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

Proceeding	92050557
Party	Defendant Direct From Vegas Productions, Inc.
Correspondence Address	Jacob L. Hafter Law Offices of Jacob L. Hafter & Associates 7201 W. Lake Mead Blvd., Suite 210 Las Vegas, NV 89128 UNITED STATES jhafter@hafterlaw.com
Submission	Motion for Summary Judgment
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Date	12/09/2009
Attachments	Complete Motion for Partial Summary Judgment.120909.01.pdf ( 16 pages ) (216112 bytes )

**UNITED STATES PATENT AND TRADEMARK OFFICE  
TRADEMARK TRIAL AND APPEAL BOARD**

TRP ENTERTAINMENT, LLC, a Nevada  
Limited Liability Company,

Petitioner,

vs.

DIRECT FROM VEGAS PRODUCTIONS,  
INC., a California Corporation,

Respondent.

Cancellation No.: 92050557

Registration No: 3220387

Mark: DIRECT FROM VEGAS THE RAT PACK

**FILED VIA ESTTA**

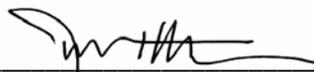
**RESPONDENT'S  
MOTION FOR PARTIAL SUMMARY JUDGMENT**

Pursuant to 37 C.F.R. §2.127(d) and Rule 56(f) of the Federal Rules of Civil Procedure, DIRECT FROM VEGAS PRODUCTIONS, INC. ("DVP" or "RESPONDENT"), respectfully moves for partial summary judgment in its favor and against TRP ENTERTAINMENT, INC. ("TRP" or "PETITIONER") to cancel registration No. 2640066 for the mark THE RAT PACK IS BACK (the "Mark").

Petitioner requests that the Trademark Trial and Appeal Board ("Board") grant this motion based upon a recent United States District Court holding in *TRP Entertainment vs. BC Entertainment*, 2:08-cv-0579-LDG stated that "The Rat Pack" is a generic term, supporting Respondent's claims in their counterclaim that the Mark is, in whole or in part, generic. Thus, RESPONDENT is entitled to a judgment as a matter of law.

DATED this 8<sup>th</sup> day of December, 2009.

LAW OFFICES OF JACOB HAFTER & ASSOCIATES



Jacob Hafter, Esq.  
Michael Naethe, Esq.  
7201 W. Lake Mead Boulevard, Suite 210  
Las Vegas, Nevada 89128  
Counsel for Respondent

## MEMORANDUM OF POINTS AND AUTHORITIES

Respondent makes this timely request for partial summary judgment because the Mark has been deemed, in whole or in part, as generic. As set forth herein, “the pleadings, depositions and... admissions on file, together with the affidavits, if any, show that there is no genuine issue of material fact” and that Respondent is “entitled to judgment as a matter of law.” Fed. R. Civ. P. 56(c).

### **I. INTRODUCTION**

Petitioner has a known reputation for using their capital and fiscal resources to push, bully and stymie smaller Rat Pack era tribute shows out of the market place. This instant action is a key example of such behavior. Rather than bringing such action before the judiciary, where Petitioner may be liable for the cost of such an action if it turns out that its claims are not meritorious, they have sought to frustrate Respondent with frivolous claims before the Board.

In response, Respondent added cross claims in answering the Petition for Cancellation, alleging that the Petitioner’s Mark should be cancelled, as a matter of law, as it is generic. During the prosecution of this instant action, another case involving Petitioner, this time one that was before the United States District Court, District of Nevada, held, specifically with respect to the Mark, that the phrase “The Rat Pack” was generic. See Order (Document 49) in *TRP Entertainment vs. BC Entertainment*, 2:08-cv-0579-LDG, a copy of which is attached hereto as **Exhibit “A.”** Based upon this new ruling, Respondent asks the Board, as a matter of law to invalidate the Mark, as it is generic.

### **II. LEGAL STANDARD**

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).

