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UNITED STATES DISTRICT COURT FOR THE DISTRICT OF UTAH
CENTRAL DIVISION

SALT LAKE CITY CORPORATION, a
municipal corporation of the State of Utah,

Plaintiff,

v.

DEPARTMENT OF HOMELAND
SECURITY, an agency of the UNITED
STATES OF AMERICA, and
TRANSPORTATION SECURITY
ADMINISTRATION, an agency of the
UNITED STATES OF AMERICA,

Defendants.

C O M P L A I N T

Civil No. _____

Judge _____

Plaintiff Salt Lake City Corporation (“Plaintiff”) hereby complains of defendants and alleges as follows:

PARTIES, JURISDICTION, AND VENUE

1. Plaintiff Salt Lake City Corporation is a municipal corporation of the State of Utah, organized and existing under the laws of the State of Utah with its principal place of business in Salt Lake City, Utah.

2. Defendant Department of Homeland Security (“DHS”) is a Department of the Executive Branch of the United States Government. DHS is an agency within the meaning of 5 U.S.C. § 552(f).

3. Defendant Transportation Security Administration (“TSA”) is a component of Defendant DHS. TSA is an agency within the meaning of 5 U.S.C. § 552(f).

4. This Court has jurisdiction pursuant to 28 U.S.C. §§ 1331, 1338(a), and 15 U.S.C. § 1121.

GENERAL ALLEGATIONS

5. Since July 2003, Plaintiff has been using the service mark SIMPLI-FLY in interstate commerce to identify its airport customer assistance and information services, which include providing information to callers regarding airport security, airline procedures, and other airport services and facilities.

6. Plaintiff applied for registration of the mark SIMPLI-FLY with the United States Patent and Trademark Office (“PTO”) on August 5, 2003. Registration of the SIMPLI-FLY mark with the PTO was finalized February 21, 2005, as Registration No. 2922126.

7. The SIMPLI-FLY mark was registered for the following services, among others: “Airport telephone information services, namely, *providing information to callers regarding parking, flight information, nearby road construction, airport security, airline procedures*, airport services and facilities, and other topics of interest to airport customers (emphasis supplied). Plaintiff is the owner of this registration and all rights thereunder.

8. Since July 2003, Plaintiff has used the service mark SIMPLI-FLY, which it has prominently displayed in advertising and marketing its services, including use of the mark in newspaper advertisements, on signs, and on Plaintiff’s website. As a result of substantial

advertising and marketing, Plaintiff's SIMPLI-FLY mark has become an asset of substantial value as a distinctive indication of the origin and quality of Plaintiff's services.

9. By using the mark SIMPLI-FLY, Plaintiff has developed significant and valuable goodwill in its mark, since first commencing to utilize the mark in interstate commerce.

10. TSA and DHS (collectively "Defendant") have adopted and are using SIMPLIFLY as a service mark in connection with providing information and recommendations regarding airport security procedures, and advertises such airport security information services in connection with that mark.

11. Defendant has marketed and is continuing to market its airport security information services in interstate commerce, including to airport customers and users who travel to and from the Salt Lake City airport and to whom Plaintiff also advertises and markets its own services.

12. Defendant first used the designation SIMPLIFLY long after Plaintiff first used and obtained federal trademark registration for its mark SIMPLI-FLY.

13. Because of the similarity between the marks used by Plaintiff and Defendant, prospective users of the services are likely to be deceived, mistaken, or confused as to the source or origin of Defendant's services.

14. On January 11, 2008, Plaintiff sent a letter to TSA, notifying Defendant of Plaintiff's rights in its service mark and demanding that Defendant cease using SIMPLIFLY in connection with its services. On December 31, 2009, Plaintiff's attorney, Tadiana W. Jones, sent another letter to TSA, repeating Plaintiff's demand that TSA cease using the SIMPLIFLY mark. Defendant has failed to comply with Plaintiff's demands and has continued to use the SIMPLIFLY mark in commerce.

FIRST CLAIM FOR RELIEF

(Infringement of Federally Registered Trademark – Injunctive Relief and Damages)

15. Paragraphs 1 through 14 are realleged and by this reference are incorporated into the First Claim for Relief.

16. Defendant's use of the designation SIMPLIFLY, alone or in combination with other words, in the marketing of its services is an infringement of Plaintiff's registered trademark SIMPLI-FLY in violation of Section 32 of the Lanham Act of 1946, 15 U.S.C. § 1114.

