

**IN THE UNITED STATES DISTRICT COURT  
FOR THE EASTERN DISTRICT OF VIRGINIA  
Richmond Division**

**VIRGINIA TOURISM AUTHORITY  
d/b/a VIRGINIA TOURISM CORPORATION  
901 East Byrd Street  
Richmond, Virginia 23219**

**Plaintiff,**

v.

**Civil Action No. 3:18cv372**

**RECOVERED GOLD, LLC  
Serve: Andrew L. Newell  
5808 East Rois Road  
Richmond, Virginia 23227**

**Defendant.**

**COMPLAINT**

Plaintiff Virginia Tourism Authority d/b/a Virginia Tourism Corporation (“VTC”), by counsel, for its complaint against Defendant Recovered Gold, LLC (“Recovered Gold” or “Defendant”) states as follows:

**Nature of the Action**

1. This action is for trademark infringement and unfair competition arising from the Trademark Act of 1946, as amended, 15 U.S.C. § 1051, *et seq.* (the “Lanham Act”), and under the common law.

**The Parties**

2. VTC is a public body corporate and a political subdivision of the Commonwealth of Virginia created pursuant to Va. Code § 2.2-2315. VTC exercises public and essential governmental functions, and the exercise by VTC of the duties and powers conferred

shall be deemed and held to be the performance of an essential governmental function of the Commonwealth. Va. Code § 2.2-2315. No provision of the Virginia Tourism Authority Act, Va. Code 2.2-2315, *et seq.*, nor act of VTC shall be deemed a waiver of sovereign immunity to which VTC is otherwise entitled. Va. Code § 2.2-2326.

3. Upon information and belief, Recovered Gold is a Virginia limited liability company with its principal place of business at 5808 East Rois Road, Richmond, Virginia 23227.

### **Jurisdiction and Venue**

4. This Court has jurisdiction over the parties and the subject matter of this action under 15 U.S.C. § 1121, 28 U.S.C. § 1338(a) and (b) and 28 U.S.C. § 1331. This action arises under the trademark laws of the United States, 15 U.S.C. §§ 1051 to 1127. The state law claims herein are joined with a substantial and related claim under the trademark laws of the United States pursuant to 28 U.S.C. § 1367, and fall within the Court's supplemental jurisdiction. Venue is proper in this District pursuant to 28 U.S.C. § 1391(b)(2).
5. This court has personal jurisdiction over Recovered Gold because Recovered Gold is subject to the jurisdiction of the state courts of Virginia pursuant to Va. Code § 8.01-328.1(A)(1), (A)(2), (A)(3), and (A)(6).

### **Facts**

6. Since 1969, the Commonwealth of Virginia has used the words "Virginia is For Lovers" (the "Common Law Mark") to promote travel and tourism within the Commonwealth of Virginia. Over decades, the Commonwealth of Virginia has created in its Common Law Mark an iconic image of the Commonwealth, with name recognition and goodwill within the Commonwealth of Virginia and throughout the United States. The Commonwealth of

Virginia and VTC have used, through licensed exclusive distributors, the Common Law Mark on apparel and merchandise to symbolize affinity for and travel to the Commonwealth of Virginia. The license fees received by the Commonwealth and VTC from the sale of such apparel and merchandise benefit the citizens of the Commonwealth of Virginia.

7. The Common Law Mark is inherently distinctive to denote travel to and affinity for the Commonwealth of Virginia.
8. In 1999, the General Assembly of the Commonwealth of Virginia created VTC for the promotion of tourism in the Commonwealth and in order to increase the prosperity of its citizens.
9. On September 20, 2002, VTC filed an application for registration of the mark:



in the United States Patent and Trademark Office (“USPTO”). On December 23, 2003, the mark was registered by the USPTO on the Principal Register (Registration No. 2,797,036) under the Lanham Act covering the use of said mark in classes 25 for “clothing, namely, men’s, women’s and children’s shirts, jackets, hats, belts, trousers, warm-up pants, sweatshirts, T-shirts, headband, neckbands, sweatbands, and wrist bands” and 35 for “promoting travel and tourism in the United States.” Said registration is now incontestable by virtue of its long use and registration.

