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

Proceeding	91213310
Party	Defendant Riesett, Sandra L.
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Submission	Motion to Suspend for Civil Action
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In the matter of trademark application Serial No. 85/794867
For the Mark SHOW YOUR SOFT SIDE
Published in the Official Gazette on May 7, 2013

Mayor and City Council of Baltimore

Opposer,

v.

Sandra L. Riesett,

Applicant

Opposition No.91213310

MOTION FOR SUSPENSION

Applicant Sandra L. Riesett (“Riesett”) moves for suspension of the above-identified opposition proceeding pursuant to Trademark Rule of Practice 2.117(a) (37 C.F.R. § 2.117(a)) and Section 510.02(a) of the Trademark Trial and Appeal Board Manual of Procedure (“TBMP”).

In the above-captioned proceeding, Opposer Mayor and City Council of Baltimore (“City of Baltimore”) has opposed Applicant Riesett’s Application No. 85/794867 to register the mark SHOW YOUR SOFT SIDE (the “Mark”). The City of Baltimore has based its opposition on allegations that: (i) Riesett, through her advertising agency, created the Mark for the City of Baltimore; (ii) the City of Baltimore is the owner and prior user of the Mark; (iii) Applicant’s use of the Mark is likely to cause confusion with regard to the City of Baltimore’s affiliation, license or endorsement of Applicant and/or the Mark; and (iv) Applicant’s registration of the Mark would be inconsistent with the City of Baltimore’s rights in the mark at common law.

On June 26, 2013, Applicant Riesett filed a Complaint for Declarative Relief captioned *Riesett v. Mayor and City Council of Baltimore*, Civil Action No. GLR-13-1860, which is currently pending in the United States District Court for the District of Maryland (the “Civil Action”). (A copy of Riesett’s Complaint in the Civil Action is attached hereto as **Exhibit A** and a copy of the Answer, Affirmative Defenses and Counterclaim of Defendant/Opposer is attached hereto as **Exhibit B**.) In the Civil Action, Riesett claims to have created an anti-animal abuse public service advertising campaign (the “Campaign”) in connection with which she uses the Mark, and formerly licensed use of the Campaign and the Mark to the City of Baltimore. In the Civil Action, Riesett seeks, in part, a judgment declaring that the Defendant/Opposer City of Baltimore is not entitled to ownership or registration of the marks associated with the Campaign, which include the Mark, and that she is entitled to sole and exclusive ownership and registration of the marks associated with the Campaign, including the Mark. *See* paragraphs a and b on page 7 of the Complaint attached hereto as Exhibit A.

In its Answer, Affirmative Defenses and Counterclaim in the Civil Action, Defendant/Opposer alleges that the Mark was created by Applicant for the City of Baltimore and seeks final judgment declaring that the City of Baltimore is entitled to ownership and registration of the marks associated with the Campaign, including the Mark, and that Plaintiff/Applicant Riesett is not entitled to ownership or registration of the marks associated with the Campaign, including the Mark. *See* paragraphs a and c on page 12 of Defendant/Opposer’s Answer, Affirmative Defenses and Counterclaim attached hereto as Exhibit B. Because the Civil Action between Riesett and City of Baltimore involves determination of the ownership of and the right to register the Mark between the parties involved in this opposition proceeding, the Civil Action will have a bearing on Defendant/Opposer City of Baltimore’s trademark rights in the SHOW

YOUR SOFT SIDE mark, which in turn affects its right and basis to oppose Applicant Riesett's applied-for mark in the above-captioned proceeding.

Pursuant to Trademark Rule 2.117(a), the Board has discretion to suspend proceedings pending the final determination of a civil action which may have a bearing on the case. *See also General Motors Corp. v. Cadillac Club Fashions Inc.*, 22 USPQ2d 1933 (TTAB 1992); *Toro Co. v. Hardigg Industries, Inc.*, 187 USPQ 689 (TTAB 1975), *rev'd on other grounds*, 549 F.2d 785, 193 USPQ 149 (CCPA 1977). Accordingly, the Board has discretion to suspend the instant proceedings pending final determination of the Civil Action, where, as here, the outcome of the Civil Action will clearly have a bearing on Opposer City of Baltimore's ownership of and right to use and register the SHOW YOUR SOFT SIDE mark, which is the basis of this opposition proceeding against Riesett.

Therefore, Applicant Riesett respectfully requests that the Board suspend this opposition proceeding pending determination of the Civil Action.

Respectfully submitted,

Dated: January 9, 2014



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CERTIFICATE OF SERVICE

The undersigned, a member of the Maryland Bar, hereby certifies that on this 9th day of January, 2014, she caused a copy of the foregoing Motion for Suspension to be served via first class mail, postage prepaid on:

Suzanne Sangree, Chief Solicitor
Patrick D. Sheridan, Assistant Solicitor
Baltimore City of Law Dept.
100 N. Holliday St., Room 109
Baltimore, MD 21202

Attorneys for Opposer



Donna M.D. Thomas

EXHIBIT A

IN THE UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF MARYLAND
(Northern Division)

SANDE RIESETT *
10122 Falls Road *
Lutherville, Maryland 21093 *

Plaintiff, *

Civil Action No.:

v. *

MAYOR AND CITY COUNCIL OF BALTIMORE *

Service Upon: George A. Nilson, Esq. *
100 N. Holliday Street, Ste. 101 *
Baltimore, Maryland 21202 *

Defendant. *

* * * * *

COMPLAINT FOR DECLARATIVE RELIEF

Plaintiff, Sande Riesett (hereinafter, "Riesett"), by her undersigned counsel, sues the Defendant, Mayor and City Council of Baltimore (hereinafter, "City of Baltimore"), and alleges that:

JURISDICTION AND VENUE

1. This case arises under the Copyright Act, the Lanham Act and Declaratory Judgment Act of the United States. This Court has subject matter jurisdiction over the action pursuant to the provisions of 15 U.S.C §§ 1119, 1121, 17 U.S.C. §501 and 28 U.S.C. §§ 1331, 1338, 2201 and 2202. Venue is proper in this judicial district by reason of the provisions of 28 U.S.C. §§ 1391(b) and 1400(a).

