

**IN THE UNITED STATES DISTRICT COURT
FOR THE EASTERN DISTRICT OF VIRGINIA
Alexandria Division**

TBL LICENSING, LLC,)
200 Domain Drive)
Stratham, NH 03885)

Plaintiff,)

Civil Action No. _____

v.)

DREW HIRSHFELD,)
in his official capacity as Acting Director of)
the United States Patent & Trademark)
Office; and)

THE UNITED STATES PATENT AND)
TRADEMARK OFFICE)

Serve:)
Office of the General Counsel)
United States Patent and Trademark Office)
Madison Bldg. East, Room 10B20)
600 Dulany Street)
Alexandria, VA 22314)

Attorney General of the United States)
Main Justice Building)
950 Pennsylvania Avenue, NW)
Washington, DC 20530)

United States Attorney for the)
Eastern District of Virginia)
2100 Jamieson Avenue,)
Alexandria, VA 22314)

Defendants.)

COMPLAINT

Plaintiff TBL Licensing, LLC (“TBL”) alleges as follows, upon actual knowledge with respect to itself and its own acts, and upon information and belief as to all other matters:

NATURE OF THE ACTION

1. This is an appeal from a decision of the Trademark Trial and Appeal Board of the United States Patent and Trademark Office (“TTAB”) under 15 U.S.C. § 1071(b)(1) and 37 CFR § 2.145. TBL seeks reversal of the TTAB decision *In re TBL Licensing LLC*, Proceeding No. 86634819 (TTAB, Apr. 2, 2021), affirming the Examining Attorney’s refusal to register TBL’s trade dress for its iconic Timberland Boot depicted in Application Serial No. 86/634,819 (the “Timberland Boot Trade Dress”) for purported lack of acquired distinctiveness.

2. The TTAB wrongly disregarded TBL’s potent evidence of secondary meaning, including extensive sales, advertising, and third-party recognition (with diverse examples of high-profile unsolicited media coverage and attention) that TBL amassed from over four decades of consistent and substantially exclusive use of the Timberland Boot Trade Dress. In so doing, the TTAB refused to register what has been deemed “one of the most recognizable shoes of all time.”¹ The TTAB’s decision should thus be reversed and, because the Timberland Boot Trade Dress is not *de jure* functional, TBL’s application should be approved for publication. Alternatively, the case should be remanded for consideration of the issue of functionality.

PARTIES AND JURISDICTION

3. TBL is a Delaware corporation with an address at 200 Domain Drive, Stratham, New Hampshire, 03885.

4. Drew Hirshfeld is the Acting Director of the United States Patent & Trademark Office with an address at P.O. Box 1450, Alexandria, Virginia 22313.

¹ Joanna Douglas, *‘90s-Style Timberland Boots Make a Comeback*, FALL FASHION WITH REFINERY 29 (Sep. 15, 2013), <https://www.yahoo.com/lifestyle/tagged/health/fall-fashion/90s-style-timberland-boots-comeback-204400695.html>.

5. The PTO is a federal agency within the United States Department of Commerce. The agency is located at 600 Dulany Street, Alexandria, Virginia 22314.

6. This Court has jurisdiction over the subject matter of this action pursuant to Section 21(b) of the Trademark Act of 1946 (the “Lanham Act”), as amended, 15 U.S.C. § 1071(b), which provides that a party may challenge a final decision of the TTAB by instituting a new civil action in a Federal District Court. This Court also has subject matter jurisdiction pursuant to 37 C.F.R. § 2.145(d)(1) and 28 U.S.C. § 1331.

7. Venue is proper in this district pursuant to 28 U.S.C. § 1391(e)(1)(A).

TBL AND ITS ICONIC TIMBERLAND BOOT

8. Since 1952, TBL (then known as the “Abington Shoe Company”) has been a leading designer and manufacturer of shoes for men, women, and children. TBL is best known for its Timberland Boot, pictured below.



9. Since its debut in 1973, the Timberland Boot has become one of the most iconic examples of American footwear, garnering worldwide fame for what has been deemed its “rugged industrial chic” design and styling. The Timberland Boot was an instant success, so much so that in 1978, *within 5 years* of its introduction, the Abington Shoe Company renamed

itself “Timberland” after its marquee product. Over 40 years later, the Timberland Boot still defines the company’s brand.

10. The Timberland Boot debuted in three colors: black, brown and “yellow” (pictured above). That palette has grown considerably and, over the past four decades, TBL has sold millions of pairs of the Timberland Boots in a wide spectrum of colors, including those shown below.





