

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

In the matter of Registration Nos. 2,793,533, 2,634,215 and 2,735,848
Issued on December 16, 2003, October 12, 2002 and April 22, 2003, respectively

<p>GLENN DANZIG, Petitioner, v. CYCLOPIAN MUSIC, INC., Registrant.</p>	<p>Cancellation No. 92045173 Mark: MISFITS Our File No.: 64162-0002</p>
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Commissioner for Trademarks
P.O. Box 1451
Alexandria, Virginia 22313-1451

CERTIFICATE OF MAILING

I hereby certify that this correspondence and the identified enclosures are being deposited with the U.S. Postal Service overnight Express Mail, postage prepaid, in an envelope addressed to: Commissioner for Trademarks, P.O. Box 1451, Alexandria, Virginia 22313-1451 on November 16, 2006.

By: _____

Simone Robinson
Simone Robinson

**PETITIONER'S REPLY IN SUPPORT OF MOTION FOR SUMMARY JUDGMENT
AND OPPOSITION TO REGISTRANT'S RULE 56(f) MOTION**

Petitioner Glenn Danzig (hereinafter "Petitioner"), hereby submits this Reply Memorandum of Points and Authorities in further support of Petitioner's Motion for Summary Judgment. Petitioner further submits this Memorandum in opposition to Registrant Cyclopiان Music, Inc.'s (hereinafter "Registrant") Motion for additional discovery under Rule 56(f). Petitioner respectfully requests that Registrant's Motion be denied and summary judgment be granted in Petitioner's favor.



11-20-2006

U.S. Patent & TMO/TM Mail Rcpt Dt #32

MEMORANDUM OF POINTS AND AUTHORITIES

I. INTRODUCTION

It is well-established that where a mark is jointly owned, an application by only one of several joint owners of a mark is void, as the application must be filed in the name of the joint owners, not a single owner. *See, e.g.*, Trademark Manual of Examining Procedure § 803.03(d); *Ex parte Edward Taylor and Isabelle Stone Taylor doing business as Baby's Spray-Tray Co.*, 18 U.S.P.Q. 292 (1933). It is undisputed that the 1994 Settlement Agreement between Petitioner and the principals of Registrant granted Petitioner co-ownership of the MISFITS Marks and the right to manufacture, market, license and sell products under those Marks. The Settlement Agreement expressly prevents any party to that Agreement from asserting exclusive rights in the MISFITS Marks. Yet, through its registration of the MISFITS Marks, Registrant seeks to do just that, despite Petitioner's ownership and use of the Marks, which was ongoing at the time Registrant filed its applications for registration of the MISFITS Marks. Because the Settlement Agreement expressly provides for co-ownership of the MISFITS Marks and prevents any party to that Agreement from excluding any other party from use of these Marks, Registrant is not the exclusive owner of the MISFITS Marks. Accordingly, the registrations for the MISFITS Marks are void and subject to cancellation.

Registrant seeks to avoid such a finding by claiming a need for additional discovery prior to a ruling on Petitioner's Summary Judgment Motion. However, the discovery Registrant claims to seek is duplicative of discovery already served by Registrant, to which Petitioner has provided full responses. Further, Registrant's Rule 56(f) motion is futile, as Petitioner is entitled to summary judgment on the undisputed facts now in evidence. Accordingly, Registrant's Rule

56(f) Motion should be denied and Petitioner's Motion for Summary Judgment of Cancellation granted.

II. ADDITIONAL DISCOVERY UNDER RULE 56(F) IS UNNECESSARY

In order to obtain additional discovery under Rule 56(f) and delay ruling on a summary judgment motion, the party requesting additional discovery must demonstrate "(1) why it needs additional discovery and (2) how the additional discovery will likely create a genuine issue of material fact." *Stearns Airport Equip. Co. v. FMC Corp.*, 170 F.3d 518, 535 (5th Cir. 1999). *See also Keebler Co. v. Murray Bakery Products*, 866 F.2d 1386 (Fed. Cir. 1989) (opposing party must show how discovery requested is reasonably expected to create genuine issues of fact). Registrant has not shown that any issues of material fact will be created as a result of Registrant's requested discovery. Indeed, the discovery Registrant seeks is not targeted at contradicting the undisputed facts concerning Petitioner's ownership rights in the MISFITS Marks that are the basis for Petitioner's summary judgment motion. Accordingly, the additional discovery requested by Registrant is unnecessary and, in fact, futile.