2. Declarative relief is required because the City of Baltimore has claimed ownership of the trademarks and copyrights associated with the "SHOW YOUR SOFT

SIDE” anti-animal abuse public service advertising campaign created by Riesett (the “Campaign”). In furtherance of its position that it owns the Campaign, the City of Baltimore has threatened to sue Riesett to establish ownership. Such threats of litigation are inconsistent with the rights of Riesett pursuant to the copyrights and trademarks she asserts ownership of, will cause irreparable harm to Riesett, and result in her inability or hindered ability to license the Campaign for use in other markets, as it is now used in Baltimore City.

3. Riesett is an individual and a domiciliary of Lutherville, Maryland.

4. Riesett is a seasoned advertising professional who has authored numerous advertising campaigns, including those employed by non-profits. Riesett is the owner and president of Outlaw Advertising, LLC (“Outlaw”), a Maryland company which provides advertising services to small businesses and non-profit organizations. Prior to forming Outlaw, Riesett worked for very large advertising agencies on accounts as diverse as MOBIL oil, IAMS pet food, and THE LONDON TIMES.

5. The Mayor and City of Baltimore is a corporation established by the Charter of Baltimore City, Article 1, Section 1.

FACTS

6. In or about January 2011, Riesett became concerned at the growing number of reported incidents of animal abuse occurring in the City of Baltimore, particularly the news report regarding several pre-teens who were alleged to have set a dog on fire. Riesett reasoned that as well as posing a threat to animals, pre-teens such

as these, who would maliciously injure an animal, would likely perpetuate violent behavior on people.

7. Riesett wanted to develop a public service campaign to promote kindness to animals and to educate young people and the public at large that cruelty to animals is not acceptable social behavior. In the Spring of 2011 Riesett attended a meeting of the Mayor's Anti-Animal Abuse Task Force, which subsequently became, by approval of the Baltimore City Council, the Mayor's Anti-Animal Abuse Advisory Commission (the "Commission"), where she learned that many of the most horrific cases of animal abuse were committed by preteens and teenagers.

8. Thereafter, the idea originated with Riesett that any advertising message would need to speak to its intended audience through a person or persons that a youthful audience would respect. With the aim of formulating a message that would have an impact on youth, Riesett conceived of the idea of using well-known "tough guys" such as professional athletes and celebrities to show how animals bring out a person's soft side.

9. Riesett's next step was to create the Campaign. Riesett developed concept boards for the Campaign featuring professional athletes and celebrities with their pets and she created the slogans "ONLY A PUNK WOULD HURT A CAT OR DOG", and "SHOW YOUR SOFT SIDE" (collectively, the "Marks").

10. Riesett sought the help of a friend who had contacts with celebrities and athletes to enlist their participation in the Campaign. Through these efforts, a number of professional athletes and celebrities agreed to donate their services and personas for

use in the Campaign. Riesett secured the services of photographer Leo Lubow to photograph the athletes and celebrities, and she obtained licenses to use such images and photographs in the Campaign.

11. Riesett created all of the Campaign's advertising materials, namely posters, billboards, print and online advertising, calendars, radio spots, tv spots, videos and a Facebook page, including all of the copy, text, layout and design of such advertising materials.

12. In or about August 2011, when Riesett was prepared to launch the Campaign, some of the advertising materials were shown to certain members of the Commission and the City of Baltimore, and the City of Baltimore asked that the City logo be included in the materials. Riesett agreed and, until recently, included the City's logo on the Campaign's advertising materials in the Baltimore City market.

13. Riesett solicited friends and the media to provide free media space for the Campaign's advertising materials, such as no cost billboard space. Riesett and her friends have solicited sponsors and donors, and have personally donated funds, to support and pay for the cost of production and media placement for the Campaign. Riesett also raised money for the Campaign through events and the sale of branded merchandise.

14. Riesett always intended to retain, and has never relinquished, ownership of the Campaign and its associated advertising materials and intellectual property rights, and has filed applications with the United States Patent and Trademark Office ("USPTO") to register the Marks in her name. At no time did Riesett convey to the City

of Baltimore or to the Commission, any rights of ownership in the Campaign and its associated advertising materials and intellectual property rights, and despite repeated requests that the City of Baltimore produce any evidence of transfer, it has failed to do so.

15. There are no written agreements between Riesett, the City of Baltimore and/or the Commission regarding use of the Campaign, the Campaign's advertising materials, the Marks and copyrights. The City of Baltimore and the Commission have merely been granted by Riesett a non-exclusive, terminable at will, license to use the Campaign in the City of Baltimore.

16. Neither the City of Baltimore nor the Commission paid for the creation of the Campaign, the associated advertising materials or the copyrights and Marks associated therewith. The only payments that Riesett has received in connection with the City of Baltimore's use of the Campaign include reimbursement of costs advanced by Riesett or Outlaw for media production and media placement, such as the cost to produce posters or billboards and the cost of non-donated advertising space for displaying same on billboards and in bus shelters in Baltimore City. Such costs were the responsibility of the Commission or the City of Baltimore as the advertiser, and have been reimbursed to Riesett from local animal rescue shelters and the Baltimore City Foundation ("BCF") out of funds donated to the shelters and BCF primarily from sponsors and donors solicited by Riesett and her friends. Riesett has also personally donated funds to cover these costs.

