

**IN THE UNITED STATES DISTRICT COURT  
EASTERN DISTRICT OF NEW YORK**

DUNKIN’ BRANDS GROUP, INC. and	)	
DD IP HOLDER, LLC.	)	
	)	
Plaintiffs,	)	
v.	)	
	)	Civil Action No.
SINGH HANDICRAFT CORP.; and	)	
JAYNEET DUA,	)	<b>JURY TRIAL DEMANDED</b>
	)	
Defendants.	)	
	)	

**COMPLAINT FOR DAMAGES AND INJUNCTIVE RELIEF**

Plaintiffs Dunkin’ Brands Group, Inc. (“Dunkin’ Brands”) and DD IP Holder, LLC (“DD IP”); collectively with Dunkin’ Brands, “Dunkin’”) file this Complaint against Singh Handicraft Corp. (“Singh”) and its Chief Executive Officer, Jayneet S. Dua (“Mr. Dua”); collectively with Singh, “Defendants”), and in support thereof alleges as follows:

**NATURE AND BASIS OF ACTION**

1. This is an action against Defendants for knowing and willful trademark infringement in violation of the federal Lanham Act, 15 U.S.C. § 1114(1), and New York common law; unfair competition in violation of the federal Lanham Act, 15 U.S.C. § 1125(a), New York Gen. Bus. Law § 349 and New York common law; trademark dilution in violation of the federal Lanham Act, 15 U.S.C. § 1125(c), and New York Gen. Bus. Law § 360-I; and unjust enrichment in violation of New York common law.

2. Defendants manufacture, offer for sale, and sell electronic cigarettes and oral vaporizers using the mark VAPIN’ DONUTS & Design (shown below), through online and in-

store retailers and have applied to federally register the VAPIN' DONUTS & Design mark with the United States Patent and Trademark Office (App. No. 97/838,230).



3. Defendants' use of and application to register the VAPIN' DONUTS & Design mark infringes and dilutes by blurring and tarnishment Dunkin's federally registered and common law trademark rights in its DUNKIN' DONUTS marks.

4. Dunkin' seeks preliminary and permanent injunctive relief, damages, including punitive damages, a disgorgement of Defendants' profits, and a recovery of Dunkin's reasonable attorneys' fees and costs.

#### **THE PARTIES**

5. Plaintiff Dunkin' Brands is a corporation organized and existing under the laws of the state of Delaware. Dunkin' Brands maintains its headquarters and principal place of business at 130 Royall Street, Canton, Massachusetts 02021.

6. Plaintiff DD IP is a company organized and existing under the laws of the state of Delaware. DD IP maintains its headquarters and principal place of business at 130 Royall Street, Canton, Massachusetts 02021.

7. DD IP is the owner of the well-known DUNKIN' DONUTS trademarks which have been used by Dunkin' Brands and its franchisees under license in connection with coffee and coffee-based beverages, restaurant services, and café services (among other products and services) throughout the United States for more than 70 years.

8. Defendant Singh Handicraft Corp. (“Singh”) is a New York corporation with a principal place of business located within this District at 14 Allen Boulevard, Farmingdale, New York 11735.

9. Upon information and belief, Singh advertises, promotes, offers for sale, and sells its VAPIN’ DONUTS-branded products to consumers throughout the United States, including within this District, through various retailers, both online and in-store.

10. Singh may be served through its registered agent, Anand Consulting Group Inc., located at 534 Merrick Road, Suite 1, Lynbrook, New York, 11563.

11. Upon information and belief, Defendant Jayneet S. Dua resides within this District at 59 Fox Lane, Dix Hills, New York 11746.

12. Mr. Dua is the chief executive officer of Singh Handicraft Corporation. Upon information and belief, Mr. Dua personally authorized, directed, and/or participated in the infringing activities complained of herein.

### **JURISDICTION AND VENUE**

13. This Court has subject matter jurisdiction over Dunkin’s federal claims pursuant to 15 U.S.C. § 1121 and 28 U.S.C. §§ 1331, 1332, 1337 and 1338 because this action arises under the federal Lanham Act, 15 U.S.C. §§ 1051 et seq.

14. This Court has supplemental jurisdiction over Dunkin’s related state law and common law claims pursuant to 28 U.S.C. §§ 1338 and 1367.

15. This Court has personal jurisdiction over both Defendants because Singh’s principal place of business is located, and Mr. Dua resides, within this judicial district.

