EXHIBITS

Proceeding/Serial No: 91154398

Filed: 8/25/05

Title: DROWNING POOL, LLC

v

DROWNING POOL, a California general partnership consisting of Adam Elesh and Brett Smith, both Citizens of the United States

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August 22, 2005

U.S. Patent and Trademark Office
Trademark Trial and Appeal Board
P. O. Box 1451
Alexandria, VA 22313-1451

Re: Opposition No. 91154398
Opposer: Drowning Pool, LLC
Applicant: Drowning Pool

Dear Commissioner:

Enclosed are an original printed copy of Opposer's Trial Brief, together with a copy of Opposer's Trial Brief on a CD-ROM. Also enclosed are an original printed copy of Opposer's Statement of Objections, together with a copy of Opposer's Statement of Objections on a CD-ROM. Please acknowledge receipt and filing of the foregoing by having your mail room stamp the enclosed postcard with the date of receipt and returning it to us.

Very truly yours,

J. Rodgers Lunsford III

JRLIII/dmc
Enclosure
cc: Gordon E. Gray III, Esq.

Express Mail mailing label number **EL 948509300 US**
Date of Deposit: **August 22, 2005**
I hereby certify that this paper or fee is being deposited with the United States Postal Service "Express Mail Post Office to Addressee" service under 37 CFR 1.10 on the date indicated above and is addressed to The Commissioner of Trademarks, Box TTAB – NO FEE, P. O. Box 1451, Alexandria, VA 22313-3514

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LIT 918243.1

08-22-2005
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IN THE UNITED STATES PATENT & TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL & APPEAL BOARD

DROWNING POOL, LLC, A Texas limited liability company, Opposer, v. DROWNING POOL, a California general partnership consisting of Adam Elesh and Brett Smith, both citizens of the United States, Applicant.	)	Opposition No.: 91154398

OPPOSER'S STATEMENT OF OBJECTIONS

I. Benton Deposition (January 18, 2005) and Related Exhibits

Opposer objects to the following testimony and exhibits introduced by Applicant during the course of Mr. Benton's testimony:

A. Testimony:

1. Page 79, lines 12-22 on the grounds that there is insufficient evidence to support a finding that the witness has personal knowledge of the matter inquired about in violation of FED. R. EVID. 602.

B. Exhibits and Related Testimony:

1. App. Ex. 100 (Applicant's exhibits are referred to as "App. Ex.___") and the related testimony at page 74, line 7 through page 77, line 24 and page 131, lines 4-23 on the grounds that there is insufficient evidence to support a finding that the witness has personal knowledge of the matter inquired about in violation of FED. R. EVID. 602 and on the grounds that the same

constitutes inadmissible hearsay in violation of FED. R. EVID. 801, 802. (See page 122, lines 11-20.)

2. App. Ex. 101 and the related testimony at page 78, line 21 through page 79, line 11 on the grounds that the same constitutes inadmissible hearsay in violation of FED. R. EVID. 801, 802 and the related testimony at page 79, line 23 through page 80, line 5 on the grounds that there is insufficient evidence to support a finding that the witness has personal knowledge of the matter inquired about in violation of FED. R. EVID. 602 and on the grounds that the same constitutes inadmissible hearsay in violation of FED. R. EVID. 801, 802. *See* TBMP § 704(08). (See page 122, line 21 through page 123, line 6.)

3. App. Ex. 102 and the related testimony at page 80, line 8 through page 81, line 11 on the grounds that there is insufficient evidence to support a finding that the witness has personal knowledge of the matter inquired about in violation of FED. R. EVID. 602 and on the grounds that the same constitutes inadmissible hearsay in violation of FED. R. EVID. 801, 802. (See page 123, lines 7-14.)

4. App. Ex. 103 and the related testimony at page 81, line 17 through page 82, line 8 on the grounds that there is insufficient evidence to support a finding that the witness has personal knowledge of the matter inquired about in violation of FED. R. EVID. 602 and on the grounds that the same constitutes inadmissible hearsay in violation of FED. R. EVID. 801, 802. (See page 123, lines 15-20.)

5. App. Ex. 104: Opposer withdraws its objection to App. Ex. 104 made at page 123, lines 24-25.

6. App. Ex. 106 and the related testimony at page 85, line 3 through page 86, line 2 on the grounds that there is insufficient evidence to support a finding that the witness has personal

knowledge of the matter inquired about in violation of FED. R. EVID. 602, on the grounds that the same constitutes inadmissible hearsay in violation of FED. R. EVID. 801, 802 and that the exhibit has not been properly authenticated in violation of FED. R. EVID. 901. *See* TBMP § 704(08). (See page 123, line 25.)

7. App. Ex. 107 and the related testimony at page 87, line 16 through page 88, line 13 on the grounds that there is insufficient evidence to support a finding that the witness has personal knowledge of the matter inquired about in violation of FED. R. EVID. 602, on the grounds that the same constitutes inadmissible hearsay in violation of FED. R. EVID. 801, 802 and that the exhibit has not been properly authenticated in violation of FED. R. EVID. 901. *See* TBMP § 704(08). (See page 123, line 25 through page 124, line 1.)

8. App. Ex. 110 and the related testimony at page 91, line 21 through page 92, line 21 and page 93, line 8 through page 94, line 23 on the grounds that there is insufficient evidence to support a finding that the witness has personal knowledge of the matter inquired about in violation of FED. R. EVID. 602, on the grounds that the same constitutes inadmissible hearsay in violation of FED. R. EVID. 801, 802 and that the exhibit has not been properly authenticated in violation of FED. R. EVID. 901. *See* TBMP § 704(08). (See page 124, lines 2-9.)

9. App. Ex. 111 to the extent that the same contains information and entries other than those written by Mr. Benton on the grounds that there is insufficient evidence to support a finding that the witness has personal knowledge of the matter inquired about in violation of FED. R. EVID. 602, on the grounds that the same constitute inadmissible hearsay in violation of FED. R. EVID. 801, 802 and that the exhibit has not been properly authenticated in violation of FED. R. EVID. 901. (See page 124, line 10 through page 125, line 9.)

10. App. Ex.120 and the related testimony at page 119, line 12 through page 121, line 18 on the grounds that there is insufficient evidence to support a finding that the witness has personal knowledge of the matter inquired about in violation of FED. R. EVID. 602, on the grounds that the same constitutes inadmissible hearsay in violation of FED. R. EVID. 801, 802 and that the exhibit has not been properly authenticated in violation of FED. R. EVID. 901. *See* TBMP § 704(08). (See page 127, lines 8-16.)

II. Bassman Deposition (January 18, 2005) and Related Exhibits

Opposer objects to the following testimony and exhibits introduced by Applicant during the course of Mr. Bassman's testimony:

A. Testimony:

1. Page 45, line 1 through page 46, line 23; page 61, lines 2-7, and page 62, lines 7-10 on the grounds that the questions propounded would produce testimony protected by the attorney client privilege.

2. Page 51, lines 5-24 on the grounds that such testimony is irrelevant in violation of FED. R. EVID. 401 and 402.

B. Exhibits and Related Testimony:

1. App. Ex. 110 and the related testimony at page 33, line 23 through page 35, line 5, page 35, line 17 through page 37, line 4 and page 38, line 21 through page 39, line 17 on the grounds that there is insufficient evidence to support a finding that the witness has personal knowledge of the matter inquired about in violation of FED. R. EVID. 602, on the grounds that the same constitutes inadmissible hearsay in violation of FED. R. EVID. 801, 802 and that the exhibit has not been properly authenticated in violation of FED. R. EVID. 901. (See objection at I.B.8. above.)

2. App. Ex.120 and the related testimony at page 65, line 15 through page 67, line 17 on the grounds that there is insufficient evidence to support a finding that the witness has personal knowledge of the matter inquired about in violation of FED. R. EVID. 602, on the grounds that the same constitutes inadmissible hearsay in violation of FED. R. EVID. 801, 802 and that the exhibit has not been properly authenticated in violation of FED. R. EVID. 901. (See objections at I.B.10. above.)

III. Nixon Deposition (January 19, 2005) and Related Exhibits

Opposer has previously withdrawn Mr. Nixon's testimony which was taken solely to provide the basis of summaries prepared by Mr. Nixon. However, because Applicant, during its subsequent testimony period, introduced those underlying documents previously used to prepare such summaries, Mr. Nixon's testimony is duplicative and cumulative, and is no longer necessary. Nevertheless, because the transcript must be tendered pursuant to TBMP § 703.01(l), Opposer objects to the following cross-examination by Applicant during the course of Mr. Nixon's testimony:

A. Testimony:

1. Page 13, lines 4-18; page 14, line 21 through page 15, line 5; page 18, line 16 through page 20, line 15 on the grounds that such cross examination exceeds the scope of the witness's direct testimony.

IV. Elesh Deposition II (April 6, 2005) and Related Exhibits

Opposer objects to the following testimony and exhibits introduced by Applicant during the course of Mr. Elesh's testimony:

A. Testimony:

1. Page 47, lines 17-22 on the grounds that the same constitutes inadmissible hearsay in violation of FED. R. EVID. 801, 802.

2. Page 48, lines 12-15 on the grounds that the same constitutes inadmissible hearsay in violation of FED. R. EVID. 801, 802.

3. Page 54, lines 15-20 on the grounds that the same constitutes inadmissible hearsay in violation of FED. R. EVID. 801, 802.

B. Exhibits and Related Testimony:

1. App. Ex. 127 and the related testimony at page 17, line 6 through page 18, line 3 on the grounds that the same constitutes inadmissible hearsay and that the exhibit has not been properly authenticated in violation of FED. R. EVID. 801, 802 and 901. (See page 64, lines 1-3.)

2. App. Ex. 131 pp. 6-17 and 33-34 on the grounds that the same constitutes inadmissible hearsay and that the document has not been properly authenticated in violation of FED. R. EVID. 801, 802 and 901. (See page 64, line 19 through page 65, line 25).

3. App Ex. 133 p. 4 (O-0046): Opposer withdraws its objection to this page because the same was subsequently identified and authenticated by Mr. Licher. (See page 67, lines 7 – 16).

4. App. Ex. 142 p. 11: Opposer withdraws its objection to this page because the same was subsequently identified and authenticated by Mr. Licher. (See page 67, lines 4-11.)

V. Smith Deposition (April 6-7, 2005) and Related Exhibits

Opposer objects to the following testimony and exhibits introduced by Applicant during the course of Mr. Smith's testimony:

A. Exhibits and Related Testimony:

1. App. Ex. 127 and the related testimony at page 22, line 8 through page 24, line 24 and page 16, line 24 through page 20, line 12 on the grounds that the same constitutes inadmissible hearsay and that the exhibit has not been properly authenticated in violation of FED. R. EVID. 801, 802 and 901. *See* TBMP § 704(08). (See page 49, line 25 – page 50, line 3.)

2. App. Ex. 136 and the related testimony at page 16, line 24 through page 20, line 12 on the grounds that the same constitutes inadmissible hearsay and that the exhibit has not been properly authenticated in violation of FED. R. EVID. 801, 802 and 901. *See* TBMP § 704(08). (See page 50, lines 4-11.)

3. App. Ex. 138 and the related testimony at page 39, line 20 through page 40, line 2 on the grounds that the same constitutes inadmissible hearsay and that the exhibit has not been properly authenticated in violation of FED. R. EVID. 801, 802 and 901. *See* TBMP § 704(08). (See page 51, lines 11-16.)

4. App. Ex. 143 p.1 and the related testimony at page 41, line 21 through page 42, line 1 and lines 11-23 on the grounds that the same constitutes inadmissible hearsay and that the exhibit has not been properly authenticated in violation of FED. R. EVID. 801, 802 and 901. and the exhibit is irrelevant being sales by Scarface Charley Agency, not Applicant Drowning Pool in violation of FED. R. EVID. 401 and 402. (See page41, lines 18-20 and page 51, lines 17-24.)

5. App. Ex 169 and the related testimony at page 129, line 14 through page 131, line 4 on the grounds that the same constitutes inadmissible hearsay and that the exhibit has not been properly authenticated in violation of FED. R. EVID. 801, 802 and 901 and on the grounds that such testimony and the exhibit exceed the scope of cross examination and are inadmissible on redirect. (See page 130, lines 12-14 and page 143, lines 4 –19.)

6. App. Ex. 170 and the related testimony at page 133, line 1 through page 134, line 14 on the grounds that the same constitutes inadmissible hearsay and that the exhibit has not been properly authenticated in violation of FED. R. EVID. 801, 802 and 901 and on the grounds that such testimony and the exhibit exceed the scope of cross examination and are inadmissible on redirect. (See page 133, lines 12-14 and page 143, lines 20 – 21.)

7. App. Ex. 171: Opposer withdraws its objections to App. Ex. 171. (See page 136, lines 17 - 20 and page 143, lines 22 – 23.)

8. App. Ex. 172: Opposer withdraws its objections to App. Ex. 172. (See page 139, lines 4 – 7 and page 143, lines 24 –25.)

9. App. Ex. 173 and the related testimony at page 139, line 17 through page 141, line 12 on the grounds that the same constitutes inadmissible hearsay and that the exhibit has not been properly authenticated in violation of FED. R. EVID. 801, 802 and 901 and on the grounds that such testimony and the exhibit exceed the scope of cross examination and are inadmissible on redirect. (See page 140, lines 17-19 and page 144, lines 1 – 8.)

