

TO: Commissioner of Trademarks P.O. Box 1451 Alexandria, VA 22313-1451	REPORT ON THE FILING OR DETERMINATION OF AN ACTION REGARDING A PATENT OR TRADEMARK
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In Compliance with 35 § 290 and/or 15 U.S.C. § 1116 you are hereby advised that a court action has been filed in the U.S. District Court Colorado on the following Trademarks

DOCKET NO. 11-cv-02254	DATE FILED 8/26/11	U.S. DISTRICT COURT FOR THE DISTRICT OF COLORADO
PLAINTIFF Nimbl, LLC		DEFENDANT Bnimbl, Inc.
PATENT OR	DATE OF PATENT	HOLDER OF PATENT OR TRADEMARK
1	9,632,407	Please see copy of Complaint attached hereto
2		
3		
4		
5		

In the above—entitled case, the following patent(s) have been included:

DATE INCLUDED	INCLUDED BY <input type="checkbox"/> Amendment <input type="checkbox"/> Answer <input type="checkbox"/> Cross Bill <input type="checkbox"/> Other Pleading	
PATENT OR	DATE OF PATENT OR TRADEMARK	HOLDER OF PATENT OR TRADEMARK
1		
2		
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In the above—entitled case, the following decision has been rendered or judgement issued:

DECISION/JUDGEMENT

CLERK GREGORY C. LANGHAM	(BY) DEPUTY CLERK	DATE
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Copy 1—Upon initiation of action, mail this copy to Commissioner Copy 3—Upon termination of action, mail this copy to
 Copy 2—Upon filing document adding patent(s), mail this copy to Commissioner Copy 4—Case file copy

IN THE UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF COLORADO

Civil Action No.

NIMBL, LLC,

Plaintiff,

v.

BNIMBL, INC.,

Defendant.

COMPLAINT AND JURY DEMAND

The Plaintiff Nimbl, LLC (hereinafter "Plaintiff"), by and through its undersigned attorneys, for its complaint against the defendant, alleges as follows:

A. NATURE OF ACTION

1. This is an action for service mark infringement, unfair competition, cybersquatting and other relief arising under the trademark and service mark laws of the United States, specifically 15 U.S.C. § 1051 et seq. (hereinafter "Lanham Act"), the common law of the State of Colorado and the Colorado Consumer Protection Act. Plaintiff is a leading provider of software and IT development and consulting services based in Denver, Colorado and provides its services under the service marks **NIMBL**, **BE NIMBL** and **BE LIKE JACK**, as well as the domain name www.benimbl.com which links to Plaintiff's website and the marketing email address jack@benimbl.com through which Plaintiff communicates with its clients and prospective clients.

2. Defendant Bnimbl, Inc. ("Defendant"), located just a few miles away from Plaintiff's principal place of business in Denver, has adopted the virtually identical and confusingly

similar mark BNIMBL and is gearing up to use this mark in connection with highly related software consulting and development services. Defendant has also registered the virtually identical domain name www.bnimbl.com, which is just one letter off from Plaintiff's website. Defendant's services are directed to the same class of consumers as are Plaintiff's services, and although Defendant has not yet officially launched its business, instances of actual confusion have already begun to occur. As a result of Defendant's actions, Plaintiff has suffered and will continue to suffer serious and irreparable harm.

B. THE PARTIES

3. Plaintiff is a limited liability company organized and existing under the laws of the State of Colorado with its principal place of business located at 3457 Ringsby Court, Unit 108, Denver, Colorado 80216.

4. Upon information and belief, defendant Bnimbl, Inc. is a corporation organized and existing under the laws of the State of Colorado with a principal place of business located at 1514 Blake Street, Suite 300, Denver, Colorado 80202. Upon information and belief, defendant was originally organized as a limited liability company in Colorado (Bnimbl, LLC), but was converted to a corporation on or around February 15, 2011.

C. JURISDICTION AND VENUE

5. This Court has subject matter jurisdiction over this action pursuant to 28 U.S.C. §§ 1331 and 1338 because Plaintiff's claims arise under Section 43(a) of the Lanham Act. This Court also has supplemental jurisdiction pursuant to 28 U.S.C. §§ 1338(b) and 1367 over Plaintiff's claims that arise under the laws of the State of Colorado.

6. This Court has personal jurisdiction over the parties to this action because (i) Plaintiff's claims arise in this judicial district, and (ii) each party is located within and does business in this judicial district.