16. Furthermore, upon information and belief, Defendants have purposefully availed themselves of the benefits of doing business in the State of New York by advertising, promoting,

offering for sale and/or selling infringing products to consumers located in this State. Defendants are thus committing tortious acts in New York and have wrongfully caused Dunkin' substantial injury within the State.

17. Venue is proper in this Court pursuant to 28 U.S.C. § 1391(b)(2) and (b)(3) because Defendants, upon information and belief, are residents of this district and subject to personal jurisdiction in this district, and are causing harm to Dunkin' and consumers in this judicial district by advertising, offering to sell, and/or selling infringing VAPIN' DONUTS-branded products in this district.

### **FACTUAL BACKGROUND**

#### **I. DUNKIN' AND ITS FAMOUS DUNKIN' MARKS**

18. Founded in 1950, Dunkin' has become the largest coffee and donut brand in the United States. Dunkin', on its own and through its franchisees, operates quick-service restaurants which advertise, offer for sale, and sell DUNKIN' DONUTS-branded coffee, donuts, and merchandise to consumers.

19. There are over 12,000 DUNKIN'-branded restaurants operating across the globe in several different markets. More than 1,000 of these locations are located within the State of New York.

20. Dunkin', its licensees and/or affiliates have continuously used the following trademarks and service marks in interstate commerce to identify its food and beverage products, restaurant and café services, and related goods and services:

- DUNKIN' DONUTS, which has been in use since 1950;
  - DUNKIN' DONUTS & Design (shown below), which has been in use since 1976;
- and






- DD & Coffee Icon (shown below), which has been in use since 2006.



21. In recognition of Dunkin's exclusive rights in these marks, the United States Patent and Trademark Office ("USPTO") has issued Dunkin' numerous federal trademark registrations, as shown in the chart below (together with Dunkin's common law rights in these and other DUNKIN' DONUTS-formative marks, these registered marks are referred to collectively herein as the "DUNKIN' Marks"). Copies of the registration certificates and status pages from the USPTO are attached as **Exhibit A**.

Mark	Registration No. & Registration Date	Goods and Services
DUNKIN' DONUTS	748,901 April 30, 1963	<b>Class 42:</b> restaurant services.
<b>DUNKIN' DONUTS</b> (“DONUTS” disclaimed)	4,600,316 September 9, 2014	<b>Class 43:</b> restaurant services; cafe services; snack bar services; fast-food restaurant services.  <b>Class 30:</b> doughnuts and bakery products; cookies; cakes; pies; muffins; plain, glazed, coated and filled fried cakes; bagels; sandwiches; pizza; sugar; flour; flavoring extracts; confectionery chips for baking; honey; yeast; baking-powder; custard-based fillings for cakes and pies; chocolate-based fillings for cakes and pies; chocolate-based topping; coffee and coffee-based beverages; tea and tea-based beverages; cocoa and cocoa-based beverages; coffee-based iced beverages, namely, coffee-flavored slush-type drinks.
DUNKIN' DONUTS (“DONUTS” disclaimed)	4,591,959 August 26, 2014	<b>Class 43:</b> restaurant services; cafe services; snack bar services; fast-food restaurant services.

Mark	Registration No. & Registration Date	Goods and Services
		<b>Class 30:</b> doughnuts and bakery products; plain, glazed, coated and filled fried cakes; bagels; sandwiches; custard-based fillings for cakes; coffee and coffee-based beverages; tea and tea-based beverages.
 (“DONUTS” and “EXPRESS” disclaimed)	4,013,751 August 16, 2011	<b>Class 43:</b> restaurant services, cafe services, snack bar services, carry-out food services.
	3,282,278 August 21, 2007	<b>Class 43:</b> restaurant services, cafe services, snack bar services, carry-out food services.
 (“DONUTS” and “COFFEE” disclaimed)	3,868,634 October 26, 2010	<b>Class 43:</b> restaurant services, cafe services, snack bar services, carry-out food services.

22. The DUNKIN’ Marks are frequently presented in Dunkin’s distinctive orange and pink color combination and often include the image of a steaming coffee cup against a pink and orange background (the “Coffee Icon”).

23. Dunkin’ has prominently used and promoted its DUNKIN’ Marks through extensive advertising, marketing, rendering of restaurant services, and sale of goods bearing the marks. As a result of this extensive advertising, continuous use, and heavy promotion of the DUNKIN’ Marks, they have become famous and an invaluable asset, serving as an immediately recognizable symbol of the quality of goods and services provided by Dunkin’.

