

**IN THE UNITED STATES DISTRICT COURT  
FOR THE EASTERN DISTRICT OF NEW YORK**

NWHL Holdings, LLC, and  
NWHL LLC

Plaintiffs,

v.

Buffalo Beauts Hockey, LLC

Defendants.

Civil Action No. 1:19-cv-3803

**COMPLAINT FOR DECLARATORY  
JUDGMENT**

**NWHL HOLDINGS, LLC'S AND NWHL LLC'S COMPLAINT FOR DECLARATORY  
JUDGMENT**

Plaintiffs NWHL Holdings, LLC (“NWHL Holdings”) and NWHL LLC (collectively, “NWHL”), by and through their undersigned attorneys, hereby brings this complaint for declaratory judgment pursuant to the Declaratory Judgment Act, 28 U.S.C. § 2201, *et seq.*, against Defendant Buffalo Beauts Hockey, LLC (“Defendant”), and alleges as follows:

**NATURE OF ACTION AND RELIEF SOUGHT**

1. This is an action under the Declaratory Judgment Act, 28 U.S.C. § 2201, *et seq.*, for a declaratory judgment of non-infringement of certain of Defendant’s registered and common law trademarks (collectively, the “BEAUTS marks”). NWHL seeks a declaration that their use of the BEAUTS marks, does not constitute infringement of any of Defendant’s rights in the BEAUTS marks, nor does it constitute false affiliation, false endorsement, or unfair competition, because NWHL’s use of the BEAUTS marks is expressly permitted by a Mutual Trademark License Agreement (the “License Agreement”) that was duly executed by NWHL Holdings and Defendant on August 27, 2018.

## BACKGROUND

2. This action arises out of demands asserted by Defendant in a June 25, 2019 letter. In this letter, Defendant demands that Plaintiffs: (a) cease and desist from, *inter alia*: (i) future use of the BEAUTS marks; and (ii) displaying and distributing any marketing materials featuring the BEAUTS marks; (b) destroy all merchandise in their possession or control bearing the BEAUTS marks; and (c) provide Defendant with written assurances of NWHL's compliance with these demands.

3. Each of Defendant's demands stands in direct contravention of the License Agreement, which expressly and explicitly permits NWHL Holdings to use the BEAUTS marks "in connection with the operation and promotion of [the National Women's Hockey League]," and grants NWHL Holdings a "perpetual, royalty-free . . . non-exclusive, sublicensable . . . right and license" to use the BEAUTS marks in connection with NWHL Holdings' "operation and promotion of [the National Women's Hockey League]." A true and correct copy of the License Agreement is attached hereto as **Exhibit 1**. See Exhibit 1, at 1, § 1.1.

## THE PARTIES

4. Plaintiff, NWHL LLC, a Delaware limited liability company having a principal place of business at 67 West Street, Suite 401-B11, Brooklyn, New York 11222; a/k/a "National Women's Hockey League", is a women's professional ice hockey league that was established in 2015. NWHL LLC currently has five franchises: the Boston Pride, Connecticut Whale, Metropolitan Riveters, Minnesota Whitecaps, and the Buffalo Beauts.

5. Plaintiff, NWHL Holdings, LLC is a New York limited liability company having its principal place of business at 67 West Street, Suite 401-B11, Brooklyn, New York 11222 and is the holder of NWHL LLC's intellectual property rights.

6. Upon information and belief, Defendant Buffalo Beauts Hockey, LLC is a Delaware limited liability company having its principal place of business at 199 Scott Street, Suite 200, Buffalo, New York 14203 and operates the Buffalo Beauts women's ice hockey team.

#### **JURISDICTION AND VENUE**

7. This Court has jurisdiction over the subject matter of this action pursuant to 28 U.S.C. § 1331 and 28 U.S.C. § 1338. The claims alleged in this Complaint do not relate to Federal taxes and arise under the Declaratory Judgment Act, 28 U.S.C. § 2201, *et seq.*, and the Lanham Act, 15 U.S.C. §§ 1051, *et seq.*

8. This Court has personal jurisdiction over Defendant because, Defendant's principal place of business is within the State of New York and upon information and belief, Defendant has substantial, continuous, and systematic contacts within this judicial District including an online presence accessible within this judicial District.

9. Venue is proper in this District under 28 U.S.C. § 1391(b) and (c) because, upon information and belief, a substantial portion of the events giving rise to Plaintiffs' claims occurred in this District, the alleged infringement occurred in this district, and because the Defendant is subject to this Court's personal jurisdiction with respect to this action.

