

**UNITED STATES DISTRICT COURT  
DISTRICT OF MASSACHUSETTS**

NEW BALANCE ATHLETICS, INC.,

Plaintiff,

v.

BALANCE ATHLETICA, LLC,

Defendant.

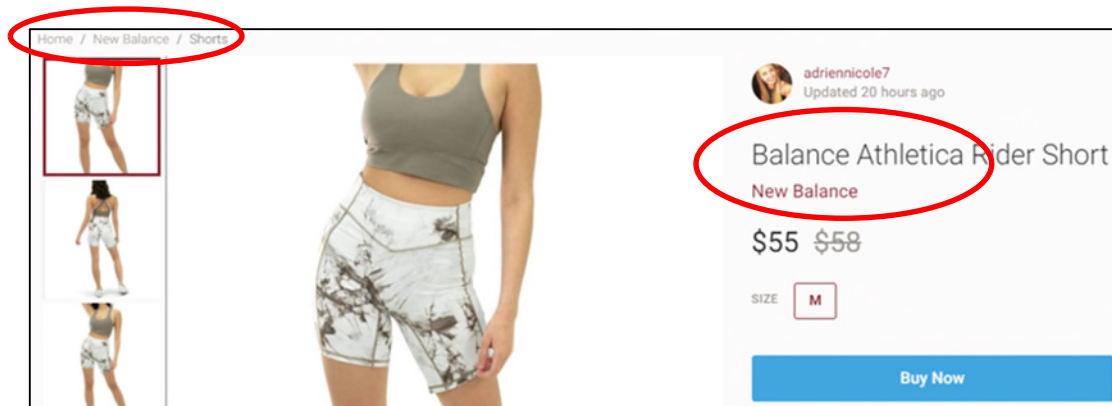
C.A. No. \_\_\_\_\_

**JURY TRIAL DEMANDED**

**COMPLAINT**

1. This is a trademark infringement case. Plaintiff New Balance Athletics, Inc. (“New Balance”) is a market-leading athletic footwear and apparel company that exclusively uses the distinctive marks NEW BALANCE and NEW BALANCE ATHLETICS in commerce. The company has invested hundreds of millions of dollars to promote the marks and it has sold more than a billion products in the United States bearing the marks. The NEW BALANCE and NEW BALANCE ATHLETICS Marks are among the company’s most valuable assets.

2. Defendant Balance Athletica, LLC (“Balance Athletica”) is a new athletic apparel company that uses the confusingly similar mark BALANCE ATHLETICA to sell the same goods, to the same consumers, using the same marketing channels. Actual confusion in the marketplace has already occurred. For example:



See <https://poshmark.com/listing/Balance-Athletica-Rider-Short-5f888dae7f80d21ee54b002c>.

3. Balance Athletica's use of a confusingly similar mark appears to be part of a larger plan to deliberately free ride on New Balance's famous brand. For example, Balance Athletica recently filed an intent-to-use trademark application with the United States Patent & Trademark Office ("USPTO") for the mark ACHIEVE BALANCE for, among other things, footwear and apparel. Since the late 1990s, New Balance has exclusively used the mark ACHIEVE with NEW BALANCE in its advertisements, at point of purchase, and on its products. And, for more than a decade, the company prominently used the ACHIEVE Mark on nearly every shoe box it sold, which corresponds to hundreds of millions of pairs of shoes:



Since at least as early as 2012, New Balance also has had a team apparel line branded ACHIEVE.

See <https://www.newbalanceteam.com/search?q=achieve>.

4. As shown more fully below, Balance Athletica's use of BALANCE ATHLETICA: (i) infringes the NEW BALANCE Mark in violation of 15 U.S.C. § 1114; (ii) constitutes false designation of origin in violation of 15 U.S.C. § 1125; (iii) dilutes the NEW BALANCE Mark in violation of 15 U.S.C. § 1125(c); (iv) infringes the NEW BALANCE and NEW BALANCE ATHLETICS Marks in violation of Mass. Gen. L. C. 110H §§ 11-14, 16; and (v) dilutes the NEW BALANCE and NEW BALANCE ATHLETICS Marks in violation of Mass. Gen. L. C. 110H § 16.

5. Given Balance Athletica's current and planned trademark uses, New Balance's

long-standing and prominent use of its marks, and New Balance's federal trademark registrations, it appears that Balance Athletica's conduct is willful.

6. Balance Athletica's conduct has and will irreparably harm New Balance and its substantial goodwill. It also has and will cause monetary harm in an amount to be determined at trial.

### **PARTIES**

7. New Balance Athletics, Inc. is a Massachusetts corporation with its principal place of business at 100 Guest Street, Boston, Massachusetts 02135.

8. Upon information and belief, Balance Athletica is a Colorado limited liability company with its principal place of business at 5303 Havana Street #150, Denver, Colorado 80239.

### **JURISDICTION AND VENUE**

9. This Court has subject matter jurisdiction over these claims pursuant to 15 U.S.C. § 1121(a), 28 U.S.C. §§ 1331, 1332(a)(2), 1338(a) and (b), and this Court's supplemental jurisdiction under 28 U.S.C. § 1367. Plaintiff New Balance Athletics, Inc. is a citizen of Massachusetts. Upon information and belief, Defendant Balance Athletica is a Colorado limited liability company and is a citizen of Colorado. As such, there is complete diversity of the parties. The matter in controversy exceeds \$75,000, exclusive of interests and costs.

10. Upon information and belief, venue is proper in this Court pursuant to 28 U.S.C. § 1391(b) and (c) because this is the judicial district where: (i) a substantial part of the events giving rise to the claims occurred; and (ii) where Balance Athletica is subject to personal jurisdiction.

11. Upon information and belief, Balance Athletica regularly solicits and conducts business in Massachusetts. Specifically, Balance Athletica promotes and sell its goods, including

the goods at issue here, within Massachusetts. In addition, upon information and belief, Balance Athletica or its agents maintain websites available in Massachusetts that facilitate and/or enable users to purchase the infringing goods from Massachusetts.

### **FACTS**

12. New Balance is a private company that was founded in 1906. Today, New Balance is one of the largest athletic footwear and apparel companies in the world, offering products in more than 120 countries. It has over 7,000 employees worldwide.

13. Since its earliest days, New Balance has focused on fit and authenticity as its core brand message. New Balance is one of the few athletic footwear manufacturers to make shoes in true width sizing, rather than the more common narrow and wide. It is the only major company that manufactures athletic footwear in factories in the United States. Because of its brand qualities, New Balance has some of the most brand-loyal customers in the marketplace.

14. New Balance sells a complete line of performance and casual footwear, including running, walking, hiking, basketball, baseball, soccer, tennis, golf, and lifestyle shoes. It also sells a complete line of performance and casual apparel, including shirts, jackets, sweatshirts, pants, leggings, sports bras, hats, and socks.

### **The NEW BALANCE and NEW BALANCE ATHLETICS Marks**

15. New Balance has exclusively used the trademark NEW BALANCE since at least as early as the 1970s. The mark has appeared on nearly every product the company has sold since that time. In the aggregate, New Balance has used the NEW BALANCE Mark (typically in several places) on more than one billion footwear and apparel products sold in the United States. The mark also appears on materials that accompanied those products at retail, including hangtags, boxes, tissue paper, informational product inserts, and bags.

16. The sales of these NEW BALANCE branded footwear and apparel products correspond to many billions of dollars of revenue.

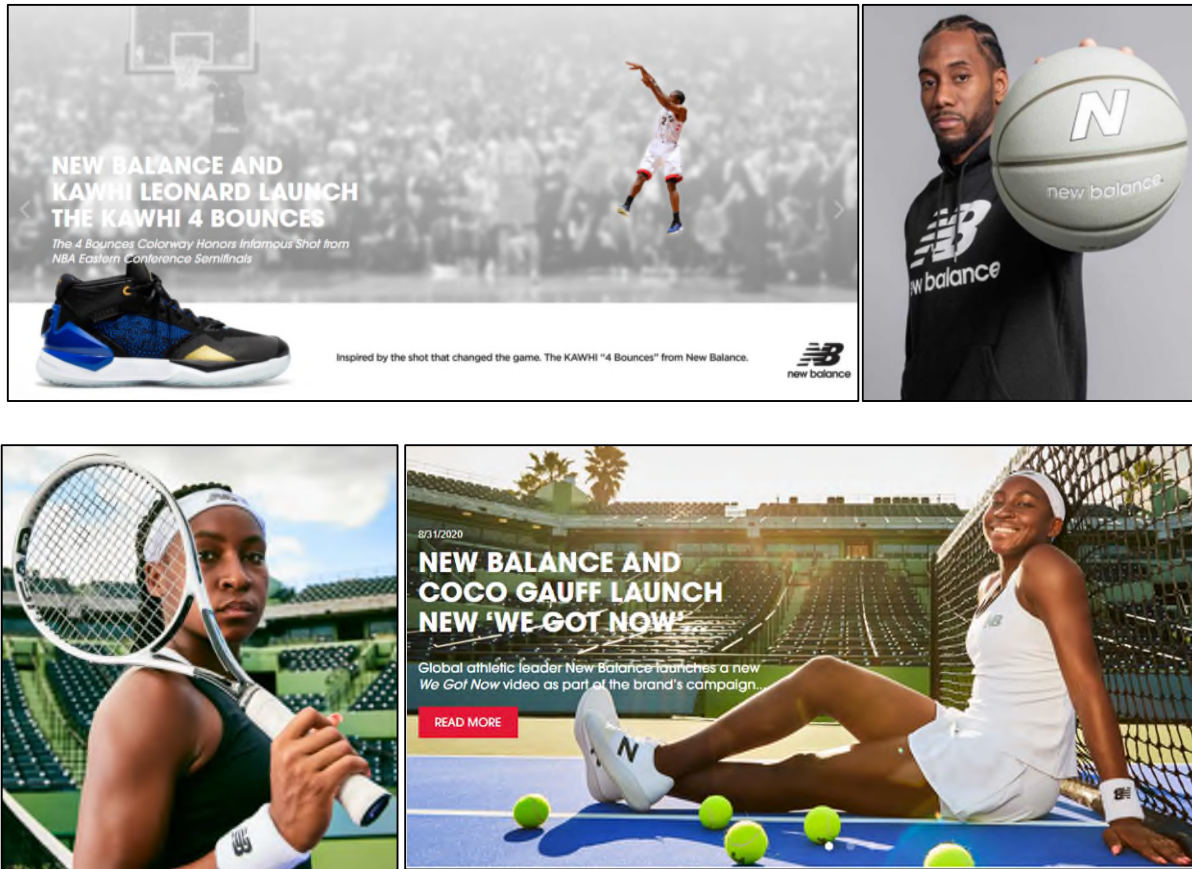
17. Over the past decade, New Balance has spent an average of \$75 million annually on marketing worldwide. The vast majority of these marketing expenditures are directed to the United States and nearly all of the marketing material features the NEW BALANCE Mark.

