

**IN THE UNITED STATES DISTRICT COURT
FOR THE NORTHERN DISTRICT OF ILLINOIS
EASTERN DIVISION**

| | | |
|---|---|-------------------------------|
| WOLFGANG PUCK WORLDWIDE, INC., and WOLFGANG PUCK EXPRESS LICENSING, LLC, |) | |
| |) | |
| |) | |
| Plaintiffs, |) | Civil Action No. _____ |
| |) | |
| v. |) | |
| |) | |
| THE KITCHEN CAFÉ LLC, |) | |
| |) | |
| Defendant. |) | |
| |) | |

COMPLAINT FOR DECLARATORY JUDGMENT

Plaintiffs WOLFGANG PUCK WORLDWIDE, INC. (“Worldwide”) and WOLFGANG PUCK EXPRESS LICENSING, LLC (“Express”)(collectively referred to as “Plaintiffs”) bring this complaint for declaratory relief against THE KITCHEN CAFÉ LLC (“TKC” or “Defendant”). For their complaint herein, Plaintiffs allege as follows:

NATURE OF CASE

1. This is a trademark and unfair competition case. Plaintiffs seek a declaration from this Court, *inter alia*, of the legal right for the trademarks THE KITCHEN BY WOLFGANG PUCK and THE KITCHEN COUNTER BY WOLFGANG PUCK (the "WP Marks") to continue to be exploited and used in commerce in connection with restaurant and related services, and that TKC does not own protectable trademark rights in the generic, highly descriptive or merely descriptive term THE KITCHEN.

2. TKC recently filed suit against a different entity, Wolfgang Puck Licensing, LLC (“WPL”), in the U.S. District Court for the District of Colorado, Civil Action No. 1:16-cv-02814-MEH (“Colorado Action”), alleging, *inter alia*, that the continued use of the WP Marks infringes and unfairly competes with TKC's alleged common law trademark rights in THE KITCHEN for use in connection with restaurant and related services.

3. TKC asserts that it has established protectable trademark rights in the descriptive and generic phrase “the Kitchen” as applied to restaurants and related services. Plaintiffs assert that the phrase “the Kitchen” is fundamentally incapable of protection as a stand-alone trademark or service mark or as an element of a trademark or service mark because it is generic, or, at best, merely descriptive of such services, and that TKC’s assertion is legally untenable and factually absurd.

4. TKC has not named Worldwide or Express as defendants in the Colorado Action. TKC, however, has manifested a clear intention to assert its federal unfair competition and related state law infringement claim against Worldwide and Express, thereby creating an immediate and real actual controversy and giving them a reasonable apprehension of suit for these claims.

5. WPL does not believe that it is subject to personal jurisdiction in the District of Colorado. WPL has filed a Motion to Dismiss under Fed.R.Civ.P. 12(b)(2) which is currently pending before the Colorado court. In the event that the Colorado Action is dismissed for lack of personal jurisdiction, WPL will voluntarily submit to jurisdiction in this District and join this action so that all of the issues and disputes can be resolved in one forum in an efficient manner.

6. Through this action, Plaintiffs seek a declaration that (1) TKC does not own valid, protectable trademark rights in the generic, highly descriptive or merely descriptive term THE KITCHEN for restaurant and related services, (2) the use of the WP Marks is not likely to cause confusion with TKC's marks, and (3) Plaintiffs do not infringe TKC's rights or unfairly compete with TKC. Plaintiffs have also included counts for cancellation of TKC's related federal trademark registrations THE KITCHEN UPSTAIRS and THE KITCHEN NEXT DOOR.

JURISDICTION AND VENUE

7. This Court has subject matter jurisdiction over this action pursuant to: 28 U.S.C. §§ 1331, 1332, 1338(a), and 1338(b); 15 U.S.C. § 1121; and 28 U.S.C. § 1367.

