

UNITED STATES DISTRICT COURT  
SOUTHERN DISTRICT OF NEW YORK

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CHRISTOPHE ROBERTS,

Plaintiff, Counter-Defendant.

-against-

PUMA NORTH AMERICA, INC.,

Defendant, Counterclaimant.

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Case No. 21-cv-2559

**ANSWER, AFFIRMATIVE DEFENSES,  
AND COUNTERCLAIM**

Defendant PUMA North America, Inc. (“Defendant” or “PUMA”), by and through its attorneys, Quarles & Brady LLP, hereby submit its Answer and Affirmative Defenses to the Complaint of Plaintiff Christophe Roberts, (“Plaintiff” or “Roberts”). The paragraphs in this Answer are numbered to respond with the paragraph numbers in Plaintiff’s Complaint. Any and all allegations in Plaintiff’s Complaint that are not specifically admitted are hereby denied.

Defendant states as follows:

**NATURE OF THE ACTION**

1. Plaintiff Christophe Roberts brings this action for preliminary injunction and permanent injunctive relief and damages against PUMA for infringement of Roberts’s intellectual property rights.

**ANSWER:** PUMA admits that Plaintiff Christophe Roberts has brought this Complaint for preliminary injunction and permanent injunctive relief and damages. PUMA denies that it has infringed any of Roberts’s alleged intellectual property rights, and denies the remaining allegations of paragraph 1.

2. This is case about willful infringement by PUMA, a global corporation, and its theft of Brooklyn-based award-winning black artist Christophe Roberts’s signature artwork and design.

**ANSWER:** PUMA denies the allegations of paragraph 2.

3. Roberts's calling card brand image is his "Roar" Mark registered with the United States Patent and Trademark Office ("USPTO") as:



**ANSWER:** PUMA is without sufficient knowledge or information to admit or deny the allegations of paragraph 3 and therefore denies the same.

4. As detailed below, PUMA hired several artists who worked with Roberts, and then began using iconography similar to Roberts.

**ANSWER:** PUMA denies the allegations of paragraph 4.

5. PUMA ultimately took Roberts Roar Mark, using a similar calligraphic ink outline and contour depiction of teeth with similar line weights and "wild style" aesthetic.

**ANSWER:** PUMA denies the allegations of paragraph 5.

6. When Roberts asked PUMA to cease and desist using his mark, PUMA indicated it did not really use the mark for sales, and intended to use it only promotionally.

**ANSWER:** PUMA denies the allegations of paragraph 6.

7. Instead, PUMA expanded sales of merchandise through, for example, a "Bite Back" line under its "Puma Basketball" clothing line using this infringing logo:



**ANSWER:** PUMA admits that it has used the phrase "Bite Back" in connection with apparel. PUMA admits it has used the design pictured in Paragraph 7. PUMA affirmatively

denies that its products used Roberts's trademark and denies that any PUMA product infringes upon any of Roberts's rights. PUMA denies any remaining allegations of paragraph 7.

8. Further, PUMA is using Roberts's trademark in large national ad campaigns targeting its products to National Basketball League ("NBA") consumers.

**ANSWER:** PUMA denies the allegations of paragraph 8.

9. Roberts works in fine art and is also famous in the "sneakerhead" community, i.e. individuals who participate in sneaker purchasing and culture, and as to which there is a large crossover to basketball and basketball related clothing and apparel.

**ANSWER:** PUMA is without sufficient knowledge or information to admit or deny the allegations of paragraph 9 and therefore denies the same.

10. Sneakerheads and others who follow Roberts's art have noticed PUMA's branding and informed Roberts that PUMA "stole" his artwork.

**ANSWER:** PUMA affirmatively denies the allegation that it "stole" any artwork. PUMA is without sufficient knowledge or information to admit or deny the remaining allegations of paragraph 10 and therefore denies the same.

11. Others have contacted Roberts to ask whether he is working with PUMA since his design appears on their merchandise.

**ANSWER:** PUMA denies that Roberts's design appears on PUMA's merchandise. PUMA is without sufficient knowledge or information to admit or deny the remaining allegations of paragraph 11 and therefore denies the same.

12. Roberts is about to launch his own product line in additional similar merchandise using his trademark.

**ANSWER:** PUMA is without sufficient knowledge or information to admit or deny the allegations of paragraph 12 and therefore denies the same.

13. Roberts's marketing campaigns, brand and image are in imminent danger of being crushed by PUMA's national marketing power and distribution channels.

**ANSWER:** PUMA denies the allegations of paragraph 13.

14. Accordingly, Roberts asserts federal and state claims for trademark infringement and unfair competition, statutory claims and trademark dilution under New York law.

**ANSWER:** PUMA admits that Roberts has asserted federal and state claims for trademark infringement and unfair competition, statutory claims, and trademark dilution under New York Law, but denies that Roberts has any basis for relief regarding any of those claims. PUMA denies the remaining allegations of paragraph 14.

15. Absent injunctive relief, Roberts will suffer irreparable harm to his goodwill, reputation, and business.

**ANSWER:** PUMA denies the allegations of paragraph 15.

#### **PARTIES JURISDICTION AND VENUE**

16. Roberts is a natural person and a citizen and resident of the State of New York, Kings County.

**ANSWER:** PUMA is without sufficient knowledge or information to admit or deny the allegations of paragraph 16 and therefore denies the same.

17. Upon information and belief, Defendant is a Delaware corporation with a principal place of business located 10 Lyberty Way, Westford Massachusetts 01886.

**ANSWER:** PUMA admits the allegations of paragraph 17.

18. Upon information and belief, Defendant has a registered agent in this District and can be served in New York City.

**ANSWER:** PUMA admits the allegations of paragraph 18.

19. Additionally, Defendant has a flagship store located at 609 5th Avenue, New York, New York 10017, with merchandise with the infringing trademark available for purchase.

**ANSWER:** PUMA admits that it has a flagship store located at 609 5th Avenue, New York, NY 10017. PUMA denies that it infringes Roberts's Roar Mark and denies the remaining allegations of paragraph 19.

20. As such, this Court has federal question subject matter jurisdiction pursuant to 28 U.S.C. § 1331 and 15 U.S.C. § 1121 since this is a civil action arising under the Lanham Act, 15 U.S.C. §§ 1051, *et seq.*

**ANSWER:** Paragraph 20 states a legal conclusion to which no answer is required. To the extent that an answer is required, PUMA admits that the Complaint purports to allege claims for violations of the Lanham Act as well as state law claims and that this Court has subject matter jurisdiction over such claims, provided that standing and other requirements are met, but PUMA denies that the Complaint states such a cause of action and/or that PUMA has or will commit any acts giving rise to such causes of action.

21. This Court has supplemental jurisdiction over the remaining claims pursuant to 28 U.S.C. § 1367 as they are so related to the federal claims in the action that they form part of the same case or controversy.

**ANSWER:** Paragraph 21 states a legal conclusion to which no answer is required. To the extent that an answer is required, PUMA denies that it has or will commit any acts that give rise to the claims asserted by Roberts in his Complaint. PUMA affirmatively states that, solely for the purposes of this action, this Court has supplemental jurisdiction.

22. Defendant transacts business in New York, committed tortious acts within New York, and caused injury to Roberts in New York.

**ANSWER:** PUMA admits that it transacts business in New York. PUMA denies that it has committed tortious acts within New York and denies that it has caused injury to Roberts within the State of New York. PUMA denies the remaining allegations of paragraph 22.

