

UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office
Trademark Trial and Appeal Board
2900 Crystal Drive
Arlington, Virginia 22202-3513

JST

THIS DISPOSITION IS NOT
CITABLE AS PRECEDENT OF THE TTAB

Opposition No. 109,721

4/27/00

D.S.E. Dirty South
Entertainment, Inc. and
substituted for Dirty
South Entertainment Co.

v.

Frederick L. Bell

Before Hanak, Hairston and Chapman,
Administrative Trademark Judges.

By the Board:

Frederick L. Bell seeks to register the mark DIRTY SOUTH for "videotapes, motion picture films featuring a variety of subject matter, namely, comedies, dramas, mysteries, westerns, documentaries, biographies, and compact discs and cassettes featuring rap and hip hop music" in International Class 9; "clothing, namely, baseball caps, T-shirts, sweatshirts, sweat pants, jackets, coats, and pants" in International Class 25; and "entertainment, namely, live music concerts and live performances by a musical band, motion picture film

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production, and videotape production" in International
Class 41.¹

¹ Application Serial No. 75/243,924, filed February 19, 1997, based on a bona fide intent to use the mark in commerce. This opposition involves all three classes of goods and services.

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Registration has been opposed by D.S.E. Dirty South Entertainment, Inc. on the grounds that prior to the filing date of the involved application, i.e., February 19, 1997, opposer has been and is now engaged, *inter alia*, in the business of distributing, advertising, marketing, offering for sale and selling clothing and related goods and providing management services in the field of entertainment which include concert promotion and distribution of recorded music; that since prior to February 19, 1997, opposer has been and is now using the mark DIRTY SOUTH ENTERTAINMENT as a trademark and service mark on and in connection with its clothing and management services; and that applicant's DIRTY SOUTH mark so resembles opposer's pleaded mark DIRTY SOUTH ENTERTAINMENT as to be likely, if applied to the goods and services of applicant, to cause confusion, or mistake, or to deceive.

Applicant, in his answer, admitted that he has not used the mark in commerce; that if opposer has used the pleaded mark, the goods and services identified by opposer are the same and/or closely associated with the goods and services of applicant; and that applicant's mark so resembles opposer's mark it is likely to cause confusion or mistake, or deception, but applicant denied that opposer has used its alleged mark. Applicant denied the remaining salient allegations of the notice opposition. Applicant

also pleaded as affirmative defenses that he developed the "DIRTY SOUTH" concept in a music composition in which he is a copyright co-owner; that the composition gained widespread popularity among music listeners; and that opposer should not be allowed to benefit from a mark that opposer has neither developed nor used in commerce.

This case now comes up for consideration of (1) opposer's combined motion for summary judgment and for suspension of the case pending the Board's decision on the motion for summary judgment; (2) opposer's combined motion to strike applicant's brief in opposition to the motion for summary judgment and reply brief in response to that opposition if it is considered; and (3) opposer's motion to correct the misidentification and/or to substitute the proper name of opposer.

Initially we grant opposer's motion to substitute its proper name. See Fed. R. Civ. P. 17 and TBMP § 303.05(c). Accordingly, the proceeding caption has been amended to properly identify the plaintiff as D.S.E. Dirty South Entertainment, Inc.

We turn next to opposer's motion to strike applicant's brief in opposition to the motion for summary judgment on the ground that it is untimely. As indicated in the certificate of service, opposer's motion for summary judgment was served by first class mail on September 4,

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1998. Any brief in opposition to the motion, or request for extension to file the same, was due no later than September 24, 1998. See Trademark Rule 2.127.² As such, applicant's brief in opposition to the motion for summary judgment filed by certificate of mailing by Express Mail dated October 6, 1998 was untimely.

In view thereof, opposer's motion to strike is granted. Nonetheless, inasmuch as the motion for summary judgment may be dispositive of this matter and because applicant contested the matter, albeit in an untimely fashion, the motion will not be treated as conceded. Rather, the Board will determine opposer's summary judgment motion on the merits.

