

1 SHEPPARD, MULLIN, RICHTER & HAMPTON LLP
A Limited Liability Partnership
2 Including Professional Corporations
3 SEONG KIM, Cal. Bar No. 166604
shkim@sheppardmullin.com
4 1901 Avenue of the Stars, 16th Floor
Los Angeles, California 90067
5 Telephone: 310.228.3700
6 Facsimile: 310.228.3701

7 LAURA L. CHAPMAN, Cal. Bar No. 167249
lchapman@sheppardmullin.com
8 TONI QIU, Cal. Bar No. 302268
tqiu@sheppardmullin.com
9 Four Embarcadero Center, 17th Floor
10 San Francisco, California 94111-4109
Telephone: 415.434.9100
11 Facsimile: 415.434.3947

12 Attorneys for Plaintiff
13 FOREVER 21, INC.

14
15 UNITED STATES DISTRICT COURT
16 CENTRAL DISTRICT OF CALIFORNIA, WESTERN DIVISION
17

18 FOREVER 21, INC., a Delaware
19 corporation,

20 Plaintiff,

21 v.

22 GUCCI AMERICA, INC., a New York
23 corporation, and GUCCIO GUCCI
24 S.p.A., an Italian entity,

25 Defendants.
26
27

Case No.

COMPLAINT FOR:

**(1) DECLARATORY JUDGMENT
OF NON-INFRINGEMENT OF
TRADEMARKS;**

**(2) CANCELLATION OF FEDERAL
TRADEMARK REGISTRATIONS;**

**(3) DENIAL OF FEDERAL
REGISTRATION OF
TRADEMARKS**

1 Plaintiff Forever 21, Inc. (“**Forever 21**”) hereby states the following
2 allegations for its Complaint against Defendants Gucci America, Inc. and Guccio
3 Gucci S.p.A. (collectively, “**Gucci**”).

4 **INTRODUCTION**

5 1. Forever 21 seeks protection against a threat of trademark litigation by
6 Gucci over a parallel stripe design of alternating bands colored blue-red-blue and
7 green-red-green. The colors red, blue, and green, and stripe designs, are among the
8 most favorite, popular and widely used colors and design features on clothing.
9 Gucci seeks to prevent Forever 21 from using stripes with common colors on
10 clothing and accessories sold at Forever 21. Gucci has warned Forever 21 in writing
11 of Gucci’s allegations that Forever 21 is infringing Gucci’s trademark and has
12 threatened to sue Forever 21 to recover monetary and injunctive relief. Consumers
13 are not likely to believe any of Forever 21’s items are manufactured by, or otherwise
14 associated with, Gucci. Forever 21 is not infringing any Gucci trademark. Gucci’s
15 trademark registrations relevant to this dispute should be cancelled. Gucci’s
16 pending applications should not proceed to registration. This matter is ripe for a
17 declaratory judgment.

18 **PARTIES**

19 2. Plaintiff Forever 21, Inc., is a Delaware corporation, having its
20 principal place of business at 3880 N. Mission Road, Los Angeles, California
21 90031.

22 3. On information and belief, Defendant Gucci America, Inc. is a New
23 York corporation, having a principal place of business at 50 Hartz Way, Secaucus,
24 New Jersey 07094.

25 4. On information and belief, Defendant Guccio Gucci S.p.A. is an Italian
26 entity, having its registered address at Via Tornabuoni 73/r, 50123 Florence, Italy.

27 5. On information and belief, Gucci is the owner of the claimed
28 trademarks that Gucci has asserted against Forever 21, as set forth below.

1 **JURISDICTION AND VENUE**

2 6. This Court has subject matter jurisdiction over this action pursuant to
3 15 U.S.C. § 1121 and 28 U.S.C. §§ 1331, 1338, and 2201 because Count 1 is for
4 declaratory judgment for claims involving trademarks and an actual case or
5 controversy exists between Gucci and Forever 21, and because this action involves
6 substantial claims arising under the Lanham Act.

7 7. This Court has personal jurisdiction over Guccio Gucci S.p.A. and
8 Gucci America, Inc., because they conduct business in the state of California and
9 because they have threatened legal action against a company that is headquartered in
10 Los Angeles, California.