24. DUNKIN’-branded restaurants and products generate billions of dollars in global sales each year.

25. *Entrepreneur* Magazine repeatedly ranks Dunkin’ as the within the top 5 franchises and #1 in the coffee and baked goods category. See <https://www.entrepreneur.com/franchises/directory/dunkin/282304>.

26. Dunkin’ promotes its DUNKIN’ Marks and restaurants through a heavily trafficked website located at <[www.dunkindonuts.com](http://www.dunkindonuts.com)>. Through the website, consumers can get information about Dunkin’ restaurant locations and the Dunkin’ rewards program, buy and manage gift cards, shop for DUNKIN’ DONUTS-branded products, and place orders for delivery from their local Dunkin’ restaurant.

27. Dunkin’ actively promotes its products and services on social media, including Facebook, X (formerly known as Twitter), Instagram, and TikTok, where it makes prominent use of DUNKIN’ Marks. As of September 18, 2023, Dunkin’s social media accounts reported the number of followers listed below:

<u>Account</u>	<u>Followers</u>
<b>Facebook</b> ( <a href="https://www.facebook.com/DunkinUS">https://www.facebook.com/DunkinUS</a> )	16.4 million
<b>TikTok</b> ( <a href="https://www.tiktok.com/@dunkin">https://www.tiktok.com/@dunkin</a> )	3.1 million
<b>Instagram</b> ( <a href="https://www.instagram.com/dunkin">https://www.instagram.com/dunkin</a> )	2.3 million
<b>X (formerly known as Twitter)</b> ( <a href="https://www.twitter.com/dunkindonuts">https://www.twitter.com/dunkindonuts</a> )	1.3 million

28. Dunkin’ has continuously and exclusively used its DUNKIN’ Marks in interstate commerce in connection with its restaurant services and food and beverage offerings, as well as related goods and services, in the United States since as early as 1950. Dunkin’ has therefore acquired valid and enforceable trademark rights in the DUNKIN’ Marks.

29. In accordance with Sections 7, 22, and 33(a) of the Trademark Act of 1946, 15 U.S.C. §§ 1057, 1072, and 1115(a), DD IP's federal trademark registrations are valid and subsisting in law, were duly and legally issued, are prima facie evidence of the validity of the marks registered and constitute constructive notice of the ownership of the DUNKIN' Marks by DD IP.

30. In addition, the DUNKIN' Marks have become incontestable pursuant to Section 15 of the Trademark Act of 1946, 15 U.S.C. § 1065, and, pursuant to Section 33(b) of the Act, 15 U.S.C. § 1115(b), constitute conclusive evidence of Dunkin's exclusive right to use the DUNKIN' Marks in commerce in the United States.

31. Furthermore, through continuous and extensive use and promotion of the DUNKIN' Marks in interstate commerce, the DUNKIN' Marks have become famous within the meaning of the Federal Trademark Dilution Act of 1995, 15 U.S.C. § 1125 (c)(2).

## **II. DEFENDANTS' UNLAWFUL CONDUCT**

32. Upon information and belief, Defendants manufacture, offer for sale, and sell electronic cigarettes and oral vaporizers (collectively, "vapes") using the mark VAPIN' DONUTS & Design (shown below; the "Infringing Mark").



33. Defendants applied to register the Infringing Mark in connection with "oral vaporizers, sold filled with essential oils, for smoking purposes" in Class 3 and "electronic cigarettes and oral vaporizers for smokers; oral vaporizers for smoking purposes sold filled with vegetable glycerin" in Class 5 (App. No. 97/838,230; the "Application").



34. Attorneys for Dunkin’ sent a cease and desist letter to Defendants and the Attorney of Record for the Application on August 23, 2023. Dunkin’ attempted to contact Defendants and their Attorney via phone, email, and mail regarding the Defendants’ infringing and dilutive activities but, to date, have not received any response.

