Trademark Trial and Appeal Board Electronic Filing System. https://estta.uspto.gov

ESTTA Tracking number: **ESTTA1284095**

Filing date: **05/10/2023**

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

Petition for Cancellation

Notice is hereby given that the following parties has filed a petition to cancel the registration indicated below.

Petitioner information

Name	Matos Insurance Agency, Inc.		
Entity	Corporation	Citizenship	Florida
Address	5448 HOFFNER AVENUE SUITE 403 ORLANDO, FL 32812 UNITED STATES		

Name	Armando J Matos		
Entity	Individual	Citizenship	UNITED STATES
Address	5448 HOFFNER AVENUE SUITE 403 ORLANDO, FL 32812 UNITED STATES		

Attorney information	MARC ALEXANDER RAPAPORT COLE, SCOTT & KISSANE, P.A. 9150 S. DADELAND BLVD. SUITE 1400 MIAMI, FL 33156 UNITED STATES Primary email: marc.rapaport@csklegal.com Secondary email(s): edward.polk@csklegal.com, danise.townsend@csklegal.com, karen.george@csklegal.com 7862686793
Docket no.	

Registration subject to cancellation

Registration no.	6209276	Registration date	12/01/2020
Register	Principal		
Registrant	Mattos Insurance, Inc. 569 EAST SAMPLE ROAD POMPANO BEACH, FL 33064 UNITED STATES		

Goods/services subject to cancellation

Class 036. First Use: Jul 7, 2009 First Use In Commerce: Jul 7, 2009 All goods and services in the class are subject to cancellation, namely: Insurance agency and brokerage

Grounds for cancellation

The mark is merely descriptive	Trademark Act Sections 14(1) and 2(e)(1)
The mark is or has become generic	Trademark Act Section 14(3)
The mark is primarily merely a surname	Trademark Act Sections 14(1) and 2(e)(4)
The mark is not inherently distinctive and has not acquired distinctiveness	Trademark Act Sections 14(1) and 1,2 and 45; and Section 2(f)

Related proceedings	Mattos Insurance, Inc. v. Jose Matos Armando and Matos Insurance Agency, Inc., Case No.: 0:22-cv- 62075-AHS, in the United States District Court Southern District of Florida

Attachments	Petition to Cancel - Matos v. Mattos.pdf(96945 bytes) Exhibit 1 Complaint.pdf(934726 bytes) Exhibit 2 Answer.pdf(186277 bytes) Exhibit 3 corporate filing.pdf(320918 bytes) Exhibit 4 Nonfinal Office Action.pdf(2923029 bytes) Exhibit 5 Response to Nonfinal Off.pdf(378328 bytes) Exhibit 6 Registration.pdf(50763 bytes)

Signature	/Marc Alexander Rapaport/
Name	Marc Alexander Rapaport
Date	05/10/2023

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

Registration No.:	**6209276**
Mark:	**MATTOS INSURANCE**
Registered:	**December 1, 2020**
Class:	**036**

MATOS INSURANCE AGENCY, INC.,
ARMANDO JOSE MATOS)
)
Petitioner,)
)
v.)
)
MATTOS INSURANCE, INC.)
)
Respondent.)

PETITION TO CANCEL

Pursuant to Trademark Act §2(e)[1], Petitioner Matos Insurance Agency, Inc., files its Petition to Cancel Respondent's federal trademark registration for MATTOS INSURANCE, registered on December 1, 2020, Registration No. 6209276, because the mark should have initially been prevented registration. Specifically, Respondent's mark is merely descriptive and is primarily merely a surname coupled with a generic term. *See Id.* at (e)(1), (e)(4). Petitioners believe they will be damaged by continued registration of the mark "MATTOS INSURANCE" in light of the pending federal court litigation brough by Respondent on November 9, 2022, in the United States District Court Southern District of Florida, wherein Respondent attempts to assert its purported trademark rights against Petitioners for monetary damages and other relief – which Petitioners

[1] 15. U.S.C. 1052(e)

disputes in its entirety. *See Mattos Insurance, Inc. v. Jose Matos Armando*[2] *and Matos Insurance Agency, Inc.*, Case No.: 0:22-cv-62075-AHS. See attached Complaint, Exhibit "1". Respondent has asserted claims against Petitioners in the federal court litigation for trademark infringement, dilution, domain name infringement, unfair competition and injunction. Respondent, in its Answer to the federal court Complaint, asserted as an affirmative defense challenging the validity of the mark, including that Respondent's mark was subject to cancellation before the USPTO for the reasons now asserted in this Petition. See attached Answer and Affirmative Defenses, Exhibit "2".

1. Petitioner, Matos Insurance Agency, Inc., is a Florida profit corporation with its principal place of business located at 5448 Hoffner Avenue, Suite 403, Orlando, Florida 32812. Petitioner has been in business since 2018. Petitioner is in the business of selling insurance.

2. Petitioner, Armando Jose Matos is a resident of the State of Florida and the owner of Matos Insurance Agency, Inc, with an address of 5448 Hoffner Avenue, Suite 403, Orlando, Florida 32812. Petitioner's business name, as described in Paragraph 1, utilizes Petitioner's surname.

3. Respondent, Mattos Insurance, Inc., is a Florida profit corporation with its principal place of business located at 569 East Sample Road, Pompano Beach, Florida 33064. The business was incorporated on July 7, 2009, by Marcelo and Deborah Mattos as President/Secretary and Vice President/Treasurer, respectively. See corporate filing, Exhibit "3". Respondent's business name and the mark at issue is apparently the surname of the originators of the business. Respondent is in the business of selling insurance.

4. Respondent filed its application for MATTOS INSURANCE on February 15, 2020 under class 036 for "Insurance agency and brokerage".

[2] The style to Respondent's federal case misnamed the individual Petitioner. This was noted in Petitioners' Answer in the federal litigation.

5. The listed attorney correspondence for Respondent's Registration, 6209276, is Ross D. Kulberg, whose last known contact information (per Florida Bar website) is Pathman Schermer Tandy, LLP, One Biscayne Tower, Suite 2400, 2 S Biscayne Blvd, Miami, FL 33131-1806, email: rkulberg@pst.law

6. On April 30, 2020, the USPTO issued a Nonfinal Office Action to Respondent during the application phase of its mark, wherein the USPTO challenged the registration of Respondent's mark on the basis that it was primarily merely a surname. The USPTO was correct in noting that the surname in Respondent's mark is the primary significance of the mark as a whole to the purchasing public and, when coupled with a generic term such as insurance, this does not "detract from the primary surname significance" of the mark. See Nonfinal Office Action, attached hereto as Exhibit "4" (quoting *Azeka Bldg. Corp. v. Azeka*, 122 USPQ2d 1477, 1481-82, 1481 n.9 (TTAB 2017) (construing *In re Hutchinson Tech. Inc.*, 852 F.2d 552, 554, 7 USPQ2d 1490, 1492-93 (Fed. Cir. 1988)); see TMEP §1211.01(b)(vi).).

7. The Nonfinal Office Action expressly notes that "[s]pecifically, applicant provides insurance agency/brokerage services. Therefore the term INSURANCE is considered generic in relation to the services and does not detract from the primary surname significance of the mark." Nonfinal Office Action.

8. Respondent attempted, and was apparently successful, in overcoming the Nonfinal Office Action by submitting a Declaration of Tiago M. Manguiera which declares that MATTOS INSURANCE has become distinctive through Respondent's substantially and exclusive and continuous use in commerce since at least 2009. See Response to Nonfinal Office Action and Declaration, attached hereto as Exhibit "5".

9. On December 1, 2020, Respondent's mark was registered on the Principal Register under class 036. See Registration, attached hereto as Exhibit "6".

10. However, the Declaration described in Paragraph 5 should not have overcome the USPTO's refusal because even in light of the declaration that the mark has acquired distinctiveness, the mark as a whole remains generic. The mark is composed simply of the last name of the owners of the company, coupled with the term "insurance" which, in other words, is literally "insurance provided by Mattos". There can be no acquired distinctiveness for such a generic mark.

11. The reference to use in commerce for five (5) years may have provided Respondent with a presumption of distinctiveness, but does not automatically ensure a sufficient level for registration on the Principal Register. Responded submitted no other evidence to support the notion that its mark acquired distinctiveness, including actual evidence showing the duration, extent and nature of use of a mark. The Declaration also fails to declare that for those five years, the substantial and exclusive continuous use of MATTOS INSURANCE was "as a mark". " 15 U.S.C. §1052(f); *see In re Craigmyle*, 224 USPQ 791, 793 (TTAB 1984) (finding registrability under §2(f) not established by sales over a long period of time where there was no evidence that the subject matter had been used as a mark); In re Kwik Lok Corp., 217 USPQ 1245, 1248 (TTAB 1983) (holding declarations as to sales volume and advertising expenditures insufficient to establish acquired distinctiveness. "The significant missing element in appellant's case is evidence persuasive of the fact that the subject matter has been used as a mark.").

12. Section 2(f) of the Act and 37 C.F.R. §2.41(a)(2) state that reliance on a claim of five years' use to establish acquired distinctiveness "may" be acceptable in "appropriate cases." The USPTO may, at its option, require additional evidence of distinctiveness. *In re La. Fish Fry*

Prods., Ltd., 797 F.3d 1332, 1336-37, 116 USPQ2d 1262, 1265 (Fed. Cir. 2015) (noting that the statute does not require the USPTO to accept five years' use as prima facie evidence of acquired distinctiveness). Whether a claim of five years' use will be deemed sufficient to establish that the mark has acquired distinctiveness depends largely on the nature of the mark in relation to the specified goods, services, or classes. Trademark Manual of Examining Procedure § 1212.05.

13. Because Respondent's mark is not inherently distinctive due to its nature, and is indeed at the most merely descriptive (actually describes the product being sold by Mattos), Respondent should have been required to provide actual evidence that the mark is perceived as a mark for the relevant goods, services, or classes would be required to establish distinctiveness and/or secondary meaning. *See generally In re Owens-Corning Fiberglas Corp.*, 774 F.2d 1116, 227 USPQ 417 (Fed. Cir. 1985).

14. A mark is merely descriptive "if it immediately conveys knowledge of a quality, feature, function, or characteristic of the goods or services with which it is used." *In re Chamber of Commerce of the United States of America*, 675 F.3d 1297, 102 USPQ2d 1217, 1219 (Fed. Cir. 2012) (quoting *In re Bayer Aktiengesellschaft*, 488 F.3d 960, 82 USPQ2d 1828, 1831 (Fed. Cir. 2007)). The idea must be conveyed with a degree of particularity. *In re TMS Corporation of the Americas*, 200 USPQ 57, 59 (TTAB 1978). Respondent's mark literally describes itself – insurance sold by Mattos. As noted, Respondent attempted to overcome this refusal by proving acquired distinctiveness through a Declaration of continuous use but should have been required to show actual evidence of the perceived nature of the mark because of the heavily descriptive nature of the term as a whole. The Declaration is also deficient because it failed to contain a reference of distinctiveness with actual reference to the applicant's good/services. There is therefore doubt whether the distinctiveness pertains to the goods/services referenced in Respondent's application

or whether it is some other type of good or service. Trademark Manual of Examining Procedure § 1212.05(d).

15. At the very least, Respondent's mark is generic and cannot be registered as a trademark. A generic term is one that the purchasing public understands to be the common name for the goods and services. A proposed mark considered to be generic will not be allowed to register on either the Principal or Supplemental Register. A two-part test is used to determine if a term is generic: (1) what is the class of goods or services at issue and (2) does the relevant public understand the term or designation primarily to refer to that class of goods. *See Sheetz of Delaware, Inc. v. Doctors Associates Inc.*, 108 U.S.P.Q 1341, 2013 WL 5315963 (TTAB 2013), where it was held that the mark FOOTLONG was generic for sandwiches. The Nonfinal Office Action expressly declared that the term "insurance" is generic and this is not in dispute. When a generic term is then coupled with a surname that has not acquired distinctiveness, the consequential substantive effect is that the mark is generic.

WHEREFORE, Petitioners, Matos Insurance Agency, Inc., and Armando Jose Matos, request the Trademark Trial and Appeal Board, upon consideration of the grounds set forth herein, and pursuant to Trademark Act §2(e)(1), (e)(4), cancel Registration No. 6209276 for the reasons stated herein.

Date: May 10, 2023

COLE SCOTT & KISSANE, P.A.
9150 S. Dadeland Blvd., Suite 1400
Miami, Florida 33156

Marc Alexander Rapaport, Esq.
Marc A. Rapaport, Esq.
Florida Bar No. 1008359
Edward S. Polk
Florida Bar No. 239860
Attorneys for Petitioners

IN THE UNITED STATES DISTRICT COURT
FOR THE SOUTHERN DISTRICT OF FLORIDA
BROWARD DIVISION

CASE NO.