18. New Balance markets its brand in all channels, including television, print, digital, social media, and at point of purchase. In the past decade, its marketing has made more than one billion consumer impressions. Its website ([www.newbalance.com](http://www.newbalance.com)) has more than thirty-five million annual visitors; its Instagram account has more than six million followers; and its Facebook account has more than eight million followers. All of these channels prominently feature the NEW BALANCE Mark.

19. The NEW BALANCE Mark is used in numerous places on or in hundreds of stand-alone retail stores and third-party footwear and apparel retailers across the United States.

20. The NEW BALANCE Mark also is used in connection with sponsorships of numerous major athletic events and venues. For example, the company sponsors the New York City marathon and has highly visible signage in Fenway Park.

21. The NEW BALANCE Mark also is used to sponsor several of the most popular sports leagues and teams in the United States, including the NBA, MLL, the Boston Red Sox, and the New York Mets. The brand also is used to sponsor famous athletes, including U.S. Olympic medalists Emma Coburn, Jenny Simpson, and Trayvon Bromell, as well as elite professional athletes such as NBA Champion Kawhi Leonard and U.S. Open Champion Coco Gauff:



22. Like many successful footwear and apparel brands, New Balance collaborates with third-party brands and fashion companies to develop “special edition” products. For example, for many years New Balance has collaborated with fashion company J. Crew on footwear and apparel lines that bear the NEW BALANCE Mark. The collaborations are widely promoted through paid and organic advertising and publicity. *See, e.g.,* <https://www.popsugar.com/fitness/JCrew-New-Balance-Activewear-Collection-42514616>.

23. The third-party branding company Brand Keys ranks the New Balance brand highly. Its annual consumer surveys and rankings indicate that New Balance purchasers are among the most loyal consumers among all consumers and that the brand is perceived as among the top 25 most “patriotic” brands in the country.

24. In 2015, New Balance changed its name from “New Balance Athletic Shoe, Inc.”



to “New Balance Athletics, Inc.” to better reflect its substantial growth beyond its origins in footwear. As a result, the company’s market-facing materials that identify the company name were changed to “New Balance Athletics, Inc.” These include the company website, shoe boxes, hangtags, and product information cards.

25. The company still uses the trademark NEW BALANCE as described above, but it also extensively uses the distinctive trademark NEW BALANCE ATHLETICS in commerce on or in connection with athletic footwear and apparel.

26. Since at least as early as 2015, New Balance has sold numerous products that bear the NEW BALANCE ATHLETICS Mark. For example:



NB Athletics Animal Print Legging  
Women's

Athletics Core Legging  
Women's

See generally [https://www.newbalance.com/search/?q=athletics&search-button=&lang=en\\_US](https://www.newbalance.com/search/?q=athletics&search-button=&lang=en_US) (listing NEW BALANCE ATHLETICS branded goods).

27. As a result of its long-standing, exclusive use of the distinctive NEW BALANCE and NEW BALANCE ATHLETICS Marks in commerce in connection with athletic footwear and apparel products, New Balance has acquired valid common law trademark rights in the marks.

28. In addition to its common law rights, New Balance owns incontestable federal registrations for the following:

<u>Mark</u>	<u>Registration No.</u>	<u>Date</u>	<u>Goods</u>
NEW BALANCE	1,260,938	12/13/83	IC 018: Tote bags.  IC 025: Hats, sweat bands, visors, sport shirts, singlets, running shorts, running suits, all-weather suits, recreational tops and shorts, socks, walking shoes, boat shoes, aerobic dancing shoes and hiking boots.
NEW BALANCE	1,053,241	11/23/76	IC 025: Athletic shoes, insoles, [heel pads,] and t-shirts.
NEW BALANCE	2,863,103	7/13/04	IC 009: Sunglasses, eyeglasses and eyeglass cases.
NEW BALANCE	2,690,233	2/25/03	IC 035: Retail store, computerized online retailing and catalog mail order services featuring athletic, sports, exercise and fitness clothing, luggage and footwear; arranging and conducting trade show exhibitions in the field of athletics, sports, exercise and fitness.  IC 036: Financial sponsorship of athletic teams, footrace marathons, athletic events, athletic matches and athletic tournaments.



<u>Mark</u>	<u>Registration No.</u>	<u>Date</u>	<u>Goods</u>
NEW BALANCE	2,845,867	5/25/04	<p>IC 001: Shoe water repellents, namely, waterproofing chemical compounds for shoes made of leather.</p> <p>IC 003: Cleaner for use on shoes, shoe conditioner cream, and shoe polish.</p> <p>IC 005: Shoe deodorizers.</p>
NEW BALANCE	2,955,395	5/24/05	<p>IC 028: Exercise equipment, namely, treadmills, elliptical trainers, and stationary pedal operated training apparatus to promote health and fitness.</p>
NEW BALANCE	2,990,081	8/30/05	<p>IC 001: Water repellent chemical compositions for clothing, fabric protectants for clothing, fabric protectants for footwear, stain repellents for clothing, stain repellents for footwear.</p> <p>IC 003: Cleaning preparations for use on clothing, laundry detergents, fabric softeners for domestic use, shoe whitener, saddle soap, spot remover, shoe conditioner spray.</p> <p>IC 005: Disinfectants for clothing.</p> <p>IC 026: Shoe laces.</p>
NEW BALANCE	3,595,487	3/24/09	<p>IC 009: Pedometers.</p> <p>IC 010: Blood pressure monitors, heart monitors to be worn during exercise, sport monitors, pulse rate monitors.</p> <p>IC 014: Watches, stop watches, chronographs for use as watches, watches for outdoor use.</p>

True and accurate copies of the certificates of registrations for these marks are attached hereto as Exhibit A.

29. New Balance's longstanding exclusive use, widespread marketing, and extensive sales have made the NEW BALANCE Mark famous. Indeed, numerous commentators have expressly identified the mark as "iconic," a "household name," or "famous." For example:

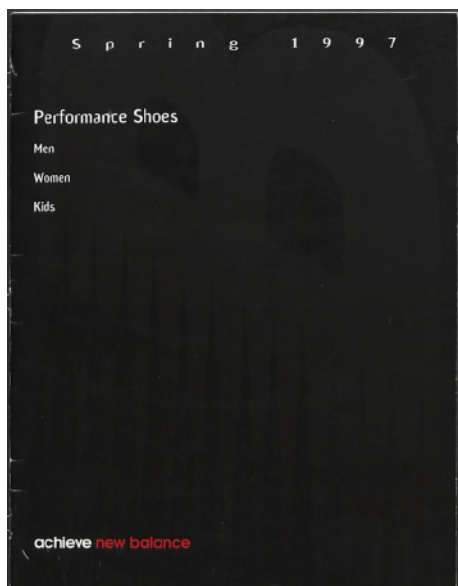
- "As one of the largest sporting manufacturers in the world, New Balance has been in business for over 100 years, producing iconic sneakers and clothing some of the world's most ambitious athletes along the way. New Balance is a household name that is only growing in popularity as the years go by." See <https://www.heddels.com/2019/07/new-balance-brand-history-philosophy-iconic-products/>.
- "Founded in Boston nearly a century ago, this iconic sneaker brand is known for real-deal running shoes with graphic appeal." See <https://www.madewell.com/womens/labels-we-love/new-balance>.
- "With Leonard set to start on Team LeBron this Sunday, expect the quiet superstar to debut a new NB basketball sneaker, officially signifying the iconic brand's foray into the hoops footwear market." See <https://sneakernews.com/2019/02/14/kawhi-leonard-new-balance-shoe-all-star/>.
- "17 iconic American clothing brands that have withstood the test of time." See <https://www.insider.com/popular-us-retail-brands-still-around> (listing New Balance).
- "The shoe slowly made its way around the running community in Massachusetts and eventually led to the buy-out from current chairman Jim Davis. This buyout would go on to elevate the brand from obscurity to a household name." See <https://www.port-magazine.com/fashion/the-quiet-revolution/>.
- "CNN anchor Chris Cuomo addressed Mark Preston — a broadcaster on the network — with a popular line from a beloved A Tribe Called Quest song, 'Buggin' Out.' The lyric is special to sneaker fans, as it names a famous brand. 'I sport New Balance sneakers to avoid a narrow path,' is the famous line that Cuomo used, which was recited by one of the group's members, the late Phife Dawg, in 1991 on the classic 'Low End Theory' album." See <https://footwearnews.com/2020/focus/athletic-outdoor/chris-cuomo-new-balance-shoes-avoid-narrow-path-atcq-1203072413/>.

30. As a result of the foregoing, New Balance has acquired enormous goodwill in the NEW BALANCE and NEW BALANCE ATHLETICS Marks. They are among the company's most valuable assets.

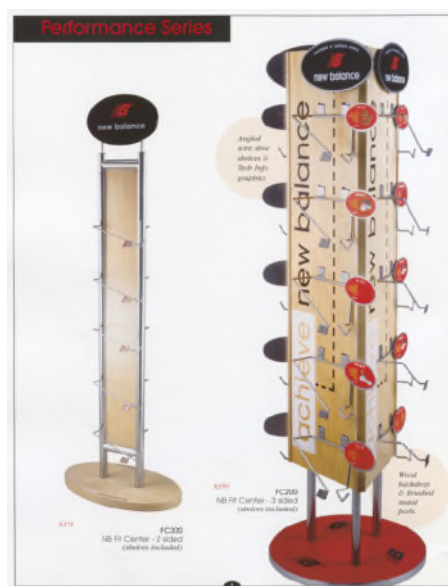
### The New Balance ACHIEVE Mark

31. New Balance owns numerous other common law and federally registered trademarks, in addition to the NEW BALANCE and NEW BALANCE ATHLETICS Marks described above.

