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

Proceeding	92048465
Party	Plaintiff Victoria Vogel for V V Sterling Corporation
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

*In the matter of Registration No. 3253838  
For "Bikini Destinations" (the "Mark")  
Issued on June 19, 2007*

VICTORIA VOGEL, for  
VV STERLING CORPORATION

Petitioner,

vs.

BENNETT PRODUCTIONS, INC.

Respondent

**Cancellation No. 92048465**

**PETITIONER'S STATUS REPORT TO  
TRADEMARK TRIAL AND APPEAL  
BOARD REGARDING CIVIL ACTION  
BETWEEN PETITIONER AND  
RESPONDENT**

**Cancellation Petition Filed:**  
November 16, 2007

Pursuant to the notice issued November 9, 2009, by the Trademark Trial and Appeal Board ("TTAB") to the parties to this Cancellation Action, Petitioner hereby provides a report of the status of the California federal district court civil action (the "Civil Action"), *VV STERLING v C. CASEY BENNETT, ROBERT BENNETT, et al.* CV 07-08127 GW (Ex), which occasioned the suspension of the presently suspended Cancellation proceeding.

**I. RELEVANT HISTORY OF FEDERAL CIVIL ACTION.**

Through prior counsel, Victoria Vogel ("Vogel") previously brought a *California Civil Code* §3344 action against the present Cancellation Action Respondent in California state court alleging violation of Vogel's right of publicity and unfair competition (*Vogel v. Bennett, et al.*, Los Angeles Superior Court Case No. BC 352438, the "State Court Action"). Eventually, the state court found copyright preemption and dissolved the §3344 claim, opining at the time that Vogel's likeness and personal rights were embodied in copyrightable works. A Summary Judgment ruling in the Defendants' favor was issued December 3, 2007.

Victoria Vogel and VV Sterling Corporation, Petitioner in this Cancellation

Action, filed the Civil Action in California federal district court for trademark and copyright infringement on December 13, 2007.

Ms. Vogel appealed the State Court's Summary Judgment ruling and succeeded in being granted a reversal of the MSJ in its entirety by the California Court of Appeal for the Second Appellate District on June 17, 2009. The Defendants in the State Court Action filed a Petition for Review of the Appellate Court Opinion to the California Supreme Court on July 27, 2009, but their petition to obtain reversal of the Opinion was denied.

A major impact of the Appellate Court reversal was to restore important trademark claims to the federal Civil Action, including a claim to the Mark at issue in the present Cancellation Proceeding. The Civil Action Court had precluded reference to certain trademarks, ruling that these trademarks had been raised or could have been raised in the State Court Action. The Appellate Court reversal of the MSJ effectively rendered the Civil Court's preclusion rulings moot.

With the reversal of the Summary Judgment ruling by the State Appellate Court, Defendants stipulated to allow Plaintiffs to file a third amended complaint in the Civil Action – unrestricted by the Court's prior orders. The Court granted the parties' request on August 13, 2009, and the now operative pleading in the Civil Action, the third amended complaint ("TAC"), was filed September 8, 2009.

## **II. RELATED TTAB PROCEEDINGS BETWEEN THE PARTIES.**

On October 7, 2008, Respondent in the present Cancellation Action filed an Opposition with the TTAB, Proceeding Number 91186845, opposing Petitioner's application for registration of the *Playing in Paradise* trademark. The basis of Opposer's Opposition is a claim of ownership in the disputed mark. Opposer previously filed an application to register the same mark, *Playing in Paradise*, on an "intent to use" basis with no dates listed on their application for "first use" or "first use in commerce." On January 5, 2008, nine months prior to filing an Opposition to Applicant's application, Opposer's application was deemed *abandoned* and is currently listed as "Dead" in the USPTO data base. Nonetheless, Opposer continues to illegally develop and exploit properties under the mark, "Playing in Paradise."



**III. SUSPENSION OF THIS CANCELLATION PROCEEDING IS NECESSARY AS THE FEDERAL CIVIL ACTION WILL LIKELY BE DISPOSITIVE OF THE TTAB CANCELLATION PROCEEDING, THE OPPOSITION PROCEEDING AND OTHER PENDING APPLICATIONS.**

Clearly, the aforementioned Opposition proceeding as well as the present Cancellation Action will be affected by the disposition of the federal Civil Action. On Thursday, December 3, 2009, the parties to the Civil Action will appear at a hearing on Defendants' motion to dismiss the TAC. Petitioner anticipates that the Court will not grant Defendants' motion and that the matter will be scheduled for trial. No new bases have been argued by Defendants in their motion to dismiss, discovery has almost been completed in the case, and the Civil Action is ripe for trial.

Petitioner is progressing with additional applications for trademark registration which marks are related to the Mark and the products and services under the Mark. Petitioner filed application serial number 77454798 for "Bikini Beach Babes" April 22, 2008, which completed its publication period and a Notice of Allowance has been issued. Petitioner filed application serial number 77454883 for "The Bikini Network," and is preparing a response to a second Office Action.

**IV. THE MARK AT ISSUE IN THIS CANCELLATION WILL BE ADDRESSED IN THE CIVIL ACTION TRIAL.**

In the Civil Action, Petitioner as Plaintiffs established factual evidence in its initial Civil Action Complaint and through the TAC of its actions to protect and use its trademarks, including the Mark. Evidence was set forth of the procurement of domain names and filing of fictitious business names on or about January 6, 2000, February 6, 2000, and March 21, 2000, and August 25, 2000, and of working with web designers to create promotional websites on or about January 6, 2000. Petitioner asserted facts of the creation and operation of a production company website which utilized the trademarks and sold goods (videos and DVD's) under the Mark. Additional factual evidence was set forth of Petitioner's retaining counsel in or around March, 2000, to prepare and submit applications for trademark registration.

Petitioner was thereafter handicapped due to Defendants' confiscation and control of Petitioner's intellectual properties.

V. **CONCLUSION.**

Petitioner respectfully requests that the TTAB continue the suspension of proceedings in this Cancellation proceeding so that the parties may address and resolve the trademark ownership issues in the Civil Action whose trial is imminent.

Dated: December 1, 2009

**JOHNSON & PHAM, LLP**

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