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Filing date: **12/11/2009**

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

Proceeding	92050557
Party	Defendant Direct From Vegas Productions, Inc.
Correspondence Address	Jacob L. Hafter Law Offices of Jacob L. Hafter & Associates 7201 W. Lake Mead Blvd., Suite 210 Las Vegas, NV 89128 UNITED STATES jhafter@hafterlaw.com
Submission	Motion for Summary Judgment
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Date	12/11/2009
Attachments	MPSJ Geo 121109.pdf (125 pages)(3730604 bytes)

UNITED STATES PATENT AND TRADEMARK OFFICE
TRADEMARK TRIAL AND APPEAL BOARD

TRP ENTERTAINMENT, LLC, a Nevada Limited Liability Company, Petitioner, vs. DIRECT FROM VEGAS PRODUCTIONS, INC., a California Corporation, Respondent.	Cancellation No.: 92050557 Registration No: 3220387 Mark: DIRECT FROM VEGAS THE RAT PACK **FILED VIA ESTTA**

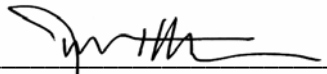
RESPONDENT'S
MOTION FOR PARTIAL SUMMARY JUDGMENT

Pursuant to 37 C.F.R. §2.127(d) and Rule 56(f) of the Federal Rules of Civil Procedure, DIRECT FROM VEGAS PRODUCTIONS, INC. ("DVP" or "RESPONDENT"), respectfully moves for partial summary judgment in its favor and against TRP ENTERTAINMENT, INC. ("TRP" or "PETITIONER"), and dismiss Petitioner's allegations, as set forth in the Amended Petition for Cancellation, that Respondent's mark, DIRECT FROM VEGAS THE RAT PACK, registration number 3220387 (the "Mark") should be cancelled for being geographically deceptive under 15 U.S.C. § 1052(e)(3), as claiming in the FIRST AMENDED PETITION FOR CANCELLATION ("FAPC") filed with the Trademark Trial and Appeal Board ("Board") on or about March 3, 2009.

Respondent will show that the term "Direct from Vegas" within the Mark is not a geographic indicator, as that is the name of the company that owns the Mark, and the use of such demonstrates ownership. Further, the phrase is meant to convey that the performance for which the Mark names, is a tribute show to performances which derived in Las Vegas, Nevada. Finally, even if the phrase, "Direct from Vegas" is a geographic indicator, there is no genuine issue of material fact that would invalidate the Mark, as there is evidence to demonstrate that the show for which the Mark relates has been performed in Las Vegas, Nevada. Thus, RESPONDENT is entitled to a judgment as a matter of law.

DATED this 11th day of December, 2009.

LAW OFFICES OF JACOB HAFTER & ASSOCIATES



Jacob Hafter, Esq.
Michael Naethe, Esq.
7201 W. Lake Mead Boulevard, Suite 210
Las Vegas, Nevada 89128
Counsel for Respondent

MEMORANDUM OF POINTS AND AUTHORITIES

Respondent makes this timely request for partial summary judgment because the Mark has been deemed, in part, as generic. As set forth herein, "the pleadings, depositions and… admissions on file, together with the affidavits, if any, show that there is no genuine issue of material fact" and that Respondent is "entitled to judgment as a matter of law." Fed. R. Civ. P. 56(c).

I. INTRODUCTION

Petitioner has a known reputation for using their capital and fiscal resources to push, bully and stymie smaller Rat Pack era tribute shows out of the market place. This instant action is a key example of such behavior. Rather than bringing such action before the judiciary, where Petitioner may be liable for the cost of such an action if it turns out that its claims are not meritorious, they have sought to frustrate Respondent with frivolous claims before the Board.

In the FAPC, Petitioner states that "when used in connection with Registrant's services in International Class 41, "Direct From Vegas The Rat Pack" is primarily a geographically deceptive misdescriptive mark and therefore may not be registered pursuant to Section 2(e)(3) of the Trademark Act, § 15 U.S.C. 1052(e)(3)." *FAPC ¶ 13*. The fatal flaw with Petitioner's position is that "Direct From Vegas" is not a geographic indicator, but, rather, the name of the company that owns the performance for which the Mark labels; accordingly, Petitioner's claim fails on its face.

Assuming, arguendo, that the Board may consider "Direct From Vegas" to be a geographic indicator, Petitioner's claim must also fail as a matter of law. Interestingly, §1052(e)(3) was recently added by the NAFTA Implementation Act in 1993. Prior to NAFTA, marks that were primarily geographically deceptively misdescriptive were treated together with marks that were primarily geographically descriptive under subsection (e)(2). Subsection (e)(3) added a materiality inquiry, and, in doing so, elevated the standard to the heightened standard applied under § 1052(a). As such, in order to fail for registration, the deceptiveness of the mark must be material; even if the Mark was deceptive,

such is not material. In this case, Petitioners suggest that since the Respondent is based in California and, as such, the production of the show is based in California, not Las Vegas, the "Direct From Vegas" component of the Mark creates deception. Even if this is technically true, the fact that Respondent is a California corporation is not material. Just as the audience does not expect to see the original members of the Rat Pack performing at the show (as such would be physically impossible, at the least), the audience does not care where the production company has placed its business headquarters. The fact is that the performance is a tribute show honoring not only the original Rat Pack, but also those numerous shows which the original Rat Pack were famous for, all of which were performed in Las Vegas. It is a tribute to those "Vegas" Rat Pack shows which the Respondent is bringing to the audience, and that is the expectation. Accordingly, Petitioner's claims of geographic misdeception are baseless, and the petition for cancellation pursuant to § 15 U.S.C. 1052(e)(3) should be DENIED as a matter of law.

II. FACTUAL BACKGROUND

Respondent is a California corporation that owns the mark "Direct from Vegas The Rat Pack" registration number 3220387. *See* Articles of Incorporation of Direct from Vegas, Inc. and Certificate of Registration, attached hereto as **Exhibits "A**" and **"B"**. In 2007, Respondent received the Mark from Steve Apple, who is a shareholder of Respondent. *See* Assignment of Mark, attached hereto as **Exhibit "C"**. Respondent has performed shows in Las Vegas on at least seven occasions. *See* Hafter Letter to Matthew Francis, attached hereto as **Exhibit "D"**.

A corporation representing Frank Sinatra's family and Sammy Davis Jr's widow, Altovise G. Davis sued the Sheraton Desert Inn Corporation for its production of the show "The Rat Pack is Back." *See Sheffield Ent., Inc. v. Sheraton*, cv-s-99-1137-kjd, 2 (D.Nev. 2001), attached hereto as **Exhibit "E"**. The plaintiffs claimed to have trademark rights over the term "Rat Pack." *Id*. The court stated "[h]ere, 'The Rat Pack' is used to describe the thing, not to identify a source" *Id*. at 19 (referring to its use in "The Rat Pack is Back"). In so finding, the court concluded "Defendant's use of the term 'The Rat Pack' is

nominative use, descriptive of content rather than an indicator of source and thus, not actionable." *Id*. at 21.

DRDC, Inc. registered the mark "The Rat Pack is Back" on October 22, 2002. *See* TESS Report, attached hereto as **Exhibit "F"**. The Petitioner, TRP, produced a musical stage show beginning in May 2002. *See TRP Opposition to Motion for Preliminary Injunction*, CV-S-05-0673-PMP-PAL, 2005 WL 3780975, 1 (D. Nev 2005), attached hereto as **Exhibit "G"**.

In 2005, Petitioner was sued by DRDC Productions, Inc., alleging copyright and trademark infringement. *DRDC v. TRP Complaint*, 2005 WL 3766623 at 2, attached hereto as **Exhibit "H"**. DRDC filed motions for a temporary restraining order and preliminary injunction seeking to prevent TRP from allegedly infringing on its trademark "The Rat Pack is Back" through the use of "The Rat Pack Returns." *See DRDC Motion for Temporary Restraining Order*, attached hereto as **Exhibit "I"** and *DRDC Motion for Preliminary Injunction*, attached hereto as **Exhibit "J"**.

In its opposition, Petitioner made a number of arguments. First, "DRDC can lay no claim to the generic term Rat Pack. This is a media-generated term that has been used to refer to Frank Sinatra, Sammy Davis, Jr., Dean Martin and Joey Bishop since the 1960s." *See TRP Opposition to Motion for Temporary Restraining Order*, attached hereto as **Exhibit "K"** at 2. Second, in a declaration filed with the court, Sandy Hackett, member of TRP, stated "there have been hundreds of Rat Pack related shows related shows since the nickname came into existence in the 1960's. *Id*. at 3. In addition, Hackett and counsel for Petitioner submitted declarations to the court stating "numerous different parties are using the terms or phrases containing the term Rat Pack." **Exhibit "G"** at 12. Their conclusion was "that Rat Pack has a commonly understood and well-recognized descriptive meaning which does not support anything beyond a narrow scope of trademark protection." *Id*. Third, Petitioners have admitted that the Las Vegas "setting is standard treatment for a show based on the Rat Pack, since that is the setting and that is the time period when they actually performed." *Id*. at 6 (arguing that the setting falls within

the scenes affaire doctrine and is unprotectable). *See also* **Exhibit "K**" at 4 ("The setting for TRP's musical production is in the 1960's in a Las Vegas casino. The setting in the 1960's in a ***Las Vegas*** casino is ***standard treatment*** for a show based on the Rat Pack, since ***that is the setting*** and that is the time period when they actually performed.").

DRDC assigned the mark "The Rat Pack is Back" to Petitioner in April 2008. Complaint ¶ 5. In February 2009, Petitioners filed their initial petition for cancellation. On March 3, 2009, Petitioners amended their petition. See FAPC.

In September 2009, the United States District Court Judge Lloyd D. George, issued an opinion stating that the term "Rat Pack" is generic and that Petitioner does not have an exclusive right to use that component. **Exhibit "L"**. The court found that "The Rat Pack" was "a term used by other persons or entities to refer to the group of entertainers, or to the activities of the group, or to indicate that an offered service or good concerned this group of entertainers in some fashion." *Id*. at 5-6. More specifically, the term "'The Rat Pack' does not answer the question of 'Who is performing the live show?" Id. at 6. The court continued:

> The existing meaning of "The Rat Pack" as a reference to members of the Rat Pack and their joint live performances of the 1960s establishes this. The live show is not "The Rat Pack" or by members of the Rat Pack. Rather, as suggested by TRP's common-law mark, TRP's live entertainment show is a tribute to members of the Rat Pack. At most, "The Rat Pack" informs the consumer that TRP's live show is about the music and performances that the members of the Rat Pack jointly performed in the 1960s, not that the show is "The Rat Pack."

Id. The court concluded that "TRP cannot appropriate the term 'The Rat Pack' for its exclusive use" and the use of the term "The Rat Pack" in connection with a Rat Pack tribute show "did not, does not, and cannot infringe TRP's registered mark." *Id*. at 7. The court then ordered the modification of Petitioner's mark to add a disclaimer of the term "Rat Pack." *Id*. at 8.

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III. LEGAL STANDARD

Summary judgment is an appropriate method of disposing of cases in which there are no genuine issues of material fact in dispute, thus leaving the case to be resolved as a matter of law. See Fed. R. Civ. P. 56(c). A party moving for summary judgment has the burden of demonstrating the absence of any genuine issue of material fact, and that it is entitled to summary judgment as a matter of law. See *Celotex Corp. v. Catrett*, 477 U.S. 317, 106 S. Ct. 2548 (1986).

Summary judgment disposes of those claims or defenses in which the moving party has shown (1) the absence of genuine issues as to the material facts, and (2) that the court may grant judgment as a matter of law. *Fed.R.Civ.Pro. 56(c)*; *Celotex Corp. v. Catrett,* 477 U.S. 317, 322 (1986). A material fact is one that affects the outcome of the litigation: a fact required to prove a basic element of a claim. *Anderson v. Liberty Lobby, Inc.,* 477 U.S. 242, 248 (1986), *Admiralty Fund v. Hugh Johnson & Co.,* 677 F.2d 1301, 1306 (9th Cir.1982). The lack of evidence supporting a fact essential to an element of a claim, or the submission of evidence precluding that fact, "necessarily renders all other facts immaterial." *Id.* at 323. In determining whether a material fact is in genuine dispute, the court construes the evidence before it "in the light most favorable to the opposing party." *Adickes v. S.H. Kress & Co.,* 398 U.S. 144, 157 (1970).

IV. THE MARK DOES NOT CONTAIN A GEOGRAPHICAL INDICATOR

The Petitioners cite 15 U.S.C § 1052(e)(3) as the justification for why the Mark should be cancelled in Paragraph 13 of the Amended Petition. *FAPC*. As a matter of law, this claim may be denied as the Mark does not contain a geographical indicator.

Petitioners argue that the phrase "Direct from Vegas" in the Mark, is a geographical indicator; Respondents vehemently deny this position. "Direct from Vegas" is derived from the name of the owner of the Mark, Direct from Vegas Productions, Inc. *See* **Exhibits "A"** and **"B"**. The use of this qualifier, "Direct From Vegas" is no different than any other use of a noun as part of a mark to show

ownership, i.e., John's Show. As Direct From Vegas Productions, Inc., or the Respondent, is the promoter and seller of the show, such modifier showing ownership is unique to that entity. Accordingly, as a matter of law, since the term "Direct From Vegas" is intended to show ownership, not be a geographic indicator, Petitioner's claims under 15 U.S.C. § 1052(e)(3) must fail.

V. THE MARK DOES NOT MEET THE REQUIREMENTS FOR A GEOGRAPHICALLY DECEPTIVE MARK

Assuming, arguendo, that the Mark contains a geographical indicator, such is not geographically deceptive. Subsection (e)(3) of 15 U.S.C. § 1052 reads "[the PTO shall not register a mark that] when used on or in connection with the goods of the applicant is primarily geographically deceptively misdescriptive of them." 15 U.S.C. § 1052(e)(3).

The Trademark Manual of Examining Procedure ("TMEP") sets forth the test for determining whether a mark is geographically deceptive. TMEP § 1210.01(c). To refuse registration because a mark has a deceptive geographic term: 1) the primary significance of the mark must be a generally known geographic location; 2) the goods must not originate from that location; 3) purchasers must be likely to believe that the goods originate from the geographic location; 4) and this belief must be a material factor in the decision to purchase. *Id*.; see also *In re Cal. Innovations, Inc*., 329 F.3d 1334, 1338 (Fed.Cir.2003). The Board has applied a nearly identical test in trademark cancellation proceedings. *See*, *e.g*., *High Sierra Food Services, Inc. v. Lake Tahoe Brewing Co. Inc*., 2003 WL 21206252 (T.T.A.B.2003); *K-Swiss Inc. v. Swiss Army Brands,* 58 U.S.P.Q.2d 1540 at *10 (T.T.A.B.2001) ("a registration more than five years old may be cancelled on the ground of geographic deceptiveness if, subsequent to the issuance of the registration, the registrant itself causes the mark to become geographically deceptive").

Looking at the first three parts of the test, the Mark, as a matter of law, cannot be geographically deceptive.

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a. The Primary Significance of the Mark Must be a Generally Known Geographic Location

The primary significance of the Mark is spatial and temporal. As discussed above, the primary significance of the Mark is to invoke images of the Rat Pack, a group of entertainers who performed in the 1960's at the Sands Hotel and Casino in Las Vegas, Nevada. Petitioners have admitted, "[t]his setting is standard treatment for a show based on the Rat Pack, since that is the setting and that is the time period when they actually performed." **Exhibit "G"** at 6 (arguing that the setting falls within the scenes affaire doctrine and is unprotectable). *See also* **Exhibit "K"** at 4. As such, the Mark does not refer to the geographic region known as Las Vegas, Nevada in 2009, but rather it is intended to recall to the relevant audience Las Vegas in the 1960s when the Rat Pack was at their peak popularity. Like any protectable mark, it invokes the imagination of customers. Respondent intentionally removed the "Las" from the Mark in an attempt to create this distinction.

b. The Goods Must Not Originate from that Location

Because the show which the Mark suggests is a tribute show to the Rat Pack shows, it is obvious and expected that the inspiration for the show was the hundreds of shows which the Rat Pack performed at the Sands Hotel and Casino in Las Vegas in the 1960's. As set forth above, this issue is not disputed by the Petitioners. **Exhibits "G"** at 6 and **"K"** at 4. Accordingly, the subject matter of the show is directly related to Vegas, hence, the name "Direct From Vegas" is appropriate, and the inspiration for the show which the Mark suggests does, in fact, originate from Las Vegas.

c. Purchasers Must Be Likely To Believe that the Goods Originate from the Geographic Location

Purchasers do not believe, nor do they expect or want that the services provided under the Mark should originate in 2009 Las Vegas, Nevada. Just as the audience does not expect the actual Rat Pack to attend and perform at the shows, (see Motion for Partial Summary Judgment, ESTTA Tracking Number ESTTA320898), so, too, is there rationality with respect to audience expectations and the

origination of the show. Most, if not all, of the people who would patronize the show related to the Mark would reasonably be expected to know something about the Rat Pack. As such, the audience would know, or should know, that the Rat Pack performed a majority of their shows live from Las Vegas, Nevada. Accordingly, where the tribute show originates, or, more specifically, as it relates to the Petitioner's claim for which they are seeking relief in the FAPC, where the Respondent has placed its business headquarters, is not as relevant to the viability and utility of the Mark as the fact that the *inspiration* for the tribute show is those shows which originated in Las Vegas, Nevada.

d. Geographic Location is not Material to Customer Purchasing Decisions

The final requirement for the four part test for geographical deception, as set forth in the TMEP, and, arguably, the most important, is that the belief that the goods originate from the geographic location must be a material factor in the decision to purchase. This last requirement is a material discussion which requires further discussion.

As stated above, subsection 1052(e)(3) was created by the NAFTA Implementation Act in 1993. Prior to NAFTA, marks that were primarily geographically deceptively misdescriptive were treated together with marks that were primarily geographically descriptive under subsection (e)(2):

> [The PTO shall not register a mark that] when used on or in connection with the goods of the applicant is primarily geographically descriptive or deceptively misdescriptive of them.

15 U.S.C. § 1052(e)(2) (1988); *see In re California Innovations, Inc*., 329 F.3d 1334 at 1336-41 (Fed.Cir.2003); *Institut National Des Appellations D'Origine v. Vintners Int'l Co*., 958 F.2d 1574, 1580 (Fed.Cir.1992) (describing the law prior to NAFTA). The "addition of a materiality inquiry [to subsection (e)(3)] equates this test with the elevated standard applied under § 1052(a)." *Cal. Innovations*. at 1340. Since the NAFTA Act, the deceptiveness of the mark must be material under subsection (e)(3) just as it is under subsection (a).

In August, 2009, the United States Court of Appeals addressed recognized that "*California Innovations* did not address the question of whether the materiality test of subsection (e)(3) embodies a requirement that a significant portion of the relevant consumers be deceived." *In re Spirits International, N.V.,* 563 F.3d 1347 (Fed. Cir.2009). Addressing this issue, the Court held that "subsection (e)(3) does incorporate such a requirement, and that the appropriate inquiry for materiality purposes is whether a substantial portion of the relevant consumers is likely to be deceived, not whether any absolute number or particular segment of the relevant consumers (such as foreign language speakers) is likely to be deceived." *Id*. at 1353. Further, the Court stated that "[u]nder the circumstances it is clear that section (e)(3)-like subsection (a), the false advertising provision of the Lanham Act, and the common law-requires that a significant portion of the relevant consuming public be deceived." *Id*. at 1356. Finally, the Court stated "in order to establish a prima facie case of materiality there must be some indication that a substantial portion of the relevant consumers would be materially influenced in the decision to purchase the product or service by the geographic meaning of the mark." *Id*. at 1357.

As set forth above, there is no evidence that a significant portion of the relevant consumers are materially influenced by any alleged geographic meaning of the Mark. Accordingly, even if there is a finding by the Board that the goods do not originate from the location, under this test, such finding would not be material to the overall bearing and utility of the Mark. As discussed above, audiences could not be reasonably expected to want to see a Rat Pat tribute show that was related to California, the location there the Respondent has its business headquarters. Rather, audiences expect to see a Rat Pack tribute show that uses impersonators to recreate the experience provided to audiences in the 1960's Las Vegas showrooms. Accordingly, the Mark, "Direct From Vegas" is not geographically misleading; rather it is symbolizes the experience which the underlying performance delivers.

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VI. ASSUMING "DIRECT FROM VEGAS" IS A GEOGRAPHICAL INDICATOR, EVIDENCE SUPPORTS THAT THE SHOW HAS BEEN PERFORMED IN LAS VEGAS.

Notwithstanding any of the foregoing, contrary to Petitioner's allegations, Respondent has a relationship with the Las Vegas market. Respondent has provided Petitioners with a list of performances of the show related to the Mark. *See* Hafter Letter to Matthew Francis, attached hereto as **Exhibit "D"**. The fact that these shows occurred is undisputed. While Petitioners have devalued the utility of these shows, as they have been private shows for large corporations and other private audiences, the fact that is relevant to this Motion is that Respondent has produced the show related to the Mark in Las Vegas, Nevada. That is undisputed.

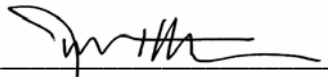
In addition, Respondent has utilized the services of two Las Vegas-based agencies – Classique Productions and Destinations by Design – to procure performance contracts on his behalf. *See Respondent's Second Amended First Interrogatories*, Interrogatory No. 8, attached hereto as **Exhibit "M"**. As such, the promotion of the performance for which the Mark relates also comes from Las Vegas. Hence, the argument that the Mark contains a false geographic indicator is flawed.

VII. CONCLUSION

This instant Motion requests that the Board dismiss, as a matter of law, Petitioner's claims that the Mark, "DIRECT FROM VEGAS THE RAT PACK," should be cancelled for being geographically deceptive under 15 U.S.C. § 1052(e)(3). First, the phrase in contention, "Direct From Vegas" indicates ownership of the Mark, namely, that of Direct From Vegas Productions, Inc., the name of the Respondent. Notwithstanding, as demonstrated herein, the Mark is reflective of a Rat Pack tribute show set in the day and age of 1960's Vegas showrooms. Hence, the Mark is suggestive of the show which it represents. Finally, while the business headquarters for the Respondent is in California, the show has been performed in Las Vegas, hence, the show does have production ties to Las Vegas. Accordingly, Respondent requests, as a matter of law, that Petitioners claims be dismissed.

DATED this 11th day of December, 2009.

LAW OFFICES OF JACOB HAFTER & ASSOCIATES



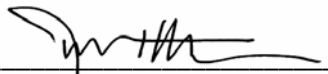
Jacob Hafter, Esq.
Michael Naethe, Esq.
7201 W. Lake Mead Boulevard, Suite 210
Las Vegas, Nevada 89128
Counsel for Respondent

CERTIFICATE OF SERVICE

The undersigned hereby certified that a copy of this paper has been served upon all parties, at their address of record, by First Class Mail, on this date.

DATED this 11th day of December, 2009.

LAW OFFICES OF JACOB HAFTER & ASSOCIATES



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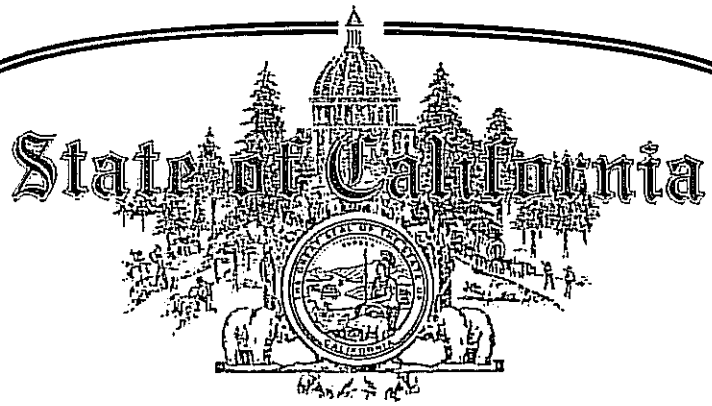
Jacob Hafter, Esq.
Michael Naethe, Esq.
7201 W. Lake Mead Boulevard, Suite 210
Las Vegas, Nevada 89128
Counsel for Respondent

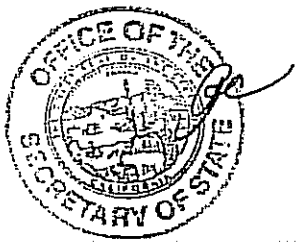
EXHIBIT "A"

EXHIBIT "A"

CONFIDENTIAL - FOR
ATTORNEY'S EYES ONLY

2315865





SECRETARY OF STATE

I, *BILL JONES*, Secretary of State of the State of California, hereby certify:

That the attached transcript of 2 page(s) has been compared with the record on file in this office, of which it purports to be a copy, and that it is full, true and correct.

IN WITNESS WHEREOF, I execute this certificate and affix the Great Seal of the State of California this day of

JUL 10 2001

Bill Jones

Secretary of State

Sec/State Form CE-107 (rev. 9/98)

OSP 01 55358

CONFIDENTIAL - FOR
ATTORNEY'S EYES ONLY

ARTICLES OF INCORPORATION

OF

DIRECT FROM VEGAS PRODUCTIONS, INC.

ENDORSED - FILED
in the office of the Secretary of State
of the State of California

JUL 3 - 2001

BILL JONES, Secretary of State

ARTICLE I

The name of this corporation is Direct From Vegas Productions, Inc.

ARTICLE II

The purpose of the corporation is to engage in any lawful act or activity for which a corporation may be organized under the General Corporation Law of California other than the banking business, the trust company business or the practice of a profession permitted to be incorporated by the California Corporations Code.

ARTICLE III

The name and address in the State of California of this corporation's initial agent for service of process is Crystal A. Zarpas, Mann & Zarpas, LLP, 5850 Canoga Avenue, Suite 400, Woodland Hills, California 91367.

ARTICLE IV

This corporation is authorized to issue only one class of shares of stock; and the total number of shares which this corporation is authorized to issue is 10,000.

ARTICLE V

The liability of the directors of the corporation for monetary damages shall be eliminated to the fullest extent permissible under California Law.

ARTICLE VI

The corporation is authorized to provide indemnification of agents (as defined in Section 317 of the Corporations Code) for breach of duty to the corporation and its stockholders through bylaw provisions or through agreements with the agents, or both, in excess of the indemnification otherwise permitted by Section 317 of the Corporations Code,

subject to the limits on such excess indemnification set forth in Section 204 of the Corporations Code.

DATED: 6-29-01

Steve Apple
Steve Apple
Incorporator

I hereby declare that I am the person who executed the foregoing Articles of Incorporation, which execution is my act and deed.

Steve Apple
Steve Apple

EXHIBIT "B"

EXHIBIT "B"

CONFIDENTIAL - FOR
ATTORNEY'S EYES ONLY

The United States of America

CERTIFICATE OF REGISTRATION

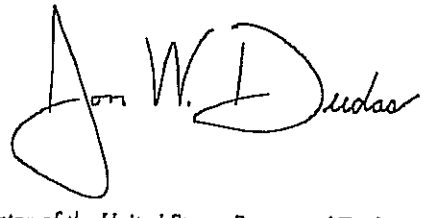
PRINCIPAL REGISTER

The Mark shown in this certificate has been registered in the United States Patent and Trademark Office to the named registrant.

The records of the United States Patent and Trademark Office show that an application for registration of the Mark shown in this Certificate was filed in the Office; that the application was examined and determined to be in compliance with the requirements of the law and with the regulations prescribed by the Director of the United States Patent and Trademark Office; and that the Applicant is entitled to registration of the Mark under the Trademark Act of 1946, as Amended.

A copy of the Mark and pertinent data from the application are part of this certificate.

To avoid CANCELLATION of the registration, the owner of the registration must submit a declaration of continued use or excusable non-use between the fifth and sixth years after the registration date. *(See next page for more information.) Assuming such a declaration is properly filed, the registration will remain in force for ten (10) years, unless terminated by an order of the Commissioner for Trademarks or a federal court. (See next page for information on maintenance requirements for successive ten-year periods.)*



Director of the United States Patent and Trademark Office

CONFIDENTIAL - FOR
ATTORNEY'S EYES ONLY

Int. Cl.: 41

Prior U.S. Cls.: 100, 101, and 107

Reg. No. 3,220,387

United States Patent and Trademark Office Registered Mar. 20, 2007

SERVICE MARK
PRINCIPAL REGISTER

DIRECT FROM VEGAS THE RAT PACK

DIRECT FROM VEGAS PRODUCTIONS, INC.
(CALIFORNIA CORPORATION)
7871 COLGATE AVE
WESTIMINSTER, CA 92683

FOR: ENTERTAINMENT SERVICES, NAMELY LIVE AND TELEVISED APPEARANCES BY A PROFESSIONAL ENTERTAINER, LIVE PERFORMANCES BY A MUSICAL BAND AND LIVE MUSIC CONCERTS, IN CLASS 41 (U.S. CLS. 100, 101 AND 107).

FIRST USE 10-9-2003; IN COMMERCE 10-9-2003.

NO CLAIM IS MADE TO THE EXCLUSIVE RIGHT TO USE "THE RAT PACK", APART FROM THE MARK AS SHOWN.

SN 76-538,531, FILED 8-18-2003.

