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7 Don Henley

BY: \_\_\_\_\_  
CLERK U.S. DISTRICT COURT  
CENTRAL DIST. OF CALIF.  
LOS ANGELES  
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FILED

9 UNITED STATES DISTRICT COURT  
10 CENTRAL DISTRICT OF CALIFORNIA

11 Don Henley,

12 Plaintiff,

13 v.

14 Duluth Holdings Inc., d/b/a Duluth  
Trading Company, a Wisconsin corporation,

15 Defendant.  
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Case No.:

LACV14-7827 DSF (AGR<sub>x</sub>)

**COMPLAINT FOR:**

- (a) Trademark Infringement in Violation of U.S. Lanham Act, 15 U.S.C. § 1114;
- (b) False Endorsement and Unfair Competition in Violation of Lanham Act, 15 U.S.C. § 1125;
- (c) Violation of California Business & Professions Code § 17200;
- (d) Violation of California Statutory Right of Publicity, Cal. Civ. Code § 3344;
- (e) Violation of Common Law Right of Publicity

**DEMAND FOR JURY TRIAL**

24  
25 Plaintiff Don Henley brings this Complaint against Duluth Holdings Inc. d/b/a  
26 Duluth Trading Company ("Duluth Trading Company") and alleges for his  
27 Complaint as follows:  
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**PRELIMINARY STATEMENT**

1. The Eagles are one of the United States' most successful bands, and Don Henley is one of the band's most well-known members. In addition to being a member of the Eagles, Mr. Henley has achieved fame as a solo performer and is a public advocate for artists' rights. His name is instantly recognizable by a large portion of the United States population.

2. Duluth Trading Company is a highly successful clothing retailer located in Wisconsin that markets and sells apparel throughout the United States. Duluth is a sophisticated marketer that advertises its products on national and local television stations, by email, and through targeted Internet advertising.

3. In disregard of Mr. Henley's rights in his name and likeness, and in violation of registered trademarks that he owns, Duluth Trading Company created and distributed an advertisement throughout the United States that deliberately invokes Mr. Henley's name and his association with the Eagles (via an Eagles hit song title) to sell its apparel. Large numbers of consumers who receive and see Duluth Trading Company's advertisements will unquestionably believe that Mr. Henley is associated with and/or has endorsed the company and its products, which is untrue.

4. Duluth Trading Company never sought to obtain a license to use Mr. Henley's name or registered marks, and Mr. Henley did not grant the company a license. To the contrary, Mr. Henley has publicly made clear on multiple occasions that he objects to any unlicensed use of his name, trademarks, and other intellectual property rights for commercial purposes.

5. Mr. Henley brings this action to address a clear and unwarranted violation of his rights, and to help ensure that the defendant and other similarly situated retailers discontinue their unlawful violation of his and others' rights. Any financial recovery he obtains from this action will be donated to charity.

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## JURISDICTION AND VENUE

2 6. This action seeks injunctive relief, damages, and other appropriate  
3 relief arises under the laws of the United States, specifically, the Lanham Act, 15  
4 U.S.C. §§ 1051, *et seq.* and California state law.

5 7. This Court has original subject matter jurisdiction over this action  
6 under 28 U.S.C. §§ 1331 and 1338. It has supplemental jurisdiction of the common  
7 and state law claims pursuant to 28 U.S.C. § 1367 in that those claims are related to  
8 claims under this Court's original jurisdiction and form part of the same case or  
9 controversy under Article III of the United States Constitution.

10 8. The Court has personal jurisdiction over Duluth Trading Company  
11 because Duluth Trading Company has established minimum contacts with the forum  
12 and the exercise of jurisdiction over Duluth Trading Company will not offend  
13 traditional notions of fair play and substantial justice. On information and belief,  
14 Duluth Trading Company has voluntarily conducted business and solicited  
15 customers in this District. On information and belief, Duluth Trading Company  
16 conducts continuous and systematic business in the state of California and,  
17 specifically, this District.

18 9. Venue is proper in this District under 28 U.S.C. §§ 1391(b)(2) because  
19 a substantial part of the events giving rise to Mr. Henley's claims occurred in this  
20 District.

## PARTIES

22 10. Plaintiff Don Henley is a songwriter, recording artist, performer, and  
23 public advocate who conducts business in this District.

