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Filing date: **06/11/2019**

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

Proceeding	92065794
Party	Plaintiff The Marshall Tucker Band, Inc.
Correspondence Address	SARAH S BROOKS VENABLE LLP 2049 CENTURY PARK EAST, SUITE 2300 LOS ANGELES, CA 90067 UNITED STATES ssbrooks@venable.com, asharon@venable.com, hedmonds@venable.com 310-229-9900
Submission	Plaintiff's Notice of Reliance
Filer's Name	Sarah S. Brooks
Filer's email	ssbrooks@venable.com, hedmonds@venable.com, asharon@venable.com
Signature	/Sarah S. Brooks/
Date	06/11/2019
Attachments	Petitioners Amended Sixth Notice of Reliance.pdf(1799112 bytes )

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

The Marshall Tucker Band, Inc.,	)	Cancellation No.: 92065794
	)	Registration Nos. 4616427 and 4616428
Petitioner,	)	Mark: THE MARSHALL TUCKER BAND
	)	
v.	)	
	)	
M T Industries, Inc.,	)	<b>AMENDED NOTICE OF</b>
	)	<b>RELIANCE</b>
	)	
Respondent.	)	
	)	
	)	
	)	
_____	)	

**PETITIONER’S AMENDED SIXTH NOTICE OF RELIANCE**

Petitioner The Marshall Tucker Band, Inc. (“MTB”), by and through undersigned counsel, pursuant to TBMP Chapter §§704, files this Amended Notice of Reliance:

Petitioner relies on this Notice of Reliance to support this cancellation proceeding and to admit the Respondent’s responses to Petitioner’s first set of interrogatories served on November 17, 2017. These responses contain Respondent’s contentions regarding ownership of and right to register the word mark and logo “The Marshall Tucker Band,” as well as contentions relating to the signing of the Declaration contained in the M.T. Industries, Inc. trademark applications, which is the basis for Petitioner’s fraud claim.

Dated: June 11, 2019

Respectfully submitted,

  /s/ Sarah S. Brooks  
Sarah S. Brooks, Esq.

Attorney for Petitioner  
Venable LLP  
2049 Century Park East, Suite 2300  
Los Angeles, CA 90067

**CERTIFICATE OF SERVICE**

I hereby certify that a true and correct copy of the foregoing **PETITIONER'S AMENDED SIXTH NOTICE OF RELIANCE** was served upon Registrant's counsel, Richard L. Albert, by forwarding said copy on June 11, 2019, via email to rick@albertlawoffices.com.

/s/ Sarah S. Brooks      Date: June 11, 2019

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Name: Sarah S. Brooks

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

The Marshall Tucker Band, Inc., ) Cancellation No.: 92065794  
 ) Registration Nos.: 4616427, 4616428  
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 ) Petitioner, )  
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 ) Mark:  
 v. ) THE MARSHALL TUCKER BAND  
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 M T Industries, Inc., )  
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 ) Registrant. )  
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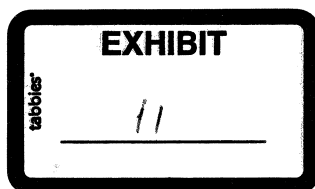
**REGISTRANT'S RESPONSE TO PETITIONER'S FIRST SET OF  
INTERROGATORIES TO REGISTRANT M T INDUSTRIES, INC.**

M T Industries, Inc. ("MTI" or "Registrant"), through undersigned counsel, responds to the First Set of Interrogatories to Registrant M T Industries, Inc. (the "Rogs") propounded by petitioner, The Marshall Tucker Band, Inc. ("MTB" or "Petitioner") as follows:

**GENERAL RESPONSES AND OBJECTIONS**

The General Responses and Objections apply to each of Registrant's Specific Responses to the Interrogatories, and the Specific Responses set forth below shall not be deemed a waiver, either in whole or in part, of any of these General Responses and Objections:

1. Registrant objects to each Interrogatory insofar as it seeks to impose obligations that exceed those imposed by the Federal Rules of Civil Procedure.
2. Registrant objects to each Interrogatory insofar as it seeks information subject to the attorney-client privilege, the work product doctrine, and any other recognized privilege or



confidentiality doctrine. All responses are subject to this objection, without prejudice or waiver thereof. Inadvertent responses containing privileged information shall not constitute the waiver of any privilege.

3. Registrant objects to each Interrogatory to the extent it seeks information that has been provided by other discovery means, or may be provided by less burdensome and more suitable means.