35. Defendants’ products bearing the Infringing Mark are sold at various online retailers.

Retailer	Link to Vape products
Vape 123	<a href="https://vape123.com/disposables/vapin-donut/">https://vape123.com/disposables/vapin-donut/</a>
World Vape USA	<a href="https://worldvapeusa.com/vapin-donut-drip-5-rechargeable-disposable-7000-puffs-17ml-5ct-display/#">https://worldvapeusa.com/vapin-donut-drip-5-rechargeable-disposable-7000-puffs-17ml-5ct-display/#</a>
JNJ Distributors	<a href="https://jnj-distribution.com/shop/e-cig/disposables-ecig/vapin-donut-drip-7000-puffs-15ml-5ct-display/">https://jnj-distribution.com/shop/e-cig/disposables-ecig/vapin-donut-drip-7000-puffs-15ml-5ct-display/</a>
AMS Distribution	<a href="https://amsdistribution.us/products/vapin-donuts-7000-puffs-disposable-10-ct-bx">https://amsdistribution.us/products/vapin-donuts-7000-puffs-disposable-10-ct-bx</a>
Lazada	<a href="https://www.lazada.com.ph/products/vapin-donuts">https://www.lazada.com.ph/products/vapin-donuts</a>
ChemNerdz	<a href="https://www.chemnerdz.com/search?type=vapin+donut">https://www.chemnerdz.com/search?type=vapin+donut</a>

36. Upon information and belief, Defendants’ products bearing the Infringing Mark are sold at retail locations which sell electronic cigarettes and oral vaporizers. See <https://www.instagram.com/p/CrW9Y68u9QK/>.



37. Defendants advertise and promote their products under the Infringing Mark (shown below) online and on social media, including Instagram (@vapin\_donuts\_).



38. Defendants' Infringing Mark is nearly identical to the DUNKIN' Marks, including the distinctive orange and pink color scheme and rounded font. Indeed, Defendants have merely replaced the term "VAPIN'" for DUNKIN' in the DUNKIN' DONUTS (Stylized) mark and an electronic vaporizer for a coffee cup in the Coffee Icon.



39. Both Dunkin' and Defendants utilize online and social media advertising in promotion of respective goods and services.

40. Both Dunkin' and Defendants offer their goods through both online and in-store retail outlets.

41. Both Defendants' products and Dunkin's food and beverage products are relatively inexpensive, typically costing less than \$15.00.

42. Upon information and belief, Defendants were aware of Dunkin’ and its exclusive rights in the DUNKIN’ Marks when they began selling their products under the Infringing Mark—without license or consent from Dunkin’.

43. Defendants are intentionally associating their products with Dunkin’, its DUNKIN’ Marks, and Dunkin’s products and services offered thereunder, though use of hashtags #coffee, #coffeevape, #drip and #donutsforlife on their Instagram page.



44. Furthermore, Defendants offer their products under the Infringing Mark in two shapes, both of which are intended to further the association with Dunkin’ and its products and services, (i) an iced coffee cup shape bearing the Infringing Mark, and (ii) a “glazed” rounded shape that is intended to evoke a donut.



45. And certain flavors in which Defendants offer the disposable vapes under the Infringing Mark are identical to flavors Dunkin' offers for its coffee products (e.g., White Mocha, Iced Cappuccino).

46. Defendants' customers have expressed that the only reason they purchased Defendants' products is out of an affection for Dunkin'. For example, the Disposable Dad account on *YouTube*, which reviews vape products and has nearly 3,000 subscribers, stated Dunkin' Donuts is part of his roots and, "that was the only reason he got it." Otherwise, he would not have reviewed the product because it encourages "the FDA to come after stuff geared towards kids". See <http://www.youtube.com/watch?v=Kz2Dmn68N3c>. The video stated, and the associated comments agreed, the product is "enticing to children," which should be discouraged.

47. Indeed, Defendants are attempting to target underaged consumers with the flavors and shape of the products, conduct which the FTC has previously warned other e-cigarette and e-liquid manufacturers against. See <https://www.ftc.gov/business-guidance/blog/2018/05/ftc-fda-warning-letters-ask-it-kids-treat-or-tobacco-product>.

48. Defendants' use of the Infringing Mark in connection with such morally reprehensible and illegal conduct harms Dunkin's reputation and the good will associated with the DUNKIN' Marks.

49. Defendants' use of the Infringing Mark is also likely to dilute the distinctive quality of the DUNKIN' Marks such that they will no longer be associated exclusively with Dunkin'.

**COUNT I**  
**Federal Trademark and Service Mark Infringement**  
**(15 U.S.C. § 1114)**

50. Dunkin' repeats and incorporates by reference the allegations contained in the foregoing paragraphs of this Complaint.

51. Dunkin' has used its DUNKIN' Marks continuously and exclusively in commerce in connection with its goods and services since as early as 1950.