8. This Court has jurisdiction over the declaratory judgment counts in this Complaint pursuant to 28 U.S.C. §2201 because this case is otherwise within the subject matter jurisdiction of this Court and involves an actual and substantial case or controversy between Plaintiffs and Defendant.

9. TKC is subject to personal jurisdiction in this District. TKC's alleged trademark THE KITCHEN which is the basis of its infringement and unfair competition allegations against Plaintiffs is in use in this District. Specifically, there is a restaurant affiliated with TKC at 316 N. Clark Street, Chicago, IL 60654, operating under the name "THE KITCHEN." TKC identifies the Chicago restaurant on its website as one of its restaurants, and has asserted rights in the Colorado Action based upon and derived from its use of the phrase "The Kitchen" in connection with the Chicago restaurant. Additionally, TKC is registered with the Illinois Secretary of State to do business in

Illinois. Upon information and belief, TKC is doing business in this District and derives revenue from its operations under the name THE KITCHEN in this District.

10. Venue in this District is proper pursuant to 28 U.S.C. § 1391 because this Court has personal jurisdiction over TKC.

PARTIES

11. Worldwide is a Delaware corporation with a principal place of business at 8687 Melrose Avenue, Room B315, Blue Building, West Hollywood, California 90069.

12. Express is a limited liability company organized under the laws of the State of Delaware, with a principal place of business at 8687 Melrose Avenue, Room B315, Blue Building, West Hollywood, California 90069.

13. TKC is a Colorado limited liability company with its principal place of business at 1980 8th Street, Boulder, CO 80302.

THE CASE AND CONTROVERSY BETWEEN THE PARTIES

The Colorado Action

14. On November 18, 2016, TKC initiated the Colorado Action by filing a complaint against WPL alleging that the use of THE KITCHEN BY WOLFGANG PUCK, THE KITCHEN COUNTER BY WOLFGANG PUCK, and any other KITCHEN-formative marks constitutes federal unfair competition under Section 43(a) of the Lanham Act, 15 U.S.C. § 1125(a) and trademark infringement and unfair competition under Colorado common law (“Complaint”). TKC predicated its claims on alleged common law trademark rights in the phrase THE KITCHEN.

15. TKC included in its Complaint allegations concerning its federal trademark registrations for THE KITCHEN NEXT DOOR, Reg. No. 4,165,447 and THE KITCHEN UPSTAIRS, Reg. No. 4,679,061, but did not plead a count for federal trademark infringement under Section 32 of the Lanham Act, 15 U.S.C. § 1114.

16. In addition, TKC included in the Complaint a count asking the Court to direct the PTO to refuse registration to WPL's trademark application for THE KITCHEN BY WOLFGANG PUCK, Serial No. 86/585,406.

17. In its Complaint, TKC demanded the Court enjoin WPL from using THE KITCHEN or any mark confusingly similar to THE KITCHEN, including but not limited to THE KITCHEN BY WOLFGANG PUCK. WPL is a holding company – it does not offer any goods or services using the WP Marks, but rather licenses the WP Marks to Worldwide. Worldwide sub-licenses the WP Marks to Express for certain categories of use.

WPL's Motion To Dismiss The Colorado Action

18. On January 6, 2017, WPL filed a motion to dismiss the Colorado Action for lack of personal jurisdiction under Fed.R.Civ.P. 12(b)(2) (“Motion to Dismiss”). In the alternative, the Motion to Dismiss seeks transfer of the case to the U.S. District Court for Nevada or the U.S. District Court for the Central District of California pursuant to 28 U.S.C. § 1631. The Motion to Dismiss is currently pending before the Colorado Court.

19. The District of Colorado lacks personal jurisdiction over WPL because WPL has not purposely directed any activities towards Colorado which have given rise to TKC's

claims in the Colorado Action, and WPL is not engaged in continuous and systematic contact with Colorado where it can be considered "at home" in that state.

