

This Opinion is not a
Precedent of the TTAB

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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Daniel M. Goodman

v.

Steven Berlin

Cancellation No. 92057241

Sawnie R. Aldredge, Esq., for Daniel M. Goodman

Thomas G. Carulli of Kaplan, Massamillo & Andrews, for Steven Berlin

Before Kuhlke, Wellington and Ritchie,
Administrative Trademark Judges.

Opinion by Wellington, Administrative Trademark Judge:

Daniel M. Goodman (“Petitioner”) has petitioned to cancel Registration No. 4199114, owned by Steven Berlin (“Respondent”), for the mark LOS SUPER SEVEN, in standard characters, for “entertainment services in the nature of live musical performances.”¹

¹ Issued August 28, 2012, from an application filed October 11, 2010, asserting first use anywhere and in commerce on April 29, 2012.

Although the electronic transmittal page with the Petition for Cancellation specifies Section 2(d) (“Priority and Likelihood of Confusion”) as the ground being asserted, Petitioner did not cite to any statutory authority or specify a ground in the body of the petition. Nevertheless, he has set forth several allegations that, cumulatively, amount to a priority and likelihood of confusion ground. Particularly, Petitioner alleges that he is the “true owner” and has “extensive priority of use of the trademark [LOS SUPER SEVEN] for both live performances and sound recordings,” and that his application for [Serial No. 85301031] for the same mark for sound recordings has been refused registration on the basis of a likelihood of confusion with the involved registered mark.² Petitioner alleges certain other facts to show how he acquired rights in the mark LOS SUPER SEVEN, including his acquisition in 2000 of the (now cancelled) Registration No. 2316298 for the same mark in connection with entertainment services in the nature of live musical performances and in 2002 of the (now cancelled) Registration No. 2543714 for the same mark on musical sound recordings and related goods.³ Petitioner alleges that “[u]nless Registrant’s mark is canceled, Petitioner will potentially lose not only the ability to control the content and character of performances of the musical group, as he has for the past 15 years but because [his application involving sound recordings is being refused registration], he may lose the right to control the content and character of these goods as well, despite

² 1 TTABVUE 3. In contravention of Fed. R. Civ. P. 10(b), Petitioner did not number the paragraphs and allegations in the complaint (petition for cancellation); therefore, only page references are applicable. See also TBMP § 309.03(a)(2) (“All averments should be made in numbered paragraphs ...”).

³ *Id.* at 4.

his extensive efforts in developing and promoting the goods and services for the past 15 years.”⁴

Respondent filed an answer denying the salient allegations in the petition, and asserted various affirmative defenses, including the following:⁵

Notwithstanding that Petitioner did not, even had Petitioner established some purported right in the term “Los Super Seven” in the late 1990’s, the Petition itself evidence[s] that Petitioner has not been involved, in any way, with any “Entertainment services in the nature of live musical performances” associated with the words “Los Super Seven” in at least a decade, and thus has abandoned any claim of right therein.⁶

The parties have submitted trial briefs.

I. The Record

The record includes the pleadings and, by operation of Rule 2.122(b), the file of the registration sought to be cancelled.

In addition, during their assigned trial periods, the parties filed notices of reliance and both parties have submitted testimony in the form of declarations with attached exhibits. As to the declarations, the Board’s manual of procedure provides that “[p]arties may stipulate to ACR-type efficiencies at any stage of a proceeding in order to expedite the remainder of the trial schedule ... [including] that the testimony of a witness may be submitted in the form of an affidavit by the witness.” See TBMP § 705 (2016). Generally, the better practice is to file with the Board a copy of any such stipulation. Here, no stipulation was filed with the Board. Nevertheless, because the

⁴ *Id.*

⁵ Aside from the allegation regarding abandonment, Respondent did not submit any evidence regarding his other affirmative defenses, nor did he address them in his brief. We consider these other defenses to have been waived.

⁶ 1 TTABVUE 4.

parties in this case both filed testimony in the form of declarations and neither side object to the other's use, they have effectively stipulated to the admission of testimony in this form, and we will treat the declarations, as described below, as admitted in evidence.

