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

Proceeding	91168992
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In The Matter of Application Serial No. 78/559,273
Filed on: February 2, 2005
For the Mark: KISS OR KILL
Published in the *Official Gazette (Trademarks)* on January 3, 2006

KISS CATALOG LTD.

Opposer,

v.

Opposition No. 91168992

JOHN ARAKAKI and COOPER MICHELE
GILLESPIE

Applicants.

MOTION FOR SUMMARY JUDGMENT AND
REQUEST TO SUSPEND PROCEEDINGS

Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451

Applicants, John Arakaki and Cooper Michele Gillespie hereby bring this Motion for Summary Judgment pursuant to Fed. R. Civ. P. 56 and TBMP Rule 528 et seq., and request that the Board suspend the proceedings as provided in 37 C.F.R. §2.127(d). In particular, Applicants submit that its pending KISS OR KILL mark does not so resemble Opposer's various KISS marks as to be likely to cause confusion, mistake or deception. Because there is no genuine issue of material fact to support Opposer's opposition against Applicants' KISS OR KILL application, the pending opposition should be dismissed as a matter of law, and the KISS OR KILL application passed to registration.

I. SUSPENSION OF PROCEEDINGS

According to 37 C.F.R. §2.127(d), “When any party files . . . a motion for summary judgment, or any other motion which is potentially dispositive of a proceeding, the case will be suspended by the Trademark Trial and Appeal Board with respect to all matters not germane to the motion and no party should file any paper which is not germane to the motion except as otherwise specified in the Board's suspension order.” Accordingly, Applicants request suspension of the current opposition proceedings as of the date on which Applicants’ present summary judgment motion is filed, pending disposition of this motion.

II. SUMMARY JUDGMENT STANDARD

Summary judgment “shall be rendered forthwith if the pleadings, depositions, answers to interrogatories, and admissions on file, together with the affidavits, if any, show that there is no genuine issue as to any material fact and that the moving party is entitled to a judgment as a matter of law.” Fed. R. Civ. P. 56(c). “The motion for summary judgment is a pretrial device, intended to save the time and expense of a full trial when a party is able to demonstrate, prior to trial, that there is no genuine issue of material fact, and that it is entitled to judgment as a matter of law.” TBMP 528.02. When considering a motion for summary judgment, the evidence of the non-movant is to be believed, and all justifiable inferences are to be drawn in its favor.

Anderson v. Liberty Lobby, Inc., 477 US 242, 248 (1986). A factual dispute is “genuine” only if, on the evidence of record, a reasonable fact finder could resolve the matter in favor of the nonmoving party. *Id.* See also *Octocom Systems Inc. v. Houston Computer Services Inc.*, 918

F.2d 937, 941 (Fed. Cir. 1990) (to establish the existence of disputed facts, the nonmoving party “must point to an evidentiary conflict created on the record at least by a counter statement of a fact or facts set forth in detail in an affidavit by a knowledgeable affiant.”).

Summary judgment is as appropriate in a trademark opposition proceeding as in any other type of action. *See e.g., id.* at 944 (affirming TTAB’s grant of summary judgment with respect to likelihood of confusion in opposition proceeding); *Pure Gold, Inc. v. Syntex (U.S.A.), Inc.*, 739 F.2d 624, 628 (Fed Cir. 1984) (affirming TTAB’s grant of summary judgment in an opposition proceeding). “The question of likelihood of confusion has been held by the U.S. Court of Appeals for the Federal Circuit to be one of law and unquestionably may be resolved by way of summary judgment under appropriate circumstances.” *Turner Entertainment Co. v. Nelson*, 38 USPQ2d 1942, 1996 WL 335214, *2 (TTAB 1996).

“The basic purpose of summary judgment procedure is one of judicial economy to save the time and expense of a full trial when it is unnecessary because the essential facts necessary to decision of the issue can be adequately developed by less costly procedures . . . with a net benefit to society.” *See Exxon Corp. v. National Foodline Corp.*, 579 F.2d 1244, 1246 (C.C.P.A. 1978). So although summary judgment motions should be granted cautiously, it is entirely proper where, as here, there are no genuine issues of material fact remaining for trial. *Id.* In *Pure Gold, Inc.*, 739 F.2s at 627, n.2, the Court encouraged the disposition of matters before the TTAB by summary judgment as follows:

The practice of the U.S. Claims Court and of the former U.S. Court of Claims in routinely disposing of numerous cases on the basis of cross-motions for summary judgment has much to commend it. The adoption of similar practice is to be encouraged in *inter partes* cases before the Trademark Trial and Appeal Board, which seem particularly suitable to this type of disposition. Too often we see

voluminous records which would be appropriate to an infringement or unfair competition suit but are wholly unnecessary to resolution of the issue of registrability of a mark.

