



officially launched in the U.S. by Barbour Inc., a subsidiary of J. Barbour & Sons Ltd. Since that time, Barbour Inc. has established multiple Barbour retail locations in major east coast markets such as Boston, New York, Philadelphia, and Washington, D.C. Barbour Inc. has also developed extensive retail partnerships for Barbour-branded products with high-end fashion retailers such as Neiman Marcus, Bloomingdales, and Nordstrom.

2. For many years, Barbour Inc. has advertised and sold apparel products in the U.S. featuring the “Barbour flag,” a piece of fabric bearing the “Barbour” name and typically affixed to the seam of the pocket of the garment. Some examples of such products include the following two shirts, which Barbour featured in its 2017 Autumn/Winter Shirt Department Lookbook:



Barbour's Summer 2002 catalogue shows a similar Barbour flag:



Additional examples can be seen in the excerpts from Barbour Inc.'s catalogues from 2001 to 2018, attached as **Exhibits A-Z**. These garments—and many others like them—not only have the name “Barbour” prominently emblazoned on the Barbour flag, but the “Barbour” name and associated branding is also displayed on the inside of the garments and on other point-of-sale material such as hangtags and placards. No reasonable and prudent consumer would ever mistakenly believe that these Barbour-branded products are somehow connected with, affiliated with, or sponsored by Levi Strauss & Co., the San Francisco-based purveyor of denim jeans. In fact, to Plaintiffs’ knowledge, in all of the years that Barbour-branded products have been sold in the U.S.—or anywhere in the world, for that matter—there has never been a *single instance* where a consumer or potential consumer has expressed any such confusion between Barbour products and those offered by Levi Strauss & Co.

3. Inexplicably, then, on May 22, 2018, Levi Strauss & Co. sent a cease and desist letter to J. Barbour & Sons Ltd. that: (a) alleged that all garments with the Barbour flag were “infringing products;” (b) insisted the immediate cessation—on a worldwide basis—of sales of garments bearing the Barbour flag; and (c) demanded information regarding sales volume and the number of infringing units remaining in inventory. Levi Strauss & Co.’s letter gave J. Barbour & Sons Ltd. ten days to comply with its demands. The demand letter is a classic example of severe overreaching by a company that has the dubious distinction of being one of the world’s biggest

trademark “bullies.” Levi Strauss & Co.’s factual allegations and legal assertions are baseless and hopelessly flawed. In light of Levi Strauss & Co.’s demand letter—not to mention its well-documented history of suing hundreds of companies and individuals in numerous federal district courts across the land—there is a substantial controversy between the parties that have adverse legal interests. This controversy is of sufficient immediacy and reality to warrant the issuance of a declaratory judgment by this Court. Consequently, among other things, Plaintiffs seek a declaration from this Court that use of the Barbour flag on its clothing products and related items are not infringing, unfairly competing with, diluting, or otherwise violating any legitimate trademark rights owned or possessed by Levi Strauss & Co.

#### **NATURE OF THE ACTION**

4. This is an action, pursuant to the Declaratory Judgment Act (28 U.S.C. § 2201 *et seq.*) and Fed. R. Civ. P. 57, for a declaratory judgment that J. Barbour & Sons Ltd. (“Barbour & Sons”) does not sell any articles in United States commerce, or in any commerce which may lawfully be regulated by Congress, and therefore is not liable under the Lanham Act (15 U.S.C. §1051, *et seq.*) or any state law. Even if Barbour & Sons has engaged in commercial activity that can be regulated by Congress, it certainly has not infringed, unfairly competed with, diluted or interfered with, and does not infringe, unfairly compete with, dilute or interfere with, any valid trademark of Levi Strauss & Co. (“LS&CO.”).

5. Further, this action, pursuant to the Declaratory Judgment Act (28 U.S.C. § 2201 *et seq.*) and Fed. R. Civ. P. 57, seeks a declaratory judgment that Barbour Inc. (“Barbour Inc.”) has not infringed, unfairly competed with, diluted or interfered with, and does not infringe, unfairly compete with, dilute or interfere with, any valid trademark of LS&CO.

6. This case arises out of LS&CO.’s unfounded claims set forth in a cease and desist letter (“C&D Letter”) sent from LS&CO. to Barbour & Sons at Barbour Inc.’s U.S. address on May 22, 2018. The C&D Letter accused Barbour & Sons of infringing and diluting various LS&CO. trademarks, including the following registered with the U.S. Patent & Trademark Office

(“USPTO”): U.S. Trademark Registration No. 2,726,253 for its Shirt Tab Trademark, as well as a number of registrations for its Tab Device Trademark, including Registration No. 516,561; Registration No. 1,157,769; Registration No. 2,791,156; Registration No. 356,701; Registration No. 577,490; Registration No. 774,625; Registration No. 775,412 (collectively “LS&CO.’s Tab Marks”).

7. As set forth herein, Barbour & Sons denies it has engaged in any U.S. commerce, including any commerce that may lawfully be regulated by Congress, or that it is subject to liability under any law of the United States, including but not limited to the Lanham Act or any state law. Likewise, Barbour Inc., the U.S. Company that advertises and sells the accused products in this Judicial District, denies all allegations by LS&CO.

#### **THE PARTIES**

8. Barbour & Sons is a United Kingdom company headquartered at Simonside, South Shields, NE34 9PD, United Kingdom. It is not registered to do business in the State of New York and does not maintain offices in this Judicial District.

9. Barbour Inc. is a Delaware corporation with its principal place of business at 55 Meadowbrook Drive Milford, New Hampshire 03055-4613. Barbour Inc. is registered to do business as a foreign corporation with the New York Department of State. Barbour Inc. maintains a brick and mortar store in the State of New York, at 123 Wooster Street, New York 10012. It also maintains in this Judicial District a showroom from which Barbour-branded products are advertised, displayed, and sold.

