

TTAB

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

In the Matter of Trademark Registrations

Registration No. 2475235
For the Mark STAIND

Registration No. 2459222
For the Mark STAIND

Registration No. 2483319
For the Mark STAIND

Registration No. 2338763
For the Mark STAIND

-----X
JON C. STAINBROOK, :
 :
 Petitioner, :
 :
 -against- :
 :
 TRADEM, INC., :
 :
 Respondent. :
-----X

Cancellation No. 92043833

MOTION TO SUSPEND CANCELLATION ACTION UNDER 37 C.F.R. § 2.117(a)

Pursuant to §2.117(a) and TBMP §510.01, Respondent, Tradem, Inc.

("Respondent") by and through its undersigned attorneys, respectfully requests that the instant proceedings be suspended pending the final determination of a civil action between the parties in United States District Court for the Northern District of Ohio, Civil Action No. 3:04CV7749.



12-21-2004

U.S. Patent & TMO/TM Mail Rcpt Dt. #66

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BRIEF STATEMENT OF FACTS

On January 28, 1999, Petitioner, Jon C. Stainbrook ("Petitioner"), assigned to Respondent "all right, title and interest in the United States and throughout the world," in and to the mark THE STAIN, "together with the goodwill of the business symbolized [therein]" for \$18,000. In addition, Respondent granted Petitioner a very limited license back to use the mark in connection with live vocal and musical performances in Class 41, and only in the states of Ohio, Kentucky, Michigan and Indiana. Petitioner breached the terms and conditions of the limited license agreement with Respondent, forcing Respondent to terminate Petitioner's limited rights thereunder. Notwithstanding the forgoing, Petitioner continues to use the mark THE STAIN in commerce in the face of Respondent's superior and valid trademark rights in and to the substantially similar mark STAIND. To exacerbate the situation, Petitioner has been harassing Respondent at common law and now in the USPTO by, *inter alia*, filing this meritless Cancellation Action and a baseless trademark application to re-register the mark THE STAIN.

THE DISTRICT COURT ACTION

Accordingly, on December 3, 2004, Respondent filed a Complaint in the United States District Court for the Northern District of Ohio, a copy of which is attached as Exhibit A and incorporated herein by reference, alleging that:

1. Petitioner breached his license agreement with Respondent;
2. Petitioner has infringed and continues to infringe Respondent's rights in and to the mark STAIND with its unauthorized use of the confusingly similar mark THE STAIN under the Lanham Act;

3. Respondent is entitled to a declaratory judgment that all of its registrations for STAIND are valid;

4. Petitioner's attempts to cancel Respondent's marks and otherwise interfere with Respondent's right to use its marks are frivolous;

5. Respondent is entitled to a declaratory judgment that Petitioner's application to re-register the mark THE STAIN is fraudulent and cannot be granted as it is the product of Petitioner's willful breach of its assignment of THE STAIN trademark to Respondent.

The newly filed civil action has a direct bearing on all of the issues involved in the instant proceeding because a decision by the Northern District of Ohio will be wholly dispositive of the pending Cancellation Action. Specifically, the District Court action will resolve: (1) whether or not Respondent is the owner of valid trademark registrations for the mark STAIND; (2) whether or not Petitioner is entitled to cancel Respondent's STAIND trademark registrations; (3) whether or not Petitioner has any remaining rights to use and to register the mark THE STAIN; and (4) whether there is a likelihood of confusion between the marks STAIND and THE STAIN. Moreover, because the civil action contemplates additional legal disputes that are not currently before the Trademark Trial and Appeal Board (the "Board") and for which the Board cannot assert jurisdiction, Registrant respectfully asserts that suspension is warranted.

SUSPENSION OF THE INSTANT PROCEEDING IS APPROPRIATE

The Board has the discretion to suspend a proceeding pending the final determination of a civil action. Pursuant to 37 C.F.R. § 2.117(a), if parties to a "pending case are engaged in a civil action which may be dispositive of the case, proceedings before the Board may be suspended until termination of the civil action." See also TBMP §

510.02(a) (“[T]he Board will suspend proceedings in the case before it if the final determination of the other proceeding will have a bearing on issues before the Board.”).

See also Tokaido v. Honda Associates, Inc., 179 U.S.P.Q. 861, 862 (TTAB 1973).