17. Despite the City of Baltimore's lack of ownership, and lack of any document transferring ownership, the City of Baltimore has asserted ownership of the Campaign and its associated advertising materials and intellectual property rights.

18. The City of Baltimore Law Office has also advised that it intends to oppose Riesett's registration of one of the Marks with the USPTO, and has filed with the USPTO a request for extension of time to oppose Riesett's application to register the mark SHOW YOUR SOFT SIDE within the statutory period.

19. Despite an in-person meeting with the City of Baltimore Law Office, and the tender to the City of Baltimore of a written royalty-free license to employ the Campaign and its associated advertising materials in the Baltimore City market, the City of Baltimore continues to assert ownership of the Campaign and its associated advertising materials and intellectual property rights (including the Marks and copyrights), threatens to file its opposition to Riesett's registration of one of the Marks with the USPTO, and has threatened to sue Riesett to establish ownership of the Campaign.

20. On information and belief, the City intends to create derivative works of the Campaign and its associated advertising materials.

COUNT I

DECLARATIVE RELIEF

21. Riesett realleges each and every allegation set forth in paragraphs 1 through 20, and incorporates them herein.

22. Riesett has a reasonable apprehension that the City of Baltimore will sue her to attempt to obtain ownership of the Campaign and its associated advertising materials and intellectual property rights, including copyrights and the Marks, and will file an opposition to registration of the Marks with the USPTO. Further, Riesett intends to license the Campaign and its associated advertising materials and intellectual property rights, including copyrights and Marks, to other jurisdictions, and any such license will be required to represent that Riesett is the sole owner thereof, that there are no third party claims associated therewith, and that she will indemnify the licensee against any such claims. As asserted by the City of Baltimore, such claims exist. These actions and assertions will result in immediate and irreparable injury.

WHEREFORE, Riesett prays a final judgment declaring that:

- a. Neither the City of Baltimore, nor the Commission, is entitled to ownership or registration of the copyrights to the Campaign and its associated advertising materials and the Marks;
- b. Riesett is entitled to sole and exclusive ownership and registration of the copyrights to the Campaign and its associated advertising materials and the Marks;
- c. Neither the City of Baltimore, nor the Commission, can exercise any rights associated with ownership of copyrights to the Campaign and its associated advertising materials under 17 U.S.C. § 106, including the preparation of derivative works;
- d. The City of Baltimore's, and the Commission's, right to use the Campaign and its associated advertising materials, copyrights and the Marks is revocable by Riesett at any time; and

e. Riesett be awarded such other relief as may be just and appropriate, including her costs and attorneys' fees.

Respectfully submitted,

/s/

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EXHIBIT B

3. The City is without knowledge or information sufficient to admit or deny the allegations in Paragraph 3 of the Complaint.

4. The City is without knowledge or information sufficient to admit or deny the allegations in Paragraph 4 of the Complaint.

5. The City denies the allegations in Paragraph 5 of the Complaint, but asserts that it is a corporation named the "Mayor and City Council of Baltimore."

6. The City is without knowledge or information sufficient to admit or deny the allegations in Paragraph 6 of the Complaint.

7. The City is without knowledge or information sufficient to admit or deny the allegation in the first sentence of Paragraph 7. The City admits that Plaintiff attended a meeting of the Mayor's Anti-Animal Abuse Advisory Commission ("the Commission") in March 2011, where she offered her volunteer services to develop an advertising campaign to address animal abuse. At that meeting, Commission members educated her concerning the goals of the Commission, the nature of animal abuse and the demographics of the perpetrators of animal abuse in Baltimore City. As to the remainder of the allegations in Paragraph 7, the City either denies, or lacks sufficient information to admit or deny those allegations.

8. The City lacks sufficient information to admit or deny the allegations in Paragraph 8 of the Complaint, except to admit that the idea of using well-known "tough guys" such as professional athletes and other celebrities in an advertising campaign did not exist prior to Plaintiff's attendance at the Commission meeting in March 2011.

9. The City lacks sufficient information to admit or deny the allegations in Paragraph 9 of the Complaint except to state that the City admits that the Campaign slogans "ONLY A PUNK WOULD HURT A CAT OR A DOG" and "SHOW YOUR SOFT SIDE"

(collectively the "Marks"), did not exist prior to the Commission engaging Plaintiff and her company, Outlaw Advertising, LLC ("Outlaw") in March 2011.

10. The City is without knowledge or information sufficient to form a belief as to the truth of the allegations in the first sentence of Paragraph 10 of the Complaint, and in the first clause of the second sentence of Paragraph 10 ("Through these efforts . . ."). The City admits the allegations in the second clause of the second sentence of Paragraph 10 in that professional athletes and celebrities agreed to pose for photographs for the Campaign. The City is without knowledge or information sufficient to admit or deny the allegations in the third sentence of Paragraph 10 of the Complaint, except to aver that licenses, jointly in the names of the Mayor's Anti-Animal Abuse Advisory Commission and the advertising agency acting on its behalf, Outlaw, were obtained from the photographer, Leo Lubow, and the talent (i.e. the athletes, celebrities and City personnel).

11. The City is without knowledge or information sufficient to admit or deny the allegations in Paragraph 11 of the Complaint.

12. The City is without knowledge or information sufficient to admit or deny the allegations in Paragraph 12 of the Complaint. The City avers that it authorized the use of its seal for the Campaign, that its seal appeared on all publications of the Campaign up until recently when Plaintiff removed it without authorization and that the Commission was provided the opportunity to approve of or object to the materials used for the Campaign.

13. The City is without knowledge or information sufficient to admit or deny the allegations in Paragraph 13 of the Complaint.