32. For example, since at least as early as 1997, New Balance has exclusively used the mark ACHIEVE in commerce, as shown in its marketing and point of purchase (“POP”) materials:



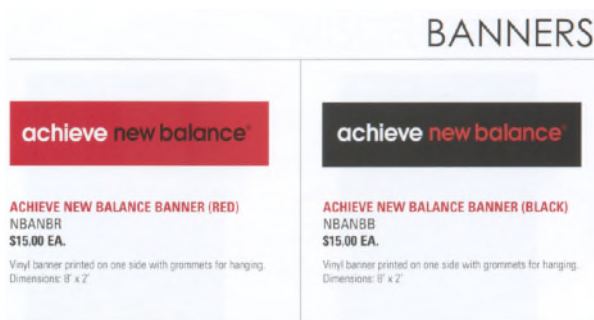
(Footwear Catalog – 1997)



(POP Catalog – 1999)



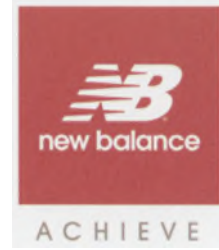
(Apparel Catalog – 2001)



(POP Catalog – 2004)



(POP Catalog – 2006)



(Footwear Catalog – 2008)

33. The company used the ACHIEVE Mark on nearly every one of its shoe boxes for more than ten years, which corresponds to hundreds of millions of pairs of shoes.

34. Since 2012, New Balance has used the ACHIEVE Mark in connection with a complete team apparel line. See <https://www.newbalanceteam.com/search?q=achieve>. It also uses a variation of the mark on an individual apparel line branded ACHIEVER. See <https://www.newbalance.com/achiever-collection/>.

35. As a result of its long-standing, exclusive use of the distinctive ACHIEVE Mark in commerce in connection with athletic footwear and apparel products, New Balance has acquired valid common law rights in the mark.

### **Balance Athletica And Its Infringing Conduct**

36. Upon information and belief, Balance Athletica is an athletic apparel company that was founded in 2018.

37. Balance Athletica holds a federal trademark registration for the mark BALANCE ATHLETICA. See Exhibit B (U.S. Reg. No. 5,676,182, dated February 12, 2019). Its registration claims use of the mark on “apparel, namely, swimwear, t-shirts, shirts, tank tops, sweatshirts, sweaters, pants, bottoms, leggings, leg warmers, tights, sweatpants, shorts, dresses, jackets, coats, vests, underwear, socks, warm-up suits, bodysuits, leotards; headwear, namely, hats, caps, visors, headbands; clothing accessories, namely, belts, scarves, shawls, shoulder wraps, arm warmers,

gloves.” Upon information and belief, Balance Athletica does not use the mark on all of the goods listed in its registration.

38. Upon information and belief, Balance Athletica is using the BALANCE ATHLETICA mark on at least the following goods: leggings, sweatpants, shirts, tank tops, dresses, skirts, shorts, sports bras, and jackets, all of which are items also sold by New Balance.

39. According to its federal trademark registration, Balance Athletica’s first use of the BALANCE ATHLETICA mark in commerce occurred in August 2018, long after the NEW BALANCE and NEW BALANCE ATHLETICS Marks had been in use, and long after the NEW BALANCE Mark had been registered and become incontestable and famous.

40. Upon information and belief, given the fame and long-standing use of the NEW BALANCE and NEW BALANCE ATHLETICS Marks, Balance Athletica must have known of New Balance’s rights. Also, given New Balance’s registrations for its NEW BALANCE Mark, Balance Athletica had at least constructive notice of New Balance’s rights in that mark. As a result, Balance Athletica’s infringement is intentional. In addition, Balance Athletica intended to dilute the distinctive source identifying quality of the NEW BALANCE Mark.

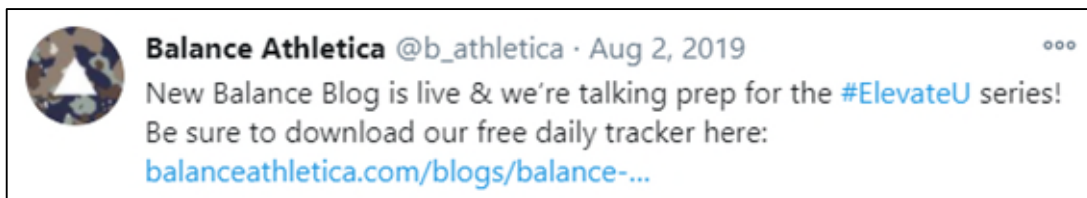
41. Balance Athletica’s infringing goods and New Balance’s goods are marketed and sold to overlapping classes of purchasers insofar as the Balance Athletica products are performance or casual “lifestyle” or fashion athletic apparel and many of New Balance’s products are in the same category.

42. Balance Athletica and New Balance advertise through overlapping marketing channels insofar as they use the Internet, including the same social media outlets (e.g., Facebook, YouTube, Twitter, and Instagram), to advertise their goods. In addition, the parties’ relevant goods

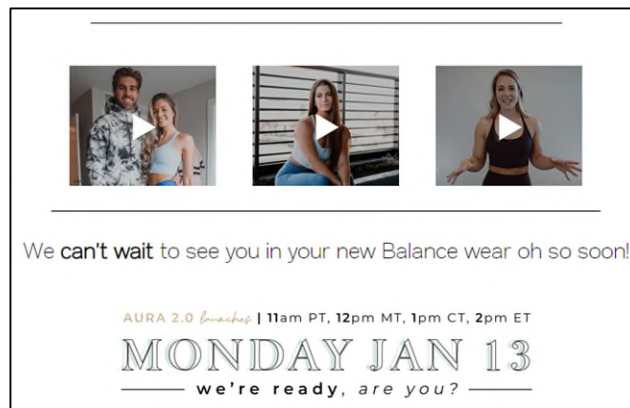
are routinely the topic of discussion in the same type of popular fashion websites, blogs, and social media posts. Both parties also rely in part on social media “influencers” to promote their goods.

43. Balance Athletica and New Balance sell their goods through overlapping sales channels insofar as they both sell their goods online.

44. Common uses of Balance Athletica’s mark will increase the already high likelihood of confusion between the parties’ marks. Balance Athletica, consumers, and the press routinely use the phrase “New Balance” or “New Balance Athletica” to describe the company’s “new” programs and products. For example:



See [https://twitter.com/b\\_athletica/status/1157392090046689280](https://twitter.com/b_athletica/status/1157392090046689280).

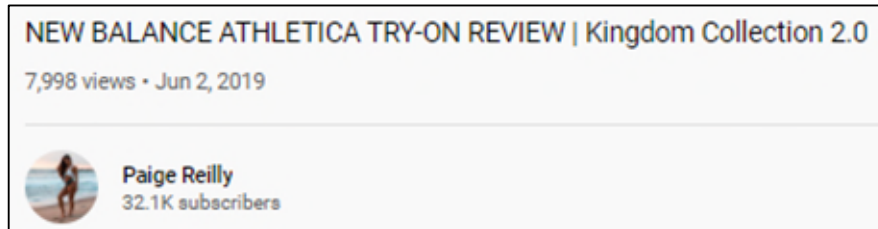


See <https://www.balanceathletica.com/blogs/balance-blog/everything-you-need-to-know-for-aura-2-0>.

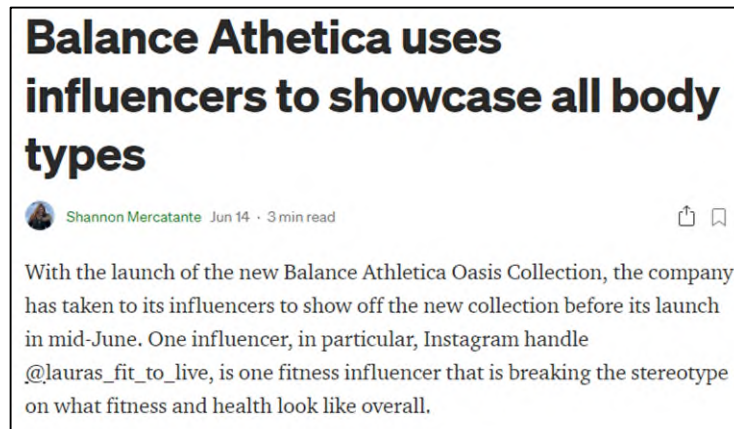




See <https://twitter.com/brookesutherby/status/1290836232923037696>.



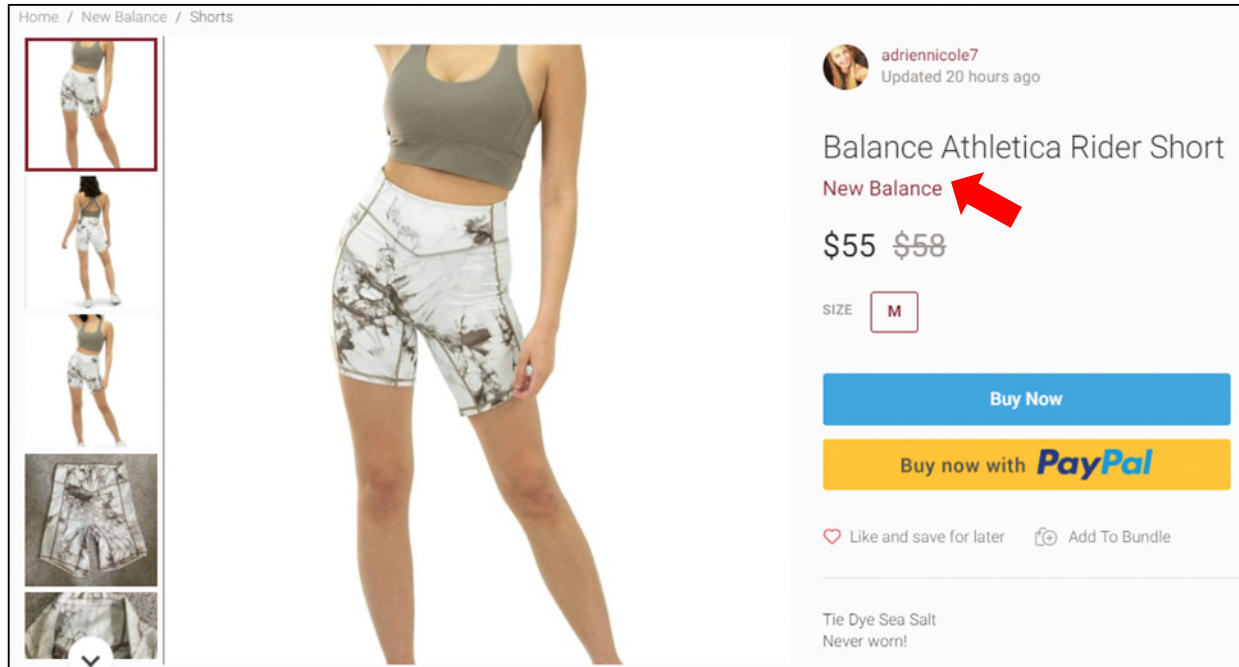
See [https://www.youtube.com/watch?v=\\_0How-D-M1c](https://www.youtube.com/watch?v=_0How-D-M1c).