10. On September 20, 2002, VTC filed an application for registration of the mark:

## *Virginia is for Lovers*

in the USPTO. On March 16, 2004, the mark was registered by the USPTO on the Principal Register (Registration No. 2,822,390) under the Lanham Act covering the use of said mark in classes 25 for “clothing, namely, men’s, women’s and children’s shirts, jackets, hats, belts, trousers, warm-up pants, sweatshirts, T-shirts, headband, neckbands, sweatbands, and wrist bands” and 35 for “promoting travel and tourism in the United States.” Said registration is now incontestable by virtue of its long use and registration.

11. On September 20, 2002, VTC filed an application for registration of the mark:



in the USPTO. On April 6, 2004, the mark was registered by the USPTO on the Principal Register (Registration No. 2,829,329) under the Lanham Act covering the use of said mark in classes 25 for “clothing, namely, men’s, women’s and children’s shirts, jackets, hats, belts, trousers, warm-up pants, sweatshirts, T-shirts, headband, neckbands, sweatbands, and wrist bands” and 35 for “promoting travel and tourism in the United States.” Said registration is now incontestable by virtue of its long use and registration.

12. On September 13, 2013, VTC filed an application for registration of the mark:

## VIRGINIA IS FOR LOVERS

in the USPTO. On June 17, 2014, the mark was registered by the USPTO on the Principal Register (Registration No. 4,553,408) under the Lanham Act covering the use of said mark in class 6 for “metal license plates.”

13. On October 6, 2014, VTC filed an application for registration of the mark:

## VIRGINIA IS FOR LOVERS

in the USPTO. On May 19, 2015, the mark was registered by the USPTO on the Principal Register (Registration No. 4,739,077) under the Lanham Act covering use of the said mark in class 35 for “promoting travel and tourism in the United States.” On July 27, 2015, VTC filed an application for registration of this same mark in class 25 for “clothing, namely, men’s, women’s, and children’s shirts, jackets, caps, hats, pants, sweatshirts, T-shirts, and infant wear.” On March 1, 2016, the mark was registered by the USPTO on the Principal Register (Registration No. 4,908,457) under the Lanham Act covering use of the said mark in class 25.

14. On October 6, 2014, VTC filed an application for registration of the mark:



in the USPTO. On May 19, 2015, the mark was registered by the USPTO on the Principal Register (Registration No. 4,739,076) under the Lanham Act covering use of the said mark in class 35 for “promoting travel and tourism in the United States.”

15. On January 19, 2015, VTC filed an application for registration of the mark:



in the USPTO. On August 25, 2015, the mark was registered by the USPTO on the Principal Register (Registration No. 4,799,401) under the Lanham Act covering use of the said mark in class 35 for “promoting travel and tourism in the United States.”

16. On January 19, 2015, VTC filed an application for registration of the mark:



in the USPTO. On September 1, 2015, the mark was registered by the USPTO on the Principal Register (Registration No. 4,803,396) under the Lanham Act covering use of the said mark in class 35 for “promoting travel and tourism in the United States.”

17. On March 19, 2015, VTC filed an application for registration of the mark:



in the USPTO. On September 15, 2015, the mark was registered by the USPTO on the Principal Register (Registration No. 4,812,918) under the Lanham Act covering use of the said mark in class 35 for “promoting travel and tourism in the United States.”

18. On April 24, 2015, VTC filed an application for registration of the mark:



in the USPTO. On May 31, 2016, the mark was registered by the USPTO on the Principal Register (Registration No. 4,967,510) under the Lanham Act covering the use of said mark in class 35 for “promoting travel and tourism in Virginia.”

19. On July 27, 2015, VTC filed an application for registration of the mark:



in the USPTO. On March 1, 2016, the mark was registered by the USPTO on the Principal Register (Registration No. 4,908,480) under the Lanham Act covering the use of said mark in classes 25 for “clothing, namely, men’s women’s and children’s shirts, jackets, caps, hats, pants, sweatshirts, T-shirts, and infant wear”; 18 for “carryalls, namely, canvas bags, back packs, sack packs, cinch packs, and weekend bags”; 21 for “beverageware, namely, cups, beverage glassware, beer glasses, coffee cups, mugs, wine glasses, shot glasses, drinking bottles for sports, tumblers for use as drinking glasses; bottle jackets; bottle openers; bottlestoppers specially adapted for use with wine bottles; corkscrews”; and 16 for “stationery, namely, greeting cards and post cards, pencils, pens, paperclips; decals; bumperstickers; paper napkins; gift bags.”

