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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91190654
Party	Plaintiff OMS Investments, Inc.
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Submission	Motion to Suspend for Civil Action
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In the matter of Application Serial No. 77/520,947
Published in the *Official Gazette* on December 16, 2008
Mark: SHAKE-N-GROW

OMS Investments, Inc.)	
)	
Opposer,)	Opposition No. 91190654
)	
v.)	
)	
Hidden Creations,)	
)	
Applicant.)	
_____)	

OPPOSER’S MOTION TO SUSPEND OPPOSITION PROCEEDING

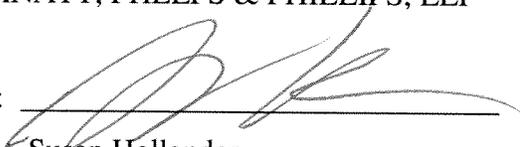
Opposer OMS Investments, Inc. (“Opposer”) moves to suspend this proceeding pursuant to Trademark Rule 2.117(a) until final determination of a related civil action styled *OMS Investments, Inc. and The Scotts Company LLC v. Gail Smith*, Case No. 2:10-cv-01037 currently pending in the United States District Court for the Eastern District of California (the “California Action”).

The California Action involves issues in common with those in this opposition proceeding. In particular, the California Action involves the issue of whether Applicant’s SHAKE-N-GROW Mark, Application No. 77/520,947, the mark which is the subject of this opposition proceeding, infringes on Opposer’s GRO and SHAKE-N-FEED family of marks. A true and accurate copy of the Complaint in the California Action along with a printout of the current electronic docket is attached hereto as Exhibit 1.

The Board should exercise its discretion to suspend this proceeding because the resolution of the California Action could resolve the issues in this proceeding, which resolution would be binding on the Board.

Dated: April 30, 2010

MANATT, PHELPS & PHILLIPS, LLP

By: 

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Shannon S. King

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Exhibit 1

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8 UNITED STATES DISTRICT COURT
9 EASTERN DISTRICT OF CALIFORNIA

11 OMS INVESTMENTS, INC., a California
12 corporation, and

13 THE SCOTTS COMPANY LLC, an Ohio
14 limited liability company,

14 Plaintiffs,

15 vs.

16 Gail E. Smith, individually and d/b/a
17 "Hidden Creations" and DOES 1-10;

18 Defendant.

Case No.

COMPLAINT FOR TRADEMARK
INFRINGEMENT, TRADE DRESS
INFRINGEMENT, FALSE DESIGNATION
OF ORIGIN, FEDERAL TRADEMARK
DILUTION, AND FEDERAL AND STATE
UNFAIR COMPETITION

DEMAND FOR JURY TRIAL

19 Plaintiffs OMS Investments, Inc. and The Scotts Company LLC (collectively, "Scotts" or
20 "Plaintiffs") for their Complaint against Gail E. Smith, individually and doing business as
21 "Hidden Creations" ("Smith" or "Defendant") allege as follows:

22 **INTRODUCTION**

23 1. This is an action seeking injunctive relief and damages for Defendant's willful
24 infringement of Plaintiffs' federally registered trademarks and trade dress. Defendant's use of
25 colorable imitations of Plaintiffs' marks and trade dress in promoting, selling, offering for sale,
26 importing, distributing and advertising Defendant's goods is likely to cause confusion as to the
27 affiliation, connection, association, origin, sponsorship or approval of Defendant's goods with
28

1 those of Plaintiffs and is also likely to dilute Plaintiffs' famous marks and trade dress, constituting
2 trademark infringement, trade dress infringement, unfair competition, false designation of origin
3 and dilution in violation of Sections 32 and 43 of the Lanham Act (15 U.S.C. § 1051 *et seq.*) and
4 of California statutory and common law.

5 **PARTIES**

6 2. Plaintiff OMS Investments, Inc. is corporation organized and existing under the
7 laws of Delaware, with its principal place of business at 10250 Constellation Boulevard, Suite
8 2800, Los Angeles, California 90067. OMS Investments, Inc. is a subsidiary of The Scotts
9 Company LLC.

10 3. Plaintiff The Scotts Company LLC is a limited liability company organized and
11 existing under the laws of Ohio, with its principal place of business at 14111 Scottslawn Road,
12 Marysville, Ohio 43041.

13 4. Scotts is informed and believes based on its investigation to date that Gail E.
14 Smith ("Smith") is a resident of the State of California with a business address of 1000 Lincoln
15 Road, Suite H #123, Yuba City, California 95991.

16 5. Scotts is informed and believes based on its investigation to date that Smith
17 operates a sole proprietorship named "Hidden Creations" with a business address of 1000 Lincoln
18 Road, Suite H #123, Yuba City, California 95991.

19 6. Scotts is informed and believes based on its investigation to date that Smith is
20 responsible for the day-to-day operations and management of, and is the moving force behind
21 "Hidden Creations."

22 7. Scotts is informed and believes based on its investigation to date that Smith is the
23 owner, operator and/or controlling force behind the websites located at <www.shakengrow.com>,
24 <www.shakeandgrow.com>, and <www.gailshiddencreations.com> which are used to assist in
25 the promotion, sale and distribution of infringing merchandise.

26 **JURISDICTION AND VENUE**

27 8. This court has jurisdiction over the subject matter of this action pursuant to 15
28 U.S.C. § 1121 and 28 U.S.C. §§ 1331 and 1338(a) and (b), and has supplemental jurisdiction over

1 the common law and state law claims asserted herein because they are so related to the claims in
2 this action that arise under federal law as to constitute part of the same case or controversy
3 pursuant to 28 U.S.C. § 1367(a).

