

**IN THE UNITED STATES DISTRICT COURT
FOR THE MIDDLE DISTRICT OF PENNSYLVANIA**

WOOLRICH, INC. and JOHN	:	
RICH & SONS INVESTMENT	:	
HOLDING COMPANY	:	CIVIL ACTION
	:	NO.
Plaintiffs,	:	
	:	
v.	:	JURY TRIAL DEMANDED
	:	FOR THOSE COUNTS FOR
EDDIE BAUER, INC.	:	WHICH RIGHTS TO JURY
	:	TRIAL EXIST
Defendant.	:	

COMPLAINT

Plaintiffs Woolrich, Inc. and John Rich & Sons Investment Holding Company for their complaint, state as follows:

INTRODUCTION

1. This is a civil action for injunctive relief, damages, and other statutory relief based on trademark infringement, misappropriation, unfair competition/false designation of origin, deceptive trade practices, and trademark dilution of a famous

mark used on and in close connection with the sale and marketing of a wide variety of retail outdoor products by Plaintiffs, comprised primarily of outdoor clothing, related garments, and accessories. As set forth more fully below, Plaintiffs have long used the federally registered mark THE ORIGINAL OUTDOOR CLOTHING COMPANY® in marketing and sales of their products throughout the United States and in this District. Through their predecessors, Plaintiffs have been marketing and selling quality clothing products in the United States and in this District continuously since 1830. In or about October, 2008, Defendant began use of a mark, THE ORIGINAL OUTDOOR OUTFITTER™, in direct competition with Plaintiffs and through the same channels of trade used by Plaintiffs in violation of a federally registered and legally protectable trademark owned by Plaintiff John Rich & Sons Investment Holding Company. Specifically, Plaintiffs allege that Defendant is infringing upon and diluting the valuable and famous federally registered trademark, THE ORIGINAL OUTDOOR CLOTHING COMPANY®, in violation of federal and Pennsylvania law.

PARTIES

2. The Plaintiff Woolrich, Inc. (hereinafter “Woolrich”) is a corporation organized and existing pursuant to the laws of the Commonwealth of Pennsylvania with its principal place of business located at 2 Mill Street, Woolrich, Clinton

County, Pennsylvania 17779. Woolrich conducts business throughout the United States and in this District.

3. The Plaintiff John Rich & Sons Investment Holding Company (hereinafter “JRS”) is a corporation organized and existing pursuant to the laws of the State of Delaware with its principal place of business located at 103 Foulk Road, Suite 200, Wilmington, Delaware 19803.

4. JRS conducts business throughout the United States and in this District.

5. Defendant Eddie Bauer, Inc. (hereinafter “Defendant”) is a corporation organized and existing pursuant to the laws of the State of Delaware with its principal place of business located at 10401 N.E. 8th Street, Bellevue, Washington 98004.

6. Defendant conducts business throughout the United States and in this District.

7. According to Defendant’s website, it owns and operates 9 retail stores within a 100 mile radius of Williamsport, Pennsylvania, including many in this District. *See* Defendant’s website Store Locator search results attached hereto as Exhibit “A.”

8. Defendant, upon information and belief, has caused or has been responsible for the hereinafter described actions of infringement and dilution.

JURISDICTION AND VENUE

9. This Court has jurisdiction under Section 39 of the Trademark Act of July 5, 1946 (“Lanham Act”), 15 U.S.C. §1121, and Sections 1331, 1338(a), and 1338(b) of the Judicial Code, 28 U.S.C. §§ 1331, 1338(a), and 1338(b), and related state law claims under the principles of supplementary jurisdiction. 28 U.S.C. §1367(a).

10. Venue is proper in this District under Section 1391(b) because Plaintiffs are located in this District, Defendant has retail establishments and regularly conducts business in this District, and a substantial part of the events giving rise to the claims occurred in this District.

BACKGROUND

11. Woolrich, through its predecessors, was formed in 1830 for the purposes of offering a wide variety of outdoor products for retail sale, including but not limited to outdoor clothing, garments, accessories, and products.

12. JRS is a wholly owned corporate subsidiary of Woolrich (collectively, hereinafter “Plaintiffs”). JRS owns a multitude of federally registered trademarks, including but not limited to the trademark infringed by Defendant, all of which are licensed to Woolrich and others.

13. JRS is the owner of federal registration number 2,821,096 for the trademark THE ORIGINAL OUTDOOR CLOTHING COMPANY®. This Registration is valid and protected under the Lanham Act, 15 U.S.C. §§ 1057 and 1115. A certified copy of the Registration is attached hereto as Exhibit “B.” Through its express licensing agreement with JRS, Woolrich has a commercial interest in and rights to use of the trademark THE ORIGINAL OUTDOOR CLOTHING COMPANY®.