20. The aforementioned marks registered on the Principal Register as Registration Nos. 2,797,036; 2,822,390; 2,829,329; 4,553,408; 4,739,077; 4,908,457; 4,739,076; 4,799,401; 4,803,396; 4,812,918; 4,908,480; and 4,967,510 are hereby collectively referred to as the “Registered Marks.”

21. The validity of the Registered Marks 2,797,036; 2,822,390; and 2,829,329 and of the registration, VTC’s ownership and exclusive right to use these Registered Marks in connection with the above-mentioned classes are incontestable under 15 U.S.C. § 1065 and 15 U.S.C. § 1115(b), as VTC has filed the required declarations with the USPTO.



22. The Registered Marks are being used in interstate commerce and have a substantial effect on interstate commerce.
23. The Commonwealth of Virginia and VTC have expended considerable time, money and effort in the development, preparation, promotion and offering of goods and services in connection with the Common Law and Registered Marks. The Common Law and Registered Marks have become strong and famous trademarks and have long been associated with the Commonwealth of Virginia and VTC.
24. The Commonwealth of Virginia and VTC have implemented and carefully controlled a licensing program to license the Common Law and Registered Marks to one or more approved licensees in connection with goods and services bearing the Common Law and/or Registered Marks. Any goods and services containing the Common Law and/or Registered Marks marketed to the public are subject to the Commonwealth's and VTC's quality controls. Such marketing promotes travel to and affinity for the Commonwealth of Virginia.
25. Defendant Recovered Gold has used and continues to use the mark VIRGINIA IS FOR GUN LOVERS (the "Infringing Mark") on its website and Facebook page and in connection with the sale of various merchandise. The Infringing Mark incorporates VTC's Common Law and Registered Marks without VTC's consent.
26. In fact, as evidenced by Recovered Gold's website and Facebook page, attached hereto as Exhibit A, Recovered Gold continues to use the Infringing Mark in connection with the sale and marketing of its goods and services in violation of VTC's Common Law and Registered Marks.

27. There may be other social-media services, other places on the Internet, and other media and advertising channels visible to the public, where Recovered Gold has used or is using the Infringing Mark to promote Recovered Gold's goods and services that have not yet been detected by VTC.
28. VTC has corresponded with Recovered Gold, repeatedly demanding that Recovered Gold cease and desist from its use of the Infringing Mark. Notwithstanding communications from VTC, Recovered Gold continues to willfully use the Infringing Mark to promote its goods and services.
29. The foregoing activities of Recovered Gold have deceived and caused confusion among the relevant purchasing public. It is likely that the purchasing public will believe that Recovered Gold's products are connected, associated or affiliated in some way with the Commonwealth of Virginia and/or VTC, when in fact no such connection, association or affiliation exists.
30. As a result of Recovered Gold's acts, VTC has suffered damages and continues to suffer substantial damage and irreparable injury. VTC has no adequate remedy at law, and unless Recovered Gold is enjoined by this Court, Recovered Gold's acts will continue to cause irreparable injury and damage to VTC.

**Count I – Infringement of Federally Registered Service Mark - 15 U.S.C. § 1114(1)**

31. VTC repeats and realleges paragraphs 1 through 30 as if set forth herein.
32. This cause of action is for infringement of VTC's federally registered service mark under 15 U.S.C. § 1114(1).
33. The Infringing Mark is confusingly similar to the Registered Marks.

