

ESTTA Tracking number: **ESTTA94773**

Filing date: **08/15/2006**

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

Proceeding	91169250
Party	Plaintiff 9900 Santa Monica, Inc.
Correspondence Address	Karin Peterka Buchalter Nemer 1000 Wilshire Blvd., Suite 1500 Los Angeles, CA 90017-2457 UNITED STATES kpeterka@buchalter.com, msolmon@buchalter.com
Submission	Motion to Suspend for Civil Action
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Signature	/Matthew S. Solmon/
Date	08/15/2006
Attachments	Friars Club of California - Motion to Stay 91169250.pdf (49 pages)(1856424 bytes)

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

In the matter of Trademark Application Serial Number 76/596,594
For the Mark: **FRIARS CLUB OF CALIFORNIA**

9900 Santa Monica, Inc.)	
a California corporation)	Opposition No. 91169250
)	
Opposer,)	
vs.)	
)	
The Friars National Association, Inc.)	
a New York corporation)	
)	
Applicant.)	
)	

OPPOSER’S MOTION TO SUSPEND PROCEEDINGS

Pursuant to 37 C.F.R. Section 2.117 and TBMP Section 510.02(a), Opposer, 9900 Santa Monica, Inc. (“Opposer”), respectfully requests that the Board suspend the above-captioned proceeding pending disposition of a civil action in the United States District Court for the Central District of California, which was filed by Applicant, The Friars National Association, Inc. (“Applicant”) against Opposer on June 7, 2005. This civil action, *Friars National Association, Inc. v. 9900 Santa Monica, Inc., d/b/a The Friars of Beverly Hills and Darren Schaeffer*, Case No. CV05-4109 ABC (USDC CDCA), is referred to hereinafter as “the Civil Action”. The complaint in the Civil Action is attached hereto as **Exhibit 1**. The answer and counterclaims in the Civil Action are attached hereto as **Exhibit 2**.

Both Opposer and Applicant are parties to the Civil Action, which involves common issues of law and fact that may have a bearing on this proceeding. The Civil Action is currently pending and has not been fully litigated or finally determined. In addition, the parties are involved in pending Opposition No. 91168643 (FRIARS COMEDY CLUB mark) and

Opposition No. 91169185 (FRIARS OF BEVERLY HILLS mark), and similar motions to suspend are being simultaneously filed with the TTAB in those proceedings.

BRIEF IN SUPPORT OF MOTION

As set forth in 37 C.F.R. Section 2.117(a), it provides:

Whenever it shall come to the attention of the Trademark Trial and Appeal Board that a party or parties to a pending case are engaged in a civil action or another Board proceeding which may have a bearing on the case, proceedings before the Board may be suspended until termination of the civil action or the other Board proceeding.

Thus, since the Civil Action filed by Applicant “may have a bearing on” the present opposition proceeding, then the TTAB, in its discretion, may suspend all proceedings in this opposition. Although it is in the discretion of the TTAB to decide whether to suspend the opposition proceeding or not, Section 510.02(a) of the TBMP states, in part:

Ordinarily, the Board will suspend proceedings in the case before it if the final determination of the other proceeding will have a bearing on the issues before the Board.

In other words, it is the ordinary course of the proceedings to be suspended if the lawsuit “will have a bearing on the issues before the Board”. TBMP Section 510.02(a); *General Motors Corp. v. Cadillac Club Fashions, Inc.*, 22 USPQ 2d 1933, 1938 (TTAB 1992) (suspending proceedings in a cancellation proceeding when a decision by a district court in a lawsuit would “be dispositive of the issues before the Board”). The Board should suspend the proceedings herein because the parties are currently engaged in a civil action in the Central District of California that bears directly on the pending proceedings and includes claims that should be dispositive of the issues raised in the pending opposition. See *Whopper-Burger v. Burger King*, 171 USPQ 805; *The Other Telephone Co. v. Connecticut Nat’l Tel. Co.*, 181 USPQ 125; *Tokaido v. Honda Assocs., Inc.*, 179 USPQ 861 (TTAB 1973). The Civil Action involves the issue of whether Opposer’s use of the mark FRIARS OF BEVERLY HILLS is infringing allegedly valid trademarks owned by Applicant (See Exhibits A and B of the Complaint). As such, the issue of

likelihood of consumer confusion is central to the Civil Action. In addition, the pleadings in the Civil Action put directly in issue the validity of several of Applicant's FRIARS marks. Because of the related nature of the claims in the Civil Action, resolution of the Civil Action will almost certainly have a bearing on the issues in this opposition proceeding, and a decision in the Civil Action will almost certainly resolve the current opposition between Opposer and Applicant. Accordingly, the Board should suspend the pending proceeding until termination of the Civil Action between the parties. The final determination of the Civil Action will have a bearing on the issues before the Board, and thus, this opposition should be stayed to avoid duplicating the effort of the District Court and to eliminate the possibility of reaching an inconsistent conclusion.

Wherefore, Opposer respectfully prays that the Board enter an order suspending this opposition proceeding currently pending before the Board pending disposition of the Civil Action between the parties that is currently in the United States District Court for the Central District of California.

Respectfully submitted,
BUCHALTER NEMER
A Professional Corporation

Date: August 15, 2006

By: Karin E. Peterka

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Attorneys for Opposer
9900 Santa Monica, Inc.

CERTIFICATE OF SERVICE

This is to certify that I have this 15th day of August 2006, served Opposer's Motion to Suspend Proceedings, by causing a true and correct copy thereof to be deposited in the United States first class mail, postage prepaid, addressed to Applicant's counsel of record as follows:

Stephen B. Rodner
Pryor Cashman Sherman & Flynn, LLP
410 Park Avenue
New York, NY 10022-4441

Date: August 15, 2006

Name: Margaret Ayers
Margaretta Ayers

EXHIBIT 1

1 STEVEN MORRIS, Esq., SBN 126193
2 TURNER AUBERT & FRIEDMAN, LLP
3 8383 Wilshire Blvd, Suite 510
4 Beverly Hills, CA 90211
5 (323) 653-3900 (Telephone)
6 (323) 653-3021 (Telefax)

7 Jamie M. Brickell (JB 0871)
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9 PRYOR CASHMAN SHERMAN & FLYNN LLP
10 410 Park Avenue, 12th Floor
11 New York, New York 10022
12 (212) 421-4100

13 Attorneys for Plaintiff Friars National Association, Inc.

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FILED

11 UNITED STATES DISTRICT COURT
12 CENTRAL DISTRICT OF LOS ANGELES

CV 05-4109 ABC PLA

13 FRIARS NATIONAL
14 ASSOCIATION, INC.,

15 Plaintiff,

16 - against -

17 9900 SANTA MONICA, INC. d/b/a
18 THE FRIARS OF BEVERLY HILLS
19 and DARREN SCHAEFFER,

20 Defendants.

CASE NO.