MATTOS INSURANCE, INC., a Florida corporation,	)
Plaintiff,	)
v.	)
JOSE MATOS ARMANDO, an individual; MATOS INSURANCE AGENCY, INC. a Florida corporation;	)
Defendants.	)

VERIFIED COMPLAINT

Plaintiff Mattos Insurance, Inc. ("Plaintiff" or "Mattos"), a Florida corporation, doing business in Broward County, Florida, through their undersigned attorneys, files this Verified Complaint against Jose Matos Armando and Matos Insurance Agency, Inc. (collectively, "Defendants"), and alleges as follows:

NATURE OF THE ACTION

1. By this action, Plaintiff seeks to enforce a range of rights including statutory and common law trademark rights relating to Mattos Insurance, Inc. (as defined herein) as they have been used by Plaintiff for approximately thirteen years in connection with insurance sales and other miscellaneous services provided to customers nationwide. In addition, Plaintiff seeks damages against Defendants for unfair competition, dilution of Plaintiff's famous mark and trade name, and injunctive relief. With regards to its trademark, Plaintiff has established extensive use

of, as well as fame in the mark within the state of Florida, New Jersey, Pennsylvania, Texas, South Carolina, North Carolina and across the United States. Since first commencing use of the Mattos Insurance mark (the "Mattos Mark") the Mattos Mark has never fallen abandoned.

2. Plaintiff seeks relief arising from infringing uses by Jose Matos Armando and the Matos Insurance Agency, Inc. mark (the "Infringing Mark") that are confusingly similar to, and which infringe on, Plaintiff's Mattos Mark. Defendants' infringement spans across various contexts in connection with insurance services which are identical in product, purpose and audience/customers, to that of Plaintiff's insurance services.

3. More particularly, Plaintiff seeks to obtain permanent injunctive relief against Defendants, and damages for trademark infringement in violation of Section 1114 of the Trademark Act of the United States, 15 U.S.C. § 1114; for unfair competition and false designations of origin in violation of Section 1125(a) of the Trademark Act of the United States, 15 U.S.C. § 1125(a), Trademark Dilution, 15 U.S.C. § 1125(c), for violations of the Florida Anti-Dilution Statute; and for related acts of unfair competition and trademark infringement actionable under the common law of the United States and the State of Florida.

4. Granting the permanent injunctive relief requested herein will serve the public interest because it is the only way to bar Defendants use of Plaintiff's intellectual property and infringement on Plaintiff's rights, as well as baring Defendants from causing actual confusion in the insurance services industries. Customers and related businesses who recognize and know Plaintiff's Mattos Mark and who rely on their recognition and knowledge of same mark to make decisions about their insurance services, together with those they refer, are at risk of being deceived into purchasing and/or obtaining services provided by Defendants under the mistaken belief that

Defendants are the same company as Plaintiff and thus selling insurance products to Plaintiff's customer who believed Defendants' company was the same as Plaintiff.

5. Granting the injunctive relief requested will serve the public interest by preventing consumer confusion and risking serious damage to Plaintiff's reputation, brands and rights.

JURISDICTION AND VENUE

6. This Court has jurisdiction over the subject matter of this action pursuant to 15 U.S.C. § 1121 (Lanham Act), 28 U.S.C. § 1338(a) (actions arising under an Act of Congress relating to copyrights), 28 U.S.C. § 1331 (federal question), 28 U.S.C. § 1338 (patent, trademark and copyright), and pursuant to 28 U.S.C. § 1367 (supplemental jurisdiction).

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

8. Jurisdiction is proper in this Court pursuant to Florida Statute § 86.011.

9. Venue is appropriate in this Court because the Plaintiff involved in the controversy is a resident of Broward County, Florida, and Defendants are doing business with the Infringing Mark in Florida including in Orange County, Florida, as per Defendants' webpage ("**Exhibit A**") with the knowledge that Plaintiff has been using the Mattos Mark since 2009 in Florida.

THE PARTIES

10. Plaintiff, Mattos Insurance, Inc. is a Florida corporation organized and existing under the laws of the State of Florida, having its principal place of business at 569 East Sample Road, Pompano Beach, Florida 33064. See attached **"Exhibit B"**.

11. Upon information and belief, Defendant Jose Matos Armando ("Armando") is a resident of the State of Florida. Upon information and belief, Defendant Armando is promoting

insurance services in the State of Florida and elsewhere using internet marketing and branding in conjunction with an entity identified as Matos Insurance Agency, Inc. Upon information and belief, Defendant Armando has sold insurance as "Matos Insurance" to customers of the State of Florida.

12. Upon information and belief, Defendant Matos Insurance Agency, Inc. is a Florida corporation organized under the laws of the State of Florida on March 22, 2018. Defendant Armando is the president of Matos Insurance Agency, Inc. (A copy of the Company filing is attached as **"Exhibit C"**).

MATTOS INSURANCE - BACKGROUND

13. Mattos Insurance, Inc. was incorporated in Florida on July 7, 2009, and has been selling insurance products in Florida and throughout the United States since that time. Mattos Insurance has served over eighteen million customers since 2009 and has gained customer recognition in the insurance industry.

14. Mattos Insurance, Inc. currently sells auto, commercial, marine, home, health and life insurance policies as well as traffic school courses, notary and auto renewal services.

15. Since many of Mattos' customers often purchase renewal insurance policies, the Mattos Mark and Plaintiff's name recognition are a valuable part of its business.

THE MARKS

16. Plaintiff is the owner of all rights and interests in the service mark MATTOS INSURANCE (the "Mattos Mark"), which is used for and in connection with the sale of insurance products and related services (the "Mattos Services"). Plaintiff's Mattos Mark is either inherently distinctive or has established secondary meaning by dint of use of the mark in interstate commerce

for well over thirteen years, and due to extensive advertising and promotion thereof.

17. Plaintiff has consistently used the Mattos Mark in word and logo form since 2009 in connection with its services, and the mark has been in constant use since then in connection with the Mattos Services; and Plaintiff has established common law rights therein.

18. Mattos Mark manifests a consistent commercial impression, including where used with the original logo components.

19. Plaintiff holds a registration for the mark Mattos Insurance at Registration No. 6209276 (the "'276 Registration"); such registration is a service mark, used to identify Plaintiff's sales of goods and services in the insurance industry. (A copy of this registration is attached hereto as **"Exhibit D"**).

20. Plaintiff has advertised its insurance business, and related services in the state of Florida and to residents of the state of Florida, as well as throughout the United States.

21. As a result of the fame afforded to Plaintiff's services performed under and pursuant to its Mattos Mark, the mark has achieved fame in the minds of the relevant public, namely consumers in need of insurance services, and those who market and provide goods and services to those individuals and entities. The Mattos Mark is identified with Plaintiff and Plaintiff's services and the mark is famous.

DEFENDANTS' INFRINGING CONDUCT

22. Defendants are infringing on Plaintiff's **Mattos** Mark by advertising and promoting insurance services (the "Infringing Services") as **Matos** Insurance, a name substantially similar to Plaintiff's Mattos Mark.

23. On or about March of 2018, Defendants appear to have created the infringing Matos

Insurance Agency, Inc. seen at Exhibit C (the "Infringing Mark").

24. Defendants' use and marketing of the Infringing Mark in marketing and promotional materials including on Facebook, YouTube and/or on Defendants' website have caused confusion with Plaintiff's mark.

25. The Infringing Mark used by Defendants is confusingly similar to Plaintiff's Mattos Mark.

26. Defendants' advertised services so closely resemble the services provided by Plaintiff under Plaintiff's Mattos Mark - though they are expected to be of lesser quality - that they create a commercial impression that Plaintiff has authorized, licensed, sponsored, or approved of Defendants' marketing, advertising, offering for sale, selling and performance of the Infringing Services in connection with the Infringing Mark.

27. The Infringing Services are identical in concept, purpose and theme to Plaintiff's insurance services offered under the Mattos Mark such as to cause confusion or cause consumers to believe that Plaintiff has authorized or endorsed the quality of the Infringing Services.

28. Upon information and belief, the Infringing Services are advertised and marketed online via Defendants' own websites and pages, printed materials, event sponsorships and/or on YouTube, Facebook and other sites.

29. Defendants have set up a substantially similar Internet site using the Internet domain name "**matosinsurance.com**." From this address, Defendants continuously broadcast information regarding the company and advertises its services to thousands of Internet users, causing confusion with Plaintiff's "**mattosinsurance.com**" domain name and Infringing on Plaintiff's Mattos Mark. It is abundantly clear that Defendants have and will continue to benefit

from the misspelling by customers of Plaintiff's domain name if not prohibited from using the Infringing Mark. See attached **"Exhibit E"**.

30. Defendants offered, and continued, to promote the Infringing Services with the specific intent to trade on Plaintiff's good name as well as the reputation and goodwill of Plaintiff's Mattos Mark, and the fame of Plaintiff's Mattos Mark, in marketing and advertising at, to and in front of the same category of customers as that of Plaintiff.

31. Defendants' infringing conduct is likely to create confusion and deceive consumers into believing that Defendants' Infringing Services and any goods sold or distributed in connection with or separate from said services originate with or are in some way sponsored, endorsed, licensed, associated or otherwise authorized or connected with Plaintiff.

32. Such confusion has irreparably harmed and damaged Plaintiff – and will continue to do so because it has no control over the nature or quality of the services provided or produced by Defendants, and because individuals and those in the trade will believe that Defendants' services are connected with, licensed by or otherwise authorized by Plaintiff.

33. Defendants' infringing conduct is likely to lead to dilution of the distinctive and famous Mattos Mark.

34. Defendants' insurance services are marketed to customers located in the State of Florida, as well as residents of other geographic locations.

35. Therefore, Defendants and Plaintiff are operating in and competing for customers in the same market and market area.

36. Defendants' infringing conduct is knowing, willful, intentional and on-going, and was undertaken in bad faith with the intention to unfairly trade on the goodwill and fame of

Plaintiff's Mattos Mark, a mark established and used by Plaintiff nine years prior to Defendants' mark.

37. Unless Defendants are restrained and enjoined from engaging in the infringing actions described herein, Plaintiff will suffer irreparable injury.

38. Plaintiff is likely to prevail in this matter by virtue of longstanding senior ownership of and rights to the Mattos Mark, and because Plaintiff is suffering irreparable harm by Defendants' infringement of Plaintiff's trademark rights. Public policy favors entry of an injunction that will reduce the likelihood of confusion experienced by potential consumers in the insurance industries.

39. Unless Defendants are restrained and enjoined from engaging in the infringing actions described herein, Plaintiff will suffer irreparable harm. Defendants are not prejudiced by being barred from violating trademark laws and other federal and state unfair competition laws, or from engaging in conduct that is misleading the public.

40. As a consequence of advertising and promotion by Plaintiff on the Internet, social media networks, via newsletters, in newspapers and magazines, and in sponsorship of and participation at industry events, the unique and distinctive marks that comprise the Mattos Mark have become famous and are publicly recognized as being associated with Plaintiff's insurance business and related services.

41. Plaintiff was the first to use the Mattos Mark in South Florida, the State of Florida, and the United States, specifically, in the same market in which Defendants seek to operate. The marks that comprise the Mattos Mark have never fallen abandoned.

42. Plaintiff's Mattos Mark are distinctive and valid, and the ownership of said mark has been and is valid.

COUNT I

Trademark Infringement (15 U.S.C. § 1125(a))

43. Plaintiff hereby incorporates by reference each and every allegation contained in each of the foregoing paragraphs 1-42 as if fully set forth herein.

44. Defendants engaged in infringement of the Mattos Mark from 2018 until present.

45. Plaintiff owns valid trademark rights in and to Plaintiff's '276 Registration, which is entitled to protection under the Lanham Act.

46. Defendants have demonstrated a deliberate intent to trade off the goodwill of Plaintiff's '276 Registration as a means of increasing Defendants' own sales and prominence at the expense of Plaintiff.

47. Defendants' deliberate conduct is likely to result in consumers obtaining Defendants' services in mistaken belief that it originates from Plaintiff. In fact, many of Plaintiff's customers have contacted Plaintiff with questions about the renewal of their insurance policy believed to have been renewed with Plaintiff's company.

48. Customers have been misled into believing that Defendants' company was the same as Plaintiff's company.

49. Defendants' use of a mark which is confusingly similar to Plaintiff's '276 Registration in connection with services that are identical or highly similar in purpose, if not in quality, is likely to cause confusion, mistake, or to deceive as to the affiliation, connection, or association of Defendants with Plaintiff, or as to the origin, sponsorship, or approval of Defendants' services or commercial activities by Plaintiff.

50. Defendants' actions, as set forth, constitute false designation of origin and unfair

competition in violation of the Lanham Act, 15 U.S.C. § 1125(a).

51. Defendants have made and will continue to make substantial profits and/or gains to which they are not entitled due to customer confusion and the similarity to Plaintiff's famous mark.

52. By reason of the foregoing, Plaintiff has been and will continue to be irreparably harmed and damaged. Plaintiff's remedies at law are inadequate to compensate for this harm and damage.

53. On information and belief, Armando was aware of Plaintiff's ownership and rights regarding prior use of the Mattos Mark in advance of Defendants' adoption of the Infringing Marks for use in connection with the Infringing Services. As such, Defendants' use of the Infringing Marks constitutes willful infringement.

54. Plaintiff has been damaged by Defendants' acts in an amount to be determined at trial, and if Defendants' conduct is allowed to manifest, resume and/or continue, Plaintiff and its goodwill and reputation will continue to suffer immediate, substantial and irreparable harm that may not be adequately calculated and compensated in monetary damages.

55. Plaintiff is entitled to monetary damages and injunctive relief prohibiting Defendants from using marks, including any logo mark, which is likely to be confused with Plaintiff's mark, including any trade name, trademark, service mark, user name, corporate name, artwork or domain name that is likely to be confused with Plaintiff's mark or otherwise unfairly competing with Plaintiff. Without preliminary and permanent injunctive relief, Plaintiff has no means by which to control the continuing injury to the reputation and goodwill associated with its Mattos Mark. Money damages may not adequately compensate Plaintiff from damage to its reputation and associated goodwill.

