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

Proceeding	92049926
Party	Plaintiff PENTHOUSE DIGITAL MEDIA PRODUCTIONS INC.
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Date	11/07/2008
Attachments	Petitioner's Amended Response to Registrant's Motion to Suspend with Exhibits.PDF ( 71 pages )(4387642 bytes )

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

PENTHOUSE DIGITAL MEDIA	)	
PRODUCTIONS INC.,	)	
	)	
Petitioner,	)	
	)	
v.	)	Cancellation No. 92049926
	)	
CLOUDSTREET, INC.	)	
d/b/a ROXBURY ENTERTAINMENT,	)	
	)	
Registrant.	)	

**PETITIONER’S AMENDED RESPONSE TO REGISTRANT’S MOTION TO SUSPEND**

Petitioner, Penthouse Digital Media Productions Inc., by and through its attorneys and for its amended response (“Amended Response”) in opposition to Registrant’s Motion to Suspend (“Registrant’s Motion”), states as follows:

1. On October 27, 2008, Petitioner filed a response to Registrant’s Motion to Suspend, which response this Amended Response supersedes.
2. Registrant’s Motion is based on the application of 37 CFR Sec. 2.117(a) to the instant action (the “Cancellation Proceeding”), which seeks the cancellation of three trademark registrations owned by Registrant for the mark ROUTE 66, namely, U.S. Registration Nos. 3189543, 3194255 and 3291736 (collectively, the “Registrations”). Registrant asserts that pending federal litigation filed on June 12, 2008, by Registrant against Petitioner and other co-defendants in the United States District Court for the Central District of California (the “Court”), captioned *Roxbury Entertainment v. Penthouse Media Group, Inc., et al.*, Case No. CV 08-03872 FMC (JWJx) (the “Litigation”), will have a significant bearing on the Cancellation Proceeding,

warranting suspension of the Cancellation Proceeding.<sup>1</sup> See Registrant's Motion, pp. 1-2. As demonstrated below, Registrant is wrong.

3. 37 CFR Sec. 2.117(a) provides:

Whenever it shall come to the attention of the Trademark Trial and Appeal Board that a party or parties to a pending case are engaged in a civil action or another Board proceeding which may have a bearing on the case, proceedings before the Board may be suspended until termination of the civil action or the other Board proceeding.

*Id.*

4. In requesting that the Trademark Trial and Appeal Board (the "Board") stay the Cancellation Proceeding pending disposition of the Litigation, Registrant incorrectly characterizes the Litigation as addressing the same issues presented in the Cancellation Proceeding. While Registrant correctly notes that "a significant issue" in the Litigation "is whether the Registrant's ROUTE 66 marks are infringed and are confusingly similar to Petitioner's use of ROUTE 66 as a trademark," Registrant blatantly misrepresents to the Board that the same issue is "raised in this Cancellation Proceeding." Registrant's Motion, p. 2. To the contrary, the Cancellation Proceeding is based solely on Registrant's conduct, namely: (i) Registrant's fraud on the United States Patent and Trademark Office ("USPTO") with respect to the Registrations, and (ii) Registrant's abandonment of two of the three Registrations. See, generally, Consolidated Petition to Cancel. Petitioner's conduct is nowhere at issue in, or even relevant to, this Cancellation Proceeding. See, generally, *id.*

5. Conversely, the primary focus in the Litigation, which Registrant filed, is on the alleged conduct of Petitioner and its co-defendants. To the extent that Registrant's conduct is even at issue in the Litigation, it is only by way of affirmative defenses raised by Petitioner and

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<sup>1</sup> The Cancellation Proceeding and the Litigation are referred to, collectively herein, as the "Two Cases".

its co-defendants, none of whom has filed any counterclaim in the Litigation seeking affirmative relief against Registrant – which again, is the sole purpose of the Cancellation Proceeding. Accordingly, contrary to Registrant’s representation to the Board in Registrant’s Motion, the issues are not the same in the Two Cases.

6. There is one overlapping and potentially dispositive issue between the Two Cases, namely, the question of the validity of the Registrations. However, in Registrant’s attempt to invoke 37 CFR Sec. 2.117(a), Registrant distorts the ramifications of the foregoing and conclusorily asserts that a suspension of the Cancellation Proceeding is warranted because the Litigation will significantly affect the Cancellation Proceeding. *See* Registrant’s Motion, p. 2 (claiming that the Litigation, “if not in fact dispositive of the issues raised in this Cancellation Proceeding, will have a significant bearing on this Cancellation Proceeding, warranting suspension under 2.117(a)”).

7. While the Board’s cancellation of the Registrations may dispose of the Litigation or at least significantly affect and narrow the issues to be determined by the Court, the reverse scenario claimed by Registrant is not true - *i.e.*, it is not necessarily the case that the outcome of the Litigation may dispose of or even significantly bear upon this Cancellation Proceeding. The Court’s finding in the Litigation that Petitioner did, or did not, infringe on Registrant’s alleged trademark rights will not “have a bearing on [the Cancellation Proceeding]” as contemplated under 37 CFR Sec. 2.117(a).

8. Accordingly, contrary to Registrant’s conclusory assertion that suspension of the Cancellation Proceeding is warranted because the pending Litigation will have a significant bearing on it, Petitioner submits that the Board should exercise the discretion granted it under 37 CFR Sec. 2.117(a) to deny Registrant’s Motion in the interest of judicial efficiency and

economy, to prevent the possibility of inconsistent judgments, and based on the authority in several cases. For example, in *Microchip Tech., Inc. v. Motorola, Inc.*, Civ. No. 01-264-JJF, 2002 WL 32332753 (D. Del. May 28, 2002) (attached hereto as Exhibit A), precisely as in the Two Cases here, after the plaintiff asserted federal and common law trademark infringement claims in federal litigation against the defendant, the defendant filed a petition in the TTAB to cancel the registration of the mark on which the litigation was based. *Id.* at \*1. The court in *Microchip* accordingly exercised its inherent discretion and stayed the litigation pending disposition of the TTAB proceeding, including the actions grounded in common law trademark rights, because the TTAB decision “would promote judicial efficiency by either narrowing the issues for trial or making this case ripe for summary judgment.” *Id.* at \*3. *See also Citicasters Co. v. Country Club Communications*, 44 U.S.P.Q.2d 1223, 1224 (C.D. Cal. 1997) (staying district court action pending resolution of TTAB’s pending cancellation proceeding “because of the efficiencies generated by the TTAB first addressing the issues involved in this matter”).

9. Indeed, as noted by the court in *Kemin Industries v. Watkins Products, Inc.*, 183 U.S.P.Q. 799 (D. Minn. 1974):

While in this case there are issues that cannot be ruled upon by the [TTAB], the determination of the threshold question of the ownership of the mark lies particularly within their field of expertise. They would know best the criteria for ownership and that seems to be the key. If that question were resolved in favor of plaintiff and the trademark cancelled, the other issues would be disposed of in a very short time by this Court.

*Id.* at 800. Thus, if anything, the Litigation should be stayed pending the disposition of the Cancellation Proceeding since resolution of this Cancellation Proceeding will certainly narrow and simplify, and indeed may even moot, the issues in the Litigation, whereas resolution of the Litigation, on the other hand, will not likely moot the issues in this Cancellation Proceeding.

10. Accordingly, on October 31, 2008, Petitioner and its co-defendants filed with the Court their moving papers asking the Court to stay the Litigation pending the outcome of this Cancellation Proceeding, based on the Court's inherent power to stay and/or the doctrine of primary jurisdiction. *See* Defendants' Notice of Motion and Motion to Stay; Memorandum in Support of Motion to Stay, attached hereto as Exhibit B.<sup>2</sup> Pursuant to an order entered by the Court on November 4, 2008, Penthouse's Motion to Stay will be heard, and likely decided, by the Court on December 1, 2008, prior to which the parties in the Litigation, including Registrant and Petitioner, will have fully briefed the motion. *See* Order Granting Defendants' Request for Relief from Central District Local Rule 7-3, attached hereto as Exhibit C and hereinafter referred to as the "November 4th Order."

11. In this Cancellation Proceeding, Registrant will have until November 27, 2008<sup>3</sup> – a mere four days before the Court hears Penthouse's Motion to Stay – to file Registrant's reply, if any, in connection with Registrant's Motion to Suspend. As such, it is prudent for Registrant, Petitioner, and the Board to simply await the Court's ruling on Penthouse's Motion to Stay since, if the Court grants Penthouse's Motion to Stay so that the Cancellation Proceeding can proceed first for the reasons set forth herein and in Penthouse's Motion to Stay, such ruling would render moot Registrant's Motion to Suspend. While the TTAB could, of course, lift any suspension of the Cancellation Proceeding if the Court were subsequently to stay the litigation in deference to

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<sup>2</sup> Defendants' moving papers entitled "Defendants' Notice of Motion and Motion to Stay; Memorandum in Support of Motion to Stay" are referred to, collectively herein, as "Penthouse's Motion to Stay."

<sup>3</sup> This date is twenty days from the filing and service of this Amended Response on November 7, 2008, which twenty-day period is based on Registrant's fifteen-day reply period, plus an additional five days since Petitioner will be serving this Amended Response by first-class mail. *See* 37 CFR 2.127(a) and 2.119(c).

the Cancellation Proceeding, judicial economy would seem to dictate that the TTAB avoid any unnecessarily hasty and inefficient ruling that might result in any such interim suspension.

12. Registrant will undoubtedly urge the Board in its reply, if any, to hasten any ruling on Registrant's Motion by arguing that the Court is likely to deny Penthouse's Motion to Stay and, therefore, that there is no good reason to await the Court's ruling. However, this would be contrary to all indications from the Court. First, after reviewing Petitioner's Motion to Stay prior to its being filed, and in the form of an exhibit attached to another pleading filed by Registrant on October 31, 2008 (*see* Defendants' Request for Relief from Central District Local Rule 7-3, relevant portions attached hereto as Exhibit D), the Court found good cause was shown and allowed Petitioner to file Petitioner's Motion to Stay earlier than otherwise permitted under the applicable local rule. *See* Central District of California's Local Rule 7-3, attached hereto as Exhibit E. Second, the Court deemed the motion to have been filed retroactively, namely, as of October 31, 2008, four days earlier than the November 4th Order. *See* November 4th Order. Third, the Court set, *sua sponte*, an expedited briefing and hearing schedule on Petitioner's Motion to Stay that ended weeks earlier than the dates that would ordinarily have resulted from the Court's own court procedures and the applicable local rules identified in Petitioner's proposed order. *See id.* (stating, in part, "NOTE: CHANGES MADE BY THE COURT," striking certain language in the proposed order submitted by Petitioner, and assigning a hearing date earlier than could have been assigned had such language not been stricken).

13. Thus, over Petitioner's objections, the Court authorized an expedited hearing and briefing schedule on Petitioner's Motion to Stay, knowing that Registrant's earlier-filed motion to suspend the Cancellation Proceeding was pending in the TTAB. Since there is a risk of inconsistent rulings if the TTAB and the Court rule on the motions before them simultaneously,

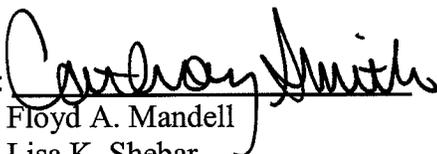
Petitioner urges the TTAB to defer its ruling until after December 1, 2008, or such later date as the Court may issue its decision, so that the rulings, whatever they may be, can be harmonized. Put another way, while Petitioner does not presume to know how the Court will rule on the Penthouse's Motion to Stay, Petitioner believes that the TTAB should have the benefit of knowing whatever the Court's ultimate decision is before issuing a ruling on Registrant's Motion. Petitioner further believes that the Court is likely to grant Penthouse's Motion to Stay in order to place the initial, threshold issues pertaining to the validity of the Registrations before the TTAB as soon as possible since the TTAB is the tribunal best-suited and experienced to adjudicate them.

14. For all the reasons set forth above, and as discussed more thoroughly in Penthouse's Motion to Stay, the Board should deny Registrant's Motion or, in the alternative, delay decision on Registrant's Motion until the Court rules on Penthouse's Motion to Stay.

WHEREFORE, Petitioner respectfully requests that the Board deny Registrant's Motion to Suspend or, in the alternative, delay decision on Registrant's Motion to Suspend until the Central District of California rules on Penthouse's Motion to Stay. In the event that the Board denies Registrant's Motion to Suspend, Petitioner has no objection to the relief requested in Registrant's Motion to Extend Time to Respond to Petition for Cancellation.

Dated: November 7, 2008

Respectfully submitted,

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

PENTHOUSE DIGITAL MEDIA )  
PRODUCTIONS INC., )

Petitioner, )

v. )

CLOUDSTREET, INC. )  
d/b/a ROXBURY ENTERTAINMENT, )

Registrant. )

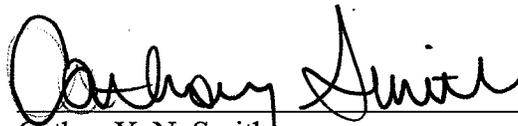
Cancellation No. 92049926

**CERTIFICATE OF SERVICE**

I hereby certify that a true and correct copy of PETITIONER'S AMENDED RESPONSE TO REGISTRANT'S MOTION TO SUSPEND was served by first class mail, postage prepaid, on this 7th day of November 2008, upon:

Cloudstreet, Inc. d/b/a Roxbury Entertainment  
201 Wilshire Boulevard, Second Floor  
Santa Monica, California 90401

Paul D. Supnik, Esq.  
9401 Wilshire Boulevard, Suite 1012  
Beverly Hills, California 90212

  
Cathay Y. N. Smith

# Exhibit A

*Penthouse Digital Media Productions Inc. v. Cloudstreet Inc. d/b/a  
Roxbury Entertainment, Cancellation No. 92049926*

Petitioner's Exhibit

Only the Westlaw citation is currently available.

United States District Court,  
 D. Delaware.  
 MICROCHIP TECHNOLOGY, INC., Plaintiff,  
 v.  
 MOTOROLA, INC., Defendant.  
 No. Civ.A. 01-264-JJF.

May 28, 2002.

John W. Shaw and Sara Beth A. Reyburn, of Young, Conaway, Stargatt & Taylor, LLP, Wilmington, Delaware, Edward A. Pennington, of Swidler, Berlin, Shereff, Friedman, LLP, Washington, D.C., for Plaintiff, of counsel.

Jack B. Blumenfeld, of Morris, Nichols, Arsht & Tunnell, Wilmington, Delaware, Roberta Horton, Michael Songer, James Walsh, and Jonathan Hooks, of Arnold & Porter, Washington, D.C., for Defendant, of counsel.

#### MEMORANDUM OPINION

FARNAN, J.

\*1 Presently before the Court is a Motion To Stay This Action (D.I.18) filed by Defendant, Motorola, Inc. (hereinafter "Motorola"). For the reasons set forth below, Motorola's Motion (D.I.18) will be granted.

