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

Proceeding	92055064
Party	Defendant Moroccanoil, Inc.
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Submission	Motion to Suspend for Civil Action
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1 IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
2 BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

3
4 Y.P. GOLAN TRADE LTD.

5 Petitioner,

6 v.

7 MOROCCANOIL, INC.

8 Respondent.

Registration Nos. 3,478,807; 3,684,909;
3,684,910

Marks: MOROCCANOIL & M
MOROCCANOIL

Proceeding No. 92055064

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10 **MOTION TO SUSPEND**

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12 Pursuant to 37 CFR § 2.117(a) and TBMP § 510.02(a), Respondent Moroccanil,
13 Inc. (“Moroccanil”) hereby requests that the Trademark Trial and Appeal Board (the
14 “TTAB” or the “Board”) suspend this proceeding (“Instant Proceeding”) until the final
15 determination of Moroccanil v. Yair Golan, et. al., Central District of California case
16 number CV11-01974SJO (JEMx) (“Golan Action”) and Moroccanil v. Vogue
17 International, Central District of California case number CV10-10048DMG (AGRx)
18 (“Vogue Action” collectively the “Civil Actions”), because the Civil Actions will have
19 a direct bearing on the instant Petition.

20
21 **I. FACTUAL BACKGROUND**

22 **A. MOROCCANOIL**

23 Since about January 2007, Moroccanil has distributed a line of professional,
24 “salon only” hair care products under the brand name and trademark
25 “MOROCCANOIL.” All of the Moroccanil Products bear one or more registered
26 trademarks, including: the word “MOROCCANOIL”(U.S. Reg. No. 3,478,807), the
27 vertical “M Moroccanil Design” (U.S. Reg. No. 3,684,910), and the horizontal “M
28 Moroccanil Design” (U.S. Reg. No. 3,684,909) (collectively, the “Moroccanil

1 Trademarks.”) A picture of MoroccanOil Oil Treatment, MoroccanOil’s best selling
2 product, is shown below:



19 **B. Y. P. GOLAN TRADE, LTD.**

20 Petitioner Y.P. Golan Trade, Ltd. (“YPGT”) is an Israeli business entity with a
21 principal place of business in Israel. The President of YPGT is Yair Golan (“Golan”).
22 Golan has applied for registration of a trademark in the United States, application
23 number 85023269, for the “Royal Moroccan” mark. Golan alleges that it has assigned
24 this application to YPGT, who uses the mark to sell an imitation line of MoroccanOil
25 products under the Royal Moroccan mark. A picture of the Royal Moroccan Oil
26 Treatment product is shown below:

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The unmistakable similarities between the Moroccanoil products and the knock-off Royal Moroccan products cannot be overlooked. The obvious copying of the Moroccanoil Trademarks, the label color, and the bottle design demonstrates that YPGT and Golan are seeking to illegally profit off of Moroccanoil’s tremendous goodwill. In fact, beyond simply copying the design, look and trademarks of the Moroccanoil products, Golan has made illegal and surreptitious attempts to copy the trade secret formulas for Moroccanoil Products. These attempts have included demanding, through black mail, the trade secret formula of the Moroccanoil Oil Treatment product from an employee of Moroccanoil Israel, Ltd., the manufacturer of the goods sold by Moroccanoil.

C. LEGAL PROCEEDINGS

On December 12, 2009, Respondent filed the Vogue Action in the District Court for the Central District of California. A Second Amended Complaint was subsequently filed on June 2, 2011 and alleges generally claims for trademark infringement and unfair competition. A copy of the Second Amended Complaint is attached hereto as Exhibit 1. The defendant in the Vogue Action, who is not a party to the Instant

1 Proceeding, has filed an Answer and Counterclaims asserting that Moroccanoil's
2 Trademarks are descriptive, geographically descriptive, geographically misdescriptive
3 and fraud in the procurement. The Counterclaims in the Vogue Action are identical to
4 the claims asserted in the Instant Proceeding. A copy of the Answer and Counterclaims
5 is attached hereto as Exhibit 2. Respondent has been actively litigating the Vogue
6 Action and expects to go to trial on November 6, 2012.

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8 On March 8, 2011, Respondent filed the Golan Action in the District Court for
9 the Central District of California. A First Amended Complaint was subsequently filed
10 on January 26, 2012 which asserts claims for declaratory relief, trademark infringement
11 pursuant to 15 U.S.C. § 1114, and trademark infringement and unfair competition
12 pursuant to 15 U.S.C. § 1125(a). A copy of the First Amended Complaint is attached
13 hereto as Exhibit 3. Golan filed an answer to the Golan Action on February 13, 2012.
14 In his answer Golan asserts the affirmative defenses of Trademark Invalidity, the
15 fourteenth affirmative defense, and Fraud in the Procurement of the Moroccanoil
16 trademark registrations, the thirteenth affirmative defense. These defenses are identical
17 to the claims asserted in the Instant Proceeding. Golan's answer is attached hereto as
18 Exhibit 4. The parties in the Golan Action have been participating in the discovery
19 process.

20
21 Nearly a year after the Golan Action was filed, YPGT filed the Instant
22 Proceeding which seeks to cancel the Moroccanoil Trademarks by asserting claims that
23 the Moroccanoil Trademarks are generic, descriptive, geographically descriptive,
24 deceptive, geographically misdescriptive and fraudulent procurement. These claims are
25 duplicative of the affirmative defenses asserted in the Golan Action and the
26 Counterclaims asserted in the Vogue Action. The trial period in the instant proceeding
27 is scheduled to conclude in May 2013, no discovery has taken place in this case yet, nor
28 have the parties exchanged initial disclosures.

1 **II. ARGUMENT**

2 **A. THE DETERMINATION OF THE CIVIL ACTIONS WILL HAVE**
3 **A DIRECT BEARING ON THE ISSUES BEFORE THE TTAB**

4 Where a party to a case pending before the Board is also involved in a civil
5 action that may have a bearing on the TTAB matter, the Board may suspend the
6 proceeding until the final determination of the civil action. 37 CFR § 2.117(a); TBMP
7 § 510.02(a). This is because “a decision by the United States District Court would be
8 binding on the Patent Office whereas a determination by the Patent Office as to
9 respondent’s right to retain its registration would not be binding or res judicata in
10 respect to the proceeding before the federal district court.” *Whopper-Burger, Inc. v.*
11 *Burger King Corp.*, 171 U.S.P.Q. 805, 807 (TTAB 1971).

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13 A TTAB proceeding should be suspended where it is clear that a determination
14 by a civil proceeding will directly affect the resolution of the issues before the Board.
15 *See The Other Tel. Co. v. Conn. Nat’l Tel. Co., Inc.*, 181 U.S.P.Q. 125, 126-7 (TTAB
16 1974). Similarly, a TTAB proceeding should also be suspended where the suspension
17 would prevent the unnecessary duplication of discovery, litigation and other efforts.
18 *See The Other Tel. Co. v. Connecticut Nat’l Tel. Co., Inc.*, 181 U.S.P.Q. 125, 126, 1974
19 WL 19878 (Feb. 11, 1974)

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21 In this instance, the two Civil Actions, the Vogue and Golan Actions, may result
22 in determinations that directly affect the resolution of the issues in the Instant
23 Proceeding and which may make the Instant Proceeding moot. First, the Petitioner and
24 Respondent are both parties to the Golan Action, in which Golan has asserted
25 affirmative defenses of trademark invalidity and fraud which encompass all of the
26 claims raised by the Petition in the Instant Proceeding. Should the Court in the Golan
27 Action reach judgment in favor of Golan on the affirmative defenses there may be no
28 need to resolve the issues in the Instant Proceeding. Likewise, a determination of the

1 District Court as to the issues raised by Golan’s affirmative defenses would be binding
2 on the TTAB. If the Instant Proceeding is not suspended, it will lead to an unnecessary
3 waste of resources as efforts are duplicated and could potentially lead to conflicting
4 rulings by each forum on the issues.

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6 Second, the counterclaims raised by the defendant in the Vogue Action, claims
7 seeking to cancel the Moroccanoil Trademarks as descriptive, geographically
8 descriptive, geographically misdescriptive and fraud, are identical to the claims
9 presented in the Instant Proceeding. The Vogue Action is significantly farther along in
10 the litigation process. Indeed, the discovery cut-off is May 18, 2012 and the trial date is
11 scheduled for November 6, 2012. If this proceeding is not suspended, the parties may
12 expend significant sums of money on discovery, motion practice, and other matters
13 only to have the Instant Proceeding made moot by a jury determination in early
14 November 2012, a full five months before the trial period in the Instant Proceeding is
15 scheduled to conclude.

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17 In addition, both the Civil Actions present a better forum to resolve the issues
18 raised by the Instant Proceeding than the forum provided by the TTAB. A
19 determination of the fraud claim would require a showing that Respondent intended to
20 deceive the Trademark Office. As courts have noted “[a]n issue of intent, by its very
21 nature, is one which should generally be resolved by a fact finder that has had the
22 opportunity to see the demeanor of witnesses under direct and cross-examination, to
23 observe firsthand the subtle shifts in tone and behavior that are often decisive in
24 judging the credibility of testimony.” *Look Magazine Enterprises S.A. v. Look, Inc.*,
25 596 F. Supp. 774, 779 (D. Del. 1984).

26
27 Likewise, the claims made in the Instant Proceeding rely heavily on consumer
28 perceptions. The perceptions that must be established include; what if anything a

1 consumer understands the term Moroccanoil to mean; whether consumers associate
2 Morocco with hair care products; whether the association between Morocco and hair
3 care products is material to a consumers' decision to purchase the goods; and whether
4 consumers are misled by the term Moroccanoil. Similar to establishing intent,
5 establishing a consumers' perception or state of mind is best accomplished with live
6 testimony which would enable the trier of fact to better judge the credibility of the
7 witnesses. These issues, and many more, would be more appropriately reviewed by a
8 forum that has the capability to take live testimony.

9

10 Suspending the Instant Proceeding would not cause any prejudice to Petitioner.
11 The Instant Proceeding is relatively new; in fact the parties have not even conducted
12 their discovery conference or exchanged initial disclosures yet. As such, the parties
13 have spent a nominal amount of time and money on the Instant Proceeding. Moreover,
14 even while the Instant Proceeding is suspended, Petitioner will be free to continue
15 litigating the claims asserted in the Instant Proceeding through the Golan Action.

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1 **III. CONCLUSION**

2 Suspending the Instant Proceeding would cause little prejudice or harm and
3 would prevent the unnecessary waste of resources that would result from litigating
4 duplicative claims in disparate forums, particularly since the Instant Proceeding may
5 become moot as a result of a decision in the Civil Actions. Based on the foregoing,
6 Respondent respectfully requests that the Board suspend the Instant Proceeding
7 pending the final determination of the Civil Actions.

8
9 Dated: March 9, 2012

Kevin R. Keegan, member of
CONKLE, KREMER & ENGEL
Professional Law Corporation

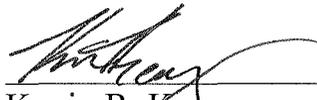
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13 By: 
14 Kevin R. Keegan
15 Attorneys for Respondent, Moroccanoil, Inc.

Exhibit 1

FILED

2011 JUN -2 PM 12:56
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CENTRAL DISTRICT OF CALIF.
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8
9 UNITED STATES DISTRICT COURT
10 CENTRAL DISTRICT OF CALIFORNIA
11

12 MOROCCANOIL, INC., a California
corporation,

13 Plaintiff,

14 v.

15 VOGUE INTERNATIONAL, a
16 fictitiously named company of TODD
CHRISTOPHER INTERNATIONAL,
17 INC., a Florida corporation, and DOES
1 through 10, Inclusive,

18 Defendants.
19

20 TODD CHRISTOPHER
INTERNATIONAL, INC. d/b/a
21 VOGUE INTERNATIONAL, a Florida
Corporation,

22 Counterclaimant,
23

24 v.