Because the undisputed facts demonstrate there is no likelihood of confusion between Opposer's marks and Applicants' KISS OR KILL mark, the present opposition should be dismissed as a matter of law, and Applicant's pending application to register KISS OR KILL passed to registration.

III. ARGUMENT

In 2003, Applicants, John Arakaki and Cooper Michele Gillespie ("Applicants"), began organizing monthly performances at various live venues in Los Angeles, California featuring several "DIY" pop/punk rock bands. *See* Declaration of John Arakai (attached hereto as Exhibit A), ¶2; *see also* History of KISS OR KILL from Applicants' website (attached hereto as Exhibit B). These monthly events became known as KISS OR KILL club nights. *Id.* Shortly thereafter, because the demand for these KISS OR KILL events increased, they began to occur on a weekly basis. *See* Exh. A at ¶3; Exh. B.

Importantly, KISS OR KILL is *not* the name of a musical band or group. *See* Exh. A at ¶4; Exh. B. Rather, under the KISS OR KILL name, Applicants organize musical shows and events featuring performances by multiple different musical groups, bands and/or musicians. *Id.* In fact, KISS OR KILL is often referred to as a "club." *Id.*

On the other hand, Opposer KISS Catalog Ltd. ("Opposer") has alleged that it is the owner of the intellectual property rights, including trademark rights, pertaining to a particular musical group called KISS, and that it has been engaged in the production of musical

entertainment services in connection with the KISS musical group, and the likenesses of the band members. *See* Notice of Opposition at ¶1. In particular, Opposer has alleged that it is the owner of the following trademark registrations (collectively referred to as the “KISS Registrations”):

Mark	Reg. No.	Goods & Services
KISS (Stylized)	1,055,765	Musical entertainment services rendered by a group
KISS (Stylized)	1,153,088	Comic books, photographs, posters, souvenirs books, greeting cards, decals, heat transfers, bumper stickers, and fan club kits comprising advertising brochures, certificates and souvenirs; cloth patches, buckles, ornamental badges and pins; jigsaw puzzles and paper toys.
KISS	1,155,932	Musical entertainment services rendered by a group
KISS (Stylized)	1,894,876	Series of prerecorded video tapes featuring musical performances; men’s, women’s and children’s shirts and caps.
KISS ARMY	2,163,803	Clothing goods, namely, shirts, jackets, caps and T-shirts; entertainment services in the nature of live performances by a musical entertainment group.
KISS KONFIDENTIAL (REGISTRATION CANCELLED)	1,916,210	Prerecorded audio and video tapes, phonograph records and compact discs featuring musical performances.
KISS PSYCHO CIRCUS	2,237,588	Men's, women's and children's shirts and caps; entertainment services in the nature of live musical concerts by a group combined with circus acts.
KISSNATION	2,106,028	Comic books.
KISSTORY (Stylized)	2,137,991	Books relating to a musical group.
KISS CONVENTION	1,989,361	Musical entertainment services rendered by a group
KISS CONVENTION (REGISTRATION CANCELLED)	2,050,016	Souvenir books, posters, and magazines featuring articles and stories about a musical group.

The distinctions between Applicants’ services and many of the goods and services identified in connection with the KISS Registrations are significant, and prevent any likelihood

of confusion. Moreover, Applicants' KISS OR KILL mark is different in sight, sound and meaning from any of the KISS Registrations. KISS OR KILL is made up of three words and syllables, which clearly distinguishes this mark from Opposer's primary KISS mark. And although both marks contain the term "kiss," KISS is not the dominant portion of Applicants' mark. Rather, Applicants' KISS OR KILL mark is intended to suggest to the public that they can either love the music being performed, or hate it. *See* Exh. B. It gives the public a "one or the other" option or impression – *either kiss or kill* – neither one of which is dominant over the other.

