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**IN THE UNITED STATES DISTRICT COURT
FOR THE SOUTHERN DISTRICT OF INDIANA**

FILED
U.S. DISTRICT COURT
INDIANAPOLIS DIVISION

16 MAR 16 PM 3:56

**OAK MOTORS, INC.,
(Indiana)
Plaintiff,**

v.

**OAK MOTORS, INC.,
(California)
Defendant.**

Case No.:

JURY TRIAL DEMANDED

1:16-cv-0595 JMS -MJD

SOUTHERN DISTRICT
OF INDIANA
LAURA A. BRIGGS
CLERK

**OAK MOTORS, INC.'S COMPLAINT
FOR INJUNCTIVE RELIEF AND DAMAGES**

For its causes of action against defendant, Plaintiff Oak Motors, Inc., an Indiana corporation, ("Oak IN") hereby files this Complaint for Trademark Infringement and other claims against Defendant, Oak Motors, Inc. ("Oak CA") and states as follows:

JURISDICTION AND VENUE

1. The Court has subject matter jurisdiction over Oak IN's claims against Oak CA and under 15 U.S.C. § 1125 pursuant to 28 U.S.C. § 1331 and 28 U.S.C. § 1338.
2. This Court has subject matter jurisdiction over Oak IN's claims against Oak CA under pursuant to 15 U.S.C. § 1125(a) (Trademark Infringement), 15 U.S.C. §1125(d) (Cybersquatting), and 28 U.S.C. § 2201 (Creation of Remedy).
3. The Court has supplemental jurisdiction over Oak IN's claims against Oak CA pursuant to 28 U.S.C. § 1367.
4. Defendant, Oak CA, is subject to the personal jurisdiction of this Court because it has advertised and promoted its goods and services for sale within the state of Indiana and this Judicial District.
6. Venue is proper in this District pursuant to 28 U.S.C. § 1400(a) and 28 U.S.C. §§ 1391(b) and (c) because this is the judicial district where (i) a substantial part of the events or

omissions giving rise to the claims occurred; (ii) where Plaintiff resides and/or conduct business; (iii) Oak CA has caused damage to the property of Oak IN within the state of Indiana and this Judicial District, and (iv) the harm from that damage is felt within the state of Indiana and this Judicial District.

THE PARTIES

7. Upon information and belief, Defendant, Oak CA is a California corporation (entity No. C3649856, with an address located at 4075 S El Camino Real San Mateo, CA 94403.

8. Upon information and belief, Oak CA's registered agent is Jeyhun Azizaliyev and has a listed address located at 2119 Valerga Dr., Apt. #15, Belmont, CA 94002.

9. Oak IN is an Indiana corporation, having a registered address of P.O. Box 1236 Anderson, IN 46016.

10. Oak IN advertises and conducts business in Indiana, throughout the country, and within this judicial district.

11. Oak IN has retained the undersigned firm and has agreed to pay a reasonable attorney fee.

12. All conditions precedent to this action have occurred or have been waived.

13. Oak IN demands a jury trial on all issues so triable.

FACTUAL ALLEGATIONS

14. This action concerns Oak CA's unauthorized advertisement, promotion, and sale of goods and services, including automobiles, automobile financing, and related products bearing and/or in association with trademarks, or confusingly similar variations thereof, at all times owned and first used by Oak IN.

15. Oak IN is a US operator of automobile dealerships and as a part of its business buys and sells automobiles and provides financial services related to the purchase and sale of automobiles.

16. Oak IN uses and owns the common law rights and federal trademark registration for OAK MOTORS (U.S. Reg. No. 4487991) in connection with its services (**Exhibit A**) (the "OAK Mark").

17. Oak IN has used the OAK Mark in connection with its business since at least as early as December 31, 1985.

18. Apart from five primary physical locations, Oak IN also advertises and offers its goods and services for sale in association with the OAK Mark over the internet from websites located at <http://www.oakmotors.com/>. (**Exhibit B**).

19. Oak IN sells all of its goods and services under the OAK Mark and has done so continuously and without interruption, since at least as early as December 31, 1985.