24 11. On information and belief, Defendant Duluth Holdings Inc., doing  
25 business as Duluth Trading Company, is a Wisconsin corporation with its principal  
26 place of business in Belleville, Wisconsin. On information and belief, Duluth  
27 Trading Company has multiple store locations, enjoys a national customer base, and  
28

1 is a sophisticated national advertiser who markets its clothing nationally, including  
2 in the state of California and, specifically, this District.

### 3 GENERAL ALLEGATIONS

4 12. Mr. Henley is a professional musician and a founding member,  
5 drummer, and singer of the Eagles, which is one of the most successful American  
6 musical groups. Every album that the Eagles has released since 1972 has been  
7 certified platinum, three albums have sold in excess of ten million copies each, and  
8 the Eagles' *Their Greatest Hits 1971-1975* album is the best-selling album of all  
9 time in the United States with sales in excess of 29 million units. The band's first  
10 hit single— "Take It Easy"—was the lead track on the Eagles' self-titled debut  
11 album and on the band's best-selling greatest hits album.

12 13. As a member of the Eagles, Mr. Henley wrote or performed on a long  
13 list of hits, including "Take It Easy," "Witchy Woman," "Desperado," and "Hotel  
14 California." In the 1980s, he launched a successful solo career independent of the  
15 Eagles, during which time he wrote and performed a number of hits including "Dirty  
16 Laundry," "Boys of Summer," and "Sunset Grill." During this time, Mr. Henley  
17 performed concerts around the world, and became well known for his philanthropy  
18 and advocacy on behalf of artists' rights.

19 14. Given the timeless nature of the many hits by the Eagles and Mr.  
20 Henley, their appeal continues to endure. In fact, they remain a part of today's pop  
21 culture and their performances routinely draw large audiences of loyal fans. As a  
22 result of Mr. Henley's undisputed success as both a member of the Eagles and as a  
23 solo artist, he enjoys instant name recognition.

24 15. Mr. Henley uses his name to distinguish his services as a recording and  
25 performing artist and is the registered owner of two trademarks in the name "Don  
26 Henley." U.S. Registration Numbers 2337742 and 2359466 were registered on  
27 April 4, 2000 and June 20, 2000, respectively. A true and correct copy of the  
28 registration certificate for each of these marks is attached as **Exhibit A**. These

1 registrations were duly and legally issued, are valid, subsisting, and incontestable,  
2 and constitute conclusive evidence of the validity of each registered mark, the  
3 registration of each mark, Mr. Henley's ownership of each mark, and of Mr.  
4 Henley's exclusive right to use the registered mark in commerce in connection with  
5 the goods and services listed in each registration certificate. 15 U.S.C. §§ 1115(b),  
6 1057(b). Duluth Trading Company had constructive notice of Mr. Henley's rights  
7 in his federally registered trademarks. 15 U.S.C § 1072.

8 16. On information and belief, on or about October 6, 2014, Duluth  
9 Trading Company distributed an advertisement in interstate commerce that was  
10 directed to residents of this District (the "Advertisement"). The Advertisement  
11 invoked "Don Henley"—Mr. Henley's trademarked name—in an effort to sell  
12 "Henley" style shirts. Specifically, as a means of exploiting the celebrity of Mr.  
13 Henley and the popularity the Eagles' hit record, "Take It Easy," Duluth Trading  
14 Company distributed an email to its nationwide customer base encouraging  
15 customers to "Don a Henley and Take It Easy." A true and correct copy of an  
16 online version of the Advertisement is attached as **Exhibit B**.







1 or association of Duluth Trading Company and/or with Mr. Henley, or as to the  
2 origin, sponsorship, or approval of Duluth Trading Company's goods, services, or  
3 commercial activities by Mr. Henley, in violation of the Lanham Act, 15 U.S.C. §  
4 1125(a).

5 30. Duluth Trading Company knew or should have known that its  
6 unauthorized use of Mr. Henley's trademarked name in conjunction with the title of  
7 the Eagles' hit single, "Take It Easy," was likely to cause confusion or mistake by  
8 the public regarding whether Mr. Henley endorsed, is affiliated, connected to, or  
9 associated with, or approved the Advertisement.

10 31. Due to Duluth Trading Company's unauthorized use of Mr. Henley's  
11 trademarked name, Mr. Henley has and will continue to suffer damages.

12 32. On information and belief, Duluth Trading Company has or will profit  
13 by its wrongful conduct and activities.

14 33. On information and belief, Duluth Trading Company's conduct has and  
15 continues to be intentional, willful, and with full knowledge of the violation of Mr.  
16 Henley's rights.

