

JUDGE SWAIN

UNITED STATES DISTRICT COURT
SOUTHERN DISTRICT OF NEW YORK

LUXO AS,

Plaintiff,

-against-

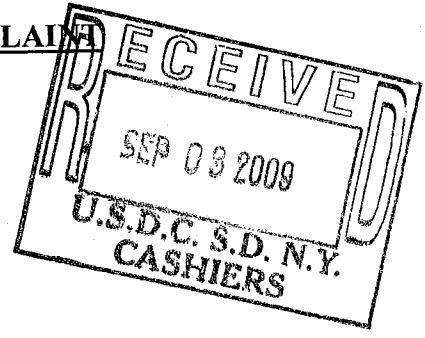
THE WALT DISNEY COMPANY, PIXAR
ANIMATION STUDIOS, JOHN DOES, JANE
DOES and XYZ COMPANIES

Defendants.

09 CIV 7689

Case No.

COMPLAINT



Jurisdiction and Venue

1. This is a complaint for trademark infringement, trademark counterfeiting and trademark dilution under the Lanham Trademark Act of 1946, 15 U.S.C. § 1114, et seq., as amended, (hereinafter the “Lanham Act”), and to which is appended claims for trademark dilution and unfair competition under the laws of the State of New York.

2. This Court has original jurisdiction over this action under 28 U.S.C. §§ 1331 and 1338(a), 15 U.S.C. §§ 1114, 1116, 1121, 1125, 1126 and the principles of pendent jurisdiction. The matter in controversy exceeds, exclusive of interest and costs, the sum of seventy five thousand dollars (\$75,000.00).

3. Venue is proper in this Court pursuant to 28 U.S.C. §§ 1391(a) and (b).

The Parties

4. Plaintiff, Luxo AS, is a corporation organized and existing under the laws of Norway having its principal place of business at Drammensveien 175, N-0277 Oslo, Norway and successor of, by change of name of Luxo ASA (hereinafter “Plaintiff” or “Luxo”).

5. (a) Upon information and belief, Defendant, The Walt Disney Company, is a Delaware corporation having a principal place of business at 500 Buena Vista Boulevard, Burbank, CA 91521 and does and/or transacts business in this District (hereinafter "Disney").

(b) Upon information and belief, Defendant, Pixar Animation Studios, is an entity, the exact nature of which is unknown, but believed to be a wholly-owned subsidiary of Defendant Disney, having a principal place of business at 1200 Park Avenue, Emeryville, CA 94608 and does and/or transacts business in this District (hereinafter "Pixar").

(c) Upon information and belief, Defendants VARIOUS JOHN DOES and JANE DOES are residents of or transact and/or do business in this District, and are actively and regularly engaged in the manufacture and/or sale of the products complained of herein. The identities of Defendants VARIOUS JOHN DOES and JANE DOES are presently not known to Plaintiff and Plaintiff will amend this Complaint to include the name or names of said individuals if and when they permit themselves to be identified (hereinafter "John Does and Jane Does").

(d) Upon information and belief, Defendants XYZ COMPANIES, through their agents, servants and employees, do business in, or transact business in, and have been present in this District and are here actively and regularly engaged in the manufacture and/or sale of the products complained of herein. The true identities of Defendants XYZ COMPANIES are not presently known to Plaintiff and Plaintiff will amend this Complaint to include the name or names of the same if and when they permit themselves to be identified (hereinafter "XYZ Companies").

Defendants Disney, Pixar, John Does, Jane Does and XYZ Companies are hereinafter sometimes referred jointly as "Disney/Pixar" or "Defendants."

Facts Applicable to All Causes of Action

6. Plaintiff Luxo is a manufacturer and distributor of high-quality lighting products, including desk lamp products, under its trade name and trademark "LUXO."

7. Luxo has enjoyed extraordinary success designing, developing and manufacturing its lighting products including desk lamps, and has sold the same in the U.S. since 1939. Luxo has spent millions of dollars in developing and designing its distinctive, high-quality lighting products which are manufactured under Luxo's strict quality controls.

8. Since its inception, Luxo has sold millions of its LUXO® lighting products worldwide, and over 25 million of its LUXO L-1, and its later version, the LUXO LS desk lamp in particular, which lamps have been awarded numerous design awards and is in the permanent collection of *The Museum of Modern Art*.

9. Plaintiff's LUXO LS lamps are distinctively designed and consists of a structure which has a dome shaped head, a base, and a body consisting of two perpendicular posts, which are joined at the center, and sold most popularly in the color gray. (The overall product design of the LUXO LS lamp is referred to herein as the "Luxo Trade Dress.") A photograph of the Plaintiff's LUXO LS lamp is attached hereto as **Exhibit A**.

