

**IN THE UNITED STATES DISTRICT COURT
FOR THE NORTHERN DISTRICT OF INDIANA
FORT WAYNE DIVISION**

NORTH AMERICAN VAN LINES, INC.,

Plaintiff,

v.

NORTH AMERICA MOVING & STORAGE,
INC.,

Defendants.



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Case No. 18-cv-196

JURY TRIAL DEMANDED

COMPLAINT FOR TRADEMARK INFRINGEMENT

Plaintiff North American Van Lines, Inc. (“NAVL”) states the following for its Complaint against Defendant North America Moving & Storage, Inc. (“Defendant”):

NATURE OF THE ACTION

1. This is a civil action arising under the United States Trademark Act of 1946, as amended, 15 U.S.C. § 1051, *et seq.* (“Lanham Act”) for willful trademark infringement, cybersquatting under the Anticybersquatting Consumer Protection Act (“ACPA”), 15 U.S.C. § 1125 *et seq.*, violation of the Indiana Trade Secrets Act and common law unfair competition.

2. NAVL and Defendant are in the business of selling and/or offering for sale transportation services.

3. NAVL markets and provides its transportation services under the trademark NORTH AMERICAN and the trade name NORTH AMERICAN VAN LINES (collectively, the “NAVL Marks”).

4. NAVL has been marketing and selling its transportation services using the NAVL Marks since at least as early as 1969, and it owns several federal registrations for the mark. NAVL has expended considerable resources in building the goodwill associated with its famous NAVL Marks in connection with transportation services. NAVL markets its transportation services through its websites located at www.northamericanvanlines.com and www.northamerican.com.

5. Defendant is operating under the name North America Moving Systems and marketing itself through an interactive website under the domain name northamericamoving.com, obviously intending to mimic NAVL's northamerican.com and northamericavanlines.com domain names.

6. Defendant's use of a confusingly similar company name to market its transportation services through a domain name that is confusingly similar to NAVL Marks is a blatant and willful violation of NAVL's trademark rights.

7. Defendant's use of the NORTH AMERICA and NORTH AMERICA MOVING SYSTEMS marks ("Infringing Marks") infringe on the NAVL Marks, has caused confusion among consumers, and has resulted in damages to NAVL and has diminished its goodwill and reputation.

8. NAVL has experienced instances of actual confusion whereby consumers have had negative experiences with Defendant and erroneously believed that Defendant was NAVL.

9. As of the filing of this Complaint, Defendant is still infringing the NAVL Marks and operating a website under the northamericamoving.com domain name.

10. NAVL brings this action for federal trademark infringement and unfair competition under Sections 32 and 43(a) of the Lanham Act, 15 U.S.C. §§ 1114, 1125(a),

cybersquatting under the Anticybersquatting Consumer Protection Act (ACPA), 15 U.S.C. § 1125 *et seq.*, violation of the Indiana Trade Secrets Act and unfair competition under Indiana's common law.

PARTIES

11. Plaintiff North American Van Lines, Inc. is a Delaware corporation with its principal place of business located at 101 E. Washington Blvd., Suite 1100, Fort Wayne, IN 46802.

12. Defendant North America Moving, Inc. is a Florida corporation with its principal place of business located at 6538 Collins Ave, Miami Beach, Florida 33141

13. Defendant is the owner of the northamericamoving.com domain name.

JURISDICTION AND VENUE

14. This action arises under 15 U.S.C. §§ 1114 and 1125(a) & (d) and under the common law of the state of Illinois. This Court has subject matter jurisdiction over these claims pursuant to 28 U.S.C. § 1331 (federal question), 15 U.S.C. § 1121 (Lanham Act claims), and 28 U.S.C. § 1367 (supplemental jurisdiction over pendant state law claims). This Court also has subject matter jurisdiction over this action under 28 U.S.C. § 1332(a)(1) as this action is between citizens of different states and the amount in controversy exceeds \$75,000, exclusive of interest and costs.

15. This Court has may exercise personal jurisdiction over Defendant under the Indiana Long-Arm Statute, because the Defendant has transacted business in Indiana and caused an injury in this state by marketing their transportation services to Indiana consumers using the Infringing Marks through its interactive websites located at www.northamericamoving.com.

16. Venue is proper in this District pursuant to 28 U.S.C. §1391(b)(2) because a substantial part of the events and omissions giving rise to this claim occurred here; and (b) the Defendant is subject to personal jurisdiction here. Further, Defendant has committed acts of infringement, cybersquatting, and unfair business practices in this district, and has caused injury in this district.

17. This case involves an amount in controversy in excess of seventy-five thousand dollars (\$75,000.00) for the damages suffered by NAVL directly, exclusive of costs and interest.

