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

Proceeding	92044495
Party	Plaintiff MICHAEL ADAY, p/k/a/ MEAT LOAF ,
Correspondence Address	PETER J. LYNFIELD ABELMAN, FRAYNE & SCHWAB 666 THIRD AVENUE NEW YORK, NY 10017-5621 sjquigley@lawabel.com
Submission	Motion to Suspend for Civil Action
Filer's Name	Stephen J. Quigley
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Date	06/30/2006
Attachments	Suspend 92044495.pdf (16 pages)(963481 bytes)

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

MICHAEL ADAY, p/k/a/ MEAT LOAF,

Petitioner,

v.

BAT OUT OF HELL, INC.

Registrant.

Cancellation No. 92044495

PETITIONER'S MOTION TO SUSPEND THE PROCEEDING

Petitioner, Michael Aday, p/k/a Meat Loaf, through his attorneys, moves this Board, pursuant to 37 C.F.R. §2.117(a), to suspend the captioned proceeding pending the disposition of the civil action *Michael Aday p/k/a/ Meat Loaf v. Jim Steinman, Bat Out of Hell, Inc., and David Sonenberg*, 2:06-cv-03290-CAS-E (C.D.Cal.), filed on May 26, 2006.

This motion is based upon all the pleadings and the Memorandum of Law in Support of Petitioner's Motion to Suspend the Proceeding, filed simultaneously with this motion, and the exhibit attached therewith.

Dated: June 30, 2006

Respectfully submitted,

Abelman, Frayne & Schwab

By: 

Peter J. Lynfield/Stephen J. Quigley
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Attorneys for Petitioner

CERTIFICATE OF SERVICE

I certify that a true copy of the foregoing PETITIONER'S MOTION TO SUSPEND THE PROCEEDING and the accompanying MEMORANDUM OF LAW were served on Registrant by first class mail, postage prepaid, this 30th day of June, 2006 to Registrant's attorney:

Ilene S. Farkas, Esq.
Pryor Cashman Sherman & Flynn LLP
410 Park Avenue
New York, NY 10022



Stephen J. Quigley

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
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**MEMORANDUM OF LAW IN SUPPORT OF
PETITIONER'S MOTION TO SUSPEND THE PROCEEDING**

Suspension of the captioned action ("Board Action") is warranted because 1) the parties in the civil action, *Michael Aday p/k/a/ Meat Loaf v. Jim Steinman, Bat Out of Hell, Inc., and David Sonenberg*, 2:06-cv-03290-CAS-E (C.D.Cal.) ("Civil Action"), are identical to the parties in the Board Action; 2) the trademark involved in the Civil Action is the same mark that is the subject of the Board Action; and 3) the relief sought in the Civil Action includes the same relief sought in the Board Action. A copy of the complaint in the Civil Action, filed on May 26, 2006, is attached hereto as Exhibit A.

As set forth in *Trademark Trial and Appeal Board Manual of Procedure* § 510.02(a): "To the extent that a civil action in a Federal district court involves issues common with those in a proceeding before the Board, the decision of the Federal district court is often binding upon the Board, while the decision of the Board is not binding upon the court." In Professor McCarthy's view, "[i]t is standard procedure for the Trademark Board to stay administrative proceedings pending the outcome of court litigation between the same parties involving related issues." J.

Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition* (4th Ed.), § 32:47, citing *Alfred Dunhill of London, Inc. v. Dunhill Tailored Clothes, Inc.*, 293 F.2d 865, 130 USPQ 412 (C.C.P.A. 1961), *cert. den.* 369 U.S. 864 (1962).

The issue in the Board Action, i.e., the validity of BAT OUT OF HELL Registration No. 1,974,464, is also an issue in the Civil Action (Second Cause of Action) and the relief sought in the Board Action, i.e., the cancellation of Registration No. 1,974,464, is also being sought in the Civil Action (Prayer for Relief No. 2).

There is no question, therefore, that the disposition of the Civil Action “may have a bearing on the case” before the Board (37 C.F.R. §2.117(a)). For this reason, suspension of the Board Action is appropriate and proper.

