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10 Attorneys for Plaintiff
 11 AIRWAIR INTERNATIONAL LTD.

12 **UNITED STATES DISTRICT COURT**
 13 **NORTHERN DISTRICT OF CALIFORNIA**

14 AIRWAIR INTERNATIONAL LTD., a
 15 company of the United Kingdom,
 16
 17 Plaintiff,
 18
 19 vs.
 20 PULL & BEAR ESPANA SA, a company of
 21 Spain, and DOES 1-50,
 22
 23 Defendants.

Case No.

COMPLAINT FOR

- (1) **FEDERAL TRADEMARK INFRINGEMENT**
- (2) **FEDERAL FALSE DESIGNATION OF ORIGIN**
- (3) **TRADEMARK DILUTION**
- (4) **CALIFORNIA STATUTORY UNFAIR COMPETITION**
- (5) **COMMON LAW UNFAIR COMPETITION**
- (6) **CALIFORNIA STATUTORY TRADEMARK DILUTION**

DEMAND FOR JURY TRIAL

Date Action Filed: November 19, 2019

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1 specifically targeted marketing and sales of its products to the state of California through
2 its website.

3 9. Venue is proper in this District pursuant to 28 U.S.C. § 1391 because Pull &
4 Bear conducts business within this District and has engaged in, and continues to engage in,
5 acts of advertising and offering retail goods and products to consumers located within this
6 District.

7 **FACTUAL ALLEGATIONS**

8 10. AirWair is headquartered in England and, through its predecessor company,
9 has manufactured footwear since 1901. AirWair has been manufacturing and marketing
10 Dr. Martens® footwear since 1960. Dr. Martens footwear is famous worldwide, and has
11 been sold not only in England, but also throughout Europe and the United States. It has
12 also been sold in Japan, China, Korea, Malaysia, Hong Kong, Thailand, Vietnam, and
13 other Asian countries; in Canada, Mexico, and Central and South America; in Australia
14 and New Zealand; and in the Middle East.

15 11. Since as early as 1984, AirWair has marketed and sold Dr. Martens boots,
16 shoes, and sandals in the United States using distinctive trade dress that features yellow
17 stitching in the welt area of the shoe, a two-tone grooved sole edge, the distinctive “DMS”
18 sole pattern, and a black fabric heel loop.




19 12. Dr. Martens footwear is widely recognized and extremely popular and has
20 achieved recognition as ranking among the world’s greatest and most recognizable brands.
21 The distinctive trade dress of its iconic boots and shoes has been used by the company
22 since 1960 and is world famous. Over the past 35 years, millions of pairs of shoes, boots,
23 and sandals with the distinctive trade dress have been sold in the United States.

24 13. AirWair holds many registrations for its trade dress throughout the world
25 including the following registrations in the United States Patent and Trademark Office.
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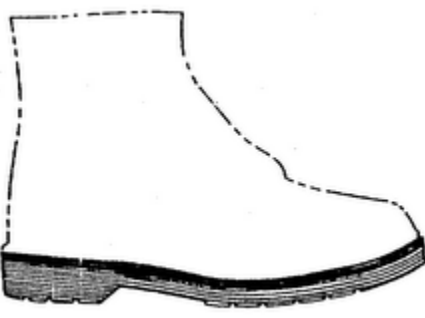

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Trade Dress Mark ¹	Design Element (where applicable)	Goods/Service
<p>Footwear Design *(incontestable mark) 2,437,750 03/27/2001</p> <p>Attached as Exhibit 1</p>		<p>Class 25: Footwear</p> <p>Notes: The mark consists of a welt stitch located around the perimeter of footwear. The phantom lining is not a part the mark, but merely indicates the position of the mark. The drawing of the welt stitch is lined for the color yellow and claim is made to color.</p>
<p>Footwear Design *(incontestable mark) 2,437,751 03/27/2001</p> <p>Attached as Exhibit 2</p>		<p>Class 25: Footwear</p> <p>Notes: The mark consists of the combination of yellow stitching in the welt area and a two-tone grooved sole edge. The drawing of the welt stitch is lined for the color yellow, and claim is made to color.</p>
<p>Footwear Design (The "DMS undersole") *(incontestable mark) 2,102,468 10/07/1997</p> <p>Attached as Exhibit 3</p>		<p>Class 25: Footwear</p> <p>Notes: The mark consists of the design of an undersole. The phantom lining is not a part of the mark, but merely indicates the position of the mark.</p>

¹ An "*" denotes that a declaration of continued use has been filed under Section 15 of the Lanham Act and the mark has become incontestable.

