

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

Mailed: April 1, 2010

Cancellation No. 92050557

TRP ENTERTAINMENT, LLC

v.

DIRECT FROM VEGAS PRODUCTIONS, INC.

Cheryl Butler, Attorney, Trademark Trial and Appeal Board:

Respondent owns a registration for the mark DIRECT FROM VEGAS THE RAT PACK for "entertainment services, namely live and televised appearances by a professional entertainer, live performances by a musical band and live music concerts."¹ In accordance with the first amended petition to cancel, petitioner alleges priority of use (through a predecessor-in-interest) and likelihood of confusion with its registered mark THE RAT PACK IS BACK for "entertainment services, namely live stage musical productions,"² that respondent's mark is deceptive within the meaning of Trademark Act §2(a); and that respondent's mark is geographically deceptively misdescriptive within the meaning of Trademark Act §2(e)(3).

In its answer, respondent admits that it is a California corporation located in California but otherwise denies the essential

¹ Registration No. 3220387, issued on March 20, 2007, claiming a date of first use anywhere and a date of first use in commerce of October 9, 2003. A disclaimer of the wording THE RAT PACK is of record.

² Registration No. 2640066.

allegations of the petition to cancel. Respondent also asserts numerous affirmative defenses and counterclaims to cancel petitioner's pleaded Registration No. 2640066 on the ground that the mark THE RAT PACK IS BACK is a generic term. Petitioner denies the essential allegations of the counterclaim.

In accordance with petitioner's consented motion, filed and granted on November 25, 2009, the discovery period was last set to close on January 1, 2010. On December 9, 2009, respondent filed a motion for summary judgment in its favor on its counterclaim that petitioner's registered mark is a generic term. On December 11, 2009, respondent filed a separate motion for partial summary judgment in its favor with respect to petitioner's claim that respondent's mark is geographically deceptively misdescriptive.

This case now comes up on petitioner's fully briefed motion, filed January 19, 2010 for a continuance for discovery pursuant to Fed. R. Civ. P. 56(f) and petitioner's motion, filed February 19, 2010, to strike respondent's response to petitioner's motion for 56(f) discovery.

Petitioner's motion to strike

Respondent's response to petitioner's 56(f) motion was due on February 8, 2010. Respondent filed its response on February 10, 2010. Petitioner's motion to strike such response is denied because, due to a weather emergency in the Washington, D.C. area, the USPTO was closed between February 8 and February 11, 2010. Consequently, each day was considered a holiday in accordance with

Trademark Rule 2.196 and any action due during that time period is considered timely if filed on the next succeeding business day on which the USPTO is open. See also the Emergency Notice at http://www.uspto.gov/news/index_emergency.jsp. Thus, respondent had until February 12, 2010 for its response to be considered timely filed. Moreover, even if respondent's response were considered untimely, the Board must consider the merits of petitioner's 56(f) request because a moving party must demonstrate its need for discovery to be reasonably directed to obtaining facts essential to its opposition of the summary judgment motion. See TBMP §528.06 (2d ed. rev. 2004).

Discovery responses served by respondent

According to petitioner, shortly before respondent filed its first summary judgment motion, respondent served the majority of its discovery responses including: revised initial disclosures with new documents and named potential witnesses, amended responses to petitioner's first sets of interrogatories and production requests, responses to petitioner's second sets of interrogatories and production requests, responses to petitioner's first request for admissions, and 1,282 documents. Petitioner also indicates that it had been working with respondent for some time to schedule depositions of respondent's witnesses; that petitioner eventually issued a second amended notice of deposition for respondent's Rule 30(b)(6) witness for December 17, 2009; that petitioner issued subpoena's for the depositions of named third-party witnesses

(Harmony and Classique) identified by respondent; and that respondent also identified another third party, Destinations, in its revised initial disclosures.

Petitioner's 56(f) request with respect to respondent's motion for summary judgment on its counterclaim

In support of its motion for summary judgment with respect to its counterclaim to cancel petitioner's pleaded registration on the ground that the mark is generic, respondent relies on the determination of the district court that the phrase THE RAT PACK is generic for live shows about or in tribute to members of the "The Rat Pack" (*i.e.*, a group of entertainers typically identified as Frank Sinatra, Dean Martin, Sammy Davis, Jr., Joey Bishop, and Peter Lawford).³ *TRP Entertainment, LLC v. BC Entertainment, Inc.*, Case No. 2:08-cv-0579-LDG (RJJ) in the United States District Court for the District of Nevada (9/28/09) at pp. 5 and 7. The district court further ordered TRP Entertainment to add a disclaimer of the term "RAT PACK" to its Registration No. 2640066. *Id.* at p. 8. The only evidence submitted by respondent is a copy of the district court determination.

Petitioner seeks depositions of respondent and the three third-parties indicated above to ascertain what facts and evidence (aside from the court decision) that respondent intends to use to support its genericness counterclaim and respondent's arguments concerning

³ As discussed later in this order, the status of this court determination occasions a suspension of proceedings herein. However, the Board is considering petitioner's 56(f) motion at this time so that, once proceedings are resumed, the schedule may move forward.

the "IS BACK" portion of petitioner's mark; and discovery concerning the prosecution of respondent's application that matured into its registration, particularly with respect to the disclaimer of the terminology "THE RAT PACK."

