

**IN THE UNITED STATES DISTRICT COURT
DISTRICT OF MINNESOTA**

Wind Turbine Industries Corp.,)	
)	
Plaintiff,)	Civil Action No.: _____
)	
v.)	JURY TRIAL DEMANDED
)	
Jacobs Wind Electric Company, Inc.,)	
)	
Defendant.)	
)	

Plaintiff, Wind Turbine Industries Corp., for its Complaint against Defendant, Jacobs Wind Electric Company, Inc., states:

THE PARTIES

1. Plaintiff, Wind Turbine Industries Corp., is a Minnesota corporation with its principal place of business at 16801 Industrial Circle S.E., Prior Lake, Minnesota 55372.
2. Defendant, Jacobs Wind Electric Company, Inc., is a Florida corporation having its principal place of business at 8020 Strehler Road, Corcoran, Minnesota 55340.

JURISDICTION AND VENUE

3. This is an action for unfair competition, cancellation of U.S. Trademark Registration No. 1,532,714, and refusal of registration for U.S. Trademark Application Serial No. 76/677,473 under Sections 14, 37 and 43(a) of the Lanham Act, 15 U.S.C. §§1051 et seq.; deceptive trade practices arising under the Minnesota Deceptive Trade Practices Act, Minn. Stat. §§ 325D.43 et seq.; unlawful trade practices under the Minnesota Unlawful Trade Practices Act, Minn. Stat. §§ 325D.09 et seq.; and common law trademark infringement and unfair competition.

4. This Court has jurisdiction of this action under 28 U.S.C. §§ 1331, 1332 and 1338 and 15 U.S.C. § 1121, as well as supplemental jurisdiction under 28 U.S.C. § 1367. The amount in controversy, exclusive of costs and interest, exceeds Seventy-Five Thousand Dollars (\$75,000.00).

5. Venue is proper in this district under 28 U.S.C. § 1391 as the Defendant resides in this district, and because a substantial part of the events giving rise to the claim occurred in this district.

INTRODUCTION

6. Wind Turbine Industries brings this action to protect its JACOBS trademark against continued infringement by Defendant. Wind Turbine Industries and its predecessors in interest have used the JACOBS mark since at least as early as 1979 in connection with wind energy products. Defendant is wrongfully using and has fraudulently obtained a registration for the mark JACOBS WIND ENERGY SYSTEMS & Design in connection with identical goods, and is wrongfully using and fraudulently seeking registration of the mark JACOBS in connection with identical goods. Defendant's use of JACOBS and JACOBS WIND ENERGY SYSTEMS & Design violates Wind Turbine Industries' rights and is likely to cause confusion among consumers unless such use is enjoined, Defendant's registration for the mark JACOBS WIND ENERGY SYSTEMS & Design is cancelled, and Defendant's application for the mark JACOBS is refused registration.

PLAINTIFF'S RIGHTS

7. On August 24, 1982, Jacobs Wind Electric Company, a Delaware corporation (hereinafter referred to as "Jacobs Delaware"), registered U.S. Trademark Registration No. 1,206,629 for the mark JACOBS for use in connection with "wind electric plants, comprising

wind-driven electric generators and parts thereof mounted upon metal towers and the like” in International Class 7. A true and correct copy of Registration No. 1,206,629 is attached hereto as Exhibit A.

8. Jacobs Delaware was renamed Earth Energy Systems, Inc. (hereinafter “EESI”).

9. By a service agreement dated May 24, 1986, EESI granted Defendant a right to limited use of the mark JACOBS as shown in Registration No. 1,206,629. By this agreement, Defendant agreed not to use the mark JACOBS in connection with the manufacture or sale of wind energy equipment.

10. By an agreement dated December 15, 1986, EESI granted all right, title, and interest in Registration No. 1,206,629 for the mark JACOBS to Wind Turbine Industries.