COUNT II

Trademark Dilution (15 U.S.C. § 1125(c))

56. Plaintiff hereby incorporates by reference each and every allegation contained in each of the foregoing paragraphs 1-55 as if fully set forth herein.

57. Based on Plaintiff's national use, publishing, advertising, marketing, and general popularity of its Mattos Mark (the "Famous Mattos Mark"), the Famous Mattos Mark has acquired fame such that the public associates the Famous Mattos Mark with the insurance services of Plaintiff.

58. Plaintiff's marks are famous and distinctive within the meaning of Section 43(c) of the Lanham Act, 15 U.S.C. § 1125(c).

59. Plaintiff's Famous Mattos Mark was famous well before Defendants' use in commerce in connection with its Infringing Services.

60. Plaintiff has not authorized or licensed Defendants' use of any mark similar to the Famous Mattos Mark.

61. Defendants' adoption and commercial use of its Infringing Mark was undertaken knowingly and willfully.

62. By reason of the foregoing, Defendants have engaged in and are continuing to engage in acts damaging to Plaintiff by diluting the distinctive quality of Plaintiff's Famous Mattos Mark in violation of Section 43(c) of the Lanham Act (15 U.S.C. § 1125(c)).

63. Plaintiff has been damaged by Defendants acts in an amount to be determined at trial, and if Defendants' conduct is allowed to manifest, resume and/or continue, Plaintiff's Famous Mattos Mark, as well as its goodwill and reputation will continue to suffer immediate,

substantial and irreparable harm that cannot be adequately calculated and compensated in monetary damages.

64. Plaintiff is entitled to monetary damages and injunctive relief prohibiting Defendants from using any Infringing Mark, and Plaintiff's corporate name, and any other trade name, trademark, service mark, username, logo, design mark, or domain name that is likely to be confused with Plaintiff's mark or otherwise unfairly competing with Plaintiff. Without preliminary and permanent injunctive relief, Plaintiff has no means by which to control the continuing injury to the reputation and goodwill associated with its Famous Mattos Mark. Money damages may not adequately compensate Plaintiff if it suffers damage to its reputation and associated goodwill through the unauthorized use by Defendants of its Infringing Mark.

COUNT III

Dilution Under (Fla. Stat. §495.151)

65. Plaintiff hereby incorporates by reference each and every allegation contained in each of the foregoing paragraphs 1-64, as if fully set forth herein.

66. Plaintiff is the exclusive owner of the distinctive Famous Mattos Mark, which is famous under the requirements of the statute in question.

67. The Famous Mattos Mark is inherently distinctive and has been in use in commerce across many different types of media.

68. The Famous Mattos Mark has gained widespread publicity and public recognition in Florida and elsewhere nationally.

69. Defendants' use of the Famous Mattos Mark in the marketing, advertising, and sale of its Infringing Services dilutes, or is likely to dilute, the distinctive quality of the Famous Mattos

Mark, and to lessen the capacity of the Famous Mattos Mark to identify and distinguish Plaintiff's goods and services.

70. Defendants' unlawful use of the Famous Mattos Mark caused and causes blurring and tarnishment in the minds of the consumers between Plaintiff and the Infringing Mark, thereby lessening the value of the Famous Mattos Mark as a unique identifier of Plaintiff's intellectual property.

71. Defendants began commercial use of the Matos Insurance, Inc. and the Internet domain name "matosinsurance.com" in or about March 22, 2018, which is substantially similar to Plaintiff's "mattosinsurance.com" domain name.

72. Defendants' commercial use of the Infringing mark and the Internet domain name "matosinsurance.com" in connection with its advertising, operation, and maintenance of an Internet site has caused and will continue to cause dilution of the distinctive quality of the Mattos Mark and has tarnished and will continue to tarnish the Mattos Mark in the minds of consumers in violation of 15 U.S.C.A. § 1125(c).

73. Defendants have used the Infringing Mark and the "matosinsurance.com" Internet domain name with the willful intent to trade on Plaintiff's reputation and/or to cause dilution of Plaintiff's Mattos Mark in violation of 15 U.S.C.A. § 1125(c).

74. Defendants willfully intended to trade on Plaintiff's reputation as developed, managed and produced by Plaintiff.

75. Defendants willfully intended to cause dilution of the Famous Mattos Mark in the State of Florida.

76. By the acts described above, Defendants have intentionally and willfully diluted

the distinctive quality of the Famous Mattos Mark and thus the acts of Defendants complained of herein constitute dilution of Plaintiff's Famous Mattos Mark in violation of Florida Code §495.151.

77. Plaintiff has been damaged by Defendants' willful acts in an amount to be determined at trial, and if Defendants' conduct is allowed to manifest, resume and/or continue, Plaintiff and its goodwill and reputation will continue to suffer immediate, substantial and irreparable injury that may not be adequately calculated and compensated in monetary damages.

78. Defendants' actions are in violation of Florida Business and Commerce Code §495.151.

COUNT IV

Trademark and Service Mark Infringement of Plaintiff's Mattos Mark Under Florida Common Law

79. Plaintiff hereby incorporates by reference each and every allegation contained in each of the foregoing paragraphs 1-78 as if fully set forth herein.

80. The Mattos Mark is distinctive. Based on Plaintiff's use, publishing, advertising, marketing and general popularity of the Mattos Mark, the Mattos Mark has acquired secondary meaning so that the public associates with Plaintiff's insurance and related services.

81. Plaintiff has made continuous use of the marks that comprise the Mattos Mark since introducing the Mattos Mark into U.S. Commerce, including the State of Florida, starting no later than July of 2009.

82. Defendants have intentionally and deliberately used the Infringing Mark without Plaintiff's consent or authorization. Defendants' use of the Mattos Mark in connection with the advertising and promotion of its Infringing Services is likely to cause confusion and mistake in the

minds of the public, leading the public to believe that Defendants' Infringing Services and Infringing Mark emanates from or originates with Plaintiff, or that Plaintiff approves of or sponsors, or otherwise associates itself with Defendants, or Defendants' Infringing Services and Infringing Mark. Such confusion manifests as initial interest, confusion, and reverse confusion, in the trade as to the source or sponsorship of the services and is likely to lead the public to believe Plaintiff is in some way connected to Defendants, and is likely to mislead the public to believe they are obtaining genuine services of Plaintiff, thereby injuring that reputation and goodwill and unjustly diverting from Plaintiff to Defendants the benefits arising therefrom.

83. Defendants' actions were committed deliberately, willfully and maliciously, without regard for Plaintiff's property rights with the intent to cause confusion, mistake or deception.

84. Plaintiff has been damaged by Defendants' acts complained of in an amount to be determined at trial, and if Defendants' conduct is allowed to manifest, resume and/or continue, Plaintiff and its goodwill and reputation will continue to suffer immediate, substantial and irreparable injury that may not be adequately calculated and compensated in monetary damages.

85. The acts of Defendants complained of herein constitute infringement in violation of the common law of the State of Florida.

COUNT V

Domain Name Infringement (False Designation of Origin— 15 U.S.C.A. § 1125(a))

86. Plaintiff hereby incorporates by reference each and every allegation contained in each of the foregoing paragraphs 1-85 as if fully set forth herein.

87. Plaintiff is the owner of the trademark "Mattos Insurance, Inc." which has been

registered with the Principal Register of the United States Patent and Trademark Office since 2020. The Mattos Mark has been in exclusive and continuous use by Plaintiff since at least 2009.

88. Plaintiff is well known and has obtained name recognition within the insurance industry.

89. Plaintiff has expended substantial resources in advertising and promoting its services over the past several years. In addition, and because of the Mattos Mark substantial popularity and good will with consumers, Plaintiff has established its insurance services in the minds of consumers as a trusted, dependable company.

90. As part of its marketing strategy, Plaintiff has set up Internet sites for its services which bear the name of "mattosInsurance.com" as part of the Internet domain name.

91. By virtue of the continuous and exclusive use made of the Mattos Mark in connection with the insurance services and related products, the name Mattos Insurance has become associated with Plaintiff's services in the minds of consumers and has come to mean and be understood to be related to Plaintiff and its products. Consumers distinguish Plaintiff's products through the unique Mattos Mark and have come to rely on that name to signify services that are of high quality and are appropriate in the insurance industry.

92. Defendants have set up an Internet site using the Internet domain name "matosinsurance.com" at the Internet address "www.matosinsurance.com". From this address, Defendants continuously broadcasts information regarding the company and advertises its services to thousands of Internet users. Defendants violated Section 43(a) of the Lanham Act, 15 U.S.C.A. § 1125(a), by registering the domain name "matosinsurance.com", and by using the domain name for a commercial purpose.

93. Through its advertising, operation and maintenance of an Internet site, which uses the domain name "matosinsurance.com", Defendants have caused, and if not enjoined will continue to cause, consumers to be confused as to the affiliation, connection or association of Defendants' Internet site with Plaintiff, or as to Plaintiff's sponsorship or approval of Defendants' business or Internet site.

94. Unless enjoined and restrained by order of this Court, the continuing acts of the Defendants will cause Plaintiff irreparable injury, which cannot adequately be compensated by money damages. By reason of the above, Plaintiff is entitled to temporary, preliminary, and permanent injunctive relief, enjoining the Defendants from any use of the domain name "matosinsurance.com" and further compelling Defendants to transfer ownership in the domain name to Plaintiff, or in the alternative for cancellation of the domain name.

COUNT VI

Unfair Competition Under Florida Common Law

95. Plaintiff hereby incorporates by reference and realleges each and every allegation contained in each of the foregoing paragraphs 1-94 above herein.

96. By making unauthorized use in commerce of the Infringing Mark, Defendants are likely to cause confusion, mistake, or deception as to the affiliation or connection of Defendants' mark with that of Plaintiff and as to the sponsorship or approval of Defendants' Infringing Services and Infringing Mark by Plaintiff.

97. The parties are competing in a similar pool for customers.

98. Defendants' marketing, advertising, and offering for sale its Infringing Services causes confusion and mistake, deceives and misleads the purchasing public, and improperly

appropriates to Defendants' the valuable goodwill of Plaintiff.

99. Defendants' marketing and advertising, of its Infringing Mark causes confusion and mistake, deceives and misleads the purchasing public and trades upon Plaintiff's high-quality reputation in connection with the Mattos Mark.

100. By the acts described above, Defendants have intentionally and willfully infringed Plaintiff's Mattos Mark, and deceived consumers into thinking that they are obtaining services provided by Plaintiff in violation of Florida common law.

101. Plaintiff has been damaged by Defendants' acts complained of in an amount to be determined at trial, and if Defendants' conduct is allowed to manifest, resume and/or continue, Plaintiff's goodwill and reputation will continue to suffer immediate, substantial and irreparable injury that cannot be adequately calculated and compensated in monetary damages.

COUNT VII

Unfair Competition (Fla. Stat. §495.131 and 495.161)

102. Plaintiff incorporates herein each and every allegation set forth in Paragraphs 1 through 101, as if fully set forth herein.

103. This cause of action is for unfair competition under Fla. Stat. §§495.131 and 495.161.

104. Plaintiff alleges that Defendants have intentionally and knowingly advertised and offered Defendants' insurance services using marks that are confusingly similar to Plaintiff's Mattos Mark, so as to confuse and deceive customers, potential customers, and the community at large, as to the origin and/or affiliation of Defendants' services, based upon the merit, reputation, and goodwill of Plaintiff.

105. Defendants' unauthorized, deliberate and willful use of Plaintiff's Mattos Mark enable Defendants to compete unfairly with Plaintiff by palming off Defendants' services as those of Plaintiff or otherwise competing unfairly by causing trade name confusion, all to Plaintiff's and the public's irreparable damage.

106. Defendants' acts have irreparably harmed Plaintiff's reputation, severely damaged Plaintiff's goodwill, and upon information and belief, have diverted business and revenue from Plaintiff.

107. Defendants' aforesaid acts have caused and will continue to cause great and irreparable injury to Plaintiff, and unless said acts are restrained by this Court, they will be continued, and Plaintiff will continue to suffer great and irreparable injury.

108. Plaintiff has no adequate remedy at law to prevent further infringement.

109. Defendants' aforesaid actions are willful, wanton and contumacious and as a result thereof, Plaintiff is entitled to an award of punitive damages and attorneys' fees in addition to any other relief this Court deems just and proper.

