

**UNITED STATES DISTRICT COURT
SOUTHERN DISTRICT OF FLORIDA**

Case No.: _____

VAUGHN BOYD and
SWI-DE, LLC D/B/A DREW ESTATE,

Plaintiffs,

v.

DEADWOOD TOBACCO COMPANY a/k/a
DEADWOOD TOBACCO COMPANY
CORPORATION,

Defendant.

JURY TRIAL DEMANDED

COMPLAINT

Plaintiffs Vaughn Boyd (“Boyd”) and SWI-DE, LLC d/b/a Drew Estate (“Drew Estate”) bring this action against Defendant Deadwood Tobacco Company a/k/a Deadwood Tobacco Company Corporation (“DTC”) for federal trademark infringement, federal unfair competition and false designation of origin, and cancellation of Defendant’s federal trademark registrations under the Lanham Act, 15 U.S.C. 1051 *et seq.*, and declaratory judgments in connection with allegations of tortious interference with contract and of breach of contract made by Defendant, and allege as follows:

PARTIES

1. Plaintiff Boyd is an individual and citizen of South Dakota, residing in Whitewood, South Dakota 57793.

2. Plaintiff Drew Estate is a limited liability company organized and existing under the laws of the State of Delaware with a principal address of 12415 SW 136th Avenue, Suite 7, Miami, Florida 33186.

3. Upon information and belief, Defendant DTC is a corporation organized and existing under the laws of the State of South Dakota with an address at Box 524, 715 Main St., Deadwood, South Dakota 57732.

4. This Court has jurisdiction of the subject matter pursuant to 28 U.S.C. §§ 1331 1338(a) because this action involves claims for federal trademark infringement and federal unfair competition under the Federal Lanham Act, 15 U.S.C. §1051 *et seq.* This court has supplemental jurisdiction over the declaratory judgment claims under 28 U.S.C. §1367(a) because the claims are so related to the Lanham Act claims that they form part of the same case or controversy.

5. This Court has personal jurisdiction over Defendant because: (a) Defendant has committed, and continues to commit, acts of trademark infringement and unfair competition in this judicial district, and (b) Defendant has purposefully directed that conduct at Plaintiff Drew Estate in this judicial district.

6. Venue in this Court is proper under 28 U.S.C. §1391(b)(2) because Defendant has committed acts of infringement and/or unfair competition complained of here in this judicial district.

BACKGROUND FACTS

Plaintiffs' Trademark Rights

7. Plaintiff Drew Estate was founded in 1996 by Jonathan Drew and Marvin Samel in New York, New York, and is one of the largest premium cigar manufacturers in the world. Since 2007, it has owned and operated the largest premium cigar factory in Nicaragua and one of the

five largest premium cigar factories in the world. Plaintiff Drew Estate has originated many famous and successful cigar brands, including ACID, Liga Privada, Undercrown, Factory Smokes, Nica Rustica, Kentucky Fire Cured, Herrera Esteli, Tabak Especial, and Isla del Sol.

8. Drew Estate has also organized and run the celebrated Barn Smoker experiential events in Florida, Pennsylvania, Connecticut, Louisiana, Texas and Kentucky; Cigar Safari cigar tourism events in Nicaragua; Freestyle Live and other online virtual events; and thousands of in-store live events at tobacconists' retail cigar stores throughout the nation.

9. Drew Estate and its brands are among the world's leaders in cigars, including in creating new cigar brands and in sales volume.

10. Drew Estate has a strong history in creating, manufacturing, and selling numerous "shop-exclusive" cigars that it sells solely to a single Drew Estate retail customer.

11. Plaintiff Boyd founded DTC in or around 2006 as a retail store and cigar bar in Deadwood, South Dakota. The retail store sold various cigar brands from multiple manufacturers, including Drew Estate, but did not at the time sell any house brands.

12. Starting in or about 2009, Drew Estate agreed with Boyd to create, make, and sell to DTC a shop-exclusive cigar under the mark DEADWOOD TOBACCO CO. SWEET JANE. The cigar blend chosen by Drew Estate and Boyd for this DEADWOOD TOBACCO CO. SWEET JANE cigar was selected from a unique set of proprietary blends owned by Drew Estate.

13. Thereafter, in or around 2013 and 2014, respectively, Drew Estate agreed with Boyd to create, manufacture and sell to DTC two additional shop-exclusive cigars under the marks DEADWOOD TOBACCO CO. FAT BOTTOM BETTY and DEADWOOD TOBACCO CO. CRAZY ALICE.

14. From their inception, the DEADWOOD TOBACCO CO. SWEET JANE, DEADWOOD TOBACCO CO. FAT BOTTOM BETTY, and DEADWOOD TOBACCO CO. CRAZY ALICE cigars were marketed and sold under those marks as well as the marks DEADWOOD, DEADWOOD TOBACCO, and DEADWOOD TOBACCO CO.

15. Like DEADWOOD TOBACCO CO. SWEET JANE, the cigar blends for DEADWOOD TOBACCO CO. FAT BOTTOM BETTY and DEADWOOD TOBACCO CO. CRAZY ALICE were selected from a unique set of proprietary blends owned by Drew Estate.

16. For the packaging of each of DEADWOOD TOBACCO CO. SWEET JANE, DEADWOOD TOBACCO CO. FAT BOTTOM BETTY, and DEADWOOD TOBACCO CO. CRAZY ALICE, Drew Estate created iconic “sugar skull” images of female characters, who together represented the marketing narrative of this DEADWOOD brand line of cigars – strong, heartbreaking women from the brothels and barrooms of the seedy underbelly of the Old West in Deadwood, South Dakota. In reference to this narrative and the delicious cigar blends used for these DEADWOOD brand cigars, Drew Estate and Boyd also marketed and promoted them under the mark THE YUMMY BITCHES. DEADWOOD TOBACCO CO. SWEET JANE, DEADWOOD TOBACCO CO. FAT BOTTOM BETTY, DEADWOOD TOBACCO CO. CRAZY ALICE, DEADWOOD, DEADWOOD TOBACCO, DEADWOOD TOBACCO CO., and THE YUMMY BITCHES will be collectively referred to herein as the “DEADWOOD Marks”.

