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

Proceeding no.	92082310
Party	Defendant Mattos Insurance, Inc.
Correspondence address	MATTOS INSURANCE, INC. 569 EAST SAMPLE ROAD POMPANO BEACH, FL 33064 UNITED STATES No email provided 954-366-6367
Submission	Motion to Suspend for Civil Action
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Signature	/Mark K Suri/
Date	06/14/2023
Attachments	Mattos Motion to Suspend with Exhibit A B C .pdf(2193027 bytes)

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

MATOS INSURANCE AGENCY, INC. and ARMANDO J MATOS,	)	
Petitioner,	)	Cancellation No. 92082310 Registration No. 6209276 Mark: MATTOS INSURANCE
v.	)	Registration Date: 12/01/2020 Class: 036
MATTOS INSURANCE, INC.,	)	
Respondent.	)	

Commissioner for Trademarks
P.O. Box 1451
Alexandria, VA 22313-1451

MOTION TO SUSPEND PROCEEDINGS

Respondent Mattos Insurance, Inc. ("Respondent") hereby moves, pursuant to Trademark Rule § 2.117, that all further proceedings in this Cancellation Proceeding, including all deadlines listed in the Board's May 15, 2023 scheduling order, be suspended pending disposition of a federal civil action between the parties. *See also* TBMP § 510.02(a).

On November 8, 2022, Respondent filed Civil Action No. 22-cv-62075, entitled *Mattos Insurance, Inc. v. Jose Matos Armando et al.*, which is pending in the Southern District of Florida. Respondent has served the complaint on Petitioner Jose Matos Armando and Matos Insurance Agency, Inc. ("Petitioner"). A copy of the complaint is attached as Exhibit A. Petitioner has answered and asserted a number of affirmative defenses. A copy of the answer and affirmative defenses is attached as Exhibit B. The district court has entered a case management order setting the pre-trial schedule. A copy of the case management order is attached as Exhibit C.

This civil action includes a claim for trademark infringement under the Lanham Act, domain name infringement as well as various claims under Florida state statutes and common law. *See* Exhibit A. The complaint seeks, inter alia, to enjoin Petitioner's further use of the MATTOS INSURANCE mark, and any marks confusingly similar thereto, which is the mark at issue in this cancellation proceeding. *Id*. Respondent seeks monetary and injunctive relief in the civil action. *Id*.

In its answer and affirmative defenses in the civil action, Petitioner asserts that the registered mark is invalid and should be cancelled. *See* Exhibit B at ¶¶ 16, 119-120. Accordingly, the issue of the registered mark's validity and whether it should be cancelled is squarely in front of the district court in the civil action.

Disposition of the civil action will determine whether Petitioner may continue its infringement of Respondent's mark, whether Respondent's registration of its MATTOS INSURANCE mark is valid and whether Respondent's registration of its MATTOS INSURANCE mark should be cancelled. Thus, the earlier-filed and already-pending civil action is dispositive of all of the issues raised in this cancellation proceeding. Trial in the civil action is scheduled for March 11, 2024, which is well before briefing in this cancellation proceeding would be underway under the current schedule. *See* Exhibit C.

Accordingly, Respondent requests that this cancellation proceeding be suspended pending the disposition of Civil Action No. 22-cv-62075, S.D. Fla.

Dated: June 14, 2023

Respectfully submitted,

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Attorneys for Respondent
MATTOS INSURANCE, INC.

CERTIFICATE OF SERVICE

I hereby certify that a true and complete copy of the foregoing **MOTION TO SUSPEND PROCEEDINGS** has been served on opposing counsel for Petitioner by forwarding said copy on June 14, 2023, via electronic mail to:

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/s/Mark K. Suri
Mark K. Suri
Attorney for Respondent

EXHIBIT A

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

EX. A

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

EX. A

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

EX. A

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

EX. A

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

EX. A

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.

EX. A

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.

EX. A

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

EX. A

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

EX. A

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

EX. A

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 87 015 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]

EX. A

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

EX. A

EXHIBIT B

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

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EX. B

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.

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EX. B

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.

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EX. B

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.

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EX. B

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.

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EX. B

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.

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EX. B

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.

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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.

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EX. B

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.

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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.

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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

EX. B

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

4003.0256-00/-1

EXHIBIT C

UNITED STATES DISTRICT COURT
SOUTHERN DISTRICT OF FLORIDA

CASE NO.: 22-62075-CIV-SINGHAL/VALLE

MATTOS INSURANCE, INC.,

Plaintiff,

v.

JOSE MATOS ARMANDO and
MATOS INSURANCE AGENCY, INC.,

Defendants.
_____/

ORDER SETTING TRIAL AND PRE-TRIAL SCHEDULE, REQUIRING MEDIATION, AND REFERRING CERTAIN MATTERS TO MAGISTRATE JUDGE

THIS CAUSE is set for trial during the Court's two-week trial calendar beginning on **March 11, 2024, at 9:00 a.m.** Calendar call will be held via ZOOM at **10:30 a.m. on Wednesday, March 6, 2024**. A ZOOM link will be sent in a subsequent order. No pre-trial conference will be held unless a party requests one at a later date and the Court determines that one is necessary. Unless instructed otherwise by subsequent order, the trial and all other proceedings in this case shall be conducted in **Courtroom 110 at the United States Courthouse, 299 East Broward Boulevard, Fort Lauderdale, Florida 33301**.