23. Roberts's claims, alleged below, arise from Defendant's activities in New York.

**ANSWER:** PUMA admits that it transacts business in New York. PUMA denies that it has committed tortious acts within New York and denies that it has caused injury to Roberts within the State of New York. PUMA denies the remaining allegations of paragraph 23.

24. Roberts's claims, alleged below, arise from Defendant's activities in New York.

In particular, upon information and belief, Defendant: (i) regularly solicits and conducts business in New York, (ii) contracts to supply goods and services in New York, (iii) engages in other persistent courses of conduct, and derives substantial revenue from goods used or consumed and services rendered in New York.

**ANSWER:** PUMA admits that it has directed business activities to consumers in the State of New York and that it has derived a commercial benefit from its business activities in the State of New York. PUMA denies that Roberts's claims arise from these activities in New York. PUMA denies the remaining allegations of Paragraph 24.

25. Moreover, Defendant committed acts of infringement at issue in this case in New York and in this District.

**ANSWER:** PUMA denies the allegations of paragraph 25.

26. Defendant's acts of infringement outside of New York caused injury to Roberts in New York, and Defendant expected or should reasonably have expected such acts to have consequences in New York.

**ANSWER:** PUMA denies the allegations of paragraph 26.

27. Accordingly, the Court has personal jurisdiction over Defendant pursuant to New York CPLR § 302.

**ANSWER:** PUMA admits that the Court has personal jurisdiction over PUMA, solely for the purposes of this action.

28. This Court also has personal jurisdiction over Defendant because, upon information and belief, Defendant has systematic and continuous contacts with the forum and Roberts's claims arises out of or relate to those contacts.

**ANSWER:** PUMA admits that this Court has personal jurisdiction over PUMA, solely for the purposes of this action. PUMA denies that its actions provide a basis for Roberts's claims and deny the remaining allegations of paragraph 28.

29. In addition, Defendant sells merchandise, including merchandise with the infringing trademark prominently displayed, on its highly interactive website, which is continuously accessible, and targets, sells, and ships goods to consumers in New York.

**ANSWER:** PUMA admits that it sells merchandise on its website and that it ships merchandise to consumers in New York. PUMA denies that it infringes Roberts's Roar Mark, and denies the remaining allegations contained in paragraph 29.

30. Pursuant to 28 U.S.C. § 1391, venue is proper in this Court because upon information and belief, the events or omissions giving rise to the claims occurred and continue to occur in the Southern District of New York.

**ANSWER:** Paragraph 30 states a legal conclusion to which no answer is required. To the extent that an answer is required, PUMA denies that it has or will commit any acts that give rise to the claims asserted by Roberts in his Complaint. PUMA affirmatively states that, solely for the purposes of this action, it does not contest venue in this Court.

**FACTS APPLICABLE TO ALL CLAIMS FOR RELIEF**

A. **Background**

31. Roberts is a talented, young, black, Brooklyn-based artist, well-known for his unique sculptures created using sneaker shoe boxes.

**ANSWER:** PUMA is without sufficient knowledge or information to admit or deny the allegations of paragraph 31 and therefore denies the same.

32. Roberts is a Chicago-reared artist of Bahamian and Southern Black American descent.

**ANSWER:** PUMA is without sufficient knowledge or information to admit or deny the allegations of paragraph 32 and therefore denies the same.

33. Roberts's artworks grapple with and complicate notions of home, masculinity, and consumerism.

**ANSWER:** PUMA is without sufficient knowledge or information to admit or deny the allegations of paragraph 33 and therefore denies the same.

34. Roberts creates sculptures, paintings, drawings, art installations, and artistic designs that are displayed at art shows, public events, social media, and other media outlets.

**ANSWER:** PUMA is without sufficient knowledge or information to admit or deny the allegations of paragraph 34 and therefore denies the same.

35. Roberts's work is often inspired from Caribbean and African folk tales and repurposes everyday objects to create found art and carbon footprint-free pieces.

**ANSWER:** PUMA is without sufficient knowledge or information to admit or deny the allegations of paragraph 35 and therefore denies the same.

36. His work has been widely exhibited and he has participated in notable shows throughout the United States, including without limitation, at Lyons Wier Gallery in New York, New York, NBA Allstar Week in Chicago, Illinois, NBA Art Week in Vancouver, Canada, Widen+Kennedy in Portland, Oregon, New Gallery of Modern Art in Charlotte, North Carolina, Long View Gallery in Washington D.C., Islip Art Museum in Long Island, New York, Mocada Museum in Brooklyn, New York, and Royal Ontario Museum in Toronto, Ontario.

**ANSWER:** PUMA is without sufficient knowledge or information to admit or deny the allegations of paragraph 36 and therefore denies the same.

37. Roberts also regularly collaborates with popular individuals and brands to create and exhibit his work, including Nike conventions such "Air Max Con 2016" and on Nike's website. *See Exhibit 1* annexed hereto is a true and accurate screenshot of Roberts featured on Nike's Website.

**ANSWER:** PUMA is without sufficient knowledge or information to admit or deny the allegations of paragraph 37 and therefore denies the same.

38. His ongoing commissions with Nike include sculptures as the Manhattan flagship store and the Staples Center as well as his commissioned sculptures and installations.

**ANSWER:** PUMA is without sufficient knowledge or information to admit or deny the allegations of paragraph 38 and therefore denies the same.

39. Roberts was prominently featured in a two-part highlight of his work by Esteban Serrano on *Complex*, a large media platform, with over 2.4 million subscribers on social media, that is focused on style, sneakers, and sports. *See Esteban Serrano, Christophe Roberts Shares His World of Sneaker Box Sculptures (Part 1)*, COMPLEX (Mar. 16, 2018), <https://www.complex.com/sneakers/2018/03/christophe-roberts-shares-his-world-of-sneaker-box-sculptures-2>.



**ANSWER:** PUMA is without sufficient knowledge or information to admit or deny the allegations of paragraph 39 and therefore denies the same.

40. Roberts was recently awarded the 2020 Colene Brown Art Prize, which awards grants to ten New York-based visual artists.

**ANSWER:** PUMA is without sufficient knowledge or information to admit or deny the allegations of paragraph 40 and therefore denies the same.

41. Roberts has also been successful in commissioning multiple private pieces.

**ANSWER:** PUMA is without sufficient knowledge or information to admit or deny the allegations of paragraph 41 and therefore denies the same.

42. Moreover, Roberts is immersed in sneaker culture and recognized as a “sneakerhead.”

**ANSWER:** PUMA is without sufficient knowledge or information to admit or deny the allegations of paragraph 42 and therefore denies the same.

43. Sneakerhead is a term referring to a sneaker enthusiast, who collects and trades sneakers as a hobby, and who is typically knowledgeable about the history of sneakers.

**ANSWER:** PUMA is without sufficient knowledge or information to admit or deny the allegations of paragraph 43 and therefore denies the same.

44. Sneakerhead culture has a strong overlap with basketball related merchandising, clothing, marketing, and art.

**ANSWER:** PUMA is without sufficient knowledge or information to admit or deny the allegations of paragraph 44 and therefore denies the same.

45. Roberts’s popularity and notoriety have allowed him to grow a successful business, which includes selling merchandise such as t-shirts, jackets, hats, posters, pins, and more.

**ANSWER:** PUMA is without sufficient knowledge or information to admit or deny the allegations of paragraph 45 and therefore denies the same.

