

ESTTA Tracking number: **ESTTA471940**

Filing date: **05/11/2012**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Notice of Opposition

Notice is hereby given that the following party opposes registration of the indicated application.

Opposer Information

Name	Sugarland Properties Incorporated		
Entity	Corporation	Citizenship	Texas
Address	15958 City Walk, Suite 250 Sugar Land, TX 77479 UNITED STATES		

Attorney information	Tim Headley Law Offices of Tim Headley 7941 Katy Fwy., Suite 506 Houston, TX 77024-1924 UNITED STATES tim@headleyiplaw.com Phone:7134678500
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Applicant Information

Application No	85478417	Publication date	05/01/2012
Opposition Filing Date	05/11/2012	Opposition Period Ends	05/31/2012
Applicant	Edmund D Samora LLC PO BOX 1475 Rosenberg, TX 77471 UNITED STATES		

Goods/Services Affected by Opposition

Class 039. First Use: 2010/08/24 First Use In Commerce: 2010/08/24 All goods and services in the class are opposed, namely: Providing taxi transport for people not capable of driving safely due to alcohol consumption or for people visiting with no transportation; Taxi transport; Taxi transport for people in wheelchairs

Grounds for Opposition

False suggestion of a connection	Trademark Act section 2(a)
Priority and likelihood of confusion	Trademark Act section 2(d)
Dilution	Trademark Act section 43(c)
Other	Opposer has common-law rights in FIRST COLONY in connection with a wide variety of goods and services that predate applicant's first use.

Marks Cited by Opposer as Basis for Opposition

U.S. Registration No.	3323420	Application Date	02/15/2007
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Registration Date	10/30/2007	Foreign Priority Date	NONE
Word Mark	FIRST COLONY		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 016. First use: First Use: 1990/01/01 First Use In Commerce: 1990/01/01 Newsletters in the field of community deed restriction compliance issues, and community sporting and cultural events Class 041. First use: First Use: 1990/01/01 First Use In Commerce: 1990/01/01 Organizing community sporting and cultural events		

U.S. Application/Registration No.	NONE	Application Date	NONE
Registration Date	NONE		
Word Mark	FIRST COLONY		
Goods/Services	a. the sale, leasing and development of real estate; b. newsletters related to community deed restriction compliance and community events; c. organizing community events; d. building construction; e. real estate brokerage and management services; f. planning and developing master-planned communities; g. library services; h. community association services; i. podiatrist services; j. child care and educational services; k. flying club services; l. health care services; m. news reporting services; n. sports association services; and o. religious services.		

Related Proceedings	Sugarland Properties, Inc. v. Edmund D. Samora and Edmund D. Samora, LLC, Civil Action No. 4:11-cv-4439, in the United States District Court For The Southern District Of Texas, Houston Division
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Attachments	77108605#TMSN.jpeg (1 page)(bytes) 2012 05 11 Opposition to FIRST COLONY TAXI.pdf (7 pages)(28885 bytes) 2012 05 11 Opposition Exhibit 1.pdf (1 page)(49294 bytes) Exhibit 1 - 2012 05 10 First Colony Status & Assignment.pdf (3 pages)(44142 bytes) 2012 05 11 Opposition Exhibit 2.pdf (3 pages)(105004 bytes) 2012 05 11 Opposition Exhibit 3.pdf (1 page)(59097 bytes) Exhibit 3 - 2012 04 05 13 1st Amended Complaint.pdf (11 pages)(53851 bytes)
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Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address

record by First Class Mail on this date.

