

IN THE UNITED STATES DISTRICT COURT
FOR THE SOUTHERN DISTRICT OF FLORIDA
MIAMI DIVISION

Case No. 1:16-cv-20683-MORENO/O’SULLIVAN

HERON DEVELOPMENT CORPORATION,
a foreign corporation,

Plaintiff,

v.

VACATION TOURS, INC., a Florida Corporation
d/b/a VACATION STORE OF MIAMI,
MEDIA INSIGHT GROUP, INC., a Florida
Corporation d/b/a MEDIA INSIGHT, ROSANNA
M. MENDEZ, and GEORGE A. ALVAREZ,
jointly, severally, and individually,

Defendants.

AMENDED COMPLAINT AND DEMAND FOR JURY TRIAL

Plaintiff, HERON DEVELOPMENT CORPORATION, a foreign corporation, by and through its attorneys, files this amended complaint in its action against Defendants VACATION TOURS, INC., a Florida Corporation d/b/a VACATION STORE OF MIAMI, MEDIA INSIGHT GROUP, INC., a Florida Corporation d/b/a MEDIA INSIGHT, ROSANNA M. MENDEZ, and GEORGE A. ALVAREZ (collectively, “Defendants”):

I. PARTIES, JURISDICTION, AND VENUE

1. Plaintiff Heron Development Corporation (“Heron” or “Plaintiff”) is a company organized and validly existing under the laws of the Republic of Panama with its principal place of business in Torre Generali, Office No. 9C-1, 9th Floor, Ave Samuel Lewis, Panama City, Panama.

2. Pursuant to a December 5, 2015 Exclusive License Agreement, Heron has an exclusive license to use Palace Resort's intellectual property, including trademarks, for marketing and promotion efforts in the United States related to certain resorts. *See Exhibit 1, Exclusive License Agreement, dated December 5, 2015, at Article 3.* During the perpetual term of the Exclusive License Agreement, Heron has the exclusive right to enforce and protect the intellectual property, including trademarks, from dilution and infringement in the United States. *See id.* at Articles 6-7. Prior to Heron gaining the exclusive right to enforce and protect the intellectual property of Palace Resorts in the United States, those exclusive rights were held by International Hotel Reservations, S.A., which transferred its rights and obligations to Heron on December 4, 2015, as part of a corporate restructuring.

3. Defendant Vacation Tours, Inc., d/b/a Vacation Store of Miami ("VSM") & Vacation Store, is a Florida Corporation with its principal place of business in Coral Gables, Florida.

4. Defendant Media Insight Group, Inc. d/b/a Media Insight ("Media Insight") is a Florida Corporation with its principal place of business in Miami Beach, Florida.

5. Defendant George A. Alvarez ("Alvarez") is the registered agent and officer/director of Defendant Media Insight and was a resident of Miami-Dade County, Florida at all relevant times referred to in this Complaint.

6. Defendant Rosanna M. Mendez ("Mendez") is an officer/director of Defendant Media Insight and Defendant VSM and was a resident of Miami-Dade County, Florida at all relevant times referred to in this Complaint.

7. At all times material to this action, each of the Defendants was the agent, servant, employee, partner, alter ego, subsidiary, or joint venturer of each of the other Defendants, and

the acts of each of Defendants were in the scope of such relationship; in doing the acts and failing to act as alleged in this Complaint, each of the Defendants acted with the knowledge, permission, and consent of each of the other Defendants; and each of Defendants aided and abetted the other Defendants in the acts or omissions alleged in this Complaint.

8. This Court has subject matter jurisdiction over Plaintiff's claims pursuant to 28 U.S.C. § 1121, § 1331, and § 1338.

9. This court has supplemental jurisdiction over the claims in this Complaint that arise under the law of the State of Florida pursuant to 28 U.S.C. § 1367(a), because the state law claims are so related to the federal claims that they form part of the same case or controversy and derive from a common nucleus of operative facts.

10. This Court has personal jurisdiction over corporate Defendants VSM and Media Insight, both of which are located in and operate out of this judicial district. This Court also has personal jurisdiction over individual Defendants Mendez and Alvarez, both of whom reside in this judicial district. All Defendants have: (a) committed intentional and tortuous acts within this State; (b) conducted substantial business within this State related to the unlawful activity at issue in this Complaint; and (c) otherwise availed themselves of this forum.

11. Venue is proper in this court pursuant to 28 U.S.C. § 1391(a) and (b) because (i) Defendants' principal places of business are within this judicial district, (ii) Defendants conduct substantial business within this judicial district related to the unlawful activity at issue in this Complaint, (iii) Defendants reside in this judicial district, and (iv) a substantial part of the events or omissions giving rise to the claims occurred in this judicial district.