25 MOROCCANOIL, INC., a California
Corporation,

26 Counterdefendant.
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CIVIL ACTION NO. CV10 10048
DMG (AGRx)

SECOND AMENDED COMPLAINT
FOR:

1. FEDERAL TRADEMARK
INFRINGEMENT
[15 U.S.C. § 1114]
2. FEDERAL TRADEMARK
INFRINGEMENT AND
UNFAIR COMPETITION
[15 U.S.C. § 1125(a)]
3. STATUTORY UNFAIR
COMPETITION AND
CONSPIRACY TO UNFAIRLY
COMPETE
[B&P CODE §§ 17200 & 17500]
4. COMMON LAW TRADEMARK
INFRINGEMENT, UNFAIR
COMPETITION AND
CONSPIRACY TO UNFAIRLY
COMPETE
5. FEDERAL UNFAIR
COMPETITION
[15 U.S.C. § 1125(a)]
6. DECLARATORY RELIEF FOR
CANCELLATION OF

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TRADEMARK REGISTRATION
NUMBER 3820162 (Deceptive)

7. DECLARATORY RELIEF FOR
CANCELLATION OF
TRADEMARK REGISTRATION
NUMBER 3820162 (Deceptively
Misdescriptive)

DEMAND FOR JURY TRIAL

JURISDICTION AND VENUE

1. This action arises under and this Court has original jurisdiction pursuant to 15 U.S.C. § 1121 (trademarks), 28 U.S.C. § 1331 (federal question), 28 U.S.C. 1332 (diversity), 28 U.S.C. § 1338(a) (trademarks), 28 U.S.C. § 1338 (b) (unfair competition) and supplemental jurisdiction pursuant to 28 U.S.C. § 1367 (related claims).

2. Venue is proper in this District under 28 U.S.C. § 1391(b) (c) because a substantial part of the events giving rise to the claims occurred in this judicial district.

THE PLAINTIFF

3. Moroccanoil, Inc., is a California corporation in good standing with the Secretary of State of California. Its principal place of business is located in the City of Los Angeles, in Los Angeles County. The term "Moroccanoil" as used herein shall include Moroccanoil, Inc., and its predecessors and/or its assignors.

DEFENDANTS

4. On information and belief, Defendant VOGUE INTERNATIONAL, a dba of TODD CHRISTOPHER INTERNATIONAL, INC. ("VOGUE") is a Florida corporation with a principal place of business located at 4027 Tampa Road, Suite 3200, Oldsmar, Florida 34677. VOGUE is in the business of manufacturing and distributing

1 hair care and personal care products. VOGUE markets and sells its products
2 throughout the United States, including in Los Angeles County, California.

3

4 5. On information and belief there are other individuals who make, obtain,
5 distribute, supply and sell products in violation of law, and violate MoroccanOil's rights
6 as alleged herein, but MoroccanOil is ignorant of their true identity or complete role in
7 the alleged conduct and therefore sues them by the fictitious names DOES 1 to 10.
8 MoroccanOil is informed and believes that each of the defendants designated as a Doe is
9 liable in some manner for the acts and omissions, damages and injuries of which
10 MoroccanOil alleges in this Complaint. MoroccanOil will seek to amend this Complaint
11 to state the true identities of Does 1 through 10 when ascertained. VOGUE and the
12 Doe Defendants are referred to collectively herein as "Defendants".

13

14 6. On information and belief there exists, and at all times mentioned there
15 existed, a unity of interests and ownership between individual Defendants and business
16 entity defendants such that any individuality and separateness between the individual
17 and businesses never existed or has ceased to exist, and each Defendant is in each
18 instance the alter ego of the other Defendants who control all such entities. To adhere
19 to the fiction of the Defendant entities as having existence as separate and distinct from
20 the individual Defendants or from those with them and who owned and controlled them
21 would permit an abuse of the corporate and other entity privileges, would sanction
22 fraud, and would promote injustice.

23

24 **ALLEGATIONS COMMON TO ALL CAUSES OF ACTION**

25 **The MoroccanOil Products**

26 7. MoroccanOil distributes in the United States and other countries hair and
27 beauty care products, including but limited to: (a) MoroccanOil Oil Treatment, (b)
28 MoroccanOil Hydrating Styling Cream, (c) MoroccanOil Restorative Hair Mask, (d)

1 Moroccanoil Intense Hydrating Mask, (e) Moroccanoil Intense Curl Cream, (f)
2 Moroccanoil Glimmer Shine Spray, (g) Moroccanoil Moisture Repair Shampoo, (h)
3 Moroccanoil Moisture Repair Conditioner, (i) Moroccanoil Luminous Hair Spray, and
4 (j) Moroccanoil Light Oil Treatment (collectively the “Moroccanoil Products”). All of
5 the Moroccanoil Products contain argan oil which is produced from the nut kernels of
6 the argan tree that grows in countries near the Mediterranean Sea.

7
8 8. Moroccanoil Oil Treatment is packaged in 3.4 fluid ounce (100 ml), amber
9 colored, druggist-style bottles with black screw-on caps. The boxes and labels of
10 Moroccanoil products are turquoise blue. The front labels of the Moroccanoil Oil
11 Treatment Products contain the words “alcohol free” and “for all hair types”. The back
12 labels of the Moroccanoil Oil Treatment Products contain the words “instant
13 absorption”, “instant shine”, “long term conditioning”, “without leaving residue” and
14 “sold exclusively by professional salons”. Moroccanoil Oil Treatment has a unique
15 viscosity, feel and fragrance. Moroccanoil’s trade dress includes the size, shape, color,
16 wording, and overall appearance of the Moroccanoil Products, as well as the packaging
17 and graphics used in their advertising. Moroccanoil’s trade dress includes the word
18 “Moroccanoil” in white, letters arranged vertically on the left side of the front label.
19 Moroccanoil’s trade dress is non-functional, distinctive and has acquired secondary
20 meaning in the marketplace as it has become uniquely associated with Moroccanoil as
21 the source of these products.

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1 9. The following images are true and correct color photographs of a bottle of
2 authentic Moroccanil Oil Treatment:



14 10. All of the Moroccanil Products bear one or more of Moroccanil's
15 trademarks which are federally registered in Class 3 on the principal register of the
16 United States Patent and Trademark Office ("USPTO"), or for which applications for
17 registration in Class 3 on the principal register are pending before the USPTO,
18 including:

19
20 (a) the word "Moroccanil" - USPTO Registration No. 3,478,807, first
21 use in commerce in January 1, 2007;

22
23 (b) "M Moroccanil Design" - with the word Moroccanil in white
24 lettering written vertically with the letter M written horizontally on the right side,
25 USPTO Registration No. 3,684,910, first use in commerce on March 11, 2007; and

1 (c) "M Moroccanoil Design" - with the word Moroccanoil in white
2 lettering horizontally through the letter M, USPTO Registration No. 3,684,909, first use
3 in commerce on March 11, 2007.
4

5 11. The federally registered trademark "Moroccanoil" and the trademarks that
6 are the subject of the foregoing applications for registration of trademarks are referred
7 to collectively herein as the "Moroccanoil Trademarks".
8

9 12. Moroccanoil owns all of the right, title and interest in the United States
10 and in other countries to the Moroccanoil Trademarks and the goodwill associated with
11 them.
12

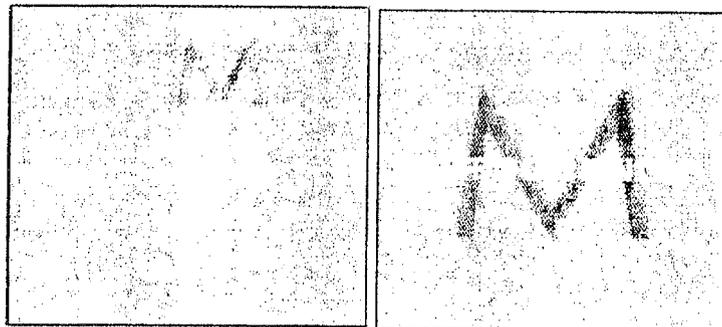
13 13. Since about January 2007, Moroccanoil has continuously used one or more
14 of the Moroccanoil Trademarks in commerce in the United States. Moroccanoil was
15 the first entrant into the market for hair care professional "salons only" products using
16 argan oil and has built goodwill and value in the Moroccanoil Trademarks and Products
17 such that consumers associate "Moroccanoil" exclusively with Plaintiff and its
18 Moroccanoil Products. Moroccanoil Products are high-quality beauty products that are
19 held in high esteem, and used and recommended by top hair stylists and salons in Los
20 Angeles County, and throughout California. The Moroccanoil Trademarks are
21 inherently distinctive and have acquired secondary meaning in the marketplace.
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1 14. The following images are true and correct photographs of other
2 Moroccanoil Trademarks owned by Plaintiffs, which are registered on the Principal
3 Register in the U.S. Patent and Trademark Office:

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6 TRADEMARK
 PRINCIPAL REGISTER

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8 MOROCCANOIL

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11 USPTO Registration No. 3,478,807



19 USPTO Registration No.
20 3,684,910

 USPTO Registration No.
 3,684,909

21
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23 **The Accused Products**

24 15. Moroccanoil recently discovered that Defendants are advertising and
25 selling in the United States professional hair care and beauty care products using the
26 term "Moroccan Argan Oil" in their name and description, without authorization from
27
28

1 Moroccanoil. Defendants' products bearing the trademark "Moroccan Argan Oil" are
2 referred to herein as the "Accused Products".

3

4 16. The Accused Products use the confusingly similar term "Moroccan Argan
5 Oil" prominently on the front, sides and back of the box the product comes in, and on
6 the front label and on the back label of the product itself, it again states prominently in
7 bold script "Moroccan Argan Oil"(the "Infringing Mark"). The Accused Products seek
8 to capitalize on the success of Moroccanoil Oil Treatment, including by being included
9 in the results of Internet searches for "Moroccanoil" or "Moroccan Oil".

10

11 17. The Accused Products also prominently use the trademark "Organix" on
12 the front, sides and back of the box the product comes in, and on the front label and on
13 the back label of the product itself. In addition, the Accused Products described
14 themselves as "organic" and use the word and identifier "organic" on the back label of
15 both the box and product itself.

16

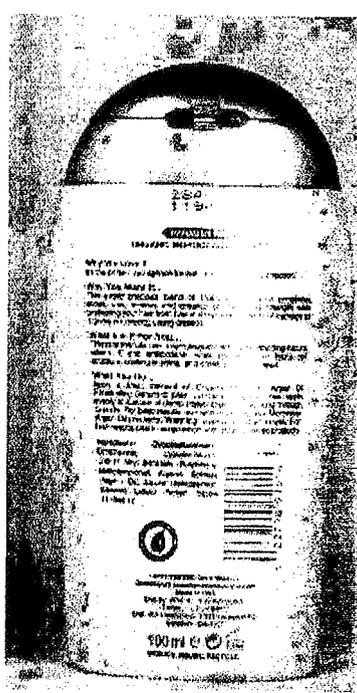
17 18. The Accused Products have a viscosity, feel and fragrance that is similar to
18 that of Moroccanoil Products and Defendants claim that the products contain argan oil.
19 The Accused Products have a similar list of ingredients as the Moroccanoil Products.
20 The Accused Products are sold in rectangular boxes containing 3.4 fluid ounce (100 ml)
21 bottles. The Accused Products use turquoise blue on their product boxes and bottles.
22 The similarity in product names and labeling, trade dress and demonstration show that
23 Defendants willfully copied Plaintiff's trademarks and trade dress.

24

25 19. Defendants describe on the boxes and labels of the Accused Products that
26 the products contain "Moroccan Argan Oil". According to the Defendants' advertising,
27 and the product packaging the Accused Products are intended for sale through retailers,
28 including professional salons.

1 20. On information and belief, retailers often place the Accused Products in
2 close proximity to MoroccanOil Products. MoroccanOil is further informed and
3 believes that Defendants and/or retailers have displayed advertising comparing the
4 Accused Products and MoroccanOil Products and suggesting that the Accused Products
5 are an alternative to MoroccanOil Products.

6
7 21. The following images are true and correct photographs of an Accused
8 Product:



22 **Defendants' Wrongful Activities**

23 22. Defendants are marketing the Accused Products in an intentional attempt
24 to unfairly capitalize on MoroccanOil's Trademarks, and the goodwill and reputation of
25 its Products. Defendants attempt to confuse and deceive hair stylists and consumers
26 into believing the Accused Product is a MoroccanOil Product or is affiliated with
27 MoroccanOil.

