

**IN THE UNITED STATES DISTRICT COURT
FOR THE WESTERN DISTRICT OF TEXAS
AUSTIN DIVISION**

**TEXAS DEPARTMENT OF
TRANSPORTATION**

Plaintiff,

v.

**CHRISTIE CRAIG, BARNES & NOBLE, INC.
HACHETTE BOOK GROUP USA,
and GRAND CENTRAL PUBLISHING**

Defendants.

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CIVIL ACTION NO.

1:11-cv-726

JURY DEMANDED

**PLAINTIFF’S APPLICATION FOR A TEMPORARY RESTRAINING ORDER
AND PRELIMINARY INJUNCTION AND BRIEF IN SUPPORT THEREOF**

I. INTRODUCTION

1. Plaintiff, Texas Department of Transportation (“Plaintiff” or “TxDOT”), brings this action alleging, inter alia, trademark infringement and dilution by Defendants in connection with a book to be published on August 23, 2011.

2. Plaintiff moves this court to issue a temporary restraining order and preliminary injunction pursuant to Rule 65 of the Federal Rules of Civil Procedure prohibiting Defendants from issuing the book under its current title of “Don’t Mess with Texas.”

II. STATEMENT OF FACTS

3. TxDOT has registered the mark DON’T MESS WITH TEXAS (the “Mark”) on the principal register of the United States Patent and Trademark Office (“USPTO”) in connection with various goods and services. See printouts of TxDOT trademark registrations, attached as composite **Exhibit A** filed with the Complaint concurrently herewith. All exhibits to the

Complaint are incorporated herein by reference. The applications for the earliest of such registrations were filed on October 16, 2000, and the registrations issued in September and October 2002. See U.S. Reg. Nos. 2627196, 2616831, and 2619887, included as part of composite **Exhibit A** attached to the Complaint.

4. The foregoing registrations of the Mark are valid, subsisting, in full force and effect, and certain of the registrations have become incontestable pursuant to 15 U.S.C. § 1065.

5. The registrations for the Mark constitute *prima facie* evidence of their validity and conclusive evidence of TxDOT's exclusive right to use the Mark in connection with the goods and services identified therein and other commercial goods and services provided by TxDOT.

6. The registrations for the Mark also provide sufficient notice to Defendants of TxDOT's ownership and exclusive rights in and to the Mark.

7. The Mark has been in continuous use for many years in connection with various goods and services, including but not limited to anti-litter campaigns, clothing, beverage containers, magnets, jewelry, printed materials (such as postcards, note pads, posters, folders, decorative pencils, etc.). See **Exhibit A** to the Complaint.

8. TxDOT has spent millions of dollars advertising the Mark and related goods and services, throughout the State of Texas and this judicial district, as well as nationwide. TxDOT has received numerous awards and favorable publicity in connection with the Mark. See list of awards and honors, attached as **Exhibit B** to the Complaint.

9. As a result of TxDOT's activities, and the widespread publicity and favorable acclaim for the Mark, the Mark is now famous as that term is used in 15 U.S.C. § 1125 (c)(1). In particular, the Mark has been marketed, advertised and used nationwide by TxDOT and authorized third parties in a variety of forms of media (television, print, radio, Internet, etc.) for

over twenty (20) years. TxDOT has offered and sold its various products, either directly or through authorized third parties, on a nationwide basis for over twenty (20) years. The Mark has been widely recognized by third parties, and the goods and services offered under the Mark are associated with TxDOT. As an example, surveys have indicated that the Mark is recognized by over 95% of the population in the State of Texas.

10. As a result of extensive use and promotion, the Mark has acquired a favorable reputation to consumers as an identifier and symbol of TxDOT and its products, services, and goodwill. Accordingly, TxDOT is the owner of broad common-law and federal trademark rights in the Mark.

11. On or about August 8, 2011, TxDOT discovered that Defendants intend to publish on August 23, 2011 a “romance novel” by the title of “Don’t Mess with Texas.” *See* composite **Exhibit C** attached to the Complaint. On August 9, 2011, TxDOT sent a demand letter to Defendants regarding infringement and dilution, and requested that the title of the foregoing book be changed to something else that did not incorporate the Mark. *See* **Exhibit D** attached to the Complaint.