During his testimony period, Petitioner submitted his own declaration, with exhibits thereto that include: a copy of a signed agreement between Petitioner and The RCA Records Label ("RCA"); copies of Petitioner's (cancelled) Registrations Nos. 2316298 and 2543714; a copy of a "cease and desist" letter from Petitioner's counsel addressed to Respondent; and the declaration of Rick Clark, a self-described "musician, journalist, record producer and music supervisor."⁷ Under notice of reliance, Petitioner submitted website printouts of the following: an "AllMusic Review by Stephen Thomas Erlewine" (from www.allmusic.com); a "No Depression" article "Los Super Seven – Border Radio" dated February 28, 2005 (obtained from www.nodepression.com); and an article from "Mix Online Extras" involving Los Super Seven (obtained from www.printthis.clickability.com).⁸

Respondent, during his testimony period, submitted his own declaration with exhibits that include: a copy of a list of what Mr. Berlin states are "musical recordings I have produced and/or on which I have performed"; and a printout from the White House website.⁹ Under notice of reliance, Respondent submitted copies of

⁷ 20 TTABVUE.

⁸ 21 TTABVUE.

⁹ 22 TTABVUE.

registrations for the mark LOS LOBOS (Reg. Nos. 2030095, 2113419, 4326958, and 4326959).

Petitioner, on rebuttal, filed his “Declaration in Rebuttal” and a notice of reliance on copies of “liner notes” (text printed on the packaging or sleeve insert) from a “Los Super Seven” album.¹⁰

II. Standing

“Standing requires only that the petitioner have a ‘real interest’ in the cancellation proceeding.” *Herbko Int’l Inc. v. Kappa Books Inc.*, 308 F.3d 1156, 64 USPQ2d 1375, 1377 (Fed. Cir. 2002). Petitioner here has made of record, *inter alia*, his registrations, albeit now cancelled, for the mark LOS SUPER SEVEN for entertainment services and musical recordings, as well as a cease and desist letter that was sent on his behalf to Respondent in June 2010.¹¹ This evidence, combined with Petitioner’s averment that he has “never abandoned the use of the mark,” as well as other evidence of record, demonstrates at the very least that Petitioner has a real interest in and standing to bring this proceeding. *See Empresa Cubana Del Tabaco v. Gen. Cigar Co.*, 753 F.3d 1270, 111 USPQ2d 1058, 1062 (Fed. Cir. 2014) (because USPTO refused petitioner’s registration based on a likelihood of confusion with respondent’s registration, petitioner “has a real interest in cancelling the Registrations and a reasonable belief

¹⁰ 29 TTABVUE. We further note that on June 6, 2016, after the close of his assigned-rebuttal testimony period, Petitioner filed a copy of Registrant’s responses to Petitioner’s first set of interrogatories. Because this filing is untimely, the interrogatory responses have not been considered.

¹¹ As noted *supra*, Petitioner pleaded ownership of an application that was refused registration on the basis of a likelihood of confusion with the involved registration. However, he did not introduce a copy of the application or evidence in this regard. Thus, we cannot consider this allegation which, if proven, would by itself confer standing.

that the Registrations blocking its application are causing it damage”); *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842 (Fed. Cir. 2000); *Lipton Industries, Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185 (CCPA 1982).

III. Priority and Rights in the Mark LOS SUPER SEVEN – Background

The parties do not dispute that concurrent use of the same LOS SUPER SEVEN mark, on or in connection with musical records or live musical performances, is likely to cause confusion as to source amongst consumers. Rather, the essential issue here is whether Petitioner can establish priority for likelihood of confusion purposes, namely, that he acquired prior rights in the LOS SUPER SEVEN mark and that he continues to hold such rights.

When it comes to musical performing groups and disputes over ownership of a band’s name, the facts and relevant circumstances are frequently vague. This is especially so when, as is the case here, there is no written agreement or other legal formalities clearly delineating trademark ownership rights. Nevertheless, we note the following relevant facts which are not in dispute.