There is ample precedent for the Board to suspend an action pending before it when a party subsequent to the Board proceeding files a civil action. In Jeffrey Banks, Ltd. v. Jos. A. Bank Clothiers, Inc., 226 U.S.P.Q. 942 (D.C. Md 1985), Plaintiff Jeffrey Banks sought a declaratory judgment that its mark JEFFREY BANKS for clothing, did not cause a likely of confusion as to Defendant Jos. A. Bank’s registered mark JOS. A. BANK. Prior to this federal lawsuit, Jos. A. Bank had filed a Notice of Opposition to the proposed registration of Jeffrey Bank’s mark, arguing that Jeffrey Bank’s use of the mark was likely to cause confusion with respect to the origin and source of the goods. Id. The Board granted Jeffrey Bank’s motion to stay the proceedings before the Board pending the resolution of the civil action. Id. at 944.

The Tokaido case addressed similar issues. In Tokaido, the respondent filed a motion to suspend the cancellation action after respondent instituted an action against petitioner. The Board considered the fact that the civil action would be dispositive of the issues present in the cancellation action and noted that:

it is clear that the outcome of the civil suit may well be dispositive of the issues raised by the pleadings of the parties in the cancellation proceeding before the Board. It should be noted in this regard that while a decision by the [U.S.] District Court would be binding upon the [Trademark] Office, a decision by the Trademark Trial and Appeal Board would only be advisory in respect to the disposition of the case pending in the [U.S.] District Court.

Tokaido, 179 U.S.P.Q. at 862. In granting Registrant’s Motion to stay the cancellation action pending resolution of the civil suit, the Board in Tokaido held that:

[a]ccordingly, and notwithstanding the fact that the [Trademark] Office proceeding was the first to be filed, it is *deemed to be the better policy to suspend proceedings herein until the civil suit has been finally concluded.* Tokaido, 179 U.S.P.Q. at 862 (emphasis added). See also Townley Clothes, Inc. v. Goldring, Inc., 100 U.S.P.Q. 57, 58 (Comr., 1953) (holding that "it is deemed to be the sounder practice to suspend the [Trademark] Office proceedings pending termination of the [civil] [c]ourt action"); Squirrel Brand Company v. Barnard Nut Co. Inc., 101 U.S.P.Q. 340 (Comr., 1954) (holding that proceedings were properly suspended where "the controlling issues presented for determination are necessarily the same as those of a civil action for infringement involving the same parties and trade marks"). See also Farah v. Topiclear Beauty Prods., Inc., 2003 WL 22022077 (T.T.A.B. August 31, 2003) ("Suspension would avoid the undesirable result of the parties litigating the same issue in two forums, with potentially inconsistent results and would minimize waste of both parties' and the Board's resources.").

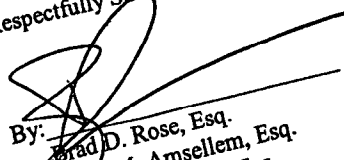
In the instant proceeding Registrant has filed a civil action against Petitioner wherein the central issues involved are exactly the same as the ones at issue in the Cancellation Action. However, the District Court action -- not the Cancellation Action -- will provide both parties with a complete judicial resolution of all of their the legal and equitable claims. Thus, in the interest of judicial economy (and by reasons of the res judicata and collateral estoppel effects that a district court judgment would have on the pending Cancellation Action) the Cancellation Action should be stayed. See TBMP § 510.02(a), citing, Goya Foods Inc. v. Tropicana Prods. Inc., 846 F.2d 848 (2d Cir. 1988) ("To the extent that a civil action in a Federal district court involves issues in common with those in a proceeding before the Board, the decision of the Federal district court is binding upon the Board, while the decision of the Board is not binding upon the court."); See also 5

J. Thomas McCarthy, *McCarthy On Trademarks and Unfair Competition*, § 32:49 at 32-102.1(4th ed. 2004) ("A judgment of a federal court is clearly binding upon the Trademark Board, while an administrative decision of the Trademark Board may have only persuasive value in later court proceedings.").

Based upon the foregoing, Respondent respectfully requests that the Board exercise its discretion to grant the instant motion to suspend the Cancellation Action pending the final determination of the civil action between the parties.

