

AO 120 (Rev. 3/04)

TO: Mail Stop 8 Director of the U.S. Patent and Trademark Office P.O. Box 1450 Alexandria, VA 22313-1450	<b>REPORT ON THE                  FILING OR DETERMINATION OF AN                  ACTION REGARDING A PATENT OR                  TRADEMARK</b>
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In Compliance with 35 U.S.C. § 290 and/or 15 U.S.C. § 1116 you are hereby advised that a court action has been filed in the U.S. District Court District of Nevada on the following  Patents or  Trademarks:

DOCKET NO. 2:08-cv-01123-KJD-RJJ	DATE FILED 8/22/2008	U.S. DISTRICT COURT District of Nevada
PLAINTIFF Glen J. Lerner		DEFENDANT Richard Sackett, et al
PATENT OR TRADEMARK NO.	DATE OF PATENT OR TRADEMARK	HOLDER OF PATENT OR TRADEMARK
1 See Complaint		
2 2,1924,045		
3		
4		
5		

In the above—entitled case, the following patent(s)/ trademark(s) have been included:

DATE INCLUDED	INCLUDED BY <input type="checkbox"/> Amendment <input type="checkbox"/> Answer <input type="checkbox"/> Cross Bill <input type="checkbox"/> Other Pleading		
PATENT OR TRADEMARK NO.	DATE OF PATENT OR TRADEMARK	HOLDER OF PATENT OR TRADEMARK	
1 See Complaint			
2			
3			
4			
5			

In the above —entitled case, the following decision has been rendered or judgement issued:

DECISION/JUDGEMENT
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CLERK <b>Lance S. Wilson</b>	(BY) DEPUTY CLERK <b>Oscar Campos</b>	DATE <b>8/25/2008</b>
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Copy 1—Upon initiation of action, mail this copy to Director Copy 3—Upon termination of action, mail this copy to Director  
 Copy 2—Upon filing document adding patent(s), mail this copy to Director Copy 4—Case file copy

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8 UNITED STATES DISTRICT COURT

9 DISTRICT OF NEVADA

10 Glen J. Lerner, P.C.; Glen J. Lerner,

11 Plaintiffs,

12 v.

13 Richard Sackett, an individual, LawCo  
USA, PLLC, a D.C. corporation and Group  
14 Matrix, Inc. a company of foreign origin

15 Defendants.

Case No.

COMPLAINT

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16  
17 Plaintiff Glen J. Lerner, P.C., a professional corporation, and Glen J. Lerner,  
18 individually, (hereinafter collectively referred to as "Lerner"), for their Complaint against  
19 Defendants Richard Sackett ("Sackett"), LawCo USA, PLLC ("LawCo"), and Group Matrix,  
20 Inc. ("Group Matrix") (collectively, "Defendants") hereby allege as follows:

21 **NATURE OF CLAIMS**

22 1. Lerner seeks a declaratory judgment that his use of the HEAVY HITTER and  
23 HEAVY HITTERS trademarks (collectively the "Marks") for legal services has not infringed  
24 or otherwise violated Defendants' alleged trademark or other rights in HEAVY HITTER or  
25 HEAVY HITTERS for legal or any other services.

26 **JURISDICTION**

27 2. This case arises under the Federal Declaratory Judgments Act, 28 U.S.C. §§  
28 2201 and 2202, the Lanham Act, 15 U.S.C. § 1051 et seq., and related state and common

1 law sections related to trademark infringement, unfair competition, and/or deceptive trade  
2 practices.

3 3. This Court has jurisdiction under 15 U.S.C. § 1121 and 28 U.S.C. §§ 1331  
4 and 1338. The Court has supplemental jurisdiction over Plaintiff's state law claims  
5 pursuant to 28 U.S.C. § 1367(a).

6 4. This Court has personal jurisdiction over Defendants because they: (a)  
7 attempted to contract with Lerner, whom they knew was located in the State of Nevada;  
8 (b) solicit or have solicited business in the State of Nevada; and (c) have sent threatening  
9 correspondence to Lerner in the State of Nevada threatening to take action against Lerner  
10 if Lerner does not comply with their demands.

