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

Proceeding	91162489
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

VIBE VENTURES LLC, :
 :
 Opposer, :
 :
 v. : Opposition No. 91162489
 : Serial No. 78/254486
 RAWVIBE ENTERTAINMENT, INC., :
 :
 Applicant. :

OPPOSER’S BRIEF IN REPLY TO APPLICANT’S MAIN BRIEF

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

Applicant: Raw Vibe Entertainment, Inc.
Trademark: RAWVIBE
Serial No.: 78/254,486
Filed: May 27, 2003
Published: June 1, 2004
Goods: Pre-recorded audio, visual and audio-visual performances in analog and digital configurations and formats contained in analog magnetic tapes and discs, all containing music in International Class 9

VIBE VENTURES LLC,	:	
	:	
Opposer,	:	
	:	
v.	:	Opposition No. 91162489
	:	Serial No. 78/254486
RAWVIBE ENTERTAINMENT, INC.,	:	
	:	
Applicant.	:	

Attention: Trademark Trial and Appeal Board
Commissioner for Trademarks
P.O. Box 1451
Alexandria, Virginia 22313-1451

OPPOSER’S BRIEF IN REPLY TO APPLICANT’S MAIN BRIEF

In further support of its Opposition, Opposer Vibe Ventures LLC and potential Opposer Vibe Media Group LLC (collectively, “Opposer”),¹ by their attorneys, Frankfurt Kurnit Klein & Selz, P.C., submit this reply memorandum in response to Applicant RawVibe Entertainment, Inc.’s (“Applicant”) Main Brief filed on July 14, 2006 (“App. Main Br.”).

¹ As stated in Opposer’s Cross-Motion to Substitute a Party, on or about June 30, 2006, Opposer sold its assets to potential Opposer Vibe Media Group LLC, and as part of this sale, assigned all right, title and interest to its trademarks, including the right to maintain this trademark proceeding.

I INTRODUCTION

Applicant is attempting to register the mark RAWVIBE for “pre-recorded audio, visual and audio-visual performances in analog and digital configurations and formats contained in analog magnetic tapes and discs, all containing music” in International Class 9. As set forth more fully in Opposer’s Main Brief In Support of Opposition, dated June 14, 2006 (“Opp. Main Br.”), the Trademark Trial & Appeal Board (the “Board”) should refuse to register the RAWVIBE Mark (“RAWVIBE” or “Applicant’s Mark”) because RAWVIBE is confusingly similar to Opposer’s VIBE Mark and is used in connection with identical goods, and is therefore likely confuse consumers as to the source of Applicant’s goods. In addition, Applicant has not made a bona fide use of the mark RAWVIBE in commerce prior to the filing of its use-based application under Section 1(a) of the Lanham Act, 15 U.S.C. § 1051(a), and therefore the application should fail *ab initio*.

Applicant argues that VIBE is a weak mark that cannot prevent the registration of Applicant’s RAWVIBE Mark. (App. Main Br. at 1). However, Applicant ignores the evidence discussed *infra* regarding the strength of the VIBE Mark and the dominance of the VIBE brand in the urban music field for close to fifteen years. Applicant also argues that Opposer lacks standing because the VIBE Marks at issue were sold or assigned to another party. (*Id.*). This argument is a red herring however, as TMBP § 512.01 allows the substitution of an assignee to continue an opposition proceeding – a matter that was addressed in Opposer Vibe Ventures LLC’s Cross-Motion to Substitute a Party. Finally, Applicant argues that the issues raised in Opposer’s Main Brief surrounding Applicant’s questionable use of the RAWVIBE Mark’s use in commerce and the false statements made by Applicant on the RAWVIBE application were not properly before the Board. (*Id.* at 2). However, because of the extensive questioning regarding the date of and scale of use of the RAWVIBE Mark in commerce, Applicant was on notice of

such arguments. Additionally, the Board has the power to remand this matter to the Examining Attorney to address these defects in Applicant's use-based application.

II OPPOSER HAS STANDING TO CHALLENGE APPLICANT'S MARK

Opposer Vibe Ventures LLC and potential Opposer Vibe Media Group LLC² have standing to challenge Applicant's Mark. As noted in Opposer's Cross-Motion to Substitute a Party, the marks at issue that are owned by Vibe Ventures LLC have been assigned to Vibe Media Group LLC, and by virtue of this assignment potential Opposer Vibe Media Group LLC owns all of the right, title, and interest in and to the trademarks previously owned by Opposer, as set forth in the Notice of Opposition herein, including the right to maintain this trademark opposition proceeding. As such, both Opposer Vibe Ventures LLC and its assignee Opposer Vibe Media Group LLC are persons who believe that they would be damaged by the registration of Applicant's Mark on the Principal Register and have standing to oppose. See 37 C.F.R. § 2.101; TBMP § 512.01.

