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IN THE UNITED STATES DITRICT COURT FOR THE NORTHERN DISTRICT OF ILLINOIS, EASTERN DIVISION

CLERK, U.S. DISTRICT COURT
MAGISTRATE JUDGE ASHMAN
JUDGE HART

BEST VACUUM, INC., an Illinois Corporation, Plaintiff,	)	
	)	COMPLAINT FOR TRADEMARK INFRINGEMENT, TRADEMARK DILUTION, UNFAIR COMPETITION, AND DECEPTIVE TRADE PRACTICES
v.	)	
IAN DESIGN, INC., a New Jersey corporation, Defendant.	)	Jury Demanded

Plaintiff, Best Vacuum, Inc., ("Best Vacuum") through its attorneys, alleges as follows:

I. SUMMARY

By this complaint, Best Vacuum seeks to prevent consumer confusion and protect "BEST VACUUM", an internationally recognized brand, from intentional dilution and infringement by a direct competitor. Defendant, Ian Design, Inc. ("Ian Design"), is operating an Internet Web site to compete directly with Best Vacuum's Internet Web site located at www.bestvacuum.com and is using bestvacuumcleaner.com and bestchoicevacuums.com as its trade names and trademarks to immediately convey to consumers an association with Best Vacuum and unfairly trade off the reputation and goodwill of the BEST VACUUM mark. Since 1983, Best Vacuum has marketed vacuum cleaners and accessories worldwide under the "BEST VACUUM" mark.

Best Vacuum has used this mark and trade name continuously since 1983 throughout North America and Europe in connection with the sale of Vacuums, Air Purifiers, Air Conditioners, Dehumidifiers, Humidifiers, Lamps, Lighting, Dust bags, Filters, Anti-Allergen Bedding and accessories for the foregoing. Further, Best Vacuum has invested substantial amounts in its advertising to develop the goodwill and good name associated with the Best

Vacuum mark. Since 1983, Best Vacuum has expended more than $1 million marketing BEST VACUUM.

In May of 1996 Best Vacuum registered the Internet Domain Name "bestvacuum.com." Since then, Best Vacuum has actively promoted the use of the mark BEST VACUUM on the Internet by advertising bestvacuum.com on Internet search engines and directories. Best Vacuum currently offers Vacuums, Air Purifiers, Air Conditioners, Dehumidifiers, Humidifiers, Lamps, Lighting, Dust bags, Filters, Anti-Allergen Bedding and accessories for sale directly to consumers via the Internet at www.bestvacuum.com.

In the Winter of 2003-2004, Ian Design began to advertise and promote itself and its vacuum cleaner products under the name "bestvacuumcleaner.com." In February 2004, Best Vacuum sent Ian Design a cease and desist letter directing Ian Design to cease use of bestvacuumcleaner.com. Ian Design failed to comply with Best Vacuum's request to cease use of the BEST VACUUM mark. Ian Design has not complied with Best Vacuum's request to cease using bestvacuumcleaner.com. Additionally, immediately after receiving Best Vacuum's letter, Ian Design registered the domain name "bestchoicevacuums.com" and is currently offering vacuum cleaners and accessories for sale directly to consumers using both domain names.

Ian Design's use of bestchoicevacuums.com and bestvacuumcleaner.com in direct competition with bestvacuum.com, for the identical type of goods distributed through the same channels of trade, is likely to confuse consumers. The similarity between the bestvacuumcleaner.com, bestchoicevacuums.com and bestvacuum.com marks will lead some to conclude that bestvacuumcleaner.com and bestchoicevacuums.com was exclusively or jointly developed by, licensed or certified by, or is otherwise associated or affiliated with Best Vacuum. Indeed, customers of Best Vacuum have been actually confused by the similarity. Consumers,

especially those first-time buyers who are not sophisticated, or who learn about bestvacuumcleaner.com and bestchoicevacuums.com by word of mouth, are likely to be misled as to the source, sponsorship, or affiliation of the bestchoicevacuums.com products.