46. Through extensive efforts and energy, Roberts developed substantial brand recognition and goodwill.

**ANSWER:** PUMA is without sufficient knowledge or information to admit or deny the allegations of paragraph 46 and therefore denies the same.

47. Since as early as 2013, Roberts used a unique stylized symbol, which he designed himself, as his artistic signature and to represent his overall brand (the “Roar Mark”).

**ANSWER:** PUMA is without sufficient knowledge or information to admit or deny the allegations of paragraph 47 and therefore denies the same.

48. Beginning in or around 2013, Roberts began using the Roar Mark on all of his art and social media, including his Instagram account “@therealchristophe,” and website at <https://www.christopheroberts.com>.

**ANSWER:** PUMA is without sufficient knowledge or information to admit or deny the allegations of paragraph 48 and therefore denies the same.

49. In early 2014, Roberts first used the mark in commerce through a jacket he designed which prominently featured the mark.

**ANSWER:** PUMA is without sufficient knowledge or information to admit or deny the allegations of paragraph 49 and therefore denies the same.

B. The Registered “Roar Mark” Design and Use

50. The Roar Mark consists of a design of an outline of sharp teeth, wherein the design consists of an upper row of teeth and lower row of teeth, each of which is depicted as an individual hand-drawn outline.

**ANSWER:** PUMA is without sufficient knowledge or information to admit or deny the allegations of paragraph 50 and therefore denies the same.

51. The Roar Mark, featured below, has become synonymous with Christophe Roberts and is a core part of his professional identity.



**ANSWER:** PUMA is without sufficient knowledge or information to admit or deny the allegations of paragraph 51 and therefore denies the same.

52. In or about early 2014, a jacket designed for Roberts's brand, featured below, that prominently featured his Roar Mark.



**ANSWER:** PUMA is without sufficient knowledge or information to admit or deny the allegations of paragraph 52 and therefore denies the same.

53. The above jacket was the first time Roberts used the Roar Mark on merchandise in commerce in or about early 2014.

**ANSWER:** PUMA is without sufficient knowledge or information to admit or deny the allegations of paragraph 53 and therefore denies the same.

54. In or about the summer of 2014, Roberts expanded his merchandise and started selling jackets, t-shirts, hoodies, and pins with the Roar Mark prominently featured.

**ANSWER:** PUMA is without sufficient knowledge or information to admit or deny the allegations of paragraph 54 and therefore denies the same.

55. Roberts promoted his Roar Mark on all his merchandise, including without limitation, jackets, t-shirts, hoodies, pins.

**ANSWER:** PUMA is without sufficient knowledge or information to admit or deny the allegations of paragraph 55 and therefore denies the same.

56. Roberts uses the Roar Mark in all his advertisements and promoted his merchandise and art under the Roar Mark.

**ANSWER:** PUMA is without sufficient knowledge or information to admit or deny the allegations of paragraph 56 and therefore denies the same.

57. Roberts also invested in paid advertisements on social media to expand his brand's reach.

**ANSWER:** PUMA is without sufficient knowledge or information to admit or deny the allegations of paragraph 57 and therefore denies the same.

58. Roberts recently hired public relations personnel to expand his brand reach.

**ANSWER:** PUMA is without sufficient knowledge or information to admit or deny the allegations of paragraph 58 and therefore denies the same.

59. The Roar Mark continues to be prominently featured on both his art work and his merchandise.

**ANSWER:** PUMA is without sufficient knowledge or information to admit or deny the allegations of paragraph 59 and therefore denies the same.

60. Roberts's merchandise is advertised promoted, and offered for sale at his studio, Manza Studios, in Brooklyn, New York, art shows he attends—including the 2014 Afropunk Festival—and on his website at <https://www.christopheroberts.com/manzastudios>.

**ANSWER:** PUMA is without sufficient knowledge or information to admit or deny the allegations of paragraph 60 and therefore denies the same.

61. In or about December 2020, Roberts removed all of his merchandise for sale from his website in order to prepare for the relaunch of his brand on the website.

**ANSWER:** PUMA is without sufficient knowledge or information to admit or deny the allegations of paragraph 61 and therefore denies the same.

62. Roberts's brand relaunch is currently scheduled for mid-April 2021, after which all of Roberts's merchandise, baring the Roar Mark, will be available online for purchase. Annexed as Exhibit 2 hereto is a true and accurate depiction of examples of Roberts merchandise bearing the Roar Mark. Annexed as Exhibit 3 hereto is a true and accurate depiction of Roberts's prominent display and use of his Roar Mark on his artwork on his website, his studio, and at various art showings.

**ANSWER:** PUMA is without sufficient knowledge or information to admit or deny the allegations of paragraph 62 and therefore denies the same.

63. Exhibit 3 annexed hereto depicts some of Roberts's prominent use of his Roar Mark in his art and at his art installations.

**ANSWER:** PUMA is without sufficient knowledge or information to admit or deny the allegations of paragraph 63 and therefore denies the same.

64. Roberts was one of two artists at the 2020 NBA Allstar week who had his own designated area.

**ANSWER:** PUMA is without sufficient knowledge or information to admit or deny the allegations of paragraph 64 and therefore denies the same.

65. Roberts's merchandise has been purchased by customers in many states across the United States, and internationally.

**ANSWER:** PUMA is without sufficient knowledge or information to admit or deny the allegations of paragraph 65 and therefore denies the same.

66. Roberts also has a strong social media presence on his Instagram account "@therealchristophe," where the Roar Mark is prominently featured in his posts and main profile picture.

**ANSWER:** PUMA is without sufficient knowledge or information to admit or deny the allegations of paragraph 66 and therefore denies the same.

C. Roberts's Successful Registration of the Roar Mark with the USPTO

67. On or about December 10, 2018, Roberts filed an application with the United States Patent and Trademark Office ("USPTO") to register the Roar Mark under Serial Number 88223502, noting a first use in 2012 and a first use in commerce in 2014.

**ANSWER:** PUMA is without sufficient knowledge or information to admit or deny the allegations of paragraph 67 and therefore denies the same.

68. On November 19, 2019, the USPTO registered The Roar Mark under Registration Number 5,912,449 for T-Shirts, hoodies, jackets, and custom design and development of visual art displays. See Exhibit 4.

**ANSWER:** PUMA admits that a copy of U.S Trademark Registration No. 5,912,449 was attached to the Complaint as Ex. 4, and affirmatively states that the registration speaks for itself.

69. Roberts continues to own and use the Roar Mark as a registered and active trademark.

**ANSWER:** PUMA is without sufficient knowledge or information to admit or deny the allegations of paragraph 69 and therefore denies the same.

D. Defendant's Discovery and Theft of the Roar Mark

70. In January 24 and 25 of 2018, Roberts created an art installation in New York, New York for The Gatorade Company ("Gatorade").

**ANSWER:** PUMA is without sufficient knowledge or information to admit or deny the allegations of paragraph 70 and therefore denies the same.

71. Roberts hired several people to help him execute the Gatorade art installation.

**ANSWER:** PUMA is without sufficient knowledge or information to admit or deny the allegations of paragraph 71 and therefore denies the same.

72. Around January 24, 2018, Emory Jones ("Mr. Jones") went to Roberts's exhibition at the Gatorade installation.

**ANSWER:** PUMA is without sufficient knowledge or information to admit or deny the allegations of paragraph 72 and therefore denies the same.

73. Upon information and belief, Mr. Jones worked with PUMA, and has an influential role in the PUMA Basketball division.

