

UNITED STATES DISTRICT COURT
NORTHERN DISTRICT OF INDIANA
FORT WAYNE DIVISION



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SUPER 8 WORLDWIDE, INC.,)	
)	
Plaintiff,)	
)	
v.)	Civil Action No.: 1:19-cv-145
)	
HARVEE PROPERTIES, LLC and)	
PARESH PATEL,)	
)	
Defendants.)	

VERIFIED COMPLAINT

Plaintiff Super 8 Worldwide, Inc., by its attorneys, James Hinshaw and Andrew Pendexter, complaining of defendants, Harvee Properties, LLC and Paresh Patel says:

PARTIES AND SUBJECT MATTER JURISDICTION

1. Plaintiff Super 8 Worldwide, Inc. (“SWI”) is a corporation organized and existing under the laws of the State of South Dakota, with its principal place of business in Parsippany, New Jersey.
2. Defendant Harvee Properties, LLC (“Harvee”), on information and belief is a limited liability company organized and existing under the laws of the State of Indiana, having an address at 503 Ley Drive, Auburn, Indiana 46706.
3. Defendant Paresh Patel (“Patel”), on information and belief, is a citizen of Indiana, having an address at 225 Touring Drive, Auburn, Indiana 46706.
4. This Court has subject matter jurisdiction over this action pursuant to 28 U.S.C. §§ 1331 & 1338, 15 U.S.C. § 1121 and, with respect to certain claims, 28 U.S.C. § 1367.

5. Venue is proper in this District pursuant to 28 U.S.C. § 1391(b). The defendant resides in and/or conducts business in this District. A substantial part of the events giving rise to this action occurred in this District, and the majority of the subject property is located herein.

ALLEGATIONS COMMON TO ALL COUNTS

The Super 8® Marks

6. SWI is one of the largest guest lodging facility franchise systems in the United States, and is widely known as a provider of guest lodging facility services.

7. SWI owns and has the exclusive right to license the use of the service mark SUPER 8® and various related trade names, trademarks and service marks (certain of which are on the principal register of the United States Patent and Trademark Office), logos, and derivations thereof (the “Super 8® Marks”), as well as the distinctive Super 8® System, which provides guest lodging services to the public under the Super 8® name and certain services to its franchisees, including a centralized reservation system, advertising, publicity, and training services.

8. SWI or its predecessors first used the SUPER 8 MOTEL mark in 1973, and the Super 8® Marks are in full force and effect. The registered Super 8® Marks listed below are incontestable pursuant to 15 U.S.C. § 1065.

9. SWI has given notice to the public of the registration of the Super 8® Marks as provided in 15 U.S.C. § 1111.

10. SWI uses or has used the Super 8® Marks as abbreviations of its brand name.

11. SWI has registered the Super 8® Marks as service marks with the US Patent and Trademark Office (“USPTO”) and owns, among others, the following valid service mark registrations for the Super 8® Marks:

MARK	LOGO	REGISTRATION NO	REGISTRATION DATE	CLASS
SUPER 8		1602723	Apr-21-2009	35, 42
SUPER 8 & Design (b/w)		3610108	Apr-21-2009	35, 43
SUPER 8 & Design (Color)		3610109	Apr-21-2009	35, 43
SUPER 8 HOTEL & Plaque Design		1951982	Jan-23-1996	42
SUPER 8 MOTEL & Design		1128057	Dec-18-1979	42

12. The USPTO registrations for the Super 8® Marks are valid and subsisting and in full force and effect and appear on the Principal Trademark Register of the USPTO. All of the above listed Super 8 ® Marks have achieved incontestable status pursuant to the Lanham Act, 15 U.S.C. § 1065. Such incontestable federal registrations for the Super 8® Marks constitute conclusive evidence of the validity of the Super 8® Marks and SWI’s ownership of the Super 8® Marks and the exclusive right to use the marks nationwide.

13. Through its franchise system, SWI markets, promotes, and provides services to its guest lodging franchisees throughout the United States. In order to identify the origin of their guest lodging services, SWI allows its franchisees to utilize the Super 8® Marks and to promote the Super 8® brand name.

14. SWI has invested substantial effort over a long period of time, including the expenditure of millions of dollars, to develop goodwill in its trade names and service marks to cause consumers throughout the United States to recognize the Super 8® Marks as distinctly designating SWI guest lodging services as originating with SWI.

