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

| | |
|------------------------|---|
| Proceeding | 91198852 |
| Party | Defendant Big Score Entertainment, LLC dba BSE Recordings |
| Correspondence Address | BRIAN C ROCHE ROCHE PIA LLC 2 CORPORATE DRIVE, SUITE 248 SHELTON, CT 06484 UNITED STATES broche@rochepia.com |
| Submission | Motion to Suspend for Civil Action |
| Filer's Name | Brian C. Roche |
| Filer's e-mail | broche@rochepia.com |
| Signature | /Brian C. Roche/ |
| Date | 03/22/2011 |
| Attachments | Motion to Suspend - Final.pdf (5 pages)(33841 bytes) Complaint.pdf (12 pages)(62268 bytes) |

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

In the matter of Application Serial No.: 77751586
Date of Application: June 3, 2009
Trademark: ARIKA KANE

| | | |
|-------------------------------|---|-------------------------|
| ERICA M. CHRISWELL, |) | |
| |) | |
| Opposer, |) | |
| |) | |
| v. |) | Opposition No. 91198852 |
| |) | |
| BIG SCORE ENTERTAINMENT, LLC, |) | |
| |) | |
| Applicant. |) | |

**MOTION TO SUSPEND PROCEEDING IN VIEW OF PENDING CIVIL ACTION
PURSUANT TO TRADEMARK RULE 2.117(a)**

Respondent, Big Score Entertainment, LLC (“Applicant” or “BSE”), by its attorneys Roche Pia LLC, hereby moves for suspension of these proceedings pursuant to Trademark Rule 2.117(a), 37 C.F.R. § 2.117(a).

On December 20, 2010, Applicant filed a complaint in the United States District Court for the District of Connecticut against Erica M. Chriswell (“Chriswell”) for trademark infringement and unfair competition, among other claims. In support of this motion, Applicant submits herewith a copy of the Complaint filed in the District of Connecticut, and further states as follows:

In its District Court Complaint, among other claims, BSE requests that the United States District Court for the District of Connecticut find and hold that the actions of Erica M. Chriswell (“Chriswell”) constitute infringement of BSE’s trademark, ARIKA KANE™

(Serial No. 77751586), and further requests the court to find that there is no legitimate basis or legal claim regarding Chriswell's ownership of trademark rights or applications involving the term ERYKA KANE which would amount to a defense negating the allegedly infringing acts.

As the Board is well aware, Chriswell has filed an Opposition to BSE's trademark application. As the Board is also aware, BSE has sought registration in international classes 009, 025 and 041; and Chriswell is opposing registration ***only in international class 009***. Accordingly, Applicant submits that its application should be granted, and registration should issue forthwith, in IC 025 and IC 041.

In her Opposition to BSE's application in IC 009, Chriswell claims that she has been and will continue to be damaged by the registration of the ARIKA KANE trademark and bases those claims primarily on her use of the stage name, "Ms. Kane," but apparently also on claimed additional, varying and inconsistent uses of the names Erika, Ms. Erica Kane, Ms. Eryka Kane and/or Eryka Kane for various goods or services.

The pending civil action accordingly involves two issues which are involved in this proceeding, namely whether Chriswell suffered any compensatory/remedial injury as a result of Applicant's use of the ARIKA KANE trademark and whether any purported trademark right owned by Chriswell provides a legitimate basis to support a finding of non-infringement. The determination of these issues by the District Court will likely be dispositive of the issues involved in this proceeding.

Applicant therefore respectfully requests suspension of these proceedings – inasmuch as they relate to IC 009 – pending determination of the civil action pursuant to

Trademark Rule 2.117(a), 37 C.F.R. § 2.117(a). *Whopper-Burger, Inc. v. Burger King Corp.*, 171 U.S.P.Q. 805, 807 (T.T.A.B. 1971) (suspending Cancellation proceeding in light of pending federal litigation because “the outcome of the civil action will have direct bearing on the question of the rights of the parties herein and may in fact completely resolve all the issues.”). In the alternative, if BSE’s application for registration in IC 025 and IC 041 cannot be bifurcated and granted absent opposition, Applicant would request that the Board suspend the proceeding in all classes until the litigation in the District of Connecticut is resolved.

