

1
2
3
4
5
6
7
8 UNITED STATES DISTRICT COURT
9 WESTERN DISTRICT OF WASHINGTON
10 AT SEATTLE

11 SUR LA TABLE, INC., a Washington
12 Corporation,

13 Plaintiff,

14 v.

15 BURBERRY LIMITED (U.S.), a New York
16 Corporation, and BURBERRY LIMITED
17 (U.K.), a United Kingdom Corporation,

18 Defendants.

Case No.:

COMPLAINT FOR DECLARATORY
JUDGMENT

[JURY DEMAND]

19 Plaintiff Sur La Table, Inc., for its Complaint, alleges as follows:

20 I. PARTIES

21 1. Plaintiff Sur La Table, Inc. ("Sur La Table"), is a corporation organized under the
22 laws of the State of Washington with its principal place of business in Seattle, Washington.

23 2. Defendant Burberry Limited ("Burberry U.S.A.") is a corporation organized
24 under the laws of the State of New York with its principle place of business at 1350 Avenue of
25 the Americas, New York, N.Y. 10019.

26 3. Defendant Burberry Limited ("Burberry U.K.") is a corporation organized under
27 the laws of the United Kingdom with its principal place of business at 18-22 Hay Market,
London, England, SW1Y 4DQ.

1 4. Burberry U.K. is the sister company of Burberry U.S.A., and each is wholly
2 owned by the same holding company, Burberry Group PLC.

3 5. Burberry U.K. purports to own certain trademarks in a generic geometric tartan
4 pattern comprising two sets of three straight lines intersecting at a ninety degree angle to form a
5 lattice pattern with a border of thin straight lines forming a square box around the lattice pattern
6 (the “generic lattice pattern”). Burberry U.S.A. displays, offers for sale and sells products
7 bearing the generic lattice pattern in the State of Washington and throughout the United States.

8 **II. JURISDICTION AND VENUE**

9 6. This Court has jurisdiction over the subject matter of this complaint pursuant to
10 28 U.S.C. ¶ 1338 and under the Declaratory Judgment Act, 28 U.S.C. §§ 2201 and 2202.
11 Jurisdiction of the related claim is proper in that said claims are substantially related to the claim
12 under the Declaratory Judgment Act, and this Court also has supplemental jurisdiction of the
13 related claim under 28 U.S.C. § 1367.

14 7. This Court has jurisdiction over Defendant Burberry U.S.A. because clothing
15 items and accessories bearing the generic lattice pattern are sold in stores in this District and
16 throughout the State of Washington, clothing items and accessories bearing the generic lattice
17 pattern are advertised in this District and throughout the State of Washington, and Burberry
18 U.S.A. regularly does business in this District and the State of Washington. This Court has
19 jurisdiction over Defendant Burberry U.K. because it regularly does business in this District and
20 in the State of Washington, either directly or indirectly through the actions of Burberry U.S.A.

21 8. Venue in this district is proper pursuant to 28 U.S.C. § 1391 as a substantial part
22 of the events giving rise to the dispute have occurred in this District, Defendants Burberry
23 U.S.A. and Burberry U.K. regularly conduct business in this District and because all parties are
24 subject to this Court’s jurisdiction.

III. FACTS

1
2 9. Founded in Seattle in 1972, Sur La Table offers for sale and sells a variety of
3 products for the kitchen, including linens and other accessories in the State of Washington and
4 throughout the United States.

5 10. Among the thousands of products for the kitchen that Sur La Table offers for sale
6 is a "Children's Pink Plaid and Poodle Apron" (the "Poodle Apron"). The Poodle Apron bears a
7 pink and brown lattice pattern with a poodle appliqué on the front. A true and correct image of
8 the product is attached hereto as Exhibit 1.

9 11. Burberry U.K. purports to own certain trademarks for clothing and accessories
10 bearing the generic lattice pattern (the "Claimed Trademarks") and has obtained various federal
11 registrations for some of those Claimed Trademarks. A true and correct copy of a cease and
12 desist letter from Burberry U.S.A.'s counsel dated April 15, 2010, listing the Claimed
13 Trademarks is attached as Exhibit 2.

14 12. Defendants' federal registrations list a number of products, but none include
15 aprons or any other clothing or accessory items bearing the image of a poodle. One or more of
16 the federal registrations owned by Burberry U.K. specifically exclude kitchen linens from the list
17 of goods on which Defendants claim use of its marks.

