

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

DROWNING POOL, LLC, a Texas Limited
Liability Company,

Opposer,

v.

DROWNING POOL, a California
partnership.

Applicant.

Opposition No. 91154398

Mark: DROWNING POOL

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APPLICANT'S TRIAL BRIEF

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TABLE OF CONTENTS

I.	MARK AT ISSUE.....	1
II.	APPLICANT’S DESCRIPTION OF THE RECORD.....	2
III.	STATEMENT OF ISSUES.....	3
IV.	RECITATION OF FACTS.....	4
	A. Applicant has used its Drowning Pool Mark Continuously since 1984... 4	4
	1. Applicant’s Founding and Recordings.....	4
	2. Applicant started Mumbles and <i>continued</i> using the Drowning Pool mark.....	6
	3. Bruce Licher and Independent Project Records.....	8
	4. Applicant’s continued efforts to promote its Drowning Pool Mark.....	11
	B. The Dallas Band.....	12
	C. The Dallas Band knew of Applicant’s continuous use of the Drowning Pool mark since 1995.....	14
IV.	SUMMARY OF ARGUMENT.....	16
V.	MARK AT ISSUE.....	16
VI.	ARGUMENT.....	17
	A. Opposer lacks standing to bring this Opposition.....	17
	B. Opposer cannot establish grounds for this Opposition.....	20
	1. Opposer’s trademark applications are void.....	21

TABLE OF CONTENTS

a.	Opposer did not exist when its applications were signed or filed.....	21
b.	Opposer's application declarations are false.....	22
2.	Opposer has <i>never</i> used the Drowning Pool trademark and did not receive an assignment of trademark rights until 2004.....	23
C.	Applicant has not abandoned its Drowning Pool mark.....	24
1.	Applicant has continuously used its Drowning Pool mark in commerce since 1984.....	24
2.	Opposer has no evidence that it began using the mark in commerce in 1995.....	25
3.	Opposer has no evidence that Applicant intended to abandon the mark.....	32
4.	The Drowning Pool trademark was unaffected by the creation of Mumbles.....	32
5.	The unique nature of music groups and music recordings resist loss of trademark rights when recorded music is continuously available for sale or licensing.....	38
VII.	CONCLUSION.....	43

TABLE OF AUTHORITIES

U.S. Supreme Court Cases

<i>Beech-Nut Packing Co. v. P. Lorillard Co.</i> , 273 U.S. 629, 47 S.Ct. 481, 71 L.Ed. 810 (1925).....	24
<i>Minneapolis & St. Louis R.R. Co. v. Peoria & Perkin Union Ry. Co.</i> , 270 U.S. 580 (1926).....	18, 19

Federal Appellate Court Cases

<i>Cerveceria Centroamericana, S.A. v. Cerveceria India, Inc.</i> , 892 F.2d 1021 (Fed. Cir. 1989).....	24, 38
<i>Continental Distilling Corp. v. Old Charter Distillery Co.</i> , 188 F.2d 614 (D.C. Cir. 1950).....	24
<i>Gaia Technologies, Inc. v. Reconversion Technologies, Inc. et al</i> , 93 F.3d 774 (Fed. Cir. 1996).....	17, 18, 19
<i>Herbko International, Inc. v. Kappa Books, Inc.</i> , 308 F.3d 1156 (Fed. Cir. 2002).....	20
<i>Hiland Potato Chip Co. v. Culbro Snack Foods, Inc.</i> , 720 F.2d 981 (8th Cir. 1983).....	39
<i>Huang v. Tzu Wei Chen Food Co. Ltd.</i> , 849 F.2d 1458 (Fed. Cir. 1988).....	18, 21
<i>Income Tax Service Co. v. Fountain</i> , 475 F.2d 655 (CCPA 1973).....	26
<i>In re Polar Music International AB</i> , 714 F.2d 1567 (Fed. Cir. 1983)	31, 33, 34
<i>Jewelers Vigilance Committee, Inc. v. Ullenberg Corp.</i> , 823 F.2d 490 (Fed. Cir. 1987).....	17

TABLE OF AUTHORITIES

<i>Marshak v. Treadwell</i> , 240 F.3d 184 (3rd Cir. 2001).....	25, 31, 37, 38, 41, 42
<i>Otto Roth & Co., Inc. v. Universal Foods Corp.</i> , 640 F.2d 1317 (CCPA 1981).....	20
<i>Person's Co. v. Christman</i> , 900 F.2d 1565 (Fed. Cir. 1990).....	24, 38
<i>Ritchie v. Simpson</i> , 170 F.3d 1092 (Fed. Cir. 1999).....	17
<i>Rivard v. Linville</i> , 133 F.3d 1446 (Fed. Cir. 1998)	32
<i>Sands, Taylor & Wood Company v. The Quaker Oats Company</i> , 978 F.2d 947 (7th Cir. 1992).....	32
<i>Universal Oil Prod. Co. v. Rexall Drug and Chem. Co.</i> , 463 F.3d 1122 (CCPA 1972).....	17
<u>Trademark Trial and Appeal Board Cases</u>	
<i>Holmes Products Corp. v. Duracraft Corp.</i> , 30 USPQ2d 1549 (TTAB 1994).....	20
<i>In re Tong Yang Cement Corp.</i> , 19 USPQ2d 1689 (TTAB 1991).....	21
<u>Federal District Court Cases</u>	
<i>General Cigar Co. v. GDM, Inc.</i> , 988 F.Supp. 647 (SDNY 1997).....	26
<i>Intrawest Fin. Corp. v. Western Nat'l Bank</i> , 610 F.Supp. 950 (D. Colo. 1985).....	38
<i>Marshak v. Treadwell</i> , 58 F.Supp.2d 551 (D.N.J. 1999).....	25, 34, 41

TABLE OF AUTHORITIES

Proctor & Gamble Co. v. Paragon Trade Brands, Inc.,
917 F. Supp. 305 (D. Del. 1995)..... 19

The Kingsmen v. K-Tel International Ltd.,
557 F.Supp. 178 (S.D.N.Y. 1983)..... 25, 31, 37, 38, 40

U.S. Statutes, Codes & Rules

Lanham Act, § 2(d)..... 20-22

15 U.S.C. § 1063..... 17

15 U.S.C. § 1127..... 38

37 C.F.R. § 2.33(a)..... 22

37 C.F.R. § 2.71(d)..... 18, 21

TBMP § 713.08..... 11

TMEP § 803.06..... 21

TMEP § 1201.02(b)..... 18, 21

I. MARK AT ISSUE

DROWNING POOL

II. APPLICANT'S DESCRIPTION OF THE RECORD

Applicant Drowning Pool ("Applicant") hereby adopts Opposer Drowning Pool LLC's description of the record except as follows:

1. Applicant in its brief abbreviates the deposition citation for Applicant's Testimony Deposition of Adam Elesh, dated April 6, 2005, as "Elesh" and not "Elesh II." Applicant's only citation to Opposer's Testimony Deposition of Adam Elesh, dated January 20, 2005, is directly to Exhibit 51 attached thereto.

2. Applicant's Notice of Reliance, dated April 20, 2005, has Exhibits 100-103, 117-118, 127, 136, 138, and 175-182 attached thereto.

III. STATEMENT OF ISSUES

1. Does Opposer Drowning Pool LLC lack standing to bring this opposition proceeding?
2. Has Opposer Drowning Pool LLC failed to establish grounds under §2 (d) of the Lanham Act to oppose registration of Applicant's DROWNING POOL mark?
3. Has Applicant Drowning Pool continuously used the mark DROWNING POOL prior to Opposer's alleged date of first use?

IV. RECITATION OF FACTS

A. APPLICANT HAS USED ITS DROWNING POOL MARK CONTINUOUSLY SINCE 1984.

1. APPLICANT'S FOUNDING AND RECORDINGS

Adam Elesh and Brett Smith founded Applicant in 1984. [Applicant's Testimony Deposition of Elesh ("Elesh"), p. 5:13-15 and Applicant's Testimony Deposition of Smith ("Smith"), p. 8:11-13.]¹ As shown below, Applicant has used the Drowning Pool trademark continuously since 1984. Adam Elesh, based on a passage from a novel by Hermann Hesse, coined the mark "Drowning Pool." [Elesh, p. 5:10-12.] Applicant began by playing live music in clubs and other venues in 1984. [Elesh, p. 6:5-7.] Applicant has played live music in clubs and other venues from 1984 through 2003 using the Drowning Pool trademark. [Elesh, p. 6: 5-7 and p. 41:9 – p. 45: 1, Exhibits 128 and 129]

In 1985, Applicant, along with former members, drummer Tom Doyle and vocalist Andrew Crane, began recording music on cassette tapes bearing the Drowning Pool mark for sale to the public. [Elesh, p. 6:10-22 and Exhibit 128.] In particular, Applicant recorded the songs "Ritual Regeneration" and "Toy Soldiers" for a promotional cassette tape. *Id.* Additionally, Applicant recorded the song "Festival of Healing" for an album titled, "Viva Los Angeles," a compilation album with other artists from Los Angeles, and "Edith, Hold Out Your Hand" for a cassette tape and as later used on "Ultraviolet," another compilation album. [Elesh, p. 6: 23 – p. 7:12; Exhibit 128.] Later, in 1985, Jon Thomas replaced Tom Doyle as drummer for the band.