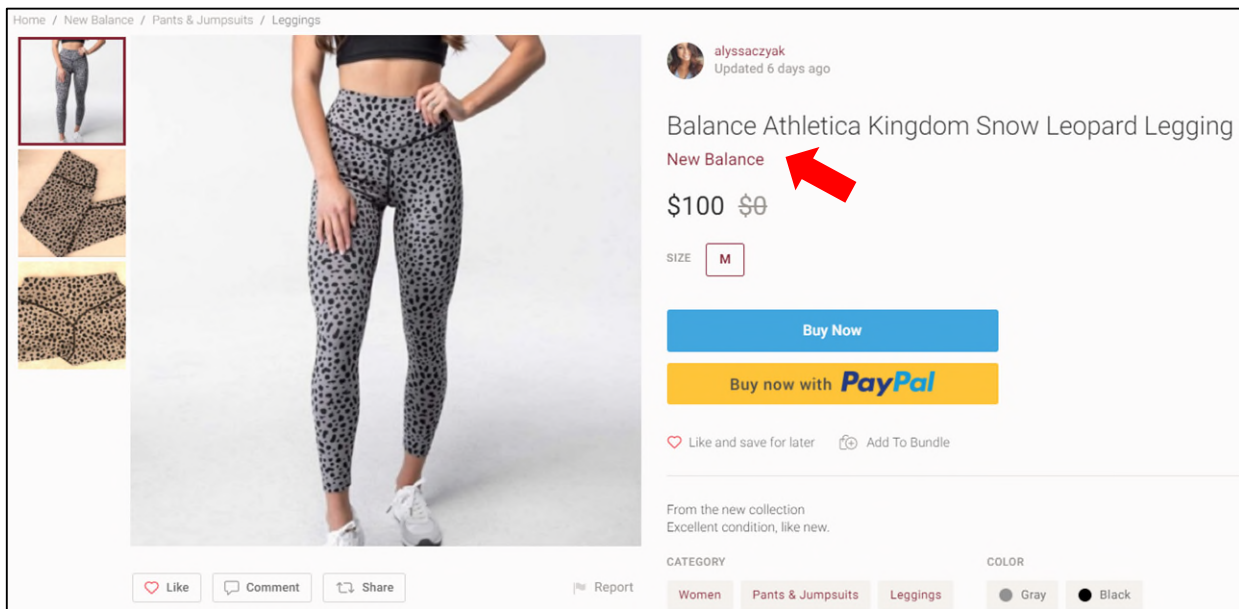
See <https://medium.com/@shanmercantante/balance-athletica-uses-influencers-to-showcase-all-body-types-71953b10cbb4>.

As a result, where a speaker or writer references Balance Athletica's new programs and products, BALANCE ATHLETICA transitions from confusingly similar to virtually identical to the NEW BALANCE and NEW BALANCE ATHLETICS Marks.

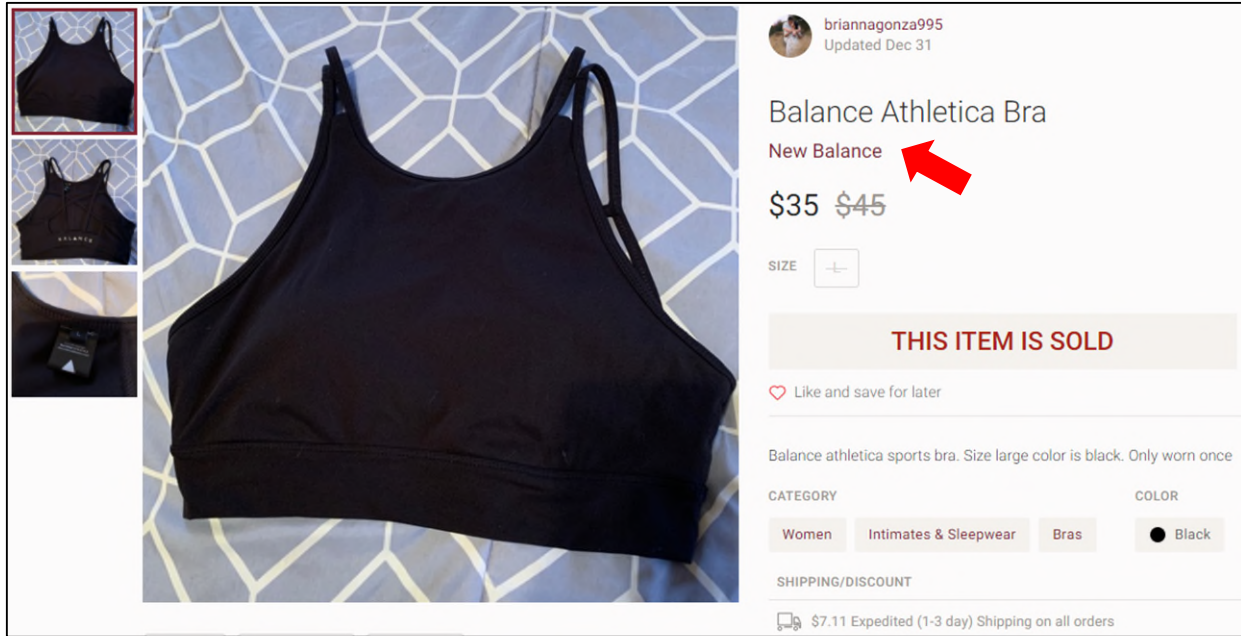
45. Consumers have already confused the parties' goods. For example, on the popular fashion marketplace Poshmark, several sellers have posted BALANCE ATHLETICA goods, but mistakenly identified them as NEW BALANCE goods:



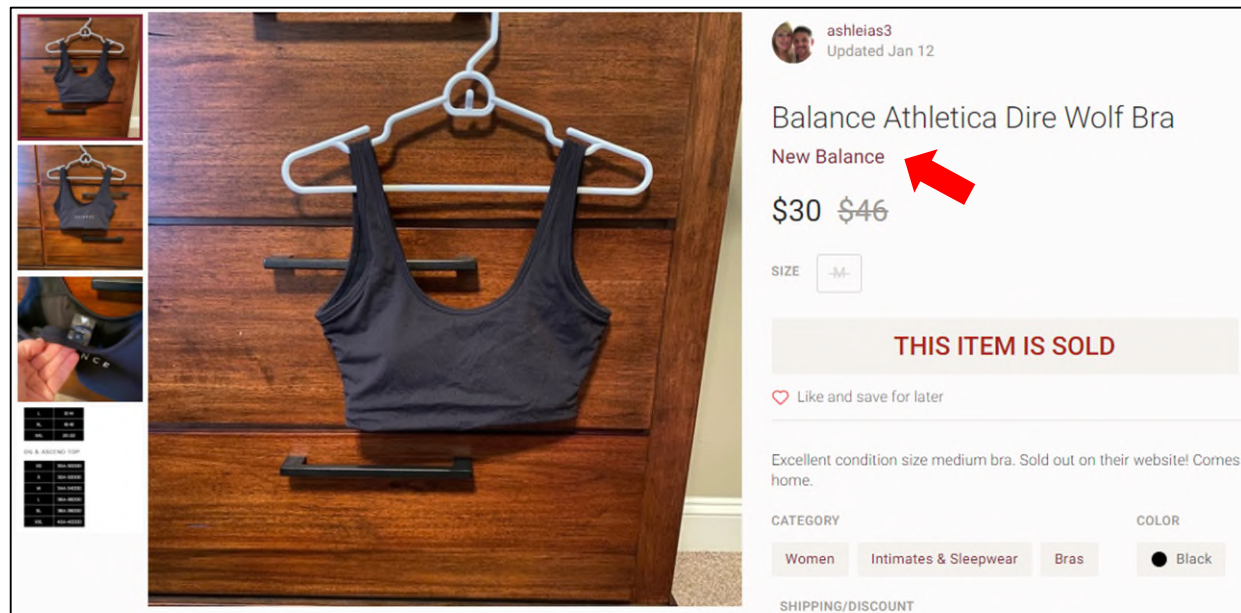
See <https://poshmark.com/listing/Balance-Athletica-Rider-Short-5f888dae7f80d21ee54b002c>.



See <https://poshmark.com/listing/Balance-Athletica-Kingdom-Snow-Leopard-Legging-5fa3876dc936af95be203821>.



See <https://poshmark.com/listing/Balance-Athletica-Bra-5e0b8a21ffc2d4c0c210b9ba>.



See <https://poshmark.com/listing/Balance-Athletica-Dire-Wolf-Bra-5ddaecf0c4cd7ee64573f764>.

46. Similarly, the Balance Athletica forum on the popular social media website Reddit describes itself (incorrectly) as a forum “about the products from New Balance Athletea.” See <https://www.reddit.com/r/Balanceathletica/>.

47. Confusion is likely to increase in the future. Balance Athletica has expressed an intent to use additional marks that are virtually identical to more of New Balance's existing marks or product line names, which will increase the branding overlap between the parties. As shown above, New Balance owns common law rights in the mark ACHIEVE for athletic footwear and apparel. Balance Athletica has filed a federal intent-to-use trademark application (Serial No. 90217568) for ACHIEVE BALANCE, which is confusingly similar to New Balance's use of its ACHIEVE Mark.

48. Balance Athletica also recently filed federal intent-to-use trademark applications for PRO and GOLF combined with BALANCE, also for footwear and apparel products. *See* Application Serial Nos. 90/217,227; 90/217,282; 90/217,356; and 90/217,415. New Balance has three long-standing and popular shoe model lines branded PRO. *See* [https://www.newbalance.com/search/?q=pro&search-button=&lang=en\\_US](https://www.newbalance.com/search/?q=pro&search-button=&lang=en_US) (tennis, soccer, and skate PRO shoes). It also has a complete golf footwear and apparel product line branded NEW BALANCE GOLF. *See* <https://www.newbalance.com/golf-collection/>.

49. Balance Athletica's use of the BALANCE ATHLETICA Mark on apparel is likely to cause confusion among consumers and/or suggest an affiliation, connection, or association between New Balance and Balance Athletica. Balance Athletica's use of its mark is likely to dilute the distinctive source identifying quality of the famous NEW BALANCE Mark.

50. Balance Athletica's use of BALANCE ATHLETICA is likely to cause initial interest, point-of-sale, and post-sale confusion, to the irreparable harm and detriment of New Balance and the substantial goodwill it has developed in its marks.

