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

Proceeding	91212034
Party	Plaintiff Champion Roofing, Inc.
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Date	08/23/2013
Attachments	Opposer's Response In Support of Applicant's Motion To Suspend.pdf(861480 bytes )

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

In the matter of the Application Serial No. 85702939  
For the mark: CHAMPION

In the matter of the Application Serial No. 85720613  
For the mark: CHAMPION and design

In the matter of the Application Serial No. 85720645  
For the mark: CHAMPION WINDOWS · SUN ROOMS & HOME EXTERIORS (and design)

In the matter of the Application Serial No. 85749389  
For the mark: CHAMPION EXTERIOR HOME IMPROVEMENTS CERTIFIED  
CONTRACTOR

In the matter of the Application Serial No. 85824612  
For the mark: CHAMPION WINDOWS · SUNROOMS · ROOFS · HOME (and design)

CHAMPION ROOFING, INC.

**OPPOSITION NOS.**

Opposer,

**91212032**

**91212034**

v.

**91212035**

**91212036**

CHAMPION WINDOW MANUFACTURING  
AND SUPPLY CO., LLC

**91212038**

Applicant.

**OPPOSER'S RESPONSE IN SUPPORT OF APPLICANT'S MOTION TO  
SUSPEND**

Opposer submits this Response in Support of Applicant's Motion to Suspend (filed August 19, 2012). Applicant has moved to suspend proceedings as provided under 37 CFR §2.117 and Trademark Trial and Appeal Board Manual of Procedure ("TBMP") § 510.02 (3d ed. rev.2 2013). Suspension of the pending opposition proceedings is proper and therefore Opposer joins in Applicant's motion.

On July 31, 2013, Opposer, Champion Roofing, Inc., filed suit against Applicant, Champion Window Manufacturing and Supply Co., LLC aka Champion Window, in the United States District Court for the Northern District of Illinois for false designation of origin under §43(a) of the Lanham Act and related claims (Case No. 1:13-cv-05478) (the “Lawsuit”). Specifically, in the Lawsuit Opposer, as the senior user of the CHAMPION ROOFING mark for roofing services, claims that Applicant’s use of the CHAMPION name in connection with roofing services in the Chicago area is likely to cause confusion, or to cause mistake or to deceive. Consistent with Trademark Trial and Appeal Board (the “Board”) practice and procedure, a copy of the operative pleading from the Lawsuit is attached as Exhibit A.

In Opposition Nos. 91212032, 91212034, 91212035, 91212036 and 91212038, Opposer, as the senior user of the CHAMPION ROOFING mark for roofing services, similarly alleges that Applicant’s use of the prominent CHAMPION name in five pending trademark applications for roofing services is likely to cause confusion, or to cause mistake or to deceive.

Notices of Opposition in Opposition Nos. 91212032, 91212034, 91212035, 91212036 and 91212038 were all filed on August 14, 2013, approximately two weeks after Opposer filed the Lawsuit.

Because the pending Lawsuit involves the same parties and issues that are common to those in all five of the applicable opposition proceedings before the Board, Opposer joins in Applicant’s suspension request. The disposition of the Lawsuit is likely to have a bearing on the opposition proceedings. For these reasons, Opposer agrees with Applicant that suspension of proceedings is appropriate.

In view thereof, Opposer respectfully requests that Applicant's Motion to Suspend be granted and that proceedings suspended pending the resolution of the Lawsuit.<sup>1</sup>

Respectfully submitted,

/S/  
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Attorneys for Opposer

CERTIFICATE OF ELECTRONIC FILING

I hereby certify that this notice is being filed with the Trademark Trial and Appeal Board, Commissioner for Trademarks, P.O. Box 1451, Alexandria, Virginia 22313-1451, by using the ESTTA electronic filing system, this 23<sup>rd</sup> day of August 2013.

/S/  
Brian D. Brown

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<sup>1</sup> Opposer further notes Applicant's pending August 19, 2013 Motion to Consolidate. If the TTAB grants that motion, Opposer presumes that the five proceedings will be consolidated into a single matter, with any subsequent papers and orders to flow from the "parent" case.

CERTIFICATE OF SERVICE

I hereby certify that a copy of the foregoing "Response In Support Of Applicant's Motion To Suspend" has been served on Applicant's Attorney, William S. Wyler, with Schwartz Manes Ruby & Slovin, 2900 Carew Tower, 441 Vine Street, Cincinnati, Ohio 45202-3090 via first class mail, today August 23, 2013.



