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Attorneys for Plaintiff  
Green Building Initiative, Inc.

UNITED STATES DISTRICT COURT  
FOR THE DISTRICT OF OREGON

09-1167-KI

**GREEN BUILDING INITIATIVE, INC.,** an  
Oregon non-profit corporation,

Civil No. \_\_\_\_\_

Plaintiff,

**COMPLAINT FOR INFRINGEMENT OF  
FEDERAL TRADEMARK; VIOLATION  
OF LANHAM ACT; FALSE  
DESIGNATION, FALSE ADVERTISING;  
UNFAIR COMPETITION;  
INTENTIONAL INTERFERENCE WITH  
PROSPECTIVE BUSINESS RELATIONS**

v.

**GREEN GLOBE INTERNATIONAL, INC.,**  
a Delaware corporation,

**DEMAND FOR JURY TRIAL**

Defendant.

COMES NOW, the Plaintiff, Green Building Initiative, Inc. (hereinafter "Plaintiff"), by and through its attorneys, and for its Complaint against Green Globe International, Inc. (hereinafter "Defendant") states and alleges as follows:

**JURISDICTION AND VENUE**

1. This is a civil action arising under the Trademark Act of 1946, as amended (the Lanham Act, codified at 15 U.S.C § 1051, *et seq.*), for federal trademark infringement, false

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designation of origin and false advertising under the Lanham Act (codified at 15 U.S.C. § 1125); as well as under state common law.

2. This Court has jurisdiction of this action pursuant to 15 U.S.C. § 1121; 28 U.S.C. § 1331, and 28 U.S.C. § 1338(a) in that this case involves a federal question arising under the trademark laws of the United States. 15 U.S.C. § 1051, *et seq.*

3. This Court also has jurisdiction on the basis of the diversity of citizenship of the parties. 28 U.S.C. § 1332. The amount in controversy, exclusive of interest and costs, exceeds the sum of Seventy-Five Thousand and 00/100 Dollars (\$75,000).

4. The Court has jurisdiction of the state common law claims in that said state law claims are joined with a substantial and related federal claim arising under the trademark laws of the United States. *See* 15 U.S.C. § 1051, *et seq.*

5. Venue is proper in this Court because Defendant may be found in this judicial district, and Defendant's actions are directed at this district causing the injury that is felt in this judicial district by Plaintiff where its corporate headquarters are located. 28 U.S.C. §1391(b) and (c).

## **PARTIES**

6. Plaintiff is a non-profit corporation organized and existing under the laws of the State of Oregon, having its principal place of business at 2104 S.E. Morrison Street, Portland, Oregon 97214.

7. Defendant is a corporation incorporated under the laws of the State of Delaware. Defendant's corporate office in the United States is located at 29970 Technology Drive, Suite 203, Murrieta, California 92563.

## STATEMENT OF FACTS COMMON TO ALL COUNTS

8. Plaintiff is a non-profit accredited standards developer and the first green building organization to be accredited as a standards developer by the American National Standards Institute. Plaintiff is one of the leading green building organizations in the United States. Its mission is to establish and accelerate the adoption of building practices that result in energy-efficient, healthier, and environmentally sustainable buildings by promoting green building approaches for residential and commercial construction. Plaintiff is supported and governed by leading corporations and associations including Dow Chemical, Trane, Jeld-Wen, Capital One, Wood Promotion Network, Vinyl Institute, and Resilient Floor Covering Institute.

9. Under exclusive license from Jones Lang LaSalle, one the largest real estate investment and property management firms in the world, Plaintiff is the exclusive licensee of the trademark, GREEN GLOBES®, for which it has been issued two United States Federal Trademark Registrations, Reg. Nos. 3549714 and 3549715. These registrations include both design with words and standard character marks.

10. Plaintiff has used its GREEN GLOBES® trademark since at least as early as February 1, 2005 (hereinafter “Plaintiff’s Mark”), in connection with an assessment protocol and a rating system and guide for integrating environmentally friendly designs into both new and existing commercial buildings (hereinafter “Plaintiff’s Services”).

11. Through substantial investment, promotional efforts, business conduct, and continuous use of Plaintiff’s Mark, Plaintiff has developed and maintains customers throughout the United States. Plaintiff’s Mark has become, through widespread and favorable public acceptance and recognition, an asset of substantial value as a symbol of Plaintiff, its high quality products, services, and its good will with respect to Plaintiff’s Services.

12. Plaintiff's Services, in connection with Plaintiff's Mark, have become so widely accepted and recognized that they have been incorporated into statutes or executive orders in nineteen states. Federal guidance documents use Plaintiff's Services and Plaintiff's Mark to reference standards of sustainability of building design and operation. Likewise, leading sustainability organizations including American Institute of Architects, ASHRAE, United States EPA's Energy Star program, Building Owners and Manager's Association, National Association of Homebuilders, International Code Commission, and Alliance to Save Energy all reference Plaintiff's Services and Plaintiff's Mark in connection with sustainable building design and operation.