To prevail on its motion, opposer must show the absence of genuine issues of material fact as to its standing to bring this action. A mark is a generic name if it refers to the class, genus or category of goods and/or services on or in connection with which it is used. See *In re Dial-A-Mattress Operating Corp.*, 240 F.3d 1341, 57 USPQ2d 1807 (Fed. Cir. 2001)(citations omitted). The test for determining whether a mark is generic involves a two-step inquiry. First, what is the genus (category or class) of goods or services at issue? Second, is the term sought to be registered understood by the relevant public primarily to refer to that genus (category or class) of goods or services? *Marvin Ginn Corp. v. International Association of Fire Chiefs, Inc.*, 782 F.2d 987, 228 USPQ 528, 530 (Fed. Cir. 1986).

### III. “THE RAT PACK” IS A GENERIC TERM

In a recent federal case, the United States District Court for the District of Nevada was asked for a declaration that the term “The Rat Pack” is a generic reference to the members of the Rat Pack, a group of entertainers, typically identified as Frank Sinatra, Dean Martin, Sammy Davis, Jr., Joey Bishop, and Peter Lawford, who, either in total or in various combinations, appeared together in live stage performances and in movies during the 1960s. See Order (Document 49) in *TRP Entertainment vs. BC Entertainment*, 2:08-cv-0579-LDG, a copy of which is attached hereto as **Exhibit “A”**. Such declaration was sought such that one may use the generic term “The Rat Pack” as part of a title of a show in tribute to the members of the Rat Pack. This inquiry was made specifically in the context of the Mark.

The Court, in deciding this issue, started its analysis by noting the following:

The issue is not whether TRP has an exclusive right to use the mark “The Rat Pack is Back,” but whether it has an exclusive right to use the component term “The Rat Pack.” See, *In re Save Venice New York, Inc.*, 259 F.3d 1346, 1353 (Fed.Cir. 2001) (“A registered mark is incontestable only in the form registered and for the goods or services claimed”); *In re National Data Corp.*, 753 F.2d 1056, 1059 (Fed.Cir. 1985) (“registration

affords prima facie rights in the mark as a whole, not in any component”).

*Id.* at 4:7-13. The court started its analysis with the following pertinent statement about generic terms:

“A ‘generic’ term is one that refers, or has come to be understood as referring, to the genus of which the particular product or service is a species. It cannot become a trademark under any circumstances.” *Surgicenters of America, Inc. v. Medical Dental Surgeries Co.*, 601 F.2d 1011, 1014 (9th Cir. 1979) (citing *Abercrombie & Fitch Co. v. Hunting World, Inc.*, 537 F.2d 4, 9-10 (2nd Cir. 1976)). The Ninth Circuit has often relied upon the “who-are-you/what-are-you” test to determine whether a term is generic. See *Filipino Yellow Pages, Inc. v. Asian Journal Publ’n, Inc.*, 198 F.3d 1143, 1147 (9th Cir. 1999). “A mark answers the buyer’s questions ‘Who are you?’ ‘Where do you come from?’ ‘Who vouches for you?’ But the [generic] name of the product answers the question ‘What are you?’” *Official Airline Guides, Inc. v. Goss*, 6 F.3d 1385, 1391 (9th Cir. 1993 (quoting 1 J. Thomas McCarthy, *Trademarks and Unfair Competition* §12.01 (3d ed. 1992)). “‘A generic term is one that refers to the genus of which the particular product is a species.’” *Committee for Idaho’s High Desert, Inc. v. Yost*, 92 F.3d 814, 821 (9th Cir. 1996) (quoting *Park ‘N Fly, Inc. v. Dollar Park and Fly, Inc.*, 469 U.S. 189, 194 (1985)). “Genus is the broader, more inclusive classification, while species are groupings within a given genus.” 2 McCarthy, §12:23 (4th ed. 2007).

*Id.* at 4:20-9.