11 8. Venue is appropriate in this district pursuant to 28 U.S.C. § 1391(b)
12 because a substantial part of the events or omissions giving rise to Forever 21's
13 claim have occurred in this district and a substantial part of the property that is
14 subject to the action is situated in this district.

15 **FOREVER 21**

16 9. Forever 21 is an American success story. It began in 1984 with a
17 single, 900-square-foot store in Los Angeles, California. It has since grown into a
18 fashion giant whose stores are now housed in large spaces in shopping malls
19 including several flagship stores in major cities exceeding 75,000 square feet.
20 Today, Forever 21 is one of the most well-known specialty retailers of apparel,
21 clothing, and accessories, operating through its online store and in over 525 retail
22 stores throughout the United States, as well as in stores throughout the Americas,
23 Asia, the Middle East, and the UK.

24 10. Most of the merchandise Forever 21 sells in its online and brick-and-
25 mortar stores is made exclusively for Forever 21.

26 11. Forever 21 owns numerous trademark registrations for retail store
27 services, clothing, and fashion accessories. The well-known FOREVER 21 name
28 appears prominently on all Forever 21 stores, on Forever 21's website, and on

1 clothing Forever 21 sells. Consumers cannot purchase Forever 21’s clothing items
2 without encountering the FOREVER 21 trademark.

3 12. Forever 21 sells clothing displaying a wide variety of colors and
4 ornamental patterns and designs. Some of the clothing Forever 21 sells has
5 ornamental/decorative stripes. Forever 21 does not use stripes as a trademark or
6 source identifier on any of its clothing items. Any use of stripes on clothing sold by
7 Forever 21 is ornamental, decorative, and aesthetically functional.

8 **THE GUCCI DEMAND LETTERS**

9 13. Forever 21 received a letter dated December 7, 2016 from Ms. Victoria
10 Galante, Junior Legal Counsel at Gucci. This December 7, 2016 letter demanded
11 that Forever 21 cease and desist from any and all use of blue-red-blue stripes.

12 14. Forever 21 received a second letter dated January 6, 2017 from Ms.
13 Victoria Galante, Junior Legal Counsel at Gucci. This January 6, 2017 letter
14 contained the same demands as the December 7 letter, namely that Forever 21 cease
15 and desist from any and all use of blue-red-blue stripes.

16 15. Forever 21 received a third letter dated February 13, 2017 from Ms.
17 Andrea L. Calvaruso, an attorney at Kelley Drye & Warren LLP, on behalf of Gucci
18 (“**February 13 Demand Letter**”). The February 13, 2017 letter demanded that
19 Forever 21 discontinue all sales of certain clothing and accessory items with blue-
20 red-blue and green-red-green stripes.


21 16. The specific items identified as “infringing products” in Gucci’s
22 February 13 Demand Letter are pictured below:
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SO, LIKE... NEW. 100'S OF NEW ARRIVALS!
Free shipping on orders over \$50. [SEE DETAILS](#)

FOREVER 21 Women Plus Size Girls Men Beauty Search Products Hello, Sign in Your Account United States

Home / Accessories / Striped Choker



Striped Choker
\$3.90

Color Red/havy

Size
ONE SIZE

Qty: 1 [Add To Wishlist](#)

Description

Details
A woven choker featuring a striped design, scalloped edges, high-polish finish and a lobster clasp closure.

Content + Care
- Made in China

Size + Fit
- Chain length: 15"
- Décor: 11" x 0.75"

Product Code : 1000191097


Reviews & Ratings
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Features New Arrivals Tops Graphic Tees Jackets + Coats Bottoms Accessories Shoes Brands Sale

Home / Men / Embroidered Satin Bomber Jacket



Embroidered Satin Bomber Jacket
\$39.90

Color Blue/White

Size [Size Guide](#)
XXS S M L XL

Qty: 1 [Add To Wishlist](#)

Description

Details
Assembled satin bomber jacket featuring a quilted body, long raglan sleeves with a contrast stripe, embroidered tigers on the chest, a zippered front closure, an interior chest pocket, slanted front waist pockets, ribbed knit trim with contrast stripes, contrast jersey mesh lining, and backpatch with crowns, "Fate Now Later", and "NYL" embroidered on it.