CARRIE ACHEN, EXAMINING ATTORNEY

EXHIBIT "C"

EXHIBIT "C"

CONFIDENTIAL - FOR ATTORNEY'S EYES ONLY

UNITED STATES PATENT AND TRADEMARK OFFICE

UNDER SECRETARY OF COMMERCE FOR INTELLECTUAL PROPERTY AND
DIRECTOR OF THE UNITED STATES PATENT AND TRADEMARK OFFICE

JANUARY 29, 2007

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BRIEF: ASSIGNS THE ENTIRE INTEREST AND THE GOODWILL
DOCKET NUMBER: S. APPLE - ASSIG

ASSIGNOR:
APPLE, STEVE

DOC DATE: 01/27/2007
CITIZENSHIP: UNITED STATES
ENTITY: INDIVIDUAL

ASSIGNEE:
DIRECT FROM VEGAS PRODUCTIONS, INC.
7871 COLGATE AVE
WESTMINSTER, CALIFORNIA 92683

CITIZENSHIP: CALIFORNIA
ENTITY: CORPORATION

APPLICATION NUMBER: 76538531
REGISTRATION NUMBER:

FILING DATE: 08/18/2003
ISSUE DATE:

MARK: DIRECT FROM VEGAS THE RAT PACK

CONFIDENTIAL - FOR
ATTORNEY'S EYES ONLY

ASSIGNMENT SERVICES BRANCH
PUBLIC RECORDS DIVISION

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TRADEMARK ASSIGNMENT

Electronic Version v1.1
Stylesheet Version v1.1

01/29/2007
900067935

SUBMISSION TYPE:	NEW ASSIGNMENT
NATURE OF CONVEYANCE:	ASSIGNS THE ENTIRE INTEREST AND THE GOODWILL

CONVEYING PARTY DATA

Name	Formerly	Execution Date	Entity Type
Steve Apple		01/27/2007	INDIVIDUAL: UNITED STATES

RECEIVING PARTY DATA

Name:	Direct From Vegas Productions, Inc.
Street Address:	7871 Colgate Ave
City:	Westminster
State/Country:	CALIFORNIA
Postal Code:	92683
Entity Type:	CORPORATION: CALIFORNIA

PROPERTY NUMBERS Total: 1

Property Type	Number	Word Mark
Serial Number:	76538531	DIRECT FROM VEGAS THE RAT PACK

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NAME OF SUBMITTER:	Crystal A. Zarpas
Signature:	/caz/
Date:	01/29/2007

OP $40.00 76538531

CONFIDENTIAL - FOR
ATTORNEY'S EYES ONLY

Total Attachments: 1
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EXHIBIT "D"

EXHIBIT "D"

CONFIDENTIAL - FOR ATTORNEY'S EYES ONLY

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Admitted to Practice Law in Nevada, Pennsylvania, New Jersey, and before the U.S. Patent & Trademark Office

November 6, 2009

VIA ELECTRONIC AND REGULAR MAIL

Matthew D. Francis, Esq.
Watson Rounds
5371 Kietzke Lane
Reno, NV 89511
Mfrancis@watsonrounds.com

FOR SETTLEMENT PURPOSES ONLY

Re: TRP v. Direct from Vegas Productions

Dear Matt:

Per your email dated November 2, 2009, I wish to provide the following contracts for performances in Las Vegas under the label "confidential - for attorney's eyes only." I offer contracts for the following performances:

1. April 29, 2008 at the Wynn;
2. March 1, 2005 at Caesar's Palace;
3. May 1, 2004 at the Ritz Carlton;
4. March 24, 2004 at the Mirage;
5. March 16, 2004 at Green Valley Ranch;
6. May 8, 2003 at Caesar's Palace; and
7. April 28, 2003 at the Venetian.

I hope this information will assist you and your client in weighing DFVP's offer. Please do not hesitate to contact me directly should you have any further questions, comments or concerns.

Very truly yours,

Jacob L. Hafter, Esq.

cc: Steve Apple

7201 Lake Mead Boulevard
Suite 210
Las Vegas, Nevada 89128
702-405-6700 Telephone
702-685-4184 Facsimile
www.hafterlaw.com

EXHIBIT "E"

EXHIBIT "E"

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ENTERED AND SERVED
OCT - 3 2001
CLERK, U.S. DISTRICT COURT
DISTRICT OF NEVADA
BY _____ DEPUTY

RECEIVED AND FILED
OCT 3 3 13 PM '01
LARRY R. ... CLERK
BY _____ DEPUTY

UNITED STATES DISTRICT COURT

DISTRICT OF NEVADA

SHEFFIELD ENTERPRISES, INC.,

Plaintiff,

v.

SHERATON DESERT INN CORPORATION,

Defendant.

ALTOVISE G. DAVIS,

Plaintiff,

v.

SHERATON DESERT INN CORPORATION,

Defendant.

CV-S-99-1137-KJD (PAL)
CV-S-99-1443-KJD (PAL)

ORDER

This matter is before the Court on Defendant's Motion for Summary Judgment or in the Alternative, Summary Adjudication (#82). The Court has also considered Plaintiffs' Opposition (#94), the Declaration of Christina Sinatra (#99) and certified copies of official records (#100), together with Defendant's Reply (#111).

Also before the Court is Defendant's request for judicial notice (#83) and Plaintiffs' Opposition (#101); Plaintiffs' Motion for Relief from Stipulated Protective Order (#102) and Defendant's Opposition (#113); Plaintiffs' Motion to Strike Portions of the

Declaration of Carolyn [sic] A. Coyle (#103), Defendants Opposition (#112), and Plaintiffs' Reply (#119); Plaintiffs Motion to Strike parts of Exhibit 17 and Exhibit 18 attached to the Declaration of Kimberly Udovic (#104), Defendant's Opposition (#112), and Plaintiffs' Reply (#118); and Plaintiffs' Motion to Strike Udo (#105), Defendant's Opposition (#112), and Plaintiffs' Reply (#117).

The Court has also considered Defendant's Evidentiary Objections to Depositions of Robina and Ming and Opposition to Declarations of Finkelstein and Sinatra (#114), Plaintiffs' Oppositions thereto (#121, #122, #123, #124 & #125), and Defendant's Reply (#127). The Court has also considered the Declaration of Scott Whiteleather in Support of Defendant's Motion for Summary Judgment (#115), Plaintiffs' Request for Judicial Notice (#98), and the Declaration of Christina Sinatra in Opposition to Defendant's Motion for Summary Judgment (#99). The Court will first rule on the evidentiary motions, then the Motion for Summary Judgment.

I. BACKGROUND

Plaintiffs in this consolidated action (#17) are SHEFFIELD ENTERPRISES, INC. (hereinafter "SHEFFIELD") and ALTOVISE G. DAVIS (hereinafter "DAVIS"). SHEFFIELD claims to be the owner of the rights to the commercial use of the late Frank Sinatra's name, identity and persona. DAVIS is the widow of Sammy Davis, Jr. Plaintiffs also claim they have trademark rights in the terms "Rat Pack," "Ol Blue Eyes," and "Chairman of the Board," in the names Frank Sinatra, Sinatra, Frank, Sammy Davis, Jr., and Sammy, and in certain other silhouettes and photographs utilized by Defendant SHERATON DESERT INN CORPORATION (hereinafter "SHERATON") in the show *The Rat Pack is Back!*

The show played approximately five months at the Desert Inn Resort and Casino ("The Desert Inn"), a property in Las Vegas, Nevada, owned by Defendant SHERATON.

The show centered around four characters named Frank, Dean, Sammy and Joey and a fictitious on-stage celebration of Frank Sinatra's birthday in 1961. The show was written by entertainer David Cassidy and television writer and producer Don Reo, and produced by their company, DRDC Productions. Neither Frank Sinatra nor Sammy Davis, Jr.'s names were used in the show. According to Cassidy, the show was designed to comment on the talents, idiosyncracies, and failings of Frank Sinatra, Sammy Davis, Jr., Dean Martin, and Joey Bishop through the use of humor and parody. Although the characters in the show were not "look-alikes" for the decedents, songs of Frank Sinatra, Sammy Davis, Jr. and Dean Martin were utilized. Also, novelty drink menus, such as "Blue Eyes", were sold in connection with the performances and a small bar serving the Starlight Room at Defendant's property was renamed *The Rat Pack is Back*! Bar. Historical photographs of the deceased performers were placed on the walls of The Desert Inn show room, although no photographs or full names were used in billboard, print ads or radio ads. T-shirts and caps utilizing the logo *The Rat Pack is Back!* were sold in the hotel and casino gift shop. The show played from at least July 13 to October 22, 1999 at The Desert Inn and then re-opened at another hotel in Las Vegas, Nevada a few months later.

"Rat Pack" - Origin and Usage

It is uncontroverted that the name "Rat Pack" has been applied by others to various individuals collectively, beginning with Humphrey Bogart and Frank Sinatra. Later, the name was applied to groups variously consisting of Frank Sinatra, Sammy Davis, Jr., Dean Martin, Joey Bishop and Peter Lawford. No evidence has been adduced that members of the group ever used the name "Rat Pack" to refer to themselves, their collective performance, or advertisements of themselves as such. The group had ceased their performances by 1970, however, three of the members came together again in 1988. There is no registration of trademarks for individual members of the group or collective members

of the group. There are, however, numerous third party trademark registrations utilizing the name Rat Pack or variations thereof. Outside of this litigation, there is no evidence of enforcement efforts such as litigation or cease and desist letters on the part of members of the group or their successors. The successors have, however, licensed some rights which included use of the name "Rat Pack" on two occasions, and unsuccessfully negotiated for live presentation of portrayals of Davis, Martin and Sinatra at The Venetian, another Las Vegas, Nevada hotel casino.

II. ANALYSIS

A. EVIDENTIARY ISSUES

1. Defendant's Request for Judicial Notice.

Plaintiffs have objected to Defendant's Request that the Court take judicial notice pursuant to Rule 201 of the Federal Rules of Evidence of a report compiled by the intellectual property search firm of Thomson & Thomson. The Thomson & Thomson report purports to be an analysis of Patent and Trademark office applications using the terms "Rat Pack," "Rat" or variations thereof. Plaintiffs argue that the Thomson & Thomson report does not meet the requirements of Rule 201(b) because the report is not derived from an "unimpeachable source." Plaintiffs rely on International Star Class Yacht Racing Ass'n v. Tommy Hilfiger U.S.A., Inc., 146 F.3d 66, 70 (2d Cir. 1998). However, that case dealt with the Court taking judicial notice of facts adjudicated in a prior case. The instant case involves information derived from a search of records of the U.S. Patent and Trademark Office. The Thomson & Thomson report clearly shows the methodology used in the search and the results by trademark, status, international classes, registration number, serial number and page.

Rule 201(b) allows the Court to take judicial notice of facts not subject to reasonable dispute which are either (1) generally known within the territorial jurisdiction of

the trial court, or (2) capable of accurate and ready determination by resort to sources whose accuracy cannot reasonably be questioned. The information provided in the Thomson & Thomson report is a purported summary of records of a government agency. Plaintiffs can readily review public records of the Patent and Trademark Office to determine whether such entries exist. The facts are thus capable of accurate and ready determination by resort to sources whose accuracy cannot reasonably be questioned. Accordingly, Plaintiffs' objections to Defendant's Request for Judicial Notice of the 97 entries in the records of the Patent and Trademark Office reflecting registrations and applications for registrations of trademarks and service marks which incorporate the phrase "Rat Pack" are overruled. Moreover, even if the Court ignored the Thomson & Thomson report, Plaintiffs raise no objection to the proffer of records of the United States Patent and Trademark Office (#83, Exh. B), which records demonstrate that there are many applications and registrations for the term "Rat Pack" or variations thereof. Certified copies of registrations and requests to the Patent and Trademark Office are properly the subject of judicial notice. See Metro Publ'g. Ltd. v. San Jose Mercury News, 987 F.2d 637, 640-41 (9th Cir. 1993). The Request for Judicial Notice (#83) is, therefore, **GRANTED.**

2. Plaintiffs' Motion for Relief from Stipulated Protective Order.

Plaintiffs' Motion for Relief from Stipulated Protective Order (#102) requests to include the signature page of the engagement agreement between SHERATON and DRDC Productions, Inc. In support of the motion, Plaintiffs claim that "a genuine issue as to a material fact has been created by an assertion in the Declaration of Caroline A. Coyle, and the specification of the exact nature of said issue requires the relief sought by this motion." Defendant objects, stating that Plaintiffs have refused to explain how the document could possibly create a genuine issue of material fact when the document is simply a signature

page. As pointed out by Defendant, Plaintiffs are free to file the document under seal pursuant to the provisions of the Stipulated Protective Order (#29). The Motion for Relief from Stipulated Protective Order (#102) is therefore **DENIED WITHOUT PREJUDICE** to request for reconsideration premised on less ambiguous grounds.

3. Motions to Strike.

A. Motion to Strike Paragraph 8 and parts of Paragraphs 2, 3, 4, 5, 6 and 7 of the Declaration of Caroline A. Coyle (#103).

Paragraph 8 of the Declaration of Caroline A. Coyle (#85) states that it was not the SHERATON's intent to indicate that either SHEFFIELD or the families of Frank Sinatra or Sammy Davis, Jr. had any involvement in or in any way endorsed *The Rat Pack Is Back!* Plaintiffs object to this statement on the basis that Ms. Coyle cannot address the intent of anyone but herself.

Ms. Coyle has identified herself in Paragraph 1 as Director of Advertising and Public Relations for Defendant and the person having responsibility for promoting the show. Plaintiffs have argued that Coyle's change order regarding silhouetted figures used in advertising should be deemed evidence of SHERATON's intent to infringe. Plaintiffs have not identified any other evidence which would point to corporate intent to infringe at a higher level. Coyle has been identified as the person who forms the intent for the corporate defendant for purposes of advertising and promotion of shows and, as such, she is certainly entitled to respond to any allegations of corporate intent which are based upon her own conduct. The objection is thus **OVERRULED**.

Plaintiffs object on the grounds of hearsay to Coyle's statement (Paragraph 2) that The Desert Inn was the fifth hotel to open on the Las Vegas Strip and that it recently celebrated the 50th anniversary of its opening. Her statement regarding the opening in 1950 is based on information and belief. That portion of the objection is therefore **SUSTAINED** even though immaterial to the instant motion for summary judgment. Her statement that

the SHERATON recently celebrated its 50th anniversary is based on personal knowledge since she was present at the time of the celebration. That objection is **OVERRULED**.

Plaintiffs object on the grounds of hearsay to Paragraph 3 of the Coyle Declaration, regarding the intent of the authors and producers of the play. Defendant responds that the statement is offered to show Coyle's state of mind and not for the truth of the matter asserted. On that limited basis, it is admissible. See Fed. R. Evid. 803(3). The producers have stated their intentions (in their own declarations) and those are consistent with Ms. Coyle's statement of her understanding. The objection is therefore **OVERRULED**.

Plaintiffs object to the use of the term "servicing" to described the function of *The Rat Pack is Back*! Bar as stated in Paragraph 4 of the Coyle Declaration. Ms. Coyle in her corporate capacity would certainly have knowledge of whether the bar in question provided services to patrons of the Starlight Room. The objection is **OVERRULED**.

Plaintiffs also object to Coyle's statements (Paragraph 5) that methods used for promoting and advertising *The Rat Pack is Back!* were typical of those used for other shows that played at the SHERATON. Plaintiffs object on the grounds that it is a conclusion and violates Rule 1002 of the Federal Rules of Evidence in that the promotions and advertisements of other shows that have played at the SHERATON have not been produced in discovery. Such testimony is certainly within the Declarant's knowledge and, as Defendant has pointed out, documents relating to the advertising of previous shows presented at the SHERATON were not requested by Plaintiffs during discovery. Advisory committee notes for Rule 1002 make it clear that the rule only applies where contents of an original record are sought to be proved. The objection is **OVERRULED**.

Plaintiffs also object to Coyle's Declaration (Paragraph 6) that David Cassidy, co-author and co-producer of the show, was "substantially involved" in the creation of advertisements. Testimony based on personal knowledge and relevant to the issues is

admissible. Coyle possessed such relevant and personal knowledge. The objection is **OVERRULED**.

Plaintiffs also object to the statement in Paragraph 7 that sale of t-shirts and hats bearing the logo *The Rat Pack is Back!* was "part of the promotion of the show" because it allegedly addresses the state of mind of individuals other than the Declarant. In her position as Director of Advertising and Public Relations, Ms. Coyle would have knowledge of activities designed to promote the show. It is within her personal knowledge and thus, admissible. See Fed. R. Evid. 601. The objection is **OVERRULED**.

Accordingly, Plaintiffs' motion to strike portions of the Declaration of Caroline A. Coyle is **DENIED IN PART** and **GRANTED IN PART**.

B. Motion to Strike Parts of Exhibits 17 and 18 attached to the Declaration of Kimberly A. Udovick (#104).

Plaintiffs first move to strike that part of Exhibit 17 attached to the Udovick Declaration which at pages 7-8 states "opine that licensing fees are available only as a result of legally defensible rights and that based on the facts presented CMG would not charge a licensing fee" and that part of Exhibit 18 which states Udovick's opinion that Plaintiffs do not hold any trademark or other exclusive rights to the term "Rat Pack," etc. Defendant points out that on a Rule 56 motion, the Court will consider all papers of record. The Court would, even without the necessity of a formal motion, disregard impermissible legal conclusions of a witness. The Court will strike the legal conclusions objected to by Plaintiffs. The motion to strike is therefore **GRANTED** regarding legal conclusions.

C. Motion to Strike Udo 5, 99:23-100:18 (#105).

This Motion requests that the Court strike portions of the testimony of Albert Murray concerning the reasons for an impasse in negotiations with The Venetian Hotel for a "Rat

Pack" show. Plaintiffs seek to exclude the following on hearsay grounds:

Question:	You indicated earlier that there was an impasse regarding negotiations. Do you know what the impasse was?
Answer:	I believe it had to do with our requirement for a $2,000,000 advance?
Question:	Why did that create an impasse?
Answer:	I think it was completely - I think it was monetary. That's what I believed. I'm not totally certain. I think that's what it was, was the problem.
Question:	What did Mr. Finklestein tell you about the impasse and why the deal didn't go through?
Answer:	I learned it from Mort Viner.
Question:	What did Mr. Viner tell you?
Answer:	He said that the Venetian backed out because of the money.
Question:	Did he give any other reason?
Answer:	Not that I recall, and I wasn't privy to all of the negotiations. If I had been, I could be more specific. But again, I backed out and allowed them to handle the negotiations.

The foregoing colloquy merely reflects Viner's belief as to the reason for the impasse. It is admissible as a present sense impression under Federal Rules of Evidence 803(1). It is also admissible as an adoptive admission under 801(d)(2)(B). The statement is admissible to show that Plaintiffs did not pursue negotiations with The Venetian Hotel because of a belief that the deal had fallen through due to financial considerations and not because of anything attributable to Defendant SHERATON. Plaintiffs argue that Viner has not been shown to be a person with personal knowledge of the events described; however, there is no dispute that Viner was trustee of the Dean Martin Family Trust and the person who represented that entity in negotiations with The Venetian Hotel. As such, he would certainly have the

requisite personal knowledge. The objection is **OVERRULED** and Motion to Strike is **DENIED**.

B. DEFENDANT'S MOTION FOR SUMMARY JUDGMENT.

1. Issues Presented.

Plaintiffs claim that Defendant's use of Davis' and Sinatra's names, identities and personas in connection with services violates their rights under the Trademark Act of 1946, see 15 U.S.C. §§ 1125(a)(1)(A), 1127, the Federal Trademark Dilution Act of 1995, see 15 U.S.C. §§ 1125c, 1127, and the Nevada common law of unfair competition. Plaintiffs allege that they acquired trademark rights in the words "Rat Pack" before any use by Defendant and that Defendant's use of the words in its advertising campaign violated their rights. Plaintiffs also allege that Defendants' use of the words "Rat Pack" as an identifier of services furnished by Plaintiffs, supports recovery of damages under its dilution claim.

Defendant's Motion for Summary Judgment is based upon Nevada's Right of Publicity Statute, the First Amendment to the U.S. Constitution, the inability of Plaintiffs to establish a prima facie case, including a valid protectable mark, ownership, likelihood of confusion, causation and damages, and Defendant's claim that its use of the names Frank, Sammy, The Rat Pack, and their identities is a descriptive or nominative use.

2. Standard for Summary Judgment.

Summary judgment may be granted if "the pleadings, depositions, answers to interrogatories, and admissions on file, together with the affidavits, if any, show that there is no genuine issue as to any material fact and that the moving party is entitled to a judgment as a matter of law." Fed. R. Civ. P. 56(c); Celotex Corp. v. Catrett, 477 U.S. 317, 322 (1986). All justifiable inferences must be viewed in light most favorable to the nonmoving party. See Matsushita Elec. Indus. Co. v. Zenith Radio Corp., 475 U.S. 574, 587 (1986); Anderson v. Liberty Lobby, Inc., 477 U.S. 242, 255 (1986). Summary

judgment shall be entered "against a party who fails to make a showing sufficient to establish the existence of an element essential to that party's case, and on which that party will bear the burden of proof at trial." Celotex, 477 U.S. at 322. Summary judgment shall not be granted if a reasonable jury could return a verdict for the nonmoving party. See Anderson, 477 U.S. at 248.

The moving party bears the initial burden of showing the absence of a genuine issue of material fact. See Celotex, 477 U.S. at 323. The burden then shifts to the nonmoving party to set forth specific facts demonstrating a genuine factual issue for trial. See Matsushita, 475 U.S. at 587; Fed. R. Civ. P. 56(e). The nonmoving party may not rest upon the mere allegations or denials of his or her pleadings, but he or she must produce specific facts, by affidavit or other evidentiary materials provided by Rule 56(e), showing there is a genuine issue for trial. See Anderson, 477 U.S. at 256; Fed. R. Civ. P. 56(e).

3. Nevada's Right of Publicity Statute.

Nevada's Right of Publicity Statute is codified at Nevada Revised Statutes 597.760-810. Section 597.790 protects an individual's right of publicity in name, voice, signature, photograph or likeness for life plus fifty years. Written consent of the person or successor-in-interest is required for the use of any of those elements of persona, except where the use is an attempt to portray, imitate, simulate or impersonate a person in a live performance, or where the use is in connection with an advertisement or commercial announcement for that use. See Nev. Rev. Stat. 597.790(2)(b), (f).

Plaintiffs, in their Reply, acknowledge that their interest is imposing liability for the use of the phrase "Rat Pack" in advertising for *The Rat Pack Is Back!*. They submit that their damages stem from the advertising of the show rather than from the show itself. Citing Golden Door, Inc. v. Odisho, 646 F.2d 347, 352 (9th Cir. 1980), Plaintiffs respond to

Defendant's reliance on the Nevada Publicity Statute positing that Nevada's statute cannot constitutionally permit what the Lanham Act prohibits.

4. First Amendment.

Defendant asserts that the First Amendment to the United States Constitution is an absolute defense to this trademark infringement claim and in support, cites Partington v. Bugliosi, 56 F.3d 1147, 1152 (9th Cir. 1995) and Cardtoons v. Major League Baseball Players Ass'n, 95 F.3d 959, 976 (10th Cir. 1996). Those cases hold that the First Amendment protection of speech protects not only parody (Cardtoons), but also negative portrayals of individuals (Bugliosi). Plaintiffs respond that Defendant's liability to Plaintiffs is not based on the "portrayal" of Frank Sinatra and Sammy Davis, Jr. in the show, the performance of the show, the content of the show, or the mere inclusion of the words "Rat Pack" in the show's title. Instead, Plaintiffs' claim is based on SHERATON'S use of the words "Rat Pack" in advertising. Plaintiffs assert that the words "Rat Pack" was a commercial use and point to the creation of the hotel's *The Rat Pack is Back!* Bar and an alleged attempt to establish a "Rat Pack" themed slot area as evidence of that use. Defendant responds that the bar was there to advertise and service the show, that the slot machines, although visible from the bar, were not part of a "themed gaming area." Defendants also point to the lack of any evidence that anything was actually changed to create a themed gaming area or that the *The Rat Pack is Back!* Bar had any effect on gaming revenue. There is no evidence that the sale of t-shirts or that designation of the bar as *The Rat Pack is Back!* Bar continued after the show closed. It is thus reasonable to conclude that those features were only for advertising and promotion for the show.

To the extent that the use of the term "Rat Pack" consists of advertising and promotion for a performance protected by the First Amendment, the advertising and promotion are also protected unless they contain language of false endorsement. See Cher

v. Forum Int'l. Ltd., 692 F.2d 634, 640 (9th Cir. 1982). It would be illogical to allow Defendant to perform the show but effectively preclude any advanced discussion or promotion of their lawful enterprise. See Guglielmi v. Spelling-Goldberg Prods., 25 Cal. 3d 860, 873 (1979) (Bird, C.J., concurring). Plaintiffs respond that advertising for *The Rat Pack Is Back!* is misleading because it falsely implies endorsement by Plaintiffs, the owners of the mark. (The issue of endorsement is dealt with in the following discussion of the infringement claim.)

5. Elements of trademark infringement.

As stated previously, Plaintiffs contend that Defendant's use of the words *The Rat Pack Is Back!* constitutes trademark infringement and unfair competition. In order to establish a claim of trademark infringement and unfair competition, the Plaintiffs must be able to show: (1) that the mark is valid and protectable; (2) that Plaintiffs are the owners; (3) that Defendant's use of the mark is likely to create confusion regarding the origin of the goods or services. See Micro Star v. Formgen. Inc., 154 F.3d 1107, 1109 (9th Cir. 1998); E. & J. Gallo Winery v. Gallo Cattle Co., 967 F.2d 1280, 1294 (9th Cir. 1992); Ford Motor Co. v. Summit Motor Prods., Inc. 930 F.2d 277, 291 (3rd Cir. 1991).

a. Valid and Protectable.

Where a mark has not been federally registered or has not achieved incontestability, validity depends on proof of secondary meaning, unless the unregistered or contestable mark is inherently distinctive. See A.J. Canfield Co. v. Honickman. 808 F.2d 291, 296 (3rd Cir. 1986). Secondary meaning is demonstrated where "in the minds of the public, the primary significance of a product feature or term is to identify the source of the product rather than the product itself." Freixenet. S.A. v. Admiral Wine & Liquor Co., 731 F.2d 148, 152 (3rd Cir. 1984). A non-exclusive list of factors which may be considered includes the extent of sales and advertising leading to buyer association, length of use, exclusivity of

use, the fact of copying, the number of sales, number of customers and actual confusion. See CIBA-GEIGY Corp. v. Bolar Pharm. Co., 747 F.2d 844, 851-52 (3rd Cir. 1984).

b. Ownership.

Plaintiffs have acknowledged that the trademarks "Rat Pack," the silhouettes with hats, the terms "Ol Blue Eyes," "Chairman of the Board," "Frank," and "Sammy" are not registered marks. Therefore, protection can only be established by proof of use. Plaintiffs argue that they acquired trademark rights in those words and images by use prior to that of the Defendant. In support of this claim, Plaintiffs point to their licensing of the words "Rat Pack" on both Nick at Night and Nick at Night's TV Land and a license to the Museum of Television and Radio for the same use. Plaintiffs also point to the licensing of the use of the words "Rat Pack" and collective likenesses of Sinatra, Davis and Martin in connection with a potential presentation at The Venetian Hotel, another hotel casino in Las Vegas, Nevada.

Defendant responds that, as a matter of law, two instances of licensing are not sufficient use to create trademark rights in the phrase "Rat Pack." Defendant also responds that the license given to the museum and the Nick at Night shows included many other elements, including the right to use rare footage of the decedents and other likenesses and audio/video material.

Sporadic and *de minimis* uses are insufficient. In La Societe Anonyme des Parfums le Gallion v. Jean Patou, Inc., 495 F.2d 1265, 1272 (2d Cir. 1974), the Court held that trademark rights are not created by sporadic, casual and nominal shipment of goods bearing a mark. As indicated above, there is no evidence that the decedents themselves ever used the phrase "Rat Pack" to advertise their performances or for any other purpose. The collective performances of Sinatra, Davis, Martin, Bishop and Lawford were not so advertised, and in fact, there is nothing to contradict Defendant's contention that the

nickname was created by the press. Plaintiffs have not adduced evidence that it owned the mark prior to licensing.

There is no authority that licensing a mark without ownership rights can create ownership. Sporadic licensing is insufficient to create trademark rights. See Silverman v. CBS Inc., 870 F.2d 40, 48 (2d Cir. 1989). The records of the U.S. Patent and Trademark Office show many other registrations of the name "Rat Pack." Some of them predate Plaintiffs' claimed commercial usage in 1998.

Defendant also asserts that Plaintiffs cannot prove that they are the owners because Plaintiffs do not represent all of the various individuals who were referred to as the "Rat Pack." Only the interests of Sinatra and Davis are represented in this litigation. Although Martin's interests were represented in the licensing and promotion of the show with The Venetian Hotel, they are not represented here. Nor are the interests of Lawford, Bishop or Bogart represented. Plaintiffs assert that those individuals are not indispensable parties within Rule 19(b), citing Edward B. Marks Music Corp. v. Jerry Vogel Music Co., 140 F.2d 268 (2d Cir. 1944). However, that case involved the defendant's failure to object by motion or by answer. Here, Defendant has objected by way of the instant motion for summary judgment and has denied in its Answer (#21) that Plaintiffs are the markholder. Defendant also clearly affirms in its Eleventh Separate and Additional Defense that Plaintiffs are not entitled to relief because Plaintiffs are not the owner of the marks in question. There has been no waiver of Defendant's right to challenge the absence of other parties who would have claims at least equal to those of Plaintiffs if licensing is the basis of ownership.

c. Likelihood of Confusion.

Defendant also contends that Plaintiffs cannot establish proof that any use made of the purported marks by Defendant is likely to create confusion regarding the origin of the goods or services. Underlying Plaintiffs' contention that confusion is likely, is the

assumption that the use of the phrase *The Rat Pack Is Back!* or the silhouette of three individuals would create a reasonable belief that the show was associated with Plaintiffs. However, the advertising for *The Rat Pack Is Back!* had no indication of sponsorship except the names of Cassidy and Reo.

There is nothing before the Court to show that silhouettes, names or nicknames or photos of the decedents were used as an indicator of source. Famous individuals do not have a trademark in images unless such images are used repeatedly as an indication of origin. See Pirone v. MacMillan, Inc. 894 F.2d 579, 583 (2d Cir. 1990). The use of the denominator "presented by David Cassidy and Don Reo" reduced the possibility that individuals would be misled as to the source of the presentation. Plaintiffs have not presented any evidence that individuals patronizing the show were deceived or confused. Nor have Plaintiffs submitted any evidence that individuals viewing advertising or promotions of the show were deceived as to source or origin. Nor is the use of the name *The Rat Pack Is Back!* or the silhouettes misleading. Mere use of the name, likeness or mark of the subject of the underlying expression is not sufficient to remove protection for promotion of a First Amendment work without some independent and false expression of endorsement. See New Kids On The Block v. News Am. Publ'g, Inc., 745 F. Supp. 1540, 1546 (C.D. Cal. 1990).

There is no evidence that Defendant made any false representation, express or implied, in the advertising for the show. Use of images and words does not necessarily imply an endorsement. See Cairns v. Franklin Mint Co., 24 F. Supp. 2d 1013 (C.D. Cal. 1998). There is no evidence before the Court that any reasonable person could be confused by the name "Rat Pack," the silhouettes, or the names Sammy, Dean or Frank in the context of a show in Las Vegas, Nevada where impersonation, tributes and other forms of imitation are widely used as a part of live performances. Normally, the likelihood of confusion is a

factual question, centering on the probable reactions of prospective purchasers of the parties' goods. See American Int'l. Group, Inc. v. London America Int'l. Corp., 664 F.2d 348, 351 (2d Cir. 1981). Claims, however, may be dismissed as a matter of law where the Plaintiff fails to introduce evidence of secondary meaning or factors the court uses to determine likelihood of confusion. See AMF, Inc. v. Sleekcraft Boats, 599 F.2d 341, 348-9 (9th Cir. 1979). Plaintiffs argue that intent to confuse may be "inferred" from Defendant's decision to change the style of the hat on one of three silhouettes to a derby so the silhouette would appear to be Sammy Davis, Jr. However, such change would not, to any reasonable trier of fact, indicate that Sammy Davis, Jr. was the sponsor or source of the show. An ordinarily, prudent purchaser would have no difficulty discerning that the silhouettes are merely the subject matter of the show and do not in any way indicate sponsorship. No reasonable jury could find likelihood of confusion. See Pirone, 894 F.2d at 585.

