

UNITED STATES DISTRICT COURT  
SOUTHERN DISTRICT OF INDIANA  
INDIANAPOLIS DIVISION

HEINEKEN USA, INC.	)	
	)	
Plaintiff,	)	
	)	CASE NO. 1:07-CV-1054-JDT-TAB
	)	
v.	)	
	)	
GI APPAREL, INC.;	)	
PANAMA JACK, INC.; and	)	
KOHL’S DEPARTMENT STORES, INC.	)	
	)	
Defendants.	)	

**AMENDED COMPLAINT**

For this Complaint against GI Apparel, Inc. (“GI”); Panama Jack, Inc. (“PJI”); and Kohl’s Department Stores, Inc. (“Kohl’s”) (hereinafter collectively referred to as “Defendants”), Plaintiff, Heineken USA, Inc. (“HUSA”) hereby alleges as follows:

**SUBSTANCE OF THE ACTION**

1. This case involves infringement upon the distinctive and world-famous Heineken trademarks used by HUSA in connection with the sale and promotion of Heineken products within the United States. Defendants’ infringement arises out of the unauthorized use of the Heineken trademarks on clothing items bearing the Heineken marks (“infringing items”).
2. Defendants’ use of the Heineken marks on the infringing items violates HUSA’s rights under federal trademark law, common law and Indiana state law. HUSA asserts claims for federal trademark infringement, federal trademark dilution, false designation of origin or sponsorship, false advertising, and trade dress infringement pursuant to the Lanham Act, as well as common law trademark infringement, unfair competition, conversion,

forgery, counterfeiting, and deception. HUSA seeks a permanent injunction preventing Defendants from using the distinctive Heineken trademarks, along with an award of damages, treble damages, profits, attorney's fees and costs.

**THE PARTIES**

3. HUSA is a business organized and existing under the laws of New York with its corporate office at 360 Hamilton Avenue, Suite 1102, White Plains, NY 10601.
4. Defendant GI is a business organized and existing under the laws of New Jersey. GI may be served through its registered agent, Anthony Prisco, 271 Adelpia Road, Farmingdale, NJ 07727.
5. Defendant PJI is a business organized and existing under the laws of Florida. PJI may be served through its registered agent, Jack Katz, 230 Ernestine Street, Orlando, FL 32801.
6. Defendant Kohl's is a business organized and existing under the laws of Delaware. Kohl's may be served through its registered agent, The Corporation Trust Company, Corporation Trust Center, 1209 Orange Street, Wilmington, DE 19801.

**JURISDICTION AND VENUE**

7. This Court has original federal question jurisdiction over Counts I through III of the Amended Complaint pursuant to 28 U.S.C. §§ 1331 and 1338(a).
8. This Court has original jurisdiction over Count V of the Amended Complaint pursuant to 28 U.S.C. § 1338(b).
9. This Court has supplemental jurisdiction over Count IV and Counts VI through IX of the Amended Complaint.
10. Defendants have submitted to this Court's jurisdiction by doing business in Indiana.
11. The exercise of personal jurisdiction over Defendants by this Court is consistent with the

federal Due Process Clause.

12. Venue properly lies in this Court because a substantial part of the events giving rise to the claims alleged herein arose in Hamilton County, Indiana.

### **GENERAL ALLEGATIONS AS TO HUSA**

#### **Heineken's Trademark Rights**

13. HUSA and Heineken Brouwerijen B.V. ("HBBV") are members of the Heineken Group and affiliated subsidiaries of the parent corporation, Heineken N.V. The Heineken Group ("Heineken") owns and manages one of the world's leading portfolios of beer brands. Relative to this business, HBBV has registered with the United States Patent and Trademark Office multiple word and image trademarks. These registrations are active and unrevoked, and constitute *prima facie* evidence of Heineken's ownership of the marks. These trademarks are collectively referred to herein as the "Heineken trademarks" or the "Heineken marks."
14. HUSA is the sole importer of Heineken products in the United States and bears the responsibility for all sales, marketing and promotional activities for Heineken in the United States. As the sole importer in the United States, HUSA is the exclusive licensee for use of the Heineken marks within the United States.
15. The Heineken trademarks are distinctive and famous.
16. HUSA is engaged in the licensing of promotional items bearing the Heineken trademarks in Indiana and throughout the United States.
17. HUSA maintains strict control over the quality and nature of its products and items bearing the Heineken trademarks.
18. HUSA has invested considerable time and money in advertising the Heineken trademarks

throughout Indiana and the United States. As a result of extensive national advertising, the Heineken marks are immediately recognizable.