4. Registrant objects that these Interrogatories, including but not limited to Interrogatory No. 16, contain multiple subparts which exceeding 25 interrogatories as permitted by FRCP 33(a)(1). (see, i.e. *Safeco of America v. Rawstron* (CD CA 1998) 181 FRD 441, 445; *Miller v. Holzman* (D DC 2006) 240 FRD 1, 3).

5. Registrant's discovery, investigation and analysis in this matter are ongoing and continuing. Relevant documents have not yet been produced, and the depositions of persons who may have knowledge relevant to the issues in this lawsuit have not yet been taken and/or completed. Accordingly, Registrant reserves the right (but assumes no duty beyond the requirements of law) to amend or further supplement the following Specific Answers based on any further investigation and discovery in this case, or analysis of documents, records or facts by its counsel. Registrant further reserves the right to introduce at trial any and all evidence.

6. Without waiving any of the foregoing general objections, and specifically subject thereto, Registrants further respond as follows:

## **SPECIFIC RESPONSES**

### **INTERROGATORY NO. 1:**

Identify and describe all facts and documents supporting the statement in the MTI Mark

Applications that “the applicant [is] the owner of the trademark/service mark sought to be registered.

**ANSWER TO INTERROGATORY NO. 1**

Registrant claims ownership of the trademark/service mark as used on the defined products and services because it uses the mark “The Marshall Tucker Band” and “Marshall Tucker Band” in interstate commerce in connection with certain masters and recordings, as memorialized in the 1984 Letter Agreement made between the original band members, Petitioner, and Registrant. Documents have been produced pursuant to Petitioner’s Request for Document Production which support Registrant’s claim of such trademark/service mark ownership. This interrogatory is materially identical to Petitioner’s Interrogatory No. 1 previously propounded on Registrant on September 16, 2016 in U.S. District Court, District of South Carolina case no. 7:16-cv-00420-MGL, to which Registrant responded in full on October 17, 2016, along with document production and served supplemental responses on Nov. 14, 2016.

**INTERROGATORY NO. 2:**

Identify and describe all facts and documents supporting the statement in the MTI Mark Applications that “the mark was first used by the applicant or the applicant's related company or licensee predecessor in interest at least as early as 04/00/1973.”

**ANSWER TO INTERROGATORY NO. 2**

The original band members, individuals Toy Caldwell, Tommy Caldwell, George McCorkle, H. Douglas Gray, Jerry Eubanks, and Paul T. Riddle, began using the name “The Marshall Tucker Band” in connection with public music performances at least as early as April, 1973. These same six band members formed MTI in 1978 as its shareholders to license, own, manage, market and produce their intellectual property rights in songs and recordings using, and

to permit others to use, the name “The Marshall Tucker Band” and “Marshall Tucker Band” in connection with those songs and recordings. Documents have been produced pursuant to plaintiffs’ Request for Document Production which support Registrant’s belief.

**INTERROGATORY NO. 3:**

Identify and describe all facts and documents supporting the statement in the MTI Mark Applications that to the best of its knowledge, “no other person, firm, corporation, or association has the right to use the mark in commerce, either in the identical form thereof or in such near resemblance thereto as to be likely, when used on or in connection with the goods/services of such other person, to cause confusion, or to cause mistake, or to deceive[.]”

**ANSWER TO INTERROGATORY NO. 3**

Registrant believes that to the best of its knowledge, that "no other person, firm, corporation, or association has the right to use the mark in commerce, either in the identical form thereof or in such near resemblance thereto as to be likely, when used on or in connection with the goods/services of such other person, to cause confusion, or to cause mistake, or to deceive[.]" because unless such use is licensed or permitted by MTI, no other person or entity may use, or has been using the trademark/service mark which was subject of its applications on the same goods and services as MTI, i.e. in connection with the commercial use of masters and recordings made prior to February, 1984. Plaintiff MTB itself, in its own applications for USPTO trademark registrations of the Name “The Marshall Tucker Band” or “Marshall Tucker Band,” attests in declarations signed by attorney Ellen Cheek on behalf of plaintiff MTB, with full knowledge of MTI’s continuing use of the mark in commerce as well as the 1984 Letter Agreement apportioning use of the Name in commerce and otherwise between the original band

members, MTI, MTB and others, that MTI's use of its mark on goods or services was not likely to cause confusion, or to cause mistake, or to deceive. Documents have been produced pursuant to plaintiffs' Request for Document Production which support Registrant's belief. This interrogatory is materially identical to Petitioner's Interrogatory No. 3 previously propounded on Registrant on September 16, 2016 in U.S. District Court, District of South Carolina case no. 7:16-cv-00420-MGL, to which Registrant responded in full on October 17, 2016, along with document production and served supplemental responses on Nov. 14, 2016.