Content + Care
- Shell 1, Shell 2 & Lining: 100% polyester
- Hand wash cold
- Made in Vietnam

Size + Fit
- Model is 5'7" and wearing a Large
- Full length: 28"
- Chest: 48"
- Waist: 48"
- Sleeve length: 27"

Product Code : 2001190330

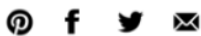
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FOREVER 21 [Women](#) [Plus Size](#) [Girls](#) [Men](#) [Beauty](#) [Hello, Sign In Your Account](#) [♥](#) [🛒](#)

[New Arrivals](#) [Want List](#) [Dresses](#) [Tops](#) [Jackets](#) [Bottoms](#) [Intimates](#) [Activewear](#) [Swim](#) [Accessories](#) [Shoes](#)
[Sale](#)

Home / Sweaters + Cardigans / Tiger Embroidery Stripe Sweater



Tiger Embroidery Stripe Sweater

\$22.90

Color : Green/navy



Size [Size Guide](#)

S M L

Qty: 1

Add To Bag

[♥ Add To Wishlist](#)

Description

Details

A lightweight ribbed knit sweater featuring an embroidered tiger chest logo, a rounded dropped shoulders, long sleeves with a stripe pattern, striped trim, and a boxy silhouette.

Content + Care

- 100% acrylic
- Hand wash cold
- Made in China

Size + Fit

- Model is 5'9" and wearing a Small
- Full length: 24.25"
- Chest: 42"
- Waist: 40.5"
- Sleeve length: 20.25"

Product Code : 2000190660

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FOREVER 21 [Women](#) [Plus Size](#) [Girls](#) [Men](#) [Beauty](#) [Hello, Sign In Your Account](#) [♥](#) [🛒](#)

[New Arrivals](#) [Want List](#) [Dresses](#) [Tops](#) [Jackets](#) [Bottoms](#) [Intimates](#) [Activewear](#) [Swim](#) [Accessories](#) [Sho](#)

[Home](#) / [Jackets](#) / [Metallic Faux Leather Bomber](#)



Metallic Faux Leather Bomber

\$34.90

Color : Silver



Size [Size Guide](#)

S M L

Qty : 1

Add To Bag

[♥ Add To Wishlist](#)

Description

Details

A faux leather bomber jacket featuring a metallic sheen, contrast varsity stripe contrast lining, and front welt pockets.

Content + Care

- Shell: 55% polyurethane, 45% cotton
- Contrast: 90% polyester, 10% spandex
- Dry clean
- Made in China

Size + Fit

- Model is 5'8" and wearing a Small
- Full length: 21"
- Chest: 36"
- Waist: 35"
- Sleeve length: 24"

Product Code : 2000226252


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SALE STARTING AT \$2!
Free shipping on orders over \$50. [SEE DETAILS](#)

FOREVER 21 [Women](#) [Plus Size](#) [Girls](#) [Men](#) [Beauty](#) [Hello, Sign In Your Account](#) [United States](#)

[New Arrivals](#) [Want List](#) [Dresses](#) [Tops](#) [Jackets](#) [Bottoms](#) [Intimates](#) [Activewear](#) [Swim](#) [Accessories](#) [Shoes](#) [Brands](#)

[Home](#) / [Jackets](#) / [Floral Bomber Jacket](#)





Floral Bomber Jacket

\$68.00

Color : [Black](#)

Size [Size Guide](#)

S M L

Qty : 1

[Add To Wishlist](#)

Description

*Available for shipment exclusively within the U.S.

Details
A knit bomber jacket featuring an allover floral print, striped ribbed trim, a zip front, front zip po and long sleeves. This is an independent brand and not a Forever 21 branded item.

Content + Care
- 95% polyester, 5% spandex
- Hand wash cold
- Made in China

Size + Fit
- Model is 5'9" and wearing a Small
- Full length: 23"
- Chest: 41"
- Waist: 40"
- Sleeve length: 23.25"

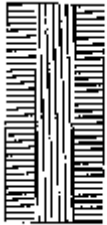

Product Code : 2000206673

17. Forever 21, through its Senior Corporate Counsel, Jerry Noh, responded to Gucci’s February 13 Demand Letter in a letter dated March 22, 2017, in which Forever 21 denied Gucci’s claims of infringement.