14. Since 1997, Woolrich has sold and placed in commerce millions of high quality items bearing the trademark THE ORIGINAL OUTDOOR CLOTHING COMPANY®, with a dollar value greater than \$500,000,000.00.

15. Millions of catalogs and promotional pieces prominently featuring THE ORIGINAL OUTDOOR CLOTHING COMPANY® have been distributed to potential and actual customers within this District, and throughout the United States. JRS and Woolrich have used THE ORIGINAL OUTDOOR CLOTHING COMPANY® trademark to promote and advertise their retail products throughout the United States using a wide variety of media outlets, including print catalogs, point-of-sale, radio, internet catalogs, and trade magazine advertisements.

16. THE ORIGINAL OUTDOOR CLOTHING COMPANY® has been prominently displayed at trade shows, in Woolrich stores, at retail outlets for

Woolrich goods, and on bags for purchased Woolrich goods within this District and throughout the United States.

17. Woolrich has spent hundreds of thousands of dollars continuously and extensively advertising and promoting the trademark THE ORIGINAL OUTDOOR CLOTHING COMPANY® in various forms in connection with the sale of their products.

18. The value to JRS and Woolrich of the right to the use of the asserted trademark exceeds seventy-five thousand dollars (\$75,000).

19. Plaintiffs' advertising efforts utilizing THE ORIGINAL OUTDOOR CLOTHING COMPANY® trademark have resulted in public recognition that the trademark symbolizes its products in the marketplace.

20. By reason of continuous marketing and sales in the United States, the trademark THE ORIGINAL OUTDOOR CLOTHING COMPANY® has come to symbolize high quality retail products within the outdoor retail and clothing industry and identifies their source, and it is the Plaintiffs that have developed THE ORIGINAL OUTDOOR CLOTHING COMPANY® trademark to this high level of recognition in the market place.

21. THE ORIGINAL OUTDOOR CLOTHING COMPANY® trademark has become synonymous with Plaintiffs, which have used THE ORIGINAL

OUTDOOR CLOTHING COMPANY® trademark in marketing high quality products; and have been responsible for elevating the trademark and its reputation.

22. In this action, Plaintiffs allege and intend to prove that Defendant is intentionally infringing and diluting JRS' federally registered trademark, THE ORIGINAL OUTDOOR CLOTHING COMPANY® in bad faith with the intent to derive benefit from Plaintiffs' reputation.

23. Plaintiffs have utilized the mark THE ORIGINAL OUTDOOR CLOTHING COMPANY® since 1997. *See* Registration at Exhibit "B."

24. THE ORIGINAL OUTDOOR CLOTHING COMPANY® mark has become distinctive of Woolrich's goods/services through Plaintiffs' continuous use in commerce.

25. Registration of THE ORIGINAL OUTDOOR CLOTHING COMPANY® trademark was granted under registration number 2,821,096 by the USPTO on March 9, 2004. Accordingly, JRS' trademark is valid and legally protectable under the Lanham Act, 15 U.S.C. §§ 1057 and 1115.

26. Since 1997, Woolrich has sold goods covered by JRS' Federal Registration No. 2,821,096 for THE ORIGINAL OUTDOOR CLOTHING COMPANY® to the public through retail stores, print catalog sales, and internet catalog sales.

27. Since 2003, Woolrich has used THE ORIGINAL OUTDOOR CLOTHING COMPANY® to promote its sale of items of clothing and related goods through print catalogs and internet catalogs.

28. Since 1997, Woolrich has placed advertisements featuring THE ORIGINAL OUTDOOR CLOTHING COMPANY promoting its clothing and retail store, catalog and internet sales services, costing in the hundreds of thousands of dollars.

29. Since 1997, in excess of fifty (50) million Woolrich catalogs featuring THE ORIGINAL OUTDOOR CLOTHING COMPANY have been distributed to purchasers and prospective purchasers of Woolrich clothing and related goods throughout the United States.

30. By reason of Plaintiffs' continued use of THE ORIGINAL OUTDOOR CLOTHING COMPANY® mark for twelve (12) years, it has acquired distinctiveness and secondary meaning with retail store consumers, print catalog consumers, and on-line internet catalog consumers in the market place, such that the relevant public identifies THE ORIGINAL OUTDOOR CLOTHING COMPANY® trademark with Plaintiffs as a source of high quality outdoor products.

31. Defendant is in the business of selling clothing, related garments, and accessories for men and women relating to outdoor lifestyle. Upon information

and belief, Defendant sells its products in retail and outlet stores, through print catalogs, and through on-line internet catalogs at www.eddiebauer.com and www.eddiebaueroutlet.com in direct competition with Woolrich.