10. An actual case or controversy exists between the parties. Defendant has threatened imminent legal action against Plaintiffs and has demanded that Plaintiffs immediately cease and desist from: (i) all future use of the BEAUTS marks; (ii) the display and/or distribution of any marketing materials, social media posts, or websites that utilize the BEAUTS marks, as well as demanding that Plaintiffs destroy all merchandise in their possession or control that bears the BEAUTS marks and provide written assurances to Defendant of compliance with these demands.

**GENERAL ALLEGATIONS**

11. NWHL LLC, owns and operates the only professional women’s ice hockey league located in the United States. Upon information and belief, Defendant owns and operates the Buffalo Beauts, which was one of the four founding franchises of the National Women’s Hockey League.

12. On August 27, 2018, Plaintiff NWHL Holdings and Defendant entered into a series of agreements, including the License Agreement. The purpose of these agreements was to transfer ownership of the Buffalo Beauts professional women’s ice hockey team from NWHL Holdings to Defendant, including the intellectual property associated with the Buffalo Beauts team, i.e. the BEAUTS marks:

**Trademarks and Service Marks**

**Registered:**

Mark	Registration Number	Class(es)
BUFFALO BEAUTS	4,906,135	041: Entertainment in the nature of hockey games
BUFFALO BEAUTS	5,655,814	025: Hats; Hoodies; Jerseys; Leggings; One-piece garments for children; Shirts; Sports bra; Sweatshirts; Tank tops
BEAUTS (plus design)	5,638,076	041: Entertainment in the nature of hockey games
BEAUTS (plus design)	5,661,523	025: Hats; Hoodies; Jerseys; Leggings; One-piece garments for children; Shirts; Sports bra; Sweatshirts; Tank tops

**Common Law:**

Mark	Recommended Class(es)
BUFFALO BEAUTS	021: Cups and mugs
BEAUTS (plus design)	021: Cups and mugs
BUFFALO BEAUTS	035: On-line retail store services featuring {a wide variety of consumer goods}
BEAUTS (plus design)	035: On-line retail store services featuring {a wide variety of consumer goods}

13. In the License Agreement, NWHL Holdings and Defendant agreed to allow each other to use intellectual property owned by the other party for the business operations of the National Women's Hockey League and the Buffalo Beauts, respectively, including the BEAUTS marks.

14. In the License Agreement, the parties<sup>1</sup> specified that:

**WHEREAS**, as a condition precedent to BBH entering into the Purchase Agreement, Holdings and BBH have agreed to enter into this Agreement, which provides BBH with, inter alia, a perpetual, royalty-free right and license to use certain National Women's Hockey League (the "**League**") related intellectual property owned by Holdings as necessary and customary to carry on day-to-day operations of the Beauts;

**WHEREAS**, Holdings is the sole and exclusive owner of the trademarks set forth on Exhibit A hereto;

**WHEREAS**, BBH wishes to use the trademarks identified on Exhibit A, and any other trademarks, service marks or other indicia of origin as may be agreed upon by Holdings and BBH from time to time (collectively, the "**Holdings Trademarks**"), in connection with BBH's operation of the Beauts, and Holdings is willing to grant to BBH a license to use the Holdings Trademarks on the terms and conditions set forth in this Agreement;

**WHEREAS**, immediately following the Closing (as that term is defined in the Purchase Agreement) of the Purchase Transaction, BBH is the sole and exclusive owner of the trademarks set forth on Exhibit B hereto (collectively, the "**BBH Trademarks**" and together with the Holdings Trademarks, the "**Licensed Trademarks**"); and

**WHEREAS**, Holdings wishes to use the BBH Trademarks in connection with the operation and promotion of the League, and BBH is willing to grant to Holdings a license to use the BBH Trademarks on the terms and conditions set forth in this Agreement.

15. Section 1 of the License Agreement details the mutual licenses that the parties granted to one another. Section 1.1 specifies that NWHL Holdings and Defendant granted each other perpetual, non-exclusive, royalty-free, and sublicensable licenses to use one another's trademarks, including the BEAUTS marks:

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<sup>1</sup> In the August 27, 2018 Mutual Trademark License Agreement (the "License Agreement"), Plaintiff NWHL Holdings, LLC is referred to as "Holdings," and as such appears as "Holdings" rather than "NWHL Holdings" in relevant sections of the License Agreement excerpted throughout this Complaint. Likewise, Defendant is referred to in the License Agreement as "BBH," and as such appears as "BBH" rather than "Defendant" in relevant sections of the License Agreement excerpted throughout this Complaint.