Date: December 15, 2004

Respectfully Submitted,

By: 

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Perry M. Amsellem, Esq.
Nicole E. Kaplan, Esq.
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Attorneys for Respondent

CERTIFICATE OF SERVICE

The undersigned hereby certifies that a copy of the foregoing MOTION TO SUSPEND CANCELLATION ACTION UNDER 37 CFR § 2.117(a) has been served upon Petitioner's attorneys,

Anthony J. DeGidio, Esq.
3738 Treelawn Drive
Toledo, OH 43614

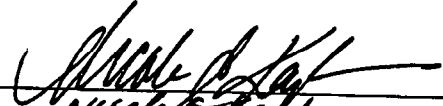
the address designated by said attorney for the purpose of depositing a true copy thereof with the United States Post Service as first-class mail on December 17, 2004.



Nicole E. Kaplan, Esq.

Certificate of Mailing by First Class Mail

I hereby certify that this MOTION TO SUSPEND CANCELLATION ACTION UNDER 37 C.F.R. § 2.117(a) is being deposited with the United States Postal Service as "First Class Mail" in an envelope addressed to: Commissioner for Trademarks, P.O. Box 1451, Alexandria, VA 22313-1451, ATTN: Trademark Trial and Appeal Board on December 17, 2004.

Signed: 
Name: Nicole E. Kaplan

1- ISSUED TO ATTORNEY

FILED

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NORTHERN DISTRICT OF OHIO
TOLEDO

ORIGINAL

UNITED STATES DISTRICT COURT
NORTHERN DISTRICT OF OHIO
WESTERN DIVISION

TRADEM, INC., p/k/a STAIND

Plaintiff,

-against-

JON C. STAINBROOK,

Defendant.

3:04 CV 7749
Case No.

COMPLAINT WITH
DEMAND FOR JURY

JUDGE JAMES G. CARR

Plaintiff Tradem, Inc. p/k/a STAIND ("Plaintiff" or "Tradem"), by its attorneys, Spengler Nathanson P.L.L. and Pryor Cashman Sherman & Flynn LLP, as and for its Complaint against defendant Jon C. Stainbrook ("Defendant"), respectfully alleges as follows:

NATURE OF ACTION

1. This is an action against a self-described punk-rock vocalist musician who doubles as a professional trademark litigant, having brought trademark actions against at least three different professional bands over time. In this case, however, Defendant finds himself on the other side of the litigation aisle. Defendant has knowingly and willfully infringed Plaintiff's trademark, "THE STAIN" (Registration No. 1,803,466), which Defendant assigned to Plaintiff in

1999 for \$18,000, including all rights, title, interest and goodwill worldwide associated therewith. Thereafter, Defendant breached his license, compelling Plaintiff to terminate his license rights. Defendant ignored the termination of his license, and continued to infringe Plaintiff's mark, "THE STAIN". Having breached his contractual obligations to Plaintiff under the license, and having infringed upon Plaintiff's mark, Defendant now fraudulently attempts to apply for the mark, "THE STAIN" before the Patent and Trademark Office. At the same time, Defendant has commenced a meritless petition before the U.S. Patent and Trademark Office (the "PTO") seeking to cancel another of Plaintiff's marks, "STAIN" (in four classifications, Registration Nos. 2,338,763 (recorded product), 2,423,319 (printed matter), 2,475,235 (clothing) and 2,459,222 (entertainment services)), which petition is designed to clear the way for Defendant to re-register the otherwise admittedly similar and confusing mark, "THE STAIN."

2. Defendant's gamesmanship and bad faith render him liable to Plaintiff on the following claims: (a) trademark infringement under the federal Lanham Act; (b) breach of contract damages; (c) declaratory judgment that Plaintiff's mark "STAIN" is valid, and that Defendant's attempts to cancel said mark are frivolous and without merit; and (d) declaratory judgment that Defendant's application to re-register the mark "THE STAIN" is baseless, fraudulent and cannot be granted, as it is the product of Defendant's willful breach of his assignment of that mark to Plaintiff.

THE PARTIES

3. Plaintiff Tradem, Inc. is a corporation duly authorized and existing pursuant to the laws of the State of Delaware, having its principal place of business in New York. Tradem is the successor-in-interest to 4 Walls, Inc. and owns the registered and common law trademarks of the

famous and internationally known musical group STAIN'D, which is wholly owned by Tradem and by which it is professionally known.