Jeanne A. Cook

# EXHIBIT A

UNITED STATES DISTRICT COURT  
FOR THE NORTHERN DISTRICT OF ILLINOIS

CHAMPION ROOFING, INC.,	)	
	)	
Plaintiff,	)	
	)	
vs.	)	Case No.
	)	
CHAMPION WINDOW	)	
MANUFACTURING AND SUPPLY	)	
CO., LLC,	)	
CHAMPION WINDOW COMPANY OF	)	
CHICAGO, LLC and	)	
CHAMPION WINDOW COMPANY OF	)	
MERRILLVILLE, LLC	)	
	)	
Defendants.	)	
_____	)	

**COMPLAINT AND JURY DEMAND**

Plaintiff Champion Roofing, Inc. (“Champion Roofing”), by and through its attorneys, brings this action against Champion Window Manufacturing and Supply Co., LLC, Champion Window Company of Chicago, LLC and Champion Window Company of Merrillville, LLC (collectively, “Champion Window”), and alleges as follows:

**NATURE OF THE ACTION**

1. This is an action for trademark infringement, contributory trademark infringement, dilution and unfair competition involving Champion Window’s unlawful use of the name “Champion” in connection with roofing services in the Chicago metropolitan area comprising the counties of Boone, Cook, DeKalb, DuPage, Grundy, Kane, Kankakee, Kendall, La Salle, McHenry, Will, and Lake in Illinois; Jasper, Lake, Newton, and Porter in Indiana; and Kenosha and Racine in Wisconsin (the “Chicagoland Area”). Champion Roofing seeks preliminary and permanent injunctive relief, disgorgement of profits and actual damages, and

other relief as specified below.

**PARTIES**

2. Champion Roofing is an Illinois corporation with its principal place of business at 219 William Street, Bensenville, IL 60106.

3. Upon information and belief, Champion Window Manufacturing and Supply Co., LLC is a Delaware limited liability company with its principal place of business at 12121 Champion Way, Cincinnati, OH 45241.

4. Upon information and belief, Champion Window Company of Chicago, LLC is a Delaware limited liability company with its principal place of business at 549 West Lake Street, Elmhurst, IL 60126.

5. Upon information and belief, Champion Window Company of Merrillville, LLC is a Delaware limited liability company with its principal place of business at 1650 Indianapolis Blvd, Schererville, IN 46375.

**JURISDICTION AND VENUE**

6. This case arises under the Lanham Act, 15 U.S.C. § 1051, et seq. and Illinois law.

7. This Court has subject matter jurisdiction over Champion Roofing's Lanham Act claims pursuant to 28 U.S.C. §§ 1331 and 1338 and has supplemental jurisdiction over Champion Roofing's state law claims pursuant to 28 U.S.C. § 1367.

8. This Court has personal jurisdiction over Champion Window Manufacturing and Supply Co., LLC because it generally does business in and purposefully directs its activities toward this forum. Champion Window Manufacturing and Supply Co., LLC markets, advertises, offers to sell, sells, and distributes its products and services throughout the United States, including in the Northern District of Illinois. This Court also has personal jurisdiction over



Champion Window Manufacturing and Supply Co., LLC because it has committed and caused to be committed unlawful acts in Illinois causing injury to Champion Roofing in the Northern District of Illinois.

9. This Court has personal jurisdiction over Champion Window Company of Chicago, LLC and Champion Window Company of Merrillville, LLC (“the Champion Subsidiaries”) because they are registered to do business in the state of Illinois and do business in the state of Illinois.

10. This Court also has personal jurisdiction over the Champion Subsidiaries because they purposefully direct their activities toward this forum. The Champion Subsidiaries market, advertise, offer to sell, sell, and distribute their products and services throughout the Chicagoland Area, including in the Northern District of Illinois. In addition, the Champion Subsidiaries have committed and caused to be committed unlawful acts in Illinois causing injury to Champion Roofing in the Northern District of Illinois.