34. Recovered Gold targets usage of the Infringing Mark at general consumers, who also are VTC's target audience and potential customers.
35. VTC has no control over the quality of the services offered by Recovered Gold or its message, and because of the likely confusion as to source engendered by Recovered Gold, VTC's valuable goodwill in respect to the Registered Marks is at the mercy of Recovered Gold.
36. Recovered Gold's use of a confusingly similar imitation of the Registered Marks is likely to cause confusion, deception, and mistake by creating the false and misleading impression that Recovered Gold's goods and services are manufactured, distributed or provided by VTC, or are associated or connected with VTC, or have the sponsorship, endorsement, or approval of VTC.
37. The infringement by Recovered Gold has been and is willful. Recovered Gold has known of, and had constructive knowledge of, the Registered Marks. Under federal law, Recovered Gold was on constructive notice of the Registered Marks before commencing use of the Infringing Mark.
38. Recovered Gold had actual notice of the Registered Marks at least since it received the cease and desist letters from counsel for VTC, which were dated February 6, 2018 and March 2, 2018. Nevertheless, Recovered Gold has persisted in using the Infringing Mark. Recovered Gold is deliberately trading upon the goodwill associated with the VTC's Registered Marks.
39. Recovered Gold's infringement of the Registered Marks has caused and, unless enjoined by the Court, will continue to cause, irreparable damage to VTC's reputation and

goodwill. VTC is unable to calculate the entire amount of compensation that would be adequate for relief for such continuing acts. VTC has no adequate remedy solely at law.

40. As a result of Recovered Gold's action. VTC has suffered, and will continue to suffer, money damages in an amount to be proven at trial.

**Count II – Federal Unfair Competition and  
False Designation of Origin (15 U.S.C. §1125(a))**

41. VTC repeats and realleges paragraphs 1 through 40 as if set forth herein.

42. The aforesaid acts of Recovered Gold constitute the use in commerce of symbols and devices and of false designations of origin and false or misleading descriptions and representations in connection with Recovered Gold's goods and services, in violation of 15 U.S.C. § 1125(a).

43. Through its use of the Infringing Mark, Recovered Gold, if not enjoined, will cause, and is likely to cause, consumers in this judicial district and elsewhere to be confused, mistaken, or deceived as to the association, sponsorship, approval or association between, on one hand, Recovered Gold, the Infringing Mark and Recovered Gold's goods and services and, on the other hand, VTC, the Registered Marks and VTC's goods and services.

44. Recovered Gold's unauthorized misuse of the Infringing Mark has caused and, unless enjoined by the Court, will continue to cause, irreparable damage to VTC's reputation and goodwill and to the Registered Marks, which is symbolic thereof. VTC is unable to calculate the entire amount of compensation that would be adequate for relief for such continuing acts. VTC has no adequate remedy solely at law.

45. As a result of Recovered Gold's actions, VTC has suffered, and will continue to suffer, money damages in an amount to be proven at trial.

**Count III – Trademark Dilution (15 U.S.C. § 1125(c))**

46. VTC repeats and realleges paragraphs 1 through 45 as if set forth herein.

47. VTC's Common Law and Registered Marks are distinctive and famous marks. The Common Law and Registered Marks are inherently strong, distinctive, and marketed to the public nationwide to denote travel to and/or affinity for the Commonwealth of Virginia. The Commonwealth of Virginia and VTC have built up decades of name recognition and goodwill, as alleged above. VTC has expended substantial financial resources to maintain such recognition and goodwill.

48. These acts by Recovered Gold dilute the distinctive quality of the famous Common Law and Registered Marks, in violation of 15 U.S.C. § 1125(c).

49. Recovered Gold's acts have lessened (and will continue to lessen) the capacity of VTC through its famous Common Law and Registered Marks to identify its services and merchandise. Recovered Gold's acts have blurred (and will continue to blur) the unique association that has existed between the Common Law and Registered Marks and the goodwill and name recognition the Commonwealth of Virginia and VTC have earned through the services and merchandise provided.

50. Recovered Gold's use of the Infringing Mark has caused the dilution of the distinctive quality of the famous Common Law and Registered Marks.

51. Recovered Gold's use of the Infringing Mark constitutes dilution by blurring under § 43(c) of the Lanham Act, 15 U.S.C. § 1125(c).

52. On information and belief, Recovered Gold engaged in the aforesaid acts with the intent to trade on the Commonwealth of Virginia's and/or VTC's reputation or to cause dilution of the famous Common Law and Registered Marks.