10. App. Ex. 174 and the related testimony at page 141, line 13 through page 141, line 17 on the grounds that the same constitutes inadmissible hearsay and that the exhibit has not been properly authenticated in violation of FED. R. EVID. 801, 802 and 901 and on the grounds that such testimony and the exhibit exceed the scope of cross examination and are inadmissible on redirect. (See page 141, lines 23 - 25 and page 144, lines 11 – 15.)

VI. Licher Deposition (April 7, 2005) and Related Exhibits

Opposer objects to the following testimony and exhibits introduced by Applicant during the course of Mr. Licher's testimony:

A. Exhibits and Related Testimony:

1. App. Ex. 146 on the grounds that the same constitutes inadmissible hearsay in violation of FED. R. EVID. 801, 802. (See page 60, lines 4-15.)

VII. Benton Rebutal Deposition (April 7, 2005) and Related Exhibits

Opposer objects to the following testimony during the course of Mr. Benton's testimony:

A. Testimony:

1. Page 23, line 6 through page 25, line 2 on the grounds that such cross examination exceeds the scope of the witnesses direct rebuttal testimony.

VIII. Applicant's Notice of Reliance

Opposer objects to the following exhibits in Applicant's Notice of Reliance:

1. App. Ex. 100 on the grounds that the same constitutes inadmissible hearsay in violation of FED. R. EVID. 801, 802 and that the exhibit has not been properly authenticated in violation of FED. R. EVID. 901.

2. App. Ex. 101 on the grounds that the same constitutes inadmissible hearsay in violation of FED. R. EVID. 801, 802 and that the exhibit has not been properly authenticated in violation of FED. R. EVID. 901. *See* TBMP § 704(08).

3. App. Ex. 102 on the grounds that the same constitutes inadmissible hearsay in violation of FED. R. EVID. 801, 802 and that the exhibit has not been properly authenticated in violation of FED. R. EVID. 901.

4. App. Ex. 103 on the grounds that the same constitutes inadmissible hearsay in violation of FED. R. EVID. 801, 802 and that the exhibit has not been properly authenticated in violation of FED. R. EVID. 901.

5. App. Ex. 127 on the grounds that the same constitutes inadmissible hearsay in violation of FED. R. EVID. 801, 802 and that the exhibit has not been properly authenticated in violation of FED. R. EVID. 901. *See* TBMP § 704(08).

6. App. Ex. 136 on the grounds that the same constitutes inadmissible hearsay in violation of FED. R. EVID. 801, 802 and that the exhibit has not been properly authenticated in violation of FED. R. EVID. 901. *See* TBMP § 704(08).

7. App. Ex. 138 on the grounds that the same constitutes inadmissible hearsay in violation of FED. R. EVID. 801, 802 and that the exhibit has not been properly authenticated in violation of FED. R. EVID. 901. *See* TBMP § 704(08).

8. App. Ex. 175 on the grounds that the same is irrelevant and inadmissible under FED. R. EVID. 401 and 402, that the same constitutes inadmissible expert testimony under FED. R. EVID. 702, that the same constitutes inadmissible hearsay in violation of FED. R. EVID. 801, 802 and that the exhibit has not been properly authenticated in violation of FED. R. EVID. 901.

9. App. Ex. 176 on the grounds that the same is irrelevant and inadmissible under FED. R. EVID. 401 and 402, that the same constitutes inadmissible expert testimony under FED. R. EVID. 702, that the same constitutes inadmissible hearsay in violation of FED. R. EVID. 801, 802 and that the exhibit has not been properly authenticated in violation of FED. R. EVID. 901.

10. App. Ex. 177 on the grounds that the same is irrelevant and inadmissible under FED. R. EVID. 401 and 402, that the same constitutes inadmissible expert testimony under FED. R. EVID. 702, that the same constitutes inadmissible hearsay in violation of FED. R. EVID. 801, 802 and that the exhibit has not been properly authenticated in violation of FED. R. EVID. 901.

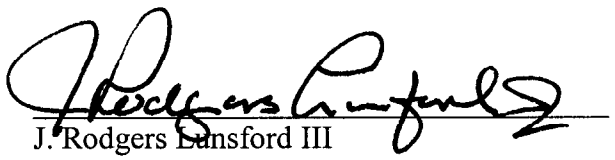
11. App. Ex. 178 on the grounds that the same is irrelevant and inadmissible under FED. R. EVID. 401 and 402, that the same constitutes inadmissible expert testimony under FED. R.

EVID. 702, that the same constitutes inadmissible hearsay in violation of FED. R. EVID. 801, 802 and that the exhibit has not been properly authenticated in violation of FED. R. EVID. 901.

12. App. Ex. 179 on the grounds that the same is irrelevant and inadmissible under FED. R. EVID. 401 and 402, that the same constitutes inadmissible expert testimony under FED. R. EVID. 702, that the same constitutes inadmissible hearsay in violation of FED. R. EVID. 801, 802 and that the exhibit has not been properly authenticated in violation of FED. R. EVID. 901.

This 22d day of August, 2005.

Respectfully submitted,



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Counsel for Opposer, DROWNING POOL, LLC

CERTIFICATE OF SERVICE

I hereby certify that a true and correct copy of the foregoing OPPOSER'S STATEMENT OF OBJECTIONS was mailed to the following via United States first class mail, postage prepaid:

Gordon E. Gray III
GRAY LAW FIRM
4401 N. Atlantic Avenue
Suite 233
Long Beach, CA 90807

This 22nd day of August, 2005.

J. Rodgers Lansford III

LIT\918116.2

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

DROWNING POOL, LLC, A Texas limited liability company, Opposer, v. DROWNING POOL, a California general partnership consisting of Adam Elesh and Brett Smith, both citizens of the United States, Applicant.	)	Opposition No.: 91154398

OPPOSER'S TRIAL BRIEF

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I. INTRODUCTION

As shown more fully below, in 1990, Applicant abandoned any rights it may have had to the Drowning Pool mark by discontinuing use of the mark and thereafter affirmatively exhibiting an intent not to resume use. Alternatively, Applicant abandoned any rights it may have had to the Drowning Pool mark by not using the mark for various three year periods from 1991 – 2003 and failing to present sufficient evidence to rebut the corresponding prima facie evidence of abandonment. Moreover, any residual use of the mark from 1991 until 2003 falls far short of the requisite use of the mark in the ordinary course of trade and, therefore, is insufficient to avoid a finding of abandonment. In view of Applicant's abandonment of the Drowning Pool mark, and because Opposer has made substantial and continuous use of the Drowning Pool mark since 1995 and has acquired ownership of it, the Opposition should be sustained and the Application to Register refused.

II. STATEMENT OF FACTS

A. APPLICANT'S HISTORY.

As previously conceded,[1] in 1984, Applicant appeared live at venues in and around Los Angeles County, California, under the Drowning Pool mark. (Elesh Dep. II, 6:5).[2] Opposer also concedes that from 1985 until 1990, Applicant recorded and released a self-titled album "Drowning Pool," more commonly referred to as "the Green Album," a second self-titled album "Drowning Pool," sold through Viva Records in Italy, an album titled "Nierika," an album titled

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[1] *See* Opposer's response to Applicant's Motion for Summary Judgment and the Board's Order denying the same. *Drowning Pool, LLC v. Drowning Pool*, 2004 WL 1475663, at *3 (T.T.A.B. June 30, 2004).

[2] Adam Elesh was deposed by Opposer on January 20, 2005, and by Applicant on April 6, 2005. Mr. Elesh's January deposition transcript will be referred to as "Elesh Dep. I, [page]:[line]" and his April deposition transcript as "Elesh Dep. II, [page]:[line]."

"Satori," an album titled "Aphonia," a song titled "Italian Pop Song" that was used on the compilation album "Viva Los Angeles II," a song titled "Edith, Hold Out Your Hand" that was used on the compilation album "Ultraviolet," and a song titled "Black Baghdad" that was used on the compilation album "Doctor Death's Volume III" and on the compilation album "Fundamental Hymnal," all of which involved the use of the Drowning Pool mark. (Elesh Dep. II, 6:8 to 9:2, 18:4 to 23:6; App. Ex. 128 to Elesh Dep. II at pp. 1-11).[3]

However, in 1989, Applicant's lead vocalist, Andrew Crane, left Applicant's band prior to the recording of the "Aphonia" album. (Elesh Dep. II, 20:14-23). In fact, the title of Applicant's last album, "Aphonia," means "loss of voice," and was a precursor of Applicant's abandonment of the Drowning Pool mark. (Elesh Dep. II, 20:24 to 21:2. *See* Opp. Not. Rel. I, Ex. 2, *Webster's New World Dictionary* 63 (2d College ed. 1980)).[4]

B. APPLICANT'S DEMISE.

In 1990, Applicant, now without its lead vocalist, renamed its band "Mumbles" and released a tape titled "Mumbles 1/Mumbles 2" and a compact disc titled "Two Clouds." (Elesh Dep. II, 23:7 to 24:11; Smith Dep., 25:15-20). Although Applicant contends that the "Drowning Pool" **mark** appears on these releases (Elesh Dep. II, 39:18 to 40:17; Smith Dep., 26:11 to 27:18), such is not the case. Rather, the name "Drowning Pool Music" appears on the "Mumbles

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[3] Applicant's Exhibits are attached to the deposition transcripts of record and will be referred to as "App. Ex. __ to ____ Dep." Specific document production numbers and/or page numbers may also be provided when referring to particular pages in an exhibit, thus "App. Ex. __ to ____ Dep. at p. __, Doc. __."

[4] Opposer has filed two Notices of Reliance which will be referred to as "Opp. Not. Rel. I" and "Opp. Not. Rel. II," respectively. Through the Notices of Reliance, Opposer has introduced exhibits attached to each Notice and exhibits attached to Opposer's Response to Applicant's Motion for Summary Judgment. Such exhibits will be referred to as "Opp. Not. Rel. __, Ex. __, (*general description of exhibit*)" and Opp. Not. Rel. __, Opp. Resp., Ex. __ (*general description of exhibit*)," respectively.

1/Mumbles 2" and "Two Clouds" releases (Elesh Dep. II, 99:6 to 101:22; App. Ex. 128 to Elesh Dep. II at pp. 12-13; Smith Dep., 76:22 to 77:22) – a clear reference to the **trade name** of Applicant's publishing company. (Elesh Dep. II, 10:4-7). The "Two Clouds" album does, however, prominently display the abbreviation "R.I.P.D.P" (App. Ex. 128 to Elesh Dep. II at p. 13), a notation that each member of Applicant freely admits means "Rest in Peace Drowning Pool":

Q. And do the letters R.I.P.D.P. appear [on the "Two Clouds" album]?

A. Yes.

Q. And what does that mean?

A. "Rest in Peace Drowning Pool."

(Elesh Dep. II, 29:9-22)

Q. Are the letters R.I.P.D.P. on that image [of the "Two Clouds" CD], as well?

A. Yes.

Q. What does that mean?

A. It stands for "Rest in Peace Drowning Pool."

(Smith Dep., 27:19-23). It is common knowledge that the phrase "Rest In Peace" means to lie peacefully dead. Thus, by Applicant's own public admission, Drowning Pool died in 1990.

In promoting Applicant under its new Mumbles mark, Applicant further confirmed the demise of the band and the abandonment of the Drowning Pool mark. Specifically, Adam Elesh and/or Brett Smith prepared and produced flyers for Applicant that identified the members of the band Mumbles as "**formerly** Drowning Pool," "**formerly known as** Drowning Pool," or "**what once was** Drowning Pool" (emphasis added). (Elesh Dep. I, 65:20 to 66:2, 73:1 to 78:8; Opp.

Exs. 40 and 42-46 to Elesh Dep. I).[5] One such flyer includes a solicitation for a lead singer, stating "MUMBLES (**formerly** Drowning Pool) Seeks ONE HONEST SINGER." (Opp. Ex. 40 to Elesh Dep. I) (emphasis added). The solicitation flyer was prepared by Scarface Charley Agency, a partnership comprised of Mr. Elesh and Mr. Smith, the same individuals that comprise Applicant. (Elesh Dep. I, 65:20 to 66:25). Scarface Charley Agency also prepared another flyer for Applicant under the Mumbles mark which states "**Prior to** the discovery of Kelly Ray ["Mumbles" lead singer], Adam, Brett, and Jon [Thomas] formed the nucleus of DROWNING POOL, and **their previous career** has left them with a number of critically acclaimed releases . . . ." (Opp. Ex. 43 to Elesh Dep. I; Elesh Dep. I, 74:14 to 75:3) (emphasis added).

Mr. Elesh also personally prepared flyers to promote Applicant's appearances under its Mumbles mark at local venues, flyers which unambiguously convey to the public the message that the band Drowning Pool ceased to exist. (Opp. Exs. 44-46 to Elesh Dep. I; Elesh Dep. I, 7724 to 78:8). For instance, in a flyer to promote a Mumbles performance at the Lectisternium, a venue in western Los Angeles County, Culver City, California, Mr. Elesh prominently states "what once was Drowning Pool, is now . . . MUMBLES." (Opp. Ex. 44 to Elesh Dep. I) (ellipsis in original). Similarly, in a flyer to promote a Mumbles performance at the Lingerie Club, a venue in Hollywood, California, and a second flyer to promote another Mumbles performance at the Lectisternium, Mr. Elesh prominently states "MUMBLES (FORMERLY DROWNING POOL)." (Opp. Exs. 45 and 46 to Elesh Dep. I).

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[5] Opposer's Exhibits are attached to the deposition transcripts of record and will be referred to as "Opp. Ex. __ to ____ Dep." Specific document production numbers and/or page numbers may also be provided when referring to particular pages in an exhibit, thus "Opp. Ex. __ to ____ Dep. at p. __, Doc. __."

