ESTTA Tracking number: **ESTTA1152668**

Filing date: **08/11/2021**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	92075170
Party	Plaintiff Mast-Jaegermeister US, Inc.
Correspondence Address	KATRIN LEWERTOFF FERDINAND IP, LLC 1221 POST ROAD EAST SUITE 302 WESTPORT, CT 06880 UNITED STATES Primary Email: klewertoff@fiplawgroup.com Secondary Email(s): jferdinand@fiplawgroup.com, amalbin@fiplawgroup.com, lauras@fiplawgroup.com 203-557-4224
Submission	Motion to Suspend for Civil Action
Filer's Name	Katrin Lewertoff
Filer's email	klewertoff@fiplawgroup.com, lauras@fiplawgroup.com
Signature	/KL/
Date	08/11/2021
Attachments	JAG096USL KUHL canc Class 33 Motion to Suspend 08112021.pdf(99772 bytes) JAG096USL NY complaint.pdf(138026 bytes)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Mast-Jaegermeister US, Inc. Petitioner, v. Alfwear Inc., Registrant.	)	**Canc. No.: 92075170**

MAST-JAEGERMEISTER US, INC.'S MOTION TO SUSPEND

Petitioner Mast-Jaegermeister US, Inc. ("Jaegermeister" or "Petitioner") moves for a suspension of the above-listed cancellation proceeding pursuant to Trademark Rule of Practice 2.117(a). See 37 C.F.R. § 2.117(a).

This proceeding, No. 92075170, is currently suspended based on settlement negotiations until today and thus resumes tomorrow, on August 12, 2021.

Petitioner respectfully moves that this proceeding be suspended immediately with respect to all matters not germane to this motion to suspend because the parties have not engaged in substantive discovery or served discovery requests, which will be due by August 20, 2021 (discovery closes on September 21, 2021,) at the latest. In addition, the deadline for expert disclosures is currently set for August 22, 2021.

Petitioner also moves that the time within which such discovery requests must be served should be extended until at least thirty (30) days after the decision of the Board on the motion to suspend, and that all other dates be extended accordingly.

The parties to this proceeding are involved in a civil action, Mast-Jaegermeister US, Inc. v. Alfwear, Inc., et al., Civil Action No. 7:20-CV-00591-VB, which is currently pending in the U.S. District Court for the Southern District of New York, involving the issue of whether Registrant's trademark registrations are invalid. (A copy of Petitioner's Complaint (Dkt. 5 in the civil action) is attached.

The aforementioned civil action is currently stayed pending the outcome of an Appeal to the 10th Circuit, Case No. 21-4029, of the Utah civil action, Alfwear, Inc. v. Mast-Jaegermeister US, Inc., Civil Action No. 2:12-CV-00936-TC-DBP.

These issues are likewise raised by the above-listed Cancellation, and the New York civil action may be dispositive of this proceeding.

Therefore, Petitioner respectfully requests that the Board suspend this Cancellation pending final determination of the New York civil action and notes that the Board, in parallel proceedings, Nos. 92070074 (parent case,) 92071897, 92071907, and 92071953, granted a suspension pending final determination of the civil actions (TTABVUE #22.)

MAST-JAEGERMEISTER US, INC.

Date: August 11, 2021

By: /Katrin Lewertoff/
Katrin Lewertoff
Ferdinand IP, LLC
1221 Post Road East, Suite 302
Westport, Connecticut 06880
Telephone: (203) 557-4224

Counsel for Petitioner

Certificate of Service

I hereby certify that a true and complete copy of the foregoing Motion to Suspend has been served on counsel for Registrant by forwarding said copy on August 11, 2021, via email to: S. Brandon Owen at bowen@rqn.com, Adam K. Richards at arichards@rqn.com, and Trent Baker at trent@bakeriplaw.com.