#### I. BACKGROUND

Plaintiff, Microchip Technology, Inc. (hereinafter "Microchip") is the owner of a U.S. trademark registration, which issued in 1981, for the mark "PIC." (D.I. 22 at 2). Microchip's "PIC" products are used in industries such as automotive, telecommunications, household appliances, and security. (D.I. 22 at 3). Motorola uses the designation "PIC" in marketing its products as an acronym for various terms including "personal interactive communicators," "program interrupt controller," "programmable interrupt controller," "position independent code," "personal intelligent communicator," "PC interrupt controller," and as a

portion of other names and claimed trademarks, such as "CORE-PIC," "GPIC (Galileo Discovery Programmable Interrupt Controller)," and "EPIC (Embedded Programmable Interrupt Controller)." (D.I. 22 at 3).

In September 2000, Microchip notified Motorola of its rights to the "PIC" trademark and requested that Motorola cease all unauthorized use. (D.I. 22 at 3). Because Motorola continued to use the "PIC" designation, on April 24, 2001, Microchip initiated this action. (D.I. 22 at 3). By its Complaint, Microchip alleges federal and common law trademark infringement, false designation of origin, trademark dilution, unfair competition, and deceptive trade practices. (D.I. 22 at 3). On May 29, 2001, Motorola filed an Answer asserting abandonment as an affirmative defense, as well as a counterclaim alleging that Microchip's "PIC" mark has become generic, and therefore, the "PIC" registration should be cancelled pursuant to 15 U.S.C. § 1119. (D.I. 19 at 2).

Before the parties engaged in any discovery, this action was stayed for several months pending mediation before Judge Thyng. (D.I. 19 at 2). The mediation occurred on November 20, 2001, but was unsuccessful. (D.I. 19 at 2). On November 28, 2001, Motorola filed a petition with the Trademark Trial and Appeal Board (hereinafter "TTAB"), seeking cancellation of Microchip's trademark registration for "PIC" on the grounds that it is a generic term for integrated circuit chips. (D.I. 19 at 2-3). On April 9, 2002, the TTAB issued an Order suspending the TTAB proceedings pending final disposition of the civil action in this Court. (D.I.40). The TTAB, however, noted that in the event this Court "elects to suspend the civil action to await determination of the Board proceeding, the Board will go forward with its proceeding." (D.I. 40, Ex. A at 3-4).

Subsequent to the unsuccessful mediation, the parties exchanged discovery requests. (D.I. 19 at 3). As of the filing date of Motorola's Motion To Stay (i.e. December 26, 2001), no documents had been produced, no written responses had been served, and no depositions had been noticed or taken. (D.I. 19 at 3). On 2/20/02, the Court entered a Scheduling Order

setting 9/13/02 as the discovery cutoff date, 12/15/02 as the deadline for filing dispositive motions, 4/3/03 as the pre-trial date, and 5/12/03 as the trial date. (D.I.29). The parties have since noticed depositions and responded to various interrogatories and document requests.

## II. DISCUSSION

\*2 Motorola contends that the Court should exercise its discretion and stay this action in order to permit the TTAB to resolve the issue of whether "PIC" is a generic term that is not entitled to trademark protection. (D.I. 19 at 1). According to Motorola, the Court can stay this action by either exercising its inherent power to promote economy of judicial time and effort, or invoking the "primary jurisdiction" doctrine, which "comes into play whenever enforcement of the claim requires the resolution of issues which ... have been placed within the special competence of an administrative body." (D.I. 19 at 3-4); Driving Force, Inc. v. Manpower, Inc., 498 F.Supp. 21, 24 (E.D.Pa.1980); See also Texaco, Inc. v. Borda, 383 F.2d 607, 608 (3<sup>rd</sup> Cir.1967). Motorola contends that the TTAB regularly decides issues of genericism and would be a material aid to this Court, as an opinion from the TTAB would significantly expedite the Court's treatment of the issues presented. (D.I. 19 at 60. Specifically, Motorola contends that if the TTAB determines that Microchip's "PIC" designation is generic, and the Court adopts that determination, this decision would warrant dismissal of Microchip's entire suit. (D.I. 19 at 9). Motorola further contends that a stay would not harm or prejudice either party, since Motorola has been using "PIC" for many years and there is no expedited proceedings pending in this Court. (D.I. 19 at 13).

In response, Microchip contends that Motorola's reliance on the "primary jurisdiction" doctrine is misplaced. (D.I. 22 at 1). Microchip contends that the "primary jurisdiction" doctrine should only be applied when: 1) uniformity of regulation is appropriate; or 2) there is a need for an initial consideration of the problem by a tribunal with specialized knowledge. (D.I. 22 at 6). Additionally, Microchip contends that the "primary jurisdiction" doctrine should not be applied when the district court proceedings involve issues that would not be present in the TTAB proceeding. (D.I. 22 at 9-10). Because the genericism of the "PIC" designation is not a

question that is within the special expertise of the TTAB, and because genericism is only one of several issues pending before this Court, Microchip contends that the doctrine of primary jurisdiction is not applicable. (D.I. 22 at 1-2).

Microchip further contends that it would suffer prejudice in the event a stay is granted, and that a stay would not expedite the proceedings in this action or promote judicial efficiency. (D.I. 22 at 2). Microchip contends that a cancellation proceeding before the TTAB will likely run for years from the time of initiation, and that, regardless of the outcome, TTAB's decision must be reviewed by this court *de novo*. (D.I. 22 at 2, 11). Additionally, Microchip contends that any delay works to its disadvantage in combating genericide, as additional time will only provide Motorola the opportunity to increase its misuse of the "PIC" designation. (D.I. 22 at 14). According to Microchip, the fairest and most efficient course of action is to deny Motorola's Motion To Stay and proceed in this Court, which is capable of resolving all of the issues between the parties. (D.I. 22 at 1-2).

\*3 After reviewing the parties' arguments and the applicable law on this issue, the Court concludes that Motorola's Motion To Stay (D.I.18) should be granted. A court has the inherent power to stay an action in the interests of efficient and fair resolution of the disputed issues. See Texaco, Inc. v. Borda, 383 F.2d 607, 608 (3<sup>rd</sup> Cir.1967). In addition to this inherent power, a court may also enter a stay under the doctrine of primary jurisdiction. Application of the primary jurisdiction doctrine is appropriate when there is a need for an initial consideration of issues by an agency with specialized knowledge, and those issues have been placed before that agency by the parties. See Consolidated Rail Corp. v. City of Dover, 450 F.Supp. 966 (D.Del.1978). In determining whether to apply the doctrine of primary jurisdiction, courts typically focus on whether the agency's decision could be dispositive of the district court action. See American Bakeries Co., 650 F.Supp. 563 (D. Min 1986) (holding that "the case for permitting the PTO to proceed first is bolstered where the PTO adjudication might serve as a final disposition of the matter"); Goya Foods v. Tropicana Prods. Inc., 846 F.2d 848 (2<sup>nd</sup> Cir.1988) (holding "if a district court action involves only the issue of whether a mark is entitled to registration [ i.e., the

same issue as was then before the TTAB) ] ..., the doctrine of primary jurisdiction might well be applicable"); E & J Gallo Winery v. F & P S.p.A., 899 F.Supp. 465, 468 (E.D.Cal.1994) (holding that fact that issues raised in TTAB proceeding were "not dispositive" was the "most important" factor in denying a stay).

In this case, a determination that the "PIC" designation is generic, if adopted by the Court, would be dispositive of all of Microchip's claims, as each claim depends on Microchip owning a valid trademark. Additionally, because the TTAB is often called upon to determine whether a commonly-used word or term is generic, the issue of genericism is within the special expertise of the TTAB. See Continental Airlines, Inc. v. United Air Lines, Inc., 53 U.S.P.Q.2d 1385 (TTAB Jan. 7, 2000) (holding that the term "e-ticket" for computerized reservation and ticketing services is generic); In re 3Com Corp., No. 74/495, 184, 2000 WL 1182872 (TTAB Aug. 14, 2000) (holding that "ATMlink" for computer network components was generic). Accordingly, despite Microchip's contentions, application of the primary jurisdiction would not be improper.

In an attempt to convince the Court that a stay would not expedite the proceedings in this action or promote judicial efficiency, Microchip contends that, regardless of the outcome, the TTAB's decision must be reviewed by this Court *de novo*. While Microchip is correct that the Court must review any TTAB decision, Microchip misrepresents the standard by which a TTAB decision is reviewed. The district court's role in reviewing a TTAB decision has been described as "unique," in that the Court acts as both a reviewing body and as a fact-finder. See CVP Systems, Inc. v. M-Tek Incorporated, 32 U.S.P.Q.2d 1951 (N.D.Ill.1994); see also Loglan Institute v. Logical Language Group, 962 F.2d 1038, 1040 (Fed.Cir.1992) (holding that it is "well settled" that a TTAB decision "must be accepted as controlling upon a finding of fact ... unless the contrary is established by testimony which in character and amount carries thorough conviction"). The standard of review has been explained as follows:

\*4 It is true that new evidence must itself be considered *de novo* by the district court--in the sense of being fairly weighed without placing a thumb on the scales of dismissing it out of hand.

The evidence must then be weighed against the Board's findings under the thorough conviction standard. Unless the new evidence leads to a thorough conviction that a finding of the Board is incorrect, that finding is controlling.

Spraying Systems Co. v. Delvan, Inc., 975 F.2d 387, 391 (7<sup>th</sup> Cir.1992).

In light of the deference that a district court must give to a TTAB decision under the "hybrid" standard of review and the fact that the genericism of the "PIC" designation is a dispositive issue, the Court concludes that staying this action to await a decision from the TTAB would promote judicial efficiency by either narrowing the issues for trial or making this case ripe for summary judgement. For these reasons, the Court will grant Motorola's Motion To Stay This Action (D.I.18).

### III. CONCLUSION

For the reasons discussed, the Motion To Stay This Action (D.I.18) filed by Motorola will be granted.

An appropriate Order will be entered.

### ORDER

At Wilmington this 28th day of May, 2002, for the reasons set forth in the Memorandum Opinion issued this date;

IT IS HEREBY ORDERED that:

- 1) Motorola's Motion To Stay This Action (D.I.18) is *GRANTED*;
- 2) This case is administratively *CLOSED*;
- 3) The parties shall promptly notify the Court when the TTAB has reached a decision regarding the genericism of the "PIC" designation.

Not Reported in F.Supp.2d, 2002 WL 32332753 (D.Del.)

END OF DOCUMENT

# Exhibit B

*Penthouse Digital Media Productions Inc. v. Cloudstreet Inc. d/b/a  
Roxbury Entertainment, Cancellation No. 92049926*

Petitioner's Exhibit

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22 Attorneys for Defendants

23 **UNITED STATES DISTRICT COURT**  
24 **CENTRAL DISTRICT OF CALIFORNIA**

25 ROXBURY ENTERTAINMENT, a ) CASE NO. CV-08-03872  
26 California corporation )  
27 ) **DEFENDANTS' NOTICE OF**  
28 ) **MOTION AND MOTION TO STAY;**  
29 ) **MEMORANDUM IN SUPPORT OF**  
30 ) **MOTION TO STAY**  
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1                    **NOTICE OF MOTION AND MOTION TO STAY PROCEEDINGS**

2                    PLEASE TAKE NOTICE THAT, on \_\_\_\_\_ and \_\_\_\_\_, or as soon thereafter as  
3 the matter may be heard, in Courtroom 750 of the United States District Court for the  
4 Central District of California, located at 225 East Temple Street, Los Angeles,  
5 California 90012, Defendants Penthouse Media Group, Inc., n/k/a FriendFinder  
6 Networks Inc., Penthouse Digital Media Productions, Inc., and Pulse Distribution,  
7 LLC (collectively, "Defendants"), will and do hereby respectfully move this Court,  
8 pursuant to its inherent discretionary power and/or the doctrine of primary  
9 jurisdiction, to enter an order staying this litigation pending the resolution of the  
10 cancellation proceeding pending before the Trademark Trial and Appeal Board in the  
11 United States Patent and Trademark Office.

12                    Defendants' Motion is based on this notice, the attached memorandum in  
13 support, all supporting declarations, the pleadings and other records on file with the  
14 Court, all relevant matters judicially noticeable, and such further evidence and  
15 arguments as the Court may consider.

16                    This Motion is made following the conference of counsel pursuant to L.R. 7-3  
17 which was initiated on October 22, 2008 and following an in person meet and confer  
18 which took place on October 27, 2008. Defendants have requested leave of Court to

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1 file this Motion earlier than twenty (20) days after these two meetings in order to have  
2 the motion heard as soon as possible.

3  
4 Dated: October 31, 2008

5 Respectfully submitted,

6  
7  
8 

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1 MEMORANDUM IN SUPPORT OF DEFENDANTS' MOTION TO STAY

2 INTRODUCTION

3 This Court should exercise its discretion to stay this litigation pending  
4 resolution of a trademark cancellation proceeding against Plaintiff in the Trademark  
5 Trial and Appeal Board ("TTAB") of the United States Patent and Trademark Office  
6 ("USPTO"). A stay will promote judicial economy, prevent simultaneous  
7 proceedings or inconsistent judgments on the same legal and factual issues, and  
8 provide the TTAB the opportunity to complete its review of the trademarks that  
9 Plaintiff claims Defendants have infringed. In similar situations, courts have stayed  
10 trademark litigation pending the TTAB's review, even when common law rights are at  
11 issue in the litigation, because that review may dispose of the litigation or at least  
12 narrow the issues for trial.

13 On September 12, 2008, defendant Penthouse Digital Media Productions, Inc.  
14 ("Penthouse"), filed a consolidated petition in the TTAB, Cancellation No. 92049926  
15 (the "Cancellation Proceeding"), seeking cancellation of U.S. Registration Nos.  
16 3189543, 3194255 and 3291736 (collectively, the "Registrations") owned by Plaintiff  
17 for the mark ROUTE 66 in connection with various goods and services (collectively,  
18 the "ROUTE 66 Marks"). See Consolidated Petition to Cancel, attached hereto as  
19 Exhibit A. While the focus of the Cancellation Proceeding is on Plaintiff's right to  
20 retain ownership of the Registrations, in reaching such decision, the TTAB will  
21 necessarily address whether Plaintiff has a protectible interest in the ROUTE 66  
22 Marks in the first instance, given the claims raised in the Consolidated Petition to  
23 Cancel, namely: (1) whether Plaintiff's alleged rights in the ROUTE 66 Marks are  
24 invalid as a result of Plaintiff's fraud on the USPTO;<sup>1</sup> and (2) whether Plaintiff has  
25 abandoned its alleged ownership of the ROUTE 66 Marks. See *id.* If the TTAB finds  
26 in Penthouse's favor on either of these issues, Plaintiff's trademark registrations will

27 <sup>1</sup> The TTAB has routinely held that, if fraud can be shown in the procurement of a registration, the  
28 entire resulting registration is void. See, e.g., *Medinol Ltd. v. Neuro Vax Inc.*, 67 U.S.P.Q.2d 1205  
(TTAB 2003).