III LIKELIHOOD OF CONFUSION BETWEEN APPLICANT'S AND OPPOSER'S MARKS EXISTS

Pursuant to Section 2(d) of the Lanham Act, which precludes the registration of a mark that so resembles "a mark of trade name previously used in the United States by another and not abandoned, as to be likely, when used on or in connection with the goods of the applicant, to cause confusion, or to cause mistake, or to deceive," Applicant is not entitled to register its RAWVIBE Mark. Opposer has made widespread use of the VIBE Mark in the United States

² Again, as stated in Opposer's Cross-Motion to Substitute a Party, on or about June 30, 2006, Opposer sold its assets to potential Opposer Vibe Media Group LLC, and as part of this sale, assigned all right, title and interest to its trademarks.

since 1992 in connection with a wide variety of goods and services related to urban music, thereby establishing proprietary rights in such Mark. Applicant's junior use of RAWVIBE in connection with both identical and closely related goods and services is likely to cause confusion with Opposer's similar VIBE Mark, whose strength and fame is widely known in the urban music genre. Due to (a) Applicant's appropriation of the Opposer's entire Mark as RAWVIBE's dominant feature, (b) the identical and closely related nature of the parties' goods and services, and (c) the strength and fame of the VIBE Mark in the urban music field, consumers are likely to be confused as to the source of Applicant's goods. Therefore, the RAWVIBE Mark is not registrable under the Lanham Act.

A. Because of the Similarity of the RAWVIBE and VIBE Marks, Consumers Will Be Confused as to the Source of Applicant's Goods.

Although not identical, when considered in their entireties, RAWVIBE and VIBE are similar in sound, appearance, connotation, and commercial impression. See In re E.I. DuPont de Nemours & Co., 476 F.2d 1357, 1361 (C.C.P.A. 1973). Similarity in any one of these elements is sufficient to find a likelihood of confusion. In re Mack, 197 U.S.P.Q. 755, 757 (Trademark Tr. & App. Bd. 1977). Here, "VIBE" is the conspicuous part of both Opposer's and Applicant's marks. By using RAWVIBE, Applicant has appropriated Opposer's entire, identical VIBE Mark as the dominant portion of Applicant's Mark. When such appropriation occurs, confusing similarity must be found to exist. See Purolator, Inc. v. Efra Distributors, Inc., 524 F. Supp. 471, 213 U.S.P.Q. 961, 965 (D. P.R. 1981); In re Sawyer of Napa, Inc., 222 U.S.P.Q. 923, 924 (Trademark Tr. & App. Bd. 1983). The similarity of RAWVIBE and VIBE leads to a likelihood of confusion as to the source or sponsorship of goods and services in the urban music field.

Applicant attempts to argue that RAW rather than VIBE is the dominant element of its Mark. (App. Main Br. at 11-12). Implicitly recognizing the weakness of this argument, in order

to attempt to convince the Board of its merits, Applicant next makes the baseless contention that “VIBE” is generic. (App. Main Br. at 12-13). To prove its point Applicant ignores the impressive collection of Opposer’s VIBE Marks, including almost fifteen years of continuous use of the VIBE Mark in connection with goods and services related to urban music,³ and instead seeks to introduce into evidence the useless results of a search of the USPTO database made by its counsel listing registered marks and applications (live and dead) in International Class 9 that contain the word “VIBE” without regard to goods and services. (*Id.* at 12). First, such introduction of evidence is improper as “a party may *not* make a third-party registration of record simply by introducing a list of third party registrations that includes it; ... or by referring to the registration in its brief.” TBMP § 704.03(b)(1)(B) (emphasis in original); see also TBMP § 704.03(b)(2). Second, however, even if this evidence were allowed, Applicant fails to point out that many of the marks listed on the printout reviewed during the testimonial deposition of Opposer’s witness were either dead registrations or dead applications, a few did not even contain the word “vibe” at all, as noted by the objection of Opposer’s counsel at the deposition, and the list is without regard to goods and services. (See Gibbs Dep. 77-84; Gibbs Dep. Ex. 4).

Applicant also attempts to show that “VIBE” is weak and generic by listing three registrations and four applications using the word “VIBE” in connection with pre-recorded audio. (App. Main Br. at 12). Again, this is improper and inadmissible pursuant to TBMP §

³ The VIBE Mark has been continuously used on the following urban music-related goods and services: audio and video recordings featuring music (Gibbs Dep. 56; Gibbs Dep. Ex. FF); pre-recorded audio compilations in the urban music genre (Gibbs Dep. 11-24; Gibbs Dep. Exs. D through J); one of the leading urban music magazines in the United States (Gibbs Dep 7-8; Gibbs Dep. Ex. Y); a nationally televised music awards show (Gibbs Dep. 37-39, 55; Gibbs Dep. Ex. EE); an urban music seminar (Gibbs Dep. 19-20); a syndicated television show featuring music videos and musical artists (Gibbs Dep. 10, 40); books featuring urban music personalities and culture (Gibbs Dep. 29-36; Exs. O through R); mobile audio and video content (Gibbs Dep. 11-12, 42, 48); and a website that is one of the most visited websites in the urban music space (Gibbs Dep. 43, 53; Ex. CC).

