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8 PULL & BEAR ESPAÑA, S.A. and ITX USA LLC

9 UNITED STATES DISTRICT COURT

10 NORTHERN DISTRICT OF CALIFORNIA – SAN FRANCISCO  
11

12 AIRWAIR INTERNATIONAL LTD., a  
company of the United Kingdom,

13 Plaintiff,

14 vs.  
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16 PULL & BEAR ESPAÑA, S.A., a  
company of Spain, ITX USA LLC, and  
DOES 1-50,

17 Defendants.  
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Case No. 3:19-cv-07641-SI

**DEFENDANT ITX USA LLC'S ANSWER  
AND COUNTERCLAIMS**

**DEMAND FOR JURY TRIAL**

Judge: The Honorable Susan Illston  
Courtroom: 1 – 17th Floor

Complaint Filed: Nov. 20, 2019

1 Defendant ITX USA LLC (“ITX” or “Defendant”), by its attorneys Arent Fox LLP, for  
2 their answer to the Amended Complaint of Plaintiff AirWair International Ltd. (“AirWair” or  
3 “Plaintiff”) allege as follows:

4 1. ITX lacks knowledge or information sufficient to form a belief about the truth of  
5 the allegations in paragraph 1, and therefore denies the allegations.

6 2. ITX lacks knowledge or information sufficient to form a belief about the truth of  
7 the allegations in paragraph 2, and therefore denies the allegations.

8 3. ITX admits that it is domiciled at 500 Fifth Avenue Suite 400, New York, NY  
9 10110. ITX denies the remaining allegations in Paragraph 3.

10 4. ITX admits that it operates the warehouse located at Easton 1, 1520 Van Buren  
11 Road Suite 200, Easton PA 18045 as a location for U.S. product returns. ITX lacks knowledge or  
12 information sufficient to form a belief about the truth of the remaining allegations in paragraph 4,  
13 and therefore denies the same.

14 5. ITX admits that it engages in e-commerce in the United States. ITX lacks  
15 knowledge or information sufficient to form a belief about the truth of the remaining allegations  
16 in paragraph 5, and therefore denies the same.

17 6. ITX admits that it operates a U.S.-facing website selling a broad range of clothing  
18 and footwear at <http://www.pullandbear.com/us>. ITX denies the remaining allegations in  
19 Paragraph 6.

20 7. ITX admits that it markets, distributes, and sells footwear products in the United  
21 States, and within this District, through the website located at [www.pullandbear.com/us](http://www.pullandbear.com/us). ITX  
22 further admits that Pull & Bear-branded footwear products are the subject matter of this action.  
23 ITX lacks knowledge or information sufficient to form a belief about the truth of the remaining  
24 allegations in paragraph 7, and therefore denies the same.

25 8. ITX lacks knowledge or information sufficient to form a belief about the truth of  
26 the allegations in paragraph 8, and therefore denies the same.

**JURISDICTION AND VENUE**

9. The allegations of paragraph 9 of the Amended Complaint consist of legal conclusions to which no response is necessary. To the extent a response is required, ITX admits that Plaintiff appears to intend to rely on 15 U.S.C. §1121 and 28 U.S.C. §1338(a) to establish subject matter jurisdiction in this matter. ITX denies the remaining allegations of Paragraph 9.

10. The allegations of paragraph 10 of the Amended Complaint consist of legal conclusions to which no response is necessary. To the extent a response is required, ITX admits that Plaintiff appears to intend to rely on 28 U.S.C. §1338(b) to establish pendant jurisdiction in this matter. ITX denies the remaining allegations of Paragraph 10.

11. ITX lacks knowledge or information sufficient to form a belief about the truth of the allegations in paragraph 11, and therefore denies the allegations.

12. The allegations of paragraph 12 of the Amended Complaint consist of legal conclusions to which no response is necessary. To the extent a response is required, ITX denies the allegations of paragraph 12, but does not contest personal jurisdiction solely with respect to it, to this action.