17. Defendant will, if not enjoined by this Court, continue its acts of trademark infringement set forth above, which have caused and will continue to cause Plaintiff immediate and irreparable harm. Defendant's acts have damaged Plaintiff's business reputation and have impaired and diluted Plaintiff's goodwill in its trademark.

18. Pursuant to Section 34 of the Lanham Act, 15 U.S.C. § 1116, Plaintiff is entitled to an order of this Court, effective during the pendency of this action and thereafter to be made permanent, enjoining Defendant, its officers, agents, and employees from using the designation SIMPLIFLY alone or in combination with other words or in any other imitations of Plaintiff's mark SIMPLI-FLY in the advertising, marketing or providing of any of Defendant's services.

19. As a result of Defendant's trademark infringement, Plaintiff has suffered damages, the exact amount of which Plaintiff has not yet been able to determine. Pursuant to Section 35 of the Lanham Act, 15 U.S.C. § 1117, Plaintiff is entitled to recover a judgment for damages not to exceed three times the amount of its actual damages, as shall be proved at trial, together with interest thereon, and for an amount equal to Defendant's profits derived from its unlawful and wrongful conduct.

SECOND CLAIM FOR RELIEF

(False Designation of Origin – Injunctive Relief and Damages)

20. Paragraphs 1 through 19 are realleged and by this reference are incorporated into the Second Claim for Relief.

21. Defendant's use of the designation SIMPLIFLY in its labeling, advertising, marketing, and providing of its services for its own benefit, in such a fashion and design as to imitate Plaintiff's trademark SIMPLI-FLY, constitutes a violation of Section 43(a) of the Lanham Act, 15 U.S.C. § 1125(a), on the grounds that it creates a likelihood of confusion among prospective purchasers and employees, and further on the grounds that such usage induces, or is likely to induce, prospective purchasers and employees and others to believe, contrary to facts, that Defendant's services are performed by, approved by, or otherwise connected in some way with Plaintiff or with Plaintiff's services.

22. Defendant's use of the designation SIMPLIFLY in the manner alleged above constitutes a false designation of origin of Defendant's services, or false description or representation of Defendant's services, in violation of Section 43(a) of the Lanham Act, 15 U.S.C. § 1125(a).

23. Defendant will, if not enjoined by this Court, continue its acts of unfair competition by the use of the false designation and false representation set forth above, which has caused, and will continue to cause, Plaintiff immediate and irreparable harm.

24. Pursuant to Section 34 of the Lanham Act, 15 U.S.C. § 1116, Plaintiff is entitled to an order of this Court, effective during the pendency of this action and thereafter to be made permanent, enjoining Defendant, its officers, agents, and employees from using SIMPLIFLY

alone or in combination with other words or any other colorable imitations of Plaintiff's trademark SIMPLI-FLY, in the advertising, marketing, or sale of Defendant's services.

25. As a result of Defendant's acts of unfair competition set forth above, Plaintiff has suffered damages, the exact amount of which Plaintiff has not yet been able to determine. Pursuant to Section 35 of the Lanham Act, 15 U.S.C. § 1117, Plaintiff is entitled to a judgment for damages not to exceed three times the amount of its actual damages, as shall be proved at trial, together with interest thereon, and for an amount equal to Defendant's profits derived from its unlawful and wrongful conduct.

THIRD CLAIM FOR RELIEF

(Common Law Trademark Infringement – Injunctive Relief and Damages)

26. Paragraphs 1 through 25 are realleged and by this reference are incorporated into the Third Claim for Relief.

27. Plaintiff first used the SIMPLI-FLY mark long before Defendant first used the mark SIMPLIFLY.

28. Defendant's use of the phrase SIMPLIFLY infringes Plaintiff's ownership of the SIMPLI-FLY mark and has and will continue to have the effect of causing confusion, mistake, or deception as to the source and origin of Defendant's products and to deceive the public by passing off Defendant's products as being manufactured, sponsored, or otherwise approved by or connected with Plaintiff.

