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UNITED STATES DISTRICT COURT  
SOUTHERN DISTRICT OF KENTUCKY  
NEW ALBANY DIVISION

FILED  
DISTRICT COURT  
NEW ALBANY DIVISION  
17 MAR 10 AM 9:34  
SOUTHERN DISTRICT  
OF KENTUCKY  
LAUREL, KENTUCKY

HUBER ORCHARDS, INC. )  
19816 Huber Road )  
Borden, Indiana, 47106 )  
v. )  
C. MONDAVI & FAMILY )  
2800 Main Street )  
St. Helena, California 94574 )  
Serve: Indiana Secretary of State )  
302 W. Washington Street )  
Room E018 )  
Indianapolis, IN 46204 )  
and )  
C. MONDAVI & SONS, INC. )  
2800 Main Street )  
St. Helena, California 94574 )  
Serve: Meredith Werne )  
5337 West 78<sup>th</sup> Street )  
Indianapolis, Indiana 46268 )

**4 : 17-cv- 0046 RLY -TAB**

Civil Action No.: \_\_\_\_\_

**COMPLAINT FOR DECLARATORY JUDGMENT**

Comes Plaintiff, Huber Orchards, Inc. ("Huber"), by and through undersigned counsel, and for is Complaint for Declaratory Judgment brought pursuant to Fed. R. Civ. P. 57 against C. Mondavi & Family ("CMF") and C. Mondavi & Sons, Inc. ("CMS"), states as follows.

**PARTIES**

1. Huber is an Indiana corporation having its principal place of business at 19816 Huber Road, Borden, Indiana 47106. Huber carries on various lines of business including, but

not limited to, maintaining a winery and producing and selling its line of wines regionally and online, and to a lesser extent nationally at select stores.

2. Defendant CMF is a California “domestic stock corporation” having its principal place of business at 2800 Main Street, St. Helena California. CMF produces and sells wine, including the products that are the subject controversy described herein, in retail stores and online, including in the Southern District of Indiana.

3. Defendant CMS is a California corporation registered in Indiana as a foreign for-profit corporation having the same principal address as CMF and having its registered agent in Indiana for service of process as Meredith Verne, 5337 W. 78<sup>th</sup> Street, Indianapolis, Indiana 46268.

#### **JURISDICTION AND VENUE**

4. This Court has jurisdiction over the instant action pursuant to 28 U.S.C. §§2201(a), 1331 and 1338 because it is an action for declaratory judgment regarding trademarks and enforceability pursuant to federal trademark law.

5. Jurisdiction and venue over the Defendants are proper as CMS is registered to do business in Indiana and, in fact, both Defendants conduct continuous and systematic business in the Southern District of Indiana. Further, the controversy herein involves alleged infringement of Defendant CMF’s trademark in the Southern District of Indiana where CMF’s threatened action against Huber would be properly brought. Jurisdiction and venue are therefore proper pursuant to Indiana Trial Rule 4.4 and 28 U.S.C. §1391.

#### **GENERAL ALLEGATIONS**

6. On or about February 22, 2017, CMF sent a cease and desist letter to Ted C. Huber, as president of Huber (“C&D Letter”). (A copy of the C&D letter is annexed hereto and incorporated herein by reference as Exhibit A.)

7. CMF's C&D Letter alleges that CMF is the owner of a federally registered trademark for GENERATIONS (U.S. Reg. No. 2,236,517) for Wine in International Class 33," which registration issued on April 6, 1999.

8. CMF's C&D Letter demands that Huber cease all use of the trademark GENERATIONS in connection with its Huber Winery Generation Indiana Red blend wines.

9. CMF's C&D Letter alleges that CMF has continuously used the GENERATIONS trademark on wines in commerce since 1996 for the sale of its "Charles Krug Peter Mondavi Family Napa Valley GENERATIONS" red blend wines.

10. According to the C&D Letter, the CMF wines at issue are sold for approximately \$60 per bottle, and the Huber wines in controversy sell at approximately \$16 per bottle.

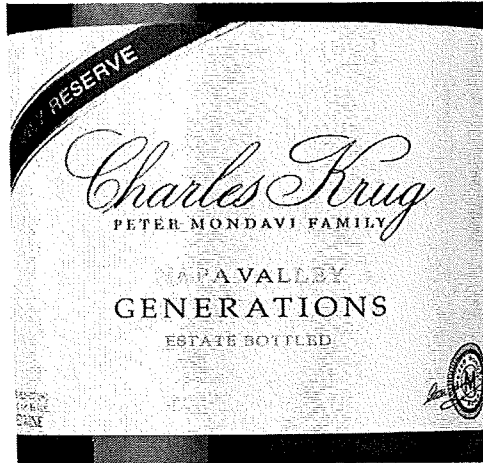
11. In its C&D Letter, CMF asserts that Huber is violating the Lanham Act by infringing and diluting CMF's trademark and is liable for injunctive relief, damages, possible treble damages and attorneys' fees. In its C&D Letter, CMF specifically references violations of 15 U.S.C §§1114 and 1125 (a) and (c).

12. In its C&D Letter, CMF demands that Huber "settle" by discontinuing all use of the trademark "Generations," and confirm such action no later than Thursday March 9, 2017; the obvious implication being do so or be sued.

