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

Lykos

Mailed: August 22, 2007

Cancellation No. 92043813

Warner Bros.  
Entertainment, Inc.

v.

The Kaplan Trust

Before Hohein, Holtzman, and Bergsman, Administrative  
Trademark Judges.

By the Board:

This case now comes up for consideration of  
petitioner's motion for summary judgment on its Section 2(d)  
and fraud claims. The motion is fully briefed.<sup>1</sup>

I. *Background*

On October 20, 2004, petitioner filed a petition to  
cancel respondent's registration for the mark THE BOWERY  
BOYS for "entertainment services, namely production and  
distribution of motion pictures; entertainment services, in  
the nature of an on-going television program[sic] in the  
field of comedy; distribution of television programs for

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<sup>1</sup> The Board has exercised its discretion to consider petitioner's  
reply brief. See Trademark Rule 2.127(a).

others" in International Class 41.<sup>2</sup> Petitioner seeks to cancel respondent's registration on the grounds that (1) respondent's mark so resembles petitioner's previously used THE BOWERY BOYS mark for the distribution of motion pictures and television programs, and pre-recorded videotapes, that it is likely to cause confusion, mistake, or deception of prospective consumers under Section 2(d) of the Lanham Act; (2) respondent's mark falsely suggests a connection between petitioner and respondent under Section 2(a) of the Lanham Act; and (3) respondent fraudulently procured its registration.

In the petition to cancel, petitioner alleges ownership of all rights to the mark THE BOWERY BOYS for the distribution of motion pictures and television programs, and pre-recorded videotapes, and that petitioner and its predecessors have continuously used its mark prior to respondent's claimed date of first use. Petitioner also alleges that:

5. Petitioner's mark THE BOWERY BOYS has been widely used and publicized for a period of several decades in connection with a series of movies shown in theaters and on television, and on video tapes sold and rented in a variety of retail outlets.

In its answer, respondent denied the relevant allegations contained in the petition for cancellation, and

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<sup>2</sup> Registration No. 2761675, issued on September 9, 2003, alleging January 1, 1983 as the date of first use anywhere and in commerce.

asserted various affirmative defenses, including acquiescence.

On August 24, 2006, the Board issued an order which admonished respondent for its destruction of documents and entered the sanction that respondent may only prove use of its mark by documentary evidence. The order further provides that testimonial evidence from respondent on the issue of use would not be considered except for authentication purposes.

II. *Petitioner's Motion for Summary Judgment*

We now turn to petitioner's motion for summary judgment in its favor on the pleaded Section 2(d) and fraud claims.

Summary judgment is an appropriate method of disposing of cases in which there are no genuine issues of material fact in dispute, thus leaving the case to be resolved as a matter of law. See Fed. R. Civ. P. 56(c). A party moving for summary judgment has the burden of demonstrating the absence of any genuine issue of material fact, and that it is entitled to summary judgment as a matter of law. See *Celotex Corp. v. Catrett*, 477 U.S. 317, 106 S.Ct. 2548 (1986). The nonmoving party must be given the benefit of all reasonable doubt as to whether genuine issues of material fact exist, and the evidentiary record on summary judgment, and all inferences to be drawn from the undisputed facts, must be viewed in the light most favorable to the

nonmoving party. See *Opryland USA, Inc. v. Great American Music Show, Inc.*, 970 F.2d 847, 23 USPQ2d 1471 (Fed. Cir. 1992). When the moving party's motion is supported by evidence sufficient to indicate that there is no genuine issue of material fact, and that the moving party is entitled to judgment, the burden shifts to the nonmoving party to demonstrate the existence of specific genuinely-disputed facts that must be resolved at trial. The nonmoving party may not rest on the mere allegations of its pleadings and assertions of counsel, but must designate specific portions of the record or produce additional evidence showing the existence of a genuine issue of material fact for trial.

Based on the submissions of the parties, we find that petitioner has met its burden of demonstrating that there are no genuine issues of material fact, and that petitioner is entitled to judgment as a matter of law on its Section 2(d) and fraud claims.

A. *Petitioner's Section 2(d) Claim*

A party moving for summary judgment in its favor on a Section 2(d) claim must establish that there is no genuine dispute that (1) it has standing to maintain the proceeding; (2) it is the prior user of its pleaded mark or marks; and (3) contemporaneous use of the parties' respective marks on their respective goods or services would be likely to cause

confusion, mistake or to deception of consumers. See *Hornblower & Weeks, Inc. v. Hornblower & Weeks, Inc.*, 60 USPQ2d 1733 (TTAB 2001).

(1) **Standing**

In its responsive brief, respondent has questioned petitioner's standing to bring the present action on the grounds that petitioner is not using the words "The Bowery Boys" as a mark, but rather as a means of identifying the actors appearing in certain films, and that the history of the copyright assignments in "The Bowery Boys" films contains a break in the chain of title. As discussed in more detail below, we find that the evidence of petitioner's prior use of its THE BOWERY BROTHERS mark suffices to establish petitioner's standing to bring this case. As such, no genuine issue of material fact exists on the issue of standing.