29. Defendant's acts have damaged Plaintiff's business reputation and have impaired and diluted Plaintiff's goodwill in its trademark.

30. Unless enjoined by this Court, Defendant will continue its acts of trademark infringement, thereby deceiving the public and causing Plaintiff immediate and irreparable harm and damage.

31. Plaintiff is entitled to an order of this Court enjoining Defendant, its officers, agents, and employees, and anyone acting in concert with it, from using the phrase SIMPLIFLY alone or in combination with other words or any other colorable imitations of the SIMPLI-FLY mark in Defendant's advertising, marketing, or sale of its products and services or in any other way in connection with the conduct of its business.

32. As a result of Defendant's conduct set forth above, Plaintiff has suffered damages the exact amount of which Plaintiff has not been able to determine. Plaintiff is entitled to recover from defendant such damages, together with interest thereon, and an amount equal to Defendant's profits derived from its unlawful and wrongful conduct.

FOURTH CLAIM FOR RELIEF

(Common Law Unfair Competition -- Injunctive Relief, and Damages)

33. Paragraphs 1 through 32 are realleged and by this reference are incorporated into the Fourth Claim for Relief.

34. The tendency and effect of Defendant's continued use of the designation SIMPLIFLY, alone or in combination with other words, in the advertising and marketing of its services is to cause confusion, mistake, and deception as to the source or origin of Defendant's services. Defendant's acts have damaged Plaintiff's business reputation and have impaired and diluted Plaintiff's goodwill in its service mark, and constitute common law unfair competition.

35. Unless enjoined by this Court, Defendant will continue its acts of unfair competition, and trademark and service mark infringement, thereby deceiving and confusing the public and causing Plaintiff immediate and irreparable damage.

36. Plaintiff is entitled to an order of this Court, effective during the pendency of this action and thereafter to be made permanent, enjoining Defendant, its officers, agents, and employees from using the designation SIMPLIFLY, alone or in combination with other words or in any other colorable imitation of Plaintiff's mark SIMPLI-FLY, in Defendant's advertising, marketing, or sale of its services.

37. As a result of Defendant's conduct as set forth above, Plaintiff has suffered damages the exact amount of which has not been ascertained. Plaintiff is entitled to recover damages in an amount to be proved at trial, together with interest thereon.

FIFTH CLAIM FOR RELIEF

(Trademark Dilution Injunctive Relief and Damages)

38. Paragraphs 1 through 37 are realleged and by this reference incorporated into this claim for relief.

39. Plaintiff's SIMPLI-FLY mark has become famous and distinctive through Plaintiff's continuous use of the name and mark in connection with its services.

40. Through widespread and favorable public acceptance, Plaintiff's mark has gained a reputation as a distinctive indication of the origin and quality of Plaintiff's services.

41. Defendants have used and continue to use the confusingly similar SIMPLIFLY mark in connection with the advertising and marketing of their own services.

42. Defendant's use of the SIMPLIFLY mark in connection with the advertising and marketing of its services has caused and will continue to cause injury to and dilution of the

distinctive quality of the SIMPLI-FLY mark in violation of Plaintiff's rights under 15 U.S.C. § 1125(c).

43. Defendants have engaged in these actions willfully, recklessly, wantonly and unlawfully and with the intent to dilute Plaintiff's mark, and with the intent to trade on Plaintiff's goodwill and reputation.

44. As a direct and proximate result of Defendant's conduct, Plaintiff has suffered and continues to suffer irreparable harm, and Plaintiff has no adequate remedy at law if Defendant's actions in this regard are allowed to continue.

45. Pursuant to Section 43(c) of the Lanham Act, 15 U.S.C. § 1125(c), Plaintiff is entitled to an order of this Court, effective during the pendency of this action and thereafter to be made permanent, enjoining Defendants, their officers, agents, and employees from using the SIMPLIFLY mark or any other colorable imitations of Plaintiff's mark in the advertising or marketing of Defendant's services.

46. As a result of Defendant's acts as set forth above, and in addition to the irreparable harm already suffered, Plaintiff has suffered damages, the exact amount of which will be determined at trial. Pursuant to Sections 35 and 36 of the Lanham Act, 15 U.S.C. §§ 1117 and 1118, Plaintiff is entitled to a judgment for damages not less than three times the amount of their actual damages, as shall be proved at trial, together with interest thereon, an amount equal to Defendant's profits derived from its unlawful and wrongful conduct, and an order requiring Defendant to destroy all infringing advertising and marketing materials.