1 23. The Accused Product has no affiliation with Moroccanoil. The Accused
2 Product is not covered by Moroccanoil’s warranty, customer service or its product
3 liability coverage.

4
5 24. On information and belief, Defendants have known about Moroccanoil,
6 Moroccanoil Products and the Moroccanoil Trademarks since January 2007, when the
7 Moroccanoil Products bearing the Moroccanoil Trademarks were first used in
8 commerce in the United States.

9
10 25. The product name, trade dress and marketing efforts for the Accused
11 Product has been created and used in such a way to create confusion in the marketplace.
12 On information and belief, the acts of Defendants were willful and were committed
13 with the knowledge that such imitation was intended to be used to cause confusion,
14 mistake or to deceive.

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16 26. On information and belief, the Accused Products contain less than 70%
17 organic material. When products do not contain 70% organic material, any use of the
18 word “organic” on or in connection with them constitutes false and misleading
19 advertising, as that term is statutorily defined and regulated within the meaning of
20 California Health and Safety Code § 110810 et seq. (the “California Organic Products
21 Act”) and 7 U.S.C. § 6501 et seq (the “National Organic Program”). Furthermore, to
22 be “organic” under the statutes, the ingredients must consist of agricultural products
23 which have been grown “organically” without certain proscribed fertilizers and
24 pesticides, and then certified by licensed inspectors as organic. On information and
25 belief, the Accused Products do not contain at least 70% organic content.

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1 **FIRST CLAIM FOR RELIEF**
2 **FOR TRADEMARK INFRINGEMENT**
3 **(AGAINST ALL DEFENDANTS)**

4 27. Moroccanoil alleges and incorporates by reference each and every
5 allegation contained in Paragraphs 1 through 26, as if fully set forth herein.
6

7 28. Moroccanoil owns the federally registered trademark for "Moroccanoil",
8 Registration No. 3,478,807. Defendants have infringed Moroccanoil's federally
9 registered trademark by using "Moroccan Argan Oil" for advertising, distribution and
10 sale of the Accused Products without Moroccanoil's authorization.
11

12 29. Defendants' use of the Infringing Mark and their sale and advertising of
13 the Accused Product have a substantial effect on interstate commerce, and have caused
14 confusion and mistake and are likely to continue to cause confusion and mistake, and to
15 deceive the public into believing that the Infringing Mark and/or the Accused Product
16 originate with, are associated with and/or authorized by Moroccanoil.
17

18 30. On information and belief, Defendants have committed these acts of
19 infringement with the intent to cause confusion and mistake and to deceive the public
20 into believing that the Infringing Marks and/or the Accused Products originate with, are
21 associated with and/or authorized by Moroccanoil.
22

23 31. Defendants' unlawful use of the Infringing Mark, and their sale and
24 advertising of the Accused Product constitute infringement in violation of Section 32(a)
25 of the Lanham Act, 15 U.S.C. § 1114(1).
26

27 32. On information and belief, Defendants, in engaging in the conduct
28 described herein, knowingly, intentionally and willfully intended to trade on the

1 reputation and goodwill of MoroccanOil, the MoroccanOil Trademarks and the
2 MoroccanOil Products, and to cause injury to MoroccanOil. As such, this is an
3 exceptional case within the meaning of 15 U.S.C. § 1117(a) and damages should be
4 trebled and attorneys' fees awarded.

5

6 33. As a direct and proximate result of Defendants' unlawful acts alleged
7 herein, including infringement of the MoroccanOil Trademarks, MoroccanOil has
8 suffered and will continue to suffer injury to its business, goodwill and property.

9

10 34. MoroccanOil is entitled to recover from Defendants the damages it has
11 sustained and will sustain as a result of Defendants' wrongful conduct as alleged herein.
12 MoroccanOil is also entitled to recover from Defendants the gains, profits, and
13 advantages that Defendants have obtained as a result of the wrongful conduct alleged
14 herein. MoroccanOil is presently unable to ascertain the full extent of its damages, or
15 the gains, profits and advantages that Defendants have obtained by reason of their
16 wrongful conduct described herein.

17

18 35. MoroccanOil demands and is entitled to an accounting from each
19 Defendant, including all information necessary to permit MoroccanOil to determine the
20 gains, profits and advantages that Defendants have obtained by reason of their wrongful
21 conduct described herein.

22

23 36. MoroccanOil has no adequate remedy at law. Monetary compensation will
24 not afford MoroccanOil adequate relief. Defendants' acts and omissions as alleged
25 herein will engender the need for a multiplicity of judicial proceedings and will cause
26 damages to MoroccanOil that are difficult, if not impossible, to measure. Unless
27 Defendants are preliminarily and permanently enjoined from committing the unlawful
28 acts alleged including infringement of the MoroccanOil Trademarks, MoroccanOil will

1 continue to suffer irreparable harm. Injunctive relief is therefore appropriate pursuant
2 to 35 U.S.C. § 1116 to prevent Defendants from engaging in any further violations of
3 15 U.S.C. § 1114.

4
5 **SECOND CLAIM FOR RELIEF**
6 **FOR FEDERAL TRADEMARK INFRINGEMENT**
7 **AND UNFAIR COMPETITION**
8 **(AGAINST ALL DEFENDANTS)**

9 37. Moroccanoil alleges and incorporates by reference each and every
10 allegation contained in Paragraphs 1 through 36, as if fully set forth herein.

11
12 38. Defendants' acts, including its acts of false advertising, trade dress
13 infringement, infringement of unregistered trademarks and unfair competition are likely
14 to cause confusion or to cause mistake or to deceive as to the affiliation, connection, or
15 association of the Accused Product with Moroccanoil or as to the origin, sponsorship or
16 approval of the Accused Product by Moroccanoil. Defendants' conduct constitutes
17 infringement of Moroccanoil's unregistered trademarks, unfair competition and such
18 conduct is prohibited by 15 U.S.C. § 1125(a).

19
20 39. As a direct and proximate result of Defendants' unlawful acts as set forth
21 herein, including infringement of the Moroccanoil Trademarks, and Defendants' unfair
22 competition, Moroccanoil has suffered and will continue to suffer injury to its business,
23 goodwill and property.

24
25 40. As a proximate result of Defendants' wrongful conduct, Defendants have
26 been unjustly enriched while Moroccanoil has suffered damages of a nature and in an
27 amount according to proof at trial.

1 41. Moroccanoil is entitled to recover from Defendants the damages it has
2 sustained and will sustain as a result of Defendants' wrongful conduct as alleged herein.
3 Moroccanoil is also entitled to recover from Defendants the gains, profits, and
4 advantages that Defendants have obtained as a result of the wrongful conduct alleged
5 herein. Moroccanoil is presently unable to ascertain the full extent of its damages, or
6 the gains, profits and advantages that Defendants have obtained by reason of their
7 wrongful conduct described herein.

8
9 42. Moroccanoil demands and is entitled to an accounting from each
10 Defendant, including all information necessary to permit Moroccanoil to determine the
11 gains, profits and advantages that Defendants have obtained by reason of their wrongful
12 conduct described herein.

13
14 43. Moroccanoil has no adequate remedy at law. Monetary compensation will
15 not afford Moroccanoil adequate relief. Defendants' acts and omissions as alleged
16 herein will engender the need for a multiplicity of judicial proceedings and will cause
17 damages to Moroccanoil that are difficult, if not impossible, to measure. Unless
18 Defendants are preliminarily and permanently enjoined from committing the unlawful
19 acts alleged, including infringement of the Moroccanoil Trademarks, Moroccanoil will
20 continue to suffer irreparable harm. Injunctive relief is therefore appropriate pursuant
21 to 35 U.S.C. § 1116 to prevent Defendants from engaging in any further violations of
22 15 U.S.C. § 1125(a).

23
24 44. Defendants' acts and omissions as alleged herein were committed
25 knowingly, intentionally and willfully with the intent to trade on Moroccanoil's
26 goodwill in the Moroccanoil Products, the Moroccanoil Trademarks and trade dress.
27 As such, this is an exceptional case within the meaning of 15 U.S.C. § 1117(a) and
28 damages should be trebled and attorneys' fees awarded.

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**THIRD CLAIM FOR RELIEF
FOR STATUTORY UNFAIR COMPETITION
AND CONSPIRACY TO UNFAIRLY COMPETE
(AGAINST ALL DEFENDANTS)**

45. Moroccanoil alleges and incorporates by reference each and every allegation contained in Paragraphs 1 through 44, as if fully set forth herein.

46. Defendants' unfair business practices, acts of infringement, and their misleading advertising practices as herein alleged are in violation of California Business and Professions Code, Section 17200, et seq., and California Business and Professions Code, Section 17500, et seq.

47. Moroccanoil has no adequate remedy at law. Monetary compensation will not afford Moroccanoil adequate relief. Defendants' acts and omissions as alleged herein will engender the need for a multiplicity of judicial proceedings and will cause damages to Moroccanoil that are difficult, if not impossible, to measure. Unless Defendants are preliminarily and permanently enjoined from committing the unlawful acts alleged including unfair competition, Moroccanoil will continue to suffer irreparable harm. Injunctive relief is therefore appropriate under Business & Professions Code Sections 17200 and 17500, et seq. to prevent Defendants from engaging in any further acts of unfair competition.

48. In performing the acts and unfair business practices alleged, Defendants have conspired to engage in, and are engaged in, unlawful and unfair competition in violation of Moroccanoil's rights. Defendants have obtained revenue and profit by their acts of unfair competition and they should be ordered to disgorge all such revenue and profit. Defendants will continue such unfair and fraudulent business practices until restrained.

1 **FOURTH CLAIM FOR RELIEF FOR COMMON LAW**
2 **TRADEMARK INFRINGEMENT AND UNFAIR**
3 **COMPETITION AND CONSPIRACY TO UNFAIRLY COMPETE**
4 **(AGAINST ALL DEFENDANTS)**

5 49. Moroccanoil alleges and incorporates by reference each and every
6 allegation contained in Paragraphs 1 through 48, as if fully set forth herein.

7
8 50. Defendants' actions herein constitute infringement of Moroccanoil's
9 common law rights in the Moroccanoil Trademarks.

10
11 51. In performing the acts and unfair business practices alleged, Defendants
12 have conspired to engage in, and are engaging in, unlawful and unfair competition in
13 violation of Moroccanoil's rights.

14
15 52. On information and belief, Defendants' acts and omissions as alleged
16 herein were committed knowingly, intentionally and willfully with the intent to trade on
17 Moroccanoil's goodwill in the Moroccanoil Products, the Moroccanoil Trademarks and
18 trade dress.

19
20 53. Moroccanoil has no adequate remedy at law. Monetary compensation will
21 not afford Moroccanoil adequate relief. Defendants' acts and omissions as alleged
22 herein will engender the need for a multiplicity of judicial proceedings and will cause
23 damages to Moroccanoil that are difficult, if not impossible, to measure. Unless
24 Defendants are preliminarily and permanently enjoined from committing the unlawful
25 acts alleged including infringement common law trademarks, Moroccanoil will
26 continue to suffer irreparable harm. Injunctive relief is therefore appropriate to prevent
27 Defendants from engaging in any further infringement of common law trademarks or
28 acts of unfair competition.

1 **FIFTH CLAIM FOR RELIEF FEDERAL UNFAIR**
2 **COMPETITION [15 U.S.C. § 1125(a)]**
3 **(AGAINST ALL DEFENDANTS)**

4 54. Moroccanoil alleges and incorporates by reference each and every
5 allegation contained in Paragraphs 1 through 53.

6
7 55. Defendants' use of the terms "organic" and "organix" in connection with
8 the labeling, advertisement, promotion and sale of the Accused Products as well as the
9 false representations that the Accused Products are organic constitutes false advertising
10 and are violations of 15 U.S.C. § 1125 (a)(1)(B).

11
12 56. As a direct and proximate result of Defendants' unlawful acts,
13 Moroccanoil has suffered and will continue to suffer injury to its business, goodwill
14 and property.

