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

Proceeding	92057241
Party	Plaintiff Daniel M. Goodman
Correspondence Address	SAWNIE R ALDREDDE PO BOX 120713 NASHVILLE, TN 37212 UNITED STATES trip@aldredgelaw.com
Submission	Other Motions/Papers
Filer's Name	Sawnie R. Aldredge
Filer's e-mail	trip@aldredgelaw.com
Signature	/Sawnie R Aldredge/
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Attachments	Petitioners Motion To Request Reconsideration of Final Decision.pdf(163172 bytes)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE BEFORE

THE TRADEMARK TRIAL AND APPEAL BOARD

Petitioner: Daniel M. Goodman c/o P.O. Box 120713, Nashville, Tennessee 37212

Registrant: Steven Berlin, Suite 224, 3439 N.E. Sandy Blvd. Portland, Oregon 97232.

Proceeding Number 92057241

PETITIONER DANIEL GOODMAN'S MOTION TO REQUEST RECONSIDERATION OF FINAL DECISION

I. Table of Authorities

Carter Wallace, Inc. v. Proctor and Gamble Co., 434 F. 2d 794, 804 (9th Cir. 1970)

Electro Source LLC, v. Brandess-Kalt-Aetna Group, Inc. 458 F. 3d 931, 936 (9th Cir. 2006)

Herb Reed Enterprises v. Florida Entertainment Management Inc. 736 F3d 1239 (9th Cir. 2013

Kingsmen v. K-Tel International Ltd., 557 F. Supp 178 (S.D.N.Y. 1983)

Marshak v. Treadwell, et al., 240 F. 3d 184 (3rd Cir. 2001)

Saxlehner v. Eisner & Mendelson Co. 179 US 19, 31, 21 S. Ct. 7, 11-12, 45 L.Ed 60 (US 1900).

United States Jaycees v. Philadelphia Jaycees, 639 F2d 134,139 (3rd Cir. 1984).

Wells Fargo Company USA v. ABD Insurance Financial Services Inc., No 13-15625 (9th Cir. 2014)

15 U.S.C. Sec. 1127

Ann Gilson La Londe, *Gilson on Trademarks* 3:05 (4)(Matthew Bender).

II. INTRODUCTION

Petitioner respectfully requests pursuant to TMBP Sec. 543 and 37 CFR Sec. 2.129(c) that the Board reconsider and reverse its decision in the Order dated October 12, 2016 ("Order") dismissing Petitioner's petition to cancel. Petitioner argues that based upon all of the prevailing authorities and the undisputed evidence of record, the Board erred in its conclusion that the Petitioner has abandoned his rights in the "Los Super Seven" trademark. The Board found that based upon the record there was no evidence that "Petitioner was involved in promoting either live performances or musical recordings under the mark "Los Super Seven" since 2005." Hence the Board concluded that Petitioner had abandoned the mark. However, the relevant and controlling case law sets a different standard for determining abandonment in cases such as this and Petitioner has met that standard.

III. ARGUMENT

The case law is uniformly consistent that there is no abandonment of a trademark when a musical group's recordings continue to be commercially available. Petitioner testified that all three recordings by Los Super Seven continue to be commercially available (TTABVUE 20 P.3 Goodman Declaration) and this fact is uncontroverted.

The court in *Kingsmen v. K-Tel International Ltd.*, 557 F. Supp 178 (S.D.N.Y. 1983) cited in Petitioner's brief, makes this important point:

> "Moreover the fact that these individuals continue to receive royalties for Kingsmen recordings flies in the face of any suggestion of intent to abandon the use of the name Kingsmen. These plaintiffs have no more abandoned their right to protect the name of the Kingsmen than had the Beatles, the Supremes or any other group that has disbanded or ceased performing and recording but continues to collect royalties for the sale of previously recorded material. We must reject defendant's contention that the name Kingsmen has been abandoned to the public domain." 557 F. Supp, 178, 183.

The *Kingsmen* case has been relied upon with approval by Judge Samuel Alito in the case *Marshak v. Treadwell, et al.,* 240 F. 3d 184 (3rd Cir. 2001). Judge Alito cited the above-referenced section and stated that "a successful musical group does not abandon its mark unless there is proof that the Owner ceased to commercially exploit the mark's secondary meaning in the music industry. (240 F. 3d 184, 199.) In that case the court noted that the proof of non-use would be that the recordings of "the Drifters" were not played and that resulting royalties were not paid.

In another case *Herb Reed Enterprises v. Florida Entertainment Management Inc.* 736 F3d 1239 (9th Cir. 2013) the court stated that "although non-use of the mark for three consecutive years constitutes prima facie evidence of abandonment the standard for non-use is high. Non-use requires '*complete* cessation or discontinuance of trademark use' where 'use' signifies any use in commerce and includes 'the placement of a mark on goods sold or transported'. Even a single instance of use is sufficient against the claim of abandonment of a mark if such use is made in good faith." 736 F3d 1239, 1247 citing *Electro Source LLC, v. Brandess-Kalt-Aetna Group, Inc*. 458 F. 3d 931, 936 (9th Cir. 2006) and *Carter Wallace, Inc. v. Proctor and Gamble Co.*, 434 F. 2d 794, 804 (9th Cir. 1970) (emphasis in original). See also *Wells Fargo Company USA v. ABD Insurance Financial Services Inc.,* No.

