

IN THE UNITED STATES DISTRICT COURT  
FOR THE EASTERN DISTRICT OF MISSOURI  
EASTERN DIVISION

THE NORTH FACE APPAREL CORP.,	)	
a Delaware corporation,	)	
	)	
Plaintiff,	)	
	)	
v.	)	Case No.:
	)	
WILLIAMS PHARMACY, INC.	)	
JAMES A. WINKELMANN, JR., and	)	
THE SOUTH BUTT LLC,	)	
	)	
Defendants.	)	

COMPLAINT

Plaintiff The North Face Apparel Corp. (“The North Face” or “Plaintiff”) hereby files this Complaint on personal knowledge as to its activities and on information and belief as to the activities of others:

INTRODUCTION

The North Face is a company built from the dreams of two young hiking enthusiasts. In 1966, they founded a small store in San Francisco where they designed and sold mountaineering equipment and apparel. They named their store “The North Face” — evoking a mountain’s north face, generally considered the most difficult face to climb. Over the past 43 years, The North Face has grown from one small shop in northern California to a world-renowned source of exceptional outdoor adventure equipment and apparel. During the last four decades, THE NORTH FACE® mark and a stylized silhouette of Yosemite’s Half Dome peak (below)



have become famous trademarks uniquely associated with The North Face and its quality goods.

Unfortunately, and inevitably, The North Face's success attracts opportunists seeking to pirate its famous trademarks for their inferior knockoffs. The three defendants named here are merely the latest in a long line of such opportunists. They are marketing apparel that directly and unabashedly infringes and dilutes The North Face's famous trademarks and duplicates The North Face's trade dress in its iconic Denali jacket.



While defendants may try to legitimize their piracy under the banner of parody, their own conduct belies that claim. For example, defendant The South Butt, LLC (“The South Butt”) has attempted not once, but twice, to obtain a U.S. trademark registration for THE SOUTH BUTT. In response to The North Face's request to withdraw this trademark application and cease sales of infringing products, defendant James A. Winkelmann Jr. (“Winkelmann”) offered to sell his business to The North Face for \$1 million — a proposal he later withdrew in light of a significant increase in publicity and sales activity for The South Butt. More recently, defendants asserted that they plan to expand the manufacture and sale of their infringing apparel nationwide by spring 2010. Accordingly, The North Face has no choice but to commence this action to protect its valuable and famous THE NORTH FACE® brand and trademarks.

THE PARTIES

1. Plaintiff The North Face Apparel Corp. is a corporation organized and existing under the laws of Delaware and having a principal place of business at 3411 Silverside Road, Wilmington, Delaware 19810.

2. Defendant Williams Pharmacy, Inc. is a Missouri corporation having a principal place of business within this District at 7010 Pershing Avenue, St. Louis, Missouri 63130. On information and belief, it owns stores known as and located at: (a) Williams Pharmacy, 7010 Pershing Avenue, University City, Missouri 63131; (b) Ladue Pharmacy, 9832 Clayton Road, Ladue, Missouri 63124; (c) Clarkson Square Pharmacy, 1737 Clarkson Road, Chesterfield, Missouri 63017; and (d) Prescription Plus, 5 Maryland Plaza, St. Louis, Missouri 63108 (collectively, “Williams Pharmacies”). Williams Pharmacies also maintains an informational website available on the World Wide Web with an Internet address resolving at the Uniform Resource Locator (“URL”) [www.williamspharmacy.com](http://www.williamspharmacy.com).

3. Defendant, The South Butt, LLC, is a Missouri limited liability company having an office address within this District at 7710 Carondelet, Suite 404, Clayton, Missouri 63105. The South Butt also maintains a retail website available on the World Wide Web with an Internet address resolving at the URL <http://www.thesouthbutt.com> (the “South Butt Website”). The South Butt also maintains pages on the popular social networking sites, Facebook, which is available on the Internet resolving at the URL [www.facebook.com/pages/South-Butt/276080795511](http://www.facebook.com/pages/South-Butt/276080795511), and Twitter, which is available on the Internet resolving at the URL <http://twitter.com/thesouthbutt>.

4. Defendant, James A. Winkelmann Jr., is an individual residing within this District at 23 Glen Abbey Drive, Frontenac, Missouri 63131.