4 9. Venue is proper in the Eastern District of California pursuant to 28 U.S.C. §
5 1391(b) because a substantial part of the actions that form the basis of Plaintiffs' claims against
6 Defendant occurred in this judicial district. Venue also is proper in this judicial district because
7 Defendant is subject to personal jurisdiction in this district and is deemed a resident hereof
8 pursuant to 28 U.S.C. § 1391(b) and 28 U.S.C. § 1391(c).

9 **FACTUAL BACKGROUND**

10 **A. Scotts' Famous Trademarks and Trade Dress**

11 10. Scotts is one of the world's leading marketers of branded consumer lawn and
12 garden products including fertilizers. Scotts owns some of the industry's most recognized brands,
13 including SCOTTS® and MIRACLE-GRO®. Scotts also has created a unique trade dress for
14 each of its brands, including the famous green and yellow trade dress of its MIRACLE-GRO®
15 line of products.

16 11. The MIRACLE-GRO® line featuring a distinctive green and yellow trade dress
17 was first introduced to the American public in 1951 and has been continuously sold ever since.
18 Scotts' MIRACLE-GRO® products include a wide variety of plant foods, lawn foods, fertilizers,
19 bloom enhancers, enhanced soils and potting mixes. MIRACLE-GRO® is now one of the most
20 recognizable and valuable brands in the consumer lawn and garden industry.

21 12. Scotts also owns numerous trademark and service marks incorporating its famous
22 and distinctive MIRACLE-GRO mark and GRO element (collectively, the "GRO Marks"). Since
23 at least as early as 1951, Scotts has used one or more of its GRO Marks in connection with a wide
24 range of garden and lawn related goods and services including without limitation plant food,
25 fertilizers, plant growing media and soil conditioners, and potting mix and soil, all as reflected in
26 the following representative registrations and applications at the United States Patent and
27 Trademark Office ("USPTO"):
28

Registered Marks	Registration No.
MIRACLE-GRO	668868
MIRACLE-GRO	1223038
EARTHGRO	1378337
EARTHGRO	1378721
EARTHGRO THE NATURAL CHOICE & Design	1723116
EARTHGRO THE NATURAL CHOICE & Design	1726060
MIRACLE-GRO POUR & FEED	2601682
MIRACLE-GRO GARDEN WEED PREVENTER & PLANT FOOD	2618698
MIRACLE-GRO GARDEN WEED PREVENTER	2618699
MIRACLE-GRO FAST ROOT	2787356
MIRACLE-GRO TREE & SHRUB CARE	2809982
MIRACLE-GRO SELECT PLANTS & DESIGN	2816031
MIRACLE-GRO & Design	2820953
MIRACLE-GRO & Design	2822655
MIRACLE-GRO	2856922
MIRACLE-GRO & Design	2856923
MIRACLE-GRO & Design	2856924
HAVE YOU USED MIRACLE-GRO LATELY?	2870768
MIRACLE-GRO SELECT PLANTS & Design	2900658
MIRACLE-GRO & Design	2906855
MIRACLE-GRO & Design	2906856
MIRACLE-GRO MOISTURE CONTROL POTTING MIX CONTAINS AQUACOIR & Design	2935663
MIRACLE-GRO & Design	2996098
MIRACLE-GRO	3074660
MIRACLE-GRO GARDEN SOIL ROSES & Design	3156217
MIRACLE-GRO ORGANIC CHOICE	3180531
MIRACLE-GRO GARDEN SOIL TREES & SHRUBS & Design	3182529
MIRACLE-GRO GARDEN SOIL FLOWERS & VEGETABLES & Design	3190987
MIRACLE-GRO & Design	3233837
MIRACLE-GRO	3456832
GARDEN-GRO	3498947
IT'S GRO TIME	3552933
Pending Applications	Application No.
GARDEN GRO	76/653762
IT'S GRO TIME	77/341556
IT'S GRO TIME	77/341562
PRO GRO	77/406779
MIRACLE-GRO SELECT PLANTS	77/421528
ORGANIC-GRO	77/699226
ORGANIC-GRO	77/699235
SLO-GRO	77/727569
GRO	77/755926
GRO	77/755931
GRO (STYLIZED)	77/755934
GRO (STYLIZED)	77/755935
GRO (STYLIZED)	77/755938
GRO (STYLIZED)	77/755988

1	MIRACLE-GRO COMPLETE	77/813595
2	EXPAND 'N GRO	77/907119
3	GRO YOUR OWN	77/880022
4	GRO-MIX	77/799605
5	GRO-POD	77/799595
6	MIRACLE-GRO	77/775762
7	READY, SET, GRO	77/799589

8 True and correct copies of the registrations or electronic records for the applications for the GRO
9 Marks printed out from the USPTO's online database are attached hereto as Exhibit A.

10 13. Each of the trademark registrations for the GRO Marks are valid and subsisting in
11 full force, unrevoked and uncanceled. Notably, Registrations Nos. 668,868; 1,223,038;
12 2,235,973; 1,378,337; 1,378,721; 1,723,116; 1,726,060; 2,601,682; 2,618,698; 2,618,699;
13 2,787,356; 2,809, 982; 2,816,031; 2,820,953; 2,822,655; 2,856,922; 2,856,923; 2,856,924;
14 2,870,768; 2,900,658; 2,906,855; 2,906,856; and 2,935,663 are incontestable pursuant to 15
15 U.S.C. Section 1065 and thus provide conclusive evidence of the validity of those registered
16 marks and of the registration of the marks, of Scotts' ownership of the marks, and of Scotts'
17 exclusive right to use those registered marks in commerce.

