

Keith J. Miller  
ROBINSON MILLER LLC  
Ironside Newark  
110 Edison Place, Suite 302  
Newark, New Jersey 07102  
Telephone: (973) 690-5400  
kmiller@rwmlegal.com

David Donahue (admitted *pro hac vice*)  
Laura Popp-Rosenberg (admitted *pro hac vice*)  
Daniel M. Nuzzaci (admitted *pro hac vice*)  
FROSS ZELNICK LEHRMAN & ZISSU, P.C.  
151 West 42nd, 17th Floor  
New York, New York 10036  
Telephone: (212) 813-5900

*Attorneys for Plaintiff INEOS Automotive Limited*

**UNITED STATES DISTRICT COURT  
DISTRICT OF NEW JERSEY**

INEOS AUTOMOTIVE LIMITED,

Plaintiff,

v.

JAGUAR LAND ROVER LIMITED and  
JAGUAR LAND ROVER NORTH  
AMERICA, LLC,

Defendants.

Case No.: 2:21-cv-13174-JXN-JBC

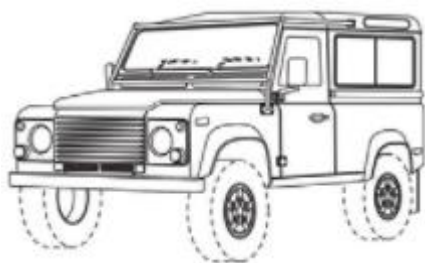
**FIRST AMENDED COMPLAINT FOR  
DECLARATORY JUDGMENT**

Plaintiff INEOS Automotive Limited (“Plaintiff”), by its undersigned counsel, for its First Amended Complaint for Declaratory Judgment against Defendants Jaguar Land Rover Limited (“JLR Ltd.”) and Jaguar Land Rover North America LLC (“JLR NA,” and together with JLR Ltd., “Defendants”), alleges as follows:

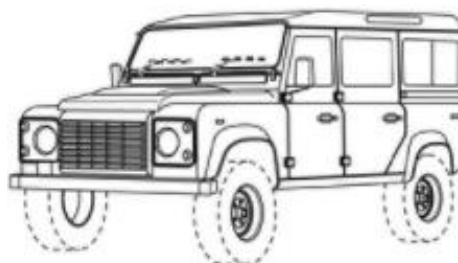
**SUBSTANCE OF THE ACTION**

1. This case arises out of Defendants’ international campaign to interfere with Plaintiff’s launch of a highly-anticipated 4x4 automotive vehicle called the INEOS

GRENADIER based on Defendants’ purported trade dress rights in the design of a two-door 4x4 utility vehicle known as the Land Rover Defender NAS 90 (the “Discontinued Two-Door Design”) and the design of a four-door 4x4 utility vehicle known as the Land Rover Defender NAS 110 (the “Discontinued Four-Door Design,” and together with the Discontinued Two-Door Design, the “Discontinued Designs”) that were little-used at the outset and were long-ago abandoned in the United States market, renderings of which are shown here:



*Discontinued Two-Door Design*



*Discontinued Four-Door Design*

2. Specifically, after INEOS group (“INEOS”) first announced plans to develop the INEOS GRENADIER in 2016, JLR Ltd. contacted INEOS and threatened to file suit “in any relevant jurisdiction” based on its purported rights in the Discontinued Designs. In a further attempt to thwart Plaintiff’s plans, JLR Ltd. embarked on a global campaign to obtain trademark registrations for the Discontinued Designs, including in the United States where Defendants falsely claimed *current* use of the Discontinued Designs in commerce even though Defendants had ceased manufacturing and selling vehicles featuring the Discontinued Designs in the United States market more than two decades ago.

3. Making good on its prior threat, JLR Ltd. so far in 2021 has already filed suit against Plaintiff in two jurisdictions—Spain and Italy—alleging claims for trademark infringement and unfair competition (relying on, among other marks, 3-D trademarks that are directly comparable to the Discontinued Two-Door Design and Discontinued Four-Door Design) and seeking preliminary injunctions against Plaintiff’s sale of the INEOS GRENADIER. JLR

Ltd. has also recently issued a cease-and-desist letter in the Netherlands. In both the Dutch letter and the Spanish and Italian proceedings, JLR Ltd. consistently calls the INEOS GRENADIER a direct or blatant copy of the Discontinued Designs.

4. In light of the clear threat of litigation by Defendants in the United States, there exists a substantial controversy between the parties—who have adverse legal interests—that is of sufficient immediacy and reality to warrant the issuance of a declaratory judgment. Accordingly, Plaintiff seeks a declaratory judgment that (i) Defendants’ purported trade dress rights in the Discontinued Designs are invalid and unenforceable; (ii) the marketing, importation, distribution, and sale of the INEOS GRENADIER does not infringe any purported rights Defendants may have in the Discontinued Designs; and (iii) the marketing, importation, distribution, and sale of the INEOS GRENADIER is not likely to cause confusion and does not constitute unfair competition with the Discontinued Designs.

#### **THE PARTIES**

5. Plaintiff is a limited liability company incorporated under the laws of England and Wales with an address at Hawkslease, Chapel Lane, Lyndhurst, Hampshire S043 7FG, United Kingdom.

6. Defendant JLR Ltd. is the principal commercial entity (as well as, among other things, primary owner of intellectual property rights) within a multinational group of companies in the automotive business. JLR Ltd. and its related companies produce luxury and sport utility automotive vehicles under the brands JAGUAR and LAND ROVER and sell them throughout the world, including in the United States. Upon information and belief, JLR Ltd. is a private company limited by shares (prc) incorporated under the laws of the United Kingdom with an address at Abbey Road, Whitley, Coventry CV3 4LF, United Kingdom.

7. Upon information and belief, JLR Ltd. operates in the United States through defendant JLR NA, which functions as JLR Ltd.'s North American headquarters. JLR NA is a wholly owned subsidiary of JLR Ltd. and is JLR Ltd.'s exclusive authorized distributor for new Jaguar and Land Rover vehicles in the United States. According to a declaration submitted to the the United States Patent and Trademark Office ("USPTO") by JLR NA's Corporate Counsel, JLR NA also is "charged with enforcement of [JLR Ltd.'s] trademark rights in the United States." Upon information and belief, JLR NA is a Delaware limited liability company with a principal place of business at 100 Jaguar Land Rover Way, Mahwah, New Jersey 07495.

### **JURISDICTION AND VENUE**

8. This Court has jurisdiction over the subject matter of this action pursuant to 28 U.S.C. § 2201, which permits the Court to declare the rights of any party seeking a declaration, and pursuant to Section 39 of the Lanham Act, 15 U.S.C. § 1121, because this action arises from Defendants' unmeritorious claim that Plaintiff's marketing, importation, distribution and sale of the INEOS GRENADIER infringes upon Defendants' purported trade dress rights in the Discontinued Designs. The Court also has subject matter jurisdiction under 28 U.S.C. §§ 1331 and 1338(a) because this action arises under the federal Trademark (Lanham) Act.

9. The Court has general personal jurisdiction over JLR NA because it is a domiciliary of this State by virtue of having its principal place of business at 100 Jaguar Land Rover Way, Mahwah, New Jersey.

10. The Court has general personal jurisdiction over JLR Ltd. because JLR NA is a merely the alter ego or agent of its parent and controlling company JLR Ltd., and the Court has general personal jurisdiction over JLR NA.

11. The Court has specific personal jurisdiction over JLR Ltd. Upon information and belief, JLR Ltd. has purposefully directed its activities at New Jersey by establishing the North American “arm” of its business in Mahwah, New Jersey, and maintaining a substantial, ongoing relationship with this New Jersey-based subsidiary. The instant declaratory judgment action arises out of JLR Ltd.’s activities that are purposefully directed towards this State because Mahwah, New Jersey, is the locus of JLR Ltd.’s enforcement activities within the United States, as demonstrated by, among other things: (i) Mahwah-based JLR NA is entrusted to enforce JLR Ltd.’s trademark rights in the United States; and (ii) JLR Ltd. directed Mahwah-based JLR NA officers and employees to execute the U.S. Trademark Applications for the Discontinued Designs on JLR’s behalf and to submit declarations to the United States Patent and Trademark Office supporting JLR’s false claim of use in commerce of the Discontinued Designs in the United States. Finally, the exercise of specific personal jurisdiction over JLR Ltd. otherwise comports with fair play and substantial justice.