In 1997, at the South by Southwest Music festival in Austin, Texas, there was an informal “jam session” involving various musicians, including members of the band Los Lobos, who played an assortment of Mexican-American songs. The following year, in 1998, various artists who performed in Austin recorded an album, released as “Los Super Seven” by RCA Records (“RCA”). For this first album, Petitioner had signed a contract with RCA wherein he agreed to act as “executive producer.” Respondent alleges that he acted in the role of producer of this album. The first album was

received with some success and won a Grammy award for “Best Mexican-American Album of 1999.” Liner notes on this album read:

Recorded in Austin Texas in April 1998, the album was the brainchild of artist manager Dan Goodman, who produced a show of Tex-Mex music at the 1997 South By Southwest. The intimate acoustic show at Austin’s famous Las Manitas café featured artists like Texas Tornadoes Doug Sahm and Augie Meyers, Joe Ely, Rick Trevino and Rosie Flores. It reflected Goodman’s growing fascination with border music and its Tex-Mex offshoots. Goodman began contacting the artists involved and even spent a week in San Antonio combing the record stores for traditional Mexican music to suggest for the project.

Petitioner meanwhile filed an application for the mark LOS SUPER SEVEN for “entertainment services in the nature of live musical performances,” which issued on February 8, 2000, as Registration No. 2316298.¹²

In 2001, a second Los Super Seven album was released, entitled “Canto.” Petitioner asserts that he again acted in the capacity of “executive producer” and Respondent alleges he again was the “producer.”

On March 5, 2002, Registration No. 2543714 for the mark LOS SUPER SEVEN for “musical sound recordings ... audio/visual discs, all containing music” issued to Petitioner.¹³

In 2005, a third album entitled “I Heard It on the X” was released by “Los Super Seven.” According to Petitioner, Respondent had no involvement with this album. Respondent does not dispute this. A review of this album states “Los Super Seven

¹² The underlying application was filed on December 8, 1998.

¹³ The underlying application was filed on December 8, 1998.

isn't even a band, per se – it's a collective, organized by manager Dan Goodman, who comes up with a concept for each of the group's albums and assembles a band to fit.”¹⁴

On December 13, 2008, Petitioner's Registration No. 2543714 was cancelled by the Office for failure to file the required affidavit of continued use (or excusable nonuse), pursuant to Section 8.

In a letter dated June 28, 2010, Petitioner's counsel demanded that Respondent “cease and desist any and all uses of the ‘Los Super Seven’ name and mark in connection with any of [Respondent's] activities.”

On September 10, 2010, Petitioner's Registration No. 2316298 was cancelled by the Office for failure to renew, pursuant to Section 8.

On October 11, 2010, Respondent filed the application that matured into the involved registration.

IV. The Parties' Positions

Petitioner contends that he is the rightful owner of the LOS SUPER SEVEN mark on musical recordings and in connection with entertainment services based on his role as an “executive producer” or “artist manager” and that “in 1997, [he] conceived the idea of creating a musical performing group with a rotating cast of musicians who would record and perform traditional Mexican-American songs ... This entity became ‘Los Super Seven.’”¹⁵ In addition to the undisputed facts outlined above, Petitioner relies on the averments in his declaration, including that he “first produced a concert in Los Angeles, California on September 14, 1998 and produced other concerts in New

¹⁴ 21 TTABVUE 3.

¹⁵ 31 TTABVUE 4.

York, Lexington, Kentucky, Austin, Texas and Nashville, Tennessee as well as other cities.”¹⁶ In response to Respondent’s assertion that Petitioner has abandoned any rights he may have acquired to the LOS SUPER SEVEN mark, Petitioner makes the following averment:¹⁷

I have never abandoned use of the mark. Specifically, the related goods, the three record albums I produced as “Los Super Seven” are still commercially available and I am in the planning stages of the fourth “Los Super Seven” recording which will be supported by a promotional tour.

