted).

¹³⁴ 33 TTABVUE 11.

¹³⁵ *Id.* at 11.

Rascals asset would **not** be a decision in the normal course of business, and would require the consent of the majority of the band members.

An exclusive license may involve an assignment of ownership rights. *Cf. JC Hosp. v. Hochberg*, ___ F.Supp.3d ___, 2023 WL 8188330 (S.D.N.Y. November 27, 2023) (in discussing whether a licensee has standing, noted that the U.S. Court of Appeals for the Second Circuit has held that “[a]t least two requisites are inherent in the concept of assignment under the [Lanham] Act: (1) the need for the relevant assigning document to be effected ‘by [an] instrument[] in writing duly executed,’ 15 U.S.C. § 1060(a)(3); and (2) the need for the assignment to transfer an ownership interest in the marks at issue.”) (citing *Fed. Treasury Sojuzplodoimport v. SPI Spirits Ltd.*, 726 F.3d 62, 73 (2d Cir. 2013)); *Telebrands Corp. v. Del Lab’ys, Inc.*, 719 F.Supp.2d 283, 293 (S.D.N.Y. 2010) (“[A]n exclusive licensee only has standing if the licensing agreement grants the licensee a property interest in the mark or otherwise assigns to the licensee the registrant-licensor’s ownership rights.”).

Clearly, when Subsections 2.c.(ii) and 2.c.(iii) are read together, an exclusive license or assignment to another person or entity, such as Applicant, would be considered a “major decision” requiring the consent of the majority of the band members. Further, although the parenthetical regarding “major decisions” commences with “i.e.,” which means “that is,”¹³⁶ pointing to exclusive examples of

¹³⁶ We take judicial notice that “i.e.” is defined as “that is (to say).” *See Collins Dictionary (American English)* ([collinsdictionary.com/us/dictionary/english/ie](https://www.collinsdictionary.com/us/dictionary/english/ie)), ©Collins 2024, citing *Webster’s New World College Dictionary, 4th Edition*, © 2010 by Houghton Mifflin Harcourt, accessed March 28, 2024.

“major decisions,” failure to identify a transfer of the rights to the RASCALS mark, the partnership’s commercial asset, as a “major decision” would lead to the absurd result that any of the band members could give an exclusive license, or assign his trademark rights, to another party or entity.¹³⁷ Cf. *Eighth Ave. Coach Corp. v. City of New York*, 10 N.Y.S.2d 170, 183-84 (Sup. Ct. 1939), *aff’d sub nom. McCarthy v. City of New York*, 259 A.D. 870, 20 N.Y.S.2d 401 (App. Div. 1940), *aff’d*, 286 N.Y. 636, 36 N.E.2d 684 (1941), and *aff’d*, 259 A.D. 870, 20 N.Y.S.2d 402 (App. Div. 1940), *aff’d*, 286 N.Y. 84, 35 N.E.2d 907 (1941) (“Where a literal construction of a clause tends to an unreasonable result, destructive of the main purpose of the contract, the court is required, if possible, to render a construction within the meaning and intent of the parties which is ‘reasonable and executable.’ ... The ascertainment of the substantial intent of the parties is the fundamental rule in the construction of all agreements. ... If the clause deemed to permit the police department to change two-way traffic along the main routes to one-way traffic the provision renders the entire franchise uncertain and destroys the value of the rights granted to and paid for by plaintiff. Such an interpretation is inconsistent with the main purpose of the contract and contrary to the plain intent of the parties.”).

We also note the context of Subsections 2.c.(ii) and 2.c.(iii), i.e., within the introductory statement of Section 2.c., which addresses decision-making related to

¹³⁷ When the entire section of the agreement is read in context, the use of “i.e.,” in this section does not limit major decisions to audits and litigation. See *Eighth Ave. Coach*, 10 N.Y.S.2d at 184 (“Indeterminate forms of expression inconsistent with the evident design of a contract are to be understood in a sense subservient to the general purposes of the contract.”) (internal citation omitted).

“the commercial exploitation of the Rascals assets.”¹³⁸ Placement of those subsections within the larger section related to “the commercial exploitation of the Rascals assets” demonstrates the intent of the parties to protect the Rascals’ assets separate from the royalty provisions earlier in the agreement. This conclusion is supported by the introductory (preamble) paragraphs of the agreement,¹³⁹ which explain the intent of the parties to resolve two different civil actions in which they were involved¹⁴⁰ and “to set forth a framework by which the Rascals['] assets can be effectively exploited in the future.”¹⁴¹ In view thereof, the “only construction that can fairly be placed” on the terms of the agreement is that the exploitation of the Rascals’ assets does not include assignment or transfer of rights in the assets, which would diminish, not “effectively exploit,” the Rascals’ assets, unless a majority of the partners agree. *See, e.g., Pado, Inc. v. SG Trademark Holding Co. LLC*, 527 F. Supp. 3d 332, 341 (E.D.N.Y. 2021) (“a trademark cannot be sold or assigned apart from [the] goodwill it symbolizes” or accompanying business assets) (citing *Marshak v. Green*, 746 F.2d 927, 929 (2d Cir. 1984)); *Palu v. Lincoln Weather Strip & Screens Corp.*, 232 A.D. 647, 650, 251 N.Y.S. 52, 54 (App. Div. 1931) (the trade-name and trade-mark being part of the good will and assets of the partnership).¹⁴²

¹³⁸ 33 TTABVUE 9-11.

¹³⁹ *Id.* at 7.

¹⁴⁰ *Brigati v. Cavaliere*, 90 Civ. 6988 (KMW) and *Cornish and Danelli v. Cavaliere*, 91 Civ. 1928 (KMW). 33 TTABVUE 7.

¹⁴¹ 33 TTABVUE 7.

¹⁴² We note also that the District Court in the Prior Action made no finding regarding whether the partnership still exists or is considered dissolved under New York law.

Based on our construction of the 1992 Settlement Agreement, we find no genuine dispute of material fact that Cavaliere and Cornish were unable to transfer any rights they had in the RASCALS mark, much less file a trademark application for the Rascals' trademark, without the consent of the majority of the band members. In view thereof, we conclude as a matter of law that those actions were barred by contractual estoppel, and Opposer Brigati is entitled to judgment on his contractual estoppel claim. Accordingly, summary judgment is **GRANTED** in favor of Opposer Brigati as to this claim, the opposition is sustained, and registration is refused in connection with both opposed classes of goods and services.¹⁴³

To summarize, summary judgment is **GRANTED** in favor of Opposer Brigati on Applicant's construed defense of issue preclusion and on Opposer Brigati's claim of contractual estoppel. Therefore, judgment is entered against Applicant and registration is refused.

¹⁴³ Because we have sustained the opposition on the ground of contractual estoppel, we need not consider Opposer's remaining claims of lack of bona fide intent to use the mark and claim preclusion. *See, e.g., Yazhong Investing Ltd. v. Multi-Media Tech. Ventures, Ltd.*, 126 USPQ2d 1526, 1540 n.52 (TTAB 2018) (Board has the "discretion to decide only those claims necessary to enter judgment and dispose of the case"); *Chanel, Inc. v. Makrczyk*, 110 USPQ2d 2013, 2027 (TTAB 2014) ("Insofar as we are sustaining the opposition on this ground, we need not consider opposer's remaining claims....").