4. Upon information and belief, Defendant is an individual residing at 2278 Belvedere Drive, Toledo, Ohio. Upon information and belief, Defendant is a musician.

JURISDICTION AND VENUE

5. This action arises, inter alia, under the federal Lanham Act, 15 U.S.C. § 1051 et seq. (the "Lanham Act"), the Declaratory Judgment Act, 28 U.S.C. § 2201 et seq., and the common law of New York. This Court has subject matter jurisdiction pursuant to 28 U.S.C. §§ 1331, 1338, 1367, 2201 and 2202.

6. This Court has general personal jurisdiction over Defendant in that Defendant resides in Toledo, Ohio.

7. Venue is proper pursuant to 28 U.S.C. § 1391(b).

FACTS

8. Tradem owns the registered and common law famous trademarks of and for a famous musical performance group professionally known as "STAIN'D", which has been performing under this name and mark throughout the U.S., and the rest of the world for many years. The STAIN'D band has been using the STAIN'D mark as its stage name and is professionally known world wide by and through this name.

Defendant's Assignment of His Rights in "THE STAIN" to Plaintiff

2. Tradem's predecessor, 4 Walls, learned in 1999 that Defendant was the legal owner of a separate but likely confusing mark, "THE STAIN," and contacted him in good faith for the purpose of purchasing all of Defendant's rights, title and interest in the mark "THE

STAIN" for monetary compensation, for the express and known purpose of, inter alia, avoiding any claims in the future by Defendant with respect to Plaintiff's use of the mark "STAIN".

10. Defendant agreed to and did sell Plaintiff, without limitation, all rights, title and interest in and to "THE STAIN" for \$18,000, which payment was made by Plaintiff.

11. No other consideration was promised by Plaintiff to Defendant as part of the Assignment.

12. On January 28, 1999, Defendant signed a document entitled Assignment of Registered Service Mark (the "Assignment"), a copy of which is attached as Ex. A. By and through the Assignment, Defendant assigned to Plaintiff with respect to "THE STAIN" "all right, title and interest in the United States, and throughout the world, in and to said Service mark together with good will of the business symbolized by said Service mark and registration thereof." In consideration for the Assignment, Defendant acknowledged the receipt of \$18,000 paid by Plaintiff. In entering into the Assignment, Defendant surrendered all right, title and interest he may ever have had in "THE STAIN," together with all goodwill in connection therewith.

13. The Assignment was recorded with the PTO on April 30, 1999.

**Defendant's Agreement to Continue to Use "THE STAIN"
In Commerce Pursuant to a License Granted by Plaintiff**

14. On the same day, and simultaneous with the signing of the Assignment, Plaintiff and Defendant entered into a limited non-exclusive License of Registered Service Mark (the "License"), a copy of which is attached hereto as Ex. B. The License granted Defendant the limited right to use "THE STAIN" in connection with the "rendition of Entertainment Services.

namely rendering live vocal and musical performances in Class 41" in four States (i.e., Ohio, Kentucky, Michigan and Indiana).

15. Paragraph 8 of the License to Defendant states:

[Defendant] acknowledges [Tradem's] exclusive right, title and interest in and to the Service Mark and any Registration or Amendment that have issued or may issue thereon, and will not at any time do or cause to be done any act or thing contesting or in any way impairing or tending to impair part of such right, title and interest. In connection with the use of the Service Mark [Defendant] shall not in any manner represent that he or it has any ownership of the Service Mark or registrations thereof, and all parties acknowledge that use of the Service Mark shall enure to the benefit of [Tradem].

16. Part of the consideration for the License, as Defendant knew, was that Plaintiff intended and relied upon Defendant using the mark "THE STAIN" in commerce in order to maintain continuity of use of "THE STAIN," so that Plaintiff could maintain its registration of "THE STAIN." To that end, Paragraph 4 of the License provides that "[Defendant] shall, from time to time, provide [Tradem] with samples of literature, brochures, signs and advertising material prepared by [Defendant], and [Defendant] shall obtain the approval of [Tradem] with respect to all such brochures, signs and advertising material bearing the Service Mark prior to the use thereof."

17. Despite repeated written warnings, Defendant engaged in repeated breaches of the License. In particular, although Defendant continued to use "THE STAIN" in commerce, he failed and refused to provide Plaintiff with the necessary supporting information confirming his ongoing use.