¹ The format for deposition citations shall be [Deponent, page:lines, and exhibit(s) if any.]

[Elesh, p. 7: 13-21.]

In 1986, Applicant began recording the self-titled album "Drowning Pool" more commonly referred to as "the Green Album." [Elesh, p. 7: 22 – p. 8: 19.] The Green album was not released until 1987. *Id.* In December 1986, Applicant recorded their first to be released album, the self-titled "Drowning Pool" that was sold through Viva Records in Italy and the United States. [Elesh, p. 8: 20 – p. 9: 2.] Also in 1986, Applicant signed with Nate Starkman & Son and Bruce Licher to distribute Applicant's music in the United States. [Elesh, p. 9: 3-10.]

In 1987, Applicant signed with Broadcast Music, Inc. ("BMI") for licensing services for its music under "Drowning Pool Music." [Elesh, p. 9: 11 – p. 10: 5.] Applicant's music has been available for license through BMI continuously since 1987. [Elesh, p. 11: 1 – p. 12: 17 and Exhibits 125-127.] Continuing in 1987, Applicant recorded two albums: Nierika and Satori. [Elesh, p. 18:6 – p. 19:18 and Exhibit 128.] The Nierika album was recorded in the United States in 1987 and printed in Italy in 1988 by Viva Records for sale in Europe and the United States. *Id.* The Satori album was recorded and printed in 1987 by Nate Starkman and Son for distribution in the United States. *Id.* The Green Album was released and printed in 1987 by Applicant and distributed by Caroline Records, Inc. in New York for sale in the United States. [Elesh, p. 19: 19 – p. 20:1 and Exhibit 128.] Also, in September of 1987, Applicant recorded "Italian Pop Song" for use on the album "Viva Los Angeles II," another compilation album for Viva Records. [Elesh, p. 20:2-13 and Exhibit 128.] "Viva Los Angeles II" was released in Europe and the United States in 1990. *Id.*

On or around 1989, Andrew Crane, the band's lead vocalist, left Applicant's band. Applicant along with band member Jon Thomas recorded the album "Aphonia" in 1989. [Elesh, p. 20: 14-23 and Exhibit 128.] Also in 1989, the compilation albums "Ultraviolet" and "Doctor Death's Volume III" were released. [Elesh, p. 21:10 – p. 22:17 and Exhibit 128.] "Ultraviolet" was released with the 1985 recording of "Edith, Hold Out Your Hand." *Id.* "Doctor Death's Volume III" was released with Applicant's recording of "Black Baghdad" from Aphonia. *Id.* On or around 1990, the compilation album, "Fundamental Hymnal," was released with Applicant's song "Black Baghdad." [Elesh, p. 22: 18 – p. 23: 6 and Exhibit 128.]

2. APPLICANT STARTED MUMBLES AND *CONTINUED* USING THE DROWNING POOL MARK.

In 1990, Applicant created another band named, "Mumbles," comprising Brett Smith, Adam Elesh, Jon Thomas and Kelly Rasmussen. [Smith, pp. 25:15 – 26:1, Exhibit 128.] The band had two releases, a tape release titled "Mumbles 1/Mumbles 2" and a compact disc ("CD") album "Two Clouds." *Id.* Both recordings were released and sold during and after 1990 and marked with the Drowning Pool trademark. [Testimony Deposition of Bruce Licher ("Licher"), p. 20:24 – 22:10; Smith, pp. 26:19-22, 26:23-27:6, and 27:10-18; Exhibits 128 and 153.] It is important to note that all of the songs contained on the above albums were available for license through BMI at least as early as 1990 as "Drowning Pool Music". [Elesh, p.13:7-18; Smith, pp. 24:19-25:5 and 25:18-23; and Exhibits 125, 126, 127 and 128.]

The band Mumbles was intended to be a new revenue stream for Applicant Drowning Pool. [Smith, p. 25:18-23.] The band Mumbles had a different lead singer and a different sound from Applicant's first band, Drowning Pool, so Applicant wanted to differentiate the two bands under the Drowning Pool trademark. [Elesh, p. 23:7-20.] Applicant had no intention of abandoning its Drowning Pool trademark by starting the band Mumbles. [Elesh, p.30:23-25 and Smith, p. 28:20-22.]

Applicant continued to do business under the Drowning Pool trademark, after Applicant started the band Mumbles, by licensing Drowning Pool songs both directly and through BMI, selling Drowning Pool records through Bruce Licher and Independent Project Records ("IPR"), and performing live under the Drowning Pool mark. The creation of the band Mumbles did not end Applicant's efforts to market, license and sell recordings bearing the Drowning Pool trademark. After the creation of Mumbles, the band Drowning Pool still performed live. [Smith, pp. 29:13 – 30:15.] After the creation of Mumbles, Applicant continued to offer Drowning Pool music for license through BMI. [Elesh, p. 30:5-8; Smith, p. 28:8-11; Exhibit 127.] After the creation of Mumbles, IPR did not stop selling or advertising Applicant's Drowning Pool recordings. [Licher, p. 24:7-10.] At no time did Applicant did tell IPR to stop selling Drowning Pool records. [Licher, pp. 23:24 – 24:1; Elesh, p. 30:9-14.] Nor did Applicant ask IPR to stop advertising the sale of Drowning Pool recordings. [Licher, p. 24:2-5.]

There is no evidence in the record that sales of Mumbles recordings ever eclipsed the sales of Drowning Pool recordings. The reason Applicant had no intention of abandoning the Drowning Pool mark and IPR had no interest in pulling the Drowning Pool recordings from its

catalog was because there was, and continues to be a demand from consumers for Drowning Pool recordings not only in the United States but worldwide as well. [Elesh, p. 30:9-14; Licher, p.29:2-7; Smith, p. 28:12-19, and *see, e.g.*, Exhibit 159.]

3. BRUCE LICHER AND INDEPENDENT PROJECT RECORDS

Each of the above mentioned albums and compilation albums (except for Fundamental Hymnal and Doctor Death's Volume III) bearing Applicant's Drowning Pool mark were sold in the United States from 1986 to 2002 by Independent Project Records and Bruce Licher's other companies, Nate Starkman and Son and "The Starkman Concern." [Licher, pp. 7-22 and p. 24: 21-24.]

Bruce Licher has testified regarding sales and advertisement of Drowning Pool recordings and produced corroborating catalogs and mail order price lists showing that Applicant's albums have been on sale and sold by Licher from 1986 to 2002. Opposer has conceded Applicant's use of the Drowning Pool mark from 1984 to 1989. [Opposer's brief, pp. 1-2.] Focusing on the period from 1990 to 2003, Licher's Independent Project Records and Parasol Records put out music catalogs and price lists quarterly or semi-annually featuring Drowning Pool's recordings. [Licher, pp. 26:24 – 29: 1 and Exhibits 150, 152, 153, 154, 156, 164, and 165.] IPR's catalogs have been distributed worldwide to several countries including The United States, Canada, Japan, Australia, New Zealand and most of the countries in Europe. *Id.* This worldwide promotion results in sales of Drowning Pool records throughout the United States, Canada, Europe and Japan. [Licher, p. 29: 2-7.]

Even on compilation albums listed in the catalogs, such as Viva Los Angeles II, Mr. Licher specifically listed Drowning Pool as one of the featured artists. Mr. Licher testified that he did this because:

I knew that they had a name that was well-known amongst the individuals on our mailing list and were interested in the style of music that we were offering for sale. So I felt that by showing their name, that would encourage people to buy the album. [Licher, p. 43: 16-21 and *see* Exhibit 154.]

In other words, Mr. Licher is well aware that Applicant's Drowning Pool mark has not been abandoned and has substantial goodwill amongst consumers.

Mr. Licher has also produced, distributed and sold promotional compilation cassette tapes with Applicant's Drowning Pool mark and music. [Licher, p. 29:20 – p. 31:5 and Exhibits 141 and 164.] These tapes, each featuring Drowning Pool recordings, were sold from 1995 to 1999. [Licher, p. 30:16-18 and Exhibit 141.]

Mr. Licher testified that IPR made substantial sales of Drowning Pool recordings from, *inter alia*, 1990 to 2002. In support of this testimony, he produced numerous invoices and inventory sheets showing sales of Drowning Pool recordings from 1990 to 2002. [See Licher, p. 45:8-24; p.46: 2-15; pp. 46:16-47:20; p. 48:2-18; pp.53:6 – 54:3; p.54: 4-17; p. 55:8-21; and Exhibits 144, 157, 158, 159, 160, 161, 166, 167, and 168.] Moreover, Mr. Licher further explained that these invoices, catalogs and inventory sheets are merely exemplary and that he has not kept every Drowning Pool invoice generated by a sale over his near 20-year relationship with Applicant. [Licher, pp. 56:2 – 57:9.] In fact, he testified that there were more sales made by IPR of Drowning Pool recordings than are shown on the documents produced. *Id.*

Contrary to Opposer's claim that Mr. Licher received no Drowning Pool albums after "sometime in the early 1990's," (Opposer's brief, p. 11), Mr. Licher testified that he received albums for sale from Applicant from 1986 to 2002. [Licher, p. 25:13 – p. 26: 15.] For example, in a note dated May 3, 1993, Mr. Licher tells Applicant's Brett Smith:

I've finally sold the last of the DROWNING POOL records you consigned to me 2 years ago, so here is final payment. I paid invoice of 4/8/91 for 25 copies for 5/31/91, and then got another 50 copies from you on 6/1/91, totaling \$250.00. I made payments of \$100.00 on 1/22/92, and \$75.00 on 12/28/92, owing another \$75.00. [Exhibit 144](emphasis added.)