Signature	/Tim Headley/
Name	Tim Headley
Date	05/11/2012

**In The United States Patent And Trademark Office
Before The Trademark Trial And Appeal Board**

Sugarland Properties Incorporated	§	Application Serial No. 85/478,417
	§	
Opposer,	§	
v.	§	
	§	Opposition No. _____
Casual Dining, Inc.	§	
	§	
Applicant	§	Mark: FIRST COLONY TAXI

Notice Of Opposition

1. Opposer (“SPI”) is a Texas corporation, with its principal place of business located at 15958 City Walk, Suite 250, Sugar Land, TX 77479.
2. SPI believes that it will be damaged by the registration of FIRST COLONY TAXI as shown in application serial number 85/478,417, international class 039, for the services of “providing taxi transport for people not capable of driving safely due to alcohol consumption or for people visiting with no transportation; taxi transport; taxi transport for people in wheelchairs”.
3. Applicant Edmund D. Samora LLC filed the application for FIRST COLONY TAXI on November 21, 2011.
4. SPI opposes the registration pursuant to 15 U.S.C. §1063, and respectfully provides the following grounds for its opposition.

5. In 1973, SPI established a real estate development (the “Development”) in Fort Bend County, near the city of Sugar Land, Texas. SPI created its FIRST COLONY mark for use in connection with the Development.
6. SPI operates its business in Fort Bend County, and in the city of Sugar Land, Texas. SPI offers for sale to the public its goods and services in Fort Bend County, in the city of Sugar Land, Texas, and in and around the Development.
7. SPI, by itself and through its licensees, has offered for sale, in and around the Development, to the public various products and services in connection with its FIRST COLONY mark, since at least as early as 1975. The products and services still offered by SPI and its licensees, in connection with SPI’s FIRST COLONY mark, in and around the Development, include:
 - a. the sale, leasing and development of real estate;
 - b. newsletters related to community deed restriction compliance and community events;
 - c. organizing community events;
 - d. building construction;
 - e. real estate brokerage and management services;
 - f. planning and developing master-planned communities;
 - g. library services;
 - h. community association services;
 - i. podiatrist services;

- j. child care and educational services;
 - k. flying club services;
 - l. health care services;
 - m. news reporting services;
 - n. sports association services; and
 - o. religious services.
8. Thus SPI, either directly or through its licensees, has used SPI's FIRST COLONY mark in commerce, in and around the Development, as an indicia of origin for a wide variety of products and services, on an exclusive basis, long prior to Applicant's filing date of November 21, 2011. Also, SPI continues to look for opportunities to expand the use of its famous FIRST COLONY mark through licensees that offer quality products and services.
9. SPI owns Federal Trademark Registration Number 3,323,420, for FIRST COLONY, for use in connection with (1) "Newsletters in the field of community deed restriction compliance issues, and community sporting and cultural events", in international class 016, and (2) "Organizing community sporting and cultural events", in international class 041. The date of first use in commerce for these services is January 1, 1990.
10. Printouts of the U.S. Trademark Office electronic records of the status and title of Registration Number 3,323,420 are attached as **Exhibit 1**.

11. SPI's registered FIRST COLONY mark is valid and subsisting, and constitutes prima facie evidence of SPI's exclusive right to use its FIRST COLONY mark in commerce on the goods and services specified in its registration.
12. As a result of the extensive sales and promotion of its goods and services, in and around the Development, bearing or offered in connection with SPI's FIRST COLONY mark, SPI has built up highly valuable goodwill in SPI's FIRST COLONY mark, and such goodwill has become closely and uniquely identified and associated with SPI.
13. SPI's FIRST COLONY mark is distinctive, well-known, and famous with respect to the goods and services bearing or offered in connection with SPI's FIRST COLONY mark, and became distinctive, well-known, and famous with respect to such goods and services prior to Applicant's filing date of November 21, 2011.
14. SPI actively uses the FIRST COLONY mark in the course of its business, and in connection with the goods and services of its licensees.
15. The services covered by the application for the alleged mark FIRST COLONY TAXI are currently being encountered by the same class of purchasers as those who are interested in or familiar with the goods and services promoted, offered and provided by SPI under its mark FIRST COLONY.
16. Applicant's alleged FIRST COLONY TAXI mark, when considered in its entirety, is similar in appearance, meaning, and commercial impression to SPI's FIRST COLONY mark. Further, the goods and services covered by the application are

closely related to those goods and services covered by one or more of SPI's registered and common law FIRST COLONY marks.