In addition, various print media publications published articles, frequently after interviews with Applicant, that conveyed to the public the clear message that Applicant no longer performed under the Drowning Pool mark but, rather, had adopted the new mark Mumbles to identify its entertainment services. For example, a story about Mumbles in *In Pittsburg* magazine compared the Mumbles "Two Clouds" album with "[f]our albums released by the group when they were called Drowning Pool . . . ." (Opp. Ex. 47 to Elesh Dep. I). A second story in *In Pittsburg* magazine regarding a Mumbles performance at the Lectisternium describes Mumbles as "the new band ex-Drowning Pool members have formed." (Opp. Not. Rel. I, Opp. Resp., Ex. P, Decl. Ex. 5, Doc. AP1630 (*In Pittsburgh* newspaper excerpt)). Likewise, other publications present the same clear message. *See* Opp. Not. Rel. I, Opp. Resp., Ex. P, Decl. Ex. 5, Doc. AP1630 (magazine excerpts):

- ("DEMO CRITIQUE: Formerly known as Drowning Pool, the guys added a part-time vocalist . . . and now call themselves Mumbles.")
- ("DROWNING POOL *APHONIA* MUMBLES: Drowning Pool's third (and presumably final) album . . . . The songs are a fitting swan song . . . . However, all is not lost. The three instrumentalists have stayed together but have renamed themselves as Mumbles.");

and Opp. Not. Rel. I, Opp. Resp., Ex. P, Decl. Ex. 5, Doc. AP1634 (*Melody Maker* magazine excerpt)

- ("MUMBLES: DROWNING Pool has ended, MUMBLES is the new happening deal.").

Most notably, in or about April 1991, Mr. Elesh and Mr. Smith were interviewed for a story about Mumbles in the *L.A. Times,* a widely read newspaper not only in Los Angeles

County, California, but throughout the country. (Elesh Dep. I, 82:21 to 83:9). The article describes the band's approach: "Exploration was the founding principle when the band started out under its **former name** of Drowning Pool, according to bassist Brett Smith," then recites the lifespan and confirms the death of Drowning Pool: "Drowning Pool, **which lasted from 1984 to 1989**, issued several albums on tiny, underground labels that didn't do much to drag the band's profile out of the deep end. . . . When Drowning Pool's singer left in 1988, Smith, Elesh, and Thomas made an all-instrumental album **as a farewell to the old name**, then decided to hang together **with a new name** and a new approach." (Opp. Ex. 48 to Elesh Dep. I) (emphasis added). Moreover, when asked about such statements, Mr. Elesh admits that they are true and correct:

Q. It's the second full paragraph in the right-hand most column that begins, "When Drowning Pool's singer . . ."

A. Yes.

Q. Would you read that to yourself, please.

A. I've read it.

Q. That's a true and correct statement based on what you and Mr. Smith told Mr. Bohem [the author of the article] during the course of the interview, isn't it?

[A.] Yes.

Q. Now, I would like for you to read the paragraph that begins at the bottom of the left-hand most column. It begins so far down to the end of the paragraph, the actual paragraph bridges columns one and two. If you will read that paragraph and tell me, you know, when you conclude.

A. I've read it.

Q. That paragraph is true and correct based on what you and Mr. Smith told Mr. Boehm in the interview, isn't it?

[A.] As far as I remember.

Elesh Dep. I, 84:19 to 85:17 (objections by counsel for Applicant omitted).

Even Applicant's "[own] record company," Independent Project Records ("IPR") (Elesh Dep. II, 46:15-17), informed the relevant consuming public that Applicant had adopted a new mark. IPR's fall 1991 mail order price list includes Applicant's "Two Clouds" album and identifies Applicant under its Mumbles mark as "**[f]ormerly known as** DROWNING POOL, this first release **under the new name** . . . ." (App. Ex. 153 to Licher Dep. at Doc. AP0131; Licher Dep., 68:22 to 69:5) (emphasis added). The same price list also describes Applicant's "Aphonia" album as Applicant's "[l]ast LP **before changing their name** to MUMBLES." (App. Ex. 153 to Licher Dep. at Doc. AP0131; Licher Dep., 68:12-21) (emphasis added).

IPR also informed the public of Applicant's exit from the market under the Drowning Pool mark by designating Applicant's albums as "out-of-print" or "the last copies available." Specifically, IPR's spring 1991 mail order price list contains the legend "[w]e've just acquired a small batch of this out-of-print first lp . . . ." adjacent to the listing for Applicant's "Green" album. (Licher Dep., 65:4-18; App. Ex. 152 to Licher Dep. at Doc. AP0127). Likewise, IPR's fall 1991 mail order pricelist contains the legends "we have the last copies available . . . ." adjacent to the listing for Applicant's "Green" album. (Licher Dep., 67:15 to 68:10: App. Ex. 153 to Licher Dep. at Doc. AP0131). In its 1995 mail order catalog, IPR also lists Applicant's "Satori" album as "out-of-print." (Licher Dep. 70:5 to 71:11; 156 to Licher Dep. at Doc. AP0135).

When asked about the aforementioned statements, Mr. Licher testified that he believed that the statements were true and correct:

Q. As the owner of Independent Project Records, you believe that the information contained in the price list[s] and catalogs of Independent Project Records is true and correct, don't you?

A. Yes, I do.

. . .

Q. And you would agree with me, wouldn't you, that as of the spring of 1991, the Drowning Pool Green LP was out of print?

A. Well, as anyone knows who is involved in the music industry, records can go in and out of print at various times. So a particular record in the spring of 1991 could have been out of print, but it could also have come back into print at a later date.

Q. But your price list said it was out of print, doesn't it?

A. At that particular time that - -

Q. And that statement was true as of that particular time, wasn't it?

A. As of that particular time, that particular record was out of print.

. . .

Q. And the information listed underneath that heading says, "Earliest release on their own label. We have the last copies available." Isn't that true.

A. At that time it was my belief that those were the last copies that were available for sale.

(Licher Dep., 64:16-22, 66:2-24, and 67:25 to 68:10) (objections by counsel for Applicant omitted).

Remarkably, Applicant has offered no tangible evidence that contradicts such admissions or even suggests that the conclusion of abandonment that follows from them is inaccurate. Thus, Applicant's own statements preponderantly demonstrate that no later than 1990 it affirmatively abandoned the Drowning Pool mark within the meaning of 15 U.S.C. § 1127, and adopted and thereafter used the mark "Mumbles" to identify its entertainment services.

In addition to Applicant's above public pronouncements of its abandonment of the Drowning Pool mark, Applicant's private actions and inaction, starting in about 1990, also strongly support the conclusion that Applicant abandoned the Drowning Pool mark. First, the personal income tax returns and employment history of the members of Applicant suggest that they left the music business soon after forming Mumbles. In 1991, Adam Elesh entered the Art Center College of Design in Pasadena, California as a full-time student, from which he graduated in 1995 with a bachelor's degree in art. (Elesh Dep. I, 10:17 to 11:6). One month after graduation in 1995, Mr. Elesh began a graphics business. (Elesh Dep. I, 11:7 to 12:2). On his 1995 personal income tax return, Mr. Elesh listed his occupation as "Graphics" and did not include any income, expense or other data or information relating to a music business. (Opp. Ex. 19 to Elesh Dep. I; Elesh Dep. I, 12:17 to 14:14). In fact, not a single income tax return of Mr. Elesh produced in this proceeding, *i.e.*, returns for years 1995, 1996, 1997, 1998, 1999, 2000, and 2002, includes a Schedule C Profit or Loss statement for a music business and, during those years, Mr. Elesh never received a Form K-1 or Form 1099 from Applicant partnership Drowning Pool. (Opp. Exs. 19-28 to Elesh Dep. I; Elesh Dep. I, 12:6 to 53:25).

Similarly, on Brett Smith's 1991 personal income tax return, Mr. Smith listed his occupation as "Ceilings," identifying his employment in a construction business installing ceilings, and did not include any income, expense, or other data or information relating to a music business. (Opp. Ex. 88 to Smith Dep.; Smith Dep., 101:2 to 103:18). As with Mr. Elesh's returns, not one of Mr. Smith's income tax returns produced in this proceeding, *i.e.*, returns for years 1991, 1992, 1993, 1994, 1998, 1999, 2000, 2001, and 2002, includes a Schedule C Profit or Loss statement for a music business and, during those years, Mr. Smith never received a Form K-1 or Form 1099 from Applicant partnership Drowning Pool. (Opp. Exs. 88-96 to Smith Dep.; Smith Dep., 101:2 to 121:6).

Second, the extent of airplay of Applicant's records in the decade of the 90's was so insignificant and the corresponding royalties earned by Applicant were so de minimis that Mr. Elesh failed to keep a current address with BMI from about 1990 until June 2000. (Opp. Ex. 52 to Elesh Dep. II; Elesh Dep. II, 79:7 to 87:2). With the exception of one royalty statement for the first quarter of 1989 (Opp. Ex. 52 to Elesh Dep. II at p. 22, Doc. AP0224), every statement from BMI to Mr. Elesh introduced by Applicant lists Mr. Elesh's address as "UNKNOWN." (Opp. Ex. 52 to Elesh Dep. II at pp. 2-8 and 10-21, Docs. AP0199-AP0205 and AP0212-AP0223). Finally, on June 22, 2000, BMI forwarded to Mr. Elesh a letter confirming his then current address and enclosing a check in the amount of $53.49 for royalties "**withheld due to lack of address**" and the corresponding statement(s) from 1991 to 2000. (Opp. Ex. 52 to Elesh Dep. II at p. 1, Doc. AP0198) (emphasis added). Not only is the total royalty amount of $53.49

for the 1991-2000 time period de minimis,[6] remarkably, BMI did not have Mr. Elesh's address for almost ten (10) years.

Third, the last time either Adam Elesh or Brett Smith provided IPR (their record company) with Drowning Pool vinyl records was "sometime in the early 1990's." (Licher Dep., 98:10-16).

Fourth, Applicant testified that it has not used its Drowning Pool master tapes to make a Drowning Pool vinyl album since 1992, if not earlier, and has not used its Drowning Pool master tapes to make any Drowning Pool compact discs other than the "Aphonia" CD, released in 1989 or 1990 (Elesh Dep. II, 102:13-19), and the "Green" CD, released thirteen years later in 2003 (Elesh Dep. II, 42:8 to 43:1):

> Q. Now, the master tapes that comprise Applicant's Exhibit 137 have been used to create only two CD's; isn't that correct? . . . Only two CD's, the first one was the "Aphonia" CD, and the second one was "The Green Album" CD. There have been no other CD's made from the master tapes, have there?
>
> A. That's correct, there have been no other CD's made from the master tapes.
>
> Q. When was the last time that a record, a vinyl record was made from the master tapes?
>
> A. I don't recall.
>
> Q. It was in 1989 wasn't it, Mr. Smith?

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[6] *See* Opp. Ex. 52 to Elesh Dep. II at pp. 8 and 16 (reporting $3.44 in 1991), pp. 6 and 14 (reporting $2.21 in 1992), pp. 7 and 15 (reporting $32.92 in 1992), pp. 5 and 13 (reporting $2.73 in 1993), pp. 4 and 12 (reporting $1.26 in 1993), pp. 3 and 11 (reporting $9.03 in 1994), and pp. 2 and 10 (reporting $1.90 in 1996), the sum of which totals $53.49.

A. I don't recall.

Q. You don't - - do you recall [a] vinyl recording made from the master tapes in 1999?

A. No, I don't recall.

Q. Do you recall a vinyl album being made from the master tapes in 1998?

A. No, I don't recall.

Q. Do you recall a vinyl album being made from the master tapes in 1997?

A. No, I don't recall.

Q. Do you recall a vinyl album being made from the master tapes in 1996?

A. No, I don't recall.

Q. Do you recall a vinyl album being made from the master tapes in 1995?

A. No, I don't recall.

Q. Do you recall a vinyl album being made from the master tapes in 1994?

A. No, I don't recall.

Q. Do you recall a vinyl album being made from the master tapes in 1993?

A. No, I don't recall.

Q. Do you recall a vinyl album being made from the master tapes in 1992?

A. No, I don't recall.

Q. You yourself have never contracted for the production of a vinyl album from the master tapes, have you?

A. Yes, I have.

Q. But not - - not after 1992?

A. That's correct.

(Smith Dep., 78:7 to 80:3).

Fifth, Applicant's detailed business records (Opp. Exs. 29-38 to Smith Dep.), bank statements (Opp. Exs. 53, 55-87, 97-99, and 200 to Smith Dep.), invoices (App. Exs. 143 and 173 to Smith Dep.), track logs (App. Ex. 169 to Smith Dep.), radio station playlists (App. Ex. 170 to Smith Dep.), and mail (App. Exs. 171 and 172 to Smith Dep.) relating to Applicant's entertainment services under the Drowning Pool mark all abruptly end in 1990.

Applicant kept by hand detailed financial records for the entertainment services it rendered and the goods and promotional items it sold under the Drowning Pool mark from 1984 through early 1990. *See* Opp. Exs. 29-38 to Smith Dep.; *and* Smith Dep. 11:5-6 (the witness stating "February of 1990 is the last entry I have in this journal."). Applicant's financial records include a cash account journal with entries dating from November 16, 1984, to December 1, 1989. (Opp. Ex. 29 to Smith Dep.; Smith Dep. 63:23 to 64:7). Applicant also kept capital account records for Brett Smith, Adam Elesh, Andrew Crane, and Jon Thomas[7] which include entries dating from November 16, 1984, to January 1, 1990. (Opp. Exs. 30-33 to Smith Dep.; Smith Dep. 64:9 to 65:16).