6. Causation and Damages.

Defendant argues that Plaintiffs have not presented any evidence they were caused to suffer damages because of the SHERATON's alleged infringement. As noted above, Plaintiffs are claiming that they suffered damages based upon Defendant's advertising for a period of five months which prevented Plaintiffs from selling its own live stage show based on the collective works of Sinatra, Davis and Martin. No evidence has been presented, however, that Plaintiffs have been unable to produce their own show as a result of the actions of Defendant. As noted, the show closed in Defendant's hotel in 1999. Plaintiffs have not demonstrated that the reasons the prospective deal at The Venetian Hotel fell through was because of anything attributable to Defendant. Plaintiffs have not demonstrated that they can establish causation. Plaintiffs must prove causation in order to avoid summary judgment. See Burndy Corp. v. Teledyne Indus., Inc., 748 F.2d 767, 771 (2d Cir. 1984).

Defendant also contends that Plaintiffs have failed to demonstrate that they suffered any damages. Although Plaintiffs have produced the testimony of an expert, Maynard J. Sloate, that the value of a show based on the Rat Pack, was substantially lessened for approximately three years, the opinion is based on Sloate's experience in 1993 when he abandoned plans for a show similar to one running in another casino. He presented no evidence that similar shows failed to produce expected profits when they run in the same general time period. His testimony is speculative at best and does not provide any level of certainty as to what Plaintiffs' damages would be. An expert is permitted to render opinions but must have a factual basis. See Bilthuis v. Rexall Corp., 789 F.2d 1315, 1318 (9th Cir. 1985). Sloate has failed to provide specific facts to support his conclusion that Plaintiffs have suffered damage or that such damages are calculable.

7. Nominative, Non-Trademark Fair Use.

Citing Pirone, Defendant claims that the use of the names "Frank," "Sammy," "The Rat Pack" and their identities is protected by the nominative use exception. A use that merely describes the subject matter and contents of a work, rather than its source, is therefore not actionable. See Pirone, 894 F.2d at 583-84 (permitting use of Babe Ruth's photo and name). Defendant cannot effectively parody or comment on Sinatra or Davis without use of their names. See Mattel v. MCA Records, Inc., 28 F. Supp. 2d 1120, 1125 (C.D. Cal. 1998)

The purpose of a trademark is to designate the source of a product and it has no existence apart from the trade "in connection with which the mark is employed." United Drug Co. v. Theodore Rectanus Co., 248 U.S. 90, 97 (1918). A trademark is a word or symbol indicating the origin or source of a product. The owner of a mark acquires the right to prevent his goods from being confused with those of others and to prevent his own trade from being diverted to competitors through their use of misleading marks. There are no

rights in a trademark beyond these. See Indus. Rayon Corp. v. Dutchess Underwear Corp., 92 F.2d 33, 35 (2d Cir. 1937).

Whatever rights Plaintiffs may have in the names "Sinatra" or "Davis" or in photos of those individuals, Defendant's use can infringe those rights only if that use is a trademark use, that is one indicating source or origin. A trademark would not cover all photos taken of decedents during their careers, only those so closely associated with product as to have acquired distinctiveness and secondary meaning. See Pirone, 894 F.2d at 583.

The Plaintiffs have not shown that the photos of Sinatra and Davis as used in connection with Defendant's presentation of *The Rat Pack is Back!* had acquired a secondary meaning or become closely associated with a business or product. Even the registration of a famous name will not supply protection unless it has acquired distinctiveness and secondary meaning through usage. See Abraham Zion Corp., v. Lebow, 761 F.2d 93, 104 (2d Cir. 1985).

Citing New Kids, 971 F.2d at 308, Defendant asserts that any use of a mark identified with Plaintiffs was done as an integral part of what was being expressed, rather than a source identifier and that such use is a "nominative fair use" and protected. In New Kids, the Ninth Circuit held that a nominative fair use is protected when (1) "the product or service in question [is] not readily identifiable without use of the trademark"; (2) "only so much of the mark or marks [is used] as is reasonably necessary to identify the product or service"; and (3) "the user [does] nothing that would, in conjunction with the mark, suggest sponsorship or endorsement by the trademark holder." Id. Here, "The Rat Pack" is used to describe the thing, not to identify a source. Only the first names of Davis and Sinatra are used, thus limiting use to that reasonably necessary to identify the subject matter of the show. Finally, there is no suggestion of sponsorship by Plaintiffs. To the contrary, much of

the advertising makes it clear that Cassidy and Rio are the producers and that the characters who star in the show are actors.

III. CONCLUSION

Plaintiff SHEFFIELD's Amended and Supplemental Complaint and Plaintiff DAVIS' Complaint seek damages for Defendant's commercial use of Frank Sinatra and Sammy Davis, Jr.'s name, identity and persona in connection with services, which use, allege Plaintiffs, is likely to cause confusion or mistake or deceive as to the owner having endorsed, licensed, produced, sponsored or otherwise affiliated with Defendant's services. Plaintiffs' claims for damages, as distilled in response to the instant Motion for Summary Judgment, is for use of the phrase "Rat Pack" in advertising for *The Rat Pack Is Back!* show. Plaintiffs acknowledge in their Opposition that their damages are from the advertising of the show, not from the show itself.

There is no dispute that the production is a parody centered around a fictitious on-stage celebration of Frank Sinatra's birthday in 1961. The show is a commentary on the drinking, womanizing, idiosyncracies and failings of various individuals, including Plaintiffs' decedents. It is also undisputed that the term "Rat Pack" was created and first used by the press to describe various personalities including, but not limited to, Plaintiffs' decedents. There is no evidence that Plaintiffs' decedents ever referred to themselves as The Rat Pack. Plaintiffs' claims of ownership of the mark "Rat Pack" are based solely on two instances of licensing and a few offers to license. There is extensive evidence of third-party use including trademark registrations for "Rat Pack." Plaintiffs' efforts at licensing appear to be an attempt to bootstrap an ownership claim for a phrase created by third-parties and never used by Plaintiffs in association with any identifiable product. The two instances of licensing relied upon by Plaintiffs to create ownership included rights to use rare film footage, various likenesses and audio/video material.

The First Amendment and the Nevada Right of Publicity Statute protect Defendant's presentation and portrayal of Plaintiffs' decedents. Advertising for such a presentation must also be protected because without it the First Amendment right is not meaningful. Advertising and promotion of a performance protected by the First Amendment are also protected unless they contain language of false endorsement. Plaintiffs have not presented evidence of false endorsement. See Cher, 692 F.2d at 640.

Accordingly, Defendant is entitled to summary judgment on its claim that the show and its advertising are protected by the First Amendment and the Nevada Right of Publicity Statute.

Even if Defendant was not entitled to summary judgment based on the First Amendment and the Nevada Right of Publicity Statute, Plaintiffs cannot prove a trademark infringement. Plaintiffs are unable to show that they are the owners or, even if they are, that Defendant's use of the mark was likely to create confusion regarding the origin of goods or services. Plaintiffs have failed to introduce any evidence of secondary meaning or factors the Court uses to determine likelihood of confusion, requesting instead that the Court "infer" an intent to confuse. Nor have the Plaintiffs shown causation or damages except through conclusions of an expert who failed to provide factual underpinning in support of his conclusions.

Finally, Defendant's use of the term "The Rat Pack" is a nominative use, descriptive of content rather than an indicator of source and thus, not actionable.

ACCORDINGLY, Defendant's Motion for Summary Judgment or in the Alternative, Summary Adjudication (#82) is **GRANTED**.

IT IS FURTHER ORDERED that the Request for Rulings on Evidentiary Issues are disposed of as set forth in Pages 4-10 of this Order.

IT IS FURTHER ORDERED that the Clerk of the Court shall enter judgment for the Defendant

IT IS FURTHER ORDERED that all outstanding motions are **DENIED AS MOOT**.

DATED this 3rd day of October 2001.

Kent J. Dawson
United States District Judge

EXHIBIT "F"

EXHIBIT "F"

United States Patent and Trademark Office

Trademarks > Trademark Electronic Search System (TESS)

TESS was last updated on Wed Apr 1 04:08:08 EDT 2009

Logout Please logout when you are done to release system resources allocated for you.

Start List At: OR Jump to record: **Record 45 out of 113**

Typed Drawing

Word Mark	THE RAT PACK IS BACK
Goods and Services	IC 025. US 022 039. G & S: clothing, namely, hats, t-shirts, jackets, and sweatshirts. FIRST USE: 19990714. FIRST USE IN COMMERCE: 19990714
Mark Drawing Code	(1) TYPED DRAWING
Serial Number	76236758
Filing Date	April 9, 2001
Current Filing Basis	1A
Original Filing Basis	1A
Published for Opposition	March 19, 2002
Registration Number	2578115
Registration Date	June 11, 2002
Owner	(REGISTRANT) DRDC Productions, Inc. CORPORATION NEVADA 6985 South Pecos Las Vegas NEVADA 89210 (LAST LISTED OWNER) TRP ENTERTAINMENT, LLC LTD LIAB CO NEVADA 7910 BERMUDA ROAD LAS VEGAS NEVADA 89123
Assignment Recorded	ASSIGNMENT RECORDED
Attorney of Record	Michael J. McCue
Type of Mark	TRADEMARK
Register	PRINCIPAL
Affidavit Text	SECT 15. SECT 8 (6-YR).
Live/Dead Indicator	LIVE

EXHIBIT "G"

EXHIBIT "G"

For Dockets See 2:05CV00673

United States District Court, D. Nevada.
DRDC PRODUCTIONS, INC., a Nevada corporation, Plaintiff,
v.
TRP ENTERTAINMENT, LLC, a Nevada limited liability corporation, Sandy Hackett, an individual, Richard Feeney, an individual, Convention Center Drive Hotel and Casino Llc d/b/a Greek Isles Hotel and Casino, Defendants,
And Related Counterclaims
Case No. CV-S-05-0673-PMP-PAL.
June 24, 2005.

Opposition to Motion for Preliminary Injunction; Memorandum of Points and Authorities in Support Thereof

Pursuant to this Court's June 1, 2005 Order, Defendants/Counter-claimants TRP Entertainment, LLC, Sandy Hackett, and Richard Feeney (sometimes collectively referred to herein as TRP) hereby submit the following supplemental points and authorities in opposition to Plaintiff DRDC, Inc.'s (DRDC) Motion for Preliminary Injunction.[FN1] This Opposition is supported by the June 5, 2005 declaration of Sandy Hackett (Hackett Decl.), the June 5 and June 24, 2005 declarations of Michael D. Rounds (Rounds Decl.), the June 23, 2005 declaration of Matthew D. Francis (Francis Decl.), the following points and authorities, and all pleadings and papers on file herein.

FN1. For purposes of at least this Opposition, TRP's counsel also represents Defendant Convention Center Drive Hotel and Casino, LLC, and all arguments raised herein apply to this Defendant as well.

I. INTRODUCTION

TRP produces a musical stage show called The Tribute to Frank, Sammy, Joey and Dean. Hackett Decl., ¶¶ 6-7. As implied by the name, it is a musical and comedy show involving actors that recreate **Rat Pack** performances. *See* Hackett Decl., ¶¶ 6B-E. The show was introduced in Las Vegas at the Greek Isles Hotel and Casino on May 24, 2002, and has played continuously there and throughout the United States since that time. Hackett Decl., ¶¶ 6, 16. With full knowledge of these circumstances, DRDC now seeks to shut the show down, putting 40-50 people out of work, causing the breach of numerous contracts, damaging TRP to the tune of $20,000 per day, and causing other irreparable harm. Hackett Decl., ¶¶ 17-17C. There is no basis in law or fact for this request.

As to its copyright infringement claims, DRDC is not likely to succeed on the merits at trial for 4 main reasons: (1) DRDC does not have a valid certificate of registration from the Library of Congress for the script for its show The **Rat Pack** is Back, an omission that is procedurally fatal to its claim; (2) DRDC's alleged script is unoriginal; (3) TRP did not have access to DRDC's alleged script for its show and TRP independently created its own script for its show; and (4) TRP's script is not substantially similar to DRDC's alleged script.

As to its **trademark** infringement claims, DRDC is not likely to succeed on the merits at trial for 2 main reasons: (1) U.S. **Trademark** Registration No. 2640066 ('066 Reg.) is invalid and should be canceled because The **Rat Pack** is Back and the **Rat Pack** terms are unprotectable as a matter of law; and (2) TRP's descriptive or generic use of the terms the **Rat Pack** returns or the **Rat Pack** are not likely to cause confusion among the consuming public.

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In sum, DRDC has delayed a long time to file a bad case, and DRDC's Motion for Preliminary Injunction must be denied for the same (and additional) reasons that its TRO request was.[FN2]

FN2. This case was originally filed on May 17, 2005 before the Honorable James Mahan. For reasons unknown to TRP, that action was dismissed without prejudice and the present action was filed on May 31, 2005. The only difference between the lawsuits is that the present action named Richard Feeney, whom DRDC could have added to the original action under Fed. R.Civ.P. 15(a). The basis for DRDC's change of Courts therefore remains a mystery.

II. ARGUMENT

A. PRELIMINARY INJUNCTION STANDARDS

A preliminary injunction is an extraordinary remedy, which should be granted only in limited circumstances. *Miracle Blade, LLC. v. Ebrands Commerce Group, LLC.*, 207 F. Supp.2d. 1136, 1148 (D. Nev. 2002)(denying motion for preliminary injunction), quoting *Frank's GMC Truck Center, Inc. v. G.M.C.*, 847 F.2d 100, 102 (3rd Cir. 1988)(reversing preliminary injunction). This remedy should only be granted where the merits of the case clearly favor one party over the other. *Miracle Blade*, 207 F. Supp.2d at 1148, citing *Remlinger v. Nevada*, 896 F. Supp. 1012, 1015 (D. Nev. 1995)(motion denied).

A court may issue a preliminary injunction if it decides: (1) the movant will likely succeed on the merits; (2) the movant will be irreparably harmed if an injunction does not issue; (3) the balance of hardships favors the movant; and (4) the public interest favors granting relief. *Miracle Blade*, 207 F. Supp.2d at 1148, citing *Cassim v. Bowen*, 824 F.2d 791, 795 (9th Cir. 1987) (motion denied); *Great Basin Brewing Co. v. Healdsburg Brewing Co.*, 44 U.S.P.Q.2d 1751, 1752-1753 (D. Nev. 1997), citing *Int'l Jensen, Inc. v. Metrosound U.S.A. Inc.*, 4 F.3d 819, 822 (9th Cir. 1993)(motion denied). The Ninth Circuit has also adopted an alternative standard whereby a movant may meet its burden for obtaining a preliminary injunction if it demonstrates either: (1) a combination of probable success on the merits and the possibility of irreparable injury if relief is not granted; or (2) the existence of serious questions going to the merits and that the balance of hardships tips sharply in its favor. *Miracle Blade*, 207 F. Supp.2d at 1148, citing *Cassim*, 824 F.2d at 795; *Int'l Jensen*, 4 F.3d at 822. The alternative standards are not separate tests but the outer reaches of a single continuum. *Int'l Jensen*, 4 F.3d at 822 (citations omitted). Essentially, the trial court must balance the equities in the exercise of its discretion. *Id.*

Because DRDC has already failed to satisfy its significant and exigent burden with respect to the issuance of a temporary restraining order,[FN3] and similarly fails to meet its burden with respect to the issuance of a preliminary injunction, its Motion should be denied. The following arguments make this conclusion crystal clear.

FN3. At the June 6, 2005 1:30 p.m. TRO hearing, DRDC's counsel represented that he had not yet seen or been served with TRP's TRO Opposition. This is yet another DRDC mystery because DRDC's counsel was hand-delivered the Opposition at 11:30 a.m. at his offices, and his secretary signed an acceptance of service at that time.

B. DRDC IS NOT LIKELY TO SUCCEED ON ITS COPYRIGHT INFRINGEMENT CLAIMS AT TRIAL

The entire predicate for DRDC's request to shut down TRP's musical productions in Las Vegas, Detroit and San Francisco, is its copyright infringement claims. In order to establish a successful claim for copyright infringement, a plaintiff must show that: (1) it owns a valid copyright; and (2) the defendant copied protected elements of the copyright. *Swirsky v. Carey*, 376 F.3d 841, 844 (9th Cir. 2004), citing *Rice v. Fox Broadcasting Co.*, 330 F.3d 1170, 1174 (9th Cir. 2003); *Miracle Blade*, 207 F. Supp.2d at 1148-1149 (denying motion for preliminary injunction). Since direct evidence of copying is hard to obtain, a plaintiff can prove copying by showing that the defendant had access to the

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work, and the defendant's work is substantially similar to the protected elements of the copyright. *Swirsky*, 376 F.3d at 844, citing *Smith v Jackson*, 84 F.3d 1213, 1218 (9th Cir. 1996).

As a threshold matter, the only copyrighted work at issue in this case is the script for The **Rat Pack** is Back. Pl.'s Mot., p. 6. DRDC therefore cannot satisfy the first element for copyright infringement because it does not have a certificate of registration from the Library of Congress. In addition, DRDC cannot satisfy this element because its script is apparently unoriginal and any registration issued therefrom would be the subject of fraud or unclean hands. With regard to the second element of copyright infringement, DRDC cannot prove copying because TRP did not have access to DRDC's script for its show, and TRP's work is also not substantially similar to DRDC's alleged copyrighted work. Each of these dispositive issues are discussed below.

1. Because DRDC Has Not Received a Certificate of Registration for its Script, this Court Does Not Have Subject Matter Jurisdiction Over DRDC's Claims of Copyright Infringement

In order for this Court to have subject matter jurisdiction over DRDC's copyright infringement claims, DRDC must have a valid copyright registration. *Kodadek v. MTV Networks, Inc.* 152 F.3d 1209, 1211 (9th Cir.1998), citing *S.O.S. Inc. v. Payday, Inc.*, 886 F.2d 1081, 1085 (9th Cir. 1989); *Datastorm Technologies, Inc. v. Excalibur Communications, Inc.*, 888 F. Supp. 112, 114 (N.D. Cal. 1995). The statutory basis for this requirement is found in 17 U.S.C. § 41 l(a), which provides in pertinent part: [n]o action for copyright infringement in any work shall be instituted until registration of the copyright claim has been made ... This means that a party *must* have a certificate of registration at the time of filing suit, and without one the court has no jurisdiction. *Kodadek*, 152 F.3d at 1211.[FN4]

FN4. Other cases illustrating this point of law are as follows: *Whimsicality, Inc. v. Rubie's Costume Co., Inc.*, 891 F.2d 452, 453 (2nd Cir. 1989); *Haan Crafts Corp. v. Craft Masters, Inc.*, 683 F. Supp. 1234, 1242 (N.D. Ind. 1988) ([A] lawsuit for copyright infringement cannot be filed unless plaintiff has a registered copyright.... this is a jurisdictional requirement which must be satisfied before a federal court can entertain a copyright infringement claim.); *Demetriades v. Kaufmann*, 680 F.Supp. 658, 661 (S.D.N.Y. 1988) ([r]eceipt of an actual certificate of registration or denial of same is a jurisdictional requirement, and this court cannot prejudge the determination to be made by the Copyright Office.); *Dodd v. Fort Smith Special School District No. 100*, 666 F. Supp. 1278, 1282 (W.D. Ark. 1987) ([u]nder the Copyright Act ... registration of the copyright, while not a prerequisite to having a protectable interest, is a jurisdictional prerequisite to the initiation of an infringement suit in federal court.); *Quincy Cablesystems, Inc. v. Sully's Bar, Inc.*, 650 F. Supp. 838, 850 (D. Mass.1986) ([c]opyright registration under § 41 1(a) is a condition precedent to filing an infringement action.); *Conan Properties, Inc. v. Mattel, Inc.*, 601 F. Supp. 1179, 1182 (S.D.N.Y. 1984) ([w]ithout registration of the copyrights the suit is barred and absent an allegation that the copyrights have been registered the complaint is defective).

Although DRDC has supplied evidence that it has filed a copyright application, it has not provided any evidence that it has obtained a copyright registration. Pl.'s Mot., p. 12, Cassidy Decl., ¶ 23, Exhibit Q. It is important to note that the filing of a copyright application does not support a claim under the Copyright Act. *Rommel v. Laffey*, 194 F.R.D. 441, 443444 (N.D.N.Y. 2000) (dismissing copyright claim pursuant to Rule 12(b)(6) because the plaintiff had only applied for a copyright registration, but had not received it), citing *Noble v. Town Sports Int'l, Inc.*, 1998 WL 43127, * (S.D.N.Y. 1998) (dismissing copyright claim pursuant to Rule 12(b)(1)), *Nat'l Assoc. of Freelance Photographers v. Associated Press*, 1997 WL 759456, *12 (S.D.N.Y. 1997) (dismissing copyright claim pursuant to Rule 12(c)). As a result, this Court does not have subject matter jurisdiction over DRDC's claim for copyright infringement, and that claim must be immediately dismissed pursuant to Fed. R.Civ.P. 12(b)(1) or (6), or Fed. R.Civ.P. 12(c) consistent with TRP's concurrent Motion. *Archie Comic Pubs., Inc. v. DeCarlo*, 2001 WL 831250, * 1 (S.D.N.Y. 2001)(granting Rule 12(b)(1) motion to dismiss for lack of subject matter jurisdiction due to lack of copyright registration); *Rommel*, 194 F.R.D. at 443-444; *Noble*, 1998 WL 43127 at *1; *Nat'l Assoc. of Freelance Photographers*, 1997 WL 759456 at* 12.

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Even if this Court did have subject matter jurisdiction over DRDC's copyright infringement claims, however, DRDC is not likely to succeed on the merits of those claims.

2. At Best, DRDC's Script is Unoriginal

In addition to its lack of registration, DRDC's script/production was apparently copied from an earlier **Rat Pack** theatrical production created by Ronald Onesti of Onesti Entertainment in 1995. Hackett Decl., ¶ 1; 6/24/05 Rounds Decl., ¶¶ 4-5.[FN5] The show was entitled The Pack is Back and played to packed houses at Piper's Alley playhouse throughout 1996. 6/24/05 Rounds Decl. ¶ 3. At least DRDC's alleged author Don Reo attended the show on several occasions, and DRDC attempted to negotiate the rights to The Pack is Back show for Las Vegas. *Id.*, ¶ 4. When this proved unsuccessful, DRDC opened its own show under the knock-off The **Rat Pack** is Back name, and appears to have copied several portions of The Pack is Back script and show. *Id.*, ¶ 5. In light of these facts, it appears that DRDC is claiming exclusive ownership in an unoriginal work that was pirated from a third party.

FN5. As indicated in Mr. Rounds' declaration, Mr. Onesti was apparently too busy to review and sign a declaration, and TRP hopes to supplement the record with an Onesti declaration and exhibits on Monday, June 27, 2005. This is not uncommon in the exigent circumstances of a preliminary injunction setting, and the Rounds declaration itself is admissible. *See* *Dr. Seuss Enterprises LP v. Penguin Books, USA*, 924 F.Supp. 1559, 1562 (S.D. Cal. 1996).

At best, it appears DRDC's script is unoriginal and not entitled to copyright protection. *Feist v. Rural Tel. Serv. Co.*, 499 U.S. 340, 345 (holding that [t]he *sine qua non* of copyright is originality). To qualify for copyright protection, a work must be original to the authors, as opposed to copied from other works. *Id.* At worst, DRDC's actions in pirating this script and then filing a copyright application for it constitute fraud on the Copyright Office. *See generally* *S.O.S.*, 886 F.2d at 1086. In DRDC's copyright application, it does not identify its script as either a derivative work or a compilation. Motion, Exhibit Q. DRDC's actions also invoke the doctrine of unclean hands, since its copying misconduct relates directly to the right asserted by DRDC. *See* *Tiffany Design, Inc. v. Reno-Tahoe Speciality, Inc.*, 55 F. Supp.2d 1113, 1123 (D. Nev. 1999)(citations omitted). As a result, DRDC's claim for injunctive relief is stalled as a result of its apparent inequitable conduct at the outset.

3. DRDC is Not Likely to Succeed on the Merits of its Copyright Infringement Claims Because TRP Did Not Have Access to DRDC's Script For its Show and TRP Independently Created the Script for its Show

As set forth above, access is the first element DRDC must show to prove copying. *See supra.* Proof of access requires that a defendant have an opportunity to view or to copy plaintiffs work. *Three Boys Music Corp. v. Bolton*, 212 F.3d 477, 482 (9th Cir. 2000), quoting *Sid and Marty Krofft Television Prods., Inc. v. McDonald's Corp.*, 562 F2d 1157, 1172 (9th Cir. 1977). Access may not be inferred through mere speculation or conjecture. *Three Boys*, 212 F.3d at 482, quoting 4 Melville B. Nimmer & David Nimmer, Nimmer on Copyright, § 13.02[A], at 13-19 (1999).

DRDC claims that TRP infringed its copyright by copying the alleged script for The **Rat Pack** is Back. Pl.'s Mot., p. 12. Although Mr. Hackett admittedly went to see DRDC's production on two different occasions during its 3 year tenure (the performance was open to the public), and a few actors who performed in DRDC's show subsequently performed at times in TRP's show, Mr. Hackett *never* saw DRDC's script for The **Rat Pack** is Back until DRDC filed its Motion for Preliminary Injunction. Hackett Decl., ¶¶ 6C, 6F, 16. As a result, no access to the copyrighted work exists as a matter of law.

To the contrary, TRP's script was independently created by Mr. Hackett in 20012002. Mr. Hackett received sounding

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board input from original **Rat Pack** member Joey Bishop, as well as from Buddy Hackett, Mr. Feeney and certain long-time impersonators of the **Rat Pack** members. Hackett Decl., ¶ 6C-E. As a primary source of inspiration, Mr. Hackett also viewed dozens of hours of source footage of **Rat Pack** shows from the 1960's to ensure that TRP's show was true to the original performances of the **Rat Pack**. Hackett Decl., ¶ 6E.

In light of Mr. Hackett's substantial effort and due diligence in creating the TRP script, it is clear that the script was independently created. Independent creation is a complete defense to a charge of copyright infringement. *Granite Music Corp. v. United Artists Corp.*, 532 F.2d 718, 720 (9th Cir. 1976), quoting *Amstein v. Marks Corp.*, 82 F.2d 275 (2nd Cir. 1936)(holding that independent creation of a copyrighted work is not infringement and nothing short of plagiarism will serve.); *see also CMM Cable Rep. Inc. v. Keymarket Communications, Inc.*, 870 F. Supp. 631, 636 (M.D. Penn. 1994), citing *Whelan Assocs. Inc. v. Jaslow Dental Laboratory, Inc.*, 797 F.2d 1222, 1227 n. 7 (3rd Cir. 1986).

Because there was no access to the alleged copyrighted work, and TRP's script was independently created, DRDC's copyright infringement claims fail and the test for substantial similarity need not be addressed. However, if the Court is also inclined to entertain DRDC's arguments regarding substantial similarity, those arguments are easily defeated as well.

4. TRP's Script is Not Substantially Similar to DRDC's Script

As noted, the second element in proving copying is that the copyrighted work and the allegedly infringing work are substantially similar. *See supra.* In determining whether two works are substantially similar, the Ninth Circuit employs two tests: (a) the extrinsic test, and (b) the intrinsic test. *Swirsky*, 376 F.3d at 845; *Miracle Blade*, 207 F. Supp.2d at 1149. Each test is discussed below.

(a) The Extrinsic Test

The extrinsic test considers whether the two works share a similarity of ideas and expression as measured by external, objective criteria. *Swirsky*, 376 F.3d at 845, citing *Smith*, 84 F.3d at 1218.[FN6] This test requires analytical dissection of a work and expert testimony. *Swirsky*, 376 F.3d at 845, quoting *Three Boys*, 212 F.3d at 485. The analytical dissection requires that the two works be broken down into their protectable constituent elements. *Id.* Once those protectable elements are identified, they must be compared to each other to determine whether they are substantially similar. *Id.* (citation omitted). When considering the extrinsic test, the Court must consider applicable doctrines that narrow the scope of copyright protection, such as merger, scenes a faire and originality. *Miracle Blade*, 207 F. Supp.2d at 1150.

FN6. It is important to note that although the extrinsic test examines the similarity of ideas and expression, ideas by themselves are not subject to copyright protection. *Swirsky*, 376 F.3d at 845 n. 4 (citation omitted).

DRDC alleges that TRP copied the following elements from its script: (1) the setting; (2) the plot; (3) themes; (4) dialogue; (5) music; (6) mood; (7) characters; (8) sequence of events; and (9) the use of the voice of God. Pl.'s Mot., pp. 12-14. DRDC is simply incorrect, and when these elements are viewed in conjunction with the above-mentioned scope of protection doctrines, it is clear that they are not protectable.

(i) DRDC's Alleged Script is a Compilation of Facts, Entitled to Little or No Protection

There can be no dispute that DRDC's alleged copyrighted work is a collection of songs, performances and dialogue that are taken from past **Rat Pack** performances. As such, DRDC's alleged script is, at best, a compilation of preexisting facts and data entitled to a thin scope of protection. 17 U.S.C. § 101; *Feist* 499 U.S. at 348-349; *Satara v. Lowry*,

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323 F.3d 805, 811-12 (9th Cir. 2003). The only originality, if any, DRDC would be entitled to is the selection, coordination or arrangement of these pre-existing facts and data in its alleged script. *Id.*

This limited protection, if applicable, effectively destroys DRDC's infringement claims. As is evident from a viewing of the scripts, TRP's **Rat Pack** show uses a distinctly different selection, coordination and arrangement of pre-existing **Rat Pack** facts and data. Hackett Decl., ¶¶8 15-15G. Placed in the thin context it may be entitled to, there can be no case for an alleged infringement of DRDC's alleged script as a matter of law.

(ii) The Setting of DRDC's Script and the Themes of Booze, Women, Ethnicity, and Religion are Not Protectable Elements Pursuant to the *Scenes A Faire* Doctrine

There are further related reasons that render DRDC's alleged script unprotectable or entitled to thin protection. Under the *scenes afaire* doctrine, when certain commonplace expressions are indispensable and naturally associated with the treatment of a given idea, those expressions are treated like ideas and therefore not protected by copyright. Swirsky, 376 F.3d at 850 (citation omitted). What this means is that when certain elements are standard treatment for a particular idea, they are not protectable. *Id.* With regard to the setting for TRP's musical production, TRP admits that the setting takes place in the 1960's in a Las Vegas casino. Pl.'s Mot., p. 13, Cassidy Decl., ¶ 25. This setting is standard treatment for a show based on the **Rat Pack**, since that is the setting and that is the time period when they actually performed. As a result, the setting falls within the *scenes afaire* doctrine and is unprotectable.