Moreover, there are numerous other registered trademarks that use the word "kiss", as well as trademark applications for which a notice of allowance has been mailed, in connection with the entertainment industry alone. For example: HOLLYWOOD KISS (Reg. No. 2,426,970, for retail store services and mail order services featuring current and classic merchandise and collectible items relating to notable entertainment, musical and other celebrity personalities); PLACES TO KISS (Reg. No. 2,621,885, for promoting, advertising and marketing of dining, travel and entertainment products, services and establishments of others); FIRST KISS PRODUCTIONS (Reg. No. 2,352,991 for entertainment services in the nature of film and video production); TRUE KISS DESTINATIONS (Reg. No. 2,568,834 for Phonograph records and audio tapes featuring music and entertainment); LEMON KISS (Ser. No. 78/562,713 for entertainment services in the nature of providing online interactive computer and video games, screen savers, and audio visual content in the nature of news, entertainment, and culture via a global communications network; KISS THE FROG (Ser. No. 78/471,161 for production and distribution of motion pictures and television programs for others; production of home

entertainment, namely, videotapes, video cassettes, video discs, video games and computer games; VHI KISS OR DISS (Ser. No. 78/447,505 for entertainment services in the nature of an on-going television series featuring reviews of entertainment and popular culture; providing online information in the field of entertainment concerning entertainment and popular culture); and KISS OFF (Ser. No. 76/520,740 for entertainment services, namely conducting contests on radio stations and in retail stores).

Because consumers are accustomed to distinguishing between entertainment-related marks using the word “KISS,” there is very little possibility, let alone a likelihood, that they would be confused by Applicants’ use of the mark KISS OR KILL. It is further particularly noteworthy that the U.S. Patent and Trademark Office passed Applicants’ KISS OR KILL trademark application to publication without citing even one the KISS Registrations.

Given the distinctions between Applicants’ and Opposer’s respective services and/or goods, the differences in sight, sound and meaning of the respective marks, and the abundance of other “KISS” marks used in the entertainment industry, there clearly is no likelihood of confusion between Applicants’ KISS AND KILL mark and the KISS Registrations.

IV. Conclusion

The facts are simple, clear and fit squarely within the cited statutes and case law. There are no genuine issues of material fact to be tried, and in view of the clear lack of likelihood of confusion, summary judgment is particularly appropriate. Applicants respectfully request that the Board grant the present motion in all respects.

Respectfully submitted,

ATTORNEY FOR APPLICANTS

Dated: September 26, 2006



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

In The Matter of Application Serial No. 78/559,273
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KISS CATALOG LTD.

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JOHN ARAKAKI and COOPER MICHELE
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Applicants.

Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451

**DECLARATION OF JOHN ARAKAKI IN SUPPORT OF
APPLICANTS' MOTION FOR SUMMARY JUDGMENT**

I, John Arakaki, declare as follows:

1. I am one of the co-owners of U.S. Trademark Application No. 78/559,273 for the mark KISS OR KILL in connection with organizing musical shows and events featuring performances by multiple different musical groups, bands and/or musicians, and providing a website featuring musical performances, musical videos, related film clips, photographs, and other multimedia materials.

2. In 2003, Cooper Michele Gillespie and I began organizing monthly performances at various live venues in Los Angeles, California featuring several "DIY" pop/punk rock bands. These monthly events became known as KISS OR KILL club nights.

3. Soon after beginning our monthly KISS OR KILL club nights, the demand for these KISS OR KILL events increased, so they began to occur on a weekly basis.

4. KISS OR KILL is *not* the name of a musical band or group. Rather, under the KISS OR KILL name, Mr. Gillespie and I organize musical shows and events featuring performances by multiple different musical groups, bands and/or musicians. In fact, KISS OR KILL is often referred to as a "club."

I declare under penalty of perjury that the foregoing is true and correct. Executed this 25th day of September 2006 at Los Angeles, California.

John Arakaki

A handwritten signature in black ink, appearing to be 'JA', written over a horizontal line.

