

ESTTA Tracking number: **ESTTA403963**

Filing date: **04/15/2011**

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

Proceeding	91194292
Party	Plaintiff Larry Marshak
Correspondence Address	WILLIAM DUNNEGAN DUNNEGAN LLC 350 FIFTH AVENUE NEW YORK, NY 10118 UNITED STATES wd@dunnegan.com, lmar558636@aol.com
Submission	Motion to Suspend for Civil Action
Filer's Name	William Dunnegan
Filer's e-mail	wd@dunnegan.com, ea@dunnegan.com, ls@dunnegan.com
Signature	/William Dunnegan/
Date	04/15/2011
Attachments	Motion to Suspend 041511.pdf (4 pages)(122202 bytes) Ex A Complaint for Filing.pdf (13 pages)(315587 bytes) Declaration of Service.pdf (1 page)(4943 bytes)

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

In the Matter of Application Serial No. 77/550,496

Published in the Official Gazette on February 9, 2010

Mark: THE MARVELETTES

-----X
LARRY MARSHAK, :
 :
 :
 Opposer, :
 :
 :
 -against- : Opposition No. 91194292
 : Serial No. 731108367
 KATHERINE SCHAFFNER, :
 GLADYS HORTON, :
 :
 Applicants. :
 :
 :
-----X

AMENDED MOTION TO SUSPEND THE PROCEEDINGS

Pursuant to the order of Interlocutory Attorney Elizabeth J. Winter, dated April 12, 2011, 37 CFR § 2.117(a) and TBMP § 510.02(a), opposer Larry Marshak hereby requests that the Trademark Trial and Appeal Board suspend this proceeding until the final determination of *Larry Marshak v. Katherine Schaffner, and John Doe as the Executor of the Estate of Gladys Horton.*, 11 Civ.1104 (DLC) (the “Civil Action”), because the outcome of the Civil Action will control the result the instant proceedings.

FACTUAL BACKGROUND

On information and believe, at least as early as 1961, Motown Records used the mark THE MARVELETTES in connection with live and recorded performances by a musical group. In 1973 Motown assigned to Marshak its rights to the mark THE MARVELLETTES (sometimes inadvertently spelled "MARVELETTES"), for live performances and limited live recordings, as well as the goodwill associated with that mark. Marshak thereafter used the mark THE MARVELLETTES in interstate commerce in connection with live entertainment services. In 1978, Marshak received from the United

States Patent and Trademark Office Registration No. 1,081,340 for the mark THE MARVELLETTES. Marshak renewed the registration on May 17, 1998. To further secure his rights in the mark THE MARVELLETTES, on or about December 14, 1994, Marshak obtained an assignment from Gladys Horton of all her right, title and interest to the mark THE MARVELLETTES. As part of that assignment, Horton "agreed to the entry of an order of permanent injunction, in any court of competent jurisdiction enjoining her, her agents, servants and employees from representing to any third-party, directly or indirectly that she has the right to use the name or mark THE MARVELLETTES to identify any musical performing group other than a musical performing group controlled by Larry Marshak and Gladys Horton will not knowingly authorize any third party to represent that Gladys Horton or her performing group are THE MARVELLETTES."

Schaffner, upon information and belief, in or about 1970, abandoned any rights that she had in the mark THE MARVELLETTES by ceasing to use the mark with the intention not to resume use of the mark.

Since acquiring the THE MARVELLETTES mark and the goodwill associated with it in 1973, Marshak has promoted performances under the mark THE MARVELLETTES across the United States. Marshak invests significant monies to organize and promote performances under the mark THE MARVELLETTES. Marshak, for example, makes substantial investments in searching for appropriate forums for performances, negotiating the terms of the performances, ensuring appropriate practice space for the performers, seeking out strategic advertisement for the performances, negotiating the cost of tickets for the performances, hiring and training personnel to perform in the group, hiring and training back up musicians to perform with the group, creating the content of the show, selecting the group's performance material, selecting professional staff of choreographers and vocal coaches to train the group, selecting costumes and uniforms and overseeing the groups general, professional demeanor. In 2008, Marshak inadvertently let his United States mark registration lapse. He nevertheless continued to

use the mark THE MARVELETTES without interruption in the United States to organize and promote musical performances.

To protect his rights in the THE MARVELETES mark, Marshak on February 18, 2011, filed a complaint with the United States District Court of the Southern District of New York, alleging that Schaffner and the executor of the Estate of Gladys Horton's use of the THE MARVELETTES designation constitutes false designation of origin under the Lanham Act, 15 U.S.C. §1125(a), common law unfair competition under New York State law, deceptive business practice under New York General Business Law Art. 22-A § 349, and intentional interference with prospective economic relations. A copy of the complaint is annexed hereto as Exhibit A.

