IN THE UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF NEBRASKA

WILLIE WILSON PRODUCTIONS, INC., Plaintiff, v. MILLARD PUBLIC SCHOOL DISTRICT, Defendant.	No. 8:15-cv-437

COMPLAINT FOR INJUNCTIVE AND OTHER RELIEF

Plaintiff Willie Wilson Productions, Inc. ("Willie Wilson"), by and through its attorneys, for its Complaint against Defendant Millard Public School District ("Defendant"), states as follows:

INTRODUCTION

Willie Wilson is the owner of the "SINGSATION" brand name and is the producer of the SINGSATION entertainment show. Defendant is unlawfully using Willie Wilson's marks related to the SINGSATION brand name in its vocal and musical performances and recordings thereof, namely a show choir competition and performance, operating under the name "Singsation." Willie Wilson seeks injunctive and other relief against Defendant due to Defendant's unlawful use of Willie Wilson's marks. Defendant's actions violate the Lanham Act, U.S. Code Title 15, Nebraska common law, the Nebraska Uniform Deceptive Trade Practices Act (Neb. Rev. Stat. § 87-301 *et seq.*) and the Nebraska Consumer Protection Act (Neb. Rev. Stat. § 59-1601 *et seq.*). If Defendant is allowed to continue to make unauthorized

use of the SINGSATION brand name and marks, Willie Wilson will suffer irreparable harm, for which monetary damages will not provide an adequate remedy.

PARTIES, JURISDICTION AND VENUE

1. Plaintiff, Willie Wilson Productions, Inc., is an Illinois corporation with its principal place of business in Matteson, Illinois. Willie Wilson is in the business of hosting, sponsoring and producing live musical and variety shows, which are recorded and produced for distribution in commerce via television and over the Internet to customers and prospective customers in Illinois, nationally and internationally. Willie Wilson owns the trademarks and intellectual property rights for the SINGSATION brand name.

2. Upon information and belief, Defendant, Millard Public School District, is a public school district in Omaha, Nebraska that operates Millard West High School at 5710 S. 176th Ave, Omaha, Nebraska 68135, which operates a show choir performance under the name "Singsation."

3. This action arises under the Lanham Act, 15 U.S.C. §§ 1114 and 1125(a), the laws of the State of Nebraska, including the Nebraska Trademark Registration Act, Neb. Rev. Stat. § 87-126 *et seq*., the Nebraska Uniform Deceptive Trade Practices Act, Neb. Rev. Stat. § 87-301 *et seq.*, the Nebraska Consumer Protection Act, Neb. Rev. Stat. § 59-1601 *et seq.*, and Nebraska common law. Willie Wilson seeks injunctive relief and actual damages, including Defendant's profits and Willie Wilson's costs and attorneys' fees under 15 U.S.C. § 1117, Neb. Rev. Stat. § 87-303 and Neb. Rev. Stat. § 59-1608.

4. This Court has jurisdiction over the matters raised herein pursuant to 28 U.S.C. § 1331, 28 U.S.C. §§ 1338(a) and (b) and 28 U.S.C. § 1367(a).

5. Venue in this matter is proper in this District because Defendant regularly does business in this District and pursuant to 28 U.S.C. §§ 1391(b) and (c).

ALLEGATIONS COMMON TO ALL COUNTS

6. Willie Wilson owns and claims common-law rights under the mark SINGSATION, for use in connection with its entertainment services, including in its continuing musical and variety show distributed over television and the Internet (the "SINGSATION Mark").

7. Willie Wilson owns U.S. Federal Service Mark Registration No. 1,666,148 (the "Registered Mark"), which was registered on the Principal Register in the U.S. Patent and Trademark Office on November 26, 1991. This registration is for the mark and design SINGSATION, an image of which is reproduced below, for use in connection with Willie Wilson's provision of entertainment services, namely, a continuing musical and variety show distributed over television. A copy of the registration certificate of the Registered Mark is attached hereto as Exhibit 1.