11 5. Defendants have created an actual case and controversy and a reasonable  
12 apprehension of litigation by, among other things, sending a letter threatening to file suit  
13 against Lerner on August 14, 2008.

14 **THE PARTIES**

15 6. Plaintiff Glen J. Lerner is an attorney and President of Glen J. Lerner, P.C., a  
16 Nevada professional corporation with its principal place of business in Las Vegas,  
17 Nevada. Lerner primarily represents plaintiffs who have been personally injured due to  
18 the negligent conduct of others.

19 7. Upon information and belief, Defendant Sackett is an individual living in the  
20 State of Louisiana who allegedly owns trademark registrations and applications with the  
21 United States Patent and Trademark Office ("USPTO") for HEAVY HITTERS.

22 8. Upon information and belief, LawCo USA, PLLC, is a corporation registered  
23 in Washington, D.C. with its principal place of business in Washington, D.C. Upon  
24 information and belief, LawCo is an advertising agency which is owned and operated by  
25 Sackett.

26 9. Upon information and belief, Group Matrix, Inc., is a corporation with its  
27 principal place of business in Fort Lauderdale, Florida. Upon information and belief,  
28 Group Matrix is an advertising agency which is owned and operated by Sackett.

**ALLEGATIONS COMMON TO ALL COUNTS**

1  
2 10. Plaintiff is in the business of providing legal services to the purchasing public  
3 in the State of Nevada.

4 11. Plaintiff has since 2001 used the trademarks HEAVY HITTER and HEAVY  
5 HITTERS in commerce in association with his provision of legal services. Plaintiff has  
6 expended millions of dollars in advertising said services under the Marks, has exerted  
7 every effort to maintain the highest standards of quality for said services, and has created  
8 invaluable good will under said trademarks among the purchasing public.

9 12. On information and belief, Defendants are involved in the business of  
10 providing advertising and promotion services to third parties.

11 13. In August of 2002, Plaintiff attempted to enter into an advertising agreement  
12 with Defendants regarding the advertising and promotion of Plaintiff's legal services (the  
13 "Agreement"). At the time the parties attempted to enter into the Agreement, Plaintiff  
14 believed that Defendants had legitimate trademark rights in the terms HEAVY HITTER  
15 and HEAVY HITTERS for use in connection with legal services based upon Defendants'  
16 alleged ownership of U.S. Trademark Application Serial Nos. 78/056565, filed on April 3,  
17 2001, and 78/080511, filed on August 22, 2001.

18 14. Prior to attempting to enter into the Agreement, and during the term of the  
19 alleged Agreement, Plaintiff used the Marks exclusively and extensively as a source  
20 identifier of his legal services offered in the State of Nevada. Defendants induced  
21 Plaintiffs to enter into the alleged Agreement based upon the misrepresentation that  
22 Defendants owned legitimate trademark rights in the Marks. However, in reality  
23 Defendants did not and do not own trademark rights in the Marks for legal services as  
24 Defendants themselves do not provide such legal services in connection with the Marks.  
25 Additionally, Defendants cannot provide such services because Defendants are not  
26 licensed attorneys capable of providing legal services.

27 15. Defendants cannot rely on Plaintiff's use of the Marks under the alleged  
28 Agreement to establish trademark rights because Defendants did not control the quality of

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1 the legal services Plaintiff offered in connection with the Marks, as required by the  
2 Trademark Act, 15 U.S.C. §§ 1055, 1127.

3 16. Upon information and belief, Defendants have entered into advertising  
4 and/or licensing agreements with third party legal service providers for use of the Marks in  
5 territories outside of Nevada.

6 17. Upon information and belief, Defendants have not exercised the requisite  
7 quality control over the legal services offered by any of its clients necessary to establish  
8 trademark rights; therefore, Defendants do not have legitimate trademark rights in the  
9 Marks.