704.03(b)(1)(B). In any event, however, the probative value of such third party registrations is limited, “particularly when the issue to be determined is likelihood of confusion, and there is no evidence of actual use of the mark shown in registration.” TBMP § 704.03(b)(1)(B). These third party registrations are totally devoid of evidentiary value because such registrations do not establish that the marks shown therein are in use, or that the public is familiar with them. See Olde Tyme Foods, Inc. v. Roundy’s Inc., 961 F.2d 200, 22 U.S.P.Q.2d 1542, 1545 (Fed. Cir. 1992); Helene Curtis Industries Inc. v. Suave Shoe Corp., 13 U.S.P.Q.2d 1618 (Trademark Tr. & App. Bd. 1989); Smith Bros. Mfg. Co. v. Stone Mfg. Co., 476 F.2d 1004 (C.C.P.A. 1973) (“The purchasing public is not aware of registrations reposing in the Patent Office and though they are relevant, in themselves they have little evidentiary value on the issue before us.”). Applicant has not introduced evidence that these third party marks “were actually used by third parties, that they were well promoted, or that they were recognized by consumers.” Scarves by Vera, Inc. v. Todo Imports, Ltd., 544 F.2d 1167 (2d Cir. 1976). The mere citation of third party registrations is not proof of third party uses for the purpose of showing a crowded field and relative weakness. Third party registrations themselves are not evidence of use “so as to have conditioned the mind of prospective purchasers.” San Fernando Electric Mfg. Co. v. JFD Electronics Components Corp., 565 F.2d 683 (C.C.P.A. 1977). Contrary to Applicant’s argument that there is extensive use of VIBE for prerecorded audio (App. Main Br. at 13), there is no *actual evidence* before the Board of any use by any third party of any mark including the word “VIBE” for the same or related goods or services.

Moreover, the four third party applications listed by Applicant carry no weight as it is evidence only that the application was filed on a particular date. TBMP § 704.03(b)(2); Glamorene Products Corporation v. Earl Grissmer Company, Inc., 203 U.S.P.Q. 1090, 1092 n.5 (evidence only of the filing of the application).

So even if Applicant's "list" were admissible (which it is not), it does not, as Applicant claims, demonstrate the weakness of the VIBE mark. Merely introducing a list of third party uses alone is not particularly persuasive. The existence of these registrations or applications is not evidence of what happens in the market place or that customers are familiar with their use. Therefore, in the absence of proof of use and effect on the public mind, third party registrations or applications can have no impact on the issues of strength or likelihood of confusion.

On the other hand, Opposer has offered persuasive evidence that "VIBE" is the distinct and dominant portion of Applicant's RAWVIBE Mark. Opposer's President carefully set forth the public's strong association with the VIBE Mark in connection with a wide variety of goods and services relating to urban music, including pre-recorded audio.⁴ Importantly, the slight differences between Applicant's RAWVIBE mark and each of Opposer's various VIBE Marks may not be recalled by purchasers seeing the marks at separate times.⁵ Consumers will more likely than not remember the distinctive "VIBE" portion of the Applicant's Mark, which is identical to Opposer's Mark. Thus, confusion as to the source of the respective marks will occur.

⁴ Opposer's President testified that the VIBE Mark is used on the following urban music-related goods and services: audio and video recordings featuring music (Gibbs Dep. 56; Gibbs Dep. Ex. FF); pre-recorded audio compilations in the urban music genre (Gibbs Dep. 11-24; Gibbs Dep. Exs. D through J); one of the leading urban music magazines in the United States (Gibbs Dep. 7-8; Gibbs Dep. Ex. Y); a nationally televised music awards show (Gibbs Dep. 37-39, 55; Gibbs Dep. Ex. EE); an urban music seminar (Gibbs Dep. 19-20); a syndicated television show featuring music videos and musical artists (Gibbs Dep. 10, 40); books featuring urban music personalities and culture (Gibbs Dep. 29-36; Exs. O through R); mobile audio and video content (Gibbs Dep. 11-12, 42, 48); and a website that is one of the most visited websites in the urban music space (Gibbs Dep. 43, 53; Ex. CC).

⁵ The proper test in determining likelihood of confusion is not on a side-by-side comparison of the marks, but rather must be on the recollection of the average purchaser, who normally retains a general rather than a specific impression of the many trademarks encountered. In other words, a purchaser's fallibility of memory over a period of time must also be kept in mind. See Grandpa Pidgeon's of Missouri, Inc. v. Borgsmiller, 477 F.2d 586 (C.C.P.A. 1973); Spoon's Restaurants Inc. v. Morrison, Inc., 23 U.S.P.Q.2d 1735 (Trademark Tr. & App. Bd. 1991).

In sum, by adding the descriptive “RAW” to the distinctive and dominant “VIBE” portion of the mark, Applicant has misappropriated Opposer’s Mark. This misappropriation of the entire, identical VIBE Mark leads to confusing similarity between Applicant’s and Opposer’s marks.

