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

Proceeding	92057241
Party	Defendant Steven Berlin
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Daniel M. Goodman,

Cancellation: 92057241

Petitioner,

-v-

Steven Berlin,

Registrant

**RESPONDENT STEVEN BERLIN'S RESPONSE IN OPPOSITION TO PETITIONER'S
MOTION TO REQUEST RECONSIDERATION OF FINAL DECISION AND
PETITIONER'S MOTION TO REQUEST BOARD TO TAKE JUDICIAL NOTICE**

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Respondent submits this Opposition and Response to Petitioner's Motion to Request Reconsideration of Final Decision and Petitioner's Motion to Request Board to Take Judicial Notice, both of which should be denied.

Petitioner in his Motion to Request Board to Take Judicial Notice seeks judicial notice of a listing of two websites.

Petitioner bases his Motion to Request Reconsideration of Final Decision on the contention that the Board erred in that "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." (Petitioner's Motion to Request Reconsideration of Final Decision, p. 2).

In that Motion to Request Reconsideration of Final Decision, Petitioner seeks to rely on judicial notice to establish as a "fact" that "the recordings remain commercially available by reference to the inventory of on line stores" (Petitioner's Motion to Request Reconsideration, p. 4).

1. **ARGUMENT**

A. The TTAB should not take judicial notice based upon Petitioner's submission because that submission does not comprise any "fact" that can be judicially noticed.

TBMP Section 704.12(a) provides "The only kind of fact that may be judicially noticed by the Board is a fact that is "not subject to reasonable dispute in that it is either (1) generally known within the territorial jurisdiction of the trial court or (2) capable of accurate and ready determination by resort to sources whose accuracy cannot reasonably be questioned."

Petitioner submitted no copies of any webpages with his Motion. Rather, Petitioner merely listed the urls of supposed webpages that purportedly Petitioner viewed on November 8, 2016 – which pages no longer exist and cannot be viewed.

The Board has time and again rejected submissions such as that proposed by Petitioner as neither being facts nor being from sources whose accuracy cannot reasonably be questioned.

As the Board held in *Vitasoy International Holdings Limited v. Caffè Vita, Inc.*, 2015 WL 8966284 (TTAB 2015), links to retail websites are neither facts nor are they sources whose accuracy cannot reasonably be questioned, as contemplated by the rule:

We address Opposer's request in its Trial Brief for judicial notice of the fact that “prominent beverage chains like Dunkin' Donuts and Starbucks regularly offer both coffee and tea products,” for which Opposer provided links to their respective websites. Judicial notice may be taken of facts not subject to reasonable dispute because they are generally known or “can be accurately and readily determined from sources whose accuracy cannot reasonably be questioned.” Fed. R. Evid. 201. While the Board frequently exercises its discretion to take judicial notice of dictionary definitions or entries from reference works, particularly given the late timing of the request and in view of the nature of this factual assertion about the retail activity of particular entities, we do not deem it appropriate for judicial notice. The factual assertion does not appear to be generally known, and the internet URLs provided for particular retail websites do not constitute the types of sources whose accuracy cannot reasonably be questioned, as contemplated by the rule. See *UMG Recordings, Inc. v. Mattel, Inc.*, 100 USPQ2d 1868, 1874 (TTAB 2011) (rejecting request for judicial notice of webpages); *Motion Picture Ass'n of Am., Inc. v. Respect Sportswear, Inc.*, 83 USPQ2d 1555, 1558 (TTAB 2007) (denying judicial notice of internet search engine results and eBay postings).

Likewise, in refusing to take judicial notice of a webpage, the Board in *In Re Solene, Inc.*, 2016 WL 6523994 (TTAB 2016) held:

The content of websites is changeable and evanescent. Consequently, the Board will not utilize a URL to access a website to consider whatever content may appear there.

Similarly, in refusing to take judicial notice of a submission such as Petitioner submits in the present case, the Board held in *Jahn & Associates, LLC v. Melvin N.A. Avanzado dba The Avanzado Law Firm*, 2016 WL 1677307 (TTAB 2016):

Respondent also included a summary listing of the Internet pages in its responsive brief and requested that the Board take judicial notice of the listing. **The Board will not take judicial notice of facts subject to reasonable dispute.** See Fed. R. Evid. 201(b); TBMP § 704.12(b). Even if the Board took judicial notice of the search summaries, **such a listing of website links has no probative value, and the mere listing of a link to a website does not make the material that might be found on that website of record.** (emphasis added)

In light of the foregoing, Petitioner's Motion to Request Board to Take Judicial Notice should be denied.

B. The TTAB in its discretion should deny Petitioner's Request to Take Judicial Notice as untimely, in that Petitioner should have and could have made such request in Petitioner's testimony period.

Petitioner waited far too long to make this request for judicial notice. TMBP 704.12 (b) states that: "The request should be made during the requesting party's testimony period, by notice of reliance accompanied by the necessary information."

The Board has often refused to take judicial notice where a party has waited until after their case in chief to make the request. Thus, in *Boswell v. Mavety Media Group Ltd.*, 52 USPQ2d 1600, 1603 (TTAB 1999), the Board declined to take judicial notice of slang dictionary definition when submitted as part of rebuttal testimony when could have been submitted with case in chief. And in *StonCor Group, Inc. v. Les Pierres Stonedge Inc.*, 2011 WL 2161068 (TTAB 2011), the Board declined to take judicial notice of dictionary definitions when request was made in Applicant's brief, holding "we are not inclined to use judicial notice to remedy applicant's decision to do nothing during its testimony period".

Respondent respectfully submits that the Board should deny Petitioner's Motion to Request Board to Take Judicial Notice as untimely.