Preventing this confusion will help consumers to make fully informed choices about the products they purchase and the merchants from whom they purchase, and will therefore promote the consumer protection goals of the trademark and unfair competition laws. In this action Best Vacuum seeks to enjoin Ian Design from using anything confusingly similar to the trade name and trademark BEST VACUUM for the marketing and sale of directly competing products. The unfair competition laws do not allow a latecomer to copy a famous mark and "free ride" on the goodwill associated with it. A myriad of other names are available. Best Vacuum's long term and extensive investment in BEST VACUUM has made that mark famous, and a direct competitor should not be allowed to benefit from that investment at the expense of Best Vacuum and to the detriment of consumers.

II. JURISDICTION AND VENUE

1. This is a Complaint for Trademark Infringement, Trademark Dilution and Unfair Competition arising under §§ 32 and 43 of the Lanham Act, 15 U.S.C. § 1114(1)(Trademark Infringement), 15 U.S.C. § 1125(c)(Trademark Dilution), and 15 U.S.C. § 1125(a)(Unfair Competition), and for deceptive trade practices arising under the Illinois Uniform Deceptive Trade Practices Act, 815 ILCS 510/2.

2. The Court has original subject matter jurisdiction over this action pursuant to 28 U.S.C. § 1331 and 28 U.S.C. § 1338(a). The Court has supplemental jurisdiction over the state law claim pursuant to 28 U.S.C. § 1367.

3. The Court has personal jurisdiction over the defendant Ian Design because the defendant maintains continuous and systematic commercial contacts with the State of Illinois. Also, the defendant has purposefully availed itself of the opportunity to conduct commercial activities in this forum, and this Complaint arises out of those activities. The defendant maintains Web sites at www.bestvacuumcleaner.com and www.bestchoicevacuums.com that actively and continuously solicit commercial interaction with Illinois residents, that actively displays, disseminates, and promotes the infringing bestvacuumcleaner.com and bestchoicevacuums.com marks, and that urges other proprietors of websites in Illinois and throughout the United States to display and propagate the infringing marks. The publication and dissemination of the infringing trademark in Illinois is causing ongoing injury to Best Vacuum and dilution of the BEST VACUUM trademark in Illinois.

4. Venue is proper in this Court pursuant to 28 U.S.C. § 1391(b), because a substantial part of the events giving rise to the claim occurred, and continue to occur, in the Northern District of Illinois. The damage to Best Vacuum described herein takes place in the Northern District of Illinois.

III. THE PARTIES

5. Best Vacuum is an Illinois corporation with its principal place of business in Chicago, Illinois. Best Vacuum's business activities include the sale of Vacuums, Air Purifiers, Air Conditioners, Dehumidifiers, Humidifiers, Lamps, Lighting, Dust bags, Filters, Anti-Allergen Bedding, accessories and related products. Best Vacuum uses the BEST VACUUM mark around the world to promote the sale of its products at its retail store locations and through its Internet Web site.

6. On information and belief, Ian Design is a New Jersey corporation that is registered to conduct business in New Jersey. Ian Design is marketing and selling directly competing vacuums, accessories and related products. Ian Design is currently using the marks BEST VACUUM, bestvacuumcleaner.com and bestchoicevacuums.com to promote the sales of its products.

IV. STATEMENT OF FACTS

7. Best Vacuum, Inc. is a world leader in the market for vacuum cleaners sold to consumers via the Internet.

8. Since at least as early as 1983, Best Vacuum has used the trademark BEST VACUUM to promote its vacuum cleaner products for consumers.

9. On July 28, 2003, Best Vacuum applied for the registration of its BEST VACUUM trademark. United States Trademark Application Serial No. 78279712 is currently pending with the United States Patent & Trademark Office. (See Exhibit A.)

10. Since 1983, Best Vacuum has expended over $1 Million to market its products using the BEST VACUUM trademark. On average, Best Vacuum spends Sixty Thousand Dollars ($60,000) per month on Internet advertising alone. (See Exhibit B.) Best Vacuum continues to widely advertise and market BEST VACUUM using the BEST VACUUM trademark.