However, even though Mr. Licher claims in Exhibit 144 to have "sold the last of the DROWNING POOL records," (emphasis in original), Mr. Licher testified that he received more Drowning Pool records after Exhibit 144. [Licher, p. 58:2-4.] Moreover, catalogs, inventory sheets and invoices corroborate his testimony and show that Mr. Licher and IPR received more of Applicant's recordings and continued to offer for sale and sell Applicant's recordings through 2002. [Licher, Exhibits 154-168.] The fact that IPR continued to sell Drowning Pool recordings for the next decade after Exhibit 144 was written shows that IPR's catalog statements such as "the last available" and "out of print" is merely puffery intended to encourage sales by claiming scarcity. IPR's catalog entries are much like the common advertising phrase "BUY NOW WHILE SUPPLIES LAST!!!" and do not indicate an intent to abandon a trademark when "supplies" are exhausted.

**4. APPLICANT'S CONTINUED EFFORTS TO PROMOTE ITS
DROWNING POOL MARK.**

Applicant intended to expand use of its Drowning Pool trademark. After the 1990 "Two Clouds" album, Applicant's next recording session occurred in 1996. [Elesh, p. 42:2 – 43:11, Exhibit 129.] That session resulted in a song entitled, "Sparrow", which was sold as a bonus track when the "Green Album" was re-released in December 2003. *Id.* and *see* Smith, pp. 31:6 – 35:23, Exhibit 137. Despite Opposer's claims to the contrary, the master recording for Sparrow and the rest of Applicant's master tapes have been available to Opposer for inspection for years. [Exhibit 51, p. 8.] Moreover, these tapes were available at the testimony deposition of Brett Smith but Opposer's counsel chose to attend only by telephone. [Smith, p. 2.] Applicant's master tapes have been submitted into evidence in this case via photographs. [Exhibit 137.]

Applicant submitted photographs of the master recordings to the Board rather than the physical specimens because Applicant's master recordings are extremely heavy and large. [Smith, p.34:16-20.] The tapes are also prone to degradation if not protected from heat and/or cold. Moreover, Applicant's master recordings by their very nature are one of a kind and irreplaceable. Accordingly, submission of photographs in lieu of the physical specimens was warranted and permissible under the rules. TBMP § 713.08 ("If exhibits are large, bulky, valuable, or breakable, the Board strongly prefers that they be photographed...and that the photographs be filed with the Board in lieu of the originals.")

In 1996, Applicant licensed the song "Romans" to Image Foundry, Inc., a "post-production house," for a television ad campaign. [Elesh, p. 45:6-24.] This was not, as Opposer

claims, merely fortuitous but a continuation of Applicant's efforts to license their music for television and film. Applicant had previously licensed a number of songs to filmmaker Richard Casey for a 1988 movie called "Hellbent." [Elesh, pp. 45:25 – 46:9.]

Applicant signed a license in 2000 with Independent Project Records to release their songs for download over the Internet. [Licher, pp. 31:24 – 33:25, Exhibit 142.] Thus, in addition to its consistent use of the Drowning Pool mark to sell and license its recorded music, Applicant has shown its intent to further expand use of its mark in other areas such as television and film and through alternate media such as digital music downloads.

Applicant filed Trademark Application Serial No. 76/287792, the subject of the present opposition, in July of 2001. [Exhibit 131.] Applicant performed live at the Don O'Melveny Gallery in West Hollywood in December, 2003. [Elesh, p. 42:2 – 43:11, Exhibit 129.] At that performance, Applicant re-released for sale on CD the "Green Album" with the "Sparrow" track previously recorded in 1996. *Id.* The Don O'Melveny Gallery performance by Applicant's band Drowning Pool was recorded on video and a DVD was produced for sale. *Id.* The Green Album and the DVD were placed on sale on Mr. Elesh's website in December 2003 and are still available there today. *Id.*

B. THE DALLAS BAND

Opposer has alleged numerous dates of first use. *Compare* Notice of Opposition, Exhibits 117, 118, and 121. Its earliest allegation of use was that a Dallas band named Drowning Pool started using the mark in 1995. [Bassman, Exhibit 121, Resp. to Rog. No. 3.] T Peirce Baker managed the Dallas band and its first members were Sean Field Hall (vocals), Michael

Painter (guitar), Reynolds Pervis (guitar), Kevin Rynders (drums), and later Thomas Driver joined as a bass player. [Hall, pp. 3:23 – 6:5, Baker, p. 4:2-16; Painter, pp. 4:6-13 and 5:4-7; and Driver, pp. 3:15-18 and 4:11-21.] For that band, Sean Hall chose the name “Drowning Pool.” [Hall, pp. 5:16 – 6:5; Baker, p. 4:17-22; and Painter, pp. 4:22 – 5:3.] The Dallas band’s first recording was a song called “Skin” for a compilation album called, “Lost in Dallas.” [Hall, pp. 5:23 – 6:15; Baker, pp. 6:19 – 7:7; Painter, pp. 5:13 – 6:7; Driver, pp. 4:11 – 5:18; and Exhibit 1.] Stevie Benton, responding to an ad in a local music magazine, replaced Thomas Driver on bass around March or February of 1995 after “Skin” was recorded. [Hall, pp. 6:6 – 7:17 and 8:10-9:14; Baker, p. 7:8-23 and pp. 9:8-10:23; Painter, p. 7:4-21; Driver, 5:13-18; and Exhibit 104.] The “Lost in Dallas” album was a promotional release to promote Nouveau Records and Ground Zero Studios. [Baker, p. 29:8-13.] There is no evidence in the record that the “Lost in Dallas” album was ever sold.

From 1996 to 1999, Michael Luce (drums), C.J. Pierce (guitar) and David Williams (vocals) replaced Messrs. Hall, Painter and Rynders in the Dallas band. [Benton I, pp. 29:7 – 30:23.] From 1995 to 2000, Opposer claims the Dallas band performed live 6 times in 1995, 11 times in 1996, 7 times in 1997, 3 times in 1998, 2 times in 1999 and 4 times in 2000. [Benton I, pp. 12-28 and 36-40, Exhibits 2 and 3.] No testimony or documentary evidence was submitted to show the size of these venues; the attendance, if any, at the alleged performances; the length of time that the Dallas band performed, and whether the Dallas band was even paid for their performance. Moreover, no documentary evidence was offered to show that the Dallas band sold any recordings during that time.

Mr. Williams, the Dallas band's vocalist, passed away on August 14, 2002. [Benton I, p.56:6-8.] James G. Vetter created Opposer Drowning Pool LLC on August 19, 2002. [Applicant's Notice of Reliance, Exhibit 180, pp. 1 and 9.] Opposer filed its Notice of Opposition in December of 2002. Opposer did not receive trademark assignments for "Drowning Pool" from members of the Dallas band or the Estate of Mr. Williams, until April of 2004. [Benton I, pp. 107:25 – 108:16, Exhibits 115 and 116.] Opposer, lacking any assets or funds, subsequently forfeited its corporate privileges and certificate of authority on July 9, 2004 and was not revived until January 20, 2005. [Exhibit 180, p. 4.] Members of the Dallas band allegedly became members of Opposer Drowning Pool LLC on June 23, 2005, approximately 2.5 years after the present opposition was filed and approximately sixty days before Opposer's trial brief was filed. [Pierce, Exhibit 205.]

C. THE DALLAS BAND KNEW OF APPLICANT'S CONTINUOUS USE OF THE DROWNING POOL MARK SINCE 1995.

Dallas band member, Stevie Benton, has been aware of Applicant's use of the Drowning Pool mark since at least as early as 1995. [Baker, p. 5:3-19.] Contrary to Opposer's claims of abandonment, T Peirce Baker located evidence of Applicant's use of the Drowning Pool mark using searches of the Internet in 1995 and told the Dallas band of Applicant's existence. *Id.* In 1995 or 1996, Thomas Driver was also able to locate evidence of Applicant's use of Drowning Pool using the Internet. [Driver, pp. 6:21 – 7:8.] Mr. Benton and the Dallas band were again notified of Applicant's ownership of the mark in 2000 through a music media search. [Bassman, pp. 15:2 – 16:21, Exhibit 119.]

Applicant subsequently became aware of the Dallas band's unlawful adoption of its name and attempted to contact them to resolve the issue. [Elesh pp. 48:8-25 and 53:8 – 54:8, Exhibits 130 and 132.] Applicant also filed the trademark application at issue to register its trademark on July 20, 2001. [Exhibit 131.] However, the Dallas band's attorneys feigned ignorance of Applicant's existence and use of its Drowning Pool trademark and demanded further evidence of Applicant's usage. [Elesh, p. 54:9-20.] Applicant provided the requested evidence and the Dallas band's counsel denounced it as baseless. [Elesh, pp. 54:9 – 55:4, 57:17 – 59:14, Exhibit 133.] The Dallas band blatantly ignored the mountain of evidence of Applicant's existence and continued using Applicant's Drowning Pool mark.