17. From their inception until approximately 2016, DEADWOOD TOBACCO CO. SWEET JANE, DEADWOOD TOBACCO CO. FAT BOTTOM BETTY, and DEADWOOD TOBACCO CO. CRAZY ALICE brand cigars remained shop-exclusives that Drew Estate sold only to DTC.

18. In or around 2016, based on the consumer response to the unique blend profiles, iconic brand imagery, and compelling narrative of the cigars sold under the DEADWOOD Marks, Drew Estate and Boyd agreed that they could be successful nationwide if released and sold under the DEADWOOD Marks by Drew Estate throughout the country.

19. Accordingly, on or about July 22, 2016, DTC (owned at the time by Boyd) and Drew Estate entered into an exclusive license agreement (the “EXCL. TM LICENSE AGREEMENT”) under which DTC granted Drew Estate an exclusive worldwide license to, among other things, the DEADWOOD Marks, granting to Drew Estate the exclusive right to, among other things, make and sell cigars under the DEADWOOD Marks and other marks incorporating DTC’s name, mark, logo, or signature or facsimile thereof.

20. In that same month, Drew Estate announced its national release of the DEADWOOD brand cigars at the 2016 IPCPR trade show, the largest trade show in the premium cigar industry, hosted by and named for the trade association then known as the International Premium Cigar & Pipe Retailers Association. As reported at the time by the industry publication Cigar Dojo in its review of announcements by Drew Estate at the 2016 IPCPR trade show, “Drew Estate is making Deadwood’s Three Yummy Bitches line a national release. The line includes Sweet Jane, Fat Bottom Betty, and Crazy Alice – previously a shop-exclusive for Deadwood Tobacco Co. in South Dakota.”

21. Since that time, Drew Estate has, pursuant to and in accordance with the exclusive license agreement, expanded its DEADWOOD brand line to include cigars sold under the mark DEADWOOD TOBACCO CO. LEATHER ROSE starting in 2020, and cigars sold under the mark DEADWOOD TOBACCO CO. THE GIRL WITH NO NAME starting in 2022. DEADWOOD TOBACCO CO. LEATHER ROSE, DEADWOOD TOBACCO CO. THE GIRL WITH NO

NAME, and the DEADWOOD Marks will collectively be referred to herein as the DEADWOOD CIGAR Marks.

22. Since the release of the DEADWOOD TOBACCO CO. SWEET JANE brand cigar in or around 2009, Plaintiffs Boyd and Drew Estate have spent millions of dollars promoting the DEADWOOD CIGAR Marks. Plaintiffs have promoted the DEADWOOD CIGAR Marks through extensive advertising and promotional activities including: print advertising, online advertising, sweepstakes, price promotions, hundreds of in-store events, trade shows, experiential events, promotional “swag” (*i.e.*, branded utilitarian items such as lighters, cutters, hats, t-shirts, humidors, etc.), and inclusion in Drew Estate promotional and trade programs such as the Drew Diplomat Retailer Program.

23. By virtue of Plaintiffs’ extensive promotion and use of the DEADWOOD CIGAR Marks and their distinctiveness, the purchasing public (including retailers and end users) has come to recognize DEADWOOD TOBACCO CO. SWEET JANE, DEADWOOD TOBACCO CO. FAT BOTTOM BETTY, DEADWOOD TOBACCO CO. CRAZY ALICE, DEADWOOD TOBACCO CO. LEATHER ROSE, and DEADWOOD TOBACCO CO. THE GIRL WITH NO NAME as a family of products marketed under a family of trademarks with a common origin (the “DEADWOOD FAMILY OF MARKS”).

24. The result of such promotional activity by Plaintiff Drew Estate is that the DEADWOOD CIGAR Marks have become one of the most successful and widely sold cigar brands in the United States, and both Drew Estate’s direct customers (such as retailers) as well as the end user consuming public have come to associate the DEADWOOD CIGAR Marks, including but not limited to the DEADWOOD FAMILY OF MARKS, with Plaintiff Drew Estate, which

inures to the benefit of Plaintiff Boyd as licensor. As a result, Plaintiffs' rights in those marks are highly valuable.

25. Plaintiff Boyd is the owner of various U.S. Trademark Registrations that have been exclusively licensed to Plaintiff Drew Estate, including U.S. Trademark Registration No. 4,617,294 for DEADWOOD TOBACCO CO. SWEET JANE, U.S. Trademark Registration No. 4,617,607 for DEADWOOD TOBACCO CO. CRAZY ALICE, U.S. Trademark Registration No. 4,648,322 for DEADWOOD TOBACCO CO. FAT BOTTOM BETTY, and U.S. Trademark Registration No. 6,397,678 for DEADWOOD TOBACCO CO. LEATHER ROSE, all for cigars. *See* Trademarks attached hereto as Exhibits 1-4.

26. On or about April 1, 2018, Plaintiff Boyd, under a Stock Purchase Agreement, agreed to sell 99% of her interest in DTC to new owners. Excluded from that sale were the DEADWOOD CIGAR Marks, including but not limited to the trademark registrations for DEADWOOD TOBACCO CO. SWEET JANE, DEADWOOD TOBACCO CO. CRAZY ALICE, and DEADWOOD TOBACCO CO. FAT BOTTOM BETTY, as well as the EXCL. TM LICENSE AGREEMENT. On September 30, 2019, Plaintiff Boyd sold her remaining 1% interest in DTC to the new owners.