12. Venue is proper in this district pursuant to 28 U.S.C. § 1391(b).

### **FACTS GIVING RISE TO THIS ACTION**

#### **A. Plaintiff and the INEOS GRENADIER**

13. Plaintiff is a subsidiary company of INEOS Industries Holdings Limited and the automotive business of multinational chemicals and industrial group INEOS.

14. In 2016, INEOS announced plans to manufacture INEOS’s own stripped-back, utilitarian, truly functional, off-road 4x4 vehicle to fill the gap in the market left by—among others—the Land Rover Defender, which had ceased production worldwide by that time. In 2017, INEOS founded Plaintiff to bring this goal to fruition.

15. On February 13, 2017, Plaintiff publicly announced in a press release titled “INEOS Automotive to Build ‘Uncompromising’ 4x4 Off-Roader” that it was prepared to invest “many hundreds of millions” to develop, manufacture, and distribute a brand new 4x4 automotive vehicle.

16. As stated in the February 13 press release, Plaintiff’s goal in developing the new vehicle was to “build the world’s purest 4x4” and to market it to “explorers, farmers and off-road enthusiasts across the globe.”

17. On July 1, 2020—after years of numerous design iterations, modifications, and changes—Plaintiff publicly revealed the exterior design of the INEOS GRENADIER. In a press release titled “INEOS Automotive Reveals the Design of its Upcoming 4x4, the Grenadier,” Plaintiff stated that with respect to the design of the INEOS GRENADIER, “[n]othing is for show. Modern engineering and production techniques ensure the Grenadier is highly capable, but we have been able to stay true to the essence of creating a utilitarian vehicle that will stand the test of time.”

18. Plaintiff further stated in its July 1 press release that “[t]he Grenadier project started by identifying a gap in the market, abandoned by a number of manufacturers, for a utilitarian off-road vehicle. This gave us our engineering blueprint for a capable, durable and reliable 4X4 built to handle the world’s harshest environments.”

19. The ultimate design of the INEOS GRENADIER is inspired by numerous older-style 4x4 utility vehicles and combines rugged British spirit with German engineering. The result is an uncompromising 4x4 vehicle designed to overcome all conditions and provide best-in-class off-road capability, durability, and reliability. A true and correct copy of an image showing the final design for the INEOS GRENADIER is attached hereto as **Exhibit A**.

20. On September 4, 2020, Plaintiff issued a press release titled “INEOS Grenadier Prototype Takes a Bow to its Inspirations at Concours of Elegance.” Through the press release, Plaintiff announced that the INEOS GRENADIER prototype would be “on display at the Concours of Elegance,” a celebrated event for classic and vintage cars, “at Hampton Court Palace, London, over the weekend of September 4 to 6.” Notably, Plaintiff’s Concours of Elegance display featured a number of historic 4x4s, including “the first ever production Land Rover (registration JUE 477),” “a fully restored Toyota FJ40 (1980),” “a Willys Jeep (1944) that was used by the US Navy in WWII,” and “a classic Mercedes-Benz G-Wagen (1988).”

21. The September 4 press release makes clear that the design for the INEOS GRENADIER was inspired by the common traits of numerous historic 4x4 utility vehicles. In particular, Plaintiff stated that “[a]t the outset of the Grenadier project, we brought some of the great 4X4s of the past into the studio to look closely at what made them so enduring . . . [a]nd now, it’s fantastic to see Grenadier in the company of these legends. You can see common design traits and proportions, and certainly the same clarity of purpose. . . . [T]he Grenadier sits very naturally among these 4X4 icons, and if others agree, then we’ve achieved our design objective.”

22. On May 21, 2021, Plaintiff issued a press release titled “The Grenadier Prototype Arrives for its First US Tour.” A true and correct copy of the aforementioned press release is attached hereto as **Exhibit B**. In the press release, Plaintiff stated that “the very first Grenadier 4x4 prototype – Grenadier 001 – has made its inaugural trip to the US. Its tour will take it across the country, from Texas to New York, as Americans [get] their first opportunity to see the uncompromising 4x4 for themselves.” (See **Exhibit B**.) The U.S. tour took place in late May 2021, with stops in Texas, Virginia, New Jersey, and New York City.

23. During Plaintiff's tour stop in New Jersey, Plaintiff visited BMW North America ("BMW NA") headquarters in Woodcliff Lake, New Jersey, to present the prototype of the INEOS GRENADIER vehicle to the President and Chief Executive Officer of BMW NA. Plaintiff and BMW NA held discussions on sales as well as on service and U.S. marketing strategy. Plaintiff and BMW have partnered on powertrain technology for the INEOS GRENADIER, meaning that BMW will supply the engines for Plaintiffs' 4x4.

24. While the INEOS GRENADIER is currently scheduled for release in the United States in 2023, Plaintiff has already begun marketing the vehicle to U.S. consumers on its website at *ineosgrenadier.com/en-us* ("Plaintiff's Website").

25. Plaintiff's Website includes information about the development and design of the INEOS GRENADIER. For example, Plaintiff's Website states that the design of the vehicle uses "[a] boxy exterior for strength. A wheel at each corner for stability. Split rear doors for easy access. If it's there, it's there for a reason."

26. Plaintiff's Website has further information about the utilitarian underpinnings for specific design elements. For example, "high bumpers and a tucked-up exhaust allow optimal approach and departure angles," "a wheel on each corner, linked by beam axles . . . means minimal overhang, a planted appearance and maximum tractability – whatever the surface," "roof rails and loading strips [means] you can mount loads to the top of the vehicle without the need for a separate roof rack," a split rear door frame allows for "use [of] the left rear door without opening the whole cargo bay" because "[s]plitting the rear doors doesn't just make them versatile[,] [i]t makes them easier to operate," "optional door-mounted ladder provides access to more storage on the roof," and "optional utility belts" that "can be used to strap down loads mounted on the roof, or to fix accessories to the vehicle's sides."



27. Plaintiff's Website also allows consumers to "register their interest" in the INEOS GRENADIER vehicle. The consumers who have signed up, which include many United States consumers, receive "the very first look at [the] latest updates, exclusive content and the chance to order before anyone else." A true and correct copy of the aforementioned webpage is attached hereto as **Exhibit C**.

28. Plaintiff also commenced early-access reservations to consumers in the United States who register their interest in purchasing the INEOS GRENADIER vehicle. Registered consumers who pay a \$450 reservation fee will have priority when the ordering window for the INEOS GRENADIER opens. Consumers who register also are permitted to customize and configure their prospective vehicles to their exact specifications to facilitate checkout and delivery when the INEOS GRENADIER becomes available. Numerous New Jersey-based consumers have taken advantage of this opportunity by paying the \$450 reservation fee.

29. Plaintiff also has spent significant time developing its U.S. market-introduction strategy for the INEOS GRENADIER, including selecting key states where Plaintiff intends to establish dealerships and meeting with prospective dealer partners, including in New Jersey.

30. Plaintiff has spent significant resources advertising and promoting the release of the INEOS GRENADIER across a variety of media, including its website, in news articles, social media, and in print advertising.

31. To further protect its rights in the INEOS GRENADIER upon the vehicle's imminent release in the United States, Plaintiff filed trademark applications in the USPTO to register, among others, the trademarks PROJEKT GRENADIER and GRENADIER.

32. On May 14, 2019, the USPTO issued U.S. Trademark Registration No. 5747935 for the mark PROJEKT GRENADIER in, *inter alia*, International Class 12 for use in connection with “Land vehicles; structural parts and fittings for the aforesaid goods.”

33. On June 4, 2019, the USPTO issued U.S. Trademark Registration No. 5766287 for the mark GRENADIER in, *inter alia*, International Class 12 for use in connection with “Land vehicles; structural parts and fittings for the aforesaid goods.”

**B. Defendants and the Discontinued Designs**

34. Upon information and belief, the only vehicle manufactured by JLR Ltd. for the United States market purportedly bearing the Discontinued Four-Door Design was a four-door 4x4 vehicle known as the Land Rover Defender NAS 110.

35. Upon information and belief, the Land Rover Defender NAS 110 vehicle was available in the U.S. market for only one model year (1993), came in only one color (alpine white), and came equipped with standard roof racks and “safari cages,” each of which partially obscured the Discontinued Four-Door Design, as shown below:



36. Upon information and belief, Defendants sold approximately 500 Land Rover NAS 110 vehicles in the United States and all sales occurred between 1992 and 1993. Upon

further information and belief, when considered in the context of the entire automotive industry in which tens of millions of cars and light trucks were sold in the United States between 1992 and 1993, Defendants' sales constituted a *de minimis* percentage of total sales during the relevant time period.

