

1 Paul A. Stewart (SBN 153,467)
paul.stewart@knobbe.com
2 Ali S. Razai (SBN 246,922)
ali.razai@knobbe.com
3 Nicole Rossi Townes (CA SBN 272,342)
nicole.townes@knobbe.com
4 KNOBBE, MARTENS, OLSON & BEAR, LLP
2040 Main Street, Fourteenth Floor
5 Irvine, CA 92614
Phone: (949) 760-0404
6 Facsimile: (949) 760-9502

7 David G. Kim (SBN 307,821)
david.kim@knobbe.com
8 KNOBBE, MARTENS, OLSON & BEAR, LLP
1925 Century Park East, Suite 600
9 Los Angeles, CA 90067
Telephone: (310) 551-3450
10 Facsimile: (310) 601-1263

11 Attorneys for Plaintiff,
DELICATO VINEYARDS
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IN THE UNITED STATES DISTRICT COURT
FOR THE NORTHERN DISTRICT OF CALIFORNIA

17 _____
DELICATO VINEYARDS, a California
18 corporation,

19 Plaintiff,

20 v.

21 ALEXA COHN, KATIE BARRY, and
ANDREW COHN, individuals, d/b/a
22 BOTA BACKPACK,

23 Defendants.

) Case No. 3:20-cv-7668

) **COMPLAINT FOR TRADEMARK**
) **INFRINGEMENT, FALSE**
) **DESIGNATION OF ORIGIN, UNFAIR**
) **COMPETITION, AND CANCELLATION**
) **OF TRADEMARK REGISTRATION**

) **DEMAND FOR JURY TRIAL**
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1 Plaintiff Delicato Vineyards (“Delicato”) hereby complains of Defendants Alexa Cohn,
2 Katie Barry, and Andrew Cohn, individuals doing business as Bota Backpack (“Defendants”)
3 and alleges as follows:

4 **I. INTRODUCTION**

5 1. Delicato is a family-owned wine company that was founded in California in
6 1924. For more than 90 years, the Indelicato family has owned and operated Delicato
7 Vineyards, which is one of the fastest growing top-ten wine companies in the United States.
8 Delicato has offered wine under the distinctive trademarks BOTA[®], BOTA BOX[®], BOTA
9 MINI[®], and BOTA BRICK[®] (collectively, “BOTA[®] Marks”) for almost seventeen years and,
10 through significant time, effort, and expense, Delicato has amassed considerable goodwill in
11 its BOTA[®] Marks. Recently, Delicato learned that Defendants began using the identical BOTA
12 mark and confusingly similar BOTA BACKPACK mark in connection with their products,
13 including backpacks for carrying beverages.

14 **II. INTRADISTRICT ASSIGNMENT**

15 2. This action is an intellectual property action subject to district-wide assignment
16 pursuant to Local Civil Rules 3-2(c) and 3-5(b).

17 **III. JURISDICTION AND VENUE**

18 3. This is an action for (1) trademark infringement under 15 U.S.C. § 1114, (2)
19 trademark infringement and false designation of origin under 15 U.S.C. § 1125(a), (3) petition
20 for cancellation of U.S. Trademark Registration No. 5,922,942, (4) unfair competition under
21 California Business & Professions Code §§ 17200, *et seq.*, and (5) California common law
22 unfair competition.

23 4. The Court has original subject matter jurisdiction over the claims that relate to
24 trademark infringement, false designation of origin, and cancellation of a U.S. Trademark
25 Registration pursuant to 15 U.S.C. §§ 1116 and/or 1121(a) and also pursuant to 28 U.S.C.
26 §§ 1331 and 1338, as these claims arise under the laws of the United States. The Court has
27 supplemental jurisdiction over the claims in this Complaint that arise under state statutory and
28 common law pursuant to 28 U.S.C. §§ 1338(b) and 1367(a), because the state law claims are

1 so related to the federal claims that they form part of the same case or controversy and derive
2 from a common nucleus of operative facts.