Petitioner also relies on the declaration of Rick Clark, who averred that he “worked with [Petitioner] as one of the producers of the third Los Super Seven album ‘Heard It on the X’ [and Respondent] was not involved in the production of that sound recording nor was [Respondent] involved in any of the live performances which followed the release of that sound recording.”¹⁸ Mr. Clark added that “[t]o the best of my knowledge, information and belief, [Petitioner] never abandoned the Los Super Seven service mark.”¹⁹

Respondent’s position is that Petitioner was never the owner of the LOS SUPER SEVEN mark and that, even if Petitioner acquired rights in the mark, he abandoned these rights before Respondent filed the underlying application for the involved registration. With respect to the musical recordings, Respondent points to several passages from the agreement Petitioner entered into with RCA and states that “it was RCA, and only RCA, that had the right to control the nature and quality of the

¹⁶ 20 TTABVUE 3.

¹⁷ *Id.* at 4.

¹⁸ *Id.* at 27.

¹⁹ *Id.*

sound recordings and to manufacture the sound recordings of that album on which the name LOS SUPER SEVEN was used.”²⁰ As to any use by Petitioner of the mark in connection with live performances, Respondent contends that “had any rights been established by Petitioner having controlled the nature and quality of live musical performances conducted in or around the time the sound recordings were produced by the record companies in 1998, or even 2005, [and] such rights were abandoned more than a decade ago due to non-use.”²¹ Respondent asserts that because there was more than three years’ nonuse of the mark after those dates, there is a presumption of abandonment and Petitioner has not rebutted this presumption with credible evidence showing excusable nonuse of the mark.

V. Analysis

Respondent, as owner of the involved registration, is entitled to the *prima facie* presumptions, under Section 7(b) of the Trademark Act, 15 U.S.C. § 1057(b), of the validity of the registration, Respondent's ownership of the registered mark, and Respondent's right to exclusive use of the mark in commerce in connection with the identified services. Respondent may also rely on the filing date of the application that matured into the involved registration as his constructive use priority date. *See Cent. Garden & Pet Co. v. Doskocil Mfg. Co.*, 108 USPQ2d 1134, 1140 (TTAB 2013).

Petitioner, on the other hand, is plaintiff in this proceeding and thus bears the burden of establishing by a preponderance of the evidence that he possesses prior

²⁰ 32 TTABVUE 7.

²¹ *Id.* at 9.

rights in the LOS SUPER SEVEN mark. *Cunningham*, 55 USPQ2d at 1848; *Cerveceria Centroamericana, S.A. v. Cerveceria India Inc.*, 892 F.2d 1021, 13 USPQ2d 1307, 1309 (Fed. Cir. 1989).

As far as the Petitioner's acquisition of rights in the LOS SUPER SEVEN mark, the totality of the record shows that he was substantively involved in the creation and continuation of a "musical band" consisting of revolving musicians known as "Los Super Seven" from approximately 1997 until 2005. Petitioner averred that, as "the creator of a live performing group 'Los Super Seven,' [he] first produced a concert in Los Angeles, California on September 14, 1998" in addition to other live shows around the country.²² He also declared, under oath, that he released a third album, also released under the name "Los Super Seven," in 2005. Petitioner's statements are supported not only by the declaration of Rick Clark, but also the liner notes in the first album acknowledging the album as "the brainchild of artist manager Dan Goodman [Petitioner], who produced a show of Tex-Mex music at the 1997 South By Southwest." In addition, there are several reviews of the third album that reflect a public understanding that Petitioner is the person "who comes up with a concept for each of the group's albums and assembles a band to fit."²³

In spite of the aforementioned circumstances, it remains unclear whether Petitioner had rights to the mark LOS SUPER SEVEN at any time. The RCA agreement that Petitioner introduced sheds little light in this respect inasmuch as

²² 20 TTABVUE 3.

