

IN THE UNITED STATES DISTRICT COURT  
FOR THE WESTERN DISTRICT OF PENNSYLVANIA

|                                 |   |                        |
|---------------------------------|---|------------------------|
| J. MARCUS WHOLESALERS, INC.     | ) |                        |
| and THE PARADIES SHOPS, INC.,   | ) | Electronically Filed   |
|                                 | ) |                        |
| Plaintiffs,                     | ) | Civil Action No. _____ |
|                                 | ) |                        |
| v.                              | ) |                        |
|                                 | ) | JURY TRIAL DEMANDED    |
| LOUIS VUITTON MALLETTIER, S.A., | ) |                        |
|                                 | ) |                        |
| Defendant.                      | ) |                        |

**VERIFIED COMPLAINT**

NOW COME Plaintiffs, J. Marcus Wholesalers, Inc. (“J. Marcus”) and The Paradies Shops, Inc. (“Paradies”), by and through their counsel, and file the following Complaint, stating as follows:

**Introduction**

1. Plaintiffs commence this action under The Declaratory Judgment Act, 28 U.S.C. §§ 2201-02, seeking a judgment that the inexpensive fabric travel bags supplied by J. Marcus and sold by Paradies do not infringe United States Trademark Registration No. 2,421,618.

**The Parties**

2. Paradies is a Georgia corporation that operates various retail shops throughout the United States, predominantly at airports and hotels, including the Pittsburgh International Airport, and has a principal place of business at 5950 Fulton Industrial Boulevard, S.W., Atlanta, Georgia 30336.

3. J. Marcus is a Pennsylvania corporation that supplies various novelty and other items to retail businesses, and has a principal place of business at 1728 Smallman Street, Pittsburgh, Pennsylvania 15222.

4. Louis Vuitton Malletier, S.A. ("Louis Vuitton") is a French corporation that designs and supplies worldwide various expensive and high quality leather goods to boutiques and upscale department stores, including stores within this district, and maintains a business address in the United States at 19 East 57th Street, New York, New York, 10022.

#### **Jurisdiction and Venue**

5. This Court has jurisdiction over the subject matter of this action pursuant to 28 U.S.C. §§ 1331 and 1338 and 15 U.S.C. § 1121(a).

6. This Court has jurisdiction over all parties involved in this action because the parties have a principal place of business in the Western District of Pennsylvania, regularly conduct business in the Western District of Pennsylvania, or both.

7. Venue is proper in this Court pursuant to 28 U.S.C. § 1391 because all parties regularly conduct business in the Western District of Pennsylvania and therefore reside in the Western District of Pennsylvania.

#### **Background Facts**

8. J. Marcus supplied to Paradies a line of inexpensive fabric travel bags that display a dark brown and light brown checkerboard pattern without any unique or source identifying characteristics (the "Checkerboard Travel Bags").

9. J. Marcus sold these bags to Paradies, which sold the travel bags to the public at certain of its airport retail stores at prices generally ranging from \$9.99 to \$39.99.

10. Louis Vuitton sells expensive, high quality handbags and other goods including luggage displaying its "Damier" design. These Damier products are priced in the approximate price range of \$850 to \$3,500.00, and are sold through the Louis Vuitton website or exclusive boutique and specialty stores.

11. Louis Vuitton's "Damier" handbags and luggage prominently display the "Louis Vuitton" brand name and they are extremely well made using superior materials and craftsmanship.

12. The Checkerboard Travel Bags do not display Louis Vuitton's brand name or trademark. Nor do are they made of leather or imitation leather and do not have the appearance of either leather or imitation leather, and have a thread pattern distinctly different from the warp and weft design described in Louis Vuitton's '618 registration.

13. Louis Vuitton registered its Damier design with the United States Patent and Trademark Office, and was granted United States Trademark Registration No. 2,421,618 for its Damier design (the "'618 registration") for:

Goods made of leather or imitations of leather not included in other classes, namely, boxes of leather or leather board principally used for travel purposes, envelopes of leather for merchandise packaging, trunks, valises, traveling bags, traveling sets for containing cosmetics, jewelry, and stationery, garment bags for travel, vanity cases, rucksacks, handbags, beach bags, shopping bags, shoulder bags, attaché-cases, brief cases, pouches, fine leather goods, namely, pocket wallets, purses, key cases, business card cases, credit card cases, calling card cases, parasols, umbrellas, canes, walking-stick seats.

A copy of the '618 registration is attached to this Complaint as Exhibit A.

14. Louis Vuitton's description of the mark that is subject of the '618 registration is as follows:

The mark consists of a checkered pattern of light and dark brown with an unusual contrast of weft and warp, and color is claimed as a feature of the mark. The pattern appears over substantially the entire surface of the goods. The lining constitutes a feature of the mark and itself does not indicate the colors described above.

*See Ex. A.*

15. On December 15, 2006, Paradies received from Louis Vuitton a cease and desist letter demanding, among other things, that Paradies stop selling the Checkerboard Travel Bags, provide the identity of the source of the Checkerboard Travel Bags, identify to whom Paradies has sold the Checkerboard Travel Bags, and account for the total dollar amount of moneys earned as a result of selling these travel bags. A copy of this letter is attached to this Complaint as Exhibit B.

16. The letter stated that Paradies "damaged and diluted and will continue to damage and dilute the good will represented by the Louis Vuitton 'Damier' Trademark. As a result, The Paradies Shop is liable to Louis Vuitton for its profits, treble damages and costs and attorney's fees."

