UNITED STATES DISTRICT COURT
EASTERN DISTRICT OF NEW YORK

VANS, INC. and VF OUTDOOR, LLC, Plaintiffs, v. MSCHF PRODUCT STUDIO, INC., Defendant.	Case No. 22-cv-02156-WFM-RML JURY TRIAL DEMANDED

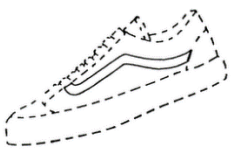
[PROPOSED] TEMPORARY RESTRAINING ORDER AND ORDER TO SHOW CAUSE FOR PRELIMINARY INJUNCTION

The Court, having considered the facts set forth in the Complaint, the Memorandum of Law in Support of Plaintiffs Vans, Inc. and VF Outdoor, LLC's ("Vans" or "Plaintiffs") Motion for a Temporary Restraining Order and Order to Show Cause for Preliminary Injunction, and the supporting declarations and all other evidence filed therewith; and

This matter having come before the Court on Vans' Motion for a temporary restraining order ("TRO") and preliminary injunction pursuant to the Lanham Act, 15 U.S.C. § 1125, and Rule 65 of the Federal Rules of Civil Procedure; and

The Court having found from the specific facts set forth in the above-mentioned materials sufficient proof that:

1. Vans is the owner of the incontestable and famous "Side Stripe Mark," as embodied in exemplary U.S. Registration No. 2,177,772:



2. Vans is also the owner of the famous Old Skool shoe trade dress (the "OLD SKOOL Dress," and together with the Side Stripe Mark, the "Asserted Marks"), comprising: (1)

the Vans Side Stripe Mark on the shoe upper; (2) a rubberized sidewall with a consistent height around the perimeter of the shoe; (3) the uppermost portion of the sidewall having a three-tiered or grooved appearance; (4) a textured toe box outer around the front of the sidewall; (5) visible stitching, including where the eyestay meets the vamp; and (6) the placement and proportion of these elements in relation to one another, as shown in this representative image:

3. Defendant MSCHF Product Studio, Inc. ("MSCHF" or "Defendant") has announced plans to release a line of "Wavy Baby" Shoes (the "Accused Shoes"), shown in the below representative image, on April 18, 2022, at 12 p.m. EST:

4. Vans has a strong likelihood of success on its federal, state, and common law trademark infringement, false designation of origin, unfair competition, and dilution claims. MSCHF's promotion, offer for sale, and sale of the Accused Shoes is likely to confuse consumers about the origin, source, sponsorship, or approval of MSCHF's goods, diluting the ability of Vans' Asserted Marks to identify Vans' goods, and tarnishing Vans' famous Marks;

5. MSCHF's threatened release of the Accused Shoes poses a clear and substantial threat of irreparable harm to Vans because (a) Vans will lose its ability to control its reputation embodied by and associated with its marks, including the Asserted Marks; (b) the value of Vans' marks as exclusively designating Vans will be impaired by MSCHF's actions; (c) the value of Vans' marks will be diminished by association with MSCHF and its construction of the Accused Shoes in a manner that is less safe than Vans' standards of quality; and (d) Vans has no adequate remedy at law. Issuance of the requested temporary restraining order is also in the public interest to protect the public against confusion, deception, and mistake;

6. The harm to Vans in denying a temporary restraining order outweighs the harm to MSCHF in granting it; and

7. A temporary restraining order is necessary to achieve the purpose of 15 U.S.C. § 1114, 1125(a), and 1125(c), to protect the public from confusion and mistake, and to protect Vans from immediate irreparable injury. No other order is adequate to achieve this purpose.

TEMPORARY RESTRAINING ORDER

IT IS HEREBY ORDERED THAT, pending the hearing and determination of Plaintiffs' motion for a preliminary injunction, Defendant MSCHF Product Studio, Inc. ("MSCHF" or "Defendant"), and any companies owned or controlled by MSCHF, and each of its officers, agents, privies, principals, directors, shareholders, managing agents, owners, licensees, distributors, servants, attorneys, employees, affiliates, subsidiaries, parents, successors, and assigns, all of those in active concert or participation with any of them who receive notice directly or otherwise, are hereby enjoined from:

a. releasing for sale to the public any of the "Wavy Baby" shoes, or any colorful imitations or reconstructions thereof (the "Prohibited Shoes");

b. fulfilling orders for any of the Prohibited Shoes;

c. using Vans' OLD Skool Dress or Side Stripe Mark, or any mark that is confusingly similar to those marks and trade dress, or is a derivation or colorable imitation or recreation thereof, regardless of whether used alone or with other terms or elements (collectively, the "Prohibited Marks")

d. referring to or using any Prohibited Marks in any advertising, marketing, or promotion; and,

e. instructing, assisting, aiding, or abetting any other person or business entity in engaging in or performing any of the activities referred to in the above subparagraphs, or taking any action that contributes to any of the activities referred to in the above subparagraphs.

ORDER TO SHOW CAUSE FOR PRELIMINARY INJUNCTION

IT IS FURTHER ORDERED THAT, Defendant MSCHF Product Studio, Inc. appear before this Court on _____, 2022, at the time of _____, to show cause, if any there be, why, pursuant to Rule 65 of the Federal Rules of Civil Procedure, Plaintiffs should not be granted a preliminary injunction extending the terms of the temporary restraining order granted herein and further ordering that:

(1) during the pendency of this action, MSCHF and its officers, agents, employees, attorneys, and all other persons who are in active concert or participation with MSCHF are prohibited from releasing for sale to the public and/or fulfilling orders for the "Wavy Baby" shoes and/or colorable imitations or reconstructions thereof (the "Prohibited Shoes");

(2) during the pendency of this action, MSCHF and its officers, agents, employees, attorneys, and all other persons who are in active concert or participation with MSCHF are prohibited from promoting, offering to sell, selling, and/or taking orders for the Prohibited Shoes;

(3) MSCHF must escrow any funds received from all orders taken to date for the Prohibited Shoes so that, if Vans prevails in this action, MSCHF may return those funds to customers who ordered MSCHF's Prohibited Shoes under the mistaken belief that Vans was the source of the shoes or otherwise approved or sponsored the shoes; and

(4) MSCHF must file with the Court within thirty (30) days after entry of the injunction a report in writing under oath setting forth in detail the manner and form in which MSCHF has complied with the injunction.

SERVICE

IT IS FURTHER ORDERED THAT delivery or transmission of this Motion and all supporting papers to Defendant MSCHF Product Studio, Inc. or Defendant's counsel by email or hand delivery be made on _____, 2022 by 5:00 p.m., and shall be deemed sufficient service on MSCHF.

IT IS FURTHER ORDERED THAT opposing papers, if any, shall be served by email or ECF on Plaintiffs' counsel on or before _____, 2022 at 5:00 p.m., and reply papers, if any, shall be served by electronic mail or ECF on Defendant or its counsel on or before _____, 2022 at 5:00 p.m.

Defendant is hereby put on notice that failure to attend the show cause hearing scheduled herein shall result in the immediate issuance of a preliminary injunction, which shall be deemed to take effect immediately upon the expiration or dissolution of the temporary restraining order herein, and shall extend during the pendency of this suit the injunctive relief provided in this Order. Defendant is hereby further notified that Defendant shall be deemed to have actual notice of the terms and issuance of such preliminary injunction, and that any act by Defendant in violation of any of its terms may be considered and prosecuted as contempt of the Court.

BOND

IT IS FURTHER ORDERED THAT, pursuant to Rule 65(c) of the Federal Rules of Civil Procedure, Plaintiffs shall give security in the sum of [TEN THOUSAND DOLLARS ($10,000.00)], on or before April ___, 2022.

Dated: _____, 2022

_____
United States District Judge

UNITED STATES DISTRICT COURT
EASTERN DISTRICT OF NEW YORK

VANS, INC. and VF OUTDOOR, LLC, Plaintiffs, v. MSCHF PRODUCT STUDIO, INC., Defendant.	Case No. 22cv02156 JURY TRIAL DEMANDED

PLAINTIFFS VANS, INC. AND VF OUTDOOR, LLC'S MEMORANDUM OF LAW IN SUPPORT OF THEIR MOTION FOR A TEMPORARY RESTRAINING ORDER & PRELIMINARY INJUNCTION

TABLE OF CONTENTS

TABLE OF AUTHORITIES

Page(s)

Cases

Statutes

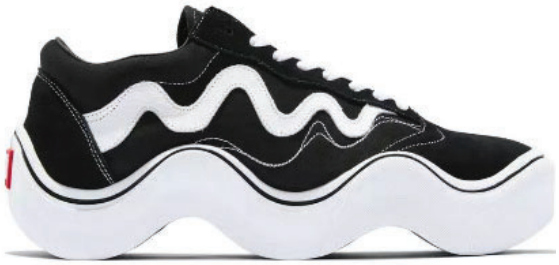
Other Authorities

I. INTRODUCTION

Plaintiffs Vans, Inc. and VF Outdoor, LLC (collectively, "Vans") bring this motion for a temporary restraining order and a preliminary injunction to prevent the imminent release by Defendant MSCHF Product Studio, Inc. ("MSCHF") of its WAVY BABY shoes (the "Infringing Shoes"), which purposefully imitate the famous and well-recognized OLD SKOOL trade dress while also incorporating numerous other Vans trademarks and indicia of source. Having already generated significant media attention by collaborating with the rapper Tyga, MSCHF has indicated that it intends to release the shoes to the public on Monday, April 18, 2022, at 12:00 p.m. EST. Vans therefore respectfully requests that its application for a temporary restraining order be heard, and an order entered, before that date and time, or that an order issue enjoining the release of the Infringing Shoes until the Court can hear arguments on the restraining order. Given that the release is likely to sell out very quickly, likely long before a preliminary injunction could be granted, immediate relief is the only option that will avoid irreparable harm to Vans.

That MSCHF has purposefully imitated the Vans' branding in its entirety is obvious from a side-by-side comparison of the relevant Vans branding, trademarks and OLD SKOOL trade dress with the Infringing Shoes (*see* Decl. of Tanya L. Greene ("Greene Decl."), Ex. 1):

Vans' Trademarks/Trade Dress	WAVY BABY Design
	







Nor does the "wavy" nature of the Infringing Shoes obviate the likelihood of confusion. Vans itself is known for customized versions of its shoes that retain its core OLD SKOOL trade dress. Vans also routinely collaborates with artists on unique or artistic versions of its OLD SKOOL and other iconic shoe lines. Vans itself playfully "skews" its own branding by placing a crooked version of the classic VANS logo on the footbed of its shoes, and both uses and has applied to register the trademark WAYVEE in connection with footwear. Any consumer encountering MSCHF's shoe is therefore likely to believe that MSCHF is collaborating with Vans. Furthermore, Vans' ability to partner with artists to create unique limited editions is likely to be permanently damaged if MSCHF is permitted to usurp this right.

MSCHF's intent in adopting virtually every feature of the OLD SKOOL trade dress and Vans' branding is clearly to capitalize on Vans' fame and goodwill. Since the 1970s, Vans has invested tens of millions of dollars in advertising and promoting its famous shoes lines and trademarks, including its OLD SKOOL shoes, which feature and are sold in connection with a distinctive trade dress (the "OLD SKOOL Trade Dress"), the Vans' "jazz stripe" trademark (the "Side Stripe Mark"), the VANS "Flying-V" Mark ("Flying-V Mark"), the VANS OFF THE WALL Mark and trade dress ("OFF THE WALL Mark"), the waffle sole mark ("Waffle Sole"), the Vans footbed logo ("Footbed Logo"), and the Vans' shoe box trade dress ("Vans Packaging") (collectively, the "Asserted Marks"). Vans' continuous and prominent use and advertisement of the Asserted Marks has generated billions of dollars of revenue from sales of millions of pairs of shoes, including over a billion dollars in revenue each year for the past few years for sales of the OLD SKOOL shoes in the United States, alone. The Asserted Marks, and the OLD SKOOL shoes embodying those marks, have also earned unsolicited recognition for their fame and popularity, becoming one of the most popular and recognizable shoes in the

United States and across the globe. And Vans has built on the fame and notoriety of its brand through key collaborations with celebrities, including the Foo Fighters, Metallica, and A$AP Rocky, to release limited-edition designs of its famous shoes.

Despite Vans' well-established rights in its famous OLD SKOOL Trade Dress and the Side Stripe Mark, MSCHF has announced its intent to release the Infringing Shoes, which intentionally copy the OLD SKOOL Trade Dress and merely alter the Dress to give the shoe a warped, or "wavy," appearance. Indeed, as shown above, a visual comparison of the Infringing Shoes and the OLD SKOOL Trade Dress demonstrates that there is no significant difference between the shoes other than the wavy appearance. But MSCHF did not stop there, copying not only the OLD SKOOL Trade Dress, but also the Waffle Sole, Footbed Logo, and Vans Packaging. There is therefore no doubt that the Infringing Shoes are intended to indicate to consumers that the Infringing Shoes are manufactured, sponsored, or otherwise endorsed by Vans, when they are not, creating a significant likelihood of consumer confusion and diluting the value of Vans' famous OLD SKOOL Trade Dress and Side Stripe Mark.

Vans will be irreparably harmed if MSCHF is not enjoined from releasing the Infringing Shoes during the pendency of this litigation. Not only will the Infringing Shoes cause consumer confusion, their release will also deprive Vans of its right to control the quality and distinctiveness of its shoes and the manner and timing of their release, causing irreparable harm to Vans' name and brand. By contrast, because it has not yet released its Infringing Shoes, MSCHF will suffer little, if any, harm from a preliminary injunction. Considering the likelihood that Vans will succeed on the merits of its claims, the harm to Vans' if no injunction is granted, and the balance of equities and public interest—as set forth more fully below—the Court should enjoin further unlawful conduct by MSCHF and grant Vans' requested relief.

II. FACTUAL BACKGROUND

A. Vans and Its Intellectual Property Rights

Founded in 1966, Vans is an industry-leading shoe and apparel company, which is known for its original, authentic, and distinctive footwear and apparel that embody Southern California counterculture. *See* Decl. of Kia Wimmer ("Wimmer Decl.") ¶ 5. Since the 1970s and 1980s, Vans has been developing, promoting, and selling some of its most iconic shoe lines, including its OLD SKOOL shoes. Decl. of Rian Pozzebon ("Pozzebon Decl.") ¶¶ 6, 10, 12, 15.

Vans has continuously promoted and sold its OLD SKOOL shoes for over four decades. *Id.* ¶ 12. Vans distributes its iconic footwear through a carefully selected, global network of distribution channels, including major department stores and retailers; sporting goods and outdoor retailers; Vans' own 450+ retail stores throughout the United States; and via online sales on Vans' own website (www.vans.com). Decl. of Daniel Callahan ("Callahan Decl.") ¶ 11.

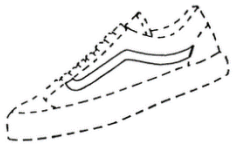
Vans' shoes, including the OLD SKOOL shoes, are now some of the most popular footwear in the United States. For each of the past several years, an independent third-party survey called "Taking Stock with Teens" has consistently found that Vans is the No. 2 overall favorite footwear brand among U.S. teens. According to the survey, Vans trails only Nike in popularity among teens. *Id.* ¶ 9, Ex. 1. This popularity has also been reflected in Vans' sales. For each of the past few years, Vans' annual sales in the U.S. have surpassed $1 billion for the OLD SKOOL shoes, alone. *Id.* ¶ 7.

Vans' success has been driven by factors such as its focus on just a few iconic shoe lines, its reputation for creating lasting and durable footwear without sacrificing style, and its longstanding and consistent use of its trademark and trade dress rights, including its rights with

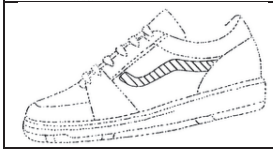
respect to the Asserted Marks and its other relevant intellectual property, as detailed below. Wimmer Decl. ¶ 7-27; Callahan Decl. ¶ 15.

1. Vans' Side Stripe Trademark

In the 1970s, Vans began using its now-iconic "jazz stripe," which adorns the side panel of its OLD SKOOL shoes, as well as many other shoes sold by Vans (the "Side Stripe Mark"). *See* Pozzebon Decl. ¶ 5-6. Since then, Vans has continuously manufactured, promoted, and sold footwear using the Side Stripe Mark. *Id.* As displayed on the OLD SKOOL Trade Dress, Vans owns all right, title, and interest in the following Side Stripe Marks:

Trademark	U.S. Reg. No.	Reg. Date	Relevant Goods/Services
	2,177,772	August 4, 1998	***Class 25***: Footwear
	4,442,122	December 3, 2013	***Class 25***: Clothing

Wimmer Decl. ¶ 8. Vans also owns all right, title, and interest in the following Side Stripe Marks for other shoe lines:

Trademark	U.S. Reg. No.	Reg. Date	Relevant Goods/Services
	2,170,961	July 7, 1998	***Class 25***: Footwear
	2,172,482	July 14, 1998	***Class 25***: Footwear

Id. Pursuant to Sections 8 and 15 of the Lanham Act, each of these registrations is incontestable. *Id.* ¶¶ 9-10; Exs. 1-4.

Since placing the Side Stripe Mark on shoes, including the OLD SKOOL, Vans has sold hundreds of millions of shoes bearing the Side Stripe Mark in the U.S. alone. Callahan Decl. ¶ 7. In is lifetime, Vans has generated well over $10 billion in revenue based solely on U.S. sales of footwear with the Side Stripe Mark. *See id.* Moreover, for each of the past few years, Vans generated over $1 billion per year based on U.S. sales of such shoes. *Id.*

Over the years, Vans has spent tens of millions promoting the Side Stripe Mark. Declaration of Justin Regan ("Regan Decl.") ¶ 14. Vans advertises and promotes footwear bearing the Side Stripe Mark through a wide variety of traditional and non-traditional means, including print, television, and internet advertising, event sponsorship, and athlete endorsement, to name a few. *Id.* ¶¶ 13-18. Vans has also collaborated with celebrities to develop and sell limited-edition releases of shoes featuring the Side Stripe Mark, including collaborations with artists such as Tyler, the Creator, Public Enemy, and Metallica. *Id.* ¶ 24. As a result of Vans' efforts, the public recognizes and understands that the Side Stripe Mark distinguishes and uniquely identifies Vans' products, including the OLD SKOOL shoes, as evidenced by the significant unsolicited news coverage referring to the "famous" and "iconic" nature of the mark. *Id.* ¶ 18; Ex. 1.

2. Vans' OLD SKOOL Trade Dress

In 1977, Vans introduced its iconic low-top skate shoe known as the "OLD SKOOL." Pozzebon Decl. ¶ 5. Debuting under the name "Style 36," the OLD SKOOL was one of the first Vans shoes to feature the Side Stripe Mark. *Id.*

Vans owns the OLD SKOOL Trade Dress, which comprises a distinctive combination of source-identifying elements, including: (1) the Vans Side Stripe Mark on the shoe upper; (2) a rubberized sidewall with a consistent height around the perimeter of the shoe; (3) the uppermost

portion of the sidewall having a three-tiered or grooved appearance; (4) a textured toe box outer around the front of the sidewall; (5) visible stitching, including where the eyestay meets the vamp; and (6) the placement and proportion of these elements in relation to one another. Wimmer Decl. ¶ 12; Pozzebon Decl. ¶ 7.

Vans OLD SKOOL

Since first launching the OLD SKOOL, Vans has continuously manufactured, promoted, and sold shoes bearing the OLD SKOOL Trade Dress. Pozzebon Decl. ¶ 6. Vans has manufactured, promoted, and sold well over 1,000 colorways (including numerous high-profile collaborations) within the OLD SKOOL shoe line. *Id.* ¶ 12.