7. Venue is proper in this judicial district pursuant to 28 U.S.C. § 1391 because Plaintiff's claims arise in this judicial district, each party does business in this judicial district, witnesses and evidence are located within this judicial district, and the acts complained of herein have taken place in this judicial district.

D. PLAINTIFF'S NIMBL, BE NIMBL AND BE LIKE JACK MARKS

8. Plaintiff is the owner of the service marks **NIMBL, BE NIMBL** and **BE LIKE JACK** which it uses in connection with its software consulting and development services. Plaintiff has been providing its software consulting and development services under its aforementioned marks since at least as early as March, 2009.

9. Plaintiff is also the owner of the domain name www.benimbl.com, which domain name links to its web site, through which its services provided under its marks **NIMBL, BE NIMBL** and **BE LIKE JACK** are advertised and promoted. Printouts from Plaintiff's web site located at www.benimbl.com, which demonstrate Plaintiff's use of its **NIMBL** and **BE LIKE JACK** marks are attached hereto as **Exhibit A**.

10. Plaintiff has continuously utilized its **BE NIMBL** and **BE LIKE JACK** marks as slogan marks in connection with its advertising materials. Plaintiff's **BE NIMBL** and **BE LIKE JACK** marks each play on the well known expression "Jack Be Nimble" which has its origins in the famous nursery rhyme of the same name. Plaintiff utilizes its **BE NIMBL** and **BE LIKE JACK** marks on various advertising and promotional materials, as well as part of the signature block on all company emails which are sent to Plaintiff's clients and prospective clients. Copies of Plaintiff's

advertising materials demonstrating its use of the marks **BE NIMBL** and **BE LIKE JACK** are attached hereto at **Exhibit B**.

11. In addition, Plaintiff utilizes the email address jack@benimbl.com in connection with its marketing emails which are sent to Plaintiff's clients and prospective clients. The email address jack@benimbl.com is also used to connote the famous nursery rhyme "Jack Be Nimble."

12. Plaintiff is the owner of United States Service Mark Application Serial No. 85/027,038 for its **NIMBL and design** mark in International Class 42 for IT SAP integration services. A printout from the United States Patent and Trademark Office's Online Database of Plaintiff's application is attached hereto as **Exhibit C**.

13. Plaintiff is also the owner of United States Service Mark Application Serial Nos. 85/406,526 for its **BE NIMBL** mark in International Class 42 for IT consulting services; and 85/406,529 for its **BE LIKE JACK** mark in International Class 42 for IT consulting services. Printouts of the filing receipts from the United States Patent and Trademark Office of the above referenced applications are attached hereto as **Exhibit D**.

E. PLAINTIFF'S SOFTWARE CONSULTING AND DEVELOPMENT SERVICES

14. Plaintiff provides software consulting and development services with a primary specialty in SAP software products. SAP software is one of the most widely used software platforms in the world, and is used by a wide variety of businesses in almost every conceivable business space. As a result of the extremely broad scope of SAP software products, SAP software is used in tandem with many of the other leading software and technology solutions on the market, and as such there is a direct overlap between SAP software and a variety of other software and technology. Plaintiff's client base consists of both some of the largest companies in the world (such as PepsiCo, Exxon Mobil and Nestle), as well as a variety of smaller companies.

Plaintiff interacts and provides its services to both IT professionals employed by its various clients, including developers, architects, IT managers, IT directors and Chief Information Officers as well as non-IT professionals, including Business Analysts, Business managers, Human Resource Managers, Procurement Specialists, Chief Executive Officers, Vice Presidents, etc.

15. While Plaintiff primarily specializes in SAP software, Plaintiff's clients consistently seek Plaintiff's assistance and consultation in dealing with a wide variety of other software and technology related issues. In fact, Plaintiff consults with its clients on a daily basis with respect to their needs in other areas, including in connection with issues in the mobility and cloud technology spaces. As a result, Plaintiff is constantly expanding the scope of its consulting and development services to include products and technologies that are not exclusively related to SAP software.

16. Plaintiff has invested a substantial amount of time, money and other resources advertising, promoting, marketing and publicizing its services provided under its **NIMBL**, **BE NIMBL** and **BE LIKE JACK** marks. As a result of Plaintiff's substantial advertising, marketing and promotional efforts, its **NIMBL**, **BE NIMBL** and **BE LIKE JACK** marks have acquired substantial consumer recognition and good will. Plaintiff's marks have become important source indicators which identify the quality services provided by Plaintiff. For all of the foregoing reasons, the **NIMBL**, **BE NIMBL** and **BE LIKE JACK** marks are exceedingly valuable assets of Plaintiff.

