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

Butler

**Mailed: January 26, 2007**

**Cancellation No. 92045173**

**Glenn Danzig**

**v.**

**Cyclopiian Music, Inc.**

**Before Hairston, Grendel and Zervas, Administrative Trademark  
Judges.**

**By the Board:**

Petitioner seeks to cancel three of respondent's registrations.<sup>1</sup> The first registration is for the mark MISFITS for the following goods:

brooches, charms, costume jewelry, earrings, jewelry lapel pins, ornamental pins, and tie pins in Class 14.<sup>2</sup>

The second registration is also for the mark MISFITS and is for the following goods and services:

musical sound recordings; and, pre-recorded audio tapes and videotapes featuring recorded musical performances and music videos in Class 9;

book covers; bumper stickers; comic books; fan magazines namely, musical group fan magazines; graphic art reproductions; posters; publications, namely, biographical

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<sup>1</sup> The petition to cancel is brought against all six classes of goods and services covered by the three registrations. Petitioner paid the appropriate fees for six classes.

<sup>2</sup> Registration No. 2793533, issued December 16, 2003, claiming a date of first use anywhere and first use in commerce of October 5, 1999.

and autobiographical books and magazines about the members of the musical group; souvenir pamphlets about musical groups; and, trading cards in Class 16; and

musical entertainment, namely, live performances by a rock group; arranging and conducting rock concerts; rock music fan club services; providing musical entertainment programs for television and for the internet; and musical entertainment services, namely, providing rock music programming via television and the internet in Class 41.<sup>3</sup>

The third registration is for the mark



for the following goods and services:

musical sound recordings; and, pre-recorded audio tapes and videotapes featuring recorded musical performances and music videos in Class 9; and

book covers; bumper stickers; comic books; fan magazines, namely, musical group fan magazines; graphic art reproductions; posters; publications, namely, biographical and autobiographical books and magazines about the members of the musical group; souvenir pamphlets about musical groups; and, trading cards in Class 16.<sup>4</sup>

As grounds for the petition to cancel, petitioner alleges that he was a founding member and lead vocalist of the musical group the MISFITS; that respondent is composed of Gerard Caiafa and Paul Caiafa, two other original members of the musical group; that, pursuant to a Settlement Agreement dated December 31, 1994

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<sup>3</sup> Registration No. 2634215, issued October 15, 2002, claiming a date of first use anywhere and a date of first use in commerce of April 19, 1994.

<sup>4</sup> Registration No. 2735848, issued July 15, 2003, claiming a date of first use anywhere and a date of first use in commerce of April 19, 1994.

involving petitioner, Messrs. Caiafa, and two other members of the musical group,<sup>5</sup> petitioner is a co-owner of the name and trademark the MISFITS and all artwork and logos associated therewith;<sup>6</sup> that respondent, consequently, is not the exclusive owner of the registered marks, as required by Trademark Act §1(a), thus making the registrations void; and that respondent committed fraud in the procurement of the registrations at issue by representing that it was the exclusive owner of the marks for the various goods and services identified.

In its answer, respondent admits that petitioner was one of the founders of the MISFITS and, at one time, the lead vocalist; admits the existence of the Settlement Agreement; and otherwise denies the essential allegations of the petition to cancel. Respondent also asserts numerous affirmative defenses including that petitioner has not used the mark MISFITS in commerce on the goods and services identified in the registrations; that the Settlement Agreement prohibits petitioner from using the mark on the goods and services identified in the registrations; that petitioner abandoned any trademark rights he had in the MISFITS marks; and that petitioner's claims are barred by laches, waiver,

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<sup>5</sup> Frank Licata and Julio Valverde are the other two individuals involved in the Settlement Agreement. As mentioned later in this order, they transferred their rights to Messrs. Caiafa.

<sup>6</sup> In paragraph no. 3 of the petition to cancel, petitioner alleges that paragraph no. 5 of the Settlement Agreement states, in part, "The parties shall be co-owners of the names and trademarks of the Misfits and all logo(s) and artwork (including all artwork used on Misfits releases for Slash, Caroline or Plan 9 Records) previously associated therewith."

acquiescence, estoppel, unclean hands, release, and any applicable statute of limitations.