51. As a result of the foregoing, New Balance has and will suffer irreparable harm and monetary harm in an amount to be determined at trial.

**COUNT I**  
**(Trademark Infringement—15 U.S.C. § 1114)**  
**(The NEW BALANCE Mark)**

52. New Balance repeats and realleges the allegations contained in paragraphs 1 through 51 above as if fully set forth herein.

53. As described above, New Balance owns the distinctive and federally registered NEW BALANCE Mark as depicted in U.S. Reg. Nos. 1,260,938; 1,053,241; 2,863,103; 2,690,233; 2,845,867; 2,955,395; 2,990,081; and 3,595,487.

54. New Balance's ownership and exclusive use in commerce of the NEW BALANCE Mark predates the use by Balance Athletica of its BALANCE ATHLETICA Mark on athletic apparel.

55. Upon information and belief, Balance Athletica's conduct is willful and intentional and intended to free-ride off the goodwill associated with the NEW BALANCE Mark. Balance Athletica is and was at all relevant times both actually and constructively aware of New Balance's prior use, ownership, and registration, and Balance Athletica's conduct is therefore also willful and intentional.

56. Balance Athletica uses its BALANCE ATHLETICA Mark in interstate commerce in connection with the sale, offering for sale, distribution, and/or advertising of its athletic apparel products.

57. Balance Athletica's use in commerce of its BALANCE ATHLETICA Mark in connection with athletic apparel, as described above, constitutes infringement of at least the trademarks that are the subjects of U.S. Reg. Nos. 1,260,938; 1,053,241; and 2,690,233, in violation of 15 U.S.C. § 1114, in that it is without New Balance's consent and is likely to cause confusion, mistake, and/or deception among consumers.

58. As a direct and proximate result of Balance Athletica's violations of 15 U.S.C.



§ 1114, New Balance has been and will continue to be damaged.

59. Upon information and belief, Balance Athletica has realized, and continues to realize, substantial revenues, profits, and other benefits rightfully belonging to New Balance as a result of its wrongful conduct.

60. Balance Athletica's conduct is causing and will continue to cause New Balance to suffer irreparable harm and, unless Balance Athletica is restrained, New Balance will continue to be so damaged, because it has no adequate remedy at law.

**COUNT II**  
**(False Designation of Origin—15 U.S.C. § 1125(a))**  
**(The NEW BALANCE and NEW BALANCE ATHLETICS Marks)**

61. New Balance repeats and realleges the allegations contained in paragraphs 1 through 60 above as if fully set forth herein.

62. As described above, New Balance owns valid and protectable rights in the distinctive NEW BALANCE and NEW BALANCE ATHLETICS Marks in connection with footwear and apparel.

63. New Balance's ownership and exclusive use in commerce of the NEW BALANCE and NEW BALANCE ATHLETICS Marks in connection with footwear and apparel predates the use by Balance Athletica of its BALANCE ATHLETICA Mark in connection with footwear and apparel.

64. Upon information and belief, Balance Athletica's conduct is willful and intentional and intended to free-ride off the goodwill associated with the NEW BALANCE and NEW BALANCE ATHLETICS Marks. Balance Athletica is and was at all relevant times both actually and constructively aware of New Balance's prior use, ownership, and registration, and Balance Athletica's conduct is therefore also willful and intentional.

65. Balance Athletica uses the BALANCE ATHLETICA Mark in interstate commerce



in connection with the sale, offering for sale, distribution, and/or advertising of its footwear and apparel products.

66. Balance Athletica's use in commerce of the BALANCE ATHLETICA Mark in connection with apparel, as described above, constitutes false designation of origin in violation of 15 U.S.C. § 1125(a)(1)(A) in that it is likely to cause confusion, to cause mistake, or to deceive as to the affiliation, connection, or association of Balance Athletica with New Balance and/or as to the origin, sponsorship, or approval by New Balance of Balance Athletica's goods, services, or commercial activity.

67. As a direct and proximate result of Balance Athletica's violations of 15 U.S.C. § 1125, New Balance has been and will continue to be damaged.

68. Upon information and belief, Balance Athletica has realized, and continues to realize, substantial revenues, profits, and other benefits rightfully belonging to New Balance as a result of its wrongful conduct.

69. Balance Athletica's conduct is causing and will continue to cause New Balance to suffer irreparable harm and, unless Balance Athletica is restrained, New Balance will continue to be so damaged, because it has no adequate remedy at law.

**COUNT III**  
**(Dilution—15 U.S.C. § 1125(c))**  
**(The NEW BALANCE Mark)**

70. New Balance repeats and realleges the allegations contained in paragraphs 1 through 69 above as if fully set forth herein.

71. As described above, As described above, New Balance owns the distinctive and federally registered NEW BALANCE Mark as depicted in U.S. Reg. Nos. 1,260,938; 1,053,241; 2,863,103; 2,690,233; 2,845,867; 2,955,395; 2,990,081; and 3,595,487.

72. New Balance's ownership and exclusive use in commerce of the NEW BALANCE Mark predates the use by Balance Athletica of its BALANCE ATHLETICA Mark on apparel.

73. Through consistent and continued use, product promotion, and consumer and industry recognition, New Balance has developed the NEW BALANCE Mark to the point that it is famous. Balance Athletica did not begin using the BALANCE ATHLETICA Mark in commerce until after the NEW BALANCE Mark became famous.

74. Upon information and belief, Balance Athletica's conduct is willful and intentional and intended to free-ride off the goodwill associated with the NEW BALANCE Mark. Balance Athletica is and was at all relevant times both actually and constructively aware of New Balance's prior use, ownership, and registration, and Balance Athletica's conduct is therefore also willful and intentional.

75. Balance Athletica's BALANCE ATHLETICA Mark used in the context of the same goods is likely to cause dilution of the distinctive qualities of the NEW BALANCE Mark in violation of 15 U.S.C. § 1125(c).

76. As a direct and proximate result of Balance Athletica's violations of 15 U.S.C. § 1125, New Balance has been and will continue to be damaged.

77. Upon information and belief, Balance Athletica has realized, and continues to realize, substantial revenues, profits, and other benefits rightfully belonging to New Balance as a result of its wrongful conduct.

78. Balance Athletica's conduct is causing and will continue to cause New Balance to suffer irreparable harm and, unless Balance Athletica is restrained, New Balance will continue to be so damaged, because it has no adequate remedy at law.

**COUNT IV**

**(Trademark Infringement—Mass. Gen. L. C. 110H §§ 11-14, 16)  
(The NEW BALANCE and NEW BALANCE ATHLETICS Marks)**

79. New Balance repeats and realleges the allegations contained in paragraphs 1 through 78 above as if fully set forth herein.

80. As described above, New Balance owns valid and protectable rights in the distinctive NEW BALANCE and NEW BALANCE ATHLETICS Marks in connection with footwear and apparel.

81. New Balance's ownership and exclusive use in commerce of its NEW BALANCE and NEW BALANCE ATHLETICS Marks in connection with athletic footwear and apparel predates the use by Balance Athletica of its BALANCE ATHLETICA Mark in connection with apparel.

82. Upon information and belief, Balance Athletica's conduct is willful and intentional and intended to free-ride off of the goodwill associated with the NEW BALANCE and NEW BALANCE ATHLETICS Marks. Balance Athletica is and was at all relevant times both actually and constructively aware of New Balance's prior use, ownership, and registration, and Balance Athletica's conduct is therefore also willful and intentional.

83. Balance Athletica's adoption and use of a confusingly similar BALANCE ATHLETICA Mark in Massachusetts and elsewhere in connection with the sale, offering for sale, distribution, and/or advertising of its apparel is likely to cause confusion among relevant consumers.

84. Balance Athletica's use of a confusingly similar mark, as described above, constitutes trademark infringement in violation of Mass. Gen. Laws ch. 110H §§ 12 and 14 in that it is without New Balance's consent and is likely to cause confusion, mistake, and/or deception among consumers, all to the irreparable injury of New Balance and the goodwill it has developed

in the NEW BALANCE and NEW BALANCE ATHLETICS Marks.

85. As a direct and proximate result of Balance Athletica's violations of Mass. Gen. Laws ch. 110H §§ 12 and 14, New Balance has been and will continue to be damaged.

86. Upon information and belief, Balance Athletica has realized, and continues to realize, substantial revenues, profits, and other benefits rightfully belonging to New Balance as a result of its wrongful conduct.

87. Balance Athletica's conduct is causing and will continue to cause New Balance to suffer irreparable harm and, unless Balance Athletica is restrained, New Balance will continue to be so damaged, because it has no adequate remedy at law.

**COUNT V**  
**(Massachusetts Statutory Dilution—Mass. Gen. L. C. 110H § 16)**

88. New Balance repeats and realleges the allegations contained in paragraphs 1 through 87 above as if fully set forth herein.

89. As described above, New Balance owns valid and protectable rights in the distinctive NEW BALANCE and NEW BALANCE ATHLETICS Marks in connection with footwear and apparel.

90. New Balance's ownership and exclusive use in commerce of its NEW BALANCE and NEW BALANCE ATHLETICS Marks in connection with footwear and apparel predates the use by Balance Athletica of the BALANCE ATHLETICA Mark in connection with apparel.

91. Upon information and belief, Balance Athletica's conduct is willful and intentional and intended to free-ride off of the goodwill associated with the NEW BALANCE and NEW BALANCE ATHLETICS Marks. Balance Athletica is and was at all relevant times both actually and constructively aware of New Balance's prior use, ownership, and registration, and Balance Athletica's conduct is therefore also willful and intentional.

92. Balance Athletica's adoption and use of a confusingly similar BALANCE ATHLETICA Mark as described above, constitutes statutory dilution in that it is without New Balance's consent and create and will continue to create a likelihood of injury to New Balance's reputation and/or a likelihood of dilution of the distinctive quality of the NEW BALANCE and NEW BALANCE ATHLETICS Marks in violation of Mass. Gen. Laws ch. 110H § 16.

93. As a direct and proximate result of Balance Athletica's dilution of the NEW BALANCE and NEW BALANCE ATHLETICS Marks, New Balance has been and will continue to be damaged.

94. Balance Athletica's conduct is causing and will continue to cause New Balance to suffer irreparable harm and, unless Balance Athletica is restrained, New Balance will continue to be so damaged, because it has no adequate remedy at law.

**COUNT VI**  
**(Cancellation of U.S. Reg. No. 5,676,182)**

95. New Balance repeats and realleges the allegations contained in paragraphs 1 through 94 above as if fully set forth herein.