14. The City is without knowledge or information sufficient to form a belief as to Plaintiff's intent as alleged in the first clause of the first sentence of Paragraph 14. The City

denies that Plaintiff ever owned the Marks referred to in this first sentence of Paragraph 14, or expressed her belief that she owned the Marks prior to her filing applications to register the Marks with the United States Patent and Trademark Office. The City avers that Plaintiff granted the City a perpetual license to use the copyright to the Campaign, so in this respect the City denies that Plaintiff "has never relinquished ownership of the Campaign" as alleged in this first sentence. As to the first two clauses of the second sentence of Paragraph 14 of the Complaint, the City admits that Plaintiff did not convey ownership of the Marks to the City because she did not possess any ownership to convey. Concerning these same first two clauses of Paragraph 14, the City denies that Plaintiff did not convey any rights of ownership of the copyrights to the Campaign, because she granted the City a perpetual license to use the copyrights. The City denies the remaining allegations in Paragraph 14 of the Complaint. As to the last clause of Paragraph 14, the City avers that the City had no evidence of transfer because from the inception of the Campaign, the Marks were owned by the City because they were developed by the City's advertising agent.

15. Upon information and belief, the City admits that there are no written agreements between the City and Plaintiff or between the Commission and Plaintiff. The City denies the allegations in the second sentence of Paragraph 15 of the Complaint.

16. The City is without knowledge or information sufficient to admit or deny the allegations in Paragraph 16 of the Complaint.

17. The City denies the allegations in Paragraph 17, except to admit that the City owns and asserts its ownership of the Marks to the Campaign and it owns and asserts its ownership of a perpetual license to the copyrights in the Campaign.

18. The City admits the allegations in Paragraph 18 of the Complaint and avers that Plaintiff consented through her attorneys to the City's request for an extension of time to oppose her application to register the mark SHOW YOUR SOFT SIDE.

19. Paragraph 19 contains allegations of what was communicated during settlement negotiations and the City objects to their inclusion in the Complaint. Without waiving its objection, the City admits the allegation in Paragraph 19 of the Complaint that there was an in-person meeting. The City also denies that Plaintiff's description of her settlement offer is accurate. The City denies that it in any way threatened to sue Plaintiff, though it admits that it informed her that it planned to oppose her trademark application. The City admits that it continues to assert ownership as delineated in Paragraph 17 above.

20. The City admits the allegations in Paragraph 20 of the Complaint but avers that it has the right and/or license to do what is alleged.

**COUNT I
DECLARATORY RELIEF**

21. The City incorporates by reference Paragraphs 1-20 of this Answer as if fully set forth herein, in response to Paragraph 21 of the Complaint.

22. The City is without knowledge or information sufficient to form a belief as to the truth of the allegations in the first and second sentence of Paragraph 22 of the Complaint, except to admit that the City will oppose Plaintiff's trademark applications which conflict with the City's rights. The allegation in the third sentence of Paragraph 22 of the Complaint is vague and subject to multiple interpretations and, therefore, the City is unable to admit or deny the allegation, "As asserted by the City of Baltimore, such claims exist." The City denies the allegations contained in the fourth and last sentence of Paragraph 22 of the Complaint.

PLAINTIFF'S PRAYER FOR RELIEF

23. The City denies that the Plaintiff is entitled to any of the relief requested in Paragraphs (a)-(c) of the Plaintiff's Prayer for Relief or to any other relief.

DEFENSES

First Defense

24. The City has not infringed, contributorily infringed, or induced the infringement of the Marks or any works subject to copyright protection which may be at issue in the Complaint.

Second Defense

25. Plaintiff has no trademark rights in the Marks.

Third Defense

26. Plaintiff's copyrights in the Campaign have not been infringed because the City possesses a perpetual license to use the Campaign.

Fourth Defense

27. Plaintiff has not been damaged and will not be damaged as alleged in the Complaint.

AFFIRMATIVE DEFENSES

First Affirmative Defense

28. The Complaint fails to state a claim upon which relief can be granted.

Second Affirmative Defense

29. Upon information and belief, Plaintiff's damages claims may be barred, in whole or in part, under the doctrines of waiver, estoppel, acquiescence, and laches.

RESERVATION OF ADDITIONAL DEFENSES

30. The City's investigations into the allegations set forth in Plaintiff's Complaint are ongoing and discovery has not yet commenced. The City expressly reserves the right to

assert and pursue additional defenses and affirmative defenses.

COUNTERCLAIM

Statement of Facts

31. The City incorporates by reference its responses and defenses contained in paragraphs 1-30 above.

32. On October 8, 2010, the City enacted Ordinance 10-369 to create the Commission after a young pit bull terrier – subsequently named Phoenix – was doused with gasoline and set on fire in West Baltimore.¹ The purpose of the Commission is to provide the services of promoting best practices for eradicating animal abuse in the City of Baltimore, raising awareness of animal cruelty laws, improving training for law enforcement officials on how to handle animal cruelty cases, and fostering improved responses to animal cruelty.

33. On February 7, 2011, the second criminal trial against the teenagers charged with setting Phoenix on fire ended in a hung jury. Shortly thereafter, Plaintiff, the president and sole owner of Outlaw, approached Caroline Griffin, then Chair of the Commission, to express outrage at the results of the criminal trial and to ask if she and her company Outlaw could do anything to help the Commission with its work. At that time, neither Plaintiff nor Outlaw had created or even considered any materials or taglines that might have been used in the Commission's efforts.

34. A small meeting was held soon thereafter attended by Ms. Griffin, and several members of the Commission with Plaintiff. In this meeting, Plaintiff professed to know very little about animal abuse and asked the Commission members to educate her about the incidence of animal abuse and the demographics of its perpetrators in the City of Baltimore, which the Commission members proceeded to do.

