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**UNITED STATES PATENT AND TRADEMARK OFFICE  
TRADEMARK TRIAL AND APPEAL BOARD**

PHILTHY McNASTY'S SPORTS  
TAP & GRILL, INC.,

Petitioner,

Cancellation No. 25,538  
Registration No. 1,166,829

vs.

FILTHY McNASTY,

Respondent.

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**RESPONDENT'S TRIAL BRIEF**

Oppenheimer Wolff & Donnelly LLP  
2029 Century Park East, 38<sup>th</sup> Floor  
Los Angeles, CA 90067-3024  
Telephone: (310) 788-5000 • Fax: (310) 788-5100  
Louis J. Bovasso, Reg. No. 24,075  
Attorney for Respondent  
FILTHY McNASTY

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## INTRODUCTION

Respondent, Filthy McNasty (“Respondent”) by and through his undersigned counsel, submits the following Trial Brief in support of its opposition to Petitioner’s Philthy McNasty’s Sports Tap & Grill Inc.’s (“Petitioner”) Petition to Cancel Registration No. 1,166,829 in class 42 for the service mark Filthy McNasty’s for cabaret services. Petitioner argues that Respondent abandoned his mark more than three years ago. Respondent denies that he has abandoned his mark and Respondent has not submitted proof of abandonment by a preponderance of the evidence.

## DESCRIPTION OF THE RECORD

The evidence of record consists of the following:

1. Testimony Deposition of Filthy McNasty taken on April 30, 2001 and exhibits thereto (hereinafter Filthy McNasty Tr. 1).
2. Trial Testimony Deposition Transcript of Filthy McNasty and exhibits thereto taken by Respondent on June 21, 2001 (hereinafter Filthy McNasty Tr. 2).

### Exhibits

<u>#</u>	<u>Description</u>
10.	Copy of USPTO Service Mark Registration No. 1,166,829 for “Filthy McNasty’s”
11.	Decree Changing Name
25.	“L.A. Life Weekend”, 10/31/97
26.	“L.A. Life Weekend”, 11/28/97
27.	“L.A. Life Weekend”, 12/6/97
28.	“L.A. Life Weekend”, 11/7/97
29.	Pac Bell Website Printout, 12/11/97
30.	“Music Connection”, Oktoberfest
31.	“Music Connection”, Oktoberfest Ads
32.	“Music Connection”, Reunion
33.	Photographs

**A. NOTICE OF RELIANCE**

<u>Number</u>	<u>Mark</u>
1,286,486	All-Star Game
997,385	Kentucky Derby
888,872	Stanley Cup
882,283	Super Bowl
1,178,547	World Series

**STATEMENT OF THE ISSUES**

I. Did Respondent abandon his “Filthy McNasty” trademark registered for cabaret services?

Answer required by trial evidence: No.

II. Did Respondent abandon his “Filthy McNasty” trademark registered for cabaret services by closing his commercial establishment on or about late 1997, early 1998 and not reopening a permanent similar establishment since then?

Answer required by the trial evidence: No.

III. Has Petitioner proved by a preponderance of the evidence that Respondent abandoned his mark by failing to make legitimate commercial use of the mark for three consecutive years.

Answer required by the trial evidence: No.

IV. Has Respondent presented sufficient evidence to rebut the presumption of abandonment of his mark?

Answer required by the trial evidence: Yes.

**RECITATION OF FACTS**

Respondent is an individual and owner of Registration No. 1,166,829 in class 42 for cabaret services (Tr. 2 at 11, Exh. 10). Respondent legally changed his name to Filthy McNasty in 1974 (Tr. 2 at 22, Exh. 11). Respondent first opened a nightclub in 1967 (Tr. 2, at 12) in North Hollywood, California. He opened a second club in Hollywood,

California in 1969 (Tr. 2, at 12). He opened a third club in North Hollywood, California in 1976 (Tr. 2 at 12). He provided cabaret services at all three clubs (Tr. 2 at 15-16). These services included entertainment, food, drinks and personal appearances by Respondent (Tr. 2 at 16). He closed his third club in North Hollywood, California at the end of 1997 (Tr. 2 at 19). There is no dispute in the record that Respondent offered cabaret services in all three clubs at each location (Tr. 2 at 20).

Mr. McNasty testified that both he personally and his clubs had achieved a certain amount of fame and notoriety over the years (Tr. 2 at 51-54). He introduced a number of exhibits at his trial testimony deposition (Tr. 2 at 55-60, Exhs. 25-29) relating to advertising and promotion of his North Hollywood nightclub in late 1997. These exhibits clearly showed the use of Filthy McNasty's in conjunction with the North Hollywood nightclub at least as late as December 11, 1997. For example, Exhibits 26, 27 and 28 are ads that appeared in Daily News, a Los Angeles newspaper of general circulation, advertising Filthy McNasty's F.M. Station Live, his North Hollywood nightclub.

During 1998, Respondent explored the possibility of opening another club after he closed the North Hollywood club in late 1997 (Tr. 2 at 62).