10. Upon information and belief, LS&CO. is a Delaware corporation with its principal place of business at Levi’s Plaza, 1155 Battery Street, San Francisco, California 94111. LS&CO. is registered to do business as a foreign corporation with the New York Department of State.

#### **JURISDICTION AND VENUE**

11. This action arises under the federal trademark statute (the “Lanham Act”), 15 U.S.C. §1051, *et seq.*

12. This Court has jurisdiction over the subject matter of this action under 15 U.S.C. § 1119 and 1121 (the Lanham Act), and 28 U.S.C. §§ 2201 and 2202 (the Declaratory Judgment Act). Further, this Court has jurisdiction over the subject matter of this action under 28 U.S.C. §§ 1331, 1338, and 1367.

13. This Court has personal jurisdiction over LS&CO., as LS&CO. engages in substantial, continuous, and systematic business activities in the State of New York by, among other things, maintaining and selling goods bearing the trademarks at issue in at least twelve LS&CO. retail locations in the State, including at least six in this Judicial District alone. Upon information and belief, LS&CO. has purposely directed substantial activities at the residents of the State of New York by means of LS&CO.'s e-commerce promotion and sales via its online retailer, www.levi.com, and derives substantial revenue from interstate commerce emanating from this State. Upon information and belief, LS&CO. also engages in substantial, continuous, and systematic business activity in this Judicial District by selling its goods through third party retailers located in this Judicial District, such as J.C. Penney Manhattan Mall and Kohl's Yonkers. Upon information and belief, LS&CO. has also purposely directed substantial activities at the residents of the State of New York and in this Judicial District through extensive advertising campaigns, including advertising LEVI'S® branded products via billboard in Times Square in New York, NY. By virtue of these actions, LS&CO. has purposefully availed itself of the privilege of conducting business in this State and in this Judicial District and is subject to jurisdiction.

14. Venue is proper in this Judicial District pursuant to 28 U.S.C. § 1391(b)(2)-(3) because LS&CO. does business in this Judicial District and/or because a substantial part of the events giving rise to the causes of action alleged herein, including substantial sales of Barbour-flagged products, occurred in this Judicial District, and the injury Plaintiffs would suffer from having to cease sales of Barbour-flagged products would be felt in this Judicial District. Moreover, LS&CO. conducts continuous business throughout the State of New York, including in this Judicial District.

**FACTS SUPPORTING CLAIMS FOR DECLARATORY RELIEF**

**I. The History of the Barbour Brand**

15. Barbour & Sons was founded over 120 years ago in the Market Place in South Shields, United Kingdom. Today the 5th generation, family-owned business operates out of Simonside, South Shields, United Kingdom. Since its beginning, Barbour & Sons has produced clothes perfectly suited to enjoyment of life beyond the city. It is this commitment to quality and durability that has seen the name “Barbour” become synonymous with the best of country living. Although it sources products from around the globe, Barbour & Sons’ classic wax jackets are still manufactured by hand in the factory in Simonside, and each year over 100,000 jackets are processed via the central, subsidiary, and local customer service operations. The heritage and lifestyle clothing brand produces clothing that is designed for a full lifestyle wardrobe. As well as jackets and coats, the Barbour-branded wardrobe includes trousers, shirts, socks, knitwear, and a range of accessories. In all areas in which it operates, Barbour & Sons remains committed to its core values as a family business that espouses the unique ethos of the British Countryside and brings the qualities of wit, grit and glamour to its beautifully functional clothing.

16. Barbour & Sons does not itself conduct business in the United States. Although Barbour & Sons maintains a non-transactional U.S. facing website, <https://www.barbour.com/us>, all authorized sales and distribution of Barbour-branded products in the United States is conducted by Barbour Inc. and its authorized retailers.

17. Barbour Inc. was founded in 1987, as Barbour & Sons’ wholly-owned North American subsidiary. Barbour Inc.’s line of business includes the wholesale distribution and retail sale of men’s, women’s, children’s, and infants’ clothing and accessories under the Barbour brand in North America. Barbour Inc. has established nine “Barbour Own” retail locations in major east coast markets such as Boston, New York, Philadelphia, and Washington, D.C., as well as Chicago, Princeton, and New Haven. Barbour Inc. has also developed extensive retail partnerships for Barbour-branded products with high-end fashion retailers such as Neiman Marcus, Bloomingdales, and Nordstrom.

18. Barbour Inc. began distributing and selling primarily Barbour-branded outerwear in 1987. In 2000, Barbour Inc. expanded its product line to include Barbour-branded shirts. Today, Barbour Inc. is in the business of distributing and selling apparel and accessories, including t-shirts, button down shirts, and denim jeans, as illustrated in **Exhibits A-Z**. Some of those shirt and jean styles feature, respectively, a Barbour flag fixed to the chest pocket or rear pocket bearing the “Barbour” name.

19. Barbour Inc. has been continuously selling Barbour-flagged apparel products in the United States for at least 18 years. Examples of just some use of the Barbour flag on Barbour-branded apparel products have been set forth above and also include:



20. In addition to the Barbour flag, Barbour branded apparel products display the Barbour name on labels and tags on the inside of garments, on hang tags, and on additional point-of-sale materials and displays:



## II. Levi Strauss & Co. and the Current Controversy

21. LS&CO. is one of the most litigious apparel companies in the United States, if not the world. It has a well-deserved reputation as a trademark “bully,” having filed more than 300 trademark lawsuits since 1989.<sup>1</sup> It is infamous for suing companies over the “pocket tab,” the “arcuate” stitching, and the leather patch, in which it claims to own rights.