52. Dunkin' owns federal registrations for the DUNKIN' Marks, which serve to identify to the public certain goods and services that are offered by Dunkin' alone, and the goods and services offered in connection with the DUNKIN' Marks are regarded by the public as being offered by, approved by, authorized by, associated with, affiliated with, or otherwise connected to Dunkin', which has been recognized as the #1 franchise in the United States.

53. Defendants' adoption and use, in bad faith, of the nearly identical Infringing Mark, without Dunkin's authorization or consent, in commerce in connection with the sale, offering for sale, or advertising of its own goods, is likely to confuse, mislead, or deceive the public as to the true source, origin, affiliation, or sponsorship of Defendants' goods.

54. Defendants' use of the VAPIN' DONUTS & Design mark infringes Dunkin's exclusive rights in its protectable federally registered trademarks—specifically Registration Nos.

4,600,316; 3,282,278; 3,868,634; and 748,901—in violation of Section 32(1) of the Trademark Act of 1946, 15 U.S.C. § 1114(1).

55. Defendants’ aforesaid conduct has enabled Defendants to earn profits to which they are not in law, equity, or good conscience entitled, and have unjustly enriched Defendants, all to their profit and Dunkin’s damage and detriment.

56. Defendants’ adoption and use of the VAPIN’ DONUTS & Design mark was willful and intended for the purpose of trading on Dunkin’s reputation and goodwill.

57. Defendants’ aforesaid conduct has caused and will continue to cause actual and irreparable injury to Dunkin’ and the goodwill associated with the DUNKIN’ Marks for which Dunkin’ has no adequate remedy at law.

58. Dunkin’ is therefore entitled to appropriate relief as prayed for hereinafter, including preliminary and permanent injunctive relief.

59. As a result of Defendants’ wrongful conduct, Dunkin’ is also entitled to recover its monetary damages, an accounting of Defendants’ profits, and its costs, in an amount to be determined at trial.

60. Defendants’ conduct was willful and intentional, making this an “exceptional case,” and therefore Dunkin’ is also entitled to an award of its attorneys’ fees pursuant to 15 U.S.C. § 1117.

**COUNT II**  
**Federal Unfair Competition/False Designation of Origin**  
**(15 U.S.C. § 1125(a))**

61. Dunkin’ repeats and incorporates by reference the allegations contained in the foregoing paragraphs of this Complaint.

62. In addition to Dunkin’s federally registered DUNKIN’ Marks, discussed above,

Dunkin' possesses rights at common law in a number of DUNKIN'-formative marks. Dunkin' has used each of these marks in connection with its goods and services.

63. Defendants have intentionally adopted and used the Infringing Mark—prominently incorporating Dunkin's distinctive pink and orange combination; using an identical or similar font; and shape of a small, ice coffee cup with a straw—in commerce, without authorization or consent from Dunkin', in connection with the sale, offering for sale, distribution, and advertising of its disposable vapes, in an attempt to trade on Dunkin's good will.

64. Defendants' use of the Infringing Mark is likely to continue to cause confusion, mistake, or deception as to whether Defendants' disposable vapes originate from, are associated, affiliated or connected with, or are sponsored, endorsed or approved by Dunkin'.

65. Accordingly, Defendants' conduct constitutes unfair competition and false designation of origin in violation of the Lanham Act, 15 U.S.C. § 1125(a).

66. Defendants' aforesaid conduct has enabled Defendants to earn profits to which they are not in law, equity, or good conscience entitled, and have unjustly enriched Defendants, all to their profit and Dunkin's damage and detriment.

67. Defendants' adoption and use of the Infringing Mark was willful, in bad faith, and intended for the purpose of trading on Dunkin's reputation and goodwill.

68. As a direct and proximate result, Defendants' aforesaid conduct has caused and will continue to cause actual and irreparable injury to Dunkin' and the goodwill associated with the DUNKIN' Marks for which Dunkin' has no adequate remedy at law.

69. As a result of Defendants' wrongful conduct, Dunkin' is also entitled to recover its monetary damages, an accounting of the Defendants' profits, and its costs, in an amount to be determined at trial.

70. Defendants' conduct was willful and intentional, making this an "exceptional case," and therefore Dunkin' is also entitled to an award of its attorneys' fees pursuant to 15 U.S.C. § 1117.

**COUNT III**  
**Federal Trademark Dilution**  
**(15 U.S.C. § 1125(c))**

71. Dunkin' repeats and incorporates by reference the allegations contained in the foregoing paragraphs of this Complaint.

