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

Proceeding	91162489
Party	Defendant RawVibe Entertainment, Inc. RawVibe Entertainment, Inc. 10040 Sheridan Street Suite 211 Pembroke Pines, FL 33024
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Attachments	Opposition Number 91162489 - Reply ISO Mt to Reopen Testimony Period.pdf (7 pages)(246814 bytes) Opposition Number 91162489 - HDD Reply Dec ISO Mt to Reopen Testimony Period.pdf (3 pages)(56076 bytes) Opposition Number 91162489 - Ex A to HDD Reply Dec.pdf (2 pages)(109204 bytes)

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

Applicant: RawVibe Entertainment, Inc.

Mark: 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,

Opposition No. 91162489

v.

RAWVIBE ENTERTAINMENT, INC.,

Applicant.

**RAWVIBE ENTERTAINMENT'S REPLY IN SUPPORT OF
MOTION TO REOPEN APPLICANT'S TESTIMONY PERIOD
IN LIGHT OF NEWLY DISCOVERED EVIDENCE AND OPPOSITION TO
OPPOSER'S MOTION TO SUBSTITUTE VIBE MEDIA GROUP**

I. INTRODUCTION.

Applicant RawVibe Entertainment Inc.'s ("Applicant") Motion to reopen Applicant's testimony period in light of newly discovered evidence should be granted. Indeed, although Opposer Vibe Ventures LLC ("Opposer") conceded that it assigned each of the marks asserted in

this proceeding, Opposer failed to address Applicant's need to evaluate whether – and the extent to which – Opposer's transfer of the marks asserted in this proceeding impacts these proceedings. The law is well established that a trademark by itself cannot be assigned in the absence of a transfer of the business or property with which it has been used. Opposer has not demonstrated that the transfer of its marks comports with this well established law. Accordingly, Applicant must be afforded an opportunity to determine precisely what aspects, if any, of Vibe Ventures' business were transferred when its marks were assigned to Vibe Media Group.

For example, since the basis for Opposer objecting to registration of the "RawVibe" mark is solely dependent on the alleged branding of the "Vibe" mark vis-à-vis Vibe Magazine, Applicant must have an opportunity to determine whether Vibe Magazine was transferred to Vibe Media Group, and, assuming that Vibe Magazine was transferred to Vibe Media Group (which Opposer has not established) how Vibe Media Group intends to use the Vibe mark in connection with Vibe Magazine.

Because Vibe has not established that it also transferred its business along with the assignment of its marks to Vibe Media Group, Applicant opposes Vibe's motion to substitute Vibe Media Group as Opposer in this action and respectfully requests that the TTAB grant Applicant's motion to reopen its testimony period, and deny Opposer's motion to substitute Vibe Media Group.

II. ANALYSIS.

A. Opposer Concedes That It Created New Evidence After The Closing Of Applicant's Testimonial Period.

Opposer does not dispute that it is no longer the owner of the marks asserted in this proceeding. *See* Opposition to Motion to Reopen Testimony at 3 ("Applicant is correct, on or about June 30, 2006, Opposer sold its assets to Vibe Media, and, as part of this sale, assigned all

its right, title and interest to its trademarks to Vibe Media.”). However, Opposer failed to address the disposition of Vibe Magazine – the good through which Opposer attributes fame of the “Vibe” mark in an effort to block the registration of Applicant’s “RawVibe” mark in this proceeding. The purported sale of Vibe Magazine is expressly at issue in Applicant’s Motion to Reopen Testimony. *See* Motion to Re-Open at 2 (“As the sale of Vibe Magazine . . . may affect these proceedings and whether Vibe Ventures LLC is entitled to seek the requested relief, Applicant respectfully requests that its testimony period be reopened so that it may explore this issue through further deposition (and corresponding production of documents relating to the sale of Vibe Magazine and the [e]ffect of such sale on the marks asserted by Opposer in these proceedings) of Vibe Ventures LLC, the Wicks Group, and/or Keith Glenn Media within 30-days of the Order on this Motion.”).