¹ A copy of Ordinance 10-369 is attached hereto as Exhibit 1.

35. Plaintiff next attended the March 9, 2011, meeting of the Commission. Plaintiff presented her experience and credentials and offered her services and the services of Outlaw, to act as the Commission's/City's advertising agency and help the Commission with outreach and public relations. The agenda and minutes of that meeting record that Riesett was representing Outlaw. She sought the Commission members' direction as to what type of public education campaign they might wish to pursue. She asked the Commission members various questions concerning the goals for a Commission campaign, including whether the campaign should focus on educating the public about animal abuse, discouraging people from engaging in animal abuse, or informing the public about how to report animal abuse. She asked the Commission members whether the campaign should feature local celebrities. The Commission agreed to consider these options.

36. At the March 9 meeting, Commission members told Plaintiff that any campaign should target juveniles since they were the principal perpetrators of the worst incidents of abuse. Commission members also agreed that any campaign should not focus on the atrocities but should promote some sort of "happy ending." This part of the meeting was a brainstorming session for Plaintiff to obtain more specific guidance from the Commission. At the March 9 meeting, the campaign was still considered a "potential campaign." Plaintiff was gathering input from the Commission members as she asked them what they wanted as the goals of that potential campaign.

37. After a few months of work, Outlaw, as the Commission's/City's advertising agency, developed the Campaign on behalf of the City as Outlaw had promised. The Campaign included the Marks, developed while Outlaw, and Riesett on behalf of Outlaw, was serving as the Commission's advertising agency. The nature and quality of the Campaign – being the services

offered by the Commission was subject to the ultimate control of the Commission. Outlaw, and Plaintiff as Outlaw's agent, knowing that the Commission had such rights of control, provided the Campaign to the Commission for its approval. In the summer of 2011, Ms. Griffin distributed to the members of the Commission the proposed anti-animal abuse advertisements prepared by Outlaw for the Commission members to review and approve. The Commission approved the advertisements and, in September 2011, issued a press release announcing its Campaign. The purpose of the Campaign was to further the Commission's services of promoting best practices for eradicating animal abuse in the City of Baltimore, raising awareness of animal cruelty laws, and fostering improved responses to animal cruelty.

38. From May 2011 through April 2013, Plaintiff, acting as an agent for Outlaw, and Outlaw acting as the advertising agency for the City, secured "General Talent Releases" from a variety of athletes, celebrities, and individuals to appear in the photographs used in the posters and advertisements for the Campaign. The General Talent Releases identify Outlaw as the advertising agency for the Commission and grant to the Commission and Outlaw the right to use their likenesses. Plaintiff was not listed as a relevant party in the General Talent Releases. The athletes and police officers who appear in the Campaign were only permitted by their respective employers to pose in their uniforms because their images were being used for the Commission's public anti-animal abuse Campaign, and not for commercial profit or for the benefit of any entity (including Plaintiff or Outlaw) other than the City. All of the posters and advertisements used in the Campaign bear the City's seal and the name of the Commission. None of the original materials of the Campaign mention Outlaw or Plaintiff, and certainly do not mention Show Your Soft Side, Inc., since it was not incorporated until later.

39. In December 2011, the Commission and Outlaw, not Plaintiff, entered into a License Agreement with the photographer Leo Howard Lubow. The License Agreement provides that Mr. Lubow owns the copyright to all images photographed by him for the Campaign and grants to both the Commission and Outlaw, not Plaintiff, the right to display the images in any type of media that promotes the Campaign. Plaintiff is not listed as a party to the License Agreement, is not a grantee, and the grant is for no other purpose.

40. Throughout 2012, Outlaw, as the advertising agency for the Commission, entered into a number of advertising agreements with media or production vendors. Outlaw then issued invoices to the Commission, which were paid from the Commission's account at the Baltimore City Foundation. None of the advertising agreements or invoices listed Plaintiff as a party or as the agent.

41. The Commission's Campaign ran from approximately September 2011 to the present, garnering praise and recognition for the City. The Commission was and is offering the services of the Campaign; Plaintiff was and is not.

42. Plaintiff created a Facebook page under the name ShowYourSoftSide. The contact for the site is info@showyoursoftside.org and its owner is Outlaw.

43. In or around November 2012, Mayor Stephanie Rawlings-Blake's office learned that a representative of the State of New Mexico had posted an inquiry on the ShowYourSoftSide Facebook page, expressing an interest in using the Campaign.

44. As a result of that inquiry, the Baltimore City Law Department, on behalf of the Commission, began discussions with Outlaw and its attorneys, Donna M.D. Thomas and James Astrachan of the law firm Astrachan Gunst Thomas, P.C., about the ownership of the copyrights and trademarks related to the Campaign.

45. Shortly after the Facebook inquiry, and unbeknownst to the City, on December 5, 2012, Plaintiff filed an application in her own name with the United States Patent and Trademark Office to register the trademark SHOW YOUR SOFT SIDE.

46. On or about March 14, 2013, Plaintiff formed a Maryland corporation, Show Your Soft Side, Inc.

47. After meeting and agreeing to a settlement in principle, the City and Outlaw traded drafts of a proposed agreement to define their respective rights in the copyrights and trademarks. In the midst of those discussions and unbeknownst to the City, on June 6, 2013, Plaintiff filed an application in her own name with the United States Patent and Trademark Office to register the trademark ONLY A PUNK WOULD HURT A CAT OR DOG. Shortly thereafter, Plaintiff filed this lawsuit.