37. Upon information and belief, given the very short time period of use in commerce of vehicles bearing the Discontinued Four-Door Design and the *de minimis* sales of vehicles bearing the Discontinued Four-Door Design, the Discontinued Four-Door Design never acquired distinctiveness or developed secondary meaning among consumers in the United States.

38. Upon information and belief, Defendants first began selling vehicles purportedly bearing the Discontinued Two-Door Design in the United States market when JLR Ltd. released a two-door 4x4 vehicle known as the 1994 Land Rover Defender NAS 90.

39. Upon information and belief, Defendants only released two more model years of the Land Rover Defender NAS 90 vehicle: 1995 and 1997.

40. Upon information and belief, Defendants sold fewer than 7,000 total units of the Land Rover Defender NAS 90 vehicle across all model years in the United States and all sales occurred between 1994 and, at the latest, 1999. Upon further information and belief, when considered in the context of the entire automotive industry in which tens of millions of cars and light trucks were sold in the United States between 1994 and 1999, Defendants' sales constituted a *de minimis* percentage of total sales during the relevant time period.

41. Upon information and belief, many of the Land Rover Defender NAS 90 vehicles sold in the United States bore designs different from the Discontinued Two-Door Design, including models that came standard without any roof (image below, left) or models that came with optional soft-top roofs of various types (one example in image below, right):



42. Upon information and belief, given the short time period of use in commerce of vehicles bearing the Discontinued Two-Door Design and the *de minimis* sales of vehicles bearing the Discontinued Two-Door Design, the Discontinued Two-Door Design never acquired distinctiveness or developed secondary meaning among consumers in the United States

43. Upon information and belief, after the release of the 1997 Land Rover Defender NAS 90 vehicle, JLR Ltd. permanently ceased manufacturing vehicles bearing the Discontinued Designs for the United States market because JLR Ltd. did not wish to comply with safety regulations set forth in the United States Intermodal Surface Transportation Efficiency Act of 1991—specifically, the requirement that passenger cars and light trucks built after September 1, 1998, come equipped with airbags for the driver and the right front passenger.

44. Upon information and belief, JLR Ltd. decided not to absorb the cost associated with installing such airbags due to the low sales volumes of the Land Rover Defender NAS 90 in the United States.

45. Upon information and belief, Defendants' last sale in the United States of any new vehicle bearing either of the Discontinued Designs manufactured for the United States market occurred no later than 1999.

46. Upon information and belief, Defendants did not thereafter release any vehicle under the Defender name for the United States market until 2020, when Defendants commenced

sale of a completely redesigned Land Rover Defender that bears little, if any, resemblance to the Discontinued Designs, as shown below:



47. Upon information and belief, Defendants continued to manufacture 4x4 Land Rover Defender vehicles bearing the Discontinued Designs for sale outside the United States (“Other-Market Defenders”) until the designs were permanently discontinued in January 2016. However, under the National Traffic and Motor Vehicle Safety Act, 49 U.S.C. § 30112(a), it is illegal to import into the United States any such Other-Market Defenders that were manufactured less than 25 years ago, with the limited exception of certain Land Rover Defender 90 4x4s manufactured prior to September 1, 1997.

**C. Defendants’ Global Campaign to Interfere with the INEOS GRENADIER**

48. Upon information and belief, shortly after learning of INEOS’s desire to build a 4x4 that would fill the void left by Defendants’ decision to cease production of Other-Market Defenders bearing the Discontinued Designs, Defendants began arming themselves for battle against Plaintiff around the world by embarking on a global campaign to obtain trademark registrations for three-dimensional configurations of the Discontinued Designs.

49. In many foreign jurisdictions, Plaintiff and INEOS have challenged Defendants’ attempt to obtain registrations for the Discontinued Designs (proceedings are ongoing in Spain, Italy, Qatar, Botswana, South Africa, Kenya, Vietnam, and India) and obtained favorable

decisions refusing registration therefor based on lack of distinctiveness (including final decisions in the United Kingdom and European Union).

50. For example, in the United Kingdom—the location of JLR Ltd.’s worldwide headquarters and the birthplace and manufacturing home of the Land Rover Defender—the UK Intellectual Property Office (“UK IPO”) rendered a decision refusing registration of the Discontinued Designs on grounds that the designs were not inherently distinctive and lacked acquired distinctiveness. Notably, the UK IPO found a lack of distinctiveness despite JLR Ltd. having sold vehicles bearing the Discontinued Designs for three decades longer in the United Kingdom than in the United States and having sold more than twenty times as many units in a far smaller market for passenger automobile sales. The UK IPO’s decision was affirmed by the United Kingdom’s High Court of Justice (the “High Court”). Leave to appeal the High Court’s decision by JLR Ltd. was denied by the UK Court of Appeal on December 8, 2020, which means the High Court’s decision is final and non-appealable. True and correct copies of the High Court’s and UK Court of Appeal’s respective decisions are attached as **Exhibit D** and **Exhibit E**.

51. In the United States, on December 20, 2016, JLR Ltd. filed U.S. Application Serial No. 87274875 to register the Discontinued Two-Door Design in International Class 12 for use in connection with “Motor land vehicles and structural parts therefor.” Even though the application was filed in JLR Ltd.’s name, it was signed by JLR NA’s General Counsel, who identified herself as an “Authorized Representative” of JLR Ltd. Despite the fact that Defendants had ceased manufacturing vehicles bearing the Discontinued Two-Door Design for the United States market *nearly two decades before* the application filing date, JLR Ltd. filed the application for the Discontinued Two-Door Design based on an assertion of purported *current use in commerce* under Section 1(a) of the Lanham Act, 15 U.S.C. § 1051(a).

52. In its USPTO application to register the Discontinued Two-Door Design, JLR Ltd. represented that “the mark was . . . first used in commerce at least as early as 08/07/1992, and is now in use in such commerce.” Upon information and belief, these statements were false, since Land Rover Defenders bearing the Discontinued Two-Door Design were not sold in the United States until the 1994 model year and because Defendants ceased using the Discontinued Two-Door Design in commerce long before the filing date of the application.

53. Contemporaneously with its filing of the application for the Discontinued Two-Door Design, JLR Ltd. submitted a declaration that states, *inter alia* “the applicant is using the mark in commerce on or in connection with the goods/services in the application . . . [and] [t]he signatory being warned that . . . willful false statements and the like may jeopardize the validity of the application or any registration resulting therefrom, declares that all statements made of his/her own knowledge are true and all statements made on information and belief are believed to be true.”

54. On September 6, 2017, in response to an office action issued by the USPTO initially refusing registration to the application for the Discontinued Two-Door Design for—among other things—lack of acquired distinctiveness, JLR Ltd. submitted the declaration of Gianfranco G. Mitrione, Esq., who is the Corporate Counsel of JLR NA. In support of JLR Ltd.’s argument that the Discontinued Two-Door Design is registrable because it had acquired distinctiveness, the declaration falsely stated that “[the Discontinued Two-Door Design] is used in conjunction with motor land vehicles” and—in an attempt to obfuscate— included copious amounts of irrelevant information including, for example, information concerning sales and consumer recognition of Other-Market Defenders outside the United States and the appearance



of significantly modified versions of Land Rover Defenders in movies in a manner that did not indicate that the shape of the vehicle was being used as a trade dress.

55. On May 1, 2018, in reliance on Defendants' material misrepresentations concerning the purported current use in commerce of the Discontinued Two-Door Design, the USPTO issued U.S. Registration No. 5456370 (the "Two-Door Registration") for the Discontinued Two-Door Design, as shown below:



56. On December 20, 2017, exactly a year after JLR Ltd. filed the application for the Discontinued Two-Door Design, JLR Ltd. filed U.S. Application Serial No. 87727806 to register the Discontinued Four-Door Design in International Class 12 for use in connection with "Motor land vehicles and structural parts therefor." Again, even though the application was filed in JLR Ltd.'s name, it was signed by JLR NA's General Counsel, who identified herself as an "Authorized Representative" of JLR Ltd. Despite the fact that Defendants had not manufactured any vehicle bearing the Discontinued Four-Door Design for the United States market for *more than twenty years* before the application filing date, JLR Ltd. based its application for the Discontinued Four-Door Trade Dress on an assertion of purported *current use in commerce* under Section 1(a) of the Lanham Act, 15 U.S.C. § 1051(a).