ARGUMENT

The determination in the Civil Action will control the outcome of the issues before the Board. Where a party to a case pending before the Board is also involved in a civil action that may have a direct bearing on a TTAB matter, the Board may suspend the proceeding until the final determination of the civil action. 37 CFR §2.117(a); TBMP 510.02(a). This is because "a decision by the United States District Court would be binding on the Patent Office whereas a determination by the Patent Office as to respondent's right to retain its registration would not be binding or res judicata in respect to the proceeding before the federal district court." *Whopper-Burger, Inc., v. Burger King Corp.*, 171 U.S.P.Q. 805, 807 (TTAB 1971).

Applicants and opposer are both parties to the Civil Action, which involves the mark that is at issue in the instant proceeding, as well as claims for other relief. In that case, the district court will determine the rights of Marshak, Schaffner and the estate of Horton, with respect to the THE MARVELETTES mark and the THE MARVELETTES designation. This type of determination will directly affect the resolution of the issues before the Board. Further proceedings in this matter are therefore unnecessary.

Based on the foregoing, opposer respectfully requests that the Board stay this proceeding pending

the final determination of the Civil Action.

Dated: New York, New York
April 15, 2011

Respectfully submitted,

DUNNEGAN LLC

By /William Dunnegan/
William Dunnegan
wd@dunnegan.com
Samantha Morrissey
sm@dunnegan.com
Attorneys for Opposer
Larry Marshak
New York, New York 10118
(212) 332-8300

UNITED STATES DISTRICT COURT
SOUTHERN DISTRICT OF NEW YORK

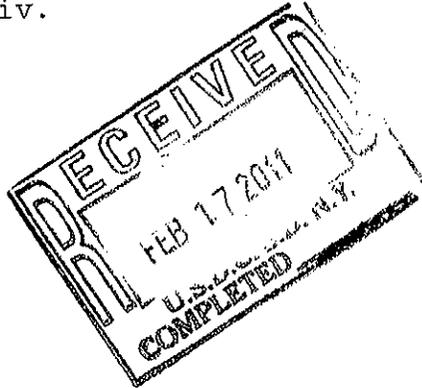
----- x

LARRY MARSHAK, :
 :
 Plaintiff, :
 :
 -against- :
 :
 KATHERINE SCHAFFNER, AND JOHN :
 DOE AS THE EXECUTOR OF THE :
 ESTATE OF GLADYS HORTON, :
 :
 Defendants. :

JUDGE COTE

11 CV 1104

11 Civ.



----- x

COMPLAINT

Plaintiff Larry Marshak ("Marshak"), by his undersigned attorneys, for his complaint against defendants, avers:

Nature of the Action

1. Marshak is bringing this action to enforce his common law rights in the mark THE MARVELLETTES, and to seek injunctive relief and damages resulting from the unlawful use of that mark by defendants Katherine Schaffner ("Schaffner") and John Doe, as the Executor of the Estate of Gladys Horton ("Horton").

Jurisdiction and Venue

2. This Court has subject matter jurisdiction over the first claim in this action pursuant to 28 U.S.C. § 1331 because it arises under 15 U.S.C. § 1125(a).

3. In addition, this Court has subject matter jurisdiction pursuant to 28 U.S.C. § 1332 over the remaining claims because there is complete diversity of citizenship between Marshak, a citizen of the State of New York, and Schaffner and Horton, upon information and belief citizens of the State of Michigan, and because the amount in controversy exceeds \$75,000 exclusive of interest and costs.

4. Upon information and belief, venue is proper in this District pursuant to 28 U.S.C. §§ 1391 and 1400.

Parties

5. Marshak is a natural person residing at 69-41 261st Street, Floral Park, New York 11004-1101.

6. Upon information and belief, Schaffner is a natural person residing at 27071 Hopkins Street, Inkster, Michigan 48141-3115.

7. Upon information and belief, John Doe is a natural person whose identity and address is currently unknown.

Marshak's Common Law Mark

8. Upon information and belief, at least as early as 1961, Motown Records used the mark THE MARVELLETTES in connection with live and recorded performances by a musical group.

9. In 1973, Motown assigned to Marshak its rights to the mark THE MARVELLETTES (sometimes inadvertently spelled

"MARVELETTES"), for live performances and limited live recordings, as well as the goodwill associated with that mark. Marshak thereafter used the mark THE MARVELLETTES in interstate commerce in connection with live entertainment services.

10. In 1978, Marshak received from the United States Patent and Trademark Office Registration No. 1,081,340 for the mark THE MARVELLETTES. Marshak renewed the registration on May 17, 1998.