(2) **Priority**

To establish priority on a likelihood of confusion claim brought under Section 2(d) of the Trademark Act, a party must prove that, vis-à-vis the other party, it owns "a mark or trade name previously used in the United States ... and not abandoned...." Trademark Act Section 2, 15 U.S.C. Section 1052. A party may establish its own prior proprietary rights in a mark through actual use or through use analogous to trademark use, such as use in advertising

brochures, trade publications, catalogues, newspaper advertisements and Internet websites which creates a public awareness of the designation as a mark identifying the party as a source. See Trademark Act Sections 2(d) and 45, 15 U.S.C. Sections 1052(d) and 1127; *T.A.B. Systems v. PacTel Teletrac*, 77 F.3d 1372, 37 USPQ2d 1879 (Fed. Cir. 1996), vacating *Pactel Teletrac v. T.A.B. Systems*, 32 USPQ2d 1668 (TTAB 1994).

We find that the declaration of Janet A. Kobrin, Vice President, Intellectual Property for petitioner (hereinafter referred to as the "Kobrin Declaration"), relied upon by petitioner in support of its motion for summary judgment, contains unequivocal statements regarding petitioner's date of first use in interstate commerce of its mark, and is sufficient to establish petitioner's date of first use as 1992.<sup>3</sup> In particular, the declaration includes the following statement:

In 1992, Warner released to the public six (6) of the films from the Bowery Boys Collection on videocassette,

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<sup>3</sup> Respondent has moved to strike the Kobrin Declaration on the grounds that petitioner did not disclose Ms. Kobrin's identity as an individual with knowledge of the facts alleged in this proceeding, and that she was not made available for cross examination. Respondent's motion is denied. Petitioner did not outright refuse to furnish her identity during discovery. In addition, the Kobrin Declaration does not contain any previously undisclosed facts. Under these circumstances, it would be unduly harsh to impose the preclusion sanction under Fed. R. Civ. P. 37(c)(1). See *Vignette v. Marino*, 77 USPQ2d 1408 (TTAB 2005). As a final comment, the Board notes that the fact that another individual was designated as petitioner's Rule 30(b)(6) witness does not prevent petitioner from introducing on summary judgment the declaration of another corporate official.

including the film "Ghost Chasers." These films were released under the mark THE BOWERY BOYS and are still available in stores today. . . .

Paragraph 21, Kobrin Declaration.

Attached to the declaration are photographs of the packaging for the pre-recorded videocassettes displaying THE BOWERY BOYS mark for the featured films. See Kobrin Declaration, Exhibit 3. Thus, the Kobrin declaration, coupled with the documentary evidence consisting of the photographs of labels affixed to videocassette boxes submitted therewith, are sufficient to establish petitioner's priority date as 1992.

In contrast, respondent has not produced any documentary evidence showing use of the mark THE BOWERY BOYS so as to raise a genuine issue of material fact to rebut petitioner's date of first use. See Deposition of Jeff Kaplan, October 13, 2006 at 12-25.

Respondent attempts to raise a genuine issue of material fact by arguing that petitioner is not using the words "The Bowery Boys" as a trademark because it appears on the labels of the videocassettes as "Leo Gorcey and The Bowery Boys" and therefore describes a group of actors appearing in certain films. The Board disagrees with respondent's characterization of petitioner's mark. We find the stylization of the wording "The Bowery Boys" as displayed on the videocassette labels sufficiently

distinctive to create a separate commercial impression so as to constitute a discrete trademark.

Respondent also attempts to raise of genuine issue of material fact by arguing that petitioner's evidence regarding the history of copyright assignments in the Bowery Boys film series contains a break in the chain of title. We find respondent's argument unavailing. In light of petitioner's uncontroverted evidence of current ownership and trademark use as provided by the Kobrin declaration and supporting documentation, the chain of title of copyright transfers is irrelevant to our analysis of priority in this case.

(3) **Likelihood of Confusion**

Turning to the issue of likelihood of confusion, we are guided by the factors set forth in the case of *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). Our determination of likelihood of confusion is based on an analysis of all of the facts and evidence that are relevant to the factors bearing on the issue of likelihood of confusion.<sup>4</sup> In this particular case, the key factors are the degree of similarity of the parties' marks, the relatedness of the parties' goods and services, and the

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<sup>4</sup> Our primary reviewing Court has held that only those *du Pont* factors shown to be material or relevant in the particular case and which have evidence submitted thereon are to be considered. See *Olde Tyme Foods, Inc. v. Roundy's, Inc.*, 961 F.2d 200, 22 USPQ2d 1542 (Fed. Cir. 1992).

channels of trade. We thus have concentrated our discussion on the *du Pont* factors which the parties have discussed and/or on which we have evidence.

Considering first the marks, there is no issue that respondent's mark is identical to petitioner's mark. As discussed *inter alia*, petitioner's mark, as displayed on the labels of its pre-recorded videocassettes, appears as the single trademark THE BOWERY BOYS. Thus, the identical nature of the marks at issue weighs heavily in favor of finding likelihood of confusion.