Applicant's business records also include an album disposition journal with entries dating from April 5, 1987, to February 5, 1990 (Opp. Ex. 34 to Smith Dep.; Smith Dep. 65:17-23); a tape disposition journal and a t-shirt journal with entries dating from April 1, 1987, to December

[7] Although Applicant has testified that Brett Smith and Adam Elesh are the only two partners in the partnership Drowning Pool (Smith Dep. 8:14 to 9:3), Applicant's capital account records show that Andrew Crane, Jon Thomas, and Tom Doyle contributed money to the partnership and that Andrew Crane and Jon Thomas received goods or money from the partnership. (Opp. Exs. 29-33 to Smith Dep.; Smith Dep. 52:11 to 63:22).

31, 1987 (Opp. Exs. 35 and 36 to Smith Dep.; Smith Dep. 66:6-13); and an inventory journal with entries dating from November 16, 1984, to April 21, 1987. (Opp. Ex. 37 to Smith Dep.; Smith Dep. 66:14-20). Lastly, Applicant's financial records include a general ledger with entries dating from November 16, 1984, to June 29, 1987. (Opp. Ex. 38 to Smith Dep.; Smith Dep. 66:21 to 67:1).[8]

Similarly, Applicant maintained a bank account and received statements which span almost continuously from October 1987 to January 1991, but show no activity after September 17, 1990. (Opp. Exs. 53, 55-87, 97-99, and 200 to Smith Dep.). Further, Applicant kept invoices for album consignments and sales dated in 1987, 1988, and 1989 (App. Exs. 143 and 173 to Smith Dep.), track logs dated from 1985 to 1988 (App. Ex. 169 to Smith Dep.), and radio station playlists from 1987 to 1989 (App. Ex. 170 to Smith Dep.), but none thereafter.[9] Likewise, Applicant saved mail it received from radio stations and fans from 1985 until 1990. Demonstrably, there is not a single item of mail received after 1990. (App. Exs. 171 and 172 to Smith Dep.).

Finally, Applicant maintained a scrapbook of all its activities under the Drowning Pool mark. Indeed, the title of Applicant's scrap book says it all: "**Drowning Pool 1984-1990**." (Opp. Ex. 39 to Elesh Dep. I) (emphasis added).

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[8] In view of the the detailed financial records maintained by Applicant and the varying dates the various journals and ledgers ended, Applicant's assertion that other receipts "exist," but that Applicant "got lazy" in keeping financial records (Smith Dep., 11:7-13 and 67:5 to 74:11), is simply not credible.

[9] Applicant introduced printouts of Internet web sites showing two radio station playlists for years 1994 and 1999, respectively (App. Ex. 136 to Smith Dep.). However, because such records were printed in 2003, they appear to have been obtained in anticipation of this Opposition rather than kept in the course of Applicant's business activities or record keeping, and are therefore, inadmissible. *See infra* at pp. 37-38.

C. APPLICANT'S DE MINIMIS RESIDUAL USE.

In the face of the foregoing facts, Applicant previously contended,[10] and likely will again contend, that from 1991 until 2003, residual use of the Drowning Pool mark precludes a finding of abandonment. Applicant was wrong then and again will be wrong. It is undisputed that between 1989 and 2003, Applicant did not release any new music for sale under the Drowning Pool mark. (Elesh Dep. I, 96:8 to 105:18).[11] Moreover, it is undisputed that between 1991 and 2003, Applicant did not make more than one alleged public appearance under the Drowning Pool mark. (Elesh Dep. I, 105:19 to 107:12; Elesh Dep. II, 41:9 to 42:9). It is also undisputed that between 1991 and 1999, Applicant did not tour under the Drowning Pool mark. (Elesh Dep. I, 95:3 to 96:7). Furthermore, Applicant's only evidence of record sales after 1990 consists of sales made by a single entity, IPR, its record company, which apparently acquired its entire inventory of Applicant's releases no later than the early 1990s or from others who acquired their inventory no later than 1990. (Licher Dep., 98:10 to 99:2).

Even more telling, Applicant has produced no evidence that it actively advertised or promoted its services under the Drowning Pool mark after 1990, although it did so frequently from 1985 through 1989. (Opp. Ex. 39 to Elesh Dep. I). On this subject, Mr. Elesh testified:

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[10] *Drowning Pool, LLC*, 2004 WL 1475663, at *3 .

[11] Although Applicant stated that 10 to 15 tapes were "given away" in 1997 (Elesh Dep. I, 104:6-19), such activity does not qualify as use of the Drowning Pool mark in commerce because federal trademark rights are created by actual use of the mark in commerce, 15 U.S.C. § 1051, and, as defined in the Lanham Act, "a mark shall be deemed to be in use in commerce . . . on goods when . . . the goods are **sold or transported** in commerce." 15 U.S.C. § 1127 (emphasis supplied).

Q. I'm asking whether the band Drowning Pool spent any money itself, the members of the band Drowning Pool spent any money on promotional literature or advertisements in calendar years 1992 through 1999?

A. Yes.

Q. And then I asked you for what years.

A. [19]96.

Q. And that was the only year?

A. I think so.

Q. And what was the advertising expense, what was the advertisement or promotional piece for which the expense was incurred?

A. A promotion for a show at Nana's with Brett and I of Drowning Pool, fliers.

Q. Do you have a copy of any promotional literature that was used for that particular performance?

A. I do not. I do not.

(Elesh Dep. I, 93:23 to 94:16).

From 1986-1990, Applicant distributed flyers promoting itself under the Drowning Pool mark, distributed engagement announcements of its performances under the Drowning Pool mark, was the subject of news articles in which it was identified by the Drowning Pool mark, and was the recipient of fan mail addressed to it under the Drowning Pool mark. (Opp. Ex. 39 to Elesh Dep. I; App. Ex. 172 to Smith Dep.). However, from 1991 through 2002, Applicant has not introduced into evidence (i) a single flyer promoting it under the Drowning Pool mark, (ii) a single engagement announcement for a performance by it under the Drowning Pool mark, (iii)

any news article identifying Applicant by the Drowning Pool mark (other than indicating its demise), or (iv) any fan mail addressed to it under the Drowning Pool mark.

In the face of the foregoing, Applicant must rely exclusively on the following to support its argument that, from 1991 until 2003, there has been residual use of the Drowning Pool mark: (i) aggregate royalty receipts of $240.17[12] ($53.49 of which was withheld until 2000 due to Mr. Elesh's failure to maintain an address with BMI);[13] (ii) IPR's sale[14] of a total of eighteen (18) albums[15] (all of which were manufactured prior to the early 1990s and acquired by IPR prior to 1991 or from others who acquired them prior to or at about the time of Drowning Pool's demise (Licher Dep., 98:10 to 99:2)); (iii) a self-described 1994 public performance by Smith and Elesh, allegedly as Drowning Pool (Elesh Dep. II, 41:6 to 42:9); (iv) two self-described unpublicized

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[12] *See* Opp Ex. 52 to Elesh Dep. II at pp. 8 and 16, Docs. AP0204 and AP0218 (reporting $3.44 in 1991); Opp. Ex. 89 to Smith Dep. at Doc. 1447 (reporting $36.36 and $10.31 in 1992); Opp. Ex. 52 to Elesh Dep. II at pp. 6 and 14, Docs. AP0203 and AP0216 (reporting $2.21 in 1992); Opp. Ex. 52 to Elesh Dep. II at pp. 7 and 15, Docs. AP0205 and AP0217 (reporting $32.92 in 1992 for airplay in Canada); Opp. Ex. 90 to Smith Dep. at Doc. 1456 (reporting $115.86 in 1993); Opp. Ex. 52 to Elesh Dep. II at pp. 5 and 13, Docs. AP0199 and AP0215 (reporting $2.73 in 1993); Opp. Ex. 52 to Elesh Dep. II at pp. 4 and 12, Docs. AP0200 and AP0214 (reporting $1.26 in 1993); Opp. Ex. 91 to Smith Dep. at Doc. AP1467 (reporting $24.15 in 1994); Opp. Ex. 52 to Elesh Dep. II at pp. 3 and 11, Docs. AP0201 and AP0213 (reporting $9.03 in 1994 for airplay in Belgium); and Opp. Ex. 52 to Elesh Dep. II at pp. 2 and 10, Docs. AP0202 and AP0212 (reporting $1.90 in 1996).

[13] Opp. Ex. 52 to Elesh Dep. II at p. 1, Doc. AP0198.

[14] Because consignments are not sales, the same were not included. *See* App. Ex. 157 to Licher Dep. (showing 12 albums consigned in 1995); App. Ex. 158 to Licher Dep. (showing 18 albums consigned in 1995); App. Ex. 160 to Licher Dep. (showing albums returned from consignment in 1997); App. Ex. 163 to Licher Dep. (showing 14 albums consigned in 1998); App. Ex. 167 to Licher Dep. (showing 3 albums consigned in 2002); and App. Ex. 168 to Licher Dep. (showing 6 albums consigned in 2002).

[15] App. Ex. 159 to Licher Dep. (showing sale of 13 albums to customer in Greece in 1996); App. Ex. 161 to Licher Dep. (showing sale of 3 albums in 1998); and App. Ex. 166 to Licher Depo. (showing sale of 2 albums in 2002).

recording sessions in 1996 (one by only Brett Smith and Adam Elesh[16] and the second including Smith, Elesh and others who were not previously members of Drowning Pool[17]) allegedly as Drowning Pool; (v) one fortuitous licensing arrangement in 1996 for a single song (for which no evidence has been introduced showing that the Drowning Pool mark was used) (Elesh Dep. II, 45:6-24); (vi) listings in a single entity's catalog[18] and two local radio station playlists;[19] and (vii) a May 3, 2000 license to IPR to sub-license Applicant's recordings for "digital music delivery"[20] (under which no sub-licensing ever occurred).[21] As shown hereinafter, such de minimis use is not only suspect, it is insufficient for Applicant to maintain ownership rights in the Drowning Pool mark.

D. OPPOSER'S HISTORY.

Opposer was founded in 1995 as a Texas general partnership consisting of Stevie Benton and three other individuals, and chose the name and mark "Drowning Pool" based on the title of the 1975 film "Drowning Pool" starring Paul Newman. (Benton Dep. I, 6:24 to 8:8).[22] In about

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[16] *See* Elesh Dep. II, 43:2-6; Smith Dep., 35:14-19. *But see* Opp. Not. Rel. I, Opp. Resp., Ex. K, (Applicant's Supplemental Response to Opposer's Interrogatory No. 3) (stating that the recording session occurred in 1992); and Elesh Dep. I, 98:5 to 99:21 (stating that the recording session occurred in 1993).

[17] Elesh Dep. I, 100:3-16.

[18] *See* App. Exs. 151-153 to Licher Dep. (1991 listing); App. Ex. 154 to Licher Dep. (1993 listing); App. Ex. 155 to Licher Dep. (1994 listing); App. Ex. 156 to Licher Dep. (1995 listing); App. Ex. 162 to Licher Dep. (1998 listing); App. Ex. 164 to Licher Dep. (2001 listing); and App. Ex. 165 to Licher Depo. (2002 listing).

[19] *See* App. Ex. 136 to Smith Dep. at p. 1 (showing one song included on Joe Radio's (Stanford Univ., CA) 1994 radio playlist); and App. Ex. 136 to Smith Dep. at p. 3 (showing one song included on KFJC's (Los Altos Hills, CA) 1999 radio playlist.

[20] App. Ex. 142 to Elesh Dep. II.

[21] Licher Depo., 97:17 to 98:8.

[22] Stevie Benton was deposed by Opposer on January 18, 2005 and on June 23, 2005. Mr. Benton's January deposition transcript will be referred to as "Benton Dep. I, [page]:[line]" and his June rebuttal deposition transcript as "Benton Dep. II, [page]:[line]."

1995, Opposer recorded the song "Skin," which was included in the compilation album titled "Lost in Dallas Compilation" that was released that same year and on which Opposer's Drowning Pool mark appeared. (Benton Dep. I, 8:16 to 10:12; Opp. Ex. 1 to Benton Dep. I). Opposer began publicly performing at various clubs and other venues under the Drowning Pool mark beginning in about 1995, and has done so extensively and continuously through the present. (Benton Dep. I, 11:2 to 29:1, 31:1 to 32:19, 33:20 to 34:22, 36:9 to 40:2, 41:8 to 42:20, 44:11 to 46:25, 51:3 to 55:25, 67:25 to 69:13, 70:6-16; Opp. Exs. 2-3 to Benton Dep. I).[23]

Mike Luce and C.J. Pierce moved from New Orleans to Dallas to join Opposer in 1996. (Benton Dep. I, 29:7 to 30:13). In 1997 and 1998, Opposer, now composed of Benton, Luce, Pierce, and Sean Field Hall, expanded the geographic area in which it performed under the Drowning Pool mark to include appearances in various clubs and other venues in cities such as Tulsa, Oklahoma; New Orleans, Louisiana; and other major cities throughout Texas in addition to Dallas. (Benton Dep. I, 31:1 to 32:19). In 1998, Sean Field Hall, Opposer's lead vocalist, left the band (Benton Dep. I, 30:14-17), and in about October of 1998, Dave Williams joined Opposer as lead vocalist. (Benton Dep. I, 30:18-23).