Counterclaim (Declaratory Relief)

48. Defendant incorporates by reference its responses, defenses and facts contained in paragraphs 1-47 above.

49. On information and belief, Outlaw, Plaintiff, and/or Show Your Soft Side, Inc. ("SYSS") are using and intend to continue using the Campaign and its associated advertising materials and intellectual property rights, including copyrights and Marks, only without the City's logo or attribution to the Commission or the City.

50. Through the underlying Complaint in this case and through her applications for trademark certifications of the Marks, Plaintiff has sued the City seeking to obtain ownership and has claimed ownership of the Campaign and its associated advertising materials and intellectual property rights, including copyrights and Marks.

51. In the underlying Complaint, Plaintiff avers her intent to “license the Campaign and its associated advertising materials and intellectual property rights, including copyrights and Marks, to other jurisdictions [or entities], and any such license will be required to represent that [Plaintiff] is the sole owner thereof. . . .” *Complaint*, Doc. 1 ¶ 22.

52. On information and belief Outlaw and/or SYSS intend to license the Campaign and its associated advertising materials and intellectual property rights, including copyrights and Marks, to other entities, in violation of the City’s trademark rights.

WHEREFORE, the City requests a final judgment declaring that:

- a. The City is entitled to ownership or registration of the Marks of the Campaign and its associated advertising materials;
- b. The City is entitled to a perpetual license to use the copyright to the Campaign and its associated advertising materials;
- c. Neither Plaintiff, Outlaw nor SYSS are entitled to ownership or registration of the Marks associated with the Campaign;
- d. Plaintiff must immediately withdraw her trademark registration applications for the Marks;
- e. Plaintiff, Outlaw and SYSS must immediately cease and desist from using, and refrain from any future use, of the Marks;
- f. The City be awarded such other relief as may be just and appropriate, including costs and attorneys’ fees.

PRAYER FOR RELIEF

WHEREFORE, the City prays for relief as follow:

- a. Dismiss the Plaintiff's Complaint with prejudice;
- b. Grant the Mayor and City Council the relief requested in its Counter Claim;
- c. Award the Mayor and City Council of Baltimore attorneys' fees and other costs of defense; and
- d. Grant such other and further relief as the Court deems just and proper.

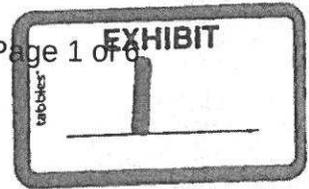
Respectfully submitted,

/s/

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CITY OF BALTIMORE
ORDINANCE **10-369**
Council Bill 10-0506

Introduced by: Councilmembers Reisinger, Holton, D'Adamo, Branch, Middleton, Henry,
President Young, Councilmembers Curran, Cole, Conaway, Clarke, Welch, Stokes, Spector
Introduced and read first time: May 3, 2010
Assigned to: Public Safety and Health Committee
Committee Report: Favorable with amendments
Council action: Adopted
Read second time: September 20, 2010

AN ORDINANCE CONCERNING

Mayor's Anti-Animal Abuse Advisory Commission – Establishment

FOR the purpose of establishing the Mayor's Anti-Animal Abuse Advisory Commission;
defining certain terms; providing for the composition of the Advisory Commission;
establishing the duties of the Advisory Commission; and generally relating to efforts to
eradicate animal abuse in Baltimore.

BY adding

Article 1 - Mayor, City Council, and Municipal Agencies
Section(s) 55-1 to 55-13, to be under the new subtitle,
"Subtitle 55. Mayor's Anti-Animal Abuse Advisory Commission "
Baltimore City Code
(Edition 2000)

SECTION 1. BE IT ORDAINED BY THE MAYOR AND CITY COUNCIL OF BALTIMORE, That the
Laws of Baltimore City read as follows:

Baltimore City Code

Article 1. Mayor, City Council, and Municipal Agencies

SUBTITLE 55. MAYOR'S ANTI-ANIMAL ABUSE ADVISORY COMMISSION

§ 55-1. DEFINITIONS.

(A) *IN GENERAL.*

IN THIS SUBTITLE, THE FOLLOWING TERMS HAVE THE MEANINGS INDICATED.

(B) *ADVISORY COMMISSION.*

"ADVISORY COMMISSION" MEANS THE MAYOR'S ANTI-ANIMAL ABUSE ADVISORY
COMMISSION ESTABLISHED UNDER THIS SUBTITLE.

EXPLANATION: CAPITALS indicate matter added to existing law.
[Brackets] indicate matter deleted from existing law.
Underlining indicates matter added to the bill by amendment.
~~Strike out~~ indicates matter stricken from the bill by
amendment or deleted from existing law by amendment.

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1 § 55-2. COMMISSION ESTABLISHED.

2 THERE IS A MAYOR'S ANTI-ANIMAL ABUSE ADVISORY COMMISSION.

3 §55-3. ADVISORY COMMISSION MEMBERSHIP.

4 (A) *IN GENERAL.*

5 (1) THE ADVISORY COMMISSION CONSISTS OF 30 MEMBERS.

6 (2) OF THESE:

7 (i) ~~23~~ 25 MEMBERS ARE APPOINTED BY THE MAYOR IN ACCORDANCE WITH
8 ARTICLE IV, § 6 OF THE BALTIMORE CITY CHARTER; AND

9 (ii) ~~7~~ 8 MEMBERS ARE AGENCY REPRESENTATIVES.

10 (B) *APPOINTED MEMBERS.*

11 THE ~~23~~ 25 APPOINTED MEMBERS OF THE ADVISORY COMMISSION ARE AS FOLLOWS:

12 (1) 1 MEMBER FROM EACH OF THE 14 CITY COUNCIL DISTRICTS.