<p>1 Footwear Design 5,067,689 10/25/2016</p> <p>2</p> <p>3 Attached as Exhibit 4</p> <p>4</p> <p>5</p> <p>6</p>		<p>Class 25: Footwear</p> <p>Notes: The mark consists of the design of a sole edge including longitudinal ribbing, and a dark color band over a light color. The phantom lining is not a part of the mark, but merely indicates the position of the mark.</p>
<p>7 Footwear Design 5,067,692 10/25/2016</p> <p>8</p> <p>9 Attached as Exhibit 5</p> <p>10</p> <p>11</p> <p>12</p> <p>13</p> <p>14</p>		<p>Class 25: Footwear</p> <p>Notes: The mark consists of longitudinal ribbing and a dark color band over a light color on the outer sole edge, welt stitching, and a tab located at the top back heel of footwear.</p>

15 14. All of the above trade dress of Dr. Martens footwear (“Dr. Martens Trade
16 Dress”) has been in use in the United States since at least 1984.

17 15. AirWair has filed declarations of continued use under Sections 8 and 15 of
18 the Lanham Act for Dr. Martens Trade Dress marks referenced in Exhibits 1, 2, and 3, and
19 those marks have thus become incontestable.

20 16. The Dr. Martens Trade Dress is unique and distinctive when applied to the
21 high quality Dr. Martens footwear and related merchandise, and identifies the merchandise
22 as high-quality goods from AirWair. The registration of these marks constitutes *prima*
23 *facie* evidence of their validity, and conclusive evidence of AirWair’s exclusive right to
24 use the Dr. Martens Trade Dress in connection with the goods identified therein and other
25 commercial goods.

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1 17. The Dr. Martens Trade Dress marks qualify as famous marks, as that term is
2 used in 15 U.S.C. § 1125(c)(1), and such marks have been continuously used and never
3 abandoned.

4 18. The distinctive Dr. Martens Trade Dress and each of the individual elements
5 thereof are distinctive or have acquired distinctiveness, and are non-functional.

6 19. In 2010, AirWair celebrated the 50th anniversary of its classic Dr. Martens
7 footwear with its distinctive Trade Dress. Examples of classic Dr. Martens footwear,
8 including the 1460 boot, are shown below.



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18 20. From time to time, AirWair creates new Dr. Martens designs, with each new
19 style incorporating essential trade dress elements of the classic Dr. Martens footwear to
20 identify the product as genuine Dr. Martens.

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22 21. In 2013, AirWair began marketing a new style called the “Jadon.” The
23 Jadon boot uses classic Dr. Martens trade dress elements that consumers recognize and
24 associate with Dr. Martens, such as welt stitching, a grooved sole edge, heel tab, an angled
25 heel, and a distinctive cleat pattern. In addition, the Jadon boot uses a distinctive grooved,
26 double-layered platform sole. The Jadon style is hugely popular and has become an icon
27 of its own.
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22. Pull & Bear has marketed, distributed, and sold shoes and boots that are confusingly similar to and that unlawfully copy the distinctive Dr. Martens Trade Dress and various distinctive features of Dr. Martens footwear in violation of AirWair’s rights.



Genuine Dr. Martens® 1461 Shoe



Pull & Bear Shoe



Genuine Dr. Martens® “Jadon” Boot



Pull & Bear Boot

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Genuine Dr. Martens® Shriver Hi Vintage



Pull & Bear Boot

23. The infringing styles manufactured, marketed, and sold by Pull & Bear include, but are not limited to, the “Derby Shoes With Topstitching,” “White Platform Boots,” “Black Platform Derby Shoes,” and “Faux Suede Lace Front Chunky Sole Boot” pictured in **Exhibit 6** attached hereto. These infringing styles were offered for sale, advertised, and promoted in the United States on <https://www.pullandbear.com/us> and through third-party retailers that reach the United States such as Asos (<https://www.asos.com>).

24. Pull & Bear also advertises in the United States through Facebook (<https://www.facebook.com/pullandbear/>), Instagram (<https://www.instagram.com/pullandbear/>), and Twitter (https://twitter.com/pullandbear?ref_src=twsrc%5Egoogle%7Ctwcamp%5Eserp%7Ctwgr%5Eauthor). Through those popular channels, Pull & Bear markets and promotes its products, including the infringing footwear, in California, and throughout the United States.