18. Defendant's failure to provide such information, as he knew, would (and ultimately did) hamper Plaintiff's right to maintain its registration of "THE STAIN," as set forth more fully below.

19. Defendant breached his obligations under paragraphs 1, 2, 3, 4, 7 and 8 of the License, and as a result, on August 23, 2000, a termination letter was sent to Defendant by an attorney for the Plaintiff, notifying him that this letter "constitutes formal Notice under Paragraph 7 of the License, that the License shall be terminated for good cause in 30 days."

20. Thus, Defendant lost all rights to use "THE STAIN" in commerce after September 21, 2000.

21. As a direct consequence of Plaintiff's inability to prove continuous use of "THE STAIN" in commerce by Defendant pursuant to the License, Plaintiff's registration of "THE STAIN" lapsed on or about May 10, 2004.

Defendant's Infringement of "THE STAIN"

2. Upon information and belief, between September 22, 2000 and May 9, 2004, Defendant continued to use "THE STAIN" in commerce in connection with the promotion of his music and band, including performances, notwithstanding that he had no right to do so.

2. Thus, Defendant infringed Plaintiff's mark, "THE STAIN," during this time.

Plaintiff's Valid Registration of "STAIN"

2. Plaintiff is also the registered Federal owner of the mark "STAIN" in four different categories as and by its "first use in commerce." These include the following:

(a) Prerecorded audio cassette and cartridge tapes, compact discs and phonograph records all featuring music and entertainment, namely, humor variety and drama, (Registration No. 2,338,763);

(b) Paper goods, namely posters, stickers, temporary tattoos, decals, and lyric books. (Registration No. 2,483,319);

(c) Clothing, namely shirts, T-shirts, jerseys, jackets, wind-resistant jackets, belts, and headwear, namely hats, caps, beanies, and bandanas. (Registration No. 2,475,235); and

(d) Entertainment services, namely live performances by a musical group, Record production of musical performances; providing information on musical groups and other music and entertainment subjects via an on-line global computer network. (Registration No. 2,459,222).

25. Although Plaintiff's registration of "STAIN" with the PTO contained a harmless typographical or ministerial error concerning the date of first use of said mark by Plaintiff, Plaintiff's registration of "STAIN" is and remains valid.

Defendant's Recent Harassing Litigation Tactics

26. On November 6, 2003, attorneys for Defendant sent a letter to Plaintiff, in which they raised frivolous allegations and demands for damages and compensation because of certain purported "verbal promises" that were allegedly also made to Defendant in connection with the Assignment and the License, concerning gigs, credits, passes, tickets and marketing and merchandising. In this letter Defendant also raised allegations as to Plaintiff's alleged infringement of Defendant's so-called rights in "THE STAIN." Defendant requested \$6,000,000 to avoid suit.

27. There were no such "verbal promises" made by Plaintiff to Defendant in connection with the Assignment or the License.

28. By virtue of the Assignment, Defendant had no rights to "THE STAIN," subsequent to Plaintiff's termination of the License by reason of Defendant's breaches.

29. On or about October 8, 2004, Defendant filed with the PTO a meritless Petition to Cancel all four classifications of Plaintiff's mark "STAIN." Defendant premised his challenge on an inadvertent error of the date of Plaintiff's first use of said mark, calling such an error "fraudulent" without a scintilla of factual support or inference - for which there is none.

30. On or about October 14, 2004, Defendant, seeking to profit off of his own breach of the License, which caused Plaintiff's registration in "THE STAIN" to lapse, also filed with the PTO an application to re-register "THE STAIN" in his name.

FIRST CLAIM FOR RELIEF

**Willful Trademark Infringement Under
Section 32 of the Lanham Act, 15 U.S.C. § 1114**

31. Plaintiff repeats and realleges the allegations contained in paragraphs 1 through 30, as if fully set forth herein.

32. Defendant willfully infringed "THE STAIN" through his use thereof during the period of September 22, 2000 through May 9, 2004, during which time Plaintiff was the lawful owner and registrant of "THE STAIN."