10. Luxo is the owner of the entire right, title and interest in and to the trade name LUXO, common law trademark LUXO and is the owner of valid and incontestable trademark registrations for the same in the United States Patent and Trademark Office, namely Registration Nos. 778106 and 1314484 (hereinafter sometimes combined as "Luxo Mark"). Photocopies of Plaintiff's trademark registrations are attached hereto as **Exhibit B**.

11. Plaintiff's Luxo Mark, the Luxo Trade Dress and the goodwill of the business associated therewith in the United States and indeed worldwide are of great and incalculable

value, and have become associated in the public mind with the products of very highest quality and reputation finding their source in Plaintiff.

12. Notwithstanding the prior use and fame of Plaintiff's LUXO trademark and products, Plaintiff has learned Defendants' are now advertising for sale and/or selling and distributing in the U.S. and elsewhere a lamp product namely the "Limited Edition Luxo Jr. Lamp Collectible Pack" which comprises a DVD of a Disney/Pixar film and includes a small actual lamp bearing "Luxo Jr." on its base, which lamp itself simulates the Luxo Trade Dress (hereinafter "Defendants' Lamp Product"). A copy of a page from Amazon.com showing availability of Defendants' Lamp Product is annexed as **Exhibit C**.

13. By way of background, and upon information and belief, in 1986 Defendant Pixar produced a two-minute silent short film wherein in the story line, two animated lamps come to (fictional) life and play with a ball. In fact, Defendant Pixar's founder, John Lasseter, has long touted that he was inspired to create his animation by the [Luxo] lamp on his desk and hence, the animated lamp became part of Pixar's logo. See, Exhibit D.

14. However, Defendant Pixar's logo made no express reference to the name "Luxo," and heretofore, other than Plaintiff's lamps, there existed no actual lamps which used the LUXO trademark.

15. Now, in addition to the Defendants' Lamp Products bearing Plaintiff's LUXO Mark, Defendants have debuted on August 23, 2009 a new animatronic attraction at its Walt Disney World Amusement Park, calling such attraction "Luxo Jr." This attraction consists of a 6-foot animatronic version of a LUXO lamp and is listed among Defendants' other attractions, along with such Disney classics as *Muppet Vision*, *It's A Small World* and *Pirates of the Caribbean* (hereinafter "Luxo Jr. Attraction"). See, Exhibit E.

16. Defendant Pixar, and upon information and belief, Defendant Disney, were aware of Plaintiff's LUXO products, the Luxo Mark and Luxo Trade Dress when it chose to use the name "Luxo Jr." and to market and sell its real-life "Luxo Jr." lamp products and create the Luxo Jr. Attraction, all with no compensation to Plaintiff and without its consent.

17. Defendants' increasing commercial exploitation of Plaintiff's Mark LUXO, indeed its near complete expropriation of it, will have the effect of causing consumers to believe that Plaintiff is the infringer – or that it is the licensee of Defendants.

18. Alternatively, the expropriation of the "Luxo" (or "Luxo Jr.") mark by Defendants especially in combination with use of trade dress which is so visually similar to Luxo's Trade Dress of its genuine products renders the sale and marketing of Defendants' Lamp Product likely to cause confusion and deceive the public into purchasing the Defendants' Lamp Product believing it is the product of or associated with Luxo.

19. Upon information and belief, the Defendants' Lamp Products which are manufactured by an unknown entity are inferior in quality to products sold by Luxo under Luxo's authority and therefore the sale thereof will cause devastating damage to Luxo and dilute the goodwill which Luxo has built-up in connection with the sale of its legitimate, high-quality lamp products.

20. The unlawful activities of Defendants result in immediate and irreparable harm and injury to Luxo. Among other harms, these activities: deprive Luxo of its absolute right to determine the manner in which its image is presented to the general public; deceive the public as to the origin and sponsorship of Defendants' Lamp Products; and wrongfully trades upon Luxo's reputation and exclusive rights in its Luxo Mark and the Luxo Trade Dress.

Count I

Federal Trademark Counterfeiting

21. Plaintiff repeats and realleges the allegations set forth in paragraphs 1 through 20 of this complaint as if fully set forth herein.

22. Upon information and belief, notwithstanding knowledge of Plaintiff's well-known and prior rights in the Luxo Mark, Defendants have manufactured, advertised, offered for sale and/or sold lamps bearing the spurious copy of Plaintiff's Mark, in or affecting interstate commerce.

23. Defendants' use of copies or simulations of Plaintiff's Mark is likely to cause and/or is causing confusion, mistake and deception among the public as to the origin of Defendants' Lamp Products.

24. Defendants' aforesaid actions constitute trademark counterfeiting in violation of Section 32 of the Lanham Act, 15 U.S.C. §1114.