17. Upon information and belief, SPI's rights in its FIRST COLONY marks precede any use by Applicant of its alleged FIRST COLONY TAXI mark in United States commerce.
18. The alleged FIRST COLONY TAXI mark so resembles one or more of SPI's registered and common law FIRST COLONY marks, as to be likely, when applied to Applicant's services, to cause confusion, or to cause mistake, or to deceive the trade and public, who are likely to believe that Applicant's goods and services have their origin with SPI and/or that such services are approved, endorsed, or sponsored by SPI, or associated in some way with SPI. Applicant has been parking his two taxis in front of the Marriott Hotel in the town square (see **Exhibit 2**), which is the heart of the Development, flaunting his unlicensed, infringing use of SPI's FIRST COLONY mark in front of all the shop owners in the town square who are properly using their own trademarks.
19. The alleged FIRST COLONY TAXI mark is also likely to be dilutive of the distinctive character of SPI's FIRST COLONY marks. SPI would thereby be injured by the granting to Applicant of a certificate of registration for Applicant's alleged FIRST COLONY TAXI mark.
20. On at least two occasions, SPI advised Applicant that his use of the phrase "FIRST COLONY TAXI" infringes SPI's FIRST COLONY mark.

21. On November 21, 2011, **the same day** that Applicant filed his application, he acknowledged in an email to SPI's lawyer that he had received SPI's letter regarding his infringing use of "FIRST COLONY TAXI":

From: Edmund [mailto:edmund@firstcolonytaxi.com]
Sent: Monday, November 21, 2011 3:15 PM
To: Carl Favre
Subject: First Colony trademark

Carl,

I recieved your letter today. Could you provide us with the registered mark that your client feels is being infringed on by my company.

Edmund D Samora
Owner/Operator
ROSE RICH TAXI
FIRST COLONY TAXI
832-222-2222

Sent from my Verizon Wireless iPhone.

22. In view of Applicant's knowledge of SPI's extensive use of its FIRST COLONY mark for a wide variety of goods and services, and in view of his having received a letter from SPI's lawyer on November 21, 2011, asking him to stop using the mark FIRST COLONY, the truthfulness of his declaration that he made in his application on November 21, 2011, is somewhat questionable:

"to the best of his/her knowledge and belief no other person, firm, corporation, or association has the right to use the mark in commerce, either in the identical form thereof or in such near resemblance thereto as to be likely, when used on or in connection with the goods/services of such other person, to cause confusion, or to cause mistake, or to deceive".

23. Because Applicant refused to comply with SPI's request to stop using the phrase "FIRST COLONY TAXI", on December 16, 2011, SPI sued Applicant in federal

court in the Southern District of Texas. A copy of the amended complaint is attached as **Exhibit 3**. That suit is still pending.

SPI respectfully requests (a) that this opposition be sustained, and (b) that application Serial No. 85/478,417 not be permitted to proceed to registration.

Respectfully submitted,



Tim Headley
Attorney For Opposer
State Bar No. 09325210
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7941 Katy Fwy., Suite 506
Houston Texas 77024-1924
Phone: 713-467-8500
Fax: 713-467-8501
Email: tim@headleyiplaw.com

Certificate of Service

I certify that a true and complete copy of this Notice of Opposition has been served by first class mail on May 11, 2012, on Applicant, pursuant to 37 CFR §2.119(b)(4), to:

Edmund D. Samora
PO BOX 1475
Rosenberg TEXAS 77471



Tim Headley

**In The United States Patent And Trademark Office
Before The Trademark Trial And Appeal Board**

Sugarland Properties Incorporated	§	Application Serial No. 85/478,417
	§	
Opposer,	§	
v.	§	
	§	Opposition No. _____
Casual Dining, Inc.	§	
	§	
Applicant	§	Mark: FIRST COLONY TAXI

Notice Of Opposition

Exhibit 1

Printouts of the U.S. Trademark Office electronic records
showing the status and title of Registration Number 3,323,420

Thank you for your request. Here are the latest results from the [TARR web server](#).