1 be cancelled, which would dispose of most, if not all, of Plaintiff's claims in this  
2 litigation.

3 Accordingly, this Court should stay this litigation pursuant to its inherent power  
4 and/or the doctrine of primary jurisdiction because judicial efficiency and economy  
5 weigh in favor of staying this litigation, the parties will not be prejudiced by a stay of  
6 this litigation, and issues such as ownership and validity of Plaintiff's trademarks  
7 should be determined by the expertise and specialized knowledge of the TTAB.

8 **ARGUMENT**

9 **I. The Court Should Stay This Litigation Pursuant To Its Inherent Power.**

10 A district court has the inherent power to stay its proceedings. *Rivers v. Walt*  
11 *Disney Co.*, 980 F. Supp. 1358, 1360 (C.D. Cal. 1997); *Cucci v. Edwards*, No. SACV  
12 07-532 PSG (MLGx), 2007 WL 3396234, at \*2 (C.D. Cal. Oct. 31, 2007). According  
13 to the U.S. Supreme Court, "[T]he power to stay proceedings is incidental to the  
14 power inherent in every court to control the disposition of the causes on its docket  
15 with economy of time and effort for itself, for counsel, and for litigants." *Landis v.*  
16 *North Am. Co.*, 299 U.S. 248, 254 (1936). The Ninth Circuit has held that "[t]his rule  
17 applies whether the separate proceedings are judicial, administrative, or arbitral in  
18 character, and does not require that the issues in such proceedings are necessarily  
19 controlling of the action before the court." *Leyva v. Certified Grocers of Cal., Ltd.*,  
20 593 F.2d 857, 863-64 (9th Cir. 1979). "A stay is appropriate when it serves the  
21 interests of judicial economy and efficiency." *Cucci*, 2007 WL 3396234 at \*2 (citing  
22 *Rivers*, 980 F. Supp. at 1360). *See also Kemin Industries v. Watkins Products, Inc.*,  
23 183 U.S.P.Q. 799, 800 (D. Minn. 1974) ("The more compelling reason for granting  
24 the stay, however, is judicial efficiency and economy."). Here, a stay would be  
25 appropriate pending the disposition of the Cancellation Proceeding since such  
26 proceeding will narrow and simplify, and indeed may even moot, the issues in the  
27 instant case, and since a stay of this litigation will not prejudice the parties.

28

1           A.     **Staying This Litigation Will Moot Or Simplify The Issues In This**  
2                     **Case And Any Eventual Trial.**

3           Judicial efficiency and economy weigh in favor of staying this litigation.  
4           “There can be no doubt that two judicial forums considering the same problem is  
5           wasteful.” *Kemin*, 183 U.S.P.Q. at 800. The issues before the TTAB concern the  
6           validity of the Registrations, namely: (1) whether Plaintiff’s alleged rights in the  
7           ROUTE 66 Marks are invalid as a result of Plaintiff’s fraud on the USPTO; and (2)  
8           whether Plaintiff has abandoned its alleged ownership of the ROUTE 66 Marks. *See*  
9           Exh. A, ¶¶ 10-26. This threshold issue of the validity of Plaintiff’s trademark rights  
10          must also first be addressed in this litigation.

11          First, the validity of the ROUTE 66 Marks is “a threshold issue” on which  
12          Plaintiff bears the ultimate burden of proof in proving trademark infringement in this  
13          litigation. *Tie Tech, Inc. v. Kinedyne Corp.*, 296 F.3d 778, 783 (9th Cir. 2002).  
14          Furthermore, Defendants have pled numerous affirmative defenses in this litigation  
15          that undermine Plaintiff’s alleged ownership of the ROUTE 66 Marks. *See*  
16          Defendants’ Answer and Affirmative Defenses, Document No. 13, at 28-29.

17          This issue of the validity of the Registrations, if decided by the TTAB, would  
18          be a material aid to this Court, as an opinion from the TTAB would significantly  
19          expedite the Court’s treatment of issues presented. *See Citicasters Co. v. Country*  
20          *Club Communications*, 44 U.S.P.Q.2d 1223, 1224 (C.D. Cal. 1997) (staying district  
21          court action pending resolution of TTAB’s pending cancellation proceeding “because  
22          of the efficiencies generated by the TTAB first addressing the issues involved in this  
23          matter”). As noted by the court in *Kemin Industries v. Watkins Products, Inc.*, 183  
24          U.S.P.Q. 799 (D. Minn. 1974):

25                     While in this case there are issues that cannot be ruled upon  
26                     by the [TTAB], the determination of the threshold question  
27                     of the ownership of the mark lies particularly within their  
28                     field of expertise. They would know best the criteria for

1 ownership and that seems to be the key. If that question  
2 were resolved in favor of plaintiff and the trademark  
3 cancelled, the other issues would be disposed of in a very  
4 short time by this Court.

5 *Id.* at 800. Similarly, here, if the TTAB determines that Plaintiff has abandoned  
6 its rights in the ROUTE 66 Marks and/or that Plaintiff's ROUTE 66 Marks are invalid  
7 because Plaintiff committed fraud on the USPTO, the TTAB's decision would result  
8 in the cancellation of the Registrations and could dispose of Plaintiff's trademark-  
9 related claims or, at the very least, significantly narrow the issues in this litigation.

10 On the other hand, the Court's decision in this case would not dispose of the  
11 TTAB's proceeding, and, therefore, inconsistent judgments between this Court and  
12 the TTAB could result if the Court does not stay this litigation. For example, if the  
13 Court proceeds with this litigation, and the TTAB subsequently determines that  
14 Plaintiff committed fraud on the USPTO and/or abandoned its rights in the ROUTE  
15 66 Marks, the impact of any decisions or findings made by this Court could be mooted  
16 or contradicted by the TTAB's decision.

17 For these reasons, courts generally stay trademark claims pending TTAB  
18 proceedings pursuant to the court's discretion, even if those trademark claims are  
19 based on common law rights. In *Microchip Tech., Inc. v. Motorola, Inc.*, Civ. No. 01-  
20 264-JJF, 2002 WL 32332753 (D. Del. May 28, 2002), after the plaintiff asserted  
21 federal and common law trademark infringement claims in federal litigation against  
22 the defendant, the defendant filed a petition in the TTAB to cancel the registration of  
23 the mark on which the litigation was based. *Id.* at \*1. The court in *Microchip*  
24 accordingly exercised its inherent discretion to stay the litigation pending disposition  
25 of the TTAB proceeding, including the claims grounded in common law trademark  
26 rights, since the TTAB decision, as in the instant case, "would promote judicial  
27 efficiency by either narrowing the issues for trial or making this case ripe for summary  
28 judgment." *Id.* at \*3-\*4.

1           **B. Staying This Litigation Will Not Unduly Prejudice Plaintiff.**

2           A stay of this litigation will not harm or prejudice Plaintiff. First and foremost,  
3 Defendants are no longer using the term “Route 66” in connection with the marketing,  
4 promoting, or selling of any goods or services in the United States. *See* Declaration of  
5 Kelly Holland, attached hereto as Exhibit B, ¶3. Accordingly, any alleged harm to  
6 Plaintiff by Defendants’ use of the term “Route 66” is not ongoing, such that a stay of  
7 this litigation will not cause Plaintiff any irreparable harm.

8           Moreover, even though awaiting the TTAB’s ruling in the Cancellation  
9 Proceeding may slightly delay this Court’s disposition of the instant case, any such  
10 minor delay will be offset by the increased efficiency with which this Court will be  
11 able to make its future decisions using the TTAB’s ruling as a guide. *See Citicasters*,  
12 44 U.S.P.Q.2d at 1224 (“[A]ny minor delay is countered by the speed at which the  
13 court will ultimately be able to decide the issues herein, after the TTAB has offered its  
14 essentially advisory opinion. There will be little in the way of new discovery and the  
15 legal issues, though not disposed of, will be clearly set out.”).

16           Finally, discovery in this case is still in its infancy. The parties only recently  
17 filed their Joint Discovery Report on October 16, 2008 (Document No. 18), and have  
18 not yet exchanged any documents or taken any depositions of witnesses. Accordingly,  
19 Plaintiff will not be unfairly harmed by a stay, and institution of a stay pending the  
20 completion of the Cancellation Proceeding is both efficient and appropriate.

21           **II. The Court Should Stay This Litigation Pursuant To The Doctrine Of**  
22           **Primary Jurisdiction.**

23           In addition, or in the alternative, this Court should enter a stay of this litigation  
24 under the doctrine of primary jurisdiction. Application of the primary jurisdiction  
25 doctrine is appropriate when there is a need for initial consideration of issues by an  
26 agency with specialized knowledge, and those issues have been placed before that  
27 agency by the parties. *Microchip*, 2002 WL 32332753 at \*3. Under this doctrine,  
28 district courts have stayed trademark infringement claims to await the disposition of

1 pending TTAB proceedings involving the marks. *See, e.g., Citicasters*, 44 U.S.P.Q.2d  
2 at 1224; *Microchip*, 2002 WL 32332753; *Nat'l Mktg. Consultants, Inc. v. Blue Cross*  
3 *Blue Shield Ass'n*, No. 87 C 7161, 1987 WL 20138 (N.D. Ill. Nov. 19, 1987); *Sun*  
4 *Drop Sales Corp. of America v. Seminole Flavor Co.*, 159 F. Supp. 828, 828 (E.D.  
5 Tenn. 1958).

6 The test for invoking the doctrine of primary jurisdiction is whether the parallel  
7 agency proceedings will be a "material aid" in resolving the judicial proceedings.  
8 *Nat'l Mktg.*, 1987 WL 20138 at \*2 (citing *Ricci v. Chicago Mercantile Exch.*, 409  
9 U.S. 289, 305 (1973)). As discussed more thoroughly above, the TTAB's evaluation  
10 of Plaintiff's rights in the ROUTE 66 Marks will be a material aid in resolving this  
11 litigation.

12 Furthermore, in considering whether to invoke the doctrine of primary  
13 jurisdiction, courts have traditionally employed such factors as (1) the need to resolve  
14 an issue that (2) has been placed by Congress within the jurisdiction of an  
15 administrative body having regulatory authority (3) pursuant to a statute that subjects  
16 an industry of activity to a comprehensive regulatory authority that (4) requires  
17 expertise or uniformity in administration. *Syntek Semiconductor Co., Ltd. v.*  
18 *Microchip Technology Inc.*, 307 F.3d 775, 781 (9th Cir. 2002). When these factors  
19 are considered here, application of the doctrine is warranted.

20 The USPTO is vested by Congress with broad authority to regulate the  
21 registration of trademarks. Included within the statutory mandate of the Lanham Act  
22 is the power to resolve inter-party disputes concerning registration of particular marks.  
23 The TTAB was created especially to hear such disputes. Decisions of the TTAB are  
24 entitled to the most respectful consideration because of the TTAB's day-to-day  
25 expertise in adjudicating issues concerning ownership and validity of trademarks. *See*  
26 *Carling Brewing Co. v. Philip Morris Inc.*, 297 F. Supp. 1330, 1337 (N.D. Ga. 1968)  
27 ("While . . . Patent Office decisions . . . are not binding upon this court, they are  
28 certainly entitled to the most respectful consideration."); *accord, D. M. & Antique*

1 *Import Corporation v. Royal Saxe Corp.*, 311 F. Supp. 1261, 1274 (S.D.N.Y. 1970)  
2 (The expertise of the [TTAB] . . . entitle[s] their views to respectful consideration.”).

3       Indeed, the overlapping and yet-undecided issues presented in this litigation and  
4 the Cancellation Proceeding – *i.e.*, whether Plaintiff has trademark rights in the  
5 ROUTE 66 Marks, and whether the Registrations are invalid due to Plaintiff’s fraud  
6 on the USPTO – are technical, specialized issues that Congress has committed to the  
7 USPTO. In deciding these issues, the TTAB can draw upon its familiarity with the  
8 vast array of trademark cases that it has decided in the past. Before the Court  
9 considers this case, the USPTO, acting through the TTAB, ought to have the  
10 opportunity to apply its expert, specialized knowledge and experience. *See Sun Drop*,  
11 159 F. Supp. at 828 (“The Commissioner of Patents and his assistants are, being  
12 experts in this field, far better equipped to pass upon that question [of trademark  
13 registration] than this Court”); *Citicasters*, 44 U.S.P.Q. at 1224 (“In granting the  
14 motion to stay, the court is confident that the TTAB will exercise its specialized  
15 knowledge in effecting a determination that will prove valuable to this court”).

16       Accordingly, this Court should stay this litigation pursuant to the doctrine of  
17 primary jurisdiction and allow the TTAB’s expertise and specialized knowledge to  
18 determine issues concerning the validity and ownership of Plaintiff’s trademarks.  
19 Regardless of the outcome of the Cancellation Proceeding, the findings of the TTAB,  
20 and the ramifications of such findings, will undoubtedly have significant bearing on  
21 this litigation.

22 ///  
23 ///  
24 ///  
25 ///  
26 ///  
27 ///  
28 ///

1 **CONCLUSION**

2 Wherefore, Defendants Penthouse Media Group, Inc., n/k/a FriendFinder  
3 Networks Inc., Penthouse Digital Media Productions, Inc., and Pulse Distribution,  
4 LLC, respectfully request that this Court grant Defendants' Motion to Stay by entering  
5 an order staying this litigation pending the resolution of the Cancellation Proceeding  
6 pending before the TTAB.

7  
8 Dated: October 31, 2008

9 Respectfully submitted,

10  
11 

12 \_\_\_\_\_  
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Exhibit A

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

In the matter of U.S. Trademark Registration No. 3,189,543  
For the mark ROUTE 66  
Date registered: December 26, 2006

In the matter of U.S. Trademark Registration No. 3,194,255  
For the mark ROUTE 66  
Date registered: January 2, 2007

In the matter of U.S. Trademark Registration No. 3,291,736  
For the mark ROUTE 66  
Date registered: September 11, 2007

PENTHOUSE DIGITAL MEDIA )  
PRODUCTIONS INC., )  
 )  
Petitioner, )  
 )  
v. )  
 )  
CLOUDSTREET, INC. )  
d/b/a ROXBURY ENTERTAINMENT, )  
 )  
Registrant. )

Cancellation No. \_\_\_\_\_

**CONSOLIDATED PETITION TO CANCEL**

Petitioner, Penthouse Digital Media Productions Inc., a New York corporation having an address at 6800 Broken Sound Parkway, Suite 100, Boca Raton, Florida 33487, believes that it is and will be damaged by, and hereby petitions to cancel, the following three U.S. Trademark Registrations (collectively, the "Registrations") for the mark ROUTE 66 (the "Asserted Mark"):

- U.S. Registration No. 3,189,543 "for pre-recorded DVD's and videocassettes featuring drama, action and adventure" in International Class 9 (the "DVD/Videocassette Registration");
- U.S. Registration No. 3,194,255 for "entertainment services, namely, entertainment in the nature of an on-going television program in the field of drama, action and adventure; television production services" in International Class 41 (the "TV Program Registration"); and

- U.S. Registration No. 3,291,736 for “motion picture film series featuring drama, action and adventure” in International Class 9 (the “Motion Picture Registration”).