As recognized by petitioner, the only evidence submitted by respondent in support of its motion for summary judgment on the counterclaim is the court decision. Thus, petitioner has not shown a need for the discovery it says it needs in order to respond to the summary judgment motion on the counterclaim. The Board notes in passing that any reply submitted by respondent is limited to responding to the arguments and evidence submitted by petitioner in its responsive brief. *Cf. Netword LLC v. Centraal Corp.*, 242 F.3d 147, 58 USPQ2d 1076, 1082 (Fed. Cir. 2001) (purpose of reply brief is to respond to arguments presented by appellee).

Accordingly, petitioner's request for 56(f) discovery with respect to respondent's summary judgment motion on its counterclaim is denied.

Petitioner's 56(f) request with respect to respondent's motion for partial summary judgment on petitioner's claim that respondent's mark is deceptively geographically misdescriptive

Petitioner seeks to depose respondent's several witnesses (and obtain documents identified in its subpoenas) on the following topics related to the standard for determining whether a mark is deceptively geographically misdescriptive: 1) how DIRECT FROM VEGAS THE RAT PACK is not a geographic indicator because DIRECT FROM VEGAS is respondent's corporate name; 2) how and why respondent's mark is

"spatial and temporal," what the statement means, how and why the mark "is intended to recall the relevant audience of Las Vegas in the 1960's when the Rat Pack was at their peak popularity," how and why the mark "invokes the imagination of customers," what customers' imagination have been invoked, and the removal of the term "Las" to achieve these goals; 3) how and to whom it "is obvious" that the mark suggests a Rat Pack tribute show venues at the Sands Hotel in Las Vegas in the 1960's; 4) how, why and where respondent's show originated and respondent's theory that the show originated in Las Vegas because the concept of the show originates in Las Vegas; 5) respondent's contention that purchasers, and what purchasers, do not believe, expect or want the services to originate in Las Vegas; 6) about respondent's patrons and which patrons believe that inspiration for tribute shows is more important than the geographic location of the show; and 7) about respondent's private shows performed under contract in Las Vegas, where such shows were performed, how they were produced and performed, and how two of the third-party witnesses assisted in the performance and/or production of these shows. Petitioner also seeks discovery concerning respondent's statements regarding petitioner's purportedly bad faith behavior.

With respect to the latter topic, information concerning the basis of respondent's statements going to petitioner's purported behavior in the field is not relevant to the issues presented by the partial summary judgment motion on the claim that respondent's mark

is deceptively geographically misdescriptive. Moreover, it appears that respondent has provided some information about this topic at least in its second amended answers to petitioner's first set of interrogatories. Accordingly, petitioner's request for 56(f) discovery on such topic is denied.⁴

As a responding party on summary judgment, petitioner's burden is to raise a genuine issue of material fact, not to prove its case. The Board recognizes that respondent's filing of its summary judgment motions occasioned the cancelling of petitioner's scheduled depositions, that petitioner (as many litigants) prefers to take depositions after receiving written discovery responses, that respondent's revised initial disclosures listed third parties not previously listed for petitioner, and that petitioner worked in good faith to notice the depositions. Nonetheless, it appears that petitioner has obtained sufficient discovery responses to permit it to respond to respondent's motion for partial summary judgment. Accordingly, petitioner's motion for 56(f) discovery with respect to respondent's motion for partial summary judgment on petitioner's claim that respondent's mark is deceptively geographically misdescriptive is denied.

Proceedings suspended

The Board has reviewed the docket history (using the PACER system) for *TRP Entertainment, LLC v. BC Entertainment, Inc.*, Case

⁴ Further, the Board has experience with party posturing, opinions, and expressions of frustration. Consequently, very little, if any, consideration will be given to statements of the kind referenced made by either party.

Cancellation No. 92050557

No. 02-cv-00579-LDG (RJJ). On December 14, 2009, the court denied TRP's motion for reconsideration of the September 9, 2009 order granting BC's motion for summary judgment, finding THE RAT PACK to be a generic term for live shows about or in tribute to the "Rat Pack." On November 5, 2009, BC submitted its proposed partial judgment. The court has not yet acted on such filing.

Whenever it comes to the attention of the Board that the parties (or a party) to a case pending before it are involved in a civil action which may be dispositive of (or at least have a bearing upon) the Board case, proceedings before the Board may be suspended until final determination of the civil action. See Trademark Rule §2.117(a); and TBMP §510.02(a) (2d ed. rev. 2004).

The Board has reviewed the September 28, 2009 determination of the court, and the December 14, 2009 denial of reconsideration of such determination, and finds that the September 28, 2009 determination may be dispositive of, or at least have a strong bearing on, some of the claims and the counterclaim in the present opposition. Petitioner has indicated that the final order has not been entered with respect to the September 28, 2009 and that it may appeal such determination

Accordingly, proceedings herein are suspended pending a final disposition of the referenced civil action.

Within twenty days after the final determination of the civil action, the interested party should notify the Board so that this case may be called up for appropriate action. During

Cancellation No. 92050557

the suspension period the Board should be notified of any address changes for the parties or their attorneys.

Upon resumption, and if appropriate, petitioner's time to respond to respondent's summary judgment motions will be reset.

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