Due to Vans' significant investments and efforts, Vans has sold over 200 million pairs of OLD SKOOL shoes in the U.S. Callahan Decl. ¶ 7. In its lifetime, Vans has generated over $10 billion in revenue based solely on U.S. sales of OLD SKOOL shoes. *Id.* Moreover, for each of the past few years, Vans generated over $1 billion per year based on U.S. sales of such shoes. *Id.* Vans has also spent tens of millions of dollars promoting its OLD SKOOL Trade Dress. Regan Decl. ¶ 20. And Vans advertises and promotes footwear bearing the OLD SKOOL Trade Dress through a wide variety of traditional and non-traditional means, as outlined in the Declaration of Justin Regan. *Id.* ¶¶ 20-26; Exs. 2-7.

Over the 40 years since the introduction of the OLD SKOOL shoe, the OLD SKOOL Trade Dress remains immensely popular and continues to grow in popularity. Vans shoes bearing the OLD SKOOL Trade Dress are routinely worn and popularized by athletes, pop stars, rappers, artists, and other influential celebrities, including Frank Ocean, Justin Bieber, Kanye, A$AP Rocky, Tyler, the Creator, Russell Westbrook, Julia Roberts, Paul Walker, Gwen Stefani, Miguel, Olivia Wilde, Kylie Jenner, and Kristen Stewart. Regan Decl. ¶ 24.

Similarly, third-party news organizations comment on the popularity and distinctiveness of the OLD SKOOL Trade Dress. By way of example, a 2018 article in *W Magazine* named the OLD SKOOL as the "most popular shoe of the summer," and *Business Insider* observed that the OLD SKOOL was "blowing up the fashion world" and had "surpassed its humble roots to become an icon in its own right." *Id.* ¶¶ 22; Exs. 4-5.

The OLD SKOOL shoe is one of the most sought-after sneakers in the world. In 2017, online fashion website *Lyst* found the OLD SKOOL shoe was the No. 4 most searched sneaker in the world. *Id.* ¶ 23; Ex. 6. And according to a 2019 research study by SEMrush, Vans' OLD SKOOL was the No. 3 most popular sneaker search on Google in the U.S. within the previous 12 months. *Id.* ¶ 23; Ex. 7.

As a result of Vans' extensive use and promotion of the OLD SKOOL Trade Dress, Vans built up and now owns tremendous and valuable goodwill symbolized by the trade dress. Wimmer Decl. ¶ 13; Pozzebon Decl. ¶ 13. Vans' OLD SKOOL Trade Dress is distinctive and non-functional, and it has achieved significant secondary meaning. Pozzebon Decl. ¶ 13. Indeed, multiple consumer surveys, including a survey conducted by Vans, have demonstrated that the OLD SKOOL Trade Dress has secondary meaning as a source identifier for Vans. Wimmer Decl. ¶ 14; Ex. 5.

3. Vans' Additional Intellectual Property Pertinent to Consumer Confusion.

In addition to the Side Stripe Mark and OLD SKOOL Trade Dress, since 1977, Vans has used and owns all rights in the following trademarks that are featured on the OLD SKOOL shoe (the "OFF THE WALL Mark"):

Trademark	U.S. Reg. No.	Reg. Date	Relevant Goods/Services
	6,309,462	March 30, 2021	***Class 25***: Footwear
	6,309,463	March 30, 2021	***Class 25***: Footwear

Wimmer Decl. ¶ 15.

Since the 1970s, Vans has continuously manufactured, promoted, and sold shoes featuring the OFF THE WALL Mark, including the OLD SKOOL shoe. Pozzebon Decl. ¶¶ 6, 15. In that period, Vans has sold millions of shoes bearing the OFF THE WALL Mark in the U.S. alone. Callahan Decl. ¶ 7. Vans has generated well over $10 billion in revenue on sales of footwear featuring the OFF THE WALL Mark, including over $1 billion in U.S. sales revenue for such shoes each year for the past few years. *Id.* ¶¶ 7-8. Vans has also spent millions promoting the OFF THE WALL Mark through traditional and non-traditional means. Regan Decl. ¶¶ 27-28. As a result of Vans' efforts, the public recognizes and understands that the OFF THE WALL Mark distinguishes and uniquely identifies Vans' products. *Id.*

In addition to the OFF THE WALL Mark, Vans has also continuously used and registered the following representative examples of its other Asserted Marks:

Trademark	U.S. Reg. No.	Reg. Date	Relevant Goods/Services
VANS *Flying V Mark*	6,136,351	August 25, 2020	***Class 25***: Footwear
 *Waffle Sole*	1,244,537	July 5, 1983	***Class 25***: Footwear

MSCHF has also intentionally copied the trade dress of Vans' shoe boxes, as well as the VANS logo placed in the footbed of its shoes (the Footbed Logo), as shown in the below comparison (Greene Decl., Ex. 1):

Vans Trade Dress	Wavy Baby Design
	
	

Finally, since August 2021, Vans has used the mark WAYVEE in connection with footwear, which Vans has applied to register under U.S. Serial No. 97/040,210. Wimmer Decl. ¶ 16. The WAYVEE Mark is a creative reference to both Vans' famous "Flying Vee" design and

its wavy Side Stripe Mark. *Id.* ¶ 17. Vans' rights in the WAYVEE Mark are senior to any rights MSCHF has in the WAVY BABY name. *Id.* ¶ 18.

4. Vans' Collaboration with Celebrities

As part of its business strategy, Vans has collaborated with a curated list of celebrities to advertise, design, and sell its shoe lines, including Anderson Paak, Metallica, A$AP Rocky, Tierra Whack, and the Foo Fighters. Regan Decl. ¶ 24, 29. These partnerships include collaborations on limited-edition releases of Vans' famous shoes, such as the OLD SKOOL. *Id.* ¶ 29. Vans' collaboration strategy is particularly focused on the music industry, in recognition of music's importance to Vans' brand and customer base. *Id.* In total, Vans invests millions of dollars a year in collaborations with celebrities and music industry advertising. *Id.*

B. MSCHF and Its Unlawful Use of Vans' Intellectual Property

Unlike Vans, MSCHF has built its business model on avoiding the significant investments required to develop original, authentic, and high-quality products of its own design, choosing instead to adopt, with few changes, the famous designs of its competitors' shoes. Its intended release of the Infringing Shoes is no exception.

In March 2022, Vans discovered that Michael Ray Nguyen-Stevenson, a recording artist who goes by the stage name Tyga, had posted images of his latest music video in which he wore shoes that resembled Vans' OLD SKOOL shoe. Wimmer Decl. ¶ 19. On or about April 6, 2022, Vans discovered that the shoes were a collaboration between Mr. Stevenson and MSCHF called the WAVY BABY, and that MSCHF intended to release the shoes on its website and mobile application on April 18, 2022. *Id.* ¶ 20. Upon learning of MSCHF's imminent release of the Infringing Shoes, Vans demanded that Mr. Stevenson, MSCHF, and their affiliates immediately

cancel the planned launch of the Infringing Shoes and permanently refrain from marketing the WAVY BABY design. *Id.* ¶ 21.

Despite Vans' efforts to prevent MSCHF's infringing conduct or otherwise resolve the parties' dispute, MSCHF has refused to cancel its planned release of the Infringing Shoes, threatening to release into the market potentially thousands of pairs of shoes that are confusingly similar to, and dilutive of, Vans' OLD SKOOL Trade Dress and the Side Stripe Mark. *Id.* ¶ 22.

III. LEGAL STANDARD

"To obtain a preliminary injunction, a plaintiff must establish: '(1) the likelihood of irreparable injury in the absence of such an injunction, and (2) either (a) likelihood of success on the merits or (b) sufficiently serious questions going to the merits to make them a fair ground for litigation plus a balance of hardships tipping decidedly' in its favor.'" *Louis Vuitton Malletier v. Burlington Coat Factory Warehouse Corp.*, 426 F.3d 532, 537 (2d Cir. 2005). The "standards which govern consideration of an application for a temporary restraining order… are the same standards as those which govern a preliminary injunction." *Local 1814, Int'l Longshoremen's Ass'n v. N.Y. Shipping Ass'n, Inc.*, 965 F.2d 1224, 1228 (2d Cir. 1992). A court can also grant preliminary relief "in situations where it cannot determine with certainty that the moving party is more likely than not to prevail on the merits of the underlying claim, but where the costs outweigh the benefits of not granting the injunction." *Citigroup Global Mkts., Inc. v. VCG Special Opportunities Master Fund Ltd.*, 598 F.3d 30, 35 (2d Cir. 2010). As detailed below, Vans has met the standard for a preliminary injunction, and thus, a temporary restraining order should also issue against MSCHF.

IV. ARGUMENT

A. Vans Is Likely to Succeed on the Merits of Its Trade Dress and Trademark Infringement Claims.

To prevail on its trademark infringement claims, Vans must show: (1) it owns a valid, protectable mark; (2) that the defendant used the mark in commerce without consent; and (3) that there is a likelihood of consumer confusion. *See* 15 U.S.C.A. § 1114(1)(a)-(b). Vans' other trademark-related claims for false designation of origin/unfair competition under the Lanham Act (Counts I and II) and common law trademark infringement and unfair competition (Count VI) require essentially the same showing. *See, e.g.*, 15 U.S.C. § 1125(a); 15 U.S.C. § 1125(c); *Innovation Ventures, LLC v. Ultimate One Distrib. Corp.*, 176 F. Supp. 3d 137, 157-158 (E.D.N.Y. 2016). Once a mark is found to be protectable, establishing a likelihood of confusion "is generally sufficient to demonstrate both irreparable harm and a likelihood of success on the merits," that justifies preliminary relief. *Virgin Enters. Ltd. v. Nawab*, 335 F.3d 141, 146 (2d Cir. 2003). Here, there is no dispute that MSCHF has, without authorization, used the OLD SKOOL Trade Dress and Side Stripe Mark, as well as the other Asserted Marks, in commerce by advertising the Infringing Shoes for sale in the United States. Wimmer Decl. ¶ 23. Accordingly, the likelihood that Vans will succeed on the merits turns on the first and last elements.

1. Vans' Asserted Marks are Valid and Protectable[1]

The evidence clearly establishes that Vans has valid and protectable rights in the Side Stripe Mark and OLD SKOOL Trade Dress. For one, Vans' trademark registrations for the Side Stripe Mark are *prima facie* evidence of the validity, ownership, and exclusive right by Vans to use the Mark. 15 U.S.C. § 1057(b); *Lane Capital Mgmt., Inc. v. Lane Capital Mgmt., Inc.*, 192

[1] Although Vans has valid and protectable rights in all of its Asserted Marks, due to space constraints, Vans has focused on its OLD SKOOL Trade Dress and the Side Stripe Mark. Vans can provide evidence of its rights in the other Asserted Marks at the Court's request.

F.3d 337, 345 (2d Cir. 1999) (holding that a certificate of registration establishes that a mark is "valid (i.e., protectable), that the registrant owns the mark, and that the registrant has the exclusive right to use the mark in commerce"). The registrations for the Side Stripe Mark have also become incontestable, and "are conclusively presumed to be valid and entitled to protection." *Paco Sport, Ltd. v. Paco Rabanne Perfumes*, 234 F.3d 1262 (2d Cir. 2000); 15 U.S.C. § 1065; Wimmer Decl. ¶¶ 9-10; Exs. 1-4.

Additionally, Vans has valid and protectable rights in the OLD SKOOL Trade Dress. "'A product's trade dress is protected under the Lanham Act if it is not functional and if it is either inherently distinctive or has acquired secondary meaning in the marketplace.'" *Shandong Shino Food Indus. Co. v. May Flower Int'l, Inc.*, 521 F. Supp. 3d 222, 253 (E.D.N.Y. 2021) (quoting *Nora Beverages, Inc. v. Perrier Grp. of Am., Inc.*, 269 F.3d 114, 118 (2d Cir. 2001)).

Here, Vans has ample evidence that its OLD SKOOL Trade Dress has at least acquired secondary meaning. Factors indicating secondary meaning include: "(1) advertising expenditures, (2) consumer studies linking the mark to a source, (3) unsolicited media coverage of the product, (4) sales success, (5) attempts to plagiarize the mark, and, (6) length and exclusivity of the mark's use." *Christian Louboutin S.A. v. Yves Saint Laurent Am. Holdings, Inc.*, 696 F.3d 206, 226 (2d Cir. 2012). Each of these factors is satisfied here.

Indeed, Vans began selling its OLD SKOOL Trade Dress in the 1970s, and it has sold over 200 million pairs of the shoes in the years since, establishing both length of use and sales success. Callahan Decl. ¶¶ 5-7. Vans has also earned several billion dollars in revenue based on its U.S. sales of the OLD SKOOL shoe, alone, and has invested millions in advertising the OLD SKOOL Trade Dress through traditional and non-traditional means. Regan Decl. ¶ 20; Callahan

Decl. ¶ 7. And third-party sources have given the OLD SKOOL Trade Dress significant unsolicited praise and attention. Regan Decl. ¶¶ 22-23; Exs. 3-7.

Further, MSCHF's intentional copying of the OLD SKOOL Trade Dress is itself "persuasive evidence of secondary meaning." *Essie Cosmetics, Ltd. v. Dae Do Int'l, Ltd.*, 808 F. Supp. 952, 958 (E.D.N.Y. 1992). Consumers surveys have also found the OLD SKOOL Trade Dress to be distinctive, which are "particularly useful in establishing secondary meaning." *Essie Cosmetics*, 808 F. Supp. at 958; Wimmer Decl. ¶ 14; Ex. 5.

Finally, the OLD SKOOL Trade Dress elements are nonfunctional, as none of the elements are "'essential the purpose of the article,'" in that they are not "dictated by the functions to be performed by [shoes]"—*i.e.*, the support and protection of a foot—nor do the features of the OLD SKOOL Trade Dress "'affect[] the quality or cost of the article,'" because they do not "permit[] the [shoe] to be manufactured at a lower cost or . . . improve[] the operation of the [shoe]." *Christian Louboutin S.A.*, 696 F.3d at 219-20 (quoting in part *Innwood Labs., Inc. v. Ives Labs., Inc.*, 456 U.S. 844, 850 n.10 (1982)). And the OLD SKOOL Trade Dress is not aesthetically functional, as giving Vans exclusive right to use the Dress does not "*significantly* limit the range of competitive designs available" to competitors and therefore does not "put competitors at a significant non-reputation-related disadvantage." *Id.* (emphasis supplied).

Considering the above factors and evidence, MSCHF cannot genuinely dispute that Vans has valid and protectable rights in at least the OLD SKOOL Trade Dress and Side Stripe Mark, and Vans can establish its indisputable rights in the remaining Asserted Marks, as well.

2. MSCHF's Infringing Shoes Are Likely to Cause Consumer Confusion

Vans is also likely to succeed in establishing a likelihood of confusion—and thus irreparable harm—from MSCHF's promotion and sales of its Infringing Shoes. To determine likelihood of confusion, courts in the Second Circuit apply the eight-factor test set forth in *Polaroid Corp. v. Polarad Elecs. Corp.*, 287 F.2d 492 (2d Cir. 1961), which considers: (1) the strength of the senior user's mark; (2) the degree of similarity between the two marks; (3) the proximity of the products; (4) the likelihood that the prior owner will bridge the gap; (5) actual confusion; (6) the junior user's good faith in adopting its own mark; (7) the quality of defendant's product; and (8) the sophistication of buyers. *Id.* at 495. The same factors are also used to determine trade dress infringement. *See Essie Cosmetics*, 808 F. Supp. at 959. "[A]pplication of the Polaroid test need not be rigid," and although "no single factor is determinative," "the first three factors are perhaps the most significant." *New Kayak Pool Corp. v. R & P Pools, Inc.*, 246 F.3d 183, 185 (2d Cir. 2001).

a. Vans' Marks and Trade Dress Rights Are Strong (Factor One)

"The strength of a trademark encompasses two different concepts, both of which relate significantly to likelihood of consumer confusion." *Virgin Enters.*, 335 F.3d at 147. The first is the inherent distinctiveness of the mark, which considers whether the mark is arbitrary and fanciful or merely generic, descriptive, or suggestive of the goods with which it is sold. *Id.* The second concept—acquired distinctiveness—refers to the fame the mark has obtained from its prominent use in commerce and consumer recognition. *Id.* Marks that have inherent and/or acquired distinctiveness are entitled to "broad, muscular protection." *Id.*

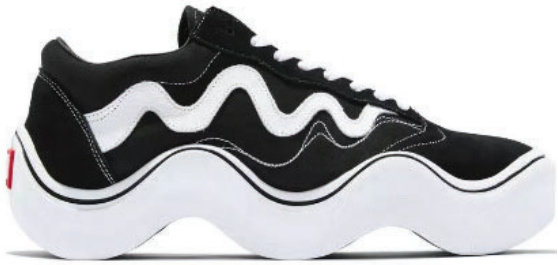
The OLD SKOOL Trade Dress and Side Stripe Mark are both inherently and commercially strong. The Asserted Marks have no intrinsic relationship to shoes and are

therefore arbitrary and fanciful with respect to the goods with which they are sold. *Id.* at 148. The Asserted Marks have also acquired distinctiveness and fame through Vans' investment of tens of millions of dollars in advertising and promoting the Asserted Marks; Vans' significant sales of products bearing the asserted rights; and the numerous, unsolicited media references and coverage of the Dress and Mark. *See* Regan Decl. ¶¶ 18, 22-23; Exs. 2-7; Callahan Decl. ¶ 7. Vans' OLD SKOOL shoes have also been recognized as among the most well-known and popular sneakers in the world. Regan Decl. ¶¶ 22-23; Exs. 3-7. And consumer surveys have shown that the OLD SKOOL Trade Dress serves as a unique identifier for Vans. Wimmer Decl. ¶ 14; Ex. 5. For at least these reasons, Vans' trademarks and trade dress rights are strong.

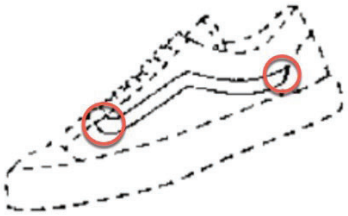
b. The Infringing Shoes Are Highly Similar to the Asserted Marks (Factor Two)

The second *Polaroid* factor—the degree of similarity between the marks at issue—also weighs strongly in Vans' favor. Indeed, a visual comparison of the Infringing Shoes to Vans' OLD SKOOL Trade Dress and other Asserted Marks establishes the high degree of similarity between MSCHF's shoes and Vans' famous dress and associated marks.

Vans' Trademarks/Trade Dress	WAVY BABY Design
	

As the above images show, the WAVY BABY shoe design is undeniably evocative of Vans' Side Stripe Mark and OLD SKOOL Trade Dress. First, the side stripe on MSCHF's Infringing Shoes is placed on the silhouette of the shoes in the same manner as Vans' placement—emanating from the heel counter and terminating at the eye stay reinforcements. A comparison between Vans' U.S. Trademark Registration No. 2,177,772 and MSCHF's Wavy Baby shoe demonstrates MSCHF's use of a confusingly similar stripe:



U.S. Reg. No. 2,177,772

Infringing Wavy Baby Shoe

The Infringing Shoes also feature a rubberized sidewall that, apart from the "wavy" construction, maintains a consistent perimeter around the shoe; a three-tiered appearance on the uppermost portion of the sidewall; a textured toe box outer around the front of the sidewall; and visible stitching, including where the eyestay meets the vamp, all of which are distinctive features of the OLD SKOOL Trade Dress. Wimmer Decl. ¶ 12; Pozzebon Decl. ¶¶ 7-8.