Turning finally to opposer's motion for summary judgment on the grounds of priority of use, we note that applicant has admitted that confusion is likely between the parties' asserted marks. Accordingly, and as stated by opposer, the sole issue before the Board on summary

² By amendment to the Trademark Rules of Practice, effective October 9, 1998, the response period for filing a brief in opposition to a motion for summary judgment is now thirty days. However, at the time the motion for summary judgment was filed, a brief in response to a motion had to be filed within 15 days from the date of service of the motion (20 days if service of the motion was made by first-class mail, "Express Mail," or overnight courier--see 37 CFR §2.119(c)), unless another time is specified by the Board; or the time is extended by stipulation of the parties approved by the Board or by order of the Board on motion for good cause; or the time is reopened by stipulation of the parties approved by the Board or by order of the Board on motion showing excusable neglect.

judgment is priority of use. In this regard, opposer asserts that its first use date of the pleaded trade name, trademark and service mark, DIRTY SOUTH ENTERTAINMENT, predates the filing date of the involved application, i.e., February 19, 1997 - the earliest date upon which applicant may rely.

As evidentiary support therefor, opposer has submitted the declarations of Louis Jean Denis, Willie Dixon, Derrick Green, and Tyrone Taylor. Mr. Denis, opposer's chief executive officer, in his declaration states in part that:

2. Prior to February 13, 1997, I was a partner in D.S.E. Dirty South Entertainment Co. a.k.a. Dirty South Entertainment a.k.a. Dirty South Entertainment Co., a partnership using the mark DIRTY SOUTH ENTERTAINMENT in connection with services including management of performing artists, registering performing artists with potential employers, finding employment engagements for performing artists, and theatrical booking services for performing artists.
3. As an example of the services listed in paragraph 2 above, in October of 1996, D.S.E. Dirty South Entertainment Co. provided services using the mark DIRTY SOUTH ENTERTAINMENT which included arranging a promotional show involving musical artists collectively known as Dru Hill at a venue known as Q-tip Night Club, 500 S.Davies Blvd., Greensboro, North Carolina for a performance scheduled for November 22, 1996 or November 23, 1996.
28. The mark DIRTY SOUTH ENTERTAINMENT in connection with clothing and in connection with the services listed in paragraph 2 above along with the good will associated therewith were assigned by the partnership referred to in paragraph 2 above to D.S.E. Dirty South Entertainment, Inc. a.k.a.

Dirty South Entertainment Co. upon formation of the Corporation on February 13, 1997.

29. D.S.E. Dirty South Entertainment, Inc. a.k.a. Dirty South Entertainment Co. has continuously used the trademark/service mark DIRTY SOUTH ENTERTAINMENT in connection with its business since its inception on February 13, 1997.

Mr. Denis also introduced, among other things, (1) copies of solicitation letters for the above-referenced services to be performed under the service marks DSE and DIRTY SOUTH ENTERTAINMENT dated December 26, 1996 and December 27, 1996, respectively; (2) sales invoices dated as early as October 20, 1996 for clothing bearing the Dirty South Entertainment mark (as well as photographs thereof); (3) a certified copy of the certificate of incorporation of D.S.E. Dirty South Entertainment filed February 13, 1997; (4) and copies of invoices dated January 19, 1997 for business cards bearing the DIRTY SOUTH ENTERTAINMENT trade name.³

Mr. Green, the owner of Power Move Studios (located at 441 Tuscan Drive, Greensboro, North Carolina), in his declaration, states in part that:

4. Since at least December of 1996, I have associated the mark DIRTY SOUTH ENTERTAINMENT with clothing

³ The Board has considered as persuasive only those exhibits which show use by opposer of the DIRTY SOUTH ENTERTAINMENT mark. Those exhibits referencing only opposer's DSE or D.S. ENTERTAINMENT marks carry little, if any, weight in this proceeding which involves the question of the registrability of applicant's mark, DIRTY SOUTH.

distributed by the company that is now known as D.S.E. Dirty South Entertainment, Inc.