53. Recovered Gold's infringement of the Registered Marks has caused and, unless enjoined by the Court, will continue to cause, irreparable damage to VTC's reputation and goodwill. VTC is unable to calculate the entire amount of compensation that would be adequate for relief for such continuing acts. VTC has no adequate remedy solely at law.

54. As a result of Recovered Gold's action. VTC has suffered, and will continue to suffer, money damages in an amount to be proven at trial.

**Count IV – Trademark Infringement (Common Law)**

55. VTC repeats and realleges paragraphs 1 through 54 as if set forth herein.

56. The Common Law and Registered Marks are distinctive marks for VTC, its reputation and the merchandise and services it provides. The Commonwealth of Virginia and VTC have established valuable goodwill due to their reputation.

57. Recovered Gold's unauthorized use of the Infringing Mark in interstate commerce and in the Commonwealth of Virginia constitutes a false designation or origin, a false and/or misleading description of fact, and/or a false or misleading representation of fact, which constitutes an infringement in VTC's trademark rights in and to the Common Law and Registered Marks, and is likely to cause, and upon information and belief, has caused confusion, mistake and/or deception as to the affiliation, connection or association of Recovered Gold's merchandise and the Commonwealth of Virginia and/or VTC.

58. Recovered Gold's infringement of the Registered Marks has caused and, unless enjoined by the Court, will continue to cause, irreparable damage to VTC's reputation and goodwill. VTC is unable to calculate the entire amount of compensation that would be adequate for relief for such continuing acts. VTC has no adequate remedy solely at law.

59. As a result of Recovered Gold's action. VTC has suffered, and will continue to suffer, money damages in an amount to be proven at trial.

**Count V- Violation of Virginia Code § 2.2-417**

60. VTC repeats and realleges paragraphs 1 through 59 as if set forth herein.

61. The Commonwealth of Virginia created or developed and/or commissioned the creation and/or development of the motto or slogan "Virginia is for Lovers" in the late 1960s to promote travel and tourism within the Commonwealth of Virginia.

62. In 1972, the General Assembly adopted and the Governor signed into law Chapter 403, 1972 Va. Acts of Assembly, which provided for the registration of mottoes or slogans by State agencies, prohibited the use of such mottoes or slogans by unauthorized persons, provided penalties for violations of prohibited uses, and registered the slogan "Virginia is for Lovers" with the Secretary of the Commonwealth. Chapter 403 was codified in 1972 at Va. Code §§ 2.1-81.1 through 2.1-81.4.

63. Section 2.1-81.1 provided that any department, division, board, commission, agency or facility owned or operated by the Commonwealth which creates or develops a slogan or motto for its use shall register such slogan with the Secretary of the Commonwealth. Public institutions of higher learning and the Virginia National Guard were exempt from the registration requirement.

64. Sections 2.1-81.2 and 2.1-81.3 prohibited the use by any individual, partnership, association or corporation of the registered mottoes or slogans without the express consent of the registrant and provided for a penalty of no more than \$1,000.00 per day of prohibited use.
65. Section 2.1-81.4 provided, “[t]he slogan “Virginia is for Lovers” shall be registered with the Secretary of the Commonwealth as the slogan of the Virginia Division of Tourism within five days of April 5, 1972.”
66. In 2001, Sections 2.1-81.1 through 2.1-81.4 were recodified at Va. Code §§ 2.2-416 and 2.2-417. In the recodification, Sections 2.1-81.2 and 2.1-81.3 were merged and, according to the Virginia Code Commission, Section 2.1-81.4 was deleted as obsolete “since the slogan ‘Virginia is for Lovers’ has, in fact, been registered with the Secretary of the Commonwealth and continues to be registered as of this writing.”
67. “Virginia is for Lovers” has been registered with the Secretary of Commonwealth in accordance with Va. Code § 2.1-81.1, recodified at Va. Code § 2.2-416, since at least April 10, 1972.
68. On February 17, 2011, VTC hand delivered to the Secretary of the Commonwealth an Application for Renewal of a Motto or Slogan. The Application for Renewal requested renewal of “Virginia is for Lovers,” which was originally registered with the Secretary of the Commonwealth on April 10, 1972.
69. On March 18, 2011, VTC received confirmation of registration of “Virginia is for Lovers” from the Secretary of the Commonwealth.