1. Grant of License.

1.1 Grant. Subject to the terms and conditions of this Agreement, Holdings hereby grants to BBH a perpetual, non-exclusive, royalty-free (subject to Section 9.16 hereof) and sublicensable (subject to Section 1.5 hereof) right and license to use the Holdings Trademarks identified on Exhibit A in connection with BBH's operation and promotion of the Beauts (including, without limitation, the sale of various merchandise and apparel bearing the Holdings Trademarks). BBH hereby grants to Holdings a perpetual, royalty-free (subject to Section 9.16 hereof), non-exclusive, sublicensable (subject to Section 1.5 hereof) right and license to use the BBH Trademarks identified on Exhibit B in connection with Holdings' operation and promotion of the League (including, without limitation, the sale of various merchandise and apparel bearing the BBH Trademarks).

16. Sections 1.2 and 1.3 of the License Agreement deal with the parties' use of these trademarks, including for purposes of advertising, marketing, and promotion:

1.2 Use of Holdings Trademarks. BBH hereby acknowledges that its use of the Holdings Trademarks identified on Exhibit A hereto, as the same may be updated, amended or modified from time to time, as it relates to the manufacture, advertising, marketing, promotion, sale and distribution of various merchandise items ("**BBH Merchandise**") is subject to Holdings' approval which shall not be unreasonably withheld, conditioned or delayed. Except to the extent it is not reasonably practicable, or the parties hereto otherwise agree in writing, BBH shall furnish to Holdings a virtual sample (e.g., printer's proof) of each item of BBH Merchandise prior to distribution of any BBH Merchandise bearing a Holdings Trademark; provided, however, during the Term of this Agreement, BBH shall retain a physical sample of each item of BBH Merchandise at its facilities for inspection by Holdings. Holdings also reserves the right to inspect any manufacturing facilities to ensure proper quality controls are in place. BBH represents that any manufacturing will be in compliance with applicable laws and any goods imported will be in compliance with applicable regulations.

1.3 Use of BBH Trademarks. Holdings hereby acknowledges that its use of the BBH Trademarks identified on Exhibit B hereto, as the same may be updated, amended or modified from time to time, as it relates to the manufacture, advertising, marketing, promotion, sale and distribution of various merchandise items ("**Holdings Merchandise**" and together with the BBH Merchandise, collectively "**Merchandise**") is subject to BBH's approval which shall not be unreasonably withheld, conditioned or delayed. Except to the extent it is not reasonably practicable, or the parties hereto otherwise agree in writing, Holdings shall furnish to BBH a virtual sample (e.g., printer's proof) of each item of Holdings Merchandise prior to distribution of any Holdings Merchandise bearing a BBH Trademark; provided, however, during the Term of this Agreement, Holdings shall retain a physical sample of each item of Holdings Merchandise at its facilities for inspection by BBH. BBH reserves the right to inspect any manufacturing facilities to ensure proper quality controls are in place. Holdings also represents that any manufacturing will be in compliance with applicable laws and any goods imported will be in compliance with applicable regulations.

17. The License Agreement contains provisions directed at the maintenance of these trademarks, as well as their enforcement. *See* Exhibit 1, §§ 2.2, 2.3. The laws of the State of New York govern the License Agreement. *Id.* at § 9.11.

18. The marks that constitute the BEAUTS marks are listed in Exhibit B to the License Agreement (at the time the License Agreement was executed, Application Serial Nos. 88/009,831, 88/013,888, and 88/013,784 were pending, and have now registered), which is referenced throughout the above excerpts.

19. Exhibit B to the License Agreement specifies that after execution of the License Agreement, Defendant became owner of the following trademarks:

**EXHIBIT B**

**BBH US Federal Trademarks**

Applications Serial Nos. 88/009,831, 88/013,888 and 88/013,784  
Registration No. 4,906,135

**Common Law Trademarks**

BUFFALO BEAUTS  
BEAUTS (plus design)

20. Upon information and belief, Defendant is record owner of the following trademarks:

- a. U.S Registration No. 4,906,135, for the standard character mark BUFFALO BEAUTS in International Class 41, which is listed for use in connection with “Entertainment in the nature of hockey games.”
- b. U.S Registration No. 5,655,814 (Application Serial No. 88/009,831), for the standard character mark BUFFALO BEAUTS in International Class 25, which is

listed for use in connection with “Hats; Hoodies; Jerseys; Leggings; One-piece garments for children; Shirts; Sports bra; Sweatshirts; Tank tops.”