32. Beginning in December, 2007, upon information and belief, Defendant began implementing a plan for eventual use of a new mark, THE ORIGINAL OUTDOOR OUTFITTER™.

33. By use of a mark confusingly similar to THE ORIGINAL OUTDOOR CLOTHING COMPANY® mark, Defendant is attempting to trade off JRS' mark, which has been developed and established by Plaintiffs, and there exists a likelihood of confusion in the market place.

34. Specifically, on December 12, 2007, Defendant filed six (6) trademark registration applications with the USPTO for THE ORIGINAL OUTDOOR OUTFITTER™ on *an intent-to-use basis*, including, the following:

- a. Application Serial Number 77-350,552 under International Class 011 to identify flashlights and lamps;
- b. Application Serial Number 77-350,567 under International Class 16 to identify catalogs in the field of apparel and in the field of equipment for outdoor activities;

- c. Application Serial Number 77-350,571 under International Class 18 to identify backpacks, duffel bags, knap sacks, travel bags and luggage;
- d. Application Serial Number 77-350,574 under International Class 22 to identify tents;
- e. Application Serial Number 77350,593 under International Class 25 to identify clothing, namely jackets, parkas, coats, sweaters, vests, shirts, hats, gloves, scarves; and
- f. Application Serial Number 77-350,608 under International Class 35 to identify retail store services and on-line retail store services featuring apparel, clothing, accessories, backpacks, luggage, and gear and equipment for camping, hiking and outdoor sports.

35. On March 20, 2008, the USPTO issued Initial Office Actions rejecting Defendant's six (6) Applications. Application Number 77-350,593, for International Class 25 clothing, and Application Number 77-350,608, for International Class 35 retail and on-line retail store services featuring clothing, were rejected because of a likelihood of confusion with JRS' registered trademark number 2,821,096 for THE ORIGINAL OUTDOOR CLOTHING COMPANY®. All six (6) trademark Applications were rejected because THE ORIGINAL

OUTDOOR OUTFITTER was descriptive of the goods or services. True and correct copies of the USPTO Initial and Final Office Actions of March 20, 2008 and October 16, 2008 on Applications Numbers 77-350,593 (Class 25) and 77-350,608 (Class 25) are attached as Exhibit "C." (Because they are voluminous, the Initial and Final Office Actions included in Exhibit C do not contain attachments. The complete USPTO Initial and Final Office Actions, including attachments, are available at <http://www.uspto.gov/>.)

36. On September 22, 2008, Defendant filed responses to the USPTO Initial Office Actions in all six (6) Applications, arguing, *inter alia*, against the rejections. The responses in Application Number 77-350,593 and Application Number 77-350,608 discuss JRS' trademark THE ORIGINAL OUTDOOR CLOTHING COMPANY® and JRS' Federal Trademark Registration 2,821,096 for THE ORIGINAL OUTDOOR CLOTHING COMPANY®.

37. On October 16, 2008, the USPTO issued Final Office Actions in all six (6) of Defendant's trademark applications. In Application Number 77-350,593 and 77-350,608, the rejections based on JRS' registered mark THE ORIGINAL OUTDOOR CLOTHING COMPANY® were withdrawn. However, the USPTO Final Office Actions finally rejected all Defendant's Applications on the basis that Defendant's THE ORIGINAL OUTDOOR OUTFITTER™ mark is merely

descriptive under Section 2(e) of the Trademark Act, 15 U.S.C. § 1052(e); TMEP §§ 1209 *et seq.* See Exhibit “C.”

38. On November 5, 2008, Defendant filed amendments in Application Numbers 77-350,608, 77-350,593, 77-350,571 and 77-350,567, filing proof of use of the marks in interstate commerce and amendments converting the applications from the Principal Register to the Supplemental Register.

39. On December 16, 2008, the USPTO issued Defendant’s Application Numbers 77-350,608, 77-350,593, 77-350,571 and 77-350,567 as Registrations on the Supplemental Register Numbers 3,548,488, 3,548,487, 3,548,486 and 3,548,485 respectively, attached as Exhibit “D”. Defendant’s Application Numbers 77-350,552 and 77-350,574 remain pending. Defendant may respond to the October 16, 2008 Official Office Actions in these Applications up to April 26, 2009.

40. Although the USPTO’s disposition of Defendant’s Applications is not yet final, Defendant’s adoption and continued use of the offending mark, which use continues as of today, clearly evidences knowledge and, thus, willful and intentional infringement of JRS’ registered mark.

41. Upon information and belief, Defendant began its use of THE ORIGINAL OUTDOOR OUTFITTER™ mark in or about October, 2008.