15. The value of the goodwill developed in the Super 8® Marks does not admit of precise monetary calculation, but because SWI is one of the largest guest lodging facility franchise systems in the United States and is widely known as a provider of guest lodging facility services, the value of SWI's goodwill exceeds hundreds of millions of dollars.

16. The Super 8® Marks are indisputably among the most famous in the United States.

FACTUAL ALLEGATIONS

17. On or about March 31, 2017, SWI entered into a franchise agreement (the "Franchise Agreement") with Amrex Receivers, LLC ("Amrex Receivers") for the operation of a 51-room Super 8® guest lodging facility located at 503 Ley Drive, Auburn, Indiana 46706 (the "Facility"). A true copy of the Franchise Agreement is attached hereto as Exhibit A.

18. Pursuant to section 5 of the Franchise Agreement, Amrex Receivers was obligated to operate a Super 8® guest lodging facility for a twenty-year term, during which time Amrex Receivers was permitted to use the Super 8® Marks in association with the operation and use of the Facility as part of SWI's franchise system.

19. On or about December 4, 2017 Amrex Receivers terminated the Franchise Agreement, thereby terminating Amrex Receivers' right to use the Super 8® Marks in association with the operation and use of the Facility as part of SWI's franchise system.

20. By letter dated December 29, 2017, a true copy of which is attached hereto as Exhibit B, SWI acknowledged Amrex Receivers' unilateral termination of the Franchise Agreement, effective December 4, 2017, and advised Amrex Receivers that (a) it was to immediately discontinue the use of all trade names, service marks, signs, and other forms of advertising, and other indicia of operation as a Super 8® facility, and to discontinue the use of other materials on the premises effectively to distinguish the same from its former appearance as a Super 8® facility, (b) all items bearing the Super 8® Marks had to be removed, (c) all signs and any listings in directories and similar guides in which the Facility was identified as a Super 8® had to be changed, and (d) it had to de-identify the Facility within 10 days from the receipt of the notice.

21. Upon information and belief, Amrex Receivers lost possession of the Facility.

22. Upon information and belief, Harvee and Patel ("Defendants") obtained possession of the Facility on or about March 14, 2018.

23. Defendants have continued to use the Super 8® Marks, and/or names and marks confusingly similar to the Super 8® Marks, to induce the traveling public to rent guest rooms at the Facility.

24. To rent rooms at the Facility, Defendants have used the Super 8® Marks, and/or names and marks that are confusingly similar to the Super 8® Marks, without authorization through, among other things, their failure to remove Super 8® signage and continuing to identify the Facility as a Super 8® guest lodging facility.

25. By letter dated September 14, 2018, a true copy of which is attached as Exhibit C, SWI advised Defendants that they were to immediately cease and desist from using the Super 8® Marks, and/or names and marks that are confusingly similar to the Super 8® Marks.

26. By letter dated October 18, 2018, a true copy of which is attached as Exhibit D, counsel for SWI advised Defendants that they were required to immediately cease and desist the misuse of the Super 8® Marks, and cease to represent that they have a relationship with SWI.

27. Defendants have refused SWI's attempts to exercise its contractual right of self-help to remove all signage at and around the Facility bearing the Super 8® Marks.

28. Defendants have continued to misuse the Super 8® Marks despite receiving notification from SWI to cease and desist from the misuse of the Super 8® Marks.

FIRST COUNT

Service Mark Infringement under the Lanham Act (15 U.S.C. § 1114)

29. SWI repeats and makes a part hereof each and every allegation set forth in paragraphs 1 through 28 of the Verified Complaint.

30. SWI is the owner of the Super 8® Marks that are the subjects of the registrations described in Paragraph 11 of this Verified Complaint.

31. SWI uses the Super 8® Marks in commerce in connection with the offering for guest lodging services and related services.

32. SWI's Super 8® Marks are prima facie valid and SWI's rights in certain of the Super 8® Marks are incontestable.

33. Defendants have used and continue to use service marks in interstate commerce for their guest lodging services, which marks are confusingly similar to SWI's Super 8® Marks, without SWI's consent.

34. Defendants' actions are likely to cause, have caused, and will continue to cause confusion, mistake, and deception in the minds of customers as to the source or origin of Defendants' services.