C. The Board correctly held that Petitioner has not shown by the preponderance of the evidence that he has acquired rights in the LOS SUPER SEVEN mark

Petitioner's unsupported argument on this Motion for Reconsideration is essentially that class 9 products are available for purchase.

Petitioner ignores the fundamental finding made by the TTAB in its October 12, 2016 Opinion – **that there is no evidence of record sufficient to carry the burden of proof that Petitioner ever owned trademark rights in the mark LOS SUPER SEVEN** for goods in class 9, namely recorded media products such as CD's. As the Board held: "Ultimately, Petitioner has not shown by the preponderance of the evidence that he has acquired rights in the LOS SUPER SEVEN mark..." (TTAB October 12, 2016 Opinion, p. 14).

Plaintiff does not challenge this finding. On that basis alone, Petitioner's Motion must fail.

Turning to the straw man Petitioner evokes - that the Board erred in a different conclusion, i.e., that based upon the record there was no evidence "Petitioner was involved in promoting either live performances or musical recordings under the mark "Los Super Seven" since 2005" (Petitioner's Motion to Request Reconsideration of Final Decision, p. 2) – Petitioner also is incorrect – there remains no such evidence that *Petitioner* ever was involved in *promoting* anything under the subject mark since 2005.

Petitioner apparently seeks to assert that the alleged availability of some physical recordings is evidence that Petitioner was involved in promoting musical recordings (but not live performances). But there remains no evidence of record of such.

Moreover, whether recorded music products are or are not available for purchase, in and of itself, is not relevant to proving ownership of any trademark rights in LOS SUPER SEVEN for goods in class 9, or for any other product or service. Indeed, the actual evidence which is of record is clear - the record labels (i.e., RCA, Sony) – not Petitioner – controlled the nature and quality of the Class 9 products they manufactured, whatever marks appeared on such products (the RCA Agreement, TTABVUE 20, p. 5 *et seq.* Respondent Berlin Testimony, TTABVUE 22, p. 4, para. 9), and there is no evidence to the contrary..

As the Board found: “Rather, the agreement is clear that RCA not only owned the master recordings **but also enjoyed exclusive control over the distribution of the recordings**” (TTAB October 12, 2016 Opinion, p. 12).

Paragraph 7 of the RCA Agreement confirms that RCA owned all rights “*in the Masters*” and “*in the derivatives manufactured therefrom*” (any CDs and other physical musical recordings that RCA made from the Masters) and that RCA had the sole right to manufacture Class 9 products “embodying the Masters” (TTABVUE 20, p. 8).

Thus, the RCA Agreement confirms that it was RCA, and only RCA, that had the right to control the nature and quality of, and to manufacture, the physical Class 9 products.

In contrast, there is no evidence that any mark was used by Petitioner for a series of recorded Class 9 products.

Turning to Petitioner’s argument that he was to receive royalties under the RCA Agreement, this allegation has no bearing on whether Petitioner ever acquired rights in LOS SUPER SEVEN for pre-recorded music products in class 9, or for services in Class 41, and the cases cited by Petitioner are not at all relevant.

First, the RCA Agreement, paragraph 5, merely states that Petitioner was to receive a “Producing Royalty” (TTABVUE 20, p. 6). This has no bearing on the ownership of trademark rights.

Further, the RCA Agreement actually evidences that RCA was to pay royalties to the Producer (Respondent Berlin) and the Artists (e.g., Berlin’s LOS LOBOS partners and bandmates David Hidalgo and Cesar Rosas) - separately and independently from Petitioner, pursuant to their separate agreements with RCA.

Paragraph 1 of the RCA Agreement confirms that the artists had separate “Artist Agreements’ with RCA) (TTABVUE 20, p. 5)¹. Paragraph 6(b) further confirms the Artists’ separate agreements with RCA (TTABVUE 20, p. 7), and paragraph 8(a) confirms the separate Producer Agreement for Respondent and the separate Artist Agreements (TTABVUE 20, p. 9). These facts were never denied by Petitioner.

The RCA Agreement further contains a most favored nation’s clause (TTABVUE 20, p. 7), which again evidences that Respondent and the musical artists were each separately being paid royalties by RCA. That clause provided that if RCA were to give Respondent or the Artists a better method of computing their royalties, then RCA would provide Petitioner with that better method for his royalty as well.

Thus, Petitioner’s potential to receive royalties simply is of no relevance to whether Petitioner (or anyone) ever acquired rights in, or used or continued to use on Class 9 goods, any trademark at all, much less the mark in question.

¹ “album ... embodying the performances of David Hidalgo, Cesar Rosas, ... (each, individually, an "Artist" and collectively, the "Artists") subject to recording agreements with RCA ("Artists' Agreements").

Finally, there is no evidence of record that anyone has been paid a royalty by RCA in decades, or at all.

In short, Petitioner's arguments about royalties for sales of Class 9 products are without merit and further have no bearing whatsoever on the ownership of the trademark rights at issue.

2. CONCLUSION

Based upon the forgoing facts, arguments and authorities, Respondent respectfully submits that Petitioner's Motion to Request Reconsideration of Final Decision and Petitioner's Motion to Request Board to Take Judicial Notice both should be denied.

November 22, 2016

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CERTIFICATE OF SERVICE

I hereby certify that a true and correct copy of the foregoing RESPONDENT STEVEN BERLIN'S RESPONSE IN OPPOSITION TO PETITIONER'S MOTION TO REQUEST RECONSIDERATION OF FINAL DECISION AND PETITIONER'S MOTION TO REQUEST BOARD TO TAKE JUDICIAL NOTICE has been sent by email to trip@aldredgelaw.com this the 22nd day of November, 2016.