Similarly, the themes of booze, women, ethnicity and religion were the exact themes utilized by the **Rat Pack** in the 1950's and 1960's, and were the essence of the **Rat Pack**. Hackett Decl., ¶ 15B. As a result, these themes and expressions are not protectable under the *scenes a faire* doctrine. Finally, since the mood, and the cast of characters - to the extent they are impersonations of the original members of the **Rat Pack** - are also elements that are standard for a **Rat Pack** the med show, they are unprotectable as well.

(iii) The Remaining Elements Are Either Unprotectable or Not Substantially Similar

The other elements of DRDC's alleged script - to the extent they contain any originality - also cannot survive the extrinsic test for substantial similarity. As to the point concerning setting and plot, it is evident from Mr. Cassidy's own comments that the two shows are substantially different. Hackett Decl., ¶ 15A. DRDC's production uses a theme of Frank Sinatra's birthday party - TRP's production does not. Hackett Decl., ¶ 15B. TRP's show has a Marilyn Monroe character who sings Happy Birthday to a member of the audience - the DRDC's production does not even have a Marilyn Monroe character. *Id.*

DRDC has reduced the dialogue comparison to 3 jokes to show substantial similarity, even though there is a substantial amount of other dialogue in TRP's production. The Martini Joke is a joke that was conceived by Rick Michel who performed the joke prior to the DRDC's production and gave TRP consent to use it. Hackett Decl., ¶ 15C. The Flaming Pansy Joke is a take-off of a homosexual joke, i.e. how do you make a fruit cordial that was often performed by the **Rat Pack**. *Id.* The punch line that TRP uses for that joke is different. *Id.* The concept was an original creation of the **Rat Pack** and is not protectable by DRDC. *Id.* Finally, the Dentist Joke is a joke that was created by Sandy Hackett's father, Buddy Hackett, and TRP (if anyone) has the exclusive right to use it. *Id.* Because of their unoriginality to DRDC, and the vast amount of other dialogue and jokes in the script, none of these elements can be used to prove copyright infringement or support the preliminary injunction that DRDC proposes.

The music in both shows is primarily **Rat Pack** era music, with the various selections in either production taken from 3 **Rat Pack** era CD's. Hackett Decl., ¶ 15D. DRDC does not have any exclusive rights to use the songs, and they are performed daily around the world. Hackett Decl., ¶ 15D. TRP's musical production also includes some additional

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songs not included in DRDC's musical production, to-wit: New York, New York; My Way; and Come Fly with Me. *Id.* In addition, the sequence of the songs is entirely different. *Compare,* Hackett Decl., Exhibit 4, with Cassidy Decl., Exhibit Q. There is therefore no case for copyright infringement in the musical aspects of the show, and it is absurd for DRDC to propose that TRP be limited to only 3 of DRDC's **Rat Pack** songs in its proposed preliminary injunction.

The rest of DRDC's elements are easily dismissed as well. The fact that there are monologues, mixed duets, solos and ensembles is standard **Rat Pack** fare, and the sequence of events and how those are put together are substantially different. Hackett Decl., ¶ 15E. DRDC also claims that the use of the voice of God was copied. Pl.'s Mot., p. 13. However, DRDC uses the voice of God in a gambler joke at the end of the show, and TRP uses the voice of God in the introduction. The inspiration for using the voice of God came from the idea of the deceased **Rat Pack** members being (hopefully) in heaven, not DRDC's show. Hackett Decl., § 15F. TRP did not copy this idea or expression, nor is it protectable as a general concept.

In short, the extrinsic test shows that the elements of DRDC's script are not protectable and they are not substantially similar to those of TRP's script.

(b) The Intrinsic Test

Like the extrinsic test, the intrinsic test does not support a substantial similarity finding. The intrinsic test is a subjective one that evaluates, from the standpoint of an ordinary consumer, whether there is substantial similarity in the total concept and feel of the works. *Miracle Blade,* 207 F. Supp.2d at 1151. While the script is the alleged copyrighted work at issue, it is useful to gauge the substantial differences in the total concept and feel of the works by reviewing the actual productions as well. *Id.* A copy of each of the productions is therefore provided to the Court with the filing of this Opposition, and they are substantially different. Hackett Decl., Exhibit 8.[FN7]

FN7. TRP understood at the TRO hearing that at least one copy of the DVD's attached to Exhibit 8 did not operate properly. TRP apologizes for this inconvenience and has attached 2 new DVD's for the Court's and counsel's review.

DRDC attempts to rely upon the purported hearsay statements of a few news reports to prove substantial similarity under the intrinsic test Motion, Exhibit R. These articles on their face do not support the inference that DRDC attempts to draw, and instead only serve to narrow the scope of the alleged copyrighted work. *Id.* Moreover, the vast majority of news articles concerning TRP's show identify it as an excellent and unique tribute. Francis Decl., Exhibit 12. In short, any media evidence, to the extent relevant, does not prove copying under the intrinsic test.[FN8]

FN8. DRDC's representation concerning delay at the TRO hearing cut directly against the grain of Exhibit R. The June 12, 2002 Review Journal article was written at a time when DRDC claims the show was *not* substantially similar. DRDC now claims that the show changed when Mr. Cassidy allegedly reviewed excerpts in early, 2005, and that these changes prompted the present action. This highlights the lack of credibility in DRDC's arguments concerning substantial similarity.

For all the above reasons, when placed in proper context, there is no basis for infringement under the intrinsic test either. The two shows are substantially different period. DRDC has no claim for copyright infringement.

C. DRDC IS NOT LIKELY TO SUCCEED ON ITS **TRADEMARK**[FN9] INFRINGEMENT CLAIMS AT TRIAL

FN9. This is a service mark case since The **Rat Pack** is Back registration at issue - the '066 Reg. - and the term the **Rat Pack** are used in conjunction with the sale of services. Notwithstanding this fact, the law for

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both **trademark** and service mark infringement is the same, and the terms **trademark** and service mark may be used interchangeably throughout this Opposition. *American Int'l Group, Inc. v. American Int'l Bank*, 926 F.2d 829, 830 (9 Cir. 1991), citing 15 U.S.C. § 1053.

1. DRDC Does Not Have a Protectable **Trademark** in Either the Phrase The **Rat Pack** is Back, or the **Rat Pack**

The first issue in an action for **trademark** infringement is whether the words and designs used by the plaintiff are entitled to protection. *Transgo, Inc. v. AJAC Transmission Parts, Corp.*, 768 F.2d 1001, 1014 (9th Cir. 1985). Once this first step is established, the next step in a **trademark** infringement analysis is to determine whether the defendant's use of a given mark in conjunction with its sale of goods or services is likely to confuse the public as to the source, affiliation, connection, or sponsorship of the goods or services in question. *American Circuit Breaker Corp. v. Oregon Breakers Inc.*, 406 F.3d 577, 584 (9th Cir. 2005), citing *Brookfield Communications, Inc. v. West Coast Entertainment Corp.*, 174 F.3d 1036, 1046 n.6 (9th Cir. 1999) (citation omitted). As set forth below, the '066 Reg. is invalid and should be canceled, and the term the **Rat Pack** is generic. *See infra.* As such, DRDC cannot satisfy the protectable mark element of the **trademark** infringement test. However, even if these terms were protectable, no likelihood of confusion exists, as set forth in detail below.

(a) Since the '066 Reg. Is Invalid and Should be Canceled Pursuant to 15 U.S.C. § 1119, DRDC Should Not Be Allowed to Enforce that Registration Against TRP

(i) 15 U.S.C. § 1119 and Applicable Case Law Support Cancellation of the '066 Reg.

15 U.S.C. § 1119 empowers district courts to determine the rights related to **trademark** registrations, including the right to register a mark, order cancellation of registrations, and the right to rectify the register with respect to the registration of any party to an action. *Id.*, *Dymo Indus., Inc. v. Tapeprinter Inc.*, 326 F.2d 141, 143 (9th Cir. 1964); *Caesars World, Inc. v. Milanian*, 247 F. Supp.2d 1171, 1206 (D. Nev. 2003); *Levi Strauss & Co. v. GTFM Inc.*, 196 F. Supp.2d 971, 975 (N.D. Cal. 2002); *Sykes Laboratory, Inc. v. Kalvin*, 610 F. Supp. 849, 863 (C.D. Cal. 1985); 5 J.T. McCarthy, McCarthy on **Trademarks** and Unfair Competition (McCarthy), §§ 30:109-111, pp. 30-210-213 (4th ed. 2005). This statutory authority grants district courts the power to decide all matters related to **trademark** registrations, including the validity of the given registration. *Dymo*, 326 F.2d at 143, *Am. Bakeries Co. v. Pan-O-Gold Baking Co.*, 650 F. Supp. 563, 567 (D. Minn. 1986), citing *Sonora Cosmetics, Inc. v. Loreal S.A.*, 631 F. Supp. 626, 629 (S.D.N.Y. 1986)(holding that questions regarding the validity of a **trademark** registration are within the competence of the district court). Because the '066 Reg. does not function as a service mark, that Registration should be invalidated and canceled.[FN10]

FN10. TRP has not filed a petition to cancel the '066 Reg. in the **Trademark** Trial and Appeal Board because this Court can decide all of the issues the TTAB can pursuant to 15 U.S.C. § 1119. *See Supra.*

In order for a service mark to be entitled to registration, it must identify and distinguish the applicant's services from those of others and to indicate their source. *See* 15 U.S.C. §§ 1051, 1052, 1053 and 1127; TMEP §1301.02(d). Words or phrases that are the title of a single book or program such as live musical and theatrical performance are not entitled to registration. *See Herbko Intl', Inc. v. Kappa Books, Inc.*, 308 F.3d 1156, 1162 (Fed. Cir. 2002), citing *In re Cooper*, 254 F.2d 611, 615-616 (C.C.P.A. 1958); *In re Posthuma*, 45 U.S.P.Q.2d 2011, 2013-2014 (T.T.A.B. 1998)(holding that a term that identifies title of a play not registerable as service mark for entertainment services); *In re Scholastic Inc.*, 223 U.S.P.Q. 431-432 (T.T.A.B. 1984). The United States Patent and **Trademark** Office (PTO) treats titles of single works as generic and not registerable even upon a showing of secondary meaning. *Herbko*, 308 F.3d at 1164 (citation omitted). Notwithstanding the foregoing, the title of a series of books, plays or other such programs can be entitled to registration on the principal register. *In re Cooper*, 254 F.2d at 615-616.

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Given that DRDC's alleged service mark - The **Rat Pack** is Back - is the title of a single work and not a series, the phrase does not function as a mark. *See supra.* As such, it should be canceled and DRDC's 15 U.S.C. § 1114 causes of action should be dismissed with prejudice.

TRP anticipates that DRDC will argue that the '066 Reg. is presumed valid and should not be canceled. However, a review of the '066 file history reveals that the '066 Reg. should not have been registered in the first place, and either examiner error or malfeasance on the part of DRDC contributed to its registration. A synopsis of the file history appears below.

(ii) The '066 File History Supports Cancellation of the '066 Reg.

On May 17, 1999, DRDC filed an intent to use application for The **Rat Pack** is Pack in international class 41 for entertainment services and on September 17, 1999, submitted an Amendment to Allege Use with a specimen. Francis Decl., ¶ 3, Exhibit 11. On October 29, 1999, the PTO mailed its first office action. *Id.* In that office action, the examining attorney cited the *Cooper, Scholastic,* and *Posthuma* cases and refused registration for the mark to the Principal Register since it was the title of a single creative work. *Id.*

On January 3, 2000, the examiner responded to DRDC's May 17, 1999 Amendment to Allege Use, refusing to accept the specimen because it only showed the use of the **Rat Pack** is Back as the name of a single live musical production. *Id.* The examining attorney again cited *Cooper, Scholastic,* and *Posthuma. Id.* On May 3, 2000, DRDC responded to the office action, stating that the mark is to be used to identify the source of a continuously changing and evolving musical production as well as to identify the source of multiple productions. *Id.* In a June 9, 2000 final office action, the examining attorney refused to accept DRDC's arguments and again refused registration on the basis that the mark was the title of a single work. *Id.*

On June 30, 2000, DRDC responded to the examiner's final action, stating that it did not have a specimen proving that the mark identified a series, rather than a single work. *Id.* As a result, DRDC withdrew its Amendment to Allege Use, until such time in the near future when Applicant [DRDC] is able to provide evidence for the record necessary for the Examiner to approve an Amendment to Allege Use. *Id.* Even though DRDC did not have an adequate specimen, it submitted another specimen for the record. *Id.*

On August 23, 2000, the examining attorney issued a No Call Examiner's Amendment based on a telephone conversation the examiner had with DRDC's counsel. *Id.* In this document, the Applicant [DRDC] agreed to withdraw its Amendment to Allege Use filed on September 29, 1999, and in exchange, the Examiner withdrew her final June 9, 2000 office action. *Id.*

Even though DRDC never proved that The **Rat Pack** is Back was the title of a series as opposed to the name of a single work, the application was somehow published for opposition on October 31, 2000, and the application matured into a Notice of Allowance on January 23, 2001. *Id.* Thereafter, DRDC's attorney failed to submit a Statement of Use and the application went abandoned. *Id.* After reviving the application, and after obtaining an extension of time to file a statement of use, DRDC filed a Statement of Use on November 7, 2001 with a specimen. *Id.* However, the specimen did not show that the **Rat Pack** is Back was the name of a series. *Id.*

Simply put, this application either fell through the cracks and the examining attorney erred in accepting the statement of use that did not prove that The **Rat Pack** is Back is a series, or DRDC committed some act of malfeasance in the PTO that led to the issuance of the '066 Reg. The bottom line is that DRDC never proved that the The **Rat Pack** is Back mark functions as a service mark with respect to entertainment services because it is a series, not the title of a single work. As such, the '066 Reg. is unprotectable and should be immediately invalidated and canceled.

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(b) Without its Federal Registration to Shield it, the Phrase The **Rat Pack** is Back is Not Entitled to Protection

The Ninth Circuit recognizes 4 different categories of terms that may be subject to **trademark** protection. *Filipino Yellow Pages, Inc. v. Asian Journal Pubs. Inc.*, 198 F.3d 1143, 1146 (9th Cir. 1999). These categories are (a) generic, (b) descriptive, (c) suggestive, and (d) arbitrary or fanciful. *Id.* (citations omitted). Arbitrary, fanciful, and suggestive marks are inherently distinctive and are therefore protected upon adoption and use. *Official Airline Guides, Inc. v. Goss*, 6 F.3d 1385, 1390 (9th Cir. 1993). To the contrary, descriptive marks are only protected upon a showing of secondary meaning. *Filipino Yellow Pages*, 198 F.3d at 1151. Generic marks are not entitled to protection at all. *Id.*, 198 F.3d at 1147; *Surfvivor Media, Inc. v. Survivor Productions*, 406 F.3d 625, 632 (9th Cir. 2005).

While the term **Rat Pack** is generic (*see infra.*), TRP will assume solely for purposes of argument here that The **Rat Pack** is Back is a descriptive mark. The phrase clearly describes the particular class of entertainment services being offered by DRDC - i.e., **Rat Pack** era music and entertainment. *See Narwood Productions, Inc. v. Lexington Broadcast Servs. Co., Inc.*, 541 F. Supp. 1243, 1248 (S.D.N.Y. 1982). Since this phrase is at best descriptive, it requires proof of secondary meaning for it to acquire distinctiveness and be protected as a **trademark** or service mark. *See supra.* Because there is no probative evidence of secondary meaning, the phrase cannot be protected.

A descriptive **trademark** has achieved secondary meaning when there is a mental recognition in buyers' and potential buyers' minds that products connected with the [mark] are associated with the same source. *Levi Strauss & Co. v. Blue Bell, Inc.*, 632 F.2d 817, 820 (9th Cir. 1980). Secondary meaning can be established by the following types of evidence: direct consumer testimony; survey evidence; exclusivity, manner, and length of use of a mark; amount and manner of advertising; amount of sales and number of customers; established place in the market; and proof of intentional copying by the defendant. *Filipino Yellow Pages*, 198 F.3d at 1151 (citation omitted); *see also Levi Strauss*, 632 F.2d at 82021.

The only evidence DRDC offers in support of any of these factors is that DRDC owns two federal registrations for The **Rat Pack** is Back(the '066 for entertainment and U.S. **Trademark** Registration No. 2578115 for clothing) and that it has spent hundreds of thousands of dollars in connection with enforcement and protection of 'The **Rat Pack** is Back' mark. Cassidy Decl., ¶ 3.[FN11] Even if the alleged expenditures are true - which TRP seriously doubts - Mr. Cassidy's declaration offers little probative value, and the alleged enforcement and protection is not enough to prove the phrase has achieved secondary meaning. *Filipino Yellow Pages*, 198 F.3d at 1152 (holding that [e]vidence of secondary meaning from a partial source possesses very limited probative value), citing *Norm Thompson Outfitters, Inc. v. GM Corp.*, 448 F.2d 1293, 1297 (9th Cir. 1971)(same), and *In re Redken Labs, Inc.*, 170 U.S.P.Q. 526, 529 (T.T.A.B. 1971). When these facts and law are combined with the fact that DRDC's show has only operated sporadically since 2002, it is clear that the descriptive term The **Rat Pack** is Back has not acquired distinctiveness via secondary meaning. As such, the phrase is unprotectable, and DRDC should not be allowed to enforce it against TRP.

FN11. It is important to note that DRDC does not indicate how much it has spent enforcing the alleged mark with regard to clothing and with regard to entertainment.

(c) The Term **Rat Pack** is Generic and Therefore Unprotectable

A generic term is one that refers to the genus of which the particular product or service is a species, and it cannot become a **trademark** under any circumstance. *Filipino Yellow Pages*, 198 F.3d at 1147 (citations omitted). Basically, a generic term is the name of product or service, and as such, it is the antithesis of a mark. *Id.* A common test used in determining whether relevant consumers use the mark at issue in a generic sense is the who are you/what are you test. *Id.* A **trademark** answers the buyer's questions who are you, while a generic name answers the question what are you. *Filipino Yellow Pages*, 198 F.3d at 1 147 (citations omitted). When determining whether a mark is generic, the Ninth

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Circuit takes a holistic approach, and therefore analyzes the mark as a whole as opposed to its individual components separately. *Filipino Yellow Pages*, 198 F.3d at 1150. In cases involving unregistered marks, the plaintiff has the burden of proving non-genericness once the defendant asserts genericness as a defense. *Id.*, 198 F.3d at 1146. Plaintiff cannot meet its burden.

TRP submits that the relevant consumers in this case are attendees or potential attendees of the parties' respective shows, in most cases members of the baby b??oomer generation that grew up watching the Frank Sinatra, Sammy Davis Jr., Dean Martin, and Joey Bishop, i.e., the **Rat Pack**. The term **Rat Pack** is a media-generated term that has been used to refer to these individuals since the 1960's, and it is used by third parties everywhere to refer to these people. Hackett Decl., ¶ 2A; 6/5/05 Rounds Decl., ¶3-3Y, Exhibit 9; Francis Decl., ¶ 2, Exhibits 10 and 12. The term has been used for movies, books, restaurants, golf tournaments, websites, and numerous other products or services to connote one thing - the original members of the **Rat Pack**. *Id.* Placed in the proper context then, DRDC can lay no claim to this generic term and as such, DRDC has no **trademark** claim against TRP for any use of the term.

2. DRDC Cannot Prove that TRP's Use of The **Rat Pack** Returns, The **Rat Pack**, or any Other Variation Thereof is Likely to Cause Confusion Among the Consuming Public

The central inquiry of a **trademark** infringement claim is whether the similarity of the marks is likely to confuse consumers about the source of the goods or services. *Official Airline Guides*, 6 F.3d at 1391. The Ninth Circuit has identified eight factors which are relevant to the determination of likelihood of confusion:
(1) Strength of the plaintiffs mark;
(2) Proximity of the goods offered;
(3) Similarity of the marks;
(4) Evidence of actual confusion;
(5) Similarity of marketing channels;
(6) Similarity of the type of goods and purchaser care;
(7) Defendant's intent in adopting the infringing mark; and
(8) The likelihood of expansion of defendant's product line.

Surfvivor, 406 F.3d at 631, citing *AMF, Inc. v. Sleekcraft Boats*, 599 F.2d 341, 348-49 (9th Cir. 1979); *see also Century 21 Real Estate Corp. v. Sandlin*, 846 F.2d 1175, 1179 (9th Cir. 1988); When these factors are applied to the **trademarks** at issue, it is clear that DRDC is not likely to prevail on the merits of its federal **trademark** infringement claims.

(a) Strength Of The Marks

As set forth above, neither the phrase The **Rat Pack** is Back, nor the term **Rat Pack** can be protected as **trademarks** or service marks. *See supra.* However, even if the phrase **Rat Pack** is Back was protectable, it would be the feeblest of descriptive marks -in the words of one court, 'perilously close to the generic line.' *Filipino Yellow Pages*, 198 F.3d at 1151, quoting *Computerland Corp. v. Microland Computer Corp.*, 586 F. Supp. 22, 25 (N.D. Cal. 1984). Third-party use further weakens this highly descriptive mark.[FN12]

FN12. Not only does third party use weaken DRDC's alleged mark The **Rat Pack** is Back, but DRDC's direct copying of Onesti Entertainment's The Pack is Back mark smacks of unclean hands as well.

Evidence of third party use of similar marks on similar goods is admissible and relevant to show that the mark is relatively weak and entitled to only a narrow scope of protection. 2 McCarthy, § 11:88, pp. 11-167-168. The purpose of a defendant introducing third party uses is to show that customers have become so conditioned by a plethora of such

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similar marks that customers 'have been educated to distinguish between different [such] marks on the basis of minute distinctions. 2 McCarthy, § 11:88, p. 11-168. To put it another way, third party registrations and use are relevant to prove that some segment of the composite marks which both contesting parties use has a normally understood and well-recognized descriptive or suggestive meaning, leading to the conclusion that the segment is relatively weak. *Petro Stopping Centers, L.P. v. James River Petroleum, Inc.* 130 F.3d 88, 94 (4th Cir. 1997) citing *First Sav. Bank, F.S.B. v. First Bank Sys., Inc.*, 101 F.3d 645, 654 (10th Cir.1996).

As set forth in Exhibit 2 to the Hackett Decl., Exhibit 9 to the 6/5/05 Rounds Decl., Exhibits 10 and 13 to the Francis Decl., and even Exhibit R to the Cassidy Decl., numerous different parties are using terms or phrases containing the term **Rat Pack**. Hackett Decl., ¶ 2B, Exhibit 2; 6/5/05 Rounds Decl., ¶¶ 3-3Y, Exhibit 9; Francis Decl., ¶¶ 2, 4, Exhibits 10 and 13; Cassidy Decl., ¶ 26, Exhibit R; *see also* Francis Decl., Exhibit 12. This supports Mr. Hackett's statements that there have been hundreds of different **Rat Pack** shows in the United States involving **Rat Pack** performances. Hackett Decl., ¶ 2B. This indicates the obvious, i.e. that **Rat Pack** has a commonly understood and well-recognized descriptive meaning which does not support anything beyond a narrow scope of **trademark** protection. As such, a descriptive statement that the **Rat Pack** returns or the use of ratpackvegas.com can in no way generate confusion with DRDC's generic or narrowly protected phrase The **Rat Pack** is Back. This factor does not support a likelihood of confusion finding.

(b) Proximity Of The Goods Offered

Both DRDC and TRP offer live musical theatrical productions. It is believed that DRDC has held performances in Connecticut and Indiana during the last couple of years, while TRP's shows have been in Las Vegas and elsewhere. TRP does not seriously contest this minor point, other than to point out that DRDC's show has had very little activity recently.

(c) Similarity Of The Marks

DRDC claims that TRP infringes its marks by using the phrases and terms The **Rat Pack** Returns, **Rat Pack** and **Rat Pack** Vegas. DRDC is wrong.

With regard to the phrase The **Rat Pack** Returns, TRP uses this phrase only in a descriptive sense, and not as a mark for the show. Hackett Decl., ¶ 10. A simple comparison of this descriptive use to DRDC's advertising demonstrates that there is no likelihood of confusion - that is the end of the inquiry. *KP Permanent Make Up, Inc. v. Lasting Impression I, Inc.*, 408 F.3d 596, 608 (9th Cir. 2005).

Moreover, under the common law fair use defense, codified in 15 U.S.C. § 1 15(b), a junior user is always entitled to use a descriptive term in good faith in its primary, descriptive sense other than as a **trademark**. *Brother Records, Inc. v. Jardine* 318 F.3d 900, 905-906 (9th Cir. 2003)(citation omitted); *see also Cairns v. Franklin Mint Co.*, 292 F.3d 1139, 1150 (9th Cir. 2002). To establish this fair use defense, a defendant must prove the following 3 elements: (1) defendant's use of the term is not as a **trademark** or service mark; (2) defendant uses the term fairly and in good faith; and (3) defendant uses the term only to describe its goods or services. *Cairns* 292 F.3d at 1151. The Court may consider other facts as well. *KP Permanent*, 408 F.3d at 608. Again, TRP is not using the The **Rat Pack** Returns, or any other **Rat Pack** term as a **trademark** or a service mark. TRP simply uses the term in good faith to tell the would be customer that the **Rat Pack** is returning to perform again after an absence from the stage. Also, it is undisputed that TRP is only using these terms to describe its own show, not DRDC's defunct production, and the other likelihood of confusion factors weigh heavily against infringement. In light of these facts, it is clear that the classic fair use defense controls, and TRP's use of The **Rat Pack** Returns does not violate any **trademark** right of DRDC.

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As to the use of the generic term **Rat Pack**, not only does DRDC not have a registration for this term, the term has been used to refer to a particular music and era for more than 40 years. Hackett Decl, ¶¶ 2A-2B. If anyone has a right to use the term, it would be Defendant Sandy Hackett who received a license directly from Joey Bishop, one of the **Rat Pack** members. Hackett Decl., ¶ 6F, Exhibit 5.

As to the use of the ratpackvegas.com domain name, due to the non-existent or narrow scope of protection afforded DRDC's alleged mark The **Rat Pack** is Back, the domain name use is simply different. A consumer would not possibly believe these names are similar when the term **Rat Pack** has been used generically for 40 years, and there are third parties throughout the United States using derivative variations.

(d) Evidence Of Actual Confusion

DRDC has admitted that it has no evidence of actual confusion. Although it is not absolutely necessary to have actual confusion to establish a likelihood of confusion, it is an element in TRP's favor. Moreover, DRDC's lack of actual confusion evidence is particularly noteworthy because it highlights the crowded marketplace and the inherent weakness of DRDC's alleged marks.

(e) Marketing Channels

It is believed that DRDC and TRP utilize similar marketing channels to advertise their respective shows. However, they have always operated in different cities at any one time, which decreases the likelihood of any confusion.

(f) Types Of Goods And Customer Care

Unlike a trip to a movie, and in-part due to the increasing price of show tickets, consumers generally exercise a significant degree of care before purchasing tickets of a theatrical musical production. This decision is likely to involve visits to web sites, reading reviews, and considering recommendations from friends. Due to the high degree of customer care and advance preparation, it is unlikely that any confusion would result. *Sally Beauty Co., Inc. v. Beautyco, Inc.*, 304 F.3d 964, 975 (10th Cir. 2002), citing *Heartsprings, Inc. v. Heartspring, Inc.*, 143 F.3d 550, 557 (10th Cir. 1998). This factor therefore favors TRP.

(g) Defendant's Intent In Selecting the Marks

Given the general use of the term **Rat Pack**, and the massive third party use in existence, there is no credible argument that TRP has attempted to trade upon the goodwill of the alleged The **Rat Pack** is Back mark. Instead, TRP has gone out of its way not to tread on DRDC's purported rights in that alleged mark. TRP specifically changed its billboard, taxi cab and magazine advertisements in 2002 so as to avoid DRDC's claims, and its present use is purely a descriptive one. Hackett Decl., ¶ 8. In short, TRP did not select any mark to cause confusion, and has only sought in good faith to avoid DRDC's overreaching claims.

(h) The Likelihood Of Expansion Of Defendant's Operations

DRDC has conceded that the likelihood of expansion factor is irrelevant under the instant circumstances.

Based on the above factors, and DRDC's non-existent or feeble marks, DRDC is unlikely to succeed on the merits at trial on its **trademark** infringement allegations.[FN13]

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FN13. In fact, DRDC's ownership claims to the **Rat Pack** term is itself an act of unfair competition, subject to TRP's counterclaims. Further, these unfounded and illegal claims invoke the doctrine of unclean hands, which should bar DRDC's request for injunctive relief. *See* *Fuddruckers, Inc. v. Doc's B.R. Others, Inc.*, 826 F.2d 837, 847 (9th Cir. 1987).

D. DRDC WILL NOT SUFFER ANY IRREPARABLE HARM WITHOUT INJUNCTIVE RELIEF.

Again, TRP's musical production has been showing in Las Vegas since May 24, 2002. After all this time, DRDC now seeks a preliminary injunction claiming that it will be irreparably harmed in the absence of one. It has not articulated any specific irreparable harm, but instead relies on a presumption of irreparable harm that goes along with a showing of a **trademark** or copyright infringement. As pointed out by TRP above, there is no likelihood of a copyright or **trademark** infringement finding, and thus no presumption of irreparable harm. Further, DRDC's substantial delay evidences an absence of the kind of irreparable harm required to support a preliminary injunction. *See* *Seiko Kabushiki Kaisha v. Swiss Watch Intern., Inc.* 188 F.Supp.2d 1350, 1351 (S.D.Fla. 2002). DRDC's delay in seeking injunctive relief is a clear indication that DRDC has no valid argument for irreparable harm, and the sporadic performance of its show recently also belies any notion of it.

E. THE BALANCE OF HARDSHIPS FAVORS TRP AND SUPPORTS THE DENIAL OF DRDC'S MOTION.

If the injunctive relief requested by DRDC was granted, TRP would incur enormous hardship and financial loss. Hackett Decl., ¶ 17. In Las Vegas alone, TRP and the Greek Isles would have to lay off 40-50 employees. Hackett Decl., ¶ 17A. TRP would lose approximately $20,000 per week in profits and the Greek Isles would lose substantial gaming revenue. *Id.* Moreover, if the Detroit show were canceled now that all of the contracts are in place, TRP would lose up to $250,000 in profits and be subject to numerous breach of contract claims. Hackett Decl., ¶ 17B. Similar harm would occur in San Francisco. Hackett Decl., ¶ 17C. Although there is no basis to discuss a bond given DRDC's poor showing, DRDC would need to post a bond in the amount of least one million dollars ($1,000,000.00) to cover the Defendants' potential losses.

F. PUBLIC INTEREST FAVORS DENIAL.

There is no public interest in rewarding DRDC with its poor showing and this factor favors denial of its Motion.