25. Plaintiff has no adequate remedy at law.

Count II

Federal Trademark Infringement

26. Plaintiff repeats and realleges the allegations set forth in paragraphs 1 through 25 of this complaint as if fully set forth herein.

27. Defendants' use of one or more of Plaintiff's registered LUXO Marks is likely to cause and/or is causing confusion, mistake and deception among the general purchasing public as to the origin of Defendants' Lamp Product and its Luxo Jr. Attraction, and is likely to deceive the public into believing that such originate from or are associated with or is otherwise

authorized by Plaintiff, or conversely that Plaintiff's genuine products are the products of Defendants.

28. Upon information and belief, Defendants' activities described herein are with knowledge of Plaintiff and of its prior rights in an to its trademarks.

29. Defendants' aforesaid actions constitute trademark infringement in violation of Section 32 of the Lanham Act, 15 U.S.C. §1114.

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

Count III

Federal Trademark Infringement Under 43(a)

31. Plaintiff repeats and realleges the allegations set forth in paragraphs 1 through 30 of this Complaint as if fully set forth herein.

32. By adopting the name "Luxo" especially with regard to products and services which bear simulations of Plaintiff's Trade Dress, Defendants misrepresent and falsely describe to the public the origin and source of Defendants' Lamp Products and the Luxo Jr. Attraction create a likelihood of confusion as to both the source and sponsorship.

33. Defendants' acts violate § 43(a) of the Lanham Act, 15 U.S.C. § 1125(a) and cause and will continue to cause Luxo irreparable injury unless restrained by this Court. Luxo has no adequate remedy at law.

Count IV

Trademark Dilution

34. Plaintiff repeats and realleges the allegations set forth in paragraphs 1 through 33 of this Complaint as if fully set forth herein.

35. Plaintiff's Mark LUXO is famous and distinctive and has enjoyed such fame and distinction long before the time Defendants' commenced its use of "Luxo".

36. The actions of Defendants cause injury to the business reputation of Plaintiffs and of the dilution of the distinctive quality of Plaintiff's Mark in violation of Section 43(c) of the Lanham Act, 15 U.S.C. § 1125 (c).

37. Plaintiff has no adequate remedy at law. The conduct of Defendants described above has caused and, if not enjoined, will continue to cause, irreparable harm to the rights of Plaintiff in Plaintiff's Mark and the business, reputation and goodwill of Plaintiff.

Count V

Unfair Competition Under New York Law

38. Plaintiff repeats and realleges the allegations set forth in paragraphs 1 through 37 of this Complaint as if fully set forth herein.

39. Defendants' use of the name "Luxo" and the Luxo Trade Dress is likely to and does permit Defendants to palm off its goods and services as those of Luxo, all to the detriment of Luxo and the unjust enrichment of Defendants.

40. Defendants' acts permit and accomplish confusion, mislead and deceive the public as to the source of Defendants' goods and services, permit and accomplish palming off of Defendants' goods as Luxo's, and falsely suggest a connection with Luxo, thus constituting unfair competition with Luxo in violation of New York law. These acts have caused and will

continue to cause Luxo irreparable harm unless enjoined by this Court. Luxo has no adequate remedy at law.

Count VI

Dilution Under New York Law

41. Plaintiff repeats and realleges the allegations set forth in paragraphs 1 through 40 of this Complaint as if fully set forth herein.

42. Defendants' use of "Luxo" (or "Luxo Jr.") dilutes and tarnishes the distinctive quality of Plaintiff's Mark LUXO.

43. Defendants' unlawful conduct is in violation of the New York State Anti-Dilution Statute, Section 360-1 of the New York General Business Law and will damage Plaintiff unless enjoined by this Court. Plaintiff has no adequate remedy at law.

WHEREFORE, Plaintiff respectfully prays that this Court grant the following relief as to each of the above causes of action:

a. Order that all Defendants' Lamp Products and any other product or service bearing signs, wrappings, catalogs, decals or other goods or service printed matter bearing Plaintiff's Mark LUXO or colorable imitations of same and all machinery, plates, molds, matrices or other material for producing, printing or distributing such items in the possession or control of Defendants be delivered up for destruction or other disposition at Plaintiff's sole discretion, and Defendants be ordered to notify its customers that the products sold by Defendants are in no way connected with Plaintiff; and

b. Issue a preliminary injunction and thereafter permanent injunction prohibiting Defendants from manufacturing, exporting, importing, distributing, offering for sale or selling Defendants' Lamp Products and any other product or service using Plaintiff's Mark LUXO or

colorable imitations of same and ordering that such products in Defendants' possession or control be delivered up to Plaintiff for destruction or other disposition at Plaintiff's sole discretion;

c. Grant Plaintiff an equitable accounting of Defendants' profits and award Plaintiff judgment for its damages or Defendants' profits, whichever are greater, arising from Defendants' trademark counterfeiting, trademark infringement, false designation of origin, unfair competition and trademark dilution, such damages to be trebled pursuant to 15 U.S.C. §1117 by reason of the willfulness of Defendants' acts; and

d. That the Court award Plaintiff their reasonable attorneys' fees pursuant to 15 U.S.C. § 1117(a); and

e. That the Court award Plaintiff its costs of suit incurred herein; and

f. For such other and further relief as this Court deems just and proper.