57. In its USPTO application to register the Discontinued Four-Door Design, JLR Ltd. represented that "the mark was . . . first used in commerce at least as early as 08/01/1992, and is now in use in such commerce." Contemporaneously with its filing of the application, JLR

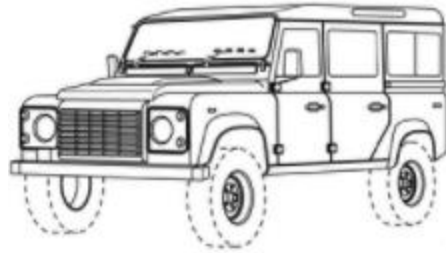


Ltd. submitted a declaration that states, *inter alia*, “the mark is in use in commerce on or in connection with the goods/services in the application . . . the facts recited in the application are accurate . . . [and] [t]he signatory being warned that . . . willful false statements and the like may jeopardize the validity of the application or submission or any registration resulting therefrom, declares that all statements made of his/her own knowledge are true and all statements made on information and belief are believed to be true.”

58. On September 10, 2018, in response to an office action issued by the USPTO initially refusing registration to the application for the Discontinued Four-Door Design for—among other things—lack of acquired distinctiveness, JLR Ltd. again submitted the declaration of JLR NA’s Corporate Counsel, Gianfranco G. Mitrione, Esq. In support of JLR Ltd.’s argument that the Discontinued Four-Door Design is registrable because it had acquired distinctiveness, the declaration falsely stated that “[the Discontinued Four-Door Design] is used in conjunction with motor land vehicles”; misrepresented that JLR Ltd. “sold 6,000 DEFENDER vehicles in the United States between 1994 and 1999” when, in fact, only 500 units of the Land Rover Defender NAS 110 were sold between 1992 and 1993; and—in a further attempt to obfuscate—included copious amounts of irrelevant information, including for example, information pertaining to use of Other-Market Defenders outside the United States and the sometimes fleeting appearance of the Discontinued Four-Door Design or modified versions of other Defender vehicles in movies in a manner that did not indicate that the shape of the vehicle was being used as a trademark.

59. On July 16, 2019, in reliance on Defendants’ material misrepresentations concerning the purported current use in commerce of the Discontinued Four-Door Design, the USPTO issued U.S. Registration No. 5803089 (the “Four-Door Registration,” and together with

the Two-Door Registration, the “JLR Registrations”) for the Discontinued Four-Door Design, as shown below:



60. Despite being issued registrations by the USPTO, many elements comprising the Discontinued Designs serve utilitarian functions that, at the time of creation, either reduced costs of manufacturing or improved user experience. Among these functional elements are: (a) the square, box-like outline comprised of flat body panels and right angles; (b) modular, riveted/bolted styling; (c) the curved profiling limited to wing curvature from bonnet to front panel; (d) the completely flat, square section rear profile, with specific window configuration; (e) the horizontal “waist” line running from hood height around full body; (f) the raised, narrow profile of front windscreen; (g) the clam shell hood; and (h) the offset, rear mounted wheel. None of the foregoing elements—each of which Defendants cite as an example of distinctive features of the Discontinued Designs in their declarations submitted to the USPTO—is arbitrary, incidental, or ornamental.

61. After obtaining the JLR Registrations from the USPTO for the Discontinued Designs, Defendants recorded the JLR Registrations with U.S. Customs and Border Protection. The Discontinued Two-Door Design was given Recordation Number TMK 19-00630 (effective starting June 7, 2019) and the Discontinued Four-Door Design was given Recordation Number TMK 19-00972 (effective starting September 9, 2019). True and correct copies of the recordations are attached hereto as **Exhibit F**.

62. Upon information and belief, Defendants' purpose in recording the JLR Registrations with U.S. Customs and Border Protection is to interfere with Plaintiff's importation of the INEOS GRENADIER into the United States.

**D. JLR NA Is Controlled By, and Is Merely an Alter Ego or Agent of, JLR Ltd.**

63. JLR NA functions merely as an alter ego or agent of JLR Ltd.

64. As a wholly-owned subsidiary, one hundred percent of JLR NA's outstanding stock is owned by JLR Ltd. Upon information and belief, the sole function of JLR NA is to conduct JLR Ltd.'s business in the United States.

65. JLR Ltd. serves the American market through JLR NA. Upon information and belief, JLR NA is not operating its own separate business out of Mahwah, New Jersey, but instead acts as an "arm" of its parent company JLR Ltd. In fact, in a press release dated September 21, 2016, JLR NA is identified as the "Mahwah-based *arm* of British premium automaker Jaguar Land Rover Limited." (Emphasis added.) The press release explains that JLR NA merely "manages [JLR Ltd.'s] business in the United States and Canada, providing support for 377 Jaguar and Land Rover retailers." A true and correct copy of Defendants' press release containing the aforementioned admissions is attached hereto as **Exhibit G**.

66. Upon information and belief, JLR NA is JLR Ltd.'s sole customer for new Land Rover and Jaguar vehicles in the United States and represents one hundred percent of JLR Ltd.'s U.S. sales. There are no new JLR Ltd.-made cars on American roads except those that are here by virtue of JLR Ltd.'s relationship with JLR NA.

67. Upon information and belief, JLR Ltd. considers JLR NA employees to be employees of JLR Ltd. For example, numerous JLR Ltd. press releases assert that JLR Ltd. has hundreds of employees in the United States, which, upon information and belief, were references to persons actually employed by JLR NA.

68. And regardless of a U.S. employee's nominal employer, upon information and belief, JLR Ltd. exerts substantial control over personnel and personnel decisions of JLR NA.

69. For example, upon information and belief, JLR Ltd. has the power to appoint and remove the Mahwah-based President and Chief Executive Officer of JLR NA. Upon further information and belief, the Mahwah-based President and Chief Executive Officer of JLR NA reports directly to JLR Ltd.'s Group Sales Operations Director in the United Kingdom. *See, e.g.,* <https://media.jaguarlandrover.com/en-us/person/joe-eberhardt> (last accessed Oct. 13, 2021).

70. Also upon information and belief, other officers and employees of JLR NA directly report to officers and supervisors of JLR Ltd. in the United Kingdom instead of or in addition to officers or supervisors of JLR NA.

71. Upon information and belief, the United States is an important market for JLR Ltd., representing a disproportionately large percentage of global sales, particularly for Land Rover vehicles. Upon further information and belief, JLR Ltd. and JLR NA closely collaborate in order to serve and exploit the U.S. market,

72. Upon information and belief, JLR Ltd. also exerts substantial control over the day-to-day activities of JLR NA. For example, with regard to U.S. marketing, upon information and belief, the Jaguar and Land Rover sales and marketing strategy for the U.S. market is designed not by JLR NA, but by JLR Ltd., which directs Mahwah-based JLR NA to implement such strategies on its behalf.

73. JLR Ltd., not JLR NA, owns the jaguarusa.com and landroverusa.com domain names. Upon information and belief, JLR Ltd., instead of JLR NA, also owns the Jaguar and Land Rover social media accounts for the U.S. market, including without limitation the Land Rover USA Facebook, Instagram, Twitter, and YouTube accounts, and either operates such

websites and social media accounts or directs JLR NA personnel to operate such websites and social media accounts on JLR Ltd.'s behalf.

74. Upon information and belief, JLR Ltd. regularly disregards corporate formalities. For example, despite the fact that JLR Ltd. submitted applications to the USPTO to register the Discontinued Designs, the applications were signed by JLR NA's General Counsel and the only declarations submitted in connection with JLR Ltd.'s responses to USPTO Office Actions were executed by Gianfranco G. Mitrione, Esq., Corporate Counsel of JLR NA. Moreover, although he serves as Corporate Counsel of *JLR NA*, Mitrione declared that “[a]s a result of my considerable experience working as part of Applicant’s [i.e., *JLR Ltd.*’s] legal team, I am intimately familiar with [JLR Ltd.’s] operations.”

**E. New Jersey Is the Locus of JLR Ltd.’s Enforcement Activities in the U.S.**

75. New Jersey is the locus of JLR Ltd.’s enforcement activities in the United States because Mahwah-based JLR NA is charged with enforcement of, and does in fact enforce, JLR Ltd.’s intellectual property rights, including its trademark rights, in the United States.