Signature: /Katrin Lewertoff/ Date: August 11, 2021

UNITED STATES DISTRICT COURT
SOUTHERN DISTRICT OF NEW YORK

MAST-JAEGERMEISTER US, INC. Plaintiff, vs. ALFWEAR, INC.; DOES 1 through 10, inclusive, Defendants.	Case No.: **COMPLAINT FOR DECLARATORY AND INJUNCTIVE RELIEF**

COMES NOW Plaintiff MAST-JAEGERMEISTER US., INC. ("Plaintiff"), and for its Complaint and causes of action against Defendant ALFWEAR, INC. and DOES 1 through 10, inclusive, alleges as follows:

INTRODUCTION

1. Plaintiff brings this complaint under F.R.C.P. Rule 57, 28 U.S.C. section 2201 and 15 U.S.C. section 1064 for declaratory and injunctive relief seeking judgment from this Court declaring that Plaintiff is not liable to Defendants for trademark infringement and that Defendants' trademarks are invalid and unenforceable as against Plaintiff. Defendant, maker and retailer of outdoor clothing that uses in some sense the German word for "cool," "KÜHL," is attempting to stop Plaintiff, the subsidiary of a German company, from further use of the descriptive word KÜHL in connection with advertisements for its popular beverage. Defendants attempt to curb Plaintiff's commercial speech through enforcement of various purported trademarks (employing the word KÜHL) registered in connection with Defendants' clothing, clothing accessories, lip balm, and water bottles, among others.

2. The aforementioned attempt(s) should be enjoined for several reasons. First, Plaintiff does not use "KÜHL" as a trademark, but merely in a descriptive sense to describe how Plaintiff's customers and consumers can enjoy Plaintiff's beverage – at a cool temperature, a textbook example of descriptive fair use. Second, under the Trademark Act of 1946, Sections 14(1) and 2(e)(1), Defendants' purported "KÜHL" trademarks are merely descriptive. Third, under the Trademark Act, Sections 14(1) and 2(e)(1), the "KÜHL" marks are also deceptively misdescriptive. Fourth, under the Trademark Act, Sections 14(1) and (1)(a), (c), and (d), Defendants never used the "KÜHL" marks in commerce before the applications, amendments to allege use, or statements of use were filed. Fifth, under Trademark Act Section 14(3), Defendants have abandoned their "KÜHL" marks. Sixth, under Trademark Act Sections 14(3) and 2(a), the "KÜHL" marks are deceptive.

3. For these and other reasons, Plaintiff respectfully petitions this Court for a declaration that Defendants' purported trademark registrations are invalid and should be cancelled and/or that Plaintiff's use of the word KÜHL is non-infringing.

JURISDICTION & VENUE

4. This action is filed pursuant to the Federal Declaratory Judgment Act, 28 U.S.C. §§ 2201, *et seq*., and Federal Rule of Civil Procedure 57.

5. This Court has subject matter jurisdiction over this action under 15 U.S.C. § 1121 as it concerns the validity of trademarks, under 28 U.S.C. §§ 1331 and 1338(a) as this action arises under an Act of Congress relating to trademarks, the Lanham Act, 15 U.S.C. § 1125(a), (c), and because an actual case or controversy exists between the parties, as is evidenced by the facts and circumstances described herein.

6. Venue is proper in this Court under 28 U.S.C. § 1391(b)(2) because a substantial part of the events giving rise to this claim occurred in this District.

7. An actual controversy exists between the parties within the meaning of 28 U.S.C. § 2202, which is of sufficient immediacy and reality to warrant declaratory relief under 28 U.S.C. § 2201.

8. The Court has personal jurisdiction over Plaintiff and Defendants in this action because the parties have had, and continue to have, substantial, continuous and systematic contacts and business activities in New York and this Judicial District, and have purposefully availed themselves of the privilege of conducting activities in this Judicial District, thereby invoking the benefits and protections of the State of New York, and this Judicial District.

PARTIES

9. Plaintiff is a New York company with its principal place of business at 10 Bank Street, White Plains, New York 10606.

10. Defendant is a Utah company with a principal place of business at 4884 South 300 West Murray, Utah 84107.

11. The identities of Defendants DOES 1 through 10 are presently unknown to Plaintiff, but on information and belief said defendants are liable in whole or part for the matters alleged herein. Plaintiff will seek leave of court to add them by name when their identities are ascertained.

12. On information and belief, each defendant was, at all times herein mentioned and relevant to liability, a servant, agent, and/or employee of each other defendant, and was acting within the course and scope of such agency and/or employment on behalf of and with the

consent, knowledge, and permission of each other, and that each said defendant ratified the conduct of all remaining defendants.

13. This Court has personal jurisdiction over each of the Defendants by virtue of their residence in this judicial district and conducting business in this judicial district, their contacts and transaction of business in this judicial district.