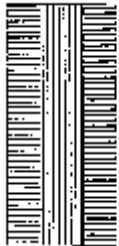

GUCCI’S TRADEMARK REGISTRATIONS AND APPLICATIONS

18. In its February 13 Demand Letter, Gucci asserted that each of the items pictured above (the “**Striped Products**”) infringes Gucci’s rights in various federal trademark registrations for the use of blue-red-blue and green-red-green stripes on clothing and accessory items. The registrations asserted in Gucci’s February 13 Demand Letter are listed in the table below:


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Mark	Class: Goods
<p>Reg. No. 1520796 Reg. Date: 1/17/1989</p>  <p>THE MARK IS AT LEAST ONE PROMINENT STRIPE CONTAINING THREE DISTINCT BANDS OF COLOR, THE COLORS BEING BLUE, RED, AND THEN BLUE, APPEARING ON THE GOODS AND NOT CONTIGUOUS TO ANOTHER STRIPE.</p> <p>Incontestable: 9/15/1995 Renewal Date: 6/6/2008</p>	<p>14: [GOODS MADE OR COATED WITH PRECIOUS METAL -NAMELY, CANDLE HOLDERS,] WATCHES, [CUFFLINKS, BRACELETS, PENDANTS, KEY RINGS, PAPERWEIGHTS, EARRINGS, RINGS, NECKLACES, ICE BUCKETS, GOBLETS, AND STYLIZED ANIMAL CONTAINERS].</p> <p>FIRST USE: 19570000. FIRST USE IN COMMERCE: 19670000</p>
<p>Reg. No. 4563151 Reg. Date: 7/8/2014</p>  <p>The color(s) Blue and Red is/are claimed as a feature of the mark. The mark consists of a stripe containing three distinct bands of color with a red band in the middle of two blue bands.</p>	<p>18: Gym bags, wallets, cosmetic cases sold empty.</p> <p>FIRST USE: 19630000. FIRST USE IN COMMERCE: 19630000</p>

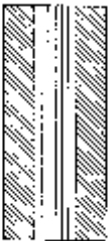
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Mark	Class: Goods
<p>Reg. No. 1495863 Reg. Date: 7/12/1988</p>  <p>THE MARK IS MADE UP OF A STIPE CONTAINING THREE DISTINCT BANDS OF COLOR, THE COLORS BEING BLUE, RED AND THEN BLUE.</p> <p>Incontestable: 11/7/1994 Renewal Date: 3/29/2008</p>	<p>25: FOOTWEAR. FIRST USE: 19590000. FIRST USE IN COMMERCE: 19670000</p>
<p>Reg. No. 1511774 Reg. Date: 11/8/1988</p>  <p>THE DRAWING IS LINED FOR THE COLORS BLUE AND RED.</p> <p>Incontestable: 5/15/1995 Renewal Date: 4/30/2008</p>	<p>28: [WALLETS,] PURSES, HANDBAGS, SHOULDER BAGS, CLUTCH BAGS, TOTE BAGS [, BUSINESS CARD CASES, CREDIT CARD CASES, PASSPORT CASES, COSMETIC CASES SOLD EMPTY, ATTACHE CASES, VALISES, SUITCASES, DUFFLE BAGS, NECKTIE CASES, UMBRELLAS, SADDLES, BRIDLES, WALKING STICKS, CANES AND KEY CASES]. FIRST USE: 19510000. FIRST USE IN COMMERCE: 19630000</p>

