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

Proceeding no.	91249965
Party	Defendant Beata Music LLC
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UNITED STATES PATENT AND TRADEMARK OFFICE
TRADEMARK TRIAL AND APPEAL BOARD

In The Matter Of Trademark Application No. 87/803,534
Filed on February 20, 2018; Published: February 5, 2019
Mark: THE RASCALS

Dino Danelli and Edward Brigati, Opposer, v. Beata Music LLC, Applicant.	)	Opposition No. 91249965

APPLICANT'S RESPONSE TO THE BOARD'S ORDER OF JULY 26, 2023

In response to the board's order serves the following brief explanation of this cast excuses been extensively litigated and we had apologizes to extent that it's violence have assumed some knowledge of that litigation which it has lived with for several years. The basic facts of the case are laid out in the motion for summary judgment filed by Beata on the claims by Eddie Brigati opposer here no sparks are substantiated on the attached paper they're quoted below so that the board can understand the context of this matter.

From the Motion for Summary Judgment Motion:

The Rascals are a world-renowned music group inducted into the Rock n Roll Hall of Fame. CSF, ¶1. They released such hits as "Groovin'", "Good Lovin'", "It's a Beautiful Morning," and

"People Got to Be Free." CSF, ¶2. The Rascals were a four piece band, featuring Cavaliere on vocals and Hammond organ, Cornish on guitar and Danelli on drums. Eddie Brigati sang on some songs and played tambourine during the band's 1960s era. CSF, ¶3. Brigati quit the group in 1970. CSF, ¶4. He quit just as the Rascals were to sign a million dollar record deal with Columbia Records, which the Rascals signed anyway. CSF, ¶5. Cornish departed the group in 1971. At Columbia, the Rascals released their eighth and ninth studio albums with Cavaliere and Danelli only. CSF, ¶6. Cavaliere and Danelli toured extensively as the Rascals during 1971 – 1972. CSF, ¶7. Brigati never objected to Cavaliere and Danelli using the name the Rascals. CSF, ¶8. He testified at deposition that he was not following The Rascals' tours. CSF, ¶9**.**

1. **B. <u>The 1988 Reunion Tour and Subsequent Litigation.</u>**

In 1988, a Rascals reunion tour was produced by Cavaliere; they hired Cornish and Danelli to work as contractors. CSF, ¶10. It was billed as a Rascals "Reunion;" Brigati did not participate. The tour was successful, and Danelli and Cornish wished to continue, but Cavaliere refused. CSF, ¶11. Danelli and Cornish attempted to continue to play as the Rascals, but Cavaliere sent a cease and desist letter. CSF, ¶12. Danelli and Cornish filed suit for declaratory relief in 1989**.** CSF, ¶13..

That case settled in 1990 via a verbal stipulation ("the 1990 Settlement") before Hon. Louis Stanton, addressing only live touring. CSF, ¶14. The upshot is that Danelli and Cornish could use, subject to certain font size restrictions, "The New Rascals,

featuring Dino Danelli and Gene Cornish." Cavaliere could use "Felix Cavliere's Rascals" and any other names of individuals he may add to his band." CSF, ¶15.

Thereafter, Brigati filed a separate lawsuit in 1990, regarding rights to other Atlantic recordings and "assets." That case had nothing to do with touring or even the Columbia records sold as The Rascals. CSF, ¶16. The Settlement Agreement in that case deals with recordings and musical compositions and is discussed in detail below. It contains no integration clause and does not purport anywhere to replace the 1990 Settlement. CSF, ¶17. In 1988, the Rascals played at the 40th Anniversary of Atlantic Records. Brigati did not appear. CSF, ¶18. A DVD of their performance as the Rascals was released, and Brigati has never objected or claimed ownership rights. CSF, ¶19.

