

**UNITED STATES DISTRICT COURT
SOUTHERN DISTRICT OF NEW YORK**

STEVEN MADDEN, LTD.,

Plaintiff,

v.

JASMIN LARIAN, LLC.,

Defendant.

CIVIL ACTION NO. 18-CV-_____

COMPLAINT

Plaintiff Steven Madden, Ltd. (“Steven Madden” or “Plaintiff”), by and through its undersigned attorneys Davis Wright Tremaine LLP, as and for its complaint against Jasmin Larian, LLC (“Jasmin Larian” or “Defendant”), respectfully alleges as follows, on personal knowledge as to Steven Madden’s own activities and on information and belief as to the activities of others:

THE PARTIES

1. Plaintiff Steven Madden is a corporation organized and existing under the laws of the State of Delaware, with a principal place of business in Long Island City, New York.

2. Upon information and belief, Jasmin Larian is a limited liability company organized and existing under the laws of the State of Delaware, with its principal place of business in Los Angeles, California.

JURISDICTION AND VENUE

3. Steven Madden seeks a declaration of its rights, pursuant to 28 U.S.C. §§ 2201(a) and 2202, to resolve an actual controversy within this Court’s jurisdiction. The Court has subject matter jurisdiction pursuant to 28 U.S.C. § 1331, as this action arises under the trademark laws of the United States.

4. The Court has personal jurisdiction over Jasmin Larian because Jasmin Larian engages in continuous and systematic business activities in the State of New York by, among other things, selling its goods in at least nine retail locations in the State. Moreover, Jasmin Larian has purposely directed substantial activities at the residents of the State of New York by means of Jasmin Larian's e-commerce promotion and sales and derives substantial revenue from interstate commerce.

5. Venue is proper pursuant to 28 U.S.C. § 1392(a)(2) because Jasmin Larian does business in this Judicial District and/or because a substantial part of the events giving rise to the causes of action alleged herein occurred in this Judicial District, and the injury suffered by Plaintiff took place in this Judicial District. Moreover, Plaintiff conducts continuous business throughout the State of New York, including this Judicial District.

GENERAL ALLEGATIONS

I. The Traditional Japanese Bamboo Half-Moon Bag Design

6. Beginning in 2013, Jasmin Larian, which designs and sells handbags, accessories and clothing, launched sales of a half-moon bag under the name "Cult Gaia Ark," which bag slavishly copies the traditional Japanese bamboo picnic bag design ("Traditional Japanese Design") from the 1940s.

Vintage-Japanese



Jasmin Larian-2013



7. In an attempt to appropriate the Traditional Japanese Design for itself, Jasmin

Larian has filed with the United States Patent and Trademark Office (“USPTO”) an application to register the design of its Cult Gaia Ark bag, as shown below:



8. On October 5, 2017, the USPTO issued an office action initially refusing registration on the basis that the Cult Gaia Ark bag design is merely functional and consists of a nondistinctive product design. The USPTO stated: “Consumers are aware of Japanese bamboo half-moon shaped carrying-bags. Applicant’s mark is merely an iteration or appropriation of a style of bag from the Japanese culture. The design is a classic shape and style of carrying bag for personal use.”

9. In describing its claimed trade dress for the Cult Gaia Ark bag design, Jasmin Larian does nothing more than describe the exact design of the Traditional Japanese Design, namely:

- structured and flat front and back panels made of thin, uniformly-sized strips of rigid material (such as bamboo);
- arranged in an interlocking manner to form three concentric half circles creating a distinctive see-through sunburst design; and
- topped by horizontal strips and a wide handle with a curved, tapering cutaway handle made of the same material, and a curved side panel made of interlocking pieces of the same material and in the same width as the pieces that make up the front and back panels.

10. The Cult Gaia Ark bag is described by third parties as being a reproduction of a classic Japanese picnic bag. For example:

This summer's it bag can be traced back to a Japanese bamboo picnic bag from the 70s. LA label Cult Gaia has reproduced the classic half-moon shaped tote into two sizes.