5. Defendants, Winkelmann and The South Butt are collectively referred to herein as the “The South Butt Defendants.” Williams Pharmacies and The South Butt Defendants are collectively referred to herein as “Defendants.”

## JURISDICTION AND VENUE

6. This is a complaint for trademark infringement, trademark dilution, and unfair competition arising under the Trademark Act of 1946, 15 U.S.C. §§ 1051, *et seq.*, as amended (the “Lanham Act”), for common law trademark infringement and unfair competition and for trademark dilution under the laws of the State of Missouri.

7. This Court has original subject matter jurisdiction over Plaintiff’s claims pursuant to 28 U.S.C. §§ 1331 and 1338 and 15 U.S.C. §§ 1116 and 1121. This Court has supplemental jurisdiction over state law claims under 28 U.S.C. § 1367.

8. This Court has personal jurisdiction over Defendants in that they do business and reside in the State of Missouri and in this District.

9. Venue is appropriate in this judicial district under 28 U.S.C. § 1391 in that Defendants are subject to personal jurisdiction in this judicial district, and this is the District in which events giving rise to the claims hereinafter set forth occurred.

## BACKGROUND FACTS




### **The North Face Trademarks and Products**





10. The North Face was founded in 1966 by two young hiking enthusiasts with a love of the outdoors and an ingenious plan for a line of apparel and equipment.

11. The North Face, its predecessors in interest and associated companies have, themselves and through licensees, sold high quality technical and casual outdoor apparel and equipment using the THE NORTH FACE trademarks (“THE NORTH FACE® Products”) for more than 40 years. The continuous and broad use of trademarks and trade names associated with The North Face during this time enabled Plaintiff to achieve world-wide celebrity under its the THE NORTH FACE trademarks in the performance apparel, equipment and footwear markets.

12. Inspired by the spirit of its founders, The North Face uses the trademark NEVER STOP EXPLORING<sup>®</sup> on its hang-tags, including those affixed to its best-selling Denali jacket, as well as throughout its website at [www.thenorthface.com](http://www.thenorthface.com) and in THE NORTH FACE<sup>®</sup> retail stores. The registered trademark NEVER STOP EXPLORING brings to consumers' minds The North Face's products and its commitment to pushing design limits, so that those consumers can likewise push themselves to higher levels of achievement.

13. The North Face is the owner of the entire right, title and interest in and to, *inter alia*, the following federally-registered trademarks and/or service marks:

Registration Number	Trademark	Goods and Services
1,102,407		Retail store, mail order, and distributorship services in the field of camping and outdoor gear, books, food, hardware and sports equipment.
983,624	THE NORTH FACE	Backpacks, sleeping bags, tents, snowshoes, skis and camping clothing, namely rainwear, parkas, vests, trousers, shoes, gloves and headgear.
1,030,071		Backpacks, sleeping bags, tents, snowshoes, skis and camping clothing, namely rainwear, parkas, vests, trousers, shoes, gloves and headgear.
1,102,407		Retail store, mail order, and distributorship services in the field of camping and outdoor gear, books, food, hardware and sports equipment.

Registration Number	Trademark	Goods and Services
983,624	THE NORTH FACE	Backpacks, sleeping bags, tents, snowshoes, skis and camping clothing, namely rainwear, parkas, vests, trousers, shoes, gloves and headgear.
1,030,071		Backpacks, sleeping bags, tents, snowshoes, skis and camping clothing, namely rainwear, parkas, vests, trousers, shoes, gloves and headgear.
2,097,715		Backpacks, sleeping bags, tents, snowshoes, skis and clothing, namely, parkas, vests, jackets, anoraks, pants, ski bibs, gloves, mittens, underwear, hats, headbands, caps, ski suits, gaiters, shorts, shirts and belts.
2,300,758		Shoes
2,897,197	NEVER STOP EXPLORING	Backpacks, luggage, duffel bags, waist packs, sleeping bags, tents, clothing, namely, t-shirts, tops, shorts, sweatshirt, sweaters, pants, jackets, vests, anoraks, ski suits, ski jackets, ski vests, rain jackets, and rain pants, footwear and headwear.
3,538,773		Bags, umbrellas, sleeping bags, tents, tent accessories, clothing, retail services

14. Attached to this complaint as Exhibit A are true copies of printouts from the United States Patent and Trademark Office (“USPTO”) website evidencing Plaintiff’s ownership of these trademarks. All of the registrations in Exhibit A are valid, subsisting, unrevoked and uncanceled. Many are also incontestable. The North Face also owns common law rights in these and other marks for use in connection with apparel. These registered and common law trademarks are collectively referred to as the “THE NORTH FACE Trademarks.”