To the best of Petitioner’s knowledge, based on the TARR database of the United States Patent and Trademark Office (“Trademark Office”), the name and address of the current owner of the Registrations are Cloudstreet, Inc. d/b/a Roxbury Entertainment (“Registrant”), 201 Wilshire Boulevard, Second Floor, Santa Monica, California 90401, and the correspondent for the Registrations is Paul D. Supnik, 9401 Wilshire Boulevard, Suite 1012, Beverly Hills, California 90212.

Petitioner’s grounds for cancellation are as follows:

#### The Lawsuit

1. On June 12, 2008, Registrant sued Petitioner, Petitioner’s parent FriendFinder Networks Inc. (f/k/a Penthouse Media Group Inc.), Petitioner’s licensee Pulse Distribution LLC, and Does 1-10 in the United States District Court for the Central District of California, Case No. CV08-03872 (the “Lawsuit”), for the alleged violation of the Lanham Act, federal trademark infringement and other causes of action based on Petitioner’s production, release and distribution in commerce of the adult entertainment motion picture titled PENTHOUSE: ROUTE 66.

2. In the Lawsuit, Registrant claims to be the current successor-in-interest to alleged ROUTE 66 trademark rights arising from the “Route 66” television series originally broadcast via the CBS television network from 1960-1964 starring actors Martin Milner, George Maharis, and later Glenn Corbette (“Registrant’s Television Series”).

3. In the Lawsuit, Registrant has alleged that Petitioner, among others, unlawfully used “Route 66” as part of the title of an adult entertainment movie in violation of Registrant’s

claimed exclusive right to use such term in connection with the goods and services identified in the Registrations.

4. Because Registrant has asserted the Registrations against Petitioner, its parent and its licensee in the Lawsuit, Petitioner is harmed by the continued subsistence of the Registrations, including the evidentiary presumptions that such Registrations confer upon Registrant, which Petitioner must rebut in the Lawsuit.

#### **The Registrations**

5. The DVD/Videocassette Registration claims a date of first use anywhere, and in commerce, of February 28, 1995, the TV Program Registration claims a date of first use anywhere, and in commerce, of September 30, 1960, and the Motion Picture Registration claims a date of first use anywhere, and in commerce, of May 7, 2007.

6. The Registrations provide Registrant with certain benefits, including, without limitation: (a) *prima facie* evidence that trademark rights in the Asserted Mark are valid; (b) *prima facie* evidence that the Registrant is the exclusive owner of the Asserted Mark; and (c) the possibility to recover treble damages and attorneys' fees from an adjudicated infringer of the Registrations.

#### **Applicable Law**

7. Trademark Manual of Examining Procedure ("TMEP") Section 903.02 governs an applicant's designation of the date of first use of a claimed mark in commerce. That section provides, in pertinent, part that "[a]n applicant may not file an application on the basis of use of a mark in commerce *if such use has been discontinued.*" Id. (emphasis added).

8. TMEP Section 903.09 governs an applicant's designation of the date of first use of a claimed mark in commerce for more than one item of goods or services in a particular class.

That section provides, in pertinent part:

There must be at least one specified item in a class to which the specified dates pertain. . . . Where the dates of use do not pertain to all items, the applicant should designate the particular item(s) to which they do pertain. . . . If more than one item of goods or services is specified in a particular class, the [Trademark] Office will presume that the dates of use apply to all the goods or services, unless the applicant states otherwise.

Id. (citations omitted).

9. TMEP Section 1202.08 governs an applicant's ability to register the title of a single creative work. That section provides, in pertinent part:

The title, or a portion of a title, of a single creative work must be refused registration under §§1, 2 and 45 of the Trademark Act, 15 U.S.C. §§1051, 1052 and 1127, unless the title has been used on a series of creative works. The title of a single creative work is not registrable on either the Principal or Supplemental Register.

Id. TMEP Section 1202.08(c) further provides, in pertinent part:

An applicant must submit evidence that the title is used on at least two different creative works. A series is not established when only the format of the work is changed, i.e., the same title used on a printed version of a book and a recorded version does not establish a series.

Id.

#### **DVD/Videocassette Registration**

#### **(Fraud on the Trademark Office)**

10. On information and belief, Registrant committed fraud on the Trademark Office in the prosecution of the application underlying the DVD/Videocassette Registration in that Registrant (including its predecessors-in-interest) had not used the Asserted Mark in commerce on DVDs continuously since the claimed date of first use – namely, February 28, 1995 – a fact

that Registrant deliberately concealed from and/or knowingly misrepresented to the Trademark Office.

11. On information and belief, Registrant (including its predecessors-in-interest) did not use the Asserted Mark in commerce on DVDs until 2005, at least nine years after Registrant's claimed date of first use. The specimen of use submitted to the Trademark Office by Registrant in support of the Amendment to Allege Use in the application underlying the DVD/Videocassette Registration corroborates this belief since it depicts Registrant's DVD box artwork sleeve bearing a copyright notice dated 2005 and claiming to be the "First Ever DVD Release." See Amendment to Allege Use, filed July 14, 2006, attached as Exhibit 1.

12. Similarly, on information and belief, Registrant committed fraud on the Trademark Office in the prosecution of the application underlying the DVD/Videocassette Registration in that Registrant (including its predecessors-in-interest) had not used the Asserted Mark in commerce on videocassettes continuously since the claimed date of first use -- namely, February 28, 1995 -- a fact that Registrant deliberately concealed from and/or knowingly misrepresented to the Trademark Office.

13. Even assuming, *arguendo*, that Registrant can somehow establish that the claimed date of first use is correct with respect to one, but not both, of the two types of goods identified in the DVD/Videocassette Registration, Registrant's failure to designate the particular item to which such date pertains is in violation of TMEP Section 903.09.

14. On information and belief, the Trademark Office relied on Registrant's misrepresentations when it accepted the Amendment to Allege Use and specimen submitted by Registrant in the application underlying the DVD/Videocassette Registration.

15. On information and belief, the Trademark Office would not have issued the DVD/Videocassette Registration had the assigned examining attorney known that, in fact, Registrant's claimed date of first use was incorrect and/or did not apply to all of the goods identified in the underlying application.

**(Abandonment)**

16. On information and belief, Registrant has abandoned the DVD/Videocassette Registration since Registrant (including its predecessors-in-interest) has not used the Asserted Mark in commerce on videocassettes for at least three (3) years, constituting *prima facie* evidence of abandonment of the Asserted Mark for such goods.

**TV Program Registration**

**(Fraud on the Trademark Office)**

17. On information and belief, Registrant committed fraud on the Trademark Office in the prosecution of the application underlying the TV Program Registration in that Registrant (including its predecessors-in-interest) had not used the Asserted Mark in commerce in connection with the services identified in the TV Program Registration continuously since the claimed date of first use – namely, September 30, 1960 – a fact that Registrant deliberately concealed from and/or knowingly misrepresented to the Trademark Office.

18. On information and belief, Registrant's Television Series containing "Route 66" in its title was not televised in commerce for at least twenty years after its initial run cancellation in 1964. On information and belief, Registrant's Television Series was not televised in commerce again until its run from 1985-1987 on the Nickelodeon cable channel (the "Nick at Nite Run"). See [www.Wikipedia.com](http://www.Wikipedia.com) materials attached as Exhibit 2.

19. On information and belief, not until 1993, more than five years after the Nick at Nite Run, did any "Route 66"-titled television series surface again – this time a sequel series starring actors James Wilder and Dan Cortese. The sequel series lasted four episodes on the NBC television network before being cancelled. See Ex. 2. As such, there was no "on-going television program" or "television production services" at the time Registrant filed the underlying application on July 6, 2005, claiming that such services then existed.

20. On information and belief, the Trademark Office relied on Registrant's misrepresentations when it accepted Registrant's claimed date of first use and/or claim of continuous/on-going use in the application underlying the TV Program Registration.

21. On information and belief, the Trademark Office would not have issued the TV Program Registration had the assigned examining attorney known that, in fact, Registrant's claimed date of first use was incorrect and/or that the claim of continuous/on-going use was incorrect, and as such, either misrepresentation would constitute fraud on the Trademark Office.

**(Abandonment)**

22. On information and belief, Registrant has abandoned the TV Program Registration since Registrant (including its predecessors-in-interest) has not used the Asserted Mark in commerce in connection with the services identified in the TV Program Registration for at least three (3) years, constituting *prima facie* evidence of abandonment of the Asserted Mark for such goods.

**Motion Picture Registration**

**(Fraud on the Trademark Office)**

23. On information and belief, Registrant committed fraud on the Trademark Office in the prosecution of the application underlying the Motion Picture Registration in that

Registrant (including its predecessors-in-interest) had not yet used the Asserted Mark in commerce in connection with the services identified in the Motion Picture Registration – a fact that Registrant deliberately concealed from and/or knowingly misrepresented to the Trademark Office when Registrant filed the Statement of Use in the underlying application on May 22, 2007, claiming a date of first use anywhere, and first use in commerce, of May 7, 2007.

24. On information and belief, even assuming, *arguendo*, that at some point Registrant released a single motion picture film entitled “Route 66,” Registrant never released any motion picture film series as claimed in the Motion Picture Registration, and the specimen of use submitted to the Trademark Office by Registrant in support of the Statement of Use in the underlying application corroborates this belief. Registrant describes its specimen, which consists of two photographs, as a “photograph showing title of motion picture film in theater during film festival and reference to series of motion picture films under the trademark outside of theater.” See Statement of Use, filed on May 22, 2007, attached as Exhibit 3. On information and belief, however:

- (a) both photographs depict only a single motion picture film, or advertising relating thereto, entitled “ROUTE 66” – i.e., not a motion picture film series;
- (b) notwithstanding Registrant’s purported characterization of the latter photograph – i.e., a “photograph showing . . . reference to series of motion picture films under the trademark outside of theater” (the “Second Photograph”) – such photograph makes no visible reference to any such series; and

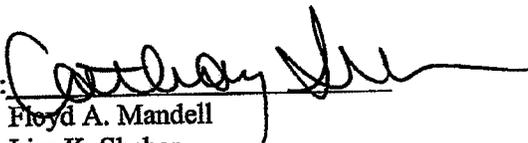
(c) the Second Photograph reveals that the motion picture film depicted in the advertisement was not yet in theaters, since the advertisement expressly states that it is "COMING SOON". See id. Indeed, Registrant's future plan or intention, if any, to release a motion picture film that is to be part of a series does not constitute "use in commerce" of the Asserted Mark within the meaning of 15 U.S.C. § 1127 as required to support registration, nor does it constitute a "series of creative works" as required to support registration under TMEP Section 1202.08.

25. On information and belief, the Trademark Office relied on Registrant's misrepresentations when it accepted the Statement of Use (including the specimen) submitted by Registrant in the application underlying the Motion Picture Registration.

26. On information and belief, the Trademark Office would not have issued the Motion Picture Registration had the assigned examining attorney known that, in fact, Registrant had not yet released at least two motion pictures entitled "Route 66".

WHEREFORE, Petitioner respectfully requests that the Trademark Trial and Appeal Board cancel the Registrations in their entirety.

Respectfully submitted,

By:   
Floyd A. Mandell  
Lisa K. Shebar  
Cathay Y. N. Smith  
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Chicago, Illinois 60661  
(312) 902-5200

# Exhibit 1

## Trademark/Service Mark Amendment to Allege Use (15 U.S.C. Section 1051(c))

The table below presents the data as entered.

Input Field	Entered
SERIAL NUMBER	78977114
LAW OFFICE ASSIGNED	LAW OFFICE 114
NOTICE OF ALLOWANCE	NO
EXTENSION OF USE	NO
REQUEST TO DIVIDE	NO
<b>MARK SECTION</b>	
STANDARD CHARACTERS	YES
USPTO-GENERATED IMAGE	YES
LITERAL ELEMENT	ROUTE 66
<b>OWNER SECTION (no change)</b>	
<b>ATTORNEY SECTION (no change)</b>	
<b>GOODS AND/OR SERVICES SECTION</b>	
INTERNATIONAL CLASS	009
GOODS AND/OR SERVICES	KEEP ALL LISTED
FIRST USE ANYWHERE DATE	02/28/1995
FIRST USE IN COMMERCE DATE	02/28/1995
SPECIMEN FILE NAME(S)	WTICRS\EXPORT4\IMAGEOUT4\789771\78977114.xml\1\AAU0002.JPG
SPECIMEN DESCRIPTION	copy of DVD insert
<b>PAYMENT SECTION</b>	
NUMBER OF CLASSES	1
SUBTOTAL AMOUNT	100
TOTAL AMOUNT	100
<b>SIGNATURE SECTION</b>	
SIGNATURE	/KIRK HALLAM/
SIGNATORY NAME	Kirk Hallam
SIGNATORY DATE	07/14/2006
SIGNATORY POSITION	President
<b>FILING INFORMATION</b>	
SUBMIT DATE	Fri Jul 14 19:34:30 EDT 2006
TEAS STAMP	USPTO/AAU-69,234,151.78-2 0060714193430694319-78977 114-3325cb4df7f261d89f5f1 e5cafbbb6e664-CC-748-2006 0712204215357385

Trademark/Service Mark Amendment to Allege Use  
(15 U.S.C. Section 1051(c))

To the Commissioner for Trademarks:

MARK: ROUTE 66  
SERIAL NUMBER: 78977114

The applicant, CLOUDSTREET, INC. dba Roxbury Entertainment, having an address of 201 Wilshire Boulevard, Second Floor, Santa Monica, California United States 90401, is using or is using through a related company or licensee the mark in commerce on or in connection with the goods and/or services as follows:

For International Class: 009, the applicant, or the applicant's related company or licensee, is using the mark in commerce on or in connection with all goods and/or services listed in the application or Notice of Allowance.  
The mark was first used by the applicant, or the applicant's related company, licensee, or predecessor in interest at least as early as 02/28/1995, and first used in commerce at least as early as 02/28/1995, and is now in use in such commerce. The applicant is submitting one specimen for the class showing the mark as used in commerce on or in connection with any item in the class, consisting of a(n) copy of DVD insert.  
Specimen-1

The applicant hereby appoints Paul D. Supnik to submit this Trademark/Service Mark Amendment to Allege Use on behalf of the applicant. The attorney docket/reference number is 2226-11.