A reproduction of a classic Japanese picnic bag, this Cult Gaia Handbag is a showstopper you can wear with everything. You'll never need another carry-all.

Architectural and elegantly original, this half-moon bamboo handbag is a modern, minimalist re-envisioning of classic Japanese picnic bags from the 1940s.

11. Jasmin Larian is not alone in capitalizing on the reproduction of the Classic Japanese Design for fashion purposes, as there are multiple third parties who have sold these identical bags into the United States since at least as early as the 1960's through today, some of which are depicted below:



Red Dress



Poshmark



Miuco/Amazon



DSAIKGTR/Amazon



VM Fashion
Kiss/Amazon



Beauty
Yaya/Amazon



Perennial Chic



Storenvy



Mercari



St. Hamilton and
Co

12. Steven Madden, who for nearly 30 years, has been a leading designer, marketer and retailer of shoes and fashion accessories for women, men and children, is also making a bag under the name BShipper that incorporates the Traditional Japanese Design.

II. The Present Dispute

13. On February 16, 2018, Steven Madden received a letter from an attorney at Mitchell Silberberg & Knupp LLP, counsel to Jasmin Larian. A copy of that letter is attached as Exhibit A hereto. Defendant's attorney claimed that Steven Madden was infringing the trade

dress of the Cult Gaia Ark bag by virtue of its marketing and sale of the BShipper bag, see below:



14. Defendant’s attorney further demanded that Steven Madden take certain actions including, among other things, “[i]mmediately and permanently cease and desist from any further sale, distribution, promotion, and/or advertisement of any item that infringes upon the Ark trade dress” and “destroy all infringing items and confirm destruction of the same, “and “cancel any outstanding orders/backorders to manufacturer(s), wholesaler(s), and/or importer(s) of the infringing items.”

15. Defendant’s attorney stated that Jasmin Larian reserved its option to “vigorously enforce its rights” and explicitly threatened to “file a lawsuit seeking any and all available legal and equitable remedies, including injunctive relief, monetary damages, restitution, and attorneys’ fees.”

CLAIMS FOR RELIEF

COUNT ONE

(Declaratory Judgment of Non-infringement of Trade Dress)

16. Plaintiff incorporates by reference the allegations contained in paragraphs 1 through 15, inclusive.

17. Jasmin Larian has claimed that Steven Madden’s BShipper bag infringes Jasmin Larian’s trade dress in its Cult Gaia Ark bag and has threatened to bring a lawsuit against Steven

Madden on this basis.

18. An actual, present and justiciable controversy has arisen between Steven Madden and Jasmin Larian concerning Steven Madden's right to sell its BShipper bag.

19. Steven Madden seeks a declaratory judgment from this Court that Jasmin Larian's claimed trade dress is generic as it merely describes the Traditional Japanese Design.

20. Steven Madden seeks a declaratory judgment from this Court that Jasmin Larian's claimed trade dress is ubiquitous in the handbag market and does not warrant Lanham Act protection.

21. Steven Madden seeks a declaratory judgment from this Court that Jasmin Larian's claimed trade dress is merely functional and does not warrant Lanham Act protection.

22. Steven Madden seeks a declaratory judgment from this Court that its BShipper bag does not constitute trade dress infringement.

PRAYER FOR RELIEF

WHEREFORE, Plaintiff respectfully requests that this Court enter judgment as follows:

1. Enter judgment according to the declaratory relief sought;
2. Award Steven Madden its costs and attorneys' fees in this action;
3. Enter such other and further relief to which Steven Madden may be entitled as a matter of law or equity, or which this Court determines to be just and proper.

DEMAND FOR JURY TRIAL

Pursuant to Federal Rule of Civil Procedure 38 and Civil Local Rule 3-6, Steven Madden hereby demands a jury trial on all issues so triable.

Dated: March 6, 2018

Respectfully submitted,

By:


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