

**THE UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF COLORADO**

FRIENDS FOR LIFE, INC.)	
)	
Plaintiff,)	
v.)	Civ. No. _____
)	
FRIENDS FOR LIFE – COLORADO)	
)	
Defendants.)	
)	

COMPLAINT FOR FEDERAL TRADEMARK INFRINGEMENT (15 U.S.C. §1114), FALSE DESIGNATION OF ORIGIN (15 U.S.C. §1125(a)), DILUTION (15 U.S.C. §1125(c)), AND CYBERPIRACY (15 U.S.C. §1125(d))

Plaintiff Friends For Life, Inc., by and through undersigned counsel, asserts claims against Defendant Friends For Life – Colorado for trademark infringement, false designation of origin, dilution and cyberpiracy under the Lanham Act, and seeks permanent injunction, damages, costs, and attorneys’ fees, and such other relief as this Court deems just and proper.

THE PARTIES

1. Plaintiff, Friends For Life, Inc., is a corporation organized under the laws of the State of Colorado and maintains its principal office at 5912 South Cody Street, Suite 310, Littleton, CO 80123.
2. Defendant, Friends For Life – Colorado, is a non-profit corporation organized under the laws of the State of Colorado. According to Colorado Secretary of

State records (**Exhibit A**), Defendant's principal office street address is 1750 30th Street, Suite 156, Boulder, CO 80301. However, upon information and belief, this location is merely a post office box location. The registered agent address identified on the Secretary of State records is 7580 Xavier Street, Westminster, CO 80030, which upon information and belief is the home address of Defendant's Chief Financial Officer.

JURISDICTION AND VENUE

3. This Court has original subject matter jurisdiction over federal Lanham Act claims pursuant to 15 U.S.C. §§1121(a) and 28 U.S.C. §§1331 and 1338.
4. Personal jurisdiction is proper, because both parties are residents of Colorado.
5. Venue is proper in this Court under 28 *U.S.C* §1391(b), because the facts giving rise to the acts or omissions alleged herein took place at least in part in this District and/or because Defendant is subject to personal jurisdiction in this District.

FACTUAL BACKGROUND

6. Plaintiff, Friends For Life, Inc. was founded in Colorado in 1997 with the primary purpose of assisting senior citizens and their families by providing personalized visits to seniors' homes or long-term care facilities. These visits may include such activities as accompanying the loved one during meals, taking them to the doctor, walking in the park, or assisting with household

- activities and errands. Families can customize the services provided as they wish.
7. Although Friends For Life, Inc.’s primary focus is on the elderly, they are at times asked by families to provide such services for young adults, particularly those with physical and/or mental disabilities or traumatic brain injuries.
 8. Since their formation in 1997, Friends For Life, Inc. has helped hundreds of families in the State of Colorado. They are often hired by family members outside of the State of Colorado, who are physically unable to be with their loved ones to provide assistance themselves.
 9. In January of 2006, Friends For Life, Inc. expanded to open a second office in the State of Florida. Although that office closed in September 2007, Friends For Life, Inc., anticipates opening other branch offices and/or franchise locations in the future.
 10. On October 3, 2014, Plaintiff filed an application with the U.S. Patent and Trademark Office for registration of their trademark, “Friends For Life.” That application was accepted and the trademark was registered by the U.S.P.T.O. on May 19, 2015 with the Registration Number 4,739,024. **(Exhibit B)**
 11. Plaintiff’s trademark was registered in International Class 045. The short definition of this class is: “...personal and social services rendered by others to meet the needs of individuals.” **(Exhibit C)**

FACTUAL ALLEGATIONS

12. On August 2, 2016, more than fourteen months after Plaintiff's trademark registration was granted, Defendant formed its non-profit corporation, named "Friends For Life – Colorado." **(Exhibit A)**
13. Five days earlier, on July 28, 2016, Defendant had registered the domain name, www.friendsforlifecolorado.org. WHOis.net records reflect that the Registrant Name listed for this domain is "Friends For Life" at the address 1750 30th Street, Suite 156, Boulder, Colorado 80301; the same address listed in Colorado Secretary of State records as the office address of Defendant. **(Exhibit D)**
14. According to Defendant's website, "Friends for Life, a Christian-based organization open to all, recognizes the challenges adults with intellectual & developmental disabilities face in forming lasting friendships and the powerful impact social relationships have on their health and psychosocial well-being. By fostering a community of support through weekly social gatherings, field trips, and seasonal camps at no- or low-cost to families, Friends for Life provides ample opportunity to establish friendships and a network of support for these families." **(Exhibit E)** These services described fall within the description of trademark International Class 045: "...personal and social services rendered by others to meet the needs of individuals."