In this instant action, it is critical to recognize that “The Rat Pack” is not a specific group of entertainers, but, rather, a term that indicates an type of entertainers offering a type of service or good. This is the same distinction that was made in *TRP Entertainment vs. BC Entertainment*, 2:08-cv-0579-LDG. As stated by Judge George, “[a]t most, ‘The Rat Pack’ informs the consumer that TRP’s live show is about the music and performances that the members of the Rat Pack jointly performed in the 1960s, not that the show is ‘The Rat Pack.’” *Id.* at 6:13-15. Moreover, the Court found:

Since the 1960s, the term “The Rat Pack” has been used by producers of many types of goods or services to indicate that the goods or services relates to members of the Rat Pack or to the joint movie or live (or recorded) musical or movie performances of the Rat Pack during the 1960s. From its initial use to refer to members of the group, particularly when jointly performing live musical entertainment, “The Rat Pack” did not and, indeed, could not refer to or identify TRP’s live musical show.

*Id.* at 6:20-26. Indeed, the term “The Rat Pack” meets the test of a generic phrase which is why the Court held that “[a]s the term ‘The Rat Pack’ is generic in the context of live shows about or in tribute to members of the Rat Pack, TRP does not have an exclusive right to use the term ‘The Rat Pack.’” *Id.* at 7:14-16.

#### **IV. ADDING “IS BACK” TO A GENERIC TERM DOES NOT MAKE THE PHRASE UNIQUE**

As a generic term, the phrase “The Rat Pack” is indicative of a genre or type of show which one will expect to see, not a specific performer. Merely adding the qualifier “is back” does not create enough specificity to make the phrase unique. Obviously, TRP, despite their wishes, cannot, nor do they bring back to life performers such as Frank Sinatra and Sammy Davis Jr. for their performances; rather, they use impersonators to entertain their audiences in a manner that is no different, in theory, than any other Rat Pack tribute show.

There is no genuine issue of material fact as it relates to this issue; TRP cannot, nor has not resuscitated the original Rat Pack members and brought them “back” for their show. Accordingly, the Mark does nothing more than announce that another Rat Pack tribute show is being produced for nostalgic audiences.

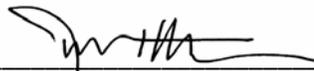
The Board is capable, based upon the ruling by Judge George, to apply the two part test for genericness as set forth in *Marvin Ginn Corp.* to the Mark, as a whole, as a matter of law. First, what is the genus (category or class) of goods or services at issue? Clearly, the Mark refers to a tribute show as it relates to the Rat Pack. Second, is the term sought to be registered understood by the relevant public primarily to refer to that genus (category or class) of goods or services? In answering this question, the Board must recognize that adding “is back” to a generic term does nothing special to the generic term so that the relevant public can distinguish TRP’s tribute show from any other collection of Rat Pack impersonators. Moreover, such analysis is one of first impressions, not one contingent upon fact. Hence, the Board must find that the Mark is generic, and, as such, must cancel the Mark.

**V. CONCLUSION**

In light of recent federal case law which directly addresses the generic nature of the Mark, in part, Respondents bring this Motion for Partial Summary Judgment, as a matter of law, before the Board. There is no genuine issue of fact which would preclude the Board from cancelling the Petitioner's Mark, as a matter of law, as it is generic. As such, Respondent respectfully requests that the Board GRANT this Motion.

DATED this 8<sup>th</sup> day of December, 2009.

LAW OFFICES OF JACOB HAFTER & ASSOCIATES



\_\_\_\_\_  
Jacob Hafter, Esq.

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Las Vegas, Nevada 89128

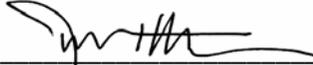
Counsel for Respondent

**CERTIFICATE OF SERVICE**

The undersigned hereby certified that a copy of this paper has been served upon all parties, at their address of record, by First Class Mail, on this date.

DATED this 8<sup>th</sup> day of December, 2009.

LAW OFFICES OF JACOB HAFTER & ASSOCIATES



\_\_\_\_\_  
Jacob Hafter, Esq.

Michael Naethe, Esq.

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Las Vegas, Nevada 89128

Counsel for Respondent

**UNITED STATES PATENT AND TRADEMARK OFFICE  
TRADEMARK TRIAL AND APPEAL BOARD**

TRP ENTERTAINMENT, LLC, a Nevada  
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Respondent.

