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Whole Oats Enterprises

**UNITED STATES DISTRICT COURT
FOR THE EASTERN DISTRICT OF NEW YORK**

WHOLE OATS ENTERPRISES,

Plaintiff,

vs.

EARLY BIRD FOODS & CO., LLC,

Defendant.

Case No.: 15-cv-1124

**COMPLAINT ALLEGING TRADEMARK
AND SERVICE MARK INFRINGEMENT,
COMMON LAW TRADEMARK AND
SERVICE MARK INFRINGEMENT AND
UNFAIR COMPETITION**

Jury Trial Demanded

The Plaintiff Whole Oats Enterprises (“Plaintiff”), by and through its undersigned attorneys, for its complaint against the defendant, alleges as follows:

NATURE OF ACTION

1. This is an action for trademark and service mark infringement, unfair competition and other relief arising under the trademark and service mark laws of the United States, specifically 15 U.S.C. § 1051 *et seq.* (hereinafter “Lanham Act”) and the common law of the State of New York.

THE PARTIES

2. Plaintiff Whole Oats Enterprises is a partnership organized under the laws of New York and is solely owned by partners Daryl Hall and John Oates, with a principal address of c/o Fulton & Meyer, 16030 Ventura Blvd., Suite 240, Encino, California 91436.

3. Daryl Hall and John Oates (collectively the “Artists”), the sole partners of Whole Oats Enterprises, are well known musicians and members of the world famous musical duo DARYL HALL AND JOHN OATES, which musical group is commonly referred to by the group, fans and the media as HALL & OATES. The Artists have assigned the rights to the trademarks and service marks DARYL HALL AND JOHN OATES and HALL & OATES to Whole Oats Enterprises.

4. Upon information and belief, the defendant Early Bird Foods & Co., LLC (“Defendant”) is a limited liability company organized and existing under the laws of the state of New York with a principal place of business located at 24 Commerce Street, Brooklyn, New York 11231.

JURISDICTION AND VENUE

5. This Court has subject matter jurisdiction over this action pursuant to 28 U.S.C. §§ 1331 and 1338 because Plaintiff’s claims arise under the trademark and service mark laws of the United States. This Court also has supplemental jurisdiction pursuant to 28 U.S.C. §§ 1338(b) and 1367 over Plaintiff’s claims that arise under the laws of the State of New York.

6. This Court has personal jurisdiction over the parties to this action because (i) Plaintiff’s claims arise in this judicial district, and (ii) the defendant is located within this judicial district and each party does business in this judicial district.

7. Venue is proper in this judicial district pursuant to 28 U.S.C. § 1391 because Defendant’s primary place of business is in this judicial district, each party does business in this

judicial district, witnesses and evidence are located within this judicial district, and the acts complained of herein have taken place in this judicial district.

PLAINTIFF'S "DARYL HALL AND JOHN OATES" AND "HALL & OATES"
TRADEMARKS AND SERVICE MARKS

8. The Artists are well known musicians and members of the world famous musical duo DARYL HALL AND JOHN OATES. DARYL HALL AND JOHN OATES is one of the most successful musical groups of the last 40 years, having begun performing and recording in the early 1970s. Since that time, the group has sold many millions of musical sound recordings, and sold more albums than any other duo in music history.

9. From the mid-1970s to the mid-1980s, DARYL HALL AND JOHN OATES released six singles that went to Number 1 on the charts, namely the songs "Rich Girl", "Kiss on My List," "Private Eyes," "I Can't Go For That (No Can Do), "Maneater" and "Out of Touch." These singles were featured on the group's six consecutive multi-platinum albums, namely, *Bigger Than Both of Us* (1976), *Voices* (1980), *Private Eyes* (1981), *H2O* (1982), *Rock N Soul, Part I* (1983) and *Big Bam Boom* (1984).

10. DARYL HALL AND JOHN OATES has been performing in the most well-known music venues in the United States for decades and has participated in such historic musical moments as the "We Are The World" sessions and resulting hit single, as well as the Live-Aid concert held in Philadelphia in 1985. In addition, DARYL HALL AND JOHN OATES was inducted into the Rock N' Roll Hall of Fame in 2014 in connection with which the duo performed at the induction ceremony which took place at the Barclays Center in Brooklyn, New York.

11. DARYL HALL AND JOHN OATES has continuously recorded and performed for music fans throughout the United States and elsewhere throughout the world for over four decades.