III. CONCLUSION

For all of the above reasons, DRDC's Motion for Preliminary Injunction must be denied.

Appendix not available.

DRDC PRODUCTIONS, INC., a Nevada corporation, Plaintiff, v. TRP ENTERTAINMENT, LLC, a Nevada limited liability corporation, Sandy Hackett, an individual, Richard Feeney, an individual, Convention Center Drive Hotel and Casino Llc d/b/a Greek Isles Hotel and Casino, Defendants, And Related Counterclaims
2005 WL 3780975 (D.Nev.) (Trial Motion, Memorandum and Affidavit)

END OF DOCUMENT

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EXHIBIT "H"

EXHIBIT "H"

For Dockets See 2:05CV00673

United States District Court, D. Nevada.
DRDC PRODUCTION, INC., a Nevada corporation, Plaintiff,
v.
TRP ENTERTAINMENT LLC, a Nevada limited liability corporation; Sandy Hackett, an individual; Richard Feeney, an individual; Convention Center Drive Hotel and Casino LLC dba Greek Isles Hotel and Casino, Defendants.
Case No. CV-S-05-0673-PMP-PAL.
July 8, 2005.

Jury Demand

First Amended Complaint

For its complaint, DRDC Production, Inc. alleges as follows:

NATURE OF THE CASE

This is an action by Plaintiff DRDC Production, Inc. (DRDC), the producer of the show THE **RAT PACK** IS BACK, against Defendants TRP Entertainment LLC, Sandy Hackett, Richard Feeney and Convention Center Drive Hotel & Casino, LLC dba Greek Isles Hotel, for **trademark** infringement, cybersquatting, unfair competition, and copyright infringement based on, among other things, Defendants' use of THE **RAT PACK** RETURNS, **RAT PACK** VEGAS marks and other confusingly similar marks, and Defendants' infringement of DRDC's copyright in THE **RAT PACK** IS BACK show.

JURISDICTION AND VENUE

1. This Court has subject matter jurisdiction over this action undor 28 U.S.C. §§ 1331 and 1338(a) & (b).

2. This Court has personal jurisdiction over Defendant TRP Entertainment LLC, because it is a Nevada limited liability company and it regularly conducts business in this judicial district.

3. This Court has personal jurisdiction over Defendant Sandy Hackett because he resides in this judicial district.

4. This Court has personal jurisdiction over Defendant Richard Feeney because he resides in this judicial district.

5. This Court has personal jurisdiction over Defendant Convention Center Drive Hotel & Casino dba Greek Isles Hotel & Casino (Greek Isles), because it is a Nevada limited liability company and it regularly conducts business in this judicial district.

FACTUAL ALLEGATIONS

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6. DRDC wrote and produces a musical stage show known as THE **RAT PACK** IS BACK. The **RAT PACK** IS BACK is the brainchild of Don Reo and David Cassidy. The show is a song, dance and comedy tribute to the era of early 1960s Las Vegas. The show is about Frank, Sammy, Dean and Joey performing on stage as they celebrate Frank's birthday.

7. Defendant Sandy Hackett applied to play Joey in DRDC's show. DRDC rejected Hackett's proposal. Upon information and belief, Hackett then decided to create a competing show and to do so by copying DRDC's intellectual property in THE **RAT PACK** IS BACK show.

8. THE **RAT PACK** IS BACK show debuted at the Desert Inn resort hotel and casino in Las Vegas, Nevada, in July 1999. THE **RAT PACK** IS BACK show received rave reviews from local and national media.

9. On May 17, 1999, DRDC filed a federal **trademark** application with the United States Patent and **Trademark** Office (USPTO) for THE **RAT PACK** IS BACK for entertainment services, namely, live stage musical productions. The application matured into a registration on October 22, 2002. As a result, DRDC owns the exclusive rights to use THE **RAT PACK** IS BACK in connection with entertainment services. DRDC also owns a federal **trademark** registration for THE **RAT PACK** IS BACK for clothing.

10. DRDC is entitled to an injunction against others who use THE FAT PACK IS BACK mark or confusingly similar marks in connection with the same or related types of goods or services.

11. Since 1998, DRDC has spent hundreds of thousands of dollars in connection with enforcement and protection of THE **RAT PACK** IS BACK mark.

12. In September 1999, Sheffield Enterprises (a licensing entity owned by Frank Sinatra's children) filed suit against the Sheraton Desert Inn alleging that, among other things, the use of THE **RAT PACK** IS BACK mark in connection with DRDC's show infringed Sheffield's alleged rights in the **RAT PACK** mark and Frank Sinatra's persona. Sheffield did not prevail in this action.

13. THE **RAT PACK** IS BACK show moved to the Sahara hotel and casino in 2000.

14. Samples of advertisements for THE **RAT PACK** IS BACK show include the following:

15. In April 2002, THE **RAT PACK** IS BACK show closed in Las Vegas and subsequently performed in other venues in the United States.

16. Shortly after THE **RAT PACK** IS BACK show left Las Vegas, TRP's show titled Tribute to Frank, Sammy, Joey and Dean opened at the Greek Isles hotel and casino in Las Vegas. The show was produced by TRP Entertainment LLC, which includes comedian Sandy Hackett and producer Dick Feeney as members.

17. In or around October 2002, TRP's and Greek Isles prominently featured the phrase THE **RAT PACK** RETURNS in their advertisements for their show. THE **RAT PACK** RETURNS is confusingly similar to DRDC's mark, THE **RAT PACK** IS BACK. TRP's advertisement also featured a blonde woman in a white dress. DRDC's show included a bit about Frank being given a date with a blonde as a birthday gift. TRP's advertisement also featured two principal actors who previously worked in DRDC's show and were featured in DRDC's advertisements. TRP's and the Creek Isle's ad is shown below:

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18. Based on TRP's conduct, in November 2002, DRDC sent a cease and desist letter to Hackett accusing Hackett of infringing DRDC's intellectual property rights. DRDC demanded that they instruct advertisers to stop running the infringing advertisement, cease using the phrase THE **RAT PACK** RETURNS in any fashion, and cease using images similar to those used in DRDC's advertisements.

19. On December 11, 2002, Hackett sent a letter to DRDC's counsel in which he agreed to create new advertisements, agreed to eliminate use of THE **RAT PACK** RETURNS mark, and assured DRDC that the name of its show is simply The Tribute to Frank, Joey, Sammy and Dean. Hackett agreed to eliminate use of THE **RAT PACK** RETURNS.

20. Upon information and belief, TRP and Greek Isles initially ceased using THE **RAT PACK** RETURNS. In reliance on TRP's representations and apparent compliance with DRDC's demands, DRDC did not take any further action against TRP at that time.

21. In or around early 2005, David Cassidy of DRDC saw a report on CBS Eye on America regarding Defendants' show. During an interview segment, Sandy Hackett stated that the show takes you back in time to the early 60s when the **Rat Pack** ruled Las Vegas. Clips of the Defendants' show shown in the CBS report revealed that the Defendants were using material that is identical or substantially similar to elements of DRDC's THE **RAT PACK** IS BACK show.

22. DRDC also learned that TRP had filed a federal **trademark** application for **RAT PACK** VEGAS for shows. The USPTO has issued an office action refusing registration of the **RAT PACK** VEGAS mark on various grounds, including, because it is likely to cause confusion with DRDC's THE **RAT PACK** IS BACK mark.

23. On February 18, 2005, DRDC's counsel sent a cease and desist letter to TRP demanding that TRP cease all uses of the **RAT PACK** VEGAS mark, agree not to resume use of any infringing or similar names or marks in the future, and sign and return a written confirmation of compliance with DRDC's demands.

24. In a letter dated February 23, 2005, Hackett, on behalf of TRP, apologized to DRDC for any confusion. Hackett stated that TRP owns the <ratpackvegas.com> domain name and filed a federal **trademark** registration for that entity, but [s]comehow in the application process it must have been changed and listed as ' **Rat Pack** Vegas.' Hackett promised that TRP would make every effort to clear up the matte with the U.S. Patent and **Trademark** Office ...

25. By letter dated February 28, 2005, DRDC's counsel explained to Hackett that TRP's use of **RAT PACK** VEGAS for a theatrical show is confusingly similar to DRDC's mark THE **RAT PACK** RETURNS for a live stage musical production. DRDC's counsel further explained that use of <ratpackvegas.com> as a domain name would also lead to confusion. Again, DRDC's counsel demanded that TRP cease all uses of **RAT PACK** VEGAS, agree not to resume use of any infringing or similar names or marks in the future, and sign and return a written confirmation of compliance. In addition, DRDC also again demanded that TRP stop using THE **RAT PACK** RETURNS in promoting its show.

26. In a responsive letter dated March 17, 2005, Hackett, on behalf of TRP, denied using THE **RAT PACK** RETURNS in promoting TRP's show. Hackett represented that TRP had not used THE **RAT PACK** RETURNS since receiving DRDC's cease and desist two and a half years ago and that any use of the phrase has been by others, such as ticket brokers, over which TRP has no control. Hackett also contended that <ratpackvegas.com> is a domain name for a web site that promotes The Tribute to Frank, Sammy, Joey and Dean show, but the show is not advertised as **RAT PACK** VEGAS. Hackett also indicated that TRP would not respond to further comespondence unless DRDC wishes to take formal legal action ....

27. Contrary to TRP's representation, TRP is using THE RIT PACK RETURNS in its own promotion of its show. TRP is using THE **RAT PACK** RETURNS on the home page and interior pages of its web site at <ratpackvegas.com>.

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TRP is using THE **RAT PACK** RETURNS on the home page of its web site at <thetributetotheratpack.com>.

28. Furthermore, Defendants are using other **RAT PACK** formative marks and domain names. TRP uses the <ratpackvegas.com> domain name. TRP uses **RAT PACK** in bold letters on the navigation page of its web site. TRP is also using **RAT PACK** and **RAT PACK** VEGAS in the metatags for the home page of its web site at < ratpackvegas.com>. Moreover, upon information and belief, TRP has not taken any action to abandon its application for registration of the **RAT PACK** VEGAS mark with the USPTO.

29. The Greek Isles is now promoting TRP's show as THE **RAT PACK** as shown in the advertisement below:

30. Defendants are trading off of the goodwill developed by DRDC in THE **RAT PACK** IS BACK mark.

31. DRDC has taken all steps necessary to obtain a United States copyright registration in THE **RAT PACK** RETURNS show (Copyrighted Work).

32. Defendants had access to DRDC's Copyrighted Work.

33. Defendants' show is substantially similar to DRDC's Copyrighted Work. Defendants have copied elements of the plot, themes, dialogue, jokes, choreography, music, mood, setting, pace, characters and sequence of events from DRDC's Copyrighted Work.

34. The press has noted the substantial similarities between Defendants' THE **RAT PACK** RETURNS show and DRDC's THE **RAT PACK** RETURNS/THE **RAT PACK** show. *Las Vegas Stage* has referred to Defendants' show as the unofficial remake of DRDC's show. The *Las Vegas Review-Journal* referred to Defendants' **Rat Pack** show as a copy and a spinoff.

35. Upon information and belief, Hackett and Feeney have personally taken part in and specifically directed TRP's **trademark** infringement and unfair competition.

36. Upon information and belief, Hackett, Feeney and the Greek Isles have knowingly participated in, aided, ratified and/or adopted TRP's infringing conduct.

COUNT I (**Trademark** Infringement under the Lanham Act, 15 U.S.C. § 1114 -- THE **RAT PACK** RETURNS)

37. DRDC realleges each allegation set forth in the preceding paragraphs as if set forth herein.

38. Defendants have used and/or are using in commerce THE **RAT PACK** RETURNS mark, which is a reproduction, counterfeit, copy, or colorable imitation of DRDC's registered THE **RAT PACK** IS BACK mark, in connection with the sale, offering for sale, distribution, or advertising of services on or in connection with which such use is likely to cause confusion, or to cause mistake, or to deceive.

39. By adopting THE **RAT PACK** RETURNS mark, the Defendants have reproduced, counterfeited, copied, or colorably imitated DRDC's registered THE **RAT PACK** IS BACK mark and are using such reproduction, counterfeit, copy, or colorable imitation in advertisements in commerce in connection with the sale, offering for sale, or advertising of services on or in connection with which such use is likely to cause confusion, or to cause mistake, or to deceive.

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40. As a direct and proximate result of such **trademark** infringement, DRDC has suffered and will suffer monetary loss and irreparable injury to its business, reputation. and goodwill.

41. Defendants have committed such acts with knowledge that such imitation is intended to cause confusion, or to cause mistake, or to deceive.

42. Each of Defendants is directly, vicariously, contributorily and/or jointly liable for the infringing conduct.

COUNT II (**Trademark** Infringement under the Lanham Act, 15 U.S.C. § 1114 -- Other **RAT PACK** Marks)

43. DRDC incorporates the allegations set forth in the preceding paragraphs as if set forth herein.

44. Defendants have used and are using in commerce various **RAT PACK** formative marks, which constitute a reproduction, counterfeit, copy, or colorable imitation of DRDC's registered THE **RAT PACK** IS BACK mark, in connection with the sale, offering for sale, distribution, or advertising of services on or in connection with which such use is likely to cause confusion, or to cause mistake, or to deceive.

45. By adopting **RAT PACK** formative marks, the Defendants have reproduced, counterfeited, copied, or colorably imitated DRDC's registered THE **RAT PACK** IS BACK mark and are using such reproduction, counterfeit, copy, or colorable imitation in advertisements in commerce in connection with the sale, offering for sale, or advertising of services on or in connection with which such use is likely to cause confusion, or to cause mistake, or to deceive.

46. As a direct and proximate result of such **trademark** infringement, DRDC has suffered and will suffer monetary loss and irreparable injury to its business, reputation, and goodwill.

47. Defendants have committed such acts with knowledge that such imitation is intended to cause confusion, or to cause mistake, or to deceive.

48. Each of the Defendants is directly, vicariously, contributorily and/or jointly liable for the infringing conduct.

COUNT III (Copyright Infringement under the Copyright Act, 17 U.S.C. § 101 *et seq.*)

49. DRDC incorporates the allegations set forth in the preceding paragraphs as if set forth herein.

50. Defendants had access to DRDC's Copyrighted Work.

51. Defendants' show is substantially similar to DRDC's THE **RAT PACK** IS BACK Copyrighted Work.

52. As a direct and proximate result of such copyright infringement, DRDC will suffer monetary loss and irreparable injury to its business, reputation, and goodwill.

53. Each of the Defendants is directly, vicariously, contributorily and/or jointly liable for the infringing conduct.

COUNT IV (Trade Dress Infringement under 15 U.S.C. 1125(a))

54. DRDC incorporates the allegations set forth in the preceding paragraphs as if set forth herein.

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55. The trade dress in DRDC's THE **RAT PACK** RET RNS show and advertising for the show is inherently distinctive or has acquired distinctiveness through secondary meaning.

56. DRDC's trade dress is non-functional.

57. Defendants' use of the same or similar trade dress is likely to cause confusion by the consuming public.

58. As a direct and proximate result of such trade dress infringement, DRDC will suffer monetary loss and irreparable injury to its business, reputation, and goodwill.

59. Each of the Defendants is directly, vicariously, contributorily and/or jointly liable for the infringing conduct.

COUNT V (Cybersquatting under the Anticybersquatting Consumer Protection Act, 15 U.S.C. § 1125(c))

60. DRDC incorporates the allegations set forth in the preceding paragraphs as if set forth herein.

61. TRP has registered, trafficked in, and/or used the <ratpackvegas.com> domain name.

62. TRP's <ratpackvegas.com> domain name is confusingly similar to DRDC's THE **RAT PACK** IS BACK mark, which was distinctive at the time of TRP's registration of the domain name.

63. Upon information and belief, TRP has or has had a bad faith intent to profit from DRDC's **trademark**.

COUNT VI (Unfair Competition under the Lanham Act, 15 U.S.C. § 1125(a))

64. DRDC incorporates the allegations set forth in the preceding paragraphs as if set forth herein.

65. Defendants' use of THE **RAT PACK** RETURNS and other **RAT PACK** formative marks in commerce in connection with the sale of services constitutes a false designation of origin, false or misleading description of fact, or false or misleading representation of fact, which is likely to cause confusion, or to cause mistake, or to deceive as to the affiliation, connection, or association of Defendants with DRDC, or as to the origin, sponsorship, or approval of Defendants' services, by DRDC.

66. As a direct and proximate result of such unfair competition, DRDC will suffer monetary loss and irreparable injury to its business, reputation, and goodwill.

67. Each of the Defendants is directly, vicariously, contributorily and/or jointly liable for the infringing conduct.

COUNT VII (Unfair competition under common law)

68. DRDC incorporates the allegations set forth in the preceding paragraphs as if set forth herein.

69. Defendants have engaged in unfair competition under common law.

70. As the direct and proximate result of Defendants' conduct. DRDC has suffered damages in an amount to be de-

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termined at trial.

71. Each of the Defendants is directly, vicariously, contributorily and/or jointly liable for the infringing conduct.

PRAYER FOR RELIEF

WHEREFORE, Plaintiff DRDC respectfully requests that the Court:

A. Grant temporary, preliminary and permanent injunctive relief prohibiting Defendants from:
1. Using the THE **RAT PACK** RETURNS, **RAT PACK** VEGAS, and any confusingly similar marks, in connection with any entertainment related services, including, but not limited to, live stage performances;
2. Pursuing or maintaining federal or state **trademark** applications or registrations for **RAT PACK** VEGAS, or any confusingly similar marks; and
3. Owning or using any domain names comprised of the term the **RAT PACK** or any confusingly similar domain name.

B. Enter an order directing the United States Patent and **Trademark** Office to cancel any registration of **RAT PACK** VEGAS or **RAT PACK** formative **trademarks** that Defendants may obtain;

C. Award compensatory, consequential, statutory, exemplary,, and other damages (including, but not limited to, actual damages, profits, award for corrective advertising) to DRDC in an amount to be determined at trial;

D. Award attorneys' fees and costs to DRDC; and

E. Grant to DRDC whatever other relief is just and proper.

DEMAND FOR JURY TRIAL

DRDC demands trial by jury on all claims.

DRDC PRODUCTION, INC., a Nevada corporation, Plaintiff, v. TRP ENTERTAINMENT LLC, a Nevada limited liability corporation; Sandy Hackett, an individual; Richard Feeney, an individual; Convention Center Drive Hotel and Casino LLC dba Greek Isles Hotel and Casino, Defendants.
2005 WL 3766623 (D.Nev.) (Trial Pleading)

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EXHIBIT I

EXHIBIT I

For Dockets See 2:05CV00673

United States District Court, D. Nevada.
DRDC PRODUCTION, INC., a Delaware corporation, Plaintiff,
v.
TRP ENTERTAINMENT LLC, a Nevada limited liability corporation; Sandy Hackett, an individual; Convention Center Drive Hotel and Casino Llc dba Greek Isles Hotel and Casino, Defendants.
No. CV-S-05-0673-PMP-PAL.
May 31, 2005.

Plaintiff's Motion for Preliminary Injunction

DRDC Production, Inc. respectfully moves the Court for a preliminary injunction enjoining the Defendants TRP Entertainment, Inc., Sandy Hackett, and Convention Center Drive Hotel and Casino LLC dba Greek Isles Hotel and Casino from infringing on DRDC's THE **RAT PACK** IS BACK **trademarks** and copyright. This motion is supported by the accompanying declaration of David Cassidy and the points and authorities set forth below.

FACTUAL ALLEGATIONS

DRDC Production, Inc. ("DRDC") wrote and produces a musical stage show known as THE **RAT PACK** IS BACK. The **RAT PACK** IS BACK is the brainchild of Don Reo and David Cassidy. The show is a song, dance and comedy tribute to the era of early 1960s Las Vegas. The show is about Frank, Sammy, Dean and Joey performing on stage as they celebrate Frank's birthday. Declaration of David Cassidy ("Cassidy Decl.") ¶2.

On May 17, 1999, DRDC filed a federal **trademark** application with the United States Patent and **Trademark** Office ("USPTO") for THE **RAT PACK** IS BACK for entertainment services, namely, live stage musical productions. The application matured into a registration on October 22, 2002. Cassidy Decl. Exh. A. As a result, DRDC owns the exclusive rights to use THE **RAT PACK** IS BACK in connection with entertainment services. DRDC also owns a federal **trademark** registration for THE **RAT PACK** IS BACK in connection with clothing. Cassidy Decl. Exh. B. Since 1999. DRDC has spent hundreds of thousands of dollars in connection with enforcement and protection of THE **RAT PACK** IS BACK mark. Cassidy Decl. ¶ 3.

THE **RAT PACK** IS BACK show debuted at the Desert Inn resort hotel and casino in Las Vegas, Nevada, in July 1999. THE **RAT PACK** IS BACK show received rave reviews from local and national media. Cassidy Decl. ¶ 4.

In September 1999, Sheffield Enterprises (a licensing entity owned by Frank Sinatra's children) filed suit against the Desert Inn alleging that, among other things. the use of THE **RAT PACK** IS BACK mark infringed Sheffield's alleged rights in the **RAT PACK** mark and Frank Sinatra's persona. Sheffield Enterprises later added DRDC as a defendant. DRDC prevailed in this action. Cassidy Decl. ¶ 5.

THE **RAT PACK** IS BACK show moved to the Sahara hotel and casino in 2000. Samples of advertisements for THE **RAT PACK** IS BACK show include the following:

Cassidy Decl. ¶ *6*, Exh. C.

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In April 2002, THE **RAT PACK** IS BACK show closed in Las Vegas and subsequently performed in other venues in the United States. Cassidy Decl. ¶ 7.

In June 2002, two months after THE **RAT PACK** IS BACK show left Las Vegas, TRP's show purportedly titled "Tribute to Frank, Sammy, Joey and Dean" opened at the Greek Isles hotel and casino in Las Vegas. The show was produced by TRP Entertainment LLC. which includes comedian Sandy Hackett and producer Dick Feeney as members. Upon information and belief, Sandy Hackett wrote the show. Sandy Hackett had previously unsuccessfully applied to perform as "Joey" in DRDC's THE **RAT PACK** IS BACK show. Cassidy Decl. ¶ 8.

In or around October 2002, TRP and the Greek Isles prominently featured the phrase "THE **RAT PACK** RETURNS" in their advertisements for their show. Cassidy Decl. Exh. D. TRP's advertisement also featured a blonde woman in a white dress. DRDC's show included a bit about Frank being given a date with a blonde as a birthday gift. TRP's advertisement also featured two principal actors who previously worked in DRDC's show and were featured in DRDC's advertisements. TRP's and the Greek Isle's ad is shown below:

Cassidy Decl. ¶ 9, Exh. D.

Based on TRP's conduct, in November 2002, DRDC sent a cease and desist letter to Hackett accusing Hackett of infringing DRDC's intellectual property rights. DRDC demanded that TRP instruct advertisers to stop running the infringing advertisement, cease using the phrase THE **RAT PACK** RETURNS in any fashion, and cease using images similar to those used in DRDC's advertisements. Cassidy Decl. Exh. E.

On December 11, 2002, Hackett sent a letter to DRDC's counsel in which he agreed to create new advertisements, agreed to eliminate use of THE **RAT PACK** RETURNS mark, and assured DRDC that the name of its show is simply "The Tribute to Frank, Joey, Sammy and Dean." Cassidy Decl. Exh. F.

Upon information and belief, TRP and Greek Isles initially ceased using THE **RAT PACK** RETURNS. In reliance on TRP's representations and apparent compliance with DRDC's demands, DRDC did not take any further action against TRP at that time. Cassidy Decl. ¶ 12.

In or around early 2005, David Cassidy of DRDC saw a report on "CBS Eye on America" regarding TRP's show. During an interview segment, Sandy Hackett stated that the show "takes you back in time to the early 60s when the **Rat Pack** ruled Las Vegas." Clips of TRP's show shown in the CBS report revealed that TRP was using material that is identical, or at least substantially similar, to elements of DRDC's THE **RAT PACK** IS BACK show. DRDC also learned that TRP had filed a federal **trademark** application for **RAT PACK** VEGAS for shows. Cassidy Decl. ¶ 13.

On February 18, 2005, DRDC's counsel sent a cease and desist letter to TRP demanding that TRP cease all uses of the **RAT PACK** VEGAS mark, agree not to resume use of any infringing or similar names or marks in the future, and sign and return a written confirmation of compliance with DRDC's demands. Cassidy Decl. Exh. G.

In a letter dated February 23, 2005, Hackett, on behalf of TRP, apologized to DRDC for any confusion. Hackett stated that TRP owns the <ratpackvegas.com% domain name and filed a federal **trademark** registration "for that entity." but "[s]omehow in the application process it must have been changed and listed as " ' **Rat Pack** Vegas.' " Hackett promised that TRP would "make every effort to clear up the matter with the U.S. Patent and **Trademark** Office ..." Cassidy Decl. Exh. II.

By letter dated February 28, 2005. DRDC's counsel explained to Hackett that TRP's use of **RAT PACK** VEGAS for a theatrical

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show is confusingly similar to DRDC's mark THE **RAT PACK** RETURNS for a live stage musical production. DRDC's counsel further explained that use of <ratpackvegas.com% as a domain name would also lead to confusion. Again, DRDC's counsel demanded that TRP cease all uses of **RAT PACK** VEGAS, agree not to resume use of any infringing or similar names or marks in the future, and sign and return a written confirmation of compliance. In addition, DRDC also again demanded that TRP stop using THE **RAT PACK** RETURNS in promoting its show. Cassidy Decl. Exh. I.

In a responsive letter dated March 17, 2005, Hackett, on behalf of TRP, denied using THE **RAT PACK** RETURNS in promoting TRP's show. Hackett represented that TRP had not used THE **RAT PACK** RETURNS since receiving DRDC's cease and desist "two and a half years" ago and that any use of the phrase has been by others, such as ticket brokers, over which TRP has no control. Hackett also contended that <ratpackvegas.com% is a domain name for a web site that promotes "The Tribute to Frank, Sammy, Joey and Dean" show, but the show is not advertised as **RAT PACK** VEGAS. Hackett also indicated that TRP would not respond to further correspondence unless DRDC "wishes to take formal legal action ...." Cassidy Decl. Exh. J.

Contrary to TRP's representation, TRP is using THE **RAT PACK** RETURNS in its own promotion of its show. Cassidy Decl. Exh. K. TRP is using THE **RAT PACK** RETURNS on the home page and interior pages of its web site at <ratpackvegas.com%. Cassidy Decl. Exh. M. TRP is using THE **RAT PACK** RETURNS on the home page of its web site at <thetributetotheratpack.com%. Cassidy Decl. Exh. L.

Furthermore, TRP is using other **RAT PACK** formative marks and domain names. TRP uses the <ratpackvegas.com% domain name. Cassidy Decl. Exh. M. TRP uses **RAT PACK** in bold letters on the navigation page of its web site. Cassidy Decl. Exh. N. TRP is also using **RAT PACK** and **RAT PACK** VEGAS in the metatags for the home page of its web site at <ratpackvegas.com%. Cassidy Decl. Exh. O.

The Greek Isles is now promoting TRP's show as THE **RAT PACK** as shown in the advertisement below:

Cassidy Decl. Exh. P.

DRDC has taken all steps necessary to obtain a United States copyright registration in a script of THE **RAT PACK** RETURNS show ("Copyrighted Work"). Cassidy Decl. Exh. Q. TRP's show is substantially similar to THE **RAT PACK** RETURNS SHOW, including, the setting, dialogue, music. themes, and other elements. Cassidy Decl. ¶ 25. TRP's show copied the setting: early 1960s in a Las Vegas casino. TRP's show copied some of the dialogue from DRDC's show. including jokes regarding a marting??, a flaming pansy and a dentist. TRP's show copied DRDC's selection of songs. TRP's show copied an original musical orchestration from DRDC's show. TRP's show copied other elements of DRDC's show as detailed in the accompanying declaration of David Cassidy. Cassidy Decl. ¶ 25.

The press has noted the substantial similarities between TRP's THE **RAT PACK** RETURNS show and DRDC's THE **RAT PACK** RETURNS/THE **RAT PACK** show. *Las Vegas Stage* has referred to TRP's show as "the unofficial remake" of DRDC's show. Cassidy Decl. Exh. R. The *Las Vegas Review-Journal* referred to Defendants' **Rat Pack** show as a "copy" and a "spinoff." Cassidy Decl. Exh. S. In reviewing TRP's show in the *Las Vegas Review-Journal,* entertainment reporter Mike Weatherford stated that "[a]lumni of a Sahara production called 'The **Rat Pack** is Back' retreated, regrouped and reopened as "The Tribute to Frank, Sammy, Joey & Dean." Cassidy Decl. Exh. T.

ARGUMENT

The Court should enter a preliminary injunction prohibiting TRP and the other defendants from infringing DRDC's **trademarks** and copyrights. In determining whether to grant preliminary injunctive relief, courts traditionally considers four factors: (I) whether the moving party will suffer irreparable harm if injunctive relief is not granted: (2) whether the moving party is likely to succeed on the merits; (3) whether the balance of equities tips in favor of the moving party; and (4) whether granting

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the injunction is in the public interest. *See* Stanley v. University of Southern California, 13 F.3d 1313, 13 19 (9th Cir. 1994). Alternatively, the court may issue preliminary injunctive relief if the moving party establishes a combination of: (1) probable success on the merits and the possibility of irreparable injury without injunctive relief; or (2) serious questions are raised and the balance of hardships tips sharply in the moving party's favor. *Id.* A serious question" is one for which the moving party has a "fair chance" of success on the merits. *Id.* DRDC relies on the first alternative test under *Stanley.*

I. *DRDC WILL PROBABLY SUCCEED ON THE MERITS AT TRIAL*

DRDC will probably succeed on the merits of its **trademark** infringement and copyright infringement claims at trial.

A. DRDC Will Probably Succeed on the Merits of Its ***Trademark*** *Infringement and Unfair Competition Claims*

"The likelihood of confusion is the central element of **trademark** infringement, and the issue can be recast as the determination of whether 'the similarity of the marks is likely to confuse consumers about the source' " of the goods or services. *See* Goto.com v. The Walt Disney Company, 202 F.3d 1199 (9th Cir. 2000). The test for **trademark** infringement is the identical test used for determining unfair competition. Century 21 Real Estate Corp. v. Sandlin, 846 F.2d 1175, 1178 (9th Cir. 1988). In determining likelihood of confusion, the Ninth Circuit generally considers eight factors: (1) the strength of the allegedly infringed mark; (2) the proximity or relatedness of the goods or services; (3) similarity of the marks; (4) evidence of actual confusion; (5) the degree to which the marketing channels converge; (6) the degree of care consumers are likely to exercise in purchasing the goods or services: (7) the intent of the defendant in selecting the allegedly infringing mark; and (8) the likelihood that the parties will expand their product lines. *See* AMF, Inc. v. Sleekcraft Boats, 599 F.2d 341, 348-49 (9th Cir. 1979).