11. Venue is proper in this district pursuant to 28 U.S.C. § 1391(b) and (c).

### **GENERAL ALLEGATIONS**

#### **A. Champion Roofing**

12. In 1998, Harry Friedman and Joseph Smith were employed by the same Chicago roofing company and believed the time was right for them to strike out on their own and build a business for themselves. With their ample experience and entrepreneurial spirit, they launched their new roofing business in Chicago in 1999. They decided to call their business Champion Roofing, Inc. and incorporated the company on January 12, 1999. *See Exhibit A.*

13. On February 19, 1999, Champion Roofing started using the CHAMPION ROOFING INC. trade name and service mark (the “CHAMPION ROOFING Mark”) in

connection with residential and commercial roofing services in the Chicagoland Area.

14. On February 22, 1999, Champion Roofing obtained roofing contractor license number 104011864 from the Illinois Department of Financial and Professional Regulation, which license is currently valid through June 30, 2015.

15. Since 1999, Champion Roofing has continuously provided residential and commercial roofing services under the CHAMPION ROOFING Mark to consumers in the Chicagoland Area.

16. From humble beginnings, Harry and Joe have built Champion Roofing into one of the major roofing contractors in the Chicagoland Area. Despite a challenging economy, Champion Roofing has produced sales of over \$37 million over the last five years.

17. Champion Roofing is a roofing specialist providing customized installation of state of the art roofing systems, involving the use of single ply membranes, including modified bitumen, PVC, EPDM, and TPO, shingles, slate, and other surfaces, to commercial businesses, industrial facilities, and residential homes.

18. Champion Roofing has been designated a Duro-Last Elite Contractor by Duro-Last Roofing, Inc., a GAF Certified Contractor by GAF Corp., a TAMKO Pro Contractor by TAMKO Building Products Inc., and has been certified as an installer by Firestone Building Products Company, Carlisle SynTec, Versico Incorporated, GenFlex Roofing Systems, Mule-Hide Products Co, Inc. and Johns Manville, the most prominent roofing system manufacturers in the trade.

19. In their effort to establish and grow the Champion Roofing business, Harry and Joe have worked extremely hard to satisfy customers throughout the Chicagoland Area, and Champion Roofing has received a number of awards as a result.

20. Duro-Last Roofing, a prominent manufacturer of roofing systems, has awarded Champion Roofing either the Elite Contractor Award, Presidents Club Award, or Admirals Club Award every year from 2000 through 2012.

21. Angie's List, a prominent and well respected review website that assists consumers in finding the highest quality service providers, awarded Champion Roofing its prestigious Super Service Award for roofing services in 2005, 2006, 2007, 2008, 2009, and 2010.

22. Best Pick Reports, a prominent and well respected independent researcher of home service providers, awarded Champion Roofing its EBSCO Research Best Pick Award for roofing services in 2010, 2011, 2012, and 2013.

23. In addition to building its brand through top quality service, Champion Roofing has invested millions of dollars advertising the CHAMPION ROOFING Mark in the Chicagoland Area.

24. Champion Roofing uses various strategies to advertise the CHAMPION ROOFING Mark in the Chicagoland Area, including development and promotion of its website, direct marketing, Internet lead generation, radio advertising, television advertising, and advertising with the yellow pages, Angie's List, Blue Book, Better Business Bureau, and Best Pick Reports.

25. Over the years, Champion Roofing has run numerous radio advertisements on Chicagoland Area radio stations, including AM 670 The Score "Chicago SportsRadio," 89 WLS "Chicago's Talk Leader," and WGN Radio 720 "The Voice of Chicago."

26. Champion Roofing has also run numerous television commercials on Chicagoland Area television stations, including Comcast SportsNet's CSNChicago, CLTV "Chicagoland Television," and WGN "Chicago's Very Own," as well as Chicagoland Area broadcasts of

Comcast Cable TV channels including the NFL Network.

27. Champion Roofing has advertised in connection with WGN's "Chicago Weather Center" and its radio and television advertising often has "weather triggers" so that more extensive advertising occurs at times of substantial rainfall.

28. Champion Roofing has advertised in connection with home improvement television shows like WGN's "Weekend Workbench," also shown on CLTV.

29. In recent years, Champion Roofing has focused its television advertising on Chicago's popular sports franchises. For example, Champion Roofing sponsored the "Player of the Game" award on CSNChicago's television broadcasts of 2012 Chicago Bears professional football games, including the September 9<sup>th</sup> game against the Indianapolis Colts, when Brandon Marshall won the award in his first game as a Chicago Bear.