18 14. In or around 2001, as part of its MIRACLE-GRO® line of products, Scotts
19 unveiled a new line of plant food products in bead form, in a convenient shaker container, under
20 the mark SHAKE 'N FEED. Consumers immediately took to the easy-to-use SHAKE 'N FEED
21 product, and Scotts has now expanded the line to include several different varieties. Scotts'
22 SHAKE 'N FEED product line has become extremely popular among consumers of lawn and
23 garden products since its introduction.

24 15. Scotts owns two federal trademark registrations for the SHAKE 'N FEED mark:
25 Registration No. 2,705,327 and Registration No. 3,254,549. Notably, Registration No. 2,705,327
26 for SHAKE 'N FEED is incontestable pursuant to 15 U.S.C. Section 1065 and thus provides
27 conclusive evidence of the validity of the registered mark and of the registration of the mark, of
28 Scotts' ownership of the mark, and of Scotts' exclusive right to use the registered mark in
commerce.

16. In addition, due to the success of the SHAKE 'N FEED products, on or about

1 September 19, 2006, Scotts also filed two federal trademark applications for the mark SHAKE ‘N
2 SEED at Application Serial No. 77/002,750 and 77/002,759.

3 17. Scotts has also used and registered an additional SHAKE-formative mark, which
4 also contains the term “GROW” in connection with its popular SHAKE ‘N FEED products.
5 Since at least as early as 2002, Scotts has used the mark SHAKE A LITTLE GROW A LOT and
6 owns federal Registration No. 2,792,358 for the SHAKE A LITTLE GROW A LOT mark.
7 Indeed, Registration No. 2,792,358 is incontestable.

8 18. The SHAKE ‘N FEED, SHAKE ‘N SEED and SHAKE A LITTLE GROW A
9 LOT marks and the registrations and applications therewith are hereinafter collectively referred to
10 as the “SHAKE ‘N FEED Marks.” True and correct copies of the registrations or electronic
11 records for the applications as printed out from the USPTO’s online database for the SHAKE ‘N
12 FEED Marks are attached hereto as Exhibit B.

13 19. Not only have the GRO and SHAKE ‘N FEED Marks become famous and
14 protectable, the trade dress that accompanies these marks, particularly the widely recognized
15 green and yellow color combination of Scotts’ MIRACLE-GRO® packaging, has also become
16 associated in the minds of the consuming public with Scotts and its high quality products. True
17 and correct representations of Scotts’ MIRACLE-GRO® SHAKE ‘N FEED products displaying
18 Scotts’ famous MIRACLE GRO trade dress are attached as Exhibit C.

19 20. The unique combination of trade dress features such as the green and yellow color
20 combination used by Scotts in connection with its MIRACLE-GRO® products, including the
21 MIRACLE-GRO® SHAKE ‘N FEED products, (the “MIRACLE-GRO Trade Dress”) creates an
22 overall commercial impression that is inherently distinctive. Indeed, the green and yellow color
23 combination of the MIRACLE-GRO Trade Dress is so clearly associated in consumers’ minds
24 with Scotts that Scotts was able to obtain U.S. Registration No. 2,139,929, which expressly
25 covers Scotts’ green and yellow color scheme. A true and correct copy of Registration No.
26 2,139,929 is attached hereto as Exhibit D. Notably, this registration is incontestable pursuant to
27 15 U.S.C. Section 1065 and thus provides conclusive evidence of the validity of Scotts’ registered
28 trade dress, of Scotts’ ownership of the trade dress, and of Scotts’ exclusive right to use the

1 registered trade dress in commerce.

2 21. The SHAKE ‘N FEED Marks, the GRO Marks and the MIRACLE-GRO Trade
3 Dress are hereinafter collectively referred to as the “Scotts Marks and Trade Dress.”

4 22. The distinctiveness of the Scotts Marks and Trade Dress is buttressed by their
5 widespread secondary meaning in the marketplace. Over many decades, Scotts expended and
6 continues to expend substantial time, money and effort in advertising and promoting the Scotts
7 Marks and Trade Dress to identify Scotts as the source of its goods and services, such as in
8 newspapers, magazines, sponsorships, and through nationally broadcast television and radio
9 commercials.

10 23. In addition, the Scotts Marks and Trade Dress have been prominently featured on
11 Scotts’ popular website <www.scotts.com> as well as other websites. Over the years, the Scotts
12 Marks and Trade Dress as well as the products associated therewith have received significant
13 amounts of unsolicited press and have been the subject of numerous articles in major
14 publications. In addition, the strength of the Scotts Marks and Trade Dress is enhanced by Scotts’
15 vigilant and successful policing efforts of these marks.

16 24. As a result of Scotts’ tremendous success, extensive sales, and widespread
17 marketing and advertising efforts, the Scotts Marks and Trade Dress have all become well-known
18 among the general consuming public as identifying the high-quality products offered exclusively
19 by Scotts.

20 **B. Defendant’s Wrongful Acts**

21 25. Scotts is informed and believes based on its investigation to date, that Defendant
22 uses the mark SHAKE-N-GROW (the “Infringing Mark”) in connection with the promotion and
23 sale of a plant food product (the “Infringing Product”). Defendant also uses a predominantly
24 green and yellow trade dress (the “Infringing Trade Dress”) in connection with the Infringing
25 Product which is highly reminiscent of the MIRACLE-GRO Trade Dress and the green and
26 yellow color combination protected by Scotts’ Registration No. 2,139,929. A true and correct
27 representation of Defendant’s Infringing Product compared to Plaintiffs’ MIRACLE-GRO®
28 SHAKE ‘N FEED product featuring the MIRACLE-GRO Trade Dress is attached as Exhibit E.

