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

Proceeding	92047744
Party	Defendant CAPLIN, LEE
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Submission	Motion to Suspend for Civil Action
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Date	01/23/2008
Attachments	AR-M355N_20080123_132019.pdf (18 pages)(877172 bytes)

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FILED

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CLERK U.S. DISTRICT COURT
CENTRAL DIST. OF CALIF.
LOS ANGELES

BY _____

UNITED STATES DISTRICT COURT

CENTRAL DISTRICT OF CALIFORNIA

CV07-07842 GW (CWx)

LEE CAPLIN, Plaintiff, vs. LOS ANGELES CONFIDENTIAL MEDIA, LLC, and DOES 1-20, inclusive, Defendants.	CASE NO.: COMPLAINT FOR INJUNCTIVE RELIEF AND DAMAGES FOR: 1. TRADEMARK INFRINGEMENT (FEDERAL); 2. TRADEMARK INFRINGEMENT--REVERSE CONFUSION (FEDERAL); 3. LANHAM ACT VIOLATION; 4. UNFAIR COMPETITION (FEDERAL); 5. TRADEMARK INFRINGEMENT (STATE); 6. UNFAIR COMPETITION (STATE); 7. TRADEMARK INFRINGEMENT--REVERSE CONFUSION (STATE); 8. ACCOUNTING

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JURISDICTION AND VENUE

1. This Court has original jurisdiction over the subject matter of this action pursuant to 15 U.S.C. § 1125(a) et seq.; 28 U.S.C. § 1331, § 1338(a) and (b), and the principles of pendant and ancillary jurisdiction. Venue in this district is proper pursuant to 28 U.S.C. § 1391 (b) and (c).

NATURE OF ACTION

2. This is an action for trademark infringement in violation of section 43 of the Lanham Act, 15 U.S.C. §1125 and Section 32 of the Lanham Act, 15 U.S.C. 1114; for false designation of origin and false descriptions and representations in commerce under section 43 of the Lanham Act 15 U.S.C. §1125; for unfair and deceptive methods of competition in violation of the Unfair Business Practices Act, California Business & Professions Code §17200 et seq.; for trademark infringement in violation of California Business & Professions Code §14330 et seq.; and for an accounting under California law.

PARTIES

3. Plaintiff is, and at all times material hereto, an individual residing in Los Angeles, California.

4. Plaintiff is the owner of the trademark "LA CONFIDENTIAL" (hereinafter referred to as "the Trademark") for, comic books and fiction books (hereinafter referred to as "the Products").

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5. Since November 1997, Plaintiff has continuously manufactured, sold, and distributed products incorporating and bearing the Trademark, including but not limited to the Products bearing and/or produced under the Trademark.

6. Before the filing of this action, Plaintiff's business has significantly included the creation and nationwide commercial exploitation of the Trademark in connection with the Products and Plaintiff has acquired, through widespread distribution of the Products and significant advertising and promotion of the Products and the Trademark, distinctive recognition in the minds of its customers of the Products under the Trademark.

7. Upon information and belief, Defendant LOS ANGELES CONFIDENTIAL MEDIA, LLC is a limited liability company organized under the laws of the State of New York, is subject to the jurisdiction of this Court, and is promoting and producing material which infringes Plaintiff's Trademark.

8. Plaintiff is ignorant of the true names and capacities of Defendants sued herein as DOES 1 through 20, inclusive, and therefore sues such Defendants by such fictitious names. Plaintiff will amend this Complaint to state their true names and capacities when the same have been ascertained. Plaintiff is informed and believes, and upon such information and belief alleges, that each of the fictitiously named Defendants is responsible in some manner for the occurrences herein alleged, and that Plaintiff's damages as herein alleged were proximately caused by the acts or

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omissions of such Defendants (LOS ANGELES CONFIDENTIAL MEDIA, LLC and DOES 1 through 20 are collectively hereinafter referred to as "the Defendants").

9. Plaintiff is informed and believes, and upon such information and belief alleges, that each of the Defendants was the agent, representative and/or employee of each of the other Defendants, and in doing the things hereinafter alleged, was acting within the scope and course of such agency, representation and/or employment.

