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

Proceeding	92058978
Party	Defendant Black Clouds
Correspondence Address	BARBARA L (PIXIE) WAITE LAW OFFICE OF BARBARA L WAITE PC 1425 K STREET NW, SUITE 350 WASHINGTON, DC 20005 UNITED STATES pixie@blwaitepc.com
Submission	Motion for Summary Judgment
Filer's Name	Barbara L. (Pixie) Waite
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Signature	/ B. L. Waite /
Date	02/20/2015
Attachments	Opposition.pdf(138594 bytes)

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

Daniel P. Matthews,

Petitioner,

v.

Cancellation No. 92058978
Registration No. 4,233,433

Black Clouds LLC,

Registrant.

Opposition to Petitioner's Motion for Summary Judgment

Registrant, by counsel, hereby opposes Petitioner's Motion for Summary Judgment[1] as follows. Registrant does not dispute Petitioner's statements of the law with respect to summary judgment and likelihood of confusion. Registrant does, however, very much dispute Petitioner's allegation of facts with respect to use and the significance attached to them.

Petitioner seeks to cancel Registrant's valid registration on the basis of alleged prior rights to the mark THE BLACK CLOUDS for the same goods as are contained in Registration No. 4,233,433 (submitted herewith as Exhibit A) under Section 2(d) of the Lanham Act. Petitioner alleges that he has continuously used as a mark THE BLACK CLOUDS since 2005 in the United States in interstate commerce.

Use of a mark should be a bona fide use in commerce and not merely to reserve a right in the mark, according to Section 45 of the Lanham Act. Registrant submits that Petitioner has not been continuously using its mark in the ordinary course of trade, if he ever did. "[T]he right to a particular mark grows out of its use,

[1] Petitioner's Motion contains no Certificate of Service. A service copy was received in Registrant's counsel's office via the U.S. Postal Service and the transmitting cover letter from Petitioner's counsel recites that it traveled via First Class Mail. Registrant has calculated the due date for this response accordingly.

not its mere adoption." *United Drug Co. v. Theodore Rectanus Co.*, 248 U.S. 90, 97 (1918). "To prove bona fide usage, the proponent of the trademark must demonstrate that his use of the mark has been deliberate and continuous, not sporadic, casual or transitory." *LaSociete Anonyme des Parfums Le Galion v. Jean Patou, Inc.*, 495 F.2d 1265, 1271-72 (2d Cir.1974).

Petitioner asserts that use of his mark began in 2005. He offers no evidence of said use, merely allegations. The earliest date of first use on his Exhibit B representing CD sales appears to be in 2008.

Furthermore, his Exhibit B demonstrates that there were no sales of CDs between November 2009 and 2013. Hurt Declaration, attached hereto as Exhibit B, paragraph 1. Abandonment of a mark, assuming that any rights had been established by the minimal use in 2008-09, i.e., the sale of 13 CDs, is presumed after three years of non-use. 15 U.S.C. § 1127. *See Paramount Pictures Corp. v. White*, 31 U.S.P.Q.2d 1768 (T.T.A.B. 1994) (use of a mark on parlor board game sold or given away by a musical group in annual quantities of about 20-30 units did not reach the level of use required by the statute).

The fuel logs in Exhibit A are not evidence of anything. If we accept Petitioner at his word, they merely establish that he drove to the designated cities and spent a certain amount of money on fuel to get there. There are no venues identified, no contracts, no advertisements, no corroborating evidence of any kind that the purpose of these travels was to give a performance as a band. Exhibit B, paragraph 3. Even if there were, entertainment services are not at issue here; Petitioner has alleged that his goods are the same as Registrant's in Class 9.

Petitioner's Exhibit C, while impressive in its sheer heft, likewise proves nothing with respect to use. They represent streamed plays of music. Exhibit B,

paragraph 4. There is no way to establish who listened to these plays or whether they were generated by the Petitioner himself by clicking on "refresh". *Id.*

This paltry evidence of use is reflected in Registrant's failure to find any indication of Petitioner's existence as a band before it adopted its mark in 2011. Exhibit B, paragraph 7. Likewise, Registrant's application to register its mark was published for opposition on August 14, 2012, during Petitioner's period of non-use. No doubt this fact contributed towards Petitioner's failure to oppose Registrant's application.

