

Ex-NFL Linebacker Files Suit Over 'Lights Out' Pajamas

By **Fola Akinnibi**

Law360, New York (April 6, 2016, 12:24 PM ET) -- Former San Diego Chargers linebacker Shawne Merriman filed a trademark suit in California federal court on Tuesday, accusing a Vermont-based teddy bear retailer of using his "Lights Out" nickname on its products without his permission.

Merriman, who also played for the Buffalo Bills during his NFL career, and his company, Lights Out Holdings LLC, claim Vermont Teddy Bear Co. Inc. sold "Lights Out" pajamas nationally through an online retail store, according to the complaint.

This isn't Merriman's first crack at a trademark suit. He recently settled with Nike Inc. in a separate suit alleging infringement of the "Lights Out" trademark. The nickname — which he earned after knocking four opposing players unconscious in the first half of a high school football game — has been a registered trademark since 2004 and long associated with the player and his on-field accomplishments, the suit says. However, knowing this, Vermont still willfully infringed on the mark, it continued.

"Plaintiffs demanded that Vermont cease and desist use of the 'Lights Out' mark and further engaged in extensive efforts to negotiate a resolution without litigation," the complaint said. "However, Vermont refused to cooperate."

The 2004 trademark, U.S. Registration Number 2,885,212, for "Lights Out" covers "clothing for men, women and children, namely, bottoms, boxer shorts, caps, hats, headwear, nightwear, shirts, shorts, sleepwear, sweatshirts, tank tops, tops, T-shirts and underwear," according to the suit.

Merriman started Lights Out Holdings in 2007 in a bid to further his brand. The company has sold its brand merchandise at its own sites, in addition to retailers like Wal-Mart Stores Inc. and others, the suit said.

Vermont allegedly began selling adult and kids' sleepwear with the trademark sometime before 2015 through a retail store called pajamagram.com and has made substantial sales of the products since the infringement started, the suit alleges.

He seeks \$2 million in statutory damages, along with exemplary and punitive damages, for trademark infringement, unfair competition and false endorsement, according to the suit. Merriman also seeks a trebling of damages, for the willful nature of the infringement.

Andrew Skale of Mintz Levin PC, counsel for Merriman, told Law360 on Wednesday that Merriman is vigorously protecting his valuable "Lights Out" trademark.

This isn't the former linebacker's first trademark suit over the "Lights Out" mark. He **filed**

suit against Nike in April 2014, accusing the apparel giant of using the brand without permission after negotiations for a licensing deal fell through. The parties **settled the suit** in February for an undisclosed amount, according to court documents.

Merriman is represented by Andrew D. Skale and Natalie Prescott of Mintz Levin Cohn Ferris Glovsky and Popeo PC.

Counsel information for Vermont was not immediately available.

The case is Lights Out Holdings LLC et al. v. The Vermont Teddy Bear Co. Inc., case number 3:16-cv-00813, in the U.S. District Court for the Southern District of California.

--Additional reporting by Y. Peter Kang and David McAfee. Editing by Rebecca Flanagan.

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