5. Since as least December of 1996, I have associated the mark DIRTY SOUTH ENTERTAINMENT with services offered and conducted by the company that is now known as D.S.E. Dirty South Entertainment, Inc. which services include management of performing artists, performing research to find employment opportunities for performing artists, registering performing artists with potential employers, finding employment engagements for performing artists and theatrical booking services for performing artists.

Mr. Taylor, a producer of musical recordings, in his declaration, states in part that:

4. Since as least October of 1996, I have associated the mark DIRTY SOUTH ENTERTAINMENT with clothing distributed by the company that is now known as D.S.E. Dirty South Entertainment, Inc.

5. Since as least October of 1996, I have associated the mark DIRTY SOUTH ENTERTAINMENT with services offered and conducted by the company that is now known as D.S.E. Dirty South Entertainment, Inc. which services include management of performing artists, performing research to find employment opportunities for performing artists, registering performing artists with potential employers, finding employment engagements for performing artists and theatrical booking services for performing artists.

It is well established that the purpose of summary judgment is one of judicial economy, that is, to save the time and expense of a useless trial where no genuine issue of material fact remains and more evidence than is already available in connection with the summary judgment motion could not reasonably be expected to change the result.

Pure Gold, Inc. v. Syntex (U.S.A.), Inc., 739 F.2d 624, 222

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USPQ 741 (Fed. Cir. 1984). Fed. R. Civ. P. 56(c) provides that summary judgment may be granted "if the pleadings, depositions, answers to interrogatories, and admissions on file, together with the affidavits, if any, show that there is no genuine issue as to any material fact and that the moving party is entitled to a judgment as a matter of law." The record must be viewed in the light most favorable to the nonmoving party, and all factual inferences must be drawn in favor of the nonmoving party. *Olde Tyme Foods Inc. v. Roundy's Inc.*, 961 F.2d 200, 22 USPQ2d 1542 (Fed. Cir. 1993).

After a careful review of the record in this case, we conclude that opposer has established use of the pleaded DIRTY SOUTH ENTERTAINMENT trademark and service mark as early as October 1996, and use of DIRTY SOUTH ENTERTAINMENT as part of its trade name since February 13, 1997. Moreover, applicant admitted that he has not used the DIRTY SOUTH mark in interstate commerce except, as asserted in its answer, as a "concept in a music composition in which applicant is a copyright co-owner of such composition." As such, the filing date of applicant's intent-to-use application, i.e., February 19, 1997, is the earliest use date on which applicant may rely. As such, opposer has clearly established that there is no genuine issue of material fact as to opposer's use of its pleaded DIRTY

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SOUTH ENTERTAINMENT mark on and in connection with its asserted goods and services prior to any use date which may be claimed by applicant.

In view of the foregoing, opposer's motion for summary judgment is granted; the opposition is sustained and registration to applicant is refused.⁴

E. W. Hanak

P. T. Hairston

B. A. Chapman
Administrative Trademark
Judges, Trademark Trial
and Appeal Board

⁵ We hasten to add that even if we had considered applicant's brief in opposition to summary judgment, our decision would be the same. When, as here, the moving party's motion is supported by evidence sufficient, if unopposed, to indicate that there is no genuine issue of material fact, and that the moving party is entitled to judgment, the nonmoving party may not rest on mere denials or conclusory assertions, but rather must proffer countering evidence, by affidavit or as otherwise provided in FRCP 56, showing that there is a genuine factual dispute for trial. See FRCP 56(e); *Copelands' Enterprises Inc. v. CNV Inc.*, 945 F.2d 1563, 20 USPQ2d 1295 (Fed. Cir. 1991); and *Octocom Systems Inc. v. Houston Computer Services Inc.*, 918 F.2d 937, 16 USPQ2d 1783 (Fed. Cir. 1990). Applicant made several references to an "Exhibit 8" in his brief in opposition to summary judgment. However, that exhibit is not in the proceeding file. It is also noted that applicant did not reference any other exhibits.

On April 25, 2000, the Board contacted applicant's "former" counsel as well as applicant to obtain a copy of Exhibit 8. Neither applicant nor counsel could identify or produce a copy of Exhibit 8. Consequently, on this record, applicant did not offer any countering evidence to raise a genuine issue of material fact as to priority.