18 13. Burberry U.S.A. is an assignee or authorized user of Burberry U.K.'s Trademarks,
19 and it controls and manages the importation, distribution and sale of Burberry's goods in North
20 America.

21 14. Products bearing the generic lattice pattern in various color combinations, though
22 rarely pink and brown, are displayed or sold in the State of Washington and throughout the
23 United States.

24 15. Defendants claim exclusive rights in the United States to the generic lattice
25 pattern for use in association with a long list of products, but not including kitchen linens.
26 However, there is nothing suggestive, fanciful or arbitrary about a lattice configuration on tartan
27

1 (plaid) fabric. There is nothing inherently distinctive about Defendants' generic lattice pattern,
2 nor has such pattern acquired distinctiveness through secondary meaning.

3 16. The generic lattice pattern is functional; it is a decorative geometric pattern
4 present on many products, from plaid fabric to waffle-cut french fries.

5 17. Some of Defendants' federal registrations define the shades of color that appear
6 with the generic lattice pattern, as shades of the colors tan, red, dark gray, medium gray, and
7 light gray.

8 18. Burberry U.S.A., through counsel, mailed a cease and desist letter dated April 15,
9 2010, to Sur La Table, claiming that the Poodle Apron infringed Burberry's Claimed
10 Trademarks, namely, what it described as the "Burberry Check" (color-specific) trademarks, the
11 "Burberry Check (no color designation)" trademarks, and the "Equestrian Knight Device"
12 trademark. Defendants also accused Sur La Table of infringing common law (unregistered)
13 rights in its lattice pattern mark occurring "in a wide variety of colors." Exhibit 2.

14 19. Sur La Table has never sold any item decorated with camel/black/white/red tartan
15 fabric.

16 20. Sur La Table has never sold any item bearing the "Equestrian Knight Device"
17 trademark.

18 21. Defendants' April 15 letter demands that Sur La Table take a series of actions,
19 including that it immediately stop offering the Poodle Apron for sale and pay damages to
20 Defendants. The letter informs Sur La Table that its failure to comply with the numerous
21 demands made will result in legal action against Sur La Table.

22 22. The Poodle Apron uses the generic lattice pattern in pink and brown colors. The
23 resulting blocks of color repeat vertically and horizontally in a pattern of squares and lines
24 known as a sett. As used in the Poodle Apron by Sur La Table, the generic lattice pattern is
25 merely decorative.

26 23. The generic lattice pattern is a common geometrical shape to which no one may
27 claim exclusive rights.

1 24. Tartan fabric in pink and brown is a common pattern and coloring to which no
2 one may claim exclusive rights.

3 25. The generic lattice pattern is not original to Defendants, and it has been in use,
4 including on tartan fabrics, for centuries.

5 26. Defendants’ Claimed Trademarks have not acquired distinctiveness.

6 27. Defendants have not used pink and brown tartan as a trademark in association
7 with any goods or services.

8 28. Defendants’ claimed pink/brown tartan common law trademark is not famous.

9 29. Defendants do not sell aprons or other kitchen linens.

10 30. Defendants’ actions have placed Sur La Table under immediate apprehension of
11 litigation and loss of its rights.

12 31. Defendants’ actions have impeded Sur La Table’s operations.

13 32. There now exists a substantial controversy, between parties having adverse legal
14 interests, of sufficient immediacy and reality to convey jurisdiction upon this Court. The current
15 dispute is definite and concrete, real and substantial.

16 **FIRST CLAIM**
17 **DECLARATORY JUDGMENT OF NON-INFRINGEMENT**

18 33. Plaintiff realleges and incorporates by reference the allegations contained in
19 paragraphs 1 through 32 as if fully set forth herein.

20 34. There is an actual common justiciable controversy between Plaintiff Sur La Table
21 and Defendants Burberry U.S.A. and Burberry U.K. regarding the right of Sur La Table to
22 continue to display, offer to sell and sell the Poodle Apron.

23 35. There is nothing suggestive, fanciful or arbitrary about a lattice configuration.
24 There is nothing inherently distinctive about the generic lattice pattern, nor has the generic lattice
25 pattern without color designation acquired distinctiveness through secondary meaning.