The information Applicant has been able to obtain publicly does not clarify this issue. *See e.g.*, Declaration of Shanée Y. Williams in Support of RawVibe Entertainment’s Motion to Reopen Applicant’s Testimony Period in Light of Newly Discovered Evidence (“Williams Decl.”), Exhs. C-D, F-G; *see also* Reply Declaration of Halimah D. DeLaine (“DeLaine Decl.”), Exh. A [June 30, 2006 Press Release from the Jordan Edmiston Group, Inc., which represented Opposer in the sale of Vibe Magazine (the “JEGI Press Release”)]. Indeed, if anything, the publicly available information has created more ambiguity as to whether Opposer or its assignee has standing in this Opposition proceeding. For example, although the JEGI Press Release addresses the sale of Vibe Magazine to the Wicks Group of Companies, LLC, and identifies certain principals of the Keith Glen Media Corporation as part of the management team for Vibe Magazine, the JEGI Press Release does not address the transfer of any marks owned or applied for by Opposer. Nor does the article mention Vibe Media Group, the assignee of Opposer’s marks.

The law is well established that:

A trade-mark is not by itself such property as can be transferred, and the right to use it cannot be assigned except as incidental to the transfer of the business or property in connection with which it has been used. A transfer of the right to use it in connection with a different article, or one of a different manufacture, would result in deceiving the public as to the article or its origin, which it is the sole legitimate purpose of a trade-mark to prevent, and a transferee will not be protected in such use by a court of equity.

MacMahan Parmacal Co. v. Denver Chemical Mfg. Co., 113 F. 468 (8th Cir. 1901); *see also* *Nettie Rosenstein, Inc. v. Princess Pat, Ltd.*, 42 C.C.P.A. 806, 817, 220 F.2d 444, 453 (C.C.P.A. 1955) (“a mark may not be legally transferred to another unless accompanied by the transfer of some business with which the mark is shown to have been used.”).

In light of this well established precedent, Opposer’s assertion that “there is no information to be gathered as a result of the sale by Opposer of its assets” is disingenuous. Indeed, there is potentially material information to be gathered as a result of the sale by Opposer of its assets. However, Opposer has failed and refused to provide Applicant with the entire agreement(s) disposing of Opposer’s assets. Applicant has not had an opportunity to analyze whether or the extent to which its interests are impacted by Opposer’s decision to sell Vibe Magazine during the pendency of these proceedings; nor can Applicant engage in such analysis as Opposer refuses to provide Applicant the information for Applicant’s consideration.

Accordingly, Applicant respectfully requests that its testimonial period be reopened for the purpose of introducing this newly discovered evidence regarding the sale of Vibe Magazine and assignment of related marks, the relationship (or lack thereof) of the entities to whom Opposer transferred its assets, and the impact of such transactions of these proceedings. As these matters were *not* at issue during Applicant’s testimony period and arise only because of Opposer’s disposition of assets after the close of the parties’ respective testimonial periods, the requested relief is warranted by the circumstances of this case. For the foregoing reasons,

Applicant will be unfairly prejudiced if the requested relief is not granted – an important factor that Opposer apparently concedes by its failure to address it in its Opposition to this Motion.

B. Opposer’s Cross-Motion To Substitute A Party Must Be Denied.

Opposer contends that its cross-motion to substitute Vibe Media Group, the assignee of the marks asserted by Opposer, as Opposer in this proceeding should be granted as a matter of course. See Cross-Motion to Substitute at 1. The relief requested by Opposer is based on its assumption that TBMP § 512.01 is an absolute right or entitlement for substitution in every instance where marks are assigned during the course of an Opposition proceeding. Opposer is incorrect. Indeed, TBMP § 512.01 by its own terms is a discretionary provision. *See* TBMP § 512.01. Moreover, it is settled law that “substitution . . . is not mandatory where a transfer of interest has occurred.” *See Sun-Maid Raisin Growers of California v. California Packing Corp.*, 273 F.2d 282 (9th Cir. 1959). Furthermore, substitution is not appropriate where it would create new relationships among parties to a suit. *See e.g. Citibank v. Grupo Cupey, Inc.*, 382 F.3d 29, 32 (1st Cir. 2004) (discussing Fed. R. Civ. P. 25(c), citations omitted).