1. *DRDC's* ***Trademark*** *is Strong*

Trademark law offers greater protection to marks that are strong. The strength of a mark is determined by its placement on a continuum from generic (afforded no protection) through descriptive and suggestive (entitled to moderate protection) through arbitrary or fanciful (entitled to maximum protection). *See id.;* GoTo.com, 202 F.3d at 1207 ("[t]his 'strength' of the **trademark** is evaluated in terms of its conceptual strength and commercial strength"); *see also* Two Pesos, Inc. v. Taco Cabana, Inc., 505 U.S. 763, 768 (1992).

DRDC's THE **RAT PACK** IS BACK mark is suggestive, because it requires consumers to use some degree of imagination to determine the nature of the entertainment services provided by DRDC under the mark. As a result, the mark is entitled to moderate protection.

2. *Defendants are Using the Mark on the Same or Similar Services*

Where the goods or services are related or complementary, the danger of consumer confusion is heightened. *See* AMF, 599 F.2d at 350. "Related goods are generally more likely than unrelated goods to confuse the public as to the producers of the goods." Brookfield Communications v. West Coast, 174 F.3d 1036, 1056 (9th Cir. 1999). Where a defendant is using the same or a similar mark in connection with the same or similar services, "likelihood of confusion would follow as a matter of course." *Id.* at 1056.

In this case, TRP is using THE RAT BACK RETURNS, **RAT PACK** VEGAS and other **RAT PACK** formative marks in connection with essentially the same services as DRDC: a musical stage show.

3. *The Marks at Issue are Identical or Nearly Identical*

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"[T]he greater the similarity between the two marks at issue, the greater the likelihood of confusion." *Goto.com*, 202 F.3d at 1206. In determining the similarity of two marks, the Court must: (1) consider the marks in their entirety as they appear in the marketplace; (2) consider the appearance, sound and meaning of the marks; and (3) weigh similarities more heavily than differences. *Id.*

TRP's mark THE **RAT PACK** RETURNS is almost identical to DRDC's THE **RAT PACK** IS BACK mark. The marks have the same meaning. The marks sound similar. The marks look similar as they appear in the marketplace. In fact, TRP even copied the appearance of DRDC's mark by; (1) using white type on a dark background; (2) making the words " **RAT PACK**" appear in lettering that gradually decreases in size over an arch or curve; (3) using nearly identical font; (4) making the words " **RAT PACK**" appear larger in size than the other words in the title; (5) using upper case lettering for " **RAT PACK** RETURNS"; (6) aligning "The" to the left and "Returns" to the right, which is similar to DRDC's alignment of "THE" to the left and IS BACK" to the right:

Moreover, TRP's other **RAT PACK** formative marks are likewise similar to DRDC's THE **RAT PACK** IS BACK mark.

4. *Defendants Intended to Cause Confusion*

It is well established that a defendant's intention in adopting a mark that is the same or similar to another's mark is evidence of likelihood of confusion. *See Sleekcraft*, 599 F.2d at 354. As McCarthy has observed. "[a] wrongful intent appears easy to infer where defendant knew of plaintiffs mark, had freedom to choose any mark and 'just happened' to choose a mark confusingly similar to plaintiffs mark." *McCarthy*, § 23:115; *see also Stork Restaurant v. Sahati*, 166 F.2d 348 (9th Cir. 1948) ("This thought that a newcomer has an 'infinity' of other names to choose from without *infringing* upon a senior appropriation runs through the decisions like a leitmotif."); *Brookfield*. 174 F.3d at 1509 (this factor favors the plaintiff where the defendant adopted the plaintiffs mark with knowledge, constructive or actual, that it was another's **trademark**). However, intent is not necessary to prove a likelihood of confusion. *Goto.com*, 202 F.3d at 1208.

Even though TRP claims that the title of its show is "A Tribute To Frank, Sammy, Dean & Joey," TRP has repeatedly used "THE **RAT PACK** RETURNS" in advertising and marketing the show. Cassidy Decl. ¶ 18. Furthermore, TRP has emphasized "THE **RAT PACK** RETURNS" more so than the "tribute" reference. Cassidy Decl. Exh. I., TRP has even falsely denied its continued use of "THE **RAT PACK** RETURNS." Cassidy Decl. Exh. J. Even though TRP could have used numerous different marks in connection with its tribute show, TRP chose a four-word phrase that is nearly identical to DRDC's federally registered mark.

5. *Actual Confusion is Highly Likely*

Evidence of actual confusion is not necessary for a finding of likelihood of confusion under the Lanham Act. *See Sleekcraft*, 599 F.2d at 353. Indeed, it is widely recognized that "it is very difficult, and often impossible, to obtain reliable evidence of actual confusion ...." *McCarthy*, § 23:12.

Although DRDC is not currently aware of instances of confusion. even sophisticated commentators, such as entertainment reporters, have commented on the similarity of the shows, as discussed in the statement of facts above.

6. *The Marketing Channels are Similar*

When marketing channels are similar, consumers are more likely to be confused by a defendant's use of identical or similar marks. *See Lozano Enterprises*. 44 U.S.P.Q.2d at 1768; *see also Sleekcraft*, 599 F.2d 353 ("convergent marketing channels increase the likelihood of confusion").

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DRDC's THE **RAT PACK** IS BACK show has appeared primarily in resort hotel casino venues in Las Vegas and elsewhere. Cassidy Decl. ¶ 21. DRDC's show has been advertised in entertainment magazines, newspapers, billboards, on the Internet, and through ticket brokers. Cassidy Decl. ¶ 21. TRP's show also performs in the same venues and is advertised through the same channels. Cassidy Decl. ¶ 21.

7. *The Degree of Consumer Care is Likely to be Low*

Consumers are not likely to exercise a great deal of care in determining the source of TRP's THE **RAT PACK** RETURNS show prior to purchasing tickets. Indeed, consumers visiting Las Vegas are likely to simply see advertisements for TRP's show or hear by word of mouth about the show and purchase the tickets without investigating the source of the services. Cassidy Decl. ¶ 22.

8. *Expansion of Product Lines is Irrelevant*

"A strong likelihood that either party may expand his business to compete with the other favors a finding of infringement." *Official Airline Guides, Inc. v. Goes*, 6 F.3d 1385, 1394 (9th Cir. 1993). TRP is using DRDC's mark on services similar to those offered by DRDC. Therefore, the question of expansion into the same product line is moot. There is already an overlap in services and, thus, an increase in the likelihood of confusion. *See New West Corp. v. NYM Co. of California*, 595 F.2d 1194 (9th Cir. 1979) (identical names, products and area of distribution compel the conclusion that there will be a likelihood of confusion).

9. *Conclusion on **Trademark** Infringement*

Based on the foregoing points, DRDC will probably succeed on its **trademark** infringement claim at trial.

B. DRDC Will Probably Succeed on the *Merits of Its Copyright Infringement Claim*

DRDC will probably succeed on the merits of its copyright infringement claim. To succeed on a copyright infringement claim, a plaintiff need only establish that: (1) it is the owner of the copyrighted work; and (2) defendants have copied the copyrighted work. *Sid & Marty Krofft Television Prods., Inc. v. McDonald's Corporation*, 562 F.2d 1157, 1162 (9th Cir. 1977).

1. *DRDC Owns Copyrights in the Show*

DRDC wrote THE **RAT PACK** IS BACK script and, therefore, owns the copyright in the script. Cassidy Decl. ' 23. Moreover, DRDC has taken all steps necessary to obtain a copyright registration for the show. The registration certificate will constitute prima facie evidence of the validity of the copyrights and DRDC's ownership. *See* 17 U.S.C. § 410(c); *see also Apple Computer, Inc. v. Formula Int'l, Inc.*, 725 F.2d 521, 523 (9th Cir. 1984).

2. *Defendants Copied DRDC's Show*

Copying is ordinarily proven circumstantially by evidence of access and substantial similarity. *Sid & Marty Krofft*, 562 F.2d at 1162.

a. *Defendants Had Access to the Copyrighted Work*

"[P]roof of access requires only an opportunity to view or to copy plaintiff's work." *Kamar International v. Russ Berrie & Co.*,

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657 F.2d 1059, 1062 (9th Cir. 1981).

TRP clearly had access to DRDC's copyrighted script for THE **RAT PACK** IS BACK show. Three of the actors TRP's show had previously performed in THE **RAT PACK** IS BACK. Accordingly, each of these actors had copies of DRDC's copyrighted work. Cassidy Decl. ¶ 24. Moreover, TRP had the opportunity to view the performance of THE **RAT PACK** IS BACK numerous times during its run at the Desert Inn and the Sahara in Las Vegas, before TRP started performing its competing show.

b. Defendants' Show is Substantially Similar *To DRDC's THE **RAT PACK** IS BACK Show*

TRP's THE **RAT PACK** RETURNS show is substantially similar to DRDC's copyrighted script for THE **RAT PACK** IS BACK show.

To determine whether two works are substantial similar, courts conduct a two?? prong analysis: the extrinsic and the extrinsic test. *Kouf v. Walt Disney Pictures & Television*, 16 F.3d 1042, 1045 (9th Cir. 1994). The extrinsic test is an objective measure of the "articulable similarities between the plot, themes, dialogue, mood, setting, pace. characters, and sequence of events." *Id.* The intrinsic test is a subjective test that focuses on the total concept and feel of the two works. *Id.* Under the "inverse ratio rule," the Ninth Circuit requires a lower standard of proof of substantial similarity when a high degree of access is shown. *Three Boys Music Corp. v. Bolton*, 212 F.3d 477, 485 (9th Cir. 2000).

Application of the extrinsic test supports finding of substantial similarity. The chart below identifies the articulable similarities that exist between DRDC's show and TRP's show:

	DRDC	TRP
Setting	December 12, 1961; Las Vegas casino	Early 1960s; Las Vegas casino
Plot	**Rat Pack** puts on show on night of Frank's birthday	**Rat Pack** comes back for one last show
Themes	Booze Women Ethnicity Religion Birthday	Booze Women Ethnicity Religion Birthday
Dialogue	1. Martini joke 2. Flaming pansy joke 3. Dentist joke	1. Same martini joke 2. Same flaming pansy joke 3. Same dentist joke
Music	Come Fly with Me	Yes
	Luck be a Lady Tonight	No
	Everybody Loves Somebody	Yes
	That's Amore	Yes
	Kick in the Head	Yes
	Sam's Song	Yes
	Old Black Magic	Yes
	What Kind of Fool Am I?	No
	Mr. Boj angles	Yes
	Similar original orchistrations	Yes

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	A Foggy Day	Yes
	Lady is a Tramp	Yes
	Birth of the Blues	Yes
Mood	Upbeat	Upbeat
Characters	Frank, Dean, Sammy, Joey, blonde woman	Frank, Dean, Sammy, Joey, Marilyn Monroe
Sequence of Events	Monologues, mixed duets/solos/ensembles	Monologues, mixed duets/solos/ensembles
Other	Voice of God used in joke Choreography for "Birth of the Blues"	Voice of God used in intro Same

Cassidy Decl. ¶ 25.

The intrinsic test is also satisfied in this case. Indeed, reporters have commented on the similarity in the overall look and feel of the two works. In reviewing Defendants' show in the *Las Vegas Review-Journal,* entertainment reporter Mike Weatherford stated that "[a]lumni of a Sahara production called 'The **Rat Pack** is Back' retreated, regrouped and reopened as "The Tribute to Frank, Sammy. Joey & Dean." Rob Garrett. The Voice of Vegas, characterized Defendants' show as "the unofficial remake" of DRDC's THE **RAT PACK** IS BACK show. Cassidy Decl. Exh. R.

Accordingly, DRDC will probably succeed on the merits of its copyright infringement claim.

II. THERE IS A POSSIBILITY THAT DRDC WILL SUFFER *IRREPARABLE INJURY IF INJUNCTIVE RELIEF IS NOT GRANTED*

As a matter of law, **trademark** infringement injures the **trademark** owner's good will and reputation associated with the mark. which is not compensable through an award of damages. *See* Paisa, Inc. v. N&G Auto, Inc., 928 F. Supp. 1009.1012 (C.D. Cal. 1996). The Ninth Circuit has held that, in **trademark** infringement actions, "once the plaintiff establishes a likelihood of confusion. it is ordinarily presumed that the plaintiff will suffer irreparable harm." *Vision Sports, Inc. v. Melville Corp.,* 888 F.2d 609, 612 n.3 (9th Cir. 1989); *see also* Century 21 Real Estate Corp. v. Sandlin, 846 F.2d 1175. 1180 (9th Cir. 1988) (injunctive relief is the remedy of choice for **trademark** infringement or unfair competition because there is no adequate remedy at law). This presumption "effectively conflates the dual inquiries" of likelihood of success on the merits and irreparable injury "into the single question of whether the plaintiff has shown a likelihood of success on the merits." Goto.com, 202 F.3d at 1205 n.4. "[A] plaintiff is therefore entitled to a preliminary injunction in a **trademark** case simply when it shows a likelihood of confusion." *Id.* at n.5. Accordingly, DRDC only needs to establish a likelihood of success on the merits of its **trademark** infringement or unfair competition claims to obtain a temporary restraining order and preliminary injunctive relief against TRP. As discussed in Section I above, DRDC will probably succeed on the merits at trial.

Under copyright law, a plaintiff that demonstrates a likelihood of success on the merits of a copyright infringement claim is entitled to a presumption of irreparable harm. Sun Microsystems, Inc. v. Microsoft Corporation, 188 F.3d 1115, 1119 (9th Cir. 1999); *Cadence Design Systems v. Avant! Corp.,* 125 F.3d 824, 826-27 (9th Cir. 1997). *cert. denied,* 523 U.S. 1118 (1998). Because of the presumption of irreparable harm, a copyright owner only needs to show a reasonable likelihood of success on the merits to obtain a preliminary injunction. *See* Micro Star v. Formgen, Inc., 154 F.3d 1107, 1109 (9th Cir. 1998); *Sony Pictures Entertainment, Inc. v. Fireworks Entertainment Group, Inc.,* 137 F. Supp. 2d 1177 (C.D. Cal. 2001). The presumption means that the balance of hardships issue cannot be accorded significant, if any, weight in determining whether a court should enter a preliminary injunction to prevent the use of infringing material in cases in which the plaintiff has made a strong showing of likely success on the merits. Sun Microsystems, 188 F.3d at 1119. As discussed in Section I above, DRDC will probably

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succeed on the merits of its copyright infringement claim.

In addition to the presumption of irreparable harm, DRDC is actually suffering harm. TRP's performance of a confusingly similar show under a confusingly similar mark has effectively foreclosed the Las Vegas market to DRDC. Indeed, venues are unwilling to book DRDC's show to compete with Defendants' substantially similar show. Cassidy Decl. ¶ 27.

CONCLUSION

The Court should grant DRDC's motion for a preliminary injunction enjoining Defendants from: (1) using THE **RAT PACK** RETURNS or any **RAT PACK** formative mark in connection with any kind of live show; and (2) enjoin Defendants from performing its show using the protectible elements of DRDC's show.

Appendix not available.

DRDC PRODUCTION, INC., a Delaware corporation, Plaintiff, v. TRP ENTERTAINMENT LLC, a Nevada limited liability corporation; Sandy Hackett, an individual; Convention Center Drive Hotel and Casino Llc dba Greek Isles Hotel and Casino, Defendants.
2005 WL 3780957 (D.Nev.) (Trial Motion, Memorandum and Affidavit)

END OF DOCUMENT

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EXHIBIT J

EXHIBIT J

For Dockets See 2:05CV00673

United States District Court, D. Nevada.
DRDC PRODUCTION, INC., a Delaware corporation, Plaintiff,
v.
TRP ENTERTAINMENT LLC, a Nevada limited liability corporation; Sandy Hackett, an individual; Convention Center Drive Hotel and Casino Llc dba Greek Isles Hotel and Casino, Defendants.
No. CV-S-05-0673-PMP-PAL.
May 31, 2005.

Plaintiff's Motion for Preliminary Injunction

DRDC Production, Inc. respectfully moves the Court for a preliminary injunction enjoining the Defendants TRP Entertainment, Inc., Sandy Hackett, and Convention Center Drive Hotel and Casino LLC dba Greek Isles Hotel and Casino from infringing on DRDC's THE **RAT PACK** IS BACK **trademarks** and copyright. This motion is supported by the accompanying declaration of David Cassidy and the points and authorities set forth below.

FACTUAL ALLEGATIONS

DRDC Production, Inc. ("DRDC") wrote and produces a musical stage show known as THE **RAT PACK** IS BACK. The **RAT PACK** IS BACK is the brainchild of Don Reo and David Cassidy. The show is a song, dance and comedy tribute to the era of early 1960s Las Vegas. The show is about Frank, Sammy, Dean and Joey performing on stage as they celebrate Frank's birthday. Declaration of David Cassidy ("Cassidy Decl.") ¶2.

On May 17, 1999, DRDC filed a federal **trademark** application with the United States Patent and **Trademark** Office ("USPTO") for THE **RAT PACK** IS BACK for entertainment services, namely, live stage musical productions. The application matured into a registration on October 22, 2002. Cassidy Decl. Exh. A. As a result, DRDC owns the exclusive rights to use THE **RAT PACK** IS BACK in connection with entertainment services. DRDC also owns a federal **trademark** registration for THE **RAT PACK** IS BACK in connection with clothing. Cassidy Decl. Exh. B. Since 1999. DRDC has spent hundreds of thousands of dollars in connection with enforcement and protection of THE **RAT PACK** IS BACK mark. Cassidy Decl. ¶ 3.

THE **RAT PACK** IS BACK show debuted at the Desert Inn resort hotel and casino in Las Vegas, Nevada, in July 1999. THE **RAT PACK** IS BACK show received rave reviews from local and national media. Cassidy Decl. ¶ 4.

In September 1999, Sheffield Enterprises (a licensing entity owned by Frank Sinatra's children) filed suit against the Desert Inn alleging that, among other things. the use of THE **RAT PACK** IS BACK mark infringed Sheffield's alleged rights in the **RAT PACK** mark and Frank Sinatra's persona. Sheffield Enterprises later added DRDC as a defendant. DRDC prevailed in this action. Cassidy Decl. ¶ 5.

THE **RAT PACK** IS BACK show moved to the Sahara hotel and casino in 2000. Samples of advertisements for THE **RAT PACK** IS BACK show include the following:

Cassidy Decl. ¶ *6*, Exh. C.

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In April 2002, THE **RAT PACK** IS BACK show closed in Las Vegas and subsequently performed in other venues in the United States. Cassidy Decl. ¶ 7.

In June 2002, two months after THE **RAT PACK** IS BACK show left Las Vegas, TRP's show purportedly titled "Tribute to Frank, Sammy, Joey and Dean" opened at the Greek Isles hotel and casino in Las Vegas. The show was produced by TRP Entertainment LLC. which includes comedian Sandy Hackett and producer Dick Feeney as members. Upon information and belief, Sandy Hackett wrote the show. Sandy Hackett had previously unsuccessfully applied to perform as "Joey" in DRDC's THE **RAT PACK** IS BACK show. Cassidy Decl. ¶ 8.

In or around October 2002, TRP and the Greek Isles prominently featured the phrase "THE **RAT PACK** RETURNS" in their advertisements for their show. Cassidy Decl. Exh. D. TRP's advertisement also featured a blonde woman in a white dress. DRDC's show included a bit about Frank being given a date with a blonde as a birthday gift. TRP's advertisement also featured two principal actors who previously worked in DRDC's show and were featured in DRDC's advertisements. TRP's and the Greek Isle's ad is shown below:

Cassidy Decl. ¶ 9, Exh. D.

Based on TRP's conduct, in November 2002, DRDC sent a cease and desist letter to Hackett accusing Hackett of infringing DRDC's intellectual property rights. DRDC demanded that TRP instruct advertisers to stop running the infringing advertisement, cease using the phrase THE **RAT PACK** RETURNS in any fashion, and cease using images similar to those used in DRDC's advertisements. Cassidy Decl. Exh. E.

On December 11, 2002, Hackett sent a letter to DRDC's counsel in which he agreed to create new advertisements, agreed to eliminate use of THE **RAT PACK** RETURNS mark, and assured DRDC that the name of its show is simply "The Tribute to Frank, Joey, Sammy and Dean." Cassidy Decl. Exh. F.

Upon information and belief, TRP and Greek Isles initially ceased using THE **RAT PACK** RETURNS. In reliance on TRP's representations and apparent compliance with DRDC's demands, DRDC did not take any further action against TRP at that time. Cassidy Decl. ¶ 12.

In or around early 2005, David Cassidy of DRDC saw a report on "CBS Eye on America" regarding TRP's show. During an interview segment, Sandy Hackett stated that the show "takes you back in time to the early 60s when the **Rat Pack** ruled Las Vegas." Clips of TRP's show shown in the CBS report revealed that TRP was using material that is identical, or at least substantially similar, to elements of DRDC's THE **RAT PACK** IS BACK show. DRDC also learned that TRP had filed a federal **trademark** application for **RAT PACK** VEGAS for shows. Cassidy Decl. ¶ 13.

On February 18, 2005, DRDC's counsel sent a cease and desist letter to TRP demanding that TRP cease all uses of the **RAT PACK** VEGAS mark, agree not to resume use of any infringing or similar names or marks in the future, and sign and return a written confirmation of compliance with DRDC's demands. Cassidy Decl. Exh. G.

In a letter dated February 23, 2005, Hackett, on behalf of TRP, apologized to DRDC for any confusion. Hackett stated that TRP owns the <ratpackvegas.com% domain name and filed a federal **trademark** registration "for that entity." but "[s]omehow in the application process it must have been changed and listed as " ' **Rat Pack** Vegas.' " Hackett promised that TRP would "make every effort to clear up the matter with the U.S. Patent and **Trademark** Office ..." Cassidy Decl. Exh. H.

By letter dated February 28, 2005. DRDC's counsel explained to Hackett that TRP's use of **RAT PACK** VEGAS for a theatrical

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show is confusingly similar to DRDC's mark THE **RAT PACK** RETURNS for a live stage musical production. DRDC's counsel further explained that use of <ratpackvegas.com% as a domain name would also lead to confusion. Again, DRDC's counsel demanded that TRP cease all uses of **RAT PACK** VEGAS, agree not to resume use of any infringing or similar names or marks in the future, and sign and return a written confirmation of compliance. In addition, DRDC also again demanded that TRP stop using THE **RAT PACK** RETURNS in promoting its show. Cassidy Decl. Exh. I.

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Furthermore, TRP is using other **RAT PACK** formative marks and domain names. TRP uses the <ratpackvegas.com% domain name. Cassidy Decl. Exh. M. TRP uses **RAT PACK** in bold letters on the navigation page of its web site. Cassidy Decl. Exh. N. TRP is also using **RAT PACK** and **RAT PACK** VEGAS in the metatags for the home page of its web site at <ratpackvegas.com%. Cassidy Decl. Exh. O.

The Greek Isles is now promoting TRP's show as THE **RAT PACK** as shown in the advertisement below:

Cassidy Decl. Exh. P.

DRDC has taken all steps necessary to obtain a United States copyright registration in a script of THE **RAT PACK** RETURNS show ("Copyrighted Work"). Cassidy Decl. Exh. Q. TRP's show is substantially similar to THE **RAT PACK** RETURNS SHOW, including, the setting, dialogue, music. themes, and other elements. Cassidy Decl. ¶ 25. TRP's show copied the setting: early 1960s in a Las Vegas casino. TRP's show copied some of the dialogue from DRDC's show. including jokes regarding a marting??, a flaming pansy and a dentist. TRP's show copied DRDC's selection of songs. TRP's show copied an original musical orchestration from DRDC's show. TRP's show copied other elements of DRDC's show as detailed in the accompanying declaration of David Cassidy. Cassidy Decl. ¶ 25.

The press has noted the substantial similarities between TRP's THE **RAT PACK** RETURNS show and DRDC's THE **RAT PACK** RETURNS/THE **RAT PACK** show. *Las Vegas Stage* has referred to TRP's show as "the unofficial remake" of DRDC's show. Cassidy Decl. Exh. R. The *Las Vegas Review-Journal* referred to Defendants' **Rat Pack** show as a "copy" and a "spinoff." Cassidy Decl. Exh. S. In reviewing TRP's show in the *Las Vegas Review-Journal,* entertainment reporter Mike Weatherford stated that "[a]lumni of a Sahara production called 'The **Rat Pack** is Back' retreated, regrouped and reopened as "The Tribute to Frank, Sammy, Joey & Dean." Cassidy Decl. Exh. T.

ARGUMENT

The Court should enter a preliminary injunction prohibiting TRP and the other defendants from infringing DRDC's **trademarks** and copyrights. In determining whether to grant preliminary injunctive relief, courts traditionally considers four factors: (1) whether the moving party will suffer irreparable harm if injunctive relief is not granted: (2) whether the moving party is likely to succeed on the merits; (3) whether the balance of equities tips in favor of the moving party; and (4) whether granting

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the injunction is in the public interest. *See* Stanley v. University of Southern California, 13 F.3d 1313, 13 19 (9th Cir. 1994). Alternatively, the court may issue preliminary injunctive relief if the moving party establishes a combination of: (1) probable success on the merits and the possibility of irreparable injury without injunctive relief; or (2) serious questions are raised and the balance of hardships tips sharply in the moving party's favor. *Id.* A serious question" is one for which the moving party has a "fair chance" of success on the merits. *Id.* DRDC relies on the first alternative test under *Stanley.*

I. *DRDC WILL PROBABLY SUCCEED ON THE MERITS AT TRIAL*

DRDC will probably succeed on the merits of its **trademark** infringement and copyright infringement claims at trial.

A. DRDC Will Probably Succeed on the Merits of Its ***Trademark*** *Infringement and Unfair Competition Claims*

"The likelihood of confusion is the central element of **trademark** infringement, and the issue can be recast as the determination of whether 'the similarity of the marks is likely to confuse consumers about the source' " of the goods or services. *See* Goto.com v. The Walt Disney Company, 202 F.3d 1199 (9th Cir. 2000). The test for **trademark** infringement is the identical test used for determining unfair competition. Century 21 Real Estate Corp. v. Sandlin, 846 F.2d 1175, 1178 (9th Cir. 1988). In determining likelihood of confusion, the Ninth Circuit generally considers eight factors: (1) the strength of the allegedly infringed mark; (2) the proximity or relatedness of the goods or services; (3) similarity of the marks; (4) evidence of actual confusion; (5) the degree to which the marketing channels converge; (6) the degree of care consumers are likely to exercise in purchasing the goods or services: (7) the intent of the defendant in selecting the allegedly infringing mark; and (8) the likelihood that the parties will expand their product lines. *See* AMF, Inc. v. Sleekcraft Boats, 599 F.2d 341, 348-49 (9th Cir. 1979).

1. *DRDC's* ***Trademark*** *is Strong*

Trademark law offers greater protection to marks that are strong. The strength of a mark is determined by its placement on a continuum from generic (afforded no protection) through descriptive and suggestive (entitled to moderate protection) through arbitrary or fanciful (entitled to maximum protection). *See id.;* GoTo.com, 202 F.3d at 1207 ("[t]his 'strength' of the **trademark** is evaluated in terms of its conceptual strength and commercial strength"); *see also* Two Pesos, Inc. v. Taco Cabana, Inc., 505 U.S. 763, 768 (1992).

DRDC's THE **RAT PACK** IS BACK mark is suggestive, because it requires consumers to use some degree of imagination to determine the nature of the entertainment services provided by DRDC under the mark. As a result, the mark is entitled to moderate protection.

2. *Defendants are Using the Mark on the Same or Similar Services*

Where the goods or services are related or complementary, the danger of consumer confusion is heightened. *See* AMF, 599 F.2d at 350. "Related goods are generally more likely than unrelated goods to confuse the public as to the producers of the goods." Brookfield Communications v. West Coast, 174 F.3d 1036, 1056 (9th Cir. 1999). Where a defendant is using the same or a similar mark in connection with the same or similar services, "likelihood of confusion would follow as a matter of course." *Id.* at 1056.

In this case, TRP is using THE RAT BACK RETURNS, **RAT PACK** VEGAS and other **RAT PACK** formative marks in connection with essentially the same services as DRDC: a musical stage show.

3. *The Marks at Issue are Identical or Nearly Identical*

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"[T]he greater the similarity between the two marks at issue, the greater the likelihood of confusion." Goto.com, 202 F.3d at 1206. In determining the similarity of two marks, the Court must: (1) consider the marks in their entirety as they appear in the marketplace; (2) consider the appearance, sound and meaning of the marks; and (3) weigh similarities more heavily than differences. *Id.*

TRP's mark THE **RAT PACK** RETURNS is almost identical to DRDC's THE **RAT PACK** IS BACK mark. The marks have the same meaning. The marks sound similar. The marks look similar as they appear in the marketplace. In fact, TRP even copied the appearance of DRDC's mark by; (1) using white type on a dark background; (2) making the words " **RAT PACK**" appear in lettering that gradually decreases in size over an arch or curve; (3) using nearly identical font; (4) making the words " **RAT PACK**" appear larger in size than the other words in the title; (5) using upper case lettering for " **RAT PACK** RETURNS"; (6) aligning "The" to the left and "Returns" to the right, which is similar to DRDC's alignment of "THE" to the left and IS BACK" to the right:

Moreover, TRP's other **RAT PACK** formative marks are likewise similar to DRDC's THE **RAT PACK** IS BACK mark.

4. *Defendants Intended to Cause Confusion*

It is well established that a defendant's intention in adopting a mark that is the same or similar to another's mark is evidence of likelihood of confusion. *See Sleekcraft*, 599 F.2d at 354. As McCarthy has observed. "[a] wrongful intent appears easy to infer where defendant knew of plaintiffs mark, had freedom to choose any mark and 'just happened' to choose a mark confusingly similar to plaintiffs mark." *McCarthy*, § 23:115; *see also Stork Restaurant v. Sahati*, 166 F.2d 348 (9th Cir. 1948) ("This thought that a newcomer has an 'infinity' of other names to choose from without *infringing* upon a senior appropriation runs through the decisions like a leitmotif."); *Brookfield*, 174 F.3d at 1509 (this factor favors the plaintiff where the defendant adopted the plaintiffs mark with knowledge, constructive or actual, that it was another's **trademark**). However, intent is not necessary to prove a likelihood of confusion. Goto.com, 202 F.3d at 1208.

Even though TRP claims that the title of its show is "A Tribute To Frank, Sammy, Dean & Joey," TRP has repeatedly used "THE **RAT PACK** RETURNS" in advertising and marketing the show. Cassidy Decl. ¶ 18. Furthermore, TRP has emphasized "THE **RAT PACK** RETURNS" more so than the "tribute" reference. Cassidy Decl. Exh. I., TRP has even falsely denied its continued use of "THE **RAT PACK** RETURNS." Cassidy Decl. Exh. J. Even though TRP could have used numerous different marks in connection with its tribute show, TRP chose a four-word phrase that is nearly identical to DRDC's federally registered mark.