II. PLAINTIFF'S BUSINESS & TRADEMARKS

12. Heron is a wholesale commercial retailer of unsold resort inventory for eight all-inclusive hotel resorts in Mexico and the Caribbean, including: (1) Beach Palace, located in Cancun, Mexico (opened in October 1985); (2) Cozumel Palace, located in Cozumel, Mexico (opened in May 2005); (3) Isla Mujeres Palace, located in Isla Mujeres, Mexico (opened in January 2007); (4) Le Blanc Spa Resort, located in Cancun, Mexico (opened in August 2005); (5) Moon Palace Golf & Spa Resort, located in Cancun, Mexico (opened in January 1997); (6) Moon Palace Jamaica Grand, located in Ocho Rios, Jamaica (opened in June 2015); (7) Playacar Palace, located in Playa del Carmen, Mexico (opened in December 2005); and (8) Sun Palace, located in Cancun, Mexico (opened in December 1990) (collectively "the Palace Resorts"). Heron is also an intellectual property holding company that, pursuant to an Exclusive License Agreement, dated December 5, 2015, manages and protects the intellectual property of the Palace Resorts in the United States (*see Exhibit 1*).

13. The Palace Resorts are all-inclusive hotel resorts featuring banquet and conference facilities, wedding and honeymoon accommodations, restaurants, bars, world-class spas, fitness facilities, and optional golf packages.

14. Plaintiff Heron manages and protects numerous registered trademarks for the Palace Resorts in the United States which include (as registered on the date in parentheses):

1. BEACH PALACE (May 19, 2009)
2. CANCUN PALACE (Filed June, 2015)
3. COZUMEL PALACE (October 10, 2006)
4. ISLA MUJERES PALACE (April 28, 2009)
5. LE BLANC BED (May 18, 2010)
6. LE BLANC SPA RESORT (October 17, 2006)
7. MOON PALACE (May 22, 2001)
8. MOON PALACE GOLF & SPA RESORT (April 28, 2009)
9. MOON SPA & GOLF CLUB (April 28, 2009)
10. PALACE RESORTS (January 19, 2010)

11. PLAYACAR PALACE (October 24, 2006)
12. SUN PALACE (May 19, 2009)

Exhibit 2, printouts of Trademark Registrations.

15. In addition to having rights in the registered trademarks listed above, Plaintiff also has common law trademark rights in the marks and in variations of the marks, particularly in the word “Palace” and its associated stylized design and in each of the resort names and variations thereof, as set forth in Paragraph 11.

16. Plaintiff’s registered trademarks, common law trademarks, hotel names, trade names, service marks, domain names, and variants are collectively referred to as the “Palace Resort Marks”.

17. Plaintiff, and related companies, spend approximately \$12 million/year on advertising and promotion of the Palace Resort Marks (not including separate spending on public relations). The advertising mediums include television, newspapers, trade shows, and travel directories, as well as pamphlets, souvenirs and amenities. The Palace Resort Marks have been featured in such magazines as New York Times T Magazine; Travel & Leisure; Conde Nast Traveler; Departures; Brides; The Knot; AARP; and Elite Traveler; such newspapers as the Wall Street Journal; and on television stations and programs such as the Travel Channel; Real Housewives of Atlanta on Bravo; TODAY with Kathie Lee & Hoda on NBC; the Steve Harvey Show on NBC; the Wendy Williams Show on NBC; and E! News on E!TV. The Palace Resort Marks are also represented each year at the international tradeshows such as FITUR, IMEX, ITB, World Travelmart, and the New York Times Travel Show. Plaintiff uses Google AdWords to promote the Palace Resort Marks and attract online consumers and has filed copyright restrictions with Google for a number of the resort names and variations, restricting the ability of others to purchase these AdWords.

18. The Palace Resort Marks are marketed, in part, through each resort's websites, which include carefully designed and implemented marketing content about each resort, offer the ability to book rooms at defined prices, provide service to customers with inquiries about new and existing bookings made through travel agents or wholesalers and describe a customer experience associated with The Palace Resort Marks.

19. The Palace Resort Marks have established a strong United States and global customer base, and as a result the Palace Resorts are known throughout the world as all-inclusive resort vacation providers.

20. The Palace Resort Marks are distinctive and were distinctive in the United States marketplace at the time of all acts alleged herein and, as such, designate a source of origin of the resort's goods and services.

