

8/10/01

**THIS DISPOSITION  
IS NOT CITABLE AS PRECEDENT  
OF THE T.T.A.B.**

Paper No. 43  
BAC

**UNITED STATES PATENT AND TRADEMARK OFFICE**

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**Trademark Trial and Appeal Board**  
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**Thomas D. Mills**  
v.  
**Yvonne R. Sewall**  
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Opposition No. 104,398  
to application Serial No. 74/731,584  
filed on **September 20, 1995**  
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**Thomas D. Mills, pro se.**<sup>1</sup>

**H. John Campaign and Charles H. Knull** of Graham, Campaign  
P.C. for **Yvonne R. Sewall.**<sup>2</sup>  
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Before Seeherman, **Chapman and Rogers**, Administrative  
Trademark Judges.

Opinion by **Chapman**, Administrative Trademark Judge:

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<sup>1</sup> Opposer was represented by counsel from the filing of the opposition through the filing of opposer's notices of reliance, at which point opposer revoked the appointment of his initial attorney and law firm and appointed a new attorney and law firm. After the close of all trial dates, opposer filed a revocation of the new power of attorney, and has since proceeded pro se.

<sup>2</sup> Applicant was pro se when she filed her application and throughout the ex parte prosecution thereof. She appointed counsel at the time her answer to the notice of opposition was filed with the Board. About two months later she revoked that power of attorney and appointed new counsel. In the midst of her testimony period as defendant in the opposition, she revoked the new power of attorney and proceeded pro se until June 2000 when she re-appointed her second attorney as counsel of record.

**Opposition No. 104398**

An application has been filed by **Yvonne R. Sewall** (an individual) to register on the Principal Register the mark  
MAX'S KANSAS CITY for "CD-ROMs, phonograph records, audio and video cassette tapes, and compact discs, featuring music and lyrics, poetry, taped interviewed [sic], photographs, narratives and documentaries, about music and art" in International Class 9; "T-shirts and jackets" in International Class 25; and "bar and restaurant services" in International Class 42. The application for all three classes of goods and services is based on applicant's assertion of a bona fide intention to use the mark in commerce.<sup>3</sup>

Thomas D. Mills has opposed the application in all three classes, alleging that since 1975, long prior to the filing date of applicant's application, he has used the mark MAX'S KANSAS CITY in connection with "CD-ROMs, phonograph records, audio and video cassette tapes, and compact discs, featuring music and lyrics, poetry[, ] taped interviewed [sic], photographs, narratives and documentaries, about music and art" in International Class 9, "T-shirts and

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<sup>3</sup> In an Examiner's Amendment, the Examining Attorney entered the following statement into the record: "Section 2(f) In Part--The

**Opposition No. 104398**

jackets" in International Class 25, and "bar and restaurant services" in International Class 42; that by virtue of his continuous use, the mark MAX'S KANSAS CITY indicates the single source of said goods and services to be opposer; that opposer owns application Serial No. 75/096,169, filed April 29, 1996, for the mark MAX'S KANSAS CITY for "prerecorded music and video records, prerecorded cassette tapes, compact disks and CD-ROM disks" in International Class 9<sup>4</sup>; and that applicant's mark, when used on or in connection with her goods and services, would so resemble opposer's previously used mark as to be likely to cause confusion, mistake, or deception.

In her answer applicant admitted "that the services and products to which Opposer claims it [sic] applies or seeks to apply the mark are sold or would be sold to the same class of customers and in the same channels of trade

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applicant claims the benefit of Section 2(f) of the **Trademark Act, 15 U.S.C. §1052(f), in part as to KANSAS CITY.**"

<sup>4</sup> This application is based on opposer's claimed date of first use and first use in commerce of January 1975. Opposer disclaimed "Kansas City." Action on opposer's application Serial No. 75/096,169 has been suspended in Law Office 103.

We note that subsequent to the filing of opposer's notice of opposition (and not added to the pleading by motion to amend), opposer filed on January 20, 1998 application Serial No. 75/420,053, based on opposer's assertion of a bona fide intention to use the mark in commerce, for the mark MAX'S KANSAS CITY for "restaurant, bar, night club and cabaret services."

