

IN THE UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF COLUMBIA

GENERAL CONFERENCE
CORPORATION OF SEVENTH-DAY
ADVENTISTS and GENERAL
CONFERENCE OF SEVENTH-DAY
ADVENTISTS,
12501 Old Columbia Pike
Silver Spring, Maryland 20904-6600,

Plaintiffs,

v.

U.S. DEPARTMENT OF HEALTH AND
HUMAN SERVICES (AGENCY OF THE
UNITED STATES GOVERNMENT)

Suite 450 6120 Executive Boulevard
Bethesda, Maryland 20892-7181,

and

NATIONAL INSTITUTES OF HEALTH
(AGENCY OF THE UNITED STATES
GOVERNMENT)

9000 Rockville Pike
Bethesda, Maryland 20892

Defendants

Also Serve:

The United States Attorney for the
District of Columbia and the Attorney
General of the United States

FILED

FEB - 3 2009

Clerk, U.S. District and
Bankruptcy Courts

Case: 1:09-cv-00202
Assigned To : Leon, Richard J.
Assign. Date : 2/3/2009
Description: General Civil

COMPLAINT

This is an action for trademark infringement, trademark dilution, and unfair competition under the Lanham Act against Defendants U.S. Department of Health and Human Services and National Institutes of Health, both agencies of the United States Government.

Plaintiffs General Conference Corporation of Seventh-day Adventists and General Conference of Seventh-day Adventists ("Plaintiffs") are seeking a permanent injunction, damages, profits, treble damages or profits, attorneys' fees, and costs. Plaintiffs, appearing through their undersigned counsel, allege as follows:

PARTIES

1. Plaintiff General Conference Corporation of Seventh-day Adventists is a corporation organized under the laws of the District of Columbia, and has its principal place of business at 12501 Old Columbia Pike, Silver Spring, Maryland 20904-6600.

2. Plaintiff General Conference Corporation of Seventh-day Adventists is the corporate entity established by the Seventh-day Adventist Church (the "Church") to hold title to the Church's assets (including trademarks) and to serve the Church in carrying out its purposes.

3. Plaintiff General Conference of Seventh-day Adventists is an unincorporated association that represents the interests of the Church.

4. Upon information and belief, Defendant US Department of Health and Human Services ("HHS") has a place of business at Suite 450, 6120 Executive Boulevard, Bethesda, Maryland 20892-7181. HHS is an agency of the United States Government.

5. Upon information and belief, Defendant National Institutes of Health ("NIH") has a principal place of business at 9000 Rockville Pike, Bethesda, Maryland 20892. NIH is a component of the Public Health Service, a division of HHS, and thus an agency of the United States Government.

JURISDICTION AND VENUE

6. This is a claim for damages and injunctive relief for trademark infringement, trademark dilution, and unfair competition under the Lanham Act, 15 U.S.C. § 1051, et seq., including §§ 1114(1), 1122(c) and 1127.

7. The United States has waived its sovereign immunity for any violation under the Lanham Act, including suits against the United States and all agencies and instrumentalities of the United States. 15 U.S.C. § 1122 (a) & (c).

8. The Court has subject matter jurisdiction over this action pursuant to the Lanham Act, 15 U.S.C. § 1121, and 28 U.S.C. §§ 1331 and 1338.

9. Venue is proper in this judicial district under 28 U.S.C. § 1391(b) because Defendants transact business within this district, and the acts complained of herein that have caused and are continuing to cause injury to Plaintiffs have occurred and are continuing to occur within this district.

PLAINTIFFS' QUIT NOW MARKS

10. Plaintiff General Conference Corporation of Seventh-day Adventists is the owner of all rights in the federally registered marks QUIT NOW and QUIT NOW and Design (hereinafter collectively referred to as "Plaintiffs' QUIT NOW Marks"). Plaintiffs have used the QUIT NOW marks to identify and distinguish their services since at least as early as 2005.