Dated: June 30, 2006

Respectfully submitted,

Abelman, Frayne & Schwab

By: 

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EXHIBIT A

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13 Attorneys for Plaintiff
14 Michael Aday p/k/a Meat Loaf

15 UNITED STATES DISTRICT COURT
16 CENTRAL DISTRICT OF CALIFORNIA

17 MICHAEL ADAY p/k/a MEAT LOAF,
18 an individual,

19 Plaintiff,

20 v.

21 JIM STEINMAN, an individual;
22 BAT OUT OF HELL, INC., a New
23 York corporation; and
24 DAVID SONENBERG, an individual,

25 Defendants.

26 CASE NO.

27 COMPLAINT FOR:

- 28 (1) DECLARATORY JUDGMENT
OF TRADEMARK
INVALIDITY
(2) DECLARATORY JUDGMENT
OF TRADEMARK NON-
INFRINGEMENT
(3) TORTIOUS INTERFERENCE
WITH CONTRACTUAL
RELATIONS

DEMAND FOR TRIAL BY JURY

SUMMARY OF ACTION

1. For the past 29 years, Plaintiff Michael Aday p/k/a Meat Loaf
("Plaintiff") has used the BAT OUT OF HELL mark extensively and continuously
in connection with, among other things, his live musical performances, audio and
visual recordings and merchandising. As a result of Plaintiff's world-renowned
artistic talent and continuous touring, marketing and promotional efforts, the first

1 *Bat Out Of Hell* album has become one of the most successful albums in the history
2 of recorded music. Since the release of the first *Bat Out of Hell* album, Plaintiff has
3 released a multitude of additional albums utilizing the BAT OUT OF HELL mark
4 in the title, including, without limitation, *Bat Out Of Hell II* which, to date has sold
5 in excess of 11 million copies. Defendants Jim Steinman and *Bat Out Of Hell, Inc.*
6 ("Defendant BOH"), on the other hand, have never used the BAT OUT OF HELL
7 mark.

8 2. Out of nowhere in 1995, Defendant BOH applied for a trademark
9 registration for BAT OUT OF HELL with the Patent Trademark Office ("PTO").
10 Plaintiff's exploitation of the mark has always taken place without the consent or
11 objection of Defendant Steinman and Defendant BOH. Nevertheless, in the
12 process, Defendant falsely represented to the PTO that *Bat Out Of Hell, Inc.* had
13 exclusive rights to the mark. After 29 years of use of the mark by Plaintiff,
14 Defendant BOH is contending for the first time ever that Plaintiff's use of the BAT
15 OUT OF HELL mark constitutes trademark infringement.

16 3. This contention is blackmail and a hold-up. Neither Defendant BOH
17 nor Defendant Steinman have any claim to the BAT OUT OF HELL mark.
18 Defendants are merely attempting to harass Plaintiff, who had to discharge
19 Defendant Steinman as the producer of the *Bat Out Of Hell III* album when it
20 became apparent Plaintiff could no longer perform in accordance with the parties'
21 agreement. Shortly thereafter, and in blatant retaliation, Defendant Steinman
22 threatened Plaintiff with a legal action for trademark infringement.

23 4. Defendants Jim Steinman and David Sonenberg used the trademark
24 rights they purportedly claim to control as the basis of a campaign to undermine and
25 interfere with Plaintiff's upcoming *Bat Out Of Hell III* concert, album and tour, as
26 well as Plaintiff's existing contracts. Plaintiff therefore requests that the Court
27 enter a preliminary and permanent injunction against Defendants Steinman and
28 Sonenberg from tortiously interfering with Plaintiff's contracts, and award

1 compensatory and punitive damages sustained as a result of Defendants' wrongful
2 conduct.

3 4 PARTIES

5 5. Plaintiff Michael Aday, an individual, resides within the Central
6 District of California.

7 6. On information and belief, Defendant BOH is a New York
8 corporation.

9 7. Defendant Sonenberg, an individual, is a resident of the State of New
10 York, and at all relevant times served as Plaintiff's manager and advisor.

11 8. Defendant Steinman, an individual, is a resident of the State of
12 Connecticut.