15. THE NORTH FACE® Products, which feature the THE NORTH FACE Trademarks, include a range of apparel and outdoor products. Among the most well-known and popular of the THE NORTH FACE® Products is the iconic Denali fleece jacket, in which The North Face has valuable trade dress rights.

16. The North Face, through its licensee, conducts the THE NORTH FACE® business throughout the United States.

17. The THE NORTH FACE Trademarks have been widely promoted, both in the United States and throughout the world and are among the world’s most famous and widely recognized. Consumers, potential consumers and other members of the public and outdoor products industry not only associate THE NORTH FACE® Products with exceptional materials, style and workmanship, but also recognize that THE NORTH FACE® Products originate exclusively with The North Face.

18. The North Face maintains quality control standards for all of THE NORTH FACE® Products. All genuine THE NORTH FACE® Products are distributed through a worldwide network of authorized licensees, distributors, and retailers.

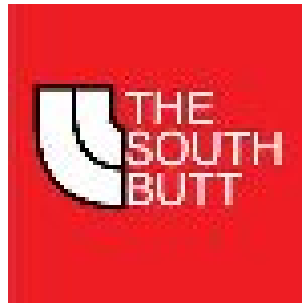
19. The THE NORTH FACE Trademarks are featured prominently in the advertising and promotion of THE NORTH FACE® Products. VF Outdoor, Inc. has spent hundreds of millions of dollars in advertising and promoting THE NORTH FACE® Products, which prominently bear the THE NORTH FACE Trademarks. THE NORTH FACE® Products bearing the THE NORTH FACE Trademarks have generated billions of dollars in sales. The THE NORTH

FACE Trademarks are highly visible and distinctive worldwide symbols of excellence in quality and uniquely associated with Plaintiff.

### **Defendants' Conduct**

20. In March of 2007, Defendant Winkelmann launched The South Butt as an apparel company organized in the State of Missouri.

21. As shown below, Defendants manufacture, advertise, distribute, offer for sale and/or sell a directly competing line of fleece jackets, T-shirts, and other apparel under trademarks, including "The South Butt" and "Never Stop Relaxing" as well as the design below, that are knock-offs of Plaintiff's trademarks (the "Infringing Trademarks"):



22. Defendants presently offer directly competing fleece jackets, T-shirts, and other apparel items bearing the Infringing Trademarks (the "Infringing Products"):



23. Among other directly competing products, Defendants manufacture, distribute, advertise, offer for sale and sell a fleece jacket that intentionally and directly copies Plaintiff's valuable marks and trade dress in its iconic Denali Jacket:



**THE NORTH FACE® Jacket**



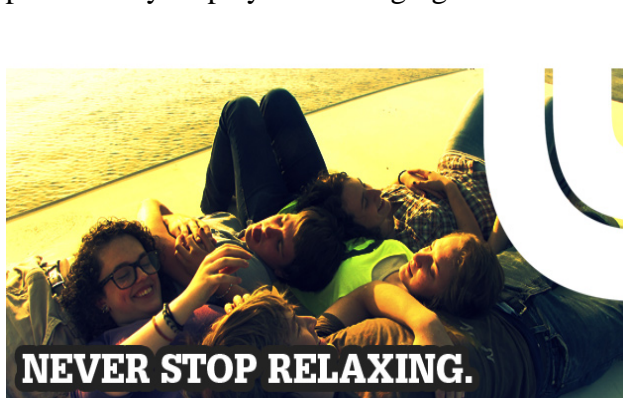
**THE SOUTH BUTT Jacket**



24. As shown in the screen-grab image below from the original version of The South Butt Website, The South Butt Defendants use the Infringing Trademarks prominently at the top of the web page:



25. In a newly revised version of The South Butt Website, Defendants continue to prominently display the Infringing Trademarks:



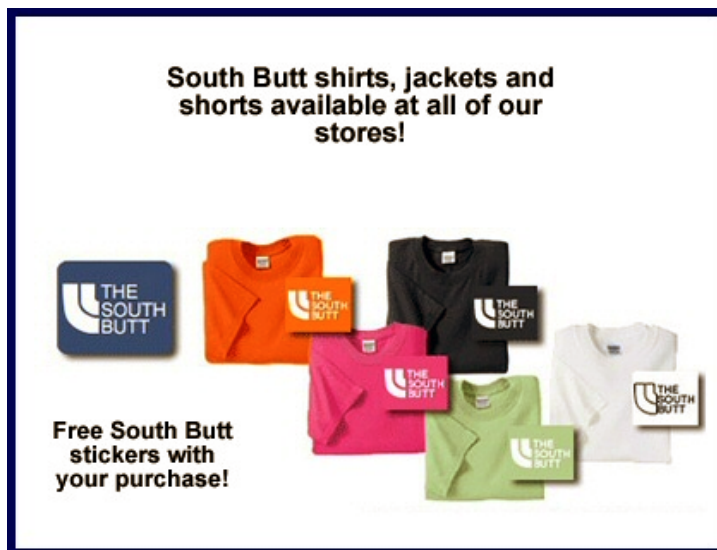
26. The Infringing Products are available for sale on The South Butt Website, with an online shop available on the Internet resolving at the URL [www.shop.thesouthbutt.net/](http://www.shop.thesouthbutt.net/) and in

Williams Pharmacies' brick-and-mortar stores in and around St. Louis, Missouri, which are located in this judicial district.

27. The South Butt Website prominently identifies Williams Pharmacies as the seller of the Infringing Products and lists contact information for Williams Pharmacies on The South Butt Website.

28. The South Butt Defendants also prominently feature and promote the Infringing Products bearing the Infringing Trademarks on the popular social networking sites Facebook and Twitter, available online at the respective URLs <http://www.facebook.com/pages/South-Butt/276080795511> and <http://twitter.com/thesouthbutt>.

29. Williams Pharmacies is fulfilling all telephone and online orders for the Infringing Products and prominently advertises the Infringing Products and Infringing Trademarks in the front window of at least one of its retail stores, on the sidewalk in front of at least one of its retail stores, and on the main page of the Williams Pharmacies website, as shown below (see also Exhibit B and Exhibit C):



30. Purchasers of the Infringing Products receive a free gift with each purchase in the form of a sticker that features The South Butt Website and the Infringing Trademarks:



31. The owner of Ladue Pharmacy, a Williams Pharmacies retail location, acts as Winkelmann’s sales manager and makes a commission on sales.

32. On November 19, 2008, The South Butt Defendants filed an application with the USPTO to register “The South Butt” design mark in Class 35 (Serial No. 77/617,979), shown below (see also Exhibit D) (the “First South Butt Trademark Application”):



33. Counsel for The North Face learned about the First South Butt Trademark Application after it was published for Opposition on August 4, 2009.

34. On August 14, 2009, counsel for Plaintiff contacted The South Butt Defendants to request that they stop manufacturing, distributing, selling and offering the Infringing Products for sale. A copy of Plaintiff’s counsel’s letter to The South Butt Defendants is annexed hereto as Exhibit E. On August 17, 2009, Plaintiff’s counsel opposed the First South Butt Trademark Application for registration to preserve The North Face’s rights.

35. Counsel for The South Butt Defendants responded to The North Face on September 10, 2009, refusing Plaintiff's request that The South Butt Defendants stop their infringing conduct. Counsel further stated that his client was interested in "[The] North Face acquiring [The South Butt] company, inclusive of its inventory, operational infrastructure, and intellectual property rights" and that counsel was authorized to offer to sell The South Butt to The North Face "for the sum of \$1,000,000.00." A copy of The South Butt Defendants' September 10, 2009 letter to Plaintiff's counsel is annexed hereto as Exhibit F.

36. About two weeks after counsel's September 10, 2009 letter, The South Butt Defendants filed yet a second application for registration with the U.S. Patent and Trademark Office, this time seeking to register "The South Butt" as a word mark in Class 25 (Serial No. 77/840,757) (the "Pending South Butt Trademark Application"). See Exhibit G.

37. Within this same time period, Defendants began actively pursuing media coverage concerning the matters described herein and provided correspondence between the parties, a press release, and interviews to the media. See Exhibit H.