**Opposition No. 104398**

as those of Applicant. Applicant further admits that, if Opposer were to so use the mark, confusion or mistake among purchaser [sic] will be caused"; and that opposer's application Serial No. 75/096,169 is seriously jeopardized should applicant's application mature into a registration. Applicant otherwise denied the allegations of the notice of opposition, and she also asserted several "affirmative defenses," including a claim that opposer has acquiesced in applicant's use of the mark; that opposer is estopped from objecting to applicant's use of the mark; that opposer's undue delay constitutes laches; and that opposer's failure to use the mark for over fifteen years constitutes an abandonment of whatever rights he may have had.<sup>5</sup>

The record consists of the pleadings; the file of the opposed application; opposer's notices of reliance on (i) applicant's responses to opposer's first set of interrogatories, (ii) applicant's documents produced in response to opposer's first set of document requests,

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Action on this application has also been suspended in Law Office 103.

<sup>5</sup> Applicant did not mention any of her affirmative defenses in her brief on the case, hence, the Board considers acquiescence, estoppel and laches to have been waived. [Specifically, with regard to laches in an opposition proceeding, see National Cable Television Association, Inc. v. American Cinema Editors, Inc., 937 F.2d 1572, 19 USPQ2d 1424 (Fed. Cir. 1991).] The question

**Opposition No. 104398**

(iii) a copy of the file of opposer's application Serial No. 75/096,169, and (iv) the testimony, with exhibits, of opposer, Thomas Dean Mills; applicant's notices of reliance on (i) a copy of the cover and copyright pages from her book, (ii) photocopies of certain pages from the 1997-2000 Manhattan Bell Atlantic/Nynex white pages, (iii) copies of certain pages printed from applicant's website, (iv) a photocopy of the January 12, 1998 decision of the U.S. District Court for the Southern District of New York<sup>6</sup>, and (v) the transcripts of the January 8, 1998 depositions of opposer, Thomas D. Mills, and applicant, Yvonne R. Sewall, taken in the U.S. District Court case.<sup>7</sup>

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of opposer's alleged abandonment of his mark will be discussed later in this decision.

<sup>6</sup> The civil action was Yvonne R. Sewall v. Thomas D. Mills, aka Tommy Dean, Max's Kansas City, Inc., "John Doe", Marivi Wolfe in the United States District Court for the Southern District of New York, Case No. 97 Civ. 8316 (RPP). In the January 12, 1998 decision of the Court, a motion by plaintiff (applicant in this Board proceeding) for a preliminary and permanent injunction was denied.

<sup>7</sup> The deposition transcripts from the U.S. District Court case were submitted pursuant to the stipulation of the parties (signed in September 1999 by their respective counsel); and both were filed under seal as "confidential." Applicant's cover letter accompanying this notice of reliance states that "[T]o the extent that confidential information is disclosed in the depositions, this information is protected by the order of confidentiality in the civil action above." There was no delineation by either party as to precisely what was considered confidential information. Therefore, in our decision we have used discretion in referring to information contained in said depositions which was not otherwise in the record. See Trademark Rule 2.27(d) and(e).

**Opposition No. 104398**

In addition, during opposer's rebuttal testimony period opposer (pro se) filed on July 26, 2000, three separate documents, specifically (i) "opposer's notice of reliance" (on photocopies of a magazine article from 1995, opposer's New York state service mark registration, and a June 25, 1998 letter from the New York Division of Alcohol Beverage Control regarding approval and formal processing of the application of MKC New York LLC for a liquor license), (ii) "opposer's rebuttal brief,"<sup>8</sup> and (iii) "opposer's production of documents in response to applicants [sic] request."

None of these three documents indicates proof of service of a copy thereof on counsel for applicant as required by Trademark Rule 2.119(c). After opposer revoked his latest power of attorney and thereafter went forward pro se in this case, the Board repeatedly advised him of the requirement of complying with the trademark rule on serving the adverse party's attorney, but to no avail. However, it is obvious that applicant's attorney obtained copies of at least the latter two documents either from opposer or by other means because in

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<sup>8</sup> The document titled "rebuttal brief" (but submitted during opposer's rebuttal testimony period) consists primarily of statements made in "rebuttal" to various quoted sections of the January 8, 1998 deposition of Yvonne R. Sewall introduced into the record by applicant.

**Opposition No. 104398**

applicant's brief on the case she objected to both opposer's "rebuttal brief" (and the exhibits attached thereto) and opposer's "production of documents" paper. These two documents have not been made of record as provided by the Trademark Rules of Practice (indeed, a brief on the case after trial does not constitute evidence at all) and they have not been considered by the Board. Even if they had been considered, it would not alter our decision herein. We have, however, considered opposer's notice of reliance.

Opposer's untimely brief submitted on March 19, 2001 was stricken by Board order dated March 28, 2001.<sup>9</sup> Applicant has filed a brief on the case. Neither party requested an oral hearing.