GENERAL ALLEGATIONS

10. Upon information and belief, long after the adoption and use by Plaintiff of its Trademark on the Products, the Defendants have promoted, produced and sold products incorporating a mark substantially similar to Plaintiff's Trademark, using said infringing mark in commerce without Plaintiff's consent, including, without limitation, advertising and selling printed publications under the mark "Los Angeles Confidential Guide". The Defendants are not licensed by Plaintiff, and at all relevant times were not authorized by Plaintiff, or any authorized agent of Plaintiff, to promote, produce or sell such products under such name. The Defendants are currently engaged in such use and unless enjoined by this Court will continue such use.

11. By engaging in the above-mentioned conduct, the Defendants have acted in willful disregard of the Trademarks and other laws protecting Plaintiff's goodwill and Trademarks, and have confused and deceived, or threatened to confuse

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and deceive, the consuming public as to the source and sponsorship of Defendants' said products.

FIRST CAUSE OF ACTION

FOR FEDERAL TRADEMARK INFRINGEMENT

AGAINST ALL DEFENDANTS

12. Plaintiff repeats and adopts each allegation contained in paragraphs 1 through 11 of this Complaint as though fully set forth herein.

13. Plaintiff's claim arises under section 43 of the Lanham Act, 15 U.S.C. §1125 and Section 32 of the Lanham Act, 15 U.S.C. 1114, for infringement of Plaintiff's registered Trademark.

14. Plaintiff is the owner of the registered Trademark "LA Confidential," Registration No. 2875852.

15. The Defendants have intentionally and knowingly copied Plaintiff's distinctive Trademark as alleged in paragraph 10 hereof.

16. The Defendants, without permission, license, or authority from Plaintiff, produced, promoted and sold their products, in violation of Plaintiff's Trademark, within this District and throughout the United States.

17. Prior to the Defendants' acts complained of herein:

(a) Plaintiff marketed and sold products incorporating and bearing the Trademark including but not limited to the Products under the Trademark;

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(b) Plaintiff expended and continues to spend large sums of money to build, maintain, and extend his reputation;

(c) Plaintiff engaged and continues to engage in interstate activities designed to promote the Products sold and the goodwill associated with its Trademark throughout the United States;

(d) Plaintiff engaged and continues to engage in interstate activities designed to promote the business and goodwill identified by its Trademark in interstate commerce and to expand the use and reputation of its Trademark in California and throughout the United States;

(e) The Trademark has been and continues to be known in numerous states, including California, as a mark identifying and distinguishing the products of Plaintiff; and

(f) The Trademark is inherently distinctive, and has been and continues to be known throughout the United States, including California, as identifying and distinguishing Plaintiff's business.

18. The Defendants' conduct is likely to cause confusion, cause mistake, or to deceive customers as to the source and origin of the products promoted and sold by Defendants and Plaintiff.

19. Upon information and belief, the Defendants' activities have caused actual confusion with consumers as to the source and origin of such products.

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20. The acts of the Defendants will nullify Plaintiff's right to the exclusive use of its Trademark free from infringement.

21. The Defendants' activities have had and will continue to have a substantial, adverse effect on Plaintiff's existing and projected future interstate business of marketing products and services identified by its Trademark, and the goodwill of Plaintiff's business connected with the use of, and symbolized by, Plaintiff's Trademark.

22. The Defendants' activities and conduct constitute infringement of Plaintiff's Trademark in violation of Section 43 of the Lanham Act, 15 U.S.C. §1125 and Section 32 of the Lanham Act, 15 U.S.C. 1114.

23. Plaintiff has been and continues to be damaged by the Defendants' activities and conduct. The Defendants have profited thereby and unless their conduct is enjoined, Plaintiff and its goodwill and reputation will suffer irreparable injury which cannot be adequately compensated solely by money damages.

24. Unless the conduct of the Defendants is enjoined, Plaintiff and its goodwill and reputation will continue to suffer irreparable injury which cannot be adequately compensated solely by money damages. Accordingly, Plaintiff seeks permanent injunctive relief pursuant to 15 U.S.C. §1116.