42. Since that time, Defendant has advertised its products using THE ORIGINAL OUTDOOR OUTFITTER™ and sold products marked with THE ORIGINAL OUTDOOR OUTFITTER™ throughout the United States and in this District.

43. Upon information and belief, an overwhelming number of the goods offered by Defendant for sale through use of THE ORIGINAL OUTDOOR OUTFITTER™ mark are goods specifically registered on JRS' Registration Number 2,821,096, including, but not limited to:

- a. The following products or goods that include a label or hang tag bearing THE ORIGINAL OUTDOOR OUTFITTER™: shirts, pants, socks, jackets, vests, shoes, shirts (sportswear), pullovers (outerwear), and scarves (outerwear). *See, e.g.*, Exhibit "E," an Eddie Bauer hang tag bearing THE ORIGINAL OUTDOOR OUTFITTER used on an Eddie Bauer jacket sold in this District;
- b. The following products or goods offered for sale on a website that includes THE ORIGINAL OUTDOOR OUTFITTER™: shirts, tank tops, sweaters, t-shirts, cardigans, pants, shorts, jumpers, skirts, jeans, socks, bathing suits, coats, jackets, parkas, vests, hats, caps, baseball caps, belts, gloves, sandals,

slippers, shoes, scarves, robes, shirts (sportswear), henleys (sportswear), t-shirts (sportswear), jumpers (sportswear), skirts (sportswear), turtlenecks (sportswear), vests (sportswear), sweat shirts (sportswear), thermal pullovers (sportswear), sweaters (sportswear), cardigans (sportswear), pants (sportswear), jeans (sportswear), cargo pants (sportswear), coats (sportswear), jackets (sportswear), belts (sportswear), jackets (outerwear), coats (outerwear), pants (outerwear), parkas (outerwear), turtlenecks (outerwear), vests (outerwear), pullovers (outerwear), cardigans (outerwear), caps (outerwear), hats (outerwear), gloves (outerwear), scarves (outerwear), and earbands (outerwear). *See* Exhibit “F,” a screen taken from the Eddie Bauer website showing use of THE ORIGINAL OUTDOOR OUTFITTER™; and

- c. The following products or goods, among others, are offered for sale through an Eddie Bauer Fall 2008 print catalog bearing THE ORIGINAL OUTDOOR OUTFITTER™: shirts, tank tops, sweaters, t-shirts, pants, shorts, skirts, tunics, jeans, socks, coats, jackets, parkas, vests, hats, caps, belts, shoes, shirts (sportswear), tank tops (sportswear), t-shirts (sportswear),

turtlenecks (sportswear), vests (sportswear), sweatshirts (sportswear), pullovers (sportswear), pants (sportswear), cargo pants (sportswear), jackets (outerwear), coats (outerwear), pants (outerwear), vests (outerwear), pullovers (outerwear), hats (outerwear). *See* Exhibit “G,” the inside cover page from the Eddie Bauer Fall 2008 print catalog showing use of THE ORIGINAL OUTDOOR OUTFITTER™.

44. Defendant began use of THE ORIGINAL OUTDOOR OUTFITTER™ in connection with the promotion and sale of these goods with full knowledge of the long standing prior use and Federal Registration of THE ORIGINAL OUTDOOR CLOTHING COMPANY® mark by Plaintiffs.

45. Upon information and belief, at or about the time that it began its use of THE ORIGINAL OUTDOOR OUTFITTER™ mark, Defendant also embarked on a web-based advertising campaign targeting consumers searching for Woolrich products in order to promote Defendant’s products through the infringing confusingly similar mark.

46. Upon information and belief, in or about October, 2008, Defendant paid for a ranking with Yahoo.com’s keyword advertising service under which the subscriber (the Defendant) designates “keyword[s]” related to its products. When

a web searcher types the subscriber's designated "keyword" into the Yahoo! search box, the subscriber's advertisement appears.

47. Upon information and belief, in its engagement of the Yahoo.com service, Defendant designated "Woolrich" as a "keyword" to trigger display of its advertisement in the user's search results for Woolrich products. As a result, web users searching for "Woolrich" in the Yahoo! search box were greeted with an Eddie Bauer advertisement complete with THE ORIGINAL OUTDOOR OUTFITTER™ mark prominently displayed in banner form at the top of the search results. A copy of Yahoo "Woolrich" search results are attached as Exhibit "H."

48. Defendant's advertising scheme patently targeted consumers who were searching for Plaintiffs' brand name in order to introduce them to Defendant's THE ORIGINAL OUTDOOR OUTFITTER™ mark so as to associate Eddie Bauer and its products with the famous THE ORIGINAL OUTDOOR CLOTHING COMPANY® mark and create initial interest confusion.