22. LS&CO. alleges that it is the owner of several Tab Marks, including U.S. Trademark Registration No. 2,726,253 for its Shirt Tab Trademark, as well as a number of registrations for its Tab Device Trademark, including U.S. Trademark Registration No. 516,561; U.S. Trademark Registration No. 1,157,769; U.S. Trademark Registration No. 2,791,156; U.S. Trademark Registration No. 356,701; U.S. Trademark Registration No. 577,490; U.S. Trademark Registration No. 774,625; U.S. Trademark Registration No. 775,412.

23. Examples of LS&CO.’s use of its Tab Mark on LEVI’S® jeans and pants include:



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<sup>1</sup> See, e.g., Leah Chan Grinvald, *Shaming Trademark Bullies*, 2011 WIS. L. REV. 625, 670 citing Michael Barbaro & Julie Creswell, *With a Trademark in Its Pocket, Levi's Turns to Suing Its Rivals*, N.Y. TIMES, Jan. 29, 2007, at A1; Bill Donahue, *Levi's Has Filed Trademark Suits Against Just About Everyone*, Law360 (April 12, 2018) <https://www.law360.com/articles/1032904/levi-s-has-filed-trademark-suits-against-just-about-everyone> (“The list of targets is so vast that it might be easier to name the apparel companies that haven’t been sued by Levi’s.”).



24. An example of LS&CO.'s use of its Tab Mark on LEVI'S® shirts include:



25. On or about May 22, 2018, LS&CO., through its attorneys Kilpatrick Townsend & Stockton LLP, sent a letter to Barbour Inc.'s New Hampshire location addressed to Barbour & Sons. The C&D letter demands, among other things, that Barbour & Sons immediately cease and desist, on a worldwide basis, from any use of the Barbour flags referenced in the C&D Letter. A true and correct copy of the C&D Letter is attached hereto as **Exhibit AA**.

26. The C&D Letter contends that Barbour & Sons' use of the Barbour flag on shirts and jeans "will create a substantial likelihood of confusion as to the source of these products and/or the relationship between Barbour and LS&CO." The C&D letter threatens that "such likely confusion may give rise to claims for trademark infringement and dilution that would entitle LS&CO. to injunctive relief and monetary damages against Barbour."

27. The C&D indicated LS&CO.'s intention to seek legal relief unless "Barbour immediately cease and desist, on a worldwide basis, from any use of the pocket tabs," and "withdraw all infringing products from sales and distribution channels, and provide binding written assurances that it will have no future involvement in the manufacture, distribution, or sale of products that infringe LS&CO.'s Tab Trademarks," as well as "provide information about the volume of Barbour's sales of products bearing the tab devices worldwide, as well as the number of units remaining in inventory."

### **III. LS&CO.'s Claims are Baseless**

28. LS&CO.'s claims that Barbour-branded products bearing the Barbour flag infringe the LS&CO. Tab Marks are entirely baseless. The following are just some of the reasons why:

#### **A. The Ubiquitous Use of Tabs in the Apparel Industry**

29. Contrary to its claims in the C&D Letter, LS&CO.'s Tab Marks do not appear to be strong, "famous," or "well-known to consumers as an indicator of the LEVI'S® brand." In fact, the marketplace is awash with apparel and related accessories featuring a "tab" or "tab-like" fabric affixed to the seam of a pocket or in that same general vicinity. For example, the below images show apparel products sold by more than a dozen brands featuring a tab or tab-like fabric affixed to the seam of a chest pocket:

PRODUCT	DESIGN	MANUFACTURER
	<p>Men's Woven Shirt</p>	<p>Faconnable (Nice, France)</p>
	<p>Howl Woven Shirt</p>	<p>Brixton (Oceanside, CA)</p>
	<p>Women's Industrial Short Sleeve Color Block Shirt - Dark Navy/Smoke</p>	<p>Dickies (Ft. Worth, TX)</p>

	<p>Indigo Striped Short-Sleeve Sport Shirt</p>	<p>Sol Angeles (Los Angeles, CA)</p>
	<p>Long Sleeve Pocket Tee – Black/Buffalo</p>	<p>Ball and Buck (Boston, MA)</p>
	<p>Dorian Woven Shirt</p>	<p>Obey (Irvine, CA)</p>

	<p>Plaid Flannel Shirt</p>	<p>H&amp;M (Stockholm, Sweden)</p>
	<p>Shirt with Skull Graphic</p>	<p>Riccardi Boston [Boston, MA)</p>
	<p>Pocket Tee</p>	<p>Ripndip (Los Angeles, CA)</p>

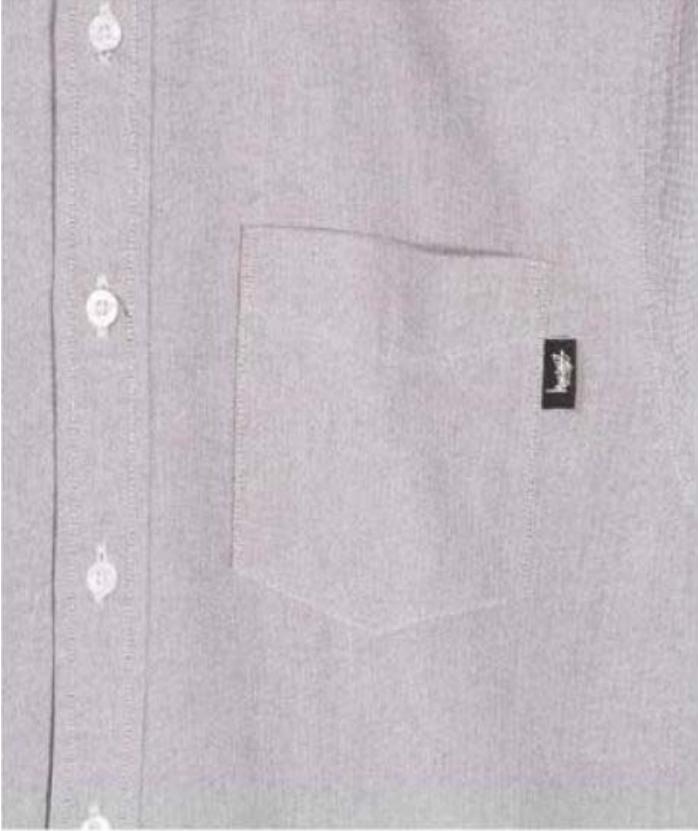
	<p>Jaded Woven Shirt</p>	<p>RVCA (Costa Mesa, CA)</p>
	<p>Scout Shirt with Pocket - Boulder</p>	<p>Buck and Boulder (Boston, MA)</p>