COMPLAINT FOR TRADEMARK
INFRINGEMENT; DILUTION OF
SERVICE MARK; AND UNFAIR
COMPETITION

DEMAND FOR JURY TRIAL

21 Plaintiff Friars National Association, Inc., a New York Membership
22 Corporation operating the New York Friars Club ("Plaintiff" or "the Friars Club"), by
23 its attorneys, Turner, Aubert & Friedman, LLP, and Pryor Cashman Sherman & Flynn
24 LLP, as and for its complaint against Defendant 9900 Santa Monica, Inc. d/b/a The
25 Friars of Beverly Hills ("9900 Santa Monica") and defendant Darren Schaeffer
26 ("Schaeffer") (collectively "Defendants"), respectfully alleges as follows:

1 **NATURE OF THE ACTION**

2 1. Plaintiff seeks declaratory relief, injunctive relief and damages based
3 upon trademark infringement, trademark dilution and unfair competition.

4 **THE PARTIES**

5 2. The Friars Club is a New York Membership Corporation, with its
6 principal place of business at 57 East 55th Street, New York, New York.

7 3. Upon information and belief, 9900 Santa Monica is a California
8 corporation, with its principal place of business at 9900 Santa Monica Boulevard,
9 Beverly Hills, California. Upon information and belief, 9900 Santa Monica is a
10 social club and restaurant doing business under the name "The Friars of Beverly
11 Hills."

12 4. Upon information and belief, Schaeffer is the chief executive officer
13 and owner of 9900 Santa Monica and is a conscious, dominant and active force
14 behind the wrongful acts of 9900 Santa Monica complained of herein, which
15 wrongful acts he has engaged in for the gain and benefit of 9900 Santa Monica and
16 for his own individual gain and benefit.

17 **JURISDICTION AND VENUE**

18 5. This action arises under the Lanham Trademark Act of 1946, 15
19 U.S.C. §1051 et seq. (the "Lanham Act"), New York General Business Law §368-
20 d, California Business and Professions Code §§14330 and 17200, et seq, and
21 common law. This Court has subject matter jurisdiction pursuant to 28 U.S.C. §§
22 1331, 1338 and 1367, and the doctrine of supplemental jurisdiction.

23 6. Venue is proper in the Central District of California pursuant to 28
24 U.S.C. §1391 in that, inter alia, defendant Schaeffer resides within this judicial
25 district and defendant 9900 Santa Monica Blvd is a California corporation with its
26 principal place of business within this judicial district.

1 dedicated to promoting the best professional and fraternal relations among its
2 members and restaurant services.” (A copy of Plaintiff’s registration for FRIARS
3 CLUB and Design, Reg. No. 1,578,351, is annexed hereto as Exhibit A.) On
4 March 8, 1995, Plaintiff filed Section 8 and 15 Affidavits. Thus, Plaintiff’s
5 registered mark, FRIARS CLUB and Design, is an incontestable service mark.

6 11. Plaintiff also owns a federal registration for the mark FRIARS CLUB
7 in Class 36 for charitable fundraising services, Class 41 for health club services
8 and Class 42 for “theatrical business, private social club services, restaurant
9 services and health club services.” (A copy of Plaintiff’s registration for FRIARS
10 CLUB, Reg. No. 2,387,620, is annexed hereto as Exhibit B.)

11 **Defendants’ Infringing Conduct**

12 12. Plaintiff brings this action because, among other things, Defendants have
13 been operating a social club and sponsoring entertainment services and events under
14 the name “The Friars of Beverly Hills.”

15 13. On January 30, 2004, Defendants filed a Fictitious Business Name
16 Statement with the Recorder’s Office in Los Angeles County, California in which they
17 indicated that they are doing business under the following names: (1) The Friars of
18 B.H.; (2) The Friars of Beverly Hills; (3) Virgo at the Friars B.H.; (4) Virgo
19 Restaurant; (5) VirgoRestaurant.com; (6) VirgoBistro.com; and (7) VirgoBH.com.
20 (A copy of this Fictitious Business Name Statement is attached hereto as Exhibit C.)

21 14. On or about March 9, 2004, Defendants issued a press release entitled
22 “Successful Entrepreneur to acquire Friars Club of California.” (A copy of this press
23 release is attached as Exhibit D.) In this release, Defendants state that they are
24 operating a social club and restaurant under the name “The Friars of Beverly Hills.”
25 Defendants also indicate their intention to hold celebrity roasts, similar to the world-
26 renown roasts sponsored by the Friars Club.

1 15. Also in March 2004, Defendants publicly announced that The Friars of
2 Beverly Hills would be hosting a "Special Roast Event" on March 13, 2004, which
3 would be taped for inclusion on an NBC primetime show.

4 16. Mr. Schaeffer has registered and is operating the following domain
5 names: www.thefriarsbh.com, www.virgorestaurant.com and www.virgobh.com.
6 When each of these websites is accessed, the user finds the following message:
7 "TheFriarsBH.com. Friars of Beverly Hills is in the process of setting up it's new
8 web site. Until it's finished, you will be re-directed to www.friarsclub-ca.com. You
9 will be automatically transferred to the site in 30 seconds."

10 17. Defendants also have hosted various events under the name "The Friars
11 of Beverly Hills" for which they have solicited attendance by sending fliers to
12 individuals around the United States, including but not limited to individuals in New
13 York. By way of example, these events include "The Friars of Beverly Hills Present
14 Passover at the Friars" on April 5 and 6, 2004 and "Mother's Day at The Friars of
15 Beverly Hills on May 9, 2004."

16 18. In each instance described in paragraphs 13 through 17 above,
17 Defendants are using the FRIARS mark without any license or authorization from
18 Plaintiff, thereby unlawfully appropriating Plaintiff's trademark and good will for its
19 own commercial purposes.

20 19. Upon information and belief, the activities of Defendants complained of
21 herein constitute willful and intentional infringement of Plaintiff's registered
22 trademark and common law trademark rights, are in total disregard of Plaintiff's rights
23 and were commenced and have continued in spite of Defendants' knowledge that the
24 use of the FRIARS trademark was and is in direct contravention of Plaintiff's rights.

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1 Plaintiff's detriment.

2 26. Upon information and belief, Defendants' acts are deliberate and
3 intended to confuse consumers and the public as to the source of Defendants' services
4 and to injure Plaintiff and reap the benefit of Plaintiff's goodwill associated with the
5 Plaintiff's registered marks.

6 27. Defendants' acts violate Section 32(1) of the Lanham Act, 15 U.S.C.
7 §1114(a).

8 28. As a direct and proximate result of Defendants' willful and unlawful
9 conduct, Plaintiff has been injured and will continue to suffer injury to its business
10 and reputation unless Defendants are restrained by this Court from infringing its
11 registered service marks. Plaintiff has no adequate remedy at law.

12 29. In light of the foregoing, Plaintiff is entitled to a preliminary and
13 permanent injunction prohibiting Defendants from using the mark FRIARS OF
14 BEVERLY HILLS for any purpose, and to recover from Defendants all damages that
15 Plaintiff has sustained and will sustain as a result of such infringing acts, and all gains,
16 profits and advantages obtained by Defendants as a result, in an amount not yet
17 known, and the costs and attorneys' fees of this action pursuant to 15 U.S.C. §
18 1117(a).