96. As described above, New Balance owns the distinctive and federally registered NEW BALANCE Mark as depicted in U.S. Reg. Nos. 1,260,938; 1,053,241; 2,863,103; 2,690,233; 2,845,867; 2,955,395; 2,990,081; and 3,595,487.

97. As described above, Balance Athletica is the owner of U.S. Reg. No. 5,676,182 for the mark BALANCE ATHLETICA, which was filed on October 11, 2017 and claims use of the mark in commerce since August 13, 2018, on "Apparel, namely, swimwear, t-shirts, shirts, tank tops, sweatshirts, sweaters, pants, bottoms, leggings, leg warmers, tights, sweatpants, shorts, dresses, jackets, coats, vests, underwear, socks, warm-up suits, bodysuits, leotards; headwear,

namely, hats, caps, visors, headbands; clothing accessories, namely, belts, scarves, shawls, shoulder wraps, arm warmers, gloves” (“the ‘182 Registration”).

98. New Balance’s ownership, exclusive use in commerce and registrations of the NEW BALANCE Mark for athletic apparel all predate Balance Athletica’s filing date and claimed first use date of its BALANCE ATHLETICA Mark on athletic apparel.

99. The NEW BALANCE Mark is famous, and it attained fame prior to the use or filing of the BALANCE ATHLETICA Mark.

100. As the junior user, Balance Athletica had an obligation to select a mark that does not infringe or dilute a prior mark.

101. As set forth above, the BALANCE ATHLETICA mark is confusingly similar to the prior NEW BALANCE Marks in appearance, sound, and overall impression. The marks are used on identical and highly similar goods, sold in the same channels of trade to the same target customers.

102. Balance Athletica’s use and registration of its BALANCE ATHLETICA Mark in connection with athletic apparel, as described above, constitutes infringement of at least the trademarks that are the subjects of New Balance’s U.S. Reg. Nos. 1,260,938; 1,053,241; and 2,690,233, in violation of 15 U.S.C. § 1114, in that it is without New Balance’s consent and is likely to cause – and has in fact caused – confusion, mistake, and/or deception among consumers.

103. Balance Athletica’s ‘182 registration is therefore subject to cancellation under Sections 2(d) and 14 and 37 of the Act (15 USC §§ 1052(d), 1064, and 1119).

104. Further, upon information and belief, Balance Athletica is not using the BALANCE ATHLETICA Mark on all of the goods listed in the ‘182 Registration currently, and was not using the mark on all the claimed goods as of its deadline to file a Statement of Use. For example,



Balance Athletica does not appear to use the mark on at least the following claimed goods: swimwear, sweaters, leg warmers, coats, vests, underwear, socks, hats, caps, visors, headbands, belts, scarves, shawls, shoulder wraps, arm warmers, and gloves.

105. The '182 Registration was therefore void *ab initio* and is subject to cancellation under Sections 1, 14, and 45 of the Act (15 U.S.C. §§ 1051, 1064 & 1127).

106. Based on the foregoing, New Balance is entitled to an order pursuant to 15 U.S.C. § 1119 directing the Director of the USPTO to cancel U.S. Reg. No. 5,676,182.

### **PRAYER FOR RELIEF**

WHEREFORE, New Balance respectfully requests the following relief:

A. That this Court enter judgment that: (i) Balance Athletica has infringed the NEW BALANCE Mark in violation of 15 U.S.C. § 1114; (ii) Balance Athletica's use of BALANCE ATHLETICA constitutes false designation of origin in violation of 15 U.S.C. § 1125; (iii) Balance Athletica has diluted the NEW BALANCE Mark in violation of 15 U.S.C. § 1125(c); (iv) Balance Athletica has infringed the NEW BALANCE and NEW BALANCE ATHLETICS Marks in violation of Mass. Gen. L. C. 110H §§ 11-14, 16; (v) Balance Athletica has diluted the NEW BALANCE and NEW BALANCE ATHLETICS Marks in violation of Mass. Gen. L. C. 110H § 16; and that all of the foregoing wrongful activities by Balance Athletica were willful;

B. That this Court Order that U.S. Reg. No. 5,676,182 be cancelled and direct the Clerk of Court to transmit notice of the Order to the Director of the United States Patent and Trademark Office;

C. That this Court enjoin Balance Athletica, its employees, agents, servants, and all in privity or acting in concert with any of them, from using the BALANCE ATHLETICA Mark, or

any derivative(s) thereof or any design(s) confusingly similar thereto, in commerce on or in connection with Balance Athletica's apparel;

D. That this Court enter an injunction against further infringement and dilution of the NEW BALANCE Mark, further false designation of origin concerning the NEW BALANCE and NEW BALANCE ATHLETICS Marks, and further unfair competition and unfair or deceptive acts or practices related thereto, by Balance Athletica and its employees, agents, servants, and all in privity or acting in concert with any of them, including at least from selling, offering to sell, distributing, importing, or advertising the infringing products, or any other apparel products that use a copy, reproduction, or colorable imitation of the NEW BALANCE and NEW BALANCE ATHLETICS Marks;

E. That this Court enter an order recalling all of Balance Athletica's apparel products bearing the BALANCE ATHLETICA Mark presently manufactured, sold, and/or distributed;

F. That this Court enter an order directing the destruction of: (i) all infringing products, including all recalled infringing products; (ii) any other apparel products that use a copy, reproduction, or colorable imitation of the NEW BALANCE and NEW BALANCE ATHLETICS Marks in Balance Athletica's possession or control; (iii) all advertising materials related to the infringing products in Balance Athletica's possession, custody, or control, including on the Internet, pursuant to at least 15 U.S.C. § 1118;

G. That this Court require an accounting of profits by Balance Athletica;

H. That this Court award New Balance Balance Athletica's profits, New Balance's actual damages, enhanced damages, exemplary damages, costs, prejudgment and post-judgment interest, and reasonable attorneys' fees pursuant to at least 15 U.S.C. §§ 1114(1), 1125(a), 1125(c), 1116, and/or 1117, and Mass. Gen. L. C. 110H §§ 11-14, 16; and

I. That this Court award New Balance such other and further relief that this Court deems just and proper.

**JURY DEMAND**

New Balance demands a trial by jury of all claims so triable.

\*\*\*\*

Respectfully submitted,

NEW BALANCE ATHLETICS, INC.

*By its attorneys,*

/s/ Mark S. Puzella

ORRICK, HERRINGTON & SUTCLIFFE LLP

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Telephone: 212.506.3535

ebrenckman@orrick.com

Dated: November 13, 2020

**Exhibit A**

**Int. Cls.: 18 and 25**

**Prior U.S. Cls.: 3 and 39**

**United States Patent and Trademark Office**

**Reg. No. 1,260,938**

**Registered Dec. 13, 1983**

**TRADEMARK**

**Principal Register**

**NEW BALANCE**

New Balance Athletic Shoe, Inc. (Massachusetts corporation)  
38-42 Everett St.  
Boston, Mass. 02134

For: TOTE BAGS, in CLASS 18 (U.S. Cl. 3).  
First use Jul. 1977; in commerce Jul. 1977.

For: HATS, SWEAT BANDS, VISORS, SPORT SHIRTS, SINGLETs, RUNNING SHORTS, RUNNING SUITS, ALL-WEATHER SUITS, RECRE-

DANCING SHOES AND HIKING BOOTS, in CLASS 25 (U.S. Cl. 39).

First use Mar. 1977; in commerce Mar. 1977.

Owner of U.S. Reg. No. 1,053,241.

Ser. No. 391,301, filed Sep. 28, 1982.

ATIONAL TOPS AND SHORTS, SOCKS,  
WALKING SHOES, BOAT SHOES, AEROBIC DEBORAH S. COHN, Examining Attorney



**Int. Cl.: 10, 25**

**Prior U.S. Cl.: 39, 44**

**United States Patent Office**

**Reg. No. 1,053,241**

**Registered Nov. 23, 1976**

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**TRADEMARK**

**Principal Register**

**NEW BALANCE**

New Balance Athletic Shoe, Inc. (Massachusetts corporation)  
176 Belmont St.  
Watertown, Mass. 02172

For: ARCH SUPPORTS, in CLASS 10 (U.S. CL. 44).  
First use 1972; in commerce 1972.

For: ATHLETIC SHOES, INSOLES, HEEL PADS,  
AND T-SHIRTS in CLASS 25 (U.S. CL. 39).  
First use 1951; in commerce 1951.

Ser. No. 62,763, filed Sept. 11, 1975.

R. E. WOLFINGTON, Examiner

**Int. Cl.: 9**

**Prior U.S. Cls.: 21, 23, 26, 36, and 38**

**Reg. No. 2,863,103**

**United States Patent and Trademark Office**

**Registered July 13, 2004**

**TRADEMARK  
PRINCIPAL REGISTER**

**NEW BALANCE**

NEW BALANCE ATHLETIC SHOE, INC. (MAS-  
SACHUSETTS CORPORATION)  
61 NORTH BEACON STREET  
BOSTON, MA 02134

OWNER OF U.S. REG. NOS. 1,053,241 AND  
1,260,938.

FOR: SUNGLASSES, EYEGLASSES AND EYE-  
GLASS CASES, IN CLASS 9 (U.S. CLS. 21, 23, 26, 36  
AND 38).

SN 76-174,713, FILED 11-29-2000.

FIRST USE 1-1-2004; IN COMMERCE 1-1-2004.

JOHN DWYER, EXAMINING ATTORNEY

**Int. Cls.: 35, 36 and 41**

**Prior U.S. Cls.: 100, 101, 102 and 107**

**United States Patent and Trademark Office**

**Reg. No. 2,690,233**

**Registered Feb. 25, 2003**

**SERVICE MARK  
PRINCIPAL REGISTER**

**NEW BALANCE**

NEW BALANCE ATHLETIC SHOE, INC. (MASSACHUSETTS CORPORATION)  
20 GUEST STREET  
BOSTON, MA 02135

FOR: RETAIL STORE, COMPUTERIZED ONLINE RETAILING AND CATALOG MAIL ORDER SERVICES FEATURING ATHLETIC, SPORTS, EXERCISE AND FITNESS CLOTHING, LUGGAGE AND FOOTWEAR; ARRANGING AND CONDUCTING TRADE SHOW EXHIBITIONS IN THE FIELD OF ATHLETICS, SPORTS, EXERCISE AND FITNESS, IN CLASS 35 (U.S. CLS. 100, 101 AND 102).

FIRST USE 0-0-1972; IN COMMERCE 0-0-1983.