17 34. Duluth Trading Company is causing and, unless enjoined by the Court,  
18 will continue to cause Mr. Henley irreparable harm for which he has no adequate  
19 remedy at law.

20 35. Mr. Henley is entitled to his attorneys' fees and full costs pursuant to  
21 15 U.S.C. § 1117 and prejudgment interest according to law.

22  
23 **THIRD CLAIM FOR RELIEF**  
**(Violation of California Business & Professions Code § 17200)**

24 36. Mr. Henley incorporates by reference Paragraphs 1 through 35 above as  
25 though fully set forth herein.

26 37. As discussed above, Duluth Trading Company's conduct is likely to  
27 cause confusion or mistake regarding whether Mr. Henley endorsed, is affiliated,  
28 connected to or associated with, or approved the message and content of the



1 Advertisement. The conduct of Duluth Trading Company is intended to and likely  
2 has produced substantial benefits to Duluth Trading Company at the expense of Mr.  
3 Henley.

4 38. Duluth Trading Company's conduct is likely to deceive the general  
5 public and constitutes willful and intentional unlawful, unfair and fraudulent  
6 business practices, in violation of California Business & Professions Code § 17200  
7 *et seq.*

8 39. As a direct and proximate result of Duluth Trading Company's  
9 wrongful conduct, Duluth Trading Company has and will continue to wrongfully  
10 profit.

11 40. As a direct and proximate result of Duluth Trading Company's  
12 wrongful conduct, Mr. Henley has suffered substantial injury in fact. In addition,  
13 Duluth Trading Company's unlawful conduct has and continues to cause irreparable  
14 injury to Mr. Henley and his reputation and goodwill. Unless the improper conduct  
15 is enjoined, Duluth Trading Company will cause further irreparable injury for which  
16 Mr. Henley has no adequate remedy at law.

17 41. Mr. Henley is entitled to an injunction restraining Duluth Trading  
18 Company, its officers, agents, employees, and all persons acting in concert with it,  
19 from engaging in further such unlawful conduct.

20 42. Mr. Henley is further entitled to restitutionary recovery and  
21 disgorgement from Duluth Trading Company.

22  
23 **FOURTH CLAIM FOR RELIEF**  
**(Violation of California Statutory Right of Publicity, Cal. Civ. Code § 3344)**

24 43. Mr. Henley incorporates by reference Paragraphs 1 through 42 above as  
25 though fully set forth herein.

26 44. Without Mr. Henley's consent, Duluth Trading Company has  
27 knowingly caused the Advertisement, which prominently contains Mr. Henley's  
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1 name, to be created and prominently displayed in interstate commerce, including in  
2 this judicial district.

3 45. Such use of Mr. Henley's by Duluth Trading Company was for the  
4 purposes of advertising, selling and soliciting the purchase of Duluth Trading  
5 Company's products, merchandise, goods and services.

6 46. Duluth Trading Company's conduct is in direct violation of California  
7 Civil Code Section 3344, since such acts were without the consent of Mr. Henley.

8 47. There was, and is, a direct connection between the use and exploitation  
9 of Mr. Henley's name and the commercial purposes associated with the promotion  
10 of Duluth Trading Company and its products, merchandise, goods and services.

11 48. As a proximate result of the misappropriation of his name, Mr. Henley  
12 has been and will continue to be harmed.

13 49. The use of Mr. Henley's name in the Advertisements implies that Mr.  
14 Henley endorsed the Duluth Trading Company and/or its products, merchandise,  
15 goods and services.

16 50. As a proximate result of Duluth Trading Company's actions, Mr.  
17 Henley has suffered actual damages in an amount to be proven at trial.

18 51. Pursuant to California Civil Code Section 3344, Mr. Henley is also  
19 entitled to disgorgement of Duluth Trading Company's profits from the  
20 Advertisement, resulting from the unauthorized exploitation of his name, in an  
21 amount to be proven at trial.

22 52. Duluth Trade Company's conduct was willful, malicious and  
23 oppressive; it acted in conscious disregard of Mr. Henly's rights thereby subjecting  
24 Mr. Henley to unjust hardship. Duluth Trading Company well knew that it was  
25 required to obtain approval for its use of Mr. Henley's name. Accordingly, Mr.  
26 Henley seeks an award of punitive damages in an amount to be determined at trial,  
27 for Duluth Trading Company's wrongdoing and to deter it from similar wrongdoing  
28 in the future.

1           53. Pursuant to California Civil Code Section 3344, Mr. Henley is entitled  
2 to recover his attorneys' fees in pursuing this action.