10 18. Given that Plaintiff was fraudulently induced by Defendants into attempting  
11 to enter the Agreement, and Defendants have no legitimate trademark rights in the Marks,  
12 there is no breach of the Agreement, no service mark infringement under the Federal  
13 Lanham Act and related State laws, nor unfair competition under state and federal law.

14 19. Due to Defendants' threats to file suit against Plaintiff, Plaintiff has a  
15 reasonable apprehension that Defendants will file legal action against him.

16 **CLAIMS FOR RELIEF**

17 **FIRST CLAIM FOR RELIEF**

18 **Declaration as to Rights Pursuant to 28 U.S.C. § 2201 and Trademark Infringement**  
19 **under The Lanham Act, 15 U.S.C. § 1114**

20 20. Plaintiff incorporates the allegations in the preceding paragraphs as if set  
21 forth fully herein.

22 21. Declaratory relief actions are available when an actual case or controversy  
23 exists between two parties.

24 22. Beginning on August 14, 2008, Defendants have asserted that Plaintiff's use  
25 of the Marks constitutes an infringement of trademark rights allegedly held by Defendants  
26 in violation of The Lanham Act, and demanding, *inter alia*, that Plaintiff immediately cease  
27 and desist all use of the Marks and similar variations thereof.

28 23. Plaintiff maintains that his use of the Marks is lawful and does not infringe

1 upon the rights of Defendants.

2 24. Therefore, an actual case or controversy exists between the parties.

3 25. Plaintiff has no adequate remedy at law under administrative law and before  
4 the USPTO.

5 26. Defendants' assertions that Plaintiff is violating their legal rights irreparably  
6 injures and adversely affects Plaintiff and, unless prevented by this Court, will continue to  
7 so affect Plaintiff's business and the immense investment he has made in the Marks and  
8 attendant good will. To resolve the legal and factual questions raised by Defendants and  
9 to afford relief from the uncertainty and controversy which Defendants' assertion has  
10 precipitated, Plaintiff is entitled to a declaratory judgment of his rights under 28 U.S.C. §§  
11 2201-02. Plaintiff's use of the Marks is not in violation of any rights Defendants might  
12 have pursuant to 15 U.S.C. § 1114(1).

13 27. Plaintiff hereby seeks a judicial declaration of his continued right to use the  
14 Marks free and clear of interference or harassment by Defendants and without any  
15 obligation or liability to Defendants.

16 28. Plaintiff additionally seeks reimbursement of his attorneys' fees and costs  
17 from Defendants associated with bringing the action at hand.

18 **SECOND CLAIM FOR RELIEF**

19 **Declaratory Relief Concerning Unfair Competition Under The Lanham Act, 15 U.S.C.**  
20 **§ 1125(a)**

21 29. Plaintiff incorporates the allegations in the preceding paragraphs as if set  
22 forth fully herein.

23 30. Beginning on August 14, 2008, Defendants have asserted that Plaintiff's use  
24 of the Marks constitutes unfair competition in violation of The Lanham Act, and  
25 demanding, *inter alia*, that Plaintiff immediately cease and desist all use of the Marks and  
26 similar variations thereof.

27 31. Plaintiff maintains that his use of the Marks is lawful and does not infringe  
28 upon the rights of Defendants.

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1 32. Therefore, an actual case or controversy exists between the parties.

2 33. Defendants' assertions that Plaintiff is violating their legal rights irreparably  
3 injures and adversely affects Plaintiff and, unless prevented by this Court, will continue to  
4 so affect Plaintiff's business and the immense investment he has made in the Marks and  
5 attendant good will. To resolve the legal and factual questions raised by Defendants and  
6 to afford relief from the uncertainty and controversy which Defendants' assertion has  
7 precipitated, Plaintiff is entitled to a declaratory judgment of his rights under 28 U.S.C. §§  
8 2201-02.

9 34. Plaintiff's use in commerce of the Marks is not likely to cause confusion, or to  
10 cause mistake, or to deceive as to the affiliation, connection, or association of Plaintiff with  
11 Defendants and is not likely to cause confusion as to the origin, sponsorship, or approval  
12 of Plaintiff's services and the services offered by Defendants. Therefore, Plaintiff's use of  
13 the Marks does not constitute false designation of origin pursuant to Section 43(a) of the  
14 Lanham Act, 15 U.S.C. § 1125(a).