**ANSWER:** While Mr. Jones has collaborated with PUMA on various projects, including projects related to PUMA's Basketball division, Mr. Jones did not create, direct, or contribute to the development of the teeth graphics accused of infringement. As a result, PUMA denies the allegations of paragraph 73.

74. Roberts met and spoke with Mr. Jones at the Gatorade event.

**ANSWER:** PUMA is without sufficient knowledge or information to admit or deny the allegations of paragraph 74 and therefore denies the same.

75. After Roberts's Gatorade installation, Mr. Jones hired several people who worked with Roberts on the Gatorade installation.

**ANSWER:** PUMA is without sufficient knowledge or information to admit or deny the allegations of paragraph 75 and therefore denies the same.

76. Since then, PUMA Basketball has significantly integrated the Roar Mark into their merchandise collection.

**ANSWER:** PUMA denies the allegations of paragraph 76.

77. In or about June of 2018, Puma started publicly using the Roar Mark on merchandise, and the advertisements, marketing, and promotion of PUMA merchandise.

**ANSWER:** PUMA denies the allegations of paragraph 77.

E. Defendant's Infringement of the Mark to Promote its Basketball Merchandise

78. Specifically, PUMA has been marketing its line of NBA basketball products and prominently using the Roar Mark on its merchandise, including without limitation shirts, jackets, and sweatshirts (the "Infringing Products").

**ANSWER:** PUMA denies the allegations of paragraph 78.

79. Starting in or around June of 2018, PUMA's efforts to court consumers in the basketball market were widely reported.

**ANSWER:** PUMA admits that its launch of its basketball line in connection with the 2018 NBA Draft in June of 2018 was widely reported. PUMA denies any remaining allegations in paragraph 79.

80. For example, on June 21, 2018 Vox Media-owned sports blogging website SBNation published Kristian Winfield's article *Here's how PUMA is trying to get back into NBA sneakers*, which featured several photos and social media posts about a PUMA store near Barclay's Center in Brooklyn, New York selling merchandise with the Roar Mark. See <https://www.sbnation.com/2018/6/21/17490472/puma-hoops-nba-resurgence-marvin-bagley-deandre-ayton-michael-porter-jr-zhaire-smith>.



**ANSWER:** PUMA admits that the link in paragraph 80 is for an article entitled *Here's how PUMA is trying to get back into NBA sneakers*, and admits that PUMA had a store near Barclay's Center in Brooklyn, New York, and that it has used social media to promote products. PUMA denies that it has used the Roar Mark and denies that any of its products are infringing. PUMA is without sufficient knowledge or information to admit or deny the remaining allegations of paragraph 80, and therefore denies the same.

81. Similarly, on August 1, 2018, ESPN published Nick DePaula's article, *PUMA's unexpected NBA comeback: 'You can only surprise people once.'* See [https://www.espn.com/nba/story/\\_/id/24245215/how-sneaker-brand-puma-making-unexpected-comeback-world-basketball-sneakers-nba](https://www.espn.com/nba/story/_/id/24245215/how-sneaker-brand-puma-making-unexpected-comeback-world-basketball-sneakers-nba).



**ANSWER:** PUMA admits that the link in paragraph 81 is for an article entitled *PUMA's unexpected NBA comeback: 'You can only surprise people once.'* PUMA denies any remaining allegations of paragraph 81.

82. Reflecting PUMA's continuing efforts to brand in the basketball market, on June 11, 2019, Yahoo! Finance published Reggie Wade's article *How Puma is becoming relevant in basketball again*. This article featured a photo of Deandre Ayton, the first overall NBA draft pick of 2018, wearing a PUMA shirt with Roberts's Roar Mark prominently showcased. See, <https://finance.yahoo.com/news/how-puma-is-becoming-relevant-in-basketball-210335622.html>.



**ANSWER:** PUMA admits that the link in paragraph 82 is for an article entitled *How Puma is becoming relevant in basketball again*. PUMA denies that it has used Roberts's Roar Mark and denies that the shirt pictured uses Roberts's Roar Mark. PUMA admits that Deandre Ayton is wearing a PUMA shirt. PUMA is without sufficient knowledge or information to admit or deny the remaining allegations of paragraph 82, and therefore denies the same.

83. On August, 29, 2019 Sneakernews.com, a prominent sneaker and sneakerhead website, published Ross Dwyer's article, *PUMA Hoops Signs Knicks Rookie R.J. Barrett*. This article featured an @pumahoops social media post which depicted New York Knicks guard R.J. Barrett standing in front of a large multi-story Puma mural in featuring a portrait of Barrett and PUMA's logo. See, <https://sneakernews.com/2019/08/29/rj-barrett-puma-hoops-shoe-deal/>.

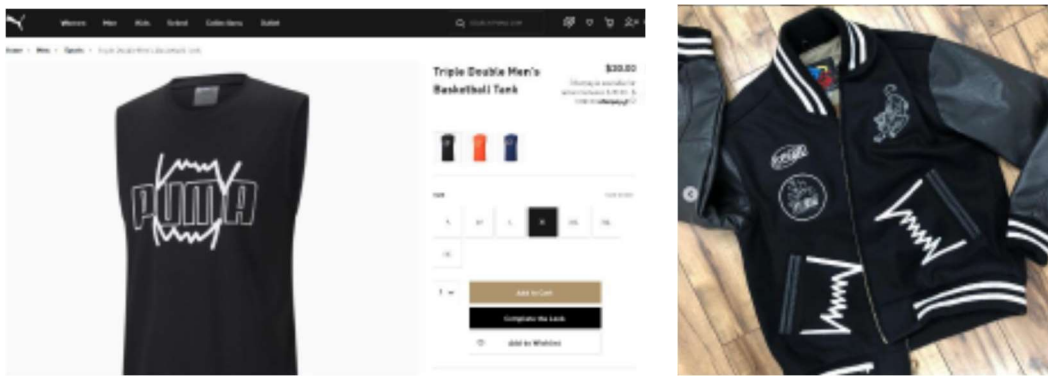
**ANSWER:** PUMA admits that the link in paragraph 83 is for an article entitled *PUMA Hoops Signs Nick Rookie R.J. Barrett*, and admits that it has used social media to promote

products and that the posts in the article are PUMA posts that featured Barrett and PUMA's logos. Puma is without sufficient knowledge or information to admit or deny the remaining allegations of paragraph 83, and therefore denies the same.

84. In short, PUMA used the Roar Mark as a prominent part of its valuable push into the basketball market.

**ANSWER:** PUMA denies the allegations of paragraph 84.

85. For example, featured below are just two examples of the ways PUMA infringed on Roberts's mark and incorporated it into its own merchandise available in commerce.



Annexed hereto as Exhibit 5 are true and accurate depictions of many examples of such Infringing Products since PUMA started using the Roar Mark in or around 2018. Annexed hereto as Exhibit 6 are true and accurate depictions of just some of the many examples of PUMA using the Roar Mark to market its products online via its website at <https://us.puma.com/en/us/home>, its PUMA Basketball Instagram at “@pumahoops”, and various other advertising efforts.

**ANSWER:** PUMA admits that it has used social media to promote products, and admits that it markets products on its website at <https://us.puma.com/en/us/home>. PUMA denies that it has used the Roar Mark and denies that any of its products are infringing. PUMA denies the remaining allegations of paragraph 85.