3  
4                                   **FIFTH CLAIM FOR RELIEF**  
                                  **(Common Law Right of Publicity)**

5           54. Mr. Henley incorporates by reference Paragraphs 1 through 53 above as  
6 though fully set forth herein.

7           55. By using his name in conjunction with the title of the Eagles' debut,  
8 highly successful single, "Take It Easy," Mr. Henley is clearly identified in the  
9 Advertisement.

10          56. Duluth Trading Company's use of Mr. Henley's name in the  
11 Advertisement in conjunction with the title of the Eagles' debut, highly successful  
12 single, "Take It Easy," was in interstate commerce and done specifically to increase  
13 sales of its clothing and advance Duluth Trading Company's other interests.

14          57. On information and belief, Duluth Trading Company has or will profit  
15 by its wrongful conduct and activities.

16          58. On information and belief, Duluth Trading Company's decision to use  
17 Mr. Henley's name was knowing and malicious, and done with clear knowledge that  
18 it was a violation of his rights.

19          59. Mr. Henley is entitled to recover from Duluth Trading Company the  
20 damages, including attorneys' fees, he has and will sustain, and any gains, profits,  
21 and advantages obtained by Duluth Trading Company as a result of its infringement  
22 as alleged above, and an award of punitive damages. At present, the amount of such  
23 damages, gains, profits, and advantages cannot fully be ascertained by Mr. Henley.

24                                   **PRAYER FOR RELIEF**

25          WHEREFORE, Mr. Henley respectfully requests that this Court grant relief  
26 against Defendant Duluth Trading Company as follows:

27           a. For temporary, preliminary and permanent injunctive relief against  
28 Duluth Trading Company, prohibiting Duluth Trading Company, its agents, or

1 anyone working for, in concert with or on behalf of Duluth Trading Company from  
2 advertising for sale any merchandise that contains Mr. Henley's name or registered  
3 trademark.

4 b. That Duluth Trading Company pay Mr. Henley the damages he has  
5 sustained in consequence of Duluth Trading Company's conduct.

6 c. That Duluth Trading Company pay Mr. Henley all profits obtained by  
7 Duluth Trading Company as a consequence of Duluth Trading Company's conduct.


8 d. That Mr. Henley recover his costs and reasonable attorneys' fees.

9 e. That Mr. Henley recover punitive damages from Duluth Trading  
10 Company.

11 f. That Mr. Henley have such other and further relief as the Court deems  
12 just and proper.

13 Dated: October 8, 2014

LOEB & LOEB LLP  
THOMAS P. JIRGAL  
MELANIE J. HOWARD

16 By:   
17 Melanie J. Howard  
18 Attorneys for Plaintiff  
19 Don Henley


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**JURY DEMAND**

Mr. Henley hereby demands a trial by jury on all issues so triable.

Dated: October 8, 2014

LOEB & LOEB LLP  
THOMAS P. JIRGAL  
MELANIE J. HOWARDJ

By:   
Melanie J. Howard  
Attorneys for Plaintiff  
Don Henley

# **EXHIBIT A**

**Int. Cl.: 9**

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

**Reg. No. 2,337,742**

**United States Patent and Trademark Office**

**Registered Apr. 4, 2000**

**TRADEMARK  
PRINCIPAL REGISTER**

**DON HENLEY**

**HENLEY, DON (UNITED STATES CITIZEN)  
C/O AZOFF ENTERTAINMENT  
3500 W. OLIVE AVENUESUITE 600  
BURBANK, CA 91505**

**VISUAL DISCS ALL FEATURING MUSIC, IN  
CLASS 9 (U.S. CLS. 21, 23, 26, 36 AND 38).**

**FIRST USE 8-19-1982; IN COMMERCE  
8-19-1982.**

**FOR: SERIES OF MUSICAL SOUND RE-  
CORDINGS; AND A SERIES OF PRE-RECORD-  
ED COMPACT DISCS, PRE-RECORDED  
AUDIO CASSETTES, PRE-RECORDED VIDEO-  
TAPES, AND PRE-RECORDED AUDIO/**

**SER. NO. 75-576,475, FILED 10-27-1998.**

**ANTHONY MERCALDI, EXAMINING ATTOR-  
NEY**

**Exhibit A**

**Int. Cl.: 41**

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

**Reg. No. 2,359,466**

**United States Patent and Trademark Office** **Registered June 20, 2000**

**SERVICE MARK  
PRINCIPAL REGISTER**

**DON HENLEY**

HENLEY, DON (UNITED STATES CITIZEN)  
C/O AZOFF ENTERTAINMENT  
3500 W. OLIVE AVENUE, SUITE 600  
BURBANK, CA 91505

FIRST USE 0-0-1981; IN COMMERCE 0-0-1981.  
THE NAME "DON HENLEY" IDENTIFIES A LIV-  
ING INDIVIDUAL WHOSE CONSENT IS OF  
RECORD.