FOR: FINANCIAL SPONSORSHIP OF ATHLETIC TEAMS, FOOTRACE MARATHONS, ATHLETIC EVENTS, ATHLETIC MATCHES AND ATHLETIC TOURNAMENTS, IN CLASS 36 (U.S. CLS. 100, 101 AND 102).

FIRST USE 0-0-1982; IN COMMERCE 0-0-1982.

FOR: PROVIDING INFORMATION IN THE FIELD OF ATHLETICS, SPORTS, EXERCISE AND FITNESS VIA THE INTERNET; EDUCATIONAL SERVICES, NAMELY, PROVIDING INCENTIVES TO AMATEUR ATHLETES TO DEMONSTRATE EXCELLENCE IN THE FIELD OF ATHLETIC COMPETITION THROUGH THE ISSUANCE OF MONETARY AWARDS, IN CLASS 41 (U.S. CLS. 100, 101 AND 107).

FIRST USE 9-13-1995; IN COMMERCE 9-13-1995.

OWNER OF U.S. REG. NOS. 1,053,241, 1,260,938, AND 2,184,990.

SER. NO. 76-332,796, FILED 11-5-2001.

JOHN DWYER, EXAMINING ATTORNEY

**Int. Cls.: 1, 3, and 5**

**Prior U.S. Cls.: 1, 4, 5, 6, 10, 18, 26, 44, 46, 50, 51, and 52**

**United States Patent and Trademark Office** **Reg. No. 2,845,867**  
**Registered May 25, 2004**

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**TRADEMARK  
PRINCIPAL REGISTER**

**NEW BALANCE**

NEW BALANCE ATHLETIC SHOE, INC. (MASSACHUSETTS CORPORATION)  
20 GUEST STREET  
BOSTON, MA 02135

FOR: SHOE WATER REPELLENTS, NAMELY, WATERPROOFING CHEMICAL COMPOUNDS FOR SHOES MADE OF LEATHER, IN CLASS 1 (U.S. CLS. 1, 5, 6, 10, 26 AND 46).

FIRST USE 10-1-2003; IN COMMERCE 10-1-2003.

FOR: CLEANER FOR USE ON SHOES, SHOE CONDITIONER CREAM, AND SHOE POLISH, IN CLASS 3 (U.S. CLS. 1, 4, 6, 50, 51 AND 52).

FIRST USE 10-1-2003; IN COMMERCE 10-1-2003.

FOR: SHOE DEODORIZERS, IN CLASS 5 (U.S. CLS. 6, 18, 44, 46, 51 AND 52).

FIRST USE 10-1-2003; IN COMMERCE 10-1-2003.

OWNER OF U.S. REG. NOS. 1,053,241, 1,260,938, AND 2,184,990.

SN 76-427,639, FILED 7-5-2002.

JOHN DWYER, EXAMINING ATTORNEY

**Int. Cl.: 28**

**Prior U.S. Cls.: 22, 23, 38, and 50**

**Reg. No. 2,955,395**

**United States Patent and Trademark Office**

**Registered May 24, 2005**

**TRADEMARK  
PRINCIPAL REGISTER**

**NEW BALANCE**

NEW BALANCE ATHLETIC SHOE, INC. (MASSACHUSETTS CORPORATION)

20 GUEST STREET

BOSTON, MA 02135

FOR: EXERCISE EQUIPMENT, NAMELY, TREADMILLS, ELLIPTICAL TRAINERS, AND STATIONARY PEDAL OPERATED TRAINING APPA-

RATUS TO PROMOTE HEALTH AND FITNESS, IN CLASS 28 (U.S. CLS. 22, 23, 38 AND 50).

FIRST USE 3-1-2004; IN COMMERCE 3-1-2004.

SN 76-499,093, FILED 3-20-2003.

JILL C. ALT, EXAMINING ATTORNEY

**Int. Cls.: 1, 3, 5, and 26**

**Prior U.S. Cls.: 1, 4, 5, 6, 10, 18, 26, 37, 39, 40, 42, 44,  
46, 50, 51, and 52**

**Reg. No. 2,990,081**

**United States Patent and Trademark Office**

**Registered Aug. 30, 2005**

**TRADEMARK  
PRINCIPAL REGISTER**

**NEW BALANCE**

NEW BALANCE ATHLETIC SHOE, INC. (MAS-  
SACHUSETTS CORPORATION)  
20 GUEST STREET  
BOSTON, MA 02135

FOR: WATER REPELLENT CHEMICAL COMPO-  
SITIONS FOR CLOTHING, FABRIC PROTECTANTS  
FOR CLOTHING, FABRIC PROTECTANTS FOR  
FOOTWEAR, STAIN REPELLENTS FOR CLOTH-  
ING, STAIN REPELLENTS FOR FOOTWEAR, IN  
CLASS 1 (U.S. CLS. 1, 5, 6, 10, 26 AND 46).

FIRST USE 10-1-2003; IN COMMERCE 10-1-2003.

FOR: CLEANING PREPARATIONS FOR USE ON  
CLOTHING, LAUNDRY DETERGENTS, FABRIC  
SOFTENERS FOR DOMESTIC USE, SHOE WHITE-  
NER, SADDLE SOAP, SPOT REMOVER, SHOE CON-  
DITIONER SPRAY, IN CLASS 3 (U.S. CLS. 1, 4, 6, 50,  
51 AND 52).

FIRST USE 10-1-2003; IN COMMERCE 10-1-2003.

FOR: DISINFECTANTS FOR CLOTHING, IN  
CLASS 5 (U.S. CLS. 6, 18, 44, 46, 51 AND 52).

FIRST USE 10-1-2003; IN COMMERCE 10-1-2003.

FOR: SHOE LACES, IN CLASS 26 (U.S. CLS. 37, 39,  
40, 42 AND 50).

FIRST USE 10-1-2003; IN COMMERCE 10-1-2003.

OWNER OF U.S. REG. NOS. 1,053,241, 2,845,867,  
AND OTHERS.

SN 76-529,114, FILED 7-2-2003.

JOHN HWANG, EXAMINING ATTORNEY

**Int. Cls.: 9, 10, and 14**

**Prior U.S. Cls.: 2, 21, 23, 26, 27, 28, 36, 38, 39, 44, and 50**

**United States Patent and Trademark Office**

**Reg. No. 3,595,487**

**Registered Mar. 24, 2009**

**TRADEMARK  
PRINCIPAL REGISTER**

**NEW BALANCE**

NEW BALANCE ATHLETIC SHOE, INC. (MASSACHUSETTS CORPORATION)  
20 GUEST STREET, 8TH FLOOR  
BOSTON, MA 02135

FOR: WATCHES, STOP WATCHES, CHRONOGRAPHS FOR USE AS WATCHES, WATCHES FOR OUTDOOR USE, IN CLASS 14 (U.S. CLS. 2, 27, 28 AND 50).

FOR: PEDOMETERS, IN CLASS 9 (U.S. CLS. 21, 23, 26, 36 AND 38).

FIRST USE 5-1-2007; IN COMMERCE 5-1-2007.

FIRST USE 5-1-2007; IN COMMERCE 5-1-2007.

THE MARK CONSISTS OF STANDARD CHARACTERS WITHOUT CLAIM TO ANY PARTICULAR FONT, STYLE, SIZE, OR COLOR.

FOR: BLOOD PRESSURE MONITORS, HEART MONITORS TO BE WORN DURING EXERCISE, SPORT MONITORS, PULSE RATE MONITORS, IN CLASS 10 (U.S. CLS. 26, 39 AND 44).

SN 77-170,081, FILED 5-1-2007.

FIRST USE 5-1-2007; IN COMMERCE 5-1-2007.

JULIE GUTTADAURO, EXAMINING ATTORNEY



**Exhibit B**

# United States of America

## United States Patent and Trademark Office

### BALANCE ATHLETICA

**Reg. No. 5,676,182**

**Registered Feb. 12, 2019**

**Int. Cl.: 25**

**Trademark**

**Principal Register**

BALANCE ATHLETICA L.L.C. (INDIANA LIMITED LIABILITY COMPANY)  
1738 Lowell Blvd  
Denver, COLORADO 80204

CLASS 25: apparel, namely, swimwear, t-shirts, shirts, tank tops, sweatshirts, sweaters, pants, bottoms, leggings, leg warmers, tights, sweatpants, shorts, dresses, jackets, coats, vests, underwear, socks, warm-up suits, bodysuits, leotards; headwear, namely, hats, caps, visors, headbands; clothing accessories, namely, belts, scarves, shawls, shoulder wraps, arm warmers, gloves

FIRST USE 7-27-2018; IN COMMERCE 8-13-2018

THE MARK CONSISTS OF STANDARD CHARACTERS WITHOUT CLAIM TO ANY PARTICULAR FONT STYLE, SIZE OR COLOR

SER. NO. 87-640,959, FILED 10-11-2017



*Andrei Iancu*

Director of the United States  
Patent and Trademark Office

# CIVIL COVER SHEET

The JS 44 civil cover sheet and the information contained herein neither replace nor supplement the filing and service of pleadings or other papers as required by law, except as provided by local rules of court. This form, approved by the Judicial Conference of the United States in September 1974, is required for the use of the Clerk of Court for the purpose of initiating the civil docket sheet. (SEE INSTRUCTIONS ON NEXT PAGE OF THIS FORM.)

## I. (a) PLAINTIFFS

NEW BALANCE ATHLETICS, INC.

(b) County of Residence of First Listed Plaintiff SUFFOLK, MA  
(EXCEPT IN U.S. PLAINTIFF CASES)

(c) Attorneys (Firm Name, Address, and Telephone Number)

ORRICK, HERRINGTON & SUTCLIFFE LLP (617) 880 1800  
222 BERKELEY STREET, SUITE 200, BOSTON MA 02116

## DEFENDANTS

BALANCE ATHLETICA, LLC

County of Residence of First Listed Defendant DENVER, CO  
(IN U.S. PLAINTIFF CASES ONLY)

NOTE: IN LAND CONDEMNATION CASES, USE THE LOCATION OF THE TRACT OF LAND INVOLVED.