Cancellation No.: 92050557

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Mark: DIRECT FROM VEGAS THE RAT PACK

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**EXHIBIT A**

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**UNITED STATES DISTRICT COURT  
DISTRICT OF NEVADA**

TRP ENTERTAINMENT, LLC,

Plaintiff,

v.

BC ENTERTAINMENT, INC., *et al.*,

Defendants.

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BC ENTERTAINMENT, INC., *et al.*,

Counterclaimants,

v.

TRP ENTERTAINMENT, LLC,

Counterdefendant.

Case No. 2:08-cv-0579-LDG (RJJ)

**ORDER**

TRP Entertainment, LLC, the plaintiff/counterdefendant, alleges that the defendant's use of the marks "Rat Pack - Frank, Sammy, and Dean," "The Rat Pack A Tribute to Frank, Dean & Sammy," and "Rat Pack" infringes its registered mark "The Rat Pack is Back," and its common-law mark "The Tribute to Frank, Sammy, Joey, and Dean." Barrie Cunningham, the defendant/counterclaimant, counters with claims seeking a declaration

1 that “The Rat Pack” is generic and cannot be exclusively owned or registered by any party,  
2 that his marks do not infringe TRP’s marks. Cunningham also seeks the cancellation or  
3 modification of TRP’s registration of the “The Rat Pack is Back” mark.

4 Cunningham moves for partial summary judgment (#23) as to his claims that “The  
5 Rat Pack” is generic, that he has not infringed TRP’s marks, and for the modification of  
6 TRP’s registration of the “The Rat Pack is Back” mark. TRP opposes the motion (## 27,  
7 28).<sup>1</sup>

8 Motion for Summary Judgment

9 In considering a motion for summary judgment, the court performs “the threshold  
10 inquiry of determining whether there is the need for a trial—whether, in other words, there  
11 are any genuine factual issues that properly can be resolved only by a finder of fact  
12 because they may reasonably be resolved in favor of either party.” *Anderson v. Liberty*  
13 *Lobby, Inc.*, 477 U.S. 242, 250 (1986). To succeed on a motion for summary judgment,  
14 the moving party must show (1) the lack of a genuine issue of any material fact, and (2)  
15 that the court may grant judgment as a matter of law. Fed. R. Civ. Pro. 56(c); *Celotex*  
16 *Corp. v. Catrett*, 477 U.S. 317, 322 (1986).

17 A material fact is one required to prove a basic element of a claim. *Anderson*, 477  
18 U.S. at 248. The failure to show a fact essential to one element, however, “necessarily  
19 renders all other facts immaterial.” *Celotex*, 477 U.S. at 323.

20 “[T]he plain language of Rule 56(c) mandates the entry of summary judgment, after  
21 adequate time for discovery and upon motion, against a party who fails to make a showing  
22 sufficient to establish the existence of an element essential to that party’s case, and on  
23

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24 <sup>1</sup> TRP has also moved for entry of a default (#48) against defendant BC  
25 Entertainment, Inc. Previously, the court has stricken the answer and counterclaim of BC  
26 Entertainment for failure to appear in this matter through counsel, as is required of a  
corporation. BC Entertainment has yet to have counsel appear on its behalf. Accordingly,  
the court will grant the motion for default.

1 which that party will bear the burden of proof at trial.” *Id.* “Of course, a party seeking  
2 summary judgment always bears the initial responsibility of informing the district court of  
3 the basis for its motion, and identifying those portions of ‘the pleadings, depositions,  
4 answers to interrogatories, and admissions on file, together with the affidavits, if any,’ which  
5 it believes demonstrate the absence of a genuine issue of material fact.” *Celotex*, 477 U.S.  
6 at 323. As such, when the non-moving party bears the initial burden of proving, at trial, the  
7 claim or defense that the motion for summary judgment places in issue, the moving party  
8 can meet its initial burden on summary judgment “by ‘showing’—that is, pointing out to the  
9 district court—that there is an absence of evidence to support the nonmoving party’s case.”  
10 *Celotex*, 477 U.S. at 325. Conversely, when the burden of proof at trial rests on the party  
11 moving for summary judgment, then in moving for summary judgment the party must  
12 establish each element of its case.