27. Effective April 1, 2018, Defendant DTC assigned all of its rights and obligations under the EXCL. TM LICENSE AGREEMENT, and any rights in the trademarks covered by that license agreement and their associated goodwill, to Plaintiff Boyd. This included execution by Defendant DTC and Plaintiff Boyd of an agreement titled ASSIGNMENT OF EXCLUSIVE TRADEMARK LICENSE AGREEMENT ("ASSIGNMENT") in which DTC explicitly acknowledged that it received sufficient consideration as part of this agreement.

28. In an amendment to the EXCL. TM LICENSE AGREEMENT, Plaintiff Boyd extended the term of the EXCL. TM LICENSE AGREEMENT to Plaintiff Drew Estate for fifty (50) years from the July 22, 2016 Effective Date, to July 22, 2066.

29. In the amendment titled AMENDMENT NO. 1 TO ASSIGNMENT OF EXCLUSIVE TRADEMARK LICENSE AGREEMENT dated March 1, 2020 and executed by DTC and Boyd (“FIRST AMENDMENT TO ASSIGNMENT AGREEMENT”), DTC acknowledged that: (a) from inception, Defendant DTC and Plaintiff Drew Estate recognized that they may wish to add to the family of marks exclusive licensed to Plaintiff Drew Estate under the EXCL. TM LICENSE AGREEMENT that incorporate within them the mark “DEADWOOD TOBACCO CO.”, and that (b) Defendant DTC benefitted from Plaintiff Drew Estate’s license of marks that incorporated the mark DEADWOOD TOBACCO CO.” It also acknowledged that Plaintiff Boyd as assignee and Plaintiff Drew Estate may continue to expand the scope of marks licensed to Plaintiff Drew Estate.

30. Defendant DTC expressly agreed to an irrevocable, worldwide, royalty-free license to Plaintiff Boyd of the mark DEADWOOD TOBACCO CO. in association or combination with any other marks exclusively licensed to Plaintiff Drew Estate by Plaintiff Boyd, whether then or in the future, and including the right to Plaintiff Boyd to sublicense use of DEADWOOD TOBACCO CO. to Plaintiff Drew Estate. By way of example and not limitation, Defendant DTC agreed that Plaintiff Boyd had a license to use DEADWOOD TOBACCO CO. in combination with LEATHER ROSE, to form the fourth mark DEADWOOD TOBACCO CO. LEATHER ROSE exclusively licensed to Drew Estate, and Plaintiff Boyd agreed to incorporate such mark in the license granted to Plaintiff Drew Estate.

31. Based on the exclusive license from DTC and later Plaintiff Boyd, Plaintiff Drew Estate has devoted substantial resources to building up goodwill and name recognition in the DEADWOOD CIGAR Marks for cigars, both individually and as a family. These marks now enjoy enormous consumer recognition and substantial goodwill. Drew Estate has sold millions of dollars of cigars under the DEADWOOD CIGAR Marks. Accordingly, the DEADWOOD CIGAR Marks are a property of significant value to Plaintiff Boyd and exclusive licensee Plaintiff Drew Estate. Customers have come to strongly associate the DEADWOOD CIGAR Marks with a single source, Plaintiff Drew Estate, which inures to the benefit of owner Plaintiff Boyd.

INFRINGING ACTIVITIES OF DEFENDANT DTC

32. Defendant DTC has started to promote and sell cigars under trademarks that are confusingly similar to the DEADWOOD CIGAR Marks, including but not limited to the DEADWOOD FAMILY OF MARKS, infringing them.

33. At no point did Defendant DTC obtain permission to use any of the DEADWOOD CIGAR Marks from either Plaintiff.

34. Furthermore, DTC has started to market its infringing products by trading on the goodwill in the DEADWOOD CIGAR Marks and DEADWOOD FAMILY OF MARKS developed and owned by Plaintiffs, not DTC. The infringing marks that Defendant DTC has begun to use, and/or for which it has obtained or sought U.S. trademark registration, include the following:

D.T.C. DEADWOOD TOBACCO COMPANY (U.S. Trademark Serial No. 90/757,907 and U.S. Trademark Serial No. 90/634,190)

DEADWOOD TOBACCO CO. CHASING THE DRAGON (U.S. Trademark Serial No. 97/047,226, U.S. Trademark Registration No. 7,006,299, and U.S. Trademark Registration No. 6,872,906)

DEADWOOD TOBACCO CO. CHASING THE DRAGON ZERO (U.S. Trademark Serial No. 6,926,495)

DEADWOOD TOBACCO CO. CHASING THE DRAGON AUNTIE (U.S. Trademark Registration No. 6,926,496)

DEADWOOD TOBACCO CO. CHASING THE DRAGON MIDNIGHT OIL (U.S. Trademark Serial No. 97/251,438 and U.S. Trademark Registration No. 6,926,497)

DEADWOOD TOBACCO CO. ZERO (U.S. Trademark Serial No. 97/818,535 and U.S. Trademark Serial No. 97/251,401)

DEADWOOD TOBACCO CO. AUNTIE (U.S. Trademark Serial No. 97/818,541 and U.S. Trademark Serial No. 97/251,424)

DEADWOOD TOBACCO CO. MIDNIGHT OIL (U.S. Trademark Serial No. 97/818,545)

35. Defendant DTC has been offering for sale and selling the cigars in its retail store and on its website using the DEADWOOD CIGAR Marks under the marks as follows:

DEADWOOD TOBACCO CO. CHASING THE DRAGON ZERO

DEADWOOD TOBACCO CO. CHASING THE DRAGON MIDNIGHT OIL

DEADWOOD TOBACCO CO. CHASING THE DRAGON AUNTIE

DEADWOOD TOBACCO CO. CHASING THE DRAGON DOUBLE SWEET

36. The use by Defendant DTC of the marks in the two preceding paragraphs (collectively, along with DEADWOOD, DEADWOOD TOBACCO, and DEADWOOD TOBACCO CO., the “Infringing Marks”) in connection with cigars has created a likelihood of confusion with cigars sold by Plaintiff Drew Estate under the DEADWOOD CIGAR Marks, including but not limited to the DEADWOOD FAMILY OF MARKS.