1 26. On information and belief based on Plaintiffs' investigation to date, Defendant
2 began using the Infringing Mark and Infringing Trade Dress long after Scotts' use of its famous
3 and distinctive Scotts Marks and Trade Dress and long after the Scotts Marks and Trade Dress
4 became famous.

5 27. On information and belief based on Plaintiffs' investigation to date, Defendant
6 owns, operates and/or controls the websites located at <www.shakengrow.com>,
7 <www.shakeandgrow.com>, and <www.gailshiddencreations.com> (the "SHAKE-N-GROW
8 Websites"), which Defendant uses for advertising, promotion and sale of the Infringing Product.
9 The <www.shakengrow.com> domain name wholly incorporates the Infringing Mark. On
10 information and belief, Defendant registered or caused to be registered the
11 <www.shakengrow.com> domain name with constructive and actual notice of the SHAKE 'N
12 FEED and GRO Marks.

13 28. On or about July 29, 2008, Defendant filed an application for federal registration
14 of the SHAKE-N-GROW mark with the USPTO as shown in Application Serial No. 77/520,947.
15 A true and correct copy of the application record for Application Serial No. 77/520,947 from the
16 USPTO's online database is attached as Exhibit F.

17 29. Upon learning of Defendant's Infringing Mark and application, on or about May
18 13, 2009, counsel for Scotts sent a cease-and-desist letter to Defendant setting forth Scotts'
19 federally registered trademark rights and requesting that Defendant cease use of the Infringing
20 Mark and Infringing Trade Dress. After receiving no response, on or about June 15, 2009, Scotts
21 filed Opposition No. 91190654 against the SHAKE-N-GROW application with the USPTO
22 Trademark Trial & Appeal Board.

23 30. Despite notice of Scotts' rights and continued protests from Scotts including
24 Opposition No. 91190654, Defendant continues to advertise, promote and offer for sale the
25 Infringing Product. Defendant's use of the Infringing Mark and Infringing Trade Dress is likely
26 to cause confusion, mistake, or deception in the marketplace as to the source or origin of
27 Defendant's goods and/or falsely suggest a sponsorship, connection, license or association
28 between Defendant and Plaintiffs.

1 an intent to injure Scotts and to deceive the public.

2 37. Defendant's acts have been and are being committed with the intent and purpose
3 of appropriating and trading upon the goodwill and reputation associated with the SHAKE 'N
4 FEED and GRO Marks. Such acts have damaged that part of Scotts' goodwill symbolized by its
5 famous SHAKE 'N FEED and GRO Marks, to Scotts' immediate and irreparable harm.

6 38. Defendant's unauthorized use of Infringing Mark, which is confusingly similar to
7 the SHAKE 'N FEED and GRO Marks, constitutes trademark infringement in violation of 15
8 U.S.C. § 1114.

9 39. As a direct and proximate result of Defendant's wrongful acts, Scotts has suffered
10 and/or is likely to suffer damage to its business reputation and goodwill. Unless restrained,
11 Defendant will continue to use the Infringing Mark, causing irreparable harm to Scotts. Scotts
12 has no adequate remedy at law. Scotts is entitled to an injunction restraining Defendant, its
13 agents and employees, and all persons acting in concert with Defendant from engaging in further
14 acts of infringement pursuant to 15 U.S.C. § 1116.

15 40. Scotts is further entitled to recover from Defendant the gains, profits and
16 advantages that Defendant has obtained as a result of its wrongful acts. Scotts is presently unable
17 to ascertain the full extent of the gains, profits and advantages that Defendant has realized by
18 reason of its wrongful acts.

19 41. The acts alleged herein constitute an exceptional case under 15 U.S.C. § 1117(a).

20 42. Scotts is further entitled to recover from Defendant up to three times the amount of
21 Plaintiffs' actual damages sustained and/or likely to be sustained by Scotts as a result of
22 Defendant's wrongful acts. Scotts is presently unable to ascertain the full extent of monetary
23 damages that it has suffered and/or is likely to suffer by reason of Defendant's wrongful acts.

24 **SECOND CLAIM FOR RELIEF**

25 (Willful Infringement of Federally Registered Trade Dress)

26 [15 U.S.C. § 1114]

27 43. Scotts repeats and realleges paragraphs 1 through 42 of this complaint as if fully
28 set forth herein.

44. Scotts owns Registration No. 2,139,929 for the green and yellow color scheme as

1 featured in the MIRACLE-GRO Trade Dress.

2 45. The MIRACLE-GRO Trade Dress is non-functional, inherently distinctive and has
3 acquired secondary meaning.

4 46. Defendant has infringed and will continue to infringe Scotts' MIRACLE-GRO
5 Trade Dress by copying and incorporating elements of that trade dress into the trade dress for its
6 Infringing Product.

7 47. Defendant's production, marketing and sale of the Infringing Product using the
8 trade dress embodied therein creates a likelihood of confusion, mistake or deception as to the
9 affiliation, connection or association of Defendant with Plaintiffs, or as to the origin, sponsorship
10 or approval of Defendant's goods by Plaintiffs. Defendant's conduct is likely to induce
11 consumers to believe, contrary to fact, that the goods of Defendant are rendered, sponsored, sold,
12 approved by or connected with Plaintiffs.

13 48. Defendant's activities are without Scotts' permission or authority. Scotts has
14 specifically demanded that Defendant cease and desist using the Infringing Trade Dress, which
15 Defendant continues to use despite actual knowledge of Scotts' rights. As a result, Defendant has
16 committed infringement with full knowledge of Scotts' rights in the MIRACLE-GRO Trade
17 Dress. Defendant has willfully, deliberately and maliciously engaged in the described acts with
18 an intent to injure Scotts and to deceive the public.