The similarity of the Infringing Shoes to Vans' OLD SKOOL Trade Dress is also compounded by the additional Vans-identifying branding that MSCHF uses in connection with the Infringing Shoes. Indeed, the similarity of two products requires consideration on "the overall appearance of the packaged products," including the placement of fixtures on the product and the colors used. *See Fun-Damental Too, Ltd. v. Gemmy Indus. Corp.*, 111 F.3d 993, 1003 (2d Cir. 1997). Here, MSCHF mutilates several Vans' marks and trade dress elements to create an even closer connection between the Infringing Shoes and Vans in the mind of consumers. For example, MSCHF applied a red badge on the rear heel of the shoe with an image of a ghost in

white, which is meant to resemble the OFF THE WALL Marks used on the rear heel of Vans' OLD SKOOL shoes. *See supra*, Section II.A.3. The red badge logo also features a stylized version of the word WAVY, which intentionally mimics Vans' Stylized VANS Mark. *See id.* And even the chosen name for the shoes, WAVY BABY, resembles Vans' WAYVEE Mark. *See id.* As shown above, the Infringing Shoes also intentionally mimic and use the Waffle Sole, Footbed Logo, and even the Vans Packaging. As these non-limiting examples demonstrate, the Infringing Shoes are packaged and advertised in a manner that is almost identical to the OLD SKOOL Trade Dress and that intentionally copies Vans' other well-known marks, in an obvious attempt to capitalize on the tremendous goodwill that Vans has built in the Asserted Marks over many decades. The similarities between the Infringing Shoes and the Asserted Marks therefore strongly favors Vans.

c. MSCHF Intends to Sell Identical Products to Overlapping Consumers (Factors Three and Four)

The proximity of the senior and junior users' products in the marketplace "has an obvious bearing on the likelihood of confusion." *Virgin Enters.*, 335 F.3d at 149-50. "[T]he closer the secondary user's goods are to those the consumer has seen marketed under the prior user's brand, the more likely that the consumer will mistakenly assume a common source." *Id.* at 150. Here, the goods sold by Vans and MSCHF are both sneakers and thus could not be more related. *See Fun-Damental Too, Ltd.*, 111 F.3d at 1003 (finding that products that were "nearly identical" supported "the finding of likelihood of confusion"). MSCHF also intends to sell the Infringing Shoes through the same marketing channels as Vans—namely, digital platforms—to overlapping consumers. Regan Decl. ¶¶ 9-10; Callahan Decl. ¶ 11. And, like MSCHF, Vans has collaborated with celebrities on its own limited-edition releases of shoe designs, as well as to

advertise its productions, with a particular focus on the music industry—the same industry in which MSCHF's collaborator, Mr. Stevenson, is well known. *See supra*, Section II.A.4.

The products at issue therefore exist in the same market and target overlapping consumers who are likely to falsely believe that the Infringing Shoes are another Vans celebrity collaboration. Accordingly, the third *Polaroid* factor favors Vans. Moreover, because the products will operate in the same market, the fourth *Polaroid* factor—whether the senior user is likely to "bridge the gap" into the junior user's market—is not relevant. *See Bulman v. 2BKCO, Inc.*, 882 F. Supp. 2d 551, 562 (S.D.N.Y. 2012).

d. Actual Confusion (Factor Five)

"[I]t is black letter law that actual confusion need not be shown to prevail under the Lanham Act, since actual confusion is very difficult to prove and the Act requires only a likelihood of confusion as to source." *Lois Sportswear, U.S.A., Inc. v. Levi Strauss & Co.*, 799 F.2d 867, 875 (2d Cir. 1986). Nonetheless, even before the planned release of the Infringing Shoes, multiple independent sources have noted the obvious similarity between the Infringing Shoes and Vans' OLD SKOOL Trade Dress, and have even directly confused Vans and MSCHF as the source of the goods. *See, e.g.*, Rosendahl Decl. ¶ 4; Ex. 1. As just one example, the online magazine *Input* wrote an article titled "MSCHF and Tyga's 'Wavy Baby' Sneakers Seriously Distort Classic Vans," in which it stated that the "'Wavy Baby' . . . features a black upper, a much curvier version of Vans' signature Jazz Stripe, white midsole, and a gum waffle outsole," noting also that it was "impossible to ignore the sneakers' heavy resemblance to Vans' classic Old Skool silhouette." *Id.*, Ex. 1. Another source referred to the Infringing Shoes as "The MSCHF x Vans Baby Wave." *Id.* MSCHF's extensive promotion is already causing confusion,

which is likely to compound if the Infringing Shoes are released. The fifth *Polaroid* factor therefore favors Vans.

e. MSCHF Has Acted in Bad Faith (Factor Six)

There is no question in this case that MSCHF intentionally adopted the same features as the OLD SKOOL Trade Dress to capitalize on Vans' reputation and goodwill and to cause confusion between its shoes and Vans' products. As multiple third-party sources have recognized, the Infringing Shoes are an intentional mutilation of the Asserted Marks. Rosendahl Decl. ¶ 4, Ex. 1. MSCHF's intentional copying of multiple Vans' trademark and trade dress rights in connection with the Infringing Shoes only confirms that it acted in bad faith to profit from Vans' famous shoe designs. The sixth *Polaroid* factor therefore favors Vans.

f. MSCHF's Infringing Shoes Are of Unknown Quality and Dangerously Designed (Factor Seven)

The seventh *Polaroid* factor requires the Court "consider[ ] whether the senior user's reputation could be 'tarnished by [the] inferior merchandise of the junior user.'" *Cadbury Beverages v. Cott Corp.*, 73 F.3d 474, 483 (2d Cir. 1996) (quoting *Scarves by Vera, Inc. v. Todo Imps. Ltd.*, 544 F.2d 1167, 1172 (2d Cir. 1976)). Because the Infringing Shoes have yet to be released, their quality is unknown. However, MSCHF has made obvious alterations to the OLD SKOOL Trade Dress that pose a safety risk to consumers, as the wavy construction of the out- and midsole of the shoes is less stable than the standard flat-sole shoe design found in Vans' OLD SKOOL shoes, and therefore less likely to support the wearer. Callahan Decl. ¶ 16. The potential instability of the Infringing Shoes, and risk of resulting injury to consumers, threatens to tarnish Vans' reputation as a source of high-quality, dependable footwear. The seventh *Polaroid* factor therefore favors Vans.

g. Purchasers of Footwear are Unlikely to Exercise Significant Care (Factor Eight)

The final factor considers the degree of care that typical consumers of the parties' products would be expected to exercise in purchasing those products. *Virgin Enters.*, 335 F.3d at 151. Along the spectrum of possible purchasers, "[r]etail customers . . . are not expected to exercise the same degree of care as professional buyers, who are expected to have greater powers of discrimination." *Id.* (internal quotations and citations omitted). Here, the purchasers of Vans' and MSCHF's products are retail customers, who most often purchase shoes through self-service mediums such as a website, without any guidance from a professional. Wimmer Decl. ¶¶ 25-26. Moreover, shoes are a common consumer item, purchasers of which are unlikely to exercise a high degree of care. The eighth, and final, *Polaroid* factor therefore favors Vans.

3. MSCHF's Infringing Shoes are Not a Parodic or Artistic Expression

Acknowledging that its Infringing Shoes are clearly knockoffs of Vans' OLD SKOOL Trade Dress, MSCHF has instead fallen back on the argument that its shoes, which it intends to sell to the general public for its own profit, are merely a parody or artistic take on Vans' Asserted Marks. However, the Second Circuit has recognized that parodic use or artistic alteration of a mark is "sharply limited" in circumstances where, as here, "an alleged parody of a competitor's mark [is used] to sell a competing product." *Harley Davidson, Inc. v. Grottanelli*, 164 F.3d 806, 813 (2d Cir.1999). Moreover, parody marks also cannot themselves be used to indicate the source or sponsorship of a good. *Starbucks Corp. v. Wolfe's Borough Coffee, Inc.*, 588 F.3d 97, 111-13 (2d Cir. 2009).

Here, MSCHF has not released the Infringing Shoes as an obvious commentary on Vans, the OLD SKOOL shoe, or some other societal issue, as is typical in a parody case. Instead, it has merely adopted the well-known and famous Asserted Marks and slightly altered their appearance

to sell potentially thousands of shoes that directly compete with, and dilute the distinctiveness of, Vans' own products. But giving the Asserted Marks a "wavy" appearance as a fast gimmick to sell shoes is not a fair or artistic use of Vans' intellectual property rights. *See Harley Davidson, Inc.*, 164 F.3d at 813 (finding that claimed parodic use of Harley Davidson logo was not fair use when the logo made no obvious comment on Harley Davidson or its logo and was simply used in a humorous manner to promote the defendant's own products). This is particularly true when Vans itself is known for customized versions of its shoes that retain its core OLD SKOOL Trade Dress, as the Infringing Shoes do here, and also for playful "skews" of its own branding, such as placing a crooked version of the classic VANS logo on the footbed of its shoes. Regan Decl. ¶ 30. Simply put, MSCHF cannot slightly alter a famous trade dress in which Vans has invested significant resources to sell a competing product and claim that it is merely artistic or parodic expression. MSCHF's only defense is therefore unlikely to prevail on the merits.

Ultimately, because Vans is very likely to establish that it has valid and protectable rights in the OLD SKOOL Trade Dress and Side Stripe Mark and that MSCHF has infringed those rights, Vans respectfully requests that the Court temporarily and preliminary enjoin MSCHF from selling the Infringing Shoes until an adjudication on the merits.

B. Vans Is Likely to Succeed on the Merits of Its Dilution Claim.

Even if the Court finds that Vans is not entitled to preliminary relief on its trademark infringement claims, Vans is nonetheless separately entitled to preliminary relief on its federal and state trademark dilution claims (Counts III and V). To prevail on its federal dilution claim, Vans must establish that its Asserted Marks are famous, and that MSCHF's Infringing Shoes are likely to cause dilution of those marks by blurring or tarnishment, "regardless of the presence or absence of actual or likely confusion, of competition, or of actual economic injury." 15 U.S.C. §

1125(c)(1). Vans' New York state dilution claim also requires proof of dilution by blurring or tarnishment, though "the plaintiff's mark need not be famous or celebrated." *Uber Inc. v. Uber Techs., Inc.*, 521 F. Supp. 3d 455, 468 (S.D.N.Y. 2021). Instead, "distinctiveness for the purpose of trademark dilution claims under New York state law has been equated with the strength of a mark for infringement purposes." *Id.* at 469 (internal quotations and citations omitted).

Here, MSCHF cannot dispute that the Asserted Marks are famous. Indeed, as noted above, numerous third-party sources have commented on the strength and fame of the OLD SKOOL Trade Dress and Side Stripe Mark, referring to the Side Stripe Mark as "famous" and "iconic," and recognizing the OLD SKOOL Shoe one of the most popular and sought-after sneakers in the world. Regan Decl. ¶¶ 18, 22-23; Exs. 2-7. Vans has also spent tens of millions of dollars promoting the Asserted Marks, selling millions of pairs of shoes featuring the Asserted Marks and earning billions in revenue from the sale of such shoes. *Id.* ¶¶ 14, 20; Callahan Decl. ¶ 7. Finally, consumer surveys have established that the OLD SKOOL Trade Dress has secondary meaning. Wimmer Decl. ¶ 14; Ex. 5. The Asserted Marks are therefore famous.

MSCHF's Infringing Shoes are also likely to dilute the Asserted Marks by both blurring and tarnishment. For one, the factors establishing dilution by blurring under § 1125(c)(2)(B), including the degree of similarity between Infringing Shoes and the OLD SKOOL Trade Dress, all demonstrate that the Infringing Shoes are likely to impair the distinctiveness of the Asserted Marks.[2] *See supra,* Section IV.A.2.b. And as discussed above, the Infringing Shoes are likely to tarnish Vans' reputation by creating negative associations between Vans and MSCHF's

[2] The relevant factors include: (i) the degree of similarity between the mark and the famous mark; (ii) the degree of inherent or acquired distinctiveness of the famous mark; (iii) the extent to which the owner of the famous mark is engaging in substantially exclusive use of the mark; (iv) the degree of recognition of the famous mark; (v) whether the user of the mark intended to create an association with the famous mark; (vi) any actual association between the mark and the famous mark. 15 U.S.C. § 1125(c)(1), (c)(2)(B).

dangerously constructed shoes. *See supra,* Section IV.A.2.f; *see also Hormel Foods Corp. v. Jim Henson Productions, Inc.*, 73 F.3d 497 at 507 (2d Cir. 1996) ("The *sine qua non* of tarnishment is a finding that the plaintiff's mark will suffer negative associations through defendant's use.").

C. Vans is Likely to Suffer Irreparable Harm

Where a trademark plaintiff establishes a likelihood of success on liability, irreparable harm is presumed. 15 U.S.C. § 1116(a). Therefore, because Vans is likely to succeed on the merits, it is entitled to a presumption of irreparable harm that favors preliminary relief, which MSCHF must rebut.

But even without a presumption, the irreparable harm to Vans if preliminary relief is not granted is obvious from the record. "Irreparable harm exists in a trademark case when the party seeking the injunction shows that it will lose control over the reputation of its trademark . . . because loss of control over one's reputation is neither 'calculable nor precisely compensable.'" *U.S. Polo Ass'n, Inc. v. PRL USA Holdings Inc.*, 800 F. Supp. 2d 515, 540 (S.D.N.Y.2011); *see also NYC Triathlon LLC v. NYC Triathlon Club, Inc.*, 704 F. Supp. 2d 305, 343 (S.D.N.Y.2010) ("Prospective loss of ... goodwill alone is sufficient to support a finding of irreparable harm."). To that end, Vans has presented evidence of its significant and extensive investment in the Asserted Marks over decades. *See supra*, Section II. That investment has resulted in a tremendous level of goodwill and consumer recognition in Vans' trade dress and trademarks, which Vans will lose if MSCHF is allowed to sell its Infringing Shoes. Callahan Decl. ¶¶ 12-19.

Additionally, because MSCHF has advertised its Infringing Shoes as a celebrity collaboration with Mr. Stevenson, Vans will also lose control of consumer perception regarding the celebrities with whom it collaborates, the design and quality of those collaborations, and how and in what frequency those collaborations are released and marketed. Regan Decl. ¶ 29. These

controls are critical to prevent oversaturation of the market and maintain Vans' reputation. *Id.* ¶ 31 (discussing Vans' carefully constructed premium brand image).

Finally, Vans carefully controls the promotion and supply of its products to prevent damage to its reputation and goodwill from subpar or dangerous goods. Callahan Decl. ¶¶ 12-19. But MSCHF does not have the same standards, and MSCHF's alterations to the Infringing Shoes are likely impair the structural integrity of the sneakers, at the risk of consumer safety. *Id.* MSCHF's intentional alteration of the OLD SKOOL Trade Dress to make it ***more harmful*** to consumers falls far short of Vans' strict standards, and the release of the Infringing Shoes would therefore deprive Vans of the ability to protect its brand from significant reputational harm.

For at least these reasons, absent a temporary restraining order and preliminary injunction, Vans will suffer irreparable harm to the reputation and goodwill it has built over decades. Accordingly, in the unlikely event MSCHF is able to rebut the presumption of harm to Vans, the record evidence nonetheless also justifies preliminary relief.

D. The Balance of Equities Tips Decidedly in Vans' Favor

In contrast to the irreparable harm to Vans' goodwill and reputation if no preliminary relief is granted, the relative harm to MSCHF from not being able to release the Infringing Shoes is minimal. Indeed, when, as here, a restraining order or preliminary injunction would maintain the status quo pending resolution of the litigation, the balance of equities tips in the movant's favor. *See Perry Street Software, Inc. v. Jedi Techs., Inc.*, No. 20-cv-04539-CM, 2020 WL 6064168, at *7 (S.D.N.Y. Oct. 14, 2020). MSCHF has yet to release its Infringing Shoes, so any order enjoining the release of those shoes would leave MSCHF in the position it is already in and would at most postpone the sales of only the Infringing Shoes, while leaving intact MSCHF's ability to sell other goods that do not infringe Vans' asserted rights. Entering an injunction will

therefore cause only little if any harm to MSCHF's business, allowing it to continue as a going concern, while avoiding the significant harm to Vans if the status quo is not maintained.

E. Injunctive Relief Is in the Public Interest

An injunction would also serve the "'strong interest in preventing public confusion.'" *Marks Org., Inc. v. Joles*, 784 F. Supp. 2d 322, 336 (S.D.N.Y. 2011) (citation omitted). Because Vans has established that MSCHF's intended release of the Infringing Shoes is likely to confuse consumers (*see supra*, Section IV.A), granting an injunction will serve the public's interest in avoiding such confusion. *See Juicy Couture, Inc. v. Bella Int'l Ltd.*, 930 F. Supp. 2d 489, 504 (S.D.N.Y. 2013) (finding that "the public interest would not be disserved by the issuance of a preliminary injunction" because the plaintiff established that defendants' actions were likely to cause consumer confusion).

Ultimately, because Vans has demonstrated that it is "likely to succeed on the merits, that [it is] likely to suffer irreparable harm in the absence of preliminary relief, that the balance of equities tips in [its] favor, and that an injunction is in the public interest," Vans respectfully requests that the Court enter a restraining order enjoining the imminent release of the Infringing Shoes until a preliminary injunction is decided, and further enter a preliminary injunction enjoining any future releases of the shoes until a final adjudication on the merits. Given the imminent planned release of the Infringing Shoes on April 18, 2022, Vans further requests the entry of a restraining order before the noon EST on April 18, or the entry of an order enjoining the planned release until the Court can entertain arguments on such restraining order.

F. The Bond Should be Minimal

Under Federal Rule of Civil Procedure 65(c), district courts have "wide discretion in the matter of security and it has been held proper for the court to require no bond where there has

been no proof of likelihood of harm." *Doctor's Assocs., Inc. v. Stuart*, 85 F.3d 975, 985 (2d Cir. 1996). Here, MSCHF will not be harmed by a preliminary injunction. *See supra*, Section IV.D. MSCHF will not be restrained from using non-infringing marks to promote its products and business. *Id.* Moreover, Vans' likelihood of succeeding on the merits at trial is high (*see supra*, Section IV.A), making the likelihood of a "wrongful" injunction very low. Vans therefore requests that the Court use its discretion to require no bond if an injunction is issued, or if it decides to require a bond, that any bond be nominal to account for the minimal harm to MSCHF.

V. CONCLUSION

For all the reasons set forth above, Vans requests that the Court grants Vans' application for a temporary restraining order and motion for a preliminary injunction, and issue Vans' proposed preliminary injunction against MSCHF.

Dated: April 14, 2022

Respectfully submitted,

McGuireWoods LLP

Philip A. Goldstein
Michael L. Simes
1251 Avenue of the Americas, 20th Floor
New York, NY 10020
Tel: (212) 548-2167
Fax: (212) 715-6275
pagoldstein@mcguirewoods.com
msimes@mcguirewoods.com

Tanya L. Greene (*pending pro hac vice*)
Wells Fargo Center, South Tower
355 S. Grand Ave., Suite 4200
Los Angeles, CA 90071
Tel: (213) 457-9879
Fax: (213) 547-9899
tgreene@mcguirewoods.com

Lucy J. Wheatley (*pending pro hac vice*)
Matthew G. Rosendahl (*pending pro hac vice*)
800 East Canal Street
Richmond, VA 23219
Tel: (804) 775-1000
Fax: (804) 698-2016
lwheatley@mcguirewoods.com
mrosendahl@mcguirewoods.com

Matthew W. Cornelia (*pending pro hac vice*)
2000 McKinney Ave., Suite 1400
Dallas, TX 75201
Tel: (214) 932-6400
Fax: (214) 932-6499
mcornelia@mcguirewoods.com

Counsel for Plaintiffs
Vans, Inc. and VF Outdoor, LLC

UNITED STATES DISTRICT COURT
EASTERN DISTRICT OF NEW YORK

VANS, INC. and VF OUTDOOR, LLC, Plaintiffs, v. MSCHF PRODUCT STUDIO, INC., Defendant.	Case No. 22-cv-02156-WFM-RML JURY TRIAL DEMANDED

DECLARATION OF KIA WIMMER IN SUPPORT OF PLAINTIFFS' MOTION FOR TEMPORARY RESTRAINING ORDER AND PRELIMINARY INJUNCTION

I, Kia Wimmer, declare and state as follows:

1. This declaration is based upon my personal knowledge of the facts or on business records that were made in the regular course of business. If called as a witness, I could and would testify to the statements made herein.