Here, neither Applicant nor the TTAB can assess whether or the extent to which substitution of Vibe Media Group would create a new relationship among the parties because Opposer has refused to produce information concerning the relationships of the entities to whom its assets were transferred. The decision of whether to substitute a party is a discretionary decision made to facilitate the conduct of the proceedings. *See Maysonet-Robles v. Cabrero*, 323 F.3d 43, 49 (1st Cir. 2003). Opposer has not established that substitution of Vibe Media Group would facilitate the conduct of these proceedings. Indeed, given its refusal to respond to Applicant’s inquiries as to the disposition of Opposer’s assets – or to address the issue (which is clearly at issue as set forth in Applicant’s Notice of Motion) in Opposition to this Motion,

Applicant can only conclude that Opposer knows that such information is harmful to Opposer.

Applicant should have an opportunity to confirm whether its suspicion is correct.

III. CONCLUSION.

For the foregoing reasons, Applicant respectfully requests that the Board grant Applicant's Motion to reopen Applicant's testimony period and deny Opposer's motion to substitute Vibe Media Group.

Dated: August 16, 2006

/s/

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1117 California Avenue
Palo Alto, CA 94304
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Attorneys for Applicant,
RawVibe Entertainment, Inc.

CERTIFICATE OF SERVICE

I hereby certify that a true and correct copy of the foregoing documents have been duly served by mailing such copy via Federal Express, to Edward H. Rosenthal, Esq. and Jean Voutsinas, Esq. of Frankfurt Kurnit Klein & Selz, PC, 488 Madison Avenue, New York, NY 10022, on August 16, 2006.

**RAWVIBE ENTERTAINMENT'S REPLY IN SUPPORT OF MOTION TO
REOPEN APPLICANT'S TESTIMONY PERIOD IN LIGHT OF NEWLY
DISCOVERED EVIDENCE AND OPPOSITION TO OPPOSER'S MOTION TO
SUBSTITUTE VIBE MEDIA GROUP**

/s/ _____
Carol Skogstrom

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VIBE VENTURES LLC,

Opposer,

Opposition No. 91162489

v.

RAWVIBE ENTERTAINMENT, INC.,

Applicant.

**REPLY DECLARATION OF HALIMAH D. DELAINE IN SUPPORT OF RAWVIBE
ENTERTAINMENT'S MOTION TO REOPEN APPLICANT'S TESTIMONY PERIOD
IN LIGHT OF NEWLY DISCOVERED EVIDENCE AND OPPOSITION TO
OPPOSER'S MOTION TO SUBSTITUTE VIBE MEDIA GROUP**

I, Halimah D. DeLaine declare:

1. I am an attorney licensed to practice in all of the Courts of California and the Northern District of California, and am an associate with the law firm of Dechert LLP, counsel

for Applicant RawVibe Entertainment, Inc. This declaration is based on my personal knowledge and I could competently testify with respect to the matters stated herein.

2. Attached hereto as Exhibit A is a true and correct copy of a document I printed from www.jegi.com on August 16, 2006.

I declare under penalty of perjury under the laws of the United States of America that the foregoing is true and correct.

Executed this 16th day of August, 2006 in Palo Alto, California.

/s/

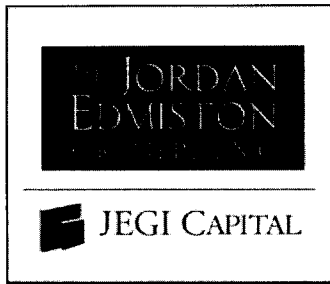
Halimah D. DeLaine

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**REPLY DECLARATION OF HALIMAH D. DELAINE IN SUPPORT OF
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GROUP**