11. Wind Turbine Industries acknowledges the limited right of Defendant to use the mark JACOBS in connection with the provision of repair services related to wind energy equipment pursuant to the earlier agreement between EESI and Defendant.

12. Wind Turbine Industries currently manufactures, markets, and sells wind energy equipment and parts therefore under its distinctive JACOBS mark.

13. Wind Turbine Industries and its predecessors in interest have been using the JACOBS mark in connection with the manufacture, sale, and promotion of wind energy equipment since at least as early as 1979. Wind Turbine Industries has developed a strong reputation for manufacturing and selling high quality wind energy products under the JACOBS mark.

14. Wind Turbine Industries has advertised and promoted its JACOBS mark, and has made substantial sales of its wind energy products bearing the JACOBS mark. As a result of

these activities, the JACOBS mark has achieved widespread consumer recognition in the wind energy industry, making it a strong mark entitled to broad protection against infringement.

15. Wind Turbine Industries' JACOBS mark has acquired considerable value and has become well-known among the relevant consuming public and the trade as identifying and distinguishing the exclusive source of Wind Turbine Industries' wind energy products sold under the JACOBS mark.

DEFENDANT'S WRONGFUL CONDUCT

16. On August 12, 1988, Defendant filed for and later obtained U.S. Trademark Registration No. 1,532,714 for the mark JACOBS WIND ENERGY SYSTEMS & Design for use in connection with "wind energy conversion apparatus comprising wind-driven generators for electrical and mechanical power generation and parts thereof mounted upon metal towers and the like" in International Class 7. A true and correct copy of Registration No. 1,532,714 is attached hereto as Exhibit B.

17. Pursuant to the May 24, 1986 agreement between EESI and Defendant, Defendant had and currently has no right to use the JACOBS WIND ENERGY SYSTEMS & Design mark in connection with the manufacture or sale of the wind energy equipment covered by Registration No. 1,532,714.

18. Registration No. 1,532,714 was obtained fraudulently because Defendant, having full knowledge that it had no right to use the JACOBS WIND ENERGY SYSTEMS & Design mark in connection with the manufacture or sale of the wind energy equipment, filed a false declaration in support of Registration No. 1,532,714, signed on August 5, 1988 by Paul R. Jacobs, President of Defendant Jacobs Wind Electric Company, Inc., stating that (1) Defendant believed itself to be the exclusive owner of the registered mark, and (2) that no one else, to the

best of its knowledge and belief, had the right to use the mark in commerce, either in the identical form or in such near resemblance as to be likely, when applied to the goods or services of the other person, to cause confusion or mistake, or to deceive. This false declaration violates 15 U.S.C. § 1051(a)(3)(A) and 37 C.F.R. § 2.33(b)(1).

19. Registration No. 1,532,714 was also obtained fraudulently because, upon information and belief, the specimen of use filed by Defendant in support of its application to register Registration No. 1,532,714 was a photograph of a generator fin not first sold by Defendant.

20. Registration No. 1,532,714 was also obtained fraudulently because, upon information and belief, the specimen of use filed by Defendant in support of its renewal of Registration No. 1,532,714 was a photograph cropped by Defendant to misrepresent the fact that the product being installed was primarily not made by Defendant.

21. On or about May 29, 2007, Defendant filed U.S. Trademark Application Serial No. 76/677,473 for the mark JACOBS for “wind energy conversation apparatus comprising wind-powered electricity generators and related parts thereof for use in electrical and mechanical power generation” in International Class 7. Information from the United States Patent & Trademark Office Trademark Applications and Registrations Retrieval (TARR) system regarding Application Serial No. 76/677,473 is attached hereto as Exhibit C.

22. Pursuant to the May 24, 1986 agreement between EESI and Defendant, Defendant had and currently has no right to use the JACOBS mark in connection with the manufacture or sale of the wind energy equipment covered by Application Serial No. 76/677,473.