25. Pull & Bear has a domain name that is specifically targeted and purposefully directed to United States residents. Orders submitted on the website are priced in U.S. dollars and ship to the United States, including California.

1 26. AirWair is informed and believes that the infringing footwear has been
2 regularly sold in California and in the Northern District of California. True and correct
3 copies of the receipts for certain infringing Pull & Bear styles purchased in California
4 through the Pull & Bear and Asos websites are attached hereto as **Exhibit 7**.

5 27. Pull & Bear's offering for sale and sale of the infringing footwear is likely to
6 cause and, on information and belief, has caused confusion between Dr. Martens footwear
7 and Pull & Bear's footwear.

8 28. Upon information and belief, Pull & Bear is familiar with the Dr. Martens
9 brand and its famous Trade Dress, which is and has been sold in the United Kingdom and
10 throughout Europe for more than 50 years.

11 29. Upon information and belief, Pull & Bear intentionally copied the Dr.
12 Martens Trade Dress in order to capitalize on the reputation and fame of the Dr. Martens
13 brand. This is an "exceptional case" of infringement within the meaning of 15 U.S.C. §§
14 1117(b) and 1117(a)(3) because Pull & Bear knowingly and intentionally used the Dr.
15 Martens Trade Dress and intentionally sold copy footwear with the intent to confuse
16 consumers. AirWair is therefore entitled to treble damages and attorneys' fees.

17 30. The use of the Dr. Martens Trade Dress on Pull & Bear's infringing footwear
18 suggests a sponsorship and affiliation that does not exist.

19 31. Pull & Bear has no right to use the Dr. Martens Trade Dress. Pull & Bear's
20 sale, advertisement, distribution, and promotion of the infringing footwear in the United
21 States is without authorization or consent from AirWair.

22 32. Pull & Bear's conduct in copying the Dr. Martens Trade Dress has been
23 systematic and deliberate. Pull & Bear has copied the Dr. Martens Trade Dress, and the
24 overall style and configuration of Dr. Martens boots and shoes, in a deliberate and
25 calculated attempt to trade upon the popularity and distinctive appearance and design of
26 Dr. Martens footwear.

27 33. By reason of Pull & Bear's acts, AirWair has suffered and will continue to
28 suffer damage to its business, reputation, and goodwill, and the loss of sales and profits

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1 AirWair would have realized but for Pull & Bear’s acts. Unless restrained and enjoined,
2 Pull & Bear will continue to engage in the acts complained of and irreparably damage
3 AirWair. AirWair’s remedy at law is not adequate to compensate AirWair for all the
4 resulting injuries arising from Pull & Bear’s actions.

5 **FIRST CLAIM FOR RELIEF**

6 **(Trademark Infringement in Violation of Lanham Act Section 32, 15 U.S.C. § 1114)**

7 34. AirWair realleges and incorporates by reference paragraphs 1 through 33 of
8 this Complaint.

9 35. Pull & Bear has, on or in connection with footwear products, used in
10 commerce subject to regulation by the U.S. Congress, a reproduction, counterfeit, copy or
11 colorable imitation of the Dr. Martens Trade Dress in connection with the sale, offering for
12 sale, distribution, and/or advertising of goods and services, which use is likely to cause
13 confusion, or to cause mistake, or to deceive.

14 36. Pull & Bear has, on or in connection with footwear products, reproduced,
15 counterfeited, copied and/or imitated the Dr. Martens Trade Dress and has applied such
16 reproductions, counterfeits, copies and/or colorable imitations to footwear, signs, displays,
17 advertisements, promotional materials, packaging, website content, and other materials
18 used in commerce in connection with the sale, offering for sale, distribution, or advertising
19 of goods and services, which use is likely to cause confusion, or to cause mistake, or to
20 deceive.

21 37. Pull & Bear is acting and has acted with knowledge that its copying and use
22 of the Dr. Martens Trade Dress is unauthorized, and such imitation is intended to cause
23 confusion, or to cause mistake, or to deceive.

24 38. Pull & Bear’s acts are in violation of 15 U.S.C. § 1114, and AirWair has
25 been and is likely to be damaged by these acts.