2. **C. <u>The 2000s and Once Upon A Dream.</u>**

Throughout the 1990s and 2000s, Cavaliere toured as Felix Cavaliere's Rascals. CSF, ¶20. In 2012, Renegade Productions approached the members for a Broadway musical called "The Rascals: Once Upon a Dream." CSF, ¶21. It told the story of the 1960's through music and video media. This was the first time since 1970 that the four members had toured together, thought it was not a Rascals reunion. CSF, ¶22. Each former member signed separate contracts, and Cavaliere was paid more. CSF, ¶23.

"Once Upon a Dream" was performed as a Broadway Musical in early 2013. The show was taken on the road, but became unprofitable, and Renegade Productions canceled the tour on November 29, 2013. CSF, ¶24.

3. **D. <u>The Attempted 2018 Reunion; Felix Cavaliere And Gene Cornish's Rascals.</u>**

After "Once Upon A Dream," Cavaliere hired manager Obi Steinman. CSF, ¶26. Following an emotional show in Hawaii 2017, Cavaliere decided to propose one last tour with the original group as "The Rascals." CSF, ¶27. Cavaliere called Brigati first. Brigati declined to participate. CSF, ¶28. Cornish agreed immediately. CSF, ¶29. Danelli agreed and later became unreasonable in his demands, eventually sending a cease and desist letter. CSF, ¶30.

In February, 2018, this suit was filed as a declaratory relief action seeking judicial construction of the 1990 Agreement and also allege a claim for dilution because Danelli was refusing to let the band tour. CSF, ¶31. Cavaliere continued to organize the tour. CSF, ¶32. Cavaliere and Cornish transferred any rights they had in the RASCALS mark for live performances into the touring company, Plaintiff Beata Music, LLC. CSF, ¶33.

Also in February, 2018, Beata filed an intent-to-use trademark application for THE RASCALS for live performances and related clothing (for the tour merchandising). Brigati and Danelli later filed an opposition in the TTAB, which is currently stayed. CSF, ¶34.

APA (the talent agency handling the tour) and Beata announced a press release to the public on March 13, 2018, that the tour would be "The Rascals featuring Felix Cavaliere and Gene Cornish with Special Guest Carmine Appice on Drums." CSF, ¶35. Lawyers for Danelli contacted the first venue to go on sale (Mountain Winery in

Saratoga, California), as well as Livenation and AEG (who own venues). CSF, ¶36.

A flurry of negotiations ensued, and the lawyer for Brigati and Danelli agreed that Cavaliere and Cornish could use "Felix Cavaliere and Gene Cornish's Rascals." CSF, ¶37.

For promotion, Beata's team developed promotional materials to be used by every promoter; there was no representation that Eddie Brigati or Dino Danelli would perform**.** CSF, ¶38. Venues received very specific instructions to use "Felix Cavaliere and Gene Cornish's Rascals" including font size and that it was not a Rascals reunion. CSF, ¶39.

The tour began, and, tragically, at the seventh show in Billings, Montana, Gene Cornish had a heart attack on stage during the second song and had to be revived. He would be out for nearly the rest of the tour, and many venues either canceled or requested reduced fees. Thus, the tour was not profitable. CSF, ¶40.

Based upon these, facts Judge Koeltl of the Southern District of New York granted summary judgment, finding, inter alia, that. Brigati's contract claims failed because he showed no damages and that he was not a party to the agreements from 1990 and 1992, nor was he a third party beneficiary.

The court specifically found he had not toured with the group for 20 years, and it found that there was no agreement regarding touring revenues .

The Court also found against Brigati on his trademark-related claims. The Court found he had abandoned his rights in live performances, and it foiund that Beata had shown abandonment by clear and convincing evidence. he court also found that Bugatti should know likelihood of confusion.

In a subsequent motion on Beata's affirmative rights, the Court found that neither Danelli nor Brigati had any rights in the mark.

Since the court since the court entered these motions fiada has performed cavalry and corners have performed As the rascals. Attached here too

Plaintiffs have toured extensively following that issue. As shown in the Declaration of Eric Bjorgum, Exhibit A, there have been multiple shows as "The Rascals." There has been no confusion or allegations of confusion. Thus, at the very least, Beata is establishing common law rights after the litigation.

Collateral Estoppel Also Applies.

