

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

HERON DEVELOPMENT CORPORATION,  
a foreign corporation,

Plaintiff,

Case No. 1: 16-cv-20683-FAM

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.

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**DEFENDANTS' ANSWER AND AFFIRMATIVE DEFENSES TO AMENDED**

**COMPLAINT**

Defendants, VACATION TOURS, INC., MEDIA INSIGHT GROUP, INC., ROSANNA METZ-MENDEZ and GEORGE ALVAREZ (collectively "Defendants"), through undersigned counsel, hereby Answer the Amended Complaint and Demand for Jury Trial, state their Affirmative Defenses, and state:

**I. PARTIES, JURISDICTION, AND VENUE**

- 1-2 Defendants deny the allegations of paragraphs numbered 1 through 2.  
3-6 Defendants admit the allegations of paragraphs numbered 3 through 6.  
7-11. Defendants deny the allegations of paragraphs numbered 7 through 11.

**II. PLAINTIFF'S BUSINESS AND TRADEMARKS**

- 12- 23. Defendants deny the allegations of paragraphs numbered 12 through 23.

**III. PLAINTIFF'S USE OF THE INTERNET**

- 24-30. Defendants deny the allegations of paragraphs numbered 24 through 30.

**IV. PRIOR DEALINGS OF THE PARTIES**

31-32. Defendants deny the allegations of paragraphs numbered 31 through 32.

33. Defendants admit the allegations of paragraph numbered 33.

34-58. Defendants deny the allegations of paragraphs numbered 34-58.

**COUNT I**

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

59. Defendants incorporate their answers and denials to paragraphs numbered 1 through 58.

60-73. Defendants deny the allegations of paragraphs numbered 60 through 73.

**COUNT II**

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

74. Defendants incorporate their answers and denials to paragraphs numbered 1 through 73.

75-84. Defendants deny the allegations of paragraphs numbered 75 through 84.

**COUNT III**

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

85. Defendants incorporate their answers and denials to paragraphs numbered 1 through 84.

86-95. Defendants deny the allegations of paragraphs numbered 86 through 95.

**COUNT IV**

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

96. Defendants incorporate their answers and denials to paragraphs numbered 1 through 95.

97-104. Defendants deny the allegations of paragraphs numbered 97 through 104.

**COUNT V**

**Trademark Infringement Under Florida Statute – § 495.131 et. seq.**

105. Defendants incorporate their answers and denials to paragraphs numbered 1 through 104.

106-113. Defendants deny the allegations of paragraphs numbered 106 through 113.

**COUNT VI**

**Trademark Dilution Under Florida Statutes §§ 495.151 et. seq.**

114. Defendants incorporate their answers and denials to paragraphs numbered 1 through 113.

115-123. Defendants deny the allegations of paragraphs numbered 115 through 123.

**COUNT VII (sic)**

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

124. Defendants incorporate their answers and denials to paragraphs numbered 1 through 123.

125-131 Defendants deny the allegations of paragraphs numbered 125 through 131.

**AFFIRMATIVE DEFENSES**

**First Affirmative Defense**

Plaintiff fails to state a claim for which relief could be granted. Plaintiff, by its own actions and the actions of their related entities, are estopped or have waived their right to bring those claims. Plaintiff, entered into written agreements with Defendant, Vacation Tours, Inc., agreeing to provide Defendant with instantaneous online booking of hotel rooms in the every same hotels of which Plaintiff now complains of Defendants sale of rooms, and established specific credit lines for Defendants to allow it to make such accommodations. Thus, Plaintiff is suing Defendants for doing the very thing that the Plaintiff contracted for Defendants to do.

As a result of such contractual commitments, Plaintiff may not be heard to complain of the matters set forth in their Complaint.

**Second Affirmative Defense**

Vacation Tours has permission to advertise and use Plaintiff's marks and therefore cannot be held liable to Plaintiff.

**Third Affirmative Defense**

Vacation Tours' use of marks to sell genuine goods, in advertising genuine goods and actions of re-packaging genuine goods, are protected under the first sale doctrine.

**Fourth Affirmative Defense**

Plaintiff's claims are barred by doctrine of waiver.

**Fifth Affirmative Defense**

Plaintiff's claims are barred by estoppel by acquiescence.

**Sixth Affirmative Defense**

Plaintiff's claims are barred by doctrine of laches.