This case now comes up on petitioner's fully-briefed motion, filed September 22, 2006, for summary judgment in his favor with respect to its claim that respondent is not the exclusive owner of the registered marks and, therefore, not entitled to the issued registrations. Petitioner's motion is directed to the Class 14 goods, the sole class of goods identified in Registration No. 2793533, and to the Class 9 goods only identified in Registration Nos. 2634215 and 2735848, both of which are multiple class registrations.<sup>7</sup>

As background, and according to petitioner, following the break-up of the punk rock band "The Misfits" in 1983, legal disputes arose among the five band members regarding the ownership of royalties and song rights resulting in a Settlement Agreement in 1994 "which resolved issues of ownership, rights of performance, and rights in the MISFITS trademark." More specifically, petitioner characterizes the Settlement Agreement as providing for co-ownership (by the involved individuals) of the name and trademark MISFITS, including the right to manufacture and sell merchandise, previously recorded music and performances, and other goods and services under the mark, but

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<sup>7</sup> Both parties submitted specific exhibits under seal. Where the Board refers to such exhibits, either a general reference is made or the language used by the parties in their respective briefs is used.

giving Messrs. Caiafa, in addition, the exclusive future right to perform and record as the MISFITS.

In support of its motion, petitioner argues that respondent filed trademark applications in October and November 2000 which matured into the subject registrations; that respondent "was listed as the sole owner" of the marks; that the registrations were issued in 2003; and that respondent then sought to enforce its alleged trademark rights against petitioner and petitioner's licensees. Petitioner argues that the registrations are void because respondent, not being the sole owner of the MISFITS marks, cannot claim a right of exclusive ownership in view of the terms of the Settlement Agreement and because a co-owner may not unilaterally register a mark. Petitioner contends that he has a contractual right to co-ownership of the marks "separate and apart from his rights arising from use of the marks"; that petitioner's co-ownership, *per se*, bars respondent from claiming exclusive rights to use the MISFITS marks; and that petitioner has been using the MISFIT marks "on t-shirts, apparel and other merchandise, which are included in the goods and services recited in the subject registrations."

Petitioner's motion is accompanied by the declaration of his attorney, Brian W. Kassel, introducing the following exhibits: a copy of the 1994 Settlement Agreement (under seal); copies of letters sent from respondent's attorney to companies licensed by petitioner to manufacture and sell merchandise under the MISFITS

marks; copies of petitioner's licensing agreements (under seal); and copies of sample MISFITS merchandise produced and sold on behalf of petitioner. This latter exhibit is for apparel and two sound recordings, "THE MISFITS Static Age" (Bates No. DANZ 0208) and "MISFITS Plan 9" (Bates No. DANZ 0212).<sup>8</sup>

As background to its response, respondent explains that, under the terms of the Settlement Agreement, "the parties shall be co-owners of the name and trademarks of the MISFITS and all logos and artwork ... previously associated therewith" (para. no. 5 of the Settlement Agreement); that Gerald Caiafa, Paul Caiafa, Frank Licata, and Julio Valverde would have "the exclusive right to publicly perform and record as 'The Misfits'" (para. no. 7 of the Settlement Agreement);<sup>9</sup> that petitioner would not receive any payments from such future performances and recordings (*Id.*); that for a period of two years, the new band was required to make it clear in promotional materials and to promoters of its live performances (and in related contracts) that petitioner was not and is not a member of the current band (*Id.*); and that, the parties to the Settlement Agreement, in accordance with express terms therein, sold all the MISFITS' musical recordings from 1977-1983, and the copyrights associated therewith, to Caroline

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<sup>8</sup> Respondent, in its summary judgment response, refers to the Bates No. 0212 CD as "Collection 1."

<sup>9</sup> Respondent clarifies that these four individuals subsequently entered into a separate agreement whereby the rights of Frank Licata and Julio Valverde to the MISFITS were granted to Messrs. Caiafa who then assigned their rights in the MISFITS marks to respondent.