13 14 JURISDICTION AND VENUE

15 9. This Court has subject matter jurisdiction pursuant to 28 U.S.C. §§
16 1331 and 1338 (federal question), and 28 U.S.C. §1338(a) (trademark disputes).
17 The Court has supplemental or pendent jurisdiction over the tortious interference
18 claims pursuant to 28 U.S.C. § 1367(a), in that these claims involve the same facts
19 and issues, and form part of the same case or controversy, as the federal question
20 claims.

21 10. Defendants are subject to the exercise of personal jurisdiction because
22 they have sufficient contacts with this judicial district generally, and in particular,
23 with regard to the events alleged herein. Venue is proper in this judicial district
24 pursuant to 28 U.S.C. § 1391(b) and (c).

25 26 ALLEGATIONS

27 11. The first *Bat Out Of Hell* album is one of the most acclaimed and
28 successful albums in the history of recorded music. To date, more than 34 million

1 copies of the album have been sold worldwide, including more than 14 million in
2 the United States.

3 12. The concept of the *Bat Out Of Hell* album resulted from a joint
4 creative effort between Plaintiff and Defendant Steinman. The "Bat Out Of Hell"
5 song was written by Defendant Steinman in 1975; other songs featured on the *Bat*
6 *Out Of Hell* album were written by Defendant Steinman between 1969 and 1977.

7 13. Plaintiff was the artist, singer and performer for *Bat Out Of Hell*. His
8 role included providing portions of the lyrics, as well as developing the overall
9 presentation of the songs. Plaintiff performed all the songs on the album, and was
10 and is the sole user of the BAT OUT OF HELL mark.

11 14. Defendant Steinman and Plaintiff agreed that their collaboration would
12 be divided as follows: Defendant Steinman would control the publishing of the
13 songs, and Plaintiff would control everything else, including (among other things)
14 the recordings, performances, tours and merchandising.

15 15. The first *Bat Out Of Hell* album was released on October 21, 1977,
16 and was an instant success. The album went platinum in August 1978.

17 16. Plaintiff always maintained control of the relationships and
18 negotiations with the record company that released *Bat Out Of Hell*. Defendant
19 Steinman did not control any aspect of the financing, distribution, merchandising or
20 touring associated with the *Bat Out Of Hell* album.

21 17. Following the success of *Bat Out Of Hell I*, a *Bat Out Of Hell II* album
22 was released in September 1993. Defendant Steinman wrote the songs and
23 produced the album. Plaintiff provided most of the lyrics, singing, performing and
24 developing the overall presentation of the songs.

25 18. The *Bat Out Of Hell II* album sold more than 14 million copies
26 worldwide, including more than 5 million in the United States.

27 19. Since the release of *Bat Out of Hell I* in 1977, Plaintiff and Plaintiff
28 alone has controlled all aspects of concerts, tours and merchandise sold bearing the

1 BAT OUT OF HELL mark. Plaintiff never requested or received, either expressly
2 or by implication, a license in connection with merchandising or anything else, and
3 Defendant BOH never intimated that Plaintiff was liable for infringement in using
4 the mark at any point during the last 29 years.

5 20. The vast majority of media reports confirm the public's perception
6 that Plaintiff is the party associated with the mark. This association is no casual
7 relationship, as Plaintiff's fans are quite passionate about him, and the *Bat Out Of*
8 *Hell* series of recordings.

9 21. Despite Plaintiff's extensive and continuous use of the BAT OUT OF
10 HELL mark in interstate commerce, Defendant Steinman filed an application with
11 the PTO in connection with the BAT OUT OF HELL mark on June 13, 1995.
12 Defendant Steinman sought to register BAT OUT OF HELL for "a series of pre-
13 recorded sound recordings in the form of vinyl records, audio tapes and compact
14 discs."

15 22. Defendant Steinman's registration of the BAT OUT OF HELL
16 trademark is of no effect, and has had no effect. Plaintiff continued to use the mark
17 in connection with live performances, recordings, and merchandise continuously
18 from 1995 to the present, just as he had done prior to 1995.