FACTUAL ALLEGATIONS

A. Background of the Companies

14. Plaintiff is, among other things, the domestic distributor of the popular German-made beverage Jägermeister, which means, literally, "Master Hunter."

15. In recent years, Plaintiff has used the German word for "cool," "KÜHL," in certain of its advertising, as Plaintiff's beverage is often served at cool or cold temperatures. More specifically, Plaintiff has advertised certain of its beverages using the phrases, "KÜHL as Ice," and "Drink it ice KÜHL." These phrases do not constitute a designation of origin, and are not used in a trademark sense. Moreover, they do not refer to and are not used in connection with a clothing line, or any other use that may even potentially cause consumer confusion. They instead qualify as fair use under 15 U.S.C. §§ 1115(b)(4), 1125(c)(3).

16. "KÜHL," the German word for "cool," refers to temperature, and is not slang for "cool," such as hip or popular. German speakers use the English word "cool" to express acceptance, approval and admiration, not "KÜHL." Further, the German word "KÜHL" is transliterated into and spelled "kuehl" in English.

17. Defendants are, among other things, manufacturers and retailers of outdoor clothing known to and used by select groups of individuals in specific parts of the United States engaged in certain recreational activities. Though Defendant's company has no apparent

German origin, lineage, background or association, Defendants sell certain of their clothing using the name "KÜHL."

B. Defendants' Trademarks at Issue

18. Defendants purport to be the owners/holders of trademarks registered with the Patent and Trademark Office for the word "KÜHL" for clothing and accessories, though the clothing and accessories have little or nothing to do with a cool or cold temperature, or any association with Germany or the German language. The Registrations are as follows: Registration No. 1990375; Registration No. 3916866; Registration No. 4441177; Registration No. 4576371; Registration No. 4576447; Registration No. 4580723; Registration No. 5931177; Registration No. 5931048; Registration No. 5466394; and Registration No. 4818036. They will be referred to as "the Trademarks."

19. Registration No. 1990375 was registered on July 30, 1996 for "KÜHL" for "rugged outdoor clothing, namely jackets, shirts, pants, shorts, T-shirts and hats" in Class 25" and "bottled spring water" in Class 32.

20. Registration No. 3916866 was registered on February 8, 2011 for KÜHL for "Belts; Bottoms; Hats; Jackets; Pants; Shirts; Shorts; Top" in Class 25.

21. Registration No. 4441177 was registered on November 26, 2013 for "KÜHL" for "lip balm" in Class 3 with a first use and first use in commerce date of January 28, 2013; for "KÜHL" in various clothing items and accessories (belts, bottoms, hats, jackets, pants, shirts, shorts, tops, fabric sold as an integral component of finished clothing, namely belts, bottoms, hats, jackets, pants, shirts, shorts and tops) in Class 25 with a first use and first use in commerce date of February 1, 1994; and for "KÜHL" for bottled water in Class 32 with a first use and first use in commerce date of August 17, 2004.

22. Registration No. 4576371 was registered on July 29, 2014 for "KÜHL" for textile fabrics in Class 24 for the manufacture of clothing with a first use and first use in commerce date of May 27, 2014.

23. Registration No. 4576447 was registered on July 29, 2014 for "KÜHL" for textile fabrics in Class 24 for the manufacture of clothing, with a first use and first use in commerce date of May 27, 2014; and for "KÜHL" on belts, bottoms, hats, jackets, pants, shirts, shorts and tops in Class 25 with a first use and first use in commerce date of August 1, 1996.

24. Registration No. 4580723 was registered on August 5, 2014 for "KÜHL" for "textile fabrics for the manufacture of clothing" in Class 24, with a first use and first use in commerce date of May 27, 2014; and for "KÜHL" for "belts, bottoms, hats, jackets, pants, shirts, shorts and tops" in Class 25, with a first use and first use in commerce date of August 1, 1995.

25. Registration No. 5931177 was registered on December 10, 2019 for "KÜHL" for "water bottles sold empty, empty water bottles for bicycles, plastic water bottles sold empty, reusable plastic water bottles sold empty" in Class 21 with a first use and first use in commerce date of April 30, 2019.

26. Registration No. 5931048 was registered on December 10, 2019 for "coffee" in Class 30 with a first use and first use in commerce date of April 5, 2019.