23. Application Serial No. 76/677,473 was fraudulently filed because Defendant, having full knowledge that it had no right to use the mark JACOBS in connection with the

manufacture or sale of the wind energy equipment, filed a false declaration, signed on May 16, 2007 by Paul R. Jacobs, President of Defendant Jacobs Wind Electric Company, Inc., stating that (1) Defendant believed itself to be the exclusive owner of mark sought to be registered, and (2) that no one else, to the best of its knowledge and belief, had the right to use the mark in commerce, either in the identical form or in such near resemblance as to be likely, when applied to the goods or services of the other person, to cause confusion or mistake, or to deceive. This false declaration violates 15 U.S.C. § 1051(a)(3)(A) and 37 C.F.R. § 2.33(b)(1).

24. Application Serial No. 76/677,473 was also fraudulently filed because Defendant, having full knowledge that the JACOBS mark had been assigned and that it had no right to use the mark JACOBS in connection with the manufacture or sale of the wind energy products, cites a date of first use of January 1, 1925. Defendant has no lawful right to claim the benefit of such early use.

25. Application Serial No. 76/677,473 was also fraudulently filed because Defendant does not make and sell the wind generators recited in the application, but, at most, makes or has made some repair or control parts therefore.

26. Upon information and belief, Defendant was aware of Wind Turbine Industries and/or its JACOBS mark before it sought registration of the JACOBS and JACOBS WIND ENERGY SYSTEMS & Design marks and before it used or sold any goods under the JACOBS or JACOBS WIND ENERGY SYSTEMS & Design marks in the United States.

27. Defendant sells competing wind energy products as Wind Turbine Industries to the same types of consumers.

28. Defendant intends by its use of the JACOBS and JACOBS WIND ENERGY SYSTEMS & Design marks to trade off the goodwill of Wind Turbine Industries in the JACOBS mark for wind energy products.

29. Use of the JACOBS and JACOBS WIND ENERGY SYSTEMS & Design marks by Defendant is without the permission or consent of Wind Turbine Industries. Wind Turbine Industries has no control over the manner of use of the marks or the quality of products advertised, promoted, and offered under them by Defendant.

CLAIM 1: FEDERAL UNFAIR COMPETITION

30. Paragraphs 1 through 29 are incorporated and made a part of this Claim.

31. Defendant's use of the JACOBS and JACOBS WIND ENERGY SYSTEMS & Design marks in commerce in connection with the sale of wind energy products is likely to cause confusion, mistake, or deception as to the source of origin of the products offered by Defendant in that consumers and potential consumers are likely to believe that such products are provided by, sponsored by, approved by, licensed by, affiliated or associated with, or in some other way legitimately connected to Wind Turbine Industries and its JACOBS mark in violation of 15 U.S.C. § 1125(a).

32. As a direct and proximate result of the likely confusion, mistake, or deception, Wind Turbine Industries has suffered and will continue to suffer irreparable harm if the conduct of Defendant is not enjoined.

33. Pursuant to 15 U.S.C. § 1117, Wind Turbine Industries is entitled to recover all of Defendant's profits, Wind Turbine Industries' damages, and the costs of this action. The intentional nature of Defendant's unlawful conduct also renders this an "exceptional case,"

entitling Wind Turbine Industries to enhanced damages and an award of attorney fees under 15 U.S.C. § 1117(a).

**CLAIM 2: CANCELLATION OF REGISTRATION NO. 1,532,714
AND REFUSAL OF REGISTRATION FOR APPLICATION SERIAL NO. 76/677,473**

34. Paragraphs 1 through 33 are incorporated and made a part of this Claim.

35. Pursuant to 15 U.S.C. §§ 1064 and 1119, the court should cancel Registration No. 1,532,714 because the registered mark is being used by Defendant so as to misrepresent the source of the goods in connection with which the mark is used.

