

UNITED STATES DISTRICT COURT  
SOUTHERN DISTRICT OF NEW YORK

JUDGE JONES

VICTORIA'S SECRET STORES, LLC,  
VICTORIA'S SECRET DIRECT, LLC, and  
BATH & BODY WORKS, INC.

06 CV 14436

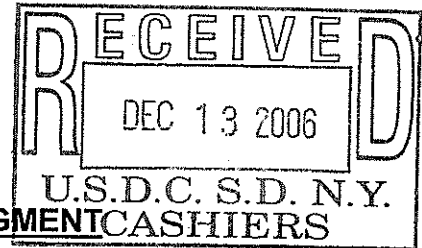
Civil Action No.

Plaintiffs,

v.

ASPEN LICENSING INTERNATIONAL, INC.

Defendant.



COMPLAINT FOR DECLARATORY JUDGMENT

Plaintiffs, VICTORIA'S SECRET STORES, LLC, VICTORIA'S SECRET DIRECT, LLC, and BATH & BODY WORKS, INC. ("plaintiffs" or "VS & BBW"), by their attorneys, for their declaratory judgment complaint against defendant, ASPEN LICENSING INTERNATIONAL, INC. ("defendant" or "Aspen"), allege as follows:

THE PARTIES

1. Plaintiff, Victoria's Secret Stores, LLC ("VS Stores"), is a Delaware corporation, having its principal office and place of business at Four Limited Parkway, Reynoldsburg, Ohio 43068 and is qualified to do business and is doing business in the State of New York and in this judicial district. VS Stores owns and operates over 900 VICTORIA'S SECRET retail stores located throughout the United States, including those within this judicial district.

2. Plaintiff, Victoria's Secret Direct, LLC ("VS Direct"), is a Delaware corporation, having its principal office and place of business at 3425 Morse Crossing, Columbus, Ohio 43219, and is doing business in the State of New York and in this

judicial district. VS Direct operates and distributes the world famous VICTORIA'S SECRET Catalogue and website, [www.victoriassecret.com](http://www.victoriassecret.com), through which VS Direct offers for sale and sells lingerie, sleepwear, as well as other apparel and swimwear. VS Stores and VS Direct are referred to collectively as "VS."

3. Plaintiff, Bath & Body Works, Inc. ("BBW"), is a Delaware corporation, having its principal office and place of business at Seven Limited Parkway East, Reynoldsburg, Ohio 43068, and is qualified to do business and is doing business in the State of New York and in this judicial district. Bath & Body Works owns and operates over 1,500 BATH & BODY WORKS retail stores nationwide and its own website, [www.bathandbodyworks.com](http://www.bathandbodyworks.com), both of which sell a wide range of personal care, wellness and beauty products, such as soaps, lotions, creams, shower gels, fragrances, face care products, gift sets, home fragrances, candles and potpourri.

4. VS Stores, VS Direct and BBW are all wholly-owned subsidiaries of Limited Brands, Inc. ("Limited Brands"), a Delaware corporation, having its principal office and place of business at Three Limited Parkway, Columbus, Ohio 43230.

5. Upon information and belief, defendant, Aspen Licensing International, Inc. ("defendant" or "Aspen"), is a Florida corporation, having its principal office and place of business at 1649 Forum Place Suite 12, West Palm Beach, Florida 33401, and is transacting business in the State of New York and in this judicial district.

#### **JURISDICTION AND VENUE**

6. The Court has jurisdiction over the subject matter of this trademark declaratory judgment action pursuant to 28 U.S.C. §§ 1331, 1338(a), the Lanham Act, 15 U.S.C. § 1051 et seq., and pursuant to 28 U.S.C. §§ 2201(a) and 2202.

7. The Court has jurisdiction over defendant because defendant is qualified to do business in the State of New York, and, upon information and belief, defendant itself, and/or through its licensees, transacts and solicits business in the State of New York, within this judicial district.