33. Defendant's willful use of "THE STAIN" during this time was without permission or authority of Plaintiff.

34. As a direct and proximate result of Defendant's willful conduct, Tradem was injured and is entitled to recover damages from Defendant resulting from Defendant's infringing acts, including all gains, profits and advantages obtained by Defendant as a result thereof, in an amount to be proved at trial, and which amount should be trebled due to Defendant's willful infringement, together with the costs of this action, including reasonable attorneys' fees, pursuant to 15 U.S.C. §§ 1114, 1116 and 1117(a).

SECOND CLAIM FOR RELIEF

Breach of Contract

35. Plaintiff repeats and realleges the allegations contained in paragraphs 1 through 34, as if fully set forth herein.

36. In the License entered between Plaintiff (and its predecessor-in-interest) and Defendant, Defendant agreed to provide Plaintiff with samples of literature, brochures, signs and advertising material prepared by Defendant with respect to "THE STAIN", and to obtain the approval of Plaintiff with respect to all such brochures, signs and advertising material bearing the "THE STAIN" mark prior to its use.

37. Despite numerous repeated requests, Defendant failed and refused to fulfill its contractual obligations, resulting in a breach of the License and his License was therefore terminated on or about September 23, 2000.

38. Defendant's breach of the License damaged Plaintiff in an amount not yet known, but including, inter alia, consequential damages arising out of Plaintiff's loss of its registration in "THE STAIN."

THIRD CLAIM FOR RELIEF

Declaratory Judgment of Validity of All Four Classifications of Plaintiff's Mark "STAIN"

39. Plaintiff repeats and realleges the allegations contained in paragraphs 1 through 38, as if fully set forth herein.

40. By virtue of Defendant's recent filing with the PTO a Petition to Cancel all four classifications of Plaintiff's mark "STAIN," an actual and justiciable controversy exists between the parties concerning the validity of said mark.

41. The PTO has not commenced any action on Defendant's recent Petition to Cancel, as Plaintiff has not yet filed answering papers.

2. Any determination by the PTO would be subject to de novo review by this Court, and Plaintiff has the right to have this Court adjudicate the dispute in the first instance.

2. Accordingly, Plaintiff is entitled to a declaration declaring all four classifications of Plaintiff's mark "STAIN" to be valid.

FOURTH CLAIM FOR RELIEF

Declaratory Judgment of Invalidity of Defendant's Application to Re-Register "THE STAIN" in Defendant's Name

2. Plaintiff repeats and realleges the allegations contained in paragraphs 1 through 43, as if fully set forth herein.

2. By virtue of Defendant's recent fraudulent filing with the PTO of an application to re-register "THE STAIN" in Defendant's name, an actual and justiciable controversy exists concerning the validity of said application.

2. In particular, Defendant's application is a bad faith attempt to profit from his own malfeasance in breaching the License and thereby preventing Plaintiff from maintaining its registration over the mark "THE STAIN."

2. In addition, and alternatively, Defendant is not entitled to register "THE STAIN" due to the confusing similarity with Plaintiff's mark, "STAIN," which is valid and precedes any new registration of "THE STAIN."

2. Accordingly, Plaintiff is entitled to a declaration that Defendant's application to re-register "THE STAIN" must be denied.

WHEREFORE, Tradem demands judgment against Defendant as follows:

- (a) On the First Claim for Relief, that Tradem recover from Defendant all of Defendant's profits and all damages, including lost profits, sustained by Tradem as a result of Defendant's willful infringement of "THE STAIN" during the period of September 22, 2000 through May 9, 2004, in an amount to be proved at trial, and such other compensatory damages as the Court determines to be fair and appropriate, pursuant to 15 U.S.C. § 1117(a).
- (b) On the First Claim for Relief, that Tradem recover from Defendant three times the amount of Defendant's profits or Tradem's damages, whichever is greater, for willful infringement pursuant to 15 U.S.C. § 1117(b).
- (c) On the First Claim for Relief, that Tradem be awarded all the costs, disbursements and attorneys' fees incurred by it in having to bring this action, pursuant to 15 U.S.C. § 1117.
- (d) On the First Claim for Relief, that Defendant be required to deliver to Tradem for destruction, all goods and materials of any kind whatsoever to which are affixed the THE STAIN Mark or the STAIND Mark, or any mark confusingly similar thereto containing the phrase THE STAIN or STAIND, and all related products, catalogues, advertising, and promotional materials in its possession, custody, or control, pursuant to 15 U.S.C. §1118.
- (e) On the Second Claim for Relief, that Plaintiff be awarded compensatory damages in an amount to be determined at trial, including consequential damages arising out of Plaintiff's loss of registration of "THE STAIN," pursuant to Defendant's breach of the License.
- (f) On the Third Claim for Relief, a declaration that all four classifications of Plaintiff's mark "STAIND" are valid.
- (g) On the Fourth Claim for Relief, a declaration that Defendant's application to re-register "THE STAIN" in his own name must be denied.