	<p>Gillis Woven Shirt</p>	<p>Vans (Costa Mesa, CA)</p>
	<p>Bleeker Woven Shirt</p>	<p>Volcom (Costa Mesa, CA)</p>

	<p>Micro Diamond Print Sport Shirt</p>	<p>Ben Sherman</p>
	<p>Long Sleeve Polka Dot Print Shirt</p>	<p>Ben Sherman</p>

	<p>Long Sleeve Core Gingham Shirt</p>	<p>Ben Sherman</p>
	<p>Dark Navy Denim Button Down Shirt</p>	<p>Paul Smith</p>

 A close-up photograph of a dark navy blue denim button-down shirt. The shirt is laid flat, showing the collar, a buttoned placket, and a folded cuff. The buttons are light-colored with a dark cross pattern. A small, dark rectangular label is visible on the inside of the collar.	<p>Dark Navy Denim Button Down Shirt</p>	<p>Paul Smith</p>
 A close-up photograph of a red and blue checkered shirt. The shirt is laid flat, showing the collar, a buttoned placket, and a folded cuff. The buttons are dark-colored. A small, dark rectangular label is visible on the inside of the collar.	<p>Red Check Shirt with Contrasting Back</p>	<p>Paul Smith</p>

	<p>Frank Oxford Long-Sleeve Shirt</p>	<p>Stussy</p>
	<p>Frank Oxford Long-Sleeve Shirt</p>	<p>Stussy</p>

	<p>Bold Stripe Jersey</p>	<p>Stussy</p>
	<p>Bold Stripe Jersey</p>	<p>Stussy</p>

	<p>Fort Short Sleeve Chambray Shirt</p>	<p>Carhartt</p>
	<p>Foreman Solid Short Sleeve Work Shirt</p>	<p>Carhartt</p>

	<p>Sandstone Twill Shirt</p>	<p>Carhartt</p>
	<p>Ironwood Denim Work Shirt</p>	<p>Carhartt</p>

30. Additional examples of apparel products and related accessories featuring a tab or tab-like fabric similar to LS&CO.'s Tab Marks are attached as **Exhibit BB**. LS&CO.'s tabs quite clearly exist in a crowded marketplace. As another Court in this Circuit has aptly noted previously, "in a crowded field of similar marks, each member of the crowd is relatively weak in its ability to prevent use by others in the crowd." *Mrs. U.S. Nat'l Pageant, Inc. v. Miss U.S.A. Org., LLC*, 875 F. Supp. 2d 211, 227 (W.D.N.Y. 2012). This statement applies with powerful force to LS&CO.'s claims here.

**B. There are Significant Differences between the Barbour Flag and LS&CO.'s Tabs**

31. The parties' respective flags and tabs are plainly different. For example, because the Barbour flags indicate on their face that they come from Barbour, it is hard to conjure up a situation where consumers would be "confused" or "deceived" into thinking the Barbour flags in any way relate to LS&CO. Moreover, the commercial impression of the Barbour flags versus the LS&CO. tabs is different. On information and belief, LS&CO. appears to primarily use a red tab that is located on the inside seam of the pocket,  $\frac{1}{4}$  of the way down on the pocket on its shirts and pants. The LS&CO. tab has the name "Levi's" written vertically, from top to bottom. In contrast, the Barbour flag is either blue or white, and the placement appears at or very near the top of the pocket, on the inside seam of the pocket on shirts and the outside seam of the pocket on pants. The Barbour flag has the name "Barbour" written facing the seam.

**C. The Parties' Primary Marketing Channels Are Drastically Different**

32. Barbour Inc. conducts the overwhelming majority of its U.S. sales of Barbour-flagged apparel products at its select brick and mortar locations, as well as high-end retailers such as Neiman Marcus, Bloomingdales, Nordstrom, and various specialized clothing and sporting boutiques.

33. Upon information and belief, LS&CO. primarily sells its tabbed apparel products bearing the LS&CO. Tab Mark through its own website and brick and mortar locations, as well as discount retailers such as Walmart, Target, J.C. Penney, Sears, and outlet malls.

**D. Consumers Do Not Confuse the Barbour Flag with LS&CO. Tabs**

34. Barbour Inc. has been selling Barbour-branded products in its independent U.S. stores and through high-end U.S. retailers for at least 18 years. Neither Barbour Inc. nor Barbour & Sons is aware of a single instance of any consumers, vendors, or other third parties expressing confusion or deception between Barbour-flagged products and LS&CO.'s apparel products bearing the LS&CO. Tab Marks. It is well-established in this Circuit and this Judicial District that when there is no actual confusion after a substantial period of co-existence in the market-place, that is a "strong indicator that likelihood of confusion is minimal." *LVL XIII Brands, Inc. v. Louis Vuitton Malletier S.A.*, 209 F. Supp. 3d 612, 684 (S.D.N.Y. 2016), citing *Plus Prods. v. Plus Discount Foods, Inc.*, 722 F.2d 999, 1006 (2d Cir. 1983).