Records, Inc. which received all "right, title and interest in and to all the master recordings ... embodying the performances of the recording group publicly known as The Misfits which were recorded prior to the date hereof."<sup>10</sup>

Respondent argues that, since 1994, it has been successful as an active musical group, engaging in live concert tours worldwide and releasing four full length music albums as well as numerous singles; that it has developed an extensive licensing program for merchandise, including clothing, footwear, posters, stickers, buttons, pins, trading cards, action figures, and skateboards sold through prominent retail outlets such as HOT TOPIC and VIRGIN MEGASTORES, as well as at its own website; and that its success and ensuing consumer recognition results from its own efforts, which have not involved petitioner and from which petitioner is contractually prohibited from being associated. In contrast, according to respondent, subsequent to the Settlement Agreement, petitioner did not pursue any use of the MISFITS name, but instead pursued his interest in two separate musical groups, SAMHAIN and DANZIG, until the end of 1999 when, approached by a merchandising group interested in DANZIG products, petitioner proposed including his purported MISFITS rights as part of the deal. It is respondent's position that petitioner is attempting to exploit and profit from the

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<sup>10</sup> This transaction with Caroline Records is referred to as the "Catalog Purchase Agreement" and is dated January 1, 1995, the day after the Settlement Agreement was executed.

MISFITS marks now that respondent has spent years establishing a unique, new identity with a new fan base.

Respondent argues that petitioner abandoned any ownership rights he had in the MISFITS marks by his failure to use the marks for at least five years after the execution of the Settlement Agreement; that, in 1999, petitioner licensed use of the MISFITS mark for apparel, goods not involved in this proceeding; that respondent first began use of the MISFITS mark on the Class 14 goods in 2001, a full seven years after the Settlement Agreement was executed, and that petitioner does not now offer and has not in the past offered such goods; and that petitioner is contractually prohibited from using the MISFITS marks on the Class 9 goods because, as a practical matter, absent the rights to perform and record under the MISFITS mark, petitioner could not use the mark in connection with the Class 9 goods without breaching the Settlement Agreement.

With respect to the copies of the CD's petitioner submitted with his motion for summary judgment, respondent argues that the "Static Age" recording was released by Caroline Records in 1997 featuring Misfits music from the 1977-1983 period and that, in accordance with the Catalog Purchase Agreement, Caroline Records is the owner of these recordings, including the copyrights thereto. As to the "Collection 1" CD, respondent argues that it was released in 1986, prior to the execution of the Settlement Agreement. Respondent refers to this CD as "one of the unlawful

releases by Petitioner without the permission of the other contributing members of the MISFITS, which, among other things, provoked the 1992 Action"<sup>11</sup> and argues that, in any event, ownership rights in this recording were also sold to Caroline Records and could not have been exploited by petitioner after execution of the 1994 Settlement Agreement. Respondent also contends that petitioner's position that the "Static Age" CD is "MISFITS merchandise produced and sold on behalf of Petitioner" is inconsistent with petitioner's response to respondent's interrogatory No. 4 asking petitioner to "[i]dentify each and every product you have sold or offered for sale using the MISFITS Mark since December 31, 1994." Petitioner's responded, "... at least the following items under the MISFITS mark since December 31, 1994: t-shirts, sweatshirts and stickers ... [and] products bearing the MISFITS marks were sold through licensed merchandising companies, who handled the production and sale of these items."

Respondent's response to petitioner's motion is accompanied by the declaration of respondent's principal, Gerald Caiafa, making statements as to the history of the musical group, the MISFITS, the circumstances of the Settlement Agreement, and the activities of the newly formed MISFITS musical group; and introducing a copy of the Catalog Purchase Agreement as well as a

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<sup>11</sup> The "1992 Action" refers to the lawsuit in district court in New York that resulted in the Settlement Agreement.

copy of the front and back cover art for respondent's "American Psycho" compact disc, released in 1997. Respondent's response is also accompanied by the declaration of its attorney, Curtis B. Krasik, introducing, among other things, excerpts from the discovery deposition (under seal) of Felix Sebacious, vice president of Bravado International Group, Inc. a merchandising company that is a successor-in-interest to Blue Grape Merchandising,<sup>12</sup> which was a merchandising company having a business relationship with petitioner; copies of documents (under seal) produced by Bravado International Group; and petitioner's responses to respondent's first set of interrogatories.