3 5. This Court has personal jurisdiction over Defendants because Defendants have
4 a continuous, systematic, and substantial presence within this Judicial District and within
5 California. Defendants' offices are located within this Judicial District at 275 South Maple
6 Avenue, South San Francisco, California. Defendants advertise, market, promote, sell, and
7 offer to sell their products in California, including in this Judicial District. In addition, by
8 committing acts of trademark infringement, false designation of origin, and unfair competition
9 in this Judicial District, including, but not limited to, by using infringing marks in connection
10 with the advertisement, marketing, promotion, sale, and offer for sale of goods to customers in
11 this Judicial District, Defendants' acts form a substantial part of the events or omissions giving
12 rise to Delicato's claims.

13 6. Venue is proper in this Judicial District pursuant to 28 U.S.C. § 1391(b) and (c)
14 at least because Defendants' principal place of business is in this Judicial District and a
15 substantial portion of the events complained of herein have taken place in this Judicial District.

16 **IV. THE PARTIES**

17 7. Delicato is a corporation organized and existing under the laws of the State of
18 California, having a principal place of business at 12001 South Highway 99, Manteca,
19 California 95336.

20 8. Delicato is informed and believes, and based thereon alleges that Defendant
21 Alexa Cohn is an individual residing at 702 E. Osborn Road, Phoenix, Arizona 85014 and doing
22 business as Bota Backpack, having a principal place of business at 275 South Maple Avenue,
23 South San Francisco, California 94080.

24 9. Delicato is informed and believes, and based thereon alleges that Defendant
25 Katie Barry is an individual residing at 702 E. Osborn Road, Phoenix, Arizona 85014 and doing
26 business as Bota Backpack, having a principal place of business at 275 South Maple Avenue,
27 South San Francisco, California 94080.

1 **Exhibit C** is a true and correct copy of the '650 Registration, which is incorporated by
2 reference. Pursuant to 15 U.S.C. § 1065, the '650 Registration is incontestable.

3 17. Delicato owns U.S. Trademark Registration No. 4,693,255 (the "'255
4 Registration") for the BOTA BRICK[®] mark, which was filed on November 19, 2013. Attached
5 hereto as **Exhibit D** is a true and correct copy of the '255 Registration, which is incorporated
6 by reference. Pursuant to 15 U.S.C. § 1065, the '255 Registration is incontestable.

7 18. As a result of Delicato's long, continuous, extensive and exclusive use of the
8 BOTA[®] Marks, as well as its marketing, promotion, and sale of products under the marks, the
9 relevant public has come to recognize the BOTA[®] Marks as identifying products that originate
10 from or are otherwise associated exclusively with Delicato. Delicato has spent enormous, time,
11 effort, and expense to create valuable goodwill in the BOTA[®] Marks.

12 19. At least fifteen years after Delicato started using the BOTA[®] Marks for wine,
13 Defendants began using the BOTA and BOTA BACKPACK marks in connection with
14 backpacks for carrying beverages.

15 20. On April 18, 2018, Defendants filed U.S. Trademark Application No.
16 87/788,3248 for the BOTA BACKPACK mark for "Backpacks for carrying hydrating fluids,
17 not to include alcoholic beverages; Backpacks compatible with personal hydration systems,
18 sold empty." During the prosecution of this application, Defendants agreed to a disclaimer for
19 "BACKPACK." On November 26, 2019, Defendants' trademark application matured into U.S.
20 Registration No. 5,922,942 ("the '942 Registration"). Attached hereto as **Exhibit E** is a true
21 and correct copy of the '942 Registration, which is incorporated by reference.

22 21. On May 5, 2020, Delicato sent Defendant Alexa Cohn a cease and desist letter
23 demanding that Defendants cease using the BOTA and BOTA BACKPACK marks. Attached
24 hereto as **Exhibit F** is a true and correct copy of Delicato's cease and desist letter dated May
25 5, 2020.

26 22. Despite Delicato's letter dated May 5, 2020, Defendants have continued to use
27 the BOTA and BOTA BACKPACK marks.