**CLAIMS FOR RELIEF**

**COUNT I**

**(Declaration of no Commercial Activity by Barbour & Sons in the U.S.)**

35. Paragraphs 1-34 are incorporated by reference as if fully restated herein.

36. Barbour & Sons was founded over 120 years ago in the Market Place in South Shields, United Kingdom. Today the family-owned business is headquartered in Simonside, South Shields, United Kingdom. Barbour & Sons does not itself conduct business in the United States—Barbour & Sons does not sell any articles in United States commerce, or in any commerce which may lawfully be regulated by Congress. Commercial endeavors pertaining to Barbour-branded products in the United States are conducted by Barbour Inc., Barbour & Sons' wholly-owned North American subsidiary.

37. In correspondence with Barbour & Sons through its counsel, LS&CO. has alleged that Barbour & Sons' actions may lead LS&CO. to file claims for trademark infringement and dilution and to seek injunctive relief and monetary damages under the United States trademark laws, including the Lanham Act (15 U.S.C. §1051, *et seq.*), and U.S. state law.

38. Barbour & Sons denies that its actions infringe, dilute, or in any way violate LS&CO.'s alleged trademark rights or other legal rights and denies that LS&CO. is entitled to any

injunctive relief or monetary damages against Barbour & Sons under the Lanham Act, or any other laws of the United States.

39. There is an actual and substantial controversy between Barbour & Sons and LS&CO., which have adverse legal interests. To resolve the legal and factual questions raised by LS&CO., and to afford relief from the uncertainty and controversy that LS&CO.'s assertions have precipitated, Barbour & Sons is entitled to a declaratory judgment of its rights under 28 U.S.C. §§ 2201-02.

40. Barbour & Sons therefore seeks a declaratory judgment that it is not liable for any claim under the Lanham Act (15 U.S.C. §1051, *et seq.*) or U.S. state law with regard to Barbour-flagged products, because Barbour & Sons does not use the Barbour flag in U.S. commerce.

## COUNT II

### **(Declaration of no Trademark Infringement by Barbour & Sons)**

41. Paragraphs 1-40 are incorporated by reference as if fully restated herein.

42. In correspondence with Barbour & Sons through its counsel, LS&CO. has alleged that Barbour & Sons' use of the Barbour flag on shirts and pants infringes rights in LS&CO.'s Tab Marks, including U.S. Trademark Registration No. 2,726,253 for its Shirt Tab Trademark, as well as a number of registrations for its Tab Device Trademark, including U.S. Trademark Registration No. 516,561; U.S. Trademark Registration No. 1,157,769; U.S. Trademark Registration No. 2,791,156; U.S. Trademark Registration No. 356,701; U.S. Trademark Registration No. 577,490; U.S. Trademark Registration No. 774,625; U.S. Trademark Registration No. 775,412, or any other trademark belonging to LS&CO.

43. To the extent this Court finds that Barbour & Sons is engaging in commerce that is subject to regulation under the Lanham Act, Barbour & Sons denies that any such commercial use of the Barbour flag on shirts, pants, or any other item infringes LS&CO.'s alleged rights in LS&CO.'s Tab Marks.

44. Any such use by Barbour & Sons of the Barbour flag on shirts, pants, or any other item is not confusingly similar to LS&CO.'s Tab Marks. Barbour & Sons' use of the Barbour flag

on shirts, pants, or any other item will not mislead customers into believing that its goods originate with or are otherwise authorized by LS&CO.

45. LS&CO.'s assertion that Barbour & Sons' use of the Barbour flag on shirts and pants is violating LS&CO.'s legal rights irreparably injures Barbour & Sons and adversely affects its business and the large investment it has made in its brand and products. These assertions will continue to adversely affect Barbour & Sons' business unless prevented by the Court.

46. There is an actual and substantial controversy between Barbour & Sons and LS&CO., which have adverse legal interests. LS&CO. has made clear that it believes Barbour & Sons' use of the Barbour flag infringes LS&CO.'s Tab Marks and that it will seek legal relief for the alleged infringement. Barbour & Sons denies any wrongdoing. The dispute between Barbour & Sons and LS&CO. is therefore substantial, definite and immediate, and not hypothetical.

47. To resolve the legal and factual questions raised by LS&CO., and to afford relief from the uncertainty and controversy that LS&CO.'s assertions have precipitated, Barbour & Sons is entitled to a declaratory judgment of its rights under 28 U.S.C. §§ 2201-02.

48. To the extent this Court finds that Barbour & Sons is engaging in commerce that is subject to regulation under the Lanham Act, Barbour & Sons requests a judgment declaring that its use of the Barbour flag on shirts, pants, and any other item is not likely to cause confusion with LS&CO.'s Tab Mark, and that Barbour & Sons has not engaged in trademark infringement, counterfeiting and/or false designation of origin in violation of Sections 32, 42, and 43(a) of the Lanham Act (15 U.S.C. §§ 1114, 1124 and 1125(a)), or any U.S. state law. LS&CO. is not entitled to injunctive relief or to any monetary remedies set forth in Section 35 of the Lanham Act, 15 U.S.C. § 1117, including but not limited to profits, damages, costs, or attorneys' fees, for trademark infringement based on Barbour & Sons' use of the Barbour flag on shirts, pants, or any other item.

### **COUNT III**

#### **(Declaration of no Unfair Competition by Barbour & Sons)**

49. Paragraphs 1-48 are incorporated by reference as if fully restated herein.

50. In correspondence with Barbour & Sons through its counsel, LS&CO. has alleged that Barbour & Sons has engaged in unfair competition with respect to LS&CO.'s Tab Marks, including U.S. Trademark Registration No. 2,726,253 for its Shirt Tab Trademark, as well as a number of registrations for its Tab Device Trademark, including U.S. Trademark Registration No. 516,561; U.S. Trademark Registration No. 1,157,769; U.S. Trademark Registration No. 2,791,156; U.S. Trademark Registration No. 356,701; U.S. Trademark Registration No. 577,490; U.S. Trademark Registration No. 774,625; U.S. Trademark Registration No. 775,412, or any other trademark belonging to LS&CO.

