

UNITED STATES DISTRICT COURT
FOR THE SOUTHERN DISTRICT OF NEW YORK

09 CV 4947

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JOHN OSBOURNE p/k/a OZZY OSBOURNE, :
Plaintiff, :
- against - :
ANTHONY IOMMI, :
Defendant. :
-----X

Case No. _____

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COMPLAINT FOR DECLARATORY JUDGMENT

John Osbourne p/k/a Ozzy Osbourne (hereinafter referred to as “Plaintiff” or “Ozzy”), by its attorneys Kenyon & Kenyon LLP, as and for its Complaint against defendant Anthony Iommi (hereinafter referred to as “Defendant” or “Iommi”), alleges as follows, upon knowledge with respect to himself and his own acts, and upon information and belief as to all other matters:

NATURE OF THE ACTION

1. This is a dispute concerning ownership of one of the most famous and valuable names in the history of rock and roll, namely BLACK SABBATH. Ozzy for many years has been and is the lead singer and most recognizable member of the rock band Black Sabbath, one of the most financially and critically successful bands of all time. With Ozzy as the lead vocalist, Black Sabbath attained a reputation as the band that defined the “heavy metal” genre, selling over 100 million albums worldwide. In 2006, Black Sabbath was inducted to the Rock and Roll Hall of Fame. To fans of heavy metal music, Ozzy has become synonymous with Black Sabbath.

2. Defendant Iommi, a member of Black Sabbath, however, purports to own exclusive rights to the mark BLACK SABBATH under a federal trademark registration, U.S. Reg. No. 2,399,391. Without Ozzy's knowledge or consent, Iommi applied to register the BLACK SABBATH mark with the U.S. Patent and Trademark Office ("USPTO"), falsely listing himself as the sole owner of the BLACK SABBATH mark. Iommi's false and improper assertions to the USPTO and others that he alone owns exclusive rights in and to the BLACK SABBATH mark necessarily derogates Ozzy's proprietary rights in and to the BLACK SABBATH mark.

3. This is an action for declaratory judgment. By this action, Ozzy seeks to eliminate any doubt that he is an equal co-owner of the BLACK SABBATH mark, along with Iommi.

4. Since at least 1997, Ozzy, without any significant input from Iommi, has exercised control over the quality of the goods and services marketed under the BLACK SABBATH mark. Accordingly, Ozzy seeks a declaration from this Court that Iommi and he are the joint owners of the BLACK SABBATH mark and that they jointly own the exclusive rights to use and register this mark in the United States. In addition, Ozzy requests that the Court cancel U.S. Trademark Reg. No. 2,399,391 on the basis that such registration was fraudulently obtained and maintained by Iommi, who falsely declared to the USPTO that he was the sole owner of the BLACK SABBATH mark.

JURISDICTION AND VENUE

5. This action arises under the Declaratory Judgment Act, 28 U.S.C. §§ 2201-02, and the Lanham Act, 15 U.S.C. § 1051 *et seq.* and a related state statute. This Court has subject matter jurisdiction under 28 U.S.C. § 1338 and 15 U.S.C. § 1121. This Court has supplemental jurisdiction over the state law claim under 28 U.S.C. § 1367(a). Additionally, because this action concerns an amount in controversy that exceeds \$75,000, exclusive of costs and interest, and is between a resident of California and a resident of the United Kingdom, subject matter jurisdiction is also proper under 28 U.S.C. § 1332. Venue is proper in this district under 28 U.S.C. § 1391.

PARTIES

6. Plaintiff Ozzy is an individual residing in the State of California.

7. Upon information and belief, Defendant Iommi is an individual residing in the United Kingdom.

BACKGROUND

8. With Ozzy's signature lead vocals, Black Sabbath's revolutionary sound was immensely successful, establishing Ozzy as the "Godfather of Heavy Metal." From 1969 to 1979, with Ozzy as the voice and face of Black Sabbath, the band released its most successful and critically acclaimed albums: "*Black Sabbath*" (1970); "*Paranoid*" (1970); "*Master of Reality*" (1971); "*Black Sabbath, Vol. 4*" (1972); and "*Sabbath Blood Sabbath*" (1973). When Ozzy performed with the band from 1969 to 1979, every album Black Sabbath released went certified platinum (*e.g.*, selling over 1 million copies) or gold (*e.g.*, selling over 500,000 copies) in the United States. The album "*Paranoid*", which has been recognized by *Time*

Magazine as one of the “Top 100 Albums of All Time,” is certified quad-platinum (*e.g.*, selling over 4 million copies) in the United States.