Respectfully Submitted,

By:



Brian C. Roche
Gerald C. Pia, Jr.
Roche Pia LLC
Two Corporate Dr., Suite 248
Shelton, CT 06484
203.944.0235 (telephone)
203.567.8033 (facsimile)
broche@rochepia.com
gpia@rochepia.com

*Attorneys for Applicant
Big Score Entertainment, LLC*

CERTIFICATE OF SERVICE

I hereby certify that a copy of the foregoing was filed electronically and served on counsel for Opposer, on this 22 day of March, 2011, by sending same via Federal Express overnight service to:

Evan Anderson
John Alunit
Patel & Alunit, P.C.
16830 Ventura Boulevard, Suite 360
Encino, CA 91436



Brian C. Roche
Gerald C. Pia

Attorneys for Applicant

EXHIBIT A – COPY OF CIVIL COMPLAINT FILED IN UNITED STATES DISTRICT
COURT DISTRICT OF CONNECTICUT

**UNITED STATES DISTRICT COURT
DISTRICT OF CONNECTICUT**

BIG SCORE ENTERTAINMENT, LLC,)
)
Plaintiff,)
)
v.)
)
ERICA M. CHRISWELL,)
)
Defendant.)
_____)

CIVIL ACTION NO.

DECEMBER 20, 2010

COMPLAINT

The plaintiff, Big Score Entertainment, LLC (“BSE” or “Plaintiff”), by and through its undersigned attorneys, and for its Complaint for injunctive and other relief against the defendant, Erica M. Chriswell (“Defendant”), hereby states and alleges the following:

Nature of Action

1. This action seeks recovery for violations of the Lanham Act, 15 U.S.C. § 1125, *et seq.*, the Connecticut Unfair Trade Practices Act (CUTPA), and the common law of the state of Connecticut. Plaintiff seeks injunctive relief to enjoin Defendant from her ongoing violations, as well as monetary damages.

Parties, Jurisdiction and Venue

2. Plaintiff is a Connecticut limited liability company with its principal place of business in Stratford, Connecticut.

3. Upon information and belief, Defendant resides in Burbank, Illinois, and is a citizen of Illinois.

4. This Court has subject matter jurisdiction over the claims in this action pursuant to the provisions of 15 U.S.C. § 1121 and 28 U.S.C. § 1331. The Court also has subject matter jurisdiction pursuant to 28 U.S.C. § 1332 and/or 28 U.S.C. § 1367(a) because the parties are citizens of different states and the amount in controversy exceeds \$75,000 exclusive of interest and costs, and because those claims are so related to Plaintiff's claims under federal law that they form part of the same case or controversy and derive from a common nucleus of operative fact.

5. Venue is proper in this Judicial District under 28 U.S.C. § 1391(b), in that a substantial part of the events or omissions giving rise to the claim occurred in this district and the intellectual property that is the subject of the action is situated in this district. Among other things, venue is proper in this Judicial District under 28 U.S.C. § 1391(b) in that the infringing materials that are the subject of this litigation were offered for distribution, and distributed, in this district and the claims alleged in this action arose in this district.

Facts Common to All Claims

6. Plaintiff is a Connecticut-based record label that has positioned new artists on several Billboard charts, including UAC, rhythmic, R&B, pop and urban. In this regard, BSE Recordings is one of the most successful independent record companies in the world.

7. BSE owns and controls the use and goods associated with the Arika Kane™ trademark and service mark. The artist known by the Arika Kane™ mark is

BSE's marquee recording artist, showing movement on four of Billboard's singles charts.

8. Plaintiff has distributed numerous goods bearing the Arika Kane™ mark since at least January 1, 2008, including: digital materials, namely, CDs and downloadable audio recordings featuring music; and various clothing items, such as Jeans, Shoes, and T-shirts. Additionally, Plaintiff has utilized the Arika Kane™ mark in the provision of entertainment services, including live musical performances, since at least January 1, 2008.