FOR: ENTERTAINMENT SERVICES IN THE NA-  
TURE OF LIVE MUSICAL PERFORMANCES, IN  
CLASS 41 (U.S. CLS. 100, 101 AND 107).

SER. NO. 75-576,421, FILED 10-27-1998.  
ANTHONY MERCALDI, EXAMINING ATTORNEY


**Exhibit A**



# **EXHIBIT B**

Let's see you vent with our \$19.50 Longtail T Henley deal + FREE Shipping\*



Share with a Friend   
No Bull Guarantee | 866.301.8553

[Men](#) [Women](#) [Workshop](#) [Gifts & Gear](#) [Men's Sale](#) [Women's Sale](#)

FREE SHIPPING ON \$50 ORDERS\*

SHARE CODE: [50OCT](#) 

**DON A HENLEY**  
AND *Take it easy*

**FROM \$19.50 EACH**

LONG SLEEVE  
REG. \$29.50  
NOW \$24.50 EA.

SHORT SLEEVE  
REG. \$24.50  
NOW \$19.50 EA.

**\$19.50 LONGTAIL T HENLEY SALE**

# Exhibit B

Does bending over cause a suspicious amount of snickering from whoever is behind you? Sounds like you could use a Longtail T® Henley. 3" longer to cover your backside plus a 3-button front placket for nice looks and venting where you actually want it. Cover up with a couple at our SALE price!

Longtail T Henley  
From \$19.50

SHOP NOW

\$10 OFF NO GOOD LAZY PANTS



\$10 OFF No Good Lazy Pants:  
Because you deserve some time off

You work hard. But when it's time to relax you deserve real comfort. No Good Lazy pants pile it on with soft easy-moving jersey knit fabric and a roomy fit that really lets you get down to the serious business of chilling out. Get a pair at \$10 OFF today!

Reg. \$39.50  
Now \$29.50

SHOP NOW



FLANNEL CITY FACE-OFF

Free Swingin' Flannel Shirt fans it's time to limber up and get those Armpit Gussets ready for a Flannel City Face-Off. Size up the contenders then VOTE for your favorite Flannel City!

READ MORE

# Exhibit B

**CUSTOMER SERVICE**  
1-866-301-8553  
Track order  
Privacy & Security

**ABOUT US**  
Product Videos  
Watch our TV Ads  
Our Stores

**SHOP MEN'S**  
Buck Naked Underwear  
Fire Hose Work Pants  
Free Swingin' Flannel

**SHOP WOMEN'S**  
Longtail T Shirts  
Free Swingin' Flannel  
New Arrivals



KEEP UP WITH DULUTH



Need help with an order? Have something on your mind?  
Call **1-866-301-8553** or email us at:  
[customerservice@duluthtrading.com](mailto:customerservice@duluthtrading.com)

Add [duluthtrading@duluthtradingemail.com](mailto:duluthtrading@duluthtradingemail.com) to your address book or "safe list" to ensure delivery. Please don't use your email's "Reply" function. We don't monitor this address.

This message was sent to: [daughetyfamily@att.net](mailto:daughetyfamily@att.net)  
[Unsubscribe](#) [Update email preferences](#)

**OFFER NOTES:** Click on any link from this email to start shopping or call 1-866-301-8553 and mention promo code "**T14C166P**" to get Free Shipping on orders of \$50 or more. \$50 minimum order requirement applies to the order total before taxes, shipping, gift packaging and gift cards. Valid on domestic standard delivery (5-7 business days) only. **Email subscribers (that's you, smarty pants) receive our very best deals, promotions and special offers. So how can you get even better offers than best? You can't! So please understand, email offers are not valid in combination with any other offers.** Longtail T Henley offer valid on style 67009, 94113, 56014 only. Advertised prices are good on regular sizes; additional charges may apply to Big and Tall sizes. Not valid for use on prior purchases. Not valid in the Duluth Trading Retail Stores. Offers expire at 11:59 p.m. CT on October 12, 2014.

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170 Countryside Drive, Belleville, WI 53508

# Exhibit B