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Paper No. 76
JQ

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UNITES STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Synergy Productions, Ltd.
v.
Reggae Sunsplash, Inc.

Opposition No. 93,387
to application Serial No. 74/366,575
filed on March 10, 1993

Samuel Cooper, III for Synergy Productions, Ltd.

Keith J. Harrison and Thomas W. Jones, Jr. of King,
Pagano & Harrison for Reggae Sunsplash, Inc.

Before Quinn, Chapman and Holtzman, Administrative
Trademark Judges.

Opinion by Quinn, Administrative Trademark Judge:

An application has been filed by Reggae Sunsplash,
Inc. to register the mark shown below

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for "jewelry, pendants" (in International Class 14),
"clothing, namely, shirts, T-shirts, sweatshirts,
sweaters, jackets, vests, shorts, skirts, socks, caps,
pants, leather jackets, leather shirts and leather pants"
(in International Class 25), and "entertainment services
in the nature of live musical performances" (in
International Class 41).¹

Registration has been opposed by Synergy
Productions, Ltd. In an amended notice of opposition,
opposer alleges that applicant's mark, when applied to
applicant's goods and/or services, so resembles opposer's
previously used mark shown below

for prerecorded audio and video cassettes, printed
material, jewelry, wearing apparel and entertainment
services in the nature of musical performances as to be
likely to cause confusion under Section 2(d) of the
Trademark Act. In addition, opposer alleges that the

¹ Application Serial No. 74/366,575, filed March 10, 1993,
alleging dates of first use anywhere of May 1, 1978 and dates of

application was fraudulently filed in that opposer, not applicant, is the owner of the mark.

Applicant, in its answer, alleges that it has priority of use of the mark. Applicant otherwise denies the salient allegations of the opposition.²

The record consists of the pleadings; the file of the involved application; trial testimony, with related exhibits, taken by each party; applicant's answers to opposer's interrogatories and requests for admissions, introduced by opposer's notice of reliance; and an official record of the Jamaican government submitted by applicant. Both parties filed briefs. An oral hearing was not requested.

Before turning to the merits, we direct our attention to opposer's claim that applicant's case is "based upon incompetent evidence not admissible at trial." (reply brief, p. 5) More specifically, opposer for the first time objects to applicant's submission of

first use in interstate commerce of June 4, 1984. The word "Reggae" is disclaimed apart from the mark.

² Applicant also asserts that opposer is guilty of laches. The defense of laches in opposition proceedings effectively has been eliminated inasmuch as the pertinent period to consider in determining whether an opposer delayed in bringing an opposition begins with the publication of the mark in the *Official Gazette*. *National Cable Television Association v. American Cinema Editors, Inc.*, 937 F.2d 1572, 19 USPQ2d 1424 (Fed. Cir. 1991).

the Jamaican government document; the declaration of Linden Anthony Johnson; and Renee Sinclair's testimony.

Applicant submitted the document of the Jamaican Office of the Registrar of Companies during its rescheduled testimony period. Although the submission was not accompanied by a notice of reliance, the document constitutes an official record under Trademark Rule 2.122(e). And, although applicant characterizes the evidence as "new," the submission by applicant during its scheduled testimony period is permissible. In any event, opposer failed to raise its objection in a timely manner upon submission of the evidence. Rather, opposer waited until the late juncture of filing its reply brief before objecting. Thus, opposer's delay resulted in a waiver of any such objection. *TBMP* §718.02. See also: *TBMP* §527.05.

The declaration of Mr. Johnson originally was submitted in response to opposer's motion for summary judgment. Although evidence filed in connection with such a motion is of record only for purposes of that motion, the evidence may form part of the evidentiary record to be considered at final hearing if it is properly introduced in evidence during the testimony

period. And, declarations may be introduced into evidence by stipulation. Trademark Rule 2.123(b).

In the present case, the Johnson declaration was introduced as exhibit no. 1 to the testimony of his daughter, Renee Lorraine Sinclair. Further, opposer failed to raise any objection to the introduction of the declaration until its reply brief. Thus, we view any objection as being waived, and the declaration forms part of the record for our consideration. The probative weight to be accorded this evidence is, of course, a separate matter.