8. Venue is proper in this judicial district under 28 U.S.C. §§ 1391(b) and (c) and 1400(a).

### **FACTS COMMON TO ALL COUNTS**

9. VS uses the famous VICTORIA'S SECRET trademark which has long been used both domestically and internationally by it in connection with the manufacture and sale of high quality lingerie, clothing, accessories, personal care and beauty products. VS's brand name products are sold and distributed primarily through its approximately 900 company-owned stores in the United States, by direct catalog sales worldwide and by sales through its website worldwide. The VICTORIA'S SECRET brand identifies VS as the source of these goods and assures consumers of the high level of quality, design, appeal and customer satisfaction with which VS's brands have become synonymous.

10. BBW uses the famous BATH & BODY WORKS trademark, which has long been used both domestically and internationally by it in connection with the manufacture and sale of personal care, wellness and beauty products. BBW's brand name products are sold and distributed primarily through its approximately 1,500 company-owned stores in the United States and by sales through its website worldwide. The BATH & BODY WORKS brand identifies BBW as the source of these goods and

assures consumers of the high level of quality, design, appeal and customer satisfaction with which BBW's brands have become synonymous.

11. Upon information and belief, defendant is the owner of several trademark registrations for various marks that include the word "Aspen." These registrations include: U.S. Registration Nos. 1,810,824; 884,709; 884,710; 1,102,787; 1,187,768; 1,187,769; 1,236,423; 1,236,424; 1,751,333; 1,798,796; 1,827,545 and 2,383,524 for various items of clothing, U.S. Registration No. 3,080,060 for "toiletries and bath products" and U.S. Registration Nos. 1,086,411 and 1,649,495 for "luggage and accessories" (hereinafter collectively referred to as "Defendant's ASPEN Registrations").

12. Upon information and belief, defendant itself does not manufacture or sell any products bearing the trademarks set forth in Defendant's ASPEN Registrations. Rather, defendant allegedly licenses Defendant's ASPEN Registrations to third parties.

13. As part of their seasonal winter offerings, VS Stores and VS Direct recently introduced a collection of graphic turtleneck sweatshirts and track jackets for sale that have a ski season theme and include the names of well-known skiing locations such as Beaver Creek (Colorado), Whistler (British Columbia) and Aspen (Colorado). The use of these names is intended only in a geographic manner to reinforce the winter theme of the items, and is not used in a trademark manner or to identify VS Stores or VS Direct in any way. For example, the turtleneck sweatshirt features the words "Aspen Championship" across the front, with a graphic of a large snowflake in the background amidst a snow-covered mountainous landscape. These turtleneck sweatshirts and

track jackets are available through VS Direct's Holiday Casual catalogue and online at its website [www.victoriasecret.com](http://www.victoriasecret.com) as well as through VS Stores' retail stores throughout the United States. True and accurate copies of photographs of VS's "Aspen" turtleneck sweatshirt and track jacket are attached hereto as Exhibit 1.

14. As part of its winter line of products, BBW similarly evokes a skiing theme in its sales of personal care, travel bags, candles, and other specialty items that include the word "Aspen." Like VS's use, BBW's use of the name Aspen is not in a trademark manner or to identify BBW in any way. Instead, in each instance that it is displayed, the word "Aspen" appears with other words that relate to the theme and imagery of an escape to Aspen, Colorado for the winter season and either BBW's BATH & BODY WORKS or its PERFECT CHRISTMAS trademarks are plainly visible, including the following: "BATH AND BODY WORKS™ Aspen Holiday Getaway Bag"; "THE PERFECT CHRISTMAS® Aspen"; "THE PERFECT CHRISTMAS® Aspen Winter"; "Aspen Winter"; "BATH AND BODY WORKS™ Aspen Glam"; "BATH AND BODY WORKS™ Aspen Chic"; and "Kiss My Aspen". True and accurate copies of photographs of some of the foregoing products are attached hereto as Exhibit 2. The winter/skiing-themed products sold by VS Stores, VS Direct and BBW that incorporate the word "Aspen," as set forth in paragraphs 11 and 12 herein are referred to collectively as the "VS & BBW Aspen Products."