86. As shown in these images, Puma's infringing mark consists of an outline of teeth, similar to the Roar Mark.

**ANSWER:** PUMA denies the allegations of paragraph 86.

87. PUMA's infringing mark also uses a frontal perspective, similar to the Roar Mark.

**ANSWER:** PUMA denies the allegations of paragraph 87.

88. PUMA's infringing mark depicts only the contour of teeth and not a face or other aspect, similar to the Roar Mark.

**ANSWER:** PUMA denies the allegations of paragraph 88.

89. PUMA's infringing mark also uses a hand drawn ink and calligraphic style, similar to the Roar Mark.

**ANSWER:** PUMA denies the allegations of paragraph 89.

90. PUMA's infringing mark also uses a line feel known as "wild style" in graffiti art, similar to the Roar Mark.

**ANSWER:** PUMA denies the allegations of paragraph 90.

91. PUMA's infringing mark uses a similar line weight as Roberts' Roar Mark.

**ANSWER:** PUMA denies the allegations of paragraph 91.

92. In Short, PUMA's infringing mark is substantially similar to Roberts' Roar Mark.

**ANSWER:** PUMA denies the allegations of paragraph 92.

93. Continuing its infringement, PUMA Hoops set up a pop-up store in Brooklyn, New York, featured below, that blatantly used Roberts's mark not only on available Chinatown Market merchandise inside, but brazenly on the store front. See Irich, *Puma Hoops x Chinatown Market 2018 NBA Draft Pop Up Experience: The Return*, MORE THAN STATS, (June 23, 2018), <https://morethan-stats.com/puma-hoops-x-chinatown-market-2018-nba-draft-pop-up-experience/>.



**ANSWER:** PUMA admits that the link in paragraph 93 is for an article entitled *PUMA Hoops x Chinatown Market 2018 NBA Draft Pop Up Experience*. PUMA denies that it has used the Roar Mark and denies that any of its products are infringing. PUMA denies all the remaining allegations of paragraph 93.

94. PUMA has even copied Roberts's packaging of his merchandise. *See Exhibit 7*.

**ANSWER:** PUMA denies the allegations of paragraph 94.

95. As show in Exhibit 7, hereto, PUMA copied the packaging Roberts used to sell his t-shirt in (i.e. a white take-out container with the Roar Mark drawn on the top) next to a June 20, 2018 photo from @pumahoops Instagram photo marketing, upon information and belief, a limited edition shoe, with a white shoebox and the Roar Mark drawn on the lid.

**ANSWER:** PUMA admits that it has used social media to promote its products. PUMA denies that it has copied the packaging Roberts used to sell his t-shirt, denies that it used the Roar Mark and denies that any of its products are infringing. PUMA denies any remaining allegations of paragraph 95.

96. Additionally, as seen in a widely publicized photo, Shawn Corey Carter, professionally known as "JAY-Z" (hereinafter "Mr. Carter"), attending Game 3 of the NBA Finals on June 5, 2019 and wore a PUMA shirt clearly, and plainly displaying the Roar Mark in white lines on a black background. *See Exhibit 8*.

**ANSWER:** PUMA admits that Mr. Carter wore a PUMA shirt to Game 3 of the NBA Finals on June 5, 2019. PUMA denies that the PUMA shirt pictured displays the Roar Mark and denies any remaining allegations of paragraph 96.

97. In fact, the shirt Mr. Carter wore with the infringing mark is an inverse of a shirt Roberts previously sold. *Compare Exhibit 8 with Exhibit 2* at pg. 1 and 3.

**ANSWER:** PUMA denies that the shirt Mr. Carter wore infringes Roberts's mark. PUMA denies any remaining allegations of paragraph 97.

98. Upon information and belief, Mr. Carter is Creative Director at PUMA, and works closely with the Basketball Operations within Puma.

**ANSWER:** PUMA admits that Mr. Carter is Creative Director of PUMA Basketball.

PUMA affirmatively states that Mr. Carter did not create, direct, or contribute to the development of the teeth graphics accused of infringement. Consistent with the declarations submitted in connection with the preliminary injunction briefing, that design was originally created by a third-party creative agency, not Mr. Carter. PUMA denies any remaining allegations of paragraph 98.

99. Notably, on or about June 6, 2019, Upscale Hype, a high-end lifestyle online magazine, posted a social media post and article after photo of Mr. Carter went viral titled “Jay-Z and Beyonce wears a Paper Planes Hat, Christophe Roberts T-Shirt, and Puma Sneakers with Beyonce in Burberry Coat with By Far Bag”. See Exhibit 8.

**ANSWER:** PUMA is without sufficient knowledge or information to admit or deny the allegations of paragraph 99 and therefore denies the same.

100. Roberts received numerous messages and social media posts from friends and fans praising him and congratulating him on his supposed collaboration with PUMA and Mr. Carter.

**ANSWER:** PUMA is without sufficient knowledge or information to admit or deny the allegations of paragraph 100 and therefore denies the same.

101. To be clear, Roberts has never collaborated with PUMA, and never authorized PUMA to use his Roar Mark.

**ANSWER:** PUMA admits that it has never collaborated with Roberts. PUMA denies that it has used the Roar Mark, and denies all remaining allegations of paragraph 101.

F. Roberts’s Attempts to Protect his Creative Property and Defendant’s Continued Use

102. On or about August 19, 2019, Roberts sent a cease and desist letter to PUMA.

**ANSWER:** PUMA admits that it received correspondence from counsel for Roberts dated August 19, 2019. Puma denies the remaining allegations of paragraph 102.

103. Based on following discussions between the parties, Roberts understood that PUMA did not intend to use the Roar Mark on items for sale, that it had made limited sales of merchandise using the Roar Mark, and that it did not intend to continue use of the Roar Mark.

**ANSWER:** PUMA denies that it has used or intends to use the Roar Mark. PUMA admits that certain products identified in the Roberts letter from August 19, 2019 were not products that were available for sale, but instead were promotional items. PUMA denies the remaining allegations of paragraph 103.

104. Accordingly, Roberts did not pursue his infringement claims at that time.

**ANSWER:** PUMA is without sufficient knowledge or information to admit or deny the allegations of paragraph 104 and therefore denies the same.

105. However, around September and October 2020, PUMA rolled out a large advertisement campaign during the 2020 NBA Finals which featured Roberts's Roar Mark.

**ANSWER:** PUMA admits that it promoted its merchandise during the 2020 NBA Finals. PUMA denies that it has used Roberts's Roar Mark, and denies the remaining allegations of paragraph 105.

106. On or about February 19, 2020, PUMA posted on their public website an article titled "PUMA full-year and Q4 2019 results" in which the "Brand Strategy" section mentions a successful re-entry into the NBA basketball season and mentions that its "products were very visible on the court throughout the NBA Season, the All-Star Game, the Playoffs and NBA Finals." See Exhibit 9 at pg. 10.

**ANSWER:** PUMA admits that its website is public and that Ex. 9 to the Complaint is an article entitled *PUMA Posts Record Sales and EBIT as Strong Growth Momentum Continues Throughout 2019*. Puma asserts that the document speaks for itself and denies any remaining allegations of paragraph 106.

107. On or about November 23, 2020, Statista, a statistics portal specializing in market and consumer data, stating that PUMA "bounce[s] back" financially and specifically mentions PUMA entering back into the basketball arena and how PUMA likely hoped that will increase product sales. See M. Shahbandeh, *PUMA's net sales worldwide from 1993 to 2019*, Statista

(Nov. 23, 2020), <https://www.statista.com/statistics/268465/consolidated-sales-of-puma-worldwide-since-1993/>.

