

This Opinion is not a  
Precedent of the TTAB

Mailed: December 12, 2016

**UNITED STATES PATENT AND TRADEMARK OFFICE**

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**Trademark Trial and Appeal Board**

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*Daniel M. Goodman*

v.

*Steven Berlin*

—  
Cancellation No. 92057241

—  
On Request for Reconsideration

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

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

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Before Kuhlke, Wellington and Ritchie,  
Administrative Trademark Judges.

Opinion by Wellington, Administrative Trademark Judge:

On October 12, 2016, the Board issued a final decision (the “Final Decision”) denying Petitioner Daniel M. Goodman’s petition to cancel Respondent Steven

Berlin's Registration No. 4199114 on the ground of likelihood of confusion.<sup>1</sup> In the Final Decision, we stated:<sup>2</sup>

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.

Petitioner has filed, concurrently, a request to take judicial notice<sup>3</sup> and a request for reconsideration of the Final Decision, which are fully briefed.

*Petitioner's Judicial Notice Request*

Petitioner, citing Fed. R. Evid. 201 and TBMP § 704.12, "requests that the Board take judicial notice of ... documents" that it states are being "introduced in support of the fact that recordings of the musical group Los Super Seven continue to be commercially available."<sup>4</sup> However, Petitioner did not attach any materials but merely provided Internet address or hypertext link to two websites, Amazon and Apple iTunes. Petitioner's request for the Board to take judicial notice of the identified websites is not well-taken for several reasons, and, accordingly, denied.

Petitioner's request is untimely for two reasons. First, a request for reconsideration may not be used to introduce additional evidence. TBMP § 543

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<sup>1</sup> 35 TTABVUE.

<sup>2</sup> *Id.* at 14.

<sup>3</sup> 36 TTABVUE.

<sup>4</sup> *Id.* at 2.

(2016). Second, a judicial notice request “should be made during the requesting party's testimony period, by notice of reliance accompanied by the necessary information.” TBMP § 704.12(b).

In addition, the materials purportedly containing the information were not provided to the Board nor would they contain appropriate subject matter for judicial notice. As noted above, Petitioner did not attach any materials but merely provided website addresses (or URL's).<sup>5</sup> “The Board will not utilize a link or reference to a website's internet address to access the site to consider whatever content may appear therein.” *In re Future Ads LLC*, 103 USPQ2d 1571, 1572 n. 3 (TTAB 2016); *see also In re HSB Solomon Associates, LLC*, 102 USPQ2d 1269, 1274 (TTAB 2012).

Finally, “[t]he 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.” TBMP § 704.12(a) (citing Fed. R. Evid. 201). It is clear that these websites are not indisputably authoritative sources that would be appropriate matter for judicial

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<sup>5</sup> Petitioner attempted to correct this by attaching printouts with a reply brief filed on December 6, 2016, arguing that his failure to attach these materials with its initial request was due to “inadvertence or mistake.” 39 TTABVUE. Such material attached to a reply brief is untimely and may not be considered, as such timing forecloses the opportunity for the adverse party to respond. *Cf. Boswell v. Mavety Media Group Ltd.*, 52 USPQ2d 1600, 1603 (TTAB 1999) (no judicial notice taken when submitted as part of rebuttal testimony when could have been submitted with case in chief). Moreover, as explained above, these materials are not from authoritative sources and, by themselves, would not establish a fact whose accuracy cannot reasonably be questioned.

notice by the Board; the printouts would not establish a fact for which the Board can take judicial notice.<sup>6</sup>

Petitioner's request is nothing short of an untimely and inappropriate attempt to introduce evidence that he should have introduced at trial, which would have afforded Respondent the opportunity to rebut such evidence. For the reasons mentioned, the request is denied and the referenced website addresses are given no consideration.

*Petitioner's Request for Reconsideration*

"[T]he premise underlying a request for ... reconsideration ... is that, based on the evidence of record and the prevailing authorities, the Board erred in reaching the decision it issued. The request may not be used to introduce additional evidence, nor should it be devoted simply to a reargument of the points presented in the requesting party's brief on the case." TBMP § 543 (2016).