The testimony of Ms. Sinclair, submitted by a deposition upon written questions, was properly taken and, thus, has been considered. Again, the probative value of the testimony must be weighed as is the case with any testimony before the Board.

In sum, all of applicant's evidence to which opposer objected for the first time in opposer's reply brief is deemed admissible, and the evidence has been considered in reaching our final conclusion.

Opposer was formed as a corporation of Jamaica, West Indies for the purpose of promoting an annual summer festival in Jamaica featuring reggae music. In 1978, the first festival was held and opposer obtained three

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Jamaican registrations for its pleaded mark covering recordings and clothing.

Applicant is a California corporation which is engaged in the promotion and production of reggae concerts in the United States. Applicant was the creation of Linden Anthony Johnson, a former president and member of the board of directors of opposer. Since 1984, concert tours have been held throughout the United States under the mark sought to be registered. Applicant has spent over \$8 million in the promotion and running of the concert tours.

The crux of this controversy involves ownership and priority of use, thus we need not address in detail the likelihood of confusion issue. There is no question but that the contemporaneous use by the parties of their respective marks is likely to cause confusion in the marketplace. The marks are virtually identical, and the goods and/or services sold thereunder are identical in part, and otherwise are closely related. Indeed, applicant does not dispute likelihood of confusion, but rather maintains that opposer cannot prevail on this ground because opposer's rights are inferior to applicant's rights in this country. More specifically, applicant claims that it has priority of use in the

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United States, and that to the extent that opposer had any rights in this country, it abandoned those rights due to nonuse.

Our determination of these issues is complicated by the facts that none of opposer's principals have testified in this case, and that applicant's president, Mr. Johnson, passed away before applicant's testimony period. Opposer, as plaintiff in this proceeding, has the burden of proof to show by a preponderance of the evidence that it is the owner of the pleaded mark and that it has priority such that it can prevail on its likelihood of confusion claim. *Sanyo Watch Co. v. Sanyo Electric Co., Ltd.*, 691 F.2d 1019, 215 USPQ 833, 834 (Fed. Cir. 1982). That is, likelihood of confusion cannot be recognized where one claimed to be aggrieved by that confusion does not have a right superior to his opponent's. *Otto Roth & Co., Inc. v. Universal Foods Corp.*, 640 F.2d 1317, 209 USPQ 40 (CCPA 1981); and *BellSouth Corp. v. Planum Technology Corp.*, 14 USPQ2d 1555 (TTAB 1988).

Mr. Johnson, while living in Jamaica in 1978, was involved with the formation of opposer. He was opposer's president and a member of its board of directors. As indicated above, opposer essentially was formed for the

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purpose of promoting an annual reggae music festival in Jamaica. Opposer, in conjunction with the Jamaica Tourist Board, promoted the 1978 event in the United States in the hope of luring vacationing students to Jamaica. Opposer obtained Jamaican trademark registrations in 1980.

Mr. Johnson moved to the United States in 1983 and, in 1984, he established applicant and applicant began to promote concert tours featuring reggae music, and selling related tour merchandise under the mark sought to be registered. The concerts, part of an annual "Reggae Sunsplash" tour, have been held throughout the country. Over the years, over 250 concerts have been staged by applicant. Applicant has been responsible for all of the tour logistics, from employing the musical groups to arranging travel and lodging plans. According to Mr. Johnson, the sole concert event involving opposer within the United States was a 1988 charitable concert in Miami, Florida held to raise money for hurricane relief efforts in Jamaica. Opposer has never supplied any financial support for the tours rendered by applicant. Mr. Johnson further declared that opposer was on notice of applicant's continuous use of its mark since 1984, and that opposer neither sought to register its mark in the

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United States nor expressed any reservation as to the use of applicant's mark in connection with applicant's concert tours in this country. According to Mr. Johnson, "on numerous occasions, [opposer] has openly admitted that [applicant] owns all rights to the Reggae Sunsplash mark in the United States."