B. Because of the Similarity of the Goods and Services, Consumers Will Be Confused as to the Source of Applicant’s Goods.

As discussed in Opposer’s Main Brief, in addition to the similarity of the RAWVIBE and VIBE Marks themselves, the goods and services offered under each mark are both identical and closely related. Their contemporaneous use, on and in connection with the same and closely related goods and services, would be likely to cause confusion as to the source or sponsorship of such goods. DuPont, 476 F.2d at 1361. For likelihood of confusion to occur, the goods and services only need to be related in some manner, or their conditions surrounding marketing be such, that they could be encountered by the same purchasers under circumstances that could, because of similarity of the marks, give rise to the mistaken belief that the goods and services come from a common source or originate from the same producer. See In re Martin’s Famous Pastry Shoppe, Inc., 748 F.2d 1565, 1567 (Fed. Cir. 1984).

Applicant purports to use the RAWVIBE Mark in connection with hip-hop and R&B music, including the creation and distribution of compact discs. (App. Main Br. at 3; see also Serial No. 78/254,486). These goods are exactly the same as the numerous urban music compilations offered by Opposer under the VIBE Mark. (Gibbs Dep. 11-19, 21-24, 28; Gibbs Dep. Ex. D (“VIBE Hits” compilation); Gibbs Dep. Ex. E (VIBE music compilation for Academix); Gibbs Dep. Ex. F (VIBE music compilation for Twix); Gibbs Dep. Ex. G (VIBE music compilation for Motown Records entitled “VIBEology”); Gibbs Dep. Ex. H (VIBE music compilation for Diesel); Gibbs Dep. Ex. I (Vibe Holiday 2004 music compilation); Gibbs Dep.

Ex. J (VIBE music compilation for Jam Hair Care); and Gibbs Dep. Ex. M (VIBE “mix tape” music compilation)). Additionally, Opposer, through a licensee,⁶ operates a record label under the VIBE RECORDS mark that distributes pre-recorded audio and audio-visual performances in all genres of music. (Gibbs Dep. 56; Gibbs Dep. Ex. FF).⁷ Again, the goods offered under the VIBE RECORDS Mark are exactly the same as the goods purportedly offered under the RAWVIBE Mark.

The evidence also establishes that, not only does Opposer distribute identical goods under the VIBE and VIBE RECORDS Marks, Opposer’s other urban music goods and services are closely related to Applicant’s goods. See In re Martin’s Famous Pastry Shoppe, Inc., 748 F.2d at 1567; Recot, Inc. v. Becton, 214 F.3d 1322, 1329 (Fed. Cir. 2000) (“Even if the goods in question are different from, thus not related to, one another in kind, the same goods can be related in the mind of the consuming public as to the origin of the goods.”).⁸ For example, Opposer has been using its VIBE Mark on various music related goods and services for a number of years. Such goods and services include: one of the leading urban music magazines in the United States (Gibbs Dep 7-8; Gibbs Dep. Ex. Y); a nationally televised music awards show

⁶ A licensee’s use inures to the benefit of an opposer. See Compuclean Marketing and Design v. Berkshire Products, Inc., 1 U.S.P.Q.2d 1323, 1325 (TTAB 1986).

⁷ Applicant argues that the VIBE RECORDS Mark is easily distinguishable from the RAWVIBE Mark because VIBE RECORDS is “highly stylized design.” (App. Main Br. at 14). However, words in a mark as well as the design must be considered when assessing a likelihood of confusion. As stated previously, the proper test in determining likelihood of confusion is not on a side-by-side comparison of the marks, but rather must be on the recollection of the average purchaser, who normally retains a general rather than a specific impression of the many trademarks encountered; in other words, a purchaser’s fallibility of memory over a period of time must also be kept in mind. See Grandpa Pidgeon’s of Missouri, Inc., 477 F.2d at 586; Spoon’s Restaurants Inc., 23 U.S.P.Q.2d at 1735. Importantly, when spoken, the design feature of Opposer’s VIBE RECORDS mark is not seen by the purchasers, and such potential purchasers are more likely to only remember the “VIBE” portion of the Mark.

⁸ In Recot, the goods in question - human snack food and pet food - were completely unrelated and marketed to different consumers, yet were compared for likelihood of confusion of the marks.

(Gibbs Dep. 37-39, 55; Gibbs Dep. Ex. EE); an urban music seminar (Gibbs Dep. 19-20); a syndicated television show featuring music videos and musical artists (Gibbs Dep. 10, 40); books featuring urban music personalities and culture (Gibbs Dep. 29-36; Exs. O through R); mobile audio and video content (Gibbs Dep. 11-12, 42, 48); and a website that is one of the most visited websites in the urban music space (Gibbs Dep. 43, 53; Ex. CC).