This page was generated by the TARR system on 2012-05-10 16:07:07 ET

Serial Number: 77108605 [Assignment Information](#) [Trademark Document Retrieval](#)

Registration Number: 3323420

Mark

FIRST COLONY

(words only): [FIRST COLONY](#)

Standard Character claim: [Yes](#)

Current Status: [Registered](#). The registration date is used to determine when post-registration maintenance documents are due.

Date of Status: [2007-10-30](#)

Filing Date: [2007-02-15](#)

Filed as TEAS Plus Application: [Yes](#)

Currently TEAS Plus Application: [Yes](#)

Transformed into a National Application: [No](#)

Registration Date: [2007-10-30](#)

Register: [Principal](#)

Law Office Assigned: [LAW OFFICE 109](#)

If you are the applicant or applicant's attorney and have questions about this file, please contact the Trademark Assistance Center at TrademarkAssistanceCenter@uspto.gov

Current Location: [650 -Publication And Issue Section](#)

Date In Location: [2007-10-30](#)

LAST APPLICANT(S)/OWNER(S) OF RECORD

1. SUGARLAND PROPERTIES INCORPORATED

Address:

SUGARLAND PROPERTIES INCORPORATED

Suite 250 15958 City Walk

Sugar Land, TX 77479

United States

Legal Entity Type: Corporation**State or Country of Incorporation:** Texas

GOODS AND/OR SERVICES

International Class: 016**Class Status:** Active

Newsletters in the field of community deed restriction compliance issues, and community sporting and cultural events

Basis: 1(a)**First Use Date:** 1990-01-01**First Use in Commerce Date:** 1990-01-01**International Class:** 041**Class Status:** Active

Organizing community sporting and cultural events

Basis: 1(a)**First Use Date:** 1990-01-01**First Use in Commerce Date:** 1990-01-01

ADDITIONAL INFORMATION

Prior Registration Number(s):

1059541

2101467

2103300

MADRID PROTOCOL INFORMATION

(NOT AVAILABLE)

PROSECUTION HISTORY

NOTE: To view any document referenced below, click on the link to "Trademark Document Retrieval" shown near the top of this page.

2011-06-02 - TEAS Change Of Correspondence Received

2008-07-08 - TEAS Change Of Correspondence Received

2007-11-13 - TEAS Change Of Correspondence Received

2007-10-30 - Registered - Principal Register

2007-08-14 - Published for opposition

2007-07-25 - Notice of publication

2007-07-09 - Law Office Publication Review Completed

2007-07-09 - Assigned To LIE

2007-06-05 - Approved for Pub - Principal Register (Initial exam)

2007-06-04 - Assigned To Examiner

2007-02-21 - New Application Entered In Tram

ATTORNEY/CORRESPONDENT INFORMATION

Attorney of Record

Tim Headley

Correspondent

Tim Headley

Law Offices of Tim Headley

7941 Katy Freeway

Houston TX 77024

Phone Number: 713-467-8500

Fax Number: 713-467-8501

**In The United States Patent And Trademark Office
Before The Trademark Trial And Appeal Board**

Sugarland Properties Incorporated	§	Application Serial No. 85/478,417
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Opposer,	§	
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	§	Opposition No. _____
Casual Dining, Inc.	§	
	§	
Applicant	§	Mark: FIRST COLONY TAXI

Notice Of Opposition

Exhibit 2

A layout of the town square, which is the heart of the FIRST COLONY Development



Idvkrq) Vkrhv

#	Name & Phone #	#	Name & Phone #
16	Ann Taylor Loft 281.265.2703	18	Anything Bling Boutique 281.240.0752
7	Awakened Yoga 281.980.8703	64	Charming Charlie 281.980.8703
61	Designs In Gems 713.995.7975	27	Em&Lee Boutique 281.494.0391
17	JoAnn's 281.242.0202	14	JoS. A. Bank Menswear 281.980.1601
15	Motherhood Maternity 281.491.0258	25	Wardrobe The Boutique 281.265.0161