25. The Defendants have intentionally and knowingly used Plaintiff's Trademarks; accordingly, Plaintiff is entitled to a judgment of up to three times its

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damages or Defendants' profits, together with reasonable attorneys' fees pursuant to 15 U.S.C. §1117(a).

SECOND CAUSE OF ACTION

FEDERAL TRADEMARK INFRINGEMENT--REVERSE CONFUSION

AGAINST ALL DEFENDANTS

26. Plaintiff repeats and adopts each allegation contained in paragraphs 1 through 11, and 13 through 23 of this Complaint as though fully set forth herein.

27. The Defendants' activities and conduct constitute infringement of Plaintiff's Trademarks in violation of Section 43 of the Lanham Act, 15 U.S.C. §1125.

28. The Defendants' extensive, yet junior, use of Plaintiff's Trademark, particularly in connection with the Defendants' use of the Trademark or substantially similar marks on printed publications, is likely to cause substantial reverse confusion and devaluation of Plaintiff's Trademark, as the Defendants' extensive use of the Trademark will likely cause consumers to believe that Plaintiff's subsequent use of the Trademarks originate from, and/or were authorized, licensed, or approved by, the Defendants.

29. Plaintiff has been and continues to be damaged by Defendants' activities and conduct. The Defendants have profited thereby and unless their conduct is enjoined, Plaintiff and its goodwill and reputation will suffer irreparable injury which cannot be adequately compensated solely by money damages.

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Accordingly, Plaintiff seeks permanent injunctive relief pursuant to 15 U.S.C. §1116.

THIRD CAUSE OF ACTION

FALSE DESIGNATION OF ORIGIN AND FALSE DESCRIPTION UNDER SECTION 43 (A) OF THE LANHAM ACT AGAINST ALL DEFENDANTS

30. Plaintiff repeats and adopts each allegation contained in paragraphs 1 through 11, 13 through 23, and 28 of this Complaint as though fully set forth herein.

31. Plaintiff's claim arises under section 43(a) of the Lanham Act, 15 U.S.C. §1125(a), for false designation of origin and false descriptions and representations in interstate commerce.

32. Plaintiff's Trademark has been used throughout the United States and, in some cases, worldwide, and are well known to members of the purchasing public. The public generally associates and identifies Plaintiff's Trademark with the Plaintiff herein.

33. The Defendants' conduct in the promotion and production, of the material incorporating and bearing Plaintiff's Trademark constitutes false designations of origin or sponsorship of said products and tends to falsely represent that said material originates from Plaintiff or that the material and Defendants have been sponsored, approved, or licensed by Plaintiff or are in some way affiliated or connected with Plaintiff. Such conduct of Defendants is likely to confuse, mislead

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and deceive Defendants' customers, purchasers, and members of the public as to the origin of said products and Plaintiff's Trademarks or cause said persons to believe that those products and/or Defendants have been sponsored, approved, authorized, or licensed by Plaintiff or are in some way affiliated or connected with Plaintiff, all in violation of Title 15, U.S.C. § 1125(a).

34. Upon information and belief, the Defendants' actions were done willfully with full knowledge of the falsity of such designations of origin and false descriptions or representations, and with the express intent to cause confusion, and to mislead and deceive the purchasing public.

35. Plaintiff has no adequate remedy at law. The Defendants' conduct described above, has caused and, if not enjoined, will continue to cause irreparable damage to Plaintiff's rights in its Trademark, and to the business, reputation and goodwill of Plaintiff which cannot be adequately compensated solely by money damages.

FOURTH CAUSE OF ACTION

FEDERAL UNFAIR COMPETITION AGAINST ALL DEFENDANTS

36. Plaintiff repeats and adopts each allegation contained in paragraphs 1 through 11, 13 through 23, 28, and 32 through 34 of this Complaint as though fully set forth herein.

37. Plaintiff's claim arises under Section 43(a) of the Lanham Act, 15 U.S.C. §1125(a)(1)(B).

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38. The Defendants' conduct and activities constitute attempts to pass off and palm off their own products as being licensed or approved by the Plaintiff with the intent to deceive the public and to appropriate themselves with Plaintiff's exclusive rights in and to the Trademark. Such acts constitute acts of unfair competition against Plaintiff.