With Dave Williams as its "front man," Opposer released an album in May 1999 that was well received. Also in 1999, as a result of an invitation from the nationally recognized band "Sevendust," Opposer, under the Drowning Pool mark, joined "Sevendust" and another band "Double Drive" on a music tour which included Memphis, Tennessee; Knoxville, Tennessee;

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[23] Although Opposer's Notice of Opposition and the file of Opposer's trademark application Serial No. 76/305,997 give February 1, 2002, and February 1, 1999, as Opposer's date of first use of its Drowning Pool mark, respectively, since conducting background research during the preparation of Opposer's Response to Applicant's Motion for Summary Judgment, Opposer has consistently asserted to have first used its Drowning Pool mark in about 1995.

and Lafayette, Louisiana, then continued alone to perform in Salina, Kansas. (Benton Dep. I, 33:20 to 34:22).

In 2000, Opposer recorded and released its second album, "Pieces of Nothing," which featured a song titled "Tear Away." (Benton Dep. I, 34:23 to 35:10). "Tear Away" reached the top ten at the Dallas, Texas radio station "Active Rock, 97.1 KEGL" in the fall of 2000. (Benton Dep. I, 35:11 to 36:5). Also in 2000, Opposer participated in tours with the bands "Kittie" and "'Hed P.E." (Benton Dep. I, 41:14 to 42:8).

On November 15, 2000, Opposer signed a recording contract with Wind-Up Records. (Benton Dep. I, 40:5-15). Under this contract, from January to March of 2001, Opposer recorded an album titled "Sinner," and in about March of 2001, Opposer recorded a music video for a song featured on the "Sinner" album titled "Bodies." (Benton Dep. I, 40:16 to 41:7). In April 2001, Opposer's song "Bodies" was released to radio stations across the United States, and Opposer's music video for its song "Bodies" was released to MTV where it received special, public recognition as being "Buzzworthy. " (Benton Dep. I, 42:21 to 44:10).

Also in April 2001, Opposer toured with the band "Slaves on Dope" to venues in the Northeastern United States. (Benton Dep. I, 42:9-20). Then, in May of 2001, Opposer, under its Drowning Pool mark, toured with the band "Finger Eleven" to venues in the Northeastern United States and along the East Coast. (Benton Dep. I, 44:11 to 45:2).

On June 5, 2001, Opposer's "Sinner" album was released under the Drowning Pool mark, which sold over 500,000 copies, *i.e.*, "went gold," within six weeks and sold more than one million copies, *i.e.*, "went platinum," within eleven weeks, making it the fastest debut album to go platinum in rock music history. (Benton Dep. I, 47:15 to 49:15).

Following its tour with "Finger Eleven," Opposer participated in the national "Ozzfest" music tour, an annual tour headlined by singer Ozzy Ozbourne, and consisting of about twenty bands, where Opposer performed in over thirty cities across the United States. (Benton Dep. I, 45:3 to 46:25). After concluding the "Ozzfest" tour, Opposer recorded two more music videos and continued touring the United States for the remainder of 2001, first reuniting with the band "Sevendust," then touring with the band "Disturbed." (Benton Dep. I, 49:18 to 52:23).

In 2002, Opposer began touring internationally, performing at venues in Australia, Japan, and Europe. (Benton Dep. I, 53:4 to 54:16). Opposer returned to the United States in March 2002 to participate in the "Jagermeister" national music tour. (Benton Dep. I, 54:17 to 55:9). In about July 2002, Opposer joined the "Ozzfest" tour for the second year in a row. (Benton Dep. I, 55:15-25).

On August 14, 2002, before the "Ozzfest" tour was completed, Dave Williams, Opposer's lead singer, died as a result of a previously undiagnosed heart condition. (Benton Dep. I, 56:1-20). In the fall of 2002, Opposer, under its Drowning Pool mark, recorded and released a track for the soundtrack of the movie "Daredevil" with a guest vocalist named Rob Zombie. (Benton Dep. I, 58:2 to 59:1). From January to April 2003, Opposer engaged in a search for a new lead singer, and ultimately selected a vocalist named Jason Jones. (Benton Dep. I, 59:2 to 60:4).

Jones joined Opposer in August of 2003 and worked with the other band members throughout the fall of 2003 on a new album. (Benton Dep. I, 60:5-22). Opposer recorded the drum tracks for the new album, entitled "Desenstized," in December 2003, and the remainder of the album from January to March 2004. (Benton Dep. I, 61:3-13 and 67:15-20). Opposer's "Desensitzed" album was released on April 20, 2004. (Benton Dep. I, 67:21-24).

Also in April 2004, Opposer participated in the national "Headbanger's Ball" tour, sponsored by MTV, and performed at thirty to forty venues across the United States. (Benton Dep. I, 68:5-18). Opposer then toured Europe again with another band named "Damaged Planet." (Benton Dep. I, 68:19 to 69:3). Opposer finished 2004 by headlining its own tour of the United States, and concluded with a show in Mexico City on January 15, 2005. (Benton Dep. I, 69:4-13). Opposer is currently planning a new album for release in late 2005 or early 2006. (Benton Dep. I, 69:14-24).

From 1995 until 2002, Drowning Pool operated as a Texas general partnership (Opp. Ex. 10 to Childress Dep. at Tab 2). On August 19, 2002, after the death of Dave Williams, at the direction of Opposer's manager and accountants, Opposer 's attorneys created new entities, with Stevie Benton, Mike Lucie and C.J. Pierce as their members, including Drowning Pool, LLC which is the Opposer in this opposition. (Opp. Not. Rel. II).

E. APPLICANT'S ATTEMPT TO CASH IN.

After being nonexistent for more than ten years, Applicant became aware of Opposer's use of the Drowning Pool mark in mid-to-late 2000. (Elesh Dep. II, 47:7 to 48:7; Opp. Not. Rel. I, Opp. Resp., Ex. H (Applicant's Response to Opposer's Interrogatory No. 1 at p. 3). On June 5, 2001, Opposer, under the Drowning Pool mark, released its album "Sinner" that went platinum within eleven weeks. (Benton Dep. I, 47:15 to 49:15). At substantially the same time, Applicant received an email from Andrew Crane, its former lead singer, stating that a friend had seen a band called "Drowning Pool" on MTV. (Elesh Dep. II, 48:8-15.)

Apparently perceiving the possibility of a big future payday, Applicant sent an email to Wind-up Records, Opposer's record label, asking for information about Opposer. (Elesh Dep. II, 48:18 to 49:18; App. Ex. 130 to Elesh Dep. II). To further bolster its charlatan's claim of

ownership of the Drowning Pool mark, on July 20, 2001, Applicant filed the trademark application at issue for a "series of audio records, audio cd's, audio tapes, and cassettes, video cassettes, and DVD's featuring music and musical performances." (Trademark Application Ser. No. 76/287,792). Opposer filed its Notice of Opposition on December 12, 2002.

III. STATEMENT OF THE ISSUES

The issues presented before the Board are:

1. Did Applicant discontinue use of the Drowning Pool mark in 1990 with an intent not to resume use?
2. Has Applicant ceased use of the Drowning Pool mark for various three year periods from 1991 to 2003 and failed to present sufficient evidence to rebut the prima facie evidence of abandonment?
3. Does any residual use of the Drowning Pool mark by Applicant or third parties from 1990 until 2003 fall short of the requisite use of the mark by Applicant in the ordinary course of trade, and, therefore, is any such use insufficient to avoid a finding of abandonment?
4. Has Opposer adopted and made sufficient and continuous use of the Drowning Pool mark since 1995 to acquire ownership of it?

IV. ARGUMENT AND CITATION OF AUTHORITY: APPLICANT CANNOT OVERCOME OPPOSER'S *PRIMA FACIE* EVIDENCE OF ABANDONMENT

A. STANDARD.

Abandonment is a question of fact. *On-line Careline, Inc. v. America Online, Inc.*, 229 F.3d 1080, 1087, 56 U.S.P.Q.2d 1471, 1476 (Fed. Cir. 2000). Under Section 1127 of the Lanham Act:

> A mark shall be deemed to be "abandoned" if . . . its use has been discontinued with intent not to resume such use. Intent not to resume may be inferred from circumstances. Nonuse for 3 consecutive years shall be prima facie evidence of abandonment. "Use" of a mark means the bona fide use of such mark made in the ordinary course of trade, and not made merely to reserve a right in a mark.

15 U.S.C. § 1127.

The Lanham Act thus provides two approaches by which a party may prove abandonment. One approach is to establish a prima facie case of abandonment by showing proof of nonuse for three consecutive years. *On-line Careline*, 229 F.3d at 1087, 56 U.S.P.Q.2d at 1476. "Establishing a prima facie case 'eliminates the challenger's burden to establish the intent element of abandonment as an initial part of his case,' creating a rebuttable presumption that the trademark owner has abandoned the mark without intent to resume use . . . . The burden then shifts to the trademark owner to produce evidence that he either used the mark during the statutory period or intended to resume use." *Id.*[24] (citation omitted).

The other option is to prove affirmative abandonment, *i.e.*, carry the burden of persuasion that use has been discontinued with intent not to resume such use, without relying on nonuse for three consecutive years as a basis for the abandonment claim. *Bureau Nat'l Interprofessionnel Du Cognac v. International Better Drinks Corp.*, 6 U.S.P.Q.2d 1610, 1617 (T.T.A.B. Mar. 16, 1988); *Fruit of the Loom, Inc. v. Fruit of the Earth, Inc.*, 3 U.S.P.Q.2d 1531, 1534 (T.T.A.B. June 30, 1987); *IntraWest Fin. Corp. v. Western Nat'l Bank*, 610 F. Supp. 950, 958, 227 U.S.P.Q. 27, 33 (D. Colo. 1985).

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[24] *See also Rivard v. Linville*, 133 F.3d 1446, 1449, 45 U.S.P.Q.2d 1374, 1376 (Fed. Cir. 1998); *Imperial Tobacco Ltd. v. Philip Morris Inc.*, 899 F.2d 1575, 1579, 14 U.S.P.Q.2d 1390, 1393 (Fed. Cir. 1990); *Cerveceria Centroamericana, S.A. v. Cerveceria India, Inc.*, 892 F.2d 1021, 1026, 13 U.S.P.Q.2d 1307, 1312 (Fed. Cir. 1989); *Stromgren Supports, Inc. v. Bike Athletic Co.*, 43 U.S.P.Q.2d 1100, 1111 (T.T.A.B. Mar. 6, 1997).

The burden of persuasion remains with the party claiming abandonment to prove abandonment by a preponderance of the evidence. *On-line Careline*, 229 F.3d at 1087, 56 U.S.P.Q.2d at 1476.

B. EVIDENCE OF ABANDONMENT.

Because the evidence of Applicant's cessation of use of the Drowning Pool mark and its intent not to resume use, in both character and amount, is so preponderant, Opposer will first show Applicant's abandonment on that basis. Thereafter, Opposer will show that for various periods of three years during the time period 1991-2003, Applicant did not make sufficient use of the Drowning Pool mark to maintain ownership rights therein and that Applicant is unable to rebut such evidence of abandonment.

1. Affirmative Abandonment.

The evidence presently of record clearly demonstrates that Applicant, by its own affirmative actions, abandoned the Drowning Pool mark in 1990 when it changed the name of its band to Mumbles. Effecting a change of name without any reference to continued use of the former name can constitute abandonment even where the period of nonuse is only a few months. *IntraWest Fin. Corp.*, 610 F. Supp. at 958, 227 U.S.P.Q. at 33.

After losing its lead vocalist and releasing its "Aphonia" album (meaning "loss of voice"), Applicant changed its name to "Mumbles" in 1990. Although Applicant, by referring to Mumbles as "another revenue stream" (Smith Dep., 25:22-23), seems to suggest that Mumbles and Drowning Pool existed simultaneously, the evidence of record is clearly to the contrary.

First, the same three individuals that made up Drowning Pool on the "Aphonia" album became Mumbles and subsequently found a lead vocalist. (Elesh Dep. I, 9:21 to 10:7 and 65:20 to 66:7.) Second, the Mumbles "Two Clouds" album conspicuously displays the abbreviation

"R.I.P.D.P.," which Applicant admits means "Rest in Peace Drowning Pool." (App. Ex. 128 to Elesh Dep. II at p. 13; Elesh Dep. II, 29:9-22; Smith Dep., 27:19-23). By including such a statement on its "Two Clouds" album, Applicant unambiguously announced the "death" of the Drowning Pool band and its abandonment of the Drowning Pool mark.

Third, virtually every publication of record that features a story or review about the band Mumbles describes the band as **formerly** being known as Drowning Pool. *See* Opp. Exs. 47 and 48 to Elesh Dep. I; Opp. Not. Rel. I, Opp. Resp., Ex. P, Decl. Ex. 5, Doc. AP1630 (*In Pittsburgh* newspaper excerpt); *and* Opp. Not. Rel. I, Opp. Resp., Ex. P, Decl. Ex. 5, Doc. AP1634 (*Melody Maker* magazine excerpt). Notably, in what was likely the most significant public exposure in Applicant's history, a story in the April 5, 1991 edition of the *L.A. Times*, Applicant is credited with telling the *Times* that Mumbles started out under the **former name** of Drowning Pool. *See* Opp. Ex. 48 to Elesh Dep. I (stating "Exploration was the founding principle when the band started out under its **former name** of Drowning Pool, **according to bassist Brett Smith**....") (emphasis supplied). Even more notably, Applicant admits that the *L.A. Times* article correctly states that "**Drowning Pool . . . lasted from 1984 to 1989**" and that "[w]hen Drowning Pool's singer left in 1988, Smith, Elesh, and Thomas made an all-instrumental album **as a farewell to the old name**, then decided to hang together **with a new name** and a new approach." (Elesh Dep. I, 84:19 to 85:17) (emphasis added).[25]

Fourth, and most significantly, Applicant directly communicated to the public that Drowning Pool had changed its name by personally preparing flyers that promoted Mumbles as "**formerly** Drowning Pool," "**formerly known as** Drowning Pool," and "**what once was**

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[25] As shown previously, Mr. Elesh admitted in his deposition testimony that such statements are correct and accurate (*supra* at pp. 6-7).