Attorneys (If Known)

## II. BASIS OF JURISDICTION (Place an "X" in One Box Only)

- ☐ 1 U.S. Government Plaintiff
- ☒ 3 Federal Question (U.S. Government Not a Party)
- ☐ 2 U.S. Government Defendant
- ☐ 4 Diversity (Indicate Citizenship of Parties in Item III)

## III. CITIZENSHIP OF PRINCIPAL PARTIES (Place an "X" in One Box for Plaintiff and One Box for Defendant)

- |   | PTF                        | DEF                        |   | PTF                        | DEF                        |
|---|----------------------------|----------------------------|---|----------------------------|----------------------------|
| Citizen of This State                   | <input type="checkbox"/> 1 | <input type="checkbox"/> 1 | Incorporated or Principal Place of Business In This State     | <input type="checkbox"/> 4 | <input type="checkbox"/> 4 |
| Citizen of Another State                | <input type="checkbox"/> 2 | <input type="checkbox"/> 2 | Incorporated and Principal Place of Business In Another State | <input type="checkbox"/> 5 | <input type="checkbox"/> 5 |
| Citizen or Subject of a Foreign Country | <input type="checkbox"/> 3 | <input type="checkbox"/> 3 | Foreign Nation  | <input type="checkbox"/> 6 | <input type="checkbox"/> 6 |

## IV. NATURE OF SUIT (Place an "X" in One Box Only)

Click here for: [Nature of Suit Code Descriptions.](#)

CONTRACT	TORTS	FORFEITURE/PENALTY	BANKRUPTCY	OTHER STATUTES
<input type="checkbox"/> 110 Insurance <input type="checkbox"/> 120 Marine <input type="checkbox"/> 130 Miller Act <input type="checkbox"/> 140 Negotiable Instrument <input type="checkbox"/> 150 Recovery of Overpayment & Enforcement of Judgment <input type="checkbox"/> 151 Medicare Act <input type="checkbox"/> 152 Recovery of Defaulted Student Loans (Excludes Veterans) <input type="checkbox"/> 153 Recovery of Overpayment of Veteran's Benefits <input type="checkbox"/> 160 Stockholders' Suits <input type="checkbox"/> 190 Other Contract <input type="checkbox"/> 195 Contract Product Liability <input type="checkbox"/> 196 Franchise	<b>PERSONAL INJURY</b> <input type="checkbox"/> 310 Airplane <input type="checkbox"/> 315 Airplane Product Liability <input type="checkbox"/> 320 Assault, Libel & Slander <input type="checkbox"/> 330 Federal Employers' Liability <input type="checkbox"/> 340 Marine <input type="checkbox"/> 345 Marine Product Liability <input type="checkbox"/> 350 Motor Vehicle <input type="checkbox"/> 355 Motor Vehicle Product Liability <input type="checkbox"/> 360 Other Personal Injury <input type="checkbox"/> 362 Personal Injury - Medical Malpractice	<input type="checkbox"/> 625 Drug Related Seizure of Property 21 USC 881 <input type="checkbox"/> 690 Other	<input type="checkbox"/> 422 Appeal 28 USC 158 <input type="checkbox"/> 423 Withdrawal 28 USC 157 <b>PROPERTY RIGHTS</b> <input type="checkbox"/> 820 Copyrights <input type="checkbox"/> 830 Patent <input type="checkbox"/> 835 Patent - Abbreviated New Drug Application <input checked="" type="checkbox"/> 840 Trademark	<input type="checkbox"/> 375 False Claims Act <input type="checkbox"/> 376 Qui Tam (31 USC 3729(a)) <input type="checkbox"/> 400 State Reapportionment <input type="checkbox"/> 410 Antitrust <input type="checkbox"/> 430 Banks and Banking <input type="checkbox"/> 450 Commerce <input type="checkbox"/> 460 Deportation <input type="checkbox"/> 470 Racketeer Influenced and Corrupt Organizations <input type="checkbox"/> 480 Consumer Credit <input type="checkbox"/> 490 Cable/Sat TV <input type="checkbox"/> 850 Securities/Commodities/Exchange <input type="checkbox"/> 890 Other Statutory Actions <input type="checkbox"/> 891 Agricultural Acts <input type="checkbox"/> 893 Environmental Matters <input type="checkbox"/> 895 Freedom of Information Act
<b>REAL PROPERTY</b> <input type="checkbox"/> 210 Land Condemnation <input type="checkbox"/> 220 Foreclosure <input type="checkbox"/> 230 Rent Lease & Ejectment <input type="checkbox"/> 240 Torts to Land <input type="checkbox"/> 245 Tort Product Liability <input type="checkbox"/> 290 All Other Real Property	<b>CIVIL RIGHTS</b> <input type="checkbox"/> 440 Other Civil Rights <input type="checkbox"/> 441 Voting <input type="checkbox"/> 442 Employment <input type="checkbox"/> 443 Housing/Accommodations <input type="checkbox"/> 445 Amer. w/Disabilities - Employment <input type="checkbox"/> 446 Amer. w/Disabilities - Other <input type="checkbox"/> 448 Education	<b>PRISONER PETITIONS</b> <b>Habeas Corpus:</b> <input type="checkbox"/> 463 Alien Detainee <input type="checkbox"/> 510 Motions to Vacate Sentence <input type="checkbox"/> 530 General <input type="checkbox"/> 535 Death Penalty <b>Other:</b> <input type="checkbox"/> 540 Mandamus & Other <input type="checkbox"/> 550 Civil Rights <input type="checkbox"/> 555 Prison Condition <input type="checkbox"/> 560 Civil Detainee - Conditions of Confinement	<b>LABOR</b> <input type="checkbox"/> 710 Fair Labor Standards Act <input type="checkbox"/> 720 Labor/Management Relations <input type="checkbox"/> 740 Railway Labor Act <input type="checkbox"/> 751 Family and Medical Leave Act <input type="checkbox"/> 790 Other Labor Litigation <input type="checkbox"/> 791 Employee Retirement Income Security Act	<b>SOCIAL SECURITY</b> <input type="checkbox"/> 861 HIA (1395ff) <input type="checkbox"/> 862 Black Lung (923) <input type="checkbox"/> 863 DIWC/DIWW (405(g)) <input type="checkbox"/> 864 SSDI Title XVI <input type="checkbox"/> 865 RSI (405(g))
		<b>IMMIGRATION</b> <input type="checkbox"/> 462 Naturalization Application <input type="checkbox"/> 465 Other Immigration Actions	<b>FEDERAL TAX SUITS</b> <input type="checkbox"/> 870 Taxes (U.S. Plaintiff or Defendant) <input type="checkbox"/> 871 IRS—Third Party 26 USC 7609	<input type="checkbox"/> 896 Arbitration <input type="checkbox"/> 899 Administrative Procedure Act/Review or Appeal of Agency Decision <input type="checkbox"/> 950 Constitutionality of State Statutes

## V. ORIGIN (Place an "X" in One Box Only)

- ☒ 1 Original Proceeding
- ☐ 2 Removed from State Court
- ☐ 3 Remanded from Appellate Court
- ☐ 4 Reinstated or Reopened
- ☐ 5 Transferred from Another District (specify)
- ☐ 6 Multidistrict Litigation - Transfer
- ☐ 8 Multidistrict Litigation - Direct File

## VI. CAUSE OF ACTION

Cite the U.S. Civil Statute under which you are filing (Do not cite jurisdictional statutes unless diversity):

15 U.S.C. § 1114 et. seq.

Brief description of cause:

TRADEMARK INFRINGEMENT, FALSE DESIGNATION OF ORIGIN, DILUTION, CANCELLATION

## VII. REQUESTED IN COMPLAINT:

- ☐ CHECK IF THIS IS A CLASS ACTION UNDER RULE 23, F.R.Cv.P.
- DEMAND \$ Exceeds \$75,000
- CHECK YES only if demanded in complaint:  
JURY DEMAND: ☒ Yes ☐ No

## VIII. RELATED CASE(S) IF ANY

(See instructions):

JUDGE

DOCKET NUMBER

DATE

SIGNATURE OF ATTORNEY OF RECORD

11/13/2020

/s/ Mark S. Puzella

FOR OFFICE USE ONLY

RECEIPT #

AMOUNT

APPLYING IFP

JUDGE

MAG. JUDGE

UNITED STATES DISTRICT COURT  
DISTRICT OF MASSACHUSETTS1. Title of case (name of first party on each side only) NEW BALANCE ATHLETICS, INC. v. BALANCE ATHLETICA, LLC

2. Category in which the case belongs based upon the numbered nature of suit code listed on the civil cover sheet. (See local rule 40.1(a)(1)).

☐

I. 160, 400, 410, 441, 535, 830\*, 835\*, 850, 891, 893, R.23, REGARDLESS OF NATURE OF SUIT.

☒

II. 110, 130, 190, 196, 370, 375, 376, 440, 442, 443, 445, 446, 448, 470, 751, 820\*, 840\*, 895, 896, 899.

☐

III. 120, 140, 150, 151, 152, 153, 195, 210, 220, 230, 240, 245, 290, 310, 315, 320, 330, 340, 345, 350, 355, 360, 362, 365, 367, 368, 371, 380, 385, 422, 423, 430, 450, 460, 462, 463, 465, 480, 490, 510, 530, 540, 550, 555, 560, 625, 690, 710, 720, 740, 790, 791, 861-865, 870, 871, 890, 950.

\*Also complete AO 120 or AO 121. for patent, trademark or copyright cases.

3. Title and number, if any, of related cases. (See local rule 40.1(g)). If more than one prior related case has been filed in this district please indicate the title and number of the first filed case in this court.

NOT APPLICABLE.

4. Has a prior action between the same parties and based on the same claim ever been filed in this court?

YES

☐

NO

☒

5. Does the complaint in this case question the constitutionality of an act of congress affecting the public interest? (See 28 USC §2403)

YES

☐

NO

☒

If so, is the U.S.A. or an officer, agent or employee of the U.S. a party?

YES

☐

NO

☒

6. Is this case required to be heard and determined by a district court of three judges pursuant to title 28 USC §2284?

YES

☐

NO

☒7. Do all of the parties in this action, excluding governmental agencies of the United States and the Commonwealth of Massachusetts ("governmental agencies"), residing in Massachusetts reside in the same division? - (See Local Rule 40.1(d)).

YES

☒

NO

☐A. If yes, in which division do all of the non-governmental parties reside?

Eastern Division

☒

Central Division

☐

Western Division

☐

B. If no, in which division do the majority of the plaintiffs or the only parties, excluding governmental agencies, residing in Massachusetts reside?

Eastern Division

☐

Central Division

☐

Western Division

☐

8. If filing a Notice of Removal - are there any motions pending in the state court requiring the attention of this Court? (If yes, submit a separate sheet identifying the motions)

YES

☐

NO

☐

(PLEASE TYPE OR PRINT)

ATTORNEY'S NAME MARK S. PUZELLAADDRESS 222 BERKELEY STREET, SUITE 2000, BOSTON, MA 02116TELEPHONE NO. (617) 880-1896