13. The allegations of paragraph 13 of the Amended Complaint consist of legal conclusions to which no response is necessary. To the extent a response is required, ITX denies the allegations of paragraph 13, but does not contest venue solely with respect to it, to this action.

**FACTUAL ALLEGATIONS**

14. ITX lacks knowledge or information sufficient to form a belief about the truth of the allegations in paragraph 14, and therefore denies the same.

15. ITX lacks knowledge or information sufficient to form a belief about the truth of the allegations in paragraph 15, and therefore denies the same.

16. ITX lacks knowledge or information sufficient to form a belief about the truth of the allegations in paragraph 16, and therefore denies the same.

1           17. ITX admits that Plaintiff purports to own trademark registrations, the validity and  
2 scope of which ITX questions. ITX lacks knowledge or information sufficient to form a belief  
3 about the truth of the allegations in paragraph 17, and therefore denies the same.

4           18. ITX lacks knowledge or information sufficient to form a belief about the truth of  
5 the allegations in paragraph 18, and therefore denies the same.

6           19. ITX lacks knowledge or information sufficient to form a belief about the truth of  
7 the allegations in paragraph 19, and therefore denies the same.

8           20. ITX denies the allegations in paragraph 20 of the Amended Complaint.

9           21. ITX denies the allegations in paragraph 21 of the Amended Complaint.

10          22. ITX denies the allegations in paragraph 22 of the Amended Complaint.

11          23. ITX lacks knowledge or information sufficient to form a belief about the truth of  
12 the allegations in paragraph 23, and therefore denies the same.

13          24. ITX lacks knowledge or information sufficient to form a belief about the truth of  
14 the allegations in paragraph 24, and therefore denies the same.

15          25. ITX lacks knowledge or information sufficient to form a belief about the truth of  
16 the allegations in paragraph 25, and therefore denies the same.

17          26. ITX denies the allegations of paragraph 26 of the Amended Complaint to the  
18 extent they claim that ITX “colluded” with any third-party or committed any unlawful act,  
19 including copying. With respect to the remaining allegations of paragraph 26 of the Amended  
20 Complaint, ITX lacks knowledge or information sufficient to form a belief about the truth of the  
21 allegations, and therefore denies the same.

22          27. ITX denies the allegations of paragraph 27 of the Amended Complaint to the  
23 extent they claim ITX committed any unlawful act. With respect to the remaining allegations of  
24 paragraph 27 of the Amended Complaint, ITX lacks knowledge or information sufficient to form  
25 a belief about the truth of the allegations, and therefore denies the same.

26          28. ITX denies the allegations of paragraph 28 of the Amended Complaint to the  
27 extent they claim ITX committed any unlawful act, and that “Pull & Bear is ITX and ITX is Pull  
28

1 & Bear.” With respect to the remaining allegations of paragraph 28 of the Amended Complaint,  
2 ITX lacks knowledge or information sufficient to form a belief about the truth of the allegations,  
3 and therefore denies the same.

4 29. ITX denies the allegations of paragraph 29 of the Amended Complaint to the  
5 extent they claim ITX had any involvement with infringing styles. With respect to the remaining  
6 allegations of paragraph 29 of the Amended Complaint, ITX lacks knowledge or information  
7 sufficient to form a belief about the truth of the allegations, and therefore denies the same.

8 30. ITX lacks knowledge or information sufficient to form a belief about the truth of  
9 the allegations in paragraph 30, and therefore denies the same.

10 31. ITX admits that it operates the U.S. website located at [www.pullandbear.com/us](http://www.pullandbear.com/us).  
11 ITX denies the allegations of paragraph 31 of the Amended Complaint to the extent they claim  
12 that ITX committed any unlawful act, including with respect to any infringing styles. With  
13 respect to the remaining allegations of paragraph 31 of the Amended Complaint, ITX lacks  
14 knowledge or information sufficient to form a belief about the truth of the allegations, and  
15 therefore denies the same.