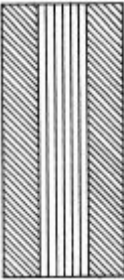
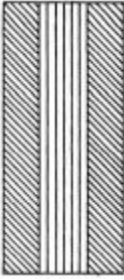
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Mark	Class: Goods
<p>Reg. No. 4379039 Reg. Date: 8/6/2013</p>  <p>The color(s) GREEN and RED is/are claimed as a feature of the mark. The mark consists of a stripe containing three distinct bands of color with a red band in the middle of two green bands.</p>	<p>25: Shorts, pants, jeans, leggings, t-shirts, polo shirts, shirts, sweaters, sweatshirts, dresses, skirts, swimwear, one piece garments for infants and toddlers, cloth bibs, scarves, ties, hats, gloves, suspenders, belts. FIRST USE: 19670900. FIRST USE IN COMMERCE: 19670900</p>

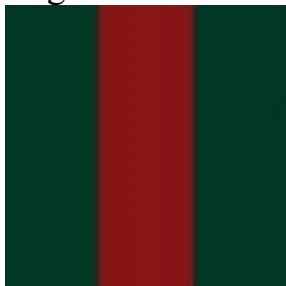
19. On information and belief, Gucci America, Inc. is the registered owner of the following trademark registrations for green-red-green stripes, which were not included or identified in Gucci’s February 13 Demand Letter:

Mark	Class: Goods
<p>Reg. No. 1483526 Reg. Date: 4/5/1988</p>  <p>THE MARK IS MADE UP OF A STRIPE CONTAINING THREE BANDS OF COLOR, THE COLORS BEING GREEN, RED THEN GREEN. THE MARK IS LINED FOR THE COLORS RED AND GREEN.</p> <p>Incontestable: 6/17/1994 Renewal Date: 10/25/2007</p>	<p>25: FOOTWEAR. FIRST USE: 19670900. FIRST USE IN COMMERCE: 19670900</p>

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Mark	Class: Goods
<p>Reg. No. 1123224 Reg. Date: 7/31/1979</p>  <p>THE MARK IS MADE OF A STRIPE CONTAINING THREE DISTINCT BANDS OF COLOR BEING GREEN, RED, THEN GREEN.</p> <p>Incontestable: 9/12/1985 Renewal Date: 9/11/2008</p>	<p>14: GOODS MADE OR COATED WITH PRECIOUS METAL-NAMELY, [CANDLE HOLDERS,] WATCHES, [CUFFLINKS, BRACELETS, PENDANTS, KEY RINGS, PAPERWEIGHTS, EARRINGS, RINGS, NECKLACES, ICE BUCKETS, GOBLETS, STYLIZED ANIMAL CONTAINERS AND LETTER OPENERS].</p> <p>FIRST USE: 19670800. FIRST USE IN COMMERCE: 19670800</p>
<p>Reg. No. 1122780 Reg. Date: 7/24/1979</p>  <p>THE MARK IS MADE UP OF A STRIPE CONTAINING THREE DISTINCT BANDS OF COLORS, THE COLORS BEING GREEN, RED THEN GREEN.</p> <p>Incontestable: 9/13/1985 Renewal Date: 1/14/2009</p>	<p>18: WALLETTS, PURSES, HANDBAGS, SHOULDER BAGS, CLUTCH BAGS, TOTE BAGS, CARD CASES, [PASSPORT CASES, COSMETIC CASES,] ATTACHE CASES, VALISES, SUITCASES, DUFFLES, [[NECKTIE CASES, UMBRELLAS, SADDLES, BRIDLES, WALKING STICKS, CANES,] AND KEY CASES.</p> <p>FIRST USE: 19630700. FIRST USE IN COMMERCE: 19630700</p>



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Mark	Class: Goods
<p>Reg. No. 4567112 Reg. Date: 7/15/2014</p>  <p>The color(s) GREEN and RED is/are claimed as a feature of the mark. The mark consists of a stripe containing three distinct bands of color with a red band in the middle of two green bands.</p>	<p>09: Eyeglasses and sunglasses and cases therefor; protective covers and cases for mobile electronic communication devices and computers; cell phone straps; computer carrying cases. FIRST USE: 20100915. FIRST USE IN COMMERCE: 20100915</p> <p>14: Jewelry and key rings of precious metal. FIRST USE: 20100915. FIRST USE IN COMMERCE: 20100915</p> <p>18: Cosmetic cases sold empty, suitcases, luggage, duffle bags, diaper bags partly and wholly of leather; pet accessories, namely, carriers, collars and leashes. FIRST USE: 20100915. FIRST USE IN COMMERCE: 20100915</p>