²³ 21 TTABVUE 3.

there is no mention of trademark rights therein. Rather, the agreement is clear that RCA not only owned the master recordings but also enjoyed exclusive control over the distribution of the recordings. As to any reliance by Petitioner on the now-cancelled registrations, we point out that they have no more probative value other than to show that they once issued. Petitioner is not entitled to any of the statutory presumptions of Section 7(b) of the Trademark Act that he was once the owner of the mark. *In Re Ginc UK Limited*, 90 USPQ2d 1472, 1480 (TTAB 2007). *See also Action Temporary Services Inc. v. Labor Force Inc.*, 870 F.2d 1563, 10 USPQ2d 1307, 1309 (Fed. Cir. 1989) (“a cancelled registration does not provide constructive notice of anything.”); *In re Hunter Publishing Company*, 204 USPQ 957, 963 (TTAB 1979) (cancellation “destroys the Section [7(b)] presumptions and makes the question of registrability ‘a new ball game’ which must be predicated on current thought.”).

In any event, even assuming *arguendo* that we were to find that this record sufficiently establishes that Petitioner acquired rights in this mark at some earlier time, the record also establishes that Petitioner abandoned those rights. That is, subsequent to release of the third “Los Super Seven” album in 2005, there is very little, if any, evidence showing Petitioner was involved with either musical recordings or entertainment services offered under the mark LOS SUPER SEVEN. As noted, *supra*, Petitioner’s two registrations were cancelled by the Office for either a failure to renew or failure to file an affidavit of continued use (or excusable nonuse). There is also no evidence corroborating Petitioner’s blanket assertions that his failure to maintain the registrations was due to “inadvertence and mistake”; or that the three

“Los Super Seven” albums are still “commercially available”; or that he is in the “planning stages” of a fourth “Los Super Seven” album that “will be supported by a promotional tour.” Indeed, there are no statements from third parties or documentary evidence to indicate that Petitioner was involved in promoting either live performances or musical recordings under the mark LOS SUPER SEVEN since 2005. The 2010 cease and desist letter sent by Petitioner’s counsel does not amount to use of the mark itself and statements made in the letter, *e.g.*, “[Petitioner] has continuously exploited the ‘Los Super Seven’ trademark for over twelve (12) years,” are merely hearsay. At best, the cease and desist letter constitutes an attempt to police the mark or shows that Petitioner believed he had rights in the mark at that time. Regardless, the record is void of testimony or additional evidence showing Petitioner was actually using the mark at that time or at any point since 2005. Notably absent is evidence of the mark being used in advertisements for either the musical recordings or entertainment services.

Section 45 of the Trademark Act provides that a mark is abandoned when “its use has been discontinued with intent not to resume use. Nonuse for three consecutive years shall be *prima facie* evidence of abandonment.” 15 U.S.C. § 1127. Inasmuch as Petitioner’s registrations were cancelled in 2008 and 2010 and to the extent he is now relying on common law rights in the mark, we note that the statutory presumption of abandonment applies not only to registered marks but also “to a party’s unregistered common-law mark.” *Miller Brewing Company v. Oland’s Breweries [1971] Limited*, 548 F.2d 349, 192 USPQ 266, 267 (CCPA 1976). In this case, a

presumption of abandonment has been created based on Petitioner's failure to account for any trademark use since 2005. Petitioner has not rebutted this presumption. *See, e.g., On-line Careline Inc. v. America Online Inc.*, 229 F.3d 1080, 56 USPQ2d 1471, 1476 (Fed. Cir. 2000) regarding the presumption of abandonment and burden shifting. Specifically, Petitioner has not only failed to introduce sufficient evidence that he was actually using the mark in the three years since 2005, but he has not established that the period of nonuse was excusable and that he had an intent to resume use of the mark. *See id.*

Ultimately, Petitioner has not shown by the preponderance of the evidence that he has acquired rights in the LOS SUPER SEVEN mark; even if we were to find that he did, the record shows that he was not continuously using the mark since at least 2005, or that this period of nonuse was excusable and he had an intent to resume use. Any rights in the mark that he may have once possessed were abandoned and, simply put, he was not the owner of the mark by the time Respondent filed the underlying application for the involved registration on October 11, 2010. Without existing prior rights in the mark LOS SUPER SEVEN, Petitioner cannot prevail on the ground of likelihood of confusion.

Decision: The petition for cancellation is dismissed.