13       Once the moving party meets its initial burden on summary judgment, the non-  
14 moving party must submit facts showing a genuine issue of material fact. Fed. R. Civ. Pro.  
15 56(e). As summary judgment allows a court “to isolate and dispose of factually  
16 unsupported claims or defenses,” *Celotex*, 477 U.S. at 323-24, the court construes the  
17 evidence before it “in the light most favorable to the opposing party.” *Adickes v. S. H.*  
18 *Kress & Co.*, 398 U.S. 144, 157 (1970). The allegations or denials of a pleading, however,  
19 will not defeat a well-founded motion. Fed. R. Civ. Pro. 56(e); *Matsushita Elec. Indus. Co.*  
20 *v. Zenith Radio Corp.*, 475 U.S. 574, 586-87 (1986).

21       Whether the term “The Rat Pack” is Generic

22       Cunningham seeks a declaration that the term “The Rat Pack” is a generic reference  
23 to the members of the Rat Pack. As such, he contends that he may use the generic term  
24 “The Rat Pack” as part of a title of a show in tribute to the members of the Rat Pack.  
25 Further, as a generic term, he argues that TRP’s trademark registration for “The Rat Pack  
26 is Back” should be modified to disclaim the generic term “The Rat Pack.”

1 In considering this question, the court must initially note that the specific question  
2 presented by Cunningham is whether the term “The Rat Pack” is generic. Stated  
3 otherwise, Cunningham has not asked the court to decide whether TRP’s entire mark, “The  
4 Rat Pack is Back” is generic. Rather, he seeks a ruling that a component of TRP’s mark is  
5 generic, and thus that TRP does not have an exclusive right to the use of the component.  
6 To the extent that TRP has opposed Cunningham’s motion by arguing that its entire mark,  
7 “The Rat Pack is Back,” is not generic, such argument is irrelevant. The issue is not  
8 whether TRP has an exclusive right to use the mark “The Rat Pack is Back,” but whether it  
9 has an exclusive right to use the component term “The Rat Pack.” *See, In re Save Venice*  
10 *New York, Inc.*, 259 F.3d 1346, 1353 (Fed.Cir. 2001) (“A registered mark is incontestable  
11 only in the form registered and for the goods or services claimed”); *In re National Data*  
12 *Corp.*, 753 F.2d 1056, 1059 (Fed.Cir. 1985) (“registration affords prima facie rights in the  
13 mark as a whole, not in any component”).

14 Further, while TRP refers to its mark as the Rat Pack Mark, the registered mark is  
15 not the term “Rat Pack,” or the term “The Rat Pack,” each of which is merely a component  
16 of the entire mark: “The Rat Pack is Back.” Thus, the court will consider TRP’s arguments  
17 regarding whether the term “The Rat Pack” is generic only to the extent that TRP’s  
18 arguments address whether the “The Rat Pack” component of its entire mark is or is not  
19 generic.

20 “A ‘generic’ term is one that refers, or has come to be understood as referring, to the  
21 genus of which the particular product or service is a species. It cannot become a  
22 trademark under any circumstances.” *Surgicenters of America, Inc. v. Medical Dental*  
23 *Surgeries Co.*, 601 F.2d 1011, 1014 (9<sup>th</sup> Cir. 1979) (citing *Abercrombie & Fitch Co. v.*  
24 *Hunting World, Inc.*, 537 F.2d 4, 9-10 (2<sup>nd</sup> Cir. 1976). The Ninth Circuit has often relied  
25 upon the “who-are-you/what-are-you” test to determine whether a term is generic. *See*  
26 *Filipino Yellow Pages, Inc. v. Asian Journal Publ’n, Inc.*, 198 F.3d 1143, 1147 (9<sup>th</sup> Cir.