1 23. Defendants are not affiliated with Delicato. Delicato has never given
2 Defendants license, permission or authority to use or display the BOTA[®] Marks or any similar
3 marks.

4 24. Defendants have attempted to capitalize on Delicato's valuable reputation and
5 customer goodwill in the BOTA[®] Marks by using the identical BOTA mark and confusingly
6 similar BOTA BACKPACK mark in connection with the advertisement, marketing, promotion,
7 sale, and/or offer for sale of backpacks for carrying beverages. Defendants' backpacks for
8 carrying beverages sold in connection with the identical BOTA mark and confusingly similar
9 BOTA BACKPACK mark are highly related to Defendants' products which are beverages.

10 25. Defendants were aware of Delicato's BOTA[®] Marks at least as early as May 5,
11 2020 when Delicato sent its cease and desist letter. Despite receiving Delicato's cease and
12 desist letter, Defendants have continued to use the infringing BOTA and BOTA BACKPACK
13 marks.

14 26. Without permission or consent from Delicato, Defendants have infringed
15 Delicato's BOTA[®] Marks in interstate commerce by advertising, marketing, promoting,
16 selling, and/or offering to sell products under the BOTA and BOTA BACKPACK marks.

17 27. Delicato is informed and believes, and based thereon alleges that Defendants'
18 actions alleged herein are intended to cause confusion, mistake, or deception as to the source
19 of Defendants' products and are intended to cause consumers and potential customers to believe
20 that Defendants' products are associated with, sponsored by, originate from, or are approved
21 by, Delicato, when they are not.

22 28. By virtue of the acts complained of herein, Defendants have created a likelihood
23 of injury to Delicato's business reputation and goodwill, caused a likelihood of consumer
24 confusion, mistake, and deception as to the source of, origin or relationship of Defendants'
25 products with Delicato, and have otherwise competed unfairly with Delicato by unlawfully
26 trading on and using Delicato's BOTA[®] Marks without Delicato's permission or consent.

27 29. Delicato is informed and believes, and based thereon alleges that Defendants'
28 acts complained of herein are willful and deliberate.

1 38. Delicato is informed and believes, and based thereon alleges that Defendants
2 had actual knowledge of Delicato's ownership and prior use of the BOTA[®] Marks, and that
3 Defendants have willfully infringed Delicato's trademark rights under 15 U.S.C. § 1114.

4 39. Defendants, by their actions, have damaged Delicato in an amount to be
5 determined at trial.

6 40. Defendants, by their actions, have irreparably injured Delicato. Such irreparable
7 injury will continue unless Defendants are preliminarily and permanently enjoined by this
8 Court from further violating Delicato's rights, for which Delicato has no adequate remedy at
9 law.

10 **VII. SECOND CLAIM FOR RELIEF**

11 (Trademark Infringement and False Designation of Origin

12 under 15 U.S.C. § 1125(a))

13 41. Delicato hereby repeats, realleges, and incorporates by reference paragraphs 1-
14 40 of this Complaint as though fully set forth herein.

15 42. This is an action for trademark infringement and false designation of origin
16 under 15 U.S.C. § 1125(a).

17 43. As a result of Delicato's widespread use and promotion of the BOTA[®] Marks,
18 the marks have acquired strong secondary meaning to consumers and potential customers, in
19 that consumers and potential customers have come to associate the BOTA[®] Marks with
20 Delicato. Delicato's BOTA[®] Marks are also inherently distinctive.

21 44. Defendants have infringed the BOTA[®] Marks and created a false designation of
22 origin by using in commerce, without Delicato's permission, identical and confusingly similar
23 marks in connection with the advertising, marketing, promotion, sale, and/or offer for sale of
24 Defendants' products.

25 45. Defendants' actions are likely to cause confusion and mistake, or to deceive as
26 to the affiliation, connection, or association of Defendants with Delicato, and/or as to the origin,
27 sponsorship, or approval of Defendants' products or commercial activities, in violation of 15
28 U.S.C. § 1125(a).