20. Hereinafter, the registrations identified in the charts above will be collectively referred to as the **“Gucci Registrations.”**


21. On information and belief, Gucci America, Inc. is the owner of record for the following trademark applications for blue-red-blue and green-red-green stripes (hereinafter, the **“Gucci Applications”**):

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Mark	App. Serial No.	Class: Goods
 <p data-bbox="277 533 659 873">The color(s) Blue and Red is/are claimed as a feature of the mark. The mark consists of a stripe containing three distinct bands of color with a red band in the middle of two blue bands.</p>	<p data-bbox="675 254 946 296">87206686</p> <p data-bbox="675 338 946 464">Filing Date: 10/18/2016 Filing Basis: 1A</p>	<p data-bbox="963 254 1521 506">25: Clothing, namely, sweaters, shirts, tops, jackets, coats, skirts, pants, jeans, shorts, dresses, boots, sandals, sneakers, belts and hats FIRST USE: 19740000. FIRST USE IN COMMERCE: 19740000</p>
 <p data-bbox="277 1155 659 1495">The color(s) Blue and Red is/are claimed as a feature of the mark. The mark consists of a stripe containing three distinct bands of color with a red band in the middle of two blue bands.</p>	<p data-bbox="675 873 946 915">87116368</p> <p data-bbox="675 957 946 1083">Filing Date: 7/26/2016 Filing Basis: 1A</p>	<p data-bbox="963 873 1521 999">24: Baby blankets. FIRST USE: 20160100. FIRST USE IN COMMERCE: 20160100</p>

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Mark	App. Serial No.	Class: Goods
 <p>The color(s) Blue and red is/are claimed as a feature of the mark. The mark consists of a stripe containing three distinct bands of color with a red band in the middle of two blue bands.</p>	<p>87391139</p> <p>Filing Date: 3/29/2017</p> <p>Filing Basis: 1A</p>	<p>09: Sunglasses; mobile phone cases; cell phone straps. FIRST USE: 20040000. FIRST USE IN COMMERCE: 20040000</p> <p>18: Backpacks. FIRST USE: 20110000. FIRST USE IN COMMERCE: 20110000</p> <p>25: Scarves. FIRST USE: 20080000. FIRST USE IN COMMERCE: 20080000</p>
 <p>The color(s) GREEN and RED is/are claimed as a feature of the mark. The mark consists of a stripe containing three distinct bands of color with a red band in the middle of two green bands.</p>	<p>87116786</p> <p>Filing Date: 7/26/2016</p> <p>Filing Basis: 1A</p>	<p>24: Baby blankets. FIRST USE: 20160100. FIRST USE IN COMMERCE: 20160100</p>

Mark	App. Serial No.	Class: Goods
 <p data-bbox="280 537 646 873">The color(s) Green and red is/are claimed as a feature of the mark. The mark consists of a stripe containing three distinct bands of color with a red band in the middle of two green bands.</p>	<p data-bbox="672 254 824 296">87390952</p> <p data-bbox="672 344 854 422">Filing Date: 3/29/2017</p> <p data-bbox="672 428 919 470">Filing Basis: 1A</p>	<p data-bbox="961 254 1414 338">18: Backpacks; briefcases and messenger bags.</p> <p data-bbox="961 344 1511 422">FIRST USE: 19680000. FIRST USE IN COMMERCE: 19680000</p>

GUCCI'S THREATENED CLAIMS

22. Gucci's February 13 Demand Letter accuses Forever 21 of trademark infringement based on Forever 21's sale of the Striped Products.

23. In addition to demanding that Forever 21 "immediately ceas[e] any and all manufacture, importation, offering for sale, sale, shipment, advertising or display" of the Striped Products and any other products bearing designs that are "confusingly similar" to Gucci's blue-red-blue and green-red-green stripe marks, Gucci demanded in its February 13 Demand Letter that Forever 21 provide an accounting of all Striped Products sold and in inventory, as well as the identity and contact information for the persons or entities that designed, manufactured, and or distributed the Striped Products. Gucci further threatened to file an action against Forever 21 "to fully protect [Gucci's] valuable rights in the U.S. and abroad," if Forever 21 did not comply with Gucci's demands.