19 **SECOND CLAIM FOR RELIEF AGAINST DEFENDANTS**

20 **(Trademark Infringement Under**

21 **Section 43(a) of the Lanham Act, 15 U.S.C. § 1125(a))**

22 30. Plaintiff repeats and realleges the allegations contained in paragraphs
23 1 through 29 of the Complaint as if fully set forth herein.

24 31. Plaintiff's FRIARS CLUB mark is entitled to and deserving of
25 protection against the unauthorized use of identical and confusingly similar marks.

26 32. Defendant's adoption and use of the FRIARS OF BEVERLY HILLS
27 mark in conjunction with the operation of a social club and restaurant and the
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1 sponsoring of entertainment services constitute a false designation of origin and a
2 false representation that the social club and restaurant are sponsored, authorized,
3 licensed by or otherwise connected with Plaintiff or come from the same source as
4 Plaintiff's services and are of the same quality as that assured by Plaintiff's
5 FRIARS CLUB mark.

6 33. Defendants' use of Plaintiff's FRIARS CLUB marks, as described
7 above, is without Plaintiff's permission or authority.

8 34. Defendants' activities are likely to lead to and result in consumer
9 confusion, mistake or deception, and are likely to cause consumers and the public
10 to believe that the Friars Club has produced, sponsored, authorized, licensed or is
11 otherwise connected or affiliated with Defendants' commercial and business events
12 and broadcasts, all to the detriment of Plaintiff.

13 35. Upon information and belief, Defendants' acts are deliberate and
14 intended to confuse consumers and the public as to the source of Plaintiff's
15 services and to injure Plaintiff and reap the benefit of Plaintiff's goodwill
16 associated with the Plaintiff's FRIARS CLUB marks.

17 36. Defendants' acts violate Section 43(a) of the Lanham Act, 15 U.S.C. §
18 1125(a).

19 37. As a direct and proximate result of Defendants' willful and unlawful
20 conduct, Plaintiff has been injured and will continue to suffer injury to its business
21 and reputation unless Defendants are restrained by this Court from infringing its
22 FRIARS CLUB mark. Plaintiff has no adequate remedy at law.

23 38. In light of the foregoing, Plaintiff is entitled to preliminary and
24 permanent injunctive relief prohibiting Defendants from using the FRIARS mark
25 for any purpose, and to recover from Defendants all damages that it has sustained
26 and will sustain as a result of such infringing acts, and all gains, profits and
27 advantages obtained by Defendants as a result thereof, in an amount not yet
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1 known, and the costs and attorneys' fees of this action pursuant to 15 U.S.C. §
2 1117(a).

3 **THIRD CLAIM FOR RELIEF AGAINST DEFENDANTS**

4 **(Dilution of Plaintiff's Service Mark**

5 **in Violation of 15 U.S.C. § 1125(c), Lanham Act § 43(c))**

6 39. Plaintiff repeats and realleges the allegations of paragraphs 1 through
7 38 of the Complaint as if fully set forth herein.

8 40. Plaintiff's FRIARS CLUB mark is "famous" within the meaning of
9 Lanham Act § 43(c), 15 U.S.C. § 1125(c).

10 41. Defendants' acts described above have diluted and continue to dilute
11 Plaintiff's unique and distinctive FRIARS CLUB mark. These acts violate Section
12 43(c) of the Lanham Act, 15 U.S.C. § 1125(c), and have injured and, unless
13 immediately restrained, will continue to injure Plaintiff, causing damage to
14 Plaintiff in an amount to be determined at trial, as well as irreparable injury to
15 Plaintiff's goodwill and reputation associated with the value of the FRIARS CLUB
16 mark.

17 42. Upon information and belief, Defendants acted knowingly and
18 deliberately with intent to dilute Plaintiff's FRIARS CLUB mark. Defendants'
19 conduct is willful, wanton and egregious.

20 43. Plaintiff has no adequate remedy at law to compensate it fully for the
21 damages that have been caused and which will continue to be caused by
22 Defendants' unlawful acts, unless they are enjoined by this Court.

23 **FOURTH CLAIM FOR RELIEF AGAINST DEFENDANTS**

24 **(Dilution of Plaintiff's Service Mark**

25 **in Violation of New York General Business Law § 368-d)**

26 44. Plaintiff repeats and realleges the allegations of paragraphs 1 through
27 43 of the Complaint as if fully set forth herein.

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1 45. Defendants' acts described above have diluted and continue to dilute
2 the unique and distinctive quality of Plaintiff's FRIARS CLUB mark. These acts
3 are in violation of New York General Business Law § 368-d and have already
4 injured, and unless immediately restrained, will continue to injure, Plaintiff's
5 goodwill and reputation associated with the FRIARS CLUB mark.

6 46. Plaintiff has no adequate remedy at law to compensate it fully for the
7 damages that have been caused and which will continue to be caused by
8 Defendants' unlawful acts, unless they are enjoined by this Court.

9 **FIFTH CLAIM FOR RELIEF AGAINST DEFENDANTS**

10 **(Dilution of Plaintiff's Service Mark in**

11 **Violation of California Business and Professions Code §14330)**

12 47. Plaintiff repeats and realleges the allegations of paragraphs 1 through
13 46 of the Complaint as if fully set forth herein.

14 48. Defendants' acts described above have diluted and continue to dilute
15 the unique and distinctive quality of Plaintiff's FRIARS CLUB mark. These acts
16 are in violation of California Business and Professions Code §14330 and have
17 already injured, and unless immediately restrained, will continue to injure,
18 Plaintiff's goodwill and reputation associated with the FRIARS CLUB mark.

19 49. Plaintiff has no adequate remedy at law to compensate it fully for the
20 damages that have been caused and which will continue to be caused by
21 Defendants' unlawful acts, unless they are enjoined by this Court.

22 **SIXTH CLAIM FOR RELIEF AGAINST DEFENDANTS**

23 **(Common Law Unfair Competition)**

24 50. Plaintiff repeats and realleges the allegations of paragraphs 1 through
25 49 of the Complaint as if fully set forth herein.

26 51. The Friars Club owns and enjoys common law trademark rights in the
27 mark FRIARS CLUB in New York and throughout the United States. The Friars
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1 Club's rights in the mark FRIARS CLUB are superior to any rights that
2 Defendants may claim in and to the mark FRIARS OF BEVERLY HILLS for any
3 purpose, and especially for the commercial exploitation of the mark FRIARS in the
4 commercial or business entertainment context.

5 52. Defendants' unlawful acts in appropriating rights in Plaintiff's
6 common law FRIARS CLUB mark were intended to capitalize on Plaintiff's
7 goodwill for Defendants' own pecuniary gain. Plaintiff has expended substantial
8 time, resources and effort to obtain its excellent reputation. As a result of
9 Plaintiff's efforts, Defendants are now unjustly enriched and are benefiting from
10 property rights which rightfully belong to Plaintiff.

11 53. Defendants' unauthorized use of Plaintiff's common law FRIARS
12 CLUB mark is likely to cause confusion as to the ownership of the social club in
13 California and set forth above, all to the detriment of Plaintiff.

14 54. Defendants' acts are willful, deliberate, and intended to confuse
15 consumers and the public and injure Plaintiff.

16 55. Defendants' acts constitute unfair competition under New York
17 common law.