1 1999). “A mark answers the buyer’s questions ‘Who are you?’ ‘Where do you come  
2 from?’ ‘Who vouches for you?’ But the [generic] name of the product answers the  
3 question ‘What are you?’” *Official Airline Guides, Inc. v. Goss*, 6 F.3d 1385, 1391 (9<sup>th</sup> Cir.  
4 1993 (quoting 1 J. Thomas McCarthy, *Trademarks and Unfair Competition* §12.01 (3d ed.  
5 1992)). “A generic term is one that refers to the genus of which the particular product is a  
6 species.” *Committee for Idaho’s High Desert, Inc. v. Yost*, 92 f.3d 814, 821 (9<sup>th</sup> Cir. 1996)  
7 (quoting *Park ‘N Fly, Inc. v. Dollar Park and Fly, Inc.*, 469 U.S. 189, 194 (1985). “Genus is  
8 the broader, more inclusive classification, while species are groupings within a given  
9 genus.” 2 McCarthy, §12:23 (4<sup>th</sup> ed. 2007).

10 Cunningham offers extensive evidence, undisputed by TRP, that the term “The Rat  
11 Pack” is recognized by the consuming public as a reference to a group of entertainers:  
12 typically identified as Frank Sinatra, Dean Martin, Sammy Davis, Jr., Joey Bishop, and  
13 Peter Lawford. This group of entertainers, either in total or in various combinations,  
14 appeared together in live stage performances and in movies during the 1960s. The  
15 entertainers, themselves, did not generally identify themselves as the Rat Pack. Rather,  
16 the reference appears to have been adopted by the popular media to refer to members of  
17 the group, often in reference to their joint live (and often impromptu) show appearances.  
18 Cunningham’s evidence establishes that, subsequent to the 1960s, numerous and various  
19 different types of products, including books, documentaries, movies, and compact disc or  
20 DVD recordings (including recordings of joint performances from the 1960s), have used the  
21 term “The Rat Pack” to identify that the underlying product concerns this group of  
22 entertainers or is a recording of a joint entertainment performance involving this group of  
23 entertainers.

24 As noted, from its initial use as a reference to this group of entertainers, the  
25 entertainers did not use the term “The Rat Pack” to identify the origin of a good or service  
26 offered by the group. Rather, “The Rat Pack” was a term used by other persons or entities

1 to refer to the group of entertainers, or to the activities of the group, or to indicate that an  
2 offered service or good concerned this group of entertainers in some fashion.

3 TRP has not offered any evidence to the contrary. Rather, and at most, TRP has  
4 merely argued that such evidence is irrelevant to whether its entire mark is a generic  
5 reference to all live musical entertainment shows. TRP's argument, however, presents a  
6 question that is irrelevant to Cunningham's motion. In the context of live musical  
7 performances and TRP's show, "The Rat Pack" does not answer the question of "Who is  
8 performing the live show?" The existing meaning of "The Rat Pack" as a reference to  
9 members of the Rat Pack and their joint live performances of the 1960s establishes this.  
10 The live show is not "The Rat Pack," nor would any consumer recognize the show as one  
11 performed by "The Rat Pack" or by members of the Rat Pack. Rather, as suggested by  
12 TRP's common-law mark, TRP's live entertainment show is a tribute to members of the Rat  
13 Pack. At most, "The Rat Pack" informs the consumer that TRP's live show is about the  
14 music and performances that the members of the Rat Pack jointly performed in the 1960s,  
15 not that the show is "The Rat Pack."

16 Stated succinctly, Cunningham's evidence establishes that, long before TRP offered  
17 live musical shows, the term the "The Rat Pack" had a meaning that was used in  
18 connection with the joint performances of members of the Rat Pack during the 1960s.  
19 While some of these performances included movie appearances, typically the joint  
20 performances were live musical performances. Since the 1960s, the term "The Rat Pack"  
21 has been used by producers of many types of goods or services to indicate that the goods  
22 or services relates to members of the Rat Pack or to the joint movie or live (or recorded)  
23 musical or movie performances of the Rat Pack during the 1960s. From its initial use to  
24 refer to members of the group, particularly when jointly performing live musical  
25 entertainment, "The Rat Pack" did not and, indeed, could not refer to or identify TRP's live  
26 musical show.