38. The South Butt Defendants claimed, in statements to the media and on The South Butt Website -- where they stated the company is "getting slammed with orders due to the recent publicity" (see Exhibit J) -- that Defendants' sale of the Infringing Products had increased dramatically. See Exhibit I.

39. In the midst of the press activity, and alleged dramatic increase in commercial sales of the Infringing Products, The South Butt Defendants' counsel advised the media it was withdrawing his clients' offer to sell The South Butt to The North Face for \$1,000,000. See Exhibit I.

40. The South Butt Defendants have actively solicited additional retail locations to sell the Infringing Products and "Campus Reps" to represent the company on college campuses, directing interested parties to contact Defendants at retail@thesouthbutt.com and campusrep@thesouthbutt.com, respectively. See Exhibit J.

41. On September 26, 2009, The South Butt Defendants withdrew the First South Butt Trademark Application. Ten days later, the Trademark Trial and Appeal Board sustained Plaintiff's Opposition, entered judgment against The South Butt Defendants, and refused to register the First South Butt Trademark Application.

42. The South Butt Defendants have stated their intent to have the Infringing Products available in stores nationwide by spring 2010. See Exhibit K.

43. The South Butt has stated its sales for November alone reached over \$100,000.

44. Defendants have knowingly manufactured, advertised, offered for sale, sold and distributed the Infringing Products bearing one or more of the Infringing Trademarks in interstate, intrastate and foreign commerce, including commerce in the State of Missouri and in this judicial district. Defendants have also knowingly advertised and promoted the Infringing Products using the Infringing Trademarks on The South Butt Website and by prominently displaying the Infringing Products at Williams Pharmacies.

45. The use by Defendants of the Infringing Trademarks on or in connection with the manufacturing, advertising, offering for sale, sale and distribution of the Infringing Products is likely to cause confusion, or to cause mistake or to deceive.

46. Defendants are not authorized by Plaintiff to manufacture, advertise, distribute, sell or offer to sell products bearing the THE NORTH FACE Trademarks.

47. Upon information and belief, the Infringing Trademarks are being used by Defendants to mislead, deceive, and draw customers to the Infringing Products and away from Plaintiff's authentic products.

#### FIRST CLAIM FOR RELIEF

(Trademark Infringement – 15 U.S.C. § 1114 - Against All Defendants)

48. Plaintiff hereby realleges and incorporates by reference the preceding allegations of this Complaint as if fully set forth herein.

49. The THE NORTH FACE Trademarks and trade dress in the iconic Denali Jacket and the goodwill of the businesses associated with them in the United States and throughout the

world are of great and significant value, are highly distinctive and arbitrary, and have become universally associated in the public mind with the products and services of the very highest quality and reputation finding their source in The North Face.

50. Without Plaintiff's authorization or consent, and having knowledge of Plaintiff's well-known, famous, and prior rights in the THE NORTH FACE Trademarks and trade dress, and the fact that Defendants' Infringing Trademarks are confusingly similar to the THE NORTH FACE Trademarks, and the Infringing Products intentionally trade on The North Face's trademarks and trade dress, Defendants have intentionally and knowingly advertised, manufactured, distributed, offered for sale and/or sold the Infringing Products to the consuming public in direct competition with Plaintiff's sale of genuine products, in or affecting interstate commerce.

51. Defendants' use of the Infringing Trademarks is likely to cause and is causing confusion, mistake and deception among the general purchasing public as to the origin of Defendants' Infringing Products, and is likely to deceive the public into believing the Infringing Products sold by Defendants originate from, are associated with or are otherwise authorized by Plaintiff, all to the damage and detriment of The North Face's reputation, goodwill and sales.

52. Defendants' use of the Infringing Trademarks to advertise, manufacture, distribute, offer for sale and/or sell the Infringing Products to the consuming public was done with the willful intent to trade on Plaintiff's reputation and/or to infringe the THE NORTH FACE Trademarks and trade dress.

53. Defendants' use of the Infringing Trademarks is likely to cause initial confusion, mistake and deception among consumers who are drawn to the Infringing Products believing they originate from, are associated with or are otherwise authorized by Plaintiff, even if such consumers do not purchase Defendants' Infringing Products as a result of such confusion.