51. To the extent this Court finds that Barbour & Sons is engaging in commerce in the United States, Barbour & Sons denies that any such commercial use, including by using the Barbour flag on shirts, pants, or any other item, constitutes unfair competition with respect to LS&CO.'s alleged rights in LS&CO.'s Tab Marks.

52. Barbour & Sons' use of the Barbour flag on shirts, pants, or any other item is not confusingly similar to LS&CO.'s Tab Marks. Barbour & Sons' use of the Barbour flag on shirts, pants, or any other item will not mislead customers into believing that its goods originate with or are authorized by LS&CO.

53. LS&CO.'s assertion that Barbour & Sons' use of the Barbour flag on shirts and pants is violating LS&CO.'s legal rights irreparably injures Barbour & Sons and adversely affects its business and the large investment it has made in its brand and products. These assertions will continue to adversely affect Barbour & Sons' business unless prevented by the Court.

54. There is an actual and substantial controversy between Barbour & Sons and LS&CO., which have adverse legal interests. LS&CO. has made clear that it believes Barbour & Sons' use of the Barbour flag constitutes unfair competition with respect to LS&CO.'s Tab Marks and that it will seek legal relief for the alleged unfair competition. Barbour & Sons denies any wrongdoing. The dispute between Barbour & Sons and LS&CO. is therefore substantial, definite and immediate, and not hypothetical.

55. To resolve the legal and factual questions raised by LS&CO., and to afford relief from the uncertainty and controversy that LS&CO.'s assertions have precipitated, Barbour & Sons is entitled to a declaratory judgment of its rights under 28 U.S.C. §§ 2201-02.

56. To the extent this Court finds that Barbour & Sons is engaging in commerce in the United States, Barbour & Sons requests a judgment declaring that its use of the Barbour flag on shirts, pants, and any other item is not likely to cause confusion with LS&CO.'s Tab Marks, and that Barbour & Sons has not engaged in unfair competition by using the Barbour flag on shirts, pants, or any other item. LS&CO. is not entitled to injunctive relief or to any monetary remedies, including but not limited to profits, damages, costs, or attorneys' fees, for unfair competition based on Barbour & Sons' use of the Barbour flag on shirts, pants, or any other item.

#### **COUNT IV**

##### **(Declaration of no Dilution by Barbour & Sons)**

57. Paragraphs 1-56 are incorporated by reference as if fully restated herein.

58. In correspondence with Barbour & Sons through its counsel, LS&CO. has alleged that Barbour & Sons' use of the Barbour flag on shirts and pants dilutes LS&CO.'s Tab Marks, including U.S. Trademark Registration No. 2,726,253 for its Shirt Tab Trademark, as well as a number of registrations for its Tab Device Trademark, including U.S. Trademark Registration No. 516,561; U.S. Trademark Registration No. 1,157,769; U.S. Trademark Registration No. 2,791,156; U.S. Trademark Registration No. 356,701; U.S. Trademark Registration No. 577,490; U.S. Trademark Registration No. 774,625; U.S. Trademark Registration No. 775,412, or any other trademark belonging to LS&CO.

59. The LS&CO. Tab Marks are not famous.

60. To the extent this Court finds that Barbour & Sons is engaging in commerce that is subject to regulation under the Lanham Act, Barbour & Sons denies that any such commercial use of the Barbour flag on shirts, pants, or any other item constitutes dilution of LS&CO.'s Tab Marks.

61. Any such use by Barbour & Sons of the Barbour flag on shirts, pants, or any other item does not blur the connection in consumers' minds between the LS&CO.'s Tab Marks and

LS&CO. products. Barbour & Sons' use of the Barbour flag on shirts, pants, or any other item will not tarnish the LS&CO. Tab Marks.

62. LS&CO.'s assertion that Barbour & Sons' use of the Barbour flag on shirts and pants is violating LS&CO.'s legal rights irreparably injures Barbour & Sons and adversely affects its business and the large investment it has made in its brand and products. These assertions will continue to adversely affect Barbour & Sons' business unless prevented by the Court.

63. There is an actual and substantial controversy between Barbour & Sons and LS&CO., which have adverse legal interests. LS&CO. has made clear that it believes Barbour & Sons' use of the Barbour flag dilutes LS&CO.'s Tab Marks and that it will seek legal relief for the alleged dilution. Barbour & Sons denies any wrongdoing. The dispute between Barbour & Sons and LS&CO. is therefore substantial, definite and immediate, and not hypothetical.

64. To resolve the legal and factual questions raised by LS&CO., and to afford relief from the uncertainty and controversy that LS&CO.'s assertions have precipitated, Barbour & Sons is entitled to a declaratory judgment of its rights under 28 U.S.C. §§ 2201-02.

65. To the extent this Court finds that Barbour & Sons is engaging in commerce that is subject to regulation under the Lanham Act, Barbour & Sons requests a judgment declaring that its use of the Barbour flag on shirts, pants, and any other item does not dilute LS&CO.'s Tab Marks, and that Barbour & Sons has not engaged in illegal trademark dilution in violation of Section 43(a) of the Lanham Act, 15 U.S.C. § 1125(c). LS&CO. is not entitled to injunctive relief or to any monetary remedies set forth in Section 35 of the Lanham Act, 15 U.S.C. § 1117, including but not limited to profits, damages, costs, or attorneys' fees, for trademark infringement based on Barbour & Sons' use of the Barbour flag on shirts, pants, or any other item.