30. Champion Roofing sponsored the "Goal of the Game" award on CSNChicago's television broadcasts of 2013 Chicago Blackhawks professional hockey playoffs games, including Game 6 of the Stanley Cup Final on June 24<sup>th</sup> against the Boston Bruins, when Dave Bolland won the award for his series-clinching goal with 59 seconds left in the game.

31. As a result of Champion Roofing's extensive advertising, marketing and sales over the last 14 years, the CHAMPION ROOFING Mark has become well-recognized by consumers in the Chicagoland Area as a single source of quality roofing services.

32. Champion Roofing has taken steps to protect and enforce its rights in the CHAMPION ROOFING Mark in the Chicagoland Area. On April 26, 2010, Champion Roofing registered the CHAMPION ROOFING (and weightlifter design) trademark with the State of Illinois (Illinois Trademark Registration No. 101614). *See Exhibit B.*

33. On April 28, 2010, Champion Roofing sent a cease-and-desist letter to

“Champion Roofing & Construction Co.” of Chicago demanding that it halt use of the CHAMPION ROOFING Mark for roofing services, and Champion Roofing & Construction Co. complied with this demand.

**B. Champion Window**

34. Upon information and belief, Champion Window is a national manufacturer and seller of replacement windows. According to the history of Champion Window available at its website (<http://www.championwindow.com/about/history.aspx>), the company was “[f]ounded as a small manufacturer of aluminum storm windows, storm doors, awnings and screen rooms” in 1953.

35. Upon information and belief, Champion Window started serving the Chicagoland Area in 2002. On July 30, 2002, Champion Window Company of Chicago, LLC was incorporated in Illinois, and later merged with a Delaware limited liability company bearing the same name.

36. On December 5, 2007, Champion Window Company of Merrillville, LLC registered to do business in Illinois.

37. Champion Window offers its windows and related window replacement services under the CHAMPION mark.

38. Until this year, Champion Roofing and Champion Window coexisted without any issues or objections concerning their names in the Chicagoland Area. At no time prior to 2013 did either party object to the other party’s use of their respective marks. Further, until 2013, Champion Roofing was unaware of any instances of actual confusion by consumers concerning its use of the CHAMPION ROOFING Mark.

### **C. Champion Window Expands Into Roofing**

39. In the spring of 2013, Champion Roofing first became aware that Champion Window had expanded its services and was advertising roofing services in the Chicagoland Area under the “Champion” name. Champion Roofing became aware of this when a Champion Roofing customer tendered a Champion Window coupon to Champion Roofing mistakenly believing that the coupon was from Champion Roofing. Champion Roofing then conducted a Google search and discovered Champion Window’s Internet advertisements for roofing services in the Chicagoland Area.

40. Champion Roofing investigated Champion Window’s use of the “Champion” name in connection with roofing services. This investigation revealed that Champion Window Manufacturing and Supply Co. had filed the following trademark applications with the USPTO:

- a. Application serial number 85/702,939, dated August 14, 2012, for CHAMPION for roofing services (the “‘939 Application”), claiming first use on August 8, 2012;
- b. Application serial number 85/720,613, dated September 5, 2012, for CHAMPION (and design) for roofing services (the “‘613 Application”), claiming first use on June 1, 2012;
- c. Application serial number 85/720,645, dated September 5, 2012, for CHAMPION WINDOWS · SUN ROOMS & HOME EXTERIORS (and Design) for roofing services (the “‘645 Application”), claiming first use on June 1, 2012;
- d. Application serial number 85/749,389, dated October 9, 2012, for CHAMPION EXTERIOR HOME IMPROVEMENTS CERTIFIED CONTRACTOR (and Design) for roofing services on an intent-to-use basis (the “‘389 Application”);

and

- e. Application serial number 85/824,612, dated January 16, 2013, for CHAMPION WINDOWS · SUNROOMS · ROOFS · HOME EXTERIORS (and Design) for roofing services (the “612 Application”), claiming first use on January 14, 2013.

41. Based on its prior rights in the CHAMPION ROOFING Mark for roofing services, Champion Roofing will be opposing each of Champion Window’s applications to register “Champion” marks for roofing services.

42. Upon information and belief, Champion Window was aware of Champion Roofing’s prior rights to the CHAMPION ROOFING Mark in the Chicagoland Area and, as a much larger company with greater resources, decided to intentionally and willfully enter the Chicagoland Area roofing market in the spring of 2013 and appropriate for itself the substantial goodwill Champion Roofing had established in the CHAMPION ROOFING Mark.