20. The WP Marks are not in use in Colorado. There are no restaurants operating under the WP Marks in Colorado and there is no advertising or promotional activities for the WP Marks specifically directed to Colorado.

21. On February 3, 2017, TKC filed its opposition to the Motion to Dismiss as well as a motion for jurisdictional discovery ("Jurisdictional Discovery Motion") in which it made clear that it asserts infringement against Worldwide and/or Express, yet has not named these parties in the Colorado action. This threat creates uncertainty as to when or if Worldwide and Express might be hauled into the District of Colorado. Plaintiffs do not believe they are subject to personal jurisdiction in the District of Colorado, but nevertheless must deal with the uncertainty created by TKC's threat of infringement.

TKC Does Not Have Protectable Trademark Rights In THE KITCHEN

22. TKC's bases its claims against Plaintiffs on alleged common law trademark rights in the term THE KITCHEN. In the restaurant field, "kitchen" is a generic, highly descriptive or merely descriptive term, and lacks secondary meaning.

23. The "Kitchen" denotes a location (in a restaurant or otherwise) where food is prepared. In addition, in today's restaurant culture, patrons often want to see the "kitchen" in operation, which has led to the "open kitchen" concept prevalent in many restaurants throughout the country. "Kitchen" is also a generic term used when conveying to patrons the type of cuisine available at the restaurant (e.g., "Italian Kitchen" or "Greek Kitchen").

24. “The kitchen” also describes restaurant and related services. It immediately conveys to patrons a characteristic or feature of the restaurant, namely it provides, *inter alia*, an open kitchen concept, and/or a friendly, homey atmosphere and menu, similar to “bistro” or “cafe.”

25. The term “the” is simply a common article in the English language which adds no distinctiveness to “kitchen.”

26. TKC has not acquired distinctiveness in THE KITCHEN. Its use of the name has been limited to no more than a handful of restaurants located in Colorado, Chicago and Memphis, Tennessee. There are many, many restaurants unrelated to TKC which use the name THE KITCHEN. In addition, there are hundreds of other restaurants which use KITCHEN in their names in combination with other terms.

27. TKC’s effort to claim exclusive rights in THE KITCHEN in the Chicago metropolitan area specifically is particularly egregious. Chicago, like many other locations throughout the U.S., is home to many, many restaurants that have used “Kitchen” as an element of their name.

28. For example, there are approximately four restaurants currently operating under the name LYFE KITCHEN in Chicago in the River North, Streeterville, Gold Coast, and Lincoln Park neighborhoods. The River North location is approximately one and a half blocks from TKC’s restaurant in Chicago. Below is a photo of the Gold Coast restaurant located at 831 N. State Street, Chicago, IL 60611:



A copy of the above photograph is reproduced in *Exhibit A*.

29. In addition, ONE NORTH KITCHEN & BAR is a restaurant currently operating in the Loop, located at One North Wacker Drive, Chicago, IL 60606. ONE NORTH KITCHEN & BAR is located approximately nine blocks from TKC's restaurant in Chicago. A photo of the exterior signage for the ONE NORTH KITCHEN & BAR restaurant on Wacker Drive is reproduced below:



A copy of the above photograph is reproduced in *Exhibit A*.

30. The Langham, a mere two blocks from TKC's restaurant in Chicago, features a restaurant named TRAVELLE KITCHEN + BAR which is currently operating at 330 N. Wabash Ave, Chicago, IL 60611. A photo of the exterior signage for the restaurant on Wabash St. is reproduced below:



A copy of the above photograph is reproduced in *Exhibit A*.

31. DOC B'S FRESH KITCHEN is a restaurant currently operating at two locations in the Gold Coast and River North neighborhoods of Chicago. The River North restaurant located, at 55 E. Grand Avenue, Chicago, IL 60611, is approximately six blocks from TKC's restaurant in Chicago. A photo of the exterior signage for the DOC B'S FRESH KITCHEN restaurant on Grand Avenue is reproduced below:



Copies of the above photographs are reproduced in *Exhibit A*.