24. Gucci's February 13 Demand Letter further stated, "We must hear from you or your counsel within five (5) business days to arrange Forever 21's compliance with the foregoing."

1 25. To Forever 21’s knowledge, Gucci has not yet filed suit against Forever
2 21 and has not withdrawn its demand against Forever 21.

3 26. All of the Gucci Registrations feature three parallel stripes colored
4 blue-red-blue or green-red-green.

5 27. Many clothing and accessory items adorned with decorative stripes
6 colored blue-red-blue or green-red-green are sold by countless third parties.

7 28. Gucci should not be allowed to claim that Gucci, alone, has a
8 monopoly on all blue-red-blue and green-red-green striped clothing and accessory
9 items.

10 29. Consumers are not likely to be confused into believing the Striped
11 Products sold in Forever 21’s stores by Forever 21 is manufactured by, sponsored
12 by, authorized by, or otherwise associated or affiliated with Gucci.

13 30. Because Gucci continues to threaten to sue Forever 21 if Forever 21
14 has not caved to Gucci’s demands, an immediate, justiciable case or controversy
15 exists such that Forever 21 is entitled to seek a declaratory judgment of non-
16 infringement.

17 **FIRST CAUSE OF ACTION**

18 **(Declaration of Non-Infringement)**

19 31. Forever 21 incorporates paragraphs 1 through 30 herein by reference.

20 32. Forever 21’s Striped Products display stripes in an ornamental,
21 decorative, non-trademark manner. Additionally, or in the alternative, none of
22 Forever 21’s Striped Products is likely to cause confusion as to the source,
23 sponsorship, or affiliation of the Forever 21 products.

24 33. Forever 21’s Striped Products items do not infringe any of the Gucci
25 Registrations or any other trademark rights owned by Gucci.

26 34. An actual, present, and justiciable controversy has arisen between
27 Gucci and Forever 21 concerning the Striped Products. Gucci and Forever 21 have
28 adverse legal interests. Gucci has made clear to Forever 21 Gucci’s belief that its

1 trademark is currently being infringed by Forever 21's Striped Products, and
2 Forever 21 has denied any wrongdoing. The dispute between Forever 21 and Gucci
3 is substantial, definite and immediate, and not hypothetical.

4 35. A declaratory judgment of non-infringement should be entered in
5 Forever 21's favor regarding the blue-red-blue and green-red-green striped design.

6 36. In order to resolve the legal and factual questions raised by Gucci and
7 to afford relief from the uncertainty and controversy which Gucci's assertions have
8 precipitated, Forever 21 is entitled to a declaratory judgment of its rights under 28
9 U.S.C. §§ 2201-02.

10 **SECOND CAUSE OF ACTION**

11 **(Cancellation of Federal Registration Nos. 4379039, 4563151, and 4567112
12 for Lack of Secondary Meaning)**

13 37. Forever 21 incorporates paragraphs 1 through 36 herein by reference.

14 38. Forever 21 believes that it will be damaged by the continued
15 registration of Registration Nos. 4379039, 4563151, and 4567112, and hereby
16 petitions to cancel these registrations on the grounds that the marks that are the
17 subject of these registrations lack secondary meaning.

18 **THIRD CAUSE OF ACTION**

19 **(Cancellation of Federal Registration Nos. 1495863, 1511774, 1520796,
20 1483526, 1123224, 1122780, 4379039, 4563151, and 4567112
21 for Aesthetic Functionality)**

22 39. Forever 21 incorporates paragraphs 1 through 38 herein by reference.

23 40. Forever 21 believes that it will be damaged by the continued
24 registration of Registration Nos. 1495863, 1511774, 1520796, 1483526, 1123224,
25 1122780, 4379039, 4563151, and 4567112, and hereby petitions to cancel these
26 registrations on the grounds that the marks that are the subject of these registrations
27 are aesthetically functional.
28

1 **FOURTH CAUSE OF ACTION**

2 **(Cancellation of Federal Registration Nos. 1495863, 1511774, 1520796,**
3 **1483526, 1123224, 1122780, 4379039, 4563151, and 4567112**
4 **for Genericism)**

5 41. Forever 21 incorporates paragraphs 1 through 40 herein by reference.