11. Best Vacuum currently sells eight (8) different brands of vacuum cleaner and is the leading United States distributor of Miehle brand Vacuum Cleaners. (See Exhibit B), Since its inception, Best Vacuum has sold to over fifty thousand (50,000) customers. This ongoing success is due at least in part to Best Vacuum's extensive effort to promote BEST VACUUM using the BEST VACUUM trademarks.

12. The BEST VACUUM trademark is broadly recognized both within the vacuum cleaner industry and among the general public as the brand identifier for Best Vacuum's products. BEST VACUUM is one of the most widely recognized brands in the nation. The fame and goodwill associated with the BEST VACUUM trademark is one of Best Vacuum's most valuable corporate assets.

13. On November 6, 2003, Ian Design registered the Internet domain name "bestvacuumcleaner.com." On February 14, 2004, Ian Design registered the Internet domain name "bestchoicevacuums.com." Both domain names lead consumers to products that compete directly with Best Vacuum's products, including identical brands. According to the Ian Design website, "bestchoicevacuums.com is wholly owned and operated by Ian Design, Inc....a sales and marketing organization...which specializes in the promotion of...consumer items." (See Exhibit C-1.)

14. Ian Design has chosen the trade names and trademarks "bestchoicevacuums" and "bestvacuumcleaner" to market and sell products that compete directly with BEST VACUUM.

15. Ian Design has continually used the trade names and trademarks "bestchoicevacuums" and "bestvacuumcleaner" in promoting both the company and its products.

16. On information and belief, Ian Design intends to continue to use the "bestchoicevacuums" and "bestvacuumcleaner" marks in promoting both the company and its products.

17. The "bestchoicevacuums" and "bestvacuumcleaner" marks and the BEST VACUUM mark are nearly identical in appearance, sound and overall impression. On information and belief, Ian Design intentionally adopted the "bestchoicevacuums" and

"bestvacuumcleaner" marks to trade on the fame and goodwill associated with the BEST VACUUM mark.

18. As part of its ongoing promotional, marketing and sales effort, Ian Design maintains an interactive commercial website at www.bestchoicevacuums.com and www.bestvacuumcleaner.com.

19. Ian Design's Web site actively solicits sales and invites potential customers to engage in a variety of interactive exchanges. On information and belief Ian Design has obtained subscribers for its mailing lists in the Northern District of Illinois and has distributed its newsletters, including the infringing trademarks, in the Northern District of Illinois.

20. Ian Design's Web site solicits consumers to send inquiries, send questions and get information about new products and promotional offers, join mailing lists and e-mail distribution groups, and e-mail questions to mailboxes specifically designated for such topics. On information and belief users in the Northern District of Illinois have responded to these requests and joined Ian Design mailing lists.

21. Ian Design's Web site also solicits users to establish a "link" and display on other Web sites advertisements containing the "bestchoicevacuums" and "bestvacuumcleaner" marks. Therefore, the "bestchoicevacuums" and "bestvacuumcleaner" marks are being been freely disseminated and published at other Internet locations. (See Exhibit C-2.)

22. Best Vacuum markets its products for sale to consumers at the retail level. Best Vacuum also sells its products directly to individual consumers via the Internet through its Web site located at www.bestvacuum.com. Therefore, by marketing the Ian Design products to retail consumers through the Internet, Ian Design is selling identical products in the same channels of distribution that are used by Best Vacuum.

23. The use of the "bestchoicevacuums" and "bestvacuumcleaner" marks to compete directly with BEST VACUUM is likely to cause consumer confusion, mistake, and deception.

24. The similarity between the "bestchoicevacuums," "bestvacuumcleaner" and BEST VACUUM marks is likely to lead consumers to mistakenly conclude that the "bestchoicevacuums" and "bestvacuumcleaner" Web sites were exclusively or jointly developed by, licensed or certified by, or otherwise sponsored or approved by Best Vacuum, or that Ian Design and its products are somehow otherwise affiliated, connected, or associated with Best Vacuum. Consumers are likely to be misled as to the true source, sponsorship, or affiliation of the Ian Design products.

25. On information and belief, through its use of the "bestchoicevacuums" and "bestvacuumcleaner" marks, Ian Design has intentionally and with knowledge sought to cause consumer confusion, mistake, and deception.