COUNT VIII

INJUNCTION

110. The Plaintiff realleges paragraphs 1 through 109 as if fully pled herein.

111. The Plaintiff is suffering irreparable harm.

112. The Plaintiff has a clear legal right to the subject trademarks including the Mattos Mark.

113. Plaintiff has no adequate remedy at law as to certain damages it suffered and continues to suffer.

114. The public interest will be served by the issuance of an injunction.

JURY DEMAND

115. Plaintiff demands a trial by jury on all issues so triable as of right.

PRAYER FOR RELIEF

WHEREFORE, Plaintiff demands:

A. For judgment that:

i. Defendants have violated Section 43(a) of the Lanham Act, 15 U.S.C. §1125(a);

ii. Defendants have violated Section 43(c) of the Lanham Act, 15 U.S.C. §1125(c);

iii. Defendants have engaged in unlawful dilution in violation of Florida Code §495.151.

iv. Defendant is engaged in unfair competition under the common law of the State of Florida;

v. Defendants have caused dilution to Plaintiff's Mattos Mark in violation of the common law of the State of Florida;

B. That Defendants, individually and collectively, as well as their agents, servants, employees, licensees, sponsors, associates, and attorneys, and all persons acting by, through, or in active concert with any of them, be preliminarily and permanently enjoined:

i. From using in any manner and on any platform or in any media any name or mark confusingly similar to any of Plaintiff's Mattos Mark, domain

name, designs or slogans;

ii. From committing any other act which falsely represents or which has the effect of falsely representing that the goods or services of the Defendant are licensed, authorized by, or in any way associated with Plaintiff;

iii. From otherwise infringing the Mattos Mark;

iv. From otherwise unfairly competing with Plaintiff;

v. From otherwise diluting or tarnishing the Mattos Mark and Plaintiff's business reputation;

vi. From interfering with Plaintiff's contractual relations with any third party;

vii. From registering or holding any registration for any mark containing any formative found in Plaintiff's Mattos Mark within the State of Florida or in any other state, country or trademark registration office.

C. That Defendants account to Plaintiff for all revenue, gains, profits and advantages derived from Defendants' wrongful acts;

D. That Plaintiff recovers from Defendants all of Plaintiff's damages, including lost profits, sustained by Plaintiff as a result of Defendants' wrongful acts, and such other compensatory damages as the Court determines to be fair and appropriate, pursuant to 15 U.S.C. § 1117(a) and Florida law;

E. That Plaintiff be awarded all available costs, disbursements and attorneys' fees incurred by Plaintiff in bringing this claim, pursuant to 15 U.S.C. § 1117 and Florida law, and actual and punitive damages to the full extent available under common law; and

F. Such other and further relief as this Court may deem just and proper.

Respectfully submitted,

PATHMAN SCHERMER TANDY, LLP
Counsel for Plaintiff
One Biscayne Tower, Suite 2400
Two S. Biscayne Boulevard
Miami, Florida 33131
Telephone: (305) 379-2425
Facsimile: (305) 379-2420

By: */s/ Aaron W. Tandy*
AARON TANDY
Fla. Bar No. 190144

Verification

I, Tiago Mangueira hereby swear and affirm that I have reviewed the information contained in this Verified Complaint and all exhibits thereof, and that the information herein is true and correct to the best of my knowledge.

Tiago Mangueira, Vice-President
Mattos Insurance, Inc.
569 East Sample Road
Pompano Beach, FL 33064

County of BROWARD
State of Florida

This Verified Complaint for Trademark Infringement was sworn to and subscribed before me this 20 day of October, 2022 by TIAGO MANGUEIRA who is personally known or has produced a FL-DL as identification.

License Number M526 813 87 045 1.

NOTARY PUBLIC
My commission expires: 03/22/25

Notary Public State of Florida
Suzan Veras Souza
My Commission HH 107225
Expires 03/22/2025

[Notary Stamp]

CERTIFICATE OF SERVICE

I HEREBY CERTIFY that I electronically filed on November 8, 2022, the foregoing with the Clerk of the Court using the CM/ECF system, which will send notification of such filing to all persons registered for this case, including all opposing counsel.

By: Aaron W. Tandy
Aaron Tandy

UNITED STATES DISTRICT COURT
SOUTHERN DISTRICT OF FLORIDA

CASE NO.: 22-cv-62075-AHS

MATTOS INSURANCE, INC.,
a Florida corporation

Plaintiff,

v.

JOSE MATOS ARMANDO an individual;
MATOS INSURANCE AGENCY, INC., a
Florida corporation

Defendants.

_____/

DEFENDANT'S ANSWER AND AFFIRMATIVE DEFENSES

Defendants Armando Jose Matos[1] and Matos Insurance Agency, Inc., respond to Plaintiff's Verified Complaint.

NATURE OF THE ACTION

1. Paragraph 1 of the Verified Complaint is a summary of what Plaintiff is seeking in this action and contains a brief history of Plaintiff's purported use of the marks. Defendants are without sufficient information to admit to the truth of the allegations as it pertains to the history of Plaintiff's marks or Plaintiff's use of it own marks and therefore denies those allegations. Defendants further deny that Plaintiff is entitled to any of the relief in which it seeks herein.

2. Paragraph 2 of the Verified Complaint is denied.

3. Paragraph 3 of the Verified Complaint is a recitation of Plaintiff's claims. Defendant denies Plaintiff is entitled to any such recovery for said claims.

[1] Plaintiff incorrectly named the individual Defendant in this case.

4. Paragraph 4 of the Verified Complaint is denied.

5. Paragraph 5 of the Verified Complaint is denied.

JURISDICTION AND VENUE

6. Defendants admit this Court ha subject matter jurisdiction but denies Plaintiff is entitled to relief for any of its asserted claims.

7. Paragraph 7 of the Verified Complaint is denied.

8. Paragraph 8 of the Verified Complaint is denied.

9. Paragraph 9 of the Verified Complaint is denied.

THE PARTIES

10. Defendants are without sufficient information to admit to the truth of the allegations in Paragraph 10 of the Verified Complaint and therefore denies those allegations.

11. Defendant denies it engages in business outside the State of Florida. The remaining allegations of Paragraph 11 are admitted.

12. Paragraph 12 of the Verified Complaint is admitted.

MATTOS INSURANCE - BACKGROUND

13. Defendants are without sufficient information to admit to the truth of the allegations in Paragraph 13 of the Verified Complaint and therefore denies those allegations.

14. Defendants are without sufficient information to admit to the truth of the allegations in Paragraph 14 of the Verified Complaint and therefore denies those allegations.

15. Defendants are without sufficient information to admit to the truth of the allegations in Paragraph 15 of the Verified Complaint and therefore denies those allegations.

THE MARKS

COLE, SCOTT & KISSANE, P.A.
COLE, SCOTT & KISSANE BUILDING - 9150 SOUTH DADELAND BOULEVARD - SUITE 1400 - P.O. BOX 569015 - MIAMI, FLORIDA 33256 - (305) 350-5300 - (305) 373-2294 FAX

16. Defendants are without sufficient information to admit to the truth of the allegations in Paragraph 16 of the Verified Complaint at pertains to Plaintiffs rights in the mark and therefore denies those allegations. Defendants deny that Plaintiff's marks are inherently distinctive or have established secondary meaning. Plaintiff's mark is not incontestable and is therefore subject to a cancellation proceeding.

17. Defendants are without sufficient information to admit to the truth of the allegations in Paragraph 17 of the Verified Complaint and therefore denies those allegations.

18. Paragraph 18 of the Verified Complaint is denied.

19. Defendants are without sufficient information to admit to the truth of the allegations in Paragraph 19 of the Verified Complaint and therefore denies those allegations.

20. Defendants are without sufficient information to admit to the truth of the allegations in Paragraph 20 of the Verified Complaint and therefore denies those allegations.

21. Paragraph 21 of the Verified Complaint is denied.

DEFENDANTS' INFRINGING CONDUCT

22. Paragraph 22 of the Verified Complaint is denied.

23. Paragraph 23 of the Verified Complaint is denied.

24. Paragraph 24 of the Verified Complaint is denied.

25. Paragraph 25 of the Verified Complaint is denied.

26. Paragraph 26 of the Verified Complaint is denied.

27. Paragraph 27 of the Verified Complaint is denied.

28. Paragraph 28 of the Verified Complaint is denied.

29. Paragraph 29 of the Verified Complaint is denied.

30. Paragraph 30 of the Verified Complaint is denied.

COLE, SCOTT & KISSANE, P.A.
COLE, SCOTT & KISSANE BUILDING - 9150 SOUTH DADELAND BOULEVARD - SUITE 1400 - P.O. BOX 569015 - MIAMI, FLORIDA 33256 - (305) 350-5300 - (305) 373-2294 FAX

31. Paragraph 31 of the Verified Complaint is denied.

32. Paragraph 32 of the Verified Complaint is denied.

33. Paragraph 33 of the Verified Complaint is denied.

34. Paragraph 34 of the Verified Complaint is denied.

35. Paragraph 35 of the Verified Complaint is denied.

36. Paragraph 36 of the Verified Complaint is denied.

37. Paragraph 37 of the Verified Complaint is denied.

38. Paragraph 38 of the Verified Complaint is denied.

39. Paragraph 39 of the Verified Complaint is denied.

40. Paragraph 40 of the Verified Complaint is denied.

41. Defendants are without sufficient information to admit to the truth of the allegations in Paragraph 41 of the Verified Complaint and therefore denies those allegations.

42. Paragraph 42 of the Verified Complaint is denied.

COUNT I

Trademark Infringement (15 U.S.C. 1125(a)

43. Defendants incorporate their responses to Paragraphs 1-42 as if fully set forth herein.

44. Paragraph 44 of the Verified Complaint is denied.

45. Paragraph 45 of the Verified Complaint is denied.

46. Paragraph 46 of the Verified Complaint is denied.

47. Paragraph 47 of the Verified Complaint is denied.

48. Paragraph 48 of the Verified Complaint is denied.

49. Paragraph 49 of the Verified Complaint is denied.

COLE, SCOTT & KISSANE, P.A.
COLE, SCOTT & KISSANE BUILDING - 9150 SOUTH DADELAND BOULEVARD - SUITE 1400 - P.O. BOX 569015 - MIAMI, FLORIDA 33256 - (305) 350-5300 - (305) 373-2294 FAX

50. Paragraph 50 of the Verified Complaint is denied.

51. Paragraph 51 of the Verified Complaint is denied.

52. Paragraph 52 of the Verified Complaint is denied.

53. Paragraph 53 of the Verified Complaint is denied.

54. Paragraph 54 of the Verified Complaint is denied.

55. Paragraph 55 of the Verified Complaint is denied.

WHEREFORE, Defendants demand judgment against Plaintiff and in its favor as to Count I of the Complaint, for costs, attorneys fees should this Court deem this to be an "exceptional case" pursuant to 15 U.S.C. § 1117(a) and for any other and further relief this Court deems just and proper.

COUNT II

Trademark Dilution (15 U.S.C. § 1125(c)

56. Defendants incorporate their responses to paragraphs 1-42 of the Verified Complaint as if fully set forth herein.

57. Paragraph 57 of the Verified Complaint is denied.

58. Paragraph 58 of the Verified Complaint is denied.

59. Paragraph 59 of the Verified Complaint is denied.

60. Paragraph 60 of the Verified Complaint is denied.

61. Paragraph 61 of the Verified Complaint is denied.

62. Paragraph 62 of the Verified Complaint is denied.

63. Paragraph 63 of the Verified Complaint is denied.

64. Paragraph 64 of the Verified Complaint is denied.

COLE, SCOTT & KISSANE, P.A.
COLE, SCOTT & KISSANE BUILDING - 9150 SOUTH DADELAND BOULEVARD - SUITE 1400 - P.O. BOX 569015 - MIAMI, FLORIDA 33256 - (305) 350-5300 - (305) 373-2294 FAX

WHEREFORE, Defendants demand judgment against Plaintiff and in its favor as to Count II of the Complaint, for costs, attorneys fees should this Court deem this to be an "exceptional case" pursuant to 15 U.S.C. § 1117(a) and for any other and further relief this Court deems just and proper.

COUNT III

Dilution under (Fla. Stat. §495.151)

65. Defendants incorporate their responses to paragraphs 1-42 of the Verified Complaint as if fully set forth herein.

66. Paragraph 66 of the Verified Complaint is denied.

67. Paragraph 67 of the Verified Complaint is denied.

68. Paragraph 68 of the Verified Complaint is denied.

69. Paragraph 69 of the Verified Complaint is denied.

70. Paragraph 70 of the Verified Complaint is denied.

71. Paragraph 71 of the Verified Complaint is denied.

72. Paragraph 72 of the Verified Complaint is denied.

73. Paragraph 73 of the Verified Complaint is denied.

74. Paragraph 74 of the Verified Complaint is denied.

75. Paragraph 75 of the Verified Complaint is denied.

76. Paragraph 76 of the Verified Complaint is denied.

77. Paragraph 77 of the Verified Complaint is denied.

78. Paragraph 78 of the Verified Complaint is denied.

COLE, SCOTT & KISSANE, P.A.
COLE, SCOTT & KISSANE BUILDING - 9150 SOUTH DADELAND BOULEVARD - SUITE 1400 - P.O. BOX 569015 - MIAMI, FLORIDA 33256 - (305) 350-5300 - (305) 373-2294 FAX

WHEREFORE, Defendants demand judgment against Plaintiff and in its favor as to Count III of the Complaint, for costs, attorneys fees and for any other and further relief this Court deems just and proper.

COUNT IV

Trademark and Service Mark Infringement of Plaintiff's Mattos Mark Under Florida Common Law

79. Defendants incorporate their responses to paragraphs 1-42 of the Verified Complaint as if fully set forth herein.

80. Paragraph 80 of the Verified Complaint is denied.

81. Paragraph 81 of the Verified Complaint is denied.

82. Paragraph 82 of the Verified Complaint is denied.

83. Paragraph 83 of the Verified Complaint is denied.

84. Paragraph 84 of the Verified Complaint is denied.

85. Paragraph 85 of the Verified Complaint is denied.

WHEREFORE, Defendants demand judgment against Plaintiff and in its favor as to Count IV of the Complaint, for costs and for any other and further relief this Court deems just and proper.