9. During the period (1980-1996) when Ozzy did not perform on BLACK SABBATH albums, there was significantly less revenue derived from the sales of these albums. During this period, BLACK SABBATH albums that had been recorded prior to 1980, on which Ozzy did perform and whose quality he controlled, were extensively sold in the United States and elsewhere.

10. At no time did Ozzy validly sign to Iommi his rights in or to the BLACK SABBATH mark or to Ozzy’s name, image, or likeness.

11. When Ozzy rejoined Black Sabbath in 1997, the band once again recaptured its extraordinary success. Ozzfest, one of the most successful hard rock festivals of all time, which was created and managed by Ozzy’s wife/manager Sharon Osbourne (“Sharon”), provided Black Sabbath with a platform from which to launch its reunion tour. The reunited Black Sabbath group was the headline act for 1997 Ozzfest tour. In 1998, Black Sabbath released a live album entitled “*Reunion*”, featuring Ozzy’s lead vocals. *Reunion* was a smash hit with rock fans, selling over 1 million copies.

12. Since at least as early as 1997, Ozzy, either himself or through persons acting on his behalf, has exercised control with respect to nature and quality of goods and services sold under and in connection with the BLACK SABBATH mark, from concert tours to merchandise, thereby developing invaluable goodwill in the mark. Such sales have generated millions of dollars and rock fans worldwide recognize Ozzy, the “Godfather of Heavy Metal,”

as the driving force behind the BLACK SABBATH band. During this time, Iommi has had no significant control over the quality of the BLACK SABBATH goods or services.

13. As a result of Ozzy's long-standing and continuous exercise of quality control over the BLACK SABBATH mark, Ozzy is, at minimum, a co-owner of the BLACK SABBATH mark, and entitled to an undivided half (50%) interest to the right, title and interest in and to the BLACK SABBATH mark and the goodwill appurtenant thereto and which is symbolized thereby.

JUSTICIABLE CONTROVERSY

14. In or around 2008, it came to Ozzy's attention that, without his knowledge or consent, Iommi had registered the BLACK SABBATH mark with the respective Trademark Offices in the United States, the United Kingdom, and the European Union. Iommi falsely asserted in such applications that he was the sole owner of the BLACK SABBATH mark. In the United States, the USPTO issued Reg. No. 2,399,391 to Iommi for the mark BLACK SABBATH on October 31, 2000.

15. To procure the registration for BLACK SABBATH, without Ozzy's knowledge or consent, Iommi made at least one false statement to the USPTO under penalty of perjury: On March 1, 1999, in his application for trademark registration, Iommi signed a sworn declaration that "to the best of his knowledge and belief no other person, firm, corporation, or association has the right to use [the BLACK SABBATH mark] in commerce . . .". A true and correct copy of Iommi's declaration filed with the USPTO is attached hereto as Exhibit A.

16. After Ozzy learned that Iommi had registered the BLACK SABBATH mark in Iommi's name, representatives of Ozzy contacted Iommi to memorialize their co-ownership of

the mark. On or about April 10, 2008, as Ozzy and Iommi were in the process of negotiating a written agreement memorializing their co-ownership, unbeknownst to Ozzy, Iommi sent a protest letter to Signatures Networks, Inc. (“Signatures”), a third party which had been licensed by Ozzy and Iommi since 1997 to manufacture, distribute, and sell merchandise bearing the BLACK SABBATH mark. In Iommi’s letter to Signatures, he falsely claimed that he was the sole owner of the mark, demanding that Signatures stop using the BLACK SABBATH mark.

17. In recognition of Ozzy’s and Iommi’s joint ownership of the BLACK SABBATH mark, and with Iommi’s full knowledge, for years Signatures has paid royalties on a “50/50” basis to Ozzy and Iommi for Signatures’ sales of products bearing the mark, in accordance with written agreements that Ozzy’s and Iommi’s designees previously negotiated and entered into with Signatures. Iommi has agreed to this sharing of royalties on a “50/50” basis.

18. The parties’ designees were in the process of negotiating a further extension of the long-standing exclusive license agreement with Signatures when Iommi’s April 10, 2008 protest letter, brazenly accusing Signatures of infringing upon Iommi’s exclusive rights in and to the BLACK SABBATH mark, effectively derailed such negotiations.