19. HUSA has acquired substantial goodwill among consumers.

20. As a result of such goodwill and immediate recognition, and as a result of extensive advertising, the Heineken trademarks have become highly valuable.

**Defendants' Infringement of Heineken's Trademark Rights**

21. Subsequent to Heineken's development, use and registration of the Heineken trademarks, Defendants began using the Heineken marks or confusingly similar variations of the marks.

22. Specifically, Defendants have manufactured, produced, advertised and/or sold T-shirts bearing a replication of the Heineken beer bottle. The Heineken bottle is featured amongst several other brand name bottles.

23. Defendants have not received permission from HUSA, or anyone acting on Heineken's behalf, to manufacture, produce, advertise or sell any item bearing the Heineken trademarks in the United States or elsewhere.

24. By manufacturing, producing, advertising and/or selling items bearing the Heineken marks without permission, Defendants have attempted to profit from and capitalize on the trademark rights and substantial goodwill developed by HUSA.

25. Defendants have willfully and intentionally manufactured, produced, advertised and/or sold products bearing the Heineken trademarks with knowledge that the Heineken marks are federally registered trademarks owned by Heineken.

26. Defendants manufactured, produced, advertised and/or sold items bearing the Heineken marks with knowledge that Defendants' use of the Heineken trademarks was

unauthorized.

27. The manufacture, production, advertisement, and/or sale of items bearing the Heineken trademarks created a likelihood of consumer confusion.

28. Defendants used the Heineken marks with the intent to confuse and/or deceive consumers.

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

29. HUSA incorporates herein by reference the allegations contained in all previous paragraphs of this Complaint.

30. Defendants have used in commerce, and in connection with the sale of goods, a reproduction, counterfeit, copy or colorable imitation of the Heineken trademarks.

31. Defendants have reproduced, counterfeited, copied or imitated the Heineken marks and applied the marks to labels, signs, prints, packages, receptacles or advertisements intended to be used in commerce.

32. Defendants' use of the Heineken trademarks creates the likelihood of confusion, mistake and/or deception among consumers.

33. Defendants willfully infringed upon the trademark rights of HUSA. Defendants intended to confuse, mistake or deceive consumers.

34. Defendants used the reproductions of the Heineken trademarks with knowledge that the marks were copies and/or counterfeits.

35. Consumers were initially interested and lured to the infringing items by the similarity to the Heineken marks.

36. As a result of Defendants' infringement, HUSA has suffered irreparable harm to valuable Heineken trademarks. Unless Defendants are permanently enjoined from further

infringement, HUSA will continue to suffer irreparable harm.

37. A permanent injunction is necessary to prevent Defendants from further interference with Heineken's trademark rights.

38. As a result of Defendants' infringement under 15 U.S.C. § 1114, HUSA has been injured and is entitled to damages, including but not limited to, Defendants' profits from the sale of all infringing goods, actual damages, treble damages, statutory damages, costs of suit and attorney's fees.

**COUNT II**  
**TRADEMARK DILUTION UNDER 15 U.S.C. § 1125(c)**

39. HUSA incorporates by reference the allegations contained in all previous paragraphs of this Complaint.

40. The Heineken trademarks are the product of creativity and imagination.

41. The Heineken trademarks are distinctive and famous.

42. Defendants adopted the Heineken trademarks after the marks became famous.

43. Defendants' use of the Heineken trademarks caused dilution of the marks.

44. Defendants' use of the Heineken trademarks is commercial and in commerce.

45. Defendants' use of the Heineken trademarks has weakened the unique association of the marks with HUSA, as owner of the marks.

46. As a result of Defendants' dilution under 15 U.S.C. § 1125(c), HUSA has suffered irreparable harm to valuable Heineken trademarks. Unless Defendants are permanently enjoined from further dilution, HUSA will continue to suffer irreparable harm.

47. A permanent injunction is necessary to prevent Defendants from further interference with Heineken's trademark rights.

48. Defendants' dilution of the Heineken marks has caused HUSA damages, including, but

not limited to, Defendants' profits from the sale of all infringing goods, actual damages, treble damages, statutory damages, costs of suit and attorney's fees.