5. *Actual Confusion is Highly Likely*

Evidence of actual confusion is not necessary for a finding of likelihood of confusion under the Lanham Act. *See Sleekcraft*, 599 F.2d at 353. Indeed, it is widely recognized that "it is very difficult, and often impossible, to obtain reliable evidence of actual confusion ...." *McCarthy*, § 23:12.

Although DRDC is not currently aware of instances of confusion. even sophisticated commentators, such as entertainment reporters, have commented on the similarity of the shows, as discussed in the statement of facts above.

6. *The Marketing Channels are Similar*

When marketing channels are similar, consumers are more likely to be confused by a defendant's use of identical or similar marks. *See Lozano Enterprises*. 44 U.S.P.Q.2d at 1768; *see also Sleekcraft*, 599 F.2d 353 ("convergent marketing channels increase the likelihood of confusion").

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DRDC's THE **RAT PACK** IS BACK show has appeared primarily in resort hotel casino venues in Las Vegas and elsewhere. Cassidy Decl. ¶ 21. DRDC's show has been advertised in entertainment magazines, newspapers, billboards, on the Internet, and through ticket brokers. Cassidy Decl. ¶ 21. TRP's show also performs in the same venues and is advertised through the same channels. Cassidy Decl. ¶ 21.

7. *The Degree of Consumer Care is Likely to be Low*

Consumers are not likely to exercise a great deal of care in determining the source of TRP's THE **RAT PACK** RETURNS show prior to purchasing tickets. Indeed, consumers visiting Las Vegas are likely to simply see advertisements for TRP's show or hear by word of mouth about the show and purchase the tickets without investigating the source of the services. Cassidy Decl. ¶ 22.

8. *Expansion of Product Lines is Irrelevant*

"A strong likelihood that either party may expand his business to compete with the other favors a finding of infringement." *Official Airline Guides, Inc. v. Goes*, 6 F.3d 1385, 1394 (9th Cir. 1993). TRP is using DRDC's mark on services similar to those offered by DRDC. Therefore, the question of expansion into the same product line is moot. There is already an overlap in services and, thus, an increase in the likelihood of confusion. *See New West Corp. v. NYM Co. of California*, 595 F.2d 1194 (9th Cir. 1979) (identical names, products and area of distribution compel the conclusion that there will be a likelihood of confusion).

9. *Conclusion on **Trademark** Infringement*

Based on the foregoing points, DRDC will probably succeed on its **trademark** infringement claim at trial.

B. DRDC Will Probably Succeed on the *Merits of Its Copyright Infringement Claim*

DRDC will probably succeed on the merits of its copyright infringement claim. To succeed on a copyright infringement claim, a plaintiff need only establish that: (1) it is the owner of the copyrighted work; and (2) defendants have copied the copyrighted work. *Sid & Marty Krofft Television Prods., Inc. v. McDonald's Corporation*, 562 F.2d 1157, 1162 (9th Cir. 1977).

1. *DRDC Owns Copyrights in the Show*

DRDC wrote THE **RAT PACK** IS BACK script and, therefore, owns the copyright in the script. Cassidy Decl. ' 23. Moreover, DRDC has taken all steps necessary to obtain a copyright registration for the show. The registration certificate will constitute prima facie evidence of the validity of the copyrights and DRDC's ownership. *See* 17 U.S.C. § 410(c); *see also Apple Computer, Inc. v. Formula Int'l, Inc.*, 725 F.2d 521, 523 (9th Cir. 1984).

2. *Defendants Copied DRDC's Show*

Copying is ordinarily proven circumstantially by evidence of access and substantial similarity. *Sid & Marty Krofft*, 562 F.2d at 1162.

a. *Defendants Had Access to the Copyrighted Work*

"[P]roof of access requires only an opportunity to view or to copy plaintiff's work." *Kamar International v. Russ Berrie & Co.*,

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657 F.2d 1059, 1062 (9th Cir. 1981).

TRP clearly had access to DRDC's copyrighted script for THE **RAT PACK** IS BACK show. Three of the actors TRP's show had previously performed in THE **RAT PACK** IS BACK. Accordingly, each of these actors had copies of DRDC's copyrighted work. Cassidy Decl. ¶ 24. Moreover, TRP had the opportunity to view the performance of THE **RAT PACK** IS BACK numerous times during its run at the Desert Inn and the Sahara in Las Vegas, before TRP started performing its competing show.

b. Defendants' Show is Substantially Similar *To DRDC's THE **RAT PACK** IS BACK Show*

TRP's THE **RAT PACK** RETURNS show is substantially similar to DRDC's copyrighted script for THE **RAT PACK** IS BACK show.

To determine whether two works are substantial similar, courts conduct a two?? prong analysis: the extrinsic and the extrinsic test. *Kouf v. Walt Disney Pictures & Television*, 16 F.3d 1042, 1045 (9th Cir. 1994). The extrinsic test is an objective measure of the "articulable similarities between the plot, themes, dialogue, mood, setting, pace. characters, and sequence of events." *Id.* The intrinsic test is a subjective test that focuses on the total concept and feel of the two works. *Id.* Under the "inverse ratio rule," the Ninth Circuit requires a lower standard of proof of substantial similarity when a high degree of access is shown. *Three Boys Music Corp. v. Bolton*, 212 F.3d 477, 485 (9th Cir. 2000).

Application of the extrinsic test supports finding of substantial similarity. The chart below identifies the articulable similarities that exist between DRDC's show and TRP's show:

	DRDC	TRP
Setting	December 12, 1961; Las Vegas casino	Early 1960s; Las Vegas casino
Plot	**Rat Pack** puts on show on night of Frank's birthday	**Rat Pack** comes back for one last show
Themes	Booze Women Ethnicity Religion Birthday	Booze Women Ethnicity Religion Birthday
Dialogue	1. Martini joke 2. Flaming pansy joke 3. Dentist joke	1. Same martini joke 2. Same flaming pansy joke 3. Same dentist joke
Music	Come Fly with Me	Yes
	Luck be a Lady Tonight	No
	Everybody Loves Somebody	Yes
	That's Amore	Yes
	Kick in the Head	Yes
	Sam's Song	Yes
	Old Black Magic	Yes
	What Kind of Fool Am I?	No
	Mr. Boj angles	Yes
	Similar original orchistrations	Yes

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	A Foggy Day	Yes
	Lady is a Tramp	Yes
	Birth of the Blues	Yes
Mood	Upbeat	Upbeat
Characters	Frank, Dean, Sammy, Joey, blonde woman	Frank, Dean, Sammy, Joey, Marilyn Monroe
Sequence of Events	Monologues, mixed duets/solos/ensembles	Monologues, mixed duets/solos/ensembles
Other	Voice of God used in joke Choreography for "Birth of the Blues"	Voice of God used in intro Same

Cassidy Decl. ¶ 25.

The intrinsic test is also satisfied in this case. Indeed, reporters have commented on the similarity in the overall look and feel of the two works. In reviewing Defendants' show in the *Las Vegas Review-Journal,* entertainment reporter Mike Weatherford stated that "[a]lumni of a Sahara production called 'The **Rat Pack** is Back' retreated, regrouped and reopened as "The Tribute to Frank, Sammy. Joey & Dean." Rob Garrett. The Voice of Vegas, characterized Defendants' show as "the unofficial remake" of DRDC's THE **RAT PACK** IS BACK show. Cassidy Decl. Exh. R.

Accordingly, DRDC will probably succeed on the merits of its copyright infringement claim.

II. THERE IS A POSSIBILITY THAT DRDC WILL SUFFER *IRREPARABLE INJURY IF INJUNCTIVE RELIEF IS NOT GRANTED*

As a matter of law, **trademark** infringement injures the **trademark** owner's good will and reputation associated with the mark. which is not compensable through an award of damages. *See Paisa, Inc. v. N&G Auto, Inc.,* 928 F. Supp. 1009.1012 (C.D. Cal. 1996). The Ninth Circuit has held that, in **trademark** infringement actions, "once the plaintiff establishes a likelihood of confusion. it is ordinarily presumed that the plaintiff will suffer irreparable harm." *Vision Sports, Inc. v. Melville Corp.,* 888 F.2d 609, 612 n.3 (9th Cir. 1989); *see also Century 21 Real Estate Corp. v. Sandlin,* 846 F.2d 1175. 1180 (9th Cir. 1988) (injunctive relief is the remedy of choice for **trademark** infringement or unfair competition because there is no adequate remedy at law). This presumption "effectively conflates the dual inquiries" of likelihood of success on the merits and irreparable injury "into the single question of whether the plaintiff has shown a likelihood of success on the merits." *Goto.com,* 202 F.3d at 1205 n.4. "[A] plaintiff is therefore entitled to a preliminary injunction in a **trademark** case simply when it shows a likelihood of confusion." *Id.* at n.5. Accordingly, DRDC only needs to establish a likelihood of success on the merits of its **trademark** infringement or unfair competition claims to obtain a temporary restraining order and preliminary injunctive relief against TRP. As discussed in Section I above, DRDC will probably succeed on the merits at trial.

Under copyright law, a plaintiff that demonstrates a likelihood of success on the merits of a copyright infringement claim is entitled to a presumption of irreparable harm. *Sun Microsystems, Inc. v. Microsoft Corporation,* 188 F.3d 1115, 1119 (9th Cir. 1999); *Cadence Design Systems v. Avant! Corp.,* 125 F.3d 824, 826-27 (9th Cir. 1997). *cert. denied,* 523 U.S. 1118 (1998). Because of the presumption of irreparable harm, a copyright owner only needs to show a reasonable likelihood of success on the merits to obtain a preliminary injunction. *See Micro Star v. Formgen, Inc.,* 154 F.3d 1107, 1109 (9th Cir. 1998); *Sony Pictures Entertainment, Inc. v. Fireworks Entertainment Group, Inc.,* 137 F. Supp. 2d 1177 (C.D. Cal. 2001). The presumption means that the balance of hardships issue cannot be accorded significant, if any, weight in determining whether a court should enter a preliminary injunction to prevent the use of infringing material in cases in which the plaintiff has made a strong showing of likely success on the merits. *Sun Microsystems,* 188 F.3d at 1119. As discussed in Section I above, DRDC will probably

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succeed on the merits of its copyright infringement claim.

In addition to the presumption of irreparable harm, DRDC is actually suffering harm. TRP's performance of a confusingly similar show under a confusingly similar mark has effectively foreclosed the Las Vegas market to DRDC. Indeed, venues are unwilling to book DRDC's show to compete with Defendants' substantially similar show. Cassidy Decl. ¶ 27.

CONCLUSION

The Court should grant DRDC's motion for a preliminary injunction enjoining Defendants from: (1) using THE **RAT PACK** RETURNS or any **RAT PACK** formative mark in connection with any kind of live show; and (2) enjoin Defendants from performing its show using the protectible elements of DRDC's show.

Appendix not available.

DRDC PRODUCTION, INC., a Delaware corporation, Plaintiff, v. TRP ENTERTAINMENT LLC, a Nevada limited liability corporation; Sandy Hackett, an individual; Convention Center Drive Hotel and Casino Llc dba Greek Isles Hotel and Casino, Defendants.
2005 WL 3780957 (D.Nev.) (Trial Motion, Memorandum and Affidavit)

END OF DOCUMENT

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EXHIBIT K

EXHIBIT K

For Dockets See 2:05CV00673

United States District Court, D. Nevada.
DRDC PRODUCTIONS, INC., a Nevada corporation, Plaintiff,
v.
TRP ENTERTAINMENT, LLC, a Nevada limited liability corporation, Sandy Hackett, an individual, Richard Feeney, an individual, Convention Center Drive Hotel and Casino Llc dba Greek Isles Hotel and Casino, Defendants.
Case No. CV-S-05-0673-PMP-PAL.
June 6, 2005.

Opposition to Motion for Temporary Restraining Order

The Defendants, by and through their attorneys WATSON ROUNDS, and submit the following points and authorities in opposition to the Plaintiffs Motion for Temporary Restraining Order. This opposition is supported by the accompanying declarations of Sandy Hackett and Michael D. Rounds, the following points and authorities, and all pleadings and papers on file herein.

I. INTRODUCTION

TRP Entertainment, LLC. (TRP) produces a musical stage show called The Tribute to Frank, Sammy, Joey and Dean. As implied by the name, it is a musical and comedy show involving **Rat Pack** impersonators. The show was introduced in Las Vegas at the Greek Isles Hotel and Casino on May 24, 2002, and has played continuously there and throughout the United States since that time. Hackett Decl. ¶¶ 6, 16. With full knowledge of these circumstances, DRDC now seeks to shut the show down with one day of notice, putting 40-50 people out of work and causing the breach of numerous contracts. Hackett Decl. ¶¶ 17-17C. There is no basis in law or fact for this request - none.

As to its copyright allegations, DRDC has no copyright registration for its alleged work, an omission that is fatal to its claim. Motion, Exhibit Q. DRDC has delayed more than six (6) years in filing its registration because it has little or no rights to begin with. DRDC apparently purloined its script from a third party, and seeks to protect elements of its alleged show that are either not its own or are in the public domain. Hackett Decl. ¶¶ 2-2B. In short, DRDC cannot in good faith claim that TRP's original show has copied any protectable elements of DRDC's it is DRDC who is the copyist. Hackett Decl. ¶¶ 6-6F, 15-15G.

As to its **trademark** allegations, DRDC can lay no claim to the generic term **Rat Pack**. This is a media-generated term that has been used to refer to Frank Sinatra, Sammy Davis, Jr., Dean Martin and Joey Bishop since the 1960's. Hackett Decl. ¶ 2A. It is used by third parties everywhere. Rounds Decl. ¶3-3Y, Exhibit 9. The term has been used for movies, books, restaurants, golf tournaments, websites, and numerous other products or services to connote one thing - the original members of the **Rat Pack**. Id. Placed in the proper context then, DRDC has no **trademark** claim. A descriptive statement that the **Rat Pack** returns or the use of ratpackvegas.com can in no way generate confusion with DRDC's narrow or generic mark THE **RAT PACK** IS BACK. DRDC's infringement allegations are therefore at best, wishful thinking.

In sum, DRDC has delayed a long time to file a bad case. The Motion for Temporary Restraining Order must be

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denied.

II. ARGUMENT

A. PRELIMINARY INJUNCTION AND TEMPORARY RESTRAINING ORDER STANDARDS

A temporary restraining order or preliminary injunction is an extraordinary remedy, which should be granted only in limited circumstances. *Miracle Blade, LLC. v. Ebrands Commerce Group, LLC.* 207 F.Supp.2d. 1136, 1147 (D.Nev. 2002). A court may issue a preliminary injunction if it decides: (1) the movant will likely succeed on the merits; (2) the movant will be irreparably harmed if an injunction does not issue; (3) the balance of hardships favors the movant; and (4) the public interest favors granting relief. *Great Basin Brewing Co. v. Healdsburg Brewing Co.*, 44 U.S.P.Q.2d 1751, 1752-1753 (D. Nev. 1997), citing *International Jensen Inc. v. Metrosound U.S.A., Inc.*, 4 F.3d 819, 822 (9th Cir. 1993). The Ninth Circuit has also adopted an alternative standard whereby a movant may meet its burden for obtaining a preliminary injunction if he or she demonstrates either: (1) a combination of probable success on the merits and the possibility of irreparable injury if relief is not granted; or (2) the existence of serious questions going to the merits and that the balance of hardships tips sharply in its favor. *International Jensen*, 4 F.3d at 822. The alternative standards are not separate tests but the outer reaches of a single continuum. *Id.* (citations omitted). Essentially, the trial court must balance the equities in the exercise of its discretion. *International Jensen*, 4 F.3d at 822.

These same tests are often used for a temporary restraining order. However, specifically, a temporary restraining order may only be granted if( ) it appears from specific facts shown by affidavit or by the verified complaint that immediate and irreparable injury, loss, or damage will result to the applicant before the adverse party or that party's attorney can be heard in opposition, and (2) the applicant's attorney certifies to the court in writing the efforts, if any, which have been made to give the notice and reasons supporting the claim that notice should not be required. Fed. R.Civ.P. 65(b).

The only grounds offered by DRDC for a Temporary Restraining Order are the fact that auditions are taking place in Detroit, and the Detroit show is set to begin on June 7, 2005. Given that the show has been running continuously since May 24, 2002 in Las Vegas and other venues, these are not immediate and irreparable circumstances under Rule 65(b). In addition, a TRO at this stage would inflict serious financial harm on TRP, and perhaps destroy a successful show forever.

Because Plaintiffs cannot meet their significant and exigent burden with respect to the issuance of a TRO, the motion should be denied. The following arguments make this conclusion crystal clear.

B. COPYRIGHT ISSUES

1. PLAINTIFF CANNOT SUCCEED ON ITS COPYRIGHT INFRINGEMENT CLAIMS

The entire predicate for Plaintiffs request to immediately shut down TRP's musical production in Las Vegas, Detroit and San Francisco, is its copyright infringement claims. In order for the court to have jurisdiction over the copyright infringement claim, the Plaintiff must have a valid copyright registration. The statutory language for this requirement is found at 17 U.S.C. §41 (a), where it states that [n]o action for copyright infringement in any work shall be instituted until registration of the copyright claim has been made ... This means that a party *must* have a certificate of registration at the time of filing suit, and without one the court has no jurisdiction. *Kodadek v. MTV Networks, Inc.* 152 F.3d 1209, 1211 *(9th* Cir.1998); See, *M.G.B. Homes, Inc. v. Ameron Homes, Inc.* 903 F.2d 1486, 1488 (11th Cir. 1990); *Haan Crafts Corp. v. Craft Masters, Inc.*, 683 F.Supp. 1234, 1242 (N.D.Ind. 1988) ([A] lawsuit for copyright infringement cannot be filed unless plaintiff has a registered copyright.... This is a jurisdictional requirement which must be satisfied before a federal court can entertain a copyright infringement claim.); *Demetriades v. Kaufmann*, 680 F.Supp. 658, 661

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(S.D.N.Y.1988) (Receipt of an actual certificate of registration or denial of same is a jurisdictional requirement, and this court cannot prejudge the determination to be made by the Copyright Office.); *Dodd v. Fort Smith Special School District No. 100*, 666 F.Supp. 1278, 1282 (W.D.Ark. 1987) (Under the Copyright Act ... registration of the copyright, while not a prerequisite to having a protectable interest, is a jurisdictional prerequisite to the initiation of an infringement suit in federal court.); Quincy *Cablesystems, Inc. v. Sully's Bar, Inc.*, 650 F.Supp. 838, 850 (D.Mass.1986) (Copyright registration under § 411(a) is a condition precedent to filing an infringement action.); *Wales Industrial, Inc. v. Hasbro Bradley, Inc.*, 612 F.Supp. 510, 515 (S.D.N.Y.1985) (Registration of a copyright claim is a jurisdictional prerequisite to a suit for infringement.); *Conan Properties, Inc. v. Mattel, Inc.*, 601 F.Supp. 1179, 1182 (S.D.N.Y.1984) (Without registration of the copyrights the suit is barred and absent an allegation that the copyrights have been registered the complaint is defective.)

Although the Plaintiff has supplied evidence that it has filed a copyright application, it has not provided any evidence that it has obtained a copyright registration. As a result, the claim for copyright infringement is defective and cannot form the basis for either a TRO or a preliminary injunction.

2. PLAINTIFF CANNOT DEMONSTRATE THAT THERE IS AN INFRINGEMENT.

In order to establish copyright infringement, a party must demonstrate: (1) ownership of a valid copyright, and (2) infringement of that copyright by invasion of one of the exclusive ownership rights. *Miracle Blade*, 207 F.Supp.2d. at 1147. The exclusive ownership rights include: (1) the right to reproduce the copyrighted work; (2) the right to prepare derivative works based on the copyrighted work; (3) the right to distribute copies of the copyrighted work; (4) the right to perform the work publicly; and/or (5) the right to display the copyrighted work publicly. *Id.* at 1147.

As previously stated, DRDC has not demonstrated ownership of a valid copyright because it has not provided a copyright registration. Furthermore, it cannot demonstrate that there has been an infringement of one of the exclusive ownership rights. DRDC claims that TRP infringed its copyright by copying its script. Copying can be shown by circumstantial evidence of access to the copyrighted work, and substantial similarity between the copyrighted work and the infringer's work. *Id.*, at 1149. Although Defendant Sandy Hackett had access to the DRDC's production (the performance was open to the public) and Defendant Hackett saw the performance twice, he had no script of the production until the Plaintiff's Motion for Preliminary Injunction was filed. Hackett Decl. ¶ 6F. No relevant access to the copyrighted work therefore exists.

In addition to the lack of access, DRDC cannot prove substantial similarity between the scripts. To determine whether two works are substantially similar, the court must undergo the following procedure: (1) determine through analytic dissection the scope of the copyright; (2) determine whether the works are extrinsically similar; and (3) determine whether the works are intrinsically similar. *Id.* at 1149.

DRDC alleges that Defendants copied the following elements from its musical production: (1) the setting; (2) the plot; (3) themes; (4) dialogue; (5) music; (6) mood; (7) characters; (8) sequence of events; and (9) the use of the voice of God. The first step is for the court to determine, through analytic dissection and expert testimony if needed, if any of these elements are protected by copyright. *Id.* at 1150. In doing so, the court must consider the applicable doctrines that narrow the scope of copyright protections, such as merger, scenes a faire and originality. *Id.* At 1150.

Mr. Hackett indicates that the Plaintiffs production was taken from an earlier **Rat Pack** production by Ronald Onesti of Onesti Entertainment that was performed in Chicago. Hackett Decl. ¶ 1. This is hardly surprising considering there have been hundreds of **Rat Pack** related shows since the nickname came into existence in the 1960's. Hackett Decl. ¶ 2B.

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The *scenes a fair* doctrine applies to certain of the elements that DRDC claims infringe. Essentially the scenes a fair doctrine recognizes that certain elements are standard treatment for a particular idea. The setting for TRP's musical production is in the 1960's in a Las Vegas casino. The setting in the 1960's in a Las Vegas casino is standard treatment for a show based on the **Rat Pack**, since that is the setting and that is the time period when they actually performed. Likewise, the themes of booze, women, ethnicity and religion were the themes utilized by the **Rat Pack** in the 1950's and 1960s. Those themes were the essence of the **Rat Pack**. Hackett Decl. ¶ 15B. The mood, and the cast of characters, to the extent they are impersonations of the original members of the **Rat Pack**, are similarly elements that are standard for a **Rat Pack** the med show.

The other elements, to the extent they contain any originality, cannot survive the extrinsic test for substantial similarity. As to the point concerning setting and plot, it is evident from Mr. Cassidy's own comments that the two shows are substantially different. Haskett Decl. ¶ 15A. DRDC's production uses a theme of Frank Sinatra's birthday party TRP's production does not. TRP's show has a Marilyn Monroe character who sings Happy Birthday to a member of the audience - the Plaintiff's production does not even have a Marilyn Monroe character. Hackett Decl. ¶ 15B.

DRDC has reduced the dialogue comparison to three jokes even though there is a substantial amount of other dialogue in TRP's production. The martini joke is a joke that was conceived by Rick Michel who performed the joke prior to the Plaintiff's production and gave TRP consent to use it. Hackett Decl. 15C. The Flaming Pansy joke is a take-off of a gay joke, i.e. how do you make a fruit cordial that was often performed by the **Rat Pack**. The punch line that TRP uses is different. Hackett Decl. ¶ 15C. The concept was an original creation of the **Rat Pack** and is not protectable by the Plaintiff. Finally, the Dentist Joke is a joke that was created by Sandy Hackett's father, Buddy Hackett and TRP (if anyone) has the exclusive right to use it. Hackett Decl. ¶ 15C.

The music in both shows is primarily **Rat Pack** era music, with the various selections in either production taken from three (3) **Rat Pack** era CDs. Hackett Decl. ¶ 15D. The Plaintiff does not have any exclusive rights to use the songs, and they are performed daily around the world. Hackett Decl. ¶ 15D. TRP's musical production also includes some additional songs not included in Plaintiff's musical production, to-wit: New York, New York; My Way; and Come Fly with Me. Hackett Decl. ¶ 15D. Furthermore, the sequence of the songs is entirely different. *Compare,* Exhibit 4 to Exhibit Q.

The fact that there are monologues, mixed duets, solos and ensembles is standard **Rat Pack** fare. The sequence of events and how those are put together are substantially different. Hackett Decl. ¶ 15E.

Finally, DRDC claims that the use of the voice of God was copied. DRDC uses the voice of God in a gambler joke at the end of the show, and TRP uses the voice of God in the introduction. The inspiration for using the voice of God came from the idea of the deceased **Rat Pack** members being (hopefully) in heaven, not DRDC's show. Hackett Decl. ¶ 15F.

The works are also different intrinsically. The intrinsic test is a subjective one that evaluates, from the standpoint of an ordinary consumer, whether there is substantial similarity in the total concept and feel of the works. Id. at 1151. In order to gauge the difference in the total concept and feel of the works it is necessary to view the actual productions. A copy of each of the productions is provided to the court with the filing of this opposition, and they are substantially different. Hackett Decl., Exhibit 8.

In summary, given the fact that the Plaintiff's show was pirated from an earlier **Rat Pack** musical production, it is questionable as to how much, if any, originality in DRDC's script is deserving of protection. To the extent any originality exists, the comparable elements of TRP's script are substantially different, as are the total concept and feel of the works to the ordinary consumer. Even if the merits are reached then, DRDC has no claim for copyright in-

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fringement.

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C. **TRADEMARK** ISSUES

1. PLAINTIFF'S MARK IS ONLY ENTITLED TO A VERY NARROW SCOPE OF PROTECTION.

The central inquiry of a **trademark** infringement claim is whether the similarity of the marks is likely to confuse consumers about the source of the goods or services. *See* Goto.com v. *Walt Disney Company*, 202 F.3d 1199, 1207 (9th Cir. 2000). The Ninth Circuit has identified eight factors which are relevant to the determination of likelihood of confusion:

(1) Strength of the plaintiffs mark;

(2) Proximity of the goods offered;

(3) Similarity of the marks;

(4) Evidence of actual confusion;

(5) Similarity of marketing channels;

(6) Similarity of the type of goods and purchaser care;

(7) Defendant's intent in adopting the infringing mark; and

(8) The likelihood of expansion of defendant's product line. *AMF, Inc. v. Sleekcraft Boats*, 599 F.2d 341, 348-49 (9th Cir. 1979); *see also*, *Century 21 Real Estate Corp. v. Sandlin*, 846 F.2d 1175, 1179 (9th Cir. 1988); *Wells Fargo & Co. v. Wells Fargo Construction Co.*, 619 F.Supp 710, 712 (D. Ariz. 1995). When these factors are applied to the **trademarks** at issue, it is clear that the Plaintiff is not likely to prevail on the merits of its federal **trademark** infringement claims.

A. Strength Of The Marks

The strength of a **trademark** in the marketplace and the degree of protection it is entitled to are categorized by the degree of the mark's distinctiveness in the following ascending order: generic, descriptive, suggestive, and arbitrary or fanciful. *Gruner + Jahr USA Pub., a Div. of Gruner + Jahr Printing and Pub. Co. v. Meredith Corp.* 991 F.2d 1072, 1075 (2nd Cir. 1993) A generic mark is afforded no protection. *E. & J. Gallo Winery v. Gallo Cattle Co.* 955 F.2d 1327, 1338 (9th Cir. 1992). A descriptive mark tells something about the product; it will be protected only when secondary meaning is shown. *AMF Inc. v. Sleekcraft Boats*, 599 F.2d 341, 349 (9th Cir. 1979); *see Miss Universe, Inc. v. Patricelli*, 408 F.2d 506 (2nd Cir. 1969).

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Although less distinctive than an arbitrary or fanciful mark and therefore a comparatively weak mark, a suggestive mark will be protected without proof of secondary meaning. *Watkins Products, Inc. v. Sunway Fruit Products, Inc.*, 3 1 F.2d 496 (7th Cir. 1962).

In the case of *Narwood Productions, Inc. v. Lexington Broadcast Services, Co., Inc.* 541 F.Supp. 1243, 1248 (D.C.N.Y., 1982) the court had to determine the strength of the mark The Music Makers. The court stated that an argument can be made for characterizing the term as either descriptive or suggestive. On the one hand, contrary to Narwood's assertion that the term gives no clue about the program, The Music Makers is arguably descriptive of the general musical nature of the program and the type of performer featured on it. The court rejected the argument that it could be generic because the term is not the name of a particular class of television or radio programs. *Id.* at 1248.

Narwood's logic helps here because DRDC's alleged mark THE **RAT PACK** IS BACK describes the particular class of entertainment services being offered, i.e. it describes **Rat Pack** era music and entertainment. As used with respect to entertainment services, namely, live stage musical productions the mark is therefore generic and not deserving of any protection. *E. & J. Gallo Winery v. Gallo Cattle Co.* 955 F.2d 1327, 1338 (9th Cir. 1992).

Third-party registrations and use are also relevant to prove that some segment of the composite marks which both contesting parties use has a normally understood and well-recognized descriptive or suggestive meaning, leading to the conclusion that that segment is relatively weak. *Petro Stopping Centers, L.P. v. James River Petroleum, Inc.* 130 F.3d 88, 94 (4th Cir. 1997) *citing First Sav. Bank, F.S.B. v. First Bank Sys. Inc.*, 101 F.3d 645, 654 (10th Cir. 1996) (quoting 1 J. Thomas McCarthy, McCarthy on **Trademarks** and Unfair Competition § 11.27[2] [b] (3d ed.1995)). The Affidavit of Michael D. Rounds sets forth the numerous marks containing the term **Rat Pack** which are reported as being used or sought after. This indicates the obvious, i.e. that **Rat Pack** has a commonly understood and well-recognized descriptive meaning which does not support anything beyond a narrow scope of **trademark** protection.

In summary, DRDC's mark THE **RAT PACK** IS BACK is either a generic term or weak mark deserving of no protection or a very narrow scope of protection.

B. Proximity Of The Goods Offered

Both the Plaintiff and Defendant TRP are offering live musical theatrical productions. It is believed that the Plaintiff has held performances in Connecticut and Indiana during the last couple of years, while TRP's shows have been in Las Vegas and elsewhere. TRP does not seriously contest this minor point, other than to point out that DRDC's show has had very little activity recently.