An Image of the Registered Mark

8. The Registered Mark has become incontestable pursuant to 15 U.S.C. § 1065.

9. The SINGSATION Mark and the Registered Mark have been continuously used in commerce in connection with entertainment services since at least June 4, 1989.

10. Willie Wilson uses the SINGSATION Mark and the Registered Mark to provide entertainment services under the marks in Illinois, across the United States and internationally.

11. Since 1989, Willie Wilson has been engaged in the televised broadcast of a continuing musical and variety show.

12. The SINGSATION brand name, including the SINGSATION Mark and the Registered Mark, is well known and famous in the Chicagoland area, in Illinois, throughout the United States and internationally.

13. The SINGSATION Mark and the Registered Mark identify the source of the goods and services of Willie Wilson in the minds of consumers in the marketplace.

14. Defendant is using the expressions "Singsation" and/or the mark and design SINGSATION which is reproduced below (collectively, the "Infringing Marks") in connection with providing entertainment services in the form of vocal and musical performances and recordings thereof, including an annual show choir performance and competition, which compete directly with the business of Willie Wilson.



An Image of the Defendant's Mark and Design SINGSATION

15. Defendant's use of the Infringing Marks is likely to cause confusion in the marketplace, in that the goods and services promoted by Defendant under the Infringing Marks are identical and/or highly related to the goods and services provided by Willie Wilson under the SINGSATION Mark and the Registered Mark.

16. Defendant is using the Infringing Marks in a manner to exploit and misappropriate the goodwill and reputation of Willie Wilson that is based on Willie Wilson's use of the SINGSATION Mark and the Registered Mark.

17. On November 3, 2014, counsel for Willie Wilson advised Defendant via written letter that Willie Wilson owns the SINGSATION Mark and the Registered Mark and that Defendant's usage of the Infringing Marks was causing confusion in the marketplace which was harming Willie Wilson. Willie Wilson requested written assurances from Defendant that Defendant would cease using the SINGSATION Mark and the Registered Mark and remove all such use from its advertising materials and website. A copy of said letter is attached hereto as Exhibit 2.

18. In a letter dated November 14, 2014, counsel for Defendant agreed to cease use of stylized designs "that would even slightly resemble" the Registered Mark. However, Defendant refused to cease use of the SINGSATION Mark or other similar marks. A copy of said letter is attached hereto as Exhibit 3. Defendant did not respond to counsel for Willie Wilson's subsequent requests that Defendant cease use of the SINGSATION Mark (copies of which are attached as Exhibit 4), and to date has not provided the written assurances requested by Willie Wilson.

19. As of December 1, 2015, Defendant continued to use the Infringing Marks shown above.

20. Counsel for Willie Wilson provided notice to Defendant that Willie Wilson would be seeking legal remedies under Federal and state law.

COUNT I:
Trademark Infringement Pursuant to
§ 32 of the Lanham Act (15 U.S.C. § 1114)

21. Willie Wilson restates and realleges Paragraphs 1-20 as if fully set forth herein.

22. The Registered Mark is inherently distinctive and/or has acquired secondary meaning in the stream of commerce.

23. The Registered Mark was first used on June 4, 1989 and predates any use of the Infringing Marks by Defendant.

24. Defendant's use of the Infringing Marks in connection with entertainment services identical or highly related to those sold by Willie Wilson under the Registered Mark constitutes infringement of Willie Wilson's rights in the Registered Mark and is likely to create confusion, or to cause mistake, or to deceive, in violation of 15 U.S.C. § 1114.

25. Defendant has used the Infringing Marks with knowledge that such imitation is intended to cause confusion, or to cause mistake, or to deceive.

26. Defendant's unlawful activities, Willie Wilson has been and is likely to be damaged, and, unless Defendant's activities are restrained, Willie Wilson will continue to suffer serious and irreparable injury, without a full and adequate remedy at law.