1 By contrast, TRP has not offered any evidence that, in using the term “The Rat  
2 Pack” in connection with its live musical show, it has deviated from this existing usage.  
3 Rather, TRP’s own common-law mark indicates that it adopted the term “The Rat Pack” to  
4 draw upon consumers’ association of the term with the Rat Pack. In the context of live  
5 shows, “The Rat Pack” standing alone, answers only the question “What?” not “Who?”  
6 “The Rat Pack” is not a reference to TRP’s show, but a reference indicating that the live  
7 musical show concerns or is about about the Rat Pack. The question before the court on  
8 Cunningham’s partial motion for summary judgment is not whether “The Rat Pack is Back”  
9 identifies and distinguishes TRP’s show in tribute to members of the Rat Pack from all  
10 other such live shows. Rather, the only question is whether the component term “The Rat  
11 Pack” so distinguishes TRP’s live show from all others about or in tribute to the Rat Pack.  
12 The evidence establishes that it does not and that TRP cannot appropriate the term “The  
13 Rat Pack” for its exclusive use.

14 As the term “The Rat Pack” is generic in the context of live shows about or in tribute  
15 to members of the Rat Pack, TRP does not have an exclusive right to use the term “The  
16 Rat Pack.” The mere fact that Cunningham has used the term “The Rat Pack” in  
17 connection with a Rat Pack tribute show did not, does not, and cannot infringe TRP’s  
18 registered mark. The court cannot, however, agree with Cunningham that he is entitled to  
19 a declaration that every use he makes of the component term “The Rat Pack” is non-  
20 infringing. The present record does not permit the court to evaluate or consider  
21 Cunningham’s use of “The Rat Pack” in the context of a composite or compound term or  
22 mark.

23 The remaining question before the court concerns the parties’ tribute phrases. TRP  
24 alleges in its complaint that it has a protected common-law mark in the phrase “The Tribute  
25 to Frank, Sammy, Joey, and Dean.” Cunningham argues the tribute phrase he uses, “A  
26 Tribute to Frank, Dean, and Sammy,” is generic. Cunningham further seeks a declaration

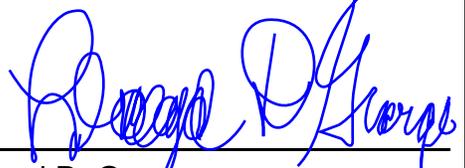
1 that his use of his tribute phrase does not infringe TRP's alleged mark because TRP has  
2 not shown that it has a protected trademark interest in its tribute phrase. Further, even if  
3 TRP has a protected interest, he argues that his use of a generic tribute phrase could not  
4 infringe TRP's claimed mark. The record before the court requires the conclusion that  
5 issues of material fact remain on these questions. Accordingly,

6 THE COURT **ORDERS** that TRP Entertainment, LLC.'s Motion for Entry of Default  
7 Against Defendant BC Entertainment, Inc. (#48) is GRANTED.

8 THE COURT FURTHER **ORDERS** that Barrie Cunningham's Motion for Partial  
9 Summary Judgment on Counterclaim for Declaratory Relief of Genericness, Counterclaim  
10 for Modification of Plaintiff's Trademark Registration, and Counterclaim for Declaratory  
11 Relief of Non-Infringement (#23) is GRANTED as to the First Counterclaim for Declaratory  
12 Relief of Genericness and as to the Second Counterclaim to the extent the Second  
13 Counterclaim requests Modification of TRP Entertainment, LLC.'s Trademark Registration  
14 No. 2,640,066 to add a disclaimer of the term "RAT PACK;" and is DENIED in all other  
15 respects as material issues of fact remain.

16 THE COURT FURTHER **ORDERS** that Barrie Cunningham shall prepare and  
17 submit a proposed partial judgment.

18  
19 DATED this 28 day of September, 2009.

20  
21   
22 Lloyd D. George  
23 United States District Judge  
24  
25  
26