21. The Palace Resort Marks are widely known and recognized among the general consuming public and members of the United States and global travel communities.

22. As a result of a substantial marketing and brand investment, the Palace Resort Marks have developed a reputation for excellence and extensive goodwill in the United States market. As such, the Palace Resort Marks are extremely valuable to Plaintiff as the true indicator of Palace Resort's offerings.

23. As a result of extensive marketing and consumer recognition, the Palace Resort Marks are distinctive and famous within the meaning of 15 USC § 1125(c).

III. PLAINTIFF'S USE OF THE INTERNET

24. Plaintiff has all necessary right, title, and interest, including the right of enforcement, associated the Palace Resort Marks in the United States.

25. The Internet has become an indispensable tool through which Plaintiff brands its goods and services, obtains new customers, books reservations, identifies prospective customers, and provides information about its resorts.

26. Palace Holding, S.A. de C.V registered the domain name <palaceresorts.com> on October 3, 1996. *See Exhibit 3, WHOIS for <palaceresorts.com>*. The website at <palaceresorts.com> began functioning in or about 2007. Many updates to the website have occurred resulting in the current website, which is now available at <palaceresorts.com>. *See Exhibit 4, Printout of <palaceresorts.com> Website.*

27. Also on the October 3, 1996 <palaceresorts.com> registration date are the websites for several resorts including Beach Palace <palaceresorts.com/beachpalace/en>; Cozumel Palace <palaceresorts.com/cozumelpalace/en>; Isla Mujeres Palace <palaceresorts.com/ islamujerespalace/en>; Moon Palace Jamaica Grande <palaceresorts.com/ moonpalacejamaicagrande/en>; Playacar Palace <palaceresorts.com/playacarpalace/en>; and Sun Palace <palaceresorts.com/sunpalace/en>. *See Exhibit 5, Printouts of WHOIS for websites.*

28. In addition to the <palaceresorts.com> websites, Palace Holding, S.A. de C.V registered independent domain names for Le Blanc Spa Resort <leblancsparesort.com> on July 30, 2004, and Moon Palace Golf & Spa Resort <moonpalacecancun.com> on April 17, 2000. *See Exhibit 6, WHOIS for <leblancsparesort.com> and <moonpalacecancun.com>*.

29. Overall, Palace Holding, S.A. de C.V is the registrant of a portfolio of domain names that includes approximately 584 domains incorporating their hotel names, brands and trademarks. *See Exhibit 7, Domain Names (“Palace Resorts Domain Names”).*

30. Plaintiff Heron has all necessary rights, title, and interest, including the right of enforcement, associated the Palace Resorts trademarks, trade names and Domain Names in the United States.

IV. PRIOR DEALINGS OF THE PARTIES

31. In or about 2008, VSM began a marketing, advertising, and reservation referral service that included potential reservations at Palace Resorts hotels.

32. Palace Resorts and VSM engaged in a wholesaler relationship for approximately a decade. On June 10, 2012, Palace Resorts and VSM entered into the most recent Wholesaler Contract and Addendum that specified rates and terms for booking rooms at seven hotels owned and operated by Palace Resorts.

33. Like other approved travel wholesalers, VSM brokered Palace Resorts' hotels in accordance with the Wholesaler Contract and Addendum using pre-approved photographs and images of Palace Resorts' hotels and properties.

34. Neither Plaintiff nor Palace Resorts transferred or licensed to VSM or other Defendants any rights to the Palace Resort Marks for the purposes of stating or suggesting any common ownership, affiliation, sponsorship, or endorsement of VSM by Palace Resorts.

35. Neither Plaintiff nor Palace Resorts authorized VSM or other Defendants to commission the registration of domain names using the Palace Resort Marks for purposes of promoting its own services.

36. Neither Plaintiff nor Palace Resorts authorized VSM or other Defendants to use its infringing domain names, trademarks, pictures, designs, or other content for purposes stating or suggesting any common ownership, affiliation, sponsorship, or endorsement of VSM by Palace Resorts.