26 36. Sur La Table is entitled to Declaratory Relief in the form of a judgment in its
27 favor and against Defendants holding under the Lanham Act and applicable state and federal

1 laws that: (a) Defendants' Claimed Trademarks are generic or merely decorative;
2 (b) Defendants' Claimed Trademarks in the generic lattice pattern are functional; (c) Defendants
3 have not made a showing of acquired distinctiveness in any of the Claimed Trademarks;
4 (d) Defendants have not made a showing of fame in any of the Claimed Trademarks; (e) Sur La
5 Table's use of the generic lattice pattern on an apron is decorative and is fair use; (f) Sur La
6 Table's display, offering for sale and sale of the Poodle Apron is fair use; (g) Sur La Table's
7 display, offering for sale and sale of the Poodle Apron is not likely to cause confusion and is not
8 an infringement of any of Defendants' Claimed Trademarks; (h) Defendants have waived any
9 right to enforce, or are estopped from enforcing, rights in Defendants' Claimed Trademarks.

10 **SECOND CLAIM**
11 **COMMON LAW UNFAIR COMPETITION**

12 37. Plaintiff realleges and incorporates by reference the allegations contained in
13 paragraphs 1 through 36 as if fully set forth herein.

14 38. The threats of infringement from Defendants have been made in an anti-
15 competitive effort to prevent Plaintiff from lawfully displaying, offering to sell and selling its
16 wares.

17 39. The above-described actions of Defendants constitute unfair competition under
18 the common law and subject the Plaintiff to irreparable injury and damages.

19 40. Sur La Table is entitled to award of its actual damages as a result of Defendants'
20 actions, an award of its attorneys' fees, costs and exemplary damages as provided by law arising
21 from this unfair competition.

22 **IV. PRAYER FOR RELIEF**

23 WHEREFORE, Plaintiff prays for relief as follows:

24 1. For judgment in favor of Plaintiff Sur La Table, Inc. against all Defendants on all
25 causes of action.

26 2. For a Declaratory Judgment holding that under the Lanham Act and applicable
27 state and federal laws, the Poodle Apron is not an infringement of Defendants' registered and/or

1 common law trademarks and that Defendants have waived any right to enforce any infringement
2 of Defendants' trademarks.

3 3. For damages, in an amount to be determined at trial, resulting from Defendants'
4 unlawful and anti-competitive acts.

5 4. For exemplary or punitive damages as provided by common law.

6 5. That Plaintiff Sur La Table, Inc. be awarded the costs of this civil action, together
7 with its reasonable attorney fees, both pursuant to 15 U.S.C. § 1116 and/or § 1117 and the
8 equity powers of the Court.

9 6. That Plaintiff Sur La Table be awarded such other and further relief as the Court
10 may deem equitable and proper.

11 **JURY DEMAND**

12 Plaintiff Sur La Table, Inc. requests a jury trial on all issues so triable.

13
14 DATED this 21st day of May, 2010.

15 STOKES LAWRENCE, P.S.

16
17 By: s/ Justo G. Gonzalez
18 Leslie C. Ruitter (WSBA #28090)
19 Justo G. Gonzalez (WSBA #39127)
20 Attorneys for Plaintiff Sur La Table, Inc.

EXHIBIT 1



SIGN IN / REGISTER
MY ACCOUNT
TRACK AN ORDER
GIFT CARDS

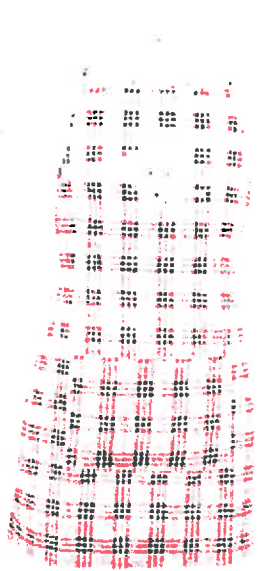
SHOPPING CART
0 Items \$0.00

Search keyword

TABLETOP & SERVING | BAKEWARE | COOKWARE | CUTLERY | KITCHEN & BAR TOOLS | ELECTRICS | COFFEE & TEA | BOOKS & FOOD | HOUSE

Home | Housewares | Chefs Clothing & Aprons | Children's Pink Plaid and Poodle Apron

◀ Previous



ZOOM | ADDITIONAL VIEWS

Children's Pink Plaid and Poodle Apron

Fun for baking projects, this child-size apron is a charming way to spend time in the kitchen. Delightful pink plaid is complemented by a poodle appliqué. Features a roomy pocket to carry kitchen tools. Washable cotton. Made in the USA.