The VIBE Mark has always been associated with urban music and has achieved widespread recognition in that field. For close to fifteen years, Opposer has used the VIBE Mark in connection with a wide variety of goods and services in the genres of hip-hop and R&B music (Gibbs Dep. 5-7), including the identical goods offered by Applicant. Indeed, Opposer is such an authority on the hip-hop genre of music that it published books under the VIBE mark entitled *The Vibe History of Hip-Hop* and *Vibe Hip-Hop Divas* (Gibbs Dep. 33-34; Gibbs Dep. Exs. O and P). Since both Applicant's and Opposer's marks are used for goods and services in the urban music genre and are targeted to the same market of purchasers (see Gibbs Dep. 7, 9, 14, 19-21, 29, 38, 40, 43; Toney Dep. 5, 11; App. Br. at 3), confusion as to the source of these goods and services is likely to occur, as a consumer may reasonably ask whether Opposer might be the source of RAWVIBE pre-recorded audio in the urban music field.

C. Opposer's Strong and Famous VIBE Mark Has Been Used Continuously and Stringently Enforced for Close to Fifteen Years.

Opposer's VIBE Mark has been used for goods and services in the urban music field for close to fifteen years, demonstrating the strength and fame of VIBE Mark in this field. (See Gibbs Dep. 5-7). As noted in the testimonial deposition of Opposer's witness, there is ample evidence of the strength and fame of the VIBE Mark.⁹ Applicant ignores this evidence and

⁹ As previously noted, the VIBE Mark is used on the following urban music-related goods and services: audio and video recordings featuring music (Gibbs Dep. 56; Gibbs Dep. Ex. FF); pre-recorded audio compilations in the urban music genre (Gibbs Dep. 11-24; Gibbs Dep. Exs. D through J); one of the

attempts to argue that the Mark is weak or generic (i.e., something that does not function as a source identifier at all). (App. Main Br. at 12, 18-20). This argument is absurd, as Opposer is the established source for urban music goods and services bearing the VIBE Mark. Applicant asserts that the VIBE Mark is further weakened by the fact that Opposer does not enforce its trademark rights in the Mark. (App. Main Br. at 19). Such a contention could not be further from the truth, as Opposer “vigorously” defends its trademark rights.

As set forth above in Section III.B., the use of the VIBE Mark on a wide variety of goods and services reflects and emphasizes the strength of the Mark. See Kenner Parker Toys, Inc. v. Rose Art Industries, Inc., 22 U.S.P.Q. 2d 1453, 1458 (Fed. Cir. 1992) (“use of a mark on a wide variety of products is reflective of and emphasizes the mark’s strength.”). The variety of the goods and services offered under the VIBE Mark include such goods and services as: audio and video recordings featuring music (Gibbs Dep. 56; Gibbs Dep. Ex. FF); pre-recorded audio compilations in the urban music genre (Gibbs Dep. 11-24; Gibbs Dep. Exs. D through J); one of the leading urban music magazines in the United States (Gibbs Dep 7-8; Gibbs Dep. Ex. Y); a nationally televised music awards show (Gibbs Dep. 37-39, 55; Gibbs Dep. Ex. EE); and an urban music seminar (Gibbs Dep. 19-20). A mark with extensive public recognition for a variety of goods and services, such as VIBE, deserves legal protection.

Moreover, Opposer’s ownership of five incontestable registrations consisting solely or primarily of the word VIBE is undisputed. 15 U.S.C. § 1065. These registrations include: VIBE RECORDS for goods in International Class 9 (Reg. No. 1,819,799; Gibbs Dep. Ex. FF); VIBE

leading urban music magazines in the United States (Gibbs Dep 7-8; Gibbs Dep. Ex. Y); a nationally televised music awards show (Gibbs Dep. 37-39, 55; Gibbs Dep. Ex. EE); an urban music seminar (Gibbs Dep. 19-20); a syndicated television show featuring music videos and musical artists (Gibbs Dep. 10, 40); books featuring urban music personalities and culture (Gibbs Dep. 29-36; Exs. O through R); mobile audio and video content (Gibbs Dep. 11-12, 42, 48); and a website that is one of the most visited websites in the urban music space (Gibbs Dep. 43, 53; Ex. CC).

for goods in International Class 16 (Reg. No. 1,800,105; Gibbs Dep. Ex. Y); VIBE for goods in International Class 16 (Reg. No. 2,144,655; Gibbs Dep. Ex. AA); and VIBE for services in International Classes 41 and 42 (Reg. No. 2,303,664; Gibbs Dep. Ex. CC). The incontestability of these numerous registrations demonstrates the strength of the VIBE Mark. Not only do these incontestable registrations demonstrate strength, but Opposer also possesses strong common law rights in the VIBE Mark for goods and services in the urban music field, including the numerous books published under the VIBE Mark featuring urban music personalities and the nationally televised *Weekend Vibe*, which is a weekly program featuring musical artists and videos. (Gibbs Dep. 29-36, 40)

Applicant also contends that the evidence presented does not establish the “high requirements for” fame under the DuPont likelihood of confusion analysis. (App. Main Br. 17). Opposer, however, is not arguing that VIBE is famous for all purposes, including completely unrelated goods. The VIBE Mark, however, is famous in the field of urban music, and such fame should be considered when determining likelihood of confusion under DuPont.