72. As a result of Dunkin's long term and widespread use of its DUNKIN' Marks and the amount of publicity and recognition surrounding Dunkin's goods and services, the DUNKIN' Marks have achieved a level of recognition such that they are famous and were famous prior to the acts of Defendants complained of herein.

73. Defendants' use of the nearly identical Infringing Mark in connection with their goods is likely to dilute the distinctive quality of the DUNKIN' Marks, through blurring and tarnishment, in violation of the Federal Trademark Dilution Act of 1995, 15 U.S.C. § 1125(c).

74. Defendants' aforesaid conduct has enabled Defendants to earn profits to which they are not in law, equity, or good conscience entitled, and have unjustly enriched Defendants, all to their profit and Dunkin's damage and detriment.

75. Defendants' adoption and use of the Infringing Mark was willful, in bad faith, and intended for the purpose of trading on Dunkin's reputation and goodwill.

76. As a direct and proximate result, Defendants' aforesaid conduct has caused and will continue to cause actual and irreparable injury to Dunkin' and the goodwill associated with the DUNKIN' Marks for which Dunkin' has no adequate remedy at law.



77. Dunkin' is therefore entitled to appropriate relief as prayed for hereinafter, including preliminary and permanent injunctive relief.

78. As a result of Defendants' wrongful conduct, Dunkin' is also entitled to recover its monetary damages, the Defendants' profits, and its costs, in an amount to be determined at trial.

79. Defendants' conduct was willful and intentional, making this an "exceptional case," and therefore Dunkin' is also entitled to an award of its attorneys' fees pursuant to 15 U.S.C. § 1117.

**COUNT IV**  
**New York Common Law Trademark and Service Mark Infringement**

80. Dunkin' repeats and incorporates by reference the allegations contained in the foregoing paragraphs of this Complaint.

81. Dunkin' has used its DUNKIN' Marks continuously and exclusively in commerce in connection with its goods and services since at least as early as 1950.

82. Defendants' unauthorized use of the Infringing Mark in New York for their vapes infringes Dunkin's rights in its DUNKIN' Marks, including its rights under New York common law, and is likely to cause consumer confusion. Such unauthorized use constitutes trademark infringement under New York common law.

83. Defendants are willfully infringing Dunkin's DUNKIN' Marks with full prior knowledge of Dunkin's rights in the marks.

84. Defendants' actions complained of herein will deceive the public as to the source of Defendants' products and as to the existence of an affiliation between Dunkin' and the Defendants.

85. As a direct and proximate result, Defendants' aforesaid conduct has caused and will continue to cause actual and irreparable injury to Dunkin' and the goodwill associated with the

DUNKIN' Marks.

86. As a result of Defendants' willful, egregious and intentional misconduct, Dunkin' is also entitled to recovery of its actual damages, as well as exemplary and punitive damages pursuant to the common law of New York, and to recover its costs and reasonable attorneys' fees, in an amount to be determined.

**COUNT V**  
**Deceptive Trade Practices Under New York Gen. Bus. Law § 349**

87. Dunkin' repeats and incorporates by reference the allegations contained in the foregoing paragraphs of this Complaint.

88. Defendants have intentionally adopted and used the Infringing Mark—prominently incorporating Dunkin's distinctive pink and orange combination; using an identical or similar font; and shape of a small, ice coffee cup with a straw—in commerce, without authorization or consent from Dunkin', in connection with the sale, offering for sale, distribution, and advertising of their disposable vapes to consumers in New York, in an attempt to trade on Dunkin's reputation and goodwill.

89. Defendants' use of the Infringing Mark is in bad faith and is likely to continue to cause confusion, mistake, or deception as to whether Defendants' disposable vapes originate from, are associated, affiliated or connected with, or are sponsored, endorsed or approved by Dunkin'.

90. As a result of Defendants' deceptive practices through use of the Infringing Mark, Dunkin' has suffered harm to its reputation and the goodwill associated with its DUNKIN' Marks.

91. Defendants' wrongful conduct will continue to cause such injury to Dunkin', in violation of New York Gen. Bus. Law § 349, unless and until enjoined by this Court.

92. As a result of Defendants' willful, egregious and intentional misconduct, Dunkin' is also entitled to treble damages pursuant to New York Gen. Bus. Law § 349 and to recover its

costs and reasonable attorneys' fees, in an amount to be determined.