/s/ _____
Carol Skogstrom



For Immediate Release

Contact: Adam Gross

Phone: 212-754-0710

Email: adamg@jegi.com

VIBE, the Country's Leading Urban Youth Lifestyle Magazine, Has Been Acquired by The Wicks Group

New York, NY June 30, 2006 – VIBE, the world's leading urban music and lifestyle magazine, was acquired by The Wicks Group of Companies, L.L.C., a New York-based private equity firm. Eric Gertler joins as CEO of the company, and Ari Horowitz has been appointed President. Danyel Smith has been named Editor-in-Chief of the magazine, and Len Burnett will continue as Group Publisher. The Jordan, Edmiston Group, Inc. (JEGI), the New-York based investment banking firm for the media and information industries, represented Vibe Ventures LLC, owner of VIBE, in this transaction.

The acquisition underscores management's commitment to extend the VIBE brand into multiple media platforms and distribution channels, while strengthening its unique position among its base of young multicultural consumers. As measured by circulation, VIBE is the leading urban entertainment magazine covering urban music and lifestyle. With circulation of approximately 850,000, the magazine reaches more than seven million readers per month.

Its current brand extension platforms include: *VIBE Vixen*, a magazine for trend-setting women whose love for urban music and culture inspires their choices in beauty, fashion and lifestyle; VIBE Online, the online site for VIBE Magazine; VIBE On Demand, a leading on-demand network for urban youth culture; VIBE on film; and MVibe, the wireless service that allows the VIBE community to interact with VIBE content via handheld devices. The VIBE brand extends into additional product and distribution channels, such as the VIBE CD and DVD series and television programming.

"The power of VIBE is its appeal to the diverse, trendsetting young style makers who enjoy and are passionate about urban music, fashion and culture," said Gertler. "We think there are tremendous growth and value-creation opportunities to leverage the brand across multiple media platforms, and we are excited to build upon the great relationship that VIBE has with its community."

Gertler has spent more than 15 years in a variety of senior management positions in the media industry, most notably serving as the President of the media group that published *U.S. News and World Report*, *Fast Company* and *The Atlantic Monthly*. He is currently a principal of Keith Glen Media Corporation, and most recently served as CEO of Blackbook Media Corporation.

Horowitz is currently a Principal of Keith Glen Media and previously served as President of BlackBook Media. "VIBE's strength is its ability to create content that appeals to a savvy group of style makers," said Horowitz. "VIBE is perfectly positioned to be one of the great brands of the 21st century, and I am excited to see us continue its expansion through multiple distribution channels."

A former Editor-at-Large for Time Inc., Smith joined VIBE in 1993 and was appointed music editor a year later. In 1996, she was awarded a National Arts Journalism Program fellowship and was appointed Editor-in-Chief upon her

return, serving until 1999. Burnett will remain as Group Publisher and will continue to be an integral part of the growth opportunity at VIBE. He rejoined VIBE in June 2005 after serving as a member of its founding staff.

Daniel Black, Partner of the Wicks Group, said, “We are very excited about this acquisition and the talent that we have assembled to help the business reach its potential. As the leading brand in the urban market, VIBE has all of the hallmarks of an outstanding media property, and this transaction creates a strong platform from which to address its growth potential. Combined with the talent and skills of our new management team, we think VIBE is well-positioned to become a leading media company with multiple revenue and growth opportunities.”

About The Wicks Group of Companies

The Wicks Group of Companies, L.L.C. (www.wicksgroup.com) is a New York based private equity firm that invests in selected segments of the communications, information and media industries. Wicks currently owns or has owned companies in educational publishing, consumer publishing, community newspapers, radio broadcasting, television broadcasting, magazine publishing, outdoor advertising, newsletter publishing, and cable television distribution.

About The Jordan, Edmiston Group, Inc.

Founded in 1987, JEGI (www.jegi.com) of New York, NY is recognized as a leading provider of investment banking services on middle-market transactions in the media and information industries. JEGI's client base comprises a wide array of media and information companies, including global US and international diversified conglomerates and entrepreneurial businesses. JEGI also maintains extensive relationships with private equity funds and lending institutions that invest in the media and information industries.

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