26. The ongoing promotion and dissemination of the "bestchoicevacuums" and "bestvacuumcleaner" marks is likely to lessen the capacity of the BEST VACUUM trademark to identify and distinguish Best Vacuum products. On information and belief, through the use of the "bestchoicevacuums" and "bestvacuumcleaner" marks Ian Design willfully intended to dilute the ability of the BEST VACUUM trademark to identify and distinguish Best Vacuum products.

COUNT I

TRADEMARK INFRINGEMENT UNDER LANHAM ACT § 32

27. Plaintiff realleges paragraphs 1-26 of this Complaint as if fully set forth herein.

28. Ian Design's use of the "bestchoicevacuums" and "bestvacuumcleaner" marks to promote, market, or sell products in direct competition with BEST VACUUM constitutes trademark infringement pursuant to 15 U.S.C. § 1114. Ian Design's intentional and willful

infringement of the BEST VACUUM trademark has caused and will continue to cause damage to Best Vacuum, and is causing irreparable harm to Best Vacuum for which there is no adequate remedy at law.

COUNT II

TRADEMARK DILUTION UNDER LANHAM ACT § 43

29. Plaintiff realleges paragraphs 1-28 of this Complaint as if fully set forth herein.

30. Ian Design's use of the "bestchoicevacuums" and "bestvacuumcleaner" marks to promote, market, or sell identical products constitutes willful Trademark Dilution pursuant to 15 U.S.C. § 1125(c). Ian Design's intentional and willful dilution of the BEST VACUUM trademark has caused and will continue to cause damage to Best Vacuum, and is causing irreparable harm to Best Vacuum for which there is no adequate remedy at law.

COUNT III

UNFAIR COMPETITION UNDER LANHAM ACT § 43

31. Plaintiff realleges paragraphs 1-30 of this Complaint as if fully set forth herein.

32. Ian Design's use of the "bestchoicevacuums" and "bestvacuumcleaner" marks to promote, market, or sell products in direct competition with BEST VACUUM constitutes Unfair Competition pursuant to 15 U.S.C. § 1125(a). Ian Design's use of the "bestchoicevacuums" and "bestvacuumcleaner" marks is likely to cause confusion, mistake, and deception among consumers. Ian Design's unfair competition has caused and will continue to cause damage to Best Vacuum, and is causing irreparable harm to Best Vacuum for which there is no adequate remedy at law.

COUNT IV

DECEPTIVE TRADE PRACTICES UNDER 815 ILCS 510/2.

33. Plaintiff realleges paragraphs 1-32 of this Complaint as if fully set forth herein.

34. Ian Design's use of the "bestchoicevacuums" and "bestvacuumcleaner" marks to promote, market, or sell products in direct competition with BEST VACUUM constitutes a deceptive trade practice pursuant to 815 ILCS 510/2 et seq. Ian Design's use of the "bestchoicevacuums" and "bestvacuumcleaner" marks is an unfair or deceptive practice occurring in trade or commerce that impacts the public interest and has caused injury to Best Vacuum. Plaintiff's unfair business practice has caused and will continue to cause damage to Best Vacuum, and is causing irreparable harm to Best Vacuum for which there is no adequate remedy at law.

WHEREFORE, plaintiff respectfully prays that this Court:

1. Issue a preliminary and permanent injunction, enjoining and prohibiting Ian Design, or its agents, servants, employees, officers, attorneys, successors and assigns from:

(A) Using the "bestchoicevacuums" and "bestvacuumcleaner" trade names or trademarks, or any version thereof, in connection with the description, marketing, promotion, advertising, or sale of vacuum cleaners or other similar products;

(B) Infringing Best Vacuum's BEST VACUUM trademark;

(C) Diluting Best Vacuum's BEST VACUUM trademark;

2. Order an award of damages in an amount to be determined at trial;

3. Order an award of treble damages as provided by Section 35(a) of the Lanham Act;

4. Order an award of attorney's fees and costs as provided by Section 35(a) of the Lanham Act and 815 ILCS 510/3, and

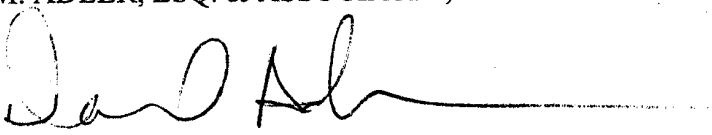
5. Any other or further relief that the Court deems appropriate.