V. SUMMARY OF ARGUMENT

Applicant has used its Drowning Pool mark continuously since 1984 and is entitled to registration. Opposer spends its entire brief attacking Applicant's proof of continuous use without success. Tellingly, however, Opposer fails to even acknowledge establish basic and necessary elements for an opposition to a trademark registration, namely Opposer's lack of standing and grounds for the opposition. Opposer had neither standing nor grounds to initiate this opposition in December of 2002. Instead, Opposer Drowning Pool LLC was a shell company with no rights that was subsequently suspended by the State of Texas during this case.

Opposer's case for abandonment is just as insubstantial. Applicant has used the Drowning Pool mark on its music continuously from 1984 to the present. Opposer misrepresents substantial documentary and corroborated testimonial evidence of Applicant's continuous use of its Drowning Pool mark including third party testimony and documents showing sales of Applicant's Drowning Pool recordings during periods in which Opposer claims no activity occurred. Moreover, by the very supposed standards for adequate use offered by Opposer when reviewing Applicant's evidence of use, Opposer cannot prove that Opposer itself has ever adequately used the Drowning Pool trademark. In fact, using Opposer's hyper-technical standards for use, the Beatles, Led Zeppelin, Duran Duran and numerous other major recording artists have abandoned their trademark rights. Instead, by reviewing case law on the issue of abandonment as applied to music groups (as opposed to banks, potato chips or perfume as Opposer has suggested), it is clear that Applicant has not abandoned its trademark rights and is entitled to registration of its mark.

VI. ARGUMENT

A. OPPOSER LACKS STANDING TO BRING THIS OPPOSITION.

The basis for standing in a trademark opposition proceeding flows from 15 U.S.C. § 1063, which states in part:

Any person who believed that he would be damaged by the registration of a mark upon the principal register, including as a result of dilution under section 43(c), may, upon payment of the prescribed fee, file a notice of opposition in the Patent and Trademark Office...

The “belief of damage” requirement has been liberally construed by the Board and the Federal Circuit but still requires a reasonable basis in fact. See *Jewelers Vigilance Committee, Inc. v. Ullenberg Corp.*, 823 F.2d 490, 493 (Fed. Cir. 1987)(citing *Universal Oil Prod. Co. v. Rexall Drug and Chem. Co.*, 463 F.3d 1122, 1124 (CCPA 1972.)) At root, the Federal Circuit in *Jewelers Vigilance, supra*, explained, “the purpose in requiring standing is to prevent litigation where there is no real controversy between the parties, where a plaintiff, petitioner or opposer, is no more than an intermeddler.” 832 F.2d at 492 (citing *Lipton Indus., Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 1029-30 (CCPA 1982.)) In the present opposition, Opposer Drowning Pool LLC has failed to offer any evidence that establishes it was more than a mere intermeddler at the time the opposition was filed. See *Gaia Technologies, Inc. v. Reconversion Technologies, Inc. et al*, 93 F.3d 774 (Fed. Cir. 1996).

The Federal Circuit in *Ritchie v. Simpson*, 170 F.3d 1092, 1095 (1999) held, “in addition to meeting the broad requirements of § 13, an opposer must meet two judicially-created requirements in order to have standing – the opposer must have a ‘real interest’ in the

proceedings and must have a 'reasonable' basis for his belief of damage." For the "real interest" requirement, the Federal Circuit in *Ritchie, supra*, held "to have standing an opposer to a registration is required to have a legitimate personal interest in the opposition." *Id.*

Opposer Drowning Pool LLC had no legitimate personal interest in the opposition when it was filed. Opposer's trademark applications, as discussed below, were void. *Huang v. Tzu Wei Chen Food Co. Ltd.*, 849 F.2d 1458 (Fed. Cir. 1988); 37 C.F.R. § 2.71(d); TMEP §1201.02(b). It had not been assigned any trademark rights. [Benton I, Exhibits 115 and 116.] Opposer has failed to offer any evidence that it was using "Drowning Pool" as a trademark. Opposer did not have any members that were also members of the Dallas band, identified in Section III(b). [Applicant's Notice of Reliance, Exhibit 180 and Exhibit 182.] Opposer Drowning Pool LLC was the very definition of an "intermeddler," a shell company with no assets and no real interest in this case. [Applicant's Notice of Reliance, Exhibit 180, p. 4.]

Opposer's standing should be assessed when the opposition was filed. See *Gaia Technologies, Inc. v. Reconversion Technologies, Inc. et al*, 93 F.3d 774 (Fed. Cir. 1996) and *Minneapolis & St. Louis R.R. Co. v. Peoria & Perkin Union Ry. Co.*, 270 U.S. 580, 586 (1926). Throughout this proceeding, Opposer has scrambled to create a semblance of standing by obtaining a *nunc pro tunc* trademark assignment from the Dallas band and, as recently as June 23, 2005, having members of the Dallas band allegedly become members of Drowning Pool LLC. [Benton I, Exhibits 115 and 116 and Pierce, Exhibit 205.] However, the Federal Circuit and the U.S. Supreme Court have admonished that standing should be determined at the time the suit was filed. In *Gaia Technologies, supra*, the Federal Circuit quoted the court in *Proctor &*

Gamble Co. v. Paragon Trade Brands, Inc., 917 F. Supp. 305, 38 U.S.P.Q.2D (BNA) 1678 (D. Del. 1995) as follows:

As a general matter, parties should possess rights before seeking to have them vindicated in court. Allowing a subsequent assignment to automatically cure a standing defect would unjustifiably expand the number of people who are statutorily authorized to sue. Parties could justify the premature initiation of an action by averring to the court that their standing through assignment is imminent. Permitting non-owners and licensees the right to sue, so long as they eventually obtain the rights they seek to have redressed, would enmesh the judiciary in abstract disputes, risk multiple litigation, and provide incentives for parties to obtain assignments in order to expand their arsenal and the scope of litigation. Inevitably, delay and expense would be the order of the day. 93 F.3d at 779-80.

The U.S. Supreme Court acknowledges this as well. The Supreme Court held, “The jurisdiction of the lower court depends upon the state of things existing at the time the suit was brought.”

Minneapolis & St. Louis R.R. Co. v. Peoria & Perkin Union Ry. Co., 270 U.S. 580, 586 (1926) (emphasis added.)

Opposer Drowning Pool LLC did not exist until August 19, 2002 and had no assignment of rights to its alleged trademark until April of 2004, more than a year after this opposition was filed. [Benton I, Exhibits 115 and 116 and Applicant’s Notice of Reliance, Exhibit 180.] Accordingly, Opposer was a mere intermeddler when filing the present opposition and, therefore, lacks standing to oppose registration of Applicant’s mark.

B. OPPOSER CANNOT ESTABLISH GROUNDS FOR THIS OPPOSITION.

Opposer's only ground alleged for the present opposition is based on §2(d) of the Lanham Act, which reads in part:

No trademark by which the goods of the applicant may be distinguished from the goods of others shall be refused registration on the principal register on account of its nature unless it—

(d) Consists of or comprises a mark which so resembles a mark registered in the Patent and Trademark Office or a mark or trade name previously used in the United States by another and not abandoned, as to be likely, when applied to the goods of the applicant, to cause confusion, or to cause mistake, or to deceive...

The Court in *Otto Roth & Co., Inc. v. Universal Foods Corp.*, 640 F.2d 1317 (CCPA 1981) required that, to assert §2(d) grounds, an opposer "must prove he has proprietary rights in the term he relies upon to demonstrate likelihood of confusion as to source, whether by ownership of a registration, prior use of a technical 'trademark,' prior use in advertising, prior use as a trade name, or whatever other type of use may have developed as a trade identity." *Id.* at 1320. This is the *Otto Roth* rule. See *Herbko International, Inc. v. Kappa Books, Inc.*, 308 F.3d 1156, 1162 (Fed. Cir. 2002).

It is necessary that an opposer have proprietary rights in the mark alleged to be confusingly similar to the applicant's mark. The Board in *Holmes Products Corp. v. Duracraft Corp.*, 30 USPQ2d 1549, 1994 TTAB LEXIS 11, 10 (TTAB 1994) admonished, "Any other interpretation could lead to the result that a business competitor who used a mark totally different from an applicant's mark would be able to harass the applicant simply by searching the register and asserting the ground of likelihood of confusion based on any marks it happened to find there." As shown below, Opposer had no proprietary interest in the mark "Drowning Pool"

existing prior to Applicant's "Drowning Pool" mark or even when the present opposition was filed, December 12, 2002.

1. OPPOSER'S TRADEMARK APPLICATIONS ARE VOID.

a. OPPOSER DID NOT EXIST WHEN ITS APPLICATIONS WERE SIGNED OR FILED.