COUNT II:
Federal Unfair Competition pursuant to
§ 43(a) of the Lanham Act (15 U.S.C. § 1125(a))

27. Willie Wilson restates and realleges Paragraphs 1-26 as if fully set forth herein.

28. The SINGSATION Mark and the Registered Mark, as used by Willie Wilson to identify the products and services it offers, are inherently distinctive and/or have acquired secondary meaning.

29. Defendant's use of the Infringing Marks in connection with entertainment services identical or highly related to those sold by Willie Wilson under the SINGSATION Mark and/or the Registered Mark constitutes infringement of Willie Wilson's rights in the SINGSATION Mark and/or the Registered Mark and is likely to create confusion, or to cause mistake, or to deceive as to the origin, sponsorship or approval of Defendant's goods and services by Willie Wilson, in violation of 15 U.S.C. § 1125.

30. Defendant deliberately and knowingly adopted, used and continues to use the Infringing Marks in bad faith, with the intent to trade upon the goodwill established by Willie Wilson, to create confusion in the public mind and to misappropriate Willie Wilson's rights in the goodwill it has established in the SINGSATION Mark and/or the Registered Mark, all to the irreparable injury of Willie Wilson.

31. By reason of Defendant's unlawful activities, Willie Wilson has been and is likely to be damaged, and, unless Defendant's activities are restrained, Willie Wilson will continue to suffer serious and irreparable injury, without a full and adequate remedy at law.

COUNT III:
Uniform Deceptive Trade Practices Act
Neb. Rev. Stat. § 87-301 *et seq.*

32. Willie Wilson restates and realleges Paragraphs 1-31 as if fully set forth herein.

33. Section 87-302 of the Nebraska Uniform Deceptive Trade Practices Act (the "UDTPA") provides, in relevant part, that a person engages in deceptive trade practices when, in the course of his or her business, vocation or occupation, the person:

> (1) passes off goods or services of those of another;
>
> (2) causes likelihood of confusion or of misunderstanding as to the source, sponsorship, approval or certification of goods or services;
>
> (3) causes likelihood of confusion or of misunderstanding as to the affiliation, connection or association with or certification by another;
>
> . . .
>
> (12) engages in any other conduct which similarly creates a likelihood of confusion or of misunderstanding.

Neb. Rev. Stat. § 87-302.

34. Defendant's use of the Infringing Marks in connection with entertainment services identical or highly similar to those sold by Willie Wilson under the SINGSATION Mark

and the Registered Mark without Willie Wilson's consent, is an attempt to pass off Defendant's goods and services as those of Willie Wilson; causes a likelihood of confusion or of misunderstanding as to the source, sponsorship, approval or certification of Defendant's goods and services; causes a likelihood of confusion or of misunderstanding as to affiliation, connection or association between Defendant and Willie Wilson; and creates a likelihood of confusion or of misunderstanding among consumers generally as between the goods and services of Defendant and those of Willie Wilson, all in violation of Section 2 of the UDTPA.

35. Defendant has willfully engaged in deceptive trade practices prohibited by Section 2 of the UDTPA in that Defendant adopted, used and continues to use the Infringing Marks with the intent to trade upon the goodwill established by Willie Wilson under the SINGSATION Mark and the Registered Mark, to create confusion in the public mind and to misappropriate Willie Wilson's rights in the goodwill it has established, all to the irreparable injury of Willie Wilson.

36. By reason of Defendant's unlawful activities, Willie Wilson has been and is likely to be damaged, and unless Defendant's activities are restrained, Willie Wilson will continue to suffer serious and irreparable injury, without a full and adequate remedy at law.

COUNT IV:
Consumer Protection Act
Neb. Rev. Stat. § 59-1601 *et seq.*

37. Willie Wilson restates and realleges Paragraphs 1-36 as if fully set forth herein.

38. Section 59-1602 of the Nebraska Consumer Protection Act provides that:

> Unfair methods of competition and unfair or deceptive acts or practices in the conduct of any trade or commerce shall be unlawful.