11. In 1988, TBL modified the outsole of the Timberland Boot to make it two-toned. Beyond this change, the boot's appearance has remained constant since 1973 and, with this change, constant since 1988—a fact that TBL has proudly promoted (see below). In maintaining this same fashion aesthetic, TBL has eschewed technological advancements that would improve the boot's operation and make it easier and cheaper to produce.



12. Consistent with its commitment to environmental causes (among others), TBL makes the Timberland Boot with responsibly sourced leather and recycled materials—proudly promoting the boot as a sustainable and eco-friendly fashion choice. As a result of these and other “Eco-Innovations,” TBL has garnered widespread recognition as a “leader in sustainability within the footwear industry.”²

13. From around 2000-2015, TBL sold tens of millions of pairs of Timberland Boots to consumers from all walks of life—resulting in over \$1.3 billion in revenue from U.S. sales alone—through a wide variety of retail means, including online, catalogs, and thousands of national, regional, independent, and specialty retailers across the country. Since 2017 alone, TBL sold hundreds of millions of dollars’ worth of Timberland Boots in the U.S.

² Peter Verry, *Timberland Reveals Sustainability Goals for 2030 That Will Have a ‘Net Positive Impact on Nature,’* FOOTWEAR NEWS (Sep. 1, 2020), <https://footwearnews.com/2020/business/sustainability/timberland-sustainability-goals-2030-1203048956/>.

14. TBL has spent millions of dollars on global campaigns to advertise and promote the Timberland Boot to the general public through virtually every available type of media, including print publications, television, mailings, and the Internet (*e.g.*, via its own website, its retailers' websites, banner ads, and social media). In fact, it has been reported that Timberland was the first boot manufacturer in American history to run advertisements on television.³

15. In addition to TBL's own substantial advertising and promotional activities, Timberland Boots have received and continue to receive widespread unsolicited media coverage and attention. Among many other things, the boots are routinely sported in myriad colors by dozens of celebrities, including Rihanna, Jennifer Lopez, Gwen Stefani, Jake Gyllenhaal, Julianne Moore, Ellie Goulding, Dakota Johnson, David Beckham, Cara Delevigne, Victoria's Secret model Josephine Skriver, Kanye West and daughter North West, Khloe Kardashian, Pharrell Williams, Drake, Mark Wahlberg, and Kris Jenner, *e.g.*:

³ *The Timberland Company*, ENCYCLOPEDIA.COM (May 29, 2018), <https://www.encyclopedia.com/social-sciences-and-law/economics-business-and-labor/businesses-and-occupations/timberland-company>; Karizza Sanchez, *10 Things You Didn't Know About Timberland Boots*, COMPLEX (Jan. 19, 2013), <https://www.complex.com/style/2013/01/10-things-you-didnt-know-about-timberland-boots/>



Rihanna



Pharrell Williams



Gwen Stefani



North West



Josephine Skriver



Julianne Moore

16. By the 1980s, the Timberland Boot had become a fashion status symbol, both in the U.S. and around the world.⁴ The Timberland Boot had become so widely-recognized for its unmistakable design that by the late 1980s, consumers were being robbed for their boots in Italy, and American flight attendants had begun purchasing the boots in bulk to resell overseas for double the price.⁵ By the early 1990s, the Timberland Boot was reportedly more sought after than Nike's Air Jordan basketball sneakers in the U.S.⁶

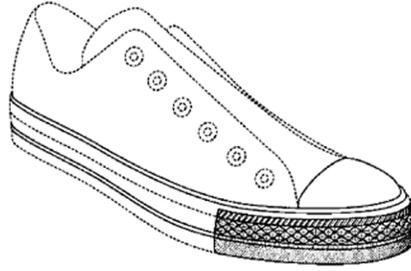
17. With success comes imitators. Copycats have tried to find a shortcut to kickstart their business by trading off of the hard-earned goodwill associated with the Timberland Boot's design. In one notable example, Levi Strauss & Co. developed a near identical knockoff boot that TBL was able to stop. In response to TBL's objection, Levi Strauss redesigned its boot to eliminate its two-toned sole, hour-glass shaped rear heel design, padded collar without bisecting stitching, hexagonal eyelets for laces, and four rows of stitching—each an element of the Timberland Boot Trade Dress.

18. As a result of substantial sales, advertising, and third-party recognition, the Timberland Boot has become a cultural icon that has maintained a foothold in various fashion trends across several decades, fondly referred to by loyalists as "Timbs." Like the registered Converse sneaker (shown below), the Timberland Boot is immediately recognizable for its unique classic design—in every color and without its logo.