V. JURY DEMAND

Plaintiff hereby demands a trial by jury of all issue in this case.

DATED this 23rd day of March, 2004.

DAVID M. ADLER, ESQ. & ASSOCIATES, PC

By: 

David M. Adler, ISBA #6242403

Attorneys for Plaintiff Best Vacuum, Inc.

Thank you for your request. Here are the latest results from the TARR web server.

This page was generated by the TARR system on 2004-03-23 14:03:58 ET

Serial Number: 78279712

Registration Number: (NOT AVAILABLE)

Mark (words only): BEST VACUUM

Standard Character claim: No

Current Status: A non-final action has been mailed. This is a letter from the examining attorney requesting additional information and/or making an initial refusal. However, no final determination as to the registrability of the mark has been made.

Date of Status: 2004-02-25

Filing Date: 2003-07-28

Transformed into a National Application: No

Registration Date: (DATE NOT AVAILABLE)

Register: Principal

Law Office Assigned: LAW OFFICE 115

Attorney Assigned:
COLLINS ALICIA Employee Location

Current Location: M6D -TMO Law Office 115 - Docket Clerk

Date In Location: 2004-02-25

LAST APPLICANT(S)/OWNER(S) OF RECORD

1. Best Vacuum, Inc.

Address:
Best Vacuum, Inc.
2646 N. Lincoln Ave. c/o Paul S. Teven
Chicago, IL 60614
United States
Legal Entity Type: Corporation
State or Country of Incorporation: Illinois
Phone Number: 773-348-4500

GOODS AND/OR SERVICES

Residential & commercial sanitization, humidification, and purification products
International Class: 007

EXHIBIT

First Use Date: 1983-05-26
First Use in Commerce Date: 1983-05-26

Basis: 1(a)

ADDITIONAL INFORMATION

Disclaimer: "BEST or VACUUM"

MADRID PROTOCOL INFORMATION

(NOT AVAILABLE)

PROSECUTION HISTORY

2004-02-25 - Non-final action mailed

2004-02-09 - Case file assigned to examining attorney

2003-10-21 - Applicant amendment prior to exam entered

2003-10-21 - TEAS Preliminary Amendment Received

CONTACT INFORMATION

Correspondent (Owner)
David M. Adler (Attorney of record)

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David M. Adler & Associates
2 N. LaSalle St., Suite 1600
Chicago, IL 60602

Phone Number: 1-312-379-0236
Fax Number: 1-312-255-1994

AFFIDAVIT

STATE OF ILLINOIS)
)
COUNTY OF COOK)

The undersigned, Paul Teven, under oath and intending to be bound, hereby avers, deposes and states as follows:

1. The undersigned is the President of Best Vacuum Inc. ("Applicant") and has the authority to act on behalf of the Applicant.

2. The undersigned has firsthand knowledge of the relevant facts and statements contained herein.

3. Applicant has made substantially exclusive and continuous use in commerce of the trade name and trademark "BEST VACUUM" since 1983 in connection with the marketing and sales of Vacuums, Air Purifiers, Air Conditioners, Dehumidifiers, Humidifiers, Lamps, Lighting, Dust bags, Filters, Anti-Allergen Bedding and accessories for the foregoing to consumers.

4. Applicant has made substantially exclusive and continuous use in commerce of the trade name and trademark "BEST VACUUM" since 1996 in connection with the marketing and sales of Vacuums, Air Purifiers, Air Conditioners, Dehumidifiers, Humidifiers, Lamps, Lighting, Dust bags, Filters, Anti-Allergen Bedding and accessories for the foregoing directly to consumers via the Internet.

5. Applicant has sold its products to customers throughout North America and Europe.

6. Applicant is the currently a leading sales representative in the United States for Miele brand vacuum cleaners, a brand originating in the Country of Germany.