20. Oak IN filed its application for federal registration of the OAK Mark on July 5, 2013.

21. The OAK Mark is arbitrary and fanciful.

22. Oak IN has generated significant goodwill and secondary meaning in the OAK Mark.

23. Consumers hold the OAK Mark in high regard and rely on the reputation of Oak IN, as embodied in the OAK Mark, when purchasing products and services offered in association with that mark.

24. Oak CA opened its business and first began infringing use of the term OAK MOTORS on February 24, 2014.

25. Oak CA was on constructive notice of Oak IN's rights in that term, as a result of Oak IN's 30+ year history of use and application for federal registration of the OAK Mark.

26. Oak CA uses the term OAK MOTORS, which is confusingly similar and or identical to the OAK Mark, in association with confusingly similar and/or identical goods and services as those offered by Oak IN in association with the OAK Mark.

27. Oak CA is a US operator of automobile dealerships and as a part of its business buys and sells automobiles and provides financial services related to the purchase and sale of automobiles.

28. In addition to its physical location, Oak CA also advertises and offers its goods and services for sale in association with the term OAK MOTORS over the internet from websites located at:

- i. <http://oakmotorsusa.com/>
- ii. <http://oakmotorsinc.com/>
- iii. <http://www.oakmotorsca.com/default.aspx>

("Collectively the Oak CA Websites" (**Exhibit C**))

29. The Oak CA Websites feature OAK MOTORS as the dominant terms and are confusingly similar to the website used by OAK IN.

30. Upon information and belief, the OAK CA Websites are calculated to cause consumer confusion as to the source of OAK CA's goods and services by causing consumers to believe that OAK CA is, is associated with, or is endorsed by, Oak IN.

31. Oak CA has no affiliation of any kind with Oak IN.

32. Oak IN has in no way given Oak CA no permission to use the OAK Mark for any purpose.

33. Oak CA has intentionally attempted to trade off the goodwill of Oak IN.

34. Upon first learning of Oak CA, Oak IN sent a cease and desist letter to Oak CA's registered agent by USPS certified mail on March 17, 2015. (Exhibit D).

35. Oak CA acknowledged receipt of Exhibit D and communicated with in-house counsel for Oak IN in March, 2015.

36. During those communications, Oak CA agreed to take down the infringing domain names and terminate all unauthorized use of the term OAK MOTORS in a manner that infringes Oak IN's OAK Mark

37. Oak CA failed to comply with that agreement and continued in its unauthorized use of the term OAK MOTORS in a manner that infringes Oak IN's OAK Mark.

38. Oak IN sent a second cease and desist letter to Oak CA's registered agent by USPS certified mail on October 29, 2015. (Exhibit E).

39. No response was received regarding the letter identified in Exhibit E.

40. Oak CA continues to use the term OAK MOTORS in an infringing manner and in violation of Oak IN's rights, including through infringing use of the Oak CA Websites.

41. Oak CA has intentionally attempted to confuse customers and potential customers of Oak IN by adopting a confusingly similar or identical trademark to the OAK Mark.

42. The existence of Oak CA and the Oak CA Websites cause initial interest confusion, and actual confusion, among consumers, misdirect consumers, and potential consumers from Oak IN's website, and cause damage to the reputation and goodwill established in the OAK Mark by Oak IN.

43. Oak CA sells and markets its goods and services to the same class of consumer that Oak IN sells and markets its goods and services.

44. Oak CA sells and markets its goods and services at the same price point and through the same channels of trade that Oak IN sells and markets its goods and services.

45. Oak CA's infringing use of the term OAK MOTORS, an identical term to the OAK Mark, to sell the same goods and services to the same class of consumers as Oak IN, is likely to cause consumer confusion and result in irreparable harm to Oak IN.

46. The similarity between the identical marks, OAK MOTORS and OAK MOTORS is self-evident: the terms are identical; the goods and services are marketed through the same channels to the same class of consumers; the goods are such that they are commonly made available for purchase through the same channels of trade; and the goods are all priced such that consumers are unlikely to exhibit a high degree of care investigating the source.

47. As a result of the foregoing, the use of OAK MOTORS by Oak CA poses a high likelihood of confusion with the OAK Mark.