15. On September 22, 2016, Plaintiff contacted Defendant via email to inform them of Plaintiff's registered trademark and to request that Defendant change the name of their organization to something that would not infringe Plaintiff's trademark. **(Exhibit F)** Plaintiff also asked that Defendant change its logo as that, too, was nearly identical to Plaintiff's logo, which is also a federally registered trademark of Friends For Life, Inc. That logo, however is not in dispute in this case, as Defendant has agreed to change its logo.
16. Later on September 22, 2016, Defendant responded to Plaintiff's email as follows: "Thank you for reaching out. Our consulting attorney is requesting a copy of your logo please and he doesn't think that we will have an issue with friends for life Colorado since you are friends for life Incorporated and they are different. You are a corporation and we are a Psuedo 501-c3 non profit. We would be willing to alter the colors of our logo and add Colorado to the Friends for Life verbiage if needed. Please advise. Thank you." **(Exhibit F)**
17. Plaintiff replied, explaining that simply adding "Colorado" was insufficient because Plaintiff itself is a Colorado corporation and a member of the public could easily be confused into thinking that "Friends For Life – Colorado" was a subsidiary or affiliate of Friends For Life, Inc. **(Exhibit G)**

18. On September 29, 2016, Defendant emailed Plaintiff: “We are working this week for reshape the logo to more of a triangle than a circle and add a head to the middle and Colorado to the wording. Thank you!” **(Exhibit H)**
19. Again, Plaintiff replied that just adding Colorado to “Friends For Life” does not alleviate the infringement. **(Exhibit H)**
20. On October 4, 2016, Plaintiff received a message through the “Contact Us” page of their website. The message stated: “I am looking for Jennifer Street. If this message could be passed on to her, I would greatly appreciate it. Thank you very much.” Jennifer Street is the Executive Director of Defendant, Friends For Life – Colorado. Thus, merely two months after Defendant’s corporate formation, there was already evidence of actual confusion in the market between Defendant’s company and that of Plaintiff, Friends For Life, Inc.
21. Plaintiff brought this communication to Defendant’s attention through an email on October 4, 2016, highlighting that this was exactly the type of confusion they were trying to avoid by asking Defendant to change its name. **(Exhibit I)**
22. Defendant responded later that day: “Thank you for forwarding this contact. We will be altering our logo this week but it is our understanding that we do not have to change our name. The name that we chose is available as a. Org site. It is also available for a state identification number with the IRS. We have

an ongoing discussion about that and are seeking legal verification on this issue. For now we will only be altering our logo because yours is trademarked and ours is not. I will keep you updated as this progresses. Thank you.”

(Exhibit I)

23. Plaintiff responded the same day, noting that domain name registrations and state identification numbers have no bearing on trademark issues. Plaintiff received no reply to this message. **(Exhibit I)**
24. On October 19, 2016, undersigned counsel sent Defendant two copies of a cease and desist letter; one copy by certified mail, return receipt requested, and one by first-class mail, to the principal office address listed in the Colorado Secretary of State records. **(Exhibit J)**
25. On October 25, 2016, undersigned counsel received the return receipt for the cease and desist letter, signed by Robert Cate on October 22, 2016. **(Exhibit K)** Counsel later learned from Defendant that the office address is a post office box and that Robert Cate is the manager of the post office box location.
26. On November 1, 2016, undersigned counsel left a voicemail for Jennifer Street, Executive Director of Friends For Life – Colorado.
27. On November 2, 2016, undersigned counsel received the following email message from Ms. Street: “I received your message yesterday and we received your letter on Monday Oct. 31st. We only check the PO Box twice monthly

and so we are requesting that we have until Nov. 8th to respond to the request as we are having it reviewed by our attorney. Please note that we are NOT seeking to trademark our name. Also note the attachment from the State of Colorado showing numerous entries using Friends for Life and the EIN # allowed by the Federal Gov't. We will make a written reply by Nov. 8th.”

