UNITED STATES PATENT AND TRADEMARK OFFICE
TRADEMARK TRIAL AND APPEAL BOARD
2900 Crystal Drive
Arlington, VA 22202-3513

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

Petitioner,

vs.

FILTHY McNASTY,

Respondent.

Wolfson

Cancellation No. 25,538
Registration No. 1,166,829 (Class 42)

PETITIONER'S BRIEF IN REPLY TO RESPONDENT'S TRIAL BRIEF

Counsel of Record for this Party:

James W. Creenan, Esquire
Pa. Id. No. 79213
Wayman, Irvin & McAuley, LLC
1624 Frick Building
437 Grant Street
Pittsburgh, PA 15219

November 30, 2001

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I. INTRODUCTION

This Brief in Reply to Respondent's Trial Brief raises three (3) points for the Board's consideration. First, Respondent's Trial Brief fails to cite any precedent to counteract his failure to use the Mark in a commercially reasonable manner. Second, Respondent fails to address, or even acknowledge, Petitioner's cited and controlling authority, which requires a finding of abandonment and the cancellation of the Mark under these facts. Third, Respondent's selective critique of Petitioner's Trial Brief fails to rebut the presumption of abandonment due to the three-year period of non-use.[1]

II. REPLY ARGUMENT

A. RESPONDENT FAILS TO CITE ANY PRECEDENT TO SUPPORT ITS FACTUAL ARGUMENT

Respondent cites no factually-congruent case law is support of its argument, nor is Respondent's legal argument supported by the controlling statute and case law. Indeed, Respondent cites only one case, Cerverceria Centroamericana, SA v. Cerverceria India, Inc., 892 F2d 1021, 13 USPQ2d 1307 (Fed. Cir. 1989), which simply sets forth the abandonment standard but fails to lend credence or support to Respondent's argument.

In contrast, Petitioner cited controlling authority that undoubtedly requires a finding of abandonment. Respondent provided testimony that outlined a lengthy period of use

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[1] Petitioner need not address these spurious commentaries; rather, in each case the Board must review the Record as a whole in order to discern the accuracy of Respondent's position. Petitioner respectfully submits that the Record is accurately reflected in its Trial Brief and directly supports the arguments therein.

while he operated the three Hollywood, California nightclubs. Respondent's commercially reasonable "use" of the Mark ended when Respondent ceased operating the Victory Boulevard location under the name "Filthy McNasty's." Certainly, the most gracious reading of the Record has Respondent ceasing to use the Mark (in a commercially reasonable manner) no later than early 1997.[2] The trial testimony further supports the conclusion that Respondent has not used the Mark in a commercially reasonable manner since early 1997. The Record contains amply comparative evidence (use in the 1970s versus alleged use in 1999 and 2000) to support the conclusion that two one-time events is not commercially reasonable. Respondent's ethereal reliance on legitimate commercial ventures such as the Super Bowl and World Series for comparison to his illusory post-1997 use is so unavailing that no further response is warranted.

Lastly, Respondent's contrived used contravenes the Act's express language, in that:

> "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.

15 U.S.C.S. § 1127(a)(1). A central issue before the Board is whether Respondent's efforts to preserve the Mark, by throwing two reunion-type parties, is a "bona fide use in the ordinary course of trade." Id. Petitioner respectfully submits that Respondent's argument on this point is undermined to the point of collapse by the documentary exhibits, the trial testimony, and Respondent's credibility.

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[2] Respondent's doubtful candor precluded Petitioner from establishing the exact date on which Respondent began using the "FM Station Live" moniker as the name of the nightclub, although such event most probably occurred in the early 1990's according to the Respondent's trial testimony.

Petitioner's argument remains, and is reinforced by the absence of any credible opposing argument, that Respondent abandoned the Mark in 1997 and failed to make commercially reasonable use of the Mark afterwards. The presumption of abandonment applies and Respondent has not provided credible rebuttal evidence.

B. RESPONDENT FAILS TO ADDRESS THE PRECEDENT CITED IN PETITIONER'S TRIAL BRIEF

While Respondent notes, at page 6, that the parties differ as to whether sufficient evidence exists, Petitioner would add that the *quality* of the evidence must also be considered and that Respondent has offered no legal support for its position on the *quantum* of evidence required.

Of great concern to the Board should be Respondent's failure to address any of Petitioner's cited authorities. For example, Petitioner cited a controlling case that squarely rejects Respondent's purported post-1997 "use", Imperial Tobacco Ltd. v. Philip Morris, Inc., 899 F.2d 1575, 1582, 14 U.S.P.Q.2d 1390, 1395 (Fed. Cir. 1990), but Respondent does not even make mention of the case, its facts, or the controlling reasoning. Furthermore, the Respondent cites **no** case law to support its position.

Accordingly, in the interest of brevity, Petitioner stands on the unchallenged precedent and legal arguments set forth in its Trial Brief.

C. RESPONDENT'S SELF-SERVING CRITIQUE OF PETITIONER'S TRIAL BRIEF FAILS TO REBUT THE PRESUMPTION OF ABANDONMENT

Respondent's Trial Brief is nothing more than a selective, unsubstantiated criticism of the manner in which Petitioner's Trial Brief characterized the Record. Not only does this approach remove the cited passages from the proper context, but Respondent never gets around to providing a plausible explanation for Respondent's non-use. Further, Respondent fails to summon any legal support for the factual argument.