13. Major consumers of Plaintiff's Services, in connection with Plaintiff's Mark, include Capital One, JP Morgan Chase, Bristol Myers Squibb, Pfizer, Meadwestvaco, Whole Foods, Rubbermaid, as well as educational/non profit institutions such as Drexel University, University of Arkansas, Arizona State University, and the William Jefferson Clinton Presidential Library. These customers have received a GREEN GLOBES® certification of building design and operation.

14. President Obama specifically referenced GREEN GLOBES® with respect to his intention to expand federal grant programs to help states and localities build more efficient public buildings and adopt aggressive green building provisions. Moreover, the New York Times Magazine describes GREEN GLOBES® as the emerging green building standard.

15. Defendant uses the mark GREEN GLOBE also in connection with an environmental certification system for environmentally friendly building design and construction standards, as well as other green businesses (hereinafter Defendant's Services). Defendant purports to offer its GREEN GLOBE certification for sustainable performance in both design

and construction of building infrastructure. Defendant also has announced its intention to expand use of the GREEN GLOBE mark to environmentally friendly certification systems to other industries.

16. Defendant's GREEN GLOBE mark is substantially the same or confusingly similar to Plaintiff's Mark, GREEN GLOBES®.

17. The use by Defendant of the GREEN GLOBE mark in connection with a certification program for environmentally friendly building design and construction standards, as well as other green businesses has caused or is likely to cause confusion, mistake, or deception within the marketplace with respect to the association of Defendant to Plaintiff, as well as the origin, sponsorship, or approval of Defendant's Services by Plaintiff.

18. By letter, dated October 14, 2008, Plaintiff notified Defendant of its infringing use of Plaintiff's Mark, or a mark confusingly similar thereto, and demanded that Defendant cease and desist from further use in the United States. A copy of this letter is attached as Exhibit 1. Despite this effort by Plaintiff to stop Defendant's infringing use, Defendant continues to use the GREEN GLOBE mark without Plaintiff's consent. Defendant's continued infringement is willful, deliberate and malicious.

19. Plaintiff has been, and continues to be, injured by Defendant's unauthorized and unlawful use of Plaintiff's Mark, or a mark confusingly similar thereto. Defendant's use of Plaintiff's Mark is causing, or will imminently cause, irreparable harm to Plaintiff and Plaintiff's good will and reputation.

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**FIRST CLAIM FOR RELIEF**

**Infringement of Federal Trademark  
(15 U.S.C. § 1114)**

20. Plaintiff repeats and realleges each of the allegations contained in paragraphs 1 through 19 of this Complaint as if fully set forth herein.

21. Defendant's use of the GREEN GLOBE mark is likely to cause, or has caused, consumers to mistakenly believe that Defendant, and/or its good and services, is affiliated with Plaintiff, and/or its goods and services, that Defendant's business is sponsored or approved by Plaintiff, or that Defendant is otherwise associated with or has obtained permission from Plaintiff to use Plaintiff's GREEN GLOBES® mark in connection with the sale of goods and services by Defendant.

22. By engaging in the unauthorized activities described above, Defendant has infringed Plaintiff's rights in its trademark, GREEN GLOBES®, in violation of 15 U.S.C. § 1114. Furthermore, in view of the notice provided to Defendant by Plaintiff, such infringement was, and remains, willful and intentional.

23. Pursuant to 15 U.S.C. § 1117, Plaintiff is entitled to recover Defendant's profits as well as actual damages suffered by Plaintiff in an amount to be determined at trial, plus treble damages and attorney fees incurred herein.

24. Defendant's willful and intentional acts of infringement is causing or will imminently cause great and irreparable injury and damage to Plaintiff's business and its good will and reputation in an amount that cannot be ascertained at this time and, unless restrained, will cause further irreparable injury and damage, leaving Plaintiff with no adequate remedy at law.

25. Accordingly, pursuant to 15 U.S.C. § 1116, Plaintiff is entitled to injunctive relief against Defendant, and anyone acting in concert with Defendant, to restrain further acts of infringement on Plaintiff's GREEN GLOBES® mark, as well as require Defendant to recall products or rename services sold in a manner that infringe on Plaintiff's Mark and provide corrective advertising to disclaim any association between Plaintiff and Defendant, including any other relief deemed appropriate by the Court.