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SECOND CLAIM FOR RELIEF

**(Federal Unfair Competition and False Designation of Origin in Violation of
Lanham Act Section 43(a), 15 U.S.C. § 1125(a))**

39. AirWair realleges and incorporates herein by reference paragraphs 1 through 38 of this Complaint.

40. Pull & Bear’s unlawful copying and use of the Dr. Martens Trade Dress in connection with its footwear products is a false and misleading designation of origin and a false and misleading representation of facts, which:

(a) is likely to cause confusion, or to cause mistake, or to deceive as to the affiliation, connection, or association of Pull & Bear with AirWair, or as to the origin, sponsorship, or approval of Pull & Bear’s goods or commercial activities by AirWair; and/or

(b) in commercial advertising or promotion, misrepresent the nature, characteristics, or qualities of Pull & Bear’s goods, services, or commercial activities.

41. Pull & Bear’s acts are in violation of 15 U.S.C. § 1125(a), and AirWair has been and is likely to be damaged by these acts.

THIRD CLAIM FOR RELIEF

**(Federal Trademark Dilution in Violation of
Lanham Act Section 43(c), 15 U.S.C. § 1125(c))**

42. AirWair realleges and incorporates herein by reference paragraphs 1 through 41 of this Complaint.

43. The Dr. Martens Trade Dress is distinctive and famous in the United States. Pull & Bear has used and is using trade dress on its footwear products that is substantially indistinguishable from the Dr. Martens Trade Dress, after it became famous.

44. On information and belief, Pull & Bear acted with knowledge of the fame and reputation of the Dr. Martens Trade Dress with the purpose of usurping such rights and to willfully and intentionally confuse, mislead, and deceive members of the public.

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1 45. Pull & Bear’s actions have and are likely to dilute, blur, and tarnish the
2 distinctive quality of the Dr. Martens Trade Dress, and lessen the capacity of the Dr.
3 Martens Trade Dress to identify and distinguish the company’s products.

4 46. Pull & Bear’s acts are in violation of 15 U.S.C. § 1125(c), and AirWair has
5 been and is likely to be damaged by these acts. Unless Pull & Bear is restrained, AirWair
6 will continue to suffer damages and injury to its reputation and goodwill.

7 47. Because Pull & Bear acted willfully and intentionally to trade on AirWair’s
8 reputation and/or cause dilution of its famous Dr. Martens Trade Dress, AirWair is entitled
9 to damages, extraordinary damages, fees, and costs pursuant to 15 U.S.C. § 1125(c)(2).

10 **FOURTH CLAIM FOR RELIEF**

11 **(Unfair Competition in Violation of California Business**
12 **& Professions Code Section 17200, et seq.)**

13 48. AirWair realleges and incorporates herein by reference paragraphs 1 through
14 47 of this Complaint.

15 49. Pull & Bear’s acts, including the unlawful use and imitation of the Dr.
16 Martens Trade Dress in connection with the manufacture, marketing, distribution, and sale
17 of footwear products, constitute an unlawful, unfair or fraudulent business act or practice
18 and unfair, deceptive, untrue or misleading advertising, in violation of California Business
19 and Professions Code §§ 17200, et seq.

20 50. Pull & Bear’s pattern and practice of imitating the Dr. Martens Trade Dress
21 in connection with its footwear products, and of trading upon AirWair’s goodwill and
22 reputation, constitutes an unfair business practice in violation of California Business and
23 Professions Code §§ 17200, et seq.

24 51. Pull & Bear’s conduct was willful, and AirWair has been and is likely to be
25 damaged by these acts.

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FIFTH CLAIM FOR RELIEF

(Common Law Unfair Competition)

52. AirWair realleges and incorporates by reference paragraphs 1 through 51 of this Complaint.

53. Pull & Bear’s use and imitation of the Dr. Martens Trade Dress and the combination of its style features in footwear constitutes infringement, copying, imitation, and misappropriation of AirWair’s intellectual property, unjust enrichment of Pull & Bear, and unfair competition with AirWair in violation of AirWair’s rights under the common law of the State of California and other states of the United States.

54. Pull & Bear’s willful acts of misrepresentation, fraud, and deceit has unjustly enriched Pull & Bear and violated AirWair’s rights.

SIXTH CLAIM FOR RELIEF

(Dilution in Violation of California

Business & Professions Code Section 14247, et seq.)

55. AirWair realleges and incorporates by reference paragraphs 1 through 54 of this Complaint.

56. The Dr. Martens Trade Dress has become famous, in that they are widely recognized by the general consuming public of this state as a designation of source AirWair’s high quality goods and services.