36. Pursuant to 15 U.S.C. §§ 1064 and 1119, the court should also cancel Registration No. 1,532,714 because it was supported by a false declaration that Defendant believed itself to be the exclusive owner of the registered mark in violation of 15 U.S.C. § 1051(a)(3)(A) and 37 C.F.R. § 2.33(b)(1), and was therefore fraudulently obtained.

37. Pursuant to 15 U.S.C. §§ 1064 and 1119, the court should also cancel Registration No. 1,532,714 because it was supported by a specimen of use showing goods not first sold by Defendant and a specimen of use that misrepresents the fact that the product being installed was primarily not made by Defendant, and was therefore fraudulently obtained.

38. Pursuant to 15 U.S.C. § 1119, which allows the court to determine the right to registration, the court should prevent registration of Application Serial No. 76/677,473 because it was supported by a false declaration that Defendant believed itself to be the exclusive owner of the mark sought to be registered in violation of 15 U.S.C. § 1051(a)(3)(A) and 37 C.F.R. § 2.33(b)(1), and was therefore filed fraudulently.

39. Pursuant to 15 U.S.C. § 1119, the court should also prevent registration of Application Serial No. 76/677,473 because the application falsely claims a date of first use of January 1, 1925, despite Defendant's knowledge that the JACOBS mark had been previously

assigned and that it had no right to use the mark in connection with wind energy products, and was therefore filed fraudulently.

40. Pursuant to 15 U.S.C. § 1119, the court should also prevent registration of Application Serial No. 76/677,473 because it was supported by a specimen of use that did not consist of goods manufactured by Defendant, and was therefore filed fraudulently.

CLAIM 3: DECEPTIVE TRADE PRACTICES

41. Paragraphs 1 through 40 are incorporated and made a part of this Claim.

42. Defendant has engaged in deceptive trade practices in violation of Minn. Stat. § 325D.44 because its use of the JACOBS and JACOBS WIND ENERGY SYSTEMS & Design marks is likely to cause confusion, mistake, or deception as to the source of origin of the goods offered by Defendant under the marks in that consumers and potential consumers are likely to believe that such goods are provided by, sponsored by, approved by, licensed by, affiliated or associated with, or in some other way legitimately connected to Wind Turbine Industries or the products Wind Turbine Industries offers under its JACOBS mark.

43. As a direct and proximate result of the likely confusion, mistake, or deception caused by Defendant, Wind Turbine Industries has suffered and will continue to suffer irreparable harm if Defendant's conduct is not enjoined.

44. Pursuant to Minn. Stat. § 325D.45, Wind Turbine Industries is entitled to injunctive relief and to recover its costs and attorney fees.

CLAIM 4: UNLAWFUL TRADE PRACTICES ACT

45. Paragraphs 1 through 44 are incorporated and made a part of this Claim.

46. Defendant has engaged in unlawful trade practices in violation of Minn. Stat. §§ 325D.09 et seq. because its use of the JACOBS and JACOBS WIND ENERGY SYSTEMS &

Design marks is likely to cause confusion, mistake, or deception as to the source of origin of the goods offered by Defendant under the marks in that consumers and potential consumers are likely to believe that such goods are provided by, sponsored by, approved by, licensed by, affiliated or associated with, or in some other way legitimately connected to Wind Turbine Industries or the products Wind Turbine Industries offers under its JACOBS mark.

47. As a direct and proximate result of the likely confusion, mistake, or deception caused by Defendant, Wind Turbine Industries has suffered and will continue to suffer irreparable harm if Defendant's conduct is not enjoined.

48. Pursuant to Minn. Stat. § 325D.15 and § 8.31, Subd. 3a., Wind Turbine Industries is entitled to recover its costs, disbursements, and reasonable attorney fees.

CLAIM 5: COMMON LAW TRADEMARK INFRINGEMENT

49. Paragraphs 1 through 48 are incorporated and made a part of this Claim.

50. Defendant's use of the JACOBS and JACOBS WIND ENERGY SYSTEMS & Design marks is likely to cause confusion, mistake, or deception as to the source of origin of the goods offered by Defendant under the marks in that consumers and potential consumers are likely to believe that such goods are provided by, sponsored by, approved by, licensed by, affiliated or associated with, or in some other way legitimately connected to Wind Turbine Industries or the products Wind Turbine Industries offers under its JACOBS mark.