35. Defendants' conduct described herein constitutes service mark infringement under 15 U.S.C. § 1114.

36. Upon information and belief, Defendants acted with full knowledge that their actions were intended to be used to cause confusion, mistake, and to deceive consumers, which constitutes a willful violation of 15 U.S.C. § 1114.

37. On information and belief, Defendants had knowledge of, directed, controlled, supervised, acted in concert with, and/or took action that contributed to these unlawful activities.

SECOND COUNT

False Designation of Origin under the Lanham Act (15 U.S.C. § 1125)

38. SWI repeats and makes a part hereof each and every allegation contained in paragraphs 1 through 37 of the Verified Complaint.

39. Defendants have used the name and mark "Super 8" in interstate commerce in connection with offering guest lodging services.

40. Defendants' use of the mark "Super 8" has caused and is likely to continue to cause confusion or mistake, or to deceive consumers and potential consumers, the public and the trade who recognize and associate SWI with the Super 8® Marks and are likely to believe that there is an affiliation, connection, or association between Defendants and SWI when there is no such affiliation, connection, or association, in violation of the Lanham Act, 15 U.S.C. § 1125(a).

41. On information and belief, Defendants had knowledge of, directed, controlled, supervised, acted in concert with, and/or took action that contributed to these unlawful activities.

42. Defendants' activities constitute false designation of origin within the meaning of 15 U.S.C. § 1125(a).

43. SWI has been injured by Defendants' false and misleading advertising in violation of 15 U.S.C. § 1125(a).

44. Upon information and belief, Defendants acted willfully, with full knowledge of SWI's rights in the Super 8® Marks, and those acts constitute a willful violation of 15 U.S.C. § 1125(a).

THIRD COUNT

Counterfeit of Registered Mark under the Lanham Act (15 U.S.C. § 1114(1)(a))

45. SWI repeats and makes a part hereof each and every allegation contained in paragraphs 1 through 44 of the Verified Complaint.

46. Section 32 of the Lanham Act, 15 U.S.C. § 1114(1)(a), provides in pertinent part that “[a]ny person who shall, without the consent of the registrant — use in commerce any reproduction, counterfeit, copy, or colorable imitation of a registered mark in connection with the sale, offering for sale, distribution, or advertising of any goods or services on or in connection with which such use is likely to cause confusion, or to cause mistake, or to deceive . . . shall be liable in a civil action by the registrant”

47. The Lanham Act, 15 U.S.C. § 1116(d)(1)(B)(i), defines a counterfeit mark as “a mark that is registered on the Principal Register in the United States Patent and Trademark Office for such goods and services sold, offered for sale, or distributed and that is in use, whether or not the person against whom relief is sought knew such mark was so registered.”

48. Defendants marketed, promoted, and rented, and continue to market, promote, and rent rooms at the Facility through the use of counterfeit Super 8® Marks, and such use caused and is likely to continue to cause confusion or mistake among prospective or actual customers, in violation of Section 32 of the Lanham Act.

49. The acts of Defendants in marketing, promoting, and renting rooms at the Facility through and with the counterfeit Super 8® Marks were intentional.

50. Defendants intentionally used the counterfeit Super 8® Marks in marketing, promoting, and renting rooms at the Facility with knowledge that the marks were counterfeit.

51. Defendants' on-going use of counterfeit Super 8® Marks in violation of Section 32 of the Lanham Act is intentional, malicious, fraudulent, willful, and deliberate.

52. Defendants' on-going use of counterfeit Super 8® Marks in violation of Section 32 of the Lanham Act has inflicted and continues to inflict irreparable harm on SWI.

53. SWI has no adequate remedy at law.

54. No previous injunctive relief has been awarded with respect to this matter in this case or any other case.

FOURTH COUNT

Trademark Infringement Under Indiana Law

55. SWI repeats and makes a part hereof each and every allegation contained in paragraphs 1 through 54 of the Verified Complaint.

56. Defendants have used confusingly similar service marks in connection with the sale or offering of their guest lodging services that are likely to cause confusion as to the source or origin of the services.

57. Defendants imitated SWI's Super 8® Marks by using them in connection with their guest lodging services, including signage.

58. Upon information and belief, Defendants knowingly acted with the intent to cause confusion between their services and SWI's services in violation of IC § 24-2-1-13.5.