ShareThis

Product

Qty

EXCLUSIVE

1

Children's Pink Plaid and Poodle Apron, 20"

In Stock

DETAILS



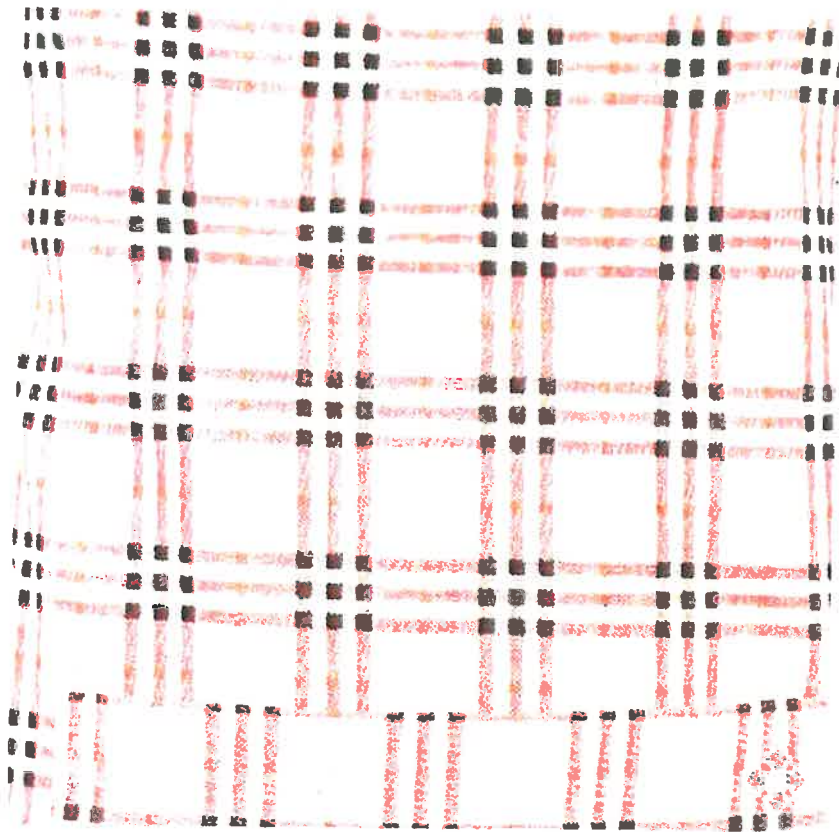
FEATURES

- Care: Machine wash cold; tumble dry low
- Dimensions: 20" length
- Material: Cotton

BENEFITS:

- Great for family baking projects.
- Pink plaid print with poodle appliqué.
- Features a pocket for carrying tools
- Made in the USA

OTHER PRODUCTS YOU MAY LIKE



Click on tools to the right to zoom in, zoom out and reset the image. Click and drag on the image to pan.



ZOOM IN



ZOOM OUT



RESET

CLOSE WINDOW

EXHIBIT 2

APR 1 2010

BURBERRY

APR 1 2010

VIA UPS

Jack Schwefel
President
Sur La Table, Inc.
5701 Sixth Avenue South
Suite 486
Seattle, WA 98108
(206) 613-6000

15 April 2010

Re: **Trademark Infringement**
Burberry Reference No. US3454

Dear Mr. Schwefel:

I am writing on behalf of Burberry Limited ("Burberry"). As you are probably aware, Burberry is a global luxury brand company involved in the design, manufacture, advertising, distribution and sale of high quality clothing, handbags and accessories. Over the past 80 years, Burberry has continuously used in connection with its products a distinctive check trademark (the "BURBERRY CHECK").

In recognition of our exclusive rights to our BURBERRY CHECK, the United States Patent and Trademark Office has granted Burberry several federal trademark registrations for a variety of products, including clothing, accessories, scarves, handbags, travel bags, wallets, pet accessories, golf accessories and umbrellas. I attach hereto exemplars of our federal trademark registrations. These federal registrations are *prima facie* evidence of the validity of our marks and of our ownership and exclusive right to use these marks. See United States Trademark Act, 15 U.S.C. §§ 1057(b), 1115(a) and 1072. Please note that Burberry also enjoys significant common law (unregistered) rights in its BURBERRY CHECK trademark for a wide variety of colors and products (See 15 U.S.C. § 1125(a)).

It has come to our attention that Sur La Table is offering for sale "Children's Pink Plaid and Poodle Aprons" that display identical representations of the BURBERRY CHECK trademark and are therefore infringing. See, e.g., attached printouts from Sur La Table website. For comparison purposes, I have also attached exemplars of genuine Burberry merchandise displaying the BURBERRY CHECK trademark.