37. Continued use by Defendant DTC of DEADWOOD, DEADWOOD TOBACCO and DEADWOOD TOBACCO CO., alone or in combination with any other words or phrases in connection with cigars has created and will continue to create a likelihood of confusion with cigars

sold by Plaintiff Drew Estate under the DEADWOOD CIGAR Marks, including but not limited to the DEADWOOD FAMILY OF MARKS.

38. Continued use by Defendant DTC of the Infringing Marks in connection with cigars has caused not just a likelihood of confusion but also actual confusion as to the source or origin of the goods on which such marks are used both at the retailer and end consumer level.

39. In a letter to the cigar trade, a copy of which is attached as Exhibit 5, Defendant DTC has been falsely representing to the public that it was the “originator” of THE YUMMY BITCHES brand, and that its DEADWOOD TOBACCO CO. CHASING THE DRAGON brand cigar was an addition to the lineage of Drew Estate’s cigars sold under the DEADWOOD CIGAR Marks and an extension of the brand narrative used in connection with THE YUMMY BITCHES mark that Drew Estate has, through extensive promotion, developed into a clear brand identity of its DEADWOOD line of cigars, stating:

“As the originator of the “Yummy Bitches,” including Sweet Jane, Crazy Alice, Fat Bottom Betty, and Leather Rose, we felt it was time to add a new flavor profile to the lineage of greatness. With that, let me introduce you to the new line. Deadwood Tobacco Co. Chasing the Dragon is the first of its kind and boasts a rich selection of flavors never before introduced to the cigar world.”

...

“Just like the yummy bitches pay homage to the madams that ran the brothels in this notorious town, the DTC Chasing the Dragon name comes from the underbelly of the wild west. While the madams were running the ladies on Main Street, the ancient Chinese “medicine” was passed from hand to hand in the shadows and tunnels of Deadwood. Opium had its hold on many of the gold prospectors and cowboys looking to spend the day’s earnings, and that is where the story of them Chasing the Dragon came from. A cigar so good you crave another upon snuffing it out. We have three different sizes, with different flavor notes available so far, with more coming soon. The Auntie, Zero and Midnight Oil all carry names borrowed from the street slang for opium at the time.”

40. These statements are false representations.

41. THE YUMMY BITCHES brand was originated, developed, and popularized by Plaintiff Boyd as licensor and Plaintiff Drew Estate as exclusive licensee, the DEADWOOD TOBACCO CO. (or “DEADWOOD”) CHASING THE DRAGON product is not connected to and not an extension of Drew Estate’s cigars sold under the DEADWOOD CIGAR Marks. Also, Defendant DTC’s use of “*Our* YUMMY BITCHES CIGARS” (emphasis added) on its website in connection with “SWEET JANE”, “CRAZY ALICE”, “FAT BOTTOM BETTY” and “LEATHER ROSE” trades on the fame and goodwill of the DEADWOOD CIGAR Marks and DEADWOOD FAMILY OF CIGARS. Defendant DTC deliberately chose to make its false statements to trade on the fame and goodwill of Plaintiffs’ marks.

42. Defendant DTC has directly and/or through its distribution partner attempted to sell its CHASING THE DRAGON products to retailers as an extension of, add-on to, and/or replacement of Drew Estate’s cigars sold under the DEADWOOD CIGAR Marks. Defendant DTC has thus been falsely representing to the public that its AUNTIE, ZERO, and MIDNIGHT OIL brands are an extension of Plaintiff Drew Estate’s Deadwood brand and creating the impression that the goodwill developed by Plaintiff Drew Estate and Plaintiff Boyd in the Deadwood CIGAR MARKS brand and the YUMMY BITCHES should be extended to AUNTIE, ZERO, and MIDNIGHT OIL.

43. The use by Defendant DEADWOOD of the Infringing Marks has resulted in injury and damage to Plaintiff Drew Estate and Plaintiff Boyd.

44. In website searches recently conducted using Google’s search engine for the word “Deadwood,” Defendant’s DTC’s website and store appeared as prominent hits. When accessing Defendant’s website, a list of Plaintiff’s Drew Estate’s cigar brands using the DEADWOOD CIGAR Marks appeared, but virtually all were noted to be “SOLD OUT.” Included in that list on

the same page of Defendant DTC's website were Defendant DTC's Chasing the Dragon cigars, interspersed in the middle of Plaintiff Drew Estate's cigar products. By listing these Drew Estate cigars under various DEADWOOD CIGAR Marks but not having stocked them for what is, on information and belief, a substantial time period, and placing Defendant DTC's Chasing the Dragon cigars right next to such out of stock product listings, Defendant DTC is attempting to attract customers to its website using the strong reputation of Plaintiff Drew Estate's brands and DEADWOOD CIGAR Marks, but then in a classic "bait and switch," trying to sell customers the infringing DTC Chasing the Dragon cigar products instead.