COUNT V

Domain Name Infringement (False Designation of Origin – 15 U.S.C.A. § 1125(a)

86. Defendants incorporate their responses to paragraphs 1-42 of the Verified Complaint as if fully set forth herein.

87. Defendants are without sufficient information to admit to the truth of the allegations in Paragraph 87 of the Verified Complaint and therefore denies those allegations.

88. Paragraph 88 of the Verified Complaint is denied.

COLE, SCOTT & KISSANE, P.A.
COLE, SCOTT & KISSANE BUILDING - 9150 SOUTH DADELAND BOULEVARD - SUITE 1400 - P.O. BOX 569015 - MIAMI, FLORIDA 33256 - (305) 350-5300 - (305) 373-2294 FAX

89. Paragraph 89 of the Verified Complaint is denied.

90. Paragraph 90 of the Verified Complaint is denied.

91. Paragraph 91 of the Verified Complaint is denied.

92. Paragraph 92 of the Verified Complaint is denied.

93. Paragraph 93 of the Verified Complaint is denied.

94. Paragraph 94 of the Verified Complaint is denied.

WHEREFORE, Defendants demand judgment against Plaintiff and in its favor as to Count V of the Complaint, for costs, attorneys fees should this Court deem this to be an "exceptional case" pursuant to 15 U.S.C. § 1117(a) and for any other and further relief this Court deems just and proper

COUNT VI

Unfair Competition under Florida Common Law

95. Defendants incorporate their responses to paragraphs 1-42 of the Verified Complaint as if fully set forth herein.

96. Paragraph 96 of the Verified Complaint is denied.

97. Paragraph 97 of the Verified Complaint is denied.

98. Paragraph 98 of the Verified Complaint is denied.

99. Paragraph 99 of the Verified Complaint is denied.

100. Paragraph 100 of the Verified Complaint is denied.

101. Paragraph 101 of the Verified Complaint is denied.

WHEREFORE, Defendants demand judgment against Plaintiff and in its favor as to Count VI of the Complaint, for costs and for any other and further relief this Court deems just and proper.

COUNT VII

Unfair Competition (Fla. Stat. §495.131 and 495.161)

102. Defendants incorporate their responses to paragraphs 1-42 of the Verified Complaint as if fully set forth herein.

103. Defendant admits Plaintiff is attempting to assert a claim for unfair competition but denies Plaintiff is entitled to any such recovery.

104. Paragraph 104 of the Verified Complaint is denied.

105. Paragraph 105 of the Verified Complaint is denied.

106. Paragraph 106 of the Verified Complaint is denied.

107. Paragraph 107 of the Verified Complaint is denied.

108. Paragraph 108 of the Verified Complaint is denied.

109. Paragraph 109 of the Verified Complaint is denied.

WHEREFORE, Defendants demand judgment against Plaintiff and in its favor as to Count VII of the Complaint, for costs, attorneys fees and for any other and further relief this Court deems just and proper.

COUNT VIII

INJUNCTION

110. Defendants incorporate their responses to paragraphs 1-42 of the Verified Complaint as if fully set forth herein.

111. Paragraph 111 of the Verified Complaint is denied.

112. Paragraph 112 of the Verified Complaint is denied.

113. Paragraph 113 of the Verified Complaint is denied.

114. Paragraph 114 of the Verified Complaint is denied.

COLE, SCOTT & KISSANE, P.A.
COLE, SCOTT & KISSANE BUILDING - 9150 SOUTH DADELAND BOULEVARD - SUITE 1400 - P.O. BOX 569015 - MIAMI, FLORIDA 33256 - (305) 350-5300 - (305) 373-2294 FAX

WHEREFORE, Defendants demand judgment against Plaintiff and in its favor as to Count VIII of the Complaint, for costs, attorneys fees and for any other and further relief this Court deems just and proper.

GENERAL DENIAL

115. All allegations not expressly admitted herein are denied.

PLAINTIFF'S CLAIMS FOR PUNITIVE DAMAGES MUST BE STRICKEN

116. In Count VII, Plaintiff seeks punitive damages pursuant to § 495.131 and 495.161. Said statutes do not expressly allow for an award of punitive damages. §768.72, Fla. Stat., provides that "[i]n any civil action, no claim for punitive damages shall be permitted unless there is a reasonable showing by evidence in the record or proffered by the claimant which would provide a reasonable basis for recovery of such damages." Plaintiff also seeks punitive damages "to the full extent available under common law" in the WHEREFORE clause on p. 21. Such a plea is in direct violation of §768.72 and must be stricken unless and until Plaintiff makes the appropriate proffer to the Court.

AFFIRMATIVE DEFENSES

117. As a first affirmative defense, Plaintiff's claims are barred by the doctrine of laches because Plaintiff unreasonably delayed before filing its claimed despite being fully aware of Defendants' actions, and Defendant has been severely prejudiced by this claim. Specifically, Plaintiff claims that it has known of Defendant's infringing conduct since "on or about March of 2018". The Verified Complaint was filed on November 8, 2022, which is over four (4) years after the infringing activity apparently became known to Plaintiff. "[The] delay in bringing trademark or trade dress infringement action is to be measured, for laches purposes, from time at which plaintiff knows or should know she has provable claim for infringement. Kason Indus., Inc. v.

COLE, SCOTT & KISSANE, P.A.
COLE, SCOTT & KISSANE BUILDING - 9150 SOUTH DADELAND BOULEVARD - SUITE 1400 - P.O. BOX 569015 - MIAMI, FLORIDA 33256 - (305) 350-5300 - (305) 373-2294 FAX

Component Hardware Group, Inc., 120 F.3d 1199 (11th Cir. 1997). Furthermore, each of Plaintiff's Florida state law claims provide a statute of limitations of four (4) years. Accordingly, each of Plaintiff's claims must be dismissed pursuant to the doctrine of laches. Plaintiff knew of defendant's use of the mark for over four years; Plaintiff's delay in bringing suit is inexcusable; and Defendant has been severely prejudiced by the delay.

118. As a second affirmative defense, Plaintiff's Verified Complaint must be dismissed as an impermissible shotgun pleading. Shotgun pleading, where each count incorporates by reference all preceding paragraphs and counts of the complaint notwithstanding that many facts alleged are not material to the claim or cause of action, makes it virtually impossible to know which allegations of fact are intended to support which claims for relief and thus are disfavored by the court. § 14:36. Impermissible shotgun pleading, 4 Cyc. of Federal Proc. § 14:36 (3d ed.). Shotgun pleadings are unacceptable for many reasons, including that they result in unintelligible pleadings that violate the basic specificity requirements of Iqbal. Ashcroft v. Iqbal, 556 U.S. 662, 129 S. Ct. 1937, 173 L. Ed. 2d 868, 73 Fed. R. Serv. 3d 837 (2009). Besides violating the Federal Rules of Civil Procedure, shotgun pleadings are prohibited because they waste scarce judicial resources, inexorably broaden the scope of discovery, wreak havoc on appellate court dockets, and undermine the public's respect for the courts. Barmapov v. Amuial, 986 F.3d 1321, 108 Fed. R. Serv. 3d 1610 (11th Cir. 2021); Pinson v. JPMorgan Chase Bank, National Association, 942 F.3d 1200 (11th Cir. 2019). Plaintiff's Verified Complaint reincorporates each preceding paragraph, and Count, into each subsequent Count, rendering it an impermissible shotgun pleading. Plaintiff's Verified Complaint must be dismissed on these grounds. In the alternative, this Court should require Plaintiff to file a more definite statement.

119. As a third affirmative defense, Plaintiff's mark is subject to cancellation as it is a generic or merely descriptive trademark which has failed to acquire distinctiveness through secondary meaning. Plaintiff's trademark is not "famous" and has not been registered for five (5) years. It is therefore at this juncture not an "incontestable' mark. Any references in the Verified Complaint to Plaintiff's marks being "famous" should be stricken.

120. As a fourth affirmative defense, Plaintiff's mark is subject to cancellation as it is fails to function as a trademark. Plaintiff's mark is simply the Plaintiff's owner's last name coupled with the word "insurance".

121. As a fifth affirmative defense, Defendants state that Plaintiffs' claims for injunctive relief are barred because Plaintiffs cannot show they will suffer any irreparable harm from Defendants' actions.

122. As a sixth affirmative defense, Defendants state that any remedies to Plaintiffs are limited to the extent that there is sought an overlapping or duplicative recovery pursuant to the various claims for any alleged single wrong.

WHEREFORE, Defendants demand judgment against Plaintiff and in its favor as to all Counts of the Verified Complaint, for costs, attorneys fees where applicable and for any other and further relief this Court deems just and proper. Defendants also demand a trial by jury on all issues so triable.

CERTIFICATE OF SERVICE

I HEREBY CERTIFY that on this 18th day of January, 2023, a true and correct copy of the foregoing has been furnished by electronic filing with the Clerk of the court via CM/ECF, which will send notice of electronic filing to all counsel of record.

COLE, SCOTT & KISSANE, P.A.

COLE, SCOTT & KISSANE, P.A.
COLE, SCOTT & KISSANE BUILDING - 9150 SOUTH DADELAND BOULEVARD - SUITE 1400 - P.O. BOX 569015 - MIAMI, FLORIDA 33256 - (305) 350-5300 - (305) 373-2294 FAX

Counsel for Defendants
Cole, Scott & Kissane Building
9150 South Dadeland Boulevard, Suite 1400
P.O. Box 569015
Miami, Florida 33256
Telephone (305) 350-5338
Facsimile (305) 373-2294
Primary e-mail: edward.polk@csklegal.com
Secondary e-mail: edward.polk@csklegal.com

By: s/ Marc A. Rapaport
EDWARD S. POLK
Florida Bar No.: 239860
EDWARD S. POLK
Florida Bar No.: 239860

4003.0256-00/-1

P09000058023

Florida Department of State
Division of Corporations
Public Access System

Electronic Filing Cover Sheet

Note: Please print this page and use it as a cover sheet. Type the fax audit number (shown below) on the top and bottom of all pages of the document.

(((H09000158606 3)))

H09000158606 3ABC2

Note: DO NOT hit the REFRESH/RELOAD button on your browser from this page. Doing so will generate another cover sheet.

To:
Division of Corporations
Fax Number : (850)617-6381

From:
Account Name : BUSINESS CHOICE, INC.
Account Number : I20010000004
Phone : (954)782-1829
Fax Number : (954)697-0245

09 JUL -7 PM 12:40
SECRETARY OF STATE
TALLAHASSEE, FLORIDA

APPROVED AND FILED

09 JUL -7 PM 3:56
RECEIVED
DEPARTMENT OF STATE

FLORIDA PROFIT/NON PROFIT CORPORATION

MATTOS INSURANCE, INC.

Certificate of Status	0
Certified Copy	1
Page Count	01
Estimated Charge	$78.75

Electronic Filing Menu Corporate Filing Menu Help

APPROVED AND FILED

09 JUL -7 PM 12:40

SECRETARY OF STATE
TALLAHASSEE, FLORIDA

H09000158606 3

ARTICLES OF INCORPORATION
of
MATTOS INSURANCE, INC.

The undersigned person(s), acting as incorporator(s) of a corporation for profit in compliance with Chapter 607 of the Florida Statutes, hereby adopt(s) the following Articles of Incorporation:

ARTICLE I
CORPORATE NAME

The name of this corporation is **MATTOS INSURANCE, INC.**

ARTICLE II
INITIAL PRINCIPAL OFFICE

The mailing address of the corporation's initial principal office is:
3111 N. University Dr. #402
Coral Springs, FL 33065

ARTICLE III
SHARES

The total number of shares which the corporation shall have authority to issue is ONE THOUSAND FIVE HUNDRED (1,500) shares of common stock having $1.00 (ONE DOLLAR) par value per share

ARTICLE IV
CAPITAL STOCK

The capital stock of this Corporation may be issued pursuant to a plan under Section 1244, Internal Revenue Code of 1954, as amended by the Small Business Tax Provision of 1958. All of the stocks and securities in lieu of cash or at a just valuation to be determined by the Board of Directors of this Corporation.

Business Choice, Inc.
1369 East Sample Rd. – Pompano Beach, FL 33064
Ph: (954) 782-1829 - Fax (954) 782-1899

ARTICLE V
REGISTERED OFFICE / AGENT & INCORPORATOR

The street address of the corporation's initial registered office and the name of its initial registered agent at such address is:

Marecio Mattos
11833 N.W. 12th DR.
Coral Springs, FL 33071

ARTICLE VI
PURPOSE

The purpose of the corporation is to engage in any lawful activity permitted by the laws of this state.

ARTICLE VII
EXISTENCE

This Corporation is to have perpetual existence, commencing on the date of the filling of these articles with the Department of State.

ARTICLE VIII
REGISTERED OWNER(S)

The Corporation, to the extent permitted by law, shall be entitled to treat the person in whose name any share or right is registered on the books of the corporation as the owner thereto, for all purposes, and except as may be agreed in writing by the Corporation, the Corporation shall not be bound to recognize any equitable or other claim to, or interest in, such share or right on the part of any other person, whether or not the Corporation shall have notice thereof.