70. Recovered Gold is prohibited by Va. Code § 2.2-417 from employing “Virginia is for Lovers,” or a recognizable variation thereof, without the express consent of VTC.

71. Recovered Gold’s use of “Virginia is for Gun Lovers” is a recognizable variation of “Virginia is for Lovers” and is without the express consent of VTC and is subject to a fine of no more than \$1,000.00 per day.

72. Recovered Gold has used and continues to use the slogan or motto “Virginia is for Gun Lovers,” a recognizable variation of “Virginia is for Lovers” without the consent of VTC.

73. Recovered Gold is liable to the Commonwealth and/or VTC in an amount up to \$1,000.00 per day for each day Recovered Gold has used and continues to use the slogan or motto “Virginia is for Lovers” without the consent of VTC.

WHEREFORE Plaintiff Virginia Tourism Corporation prays for relief against Recovered Gold, LLC as follows:

A. That Recovered Gold and its agents, servants, employees, attorneys, successors, and assigns, and any and all persons acting in concert or participating with them, or any of their successors or assigns or any of them, be preliminarily and permanently enjoined and restrained from directly or indirectly:

(1) using the Infringing Mark, or any reproduction, counterfeit, copy, or colorable imitation of the Common Law or Registered Marks;

(2) using the Common Law or Registered Marks, or any reproduction, counterfeit, copy, or colorable imitation of the same, in any manner likely to cause others to believe that Recovered Gold’s merchandise or services are connected with the Commonwealth of Virginia or VTC or are genuine VTC licensed products or services;

(3) committing any other acts that may cause the purchasing public to believe that Recovered Gold merchandise and services are genuinely licensed by VTC or otherwise provided for the benefit of the VTC or the Commonwealth of Virginia;

(4) shipping, delivering, holding for sale, importing, distributing, returning, transferring, or otherwise moving or disposing of any materials falsely bearing the Infringing Mark, or any reproduction, counterfeit, copy, or colorable imitation of the Common Law or Registered Marks; and

(5) assisting, aiding, or abetting any other person or business entity in engaging in or performing any of the activities referred to in the above subparagraphs (1) through (4).

B. That Recovered Gold and any and all persons controlled by or acting in concert with Recovered Gold be required to deliver to VTC for destruction all goods, packages, and any other written or printed materials, in tangible or intangible form, that bear or depict the Infringing Mark, or any reproduction, counterfeit, copy, or colorable imitation of the Common Law or Registered Marks.

C. That Recovered Gold be required to account for and pay to VTC Recovered Gold's profits from the sale and use of the Infringing Mark and such sum in addition thereto as the Court shall find just.

D. That this case be found exceptional and VTC be awarded its attorneys' fees pursuant to 15 U.S.C. § 1117(a).

E. That VTC recover the damages arising out of Recovered Gold's wrongful acts in a sum equal to three times the actual damages suffered by VTC, as provided in 15 U.S.C. § 1117(b).

F. That VTC be awarded statutory damages for Recovered Gold's willful use of counterfeit marks, in lieu of actual damages, as provided in 15 U.S.C. § 1117(c).

G. That Recovered Gold be required to disgorge its profits and other ill-gotten gains pursuant to Virginia common law.

H. That VTC have and recover the taxable costs of this civil action, including reasonable attorneys' fees and interest.

I. That VTC be awarded punitive damages in view of Recovered Gold's reckless, willful, wanton acts committed with conscious disregard for the rights of VTC.

J. That VTC be awarded statutory damages of up to \$1,000.00 per day for each day that Recovered Gold has used and continues to use the slogan or motto "Virginia is for Gun Lovers," a recognizable variation of "Virginia is for Lovers" without the consent of the Commonwealth of Virginia and/or VTC.

K. That VTC have such other general and further relief as this Court deems just and proper.

**TRIAL BY JURY IS REQUESTED.**

Respectfully Submitted,

VIRGINIA TOURISM AUTHORITY  
d/b/a VIRGINIA TOURISM  
CORPORATION

By Counsel

/s/ Belinda D. Jones

Belinda D. Jones (VSB 72169)

Noelle M. James (VSB 76001)

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