59. Defendants' actions have injured SWI by misappropriating its business and/or impairing the goodwill associated with SWI's business conducted under the Super 8® Marks.

60. Upon information and belief, Defendants intend to continue their infringing actions unless restrained by this Court.

FIFTH COUNT

Unfair Competition Under Indiana Law

61. SWI repeats and makes a part hereof each and every allegation contained in paragraphs 1 through 60 of the Verified Complaint.

62. Defendants have unfairly profited by using the Super 8® Marks or confusingly similar marks to promote their own services by including the marks on signage and other indicators of commercial source without SWI's authorization.

63. Defendants have been unjustly enriched and SWI has suffered damages from Defendants' violations of Indiana's statutory and common laws.

64. Upon information and belief, Defendants have made and will continue to make substantial profits and gains to which they are not entitled at law or in equity as a result of their infringing conduct.

65. Defendants' conduct described herein constitutes unfair competition under the common law of the State of Indiana pursuant to IC § 24-2-1-2.

66. SWI has been damaged as a result of the actions of Defendants in violation of Indiana Law pursuant to IC §§ 24-2-1-13-IC 24-2-1-13.5.

PRAYER FOR RELIEF

WHEREFORE, SWI respectfully requests that this Court enter the following legal and equitable relief in favor of SWI and against Defendants as a result of their infringing conduct and their unfair competition practices:

A. A Judgment declaring that:

(1) Defendants have intentionally infringed the Super 8® Marks in violation of the Lanham Act and Indiana Law;

(2) Defendants' actions have caused and will continue to cause confusion in the marketplace and constitute false designation of origin and unfair competition in violation of the Lanham Act and Indiana Law;

B. Entering a preliminary and permanent injunction enjoining and restraining Defendants and their affiliated and/or parent companies and their officers, agents, servants and other employees from using in commerce or in connection with any goods or services any mark, name or design that creates a likelihood of confusion with the Super 8® Marks and from engaging in any other acts of unfair competition and in engaging in false designation of origin;

C. Awarding SWI all direct damages, indirect damages, consequential damages (including lost profits), special damages, costs, fees and expenses incurred by reason of Defendants' trademark infringement, unfair competition, and false advertising.

D. Awarding SWI treble damages sustained as a result of Defendants' unlawful conduct, pursuant to 15 U.S.C. § 1117(a);

E. Awarding SWI statutory damages in the amount of \$2,000,000 as a result of Defendants' willful conduct, pursuant to 15 U.S.C. § 1117(c);

F. Ordering an accounting by Defendants to SWI for any and all revenue derived as a result of marketing, promoting, or selling guest lodging services at the Facility.

G. Awarding actual damages in an amount to be determined at trial, together with interest, attorneys' fees, and costs of suit.

H. Declaring that SWI, or its authorized agent, has the right, without prior notice to Defendants, to enter the property at the Facility and remove any and all exterior signage, exterior items and other exterior materials displaying the Super 8® Marks, and/or names and marks that are confusingly similar to the Super 8® Marks.

I. Awarding SWI punitive damages under Indiana Law.

J. Awarding SWI pre-judgment interest on any money awarded and made part of the judgment.

K. Awarding SWI its actual costs and attorneys' fees incurred in bringing this action pursuant to 15 U.S.C. § 1117(a), 15 U.S.C. §1125(c) and IC § 24-2-1-14; and

H. Granting such other relief as the Court deems reasonable and just.

Date: April 4, 2019

Respectfully submitted,

/s/ Andrew M. Pendexter
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VERIFICATION

STATE OF NEW JERSEY)
) ss:
COUNTY OF MORRIS)

Michael Piccola, of full age, being duly sworn according to law, upon his oath, deposes and says:

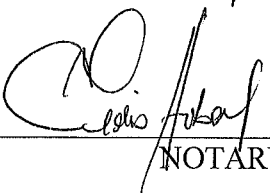
I am Senior Vice President of Contracts Administration and Compliance for Super 8 Worldwide, Inc., which is plaintiff in this action.

I have read the foregoing Verified Complaint and all the allegations contained therein. Except as to allegations alleged upon information and belief, which allegations I believe to be true, all the allegations in the Verified Complaint are true based on my personal knowledge, the records of SWI, or information available through employees of SWI.



MICHAEL PICCOLA

Sworn and subscribed to before me this 4th day of April, 2019



NOTARY PUBLIC