15
16 57. As a proximate result of Defendants' wrongful conduct, Defendants have
17 been unjustly enriched while Moroccanoil has suffered damages of a nature and in an
18 amount according to proof at trial.

19
20 58. Moroccanoil demands and is entitled to an accounting from each
21 Defendant, including all information necessary to permit Moroccanoil to determine the
22 gains, profits and advantages that Defendants have obtained by reason of their wrongful
23 conduct described herein.

24
25 59. Moroccanoil has no adequate remedy at law. Monetary compensation will
26 not afford Moroccanoil adequate relief. Defendants' acts and omissions as alleged
27 herein will engender the need for a multiplicity of judicial proceedings and will cause
28 damages to Moroccanoil that are difficult, if not impossible, to measure. Unless

1 Defendants are preliminarily and permanently enjoined from committing the unlawful
2 acts alleged the false advertisement of the terms “organic” and “organix” alone or in
3 combination with other terms, Moroccanoil will continue to suffer irreparable harm.
4 Injunctive relief is therefore appropriate pursuant to 35 U.S.C. § 1116 to prevent
5 Defendants from engaging in any further violations of 15 U.S.C. § 1125(a).

6
7 60. Defendants’ acts and omissions as alleged herein were committed
8 knowingly, intentionally and willfully. As such, this is an exceptional case within the
9 meaning of 15 U.S.C. § 1117(a) and attorneys’ fees should be awarded.

10
11 **SIXTH CLAIM FOR RELIEF**
12 **FOR DECLARATORY RELIEF FOR**
13 **CANCELLATION OF TRADEMARK**
14 **REGISTRATION NUMBER 3,820,162**
15 **(Deceptive)**
16 **(AGAINST VOGUE)**

17 61. Moroccanoil alleges and incorporates by reference each and every
18 allegation contained in Paragraphs 1 through 60.

19
20 62. Vogue is the owner of Federal Trademark Registration No. 3,820,162 for
21 the design mark ORGANIX.

22
23 63. The ORGANIX mark is a term that is deceptive of the character, quality,
24 function, composition, or use of Vogue’s Products in violation of 15 U.S.C. § 1052(a).
25 The ORGANIX mark is used on products which are similar in type to the Moroccanoil
26 Products and Moroccanoil is likely to be damaged by the continued registration of the
27 ORGANIX mark.

28

1 64. On information and belief, prospective purchasers are likely to believe that
2 the deceptive use of the mark ORGANIX actually describes Vogue's Products as being
3 organic in nature. This belief is reinforced by Vogue's use of the term organic on its
4 products. In fact, Vogue's Products are not organic and prospective purchasers are
5 deceived.

6
7 65. On information and belief, the deceptive use of the mark ORGANIX
8 material to consumers in that it is likely to affect consumer's decision to purchase
9 Vogue's Products. Organic products are a highly desirable in hair care products to a
10 certain segment of the purchasing public. The mark ORGANIX gives a false indication
11 of the nature of the Vogue Products to that segment of the purchasing public which may
12 be interested in the organic nature.

13
14 66. Moroccanoil seeks an exercise of the Court's power under 15 U.S.C.A. §
15 1119, to order the Commissioner of Patents and Trademarks to cancel the registration
16 of Vogue's U.S. Trademark Registration No. 3,820,162.

17
18 **SEVENTH CLAIM FOR RELIEF**
19 **FOR DECLARATORY RELIEF FOR**
20 **CANCELLATION OF TRADEMARK**
21 **REGISTRATION NUMBER 3,820,162**
22 **(Deceptively Misdescriptive)**
23 **(AGAINST VOGUE)**

24 67. Moroccanoil alleges and incorporates by reference each and every
25 allegation contained in Paragraphs 1 through 66.

26
27 68. The ORGANIX mark is a term that misdescribes the character, quality,
28 function, composition, or use of Vogue's Products in violation of 15 U.S.C. § 1052(e).

1 The ORGANIX mark is used on products which are similar in type to the Moroccanoil
2 Products and Moroccanoil is likely to be damaged by the continued registration of the
3 ORGANIX mark.

4
5 69. On information and belief, prospective purchasers are likely to believe that
6 the misdescriptive use of the mark ORGANIX actually describes Vogue's Products as
7 being organic in nature. This belief is reinforced by Vogue's use of the term organic on
8 its products. When in fact, Vogue's Products are not organic.

9
10 70. Consumers do not associate the ORGANIX mark with a single source and
11 the ORGANIX mark has not otherwise acquired secondary meaning and is thus
12 unenforceable.

13
14 71. Moroccanoil seeks an exercise of the Court's power under 15 U.S.C.A. §
15 1119, to order the Commissioner of Patents and Trademarks to cancel the registration
16 of Vogue's U.S. Trademark Registration No. 3,820,162.

17
18 **PRAYER**

19
20 **WHEREFORE**, Moroccanoil prays for judgment as follows:

21
22 1. For preliminary and permanent injunctive relief against all Defendants,
23 and each of them, and their officers, agents, attorneys, representatives and assigns, and
24 all persons acting in active concert or participation with them, from doing any of the
25 following acts, either directly or indirectly, and from doing any act prefatory to the
26 prohibited acts:

27
28

1 (a) Infringing any trademark, trade dress or other intellectual property
2 right owned or controlled by Moroccanoil;

3
4 (b) Causing a likelihood of confusion, deception, or mistake as to the
5 source, nature, or quality of Moroccanoil's goods or causing confusion, deception or
6 mistake as to the source, nature or quality of Defendants' goods;

7
8 (c) Using any false designation of origin or false representation
9 concerning any of Defendants' goods; and

10
11 (d) Violating any statute, decision, rule or regulation of any
12 governmental entity in the course of the offering, disposition or sales of any of the
13 Accused Products;

14
15 2. For an order directing Defendants, and each of them, to file with this Court
16 and serve on Moroccanoil within 30 days after service of an injunction, a report in
17 writing under oath, setting forth in detail the manner and form in which Defendants
18 have complied with the injunction;

19
20 3. For an order requiring Defendants, and each of them, to deliver to
21 Moroccanoil all products, literature, advertising, and other material bearing any
22 infringing trademarks or a use of any trademark constituting federal, California state or
23 common law unfair competition;

24
25 4. For an order requiring Defendants to account for all sales and transfers of
26 any of the Accused Products, including an order that they submit to Moroccanoil
27 immediately all records of all purchases, sales, and other materials pertaining to the
28 acquisition and distribution of the Accused Products;

1 5. For an accounting from each Defendant of all profits, monies and
2 advantages that Defendants have obtained by reason of their wrongful conduct;

3

4 6. For damages in an amount according to proof at trial and trebled as
5 permitted by law;

6

7 7. For an order requiring that all gains, profits, or advantages derived by
8 Defendants by their wrongful conduct be disgorged to Moroccanoil to the fullest extent
9 allowed by law;

10

11 8. For punitive and exemplary damages in an amount sufficient to punish
12 defendants and defer such conduct in the action;

13

14 9. For this Court to exercise its power under 15 U.S.C.A. § 1119, to order the
15 Commissioner of Patents and Trademarks to cancel the registration of Vogue's U.S.
16 Trademark Registration No. 3,820,162;

17

18 10. For attorneys' fees;

19

20 11. For costs; and

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1 For such other and further relief as the Court deems just and proper.

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Dated: June 2, 2011

William C. Conkle, members of
CONKLE, KREMER & ENGEL
Professional Law Corporation

By: 

William Conkle
Attorneys for Plaintiff Moroccanoil, Inc.

DEMAND FOR JURY TRIAL

Plaintiff Moroccanoil, Inc. demands trial by jury of all issues triable to a jury.

Dated: June 2, 2011

William C. Conkle, members of
CONKLE, KREMER & ENGEL
Professional Law Corporation

By: 

William Conkle
Attorneys for Plaintiff Moroccanoil, Inc.

PROOF OF SERVICE

1
2 **STATE OF CALIFORNIA, COUNTY OF LOS ANGELES**

3 At the time of service, I was over 18 years of age and **not a party to this action.**
4 I am employed in the County of Los Angeles, State of California. My business address
is 3130 Wilshire Boulevard, Suite 500, Santa Monica, California 90403-2351.

5 On June 2, 2011, I served true copies of the following document(s) described as
6 **SECOND AMENDED COMPLAINT** on the interested parties in this action as
follows:

7 Kieran Doyle, Esq.
8 Cowan, Liebowitz & Latman, P.C.
9 1133 Avenue Of The Americas
10 New York, NY 10036-6710
11 Tel: (212) 790-9261
12 Email: KGD@cjl.com
13 *Attorneys for Defendants*

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Angela P. Lin
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Email: alin@hfl-lawyers.com
Co-counsel for Defendants

14 **BY CM/ECF NOTICE OF ELECTRONIC FILING:** I caused said
15 document(s) to be served by means of this Court's electronic transmission of the Notice
16 of Electronic Filing through the Court's transmission facilities, to the parties and/or
17 counsel who are registered CM/ECF Users set forth in the service list obtained from
this Court.

18 I declare under penalty of perjury under the laws of the State of California that
19 the foregoing is true and correct.

20 Executed on June 2, 2011, at Santa Monica, California.

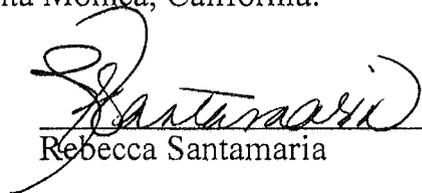
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Rebecca Santamaria

Exhibit 2

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jfedalen@hfl-lawyers.com
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10 *Attorneys for Defendant Todd Christopher*
11 *International, Inc. d/b/a/ Vogue International*

12 **UNITED STATES DISTRICT COURT**
13 **CENTRAL DISTRICT OF CALIFORNIA**

14 MOROCCANOIL, INC., a California Corporation,) Civil Action No. CV10 10048 DMG (AGRx)
15 Plaintiff,) **ANSWER TO SECOND AMENDED**
16 vs.) **COMPLAINT AND COUNTERCLAIM**
17) **FOR CANCELLATION OF**
18) **TRADEMARK REGISTRATION**

17 TODD CHRISTOPHER)
INTERNATIONAL, INC. d/b/a,)
18 VOGUE INTERNATIONAL, a Florida)
Corporation, and DOES 1 through 10,)
19 inclusive,)
20 Defendants.)

21 TODD CHRISTOPHER)
INTERNATIONAL, INC. d/b/a,)
22 VOGUE INTERNATIONAL, a Florida)
Corporation,)
23 Counterclaimant,)

24 vs.)
25)
26 MOROCCANOIL, INC., a California Corporation,)
27 Counterdefendant.)

28 ANSWER TO FIRST AMENDED COMPLAINT AND
COUNTERCLAIM FOR CANCELLATION OF TRADEMARK REGISTRATION

BY _____
2011 JUN 17 PM 3:13
CLERK OF DISTRICT COURT
CENTRAL DISTRICT OF CALIF.
LOS ANGELES

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INTRODUCTION

COMES NOW Defendant Todd Christopher International, Inc., d/b/a/ Vogue International (“Defendants”), and answer Plaintiff’s unverified Second Amended Complaint (“SAC”) as follows:

JURISDICTION AND VENUE

1. Answering Paragraph 1 of the SAC, Defendant admits to Plaintiff’s characterization of the nature of this claim, but denies that said claim is true or meritorious, and further denies that Plaintiff is entitled to any remedy whatsoever.

2. Answering Paragraph 2 of the SAC, Defendant admits to Plaintiff’s characterization of the nature of this claim, but denies that said claim is true or meritorious, and further denies that Plaintiff is entitled to any remedy whatsoever.

3. Answering Paragraph 3 of the SAC, Defendant is without knowledge or information sufficient to form a belief as to the truth of the allegations.

4. Answering Paragraph 4 of the SAC, Defendant admits to the allegations therein.

5. Answer Paragraph 5 of the SAC, Defendant denies each and every allegation therein.

6. Answering Paragraph 6 of the SAC, Defendant denies each and every allegation therein.

7. Answering Paragraph 7 of the SAC, Defendant is without knowledge or information sufficient to form a belief as to the truth of the allegations.