(Exhibit L) To the email, Ms. Street attached an IRS record showing the creation of an Employer Identification Number for “Friends For Life – Colorado” **(Exhibit M)** and a Colorado Secretary of State listing of corporations that had some variation of the name “Friends For Life.” **(Exhibit N)**

28. Later that day, undersigned counsel responded, requesting contact information for Defendant’s attorney so further communications could be made to such attorney. Counsel also agreed to extend the deadline for their reply to November 8, 2016.
29. On November 7, 2016, undersigned counsel received an email from Ms. Kaitlin D. Corey, an attorney in the Baltimore, Maryland law firm of Astrachan Gunst Thomas, P.C. In the email, Ms. Corey advised that she would respond to the cease and desist letter by November 14, 2016. **(Exhibit O)**
30. Plaintiff acted swiftly to protect its trademark rights by contacting Defendant less than two months after Defendant’s corporate entity was formed.

31. Plaintiff's "Friends For Life" trademark was registered more than fourteen months, and had been continually used by Plaintiff for more than nineteen years, before Defendant's corporate entity was formed.
32. As a matter of law, under 15 U.S.C. §1072, Defendant had constructive notice of Plaintiff's claim of ownership to the "Friends For Life" mark by virtue of Plaintiff's registration of the mark on the principal register.
33. At least as early as Plaintiff's email on September 22, 2016, Defendant had actual notice of Plaintiff's registered trademark.
34. Defendant's continued use of the mark and insignificant variations thereof after having both constructive and actual notice of Plaintiff's registered trademark constitutes willful and knowing infringement of Plaintiff's mark.
35. Defendant's name "Friends For Life" is identical to Plaintiff's mark. Defendant's alternative name, "Friends For Life – Colorado" is substantially similar to Plaintiff's mark, has caused actual confusion in the market, and is likely to continue to cause such confusion.
36. The services that Plaintiff and Defendant provide are very similar and, in some cases, overlapping. Plaintiff's primary focus is providing engagement and companionship for the elderly, but they also work with young adults suffering from developmental disabilities and traumatic brain injuries. Defendant

provides companionship services for adults with intellectual and developmental disabilities.

37. Plaintiff's trademark was registered in International Class 045, the short title of which is "...personal and social services rendered by others to meet the needs of individuals."
38. If Defendant were to attempt to trademark their name, it would fall under International Class 045 as well.

CLAIMS ALLEGED

Count 1

Federal Trademark Infringement (U.S.C. §1114)

39. Plaintiff incorporates each and every paragraph of this complaint as if fully set forth herein.
40. Plaintiff, Friends For Life, Inc., hold valid and existing federal registration number 4,739,024 for the trademark "Friends For Life," which was registered on May 19, 2015, and has continually used the mark since as early as 1997.
41. Defendant has infringed upon Plaintiff's federally registered trademark by various acts, including, without limitation, the adoption of identical and confusingly similar marks, including, "Friends For Life," "Friends For Life – Colorado," the domain name "www.friendsforlifecolorado.org," the "friendsforlifecolorado@gmail.com" email address, and the marketing,

advertisement, and provision of similar services to Plaintiff's in connection with such infringing marks.

42. Defendant formed its corporate entity on August 2, 2016 and registered its domain name, "www.friendsforlifecolorado.org" on July 28, 2016. The named registrant for this domain is "Friends For Life." Upon information and belief, this was Defendant's first use of any "Friends For Life" mark.
43. Defendant's adoption and use of the infringing mark is without permission or authority from Plaintiff, has caused actual confusion in the relevant market, and is likely to continue to cause confusion and/or mistake in the relevant market.
44. Defendant adopted and used the infringing mark in connection with its services with constructive notice of Plaintiff's registration under 15 U.S.C. §1072, and continues to willfully use the infringing mark after receiving actual notice of Plaintiff's registration at least as early as September 22, 2016.
45. By engaging in the complained-of conduct, the Defendant used in commerce, without the consent of Plaintiff, a reproduction, counterfeit, copy or colorable imitation of the registered trademark and/or reproduced, counterfeited, copied or colorably imitated the registered trademark or applied a reproduction, counterfeit, copy or colorable imitation of the registered trademark to its

website and other tangible items intended to be used in commerce or reach consumers in violation of 15 U.S.C §1114.