- c. U.S Registration No. 5,638,076 (Application Serial No. 88/013,888), for the design mark BEAUTS in International Class 41, which is listed for use in connection with “Entertainment in the nature of hockey games.”
- d. U.S Registration No. 5,661,523 (Application Serial No. 88/013,784), for the design mark BEAUTS in International Class 25, which is listed for use in connection with “Hats; Hoodies; Jerseys; Leggings; One-piece garments for children; Shirts; Sports bra; Sweatshirts; Tank tops.” True and correct copies of the foregoing registration certificates from the TSDR is attached hereto as **Exhibit 2**.

21. Each of the above registered trademarks, or their respective applications, is listed in Exhibit B to the License Agreement. The common law trademarks for “BUFFALO BEAUTS” and “BEAUTS” (plus design) are also listed in Exhibit B to the License Agreement. Thus, any purported or alleged use by NWHL is proper, authorized, and non-infringing.

22. Despite the clarity of the terms outlined in the License Agreement, however, counsel for Defendant contacted NWHL by letter dated June 25, 2019, alleging that “as you are aware . . . [NWHL] is no longer authorized to use the BEAUTS Marks.” The BEAUTS marks are purportedly listed in Exhibit A to the June 25, 2019 letter. A true and correct copy of Defendant’s June 25, 2019 letter (the “cease and desist letter”) is attached hereto as **Exhibit 3**. Exhibit A to the cease and desist letter lists the following trademarks and service marks as those in which NWHL allegedly has no right—and yet they are the very same trademarks and service



marks listed in Exhibit B to the License Agreement as those that NWHL Holdings is expressly permitted to use:

**EXHIBIT A**  
**Trademarks and Service Marks**

**Registered:**

Mark	Registration Number	Class(es)
BUFFALO BEAUTS	4,906,135	041: Entertainment in the nature of hockey games
BUFFALO BEAUTS	5,655,814	025: Hats; Hoodies; Jerseys; Leggings; One-piece garments for children; Shirts; Sports bra; Sweatshirts; Tank tops
BEAUTS (plus design)	5,638,076	041: Entertainment in the nature of hockey games
BEAUTS (plus design)	5,661,523	025: Hats; Hoodies; Jerseys; Leggings; One-piece garments for children; Shirts; Sports bra; Sweatshirts; Tank tops

**Common Law:**

Mark	Recommended Class(es)
BUFFALO BEAUTS	021: Cups and mugs
BEAUTS (plus design)	021: Cups and mugs
BUFFALO BEAUTS	035: On-line retail store services featuring {a wide variety of consumer goods}
BEAUTS (plus design)	035: On-line retail store services featuring {a wide variety of consumer goods}

23. Defendant’s cease and desist letter alleges that NWHL is engaged in “continued, unauthorized use of the BEAUTS Marks” that is “clearly willful and constitutes a violation of [Defendant’s] intellectual property rights, is actionable under numerous federal and state laws, and constitutes trademark infringement, false affiliation, false endorsement, and unfair competition.” Exhibit 3 at 1. Defendant further contends that “[t]he civil remedies available for these violations include immediate and permanent injunctive relief, recovery of NWHL’s profits,

and up to three times the amount of monetary damages suffered by [Defendant], as well as an award of attorney's fees." *Id.*

24. Defendant demands a response "on or before June 27, 2019," and warns NWHL that it should "be advised that [Defendant] will not hesitate to take further legal action" if NWHL "fail[s] to comply with the demands herein." *Id.* at 2 (emphasis original).

25. Defendant demands that NWHL immediately cease and desist from: (i) all future use of the BEAUTS marks; and (ii) the display and/or distribution of any marketing materials, social media posts, or websites that utilize the BEAUTS marks. Defendant also demands that Plaintiffs destroy all merchandise in their possession or control that bears the BEAUTS marks and provide written assurances to Defendant of their compliance with these demands. *Id.* at 1-2.

26. Nowhere in the cease and desist letter does Defendant mention the existence of the License Agreement, nor the fact that use of the BEAUTS marks is explicitly and expressly permitted pursuant to Sections 1.1 and 1.3 of the License Agreement.

27. Defendant's cease and desist letter, with its concurrent demands and threat of litigation commencing on or before June 27, 2019, creates a reasonable apprehension of litigation; accordingly, an actual case or controversy exists.

28. Defendant's demands and threats have placed a cloud over NWHL's rights to continue using the BEAUTS marks in the course of its business operations, including for advertising, marketing, and promotional purposes, and for the manufacture and distribution of various merchandise.

29. In view of Defendant's threats and allegations, NWHL is in need of, and is entitled to, a judicial declaration that: (a) the License Agreement, which is a valid instrument, explicitly permits NWHL Holdings to use the BEAUTS marks; (b) NWHL's use of the

BEAUTS marks is thus authorized; and therefore (c) NWHL's use of the BEAUTS marks does not infringe any federal and/or common law trademark rights owned by Defendant, including those claimed in the cease and desist letter, and does not constitute false affiliation, false endorsement, or unfair competition under any federal or state law.