76. For example, upon information and belief, JLR NA issues cease-and-desist letters to third parties alleging infringement of JLR Ltd.’s U.S. trademark rights. As another example, JLR NA has joined JLR Ltd. as co-complainant in a patent-based U.S. International Trade Commission (“ITC”) proceeding, where Defendants jointly claimed a domestic industry which, upon information and belief, is solely based on JLR NA’s operations here. Further, JLR NA also supports JLR Ltd.’s intellectual property litigation efforts in the U.S., such as when JLR NA employees submitted declarations and testified on behalf of JLR Ltd. in a recent trademark litigation over the DEFENDER trademark, *Jaguar Land Rover Limited v. Bombardier Recreational Prods.*, No. 2:16-cv-13386 (E.D. Mich. filed Sept. 19, 2016).

**F. Defendants Threaten and then Commence Litigation Against Plaintiff**

77. Shortly after INEOS first announced plans to develop the INEOS GRENADIER in 2016, JLR Ltd. contacted INEOS and threatened to file suit “in any relevant jurisdiction” based on its purported rights in the Discontinued Designs. A true and correct copy of JLR Ltd.’s letter correspondence is attached hereto as **Exhibit H**.

78. JLR has already followed through on its 2016 threat in at least two jurisdictions. Earlier this year, JLR Ltd. filed suit against Plaintiff in Spain and Italy, alleging claims for trademark infringement and unfair competition and seeking preliminary injunctions against Plaintiff’s distribution, marketing and sale of the INEOS GRENADIER. These proceedings are directly related to the threat that JLR Ltd. issued in 2016. In the Spanish proceeding, for example, JLR Ltd. quoted the entirety of the 2016 letter to the Court and asserted that the letter was intended to preserve JLR Ltd.’s rights in Spain and prevent INEOS from doing exactly what it did, that is, developing the INEOS GRENADIER.

79. There also should be no doubt that Defendants’ threat in the United States is both real and imminent. The activities that Plaintiff has undertaken here—taking the INEOS GRENADIER prototype on a multi-state tour of the U.S., permitting consumers to both register an interest in the INEOS GRENADIER and pay a deposit against a future order, issuing a public marketing plan, etc.—are at least as commercially significant as the activities that JLR Ltd. recently relied upon in Spain to urge the Court to take urgent action.

80. As a result of Defendants’ actions—threatening to sue Plaintiff “in any relevant jurisdiction,” obtaining U.S. registrations for the Discontinued Designs, recording those registrations with U.S. Customs, and suing Plaintiff in foreign courts—Plaintiff has been put in the untenable position of not knowing if, when, where, or how Defendants may sue Plaintiff, take action against Plaintiff, or otherwise interfere with Plaintiff’s importation, marketing,

distribution, and sale of the INEOS GRENADIER in the United States. The threat of litigation by Defendants casts a cloud over Plaintiff's business and future operations in the United States, hanging over Plaintiff as a Sword of Damocles.

81. To resolve this situation, Plaintiff now brings this action for a declaratory judgment that (i) Defendants' purported trade dress rights in the Discontinued Designs are invalid and unenforceable; (ii) the marketing, importation, distribution, and sale of the INEOS GRENADIER does not infringe any purported rights Defendants may have in the Discontinued Designs; and (iii) the marketing, importation, distribution, and sale of the INEOS GRENADIER is not likely to cause confusion and does not constitute unfair competition with the Discontinued Designs.

**FIRST CAUSE OF ACTION**  
**Declaratory Judgment for Non-Infringement of**  
**Discontinued Two-Door Design**  
**(Trade Dress Invalidity for Lack of Acquired Distinctiveness)**

82. Plaintiff repeats the allegations contained in Paragraphs 1 through 81 above as if fully set forth herein.

83. Defendants have contended that Plaintiff's distribution and sale of the INEOS GRENADIER is likely to cause confusion with the Discontinued Two-Door Design. As a result of Defendants' actions and demands described herein, there is a substantial controversy between the parties—who have adverse legal interests—of sufficient immediacy and reality to warrant the issuance of a declaratory judgment.

84. The Discontinued Two-Door Design consists of a product design for automotive vehicles that, under United States Supreme Court precedent, cannot be considered inherently distinctive as a matter of law and is not valid without proof of acquired distinctiveness or secondary meaning.

85. Upon information and belief, the Discontinued Two-Door Design is not well-known to American consumers as it was offered in the United States for only a few years and achieved only *de minimis* sales during that time. As such, the Discontinued Two-Door Design has not acquired distinctiveness and does not possess secondary meaning among United States consumers.

86. Defendants cannot prove a cause of action against Plaintiff for infringement of rights in the Discontinued Two-Door Design—whether based on the Two-Door Registration or common law rights—because Defendants lack valid and subsisting trade dress rights in the Discontinued Two-Door Design due to an absence of acquired distinctiveness or secondary meaning.

87. Accordingly, Plaintiff is entitled to a declaratory judgment that the INEOS GRENADIER does not infringe any rights of Defendants in the Discontinued Two-Door Design, including any rights under Sections 32(1) or 43(a) of the Lanham Act, 15 U.S.C. §§ 1114(1) and 1125(a), any rights under state infringement or unfair competition laws, or any rights under common law.

**SECOND CAUSE OF ACTION**  
**Declaratory Judgment for Non-Infringement**  
**of Discontinued Four-Door Design**  
**(Trade Dress Invalidity for Lack of Acquired Distinctiveness)**

88. Plaintiff repeats the allegations contained in Paragraphs 1 through 87 above as if fully set forth herein.

89. Defendants have contended that Plaintiff's distribution and sale of the INEOS GRENADIER is likely to cause confusion with the Discontinued Four-Door Design. As a result of Defendants' actions and demands described herein, there is a substantial controversy between



the parties—who have adverse legal interests—of sufficient immediacy and reality to warrant the issuance of a declaratory judgment.

90. The Discontinued Four-Door Design consists of a product design for automotive vehicles that, under United States Supreme Court precedent, cannot be considered inherently distinctive as a matter of law and is not valid without proof of acquired distinctiveness or secondary meaning.

91. Upon information and belief, the Discontinued Four-Door Design is not well-known to American consumers as it was offered in the United States for only a few years and achieved only *de minimis* sales during that time. As such, the Discontinued Four-Door Design has not acquired distinctiveness and does not possess secondary meaning among United States consumers.

92. Defendants cannot prove a cause of action against Plaintiff for infringement of rights in the Discontinued Four-Door Design—whether based on the Four-Door Registration or common law rights—because Defendants lack valid and subsisting trade dress rights in the Discontinued Four-Door Design due to an absence of acquired distinctiveness or secondary meaning.

93. Accordingly, Plaintiff is entitled to a declaratory judgment that the INEOS GRENADIER does not infringe any rights of Defendants in the Discontinued Four-Door Design, including any rights under Sections 32(1) or 43(a) of the Lanham Act, 15 U.S.C. §§ 1114(1) and 1125(a), any rights under state infringement or unfair competition laws, or any rights under common law.

**THIRD CAUSE OF ACTION**  
**Declaratory Judgment for Non-Infringement  
of Discontinued Two-Door Design  
(Trade Dress Invalidity Based on Functionality)**

94. Plaintiff repeats the allegations contained in Paragraphs 1 through 93 above as if fully set forth herein.

95. Defendants have contended that Plaintiff's distribution and sale of the INEOS GRENADIER is likely to cause confusion with the Discontinued Two-Door Design. As a result of Defendants' actions and demands described herein, there is a substantial controversy between the parties—who have adverse legal interests—of sufficient immediacy and reality to warrant the issuance of a declaratory judgment.

96. The Discontinued Two-Door Design is functional in that it is useful to the purpose of Defendants' goods as all-purpose, off-road, utility vehicles or in that it affects the cost or quality of the Defendants' goods.

97. Because the Discontinued Two-Door Design serves a utilitarian and functional purpose for automotive vehicles, it cannot be appropriated exclusively by Defendants or serve as a source indicator of Defendants.

98. Plaintiff and others in the automotive industry would suffer a significant, non-reputational disadvantage if Defendants were granted a monopoly over use of the Discontinued Two-Door Design.

99. Defendants cannot prove a cause of action against Plaintiff for infringement of rights in the Discontinued Two-Door Design—whether based on the Two-Door Registration or common law rights—because Defendants cannot prove ownership of valid and subsisting trade dress rights in the Discontinued Two-Door Design due to the design being functional under Section 2(e)(5) of the Lanham Act, 15 U.S.C. § 1052(e)(5).

100. Accordingly, Plaintiff is entitled to a declaratory judgment that the INEOS GRENADIER does not infringe any rights of Defendants in the Discontinued Two-Door Design, including any rights under Sections 32(1) or 43(a) of the Lanham Act, 15 U.S.C. §§ 1114(1) and 1125(a), any rights under state infringement or unfair competition laws, or any rights under common law.