Respondent's criticisms are easily dismissed. First, Petitioner's argument concerning Respondent's "get-togethers" is accurate and supports the conclusion that such does not constitute a bona fide use in the ordinary course of the trade. (Resp. Brief, at 6 (citing Pet. Brief, at 8)). Petitioner does not assert a "novel interpretation of the law"; rather, the statute unequivocally requires a bona fide use in the ordinary course of commerce. Respondent has not made bona fide use since, at the latest, early 1997, especially compared to Respondent's own testimony concerning his earlier use.

Similarly, Petitioner submits that Respondent's cessation of the Mark as the name of the Victory Boulevard location is further persuasive evidence to contradict commercially reasonable use. (See, Resp. Brief, at 6-7). Most incredulously, Respondent strains to compare his one-night events, which, by the way, failed to even generate a nominal donation for the stated would-be charitable beneficiaries, to the Super Bowl and other legitimate, bona fide events. Petitioner makes no argument concerning the legitimacy Super Bowl, which is beyond reproach. To the contrary, Petitions argues that the Record

and controlling case law demonstrate that Respondent has not made a commercially reasonable, bona fide use of Mark since, at the latest, early 1997.

Accordingly, Petitioner submits that this attempted comparison is yet another thread woven into Respondent's thin cloak of implausibility and incredibility.

Conclusion

For the reasons outlined in Petitioner's Trial Brief and this Brief in Reply, Petitioner respectfully requests that the Board cancel Registration No. 1,166,829 due to abandonment.

Respectfully submitted,
WAYMAN, IRVIN & McAULEY, LLC

By: _____
James W. Creenan, Esquire

1624 Frick Building
437 Grant Street
Pittsburgh, PA 15219

(412) 566-2970
(412) 391-1464 (facsimile)

Date: November 30, 2001

CERTIFICATE OF MAILING

I HEREBY CERTIFY that the original and two copies of the forgoing **Brief in Reply to Respondent's Trial Brief** is being deposited with the United States Postal Service as Express Mail in an envelope addressed to BOX TTAB NO FEE, ASSISTANT COMMISSIONER FOR TRADEMARKS, TTAB, 2900 CRYSTAL DRIVE, ARLINGTON, VIRGINIA 22202-3513 on this 30th day of November, 2001.

November 30, 2001

James W. Creenan

CERTIFICATE OF SERVICE

I hereby certify that a true and correct copy of the foregoing **Brief in Reply to Respondent's Trial Brief** has been served on the following counsel of record by first class U.S. mail, postage pre-paid, by hand delivery, or by facsimile this 30th day of November, 2001:

Charles Rosenberg, Esquire
Oppenheimer, Wolff & Donnelly, LLP
2029 Century Park East, 38th Floor
Los Angeles, CA 90067-3024
(310) 788-5100 (facsimile)
(Counsel for Respondent)

WAYMAN, IRVIN & McAULEY, LLC

BY: James W. Creenan

Tear C

TTAB

LAW OFFICES OF

WAYMAN, IRVIN & McAULEY, LLC

SUITE 1624 FRICK BUILDING
437 GRANT STREET
TTSBURGH, PA 15219-6101
(412) 566-2970

FAX: (412) 391-1464
www.waymanlaw.com

BEAVER COUNTY OFFICE
722 TURNPIKE STREET
BEAVER, PA 15009
(724) 775-8950

WASHINGTON COUNTY OFFICE
29 EAST BEAU STREET
WASHINGTON, PA 15301

OF COUNSEL
W. ARCH IRVIN, JR.
BERNARD J. McAULEY

MICHAEL L. MAGULICK
MARK J. GESK
KATE J. FAGAN
FRANCIS X. McTIERNAN, JR.
WARREN L. SIEGFRIED
DALE K. FORSYTHE ◦
JOHN C. BOGUT, JR.
PAUL M. MANNIX +
KRISTA M. KOCHOSK
SCOTT W. STEPHAN
GREGORY T. WEIS
RICHARD L. McMILLA
JAMES W. CREENAN
CHRISTINE M. SEYMOUR
BRIAN W. DELVECCHIO

◦ ALSO ADMITTED IN OHIO
+ ALSO ADMITTED IN WEST VIRGINIA

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Writer's E-mail: jcreenan@waymanlaw.com

289459
JWC

November 30, 2001

Via U.S. Express Mail
(37 C.F.R. §1.1)

United States Patent and Trademark Office
Assistant Commissioner for Trademarks
2900 Crystal Drive
Arlington, Virginia 22202-3513
ATTN: TTAB 9th Floor

RE: Philthy McNasty's Sports Tap & Grill, Inc. v. Filthy McNasty
Cancellation No. 25, 538

Dear Assistant Commissioner:

Please find enclosed for filing with the Board the Original and two copies of Petitioner's Brief in Reply to Responent's Trial Brief. By copy of this letter to opposing counsel, I am providing him one service copy and one courtesy copy.

Thank you for your attention to this matter.

Very truly yours,

James W. Creenan

Enclosures

cc: Charles Rosenberg, Esquire (w/ encl.)

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MAS