U.S. Trademark Application Serial No. 76/305,997 was filed on August 28, 2001 but received a filing date of December 17, 2002, due to Opposer's submission of two drawing pages and resulting election on December 17, 2002. [Benton I, Exhibit 117, pp. 3, 8 and 32.] U.S. Trademark Application Serial No. 76/365,925 was filed on February 2, 2002. [Benton I, Exhibit 118, p. 1.] However, Opposer Drowning Pool LLC did not exist until August 19, 2002. [Applicant's Notice of Reliance, Exhibit 180, p. 1.] Accordingly, Opposer's trademark applications are void. *Huang v. Tzu Wei Chen Food Co. Ltd.*, 849 F.2d 1458 (Fed. Cir. 1988); 37 C.F.R. § 2.71(d); TMEP §1201.02(b). The Trademark Manual of Examining Procedure states, "If the applicant does not own the mark on the application filing date, the application is *void*." TMEP §1201.02(b) (emphasis in original.) These defects cannot be cured by amendment or assignment. *In re Tong Yang Cement Corp.*, 19 USPQ2d 1689 (TTAB 1991), 37 C.F.R. §2.71(d) and TMEP §803.06. Opposer's trademark applications are void and cannot be considered a "proprietary interest" in the Drowning Pool mark.

b. OPPOSER'S APPLICATION DECLARATIONS ARE FALSE.

Michael J. Luce, as "Member/Manager" of Drowning Pool LLC, signed the declaration under penalty of perjury (18 U.S.C. §1001) for U.S. Trademark Application Serial No. 76/305,997 on August 22, 2001. [Benton I, Exhibit 117, pp. 5-6.] Michael J. Luce, as "Member/Manager" of Drowning Pool LLC, signed the declaration under penalty of perjury (18 U.S.C. §1001) for U.S. Trademark Application Serial No. 76/365,925 on August 22, 2001 as well. [Benton I, Exhibit 118, p. 6.] These declarations were and are clearly false, as Opposer Drowning Pool LLC did not exist until August 19, 2002. [Applicant's Notice of Reliance, Exhibit 180, p. 1.] Moreover, Mr. Luce was not a member or manager of Drowning Pool LLC through at least June 22, 2005, and allegedly not until June 23, 2005. [Applicant's Notice of Reliance, Exhibits 180 and 182; Pierce, Exhibit 205.] Accordingly, Mr. Luce was not authorized to sign the application declarations and the applications are void. 37 C.F.R. §2.33(a) ("The application must include a statement that is signed and verified (sworn to) or supported by a declaration under §2.20 by a person properly authorized to sign on behalf of applicant.") (emphasis added.) Opposer had no proprietary interest in the Drowning Pool trademark and cannot established §2(d) grounds for this opposition.

2. OPPOSER HAS *NEVER* USED THE DROWNING POOL TRADEMARK AND DID NOT RECEIVE AN ASSIGNMENT OF TRADEMARK RIGHTS UNTIL 2004.

Opposer has offered no documentary or testimonial evidence that it has used the Drowning Pool trademark itself. Opposer's only alleged evidence of use is by the Dallas band, an unrelated entity. No members of the band were members of Drowning Pool LLC when the opposition was filed on December 12, 2002. [Applicant's Notice of Reliance, Exhibits 180 and 182.] No assignment of trademark rights occurred until April 7, 2004. [Benton I, p. 108: 13-14 and Exhibit 115.] In fact, the entity Drowning Pool LLC was without assets, suspended and unable to conduct business due to tax forfeiture from July 9, 2004 through January 20, 2005. [Applicant's Notice of Reliance, Exhibit 180, pp. 2-4.] Opposer did not have a proprietary interest established in the Drowning Pool trademark when the opposition was filed and, therefore, had no grounds to bring the present opposition.

C. APPLICANT HAS NOT ABANDONED ITS DROWNING POOL MARK.

1. APPLICANT HAS CONTINUOUSLY USED ITS DROWNING POOL MARK IN COMMERCE SINCE 1984.

To prove abandonment, Opposer is first required to prove that Applicant did not use its “Drowning Pool” mark for a period of at least three years. *Cerveceria Centroamericana, S.A. v. Cerveceria India, Inc.*, 892 F.2d 1021, 1023 (Fed. Cir. 1989) and 15 U.S.C. § 1127. The District of Columbia Circuit admonished that a mark is *not* abandoned if not constantly used. *Continental Distilling Corp. v. Old Charter Distillery Co.*, 188 F.2d 614, 619 (D.C. Cir. 1950). It is not the law, “that the slightest cessation of use causes a trademark to roll free, like a fumbled football, so it may be pounced upon by an alert opponent.” *Continental Distilling Corp., supra*, at 619 (citing *Beech-Nut Packing Co. v. P. Lorillard Co.*, 1927, 273 U.S. 629, 47 S.Ct. 481, 71 L.Ed. 810 (1925).)

Opposer has no evidence that Applicant ever ceased using its “Drowning Pool” mark. Instead, Applicant has presented evidence that it began using the mark for live performances in 1984 and has offered music for sale and for licensing under the “Drowning Pool” mark continuously since at least as early as 1985. *See* Section III above, pp. 3-11.² The number of sales or degree of success by Applicant is irrelevant to the issue of abandonment. *Person's Co. v. Christman*, 900 F.2d 1565, 1571 (Fed. Cir. 1990). The Federal Circuit in *Person's, supra*, held:

Although sales by Christman and his corporation Team Concepts, Ltd. were often intermittent and the inventory of the corporation remained small, such circumstances do not necessarily imply abandonment. There is also no rule of law that the owner of a trademark must reach a particular level of success, measured

² Opposer has conceded that Applicant used the Drowning Pool mark from 1984-1989. (Opposer's brief, p. 1-2.)

either by the size of the market or by its own level of sales, to avoid abandoning a mark. *Id.* at 1571.

Applicant's proof of continuous use is sufficient to defeat Opposer's claim of abandonment.

As a matter of law, the trademark for a musical group is considered "in use" if the music from that group is available for sale or licensing under the group's trademark. *Marshak v. Treadwell*, 240 F.3d 184, 199 (3rd Cir. 2001); *The Kingsmen v. K-Tel International Ltd.*, 557 F.Supp. 178, 183 (S.D.N.Y. 1983). Professor McCarthy explains:

A performing group that disbands but continues to promote the sale of recordings that it made in years past does not thereby abandon its trademark rights to the group name. Thus, for example, group names like THE BEATLES and THE SUPREMES have not been abandoned. The continued promotion of records and the collection of royalties from the sale of previously recorded songs indicates an intent to continue to exploit the group name. 'A successful musical group does not abandon its mark unless there is proof that the owner ceased to commercially exploit the mark's secondary meaning in the music industry.' *McCarthy on Trademarks*, §16.45 (quoting *Marshak v. Treadwell*, 58 F.Supp.2d 551 (D.N.J. 1999)).

Applicant has continuously sold recordings bearing the Drowning Pool trademark and made them available for licensing. See Exhibits 125-127; 144, 157, 158, 159, 160, 161, 166, 167, and 168; and 150, 152, 153, 154, 156, 164, and 165. Clearly, Applicant has offered substantial proof of its continued use of the "Drowning Pool" trademark.

2. OPPOSER HAS NO EVIDENCE THAT IT BEGAN USING THE MARK IN COMMERCE IN 1995.

Opposer cannot succeed on its abandonment defense unless it also proves that it began using the "Drowning Pool" mark during the claimed period of non-use. If a challenger's first use is later than the resumed use of the party alleged to have abandoned the trademark, then the issue

of possible abandonment is irrelevant to the question of priority. See *Income Tax Service Co. v. Fountain*, 475 F.2d 655 (CCPA 1973); *General Cigar Co. v. GDM, Inc.*, 988 F.Supp. 647 (SDNY 1997). Essentially, Opposer must claim priority over Applicant's allegedly resumed use, if any. Otherwise, Applicant's application alone could stand on an intent-to-use basis.

Opposer's documentary evidence of the Dallas band's alleged use that is cited in its brief is insubstantial:

Year	U.S. Royalties³	Recording Sales	Other
1995	0	0	6 performances
1996	0	0	11 performances
1997	0	0	7 performances
1998	0	0	3 performances
1999	0	0	2 performances
2000	0	0	4 performances
2001	0	0	0
2002	0	0	0
2003	0	0	0
TOTAL:	0	0	33

³ The only alleged documentary evidence of royalties received by the Dallas band was not provided to Applicant until 15-20 minutes before the testimonial deposition of Jason Childress on January 19, 2005 even though the documents had been in the possession of Opposer's counsel since August 10, 2004. [Childress, p. 15:15-17:20 and Exhibits 11-17.] Such documents were ordered produced to Applicant by September 5, 2003 by order of the Board. Accordingly, these documents are untimely, inadmissible and should be stricken from the record.

Instead, Opposer relies almost exclusively on the self-serving and unsupported testimony of Stevie Benton, an admitted perjurer, for its evidence of use. *See* Opposer's brief, pp. 18-22 and Benton I, pp. 71:8 –73:15.