**COUNT VI**  
**Unfair Competition Under New York Common Law**

93. Dunkin' repeats and incorporates by reference the allegations contained in the foregoing paragraphs of this Complaint.

94. Defendants have intentionally adopted and used the Infringing Mark in commerce, without authorization or consent from Dunkin', in connection with the sale, offering for sale, distribution, and advertising of their disposable vapes, in an attempt to trade on Dunkin's reputation and good will.

95. Defendants' use of the Infringing Mark is willful and in bad faith and is likely to continue to cause confusion, mistake, or deception as to whether Defendants' disposable Vapes originate from, are associated, affiliated or connected with, or are sponsored, endorsed or approved by Dunkin'.

96. As a direct and proximate result, Defendants' wrongful conduct will continue to cause such injury to Dunkin', in violation of the unfair competition common law of the State of New York, unless and until enjoined by this Court.

97. As a result of Defendants' willful, egregious and intentional misconduct, Dunkin' is also entitled to exemplary and punitive damages pursuant to the common law of New York and to recover its costs and reasonable attorneys' fees, in an amount to be determined.

**COUNT VII**  
**New York Statutory Trademark Dilution**  
**(New York Gen. Bus. Law § 360-l)**

98. Dunkin' repeats and incorporates by reference the allegations contained in the foregoing paragraphs of this Complaint.

99. As a result of Dunkin's long term and widespread use of its DUNKIN' Marks and the amount of publicity and recognition surrounding Dunkin's goods and services, the DUNKIN' Marks have achieved a level of recognition such that they are famous and were famous in the state of New York prior to the acts of Defendants complained of herein.

100. Defendants' use of the nearly identical Infringing Mark in connection with their goods is likely to dilute the distinctive quality of the DUNKIN' Marks in violation of New York Gen. Bus. Law § 360-I.

101. Defendants' aforesaid conduct has enabled Defendants to earn profits to which Defendants are not in law, equity, or good conscience entitled, and has unjustly enriched Defendants, all to their profit and Dunkin's damage and detriment.

102. Defendants' adoption and use of the Infringing Mark was willful and intended for the purpose of trading on Dunkin's reputation and goodwill.

103. As a direct and proximate result, Defendants' aforesaid conduct has caused and will continue to cause actual and irreparable injury to Dunkin' and the goodwill associated with the DUNKIN' Marks for which Dunkin' has no adequate remedy at law.

104. Dunkin' is therefore entitled to appropriate relief as prayed for hereinafter, including preliminary and permanent injunctive relief.

105. As a result of Defendants' wrongful conduct, Dunkin' is also entitled to recover its monetary damages, the Defendants' profits, and its costs, in an amount to be determined at trial.

### **COUNT VIII**

#### **Unjust Enrichment Under New York Common Law**

106. Dunkin' repeats and incorporates by reference the allegations contained in the foregoing paragraphs of this Complaint.

107. Defendants have been enriched and have benefitted from the goodwill associated

with the DUNKIN' Marks, by using the nearly identical Infringing Mark in violation of New York common law. For example, through the use of marks, branding and packaging that is confusingly similar to Dunkin's, Defendants have been able to make sales that it normally would not, gaining an unfair commercial advantage. This confusion results in increased sales of Defendants' disposable vapes, as well as avoided advertising, marketing, and other costs for the Defendants.

108. Defendants have been enriched at Dunkin's expense. Dunkin' has devoted substantial amounts of time, effort, money, talent and creativity to the development of its DUNKIN' Marks. The association between the Dunkin' brand and electronic cigarettes and oral vaporizers is at the expense of Dunkin's reputation and goodwill.

109. Given Defendants' inequitable misconduct, including its intentional and knowing trademark infringement and unfair competition for Defendants' own financial benefit, equity and good conscience requires restitution.

110. Defendants' wrongful conduct will continue to cause such injury to Dunkin' unless and until enjoined by this Court.

111. As a result of Defendants' willful, egregious and intentional misconduct, Dunkin' is entitled to an accounting of Defendants' unjustly earned profits.

### **JURY DEMAND**

Dunkin' demands trial by jury of all issues raised in the Complaint that are properly tried to a jury.