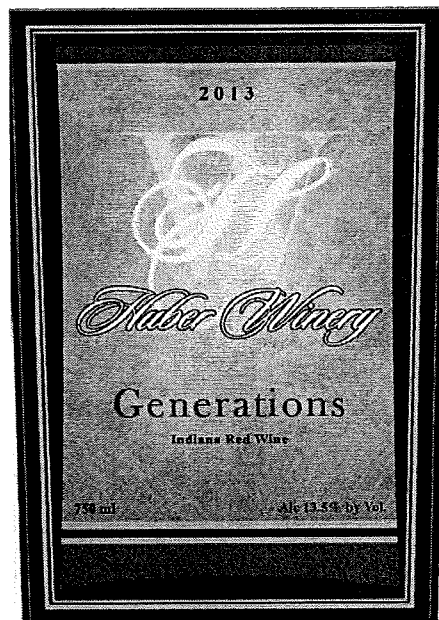
13. Huber understood and, upon information and belief, CMF intended to issue an ultimatum to "settle" on CMF's terms or be sued.

14. Defendants sell the GENERATIONS wines as part of its "Charles Krug" line and use the GENERATIONS trademark as a subordinate element of the "Charles Krug," as follows:

*{photograph of trademark appears on next page}*



15. Huber uses its common law "Huber Winery Generations Indiana Red Wine" trademark as a subordinate element of its Huber Winery common law trademark as follows:



16. Huber began selling its "Huber Winery Generations Indiana Red Wine" line locally in 1997, two years before CMF registered its trademark, and for years 1997, 1998 and 1999, before CMF obtained its registration, Huber obtained Alcohol and Tobacco Tax and Trade Bureau ("TTB") approved labels for the sale of its "Generations" wines.

17. TTB was a division of the Bureau of Alcohol Tobacco and Firearms until 2002, after which the Department of Homeland Security established it as a separate agency which, in part, functions to regulate the advertising, labeling and formulation of alcoholic beverages.

18. At all times, TTB records, including the approved labels for Huber's "Huber Winery Generations" wines were public records and accessible to Defendants by the exercise of minimal diligence.

19. Huber began selling its "Huber Winery Generations" wine on the internet in 2004. Its use of the common law mark "Huber Winery Generations" on the internet was public and accessible to Defendants by the exercise of minimal diligence.

20. Since 1997, Huber expanded its sales regionally and to a lesser extent nationally.

21. CMF's "Charles Krug Peter Mondavi Family Napa Valley GENERATIONS" and Huber's "Huber Winery Generations" wines have co-existed for twenty years, including on the internet for nearly thirteen years.

**ACTION FOR DECLARATORY JUDGMENT OF NON-INFRINGEMENT**

22. The allegations asserted in paragraphs 1-21 are hereby incorporated by reference herein.

23. CMF's C&D Letter gives rise to a real and reasonable apprehension of the imminent threat of federal trademark litigation against Huber for its sale of wines under its "Generations" common law trademark. Therefore, there exists a justiciable controversy for this Court to hear pursuant to federal law.

24. Huber's use of its "Huber Winery Generations" common law trademark does not infringe any trademark in which CMF has right because there is no likelihood of confusion.

25. Huber's and CMF's wines have co-existed in the marketplace for over 20 years without any actual confusion. Huber knows of no instances of actual confusion, and Defendants have not and cannot point to any instances of actual confusion.

26. The presentation of the trademarks, depicted in paragraphs 13 and 14 above, present no plausible possibility of confusion.

27. The pricing of the subject wines militates against any possibility of confusion.

28. Purchasers of CMF's \$60 bottles of wine are quintessential sophisticated and discerning consumers who would never confuse the wines at issue.

29. Any claim brought under the Lanham Act or any other applicable law is time barred by the analogous state law statute of limitations or by the concurrent application of the analogous state law statute of limitations to the equitable doctrine of laches.

30. Under Indiana law, the limitations period applicable to trademark actions as a claim for damage to personal property, is two years.

31. Defendants knew or should have known of Huber's use of the trademark "Huber Winery Generations" many years ago, and by the passage of time has shown a complete lack of diligence in policing its GENERATIONS mark to the extreme prejudice of Huber which has been selling its "Generations" line of wines for twenty years without consumer confusion, or harm or prejudice to Defendants.

32. Huber has expended considerable resources developing, promoting and marketing its "Huber Winery Generations" brand which has developed its own following and goodwill.

33. Huber will be severely prejudiced if restrained from use of "Generations," after twenty years, during which CMF sat on its rights for such an inordinate period of time when

even the most minimal diligence in policing its GENERATIONS trademark would have uncovered Huber's potentially infringing, yet innocent, use pursuant to §1115(b)(5).

34. Alternatively, and notwithstanding its no confusing similarity, laches and limitations defenses, Huber has been at all times, an innocent junior user of its "Generations."

WHEREFORE, Huber respectfully demands:

- a. That the Court declare Huber's use of "Generations" non-infringing as it relates to CMF's GENERATIONS trademark and that its use has not, does not and will not infringe CMF's GENERATIONS trademark;
- b. That the Court declare Huber's use of "Huber Winery Generations" as non-infringing as it relates to CMF's GENERATIONS trademark and that its use has not, does not and will not infringe CMF's GENERATIONS trademark;
- c. A jury trial on all issues so triable;
- d. Leave to amend as facts and circumstances may warrant; and
- e. That the Court award any and all other relief to which Huber may appear entitled.

/s/ Christopher A. Bates

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