16 32. ITX admits that it operates the U.S. website located at [www.pullandbear.com/us](http://www.pullandbear.com/us).  
17 ITX denies the allegations of paragraph 32 of the Amended Complaint to the extent they claim  
18 that ITX committed any unlawful act, including collusion, or that any third-party “controls” its  
19 website. With respect to the remaining allegations of paragraph 32 of the Amended Complaint,  
20 ITX lacks knowledge or information sufficient to form a belief about the truth of the allegations,  
21 and therefore denies the same.

22 33. ITX denies the allegations of paragraph 33 of the Amended Complaint to the  
23 extent they claim that ITX have committed any unlawful act. With respect to the remaining  
24 allegations of paragraph 33 of the Amended Complaint, ITX lacks knowledge or information  
25 sufficient to form a belief about the truth of the allegations, and therefore denies the same.

26 34. ITX admits that orders submitted on the website located at  
27 [www.pullandbear.com/us](http://www.pullandbear.com/us) are priced in U.S. Dollars and ship to the United States, including

1 California. ITX denies the allegations of paragraph 34 of the Amended Complaint to the extent  
2 they claim that ITX have committed any unlawful act. With respect to the remaining allegations  
3 of paragraph 34 of the Amended Complaint, ITX lacks knowledge or information sufficient to  
4 form a belief about the truth of the allegations and therefore denies the same.

5 35. ITX denies the allegations in paragraph 35 of the Amended Complaint.

6 36. ITX denies the allegations in paragraph 36 of the Amended Complaint.

7 37. ITX admits that it filed a statement of information with the California Secretary of  
8 State as a Limited Liability Company, registered in Delaware, and that the statement attached to  
9 the Amended Complaint is a copy of that statement of information. ITX denies the remaining  
10 allegations in paragraph 37 of the Amended Complaint.

11 38. ITX denies the allegations of paragraph 38 of the Amended Complaint to the  
12 extent they relate to ITX. With respect to the remaining allegations of paragraph 38 of the  
13 Amended Complaint, ITX lacks knowledge or information sufficient to form a belief about the  
14 truth of the allegations, and therefore denies the same.

15 39. ITX denies the allegations of paragraph 39 of the Amended Complaint to the  
16 extent they relate to ITX. With respect to the remaining allegations of paragraph 39 of the  
17 Amended Complaint, ITX lacks knowledge or information sufficient to form a belief about the  
18 truth of the allegations, and therefore denies the same.

19 40. ITX denies the allegations of paragraph 40 of the Amended Complaint to the  
20 extent they relate to ITX. With respect to the remaining allegations of paragraph 40 of the  
21 Amended Complaint, ITX lacks knowledge or information sufficient to form a belief about the  
22 truth of the allegations, and therefore denies the same.

23 41. ITX denies the allegations of paragraph 41 of the Amended Complaint to the  
24 extent they relate to ITX. With respect to the remaining allegations of paragraph 41 of the  
25 Amended Complaint, ITX lacks knowledge or information sufficient to form a belief about the  
26 truth of the allegations, and therefore denies the same.  
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1           42. ITX denies the allegations of paragraph 42 of the Amended Complaint to the  
2 extent they relate to ITX. With respect to the remaining allegations of paragraph 42 of the  
3 Amended Complaint, ITX lacks knowledge or information sufficient to form a belief about the  
4 truth of the allegations, and therefore denies the same.

5           43. ITX denies the allegations of paragraph 43 of the Amended Complaint to the  
6 extent they relate to ITX. With respect to the remaining allegations of paragraph 43 of the  
7 Amended Complaint, ITX lacks knowledge or information sufficient to form a belief about the  
8 truth of the allegations, and therefore denies the same.

9           44. ITX denies the allegations of paragraph 44 of the Amended Complaint to the  
10 extent they relate to ITX. With respect to the remaining allegations of paragraph 44 of the  
11 Amended Complaint, ITX lacks knowledge or information sufficient to form a belief about the  
12 truth of the allegations, and therefore denies the same.