45. Plaintiff Drew Estate notified Defendant DTC in a letter of January 27, 2023 that its use of DEADWOOD CIGAR Marks including DEADWOOD CIGAR CO. CHASING THE DRAGON, and misrepresentations that Defendant DTC is the originator of the Drew Estate's Deadwood brand and the YUMMY BITCHES marks, constitute trademark infringement and false statements to the public, and has demanded that such activity cease to avoid likelihood of confusion and trading on the goodwill of Plaintiff Drew Estate, and demanding corrective notice to the public, but Defendant DTC has refused to comply.

46. On June 9, 2023, Defendant DTC wrote to Plaintiffs attempting to excuse its infringement of the DEADWOOD CIGAR Marks by making false claims that various agreements and amendments it entered into with Boyd lacked consideration despite the agreements and amendments explicitly stating otherwise and despite Defendant DTC executing those agreements and amendments, agreeing to the adequacy and sufficiency of the consideration.

Defendant's New Threats Of Imminent Litigation

47. In its letter to Plaintiffs dated June 9, 2023, Defendant DTC claims that "nothing was exchanged" in the FIRST AMENDMENT, ASSIGNMENT, and FIRST AMENDMENT TO

ASSIGNMENT AGREEMENT and, therefore, these contracts are unenforceable for lack of consideration.

48. Defendant DTC further alleges that, even if these contracts were valid, there was no grant of exclusivity to the DEADWOOD CIGAR Marks to Plaintiffs Boyd and Drew Estate, and that nothing precludes Defendant DTC from licensing the marks and selling cigars or other items with the name “Deadwood Tobacco Co.,” in clear contravention of the plain language of the written contracts.

49. Defendant DTC threatens legal action against Plaintiffs Boyd and Drew Estate for breach of contract, breach of an implied duty of good faith and fair dealing, tortious interference with a business contract relating to its supplier of the infringing Deadwood Tobacco Co. Chasing The Dragon brand cigars, and declaratory judgment regarding the enforceability of the various contracts, unless Plaintiffs “commence [certain actions] immediately.”

COUNT I
Federal Trademark Infringement (15 U.S.C. §1125(a))

50. Plaintiffs Boyd and Drew Estate incorporate by reference the allegations of paragraphs 1 through 49 as if fully set forth herein.

51. Plaintiff Boyd is the sole owner, and Plaintiff Drew Estate is the exclusive licensee, of the federally-registered trademarks DEADWOOD TOBACCO CO. SWEET JANE (U.S. Trademark Registration No. 4,617,294), DEADWOOD TOBACCO CO. CRAZY ALICE (U.S. Trademark Registration No. 4,617,607), DEADWOOD TOBACCO CO. FAT BOTTOM BETTY (U.S. Trademark Registration No. 4,648,322), and DEADWOOD TOBACCO CO. LEATHER ROSE (U.S. Trademark Registration No. 6,397,678), for cigars and related goods (collectively, the “Registered Marks.”) *See* Exhibits 1-4.

52. Defendant has used, and on information and belief, is continuing to use in commerce the Infringing Marks, which are confusingly similar to each of the Registered Marks, in promoting, offering to sell, and selling cigars.

53. Defendant's use of the Infringing Marks in commerce was undertaken without consent or approval by either Plaintiff.

54. Defendant's unauthorized use in commerce of the Infringing Marks in connection with cigars is an infringement of Plaintiffs' exclusive rights and has caused, and is likely to cause confusion, mistake, or deception in violation of 15 U.S.C. § 1114.

55. Defendants' infringement was, and continues to be, undertaken willfully and in bad faith as part of a deliberate plan to deceive the public (including both cigar retailers and end users) into believing that the Defendant's products marketed under the Infringing Marks are sourced from, sponsored by, affiliated with, or associated with Plaintiff Drew Estate, when they are not, and to trade on the goodwill that Plaintiffs have established in the Registered Marks, all to the irreparable injury of Plaintiffs.

56. Defendant DTC's trademark infringement has damaged Plaintiffs' sales, profits, goodwill, and reputation, causing monetary damages and irreparable harm for which Plaintiffs have no adequate remedy at law.

57. Pursuant to 15 U.S.C. § 1117, Defendant's willful, deliberate actions entitle Plaintiffs to an award of profits, damages, and costs, including treble damages and an award of Plaintiffs' attorney's fees and costs.

58. Defendant's infringement will continue to cause substantial and irreparable harm to Plaintiffs unless enjoined by this Court.

COUNT II

Unfair Competition and False Designation of Origin under 15 U.S.C. § 1125(a)

59. Plaintiffs Boyd and Drew Estate incorporate by reference the allegations of paragraphs 1 through 49 as if fully set forth herein..

60. Defendant DTC’s actions complained of herein, including its unauthorized use in commerce of the Infringing Marks in marketing and selling cigars constitutes unfair competition and is an infringement of Plaintiffs’ exclusive rights in the DEADWOOD CIGAR Marks individually and the DEADWOOD FAMILY OF MARKS as a family that is likely to cause confusion, mistake, or deception among the purchasing public, including but not limited to cigar retailers and end users, as to the origin, sponsorship, or approval of Defendant’s products by Plaintiffs in violation of §43 (a) of the Lanham Act, 15 U.S.C. § 1125(a).

61. Defendant DTC has engaged in unfair competition by advertising that it is the “originator” of THE YUMMY BITCHES mark and line of cigars, expressly appropriating the brand identity and trading on the goodwill of Plaintiffs’ DEADWOOD CIGAR Marks and the DEADWOOD FAMILY OF MARKS, and by expressly indicating that its CHASING THE DRAGON cigars are an extension of the lineage of Plaintiffs’ cigars sold under the DEADWOOD CIGAR Marks and DEADWOOD FAMILY OF MARKS, by stating:

“As the originator of the “Yummy Bitches,” including Sweet Jane, Crazy Alice, Fat Bottom Betty and Leather Rose, we felt it was time to add a new flavor profile to the lineage of greatness. With that, let me introduce you to the new line.”