8. Answering Paragraph 8 of the SAC, Defendant is without knowledge or information sufficient to form a belief as to the truth of the allegations.

9. Answering Paragraph 9 of the SAC, Defendant is without knowledge or information sufficient to form a belief as to the truth of the allegations.

10. Answering Paragraph 10 of the SAC, Defendant is without knowledge or information sufficient to form a belief as to the truth of the allegations but denies the validity of the alleged trademarks listed and registrations thereof.

1 11. Answering Paragraph 11 of the SAC, Defendant admits that Plaintiff
2 uses the term Moroccan oil Trademarks throughout the SAC but denies each and
3 every other allegation therein including the validity of the alleged trademarks listed
4 and registrations thereof.

5 12. Answering Paragraph 12 of the SAC, Defendant denies each and every
6 allegation therein.

7 13. Answering Paragraph 13 of the SAC, Defendant denies each and every
8 allegation therein.

9 14. Answering Paragraph 14 of the SAC, Defendant is without knowledge
10 or information sufficient to form a belief as to the truth of the allegations.

11 15. Answering Paragraph 15 of the SAC, Defendant denies each and every
12 allegation therein except admits that Defendant advertises and sells within their
13 ORGANIX brand line of hair care products a blend which is described as containing
14 Moroccan argan oil.

15 16. Answering Paragraph 16 of the SAC, Defendant denies each and every
16 allegation therein.

17 17. Answering Paragraph 17 of the SAC, Defendant denies each and every
18 allegation therein except admits that it has used the term "organic" to truthfully
19 describe one active ingredient in its products and has used the trademark ORGANIX
20 on its products packaging .

21 18. Answer Paragraph 18 of the SAC, Defendant denies each and every
22 allegation therein except admits that Defendant uses the term Moroccan argan oil
23 descriptively.

24 19. Answering Paragraph 19 of the SAC, Defendant denies that its
25 products are or are intended to be for sale through professional salons and admits to
26 the remaining allegations therein.

27 20. Answering Paragraph 20 of the SAC, Defendant denies each and every
28 allegation therein.

1 31. Answering Paragraph 31 of the SAC, Defendant denies each and every
2 allegation therein.

3 32. Answering Paragraph 32 of the SAC, Defendant denies each and every
4 allegation therein.

5 33. Answering Paragraph 33 of the SAC, Defendant denies each and every
6 allegation therein.

7 34. Answering Paragraph 34 of the SAC, Defendant denies each and every
8 allegation therein.

9 35. Answering Paragraph 35 of the SAC, Defendant denies each and every
10 allegation therein.

11 36. Answering Paragraph 36 of the SAC, Defendant denies each and every
12 allegation therein.

13 **SECOND CLAIM FOR RELIEF**

14 (Federal Trademark Infringement and Unfair Competition)

15 37. Answering Paragraph 37 of the SAC, the allegations in Paragraph 37
16 incorporate the allegations in paragraphs 1 through 36, Defendant refers to its
17 answers to said paragraphs, and by such reference, incorporates the same herein to
18 have the same force and effect as if set forth fully at length.

19 38. Answering Paragraph 38 of the SAC, Defendant denies each and every
20 allegation therein.

21 39. Answering Paragraph 39 of the SAC, Defendant denies each and every
22 allegation therein.

23 40. Answering Paragraph 40 of the SAC, Defendant denies each and every
24 allegation therein.

25 41. Answering Paragraph 41 of the SAC, Defendant denies each and every
26 allegation therein.

27 42. Answering Paragraph 42 of the SAC, Defendant denies each and every
28 allegation therein.

1 43. Answering Paragraph 43 of the SAC, Defendant denies each and every
2 allegation therein.

3 44. Answering Paragraph 44 of the SAC, Defendant denies each and every
4 allegation therein.

5 **THIRD CLAIM FOR RELIEF STATUTORY**

6 (Unfair Competition and Conspiracy to Unfairly Competition)

7 45. Answering Paragraph 45 of the SAC, the allegations in Paragraph 45
8 incorporate the allegations in paragraphs 1 through 44, Defendant refers to its
9 answers to said paragraphs, and by such reference, incorporates the same herein to
10 have the same force and effect as if set forth fully at length.

11 46. Answering Paragraph 46 of the SAC, Defendant denies each and every
12 allegation therein.

13 47. Answering Paragraph 47 of the SAC, Defendant denies each and every
14 allegation therein.

15 48. Answering Paragraph 48 of the SAC, Defendant denies each and every
16 allegation therein.

17 **FOURTH CLAIM FOR RELIEF**

18 (Common Law Trademark Infringement and Unfair Competition and Conspiracy to
19 Unfairly Compete)

20 49. Answering Paragraph 49 of the SAC, the allegations in Paragraph 49
21 incorporate the allegations in paragraphs 1 through 48, Defendant refers to its
22 answers to said paragraphs, and by such reference, incorporates the same herein to
23 have the same force and effect as if set forth fully at length.

24 50. Answering Paragraph 50 of the SAC, Defendant denies each and every
25 allegation therein.

26 51. Answering Paragraph 51 of the SAC, Defendant denies each and every
27 allegation therein.

28

1 that paragraph is construed to contain factual allegations Defendant denies each and
2 every allegation therein.

3
4

AFFIRMATIVE DEFENSES

5 72. AS A FIRST SEPARATE AND AFFIRMATIVE DEFENSE,
6 Defendant alleges that the Complaint, and each and every purported claim set forth
7 therein, fails to state a claim upon which relief can be granted.

8 73. AS A SECOND SEPARATE AND AFFIRMATIVE DEFENSE,
9 Defendant alleges, on information and belief, that Plaintiff lacks standing to
10 maintain any of the claims against Defendant herein.

11 74. AS A THIRD SEPARATE AND AFFIRMATIVE DEFENSE,
12 Defendant alleges that Plaintiff's trademarks are not inherently distinctive and has
13 not attained secondary meaning in that purchasers of goods bearing said trademark
14 do not associate the trademark with Plaintiff alone.

15 75. AS A FOURTH SEPARATE AND AFFIRMATIVE DEFENSE,
16 Defendants' use of the alleged infringing term Moroccan argan oil is fair in that it is
17 used in the manner which truthfully describes Defendants' goods.

18 76. AS A FIFTH SEPARATE AND AFFIRMATIVE DEFENSE,
19 Defendant alleges that its use of the term Moroccan argan oil did not cause
20 confusion, or likelihood of confusion, of the public that the goods sold by Defendant
21 with said alleged infringing trademark was associated or affiliated in any way with
22 Plaintiff.

23 77. AS A SIXTH SEPARATE AND AFFIRMATIVE DEFENSE,
24 Defendant alleges that the trademarks claimed herein by Plaintiff have not become
25 incontestable, and that said trademarks are invalid and subject to cancellation on the
26 ground that they are (i) not inherently distinctive and have not become distinctive
27 through the acquisition of secondary meaning; (ii) are geographically descriptive;
28 and/or (iii) are geographically misdescriptive.

ANSWER TO SECOND AMENDED COMPLAINT AND
COUNTERCLAIM FOR CANCELLATION OF TRADEMARK REGISTRATION

1 78. AS A SEVENTH SEPARATE AND AFFIRMATIVE DEFENSE,
2 Defendant alleges that Plaintiff's claim for trademark Infringement based upon 15
3 U.S.C. § 1114 is barred because Plaintiff's trademark registrations were fraudulently
4 procured.

5 79. AS AN EIGHTH SEPARATE AND AFFIRMATIVE DEFENSE,
6 defendant's ORGANIX trademark which is the subject of United States Trademark
7 Registration No. 3,820,162 has acquired distinctiveness and therefore is not the
8 proper subject of cancellation under 15 U.S.C. § 1052(e).

9 WHEREFORE, Defendant prays that Plaintiff take nothing by way of its
10 complaint, that Plaintiff's claim for temporary and permanent injunctive relief be
11 denied, that Defendant recover its costs of suit herein, that Defendant recover its
12 attorney's fees incurred herein, and that Defendant be granted such further relief as
13 the court deems just and proper.

14 Dated: June 13, 2011 **HUANG, FE DALEN & LIN, LLP**

15

16 /s/ James C. Fedalen

17 By: _____
 James C. Fedalen
 Angela P. Lin

18

19 **COWAN LIEBOWITZ & LATMAN, PC**
20 Kieran G. Doyle (*admission pro hac vice*)
1133 Avenue of the Americas
New York, NY 10036

21

*Attorneys for Defendant Todd Christopher
International, Inc. d/b/a Vogue International*

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1 **COUNTERCLAIMS FOR CANCELLATION**
2 **OF PLAINTIFF'S TRADEMARK REGISTRATION**

3 **THE PARTIES**

4 1. Defendant and Counterclaimant Todd Christopher International, Inc.
5 dba Vogue International, is a Corporation organized and existing under the laws of
6 the State of Florida with its principal place of business in at 4027 Tampa Road, Suite
7 3200, Oldsmar, Florida 34677.

8 2. On information and belief, Plaintiff and Counterdefendant
9 Moroccanil, Inc. ("Counterdefendant") is a California corporation with its principal
10 place of business within this district.

11 **JURISDICTION AND VENUE**

12 3. The Court has jurisdiction over this counterclaim pursuant to 15 USC
13 § 1119, which provides, in pertinent part, that "[i]n any action involving a registered
14 mark the court may . . . order the cancelation of registrations, in whole or in part,"
15 and that [d]ecrees and orders shall be certified by the court to the Director, who shall
16 make appropriate entry upon the records of the Patent and Trademark Office, and
17 shall be controlled thereby" and under the Lanham Act, 15 U.S.C. § 1051 et seq. and
18 under the Federal Declaratory Judgment Act, 28 U.S.C. §§ 2201-2202. Subject
19 matter jurisdiction is conferred on this Court by 28 U.S.C. §§ 1331 and 1338(a), 15
20 U.S.C. § 1121, and under the principles of supplemental jurisdiction with respect to
21 the common law and state claims.

22 4. This Court also has ancillary, pendent and supplemental jurisdiction
23 because the underlying transactions, facts and controversies arise out of the same
24 case and controversy and nucleus of facts as those claims asserted in the first
25 Amended Complaint in this action.

26 5. The claims asserted in this counterclaim arose in substantial part
27 within this District, and venue of this counterclaim in this district and this court is
28 proper under 28 U.S.C. §§ 1391(b), 1391(c), and/or 1400(a).

1 **COUNTERCLAIM FOR A DECLARATION OF INVALIDITY**
2 **(DESCRIPTIVE)**
3 **OF UNITED STATES TRADEMARK REGISTRATION 3,478,807**

4 6. This is a counterclaim under the trademark laws of the United States
5 (15 U.S.C. § 1051 et seq.) for a declaration that United States trademark registration
6 3,478,807 for the mark MOROCCANOIL is invalid.

7 7. Counterdefendant asserts that counterclaimant and other defendants,
8 by virtue of acts alleged in the complaint in this action, have infringed and continue
9 to infringe the mark MOROCCANOIL, which is the subject of United States
10 trademark registration 3,478,807.

11 8. Counterclaimant has denied such infringement and asserts that United
12 States trademark registration 3,478,807 is invalid.

13 9. An actual controversy exists between counterclaimant and
14 counterdefendant as to the validity of United States trademark registration 3,478,807
15 as evidenced by the first amended complaint and first amended answer in this action.

16 10. United States trademark registration 3,478,807 is invalid by virtue of
17 the mark being merely descriptive in violation of 15 U.S.C. § 1052(e)(1), as it is
18 understood by prospective purchasers to directly describe only the ingredients of the
19 goods, and does not require the imagination of the prospective purchaser to reach a
20 conclusion as to the nature of the goods or services. The mark has not otherwise
21 acquired secondary meaning and is thus unenforceable.

22 11. Unless enjoined by this Court, the acts of counterdefendant have
23 caused and will continue to cause irreparable damage, loss, and injury to
24 counterclaimant for which counterclaimant has no adequate remedy at law and from
25 which counterclaimant is entitled to declaratory and injunctive relief.