Drowning Pool" (emphasis added). (Elesh Dep. I, 65:20 to 66:2 and 73:1 to 78:8; Opp. Exs. 40 and 42-46 to Elesh Dep. I). Such affirmative statements alone further announce the abandonment of the Drowning Pool mark and an intent not to resume use. *See IntraWest*, 610 F. Supp. at 958, 227 U.S.P.Q. at 33 (finding abandonment where the plaintiff advertised its name change in local and national papers, stating "The First National Bank of Denver is now IntraWest Bank of Denver," "First of Denver is now IntraWest Bank of Denver," and "IntraWest Bank of Denver, formerly First of Denver"); *Hiland Potato Chip Co.*, 720 F.2d 981, 983-84, 222 U.S.P.Q. 790, 792-93 (8th Cir. 1983) (concluding that appellant abandoned its mark by discontinuing use for four months and mailing a communication to customers stating that the mark "will be eliminated" because appellant was introducing a new brand).

Fifth, Applicant's "[own] record company," IPR (Elesh Dep. II, 46:15-17), informed the relevant consuming public that Applicant had abandoned the mark Drowning Pool and adopted a new mark. *See* Licher Dep., 68:12 to 69:5; *and* App. Ex. 153 to Licher Dep. at Doc. AP0131:

- "MUMBLES – Two Clouds CD: Formerly known as DROWNING POOL
- DROWNING POOL – Aphonia LP: Last LP before changing their name to MUMBLES . . . .".

IPR also made the public aware of the abandonment of the Drowning Pool's mark by designating Applicant's Drowning Pool albums as "out-of-print" or "the last copies available." *See* Licher Dep., 65:4-18, 67:15 to 68:10, and 70:5 to 71:11; App. Ex. 152 to Licher Dep. at Doc. AP0127:

- "DROWNING POOL – Green LP: We've just acquired a small batch of this out-of-print first lp . . . .";

App. Ex. 153 to Licher Dep. at Doc. AP0131:

- "DROWNING POOL – First LP with Green Cover . . . we have the last copies available; . . .";

and App. Ex. 156 to Licher Dep. at Doc. AP0135:

- "DROWNING POOL – Self-titled LP . . . Most of these tracks appeared on the out-of-print Satori double LP . . . ."

As shown previously, Mr. Licher has admitted in his deposition testimony that such statements are correct and accurate (*supra* at p. 8-9). Even more importantly, in the face of the foregoing public pronouncements, Applicant made no attempt to inform its fans, IPR, or specific members of the media, those individuals and the entities most familiar with Applicant, that any perception that Applicant had abandoned the Drowning Pool mark was incorrect.

Sixth, the employment history and personal income tax returns of Applicant's members suggest that, rather than continuing to provide goods or services under the Drowning Pool mark, they left the music business soon after forming the band identified by the mark Mumbles. Specifically, in connection with all of their tax returns, neither Mr. Elesh nor Mr. Smith ever listed their occupation as being related to the music industry, ever included a Schedule C Profit or Loss from a music business, or ever received a Form K-1 or a Form 1099 from Applicant partnership Drowning Pool. (Opp. Exs. 19-28 to Elesh Dep. I; Elesh Dep. I, 12:6 to 53:25; Opp. Exs. 88-96 to Smith Dep.; Smith Dep., 101:2 to 121:6).

Seventh, from about 1990, around the time of Drowning Pool's demise, until 2000, Mr. Elesh failed to maintain a current address with BMI. (Opp. Ex. 52 to Elesh Dep. II, Elesh Dep. II, 79:7 to 87:2). Surely, after starting Mumbles, if Applicant genuinely intended to "keep the [Drowning Pool] mark alive" by "licens[ing] music through BMI" (Elesh Dep. II, 31:10-15), both members would have ensured that BMI could pass royalties along to them.

Eighth, as of April 7, 2005, the last time either Adam Elesh or Brett Smith provided IPR with any Drowning Pool vinyl records was "sometime in the early 1990's." (Licher Dep., 98:10-16). Ninth, Applicant's master tapes have not been used to make a Drowning Pool vinyl album since at least 1992, if not earlier, and have not been used to make any Drowning Pool compact discs besides the "Aphonia" CD, released in 1989 or 1990 (Elesh Dep. II, 102:13-19), and the "Green" CD, released thirteen years later in 2003 (Elesh Dep. II, 42:8 to 43:1). (Smith Dep., 78:7 to 80:3).

Tenth, Applicant maintained detailed hand-generated financial records (Opp. Exs. 29-38 to Smith Dep.), received monthly bank statements (Opp. Exs. 53, 55-87, 97-99, and 200 to Smith Dep.), retained numerous invoices (App. Exs. 143 and 173 to Smith Dep.), kept track logs (App. Ex. 169 to Smith Dep.), obtained several radio station playlists (App. Ex. 170 to Smith Dep.), and received many items of mail (App. Exs. 171 and 172 to Smith Dep.) between 1984 and 1990, but none thereafter. Clearly, Applicant's activities under the Drowning Pool mark ceased in 1990.

Finally, Applicant has erected its own headstone by entitling the scrap book it personally made "Drowning Pool **1984-1990**." (Opp. Ex. 39 to Elesh Dep. I) (emphasis added).

That such course of conduct constitutes an affirmative abandonment of a mark is the clear holding of the U.S. District Court for the District of Colorado in *IntraWest Financial Corporation v. Western National Bank of Denver*, 610 F. Supp 950, 227 U.S.P.Q. 27 (D. Colo. 1985). In *IntraWest*, the First National Bank of Denver and First National Bancorporation changed their names to IntraWest Bank of Denver, N.A. and IntraWest Financial Corporation, respectively, on October 1, 1982. They spent about $2 million in October 1982, to advertise the change of names; however, nowhere in this publicity campaign was there any reference to the

continued use of the name "The First National Bank of Denver" or "First of Denver." In fact, many of the advertisements included statements such as: "(i) The First National Bank of Denver is now IntraWest Bank of Denver," (ii) "First of Denver is now IntraWest Bank of Denver," and (iii) "IntraWest Bank of Denver, formerly First of Denver." Finally, the Bank published a book entitled "The Pioneer Western Bank: First of Denver 1860-1980," which was a detailed history of the First National Bank of Denver. Based on such factual findings, the district court concluded that neither IntraWest Bank nor IntraWest Financial Corporation had any intent at the time of the name change to subsequently use the name "The First National Bank of Denver." *Id.* at 951-58, 227 U.S.P.Q. at 28-33.

The same result should obtain here. Applicant publicly announced the death of Drowning Pool on the release of the Mumbles Two Clouds album. Further, all flyers prepared by Applicant promoting Mumbles clearly stated that Mumbles was formerly Drowning Pool. Notably, Applicant itself informed the *L.A Times* and the *L.A. Times* published to the public that Drowning Pool lasted from 1984 to 1989. Similarly, Applicant's "own" record company, in distributing prices lists for Applicant's Drowning Pool records released in the 1984-89 timeframe informed the public that such records were "out of print" and "the last copies available." Finally, Applicant itself constructed a scrapbook commemorating itself as Drowning Pool and stated in the title of the scrap book the lifespan of Applicant under the Drowning Pool mark as "1984-1990." Just as the district court in *IntraWest* concluded that the Bank had no intent to resume use of the name "The First National Bank of Denver," the Board should conclude that Applicant had no intent to resume use of the Drowning Pool mark.

To the same effect is the Eighth Circuit's decision in *Hiland Potato Chip Co. v. Culbro Snack Foods, Inc.*, 720 F.2d 981, 222 U.S.P.Q. 790 (8th Cir. 1983). In *Hiland*, as a result of a

merger, the merged manufacturer of potato chips mailed a communication to its customers which stated in part that certain brands would be eliminated from the Missouri and Arkansas markets and replaced with a new brand. Immediately after the distribution of such communication, a competitor entered the Kansas City, Missouri trade area under one of the abandoned brands and soon thereafter received a cease and desist demand from the merged entity. Several months thereafter, the merged entity renewed distribution of potato chips in the Kansas City trade area under its previously abandoned brand. The trial court concluded that the public announcement of the intention to discontinue the sale of the branded product was a circumstance from which an intent not to resume use could be inferred, and found that the merged entity had, indeed, abandoned use of the disputed mark. On appeal, the Eighth Circuit affirmed. *Id.* at 982-84, 222 U.S.P.Q. at 791-93.

Applying such authorities to the facts set forth above, it is clear that Opposer has demonstrated by a preponderance of the evidence of record that Applicant affirmatively abandoned the Drowning Pool mark. Therefore, on this ground alone, in view of Opposer's previously described use and corresponding ownership of the Drowning Pool mark, the present Opposition must be sustained.

Moreover, any reliance by Applicant on *Marshak v. Treadwell*, 240 F.3d 184, 57 U.S.P.Q.2d 1764 (3d Cir. 2001) and *Kingsmen v. K-Tel Int'l Ltd.*, 557 F. Supp. 178, 220 U.S.P.Q. 1045 (S.D.N.Y. 1983) is misplaced because such decisions, read in view of *IntraWest* and *Hiland*, are clearly distinguishable.[26] *Kingsman* was a dispute between members of the band "The Kingsmen" from 1964-67 and a group of defendants who contracted with Jack Ely, a lead

[26] Applicant expressly relied on *Marshak* and *Kingsmen* in its Motion for Summary Judgment.

vocalist of The Kingsmen from 1962-64, and Lynn Eaton (one of the plaintiffs) to record two of The Kingsmen's biggest hits for release on a compilation album, "60's Dance Party," on which the mark "Kingsmen" was prominently displayed. *Kingsmen*, 557 F. Supp. at 179-80, 220 U.S.P.Q. at 1046. Plaintiffs' sought an injunction against the distribution of the "60's Dance Party" album, defendants contended that plaintiffs had abandoned any rights in the "Kingsmen" mark, and the court considered the evidence and found:

> Even though plaintiffs disbanded their group in 1967 and ceased recording new material, **there is no evidence suggesting that they failed to use the name Kingsmen during the period from 1967 to the present to promote their previously recorded albums. Moreover**, the fact that these individuals continue to receive royalties for Kingsmen recordings flies in the face of any suggestion of intent to abandon use of the name Kingsmen.

Id. at 183, 220 U.S.P.Q. at 1049 (emphasis added). Based on such findings, the Court rejected defendants' contentions that the name Kingsmen has been abandoned. *Id.*

In the instant proceeding, however, Applicant has done nothing to "promote their previously recorded albums." Instead, Applicant has done exactly the opposite. First, after adopting a new name, "Mumbles," Applicant publicly announced the death of Drowning Pool (R.I.P.D.P.). Second, it publicly announced that the members of the band Mumbles were former members of the band Drowning Pool, a clear implication that the band Drowning Pool had ceased to exist. Third, Applicants stated to the *L.A. Times*, and the *L.A. Times* informed the public, that the band existed from 1984-1989. Fourth, Applicant's "own" record company informed the public, without objection from Applicant, that Applicant's record albums were out-of-print and that its small inventory were the last copies available. Such a course of conduct was the antithesis of using the Drowning Pool mark to promote their previously recorded albums as a result of which the *Kingsmen* decision is distinguishable.

Marshak is similarly distinguishable. *Marshak* was a dispute between Fay Treadwell, the successor manager of the "Drifters" and widow of the group's initial manager, and Larry Marshak, who reunited former members of the group for revival concerts and continued to manage the revived group thereafter. *Marshak*, 240 F.3d at 187-90, 57 U.S.P.Q.2d at 1765-67. The Drifters first appeared in 1953 and were managed by George Treadwell from 1954 until his death in 1967, and thereafter by Fay Treadwell. Members of the group changed continually and all signed contracts precluding their use of the Drifters mark if they left the group. In the late 1960's, Treadwell's group focused its activities in Europe and made few appearances in the United States after 1970. However, the group's classic recordings continued to be played on the radio and Treadwell continued to receive royalties. Furthermore, many of the classic songs were recorded on CDs and re-released. In 1971, Treadwell filed suit against Marshak, but the suit was dismissed due to her failure to respond to discovery. *Id.* at 188-89, 199, 57 U.S.P.Q.2d at 1766, 1775.

Marshak's groups continued to perform and, in 1976, he applied to register the Drifters mark. In 1995, Marshak filed suit against Treadwell based on Treadwell's publication of the book *Save the Last Dance for Me* in which she claimed ownership of the Drifters mark. In the jury trial that ensued, the jury found Marshak obtained his federal registration by fraud on the United States Patent and Trademark Office but that Treadwell had abandoned the mark. The district court vacated the jury verdict of abandonment, permanently enjoined Marshak from further use of the Drifters mark, and Marshak appealed. *Id.* at 189-90, 57 U.S.P.Q.2d at 1766-67.