#### **COUNT V**

##### **(Declaration of no Trademark Infringement by Barbour Inc.)**

66. Paragraphs 1-65 are incorporated by reference as if fully restated herein.

67. In correspondence with Barbour & Sons, sent to Barbour Inc.'s U.S headquarters, through its counsel, LS&CO. has alleged that use of the Barbour flag on shirts and pants infringes

rights in LS&CO.'s Tab Marks, including U.S. Trademark Registration No. 2,726,253 for its Shirt Tab Trademark, as well as a number of registrations for its Tab Device Trademark, including U.S. Trademark Registration No. 516,561; U.S. Trademark Registration No. 1,157,769; U.S. Trademark Registration No. 2,791,156; U.S. Trademark Registration No. 356,701; U.S. Trademark Registration No. 577,490; U.S. Trademark Registration No. 774,625; U.S. Trademark Registration No. 775,412, or any other trademark belonging to LS&CO.

68. Barbour Inc. denies that its use of the Barbour flag on shirts, pants, or any other item infringes LS&CO.'s alleged rights in LS&CO.'s Tab Marks.

69. Barbour Inc.'s use of the Barbour flag on shirts, pants, or any other item is not confusingly similar to LS&CO.'s Tab Marks. Barbour Inc.'s use of the Barbour flag on shirts, pants, or any other item will not mislead customers into believing that its goods originate with or are authorized by LS&CO.

70. LS&CO.'s assertion that Barbour Inc.'s use of the Barbour flag on shirts and pants is violating LS&CO.'s legal rights irreparably injures Barbour Inc. and adversely affects its business and the large investment it has made in its brand and products. These assertions will continue to adversely affect Barbour Inc.'s business unless prevented by the Court.

71. There is an actual and substantial controversy between Barbour Inc. and LS&CO., which have adverse legal interests. LS&CO. has made clear that it believes Barbour Inc.'s use of the Barbour flag infringes LS&CO.'s Tab Marks and that it will seek legal relief for the alleged infringement. Barbour Inc. denies any wrongdoing. The dispute between Barbour Inc. and LS&CO. is therefore substantial, definite and immediate, and not hypothetical.

72. To resolve the legal and factual questions raised by LS&CO., and to afford relief from the uncertainty and controversy that LS&CO.'s assertions have precipitated, Barbour Inc. is entitled to a declaratory judgment of its rights under 28 U.S.C. §§ 2201-02.

73. Barbour Inc. requests a judgment declaring that its use of the Barbour flag on shirts, pants, and any other item is not likely to cause confusion with LS&CO.'s Tab Marks, and that Barbour Inc. has not engaged in illegal trademark infringement, counterfeiting and/or false

designation of origin in violation of Sections 32, 42, and 43(a) of the Lanham Act (15 U.S.C. §§ 1114, 1124 and 1125(a)). LS&CO. is not entitled to injunctive relief or to any monetary remedies set forth in Section 35 of the Lanham Act, 15 U.S.C. § 1117, including but not limited to profits, damages, costs, or attorneys' fees, for trademark infringement based on Barbour Inc.'s use of the Barbour flag on shirts, pants, or any other item.

### COUNT VI

#### **(Declaration of no Unfair Competition by Barbour Inc.)**

74. Paragraphs 1-73 are incorporated by reference as if fully restated herein.

75. In correspondence with Barbour & Sons, sent to Barbour Inc.'s U.S headquarters, through its counsel, LS&CO. alleges that Barbour Inc. has engaged in unfair competition with respect to LS&CO.'s Tab Marks, including U.S. Trademark Registration No. 2,726,253 for its Shirt Tab Trademark, as well as a number of registrations for its Tab Device Trademark, including U.S. Trademark Registration No. 516,561; U.S. Trademark Registration No. 1,157,769; U.S. Trademark Registration No. 2,791,156; U.S. Trademark Registration No. 356,701; U.S. Trademark Registration No. 577,490; U.S. Trademark Registration No. 774,625; U.S. Trademark Registration No. 775,412, or any other trademark belonging to LS&CO.

76. Barbour Inc. denies that it has engaged in unfair competition with respect to LS&CO.'s Tab Marks by using the Barbour flag on shirts, pants, or any other item.

77. Barbour Inc.'s use of the Barbour flag on shirts, pants, or any other item is not confusingly similar to LS&CO.'s Tab Marks. Barbour Inc.'s use of the Barbour flag on shirts, pants, or any other item will not mislead customers into believing that its goods originate with or are authorized by LS&CO.

78. LS&CO.'s assertion that Barbour Inc.'s use of the Barbour flag on shirts and pants is violating LS&CO.'s legal rights irreparably injures Barbour Inc. and adversely affects its business and the large investment it has made in its brand and products. These assertions will continue to adversely affect Barbour Inc.'s business unless prevented by the Court.

79. There is an actual and substantial controversy between Barbour Inc. and LS&CO., which have adverse legal interests. LS&CO. has made clear that it believes Barbour Inc.'s use of the Barbour flag constitutes unfair competition with respect to LS&CO.'s Tab Marks and that it will seek legal relief for the alleged unfair competition. Barbour Inc. denies any wrongdoing. The dispute between Barbour Inc. and LS&CO. is therefore substantial, definite and immediate, and not hypothetical.

80. To resolve the legal and factual questions raised by LS&CO., and to afford relief from the uncertainty and controversy that LS&CO.'s assertions have precipitated, Barbour Inc. is entitled to a declaratory judgment of its rights under 28 U.S.C. §§ 2201-02.

81. Barbour Inc. requests a judgment declaring that its use of the Barbour flag on shirts, pants, and any other item is not likely to cause confusion with LS&CO.'s Tab Marks, and that Barbour Inc. has not engaged in unfair competition by using the Barbour flag on shirts, pants, or any other item. LS&CO. is not entitled to injunctive relief or to any monetary remedies, including but not limited to profits, damages, costs, or attorneys' fees, for unfair competition based on Barbour & Sons' use of the Barbour flag on shirts, pants, or any other item.