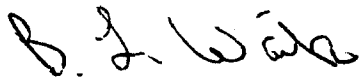
Registrant's position is that the facts demonstrate that Petitioner has no trademark rights in and to THE BLACK CLOUDS because of insufficient trademark use. Alternatively, whatever trademark rights he might have had in 2008-09 he abandoned after over four years of non-use. On this record, the Board can find in Registrant's favor.

The evidence of confusion that Petitioner presents is akin to that of misdirected mail or telephone calls which are discounted by the courts as evidence of actual confusion due to their hearsay nature and as evidence of inattentiveness on the part of the caller or sender. *Duluth News-Tribune, a Div. of Northwest Publications, Inc. v. Mesabi Pub. Co.*, 84 F.3d 1093, 1098 (8th Cir. 1996). In this case, websites electronically aggregate which mark goes on which page. Exhibit B, paragraph 5. Thus, there is even less weight to be given to a decision made by an algorithm and which could be easily corrected by Petitioner. *Id.*

Registrant also disputes that either band could be mistaken for the other. Petitioner's musical style is self-described as "grunge"and employs vocals. Exhibit B, paragraph 6. Registrant's musical style is "post-rock instrumental" and employs no vocals. *Id.*

Accordingly, Registrant respectfully submits that the Petition to Cancel Registration No. 4,233,433 must be denied.

BLACK CLOUDS, LLC



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Dated: February 20, 2015

EXHIBIT A

United States of America

United States Patent and Trademark Office

Black Clouds

Reg. No. 4,233,433

Registered Oct. 30, 2012

Int. Cl.: 9

TRADEMARK

PRINCIPAL REGISTER

HORENSTEIN, JUSTIN F (UNITED STATES INDIVIDUAL)
3449 DARTMOOR LANE
OLNEY, MD 20832 AND

RHODES, JAMES M (UNITED STATES INDIVIDUAL)
7818 TURNING CREEK COURT
POTOMAC, MD 20854 AND

HURT, ROSS P (UNITED STATES INDIVIDUAL)
2916 OLIVE ST NW
WASHINGTON, DC 20007

FOR: AUDIO AND VIDEO RECORDINGS FEATURING MUSIC AND ARTISTIC PERFORMANCES; AUDIO RECORDINGS FEATURING MUSIC; COMPACT DISCS FEATURING MUSIC; DIGITAL MUSIC DOWNLOADABLE FROM THE INTERNET; DOWNLOADABLE MUSIC FILES; DOWNLOADABLE MUSICAL SOUND RECORDINGS; DOWNLOADABLE MUSIC VIA THE INTERNET AND WIRELESS DEVICES; MUSICAL RECORDINGS; MUSICAL SOUND RECORDINGS; MUSICAL VIDEO RECORDINGS; SOUND RECORDINGS FEATURING MUSIC; VIDEO RECORDINGS FEATURING MUSIC , IN CLASS 9 (U.S. CLS. 21, 23, 26, 36 AND 38).

FIRST USE 10-5-2011; IN COMMERCE 11-20-2011.

THE MARK CONSISTS OF STANDARD CHARACTERS WITHOUT CLAIM TO ANY PARTICULAR FONT, STYLE, SIZE, OR COLOR.

SER. NO. 85-565,093, FILED 3-9-2012.

MATTHEW MCDOWELL, EXAMINING ATTORNEY

David J. Kappos

Director of the United States Patent and Trademark Office

EXHIBIT B

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

Daniel P. Matthews,

Petitioner,

v.

Cancellation No. 92058978
Registration No. 4,233,433

Black Clouds LLC,

Registrant.

Declaration of Ross Hurt in Support of Opposition to Petitioner's Motion for Summary Judgment

I, Ross Hurt, a member of Black Clouds LLC, hereby aver the following.

1. I have reviewed the Motion for Summary Judgment filed by Petitioner and the documents in support. In the statement of undisputed facts, Petitioner describes sale of his sound recordings via digital download and hard media. He also claims to have continuous sales throughout. After looking over Exhibit B, they have provided evidence of the sale of merely 21 compact discs between 2005 and 2014. Beyond that, they proved that there were ZERO sales between November 2009 and 2013; not one. Four years of no sales. This is during the window that we were researching the name. Considering they only sold 13 CDs prior to this window of no sales, it would have made it nearly impossible to discover a band of that size with such little market impact.