19 49. Defendant's acts have been and are being committed with the intent and purpose
20 of appropriating and trading upon the goodwill and reputation associated with the MIRACLE-
21 GRO Trade Dress. Such acts have damaged that part of Scotts' goodwill symbolized by its
22 famous MIRACLE-GRO Trade Dress, to Scotts' immediate and irreparable harm.

23 50. Defendant's unauthorized use of the Infringing Trade Dress, which is confusingly
24 similar to the MIRACLE-GRO Trade Dress, constitutes trade dress infringement in violation of
25 15 U.S.C. § 1125(a).

26 51. As a direct and proximate result of Defendant's wrongful acts, Scotts has suffered
27 and/or is likely to suffer damage to its business reputation and goodwill. Unless restrained,
28 Defendant will continue to use the Infringing Trade Dress, causing irreparable harm to Scotts.

1 Scotts has no adequate remedy at law. Scotts is entitled to an injunction restraining Defendant, its
2 agents and employees, and all persons acting in concert with Defendant from engaging in further
3 acts of infringement pursuant to 15 U.S.C. § 1116.

4 52. Scotts is further entitled to recover from Defendant the gains, profits and
5 advantages that Defendant has obtained as a result of its wrongful acts. Scotts is presently unable
6 to ascertain the full extent of the gains, profits and advantages that Defendant has realized by
7 reason of its wrongful acts.

8 53. This case constitutes an exceptional case under 15 U.S.C. § 1117(a).

9 54. Scotts is further entitled to recover from Defendant up to three times the amount of
10 Plaintiffs' actual damages sustained and/or likely to be sustained by Scotts as a result of
11 Defendant's wrongful acts. Scotts is presently unable to ascertain the full extent of monetary
12 damages that it has suffered and/or is likely to suffer by reason of Defendant's wrongful acts.

13 **THIRD CLAIM FOR RELIEF**

14 (False Designation of Origin and Unfair Competition)
[15 U.S.C. § 1125(a)(1)]

15 55. Scotts repeats and realleges paragraphs 1 through 54 of this complaint as if fully
16 set forth herein.

17 56. Defendant's activities alleged herein constitute use in commerce of certain words,
18 names and false designations of origin in connection with the sale or advertising of unauthorized
19 goods, which create a likelihood of confusion, mistake or deception as to the affiliation,
20 connection or association of Defendant with Scotts, or as to the origin, sponsorship or approval of
21 Defendant's goods with those of Scotts. Defendant's conduct is likely to induce consumers to
22 believe, contrary to fact, that the goods of Defendant are rendered, sponsored, sold, approved by
23 or connected with Scotts.

24 57. Defendant's activities are without Scotts' permission or authority. In fact, Scotts
25 has demanded that Defendant cease and desist using the Infringing Mark, but Defendant has
26 continued such use following Scotts' demand to them. As a result, Defendant has committed the
27 foregoing acts with full knowledge of Scotts' rights in the SHAKE 'N FEED and GRO Marks.
28 Thus, Defendant has willfully, deliberately and maliciously engaged in these acts with the intent

1 to compete unfairly with Scotts.

2 58. Defendant's unauthorized use of the Infringing Mark, which is confusingly similar
3 to the SHAKE 'N FEED and GRO Marks, constitutes false designation of origin and unfair
4 competition in violation of 15 U.S.C. Section 1125(a).

5 59. As a direct and proximate result of Defendant's wrongful acts, Scotts has suffered
6 and/or is likely to suffer damage to its business reputation and goodwill. Unless restrained,
7 Defendant will continue to use the Infringing Mark, causing irreparable harm to Scotts. Scotts
8 has no adequate remedy at law. Scotts is entitled to an injunction restraining Defendant, its
9 agents and employees, and all persons acting in concert with Defendant from engaging in further
10 acts of unfair competition.

11 60. Scotts is further entitled to recover from Defendant the gains, profits and
12 advantages that Defendant has obtained as a result of its wrongful acts. Scotts is presently unable
13 to ascertain the full extent of the gains, profits and advantages that Defendant has realized by
14 reason of its wrongful acts.

15 61. The acts alleged herein constitute an exceptional case under 15 U.S.C. §1117(a).

16 62. Scotts is further entitled to recover from Defendant up to three times the amount of
17 Plaintiffs' actual damages sustained and/or likely to be sustained by Plaintiffs as a result of
18 Defendant's wrongful acts. Scotts is presently unable to ascertain the full extent of monetary
19 damages that it has suffered and/or is likely to suffer by reason of Defendant's wrongful acts.

20 **FOURTH CLAIM FOR RELIEF**
21 (Trademark and Trade Dress Dilution)
[15 U.S.C. § 1125(c)]

22 63. Scotts repeats and realleges paragraphs 1 through 62 of this complaint as if fully
23 set forth herein.

24 64. Scotts is the owner of the Scotts Marks and Trade Dress which are distinctive and
25 famous as defined by Section 43(c) of the Lanham Act, 15 U.S.C. § 1125(c). The Scotts Marks
26 and Trade Dress have developed secondary meaning in the public's mind, in that the general
27 consuming public has come to know and recognize the Scotts Marks and Trade Dress as
28 identifying the products exclusively provided by Plaintiffs, as distinguished from competitors of

1 Plaintiffs. The Scotts Marks and Trade Dress have become known by the public as indicative of
2 the uniform high quality of goods provided by Plaintiffs and have developed and acquired
3 outstanding celebrity symbolizing goodwill of great value that Plaintiffs has created.