17. By virtue of Plaintiff's extensive use of its **NIMBL**, **BE NIMBL** and **BE LIKE JACK** marks, the marks have come to be widely recognized by the public as identifying Plaintiff and its software consulting and development services.

F. DEFENDANT'S INFRINGEMENT

18. Subsequent to Plaintiff's substantial use of its **NIMBL**, **BE NIMBL** and **BE LIKE JACK** marks, and subsequent to Plaintiff's marks acquiring public recognition as identifying and distinguishing Plaintiff's services from the services of others, Defendant adopted the virtually identical and confusingly similar name and mark **BNIMBL**. Upon information and belief, Defendant is in the process of gearing up to use the mark **BNIMBL** in connection with highly related software consulting and development services.

19. Specifically, Defendant is preparing to use the virtually identical mark **BNIMBL** in connection with highly related services, in connection with a business located within just a few miles from Plaintiff's business in Denver.

20. Defendant has filed an intent to use based service mark application, Serial No. 85/256,441 for the mark **BNIMBL** in International Class 35 for a web-based application servicing social networking and online retailers.

21. Defendant has also registered the domain name www.bnimbl.com and has linked this domain name to a website where its services are being advertised and promoted. The domain name www.bnimbl.com is virtually identical to Plaintiff's **NIMBL** and **BE NIMBL** marks, and is just one letter off from Plaintiff's www.benimbl.com domain name, thereby greatly increasing the chances that consumers will be confused as to the relationship between Plaintiff and Defendant.

22. Upon information and belief, the principal of Defendant is Jack Wodlinger was formally associated with an entity named Demand Point, which is a business associate of Plaintiff. As such, upon information and belief, Mr. Wodlinger was aware of Plaintiff's rights in and to its **NIMBL**, **BE NIMBL** and **BE LIKE JACK** marks prior to adopting the mark **BNIMBL**. Mr. Wodlinger has further adopted and is using the email address jack@bnimbl.com in connection with Defendant's business. The email address jack@bnimbl.com is one letter off from Plaintiff's

jack@benimbl.com email address which Plaintiff utilizes in connection with its marketing emails to clients and prospective clients.

23. The services Defendant is promoting and marketing under the mark **BNIMBL** are highly related to Plaintiff's software consulting and development services and are directed towards the same class of consumers, such that Plaintiff and Defendant are unquestionably in competition with respect to those services.

24. While Defendant has not officially launched its website yet, upon information and belief, Defendant intends to provide consulting and development services within the cloud software space. As set forth above, Plaintiff's primary specialty relates to SAP software products, which products directly overlap with the cloud area of software and technology. In addition, Plaintiff consistently consults with and assists its clients in connection with issues directly related to mobility and cloud computing. As such, Plaintiff's services are directly related to and overlap with Defendant's intended services.

25. In addition, the respective services are and will be provided to the same class of consumers. Specifically, both Plaintiff and Defendant will directly be marketing their services to IT professionals employed by large and small companies who employ the services of computer and technology consulting providers. Based on the direct overlap between SAP software products and Defendant's intended trade channels, as well as the fact that Plaintiff is actively expanding into the mobility and cloud technology space, there is no question that these consumers would believe that the parties respective services are provided by the same company.

26. Defendant's use of the mark **BNIMBL** is so similar to Plaintiff's **NIMBL**, **BE NIMBL** and **BE LIKE JACK** marks that it is likely to cause confusion, mistake or deception as to the source or origin of Defendant's services. The mark **BNIMBL**, like Plaintiff's marks **BE**

NIMBL and **BE LIKE JACK**, is a clear play on the same famous nursery rhyme “Jack Be Nimble.” As a result of Defendant’s use of the virtually identical mark in connection with highly related services, consumers are likely to believe that Defendant’s services are provided by, or sponsored by, or approved by, or licensed by, or affiliated with or in some other way legitimately connected to Plaintiff.

27. Not only is confusion likely, but even though Defendant has not yet officially launched its business, instances of actual confusion have already begun to take place. For example, Plaintiff has received emails to its jack@benimbl.com email address which were intended for Defendant. In addition, Plaintiff has been contacted by business associates who have encountered Jack Wodlinger’s promotion of his new business being conducted under the confusingly similar mark **BNIMBL** and have mistakenly believed that Mr. Wodlinger is employed by or otherwise associated with Plaintiff.

