

UNITED STATES DISTRICT COURT
WESTERN DISTRICT OF WASHINGTON
AT SEATTLE

UWAJIMAYA, INC., a Washington
corporation,

Plaintiff,

v.

CONCOURSE CONCESSIONS, LLC, a
Washington limited liability company,

Defendant.

No. 2:10-cv-1474

COMPLAINT

JURY DEMAND

For its complaint Plaintiff, Uwajimaya, Inc., alleges as follows:

PARTIES

1. Plaintiff Uwajimaya, Inc. (“Uwajimaya”) is a Washington corporation. Its principal place of business is in Seattle, Washington. Uwajimaya is engaged in interstate commerce.

2. Defendant Concourse Concessions, LLC (“Concourse Concessions”) is a Washington limited liability company. Its principal place of business is in Des Moines, Washington. Concourse Concessions is engaged in interstate commerce.

Complaint - 1

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JURISDICTION AND VENUE

3. This action arises under the trademark laws of the United States, 15 U.S.C. §§ 1051 *et seq.*, and jurisdiction is based upon 15 U.S.C. § 1121 and 28 U.S.C. § 1338. This Court has supplemental jurisdiction under 28 U.S.C. § 1367.

4. Venue is proper under 28 U.S.C. § 1391 as defendant resides in this judicial district and as a substantial part of the events giving rise to the claims occurred and a substantial part of the property subject to the action is situated in this judicial district.

FACTS

5. Uwajimaya was founded by Fujimatsu and Sadako Moriguchi, who opened their first retail store in Seattle in 1946. Uwajimaya now has three stores located in Washington and one in Oregon, and continues to look for growth opportunities in the Puget Sound area and across the country. Uwajimaya continues to be family run and operated, with a number of Moriguchi family members active in the day-to-day management of Uwajimaya.

6. Uwajimaya's grocery departments offer an extensive and diverse array of foods from all over Asia as well as more common American fare. In addition to their take-home grocery offerings, Uwajimaya's various locations also provide quick service and ready-to-eat food items in their delis and food courts. Shoppers can also find a variety of non-grocery items, such as kitchenware, health and beauty products, and art supplies.

7. Uwajimaya's customers include second and third generation Asian-Americans as well as non-Asians, locals and tourists alike. Many of Uwajimaya's customers frequently and familiarly refer to Uwajimaya as "Waji's," which is now a common nickname for the stores.

1 8. Through its commitment to family tradition, diversity of offerings, quality and
2 freshness of food, customer service, and knowledge and promotion of Asian cultures,
3 Uwajimaya has developed a first rate reputation and substantial goodwill.

4 9. Uwajimaya has registered a number of marks with the United States Patent and
5 Trademark Office (“USPTO”), including its service mark “UWAJIMAYA,” Registration
6 No. 2,297,381 (a copy of which is attached hereto as EXHIBIT A). This registration is
7 presently in full force and effect, has been owned by Uwajimaya during all periods of
8 infringement by Defendant described below, and is presently owned by Uwajimaya. This
9 registration has become incontestable under the provisions of 15 U.S.C. § 1065.

10 10. Defendant Concourse Concessions was incorporated on August 1, 2003.

11 11. In 2003, Seattle Restaurant Associates (“SRA”), a partnership between
12 Uwajimaya and concessionaire HMSHost Corporation, submitted a proposal in response to an
13 RFP from the Port of Seattle (the “Port”) for food and beverage concessions at Seattle-
14 Tacoma International Airport (“Sea-Tac”). The proposal contained an Uwajimaya-brand
15 concept for part of the space. The Port was enthusiastic and subsequently awarded a 10-year
16 contract to SRA. SRA contacted David Fukuhara of Concourse Concessions about subleasing
17 part of the concession space at Sea-Tac and developing a concession concept which would
18 include the Uwajimaya brand. SRA and Concourse Concessions agreed to and executed a
19 sublease, dated June 30, 2005.

20 12. In the summer of 2007, Concourse Concessions opened the restaurant called
21 “Waji’s by Uwajimaya” in Sea-Tac. The restaurant serves a variety of quick-service and
22 ready-to-eat Asian foods, including sushi, teriyaki and salads, as well as sandwiches. The
23

1 name “Waji’s by Uwajimaya” was suggested by Uwajimaya because of the popular usage of
2 the name “Waji’s” for “Uwajimaya.”

3
4 13. Uwajimaya allowed Concourse Concessions to begin operating the restaurant
5 under the name “Waji’s by Uwajimaya” under an oral license agreement. Once the restaurant
6 operations were stabilized, Uwajimaya anticipated that the oral license agreement would be
7 formalized and reduced to writing with mutually agreed-upon terms.