54. Defendants' use of the Infringing Trademarks is likely to cause and is causing post-sale confusion, mistake and deception among prospective consumers who did not purchase the

Infringing Products, but view them and believe the products bearing the Infringing Trademarks sold by Defendants originate from, are associated with or are otherwise authorized by Plaintiff, all to the damage and detriment of The North Face's reputation, goodwill and sales.

55. Plaintiff does not have an adequate remedy at law and, if Defendants' activities are not enjoined, Plaintiff will continue to suffer irreparable harm and injury to its goodwill and reputation.

56. As a result of Defendants' activities, Plaintiff has been damaged in an amount to be ascertained at trial.

### SECOND CLAIM FOR RELIEF

(Federal Trademark Dilution - 15 U.S.C. § 1125(c) – Against All Defendants)

57. Plaintiff hereby realleges and incorporates by reference the preceding allegations of this Complaint as if fully set forth herein.

58. The THE NORTH FACE Trademarks are "famous marks" within the meaning of § 43(c) of the Lanham Act, 15 U.S.C. § 1125(c) and have been famous marks prior to Defendants' conduct as alleged herein.

59. Defendants' advertisement, manufacture, distribution, sale and/or offer for sale in commerce of products bearing the Infringing Trademarks is likely to cause dilution by blurring, and/or dilution by tarnishment, of the distinctive quality of the THE NORTH FACE Trademarks, and was done with the willful intent to trade on Plaintiff's reputation and/or to cause dilution of the THE NORTH FACE Trademarks.

60. Defendants' unauthorized use of the THE NORTH FACE Trademarks was done with notice and full knowledge that such manufacture, distribution, sale and/or offer for sale was not authorized or licensed by Plaintiff.

61. Defendants' aforesaid acts are in knowing and willful violation of Plaintiff's rights under section 43(c) of the Lanham Act, 15 U.S.C. § 1125(c).

62. Plaintiff has no adequate remedy at law and, if Defendants' activities are not enjoined, will continue to suffer irreparable harm and injury to Plaintiff's goodwill and reputation.

63. As a result of Defendants' activities, Plaintiff has been damaged in an amount to be ascertained at trial.

THIRD CLAIM FOR RELIEF

(False Designation of Origin – 15 U.S.C. § 1125(a) – Against All Defendants)

64. Plaintiff hereby realleges and incorporates by reference the preceding allegations of this Complaint as if fully set forth herein.

65. The Infringing Products are of the same general nature and type as Plaintiff's goods; as such, Defendants' use of the Infringing Trademarks is likely to cause confusion among the general purchasing public.

66. By misappropriating and using the THE NORTH FACE Trademarks, Defendants misrepresent and falsely describe to the general public the origin and source of Defendants' Infringing Products and create a likelihood of confusion by ultimate purchasers as to both the source and sponsorship of such merchandise.

67. Defendants' unlawful, unauthorized and unlicensed manufacturing, advertising, distributing, offering for sale and/or selling of the Infringing Products creates express and implied misrepresentations that the Infringing Products were created, authorized or approved by Plaintiff, all to Defendants' profit and Plaintiff's great damage and injury.

68. Defendants' aforesaid acts are in violation of Section 43(a) of the Lanham Act, 15 U.S.C. § 1125(a), in that Defendants' use of the THE NORTH FACE Trademarks, in connection with the Infringing Products, in interstate commerce constitutes false designation of origin and unfair competition.

69. Plaintiff has no adequate remedy at law. If Defendants' activities are not enjoined, Plaintiff will continue to suffer irreparable harm and injury to its goodwill and reputation.



70. As a result of Defendants' activities, Plaintiff has been damaged in an amount to be ascertained at trial.

FOURTH CLAIM FOR RELIEF

(Contributory Trademark Infringement - Against The South Butt Defendants)

71. Plaintiff hereby realleges and incorporates by reference the preceding allegations of this Complaint as if fully set forth herein.

72. On information and belief, The South Butt Defendants are intentionally inducing others to infringe the THE NORTH FACE Trademarks.

73. On information and belief, The South Butt Defendants continue to supply Williams Pharmacies, and actively solicit other third party retailers and representatives, with the Infringing Products with actual or constructive knowledge of the infringing activities described herein.

74. Defendants directly control or monitor the advertisement, distribution, offer for sale and/or sale of Infringing Products with actual or constructive knowledge that such advertisement, distribution, offer for sale and sale infringes the THE NORTH FACE Trademarks.