19 23. On or about May 5, 2003, Plaintiff executed a written agreement with
20 Polydor, a division of Universal Music GmbH ("Universal"), wherein Universal
21 agreed to pay Plaintiff royalties in exchange for the exclusive license to
22 manufacture and sell certain recordings performed by Plaintiff throughout the
23 world, excluding the United States.

24 24. On or about March 16, 2006, Plaintiff executed a written agreement
25 with Virgin Records America, Inc. ("Virgin") wherein Virgin agreed to pay
26 Plaintiff royalties in exchange for the exclusive license to distribute Plaintiff's *Bat*
27 *Out Of Hell III* album in the United States and Canada.

28

1 25. Defendant BOH first objected to Plaintiff's use of the mark in 2005,
2 12 years after filing its application with the PTO, and after 29 years of continuous
3 unabated use of the mark by Plaintiff.

4 26. On or about October 20, 2005, Plaintiff filed a petition with the PTO
5 to cancel Defendant BOH's trademark on the ground that it was fraudulently
6 obtained. The PTO action is currently pending.

7 27. Recently, in 2006, Defendants contacted Plaintiff's music distributors,
8 including Universal and Virgin. Defendants falsely and fraudulently represented to
9 Universal and Virgin, both orally and in writing, that Plaintiff's use of the BAT
10 OUT OF HELL mark constitutes trademark infringement.

11 28. Plaintiff is filing this action in order to obtain relief unavailable in the
12 pending PTO action, including: (1) a declaratory judgment that Plaintiff's use of the
13 BAT OUT OF HELL mark is non-infringing; (2) a declaratory judgment that
14 Plaintiff is the sole owner of the BAT OUT OF HELL mark; (3) injunctive relief
15 preventing Defendants from causing further interference with Plaintiff's existing
16 contracts; and (4) compensatory and punitive damages in connection with
17 Defendant's tortious interference with Plaintiff's existing contracts.

18
19 **FIRST CAUSE OF ACTION**

20 **For Declaratory Judgment of Non-Infringement**

21 29. Plaintiff realleges and incorporates herein by reference each of the
22 foregoing and subsequent paragraphs, and further alleges as follows:

23 30. An actual, present and justiciable controversy between Plaintiff and
24 Defendant BOH now exists as to their respective rights to the BAT OUT OF HELL
25 mark.

26 31. Plaintiff seeks declaratory relief from this Court that Plaintiff's use of
27 the BAT OUT OF HELL mark does not constitute trademark infringement.

SECOND CAUSE OF ACTION

For Declaratory Judgment of Trademark Invalidity

32. Plaintiff realleges and incorporates herein by reference each of the foregoing and subsequent paragraphs, and further alleges as follows:

33. An actual, present and justiciable controversy between Plaintiff and Defendant BOH now exists as to their respective rights to the name BAT OUT OF HELL.

34. Plaintiff seeks declaratory relief from this Court that any and all BAT OUT OF HELL marks registered with the PTO are invalid.

35. Defendant Steinman caused Defendant BOH to knowingly submit a false declaration to the Patent Trademark Office ("PTO") with the intent to deceive. On June 13, 1995, Defendant BOH falsely stated that "no other person, firm, corporation, or association has the right to use said mark in commerce . . ."

36. Defendant BOH knew perfectly well that Plaintiff had used the mark BAT OUT OF HELL continuously since 1977 in connection with albums, concerts, tours, merchandise and live performances.

37. Defendant BOH willfully withheld material information from the PTO which, if disclosed, would have resulted in denial of the registration sought or the registration to be maintained.

38. At the time Defendant BOH filed its application with the PTO, Plaintiff had legal rights to the BAT OUT OF HELL mark that were superior to the claimed "rights" of Defendant BOH.

39. Defendant BOH, in failing to disclose the true facts to the PTO, intended to, and did, procure a registration to which Defendant BOH was not entitled.

1
2 **THIRD CAUSE OF ACTION**

3 **For Tortious Interference With Contract**

4 **(Against Jim Steinman)**

5 40. Plaintiff realleges and incorporates herein by reference each of the
6 foregoing and subsequent paragraphs, and further alleges as follows:

7 41. Defendant Steinman caused his representatives and/or others acting
8 on his behalf to interfere with Plaintiff's existing contracts with Universal and
9 Virgin. Defendant Steinman did so in an effort to harm Plaintiff, and to undermine
10 and interfere with Plaintiff's upcoming *Bat Out Of Hell III* album and concert tour.