Plaintiff General Conference Corporation of Seventh-day Adventists is the owner of the following federal service mark registrations for Plaintiffs' QUIT NOW Marks:

Registration No.	Mark	Goods/Services
3060586	QUIT NOW and Design	(Int'l Class: 41) Conducting smoking cessation seminars and distributing educational brochures and materials dealing with smoking cessation in connection with the seminars (Int'l Class: 42) Healthcare services, namely counseling to assist individuals to stop smoking
3060585	QUIT NOW	(Int'l Class: 41) Conducting smoking cessation seminars and distributing educational brochures and materials dealing with smoking cessation in connection with the seminars (Int'l Class: 42) Healthcare services, namely counseling to assist individuals to stop smoking

Copies of the Certificates of Registration for these marks are attached as Exhibit 1. The services covered by these registrations are hereinafter referred to collectively as "Plaintiffs' Services."

11. Plaintiffs' QUIT NOW Marks are inherently distinctive.

12. As a result of Plaintiff's extensive promotion of Plaintiffs' QUIT NOW Marks, Plaintiffs' QUIT NOW Marks have achieved secondary meaning in the United States among the general public identifying Plaintiffs as the sole source of the services provided under the QUIT NOW Marks.

13. As a result of Plaintiffs' longtime and continuous use of Plaintiffs' QUIT NOW Marks, the extensive nationwide advertising and promotion of Plaintiffs' QUIT NOW Marks, the extensive unsolicited media coverage of Plaintiffs' QUIT NOW Marks, and other factors, Plaintiffs' QUIT NOW Marks have become famous among the general public of the United States.

14. Plaintiffs have developed substantial goodwill in Plaintiffs' QUIT NOW Marks and they are a business asset of immense value to Plaintiffs. Consumers associate Plaintiffs' QUIT NOW Marks with services of high quality.

15. Plaintiffs have actively and consistently policed Plaintiffs' QUIT NOW Marks in the past, by demanding that third party users of similar marks cease and desist such use and by pursuing legal remedies where necessary.

DEFENDANTS' "QUIT NOW" MARKS

16. Upon information and belief, Defendants are in the business of offering and providing smoking cessation services under the mark "1-800-QUIT- NOW" and variations thereof.

17. Upon information and belief, Defendant HHS filed a trademark application with the US Patent and Trademark Office (USPTO) for the trademark 1-800 QUIT-NOW-WE CAN HELP YOU DRAW THE LINE & Design (Application Serial Number 77/188,277) on May 23, 2007.

18. On September 12, 2007 and June 18, 2008 the USPTO issued office actions containing refusals to register the mark in U.S. Application Serial Number 77/188,277 on the basis that it was likely to be confused with Plaintiff's registrations for the marks QUIT NOW. (See Exhibits 2-3).

19. On March 5, 2008, Defendant HHS filed arguments alleging that the marks were not likely to be confused. The USPTO reviewed and again decided that the marks were so closely related as to be confusingly similar resulting in the second refusal to register the mark noted above on June 18, 2008. (See Exhibit 3).

20. In early 2008, after Defendants HHS and NIH learned of the refusal of the USPTO to register the mark, Defendant NIH contacted Plaintiff to discuss acquiring Plaintiff's marks. Plaintiff did not agree to an acquisition but indicated that a license agreement could be considered.

21. On or about February 22, 2008, Plaintiff General Conference Corporation of Seventh-day Adventists and Defendant NIH engaged in a conference call to discuss the possible license of marks. Plaintiff forwarded a draft license agreement to Defendant NIH on March 26, 2008. Defendant NIH neither proposed changes nor discussed the agreement, instead continuing to pursue its trademark application. On March 27, 2008 Defendant NIH received the draft license agreement and agreed to "get back" to Plaintiff.

22. On May 20, 2008, Plaintiff contacted Defendant NIH to find out the status of the draft license agreement. Defendant NIH responded on May 23, 2008 indicating that they decided to put the issue on “hold.” Plaintiff responded indicating that an immediate resolution needed to be reached; however, Defendant NIH failed to respond and continued using Plaintiff’s mark without authorization.

23. On or about July 14, 2008, at the request of Plaintiff, Plaintiff and Defendant NIH met at Plaintiff headquarters to discuss the possible license of the mark from Plaintiff to Defendants. Defendant NIH agreed to advise Plaintiff by September 1, 2008 of how it intended to proceed in light of Plaintiff’s offer to license the mark.