12. Plaintiff is the owner of the following United States Trademark and Service Mark registrations for its DARYL HALL AND JOHN OATES mark:

DARYL HALL AND JOHN OATES, Reg. No. 3,176,157, a registration in International Class 9 for musical sound recordings; musical video recordings;

DARYL HALL AND JOHN OATES, Reg. No. 1,340,047, a registration in International Class 25 for Tee-Shirts, Sweat Shirts; and

DARYL HALL AND JOHN OATES, Reg. No. 1,288,280, a registration in International Class 41 for Entertainment Services Rendered by a Vocal and Instrumental Group.

Printouts from the United States Patent and Trademark Office's Online Database of Plaintiff's registrations are attached hereto as **Exhibit A**.

13. The musical group DARYL HALL AND JOHN OATES is commonly referred to by the group, fans and the media as HALL & OATES. In addition to its rights in and to the mark DARYL HALL AND JOHN OATES, Plaintiff is the owner of well-established common law trademark and service mark rights in and to the mark HALL & OATES.

14. Plaintiff and Artists have invested a substantial amount of time, money and other resources advertising, promoting, marketing and publicizing their goods and services provided under the DARYL HALL AND JOHN OATES and HALL & OATES marks. As a result of Plaintiff's substantial advertising, marketing and promotional efforts, Plaintiff's marks have acquired substantial consumer recognition and goodwill. Plaintiff's marks have become important source indicators which identify the quality goods and services provided by Plaintiff and the Artists. For all of the foregoing reasons, Plaintiff's DARYL HALL AND JOHN OATES and HALL & OATES marks are exceedingly valuable assets of Plaintiff.

15. By virtue of Plaintiff's extensive use of the marks DARYL HALL AND JOHN OATES and HALL & OATES, the marks have developed significant consumer recognition and goodwill. The marks DARYL HALL AND JOHN OATES and HALL & OATES have come to

be widely recognized by the public as identifying Plaintiff and Artists and their musical group goods and services.

PLAINTIFF'S "HAULIN' OATS" MARK

16. Plaintiff is the owner, via assignment, of the mark HAULIN' OATS that is used in connection with the sale of oatmeal and the provision of food delivery services. Plaintiff is the owner of United States Trademark and Service Mark Reg. No. 4,345,444 for the mark HAULIN' OATS in International Class 30 for oatmeal and in International Class 39 for food delivery, which mark has been in use since March 1, 2012.

17. The mark HAULIN' OATS is a phonetic play upon Plaintiff's well-known HALL & OATES name and mark.

DEFENDANT'S INFRINGEMENT

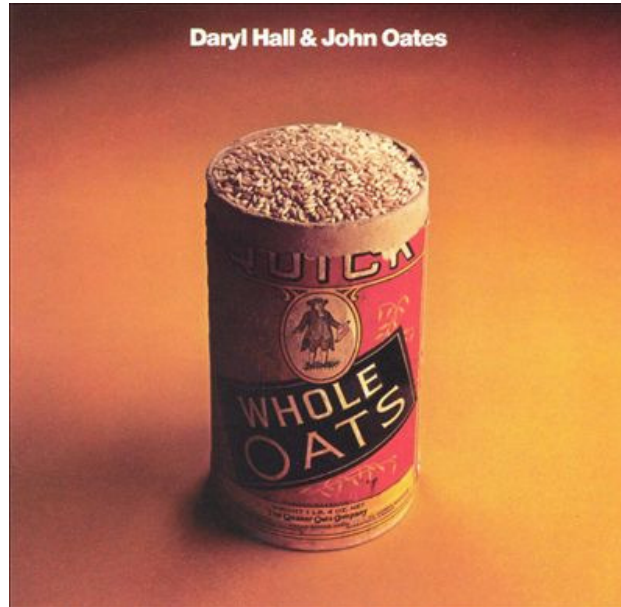
18. Subsequent to Plaintiff's substantial use of its DARYL HALL AND JOHN OATES marks, and subsequent to Plaintiff's marks acquiring public recognition as identifying and distinguishing Plaintiff's goods and services from those of others, Defendant began using the confusingly similar name and mark "Haulin' Oats" in connection with the sale of granola.

19. Upon information and belief, Defendant has utilized the confusingly similar mark "Haulin' Oats" on its product packaging, its advertising materials and on its website.