49. Defendant's use of THE ORIGINAL OUTDOOR OUTFITTER™ to identify the Defendant's products presents a direct and unlawful act of infringement and, upon information and belief, is likely to cause or may have already caused actual confusion in the market place.

COUNT I
FEDERAL TRADEMARK INFRINGEMENT, 15 U.S.C. § 1114

PLAINTIFF JOHN RICH & SONS INVESTMENT
HOLDING COMPANY v. EDDIE BAUER, INC.

50. Plaintiffs incorporate by reference their allegations set forth in Paragraphs 1 through 49 as if set forth at length herein.

51. On March 9, 2004, THE ORIGINAL OUTDOOR CLOTHING COMPANY® trademark was granted to JRS under registration number 2,821,096 by the USPTO and, therefore, is valid and legally protectable under the Lanham Act, 15 U.S.C. §§ 1057 and 1115.

52. Plaintiffs' use of THE ORIGINAL OUTDOOR CLOTHING COMPANY® mark predates any alleged use by Defendant in the United States.

53. By Defendant's use of THE ORIGINAL OUTDOOR OUTFITTER™, the Defendant has imitated, counterfeited, and infringed upon JRS' THE ORIGINAL OUTDOOR CLOTHING COMPANY® mark in violation of Section 32 of the Lanham Act, 15 U.S.C. §1114.

54. Defendant's use of THE ORIGINAL OUTDOOR CLOTHING COMPANY® mark is without JRS' consent.

55. Upon information and belief, with actual notice and knowledge of JRS' rights to THE ORIGINAL OUTDOOR CLOTHING COMPANY®

trademark, Defendant began bad faith infringement of JRS' trademark in violation of the Lanham Act in or about October, 2008.

56. Upon information and belief, with a deliberate attempt to create confusion in the market place, Defendant continues to utilize THE ORIGINAL OUTDOOR OUTFITTER™ mark in marketing of identical and related goods through retail store sale, print catalog sale, and internet catalog sale in direct competition with Woolrich in an attempt to palm off its goods as originating from Plaintiffs.

57. Defendant's use of THE ORIGINAL OUTDOOR OUTFITTER™ mark has or is likely to cause confusion, mistake, or deception as to the affiliation, connection, or association of Defendant with Plaintiffs and is likely to cause confusion, mistake, deception as to the origin, sponsorship, or approval of Defendant's products with those of the Plaintiffs.

58. By reason of Defendant's recent use in commerce of JRS' registered trademark, upon information and belief, actual acts of confusion are likely to occur and may have already occurred causing JRS irreparable harm.

59. Unless Defendant's acts are restrained and enjoined by this Court, JRS will continue to be irreparably harmed.

COUNT II
FEDERAL UNFAIR COMPETITION/
FALSE DESIGNATION OF ORIGIN, 15 U.S.C. § 1125(a)

PLAINTIFFS JOHN RICH & SONS INVESTMENT
HOLDING COMPANY AND WOOLRICH, INC. v. EDDIE BAUER, INC.

60. Plaintiffs incorporate by reference their allegations set forth in Paragraphs 1 through 59 as if set forth at length herein.

61. Defendant's use of THE ORIGINAL OUTDOOR OUTFITTER™ trademark has deceived and caused, and is likely to deceive and cause, confusion and mistake among customers as to the source and origin of the goods offered for sale by Defendant and the sponsorship or endorsement of those goods by Plaintiffs in violation of Section 43(a) of the Lanham Act, 15 U.S.C. § 1125(a).

62. By reason of Defendant's recent conduct, upon information and belief, actual acts of confusion are likely to occur and may have already occurred.

63. Upon information and belief, with actual prior notice and knowledge of JRS' rights to THE ORIGINAL OUTDOOR CLOTHING COMPANY® trademark, Defendant knowingly and in bad faith adopted and continues to use THE ORIGINAL OUTDOOR OUTFITTER™ mark. Defendant's acts of unfair competition are intentionally designed to misappropriate the established good will long associated with Plaintiffs.

64. Defendant's use of THE ORIGINAL OUTDOOR OUTFITTER™ trademark is without JRS' consent.

65. Defendant has misappropriated JRS' substantial property rights and Woolrich's commercial interest in THE ORIGINAL OUTDOOR CLOTHING COMPANY® trademark as well as the good will associated therewith.

66. Unless restrained and enjoined by this Court, Defendant will be permitted to represent its products as being produced, sponsored, or authorized by Plaintiffs.

67. The acts of Defendant set forth above were committed willfully with the full knowledge of the rights and commercial interests of Plaintiffs with the intent of deceiving and misleading the public.

68. As a result of Defendant's wrongful acts alleged herein, Plaintiffs have been or are likely to be damaged and/or irreparably harmed.