**COUNT III**  
**FALSE DESIGNATION OF ORIGIN OR SPONSORSHIP,**  
**FALSE ADVERTISING AND**  
**TRADE DRESS INFRINGEMENT UNDER 15 U.S.C. § 1125(a)**

49. HUSA incorporates by reference the allegations contained in all previous paragraphs of this Complaint.
50. Defendants used the Heineken trademarks in commerce and in connection with the sale of goods or services.
51. Defendants' use of the Heineken marks is likely to cause confusion or mistake and/or is likely to deceive consumers as to the affiliation, connection or association of Defendants with HUSA; or as to the origin, sponsorship, or approval of Defendants' goods by HUSA.
52. Defendants' conduct constitutes false or misleading descriptions, false advertising, and false designations of the origin and/or sponsorship of Defendants' goods and constitutes trade dress infringement in violation of § 43(a) of the Lanham Act, as amended, 15 U.S.C. § 1125(a).
53. As a result of Defendants' conduct, HUSA has suffered irreparable harm to valuable Heineken trademarks. Unless Defendants are permanently enjoined from further false designations, false advertisement and trade dress infringement, HUSA will continue to suffer irreparable harm.
54. A permanent injunction is necessary to prevent Defendants from further interference with Heineken's trademark rights.
55. Defendants' violations of 15 U.S.C. §1125(a) have caused HUSA to incur damages,

including, but not limited to, Defendants' profits from the sale of all infringing goods, actual damages, treble damages, statutory damages, costs of suit and attorney's fees.

**COUNT IV**  
**COMMON LAW TRADEMARK INFRINGEMENT**

56. HUSA incorporates by reference the allegations contained in all previous paragraphs of this Complaint.

57. Heineken was the first to use the Heineken trademarks or any marks similar thereto in association with the sale of any product or service. As a result of the continued sale by Heineken, the marks have become internationally known and Heineken has become identified in the public mind as the manufacturer and/or licensor of the products and services to which the Heineken trademarks are applied.

58. HUSA has acquired a reputation among consumers for quality and excellence, and the Heineken trademarks have come to symbolize that reputation.

59. Defendants, with knowledge of and with intentional disregard for the rights of HUSA, manufactured, produced, advertised and/or sold items using the Heineken marks or confusingly similar imitations thereof.

60. Defendants' use of the Heineken marks has created the likelihood of confusion among consumers.

61. Defendants' acts constitute trademark infringement and willful infringement under the common law.

62. As a result of Defendants' conduct, HUSA has suffered irreparable harm to valuable Heineken trademarks. Unless Defendants are permanently enjoined from further infringement, HUSA will continue to suffer irreparable harm.

63. A permanent injunction is necessary to prevent Defendants from further interference with

Heineken's trademark rights.

64. As a result of Defendants' infringement, HUSA has suffered damages, including, but not limited to, Defendants' profits from the sale of all infringing goods, actual damages, treble damages, statutory damages, costs of suit and attorney's fees.

**COUNT V**  
**UNFAIR COMPETITION**

65. HUSA incorporates by reference the allegations contained in all previous paragraphs of this Complaint.

66. Defendants' unlawful and unauthorized use of the Heineken trademarks constitutes unfair competition with HUSA.

67. Defendants' conduct creates consumer confusion as to the source and/or origin of the infringing items.

68. Defendants' use of the Heineken trademarks is an attempt to interfere with HUSA's business relationship with its consumers and to trade on HUSA's goodwill.

69. As a result of Defendants' conduct, HUSA has suffered irreparable harm to valuable Heineken trademarks. Unless Defendants are permanently enjoined from further unfair competition, HUSA will continue to suffer irreparable harm.

70. A permanent injunction is necessary to prevent Defendants from further interference with Heineken's trademark rights.

71. Defendants' unfair competition has caused HUSA to incur damages, including but not limited to, Defendants' profits from the sale of the infringing products, actual damages, costs of suit and attorney's fees.

**COUNT VI**  
**CONVERSION UNDER IND. CODE § 35-43-4-3**

72. HUSA incorporates by reference the allegations contained in all previous paragraphs of this Complaint.
73. Defendants knowingly or intentionally exerted unauthorized control over the property of Heineken.
74. Defendants sold items bearing Heineken intellectual property in the United States and without HUSA's consent and in a manner or to an extent other than that to which HUSA had consented.
75. Defendants knowingly or intentionally exerted unauthorized control over the goodwill developed by HUSA.
76. As a result of Defendants' conversion, HUSA was damaged and seeks an award of actual damages, treble damages, costs and attorney's fees pursuant to the Indiana Crime Victim's Act, Ind. Code § 34-24-3-1.