27. Registration No. 5466394 was registered on May 8, 2018 for "breath mints for use as a breath freshener, mints used to clean teeth, mouth and breath" in Class 3 with a first use and first use in commerce date of October 20, 2017.

28. Registration No. 4818036 was registered on March 24, 2015 for "all-purpose sport bags, carrying bags, backpacks, hiking bags, sack packs, drawstring bags used as backpacks" in Class 18 with a first use and first use in commerce date of December 31, 2003.

C. The Petitions for Cancellation with the Trademark Trial and Appeal Board

29. Four of the above Registrations are the subject of a Petition for Cancellation filed with the Trademark Trial and Appeal Board ("TTAB").

a. A Petition for Cancellation of Registration No. 4441177 was filed on November 25, 2018 and was assigned Cancellation No. 92070074.

b. A Petition for Cancellation of Registration No. 4576371 was filed on July 26, 2019 and was assigned Cancellation No. 92071907.

c. A Petition for Cancellation of Registration No. 4576447 was filed on July 26, 2019 and was assigned Cancellation No. 92071897.

d. And a Petition for Cancellation of Registration No. 4580723 was filed on July 30, 2019 and was assigned Cancellation No. 92071953.

30. On December 4, 2019, the four Cancellation proceedings were consolidated under the parent Cancellation No. 92070074.

31. As a result of the necessity of filing the Cancellation proceedings, Plaintiff has incurred tremendous costs and attorney's fees and will incur further and increasing costs and attorney's fees until such matter is resolved.

D. Defendants' Complaint for Trademark Infringement & Dilution

32. On August 17, 2017, Defendant filed a complaint for trademark infringement and dilution against Plaintiff and Oppermanweiss, LLC in the United States District Court for the District of Utah, Central Division, and the case was assigned Case No. 2:17-cv-00936-PMW. In brief, that complaint alleges that Plaintiff herein infringed Defendants' trademarks and diluted the same by using KÜHL in its advertising for its beverages. Defendants contend that their trademarks, which concern their rugged outdoor clothing and accessories, have been infringed

and their brand has been tarnished because Plaintiff, the subsidiary of a German beverage maker, used a common German word to describe a beverage that is recommended and often consumed at cold temperatures. That case is pending and is set for trial in September of 2020.

33. As a result of Defendants' trademark infringement action, Plaintiff has incurred tremendous costs and attorney's fees and will incur further and increasing costs and attorney's fees until such matter is resolved.

E. Defendants' TTAB Proceedings

34. Defendants have a confirmed history of attempting to prevent other businesses from using the German word at issue, KÜHL, or similar sounding but unrelated words. A quick search of the TTAB's website shows that from 2012 to the present, Defendants have initiated eleven (11) proceedings against market competitors who have attempted to use the word KÜHL or variations on that word in relation to products that have nothing to do with Defendants' rugged outdoor clothing and accessories. http://ttabvue.uspto.gov/ttabvue/v?qt=adv&procstatus=All&pno=&propno=&qs=&propnameop=&propname=KUHL&pop=&pn=Alfwear&pop2=&pn2=&cop=&cn= Such other products include furniture, baby products and toys.

COUNT I

(Declaratory Judgment – Non-Infringement of Trademarks)

35. Plaintiff hereby restates and realleges the allegations set forth in paragraphs 1 through 34 herein.

36. The Declaratory Judgment Act provides in relevant part: "In a case of an actual controversy within its jurisdiction…any court of the United States, upon the filing of an appropriate pleading, may declare the rights and other legal relations of any interested party

seeking such declaration, whether or not further relief is or could be sought." 28 U.S.C. § 2201(a). As set forth herein, an "actual controversy" exists between Plaintiff and Defendants. The disagreement among the parties cannot be resolved without court intervention.

37. As the Seventh Circuit said, "[Plaintiff] cannot appropriate the English language, and by doing so render a competitor inarticulate." *Blau Plumbing, Inc. v. S.O.S. Fix-It, Inc.*, 781 F.2d 604, 609-10 (7th Cir. 1986). That is precisely what Defendants attempt to accomplish through trademarking a common German word and preventing a German company from accurately using the word to accurately advertise its products.