19. On or about April 21, 2008, Ozzy’s counsel sent Iommi’s counsel a letter objecting to, *inter alia*, Iommi’s claim that he was the sole owner of the BLACK SABBATH mark. In this letter, Ozzy indicated that he would be willing to work with Iommi to continue discussing another renewal of the license with Signatures, once Ozzy and Iommi had finalized their written agreement memorializing joint ownership of the mark. A true and correct copy of this letter is attached hereto as Exhibit B.

20. Instead of finalizing the agreement to formally record the parties' joint ownership, on or about December 16, 2008, without Ozzy's knowledge or consent, Iommi filed a complaint in this District against Signatures and Live Nation, Inc., the parent company of Signatures, alleging, *inter alia*, that Signatures' use of the BLACK SABBATH mark infringed upon Iommi's exclusive rights in and to the mark (the "Unauthorized Action").

21. On January 26, 2009, Ozzy's counsel sent a letter to Iommi's counsel reiterating that Iommi's claim that he alone was the sole owner of the BLACK SABBATH mark was false because Ozzy, and his wife/manager Sharon acting on his behalf, have controlled the nature and quality of BLACK SABBATH goods and services (*i.e.*, concert tours and merchandise) from at least 1997 to date, without any significant input from Iommi. A true and correct copy of the January 26, 2009 letter is attached hereto as Exhibit C.

22. In addition, Iommi and/or his representatives have known for years that Ozzy and Sharon own the official BLACK SABBATH web site, located at www.blacksabbath.com, which offers a variety of BLACK SABBATH merchandise for sale. Iommi has never objected to their ownership of this website or to the website's sale of BLACK SABBATH merchandise. In October 2006, Iommi and former Black Sabbath band mates performed a concert tour together without Ozzy. Iommi named this touring group "Heaven and Hell," not Black Sabbath.

23. Ozzy's numerous efforts to amicably resolve this dispute with Iommi have not succeeded. Iommi continues to insist upon falsely claiming that he alone has exclusive rights in and to the BLACK SABBATH mark. Moreover, Iommi is unilaterally sabotaging the

parties' long-standing relationship with Signatures under the guise that he is the sole owner of the mark.

24. Iommi's actions and false claims of sole ownership have seriously impeded Ozzy's ability to exploit the BLACK SABBATH mark. Upon information and belief, some time after Iommi filed the Unauthorized Action against Signatures, pursuant to Iommi's direction, Signatures ceased all sales of BLACK SABBATH merchandise. As a result, Ozzy has lost and is continuing to lose royalties from such sales that he would have otherwise received from Signatures, but for Iommi's actions and false claims.

25. Upon information and belief, Iommi and Signatures are negotiating a settlement agreement whereby Iommi is to be paid monies based on Signatures' sales of products which prominently feature the BLACK SABBATH mark and Ozzy's likeness. Based on Ozzy's rights in and to the mark and his image and likeness, he is entitled to a portion of those monies.

26. Iommi's continuing false assertion of sole ownership and exclusive rights in and to the BLACK SABBATH mark is adverse to Ozzy's rights in and to the mark as a co-owner.

27. Therefore, there is a definite and concrete controversy between parties having adverse legal interests, wherein the controversy is of sufficient immediacy and reality to warrant the issuance of a declaratory judgment under 28 U.S.C. § 2201.

COUNT I
DECLARATORY JUDGMENT OF
JOINT OWNERSHIP OF THE BLACK SABBATH MARK

28. Ozzy incorporates by reference all the allegations of paragraphs 1 through 27 of this Complaint as though fully set forth herein.

29. An actual controversy has arisen and exists between Ozzy and Iommi within the meaning of 28 U.S.C. § 2201.

30. Ozzy contends that by virtue of, *inter alia*, the quality control he has exercised over the BLACK SABBATH mark with respect to the exploitation of goods and services under and in connection with the mark since at least 1997, he is at least a co-owner of the mark.

31. Iommi contends that Ozzy has no ownership interest in the BLACK SABBATH mark and that he is the sole owner.

32. Ozzy seeks a declaration that he is a co-owner of the BLACK SABBATH mark, and entitled to an undivided half (50%) interest to the right, title and interest in and to the mark and the goodwill appurtenant thereto and which is symbolized thereby.