FACTS COMMON TO ALL CLAIMS
NAVL's Trademark Rights

18. NAVL is, and was at all times relevant hereto, engaged in selling and providing transportation services, including moving services.

19. The NORTH AMERICAN mark has been registered on the Principal Register of the United States Patent and Trademark Office since in 1971. A copy of Certificates of Registration for the NORTH AMERICAN mark are attached as **Exhibit A**.

20. NAVL has continuously marketed and performed its transportation services throughout the United States, including this judicial district.

21. NAVL has spent millions of dollars to advertise, promote and sell its services using the NAVL Marks. Based on NAVL's consistent and extensive use, the NAVL Marks have become widely and favorably known, have become famous, and have acquired extensive goodwill.

22. NAVL is currently, and at all relevant times hereto, has been the exclusive owner of all property rights in the NAVL Marks.

23. The NAVL Marks have been in continuous use since 1971 and its registrations are now incontestable under 15 U.S.C. § 1065.

24. Under the Lanham Act, NAVL has exclusive rights to the registered NORTH AMERICAN marks with respect to the services identified in the registrations. In addition, the incontestable status of the registrations serve as conclusive evidence of NAVL's right to use the NORTH AMERICAN mark in commerce, pursuant to 15 U.S.C. § 1115(b), in connection with transportation services.

25. NAVL has extensively advertised and promoted the NAVL Marks in association with its business. For example, NAVL has permanently displayed the NAVL Marks on trucks, trailers, shipping materials, sales contracts, on business signs located on the premises of authorized NAVL agents, and in yellow page listings, advertisements, brochures and on its websites located at www.northamericanvanlines.com and www.northamerican.com.

26. As a result of NAVL's continuous use of the NAVL Marks in connection its advertising, promotion, distribution, and sale of transportation services, the general consuming public has come to recognize the NAVL Marks as originating from and used by NAVL, and to associate and identify the services offered and sold under the NAVL Marks exclusively with NAVL. NAVL derives an invaluable goodwill from this recognition, association, and identification by the consuming public.

Defendant's Infringing Use and Unfair Competition

27. Defendant's misappropriation of the NAVL Marks and its methods of unfair competition are blatant.

28. The transportation services offered by Defendant directly compete with those sold by Defendant under the NAVL Marks and the services are sold through overlapping channels of trade, primarily over the Internet.

29. The Infringing Marks used by Defendant are confusingly similar to the NAVL Marks, and have already caused actual confusion amongst consumers as to the source of the transportation services advertised and sold by Defendant.

30. Particularly, the Infringing Marks and NAVL Marks are similar in appearance, similar in sound, and similar in meaning.

31. The overall impression created by Defendant is that it is the same company as NAVL. In fact, Defendant's websites copies the blue and red color scheme used on NAVL's website to create the false impression that Defendant's website originates from or is sponsored or endorsed by NAVL.

32. NAVL has also received information and documentation evidencing that Defendant has been misrepresenting itself as NAVL.

33. Defendant has knowingly, willfully, intentionally, and maliciously made and continues to make use of the Infringing Marks to falsely suggest that Defendant's transportation services originate from or are sponsored or endorsed by NAVL with full knowledge of NAVL's rights in the NAVL Marks.

34. Defendant's actions have harmed, and will continue to harm, NAVL's reputation and goodwill associated with the NAVL Marks, and result in additional injury that cannot entirely be quantified or captured.

Defendant's Cybersquatting

35. Defendant registered the northamericamoving.com domain name in bad faith with actual knowledge of NAVL's rights in the NAVL Marks.

36. Moreover, Defendant has used, and continues to use, the northamericamoving.com domain name to confuse consumers and divert consumers from NAVL's business by directing them to the www.northamericamoving.com website.

37. The northamericamoving.com domain name is confusingly similar to the NAVL Marks, which are owned by NAVL.

38. Defendant acted with a bad faith intent to profit from his registration and use of the northamericamoving.com domain name. In addition, Defendant's violations of the NAVL Marks demonstrates an intent to divert customers from NAVL's online location for commercial gain.

COUNT ONE -
Federal Trademark Infringement
(Lanham Act Section 32 (15 U.S.C. §§ 1114))

39. NAVL restates the preceding paragraphs as if fully incorporated herein.

40. NAVL owns all right, title and interest in and to the NAVL Marks and holds federal registrations for the NORTH AMERICAN mark.

41. Defendant's use of the Infringing Marks has caused and is likely to continue to cause confusion, deception, and mistake by creating the false and misleading impression that Defendant's transportation services originate from NAVL, are associated or connected with NAVL, or have the sponsorship, endorsement, or approval of NAVL.