2. As far as digital sales goes: they have a total of 36 transactions for "digital sales". If you look closely at pgs 2 and 3 of Exhibit B, you will notice two VERY important facts. (1) They only sold ONE digital copy between August of 2009 and December of 2012 (during the window we researched and registered our mark). (2) 22 of all of those 36 digital transactions were sold for $0.00, meaning, ultimately they were not "selling" off the mark for any monetary gain, making it hard to believe their business is suffering due to us, when they are not actually "selling" anything off the mark, digitally.

3. The fuel logs provided in Exhibit A do not provide any "facts" of any sort. The petitioner claims they show his use of the mark on nationwide tours since 2009, but there are several things that are off here. (1) These simply show a list of cities and miles. There is no actual evidence of using the mark in any of these cities. There is no venue name, no booking contract, no itemization of CD's or shirts pertaining to the mark that may have been sold, no ticket sales, no actual proof they played anywhere/used the mark. Bottom-line, there is no actual evidence he did anything pertaining to the mark, merely a suggestion that he drove to these cities and recorded how much he may have spent on gas. (2) Petitioner claims that these tours were a means to promote the sound recordings, and he brought it to the attention of a diverse audience in several states. This is odd considering the sales reports in exhibit B show there were less than three total sales (CD and digital) between 2009 and 2012. If this was indeed a time to travel and promote the audio recordings of the mark, the sales reports do not reflect that in the least bit.

4. In regards to Exhibit D, those "facts" are flawed for the following reasons. (1) These are streamed plays, not sales. The sale is the streaming service (Spotitfy, Napster, Rhapsody) that customers pay for monthly, like Netflix. To suggest that each play is a "sale" is absurd. (2) There is no evidence of ANY market impact with these streams. As in, there is no way to prove who listened to these streams and with what intentions did they listen. There is not a regional list of who listened, an algorithm to show HOW these streams were discovered (were they searched for or automatically added to a queue?) not a list of places where the music was streamed or anything of the sorts. If I post a youtube video, I can click refresh a million times until I reach 1,000,000 views, but that doesn't mean it is actually being heard or seen by anyone aside from me.

5. Petitioner provided screenshots suggesting confusion between the two marks. To make things clear, websites electronically aggregate which mark goes on which page. After that, it is up to the person who holds the mark to police it on their own. We have done so, in removing any sites that have us listed under Petitioner's alleged mark. If Petitioner has records or MP3 or

info that is under our mark, we cannot change that. The band would have to put in the legwork with Amazon or AllMusic to make sure there is no confusion; we do not have the right to change the information on a product we don't own.

6. Petitioner claims that there is undeniable confusion with the marks. Here is why there is not. Petitioner's band has vocal; ours does not. If a listener hears vocals, they know they are listening to one and not the other. This often aggregates us in different categories, different genres, different markets, and different fan-bases' ears. They provided evidence that their music is classified as "brooding", "Grunge", or "hard rock" also making it known that they are from New Jersey (all of this is on the left hand side of Exhibit D). Our style is clearly defined as "Post-rock instrumental" and "Instrumental" on cdbaby. Ultimately "stumbling upon us" through third party searching for exactly what you are in the mood to listen to would make it nearly impossible if you were looking for bands that sound like them, and vice versa. Any listener of any genre of music would be able to recognize the difference and not find any confusion, just as one would not confuse Beethoven with Alice Cooper.

7. Above all, we did several in-depth searches for the our mark before settling on it. A review of WHOIS reveals that the domain name for THE BLACK CLOUDS.COM was not even registered until October 21, 2011. Our date of first use was October 5, 2011.

I declare under penalty of perjury that the foregoing is true and correct. Executed on February 19, 2015.

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WHOIS search results for:
THEBLACKCLOUDS.COM
(Registered)

Is this your domain? GO
Add hosting, email and more.

Want to buy this domain? GO
Get it with our Domain Buy service.