Khdwk) Ehdwx|

#	Name & Phone #	#	Name & Phone #
43	An Albert Luiz Salon & Spa 281.565.2213	7	Awakened Yoga 281.491.0221
58	Facelogic 281.242.3442	47	Hypoxi Studio 281.302.5041
45	Relax The Back 281.313.7373		

Krwho) R wkhuv

#	Name	Phone #
	Sugar Land Marriott Town Square	281.275.8400
23	Amegy Bank	713.235.8800

Vshfldw|

#	NamePhone #	#	NamePhone #
21	A Dog's Life! Luxury Dog Boutique 281.340.3647	42	AT&T Mobility 281.565.9292
28	Aventography Photo & Video 832.618.0718	37	Cigar Cigar! 281.240.1362
62	Eye Trends 281.265.2000	3	Fred Astaire Dance Studio 281.265.0644
63	Gem & Bead Gallery (Now Open) 281.265.0993	22	House of Blooms (Kiosk on the Plaza) 281.242.1555
4	Luggage & Leather 281.491.1811	59	Sugar Land Skeeters Baseball 281.240.4487
10	Sweet & Sassy 281.240.2060	8	Twenty-Two Fifty Interiors & Gifts 281.265.2250

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Before The Trademark Trial And Appeal Board**

Sugarland Properties Incorporated	§	Application Serial No. 85/478,417
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Opposer,	§	
v.	§	
	§	Opposition No. _____
Casual Dining, Inc.	§	
	§	
Applicant	§	Mark: FIRST COLONY TAXI

Notice Of Opposition

Exhibit 3

A copy of the amended complaint in the case of
Sugarland Properties, Inc. v. Edmund D. Samora, and Edmund D. Samora, LLC
Civil Action No.: 4:11-cv-4439, Houston Division, Southern District of Texas

**IN THE UNITED STATES DISTRICT COURT
FOR THE SOUTHERN DISTRICT OF TEXAS
HOUSTON DIVISION**

Sugarland Properties, Inc.	§	
	§	
Plaintiff,	§	
v.	§	Civil Action No.: 4:11-cv-4439
	§	
Edmund D. Samora, and	§	
Edmund D. Samora, LLC	§	
	§	
Defendants.	§	

**Plaintiff’s First Amended Complaint
And Request For Injunctive Relief**

Plaintiff, Sugarland Properties, Inc. (“SPI”), files this suit for trademark infringement, trademark dilution, and unfair competition against Edmund D. Samora and Edmund D. Samora, LLC (collectively, “Samora”).

1. The Court has jurisdiction over the subject matter of this action under 15 U.S.C. § 1121, 28 U.S.C. § 1338(b), and the doctrine of pendent jurisdiction.
2. In 1973, SPI established a real estate development (the “Development”) in Fort Bend County, near the city of Sugar Land, Texas. SPI created its FIRST COLONY mark for use in connection with the Development.
3. SPI operates its business in Fort Bend County, and in the city of Sugar Land, Texas. SPI offers for sale to the public its goods and services in Fort Bend County, in the city of Sugar Land, Texas, and in and around the Development.

4. SPI, by itself and through its licensees, has offered for sale to the public various products and services in connection with its FIRST COLONY mark, since at least as early as 1975. The products and services offered by SPI and its licensees, in connection with SPI's FIRST COLONY mark, include:
 - a. the sale, leasing and development of real estate;
 - b. newsletters related to community deed restriction compliance and community events;
 - c. organizing community events;
 - d. building construction;
 - e. real estate brokerage and management services;
 - f. planning and developing master-planned communities;
 - g. library services;
 - h. community association services;
 - i. podiatrist services;
 - j. child care and educational services;
 - k. flying club services;
 - l. health care services;
 - m. news reporting services;
 - n. sports association services; and
 - o. religious services.

5. SPI owns Federal Trademark Registration Number 3,323,420, for FIRST COLONY, for use in connection with (1) organizing community events, and (2) newsletters related to community deed-restriction compliance and community

events. “A registered mark is presumed to be distinctive and should be afforded the utmost protection.” *E. & J. Gallo Winery v. Spider Webs Ltd.*, 129 F.Supp.2d 1033, 1038 (S.D. Tex. 2001).