1 and '255 Registration are all prior to the filing date of Defendants' U.S. Trademark Registration
2 No. 5,922,942.

3 54. Delicato will be damaged by continued registration of Defendants' U.S.
4 Trademark Registration No. 5,922,942 in that the BOTA BACKPACK mark shown therein is
5 confusingly similar to Delicato's BOTA[®] Marks. The registration and use of the BOTA
6 BACKPACK mark shown in U.S. Trademark Registration No. 5,922,942 in connection with
7 the goods identified therein, namely, backpacks that carry beverages, are likely to cause
8 confusion, or to cause mistake or to deceive within the meaning of Section 2(d) of the
9 Trademark Act, 15 U.S.C. § 1052(d).

10 55. In view of Delicato's prior rights and trademark registrations for the BOTA[®]
11 Marks, Defendants are not entitled to federal registration of the BOTA BACKPACK mark
12 shown in U.S. Trademark Registration No. 5,922,942, and this registration should be cancelled.

13 **IX. FOURTH CLAIM FOR RELIEF**

14 (Unfair Competition under California Business &
15 Professions Code §§ 17200 *et seq.*)

16 56. Delicato hereby repeats, realleges, and incorporates by reference paragraphs 1-
17 55 of this Complaint as though fully set forth herein.

18 57. This is an action for unfair competition under California Business & Professions
19 Code §§ 17200, *et seq.*

20 58. By virtue of the acts complained of herein, Defendants have intentionally caused
21 a likelihood of confusion among consumers and the public and has unfairly competed with
22 Delicato in violation of Cal. Bus. & Prof. Code §§ 17200, *et seq.*

23 59. Defendants' acts complained of herein constitute trademark infringement,
24 unfair competition, and unlawful, unfair, or malicious business practices, which have injured
25 and damaged Delicato.

26 60. Defendants, by their actions, have irreparably injured Delicato. Such irreparable
27 injury will continue unless Defendants are preliminarily and permanently enjoined by this
28 Court from further violating Delicato's rights, for which Delicato has no adequate remedy at

1 law.

2 **X. FIFTH CLAIM FOR RELIEF**

3 (California Common Law Unfair Competition)

4 61. Delicato hereby repeats, realleges, and incorporates by reference paragraphs 1-
5 60 of this Complaint as though fully set forth herein.

6 62. This is an action for unfair competition under the common law of the State of
7 California.

8 63. Defendants' acts complained of herein constitute trademark infringement and
9 unfair competition under the common law of the State of California.

10 64. By virtue of the acts complained of herein, Defendants have willfully and
11 intentionally caused a likelihood of confusion among the purchasing public in this Judicial
12 District and elsewhere, thereby unfairly competing with Delicato in violation of the common
13 law of the State of California.

14 65. Defendants' aforementioned acts have damaged Delicato in an amount to be
15 determined at trial.

16 66. Defendants have irreparably injured Delicato. Such irreparable injury will
17 continue unless Defendants are preliminarily and permanently enjoined by this Court from
18 further violating Delicato's rights, for which Delicato has no adequate remedy at law.

19 67. Defendants' willful acts of unfair competition under California common law
20 constitute fraud, oppression and malice. Accordingly, Delicato is entitled to exemplary
21 damages pursuant to Cal. Civ. Code Section § 3294(a).

22 **PRAYER FOR RELIEF**

23 WHEREFORE, Delicato prays for judgment against Defendants as follows:

24 A. That the Court render a final judgment in favor of Delicato and against
25 Defendants on all claims for relief alleged herein;

26 B. That the Court render a final judgment that Defendants have willfully violated
27 the provisions of 15 U.S.C. § 1114 by infringing Delicato's trademark rights in at least the
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1 marks that are the subject of Delicato's U.S. Trademark Registration Nos. 3,519,182,
2 4,606,926, 4,581,650, and 4,693,255;

3 C. That the Court render a final judgment that Defendants have violated the
4 provisions of 15 U.S.C. § 1125(a) by willfully infringing the BOTA® Marks by using a false
5 designation of origin, through the marketing, sale, and promotion of Defendants' products;