V. DEFENDANTS' UNLAWFUL ACTIONS

37. Defendant Media Insight is presently the registrant of the following domain names (collectively referred to as "Infringing Domain Names"):

1. <beachpalace.tv>
2. <beachpalacecancunhotel.com>
3. <beachpalacecancunresort.com>
4. <beachpalacegrand.com>
5. <palacecancunresort.com>
6. <cancunandbeachpalace.com>
7. <cancunpalace.tv>
8. <cancunpalacelasamericas.com>
9. <cancunpalacespecials.com>
10. <palacecancun.com>
11. <palacecancunhotel.com>
12. <palacecozumel.com>
13. <islamujerespalace.com>
14. <islamujerespalacegrand.com>
15. <palaceislamujeres.com>
16. <islamujerespalaceresort.com>
17. <leblanc-cancun.com>
18. <leblanc-hotel.com>
19. <leblanccancunresort.com>
20. <leblanccancunspa.com>
21. <leblancresortspa.com>
22. <moonpalacecancunresort.com>
23. <moonpalacepuntacanahotel.com>
24. <moonpalaceresortpuntacana.com>
25. <moonpalacepuntacanaresort.com>
26. <moonpalacerivieramaya.com>
27. <moonpalacejamaicagrand.com>
28. <moonpalacejamicaresort.com>
29. <palacejamaicagrande.com>
30. <moonpalaceochorios.com>
31. <palaceresortsguide.com>
32. <palaceplayacar.com>
33. <palaceplayacarresort.com>
34. <playacarpalace.com>
35. <playacarpalacegrand.com>
36. <playacarpalaceresort.com>
37. <sunpalace.tv>
38. <sunpalacecancunresort.com>
39. <sunpalaceresort.com>

40. <xpu-hapalaceresort.com>

See Exhibit 8, Exemplars of WHOIS Information for Infringing Domains.

38. Defendants are using the following Infringing Domain Names to display websites that unlawfully incorporate the Palace Resort Marks and copyright protected content, including descriptions of the hotel and its services as well as pictures of the resort:

1. <beachpalacecancunhotel.com>
2. <beachpalacecancunresort.com>
3. <beachpalacegrand.com>
4. <palacecancunhotel.com>
5. <palacecozumel.com>
6. <islamujerespalace.com>
7. <islamujerespalacegrand.com>
8. <palaceislamujeres.com>
9. <islamujerespalaceresort.com>
10. <leblanc-cancun.com>
11. <leblancancunspa.com>
12. <leblancresortspa.com>
13. <moonpalacecancunresort.com>
14. <moonpalacejamaicagrand.com>
15. <moonpalacejamaicaresort.com>
16. <moonpalaceochorios.com>
17. <palacejamaicagrande.com>
18. <palaceresortsguide.com>
19. <palaceplayacar.com>
20. <playacarpalace.com>
21. <playacarpalacegrand.com>
22. <sunpalacecancunresort.com>
23. <sunpalaceresort.com>

All contact information on these websites are for VSM. *See Exhibit 9, Printout of representative selection of listed websites.*

39. Defendants are using the domain names <moonpalacepuntacanahotel.com> and <moonpalacepuntacanaresort.com> as a link site to showcase Palace Resorts' competitors.

See Exhibit 10, Printout of listed websites.

40. Defendant Media Insight has registered other Infringing Domain Names with the Palace Resort Marks at <beachpalace.tv>, <cancunpalace.tv>, <cancunpalacelasamericas.com>, <cancunpalacespecials.com>, <palacecancun.com>, <leblanc-hotel.com>, <leblanccancunresort.com>, <moonpalaceresortpuntacana.com>, <moonpalacerivieramaya.com>, <palaceplayacarresort.com>, <playacarpalaceresort.com>, <sunpalace.tv> and <xpu-hapalaceresort.com>. These websites direct users to a Media Insight website, network solutions landing page, or Go-Daddy page. *See Exhibit 11, Printouts of exemplars of listed Websites.*

41. Defendants have made various changes to the domain names, uses, and associated websites over time.

42. Plaintiff learned that Defendant Media Insight had registered and was using the Palace Resorts Mark in domain registrations, which suggests that those domain names are owned, operated, sponsored, and/or endorsed by Palace Resorts.

43. On March 14, 2014, Kelly A. McGovern, Esq. (Tenzer PLLC) sent a letter to VSM (specifically Rosanna Mendez), notifying VSM of the termination of the Wholesaler Contract and Addendum. *See Exhibit 12, Notice of Termination Letter.*

44. On March 19, 2014, Kelly A. McGovern, Esq. (Tenzer PLLC) sent a letter demanding VSM cease and desist using the Palace Resort Marks. *See Exhibit 13, Cease and Desist Letter.*

45. In response, on April 1, 2014, VSM sent a proposed Domain Names License Agreement seeking payment by Plaintiff to Defendants for a transfer or use of the trademark protected domain names. *See Exhibit 14, Domain Name License Agreement.*