It should be remembered that Brigati is the Opposer here. This Application has already moved to publication. Based on the Court's prior rulings, this Opposition should be dismissed, and the Application proceed to registration.

Collateral Estoppel applies to the this situation. As stated by the Board:

> Under the doctrine of collateral estoppel (also known as issue preclusion), once an issue is actually and necessarily determined by a court of competent jurisdiction, that determination is normally conclusive in a subsequent suit involving the parties to the prior litigation. International Order of Job's Daughters v. Lindeburg & Co., 727 F.2d 1087, 220 USPQ 1017 (Fed. Cir. 1984). The underlying rationale is that a party who has litigated an issue and lost should be bound by that decision and cannot demand that the issue be decided again.

Mother's Restaurant Incorporated v. Mama's Pizza, Inc., 723 F.2d 1566, 221 USPQ 394 (Fed. Cir. 1983).

Issue preclusion requires: 1) the issue to be determined must be identical to the issue involved in the prior litigation; 2) the issue must have been raised, litigated and actually adjudged in the prior action; 3) the

determination of the issue must have been necessary and essential to the resulting judgment; and 4) the party precluded must have been fully represented in the prior action. *Mother's Restaurant, supra*; *Polaroid Corp. v. C & E Vision Services Inc.*, 52 USPQ2d 1954 (TTAB 1999).

On January 6, 2021, the court moved Ordered summary judgment against Brigati on all of his claims, finding he had no rights in the name for live performance. The Court found he abandoned such rgiths. The court also found that Bugatti should no likelihood of confusion.

CONCLUSION

Based on the foregoing, Beata respectfully requests that the Board dismiss this opposition and that the matter proceed to registration.

Date: September 29, 2023

By: /Eric Bjorgum/ [electronic signature]
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I, Eric Bjorgum, declare the following:

1. I am an attorney with the firm of Karish & Bjorgum, the attorneys for Counter-Defendant BEATA MUSIC, LLC and Third Party Defendants Felix Cavaliere and Gene Cornish herein. I am admitted *pro hac vice* in this case. All facts contained herein are within my personal knowledge and, if called as a witness, I could and would competently testify thereto. This Declaration is made in support of Counter-Defendant BEATA MUSIC, LLC and Third Party Defendants Felix Cavaliere and Gene Cornish's Motion for Summary Judgment.

2. Attached hereto as Exhibit A are true and correct copies of concerts played by The Rascals recently. Each of these concernts featured performance by Felix Cavaliere and Gene Cornish, two members of the 60's version of the Rascals. Cavaliere and Cornish have transferred their rights for use of the trademark THE RASCALS into the llc for Beata

I declare under penalty of perjury under the laws of the United States of America that the foregoing is true and correct. Executed this 29th day of September 2023 at Pasadena CA.

/S/ A. Eric Bjorgum

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7 TOP 10 H
20 TOP 40

"Groovin"
"Good Lovin
"Beautiful Morn
"People Got to Be
"How Can I Be

Felix Cavaliere

ROCK 'N' ROLL HAL

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3 #1 SONGS
7 TOP 10 HITS
20 TOP 40 HITS

"Groovin"
"Good Lovin"
"Beautiful Morning"
"People Got to Be Free"
"How Can I Be Sure"

STUART & MIMI ROSE MUSIC CENTER

AT THE HEIGHTS

WAR & THE RASCALS FEATURING FELIX CAVALIERE & GENE CORNISH

Friday, July 14, 2023 - 7:30 PM

DATE

Felix Cavaliere's Rascals with **The Rose Music Center At The Heights.**
Sponsored (demo) ·

Ohio! We're coming to the Rose Music Center on Friday, July 14 with the legendary band War. Don't wait to get your tickets.

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The Rascals ✨ Friday, July 14
Rose Music Center in Huber Heights, OH
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CERTIFICATE OF SERVICE

The undersigned hereby certifies that an image of this paper is being served electronically upon all parties to this proceeding at the addresses recorded in the following manner on this day, September 29, 2023.

By Email To:

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