9. Plaintiff's current album titled "Arika Kane" includes the following songs:

- a. Make It
- b. Watcha Waitin 4
- c. Bcuz I Luv U
- d. Ring My Bell
- e. Here With Me
- f. Follow Me (Interlude)
- g. All My Life
- h. Rock Witcha
- i. Tonight I'm Urs
- j. Can't Be Without U
- k. 4 The Lovers
- l. Never Really Knew U
- m. Why Did We Fall N Luv
- n. BCuz I Luv U (Hiphop Remix)
- o. Bcuz I Luv U (House Radio Remix)

10. The Arika Kane™ song "Here With Me" has charted on Billboard's Top 100 R&B/Hip-Hop Songs.

11. With the consent and agreement of the artist known by the Arika Kane™ mark, Plaintiff has applied for registration of that mark with the United States Patent and Trademark Office on the Principal Register. Plaintiff has demonstrated the registrability of the Arika Kane™ mark, and the USPTO has published that mark for opposition.

Defendant's Infringement

12. Plaintiff has recently learned, and upon information and belief alleges, that, beginning in 2010, Defendant has distributed musical recordings, in electronic form and/or on compact disc (CD), under the name "Eryka Kane," which is substantially similar to, and infringes, Plaintiff's Arika Kane™ mark. Specifically, in or around 2010, Defendant has begun distributing an album labeled "Diesel," which Defendant promotes as her "debut album," under recording artist name "Eryka Kane." Songs promoted under the "Eryka Kane" name include:

- a. She Ridin [Explicit]
- b. Tonight [Explicit]
- c. Diesel [Explicit]
- d. Get Em Girl [Explicit]
- e. Gimee Da Crown
- f. Gimee Da Crown Fea Bump J [Explicit]
- g. Get It In [Explicit]
- h. Wanna Cum [Explicit]; and
- i. Get Ya Throat Wet [Explicit]

13. These infringing materials are offered for distribution on the internet, and in interstate commerce, including via iTunes and Amazon.com.

14. Defendant advertises these infringement materials on the internet, including on MySpace at <http://www.myspace.com/erykakane>.

15. Upon information and belief, Defendant distributes infringing materials in interstate commerce. Defendant has distributed infringing materials in this District.

16. Defendant's distribution of sound recordings under the name "Eryka Kane" name postdates Plaintiff's use of the Arika Kane™ mark, and thus Plaintiff has priority in applicable markets.

17. Defendant's recording name, Eryka Kane, is substantially similar in appearance, and identical in sound, and thus infringes, Plaintiff's Arika Kane™ mark. Defendant's conduct constitutes a violation of Plaintiff's rights under the Lanham Act, CUTPA and Connecticut common law.

18. Given the nature of the recording industry – including performances via analog, digital, satellite, and internet radio, in which the artist name is often only spoken/heard and not written/read – Defendant's phonetically identical artist name is misleading and clearly likely to cause confusion and/or mistake among listeners and other consumers as to the affiliation, connection, or association of Defendant with Plaintiff and/or Plaintiff's artist, Arika Kane™, or as to the origin, sponsorship, or approval of her goods, services, or commercial activities by Plaintiff and/or Arika Kane™.

19. Given the nature of Defendant's goods, including explicit and objectionable lyrics, any confusion or mistake regarding, or association with, Plaintiff's

Arika Kane™ mark, is and would be significantly injurious to the goodwill and reputation associated with Plaintiff's mark.

20. The Defendant continues to engage in the aforementioned conduct despite being on notice of Plaintiff's mark. Defendant's wrongful conduct has caused and is continuing to cause harm to the reputation and goodwill associated with Plaintiff's mark.

21. Defendant's wrongful conduct has caused and continues to cause significant and irreparable harm to Plaintiff. Plaintiff brings this action to recover damages for the harm it has sustained, and to obtain injunctive relief prohibiting Defendant's further violations and infringement.

COUNT I

False Designation of Origin, 15 U.S.C. § 1125, et seq.

22. Plaintiff repeats and incorporates by this reference each and every allegation set forth in paragraphs 1 through 21, inclusive.

23. Because Plaintiff advertises, markets, distributes, and licenses its product(s) under the Arika Kane™ mark described in this Complaint, this mark is the means by which Plaintiff's products are distinguished from the products and related items of others in the same field or related fields.