Business Choice, Inc.
1369 East Sample Rd. – Pompano Beach, FL 33064
Ph: (954) 782-1829 - Fax (954) 782-1899

ARTICLE IX
SHAREHOLDERS

The affirmative vote of a majority of the shareholders of this Corporation entitled to vote shall be required for the authorization of any action of the shareholders of this Corporation. The shareholders of this Corporation are:

Marcelo Mattos.....50 Shares
11833 N.W. 12th Dr.
Coral Springs, FL 33071

Deborah Mattos.....50 Shares
11833 N.W. 12th Dr.
Coral Springs, FL 33071

ARTICLE X
AMENDMENT

The corporation reserves the right to amend, alter, change or repeal any provision contained in these Articles of Incorporation, or in any amendment hereto, or to add any provision to these Articles of Incorporation or to any amendment hereto, in any manner now or hereafter prescribed or permitted by the provisions of any applicable statute of the State of Florida, and all rights conferred upon shareholders in these Articles of Incorporation or any amendment hereto are granted subject to this reservation.

ARTICLE XI
BYLAWS

The Board of Director(s) of the Corporation shall have power, without the assent or vote of the shareholders, to make, alter, amend or repeal the Bylaws of the Corporation, but the affirmative vote of a number of Directors equal to a majority of the number who would constitute a full Board of Director(s) at the time of such action shall be necessary to take any action for the making, alteration, amendment or repeal of the Bylaws.

ARTICLE XII
LIABILITY OF DIRECTORS

To the fullest extent permitted by law, no director of this corporation shall be personally liable to the corporation or its shareholders for monetary damages for breach of any duty owed to the corporation or its shareholders, except that a director may be held personally liable for (i) breaches of the duty of loyalty, (ii) acts or omissions not in good faith or which involve intentional misconduct or a knowing violation of law, (iii) declaration of unlawful dividends or unlawful stock repurchases or redemption, or (iv) a transaction from which the director derives an improper personal benefit.

Any director or officer who is involved in litigation or other proceeding by reason of his or her position as a director or officer of this corporation shall be indemnified and held harmless by the corporation to the fullest extent permitted by law.

ARTICLES XIII
EFFECTIVE DATE

Effective day is: 07/06/2009

ARTICLE XIV
OTHER PROVISIONS

Preemptive Rights. The corporation elects to have preemptive rights so that each shareholder has the right to acquire a proportional amount of any shares that are issued.

Director or Officer Interest. In the absence of fraud, no transaction between (a) this corporation and (b) any other association, corporation or any director or officer of this corporation individually, shall be affected by the fact that any director or officer of this corporation is individually a party to the transaction or is interested in or is a director or officer of such other association or corporation.

Stock Transfer Restriction. No shareholder of this corporation shall sell any shares of stock held by him or her in this corporation without first offering to sell such stock to the corporation on the same terms and conditions and at the price offered in good faith and in writing, by any proposed purchaser. The written offer by such proposed purchaser shall be delivered to the corporation at the time the stock is offered to the corporation for sale. The corporation shall have the right to accept the offer any time within thirty (30) days from and after the date on which the offer is made to the shareholder and shall exercise the option to purchase by notifying the shareholder in writing. If the corporation shall not exercise its option to purchase the shares of stock, it shall notify the shareholder in writing within the thirty (30) day period and the shares may then be sold by the shareholder, but only to the proposed purchaser on the same terms and conditions as offered to the corporation, and only within thirty (30) days from and after the date on which the corporation declines to exercise its option.

Corporate Seal. The corporation shall have a corporate seal, which shall be affixed to all deeds, mortgages, and other instruments affecting or relating to real estate.

Execution of Written Instruments. All instruments that are executed on behalf of the corporation which are acknowledged and which affect an interest in real estate shall be executed by the President or any Vice President and the Secretary or Treasurer. All other instruments executed by the corporation, including a release of mortgage or lien, may be executed by the President or Vice President. Notwithstanding the preceding provisions of this section, any written instrument may be executed by any officer(s) or agent(s) that are specifically designated by resolution of the board of directors.

H09000158606 3

ARTICLES XV
DIRECTORS

All corporate powers shall be exercised by or under the Authority of, and the business and affairs of the corporation managed under the direction of its Board of directors, subject to any limitation set forth in these Articles of Incorporation. Names and residence addresses of the persons constituting the initial board of Directors are (is):

NAME	***ADDRESS***
Marcelo Mattos President - Secretary	11833 N.W. 12th Dr. Coral Springs, FL 33071
Deborah Mattos Vice President - Treasurer	11833 N.W. 12th Dr. Coral Springs, FL 33071

After the initial Board of Directors, the board shall consist of such number of directors as shall be determined by the shareholders from time to time at each annual meeting at which directors are to be elected.

IN WITNESS WHEREOF, the undersigned being the original subscribers to the capital stock here in above named for the purpose of forming a corporation to do business in the State of Florida, under the laws of the State of Florida, do make and file these Articles of Corporation, here by declaring and certifying that the facts herein stated all true and do agree to take the number of shares herein above set forth and hereunto set our hands and seals this June 25, 2009.

Marcelo Mattos

Deborah Mattos

APPROVED AND FILED

09 JUL -7 PM 12:40

SECRETARY OF STATE
TALLAHASSEE, FLORIDA

H09000158606 3

CERTIFICATE OF DESIGNATION OF REGISTERED AGENT AND REGISTERED OFFICE

PURSUANT TO THE PROVISIONS OF SECTION 607.0501, FLORIDA STATUTES, THE UNDERSIGNED CORPORATION, ORGANIZED UNDER THE LAWS OF THE STATE OF FLORIDA, SUBMITS THE FOLLOWING STATEMENTS IN DESIGNATING THE REGISTERED OFFICE AND REGISTERED AGENT, IN THE STATE OF FLORIDA.

1 - The name of the corporation is: **MATTOS INSURANCE, INC.**

2 - The name and address of the registered agent and office is:

Marcelo Mattos
11833 N.W. 12th Dr.
Coral Springs, FL 33071

Having been named as registered agent and to accept service of process for the above stated corporation at the place designated in this certificate, I hereby accept the appointment as registered agent and agree to act in this capacity. I further agree to comply with the provisions of all statutes relating to the proper and complete performance of my duties, and I am familiar with and accept the obligations of my position as registered agent.

(Signature) (Date) 6/25/09

Business Choice, Inc.
1369 East Sample Rd. – Pompano Beach, FL 33064
Ph: (954) 782-1829 - Fax (954) 782-1899

To:	Mattos Insurance, Inc. (rkulberg@saavlaw.com)
Subject:	U.S. Trademark Application Serial No. 88794831 - MATTOS INSURANCE - 8616.001
Sent:	April 30, 2020 08:07:44 PM
Sent As:	ecom130@uspto.gov
Attachments:	Attachment - 1 Attachment - 2 Attachment - 3 Attachment - 4 Attachment - 5 Attachment - 6

United States Patent and Trademark Office (USPTO)
Office Action (Official Letter) About Applicant's Trademark Application

U.S. Application Serial No. 88794831

Mark: MATTOS INSURANCE

Correspondence Address:
ROSS D. KULBERG
SAAVEDRA-GOODWIN
312 S.E. 17TH STREET, SECOND FLOOR
FORT LAUDERDALE, FL 33316

Applicant: Mattos Insurance, Inc.

Reference/Docket No. 8616.001

Correspondence Email Address:

rkulberg@saavlaw.com

NONFINAL OFFICE ACTION

The USPTO must receive applicant's response to this letter within six months of the issue date below or the application will be **abandoned**. Respond using the Trademark Electronic Application System (TEAS). A link to the appropriate TEAS response form appears at the end of this Office action.

Issue date: **April 30, 2020**

The referenced application has been reviewed by the assigned trademark examining attorney. Applicant must respond timely and completely to the issue(s) below. 15 U.S.C. §1062(b); 37 C.F.R. §§2.62(a), 2.65(a); TMEP §§711, 718.03.

Search Results

The trademark examining attorney searched the USPTO database of registered and pending marks and found no conflicting marks that would bar registration under Trademark Act Section 2(d). 15 U.S.C. §1052(d); TMEP §704.02.

Section 2(e)(4) Refusal – PRIMARILY MERELY A SURNAME

Registration is refused because the applied-for mark is primarily merely a surname. Trademark Act Section 2(e)(4), 15 U.S.C. §1052(e)(4); *see* TMEP §1211.

An applicant's mark is primarily merely a surname if the surname, when viewed in connection with the applicant's recited goods and/or services, "'is the primary significance of the mark as a whole to the purchasing public.'" *Earnhardt v. Kerry Earnhardt, Inc.*, 864 F.3d 1374, 1377, 123 USPQ2d 1411, 1413 (Fed. Cir. 2017) (quoting *In re Hutchinson Tech. Inc.*, 852 F.2d 552, 554, 7 USPQ2d 1490, 1492 (Fed. Cir. 1988)); TMEP §1211.01.

The following five inquiries are often used to determine the public's perception of a term's primary significance:

(1) Whether the surname is rare;

(2) Whether anyone connected with applicant uses the term as a surname;

(3) Whether the term has any recognized meaning other than as a surname;

(4) Whether the term has the structure and pronunciation of a surname; and

(5) Whether the term is sufficiently stylized to remove its primary significance from that of a surname.

In re Eximius Coffee, LLC, 120 USPQ2d 1276, 1278 & n.2, 1282-83 (TTAB 2016) (citing *In re Benthin Mgmt. GmbH*, 37 USPQ2d 1332, 1333-34 (TTAB 1995) for the *Benthin* inquiries/factors); TMEP §1211.01; *see also In re Etablissements Darty et Fils*, 759 F.2d 15, 16-18, 225 USPQ 652, 653 (Fed. Cir. 1985).

These inquiries are not exclusive, and any of these circumstances – singly or in combination – and any other relevant circumstances may be considered when making this determination. *In re Eximius Coffee, LLC*, 120 USPQ2d at 1277-78; TMEP §1211.01. For example, when the applied-for mark is not stylized, it is unnecessary to consider the fifth inquiry. *In re Yeley*, 85 USPQ2d 1150, 1151 (TTAB 2007); TMEP §1211.01.

Please see the attached evidence from whitepages.com, establishing the surname significance of MATTOS. This evidence shows the applied-for mark appearing over 100 times as a surname in a nationwide phone directory of names.

Although the mark contains the additional term INSURANCE, combining a surname with a term that is merely **descriptive**, primarily geographically descriptive or deceptively misdescriptive, or **generic** of an applicant's goods and/or services typically does not "detract from the primary surname significance" of the mark. *Azeka Bldg. Corp. v. Azeka*, 122 USPQ2d 1477, 1481-82, 1481 n.9 (TTAB 2017) (construing *In re Hutchinson Tech. Inc.,* 852 F.2d 552, 554, 7 USPQ2d 1490, 1492-93 (Fed. Cir. 1988)); *see* TMEP §1211.01(b)(vi).

Specifically, applicant provides insurance agency/brokerage services. Therefore the term INSURANCE is considered generic in relation to the services and does not detract from the primary surname significance of the mark.

Response Option

A mark deemed primarily merely a surname may be registered on the Principal Register under Trademark Act Section 2(f) by satisfying one of the following:

(1) Submitting a claim of ownership of one or more prior registrations on the Principal Register for a mark that is the same as the mark in the application and for the same or related goods and/or services. 37 C.F.R. §2.41(b); TMEP §1212.04. The following wording is suggested: **"The mark has become distinctive under Section 2(f) of the goods or services as evidenced by ownership of U.S. Registration No(s). ____ on the Principal Register for the same mark for related goods or services."** TMEP §1212.04(e).;

(2) Submitting the following statement, verified with an affidavit or signed declaration under 37 C.F.R. §§2.20, 2.33: "The mark has become distinctive of the goods and/or services through applicant's substantially exclusive and continuous use in commerce **for at least the five years** immediately before the date of this statement." 37 C.F.R. §2.41(b); TMEP §1212.05(d).; or

(3) Submitting actual evidence of acquired distinctiveness. 37 C.F.R. §2.41(a); TMEP §1212.06, Such evidence may include the following: examples of advertising and promotional materials that specifically promote the applied-for mark as a trademark or service mark in the United States; dollar figures for advertising devoted to such promotion; dealer and consumer statements of recognition of the applied-for mark as a trademark or service mark; and any other evidence that establishes recognition of the applied-for mark as a source-identifier for the goods and/or services. *See In re Ideal Indus., Inc.*, 508 F.2d 1336, 184 USPQ 487 (C.C.P.A. 1975); *In re Instant Transactions Corp. of Am.*, 201 USPQ 957 (TTAB 1979); TMEP §§1212.06 *et seq.*

Trademark Act Section 2(f), 15 U.S.C. §1052(f); *see* 37 C.F.R. §2.41; TMEP §§1211, 1212.

If applicant cannot satisfy one of the above, applicant can amend the application to seek registration on the Supplemental Register. Trademark Act Section 23, 15 U.S.C. §1091; *see* 37 C.F.R. §§2.47, 2.75(a).

Although applicant's mark has been refused registration, applicant may respond to the refusal(s) by submitting evidence and arguments in support of registration.

Response Guidelines

For this application to proceed, applicant must explicitly address each refusal and/or requirement in this Office action. For a refusal, applicant may provide written arguments and evidence against the refusal, and may have other response options if specified above. For a requirement, applicant should set forth the changes or statements. Please see "Responding to Office Actions" and the informational video "Response to Office Action" for more information and tips on responding.