24. On September 10, 2008 Plaintiff wrote to Defendant NIH enquiring as to the status of Defendant NIH’s decision and requested a response from Defendant NIH by the end of that week (Exhibit 4). Plaintiff has never received a response.

25. On December 8, 2008 a response was due to the office action for Defendant HHS’s application. From reviewing the records of the USPTO, it does not appear that a response was filed thereto.

26. In late December 2008, Plaintiff became aware of a new and significant media campaign advertising Defendant NIH’s smoking cessation program under the trademarks QUIT NOW and 1800-QUIT-NOW and variations thereof.

27. Upon information and belief, Defendants are continuing to use the QUIT NOW marks and variations thereof in commerce, even after the numerous objections by Plaintiffs and Plaintiffs’ counsel.

28. Upon information and belief, Defendants adopted the QUIT NOW mark and variations thereof with knowledge of Plaintiffs’ QUIT NOW Marks.

29. Upon information and belief, Defendants intentionally chose to use, and is continuing to use, the QUIT NOW mark and variations thereof in order to capitalize on the goodwill associated with Plaintiffs' QUIT NOW Marks.

**COUNT I - INFRINGEMENT UNDER THE LANHAM ACT,
15 U.S.C. § 1114**

30. Plaintiff repeats and realleges Paragraphs 1 through 29 herein.

31. Upon information and belief, Defendants adopted and are using the marks QUIT NOW and variations thereof in connection with its services and is advertising and promoting to the general public its services in connection with the said marks, which are confusingly similar to Plaintiffs' QUIT NOW Marks.

32. Upon information and belief, Defendants have offered and provided their services in connection with the "QUIT NOW " mark and variations thereof in interstate commerce.

33. As a direct consequence of Defendants' actions, Plaintiffs' customers and the public are likely to be, and have been, deceived or confused as to the source, origin, sponsorship and/or endorsement of Defendants' services and their relationship to Plaintiffs.

34. Upon information and belief, Defendants' purpose in adopting and using the QUIT NOW marks and variations thereof was and is to deceive, mislead and confuse customers and the public into believing that Plaintiffs were and are the source of Defendants' services, or that the services offered in connection with said names and marks are sponsored by, licensed by, or associated with Plaintiffs, so as to trade on the substantial fame, reputation and goodwill enjoyed by Plaintiffs in connection with Plaintiffs' QUIT NOW Marks.

35. Defendants' unlawful acts constitute trademark infringement in violation of the Lanham Act, 15 U.S.C. § 1114.

36. By reason of Defendants' unlawful acts and practices in violation of the Lanham Act, Plaintiffs have suffered, and will continue to suffer damage to their business, reputation and goodwill, for which Plaintiffs are entitled to injunctive, monetary and other relief, and will continue to suffer irreparable harm which is not fully compensable by money damages.

**COUNT II - UNFAIR COMPETITION UNDER THE LANHAM ACT,
15 U.S.C. § 1125(a)**

37. Plaintiffs repeat and reallege paragraphs 1 through 36 herein.

38. Plaintiffs' use of Plaintiffs QUIT NOW Marks in connection with its services since at least as early as 2005 has established in the minds of consumers an association between Plaintiffs' QUIT NOW Marks and Plaintiffs as the source of the goods and services. Plaintiffs' QUIT NOW Marks are inherently distinctive and have secondary meaning as an identification of the source of Plaintiffs' Services.

39. Without Plaintiffs' permission, Defendants adopted and have begun using the QUIT NOW in connection with their services, and is promoting to the general public their services in connection with the marks QUIT NOW and variations thereof which are confusingly similar to Plaintiffs' QUIT NOW Marks.

40. Upon information and belief, Defendants have offered and provided their services in connection with the QUIT NOW marks in interstate commerce.

41. As a direct consequence of Defendants' actions, Plaintiffs' customers and potential customers are likely to be, and have been, deceived or confused into believing that Defendants' services are authorized by, licensed by, or otherwise associated with Plaintiffs.