Mr. Benton is an unrepentant liar and admits that he tells his lies for "entertainment purposes." [Benton I, pp. 71:8–73:15.] Though he recanted the details of his original lie, Mr. Benton continues to claim that he coined the name "Drowning Pool" for the Dallas band, that he created the Dallas band, and that he appeared on the compilation album, *Lost in Dallas*. [Benton I, pp. 6:24 – 8:8 and Benton I, pp. 8:16 – 10:12.] His claims are false. Three different witnesses have independently testified that Sean Field Hall, and not Stevie Benton, named the Dallas Band. [Hall, pp. 4:16 – 5:5; Baker, p. 4:17-22; and Painter, pp. 4:22 – 5:3.] Four different witnesses have independently testified that Thomas Driver played the bass on the song "Skin" from the "Lost in Dallas" album and Mr. Benton did not appear at all on that album. [Hall, pp. 5:23 – 7:10; Baker, pp. 6:19 – 7:23; Painter, pp. 5:13 – 6:16; Driver, pp. 4:11 – 5:18; and Exhibit 1.]⁴

Rather than "forming the band" as Mr. Benton claimed, he was the last to join the Dallas band when he answered a "want-ad" for a bassist in a local music magazine. [Hall, pp. 6:6 – 7:7 and 8:10-9:14; Baker, p. 7:8-23 and pp. 9:8-10:23; Painter, p. 7:4-21; Driver, 5:13-18; and Exhibit 104.] During Mr. Benton's testimony, he confirmed that he had seen the ad, Exhibit 104. [Benton I, p. 83:3-4.] Mr. Benton confirmed that he is a bassist for the Dallas band. [Benton I, p. 84:6-8.] However, when confronted with documentary evidence that he did not create the

⁴ Mr. Benton's admittedly perjured testimony was used to defeat Applicant's motion for summary judgment and he is continuing to offer perjured testimony at trial. As the Board is unable to monetarily sanction Opposer or Mr. Benton for their unlawful actions, Mr. Benton's testimony in its entirety should be deemed inadmissible and stricken from the record.

Dallas band, i.e. Exhibit 104, Mr. Benton clung to his falsehood:

Q: And are you claiming that this notice ran in this magazine for a bassist for this same group of guys that were in the original Drowning Pool that you joined, and you did not join them?

A. No. I will say that they joined with me. [Benton I, p. 84:9-13.] (emphasis added)

The Board cannot rely upon Mr. Benton's deliberately false testimony.

Opposer uses a double standard for trademark usage throughout its trial brief. For example, Opposer implies that Applicant abandoned its Drowning Pool mark because lead singer Andrew Crane left the Drowning Pool band in 1989. However, Applicant released two albums (Aphonia and Two Clouds), two cassette tapes (Mumbles 1 and 2), and appeared on three compilation albums (Ultraviolet, Doctor Death's Vol. III and Fundamental Hymnal) within the two years after Andrew Crane left.⁵ See pages 4-6 above and Exhibit 128.

Conversely, the Dallas band's lead singer David Williams died in August of 2002. During the two years from the loss of their lead singer, Opposer has only offered testimony that the Dallas band appeared on one compilation album ("Daredevil") and released one album ("Desensitized"). [Benton I, pp. 58:2 – 59:1 and p. 67:15-24.] Applicant's recording activity exceeded Opposer's alleged activity on Opposer's own flawed standard.

Without authority, Opposer proclaims in its brief, (Opposer's brief, p. 28), that Applicant's tax returns are evidence that it has not used the Drowning Pool mark since 1990. However, Opposer has been unable to provide any valid tax returns for Drowning Pool LLC or

⁵ Viva Los Angeles II, a compilation album with a Drowning Pool recording made prior to Mr. Crane's departure, was also released in 1990. [Elesh, p. 20:2-13 and Exhibit 128.]

even the Dallas band. The sole attempt was to offer the first page of an unsigned 2000 tax return that purports to be for a Drowning Pool partnership. [Childress, pp. 30:16 – 31:24.] The single page offered into evidence is not a valid return. [Childress, p. 31:7-15.] Opposer again cannot meet the standards of use it has alleged.

Yet another example of Opposer's double standard is Opposer's claim that Applicant has abandoned its mark because no vinyl albums or CD's were made from the master tapes from 1992 to 1998. (Opposer's brief, pp. 11-13.) Opposer, however, has offered no documentary evidence that it has pressed a single record or burned a single CD during its entire existence. Mr. Benton's self-serving and unfounded hearsay testimony is the only attempt to claim recordings of the Dallas band have been burned to CD. Applicant hereby objects to Benton's testimony as inadmissible hearsay.

Moreover, Opposer has failed to offer any evidence that it has recorded a single master tape or, if such a tape exists, whether it has control or possession of that tape. On the contrary, Applicant has provided photographs of each of its albums, CD's and DVD's and the master tapes from which they were recorded. [Elesh, Exhibit 128 and Smith, Exhibit 137.] Opposer has provided no such evidence.⁶

On page 14 of its brief, Opposer claims the fact that Applicant was able to provide evidence of sales from 1985 to 1990 is somehow proof of abandonment. Opposer states, "Further Applicant kept invoices from album consignments and sales dated in 1987, 1988, 1989...but none thereafter." This is simply false. Applicant has provided substantial

⁶ Opposer's specimens from its trademark applications are unauthenticated and inadmissible hearsay and Applicant hereby objects to them.

documentary evidence of sales from 1990 to 2002. *See* Exhibits 144, 157, 158, 159, 160, 161, 166, 167, and 168.

On pages 15 and 16 of its brief, Opposer claims, “Even more telling, Applicant has produced no evidence that it has actively advertised or promoted its services under the Drowning Pool mark after 1990, although it did so frequently from 1985 through 1989.” Again, this is false. Applicant has provided evidence that its recordings have been advertised for sale worldwide since 1990. [Licher, pp. 26:24 – 29: 7 and Exhibits 150, 152, 153, 154, 156, 164, and 165.]

Conversely, Opposer has provided no records of sales, consignments or otherwise, or records of advertisements showing the availability of any recordings of itself or the Dallas band. In fact when questioned about its advertising expenditures, Opposer could muster only the following statement:

Opposer responds that from 1995 until 2000, it operated as a cash business, that during such period, its expenses exceeded its income, that for such period it does not presently have any business or financial records available to it to state a specific amount, but that during such period, its advertising expenditures were minimal. [Bassman, Exhibit 121, Response to Interrogatory No. 8.]

This falls far short of Applicant’s substantial documentary evidence of sales and advertisements.

Opposer, throughout its brief, attempts to claim that Applicant cannot rely on sales of Applicant’s recordings by its record label, Independent Project Records. *See* Opposer’s brief, p. 43. (“Applicant cannot rely on the sales of IPR...”). Opposer’s chart at page 40 is similarly constructed on this flawed premise. (“ignoring the IPR sales...”). This is a curious claim to make after, based solely on the testimony of Stevie Benton, Opposer claims to have “signed a

recording contract with Wind-Up Records,” “under this contract... Opposer recorded an album titled ‘Sinner,’” and “sold over 500,000 copies...” (Opposer’s brief, p. 20.) Under Opposer’s alleged standard, none of the sales of “Sinner” inure to the benefit of Opposer or the Dallas band. In fact, Opposer has offered no documentary evidence of any sales of recordings, via a record label or otherwise.

Opposer’s claim regarding IPR’s sales is also unsupported as a matter of law. The Court in *The Kingsmen, supra*, found usage based on the plaintiffs’ contract with Jerden Music, Inc. and Scepter Records for the sale of records. *The Kingsmen, supra*, 557 F.Supp at 182. In *Marshak, supra*, the Court specifically referred to the payment of royalties by Atlantic Records, The Drifters’ record label, for record sales. *Marshak, supra*, 240 F.3d at 188. Moreover, in *In re Polar Music International AB*, 714 F.2d 1567, 1568-69 (Fed. Cir. 1983) where Atlantic Records was the label for appellant “ABBA”, the Federal Circuit explained, “Atlantic’s use of the marks inures to the benefit of appellant.” Sales of a music group’s recordings by a record label under the music group’s trademark clearly inure to the benefit of the music group. Applicant and its Drowning Pool mark, as a repository of goodwill for Applicant, certainly benefit from sales of Drowning Pool recordings by its record label. Opposer has offered an untenable double standard for use to the Board that it cannot defend and its opposition should be dismissed.

3. OPPOSER HAS NO EVIDENCE THAT APPLICANT INTENDED TO ABANDON THE MARK.

Even if Opposer were able to show a three-year period of non-use, Applicant may rebut the presumption of abandonment by showing an actual intention to resume use during that period or show actual use occurred. *See Rivard v. Linville*, 133 F.3d 1446 (Fed. Cir. 1998). As shown above, Applicant has demonstrated continuous use of the mark since 1984. Moreover, Applicant continues to offer music for license for radio, television, and film use under the mark, (Elesh, pp. 45:6-24 and 45:25-26:9, Exhibits 125-127), as proof of its intent to continue its use of “Drowning Pool.” *See Sands, Taylor & Wood Company v. The Quaker Oats Company*, 978 F.2d 947, 956 (7th Cir. 1992).⁷ Furthermore, Applicant continues to record new music for possible new releases and has signed a contract for new releases of their previously recorded material. [Elesh, pp. 42:2 – 43:11; Licher, pp. 31:24 – 33:25; Smith; Exhibits 129, 137 and 142.] Applicant has also filed the current trademark application at issue. [Elesh, Exhibit 131.] All of these actions show Applicant’s intent to continue using its mark, “Drowning Pool.”