18 56. The Friars Club has been irreparably harmed and will continue to be
19 irreparably harmed as a result of Defendants' unlawful acts unless Defendants are
20 preliminarily and permanently enjoined from its unlawful conduct. Plaintiff has no
21 adequate remedy at law.

22 57. In light of the foregoing, Plaintiff is entitled to a preliminary and
23 permanent injunctive relief prohibiting Defendants from using Plaintiff's FRIARS
24 CLUB mark, and to recover all damages that Plaintiff has sustained and will
25 sustain, and all gains, profits and advantages obtained by Defendants as a result of
26 its infringing acts alleged above in an amount not yet known, and the costs of this
27 action.

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1 the effect of falsely representing that the goods and services of Defendants are
2 licensed, authorized by, or in any way associated with Plaintiff;

3 (ii) otherwise infringing Plaintiff's registered service mark and
4 common law FRIARS CLUB mark;

5 (iii) otherwise diluting Plaintiff's FRIARS CLUB mark; and

6 (iv) unfairly competing with Plaintiff; and

7 (2) awarding actual damages suffered by Plaintiff as a result of
8 Defendants' acts; and

9 (3) ordering an accounting by Defendants of all gains, profits and
10 advantages derived from its wrongful acts; and

11 (4) awarding all of Defendants' profits and all damages including lost
12 profits sustained by Plaintiff as a result of Defendants' wrongful acts, and such other
13 compensatory damages as the court determines to be fair and appropriate, pursuant to
14 15 U.S.C. § 1117(a) and California Business and Professions Code §17203; and

15 (5) treble damages in the amount of Defendants' profits or Plaintiff's
16 damages, whichever is greater, for willful infringement pursuant to 15 U.S.C. §
17 1117(b); and

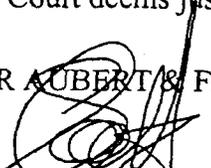
18 (b) on all claims for relief, applicable interest, costs, disbursements and
19 attorneys' fees; and

20 (c) such other and further relief as the Court deems just and proper.

21 Dated: May 31, 2005

TURNER AUBERT & FRIEDMAN, LLP

22
23 By:


24 STEVEN MORRIS
Attorneys for Plaintiff

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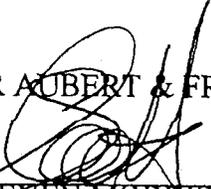
DEMAND FOR JURY TRIAL

Plaintiff hereby demands trial by jury.

Dated: May 31, 2005

TURNER AUBERT & FRIEDMAN, LLP

By:


STEVEN MORRIS
Attorneys for Plaintiff

Ex A

Int. Cl.: 42

Prior U.S. Cl.: 100

United States Patent and Trademark Office

Reg. No. 1,578,351

Registered Jan. 16, 1990

SERVICE MARK
PRINCIPAL REGISTER



FRIARS NATIONAL ASSOCIATION, INC., THE
(NEW YORK CORPORATION)
57 EAST 55TH STREET
NEW YORK, NY 10022

FOR: ASSOCIATION SERVICES, NAMELY
AN ORGANIZATION DEDICATED TO PRO-
MOTING THE BEST PROFESSIONAL AND
FRATERNAL RELATIONS AMONG ITS MEM-
BERS AND RESTAURANT SERVICES, IN
CLASS 42 (U.S. CL. 100).
- FIRST USE 0-0-1935; IN COMMERCE
0-0-1935.

NO CLAIM IS MADE TO THE EXCLUSIVE
RIGHT TO USE "CLUB", APART FROM THE
MARK AS SHOWN.

THE ENGLISH TRANSLATION OF THE
WORDS "PRAE OMNIA FRATERNITAS" IN
THE MARK IS "BROTHERHOOD ABOVE
ALL".

SER. NO. 73-800,332, FILED 5-15-1989.

SUSAN LEE, EXAMINING ATTORNEY



UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office
ASSISTANT SECRETARY AND COMMISSIONER
OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

REGISTRATION NO. 1578351

SERIAL NO. 73/800332

PAPER NO.

MAILING DATE: 12/18/95

MARK: PRAE OMNIA FRATERNITAS FRIARS CLUB

REGISTRANT: FRIARS NATIONAL ASSOCIATION, INC., THE

CORRESPONDENCE ADDRESS:

HOWARD SIEGEL
PRYOR, CASHMAN, SHERMAN & FLYNN
410 PARK AVENUE
NEW YORK, NY 10022

Please furnish the following
in all correspondence:

1. Your phone number and zip code.
2. Mailing date of this action.
3. Affidavit-Renewal Examiner's name.
4. The address of all correspondence not containing fees should include the words "Box 5".
5. Registration No.

RECEIPT IS ACKNOWLEDGED OF THE SUBMITTED REQUEST UNDER:

SECTION 8 OF THE TRADEMARK STATUTE AND 37 CFR SECS. 2.161-2.166.

SECTION 15 OF THE TRADEMARK STATUTE AND 37 CFR SECS. 2.167-2.168.

YOUR REQUEST FULFILLS THE STATUTORY REQUIREMENTS AND HAS BEEN ACCEPTED.

F. A. Pfohl

FRANCES A. PFOHL
AFFIDAVIT-RENEWAL EXAMINER
TRADEMARK EXAMINING OPERATION
(703) 308-9500 EXT. 37

FYI

The United States of America



Nº 1578351

CERTIFICATE OF REGISTRATION

This is to certify that the records of the Patent and Trademark Office show that an application was filed in said Office for registration of the Mark shown herein, a copy of said Mark and pertinent data from the Application being annexed hereto and made a part hereof,

And there having been due compliance with the requirements of the law and with the regulations prescribed by the Commissioner of Patents and Trademarks,

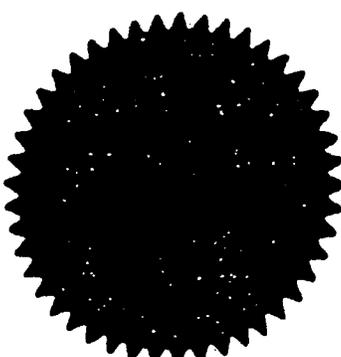
Upon examination, it appeared that the applicant was entitled to have said Mark registered under the Trademark Act of 1946, as amended, and the said Mark has been duly registered this day in the Patent and Trademark Office on the

PRINCIPAL REGISTER

to the registrant named herein.

This registration shall remain in force for TEN years unless sooner terminated as provided by law.

In Testimony Whereof I have hereunto set my hand and caused the seal of the Patent and Trademark Office to be affixed this sixteenth day of January 1990.



Jeffrey M. Savel

Acting Commissioner of Patents and Trademarks

Int. Cls.: 36, 41 and 42

Prior U.S. Cls.: 100, 101, 102 and 107

United States Patent and Trademark Office

Reg. No. 2,387,620

Registered Sep. 19, 2000

**SERVICE MARK
PRINCIPAL REGISTER**

FRIARS CLUB

FRIARS NATIONAL ASSOCIATION, INC., THE (NEW YORK CORPORATION)
57 EAST 55TH STREET
NEW YORK, NY 10022

FOR: CHARITABLE FUNDRAISING SERVICES, IN CLASS 36 (U.S. CLS. 100, 101 AND 102).