43. Upon information and belief, in the spring of 2013 Champion Window began bidding on the keyword “Champion Roofing” on Google AdWords and similar online programs marketing to the Chicagoland Area.

44. Upon information and belief, in the spring of 2013 Champion Window began advertising roofing services under the “Champion” name on Chicago radio stations like WGN Radio.

45. Upon information and belief, in the spring of 2013 Champion Window began flooding the Chicagoland Area with coupons (“Champion Window Coupons”) similar to the coupon attached at **Exhibit C**. The Champion Window Coupons prominently display the “Champion” name and offer discounts of \$1,800, \$1,200 or 20% off on roofing services.

46. Champion Window’s use of the “Champion” name in connection with offering

and advertising roofing services in the Chicagoland Area has caused actual confusion over the source of Champion Window's roofing services. Numerous Champion Roofing customers have presented Champion Roofing with Champion Window Coupons. Champion Roofing also has received numerous email inquiries and telephone calls intended for Champion Window. Several examples of these instances of actual confusion are shown in email correspondence from consumers attached as **Exhibit D**.

47. On April 23, 2013, Champion Roofing, through its attorneys, sent a letter to Champion Window demanding it halt all use of the name "Champion" in connection with roofing services in Champion Roofing's market.

48. In its response, Champion Window denied infringing the CHAMPION ROOFING Mark and instead threatened Champion Roofing with litigation.

49. Until its response to Champion Roofing's April 23, 2013 cease-and-desist letter, Champion Window had never objected to Champion Roofing's use of the CHAMPION ROOFING Mark.

**FIRST CLAIM FOR RELIEF**

Against all Defendants

False Designation of Origin - 15 U.S.C. § 1125(a)

50. Champion Roofing incorporates each of the preceding paragraphs as if fully set forth herein.

51. Champion Roofing owns the trade name and service mark CHAMPION ROOFING INC. in the Chicagoland Area for commercial and residential roofing services.

52. Since 1999, Champion Roofing has continuously used the CHAMPION ROOFING Mark in connection with residential and commercial roofing services in the Chicagoland Area to identify its services and distinguish them from those offered by others. Champion Roofing has accomplished this by using the CHAMPION ROOFING Mark as the



prominent trade name of its business and prominently displaying the mark on store fronts, vehicles, lawn signs, letterheads, bills, direct mail advertising, referral website services, radio and television advertising, telephone directory advertising and Internet advertising, among others. As a result of Champion Roofing's continuous use of the CHAMPION ROOFING Mark, the CHAMPION ROOFING Mark has come to signify that roofing services sold under the "Champion" name are derived from a single source. As such, the CHAMPION ROOFING Mark has acquired distinctiveness and secondary meaning.

53. Champion Window's unauthorized use of the "Champion" name in connection with roofing services is a false designation of origin in interstate commerce which is likely to cause confusion, to cause mistake and to deceive as to the affiliation, connection or association of defendants with Champion Roofing and as to the origin, sponsorship, or approval of such services by Champion Roofing. Such conduct constitutes a false designation of origin in violation of the Lanham Act, 15 U.S.C. § 1125(a).

54. Champion Window's infringing actions have been with knowledge of Champion Roofing's prior and exclusive rights in the CHAMPION ROOFING Mark, and with an intent to trade on and take advantage of Champion Roofing's goodwill in the CHAMPION ROOFING Mark.

55. Champion Roofing has suffered, and will continue to suffer, substantial injuries, loss, and damage to its business as a direct and proximate result of Champion Window's infringing acts.

56. As a direct and proximate result of Champion Window's knowing, deliberate, and willful infringement of the CHAMPION ROOFING Mark, Champion Roofing has suffered damages in an amount that will be shown at trial.

57. As a direct and proximate result of Champion Window's infringement, Champion Roofing is entitled to disgorgement of Champion Window's profits flowing from its infringement as well as an award of past and future corrective advertising to alleviate existing confusion resulting from Champion Window's unlawful use of the name "Champion" in connection with roofing services.

58. Based on the knowing, deliberate, and willful nature of Champion Window's unlawful conduct, this is an exceptional case, entitling Champion Roofing to an award of treble damages, prejudgment interest, and its reasonable attorneys' fees.