4. THE DROWNING POOL TRADEMARK WAS UNAFFECTED BY THE CREATION OF MUMBLES.

Applicant’s creation of the band, Mumbles, did not affect the Drowning Pool trademark because the consuming public understands that, even if a band disbands, the trademark and business of selling that band’s recordings and the quality associated therewith live on. Both the

⁷ Opposer claims that because Mr. Elesh did not maintain a current address with BMI that Applicant somehow intended to abandon its mark. However, Mr. Smith handles the day-to-day business of Drowning Pool. [Smith, p. 8:4-14.] There is no evidence in the record that Mr. Smith failed to keep his address with BMI current or ever failed to receive royalties.

Federal Circuit and the Dallas Band's Stevie Benton recognize this business/band dichotomy.

Stevie Benton acknowledged the business/band dichotomy in his testimony. [Benton I, pp. 131:4 – 132:10.] Often, Mr. Benton's use of the term "Drowning Pool" would refer to a specific group of people, such as himself, Williams, Pierce and Luce. [Benton I, p. 131:4 – 18.] For example, in Exhibit 100, Mr. Benton refers to this group being "born around a keg" in 1998. [Benton I, p. 76:16-24 and p. 81:2-8; and Exhibit 100, p. 6.] At other times, Mr. Benton refers to the Dallas band as a continuous business entity starting in 1995 and continuing to the present even though its roll call of members might change. [Benton I, pp. 131:24 – 132:4.] Mr. Benton acknowledged that the term "Drowning Pool" sometimes refers to a trademark/business and sometimes it only describes a specific group of band members. [Benton I, p. 132:7-10.]

This is also true as a matter of law. The case of *In re Polar Music, supra*, involved an attempt to register the trademark "ABBA" for the corporate entity of the music group "ABBA." The Federal Circuit overturned rejection of the mark based on descriptiveness and explained, "the mark 'ABBA' indicates not just the source of the performance but a source of the records and tapes and the sound recorded thereon." *Id.* at 1572. Thus, the mark "ABBA" was not merely a description of which group was performing but was also an indicia of a certain quality the public could rely on for music recordings. The Federal Circuit explained:

Phonograph records and tapes are much more than 'pieces of plastic.' They are the embodiment of sound. People purchase sound recordings because of the sounds they contain; it is sound that gives a recording its uniqueness. The quality of a sound recording encompasses both the quality of the material on which the sounds themselves and the quality of the material on which the sounds are recorded. We take notice of the fact, acknowledged by the board, that it is commonplace for the public to request records and tapes by the name of the recording artist. *Id.* at 1572.

It follows from this decision that the public is aware that even if a band disbands, its recordings will continue to be sold under its old mark and their quality will not change. *See Marshak v. Treadwell*, 58 F.Supp.2d 551 (D.N.J. 1999).

Opposer claims that the creation of the band Mumbles created an abandonment of the trademark Drowning Pool. However, historically, the remarks surrounding Applicant's creation of Mumbles are unremarkable. In 1970-1971, Paul McCartney filed suit to dissolve The Beatles. *See* Applicant's Notice of Reliance, Exhibit 176, excerpt from *The Longest Cocktail Party*, Richard DiLello (1972)(citing January 1, 1971, *The Times* [London] article by Geoffrey Wansell). An article in the Times of London on January 1, 1971 states:

The writ issued by Paul McCartney in the Chancery Division of the High Court yesterday sought: 'A declaration that the partnership business carried on by the plaintiff and the defendants under the name of 'The Beatles and Co.' and constituted by a deed of partnership dated April 19, 1967, and made between the parties hereto ought to be dissolved and that accordingly the same be dissolved...In a newspaper interview last April immediately after he released his first solo record Paul McCartney explained that The Beatles had ceased to exist as a group. *Id.* (emphasis added.)

The efforts by Paul McCartney were not the only public statements "to dissolve The Beatles."

The article continues, “This move to formally end The Beatles is not entirely unexpected. Some 15 months ago John Lennon announced his intention not to work with the members of the group again, as his recordings with his wife Yoko Ono and other interests were taking all his time.” *Id.* These types of statements about the Beatles continued on *for years*. For example, on September 21, 1979, when a Beatles reunion was rumored, Paul McCartney said, “None of us wanted to do the show, really, because The Beatles are over and finished with. So there was absolutely no chance of it happening.” [Applicant’s Notice of Reliance, Exhibit 175, excerpt from “The Dream Is Over – Off the Record 2,” p. 248.] Clearly, despite these statements far more unequivocal than “R.I.P.D.P.”, no one believes that the dissolution of the band, The Beatles, meant that they had abandoned their trademark rights during their very public disputes watched by millions of fans. The reason that the trademark, The Beatles, was not abandoned was because their record label, Apple Records, continued to sell records and EMI continued to license their music.

There are a number of music groups that dissolved in similar fashion that continue to maintain trademarks by continuing to sell and license previously recorded music. Bands such as Nirvana, The Eagles, and The Doobie Brothers have all been dissolved at one time or another but continue to possess trademark rights for this reason. In fact, the group Duran Duran disbanded for fifteen years and recently reunited and acknowledged that its name had an audience despite the group’s lengthy period between albums. [Applicant’s Notice of Reliance, Exhibit 179.] These examples are easily cited because of the availability of substantial historical records such as biographies and press clippings. For example, the band Led Zeppelin ceased to exist in 1980

when its drummer John Bonham died. After Bonham's death, the band released the statement, "The loss of our dear friend and the deep respect we have for his family, together with the sense of undivided harmony felt by ourselves and our manager, have led us to decide that we could not continue as we were." [Applicant's Notice of Reliance, Exhibit 178, excerpt from "Stairway to Heaven Led Zeppelin Uncensored" by Richard Cole (2002), p. 319.] Their tour manager, Richard Cole, in his biography stated, "Led Zeppelin had enjoyed an incredible flight, but the band had finally touched down for the last time." *Id.* The trademark, LED ZEPPELIN, would continue, however, because of continued sales and licensing of previously recorded music.

Applicant's label, Independent Project Records, continued to sell Applicant's Drowning Pool records and BMI continued to license Applicant's Drowning Pool music after Applicant formed Mumbles. *See* Exhibits 125-127; 144, 157, 158, 159, 160, 161, 166, 167, and 168; and 150, 152, 153, 154, 156, 164, and 165. Applicant does not contend that it is a famous entity like The Beatles or the other groups mentioned above. However, as a consequence, the statements made by Applicant regarding its Drowning Pool and Mumbles bands, received far less attention than the dramatic and unequivocal statements of Paul McCartney and John Lennon regarding the dissolution of The Beatles or the tragic death of Led Zeppelin's John Bonham.

The subsequent actions of Applicant in forming Mumbles are no less analogous to the actions by the former members of The Beatles. Each former member, John Lennon, Paul McCartney, George Harrison and Ringo Starr, started his own successful band or solo recording career after the break up of The Beatles. *See* Applicant's Notice of Reliance, Exhibit 177. Again, none of these efforts evidenced intent to abandon The Beatles' trademark rights. In fact,

more than the former Beatles, Applicant continued to use its Drowning Pool trademark on Mumbles recordings. (See Elesh, Exhibit 128.)

Thus, when Paul McCartney started his band Wings, the public did not suddenly believe that old Beatles' recordings like "Help" would somehow change in quality or be sold under a new mark. Likewise, when Applicant started Mumbles, the public was not being told Drowning Pool's "Aphonia" album would now be sold as "Mumbles Aphonia" or that the quality of that recording had somehow changed or that the album would no longer be available. Instead, Drowning Pool's Aphonia album (and Applicant's other recordings) continued to be available for sale through IPR under the same Drowning Pool mark with the same quality as before regardless of the existence of Mumbles. See Exhibits 144, 157, 158, 159, 160, 161, 166, 167, and 168. It is indisputable that Applicant's trademark rights have been preserved by the continued availability and sale of Applicant's previously recorded music, regardless of the formation of the band, Mumbles. See *Marshak v. Treadwell*, 240 F.3d 184, 199 (3rd Cir. 2001); *The Kingsmen v. K-Tel International Ltd.*, 557 F.Supp. 178, 183 (S.D.N.Y. 1983). Accordingly, the creation of Mumbles did not effect an abandonment of Applicant's Drowning Pool trademark.

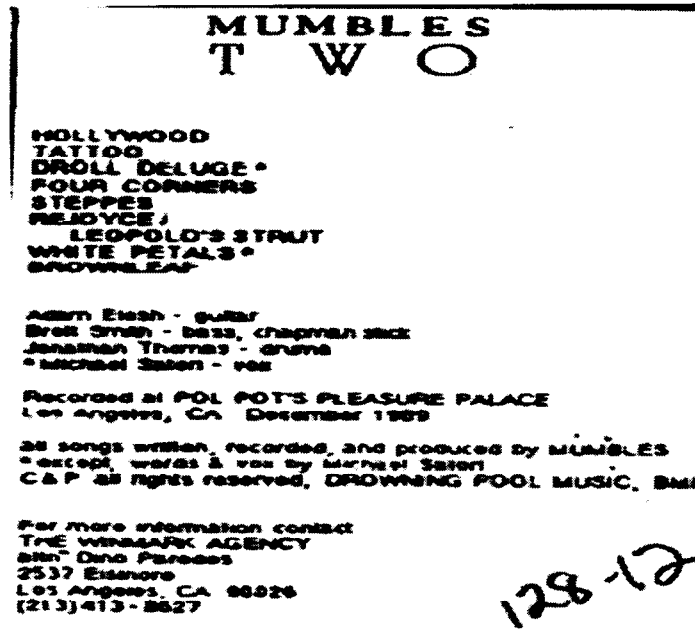
5. THE UNIQUE NATURE OF MUSIC GROUPS AND MUSIC RECORDINGS RESIST LOSS OF TRADEMARK RIGHTS WHEN RECORDED MUSIC IS CONTINUOUSLY AVAILABLE FOR SALE OR LICENSING.

