

**UNITED STATES DISTRICT COURT FOR  
THE SOUTHERN DISTRICT OF TEXAS  
HOUSTON DIVISION**

**BUC-EE'S, LTD.**

**Plaintiff,**

**v.**

**AMJAD PANJWANI,  
SHEPHERD RETAIL, INC.  
AND HARLOW FOOD, INC.**

**Defendants.**

§  
§  
§  
§  
§  
§  
§  
§  
§  
§  
§

**CIVIL ACTION NO. 4:15-CV-03704**

**JURY REQUESTED**

**OPPOSED MOTION AND BRIEF TO DISMISS OR, IN THE  
ALTERNATIVE, TRANSFER VENUE PURSUANT TO 28  
U.S.C. §§ 1391 and 1406(a)**

Defendants, Amjad Panjwani, Shepherd Retail, Inc., and Harlow Food, Inc., request the dismissal of this case, or in the alternative, transfer of venue to the Western District of Texas, San Antonio Division, pursuant to 28 U.S.C. § § 1391 and 1406(a).

**INTRODUCTION**

Plaintiff, BUC-EE'S Ltd. filed a civil action claiming trade dress infringement under 15 U.S.C. § 1125(a), statutory trademark infringement under 15 U.S.C. § 1114, violations of the Texas Anti-Dilution Statute, Texas Business and Commerce Code § 16.29, common law trademark infringement, unjust enrichment, unfair competition and misappropriation; and recover damages, profits, treble damages or profits, attorneys' fees, and costs against Defendants. Plaintiff asserts that this "Court possesses personal jurisdiction over the parties, and venue is proper in this District

pursuant to 28 U.S.C. § 1391(b) and (c) **because a substantial part of the events or omissions giving rise to the claim occurred in this District.**” Emphasis added.

Since January of 2015 Defendants have operate a convenience store in Atascosa, Texas, under the name PARADOR with a small restaurant inside the store under the name CHOKE CANYON BBQ plus design and a standalone BBQ restaurant since 2012. Defendants have been using the CHOKE CANYON BBQ plus design mark on a standalone restaurant since 2012 without complaint by Plaintiff. Defendants are at a complete loss as to any tenable basis for the complaint about their standalone CHOKE CANYON BBQ standalone restaurant.

Plaintiff alleges that the Defendants’ stores copied “the concept, design, and trade dress of Plaintiff’s convenience stores and travel centers.” It is also alleged that Defendants’ actions are creating confusion in the marketplace because their “store design copies the look and feel of BUC-EE’S stores.” Plaintiff further claims the “Defendants are marketing their business using an alligator logo that infringes on the federally registered trademarks of BUC-EE’S.”

The asserted trademark registrations include Registration Numbers 3763277 and 4007063 for the mark BUC-EE’S in plain block letters. Plaintiff also claims its following “artistic font used in BUC-EE’S is also distinct, with rounded and curved lettering” which is not part of the above two asserted word mark registrations:

**BUC-EE'S**

The asserted trademark registrations also Registration Numbers 3246893 and 4007064 for the BUC-EE’S beaver as follows:



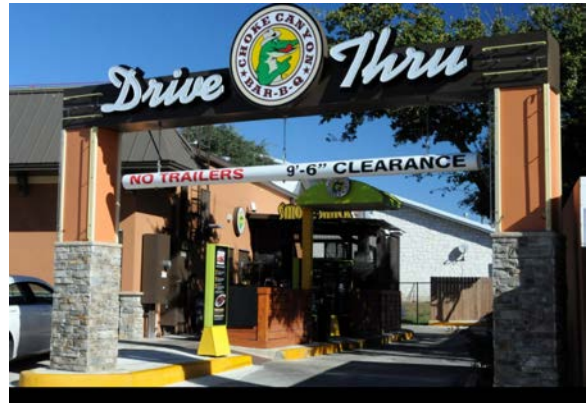
The mark which Plaintiff claims is infringing it the CHOKE CANYON BAR-B-Q plus alligator design as follows:



typically used as



To put it in context, it appears on Defendant's standalone restaurant at 21510 Blanco Road, San Antonio, Bexar County, TX 78212 as follows:



The Defendant's Alligator logo also sometimes appears as black and white and in color with black letters depending on the media and label or sign requirements. The Defendant's Alligator logo with and without the words, CHOKE CANYON BAR-B-Q, appears on private labeled goods and

on the restaurant inside Defendant's PARADOR SAN ANTONIO convenience store at 16565 Shepherd Road, Atascosa, Bexar County, Texas 78002. Defendant's convenience store has on its very large marquee sign its trademark that is visible from the road its trademark as follows:



In summary, Defendant claims the following marks are confusingly similar:



Plaintiff asserts that it has the exclusive right to use “a friendly smiling cartoon animal.” Plaintiff claims infringement because “Defendants have copied the BUC-EE’S Marks with: (i) the use of a black circle encompassing the alligator (compare to the black circle around the beaver), (2) use of a yellow background (compare to the yellow surrounding the beaver), (3) use of the red-colored tongue of the alligator (compare to the red hat on the beaver), (4) prominent use of sharply drawn black edges for the alligator mascots (compare to the sharp crisp black edges defining the beaver.” Plaintiff does not mention the friendly smiling cartoon animal that Defendants also have been using for over a decade, namely, the EXXON Tiger, on Defendants’ convenience stores and who will “PUT A TIGER IN YOUR TANK.” Even TONY THE TIGER could not put a stop to the EXXON TIGER. Plaintiff will doubtfully have any better luck.

Plaintiff also claims that it has the exclusive right to use the following features under the guise of “trade dress”:

- (a) Consistent use of bell-gabled roof lines;
- (b) Use of a red, white, yellow and black color scheme in store signage;
- (c) Use of stone siding on the exterior of the store;
- (d) Consistent use of a specific and distinctive fountain drink set up in the interior of the stores;
- (e) In-store computer ordering kiosks;
- (f) Horse-shoe shaped in-store carving stations;
- (g) Open counter deli stations;
- (h) Freshly prepared signature food choices;
- (i) Consistent, prominent use of the BUC-EE'S Marks in signage above and on the products offered for sale;
- (j) Large square footage;
- (k) Numerous fuel pumps;
- (l) Abundant and oversized parking spaces;
- (m) Oversized bathrooms;
- (n) A multitude of cashier stations;
- (o) Entrances from three of the four sides of the building.
- (p) Antique-looking displays;
- (q) Country-themed signage; and
- (r) Khaki paint colors.

Plaintiff does not explain how these common, functional and utilitarian features are subject to any protection whatsoever under "trade dress." Defendants' trademarks and building and interiors bear scant resemblance to Plaintiff's trademarks and buildings and these primarily functional features are simply not protectable. Any similarities are non-protectable common, functional and utilitarian features. The legality of this will be addressed in another motion.

The important thing for this this motion is that all of the acts of Defendants and the alleged infringement that are complained of occurred in Bexar County, Texas. It appears that the real complaint in this case is Plaintiff's objection that "a [possible future] convenience store Defendants plan to open is within close proximity of a Buc-ee's store located in New Braunfels, Texas and Luling, Texas and will share the same client base, leading to further consumer confusion." Plaintiff apparently objects to anyone using any trademark or trade dress even when not remotely similarly to Plaintiff's trademark and "trade dress" when it might involve sharing the same client base. This

free competition can be distinguished from unfair competition when a similar trademark and “trade dress” are involved.

### ARGUMENT AND AUTHORITIES

In the Plaintiff’s Original Complaint (“Complaint”), Plaintiff states the court possesses personal jurisdiction over the parties, and that venue is proper in the Southern District of Texas – Houston Division pursuant to 28 U.S.C. § 1391(b) and (c) alleging “**a substantial part of the events or omissions giving rise to the claim occurred in this District.**” Emphasis added. (See Plaintiff’s Original Complaint and Application for Preliminary and Permanent Injunction ¶ 5). The only allegations in the complaint to support this allegation of personal jurisdiction is the alleged infringement that only occurred in Bexar County, Texas.

Venue for trademark infringement claims is governed by the general federal venue statute, 28 U.S.C. § 1391(b), which provides in relevant part: "A civil action wherein jurisdiction is not founded solely on diversity of citizenship may . . . be brought in—(1) a judicial district in which any defendant resides, if all defendants are residents of the State in which the district is located; (2) a judicial district in which a substantial part of the events or omissions giving rise to the claim occurred, or a substantial part of property that is the subject of the action is situated; or (3) if there is no district in which an action may otherwise be brought as provided in this section, any judicial district in which any defendant is subject to the court's personal jurisdiction with respect to such action." *Hsin Ten Enter. United States v. Clark Enters.*, 138 F. Supp. 2d 449, 457 (S.D.N.Y. 2000). When venue is challenged, the court must determine whether the case falls within one of the three categories set out in § 1391(b). If it does, venue is proper; if it does not, venue is improper, and the case must be dismissed or transferred under § 1406(a). *Atl. Marine Constr. Co. v. United States Dist. Court*, 134 S. Ct. 568, 573 (2013).