⁴ Butterfield, *supra* note 2.

⁵ Fox Butterfield, *Shoes That Sell - Made in America*, THE NEW YORK TIMES (Aug. 18, 1985), <https://www.nytimes.com/1985/08/18/business/shoes-that-sell-made-in-america.html>; *see also* Alysha Webb, *How Hip Hop's Love of the Iconic Yellow Workboot Helped Make Timberland a Billion-Dollar Company*, CNBC MAKE IT (Dec. 20, 2020), <https://www.cnbc.com/2020/12/20/how-timberland-became-billion-dollar-company.html>.

⁶ Michel Marriott, *Out of the Woods*, THE NEW YORK TIMES (Nov. 7, 1993), <https://www.nytimes.com/1993/11/07/style/out-of-the-woods.html?smid=em-share>



Reg. No. 4,398,753

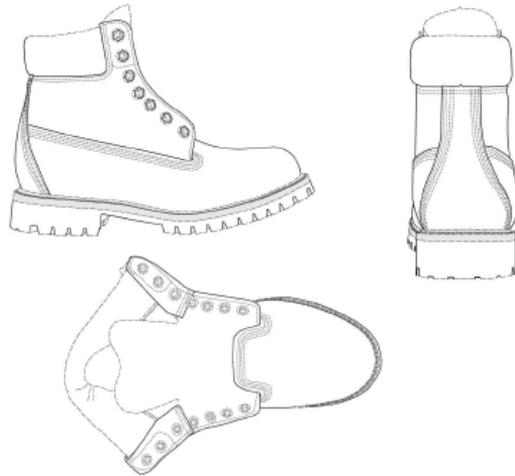
As explained by one independent source, “Timberland boots are one of the most recognizable shoes of all time”⁷ and, in the words of a popular global publication, they are “one of fashion’s most recognisable pieces of footwear, favoured across the board, from hipsters to workmen, rappers and pop royalty.”⁸

**TBL’S TRADEMARK APPLICATION
FOR THE TIMBERLAND BOOT TRADE DRESS**

19. On May 19, 2015, TBL filed a federal trademark application to register the Timberland Boot Trade Dress for “footwear, namely lace-up boots” in International Class 25 (U.S. Serial No. 86/634,819, or the “Application”). The Application depicts the stylistic characteristics that comprise the iconic design of the Timberland Boot, as shown below:

⁷ Douglas, *supra* note 1.

⁸ David Hellqvist, *Timberland: 40 Years of the Yellow Boot*, THE GUARDIAN (Apr. 16, 2013), <https://www.theguardian.com/fashion/2013/apr/16/timberland-40-years-yellow-boot#:~:text=This%2C%20however%2C%20is%20the%20drill,workmen%2C%20rappers%20and%20pop%20royalty.>



20. As described in the Application, the Timberland Boot Trade Dress claims the following features:

“a three-dimensional configuration of a lace-up boot having an overall shape and silhouette as depicted in the drawings, with a visibly bulbous toe box and the following individual features: (1) the external appearance of a tube-shaped ankle collar on the outside surface of the product running from one eyelet panel to the other eyelet panel around the sides and rear of the boot and protruding over the upper side and rear panels of the boot (material on the inside of the ankle collar not being claimed); (2) outsoles having two color tones divided horizontally and extending around the circumference of the boot, and visibly showing inverted tooth shaped cuts on each side of the heel of the outsole and around the sides and front of the forward portion of the outsole; (3) an hourglass-shaped rear heel panel, defined by four vertical stitching lines from the top of the outsole to the rear collar; (4) quad-stitching forming an inverted "U" shape around the vamp line in front of the boot at the bottom of the tongue and curving around to the left and right sides and ending at the cinched portion of the hourglass stitching of the rear heel panel; and (5) eyelets shaped hexagonally on the exterior-facing outside surface. The double row stitching around the rear and side ankle collar, the single stitching around the upper two eyelets on each side, the single stitching along the upper perimeter of the shaft in front of the eyelets and the boot tongue, the appearance of the eyelets on the boot interior, the top of the ankle collar, the bottom, outer most surface of the outsole, and the uppermost surface of the outsole connecting to the boot around the perimeter, all of which are depicted in broken or dotted lines, are not being claimed as part of the mark and serve only to show the position or placement of the mark.”