8
9 14. In the spring of 2009, Uwajimaya began preparations to apply for trademark
10 registration for the mark “WAJI’S” and contacted Concourse Concessions about formalizing
11 the license arrangement. In early August 2009, Uwajimaya followed up with David Fukuhara
12 of Concourse Concessions to request samples for the trademark application and for a meeting
13 to discuss the license arrangement. Mr. Fukuhara suggested that Uwajimaya’s attorney
14 contact his attorney.
15

16 15. Unbeknownst to Uwajimaya, on July 17, 2009, and without notification to or
17 authorization from Uwajimaya, Concourse Concessions submitted a number of applications
18 for trademark registrations including the the words “Waji’s” and “Uwajimaya.” As of the
19 date of this filing, the only trademark involving the term “Waji’s” or “Uwajimaya” that has
20 been registered to Concourse Concessions is the service mark “WAJI’S,” Registration
21 No. 3,754,351 (a copy of which is attached hereto as EXHIBIT B). However, Concourse
22 Concessions currently has pending several trademark applications including the words
23 “Waji’s” and “Uwajimaya,” and has filed such an application as recently as May 19, 2010. In
24 its applications, Concourse Concessions declared though its attorney, David L. Tingey, that it
25 believed itself to be the owner of the mark sought to be registered.
26
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1 16. Uwajimaya did not learn of the initial applications filed on July 17, 2009 until
2 several weeks after the applications were filed. Since its discovery, Uwajimaya has attempted
3 to negotiate an assignment of Concourse Concessions' trademark applications as well as
4 formalize the oral license agreement, but negotiations have been unsuccessful and recently
5 have come to a standstill. Consequently, and as a result of Concourse Concessions' material
6 breach through its misrepresentations of ownership of Uwajimaya's marks to the USPTO,
7 Uwajimaya has terminated the oral license agreement.
8

9
10 17. It appears that Defendant may be phasing out the use of the mark
11 "UWAJIMAYA" in the Sea-Tac restaurant. However, Defendant continues to use the mark
12 "WAJI'S" in the Sea-Tac restaurant without Uwajimaya's authorization or license.

13 18. The continuing use by Defendant of Uwajimaya's marks, including the mark
14 "WAJI'S," has caused and is likely to continue to cause confusion or mistake or deception of
15 purchasers as to the source or origin of the Sea-Tac restaurant's goods and services and as to
16 the affiliation of the restaurant with Plaintiff Uwajimaya.
17

18 19. Uwajimaya has no control over the quality of the goods and services sold by
19 the Sea-Tac restaurant, and because of the confusion as to source and affiliation engendered
20 by Defendant, Uwajimaya's valuable goodwill in respect to its marks has been put at risk.
21

22 20. Defendant's use of Uwajimaya's marks has resulted in the dilution of the
23 exclusive rights Uwajimaya has in its marks.

24 21. Defendant's infringement has been willful and deliberate, designed specifically
25 to trade upon the valuable goodwill associated with Uwajimaya's marks.
26

27 22. Defendant knowingly and with intent to deceive made false representations of
28 material fact regarding ownership of the service mark "WAJI'S" to the USPTO, and the

1 USPTO's reasonable reliance on the misrepresentation has proximately caused and is likely
2 to proximately cause damage to Uwajimaya.

3 23. Uwajimaya will suffer irreparable harm to its trade, business reputation, and
4 goodwill should Defendant's infringement be allowed to continue. Defendant's infringement
5 will continue unless enjoined by this court. Uwajimaya has no adequate remedy at law.
6

7 **COUNT I**
8 **FALSE DESIGNATION OF ORIGIN AND AFFILIATION**
9 **UNDER § 43(a) OF THE LANHAM ACT**

10 24. Paragraphs 1 through 23 of this Complaint are each realleged and incorporated
11 herein as if fully set forth.

12 25. Defendant's use in commerce of trademarks confusingly similar to
13 Uwajimaya's trademarks constitutes false designation of origin and affiliation in violation of
14 the Lanham Act, 15 U.S.C. § 1125(a).
15

16 26. Section 35(a) of the Lanham Act, 15 U.S.C. § 1117, provides that when a
17 violation of 1125(a) is established, the plaintiff shall be entitled to recover the defendant's
18 profits, any actual damages, and the costs of the suit, and the Court may in its discretion treble
19 the damages. In addition, the Court may award reasonable attorney's fees.
20

21 27. Uwajimaya has incurred and will continue to incur substantial attorneys' fees
22 in the prosecution of this action.

23 **COUNT II**
24 **INFRINGEMENT OF A FEDERALLY REGISTERED MARK**
25 **UNDER § 32 OF THE LANHAM ACT**

26 28. Paragraphs 1 through 27 of this Complaint are each realleged and incorporated
27 herein as if fully set forth.
28

36. The USPTO's reliance on Defendant's misrepresentations has proximately caused and is likely to proximately cause Uwajimaya to be damaged in an amount to be proven at trial.

COUNT IV
VIOLATION OF THE WASHINGTON ANTI-DILUTION STATUTE

37. Paragraphs 1 through 36 of this Complaint are each realleged and incorporated herein as if fully set forth.

38. Defendant, by its acts alleged herein, has violated the Washington anti-dilution statute, RCW 19.77.160.

COUNT V
COMMON LAW INFRINGEMENT

39. Paragraphs 1 through 38 of this Complaint are each realleged and incorporated herein as if fully set forth.

40. Defendant, by its acts alleged herein, has infringed Uwajimaya's trademarks.

COUNT VI
UNFAIR TRADE PRACTICES

41. Paragraphs 1 through 40 of this Complaint are each realleged and incorporated herein as if fully set forth.

42. Defendant, by its acts alleged herein, has engaged in unfair or deceptive acts or practices in the conduct of trade or commerce, in violation of RCW 19.86.010 *et seq.*

43. RCW 19.86.090 provides that any person who is injured in his or her business or property by a violation of RCW 19.86.020 may recover actual damages together with the costs of the suit, including reasonable attorneys' fees, and the Court may in its discretion treble the award of damages.