Opposer unsuccessfully attempts to distinguish the facts of the *Marshak* and *Kingsmen* cases from the present case. These cases are only distinguishable from the present case on the issue of Applicant's fame. Applicant does not claim to be as famous as "The Drifters" or "The Kingsmen." However, financial success and fame are not elements of abandonment. See *Person's Co. v. Christman*, 900 F.2d 1565, 1571 (Fed. Cir. 1990); *Cerveceria Centroamericana, S.A. v. Cerveceria India, Inc.*, 892 F.2d 1021, 1023 (Fed. Cir. 1989); and 15 U.S.C. § 1127.

Opposer fails to distinguish the core rationale offered by the *Kingsmen*, *supra*, and *Marshak*, *supra*, that a trademark is "in use" if recordings from that group are available for sale or licensing under the group's trademark. As shown repeatedly above, Applicant continues to sell and promote previously recorded music, make that music available for licensing, and collect royalties. Therefore, Applicant has not abandoned its Drowning Pool trademark.

Opposer's reliance on *Intrawest Fin. Corp. v. Western Nat'l Bank*, 610 F.Supp. 950 (D. Colo. 1985) is misplaced. In *Intrawest*, *supra*, the District Court held that effecting a change of name without any reference to continued use of the former name could constitute abandonment even where the period of nonuse is only a few months. *Id.* at 958. The District Court explained, "None of the extensive advertising announcing the name change apprised the public of any continued use of the mark." *Id.* at 958. The District Court also noted that the plaintiff's belated

use of the mark at issue came after the competitor had started its own use of the mark. *Id.* In the present case, however, Applicant placed its Drowning Pool mark on every Mumbles recording. Thus, showing the public that the mark "Drowning Pool" was still in use:



See Exhibit 128, p. 12. As shown above, Applicant also continued to sell recordings and license music under the Drowning Pool mark before the Dallas band adopted the name and long before Opposer ever existed. See, e.g., Exhibits 125-127, 144, 150, 154, 155, 156, 157, and 158.

Opposer's reliance on *Hiland Potato Chip Co. v. Culbro Snack Foods, Inc.*, 720 F.2d 981 (8th Cir. 1983) is also misplaced. In *Hiland, supra*, after a merger, the senior potato chip company had told its customers that its brand would be discontinued in favor another brand. The junior potato chip company then began using the disputed mark. The senior potato chip company then resumed use. This is not analogous to the present case. Here, Applicant created Mumbles, another brand of music recordings also bearing the Drowning Pool mark (Exhibit 128), and

continued to sell and license its Drowning Pool recordings before Opposer, the junior user, ever existed. *See, e.g.*, Exhibits 125-127, 144, 150, 154, 155, 156, 157, and 158.

However, abandonment is an issue of fact and Applicant does not sell potato chips or offer banking services. Applicant records, sells and licenses music. [Smith vol. II, p. 123:5-23.] Thus, the *Kingsmen* and *Marshak* cases are most analogous to the present case. Opposer's analysis of those cases is misleading. Opposer claims that Applicant disbanded Drowning Pool, started the band Mumbles and told the public that Drowning Pool had "ceased to exist," thus claiming to distinguish the present case from *Kingsmen*. However, in *Kingsmen*, a 1983 case, the Court expressly holds that the Kingsmen had been disbanded and ceased performing in 1967 after only three years of existence. *Kingsmen, supra*, at 180. The Court also holds that the band had ceased recording. *Id.* at 183. There is no reference in the *Kingsmen* opinion that the band had done any advertising or other activities to promote their mark. The Court simply states, "These plaintiffs continue to this day to receive royalties from the sale of compositions recorded by the Kingsmen in the 1960's." *Id.* at 182. The Court makes no reference to any particular volume of sales or royalties collected by the plaintiffs. The Court simply holds that the band's act of collecting royalties is sufficient to avoid abandonment. Applicant's evidence of use exceeds the scope of activity, namely collection of royalties, required by *Kingsmen, supra*. Applicant has offered evidence of sales (see below), advertisement (Licher, p. 29:2-7), new recordings (Elesh, p. 42:2 – 43:11; Smith, pp. 31:6 –35:23; Exhibits 128, 129, 137, and 141), and the licensing and collection of royalties for recordings (Exhibits 125-127). *See also* Exhibits 144, 157, 158, 159, 160, 161, 166, 167, and 168; and 150, 152, 153, 154, 156, 164, and 165.

Kingsmen is not distinguishable from the present case.

Opposer cannot distinguish *Marshak, supra*, either. In *Marshak, supra*, the senior user of "the Drifters" mark essentially stopped performing in the United States and the Court stated the group's popularity "waned." *Id.* at 189. The Court did not refer in its opinion to any volume of sales or royalties for the senior user Treadwell. The Court did not refer to any advertising activity in rendering its decision. The Court also did not refer to any new recording activity by the senior group. Moreover, the Court cited a litany of issues relied upon by junior user Marshak to indicate abandonment:

In arguing that judgment as a matter of law was improper, Marshak relies on the following evidence. First, Treadwell dropped her 1971 action against Marshak in New York state court after the court denied her application for a preliminary injunction and issued an unfavorable opinion. Second, Treadwell did not oppose the federal registration of Marshak's mark or previously seek to have it canceled. Third, Treadwell failed to challenge numerous violations of "The Drifters" name, whereas Marshak stopped those uses through legal action. Fourth, Treadwell left for England in 1972. Fifth, Treadwell's English recording contracts did not provide for distribution in the United States. *Id.* at 199-200.

Nevertheless, the Court held:

However, once it is recognized that the commercial exploitation of classic Drifters recordings in this country constitutes use, it is apparent that the evidence that Marshak cites is insufficient to show either the non-use and or the actual intent to abandon that are necessary for a finding of abandonment. *Id.* at 200. (emphasis added).

The Court upheld the District Court's finding that that there was no abandonment as a matter of law because "the original Drifters recordings have been played on the radio and sold in record stores, without interruption, for the past 40 years." *Marshak, 58 F. Supp. 2d at 575.*

This case is indistinguishable from the present case. Applicant has presented evidence of use of its Drowning Pool mark for twenty years. Applicant has provided documentary evidence showing Applicant's airplay, radio play lists and even its airplay at a nightclub over that time. [Elesh, Exhibit 126; Smith, Exhibit 136; and Smith vol. II, Exhibit 170.]⁸ Applicant's evidence also exceeds the scope of evidence required by *Marshak, supra*, as Applicant has offered evidence of, *inter alia*, advertisements, new recordings, and live performances. Applicant's Drowning Pool mark has been in use continuously for over twenty years and its mark should be registered.

⁸ Opposer objected to Exhibit 136 as hearsay. However, Brett Smith testified that he personally downloaded these play lists from the Internet. [Smith, pp. 16:1 – 19:12.] Thus, at a minimum, these play lists are admissible to show that DJs acknowledge the existence of Applicant and its recordings and believe those recordings are worthy of inclusion on their play lists.

VII. CONCLUSION

Opposer has failed to establish standing or grounds for this Opposition. Moreover, Applicant has continuously used its mark DROWNING POOL since 1984, long prior to Opposer's alleged dates of first use. Accordingly, Applicant respectfully requests that the Opposition be dismissed with prejudice and the mark allowed to register.

Respectfully submitted,

DROWNING POOL

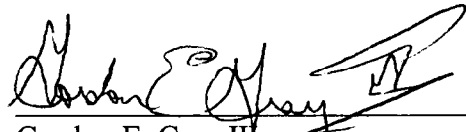
Dated: 10/3/2005

By: 

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CERTIFICATE OF SERVICE

I hereby certify that a copy of the foregoing **APPLICANT'S TRIAL BRIEF** was mailed first class mail, postage prepaid, to: J. Rodgers Lunsford III, Smith, Gambrell & Russell, LLP, 1230 Peachtree Street, N.E., Suite 3100, Promenade II, Atlanta, GA 30309-3592, attorney for the Opposer, on this October 3, 2005.

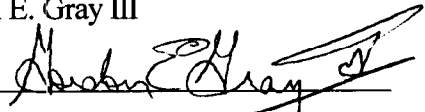


Gordon E. Gray III

CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service as First Class Mail in an envelope addressed to the Commissioner for Trademarks, P.O. Box 1451, Alexandria, VA 22313-1451 on October 3, 2005.

By: Gordon E. Gray III

Signature: 

Date: October 3, 2005 