**ANSWER:** PUMA is without sufficient knowledge or information to admit or deny the allegations of paragraph 107 and therefore denies the same.

108. Statista reports that “German sportswear company PUMA generated around 5.2 billion euros from worldwide sales of its footwear, apparel, and accessories in 2020. Consolidated sales revenues have grown by more than 2.5 billion euros since 2014.”

**ANSWER:** PUMA admits that it is a German sportswear company with worldwide sales of footwear, apparel, and accessories and that its sales revenue has grown substantially since 2014. PUMA is without sufficient knowledge or information regarding Statista's reports or the basis for Statista's reports and therefore denies the allegations with respect to Statista.

109. PUMA continued to expand and profit off its use of Roberts’s Roar Mark on more and more of its merchandise.

**ANSWER:** PUMA denies that it has used or intends to use Roberts’s Roar Mark, and denies the remaining allegations of paragraph 109.

110. As PUMA expanded their use of Roberts’s Roar Mark, more friends, fans, and professionals messaged and continue to message Roberts because they believe he is collaborating with PUMA based on PUMA’s use of his Roar Mark.

**ANSWER:** PUMA admits that it has never collaborated with Roberts. PUMA denies that it has used or intends to use Roberts’s Roar Mark. PUMA is without sufficient knowledge or information to admit or deny the remaining allegations of paragraph 110, and therefore denies the same.

111. Upon information and belief, PUMA is still using the Mark on a variety of products in commerce including without limitation its “Pivot Special Men’s Crewneck Sweatshirt”, “Pivot Special Men’s Sweatpants”, “Pivot Special Men’s Shorts” “Black Fives Long Sleeve Tee”, “Black Fives Hoodie”, “Colorblocked Men’s Basketball Crewneck”, “PUMA Hoops Men’s Basketball Tee”, “PUMA Hoops Men’s Logo Tee”, “Triple Double Men’s Basketball Tank”, “PUMA Hoops Men’s AOP Long Sleeve Tee” and other merchandise. *See e.g., Exhibit 5. See generally, <https://us.puma.com/en/us/home>* (last visited Mar. 23, 2021).



**ANSWER:** PUMA denies that it has used or is currently using the Roar Mark, and denies that any of its products are infringing. PUMA denies the remaining allegations of paragraph 111.

112. PUMA's blatant infringement of Roberts' aesthetic and signature Roar Mark is irreparably harming Roberts.

**ANSWER:** PUMA denies that it has used the Roar Mark, and denies that any of its products are infringing. PUMA denies the remaining allegations of paragraph 112.

113. Roberts is an independent artist who cannot match PUMA's massive supply chain and distribution network.

**ANSWER:** PUMA is without sufficient knowledge or information to admit or deny the allegations of paragraph 113, and therefore denies the same.

114. Roberts sells merchandise in the high-end streetwear market, and uses limited release of merchandise product (known as "drops") to protect the value of his brand.

**ANSWER:** PUMA is without sufficient knowledge or information to admit or deny the allegations of paragraph 114, and therefore denies the same.

115. By flooding the market with its merchandise using an infringing mark, PUMA is threatening the value of Roberts' brand.

**ANSWER:** PUMA denies the allegations of paragraph 115.

116. Moreover, PUMA has stolen Roberts' ability to exercise creative control and direction over his work.

**ANSWER:** PUMA denies the allegations of paragraph 116.



**FIRST CLAIM FOR RELIEF**  
**Trademark Infringement and Unfair Competition**  
**Lanham Act § 43(a), 15 U.S.C. § 1125(a)**

117. Roberts incorporates by reference each and every allegation contained above as though fully set forth herein.

**ANSWER:** PUMA repeats and re-alleges its answers set forth in paragraphs 1–116 of the Complaint as if fully set forth herein.

118. Defendant's acts alleged herein are likely to cause confusion, mistake, or deception among consumers or potential consumers as to the source or origin of Defendant's products, and the sponsorship or endorsement of those products and services by Roberts or as to the affiliation, connection or association of Defendant or its products with Roberts or his products or activities.

**ANSWER:** PUMA denies the allegations of paragraph 118.

119. Moreover, Roberts's trademark is valid and entitled to protection.

**ANSWER:** PUMA denies the allegations of paragraph 119.

120. The actions of Defendant thereby constitute trademark infringement, false association, false and misleading representations and other acts of unfair competition in violation of Section 43(a) of the Lanham Act, 15 U.S.C. § 1125(a).

**ANSWER:** PUMA denies the allegations of paragraph 120.

121. Defendant's actions have damaged and continue to damage Roberts.

**ANSWER:** PUMA denies the allegations of paragraph 121.

**SECOND CLAIM FOR RELIEF**  
**Trademark Infringement and Unfair Competition**  
**Lanham Act § 32, 15 U.S.C. § 1114**

122. Roberts incorporates by reference each and every allegation contained above as though fully set forth herein.

**ANSWER:** PUMA repeats and re-alleges its answers set forth in paragraphs 1–121 of the Complaint as if fully set forth herein.

123. Roberts owns a valid and legally protectable trademark.

**ANSWER:** PUMA denies the allegations of paragraph 123.

124. Defendant's acts alleged herein use in commerce a reproduction, counterfeit, copy, and/or colorable imitation of Roberts's registered mark in connection with the sale, distribution, and/or advertising or any goods or services on or in connection with which such use is likely to cause confusion, mistake, or deception among consumers or potential consumers.

**ANSWER:** PUMA denies the allegations of paragraph 124.

125. The actions of Defendant thereby constitute trademark infringement, false association, false and misleading representations and other acts of unfair competition in violation of Section 32 of the Lanham Act, 15 U.S.C. § 1114.

**ANSWER:** PUMA denies the allegations of paragraph 125.

126. Defendant's actions have damaged and continue to damage Roberts.

**ANSWER:** PUMA denies the allegations of paragraph 126.

### **THIRD CLAIM FOR RELIEF**

#### **Unfair Competition and Trademark Infringement Under New York Common Law**

127. Roberts incorporates by reference each and every allegation contained above as through fully set forth herein.

**ANSWER:** PUMA repeats and re-alleges its answers set forth in paragraphs 1–126 of the Complaint as if fully set forth herein.

128. Roberts owns a valid and legally protectable trademark—the Roar Mark—which he uses and advertises to identify his goods and services.

**ANSWER:** PUMA denies the allegations of paragraph 128.

129. The Roar Mark identifies Roberts as the source of goods and services marketed under the mark and has come to represent the valuable goodwill owned by Roberts.

**ANSWER:** PUMA is without sufficient knowledge or information to admit or deny the allegations of paragraph 129, and therefore denies the same.

130. Roberts's art shows, website, social media, and other promotional and marketing efforts described herein also represent Roberts's trade dress.

**ANSWER:** PUMA is without sufficient knowledge or information to admit or deny the allegations of paragraph 130, and therefore denies the same.

131. Defendant's use of the Roar Mark and look and feel of some of the merchandise create a likelihood of confusion among consumers.