Moreover, Registrant's own laundry list of information it seeks to obtain through new discovery demonstrates, by its very nature, that Registrant's request for additional discovery is unnecessary. Registrant includes information that has already been requested by Registrant and provided by Petitioner. In particular, Registrant claims a need for discovery regarding Petitioner's awareness of Registrant's registration and use of the MISFITS Marks. Registrant sought this very information in its First Set of Interrogatories to Petitioner, and Petitioner provided a complete response at that time. *See* Supplemental Declaration of Brian W. Kasell, ¶ 2, Ex. 1. It is unclear what additional information Registrant expects to uncover through duplicative discovery directed to these same topics.

Registrant asserts that it must be granted leave to pursue discovery of items it has already requested and to which discovery Petitioner has already responded. In its Motion, Registrant lists eight topics on which it claims it is entitled to discovery. Yet each of the topics listed corresponds with at least one discovery request already made by Registrant and to which Petitioner has already responded. Registrant's request for such discovery is merely a delaying tactic intended to disguise the absence of any genuine issues of material fact relating to the basis for Petitioner's Motion.

Because Registrant's basis for requesting additional discovery is the claimed need for information that has already been provided, and because the information requested, even if the discovery is allowed, will not contradict in any way the undisputed facts that are the basis for Petitioner's Motion, Registrant's request for additional discovery under Rule 56(f) should be denied.

III. PETITIONER IS ENTITLED TO SUMMARY JUDGMENT

It is fundamental that only the owner of a mark may apply for registration of that mark. *See, e.g.*, 15 U.S.C. § 1051(a) ("The owner of a trade-mark used in commerce may apply to register his or her trade-mark."); 3 J. Thomas McCarthy, McCarthy on Trademarks and Unfair Competition § 19:53 (4th ed.) ("The applicant must be the owner of the mark."). An application filed in the name of an entity that did not own the mark at the time of the filing date of the application is void and registration must be refused. 37 C.F.R. § 2.71(d). It is well-established that, where a mark is jointly owned, the application must be filed in the name of the joint owners, not by a single owner. *See, e.g.*, Trademark Manual of Examining Procedure § 803.03(d); *In re Tong Yang Cement Corp.*, 19 U.S.P.Q.2d 1689, 1689-90 (1991) (finding application void where applicant corporation was one of three that owned the mark as a joint venture); *Ex parte Edward*

Taylor and Isabelle Stone Taylor doing business as Baby's Spray-Tray Co., 18 U.S.P.Q. 292 (1933) (as the mark was owned by joint owners, it was proper for the joint owners to apply to register the mark together).

Because Registrant, which is merely a joint owner of the MISFITS Marks under the 1994 Settlement Agreement, registered the MISFITS Marks solely in its own name, without listing Petitioner as a joint owner, the registration is void and subject to cancellation.

A. Petitioner Has Ownership Rights in the MISFITS Marks.

As a founding member and visible symbol of the Misfits band, beginning in 1977, Petitioner acquired rights in the MISFITS Marks based upon the use of those Marks by the band and the public's association of the Marks, in part, with Petitioner. Following the dissolution of the band and the resultant disputes between the band members, Petitioner's rights in the MISFITS Marks were clarified by the parties' Settlement Agreement, which provides Petitioner and Registrant with equal rights to use, license and otherwise exploit the MISFITS Marks. *See* Declaration of Brian Kasell, Ex. 1.¹

Registrant's allegation that the Settlement Agreement constituted an "absolute prohibition" on Petitioner's rights to use the MISFITS Marks is not supported by the terms of that agreement. Petitioner relinquished a single right – the right to publicly perform as the Misfits – but retained the right to utilize the Misfits name in other ways, expressly including the rights to manufacture and sell products under the MISFITS Marks and to license others to do so. *Id.* This case is therefore distinguishable from the *Cookies in Bloom* case. *See Vaughn Russell Candy Co. v. Cookies in Bloom, Inc.*, 47 U.S.P.Q.2d 1635 (T.T.A.B. 1998). In the *Cookies in Bloom* case, the applicant had agreed to cease any use of the mark at issue. Here, by contrast, Petitioner

¹ The original declaration of Mr. Kasell was filed concurrently with Petitioner's Motion for Summary Judgment.

expressly retained that right. Registrant's assertion that public performance and recording is the only way to use the MISFITS Marks in commerce is unsupported and illogical. Petitioner's use of the Marks on clothing, for instance, demonstrates that the Marks can be used on products and services aside from those areas in which Petitioner agreed to be excluded.