### 13           **FIRST CLAIM FOR RELIEF**

14           45. ITX alleges and incorporates by reference its responses to paragraphs 1 through 44  
15 of the Amended Complaint.

16           46. ITX denies the allegations of paragraph 46 of the Amended Complaint to the  
17 extent they relate to ITX. With respect to the remaining allegations of paragraph 46 of the  
18 Amended Complaint, ITX lacks knowledge or information sufficient to form a belief about the  
19 truth of the allegations, and therefore denies the same.

20           47. ITX denies the allegations of paragraph 47 of the Amended Complaint to the  
21 extent they relate to ITX. With respect to the remaining allegations of paragraph 47 of the  
22 Amended Complaint, ITX lacks knowledge or information sufficient to form a belief about the  
23 truth of the allegations, and therefore denies the same.

24           48. ITX denies the allegations of paragraph 48 of the Amended Complaint to the  
25 extent they relate to ITX. With respect to the remaining allegations of paragraph 48 of the  
26 Amended Complaint, ITX lacks knowledge or information sufficient to form a belief about the  
27 truth of the allegations, and therefore denies the same.



1           56. ITX denies the allegations of paragraph 56 of the Amended Complaint to the  
2 extent they relate to ITX. With respect to the remaining allegations of paragraph 56 of the  
3 Amended Complaint, ITX lacks knowledge or information sufficient to form a belief about the  
4 truth of the allegations, and therefore denies the same.

5           57. ITX denies the allegations of paragraph 57 of the Amended Complaint to the  
6 extent they relate to ITX. With respect to the remaining allegations of paragraph 57 of the  
7 Amended Complaint, ITX lacks knowledge or information sufficient to form a belief about the  
8 truth of the allegations, and therefore denies the same.

9           58. ITX denies the allegations of paragraph 58 of the Amended Complaint to the  
10 extent they relate to ITX. With respect to the remaining allegations of paragraph 58 of the  
11 Amended Complaint, ITX lacks knowledge or information sufficient to form a belief about the  
12 truth of the allegation , and therefore denies the same.

#### 13 **FOURTH CLAIM FOR RELIEF**

14           59. ITX alleges and incorporates by reference its responses to paragraphs 1 through 58  
15 of the Amended Complaint.

16           60. ITX denies the allegations of paragraph 60 of the Amended Complaint to the  
17 extent they relate to ITX. With respect to the remaining allegations of paragraph 60 of the  
18 Amended Complaint, ITX lacks knowledge or information sufficient to form a belief about the  
19 truth of the allegations, and therefore denies the same.

20           61. ITX denies the allegations of paragraph 61 of the Amended Complaint to the  
21 extent they relate to ITX. With respect to the remaining allegations of paragraph 61 of the  
22 Amended Complaint, ITX lacks knowledge or information sufficient to form a belief about the  
23 truth of the allegations, and therefore denies the same.

24           62. ITX denies the allegations of paragraph 62 of the Amended Complaint to the  
25 extent they relate to ITX. With respect to the remaining allegations of paragraph 62 of the  
26 Amended Complaint, ITX lacks knowledge or information sufficient to form a belief about the  
27 truth of the allegations, and therefore denies the same.

**FIFTH CLAIM FOR RELIEF**

63. ITX alleges and incorporates by reference its responses to paragraphs 1 through 62 of the Amended Complaint.

64. ITX denies the allegations of paragraph 64 of the Amended Complaint to the extent they relate to ITX. With respect to the remaining allegations of paragraph 64 of the Amended Complaint, ITX lacks knowledge or information sufficient to form a belief about the truth of the allegations, and therefore denies the same.

65. ITX denies the allegations of paragraph 65 of the Amended Complaint to the extent they relate to ITX. With respect to the remaining allegations of paragraph 65 of the Amended Complaint, ITX lacks knowledge or information sufficient to form a belief about the truth of the allegations, and therefore denies the same.