A fee payment in the amount of \$100 will be submitted with the form, representing payment for 1 class.

Declaration

Applicant requests registration of the above-identified trademark/service mark in the United States Patent and Trademark Office on the Principal Register established by the Act of July 5, 1946 (15 U.S.C. Section 1051 et seq., as amended). Applicant is the owner of the mark sought to be registered, and is using the mark in commerce on or in connection with the goods/services identified above, as evidenced by the attached specimen(s) showing the mark as used in commerce.

The undersigned being hereby warned that willful false statements and the like are punishable by fine or imprisonment, or both, under 18 U.S.C. Section 1001, and that such willful false statements and the like may jeopardize the validity of this document, declares that he/she is properly authorized to execute this document on behalf of the Owner; and all statements made of his/her own knowledge are true and that all statements made on information and belief are believed to be true.

Signature: /KIRK HALLAM/ Date Signed: 07/14/2006  
Signatory's Name: Kirk Hallam  
Signatory's Position: President

RAM Sale Number: 748  
RAM Accounting Date: 07/17/2006

Serial Number: 78977114  
Internet Transmission Date: Fri Jul 14 19:34:30 EDT 2006  
TEAS Stamp: USPTO/AAU-69.234.151.78-2006071419343069  
4319-78977114-3325cb4df7261d89f5fle5caf  
bbb6e664-CC-748-20060712204215357385

[Go Back](#)

# BEST OF Route 66

Route 66 is one of the most famous television series in American history. An edge adventure series that functioned as an anthology of short stories, fantasy, and psychological dramas, its 66th premiere launched two young drivers in a car on an existential odyssey in which they encountered a mix of romantics, dreamers and outcasts in the small towns and big cities along U.S. Highway 66 and beyond.



© 1997 Turner Broadcasting System, Inc. All rights reserved.

## GUEST STARS INCLUDE

- Robert Redford
- James Caan
- Stefanie Powers
- Boris Karloff
- Walter Matthau
- Leslie Nielsen
- Robert Duvall
- Alan Alda
- Suzanne Pleshette
- Peter Lorre
- Martin Sheen
- Ronny Howard

## SPECIAL FEATURES

Plus the Best Original Episodes  
Digitally Remastered in High Definition

FIRST EVER AND RELEASE  
11 ORIGINAL TELEVISION EPISODES

# BEST OF Route 66

THE BEST OF  
Route 66



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BEST OF

# route 66

Route 66 is one of the most unique television series in American history. An edgy adventure series that functioned as an anthology of character studies and psychological dramas. In 1960 premiere launched two young drifters in a Corvette on an existential odyssey in which they encountered a myriad of exotic characters and our heroes in the small towns and big cities along U.S. Highway 66 and beyond.



2 DISC SET  
1960-1966  
1967-1977

## GUEST STARS INCLUDE

- Robert Redford
- James Caan
- Stefanie Powers
- Boris Karloff
- Walter Matthau
- Leslie Nielsen
- Robert Duvall
- Alan Alda
- Suzanne Pleshette
- Peter Lorre
- Martin Sheen
- Ronny Howard

## SPECIAL FEATURES

Includes the Best of Route 66 DVD and 11 Original Television Episodes

© 1997 ENTERTAINMENT WEEKLY INC.

FIRST EVER DVD RELEASE

11 ORIGINAL TELEVISION EPISODES

BEST OF

# route 66

BEST OF route 66



# Exhibit 2

## Route 66 (TV series)

From Wikipedia, the free encyclopedia

*Route 66* is an American TV series in which two young men traveled across America. The show ran weekly on CBS from 1960 to 1964. It starred Martin Milner as Tod Stiles and, for two and a half seasons, George Maharis as Buz Murdock. Maharis was ill for much of the third season, during which time Tod was shown traveling on his own. Tod met Lincoln Case, played by Glenn Corbett, late in the third season, and traveled with him until the end of the fourth and final season.

The series is best remembered for its iconic Corvette convertible and its instrumental theme song (composed and performed by Nelson Riddle), which became a major pop hit.

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### Format and characters

*Route 66* was a hybrid between episodic television drama, which has continuing characters and situations, and the anthology format (e.g. *The Twilight Zone*), in which each week's show has a completely different cast and story. *Route 66* had just three continuing characters, no more than two of whom appeared in the same episode. Like Richard Kimble from *The Fugitive*, the wanderers would move from place to place and get caught up in the struggles of the people there. Unlike Kimble, nothing was forcing them to stay on the move except their own sense of adventure, thus making it thematically closer to *Run for Your Life* and *Then Came Bronson*. A later example of this traveling protagonist format is *Quantum Leap*.

This semi-anthology concept, where the drama is centered on the guest stars rather than the regular cast, was carried over from series creator Stirling Silliphant's previous drama, *Naked City* (1958-63). Both shows were recognized for their literate scripts and rich characterizations. The open-ended format, featuring two roaming observers/facilitators, gave Silliphant and the other writers an almost unlimited landscape for presenting a wide variety of dramatic (or comedic) storylines. Virtually any tale could be adapted to the series. The two regulars merely had to be worked in and the setting tailored to fit the location. So, from toiling in a California vineyard to manning a Maine lobster boat, the two men took odd jobs along their journey which brought them into contact with dysfunctional families or troubled individuals in need of their help.

Tod and Buz (and later, Linc) symbolized restless youth searching for meaning in the early Sixties, but they were essentially non-characters. We learn almost nothing about them over the course of the series. All we are told is after the death of his father, Tod Stiles inherits a new Corvette and decides to drive across America with his friend Buz. Tod, portrayed by clean-cut Martin

<i>Route 66</i>	
	
Tod and Buz take a ferry to trouble in the series premiere.	
Format	Drama
Created by	Stirling Silliphant
Starring	Martin Milner George Maharis (1960-1963) Glenn Corbett (1963-1964)
Country of origin	<span><span><span></span></span><span> </span></span> United States
No. of seasons	4
No. of episodes	116
Running time	approx. 0:52 (per episode)
Original channel	CBS
Original run	October 7, 1960 – March 13, 1964
External links	IMDb profile

Milner, is the epitome of the decent, honest, all-American type. He is the moral anchor of the series. By contrast, the working-class Buz (George Maharis) is looser, hipper, more Beat Generation in attitude. His third-season replacement, Lincoln Case (Gleam Corbett), is a darker character, an army veteran haunted by his past. He's more introspective with a sometimes explosive temper, but is nonetheless a reliable companion on this soul-searching journey.

The series concluded with the two-part episode "Where There's a Will, There's a Way" in which Tod Stiles got married, and he and Linc finally settled down. This made the series one of the earliest prime-time television dramas to have a planned series finale resolving the fate of its main characters.

The show was filmed and presented in black and white throughout its run. This was not unusual for early 1960s episodic TV.

## Locations

*Route 66* is well-remembered for its cinematography and location filming. Writer-producer Stirling Silliphant traveled the country with a location manager (Sam Manners), scouting a wide range of locales and writing scripts to match the settings. The actors and film crew would arrive a few months later. Memorable locations include a logging camp, shrimp boats, an offshore oil rig, and Glen Canyon Dam, the latter while still under construction. It is one of very few series in the history of television to be filmed entirely on the road. This was done at a time when the United States was much less homogeneous than it is now. People, their accents, livelihoods, ethnic backgrounds and attitudes varied widely from one location to the next. Scripted characters reflected a far less mobile society, in which people were more apt to spend their entire lives in one small part of the country. Similarly, the places themselves were very different from one another visually, environmentally, architecturally, in goods and services available, etc. Stars Martin Milner and George Maharis both mentioned this in 1980s interviews. "Now you can go wherever you want," Maharis added by way of contrast, "and it's a Denny's."

## Guest stars

The roster of guest stars on *Route 66* includes quite a few actors who later went on to fame and fortune, as well as major stars on the downward side of their careers. One of the most historically significant episodes of the series in this respect was "Lizard's Leg and Owllet's Wing." It featured Lon Chaney, Jr., Peter Lorre and Boris Karloff as themselves, with Karloff donning his famous Frankenstein monster make-up for the first time in 25 years). The show was filmed at the O'Hare Inn, near O'Hare Airport, Chicago, Illinois. Dutch singer Ronnie Tober had a small guest role with Sharon Russo, Junior Miss America.

Other notable guest stars from the series included James Caan, Robert Duvall, Walter Matthau, David Janssen, Buster Keaton, Lee Marvin, Tina Louise, Suzanne Pleshette, Robert Redford, Martin Sheen, and Rod Steiger. Julie Newmar is especially memorable as a motorcycle-riding free-spirit—a role she reprised in a later episode. William Shatner and DeForest Kelley also guest starred, in separate episodes. Lee Marvin and DeForest Kelley were among the many actors and actresses to appear in more than one role over the course of the series.

In a 1986 interview, Martin Milner reported that Lee Marvin credited him with helping his career by breaking Marvin's nose "just enough" to improve his look. This happened in Pittsburgh, Pennsylvania during a scripted fistfight for "Mon Petit Chou", the second of two episodes in which Marvin appeared.

Two late third-season episodes, which aired one week apart, each featured a guest star in a bit part playing a character with a profession with which they would later become associated as stars of their own respective mega-hit television series. In "Shadows of an Afternoon", Michael Conrad can be seen as a uniformed policeman, many years before he became famous in his regular role as Police Sgt. Phil Esterhaus on *Hill Street Blues*. And in "Soda Pop and Paper Flags", Alan Alda guested as a surgeon, a precursor to his career-defining role as Dr. Benjamin Franklin "Hawkeye" Pierce on *M\*A\*S\*H*. Also in the first season episode *The Strengthening Angels* that aired November 4, 1960 Hal Smith, who played town drunk Otis Campbell in *The Andy Griffith Show*, also plays a drunk named Howard and is listed in the credits as "Drunk".

The episode "Is It True There Are Poxies at the Bottom of Landfair Lake?" featured guest stars Geoffrey Home and Collin Wilcox. In the episode's storyline, Wilcox's character pretended to get married to Home's, although it turned out to be a practical joke. A few years after appearing in this episode, Home and Wilcox would in real life be briefly married to each other.

A noteworthy in-joke occurs during the episode "Where Are the Sounds of Celli Brahams?" In this segment, Horace McMahon guests as a Minneapolis, Minnesota festival promoter. At one point, his character confesses to Linc his failed ambition to be a policeman. Linc remarks that he looks like a policeman Linc once knew in New York City. McMahon had starred as I.A. Mike Parker on the New York-based police drama *Naked City* from 1958-63, another television series overseen by the creative team of Stirling Silliphant and Herbert B. Leonard.

## Production notes

- The original working title of the series was *The Searchers*, according to George Maharis. That title was also the title of the 1956 film *The Searchers* directed by John Ford and starring John Wayne, so the series was renamed.
- The show actually had very little real connection with the US Highway providing its name. Most of the locations visited throughout the series were far afield from the territory covered by "The Mother Road." U.S. Route 66 the highway was briefly referred to in just three early episodes of the series ("Black November", "Play It Glissando", and "An Absence of Tears") and is shown only rarely, as in the early first season episode "The Strengthening Angels".
- The episode "I'm Here to Kill a King" was preempted because of President John F. Kennedy's assassination that month, and was not seen on television until the series entered syndication. This episode, and "A Long Way from St. Louis", are the only ones filmed outside the U.S., (in Canada).

## Scripts

*Route 66* was devised by Stirling Silliphant, who wrote the majority of the episodes. It was notable for its dark storylines and exceptional realism. Tod and Buz would frequently become involved with individuals whose almost nihilistic worldview made for occasionally frightening television. Some forty-six years after its premiere, *Route 66* is still one of the few television series to offer such a range of socially-conscious stories, including mercy killing, the threat of nuclear annihilation, terrorism, runaways and orphans. Other episodes dealt with the mentally ill, drug addiction or gang violence. However, some stories were congenially lighthearted, such as a memorable episode featuring Richard Basehart as a folklorist trying to record the local music of an isolated Appalachian community, and a Halloween episode called "Lizard's Leg and Owlet's Wing".

Even more unusual is the way it served up a kind of soaring dialog that has been referred to as "Shakespearean" and free-verse poetry. For instance, the boys encounter a Nazi hunter named Bartlett on the offshore oil drilling rig where they work. Bartlett describes the horrors of WWII and the Holocaust thusly: "Tod, I hope you live a long life and never know the blistering forces which sear and destroy, turn men into enemies and sweep past the last frontiers of compassion" and "once you've seen that dark, unceasing tide of faces... of the victims...the last spark of dignity so obliterated that not one face is lifted to heaven, not one voice is raised in protest even as they died..." (from episode #4, "The Man on the Monkey Board").

The quirky, textured writing extended even to episode titles, which included such oddities as "How Much a Pound is Albatross?" and "Ever Ride the Waves in Oklahoma?". Other episode titles were drawn from a wide range of literary sources, such as Shakespeare ("A Lance of Straw") or Alfred Tennyson ("A Fury-Slinging Flame").

Many of the stories were character studies, like the above-mentioned one featuring Richard Basehart as a man who uses people then tosses them away, as if they are plastic spoons. The episode titled "You Can't Pick Cotton in Tahiti" refers to small-town America as both a far-away, exotic Tahiti and the "real America" compared to "phony-baloney" Hollywood, and still offers food for thought. Many episodes offer moving soliloquies, into which future Academy-Award-winning writer Stirling Silliphant (*In the Heat of the Night*) poured his deepest thoughts.

Despite all the adventure, travelogue, drama and poetry, the real subject of the series was the human condition, with Tod and Buz often cast as a kind of roving Greek chorus, observers and mentors to broken-down prizefighters and rodeo clowns, sadists and iron-willed matrons, surfers and heiresses, runaway kids and people from all walks of life, forced by circumstances to confront their demons.

One hallmark of the show was the way it introduced viewers, however briefly, to new ways of life and new cultures. For instance, we get a glimpse of a shrimper's life in episode 3, "A Lance of Straw", and a look at Cleveland, Ohio's Polish community in episode 35, "First Class Moulia". Here the young are pushed by their parents into careers and even marriages they may not want, in an effort to hold community and family together, albeit at the expense of the happiness and well-being of the kids. This story featured Robert Redford, Martin Balsam, Nehemiah Persoff and Nancy Malone as guest stars.

One of the legacies *Route 66* left behind is a dramatic and photographic portrait of early-1960s America as a far less crowded and less complicated era, in which altruism and optimism still had a place. That place was filled by two young men who seemed to represent the best in us, the willingness to stand up for the weak and who espoused old-fashioned values like honesty and physical courage. Peaceful rebels who rejected material possessions and the American dream of owning a home, the boys were orphans who may have embodied Jack Kerouac's Beat Generation, a little bit of Marlon Brando's wild side from *The Wild One*, James Dean's inability to settle down and fit in from *Rebel Without a Cause* and the wanderlust of the above-mentioned Jim Bronson, the traveling writer and loner who toured the USA via motorcycle in the 1969-1970 series *Then Came Bronson*. The

use of the Corvette on *Route 66*, not only as the boys' transportation but as their marquee and symbol of their wandering spirit, created the link between America's Sports Car and America's Highway that endures to this day.