Alternatively and separately, respondent moves for discovery pursuant to Fed. R. Civ. P. 56(f) with respect to its affirmative defenses. Respondent argues that the scheduled deposition of petitioner did not occur because, a few days before the date, petitioner filed his summary judgment motion. Respondent's 56(f) discovery motion is supported by the declaration of respondent's attorney identifying the topics for which discovery is sought.

In reply and in response to respondent's 56(f) discovery request, petitioner argues that, because the Settlement Agreement provides for co-ownership of the MISFITS mark, and prohibits any party from excluding any other party from using the marks, registrant is not the exclusive owner of the marks it has

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<sup>12</sup> Mr. Sebacious is also identified as a former executive of Blue Grape Merchandising.

registered, thus making the registrations void. Petitioner argues that the 56(f) discovery sought by respondent is either duplicative of discovery already sought and responded to or is "not targeted at contradicting the undisputed facts concerning Petitioner's ownership rights in the MISFITS marks..."

Petitioner's filing is accompanied by the declaration of his attorney, Brian W. Kassel introducing a copy of petitioner's responses to respondent's first set of interrogatories.

In a motion for summary judgment, the moving party has the burden of establishing the absence of any genuine issue of material fact and that it is entitled to judgment as a matter of law. See Fed. R. Civ. P. 56. A genuine dispute with respect to a material fact exists if sufficient evidence is presented that a reasonable fact finder could decide the question in favor of the non-moving party. See *Opryland USA Inc. v. Great American Music Show, Inc.*, 970 F.2d 847, 23 USPQ2d 1471 (Fed. Cir. 1992). Thus, all doubts as to whether any particular factual issues are genuinely in dispute must be resolved in the light most favorable to the non-moving party. See *Olde Tyme Foods Inc. v. Roundy's Inc.*, 961 F.2d 200, 22 USPQ 1542 (Fed. Cir. 1992).

We find that, at a minimum, genuine issues of material fact exists as to whether petitioner's alleged five-year period of non-use of the MISFITS marks (for the merchandising uses allowed under the Settlement Agreement) amounted to an abandonment, with an intent not to resume use, of his ownership rights in the mark

and, related thereto, whether there was indeed a five-year period of non-use by petitioner.<sup>13</sup>

Moreover, petitioner has not shown that he is entitled to judgment as a matter of law. Accordingly, petitioner's motion for summary judgment is denied.<sup>14</sup>

In accordance with paragraph no. 9 of the parties' Settlement Agreement, the choice of law is New York State with respect to matters concerning the Catalog Purchase Agreement. However, there is no provision for the choice of law with respect to the Settlement Agreement itself. At trial, the parties will be expected to establish what state's law governs the Settlement Agreement and to brief or introduce copies of the relevant law and cases to support their positions insofar as the Board may be required to construe the terms of the Settlement Agreement with respect to the ownership issue. See *Old Swiss House, Inc. v. Anheuser-Busch, Inc.*, 196 USPQ 808 (CCPA 1978).

The parties are precluded from filing any further summary judgment motions because the matters presented are more suitable for determination at trial.

Proceedings are resumed. Discovery and trial dates are reset as follows:

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<sup>13</sup> Rights lost as a result of abandonment are not revived by such subsequent use. See J. Thomas McCarthy, 3 McCarthy on Trademarks and Unfair Competition, §17:3 (4<sup>th</sup> ed. 2006).

<sup>14</sup> In view of this denial, and the resetting of discovery and trial dates later in this order, respondent's alternative motion for 56(f) discovery is deemed moot.

THE PERIOD FOR DISCOVERY TO CLOSE:	March 15, 2007
30-day testimony period for party in position of plaintiff to close	June 13, 2007
30-day testimony period for party in position of defendant to close:	August 12, 2007
15-day rebuttal testimony period to close:	September 26, 2007

In each instance, a copy of the transcript of testimony together with copies of documentary exhibits, must be served on the adverse party within thirty days after completion of the taking of testimony. Trademark Rule 2.125.

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

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