11. To further secure his rights in the mark THE MARVELLETTES, on or about December 14, 1994, Marshak obtained an assignment from Gladys Horton of all her right, title and interest to the mark THE MARVELLETTES. As part of that assignment, Horton "agreed to the entry of an order of permanent injunction, in any court of competent jurisdiction enjoining her, her agents, servants and employees from representing to any third-party, directly or indirectly that she has the right to use the name or mark THE MARVELLETTES to identify any musical performing group other than a musical performing group controlled by Larry Marshak and Gladys Horton will not knowingly authorize any third party to represent that Gladys Horton or her performing group are THE MARVELLETTES."

12. Schaffner, upon information and belief, in or about 1970, abandoned any rights that she had in the mark THE

MARVELLETTES by ceasing to use the mark with the intention not to resume use of the mark.

13. Since acquiring the mark THE MARVELLETTES and the goodwill associated with it in 1973, Marshak has promoted performances under THE MARVELLETTES mark across the United States and in the State of New York.

14. Marshak invests significant monies to organize and promote performances under the mark THE MARVELLETTES. Marshak, for example, makes substantial investments in searching for appropriate forums for performances, negotiating the terms of the performances, ensuring appropriate practice space for the performers, seeking out strategic advertisements for the performances, negotiating the cost of tickets for the performances, hiring and training personnel to perform in the group, hiring and training back up musicians to perform with the group, creating the content of the show, selecting the group's performance material, selecting professional staff of choreographers and vocal coaches to train the group, selecting costumes and uniforms and overseeing the group's general, professional demeanor.

15. Marshak earns substantial revenue from the performances he promotes under the mark THE MARVELLETTES, he would suffer serious and incalculable financial injury if his rights in THE MARVELLETTES mark were not enforced.

16. Marshak ensures that the performances he organizes and promotes under THE MARVELLETTES mark are of high quality. If defendants continue to promote performances under THE MARVELLETTES mark without Marshak's consent, Marshak would not have the ability to control the quality of those performances, and the goodwill associated with his mark would suffer.

17. In 2008, Marshak inadvertently let his United States mark registration lapse. He nevertheless continued to use the mark THE MARVELLETTES without interruption in the United States and in New York to organize and promote musical performances.

The Unlawful Acts Of Defendants

18. On or about August 19, 2008, defendants filed as joint owners an application with the United States Patent and Trademark Office for the mark THE MARVELLETTES.

19. Defendants have recently entered into contracts to provide services under the mark THE MARVELLETTES, including services in this State.

20. Horton has, upon information and belief, authorized a third party to interfere with the prospective economic relations of Marshak with agents and potential venues for performances of acts under the mark THE MARVELETTES.

FIRST CLAIM FOR RELIEF

(False Designation Of Origin - 15 U.S.C. § 1125(a))

21. Marshak repeats the averments contained in paragraphs 1 through 20 above as if set forth in full.

22. Defendants' conduct aforesaid constitutes a violation of 15 U.S.C. § 1125(a), by the infringement of Marshak's aforementioned valid, protectable and distinctive mark THE MARVELLETTES. The use in the United States of the mark THE MARVELLETTES in connection with a musical performance or appearance by a musician by any party other than Marshak falsely designates the origin of those services and constitutes an infringement of Marshak's protectable and distinctive ownership of the mark used to promote musical performances.

23. Defendants' wrongful acts, including their use in commerce in the United States of the mark THE MARVELLETTES, is likely to cause confusion, mistake or deception as to the source or sponsorship of Defendants' services. Such acts falsely represent that Defendants' services or commercial activities are authorized, sponsored or approved of by Marshak, when in fact they are not. Such conduct is a violation of 15 U.S.C. § 1125(a).

24. Defendants' violation has been and remains willful, intentional and deliberate.

25. Defendants' conduct is causing and threatens to cause Marshak irreparable injury, and leaves Marshak without an adequate remedy at law as a consequence of Defendants' conduct. Accordingly, Marshak is entitled to, inter alia, injunctive relief.

26. Marshak has been and threatens to continue to be materially, immediately and irreparably injured by Defendants' conduct in that there is a likelihood of confusion, and/or Defendants have, and threaten to continue to cause confusion among members of the trade and the public including ticket-buyers, forum hosts and promoters, thereby threatening to and/or actually causing damage to the goodwill developed by Marshak. Marshak is without an adequate remedy at law.

27. Marshak is entitled to an injunction against Defendants' use of the mark THE MARVELLETTES in commerce, as well as damages for any unlawful use.

SECOND CLAIM FOR RELIEF

(Common Law Unfair Competition Under State Law)

28. Marshak repeats the averments contained in paragraphs 1 through 27 above as if set forth in full.

29. Marshak owns the common law rights in the mark THE MARVELLETTES.

30. Upon information and belief, Defendants' use of the mark THE MARVELLETTES has caused and threatens to continue

to cause, confusion, mistake and/or deception in the minds of members of the trade and of the public, including ticket-buyers, forum hosts and promoters.