Given the unusual tenor of the show and the ordeal of keeping some 50 people on the road filming for most of the year, it seems highly unlikely that anything like *Route 66* will ever be attempted again.

## Theme song

Nelson Riddle was commissioned to write the instrumental theme when CBS decided to have a new song, rather than pay royalties for the Bobby Tronp song "(Get Your Kicks on) Route 66". Riddle's theme, however, offers an unmistakable homage to the latter's piano solo (as originally recorded by Nat King Cole) throughout the number. Riddle's *Route 66* instrumental was the first television theme[1] to make *Billboard Magazine's* Top 30[2], and earned two Grammy nominations in 1962.[3]

## Car

George Maharis reported in a 1986 *Nick at Nite* interview that people often ask him about "the red Corvette." According to Maharis, the Corvette was never red. It was light blue the first season, and fawn beige for the second and third seasons. Both colors were chosen to photograph well in black and white, but the show's cinematographer complained that the powder blue car reflected too much light. The Corvette was replaced with a newer model annually by the series' sponsor, General Motors, but the show itself never mentioned or explained this technicality.

## Awards and nominations

- In 1962, guest star Ethel Waters was nominated[4] for an Emmy Award in the category "Outstanding Single Performance by an Actress in a Series" for her performance in the episode "Good Night, Sweet Blues". It was the first-ever Emmy nomination for an African-American actress[5].
- Also in 1962, George Maharis was nominated for "Outstanding Continued Performance by an Actor in a Series" (Best Actor)[6] for his role as Buz.
- In 1963, the Writers Guild of America presented writer Larry Marcus with the "Best Episodic Drama" award for his screenplay for the episode "Man Out of Time".

## Episode list

### First season (1960-1961)

Ep. #	Title	Airdate	Writer	Overview
1	"Black November"	October 7, 1960	Stirling Silliphant	Car trouble strands Tod and Buz in a small town with a terrible secret.
2	"A Lance of Straw"	October 14, 1960	Stirling Silliphant	Tod and Buz sign on to crew a shrimp boat, despite the objections of the female captain's boyfriend.
3	"The Swan Bed"	October 21, 1960	Stirling Silliphant	Tod and Buz meet a girl in New Orleans during a parrot fever epidemic.
4	"The Man on the Monkey Board"	October 28, 1960	Stirling Silliphant	Tod and Buz meet a Nazi-hunter and his quarry on an offshore oil rig.
5	"The Strengthening Angels"	November 4, 1960	Stirling Silliphant	Tod and Buz try to help a migrant worker who is in trouble with the local sheriff.
6	"Ten Drops of Water"	November 11, 1960	Howard Rodman	Devastated by drought, three orphaned ranchers need Tod, Buz and the Corvette.
7	"Three Sides" (aka Three Sides of a Coin)	November 18, 1960	Stirling Silliphant	Tod and Buz get involved in family strife while working for an Oregon hop farmer.
8	"Legacy for Lucia"	November 25, 1960	Stirling Silliphant, Melvin Levy	While working at a logging camp, Tod and Buz meet a girl from Italy, who insists she has inherited the state of Oregon from a local man.

9	"Layout at Glen Canyon"	December 2, 1960	Stirling Silliphant	Tod and Buz act as bodyguards to fashion models at the Glen Canyon Dam construction site.
10	"The Beryllium Eater"	December 9, 1960	Richard Collins	Tod and Buz help an old prospector stake his claim after he finds beryllium ore.
11	"A Fury Slings Flame"	December 30, 1960	Stirling Silliphant	Tod and Buz meet a scientist (Leslie Nielsen) who intends to hide in Carlsbad Caverns with friends until an expected nuclear holocaust is over.
12	"Sheba"	January 6, 1961	Stirling Silliphant	Tod and Buz work as cowboys for Woody Biggs (Lee Marvin), who isn't done with the woman he sent to prison.
13	"The Quick and the Dead"	January 13, 1961	Stirling Silliphant, Charles Beaumont and Jerry Sohl	Tod becomes a race car driver as he and Buz get involved in a family controversy over whether an aging driver should retire.
14	"Play It Glissando"	January 20, 1961	Stirling Silliphant	Tod and Buz try to protect a woman from her jazz musician husband.
15	"The Clover Throne"	January 27, 1961	Herman Meadow	Tod and Buz work for a date farmer (Jack Warden) who fights the highway department while he "waits out" his sexy ward, hoping she will marry him.
16	"Fly Away Home (Part 1)"	February 10, 1961	Stirling Silliphant	Tod becomes a crop duster for a struggling company.
17	"Fly Away Home (Part 2)"	February 17, 1961	Stirling Silliphant	Tod and Buz get involved in a quandary over an extra-dangerous crop dusting contract.
18	"Sleep on Four Pillows"	February 24, 1961	Stirling Silliphant	Tod and Buz meet a teenage girl who claims to be on the run from gangsters -- but her family thinks she has been kidnapped.
19	"An Absence of Tears"	March 3, 1961	Stirling Silliphant	Tod and Buz try to protect a blind widow from her husband's murderers.
20	"Like a Motherless Child"	March 17, 1961	Howard Rodman, Betty Andrews	Buz and Tod split up over whether to return a runaway boy to an orphanage.
21	"Effigy in Snow"	March 24, 1961	Stirling Silliphant	Tod and Buz try to stop a murderer who has left his latest victim in the snow at Squaw Valley.
22	"Eleven, the Hard Way"	April 7, 1961	George Clayton Johnson	Tod and Buz meet a gambler (Walter Matthau), whom the people of Broken Knee have asked to save their town.
23	"Most Vanquished, Most Victorious"	April 14, 1961	Stirling Silliphant	At the request of his aunt, Tod traces the life of his saintly cousin through the Los Angeles slums.
24	"Don't Count Stars"	April 28, 1961	Stirling Silliphant	Tod and Buz get involved in a custody case over a 9-year-old heiress and her drunken, gambling "uncle."
25	"The Newborn"	May 5, 1961	Stirling Silliphant, Herb Purdum	Tod and Buz protect a Native American girl and her newborn from their employer, who rules the land like a feudal baron.
26	"A Skill for Hunting"	May 12, 1961	Jack Turley, Martin Gelman	Tod and Buz are framed as poachers after Tod interferes with a real poacher's hunting.
27	"Trap at Cordova"	May 26, 1961	Stirling Silliphant, Joseph Vogel	Tod and Buz are coerced into teaching school children in rural New Mexico.
28	"The Opponent"	June 2, 1961	Stirling Silliphant, Leonard Freeman	Buz visits and inspires his boyhood hero, a former boxing great (Darren McGavin) who is now on the skids.
29	"Welcome to Amity"	June 9, 1961	Will Lorin	Tod and Buz meet a woman (Susan Oliver), who wants to bury her mother in a nearby cemetery. The people of Amity want to stop her.
30	"Incident on a Bridge"	June 16, 1961	Stirling Silliphant	Tod and Buz board in a home with an abused, mute girl and her two jealous - and violent - suitors.

## Second season (1961-1962)

Ep. #	Title	Airdate	Writer	Overview
31	"A Month of Sundays"	September 22, 1961	Stirling Silliphant	Buz falls for starlet Arlene Sims (Anne Francis), unaware that she has a terminal illness.
32	"Blue Murder"	September 29, 1961	Stirling Silliphant, Wilbur Daniel Steele	Tod and Buz attempt to recapture a wild horse which has apparently killed its new owner.
33	"Good Night, Sweet Blues"	October 6, 1961	Will Lorin, Leonard Freeman	A dying jazz singer (Ethel Waters) enlists Tod and Buz to search out and reunite her old combo.
34	"Birdcage on My Foot"	October 13, 1961	Stirling Silliphant, Elliot Silverstein	Tod and Buz try to help a heroin junkie (Robert Duvall) kick the habit.
35	"First Class Mouliak"	October 20, 1961	John Vlahos	When a young woman is found dead, the chief suspect (Robert Redford) is the son of Tod and Buz's employer.
36	"Once to Every Man"	October 27, 1961	Frank L. Moss	Tod seems ready to finally settle down and tie the knot with the daughter of a shipyard owner (Janice Rule).
37	"The Mud Nest"	November 10, 1961	Stirling Silliphant, Leonard Freeman	After discovering a family that resembles him in a small Maryland town, Buz goes to Baltimore to search for the woman who may be his mother.
38	"A Bridge Across Five Days"	November 17, 1961	Howard Rodman	The boys try to help a woman recently released from a mental hospital adjust to life in the outside world.
39	"Mon Petit Chou"	November 24, 1961	Stirling Silliphant	Tod becomes enamored of a lounge singer, but finds an obstacle in her intensely jealous manager (Lee Marvin).
40	"Some of the People, Some of the Time"	December 1, 1961	Stirling Silliphant	Tod and Buz work for a fraudulent beauty contest promoter and become hucksters in the process.
41	"The Thin White Line"	December 8, 1961	Leonard Freeman, Jordan Brotman, Bill Stine	Tod goes on a one-man rampage through Philadelphia after inadvertently drinking a beer spiked with a powerful hallucinogenic drug.
42	"And the Cat Jumped Over the Moon"	December 15, 1961	Stirling Silliphant, Frank L. Moss	A social worker (Milt Kamen) who is a former mentor of Buz is killed playing a dare game with a gang leader (Martin Sheen).
43	"Burning for Burning"	December 29, 1961	Stirling Silliphant	Tod and Buz work for a wealthy family with a dead son. When their daughter-in-law pays a visit with their grandchild, the family treats her with open hostility.
44	"To Walk with the Serpent"	January 5, 1962	Will Lorin	The F.B.I. wants Tod and Buz to infiltrate a Neo-Nazi group which is planning terrorism.
45	"A Long Piece of Mischief"	January 19, 1962	Stirling Silliphant, Richard Shapiro and Esther Mayesh	A rodeo clown nurses a love for a trick rider while fending off sadistic cowboys.
46	"1800 Days to Justice"	January 26, 1962	Jo Pagano	An ex-con (John Ericson) who was framed takes over a small Texas town and holds a kangaroo court to pass judgment on the real culprit (DeForest Kelly).
47	"A City of Wheels"	February 2, 1962	Frank Chase	Working in a veterans hospital brings Tod and Buz into the life of an embittered invalid.
48	"How Much a Pound Is Albatross?"	February 9, 1962	Stirling Silliphant	Free-spirited motorcycle rider Vicki Russell (Julie Newmar) arrives in Tucson and turns it - and the lives of Tod and Buz - upside down.
49	"Aren't You Surprised to See Me?"	February 16, 1962	Stirling Silliphant	A religious fanatic with a biological weapon kidnaps Buz and threatens to kill him - unless the entire city of Dallas abstains from sin for 24 hours.
50	"You Never Had It So Good"	February 23, 1962	Stirling Silliphant, Frank L. Moss	As part of a power play, a female executive promotes day-laborer Buz to a high administrative position.

51	"Shoulder the Sky, My Lad"	March 2, 1962	Mort Thaw	Tod and Buz come to the aid of a young Jewish boy, who has a crisis of faith after his father is killed in a mugging.
52	"Blues for the Left Foot"	March 9, 1962	Leonard Freeman	Tod helps a dancer - his first love - get a tryout with a major television network.
53	"Go Read the River"	March 16, 1962	Stirling Silliphant	Tod finds that his new employer, a designer of speedboat engines, is an exceptionally driven and desolate man.
54	"Even Stones Have Eyes"	March 30, 1962	Bary Trivers	Buz contemplates taking his own life after a construction accident leaves him without his sight.
55	"Love is a Skimmy Kid"	April 6, 1962	Stirling Silliphant	A young woman (Tuesday Weld) stirs up a small Texas community by arriving in town wearing a frightful mask, which she refuses to remove.
56	"Kiss the Maiden, All Fodorn"	April 13, 1962	Stirling Silliphant	An international fugitive (Douglas Fairbanks, Jr.) risks recapture by returning to the U.S. to visit his daughter.
57	"Two on the House"	April 20, 1962	Gilbert Ralston	A young boy pretends to be the target of kidnapers in order to get attention from his business-obsessed father.
58	"There I Am - There I Always Am"	May 4, 1962	Stirling Silliphant	Buz attempts to rescue a young woman who gets her foot stuck in the rocks of a Southern California beach, with the high tide coming in.
59	"Between Hello and Goodbye"	May 11, 1962	Stirling Silliphant	Tod becomes involved with a reckless blonde and her reserved brunette sister.
60	"A Feat of Strength"	May 18, 1962	Howard Rodman, Joseph Petracca and Everett De Baum	Tod helps introduce a legitimate Hungarian wrestler (Jack Warden) to the American version of the sport.
61	"Hell is Empty, All the Devils Are Here"	May 25, 1962	Stirling Silliphant	Tod's employer (Peter Graves) is an animal trainer plotting revenge against the man he believes responsible for his wife's death.
62	"From an Enchantress Fleeing"	June 1, 1962	Stirling Silliphant, Abram S. Ginnes	Tod goes in search of a henpecked runaway husband.