2. I am Assistant General Counsel at VF Intellectual Property Services, Inc., where I oversee many of the trademark prosecution and enforcement efforts for Vans, Inc. and Vans, a division of VF Outdoor LLC (collectively, "Vans"). I am listed as the Attorney of Record for many of Vans' trademark registrations with the U.S. Patent and Trademark Office.

3. As part of my role, I am intimately familiar with Vans' products, including but not limited to its OLD SKOOL shoes, and I am knowledgeable of or have access to business records concerning all of the information in this declaration, including Vans' trademarks, trade dress rights, goodwill, and reputation.

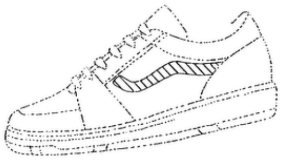
4. Vans is an industry-leading, global shoe and apparel company, which is known for its original, authentic, and distinctive footwear and apparel that embody Southern California counterculture.

5. Founded in March 1966, Vans spent the past several decades building up distinctive trademarks and trade dresses that instantly convey Vans' reputation for authenticity, quality, and creative expression.

6. Vans is now, and for years has been, among the most successful sneaker companies in the world. Vans' enduring success has been driven by factors such as its focus on just a few iconic shoe lines, its reputation for creating lasting and durable footwear without sacrificing style, and its longstanding and consistent use of its trademarks and trade dresses, including the trademark and trade dress rights discussed in this Declaration.

7. One of Vans' most valuable trademarks is its now-iconic "jazz stripe," which adorns the side panel of many Vans shoes (the "Side Stripe Mark").

8. In addition to common law trademark rights, Vans has registered the Side Stripe Mark on the Principal Register of the U.S. Patent and Trademark Office in connection with a wide array of goods and services. For example, Vans owns all right, title, and interest in the following U.S. Trademark Registrations:

Trademark	U.S. Reg. No.	Reg. Date	Relevant Goods/Services
	2,177,772	8/4/1998	***Class 25***: Footwear
	2,170,961	7/7/1998	***Class 25***: Footwear
	2,172,482	7/14/1998	***Class 25***: Footwear
	4,442,122	12/3/2013	***Class 25***: Clothing

9. True and correct copies of the Certificates of Registration for Vans' above marks are attached as **Exhibit 1** (Reg. No. 2,177,772), **Exhibit 2** (Reg. No. 2,170,961), **Exhibit 3** (Reg. No. 2,172,482), and **Exhibit 4** (Reg. No. 4,442,122). All of these registrations are valid and subsisting on the Principal Register and have been since their respective registration dates.

10. The above registrations relating to the Side Stripe Mark are incontestable.

11. As a result of Vans' efforts in providing high quality, original, and authentic footwear and apparel using the Side Stripe Mark, as well its extensive marketing and years of hard work, Vans has built up and now owns extremely valuable goodwill that is symbolized by that mark. Consumers recognize the Side Stripe Mark as a source identifier that is uniquely associated with Vans and genuine Vans brand products.

12. Vans' "OLD SKOOL Trade Dress" consists of a distinctive combination of source-identifying elements, including: (1) the Vans Side Stripe Mark on the shoe upper; (2) a

rubberized sidewall with a consistent height around the perimeter of the shoe; (3) the uppermost portion of the sidewall having a three-tiered or grooved appearance; (4) a textured toe box outer around the front of the sidewall; (5) visible stitching, including where the eyestay meets the vamp; and (6) the placement and proportion of these elements in relation to one another.

Vans OLD SKOOL Shoe

13. The combination of elements comprising the OLD SKOOL Trade Dress is distinctive, and the public recognizes and understands that the OLD SKOOL Trade Dress distinguishes and identifies genuine Vans brand shoes. As a result of Vans' extensive use of the OLD SKOOL Trade Dress, Vans has built up and now owns extremely valuable goodwill that is embodied by the OLD SKOOL Trade Dress.

14. Indeed, Vans previously commissioned a consumer survey that confirmed the secondary meaning embodied in Vans' OLD SKOOL Trade Dress. Attached as Exhibit 5 is a true and correct copy of a report prepared by consumer survey expert Michael Rappeport from RL Associates in August 2019, detailing the secondary meaning found for Vans' OLD SKOOL Trade Dress among potential consumers.

15. In addition to the Side Stripe Mark and OLD SKOOL Trade Dress, since 1977, Vans has used and owned all rights in the following trademarks that featured on the OLD SKOOL shoe (the "OFF THE WALL Marks"), copies of which are **Exhibits 6** and **7**.

Trademark	U.S. Reg. No.	Reg. Date	Relevant Goods/Services
	6,309,462	March 30, 2021	***Class 25***: Footwear
	6,309,463	March 30, 2021	***Class 25***: Footwear

16. In addition, since August 2021, Vans has used the WAYVEE mark in connection with footwear. Vans also applied to register the mark under U.S. Serial No. 97/040,210.

17. The WAYVEE Mark is a creative reference to both Vans' famous "Flying Vee" design and its wavy Side Stripe Mark.

18. Vans' rights in the WAYVEE Mark are senior to any rights MSCHF has in the WAVY BABY name.

19. In March 2022, Vans discovered that Michael Ray Nguyen-Stevenson, a recording artist who goes by the stage name Tyga, had posted images of his latest music video in which he wore shoes that resembled Vans' OLD SKOOL shoe.

20. After investigating, Vans discovered that the shoes were a collaboration between Mr. Stevenson and MSCHF called the WAVY BABY, and that MSCHF intended to release the shoes on its website and mobile application on April 18, 2022.

21. Upon learning of MSCHF's imminent release of the Infringing Shoes, Vans demanded that Mr. Stevenson, MSCHF, and their affiliates immediately cancel the planned launch of the Infringing Shoes and permanently refrain from marketing the WAVY BABY design.

22. Despite Vans' efforts to prevent MSCHF's infringing conduct or otherwise resolve the parties' dispute, MSCHF has refused to cancel its planned release of the Infringing Shoes, threatening to release into the market potentially thousands of pairs of shoes that are confusingly similar to, and dilutive of, Vans' OLD SKOOL Dress and the Side Stripe Mark.

23. Here, there can be no dispute that MSCHF has without authorization used the OLD SKOOL Dress and Side Stripe Mark in commerce by advertising the Infringing Shoes for sale in the United States.

24. The WAVY BABY shoe design is undeniably evocative of Vans' Side Stripe Mark and OLD SKOOL Dress. First, the side stripe on MSCHF's Wavy Baby shoes is placed on the silhouette of the shoes in the same manner as Vans' placement—emanating from the heel counter and terminating at the eye stay reinforcements. The MSCHF Wavy Baby shoes also feature a rubberized sidewall that, apart from the wavy appearance, maintains a consistent perimeter around the shoe; a three-tiered appearance on the uppermost portion of the sidewall; a textured toe box outer around the front of the sidewall; and visible stitching, including where the eyestay meets the vamp, all of which are distinctive features of the OLD SKOOL Dress.

25. As indicated on its website (https://mschfsneakers.com/), MSCHF intends to sell the MSCHF Wavy Baby shoes through the same marketing channels as Vans—namely, digital platforms—to overlapping consumers.

26. In particular, the purchasers of Vans' and MSCHF's products are retail customers, who most often purchase shoes through self-service mediums such as a website, without any guidance from a professional.

I declare under penalty of perjury under the laws of the United States of America that the foregoing is true and correct to the best of my knowledge.

Executed on April 14, 2022

Kia Wimmer

EXHIBIT 1

Int. Cl.: 25

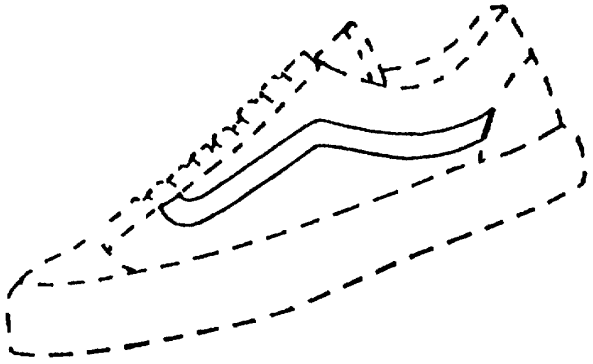
Prior U.S. Cls.: 22 and 39

Reg. No. 2,177,772

United States Patent and Trademark Office

Registered Aug. 4, 1998

TRADEMARK
PRINCIPAL REGISTER



VANS, INC. (DELAWARE CORPORATION)
2095 BATAVIA STREET
ORANGE, CA 926653101

FOR: FOOTWEAR, IN CLASS 25 (U.S. CLS. 22 AND 39).

FIRST USE 0-0-1971; IN COMMERCE 0-0-1971.

THE MATTER SHOWN BY THE DOTTED LINES IS NOT PART OF THE MARK AND SERVES ONLY TO SHOW THE POSITION OF THE MARK.

SEC. 2(F).

SER. NO. 75-091,541, FILED 4-19-1996.

KIM SAITO, EXAMINING ATTORNEY

EXHIBIT 2

United States of America

United States Patent and Trademark Office

Reg. No. 2,170,961

Registered Jul. 07, 1998

Corrected Apr. 09, 2019

Int. Cl.: 25

Trademark

Principal Register

VANS, INC. (DELAWARE CORPORATION)
1588 South Coast Drive
Costa Mesa, CALIFORNIA 92626

CLASS 25: footwear

FIRST USE 00-00-1977; IN COMMERCE 00-00-1977

The matter shown by the dotted line is not part of the mark and serves only to show the position of the mark.

The stippling is for shading purposes only and does not indicate color.

SEC.2(F)

SER. NO. 75-229,182, FILED 01-22-1997

UNITED STATES PATENT AND TRADEMARK OFFICE · DEPARTMENT OF COMMERCE

Andrei Iancu

Director of the United States
Patent and Trademark Office

REQUIREMENTS TO MAINTAIN YOUR FEDERAL TRADEMARK REGISTRATION

WARNING: YOUR REGISTRATION WILL BE CANCELLED IF YOU DO NOT FILE THE DOCUMENTS BELOW DURING THE SPECIFIED TIME PERIODS.

Requirements in the First Ten Years*
What and When to File:

- ***First Filing Deadline:*** You must file a Declaration of Use (or Excusable Nonuse) between the 5th and 6th years after the registration date. See 15 U.S.C. §§1058, 1141k. If the declaration is accepted, the registration will continue in force for the remainder of the ten-year period, calculated from the registration date, unless cancelled by an order of the Commissioner for Trademarks or a federal court.

- ***Second Filing Deadline:*** You must file a Declaration of Use (or Excusable Nonuse) and an Application for Renewal between the 9th and 10th years after the registration date.* See 15 U.S.C. §1059.

Requirements in Successive Ten-Year Periods*
What and When to File:

- You must file a Declaration of Use (or Excusable Nonuse) and an Application for Renewal between every 9th and 10th-year period, calculated from the registration date.*

Grace Period Filings*

The above documents will be accepted as timely if filed within six months after the deadlines listed above with the payment of an additional fee.

***ATTENTION MADRID PROTOCOL REGISTRANTS:** The holder of an international registration with an extension of protection to the United States under the Madrid Protocol must timely file the Declarations of Use (or Excusable Nonuse) referenced above directly with the United States Patent and Trademark Office (USPTO). The time periods for filing are based on the U.S. registration date (not the international registration date). The deadlines and grace periods for the Declarations of Use (or Excusable Nonuse) are identical to those for nationally issued registrations. See 15 U.S.C. §§1058, 1141k. However, owners of international registrations do not file renewal applications at the USPTO. Instead, the holder must file a renewal of the underlying international registration at the International Bureau of the World Intellectual Property Organization, under Article 7 of the Madrid Protocol, before the expiration of each ten-year term of protection, calculated from the date of the international registration. See 15 U.S.C. §1141j. For more information and renewal forms for the international registration, see http://www.wipo.int/madrid/en/.

NOTE: Fees and requirements for maintaining registrations are subject to change. Please check the USPTO website for further information. With the exception of renewal applications for registered extensions of protection, you can file the registration maintenance documents referenced above online at http://www.uspto.gov.

NOTE: A courtesy e-mail reminder of USPTO maintenance filing deadlines will be sent to trademark owners/holders who authorize e-mail communication and maintain a current e-mail address with the USPTO. To ensure that e-mail is authorized and your address is current, please use the Trademark Electronic Application System (TEAS) Correspondence Address and Change of Owner Address Forms available at http://www.uspto.gov.

EXHIBIT 3

United States of America

United States Patent and Trademark Office

Reg. No. 2,172,482

Registered Jul. 14, 1998

Corrected Apr. 09, 2019

Int. Cl.: 25

Trademark

Principal Register

VANS, INC. (DELAWARE CORPORATION)
1588 South Coast Drive
Costa Mesa, CALIFORNIA 92626

CLASS 25: footwear

FIRST USE 00-00-1977; IN COMMERCE 00-00-1977

The mark consists of the design on the side of the shoe. The matter shown by the dotted line is not part of the mark and serves only to show the position of the mark.

The lining is for shading purposes only and does not indicate color.

SEC.2(F)

SER. NO. 75-229,184, FILED 01-22-1997

UNITED STATES PATENT AND TRADEMARK OFFICE · DEPARTMENT OF COMMERCE

Director of the United States
Patent and Trademark Office

REQUIREMENTS TO MAINTAIN YOUR FEDERAL TRADEMARK REGISTRATION

WARNING: YOUR REGISTRATION WILL BE CANCELLED IF YOU DO NOT FILE THE DOCUMENTS BELOW DURING THE SPECIFIED TIME PERIODS.

Requirements in the First Ten Years*
What and When to File:

- ***First Filing Deadline:*** You must file a Declaration of Use (or Excusable Nonuse) between the 5th and 6th years after the registration date. See 15 U.S.C. §§1058, 1141k. If the declaration is accepted, the registration will continue in force for the remainder of the ten-year period, calculated from the registration date, unless cancelled by an order of the Commissioner for Trademarks or a federal court.

- ***Second Filing Deadline:*** You must file a Declaration of Use (or Excusable Nonuse) and an Application for Renewal between the 9th and 10th years after the registration date.* See 15 U.S.C. §1059.

Requirements in Successive Ten-Year Periods*
What and When to File:

- You must file a Declaration of Use (or Excusable Nonuse) and an Application for Renewal between every 9th and 10th-year period, calculated from the registration date.*

Grace Period Filings*

The above documents will be accepted as timely if filed within six months after the deadlines listed above with the payment of an additional fee.

***ATTENTION MADRID PROTOCOL REGISTRANTS:** The holder of an international registration with an extension of protection to the United States under the Madrid Protocol must timely file the Declarations of Use (or Excusable Nonuse) referenced above directly with the United States Patent and Trademark Office (USPTO). The time periods for filing are based on the U.S. registration date (not the international registration date). The deadlines and grace periods for the Declarations of Use (or Excusable Nonuse) are identical to those for nationally issued registrations. See 15 U.S.C. §§1058, 1141k. However, owners of international registrations do not file renewal applications at the USPTO. Instead, the holder must file a renewal of the underlying international registration at the International Bureau of the World Intellectual Property Organization, under Article 7 of the Madrid Protocol, before the expiration of each ten-year term of protection, calculated from the date of the international registration. See 15 U.S.C. §1141j. For more information and renewal forms for the international registration, see http://www.wipo.int/madrid/en/.

NOTE: Fees and requirements for maintaining registrations are subject to change. Please check the USPTO website for further information. With the exception of renewal applications for registered extensions of protection, you can file the registration maintenance documents referenced above online at http://www.uspto.gov.

NOTE: A courtesy e-mail reminder of USPTO maintenance filing deadlines will be sent to trademark owners/holders who authorize e-mail communication and maintain a current e-mail address with the USPTO. To ensure that e-mail is authorized and your address is current, please use the Trademark Electronic Application System (TEAS) Correspondence Address and Change of Owner Address Forms available at http://www.uspto.gov.

EXHIBIT 4

United States of America
United States Patent and Trademark Office

Reg. No. 4,442,122

Registered Dec. 03, 2013

Corrected Apr. 16, 2019

Int. Cl.: 25

Trademark

Principal Register

Vans, Inc. (DELAWARE CORPORATION)
1588 South Coast Drive
Costa Mesa, CALIFORNIA 92626

CLASS 25: Clothing, namely, T-shirts, shirts, sweatshirts, pants, shorts, denims, sweater, jackets, [belts, boxers,] socks [, scarves, underwear and swimwear]; Headgear, namely, hats, caps and beanies

FIRST USE 00-00-1997; IN COMMERCE 00-00-1997

The mark consists of a wave line.

OWNER OF U.S. REG. NO. 2170961, 3906529, 2172482

SER. NO. 85-361,562, FILED 07-01-2011

Director of the United States
Patent and Trademark Office

EXHIBIT 5

CONSUMERS' PERCEPTIONS OF SHOES SOLD BY VANS AND PRIMARK

A STUDY CONDUCTED FOR
McCARTER & ENGLISH, LLP

AUGUST 2019

RL ASSOCIATES

601 EWING STREET SUITE A-11
PRINCETON, NEW JERSEY 08540
(609) 683-9200
(609) 683-0855 FAX

TABLE OF CONTENTS

I – INTRODUCTION

Background

Earlier this year, we were contacted by McCarter & English, LLP, and told that they had a client, Vans, Inc. and VF Outdoor, LLC (together, "Vans"), that markets and sells footwear, apparel and accessories. One line of products sold by Vans is a low top shoe that is sold under the name "Old Skool." A second line of products sold by Vans is a high top shoe that is sold under the name "Sk8-Hi."

McCarter & English informed us that Vans had brought suit against Primark Stores Ltd., Primark Limited, and Primark US Corp. (together, "Primark"), claiming that two of the shoes that are currently being sold by Primark infringe on the trade dress of the Vans shoes.

According to the complaint filed in this case, both of the Vans shoes at issue (Old Skool and Sk8-Hi) have several design elements that contribute to the overall look and feel of the shoes, specifically:

1) the Vans Side Stripe Trademark, in contrasting color to the shoe upper;[1]
2) a white rubberized midsole;
3) a contrast line around the top edge of the midsole;
4) a texture toe box outer around the front of the midsole;
5) visible stitching, in contrasting color, including where the lace bracing meets the vamp.[2]

Vans believes that the overall look and feel of a low top shoe sold by Primark is so similar to the overall look and feel of the Vans Old Skool shoe that a significant proportion of an appropriate set of consumers is likely to mistakenly think that the Primark low top shoe is a Vans. Similarly, Vans believes that the overall look and feel of a high top shoe sold by Primark is so similar to the overall look and feel of the Vans Sk8-Hi shoe that a significant proportion of an appropriate set of consumers is likely to mistakenly think that the Primark high top shoe is a Vans.

---

[1] The Vans Side Stripe Trademark is a wavy line that runs horizontally along both sides of the shoe. According to the Vans website, the Vans Side Stripe Trademark is used not only on these two lines of shoes, but on other (although not all) Vans products as well, such as clothing.

[2] Additionally, according to the complaint, the Sk8-Hi shoes have "padded corrugated ankle collars."

Goal of the Study

McCarter & English commissioned RL Associates to design and carry out a fair and unbiased test of two issues at the heart of this case. The first issue concerns whether or not the two Vans shoes have acquired secondary meaning among consumers. The second issue concerns whether or not consumers are likely to confuse the source of the two Primark shoes with Vans.

RL Associates translated these concerns into a test of the following four testable hypotheses, broken down by the two types of shoes at issue:

a) Low top shoe cell[3]

1 Consumers who come into contact with a photo of a Vans low top Old Skool shoe will identify it as Vans product.

2 Consumers who come into contact with a photo of a Primark low top shoe will identify it as a Vans product; that is, these consumers are likely to be confused into thinking that the Primark low top shoe is a Vans.

b) High top shoe cell

3 Consumer who come into contact with a photo of a Vans high top Sk8-Hi shoe will identify it as a Vans product.

4 Consumers who come into contact with a photo of a Primark high top shoe will identify it as a Vans product; that is, these consumers are likely to be confused into thinking that the Primark high top shoe is a Vans.