**SIXTH CLAIM FOR RELIEF**

66. ITX alleges and incorporates by reference its responses to paragraphs 1 through 65 of the Amended Complaint.

67. ITX denies the allegations of paragraph 67 of the Amended Complaint to the extent they relate to ITX. With respect to the remaining allegations of paragraph 67 of the Amended Complaint, ITX lacks knowledge or information sufficient to form a belief about the truth of the allegations, and therefore denies the same.

68. ITX denies the allegations of paragraph 68 of the Amended Complaint to the extent they relate to ITX. With respect to the remaining allegations of paragraph 68 of the Amended Complaint, ITX lacks knowledge or information sufficient to form a belief about the truth of the allegations, and therefore denies the same.

69. ITX denies the allegations of paragraph 69 of the Amended Complaint to the extent they relate to ITX. With respect to the remaining allegations of paragraph 69 of the Amended Complaint, ITX lacks knowledge or information sufficient to form a belief about the truth of the allegations, and therefore denies the same.

70. ITX denies the allegations of paragraph 70 of the Amended Complaint to the extent they relate to ITX. With respect to the remaining allegations of paragraph 70 of the Amended Complaint, ITX lacks knowledge or information sufficient to form a belief about the truth of the allegations, and therefore denies the same.

71. ITX denies the allegations of paragraph 71 of the Amended Complaint to the extent they relate to ITX. With respect to the remaining allegations of paragraph 71 of the Amended Complaint, ITX lacks knowledge or information sufficient to form a belief about the truth of the allegations, and therefore denies the same.

## **PRAYER FOR RELIEF**

ITX denies that Plaintiff is entitled to any of the requested relief or remedies as outlined in subparts A through J.

## DEFENSES

Pursuant to Federal Rules of Civil Procedure 8(c), without assuming any burden that it would not otherwise, and reserving the right to assert additional defenses, at law or in equity, which may now exist or in the future may become known or available as the result of discovery in this case, Defendant asserts the following defenses:

## FIRST AFFIRMATIVE DEFENSE

The Amended Complaint, in whole or in part, fails to state a claim upon which relief may be granted.

## **SECOND AFFIRMATIVE DEFENSE**

The Amended Complaint, in whole or in part, is barred due to the absence of any injury or damage.

### THIRD AFFIRMATIVE DEFENSE

The Amended Complaint, in whole or in part, is barred by the equitable doctrines of estoppel, laches, unclean hands statute of limitations, waiver and/or other applicable equitable defenses.

**FOURTH AFFIRMATIVE DEFENSE**

ITX’s alleged infringing use of the purported trade dress designs at issue (to the extent that any uses by ITX infringed any protectable trade dress owned by Plaintiff) constitutes fair use because ITX did not intend to or attempt to capitalize on Plaintiff’s alleged goodwill.

**FIFTH AFFIRMATIVE DEFENSE**

Plaintiff is not entitled to any relief because ITX has not infringed, directly or indirectly, Plaintiff’s purported trade dress designs.

**SIXTH AFFIRMATIVE DEFENSE**

Plaintiff does not own any protectable trade dress rights given Plaintiff’s trade dress rights are invalid, and qualify, without limitation, as functional, generic, ornamental, and/or not distinctive.

**SEVENTH AFFIRMATIVE DEFENSE**

If Plaintiff suffered damages, though none are admitted, Plaintiff failed to mitigate its damages.

**EIGHTH AFFIRMATIVE DEFENSE**

To the extent that Plaintiff’s purported trade dress rights were infringed upon by ITX, ITX acted in good faith and without any intent to infringe Plaintiff’s purported rights.

**NINTH AFFIRMATIVE DEFENSE**

ITX reserves the right to assert other affirmative defenses which may become appropriate after discovery.