**INTERROGATORY NO. 4:**

State whether MTI claims the exclusive right to use the Name in connection with the description of goods and/or services identified in the MTI Mark Applications.

a. If so, state the date and manner in which MTI gained such right, and identify and describe all facts and documents supporting same.

b. If not, state the origin and scope of any usage right claimed by MTI, and identify and describe all facts and documents supporting same.

c. If not, identify any usage right not claimed by MTI, and identify and describe all facts and documents supporting same.

**ANSWER TO INTERROGATORY NO. 4**

Registrant objects that this interrogatory contains discrete subparts amounting to individual interrogatories. Registrant does not claim that MTI has the exclusive right to use the Name "The Marshall Tucker Band" or "Marshall Tucker Band" for all purposes or uses. MTI has offered to help and support MTB's intent to register its own trademarks utilizing the Name with the USPTO for its own commercial uses. The 1984 Letter Agreement does not grant, or suggest that MTB or anyone else has an "exclusive" right to use the Name, but rather apportions

the use of the name between the parties, including plaintiffs MTB, Doug Gray, and Registrant MTI, to which apportionment they all consented. Documents have been produced pursuant to plaintiffs' Request for Document Production which support Registrant's belief. This interrogatory is materially identical to Petitioner's Interrogatory No. 4 previously propounded on Registrant on September 16, 2016 in U.S. District Court, District of South Carolina case no. 7:16-cv-00420-MGL, to which Registrant responded in full on October 17, 2016, along with document production and served supplemental responses on Nov. 14, 2016.

**INTERROGATORY NO. 5:**

State whether any person or entity other than MTI has ever possessed an exclusive right to use the Name. If so:

- a. Identify each person or entity.
- b. State the date and manner in which each right originated.
- c. If applicable, state the date and manner in which each right terminated.
- d. Identify and describe all facts and supporting documents.

**ANSWER TO INTERROGATORY NO. 5**

Registrant objects that this interrogatory contains discrete subparts amounting to individual interrogatories. No person or entity ever had an exclusive right to use the Name for all purposes or all uses. However, parties to the 1984 Agreement consented to not use the Name "The Marshall Tucker Band" or "Marshall Tucker Band" in certain categories of commerce or other uses. Registrant MTI has had the right to use the Name for commercial purposes at least as early as 1978. This interrogatory is materially identical to Petitioner's Interrogatory No. 5 previously propounded on Registrant on September 16, 2016 in U.S. District Court, District of South Carolina case no. 7:16-cv-00420-MGL, to which Registrant responded in full on October

17, 2016, along with document production and served supplemental responses on Nov. 14, 2016.

**INTERROGATORY NO. 6:**

Identify all persons who have any knowledge concerning MTI's use of the Name in commerce, and describe the substance of each person's knowledge.

**ANSWER TO INTERROGATORY NO. 6**

MTI's claimed ownership and use of the trademark/service mark is public knowledge, and has been identified as such at least as early as 2014 in its public its trademark/service mark registrations. The request to identify "all persons who have any knowledge" is way too broad in light of public record and the limited permissible discovery on this narrow issue. Ron Rainey and counsel for MTI have knowledge of MTI's claims, as well as Petitioner and their counsel, which has been stated in the pleadings. Registrant objects that "the substance of each person's knowledge" is too broad and ambiguous as to be answerable, and is more suitable for discovery through deposition. This interrogatory is materially identical to Petitioner's Interrogatory No. 6 previously propounded on Registrant on September 16, 2016 in U.S. District Court, District of South Carolina case no. 7:16-cv-00420-MGL, to which Registrant responded in full on October 17, 2016, along with document production and served supplemental responses on Nov. 14, 2016.

**INTERROGATORY NO. 7:**

Identify the date on which MTI first started using the Name in commerce in connection with the goods and/or services described in the MTI Mark Applications.

a. Identify and describe all documents reflecting or supporting same.