Significantly, when reviewing the fame of the mark, it does not matter that the mark is not used on identical goods, as the Board must look at what fame the mark has achieved in the marketplace. See Recot, Inc., 214 F.3d at 1327 (Fed. Cir. 2000) (FRITO LAY achieved a high level of fame even though the goods at issue, human snack food and pet food, were completely unrelated); see also Toro Co. v. ToroHead Inc., 61 U.S.P.Q.2d 1164, 1170 (Trademark Tr. & App. Bd. 2001) (finding that TORO achieved public recognition and renown for lawn care products even though the opposition proceeding involved computer products). The urban music marketplace has recognized the fame of the VIBE Mark. For example, *VIBE* magazine, a leader in urban music coverage, has a stated and audited circulation of 850,000 (as of 2005) and generates \$70 million in revenue from advertising sales (as of 2005). (Gibbs. Dep. 7-8).

Additionally, the VIBE Awards, broadcast nationally since 2003, specifically focuses on urban music, and DVDs of this awards show featuring pre-recorded audio and audio-visual performances have been sold and distributed since 2003. (Gibbs Dep. 10, 37-39; Toney Dep. 16; Gibbs Dep. Exs. S and T). Applicant's testimonial witness himself knew of the VIBE Mark by "just being in hip-hop." (Toney Dep. 15). In fact, the general marketplace itself has acknowledged the fame of VIBE in the urban music field, as, for example, third party companies have sought out Opposer to brand urban music products such as music compilations in order to "piggyback off of the strong association between Vibe and urban music." (Gibbs Dep. 21; see Gibbs Dep. 11-24; Gibbs Dep. Exs. D through J).

In addition, and contrary to Applicant's contention (App. Main Br. at 14), Opposer has established a "family of marks" characterized by the distinctive term VIBE to promote the VIBE brand in the urban music field. See Blansett Pharmacal Co. v. Carmrick Laboratories, Inc., 25 U.S.P.Q.2d 1473, 1477 (Trademark Tr. & App. Bd. 1992). The evidence demonstrates that prior to Applicant's use of RAWVIBE, Opposer has marketed numerous goods and services together in such a manner to create among purchasers an association of common ownership based upon the family characteristic VIBE. Again, in the urban music field, Opposer has used the VIBE Mark for pre-recorded audio compilations in the urban music genre (Gibbs Dep. 11-24; Gibbs Dep. Exs. D through J),¹⁰ for the urban music magazine *Vibe* (Gibbs Dep 7-8; Gibbs Dep. Ex. Y), for the nationally televised VIBE Awards show (Gibbs Dep. 37-39, 55; Gibbs Dep. Ex. EE),

¹⁰ Applicant asserts that the pre-recorded music compilations were not released on the VIBE RECORDS label and were used to promote other companies. (App. Main Br. at 15). There is no requirement that any music compilation under the VIBE Mark must be released through the VIBE RECORDS label – Opposer produced such compilations to market the VIBE brand in general. Also, even if the compilations were created to help promote other brands, by having the VIBE Mark prominently appear on such compilations, Opposer was promoting itself and marketing its own brand in the urban music field.

for the VIBE Music Seminar (Gibbs Dep. 19-20), for the Weekend VIBE syndicated television show (Gibbs Dep. 10, 40), for numerous books about urban music personalities and culture (Gibbs Dep. 29-36; Exs. O through R), for the urban music website VIBE.com (Gibbs Dep. 43, 53; Ex. CC), for VIBE RECORDS (Gibbs Dep. 56; Gibbs Dep. Ex. FF), and for MOBILE VIBE's audio and video content (Gibbs Dep. 11-12, 42, 48). All of these goods and services were promoted under the VIBE brand in the field of urban music.

Finally, Opposer has vigorously enforced the VIBE Mark since the Mark's inception. (Gibbs Dep. 60, 64-65, 69). In many cases, Opposer has taken affirmative steps to defend its marks. (*Id.* at 65). In its Main Brief, Applicant blatantly mischaracterizes Opposer's Testimonial Witness' testimony in an attempt to show that Opposer does not enforce or police its Mark. (App. Main Br. at 19). This is far from the truth, as Opposer's Testimonial Witness stated that Opposer "vigorously" defends the VIBE Mark and has pursued many third party uses after consultation with legal counsel. (Gibbs Dep. 60, 63-65, 69). Regardless, it is not necessary for a trademark owner to object to all unauthorized uses that might conflict; a trademark owner is not required to act against every infringing use no matter how inconsequential a risk of losing rights in the mark. See Elizabeth Taylor Cosmetics Co. v. Annick Goutal, S.A.R.L., 673 F. Supp. 1238 (S.D.N.Y. 1987). Although Opposer cannot defend every single infringement of the VIBE Mark, and in fact is not required to do so, Opposer indeed has enforced and defended the VIBE Mark in numerous situations. (Gibbs Dep. 65, 72). By enforcing its rights in the VIBE Mark, Opposer maintains the strength and fame associated with such Mark.