59. As a direct and proximate result of Champion Window's knowing, deliberate, and willful infringement, Champion Roofing has suffered, and will continue to suffer, irreparable injury to its business, reputation, and goodwill, unless and until Champion Window's actions as alleged herein are preliminarily and permanently enjoined.

**SECOND CLAIM FOR RELIEF**

Against Champion Window Manufacturing and Supply Co.  
Contributory False Designation of Origin - 15 U.S.C. § 1125(a)

60. Champion Roofing hereby incorporates each of the preceding paragraphs as if fully set forth herein.

61. Champion Window Manufacturing and Supply Co. has induced, encouraged, and facilitated, and continues to induce, encourage and facilitate, the Champion Subsidiaries' knowing and intentional infringement of the CHAMPION ROOFING Mark.

62. At the time that Champion Window Manufacturing and Supply Co. first induced, encouraged and facilitated the Champion Subsidiaries' adoption of the "Champion" name in connection with roofing services, Champion Window Manufacturing and Supply Co. knew or should have known that the Champion Subsidiaries' adoption and use of the "Champion" name

was unauthorized and without Champion Roofing's consent.

63. Champion Window Manufacturing and Supply Co. engaged in knowing and systematic inducement, causing and materially contributing to the Champion Subsidiaries' knowing, intentional, unauthorized adoption and use of the "Champion" name in association with roofing services provided by the Champion Subsidiaries. Champion Window Manufacturing and Supply Co.'s conduct has been willful, intentional and purposeful, in disregard of Champion Roofing's rights.

64. Champion Window Manufacturing and Supply Co. continues to supply its product and provide services to the Champion Subsidiaries despite the fact that it knows that the Champion Subsidiaries are engaging in trademark infringement by offering roofing services in the Chicagoland Area under the "Champion" name.

65. Champion Window Manufacturing and Supply Co.'s conduct thus constitutes contributory infringement of the CHAMPION ROOFING Mark.

66. Champion Roofing has suffered, and will continue to suffer, substantial injuries, loss, and damage to its business as a direct and proximate result of Champion Window Manufacturing and Supply Co.'s contributory infringement.

67. As a direct and proximate result of Champion Window Manufacturing and Supply Co.'s knowing, deliberate, and willful contributory infringement of the CHAMPION ROOFING Mark, Champion Roofing has suffered damages in an amount that will be shown at trial.

68. As a direct and proximate result of Champion Window Manufacturing and Supply Co.'s contributory infringement, Champion Roofing is entitled to disgorgement of Champion Window Manufacturing and Supply Co.'s profits flowing from its unlawful acts as

well as an award of corrective advertising to alleviate existing confusion resulting from the infringement of the CHAMPION ROOFING Mark.

69. Based on the knowing, deliberate, and willful nature of Champion Window Manufacturing and Supply Co.'s unlawful conduct, this is an exceptional case, entitling Champion Roofing to an award of treble damages, prejudgment interest, and its reasonable attorneys' fees.

70. As a direct and proximate result of Champion Window Manufacturing and Supply Co.'s knowing, deliberate, and willful contributory infringement, Champion Roofing has suffered, and will continue to suffer, irreparable injury to its business, reputation, and goodwill, unless and until Champion Window Manufacturing and Supply Co.'s actions as alleged herein are preliminarily and permanently enjoined.

**THIRD CLAIM FOR RELIEF**

Against all Defendants

Trademark Infringement - 765 Ill. Comp. Stat. 1036/60

71. Champion Roofing hereby incorporates each of the preceding paragraphs as if fully set forth herein

72. Champion Roofing owns Illinois State Trademark Registration No. 101614 for CHAMPION ROOFING (and weightlifter design) (the "Registered Mark").

73. Champion Window's unauthorized use of the "Champion" name in connection with the sale, offering for sale, and advertisement of roofing services is likely to cause, and has actually caused, confusion, mistake, or deception as to the source, origin, sponsorship, or affiliation of Champion Window's services and products. Such conduct constitutes trademark infringement in violation of the Illinois Trademark Registration and Protection Act, 765 Ill. Comp. Stat. 1036/60.

74. Champion Window's infringing actions have been with knowledge of Champion Roofing's prior and exclusive rights in the Registered Mark, and with an intent to trade on and take advantage of Champion Roofing's goodwill in the Registered Mark.

75. Champion Roofing has suffered, and will continue to suffer, substantial injuries, loss, and damage to its business as a direct and proximate result of Champion Window's infringing acts.