FIRST USE 12-31-1904; IN COMMERCE 12-31-1904.

FOR: HEALTH CLUB SERVICES, IN CLASS 41 (U.S. CLS. 100, 101 AND 107).

FIRST USE 12-31-1904; IN COMMERCE 12-31-1904.

FOR: THEATRICAL BUSINESS, PRIVATE SOCIAL CLUB SERVICES, RESTAURANT SERVICES AND HEALTH CLUB SERVICES, IN CLASS 42 (U.S. CLS. 100 AND 101).

FIRST USE 12-31-1904; IN COMMERCE 12-31-1904.

NO CLAIM IS MADE TO THE EXCLUSIVE RIGHT TO USE "CLUB", APART FROM THE MARK AS SHOWN.

SER. NO. 75-775,988, FILED 8-13-1999.

ANDREW BAXLEY, EXAMINING ATTORNEY

The United States of America



CERTIFICATE OF REGISTRATION PRINCIPAL REGISTER

The Mark shown in this certificate has been registered in the United States Patent and Trademark Office to the named registrant.

The records of the United States Patent and Trademark Office show that an application for registration of the Mark shown in this Certificate was filed in the Office; that the application was examined and determined to be in compliance with the requirements of the law and with the regulations prescribed by the Director of the United States Patent and Trademark Office; and that the Applicant is entitled to registration of the Mark under the Trademark Act of 1946, as Amended.

A copy of the Mark and pertinent data from the application are part of this certificate.

This registration shall remain in force for TEN (10) years, unless terminated earlier as provided by law, and subject to compliance with the provisions of Section 8 of the Trademark Act of 1946, as Amended.



A handwritten signature in black ink, appearing to read "L. Towse".

Director of the United States Patent and Trademark Office

Ex C

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04 0224449

RECORDED/FILED IN OFFICIAL RECORDS
RECORDER'S OFFICE
LOS ANGELES COUNTY
CALIFORNIA

2:21 PM JAN 30 2004

TITLE(S) : Fictitious Name Statement



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D.T.T

FEE \$ 22.00

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CODE

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CODE

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CODE

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Assessor's Identification Number (AIN)

To be completed by Examiner OR Title Company in black ink.

Number of Parcels Shown

THIS FORM NOT TO BE DUPLICATED

A MARTIN S. REED, ESQ.
 Name: ANKER, REED, HYMES & SCHREIBER
 Address: 1901 AVENUE OF THE STARS #1100
 City: LOS ANGELES, CA 90067-6002

REGISTRAR - RECORDER / COUNTY CLERK'S FILING STAMP

04 0224449

2

1 First Filing Renewal Filing

PAGE 1 OF 2

FICTITIOUS BUSINESS NAME STATEMENT

THE FOLLOWING PERSON(S) IS (ARE) DOING BUSINESS AS: (Attach additional pages if required)

2 Fictitious Business Name(s)
 1. THE FRIARS OF B.H. 3. VIRGO AT THE FRIARS B. H.
 (See attached list for additional names)
 2. THE FRIARS OF BEVERLY HILLS
 Articles of Incorporation or Organization Number (if applicable)
 AI #/ON

3 Street Address & City of Principal Place of Business in California (P.O. Box alone not acceptable) Zip Code
 9900 SANTA MONICA BOULEVARD BEVERLY HILLS, CA 90212

4 Full name of Registrant (if corporation - incorporated in what state)
 9900 SANTA MONICA, INC. CALIFORNIA

Residence Street Address City State Zip Code
 9900 SANTA MONICA BOULEVARD BEVERLY HILLS, CA 90212

4A Full name of Registrant (if corporation - incorporated in what state)

Residence Street Address City State Zip Code

4B Full name of Registrant (if corporation - incorporated in what state)

Residence Street Address City State Zip Code

5 This Business Is () an individual () a general partnership () joint venture () a business trust
 conducted by: () co-partners () husband and wife () a corporation () a limited partnership
 (check one only) () an unincorporated association other than a partnership () a limited liability company

6 () The registrant commenced to transact business under the fictitious business name or names listed on (Date): JAN. 27, 2004
 () Registrant has not yet begun to transact business under the fictitious business name or names listed herein.

7 I declare that all information in this statement is true and correct.
 (A registrant who declares as true information which he or she knows to be false is guilty of a crime.)

8 Signature of Registrant(s)
 Signature type/print name
 Signature type/print name
 Signature type/print name
 Signature type/print name

8A If Registrant IS a CORPORATION, sign below
 9900 SANTA MONICA, INC.
 Corporation or Company Name
 Signature
 CHIEF EXECUTIVE OFFICER
 Title
 DARREN SCHAEFFER
 Type or Print Name

This statement was filed with the County Clerk of LOS ANGELES County on date indicated by file stamp above.

NOTICE - THIS FICTITIOUS NAME STATEMENT EXPIRES FIVE YEARS FROM DATE IT WAS FILED IN THE OFFICE OF THE COUNTY CLERK. A NEW FICTITIOUS BUSINESS NAME STATEMENT MUST BE FILED PRIOR TO THAT DATE. The filing of this statement does not of itself authorize the use in this state of a fictitious business name in violation of the rights of another under federal, state, or common law (See Section 14411 et seq., Business and Professions Code)

REGISTRAR - RECORDER/COUNTY CLERK
 BUSINESS FILING AND REGISTRATION
 P.O. BOX 83592, LOS ANGELES, CA 90053-0592
 PH: (352) 462-2177

FILING FEE: \$10.00 for 1 FDN and 2 registrants
 plus \$2.00 for each additional FDN/registrant.

THIS FORM SHOULD BE TYPED
 OR PRINTED LEGIBLY IN BLACK INK
 FORM # 7072840-0070 (REV. 10/02)

3

ADDITIONAL FICTITIOUS BUSINESS NAMES
FOR
9900 SANTA MONICA, INC.

4. Virgo Restaurant
5. VirgoRestaurant.com
6. VirgoBistro.com
7. VirgoBH.com

04 0224449

PAGE 2 OF 2

Ex D

March 9, 2004

Successful Entrepreneur to acquire Friars Club of California

The Legendary, Friars Club known the world over for its Roasts, Toasts & Jokes as one of the most exclusive entertainment clubs and societies in the nation, is in process of being acquired by Darren Schaeffer, 38, son of Friars Club Dean, Irwin Schaeffer.

"The Friars of Beverly Hills, as the new name will read, will recapture the incredible glamour where Old Hollywood meets New Hollywood in the very same building that it has lived for 43 years. The Friars will continue its world famous tradition of Roasts, Toasts & Special Events and continue its alignment with charitable organizations" said, Irwin Schaeffer.

The Friars will be a highly prestigious place for members to spend their time in a place where people will be honored to be a member, and proud of The Friars rebirth. There will always be something going on and humor will be reinvented by the finest comedians of our times.