38. Plaintiff and Defendants have been engaged in litigation over Defendants' Trademarks since August of 2017. Defendants allege, incorrectly, that Plaintiff has infringed and diluted, and continues to infringe and dilute, Defendants' Trademarks, specifically Trademark Registration No. 1990375 (outdoor clothing, t-shirts, hats in Class 25 and bottled spring water in Class 32), Registration No. 3916866 (belts, bottoms, hats, jackets, pants, shirts, shorts, tops in Class 25), and Registration No. 4441177 (belts, bottoms, hats, jackets, pants, shirts, shorts, tops in Class 25, lip balm in Class 3, and bottled water in Class 32). Plaintiff has not infringed Defendants' purported trademarks, and Defendants' purported trademarks have not been diluted by any action(s) of Plaintiff.

39. Plaintiff is a well-known distributor of a line of alcoholic beverages, Jägermeister, which are often served cold; it has no association with rugged outdoor clothing, specifically outdoor clothing comprised of t-shirts, hats, jackets, pants, shirts, shorts or tops, or lip balm or bottled water.

40. Plaintiff has used the German word for cool (KÜHL) in advertisements for its beverages, which have nothing to do with rugged outdoor clothing. Plaintiff's advertisements

using the word KÜHL depict only Plaintiff's beverage products, not a rugged outdoor scene, or rugged outdoor clothing, lip balm or bottled water.

41. There is no reasonable likelihood of confusion, mistake or error in the marketplace for persons who are seeking to purchase Defendants' rugged outdoor clothing. There is no reasonable chance an individual who is looking to purchase Jägermeister will purchase Defendants' clothing, or vice versa, from Plaintiff's use of KÜHL in its advertisements. Furthermore, there is no reasonable likelihood a consumer would be confused about the origin of Plaintiff's products or Defendants' products based on Plaintiff's use of KÜHL. And, in any event, Defendants' purported marks are invalid.

42. Plaintiff's product and Defendants' products are entirely distinct in terms of their appearance, use, price and market availability. Moreover, the products are sold in distinctly different retail outlets: Plaintiff's products are sold at beverage and grocery retailers and restaurants; Plaintiff's products are sold at clothing retailers, and there is little chance of cross-over.

43. Plaintiff's products, which are available for purchase only to those of the legal drinking age, are not available to the entire universe of potential purchasers of Defendants' products, for whom there is no age restriction. Further, to access Plaintiff's website to research Plaintiff's products and see the KÜHL advertisements, an internet user must input his or her date of birth. No such restriction exists concerning Defendants' website or products.

44. On information and belief, Plaintiff does not know of a single bona fide instance of customer confusion between Plaintiff's products and Defendants' products arising from Plaintiff's use of the word KÜHL, and such confusion is unlikely.

45. Further, on information and belief, Plaintiff alleges that Defendants' marks are not well known, let alone famous, and Plaintiff's use of KÜHL has no impact on Defendants' marks, and has no likelihood of tarnishing or diluting Defendants' marks or its brand.

46. Additionally, Plaintiff is not using KÜHL as a trademark. A trademark answers the questions "who are you?", "where do you come from?", and "who vouches for you?" McCarthy, Trademarks and Unfair Competition § 12.01 (3d ed. 1992). Plaintiff, the subsidiary of a German company selling a product with a German name, uses a common descriptive German word to advertise and describe its products; not to answer any of the relevant trademark questions. Thus, Plaintiff's use of the word KÜHL does not constitute trademark use.

47. Even if it is a trademark, Plaintiff's use of KÜHL qualifies as descriptive "fair use" under 15 U.S.C. Sections 1115, 1125 because Plaintiff uses the word for its primary descriptive meaning, relating to the cool temperature of Plaintiff's beverage. "A junior user is always entitled to use a descriptive term in good faith in its primary, descriptive sense other than as a trademark.'" *Cairns v. Franklin Mint Co.*, 292 F.3d 1139, 1150-1152 (9th Cir. 2002) (quoting McCarthy on Trademark and Unfair Competition § 11: 45 (4th ed. 2001)).

48. Plaintiff is entitled to a Declaration and Judgment that its use of KÜHL in its advertising does not infringe Defendants' rights in its registered trademarks for its rugged outdoor clothing and accessories.

COUNT II

(Declaratory Judgment – Invalidity of Trademarks)

49. Plaintiff hereby restates and realleges the allegations set forth in paragraphs 1 through 48 above.

50. Plaintiff is entitled to a declaration and judgment that Defendants' trademarks, Registration Nos. 4441177, 4576371, 4576447, 4580723, 1990375, 3916866, 5931177, 5931048, 5466394, and 4818036, are invalid as a matter of law.