46. On June 15, 2015, Laura M. Reich, Esq. (Tenzer PLLC) sent another cease and desist letter to Rosanna Mendez and George Alvarez citing defendants' intellectual property infringements and several instances of customer confusion. *See Exhibit 15, June 15, 2015 Letters from Reich to Mendez and Alvarez.*

47. On June 24, 2015, James S. Robertson, Esq. (Gaebe, Mullen, Antonelli & DiMatteo) sent a response letter to Laura M. Reich, Esq., referencing a November 16, 2011 settlement agreement between Inversiones Zahena, S.A., VSM, and Media Insights. *See Exhibit 16, June 24, 2015 Letter from Robertson.*

48. Defendants presently use all Infringing Domain Names for their own internet marketing purposes.

49. The Infringing Domain Names are identical or confusingly similar to the Palace Resort Marks.

50. Defendants' registration and use of the Infringing Domain Names created and continues to create a likelihood of confusion for Palace Resort customers.

51. The operators of the Palace Resorts have received inquiries from consumers who had been to the infringing domains and websites believing those sites were owned, operated, and/or affiliated with Palace Resorts. The infringing domains and websites have repeatedly caused actual customer confusion about Palace Resort's rates, service, and many aspects of Palace Resort's hotels, services, and business. These actions have resulted in a loss of goodwill with Palace Resorts customers.

52. By means of their registration and use of the Infringing Domain Names, Defendants intended to capitalize on the goodwill associated with the Palace Resort Marks and Palace Resorts' own websites.

53. Defendants wrongfully profit from the unlawful use of the Palace Resort Marks.

54. Defendants use the Infringing Domain Names in commerce.

55. Defendants' use of the Infringing Domain Names has created a likelihood of confusion as to the source, sponsorship, affiliation, or endorsement of those websites.

56. Defendants' unauthorized registration and use of the Infringing Domain Names is or was likely to cause confusion, mistake, and deception as to the source or origin of the Infringing Domain Names, and is or was likely to suggest a false sponsorship, connection, license, or association of Defendants with Palace Resorts.

57. Defendants' activities have irreparably harmed the general public and, if not enjoined, will continue to harm the general public, who have an inherent interest in being free from confusion, mistake, and deception.

58. Defendants' activities have irreparably harmed Plaintiff and the Palace Resort Marks and, if not enjoined, will continue to harm Plaintiff and the Palace Resort Marks.

COUNT I
Cybersquatting under the Anticybersquatting
Consumer Protection Act – 15 U.S.C. § 1125(d)

59. Plaintiff restates and incorporates paragraphs 1-58 above as though fully restated herein.

60. Defendants registered, trafficked in, or used the Infringing Domain Names with a bad-faith intent to profit from the Palace Resort Marks.

61. Defendants, as domain name registrars, registered, or maintained the Infringing Domain Names with bad-faith intent to profit from such registration or maintenance of the Infringing Domain Names.

62. One or more of Defendants is or was the registrant or the registrant's authorized agent or user of each of the Infringing Domain Names.

63. The Infringing Domain Names are identical or confusingly similar to the Palace Resort Marks.

64. The Palace Resort Marks were distinctive at the time Defendants registered, trafficked in, or used the Infringing Domain Names.

65. Defendants do not have any intellectual property rights or any other rights in the Palace Resort Marks.

66. None of the Infringing Domain Names consist of the legal name of any of the Defendants, or a name that is otherwise commonly used to identify any of the Defendants.

67. Defendants registered and used the Infringing Domain Names to divert consumers from Plaintiff's websites to a website accessible under the Infringing Domain Names for Defendants' commercial gain by creating a likelihood of confusion as to the source, sponsorship, affiliation, or endorsement of the website.

68. Defendants have registered or acquired multiple domain names that Defendants knew were dilutive of famous marks of others that were famous when the domain names were registered.

69. The Palace Resort Marks are famous within the meaning of subsection 15 U.S.C. § 1125(c).

70. Defendants' registration, use, or trafficking in the Infringing Domain Names constitutes cybersquatting in violation of 15 U.S.C. § 1125(d), entitling Plaintiff to relief.

71. By reason of Defendants' acts alleged herein, Plaintiff's remedy at law is not adequate to compensate them for the injuries inflicted by Defendants. Accordingly, Plaintiff is entitled to preliminary and permanent injunctive relief pursuant to 15 U.S.C. § 1116.

72. By reason of Defendants' acts alleged herein, Plaintiff is entitled to recover Defendants' profits, actual damages and the costs of the action, or statutory damages under 15 U.S.C. § 1117, on election by Plaintiff, in an amount of one hundred thousand dollars (\$100,000) for each domain name found to constitute cybersquatting.