11 42. Defendant Steinman engaged in the foregoing acts in order to cause
12 Virgin and Universal to terminate, cancel or otherwise breach their agreements with
13 Plaintiff. Steinman and his representatives and/or others acting on Steinman's
14 behalf misrepresented that Plaintiff does not hold a valid trademark in the name and
15 that Plaintiff's use of the mark constitutes trademark infringement.

16 43. The foregoing acts adversely affected Plaintiff's relationships with
17 Virgin and Universal.

18 44. As a result of Defendant Steinman's tortious conduct, Plaintiff has
19 suffered and continues to suffer damages in excess of \$50,000,000, or in an amount
20 to be proven at trial.

21 45. In doing the acts alleged herein, Defendant Steinman acted
22 fraudulently, maliciously, and oppressively, and as a result of such outrageous
23 conduct, Plaintiff is entitled to an award of exemplary and punitive damages.
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2 **FOURTH CAUSE OF ACTION**

3 **For Tortious Interference With Contract**

4 **(Against David Sonenberg)**

5 46. Plaintiff realleges and incorporates herein by reference each of the
6 foregoing and subsequent paragraphs, and further alleges as follows:

7 47. On information and belief, Defendant Sonenberg initiated
8 communications with Virgin, Universal and others. Defendant Sonenberg did so in
9 an effort to harm Plaintiff, and to interfere with and undermine Plaintiff's upcoming
10 *Bat Out of Hell III* album and concert tour.

11 48. These communications were designed to cause Virgin and Universal to
12 terminate, cancel or otherwise breach their agreements with Plaintiff. On
13 information and belief, these communications misrepresented that Plaintiff does not
14 hold a valid trademark in the name BAT OUT OF HELL and that Plaintiff's use of
15 the mark constitutes trademark infringement.

16 49. Defendant Sonenberg's threats adversely affected Plaintiff's
17 relationship with Virgin, Universal and other distributors.

18 50. As a result of Defendant Sonenberg's tortious conduct, Plaintiff has
19 suffered and continues to suffer damages in excess of \$50,000,000, or in an amount
20 to be proven at trial.

21 51. In doing the acts alleged herein, Defendant Sonenberg acted
22 fraudulently, maliciously, and oppressively, and as a result of such outrageous
23 conduct, Plaintiff is entitled to an award of exemplary and punitive damages.
24

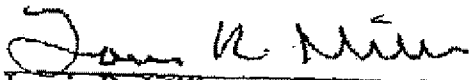
25 **PRAYER FOR RELIEF**

26 Plaintiff prays for relief, as follows:

27 1. For declaratory judgment that Plaintiff is not infringing any mark for
28 *Bat Out of Hell*;

2. For declaratory judgment canceling all of Defendants' marks for BAT OUT OF HELL;
3. For declaratory judgment that Plaintiff is the exclusive owner of all right, title and interest in the BAT OUT OF HELL trademark;
4. For a preliminary and permanent injunction against Defendants Steinman and Sonenberg from interfering with Plaintiff's contractual relationships;
5. For compensatory damages in excess of \$50,000,000, or in an amount to be determined at trial resulting from Defendant Sonenberg's tortious conduct;
6. For compensatory damages in excess of \$50,000,000, or in an amount to be determined at trial resulting from Defendant Steinman's tortious conduct;
7. For punitive damages to be assessed against Defendants Steinman and Sonenberg;
8. For costs of suit incurred herein;
9. For attorney's fees as permitted by law;
10. For prejudgment interest;
11. For such further relief as this Court may deem proper.

DATED: May 26, 2006



Louis R. Miller
Attorneys for Plaintiff
Michael Aday p/k/a Meat Loaf

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DEMAND FOR JURY TRIAL

Pursuant to Federal Rule of Civil Procedure 38, Plaintiff hereby demands a trial by jury on all issues so triable.

DATED: May 26, 2006


Louis R. Miller
Attorneys for Plaintiff
Michael Aday p/k/a Meat Loaf