17. The letter demanded that Paradies immediately cease and desist selling the travel bags and take the actions identified in Paragraph 15 within five days of receiving the letter, or "Louis Vuitton will take all steps necessary to protect its rights, including seeking immediate injunctive relief, compensatory and punitive damages, as well as attorney's fees."

18. After receiving the letter, Paradies informed J. Marcus, its supplier, of the demand made by Louis Vuitton.

19. J. Marcus, through its counsel, delivered on January 9, 2007 a letter to Louis Vuitton, attached hereto as Exhibit C, advising it that J. Marcus had supplied the Checkerboard Travel Bags to Paradies and that J. Marcus had no reason to believe that the Checkerboard Travel Bags infringed the '618 registration.

20. Louis Vuitton responded with a verbal, non-negotiable demand that J. Marcus and Paradies immediately cease offering for sale the travel bags and immediately destroy any existing travel bags.

21. Plaintiffs and Defendant have an actual controversy as to whether the Checkerboard Travel Bags supplied by J. Marcus and sold by Paradies infringe the '618 registration of sufficient immediacy and reality to warrant declaratory relief.

22. Plaintiffs have no adequate remedy at law and the balance of equities favor the Plaintiffs.

**Count I - Declaratory Judgment**  
***(Paradies and J. Marcus v. Louis Vuitton)***

23. The allegations contained in Paragraphs 1 through 22 are incorporated by reference as though fully set forth at length.

24. Louis Vuitton charged in its December 15, 2006 letter and telephone conversations that the Checkerboard Travel Bags supplied by J. Marcus and sold by Paradies infringe the '618 registration.

25. Louis Vuitton threatened litigation if J. Marcus and Paradies did not comply with its demands.

26. The Checkerboard Travel Bags do not infringe the '618 registration.

27. No reasonably prudent consumer would confuse J. Marcus's inexpensive fabric travel bags, purchased in an airport convenience store, with Louis Vuitton's expensive products bearing the Damier mark together with the consistently affixed Louis Vuitton or LV name and mark, purchased at exclusive boutique or specialty stores, merely because each incorporates a common checkerboard pattern.

28. Plaintiffs seek a declaratory judgment pursuant to 28 U.S.C. § 2201 and 15 U.S.C. § 1051, *et. seq.* that the Checkerboard Travel Bags do not infringe the '618 registration.

29. Entry of a declaratory judgment will clarify the parties' legal relations, and will enable J. Marcus and Paradies to conduct business without fear of expensive litigation commenced against them in a distant forum.

30. Declaratory relief will fully and finally settlement the controversy between the parties, and is the most effective remedy available.

31. This forum is the best forum to decide this dispute because all parties clearly are subject to jurisdiction in this forum.

32. Plaintiffs are entitled to recover their attorneys' fees and expenses pursuant to 15 U.S.C. § 1117(a) because this is an exceptional case.

WHEREFORE, The Paradies Shops, Inc. and J. Marcus Wholesalers, Inc. respectfully request this Honorable Court to:

(1) Enter judgment declaring that the travel bags supplied by J. Marcus Wholesalers, Inc., sold by The Paradies Shops, Inc., and identified in Louis Vuitton's letter of December 15, 2006 do not infringe United States Trademark Registration No. 2,421,618;

- (2) That Plaintiffs recover their reasonable attorneys fees and expenses pursuant to 15 U.S.C. 1117(a);
- (3) That all costs of this action be charged against Defendant; and
- (4) That the Court grant such other and further relief as it deems just and proper.

Respectfully submitted,

METZ LEWIS LLC

By: /s/Barry I. Friedman  
Barry I. Friedman, Esquire  
Pa. I.D. No. 50507

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Phone: (412) 918-1100

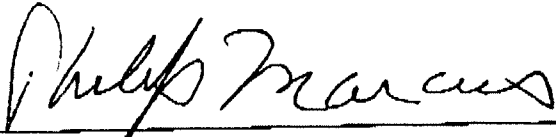
Of Counsel:  
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Atlanta, Georgia 30309  
Phone: (404) 815-3382

Attorneys for Plaintiffs

**VERIFICATION**

I, Philip Marcus, Manager of Plaintiff, J. Marcus Wholesalers, Inc., have read the foregoing **VERIFIED COMPLAINT**. The statements therein are correct to the best of my personal knowledge or information and belief.

This statement and verification is made subject to the penalties of perjury under the laws of the United States, 18 U.S.C. 1001, *et seq.* and 28 U.S.C. § 1746, relating to unsworn declarations.

  
\_\_\_\_\_  
PHILIP MARCUS

Dated: Feb. 2, 2007



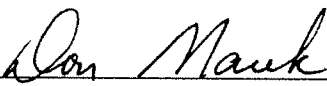
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and THE PARADIES SHOPS, INC., )  
Plaintiffs, )  
v. )  
LOUIS VUITTON MALLETIER, )  
S.A., )  
Defendant. )

Action No. \_\_\_\_\_

**VERIFICATION**

I, Don Marek, Chief Financial Officer of Plaintiff The Paradies Shops, Inc., have read the foregoing **VERIFIED COMPLAINT**. The factual averments contained in Paragraphs 2, 8, 9, 12, and 15-18 are correct to the best of my personal knowledge or information and belief. This statement and verification is made subject to the penalties of perjury under the laws of the United States, 18 U.S.C. 1001, et seq. and 28 U.S.C. § 1746, relating to unsworn declarations.

  
\_\_\_\_\_  
Don Marek, Chief Financial Officer  
For The Paradies Shops, Inc.

DATED: February 1, 2007