Please call or email the assigned trademark examining attorney with questions about this Office action. Although an examining attorney cannot provide legal advice, the examining attorney can provide additional explanation about the refusal(s) and/or requirement(s) in this Office action. *See* TMEP §§705.02, 709.06.

The USPTO does not accept emails as responses to Office actions; however, emails can be used for informal communications and are included in the application record. *See* 37 C.F.R. §§2.62(c), 2.191; TMEP §§304.01-.02, 709.04-.05.

How to respond. Click to file a response to this nonfinal Office action.

/Emily Chuo/
Trademark Examining Attorney
Law Office 130
U.S. Patent & Trademark Office
Phone: 571.272.1728
Emily.Chuo@uspto.gov

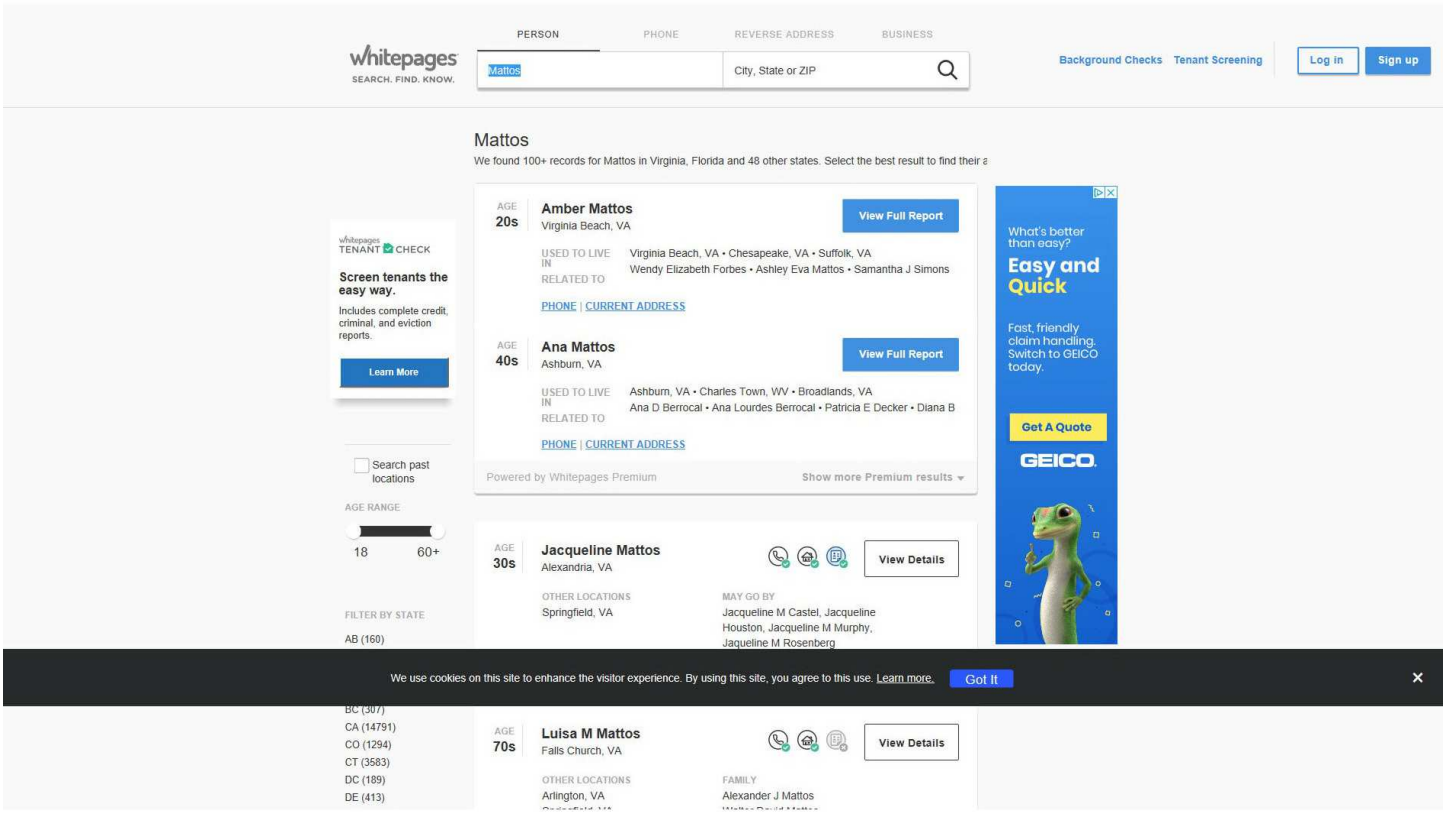
RESPONSE GUIDANCE

- **Missing the response deadline to this letter will cause the application to abandon.** A response or notice of appeal must be received by the USPTO before midnight **Eastern Time** of the last day of the response period. TEAS and ESTTA maintenance or unforeseen circumstances could affect an applicant's ability to timely respond.

- **Responses signed by an unauthorized party** are not accepted and can **cause the application to abandon.** If applicant does not have an attorney, the response must be signed by the individual applicant, all joint applicants, or someone with legal authority to bind a juristic applicant. If applicant has an attorney, the response must be signed by the attorney.

- If needed, **find contact information for the supervisor** of the office or unit listed in the signature block.

https://www.whitepages.com/name/Mattos?fs=1&q=Mattos 04/30/2020 07:21:41 PM



FL (22664)
GA (2535)
HI (1323)
IA (460)
ID (326)

Show more states

Springfield, VA

Walter David Mattos
Christina M Mattos V

Show all locations and family

AGE 30s **Alexander J Mattos**
Falls Church, VA

View Details

OTHER LOCATIONS
Arlington, VA
Springfield, VA

FAMILY
Walter David Mattos
Christina M Mattos V

We use cookies on this site to enhance the visitor experience. By using this site, you agree to this use. Learn more. Got It ×

AGE 70s **Louisa M Mattos**
Falls Church, VA

View Details

FAMILY
Luisa M Mattos
Alexander J Mattos

AGE 40s **David D Mattos**
Arlington, VA

View Details

OTHER LOCATIONS
Blacksburg, VA

We use cookies on this site to enhance the visitor experience. By using this site, you agree to this use. Learn more. Got It ×

OTHER LOCATIONS
Woodstock, CT
Marlborough, MA
Acushnet, MA

FAMILY
Sheila H Tetreault
Tiffany Mattos
Richard T Mattos Jr.

Show all locations and family

AGE 30s **Emmanuel Ivan Mattos**
Alexandria, VA

View Details

MAY GO BY
Emmanuel Ivan Roman

Emmanuel Ivan Roman

FAMILY
Ceasar Alexander Roman

Show all locations and family

We use cookies on this site to enhance the visitor experience. By using this site, you agree to this use. Learn more. Got It ×

OTHER LOCATIONS
Ripon, CA
Alexandria, VA
San Diego, CA

MAY GO BY
Christina E Kindlon

FAMILY
Theresa Geanetos Mattos

Show all locations and family

AGE
—

Yeting Mattos
Arlington, VA

FAMILY
Doris E Mattos
Katherine Louise Mattos

View Details

We use cookies on this site to enhance the visitor experience. By using this site, you agree to this use. Learn more. Got It ×

OTHER LOCATIONS
Washington, DC

MAY GO BY
Katherine Louise Krell

FAMILY
Paul Jay Krell

Show all locations and family

AGE
80+

Doris E Mattos
Arlington, VA

FAMILY
Yeting Mattos
Katherine Louise Mattos

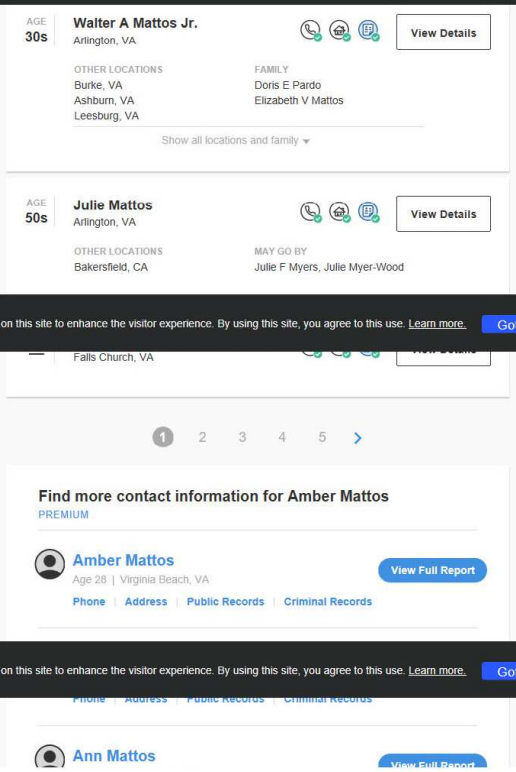
View Details

AGE

Walter A Mattos Jr.

View Details

We use cookies on this site to enhance the visitor experience. By using this site, you agree to this use. Learn more. Got It ×



We use cookies on this site to enhance the visitor experience. By using this site, you agree to this use. Learn more. Got It ×

We use cookies on this site to enhance the visitor experience. By using this site, you agree to this use. Learn more. Got It ×

Age 72 | Chesapeake, VA

View Full Report

Phone | Address | Public Records | Criminal Records

Birth, Death, and Divorce Records for Mattos

Sponsored by Ancestry.com

Mattos
4,939 Birth Rec...

Mattos
1,791 Death Re...

Mattos
152 Divorce Re...

We use cookies on this site to enhance the visitor experience. By using this site, you agree to this use. Learn more. Got It ×

Top 3 Results for Mattos

1 The best result we found for your search is **Jacqueline Mattos age 30s in Alexandria, VA**. Jacqueline is related to Jaime E Mattos. Select this result to view Jacqueline Mattos's phone number, address, and more.

2 The second best result is **Luisa M Mattos age 70s in Falls Church, VA**. They have also lived in Arlington, VA and Springfield, VA. Luisa is related to Alexander J Mattos and Walter David Mattos as well as 3 additional people. Select this result to view Luisa M Mattos's phone number, address, and more.

The third result is **Alexander J Mattos age 30s in Falls Church, VA**.

We use cookies on this site to enhance the visitor experience. By using this site, you agree to this use. Learn more. Got It ×

Mattos's phone number, address, and more.

Why use Whitepages?

We have information on 98,335 results for Mattos , including **phone numbers** and **addresses**. We also found **68835 background checks** for Mattos , including **criminal records**.

records.

Every second, Whitepages helps 19 people do **reverse phone lookups**, **find people**, and get **background reports**, including **public records**, in order to make smarter, safer decisions.

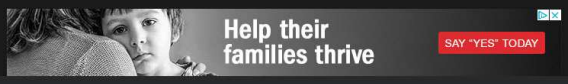
What is Whitepages?

We use cookies on this site to enhance the visitor experience. By using this site, you agree to this use. Learn more. Got It ×

family, keep contacts up to date, and verify identities.

Download on the App Store GET IT ON Google Play

We use cookies on this site to enhance the visitor experience. By using this site, you agree to this use. Learn more. Got It ×



We use cookies on this site to enhance the visitor experience. By using this site, you agree to this use. Learn more. Got It ×

To:	Mattos Insurance, Inc. (rkulberg@saavlaw.com)
Subject:	U.S. Trademark Application Serial No. 88794831 - MATTOS INSURANCE - 8616.001
Sent:	April 30, 2020 08:07:44 PM
Sent As:	ecom130@uspto.gov
Attachments:	

United States Patent and Trademark Office (USPTO)

USPTO OFFICIAL NOTICE

Office Action (Official Letter) has issued
on **April 30, 2020** for
U.S. Trademark Application Serial No. 88794831

Your trademark application has been reviewed by a trademark examining attorney. As part of that review, the assigned attorney has issued an official letter that you must respond to by the specified deadline or your application will be abandoned. Please follow the steps below.

(1) Read the official letter.

(2) Direct questions about the contents of the Office action to the assigned attorney below.

/Emily Chuo/
Trademark Examining Attorney
Law Office 130
U.S. Patent & Trademark Office
Phone: 571.272.1728
Emily.Chuo@uspto.gov

Direct questions about navigating USPTO electronic forms, the USPTO website, the application process, the status of your application, and/or whether there are outstanding deadlines or documents related to your file to the Trademark Assistance Center (TAC).

(3) Respond within 6 months (or earlier, if required in the Office action) from **April 30, 2020**, using the Trademark Electronic Application System (TEAS). The response must be received by the USPTO before midnight **Eastern Time** of the last day of the response period. See the Office action for more information about how to respond

GENERAL GUIDANCE

- **Check the status of your application periodically** in the Trademark Status & Document Retrieval (TSDR) database to avoid missing critical deadlines.

- **Update your correspondence email address**, if needed, to ensure you receive important USPTO notices about your application.

- **Beware of misleading notices sent by private companies about your application.** Private companies not associated with the USPTO use public information available in trademark registrations to mail and email trademark-related offers and notices – most of which require fees. All **official USPTO correspondence** will only be **emailed from the domain "@uspto.gov."**

Under the Paperwork Reduction Act of 1995 no persons are required to respond to a collection of information unless it displays a valid OMB control number.
PTO Form 1957 (Rev 10/2011)
OMB No. 0651-0050 (Exp 09/20/2020)

Response to Office Action

The table below presents the data as entered.