## Third season (1962-1963)

Ep. #	Title	Airdate	Writer	Overview
63	"One Tiger to a Hill"	September 21, 1962	Stirling Silliphant	Tod and Buz cross paths with an Oregon fisherman (David Janssen) whose war experiences have turned him into a bitter, vicious misanthrope.
64	"Journey to Ninevah"	September 28, 1962	William R. Cox	Tod and Buz suffer a series of odd misfortunes after they give a ride to a local jinx (Buster Keaton).
65	"Man Out of Time"	October 5, 1962	Larry Marcus	Tod's cab fare is a former prohibition-era gangster who believes someone from his past wants to kill him.
66	"Ever Ride the Waves in Oklahoma?"	October 12, 1962	Stirling Silliphant, Borden Chase and Frank Chase	At California's famous Huntington Beach, Buz challenges the local surfing champ to avenge the death of a former challenger.
67	"Voice at the End of the Line"	October 19, 1962	Larry Marcus	A co-worker of Buz carries on a telephone romance with a woman he has never seen.
68	"Lizard's Leg and Owllet's Wing"	October 26, 1962	Stirling Silliphant	Old-time horror-movie icons Lon Chaney, Jr., Boris Karloff, and Peter Lorre reunite at a Chicago hotel to plan a horror TV show for a new generation.
		November		Tod and Buz board at an Oregon house with a

69	"Across Walnuts and Wine"	2, 1962	Stirling Silliphant	strangely dysfunctional family.
70	"Welcome to the Wedding"	November 9, 1962	Howard Rodman	A cold-blooded killer (Rod Steiger) escapes from police custody and takes Tod captive.
71	"Every Father's Daughter" (a.k.a. "Every Father's Daughter Must Weave Her Own")	November 16, 1962	Anthony Lawrence	Buz's employer tries to set him up with his troubled daughter.
72	"Poor Little Kangaroo Rat"	November 23, 1962	Les Pine	Tod and Buz work for a shark-hunting scientist (Leslie Nielsen) who is so obsessed with his cholesterol research he ignores his own family.
73	"Hey Moth, Come Eat the Flame"	November 30, 1962	Stirling Silliphant	Tod and Buz try to help a young boy cope with his father's alcoholism.
74	"Only by Cunning Glimpses"	December 7, 1962	Stirling Silliphant, Preston Wood	A traveling medium displays an uncanny ability to predict the future, and her next prediction is for Buz's death!
75	"Where is Chick Lorimer? Where Has She Gone?"	December 14, 1962	Larry Marcus, Bert Lambert	Tod unwittingly helps a young woman (Vera Miles) escape from her bail bondsman.
76	"Give the Old Cat a Tender Mouse"	December 21, 1962	Stirling Silliphant	Tod once again encounters Vicki Russell (Julie Newmar) in Tennessee, where she is being courted by a cotton baron.
77	"A Bunch of Lonely Pagliaccis"	January 4, 1963	Stirling Silliphant	Tod's idyllic new existence working for a prize-winning, William Faulkner-ish novelist in rural Mississippi is shattered by murder.
78	"You Can't Pick Cotton in Tahiti"	January 11, 1963	Shimon Winzelberg	A runaway groom (Richard Basehart) in a tiny Tennessee community pretends to study local folk songs as he uses the town, its people and Tod for his own ends.
79	"A Gift for a Warrior"	January 18, 1963	Larry Marcus and Harlan Ellison	Tod and Buz try to help a German youth find his American father, unaware that the youth plans to kill the man.
80	"Suppose I Said I Was the Queen of Spain"	February 8, 1963	Stirling Silliphant, Jerome B. Thomas	Tod becomes romantically involved with a woman (Lois Nettleton) who gives the term "role playing" a whole new meaning.
81	"Somehow It Gets to Be Tomorrow"	February 15, 1963	Stirling Silliphant	Tod tries to help a pair of runaway orphans.
82	"Shall Forfeit His Dog and Ten Shillings to the King"	February 22, 1963	Stirling Silliphant	Tod joins a posse hunting a pair of killers near Arizona's Superstition Mountain.
83	"In the Closing of a Trunk"	March 8, 1963	Stirling Silliphant	A woman returning from a long prison stay believes Tod to be her son.
84	"The Cage Around Maria"	March 15, 1963	Stirling Silliphant	Tod comes to the rescue of a young woman who jumps into the bear pit of the Houston zoo.
85	"Fifty Miles from Home"	March 22, 1963	Stirling Silliphant	Tod meets his new traveling partner, one Lincoln Case (Glenn Corbett) - Army Ranger and war hero, just returned from Vietnam.
86	"Narcissus on an Old Red Fire Engine"	March 29, 1963	Joel Carpenter	Linc becomes involved with a troubled, self-obsessed young Galveston debutante.
87	"The Cruellest Sea of All"	April 5, 1963	Stirling Silliphant	Tod works at Florida's famous Weekee Watchee aquatic park when he meets a young woman who may be a real mermaid.
88	"Peace, Pity, Pardon"	April 12, 1963	Stirling Silliphant	Tod and Linc aid Jai-Lai players in a dangerous attempt to smuggle a little girl out of Cuba.
89	"What a Shining Young Man Was Our Gallant Lieutenant"	April 26, 1963	Howard Rodman	Linc pays a visit to his former commanding officer (Dick York) only to find that head wounds suffered in combat have regressed him back into an 8-year-old boy.

90	"But What Do You Do In March?"	May 3, 1963	Stirling Silliphant	Tod and Linc race speedboats as they get caught up in the rivalry between two spoiled heiresses.
91	"Who Will Cheer My Bonnie Bride?"	May 10, 1963	Shimon Wincelberg	Linc is shanghaied by holdup men who are on their way to a wedding.
92	"Shadows of an Afternoon"	May 17, 1963	Leonard Freeman, Alvin Sargent and Eric Scott	Linc is jailed after an old woman accuses him of cruelly injuring a dog.
93	"Soda Pop and Paper Flags"	May 31, 1963	John McGreevey	A hobo befriended by Tod and Linc is suspected of bringing a rare and deadly virus into a Missouri town.

## Fourth season (1963-1964)

Ep. #	Title	Airdate	Writer	Overview
94	"Two Strangers and an Old Enemy"	September 27, 1963	Stirling Silliphant	Tod and Linc search for a missing war hero (Jack Warden) in the Everglades.
95	"Same Picture, Different Frame"	October 4, 1963	Stirling Silliphant	A matron (Joan Crawford) fears her ex-husband means to kill her.
96	"Come Out, Come Out, Wherever You Are"	October 11, 1963	Stirling Silliphant	Linc falls for the capricious daughter of a sawmill owner.
97	"Where Are the Sounds of Celli Brahams?"	October 18, 1963	Stirling Silliphant	Tod gets a job working with a female acoustical engineer and finds her difficult to keep up with.
98	"Build Your Houses With Their Backs to the Sea"	October 25, 1963	Frank L. Pierson	Tod and Linc observe the grim conflict between a Maine lobster fisherman and his prodigal son (William Shatner).
99	"And Make Thunder His Tribute"	November 1, 1963	Lewis John Carlino	Tod and Linc go to work for a raspberry farmer and find themselves in yet another father-son conflict.
100	"The Stone Guest"	November 8, 1963	Stirling Silliphant	A cave-in at a Colorado mine traps the town ne'er-do-well underground with a spinster, while Mozart's <i>Don Giovanni</i> plays in the town and parallels the mine tragedy.
101	"I Wouldn't Start From Here"	November 15, 1963	Ernest Kinoy	Tod and Linc help an old Vermont farmer try to stave off bankruptcy.
102	"I'm Here to Kill a King"	Originally intended for November, 1963, not broadcast during series' original run	Stirling Silliphant	Coincidence brings Tod together with a political assassin (also played by Martin Milner) who is his identical double. Filmed in Canada.
103	"A Cage in Search of a Bird"	November 29, 1963	Stirling Silliphant	A moll (Stefanie Powers) steals six hundred dollars from her boyfriend's poker game and then hides the money in the hubcap of Tod and Linc's car.
104	"A Long Way From St. Louie"	December 6, 1963	Stirling Silliphant	Linc takes it upon himself to help out a troupe of girl musicians stranded in Toronto, Canada.
105	"Come Home, Greta Inger Gruenshaffen"	December 13, 1963	Stirling Silliphant	Tod and Linc vie for the affections of a German physical culturist who is on a sabbatical.
106	"93 Percent in Smiling"	December 20, 1963	Alvin Sargent	Tired of their parents' bickering, two young children kidnap their baby brother and set up their own "family."
107	"Child of a Night"	January 3, 1964	Stirling Silliphant	Tod and Linc try to fulfill a dying man's wish to find the child he never knew and give her

				his life's savings.
108	"Is it True There Are Poxies at the Bottom of Landfair Lake?"	January 10, 1964	Alvin Sargent	A young man in rural Georgia seeks to publicly humiliate a woman who was the instrument of a cruel practical joke perpetrated on him in the Army.
109	"Like This It Means Father --- Like This - Bitter --- Like This - Tiger"	January 17, 1964	Stirling Silliphant	Linc runs into a former member of his Vietnam outfit - the man who got his men killed in combat.
110	"Kiss the Monster, Make Him Sleep"	January 24, 1964	Stanley R. Greenberg	Linc has a full plate as he carries on a relationship with a troubled young woman while reconciling with his mother and estranged father.
111	"Cries of Persons Close to One"	January 31, 1964	William Kelley and Howard Rodman	Linc must take the place of an alcoholic boxer who is unable to participate in a fight.
112	"Who in His Right Mind Needs a Nice Girl?"	February 7, 1964	Joel Carpenter	A shy and naive young librarian becomes infatuated with a dashing stranger, unaware he is a murderer being sought by the police.
113	"This is Going to Hurt Me More Than It Hurts You"	February 14, 1964	Stirling Silliphant	A former classmate of Tod's (Soupy Sales), who is now a millionaire, wants Tod and his "manservant" Linc to take his place.
114	"Follow the White Dove With the Broken Wing"	February 21, 1964	Alvin Sargent	After accidentally killing a policeman, a troubled teenager takes Tod and Linc hostage.
115	"Where There's a Will, There's a Way" (Part One)	March 6, 1964	Stirling Silliphant	The bizarre terms of a tycoon's will mandate that Tod marry his daughter (Barbara Eden).
116	"Where There's a Will, There's a Way" (Part Two)	March 13, 1964	Stirling Silliphant	After surviving an attempt on his life by inheritance-seekers, Tod plans a Monte Cristo-esque revenge.

## DVD Release

On August 5, 2008, Infinity Resources Group will release the complete first season of *Route 66* on DVD in Region 1 for the very first time.

Title	Ep #	Release Date
The Complete First Season	30	August 5, 2008

## Cultural impact

- The series was lampooned in the April 1962 issue of *Mad* magazine. The parody, entitled "Route 67", followed the publication's established practice of irreverently satirizing current popular programs and motion pictures in comic strip format. The send-up features an appearance by the character Mary Worth, who chides the boys for trying to usurp her role as the nation's chief do-gooder.
- According to biographer Dennis McNally (*Desolate Angel: Jack Kerouac, The Beat Generation, and America*), Jack Kerouac tried to sue the show's producer Stirling Silliphant, claiming that it plagiarized his novel *On the Road*, which also featured two buddies traveling America's byways in search of adventure. McNally said Kerouac was "appalled by the show's violence," but the lawyers he contacted convinced him that he could never win a lawsuit. (page 272, *Desolate Angel*, McNally)
- *Route 66* was featured on the cover of *TV Guide* four times.
- In a 1963 episode of the popular situation comedy *Leave It to Beaver*, the character Eddie Haskell obtains a summer job on an Alaskan fishing boat and likens himself to "the guys on *Route 66*." *Beaver* was at the time airing on the rival ABC

network.

- In the *Alien Nation* episode "Gimme, Gimme", Albert gives Matt a vintage Corvette, whereupon the series theme by Nelson Riddle is heard.
- Actor Martin Milner toured the real Route 66 for the 2002 video production *Route 66: Return to the Road with Martin Milner*.
- James Rosin, author of the book, "Route 66: The Television Series, 1960-1964" (2007), hosted a presentation about the television series at the September 2007 Mid atlantic nostalgia convention in Aberdeen, Maryland.

## Sequel

In 1993, *Route 66* was resurrected, albeit briefly. The "sequel" series followed the adventures of two friends, Nick Lewis (played by James Wilder) and Arthur Clark (Dan Cortese), one of whom (Lewis) had inherited a classic Corvette from his father, Buz Murdock. The new series lasted a total of four episodes on NBC before being cancelled.

## External links

- Informative review of Route 66 Vol. 1, Part 1
- *Route 66* (1960) at the Internet Movie Database
- *Route 66* (1993) at the Internet Movie Database
- Route 66 (1960) episode list on epguides.com
- Route 66 (1993) episode list on epguides.com
- The Martin Milner Archives - fan site, with text of numerous articles about the series
- Martin Milner Fansite @ Hollywood.com - includes detailed biography & TV/film credits
- [http://www.tviv.org/Route\\_66](http://www.tviv.org/Route_66) - Route 66 on the TV-IV wiki
- The complete theme song for the series

## Further reading

- Rosin, James. *Route 66: The Television Series, 1960-1964*. The Autumn Road Company, Philadelphia. ISBN 0-9728684-2-9, ISBN 13: 978-0-9728684-2-6

## References

- Actor interviews, aired on Nick at Nite, 1986
- Steinberg, Cobbit S. *TV Facts*. New York: Facts on File, 1980. ISBN 0-87196-312-4

Retrieved from "[http://en.wikipedia.org/wiki/Route\\_66\\_\(TV\\_series\)](http://en.wikipedia.org/wiki/Route_66_(TV_series))"

Categories: CBS network shows | 1960s American television series | U.S. Route 66 | Drama television series | Television series by Sony Pictures Television | 1960 television series debuts | 1964 television series endings

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# Exhibit 3

## Trademark/Service Mark Statement of Use (15 U.S.C. Section 1051(d))

The table below presents the data as entered.

Input Field	Entered
SERIAL NUMBER	78664154
LAW OFFICE ASSIGNED	LAW OFFICE 114
NOTICE OF ALLOWANCE	YES
EXTENSION OF USE	NO
REQUEST TO DIVIDE	NO
<b>MARK SECTION</b>	
STANDARD CHARACTERS	YES
USPTO-GENERATED IMAGE	YES
LITERAL ELEMENT	ROUTE 66
<b>OWNER SECTION (no change)</b>	
<b>ATTORNEY SECTION (no change)</b>	
<b>GOODS AND/OR SERVICES SECTION</b>	
INTERNATIONAL CLASS	009
GOODS AND/OR SERVICES	KEEP ALL LISTED
FIRST USE ANYWHERE DATE	05/07/2007
FIRST USE IN COMMERCE DATE	05/07/2007
SPECIMEN FILE NAME(S)	WTICRS2\EXPORT13\786641\78664154.xml\1\SOU0002.JPG WTICRS2\EXPORT13\786641\78664154.xml\1\SOU0003.JPG
SPECIMEN DESCRIPTION	photograph showing title of motion picture film in theater during film festival and reference to series of motion picture films under the trademark outside of theater
<b>PAYMENT SECTION</b>	
NUMBER OF CLASSES	1
SUBTOTAL AMOUNT	100
TOTAL AMOUNT	100
<b>SIGNATURE SECTION</b>	
SIGNATURE	/Kirk M. Hallam/
SIGNATORY NAME	Kirk Hallam
SIGNATORY DATE	05/22/2007
SIGNATORY POSITION	President
<b>FILING INFORMATION</b>	
SUBMIT DATE	Tue May 22 10:47:44 EDT 2007
TEAS STAMP	USPTO/SOU-76.167.80.238-2 0070522104744829193-78664 154-360aac5b97fb9ea9685d3 e240e546c13ff6-CC-13548-2 0070515153944413797

**Trademark/Service Mark Statement of Use  
(15 U.S.C. Section 1051(d))**

To the Commissioner for Trademarks:

MARK: ROUTE 66  
SERIAL NUMBER: 78664154

This Allegation of Use is being filed after a Notice of Allowance has issued.