6 42. Forever 21 believes that it will be damaged by the continued
7 registration of Registration Nos. 1495863, 1511774, 1520796, 1483526, 1123224,
8 1122780, 4379039, 4563151, and 4567112, and hereby petitions to cancel these
9 registrations on the grounds that the marks that are the subject of these registrations
10 are generic.

11 **FIFTH CAUSE OF ACTION**

12 **(Denial of Federal Registration of Marks in USPTO Application Serial Nos.**
13 **87116786, 87206686, 87116368, 87390952, 87391139)**

14 43. Forever 21 incorporates paragraphs 1 through 42 herein by reference.

15 44. Forever 21 believes that it will be damaged by the registration of the
16 marks that are the subject of U.S. Application Serial Nos. 87116786, 87206686,
17 87116368, 87390952, 87391139, and hereby seeks denial of federal registration of
18 these marks on the grounds that the marks that are the subject of these applications
19 are not registrable for lack of secondary meaning.

20 45. Forever 21 believes that it will be damaged by the registration of the
21 marks that are the subject of U.S. Application Serial Nos. 87116786, 87206686,
22 87116368, 87390952, 87391139, and hereby seeks denial of federal registration of
23 these marks on the grounds that the marks that are the subject of these applications
24 are not registrable because they are aesthetically functional.

25 46. Forever 21 believes that it will be damaged by the registration of the
26 marks that are the subject of U.S. Application Serial Nos. 87116786, 87206686,
27 87116368, 87390952, 87391139, and hereby seeks denial of federal registration of
28

1 these marks on the grounds that the marks that are the subject of these applications
2 are not registrable because they are generic.

3 **PRAYER FOR RELIEF**

4 WHEREFORE, Forever 21 prays for the following relief:

5 1. A judgment declaring that (a) the blue-red-blue and green-red-green
6 stripes on Forever 21's Striped Products are ornamental and do not serve a source-
7 identifying function, and (b) Forever 21's Striped Products do not infringe any
8 trademark rights owned by Gucci;

9 2. A judgment declaring that Forever 21 has the right to use blue-red-blue
10 and green-red-green stripes on products sold and offered for sale by Forever 21, free
11 from interference by Gucci, its officers, agents, employees, attorneys, privies,
12 representatives, successors and assigns, and any and all persons acting in active
13 concert or participation with or under authority from Gucci;

14 3. A judgment ordering that Gucci, its officers, agents, employees,
15 attorneys, privies, representatives, successors and assigns, and any and all persons in
16 active concert or participation with or under authority from Gucci, be permanently
17 enjoined from:

18 a. Interfering with or threatening to interfere with the use of blue-red-
19 blue and green-red-green stripes by Forever 21, its related
20 companies, successors or assigns, in connection with its or their
21 business;

22 b. Instituting or prosecuting any suit or other proceeding placing in
23 issue the right of Forever 21 or said related companies, successors
24 or assigns to use the blue-red-blue and green-red-green stripes in
25 connection with products sold or offered for sale by Forever 21;

26 4. A judgment ordering the cancellation of Registration Nos. 1495863,
27 1511774, 1520796, 1483526, 1123224, 1122780, 4379039, 4563151, and 4567112;

28

1 5. A judgment ordering the denial of registration of Application Serial
2 Nos. 87116786, 87206686, 87116368, 87390952, 87391139;

3 6. An award of costs in this action;

4 7. A finding that this case is “exceptional” within the meaning of 15
5 U.S.C. § 1117 and a corresponding award of attorneys’ fees in Forever 21’s favor;
6 and

7 8. For such other, further, or different relief as the Court deems just and
8 proper.

9 Dated: June 26, 2017

10 SHEPPARD, MULLIN, RICHTER & HAMPTON
11 LLP

12
13 By _____
 /s/ Laura L. Chapman
14 LAURA L. CHAPMAN

15 Attorneys for Plaintiff
16 FOREVER 21, INC.
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