COUNT III
COMMON LAW TRADEMARK INFRINGEMENT
PLAINTIFF JOHN RICH & SONS INVESTMENT
HOLDING COMPANY v. EDDIE BAUER, INC.

69. Plaintiffs incorporate by reference their allegations set forth in Paragraphs 1 through 68 as if set forth at length herein.

70. Plaintiffs' use of THE ORIGINAL OUTDOOR CLOTHING COMPANY® mark predates any alleged use by Defendant in the United States.

71. By Defendant's use of THE ORIGINAL OUTDOOR OUTFITTER™, the Defendant has imitated, counterfeited, and infringed upon JRS' THE ORIGINAL OUTDOOR CLOTHING COMPANY® mark in violation of Pennsylvania law.

72. Defendant's use of THE ORIGINAL OUTDOOR CLOTHING COMPANY® mark is without JRS' consent.

73. Upon information and belief, with actual knowledge of JRS' rights to THE ORIGINAL OUTDOOR CLOTHING COMPANY® trademark, Defendant began bad faith infringement of JRS' trademark in violation of Pennsylvania law in or about October, 2008.

74. Upon information and belief, with a deliberate attempt to create confusion in the market place, Defendant continues to utilize THE ORIGINAL OUTDOOR OUTFITTER™ mark in marketing of identical and related goods through retail store sale, print catalog sale, and internet catalog sale in direct competition with Woolrich in an attempt to palm off its goods as originating from Plaintiffs.

75. Defendant's use of THE ORIGINAL OUTDOOR OUTFITTER™ mark has or is likely to cause confusion, mistake, or deception as to the affiliation, connection, or association of Defendant with Plaintiffs and is likely to cause

confusion, mistake, or deception as to the origin, sponsorship, or approval of Defendant's products with those of Plaintiffs.

76. By reason of Defendant's recent use in commerce of JRS' registered trademark, upon information and belief, actual acts of confusion are likely to occur and may have already occurred causing JRS irreparable harm.

77. Unless Defendant's acts are restrained and enjoined by this Court, JRS will continue to be irreparably harmed.

COUNT IV
FEDERAL TRADEMARK DILUTION, 15 § U.S.C. 1125

PLAINTIFFS JOHN RICH & SONS INVESTMENT
HOLDING COMPANY v. EDDIE BAUER, INC.

78. Plaintiffs incorporate by reference their allegations set forth in Paragraphs 1 through 77 as if set forth at length herein.

79. THE ORIGINAL OUTDOOR CLOTHING COMPANY® mark has acquired fame in the United States and within this District.

80. The mark has acquired strong distinctiveness based upon its widespread use and recognition by the relevant public.

81. Defendant began using THE ORIGINAL OUTDOOR OUTFITTER™ mark after JRS' THE ORIGINAL OUTDOOR CLOTHING COMPANY® mark became famous.

82. A high degree of similarity exists between THE ORIGINAL OUTDOOR OUTFITTER™ mark and JRS' famous mark, THE ORIGINAL OUTDOOR CLOTHING COMPANY®.

83. Through its employment of Yahoo.com's keyword advertising service, Defendant knowingly and intentionally acted to create an association of its products with the famous JRS trademark.

84. When it paid for a ranking on Yahoo.com's service, Defendant took affirmative action to designate "Woolrich" as a keyword in order to trigger the display of its advertisement including THE ORIGINAL OUTDOOR OUTFITTER™ mark in the search results. *See* Exhibit "H."

85. By these actions, Defendant orchestrated a system under which consumers searching for Plaintiffs' products were prominently greeted with THE ORIGINAL OUTDOOR OUTFITTER™ mark so as to associate Eddie Bauer and its products with Plaintiffs and the famous JRS trademark.

86. Through the employment of the Yahoo.com service and otherwise, Defendant's use of THE ORIGINAL OUTDOOR OUTFITTER™ mark has and is blurring the unique association between Plaintiffs' goods and JRS' famous trademark.

87. Defendant's use of THE ORIGINAL OUTDOOR OUTFITTER™ mark is willfully diluting or likely to dilute JRS' famous trademark THE

ORIGINAL OUTDOOR CLOTHING COMPANY® by disparaging the distinctive quality of JRS' trademark.

88. Defendant's use of THE ORIGINAL OUTDOOR OUTFITTER™ mark is causing dilution of the distinctive quality of THE ORIGINAL OUTDOOR CLOTHING COMPANY® trademark lessening the capacity of JRS' mark to identify and distinguish Plaintiffs' products in violation of Section 43(c) of the Lanham Act, 15 U.S.C. § 1125(c).

89. Defendant's use of THE ORIGINAL OUTDOOR OUTFITTER™ mark is willfully diluting or likely to dilute JRS' famous trademark THE ORIGINAL OUTDOOR CLOTHING COMPANY by tarnishing the distinctive quality of JRS' trademark.