### **FIRST CLAIM FOR RELIEF**

#### **(Declaratory Judgment of No Federal Trademark Infringement, No False Affiliation, No False Endorsement, and No Unfair Competition)**

30. Plaintiffs repeat and reallege the allegations contained in paragraphs 1-29 as if fully set forth herein.

31. Defendant claims that Plaintiffs' use of the BEAUTS marks in the course of its business operations constitutes federal and common law trademark infringement, false affiliation, false endorsement, and unfair competition, and, under an imminent threat of litigation, demands that Plaintiffs: (a) immediately cease and desist from: (i) all future use of the BEAUTS marks; (ii) the display and/or distribution of any marketing materials, social media posts, or websites that utilize the BEAUTS marks; (b) destroy all merchandise in their possession or control that bears the BEAUTS marks; and (c) provide written assurances to Defendant of compliance with these demands.

32. An actual, present, and justiciable controversy exists between Plaintiffs and Defendant, not involving Federal taxes, concerning Plaintiffs' use of the BEAUTS marks in the course of their business operations.

33. The License Agreement explicitly and expressly permits NWHL Holdings to use the BEAUTS marks; thus, any purported or alleged use by NWHL is proper, authorized, and non-infringing.

34. The License Agreement is a valid, duly-negotiated instrument that was voluntarily entered into by Defendant and NWHL Holdings, both of whom desired the use of each other's intellectual property in the ordinary operations and course of their businesses.

35. Plaintiffs seek a declaratory judgment from this Court that Plaintiffs' use of the BEAUTS marks does not constitute trademark infringement under the Lanham Act or under the common law of the State of New York.

36. Plaintiffs seek a declaratory judgment from this Court that Plaintiffs' use of the BEAUTS marks does not constitute false affiliation under the Lanham Act or under the common law of the State of New York.

37. Plaintiffs seek a declaratory judgment from this Court that Plaintiffs' use of the BEAUTS marks does not constitute false endorsement under the Lanham Act or under the common law of the State of New York.

38. Plaintiffs seek a declaratory judgment from this Court that Plaintiffs' use of the BEAUTS marks does not constitute unfair competition under the Lanham Act or under the common law of the State of New York.

39. Plaintiffs seek a declaratory judgment that Defendant has suffered no, and will not suffer any, damages or loss of goodwill as a result of Plaintiffs' use of the BEAUTS marks.

40. Plaintiffs seek a declaratory judgment that Defendant is not entitled to any injunctive relief or damages under 15 U.S.C. § 1125 or any other federal law or under the common law of the State of New York.

#### **PRAYER FOR RELIEF**

WHEREFORE, Plaintiffs pray that this Court enter judgment in their favor as follows:

- a. Declare that Plaintiffs' conduct, including its use of the BEAUTS marks, does not constitute trademark infringement, false affiliation, false endorsement, or unfair competition under the Lanham Act or under the laws of the State of New York;
- b. Declare that Defendant is not entitled to any injunctive relief with respect to Plaintiffs' use of the BEAUTS marks;
- c. Declare that Defendant is not entitled to recover any lost profits with respect to Plaintiffs' use of the BEAUTS marks;
- d. Declare that Defendant is not entitled to recover any form of damages, monetary or otherwise, with respect to Plaintiffs' use of the BEAUTS marks;
- e. Declare that Defendant is not entitled to any award of attorneys' fees or costs with respect to Plaintiffs' use of the BEAUTS marks;
- f. Declare that Defendant has not suffered any and will not suffer any harm or damages, and thus is not entitled to any relief under the Lanham Act or under the laws of the State of New York;
- g. Declare that Plaintiffs' are entitled and permitted to continue using the BEAUTS marks in the future, because the August 27, 2018 Mutual Trademark License Agreement between NWHL Holdings and Defendant expressly and explicitly authorizes and permits it to do so;
- h. Declare that Plaintiffs' past use of the BEAUTS marks was expressly and explicitly authorized and permitted under the August 27, 2018 Mutual Trademark License Agreement between NWHL Holdings and Defendant;
- i. Award Plaintiffs costs, expenses, and attorneys' fees in this action; and

- j. Award such and other further relief to which Plaintiffs may be entitled as a matter of law or equity, or which this Court may deem to be just and proper.

Dated: June 30, 2019

Respectfully submitted,

By: /s/ Ben Natter  
Ben Natter

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