21. In an October 6, 2015 Office Action, the PTO refused registration on two substantive grounds. First, the Examining Attorney concluded that the Timberland Boot Trade Dress “is a product configuration comprising non-distinctive features under Trademark Act

Sections 1, 2, and 45, 15 U.S.C. §§ 1051-52, 1127.” Second, the Examining Attorney alleged that the Timberland Boot Trade Dress was “functional” and incapable of registration under Section 2(e)(5) of the Lanham Act and 15 U.S.C. § 1052(e)(5). Based on this second objection, the Examiner ultimately required TBL to amend the Application’s drawing and description to contain “only capable elements.”

22. In response to the October 6, 2015 Office Action, TBL submitted evidence of acquired distinctiveness pursuant to Section 2(f), 15 U.S.C. § 1052(f), including consumer declarations, advertisements, sales volume records, and diverse examples of unsolicited media attention. TBL also submitted arguments and evidence to rebut the Examining Attorney’s functionality refusal, showing how the Examiner’s legal analysis was incorrect and that the boot’s features (alone and in combination) are not *de jure* functional, such as the bulbous toe box, hexagonally shaped eyelets, exteriorly padded ankle collar, two-toned outsole, and stitching patterns. The Examining Attorney nevertheless maintained both refusals.

23. Following a series of responses and further Office Actions, the Examining Attorney issued final refusals on the same grounds.

24. On December 4, 2018, TBL filed a Notice of Appeal with the TTAB.

THE TTAB’S DECISION

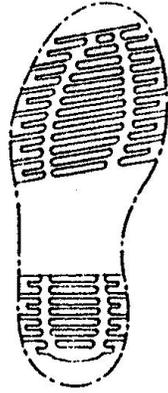
25. On April 2, 2021, following briefing and oral argument, the TTAB affirmed the refusal to register TBL’s Timberland Boot Trade Dress on the ground that TBL failed to demonstrate that the trade dress had acquired secondary meaning. The TTAB did not reach the functionality refusal or the Examiner’s related request that TBL amend its application.

26. The TTAB’s finding on secondary meaning erroneously flies in the face of substantial evidence of sales, advertising, and third-party recognition, including via unsolicited

media coverage and attention. Based on at least that evidence, the iconic Timberland Boot Trade Dress is just as deserving of federal registration as the following footwear designs and components that have been deemed non-functional and distinctive:



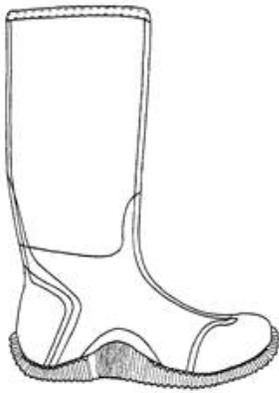
Reg. No. 5,820,374
(side sole pattern)



Reg. No. 2,102,468
(undersole)



Reg. No. 2,437,750
(welt stitching)



Reg. No. 2,801,550
(boot)



Reg. No. 5,263,157
(flip flop strap)



Reg. No. 2,781,792
(sneaker)



Reg. No. 2,416,738
(outsole)

CLAIM FOR RELIEF

Request for Judicial Review and Reversal of the TTAB Decision Under Section 21 of the Lanham Act, 15 U.S.C. § 1071(b)(1)

27. The Timberland Boot Trade Dress has acquired distinctiveness under Section 2(f) of the Lanham Act, 15 U.S.C. § 1052(f), and the Director should thus be directed to pass the Application to publication.

28. The Timberland Boot Trade Dress is non-functional pursuant to Section 2(e) of the Lanham Act, 15 U.S.C. § 1052(e)(5), and the Director should thus be directed to pass the Application to publication without requiring any amendment to the drawing or description. Alternatively, this matter should be remanded to the TTAB for consideration of the functionality issue.

PRAYER FOR RELIEF

WHEREFORE, TBL respectfully requests that this Court enter judgment in its favor on each and every claim for relief set forth above and award it relief, including the following:

- A. An Order reversing and vacating the decision in *In re TBL Licensing LLC, Proceeding No. 86634819* (TTAB, Apr. 2, 2021) allowing TBL's Application to register; and
- B. Awarding TBL such other relief as this Court may deem just and proper.

Dated: June 4, 2021

Respectfully submitted,

/s/ Anna B. Naydonov

Anna B. Naydonov (VA Bar No. 80101)

Douglas A. Rettew (*pro hac vice*
application forthcoming)

Spencer K. Beall (*pro hac vice*
application forthcoming)

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