Dated: New York, New York
September 3, 2009

Respectfully submitted,
COWAN, LIEBOWITZ & LATMAN, P.C.

By: 

Arlana S. Cohen
William M. Borchard
1133 Avenue of the Americas
New York, New York 10036
212-790-9200
Attorneys for Plaintiff

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Word Mark LUXO
Goods and Services IC 011. US 021. G & S: Electric Lighting Fixtures and Electric Lamps Mounted on Fixed Brackets, Movable Bases and Stands, Including Electric Lamps Supported Spring-Arm Assemblies and Components Thereof. FIRST USE: 19720829. FIRST USE IN COMMERCE: 19720906
Mark Drawing Code (3) DESIGN PLUS WORDS, LETTERS, AND/OR NUMBERS
Design Search Code 26.03.17 - Concentric ovals; Concentric ovals and ovals within ovals; Ovals within ovals; Ovals, concentric
 26.03.21 - Ovals that are completely or partially shaded
Serial Number 73449167
Filing Date October 21, 1983
Current Filing Basis 1A
Original Filing Basis 1A
Published for Opposition November 6, 1984
Registration Number 1314484
Registration Date January 15, 1985
Owner (REGISTRANT) Jac Jacobsen A/S CORPORATION NORWAY Enebakkveien 117 Oslo 6 NORWAY

(LAST LISTED OWNER) LUXO ASA CORPORATION NORWAY ENEBAKKVEIEN 117 OSLO NORWAY 00612

Assignment Recorded ASSIGNMENT RECORDED
Attorney of Record Pasquale A. Razzano
Prior Registrations 0778106;0778107
Type of Mark TRADEMARK
Register PRINCIPAL
Affidavit Text SECT 15. SECT 8 (6-YR). SECTION 8(10-YR) 20050216.
Renewal 1ST RENEWAL 20050216
Live/Dead Indicator LIVE

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Typed Drawing

Word Mark LUXO

Goods and Services IC 009. US 021. G & S: PORTABLE ELECTRIC LAMPS OF THE TYPE WHEREIN A LIGHT-EMITTING UNIT AND A SHADE THEREON ARE MOVABLY SUPPORTED BY AN ADJUSTABLE STAND FROM A FIXED OR MOVABLE BRACKET OR FROM A WEIGHTED BASE RESTING UPON A SURFACE. FIRST USE: 19380000. FIRST USE IN COMMERCE: 19390000

Mark Drawing Code (1) TYPED DRAWING

Serial Number 72185141

Filing Date January 22, 1964

Current Filing Basis 1A

Original Filing Basis 1A

Registration Number 0778106

Registration Date October 6, 1964

Owner (REGISTRANT) JAC. JACOBSEN A/S CORPORATION NORWAY ENEBAKKVEIEN 117 OSLO NORWAY

(LAST LISTED OWNER) LUXO ASA CORPORATION NORWAY ENEBAKKVEIEN 117 0612 OSLO NORWAY

Assignment Recorded ASSIGNMENT RECORDED

Attorney of Record PASQUALE A. RAZZANO

Prior Registrations 0605706

Type of Mark TRADEMARK

Register PRINCIPAL
Affidavit Text SECT 15. SECTION 8(10-YR) 20041116.
Renewal 2ND RENEWAL 20041116
Live/Dead Indicator LIVE

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Up - Limited Edition Luxo Jr. Collectible Lamp Pack [Blu-ray]

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File Edit View Amazon.com: Up - Limited Edition Luxo Jr. Collectible Lamp Pack (Blu-ray): Edward Asner, Jordan

http://www.amazon.com/gp/product/images/B002LE6XR2/sr=8-3/qid=1252000607/ref=dp_image_z_0?ie=UTF8&n=130&s=dvd&qid=12

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Pixar - Luxo Jr. - Behind the Scenes - Microsoft Internet Explorer provided by Cowan, Liebowitz & Latman

http://www.pixar.com/shorts/ljr/behind.html

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PIXAR

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+ BEHIND THE SCENES +



When John Lasseter was learning how to make models, he chose the nearest, easiest subject: an architect's lamp sitting on his desk. He started moving it around in the animation system like it was alive and it eventually became another short film by Pixar that was nominated for an Academy Award®.

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 - Lights Motors Action
 - Luxo Jr Animatronic
 - Muppet Vision 3D
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