Respondent held an Oktoberfest at the site of his North Hollywood club on October 30, 1999 (Tr. 2 at 64, Exh. 30). Respondent offered cabaret services in the form of entertainment, drinks, a band, etc. (Tr. 2, at 64-65).<sup>1</sup>

Respondent planned the October 1999 Oktoberfest, including making arrangements for the band and other entertainment, about 6 months before the actual event (Tr. 2, at 65-66). Respondent testified that the ad for the Oktoberfest '99 (Tr. 2, Exh. 30) ran in Music Connection, a magazine distributed nationwide (Tr. 2 at 68) and in Canada. Flyers similar to the Music Connection ad were also printed up and distributed

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<sup>1</sup> It is noted that at Mr. McNasty's discovery deposition on April 30, 2001 (Tr. 1 at 22), counsel for Petitioner stated on the record that "cabaret services" may be a restaurant or nightclub providing short programs of live entertainment."

(Tr. 2 at 69, Exh. 31). Respondent was also involved in selecting the food and beverage for the Oktoberfest '99 (Tr. 2 at 70-71).

Due to the success of the Oktoberfest '99, Respondent planned a reunion party for December 30, 2000 and an ad again ran in Music Connection (Tr. 2 at 71-72, Exh. 32). "Filthy McNasty's" was prominently displayed in the ad and the presence of a band and cocktails was advertised in the ad. The reunion party was held on December 30, 2000 (Tr. 2 at 72). Live entertainment, a full bar and food was provided (Tr. 2 at 73). Respondent started preparing for the December 2000 reunion party immediately after the Oktoberfest '99 (Tr. 2 at 73).

Respondent presented a number of photographs at his trial testimony deposition advertising the December 30, 2000 reunion party showing "Filthy McNasty's" on the marquee of his old North Hollywood club (Tr. 2 at 74-76, Exh. 33).

Due to the success of Oktoberfest '99 and the December 2000 reunion party, Respondent decided to do a reunion party at the site of his old North Hollywood club every year (Tr. 2 at 78). One is currently planned for December 19, 2001 (Tr. 2 at 79). Respondent will again provide such restaurant or cabaret services and is currently at work selecting the drinks, food and entertainment (Tr. 2 at 79).

Beginning in the year 2002, Respondent will be providing a monthly performance of the Filthy McNasty Club (Tr. 2 at 78, 80) and will again be providing cabaret services (Tr. 2 at 80). Finally, Respondent testified at his trial testimony deposition that he never intended to abandon cabaret services using the mark Filthy McNasty's (Tr. 2 at 85).

Under cross-examination, Respondent testified that the Oktoberfest '99 was a success and was jammed with people (Tr. 2 at 95). He also testified that escrow didn't close on his North Hollywood club until early 1998 (Tr. 2 at 87, 88). However, for

various reasons,<sup>2</sup> the new club, operating under the name SALOON CORONA, continued to use the name FILTHY McNASTY'S.

## ARGUMENTS

**1. Petitioner, in a cancellation proceeding, bears the heavy burden of proving, by a preponderance of evidence, that Respondent has abandoned his mark.**

Since Petitioner has no evidence of actual and deliberate abandonment, Petitioner argues that, since a mark is presumed abandoned after three consecutive years of non-use, Respondent has abandoned his mark. However, Petitioner has no clear and convincing evidence of such abandonment. Respondent has testified to, and submitted physical evidence of, an Oktoberfest in 1999, a reunion party in 2000 and an upcoming reunion party in 2001. Petitioner has presented no evidence that the 1999 and 2000 functions did not take place. All functions prominently displayed the name Filthy McNasty's and Respondent personally provided restaurant or cabaret services in the form of food, drink and entertainment. There has been no abandonment of the mark by Respondent for a consecutive three-year period nor, for like manner, since escrow didn't close on the North Hollywood club until early 1998, not even a consecutive two-year period (this is, assuming arguendo, that Respondent's fame and continued personal appearances did not carry over in the years after he closed his North Hollywood club).

**2. Statement of the Law**

A party seeking cancellation of a registration bears the burden of proof and must establish abandonment by a preponderance of evidence. Cerverceria Centroamericana, SA v. Cerverceria India, Inc., 892 F.2d 1021, 13 U.S.P.Q.2d 1307 (Fed. Cir. 1989), 15 U.S.C. § 1064(3) provides for abandonment of a mark if not used for the goods and

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<sup>2</sup> Mr. McNasty testified that the new owners continued to use Filthy McNasty's in conjunction with the new club name for many more months to capitalize on his goodwill (Tr. 2, at 33).



services described in the registration. "Abandonment," is defined in Section 15 U.S.C. § 1127(a) of the Lanham Act as occurring under the following circumstances:

- (1) When its use has been discontinued with intent not to resume such use. Intent not to resume may be inferred from circumstances. Nonuse for 3 consecutive years shall be prima facie evidence of abandonment . . .

Use, again as Petitioner states, is defined in 15 U.S.C. § 1127(a)(1) as:

"Use" of a mark means the bona fide use of such mark made in the ordinary course of trade, and not made merely to reserve a right in a mark.

Where, of course, the parties differ is in the definition of use sufficient to avoid abandonment.