**ANSWER:** PUMA denies the allegations of paragraph 131.

132. Defendant's has also misappropriated the skill, expenditure, and labors of Roberts without Roberts's permission.

**ANSWER:** PUMA denies the allegations of paragraph 132.

133. This constitutes common law trademark infringement and unfair competition.

**ANSWER:** PUMA denies the allegations of paragraph 133.

134. Defendant's use of the Roar Mark was knowing, intentional, deliberate, and in bad faith.

**ANSWER:** PUMA denies the allegations of paragraph 134.

135. Roberts has been damaged by Defendant's actions.

**ANSWER:** PUMA denies the allegations of paragraph 135.

**FOURTH CLAIM FOR RELIEF**  
**New York Dilution Statute – N.Y. Gen. Bus. Law § 360**

136. Roberts incorporates by reference each and every allegation contained above as though fully set forth herein.

**ANSWER:** PUMA repeats and re-alleges its answers set forth in paragraphs 1–135 of the Complaint as if fully set forth herein.

137. Roberts's trademark—the Roar Mark—is distinctive and legally protected.

**ANSWER:** PUMA denies the allegations of paragraph 137.

138. Defendant began use of the Roar Mark after Roberts's creation and use of the Roar Mark.

**ANSWER:** PUMA denies the allegations of paragraph 138.

139. Defendant's use of its substantially similar mark, without authorization from Roberts, is likely to dilute the distinctive quality of Roberts's trademark and to decrease the capacity of the mark to identify and distinguish Roberts's products and services, and likely to cause harm to Roberts's business and its reputation.

**ANSWER:** PUMA denies the allegations of paragraph 139.

140. The acts alleged herein constitute trademark dilution in violation of New York Law, whereby Roberts has been damaged.

**ANSWER:** PUMA denies the allegations of paragraph 140.

**ANSWER TO PRAYER FOR RELIEF**

PUMA denies that Plaintiff is entitled to any relief in this matter. Accordingly, PUMA asks that each of Plaintiff's claims be dismissed with prejudice and that the Court decline to grant Plaintiff any relief requested in its Prayer for Relief.

**AFFIRMATIVE DEFENSES**

Without assuming any burden that it would not otherwise bear under applicable law and rules, and specifically reserving its right to assert additional affirmative defenses as additional information or materials become available through discovery or otherwise, PUMA hereby asserts the following affirmative defenses.

**FIRST AFFIRMATIVE DEFENSE  
(Non-Infringement)**

PUMA has not done anything likely to cause confusion, mistake, or confusion regarding sponsorship or affiliation with respect to Plaintiff or Plaintiff's products, as demonstrated by the differences between the Parties' respective marks and the use of other source identifying indicia of origin in connection with PUMA products.

**SECOND AFFIRMATIVE DEFENSE  
(Laches)**

Based on Plaintiff's allegations, Plaintiff had knowledge of PUMA's purported activity well before filing the Complaint. Plaintiff has unreasonably delayed in bringing its claims. This unreasonable delay has prejudiced PUMA and thus bars Plaintiff from recovery based on the doctrine of laches.

**THIRD AFFIRMATIVE DEFENSE  
(Equitable Estoppel/Acquiescence)**

Based on Plaintiff's allegations, Plaintiff had knowledge of PUMA's purported activity well before filing the Complaint. Plaintiff's own actions, including Plaintiff's failure to continue discussions with PUMA in 2019, reasonably lead PUMA to believe Plaintiff had knowledge of and acquiesced to the complained of activities. Plaintiff has unreasonably delayed in bringing its claims. This unreasonable delay combined with Plaintiff's actions have prejudiced PUMA and thus bars Plaintiff from recovery based on the doctrines of equitable estoppel/acquiescence.

**FOURTH AFFIRMATIVE DEFENSE  
(Ornamental Use)**

As the Roar Mark is used by the Plaintiff, most purchasers of his products would perceive the Roar Mark to be merely decoration, and would not think that it identifies the source of the apparel. Expressions and symbols that commonly adorn products in an ornamental fashion are normally not perceived as identifying the source of the goods and are therefore not trademark use, and accordingly do not imbue the user thereof with trademark rights.

**FIFTH AFFIRMATIVE DEFENSE  
(Descriptive Fair Use)**

PUMA uses a variety of different teeth images as part of its long-established association with feline imagery. Plaintiff has accused a wide variety of images of infringement, some of

which are not source identifying marks. Trademark rights are limited to the trademark used in commerce, and do not encompass the entire concept of teeth or provide a monopoly on zig-zag geometric shapes. Some of the designs Roberts has accused are nothing more than descriptive fair use communicating a generic concept of teeth and/or a zig-zag pattern.

**SIXTH AFFIRMATIVE DEFENSE  
(Unavailability of Injunctive Relief)**

Plaintiff is not entitled to injunctive relief (temporarily, preliminarily, or permanently), including because any injury to it is not immediate or irreparable, Plaintiff would have an adequate remedy at law, the balance of hardships favors no injunction, and the public interest is best served by no injunction.

**SEVENTH AFFIRMATIVE DEFENSE  
(Failure to State a Claim)**

Plaintiff has failed to state a claim upon which relief can be granted, in law or in equity.

### **PUMA’S COUNTERCLAIMS**

Defendant/Counterclaim-Plaintiff PUMA North America, Inc. (“PUMA” or “Counterclaimant”), by and through its attorneys of record, hereby states the following allegations and counterclaims against Plaintiff/Counterclaim-Defendant, Christophe Roberts (“Roberts” or “Counter-Defendant”).

### **PARTIES**

1. Counterclaimant PUMA North America, Inc. is a Delaware corporation, having a principal place of business at 10 Lyberty Way, Westford, Massachusetts 01886.

2. In his Complaint, Counter-Defendant Roberts alleges that he is a natural person and a citizen and resident of the State of New York, Kings County.

### **JURISDICTION AND VENUE**

3. This is an action for declaratory judgment arising under (i) the Trademark Laws of the United States, 15 U.S.C. § 1051, et seq. (the “Trademark Act”); (ii) 15 U.S.C. § 1125, et seq. (the “Lanham Act”); (iii) 15 U.S.C. § 1119; and (iv) 28 U.S.C. §§ 2201 and 2202 (the “Declaratory Judgment Act”).

4. This Court has jurisdiction over these counterclaims under 28 U.S.C. §§ 1331, 1332, 1338, 1367, 2201, and 2202; and 15 U.S.C. § 1121.

5. Roberts has consented to personal jurisdiction by filing his Complaint and advancing claims in this judicial district.

6. Venue for these counterclaims is appropriate pursuant to 28 U.S.C. § 1391.

7. By filing his Complaint, Roberts has sought to impose liability on PUMA for alleged trademark infringement, false designations of origin, unfair competition, and trademark dilution under federal law, New York statutory law, and New York common law. PUMA is not

liable for the alleged trademark infringement, false designations of origin, unfair competition, and trademark dilution. Consequently, an actual controversy exists between the parties with respect to PUMA's alleged liability for the claims in Roberts's Complaint.

### **COUNTERCLAIMS**

#### **I. First Counterclaim: Cancellation of Registration No. 5,912,449 for Non-Use and Abandonment**

8. PUMA hereby incorporates by reference the allegations in the preceding paragraphs 1–7 of its Counterclaims.

9. PUMA, by this Court, seeks cancellation of Roberts's U.S. Trademark Registration No. 5,912,449 on the grounds of abandonment and nonuse.

10. Roberts's website has not continuously carried apparel associated with the Roar Mark.

11. Upon information and belief, Roberts's website did not offer hoodies in 2018 or 2019.

12. Upon information and belief, Roberts's website did not offer jackets in 2018 or 2019.

13. Upon information and belief, Roberts's website did not offer T-shirts in 2018 or 2019.

14. When Roberts's website has offered apparel associated with the Roar Mark, it has not always offered T-shirts, hoodies, and jackets.