15 35. Plaintiff's use of the Marks is not in violation of any rights Defendants might  
16 have under the federal law of unfair competition pursuant to 15 U.S.C. § 1051 *et. seq.*,  
17 and, specifically, 15 U.S.C. § 1125(a).

18 **THIRD CLAIM FOR RELIEF**

19 **Declaratory Relief Regarding Nevada State Trademark Infringement N.R.S. § 600.420**

20 36. Plaintiff incorporates the allegations in the preceding paragraphs as if fully  
21 set forth herein.

22 37. Beginning on August 14, 2008, Defendants have asserted that Plaintiff's use  
23 of the Marks constitutes trademark infringement under the trademark laws of the State of  
24 Nevada in violation of N.R.S. § 600.420, and demanding, *inter alia*, that Plaintiff  
25 immediately cease and desist all use of the Marks and similar variations thereof.

26 38. Plaintiff maintains that his use of the Marks is lawful and does not infringe  
27 upon the rights of Defendants.

28 39. Therefore, an actual case or controversy exists between the parties.

1 40. Defendants' assertions that Plaintiff is violating their legal rights irreparably  
2 injures and adversely affects Plaintiff and, unless prevented by this Court, will continue to  
3 so affect Plaintiff's business and the immense investment he has made in the Marks and  
4 attendant good will. To resolve the legal and factual questions raised by Defendants and  
5 to afford relief from the uncertainty and controversy which Defendants' assertion has  
6 precipitated, Plaintiff is entitled to a declaratory judgment of his rights under 28 U.S.C. §§  
7 2201-02.

8 41. Plaintiff has not used any trademarks in which Defendants have legitimate  
9 rights in connection with the sale, offering for sale and/or advertising of Plaintiff's services.

10 42. Plaintiff's use of the Marks is not likely to cause confusion or mistake among  
11 consumers or result in deception as to the source or origin of such services.

12 43. The use by Plaintiff of the Marks is not in violation of any rights Defendants  
13 might have under the trademark laws of the State of Nevada as set forth in N.R.S. §  
14 600.430.

15 **FORTH CLAIM FOR RELIEF**

16 **Declaratory Relief Concerning Nevada Unfair Competition**  
17 **and Deceptive Trade Practices**

18 44. Plaintiff incorporates the allegations in the preceding paragraphs as if fully  
19 set forth herein.

20 45. Beginning on August 14, 2008, Defendants have asserted that Plaintiff's use  
21 of the Marks constitutes unfair competition and deceptive trade practices in violation of the  
22 laws of the State of Nevada, and demanding, *inter alia*, that Plaintiff immediately cease  
23 and desist all use of the Marks and similar variations thereof.

24 46. Plaintiff maintains that his use of the Marks is lawful and does not infringe  
25 upon the rights of Defendants.

26 47. Therefore, an actual case or controversy exists between the parties.

27 48. Defendants' assertions that Plaintiff is violating their legal rights irreparably  
28 injures and adversely affects Plaintiff and, unless prevented by this Court, will continue to

1 so affect Plaintiff's business and the immense investment he has made in the Marks and  
2 attendant good will. To resolve the legal and factual questions raised by Defendants and  
3 to afford relief from the uncertainty and controversy which Defendants' assertion has  
4 precipitated, Plaintiff is entitled to a declaratory judgment of his rights under 28 U.S.C. §§  
5 2201-02.

6 49. Plaintiff has used the Marks in commerce in connection with legal services in  
7 the State of Nevada since 2001.

8 50. Plaintiff's use of the Marks does not constitute unfair competition under the  
9 U.S. Lanham Act and deceptive trade practices or its equivalent under Nevada State law.

10 51. Plaintiff seeks a judicial declaration of its continued right to use the Marks  
11 and seeks a declaration of this Court that his use does not constitute unfair competition  
12 nor deceptive trade practices under either The Lanham Act or Nevada's Deceptive Trade  
13 Practices Act.