Petitioner's use in accordance with the parties' Settlement Agreement, as well as his rights under that contract, suffice to establish Petitioner's rights in and co-ownership of the MISFITS Marks.

B. Petitioner Has Not Abandoned His Rights in the MISFITS Marks.

Contrary to Registrant's allegations, Petitioner has not abandoned his rights of ownership in the MISFITS Marks. In fact, the Settlement Agreement itself evidences Petitioner's intent to retain and utilize his rights in the MISFITS Marks. By reserving his rights in these Marks, although he was no longer performing with the Misfits band, Petitioner demonstrated his intent to continue his use of the MISFITS Marks. *See* Kasell Decl., Ex. 1. Petitioner's intent to abandon his right to perform publicly as the Misfits is clear from the face of the Settlement Agreement. *Id.* Had Petitioner intended to abandon his right to use and exploit the MISFITS Marks as well, it is unlikely that he would have expressly reserved the right to ownership of the Marks. *Id.* Accordingly, any presumption of abandonment is rebutted by the express provisions of the Settlement Agreement, which state Petitioner's intent to retain ownership and use of the MISFITS Marks.

Similarly, Petitioner's abandonment of his trademark application fails to establish Petitioner's abandonment of his ownership of the MISFITS Marks. Rather, Petitioner's decision not to pursue this application reflects Petitioner's recognition that his rights in the MISFITS Marks were not exclusive, in that the Settlement Agreement provided for joint ownership by Petitioner and Registrant. Like Registrant, Petitioner was therefore not entitled to registration of

the MISFITS Marks without listing Registrant as a joint owner of the Marks. *See In re Tong Yang Cement Corp.*, 19 U.S.P.Q.2d at 1689-90.

Indeed, Petitioner did continue to exercise his rights in the MISFITS Marks through licensing agreements under which he contracted for production of merchandise bearing the MISFITS Marks.² Registrant has admitted that Petitioner had entered into a licensing agreement with Blue Grape Merchandising to market and sell MISFITS products more than a year prior to Registrant's filing of a trademark application for the MISFITS Marks. *See Opposition Memorandum* at p. 7; Declaration of Curtis Krasik, Ex. 2.

The undisputed facts establish that, at the time Registrant's applications for the MISFITS Marks were filed with the Patent and Trademark Office, Registrant was not the exclusive owner of the MISFITS Marks. Pursuant to the Settlement Agreement, Petitioner had an ownership interest in the MISFITS Marks at that time and continues to hold such an interest in the Marks. At the time the applications for the MISFITS Marks were filed, and at all times since, Petitioner was actively exploiting his ownership rights in the MISFITS Marks through licensing agreement to produce merchandise under those Marks. Registrant's failure to identify all owners of the MISFITS Marks, including Petitioner, in the applications for registration voids these registrations. 37 C.F.R. § 2.71(d). Accordingly, Petitioner is entitled to summary judgment of cancellation.

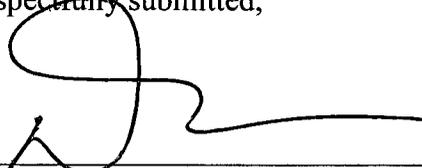
² This case is distinguishable from the *Oklahoma Beverage Co.* case relied upon so heavily by Registrant. In *Oklahoma Beverage*, one co-owner had abandoned the use of the marks for a period of nearly forty-five years, while the other co-owner had filed a trademark application immediately upon dissolution of the partnership and maintained that registration nearly continuously throughout the time period in question. *See Oklahoma Beverage Co. v. Dr. Pepper Love Bottling Co.*, 565 F.2d 629 (10th Cir. 1977). Here, by contrast, Petitioner had only brief periods of non-use of the MISFITS Marks and had established use of the Marks prior to Registrant's filing of a trademark application.

IV. CONCLUSION

For all the foregoing reasons, Petitioner respectfully requests that Registrant's Rule 56(f) motion for additional discovery be denied and that Petitioner's motion for summary judgment be granted and Registrant's MISFITS Marks registrations cancelled.

Date: November 16, 2006

Respectfully submitted,



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CERTIFICATE OF SERVICE

It is hereby certified that on **November 16, 2006**, a copy of the foregoing **PETITIONER'S REPLY IN SUPPORT OF MOTION FOR SUMMARY JUDGMENT AND OPPOSITION TO REGISTRANT'S RULE 56(f) MOTION** has been sent by first class mail, postage prepared to the attorney of record for Registrant:

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