26. Plaintiff shall also be entitled to recover prejudgment interest pursuant to 15 U.S.C. § 1117.

### **SECOND CLAIM FOR RELIEF**

#### **False Designation of Origin and False Advertising under the Lanham Act (15 U.S.C. §§ 1116, 1117, 1125)**

27. Plaintiff repeats and realleges each of the allegations contained in paragraphs 1 through 26 of this Complaint as if fully set forth herein

28. Defendant, by and through its knowing and intentional unauthorized adoption and use of the GREEN GLOBE mark in association with environmentally friendly or green certification of products and services, has and continues to falsely designate its products and services as being derived or affiliated with those of the Plaintiff which promotes its environmentally friendly or green certification under its mark GREEN GLOBES®.

29. Defendant's use of the GREEN GLOBE mark is likely to cause, or has caused, consumers to mistakenly believe that Defendant, and/or its good and services, is affiliated with Plaintiff, and/or its goods and services, that Defendant's business is sponsored or approved by Plaintiff, or that Defendant is otherwise associated with or has obtained permission from Plaintiff

to use Plaintiff's Mark, GREEN GLOBES®, or a confusingly similar variation, in connection with the sale of goods and services by Defendant.

30. By engaging in the unauthorized activities described above, Defendant has made, and continues to make, false, deceptive, and misleading statements constituting false representations and false advertising made in connection with the sale of goods or services distributed in interstate commerce in violation of Section 43(a) of the Lanham Act, 15 U.S.C. § 1125(a). Furthermore, in view of the notices provided to Defendant by Plaintiff, such activities were, and remain, willful and intentional.

31. Defendant's willful and intentional acts of unfair competition, false advertising, and false designation of origin, have caused and are causing great and irreparable injury and damage to Plaintiff's business and its good will and reputation in an amount that cannot be ascertained at this time and, unless restrained, will cause further irreparable injury and damage, leaving Plaintiff with no adequate remedy at law.

32. Accordingly, pursuant to 15 U.S.C. § 1116, Plaintiff is entitled to injunctive relief against Defendant, and anyone acting in concert with Defendant, to restrain further acts of unfair competition, false advertising, and false designation of origin and, after trial, to recover any damages proven to have been caused by reason of Defendant's aforesaid acts, and to recover enhanced damages based on Defendant's willful, intentional, and/or grossly negligent acts.

33. As the prevailing party, Plaintiff shall also be entitled to recover its attorney fees and prejudgment interest pursuant to 15 U.S.C. § 1117.



### **THIRD CLAIM FOR RELIEF**

#### **Unfair Competition**

34. Plaintiff repeats and realleges each of allegations contained in paragraphs 1 through 33 of this Complaint as if fully set forth herein.

35. By committing the acts alleged herein, Defendant has and continues to unfairly compete with Plaintiff in the marketplace.

36. As a result of Defendant's unfair competition, Plaintiff is entitled to recover compensatory and punitive damages in an amount to be proven at trial, plus prejudgment interest.

37. Defendant's unfair competition will continue unless enjoined by this Court. Accordingly, Plaintiff is also entitled to an injunction against Defendant, and anyone acting in concert with Defendant, to immediately stop infringing on Plaintiff's Mark, as well as require Defendant to recall products and services sold in a manner that infringes on Plaintiff's Mark and provide corrective advertising to disclaim any association between Plaintiff and Defendant, and any other relief that the Court deems appropriate.

### **FOURTH CLAIM FOR RELIEF**

#### **Intentional Interference With Prospective Business Relations**

38. Plaintiff repeats and realleges each of allegations contained in paragraphs 1 through 37 of this Complaint as if fully set forth herein.

39. Defendant's continued unauthorized use of Plaintiff's Mark, or a confusingly similar variation thereof, has interfered with and impaired, or threatens to interfere with and impair, Plaintiff's ability to conduct business with consumers of Plaintiff's Services.

40. Defendant has employed improper means by using Plaintiff's Mark, or a confusingly similar variation thereof, without Plaintiff's consent.

41. Defendant has an improper motive to profit from and exploit Plaintiff's Mark without Plaintiff's permission and without payment to Plaintiff.

42. As a result of Defendant's interference with prospective business relations, Plaintiff has been damaged in an amount to be proven at trial. Plaintiff is entitled to recover both compensatory and punitive damages as a result of Defendant's intentionally tortious conduct.

43. Defendant's continued interference by using Defendant's Mark will irreparably harm Plaintiff's current and future ability to conduct business in the region where Defendant is located. Damages will not be adequate to redress such interference; thus, Plaintiff is entitled to injunctive relief to prevent further tortious interference by Defendant.