4 65. Defendants have made unauthorized use in commerce of colorable imitations of
5 the Scotts Marks and Trade Dress with the intent to trade on the goodwill associated with the
6 Scotts Marks and Trade Dress, to injure Scotts' reputation and to cause dilution or impairment of
7 the Scotts Marks and Trade Dress. Defendant's acts commenced and were committed well-after
8 the Scotts Marks and Trade Dress became famous and had acquired secondary meaning.

9 66. Defendant's use of the confusingly similar Infringing Mark and confusingly
10 similar Infringing Trade Dress is likely to cause dilution by blurring and dilution by tarnishment
11 of the value of the Scotts Marks and Trade Dress and constitutes violations of 15 U.S.C. Section
12 1125(c).

13 67. As a direct and proximate result of Defendant's willful and wrongful acts, Scotts
14 has suffered and/or is likely to suffer damage to its business reputation and goodwill. Unless
15 restrained, Defendant will continue to use the Infringing Mark and Infringing Trade Dress,
16 causing irreparable harm to Scotts for which there is no adequate remedy at law. Scotts is entitled
17 to an injunction restraining Defendant, its agents and employees, and all persons acting in concert
18 with Defendant from engaging in further acts of dilution.

19 68. Scotts is further entitled to recover from Defendant the gains, profits and
20 advantages that Defendant has obtained as a result of its wrongful acts. Scotts is presently unable
21 to ascertain the full extent of the gains, profits and advantages that Defendant has realized by
22 reason of its wrongful acts.

23 69. The acts alleged herein constitute an exceptional case under 15 U.S.C. § 1117(a).

24 70. Scotts is further entitled to recover from Defendant Scotts' actual damages
25 sustained and/or likely to be sustained as a result of Defendant's wrongful acts. Scotts is
26 presently unable to ascertain the full extent of monetary damages that it has suffered and/or is
27 likely to suffer by reason of Defendant's wrongful acts.

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FIFTH CLAIM FOR RELIEF

(Violation of the Anti-Cybersquatting Consumer Protection Act)
[15 U.S.C. § 1125(d)]

71. Scotts repeats and realleges paragraphs 1 through 70 of this complaint as if fully set forth herein.

72. 15 U.S.C. Section 1125(d) provides in pertinent part that “[a] person shall be liable in a civil action by the owner of a mark . . . if without regard to the goods or services of the parties, that person – (i) has a bad faith intent to profit from that mark . . . , and (ii) registers, traffics in, or uses a domain name that – (I) in the case of a mark that is distinctive at the time of registration of the domain name, is identical or confusingly similar to that mark; [or] (II) in the case of a famous mark that is famous at the time of registration of the domain name, is identical or confusingly similar to or dilutive of that mark . . .”

73. The <www.shakengrow.com> domain name is confusingly similar to and dilutive of the SHAKE ‘N FEED Marks and GRO Marks.

74. At the time Defendant registered or caused to be registered the <www.shakengrow.com> domain name, the SHAKE ‘N FEED Marks and GRO Marks were distinctive and famous.

75. By registering or causing to be registered the <www.shakengrow.com> domain name, and by using such domain name for the promotion, display and sale of the Infringing Product which directly competes with Scotts’ products, Defendant has demonstrated a bad faith intent to profit from the SHAKE ‘N FEED Marks and GRO Marks and an intent to divert consumers away from Scotts.

76. Defendant’s acts in registering and using the <www.shakengrow.com> domain name constitute cybersquatting pursuant to 15 U.S.C. § 1125(d).

SIXTH CLAIM FOR RELIEF

(State and Common Law Trademark Infringement)
[Cal. Bus. & Prof. Code § 14335 *et seq.*]

77. Scotts repeats and realleges paragraphs 1 through 76 of this complaint as if fully set forth herein.

78. Defendant’s activities constitute willful trademark infringement or at a minimum

1 trademark infringement of Scotts' federally registered marks. Defendant's activities are without
2 Scotts' permission or authority and constitute trademark infringement under the statutory law of
3 California, including California Business & Professions Code Section 14335 *et seq.*, and under
4 the common law of the State of California.

5 79. As a direct and proximate result of Defendant's wrongful acts, Scotts has suffered
6 and/or is likely to suffer damage to its business reputation and goodwill. Unless restrained,
7 Defendant will continue to use the Infringing Mark, causing irreparable harm to Scotts. Scotts
8 has no adequate remedy at law. Scotts is entitled to an injunction restraining Defendant, its
9 agents and employees, and all persons acting in concert with Defendant from engaging in further
10 acts of infringement.

11 80. Scotts is further entitled to recover from Defendant the gains, profits and
12 advantages that Defendant has obtained as a result of its wrongful acts. Scotts is presently unable
13 to ascertain the full extent of the gains, profits and advantages that Defendant has realized by
14 reason of its wrongful acts.

15 81. Scotts is further entitled to recover from Defendant the actual damages sustained
16 and/or likely to be sustained by Scotts as a result of Defendant's wrongful acts. Scotts is
17 presently unable to ascertain the full extent of monetary damages that it has suffered and/or is
18 likely to suffer by reason of Defendant's wrongful acts.

19 **SEVENTH CLAIM FOR RELIEF**

20 (California Unfair Competition)

[Cal. Bus. & Prof. Code § 14200 *et seq.*]

21 82. Scotts repeats and realleges paragraphs 1 through 81 of this complaint as if fully
22 set forth herein.

23 83. Defendant's actions constitute unfair competition under the statutory law of
24 California including California Business and Professions Code Section 17200 *et seq.* and under
25 the common law of the State of California.