6. SPI has enforceable rights in its FIRST COLONY mark. SPI’s FIRST COLONY mark is not primarily geographically descriptive. When SPI created the Development, SPI selected FIRST COLONY as an arbitrary designation. Courts have rejected the argument that a development could become the victim of its own success, by distinguishing situations, in which the plaintiff coins and creates an arbitrary name for a geographic locale, from situations in which businesses use the name of an already existing geographic locale in their mark. *Pebble Beach Co. v. Tour 18 I. Ltd.*, 942 F. Supp. 1513 (S.D.Tex.1996), *aff’d as modified*, 155 F.3d 526 (5th Cir.1998) (enforcing PINEHURST because the mark was arbitrary and not geographically descriptive when coined by the plaintiffs, and because any developed geographic connotation was directly attributable to the success of the development itself); *see also Horseshoe Bay Resort Sales Co. v. Lake Lyndon B. Johnson Improvement Corp.*, 53 S.W.3d 799 (Tex.App.—Austin 2001); and *Prestwick, Inc. v. Don Kelly Bldg. Co.*, 302 F.Supp. 1121, 1124 (D. Md.1969). SPI can establish, as set forth above, that its FIRST COLONY marks are not geographically descriptive, and that any geographic connotation is due directly to SPI’s efforts to build and promote a development in the area.
7. SPI tightly controls use of its FIRST COLONY mark. SPI directly licenses the use of its FIRST COLONY mark to qualified businesses in the Development area. Over more than thirty years, SPI has exercised a high degree of restrictive

control over the FIRST COLONY mark's use by pursuing infringers and enforcing its rights in the mark. SPI has enforced its FIRST COLONY mark against a wide variety of infringers, including:

- a. An air conditioning services company;
 - b. A bank;
 - c. A chiropractor;
 - d. A florist;
 - e. A food mart;
 - f. A limousine service;
 - g. A mulch supply service;
 - h. An auto repair service;
 - i. A pest control company;
 - j. A plumbing services company;
 - k. A postal center;
 - l. A roofing and siding company; and
 - m. A gasoline service station.
8. As a result of SPI's enforcement activities, SPI's FIRST COLONY mark has developed good will, widespread fame, public recognition, and a reputation for quality and excellence.
9. Before SPI created the Development, there was no established area in Fort Bend County, or in the greater Houston area, known as "FIRST COLONY". When SPI created the Development, SPI selected FIRST COLONY as an arbitrary

designation for the location, and for the goods and services, which SPI intended to provide.

10. There is no area in Fort Bend County, Texas, which bears the name FIRST COLONY, and which has an active, functioning governmental structure, chartered by the state and administered by elected officials. Any geographic connotation associated with the phrase FIRST COLONY is due directly to SPI's efforts to build and promote a development in the area. Therefore, SPI's FIRST COLONY mark is not primarily geographically descriptive.
11. SPI's FIRST COLONY mark is distinctive for the goods and services provided by SPI and its direct licensees, because (1) the FIRST COLONY mark is arbitrary for the goods and services provided by SPI and its licensees, and (2) SPI's FIRST COLONY mark, through longstanding use and enforcement, is associated with good will, widespread fame, public recognition, and a reputation for quality and excellence.
12. Although defendants are not affiliated with SPI, defendants have been using the phrase "FIRST COLONY" in commerce without SPI's authorization.
13. Defendants operate a taxi service. Defendants operate their business and offer their services for sale to the public in Fort Bend County, in the city of Sugar Land, Texas, and in and around the Development. Defendants frequently locate their taxis near the Sugar Land Marriott Town Square, which is located in Sugar Land Town Square, another SPI property.