Your company's unauthorized use of Burberry's registered trademark constitutes federal counterfeiting and infringement under 15 U.S.C. § 1114(1)(a), false representations, false designations of origin, trade dress infringement and federal unfair competition under 15 U.S.C. § 1125(a), federal dilution under 15 U.S.C. § 1125(c) and related legal violations under the laws of various states.

Under the law, Burberry is entitled to an injunction against Sur La Table's further offer for sale of merchandise bearing infringements of the BURBERRY CHECK trademark, delivery and destruction of your inventory of such products and the means for making same.

an award of your profits from the sale of the counterfeit and infringing items and an award of Burberry's actual damages from the infringement.

Moreover, in view of the extraordinary exposure of Burberry's products, it is likely that your company has known of Burberry and its famous BURBERRY CHECK trademark, and your use of our trademark would therefore be considered a willful attempt to benefit from our substantial goodwill or at the very, least a reckless and callous disregard of our rights. Therefore, in addition to the remedies noted above, Burberry would also be entitled to treble damages and an award of attorneys' fees in this matter. See 15 U.S.C. § 1117.

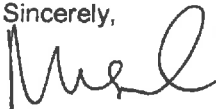
At this point, Burberry is willing to resolve this matter amicably, but it simply cannot allow the continued counterfeiting, infringement and dilution of its valuable federally registered trademark. Accordingly, we must insist that **your company immediately stop** the manufacture, distribution, and offer for sale of the subject products and all other items bearing our BURBERRY CHECK trademark or variations thereof and that, **within seven (7) days** of the date of this letter, I receive the following:

- (1) Your company's **written assurance** that it has ceased sales and offers for sale of all goods displaying the BURBERRY CHECK and has ceased and shall not recommence the unauthorized use of our mark or variations thereof;
- (2) A written statement detailing the entirety of your company's dealings in the subject merchandise, including the **quantities purchased, sold and remaining**;
- (3) A disclosure of your company's supplier(s) through copies of documents including **purchase orders, invoices and receipts**; and
- (4) **Delivery of all counterfeit and infringing inventories**, including any recalled product, for our destruction. **(DO NOT return or otherwise dispose of any remaining inventory pending resolution of this matter.)**

Upon receipt of this information, Burberry will be in a position to calculate an amount as monetary settlement. However, if you do not comply with our demands, Burberry will have no choice but to consider its legal and/or equitable remedies in this matter.

This letter does not constitute a complete statement of Burberry's claims, rights, or remedies with respect to this matter, all of which are hereby expressly reserved.

Sincerely,

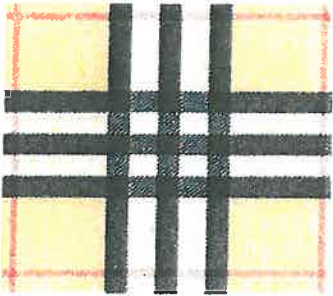
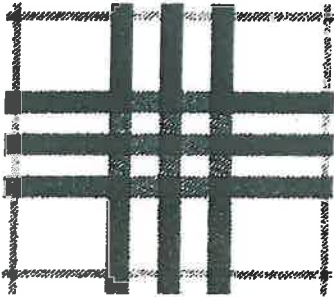



Melissa Roth
Intellectual Property Counsel - Americas

melissa.roth@burberry.com
Tel +1 212 707 6633
Fax +1 212 707 6561

Enclosures

**SELECT LISTING OF BURBERRY LIMITED'S
REGISTERED TRADEMARKS***

Registered Mark	United States Reg. Nos.
<p>The BURBERRY word mark:</p> <p align="center">BURBERRY</p>	<p>1,133,122; 260,843; 259,571; 1,607,316; 1,828,277; 2,629,931; 2,875,336</p>
<p>The BURBERRY CHECK trademark:</p> 	<p>1,241,222 2,022,789 1,855,154 2,015,462 2,689,921 2,845,852 3,529,814</p>
<p>The BURBERRY CHECK (no color designation) trademark:</p> 	<p>2,612,272 2,732,617 2,728,709</p>
<p>The EQUESTRIAN KNIGHT DEVICE trademark:</p> 	<p>862,816 863,179 1,622,186 2,952,399 2,512,119</p>

*Burberry Limited has its trademarks registered in all major markets, not necessarily included in the chart above.