13-15625 (9th Cir. 2014) where the Court said "all bona fide uses in the ordinary course of business must cease before a mark is deemed abandoned."

This important distinction has also been discussed in the treatise *Gilson on Trademarks*. Ann Gilson La Londe writes about the above cited cases:"three cases involving disbanded musical groups found that where the groups' recordings are sold and played and group members continue to receive royalties the mark continues to be commercially exploited and thus there is no time of non-use." Ann Gilson La Londe, *Gilson on Trademarks* 3:05 (4)(Matthew Bender).

Petitioner testified that all three of the Los Super Seven recordings continue to be commercially available (TTABVUE 20P3 Goodman Declaration) and introduced evidence of his right to receive royalty income from at least one of these recordings. (TTABVUE 20PG5-6 (PAR.5)). This meets the criteria established by these cases and as LaLonde summarized: there has been no showing of any time of non-use. Therefore there was no abandonment.

The Board termed Petitioner's statement that the three recordings were still commercially available a "blanket assertion" but the assertion was not contradicted and the Board could take judicial notice of the fact that the recordings remain commercially available by reference to the inventory of on line stores such as Amazon.com and iTunes (See, for example https://www.amazon.com/s/ref=nb_sb_noss_2?url=search-alias%3Dpopular&field-keywords=Los+Super+Seven. November 8 2016 and https;//itunes.apple.com/artist/los-super-seven/id471444. November 10, 2016). While TMBP 543 states that a Request for Reconsideration may not be used to introduce additional evidence, TMBP 704.12 states that the Board will take judicial notice of a relevant fact not subject to reasonable dispute as defined in Fed. R. Evid. 201(b) if a party (1) requests that the Board do so and (2) supplies the necessary information. TMBP 704.12(d) states that judicial notice may be taken at any stage of a Board

proceeding. In his testimony, Petitioner states that all three Los Super Seven recordings continue to be commercially available and this testimony was not disputed; nor is the fact subject to reasonable dispute.

Further, the Board apparently found no evidentiary value in the fact that Petitioner had instructed his attorney to send a cease and desist letter to Registrant in 2010 (TTABVUE 20 pg 25-26) but taken in the context of the fact that according to these authorities Petitioner was still using the mark, with no intent to abandon the mark, the letter was not introduced solely as proof of Petitioner's use of the mark for twelve years but to show Petitioner's intent to protect and enforce his rights in the mark- rights he clearly still possessed. The United States Supreme Court recognized this over a century ago when it held "to establish the defense of abandonment it is necessary to show not only acts indicating a practical abandonment but an actual intent to abandon. Acts which unexplained would be sufficient to establish abandonment may be answered by showing that there never was an intent to give up and abandon the right claimed." *Saxlehner v. Eisner & Mendelson Co.* 179 US 19, 31, 21 S. Ct. 7, 11-12, 45 L.Ed 60 (US 1900). Further, while the Board noted the fact that co-producer Rick Clark stated in his declaration that Petitioner "never abandoned the "Los Super Seven" mark" (TTABVUE 20, p. 27-28) it did not appear to take this corroborating fact into consideration when concluding that Petitioner had abandoned the mark. While these facts could have been more artfully presented, taking them into consideration demonstrates that Petitioner has more than met the requisite "single instance of use" discussed in the *Reed* case, 736 Fed. 1239, 1247.

IV. Conclusion

15 U.S.C. § 1127 states "Nonuse for three consecutive years shall be prima facie evidence of abandonment." The relevant case law all supports Petioner's argument that there has never been a period of non use and accordingly, there is no

prima facie evidence of abandonment. It has been held that "abandonment being in the nature of as forfeiture must be strictly proved" *United States Jaycees v. Philadelphia Jaycees*, 639 F2d 134,139 (3rd Cir5. 1984). Given this high standard and given the uniforminty of case law as it applies to musical groups, Petitioner urges the Board to reconsider and reverse its opinion of abandonment and consider Petitioner's Petition to cancel Registrant's mark on the merits.

Respectfully submitted,

/s/Sawnie R. Aldredge
Sawnie R. Aldredge
Attorney for Petitioner
P.O. Box 120713
Nashville, Tennessee 37212
615-385-4437
trip@aldredgelaw.com

CERTIFICATE OF SERVICE

I hereby certify that a true and correct copy of the foregoing PETITIONER'S Motion to Request Reconsideration of Final Decision has been sent by regular U.S. mail, postage prepaid to Thomas G. Carulli, Esq. attorney for Steve Berlin at Kaplan, Massamillo & Andres, 70 East 55th Street, 25th Floor, New York, New York 10022, and by email to tcarulli@kmalawfirm.com this the 10th day of November, 2016.

/s/Sawnie R. Aldredge
Sawnie R. Aldredge