

United States District Court

SOUTHERN

NEW YORK

DISTRICT OF

GLENN MILLER PRODUCTIONS, INC.,

Plaintiff,

SUMMONS IN A CIVIL CASE

JUDGE SPRIZZO

CASE NUMBER:

AVIREX LTD.,

Defendant.

02 CV 8830

TO: (Name and address of defendant)

Avirex Ltd.
605 Third Avenue
New York, N.Y. 10152

YOU ARE HEREBY SUMMONED and required to serve upon PLAINTIFF'S ATTORNEY (name and address)

Foley, Hickey, Gilbert & O'Reilly
116 John Street
New York, N.Y. 10038

an answer to the complaint which is herewith served upon you, within 20 days after service of this summons upon you, exclusive of the day of service. If you fail to do so, judgment by default will be taken against you for the relief demanded in the complaint. You must also file your answer with the Clerk of this Court within a reasonable period of time after service.

J. MICHAEL McMAHON

NOV - 6 2002

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DATE

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(BY) DEPUTY CLERK

UNITED STATES DISTRICT COURT
SOUTHERN DISTRICT OF NEW YORK

-----X
GLENN MILLER PRODUCTION INC.,

Plaintiff,

-against-

AVIREX LTD.

JUDGE SPRIZZO

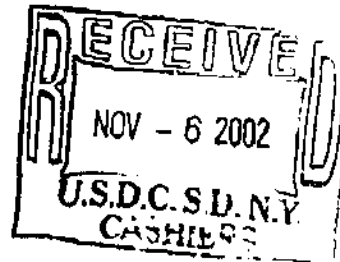
Defendant
-----X

Plaintiff Demands

Trial by Jury

02 CV 8830

COMPLAINT



Plaintiff, by its attorneys, Foley, Hickey, Gilbert & O'Reilly, for its complaint against defendant, alleges as follows:

1. Plaintiff, Glenn Miller Productions, Inc., is a corporation organized and existing pursuant to the laws of the State of New York, having its principal place of business at 116 John Street, New York, New York 10038.

2. Upon information and belief, defendant, Avirex, Ltd., is a corporation, organized and existing pursuant to the laws of the State of New York, having its, principal place of business at 605 Third Avenue, New York, New York 10152.

3. This is an action for dilution of plaintiff's service mark, unfair competition and false designation of origin pursuant to 15 U.S.C. 1125 (a) and (c). This court has jurisdiction of this matter pursuant to 15 U.S.C. 1121, 28 U.S.C. 1331 and 28 U.S.C. 1338. Venue lies pursuant to 28 U.S.C. 1391 (b).

4. Plaintiff was formed in 1956 by Helen D. Miller, the widow of the renowned bandleader Glenn Miller and David Mackay. Since its creation, plaintiff has owned and operated the Glenn Miller Orchestra and from June 6, 1956 has continuously used the mark Glenn Miller Orchestra in commerce to identify its services. In 1966, Mrs. Miller died. As a result Mr. Mackay became the sole owner of plaintiff.

5. On April 25, 1956, Helen D. Miller, individually and as the Executrix of the Estate of Glenn Miller granted to plaintiff the right to use inter alia the name and likeness of Glenn Miller "in connection with the business activities of Glenn Miller Productions, Inc." Annexed hereto as Exhibit 1 is a copy of the license dated April 25, 1956.

6. Plaintiff is the owner of the service mark "Glenn Miller Orchestra", which was first registered on the Principal Register in the United States Patent Office on September 28, 1965 bearing registration number 796934 and was renewed by the United States Patent Office on September 3, 1985 for an additional twenty year period commencing September 28, 1985. Annexed hereto as Exhibit 2 are copies of the original registration certificate dated September 28, 1965 and the renewal certificate dated September 3, 1985.

7. Continuously since 1956 plaintiff has rendered musical performances 50 weeks per year nationally and internationally under the mark

Glenn Miller Orchestra. The Glenn Miller Orchestra today is internationally renowned as the leading "big band" orchestra in the world.

8. From time to time since 1956 plaintiff, in addition to rendering live performances of the Glenn Miller Orchestra, has sold in commerce recordings, audio tapes, video tapes and other Glenn Miller Orchestra memorabilia. Continuously since 1983, plaintiff has actively marketed products, including, but not limited to, recordings, audio and video tapes, C.D.'s, clothing, including jackets, hats, golf shirts, tee shirts and other memorabilia, all bearing the mark Glenn Miller Orchestra or plaintiff's registered logo "GMO." These goods have been consistently sold by plaintiff, nationally and internationally, as part of the business of plaintiff and the Glenn Miller Orchestra. Annexed hereto as Exhibit 3 is a copy of the homepage from plaintiff's website.

9. Based upon the foregoing, plaintiff's mark, the "Glenn Miller Orchestra", is a famous and distinctive mark, as those terms are used in the Federal Trademark Dilution Act (15 U.S.C. 1125 (c)). The mark has been used in commerce continuously since 1956. Hundreds of thousands of dollars have been spent on advertising and publicizing plaintiff's mark for more than 40 years. Plaintiff's mark is registered on the Principal Register in the United States Patent Office and plaintiff's mark is readily recognized by big band fans worldwide.