**ANSWER TO INTERROGATORY NO. 7**

MTI was using the Name "The Marshall Tucker Band" or "Marshall Tucker Band" in connection with recordings and masters at least as early as February 22, 1984 the date of the

Letter Agreement, and was using the name in connection with the all of the band's songs from the date MTI was formed in 1978. Documents have been produced pursuant to plaintiffs' Request for Document Production which support Registrant's belief. This interrogatory is materially identical to Petitioner's Interrogatory No. 8 previously propounded on Registrant on September 16, 2016 in U.S. District Court, District of South Carolina case no. 7:16-cv-00420-MGL, to which Registrant responded in full on October 17, 2016, along with document production and served supplemental responses on Nov. 14, 2016.

**INTERROGATORY NO. 8:**

Identify each person involved in the decision to file, and/or the filing, of the MTI Mark Applications.

a. State the extent of each identified person's involvement in the decision to file and/or the filing of the MTI Mark Applications.

b. Identify all related documents.

**ANSWER TO INTERROGATORY NO. 8**

Ron Rainey, Michael Martin, Ken Krauss, Michael Wilkes.

Ken Krauss reviewed the 1984 agreement and advised Ron Rainey by letter on October 23, 1998 that MTI owned exclusive use of the name The Marshall Tucker Band in connection with commercial distribution of the pre-1984 masters and recordings, and specifically, a recording of a live performance by the band made prior to 1984. Michael Wilkes furnished that copy of the Letter Agreement to Krauss by mail on July 24, 1998. Ron Rainey as CEO of MTI was aware of the current 1984 use and license of the mark on digital music recordings. Michael Martin prepared and signed the applications for trademark registration, and reviewed the use of the name Marshall Tucker Band on product and services.

- b. Documents have been produced pursuant to plaintiffs' Request for Document Production which support the decision to file applications, and communications with these parties.

This interrogatory is materially identical to Petitioner's Interrogatory No. 11 previously propounded on Registrant on September 16, 2016 in U.S. District Court, District of South Carolina case no. 7:16-cv-00420-MGL, to which Registrant responded in full on October 17, 2016, along with document production and served supplemental responses on Nov. 14, 2016.

**INTERROGATORY NO. 9:**

Identify all licenses, contracts, agreements, or other documents pursuant to which MTI acquired any claimed rights to or interest in the Name.

**ANSWER TO INTERROGATORY NO. 9**

Registrant objects to this interrogatory as way too broad, when asking Registrant to identify "all licenses, contracts, agreements, or other documents pursuant to which MTI acquired any claimed rights to or interest" in the Name "The Marshall Tucker Band" or "Marshall Tucker Band" since discovery is limited only to the DECLARATION attached to MTI's trademark applications. MTI's interest in the Name goes beyond its mere trademark rights in a mark derived from placing the mark on goods or services in commerce in connection with song masters and other recordings. Documents have been produced pursuant to plaintiffs' Request for Document Production support Registrant's belief that it has the right to use the Name in connection with such masters and recordings, such as the 1984 Letter Agreement, and license agreements and exemplars of product that evidence MTI's use of the Name as a trademark or service mark as reflected in its applications to the Trademark Office for registration. This interrogatory is materially identical to Petitioner's Interrogatory No. 13 previously propounded

on Registrant on September 16, 2016 in U.S. District Court, District of South Carolina case no. 7:16-cv-00420-MGL, to which Registrant responded in full on October 17, 2016, along with document production and served supplemental responses on Nov. 14, 2016.

**INTERROGATORY NO. 10:**

State the nature and extent of MTI's right and interest to the Name prior to the execution of the 1984 Agreement.

**ANSWER TO INTERROGATORY NO. 10**

MTI was using the Name "The Marshall Tucker Band" or "Marshall Tucker Band" in connection with recordings and masters as of February 22, 1984 the date of the Letter Agreement, and earlier, and was using the name in connection with all of the band's recorded songs from the date MTI was formed in 1978.

**INTERROGATORY NO. 11:**

State the nature and extent of MTI's right and interest to the Name subsequent to the execution of the 1984 Agreement.

**ANSWER TO INTERROGATORY NO. 11**

MTI continued, subsequent to the execution of the 1984 Agreement, to use the Name "The Marshall Tucker Band" or "Marshall Tucker Band" in connection with recordings and masters which were recorded as of February 22, 1984, as it did before that date, which was using the name in connection with the band's songs.

**INTERROGATORY NO. 12:**

State the nature and extent of MTB's right and interest to the Name prior to the execution of the 1984 Agreement.

**ANSWER TO INTERROGATORY NO. 12**

MTB was using the Name before 1984 to identify public performances prior to the execution of the 1984 Agreement.