75. Defendants' conduct has been willful and intentional, and Defendants engaged in the actions alleged herein with the purpose of confusing customers and trading on the goodwill associated with the THE NORTH FACE Trademarks.

76. As a result of Defendants' activities, Plaintiff has been damaged in an amount to be ascertained at trial.

77. Defendants' conduct will continue unless enjoined by this Court.

78. As a direct result of Defendants' willful and unlawful actions, The North Face has suffered and continues to suffer irreparable harm, including damage to and diminution in value of the THE NORTH FACE Trademarks, for which there is no adequate remedy at law.

Accordingly, The North Face is entitled to injunctive and equitable relief.

FIFTH CLAIM FOR RELIEF

(Common Law Trademark Infringement – Against All Defendants)

79. Plaintiff hereby realleges and incorporates by reference the preceding allegations of this Complaint as if fully set forth herein.

80. As a result of Plaintiff's hard work and investments in producing, providing and promoting THE NORTH FACE<sup>®</sup> Products, The North Face has built-up valuable good will in the THE NORTH FACE Trademarks. As such, the THE NORTH FACE Trademarks have become associated with THE NORTH FACE<sup>®</sup> Products, and have come to symbolize the reputation for quality and excellence of THE NORTH FACE<sup>®</sup> Products.

81. Defendants' unauthorized use of the THE NORTH FACE Trademarks is likely to and does permit Defendants to pass off their Infringing Products to the general public to the detriment of Plaintiff and the unjust enrichment of Defendants. Such acts by Defendants have caused and continue to cause confusion as to the source and/or sponsorship of the Infringing Products.

82. Defendants' acts constitute willful infringement of Plaintiff's exclusive rights in the THE NORTH FACE Trademarks, in violation of state common law.

83. As a direct and proximate result of Defendants' conduct, Plaintiff has suffered damage to its valuable trademarks in an amount to be ascertained at trial.

84. Plaintiff does not have an adequate remedy at law, and will continue to be damaged by Defendants' sale of the Infringing Products unless this Court enjoins Defendants from such fraudulent business practices.

SIXTH CLAIM FOR RELIEF

(Common Law Unfair Competition- Against All Defendants)

85. Plaintiff re-alleges and incorporates by reference the allegations set forth in the proceeding paragraphs of this Complaint.

86. As a result of Plaintiff's hard work in producing, providing and promoting THE NORTH FACE<sup>®</sup> Products, Plaintiff has built-up valuable good will in the THE NORTH FACE Trademarks. As such, the THE NORTH FACE Trademarks have become associated with THE NORTH FACE<sup>®</sup> Products, and have come to symbolize the reputation for quality and excellence of THE NORTH FACE<sup>®</sup> Products.

87. Defendants, with full knowledge of the fame of the THE NORTH FACE Trademarks, intended to and did trade on the goodwill associated with the THE NORTH FACE Trademarks.

88. Defendants' acts have misled and continue to mislead and deceive the public as to the source of the Infringing Products, permit and accomplish palming off of Defendants' goods as those of Plaintiff, and falsely suggest a connection with Plaintiff. Therefore, Defendants have committed unfair competition in violation of state common law.

89. As a direct and proximate result of Defendants' conduct, Plaintiff has suffered damage to its valuable trademarks in an amount to be ascertained at trial.

90. Plaintiff does not have an adequate remedy at law, and will continue to be damaged by Defendants' sale of the Infringing Products unless this Court enjoins Defendants from such fraudulent business practices.

SEVENTH CLAIM FOR RELIEF

(Violation of Missouri Anti-Dilution Statute - Mo. Rev. Stat. Chapter 417.061)

(Against All Defendants)

91. Plaintiff hereby realleges and incorporates by reference the preceding allegations of this Complaint as if fully set forth herein.

92. The THE NORTH FACE Trademarks are distinctive marks within the meaning of Chapter 417 of the Missouri Revised Statutes and have been distinctive and famous marks since prior to Defendants' conduct as alleged herein.

93. Defendants' advertisement, manufacture, distribution, sale and/or offer for sale in commerce of products bearing the Infringing Trademarks dilutes the distinctive quality of the

THE NORTH FACE Trademarks, and was and is being done with the willful intent to trade on Plaintiff's reputation and/or to cause dilution of the THE NORTH FACE Trademarks.