42. Defendant has used marks confusingly similar to NAVL's federally registered marks in violation of 15 U.S.C. §1114, and Defendant's activities have caused and, unless enjoined by this Court, will continue to cause a likelihood of confusion and deception among consumers and, additionally, cause injury to NAVL's goodwill and reputation as symbolized by the federally registered NAVL Marks, for which NAVL has no adequate remedy at law.

43. Defendant's actions are and were an intentional, willful, and malicious intent to trade on the goodwill associated with NAVL's federally registered NORTH AMERICAN mark, to NAVL's great and irreparable injury.

44. Defendant has caused and is likely to continue to cause substantial injury to consumers and to NAVL, and NAVL is entitled to injunctive relief and to recover Defendant's profits, actual damages, trebled profits and damages, costs, and reasonable attorney's fees under 15 U.S.C. §§ 1114, 1116 and 1117.

COUNT TWO
Federal Unfair Competition
(Lanham Act Section 43(a) (15 U.S.C. §1125(a))

45. NAVL restates the preceding paragraphs as if fully incorporated herein.

46. NAVL owns all rights, title and interest in and to the NAVL Marks.

47. Defendant's use of the Infringing Marks has caused and is likely to continue to cause confusion, deception, and mistake by creating the false and misleading impression that Defendant's transportation services originate from NAVL, are associated or connected with NAVL, or have the sponsorship, endorsement, or approval of NAVL.

48. Defendant has made false representations, false descriptions, and false designations of origin of its services, and have infringed NAVL's rights in the NAVL Marks, in violation of 15 U.S.C. § 1125(a), and Defendant's activities have caused and, unless enjoined by this Court, will continue to cause a likelihood of confusion and deception among consumers and, additionally, cause injury to NAVL's goodwill and reputation as symbolized by the NAVL Marks, for which NAVL has no completely adequate remedy at law.

49. Defendant's actions are and were an intentional, willful, and malicious intent to trade on the goodwill associated with the NAVL Marks, to NAVL's great and irreparable injury.

50. Defendant has caused and is likely to continue to cause substantial injury to the public and to NAVL, and NAVL is entitled to injunctive relief and to recover Defendant's profits, actual damages, costs, and reasonable attorney's fees under 15 U.S.C. §§ 1125(a), 1116 and 1117.

COUNT THREE
Anticybersquatting Consumer Protection Act
(15 U.S.C. §1125(d))

51. NAVL restates the preceding paragraphs as if fully incorporated herein.

52. NAVL is informed and believes that Defendant registered and is using the northamericamoving.com domain name in bad faith.

53. The NAVL Marks were distinctive and incontestable at the time of Defendant's registration of the northamericamoving.com domain name.

54. The northamericamoving.com domain name is confusingly similar to the NAVL Marks.

55. NAVL owns common law rights to the NAVL Marks and has registrations for the NORTH AMERICAN mark with the United States Patent and Trademark Office.

56. Defendant has no bona fide use of the northamericamoving.com domain name.

57. Defendant's intent in registering and using the northamericamoving.com domain name was and is to divert consumers from the NAVL's online location to Defendant's website solely to harm the goodwill of the NAVL Marks and NAVL for commercial gain by creating a likelihood of confusion as to the source, sponsorship, affiliation, or endorsement of the content of the Defendant website.

58. Defendant is using the northamericamoving.com domain name without authorization from NAVL and with the bad faith intent to mislead and deceive the public.

59. The aforesaid actions constitute cyberpiracy in violation of § 43(d) of the Lanham Act, 15 U.S.C. § 1125(d).

60. Defendant's unauthorized registration and use of the northamericamoving.com domain name has, is, and, unless remedied, will continue to cause injury to NAVL and the goodwill NAVL has built in the NAVL Marks and its business reputation.

61. NAVL has no adequate remedy at law.

COUNT FOUR
INDIANA TRADEMARK INFRINGEMENT
(IN Code § 24-2-1-13 (2017))

62. NAVL restates the preceding paragraphs as if fully incorporated herein.

63. Defendant is using, without the consent of NAVL a reproduction, counterfeit, copy or colorable imitation of the NAVL's Marks in the connection with the sale, offering for sale, distribution and advertising of goods and services.

64. Defendant's use of the Infringing Marks has caused and is likely to continue to cause confusion, deception, and mistake by creating the false and misleading impression that Defendant's services originate from NAVL, are associated or connected with NAVL, or have the sponsorship, endorsement, or approval of NAVL.

65. Defendant has reproduced, counterfeited, copied or colorably imitated NAVL's Marks and applied it to materials and advertisements intended to be used in connection with the sale or other distribution of the goods or services and/or on the goods and services in Indiana.

66. NAVL has sustained injury to its business' reputation and goodwill, and Defendant has unlawfully derived income and profits from its wrongful acts.