13 (2) 1 MEMBER REPRESENTING EACH OF THE FOLLOWING 4 ORGANIZATIONS:

14 (i) MARYLAND SPCA;

15 (ii) THE SNYDER FOUNDATION FOR ANIMALS;

16 (iii) THE ASPCA; AND

17 (iv) THE BALTIMORE ANIMAL RESCUE AND CARE SHELTER.

18 (3) 3 AT-LARGE MEMBERS.

19 (4) 1 MEMBER NOMINATED BY THE PRESIDENT OF THE CITY COUNCIL.

20 (5) 1 CITY COUNCIL MEMBER, NOMINATED BY THE PRESIDENT OF THE CITY COUNCIL.

21 (6) 1 JUDGE.

22 (7) 1 VETERINARIAN PRACTICING IN BALTIMORE CITY.

23 (C) *AGENCY REPRESENTATIVES.*

24 THE ~~7~~ 8 AGENCY REPRESENTATIVES ARE THE FOLLOWING, OR THEIR DESIGNATED
25 REPRESENTATIVES:

26 (1) THE DIRECTOR OF THE BUREAU OF ANIMAL CONTROL[†];

27 (2) THE HEALTH COMMISSIONER[†];

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- 1 (3) THE DIRECTOR OF JUVENILE SERVICES;
- 2 (4) THE MAYOR;
- 3 (5) THE PRESIDENT OF THE CITY COUNCIL;
- 4 (6) THE STATE'S ATTORNEY FOR BALTIMORE CITY; ~~AND~~
- 5 (7) THE POLICE COMMISSIONER.
- 6 (8) THE BALTIMORE CITY SHERIFF.

7 (D) *APPOINTMENT WITHOUT REGARD TO POLITICAL AFFILIATION.*

8 THE APPOINTMENT OF MEMBERS MUST BE MADE WITHOUT REGARD TO POLITICAL
9 AFFILIATION.

10 **§ 55-4. TERMS, COMPENSATION, VACANCIES.**

11 (A) *TERMS OF OFFICE.*

12 (1) ADVISORY COMMISSION MEMBERS SERVE FOR A TERM OF 4 YEARS, CONCURRENT WITH
13 THE TERMS OF THE MAYOR AND THE CITY COUNCIL.

14 (2) AT THE END OF A TERM, AN ADVISORY COMMISSION MEMBER CONTINUES TO SERVE
15 UNTIL A SUCCESSOR IS APPOINTED AND QUALIFIES.

16 (3) ADVISORY COMMISSION MEMBERS MAY BE REAPPOINTED, BUT MAY NOT SERVE MORE
17 THAN 3 TERMS.

18 (B) *COMPENSATION; EXPENSES.*

19 MEMBERS OF THE ADVISORY COMMISSION:

20 (1) ARE NOT ENTITLED TO COMPENSATION FOR THEIR SERVICES; BUT

21 (2) ARE ENTITLED TO REIMBURSEMENT FOR EXPENSES INCURRED, AS PROVIDED IN THE
22 ORDINANCE OF ESTIMATES.

23 (C) *VACANCIES.*

24 A MEMBER APPOINTED TO FILL A VACANCY IN AN UNEXPIRED TERM SERVES ONLY FOR THE
25 REMAINDER OF THAT TERM.

26 **§ 55-5. OFFICERS; COMMITTEES.**

27 (A) *OFFICERS.*

28 (1) THE MAYOR MUST DESIGNATE A MEMBER OF THE ADVISORY COMMISSION TO SERVE
29 AS ITS CHAIR.

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1 (2) MEMBERS OF THE ADVISORY COMMISSION MAY SELECT ANY OTHER OFFICERS THEY
2 CONSIDER NECESSARY OR APPROPRIATE.

3 (B) *COMMITTEES.*

4 THE CHAIR MAY APPOINT COMMITTEES TO ASSIST THE ADVISORY COMMISSION IN
5 CARRYING OUT ITS FUNCTIONS AND DUTIES.

6 **§ 55-6. MEETINGS; QUORUM.**

7 (A) *IN GENERAL.*

8 (1) THE ADVISORY COMMISSION MEETS ONCE PER MONTH.

9 (2) THE ADVISORY COMMISSION MAY HOLD ADDITIONAL MEETINGS, AT THE CALL OF THE
10 CHAIR, AS FREQUENTLY AS REQUIRED TO PERFORM ITS DUTIES.

11 (3) A MAJORITY OF THE MEMBERS OF THE ADVISORY COMMISSION CONSTITUTES A
12 QUORUM FOR THE TRANSACTION OF BUSINESS.

13 (4) AN AFFIRMATIVE VOTE BY THE MAJORITY OF A QUORUM IS NEEDED FOR ANY OFFICIAL
14 ACTION.

15 (B) *RULES OF PROCEDURE.*

16 THE ADVISORY COMMISSION MAY ADOPT RULES OF PROCEDURE TO GOVERN ITS MEETINGS
17 AND PROCEDURES.

18 (C) *FAILURE TO ATTEND MEETINGS.*

19 IF ANY MEMBER IS ABSENT FROM REGULARLY SCHEDULED MEETINGS MORE THAN 3 TIMES
20 IN 1 YEAR, NOT COUNTING ABSENCES EXCUSED BY THE CHAIR:

21 (1) THE MEMBER IS CONSIDERED TO HAVE RESIGNED; AND

22 (2) THE CHAIR MUST REQUEST THAT THE MEMBER'S APPOINTING AUTHORITY FILL THE
23 RESULTANT VACANCY.