14. Defendants use the phrase FIRST COLONY TAXI as the name of their business, and as a service mark. Defendants have affixed signs containing the phrase “First Colony Taxi” to their taxis.
15. The phrases FIRST COLONY and FIRST COLONY TAXI are nearly identical. The phrases differ only in defendants’ addition of the word TAXI to SPI’s FIRST COLONY mark.
16. Consumers do not give long or careful consideration to engaging a taxi. When a taxi bears a mark developed for, and long associated with, a development, customers are likely to assume that taxi services offered near, or at, that development are associated with the development.
17. Defendants’ use of the FIRST COLONY mark creates a likelihood of confusion because:
 - a. Defendants’ trade name is nearly identical to SPI’s FIRST COLONY mark;
 - b. Both defendants and SPI, by itself and through its licensees, offer their goods and services for sale in the same geographic area, that is, Fort Bend County, Texas, Sugar Land, Texas, and in and around the Development;
 - c. The goods and services of both defendants and SPI, by itself and through its licensees, are offered to the public in the same or similar channels of trade; and
 - d. The goods and services provided by defendants and by SPI, by itself and through its licensees, are targeted to the same consumers—

residents of and visitors to the Development, Sugar Land, Texas, and the surrounding communities.

18. Determining whether a likelihood of confusion exists is a case-specific analysis.

In the Fifth Circuit, a Court will consider:

“the following nonexhaustive ‘digits of confusion’ in evaluating likelihood of confusion: (1) the type of trademark; (2) mark similarity; (3) product similarity; (4) outlet and purchaser identity; (5) advertising media identity; (6) defendant's intent; (7) actual confusion; and (8) care exercised by potential purchasers. No digit is dispositive, and the digits may weigh differently from case to case, ‘depending on the particular facts and circumstances involved.’ The court should consider all relevant evidence.”

Xtreme Lashes, LLC v. Xtended Beauty, Inc., 576 F.3d 221, 226-227 (5th Cir. 2009) (reversing summary judgments of non-infringement of the “XTREME LASHES” and “EXTEND YOUR BEAUTY” marks by the use of “XTENDED BEAUTY”). “The absence or presence of any one factor ordinarily is not dispositive; indeed, a finding of likelihood of confusion need not be supported even by a majority of the ... factors.” *Am. Rice, Inc. v. Producers Rice Mill, Inc.*, 518 F.3d 321, 329 (5th Cir. 2008). Proof of actual confusion is not a prerequisite, and no single factor is dispositive of the likelihood of confusion. *Taco Cabana Int'l, Inc. v. Two Pesos, Inc.*, 932 F.2d 1113, 1122 n.9 (5th Cir. 1991). To show a likelihood of confusion, “it is repeatedly held that the parties need not be in competition and that the goods or services need not be identical.” *Beef/Eater Restaurants, Inc. v. James Burrough Ltd.*, 398 F.2d 637, 639 (5th Cir. 1968).

19. Defendants, without authorization, use the phrase “FIRST COLONY TAXI” as a service mark. Defendants use SPI’s FIRST COLONY mark in the name of defendants’ business to identify and distinguish defendants’ services from others,

not simply to advertise the location of their business. Defendants' use is not nominative or descriptive fair use.

20. On at least two occasions, SPI has advised defendants that defendants' use of the phrase "FIRST COLONY" infringes SPI's FIRST COLONY mark. However, defendants have refused to discontinue their use of the phrase "FIRST COLONY" in connection with their business. Defendants' continued infringement of SPI's trademark is willful and deliberate.
21. Defendants' unauthorized use of the phrase "FIRST COLONY," as alleged above, constitutes infringement of SPI's federally registered mark (No. 3,323,420), in violation of 15 U.S.C. § 1114. Unless enjoined, defendants will continue their unauthorized use of the phrase "FIRST COLONY," resulting in a continuing likelihood of confusion and irreparable injury to SPI, for which SPI has no adequate remedy at law.
22. Defendants' unauthorized use of the phrase "FIRST COLONY," as alleged above, constitutes **infringement** of SPI's FIRST COLONY mark, in violation of 15 U.S.C. § 1125(a). Unless enjoined, defendants will continue their unauthorized use of the phrase "FIRST COLONY," resulting in a continuing likelihood of confusion and irreparable injury to SPI, for which SPI has no adequate remedy at law.
23. Defendants' actions, as alleged above, constitute injury to and **dilution** of SPI's FIRST COLONY mark under 15 U.S.C. § 1125(c). Unless enjoined, defendants will continue their infringing activities, resulting in irreparable injury to SPI, for which SPI has no adequate remedy at law.