67. Defendant's acts have been committed with the intent to cause deception, confusion or mistake.

68. By virtue of the aforementioned acts, Defendant has engaged in conduct in violation of the Indiana Trademark Infringement Act.

69. NAVL is entitled to all remedies set forth in IN Code § 24-2-1-14 (2017), including, but not limited to, an order of the court enjoining the use by Defendant of NAVL's Marks, enjoining Defendant from the sale of any goods or services identified by the Marks, and such other injunctive relief as the court considers just and reasonable. NAVL is entitled to treble damages for the greater of three times the profits derived from or three times actual damages based on Defendant's intentional misuse of NAVL's Marks and costs and attorney's fees.

COUNT FIVE
(Common Law Unfair Competition)

70. NAVL restates the preceding paragraphs as if fully incorporated herein.

71. NAVL owns all right, title and interest in and to the NAVL Marks. Defendant is not authorized to use NAVL's Marks or any variation thereof, or any mark confusingly similar to the NAVL Marks.

72. The NAVL Marks are inherently distinctive.

73. Defendant's use of the Infringing Marks has caused and is likely to cause confusion, deception, and mistake by creating the false and misleading impression that Defendant's transportation services originate from NAVL, or are associated or connected with NAVL, or have the sponsorship, endorsement, or approval of NAVL.

74. Defendant has created, promoted and advertised with the Infringing Marks in violation of and with knowledge of NAVL's rights to the NAVL Marks for the purpose of trading upon NAVL's goodwill and reputation.

75. The natural and probable tendency and effect of Defendant's conduct is to deceive the public so as to pass off the services or business of Defendant as and for that of NAVL.

76. Defendant has caused and is likely to continue to cause substantial injury to the NAVL and the public, and NAVL is entitled to injunctive relief and to recover Defendant's profits from the sale of the infringing goods and services, actual damages, corrective advertising damages, costs and reasonable attorney's fees.

77. Defendant's wrongful conduct was willful and deliberate or recklessly indifferent to the rights of NAVL, warranting an award of punitive damages under Indiana common law.

78. NAVL is also entitled to preliminary and permanent injunctive relief.

CONCLUSION

WHEREFORE, NAVL prays the Court enter judgment in its favor and against Defendant as follows:

1. That Defendant violated 15 U.S.C. §§ 1114(a), 1125(a) and 1125(d) and other statutory and common law authority referenced herein, including unfair competition, committing trademark infringement, cybersquatting, directly, contributorily and/or vicariously by knowing and intentional unauthorized use of the NAVL Marks;
2. That the Court permanently restrain and enjoin Defendant, its agents, servants, employees, and other persons in active concert with Defendant from any and all further use of the Infringing Marks or any other mark confusingly similar to the NAVL Marks;
3. That the Court permanently restrain and enjoin Defendant, their agents, servants, employees, and other persons in active concert with Defendants, from any and all further use of any domain name incorporating the words "northamerica" or "northamerican;

4. That the Court enter an order directing Defendant to engage in such advertisements as reasonably required to correct the misinformation in the marketplace that it is associated with NAVL and give notice to all of Defendant's customers that it is not associated with NAVL;
5. That NAVL be awarded all damages, trebled, incurred as a direct and proximate cause of Defendant's unlawful conduct;
6. That NAVL recover from Defendant all amounts, including treble profits, received by Defendant as a direct and proximate cause of Defendant's unlawful conduct;
7. That NAVL recover from Defendant exemplary and punitive damages, based on its willfulness and/or reckless indifference to NAVL's trademark rights, available under Indiana statute and common law;
8. That Defendants pay NAVL's reasonable attorney's fees, based on their willful and deliberate conduct in this exceptional case pursuant to 15 U.S.C. § 1117(a) and IN Code § 24-2-1-14 (2017);
9. That NAVL be awarded prejudgment interest;
10. That NAVL be awarded post-judgment interest;
11. That the Court find Defendant registered and used the northamericamoving.com domain name in violation of the ACPA and order Defendant to transfer the northamericamoving.com domain name to NAVL and order Defendant to pay NAVL \$100,000 in statutory damages;
12. That, pursuant to 15 U.S.C. § 1116, Defendant be directed to file with the Court and serve upon NAVL within thirty (30) days after issuance of an injunction, a report in

writing and under oath setting forth in detail the manner and form in which Defendant has complied with the injunction; and

13. That the Court grant NAVL such other and further relief as the Court may deem just and proper.

REQUEST FOR JURY TRIAL

NAVL requests a jury trial for all causes of action so triable.

Dated: June 26, 2018

Respectfully Submitted,

By: /s/ Mary A. Smigielski

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