32. TKC's attempts to establish a nationwide monopoly in the term THE KITCHEN and assert it against other businesses, such as WPL, Worldwide, and Express, creates a chilling effect on restaurants. It casts doubt whether they can continue to use the generic, highly descriptive or merely descriptive term to convey to patrons the necessary information about the nature of their restaurant services.

There is No Likelihood of Confusion Between THE KITCHEN and THE KITCHEN BY WOLFGANG PUCK or THE KITCHEN COUNTER BY WOLFGANG PUCK

33. There is no likelihood of confusion between TKC's use of "THE KITCHEN," and THE KITCHEN BY WOLFGANG PUCK or THE KITCHEN COUNTER BY WOLFGANG PUCK. The widespread use of "Kitchen" as a descriptive or generic part of the names of third party restaurants confirms that patrons view the term as descriptive or generic, and that the public is able to distinguish between different marks which include the common term KITCHEN. The WP Marks are thus dissimilar because the dominant part of each mark is the well-known name of the famous celebrity chef, Wolfgang Puck. Other factors supporting a lack of likelihood of confusion include, but are not limited to, the weakness and lack of protectability of the shared term "kitchen" as evidenced by the plain meaning of the word and third party usage, fair use of "kitchen," and potential differences in channels of trade.

34. There is also no present geographic overlap between restaurants using the WP Marks and TKC's THE KITCHEN restaurants. Restaurants using the WP Marks are

operating in Grand Rapids, Michigan; Dulles International Airport, Virginia; and Los Angeles International Airport, California. An additional restaurant will open shortly in Greenville-Spartanburg International Airport, South Carolina. Restaurants using TKC's alleged mark THE KITCHEN are operating in Chicago, Illinois, Memphis, Tennessee, and various locations in Colorado.

COUNT I

Declaratory Judgment That Use Of The WP Marks Does Not Constitute Unfair Competition Under Section 43(a) Of The Lanham Act, 15 U.S.C. § 1125(a)

35. Plaintiffs repeat and reallege each and every allegation set forth in Paragraphs 1 through 34 above, and by this Count seek a declaration that the use of the WP Marks does not violate the Lanham Act, 15 U.S.C. § 1125(a).

36. TKC lacks protectable trademark rights in its alleged mark, THE KITCHEN. The term "kitchen" is generic, so highly descriptive as to be incapable of functioning as a trademark through acquired distinctiveness, or merely descriptive and lacks secondary meaning. Both "The Kitchen" and "kitchen" have been used by hundreds of third parties in the restaurant industry, including in Illinois, for many years. Accordingly, TKC has no protectable trademark rights in the term "kitchen."

37. Additionally, the use of THE KITCHEN COUNTER BY WOLFGANG PUCK, THE KITCHEN BY WOLFGANG PUCK or any other use of the term THE KITCHEN or KITCHEN in a restaurant mark is not likely to cause confusion, mistake, or deception as to the origin, sponsorship, or approval of the services rendered under these marks.

COUNT II

Declaratory Judgment that Use Of The WP Marks Does Not Constitute Trademark Infringement and Unfair Competition Under Common Law

38. Plaintiffs repeat and reallege each and every allegation set forth in Paragraphs 1 through 37 above, and by this Count seeks a declaration that the use of the WP Marks does not constitute trademark infringement and unfair competition in violations of the applicable common law (whether that of Colorado, Illinois or any other jurisdiction, as this Court may determine is applicable).

39. TKC's allegations that Plaintiffs are violating TKC's trademark rights are seriously and irreparably injuring and adversely affecting Plaintiffs. Unless this Court declares Plaintiffs' rights in this case of actual controversy, TKC's allegations will continue to injure and adversely affect Plaintiffs. Plaintiffs have no adequate remedy at law.