28. The acts of Defendant complained of hereinabove are unlawful, willful and knowingly performed with the intent and result of injuring Plaintiff.

G. PLAINTIFF’S NOTICE TO DEFENDANT

29. Soon after Plaintiff learned about Defendant’s plans to use the confusingly similar mark **BNIMBL**, counsel for Plaintiff sent a cease and desist letter dated August 9, 2011 to counsel for Defendant, demanding that Defendant cease and desist from using the service mark **BNIMBL** in connection with its services. A copy of Plaintiff’s August 9, 2011 letter is attached hereto as **Exhibit E**.

30. Defendant has failed to comply with any of the demands set forth in Plaintiff’s aforementioned letter.

COUNT I

**UNFAIR COMPETITION UNDER SECTION 43(a)
OF THE LANHAM ACT**

31. Plaintiff repeats and reallages each and every allegation contained in Paragraphs 1-30 of the Complaint as though fully set forth herein.

32. Defendant, through its conduct as described above, is actively preparing to provide services under a colorable imitation of Plaintiff's protectable **NIMBL, BE NIMBL and BE LIKE JACK** marks, which is likely to cause confusion or mistake and/or to deceive in violation of Section 43(a) of the Lanham Act (15 U.S.C. § 1125(a)).

33. Defendant has committed such acts of false designation of origin and false description and representation willfully and with full knowledge of Plaintiff's prior use of, and rights in, its **NIMBL, BE NIMBL and BE LIKE JACK** marks.

34. As a result of Defendant's acts of unfair competition, Plaintiff has suffered and will continue to suffer serious and irreparable harm for which there is no adequate remedy at law.

COUNT II

**COMMON LAW TRADEMARK AND SERVICE MARK
INFRINGEMENT AND UNFAIR COMPETITION**

35. Plaintiff repeats and reallages each and every allegation contained in Paragraphs 1-34 of the Complaint as though fully set forth herein.

36. Defendant's aforesaid acts constitute infringement of Plaintiff's rights in its common law service marks **NIMBL, BE NIMBL and BE LIKE JACK** and tend to falsely describe or represent that Defendant's services are provided by, or sponsored by, or approved by, or licensed by, or affiliated with or in some other way legitimately connected to Plaintiff and are of the same character, nature and quality as the services of Plaintiff, thereby damaging Plaintiff and Plaintiff's reputation.

37. The acts of Defendant complained of hereinabove constitute acts of unfair competition against Plaintiff under the laws of the United States including Section 43(a) of the Lanham Act and the common law of the State of Colorado, which acts have been committed knowingly and willfully and have injured Plaintiff in its trade and business.

38. By reason of the aforesaid acts, Defendant has caused damage to Plaintiff and to the goodwill associated with Plaintiff's mark.

COUNT III

VIOLATION OF COLORADO CONSUMER PROTECTION ACT

39. Plaintiff repeats and reallages each and every allegation contained in Paragraphs 1-38 of the Complaint as though fully set forth herein.

40. Defendant is engaged in deceptive trade practices, namely, making false representations as to an affiliation, connection, or association with Plaintiff's services through its utilization of virtually identical business names, trademarks, domain names and email addresses.

41. Defendant's aforesaid acts constitute a violation of the Colorado Consumer Protection Act, C.R.S. § 6-1-105, which provides a private cause of action for deceptive trade practices that affect the public.

42. The deceptive trade practices occurred and continue to occur in the course of defendant conducting its software consulting and development business.

43. The deceptive trade practices engaged in by Defendant significantly impacted the public as actual or potential consumers of Defendant's services.

44. Plaintiff's business has been injured and continues to be injured as a result of Defendant's deceptive trade practices.

45. Defendant's deceptive trade practices have caused and continues to cause actual damages to Plaintiff.

46. By reason of the aforesaid acts, Defendant has caused, and unless enjoined by this Court, will continue to cause serious and irreparable injury and damage to Plaintiff and to the goodwill associated with Plaintiff's services.

COUNT IV

VIOLATION OF COLORADO COMMON LAW

47. Plaintiff repeats and reallages each and every allegation contained in Paragraphs 1-46 of the Complaint as though fully set forth herein.

48. By virtue of Defendant's acts hereinabove pleaded, Defendant has violated Colorado common law which prohibits unfair competition.

49. Defendant's unauthorized use of the confusingly similar mark BNIMBL in connection with software consulting and development services is likely to cause confusion or misunderstanding as to affiliation, connection or association with the services of Plaintiff provided under its NIMBL, BE NIMBL and BE LIKE JACK marks.