**INTERROGATORY NO. 13:**

State the nature and extent of MTB's right and interest to the Name subsequent to the execution of the 1984 Agreement.

**ANSWER TO INTERROGATORY NO. 13**

After 1984, MTB continued to use the Name in connection with public performances, and began affixing the Name to tee-shirts, mugs, bumper stickers, hats, and other promotional merchandise of that nature.

**INTERROGATORY NO. 14:**

With respect to Registrant's answers to Petitioner's First Requests for Admission to Registrant MT Industries, Inc., served contemporaneously herewith: If Registrant denies any request to admit, or any part thereof, explain the bases for Registrant's denial.

**ANSWER TO INTERROGATORY NO. 14**

Registrant objects that this interrogatory contains 30 discrete subparts amounting to individual interrogatories. Objections are stated in response to each applicable Request, and incorporated herein.

**Request for Admission No. 2:**

The DECLARATION does not contain a statement that Registrant "owned the [mark]" "The Marshall Tucker Band" or "Marshall Tucker Band" for all purposes.

**Request for Admission No. 10:**

The term of art "Licensee" has many legal meanings, which without specificity makes

the Request senseless. Registrant is unaware of any written license agreements between the parties.

**Request for Admission No. 14:**

MTI has been using or permitting others to use the Name exclusively in connection with music recordings since 1978. MTI knows of no writing that affords MTB “sole and exclusive” use of the name, although MTB has a right to use the name on certain goods or services.

**Request for Admission No. 18:**

MTB’s applications for trademark registration with the USPTO in 2014 was rejected for multiple reasons, as stated in the documents publicly available at the Trademark Office website, principally because MTB abandoned its applications by ignoring the examining attorney’s office actions.

**Request for Admission No. 22:**

The original band members of The Marshall Tucker Band did not create the name “Marshall Tucker.” Legend has it that was a name a band member saw on a key chain belonging to a piano tuner named Marshall Tucker.

**Request for Admission No. 25:**

The Band did not release albums. Various record companies released albums, or 45 singles to the public. Capricorn Records, Inc. and No Exit Music Co., Inc. released albums containing music recorded by the Band.

**Request for Admission No. 28:**

MTI owns master recordings made of the Band in live performances, and other recordings which were not released as the eight enumerated phonograph record albums identified in the definition of “Capricorn Masters” to the Requests for Admission.

Dated this 17th day of November, 2017

Respectfully submitted,

/Richard L. Albert/

Richard L. Albert (Cal. Bar No. 204359)  
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Attorney for Registrant M T Industries, Inc.

CERTIFICATE OF SERVICE

I hereby certify that a true and complete copy of the foregoing REGISTRANT'S RESPONSE TO PETITIONER'S FIRST SET OF INTERROGATORIES TO REGISTRANT M T INDUSTRIES, INC. has been served on SARAH S. BROOKS, ESQ. by forwarding said copy via email to: [sbrooks@sycr.com](mailto:sbrooks@sycr.com)

Signature: /Richard L. Albert/

Date: November 17, 2017

VERIFICATION

I have read the foregoing, REGISTRANT'S RESPONSE TO PETITIONER'S FIRST SET OF INTERROGATORIES TO REGISTRANT M T INDUSTRIES, INC., and know its contents.

CHECK APPLICABLE PARAGRAPHS

I am a party to this action. The matters stated in the foregoing document are true of my own knowledge except as to those matters which are stated on information and belief, and as to those matters I believe them to be true.

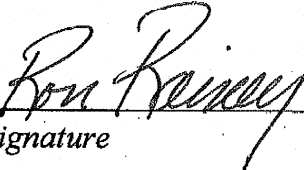
I am an Officer of M T Industries, Inc., a party to this action, and am authorized to make this verification for and on its behalf, and I make this verification for that reason.  I am informed and believe and on that ground allege that the matters stated in the foregoing document are true.  The matters stated in the foregoing document are true of my own knowledge except as to those matters which are stated on information and belief, and as to those matters I believe them to be true.

I am one of the attorneys for \_\_\_\_\_, a party to this action. Such party is absent from the county of aforesaid where such attorneys have their offices, and I make this verification for and on behalf of that party for that reason. I am informed and believe and on that ground allege that the matters stated in the foregoing document are true.

Executed on November 15, 2017, at Beverly Hills, California.

I declare under penalty of perjury under the laws of the United States and the State of California that the foregoing is true and correct.

RON RAINEY

  
\_\_\_\_\_  
Signature