90. Defendant's actions were, and remain, willfully and deliberately intended to trade on the reputation of JRS in the market place.

91. As a result of Defendant's wrongful acts alleged herein, Plaintiff has and continues to be or is likely to be irreparably harmed.

COUNT V
STATE LAW DILUTION, 54 PA. CONS. STAT. ANN. § 1124 (PURDON 1999
SUPP.)

PLAINTIFFS JOHN RICH & SONS INVESTMENT
HOLDING COMPANY v. EDDIE BAUER, INC.

92. Plaintiffs incorporate by reference their allegations set forth in Paragraphs 1 through 91 as if set forth at length herein.

93. THE ORIGINAL OUTDOOR CLOTHING COMPANY® has acquired fame in the Commonwealth of Pennsylvania.

94. THE ORIGINAL OUTDOOR CLOTHING COMPANY® has acquired strong distinctiveness based upon its widespread use and recognition by the relevant public in the Commonwealth of Pennsylvania.

95. Defendant began using THE ORIGINAL OUTDOOR OUTFITTER™ mark after JRS' THE ORIGINAL OUTDOOR CLOTHING COMPANY® mark became famous.

96. Defendant's use of THE ORIGINAL OUTDOOR OUTFITTER™ mark is blurring the unique association between Plaintiffs' goods and JRS' famous trademark.

97. Defendant's use of THE ORIGINAL OUTDOOR OUTFITTER™ mark is tarnishing the distinctive quality of JRS' trademark.

98. Defendant's use of THE ORIGINAL OUTDOOR OUTFITTER™ mark is disparaging the distinctive quality of JRS' trademark.

99. Defendant's use of THE ORIGINAL OUTDOOR OUTFITTER™ mark has caused dilution of the distinctive quality of THE ORIGINAL OUTDOOR CLOTHING COMPANY® trademark lessening the capacity of JRS' mark to identify and distinguish Plaintiffs' products.

100. Defendant's actions were, and remain, willfully and deliberately intended to trade on the reputation of JRS in the market place.

101. As a result of Defendant's wrongful acts alleged herein, JRS has and continues to be or is likely to be irreparably harmed.

COUNT VI
CANCELLATION OF DEFENDANT'S TRADEMARK APPLICATIONS
AND REGISTRATIONS
15 U.S.C. §§ 1092 AND 1119

PLAINTIFF JOHN RICH & SONS INVESTMENT
HOLDING COMPANY v. EDDIE BAUER, INC.

102. Plaintiffs incorporate by reference their allegations set forth in Paragraphs 1 through 101 as if set forth at length herein.

103. This Court has authority under Sections 24 and 37 of Lanham Act, 15 U.S.C. §§ 1092 and 1119, to order cancellation of Defendant's Supplemental Register Registration Numbers 3,548,485, 3,548,486, 3,548,487 and 3,548,488 and applications for THE ORIGINAL OUTDOOR OUTFITTER™, and to order

cancellations of any registrations resulting from Application Numbers 77-340,552 and 77-350,574.

104. THE ORIGINAL OUTDOOR CLOTHING COMPANY® mark has acquired fame in the United States and within this District.

105. The mark has acquired strong distinctiveness based upon its widespread use and recognition by the relevant public.

106. Defendant began using THE ORIGINAL OUTDOOR OUTFITTER™ mark after JRS' THE ORIGINAL OUTDOOR CLOTHING COMPANY® mark became famous.

107. A likelihood of confusion exists between THE ORIGINAL OUTDOOR OUTFITTER™ mark for the goods and services of Defendant's applications and registrations and JRS' established and famous mark, THE ORIGINAL OUTDOOR CLOTHING COMPANY®.

108. Defendant's THE ORIGINAL OUTDOOR OUTFITTER™ mark blurs the unique association between JRS' goods and its famous trademark.

109. Defendant's THE ORIGINAL OUTDOOR OUTFITTER™ mark tarnishes the distinctive quality of JRS' trademark.

110. Defendant's use of THE ORIGINAL OUTDOOR OUTFITTER™ mark has caused dilution of the distinctive quality of JRS' trademark by lessening

the capacity of Plaintiffs to identify and distinguish Plaintiffs' products in violation of Section 43(c) of the Lanham Act, 15 U.S.C. §1125(c).

111. As a result of Defendant's wrongful acts alleged herein, JRS has and continues to be actually and irreparably harmed.

COUNT VII
COMMON LAW UNFAIR COMPETITION

PLAINTIFFS JOHN RICH & SONS INVESTMENT
HOLDING COMPANY AND WOOLRICH, INC. v. EDDIE BAUER, INC.