**COUNT VII**  
**FORGERY UNDER IND. CODE § 35-43-5-2(b)**

77. HUSA incorporates by reference the allegations contained in the previous paragraphs of this Complaint.
78. Defendants, with the intent to defraud, made, uttered, and/or possessed a written instrument in such a manner that it purports to have been made by HUSA.
79. HUSA did not give Defendants the authority to make or possess the infringing items.
80. As a result of Defendants' forgery, HUSA was damaged and seeks an award of actual damages, treble damages, costs and attorney's fees pursuant to the Indiana Crime Victim's Act, Ind. Code § 34-24-3-1.

**COUNT VIII**  
**COUNTERFEITING UNDER IND. CODE § 35-43-5-2(a)**

81. HUSA incorporates herein by reference the allegations contained in all previous paragraphs of this Complaint.
82. Defendants knowingly or intentionally made and/or uttered a written instrument in such a manner that it purports to have been made by HUSA.
83. HUSA did not give Defendants the authority to make or utter the infringing items.
84. As a result of Defendants' counterfeiting, HUSA was damaged and seeks an award of actual damages, treble damages, costs and attorney's fees pursuant to the Indiana Crime Victim's Act, Ind. Code § 34-24-3-1.

**COUNT IX**  
**DECEPTION UNDER IND. CODE § 35-43-5-3**

85. HUSA incorporates herein by reference the allegations contained in all previous paragraphs of this Complaint.
86. Defendants knowingly or intentionally made a false or misleading written statement with the intent to obtain property.
87. Defendants, with the intent to defraud, misrepresented the identity or quality of property.
88. As a result of Defendants' deception, HUSA was damaged and seeks an award of actual damages, treble damages, costs and attorney's fees pursuant to the Indiana Crime Victim's Act, Ind. Code § 34-24-3-1.

**PRAYER FOR RELIEF**

WHEREFORE, HUSA prays for relief against the Defendants as follows:

- a. That Defendants, their officers, partners, agents, servants, affiliates, employees, attorneys, and representatives, and all those in privity or acting in consent or

participation with Defendants, and each and all of them, be permanently enjoined from:

- (i) Imitating, copying, reproducing, or using, in any manner, the Heineken trademarks, or any other mark confusingly similar to the Heineken trademarks;
- (ii) Committing any act that dilutes or is likely to dilute the distinctiveness of the Heineken trademarks;
- (iii) Committing any act that is likely to create the impression that Defendants' business or products are in any way sponsored by, approved of or otherwise affiliated or connected with Heineken;
- (iv) Importing, manufacturing, producing, distributing, circulating, selling, offering for sale, advertising, promoting or displaying any product or service using any simulation, reproduction, counterfeit, copy or imitation of any Heineken trademark or trade dress; and
- (v) instructing, assisting, aiding, or abetting any other person or business entity in engaging in or performing any of the activities referred to in subparagraphs (i) through (iv) above.

b. That Defendants be required to:

- (i) Deliver to HUSA for destruction all goods and materials bearing Heineken trademarks which Defendants have in their possession;
- (ii) Recall and deliver to HUSA for destruction all goods and materials bearing the Heineken trademarks that have been previously distributed or sold;

- (iii) Pay compensatory damages to HUSA in an amount to be determined at trial for the injuries HUSA has sustained as a consequence of the acts complained of;
- (iv) Pay HUSA treble damages, or alternatively, Defendants' profits trebled, whichever is greater;
- (v) Pay all of HUSA's litigation expenses, including reasonable attorneys' fees and costs of this action;
- (vi) Pay interest to HUSA, including pre-judgment interest on the foregoing sums; and
- (vii) File with this Court and serve on HUSA an affidavit setting forth in detail the manner and form of Defendants' compliance with the terms of this Court's orders.

c. That HUSA be awarded such other and further relief as the Court may deem just and proper.

**DEMAND FOR TRIAL JURY**

HUSA hereby respectfully requests a trial by jury in this cause, and for all other relief just and proper in the premises.

Respectfully submitted,

/s/ Darlene R. Seymour

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Counsel for Plaintiff

**CERTIFICATE OF SERVICE**

The undersigned hereby certifies that a copy of the foregoing has been deposited in the U. S. mail, first class postage prepaid, on the 27<sup>th</sup> day of August, 2007, addressed to:

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