94. Defendants' unauthorized use of the THE NORTH FACE Trademarks was and is being done with notice and full knowledge that such manufacture, distribution, sale and/or offer for sale was not authorized or licensed by Plaintiff.

95. Defendants' aforesaid acts are in knowing and willful violation of Plaintiff's rights under Chapter 417.061 of the Missouri Revised Statutes.

96. Plaintiff has no adequate remedy at law and, if Defendants' activities are not enjoined, will continue to suffer irreparable harm and injury to Plaintiff's goodwill and reputation.

#### PRAYER FOR RELIEF

WHEREFORE, The North Face respectfully requests entry of judgment in its favor and against Defendants on all of the above causes of action as follows:

1. That this Court preliminarily and permanently enjoin Defendants, their officers, agents, servants, employees, attorneys and all persons in active concert or participation with any of them:
  - a. From using in any manner the THE NORTH FACE Trademarks, or any other designation that is confusingly similar to THE NORTH FACE or any of THE NORTH FACE marks, including, but not limited to the Infringing Trademarks, as to be likely to cause confusion, deception or mistake on or in connection with the manufacturing, advertising, distributing, offering for sale or selling of any product not Plaintiff's, or not authorized by Plaintiff to be sold in connection with each of THE NORTH FACE® Products or is likely to dilute the THE NORTH FACE Trademarks;
  - b. From passing off, inducing or enabling others to sell or pass off, any product as and for products produced by Plaintiff, not Plaintiff's, or not

produced under the control and supervision of Plaintiff and approved by Plaintiff for sale under the THE NORTH FACE Trademarks;

- c. From committing any acts calculated to cause purchasers to believe that the Infringing Products are those sold under the control and supervision of Plaintiff, or sponsored or approved by, or connected with, or guaranteed by, or produced under the control and supervision of Plaintiff;
- d. From further diluting and infringing the THE NORTH FACE Trademarks, and damaging Plaintiff's goodwill;
- e. From otherwise competing unfairly with Plaintiff in any manner; and
- f. From conspiring with, aiding, assisting or abetting any other person or business entity in engaging in or performing any of the activities referred to above;

2. That this Court enter a judgment finding that Defendants have infringed, and willfully infringed, the THE NORTH FACE Trademarks.

3. That this Court enter a judgment finding that Defendants have diluted, and willfully diluted, the THE NORTH FACE Trademarks.

4. That this Court enter a judgment finding that Defendants' use of the Infringing Trademarks have caused and/or are likely to cause confusion among the general purchasing public as to the source of origin of the Infringing Products.

5. That this Court enter a judgment finding that Defendants' use of the Infringing Trademarks have caused and/or are likely to cause initial interest and post-sale confusion among the general purchasing public as to the source of origin of the Infringing Products.

6. That this Court enter a judgment that the use or proposed use of the Pending South Butt Trademark Application (Trademark Application Serial No. 77/840,757) causes confusion or is likely to cause confusion with THE NORTH FACE Trademarks, dilutes the

distinctive quality of THE NORTH FACE Trademarks, and is likely to cause dilution of the distinctive quality of the THE NORTH FACE Trademarks.

7. That this Court order the withdrawal and abandonment of the Pending South Butt Trademark Application;

8. That this Court certify the above orders to the Director of the United States Patent and Trademark Office so the Director may make the appropriate entry upon the records of the Patent and Trademark Office pursuant to the Lanham Act, 15 U.S.C. § 1119.

9. That this Court order Defendants to deliver up for destruction or show proof of destruction of any and all products, advertisements, publications, labels and any other materials in their possession, custody, or control that depict or reference the trademarks covered by this Court's judgment;

10. That this Court order Defendants to file with this Court and to serve upon Plaintiff a report in writing and under oath setting forth in detail the manner and form in which Defendants have complied with any injunction resulting from this matter within thirty days after service of such injunction.

11. That this Court award The North Face such damages, compensatory and otherwise, as the proof may show.

12. That this Court award The North Face its reasonable attorneys' fees and costs incurred in connection with this action.

13. That this Court grant such other and further relief as this Court may deem just, proper and equitable under the circumstances.

Dated: December 10, 2009

Respectfully submitted,

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