50. Defendant's unauthorized and continued use of the confusingly similar mark BNIMBL in connection with software consulting and development services jeopardizes the entire goodwill built up by Plaintiff in its NIMBL, BE NIMBL and BE LIKE JACK marks, causing serious irreparable injury to Plaintiff for which Plaintiff has no adequate remedy at law.

COUNT V

VIOLATION OF ANTICYBERSQUATTING CONSUMER PROTECTION ACT

51. Plaintiff repeats and reallages each and every allegation contained in Paragraphs 1-50 of the Complaint as though fully set forth herein.

52. Defendant has a bad faith intent to profit from its registration of the domain name www.bnimbl.com given that:

(a) Defendant has registered, trafficked in and/or used the domain name www.bnimbl.com which incorporates and is substantially similar to Plaintiff's NIMBL and BE NIMBL marks;

(b) Defendant has diverted, is diverting and/or planned to divert consumers away from Plaintiff's website (located at www.benimbl.com) to Defendant's own website for commercial gain by creating a likelihood of confusion as to the source, sponsorship, affiliation or endorsement of its website and the use of the domain name www.bnimbl.com; and

(c) Defendant has no valid trademark or other intellectual property rights in the domain name www.bnimbl.com.

53. Such registration, trafficking and/or use is actionable under the Anticybersquatting Consumer Protection Act, Section 43(d) of the Lanham Act, 15 U.S.C. §1125(d).

54. The actions, conduct and practices of Defendant described above have at all times been willful and/or knowing.

55. As a direct and proximate result of the actions, conduct and practices of Defendant alleged above, Plaintiff has been damaged and will continue to be damaged.

JURY DEMAND

Pursuant to Rule 38 of the Federal Rules of Civil Procedure, Plaintiff demands a trial by jury on all issues so triable raised by the pleadings in this action.

PRAYER FOR RELIEF

WHEREFORE, Plaintiff demands judgment in its favor and against Defendant as follows:

1. That Defendant, and its officers, principals, agents, servants, distributors, affiliates, employees, attorneys and representatives and all those in privity or acting in concert with the Defendant, and each of them, be permanently enjoined and restrained from, directly or indirectly:

- (a) Using the confusingly similar mark **BNIMBL**, or any other marks confusingly similar thereto, alone or in combination with other words, names, styles, titles, designs or marks in connection with the provision of software consulting or development services;
- (b) Using in any other way any other marks or designations so similar to Plaintiff's aforesaid **NIMBL**, **BE NIMBL** and **BE LIKE JACK** marks as to be likely to cause confusion, mistake or deception;
- (c) Falsely designating the origin, sponsorship, or affiliation of the Defendant's services in any manner;
- (d) Otherwise competing unfairly with Plaintiff in any manner;
- (e) Using any words, names, styles, designs, titles, designations, or marks which create a likelihood of injury to the business reputation of Plaintiff and the goodwill associated therewith;
- (f) Using any trade practices whatsoever including those complained of herein, which tend to unfairly compete with or injure Plaintiff's business and goodwill pertaining thereto;
- (g) Using the domain name www.bnimbl.com for any purpose whatsoever; and
- (h) Continuing to perform in any manner whatsoever any of the acts complained of in this complaint.

2. That Defendant be required to pay to Plaintiff compensatory damages for the injuries sustained by Plaintiff in consequence of the unlawful acts alleged herein and that such damages be trebled pursuant to 15 U.S.C. § 1117 because of the willful and unlawful acts as alleged herein.

3. That Defendant be required to account for and pay over to Plaintiff all gains, profits and advantages derived by them from the unlawful activities alleged herein.

4. That Defendant be required to deliver for destruction all stationary, signs, advertisements, promotional flyers, cards, brochures, menus, promotional materials and any other written materials which bear the trademark or service mark BNIMBL together with all plates, molds, matrices and other means and materials for making or reproducing the same.

5. That Defendant be required to pay to Plaintiff all of its litigation expenses, including but not limited to reasonable attorneys fees and the costs of this action.

6. That Defendant be required to transfer the domain name www.bnimbl.com to Plaintiff.

7. That Defendant be required to pay any and all pre and post judgment interest.

8. That any damages awarded be trebled pursuant to the Colorado Consumer Protection Act, C.R.S. § 6-1-105.

9. That Plaintiff be awarded such other and further relief as the Court may deem just and proper.

Dated: August 26, 2011

s/ Jordan Lipp

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Pending admission to the U.S. District Court