46. Defendant's infringing activities have caused and, unless enjoined by this Court, will continue to cause irreparable injury and other damages to Plaintiff, its business, its reputation and goodwill because Plaintiff has no adequate remedy at law. Accordingly, Plaintiff is entitled to permanent injunctive relief under 15 U.S.C. §1116(a).
47. Plaintiff is entitled to an award of its costs in this matter pursuant to 15 U.S.C. §1117(a).
48. At least as early as September 22, 2016, when Defendant received actual notice of Plaintiff's trademark rights, Defendant's conduct was willful and knowing and this Court should declare this an exceptional case and award Plaintiff reasonable attorney fees pursuant to 15 U.S.C. §1117(a).

Count 2
False Designation of Origin (15 U.S.C. §1125(a))

49. Plaintiff incorporates each and every paragraph of this complaint as if fully set forth herein.
50. The actions of Defendant as alleged herein constitute false designation of origin, false advertising and unfair competition pursuant to Section 43(a) of the Lanham Act, 15 U.S.C. §1125(a) in that they have on or in connection with Defendant's services, used the names "Friends For Life," "Friends For Life –

Colorado,” and the domain name “www.friendsforlifecolorado.org,” which represents a false designation of origin, false or misleading description and/or a misrepresentation of fact likely to cause confusion, mistake, or deception as to the affiliation, connection or association of Defendants with Plaintiff, Friends For Life, Inc., or which is likely to cause confusion, mistake, or deception as to whether Plaintiff has anything to do with the origin, sponsorship, or approval of the services of Defendant.

51. The actions of Defendant have and are likely to continue to deceive customers and prospective customers into believing that Defendant’s services are that of Friends For Life, Inc.
52. Friends For Life, Inc. has no control over the nature and quality of the services provided by Defendant. Any failure, neglect, or negligence by Defendant in providing such services will reflect adversely on Friends For Life, Inc. as the believed source of origin thereof, hampering efforts by Friends For Life, Inc. to continue to protect its outstanding reputation for high quality services, resulting in loss of clients, all to the irreparable harm of Friends For Life, Inc.
53. Friends For Life, Inc. has and will continue to be irreparably harmed unless Defendant is, pursuant to 15 U.S.C. §1116(a), permanently enjoined from any further use of the “Friends For Life” mark, “Friends For Life – Colorado” mark, the domain name “www.friendsforlifecolorado.org,” the

- “friendsforlifecolorado@gmail.com” email address, or any other confusingly similar mark and any further marketing, advertising or provision of services using such marks, as Friends For Life, Inc. has no adequate remedy at law.
54. The actions of Defendant as alleged herein constitute intentional, willful, knowing and deliberate unfair competition and false advertising pursuant to Lanham Act §43(a).
55. Plaintiff is entitled to an award of its costs in this matter pursuant to 15 U.S.C. §1117(a).
56. At least as early as September 22, 2016, when Defendant received actual notice of Plaintiff’s trademark rights, Defendant’s conduct was willful and knowing and this Court should declare this an exceptional case and award Plaintiff reasonable attorney fees pursuant to 15 U.S.C. §1117(a).

Count 3
Trademark Dilution (15 U.S.C. §1125(c))

57. Plaintiff incorporates each and every paragraph of this complaint as if fully set forth herein.
58. Defendant’s use of the names “Friends For Life,” “Friends For Life – Colorado,” and the domain name “www.friendsforlifecolorado.org” have caused and continue to cause dilution of the distinctive quality of Plaintiff’s mark, “Friends For Life.” Defendant’s use of these marks is a violation of 15 U.S.C. §1125(c), Plaintiff’s mark being distinctive and famous within the

meaning of the statute and Defendant's use of the marks in commerce having begun after Plaintiff's mark had become distinctive and famous.