12. Defendants’ responded on August 10, 2011, denying that any alteration was necessary. *See* **Exhibit E** attached to the Complaint..

13. On or about August 17, 2011, TxDOT received a copy of the Defendants’ book. The book contains numerous graphic references to sexual acts, states of sexual arousal, etc. In addition, Defendants have purposefully sought to copy and use the Mark, as admitted in the context of the book at issue. *See* excerpts from the book, attached as composite **Exhibit F** attached to the Complaint.

14. Defendants have not obtained authorization, permission, or a license from TxDOT to use the Mark in connection with the book entitled “Don’t Mess with Texas.”

15. Defendants intend to sell their book in some of the same established, likely to continue trade channels as some of TxDOT’s products that are marketed and sold under the Mark (e.g., TxDOT has licensed rights to a book entitled “Don’t Mess with Texas,” which is currently sold in Barnes & Noble stores; TxDOT also has registered the Mark for use in connection with printed materials such as notepads, or decorative pencils, while Barnes & Noble also sells pencils and notepads through its retail and online stores). See printout from Barnes & Noble website, indicating that it also sells, for example, pencils and notepads at its stores, attached as **Exhibit G** attached to the Complaint. If Defendants are allowed to proceed with publication of the book entitled “Don’t Mess with Texas,” irreparable harm will result to TxDOT. See also declaration attached as **Exhibit H** attached to the Complaint.

III. ARGUMENT

A. STANDARD FOR ISSUANCE OF A TEMPORARY RESTRAINING ORDER AND PRELIMINARY INJUNCTION

16. When ruling on an application for a temporary restraining order and a preliminary injunction, the Court must consider four factors:

- (1) a substantial likelihood of success on the merits;
 - (2) a substantial threat that [plaintiff] will suffer irreparable injury absent the injunction;
 - (3) that the threatened injury outweighs any harm the injunction might cause the defendants; and
 - (4) that the injunction will not impair the public interest
- Enrique Bernat F., S.A. v. Guadalajara Inc., 210 F.3rd 439, 442 (5th Cir. 2000).

B. PLAINTIFF TXDOT WILL SUFFER IRREPARABLE HARM IF THE TEMPORARY RESTRAINING ORDER AND PRELIMINARY INJUNCTION ARE DENIED

17. Plaintiff seeks a temporary restraining order and preliminary injunction that will enjoin Defendants from publishing the book under its current title of “Don’t Mess with Texas.”

18. TxDOT’s mark, DON’T MESS WITH TEXAS, is famous, and has been used for over twenty (20) years in connection with various products and services.

19. DON’T MESS WITH TEXAS is not used in connection with “romance novels,” which typically contain subjects regarding sexual acts, sexual arousal, etc., as the current book does. The goodwill in the DON’T MESS WITH TEXAS mark will be irreparably harmed, and its distinctive character lessened, if Defendants are allowed to appropriate the mark for use with a book containing such subjects. Consumers will be confused, will think that TxDOT has sponsored or approved a book containing such subjects, and thereby the immense value of the mark will be lessened. This damage cannot be “undone” if the book is published under its current title of “Don’t Mess with Texas” (or anything confusingly similar thereto).

C. DEFENDANTS WILL SUFFER NO HARM IF THE PRELIMINARY INJUNCTION IS GRANTED

20. The injunction sought by Plaintiff will require Defendants to re-title the book at issue, and to the extent that advance copies have been published and sent, to recall those copies.

D. PLAINTIFF IS LIKELY TO SUCCEED ON THE MERITS

21. This action is brought under 15 U.S.C. § 1051 et seq. with respect to infringement and dilution of a registered mark.

22. In determining whether a likelihood of confusion exists, courts consider the following non-exhaustive list of factors: (1) the type of mark infringed, (2) the similarity between the two marks, (3) the similarity of the products or services, (4) the identity of the retail outlets and purchasers, (5) the identity of the advertising media used, (6) the defendant's intent, and (7) any evidence of actual confusion. *See Pebble Beach Co. v. Tour 18 Ltd.*, 155 F.3d 526, 543 (5th Cir. 1998).