...

“Just like the yummy bitches pay homage to the madams that ran the brothels in this notorious town, the DTC Chasing the Dragon name comes from the underbelly of the wild west. While the madams were running the ladies on Main Street, the ancient Chinese “medicine” was passed from hand to hand in the shadows and tunnels of Deadwood. Opium had its hold on many of the gold prospectors and cowboys looking to spend the day’s earnings, and that is where the story of them Chasing the Dragon came

from. A cigar so good you crave another upon snuffing it out. We have three different sizes, with different flavor notes available so far, with more coming soon. The Auntie, Zero and Midnight Oil all carry names borrowed from the street slang for opium at the time.”

62. Defendant DTC has further engaged in unfair competition by attracting customers to its website using marks confusing Plaintiffs’ trademarks and by listing on its website Plaintiff Drew Estate’s DEADWOOD brand cigars, which it has not stocked, right next to (and intermixed with) Defendant DTC’s CHASING THE DRAGON products in an unfair bait and switch attempt to attract customers seeking Drew Estate’s DEADWOOD cigars to mistakenly purchase their own cigars.

63. Defendant DTC has unfairly traded on the goodwill of Plaintiffs Boyd and Drew Estate, causing loss of reputation and economic injury.

64. Defendant’s activities complained of herein were and continue to be undertaken willfully and in bad faith as part of a deliberate plan to deceive the public into believing that the Defendant’s products are from, sponsored by, affiliated with, or associated with Plaintiff Drew Estate and Plaintiff Boyd, when they are not, and to trade on the goodwill that Plaintiff Drew Estate and Plaintiff Boyd have established in the DEADWOOD CIGAR Marks and the DEADWOOD FAMILY OF MARKS.

65. Defendant is intentionally trading on Plaintiffs’ goodwill and reputation, resulting in willful infringement, all to the irreparable injury of Plaintiffs.

66. Defendant’s unfair competition and false designation of origin has damaged Plaintiffs, entitling Plaintiffs to an award of damages, profits, and costs, including treble damages and Plaintiffs’ attorneys’ fees and costs as a result of Defendant’s willfulness.

67. Defendant's activities complained of herein have caused and, unless enjoined by this Court, will continue to cause substantial and irreparable harm to Plaintiffs for which Plaintiffs have no adequate remedy at law.

COUNT III
Cancellation of Federal Trademark Registrations (15 U.S.C. §§ 1064 and 1119)

68. Plaintiffs Boyd and Drew Estate incorporate by reference the allegations of paragraphs 1 through 49 as if fully set forth herein.

69. Upon information and belief, Defendant claims ownership of the following federal trademark registrations and applications for trademark registration (collectively, "Defendant's Registrations and Applications"):

D.T.C. DEADWOOD TOBACCO COMPANY (U.S. Trademark Application Serial No. 90/757,907 and U.S. Trademark Application Serial No. 90/634,190)

DEADWOOD TOBACCO CO. CHASING THE DRAGON (U.S. Trademark Application Serial No. 97/047,226, U.S. Trademark Registration No. 7,006,299, and U.S. Trademark Registration No. 6,872,906)

DEADWOOD TOBACCO CO. CHASING THE DRAGON ZERO (U.S. Trademark Application Serial No. 6,926,495)

DEADWOOD TOBACCO CO. CHASING THE DRAGON AUNTIE (U.S. Trademark Registration No. 6,926,496)

DEADWOOD TOBACCO CO. CHASING THE DRAGON MIDNIGHT OIL (U.S. Trademark Application Serial No. 97/251,438 and U.S. Trademark Registration No. 6,926,497)

DEADWOOD TOBACCO CO. ZERO (U.S. Trademark Application Serial No. 97/818,535 and U.S. Trademark Serial No. 97/251,401)

DEADWOOD TOBACCO CO. AUNTIE (U.S. Trademark Application Serial No. 97/818,541 and U.S. Trademark Application Serial No. 97/251,424).

70. Defendant has no protectable trademark rights in any of the marks that are the subject of Defendant's Registrations and Applications.

71. The trademarks reflected in Defendant's Registration and Applications in connection with cigars are junior in priority to, and are likely to cause confusion with, Plaintiffs' DEADWOOD CIGAR Marks and DEADWOOD FAMILY OF MARKS, to which Plaintiffs own the exclusive rights.

72. Pursuant to the Lanham Act, this Court has jurisdiction to order the USPTO to rectify the trademark register and cancel Defendant's trademark registrations and refuse Defendant's applications to register.

73. Defendant's trademark registrations listed above were improvidently allowed and should be cancelled pursuant to 15 U.S.C. §§ 1064 and 1119.

74. Plaintiffs will be damaged if Defendant's federal trademark registrations listed above are not canceled and if Defendant's applications to federally register listed above are not refused.

75. Plaintiffs respectfully request that this Court declare that Defendant has no valid rights in the trademarks reflected in Defendant's Registration and Applications, order the cancellation of the registrations, and order the refusal of the applications that constitute Defendant's Registration and Applications.

COUNT IV
Declaratory Judgment Pursuant to 28 U.S.C. § 2201 and Fla. Stat. 86.011

76. Plaintiff Boyd and Plaintiff Drew Estate incorporate by reference the allegations of paragraphs 1 through 49 as if fully set forth herein.

77. By its letter dated June 9, 2023, Defendant DTC alleges that Plaintiffs Boyd and Drew Estate have tortiously interfered with a contract between Defendant DTC and a third party to promote and sell a line of cigars.