This is a report on the results of those tests.

[3] This study consists of two cells, one geared to low top shoes, and one geared to high top shoes. Aside from the specific stimuli that were used in each of the cells, all of the other test procedures (e.g, universe, screening procedures, questionnaire) used in the two cells were the same.

II – METHODOLOGY

Introduction

Before beginning our discussion of the specific methodology used in this survey, we think it is important to note that the methodology used in any survey research project involves some degree of compromise between conflicting objectives. For instance, on the one hand, there is a desire to completely control the survey process, and on the other hand, a desire to replicate actual market conditions. It is therefore important to keep in mind throughout our discussion of methodology that, of necessity, the procedures used incorporated such compromises.

General Approach

This study centers on people's perceptions of the overall look and feel of a number of shoes. Thus, it was necessary to design a survey in which respondents were able to see the shoes at issue, or more specifically, photos of the shoes at issue.[4] In general, there are three realistic approaches for presenting such material to the general public: in-home interviews, interviews utilizing presentation of material via the Internet, and mall intercept interviews. Extensive testing over a wide range of survey research issues has demonstrated that the results obtained from a well-designed mall intercept study come very close to those achieved under what are considered optimum random sample conditions, but at a much lower cost. For these reasons, the general approach used in this study was mall intercept interviews. We note that regardless of whether a survey is intended for use in litigation or as general market research, mall intercept interviewing is one of the most common ways of doing such surveys, and is generally accepted in the field as valid survey methodology for a study such as this.

Universe and Sample

There are two issues related to drawing an appropriate sample:

1. Defining the proper universe from which to draw the sample.
2. Assuring the sample is drawn in such a way as to be representative of this universe.

---

[4] In this case, we opted to use photos of shoes rather than the shoes themselves, for several reasons. Photos are what people see when they are shopping online, and thus we believe that the use of photos is a reasonable replication of how a significant proportion of consumers would encounter the product in the real world. Furthermore, photos allow us a greater degree of control over the interviewing process. That is, by using photos, we are ensuring that all respondents, regardless of location or interviewer, see the same thing. Finally, photos are both easier to ship, and are less expensive to acquire, than multiple pairs of shoes.

Universe – Our understanding is that, in a study such as this, an appropriate universe is people who are likely to be actual or potential purchasers of the products at issue. We were informed by McCarter & English that the target market for the shoes at issue in this case is comprised primarily of male and female teenagers and young adults. Accordingly, we operationalized the universe for this study as men and women between the ages of 16 and 30.[5]

Sample Frame – As explained above, the methodology used in this study was mall intercept interviews. There were two cells in this study; one cell focused on low top shoes, and the other focused on high top shoes. For each of the two cells, we used one mall in each of the five main census regions (Northeast, Midwest, Southeast, Southwest, and Pacific), for a total of ten locations.

Sample Selection – Interviewers were instructed to attempt to select potential respondents by approaching every third appropriately aged person who walked past them on the mall floor. Potential respondents were first "screened" using several qualifying requirements:

- Respondents had to be between the ages of 16 and 30 years old.
- Respondents could not have participated in an interview in any shopping mall in the past three months.
- Additionally, if respondents said they use glasses or contact lenses to read, they had to have them available for the interview.

Once they had been qualified through the screen questions, respondents were offered an incentive of $5 to participate in the study. Those who agreed to participate were then taken to a private room to be interviewed.

Survey Design

We began this project the way we begin all of the projects we work on, by conducting informal qualitative research, the primary purpose of which is to take us up a learning curve. In the course of conducting the qualitative research phase of this study, we came to believe that, among teenagers and young adults, the two lines of Vans shoes at issue in this case are well-known and identifiable. This understanding informed the specific survey design we chose to use in this

[5] We understand that there are people younger than 16 or older than 30 who may purchase the shoes at issue in this study (e.g., a parent who is purchasing the shoes for his or her child). We believe, however, that the universe we defined for this study constitutes a reasonable and appropriate approximation of the type of people who are most likely to be actual or potential purchasers of the shoes at issue in this case.

study. Specifically, as will be explained in greater detail below, respondents were shown a series of photos of shoes (one at a time and in random order), and asked, on an unaided basis, if they are able to identify the brand of the shoe. That is, respondents not only had to be able to recognize the shoe, but also come up with the brand name on their own.[6] We believe that, from the point of view of Vans, this unaided approach is a very conservative way to test for both secondary meaning and likelihood of confusion.

Stimuli and Controls

a) The Need for Controls

In the vast majority of consumer perception surveys, no matter how well designed, there remain potential sources of errors consisting of artifacts arising from the survey procedure itself (for instance, the tendency of some respondents to "guess"). Taken together, such potential sources of error are commonly referred to as "noise." While it is generally impossible to guarantee that noise has been eradicated in the questionnaire design, it is possible to build design mechanisms into the survey to estimate the noise. Doing so allows for noise to be accounted for (and accordingly removed) in the analysis of the results. In the great majority of cases, such mechanisms are the use of one form or another of controls.

In this case, an important potential source of noise is the possibility that some respondents will identify almost any shoe as a Vans. Thus, we used photos of shoes made by companies other than Vans to estimate the proportion of respondents who, in the context of a survey, will call any shoe a Vans. That is, the photos of the control shoes provide an estimate of the "noise" in this study.

b) Choosing the Controls Used in This Study

Since one cell of this study focused on low top shoes, and the other cell focused on high top shoes, we needed two sets of controls for this study. When it came time for us to select the controls, we looked in both local retail stores and online for shoes that we believed were visually similar in some way to the shoes at issue in this case (e.g., they use a black and white color scheme, and have white midsoles), without being confusingly similar to the Vans shoes at issue.

---

[6] We note here that the name "Vans" appears only once in all of the materials used in this study, specifically, in the last question of the questionnaire, when respondents were presented with an alphabetical list of 14 shoe brands, and asked which of them they had heard of. The name does not appear on the stimuli we used, or in the instructions we sent to the interviewing locations.

In each of the two cells, we wanted to use two brands of shoes that we believed are well-known to respondents (specifically, Adidas and Converse), and two brands that are not (Pony and Bally in the low top cell, and Sperry and Bally in the high top cell).[7] In addition to providing a measure of noise in the study, the two well-known shoe brands were included to serve an additional purpose, namely, so that there would be at least two stimuli that respondents would be able to identify with some degree of certainty, and thus feel that they had successfully completed the task.

b) Stimuli Used in This Study
The basic design methodology used in this study was to expose each respondent to photos of five shoes in all:

Either a Vans shoe or a Primark shoe
and
four controls[8]

c) Stimuli Used in the Low Top Shoe Cell
The Vans low top Old Skool shoe stimulus we used is as follows:

[7] Our belief that Adidas and Converse are both well-known shoe brands (while Pony, Bally and Sperry are not well-known shoe brands) among 16 to 30 year olds was confirmed both by the preliminary qualitative work we did, and, as will be seen later in this report, by the results of this study.

[8] When we sent the study materials to the interviewing services, we included a note in the memo to supervisors asking them to complete one cell (specifically, the Primark shoe cell, although it was not identified as such) before they started the second cell (the Vans shoe cell). We sent the Vans cell questionnaires and stimuli in a sealed envelope with a note that said, "DO NOT OPEN THIS PACKAGE UNTIL THE [OTHER] FORM IS COMPLETE." We did this to ensure that no one at the interviewing site (that is, neither supervisors nor interviewers) saw a Vans shoe before they saw a Primark shoe.

The Primark low top shoe stimulus we used is as follows:

The four controls we used in the low top shoe cell are as follows;

1) Adidas

2) Converse

3) Pony

4) Bally

d) Stimuli Used in the High Top Shoe Cell
The Vans high top Sk8-Hi shoe stimulus we used is as follows:

The Primark high top shoe stimulus we used is as follows:

The four controls we used in the high top shoe cell are as follows;

1) Adidas

2) Converse

3) Sperry

4) Bally

Except for the photo of the Primark high top shoe, all of the shoe photos used in this study were found by us online. We took the photo of the Primark high top shoe that we used. If a name or other word mark appeared on any of the shoes, we edited it out. We informed respondents of this fact in the course of the interview.

Copies of the stimuli used in the Low Top Shoe Cell study are included in Appendix A. Copies of the stimuli used in the High Top Shoe Cell are included in Appendix B.

Questionnaire[9]

Once respondents were in the interview facility, they were read some introductory material urging them not to guess, and then asked two open-ended questions that we included so that we could get a measure of top of mind awareness of Vans:

Q1. *My first question is, what brands of sneakers, if any, have you purchased in the past two or three years? PROBE ONCE WITH: Are there any others?*

Q2. *Aside from the brands of sneakers you purchased in the past two or three years, what other brands of sneakers can you name? PROBE ONCE WITH: Are there any other brands of sneakers you can name?*

Respondents were then told:

I'm now going to show you photos of several sneakers, one at a time and in random order. If a name was visible on the sneaker, we edited it out. You may recognize some of these sneakers, but some you may not. It's OK to tell me that you don't recognize them. After you have had a chance to look at each photo, I'm going to ask if you are able to identify the brand of the sneaker in the photo. Just to remind you, our client would appreciate it if you didn't guess.

The interviewer was then instructed to shuffle the photos in view of the respondent, and hand one of the shuffled photos to the respondent.[10] The interviewer then asked:

Q3b. *Do you think you know the brand of this sneaker, that is, the name of the company that makes it?*

Respondents who answered in the affirmative were asked two follow-up questions:

Q3c. *What do you think is the brand of this sneaker?*

Q3d. *What about the sneaker makes you think it is that brand? Please be as specific as possible. PROBE ONCE WITH: Is there anything else about the sneaker that makes you think it is that brand?*

The interviewer then took the first photo and put it out of sight, handed the respondent the second photo, and repeated the question series described above. All respondents were supposed to see, and answer questions about, a total of five photos. At the end of the interview, all respondents were handed an alphabetical list of sneaker brands and asked which of them they had heard of. The list includes one name – "Bulgur" – that we made up as a way to get a measure of "yea-saying" in the survey. A complete copy of the questionnaire used in the study is included in Appendix C.

---

[9] The same questionnaire was used in both the low top show cell and high top shoe cell.

[10] The instruction to shuffle the photos in view of the respondent was meant to ensure that respondents were aware that they were being shown the stimuli in random order.

Interviewing

Courts have consistently held that surveys require that the interviewing be done by professional interviewers who are shielded from the client sponsoring the work and from the purpose of the study. That is, the interviewing procedures must be "double blind." In this study, the interviewers and their supervisors were never told for whom the study was being conducted. Furthermore, no one at any of the interviewing firms was told the brand names of the shoes in the photos. We believe that in this study the interviewer instructions and, more importantly, the test procedures themselves are transparent, in the sense that an independent observer could not tell who had commissioned the survey.

All interviews were conducted by professional interviewers employed by firms that we consider reliable and trustworthy. Aside from their general training and experience as interviewers, each interviewer was provided with a copy of written instructions which specifically instructed them in the proper procedures for this study. Copies of the memo to the interviewing supervisors and the interviewer instructions that were used in this study are included in Appendix D.

A total of ten interviewing locations were used in this study; five in the low top shoe cell, and five in the high top shoe cell.[11] In the low top shoe cell, each location was instructed to conduct 24 interviews with the Primark low top stimulus, and 12 interviews with the Vans low top stimulus, while in the high top shoe cell, each location was instructed to conduct 16 interviews with the Primark high top stimulus, and 8 interviews with the Vans high top stimulus. The names of the companies that conducted the interviews, and the ten locations where the interviews were conducted are as follows:

[11] We began the interviewing by conducting a two city pilot test in Clearwater, FL and Tukwila, WA. The results from this pilot test are included in this report.

a) Low Top Shoe Cell
Cunningham/Test America – Freehold Raceway Mall in Freehold, NJ (Ballot #s starting "10")
C&C Market Research – Great Northern Mall in North Olmsted, OH (11)
C&C Market Research – Countryside Mall in Clearwater, FL (12)
C&C Market Research – Colorado Mills in Lakewood, CO (13)
Opinions – Solano Mall in Fairfield, CA (14)

b) High Top Shoe Cell
C&C Market Research – Broadway Mall in Hicksville, NY (Ballot #s starting "15")
Opinions – Orland Square Mall in Orland Park, IL (16)
Opinions – Triangle Town Center in Raleigh, NC (17)
C&C Market Research – Deerbrook Mall in Humble, TX (18)[12]
Opinions – Southcenter Mall in Tukwila, WA (19)

All of the interviews in this study were conducted in June 2019.[13]

Validation

In order to ensure that the interviewing was carried out as reported, two members of the RL Associates professional staff independently read and tallied all of the interviews. This practice allows us to look for any patterns in the questionnaires conducted by a particular interviewer (e.g., repetition of an unusual phrase) that indicate that the questionnaires might not have been completed correctly by the interviewer.

In addition, at least 20% of each interviewer's work has been formally validated by AVC Research, an independent interviewing service located in Belvidere, New Jersey. The purpose of this formal validation was to determine whether the respondent recalled participating in the interview, not to verify a respondent's answers to any particular question.

---

[12] Humble, TX only returned 23 of the 24 questionnaires they were asked to complete, and two of those questionnaires were not completed correctly. [In one of the questionnaires, the interviewer did not identify which cards were shown, and in the other questionnaire, the Converse stimulus was shown twice while the Adidas stimulus was not shown at all.] We did not ask Humble to replace those three questionnaires.

[13] According to our records, there are approximately 100 malls in the United States that have an interviewing service on the premises. Prior to booking this study, we used the Vans website to determine how many of those malls also have a Vans store on the premises. We determined that slightly more than 60 of the approximately 100 malls that have an interviewing services also have a Vans store. We believe that, at the time the interviews were conducted, two of the ten malls we used (specifically, the malls in OH and NY) did not have a Vans store on the premises. In our opinion, the data indicates that the presence or absence of a Vans store in the mall had minimal effect on the results of the study.

III – LOW TOP SHOE CELL – DATA AND DISCUSSION

Overview

A total of 297 respondents completed the study.[14] Of those:

60 respondents completed the Vans low top (Old Skool) cell
120 respondents completed the Primark low top cell
40 respondents completed the Vans high top (Sk8-Hi) cell
77 respondents completed the Primark high top cell

After the respondents passed the screen, but before they were shown any photos of shoes, they were asked two open-ended questions that sought to gauge their experience with and awareness of Vans. Of the 297 respondents:

37% said they had purchased Vans in the past two or three years

25% mentioned Vans as one of the brands of sneakers they can name

That is, 62% of the respondents in this study were able to come up with the name Vans on their own, unaided.

An additional 35% of the respondents said they had heard of Vans when, at the end of the interview, they were shown an alphabetical list of 14 sneaker brands and asked which of them they had heard of. Only 3% of the 297 respondents said they had not heard of Vans.

This data confirms what we learned in the qualitative phase of our research, namely, that among teenagers and young adults, Vans shoes are well-known. We believe that this data also offers the first indication that, since such a large fraction of the respondents in this study are familiar with Vans, Vans shoes can be said to have secondary meaning among these people.

---

[14] Recall that, as was noted in Footnote 12, we received three fewer questionnaires than we were expecting from one of the interviewing locations.

Identification of the Vans Low Top Old Skool Shoe

Table I is based on the 60 respondents who completed the Vans low top shoe cell. In this cell, respondents were shown a photo of the Vans Old Skool shoe and four low top shoe controls. The table shows how respondents identified each of the five stimuli they were shown.[15] The first column of the table shows how respondents identified the photo of the Vans low top shoe; the remaining four columns show how respondents identified each of the low top shoes we used as controls.

TABLE I – IDENTIFICATION OF VANS LOW TOP SHOE

	- - - - - - - Photo shown to the respondent - - - - - - -				
	Vans	Pony	Converse	Bally	Adidas
Number of Respondents	(60)	(60)	(60)	(60)	(60)
Correct identification	77%	0	87%	0	88%
Identified as Vans	n/a	7%	7	3%	0
Identified as single other brand	5	7	3	5	5
Other answer	0	0	0	0	2
Not sure	18	87	3	92	5

ALL FIGURES EXCEPT NUMBER OF RESPONDENTS ARE PERCENTAGES
PERCENTAGES MAY NOT ADD TO 100 DUE TO ROUNDING

That is, before noise is taken into account, about three-quarters (77%) of the 60 respondents who were shown a photo of the Vans low top Old Skool shoe identified it as a Vans. We will calculate the noise in the low top cell, and the net of noise results, at the end of this section.

---

[15] When they were handed one of the stimuli, but before they were asked any questions about it, several respondents made a comment indicating something about the brand of the shoe, but then, when they were then asked if they thought they knew the brand of the shoe, they said no or they were not sure. We understood most of these unprompted comments as an indication of "initial interest," and coded them accordingly.

For instance, in the Primark low top shoe cell, when Respondent #12-108 was shown the photo of the Primark shoe, he commented, "Vans almost look[s] like the older version." When he was asked if he knew the brand of the sneaker, he answered not sure. We coded this respondent as identifying the Primark shoe as Vans.

Any coding we did is written on the actual questionnaires.

Identification of the Primark Low Top Shoe

Table II is based on the 120 respondents who completed the Primark low top shoe cell. In this cell, respondents were shown a photo of the Primark low top shoe and four low top shoe controls. The table shows how respondents identified each of the five stimuli they were shown. This table (as well as Tables III and IV in the next section), are set up in the same way as Table I. That is, the first column shows how respondents identified the photo of the shoe of interest (in this case, the Primark low top shoe), and the remaining four columns show how respondents identified each of the (low top) shoes we used as controls.

TABLE II – IDENTIFICATION OF PRIMARK LOW TOP SHOE

	- - - - - - - Photo shown to the respondent - - - - - - -				
	Primark	Pony	Converse	Bally	Adidas
Number of Respondents	(120)	(120)	(120)	(120)	(120)
Correct identification	0	2%	78%	0	80%
Identified as Vans	35%	10	6	4%	0
Identified as single other brand	13	18	2	8	2
Other answer	2	1	0	0	0
Not sure	50	69	15	88	18

ALL FIGURES EXCEPT NUMBER OF RESPONDENTS ARE PERCENTAGES
PERCENTAGES MAY NOT ADD TO 100 DUE TO ROUNDING

That is, before noise is taken into account, about one third (35%) of the 120 respondents who were shown a photo of the Primark low top shoe identified it as a Vans. Respondents gave a range of reasons as to why they identified the Primark low top shoe as a Vans. About half of the respondents mentioned a specific design element (such as the white stripe on the side of the shoe or the stitching), while most of the rest commented on the overall look and feel or style of the shoe.

Calculating the Noise in the Low Top Shoe Cell

As was discussed above, in this case, one potential source of noise is the possibility that some respondents will identify any shoe that shares some characteristics with Vans shoes as a Vans. Thus, one measure of the noise in this study is indicated by the proportion of respondents who identified the control shoes as Vans products.

Recall that, in this cell, respondents saw either the low top Vans shoe and four low top controls or the low top Primark shoe and the same four low top controls. Thus, since we used the same controls in each sub-cell, we can combine them to calculate the estimate of the noise in the low top shoe cell. In this cell, three of the four controls we used – including what we believe (and what is confirmed in the tables above) is a well-known brand, Converse – were identified as a Vans product by 7 or more respondents, specifically:

16 of 180 (9%) respondents called the Pony shoe a Vans
11 of 180 (6%) respondents called the Converse shoe a Vans
7 of 180 (4%) respondents called the Bally shoe a Vans

The fourth control we used – Adidas – was not identified as a Vans by any of the respondents, and so, to be conservative (from the point of view of Vans), we will not include it in our calculation of the noise in this study.