42. Upon information and belief, Defendants' purpose in adopting and using the QUIT NOW marks and variations thereof is to deceive, mislead and confuse customers and the public into believing that Plaintiffs were and are the source of Defendants' services, or that

Defendants' services are authorized by, licensed by, or otherwise associated with Plaintiffs, so as to enable Defendants to take advantage of Plaintiffs' QUIT NOW Marks and the substantial fame, reputation and goodwill enjoyed by Plaintiffs therein.

43. Defendants' use of the marks QUIT NOW & variations thereof constitutes false representation as to source in violation of the Lanham Act, 15 U.S.C. § 1125(a).

44. By reason of Defendants' unlawful acts and practices, Plaintiffs have suffered, and will continue to suffer damage to their business, reputation and goodwill, for which Plaintiffs are entitled to injunctive relief and an award of damages, and will continue to suffer irreparable harm which is not fully compensable by money damages.

**COUNT III - DILUTION UNDER THE LANHAM ACT,
15 U.S.C. § 1125(e)**

45. Plaintiffs repeat and reallege paragraphs 1 through 44 herein.

46. As a result of Plaintiffs' longtime use and nationwide advertising and promotion of Plaintiffs' QUIT NOW Marks, extensive unsolicited media coverage of Plaintiffs' QUIT NOW Marks, and other factors, Plaintiffs' QUIT NOW Marks have become famous among the general public of the United States.

47. Plaintiffs' QUIT NOW Marks became famous long before Defendants' first use of the QUIT NOW mark and variations thereof.

48. Defendants use the marks QUIT NOW and variations thereof in connection with their smoking cessation services which are offered and provided in the United States.

49. Upon information and belief, Defendants' use of the marks QUIT NOW has been intentional and in bad faith, namely, with the intent to trade on Plaintiffs' reputation and with the intent to cause dilution of Plaintiffs' QUIT NOW Marks.

50. Defendants' use of the QUIT NOW marks has caused and is likely to continue to cause dilution of the distinctive quality of Plaintiffs' QUIT NOW Marks and is therefore in violation of the Lanham Act, 15 U.S.C. § 1125(c).

51. By reason of Defendants' unlawful acts and practices, Plaintiffs have suffered and will continue to suffer damage to their business, reputation and goodwill, for which Plaintiffs are entitled to injunctive relief.

PRAYER FOR RELIEF

WHEREFORE, Plaintiffs pray that this Court enter judgment in its favor and grant the following relief:

- A. An injunction enjoining Defendants and their officers, directors, employees, subsidiaries, affiliates, agencies, and/or instrumentalities from using any mark, trade name or source identifier, which is confusingly similar to Plaintiffs' QUIT NOW Marks, including but not limited to the names "1-800-QUIT-NOW, QUIT NOW, THE QUIT NOW CHALLENGE and variations thereof;
- B. An injunction enjoining Defendants from providing, offering, advertising or promoting in any way any of their services that infringe upon Plaintiffs' QUIT NOW Marks;
- C. That Plaintiffs be awarded their actual damages in an amount to be proven at trial;
- D. That Defendants be required to account for any revenues attributable to their infringing acts;
- E. That Plaintiffs be awarded three times any damages sustained by Plaintiffs, and prejudgment interest;
- F. That punitive damages be awarded to Plaintiffs;

G. That all products, labels, signs, prints, packages, brochures, and advertising and promotional materials in the possession of Defendants bearing Defendants' QUIT NOW marks, or any word, term, name, symbol, device, combination thereof, designation, description, or representation that is found in violation of the Lanham Act, or any reproduction, counterfeit, copy, or colorable imitation thereof, and all plates, molds, matrices, and other means of making the same, shall be delivered up by Defendants and destroyed;

II. That pursuant to 15 U.S.C. § 1116, Defendants file and serve a report under oath within thirty days of the issuance of injunctive relief indicating the manner in which they have complied with any injunctive relief ordered by the Court;

I. That Plaintiffs be awarded reasonable attorney fees in prosecuting this action; and

J. That Plaintiffs be granted such other and further relief which the Court deems just and proper.

Respectfully submitted,

GENERAL CONFERENCE CORPORATION OF
SEVENTH-DAY ADVENTISTS
and
GENERAL CONFERENCE OF SEVENTH-DAY
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Date: February 3, 2009

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