**COUNTERCLAIMS**

Counter-Plaintiff ITX USA LLC (“ITX” or “Counter-Plaintiff”), by its attorneys Arent Fox LLP, in support of its counterclaims against Counter-Defendant AirWair International Ltd. (“AirWair” or “Counter-Defendant”) alleges as follows:

1. Counter-Plaintiff ITX USA LLC is a Delaware Limited Liability Company, domiciled and with its principal place of business at 500 Fifth Avenue Suite 400, New York, NY 10110.

2. Counter-Defendant AirWair is a company of the United Kingdom located and doing business at 28 Jamestown Road, Camden Town, London NW1 7BJ, United Kingdom.

### **JURISDICTION AND VENUE**

3. This Court has subject matter jurisdiction pursuant to 28 U.S.C. §2201 to declare the rights of any party seeking a declaration, and pursuant to 15 U.S.C. §1121 as this action arises from AirWair's claims that ITX's advertisement and sale of footwear is likely to cause confusion with AirWair's footwear and infringe AirWair's purported trade dress. This Court also has federal subject matter jurisdiction over trademark disputes pursuant to 28 U.S.C. §§1331 and 1338.

4. This Court has personal jurisdiction over AirWair because it filed its Complaint and Amended Complaint in this District and therefore purposefully availed itself of the Court's personal jurisdiction. Further, AirWair does business in the state of California and has sufficient minimum contacts with this state.

5. Venue in this District is proper pursuant to 28 U.S.C. §1391 and because AirWair filed its Complaint and Amended Complaint in this District and therefore consented to venue in this Court.

### **FACTS**

6. ITX is a clothing, accessory, and footwear retailer that operates the website located at <http://www.pullandbear.com/us>, which markets, sells, and distributes goods to the United States. Products sold on ITX's website located at [www.pullandbear.com/us](http://www.pullandbear.com/us) include the footwear branded with the PULL & BEAR trademark as identified in Exhibit 6 to the Amended Complaint (the "Pull & Bear-branded Footwear") at issue in this matter.

7. AirWair is a footwear and accessory retailer, selling boots and shoes among other related products.

8. AirWair asserts five purportedly valid trademark registrations in their Complaint and Amended Complaint against ITX, attached to each as Exhibits 1 through 5.

9. Asserted U.S. Registration No. 2,437,750, attached to the Complaint and Amended Complaint as Exhibit 1 (the “750 Registration”), consists of a “welt stich located around the perimeter of footwear,” with a claim made to the color yellow.

10. Asserted U.S. Registration No. 2,437,751, attached to the Complaint and Amended Complaint as Exhibit 2 (the “751 Registration”), consists of “yellow stitching in the welt area and a two-toned grooved sole edge.”

11. Asserted U.S. Registration No. 2,102,468, attached to the Complaint and Amended Complaint as Exhibit 3 (the “468 Registration”), consists of the “design of an undersole.”

12. Asserted U.S. Registration No. 5,067,689, attached to the Complaint and Amended Complaint as Exhibit 4 (the “689 Registration”), consists of the “design of a sole edge including longitudinal ribbing and a dark color band over a light color.” The ‘689 Registration is not incontestable, and the ‘689 Registration was not awarded on the basis of acquired distinctiveness.

13. Asserted U.S. Registration No. 5,067,692, attached to the Complaint and Amended Complaint as Exhibit 5 (the “692 Registration”), consists of the “longitudinal ribbing and a dark color band over a light color, welt stitching, and a tab located on the top back heel of footwear.” The ‘692 Registration is not incontestable, and the ‘692 Registration was not awarded on the basis of acquired distinctiveness.

14. AirWair collectively refers to the five marks as the “Dr. Martens Trade Dress” or “Trade Dress” in the Complaint and the Amended Complaint. *See Am. Compl.* ¶18. AirWair alleges that each of the five marks (collectively referred to herein as the “Purported Trade Dress”) have been infringed by ITX in the Amended Complaint. *See Am. Compl.* [Dkt. 22] ¶¶26-31, 35-36, 38-44, 46-49, 51-52.