## **COUNT VII**

### **(Declaration of no Dilution by Barbour Inc.)**

82. Paragraphs 1-81 are incorporated by reference as if fully restated herein.

83. In correspondence with Barbour & Sons, sent to Barbour Inc.'s U.S headquarters, through its counsel, LS&CO. has alleged that use of the Barbour flag on shirts and pants dilutes LS&CO.'s Tab Marks, including U.S. Trademark Registration No. 2,726,253 for its Shirt Tab Trademark, as well as a number of registrations for its Tab Device Trademark, including U.S. Trademark Registration No. 516,561; U.S. Trademark Registration No. 1,157,769; U.S. Trademark Registration No. 2,791,156; U.S. Trademark Registration No. 356,701; U.S. Trademark Registration No. 577,490; U.S. Trademark Registration No. 774,625; U.S. Trademark Registration No. 775,412, or any other trademark belonging to LS&CO.

84. The LS&CO. Tab Marks are not famous.

85. Barbour Inc. denies that any such commercial use of the Barbour flag on shirts, pants, or any other item constitutes dilution of LS&CO.'s Tab Marks.

86. Any such use by Barbour Inc. of the Barbour flag on shirts, pants, or any other item does not blur the connection in consumers' minds between the LS&CO.'s Tab Marks and LS&CO. products. Barbour Inc.'s use of the Barbour flag on shirts, pants, or any other item will not tarnish the LS&CO. Tab Marks.

87. LS&CO.'s assertion that Barbour Inc.'s use of the Barbour flag on shirts and pants is violating LS&CO.'s legal rights irreparably injures Barbour Inc. and adversely affects its business and the large investment it has made in its brand and products. These assertions will continue to adversely affect Barbour Inc.'s business unless prevented by the Court.

88. There is an actual and substantial controversy between Barbour Inc. and LS&CO., which have adverse legal interests. LS&CO. has made clear that it believes Barbour Inc.'s use of the Barbour flag dilutes LS&CO.'s Tab Marks and that it will seek legal relief for the alleged dilution. Barbour Inc.'s denies any wrongdoing. The dispute between Barbour Inc. and LS&CO. is therefore substantial, definite and immediate, and not hypothetical.

89. To resolve the legal and factual questions raised by LS&CO., and to afford relief from the uncertainty and controversy that LS&CO.'s assertions have precipitated, Barbour Inc. is entitled to a declaratory judgment of its rights under 28 U.S.C. §§ 2201-02.

90. Barbour Inc. requests a judgment declaring that its use of the Barbour flag on shirts, pants, and any other item does not dilute LS&CO.'s Tab Marks, and that Barbour Inc. has not engaged in illegal trademark dilution in violation of Section 43(a) of the Lanham Act, 15 U.S.C. § 1125(c). LS&CO. is not entitled to injunctive relief or to any monetary remedies set forth in Section 35 of the Lanham Act, 15 U.S.C. § 1117, including but not limited to profits, damages, costs, or attorneys' fees, for trademark infringement based on Barbour Inc.'s use of the Barbour flag on shirts, pants, or any other item.

**PRAYER FOR RELIEF**

WHEREFORE, Barbour & Sons and Barbour Inc. request that the Court enter judgment in their favor and against LS&CO. as follows:

- A. Declaring that Barbour & Sons is not engaging in any commerce that is subject to regulation under the laws of the United States, including the Lanham Act (15 U.S.C. §1051, *et seq.*);
- B. In the alternative, to the extent the Court finds that Barbour & Sons is engaging in commercial activity that is subject to regulation under the Lanham Act, declaring that Barbour & Sons is not: (i) engaging in any conduct that is likely to cause confusion with respect to any valid rights in the LS&CO. Tab Marks; (ii) engaging in any conduct that is likely to dilute any valid rights in the LS&CO. Tab Marks; or otherwise (iii) engaging in any conduct that constitutes unfair competition with LS&CO. under the Lanham Act or applicable U.S. state law;
- C. Declaring that Barbour Inc. is not: (i) engaging in any conduct that is likely to cause confusion with respect to any valid rights in the LS&CO. Tab Marks; (ii) engaging in any conduct that is likely to dilute any valid rights in the LS&CO. Tab Marks; or otherwise (iii) engaging in any conduct that constitutes unfair competition with LS&CO. under the Lanham Act or applicable U.S. state law; and
- D. Permanently enjoining LS&CO., its officers, agents, employees, attorneys, privies, representatives, successors or assigns, and any and all persons in active concert or participation with or under authority from LS&CO., from:
  - a. Interfering with or threatening to interfere with the use of the Barbour flag on shirts, pants, and any other item by Barbour & Sons and Barbour Inc., and their related companies, retail partners, successors or assigns, in connection with its or their business; and
  - b. Instituting or prosecuting any suit or other proceeding placing in issue the right of Barbour & Sons and Barbour Inc., or their related companies, retail

partners, successors or assigns, to use the Barbour flag on shirts, pants, and any other item; and

- E. Awarding Barbour & Sons and Barbour Inc. their costs and attorneys' fees; and
- F. Granting Barbour & Sons and Barbour Inc. such further relief as the Court deems just and proper.

Dated: New York, New York  
June 8, 2018

DORSEY & WHITNEY LLP

/s/ Bruce R. Ewing

J. Michael Keyes (JK-6504)

Bruce R. Ewing (BE-0724)

Columbia Center

701 Fifth Avenue, Suite 6100

Seattle, Washington 98104-7043

Telephone: (206) 903-8800

51 West 52nd Street

New York, New York 10019

Telephone: (212) 415-9200

Attorneys for Plaintiffs J. Barbour &  
Sons Ltd. and Barbour Inc.