112. Plaintiffs incorporate by reference their allegations set forth in Paragraphs 1 through 111 as if set forth at length herein.

113. Upon information and belief, Defendant, by its acts alleged herein, has deliberately calculated to deceive, and has deceived, the relevant trade and public into accepting and purchasing Defendant's products in the mistaken belief that the products are Plaintiffs' products or that they are sponsored by, connected with, or produced under the supervision of Plaintiffs.

114. Upon information and belief, Defendant, by its acts alleged herein, has intentionally attempted to pass off Defendant's products for those of Plaintiffs.

115. Plaintiffs have suffered and will continue to suffer or are likely to suffer actual and irreparable harm and damage as a result of Defendant's willful acts alleged herein.

WHEREFORE, Plaintiffs demand judgment as follows:

1. Enjoining Defendant, its officers, agents, servants, employees, attorneys, successors, affiliates, subsidiaries, assigns, and all those in active concert or participation with Defendant from the following acts within the United States or intended for dissemination within the United States:

- a. Using or authorizing any third party to use as a trademark, service mark, domain name, business name, trade name, or symbol of origin of THE ORIGINAL OUTDOOR OUTFITTER™ or any other mark or phrase incorporating any portion or any counterfeit, copy, simulation, confusingly similar variation, or colorable imitation of JRS' trademark, ORIGINAL OUTDOOR CLOTHING COMPANY®, in any manner or form, or in connection with any business, products, or services, or in the marketing, advertising, and promotion of same;
- b. Making or displaying any statement or representation that is likely to lead the public or the trade to believe that Defendant's goods are in

any manner associated or affiliated with or approved, endorsed, licensed, sponsored, authorized or franchised by, or are otherwise connected with Plaintiffs;

- c. Diluting, or likely diluting, the distinctive quality of JRS' trademark;
 - d. Using or authorizing any third party to use in connection with the rendering, offering, advertising, or promotion of any goods, any false description, false representation, or false designation of origin, or any marks, names, words, symbols, or devices that falsely associate such goods or services with Plaintiffs or tend to do so;
 - e. Engaging in any other activity constituting unfair competition with Plaintiffs, or constituting an infringement of JRS' registered trademark ORIGINAL OUTDOOR CLOTHING COMPANY® or any of Plaintiffs' rights therein;
- and

f. Aiding, assisting, or abetting any other party in doing any act prohibited by sub-paragraphs (a) – (e).

2. Direct the USPTO to cancel any trademark registration rights or entitlement of Defendant, including any Supplemental Register registrations for the THE ORIGINAL OUTDOOR OUTFITTER™ mark, including Registration Numbers 3,548,485, 3,548,486, 3,548,487 and 3,548,488 and Application Numbers 77-350,552 and 77-350,574, and any registrations resulting from pending Application Numbers 77-350,552 and 77-350,574.

3. Directing such other relief as the Court may deem appropriate to prevent the trade and public from deriving the erroneous impression that any product sold, distributed, or otherwise offered, circulated, or promoted by Defendant is authorized by Plaintiffs or related in any way to Plaintiffs' products;

4. Directing that Defendant file with the Court and serve upon Plaintiffs' counsel within thirty (30) days after entry of such judgment, a report in writing under oath, setting forth in detail the manner and form in which Defendant has complied therewith, including:

- a. Destroying all materials bearing any of THE ORIGINAL OUTDOOR OUTFITTER™, including but not limited to signs, brochures, packages, advertisements, flyers, testimonials, correspondence, business cards, or other written material; and
- b. The time, manner of service, identity of recipient(s), and form of actual notice provided by Defendant to its officers, agents, servants, employees, attorneys, and those person in active concert or participation with Defendant pursuant to Federal Rule of Civil Procedure 65(d);

5. Awarding Plaintiffs such damages as they have sustained or will sustain by reason of Defendant's trademark infringement, dilution, and unfair competition, including trebling of the actual damages pursuant to 15 U.S.C. § 1117 and 54 PA. CONS. STAT. ANN. § 1125 (Purdon 1999 Supp.);

6. Awarding Plaintiffs all gains, profits, property, and advantages derived by Defendant from such conduct pursuant to 15 U.S.C. § 1117;

7. Awarding Plaintiffs all compensatory and punitive damages permitted by law;

8. Awarding Plaintiffs their costs and disbursements incurred in this action, including its reasonable attorneys' fees, as provided by state and federal law, including but not limited to 15 U.S.C. § 1117;

9. Awarding Plaintiffs interest, including pre-judgment interest, on the foregoing sums; and

10. Awarding Plaintiffs such other and further relief as the Court may deem just and appropriate.

Respectfully submitted,

POST & SCHELL, P.C.

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