20. The name and mark "Haulin' Oats" is an obvious play upon Plaintiff's well-known HALL & OATES mark, and was selected by Defendant in an effort to trade off of the fame and notoriety associated with the Artists and Plaintiff's well-known marks.

21. Over the years, various third parties have attempted to trade off of the fame and notoriety associated with the Artists and Plaintiff's marks, including by attempting to make a connection between the Artists' names and oats-related products.

22. In fact, DARYL HALL & JOHN OATES made this same connection from their inception, as the group's first full length musical sound recording was entitled "Whole Oats" (which title is used by Plaintiff as its corporate name) and the album cover featured a photograph of a container of oats bearing the words "Whole Oats," which album cover is depicted below:



23. In 2014, Plaintiff became aware that an entity named Haulin' Oats, a partnership organized under the laws of California and based in Nashville, Tennessee, was also utilizing the mark HAULIN' OATS in connection with the sale of oatmeal and the provision of food delivery services.

24. Thereafter, Plaintiff and Haulin' Oats entered into a business relationship whereby Haulin' Oats assigned to Plaintiff its trademark and service mark rights in and to the mark HAULIN' OATS (including the United States Trademark and Service Mark Registration identified above) and Plaintiff granted a royalty-based license back to Haulin' Oats.

25. Defendant's goods provided under the mark "Haulin' Oats" are highly related in nature to Plaintiff's licensee's goods sold under the HAULIN' OATS mark (namely oatmeal)

and are directed towards the same class of consumers, such that Plaintiff and Plaintiff's licensee on the one hand and Defendant on the other hand are unquestionably in competition with respect to those goods.

26. Defendant's use of the name and mark "Haulin' Oats" is so similar to Plaintiff's DARYL HALL AND JOHN OATES and HALL & OATES marks, and is identical to its HAULIN' OATS mark, that it is likely to cause confusion, mistake or deception as to the source or origin of Defendant's goods. As a result of Defendant's use of the confusingly similar mark "Haulin' Oats" in connection with its goods, consumers are likely to believe that Defendant's goods are provided by, or sponsored by, or approved by, or licensed by, or affiliated with or in some other way legitimately connected to Plaintiff.

27. The acts of Defendant complained of hereinabove are unlawful, willful and knowingly performed with the intent and result of injuring Plaintiff.

PLAINTIFF'S NOTICE TO DEFENDANT

28. Counsel for Plaintiff sent a cease and desist letter dated April 3, 2014 to Defendant, putting Defendant on notice of Plaintiff's rights in and to the marks DARYL HALL AND JOHN OATES and demanding that Defendant cease and desist from using the mark "Haulin' Oats" in connection with its goods.

29. On April 24, 2014, Plaintiff received a letter from Defendant's counsel indicating that they would not comply with Plaintiff's demands. Plaintiff sent a responsive letter to Defendant's counsel on May 21, 2014.

30. Defendant did not respond to Plaintiff's May 21, 2014 letter and has failed to comply with the demands set forth in Plaintiff's aforementioned letters and continues to utilize the mark "Haulin' Oats" in connection with its goods.

COUNT I

TRADEMARK AND SERVICE MARK INFRINGEMENT

31. Plaintiff repeats and realleges each and every allegation contained in Paragraphs 1-30 of the Complaint as though fully set forth herein.

32. Defendant, through its conduct described above, is providing in interstate commerce goods under a mark that is a colorable imitation of Plaintiff's registered DARYL HALL & JOHN OATES trademark and service mark, which is likely to cause confusion or mistake and/or to deceive in violation of the Lanham Act Section 32(1) (15 U.S.C. § 1114(1)).

33. In addition, Defendant, through its conduct described above, is providing in interstate commerce goods under a mark that is a colorable imitation of Plaintiff's registered HAULIN' OATS trademark and service mark, which is likely to cause confusion or mistake and/or to deceive in violation of the Lanham Act Section 32(1) (15 U.S.C. § 1114(1)).

34. Upon information and belief, Defendant has committed such acts of infringement willfully and with full knowledge of Plaintiff's prior use and registration of, and rights in and to, its DARYL HALL & JOHN OATES and HAULIN' OATS trademarks and service marks.

35. As a result of Defendant's acts of infringement, Plaintiff has suffered and will continue to suffer serious and irreparable harm for which there is no adequate remedy at law.

COUNT II

**UNFAIR COMPETITION UNDER SECTION 43(a)
OF THE LANHAM ACT**

36. Plaintiff repeats and realleges each and every allegation contained in Paragraphs 1-35 of the Complaint as though fully set forth herein.