7. Applicant has expended more than One Million Dollars ($1,000,000) promoting the mark "BEST VACUUM" and the Web site located at www.bestvacuum.com in print (Chicago Tribune & Chicago Magazine), radio, television and Internet advertising.

8. Currently, Applicant spends approximately Sixty Thousand Dollars ($60,000) per month on Internet Advertising of the mark "BEST VACUUM" and the Web site located at www.bestvacuum.com.

9. Applicant advertises in the most heavily used Internet search engines and

directories including Google & Overture.

10. Last year, Applicant's gross sales through its Internet Web site were approximately $3.75 million dollars.

11. The undersigned being warned that willful false statements and the like are punishable by fine or imprisonment, or both, under 18 U.S.C. 1001, and that such willful false statements and the like may jeopardize the validity of the application or document or any registration resulting therefrom, declares that all statements made of his/her own knowledge are true; and all statements made on information and belief are believed to be true.

Paul Teven

STATE OF ILLINOIS)
)
COUNTY OF COOK)

Subscribed and sworn to before me on this 24th day of March, 2004.

AS WITNESS my hand and Notarial Seal.

Notary Public

OFFICIAL SEAL
LETICIA VARGAS
Notary Public - State of Illinois
My Commission Expires Jun 19, 2007

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About Us

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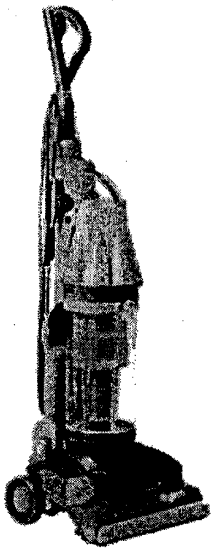

Representing only the best

BestChoiceVacuums.com is wholly owned and operated by Ian Design, Inc. Ian Design is a sales and marketing organization originally founded in 1987, which specializes in the promotion of those consumer items, identified by Ian Design, as providing superior performance, and which demonstrate the potential for both substantial and sustained market growth. We at Ian Design believe that the Dyson's DC07 line of Vacuum Cleaners is a prime example of this kind of exceptional product, and have created this site to promote Dyson Vacuum Cleaners and participate in Dyson's dynamic growth. We are proud to be aligned with Dyson, since we are certain that our customers will be equally pleased and satisfied with their purchase of a Dyson machine. We look forward to a long association with Dyson products and an equally rewarding relationship with our customers.

Recommending Superior Products

From time to time we may add products to this, or one of our other sites, which we feel meet the criteria we have outlined above. We welcome any suggestions from our customers regarding products we should investigate, or advice on how we can best improve this site. If you have a suggestion or care to bring a product to our attention please navigate to the "Contact Us" page and make your submission using the form located there.

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EXHIBIT

- Home
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- Dyson Story
- FAQs
- Testimonials
- About Us
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Links

Submit your website to be added to this directory. Click Here.

the Crystal and China Store	An elegant selection of crystal, glassware and porcelain collectibles
1st Body Balance - Liquid Vitamins by LifeForce	Liquid Vitamins and nutritional supplements to assist with weight loss, osteoporosis, calcium depletion. Life Force products help promote healthy Lifestyles with time tested diet products.
4 Her Comfort	Menastil - All natural, topically applied, temporary relief from menstrual cramps. Could help relieve Endometriosis cramps. There are no know side affects. Most women find relief in 5-15 minutes.
A Beautiful Princess Birthday Party	Princess Birthday Party in Los Angeles area. Live entertainment for childrens parties in OC/CA area. Live storybook characters, balloon sculptures, face paintings, puppets, music, games and fun !
China With Charm	China With Charm features dinnerware of all types including bone china, silverware, crystal and accessories.
Treasures and Time	Treasures and Time offers home and office decorating items including clocks, world globes, table and desk accessories.
Wood Working Today	Wood working today is dedicated to providing today's most relevant information and products for the woodworker, no matter the level of skill you may have.
YourFengShuiSource.Com	Yourfenghuisource.com offers a complete selection of Feng Shui products, Baguas, bells, Buddhas and more. Become a

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