15. Upon further information and belief, there are numerous third parties who similarly use the word "Aspen" as a geographic term associated with skiing, winter and resort activities in connection with the sale of various clothing items and

accessories, as well as personal care products. Upon information and belief, most, if not all of these parties are not licensees of defendant.

16. On or about November, 2006, defendant's president contacted Limited Brands by telephone to advise Limited Brands that defendant objected to VS's and BBW'S sale of the VS & BBW Aspen Products and considered them to be an infringement of Defendant's ASPEN Registrations. Limited Brands, through its counsel, responded to defendant by letter, which denied defendant's allegations. Thereafter, on November 28, 2006, defendant's counsel sent another letter to VS & BBW's counsel reiterating defendant's allegations and demanded that VS & BBW immediately cease and desist from all further sales of the VS & BBW Aspen Products. The letter further threatened commencement of "litigation" to recover "treble damages plus attorney's fees" and requested that VS & BBW respond by no later than December 1<sup>st</sup>. A true and accurate copy of Defendant's November 28<sup>th</sup> letter is attached hereto and annexed herein as Exhibit 3. The parties continued to exchange correspondence ending with defendant's later dated December 13<sup>th</sup>, which is attached hereto and annexed herein as Exhibit 4.

17. Defendant has and continues to threaten VS & BBW with litigation if VS & BBW continue their sales of the VS & BBW Aspen Products.

18. VS & BBW have a real and reasonable apprehension of litigation based on defendant's statements and conduct. Moreover, defendant's threats to file suit and claims of trademark infringement have created an actual, substantial and justiciable controversy between VS & BBW and defendant concerning the right of VS & BBW to continue to manufacture and sell the VS & BBW Aspen Products.

**COUNT I**

**DECLARATORY JUDGMENT FOR NON-INFRINGEMENT  
OF TRADEMARK 15 U.S.C. § 1132(a)**

19. VS & BBW repeat and incorporate herein by reference each and every one of the allegations contained in paragraphs 1 through 18, inclusive, of this complaint with the same force and effect as if hereinagain set forth in detail.

20. Due to several factors, including but not limited to: VS & BBW's geographic, non-trademark use of "Aspen" in connection with the VS & BBW Aspen Products; VS and BBW's visible use of their identifying trademarks such as VICTORIA'S SECRET or BATH & BODY WORKS in close conjunction with and/or on the VS & BBW Aspen Products themselves; the extensive third party usage of "Aspen" as a geographic identifier of Aspen, Colorado as a renown skiing and winter vacation destination; and the differences in trade channels and purchasing environments between VS & BBW's and defendant's licensed products, there is no likelihood of confusion, sponsorship or affiliation between the VS & BBW Aspen Products and Defendant's ASPEN Registrations or between defendant and VS & BBW.

21. VS & BBW are entitled to a declaratory judgment from this Court that the VS & BBW Aspen Products do not infringe Defendant's ASPEN Registrations, unfairly compete with defendant or otherwise violate any rights of defendant.

**PRAYER FOR RELIEF**

**WHEREFORE**, VS & BBW pray for the following relief:

A. The Court declare that VS & BBW's past, present and continued sale of the VS & BBW Aspen products does not constitute an infringement of

Defendant's ASPEN Registrations, unfairly competes with defendant or otherwise constitutes a violation of any of defendant's rights;

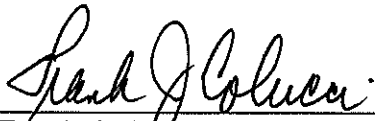
B. That defendant, its officers, agents, servants, employees and attorneys, and those persons in active concert or participation or otherwise in privity with it, be permanently enjoined and restrained from instituting, prosecuting or threatening any action against VS & BBW, or any of its related affiliates, or anyone in privity with them with respect to VS & BBW's manufacture and sales of the VS & BBW Aspen Products;

C. That VS & BBW have and recover from defendant their reasonable attorneys' fees, costs and disbursements of this civil action, pursuant to § 35 of the Lanham Act, 15 U.S.C. § 1117; and

D. That VS & BBW have such other and further relief as the Court may deem just and proper.

Dated: December 13, 2006  
New York, New York

COLUCCI & UMANS

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