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

Proceeding	91205107
Party	Defendant Edmund D Samora LLC dba First Colony Taxi
Correspondence Address	EDMUND D SAMORA LLC PO BOX 1475 ROSENBERG, TX 77471-1475 UNITED STATES trademark@firstcolonytaxi.com, edmund@firstcolonytaxi.com
Submission	Motion to Suspend for Civil Action
Filer's Name	Paul S. Beik, Beik Law Firm, PLLC
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Signature	/Paul S. Beik/
Date	05/24/2012
Attachments	Applicant's Motion to Suspend Proceedings.pdf (20 pages)(823328 bytes)

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

Sugarland Properties, Incorporated,	)	
	)	Opposition No. 91205107
Opposer,	)	
	)	Ser. No. 85478417
v.	)	
	)	
Edmund D. Samora, LLC,	)	
	)	
Applicant.	)	

APPLICANT'S MOTION TO SUSPEND PROCEEDINGS

Pursuant to 37 C.R.R. §§2.117(a) and 2.127(a), Applicant, Edmund D. Samora, LLC ("Applicant"), by and through the undersigned, hereby moves for the Trademark Trial and Appeal Board ("Board") to issue an order that suspends this proceeding until the final disposition of the civil action between Applicant and Opposer, pending before the United States District Court for the Southern District of Texas, Houston Division. In support this motion and the relief requested, Applicant would respectfully show as follows:

1. On December 16, 2011, Opposer, Sugarland Properties, Incorporated ("Opposer"), filed Civil Action No. 4:11-CV-4439, *Sugarland Properties, Inc. v. Edmund D. Samora and Edmund D. Samora, LLC*, in the United States District Court for the Southern District of Texas, Houston Division ("Civil Action"). *See* Exhibit A.

2. In the Civil Action, Opposer's latest pleading asserts causes of action for federal trademark infringement under 15 U.S.C. § 1125(a), federal trademark dilution under 15 U.S.C. § 1125(c), and other related causes of action under Texas state law. *See* Exhibit B.

3. The Civil Action is currently pending.

4. The claims asserted in the Civil Action involve common issues of law and fact as the issues presented in the above-captioned Opposition proceeding before the Board. The Civil

Action has a direct bearing on this Opposition proceeding before the Board. *See* Trademark Rule 2.127.

5. Applicant submits in support of this motion that it has been the Board's policy to suspend proceedings when the parties are involved in a civil action which may be dispositive of or have a bearing on the Board case. *See* Trademark Rule 2.117(a).

6. Moreover, Applicant submits that the determination of the issues presented in the Civil Action would be dispositive of this Opposition proceeding.

Based on the foregoing, pursuant to Trademark Rule 2.117(a), Applicant respectfully requests that the Board issue an Order suspending this Opposition proceeding pending the final disposition of the Civil Action between the parties.

Dated: May 24, 2012

Respectfully submitted,

BEIK LAW FIRM, PLLC

By: /s/Paul S. Beik

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ATTORNEY FOR APPLICANT
EDMUND D. SAMORA, LLC

CERTIFICATE OF SERVICE

I hereby certify that, pursuant to 37 CFR §2.119(b)(4), a true and correct copy of the foregoing instrument was served by first class mail on this the 24th day of May 2012, to the following attorney of record for Opposer as follows:

Tim Headley
Law Offices of Tim Headley
7941 Katy Fwy., Suite 506
Houston, Texas 77024

Attorney for Opposer
Sugarland Properties, Inc.

/s/Paul S. Beik

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ATTORNEY FOR APPLICANT
EDMUND D. SAMORA, LLC

EXHIBIT A

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 ORIGINAL 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.

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. SPI, by itself and through its licensees, has offered for sale to the public various products and services in connection with the "FIRST COLONY" mark, since at least as early as 1975.
3. Although defendants are not affiliated with SPI, defendants have been using the phrase "FIRST COLONY" in commerce without SPI's authorization.
4. Defendants operate a taxi service in and around Sugar Land, Texas. Defendants have affixed signs containing the phrase "First Colony Taxi" to their taxis.

5. On at least two occasions, SPI has advised defendants that defendants' use of the phrase "FIRST COLONY" infringes SPI's trademarks. However, defendants have refused to discontinue their use of the phrase "FIRST COLONY" in connection with their business. Defendants' continued infringement of SPI's trademarks is willful and deliberate.

6. Defendants' unauthorized use of the phrase "FIRST COLONY" as part of the trade name and service mark for their business, as alleged above, is likely to cause confusion as to defendants' affiliation a) with SPI or b) with SPI's products and services.

7. 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. § 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.

8. Defendants' actions, as alleged above, constitute injury to and dilution of SPI's trade name, trademarks, and service marks 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.

9. Defendants' actions, as alleged above, constitute injury to and dilution of SPI's trade name, trademarks, and service marks 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.

10. 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.

11. 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: December 16, 2011

Respectfully submitted,

/s/ Heather Hoopingarner Thiel

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Attorneys for Sugarland Properties, Inc.

EXHIBIT B

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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Attorney for Sugarland Properties, Inc.

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