76. As a direct and proximate result of Champion Window's knowing, deliberate, and willful infringement of the Registered Mark, Champion Roofing has suffered damages in an amount that will be shown at trial.

77. As a direct and proximate result of Champion Window's infringement, Champion Roofing is entitled to disgorgement of Champion Window's profits flowing from its infringement.

78. Based on the knowing, deliberate, and willful nature of Champion Window's unlawful conduct, this is an exceptional case, entitling Champion Roofing to an award of treble damages, prejudgment interest, and its reasonable attorneys' fees.

79. As a direct and proximate result of Champion Window's knowing, deliberate, and willful infringement, Champion Roofing has suffered, and will continue to suffer, irreparable injury to its business, reputation, and goodwill, unless and until Champion Window's actions as alleged herein are preliminarily and permanently enjoined.

**FOURTH CLAIM FOR RELIEF**

Against all Defendants

Injury to Business Reputation; Dilution - 765 Ill. Comp. Stat. 1036/65

80. Champion Roofing hereby incorporates each of the preceding paragraphs as if fully set forth herein.

81. Champion Roofing has expended millions of dollars to promote the CHAMPION ROOFING Mark and has enjoyed widespread independent recognition of its brand. This, together with the distinctive nature of the registered CHAMPION ROOFING Mark, among other things, has rendered the CHAMPION ROOFING Mark famous in the State of Illinois since at least as early as 2011.

82. According to Champion Window's '939, '613, '645, '389, and '612 Applications with the USPTO, Champion Window commenced its unauthorized use of the "Champion" name in connection with roofing services in late 2012, after the CHAMPION ROOFING Mark became famous in the State of Illinois.

83. Champion Window's unauthorized use of the "Champion" name in connection with the sale, offering for sale, and advertisement of roofing began after the CHAMPION ROOFING Mark became famous in the State of Illinois causing dilution to the distinctive quality of the CHAMPION ROOFING Mark in violation of the Illinois Trademark Registration and Protection Act, 765 Ill. Comp. Stat. 1036/65.

84. Champion Window's unlawful actions have been willful and with knowledge of Champion Roofing's prior and exclusive rights in the CHAMPION ROOFING Mark, and with an intent to trade on and take advantage of Champion Roofing's goodwill in the CHAMPION ROOFING Mark.

85. Champion Roofing has suffered, and will continue to suffer, substantial injuries, loss, and damage to its business as a direct and proximate result of Champion Window's unlawful acts.

86. As a direct and proximate result of Champion Window's knowing, deliberate, and willful use of the "Champion" name in connection with roofing services, Champion Roofing has

suffered damages in an amount that will be shown at trial.

87. As a direct and proximate result of Champion Window's knowing, deliberate, and willful use of the "Champion" name in connection with roofing services, Champion Roofing is entitled to disgorgement of Champion Window's profits flowing from its unlawful acts.

88. Based on the willful nature of Champion Window's unlawful conduct, this is an exceptional case, entitling Champion Roofing to an award of treble damages, prejudgment interest, and its reasonable attorneys' fees.

89. As a direct and proximate result of Champion Window's knowing, deliberate, and willful acts, Champion Roofing has suffered, and will continue to suffer, irreparable injury to its business, reputation, and goodwill, unless and until Champion Window's actions as alleged herein are preliminarily and permanently enjoined.

**FIFTH CLAIM FOR RELIEF**

Against all Defendants

Deceptive Trade Practices - 815 Ill. Comp. Stat. 510/2

90. Champion Roofing hereby incorporates each of the preceding paragraphs as if fully set forth herein.

91. Champion Window has unlawfully offered roofing services under the "Champion" name in the course of its business, thereby passing off Champion Window's services as those of Champion Roofing and causing a likelihood of confusion and actual confusion and misunderstanding as to the source of Champion Window's services. Champion Window's acts thus constitute deceptive trade practices under the Uniform Trade Practices Act, 815 Ill. Comp. Stat. 510/2.

92. Champion Roofing has suffered, and will continue to suffer, substantial injuries, loss, and damage to its business as a direct and proximate result of Champion Window's

deceptive trade practices.

93. As a direct and proximate result of Champion Window's knowing, deliberate, and willful deceptive trade practices, Champion Roofing has suffered, and will continue to suffer, irreparable injury to its business, reputation, and goodwill, unless and until Champion Window's actions as alleged herein are preliminarily and permanently enjoined.