TRIAL READINESS: To be "ready for trial" means that the parties have timely complied with all deadlines in this Order and any subsequent deadlines issued by the Court. Counsel MAY NOT announce ready at calendar call unless (1) exhibit and witness lists have been filed; (2) exhibits have been reviewed with opposing counsel and

evidentiary objections have been raised with the Court; and (3) deposition designations and objections have been filed.

The parties shall adhere to the following schedule:

04/17/2023	Parties exchange initial disclosures pursuant to Fed. R. Civ. P. 26(a)(1). The parties are reminded that pursuant to S.D. Fla. L.R. 26.1(b), initial disclosures shall not be filed with the Court unless an exception noted in the Local Rules applies.
04/24/2023	The parties shall select a mediator pursuant to Local Rule 16.2, shall **schedule a time, date, and place for mediation**, and shall jointly **file a notice, and proposed order scheduling mediation** via CM/ECF in the form specified on the Court's website, http://www.flsd.uscourts.gov. If the parties cannot agree on a mediator, they shall notify the Clerk in writing as soon as possible, and the Clerk shall designate a certified mediator on a blind rotation basis. Counsel for all parties shall familiarize themselves with and adhere to all provisions of Local Rule 16.2. Within **three (3) days** of mediation, the parties are required to file a mediation report with the Court. Pursuant to the procedures outlined in the CM/ECF Administrative Procedures, **the proposed order is also to be e-mailed to** singhal@flsd.uscourts.gov **in Word format.**
04/24/2023	All motions to amend pleadings or join parties are filed.
08/15/2023	Plaintiff shall disclose experts and exchange expert witness summaries or reports.
09/15/2023	Defendant shall disclose experts and exchange expert witness summaries or reports.
10/02/2023	Parties exchange rebuttal expert witness summaries or reports.
10/16/2023	All discovery, including expert discovery, is completed.
11/15/2023	Parties must have completed mediation and filed a mediation report.
12/06/2023	All pre-trial motions, motions *in limine*, and *Daubert* motions (which include motions to strike experts) are filed. **This deadline includes all dispositive motions.**
02/06/2024	Parties shall file all depositions to be used at trial and advise of the deposition portions to be used at trial by designating the page and line of each deposition. If both parties plan to use the deposition of a particular witness, the parties shall confer and file

EX. C

	only one copy of the transcript. Any objections or counter-designations shall be filed within **ten (10) days of the designations.**
02/13/2024	Counsel meet to review pre-marked exhibits and proposed demonstrative exhibits.
02/23/2024	Parties submit joint pre-trial stipulation and witness and exhibit lists in accordance with Local Rule 16.1(d) and (e), proposed jury instructions and verdict form, or proposed findings of fact and conclusions of law, as applicable.

Motions *in Limine*. Each party is limited to filing one motion *in limine*. If all evidentiary issues cannot be addressed in a 20-page memorandum, the parties may seek leave to exceed the page limit. No reply will be filed unless ordered by the Court. **The parties are reminded that motions *in limine* must contain the Local Rule 7.1(a)(3) certification.**

***Daubert* Motions**. Each side is limited to filing one *Daubert* motion per expert, limited to 10 pages. The response shall be limited to 10 pages and no reply will be filed unless ordered by the Court. If all evidentiary issues cannot be addressed in a 10-page memorandum, the parties may seek leave to exceed the page limit. **The parties are reminded that *Daubert* motions must contain the Local Rule 7.1(a)(3) certification.**

Summary Judgment Motions. The parties are reminded that strict compliance with Local Rule 56.1 is mandated. If a party fails to comply with any of the requirements of the Local Rules, the Court may strike the deficient filing and require immediate compliance, grant an opposing party relief, or enter any other sanction the Court deems appropriate.

A motion for summary judgment and a response thereto must be accompanied by a separate statement of material facts. Each statement must be supported by *specific* references to pleadings, depositions, answers to interrogatories, admissions, and

EX. C

affidavits on file with the Court. In the event a responding party fails to controvert a movant's supported material facts in an opposing statement of material facts, the movant's material facts will be deemed admitted. *See* S.D. Fla. L.R. 56.1(b). In the interest of judicial economy, in the interest of proper and careful consideration of each party's statement of material facts, and in the interest of determining matters on summary judgment on the merits, the Court orders the parties to file statements of material facts and responses as follows:

1. The statement of material facts shall be separately filed.
2. Each material fact in the statement that requires evidentiary support shall be set forth in an individually numbered paragraph and supported by a specific citation. This specific citation shall reference pages (and paragraph or line numbers, if applicable) of the cited exhibit(s). When a material fact requires evidentiary support, **a general citation to an exhibit, without a page number or pincite, is not permitted**. A statement of fact that is non-compliant with this rule will be stricken or disregarded.
3. Each exhibit referenced in the motion for summary judgment and/or in the statement of material facts, or response, must be filed on the docket with a descriptive name (i.e., Exhibit 1: Affidavit of Boo Radley). Exhibits which have already been filed on the docket *need not be refiled*. If a deposition transcript is referenced, **a complete copy must be filed**. Within twenty-four (24) hours of filing a motion for summary judgment, the movant shall separately file an index of the cited exhibits which names each exhibit and references the docket entry at which that exhibit may be found.