The record shows that an individual named Mickey Ruskin founded a bar and restaurant under the name MAX'S KANSAS CITY in New York City in 1965. It was "the salon of the psychedelic era" where one could mingle with the "underground jet set" including moviemakers, actors, painters, writers, sculptors and singers; and there was

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<sup>9</sup> We note that even if opposer's brief on the case had been considered, the arguments and statements therein would not alter our decision because factual statements made in a party's brief on the case can be given no consideration unless they are supported by evidence properly introduced at trial. See *BL Cars Ltd. v. Puma Industria de Veiculos S/A*, 221 USPQ 1018 (TTAB

**Opposition No. 104398**

live music, frequently by then-unknown artists/musical groups. However, Mickey Ruskin's MAX'S KANSAS CITY bar and restaurant was losing money by 1974, and it closed in December 1974. In 1975 opposer, Thomas D. Mills (aka Tommy Dean) and his partners purchased the bar and restaurant, and reopened it using the name MAX'S KANSAS CITY. This new MAX'S KANSAS CITY bar/restaurant operated from 1976 to 1981. In January 1977 J.M.K.C. Inc. obtained Registration No. 1,135,914 for MAX'S KANSAS CITY for "restaurant and bar services."<sup>10</sup> However, when no Section 8 affidavit of use was filed, the registration was cancelled pursuant to Section 8 of the **Trademark Act**.

Applicant met Mickey Ruskin in 1967, and she worked briefly as a waitress at his MAX'S KANSAS CITY bar/restaurant in the late sixties. Yvonne Sewall and Mickey Ruskin were a couple for about seven years (separating in about 1973), and they had two children together. Mr. Ruskin died in 1983.

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1983); and *Abbott Laboratories v. TAC Industries, Inc.*, 217 USPQ 819 (TTAB 1981). See also, TBMP §706.02.

<sup>10</sup> According to opposer's testimony, the "partners" who purchased the bar/restaurant in 1975 were opposer, his wife (Laura Dean), Joseph Vogel and Murray Lawrence; and that it was this "partnership" that obtained a registration. However, the registration issued to J.M.K.C. Inc. (a corporation of New York). Opposer was the vice president of the corporation and the on-site person at the bar/restaurant.

**Opposition No. 104398**

Opposer submitted under a notice of reliance a copy of the file history of his application Serial No. 75/096,169 for the mark MAX'S KANSAS CITY for goods in International Class 9, including the Office action suspending action on opposer's application pending the outcome of applicant's prior-filed application Serial No. 74/731,584 (the subject of this opposition proceeding). This evidence establishes opposer's standing. See *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1844 (Fed. Cir. 2000); and *Lipton Industries, Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185 (CCPA 1982).

Applicant essentially admitted that there is a likelihood of confusion, and we agree in view of opposer's alleged use of and applicant's intent-to-use application for the identical mark on identical goods and services. Thus, the issue to be decided by the Board is whether opposer has proven prior rights, which are "not abandoned," in the mark MAX'S KANSAS CITY for "CD-ROMs, phonograph records, audio and video cassette tapes, and compact discs, featuring music and lyrics, poetry[,] taped interviewed [sic], photographs, narratives and documentaries, about music and art" in International Class 9, and/or "T-shirts and jackets" in International

**Opposition No. 104398**

Class 25, and/or "bar and restaurant services" in International Class 42.

Section 2(d) of the **Trademark Act** reads, in relevant part, as follows (emphasis added):

No trademark by which the goods of the applicant may be distinguished from the goods of others shall be refused registration on the principal register on account of its nature unless it—

...(d) consists of or comprises a mark which so resembles a mark registered in the Patent and Trademark Office, or *a mark or trade name previously used in the United States by another and not abandoned*, as to be likely, when used on or in connection with the goods of the applicant, to cause confusion, or to cause mistake, or to deceive: ...

In the absence of proof of actual use at an earlier date, and applicant has provided no such evidence, the earliest date of use of the mark MAX'S KANSAS CITY on which applicant can rely for purposes of this proceeding is the filing date of her application, specifically, September 20, 1995, which is deemed to be the constructive use date of her mark for her identified goods and services. See Section 7(c) of the **Trademark Act**.