COUNT II
CANCELLATION OF TRADEMARK REGISTRATION (15 U.S.C. § 1119)

33. Ozzy incorporates by reference all the allegations of paragraphs 1 through 32 of this Complaint as though fully set forth herein.

34. Iommi made at least one material, false representation to the USPTO, namely that he is the sole owner of the BLACK SABBATH mark. On or about March 1, 1999, Iommi claimed in an application for trademark registration for the BLACK SABBATH mark that to the best of his knowledge no other person has the right to use the BLACK SABBATH mark in commerce.

35. Iommi knew or should have known at the time he made this statement, and throughout the time the application was pending (and thereafter), that it was false because

Iommi knew or should have know that Ozzy substantially controlled the quality of the BLACK SABBATH goods and services. By virtue of such control Ozzy was at least a co-owner of the mark.

36. In reliance upon Iommi's false representation to the USPTO, the USPTO issued U.S. Trademark Reg. 2,399,391 for BLACK SABBATH to Iommi.

37. Ozzy requests that the Court cancel the fraudulently procured and maintained U.S. Trademark Reg. 2,399,391 for BLACK SABBATH pursuant to 15 U.S.C. § 1119.

**COUNT III
DECLARATORY JUDGMENT
OF MONIES OWNED TO OZZY**

38. Ozzy incorporates by reference all the allegations of paragraphs 1 through 37 of this Complaint as though fully set forth herein.

39. As a co-owner of the BLACK SABBATH mark, Ozzy is entitled to an accounting of the proceeds Iommi has received or will receive from Signatures pursuant to the settlement agreement referred to above.

40. Based on Ozzy's rights in and to the BLACK SABBATH mark, he is entitled to a portion of those monies.

**COUNT IV
MISAPPROPRIATION OF OZZY'S RIGHT OF
PUBLICITY (Cal. Civ. Code § 3344 et seq.)**

41. Ozzy incorporates by reference all the allegations of paragraphs 1 through 40 of this Complaint as though fully set forth herein.

42. Upon information and belief, Iommi has received or will imminently receive monies based on Signatures' sales of products which prominently feature Ozzy's image and likeness.

43. Ozzy never consented to Iommi's commercial exploitation Ozzy's image and likeness.

44. Iommi's actions were in conscious disregard of Ozzy's rights to his image and likeness.

45. Based on Ozzy's rights to his image and likeness, he, not Iommi, is entitled to all monies based on Signatures' sales of products which prominently feature Ozzy's image and likeness.

PRAYER FOR RELIEF

THEREFORE, Ozzy prays for judgment against Iommi as follows:

A. Declaring that Ozzy is a co-owner of the BLACK SABBATH mark, and entitled to an undivided half (50%) interest to the right, title and interest in and to the mark and the goodwill appurtenant thereto and which is symbolized thereby;

B. An award of the damages that Ozzy has suffered by reason of acts of Iommi complained of herein.


C. An award of a portion of the profits that Iommi has made or will make from the BLACK SABBATH mark and/or Ozzy's image or likeness;

D. Entry of an order pursuant to 15 U.S.C. § 1119 directing the USPTO to cancel U.S. Reg. No. 2,399,391;

E. An award of the costs, expenses, and attorneys' fees incurred by Ozzy herein pursuant to 15 U.S.C. § 1117; and

F. Granting such other and further relief as the Court deems proper and just.

Dated: May 26, 2009


Howard J. Shire (MS 8892)
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Attorneys for Plaintiff
John Osbourne p/k/a Ozzy Osbourne

NY01 1753527 v1

EXHIBIT A

**COMBINED DECLARATION OF USE AND INCONTESTABILITY
Under Sections 8 and 15
IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Mark: BLACK SABBATH

Reg. No.: 2,399,391

Dated: October 31, 2000

Class No(s): IC 9, 25 & 41

Registrant: Anthony Frank Iommi (United Kingdom citizen)

The undersigned being hereby warned that willful false statements and the like so made are punishable by fine or imprisonment, or both, under 18 U.S.C. Section 1001, and that such willful false statements may jeopardize the validity of the declaration or the registration referred herein, declares:

That he is the registrant, a United Kingdom citizen, with a business address at Whin Hill Farm, Askwith, N. Yorks LS21 2JJ, England

; that he is authorized to execute this declaration on behalf of the registrant, that the registrant owns the above-identified registration, as shown by records in the U.S. Patent and Trademark Office; that the mark shown therein has been in continuous use in interstate commerce for five consecutive years from the date of the registration to the present, as evidenced as by the attached specimen showing the mark as currently used for the following goods or services recited in the registration:

that said mark is still in use in such commerce; that there has been no final decision adverse the registrant's claim of ownership of said for such goods or services or to its right to register the same or maintain it on the register, and that there is no proceeding involving any of said rights pending and not disposed of either in the U.S. Patent and Trademark Office or in the Courts; that all statements made herein of his/her own knowledge are true and that all statements made on information and belief are believed to be true.