15. ITX’s actions related to the Pull & Bear-branded Footwear and the Pull & Bear-branded Footwear themselves do not infringe the Purported Trade Dress as none of the alleged footwear at issue contain the elements of all five registrations comprising the Purported Trade Dress. Further, the allegedly infringing Pull & Bear-branded Footwear do not infringe any of the Purported Trade Dress, individually.

1           16. For example, the Pull & Bear-branded Footwear does not make use of yellow welt  
2 stitching, specified in the ‘750 and ‘751 Registrations. Multiple designs identified in Exhibit 6 to  
3 the Amended Complaint do not include pull tabs (“Derby shoes with topstitching” and “White  
4 platform boots”). Further, none of the Pull & Bear-branded Footwear contain the expressed  
5 *combinations* of elements found in the Purported Trade Dress.

6           17. Additionally, AirWair’s Purported Trade Dress and the elements thereof are  
7 generic and functional, and therefore not registerable under 15 U.S.C. §1127. These elements  
8 (i.e., the two-color soles, specific tread patterns, welt stitching, and pull tabs) are therefore  
9 incapable of trade dress protection under the Lanham Act.

10           18. Lined tread patterns on the undersoles of shoes and boots (such as the one on the  
11 ‘468 Registration) are common on slip-resistant footwear. They provide friction and grip on  
12 unsteady surfaces and generate traction by dispersing liquids and loose materials. Further, tread  
13 patterns on the undersides of soles are neither generally visible, nor source-identifying. Here,  
14 AirWair’s purported tread patterns are generic, functional, and not protectable as trade dress.

15           19. Similarly, welt-stitching (a prime component of the ‘750, ‘751, and ‘692  
16 Registrations) is a widely-known and commonly used method of constructing shoes. The visible  
17 welt-stitching as identified in the ‘750, ‘751, and ‘692 Registrations allows for the easier repair of  
18 soles in the event of damage, and is commonly used to make shoes water-resistant and supportive.  
19 The welt-stitching for which AirWair claims protection is functional, generic, and not protectable  
20 as trade dress.

21           20. Pull tabs on the upper back part of the heel of a shoe are also functional elements  
22 not protectable as trade dress. They are used to assist shoe wearers and avoid the use of a shoe  
23 horn.

24           21. AirWair’s claims trademark protection for two-toned shoes and/or boots involving  
25 a darker color over a lighter color. But, this would include nearly every piece of footwear ever  
26 made incorporating two different colors – particularly those in which one section is inevitably  
27

1 darker than the other. Such generic design is not, and has never been associated with footwear  
 2 created by AirWair, nor should it be.

3 22. The Purported Trade Dress and the elements comprising those Registrations are  
 4 common and generic, and relate to styles of shoes not solely associated with AirWair, or any  
 5 other single producer. Other manufacturers and retailers, such as H&M, Forever 21, Delia's,  
 6 Target, and others produce similar styles of footwear which make use of the allegedly protectable  
 7 elements of the Purported Trade Dress. Notably, similar footwear was produced before AirWair's  
 8 first use in commerce, both domestically and worldwide.

9 23. AirWair's Purported Trade Dress is not understood by consumers to identify  
 10 AirWair as the source of the products embodying the Purported Trade Dress as claimed.

### 11 **FIRST COUNTERCLAIM**

#### 12 **Declaration of Invalidity of the Purported Trade Dress**

13 24. ITX repeats and realleges each and every allegation contained in paragraphs 1  
 14 through 23, as if fully set forth herein.

15 25. AirWair asserts that it owns rights encompassed by the Purported Trade Dress and  
 16 has brought suit against, *inter alia*, ITX on the basis of those rights.

17 26. Therefore, an actual and justiciable controversy exists between Counter-Plaintiff  
 18 ITX and AirWair with respect to whether AirWair has any valid and/or enforceable intellectual  
 19 property rights encompassed by the Purported Trade Dress.