Following normal procedure, we calculate an estimate of the noise in the low top shoe cell by averaging the results for three of the low top control stimuli. Thus, we find that

$$(9\% + 6\% + 4\%) / 3 = 6\%$$

is an estimate of the noise in the low top shoe cell. We can use this estimate of the noise to calculate net of noise results for both the Vans low top shoe and the Primark low top shoe.

Low Top Shoe Cell Net of Noise Results

In order to calculate the unaided net of noise results, following normal procedure, we subtract the estimate of the noise (6%) from the result for each of the stimuli of interest used in this cell.

a) Vans Low Top Old Skool Shoe Cell

Identified Vans Old Skool	- Estimate of low top noise	= Identified Old Skool, net of noise
77%	- 6%	= 71%

That is, net of noise, 71% of the respondents in this cell correctly identified the photo of the Vans low top Old Skool shoe as a Vans.

b) Primark Low Top Shoe Cell

Identified Primark low top	- Estimate of low top noise	= Identified Primark low top, net noise
35%	- 6%	= 29%

That is, net of noise, 29% of the respondents in this cell identified the photo of the Primark low top shoe as a Vans.

IV – HIGH TOP SHOE CELL – DATA AND DISCUSSION

Identification of the Vans High Top SK8-Hi Shoe

Table III is based on the 40 respondents who completed the Vans high top shoe cell. In this cell, respondents were shown a photo of the Vans Sk8-Hi shoe and four high top shoe controls. The table shows how respondents identified each of the five stimuli they were shown.

TABLE III – IDENTIFICATION OF VANS HIGH TOP SHOE

	- - - - - - - Photo shown to the respondent - - - - - - -				
	Vans	Sperry	Converse	Bally	Adidas
Number of Respondents	(40)	(40)	(40)	(40)	(40)
Correct identification	72%	2%	90%	0	65%
Identified as Vans	n/a	8	2	2%	0
Identified as single other brand	2	10	0	15	2
Other answer	0	0	0	0	0
Not sure	25	80	8	82	32

ALL FIGURES EXCEPT NUMBER OF RESPONDENTS ARE PERCENTAGES
PERCENTAGES MAY NOT ADD TO 100 DUE TO ROUNDING

That is, before noise is taken into account, 72% of the 40 respondents who were shown a photo of the Vans high top Sk8-Hi shoe identified it as a Vans. We will calculate the noise in the high top cell, and the net of noise results, at the end of this section.

Identification of the Primark High Top Shoe

Table IV is based on the 77 respondents who completed the Primark high top shoe cell. In this cell, respondents were shown a photo of the Primark high top shoe and four high top shoe controls. The table shows how respondents identified each of the five stimuli they were shown.

TABLE IV – IDENTIFICATION OF PRIMARK HIGH TOP SHOE

	- - - - - - - Photo shown to the respondent - - - - - - -				
	Primark	Sperry	Converse	Bally	Adidas
Number of Respondents	(77)	(77)	(77)	(77)	(77)
Correct identification	0	4%	81%	0	74%
Identified as Vans	68%	6	1	5%	0
Identified as single other brand	5	13	1	14	1
Other answer	1	0	0	0	0
Not sure	26	77	17	81	25

ALL FIGURES EXCEPT NUMBER OF RESPONDENTS ARE PERCENTAGES
PERCENTAGES MAY NOT ADD TO 100 DUE TO ROUNDING

That is, before noise is taken into account, 68% of the 77 respondents who were shown a photo of the Primark high top shoe identified it as a Vans. Respondents gave a range of reasons as to why they identified the Primark high top shoe as a Vans. Overall, more than half of the respondents mentioned a specific design element (such as the white stripe on the side of the shoe or the stitching), while most of the rest commented on the overall look and feel or style of the shoe.

Calculating the Noise in the High Top Shoe Cell

Recall that, in this cell, respondents saw either the high top Vans shoe and four high top controls or the high top Primark shoe and the same four high top controls. Thus, since we used the same controls in each sub-cell, we can combine them to calculate the estimate of the noise in the high top shoe cell. In this cell, three of the four controls we used – including what we believe (and what is confirmed in the tables above) is a well-known brand, Converse – were identified as a Vans product by 2 or more respondents, specifically:

8 of 117 (7%) respondents called the Sperry shoe a Vans
2 of 117 (2%) respondents called the Converse shoe a Vans
5 of 117 (4%) respondents called the Bally shoe a Vans

The fourth control we used – Adidas – was not identified as a Vans by any of the respondents, and so, to be conservative (from the point of view of Vans), we will not include it in our calculation of the noise in this study.

Following normal procedure, we calculate an estimate of the noise in the high top shoe cell by averaging the results for the four high top control stimuli. Thus, we find that

$$(7\% + 2\% + 4\%) / 3 = 4\%$$

is an estimate of the noise in the high top shoe cell. We can use this estimate of the noise to calculate net of noise results for both the Vans high top shoe and the Primark high top shoe.

High Top Shoe Cell Net of Noise Results

As was the case in the low top shoe cell, in order to calculate the unaided net of noise results, following normal procedure, we subtract the estimate of the noise (4%) from the result for each of the stimuli of interest used in this cell.

a) Vans High Top Sk8-Hi Shoe Cell

Identified Vans Sk8-Hi	- Estimate of high top noise	= Identified Sk8-Hi, net of noise
72%	- 4%	= 68%

That is, net of noise, approximately three-quarters (68%) of the respondents in this cell correctly identified the photo of the Vans high top Sk8-Hi shoe as a Vans.

b) Primark High Top Shoe Cell

Identified Primark high top	- Estimate of high top noise	= Identified Primark high top, net noise
68%	- 4%	= 64%

That is, net of noise, close to two-thirds (64%) of the respondents in this cell identified the photo of the Primark high top shoe as a Vans.

V – CONCLUSIONS

The Conservative Nature of the Test

We emphasize here that the net of noise results were achieved in a test that for a couple of reasons was very conservative from the point of view of Vans. First, the study was conducted among all consumers between the ages of 16 and 30. That is, the universe was not confined to people who were familiar with Vans, or limited in any other way. Second, the study was unaided; that is, when presented with the photos of the shoes, respondents had to be able to recognize the shoes and come up with the brand name on their own. We believe that such an approach is a very strict way of measuring both secondary meaning and likelihood of confusion.

Conclusion

The results of this test show that, net of noise:

- 71% of the respondents in this study correctly identified the photo of the Vans low top Old Skool shoe as a Vans, and
- 68% of the respondents in this study correctly identified the photo of the Vans high top Sk8-Hi shoe as a Vans.

In our experience, courts have always held that results at this level, especially when obtained in a test as conservative as this, are strong evidence of acquired secondary meaning.

The results of this test also show that, net of noise:

- 29% of the respondents in this study identified the photo of the Primark low top shoe as a Vans, and
- 64% of the respondents in this study identified the photo of the Primark high top shoe as a Vans.

In our experience, courts have always held that results at this level, especially when obtained in a test as conservative as this, are strong evidence of likelihood of confusion as to source.

VI – PERSONNEL AND REMUNERATION

Michael Rappeport was responsible for all aspects of this survey. Dr. Rappeport's resume, including cases and publications, is attached as Appendix E.

RL Associates is being compensated $92,000 for work done on this project. Dr. Rappeport's hourly compensation rate for time spent subsequent to this report is $850/hour.

Michael Rappeport August 9, 2019
Michael Rappeport

EXHIBIT 6

United States of America

United States Patent and Trademark Office

Reg. No. 6,309,462

Registered Mar. 30, 2021

Int. Cl.: 25

Trademark

Principal Register

Vans, Inc. (DELAWARE CORPORATION)
1588 South Coast Drive
Costa Mesa, CALIFORNIA 92626

CLASS 25: footwear

FIRST USE 00-00-1977; IN COMMERCE 00-00-1977

The color(s) red and white is/are claimed as a feature of the mark.

The mark consists of a rectangular label featuring the mark "VANS "OFF THE WALL"" in white on a red representation of a skateboard with white wheel detail and a white line under ""OFF THE WALL"", all on a white background. The dotted outline of the footwear is not claimed as part of the mark and is intended only to show the position of the mark.

SER. NO. 88-206,499, FILED 11-27-2018

UNITED STATES PATENT AND TRADEMARK OFFICE · DEPARTMENT OF COMMERCE

Performing the Functions and Duties of the
Under Secretary of Commerce for Intellectual Property and
Director of the United States Patent and Trademark Office

REQUIREMENTS TO MAINTAIN YOUR FEDERAL TRADEMARK REGISTRATION

WARNING: YOUR REGISTRATION WILL BE CANCELLED IF YOU DO NOT FILE THE DOCUMENTS BELOW DURING THE SPECIFIED TIME PERIODS.

Requirements in the First Ten Years*
What and When to File:

- ***First Filing Deadline:*** You must file a Declaration of Use (or Excusable Nonuse) between the 5th and 6th years after the registration date. See 15 U.S.C. §§1058, 1141k. If the declaration is accepted, the registration will continue in force for the remainder of the ten-year period, calculated from the registration date, unless cancelled by an order of the Commissioner for Trademarks or a federal court.

- ***Second Filing Deadline:*** You must file a Declaration of Use (or Excusable Nonuse) and an Application for Renewal between the 9th and 10th years after the registration date.* See 15 U.S.C. §1059.

Requirements in Successive Ten-Year Periods*
What and When to File:

- You must file a Declaration of Use (or Excusable Nonuse) and an Application for Renewal between every 9th and 10th-year period, calculated from the registration date.*

Grace Period Filings*

The above documents will be accepted as timely if filed within six months after the deadlines listed above with the payment of an additional fee.

***ATTENTION MADRID PROTOCOL REGISTRANTS:** The holder of an international registration with an extension of protection to the United States under the Madrid Protocol must timely file the Declarations of Use (or Excusable Nonuse) referenced above directly with the United States Patent and Trademark Office (USPTO). The time periods for filing are based on the U.S. registration date (not the international registration date). The deadlines and grace periods for the Declarations of Use (or Excusable Nonuse) are identical to those for nationally issued registrations. See 15 U.S.C. §§1058, 1141k. However, owners of international registrations do not file renewal applications at the USPTO. Instead, the holder must file a renewal of the underlying international registration at the International Bureau of the World Intellectual Property Organization, under Article 7 of the Madrid Protocol, before the expiration of each ten-year term of protection, calculated from the date of the international registration. See 15 U.S.C. §1141j. For more information and renewal forms for the international registration, see http://www.wipo.int/madrid/en/.

NOTE: Fees and requirements for maintaining registrations are subject to change. Please check the USPTO website for further information. With the exception of renewal applications for registered extensions of protection, you can file the registration maintenance documents referenced above online at http://www.uspto.gov.

NOTE: A courtesy e-mail reminder of USPTO maintenance filing deadlines will be sent to trademark owners/holders who authorize e-mail communication and maintain a current e-mail address with the USPTO. To ensure that e-mail is authorized and your address is current, please use the Trademark Electronic Application System (TEAS) Correspondence Address and Change of Owner Address Forms available at http://www.uspto.gov.

EXHIBIT 7

United States of America

United States Patent and Trademark Office

Reg. No. 6,309,463

Registered Mar. 30, 2021

Int. Cl.: 25

Trademark

Principal Register

Vans, Inc. (DELAWARE CORPORATION)
1588 South Coast Drive
Costa Mesa, CALIFORNIA 92626

CLASS 25: footwear

FIRST USE 00-00-1977; IN COMMERCE 00-00-1977

The color(s) red and white is/are claimed as a feature of the mark.

The mark consists of a rectangular label featuring the mark "VANS "OFF THE WALL"" in red on a white representation of a skateboard with red wheel detail and a red line under ""OFF THE WALL"", all on a red background. The dotted outline of the footwear is not claimed as part of the mark and is intended only to show the position of the mark.

SER. NO. 88-206,504, FILED 11-27-2018

UNITED STATES PATENT AND TRADEMARK OFFICE · DEPARTMENT OF COMMERCE

Performing the Functions and Duties of the
Under Secretary of Commerce for Intellectual Property and
Director of the United States Patent and Trademark Office

REQUIREMENTS TO MAINTAIN YOUR FEDERAL TRADEMARK REGISTRATION

WARNING: YOUR REGISTRATION WILL BE CANCELLED IF YOU DO NOT FILE THE DOCUMENTS BELOW DURING THE SPECIFIED TIME PERIODS.

Requirements in the First Ten Years*
What and When to File:

- ***First Filing Deadline:*** You must file a Declaration of Use (or Excusable Nonuse) between the 5th and 6th years after the registration date. See 15 U.S.C. §§1058, 1141k. If the declaration is accepted, the registration will continue in force for the remainder of the ten-year period, calculated from the registration date, unless cancelled by an order of the Commissioner for Trademarks or a federal court.

- ***Second Filing Deadline:*** You must file a Declaration of Use (or Excusable Nonuse) and an Application for Renewal between the 9th and 10th years after the registration date.* See 15 U.S.C. §1059.

Requirements in Successive Ten-Year Periods*
What and When to File:

- You must file a Declaration of Use (or Excusable Nonuse) and an Application for Renewal between every 9th and 10th-year period, calculated from the registration date.*

Grace Period Filings*

The above documents will be accepted as timely if filed within six months after the deadlines listed above with the payment of an additional fee.

***ATTENTION MADRID PROTOCOL REGISTRANTS:** The holder of an international registration with an extension of protection to the United States under the Madrid Protocol must timely file the Declarations of Use (or Excusable Nonuse) referenced above directly with the United States Patent and Trademark Office (USPTO). The time periods for filing are based on the U.S. registration date (not the international registration date). The deadlines and grace periods for the Declarations of Use (or Excusable Nonuse) are identical to those for nationally issued registrations. See 15 U.S.C. §§1058, 1141k. However, owners of international registrations do not file renewal applications at the USPTO. Instead, the holder must file a renewal of the underlying international registration at the International Bureau of the World Intellectual Property Organization, under Article 7 of the Madrid Protocol, before the expiration of each ten-year term of protection, calculated from the date of the international registration. See 15 U.S.C. §1141j. For more information and renewal forms for the international registration, see http://www.wipo.int/madrid/en/.

NOTE: Fees and requirements for maintaining registrations are subject to change. Please check the USPTO website for further information. With the exception of renewal applications for registered extensions of protection, you can file the registration maintenance documents referenced above online at http://www.uspto.gov.

NOTE: A courtesy e-mail reminder of USPTO maintenance filing deadlines will be sent to trademark owners/holders who authorize e-mail communication and maintain a current e-mail address with the USPTO. To ensure that e-mail is authorized and your address is current, please use the Trademark Electronic Application System (TEAS) Correspondence Address and Change of Owner Address Forms available at http://www.uspto.gov.

UNITED STATES DISTRICT COURT
EASTERN DISTRICT OF NEW YORK

VANS, INC. and VF OUTDOOR, LLC, Plaintiffs, v. MSCHF PRODUCT STUDIO, INC., Defendant.	Case No. 22-cv-02156-WFM-RML JURY TRIAL DEMANDED

DECLARATION OF MATTHEW G. ROSENDAHL IN SUPPORT OF PLAINTIFFS' MOTION FOR TEMPORARY RESTRAINING ORDER AND PRELIMINARY INJUNCTION

I, Matthew G. Rosendahl, declare and state as follows:

1. I am a member of the bar of the Commonwealth of Virginia, with a forthcoming motion for admission *pro hac vice* before the Court, an attorney at the law firm of McGuireWoods LLP, and counsel for Plaintiffs Vans, Inc. and VG Outdoor, LLC (collectively, "Vans") in this action. I submit this Declaration in support of Vans' Motion for a Temporary Restraining Order and Preliminary Injunction against Defendant MSCHF Product Studio, Inc. ("MSCHF").

2. The information contained in this Declaration comes from my own personal knowledge and belief. If called as a witness, I am competent to testify to the matters declared herein.

3. As part of my work in connection with this case, I researched news articles and publications regarding Defendant MSCHF Product Studio, Inc.'s "Wavy Baby" shoes, as well as its business practices.

4. As part of that research, I discovered several third-party articles that directly compared the Wavy Baby shoes with Vans' Old Skool shoe design. As just an example, the online magazine *Input* wrote an article titled "MSCHF and Tyga's 'Wavy Baby' Sneakers Seriously Distort Classic Vans," in which it stated that the "'Wavy Baby' . . . features a black upper, a much curvier version of Vans' signature Jazz Stripe, white midsole, and a gum waffle outsole," noting also that it was "impossible to ignore the sneakers' heavy resemblance to Vans' classic Old Skool silhouette." Meanwhile, *HighSnobiety* released a feature on the Wavy Baby shoes titled "MSCHF & TYGA'S INSANE SKATE SHOES LOOK LIKE LIQUIFIED VANS." And *Metcha* referred to the shoes in its article as "The MSCHF x Vans Baby Wave." True and correct copies of screen captures of the above articles are attached hereto as **Exhibit 1**.

I declare under penalty of perjury under the laws of the United States of America that the foregoing is true and correct to the best of my knowledge.

Executed on April 14, 2022

/s/ Matthew G. Rosendahl
Matthew G. Rosendahl

EXHIBIT 1

Andrea Carrillo

4.11.2022 10:59 AM

STYLE

MSCHF and Tyga's 'Wavy Baby' sneakers seriously distort classic Vans

Warning: This skate shoe is not intended for skating.

There's often more to a sneaker collaboration than meets the eye, and when MSCHF is involved, almost all of the traditional rules are thrown out the window. Hot on the heels of a vinyl saw blade with The Weeknd, the Brooklyn art collective has added Tyga to its running list of partnerships. The two are coloring outside the lines with a nonlinear take on a classic Vans skate shoe.

MORE LIKE THIS

Andrea Carrillo 4.8.2022 12:50 PM
STYLE
Billie Eilish's Nike Air Force 1 sneaker is just begging you to strap in

Maya Ernest 4.5.2022 3:18 PM
'LEGACY'
Virgil Abloh was so much more than a 'hip-hop fashion designer'

Andrea Carrillo 3.30.2022 3:36 PM
STYLE
Air Jordan 1 sneakers are about to get more expensive

MAKING WAVES — Aptly named "Wavy Baby," the sneakers feature a black upper, a much curvier version of Vans' signature Jazz Stripe, white midsole, and a gum waffle outsole. Canvas and suede make up the materials, and a red heel tag boasts a "Wavy Baby" logo created just for the occasion. To round out the remixed kicks, the platform soles are given a squiggly shape from heel to toe that looks like it'd take some practice to get used to.

MSCHF

It's impossible to ignore the sneakers' heavy resemblance to Vans' classic Old Skool silhouette, but they're just unique enough to pass as their own unique creation. MSCHF told *Highsnobiety* last month that it wasn't easy bringing them to life and the process involved "a ton of trial and error." Several manufacturers weren't keen on getting involved in the Wavy Baby project and rejected MSCHF's requests immediately after seeing the sketches.

Even though the curved kicks take after the popular skate shoes, MSCHF covers its bases by adding a full disclaimer to its website: "Warning: Extremely Wavy. By placing your foot in this shoe, you agree to waive any claims against MSCHF for any injury, death, or damages arising from having your foot in this shoe."

MSCHF

MSCHF

MSCHF

Tyga's past collaborations have stretched from fast-fashion retailer BoohooMan to Milanese brand Marcelo Burlon to skate label LA Gear, but joining MSCHF's roster could open the door for more. He also sneakily debuted the shoes during his feature on Doja Cat's music video for "Freaky Deaky."

The $220 MSCHF x Tyga "Wavy Baby" sneakers will drop at 12 p.m. EST April 18 via the MSCHF sneakers app. Because the art collective is known for more adventurous and scandalous ideas (see: Satan Shoes, Birkin bag sandals, Chik-fil-A Sunday pranks), these heavily distorted Vans are on the much more tame side.

© MSCHF 1 / 3

MSCHF & TYGA'S INSANE SKATE SHOES LOOK LIKE LIQUIFIED VANS

8 DAYS AGO IN SNEAKERS
WORDS BY JAKE SILBERT

When MSCHF elected to launch its in-house footwear collection with the TAP3 sneaker, it barely scratched the surface of its truly insane shoe designs. The "Wavy Baby" is, arguably, an even better introduction to the ingenious kicks that MSCHF's cooked up.