73. This is an exceptional case, making Plaintiff eligible for an award of attorneys' fees under 15 U.S.C. § 1117.

COUNT II
Trademark Infringement Under the Lanham Act – 15 U.S.C. § 1114

74. Plaintiff restates and incorporates paragraphs 1-73 above as though fully restated herein.

75. Defendants' use in commerce of the Palace Resort Marks and variations thereof is likely to cause confusion, mistake, and/or to deceive.

76. Defendants' use in commerce of the Infringing Domain Names is likely to cause confusion, mistake, and/or to deceive.

77. The above-described acts of Defendants constitute trademark infringement in violation of 15 U.S.C. § 114, entitling Plaintiff to relief.

78. Defendants have unfairly profited from the infringing actions alleged.

79. By reason of Defendants' acts, Plaintiff has suffered damage to the goodwill associated with the Palace Resort Marks.

80. Defendants' activities have irreparably harmed and, if not enjoined, will continue to irreparably harm Plaintiff and the Palace Resort Marks.

81. Defendants' activities have irreparably harmed, and if not enjoined, will continue to irreparably harm the general public who has an interest in being free from confusion, mistake, and deception.

82. By reason of Defendants' acts, Plaintiff's remedy at law is not adequate to compensate it for the injuries inflicted by Defendants. Accordingly, Plaintiff is entitled to entry of a temporary restraining order against Defendants and preliminary and permanent injunctive relief pursuant to 15 U.S.C. § 1116.

83. By reason of Defendants' willful acts, Plaintiff is entitled to damages, including but not limited to treble damages, under 15 U.S.C. § 1117.

84. This is an exceptional case, making Plaintiff eligible for an award of attorneys' fees under 15 U.S.C. § 1117.

COUNT III

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

85. Plaintiff restates and incorporates paragraphs 1-84 above as though fully restated herein.

86. Defendants' use in commerce of the Palace Resort Marks and variations thereof and the Infringing Domain Names is likely to cause confusion, mistake and to deceive the

relevant public by suggesting the Infringing Domain Names and the websites are authorized, sponsored, approved by, or affiliated with Plaintiff.

87. Defendants' use of the Palace Resort Marks and variations thereof and the Infringing Domain Names is likely to cause confusion among the general public.

88. The above-described acts of Defendants constitute trademark infringement of the Palace Resort Marks and false designation of origin in violation of 15 U.S.C. § 1125(a), entitling Plaintiff to relief.

89. Defendants have unfairly profited from the actions alleged.

90. By reason of Defendants' acts alleged herein, Plaintiff has suffered monetary damage and loss of the goodwill associated with the Palace Resort Marks.

91. Defendants' activities have irreparably harmed and, if not enjoined, will continue to harm Plaintiff and the Palace Resort Marks.

92. Defendants' activities have irreparably harmed and, if not enjoined, will continue to harm the general public which has an interest in being free from confusion, mistake, and deception.

93. By reason of Defendants' acts alleged herein, Plaintiff's remedy at law is not adequate to compensate them for the injuries inflicted by Defendants. Accordingly, Plaintiff is entitled to entry of a temporary restraining order against Defendants and preliminary and permanent injunctive relief pursuant to 15 U.S.C. § 1116.

94. By reason of Defendants' willful acts, Plaintiff is entitled to damages, including but not limited to treble damages under 15 U.S.C. § 1117.

95. This is an exceptional case, making Plaintiff eligible for an award of attorneys' fees under 15 U.S.C. § 1117.

COUNT IV
Dilution Under 15 U.S.C. § 1125(c)

96. Plaintiff restates and incorporates paragraphs 1-95 above as though fully restated herein.

97. The Palace Resort Marks are and were famous, as that term is used in 15 U.S.C. § 1125(c), before Defendants' use of them and the Infringing Domain Names in commerce, due in part to the inherent distinctiveness and the extensive use, advertising, promotion, and recognition of the Palace Resort Marks.

98. Defendants' use of the Palace Resort Marks and variations thereof and the Infringing Domain Names in commerce is likely to cause dilution by blurring or dilution by tarnishment of the Palace Resort Marks.

99. Defendants have unfairly profited from the actions alleged.

100. By reason of Defendants' acts, Plaintiff has suffered damage to the goodwill associated with the Palace Resort Marks and has suffered and will continue to suffer irreparable harm.

101. By reason of Defendants' acts, Plaintiff's remedy at law is not adequate to compensate them for the injuries inflicted by Defendants.