Domain Name: THEBLACKCLOUDS.COM
Registry Domain ID: 1683347267_DOMAIN_COM-VRSN
Registrar WHOIS Server: whois.godaddy.com
Registrar URL: http://www.godaddy.com
Update Date: 2013-12-21T15:32:17Z
Creation Date: 2011-10-21T15:59:57Z
Registrar Registration Expiration Date: 2021-10-21T15:59:57Z
Registrar: GoDaddy.com, LLC
Registrar IANA ID: 146
Registrar Abuse Contact Email: abuse@godaddy.com
Registrar Abuse Contact Phone: +1.480-624-2505
Domain Status: clientTransferProhibited http://www.icann.org/epp#clientTransferProhibited
Domain Status: clientUpdateProhibited http://www.icann.org/epp#clientUpdateProhibited
Domain Status: clientRenewProhibited http://www.icann.org/epp#clientRenewProhibited
Domain Status: clientDeleteProhibited http://www.icann.org/epp#clientDeleteProhibited
Registry Registrant ID:
Registrant Name: Domain Admin
Registrant Organization:
Registrant Street: 7731 Tuckerman LaneSuite 160
Registrant City: Potomac
Registrant State/Province: Maryland
Registrant Postal Code: 20854
Registrant Country: United States
Registrant Phone: +1.2404828701
Registrant Phone Ext:
Registrant Fax:
Registrant Fax Ext:
Registrant Email: admin@domainassetholdings.com
Registry Admin ID:
Admin Name: Domain Admin
Admin Organization:
Admin Street: 7731 Tuckerman LaneSuite 160
Admin City: Potomac
Admin State/Province: Maryland
Admin Postal Code: 20854
Admin Country: United States
Admin Phone: +1.2404828701
Admin Phone Ext:
Admin Fax:
Admin Fax Ext:
Admin Email: admin@domainassetholdings.com
Registry Tech ID:
Tech Name: Domain Admin
Tech Organization:
Tech Street: 7731 Tuckerman LaneSuite 160
Tech City: Potomac
Tech State/Province: Maryland
Tech Postal Code: 20854
Tech Country: United States
Tech Phone: +1.2404828701
Tech Phone Ext:
Tech Fax:
Tech Fax Ext:
Tech Email: admin@domainassetholdings.com
Name Server: NS1.HOSTBABY.COM
Name Server: NS2.HOSTBABY.COM
DNSSEC: unsigned
URL of the ICANN WHOIS Data Problem Reporting System: http://wdprs.internic.net/
Last update of WHOIS database: 2015-2-18T18:00:00Z

For more information on Whois status codes, please visit https://www.icann.org/resources/pages/epp-status-codes-2014-06-16-en

The data contained in GoDaddy.com, LLC's WHOIS database, while believed by the company to be reliable, is provided "as is" with no guarantee or warranties regarding its accuracy. This

Domain already taken?

Enter Domain Name .com Search

NameMatch Recommendations

GoDaddy.com NameMatch has found similar domain names related to your search. Registering multiple domain names may help protect your online brand and enable you to capture more Web traffic, which you can then direct to your primary domain.

Domains available for new registration:

Alternate TLDs		
theblackclouds.**info**	SAVE!	$2.99*/yr
theblackclouds.**net**	SAVE!	$9.99*/yr
theblackclouds.**org**	SAVE!	$8.99*/yr
theblackclouds.**us**	SAVE!	$3.99/yr
theblackclouds.**biz**	SAVE!	$7.99*/yr
theblackclouds.**mobi**	SAVE!	$6.99*/yr
theblackclouds.**ca**		$12.99/yr
theblackclouds.**me**	SAVE!	$9.99/yr
Similar Premium Domains ?		
TornadoClouds.com		$599.00*
BlackDraught.com		$1,349.00*
TheWhether.com		$1,299.00*
thebleakoftheblack.org		$499.00*
absoluteblackgranite.com		$2,744.00*
AdhArabLack.com		$888.00*

ADD TO CART

Domains available at Go Daddy Auctions®:

wallpaperclouds.com Ends on: 5/19/2015 12:59:00 PM PST	$999.00*
sunclouds.com Ends on: 5/3/2015 12:27:00 PM PST	$1,699.00*
blackandblacker.com Ends on: 4/21/2015 12:00:00 AM PST	$49,999.00*
highclouds.com Ends on: 4/19/2015 10:36:00 AM PST	$3,588.00*
cloudshop.net Ends on: 4/16/2015 9:53:00 AM PST	$3,588.00*
altostratusclouds.com Ends on: 4/15/2015 9:58:00 AM PST	$599.00*

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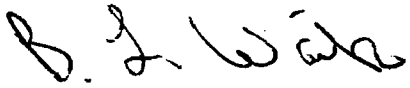
CERTIFICATE OF SERVICE

I, Barbara L. Waite, hereby certify that a true and accurate copy of the foregoing Opposition to Petitioner's Motion for Summary Judgment was served by first-class U.S. Mail, postage prepaid, on the following on this the 20th day of February, 2015:

Christopher J. Marino
Giordano Halleran & Ciesla, PC
125 Half Mile Rd., Ste. 300
Red Bank, NJ 07701

Attorney for Petitioner