51. Defendant's acts constitute trademark infringement under the common law in violation of Wind Turbine Industries' rights.

52. Defendant's acts were taken in willful, deliberate, and/or intentional disregard of Wind Turbine Industries' rights.

53. Wind Turbine Industries has suffered irreparable harm, for which it has no adequate remedy at law, and will continue to suffer irreparable injury unless and until Defendant's infringing acts are enjoined.

CLAIM 6: COMMON LAW UNFAIR COMPETITION

54. Paragraphs 1 through 53 are incorporated and made a part of this Claim.

55. Defendant's conduct constitutes unfair competition in violation of the rights of Wind Turbine Industries.

56. As a direct and proximate result of Defendant's unfair competition, Wind Turbine Industries has suffered and will continue to suffer irreparable harm if Defendant's conduct is not enjoined.

57. Defendant's acts were taken in willful, deliberate and/or intentional disregard of Wind Turbine Industries' rights.

58. Wind Turbine Industries respectfully requests a jury trial for this matter.

PRAYER FOR RELIEF

WHEREFORE, the Plaintiff, Wind Turbine Industries Corp., prays that the Court enter an order:

A. Canceling Defendant's U.S. Trademark Registration No. 1,532,714 for the mark JACOBS WIND ENERGY SYSTEMS & Design.

B. Directing that Defendant's U.S. Trademark Application Serial No. 76/677,473 for the mark JACOBS be refused registration.

C. Preliminarily and permanently enjoining and restraining Defendant, Jacobs Wind Electric Company, Inc., its directors, officers, agents, servants, employees, subsidiaries,

affiliates, and all persons in active concert or participation with, through, or under it, at first during the pendency of this action and thereafter perpetually:

1. from committing any acts of infringement and/or unfair competition and from implying a false designation of origin or a false description or representation with respect to Wind Turbine Industries' JACOBS mark;
2. from committing any acts of unfair competition by passing off or inducing or enabling others to sell or pass off goods and/or services that are not those of Wind Turbine Industries;
3. from using in any manner any packaging, labels, signs, literature, display cards, or other packaging, advertising, or promotional materials, or other materials related to the manufacture and/or sale wind energy products of that bear the marks JACOBS, JACOBS WIND ENERGY SYSTEMS & Design, and/or any other mark, word, design, or name that is confusingly similar to Wind Turbine Industries' JACOBS mark; and
4. from making any statements on promotional materials or advertising for Defendant's goods and/or services that are false or misleading as to source or origin; and
5. from seeking to register any mark confusingly similar to Wind Turbine Industries' trademarks.

D. Requiring that Defendant deliver up to Wind Turbine Industries any and all containers, signs, packaging materials, printing plates, and advertising or promotional materials, and any materials used in the preparation thereof, which in any way unlawfully use or make

reference to Wind Turbine Industries' JACOBS mark in connection with the manufacture and/or sale of wind energy products.

E. Requiring that Defendant, within thirty (30) days after service of notice of entry of judgment or issuance of an injunction pursuant thereto, file with the Court and serve upon Wind Turbine Industries' counsel a written report under oath setting forth details of the manner in which Defendant has complied with the Court's order pursuant to paragraphs B and C above.

F. Requiring Defendant to account and pay over to Wind Turbine Industries all damages sustained by Wind Turbine Industries, Defendant's profits, Wind Turbine Industries' attorney fees and costs, and ordering that the amount of damages awarded to Wind Turbine Industries be increased three times the amount thereof.

G. Awarding Wind Turbine Industries such other relief as the Court may deem just and proper.

WIND TURBINE INDUSTRIES CORP.

Date: January 8, 2009

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