**Seventh Affirmative Defenses**

Plaintiff's claims are barred by doctrine of equitable estoppel.

**Eight Affirmative Defenses**

Plaintiff's claims are barred by their failure to enforce the marks against others in the travel industry who are also engaged in selling accommodations at the Plaintiff's resorts by the use of the marks in e-commerce and print advertising.

**Ninth Affirmative Defense**

Plaintiff's claims are barred by the benefit they received by Vacation Tours' promotion of the Plaintiff's properties.

**Tenth Affirmative Defense**

Plaintiff's claims are barred by the doctrine of unclean hands in that their selective enforcement of said marks are designed to interfere with Vacation Tours' contractual rights.

**Eleventh Affirmative Defense**

Plaintiff's are estopped in bringing these claims by their anti-competitive and unfair trade practices.

**Twelfth Affirmative Defense**

All marks are generic and not entitled to protection.

**Thirteenth Affirmative Defense**

Plaintiff cannot trademark primarily geographic descriptive words or terms or restrict others from utilizing them.

**Fourteenth Affirmative Defense**

With respect to the websites, Plaintiff does not have the right in either the word or the term.

**Fifteenth Affirmative Defense**

Plaintiff cannot demonstrate that it has trademark rights in the marks at issue distinctive enough to deserve protection and the Defendants' use of said marks is not likely to cause consumer confusion as to the proper origin of the good offered.

**Sixteenth Affirmative Defenses**

Plaintiff has failed to join necessary and indispensable parties for just adjudication of these claims under Rule 19, Fed. R. Civ.P. Therefore, Plaintiff's claims cannot stand.

**Seventeenth Affirmative Defense**

Plaintiff cannot demonstrate that irreparable harm will result without the granting of permanent injunctive relief and that any harm will not be compensable by money damage therefore any claim for injunctive relief cannot stand.

**Eighteenth Affirmative Defense**

The relief requested is not available in a Lanham Act prosecution.

**Nineteenth Affirmative Defense**

In regards to all claims against the individual Defendants, Plaintiff has failed to adequately allege the role of the individuals in order to establish individual liability.

**Twentieth Affirmative Defense**

Plaintiff is unable to demonstrate bad faith. Plaintiff or its predecessors in interest knew and approved of the Defendants domain name registrations entered into prior to the trademark registrations, and there is no basis to establish bad faith intent in obtaining the domain names.

**Twenty First Affirmative Defense**

Defendants are entitled to use the domain names under the doctrine of fair use. One can use another mark truthfully to identify another's goods or services in order to describe or compare its product to the market holder's product. The marks used on the websites do not extend beyond what is reasonably necessary to identify Palace Resort Hotels.

**Twenty Second Affirmative Defense**

Plaintiff cannot demonstrate irreparable harm. As alleged by the Plaintiff, the parties have been in business for a number of years and the Defendants have used the domain names for years with the Plaintiff's knowledge. The Plaintiff authorized Defendants to use the domain names to promote the Plaintiff's hotels. There are no claims that the Defendants have used the domain names throughout the course of the relationship between the parties.

**Twenty Third Affirmative Defense**

Under the ACPA, liability attaches only to the registrant of the domain name. Liability does not attach to users of a domain name.

**Request for Attorneys' Fees**

If the Defendants are the prevailing party, reasonable attorneys' should be awarded under 15 U.S.C. §1117.

WHEREFORE, having fully answered the Amended Complaint and state their Affirmative Defenses thereto, Defendants, VACATION TOURS, INC., MEDIA INSIGHT GROUP, INC.,

ROSANNA METZ-MENDEZ and GEORGE ALVAREZ, respectfully request that this Court enter judgment in their favor and against Plaintiff, HERON DEVELOPMENT CORPORATION, and award Defendants their attorneys' fees and costs.

**CERTIFICATE OF SERVICE**

WE HEREBY CERTIFY that a true and correct copy of the foregoing was served via Email on the 13th day of January, 2017 upon: Laura M. Reich, Esq., [lreich@tenzer.com](mailto:lreich@tenzer.com); Australia Alba, Esq., [aalba@tenzer.com](mailto:aalba@tenzer.com); TENZER PLLC., 1001 Brickell Bay Drive, Suite 1812, Miami, Florida 33131 and Enrico Schaefer, Esq., TRAVERSE LEGAL, 810 Cottageview Drive, Unit G-20, Traverse City, MI 49686.

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