24. “A likelihood of dilution can be caused by either “1) ‘blurring,’ a diminution in the uniqueness or individuality of the mark, or 2) ‘tarnishment,’ an injury resulting from another's use of the mark in a manner that tarnishes or appropriates the goodwill and reputation associated with the plaintiff's mark.” *E. & J. Gallo Winery v. Spider Webs Ltd.*, 286 F.3d 270, 279 (5th Cir. 2002). “Interpreting the Texas anti-dilution statute, both federal and state courts have determined that, if the claimant holds a distinctive mark, ‘it is enough [for dilution] that the defendant has made significant use of a very similar mark.’” *Abraham v. Alpha Chi Omega*, 781 F. Supp. 2d 396, 430 (N.D. Tex. 2011) (citing *Pebble Beach Co. v. Tour 18 I, Ltd.*, 942 F. Supp. 1513, 1564 (S.D. Tex. 1996), and *Horseshoe Bay Resort Sales Co. v. Lake Lyndon B. Johnson Imp. Corp.*, 53 S.W.3d 799, 812 (Tex.App.-Austin 2001)). Defendants’ significant use of the phrase FIRST COLONY in connection with their business is sufficient to establish a likelihood of dilution.
25. Defendants’ actions, as alleged above, constitute injury to and dilution of SPI's FIRST COLONY mark under § 16.29 of the Texas Business & Commerce Code. Unless enjoined, defendants will continue their infringing activities, resulting in irreparable injury to SPI, for which SPI has no adequate remedy at law. Section 16.29 of the Texas Business & Commerce Code provides:

“A person may bring an action to enjoin an act likely to injure a business or to dilute the distinctive quality of a mark registered under this chapter or Title 15, U.S.C., **or a mark or trade name valid at common law**, regardless of whether there is competition between the parties or confusion as to the source of goods or services. An injunction sought under this section shall be pursuant to Rule 680 et seq. of the Texas Rules of Civil Procedure.”

TEX. BUS. & COM. CODE ANN. § 16.29 (emphasis added).

26. Defendants' actions, as alleged above, constitute common law trademark infringement and unfair competition under Texas law. Unless enjoined, defendants will continue their infringing activities, resulting in irreparable injury to SPI, for which SPI has no adequate remedy at law.
27. SPI is entitled to recover its damages, including costs of suit and attorneys' fees.

Prayer For Relief

SPI prays for the following relief:

- A. That defendants and their agents, servants, and employees, and all others in concert or participation with them, be enjoined from using the phrase "FIRST COLONY" as a part of defendants' trade name or in any other manner in connection with defendants' business in Texas;
- B. That defendants be ordered, pursuant to 15 U.S.C. § 1118, to modify or destroy all literature, signs, labels, prints, packages, wrappers, containers, advertising materials, stationery, and any other items in their possession or control which contain the phrase "FIRST COLONY", either alone or in combination with other words or symbols;
- C. That defendants be ordered to remove all reference to the phrase "FIRST COLONY" in any form from any website or any other online marketing or advertising over which defendants have authority or control;
- D. That defendants be ordered to file with the court and to serve on SPI, within thirty (30) days after the entry of an injunction, a report in writing, under oath, setting

forth in detail the manner and form in which defendants have complied with the injunction;

- E. That SPI recover from defendants its damages, including costs of suit and reasonable attorneys' fees;
- F. That SPI recover from defendants prejudgment and post judgment interest at the applicable rates on all amounts awarded herein; and
- G. That SPI have such further relief to which it may be entitled.

Dated: April 5, 2012

Respectfully submitted,

/s/ Tim Headley

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Certificate Of Service

I certify that on April 5, 2012, the foregoing document is being transmitted by email to Mr. Paul Beik, counsel for defendants.

/s/ Tim Headley
Tim Headley