### **DEMAND FOR RELIEF**

WHEREFORE, by virtue of Defendants' unlawful conduct as alleged in Counts I-VIII of this Complaint, Dunkin' respectfully requests that this Court:

A. Enter judgment that Defendants, as a result of their unauthorized use of the

Infringing Mark, have:

1. Infringed Dunkin's rights in the federally registered DUNKIN' Marks in violation of Section 32(1) of the Trademark Act of 1946, 15 U.S.C. § 1114(1) and the common law of New York;
2. Engaged in unfair competition and false designation of origin in violation of Section 43(a) of the Trademark Act of 1946, 15 U.S.C. § 1125(a), New York Gen. Bus. Law § 349 and the common law of New York;
3. Engaged in trademark dilution in violation of the Federal Trademark Dilution Revision Act, 15 U.S.C. § 1125(c) and New York Gen. Bus. Law § 360-I;
4. Been unjustly enriched in violation of the common law of New York;

B. Enter preliminary and permanent injunctions restraining Defendants, as well as their officers, directors, employees, agents, affiliates, subsidiaries, divisions, successors, assigns, franchisees, licensees, and all those in privity or acting in concert with them from:

1. Manufacturing, distributing, shipping, advertising, marketing, promoting, selling, or otherwise offering for sale disposable vapes using the Infringing Mark or any other mark confusingly similar to the DUNKIN' Marks, including but not limited to any mark containing the phrase "VAPIN' DONUTS", making use of the Coffee Icon (or a design confusingly similar thereto), or making use of Dunkin's unique orange and pink color combination;
2. using or authorizing the use of the Infringing Mark, or any reproduction, counterfeit, copy, or colorable imitation thereof, in any form, or in any manner, or otherwise infringing the DUNKIN' Marks;
3. Otherwise unfairly competing with, injuring the business or reputation of, or

damaging the goodwill of Dunkin' in any manner;

4. Otherwise falsely representing themselves or any of their products as being associated or affiliated with, sponsored or endorsed by, or in any way connected with Dunkin'; and
5. Otherwise harming the distinctive quality of the DUNKIN' Marks.

C. Order that Defendants destroy all products and advertising and promotional materials that bear the Infringing Mark;

D. Order that Defendants, well as their respective officers, agents, servants, employees, attorneys, and those persons in active concert or participation with any of them, be directed to file with this Court and serve on Dunkin' within thirty (30) days after service of the injunction, a report in writing and under oath, setting forth in detail the manner and form in which Defendants have complied with the injunction;

D. Order that Defendants file an express abandonment of the Application with the United States Patent and Trademark Office;

E. Order that, pursuant to Section 35 of the Trademark Act of 1946, 15 U.S.C. § 1117, an accounting be had and judgment rendered against Defendants for both (1) the profits, gains, and advantage derived from its wrongful actions and (2) the damages sustained by Dunkin' as a result of Defendants' actions, including lost sales, price erosion, injury to goodwill, diminution of value of the mark, corrective advertising, and reasonable royalties, and any actual damages with such amounts to be trebled as provided by law because of the willful and deliberate nature of Defendants' actions;

F. Order that Dunkin's recovery based on Defendants' profits is inadequate, and enter judgment for an increased sum as the Court finds just, pursuant to 15 U.S.C. § 1117;

G. Order that Dunkin' be awarded punitive damages for Defendants' willful, intentional, egregious and malicious acts of common law unfair competition, trademark infringement and unjust enrichment, and otherwise provided by New York common law;

H. Order that, pursuant to Section 35 of the Trademark Act of 1946, 15 U.S.C. § 1117(a), Defendants be required to pay Dunkin' both the costs of this action and the reasonable attorneys' fees Dunkin' has incurred in connection with this action;

I. Grant Dunkin' such other and further relief as the Court deems just and proper.

Respectfully submitted, this 22nd day of September, 2023.

By: /s/ Natalie C. Clayton

Natalie C. Clayton (4409538)

**ALSTON & BIRD LLP**

90 Park Avenue

15<sup>th</sup> Floor

New York, NY 10016-1387

Telephone: (212) 210-9400

Facsimile: (212) 210-9444

Email: Natalie.Clayton@alston.com

Of Counsel:

Jason D. Rosenberg (PHV to Be Filed)

Georgia Bar No. 510855

*jason.rosenberg@alston.com*

Sarah Parker (PHV to Be Filed)

*sarah.parker@alston.cim*

Georgia Bar No. 734610

**ALSTON & BIRD LLP**

1201 W. Peachtree Street

Atlanta, Georgia 30309

Telephone: (404) 881-7000

Facsimile: (404) 881-7777

*Attorneys for Plaintiffs Dunkin Brands  
Group, Inc. and DD IP Holder, LLC*