Opposer has used its VIBE mark continuously and without interruption since 1992 in connection with a wide variety of goods and services, achieving strength and fame in the urban music field. Strong and famous marks enjoy a wide latitude of legal protection. See Recot, Inc.,

214 F.3d at 1327. Therefore, the strength and fame of the VIBE Mark should be protected from the confusion similarity of Applicant's RAWVIBE Mark, and the opposition sustained.

IV APPLICANT HAS MADE NO BONA FIDE USE OF THE RAWVIBE MARK IN COMMERCE

As the foregoing demonstrates, there is confusing similarity between Applicant's RAWVIBE Mark and Opposer's VIBE Mark. Even assuming *arguendo* that no likelihood of confusion will occur, Applicant has made no bona fide use of the RAWVIBE Mark in commerce prior to the filing of its application, and therefore the application filed under Section 1(a) of the Lanham Act for RAWVIBE is void *ab initio*.

A. Applicant's Token Use of the RAWVIBE Mark Does Not Establish a Use in Commerce Under the Lanham Act

Under questioning from Applicant's attorney, Applicant's testimonial witness admitted that Applicant has only distributed one product to date – a pre-recorded audio CD entitled *Dramacydle* that was intended for promotional use. (Toney Dep. 6, 12; Toney Dep. Ex. 9). Only five of the *Dramacydle* CDs have been sold in commerce, all of which were in Japan. (*Id.* at 11-12). Applicant's testimonial witness again admitted during cross-examination by Opposer's counsel that the *Dramacydle* CD was the only time Applicant has used the RAWVIBE name in connection with a commercial effort. (*Id.* at 27). Although Applicant, through its counsel, asserts that Applicant has commercially distributed a pre-recorded audio CD since Applicant's inception (App. Main Br. at 3), the testimony offered by Applicant's testimonial witness contradicts such assertion.¹¹ According to the testimony of Applicant's

¹¹ Moreover, in order to demonstrate the use of RAWVIBE in commerce since the inception of Applicant, Applicant attempts to offer the Specimen attached to Applicant's RAWVIBE application as evidence of such use. (App. Main Br. at 23). Such evidence, however, is not allowed unless properly identified and introduced into evidence as an exhibit during the period for the taking of testimony. 37 C.F.R. §

testimonial witness, the only commercial use of the RAWVIBE Mark was in connection with the five sales of the *Dramacydle* CD in Japan.

Applicant's token, *de minimis* use of the RAWVIBE Mark on pre-recorded audio and audio-visual products does not meet the standard of "bona fide use of a mark in the ordinary course of trade" that is required for use-based applications under the Lanham Act. 15 U.S.C. § 1127. Both the Board and the courts have found such "use" as not rising to the level of "use in commerce" for purposes of trademark registration. See Paramount Pictures Corp. v. White, 1994 WL 484936, 31 U.S.P.Q.2d 1768 (Trademark Tr. & App. Bd. 1994); Harod v. Sage Products, Inc. 188 F. Supp. 2d 1369 (S.D. Ga. 2002); Momentum Luggage & Leisure Bags v. Jansport, Inc., 2001 WL 830667 at *4 (S.D.N.Y. July 23, 2001). Although Applicant plans to use the RAWVIBE Mark on pre-recorded audio in the future (Toney Dep. 10), such plans have no bearing on whether Applicant has made a bona fide use in commerce of the mark for its use-based application. There is no evidence that Applicant followed up on the five CD sales with active use of the RAWVIBE Mark that would allow consumers to associate RAWVIBE with pre-recorded audio goods. Therefore, Applicant has not made continuous and bona fide use of the RAWVIBE Mark in commerce, and the registration of such mark should fail.

2.122(b). While the application file may be before the Board during an opposition proceeding, the documents within the application file are not evidence in the proceeding. TBMP § 704.04. Allegations, such as a first use in commerce, must be established by competent evidence, and the proper introduction of the specimen was not done here. Id. Opposer never had the opportunity to question the authenticity of the specimen or whether it has been used or the extent of its use in commerce.

B. Opposer's Arguments Regarding Use in Commerce and False Statements Made By Applicant Are Properly Before the Board

Applicant argues that Opposer's arguments as to the use of RAWVIBE in commerce and the false statements made on the RAWVIBE application were untimely made. (App. Main Br. at 21, 23). However, as demonstrated by the line of questioning to Applicant's testimonial witness by Opposer's counsel, the date of use and scale of use of the RAWVIBE Mark on goods in commerce was clearly an issue before the parties. (Toney Dep. 16-27). Opposer was not able to include such contention in its Notice of Opposition because Opposer was not aware that Applicant's use of the RAWVIBE Mark was questionable at the time the Notice of Opposition was filed. Only upon receiving evidence during the testimony of Applicant's testimonial witness regarding such issues was Opposer able to make these arguments, which are properly before the Board as such arguments conform to the evidence.