In his request for reconsideration, Petitioner asserts that the Board "erred in its conclusion that the Petitioner has abandoned his rights in the 'Los Super Seven' trademark."<sup>7</sup> Petitioner specifically takes issue with the Board's finding that the record did not support Petitioner's use of the mark in connection with live performances or musical recordings since 2005. Petitioner argues that "the relevant and controlling case law sets a different standard for determining abandonment in cases such as this and Petitioner has met that standard."<sup>8</sup> In particular, Petitioner relies on the treatise *Gilson on Trademarks* and three decisions referenced therein

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<sup>6</sup> See TBMP § 704.12(a), Note 2, for examples of facts and materials that were decided to be (in)appropriate in the context of taking judicial notice.

<sup>7</sup> 37 TTABVUE 3.

<sup>8</sup> *Id.*

involving disbanded musical groups in which the courts 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.”<sup>9</sup>

As Respondent pointed out in his opposition to Petitioner’s request for reconsideration, Petitioner’s request overlooks the Board’s finding that Petitioner did not carry his burden of proof that he had acquired rights in the LOS SUPER SEVEN trademark in the first place.<sup>10</sup> That is, in the Final Decision, the Board clearly pointed out because Petitioner is the plaintiff and bringing a likelihood of confusion claim, without owning a registration, he “bears the burden of establishing by a preponderance of the evidence that he possesses prior rights in the LOS SUPER SEVEN mark.”<sup>11</sup> With this in mind and based on the record before the Board, we stated that “it remains unclear whether Petitioner had rights to the mark LOS SUPER SEVEN at any time.” Put simply, Petitioner did not meet his burden of establishing rights in the mark. Thus, Respondent is correct in further pointing out that Petitioner “does not challenge this finding [of not having acquired rights in the mark]” and “on that basis alone,” the request for reconsideration “must fail.”<sup>12</sup> In other words, we do not need to reach whether abandonment occurred if there were no demonstrated trademark rights acquired to begin with.

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<sup>9</sup> Citing Anne Gilson Lalonde & Jerome Gilson, 1-3 *Gilson on Trademarks* § 3:05 (2016).

<sup>10</sup> 38 TTABVUE 7, citing to Final Decision at 35 TTABVUE 14 (“Petitioner has not shown by the preponderance of the evidence that he has acquired rights in the LOS SUPER SEVEN mark ...”).

<sup>11</sup> 35 TTABVUE 10-11.

<sup>12</sup> 38 TTABVUE 7.

Nevertheless, we are not convinced by Petitioner's arguments and the authorities cited that the Board erred in concluding:<sup>13</sup>

[E]ven 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.

Petitioner's reliance on the *Gilson on Trademarks* treatise, and the three referenced decisions, is misplaced. The treatise, itself, does not elaborate on the matter other than to note that "courts finding that abandonment has not occurred rely on a variety of factual circumstances" and "three cases involving disbanded musical groups found that where the group's 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 nonuse."<sup>14</sup> In one of those three decisions, *Kingsmen v. K-Tel International, Ltd.*, 220 USPQ 1045, 1049 (S.D.N.Y. 1983), the District Court made a finding of fact that "these individuals continue to receive royalties for Kingsmen recordings" and this was crucial in rebutting "any suggestion of intent to abandon use of the name Kingsmen." In contrast, and on the record before us, Petitioner has not shown by a preponderance of the evidence that he receives royalties for any of the LOS SUPER 7 recordings or, if he has, that he was receiving royalties as a result of having trademark rights in the mark. Although Petitioner introduced an agreement (identified as "the RCA agreement" in the Final Decision)

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<sup>13</sup> *Id.* at 12.

<sup>14</sup> 1-3 *Gilson on Trademarks* § 3:05.

showing that he was entitled to certain royalties, there is no reference to trademark rights. Rather, as noted in the Final Decision, the agreement is clear that RCA not only owned the master recordings but also enjoyed exclusive control over the “method, manner and extent of release, packaging, promotion, advertising, distribution and sales relating to reproductions of the [master recordings].”<sup>15</sup>

We further find no error in the characterization of and weight attributed to the evidence submitted by Petitioner. We reiterate also the absence of convincing evidence “showing Petitioner was actually using the mark at that time or at any point since 2005,” including any “evidence of the mark being used in advertisements for either the musical recordings or entertainment services.”<sup>16</sup>

Ultimately, based on the evidence of record and the prevailing authority, we see no error in the Final Decision and Petitioner’s request for reconsideration is therefore denied.

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<sup>15</sup> 20 TTABVUE 8.

<sup>16</sup> 35 TTABVUE 13.