COUNT III

Cancellation Or Entry of Disclaimer of "Kitchen" In TKC's Federal Registration For THE KITCHEN UPSTAIRS, Reg. No. 4,679,061

40. Plaintiffs repeat and reallege each and every allegation set forth in Paragraphs 1 through 39 above and by this Count seek cancellation of, or entry of a disclaimer, in TKC's federal trademark registration for THE KITCHEN UPSTAIRS, Reg. No. 4,679,061, pursuant to Sections 14 and 37 of the Lanham Act, 15 U.S.C. §§ 1064 & 1119 because the term "kitchen" is generic, so highly descriptive as to be incapable of functioning as a trademark through acquired distinctiveness, or is merely descriptive and lacks secondary meaning for the services identified in the registration.

41. Plaintiffs will be damaged by continued registration of THE KITCHEN UPSTAIRS for the services identified in the registration without a disclaimer of the exclusive right to use "kitchen" apart from the mark as shown because such continued registration imperils the ability to use and register the marks THE KITCHEN BY WOLFGANG PUCK and THE KITCHEN COUNTER BY WOLFGANG PUCK and to use the word "kitchen" to refer to restaurant services provided under any mark owned by WPL.

COUNT IV

Cancellation Or Entry of Disclaimer of "Kitchen" In TKC's Federal Registration For THE KITCHEN NEXT DOOR, Reg. No. 4,165,447

42. Plaintiffs repeat and reallege each and every allegation set forth in Paragraphs 1 through 41 above and by this Count seek cancellation of, or entry of a disclaimer, in TKC's federal trademark registration for THE KITCHEN NEXT DOOR, Reg. No. 4,165,447, pursuant to Sections 14 and 37 of the Lanham Act, 15 U.S.C. §§ 1064 & 1119 because the term "kitchen" is generic, so highly descriptive as to be incapable of functioning as a trademark through acquired distinctiveness, or is merely descriptive and lacks secondary meaning for the services identified in the registration.

43. Plaintiffs will be damaged by continued registration of THE KITCHEN NEXT DOOR for the services identified in the registration without a disclaimer of the exclusive right to use "kitchen" apart from the mark as shown because such continued registration imperils the ability to use and register the marks THE KITCHEN BY WOLFGANG

PUCK and THE KITCHEN COUNTER BY WOLFGANG PUCK and to use the word "kitchen" to refer to restaurant services provided under any mark owned by WPL.

PRAYER FOR RELIEF

WHEREFORE, Worldwide and Express pray that the Court:

- a) Declare that the use of the WP Marks does not constitute unfair competition under Section 43(a) of the Lanham Act, 15 U.S.C. § 1125(a);
- b) Declare that the use of the WP Marks does not constitute trademark infringement and unfair competition under common law;
- c) Declare that the term "kitchen" is not a protectable term because it is generic, so highly descriptive as to be incapable of functioning as a trademark through acquired distinctiveness, or merely descriptive and lacking secondary meaning;
- d) Direct the PTO to cancel or enter a disclaimer of "kitchen" in Reg. No. 4,679,061 for THE KITCHEN UPSTAIRS;
- e) Direct the PTO to cancel or enter a disclaimer of "kitchen" in Reg. No. 4,165,447 for THE KITCHEN NEXT DOOR;
- f) Award Plaintiffs their reasonable attorneys' fees and costs relating to this action, pursuant to 15 U.S.C. § 1117 and all other applicable legal and/or equitable sources because of (without limitation) the exceptional nature of TKC's conduct; and
- g) Award such other and further relief as this Court deems appropriate.

Dated: February 24, 2017

Respectfully Submitted,

By: /s/ Philip A. Jones

Philip A. Jones (Illinois Bar No. 6217213)
Genevieve E. Charlton (Illinois Bar No. 6312219)
BARNES & THORNBURG LLP
One North Wacker Drive.
Suite 4400
Chicago, IL 60606
(312) 357-1313

pjones@btlaw.com
gcharlton@btlaw.com

Attorneys for Plaintiffs