C. Similarity Of The Marks

DRDC claims that TRP is using the marks THE **RAT PACK** RETURNS, **RAT PACK** VEGAS and other **RAT PACK** formative marks. However, TRP is only using the phrase The **Rat Pack** Returns in ... in the descriptive sense, and not as a title or **trademark** for the show. Hackett Decl. ¶ 10. Under the common law fair use defense, a junior user is always entitled to use a descriptive term in good faith in its primary, descriptive sense other than as a **trademark**. *Brother Records, Inc. v. Jardine* 318 F.3d 900, 905 906 (9th Cir. 2003)(quoting 2 J. Thomas McCarthy, McCarthy on **Trademark** and Unfair Competition § 11:45 (4th ed.2001)).

As to the use of the use of the generic term **Rat Pack**, not only does the Plaintiff not have a registration for this term, the term has been used to refer to a particular music and era for more than forty (40) years. Hackett Decl. ¶¶ 2A-2B. If

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anyone has a right to use the term, it would be Defendant Sandy Hackett who received a license directly from Joey Bishop, one of the **Rat Pack** members. Hackett Decl. ¶ 6F, Exhibit 5. In spite of this, the term **Rat Pack** is a generic reference to the group of performers that performed together in the 1950's and 1960's and is not owned by Plaintiff or anyone else.

As to the use of the ratpackvegas.com domain name, due to the narrow scope of protection afforded Plaintiffs alleged mark THE **RAT PACK** IS BACK, the domain name use is simply different. How could a consumer possibly believe these names are similar when the term **Rat Pack** has been used generically for 40 years, and there are third parties throughout the United States using derivative variations? There is no such possibility - the names are dissimilar.

D. Evidence Of Actual Confusion

DRDC has admitted that it has no evidence of actual confusion. Although it is not absolutely necessary to have actual confusion to establish a likelihood of confusion, it is an element in TRP's favor. Moreover, DRDC's lack of actual confusion evidence is particularly noteworthy because it highlights the crowded marketplace and the inherent weakness of DRDC's alleged mark.

E. Marketing Channels

It is believed that DRDC and TRP utilize similar marketing channels to advertise their respective shows. However, they have always operated in different cities at any one time which decreases the likelihood of any confusion.

F. Types Of Goods And Customer Care

Unlike a trip to a movie, and in-part due to the increasing price of show tickets, consumers generally exercise a significant degree of care before purchasing tickets of a theatrical musical production. It is likely to involve visits to web sites, the reading of reviews and considering recommendations from friends. Due to the degree of customer care and advance preparation, it is unlikely that any confusion would result. This factor therefore favors TRP.

G. Defendant's Intent In Selecting the Marks

Given the general use of **Rat Pack** term, and the massive third party use in existence, there is no credible argument that TRP has attempted to trade upon the goodwill of the alleged **RAT PACK** IS BACK mark. Instead, TRP has gone out of its way not to tread on DRDC's purported rights in THE **RAT PACK** IS BACK mark. It specifically changed its billboard, taxi cab and magazine advertisements in 2002 so as to avoid DRDC's claims, and its present use is purely a descriptive one. Hackett Decl. ¶ 8.

In short, TRP did not select any mark to cause confusion, and has only sought in good faith to avoid DRDC's over-reaching claims.

H. The Likelihood Of Expansion Of Defendant's Operations

DRDC has conceded that the likelihood of expansion factor is irrelevant under the instant circumstances.

I. Conclusion on **Trademark** Infringement.

Based on the above factors and Plaintiffs inherently weak mark, DRDC is unlikely to succeed on the merits at trial on

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its **trademark** infringement allegations. In fact, DRDC's ownership claims to the **Rat Pack** term is itself an act of unfair competition, subject to appropriate counterclaim.

D. PLAINTIFF WILL NOT SUFFER ANY IRREPARABLE HARM WITHOUT INJUNCTIVE RELIEF.

TRP's musical production has been showing in Las Vegas since May 24, 2002. After all this time, Plaintiff now seeks a TRO claiming that it will be irreparably harmed in the absence of an immediate injunction. It has not articulated any specific irreparable harm but instead relies on a presumption of irreparable harm that goes along with a showing of a likelihood of confusion. As pointed out by TRP above, there is no likelihood of confusion and thus no presumption of irreparable harm. Although a particular period of delay may not rise to the level of laches and thereby bar a permanent injunction in **trademark** infringement case, it does indicate an absence of the kind of irreparable harm required to support a preliminary injunction. *Seiko Kabushiki Kaisha v. Swiss Watch Intern., Inc.* 188 F.Supp.2d 1350, 1351 (S.D.Fla. 2002). The delay in seeking injunctive relief is a clear indication that Plaintiff has no valid argument for irreparable harm, and an injunction at this point in time should be denied on the basis of laches.

E. THE BALANCE OF HARDSHIPS FAVORS TRP AND SUPPORTS THE DENIAL OF PLAINTIFF'S MOTION.

If the injunctive relief requested by DRDC were granted, TRP would incur enormous hardship and financial loss. Hackett Decl. ¶ 17. In Las Vegas alone, TRP and the Greek Isles would have to layoff 40-50 employees. Hackett Decl. ¶ 17A. TRP would lose approximately $20,000 per week in profits and the Greek Isles would lose substantial gaming revenue. Id. Moreover, if the Detroit show were canceled now that all of the contracts are in place, TRP would lose up to $250,000 in profits and be subject to numerous breach of contract claims. Hackett Decl. ¶ 17B. Similar harm would occur in San Francisco. Hackett Decl. ¶ 17C. Although there is no basis to discuss a bond given DRDC's poor showing, DRDC would need to post a bond in the amount of least one million dollars ($1,000,000.00) to cover the Defendants' potential losses.

F. PUBLIC INTEREST FAVORS DENIAL.

There is no public interest in rewarding DRDC with its poor showing and this factor favors denial of the Motion for Temporary Restraining Order.

II. CONCLUSION

For all of the above reasons, DRDC's Motion for a Temporary Restraining Order must be denied.

Appendix not available.

DRDC PRODUCTIONS, INC., a Nevada corporation, Plaintiff, v. TRP ENTERTAINMENT, LLC, a Nevada limited liability corporation, Sandy Hackett, an individual, Richard Feeney, an individual, Convention Center Drive Hotel and Casino Llc dba Greek Isles Hotel and Casino, Defendants.
2005 WL 3780963 (D.Nev.) (Trial Motion, Memorandum and Affidavit)

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EXHIBIT "L"

EXHIBIT "L"

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UNITED STATES DISTRICT COURT
DISTRICT OF NEVADA

TRP ENTERTAINMENT, LLC, Plaintiff, v. BC ENTERTAINMENT, INC., *et al.*, Defendants.	Case No. 2:08-cv-0579-LDG (RJJ) **ORDER**
BC ENTERTAINMENT, INC., *et al.*, Counterclaimants, v. TRP ENTERTAINMENT, LLC, Counterdefendant.	

TRP Entertainment, LLC, the plaintiff/counterdefendant, alleges that the defendant's use of the marks "Rat Pack - Frank, Sammy, and Dean," "The Rat Pack A Tribute to Frank, Dean & Sammy," and "Rat Pack" infringes its registered mark "The Rat Pack is Back," and its common-law mark "The Tribute to Frank, Sammy, Joey, and Dean." Barrie Cunningham, the defendant/counterclaimant, counters with claims seeking a declaration

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that "The Rat Pack" is generic and cannot be exclusively owned or registered by any party, that his marks do not infringe TRP's marks. Cunningham also seeks the cancellation or modification of TRP's registration of the "The Rat Pack is Back" mark.

Cunningham moves for partial summary judgment (#23) as to his claims that "The Rat Pack" is generic, that he has not infringed TRP's marks, and for the modification of TRP's registration of the "The Rat Pack is Back" mark. TRP opposes the motion (## 27, 28).[1]

Motion for Summary Judgment

In considering a motion for summary judgment, the court performs "the threshold inquiry of determining whether there is the need for a trial—whether, in other words, there are any genuine factual issues that properly can be resolved only by a finder of fact because they may reasonably be resolved in favor of either party." *Anderson v. Liberty Lobby, Inc.*, 477 U.S. 242, 250 (1986). To succeed on a motion for summary judgment, the moving party must show (1) the lack of a genuine issue of any material fact, and (2) that the court may grant judgment as a matter of law. Fed. R. Civ. Pro. 56(c); *Celotex Corp. v. Catrett*, 477 U.S. 317, 322 (1986).

A material fact is one required to prove a basic element of a claim. *Anderson,* 477 U.S. at 248. The failure to show a fact essential to one element, however, "necessarily renders all other facts immaterial." *Celotex*, 477 U.S. at 323.

"[T]he plain language of Rule 56(c) mandates the entry of summary judgment, after adequate time for discovery and upon motion, against a party who fails to make a showing sufficient to establish the existence of an element essential to that party's case, and on

---

[1] TRP has also moved for entry of a default (#48) against defendant BC Entertainment, Inc. Previously, the court has stricken the answer and counterclaim of BC Entertainment for failure to appear in this matter through counsel, as is required of a corporation. BC Entertainment has yet to have counsel appear on its behalf. Accordingly, the court will grant the motion for default.

which that party will bear the burden of proof at trial." *Id.* "Of course, a party seeking summary judgment always bears the initial responsibility of informing the district court of the basis for its motion, and identifying those portions of 'the pleadings, depositions, answers to interrogatories, and admissions on file, together with the affidavits, if any,' which it believes demonstrate the absence of a genuine issue of material fact." *Celotex*, 477 U.S. at 323. As such, when the non-moving party bears the initial burden of proving, at trial, the claim or defense that the motion for summary judgment places in issue, the moving party can meet its initial burden on summary judgment "by 'showing'–that is, pointing out to the district court–that there is an absence of evidence to support the nonmoving party's case." *Celotex*, 477 U.S. at 325. Conversely, when the burden of proof at trial rests on the party moving for summary judgment, then in moving for summary judgment the party must establish each element of its case.

Once the moving party meets its initial burden on summary judgment, the non-moving party must submit facts showing a genuine issue of material fact. Fed. R. Civ. Pro. 56(e). As summary judgment allows a court "to isolate and dispose of factually unsupported claims or defenses," *Celotex*, 477 U.S. at 323-24, the court construes the evidence before it "in the light most favorable to the opposing party." *Adickes v. S. H. Kress & Co.*, 398 U.S. 144, 157 (1970). The allegations or denials of a pleading, however, will not defeat a well-founded motion. Fed. R. Civ. Pro. 56(e); *Matsushita Elec. Indus. Co. v. Zenith Radio Corp.*, 475 U.S. 574, 586-87 (1986).

Whether the term "The Rat Pack" is Generic

Cunningham seeks a declaration that the term "The Rat Pack" is a generic reference to the members of the Rat Pack. As such, he contends that he may use the generic term "The Rat Pack" as part of a title of a show in tribute to the members of the Rat Pack. Further, as a generic term, he argues that TRP's trademark registration for "The Rat Pack is Back" should be modified to disclaim the generic term "The Rat Pack."

In considering this question, the court must initially note that the specific question presented by Cunningham is whether the term "The Rat Pack" is generic. Stated otherwise, Cunningham has not asked the court to decide whether TRP's entire mark, "The Rat Pack is Back" is generic. Rather, he seeks a ruling that a component of TRP's mark is generic, and thus that TRP does not have an exclusive right to the use of the component. To the extent that TRP has opposed Cunningham's motion by arguing that its entire mark, "The Rat Pack is Back," is not generic, such argument is irrelevant. The issue is not whether TRP has an exclusive right to use the mark "The Rat Pack is Back," but whether it has an exclusive right to use the component term "The Rat Pack." *See, In re Save Venice New York, Inc.*, 259 F.3d 1346, 1353 (Fed.Cir. 2001) ("A registered mark is incontestable only in the form registered and for the goods or services claimed"); In re National Data Corp., 753 F.2d 1056, 1059 (Fed.Cir. 1985) ("registration affords prima facie rights in the mark as a whole, not in any component").

Further, while TRP refers to its mark as the Rat Pack Mark, the registered mark is not the term "Rat Pack," or the term "The Rat Pack," each of which is merely a component of the entire mark: "The Rat Pack is Back." Thus, the court will consider TRP's arguments regarding whether the term "The Rat Pack" is generic only to the extent that TRP's arguments address whether the "The Rat Pack" component of its entire mark is or is not generic.

"A 'generic' term is one that refers, or has come to be understood as referring, to the genus of which the particular product or service is a species. It cannot become a trademark under any circumstances." *Surgicenters of America, Inc. v. Medical Dental Surgeries Co.*, 601 F.2d 1011, 1014 (9th Cir. 1979) (citing *Abercrombie & Fitch Co. v. Hunting World, Inc.*, 537 F32d 4, 9-10 (2nd Cir. 1976). The Ninth Circuit has often relied upon the "who-are-you/what-are-you" test to determine whether a term is generic. *See Filipino Yellow Pages, Inc. v. Asian Journal Publ'n, Inc.*, 198 F.3d 1143, 1147 (9th Cir.

1999). "A mark answers the buyer's questions 'Who are you?' 'Where do you come from?' 'Who vouches for you?' But the [generic] name of the product answers the question 'What are you?'" *Official Airline Guides, Inc. v. Goss*, 6. F.3d 1385, 1391 (9th Cir. 1993 (quoting 1 J. Thomas McCarthy, *Trademarks and Unfair Competition* §12.01 (3d ed. 1992)). "'A generic term is one that refers to the genus of which the particular product is a species.'" *Committee for Idaho's High Desert, Inc. v. Yost*, 92 f.3d 814, 821 (9th Cir. 1996) (quoting *Park 'N Fly, Inc. v. Dollar Park and Fly, Inc.*, 469 U.S. 189, 194 (1985). "Genus is the broader, more inclusive classification, while species are groupings within a given genus." 2 McCarthy, §12:23 (4th ed. 2007).

Cunningham offers extensive evidence, undisputed by TRP, that the term "The Rat Pack" is recognized by the consuming public as a reference to a group of entertainers: typically identified as Frank Sinatra, Dean Martin, Sammy Davis, Jr., Joey Bishop, and Peter Lawford. This group of entertainers, either in total or in various combinations, appeared together in live stage performances and in movies during the 1960s. The entertainers, themselves, did not generally identify themselves as the Rat Pack. Rather, the reference appears to have been adopted by the popular media to refer to members of the group, often in reference to their joint live (and often impromptu) show appearances. Cunningham's evidence establishes that, subsequent to the 1960s, numerous and various different types of products, including books, documentaries, movies, and compact disc or DVD recordings (including recordings of joint performances from the 1960s), have used the term "The Rat Pack" to identify that the underlying product concerns this group of entertainers or is a recording of a joint entertainment performance involving this group of entertainers.

As noted, from its initial use as a reference to this group of entertainers, the entertainers did not use the term "The Rat Pack" to identify the origin of a good or service offered by the group. Rather, "The Rat Pack" was a term used by other persons or entities

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to refer to the group of entertainers, or to the activities of the group, or to indicate that an offered service or good concerned this group of entertainers in some fashion.

TRP has not offered any evidence to the contrary. Rather, and at most, TRP has merely argued that such evidence is irrelevant to whether its entire mark is a generic reference to all live musical entertainment shows. TRP's argument, however, presents a question that is irrelevant to Cunningham's motion. In the context of live musical performances and TRP's show, "The Rat Pack" does not answer the question of "Who is performing the live show?" The existing meaning of "The Rat Pack" as a reference to members of the Rat Pack and their joint live performances of the 1960s establishes this. The live show is not "The Rat Pack," nor would any consumer recognize the show as one performed by "The Rat Pack" or by members of the Rat Pack. Rather, as suggested by TRP's common-law mark, TRP's live entertainment show is a tribute to members of the Rat Pack. At most, "The Rat Pack" informs the consumer that TRP's live show is about the music and performances that the members of the Rat Pack jointly performed in the 1960s, not that the show is "The Rat Pack."

Stated succinctly, Cunningham's evidence establishes that, long before TRP offered live musical shows, the term the "The Rat Pack" had a meaning that was used in connection with the joint performances of members of the Rat Pack during the 1960s. While some of these performances included movie appearances, typically the joint performances were live musical performances. Since the 1960s, the term "The Rat Pack" has been used by producers of many types of goods or services to indicate that the goods or services relates to members of the Rat Pack or to the joint movie or live (or recorded) musical or movie performances of the Rat Pack during the 1960s. From its initial use to refer to members of the group, particularly when jointly performing live musical entertainment, "The Rat Pack" did not and, indeed, could not refer to or identify TRP's live musical show.

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By contrast, TRP has not offered any evidence that, in using the term "The Rat Pack" in connection with its live musical show, it has deviated from this existing usage. Rather, TRP's own common-law mark indicates that it adopted the term "The Rat Pack" to draw upon consumers' association of the term with the Rat Pack. In the context of live shows, "The Rat Pack" standing alone, answers only the question "What?" not "Who?" "The Rat Pack" is not a reference to TRP's show, but a reference indicating that the live musical show concerns or is about about the Rat Pack. The question before the court on Cunningham's partial motion for summary judgment is not whether "The Rat Pack is Back" identifies and distinguishes TRP's show in tribute to members of the Rat Pack from all other such live shows. Rather, the only question is whether the component term "The Rat Pack" so distinguishes TRP's live show from all others about or in tribute to the Rat Pack. The evidence establishes that it does not and that TRP cannot appropriate the term "The Rat Pack" for its exclusive use.

As the term "The Rat Pack" is generic in the context of live shows about or in tribute to members of the Rat Pack, TRP does not have an exclusive right to use the term "The Rat Pack." The mere fact that Cunningham has used the term "The Rat Pack" in connection with a Rat Pack tribute show did not, does not, and cannot infringe TRP's registered mark. The court cannot, however, agree with Cunningham that he is entitled to a declaration that every use he makes of the component term "The Rat Pack" is non-infringing. The present record does not permit the court to evaluate or consider Cunningham's use of "The Rat Pack" in the context of a composite or compound term or mark.

The remaining question before the court concerns the parties' tribute phrases. TRP alleges in its complaint that it has a protected common-law mark in the phrase "The Tribute to Frank, Sammy, Joey, and Dean." Cunningham argues the tribute phrase he uses, "A Tribute to Frank, Dean, and Sammy," is generic. Cunningham further seeks a declaration

that his use of his tribute phrase does not infringe TRP's alleged mark because TRP has not shown that it has a protected trademark interest in its tribute phrase. Further, even if TRP has a protected interest, he argues that his use of a generic tribute phrase could not infringe TRP's claimed mark. The record before the court requires the conclusion that issues of material fact remain on these questions. Accordingly,

THE COURT **ORDERS** that TRP Entertainment, LLC.'s Motion for Entry of Default Against Defendant BC Entertainment, Inc. (#48) is GRANTED.

THE COURT FURTHER **ORDERS** that Barrie Cunningham's Motion for Partial Summary Judgment on Counterclaim for Declaratory Relief of Genericness, Counterclaim for Modification of Plaintiff's Trademark Registration, and Counterclaim for Declaratory Relief of Non-Infringement (#23) is GRANTED as to the First Counterclaim for Declaratory Relief of Genericness and as to the Second Counterclaim to the extent the Second Counterclaim requests Modification of TRP Entertainment, LLC.'s Trademark Registration No. 2,640,066 to add a disclaimer of the term "RAT PACK;" and is DENIED in all other respects as material issues of fact remain.

THE COURT FURTHER **ORDERS** that Barrie Cunningham shall prepare and submit a proposed partial judgment.

DATED this 28 day of September, 2009.

Lloyd D. George
United States District Judge

EXHIBIT "M"

EXHIBIT "M"

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

TRP ENTERTAINMENT, LLC, a Nevada Limited Liability Company, Petitioner, vs. DIRECT FROM VEGAS PRODUCTIONS, INC., a California Corporation, Respondent.	Registration No: 3220387 Mark: DIRECT FROM VEGAS THE RAT PACK Cancellation No.: 92050557 **SECOND AMENDED ANSWERS TO PETITIONER'S FIRST SET OF INTERROGATORIES**

COMES NOW, Respondent DIRECT FROM VEGAS PRODUCTIONS, INC. ("DFVP," "Respondent" or "Counterpetitioner"), by and through its attorneys of record, the law firm of Law Offices of Jacob Hafter & Associates, and hereby responds to the FIRST SET OF INTERROGATORIES TO REGISTRANT ("Petition") of TRP ENTERTAINMENT, LLC ("TRP," "Petitioner" or "Counterrespondent") as follows:

ANSWERS TO INTERROGATORIES

INTERROGATORY NO. 1:

Identify and describe in detail what goods and services you sell, have sold, offer for sale, offered for sale, provide, and/or provided under the Registered Mark.

///

7201 W. Lake Mead Blvd., Suite 210
Las Vegas, Nevada 89128
(702) 405-6700 Telephone
(702) 685-4184 Facsimile
JACOB HAFTER & ASSOCIATES LAS VEGAS PHOENIX

ANSWER TO INTERROGATORY NO. 1:

Respondent sells or has sold entertainment services, namely live and televised appearances by one or more professional entertainers.

INTERROGATORY NO. 2:

Identify and describe in detail when you commenced selling, offering for sale, or classifying any goods or services under the Registered Mark.

ANSWER TO INTERROGATORY NO. 2:

Respondent provides a copy of the Trademark Electronic Search System (TESS) filing as set forth in Response to Petitioner's Request for Production No. 1. Respondent's first use appears to be in January 2002 in conjunction with a show at San Bernadino's California Theater of Performing Arts. However, Respondent also believes that usage of the Mark occurred in 2001 during a show at Big Bear Lake.

INTERROGATORY NO. 3:

Identify and describe in detail the circumstances concerning your idea for, and selection of, the Registered Mark.

ANSWER TO INTERROGATORY NO. 3:

Respondent adopted the term "Rat Pack" because the show recreates actual performances by Frank Sinatra, Dean Martin and Sammy Davis Jr.. The "Direct from Vegas" portion of the name represents the image of the famous Rat Pack performances that were in Las Vegas. It also represents the name of the corporation that owns the Registered Mark.

INTERROGATORY NO. 4:

State whether you have ever consented to, authorized, licensed, assigned or granted a third party the right to use the Registered Mark, and if so, identify and describe in detail all such third parties and all agreements between you and the given third parties relating to such use.

ANSWER TO INTERROGATORY NO. 4:

No.

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INTERROGATORY NO. 5:

Identify the date when you first became aware of TRP's use of the Mark "The Rat Pack is Back" and corresponding Registration No. 2640066.

ANSWER TO INTERROGATORY NO. 5:

Respondent objects to the terms "aware" and "use of the Mark" as vague and ambiguous. Without waiving said objection. Respondent cannot remember the exact date. Respondent became aware of TRP's use of the Mark during the registration process with the USPTO.

INTERROGATORY NO. 6:

Identify and describe in detail each instance of actual confusion as to the source, association and/or sponsorship of any goods or services offered by you under the Registered Mark, and any goods or services offered by TRP under the Mark "The Rat Pack is Back."

ANSWER TO INTERROGATORY NO. 6:

Respondent is unaware of any instances of confusion.

INTERROGATORY NO. 7:

For each instance of actual confusion identified in Interrogatory No. 6 above, please identify and describe in detail the following:

1. The name and address of the person who was confused;
2. The date and place of the confusion; and
3. A description of the circumstances which led to the confusion.

ANSWER TO INTERROGATORY NO. 7:

N/A.

INTERROGATORY NO. 8:

Identify and describe in detail what channels of trade the Registered Mark is used in.

ANSWER TO INTERROGATORY NO. 8:

Respondent markets primarily through theater trade shows and with theater general managers. Registrant has retained companies to market its show, including, but not limited to: 1) Harmony Artists; 2) Destinations by Design; and 3) Classique Productions. Registrant is

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represented by these agencies at trade shows, where theater managers come together to fill their theater schedules. Registrant provides a flier depicting the Registrants' show and detailing the background of the performers. If necessary, the agencies will provide video of the performance. Respondent has an Internet site, www.ratpackdfv.com, but it has not been running for several years. In addition, these agents represent the Respondent in booking shows for corporate clients. Respondent's market encapsulates the entire United States, and then some, as Respondent's market is truly global, having booked performances all over the world.

INTERROGATORY NO. 9:

Identify and describe in detail the ticket prices for any of your shows performed under, or in conjunction with, the Registered Mark.

ANSWER TO INTERROGATORYNO. 9:

Respondent objects to this interrogatory as irrelevant or unlikely to lead to any admissible evidence. Without waiving said objection, Respondent does not possess personal knowledge of the requested information. Respondent is not compensated based upon ticket sales, so pricing is solely within the purview of Respondent's clients.

INTERROGATORY NO. 10:

Identify and describe in detail all facts and evidence supporting the allegations in paragraph 31 of your Counterclaim that: "Counterpetitioner believes that it will be damaged by the continued registration of Registration No. 2640066 for the designation 'The Rat Pack is Back' owned by Counterrespondent."

ANSWER TO INTERROGATORY NO. 10:

Petitioner engages in intimidation towards owners of marks using the term "Rat Pack". *See* Respondent's production of documents setting forth the tactics utilized by Petitioner to intimidate agents, theater owners and others from booking shows using the term "Rat Pack."

INTERROGATORY NO. 11:

Identify and describe in detail all facts and evidence supporting the allegations in paragraph 33 of your Counterclaim that: "The designation 'The Rat Pack is Back' is generic and the public has ceased to identify any trademark utilizing the term 'The Rat Pack' with a

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particular source of a product or service, but rather identifies the mark with a class of products or services regardless of source."

ANSWER TO INTERROGATORY NO. 11:

Respondent relies upon case law, Petitioner's admissions and personal knowledge of the Rat Pack. The term "Rat Pack" is a media-generated term that has been used to refer to Frank Sinatra, Sammy Davis Jr. and Dean Martin. Respondent relies upon case law, Petitioner's admissions and thorough personal knowledge of the Rat Pack. Petitioner's admissions are contained in briefs filed in civil court, DRDC Productions, Inc. v. TRP Entertainment, LLC, Docket No. 2:05CV00673. Respondent also refers to a recent federal district court decision in TRP v. BC Entertainment, Case No. 2:08-cv-00579-LDG-RJJ, Initial Disclosures, Exhibit 44.

INTERROGATORY NO. 12:

Identify and describe in detail all facts and evidence supporting the allegations in paragraph 34 or your Counterclaim that: "Continued registration of Registration No. 2640066 and Counterrespondent's enforcement of said registration against any trademark holder utilizing the term 'The Rat Pack' is effectively creating monopoly status for Counterrespondent over the term 'The Rat Pack.'"

ANSWER TO INTERROGATORY NO. 12:

See answer to Interrogatory No. 10.

INTERROGATORY NO. 13:

Identify and describe in detail all facts and evidence supporting the allegations in paragraph 35 of your Counterclaim that: "Continued registration of Registration No. 2640066 removes from the competitive marketplace terms that other businesses have a right to use and improperly restricts and trammels common and competitive speech."

ANSWER TO INTERROGATORY NO. 13:

See Interrogatory No. 10.

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INTERROGATORY NO. 14:

Identify and describe in detail all facts and evidence supporting the allegations in paragraph 36 of your Counterclaim that: "Counterpetitioner has sustained, and will continue to sustain, damages due to lost bookings as a direct result of Counterrespondent's aggressive actions towards Counterpetitioner for utilizing the term 'The Rat Pack.'"

ANSWER TO INTERROGATORY NO. 14:

See Interrogatory No. 10.

INTERROGATORY NO. 15:

Identify and describe in detail what bookings you have lost as a direct result of "Counterrespondent's aggressive actions towards Counterpetitioner for utilizing the term 'The Rat Pack.'"

ANSWER TO INTERROGATORY NO. 15:

Petitioner's use of intimidation has caused a chilling effect in the market for Rat Pack entertainment. Potential clients have been issued cease and desist orders and this intimidation convinces them to pass on Rat Pack shows. *See* Interrogatory No. 10.

INTERROGATORY NO. 16:

Identify and describe in detail all performances you have performed using the Registered Mark.

ANSWER TO INTERROGATORY NO. 16:

Respondent objects to this as overly broad and burdensome. Without waiving said objection, respondent refers to its answers to Petitioner's Second Interrogatories, Interrogatory No. 25.

INTERROGATORY NO. 17:

Identify and describe in detail all performances you have performed in the State of Nevada using the Registered Mark.

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ANSWER TO INTERROGATORY NO. 17:

Respondent objects to this as overly broad and burdensome. Without waiving said objection, respondent refers to its answers to Petitioner's Second Interrogatories, Interrogatories 20, 21 and 25.

INTERROGATORY NO. 18:

Identify and describe in detail all facts and evidence that support the Affirmative Defenses contained in your Answer and Counterclaim for Cancellation.

ANSWER TO INTERROGATORY NO. 18:

- First Affirmative Defense. Petitioner does not have exclusive rights over the term "Rat Pack."
- Second Affirmative Defense. Petitioner has known about Registrant's use of its mark since at least 2006.
- Third Affirmative Defense. *See* Interrogatories 10 and 15.
- Fourth Affirmative Defense. Case law in the federal court since 2001 has indicated that the term "Rat Pack" cannot be trademarked. Petitioner has stated the same.
- Fifth Affirmative Defense. Petitioner has known about Registrant's use of its mark since at least 2006.
- Seventh Affirmative Defense. Petitioner has known about Registrant's use of its mark since at least 2006.
- Tenth Affirmative Defense. Since 2001, case law in the District Court of Nevada has indicated that the term "Rat Pack" cannot be trademarked. Petitioner has stated the same.
- Eleventh Affirmative Defense. Registrant and Petitioner's predecessor-in-interest have already litigated the present case in federal court. See Initial Disclosures, Exhibit 34.

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- Twelfth Affirmative Defense. Since 2001, case law in the District Court of Nevada has indicated that the term "Rat Pack" cannot be trademarked. Petitioner has stated the same.

INTERROGATORY NO. 19:

Identify and describe in detail all other administrative and/or civil proceedings involving the Registered Mark, including the names of the parties, the case numbers, and the outcome of such proceedings.

ANSWER TO INTERROGATORY NO. 19:

Respondent objects to the term "proceedings" as being vague and ambiguous. Respondent further objects because the question calls for legal conclusions. Without waiving said objections, Respondent has been involved in litigation with DRDC Productions, Inc. in 2005. The Docket No. is 2:05cv04879. The documents associated with this case speak for themselves.

Dated this 9th day of December, 2009.

LAW OFFICE OF JACOB HAFTER & ASSOCIATES.

By: _____
JACOB L. HAFTER, ESQ.

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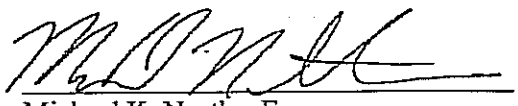
CERTIFICATE OF SERVICE

I hereby certify that on the 9th day of December, 2009, I personally sent a true and correct copy of the attached document via e-mail and to the following registrants:

Michael D. Rounds, Esq.
WATSON ROUNDS
5371 Kietzke Lane
Reno, Nevada 89511
Mfrancis@watsonrounds.com



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