15. Upon information and believe, Roberts has not used the Roar Mark on T-shirts, hoodies, and jackets continuously since 2012.

16. At the time of filing this lawsuit, Roberts did not offer T-shirts, hoodies, or jackets bearing the Roar Mark.



17. Today, Roberts does not offer for sale hoodies or jackets bearing the Roar Mark.

18. Roberts abandoned the Roar Mark for apparel because he discontinued use of the mark with an intent not to resume selling, offering for sale, shipping, transporting, advertising, promoting, or otherwise using the mark in the U.S. in interstate commerce.

19. Roberts's U.S. Trademark Reg. No. 5,912,449 (the "Roar Mark") was improperly issued by the U.S. Patent and Trademark Office because it was not used in commerce on each of the goods specified in the application when the use was alleged. Thus, the mark is void *ab initio* for nonuse at the time of filing.

20. Puma is likely to be damaged by continued registration of Roberts's U.S. Trademark Reg. No. 5,912,449 (for the "Roar Mark"). Puma is involved in the sale of goods in Class 025, and has a valid legal right to use its own teeth designs (including Serial Nos. 79284842 and 79284812) on such goods.

21. Further, the Roar Mark has been subject to a substantial period of non-use and has not been continuously used in interstate commerce.

22. U.S. Trademark Reg. No. 5,912,449 should be canceled because the Roar Mark was not used in interstate commerce at the time of filing and/or has been subject to a substantial period of non-use.

## **II. Second Counterclaim: Fraud in Registration No. 5,912,449**

23. PUMA hereby incorporates by reference the allegations in the preceding paragraphs 1–22 of its Counterclaims.

24. On December 10, 2018, Roberts submitted the following statement with Application Serial Number 88223502:

The mark is in use in commerce on or in connection with the identified goods/services.

\*\*\*\*\*

In International Class 025, the mark was first used by applicant or applicant's related company or licensee predecessor in interest at least as early as 2012 and first used in commerce at least as early as 2014.

25. On information and believe, the applied-for mark, which issued as Registration No. 5,912,449, was not in use in commerce in connection with *all* Class 25 goods identified in the application on the date the declaration was signed.

26. Upon information and believe, Roberts knew of the falsity of the representation that the mark was in use in commerce in connection with all the goods identified in the Application.

27. Roberts made the false material statements, identified above, as to the use of the mark with the intent to procure a registration to which Roberts was not entitled.

28. Roberts's false material statements were made knowingly.

29. The Trademark Office relied on such knowingly false statements of material fact in approving Application Serial Number 88223502.

30. Based on the conduct described above, Roberts committed fraud on the Trademark Office.

31. U.S. Trademark Reg. No. 5,912,449 should be canceled.

**III. Third Counterclaim: Declaratory Judgment of No Infringement of a Registered Trademark Under 15 U.S.C. § 1114**

32. PUMA hereby incorporates by reference the allegations in the preceding paragraphs 1–31 of its Counterclaims.

33. An actual case and controversy now exists between PUMA and Roberts as to their respective rights and responsibilities with respect to the Roar Mark and U.S. Trademark Application Serial Nos. 79284842 and 79284812 (the “PUMA Teeth Designs”).

34. Roberts has asserted that PUMA’s Teeth Designs infringe the Roar Mark within the meaning of 15 U.S.C. § 1114.

35. PUMA’s Teeth Designs do not infringe Roberts’s Roar Mark within the meaning of 15 U.S.C. § 1114. PUMA’s Teeth Designs were developed independently by an outside advertising agency, and without knowledge of Roberts’s art or his Roar Mark. Products bearing PUMA’s Teeth Designs are unlikely to be confused with any of Roberts’s art or other products as the channels of trade, consumers, products, and even the marks themselves are not sufficiently related. This is particularly the case given the crowded field of third-party teeth design marks for relevant goods and services.

36. To resolve the legal and factual questions raised by Roberts and to afford relief from the uncertainty which has precipitated, PUMA is entitled to issuance of an order stating its rights pursuant to 28 U.S.C. §§ 2201–02 that PUMA and those distributors/retailers downstream are free to sell products with PUMA’s non-infringing Teeth Designs throughout the U.S., without fear of infringing Roberts’s Roar Mark.

**IV. Fourth Counterclaim: Declaratory Judgment of No Violation under 15 U.S.C. § 1125(a)**

37. PUMA hereby incorporates by reference the allegations in the preceding paragraphs 1–36 of its Counterclaims.

38. An actual case and controversy now exists between PUMA and Roberts as to their respective rights and responsibilities with respect to the Roar Mark and U.S. Trademark Application Serial Nos. 79284842 and 79284812 (the “Puma Teeth Designs”).

39. Roberts has asserted that PUMA's Teeth Designs result in a false designation of origin and/or unfair competition within the meaning of 15 U.S.C. § 1125(a) with respect to the Roar Mark.

40. PUMA's Teeth Designs do not result in a false designation of origin and/or unfair competition within the meaning of 15 U.S.C. § 1125(a) with respect to the Roar Mark. Consumers of Puma's Teeth Designs are unlikely to ascribe them as products of Roberts and the competition is fair because there is no likelihood of confusion with Roberts's Roar Mark.

41. To resolve the legal and factual questions raised by Roberts and to afford relief from the uncertainty which has precipitated, PUMA is entitled to issuance of an order stating its rights pursuant to 28 U.S.C. §§ 2201–02 that PUMA and those distributors/retailers downstream are free to sell products with PUMA's non-infringing Teeth Designs throughout the U.S., without fear of being adjudged as unfairly competing and/or engaged in false designation within the meaning of 15 U.S.C. § 1125(a).

**PRAYER FOR JUDGMENT AND RELIEF**

Wherefore, PUMA North America, Inc. respectfully requests entry of judgment in its favor and against Christophe Roberts as follows:

- A. Dismissing the Complaint in this action in its entirety with prejudice and entry of judgment in favor of PUMA North America, Inc.;
- B. Cancelling U.S. Trademark Reg. No. 5,912,449;
- C. Declaring that Defendant does not infringe and has not infringed, in any way, any trademark rights of Plaintiff;
- D. Declaring that Defendant does not and has not, in any way, engaged in false designation or unfair competition with Plaintiff;

- E. Declaring that Defendant does not and has not, in any way, violated the New York Dilution Statute – N.Y. Gen. Bus. Law § 360.
- F. An award of Defendant’s attorneys’ fees and costs incurred in connection with this action, including those incurred in defending against the allegations in the Complaint;
- G. Granting Defendant such other and further relief as this Court deems just and proper.

**DEMAND FOR JURY TRIAL**

PUMA demands a trial by jury on all issues triable by jury alleged or relating to this litigation pursuant to Rule 38 of the Federal Rules of Civil Procedure.

Dated: June 1, 2021

*/s/ Johanna M. Wilbert*

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*Attorneys for PUMA North America, Inc.*

**CERTIFICATE OF SERVICE**

I hereby certify that on June 1, 2021, I caused the aforementioned document to be electronically filed with the Clerk of Court using the ECF system, which will make this document available for viewing and downloading from the ECF system.

The ECF system will send notification of such filing to the following counsel of record:

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Dated: June 1, 2021

/s/ Johanna M. Wilbert  
Johanna M. Wilbert