39. Plaintiff has been and continues to be damaged by the Defendants' activities and conduct. Accordingly, pursuant to 15 U.S.C. §1117(a), Plaintiff is entitled to recover its damages, as well as Defendants' profits received as a result of the infringement.

40. Unless the Defendants' conduct is enjoined, Plaintiff and its goodwill and reputation will suffer irreparable injury which cannot be adequately calculated or compensated solely by money damages.

FIFTH CAUSE OF ACTION

STATE AND COMMON LAW TRADEMARK INFRINGEMENT

AGAINST ALL DEFENDANTS

41. Plaintiff repeats and adopts each allegation contained in paragraphs 1 through 11, 13 through 23, 28, 32 through 34, and 38 of this Complaint as though fully set forth herein.

42. Plaintiff's claim arises under the common law of this state relating to Trademark infringement. This Court has jurisdiction over the subject matter of this claim pursuant to the provisions of 28 U.S.C. § 1338(b), this being a claim of

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Trademark infringement joined with a substantial and related claim under the Trademark Laws of the United States, and under this Court's supplementary jurisdiction pursuant to 28 U.S.C. 1367.

43. Plaintiff is the owner of all rights, title and interest in and to the distinctive trade names, trademarks, designs, symbols, and logos used by Plaintiff by virtue of its extensive sales of the Products bearing the Trademark "LA Confidential" and other trade names, trademarks, designs, symbols and logos (collectively "Common Law Trademarks").

44. The materials complained of herein were promoted and produced by the Defendants, utilizing Plaintiff's Common Law Trademarks without Plaintiff's consent or authorization. Such unauthorized use by the Defendants constitutes Trademark infringement and unfair competition and is likely to cause confusion and mistake in the minds of the trade and purchasing public as to the source of the products sold by the Defendants and to cause consumers to believe such products are authorized, sponsored, or approved by Plaintiff when, in fact, they are not.

45. Upon information and belief, the Defendants have intentionally appropriated the Common Law Trademarks with the intent of causing confusion, mistake, and deception as to the source of said products.

46. Plaintiff has been damaged by, and the Defendants have profited from the Defendants' wrongful conduct in an amount to be proven at trial.

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47. Plaintiff has no adequate remedy at law. The conduct of Defendants has caused and, if not enjoined, will continue to cause, irreparable damage to the rights of Plaintiff in its Common Law Trademarks and to the business, reputation, and goodwill of Plaintiff.

SIXTH CAUSE OF ACTION

UNFAIR COMPETITION/MISLEADING ADVERTISING - STATE

AGAINST ALL DEFENDANTS

48. Plaintiff repeats and adopts each allegation contained in paragraphs 1 through 11, 13 through 23, 28, 32 through 34, 38, and 43 through 46 of this Complaint as though fully set forth herein.

49. Plaintiff's claim arises under the California Unfair Business Practices Act, Cal. Bus. & Prof. Code §17200, et seq., 17500, et seq., this being a claim of state unfair competition joined with a substantial and related claim under the Trademark Laws of the United States, and under this Court's supplementary jurisdiction pursuant to 28 U.S.C. 1367.

50. The Defendants' conduct and activities constitute deception, misrepresentation, and false advertising as to the source of the Defendants' products and constitute acts of unfair competition in violation of California Business & Professions Code §17200, et seq.

51. Plaintiff has been and continues to be damaged by the Defendants' activities and conduct. The Defendants have profited thereby and unless their

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conduct is enjoined, Plaintiff and its goodwill and reputation will suffer irreparable injury which cannot be adequately compensated solely by money damages.

SEVENTH CAUSE OF ACTION

STATE AND COMMON LAW TRADEMARK INFRINGEMENT—REVERSE CONFUSION AGAINST ALL DEFENDANTS

52. Plaintiff repeats and adopts each allegation contained in paragraphs 1 through 11, 13 through 23, 28, 32 through 34, 38, and 42 through 46 of this Complaint as though fully set forth herein.