Input Field	Entered
SERIAL NUMBER	88794831
LAW OFFICE ASSIGNED	LAW OFFICE 130
MARK SECTION	
MARK	mark
LITERAL ELEMENT	MATTOS INSURANCE
STANDARD CHARACTERS	YES
USPTO-GENERATED IMAGE	YES
MARK STATEMENT	The mark consists of standard characters, without claim to any particular font style, size or color.
EVIDENCE SECTION	
EVIDENCE FILE NAME(S)	
ORIGINAL PDF FILE	evi_1222222390-2020080715 0833009871_._00278602.PDF
CONVERTED PDF FILE(S) (1 page)	\\TICRS\EXPORT18\IMAGEOUT 18\887\948\88794831\xml4\ ROA0002.JPG
DESCRIPTION OF EVIDENCE FILE	Signed sworn declaration of owner attesting to distinctiveness of mark
ATTORNEY INFORMATION (current)	
NAME	Ross D. Kulberg
ATTORNEY BAR MEMBERSHIP NUMBER	XXX
YEAR OF ADMISSION	XXXX
U.S. STATE/ COMMONWEALTH/ TERRITORY	XX
FIRM NAME	SAAVEDRA-GOODWIN
STREET	312 S.E. 17TH STREET, SECOND FLOOR
CITY	FORT LAUDERDALE
STATE	Florida
POSTAL CODE	33316
COUNTRY/REGION/JURISDICTION/U.S. TERRITORY	United States
PHONE	954-767-6333
FAX	954-767-8111
EMAIL	rkulberg@saavlaw.com
DOCKET/REFERENCE NUMBER	8616.001
ATTORNEY INFORMATION (proposed)	
NAME	Ross D. Kulberg

ATTORNEY BAR MEMBERSHIP NUMBER	XXX
YEAR OF ADMISSION	XXXX
U.S. STATE/ COMMONWEALTH/ TERRITORY	XX
FIRM NAME	SAAVEDRA-GOODWIN
STREET	312 S.E. 17TH STREET, SECOND FLOOR
CITY	FORT LAUDERDALE
STATE	Florida
POSTAL CODE	33316
COUNTRY/REGION/JURISDICTION/U.S. TERRITORY	United States
PHONE	954-767-6333
FAX	954-767-8111
EMAIL	rkulberg@saavlaw.com
DOCKET/REFERENCE NUMBER	8616.001
OTHER APPOINTED ATTORNEY	Glen M. Lindsay
CORRESPONDENCE INFORMATION (current)	
NAME	ROSS D. KULBERG
PRIMARY EMAIL ADDRESS FOR CORRESPONDENCE	rkulberg@saavlaw.com
SECONDARY EMAIL ADDRESS(ES) (COURTESY COPIES)	NOT PROVIDED
DOCKET/REFERENCE NUMBER	8616.001
CORRESPONDENCE INFORMATION (proposed)	
NAME	Ross D. Kulberg
PRIMARY EMAIL ADDRESS FOR CORRESPONDENCE	rkulberg@saavlaw.com
SECONDARY EMAIL ADDRESS(ES) (COURTESY COPIES)	glindsay@saavlaw.com
DOCKET/REFERENCE NUMBER	8616.001
SIGNATURE SECTION	
RESPONSE SIGNATURE	/Glen M. Lindsay/
SIGNATORY'S NAME	Glen M. Lindsay
SIGNATORY'S POSITION	Attorney of record, Florida Bar member
SIGNATORY'S PHONE NUMBER	954-767-6333
DATE SIGNED	08/07/2020
AUTHORIZED SIGNATORY	YES
FILING INFORMATION SECTION	
SUBMIT DATE	Fri Aug 07 15:13:51 ET 2020
TEAS STAMP	USPTO/ROA-XX.XXX.XXX.XX-2 0200807151351454274-88794 831-7408379b452e1e710c692 83dd929e33954ce63c182ba92 4c0e836572590aaf83847-N/A -N/A-20200807150833009871

Under the Paperwork Reduction Act of 1995 no persons are required to respond to a collection of information unless it displays a valid OMB control number.
PTO Form 1957 (Rev 10/2011)
OMB No. 0651-0050 (Exp 09/20/2020)

Response to Office Action

To the Commissioner for Trademarks:

Application serial no. **88794831** MATTOS INSURANCE(Standard Characters, see https://tmng-al.uspto.gov/resting2/api/img/88794831/large) has been amended as follows:

EVIDENCE
Evidence has been attached: Signed sworn declaration of owner attesting to distinctiveness of mark
Original PDF file:
evi_1222222390-2020080715 0833009871_._00278602.PDF
Converted PDF file(s) (1 page) Evidence-1

The owner's/holder's current attorney information: Ross D. Kulberg. Ross D. Kulberg of SAAVEDRA-GOODWIN, is a member of the XX bar, admitted to the bar in XXXX, bar membership no. XXX, is located at

312 S.E. 17TH STREET, SECOND FLOOR
FORT LAUDERDALE, Florida 33316
United States
The docket/reference number is 8616.001.
The phone number is 954-767-6333.
The fax number is 954-767-8111.
The email address is rkulberg@saavlaw.com

The owner's/holder's proposed attorney information: Ross D. Kulberg. Other appointed attorneys are Glen M. Lindsay. Ross D. Kulberg of SAAVEDRA-GOODWIN, is a member of the XX bar, admitted to the bar in XXXX, bar membership no. XXX, and the attorney(s) is located at

312 S.E. 17TH STREET, SECOND FLOOR
FORT LAUDERDALE, Florida 33316
United States
The docket/reference number is 8616.001.
The phone number is 954-767-6333.
The fax number is 954-767-8111.
The email address is rkulberg@saavlaw.com

Ross D. Kulberg submitted the following statement: The attorney of record is an active member in good standing of the bar of the highest court of a U.S. state, the District of Columbia, or any U.S. Commonwealth or territory.

Correspondence Information (current):
ROSS D. KULBERG
PRIMARY EMAIL FOR CORRESPONDENCE: rkulberg@saavlaw.com
SECONDARY EMAIL ADDRESS(ES) (COURTESY COPIES): NOT PROVIDED

The docket/reference number is 8616.001.

Correspondence Information (proposed):
Ross D. Kulberg
PRIMARY EMAIL FOR CORRESPONDENCE: rkulberg@saavlaw.com
SECONDARY EMAIL ADDRESS(ES) (COURTESY COPIES): glindsay@saavlaw.com

The docket/reference number is 8616.001.

Requirement for Email and Electronic Filing: I understand that a valid email address must be maintained by the owner/holder and the owner's/holder's attorney, if appointed, and that all official trademark correspondence must be submitted via the Trademark Electronic Application System (TEAS).

SIGNATURE(S)
Response Signature
Signature: /Glen M. Lindsay/ Date: 08/07/2020
Signatory's Name: Glen M. Lindsay
Signatory's Position: Attorney of record, Florida Bar member

Signatory's Phone Number: 954-767-6333

The signatory has confirmed that he/she is a U.S.-licensed attorney who is an active member in good standing of the bar of the highest court of a U.S. state (including the District of Columbia and any U.S. Commonwealth or territory); and he/she is currently the owner's/holder's attorney or an associate thereof; and to the best of his/her knowledge, if prior to his/her appointment another U.S.-licensed attorney not currently associated with his/her company/firm previously represented the owner/holder in this matter: the owner/holder has revoked their power of attorney by a signed revocation or substitute power of attorney with the USPTO; the USPTO has granted that attorney's withdrawal request; the owner/holder has filed a power of attorney appointing him/her in this matter; or the owner's/holder's appointed U.S.-licensed attorney has filed a power of attorney appointing him/her as an associate attorney in this matter.

Mailing Address: ROSS D. KULBERG
SAAVEDRA-GOODWIN

312 S.E. 17TH STREET, SECOND FLOOR
FORT LAUDERDALE, Florida 33316
Mailing Address: Ross D. Kulberg
SAAVEDRA-GOODWIN
312 S.E. 17TH STREET, SECOND FLOOR
FORT LAUDERDALE, Florida 33316

Serial Number: 88794831
Internet Transmission Date: Fri Aug 07 15:13:51 ET 2020
TEAS Stamp: USPTO/ROA-XX.XXX.XXX.XX-2020080715135145
4274-88794831-7408379b452e1e710c69283dd9
29e33954ce63c182ba924c0e836572590aaf8384
7-N/A-N/A-20200807150833009871

DECLARATION OF TIAGO M. MANGUIERA

1. I am a licensed insurance agent for Mattos Insurance, Inc. ("Applicant"). I hereby submit this declaration pursuant to 37 C.F.R. §2.20. I, having been warned that willful false statements and the like are punishable by fine or imprisonment, or both, under 18 U.S.C. §1001, and that such willful false statements and the like may jeopardize the validity of the application or submission or any registration resulting therefrom, declare that all statements made of my own knowledge are true and all statements made on information and belief are believed to be true.

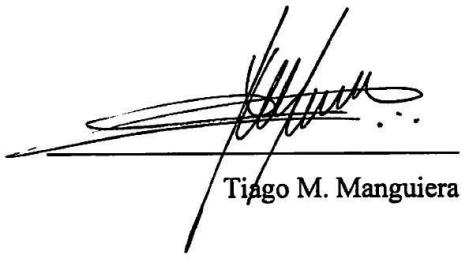
2. I am over the age of eighteen (18) years of age, am of sound mind, and am otherwise competent to attest to the matters contained within this Declaration.

3. I am familiar with the trademark application submitted by Ross Kulberg, Esq. on behalf of Applicant bearing U.S. Application Serial Number 88794831.

4. The desired trademark, "Mattos Insurance", has become distinctive of the services through Applicant's substantially exclusive and continuous use in commerce for at least five years immediately before the date of this Declaration.

5. Specifically, Applicant has been in exclusive and continuous use in commerce of the term "Mattos Insurance" since at least 2009.

Executed on June 11, 2020



Tiago M. Manguiera

United States of America
United States Patent and Trademark Office

Mattos Insurance

Reg. No. 6,209,276

Registered Dec. 01, 2020

Int. Cl.: 36

Service Mark

Principal Register

Mattos Insurance, Inc. (FLORIDA CORPORATION)
569 East Sample Road
Pompano Beach, FLORIDA 33064

CLASS 36: Insurance agency and brokerage

FIRST USE 7-7-2009; IN COMMERCE 7-7-2009

THE MARK CONSISTS OF STANDARD CHARACTERS WITHOUT CLAIM TO ANY PARTICULAR FONT STYLE, SIZE OR COLOR

No claim is made to the exclusive right to use the following apart from the mark as shown: "INSURANCE"

SEC.2(F)

SER. NO. 88-794,831, FILED 02-12-2020

Director of the United States
Patent and Trademark Office

REQUIREMENTS TO MAINTAIN YOUR FEDERAL TRADEMARK REGISTRATION

WARNING: YOUR REGISTRATION WILL BE CANCELLED IF YOU DO NOT FILE THE DOCUMENTS BELOW DURING THE SPECIFIED TIME PERIODS.

Requirements in the First Ten Years*
What and When to File:

- ***First Filing Deadline:*** You must file a Declaration of Use (or Excusable Nonuse) between the 5th and 6th years after the registration date. See 15 U.S.C. §§1058, 1141k. If the declaration is accepted, the registration will continue in force for the remainder of the ten-year period, calculated from the registration date, unless cancelled by an order of the Commissioner for Trademarks or a federal court.

- ***Second Filing Deadline:*** You must file a Declaration of Use (or Excusable Nonuse) and an Application for Renewal between the 9th and 10th years after the registration date.* See 15 U.S.C. §1059.

Requirements in Successive Ten-Year Periods*
What and When to File:

- You must file a Declaration of Use (or Excusable Nonuse) and an Application for Renewal between every 9th and 10th-year period, calculated from the registration date.*

Grace Period Filings*

The above documents will be accepted as timely if filed within six months after the deadlines listed above with the payment of an additional fee.

***ATTENTION MADRID PROTOCOL REGISTRANTS:** The holder of an international registration with an extension of protection to the United States under the Madrid Protocol must timely file the Declarations of Use (or Excusable Nonuse) referenced above directly with the United States Patent and Trademark Office (USPTO). The time periods for filing are based on the U.S. registration date (not the international registration date). The deadlines and grace periods for the Declarations of Use (or Excusable Nonuse) are identical to those for nationally issued registrations. See 15 U.S.C. §§1058, 1141k. However, owners of international registrations do not file renewal applications at the USPTO. Instead, the holder must file a renewal of the underlying international registration at the International Bureau of the World Intellectual Property Organization, under Article 7 of the Madrid Protocol, before the expiration of each ten-year term of protection, calculated from the date of the international registration. See 15 U.S.C. §1141j. For more information and renewal forms for the international registration, see http://www.wipo.int/madrid/en/.

NOTE: Fees and requirements for maintaining registrations are subject to change. Please check the USPTO website for further information. With the exception of renewal applications for registered extensions of protection, you can file the registration maintenance documents referenced above online at http://www.uspto.gov.

NOTE: A courtesy e-mail reminder of USPTO maintenance filing deadlines will be sent to trademark owners/holders who authorize e-mail communication and maintain a current e-mail address with the USPTO. To ensure that e-mail is authorized and your address is current, please use the Trademark Electronic Application System (TEAS) Correspondence Address and Change of Owner Address Forms available at http://www.uspto.gov.