**FOURTH CAUSE OF ACTION**  
**Declaratory Judgment for Non-Infringement**  
**of Discontinued Four-Door Design**  
**(Trade Dress Invalidity Based on Functionality)**

101. Plaintiff repeats the allegations contained in Paragraphs 1 through 100 above as if fully set forth herein.

102. Defendants have contended that Plaintiff's distribution and sale of the INEOS GRENADIER is likely to cause confusion with the Discontinued Four-Door Design. As a result of Defendants' actions and demands described herein, there is a substantial controversy between the parties—who have adverse legal interests—of sufficient immediacy and reality to warrant the issuance of a declaratory judgment.

103. The Discontinued Four-Door Design is functional in that it is useful to the purpose of Defendants' goods as all-purpose, off-road, utility vehicles or in that it affects the cost or quality of the Defendants' goods.

104. Because the Discontinued Four-Door Design serves a utilitarian and functional purpose for automotive vehicles, it cannot be appropriated exclusively by Defendants or serve as a source indicator of Defendants.

105. Plaintiff and others in the automotive industry would suffer a significant, non-reputational disadvantage if Defendants were granted a monopoly over use of the Discontinued Four-Door Design.

106. Defendants cannot prove a cause of action against Plaintiff for infringement of rights in the Discontinued Four-Door Design—whether based on the Four-Door Registration or common law rights—because Defendants cannot prove ownership of valid and subsisting trade dress rights in the Discontinued Four-Door Design due to the design being functional under Section 2(e)(5) of the Lanham Act, 15 U.S.C. § 1052(e)(5).

107. Accordingly, Plaintiff is entitled to a declaratory judgment that the INEOS GRENADIER does not infringe any rights of Defendants in the Discontinued Four-Door Design, including any rights under Sections 32(1) or 43(a) of the Lanham Act, 15 U.S.C. §§ 1114(1) and 1125(a), any rights under state infringement or unfair competition laws, or any rights under common law.

**FIFTH CAUSE OF ACTION**  
**Declaratory Judgment for Non-Infringement of Discontinued Two-Door Design**  
**(Trade Dress Invalidity Based on Abandonment)**

108. Plaintiff repeats the allegations contained in Paragraphs 1 through 107 above as if fully set forth herein.

109. Defendants have contended that Plaintiff's distribution and sale of the INEOS GRENADIER is likely to cause confusion with the Discontinued Two-Door Design. As a result of Defendants' actions and demands described herein, there is a substantial controversy between the parties—who have adverse legal interests—of sufficient immediacy and reality to warrant the issuance of a declaratory judgment.

110. Upon information and belief, Defendants ceased use in commerce of the Discontinued Two-Door Design no later than 1999.

111. Upon information and belief, Defendants are not using, have no plans to use, and have otherwise discontinued all use of the Discontinued Two-Door Design in commerce in the

United States in connection with motor land vehicles or parts therefor. Upon further information and belief, Defendants have no intent to resume use of the Discontinued Two-Door Design in the foreseeable future as evidenced by Defendants' relaunch of the Land Rover Defender in the form of a completely re-designed vehicle.

112. Defendants cannot prove a cause of action against Plaintiff for infringement of rights in the Discontinued Two-Door Design—whether based on the Two-Door Registration or common law rights—because Defendants cannot prove ownership of valid and subsisting trade dress rights in the Discontinued Two-Door Design due to the design being abandoned under Section 45 of the Lanham Act, 15 U.S. Code § 1127.

113. Accordingly, Plaintiff is entitled to a declaratory judgment that the INEOS GRENADIER does not infringe any rights of Defendants in the Discontinued Two-Door Design, including any rights under Sections 32(1) or 43(a) of the Lanham Act, 15 U.S.C. §§ 1114(1) and 1125(a), any rights under state infringement or unfair competition laws, or any rights under common law.

**SIXTH CAUSE OF ACTION**  
**Declaratory Judgment for Non-Infringement**  
**of Discontinued Four-Door Design**  
**(Trade Dress Invalidity Based on Abandonment)**

114. Plaintiff repeats the allegations contained in Paragraphs 1 through 113 above as if fully set forth herein.

115. Defendants have contended that Plaintiff's distribution and sale of the INEOS GRENADIER is likely to cause confusion with the Discontinued Four-Door Design. As a result of Defendants' actions and demands described herein, there is a substantial controversy between the parties—who have adverse legal interests—of sufficient immediacy and reality to warrant the issuance of a declaratory judgment.

116. Upon information and belief, Defendants ceased use in commerce of the Discontinued Four-Door Design no later than 1993.

117. Upon information and belief, Defendants are not using, have no plans to use, and have otherwise discontinued all use of the Discontinued Four-Door Design in commerce in the United States in connection with motor land vehicles or parts therefor. Upon further information and belief, Defendants have no intent to resume use of the Discontinued Four-Door Design in the foreseeable future as evidenced by Defendants' relaunch of the Land Rover Defender in the form of a completely re-designed vehicle.

118. Defendants cannot prove a cause of action against Plaintiff for infringement of rights in the Discontinued Four-Door Design—whether based on the Four-Door Registration or common law rights—because Defendants cannot prove ownership of valid and subsisting trade dress rights in the Discontinued Four-Door Design due to the design being abandoned under Section 45 of the Lanham Act, 15 U.S. Code § 1127.

119. Accordingly, Plaintiff is entitled to a declaratory judgment that the INEOS GRENADIER does not infringe any rights of Defendants in the Discontinued Four-Door Design, including any rights under Sections 32(1) or 43(a) of the Lanham Act, 15 U.S.C. §§ 1114(1) and 1125(a), any rights under state infringement or unfair competition laws, or any rights under common law.

**SEVENTH CAUSE OF ACTION**  
**Declaratory Judgment for Non-Infringement**  
**of Discontinued Two-Door Design**  
**(Trade Dress Invalidity Based on Nonuse)**

120. Plaintiff repeats the allegations contained in Paragraphs 1 through 119 above as if fully set forth herein.

121. Defendants have contended that Plaintiff's distribution and sale of the INEOS GRENADIER is likely to cause confusion with the Discontinued Two-Door Design. As a result of Defendants' actions and demands described herein, there is a substantial controversy between the parties—who have adverse legal interests—of sufficient immediacy and reality to warrant the issuance of a declaratory judgment.

122. Upon information and belief, Defendants were not using the Discontinued Two-Door Design in United States commerce in connection with the goods identified in the Two-Door Registration at the time JLR Ltd. filed the application therefor or at any time during the prosecution of the application therefor.

123. Because the Discontinued Two-Door Design was not in use in United States commerce in connection with the goods identified in the Two-Door Registration on or before the filing date of the use-based application therefor, the Two-Door Registration is void *ab initio* under Section 1(a) of the Lanham Act, 15 U.S.C. § 1051(a).

124. Defendants cannot prove a cause of action against Plaintiff for infringement of rights in the Discontinued Two-Door Design based on the Two-Door Registration because Defendants cannot prove ownership of valid and subsisting trade dress rights in the Discontinued Two-Door Design due to the Two-Door Registration being void *ab initio* for nonuse under Section 1(a) of the Lanham Act, 15 U.S.C. § 1051(a).

125. Accordingly, Plaintiff is entitled to a declaratory judgment that the INEOS GRENADIER does not infringe any rights of Defendants in the Discontinued Two-Door Design, including any rights under Section 32(1) of the Lanham Act, 15 U.S.C. § 1114(1).

**EIGHTH CAUSE OF ACTION**  
**Declaratory Judgment for Non-Infringement**  
**of Discontinued Four-Door Design**  
**(Trade Dress Invalidity Based on Nonuse)**

126. Plaintiff repeats the allegations contained in Paragraphs 1 through 125 above as if fully set forth herein.

127. Defendants have contended that Plaintiff's distribution and sale of the INEOS GRENADIER is likely to cause confusion with the Discontinued Four-Door Design. As a result of Defendants' actions and demands described herein, there is a substantial controversy between the parties—who have adverse legal interests—of sufficient immediacy and reality to warrant the issuance of a declaratory judgment.

128. Upon information and belief, Defendants were not using the Discontinued Four-Door Design in United States commerce in connection with the goods identified in the Four-Door Registration at the time JLR Ltd. filed the application therefor or at any time during the prosecution of the application therefor.