C. Request Remand Under TBMP § 515

If the Board does not allow the new arguments as being implicitly raised, Opposer requests that the Board, in its decision in this proceeding, remand the application to the Examining Attorney pursuant to 37 C.F.R. § 2.131¹² in order for the Examining Attorney to assess both the actual date of first use of RAWVIBE and the use in commerce of RAWVIBE in connection with pre-recorded audio. TBMP § 515. During the testimonial period, facts have

¹² 37 C.F.R. § 2.131 states: "If, during an inter partes proceeding involving an application under section 1 or 44 of the Act, facts are disclosed which appear to render the mark unregistrable, but such matter has not been tried under the pleadings as filed by the parties or as they might be deemed to be amended under Rule 15(b) of the Federal Rules of Civil Procedure to conform to the evidence, the Trademark Trial and Appeal Board, in lieu of determining the matter in the decision on the proceeding, may remand the application to the trademark examining attorney for reexamination in the event the applicant ultimately prevails in the inter partes proceeding. Upon remand, the trademark examining attorney shall reexamine the application in the light of the reference by the Board. If, upon reexamination, the trademark examining attorney finally refuses registration to the applicant, an appeal may be taken as provided by §§ 2.141 and 2.142."

been disclosed that appear to render the mark of the involved application unregistrable,¹³ and the Examining Attorney should be apprised of these new facts before making the determination of registration.

V RESPONSE TO APPLICANT’S MOTION TO STRIKE AND OBJECTIONS TO EVIDENCE

Pursuant to TBMP § 539, Applicant attempts to strike portions of Opposer’s Main Brief in Support of Opposition. (App. Main Br. at 28). A motion to strike is not favored and matter will not be stricken unless it clearly has no bearing on the issues in the case. Leon Shaffer Golnick Advertising, Inc. v. William G. Pendill Marketing Co., Inc., 177 U.S.P.Q. 401 (Trademark Tr. & App. Bd. 1973). In using such an un-favored procedural device, Applicant attempts to eliminate Opposer’s factually-based legal arguments from this proceeding.

Applicant clearly misreads TBMP § 539, which states that “a party is entitled to offer in its brief on the case any argument it believes will be to its advantage.” TBMP § 539. Additionally, “the Board generally will not strike the brief, or any portion thereof, upon motion by an adverse party that simply objects to the contents thereof.” Id.

Contrary to Applicant’s assertions (App. Main Br. at 29-30), Opposer has made legal arguments in its Main Brief based on the testimony elicited by both parties’ testimonial witnesses, as well as the exhibits attached thereto. (See Opp. Main Brief at 3 through 13). Throughout the argument section of Opposer’s Main Brief, as well as this Reply Brief, Opposer cited to the evidentiary record for support. Applicant’s misguided attempt to undercut Opposer’s arguments by moving to strike portions of the brief should be denied.

¹³ The facts disclosed during the deposition of Applicant’s testimonial witness which appear to render the mark of the involved application unregistrable are discussed in Opposer’s Main Brief in Support of Opposition, pages 24 through 28.

Additionally, Applicant objects to applications cited by Opposer in Opposer's Main Brief. (App. Main Br. at 27-28). Regarding the MVIBE and MOBILE VIBE Marks, Opposer's testimonial witness properly testified as to the use of these marks in commerce, and therefore evidence of such use is properly before the Board, as Applicant was on notice of such marks. (Gibbs Dep. 11-12, 42, 48). Further, the VIBE ON THE STREETS and VIBE REVOLUTIONS Marks are relevant to the issues before the Board as these demonstrate line extensions of the VIBE Mark.

Moreover, Applicant objects to the citation of certain testimony elicited by Applicant's testimonial witness, as well as an exhibit introduced during such deposition. (App. Main Br. at 28). These objections are improper, as the testimonial evidence and exhibits introduced during such testimony speak for themselves. In addition, both pieces of evidence are relevant to the use in commerce of the RAWVIBE Mark on pre-recorded audio.

Applicant's motion to strike and objections to certain portions of the evidence should be denied.

VI CONCLUSION

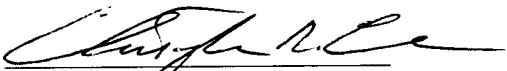
In light of the foregoing and the reasons stated in Opposer's Main Brief, the Opposition should be sustained and registration of RAWVIBE denied.

Dated: New York, New York
July 31, 2006

Respectfully Submitted,

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CERTIFICATE OF SERVICE

I hereby certify that a true and correct copy of the foregoing Opposer's Main Brief in Support of Opposition, dated July 31, 2006, was sent to the attorney for the Applicant at the address set forth below, by placing the same in a Federal Express Depository, postage pre-paid, this 31st day of July:

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