24. Because of Plaintiff's continuous, successful and exclusive use of the Arika Kane™ mark, it has come to mean, and is understood by customers, listeners, and the public to signify products or services of Plaintiff, including sound recordings and performances of the artist, Arika Kane™.

25. Defendant's wrongful conduct includes the use, advertising, marketing, offering, or distribution of goods and/or services bearing marks, names, and/or sounds that are confusingly similar and/or phonetically identical to Plaintiff's mark.

26. Upon information and belief, Defendant has engaged, and continues to engage, in such wrongful conduct for the purpose, and/or with the effect, of (i) misleading, deceiving, or confusing customers and the public as to the origin and authenticity of the goods and services offered, marketed or distributed in connection with Plaintiff's mark, and/or (ii) trading or capitalizing on Plaintiff's goodwill and reputation. Defendant's conduct constitutes (a) false designation of origin, (b) false or misleading description, and (c) false or misleading representation that her goods and services are those of, originate from, are associated with, or are authorized by Plaintiff, all in violation of § 43(a) of the Lanham Trademark Act, set forth at 15 U.S.C. § 1125(a).

27. Defendant's wrongful conduct is likely to continue unless restrained and enjoined.

28. As a result of Defendant's wrongful conduct, Plaintiff has suffered and will continue to suffer damage and losses, including, but not limited to, irreparable injury to its business reputation and goodwill. Plaintiff is entitled to injunctive relief, in that Plaintiff has no adequate remedy at law for Defendant's wrongful conduct because, among other things, (a) Plaintiff's mark is valuable intellectual property which has no readily determinable market value, (b) Defendant's advertising, marketing, or distribution of infringing products constitutes harm to Plaintiff's business reputation and goodwill such that Plaintiff could not be made whole by any monetary award, and (c) Defendant's wrongful conduct, and the resulting damage to Plaintiff, is continuing.

COUNT II
Common Law Unfair Competition

29. The Plaintiff incorporates the allegations from paragraphs 1 through 28 as if fully set forth herein.

30. The acts and conduct of Defendant as alleged above in this Complaint constitute unfair competition pursuant to the common law of the state of Connecticut.

31. Since its first use, Plaintiff's Arika Kane™ mark has become in the market the name for goods or services coming from or through that particular source, and is known as the name for a particular charting artist on Plaintiff's recording label.

32. The acts and conduct of Defendant are likely to cause confusion, mistake, and/or uncertainty among customers, end users and the public. These acts and conduct are likely to deceive and/or mislead the public by, among other things, leading the public to conclude, incorrectly, that the Defendant's products, services, transmissions, and websites and other advertising, among others, originate with, are sponsored by, associated with, or authorized by the Plaintiff, causing confusion and uncertainty.

33. The effect of Defendant's appropriation of Plaintiff's distinctive mark/name is to cause confusion and uncertainty in the Plaintiff's business and injure Plaintiff pecuniarily or otherwise, as well as deceive and/or mislead the public.

34. Defendant's conduct as alleged above has damaged Plaintiff and resulted in an unjust gain of profit to Defendant in an amount that is unknown at the present time.

COUNT III

Connecticut Unfair Trade Practices Act (CUTPA)

Conn. Gen. Stat. §§ 42-110a, *et seq.*

35. The Plaintiff incorporates the allegations from paragraphs 1 through 34 as if fully set forth herein.

36. Defendant is a "person" within the meaning of Conn. Gen. Stat. § 42-110a.

37. With respect to the foregoing acts and conduct, Defendant was engaged in the conduct of trade or commerce, as those terms are defined in the Connecticut Unfair Trade Practices Act ("CUTPA"), Conn. Gen. Stat. §§ 42-110a, *et seq.*

38. The foregoing conduct by Defendant constitutes unfair methods of competition, deceptive acts or practices in the conduct of a trade or commerce, and/or unfair acts or practices in the conduct of a trade or commerce, in violation of CUTPA, in that such conduct is offensive to public policy, egregious, unconscionable, immoral, unethical, oppressive, deceptive and/or unscrupulous, and has caused, and may continue to cause, substantial injury to Plaintiff, in addition to consumers and/or others.