129. Because the Discontinued Four-Door Design was not in use in United States commerce in connection with the goods identified in the Four-Door Registration on or before the filing date of the use-based application therefor, the Four-Door Registration is void *ab initio* under Section 1(a) of the Lanham Act, 15 U.S.C. § 1051(a).

130. Defendants cannot prove a cause of action against Plaintiff for infringement of rights in the Discontinued Four-Door Design based on the Four-Door Registration because Defendants cannot prove ownership of valid and subsisting trade dress rights in the Discontinued Four-Door Design due to the Four-Door Registration being void *ab initio* for nonuse under Section 1(a) of the Lanham Act, 15 U.S.C. § 1051(a).



131. Accordingly, Plaintiff is entitled to a declaratory judgment that the INEOS GRENADIER does not infringe any rights of Defendants in the Discontinued Four-Door Design, including any rights under Section 32(1) of the Lanham Act, 15 U.S.C. § 1114(1).

**NINTH CAUSE OF ACTION**  
**Declaratory Judgment for Non-Infringement**  
**of Discontinued Two-Door Design**  
**(Trade Dress Invalidity Due to Fraud on the USPTO)**

132. Plaintiff repeats the allegations contained in Paragraphs 1 through 131 above as if fully set forth herein.

133. Defendants have contended that Plaintiff's distribution and sale of the INEOS GRENADIER is likely to cause confusion with the Discontinued Two-Door Design. As a result of Defendants' actions and demands described herein, there is a substantial controversy between the parties—who have adverse legal interests—of sufficient immediacy and reality to warrant the issuance of a declaratory judgment.

134. Upon information and belief, Defendants were not using the Discontinued Two-Door Design in United States commerce in connection with any motor vehicles or parts therefor at the time JLR Ltd. filed an application to register the purported mark for such goods.

135. Upon information and belief, Defendants knew at the time JLR Ltd. filed the application and submitted the aforementioned declaration that they were not using the Discontinued Two-Door Design in commerce and that the declaration submitted in support of the application was false.

136. Upon information and belief, Defendants intended to deceive the USPTO by falsely asserting that they were using the Discontinued Two-Door Design in commerce as of the filing date of the application. Upon further information and belief, Defendants intended to deceive the USPTO by burying their *de minimis* use of the Discontinued Two-Door Design

among copious amounts of irrelevant and even incorrect information to mislead the USPTO into believing that the Discontinued Two-Door Design had acquired distinctiveness or developed secondary meaning. Upon information and belief, JLR Ltd.'s false and misleading statements were made for the purpose of obtaining a registration to which it was not entitled.

137. The USPTO would not have approved the application for registration but for the false and misleading statements made by Defendants in the application and supporting declaration for the Discontinued Two-Door Design. Thus, the falsehoods were material misstatements of fact.

138. As a result of Defendants' willful, misleading, and materially false statements made in connection with the application and supporting declaration for the Discontinued Two-Door Design, Defendants committed fraud against the USPTO.

139. Defendants cannot prove a cause of action against Plaintiff for infringement of rights in the Discontinued Two-Door Design based on the Two-Door Registration because Defendants cannot prove ownership of valid and subsisting trade dress rights in the Discontinued Two-Door Design due to the Two-Door Registration being void *ab initio* due to fraud committed against the USPTO.

140. Accordingly, Plaintiff is entitled to a declaratory judgment that the INEOS GRENADIER does not infringe any rights of Defendants in the Discontinued Two-Door Design, including any rights under Section 32(1) of the Lanham Act, 15 U.S.C. § 1114(1).

**TENTH CAUSE OF ACTION**  
**Declaratory Judgment for Non-Infringement**  
**of Discontinued Four-Door Design**  
**(Trade Dress Invalidity Due to Fraud on the USPTO)**

141. Plaintiff repeats the allegations contained in Paragraphs 1 through 140 above as if fully set forth herein.

142. Defendants have contended that Plaintiff's distribution and sale of the INEOS GRENADIER is likely to cause confusion with the Discontinued Four-Door Design. As a result of Defendants' actions and demands described herein, there is a substantial controversy between the parties—who have adverse legal interests—of sufficient immediacy and reality to warrant the issuance of a declaratory judgment.

143. Upon information and belief, Defendants were not using the Discontinued Four-Door Design in United States commerce in connection with any motor vehicles or parts therefor at the time JLR Ltd. filed an application to register the purported mark for such goods.

144. Upon information and belief, Defendants knew at the time JLR Ltd. filed the application and submitted the aforementioned declaration that they were not using the Discontinued Four-Door Design in commerce and that the declaration submitted in support of the application was false.

145. Upon information and belief, Defendants intended to deceive the USPTO by falsely asserting that they were using the Discontinued Four-Door Design in commerce as of the filing date of the application. Upon further information and belief, Defendants misrepresented that JLR Ltd. "sold 6,000 DEFENDER vehicles in the United States between 1994 and 1999" when, in fact, only 500 units of the Land Rover Defender NAS 110 were sold between 1992 and 1993. Upon further information and belief, Defendants intended to deceive the USPTO by burying their *de minimis* use of the Discontinued Four-Door Design among copious amounts of irrelevant and even incorrect information to mislead the USPTO into believing that the Discontinued Four-Door Design had acquired distinctiveness or developed secondary meaning. Upon information and belief, JLR Ltd.'s false and misleading statements were made for the purpose of obtaining a registration to which it was not entitled.

146. The USPTO would not have approved the application for registration but for the false and misleading statements made by Defendants in the application and supporting declaration for the Discontinued Four-Door Design. Thus, the falsehoods were material misstatements of fact.

147. As a result of Defendants' willful, misleading, and materially false statements made in connection with the application and supporting declaration for the Discontinued Four-Door Design, Defendants committed fraud against the USPTO.

148. Defendants cannot prove a cause of action against Plaintiff for infringement of rights in the Discontinued Four-Door Design based on the Four-Door Registration because Defendants cannot prove ownership of valid and subsisting trade dress rights in the Discontinued Four-Door Design due to the Four-Door Registration being void *ab initio* due to fraud committed against the USPTO.

149. Accordingly, Plaintiff is entitled to a declaratory judgment that the INEOS GRENADIER does not infringe any rights of Defendants in the Discontinued Four-Door Design, including any rights under Section 32(1) of the Lanham Act, 15 U.S.C. § 1114(1).

**ELEVENTH CAUSE OF ACTION**  
**Declaratory Judgment for Non-Infringement**  
**of Discontinued Two-Door Design**  
**(No Likelihood of Confusion)**

150. Plaintiff repeats the allegations contained in Paragraphs 1 through 149 above as if fully set forth herein.

151. Defendants have contended that Plaintiff's distribution and sale of the INEOS GRENADIER is likely to cause confusion with the Discontinued Two-Door Design. As a result of Defendants' actions and demands described herein, there is a substantial controversy between

the parties—who have adverse legal interests—of sufficient immediacy and reality to warrant the issuance of a declaratory judgment.

152. Even if Defendants could prove ownership of valid and subsisting rights in the Discontinued Two-Door Design, they cannot prevail on any infringement or unfair competition claims against Plaintiff under federal, state, or common law because there is no likelihood of confusion between the INEOS GRENADIER and the Discontinued Two-Door Design.

153. The differences between Plaintiff's INEOS GRENADIER and the Discontinued Two-Door Design prevent any likelihood of confusion, including because the INEOS GRENADIER and the Discontinued Two-Door Design are not similar in appearance, the distinctiveness of the Discontinued Two-Door Design (if any exists) is limited and entitles Defendants to a narrow scope of trade dress protection that is enforceable only against exact replicas, both parties use their respective house marks in conjunction with the vehicles at issue, and the purchasers of the parties' respective goods exercise a great deal of care in making purchasing decisions.

154. There are numerous third party 4x4 utility vehicles that have design features shared by both the INEOS GRENADIER and the Discontinued Two-Door Design such that consumers will not presume that all automotive vehicles offered in connection with these design features emanate from a common source.

155. Plaintiff's distribution and sale of the INEOS GRENADIER is not likely to cause confusion, mistake, or deception as to the source, origin, sponsorship, or approval of Plaintiff's goods and services.

156. Defendants cannot prove a cause of action against Plaintiff for infringement of rights in the Discontinued Two-Door Design—whether based on the Two-Door Registration or

common law rights—because Defendants cannot prove that there exists a likelihood of confusion between the INEOS GRENADIER and the Discontinued Two-Door Design.