FIRST CAUSE OF ACTION

10. Plaintiff repeats and realleges each and every allegation set forth in paragraphs 1 through 9 above with the same force and effect as if here set forth at

length. The court has jurisdiction of this cause of action pursuant to 15 U.S.C. 1121 and 28 U.S.C. 1331.

11. Upon information and belief, in 1987, defendant began to advertise, promote and sell a leather bomber jacket bearing the photograph of Glenn Miller on the back of the jacket, in his Army Air Force uniform with the words "Glenn Miller's AAF Band." The Letters "AAF" refer to Army Air Force. Counsel for plaintiff warned defendant in writing that its conduct constituted an infringement of plaintiff's service mark. Annexed hereto as Exhibit 4 is a copy of a letter to defendant dated November 23, 1987. Defendant agreed to withdraw all offending products from the market. Annexed hereto as Exhibit 5 is a copy of the letter from defendant's attorney dated March 1, 1988. Plaintiff accepted defendant's withdrawal of the products and took no further action.

12. Early in 2002 plaintiff learned that defendant was again marketing the same bomber jacket as it did in 1987. Again, plaintiff's counsel advised defendant in writing that its conduct constituted an infringement of plaintiff's service mark. A copy of counsel's letter to defendant dated February 6, 2002 is annexed hereto as Exhibit 6. The only difference in circumstances between 1987 and 2002 is that in 2002 defendant claimed that it was acting "under license from the Glenn Miller estate." Annexed hereto as Exhibit 7 is a copy of defendant's current advertising. Annexed hereto as Exhibits 8 and 9 respectively are copies of a letter from defendant's counsel dated February 20, 2002 and a responding letter from plaintiff's counsel dated August 26, 2002. In Exhibit 9, plaintiff's

counsel points out that defendant could not have a license from the Glenn Miller Estate since that estate was closed by court order effective December 31, 1977. Annexed hereto collectively as Exhibit 10 are copies of the order and amended order of Judge Sherwin Lester, Superior Court of New Jersey, Chancery Division, Bergen County, dated February 10, 1978 and March 22, 1978 respectively.

13. Notwithstanding defendant's actual notice in 1987 of its infringing conduct, defendant knowingly and willfully resumed its unlawful conduct in February 2002 and continues to do so today. Defendant's present conduct continues notwithstanding its actual knowledge that it has no valid license from the Glenn Miller Estate. Defendant's conduct is a knowing, willful use of plaintiff's mark with intent to trade on plaintiff's reputation and/or to cause dilution to plaintiff's pre-existing, famous mark. By its advertising, defendant has and continues to knowingly, falsely designate the origin of its mark.

14. Based upon the foregoing, plaintiff is entitled to injunctive relief pursuant to 15 U.S.C. 1116, damages consisting of defendant's profits on the sales of the offending merchandise, treble damages, attorneys' fees and costs pursuant to 15 U.S.C. 1117.

15. As a result of defendant's unlawful and willful conduct as set forth above, plaintiff's service mark, Glenn Miller Orchestra has been substantially diluted in all geographic and demographic areas where defendant has advertised and marketed the offending merchandise.

SECOND CAUSE OF ACTION

16. Plaintiff repeats and realleges each and every allegation set forth in paragraphs 1 through 15 above with the same force and effect as if here set forth at length. The court has jurisdiction of this cause of action pursuant to 15 U.S.C. 1121 and 28 U.S.C. 1331.

17. Based upon the foregoing, defendant, through its advertising has and continues to falsely designate the origin of its mark.

18. Based upon the foregoing, plaintiff is entitled to injunctive relief pursuant to 15 U.S.C. 1116, damages consisting of defendant's profits on the sales of the offending merchandise, treble damages, attorneys' fees and costs pursuant to 15 U.S.C. 1117.

THIRD CAUSE OF ACTION

19. Plaintiff repeats and realleges each and every allegation set forth in paragraphs 1 through 18 above with the same force and effect as if here set forth at length. This court has jurisdiction of this cause of action pursuant to 28 U.S.C. 1337 and 1338.

20. Based upon the foregoing, defendant is guilty of unfair competition.

21. Based upon the foregoing, plaintiff is entitled to injunctive relief pursuant to 15 U.S.C. 1116, damages consisting of defendant's profit on the sales of the offending merchandise, treble damages, attorneys' fees and costs pursuant to 15 U.S.C. 1117.

WHEREFORE, plaintiff demands judgment in its favor against defendant as follows:

(a) The issuance of a permanent injunction enjoining defendant from diluting plaintiff's service mark, falsely designating the origin of its mark and unfairly competing with plaintiff;

(b) Damages consisting of three times the profits earned by defendant from the sales of the offending merchandise;

(c) Interest, attorneys fees and costs and

(d) Such other and further relief which the Court deems just and proper.

Dated: New York, New York
November 6, 2002

Foley, Hickey, Gilbert & O'Reilly

By: 

Terrence P. O'Reilly (TO-5353)
Attorneys for Plaintiff
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