102. Accordingly, Plaintiff is entitled to entry of a temporary restraining order against Defendants and preliminary and permanent injunctive relief pursuant to 15 U.S.C. § 1116.

103. By reason of Defendants' willful acts, Plaintiff is entitled to damages, and that those damages be trebled, under 15 U.S.C. § 1117.

104. This is an exceptional case, making Plaintiff eligible for an award of attorneys' fees, under 15 U.S.C. § 1117.

COUNT V

Trademark Infringement Under Florida Statutes § 495.131 et seq.

105. Plaintiff restates and incorporates paragraphs 1-104 above as though fully restated herein.

106. Defendants' acts violate Section 495.131 of the Florida Statutes, *et seq.* The infringing uses constitute unconsented copies or colorable imitations of the Palace Resort Marks, offering for sale or advertising services in a manner likely to cause confusion or mistake as to the source or origin of the services.

107. Defendants have intentionally advertised and offered for sale Defendants' services in the hospitality industry, using the Palace Resort Marks in domain registrations and using marks confusingly similar to the Palace Resort Marks in a manner likely to cause confusion or mistake and so as to confuse and deceive clients, potential clients, and the community at large, as to the origin and/or affiliation of Defendants' services, based upon the merit, reputation, and good will of Palace Resorts and its services and products

108. On information and belief, Defendants' unlawful conduct as set forth herein has been and continues to be willful, deliberate, fraudulent, and in bad faith.

109. Defendants' violation of Section 495.131 has caused and will continue to cause irreparable damage to Plaintiff, for which Plaintiff has no adequate remedy at law. Unless enjoined, Defendants will continue their violation, further injuring Plaintiff and confusing the public.

110. On information and belief, Defendants have received revenues and profits as a result of their trademark infringement to which Defendants are not entitled. Accordingly, Defendants have unfairly profited from the actions alleged herein.

111. Additionally, Plaintiff has suffered damages as a result of Defendants' infringement upon Plaintiff's trademarks for which Defendants are responsible. By reason of Defendants' acts alleged herein, Plaintiff has also suffered damage to the goodwill associated with the Palace Resort Marks and has suffered and will continue to suffer irreparable harm.

112. By reason of Defendants' acts alleged herein, Plaintiff's remedy at law is not adequate to compensate it for the injuries inflicted by Defendants. Accordingly, Plaintiff is entitled to entry of a temporary restraining order against Defendants and preliminary and permanent injunctive relief pursuant to F.S. §495.131.

113. Plaintiff seeks to recover the ill-gotten profits made by the Defendants and an award of treble damages under Florida Statute section 495.141. Due to the exceptional nature of Defendants' violations, Plaintiff is also eligible for and seeks an award of attorneys' fees under Florida Statute section 495.141.

COUNT VI

Trademark Dilution Under Florida Statutes § 495.151 et seq.

114. Plaintiff restates and incorporates paragraphs 1-113 above as though fully restated herein.

115. Defendants' acts violate Section 495.151 of the Florida Statutes, *et seq.* Defendants infringing uses of the Palace Resort Marks are intended to derive a commercial benefit from Plaintiff's already famous and distinctive Palace Resort Marks, causing a likelihood of injury to Plaintiff's business reputation and a dilution of the distinctive value and goodwill associated with the Palace Resort Marks.

116. The Palace Resort Marks are and were famous, as that term is used in Fla. Stat. § 495.151, before Defendants' used them and the Infringing Domain Names in commerce, due in

part to the inherent distinctiveness and the extensive use, advertising, promotion, and recognition of the Palace Resort Marks.

117. The Palace Resort Marks have also acquired secondary meaning in the hospitality industry, connoting quality of services, pricing, and product in the minds of the community at large.

118. Defendants have intentionally advertised and offered for sale Defendants' services in the hospitality industry, using the Palace Resort Marks in domain registrations and using marks confusingly similar to the Palace Resort Marks so as to confuse and deceive clients, potential clients, and the community at large as to the origin and/or affiliation of Defendants' services.

119. Defendants' use of the Palace Resort Marks and variations thereof and the Infringing Domain Names in commerce is likely to cause dilution by blurring or tarnishment of the Palace Resort Marks.

120. On information and belief, Defendants' unlawful conduct as set forth herein has been and continues to be willful, deliberate, fraudulent, and in bad faith.

121. Defendants' violation of Section 495.151 has caused irreparable damage to Plaintiff, for which Plaintiff has no adequate remedy at law. Unless enjoined, Defendants will continue the violation, further injuring Plaintiff and confusing the public. Accordingly, Plaintiff is entitled to entry of a temporary restraining order against Defendants and preliminary and permanent injunctive relief.