6 D. That the Court direct the United States Patent and Trademark Office to cancel
7 U.S. Trademark Registration No. 5,922,942;

8 E. That the Court render a final judgment declaring that Defendants have violated
9 California Business and Professions Code §§ 17200, *et seq.* by committing trademark
10 infringement and unfairly competing with Delicato;

11 F. That the Court render a final judgment declaring that Defendants have violated
12 California common law by unfairly competing with Delicato;

13 G. That Defendants, their agents, servants, employees, attorneys, successors, and
14 assigns, and all other persons in active concert or participation with Defendants be enjoined
15 from:

16 i. using the BOTA mark, the BOTA BACKPACK mark, or any other mark
17 that is confusingly similar to the BOTA® Marks in connection with the advertisement,
18 marketing, promotion, sale, or offer for sale of Defendants' products, including, but not
19 limited to, products related to wine;

20 ii. using the BOTA mark, BOTA BACKPACK mark, or any confusingly
21 similar variation of the BOTA® Marks in any manner that is likely to create the
22 impression that Defendants' products originate from Delicato, are endorsed by
23 Delicato, or are connected in any way with Delicato;

24 iii. filing any applications for registration of the BOTA mark, any
25 trademarks including "BOTA", or any other mark that is confusingly similar to the
26 BOTA® Marks;

27 iv. falsely designating the origin of Defendants' products;

28 v. unfairly competing with Delicato in any manner whatsoever; and,

1 vi. causing a likelihood of confusion or injury to Delicato's business
2 reputation;

3 H. That Defendants be directed to file with this Court and serve on Delicato within
4 thirty (30) days after the service of the injunction, a report, in writing, under oath, setting forth
5 in detail the manner and form in which they have complied with the injunction pursuant to 15
6 U.S.C. § 1116;

7 I. That Defendants be required to account to Delicato for any and all profits
8 derived by Defendants and all damages sustained by Delicato by virtue of Defendants' acts
9 complained of herein;

10 J. That Defendants be ordered to pay Delicato all damages which Delicato has
11 sustained as a consequence of the acts complained of herein, subject to proof at trial, together
12 with prejudgment and post-judgment interest;

13 K. That this case be deemed exceptional and the amount of damages be trebled and
14 that the amount of profits be increased by as many times as the Court deems appropriate,
15 pursuant to 15 U.S.C. § 1117;

16 L. That Delicato be awarded exemplary damages from Defendants pursuant to Cal.
17 Civ. Code. § 3294;

18 M. That Defendants' actions be deemed willful;

19 N. That an award of reasonable costs, expenses, and attorneys' fees be awarded to
20 Delicato pursuant to at least 15 U.S.C. § 1117;

21 O. That Defendants be required to deliver and destroy all devices, literature,
22 advertising, goods, packaging, and other unauthorized materials bearing the BOTA mark, the
23 BOTA BACKPACK mark, or any confusingly similar marks, pursuant to 15 U.S.C. § 1118;

24 P. That Delicato be awarded restitution and disgorgement; and,

25 Q. That Delicato be awarded such other and further relief as this Court may deem
26 just.

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Respectfully submitted,
KNOBBE, MARTENS, OLSON & BEAR, LLP

Dated: October 30, 2020

By: /s/ Paul A. Stewart
Paul A. Stewart
Ali S. Razai
Nicole Rossi Townes
David G. Kim

Attorneys for Plaintiff,
DELICATO VINEYARDS

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DEMAND FOR TRIAL BY JURY

Pursuant to Rule 38(b) of the Federal Rules of Civil Procedure, Plaintiff Delicato Vineyards hereby demands a trial by jury on all issues so triable.

Respectfully submitted,
KNOBBE, MARTENS, OLSON & BEAR, LLP

Dated: October 30, 2020

By: /s/ Paul A. Stewart
Paul A. Stewart
Ali S. Razai
Nicole Rossi Townes
David G. Kim

Attorneys for Plaintiff,
DELICATO VINEYARDS

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