47. Defendant's actions as set forth above entitle Plaintiffs pursuant to Section 35 of the Lanham Act, 15 U.S.C. § 1117 to an award of attorneys' fees incurred in bringing this action.

SIXTH CLAIM FOR RELIEF

(Deceptive Trade Practices – Utah Code Ann. § 13-11a-3)

48. Paragraphs 1 through 47 are realleged and by this reference incorporated into this claim for relief.

49. Defendant's willful, intentional and malicious conduct, as alleged above, presents a likelihood of public confusion or misunderstanding as to the source, sponsorship or approval of Defendant's services.

50. Defendant's conduct has created a likelihood of confusion as to affiliation, connection or association between the respective services provided by Defendant and Plaintiff.

51. Defendant has so closely imitated the SIMPLI-FLY mark so as to create a likelihood of confusion or misunderstanding in the marketplace as to the source of the respective services provided by Plaintiff and Defendant.

52. Plaintiff has suffered and continues to suffer irreparable harm as a result of Defendant's acts and have no adequate remedy at law.

53. The foregoing misconduct of Defendant constitutes deceptive trade practices under Utah Code Ann. § 13-11a-3.

54. Under Utah Code Ann. § 13-11a-4(2)(a), Plaintiff is entitled to an order of this Court, effective during the pendency of this action and thereafter to be made permanent, enjoining Defendant, its officers, agents, and employees from using the SIMPLIFLY mark alone or in combination with other words or in any other colorable imitation of Plaintiff's mark in Defendants' advertising and marketing of its services.

55. Under Utah Code Ann. § 13-11a-4(2)(b), Plaintiff is entitled to recover damages to fairly and reasonably compensate it for Defendant's conduct in the above regard.

56. Under Utah Code Ann. § 13-11 a-4(2)(c), Plaintiff is entitled to an award of costs and attorneys' fees required to file and prosecute this action.

57. Under Utah Code Ann. § 13-11a-4(2)(c), Plaintiff is entitled to an order requiring Defendant to promulgate appropriate corrective advertising using the same media that Defendant has used to advertise and market its services.

58. Because Defendant's actions as set forth above are willful, intentional and malicious and designed to create a likelihood of confusion or misunderstanding in the marketplace, Plaintiff is further entitled to an award of punitive damages against Defendant.

SEVENTH CLAIM FOR RELIEF

(Attorney's Fees)

59. Paragraphs 1 through 58 are realleged and by this reference are incorporated into the Sixth Claim for Relief.

60. Because Defendant's acts and conduct were wilful, fraudulent, reckless, or in bad faith, Plaintiff is entitled to an award by the Court of its reasonable attorneys' fees, pursuant to Section 35 of the Lanham Act, 15 U.S.C. § 1117.

WHEREFORE, Plaintiff demands judgment against Defendant as follows:

A. For judgment and decree of this Court, effective during the pendency of this action and thereafter to be made permanent, enjoining Defendant, its officers, agents, employees, and all others acting in concert with any of them, from:

(i) Using in any manner the designation, SIMPLI-FLY, SIMPLIFLY, or any words or combination of words or letters similar thereto, in the advertising, marketing, or providing of Defendant's services;

(ii) Using in any manner any trademark, service mark, words, abbreviations, designs, arrangements, or other combinations thereof that would imitate, resemble, or suggest Plaintiff's mark SIMPLI-FLY;

(iii) Otherwise infringing Plaintiff's trademark SIMPLI-FLY;

(iv) Unfairly competing with Plaintiff diluting the distinctiveness of Plaintiff's service mark.

B. For an accounting by Defendant of profits attributable to Defendant's unlawful and wrongful conduct, and for a judgment against Defendant in such amount, together with interest thereon as provided by law;

C. For Plaintiff's costs and a reasonable attorneys' fees;

D. Such additional relief as the Court deems fair and just.

DATED this 23rd day of March, 2009.

DURHAM JONES & PINEGAR

By: /s/ R. Stephen Marshall
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Erin Middleton
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Plaintiff's address:

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