Plaintiff asserts that Defendants, Amjad Ranjwani, Shepherd Retail, Inc., and Harlow Food, Inc. all reside in San Antonio, TX. (See Plaintiff's Original Complaint and Application for Preliminary and Permanent Injunction ¶¶ 7, 8, 9). Defendants' brick and mortar store and restaurants are located at 16565 Shepherd Rd, Atascosa, TX 78002 and 21510 Blanco Rd, San Antonio, TX 78212 which is a standalone restaurant. Accordingly, pursuant to 28 U.S.C. § 1391(b)(1), venue is proper in San Antonio division of the Western District of Texas. The Complaint makes no mention of any connection between Defendants and the Southern District of Texas.

Plaintiff asserts that the alleged infringement is occurring at Defendants' convenience store located in Atascosa, Texas, a few miles southwest of San Antonio, Bexar County, Texas and its BBQ restaurant location is the convenience store and in San Antonio Texas (*See* Plaintiff's Original Complaint and Application for Preliminary and Permanent Injunction ¶ 2). Defendants store and restaurants are located in San Antonio, Bexar County, Texas and that the complained of acts occurred in San Antonio, Bexar County, Texas in the Western District of Texas.

But these facts do not support venue in the Southern District of Texas. In *Hopdoddy Burger Bar, Inc. v. Blacketer*, 2015 U.S. Dist. LEXIS 100139 (WD TX 2015) when faced with a very similar situation, the Court found as follows:

"Plaintiff contends that a substantial part of the events or omissions giving rise to the claim occurred in Texas. In support of that contention, Plaintiff points to phone and email communications from Blacketer to Plaintiff in March 2014 seeking to obtain a Hopdoddy Burger Bar franchise. (1st Am. Compl. ¶¶ 89 & Ex. B). Plaintiff additionally points [5] to an affidavit from its President and CEO who states Blacketer admitted he has visited at least one of Plaintiff's restaurants in Texas. (Id. Ex. A). In sum, Plaintiff contends the conduct of Blacketer, and specifically his entry into Texas to gather information concerning Plaintiff's business, gave rise to its claims.

Plaintiff's argument misses the mark for two reasons. First, at best, only some part of the events giving rise to the claims at issue in this lawsuit occurred in Texas. Notably, Plaintiff does not cite to any conduct on the part of any defendant other than Blacketer. And the conduct Plaintiff cites appears to consist of a single visit to one restaurant. However, the statute on which Plaintiff relies looks to where a "substantial part" of the events giving rise to the action occurred.



Second, the gravamen of Plaintiff's complaint is that Defendants' restaurants infringe on Plaintiff's trademarks and design. Courts uniformly agree the proper venue for a trademark infringement case lies where the infringing activity, or the "passing off" occurred. See, e.g., *Cottman Transmission Sys., Inc. v. Martino*, 36 F.3d 291, 295 (3d Cir. 1994) (focus of venue inquiry in Lanham Act trademark infringement case is location where unauthorized passing off takes place); *Woodke v. Dahm*, 70 F.3d 983, 985 (8th Cir. 1995) (place where the alleged passing off occurred "provides an obviously correct venue"); *Tefal, S. A. v. Products International Co.*, 529 F.2d 495, 496 n.1 (3d Cir. 1976) ("cause of action for trademark infringement arises where the passing off occurs"); *Kaia Foods, Inc. v. Bellafigiore*, 70 F. Supp. 3d 1178, 1184 (N.D. Cal. 2014) (in trademark infringement action, substantial part of events occurs "where the labels are affixed and where confusion of purchasers is likely to occur"); *Mrs. U.S. Nat'l Pageant, Inc. v. Miss U.S.A. Org., LLC*, 875 F. Supp. 2d 211, 226 (W.D.N.Y. 2012) (venue is proper in trademark infringement case "in each jurisdiction where infringement is properly alleged to have occurred"); *Allstar Mktg. Grp., LLC v. Your Store Online, LLC*, 666 F. Supp. 2d 1109, 1128 (C.D. Cal. 2009) (in trademark suit brought under Lanham Act, "substantial part" of the events giving rise to the claims occurs "where consumers are likely to be confused by the accused goods"); *Golden Scorpio Corp. v. Steel Horse Bar & Grill*, 596 F. Supp. 2d 1282, 1286 (D. Ariz. 2009) (same); *Sykes Lab., Inc. v. Calvin*, 610 F. Supp. 849, 860 n.8 (C.D. Cal. 1985) (confusion of customers occurs where passing off occurs, that is, "where the deceived customer buys the defendant's product in the belief that he is buying the plaintiff's").