39. The foregoing conduct by Defendant has caused, and in the future will continue to cause, ascertainable loss to Plaintiff.

40. A copy of this Complaint has been mailed to the Attorney General of the State of Connecticut and the Commissioner of Consumer Protection in accordance with Conn. Gen. Stat. § 42-110g.

PRAYER FOR RELIEF

WHEREFORE, Plaintiff respectfully requests judgment as follows:

1. That the Court enter a judgment against Defendant finding that she has:
 - a. Infringed Plaintiff's rights in the Arika Kane™ trademark and service mark, in violation of 15 U.S.C. § 1125;
 - b. Violated the Connecticut Unfair Trade Practices Act, Conn. Gen. Stat. § 42-110a, *et seq.*; and
 - c. Engaged in unfair competition in violation of Connecticut law.

2. That the Court issue temporary, preliminary, and permanent injunctive relief against Defendant; and that Defendant, her agents, representatives, servants, employees, attorneys, successors and assigns, and all others in active concert or participation with them, be enjoined and restrained from:
 - a. Imitating, copying, mimicking, improperly distributing, or making any other confusing or infringing use or infringing distribution of products that infringe Plaintiff's Arika Kane™ mark or any items or works now or hereafter protected by any trademark of Plaintiff;
 - b. Manufacturing, assembling, producing, distributing, offering for distribution, circulating, selling, offering for sale, advertising, importing, promoting, or displaying any product, service, or thing bearing the "Eryka Kane" name or any other simulation, reproduction, copy, or colorable imitation of Plaintiff's Arika Kane™ mark, or any other of Plaintiff's trademarks or service marks;
 - c. Using any false designation of origin or false or misleading description or false or misleading representation that can or is likely to lead the

trade or public erroneously to believe that any item has been manufactured, assembled, produced, distributed, transmitted, offered for distribution, circulation, sold, offered for sale, imported, advertised, promoted, displayed, licensed, sponsored, approved, or authorized by or for Plaintiff, when such is not true in fact;

d. using the names, logos, or other variations thereof of any of Plaintiff's trademark-protected product(s) or service(s) in any of Defendant's artist, trade, domain or corporate names;

e. engaging in any other activity constituting an infringement of any of Plaintiff's trademarks or service marks, including the Arika Kane™ mark, or of Plaintiff's rights in, or right to use or to exploit, these trademarks; and

f. assisting, aiding, or abetting any other person or business entity in engaging in or performing any of the activities referred to in this Section 2, subparagraphs (a) through (e), above.

3. That the Court enter an order, pursuant 15 U.S.C. § 1117(a), declaring that Defendant hold in trust, as constructive trustee for the benefit of Plaintiff, all "profits" received by her and/or her agents from their distribution or sale of infringing materials;

4. That the Court enter an order requiring Defendant to provide Plaintiff a full and complete accounting of all profits received by her and/or her agents from their distribution or sale of infringing materials, and of any other amounts due and owing to Plaintiff as a result of the infringement and wrongful conduct described in this complaint;

5. That the Court order Defendant to pay:

a. Plaintiff's damages and Defendant's profits, plus all costs and reasonable attorneys' fees, pursuant to 15 U.S.C. § 1117(a);

b. Plaintiff's compensatory and exemplary damages under Connecticut common law;

c. Plaintiff's damages pursuant to CUTPA, Conn. Gen. Stat. § 42-110g, including, but not limited to, compensatory and punitive damages and attorneys' fees; and

d. Plaintiff's other damages in an amount to be determined pursuant to Connecticut law.

6. That the Court order Defendant to pay to Plaintiff the costs of this action and the reasonable attorney's fees incurred by Plaintiff in prosecuting this action; and

7. That the Court grant Plaintiff such other and additional relief as is just and proper.

Dated this 20th day of December 2010.

THE PLAINTIFF
BIG SCORE ENTERTAINMENT, LLC,

By: _____

Brian C. Roche – ct17975
Gerald C. Pia, Jr. – ct21296
Roche Pia LLC
Two Corporate Dr., Suite 248
Shelton, CT 06484
203.944.0235 (telephone)
203.567.8033 (facsimile)
broche@rochepia.com
gpia@rochepia.com

Its Attorneys