157. Accordingly, Plaintiff is entitled to a declaratory judgment that the INEOS GRENADIER does not infringe any rights of Defendants in the Discontinued Two-Door Design, including any rights under Sections 32(1) or 43(a) of the Lanham Act, 15 U.S.C. §§ 1114(1) and 1125(a), any rights under state infringement or unfair competition laws, or any rights under common law.

**TWELFTH CAUSE OF ACTION**  
**Declaratory Judgment for Non-Infringement**  
**of Discontinued Four-Door Design**  
**(No Likelihood of Confusion)**

158. Plaintiff repeats the allegations contained in Paragraphs 1 through 157 above as if fully set forth herein.

159. Defendants have contended that Plaintiff's distribution and sale of the INEOS GRENADIER is likely to cause confusion with the Discontinued Four-Door Design. As a result of Defendants' actions and demands described herein, there is a substantial controversy between the parties—who have adverse legal interests—of sufficient immediacy and reality to warrant the issuance of a declaratory judgment.

160. Even if Defendants could prove ownership of valid and subsisting rights in the Discontinued Four-Door Design, they cannot prevail on any infringement or unfair competition claims against Plaintiff under federal, state, or common law because there is no likelihood of confusion between the INEOS GRENADIER and the Discontinued Four-Door Design.

161. The differences between Plaintiff's INEOS GRENADIER and the Discontinued Four-Door Design prevent any likelihood of confusion, including because the INEOS GRENADIER and the Discontinued Four-Door Design are not similar in appearance, the

distinctiveness of the Discontinued Four-Door Design (if any exists) is limited and entitles Defendants to a narrow scope of trade dress protection that is enforceable only against exact replicas, both parties use their respective house marks in conjunction with the vehicles at issue, and the purchasers of the parties' respective goods exercise a great deal of care in making purchasing decisions.

162. There are numerous third party 4x4 utility vehicles that have design features shared by both the INEOS GRENADIER and the Discontinued Four-Door Design such that consumers will not presume that all automotive vehicles offered in connection with these design features emanate from a common source.

163. Plaintiff's distribution and sale of the INEOS GRENADIER is not likely to cause confusion, mistake, or deception as to the source, origin, sponsorship, or approval of Plaintiff's goods and services.

164. Defendants cannot prove a cause of action against Plaintiff for infringement of rights in the Discontinued Four-Door Design—whether based on the Four-Door Registration or common law rights—because Defendants cannot prove that there exists a likelihood of confusion between the INEOS GRENADIER and the Discontinued Four-Door Design.

165. Accordingly, Plaintiff is entitled to a declaratory judgment that the INEOS GRENADIER does not infringe any rights of Defendants in the Discontinued Four-Door Design, including any rights under Sections 32(1) or 43(a) of the Lanham Act, 15 U.S.C. §§ 1114(1) and 1125(a), any rights under state infringement or unfair competition laws, or any rights under common law.

**THIRTEENTH CAUSE OF ACTION**  
**Declaratory Judgment for Cancellation of Two-Door Registration**  
**Under 15 U.S.C. § 1119**

166. Plaintiff repeats the allegations contained in Paragraphs 1 through 165 above as if fully set forth herein.

167. Defendants have contended that Plaintiff's distribution and sale of the INEOS GRENADIER is likely to cause confusion with the Discontinued Two-Door Design. As a result of Defendants' actions and demands described herein, there is a substantial controversy between the parties—who have adverse legal interests—of sufficient immediacy and reality to warrant the issuance of a declaratory judgment.

168. By reason of the foregoing, Plaintiff is likely to be harmed by the continued registration of the Two-Door Registration for the Discontinued Two-Door Design.

169. Accordingly, Plaintiff is entitled to an order cancelling the Two-Door Registration pursuant to 15 U.S.C. § 1119 because (1) the Discontinued Two-Door Design lacks acquired distinctiveness; (2) the Discontinued Two-Door Design is functional; (3) the Discontinued Two-Door Design has been abandoned; (4) the Two-Door Registration is void *ab initio* based on nonuse under Section 1(a); and/or (5) the Two-Door Registration is void *ab initio* due to Defendants perpetrating fraud against the USPTO in connection with the prosecution of the application therefor.

**FOURTEENTH CAUSE OF ACTION**  
**Declaratory Judgment for Cancellation of Four-Door Registration**  
**Under 15 U.S.C. § 1119**

170. Plaintiff repeats the allegations contained in Paragraphs 1 through 169 above as if fully set forth herein.



171. Defendants have contended that Plaintiff's distribution and sale of the INEOS GRENADIER is likely to cause confusion with the Discontinued Four-Door Design. As a result of Defendants' actions and demands described herein, there is a substantial controversy between the parties—who have adverse legal interests—of sufficient immediacy and reality to warrant the issuance of a declaratory judgment.

172. By reason of the foregoing, Plaintiff is likely to be harmed by the continued registration of the Four-Door Registration for the Discontinued Four-Door Design.

173. Accordingly, Plaintiff is entitled to an order cancelling the Four-Door Registration pursuant to 15 U.S.C. § 1119 because (1) the Discontinued Four-Door Design lacks acquired distinctiveness; (2) the Discontinued Four-Door Design is functional; (3) the Discontinued Four-Door Design has been abandoned; (4) the Four-Door Registration is void *ab initio* based on nonuse under Section 1(a); and/or (5) the Four-Door Registration is void *ab initio* due to Defendants perpetrating fraud against the USPTO in connection with the prosecution of the application therefor.

### **PRAYER FOR RELIEF**

**WHEREFORE**, Plaintiff requests that this Court issue a declaratory judgment against Defendants and in favor of Plaintiff on all causes of action asserted herein and enter an order:

(a) declaring that Plaintiff's marketing, importation, distribution and sale of the INEOS GRENADIER does not and will not infringe on any purported trade dress rights Defendants may have in the Discontinued Designs and that Plaintiff has the lawful right to import, distribute, and sell the INEOS GRENADIER as well as advertise and promote the same;

(b) declaring that Plaintiff's marketing, importation, distribution and sale of the INEOS GRENADIER (i) is not likely to create confusion among consumers as to the source or

sponsorship of Plaintiff's products and is not likely to cause consumers to mistakenly believe that Plaintiff's products are associated, sponsored, or are otherwise approved by Defendants, or that there is some relationship between the parties; and (ii) does not and will not constitute trademark infringement or unfair competition in violation of the Lanham Act or any applicable state law or common law;

(c) declaring that Defendants' purported trade dress rights in the Discontinued Designs are invalid and unenforceable due to (i) lack of acquired distinctiveness and/or secondary meaning, (ii) functionality, (iii) abandonment, (iv) non-use, and/or (v) fraud on the USPTO.

(d) instructing the Director of the USPTO to cancel U.S. Registration Nos. 5456370 and 5803089 in their entirety;

(e) permanently enjoining Defendants from asserting claims, filing actions, or making threats in the United States against Plaintiff arising out of Plaintiff's importation, distribution, and sale of the INEOS GRENADIER;

(f) awarding Plaintiff any and all damages sustained by it as a result of Defendants' threat of legal action against and interference with Plaintiff's business activities; and

(g) awarding Plaintiff its costs in this action, including attorneys' fees, together with such other and further relief as the Court may deem just and proper.

Dated: Newark, New Jersey  
October 18, 2021

ROBINSON MILLER LLC

By: s/ Keith J. Miller

Keith J. Miller

Ironside Newark

110 Edison Place, Suite 302

Newark, New Jersey 07102

Telephone: (973) 690-5400

Email: kmiller@rwmlegal.com

David Donahue (admitted *pro hac vice*)

Laura Popp-Rosenberg (admitted *pro hac vice*)

Daniel M. Nuzzaci (admitted *pro hac vice*)

FROSS ZELNICK LEHRMAN & ZISSU, P.C.

151 West 42nd Street, 17th Floor

New York, New York 10036

Telephone: (212) 813-5900

*Attorneys for Plaintiff INEOS Automotive Limited*

**LOCAL CIVIL RULE 11.2 CERTIFICATION**

Pursuant to Local Civil Rule 11.2, I hereby certify that the matter in controversy in this case is not the subject of any action pending in any court or of any pending arbitration or administrative proceeding.

Dated: October 18, 2021

/s/ Keith J. Miller

Keith J. Miller

**ROBINSON MILLER LLC**

Ironside Newark

110 Edison Place, Suite 302

Newark, New Jersey 07102

Telephone: (973) 690-5400

*Attorneys for Plaintiff INEOS Automotive Limited*