The Third Circuit found that the Treadwell Drifters' songs continued to be played, that Treadwell continued to receive royalties, that the Treadwell Drifters' albums continued to be

sold, **and** the Treadwell Drifters' songs had been recorded on CDs and re-released. Based on such findings, the Third Circuit concluded that Marshak failed to prove an intent to abandon, and affirmed the district court's holding:

> "[a] successful musical group does not abandon its mark unless there is proof that the owner ceased to commercially exhibit the mark's secondary meaning in the music industry."

Id. at 198-99, 57 U.S.P.Q.2d at 1775-76 (citation omitted).

However, that is exactly what happened here: Applicant not only ceased to commercially exploit the Drowning Pool mark's secondary meaning in the industry, it publicly announced the abandonment of the mark. After 1991, Applicant did not perform again as Drowning Pool until 2003 (except for the highly suspect performance at Nana's), did not tour, did not record (except for two also highly suspect sessions in Mr. Smith's home), did not produce new copies of their 1980's recordings, and did not record any of the old recordings for re-release until 2003, after learning of Opposer's significant success. Even more importantly, as shown in detail above, Applicant affirmatively announced its abandonment of the Drowning Pool mark in statements to the press, in promotional material produced by Applicant for Mumbles and allowing "its" record company to advertise its 1980 albums as out-of-print and otherwise not available. Simply stated, Applicant's conduct is more similar to that of IntraWest Bank and Hiland Potato Chips Company. Thus, it is plain that Applicant has abandoned the Drowning Pool mark and the opposition should be sustained.

2. Evidence of Non-Use.

In addition to proving Applicant's affirmative abandonment of the Drowning Pool mark, Opposer has also shown that Applicant has not made bona fide use of the Drowning Pool mark during multiple three year periods during the time period from 1991 to 2003, and therefore, has

abandoned the same. Before addressing the specific evidence of nonuse, one must first examine the character of applicant's alleged use to determine whether such alleged use comports with the requirements of section 45 of the Act, 15 U.S.C. § 1127.

The entirety of Applicant's "use" from 1991 until December 2003 consists of Applicant's receipt of royalties in the total amount of $240.17 ($53.49 of which was withheld until 2000 due to Mr. Elesh's failure to maintain a current address with BMI); IPR sales of eighteen (18) of Applicant's albums (which were manufactured prior to the early 1990s and acquired by IPR or other third parties prior to the early 1990s); the listing of such albums in one company's (IPR's) price lists and on two local radio station playlists; granting a license to IPR to sub-license Applicant's recordings for "digital music delivery" (under which no sub-licensing ever occurred); and Applicant's one suspect public performance, two equally suspect recording sessions, and one licensing arrangement (for which no objective evidence exists). However, any such "use" is unavailing to Applicant.

First, IPR's sales and its listing of Applicant's albums in its price lists do not inure to Applicant's benefit. *See Societe des Produits Marnier Lapostolle v. Distillerie Moccia S.R.L.*, 10 U.S.P.Q.2d 1241, 1244 n.5 (T.T.A.B. Feb. 10, 1989). *Societe* was an opposition and cancellation proceeding in which petitioner sought cancellation of a registration for the mark Royal Monier and design for cordials on the grounds of abandonment. Specifically, petitioner contended that the last shipment of goods into the United States under the Royal Monier marks was on December 21, 1984, and the resulting non-use for two years was *prima facie* evidence of abandonment. The registrant conceded the fact that the last shipment of Royal Monier brand products into the United States occurred on December 21, 1984, but contended that because the shipment, which consisted of 2,400 bottles of cordials, was to a distributor, the shipment per se is

not the only act of use in commerce. Rather, the registrant contended that because the distributor would further distribute the product to other distributors or retailers who would then sell the product to the public, the marks would be "in use in commerce" within the United States during the two-year period in question and that such use inures to the benefit of registrant. *Id.* at 1241-44 and n.5. The Board rejected such argument, holding:

> Applicant/respondent argues that its mark is still in use in commerce as long as a bottle of "ROYAL MONIER" liqueur sits on a shelf in a retail store. The sum and substance of this argument appears to be that because of some "residual goodwill" generated by the mark "ROYAL MONIER" as a result of sales made since the December 21, 1984 shipment by retailers, the Board cannot find that applicant/respondent has abandoned its mark for liqueurs. Applicant/respondent has failed to support its position with any authority, however, and, in our view, **a party cannot defend against a claim of abandonment by relying on some "residual goodwill" generated through subsequent sales of the product by distributors or retailers.**

Id. at 1244 n.5 (emphasis added).

Rather, to avoid abandonment, a manufacturer must be an active participant in the aftermarket for its goods, and continue to advertise, promote, and exploit the goodwill in its mark identifying such goods to the exclusion of others. Critically, in this Opposition, there is no evidence of record that from 1991-2003 Applicant has engaged in any activities to advertise, promote or exploit the goodwill of the Drowning Pool mark. *See Yamaha Corp. v. Wrightwood Enters., Inc.*, 2002 T.T.A.B. LEXIS 721, at *25 (T.T.A.B. Nov. 22, 2002) ("The sales [of EVERETT pianos by dealers] do not inure to opposer's benefit, such that these sales show use of the mark by opposer in the ordinary course of trade").[27] Thus, just as registrant's distributor's sales were of no benefit to it in *Societe*, IRP's sales and listings of Applicant's albums in its price list do not inure to Applicant's benefit here and are insufficient to avoid abandonment.

[27] This decision may not be cited as precedent of the Trademark Trial & Appeal Board.

Third, the license agreement with IPR for "digital music delivery" (App. Ex. 142 to Elesh Dep. II) is not evidence of use of the Drowning Pool mark. Under the terms of the license agreement, the agreement "will allow IPR to sub-license [Applicant's recordings] to an Internet Distribution Company called Emusic (or any other such Internet Distribution Company which IPR deems suitable for such licensing) for the sole purpose of selling [Applicant's recordings] for electronic download to consumers over the Internet." (App. Ex. 142 to Elesh Dep. II). However, IPR has never actually entered into any contracts with any "Internet Distribution Company," and none of Applicant's music has been licensed to any such company, for the digital delivery of music. (Licher Depo., 97:17 to 98:8). *See Silverman v. CBS, Inc.*, 870 F.2d 40, 48, 9 U.S.P.Q.2d 1778, 1784 (2d Cir. 1989) ("[S]poratic licensing for essentially non-commercial uses of a mark is not sufficient use to forestall abandonment.").

Fourth, the two radio station playlists introduced by Applicant cannot be relied upon as evidence of Applicant's use of the Drowning Pool mark. Specifically, the playlists consist of information obtained and printed from the Internet. (App. Ex. 136 to Smith Dep.; Smith Dep., 17:22-24). As such, even though the playlists may be made of record, they have only limited probative value and cannot be used to prove the truth of the matter asserted unless a competent witness has testified to the truth of such matters. TRADEMARK TRIAL AND APPEAL BOARD MANUAL OF PROCEDURE § 704.08, at 70 (2d ed. 2003, 1st rev. 2004) (hereinafter "TBMP").

Because (i) the radio station playlists have been introduced to prove that the particular radio stations included Drowning Pool music on their music rotations (Smith Dep., 18:2-7), and (ii) Mr. Smith failed to testify that he had personal knowledge of whether the particular radio stations actually included Drowning Pool music on their music rotations (Smith Dep., 17:17 to

19:14), the playlists include inadmissible hearsay[28] and are not evidence of use of the Drowning Pool mark or that the public was exposed to the Drowning Pool mark. *See Sports Auth. Mich., Inc. v. PC Auth., Inc.*, 63 U.S.P.Q.2d 1782, 1798 (T.T.A.B. Apr. 23, 2002) (treating Internet web sites the same way as third-party registrations, namely, as having limited probative value and not as evidence of trademark use); *Raccioppi v. Apogee, Inc.*, 47 U.S.P.Q.2d 1368, 1371 (T.T.A.B. May 28, 1998) ("[T]he general trend appears to be to admit information obtained from the Internet into evidence, without requiring further authentication, but at the same time to carefully evaluate the probative weight to be given to this evidence.").

Fifth, the alleged Drowning Pool recording sessions in 1996 are not probative.[29] The "Sparrow" session consisted only of Adam Elesh and Brett Smith. (Elesh Dep. I, 99:11-15). These are the two individuals who announced in 1990 that Drowning Pool had died, who said that they were formerly members of Drowning Pool, who said that they were members of what was formerly known as Drowning Pool, who said that Drowning Pool had changed its name to Mumbles and who said that Drowning Pool existed from 1984 to 1989. How do we know that Elesh and Smith had not made a decision to become a duo and the Sparrow session was their first effort? How do we know that Elesh and Smith were not just sitting around "jamming" and

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[28] Opposer's objections to the playlists, App. Ex. 136 to Smith Dep., on the ground of hearsay were raised during Mr. Smith's deposition (Smith Dep. 19:4-6 and 50:4-11) and are renewed in Opposer's Statement of Objections submitted herewith, and, to the extent the playlists are relied upon through Applicant's Notice of Reliance, Opposer raises its hearsay objections to such reliance at this time. TBMP §§ 707.02(c) and 707.03(c).

[29] *See supra* p.18 n.16-17. The "Sparrow" session (the session at which the song Sparrow was recorded) was placed in 1992, 1993 and 1996 by Applicant in its interrogatory responses and Mr. Elesh's and Mr. Smith's testimony, respectively. The "July" session (the session at which the song July was recorded) was placed in 1996 or 1997 by Mr. Elesh in his deposition testimony and included individuals who were not previously identified in Applicant's discovery responses as members of Drowning Pool.

decided to record the result? (The recording session was in Smith's home.) (Elesh Dep. I, 99:19-21). Given the fact that Applicant had made no use whatsoever of the Drowning Pool mark since 1990 (except for the alleged public performance in 1994 which is equally suspect), it is simply not credible to conclude that suddenly in 1996, Adam Elesh and Brett Smith reconstituted Drowning Pool and "laid down some tracks." Furthermore, how do we know that the Sparrow and July recording sessions were not recording sessions for a new Mumbles release, especially given that Applicant admits recording "Mumbles materials" that have not been released? (Smith Dep., 75:2-8).

Interestingly, other than Mr. Elesh's comment during Opposer's deposition of him, Applicant has not elected to make the result of the alleged "July" recording session of record. Further, the result of the "Sparrow" recording session was not released until 2003. (Elesh Dep. I, 99:5-10). More importantly, there is no public announcement of either session. If Applicant wished for the public to know it was still providing services under the Drowning Pool mark, it only had to issue a press release publicizing the recording sessions. It did not do so. Thus, there is no objective evidence that either of the recording sessions were sessions conducted under the Drowning Pool mark rather than under the Mumbles mark, or that the recording sessions were to be the advent of a duo or a new group under a new mark.

Sixth, a similar result obtains from an analysis of the alleged 1994 Drowning Pool public performance at "Nana's Clothing Gallery." Again, the performance consisted only of Adam Elesh and Brett Smith. (Elesh Dep. I, 94:11-12; Elesh Dep. II, 41:9-14). Again, there is no documentary evidence of record to establish that the performance was by Drowning Pool rather than Mumbles or that of an unnamed duo. Again, there is no evidence that the performance was advertised at all much less advertised or promoted as a Drowning Pool performance. Again,

there is no credible explanation of why a three person band that was publicly announced to have died in 1990 suddenly appears out of the blue as a duo for a single performance for one day in 1994 and has not publicly appeared again until after Opposer's significant public success.

Consequently, ignoring the IPR sales and listings of Applicant's albums, the license agreement with IPR, the radio station playlists, and the suspect performance and suspect recording sessions from the evidence of residual use of the Drowning Pool mark produces the following chart of admissible and credible evidence of use of the Drowning Pool mark to support Applicant's argument of non-abandonment:

Year	U.S. Royalties	Record Sales	Other
1991	$ 3.44	0	
1992	$ 81.80	0	
1993	$ 119.85	0	
1994	$ 33.18	0	
1995	$ 0	0	
1996	$ 1.90	0	Fortuitous Licensing of One Drowning Pool Song for Commercial.
1997	$ 0	0	
1998	$ 0	0	
1999	$ 0	0	
2000	$ 0	0	
2001	$ 0	0	
2002	$ 0	0	
2003	$ 0	0	Performance at the Don O'Melveny Gallery and Release of the "Green" CD.
Total:	**$ 240.17**	**0**	

As demonstrated below, such use is clearly insufficient to rebut the conclusion that Applicant abandoned the Drowning Pool mark.

a. Non-Use for Three Consecutive Years.

If one were to focus on the almost seven (7) year period of 1997 to December 2003, there is simply no admissible, credible or probative evidence of record to show any use by Applicant of the Drowning Pool mark. There is no evidence of royalties received, there is no evidence of

any records or albums sold by Applicant, there is no evidence of any public performances, there is no evidence of any recording sessions, and there is no evidence of any efforts by Applicant to advertise, promote or exploit the goodwill of the Drowning Pool mark. Consequently, there can be no conclusion other than Applicant has abandoned the mark. *See Stetson v. Howard D. Wolf & Assocs.*, 955 F.2d 847, 851, 21 U.S.P.Q.2d 1783, 1786 (2d Cir. 1992) ("[I]f [a] singing group held the trademark to its name and ceased touring, making and releasing records, and receiving royalties, it would be deemed to have ceased use of its trade[mark] because the public would no longer identify the group name with its members."); *Mele v. Davison & Assocs., Inc.*, 2004 WL 2285111, at *9 (W.D.N.Y. Oct. 7, 2004) ("[p]laintiff's did exactly what results in an abandonment of a mark in the music industry – to wit, neither [of plaintiff's bands] toured, made or released records, nor received royalties [for an eight (8) year period]; [plaintiff] did not place its name or the name of its bands in any forum available to the public, resulting in no public exposure or visibility of the band or of [plaintiff]").