48. As a result of the foregoing, consumers are likely to become confused as to the source of Oak IN and Oak CA's respective goods.

49. Upon information and belief, many instances of actual confusion exist where customers seeking Oak IN have encountered Oak CA as a result of the entities' confusingly similar trademarks and websites.

50. Since identifying Oak CA, Oak IN has attempted to resolve its growing dispute with Oak CA amicably.

51. Apart from its initial communications following the first demand letter from Oak IN, Oak CA has failed to respond to any communications from Oak IN.

52. Oak IN's OAK Mark was used in connection with the services offered by Oak IN for over 30 years prior to the existence of Oak CA.

53. The Oak Mark's federal application was filed nearly a year prior to the creation of Oak CA, and its subsequent first use of the term OAK MOTORS.

54. Oak CA has been on actual notice of Oak IN's objection to Oak CA's unauthorized use of the OAK Mark since Oak IN first became aware of Oak CA's infringing use, a date at least as early as March, 2015, around a year after the creation of Oak CA.

55. The OAK Mark owned by Oak IN is valid, enforceable, and has been used continuously in commerce since 1985.

56. Oak CA can bring no valid laches, waiver, abandonment, acquiescence, estoppel, invalidity based on genericness or descriptiveness without secondary meaning defense in this case.

57. In order to protect its brand, and left with no other option, Oak IN now files the following claims against Oak CA.

COUNT I
FALSE DESIGNATION OF ORIGIN and FALSE DESCRIPTION
15 U.S.C. § 1125(a)

58. Oak IN incorporates by reference the allegations set forth in Paragraphs 1 through 57 as though fully set forth herein.

59. Oak IN owns the rights to the mark OAK MOTORS for use with "Automobile dealerships" as well as in association with related goods and services, specifically the sale of vehicles and vehicle related financial services ("OAK Goods").

60. The OAK Mark is an arbitrary, inherently distinctive, or suggestive trademark, and/or a mark in which Oak IN has acquired a secondary meaning.

61. Oak IN has the exclusive right to sell, market, and distribute the OAK Goods in association with the OAK Mark.

62. Oak IN coined the OAK Mark and the OAK Mark has been used by Oak IN continuously and extensively in commerce in the United States since at least as early as December 31, 1985, and has become synonymous with Oak IN and the quality goods and services it provides as part of its core business.

63. Oak IN has established extensive goodwill in the OAK Mark which is uniquely associated with Oak IN in the minds of the consuming public.

64. Any association Oak CA has with the OAK Mark is a result of Oak CA's unlawful and impermissible misappropriation of the OAK Mark and Oak CA's intentional efforts to falsely associate Oak CA with Oak IN.

65. Oak IN used the Oak Mark in commerce in the United States independently of, and prior to, any infringement of the OAK Mark and/or use of the term OAK MOTORS by Oak CA.

66. Oak IN's sale of goods and services to consumers under the OAK Mark constitutes use in commerce by Oak IN.

67. Oak CA have profited from the sale of goods and services under the OAK Mark since at least as early as February 24, 2014 ("Infringing Sales").

68. The Infringing Sales, and any advertisements related thereto, were made in violation of Oak IN's rights and have irreparably damaged Oak IN and its reputation and goodwill among consumers.

69. Upon information and belief, Oak CA have intentionally deceived retailers and consumers into believing Oak CA's goods originate with, or are associated or sponsored by, Oak IN.

70. Upon information and belief, consumers of Oak CA's goods and services believed they were purchasing those goods from Oak IN or an entity associated, approved, or sponsored, with/by Oak IN.

71. Oak CA's use of the OAK Mark, or a confusingly similar mark, is a direct and proximate cause of the public's confusion as to the origin and source of Oak IN and Oak CA's products and associated goods and/or is likely to lead the public to believe that Oak CA is licensed or otherwise authorized by Oak IN to offer those products and services, including automobile dealerships, related sales, and related financial services, and is likely to continue causing such confusion, if Oak CA's actions are left unchecked.

72. Oak CA's misconduct constitutes willful and intentional trademark infringement, false advertising and false designation of origin.