Last Revised: November 20, 2009



SIGN IN / REGISTER
MY ACCOUNT
TRACK AN ORDER
GIFT CARDS

SHOPPING CART
0 items \$0.00

Search keyword

TABLETOP & SERVING BAKEWARE COOKWARE CUTLERY KITCHEN & BAR TOOLS ELECTRICS COFFEE & TEA BOOKS & FOOD HOUSE

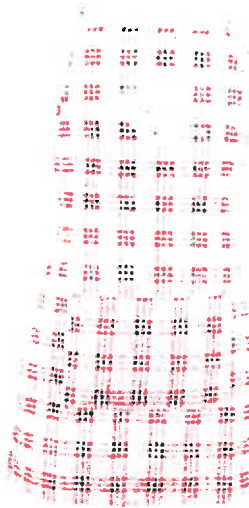
Home | Housewares | Chefs Clothing & Aprons | Children's Pink Plaid and Poodle Apron

◀ Prev

Children's Pink Plaid and Poodle Apron

Fun for baking projects, this child-size apron is a charming way to spend time in the kitchen. Delightful pink plaid is complemented by a poodle appliqué. Features a roomy pocket to carry kitchen tools. Made in the USA.

ShareThis



20" APRON

Product

EXCLUSIVE

Children's Pink Plaid and Poodle Apron, 20"

In Stock

Qty

1

Shipping & taxes



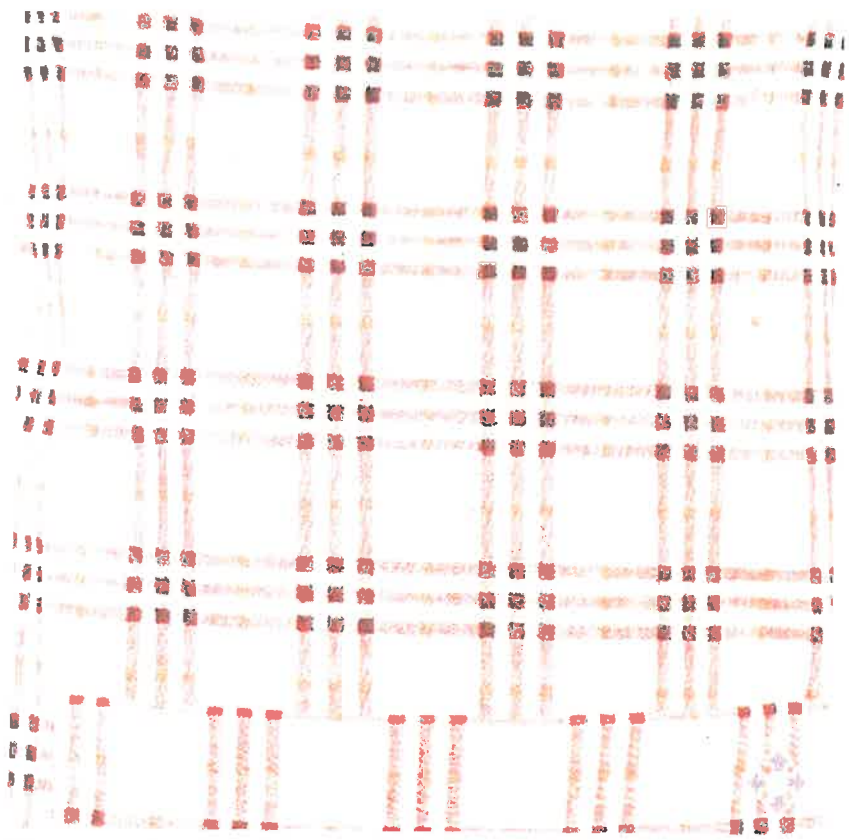
FEATURES

- Care: Machine wash cold, tumble dry low
- Dimensions: 20" length
- Material: Cotton

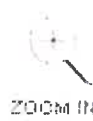
BENEFITS

- Great for family baking projects
- Pink plaid print with poodle appliqué
- Features a pocket for carrying tools
- Made in the USA

OTHER PRODUCTS YOU MAY LIKE



Click on tools to the right to zoom in, zoom out and reset the image. Click and drag on the image to pan.



ZOOM IN



ZOOM OUT



RESET

© 2001 www.surla.com

AUTHENTIC BURBERRY MERCHANDISE
DISPLAYING THE BURBERRY CHECK TRADEMARK