122. By reason of Defendants' acts alleged herein, Plaintiff has suffered damages as a result of the dilution of Plaintiff's trademarks. Plaintiff has also suffered damage to the goodwill

associated with the Palace Resort Marks and has suffered and will continue to suffer irreparable harm.

123. Plaintiff seeks to recover the ill-gotten profits made by the Defendants. Due to the exceptional nature of Defendants' violations, Plaintiff is also eligible for and seeks an award of attorneys' fees.

COUNT VIII
Deceptive and Unfair Trade Practices
Under Florida Statutes §§ 501.201 et seq.

124. Plaintiff restates and incorporates paragraphs 1-123 above as though fully restated herein.

125. Defendants' trademark infringement constitutes unfair and deceptive acts in violation of the Florida Deceptive and Unfair Trade Practices Act ("FDUTPA"), Florida Statutes §§ 501.201, *et seq.*

126. Plaintiff is an "aggrieved" person under the FDUTPA and has standing to bring this claim.

127. Members of the general public are likely to be confused as to whether Defendants are affiliated with Plaintiff. Defendants' conduct has had, and will continue to have, an adverse effect on Plaintiff and on members of the general public. As a direct and proximate result of Defendants' unfair trade practices, members of the general public have mistakenly believed, and will continue to believe, that Defendants' businesses, and the services provided by Defendants, are approved or endorsed by, or otherwise provided by Plaintiff.

128. On information and belief, Defendants' unlawful conduct as set forth herein has been and continues to be willful, deliberate, fraudulent, and in bad faith.

129. By reason of Defendants' acts alleged herein, Plaintiff has suffered damage to the goodwill associated with the Palace Resort Marks and has suffered and will continue to suffer irreparable harm. Unless enjoined, Defendants will continue to violate FDUTPA, further injuring Plaintiff and confusing the public. Accordingly, Plaintiff is entitled to entry of a temporary restraining order against Defendants and preliminary and permanent injunctive relief.

130. Defendants' acts and practices as alleged herein offend public policy, are and were unethical, oppressive, and unscrupulous, and cause and have caused Plaintiff and consumers substantial and unavoidable injury. As a direct and proximate result of Defendants' unfair, unconscionable, and deceptive acts and practices, Plaintiff has sustained injury and damages.

131. Plaintiff seeks to recover their actual damages suffered as a result of Defendants' conduct. Plaintiff is also eligible for and seeks an award of attorneys' fees.

PRAYER FOR RELIEF

WHEREFORE, Plaintiff respectfully requests that the Court enter judgment against Defendant as follows:

- A. That the Court issue temporary and permanent injunctive relief against Defendants, and that Defendants, their officers, agents, representatives, servants, employees, attorneys, successors and assignees, and all others in active concert or participation with Defendants, be enjoined and restrained from:
 - i. registering, using, or trafficking in any domain name that is identical or confusingly similar to the Palace Resort Marks, including but not limited to the Infringing Domain Names;
 - ii. infringing Plaintiff's trademarks and service marks, including the Palace Resort Marks set forth above; and

- iii. assisting, aiding, or abetting any other person or business entity from engaging in or performing any of the activities referred to in subparagraphs i) and ii) above.
- B. That the Court order the transfer of the Infringing Domain Names to Plaintiff;
- C. That the Court award Plaintiff actual damages and statutory damages;
- D. That the Court award Plaintiff treble damages pursuant to 15 U.S.C § 1117 and F.S. §495.141;
- E. That the Court order Defendants to disgorge all ill-gotten gains;
- F. That the Court award Plaintiff its attorneys' fees and costs; and
- G. That the Court grant Plaintiff all other relief to which it is entitled and such other or additional relief as is just and proper.

JURY DEMAND

Plaintiff hereby demands a trial by jury of all matters triable as of right in the instant cause of action.

Respectfully submitted this 22 day of December, 2016

Attorneys for Plaintiff

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CERTIFICATE OF SERVICE

I HEREBY CERTIFY that on December 22, 2016, I electronically filed the foregoing document with the Clerk of the Court using the CM/ECF filing system. I also certify that the foregoing document is being served on the same date on all counsel of record or pro se parties on the following Service List in the manner specified, either via transmission of Notices of Electronic Filing generated by the CM/ECF system or in some other authorized manner for those counsel or parties who are not authorized to receive electronically Notices of Electronic Filing.

/s/Laura M. Reich

Laura M. Reich

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