Now, the TAP3 was admittedly a mere taste of what's to come, barely even an appetizer and certainly not the sole entrée (though it was very much a labor of love). The "Wavy Baby" is much more indicative of forthcoming MSCHF Sneakers drops.

Releasing April 18 on the MSCHF Sneakers app for $220 apiece, MSCHF's "Wavy Baby" is the antithesis of contemporary signature sneakers.

Whereas nearly every big footwear brand creates the special shoes designated to pop culture titans and athletes by tweaking an existing mold or, occasionally, creating something distinct (yet ultimately familiar), the "Wavy Baby" is unlike any shoe that's ever come before it.

And, like any good signature sneaker, the "Wavy Baby" is aligned with yet another one of MSCHF's famous friends and it ain't Lil Nas X or Grimes (MSCHF sure knows a lotta famous folks).

Tyga, Doja Cat - Freaky Deaky (Official Video)
Share
Watch on YouTube

As you can tell from the campaign shots, MSCHF made the "Wavy Baby" with its pal Tyga, who's on a bit of a hot streak right now.

His latest single, "Freaky Deaky," featured Doja Cat while also sneakily revealing the "Wavy Baby" shoes to the world.

© MSCHF 1 / 4

MSCHF told Highsnobiety in March 2022 that it took a ton of trial and error to create the "Wavy Baby" and plenty of manufacturers immediately rejected MSCHF's requests to create this bizarre wobbly shoe based on sketches alone.

But nothing good comes easy. The effort paid off in spades: the "Wavy Baby" is a verifiable work of art and, somehow, entirely wearable.

HIGHLIGHTS

Everyone Hates SHEIN But No One Wants to Stop Buying It
Rihanna's Baby Has a Furry New Friend
PSA: Leggings Are Pants Again
Telfar & Eastpak's Not-So-Secret Collab Is Dropping Again Soon
Nightmare Blunt Rotation: Kim, Pete & Jeff Bezos

However, though the sneaker is clearly skate shoe-inspired, you proooooobbbbbaabbly don't wanna skate it according to a disclaimer on MSCHF's site: "Warning: By placing your foot in this shoe, you agree to waive any claims against MSCHF for any injury, death, or damages arising from having your foot in this shoe."

View this post on Instagram

"We've always known that sneakers are this culturally spicy object, sitting at the focal point of a lot of things," MSCHF co-founder Daniel Greenberg said last month when the TAP3 kicked off MSCHF Sneakers.

"But the sneaker landscape is so incredibly stale. If we were going to collaborate with a sneaker brand, they'd have to break open a new mold: we're not just doing a MSCHF colorway."

© MSCHF 1 / 5

The "Wavy Baby" is entirely original from top to bottom and juuuuuust distinct enough — even setting the waviness aside — to be a legally dissimilar to the famous canvas sneakers that inspired its design.

It looks like a very familiar pair of skate sneakers — complete with midsole stripe, red heel tab and waffle outsole — that's been run through a Photoshop filter like Liquify, except it's real and very, very difficult to manufacture.

© MSCHF 1 / 5

It's crazy to say but, as insane as the "Wavy Baby" sneakers are, they're merely the tip of the MSCHF Sneakers iceberg.

Things only get wilder from here.

MSCHF

Jake Silbert
News Editor

WE RECOMMEND

Odes to Pregnant Rihanna, LV Ties, Supreme SS22 & MSCHF's Sneakers
(CULTURE) 1 MONTH AGO

Who Better Than J. Balvin to Flex Tyga & MSCHF's "Wavy" Sneakers?
(CULTURE) 3 DAYS AGO

MSCHF's New Drop Is Illegal (on Purpose This Time)
(CULTURE) 3 MONTHS AGO

Suicoke & Midorikawa Drop Horrifyingly Fleshy Toenail Shoes
(SNEAKERS) 5 MONTHS AGO

Nike Accused of Shredding Brand New Shoes
(SNEAKERS) 5 MONTHS AGO

Shoe Palace's New Balance 327 Reminds Us We're Stronger Together
(SNEAKERS) 5 MONTHS AGO

WHAT TO READ NEXT

Kiko Scores Another Home Run With the ASICS UB3-S GEL-NIMBUS 9
(SNEAKERS) 25 MINUTES AGO

From Stone Island to Snow Peak: Our Staffers Pick Spring Hiking Fits
(STYLE) 1 HOUR AGO

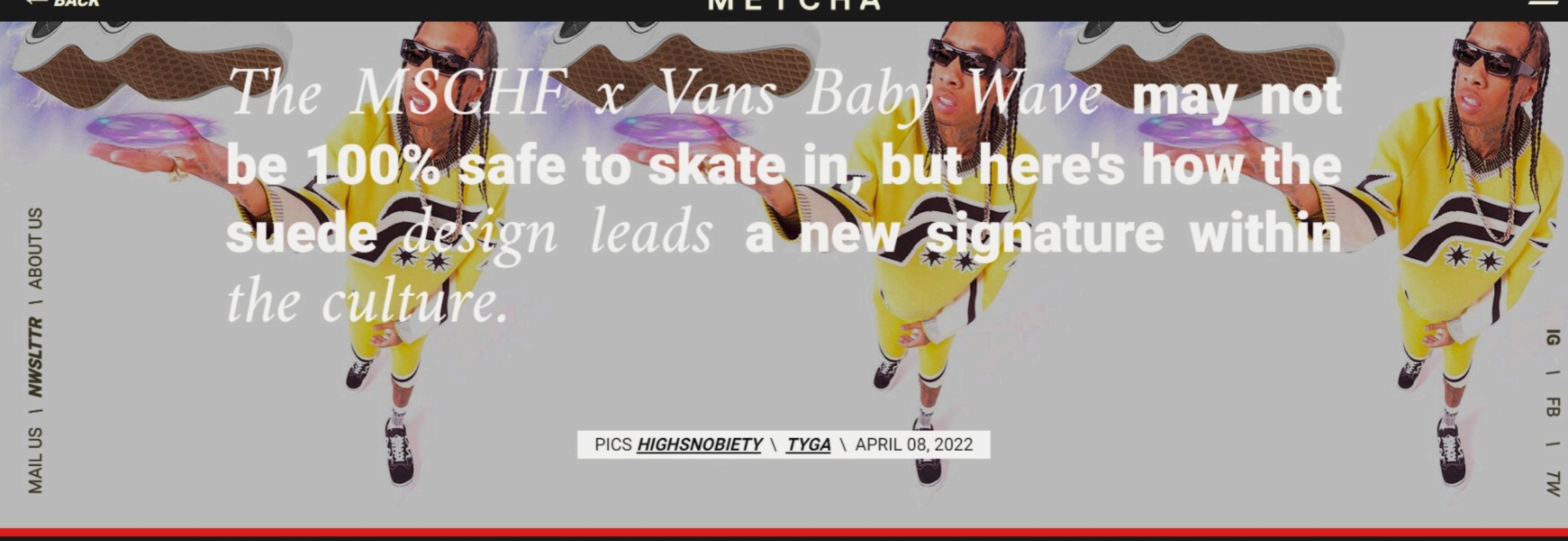
Palm Angels Sunglasses Return for Spring/Summer 2022
(STYLE, SPONSORED) 1 HOUR AGO

Time Machines Look a Lot Like Fred Perry & Nicholas Daley's SS22 Collection
(STYLE) 2 HOURS AGO

How to Get Fits Off in Wedding Season
(STYLE) 3 HOURS AGO

Will You Wear Your A-COLD-WALL* x ROAs Hiking? Unlikely
(SNEAKERS) 3 HOURS AGO

← BACK METCHA



The MSCHF x Vans Baby Wave **may not be 100% safe to skate in, but here's how the suede** *design leads* **a new signature within** *the culture.*

MAIL US \ NWSLTTR \ ABOUT US

IG \ FB \ TW

PICS ***HIGHSNOBIETY*** \ ***TYGA*** \ APRIL 08, 2022

Many manufacturers turned down

Tyga, Doja Cat - Freaky Deaky (Official Video)

Share

Watch on YouTube

Part of *the Brooklyn-based* **collective's in-house footwear collection with** *TAP3*, **they go beyond a** *simple design* **to offer us insane takes** *on creativity.*

Releasing on *April 18* **for US$ 220, the Wavy Baby introduces us to their forthcoming drops, predicting what could be a distinguished signature within the** *sneakerhead culture.*

Although *the skateboard-inspired* **uppers are well-know among the community —** *the Vans' midsole stripe and waffle* **outsole are still there — this launch features a Photoshop's liquified-like** *effect that makes* **it unlike any other pair.**

After **tons of trials and errors, the original silhouette surpassed** *the primary sketches* **to become a totally wearable** *shoe* **for those willing to** *go extra.*

But not before carefully reading MSCHF's disclaimer: *"Warning: By placing your foot in this shoe, you agree to waive any claims against MSCHF for any injury, death, or damages arising from having your foot in this shoe."*

Would *you cop* it after reading that?

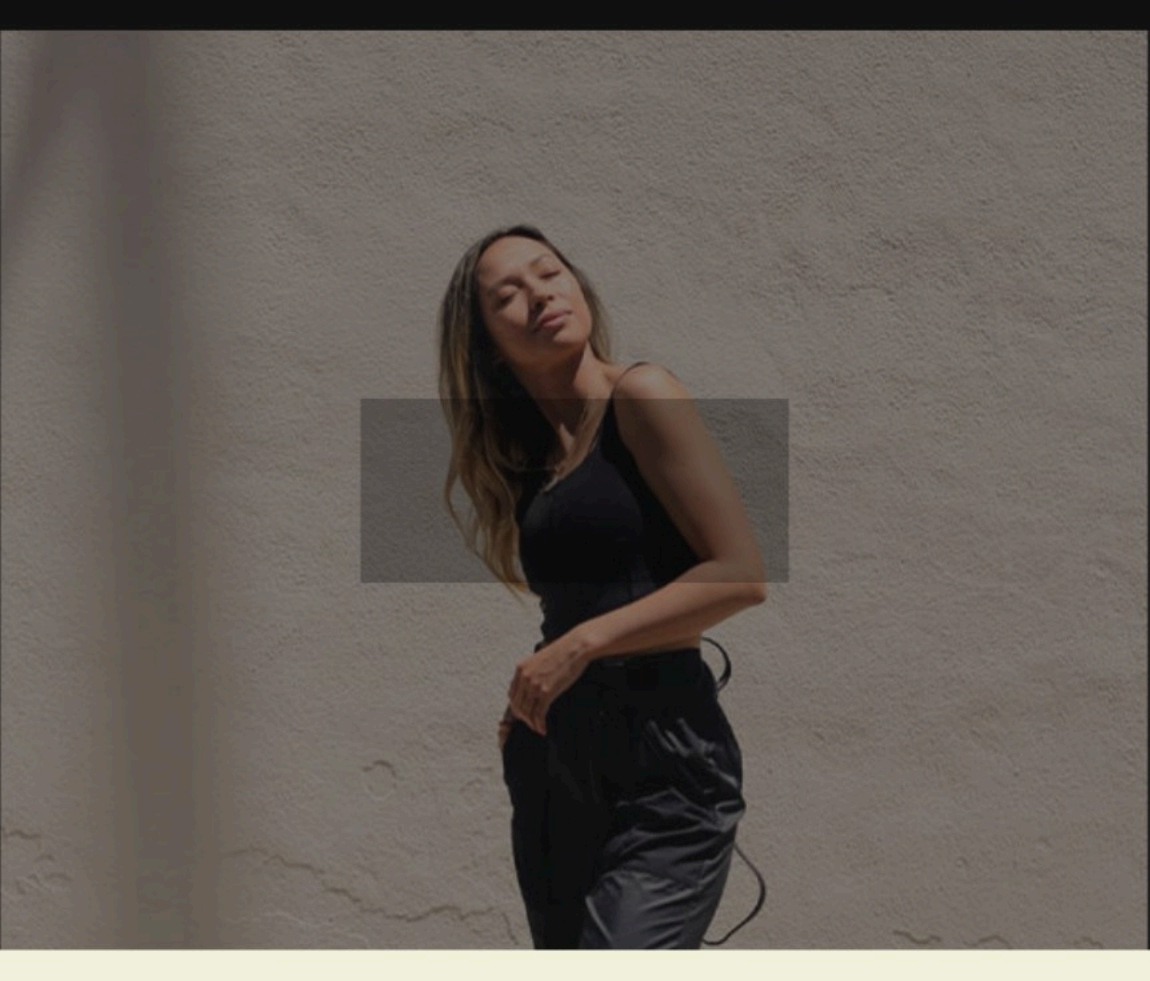
Find **how** *soccer player* **Shawna Gordon scores off** *the field* **with anticipated** *snkrs.*

\ Pics
HIGHSNOBIETY
TYGA

SHARE

FACEBOOK \ ***PINTEREST*** \ *TWITTER* \ ***WHATSAPP*** \ *LINKEDIN* \ ***MESSAGE*** \ *COPY LINK*

CLICK TO FOLLOW US ON IG



TO KEEP THE STORIES COMING

EMAIL

UNITED STATES DISTRICT COURT
EASTERN DISTRICT OF NEW YORK

VANS, INC. and VF OUTDOOR, LLC, Plaintiffs, v. MSCHF PRODUCT STUDIO, INC., Defendant.	Case No. 22-cv-02156-WFM-RML JURY TRIAL DEMANDED

DECLARATION OF JUSTIN REGAN IN SUPPORT OF PLAINTIFFS' MOTION FOR TEMPORARY RESTRAINING ORDER AND PRELIMINARY INJUNCTION

I, Justin Regan, declare and state as follows:

1. This declaration is based upon my personal knowledge of the facts or on business records that were made in the regular course of business. If called as a witness, I could and would testify to the statements made herein.

2. I am the Director of Global Product Marketing Strategy at Vans, a division of VF Outdoor, LLC, where I oversee global strategic product marketing activities. I have worked at Vans for over 10 years. My team is responsible for selecting, prioritizing, and aligning the marketing strategies for Vans products around the globe. As part of my role, I coordinate and work with teams in brand & sports marketing, brand comms, operations, and analytics.

3. Founded in March 1966, Vans, Inc. is a corporation organized under the laws of the State of Delaware, having its principal place of business at 1588 South Coast Drive, Costa Mesa, California 92626. VF Outdoor, LLC, the parent company of Vans, Inc., is a limited liability company organized under the laws of Delaware, having its principal place of business at 1551 Wewatta Street, Denver, Colorado 80202. These entities are sometimes referred to herein collectively as "Vans."

4. As part of my role at Vans, I am intimately familiar with Vans' products, including its Old Skool shoes, and I am knowledgeable of or have access to business records concerning all of the information in this declaration, including Vans' promotional efforts, media coverage, references in popular culture and analytics.

5. Vans' principal business activity is the design, development, and worldwide marketing and selling of footwear, apparel, equipment, and accessories.

6. Vans is the largest single action sports brand in the world and the largest company rooted in skateboarding.

7. Vans extensively promotes its trademarks and trade dress rights, including but not limited to the rights embodied in Vans Old Skool shoes and the related trademarks.

8. Vans advertises its brand and products through a wide variety of methods, including print publications, catalogs, and television advertisements, internet advertisements, signage, in-store displays, and social media, among other advertising mediums.

9. As described further below, Vans has spent many millions of dollars on advertisements highlighting the Vans shoes discussed herein and has also featured the shoes in high-traffic website and social media sites, where millions of consumers have seen or purchased Vans' shoes.

10. Vans website (www.vans.com) routinely receives millions of visits each month, with many of those visits specifically to webpages involving the Old Skool shoes.

11. In addition to its website, Vans extensively promotes its products on Vans' social media webpages. Vans has over 38 million combined followers on its official accounts on Facebook, Twitter, Instagram, TikTok, and Pinterest. Vans routinely features and promotes its shoes, including the Old Skool shoes, in its posts on social media. Vans' social media posts about its shoes, including the Old Skool, often receive tens of thousands of likes from consumers.

12. As described further below, Vans also goes to great lengths to increase brand recognition and promote its shoes through sponsoring events or athletes. During its history, Vans has promoted a wide variety of events, including the Vans Warped Tour, US Open Surfing, and House of Vans, just to name a few.

13. One of Vans' most recognizable pieces of branding is the Side Stripe trademark. Over 40 years ago, Vans began using the Side Stripe trademark as a logo on some of its shoes.

Since then, Vans has used the Side Stripe trademark on a variety of shoes, including across various product lines. Examples of Vans footwear bearing the Side Stripe trademark are depicted below:

Vans OLD SKOOL

Vans SK8-HI

Vans UltraRange Exo

Vans Sk8-Mid

Vans MTE (Mountain Edition) Boot

Vans Snowboard Boot

14. Vans has devoted significant resources to advertising and promoting its products bearing the Side Stripe. Over the past four-plus decades, Vans has spent tens of millions of dollars advertising footwear adorned with the Side Stripe trademark, including in print publications, television and internet advertising, signage, in-store displays, and social media,

among other advertising mediums. Based on our analytics, Vans' advertisements and marketing efforts have reached billions of individual consumers during that time.

15. Vans also promotes products bearing the Side Stripe by sponsoring athletes. As one example, skateboarding legend Tony Hawk has a partnership with Vans and can often be seen wearing Vans with the Side Stripe. A true and correct photograph of Tony Hawk wearing shoes with the Side Stripe is reproduced below:

16. Over the past several decades, Vans further promoted the Side Stripe by sponsoring events. For example, in 1996, Vans started sponsoring (and later purchased) the Vans Warped Tour, which went on to become the longest running concert series in the United States. The Vans Warped Tour operated annually every year until 2019. Vans' sponsorship and ownership of the Vans Warped Tour not only provided a forum for Vans to promote its products bearing the Side Stripe, but also helped Vans forge close relationships with musical artists who

then prominently wore Vans shoes during their performances. Blink-182's Mark Hoppus, for example, wore Vans shoes bearing the Side Stripe during multiple now-famous performances at the Vans Warped Tour and at other concerts throughout the past three decades. A representative image from a Blink-182 performance in the 1990s is depicted below:

17. As a result of Vans' promotional and sales efforts of the past four-plus decades, the Side Stripe trademark is among the most recognizable, iconic, and valuable trademarks in the world.

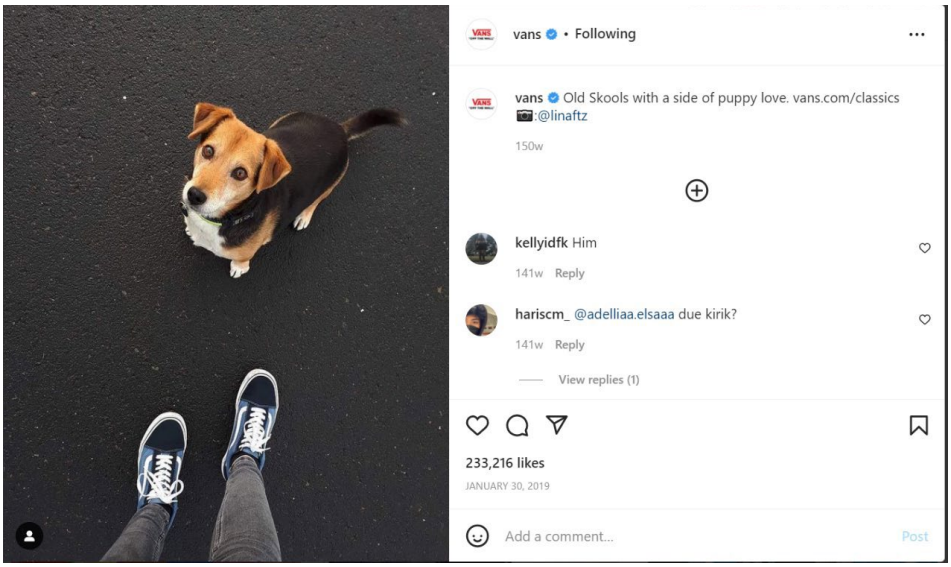
18. As a result of Vans' efforts, the public recognizes and understands that the Side Stripe distinguishes and identifies Vans' products. As just an example, third party publications and media reports routinely refer to Vans' "iconic side stripe, which has become a hallmark design characteristic for the brand"; the "now-iconic side stripe"; and Vans' "famous side stripe detail." True and correct copies of third-party publications mentioning the strength of Vans' Side Stripe trademark are attached collectively hereto as **Exhibit 1**.