78. An actual and justiciable controversy currently exists between Plaintiffs Boyd and Drew Estate, on the one hand, and Defendant DTC, on the other hand, as to whether Defendant DTC can bring and maintain a tortious interference claim against Plaintiffs in connection with Plaintiffs objecting to the improper promotion and selling a line of cigars under trademarks that infringe Plaintiffs' DEADWOOD CIGAR Marks and to the improper deliberate trading on Plaintiffs' goodwill embodied by the DEADWOOD CIGAR Marks that are exclusively licensed to Plaintiff Drew Estate. Furthermore, Plaintiffs Boyd and Drew Estate have an economic interest in the subject matter of the purported interference and, for this additional reason, no valid claim can exist.

79. Defendant DTC does not have any IP rights to the use of the DEADWOOD CIGAR Marks or any confusingly similar mark in connection with cigars, including as reflected in the EXCL. TM LICENSE AGREEMENT, ASSIGNMENT, FIRST AMENDMENT, SECOND AMENDMENT, and FIRST AMENDMENT TO ASSIGNMENT AGREEMENT.

80. Plaintiff Boyd and/or Plaintiff Drew Estate have the legal right to protect their trademarks and associated goodwill and prevent others from infringing and improperly trading on their goodwill.

81. Plaintiff Boyd has the exclusive right to license the DEADWOOD CIGAR Marks, including pursuant to the ASSIGNMENT, FIRST AMENDMENT, SECOND AMENDMENT, FIRST AMENDMENT TO ASSIGNMENT AGREEMENT, Stock Purchase Agreement, and First Amendment to Stock Purchase Agreement.

82. Plaintiff Drew Estate has the exclusive right to any and all use of the DEADWOOD CIGAR Marks, including pursuant to the EXCL. TM LICENSE AGREEMENT, FIRST AMENDMENT and SECOND AMENDMENT.

83. Defendant DTC assigned whatever rights it had in continuing to use the DEADWOOD CIGAR Marks to Plaintiff Boyd, including the exclusive license to use of the DEADWOOD CIGAR Marks to Plaintiff Drew Estate.

84. Contrary to the plain language of the various contracts, Defendant DTC has stated that it has a right to the use of the DEADWOOD CIGAR Marks, and that the various contracts are unenforceable, pursuant to its letter dated June 9, 2023.

85. Defendant DTC improperly attempted to contract the use of the DEADWOOD CIGAR Marks to a third party manufacturer/distributor to promote and sell a line of cigars to be labelled and sold as “Deadwood Tobacco Co. Chasing the Dragon,” and has improperly used the brand narrative and trading on the goodwill built by Plaintiffs and embodied by Plaintiffs’ DEADWOOD CIGAR Marks.

86. Defendant DTC’s continued infringement of the use of the DEADWOOD CIGAR Marks has caused damage to Plaintiffs Boyd and Drew Estate.

87. The EXCL. TM LICENSE AGREEMENT, ASSIGNMENT, FIRST AMENDMENT, SECOND AMENDMENT, FIRST AMENDMENT TO ASSIGNMENT AGREEMENT, Stock Purchase Agreement, and First Amendment to Stock Purchase Agreement are enforceable and binding contracts.

88. By reason of the foregoing, an actual and justiciable controversy exists between Plaintiffs Boyd and Drew Estate and Defendant DTC regarding any alleged tortious interference claim involving use of Plaintiffs trademarks by Defendant DTC.

89. A judicial determination is necessary at this time so that the parties' dispute may be resolved and the parties may be aware of their respective rights and obligations.

COUNT V
Declaratory Judgment Pursuant to 28 U.S.C. § 2201 and SDCL §21-24-1

90. Plaintiff Boyd and Plaintiff Drew Estate incorporate by reference the allegations of paragraphs 1 through 49 as if fully set forth herein.

91. By its letter dated June 9, 2023, Defendant DTC alleges that Plaintiffs Boyd and Drew Estate have breached various contracts and/or breached an implied duty of good faith and fair dealing because Defendant DTC alleges that the contracts in question lacked consideration.

92. While such an allegation fails to identify a specific contract provision alleged to have been breached, an actual and justiciable controversy currently exists between Plaintiffs Boyd and Drew Estate, on the one hand, and Defendant DTC, on the other hand, as to whether Defendant DTC can maintain a breach of contract claim or breach of implied covenant of good faith and fair dealing against Plaintiffs.

93. Rather, each of the contracts in question, signed by Defendant DTC, explicitly states that sufficient consideration was exchanged.

94. The EXCL. TM LICENSE AGREEMENT, ASSIGNMENT, FIRST AMENDMENT, SECOND AMENDMENT, FIRST AMENDMENT TO ASSIGNMENT AGREEMENT, Stock Purchase Agreement, and First Amendment to Stock Purchase Agreement are all enforceable and binding contracts.

95. These contracts read together establish that Plaintiff Boyd has the exclusive right to license the DEADWOOD CIGAR Marks.

96. Plaintiff Boyd licensed the exclusive rights to sell, promote and/or manufacture using the DEADWOOD CIGAR Marks to Plaintiff Drew Estate.

97. At all times, Plaintiffs Boyd and Drew Estate have complied with the terms of the various contracts.

98. At all times, Plaintiffs Boyd and Drew Estate have complied with any implied covenant of good faith and fair dealing.

99. Defendant DTC is disregarding the terms of the contracts in an effort to invalidate Plaintiffs Boyd and Drew Estate's contractual rights.

100. By reason of the foregoing, an actual and justiciable controversy exists between Plaintiffs Boyd and Drew Estate and Defendant DTC regarding any alleged breach of contract and breach of implied covenant of good faith and fair dealing.