#### **PRAYER FOR RELIEF**

**WHEREFORE**, Plaintiffs respectfully pray for the following relief:

(1) A preliminary and permanent injunction enjoining Defendant, its employees, agents, officers, directors, attorneys, representatives, successors, affiliates, subsidiaries and assigns, and all those in concert or participation with any of them from:

(a) imitating, copying, using, reproducing, registering, attempting to register and/or displaying the mark and designation GREEN GLOBES®, or any other mark or designation which colorably imitates or is confusingly similar to this mark and designation, such as GREEN GLOBE, among others;

(b) using any other false description or representation or any other thing calculated or likely to cause confusion, deception or mistake in the marketplace with regard to Plaintiff's Mark; and

(2) An order directing that Defendant deliver up for destruction all materials and matter in its possession or custody or under its control that infringe on Plaintiff's Mark, including, without limitation, all advertising and promotional materials;

(3) An order directing that Defendant file with the Court and serve upon counsel for Plaintiff within thirty (30) days after the entry of such order or judgment, a report in writing and under oath setting forth in detail the manner and form in which it has complied with the injunction;

(4) An order awarding to Plaintiff, under 15 U.S.C. § 1117(a), all damages sustained by Plaintiff in an amount to be proven at trial, including Defendant's profits.

(5) An order awarding to Plaintiff treble actual damages or treble damages based upon an accounting of Defendant's profits, whichever is greater, including all statutory enhancements and other enhancements on account of the willful nature of Defendant's acts as provided in 15 U.S.C. § 1117(a);

(6) An order Awarding to Plaintiff compensatory and punitive damages for unfair competition and intentional interference with prospective business relationships;

(7) An order awarding prejudgment and post judgment interest;

(8) An award of Plaintiff's costs and expenses, including, without limitation, Plaintiff's attorney's fees incurred herein;

(9) An order for corrective advertising in a form, manner and frequency that is acceptable to Plaintiff and the Court; and


(10) All other relief, in law or in equity, to which Plaintiff may be entitled, or which the Court deems just and proper.

**JURY DEMAND**

Plaintiff hereby demands trial by jury on all issues so triable.

DATED this 2<sup>nd</sup> day of October, 2009.

ATER WYNNE LLP

By:   
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Attorneys for Plaintiff  
Green Building Initiative, Inc.

October 14, 2008

***Via Certified Mail***

Mr. Steven R. Peacock  
President/CEO  
Green Globe International, Inc.  
29970 Technology Drive, Suite 203  
Murrieta, CA 92563

Re: GREEN GLOBES™/GREEN GLOBE™

Dear Mr. Peacock:

This firm represents Green Building Initiative, Inc. (“GBI”), which is the exclusive owner of the trademark GREEN GLOBES™ in the United States. In addition to its common law usage of the GREEN GLOBES™ trademark, GBI has filed applications for registration with the United States Patent and Trademark Office for the words GREEN GLOBES™ (Serial No. 77/464841), as well as GREEN GLOBES™ and Design (Serial No. 77/464837).

As you are probably aware, GBI has established GREEN GLOBES™ as one of the two primary green building standards in the United States, as well as providing design review and verification. The GREEN GLOBES™ standard sets “green” standards for evaluating, rating, comparing, certifying, and/or improving the efficiency, sustainability, and environmental performances of both new and existing buildings. GBI’s use of the GREEN GLOBES™ trademark has created substantial goodwill in the United States, particularly in the commercial building market.

It is our understanding that Green Globe International, Inc. (“GGII”) is the majority owner of Green Globe, Ltd., a British company that owns the “Green Globe Brand,” which is also focused toward sustainability programs geared to sustainable travel, tourism and other related green businesses. We further understand the services delivered in connection with the Green Globe Brand include a *certification program*, which has been identified on the Internet as “the only international benchmarking and certification program designed specifically for the travel and tourism industry.” As a result of the strong similarity of the products and services offered by GBI and GGII, there is a strong likelihood of confusion between the marks in the minds of consumers.

Accordingly, it is of utmost importance to GBI that there is no confusion in the U.S. marketplace (or in North America) regarding the GREEN GLOBES™ trademarks. Moreover, any

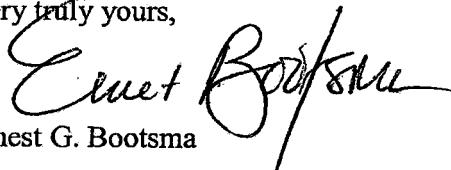
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use by GGII of the GREEN GLOBE trademark in the United States will improperly trade off the substantial goodwill that GBI have developed, and will infringe the rights of GBI in its trademarks.

Therefore, in view of the foregoing, we respectfully request that GGII avoid any future use, marketing or sale of the GREEN GLOBE benchmarking standard in the United States, or the use of any confusingly similar variations thereof. Please be advised, in the event that GGII makes use of the GREEN GLOBE trademark in the United States, GBI will take such action as it deems advisable to protect its interests. In any case, GBI expressly reserves all rights it may have under applicable state and federal laws in the United States with respect to this matter.

From a business perspective, we assume that you share our interest in avoiding confusion in the marketplace and expect cooperation between our companies.

Very truly yours,

  
Ernest G. Bootsma

cc: Green Building Initiative, Inc.  
L. David Connell