Some of the testimony submitted in this case is not a model of clarity; however, the record is clear that

**Opposition No. 104398**

after opposer closed MAX'S KANSAS CITY bar/restaurant in 1981, he engaged in no use of the mark MAX'S KANSAS CITY in connection with a bar/restaurant, and he did not reopen any bar/restaurant prior to the filing date of applicant's application. For example, opposer testified as follows in the January 8, 1998 civil action deposition (pp. 54-55):

Q. And could you tell me what your use of the name [MAX'S KANSAS CITY] in the commercial area of restaurants has been?

A. Max's Kansas City, 213 Park Avenue South.

Q. And what years was that restaurant in existence?

A. I believe it was 1975 to 1981 or '82. I think it's '81.

Q. Have you ever operated any other restaurant establishment under that name?

A. No.

Q. Have you owned any other restaurants since 1981?

A. No.

Q. Have you been a part owner of any other restaurant?

A. No.

The record shows that while opposer (as an officer of J.M.K.C., Inc.) was involved in the ownership and use of the mark MAX'S KANSAS CITY for a bar/restaurant from 1975 to 1981, that use completely ceased in 1981. While the record does show some activity in working on reopening a restaurant, all such evidence involves activity after September 20, 1995, the filing date of

**Opposition No. 104398**

applicant's application. Once a person abandons a mark, others are free to claim future possession and property rights therein. See 2 J. Thomas McCarthy, McCarthy on Trademarks and Unfair Competition, §§17:1 and 17:2 (4th ed. 2000). Even assuming opposer as an individual was the owner of the mark MAX'S KANSAS CITY for the bar/restaurant (1975-1981), he abandoned the mark by the cessation of use for at least 15 years; and he testified that he has not used the mark in connection with bar/restaurant services since 1981. Thus, opposer has not established priority with regard to bar and restaurant services.

The record is also clear that opposer has not sold clothing under the mark MAX'S KANSAS CITY since 1984. Specifically, opposer testified as follows in the January 8, 1998 civil action deposition (pp. 17-18):

Q. Okay. Now, aside from your music activity, which you cited, you had no other merchandise or anything that you sold bearing Max's Kansas City; true?

A. Some T-shirts, some jackets that were remnants of inventory that we had, some memorabilia. No storefront or no mail order or no website, no.

Q. Okay. And these items were leftovers—

A. Exactly.

Q. --from your store?

A. Exactly.

Q. Okay

A. No new purchases.

**Opposition No. 104398**

Q. Okay. Did the distribution of these items take place shortly after you closed or when?

A. It -- it was going on for approximately a year and a half to two years.

Q. So sometime to maybe '83, '84 -

A. Exactly.

Q. --when you wound down?

A. Exactly.

Opposer (or the corporation) ceased use of the mark MAX'S KANSAS CITY on clothing items in 1984, and he has not used the mark on or in connection with clothing since that date. Thus, opposer has not established priority with regard to T-shirts and jackets.

The more difficult question before us is the issue of priority as to the goods in International Class 9 (e.g., CD-ROMs, phonograph records, audio and video cassette tapes, and compact discs). There is no question that musicians/bands were featured at MAX'S KANSAS CITY bar/restaurant between 1975 and 1981, some of whom, such as Debra Harry, Blondie, Devo, and the B-52's, later became quite successful. During that time frame of 1975-1981, about \$100,000 dollars per year was spent on advertising the bar/restaurant and promoting the musicians/bands playing there; about 11 record albums were made (most were recorded at studios, but a few were recorded live at MAX'S); and approximately 5000 such recordings were sold, primarily in the United States, in

**Opposition No. 104398**

1981. Opposer testified that between 1975 and 1981 he had 55 separate agreements with performing artists; that these are not current agreements; and that he does not have copies of any of those agreements. (Civil action deposition, p. 45-46.) A "Farewell To Max's" album was released in 1982, and opposer has not issued any further albums under the mark MAX'S KANSAS CITY. There is no evidence of opposer's use of the involved mark on CDs, records or tapes between 1982 and applicant's September 20, 1995 date of constructive use.

Opposer testified regarding use of the mark MAX'S KANSAS CITY that as a record producer, he "continued to stay in the business from a marketing standpoint and re-releasing Max's Kansas City records, looking for new talent, and being very much interested in that portion of Max's Kansas City, not the restaurant business, but the marketing of merchandise, the marketing of records."

(Board proceeding deposition, pp. 18-19.) He also testified in the civil action (pp. 11-12) as follows:

Q. When you closed Max's Kansas City back in 1981 how did you continue to use the trademark Max's Kansas City?

A. Restaurant closed in 1981.

Q. Right.

A. There were some records and licensing agreements that needed to be maintained for the next two years. I was in the studio making a record

**Opposition No. 104398**

called Farewell to Max's which did not come out until 1982.