The applicant, CLOUDSTREET, INC., having an address of 201 Wilshire Boulevard, Second Floor, Santa Monica, California United States 90401, is using or is using through a related company or licensee the mark in commerce on or in connection with the goods and/or services as follows:

For International Class: 009, the applicant, or the applicant's related company or licensee, is using the mark in commerce on or in connection with all goods and/or services listed in the application or Notice of Allowance. The mark was first used by the applicant, or the applicant's related company, licensee, or predecessor in interest at least as early as 05/07/2007, and first used in commerce at least as early as 05/07/2007, and is now in use in such commerce. The applicant is submitting one specimen for the class showing the mark as used in commerce on or in connection with any item in the class, consisting of a(n) photograph showing title of motion picture film in theater during film festival and reference to series of motion picture films under the trademark outside of theater.

Specimen-1  
Specimen-2

The applicant hereby appoints Paul D. Supnik to submit this Trademark/Service Mark Statement of Use on behalf of the applicant. The attorney docket/reference number is 2226-11.

A fee payment in the amount of \$100 will be submitted with the form, representing payment for 1 class.

**Declaration**

Applicant requests registration of the above-identified trademark/service mark in the United States Patent and Trademark Office on the Principal Register established by the Act of July 5, 1946 (15 U.S.C. Section 1051 et seq., as amended). Applicant is the owner of the mark sought to be registered, and is using the mark in commerce on or in connection with the goods/services identified above, as evidenced by the attached specimen(s) showing the mark as used in commerce.

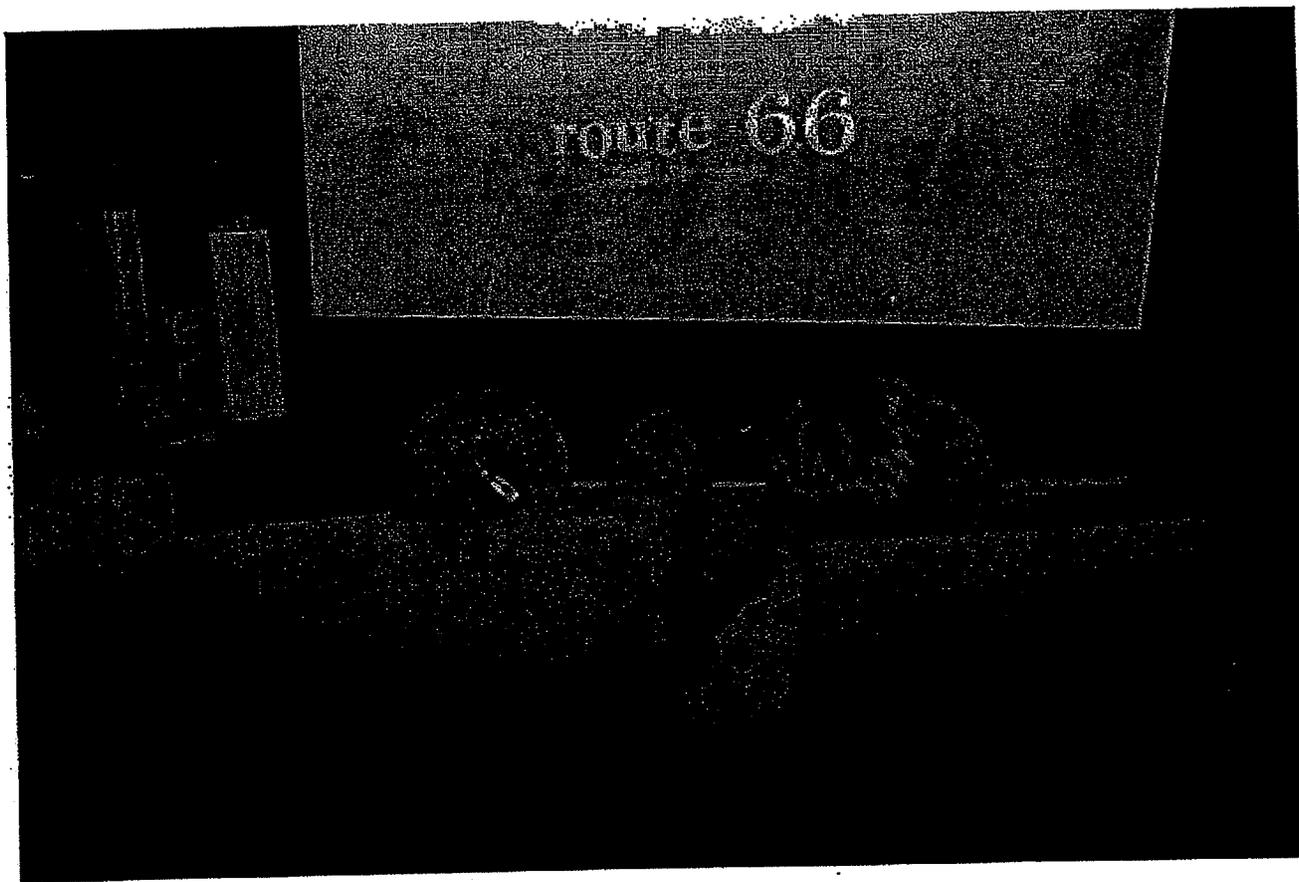
The undersigned being hereby warned that willful false statements and the like are punishable by fine or imprisonment, or both, under 18 U.S.C. Section 1001, and that such willful false statements and the like may jeopardize the validity of this document, declares that he/she is properly authorized to execute this document on behalf of the Owner; and all statements made of his/her own knowledge are true and that all statements made on information and belief are believed to be true.

Signature: /Kirk M. Hallam/ Date Signed: 05/22/2007  
Signatory's Name: Kirk Hallam  
Signatory's Position: President

RAM Sale Number: 13548  
RAM Accounting Date: 05/22/2007

Serial Number: 78664154  
Internet Transmission Date: Tue May 22 10:47:44 EDT 2007  
TEAS Stamp: USPTO/SOU-76.167.80.238-2007052210474482  
9193-78664154-360aac5b97fb9ea96885d3e240e  
546c13ff6-CC-13548-20070515153944413797

[Go Back](#)





**Exhibit B**

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 23 Email: ira@techfirm.com

24 Attorneys for Defendants  
 25 PENTHOUSE MEDIA GROUP, INC., et al.

26 **UNITED STATES DISTRICT COURT**  
 27 **CENTRAL DISTRICT OF CALIFORNIA**

28	ROXBURY ENTERTAINMENT, a	)	CASE NO. CV-08-03872
	California corporation	)	
		)	<b>DECLARATION OF KELLY</b>
	Plaintiff,	)	<b>HOLLAND</b>
		)	
	vs.	)	
		)	
	PENTHOUSE MEDIA GROUP, INC., a	)	
	Nevada corporation; PENTHOUSE	)	

1 DIGITAL MEDIA PRODUCTIONS, )  
 2 INC., a New York corporation; PULSE )  
 3 DISTRIBUTION, LLC, a California )  
 4 LLC; and DOES 1-10, inclusive )  
 5 Defendants. )

6  
 7 **DECLARATION OF KELLY HOLLAND**

8 1. I am President, Entertainment, of Penthouse Media Group, Inc., a  
 9 Defendant in this action.

10 2. I have direct knowledge of the facts contained in this Declaration, and  
 11 would be competent to testify thereto, if called as a witness.

12 3. Defendants are no longer using the term "Route 66" in connection with  
 13 the marketing, promoting, or selling of any goods or services in the United States.  
 14 Defendants intend to continue such cessation of use, until it is determined whether  
 15 Plaintiff has a protectible interest in such term.

16  
 17 I DECLARE under penalty of perjury that the foregoing is true and correct.

18 Executed this 31<sup>st</sup> day of October, 2008.

19  
 20 By Kelly Holland  
 21 KELLY HOLLAND  
 22  
 23  
 24  
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**Katten**  
 2009 Century Park East, Suite 500  
 Los Angeles, CA 90007-3273  
 Tel: 213-440-0040 Fax: 213-440-0041

# Exhibit C

*Penthouse Digital Media Productions Inc. v. Cloudstreet Inc. d/b/a  
Roxbury Entertainment, Cancellation No. 92049926*

Petitioner's Exhibit

1 Kristin L. Holland (SBN 187314)  
2 Tiffany J. Hofeldt (SBN 228864)  
3 **KATTEN MUCHIN ROSENMAN LLP**  
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NOTE: CHANGES MADE BY THE COURT

5 Floyd A. Mandell (SBN 1747681)  
6 Cathay Y. N. Smith (SBN 6290784)  
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15 Facsimile: 415.924.2905

13 Attorneys for Defendants

14 **UNITED STATES DISTRICT COURT**

15 **CENTRAL DISTRICT OF CALIFORNIA**

16 ROXBURY ENTERTAINMENT, a ) CASE NO. 2:08-cv-03872-FMC-JWJx  
17 California corporation )  
18 Plaintiff, ) **ORDER GRANTING**  
19 vs. ) **DEFENDANTS' REQUEST FOR**  
20 ) **RELIEF FROM**  
21 ) **CENTRAL DISTRICT LOCAL**  
22 ) **RULE 7-3**

21 PENTHOUSE MEDIA GROUP, INC., a )  
22 Nevada corporation; PENTHOUSE )  
23 DIGITAL MEDIA PRODUCTIONS, )  
24 INC., a New York corporation; PULSE )  
25 DISTRIBUTION, LLC, a California )  
26 LLC; and DOES 1-10, inclusive ) **Judge Florence-Marie Cooper**  
27 Defendants. )  
28 )

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**ORDER**

The Court has reviewed Defendants' Request for Relief from Local Rule 7-3 [23]. Good cause appearing therefore, the Court hereby orders the following:

- (1) Defendants' Motion to Stay is deemed filed as of October 31, 2008;
- (2) The Motion to Stay will be heard on December 1, 2008 at 10:00 a.m. in Courtroom 750; and

(3) Opposing papers and reply papers shall be filed ~~pursuant to Local Rule 7-9 and 7-10~~ as follows:

**Opposition: 11/10/08;**  
**Reply: 11/17/08.**

IT IS SO ORDERED.



Dated: November 4, 2008

---

The Honorable Florence-Marie Cooper  
United States District Judge

**Katten**  
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Los Angeles, CA 90067-3023  
310.788.4400 tel 310.788.4471 fax

# Exhibit D

*Penthouse Digital Media Productions Inc. v. Cloudstreet Inc. d/b/a  
Roxbury Entertainment, Cancellation No. 92049926*

Petitioner's Exhibit

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Tiffany J. Hofeldt (SBN 228864)  
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12 Facsimile: 415.924.2905

13 Attorneys for Defendants

14 **UNITED STATES DISTRICT COURT**

15 **CENTRAL DISTRICT OF CALIFORNIA**

16 ROXBURY ENTERTAINMENT, a ) CASE NO. CV-08-03872  
17 California corporation )  
18 Plaintiff, ) **REQUEST FOR RELIEF FROM**  
19 vs. ) **CENTRAL DISTRICT LOCAL**  
20 ) **RULE 7-3**

21 PENTHOUSE MEDIA GROUP, INC., a ) **[Proposed Order]**  
22 Nevada corporation; PENTHOUSE )  
23 DIGITAL MEDIA PRODUCTIONS, )  
24 INC., a New York corporation; PULSE ) Judge Florence-Marie Cooper  
25 DISTRIBUTION, LLC, a California )  
26 LLC; and DOES 1-10, inclusive )  
27 Defendants. )

1 Defendants PENTHOUSE MEDIA GROUP, INC., PENTHOUSE DIGITAL  
2 MEDIA PRODUCTIONS, INC. and PULSE DISTRIBUTION, LLC (“Defendants”)  
3 hereby request leave of Court to file their Motion to Stay (the “Request”) as of  
4 October 31, 2008, a date which is less than twenty days after the Conference of  
5 Counsel Prior to Filing of Motions required by Central District Local Rule 7-3 (“L.R.  
6 7-3”).

7 Defendants’ Notice of Motion and Motion to Stay, Memorandum in Support of  
8 the Motion to Stay; Declaration of Kelly Holland and related exhibits are submitted  
9 herewith as Exhibit 1 to this Request.

10 The Request is made following the conference of counsel pursuant to L.R. 7-3  
11 which was initiated by Defendants’ written correspondence to Plaintiff’s counsel on  
12 October 22, 2008, and following an in person meet and confer which took place on  
13 October 27, 2008.

14 Defendants request leave of Court to file this Motion earlier than twenty (20)  
15 days after these two meetings on the following grounds:

- 16 (1) On September 12, 2008, defendant Penthouse Digital Media Productions,  
17 Inc. (“Penthouse”), filed a consolidated petition in the TTAB, Cancellation No.  
18 92049926 (the “Cancellation Proceeding”), seeking cancellation of U.S.  
19 Registration Nos. 3189543, 3194255 and 3291736 (collectively, the  
20 “Registrations”) owned by Plaintiff for the mark ROUTE 66 in connection with  
21 various goods and services (collectively, the “ROUTE 66 Marks”);  
22 (2) Registrant (Plaintiff) has moved to suspend the TTAB Cancellation in  
23 deference to this litigation, and Penthouse filed an opposition to the Motion to  
24 Suspend on October 27, 2008;  
25 (2) While the focus of the Cancellation Proceeding is on Plaintiff’s right to  
26 retain ownership of the Registrations, in reaching such decision, the TTAB will  
27 necessarily address whether Plaintiff has a protectible interest in the ROUTE 66  
28 Marks in the first instance, given the claims raised in the Consolidated Petition



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Defendants further request that the Court set the Motion to Stay to be heard on the earliest available hearing date, or on November 17, 2008, if possible, as lead counsel for Defendants plans to be in Los Angeles on that date on another matter pending before the United States District Court for the Central District of California.

Dated: October 31, 2008

Respectfully submitted,



Kristin L. Holland (SBN 187314)  
Tiffany J. Hofeldt (SBN 228864)  
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# Exhibit E

*Penthouse Digital Media Productions Inc. v. Cloudstreet Inc. d/b/a  
Roxbury Entertainment, Cancellation No. 92049926*

Petitioner's Exhibit

***L.R. 7-3 Conference of Counsel Prior to Filing of Motions*** . In all cases not listed as exempt in L.R. 16-12, and except in connection with discovery motions (which are governed by L.R. 37-1 through 37-4) and applications for temporary restraining orders or preliminary injunctions, counsel contemplating the filing of any motion shall first contact opposing counsel to discuss thoroughly, *preferably in person*, the substance of the contemplated motion and any potential resolution. If the proposed motion is one which under the F.R.Civ.P. must be filed within a specified period of time (*e.g.*, a motion to dismiss pursuant to F.R.Civ.P. 12(b), or a new trial motion pursuant to F.R.Civ.P. 59(a)), then this conference shall take place at least five (5) days prior to the last day for filing the motion; otherwise, the conference shall take place at least twenty (20) days prior to the filing of the motion. If the parties are unable to reach a resolution which eliminates the necessity for a hearing, counsel for the moving party shall include in the notice of motion a statement to the following effect:

“This motion is made following the conference of counsel pursuant to L.R. 7-3 which took place on (date).”