53. The Defendants' extensive, yet junior, use of Plaintiff's Common Law Trademarks, particularly in connection with the Defendants' use of the Common Law Trademarks or substantially similar marks in the printed publications genre, is likely to cause substantial reverse confusion and devaluation of Plaintiff's Common Law Trademarks, as the Defendants' extensive use of the Common Law Trademarks will likely cause consumers to believe that Plaintiff's subsequent use of the Common Law Trademarks originate from, and/or were authorized, licensed, or approved by, the Defendant.

54. Plaintiff has been and continues to be damaged by the Defendants' activities and conduct. The Defendants have profited thereby and unless their conducted is enjoined, Plaintiff and its goodwill and reputation will suffer irreparable injury which cannot be adequately compensated solely by money

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damages. Accordingly, Plaintiff seeks permanent injunctive relief, including under California Business & Professions Code §14335.

EIGHTH CAUSE OF ACTION

CLAIM FOR ACCOUNTING - STATE

ACCOUNTING AGAINST ALL DEFENDANTS

55. Plaintiff repeats and adopts each allegation contained in paragraphs 1 through 11, 13 through 23, 28, 32 through 34, 38, 43 through 46, 49 through 51, and 53 through 54 of this Complaint as though fully set forth herein.

56. As a result of the conduct of the Defendants, Plaintiff has been monetarily damaged in an amount that cannot yet be determined.

57. Plaintiff requires an accounting of all monies made and profits realized by the Defendants in connection with the Defendants' wrongful use of the Trademarks and Common Law Trademarks or substantially similar marks without Plaintiff's authorization, approval, or consent.

PRAYER FOR RELIEF

WHEREFORE, Plaintiff demands judgment against the Defendants as follows:

1. That Defendants, their agents, servants, employees, representatives, successors and assigns and all persons, firms, or corporations in active concert or participation with any of said Defendants, be permanently enjoined from:

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(a) directly or indirectly infringing the above described Trademark and/or Common Law Trademarks of Plaintiff in any manner, including generally, but not limited to promoting and producing and/or selling products which infringe said Trademark and Common Law Trademarks, and specifically promoting, producing and/or selling any products which picture, reproduce, or utilize the likenesses of or which copy or bear a substantial similarity to Plaintiff's Trademark; or

(b) engaging in any conduct that tends falsely to represent that, or is likely to confuse, mislead, or deceive purchasers, the Defendants' customers, and/or members of the public to believe that the actions of the Defendants, the services or products sold by the Defendants or the Defendants themselves are connected with Plaintiff, are sponsored, approved, or licensed by Plaintiff, or are in some way connected or affiliated with Plaintiff;

(c) affixing, applying, annexing or using in connection with the promotion, production or sale and/or offering for sale or other use of any services or goods, a false description or representation, including words or other symbols, tending to falsely describe or represent such services or goods as being those of Plaintiff;

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(d) otherwise competing unfairly with Plaintiff in any manner;

(e) diluting and infringing the aforementioned Trademark and Common Law Trademarks and damaging Plaintiff's goodwill, reputation and business;

2. That those Defendants infringing upon Plaintiff's Trademark be required to pay actual damages increased to the maximum extent provided by law and/or statutory damages.

3. That the Defendants account for and pay over to Plaintiff in accordance with 15 U.S.C. § 1117(a) and § 1125(a) et seq., and California law, all monies made and profits realized by the Defendants by reason of the Defendants' unlawful acts complained of herein;

4. That Plaintiff recovers from Defendants its costs of this action and reasonable attorneys' fees; and

5. That Plaintiff has all other and further relief as the Court may deem just and proper under the circumstances.

DATED: November 27, 2007 AARONSON & AARONSON

By _____
ARTHUR AARONSON,
Attorneys for Plaintiff, Lee Caplin

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JURY TRIAL DEMAND

Plaintiff demands a trial by jury of all issues so triable.

DATED: November 27, 2007 AARONSON & AARONSON

By _____
ARTHUR AARONSON,
Attorneys for Plaintiff, Lee Caplin

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