31. Defendants' wrongful conduct constitutes misappropriation of the goodwill created and developed by Marshak in the mark THE MARVELLETTES, giving Defendants an unfair competitive advantage by allowing them to wrongfully ride on the efforts and monies Marshak has expended to make the mark valuable and marketable.

32. Defendants' continued free-riding upon the goodwill created by Marshak, through the use of the mark THE MARVELLETTES is an infringement of rights of Marshak at common law.

33. Marshak has been and threatens to continue to be materially, immediately, and irreparably injured by Defendants' conduct because, upon information and belief, Defendants have, and threaten to continue to cause confusion among members of the trade and the public, including ticket-buyers, forum hosts and promoters, thereby damaging the goodwill developed by Marshak. Marshak is without an adequate remedy at law.

34. Marshak is entitled to an injunction against Defendants' use of the mark THE MARVELLETTES in commerce, as well as damages for any unlawful use.

THIRD CLAIM FOR RELIEF

(New York General Business Law Art. 22-A § 349)

35. Marshak repeats the averments contained in paragraphs 1 through 34 above as if set forth in full.

36. Defendants' conduct aforesaid was, is, and remains willful and constitutes deceptive acts and practices in the conduct of its business, trade and commerce and in the furnishing of services in New York. Said conduct is unlawful under N.Y. Gen. Bus. L. Art. 22-A § 349, and Marshak is therefore entitled to an injunction and damages.

FOURTH CLAIM FOR RELIEF

(Intentional Interference With Prospective Economic Relations)

37. Marshak repeats the averments contained in paragraphs 1 through 36 above as if set forth in full.

38. In and before April 2010, Marshak, and his booking agent, Gary Reynolds, had negotiated with the Wildwood, New Jersey Chamber of Commerce to book a group performing under the mark THE MARVELETTES at the Convention Center in Wildwood, New Jersey on or about October 16, 2010.

39. During those negotiations, Corky Warren ("Warren") contacted representatives of the Wildwood, New Jersey Chamber of Commerce, and Marshak's regular booking agent, Gary Reynolds. Upon information and belief, Warren represented to them that (a) allowing Marshak to provide a group performing under the mark THE MARVELLETTES would violate the law, (b) if

they continued to promote the performance, the Attorney General of the State of New Jersey would commence a criminal prosecution against them and that Gladys Horton would commence a civil action against them for violating New Jersey's Truth in Music Act, and (c) a group featuring Horton would be available for the engagement.

40. Upon information and belief, on or about June 2, 2010, Warren contacted another regular booking agent of Marshak, Mike Dano of Creative Entertainment of New Jersey, and a representative of the Pitman Theater in Pitman, New Jersey. Upon information and belief, in connection with a booking at the Pittman Theatre, Warren represented that (a) allowing Marshak to provide a group performing under the mark THE MARVELLETTES would violate the law and (b) if they continued to promote the performance, the Attorney General of the State of New Jersey would commence a criminal prosecution against them and that Gladys Horton would commence a civil action against them for violating New Jersey's Truth in Music Act.

41. Upon information and belief, Warren approached the representatives of the Wildwood, New Jersey Chamber of Commerce, and the Pitman Theatre, as well as Marshak's booking agents, with the authorization of Horton, who is therefore liable for his tortious conduct.

42. As a result of the tortious conduct described above, Marshak's regular booking agents have ceased booking his acts, believing that it is not worth the aggravation. Marshak as a result has suffered the loss of revenue that he would have derived from the future efforts of his booking agents Gary Reynolds and Mike Dano.

43. Marshak is therefore entitled to recover damages from Horton in an amount to be determined at the trial of this action.

WHEREFORE, plaintiff demands judgment:

A. Preliminarily and permanently enjoining defendants, their agents, servants, employees, and attorneys and all those acting in concert with them from infringing THE MARVELLETTES mark in violation of 15 U.S.C. § 1125(a), New York common law and N.Y. Gen. Bus. L. Art. 22-A § 349;

B. Awarding Marshak his damages for any unlawful use, including without limitation defendants' profits, all damages sustained by him, the costs of this action, and reasonable attorneys' fees, and damages resulting from the tortious conduct for which Horton is vicariously responsible;

C. Directing that Defendants engage in such additional activities, including, but not limited to, recalls of advertisements and corrective advertising, as may be necessary and appropriate to mitigate the damage Defendants have caused;

D. Awarding Marshak punitive damages in an amount to be determined by the trier of fact in this action; and

E. Granting such other and further relief as to this Court seems just and proper.

Dated: New York, New York
February 17, 2011

DUNNEGAN LLC

By William Dunnegan
William Dunnegan (WD9316)
wd@dunnegan.com
Laura Scileppi (LS0114)
ls@dunnegan.com
Attorneys for Plaintiff
Larry Marshak
New York, New York 10118
(212) 332-8300