1 44. Uwajimaya has incurred and will continue to incur substantial attorneys' fees
2 in the prosecution of this action.

3 WHEREFORE, Plaintiff Uwajimaya prays for judgment and relief against Defendant
4 as follows:
5

6 A. For permanent injunctive relief, enjoining the Defendant from using the marks
7 "WAJI'S" and "UWAJIMAYA."

8 B. For an award of all damages sustained by Plaintiff on account of the
9 Defendant's false designation of origin and affiliation; infringement of Plaintiff's federally
10 registered service mark; dilution and infringement of Plaintiff's marks; unfair competition;
11 and fraudulent registration; and that such damages be trebled pursuant to 15 U.S.C. § 1117
12 and RCW 19.86.090;
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14 C. For an award of Plaintiff's reasonable attorneys' fees pursuant to
15 15 U.S.C. § 1117 and RCW 19.86.090;
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17 D. For an award of Plaintiff's costs and disbursements to be taxed herein;
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1 E. For an order certified to the Director of the USPTO ordering the cancellation
2 of service mark "WAJI'S," Registration No. 3,754,351; and

3 F. For such other and further relief as the Court may deem just and proper.
4

5 DATED this 14th day of September, 2010.

6 HILLIS CLARK MARTIN & PETERSON, P.S.
7

8 By: s/ Michael R. Scott

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17 Attorneys for Plaintiff

18 Uwajimaya, Inc.
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ND: 17670.034 4814-6373-6327v1

EXHIBIT A

Int. Cls.: 35 and 42

Prior U.S. Cls.: 100, 101 and 102

United States Patent and Trademark Office

Reg. No. 2,297,381

Registered Dec. 7, 1999

**SERVICE MARK
PRINCIPAL REGISTER**

UWAJIMAYA

UWAJIMAYA, INC. (WASHINGTON CORPORATION)
4601 SIXTH AVENUE SOUTH
SEATTLE, WA 98108

FOR: RETAIL GROCERY SERVICES;
RETAIL STORE AND MAIL ORDER CATALOG SERVICES FEATURING ASIAN FOOD, GIFTWARE AND HOUSEHOLD ITEMS, IN CLASS 35 (U.S. CLS. 100, 101 AND 102).

FIRST USE 0-0-1928; IN COMMERCE 0-0-1949.

FOR: RESTAURANT SERVICES, IN CLASS 42 (U.S. CLS. 100 AND 101).

FIRST USE 8-0-1970; IN COMMERCE 8-0-1970.

THE ENGLISH TRANSLATION OF THE "U" IN THE MARK IS EITHER "INFINITE", IN JAPANESE, OR "UNIVERSE", IN CHINESE. THE ENGLISH TRANSLATION OF THE "WA" IN THE MARK IS EITHER "PEACE/HARMONY," IN JAPANESE, OR "AND", IN CHINESE. THE ENGLISH TRANSLATION OF THE "JIMA" IN THE MARK IS "ISLAND", IN BOTH JAPANESE AND CHINESE. THE ENGLISH TRANSLATION OF THE "YA" IN THE MARK IS "STORE/SHOP" IN JAPANESE, AND "HOUSE" IN CHINESE.

SER. NO. 75-394,648, FILED 11-21-1997.

LIZ KULICK, EXAMINING ATTORNEY

EXHIBIT B

United States of America

United States Patent and Trademark Office

WAIJ'S

Reg. No. 3,754,351 CONCOURSE CONCESSIONS, LLC (WASHINGTON LIMITED LIABILITY COMPANY)
Registered Mar. 2, 2010 22518 MARINE VIEW DR
DES MOINES, WA 98198

Int. Cl.: 43 FOR: CARRY-OUT RESTAURANTS; RESTAURANT AND BAR SERVICES; RESTAURANT AND CAFE SERVICES; RESTAURANT SERVICES; RESTAURANT SERVICES FEATURING ASIAN CUISINE; RESTAURANT SERVICES, INCLUDING SIT-DOWN SERVICE OF FOOD AND TAKE-OUT RESTAURANT SERVICES, IN CLASS 43 (U.S. CLS. 100 AND 101).

SERVICE MARK
PRINCIPAL REGISTER

FIRST USE 7-31-2007; IN COMMERCE 7-31-2007.

THE MARK CONSISTS OF STANDARD CHARACTERS WITHOUT CLAIM TO ANY PARTICULAR FONT, STYLE, SIZE, OR COLOR.

SER. NO. 77-783,895, FILED 7-17-2009.

KIM SAITO, EXAMINING ATTORNEY



David J. Kybas

Director of the United States Patent and Trademark Office