19. In 1977, the Old Skool shoe debuted and was the first shoe to incorporate the Side Stripe. Since 1977, Vans has continuously sold and promoted the Old Skool shoe.

20. Over the past 44 years, Vans has spent tens of millions of dollars promoting the Old Skool shoe line. Vans advertises the Old Skool shoe through a wide variety of traditional and non-traditional means, including print, television, and internet advertising, event

sponsorship, and athlete endorsement, to name a few. A true and correct copy of an advertisement published in 1994 for the Old Skool shoe is attached as **Exhibit 2**.

21. On social media, Vans regularly promotes its Old Skool shoes through original posts, as well as by reposting images from Vans' consumers. An example post from Vans' Instagram account is included below:



22. Over 40 years since the introduction of the Old Skool shoe, the Old Skool remains immensely popular and has been growing in popularity. A true and correct copy of an unsolicited 2018 article in *W Magazine* discussing the Old Skool is attached hereto as **Exhibit 3**. The article named the Old Skool as the "most popular shoe of the summer." A true and correct copy of an unsolicited *GQ* article is attached as **Exhibit 4**. *GQ* remarked that the Old Skool shoe had become "the go-to shoe for members of every fashion tribe." And a true and correct copy of an article from Business Insider is attached hereto as **Exhibit 5**. In the unsolicited article, Business Insider observed that the Old Skool shoe was "blowing up the fashion world" and had "surpassed its humble roots to become an icon in its own right."

23. According to analytics available online, the Old Skool shoe is one of the most sought-after sneakers in the world. In 2017, Online fashion sales website Lyst found that the Old Skool shoe was the No. 4 most searched sneaker in the world. A true and correct copy of an article discussing this finding is attached hereto as **Exhibit 6**. Meanwhile, according to a 2019 research study by SEMrush, the Old Skool shoe was the No. 3 most popular search on Google in the United States within the previous 12 months. A true and correct copy of an article with these results is attached hereto as **Exhibit 7**.

24. Over the years, Old Skool shoes have been worn and popularized by countless athletes, pop stars, rappers, artists, and other influential celebrities, including but not limited to Frank Ocean, Justin Bieber, Kanye, A$AP Rocky, Tyler, the Creator, Russel Westbrook, Julia Roberts, Paul Walker, Gwen Stefani, Miguel, Olivia Wilde, Kylie Jenner, and Kristen Stewart.

25. In addition, the Old Skool shoe has appeared in a variety of television shows and movies. By way of example only, Vin Diesel wore Old Skool shoes as Xander Cage in the 2002 film *xXx*, as depicted below:

26. Old Skool shoes have also appeared in television shows such as *Friends*, *Modern Family*, *Animal Kingdom*, and *Ted Lasso*, and appeared on the feet of rapper Mac Miller in his

music video "Good News," G-Eazy in his music video "Power," and Machine Gun Kelly in his music video "Bloody Valentine." In short, Vans' Old Skool shoes have become an iconic part of pop culture.

27. As a featured part of its Old Skool shoes, Vans includes on the rear sole its "Vans Off the Wall" logo, as shown in the below image:

28. As with its Old Skool shoes, Vans spend millions promoting shoe featuring the Vans Off the Wall Logo shown above, including through tradition and non-traditional advertisements. As a result, the public has come to recognize the Off the Wall logo as identifying Vans and its products, in much the same way as it recognizes the design of Old Skool shoe itself.

29. In addition to the celebrity features described above, Vans also invests millions of dollars a year in collaborations and endorsement deals with celebrities, including Anderson Paak, Metallica, A$AP Rocky, Tierra Whack, and the Foo Fighters. These partnerships include collaborations on limited-edition releases of Vans' shoes, including the Old Skool, as well as seed placements on social media. Vans' collaboration strategy relies on a curated and targeted list of carefully selected celebrities who embody Vans' strategic and corporate values. Vans'

collaboration strategy is particularly focused on celebrities in the music industry, in recognition of music's place as a Vans brand pillar and its popularity among Vans' consumer base.

30. Both Vans' collaborations and its general shoe designs include playful skews of its own branding, including for example Vans' display of its own stylized Vans logo on the footbed of its shoes, as shown in the below image:

31. In sum, Vans has spent many years, as well as significant investments in money and effort, to carefully craft its brand and image and the image and reputation for the Old Skool shoe, Side Stripe, and Vans Off the Wall Logo. Vans carefully controls how its shoes are advertised, promoted, and showcased to ensure that such efforts are consistent with Vans' values and its overall strategic growth and sales strategies. Vans does not seek to promote any of its shoes, including the Old Skool, as discount, bargain basement, cheap, low quality, inauthentic, unsafe, or non-prestige products. MSCHF's sale of its "Wavy Baby" shoes featuring Vans' Old Skool shoe design will cause Vans to lose control over how it markets and promotes products bearing its trademarks and trade dress, and will irreparably harm Vans' goodwill and reputation if MSCHF is not ordered to cease selling its infringing shoes.

I declare under penalty of perjury under the laws of the United States of America that the foregoing is true and correct to the best of my knowledge.

Executed on April 14, 2022

Justin Regan

UNITED STATES DISTRICT COURT
EASTERN DISTRICT OF NEW YORK

VANS, INC. and VF OUTDOOR, LLC, Plaintiffs, v. MSCHF PRODUCT STUDIO, INC., Defendant.	Case No.22-cv-02156-WFM-RML JURY TRIAL DEMANDED

DECLARATION OF TANYA L. GREENE IN SUPPORT OF PLAINTIFFS' MOTION FOR TEMPORARY RESTRAINING ORDER AND PRELIMINARY INJUNCTION

I, Tanya L. Greene, declare and state as follows:

1. I am a member of the bar of the State of California, with a pending motion for admission *pro hac vice* before the Court, an attorney at the law firm of McGuireWoods LLP, and counsel for Plaintiffs Vans, Inc. and VG Outdoor, LLC (collectively, "Vans") in this action. I submit this Declaration in support of Vans' Motion for a Temporary Restraining Order and Preliminary Injunction against Defendant MSCHF Product Studio, Inc. ("MSCHF").

2. The information contained in this Declaration comes from my own personal knowledge and belief. If called as a witness, I am competent to testify to the matters declared herein.

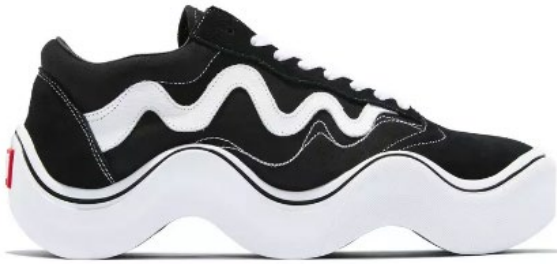
3. In connection with Vans' Motion, Vans is providing a visual chart depicting MSCHF's presenting known infringing shoes, along with information about Vans' asserted trademarks and/or trade dress rights that each violates. A true and correct copy of this visual chart is attached hereto as **Exhibit 1**.

I declare under penalty of perjury under the laws of the United States of America that the foregoing is true and correct to the best of my knowledge.

Executed on April 14, 2022

/s/ Tanya L. Greene
Tanya L. Greene

EXHIBIT 1

Vans' Trademarks/Trade Dress	WAVY BABY Design
	
	
	
	
	

	
 VANS "OFF THE WALL"	

UNITED STATES DISTRICT COURT
EASTERN DISTRICT OF NEW YORK

VANS, INC. and VF OUTDOOR, LLC, Plaintiffs, v. MSCHF PRODUCT STUDIO, INC., Defendant.	Case No. 22-cv-02156-WFM-RML JURY TRIAL DEMANDED

DECLARATION OF RIAN POZZEBON IN SUPPORT OF PLAINTIFFS' MOTION FOR TEMPORARY RESTRAINING ORDER AND PRELIMINARY INJUNCTION

I, Rian Pozzebon, declare and state as follows:

1. This declaration is based upon my personal knowledge of the facts or on business records that were made in the regular course of business. If called as a witness, I could and would testify to the statements made herein.

2. I am the Sr. Director of Global Footwear Design at Vans, a division of VF Outdoor, LLC ("Vans"), where I design Vans shoes. I have designed shoes for Vans since 2002.

3. As part of my role at Vans, I am intimately familiar with the designs of Vans' shoes, including Vans' OLD SKOOL shoes, and I am knowledgeable of or have access to business records concerning all of the information in this declaration, including the storied history of each of the shoes discussed herein, the various colorways and collaborations for Vans' shoes, and how Vans' shoes are designed and manufactured.

4. Vans' core product line includes its OLD SKOOL shoes. We sometimes refer to these shoes, as well as a few others, as one of the Vans "Classics." Vans first developed these shoes forty or more years ago. Since then, Vans has developed these shoes into some of its most popular and enduring shoes.

5. In 1977, Vans introduced "Style 36," which later became known as the OLD SKOOL. The OLD SKOOL was the first Vans shoes to feature the now-famous Vans "jazz stripe." The OLD SKOOL shoe is depicted below:

Vans OLD SKOOL

6. Since first introducing the OLD SKOOL in the 1970s, Vans has continuously manufactured, sold, and promoted the OLD SKOOL shoe.

7. Vans' "OLD SKOOL Trade Dress" consists of a distinctive combination of source-identifying elements, including: (1) the Vans Side Stripe Mark on the shoe upper; (2) a rubberized sidewall with a consistent height around the perimeter of the shoe; (3) the uppermost portion of the sidewall having a three-tiered or grooved appearance; (4) a textured toe box outer around the front of the sidewall; (5) visible stitching, including where the eyestay meets the vamp; and (6) the placement and proportion of these elements in relation to one another. This combination of elements is unique to Vans, and we go to great lengths to ensure that this combination of elements remains as consistent as possible when designing new colorways and collaborations.

8. The MSCHF Wavy Baby shoes also feature a rubberized sidewall that, apart from the wavy appearance, maintains a consistent perimeter around the shoe; a three-tiered appearance on the uppermost portion of the sidewall; a textured toe box outer around the front of the sidewall; and visible stitching, including where the eyestay meets the vamp, all of which are distinctive features of the OLD SKOOL Dress.

9. The distinctive combination of elements comprising the OLD SKOOL Trade Dress serves no function other than as a signifier of the Vans brand. The combination of elements described in the OLD SKOOL Trade Dress is not essential to the use or purpose of the shoe, it does not reduce the cost or improve performance of the shoe, and its use by Vans does not put competitors at any significant non-reputation-related disadvantage. Vans' competitors in the sneaker industry have available a multitude of alternative shoe designs they could use.

10. In the 1970s, the OLD SKOOL was originally released in three colorways, including a royal blue version worn notably by Stacy Peralta. Since then, Vans has introduced the OLD SKOOL shoe in numerous additional colorways that still faithfully maintain the OLD SKOOL silhouette.

11. A small fraction of the colorways for the OLD SKOOL are depicted below:

12. Since first introducing the OLD SKOOL in the 1970s, Vans has manufactured, sold, and promoted well over 1,000 colorways within the OLD SKOOL shoe line. Some of Vans' OLD SKOOL colorways come in the form of collaborations with other designers,

companies, or celebrities. For example, Vans has released OLD SKOOL colorways through high profile collaborations with Marc Jacobs, Tyler the Creator/Golf Wang, Supreme, Stussy, Kenzo, JJJJound, The North Face, and Disney. These collaborations and limited-run releases have given Vans' OLD SKOOL shoes a coveted level of prestige and helped further increase popularity of the shoes with new generations and demographics.

13. The distinctive elements of Vans' footwear have become an iconic aspect of Vans shoes, such as the OLD SKOOL shoes. For example, the Vans OLD SKOOL shoes have used Vans' signature waffle sole design for nearly four decades.

14. Vans' waffle sole design is protected by multiple trademark registrations, including U.S. Trademark Registration No. 1,244,537, No. 2,830,071, No. 4,623,568, and No. 5,418,305.

15. The MSCHF Wavy Baby shoes also feature a copycat version of Vans' waffle sole design. Further adding to the risk of consumer confusion, the sole of MSCHF's Wavy Baby shoes curve upward at the front and back of the shoe. As a result, MSCHF's use of Vans' trademark Waffle Sole is even more apparent, as the copycat sole can be seen at all times, and not merely when the bottom of the shoes are viewed.

16. As a result of Vans' extensive use and promotion of the OLD SKOOL Trade Dress and Vans' signature waffle sole, Vans has built up and now owns tremendous and valuable goodwill symbolized by the trade dress.

17. High quality shoes, which are designed, manufactured, and sold in a way that is consistent with Vans' history and values, are critical to Vans' brand, reputation, and goodwill. High quality shoes are especially important to the sneaker community, which places tremendous

value on quality and frequently judges a brand based on the consistency of the quality of the company's footwear products across its product lines.

18. Since the 1970s, Vans has also continuously manufactured, promoted, and sold shoes that feature the OFF THE WALL Mark, including the OLD SKOOL shoe.

I declare under the penalty of perjury under the laws of the United States of America that the foregoing is true and correct.

Executed on April 14, 2022

DocuSigned by:
DBF04405F78A446...

Rian Pozzebon

UNITED STATES DISTRICT COURT
EASTERN DISTRICT OF NEW YORK

VANS, INC. and VF OUTDOOR, LLC, Plaintiffs, v. MSCHF PRODUCT STUDIO, INC., Defendant.	Case No. 22-cv-02156-WFM-RML JURY TRIAL DEMANDED

DECLARATION OF DANIEL CALLAHAN IN SUPPORT OF PLAINTIFFS' MOTION FOR TEMPORARY RESTRAINING ORDER AND PRELIMINARY INJUNCTION

I, Daniel Callahan, declare and state as follows:

1. This declaration is based upon my personal knowledge of the facts or on business records that were made in the regular course of business. If called as a witness, I could and would testify to the statements made herein.

2. I am Vice President, Global Footwear Development and Director of Development, Footwear for Vans, a division of VF Outdoor, LLC ("Vans"). I have worked for Vans for over twenty years. I started working at Vans as a Senior Materials Manager in April 2001. Prior to working for Vans, I worked as Materials Manager for Reebok. I received a B.S. in Business Management from Providence College in 1993.

3. As part of my role at Vans, I am personally familiar with the histories of Vans' shoe lines, including its Old Skool shoes; the importance of these shoes to Vans, including the importance of these shoes to Vans' reputation and goodwill; the units sold and revenue generated for each of these shoes; and the harm that Vans will suffer if others are allowed to sell unauthorized versions of Vans' shoes.

4. I am knowledgeable of or have access to business records concerning all of the information in this declaration.

5. Vans began selling the Old Skool shoes in 1977. Debuting under the name "Style 36," the Old Skool shoe was one of the first Vans shoes to feature the Vans sidestripe and later became one of Vans' bestselling shoes of all time.

6. Since first introducing the Old Skool in the 1970s, Vans has continuously manufactured, sold, and promoted its Old Skool shoes.

7. Since introducing the Old Skool, Vans has sold over 200 million pairs of shoes with its Old Skool shoe line in the United States alone. Vans' U.S. sales of Old Skool shoes

have generated over $10 billion in revenue. For each of the past few years, Vans has sold over 20 million pairs of Old Skool shoes each year and generated over $1 billion per year in the United States based on such sales.

8. Vans Old Skool shoes also prominently feature the "Vans Off the Wall" logo on the rear sole, which has become a well-recognized part of the shoes' design and appearance.

9. Vans' shoes are now some of the most popular shoes in the United States. For the past several years, an independent third-party survey called "Taking Stock with Teens" has consistently found that Vans is the No. 2 overall favorite footwear brand among U.S. teens. A true and correct copy of the research report by Piper Sandler Investment Research, titled Taking "Stock with Teens Survey—Fall 2020," http://www.pipersandler.com/private/pdf/TSWTs_Fall_2020_Full_Report.pdf, is attached hereto as **Exhibit 1**. According to the survey, Vans trails only Nike in popularity among U.S. teens. These rankings have been recognized in publications such as *CNBC*, *Vogue*, *Bloomberg*, *Forbes*, *Footwear News*, and *Business Insider*.

10. Vans actively increases and protects the popularity of its shoes, including each of the shoes discussed in this declaration, by aggressively controlling when, how, and where its shoes are released.

11. Vans distributes its footwear through a network of carefully selected distribution channels, including major department stores and retailers such as Nordstrom, Journeys, Tillys, Urban Outfitters, PacSun, and Famous Footwear; sporting goods and outdoor retailers like Foot Locker and Dick's Sporting Goods; online retail outlets like Zappos.com; through Vans' own retail stores, including the 450+ stores throughout the United States; and via online sales through Vans' website (www.vans.com). While Vans' products are sold throughout the United States and across the world, Vans carefully picks its retail partners and distribution channels, while

exercising tight control over how Vans shoes are showcased and sold. Vans carefully selects its distribution channels and retail partners to ensure consistency with Vans' core values for authenticity, quality, and creative expression, and to ensure consistency with Vans' strategic growth and sales strategies.

12. Vans carefully selects its colorways and designs, including when certain colorways should be introduced or phased out, to prevent oversaturation of the market. Similarly, Vans exercises strict control over the collaborations it enters into in relation to its shoes, so that any resulting shoe collaborations and colorways meet Vans' high expectations and standards for authenticity and creative expression.

13. In order to control the prestige of its shoes and prevent oversaturation of the market, Vans goes to great lengths to limit the quantities of shoes sold for each style and to strategically direct such quantities to specific distribution channels or regions.

14. In addition, Vans works hard to ensure that its genuine products are of the highest quality and craftsmanship, while still maintaining Vans' standards for style, creativity, and comfort. Vans further ensures that genuine Vans shoes are manufactured and sold in a way that supports Vans' culture and mission statement.

15. Genuine Vans shoes are known throughout the sneaker industry, and within the sneaker community, for their quality, durability, craftsmanship, consistency, aesthetic, and creative expression. Vans has specific procedures in place to ensure that each product sold to a customer meets or exceeds Vans' high standards. When fakes are permitted to infiltrate the market, Vans loses control of the manufacturing process and its ability to maintain strict quality control.

16. Despite how closely they mimic the look of Vans' Old Skool shoes, MSCHF's infringing shoes fail to mimic the high quality and, importantly, safety of Vans' shoes. Specifically, the "wavy" construction of the mid- and outsole of MSCHF's shoes is less stable and secure than the traditional, flat-soled shoes sold by Vans.

17. High quality shoes that are safe for consumers and sold in a way that is consistent with Vans' values, is critical to Vans' brand, reputation, and goodwill. High quality shoes are especially important to the sneaker community, which places tremendous value on quality and frequently judges a brand based on the consistency in quality of the company's footwear products across its various product lines.

18. Fake Vans shoes, particularly fakes that mimic Vans' "look" but are manufactured with inferior quality or construction, undermine consumer confidence in the quality of genuine Vans products, erode the consumer experience, and cause immediate and irreparable harm to the brand, reputation, and goodwill that Vans has spent decades building.

19. For these reasons, if not enjoined, MSCHF's actions will cause irreparable harm to Vans, as well as to the prestige and reputation of associated with Vans' trademarks and trade dress rights.

I declare under penalty of perjury under the laws of the United States of America that the foregoing is true and correct to the best of my knowledge.

Executed on April 14, 2022

DocuSigned by:
Daniel Callahan
619DEF5A95D7403...

Daniel Callahan