Q. Okay.

A. That was my only ongoing in 1982.

Q. Okay. And how about in the years subsequent to that, what was the use of the trademark?

A. The use of the trademark basically was in the music industry, which would be licensing agreements.

Opposer testified regarding, and submitted a photocopy of, a licensing agreement dated July 27, 1995 between opposer ("Tommy Dean") and ROIR (Reachout International Records, Inc.). See opposer's exhibit 4. In this six-page agreement opposer grants to ROIR an irrevocable exclusive worldwide license in perpetuity to the "masters."<sup>11</sup> The agreement includes no listing of the "masters" involved, either by artist or by any other means of identification. (The agreement refers to a "Schedule A" listing of the "masters," but it was not included in the exhibits submitted to the Board.) Moreover, there is no reference in the agreement to the mark MAX'S KANSAS CITY. Even assuming this July 27, 1995 contract covers recordings involving the mark MAX'S KANSAS CITY, Paragraph 6 thereof states that "[a]ll recordings made hereunder and all reproductions from the

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<sup>11</sup> "Master recording" is defined in the agreement, and essentially it refers to "the original material object in which sounds are fixed." (Opposer's exhibit 4, p. 4.) That is, the

**Opposition No. 104398**

performances embodied therein and the copyrights therein and thereto shall be entirely [ROIR's] property, free of any claims whatsoever by you or any third party deriving any rights through or from you. Without limitation of the foregoing, [ROIR and its designees] shall have the worldwide right in perpetuity to manufacture ..., to lease ..., to release same under any trademarks, trade names or labels ..., to perform the records or other reproductions publicly ...." This agreement and the testimony related thereto is not sufficient to establish opposer's use of the mark MAX'S KANSAS CITY for recordings prior to September 20, 1995.

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term "master" or "master recording" refers to master recordings from which other copies are made for distribution and sale.

**Opposition No. 104398**

Mr. Mills also testified that he has continuously received royalties from 1976 to 1997, and several documents were introduced into the record relating thereto. Opposer's exhibit 11 is a photocopy of an August 15, 1995 seven-page letter regarding accounting for royalties payable to opposer from a company in England, Beggars Banquet Records Limited, for sales from December 1984 to December 1994 of the "Live At Max's" recording. We do not doubt that opposer has received royalties for this album; however, the problem is that this evidence does not support use or sales in the United States. The other documents relating to this aspect of opposer's claim (generally those attached as exhibits to Mr. Mills' September 17, 1997 testimony in the Board proceeding) include the following: (i) copies of April 18, 1996 and July 22, 1996 royalty statements from ROIR regarding the recording "Heartbreakers Live At Max's," (both royalty statements, opposer's exhibits 5 and 6, state the release date for that recording of "November 17, 1995," a date approximately two months after applicant's filing date); (ii) a two-page advertisement/press release on ROIR letterhead (opposer's exhibit 7) touting, among other recordings, the re-release of "Johnny Thunder & The Heartbreakers 'Live At

**Opposition No. 104398**

Max's Kansas City '79'" scheduled "for release on November 15, 1995"; (iii) several letters either from persons in England to "Tommy Dean," or from "Tommy Dean's" London representative (acting to assist him in recovering past royalties) to various persons/companies in England, or to "Tommy Dean" regarding the money matters in England (opposer's exhibits 8-12) (all of which deal with royalties and use in England, not the United States, some of which are dated after September 20, 1995 - applicant's priority date - and some of which do not specify MAX'S KANSAS CITY or "Live at Max's" or relate in some meaningful way to the mark involved before this Board).

Considering the entire record before us, there is no evidence of opposer's use in the United States of the mark MAX'S KANSAS CITY on CDs, records, and/or tapes between 1982 and September 20, 1995. The July 27, 1995 agreement between ROIR and opposer establishes only that he licensed "masters" to ROIR; it does not establish opposer's use, or any use inuring to opposer's benefit, of the involved mark for CDs, records or tapes. The evidence of opposer's receiving royalties for records (presumably all involving the MAX'S KANSAS CITY mark) relates to sales in the United Kingdom and hence cannot

**Opposition No. 104398**

establish opposer's use in the United States. Opposer has not established, by a preponderance of the evidence, that he has previously used and not abandoned the mark MAX'S KANSAS CITY on CD-ROMs, phonograph records, audio and video cassette tapes, and compact discs. See *Cerveceria Centroamericana, S.A. v. Cerveceria India Inc.*, 892 F.2d 1021, 13 USPQ2d 1307 (Fed. Cir. 1989).

In summary, opposer has not shown prior use that has not been abandoned as to any of the goods or services (in the three involved International Classes 9, 25 and 42). Therefore, although applicant has admitted that confusion would be likely, opposer has not established a necessary element of the likelihood of confusion ground for opposition.

**Decision:** The opposition is dismissed.