### **3. Petitioner's Arguments**

Petitioner, at page 8, third full paragraph of its Trial Brief, states that Respondent's Reunion Party (2000) and Oktoberfest (1999) were get-togethers for old friends and patrons. This is an unsupported statement and has no basis in the record. Respondent never testified that these were the only people to attend and, certainly, "old patrons" would form the core of a reunion. Such people would of course include Respondent's former customers. Petitioner also makes much of the fact that no money was raised for the stated beneficiaries of Respondent's events (page 11, footnote 10 of Petition's Trial Brief). However, this of course is irrelevant toward the issue of use. Further, Respondent testified that the promotional activities in conjunction with the events left no profit after everything was paid (Tr. 1, at 28).

Petitioner also argues that Respondent did not resume using the Mark as the name of a nightclub (Petitioner's Trial Brief, page 8, last paragraph). This, of course, ignores Respondent's testimony that the mark appeared on the marquee where the parties were held. Further, Respondent's registration is not for a nightclub, but for cabaret services. Petitioner has itself indicated that cabaret and restaurant are synonymous (Tri, at 22) and one merely need to provide, food, drinks and entertainment. Although Petitioner argues

that, at some time in the 1990s, Respondent changed the name of his nightclub to FM Station, Respondent testified that he continued to use the name Filthy McNasty in conjunction with FM Station Live (Tr. 2 at 101). Further, as seen in Exhibits 26 to 29, Respondent continued to advertise "Filthy McNasty's" in conjunction with F.M. Station Live in late 1997. Further, since Mr. McNasty legally changed his name to Filthy McNasty, obviously, he would orally refer to FM Station Live as "my" club or "Filthy McNasty's" club. This is also sufficient trademark usage for a service mark. This use is uncontroverted by Petitioner.

Petitioner, at page 11, first full paragraph of its Trial Brief, queries whether or not it takes one full year to organize a one-night event. Respondent's Notice of Reliance sets forth a number of annual events that take a year to plan. Respondent, of course, is not on the same level as the World Series or the Super Bowl but is entitled to take as long as he wants to plan an annual event (and, in the case of the Oktoberfest '99, started six months earlier to plan the same).

Petitioner implies, at page 16, first full paragraph of its Trial Brief, that Respondent scrambled to put his mark into use after the cancellation proceedings began. However, Petitioner filed this proceeding on September 25, 1996. On that date, Respondent's North Hollywood nightclub was going full blast and did so until early 1998.

At page 19 of its Trial Brief, first full paragraph, Petitioner argues that one-time events cannot be considered bona fide use. No citations or cases are cited for this novel principle. Respondent is sure that this novel interpretation of the law would come as a surprise to the entities listed in the Notice of Reliance.

In its following paragraph of its Trial Brief, Petitioner argues that the "ordinary course of business" requires the prominent and constant display and use of the Mark (apparently, according to Petitioner, only on a large sign over a nightclub). However, this ignores the fact that again the use in the registration is for cabaret services and a mark can

be used orally in conjunction with the services. Mr. McNasty, referring to his nightclub by his name, is sufficient trademark use.

#### SUMMARY

Respondent continued to use his legal name and the mark Filthy McNasty's in the years following closure of his North Hollywood club. Petitioner has no evidence rebutting Respondent's use of the mark in conjunction with cabaret or restaurant services at the 1999 Oktoberfest, the year 2000 Reunion nor any evidence that the year 2001 reunion will not take place. Petitioner has not proved by a preponderance of evidence that Respondent has abandoned his mark and has no intention to resume use.

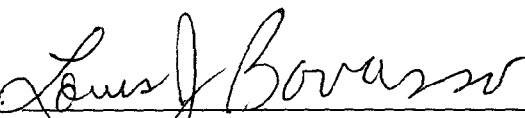
#### CONCLUSION

For the reasons set forth hereinabove, Respondent respectfully requests that the Board deny Petitioner's Petition to Cancel Reg. No. 1,166,829 due to abandonment.

Dated: November 14, 2001

Respectfully submitted,

OPPENHEIMER WOLFF & DONNELLY LLP

By:   
Louis J. Boyasso, Reg. No. 24,075  
Attorneys for Respondent

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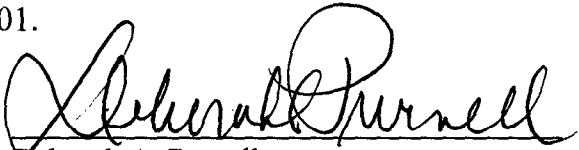
**CERTIFICATE OF MAILING AND OF SERVICE**

I certify that on November 14, 2001, I filed the RESPONDENT'S TRIAL BRIEF by Express Mail No. EL585851804US to the Assistant Commissioner for Trademarks, 2900 Crystal Drive, Arlington, VA 22202-3513 and served a copy by first class mail on applicant's attorney at:

James W. Creenan, Esq.  
Wayman, Irvin & McAuley, LLC  
1624 Frick Building  
437 Grant Street  
Pittsburgh, PA 15219

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

Executed this 14<sup>th</sup> day of November, 2001.

  
Deborah A. Purnell