59. At least as early as September 22, 2016, when Defendant received actual notice of Plaintiff's trademark rights, Defendant's conduct was willful and intended to cause dilution of Plaintiff's mark by their continued use of the names "Friends For Life," "Friends For Life – Colorado," their use of the domain name "www.friendsforlifecolorado.org," and their use of the email address "friendsforlifecolorado@gmail.com."
60. Plaintiff is entitled to permanent injunctive relief under 15 U.S.C. §1116(a).
61. Plaintiff is entitled to an award of its costs in this matter pursuant to 15 U.S.C. §1117(a).
62. At least as early as September 22, 2016, when Defendant received actual notice of Plaintiff's trademark rights, Defendant's conduct was willful and knowing and this Court should declare this an exceptional case and award Plaintiff reasonable attorney fees pursuant to 15 U.S.C. §1117(a).

Count 4
Cyberpiracy (15 U.S.C. §1125(d))

63. Plaintiff incorporates each and every paragraph of this complaint as if fully set forth herein.
64. Defendant, as registrant of the domain name www.friendsforlifecolorado.org has violated 15 U.S.C. §1125(d) in that Defendant has demonstrated a bad faith

intent to gain from Plaintiff's mark "Friends For Life" and has registered and used a domain name that is identical or confusingly similar to Plaintiff's mark and/or dilutive of that mark.

65. Defendant's bad faith cyberpiracy entitles Plaintiff to an order of this Court directing forfeiture and/or cancellation of the domain name www.friendsforlifecolorado.org or the transfer of that domain name to Plaintiff.
66. Plaintiff is further entitled to injunctive relief under 15 U.S.C. §1116 and recovery of statutory damages under 15 U.S.C. §1117(d) in an amount not to exceed one hundred thousand dollars (\$100,000).

REQUEST FOR RELIEF

WHEREFORE, Plaintiff, Friends For Life, Inc. requests that the Court enter an Order as follows:

- A. Granting Plaintiff a permanent injunction requiring Defendant to cease all use of the "Friends For Life" mark, the "Friends For Life – Colorado" mark, the domain name "www.friendsforlifecolorado.org," the "friendsforlifecolorado@gmail.com" email address, and any other confusingly similar marks;

- B. Directing forfeiture and/or cancellation of the domain name
“www.friendsforlifecolorado.org” or the transfer of that domain name to
Plaintiff.
- C. Granting Plaintiff statutory damages under 15 U.S.C. §1117(d) of one hundred
thousand dollars (\$100,000);
- D. Awarding all reasonable costs associated with this action;
- E. Finding Defendant’s infringement willful, declaring this an exceptional case,
and awarding reasonable attorneys’ fees associated with this action; and
- F. Such other and further relief that the court deems reasonable and just.

Dated: November 11, 2016

Respectfully submitted,

By: /s/ Brian D. Kaider, Esq.
Brian D. Kaider, Esq.
The Law Offices of Brian D. Kaider, LLC
24230 Kings Valley Road
Damascus, MD 20872
Telephone: (240) 308-8032
Email: bkaider@kaiderlaw.com
Attorney for Plaintiff: Friends For Life, Inc.

Index of Exhibits

Exhibit	Description	Pages
A	Colorado Secretary of State listing for “Friends For Life – Colorado”	1
B	Plaintiff’s Trademark Registration No. 4,739,024 for “Friends For Life”	2
C	World Intellectual Property Organization information sheet for Nice Classification 045 for trademarks	3
D	Copy of webpage from WHOis.net listing the registration information for the website “friendsforlifecolorado.org”	2
E	Copy of Friends For Life-Colorado website home page	3
F	Copy of 9/22/2016 email exchange between Plaintiff and Defendant	1
G	Copy of second 9/22/2016 email exchange between Plaintiff and Defendant	2
H	Copy of 9/29/2016 email exchange between Plaintiff and Defendant	1
I	Copy of 10/4/2016 email exchange between Plaintiff and Defendant	2
J	Copy of cease and desist letter sent to Defendant on 10/19/2016	2
K	Copy of return receipt from cease and desist letter, signed 10/22/2016	1
L	Copy of 11/2/2016 email from Defendant to Plaintiff’s counsel	2
M	Copy of IRS letter assigning employer identification number to Friends For Life-Colorado (attached to email in Exhibit L)	2
N	Copy of Colorado Secretary of State business search for entities with the name “Friends for Life” (attached to email in Exhibit L)	1
O	Copy of 11/7/2016 email from Defendant’s counsel to Plaintiff’s counsel	1