23. Defendants' book title, "Don't Mess with Texas," is the same as TxDOT's mark. TxDOT has used its mark in connection with printed materials, and has licensed use of the mark in connection with a different book called "Don't Mess with Texas," which is also sold by one of the defendants to this case (Barnes & Noble). Both defendants and TxDOT advertise their respective products and services via various forms of media, including print, television and via the Internet. Defendants were aware of TxDOT and its mark, and intentionally used the name "Don't Mess with Texas," as indicated by excerpts from the book attached to the Complaint.

24. In addition, the DON'T MESS WITH TEXAS mark is famous, and it was in use and became famous long before the intended publication of Defendants' book. TxDOT will be able to show that Defendants' book title will create an association between the book and the TxDOT mark, it will likely lessen the capacity of the famous mark to identify and distinguish TxDOT's goods and services, and it will harm the reputation of TxDOT's mark in light of the subject of the book.

E. THE PUBLIC INTEREST WILL NOT BE IMPAIRED.

25. The purpose of trademark law is, in part, to prevent consumer confusion with respect to the source and identity of goods and services offered under a trademark. Preventing the

publication of the book under its current title will not harm the public interest, it will serve the public interest by preventing consumer confusion as to, inter alia, source, sponsorship or affiliation. In addition, if the Defendants re-title the book, and recall any advance or other copies that have already been published or sent to distributors, the public will be able to read Defendants' book, simply under a different title.

III. CONCLUSION

WHEREFORE, for the foregoing reasons, Plaintiff respectfully requests that the Application for a Temporary Restraining Order and Preliminary Injunction be granted.

Plaintiff further asks that the Court rule on its application immediately, since the book is to be published on August 23, 2011.

Respectfully submitted,

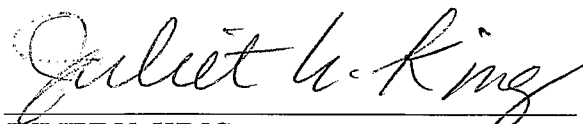
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**ATTORNEYS FOR PLAINTIFF
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VERIFICATION

I, JULIET U. KING, being first duly sworn, depose and say that I have read the foregoing Application for a Temporary Restraining Order and Preliminary Injunction and Brief in Support Thereof, and that the facts stated therein, which relate to me are true and correct and within my personal knowledge. I am of sound mind and fully competent to testify as to the facts stated therein.

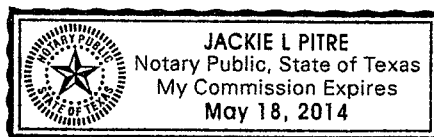


JULIET U. KING

SWORN TO AND SUBSCRIBED BEFORE on this the 19th day of August 2011.



Notary Public, State of Texas



ATTORNEY'S CERTIFICATION

I certify that I am notifying Defendants' counsel on August 19, 2011 as to the filing of the instant application and complaint, and will forward the application and complaint to such counsel immediately on August 19, 2011.


Dwayne K. Goetzl

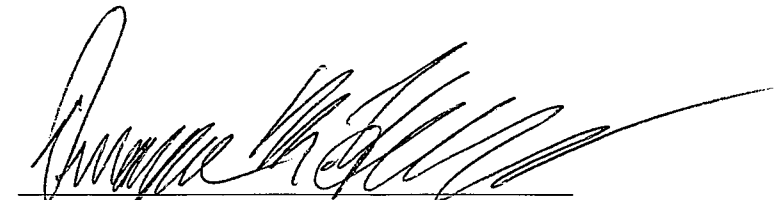
CERTIFICATE OF SERVICE

I hereby certify that a true and correct copy of the above and foregoing Plaintiff's Application for a Temporary Restraining Order and Preliminary Injunction and Brief in Support Thereof has been sent by Facsimile, Email and Federal Express as follows, on August 19, 2011:

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