24 **§ 55-7. {RESERVED}**

25 **§ 55-8. VOLUNTEERS.**

26 THE ADVISORY COMMISSION MAY ENGAGE THE SERVICES OF VOLUNTEER WORKERS AND
27 CONSULTANTS, WITHOUT SALARY.

28 **§ 55-9. BUDGET.**

29 THE ADVISORY COMMISSION MAY EXPEND FUNDS AS AUTHORIZED IN THE ORDINANCE OF
30 ESTIMATES.

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1 **§ 55-10. POWERS AND DUTIES.**

2 (A) *IN GENERAL.*

3 THE MAYOR'S ANTI-ANIMAL ABUSE ADVISORY COMMISSION MAY UNDERTAKE THE
4 ACTIVITIES DESCRIBED IN THIS SECTION.

5 (B) *RESEARCH AND ADVISE.*

6 THE ADVISORY COMMISSION MAY RESEARCH BEST PRACTICES IN THE FOLLOWING AREAS
7 AND PROVIDE RECOMMENDATIONS TO CITY AGENCIES ON EACH TOPIC:

8 (1) WAYS TO ERADICATE ANIMAL ABUSE IN THE CITY OF BALTIMORE, INCLUDING
9 DOGFIGHTING;

10 (2) METHODS OF INCREASING AWARENESS OF ANIMAL CRUELTY LAWS;

11 (3) LEGISLATION TO PROTECT ANIMALS AND PROSECUTE ABUSERS;

12 (4) TRAINING TECHNIQUES FOR LAW ENFORCEMENT OFFICIALS ON HOW TO HANDLE
13 ANIMAL CRUELTY CASES HUMANELY AND TO ENSURE ACQUISITION OF THE BEST
14 EVIDENCE TO PROSECUTE ABUSERS;

15 (5) STEPS TO FOSTER IMPROVED RESPONSES TO INCIDENTS OF ANIMAL CRUELTY; AND

16 (6) METHODS TO IMPROVE TRAINING FOR ANIMAL CONTROL OFFICERS FOR THEIR
17 PROTECTION AS WELL AS THE ANIMALS.

18 (C) *MONITOR PROGRAMS.*

19 THE ADVISORY COMMISSION MAY:

20 (1) REVIEW AND MONITOR THE SUCCESSES AND LESSONS LEARNED IN IMPLEMENTING
21 ITS RECOMMENDATIONS; ~~AND~~

22 (2) MAKE RECOMMENDATIONS FOR IMPROVING THE EFFECTIVENESS OF PROGRAMS
23 TARGETING ANIMAL ABUSE; AND

24 (3) REVIEW AND MONITOR ONGOING ANIMAL CRUELTY CALLS AND PROVIDE
25 RECOMMENDATIONS TO CITY AGENCIES FOR EFFECTIVE AND TIMELY
26 INVESTIGATION BY AND COORDINATION AMONG CITY AGENCIES.

27 (D) *EVALUATE POLICIES AND PROGRAMS.*

28 THE ADVISORY COMMISSION MAY REVIEW AND EVALUATE THE IMPACT OF EXISTING AND
29 PROPOSED POLICIES, PROGRAMS, AND LEGISLATION AFFECTING THE EFFORT TO ERADICATE
30 ANIMAL ABUSE IN BALTIMORE.

31 **§ 55-11. {RESERVED}**

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1 § 55-12. AGENCY ASSISTANCE.

2 AT THE REQUEST OF THE ADVISORY COMMISSION, ALL CITY OFFICIALS AND AGENCIES MUST
3 EXTEND THE SERVICES AND FACILITIES REQUIRED FOR THE PERFORMANCE OF THE ADVISORY
4 COMMISSION'S DUTIES, TO THE EXTENT THAT THOSE OFFICIALS AND AGENCIES ARE ABLE TO
5 DO SO GIVEN THEIR PERSONNEL AND BUDGETS.

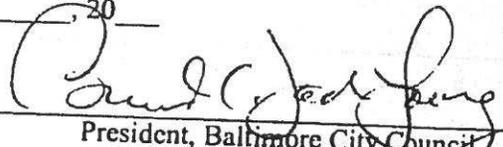
6 § 55-13. ANNUAL REPORTS.

7 THE ADVISORY COMMISSION MUST SUBMIT AN ANNUAL REPORT ON ITS ACTIVITIES TO THE
8 MAYOR AND CITY COUNCIL.

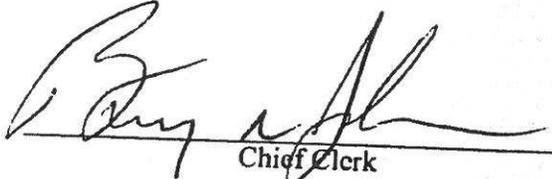
9 SECTION 2. AND BE IT FURTHER ORDAINED, That the catchlines contained in this Ordinance
10 are not law and may not be considered to have been enacted as a part of this or any prior
11 Ordinance.

12 SECTION 3. AND BE IT FURTHER ORDAINED, That this Ordinance takes effect on the 30th day
13 after the date it is enacted.

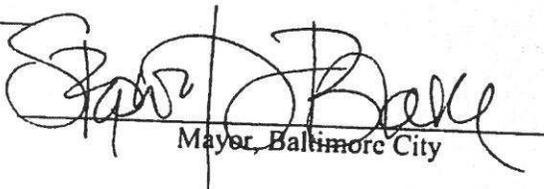
Certified as duly passed this 10 day of OCT 04 2010, 2010

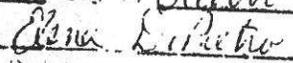

President, Baltimore City Council

Certified as duly delivered to Her Honor, the Mayor,
this 10 day of OCT 04 2010, 2010


Chief Clerk

Approved this 10 day of OCT 08 2010, 2010


Mayor, Baltimore City

Approved For Form and Legal Sufficiency
This 5th Day of October 2010

Assistant Secretary

A TRUE COPY
Edward J. Gallagher
Director of Finance