101. A judicial determination is necessary at this time so that the parties' dispute may be resolved and the parties may be aware of their respective rights and obligations.

PRAYER FOR RELIEF

WHEREFORE, Plaintiff Boyd and Plaintiff Drew Estate requests judgment against Defendant DTC as follows:

1. Defendant DTC be found to infringe Plaintiffs' rights in the DEADWOOD CIGAR Marks and in the DEADWOOD FAMILY OF MARKS under Section 43(a) of the Lanham Act, 15 U.S.C §1125(a);

2. Defendant DTC be found to infringe Plaintiff Boyd's rights and Plaintiff Drew Estate's exclusive rights in the Registered Marks under 15 U.S.C. §1114(a);

3. Defendant DTC be found to have engaged in unfair competition in violation of Section 43(a) of the Lanham Act, 15 U.S.C §1125(a);

4. Defendant be found to have no rights in the marks reflected in Defendant's Registrations and Applications, and that the U.S. Patent and Trademark Office be ordered to cancel the registrations and refuse the applications in Defendant's Registrations and Applications;

7. Defendant DTC be ordered to issue a public notice that it is not the "originator" of THE YUMMY BITCHES marks and has no rights in the DEADWOOD CIGAR Marks in connection with cigars and cigar products;

8. Defendant DTC and its owners, officers, and directors, and all those acting in concert with them, be preliminarily and permanently enjoined from further acts of infringement;

9. Defendant DTC be found liable for damages in an amount to be determined at trial and trebled due to Defendant DTC's bad faith and willful infringement;

10. Plaintiff Boyd and Plaintiff Drew Estate be awarded the costs of this action and its attorneys' fees because the Court finds this to be an exceptional case under 15 U.S.C. § 1117(a);

11. Defendant DTC deliver up for impoundment, during the pendency of this action, and for destruction upon entry of judgment, all products, labels, signs, prints, packages, wrappers, receptacles, advertisements, and other material which are used in commerce upon or in connection with the sale, offering for sale, distribution or advertising of goods on or in connection with such use which is likely to cause confusion, or to cause mistake or to deceive, which infringes Plaintiff Boyd's rights and Plaintiff Drew Estate's exclusive rights, falsely designating source or origin, or otherwise facilitating Defendant DEADWOOD's unfair competition with Plaintiff Drew Estate;

12. Defendant DTC be directed to file with this Court and serve on Plaintiff Boyd and Plaintiff Drew Estate within 30 days after service of an injunction, a written report under oath setting forth in detail the manner and form in which Defendant DTC has complied with this injunction; and

13. Entry of a judgment declaring that the various enforceable contracts grant Plaintiffs BOYD and DREW ESTATE the exclusive right to the use of the DEADWOOD CIGAR Marks.

14. Entry of a judgment declaring that Plaintiff Boyd and/or Plaintiff Drew Estate have the legal right to enforce and/or prohibit the use of the DEADWOOD CIGAR Marks.

15. Entry of a judgment declaring that Defendant DTC does not have any IP rights in regards to the DEADWOOD CIGAR Marks and as a result cannot contract the use of the DEADWOOD CIGAR Marks to third parties, including but not limited to CLE Cigars

16. Entry of a judgment declaring that Defendant DTC cannot bring any claims based on any statements by Plaintiff Boyd and/or Plaintiff Drew Estate stating that Plaintiff Boyd and/or Plaintiff Drew Estate have the exclusive right to use or own the DEADWOOD CIGAR Marks.

17. Entry of a judgment declaring that Plaintiff Boyd and/or Plaintiff Drew Estate have not tortiously interfered with a business contract involving Defendant DTC.

18. Entry of a judgment declaring that Plaintiff Boyd and/or Plaintiff Drew Estate have not breached the EXCL. TM LICENSE AGREEMENT, ASSIGNMENT, FIRST AMENDMENT, SECOND AMENDMENT, FIRST AMENDMENT TO ASSIGNMENT AGREEMENT, Stock Purchase Agreement, and/or the First Amendment to Stock Purchase Agreement.

19. Entry of a judgment declaring that Plaintiff Boyd and/or Plaintiff Drew Estate has not breached the implied covenant of good faith and fair dealing with respect to the EXCL. TM LICENSE AGREEMENT, ASSIGNMENT, FIRST AMENDMENT, SECOND AMENDMENT, FIRST AMENDMENT TO ASSIGNMENT AGREEMENT, Stock Purchase Agreement, and/or the First Amendment to Stock Purchase Agreement.

20. Entry of declaratory relief, and any preliminary and permanent injunction and equitable relief against Defendant DTC and its officers, agents, successors, employees,

representatives, and any and all persons acting in concert with it, from engaging in each of the policies, practices, customs, and usages complained of herein, as may be allowed by law;

21. Grant such further and additional relief as the Court deems just and proper.

Jury Demand

Plaintiff demands a jury trial on all issues so triable.

Date: June 14, 2023

Respectfully submitted,

DAVID BRAFMAN
Florida Bar No. 68289
777 S. Flagler Drive
Suite 1100, West Tower
West Palm Beach, FL 33401
Telephone: (561) 653-5000
Facsimile: (561) 659-6313
Email: david.brafman@akerman.com

RYAN ROMAN
Florida Bar No.: 0025509
SELENA A. GIBSON
Florida Bar No.: 0299325
201 E. Las Olas Boulevard,
Suite 1800
Fort Lauderdale, Florida 33301
Telephone: (954) 463-2700
Facsimile: (954) 463-2224
Email: Ryan.Roman@Akerman.com
Email: Selena.Gibson@Akermmman.com

*Counsel for Plaintiffs Vaughn Boyd and
SWI-DE, LLC, d/b/a Drew Estate*