With the exception of $205.09 in royalties, the same conclusion obtains to the three (3) year period 1991-1993. Clearly, the receipt of $205.09 in royalties over a three (3) year period is de minimis. *Exxon Corp. v. Humble Exploration Co.*, 695 F.2d 96, 100, 217 U.S.P.Q. 1200, 1203 (5th Cir. 1983) ("The limited sales of packaged products to targeted customers and the arranged sales of bulk products through the three shell corporations were not sufficient uses to avoid prima facie proof of abandonment under the statute."); *La Societe Anonyme des Parfums Le Galion v. Jean Patou, Inc.*, 495 F.2d 1265, 1271-72, 181 U.S.P.Q. 545, 548 (2d Cir. 1974) (concluding that proof of a bona fide usage requires a showing that "use of the mark has been deliberate and continuous, not sporadic, casual or transitory," and holding that 89 sales in 20 years, which produced a gross profit of $100, did not constitute good faith commercial

exploitation and could not be used to establish rights in the mark at issue); *Anvil Brand, Inc. v. Consol. Foods Corp.*, 464 F. Supp. 474, 481, 204 U.S.P.Q. 209, 216 (S.D.N.Y. 1978) (stating that plaintiff's use of the mark only on promotional goods was "merely to exhaust existing inventory and not a trademark use" and considering sales of less than 100,000 shirts in five years, when compared to 80,000 to 120,000 per year prior to 1970, to be "relatively minimal").

Similarly, except for the receipt of $1.90 in royalties and one alleged licensing deal, the same conclusion obtains to the **eight** (8) year period 1995-2002.

Having established a prima facie case of abandonment, the burden shifts to Applicant "to show either evidence to disprove the underlying facts triggering the presumption of [three] years [of] nonuse, or evidence of an intent to resume use to disprove the presumed fact of no intent to resume use." *Stromgren Supports, Inc. v. Bike Athletic Co.*, 43 U.S.P.Q.2d 1100, 1111 (T.T.A.B. Mar. 6, 1997); 15 U.S.C. § 1127. Applicant has not done so.

b. Applicant Cannot Overcome the Presumption of Abandonment.

To overcome the presumption of abandonment, Applicant must do more than simply aver a subjective affirmative 'intent not to abandon' or desire not to relinquish the mark. *Imperial Tobacco, Ltd. v. Philip Morris, Inc.*, 899 F.2d 1575, 1581, 14 U.S.P.Q.2d 1390, 1394 (Fed. Cir. 1990). Applicant "must put forth evidence with respect to what activities it engaged in during the nonuse period or what outside events occurred from which an intent to resume use during the nonuse period may reasonably be inferred." *Id.* at 1581, 14 U.S.P.Q.2d at 1394-95.

To prove bona fide usage, Applicant "must demonstrate that use of the mark has been deliberate and continuous, not sporadic, casual or transitory." *La Societe Anonyme des Parfums Le Galion*, 495 F.2d at 1271-72, 181 U.S.P.Q. at 548. It must be sufficient to "rekindle the

public's identification of the mark with the proprietor. . . ." *Silverman*, 870 F.2d at 48, 9 U.S.P.Q.2d at 1784. Minor activities are insufficient to avoid a finding of abandonment. *Stetson*, 955 F.2d at 851, 21 U.S.P.Q.2d at 1786.

The evidence of record clearly shows that Applicant has not met this burden. As shown below, Applicant's (and third parties') sporadic, casual, transitory and de minimis use (if any) of the Drowning Pool mark and the limited exposure of their recordings from 1991 to 2003 is insufficient to avoid a finding of abandonment. Applicant cannot rely on the sales of IPR, the license agreement with IPR, or the radio playlists. Because the recording sessions were neither public nor publicized, they are of no support. Similarly, the suspect performance at the clothing gallery was apparently not advertised, promoted or publicized. Even if it was announced, a single public performance during a twelve (12) year period is insufficient under section 45 of the Act to constitute the level of use required to avoid abandonment.

Additionally, Applicant has shown no evidence of record sales **by it** in thirteen (13) years, no evidence of record sales by anyone in 1991, 1992, 1993, 1994, 1995, 1997, 1999, 2000, 2001, or 2003; no evidence of royalties received in 1995, 1997, 1998, 1999, 2000, 2001, 2002 or 2003; no evidence of any attempt to re-record or re-release records or albums for sale from 1991 until December 2003; no evidence of any other alleged use in 1992, 1997, or 2000, and no admissible evidence of other alleged uses in 1991-93, 1995 and 1999-2002. Moreover, the royalties received by applicant after 1990 are so de minimis that they are insufficient to avoid a conclusion of abandonment. *See Pilates, Inc. v. Current Concepts, Inc.*, 120 F. Supp. 2d 286, 309-10, 57 U.S.P.Q.2d 1174, 1193 (S.D.N.Y. 2000) (finding no intent to resume use where plaintiff demonstrated that it had (1) sold two or three pieces of marked equipment, (2) distributed copies of a single brochure that advertised the marked equipment and included an

order form, and (3) included "equipment" among the types of information available from its toll-free number in magazine advertisements because such "sporadic" uses "were not sufficient to maintain the public's identification" of the mark); *Kusek v. Family Circle, Inc.*, 894 F. Supp. 522, 533 (D. Mass. 1995) (holding that the availability of back magazine issues was an inconsequential use of mark and is insufficient to forestall abandonment).

Finally, Applicant's "self-serving testimony that [it] never intended to abandon the mark is simply outweighed by the objective evidence supporting the conclusion that the mark was abandoned with an intent not to resume use." *Yamaha Corp.*, 2002 T.T.A.B. LEXIS 721, at *26.[30]

Accordingly, it is plain that Applicant abandoned the mark Drowning Pool because for any three year period from 1991-2003, Applicant "'ceased to commercially exploit [Drowning Pool] the mark's secondary meaning in the music industry.'" *Marshak*, 240 F.3d at 199, 57 U.S.P.Q.2d at 1767 (citation omitted); *Oshman's Sporting Goods, Inc. v. Highland Imp. Corp.*, 16 U.S.P.Q.2d 1395, 1397 (T.T.A.B. Aug. 20, 1990) ("The cessation of importation of SUPERSPORT shoes and the selling off of remaining inventory without any intent to resume use is deemed abandonment of the mark."); *Societe Des Produits Marnier Lapostolle v. Distillerie Moccia S.R.L.*, 10 U.S.P.Q.2d 1241, 1244 n.5 (T.T.A.B. 1989) ("[A] party cannot defend against a claim of abandonment by relying on some 'residual goodwill' generated through subsequent sales of the product by distributors or retailers"); *Yamaha Corp. v. Wrightwood Enters., Inc.*,

[30] This decision may not be cited as precedent of the Trademark Trial & Appeal Board.

2002 T.T.A.B. LEXIS 721, at *19 (T.T.A.B. Nov. 22, 2002)[31] (holding that sales of three pianos in four years falls short of use of the mark in the ordinary course of trade).

Again, Opposer has demonstrated by a preponderance of the evidence of record that Applicant cannot overcome the prima facie evidence that it abandoned the Drowning Pool mark. Therefore, on this ground also, Opposer's opposition should be sustained.

C. OPPOSER'S POST 1995 RIGHTS IN THE MARK.

Opposer has demonstrated at pages 18-22 above, its extensive, open, notorious, exclusive and continuous use of the Drowning Pool mark to identify its entertainment services beginning in Texas in 1995, expanding regionally in 1997 – 2000, expanding nationally and internationally in 2001, and continuing on the national and international stage until the present. Opposer will not repeat the detail of that use here. Such use is clearly sufficient, in character, amount and geographic scope to acquire and maintain ownership rights in the Drowning Pool mark after the mark had been abandoned by Applicant. Opposer has demonstrated by a preponderance of the evidence of record that Applicant in fact has acquired ownership of the Drowning Pool mark. Therefore, the present Opposition should be sustained.

V. CONCLUSION

Applicant has abandoned its Drowning Pool mark, and is not entitled to registration of the same. As demonstrated above, (i) Applicant affirmatively abandoned the Drowning Pool mark in 1990 and has either stated or objectively demonstrated that it had no intent to resume use of the mark, (ii) during various three year periods from 1991 until 2003, Applicant ceased use of the Drowning Pool mark, has failed to present sufficient evidence to rebut the prima facie

[31] This decision may not be cited as precedent of the Trademark Trial & Appeal Board.

evidence of abandonment, and has not made sufficient use of the Drowning Pool mark to support ownership rights in the mark, (iii) the residual use of the Drowning Pool mark by Applicant or third parties from 1991-2003 falls far short of the requisite use of the mark by Applicant in the ordinary course of trade, and, therefore is insufficient to avoid a finding of abandonment, and (iv) since 1995, Opposer has made substantial and continuous use of the Drowning Pool mark and has acquired ownership of it. Therefore, the Opposition should be sustained, and Applicant's Application to Register refused.

This 22d day of August, 2005.

Respectfully submitted,

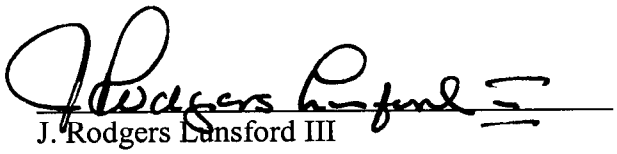

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EXHIBIT A

DESCRIPTION OF THE RECORD

The evidence of record consists of:

1. The file wrapper of the subject trademark application, Serial No. 76/287,792, pursuant to 37 C.F.R. 2.122(b).
2. Opposer's First Notice of Reliance, dated February 17, 2005, consisting of Applicant's Responses to Opposer's Interrogatories, Applicant's Responses to Opposer's Requests for Admission, and certain printed publications.
3. Applicant's Notice of Reliance, dated April 20, 2005, consisting of certain printed publications and official records.
4. Opposer's Second Notice of Reliance, dated June 24, 2005, consisting of certain official records.
5. Opposer's Deposition Testimony of Stevie Benton dated January 18, 2005 and Opposer's Exhibits 1-4 and Applicant's Exhibits 100-104, 106-120 ("Benton Dep. I").
6. Opposer's Deposition Testimony of Paul Bassman dated January 18, 2005 and Opposer's Exhibit 5 and Applicant's Exhibits 121 and 122 ("Bassman Dep.").
7. Opposer's Deposition Testimony of Jason Childress dated January 19, 2005 and Opposer's Exhibits 6-17 ("Childress Dep.").
8. Opposer's Deposition Testimony of Coby Nixon dated January 19, 2005 and Opposer's Exhibit 18 and Applicant's Exhibit 123 ("Nixon Dep."). Oppoer does not rely on Mr. Nixon's testimony, hereby formally withdraws the same, but has filed the transcript because it understands that it is required to do so.

9. Opposer's Deposition Testimony of Adam Elesh dated January 20, 2005 and Opposer's Exhibits 19-51 ("Elesh Dep. I").

10. Applicant's Deposition Testimony of Adam Elesh dated April 6, 2005 and Applicant's Exhibits 125-135 and 142, and Opposer's Exhibit 52 ("Elesh Dep. II").

11. Applicant's Deposition Testimony of Brett Smith dated April 6 and 7, 2005 and Applicant's Exhibits 136-138, 143, and 169-174, and Opposer's Exhibits 29-38, 53-99, and 200 ("Smith Dep.").

12. Applicant's Deposition Testimony of Bruce Licher dated April 7, 2005 and Applicant's Exhibits 141 and 144-168 ("Licher Dep.").

13. Applicant's Deposition Testimony of Michael Wayne Painter dated April 13, 2005 and Applicant's Exhibit 104 and Opposer's Exhibit 1 ("Painter Dep.").

14. Applicant's Deposition Testimony of Sean Field Hall dated April 13, 2005 and Applicant's Exhibit 104 and Opposer's Exhibits 1 and 2 ("Hall Dep.").

15. Applicant's Deposition Testimony of T. Pierce Baker dated April 13, 2005 and Applicant's Exhibit 104 and Opposer's Exhibit 1 ("Baker Dep.").

16. Applicant's Deposition Testimony of Thomas Driver dated April 13, 2005 and Opposer's Exhibit 1 ("Driver Dep.").

17. Opposer's Rebuttal Deposition Testimony of Stevie Benton dated June 23, 2005 and Opposer's Exhibits 201 and 202 ("Benton Dep. II").

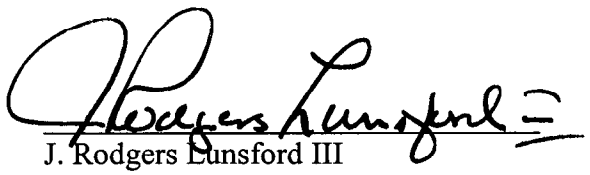
18. Opposer's Rebuttal Deposition Testimony of Christian Joseph Pierce dated June 23, 2005 and Opposer's Exhibits 203-205 ("Pierce Dep.").

CERTIFICATE OF SERVICE

I hereby certify that a true and correct copy of the foregoing OPPOSER'S TRIAL BRIEF was mailed to the following via United States first class mail, postage prepaid:

Gordon E. Gray III
GRAY LAW FIRM
4401 N. Atlantic Avenue
Suite 233
Long Beach, CA 90807

This 22nd day of August, 2005.



J. Rodgers Lunsford III

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