1 **COUNTERCLAIM FOR A DECLARATION OF INVALIDITY**
2 **(GEOGRAPHICALLY DESCRIPTIVE)**
3 **OF UNITED STATES TRADEMARK REGISTRATION 3,478,807**

4 12. This is a counterclaim under the trademark laws of the United States
5 (15 U.S.C. § 1051 et seq.) for a declaration that United States trademark registration
6 3,478,807 for the mark MOROCCANOIL is invalid.

7 13. Counterdefendant asserts that counterclaimant and other defendants,
8 by virtue of acts alleged in the complaint in this action, have infringed and continue
9 to infringe the mark MOROCCANOIL, which is the subject of United States
10 trademark registration 3,478,807.

11 14. Counterclaimant has denied such infringement and asserts that United
12 States trademark registration 3,478,807 is invalid.

13 15. An actual controversy exists between counterclaimant and
14 counterdefendant as to the validity of United States trademark registration 3,478,807
15 as evidenced by the first amended complaint and first amended answer in this action.

16 16. United States trademark registration 3,478,807 is invalid by virtue of
17 the mark being geographically descriptive in violation of 15 U.S.C. § 1052(e)(2), as
18 it is understood by prospective purchasers to directly describe only the source of the
19 ingredients of the goods (i.e., argan oil from the argan tree, primarily found in
20 Morocco), and does not require the imagination of the prospective purchaser to
21 reach a conclusion as to the nature of the goods or services. The mark has not
22 otherwise acquired secondary meaning and is thus unenforceable.

23 17. Unless enjoined by this Court, the acts of counterdefendant have
24 caused and will continue to cause irreparable damage, loss, and injury to
25 counterclaimant for which counterclaimant has no adequate remedy at law and from
26 which counterclaimant is entitled to declaratory and injunctive relief.
27
28

1 **COUNTERCLAIM FOR A DECLARATION OF INVALIDITY**
2 **(GEOGRAPHICALLY MISDESCRIPTIVE)**
3 **OF UNITED STATES TRADEMARK REGISTRATION 3,478,807**

4 18. This is a counterclaim under the trademark laws of the United States
5 (15 U.S.C. § 1051 et seq.) for a declaration that United States trademark registration
6 3,478,807 for the mark MOROCCANOIL is invalid.

7 19. Counterdefendant asserts that counterclaimant and other defendants,
8 by virtue of acts alleged in the complaint in this action, have infringed and continue
9 to infringe the mark MOROCCANOIL, which is the subject of United States
10 trademark registration 3,478,807.

11 20. Counterclaimant has denied such infringement and asserts that United
12 States trademark registration 3,478,807 is invalid.

13 21. An actual controversy exists between counterclaimant and
14 counterdefendant as to the validity of United States trademark registration 3,478,807
15 as evidenced by the first amended complaint and first amended answer in this action.

16 22. United States trademark registration 3,478,807 is invalid by virtue of
17 the mark being geographically deceptively misdescriptive in violation of 15 U.S.C. §
18 1052(e)(3), as customers of MOROCCANOIL branded products will likely believe
19 that the argan oil used in the goods comes from Morocco when such oil in
20 Counterdefendant's goods comes from Israel and Algeria . The term
21 MOROCCANOIL gives a false indication of geographical origin of a key ingredient
22 to that segment of the purchasing public which may be interested in the country of
23 origin, and the mark is likely to deceive them. Further, the mark has not otherwise
24 acquired secondary meaning and is thus unenforceable.

25 23. Unless enjoined by this Court, the acts of counterdefendant have
26 caused and will continue to cause irreparable damage, loss, and injury to
27 counterclaimant for which counterclaimant has no adequate remedy at law and from
28 which counterclaimant is entitled to declaratory and injunctive relief.

1 **COUNTERCLAIM FOR A DECLARATION OF INVALIDITY**
2 **(DESCRIPTIVE) OF UNITED STATES TRADEMARK REGISTRATION**
3 **3,684,909**

4 24. Counterclaimant repeats and realleges each and every allegation set
5 forth above.

6 25. This is a counterclaim under the trademark laws of the United States
7 (15 U.S.C. § 1051 et seq.) for a declaration that United States trademark registration
8 3,684,909 for the mark M MOROCCANOIL is invalid.

9 26. Counterdefendant asserts that counterclaimant and other defendants,
10 by virtue of acts alleged in the complaint in this action, have infringed and continue
11 to infringe the mark M MOROCCANOIL, which is the subject of United States
12 trademark registration 3,684,909. Counterclaimant has denied such infringement
13 and asserts that United States trademark registration 3,684,909 is invalid.

14 27. An actual controversy exists between counterclaimant and
15 counterdefendant as to the validity of United States trademark registration 3,684,909
16 as evidenced by the first amended complaint and first amended answer in this action.

17 28. United States trademark registration 3,684,909 is invalid by virtue of
18 the mark being merely descriptive in violation of 15 U.S.C. § 1052(e)(1), as it is
19 understood by prospective purchasers to directly describe only the ingredients of the
20 goods, and does not require the imagination of the prospective purchaser to reach a
21 conclusion as to the nature of the goods or services. The mark has not otherwise
22 acquired secondary meaning and is thus unenforceable.

23 29. Unless enjoined by this Court, the acts of counterdefendant have
24 caused and will continue to cause irreparable damage, loss, and injury to
25 counterclaimant for which counterclaimant has no adequate remedy at law and from
26 which counterclaimant is entitled to declaratory and injunctive relief.

1 **COUNTERCLAIM FOR A DECLARATION OF INVALIDITY**
2 **(GEOGRAPHICALLY DESCRIPTIVE)**
3 **OF UNITED STATES TRADEMARK REGISTRATION 3,684,909**

4 30. This is a counterclaim under the trademark laws of the United States
5 (15 U.S.C. § 1051 et seq.) for a declaration that United States trademark registration
6 3,684,909 for the mark M MOROCCANOIL is invalid.

7 31. Counterdefendant asserts that counterclaimant and other defendants,
8 by virtue of acts alleged in the complaint in this action, have infringed and continue
9 to infringe the mark M MOROCCANOIL, which is the subject of United States
10 trademark registration 3,684,909. Counterclaimant has denied such infringement
11 and asserts that United States trademark registration 3,684,909 is invalid.

12 32. An actual controversy exists between counterclaimant and
13 counterdefendant as to the validity of United States trademark registration 3,684,909
14 as evidenced by the first amended complaint and first amended answer in this action.

15 33. United States trademark registration 3,684,909 is invalid by virtue of
16 the mark being geographically descriptive in violation of 15 U.S.C. § 1052(e)(2), as
17 it is understood by prospective purchasers to directly describe only the source of the
18 ingredients of the goods (i.e., argan oil from the argan tree, primarily found in
19 Morocco), and does not require the imagination of the prospective purchaser to
20 reach a conclusion as to the nature of the goods or services. The mark has not
21 otherwise acquired secondary meaning and is thus unenforceable.

22 34. Unless enjoined by this Court, the acts of counterdefendant have
23 caused and will continue to cause irreparable damage, loss, and injury to
24 counterclaimant for which counterclaimant has no adequate remedy at law and from
25 which counterclaimant is entitled to declaratory and injunctive relief.

1 **COUNTERCLAIM FOR A DECLARATION OF INVALIDITY**
2 **(GEOGRAPHICALLY MISDESCRIPTIVE)**
3 **OF UNITED STATES TRADEMARK REGISTRATION 3,684,909**

4 35. This is a counterclaim under the trademark laws of the United States
5 (15 U.S.C. § 1051 et seq.) for a declaration that United States trademark registration
6 3,684,909 for the mark M MOROCCANOIL is invalid.

7 36. Counterdefendant asserts that counterclaimant and other defendants,
8 by virtue of acts alleged in the complaint in this action, have infringed and continue
9 to infringe the mark M MOROCCANOIL, which is the subject of United States
10 trademark registration 3,684,909. Counterclaimant has denied such infringement
11 and asserts that United States trademark registration 3,684,909 is invalid.

12 37. An actual controversy exists between counterclaimant and
13 counterdefendant as to the validity of United States trademark registration 3,684,909
14 as evidenced by the first amended complaint and first amended answer in this action.

15 38. United States trademark registration 3,684,909 is invalid by virtue of
16 the mark being geographically deceptively misdescriptive in violation of 15 U.S.C. §
17 1052(e)(3), as customers of M MOROCCANOIL branded products will likely
18 believe that the argan oil used in the goods comes from Morocco when such oil in
19 counterdefendant's goods comes from Israel and Algeria. The term M
20 MOROCCANOIL gives a false indication of geographical origin of a key ingredient
21 to that segment of the purchasing public which may be interested in the country of
22 origin, and the mark is likely to deceive them. Further, the mark has not otherwise
23 acquired secondary meaning and is thus unenforceable.

24 39. Unless enjoined by this Court, the acts of counterdefendant have
25 caused and will continue to cause irreparable damage, loss, and injury to
26 counterclaimant for which counterclaimant has no adequate remedy at law and from
27 which counterclaimant is entitled to declaratory and injunctive relief.

1 **COUNTERCLAIM FOR A DECLARATION OF INVALIDITY**
2 **(DESCRIPTIVE)**
3 **OF UNITED STATES TRADEMARK REGISTRATION 3,684,910**

4 40. Counterclaimant repeats and realleges each and every allegation set
5 forth above.

6 41. This is a counterclaim under the trademark laws of the United States
7 (15 U.S.C. § 1051 et seq.) for a declaration that United States trademark registration
8 3,684,910 for the mark M MOROCCANOIL is invalid.

9 42. Counterdefendant asserts that counterclaimant and other defendants,
10 by virtue of acts alleged in the complaint in this action, have infringed and continue
11 to infringe the mark M MOROCCANOIL, which is the subject of United States
12 trademark registration 3,684,910. Counterclaimant has denied such infringement
13 and asserts that United States trademark registration 3,684,910 is invalid.

14 43. An actual controversy exists between counterclaimant and
15 counterdefendant as to the validity of United States trademark registration 3,684,910
16 as evidenced by the first amended complaint and first amended answer in this action.

17 44. United States trademark registration 3,684,910 is invalid by virtue of
18 the mark being merely descriptive in violation of 15 U.S.C. § 1052(e)(1), as it is
19 understood by prospective purchasers to directly describe only the ingredients of the
20 goods, and does not require the imagination of the prospective purchaser to reach a
21 conclusion as to the nature of the goods or services. The mark has not otherwise
22 acquired secondary meaning and is thus unenforceable.

23 45. Unless enjoined by this Court, the acts of counterdefendant have
24 caused and will continue to cause irreparable damage, loss, and injury to
25 counterclaimant for which counterclaimant has no adequate remedy at law and from
26 which counterclaimant is entitled to declaratory and injunctive relief.

1 **COUNTERCLAIM FOR A DECLARATION OF INVALIDITY**
2 **(GEOGRAPHICALLY DESCRIPTIVE)**
3 **OF UNITED STATES TRADEMARK REGISTRATION 3,684,910**

4 46. This is a counterclaim under the trademark laws of the United States
5 (15 U.S.C. § 1051 et seq.) for a declaration that United States trademark registration
6 3,684,910 for the mark M MOROCCANOIL is invalid.

7 47. Counterdefendant asserts that counterclaimant and other defendants,
8 by virtue of acts alleged in the complaint in this action, have infringed and continue
9 to infringe the mark M MOROCCANOIL, which is the subject of United States
10 trademark registration 3,684,910. Counterclaimant has denied such infringement
11 and asserts that United States trademark registration 3,684,910 is invalid.

12 48. An actual controversy exists between counterclaimant and
13 counterdefendant as to the validity of United States trademark registration 3,684,910
14 as evidenced by the first amended complaint and first amended answer in this action.

15 49. United States trademark registration 3,684,910 is invalid by virtue of
16 the mark being geographically descriptive in violation of 15 U.S.C. § 1052(e)(2), as
17 it is understood by prospective purchasers to directly describe only the source of the
18 ingredients of the goods (i.e., argan oil from the argan tree, primarily found in
19 Morocco), and does not require the imagination of the prospective purchaser to
20 reach a conclusion as to the nature of the goods or services. The mark has not
21 otherwise acquired secondary meaning and is thus unenforceable.