"The Friars will simply become a more grand version of itself, transforming those who frequent into an era that was once lost but now reborn. One can always go to reminisce about an Entertainment era, past & present, surrounded by Friends, Humor, Glamour & Glitz, in First Class" said, Darren Schaeffer

The original memorabilia is to be elegantly and tastefully displayed in order to preserve the roots of the original Friars Club and show the importance of its original vision. Surroundings will be warm & inviting while always being comfortable for a multitude of venues, unequalled in privacy and unique services.

The Friars restaurant, "Virgo" is designed to be a first-class dining establishment and will be available for lunch, dinner as well as cocktails & appetizers throughout the day & into the night. It will be piloted by world renowned chef David Fouts, (Granita, Bamboo, Jimmy's Tavern, Josie) with no less attention than what it truly deserves. "We will put the Friars of Beverly Hills back into the spotlight and Virgo will be at its nucleus, said Fouts.

**Darren Schaeffer
Cell 310-488-5140
Office 310-229-2930**

PRYOR CASHMAN SHERMAN & FLYNN LLP

MEMORANDUM

TO: The File
FROM: Vincent F. Pitta
DATE: June 11, 2004
RE: Cespuglia v. Ward

I received a telephone call this morning while I was out of the office from Michael Mantell, Esq..

I returned the call at 2:45 PM and spoke with Mr. Mantell. Mantell told me that I had not made a counteroffer to his client's settlement proposal of \$250,000 in damages plus reinstatement to his former job and schedule.

I told Mantell that my last offer of \$20,000 plus reinstatement and an accommodation to Cespuglia so that he can work the 6:00 AM – 2:00 PM shift during his baseball season was still on the table.

Mantell told me that my offer was ridiculous and besides which, he had substantial legal fees in the case (which he later specified to be \$14,000). According to Mantell, Cespuglia's family was "driving the train" and they expected that he would get substantial damages "from the Union".

I told him that I probably could get our client to up the \$20,000 to \$30,000 provided Cespuglia waived his right to reinstatement. I also told Mantell I would try to get an additional \$5,000 for his legal fees.

Mantell reacted angrily and he told me that "Ward is going to have to deal with the tape and he'll have to take the stand." Mantell also told me that ... after that happens Ward will get fired ... by the members ... they'll vote him out of office...".

I told Mantell that to date I had requested but was not provided a copy of the tape by him. He told me that he will give us the tape since our discovery demand covered it.

I told him that I was informed by the Funds that Cespuglia's disability benefits were being terminated which he confirmed.

Thereupon we had a discussion concerning the merits of the motion made by us to stay the litigation pending the outcome of the arbitration and the remedies an arbitrator might order. Mantell and I disagreed as to whether the Court would permit the arbitration to go forward.

In closing, Mantell noted that it's obvious the case can't be settled. I told him that it can't be settled for \$250,000, \$200,000 or \$100,000 but it could be settled, provided the settlement amount is realistic, since Mr. Ward will not submit to an extortionate demand by Cespuglia. I told him again that I would recommend a settlement of \$30,000 with some additional monies for Cespuglia as severance, and for legal fees if he waives reinstatement.

Mantell ended the conversation by telling me that he thought the Judge made a mistake by permitting us to make the motion and we'll just have to see what happens.

A handwritten signature in black ink, consisting of stylized initials and a surname, enclosed within a hand-drawn oval. The initials appear to be 'V.P.P.'.

EXHIBIT 2

1 MICHAEL L. WACHTELL (SBN: 47218)
2 JASON FISHER (SBN: 222982)
3 **BUCHALTER NEMER**
4 A Professional Corporation
5 1000 Wilshire Boulevard, Suite 1500
6 Los Angeles, CA 90017-2457
7 Telephone: (213) 891-0700
8 Facsimile: (213) 896-0400

9 Attorneys for Defendants
10 9900 Santa Monica, Inc. and Darren Schaeffer

NOV 14 2015
CENTRAL DISTRICT OF CALIFORNIA

11 **UNITED STATES DISTRICT COURT**
12 **CENTRAL DISTRICT OF CALIFORNIA**

13 **FRIARS NATIONAL ASSOCIATION,**
14 **INC.,**

15 Plaintiff,

16 vs.

17 9900 SANTA MONICA, INC. d/b/a
18 THE FRIARS OF BEVERLY HILLS
19 and DARREN SCHAEFFER,

20 Defendants.

21 9900 SANTA MONICA, INC. d/b/a
22 THE FRIARS OF BEVERLY HILLS
23 and DARREN SCHAEFFER,

24 Counterclaimants,

25 vs.

26 **FRIARS NATIONAL ASSOCIATION,**
27 **INC.,**

28 Counterdefendant.

Case No. CV05-4109 ABC (PLA)

**ANSWER TO COMPLAINT AND
COUNTERCLAIMS OF 9900
SANTA MONICA, INC. AND
DARREN SCHAEFFER**

Defendants and Counterclaimants 9900 SANTA MONICA, INC. d/b/a THE
FRIARS OF BEVERLY HILLS and DARREN SCHAEFFER (collectively "FBH")
BNFY 708320v1

1 or "Defendants"), for themselves alone, answer the Complaint on file herein and
2 counterclaim as follows:

3
4 **ANSWER TO ALLEGATIONS REGARDING**
PARTIES AND GENERAL ALLEGATIONS

5
6 1. Answering paragraphs 1, 2, 5, 7, 8, 9, 10, 11, and 19, Defendants are
7 without sufficient knowledge or information to form a belief as to the truth of the
8 allegations thereon and, on that basis, deny generally and specifically each and
9 every allegation contained therein.

10 2. Answering paragraph 3, Defendants admit that Defendant 9900 Santa
11 Monica, Inc. is a California corporation with its principal place of business at 9900
12 Santa Monica Boulevard. Except as hereinabove specifically admitted and alleged,
13 Defendants deny generally and specifically each and every allegation of
14 paragraph 3.

15 3. Answering paragraph 4, Defendant Darren Schaeffer admits that he is
16 the Chief Executive Officer of 9900 Santa Monica, Inc. Except as hereinabove
17 specifically admitted, Defendants deny generally and specifically each and every
18 allegation of paragraph 4.

19 4. Answering paragraph 6, Defendant Darren Schaeffer admits that he
20 resides within the judicial district of the Central District of California and
21 Defendant 9900 Santa Monica, Inc. (erroneously named in this paragraph as "9900
22 Santa Monica Blvd") admits that it is a California corporation with its principal
23 place of business within this judicial district. Except as hereinabove specifically
24 admitted, Defendants deny generally and specifically each and every allegation of
25 paragraph 6.

26 5. Answering paragraph 12, Defendant 9900 Santa Monica, Inc. admits
27 that it has been operating a social club and sponsoring entertainment services and
28 events under the name "The Friars of Beverly Hills." Except as hereinabove

1 specifically admitted, Defendants deny generally and specifically each and every
2 allegation of paragraph 12.

3 6. Answering paragraph 13, Defendant 9900 Santa Monica, Inc. admits
4 that it filed the Fictitious Business Name Statement attached as Exhibit C to the
5 Complaint. Except as hereinabove specifically admitted, Defendants deny
6 generally and specifically each and every allegation of paragraph 13.