The record establishes, and applicant does not dispute, that opposer was the first to use the mark when it began rendering entertainment services in the nature of concerts in Jamaica 1978. Peter Martin, Desmond Henry and Carmen Tipling, all involved with the marketing of the festival through the Jamaica Tourist Board in the United States, testified that airline tour packages to opposer's festival were sold in the United States during 1978-1980, and that attendees at these early concerts included people from the United States. Prior use of a mark in a foreign country, however, does not entitle its owner to claim exclusive rights in the United States as against one who used a similar mark in the United States prior to entry of the foreigner into the United States market. In the past the Board has stated that

prior use and advertising of a mark in connection with goods or services marketed in a foreign country (whether said advertising occurs inside or outside the United States) creates no priority rights in said mark in the

United States as against one who, in good faith, has adopted the same or similar mark for the same or similar goods or services in the United States prior to the foreigner's first use of the mark on goods or services sold and/or offered in the United States, at least unless it can be shown that the foreign party's mark was, at the time of the adoption and first use of a similar mark by the first user in the United States, a "famous" mark. [citations omitted].

Mother's Restaurants Inc. v. Mother's Other Kitchen, Inc., 218 USPQ 1046, 1048 (TTAB 1983). See also: Linville v. Rivard, 41 USPQ2d 1731 (TTAB 1996), *aff'd*, 133 F.3d 1446, 45 USPQ2d 1374 (Fed. Cir. 1998); and Buti v. Perosa, S.R.L., 139 F.3d 98, 45 USPQ2d 1985 (2nd Cir. 1998).

Here, although opposer commenced use in Jamaica in 1978, applicant was the first to use the mark in the United States when it commenced use in 1984. At most, opposer merely advertised or promoted its foreign festival in the United States. What evidence there is to show opposer's actual use in commerce in the United States (e.g., exhibit no. 11 regarding sales of audio/visual tapes) concerns use long after the date of first use established by applicant. That is to say, when applicant initiated use in the United States, opposer was not using the mark in this country.

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Given Mr. Johnson's prior role with opposer, applicant obviously was aware of opposer's use of the mark in Jamaica. Nevertheless, knowledge of a foreign use does not preclude good faith adoption and use in the United States. *Person's Co. Ltd. v. Christman*, 900 F.2d 1565, 14 USPQ2d 1477, 1480 (Fed. Cir. 1990). There is case law supporting a finding of bad faith where (1) the foreign mark is famous in the United States or (2) the use is a nominal one made solely to block the prior foreign user's planned expansion into the United States. Neither of these circumstances is present here. Admittedly, opposer argues that its mark is famous. And, indeed, the record would suggest that the festival in Jamaica has been successful and that it has been the subject of some publicity in this country. The record, however, falls far short of establishing that opposer's mark is "famous" as contemplated under the case law. Cf.: *Vaudable v. Montmartre, Inc.*, 20 Misc.2d 757, 193 NYS2d 332, 123 USPQ 357 (N.Y. Sup.Ct. 1959).

Our determination in this case is buttressed by the certified document (dated November 10, 1998) issued by the Office of the Registrar of Companies of Jamaica. The document indicates that "[opposer] is not in good standing with regards to the filing of the statutory

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returns due to this office." The registrar indicates that outstanding returns are Annual Returns for 1979-1997 and Declaration of Assets for 1979-1998. Opposer's questionable existence, coupled with the lack of testimony of any of its principals and of evidence of continuous use in the United States, weighs heavily in finding that opposer has failed to sustain its burden of proof in this case.

In reaching our decision, we recognize, of course, the obvious questions raised by the earlier relationship between opposer and applicant's founder, Mr. Johnson. While opposer hints at a breach of fiduciary responsibilities on Mr. Johnson's part, suffice it to say that such a matter is beyond the scope of the Board's jurisdiction.

In sum, we find that opposer has not met its burden of proof on the pleaded claims. The record fails to establish opposer's priority in the United States and that it, not applicant, is the owner of the involved mark in the United States.

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Decision: The opposition is dismissed.

T. J. Quinn

B. A. Chapman

T. E. Holtzman
Administrative Trademark
Judges, Trademark Trial
and Appeal Board