In this case it is undisputed that the allegedly infringing restaurant operations are located in Tulsa, Oklahoma. The "passing off" and consequent deception of consumers thus occurs there. In addition, Plaintiff concedes all the defendants reside in Oklahoma. Under Section 1406(a) this court may transfer an action to "any district or division in which it could have been brought." This [7] action could have been brought in the Northern District of Oklahoma, given both Tulsa #1 and Tulsa #2 reside in that district and that it is where the events giving rise to the claims occurred. 28 U.S.C. § 1391(b). Accordingly, the Court concludes this action should be transferred to the Northern District of Oklahoma."

Defendants have a passive web site and social media accounts such as Facebook and Twitter. Defendants do not have an online store. Advertising in a passive web site or on social media such as Facebook and Twitter, however, is not sufficient to support a finding of personal jurisdiction. See *Cascade Corp. v. Hiab-Foco AB*, 619 F.2d 36, 37–38 (9th Cir. 1980) (finding no specific jurisdiction where defendant patent holder advertised in "national publications" circulated in forum, visited forum on two occasions, and mailed accusatory letters to plaintiff in forum).



Defendants only have a brick and mortar business that located in San Antonio, Bexar County, Texas.

Defendants, Harlow Food, Inc. and Shepherd Retail, Inc. are both Texas corporations, and for venue purposes, a corporation is deemed to reside in any district where it is subject to personal jurisdiction at the time the suit commenced. 28 U.S.C. § 1391(d); *Int'l Software Sys. v. Amplicon, Inc.*, 77 F.3d 112, 114 n. 2 (5th Cir. 1996). In a multi-district state like Texas, a corporation is "deemed to reside in any district in that State within which its contacts would be sufficient to subject it to personal jurisdiction if that district were a separate State." 28 U.S.C. 1391(d); *In re Volkswagen of Am., Inc.*, 545 F.3d 304, 312-13 (5th Cir. 2008). Plaintiff does not allege any facts that any of the Defendants' business is being conducted in the Southern District of Texas, nor has there been any factual allegations of Defendants having sufficient contacts in the Southern District of Texas to show venue is proper under 28 U.S.C. § 1391(d). Plaintiff asserts in the complaint that Defendants' business is not conducted in the Southern District of Texas and Defendants are located and reside in San Antonio, Bexar County Texas.

This action could have been brought in the Western District of Texas, given all Defendants reside in that district and that it is where all of the events giving rise to the claims occurred. Under the clear provisions of 28 U.S.C. § 1391, venue is proper in the United States District for the Western District of Texas – San Antonio Division, which encompasses both the residence and places of business for all Defendants and where the infringing acts are alleged to have occurred. Therefore, under § 1406(a), this Court has the authority to either dismiss this case without prejudice or transfer this case to the Western District of Texas – San Antonio Division.

### **Conclusion**

Defendants have demonstrated that the United States District Court for the Western District of Texas, San Antonio Division, is the court in which venue is proper in this case. Defendants respectfully request either the dismissing of this Complaint, without prejudice, or transferring this case to the United States District Court for the Western District of Texas.

DATED February 5, 2016.

Respectfully submitted,

/s/ Charles W. Hanor  
Charles W. Hanor  
Texas Bar No. 08928800  
Hanor Law Firm PC  
750 Rittiman Road  
San Antonio, Texas 78209  
Telephone: (210) 829-2002  
Facsimile: (210) 829-2001  
chanor@hanor.com

ATTORNEY FOR DEFENDANTS  
AMJAD PANJWANI  
SHEPHERD RETAIL, INC.  
HARLOW FOOD, INC

**CERTIFICATE OF CONFERENCE**

I certify that counsel for Defendants, Charles W. Hanor, conferred with counsel for Plaintiff, H. Tracy Richardson, III, on January 27, 2016 and February 3, 2016 by calling him and leaving a voice message and February 5, 2016 via e-mail regarding the relief requested herein. Counsel for Plaintiff did not respond so it must be assumed that Plaintiff opposes this motion, as would be expected. Therefore, Defendants file this as an opposed motion.

/s/ Charles W. Hanor  
Charles W. Hanor

**CERTIFICATE OF SERVICE**

In accordance with Local Rule 5.3, I hereby certify that on the February 5, 2016, I electronically filed the foregoing with the Clerk of the Court using the CM/ECF system, which will send notification of such filing to counsel of record who have registered for ECF filing.

H. Tracy Richardson, III  
Texas Bar No. 16863700  
General Counsel  
**BUC-EE'S, LTD.**  
327 FM 2004  
Lake Jackson, Texas 77566  
Telephone: (979) 230-2968  
Fax: (979) 230-2969  
tracy@buc-ees.com

ATTORNEY FOR PLAINTIFF  
BUC-EE'S, LTD.

/s/ Charles W. Hanor  
Charles W. Hanor