Neb. Rev. Stat. § 59-1602.

39. Defendant's unlawful conduct is causing harm to Willie Wilson and/or is likely to continue to cause harm for which there is no adequate remedy at law.

40. Defendant's violation of the UDTPA, as set forth in Paragraphs 31 to 35 herein, by its use and employment of deceptive trade practices, constitutes a violation of the Nebraska Consumer Protection Act.

COUNT V:
Common-Law Unfair Competition

41. Willie Wilson restates and realleges Paragraphs 1-40 as if fully set forth herein.

42. Defendant's use of the Infringing Marks on goods and services used in connection with goods identical or closely related to the goods and services provided by Willie Wilson under the SINGSATION Mark, and in connection with entertainment services identical or closely related to the entertainment services offered by Willie Wilson under the SINGSATION Mark, without Willie Wilson's consent, is an attempt to pass off Defendant's goods and services as those of Willie Wilson; causes a likelihood of confusion or of misunderstanding as to the source, sponsorship, approval or certification of Defendant's goods and services; causes a likelihood of confusion or of misunderstanding as to affiliation, connection or association between Defendant and Willie Wilson; and creates a likelihood of confusion or of misunderstanding among consumers generally as between the goods and services of Defendant and those of Willie Wilson, and constitutes unfair competition under the laws of the State of Nebraska.

43. Defendant has intentionally and willfully engaged in unfair competition in that Defendant adopted, used and continues to use the Infringing Marks with the intent to trade upon the goodwill established by Willie Wilson under the SINGSATION Mark, to create confusion in

the public mind and to misappropriate Willie Wilson's rights and the goodwill it has established, all to the irreparable injury of Willie Wilson.

44. The acts of Defendant complained of herein constitute inequitable pirating of the fruits of Willie Wilson's labor and are acts of unfair competition in violation of Nebraska common law. Defendant's acts of unfair competition were done and continue to be done knowingly, intentionally and willfully.

45. Defendant will continue to engage in unfair competition with Willie Wilson unless enjoined by this Court.

46. Willie Wilson has no adequate remedy at law.

47. Willie Wilson designates Omaha, Nebraska as the place of trial for this matter.

PRAYER

WHEREFORE, Willie Wilson prays that this Court:

(a) Preliminarily and permanently enjoin Defendant, its representatives, officers, agents, servants, employees and attorneys, and any and all persons in active concert with Defendant, from using the Infringing Marks, the SINGSATION Mark and/or the Registered Mark or any variations thereof or any trade name, trademark or service mark confusingly or deceptively similar to SINGSATION Mark and/or the Registered Mark in connection with the promotion, advertising, solicitation, conduct and expansion of Defendant's entertainment services in the form of vocal and musical performances in the State of Nebraska and nationally, or otherwise competing unfairly with Willie Wilson;

(b) Order Defendant to deliver to Willie Wilson for destruction all advertisements, brochures, promotional materials, signs, stationery, business cards, other written material or videotapes, compact discs, magnetic tapes, clothing, personal accessories, or any other product

that depicts or otherwise discloses the Infringing Marks or any name or mark confusingly similar thereto;

(c) Order Defendant, its representatives, officers, agents, servants, employees and attorneys, and any and all persons in active concert with Defendant, to fully compensate Willie Wilson for the preparation and distribution of corrective advertising;

(d) Order an accounting of all of Defendant's revenues derived from infringing activity, and grant an award of exemplary damages, attorneys' fees and costs to Willie Wilson; and

(e) Award Willie Wilson such other and further relief as this Court deems just and proper under the circumstances.

Respectfully submitted,

WILLIE WILSON PRODUCTIONS, INC.

By: s/Heidi A. Guttau-Fox

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