37. Defendant, through its conduct as described above, is providing goods under a colorable imitation of Plaintiff's protectable marks DARYL HALL & JOHN OATES, HALL & OATES and HAULIN' OATS, which is likely to cause confusion or mistake and/or to deceive in violation of Section 43(a) of the Lanham Act (15 U.S.C. § 1125(a)).

38. Defendant has committed such acts of false designation of origin and false description and representation willfully and with full knowledge of Plaintiff's prior use of, and rights in, its DARYL HALL & JOHN OATES, HALL & OATES and HAULIN' OATS marks.

39. As a result of Defendant's acts of unfair competition, Plaintiff has suffered and will continue to suffer serious and irreparable harm for which there is no adequate remedy at law.

COUNT III

COMMON LAW TRADEMARK AND SERVICE MARK INFRINGEMENT AND UNFAIR COMPETITION

40. Plaintiff repeats and realleges each and every allegation contained in Paragraphs 1-39 of the Complaint as though fully set forth herein.

41. Defendant's aforesaid acts constitute infringement of Plaintiff's rights in its common law trademark and service marks DARYL HALL & JOHN OATES, HALL & OATES and HAULIN' OATS and tend to falsely describe or represent that Defendant's goods are provided by, or sponsored by, or approved by, or licensed by, or affiliated with or in some other way legitimately connected to Plaintiff and are of the same character, nature and quality as the goods and services of Plaintiff, thereby damaging Plaintiff and Plaintiff's reputation.

42. The acts of Defendant complained of hereinabove constitute acts of unfair competition against Plaintiff under the common law of the State of New York, which acts have been committed knowingly and willfully and have injured Plaintiff in its trade and business.

43. By reason of the aforesaid acts, Defendant has caused damage to Plaintiff and to the goodwill associated with Plaintiff's mark.

PRAYER FOR RELIEF

WHEREFORE, Plaintiff demands judgment in its favor and against Defendant as follows:

1. That Defendant, and its principals, officers, agents, servants, distributors, affiliates, employees, attorneys and representatives and all those in privity or acting in concert with the Defendant, and each of them, be permanently enjoined and restrained from, directly or indirectly:

(a) Using the confusingly similar marks "Haulin' Oats" or any other marks confusingly similar thereto, alone or in combination with other words, names, styles, titles, designs or marks in connection with the provision of their goods and services;

(b) Using in any other way any other marks or designations so similar to Plaintiff's aforesaid DARYL HALL & JOHN OATES, HALL & OATES and/or HAULIN' OATS marks as to be likely to cause confusion, mistake or deception;

(c) Falsely designating the origin, sponsorship, or affiliation of the Defendant's goods in any manner;

(d) Otherwise competing unfairly with Plaintiff in any manner;

(e) Using any words, names, styles, designs, titles, designations, or marks which create a likelihood of injury to the business reputation of Plaintiff and the goodwill associated therewith;

(f) Using any trade practices whatsoever including those complained of herein, which tend to unfairly compete with or injure Plaintiff's business and goodwill pertaining thereto; and

(g) Continuing to perform in any manner whatsoever any of the acts complained of in this complaint.

2. That the Defendant be required to pay to Plaintiff compensatory damages for the injuries sustained by Plaintiff in consequence of the unlawful acts alleged herein and that such damages be trebled pursuant to 15 U.S.C. § 1117 because of the willful and unlawful acts as alleged herein.

3. That the Defendant be required to account for and pay over to Plaintiff all gains, profits and advantages derived by them from the unlawful activities alleged herein.

4. That Defendant be required to deliver for destruction all stationary, signs, advertisements, promotional flyers, cards, brochures, menus, promotional materials and any other written materials which bear the trademark "Haulin' Oats" together with all plates, molds, matrices and other means and materials for making or reproducing the same.

5. That the Defendant be required to pay to Plaintiff all of its litigation expenses, including but not limited to reasonable attorneys fees and the costs of this action.