14 **FIFTH CLAIM FOR RELIEF**

15 **Cancellation of Registration No. 2,924,045 Based on Defendants' Fraudulent**  
16 **Representations to the USPTO**

17 52. Plaintiff incorporates the allegations in the preceding paragraphs as if set  
18 forth fully herein.

19 53. On information and belief, Plaintiff avers that Defendants' federal registration  
20 of the mark in U.S. Registration No. 2,924,045 for HEAVY HITTERS for legal services was  
21 obtained fraudulently, within 15 U.S.C. § 1115 (b)(1), because Defendants were not, and  
22 have not used the mark in commerce in connection with legal services since the  
23 application for registration of the mark was filed in 2001.

24 54. On information and belief, Plaintiff avers that Defendants have abandoned  
25 any ownership interest they may have had in the mark, within 15 U.S.C. § 1115(b)(2),  
26 because Defendants have never used the mark in commerce in connection with legal  
27 services since they applied for a federal registration in 2001.

28 55. Plaintiff is entitled to cancellation of Defendants' registration, pursuant to the

1 Lanham Act, 15 U.S.C § 1064(3), since the registration was fraudulently obtained and/or  
2 abandoned by Defendants.

3 **SIXTH CLAIM FOR RELIEF**

4 **Fraud**

5 56. Plaintiff incorporates the allegations in the preceding paragraphs as if set  
6 forth fully herein.

7 57. Plaintiff attempted to enter into the Agreement with Defendants in August  
8 2002.

9 58. Beforehand, Defendants falsely represented to Plaintiff that the Defendants  
10 had legitimate trademark rights in the Marks.

11 59. Defendants knew that they were not offering, nor could they offer, legal  
12 services in commerce, nor were Defendants exercising the requisite quality control over  
13 any of their clients' services to establish use of the Marks in commerce. Therefore,  
14 Defendants knew that they did not have legitimate trademark rights in the Marks and  
15 concealed this fact from Plaintiff in order to induce Plaintiff to enter into the Agreement  
16 after Plaintiff had already begun using the Marks in commerce.

17 60. Plaintiff attempted to enter into the Agreement with Defendants in  
18 detrimental reliance upon the false representations and active concealment of pertinent  
19 information by Defendants.

20 61. Plaintiff would not have attempted to enter into the Agreement if he had  
21 known that Defendants did not have legitimate trademark rights in the Marks.

22 62. The acts of Defendants as alleged herein were deliberately misleading,  
23 fraudulent and calculated to induce Plaintiff to enter into the Agreement.

24 63. By reason of the foregoing and because the alleged Agreement was the  
25 product of fraud, Plaintiff is entitled to an order rescinding the alleged Agreement and  
26 thus, Plaintiff has not breached the alleged Agreement.

27 64. As a direct and proximate result of the acts of Defendants, Plaintiff has  
28 suffered and will continue to suffer damage in an amount exceeding \$75,000.00 to be

1 proven at trial if not granted the requested relief.

2 65. Plaintiff additionally seeks reimbursement of his attorneys' fees and costs  
3 from Defendants associated with bringing the action at hand.

4 **PRAYER FOR RELIEF**

5 WHEREFORE, Plaintiff respectfully requests that the Court grant the following  
6 relief:

7 A. A determination and adjudication of the rights and liabilities of the parties  
8 with regard to the Marks as they relate to this dispute;

9 B. A declaration that Plaintiff's use of the Marks is lawful and does not infringe  
10 upon any rights of Defendants;

11 C. Cancellation of Defendants' U.S. Registration No. 2,924,045;

12 D. A permanent injunction prohibiting Defendants from further vexing conduct  
13 or harassment of Plaintiff;

14 E. An award of interests, costs, and attorneys' fees incurred by Plaintiff in  
15 prosecuting this action; and

16 F. All other relief to which Plaintiff is entitled.

17 DATED this 22 day of August, 2008.

18 GREENBERG TRAUIG, LLP

19  
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