94. Based on the willful nature of Champion Window's unlawful conduct, this is an exceptional case, entitling Champion Roofing to an award its reasonable costs and attorneys' fees pursuant to 815 Ill. Comp. Stat. 510/3.

**SIXTH CLAIM FOR RELIEF**  
Against all Defendants  
Common Law Unfair Competition

95. Champion Roofing hereby incorporates each of the preceding paragraphs as if fully set forth herein.

96. Champion Window has unlawfully offered roofing services under the "Champion" name in violation of Champion Roofing's rights in the CHAMPION ROOFING Mark, thereby usurping Champion Roofing's goodwill and business reputation through unfair methods. Thus, Champion Window's conduct constitutes unfair competition, in violation of the common law.

97. Champion Window has willfully engaged in unfair competition with a bad faith intent to injure Champion Roofing. Champion Window's unauthorized use of the "Champion" name in connection with roofing services is likely to cause, and has actually caused, confusion, mistake, or deception as to the source, origin, sponsorship, or affiliation of Champion Window's services and products.

98. Champion Roofing has suffered, and will continue to suffer, substantial injuries,



loss, and damage to its business as a direct and proximate result of Champion Window's unfair competition.

99. As a direct and proximate result of Champion Window's unfair competition, Champion Roofing has suffered damages in an amount that will be shown at trial.

100. As a direct and proximate result of Champion Window's unfair competition, Champion Roofing is entitled to disgorgement of Champion Window's profits flowing from its unfair practices as well as an award of corrective advertising to alleviate existing confusion resulting from Champion Window's unlawful use of the "Champion" name in connection with roofing services.

101. Based on the willful nature of Champion Window's unlawful conduct, this is an exceptional case, entitling Champion Roofing to an award of treble damages, prejudgment interest, and its reasonable attorneys' fees.

102. As a direct and proximate result of Champion Window's knowing, deliberate, and willful actions and unfair competition, Champion Roofing has suffered, and will continue to suffer, irreparable injury to its business, reputation, and goodwill, unless and until Champion Window's actions as alleged herein are preliminarily and permanently enjoined.

#### **PRAYER FOR RELIEF**

Therefore, Champion Roofing prays for judgment as follows:

- A. A preliminary and a permanent injunction restraining Defendants, their officers, agents, servants, employees, and attorneys, and those persons acting in concert with Defendants, and each of them, from:
- (i) using the "Champion" name or any other mark that is confusingly similar to the CHAMPION ROOFING Mark in connection with roofing services

- in the Chicagoland Area;
- (ii) directly or indirectly infringing Champion Roofing's Lanham Act, Illinois Trademark Registration and Protection Act, and common law rights in the CHAMPION ROOFING Mark;
  - (iii) making any commercial use of the "Champion" name in connection with roofing services in the Chicagoland Area;
  - (iv) using the "Champion" name in connection with the advertising or offering of any roofing services on the Internet where such advertising or offerings are either directed to or made available to consumers in the Chicagoland Area;
  - (v) engaging in any deceptive trade practices involving the "Champion" name; and
  - (vi) unfairly competing with Champion Roofing in any manner whatsoever.
- B. Requiring Champion Window to account for and pay over to Champion Roofing the profits realized by Champion Window from its infringing acts, and trebling such amounts pursuant to 15 U.S.C. § 1117(a) and 765 Ill. Comp. Stat. 1036/70;
- C. Awarding Champion Roofing its actual damages arising out of Champion Window's infringing acts, and trebling such amounts pursuant to 15 U.S.C. § 1117(a) and 765 Ill. Comp. Stat. 1036/70;
- D. Awarding Champion Roofing a sum sufficient to cover the cost of reasonable past and future corrective advertising to address any existing confusion or future confusion resulting from Champion Window's unauthorized use of the "Champion" name in connection with roofing services in the Chicagoland Area;

- E. Awarding Champion Roofing its actual costs of suit and reasonable attorneys' fees pursuant to 15 U.S.C. § 1117(a) and 765 Ill. Comp. Stat. 1036/70; and
- F. Awarding Champion Roofing such further and other relief as is lawful, just or equitable.

**JURY DEMAND**

Champion Roofing hereby demands a trial by jury on all issues so triable.

Dated: July 31, 2013

Respectfully submitted,

s/ James J. Saul  
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