51. Upon information and belief, the "KÜHL" marks in Registration Nos. 4441177, 4576371, 4576447, 4580723, 1990375, 3916866, 5931177, 5931048, 5466394, and 4818036 are merely descriptive when used in connection with the registered goods because they merely describe the characteristics, qualities, features, functions, purpose and use of the goods (Trademark Act Sections 14(1) and 2(e)(1)). In other words, the term suggests the goods will make users or consumers feel a cool or cold temperature.

52. Upon information and belief, Defendants' Trademarks are alternatively deceptively mis-descriptive in connection with the registered goods because the registered goods do not have the described characteristic, feature, function, purpose and use (Trademark Act Sections 14(1) and 2(e)(1)). Plainly stated, the registered goods do not make users feel "cool," as the clothing, lip balm, bottled water, textile fabrics, water bottles, coffee, breath mints or bags do not "cool" a user, as the name implies.

53. Upon information and belief, "KÜHL" is deceptive in connection with the registered goods in the Trademarks because the goods do not have the described characteristics or bring about the described results (Trademark Act Section 14(3) and 2(a)). The goods at issue in the Trademarks do not make a purchaser or user feel cool or cold.

54. Upon information and belief, while Defendants' applications to register their marks were filed based on an intent to use the alleged marks in commerce, Defendants did not use the "KÜHL" marks set forth in Registration Nos. 4441177, 4576371, 4576447, 4580723, 1990375, 3916866, 5931177, 5931048, 5466394, and 4818036 in commerce before they filed

trademark applications, amendments to allege use, or statements of use (Trademark Act Sections 14(1) and 1(a), (c) and (d)). More specifically, upon information and belief, Defendants have never used or placed in commerce their KUHL mark on "lip balm" in Class 3, on "fabric sold as integral component of finished clothing…" in Class 25, on "bottled water" in Class 32, on containers, or tags or labels affixed to the registered goods, or on water bottles in Class 21, coffee in Class 30, breath mints in Class 3, or sport bags, carrying bags, backpacks, hiking bags, sack packs, or drawstring bags used as backpacks in Class 18.

55. Upon information and belief, Defendants have never used in commerce their KÜHL mark on "textile fabrics for the manufacture of clothing" in Class 24, or containers, or on tags or labels affixed to the registered goods.

56. Upon information and belief, Defendants did not use their alleged marks on the goods in Classes 24 and 25 prior to filing the use-based applications for Registration Nos. 4576371, 4576447, and 4580723, and Defendants have never had a bona fide intent to use their marks in U.S. commerce for any of the goods listed in the registrations, which renders the Registrations void ab initio.

57. Alternatively, if Defendants ever used the KÜHL marks with Registration Nos. 4441177, 4576371, 4576447 and 4580723, they abandoned the marks (Trademark Act Section 14(3)), and Defendants have no intention to resume use of the alleged KUHL mark in connection with the registered goods in Classes 3, 24, 25 and 32.

58. Upon information and belief, Defendants have not used the alleged KUHL mark for the registered goods in Classes 3, 24, 25 and 32, Registration Nos. 4441177, 4576371, 4576447, and 4580723, for at least three (3) consecutive years.

59. Upon information and belief, Defendants are not using their alleged marks under Registration No. 4441177 (Class 3 and Class 32), Registration No. 4576371 (Class 24), Registration No. 4576447 (Class 24, 25) and Registration No. 4580723 (Class 24) in U.S. commerce for all registered goods and have never used the marks in U.S. commerce for some registered goods.

60. Upon information and belief, Defendants had no bona fide use in commerce of the alleged KÜHL mark when they filed applications for Registration Nos. 4441177, 4576371, 4576447, and 4580723 to register the mark for the goods in classes 3, 24, 25 and 32.

61. Upon information and belief, the Registrations for the alleged KÜHL mark for the goods in Classes 3, 25 and 32 (Registration No. 4441177) and the goods in Class 24 (Registration No. 4576371) are void ab initio.

62. Upon information and belief, Defendants never used the alleged marks in Registration No. 4441177 as trademarks but only in connection with their website address, www.kuhl.com.