02-14-2006

U S Patent & TMO/c/TM Mail RcptDt #72

EXHIBIT B



Howard J. Shire
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New York, NY 10004-1050
212.425.7200
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April 21, 2008

**VIA FEDERAL EXPRESS and
FACSIMILE: 212 557 0565**

Jeffrey A. Greenberg, Esq.
Beldock Levine & Hoffman LLP
99 Park Avenue
New York, NY 10016-1503

**Re: BLACK SABBATH Trademark
Our Ref.: 14448/1**

Dear Mr. Greenberg:

We are writing on behalf of our client John Osbourne p/k/a Ozzy Osbourne ("Ozzy"). It recently came to Ozzy's attention that on behalf of your client, Anthony Iommi ("Iommi"), you sent a cease and desist letter to Signatures Network, Inc. ("Signatures") objecting to Signatures' use of the BLACK SABBATH mark (the "Mark").

As you might imagine, our client was very upset to learn of your letter, since he and Iommi were in the process of memorializing their co-ownership of the Mark. Ozzy was particularly upset with your false claim in the April 10, 2008 letter to Signatures that Iommi is the sole owner of the Mark.

As you are aware, for years Ozzy, along with Iommi, has controlled the nature and quality of services and products sold in connection with the Mark. In recognition of their joint ownership, Iommi's and Ozzy's designees previously negotiated and entered into a renewal agreement with Signatures extending the term of the long-standing exclusive license agreement for the Mark and, most recently, have been negotiating a further proposed renewal of that license agreement. Your letter to Signatures, with its false assertion of Iommi's sole ownership, has obviously derailed those negotiations, at least for now.

Ozzy would be willing to work with Iommi to continue discussing another renewal of the license with Signatures, once Iommi and Ozzy have finalized their written agreement memorializing joint ownership of the Mark.

However, if Iommi persists in claiming that he is sole owner of the Mark, Ozzy will have no choice but to take appropriate action to protect his legal rights.

Jeffrey A. Greenberg, Esq.
April 21, 2008
Page 2

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Please contact the undersigned if you would like to discuss this matter.

Sincerely yours,

A handwritten signature in cursive script that reads "Howard J. Shirz".

Howard J. Shirz

cc: Ms. Sharon Osbourne
Ernest Chapman, Esq.

EXHIBIT C

Andrew DeVore, Esq.
January 26, 2009
Page 2



resumed the lead role in 1997. All of the above facts help demonstrate how integral Ozzy has been to the quality of services rendered under the Mark.

In addition, as Iommi and/or his representatives have known for years, Ozzy and Sharon are owners of the domain name www.blacksabbath.com, and Signatures has paid royalties on a "50-50" basis to Ozzy and Iommi based on Signatures' sales of products bearing the Mark

In sum, your description in the complaint of the agreement Ozzy signed back in 1980, even if accurate, does not preclude Ozzy's ownership interest in the Mark based on subsequent events, such as, for example, his and Sharon's controlling the nature and quality of services rendered under the mark from at least 1997 to date. Likewise, as you probably realize, Iommi's ownership of a U.S. trademark registration (which Ozzy was unaware of until recently) in no way precludes Ozzy from establishing that he is at least a joint owner of the Mark.

Accordingly, Ozzy strongly disputes Iommi's claim in the December 16, 2008 complaint against Signatures and Live Nation that Iommi is the sole owner of the Mark.

As you might be aware, there have been ongoing discussions between representatives of Ozzy and Iommi to try to amicably resolve their dispute concerning ownership of the Mark. We hope that these negotiations will be fruitful so that our respective clients will not have to resort to litigation to resolve this matter. However, our clients will not hesitate to commence proceedings if your unfounded allegations made to third parties, including but not limited to Signatures, are not withdrawn within 30 days.

Sincerely,

Howard J. Shire