Jury Instructions and Verdict Form (if applicable). The parties shall submit their proposed jury instructions and verdict form jointly, although they need not agree on each proposed instruction. Where the parties do not agree on a proposed instruction, that instruction shall be set forth in bold type. Instructions proposed only by a plaintiff shall be underlined. Instructions proposed only by a defendant shall be italicized. Every instruction must be supported by citation to authority. The parties shall use as a guide the Eleventh Circuit Pattern Jury Instructions for Civil Cases, including the directions to counsel contained therein. Proposed jury instructions and verdict form, in typed form, including substantive charges and defenses, shall be submitted to the Court prior to calendar call, in Word format, via e-mail to singhal@flsd.uscourts.gov.

Referral to Magistrate Judge. Pursuant to 28 U.S.C. § 636 and this District's Magistrate Judge Rules, all discovery matters are referred to **Judge Alicia O. Valle.** Furthermore, pursuant to 28 U.S.C. § 636(c)(1), the parties may consent to trial and final disposition by Judge Alicia O. Valle. **The deadline for submitting consent is December 6, 2023.**

Discovery. The parties may stipulate to extend the time to answer interrogatories, produce documents, and answer requests for admissions. The parties shall not file with the Court notices or motions memorializing any such stipulation unless the stipulation interferes with the deadlines set forth above. Stipulations that would so interfere may be made only with the Court's approval. *See* Fed. R. Civ. P. 29. In addition to the documents enumerated in Local Rule 26.1(b), the parties shall not file notices of depositions with the Court. The parties must make every effort to resolve discovery disputes without requiring Court intervention. The parties shall not file discovery motions except as authorized by

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the referral magistrate judge's procedures. Strict compliance with the Local Rules and the referred magistrate judge's procedures is expected, particularly with regard to motion practice. *See* S.D. Fla. L.R. 7.1.

Witness and Exhibit Lists. All exhibits shall be pre-marked and reviewed by opposing counsel prior to the calendar call. Plaintiff's exhibits will be marked numerically with a letter "P" as a prefix; Defendant's exhibits must be marked with a letter "D" as a prefix. The parties must submit a list setting out all exhibits prior to the calendar call. This list must indicate the pre-marked identification label (*e.g.,* P-1 or D-1) and include a brief description of each exhibit. Prior to filing the Pre-Trial Stipulation, the parties shall meet and confer to resolve as many issues as possible regarding the other's exhibits.

Demonstrative Exhibits. If the parties desire to use demonstrative exhibits during trial (including photos, diagrams, charts, etc.), each such item must be disclosed to the opposing party. No demonstrative exhibit may be displayed absent prior written agreement between parties or, absent such agreement, prior approval by the Court.

Technology Issues. The courtroom is equipped with computer cables, screens, and an Elmo. Parties desiring to utilize laptop computers or other electronic equipment in the courtroom shall file a motion and submit a proposed order granting such use **at least one week prior to calendar call** and should describe with specificity the equipment; (2) the make of the equipment; and (3) the identity of the person who will bring the proposed equipment. Counsel shall contact the courtroom deputy **at least one week prior to calendar call** to discuss any special equipment that may require special arrangements.

Civility and Professionalism. Members of the bar and the Court are proud of the

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long tradition of courteous practice in the Southern District of Florida. Indeed, it is a fundamental tenet of this Court that attorneys in this District be governed at all times by a spirit of cooperation, professionalism, and civility. For example, and without limiting the foregoing, it remains the Court's expectation that counsel will seek to accommodate their fellow practitioners, including in matters of scheduling, whenever reasonably possible and that counsel will work to eliminate disputes by reasonable agreement to the fullest extent permitted by the bounds of zealous representation and ethical practice.

To that end, the Court advises the parties that strict compliance with the requirements of Local Rule 7.1(a)(3) is expected. In addition, if a motion for extension of time is opposed, this Court requires that the certificate of conferral state briefly the reason(s) for opposing counsel's objection to the requested extension.

The parties are further advised that the failure to comply with any of the procedures contained in this Order or the Local Rules may result in the imposition of appropriate sanctions, including, but not limited to, the dismissal of this action or entry of default.

DONE AND ORDERED in Chambers, Fort Lauderdale, Florida, this 11th day of April 2023.

RAAG SINGHAL
UNITED STATES DISTRICT JUDGE

Copies furnished to counsel of record via CM/ECF

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