63. Upon information and belief, Defendants never submitted a proper specimen for the Class 24 goods, the specimen that was submitted showed there was no use of the alleged mark at the time the statement of use was filed, and the Class 24 goods were not available when the statement of use was filed. As a result, the registration for those goods, Registration No. 4576371, should not have issued.

64. Upon information and belief, Defendants have never used in connection with, or placed their alleged KÜHL mark on "textile fabrics for the manufacture of clothing" in Class 24, or containers, or on tags or labels affixed to the registered goods, or sold or transported any of

the registered goods in commerce as alleged by Defendants in connection with Registration No. 4576371.

65. Upon information and belief, Defendants did not use their alleged marks on the goods in Classes 21, 30, 3 or 18 prior to the filing the applications for Registration Nos. 5931177, 5931048, 5466394 and 4818036, and Defendants have never had a bona fide intent to use their marks in U.S. commerce for any of the goods listed on the registrations, which renders the Registrations void ab initio.

66. Plaintiff is entitled to a declaration and judgment that Defendants' trademarks for KÜHL, Registration Nos. 4441177, 4576371, 4576447, 4580723, 1990375, 3916866, 5931177, 5931048, 5466394, and 4818036, are invalid.

COUNT III

(Injunctive Relief Against Defendants)

67. Plaintiff hereby restates and realleges the allegations set forth in paragraphs 1 through 66 herein.

68. Injunctive relief is necessary and appropriate to prevent Plaintiff from suffering irreparable harm and to prevent Defendants from engaging in further legal harassment of Plaintiff. Absent an injunction, Defendants are likely to continue their baseless litigation war against Plaintiff and other market participants who seek to use KÜHL in their business activities.

69. In the absence of an injunction, Plaintiff will be forced to defend the Utah federal court action and prosecute the above-described cancellation proceedings before the TTAB, as a result of which Plaintiff will incur tremendous attorney's fees and costs, and interruption to and frustration of its business operations. In the Utah trademark infringement action, in which Defendants seeks $400 million in damages, Plaintiff is facing a September 2020 trial date, a fast-

approaching actual and imminent injury should Defendants prevail therein. Thus, an award of monetary damages herein is plainly insufficient to foreclose the harm to Plaintiff by Defendants' conduct described herein.

70. Enjoining Defendants from further "enforcement" of their "trademarks" is in the public interest because an injunction will prevent further harm to other market participants who attempt to use a merely descriptive word to conduct and advertise their businesses. As demonstrated by the online search of the TTAB's website, Defendants have actively sought to prevent other market participants from using unrelated offshoots of KÜHL in their business, which conduct constitutes bad faith market manipulation. Only an injunction prevents further abuse of the TTAB system.

PRAYER FOR RELIEF

WHEREFORE, Plaintiff respectfully requests the Court enter judgment in its favor and against Defendants, and award the following relief:

1. Declare that Plaintiff has not, and is not, infringing any valid and enforceable Trademark held by Defendants and is thus not liable to Defendants for any such trademark infringement and/or dilution;

2. Declare that Defendants' Trademarks are invalid and are void as against Plaintiff;

3. Declare that Plaintiff has not acted willfully in violation of any provision of the Trademark Act or other laws;

4. Declare that Defendants are not entitled to any compensation or damages from Plaintiff from any alleged infringement and/or dilution of Defendants' trademarks;

5. Declare that Defendants, its officers, agents, servants, employees and attorneys, are preliminarily and permanently enjoined from taking any legal action against Plaintiff to enforce Defendants' Trademarks for goods utilizing the "KÜHL" mark;

6. Award Plaintiff its costs, expenses and reasonable attorney's fees in this action pursuant to 15 U.S.C. section 1117(a);

7. Grant Plaintiff such other relief as this Court may deem just and proper.

Dated: January 22, 2020

Respectfully Submitted,

GORDON REES SCULLY
MANSUKHANI, LLP

By:

/s/ Craig J. Mariam

Craig J. Mariam (NY Bar No. 4738084)
cmariam@grsm.com
Ronald Giller (NY Bar No. 2816072)
rgiller@grsm.com
Gordon Rees Scully Mansukhani LLP
1 Battery Park Plaza, 28th Floor
New York, NY 10004
Telephone: 212-269-5500
Facsimile: 212-269-5505
Attorneys for Plaintiff
MAST-JAEGERMEISTER US, INC.