57. After the Dr. Martens Trade Dress became famous, Pull & Bear began using trade dress and trademarks in connection with the Infringing Footwear that are substantially identical to the Dr. Martens Trade Dress.

58. Pull & Bear’s actions have diluted, blurred, and tarnished the strong and positive associations represented by the Dr. Martens Trade Dress by lessening the capacity of the Dr. Martens Trade Dress to identify and distinguish AirWair’s products and by causing AirWair’s products and the Dr. Martens Trade Dress to be associated with footwear not made, sponsored, or approved by AirWair.

59. Pull & Bear’s acts are in violation of California Business & Professions

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1 Code sections 14247, et seq., and AirWair has been and is likely to be damaged by these
2 acts.

3 60. AirWair has been damaged by way of lost sales and harm to its reputation.

4
5 **PRAYER FOR RELIEF**

6 Wherefore, AirWair prays for judgment in its favor and against Pull & Bear:

7 A. A preliminary and permanent injunction enjoining Pull & Bear, its officers,
8 shareholders, agents, servants, employees, attorneys, successors and assigns, suppliers,
9 manufacturers, distributors, business partners, e-tailers, retailers, and those in privity with
10 them, and those persons in active concert or participation with any of them who receive
11 actual notice of the judgment by personal service or otherwise, from manufacturing,
12 marketing, distributing or selling the Infringing Footwear or any other footwear products
13 that use, imitate or copy any of the Dr. Martens Trade Dress or elements of the Trade
14 Dress, as illustrated in **Exhibits 1-5**, or any combination of them.

15 B. An Order directing Pull & Bear to file with this Court and serve on
16 AirWair’s counsel within 30 days after service of an injunction, a report under oath setting
17 forth in detail the manner and form in which Pull & Bear has complied with the injunction.

18 C. An Order that (1) all point-of-sale materials, labels, signs, boxes, prints,
19 catalogs, line sheets, marketing materials, internet web pages, metatags, packages, papers,
20 other trade dress, and advertisements in the possession or control of Pull & Bear bearing
21 images, illustrations, or representations of the enjoined footwear, Trade Dress,
22 Dr. Martens® name, and undersole patterns, and all plates, molds, matrixes, and other
23 means of making the same, be delivered to AirWair’s counsel or destroyed in accordance
24 with written instructions from AirWair; (2) that Pull & Bear disclose the identities of the
25 vendors, manufacturers, distributors, suppliers, retailers, and e-tailers of the Infringing
26 Footwear, sole molds, and undersole; (3) all footwear bearing any of the Trade Dress
27 features identified in Exhibits 1-5 hereto be delivered to AirWair or destroyed in
28 accordance with written instructions from AirWair; and (4) all internet advertising,

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1 including keywords, adwords, metatags, sponsored ads, links, and other advertising that
2 uses or refers to Dr. Martens, DOCS, DMs, or any version of the Dr. Martens Trade Dress
3 be immediately discontinued and removed from operation or view.

4 D. An accounting for Pull & Bear’s profits arising from Pull & Bear’s unfair
5 competition and trademark infringement and an award of Pull & Bear’s profits to AirWair,
6 including disclosure of the number of pairs of Infringing Footwear sold in the United
7 States and internationally and an accounting for the gross revenue derived from sale of the
8 Infringing Footwear.

9 E. An award of damages sustained by AirWair.

10 F. In the alternative to actual damages and profits, an award of statutory
11 damages in an amount of not more than \$1,000,000 per counterfeit mark per type of
12 services and/or goods sold or offered for sale by Pull & Bear.

13 G. An award of treble the actual damages awarded.

14 H. Pre-judgment and post-judgment interest on the above damage awards.

15 I. An award of costs and reasonable attorney’s fees and expenses incurred by
16 AirWair in connection with this action.

17 J. Such other and further relief which this Court may deem just.

18
19 **DEMAND FOR JURY TRIAL**

20 AirWair hereby demands a trial by jury.

21 Dated: November 20, 2019

BRYAN CAVE LEIGHTON PAISNER LLP

22
23 By: /s/ Alexandra C. Whitworth

24 Marcy J. Bergman
25 Alexandra C. Whitworth
26 Attorneys for Plaintiff
27 AIRWAIR INTERNATIONAL LTD.
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