(h) For all such other and further relief as this Court may deem just and proper.

JURY DEMAND


Tradem hereby demands a trial by jury.



James P. Silk, Jr., Esq.

Respectfully submitted,

SPENGLER NATHANSON P.L.L.

By 

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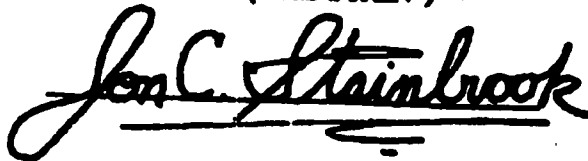
Exhibit A

ASSIGNMENT OF REGISTERED SERVICE MARK

Now, Therefore, in consideration of the sum of Eighteen Thousand Dollars (\$18,000.00) and other good and valuable consideration paid by STAIN to THE STAIN, the receipt of which is hereby acknowledged, JON C. STAINBROOK hereby assigns to FOUR WALLS, INC. all right, title and interest in the United States, and throughout the world, in and to said Service mark together with the goodwill of the business symbolized by said Service mark and registration thereof.


Signed at Toledo, Ohio, this 28th day of January, 1999

Jon C. Stainbrook ("THE STAIN")



State of Ohio)
)ss:
County of Lucas)

On this 28th day of January, 1999, personally appeared Jon C. Stainbrook, to me known and known to me to be the assignor above named, and acknowledged that he executed the foregoing Assignment on behalf of himself as said assignor.



Notary Public

Exhibit B

LICENSE OF REGISTERED SERVICEMARK

PTP
↑
Whereas, ~~Four Walls, Inc.~~, a corporation organized under the laws of the State of Massachusetts, ("STAIND" hereafter), having its principal office at: 7 West 22nd Street, Fourth Floor, New York, NY 10010, is using and is the owner of the following Service mark now registered in the United States Patent and Trademark Office, a copy of which registration is attached hereto:

Service Mark
THE STAIN

Registration No.
1,803,466

Date of Registration
November 9, 1969-73

Whereas, Jon C. Stainbrook, an individual residing in Toledo, Ohio, having his principal offices at 2527 Broadway (rear), Toledo, Ohio 43609, ("THE STAIN" hereafter), is desirous of acquiring a license to use said registered Service mark, as hereinafter provided;

THE STAIN is desirous of using said Service Mark for Entertainment Services, namely, rendering live vocal and musical performances, in Class 41, in the States of Ohio, Kentucky, Michigan and Indiana, hereinafter referred to as the "Territory," therefore, in consideration of the mutual covenants of the parties and the sum of Ten Dollars (\$10) herewith paid by THE STAIN to STAIND, the receipt and adequacy of which is hereby acknowledged by said STAIND, the parties hereby agree as follows:

1. License. STAIND grants to THE STAIN the right to use under the common law and under the auspices and privileges provided by the Registration covering the same during the term of this Agreement, and THE STAIN hereby undertakes to use the Service Mark "THE STAIN" in the Territory in connection with the rendition of Entertainment Services, namely rendering live vocal and musical performances in Class 41, the permitted services being hereinafter referred to as the "Services."

2. Quality of Services. THE STAIN shall use the Service Mark "THE STAIN" with the Services rendered by or for the THE STAIN in accordance with the guidance and directions furnished to the THE STAIN by STAIND, or its representatives or agents, from time to time, if any, which shall not require THE STAIN to deviate from his current and prior public performance characteristics.

3. Inspection. THE STAIN will permit duly authorized representatives of the STAIND to inspect the performance premises of THE STAIN where he is using the Service Mark at all reasonable times, for the purpose of ascertaining or determining compliance with Paragraphs 1 and 2 hereof.