7 7. Answering paragraph 14, Defendant 9900 Santa Monica, Inc. admits it
8 issued a press release entitled "Successful Entrepreneur to acquire Friars Club of
9 California" and refers to the document for the content thereof. Except as
10 hereinabove specifically admitted, Defendants deny generally and specifically each
11 and every allegation of paragraph 14.

12 8. Answering paragraph 15, Defendant 9900 Santa Monica, Inc. admits
13 that it publicly announced that "The Friars of Beverly Hills would be hosting a
14 Special Roast Event on March 13, 2004, which would be taped for inclusion on an
15 NBC primetime show." Except as hereinabove specifically admitted, Defendants
16 deny generally and specifically each and every allegation of paragraph 15.

17 9. Answering paragraph 16, Defendant Darren Schaeffer admits that he
18 has registered the domain names www.thefriarsbh.com, www.virgorestaurant.com,
19 and www.virgobh.com. Except as hereinabove specifically admitted, Defendants
20 deny generally and specifically each and every allegation of paragraph 16.

21 10. Answering paragraph 17, Defendant 9900 Santa Monica, Inc. admits
22 that it has hosted various events under the name "The Friars of Beverly Hills" for
23 which it has solicited attendance by sending fliers to individuals. Defendant 9900
24 Santa Monica, Inc. admits to soliciting for the events "The Friars of Beverly Hills
25 Present Passover at the Friars" and "Mother's Day at the Friars of Beverly Hills."
26 Except as hereinabove specifically admitted, Defendants deny generally and
27 specifically each and every allegation of paragraph 17.

1 18. Answering paragraph 32, Defendant 9900 Santa Monica, Inc. admits
2 that it has adopted and used the term "Friars of Beverly Hills." Except as
3 hereinabove specifically admitted, Defendants deny generally and specifically each
4 and every allegation of paragraph 32.

5 **ANSWER TO THIRD CLAIM**

6 19. Answering paragraph 39, Defendants reallege and incorporate herein
7 by reference each and every allegation, admission and denial set forth in paragraphs
8 1 through 18, above.

9 20. Answering paragraphs 40, 41, and 43, Defendants are without
10 sufficient knowledge or information to form a belief as to the truth of the
11 allegations thereon and, on that basis, deny generally and specifically each and
12 every allegation contained therein.

13 21. Answering paragraph 42, Defendants deny that they acted knowingly
14 and deliberately with intent to dilute Plaintiff's FRIARS CLUB mark. Except as
15 hereinabove specifically admitted, Defendants deny generally and specifically each
16 and every allegation of paragraph 32.

17 **ANSWER TO FOURTH CLAIM**

18 22. Answering paragraph 44, Defendants reallege and incorporate herein
19 by reference each and every allegation, admission and denial set forth in paragraphs
20 1 through 21, above.

21 23. Answering paragraphs 45, and 46, Defendants are without sufficient
22 knowledge or information to form a belief as to the truth of the allegations thereon
23 and, on that basis, deny generally and specifically each and every allegation
24 contained therein.

25 **ANSWER TO FIFTH CLAIM**

26 24. Answering paragraph 47, Defendants reallege and incorporate herein
27 by reference each and every allegation, admission and denial set forth in paragraphs
28 1 through 23, above.

1 38. Plaintiff's alleged service mark was procured through fraud and,
2 therefore, is invalid and its registration should be canceled on that basis.

3
4 **IX. NINTH AFFIRMATIVE DEFENSE**

5 39. The use by Defendants of the name "Friars of Beverly Hills"
6 constitutes a permissible fair use.

7
8 **X. TENTH AFFIRMATIVE DEFENSE**

9 40. Plaintiff is barred from any relief against Defendants based on
10 Defendants' use of the name "Friars of Beverly Hills" in the Southern California
11 geographic market in which Defendant 9900 Santa Monica, Inc., has used the
12 "Friars of Beverly Hills" name in good faith prior to any use in commerce by
13 Plaintiff of in that geographic or competitive market.

14
15 **XI. ELEVENTH AFFIRMATIVE DEFENSE**

16 41. Plaintiff's use of its alleged service mark is limited to the New York
17 region.

18 **XII. TWELFTH AFFIRMATIVE DEFENSE**

19 42. Plaintiff does not have exclusive rights to the term "FRIARS."

20
21 **XIII. THIRTEENTH AFFIRMATIVE DEFENSE**

22 43. Defendants are not amenable to the jurisdiction of the state of New
23 York or its laws.

24 **XIV. FOURTEENTH AFFIRMATIVE DEFENSE**

25 44. There is no likelihood of confusion between Plaintiff and Defendants.
26
27
28

1
2 **COUNTERCLAIMS**

3 The following counterclaim is brought by Defendants and Counterclaimants
4 9900 Santa Monica, Inc. and Darren Schaeffer against Plaintiff and
5 Counterdefendant Friars National Association, Inc. ("NY FRIARS") alleges as
6 follows:

7 45. This action arises under the laws of the United States. This Court has
8 federal question jurisdiction over this matter pursuant to 28 U.S.C. § 1331 and
9 § 1338.

10 46. Venue is proper in this Court pursuant to the allegations of Plaintiff's
11 Complaint and 28 U.S.C. § 1391 in that Plaintiff brought suit in this Court.

12 47. Counterclaimants allege and incorporate herein by reference each and
13 every allegation, admission and denial set forth in paragraphs 1 through 36, *supra*
14 and apply them as well as paragraphs 37 through 38 to all claims, *infra*.

15 **FIRST CLAIM**

16 **(Fraud)**

17 48. On May 17, 1999, NY FRIARS filed a lawsuit in the Southern District
18 of New York, against Friars Club of California, Inc. ("FCC") for, *inter alia*,
19 trademark infringement, entitled *Friars National Association v. Friars Club of*
20 *California*, numbered 99 Civ 3615 (JGK). On or about February 18, 2000,
21 Plaintiff and FCC settled this litigation (the "Settlement"). One of the express
22 terms of the settlement was that Plaintiff would "immediately withdraw its pending
23 trademark applications." These applications included "Friars Frolic" (Serial No.
24 75/776052), "Friars Club Celebrity Roast" (Serial No. 75/775684), and "Friars
25 Club" (Serial No. 75/775988).

26 49. On or about March 13, 2000, Jamie Brickell, counsel for NY FRIARS,
27 wrote a letter with enclosures of letters and express abandonments of the three
28

1 above mentioned applications purported to be sent to the Assistant Commissioner
2 of Trademarks. FCC was satisfied that the applications would not move forward
3 based on its reasonable reliance on NY FRIARS' counsel's representation that the
4 enclosures were mailed to the Assistant Commissioner of Trademarks.

5 50. The application for "Friars Club Celebrity Roast" was properly
6 withdrawn as per the Settlement, but the applications for "Friars Club" and "Friars
7 Frolic" were never properly withdrawn.

8 51. NY FRIARS did NOT withdraw its applications as per the Settlement.
9 NY FRIARS fraudulently pursued the applications for "Friars Club" and "Friars
10 Frolic" and obtained registrations thereon.

11 52. On or about September 19, 2000, the mark "Friars Club" was
12 registered (Registration number 2,387,620) by the U.S.P.T.O.