22 50. Unless enjoined by this Court, the acts of counterdefendant have
23 caused and will continue to cause irreparable damage, loss, and injury to
24 counterclaimant for which counterclaimant has no adequate remedy at law and from
25 which counterclaimant is entitled to declaratory and injunctive relief.

1 **COUNTERCLAIM FOR A DECLARATION OF INVALIDITY**
2 **(GEOGRAPHICALLY MISDESCRIPTIVE)**
3 **OF UNITED STATES TRADEMARK REGISTRATION 3,684,910**

4 51. This is a counterclaim under the trademark laws of the United States
5 (15 U.S.C. § 1051 et seq.) for a declaration that United States trademark registration
6 3,684,910 for the mark M MOROCCANOIL is invalid.

7 52. Counterdefendant asserts that counterclaimant and other defendants,
8 by virtue of acts alleged in the complaint in this action, have infringed and continue
9 to infringe the mark M MOROCCANOIL, which is the subject of United States
10 trademark registration 3,684,910. Counterclaimant has denied such infringement
11 and asserts that United States trademark registration 3,684,910 is invalid.

12 53. An actual controversy exists between counterclaimant and
13 counterdefendant as to the validity of United States trademark registration 3,684,910
14 as evidenced by the first amended complaint and first amended answer in this action.

15 54. United States trademark registration 3,684,910 is invalid by virtue of
16 the mark being geographically deceptively misdescriptive in violation of 15 U.S.C. §
17 1052(e)(3), as customers of M MOROCCANOIL branded products will likely
18 believe that the argan oil used in the goods comes from Morocco when such oil in
19 Counterdefendant's goods comes from Israel and Algeria. The term M
20 MOROCCANOIL gives a false indication of geographical origin of a key ingredient
21 to that segment of the purchasing public which may be interested in the country of
22 origin, and the mark is likely to deceive them. Further, the mark has not otherwise
23 acquired secondary meaning and is thus unenforceable.

24 55. Unless enjoined by this Court, the acts of counterdefendant have
25 caused and will continue to cause irreparable damage, loss, and injury to
26 counterclaimant for which counterclaimant has no adequate remedy at law and from
27 which counterclaimant is entitled to declaratory and injunctive relief.

1 **COUNTERCLAIM FOR A DECLARATION OF NON-INFRINGEMENT**

2 56. Counterclaimant repeats and realleges each and every allegation set
3 forth above.

4 57. This is a counterclaim under the trademark laws of the United States
5 (15 U.S.C. § 1051 et seq.) for a declaration that, should counterdefendant's
6 trademarks be found valid and enforceable, counterclaimant's business activities and
7 sales do not infringe upon said trademark rights of counterdefendant. An actual
8 controversy exists between counterclaimant and counterdefendant as to trademark
9 infringement as evidenced by the complaint and answer in this action.

10 58. Counterclaimant's alleged sales do not constitute a Lanham Act
11 violation.

12 59. Unless enjoined by this Court, the acts of counterdefendant have
13 caused and will continue to cause irreparable damage, loss, and injury to
14 counterclaimant for which counterclaimant has no adequate remedy at law and from
15 which counterclaimant is entitled to declaratory and injunctive relief.

16 **COUNTERCLAIM FOR UNFAIR COMPETITION**

17 60. Counterclaimant repeats and realleges each and every allegation set
18 forth above.

19 61. Upon information and belief, counterdefendant commenced this action
20 without a good faith basis for believing that counterclaimant has infringed any
21 trademark rights owned by counterdefendant and instead for the sole or primary
22 purpose of hindering the sale of authentic hair care products which accurately are
23 described as containing argan oil from argan nuts grown in Morocco.

24 62. Upon information and belief, counterdefendant commenced this action
25 for the sole or primary purpose of unlawfully and unfairly restraining trade and
26 legitimate competition in hair care products which accurately are described as
27 containing argan oil from argan nuts grown in Morocco.

28

1 7. For general, special compensatory damages and/or disgorgement of
2 lost profits in an amount to be proven at trial.

3 8. For costs and disbursements incurred herein, including attorneys' fees.

4 9. For such other relief as the court may deem appropriate.

5

6

JURY TRIAL DEMANDED

7

Defendant hereby demands a trial by jury.

8

Dated: June 13, 2011

HUANG, FEDALEN & LIN, LLP

9

10

/s/ James C. Fedalen

11

By: _____
James C. Fedalen
Angela P. Lin

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COWAN LIEBOWITZ & LATMAN, PC

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Kieran G. Doyle (*admission pro hac vice*)
1133 Avenue of the Americas
New York, NY 10036

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*Attorneys for Defendant Todd Christopher
International, Inc. d/b/a Vogue International*

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Exhibit 3

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6 Phone: (310) 998-9100 • Fax: (310) 998-9109

7 Attorneys for Plaintiff Moroccanoil, Inc.,
8

9 UNITED STATES DISTRICT COURT
10 CENTRAL DISTRICT OF CALIFORNIA, WESTERN DIVISION
11

12 MOROCCANOIL, INC., a California
corporation,

13 Plaintiff,
14

15 v.

16 YAIR GOLAN, an individual; GIDON
ZAFI, an individual; ROYAL
17 MOROCCAN, CORP. a Florida
corporation; Y.P. GOLAN TRADE,
18 LTD. an Israeli entity; and DOES 1
through 10 inclusive,
19

20 Defendants.
21

CASE No. CV 11-01974 SJO (JEMx)

**FIRST AMENDED COMPLAINT
FOR:**

1. **DECLARATORY RELIEF**
2. **FEDERAL TRADEMARK
INFRINGEMENT**
[15 U.S.C. § 1114]
3. **FEDERAL TRADEMARK
INFRINGEMENT AND
UNFAIR COMPETITION**
[15 U.S.C. § 1125(a)]

DEMAND FOR JURY TRIAL

BY: _____
2012 JAN 23 PM 2:56
CENTRAL DISTRICT OF CALIF.
LOS ANGELES

FILED

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JURISDICTION

1. This action arises under and this Court has original jurisdiction pursuant to 15 U.S.C. § 1121 (Original Jurisdiction – Trademarks), 28 U.S.C. § 1331 (Federal Question), 28 U.S.C. § 1338(a) (Original Jurisdiction – Patents and Trademarks), 28 U.S.C. § 1332 (Diversity of Citizenship) and 28 U.S.C. § 1367 (Supplemental Jurisdiction).

VENUE

2. Venue is proper in this District under 28 U.S.C. § 1391(d) because Defendants are aliens and 28 U.S.C. § 1391(b)(2) because a substantial part of the events giving rise to the claims occurred in this District.

THE PLAINTIFF

3. Moroccanoil, Inc. is a California corporation having a principal place of business at 16311 Ventura Blvd., Ste. 1200, Los Angeles, CA 91436. Moroccanoil, Inc., and its predecessor with which it is joined by statutory merger are referred to as “Moroccanoil” or “Plaintiff”. Moroccanoil distributes products bearing the name and trademark Moroccanoil (“Moroccanoil Products”) to authorized distributors throughout the United States.

THE DEFENDANTS

4. Plaintiff is informed and believes that Defendant Yair Golan, (“Golan”) is not a citizen of the United States, and is instead a citizen of the nation of Israel and resides in Israel. This Court has personal jurisdiction over Golan pursuant to FRCP 4(k)(2). Plaintiff is informed and believes that Golan is not subject to jurisdiction in any state’s courts of general jurisdiction. Exercising jurisdiction over Golan is consistent with the United States Constitution and laws as Golan has made a deliberate decision to register marks with the United States Patent and Trademark Office.

1 5. Plaintiff is informed and believes that Defendant Gidon Zaft, (“Zaft”) is a
2 citizen of the United States, residing in the state of Florida. On information and belief
3 Zaft owns 70% of Defendant Royal Moroccan, Corp.
4

5 6. On information and belief, Defendant Royal Moroccan Corp., (“RMC”) is
6 a Florida corporation with a principal place of business located at 2797 1st Street, Suite
7 #1401, Fort Meyer, FL 33916. RMC is in the business of distributing hair care and
8 personal care products. RMC markets and sells its products through its website at
9 <http://www.RoyalMoroccan.com> (the “Royal Moroccan Website”) throughout the
10 United States, including in Los Angeles County, California.
11

12 7. On information and belief, Defendant Y.P. Golan Trade, Ltd., (“YPGT”) is
13 an Israeli business entity of unknown form with a principal place of business in Israel.
14 YPGT is listed as the owner of the domain RoyalMoroccan.com. On information and
15 belief, YPGT lacks contacts with a single state sufficient to justify personal jurisdiction
16 of YPGT in any state’s court of general jurisdiction. On information and belief, YPGT
17 is in the business of manufacturing and distributing hair care and personal care
18 products. YPGT’s products are sold throughout the United States, including in Los
19 Angeles County, California through the Royal Moroccan Website. As such, pursuant to
20 Federal Rule of Civil Procedure 4(k)(2), this court has personal jurisdiction over YPGT
21

22 8. Plaintiff believes there are others who are involved in the acts and
23 omissions of each of the defendants, and sues them by fictitious names DOES 1 - 10.
24

25 9. Other than as alleged in this Complaint, Plaintiff is ignorant of the true
26 identities and participation of Does 1 through 10, inclusive, and therefore sues them by
27 such fictitious names. Plaintiff is informed and believes that each of the defendants
28 designated as a Doe is liable in some manner for the acts and omissions, damages and

1 injuries of which Plaintiff alleges in this Complaint. Plaintiff will seek to amend this
2 Complaint to state the true identities of Does 1 through 10 when ascertained.

3
4 10. On information and belief, each of the named defendants, and each of the
5 Doe defendants (collectively "Defendants"), was at all relevant times acting to the
6 fullest extent recognized by law as the agent, employee or co-conspirator of each of the
7 other Defendants and that in committing the acts and omissions alleged herein and
8 causing the damage and injuries alleged, was acting within the scope of such agency,
9 employment, conspiracy, joint venture or partnership relationship. The Defendants
10 have committed acts in furtherance of the conspiracy, have given aid and
11 encouragement to the conspirators and have ratified and adopted the acts of their co-
12 conspirators.

13
14 11. On information and belief, there exists, and at all times herein mentioned
15 there existed, a unity of interests and ownership between Defendants such that any
16 individuality and separateness between the Defendants never existed or has ceased to
17 exist, and the Defendants are in each instance the alter ego of the other Defendants who
18 control each entity. To adhere to the fiction of the separate existence of the entities as
19 separate and distinct from the Defendants identified with them as owning and
20 controlling them would permit an abuse of the corporate and other entity privileges,
21 would sanction fraud and would promote injustice.

22
23 **MOROCCANOIL'S INTELLECTUAL PROPERTY AND PRODUCTS**

24 12. Moroccanoil distributes in Los Angeles County and throughout the United
25 States a line of professional, "salon only" hair care products under the brand name and
26 trademark "MOROCCANOIL". Products distributed under the Moroccanoil brand
27 ("Moroccanoil Products") contain a signature ingredient, argan oil. Argan oil is
28 produced from the nut kernels of the argan tree, which is native to the Mediterranean.

1 13. All of the Moroccanoil Products bear one or more of the federally
2 registered trademarks of Plaintiff, including: the word "MOROCCANOIL"(U.S. Reg.
3 No. 3,478,807), the vertical "M Moroccanoil Design" (U.S. Reg. No. 3,684,910), and
4 the horizontal "M Moroccanoil Design" (U.S. Reg. No. 3,684,909). The trademarks are
5 registered in Class 3 on the Principal Register of the United States Patent and
6 Trademark Office. In addition to the federally registered trademarks, Plaintiff owns
7 trade dress that encompasses the size, shape, color, wording, graphics, packaging and
8 overall appearance of the Moroccanoil Products as well as the placement and position
9 of the Moroccanoil Trademarks on the labels and packaging ("Moroccanoil Trade
10 Dress"). Moroccanoil Trade Dress is non-functional, and inherently distinctive, and has
11 become uniquely associated with Moroccanoil in the marketplace as the source of these
12 products. Moroccanoil owns all right, title and interest in the United States and in other
13 countries to the Moroccanoil Trademarks and Moroccanoil Trade Dress and the
14 goodwill associated with them (collectively "Moroccanoil Intellectual Property").