6. That Plaintiff be awarded such other and further relief as the Court may deem just and proper.

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140 Broadway, 46th Floor
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(973) 530-2045
Attorneys for Plaintiff
Whole Oats Enterprises

By: /s/ Ronald L. Israel
RONALD L. ISRAEL

Dated: March 4, 2015
New York, New York

EXHIBIT A



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DARYL HALL JOHN OATES

Word Mark DARYL HALL JOHN OATES

Goods and Services IC 009. US 021 023 026 036 038. G & S: musical sound recordings; musical video recordings. FIRST USE: 19710101. FIRST USE IN COMMERCE: 19710101

Standard Characters Claimed

Mark Drawing Code (4) STANDARD CHARACTER MARK

Serial Number 78595103

Filing Date March 25, 2005

Current Basis 1A

Original Filing Basis 1A

Published for Opposition September 12, 2006

Registration Number 3176157

Registration Date November 28, 2006

Owner (REGISTRANT) Whole Oats Enterprises Daryl Hall and John Oates, both US citizens PARTNERSHIP NEW YORK c/o Fulton & Meyer 17530 Ventura Boulevard, Suite 201 Encino CALIFORNIA 91316

Attorney of Record DEBORAH L BENSON

Prior

Registrations 1288280;1340047

Type of Mark TRADEMARK

Register PRINCIPAL

Affidavit Text SECT 15. SECT 8 (6-YR).

Other Data The name DARYL HALL JOHN OATES identifies a living individual whose consent is of record.

Live/Dead Indicator LIVE

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DARYL HALL JOHN OATES

Word Mark DARYL HALL JOHN OATES

Goods and Services IC 041. US 107. G & S: Entertainment Services Rendered by a Vocal and Instrumental Group. FIRST USE: 19710000. FIRST USE IN COMMERCE: 19710000

Mark Drawing Code (5) WORDS, LETTERS, AND/OR NUMBERS IN STYLIZED FORM

Serial Number 73420603

Filing Date April 7, 1983

Current Basis 1A

Original Filing Basis 1A

Published for Opposition May 8, 1984

Registration Number 1288280

Registration Date July 31, 1984

Owner (REGISTRANT) Whole Oats Enterprises Partnership composed of Daryl Hall and John Oates (United States citizens) PARTNERSHIP NEW JERSEY c/o Paul Dickman, Dickman Entertainment PO BOX 63535 Philadelphia PENNSYLVANIA 19147

Attorney of Andrea J. Mealey

Record

Description of Mark

Color is not claimed as a feature of the mark.

Type of Mark

SERVICE MARK

Register

PRINCIPAL

Affidavit Text

SECT 15. SECT 8 (6-YR). SECTION 8(10-YR) 20140827.

Renewal

2ND RENEWAL 20140827

Other Data

The names Daryl Hall and John Oates are of living individuals whose consents are of record.

Live/Dead Indicator

LIVE

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Typed Drawing

Word Mark DARYL HALL JOHN OATES

Goods and Services (CANCELLED) IC 006. US 002 012 013 014 023 025 050. G & S: [Key Chains]. FIRST USE: 19830300. FIRST USE IN COMMERCE: 19830300

(CANCELLED) IC 016. US 002 005 022 023 029 037 038 050. G & S: [Posters and Printed Concert Programs]. FIRST USE: 19760000. FIRST USE IN COMMERCE: 19760000

(CANCELLED) IC 020. US 002 013 022 025 032 050. G & S: [Ornamental Novelty Buttons]. FIRST USE: 19710000. FIRST USE IN COMMERCE: 19710000

IC 025. US 039. G & S: Tee-Shirts, Sweat Shirts [, Shorts, Hats and Visor Caps]. FIRST USE: 19760000. FIRST USE IN COMMERCE: 19760000

Mark Drawing Code (1) TYPED DRAWING

Serial Number 73495661

Filing Date August 20, 1984

Current Basis 1A

Original Filing Basis 1A

Published for Opposition February 19, 1985

Change In Registration CHANGE IN REGISTRATION HAS OCCURRED

Registration Number 1340047

Registration Date June 11, 1985

Owner (REGISTRANT) Whole Oats Enterprises Partnership composed of Daryl Hall, John Oates (United States citizens) PARTNERSHIP c/o Paul Dickman, Dickman Entertainment PO BOX 63535 Philadelphia PENNSYLVANIA 19147

Attorney of Record Andrea J. Mealey

Type of Mark TRADEMARK

Register PRINCIPAL

Affidavit Text SECT 15. PARTIAL SECT 8 (6-YR). SECTION 8(10-YR) 20140917.

Renewal 2ND RENEWAL 20140917

Other Data Daryl Hall and John Oates are the names of living individuals, the two partners of applicant, both whom have consented to the use and registration of their names by signing this application.

Live/Dead Indicator LIVE

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