KISS OR KILL

HOME • ABOUT • BOARD • PICS • THE MOVIE • LINKS •
 BOOKING • BUY KISS OR KILL STUFF • CONTACT

KISS OR KILL: ONE COMMUNITY'S UNIQUE ROCK 'N' ROLL VISION

Dedicated to Los Angeles' DIY/indie music scene, The Los Angeles Times has described the Kiss or Kill Club as the "place where old schoolers can punk out" to "harmonic power pop hellraisers". Located at the The Key Club (on the first Friday of every month) and Safari Sam's (On the rest of the Friday's in the month), Kiss or Kill Club is a collective of like-minded musicians, artists and fans of music creating an invigorating music scene.

Originally a monthly event, demand for the night necessitated Kiss or Kill happen on a weekly basis. On September 2nd, 2003, Kiss or Kill became a weekly event every Tuesday at the Garage. Upon the closing of the Garage, Kiss or Kill found a new home in the Red Room at Zen Sushi in 2004, and moved to a larger stage at The Echo in 2005. The Club has continued to grow and has moved to Friday nights at The Key Club and Safari Sams. It's ALL AGES, starts at 8pm (Key Club) or 9pm (Safari Sam's), features 5 or 6 power-pop/punk rock bands, the cover is a mere \$3 before 10pm, drink specials abound and if you're too poor to afford alcohol the emcee, Rob Zylowski, carries a tequila filled squirt gun on him at all times.

"We wanted to create a community of talented artists and musicians who were interested in banding together and creating a new paradigm for a rock 'n' roll "club". All of the people involved with Kiss or Kill are truly about the sum of Kiss or Kill's parts. Everyone recognizes the strength we have gained through sticking together and helping one another", says Cooper (bassist for BANG sugar BANG).

John Arakaki (bassist for Silver Needle) adds,

"People know when they come to our shows they are going to see a great lineup of like-minded bands. No one will ever be bored at a Kiss or Kill show, The bands are just too darn good. Plus, the crowd's antics are always sure to entertain".

The night is aptly titled, "Kiss or Kill". Matt Southwell (guitarist for BANG sugar BANG) explains,

"We named the night "Kiss or Kill" because first, it's a great lyric in "We're Desperate" by X. When we started this night we were all completely desperate for a music scene in Hollywood where our style and attitude about music fit in. Second, the people who come to these shows have two choices. They can either totally get off on the music and the bands, or they can piss off. So far, the response has been overwhelmingly positive. All we wanted was to create an exceptional rock community and have a wild party with all our friends every Tuesday night. Basically, you can sit around and moan about how hard it is being different or you can take responsibility and create a community of artists, bands, etc. who feel just as you do. There's a lot more power in the latter option".

Currently the Kiss or Kill Club is ready to spread it's DIY message far beyond Los Angeles. The club is releasing it's second compilation CD this February. Also, Kiss or Kill bands have been touring the country together spreading the DIY message of Kiss or Kill. Considering the hard work and determination of Kiss or Kill's members, the future for all involved is sure to contain continued growth and success.

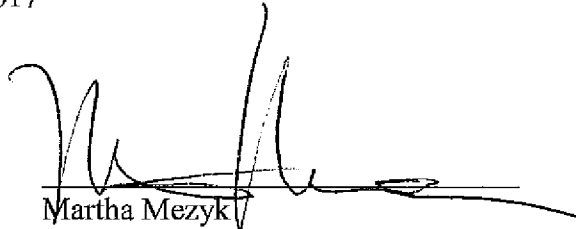
Exhibit B

CERTIFICATE OF SERVICE

It is hereby certified that a true copy of the foregoing **MOTION FOR SUMMARY JUDGMENT AND REQUEST TO SUSPEND PROCEEDINGS** was mailed, first class, postage prepaid this 26th day of September, 2006, to the following:

William H. Cox
Peter J. Vranum
Janvey, Gordon, Herlands, Randolph & Cox LLP
355 Lexington Ave.
New York, NY 10017

By

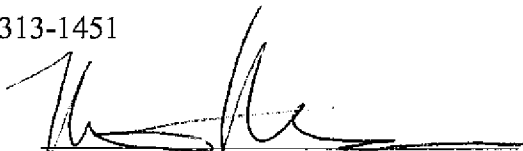

Martha Mezyk

CERTIFICATE OF MAILING

It is hereby certified that a true copy of the foregoing **MOTION FOR SUMMARY JUDGMENT AND REQUEST TO SUSPEND PROCEEDINGS** was filed electronically via ESTTA this 26th day of September, 2006, to the following:

Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451

By


Martha Mezyk