26 84. As a direct and proximate result of Defendant's wrongful acts, Scotts has suffered
27 and/or is likely to suffer damage to its business reputation and goodwill. Defendant will continue,
28 unless restrained, to use the Infringing Mark and Infringing Trade Dress causing irreparable harm

1 to Scotts. Scotts has no adequate remedy at law. Scotts is entitled to an injunction restraining
2 Defendant, its agents and employees, and all persons acting in concert with Defendant from
3 engaging in further acts of unfair competition.

4 85. Because of the willful nature of Defendant's wrongful acts, Scotts is also entitled
5 to an award of punitive damages.

6 **EIGHTH CLAIM FOR RELIEF**

7 (California Injury to Business Reputation or Dilution)
8 [Cal. Bus. & Prof. Code § 14330]

9 86. Scotts repeats and realleges paragraphs 1 through 85 of this complaint as if fully
10 set forth herein.

11 87. The use by Defendant of the Infringing Mark and Infringing Trade Dress in
12 California dilutes and/or is likely to dilute the distinctive quality of the Scotts Marks and Trade
13 Dress, reduces and/or is likely to reduce the value of Scotts' goodwill, and injures and/or is likely
14 to injure the exclusive association by the public of the Scotts Marks and Trade Dress with Scotts.
15 The acts of Defendant therefore constitute injury to business reputation and dilution of the
16 distinctive quality of the Scotts Marks and Trade Dress within the meaning of California Business
& Professions Code Section 14330.

17 88. As a direct and proximate result of Defendant's wrongful acts, Scotts has suffered
18 and/or is likely to suffer dilution of its trademarks and trade dress and damage to its business
19 reputation and goodwill. Unless restrained, Defendant will continue to use the Infringing Mark
20 and Infringing Trade Dress, causing irreparable harm to Scotts. Scotts has no adequate remedy at
21 law. Scotts is entitled to an injunction restraining Defendant, its agents and employees, and all
22 persons acting in concert with Defendant from engaging in further acts of injury to business
23 reputation and dilution.

24 **PRAYER FOR RELIEF**

25 WHEREFORE, Scotts prays that this Court enter judgment against Defendant as follows:

26 1. Finding that Defendant has infringed the Scotts Marks and Trade Dress under 15
27 U.S.C. § 1114, Cal. Bus. & Prof. Code § 14335, and the common law; has violated 15 U.S.C. §
28

1 1125(a); has engaged in acts of unfair competition under Cal. Bus. & Prof. Code § 14200 *et seq.*
2 and the common law; and has diluted the distinctive quality of the Scotts Marks and Trade Dress
3 under 15 U.S.C. § 1125 (c) and Cal. Bus. & Prof. Code § 14330;

4 2. Ordering that Defendant and its agents, affiliates, servants, employees, partners,
5 representatives and all persons in active concert or participation with Defendant or with any of the
6 foregoing, be enjoined preliminarily during the pendency of this action and permanently
7 thereafter from:

8 A. directly or indirectly using the Infringing Mark and Infringing Trade Dress
9 or any other reproduction, counterfeit, copy or colorable imitation of the SHAKE ‘N FEED
10 Marks, GRO Marks or MIRACLE-GRO Trade Dress to identify any good or to render any
11 service not authorized by Scotts;

12 B. manufacturing, producing, distributing, circulating, selling, marketing,
13 offering for sale, advertising, promoting, displaying or otherwise disposing of any products not
14 authorized by Scotts bearing the Infringing Mark or Infringing Trade Dress or any other
15 reproduction, counterfeit, copy or colorable imitation of the SHAKE ‘N FEED Marks, GRO
16 Marks or MIRACLE-GRO Trade Dress;

17 C. engaging in any course of conduct likely to cause confusion, deception or
18 mistake, weaken the distinctive quality of the SHAKE ‘N FEED Marks, GRO Marks or
19 MIRACLE-GRO Trade Dress, or injure Scotts’ business reputation or goodwill;

20 D. using or continuing to use the Infringing Mark or Infringing Trade Dress or
21 any other reproduction, counterfeit, copy or colorable imitation of the SHAKE ‘N FEED Marks,
22 GRO Marks on the Internet in any manner in connection with any goods or services not
23 authorized by Scotts; and
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1 E. applying to register the Infringing Mark or any other reproduction,
2 counterfeit, copy or colorable imitation of the SHAKE 'N FEED Marks or GRO Marks as a mark,
3 business name, domain name, keyword or other designation with any governmental authority
4 (including the USPTO) or Internet registry.

5
6 3. Ordering that Defendant abandon United States Trademark Application No.
7 77/520,947 for the mark SHAKE-N-GROW;

8 4. Ordering Defendant to account to Scotts for any and all profits derived by
9 Defendant from the use of Infringing Mark and Infringing Trade Dress and for all damages
10 sustained by Scotts by reason of Defendant's acts of infringement, unfair competition, and injury
11 to business reputation complained of in this Complaint, and that such amounts be held in
12 constructive trust for Scotts;

13
14 5. Ordering that Defendant be required to deliver to Scotts for destruction all
15 infringing materials, including, without limitation, all Infringing Products, catalogs, promotional
16 materials, labels, signs, business cards, stationery, packaging, wrappers, promotional materials,
17 brochures, manuals, and advertisements bearing the Infringing Mark, the Infringing Trade Dress
18 or any reproduction, counterfeit, copy or colorable imitation thereof, and all plates, molds,
19 matrices and other means of making the same, pursuant to 15 U.S.C. § 1118;