20 27. AirWair has no rights in the Purported Trade Dress because the Purported Trade  
 21 Dress and elements contained therein are functional and not entitled to legal protection.

22 28. AirWair has no rights in the Purported Trade Dress because the Purported Trade  
 23 Dress and elements contained therein are generic and not entitled to legal protection.

24 29. AirWair has no rights in the elements of the Purported Trade Dress described by  
 25 Registrations '689 and '692 because those elements and not inherently distinctive, they have not  
 26 acquired distinctiveness, and are therefore not entitled to legal protection.

30. The Purported Trade Dress is not understood by the public to identify AirWair as the source of the footwear claimed in the Amended Complaint to have been infringed.

31. For the above reasons, the Purported Trade Dress are not valid trademarks and are not protectable.

32. Counter-Plaintiff ITX seeks a declaratory judgement that the Purported Trade Dress is not protectable and that AirWair has no trade dress rights in the Purported Trade Dress under the Lanham Act or California statutory or common law.

## **SECOND COUNTERCLAIM**

### **Declaration of Non-Infringement and Non-Dilution**

33. ITX repeats and realleges each and every allegation contained in paragraphs 1 through 32 as if fully set forth herein.

34. AirWair asserts that it owns rights encompassed by the Purported Trade Dress and has brought suit against, *inter alia*, ITX on the basis of those rights, claiming that, *inter alia*, ITX has infringed or diluted AirWair's purported intellectual property rights encompassed by the Purported Trade Dress.

35. An actual and justiciable controversy exists between Counter-Plaintiff ITX and AirWair with respect to whether ITX has infringed or diluted AirWair's purported intellectual property rights encompassed by the Purported Trade Dress.

36. Counter-Plaintiff ITX did not infringe or dilute any of AirWair's rights with respect to the Purported Trade Dress.

37. Counter-Plaintiff ITX seeks a declaratory judgement that, even assuming Counter-Plaintiff ITX sold the Pull & Bear-branded Footwear as alleged in the Amended Complaint, it: (1) does not infringe any element of AirWair's Purported Trade Dress; (2) does not violate Section 32 of the Lanham Act, 15 U.S.C. §1114; (3) does not violate Section 43(a) of the Lanham Act, 15 U.S.C. §1125(a); does not violate Section 43(c) of the Lanham Act, 15 U.S.C. §1125(c); and (5) does not violate any California laws, including, but not limited to, *California Business & Professions Code* §§17200 *et seq.*, or 14247 *et seq.*

**THIRD COUNTERCLAIM**

**Cancellation**

38. ITX repeats and realleges each and every allegation contained in paragraph 1 through 37 as if fully set forth herein.

39. Because the trademark registrations underlying the Purported Trade Dress are functional, generic, and not distinctive, the ‘750, ‘751, ‘468, ‘689, and ‘692 Registrations should be cancelled.

**PRAYER FOR RELIEF**

WHEREFORE, Counter-Plaintiff ITX respectfully requests that this Court enter judgment for Counter-Plaintiff ITX on each and every counterclaim, and further that this Court:

a. Declare that AirWair’s Purported Trade Dress is not protectable under federal and state law and cancel the ‘750, ‘751, ‘468, ‘689, and ‘692 Registrations;

b. Declare the Counter-Plaintiffs do not infringe or dilute any rights AirWair alleges to have in the Purported Trade Dress, or otherwise in the designs of subject footwear sold under the Dr. Martens trademark, under the Lanham Act, California Business & Professions Code, California common law, or any other applicable laws;

c. Award Counter-Plaintiff ITX all costs in this action, including attorneys’ fees; and

d. Any other relief that the Court may deem just and proper.

**DEMAND FOR JURY TRIAL**

Defendant ITX demands a jury trial on all claims, defenses, and counterclaims.

Dated: March 6, 2020

Respectfully submitted,

**ARENT FOX LLP**

By: /s/Allan E. Anderson

ALLAN E. ANDERSON

JAKE GILBERT

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