73. Oak CA's unauthorized use of the OAK Mark has damaged Oak IN's reputation and resulted in significant monetary damages to Oak IN. This damage likely to continue if Oak CA's actions are left unchecked.

74. As a result of Oak CA's conduct, Oak IN has been damaged and is entitled to damages, including but not limited to, injunctive relief as well as Oak CA's profits from the sale of all infringing goods, actual damages, punitive damages, statutory damages, treble damages, costs of litigation and attorneys' fees.

**COUNT II
COMMON LAW TRADEMARK INFRINGEMENT**

75. Oak IN incorporates by reference the allegations set forth in Paragraphs 1 through 74 as though fully set forth herein.

76. Oak IN owns the common law rights to the mark OAK MOTORS for use with the OAK Goods and those goods and services related to the OAK Goods.

77. The OAK Mark is either arbitrary, inherently distinctive or suggestive, and/or a mark in which Oak IN has acquired a secondary meaning.

78. Oak CA has used the OAK Mark in violation of Oak IN's trademark rights under Federal, California, and Indiana law.

79. Oak CA's unauthorized and illegal use of the Oak Mark is a direct and proximate cause of the public's confusion as to the origin and source of Oak CA's goods and services, and associated goods and services, and/or is likely to lead the public to believe that Oak CA is licensed or otherwise authorized by Oak IN to offer those products and services bearing the OAK Mark and is likely to continue causing such confusion, if Oak CA's actions are left unchecked.

80. As a result of Oak CA's conduct and infringement, Oak IN has been damaged and is entitled to damages, including but not limited to, injunctive relief as well as Oak CA's profits from the sale of goods and services sold in association with the infringement, actual damages, statutory damages, punitive damages, treble damages, costs of litigation and attorneys' fees.

81. Oak IN is further entitled to a permanent injunction prohibiting Oak CA's unauthorized conduct.

**COUNT III
UNFAIR COMPETITION**

82. Oak IN incorporates by reference the allegations set forth in Paragraphs 1 through 81 as though fully set forth herein.

83. Oak CA's unauthorized use of the Oak Mark in connection with the OAK Goods and related goods and services constitutes unfair competition with Oak IN, because Oak CA's conduct has and will continue to deceive the relevant consuming public about the goods offered for sale by Oak IN.

84. Oak CA's unauthorized and illegal use of the OAK Mark is a direct and proximate cause of the public's confusion as to the origin and source of Oak CA's goods and services and/or is likely to lead the public to believe that Oak CA is licensed or otherwise authorized by Oak IN to offer those products and services bearing the OAK Mark, or confusingly similar marks, and is likely to continue causing such confusion if Oak CA's actions are left unchecked.

85. Oak CA's misconduct constitutes willful and intentional trademark infringement, false designation of origin, false advertising and unfair competition.

86. Oak IN has been damaged by Oak CA's wrongful use of the OAK Mark.

87. Oak CA's unauthorized use of the OAK Mark has damaged Oak IN's reputation and resulted in significant monetary damages to Oak IN. This damage likely to continue if Oak CA's actions are left unchecked.

88. Oak CA's unfair competition entitles Oak IN to recover damages including, but not limited to, Oak CA's profits from the sale of the infringing products, actual damages, corrective advertising damages, punitive damages, costs of suit and attorneys' fees.

89. Oak IN is further entitled to a permanent injunction prohibiting Oak CA's unauthorized conduct.

**COUNT IV
CYBERSQUATTING
15 U.S.C. §1125(d)**

90. Oak IN incorporates by reference the allegations set forth in Paragraphs 1 through 89 as though fully set forth herein.

91. Oak CA has registered or renewed in bad faith internet domain registrations and social media addresses containing the OAK Mark, or a confusingly similar variation thereof. These include but are not limited to the Oak CA Websites.

92. Oak CA's registration or renewal of these internet domains and social media accounts is in violation of Oak IN's rights under 15 U.S.C. § 1125(d), and as a result Oak IN has been damaged by Oak CA's intentional and reckless misconduct.