We next turn to a consideration of the parties' respective goods and services. There is no genuine issue that, based on the evidence of record, petitioner's goods consist of pre-recorded videocassettes featuring a film series, and that respondent's services, as identified in the involved registration, include the production and distribution of motion pictures. It is well recognized that confusion is likely to occur from the use of the same or similar marks for goods, on the one hand, and for services involving those goods on the other. See *e.g. Corinthian Broadcasting Corp. v. Nippon Electric Co. Ltd.*, 219 USPQ 773 (TTAB 1983) (TVS for transmitters and receivers of still television pictures held likely to be confused with TVS for television broadcasting services). The nature of petitioner's goods (videocassettes featuring a film series)

and respondent's services (production and distribution of motion pictures) are so closely related that if the goods are sold and the services are rendered under the same mark, consumers will mistakenly believe that the goods and services emanate from a single source. This *du Pont* factor therefore favors a finding of likelihood of confusion.

Regarding the channels of trade, it is undisputed that petitioner sells its pre-recorded videocassettes through retail outlets. Respondent's involved registration, however, contains no limitation regarding the channels of trade. While the production and distribution of films are not services that are offered at the retail level, the ultimate consumer of such services (i.e. the ordinary consumer who views films in movie theaters) is the same prospective purchaser of prerecorded videotapes featuring films. In this particular case, the films which are recorded on the videocassettes were all previously released in movie theaters. Indeed, the labels affixed to the pre-recorded videocassettes explicitly notify the consumers of this fact. Thus, prospective consumers certainly are aware that the same company offers the service of producing and distributing films as well as offering for sale pre-recorded videocassettes featuring films. This *du Pont* factor also favors a finding of likelihood of confusion.

Inasmuch as petitioner has demonstrated that there is no genuine issue of material fact, and that it is entitled to judgment as a matter of law, petitioner's motion for summary judgment is granted on its Section 2(d) claim.<sup>5</sup>

*B. Petitioner's Fraud Claim*

Petitioner has also moved for summary judgment on its claim of fraud, arguing that respondent copied petitioner's labels as they appeared on petitioner's videocassettes, and submitted such labels as specimens in support of its own application. Petitioner further contends that respondent falsely declared that the label specimen constitutes evidence of respondent's use in commerce in connection with its application.

Fraud in procuring a trademark registration occurs when an applicant for registration knowingly makes false, material representations of fact in connection with an

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<sup>5</sup> In its responsive brief, respondent argues that based on e-mail correspondence between respondent and petitioner which took place prior to the institution of this case, petitioner acquiesced to respondent's use of the words "The Bowery Boys" as a trademark. It is well settled that acquiescence requires proof of an affirmative act or misleading conduct by the party against whom the defense is asserted, with such act or conduct signaling to the adverse party that its use and/or registration of a mark would not be challenged. See *DAK Indus. Inc. v. Daiichi Kosho Co. Ltd.*, 25 USPQ2d 1622 (TTAB 1993). The e-mail correspondence does not affirmatively state that petitioner would not assert any claims against respondent either before the Board or in federal court. We therefore find that the evidence presented by respondent is insufficient to raise a genuine issue of material fact to rebut petitioner's motion for summary judgment on its Section 2(d) claim, and is also insufficient for respondent to meet its burden of proof on this defense.

application to register. See *Torres v. Cantine Torresella S.r.l.*, 808 F.2d 46, 1 USPQ2d 1483 (Fed. Cir. 1986). As set forth below, there is no genuine issue of material fact that respondent made materially false representations in connection with the specimen submitted with its application during *ex parte* examination.

There is no dispute and no genuine issue of material fact that respondent filed an application based on use in commerce and signed a declaration attesting to the truth of all the statements in the application. A side-by-side comparison of respondent's label specimen with petitioner's videocassette label reveals that the labels are virtually identical. Kobrin Declaration, Exhibit D. Indeed, the placement and stylization of both parties' marks is the same. While respondent claimed that it obtained the image from a lobby card, it was unable to produce documentary evidence of such a card. Deposition of Jeffrey Kaplan, August 31, 2005, at 103-105, 107. We therefore conclude that there is no genuine issue of material fact that respondent submitted a fabricated specimen in support of its registration, namely a very slightly altered but essentially identical copy of one of petitioner's videocassette labels. By relying on a label obtained from petitioner's videocassette box to support its own allegation of use,

respondent knowingly made false and material misrepresentations in connection with its application.

Accordingly, we find that there are no genuine issues of material fact that respondent fraudulently obtained its registration. Accordingly, petitioner's motion for summary judgment is granted on its fraud claim.

Inasmuch as petitioner did not move for summary judgment on its Section 2(a) claim, we need not reach this remaining claim. Judgment is hereby entered against respondent, the petition to cancel is granted and the involved registration will be cancelled in due course, based on the Section 2(d) and fraud claims.