20
21 6. Ordering Defendant to file with this Court and serve upon Scotts within 30 days
22 after service on the Defendant of any injunction, a report in writing under oath setting forth in
23 detail the manner and form in which Defendant has complied with such injunction pursuant to 15
24 U.S.C. § 1116;

25 7. Ordering the transfer of the <www.shakengrow.com> domain name to Scotts;

26 8. Awarding Scotts:

27 A. All profits derived by Defendant's wrongful acts complained of herein;
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- B. All damages sustained by reason of the wrongful acts complained of herein, including those available under 15 U.S.C. § 117;
- C. Treble the amount of Defendant’s profits or actual damages suffered by Scotts under 15 U.S.C. § 1117;
- D. Punitive and exemplary damages against Defendant and in favor of Scotts in an amount sufficient to deter and punish Defendant for its willful and wrongful acts;
- E. Scotts’ costs of incurred in this action;
- F. Reasonable attorneys’ fees pursuant to 15 U.S.C. § 1117(a) and/or state law, or on equitable grounds;
- G. Pre-judgment and post-judgment interest; and
- H. Such other and further relief, in law or in equity, as this Court deems just and proper.

Dated: April 28, 2010

MANATT, PHELPS & PHILLIPS, LLP
Susan E. Hollander
Shannon S. King

By: /s/ Shannon S. King
Shannon S. King

Attorneys for Plaintiffs
OMS INVESTMENTS, INC. AND
THE SCOTTS COMPANY LLC

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DEMAND FOR JURY TRIAL

OMS Investments, Inc. and The Scotts Company LLC hereby demands a jury trial for all issues triable by jury.

Dated: April 28, 2010

MANATT, PHELPS & PHILLIPS, LLP
Susan E. Hollander
Shannon S. King

By: /s/ Shannon S. King
Shannon S. King

Attorneys for Plaintiffs
OMS INVESTMENTS, INC. AND
THE SCOTTS COMPANY LLC

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CIVIL

**U.S. District Court
Eastern District of California - Live System (Sacramento)
CIVIL DOCKET FOR CASE #: 2:10-cv-01037-GEB-EFB**

OMS Investments, Inc. et al v. Smith
Assigned to: Judge Garland E. Burrell, Jr
Referred to: Magistrate Judge Edmund F. Brennan
Cause: 15:1114 Trademark Infringement

Date Filed: 04/28/2010
Jury Demand: Plaintiff
Nature of Suit: 840 Trademark
Jurisdiction: Federal Question

Plaintiff**OMS Investments, Inc.**

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Plaintiff**The Scotts Company LLC**

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ATTORNEY TO BE NOTICED

Shannon Scott King
(See above for address)
ATTORNEY TO BE NOTICED

V.

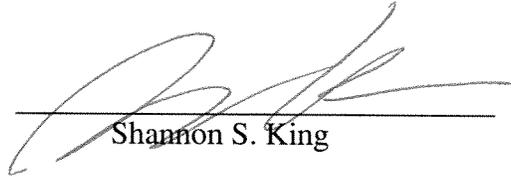
Defendant**Gail E. Smith**

Doing business as
Hidden Creations

Date Filed	#	Docket Text
04/28/2010	1	CIVIL COVER SHEET by OMS Investments, Inc., The Scotts Company LLC (King, Shannon) (Entered: 04/28/2010)
04/28/2010	2	COMPLAINT for Trademark Infringement, Trade Dress Infringement, False Designation of Origin, Federal Trademark Dilution, and Federal and State Unfair Competition; Demand for Jury Trial against Gail E. Smith by OMS Investments, Inc., The Scotts Company LLC. (Attachments: # 1 Exhibit A, # 2 Exhibit B, # 3 Exhibit C, # 4 Exhibit D, # 5 Exhibit E, # 6 Exhibit F)(King, Shannon) Modified on 4/28/2010 (Carlos, K). (Entered: 04/28/2010)
04/28/2010	3	STATEMENT of Corporate Disclosure by Plaintiffs OMS Investments, Inc., The Scotts Company LLC. (King, Shannon) (Entered: 04/28/2010)
04/28/2010		RECEIPT number #CAE200025800 \$350.00 fbo Edith Gould by Edith Gould on 4/28/2010. (Carlos, K) (Entered: 04/28/2010)
04/28/2010	5	SUMMONS ISSUED as to *The Scotts Company LLC, Gail E. Smith* with answer to complaint due within *21* days. Attorney *Shannon Scott King* *Manatt Phelps & Phillips LLP* *One Embarcadero Ctr., 30th Floor* *San Francisco, CA 94111*. (Carlos, K) (Entered: 04/28/2010)
04/28/2010	6	CIVIL NEW CASE DOCUMENTS ISSUED; Initial Scheduling Conference set for 8/9/2010 at 09:00 AM in Courtroom 10 (GEB) before Judge Garland E. Burrell Jr.. (Attachments: # 1 Consent Form, # 2 VDRP Form) (Carlos, K) (Entered: 04/28/2010)
04/28/2010	7	SUMMONS ISSUED as to *Gail E. Smith* with answer to complaint due within *21* days. Attorney *Shannon Scott King* *Manatt Phelps & Phillips LLP* *One Embarcadero Ctr., 30th Floor* *San Francisco, CA 94111*. (Carlos, K) (Entered: 04/28/2010)

CERTIFICATE OF SERVICE

I hereby certify that a true and correct copy of the foregoing Opposer's Motion to Suspend Opposition Proceeding has been properly served, via email addressed to gailhiddencreations@comcast.net and hiddencreations@comcast.net on this 30th day of April, 2010.


Shannon S. King

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