4. Use of Service Mark. THE STAIN shall, from time to time, provide STAIND with

samples of literature, brochures, signs and advertising material prepared by the THE STAIN, and THE STAIN shall obtain the approval of STAIND with respect to all such brochures, signs and advertising material bearing the Service Mark prior to the use thereof. When using the Service Mark under this Agreement, THE STAIN undertakes to comply substantially with all laws pertaining to service marks in force at any time in the Territory. This provision includes compliance with marking requirements. THE STAIN shall suitably mark all literature, brochures, signs and other such advertising material so as to distinguish his services from those of STAIND.

5. **Extent of License.** The right granted in Paragraph 1 hereof shall be nonexclusive and shall not be transferable without STAIND's prior written consent, and STAIND shall have the right to use the Service Mark and to license its use to any other designee in the Territory. The license herein granted shall not be assignable or transferable in any manner whatsoever, nor shall the THE STAIN have the right to grant any sublicenses, except by prior written consent of the STAIND.

6. **Indemnity.** STAIND assumes no liability to THE STAIN or to third parties with respect to the THE STAIN's use of the mark "THE STAIN", and with respect to the performance characteristics of the Services rendered by the THE STAIN under the Service Mark, and the THE STAIN shall indemnify STAIND against losses incurred to claims of third parties against STAIND involving sale of the THE STAIN's Services.

7. **Termination.**

a. Except as otherwise provided herein, this Agreement shall remain in full force and effect, but is terminable by STAIND upon not less than thirty (30) days written notice to THE STAIN, but only for good cause shown.

b. If THE STAIN makes any assignments of assets or business for the benefit of creditors, or a trustee or receiver is appointed to conduct its business or affairs, or it is adjudged in any legal proceeding to be either a voluntary or involuntary bankruptcy, then the rights granted herein shall forthwith cease and terminate without prior notice or legal action by STAIND.

c. If STAIND shall, at any time hereafter, abandon the use of the Service mark or allow the registration of the Service mark to expire, or be otherwise terminated by the United States Patent & Trademark Office, this license shall terminate, and THE STAIN may continue to use the Service mark as though the Assignment of same of even date had not been made.

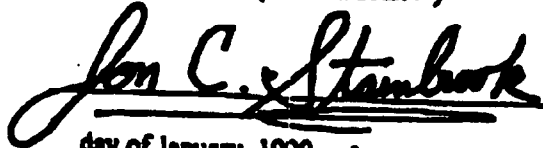
8. **Ownership of Service Mark.** The THE STAIN acknowledges STAIND's exclusive right, title and interest in and to the Service Mark and any Registration or Amendment that have issued or may issue thereon, and will not at any time do or cause to be done any act or thing contesting or in any way impairing or tending to impair part of such right, title and interest. In connection with the use of the Service Mark, THE STAIN shall not in any manner represent that he or it has any ownership in the Service Mark or registrations thereof, and all parties acknowledge that use of the Service Mark shall enure to the benefit of STAIND. On termination

of this Agreement in any manner provided herein, with the exception of that contained in Section 7c. above, the THE STAIN will cease and desist from all use of the Service Mark in any way and will deliver up to the STAIND, or its duly authorized representatives, all material and papers upon which the Service Mark appears, and furthermore, THE STAIN will not at any time adopt or use without the STAIND's prior written consent, any word or Service mark which is likely to be similar to or confusing with the Service Mark.

9. Any notices required or permitted to be given under this Agreement shall be deemed sufficiently given if mailed by registered mail, postage prepaid, addressed to the party to be notified at its address shown below, or at such other address as may be furnished in writing to the notifying party.

Signed at Toledo, Ohio, this 28th day of January, 1999.

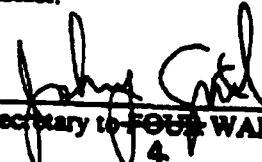
Jon C. Stainbrook ('THE STAIN')

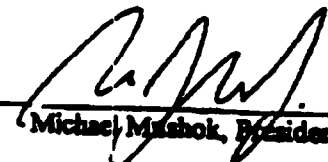


Signed at New York, New York, this _____ day of January, 1999.

FOUR WALLS, INC. ('STAIND')
4 rvm

Attest:


Secretary to FOUR WALLS, INC.
4 rvm

By 
Michael Mishok, President

ENCLOSURE