93. Oak IN is entitled to assignment and ownership of all internet domains owned or controlled by Oak CA that include the term OAK MOTORS, or any confusingly similar term.

94. Oak IN is entitled to its damages, including punitive and statutory damages, attorneys' fees and costs incurred in connection with these wrongful acts.

95. Oak IN is further entitled to a permanent injunction prohibiting Oak CA's unauthorized conduct.

**COUNT V
DECLARATORY JUDGMENT**

96. Oak IN incorporates by reference the allegations set forth in Paragraphs 1 through 95 as though fully set forth herein.

97. Oak IN seeks Declaratory Judgment that:

- (1) Oak CA has no intellectual property rights in the term OAK MOTORS as a trademark or otherwise;
- (2) Oak CA has no intellectual property rights to any other trademark owned by Oak IN;
- (3) Oak IN is the only owner of the OAK Mark and has priority over Oak CA in the trademark use of that mark; and
- (4) The OAK Mark is:
 - I. valid and enforceable;
 - II. has been in continuous use by Oak IN since at least as early as December 31, 1985;
 - III. has never been abandoned; and
 - IV. is arbitrary and/or fanciful; or is descriptive with secondary meaning.

98. By this count, Oak IN also seeks judgment that Oak CA is barred from advancing any claims against Oak IN inconsistent with these findings.

99. By this count, Oak IN seeks permanent injunction, as well as judgment, barring Oak CA from using the subject marks and related trade dress in association with the OAK Goods or related goods and/or services.

100. Oak IN seeks its attorneys' fees and costs in prosecuting this claim.

JURY DEMAND

Oak IN hereby demands a trial by jury of all issues raised in this action.

PRAYER FOR RELIEF

WHEREFORE, Oak IN, in addition to the relief requested above, respectfully requests the following relief:

A. A permanent injunction providing that Oak CA, its owners, officers, directors, agents, servants, employees, representatives, licensees, subsidiaries, manufacturers and distributors, jointly and severally, be enjoined throughout the world from:

(i) Using and/or Infringing the OAK Mark in any manner, including in any corporate name or website internet domain; and

(ii) Manufacturing, marketing, advertising, distributing, selling, promoting, licensing, exhibiting or displaying any product or service using the OAK Mark or any copies or counterfeits thereof or anything confusingly similar thereto; and

(iii) Otherwise infringing on the OAK Mark; and

(iv) Using any false description, representation, or designation, or otherwise engaging in conduct that is likely to create an erroneous impression that Oak CA's products are endorsed by Oak IN or any related company, sponsored by Oak IN or any related company, or are connected in any way with Oak IN or any related company; and

(v) Interfering in the existing contracts or business expectancies of Oak IN in any manner whatsoever; and

(vi) Holding themselves out as a licensee or otherwise authorized user of the OAK Mark;

(vii) Using the OAK Mark in promotional literature or materials, including those posted on the Internet; and

(viii) Such other and further relief to which Oak IN may show itself otherwise entitled.

B. Awarding transfer to Oak IN of all rights and interests Oak CA may have in any and all websites or domain names referencing the OAK Mark or any similar mark, including the Oak CA Websites.

C. Awarding actual damages in Oak IN's favor for all damages sustained as a result of Oak CA's wrongdoing in an amount to be proven at trial, including interest;

D. Awarding Oak CA's profits in favor of Oak IN for all profits obtained by Oak CA in an amount to be proven at trial, including interest;

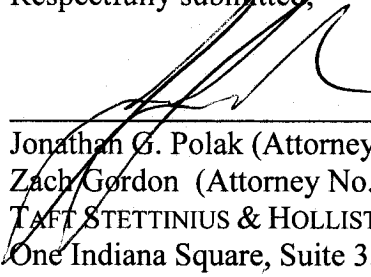
E. Awarding treble, statutory or punitive damages to Oak IN;

F. Awarding Oak IN reasonable costs and expenses incurred in this action, including attorneys' fees and expert fees;

G. Permanently enjoining Oak CA from the activities which caused injury to Oak IN as set forth herein; and

H. Such other relief as the Court may deem just and proper.

Respectfully submitted,



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