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

Proceeding	91194292
Party	Plaintiff Larry Marshak
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Submission	Motion to Suspend for Civil Action
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Date	02/28/2011
Attachments	Motion to Suspend.pdf (4 pages)(96961 bytes)

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

In the Matter of Application Serial No. 77/550,496

Published in the Official Gazette on February 9, 2010

Mark: THE MARVELETTES

LARRY MARSHAK, Opposer, -against- KATHERINE SCHAFFNER, GLADYS HORTON, Applicants.	Opposition No. 91194292 Serial No. 731108367

MOTION TO SUSPEND THE PROCEEDINGS

Pursuant to 37 CFR § 2.117(a) and TBMP § 510.02(a), opposer Larry Marshak hereby requests that the Trademark Trial and Appeal Board suspend this proceeding until the final determination of *Larry Marshak v. Katherine Schaffner, and John Doe as the Executor of the Estate of Gladys Horton.*, 11 Civ.1104 (DLC) (the "Civil Action"), because the outcome of the Civil Action will control the result the instant proceedings.

FACTUAL BACKGROUND

On information and believe, at least as early as 1961, Motown Records used the mark THE MARVELETTES in connection with live and recorded performances by a musical group. In 1973 Motown assigned to Marshak its rights to the mark THE MARVELLETTES (sometimes inadvertently spelled "MARVELETTES"), for live performances and limited live recordings, as well as the goodwill associated with that mark. Marshak thereafter used the mark THE MARVELLETTES in interstate commerce in connection with live entertainment services. In 1978, Marshak received from the United

States Patent and Trademark Office Registration No. 1,081,340 for the mark THE MARVELLETTES. Marshak renewed the registration on May 17, 1998. To further secure his rights in the mark THE MARVELLETTES, on or about December 14, 1994, Marshak obtained an assignment from Gladys Horton of all her right, title and interest to the mark THE MARVELLETTES. As part of that assignment, Horton "agreed to the entry of an order of permanent injunction, in any court of competent jurisdiction enjoining her, her agents, servants and employees from representing to any third-party, directly or indirectly that she has the right to use the name or mark THE MARVELLETTES to identify any musical performing group other than a musical performing group controlled by Larry Marshak and Gladys Horton will not knowingly authorize any third party to represent that Gladys Horton or her performing group are THE MARVELLETTES."

Schaffner, upon information and belief, in or about 1970, abandoned any rights that she had in the mark THE MARVELLETTES by ceasing to use the mark with the intention not to resume use of the mark.

Since acquiring the THE MARVELLETTES mark and the goodwill associated with it in 1973, Marshak has promoted performances under the mark THE MARVELLETTES across the United States. Marshak invests significant monies to organize and promote performances under the mark THE MARVELLETTES. Marshak, for example, makes substantial investments in searching for appropriate forums for performances, negotiating the terms of the performances, ensuring appropriate practice space for the performers, seeking out strategic advertisement for the performances, negotiating the cost of tickets for the performances, hiring and training personnel to perform in the group, hiring and training back up musicians to perform with the group, creating the content of the show, selecting the group's performance material, selecting professional staff of choreographers and vocal coaches to train the group, selecting costumes and uniforms and overseeing the groups general, professional demeanor. In 2008, Marshak inadvertently let his United States mark registration lapse. He nevertheless continued to

use the mark THE MARVELLETTES without interruption in the United States to organize and promote musical performances.

To protect his rights in the THE MARVELLETES mark, Marshak on February 18, 2011, filed a complaint with the United States District Court of the Southern District of New York, alleging that Schaffner and the executor of the Estate of Gladys Horton's use of the THE MARVELETTES designation constitutes false designation of origin under the Lanham Act, 15 U.S.C. §1125(a), common law unfair competition under New York State law, deceptive business practice under New York General Business Law Art. 22-A § 349, and intentional interference with prospective economic relations.

ARGUMENT

The determination in the Civil Action will control the outcome of the issues before the Board. Where a party to a case pending before the Board is also involved in a civil action that may have a direct bearing on a TTAB matter, the Board may suspend the proceeding until the final determination of the civil action. 37 CFR §2.117(a); TBMP 510.02(a). This is because "a decision by the United States District Court would be binding on the Patent Office whereas a determination by the Patent Office as to respondent's right to retain its registration would not be binding or res judicata in respect to the proceeding before the federal district court." *Whopper-Burger, Inc., v. Burger King Corp.*, 171 U.S.P.Q. 805, 807 (TTAB 1971).

Applicants and opposer are both parties to the Civil Action, which involves the mark that is at issue in the instant proceeding, as well as claims for other relief. In that case, the district court will determine the rights of Marshak, Schaffner and the estate of Horton, with respect to the THE MARVELETTES mark and the THE MARVELETTES designation. This type of determination will directly affect the resolution of the issues before the Board. Further proceedings in this matter are therefore unnecessary.

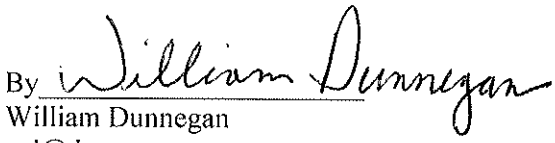
Based on the foregoing, opposer respectfully requests that the Board stay this proceeding pending

the final determination of the Civil Action.

Dated: New York, New York
February 28, 2011

Respectfully submitted,

DUNNEGAN LLC

By 
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