13 53. On or about November 14, 2000, the mark "Friars Frolic was
14 registered (Registration number 2,403,841) by the U.S.P.T.O.

15 54. In or about February 2004, Counterclaimant 9900 Santa Monica, Inc.
16 purchased the assets of FCC relying on the Settlement and (along with
17 Counterclaimant Darren Schaeffer) as such is a third party beneficiary, thereunder.

18 55. At the time NY FRIARS entered into the Settlement they had no
19 intention of performing their responsibilities thereunder. They entered into the
20 Settlement with the intent to defraud FCC and not abandon their applications. At
21 the time the Settlement was entered into, FCC was ignorant of the NY FRIARS'
22 secret intention not to perform its obligations under the Settlement. NY FRIARS
23 failed to abide by its obligations under the Settlement and pursued the applications
24 through the time they became registrations.

25 56. The aforementioned conduct of NY FRIARS was an intentional act
26 done with the intention on the part of NY FRIARS of depriving FCC and any and
27 all successors in interest and/or third party beneficiaries (collectively "Injured
28 Parties") of property or legal rights or otherwise causing injury, and was despicable

1 conduct that subjected the Injured Parties to a cruel and unjust hardship in
2 conscious disregard of Injured Parties' rights and interests, so as to justify an award
3 of exemplary and punitive damages.

4 57. As a proximate result of the fraudulent conduct and omission of the
5 NY FRIARS as herein alleged, the Counterclaimants have been damaged as third
6 party beneficiaries of the Settlement.

8 SECOND CLAIM

9 **(Cancellation of "Friars Club" and "Friars Frolic" Registration)**

10 58. According to the U.S.P.T.O. records, NY FRIARS has received U.S.
11 Registration No. 2,387,620 for the service mark "Friars Club", issued on September
12 19, 2000, for "charitable fundraising services" (IC 036), "health club services" (IC
13 041), and "theatrical business, private social club services, restaurant services and
14 health club services" (IC 042) provided that no claim is made to the exclusive right
15 to use "Club" apart from the mark as shown.

16 59. According to the U.S.P.T.O. records, NY FRIARS has received U.S.
17 Registration No. 2,403,841 for the service mark "Friars Frolic", issued on
18 November 14, 2000, for "Entertainment services, namely, a series of live variety
19 and comedy shows." (IC 041).

20 60. Counterclaimants believe that they are being damaged by the
21 continued registrations of Registration No.'s 2,387,620 and 2,403,841 and hereby
22 petition to cancel same.

23 61. The registrations for "Friars Club" and "Friars Frolic" were procured
24 by defrauding the U.S.P.T.O. and all Injured Parties.

25 62. Based upon the foregoing and the allegations and requests for relief
26 made by Plaintiff against Defendants in Plaintiff's Complaint, Crosscomplainants
27 are and will continue to be damaged by the continued registration of Registration
28 No.'s 2,387,620 and 2,403,841.

1 63. Defendants therefore request that Registration No.'s 2,387,620 and
2 2,403,841 be cancelled pursuant to 15 U.S.C. § 1064.

3 WHEREFORE, Defendants and Counterclaimants pray judgment as follows:

- 4 1. That Plaintiff take nothing by its Complaint and the same be
5 dismissed;
- 6 2. For damages based on the Counterclaims to be proven at trial;
- 7 3. For punitive damages based on the Counterclaims to be proven at trial;
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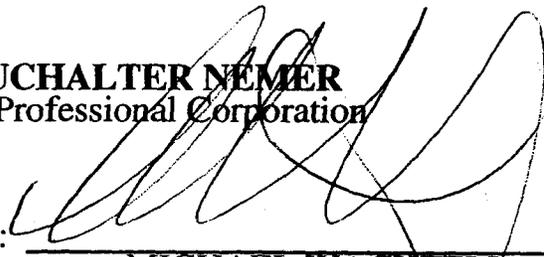
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- 4. For a finding that U.S. Registration No.'s 2,387,620 and 2,403,841 were procured through fraud and an order canceling said registration;
- 5. For an award of attorneys' fees pursuant to 15 U.S.C. § 1117;
- 6. For costs of suit herein; and
- 7. For such other and further relief as to the Court may seem just and proper.

DATED: November 14, 2005

BUCHALTER NEMER
A Professional Corporation

By: 

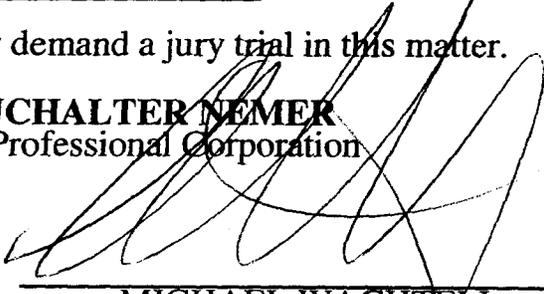
MICHAEL WACHTELL
JASON H. FISHER
1000 Wilshire Boulevard, Suite 1500
Los Angeles, CA 90017-2457
Telephone: (213) 891-0700
Attorneys for Defendant

DEMAND FOR JURY TRIAL

Defendants and Counterclaimants hereby demand a jury trial in this matter.

DATED: November 14, 2005

BUCHALTER NEMER
A Professional Corporation

By: 

MICHAEL WACHTELL
JASON H. FISHER
1000 Wilshire Boulevard, Suite 1500
Los Angeles, CA 90017-2457
Telephone: (213) 891-0700
Attorneys for Defendant

1 **PROOF OF SERVICE**

2
3 I am employed in the County of Los Angeles, State of California. I am over the age of 18
4 and not a party to the within action. My business address is at BUCHALTER NEMER, A
5 Professional Corporation, 1000 Wilshire Boulevard, Suite 1500, Los Angeles, California 90017.-

6 On the date set forth below, I served the foregoing document described as:

7 **ANSWER TO COMPLAINT AND COUNTERCLAIMS OF 9900 SANTA**
8 **MONICA, INC. AND DARREN SCHAFFER**

9 on all other parties and/or their attorney(s) of record to this action by _____ faxing and/or
10 X placing a true copy thereof in a sealed envelope as follows:

11 Jamie M. Brickell
12 Pryor Cashman Sherman & Flynn
13 410 Park Avenue, Suite 910
14 New York, NY 10022

15 Ronald A. Giller
16 Pryor Cashmn Sherman & Flynn
17 410 Park Avenue, 12th Floor
18 New York, NY 10022

19 Steven A. Morris
20 Turner Aubert & Friedman
21 8383 Wilshire Boulevard, Suite 510
22 Beverly Hills, CA 90210

23 **BY MAIL** I am readily familiar with the business' practice for collection and processing
24 of correspondence for mailing with the United States Postal Service. The address(es) shown above
25 is(are) the same as shown on the envelope. The envelope was placed for deposit in the United
26 States Postal Service at Buchalter, Nemer, Fields & Younger in Los Angeles, California
27 November 11, 2005. The envelope was sealed and placed for collection and mailing with first-
28 class prepaid postage on this date following ordinary business practices.

I declare that I am employed in the office of a member of the bar of this court at whose
direction the service was made. Executed on November 11, 2005 at Los Angeles, California.

Barbara J. Young


(Signature)