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1 14. The following images are true and correct photographs of Plaintiff's
2 federally registered trademarks:

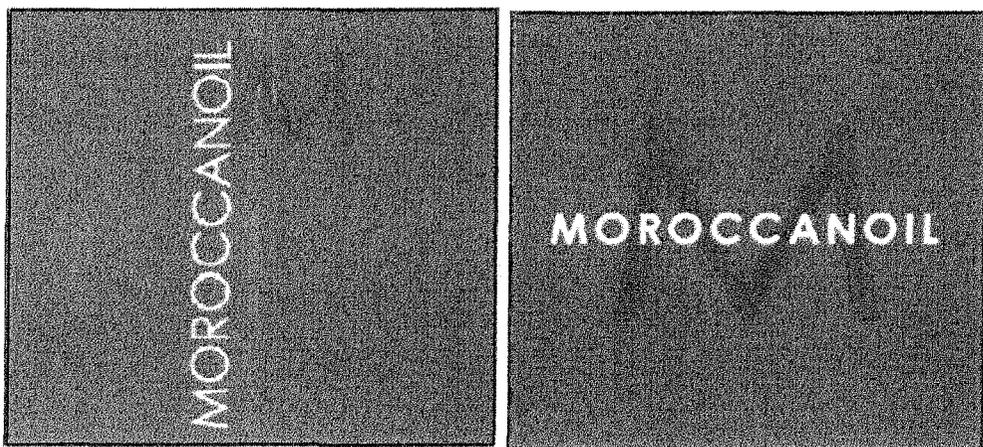
3
4 USPTO Registration No. 3,478,807

5 TRADEMARK
6 PRINCIPAL REGISTER

7
8 MOROCCANOIL

9
10 USPTO Registration No.
11 3,684,910

12 USPTO Registration No.
13 3,684,909



20
21 15. Since about January 2007, Plaintiff has continuously used one or more of
22 the Moroccan oil Trademarks in commerce in the United States. All Moroccan oil
23 Products bear one or more of the Moroccan oil Trademarks. Moroccan oil was the first
24 entrant into the market for salon-professional, argan oil based hair care products and
25 has built goodwill and value in the Moroccan oil Trademarks and other intellectual
26 property such that consumers in the United States associate "Moroccan oil" exclusively
27 with it and with Moroccan oil Products. The Moroccan oil Trademarks are inherently
28 distinctive and have acquired secondary meaning in the marketplace. Moroccan oil

1 Products are high-quality beauty products that are held in high regard, and used
2 regularly by successful stylists and salons in Los Angeles County, California and
3 throughout the United States.

4

5

THE PERTINENT MOROCCANOIL PRODUCTS

6 16. MoroccanOil Oil Treatment, MoroccanOil's best selling product, is a
7 viscous mix of argan oil and other ingredients that is a golden colored oil
8 ("MoroccanOil Oil Treatment"). It is packaged in 3.4 fl. ounce, amber colored,
9 druggist-style tempered glass bottles with black screw-on caps. The turquoise,
10 rectangular-shaped front labels of the MoroccanOil Oil Treatment contain the
11 MoroccanOil logo with an orange-colored "M" and the word "MoroccanOil" in white,
12 capital letters vertically up the left hand side of the label. The labels also contain the
13 words "Oil treatment for all hair types," "MoroccanOil Series" and "alcohol free" in
14 English, French and Spanish. The turquoise, rectangular-shaped back labels of the
15 MoroccanOil Oil Treatment contain the MoroccanOil logo and the word "MoroccanOil"
16 in orange, capital letters, a description of the product and its usage in English, French
17 and Spanish, the ingredient list, and the words "sold exclusively by professional
18 salons." Each bottle of genuine MoroccanOil Oil Treatment includes a sticker that
19 extends from the top of the bottle cap down to the front of the bottle that includes the
20 MoroccanOil logo with an orange "M" with the word "MoroccanOil" through it in white
21 letters, and the words "The Original" in English and French. Each bottle of genuine
22 MoroccanOil Oil Treatment has MoroccanOil Trademarks on it.

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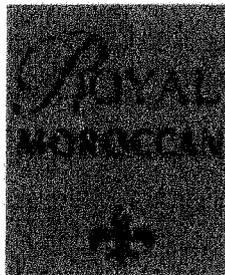
28

1 17. The following images are true and correct photographs of the front and
2 back sides of genuine Moroccanoil Oil Treatment.



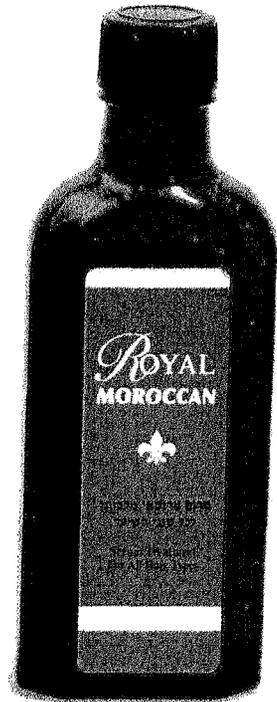
15
16 **DEFENDANTS' CONFUSINGLY SIMILAR PRODUCTS**

17 18. Defendants have applied for registration of a trademark in the United
18 States (application number 85023269) for “non-medicated hair treatment preparations
19 for cosmetic purposes made of serum for use in professional hair salons” (“Royal
20 Moroccan Application”). The trademark for which registration is sought in the Royal
21 Moroccan Application consists of the stylized wording “Royal Moroccan,” which is
22 located above a fleur-de-lis design, both in dark blue on a light blue background, as
23 shown below (the “ROYAL MOROCCAN” mark).



1 19. In the Royal Moroccan Application, Golan states under penalty of perjury
2 that he intends to use the applied for mark in commerce in the United States.

3
4 20. On information and belief, Defendants manufacture and distribute a
5 “serum treatment” hair care product bearing the mark ROYAL MOROCCAN in Israel
6 in the packaging depicted below (“Royal Moroccan Product”).



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22 21. On information and belief, Defendants made illegal and surreptitious
23 attempts to copy MoroccanOil Products, including demanding the trade secret formula
24 of the MoroccanOil Oil Treatment product from an employee of MoroccanOil Israel,
25 Ltd., the manufacturer of the goods sold by Plaintiff.

26
27 22. The Royal Moroccan Product is an imitation of MoroccanOil Oil
28 Treatment, with a similar but not identical appearance, feel and fragrance. The product

1 name, "Royal Moroccan Serum Treatment," the ROYAL MOROCCAN mark, and the
2 Royal Moroccan Product trade dress are confusingly similar to the Moroccanoil
3 trademarks and trade dress, and likely to confuse and mislead consumers and stylists to
4 believe that Defendants' Royal Moroccan Product is sponsored by or associated with
5 Plaintiff.

6
7 **Defendants' Distribution of Products in The United States**

8 23. On information and belief, Defendants operate a website available at
9 <http://www.RoyalMoroccan.com>, through which they offer to sell the Royal Moroccan
10 Product in the United States. The website solicits interested distributors to contact
11 Defendants to inquire about distributing the Royal Moroccan Product in the United
12 States. The Royal Moroccan Website copies many of the same design, layout, colors,
13 and other features of Moroccanoil's website.

14
15 24. Defendants market and distribute the Royal Moroccan Product in an
16 intentional attempt to unfairly capitalize on Moroccanoil's Trademarks, and the
17 goodwill and reputation of Moroccanoil Products. Defendants attempt to confuse
18 consumers into believing the Royal Moroccan Product is a Moroccanoil Product or is
19 affiliated with Moroccanoil.

20
21 25. The Royal Moroccan Product has no affiliation with Moroccanoil. The
22 Royal Moroccan Product is not covered by Moroccanoil's warranty, customer service
23 or its product liability coverage. The Defendants are not authorized or licensed to use
24 the Moroccanoil Trademarks or Trade Dress.

25
26 26. On information and belief, Defendants have known about Moroccanoil,
27 Moroccanoil Products and the Moroccanoil Trademarks since January 2007, when the
28

1 Moroccanoil Products bearing the Moroccanoil Trademarks were first used in
2 commerce in the United States.

3
4 27. The product name, trade dress and marketing efforts for the Royal
5 Moroccan Product has been created and used in such a way to create confusion in the
6 marketplace. On information and belief, the acts of Defendants were willful and were
7 committed with the knowledge that such imitation was intended to be used to cause
8 confusion, mistake or to deceive.

9
10 **FIRST CLAIM FOR RELIEF**
11 **DECLARATORY RELIEF**
12 **AGAINST ALL DEFENDANTS**

13 28. Plaintiff alleges and incorporates by reference each and every allegation
14 contained in Paragraphs 1 through 27, as if fully set forth herein.

15
16 29. A genuine dispute and controversy exists between the parties concerning
17 their respective rights, duties and obligations with respect to the Moroccanoil
18 Trademarks and Royal Moroccan Application.

19
20 30. The use by Defendants of the mark ROYAL MOROCCAN for the
21 specified goods is likely to create confusion with Moroccanoil as to the source of the
22 goods. The Moroccanoil Products and the goods specified in the Royal Moroccan
23 Application are nearly identical to the products which are sold by Moroccanoil.
24 Moroccanoil Products and the goods specified in Royal Moroccan Application are
25 advertised and sold in the same trade channels.

26
27 31. Moroccanoil requests the Court to declare that the mark ROYAL
28 MOROCCAN is likely to infringe and cause consumer confusion as to the source and

1 origin of the specified goods bearing the ROYAL MOROCCAN mark, and to confuse
2 consumers of ROYAL MOROCCAN products to falsely believe that the Defendants'
3 products are made by, associated with, or sponsored by Moroccanoil.

4
5 32. Moroccanoil has no adequate remedy at law. Monetary compensation will
6 not afford Moroccanoil adequate relief. Defendants' acts and omissions as alleged
7 herein will engender the need for a multiplicity of judicial proceedings and will cause
8 damages to Moroccanoil that are difficult, if not impossible, to measure. Unless
9 Defendants are ordered to refrain from committing the unlawful acts alleged, including
10 infringement of the Moroccanoil Trademarks, Moroccanoil will suffer irreparable harm.
11 Declaratory and injunctive relief is therefore appropriate pursuant to 15 U.S.C. § 1116
12 to prevent Defendants from engaging in any further violations of 15 U.S.C. §§ 1114
13 and 1125.

14
15 **SECOND CLAIM FOR RELIEF**
16 **FOR TRADEMARK INFRINGEMENT**
17 **(AGAINST INFRINGING DEFENDANTS)**

18 33. Moroccanoil alleges and incorporates by reference each and every
19 allegation contained in Paragraphs 1 through 27, as if fully set forth herein.

20
21 34. Moroccanoil owns the federally registered trademarks for the word
22 "Moroccanoil", Registration Nos. 3,478,807, M Moroccanoil Design No 3,684,909
23 (Vertical lettered Moroccanoil); and M Moroccanoil Design No. 3,684,910.
24 Defendants have infringed Moroccanoil's Trademarks by using the ROYAL
25 MOROCCAN mark for advertising, distribution and sale of the Royal Moroccan
26 Product without Moroccanoil's authorization.

1 35. Defendants' use of the ROYAL MOROCCAN Mark and their sale and
2 advertising of the Royal Moroccan Product have a substantial effect on interstate
3 commerce, and have caused confusion and mistake and are likely to continue to cause
4 confusion and mistake, and to deceive the public into believing that the ROYAL
5 MOROCCAN Marks and/or the Royal Moroccan Product originate with, are associated
6 with and/or authorized by Moroccanoil.

7
8 36. On information and belief, Defendants have committed these acts of
9 infringement with the intent to cause confusion and mistake and to deceive the public
10 into believing that the ROYAL MOROCCAN mark and/or the Royal Moroccan
11 Product originate with, are associated with and/or authorized by Moroccanoil.

12
13 37. Defendants' unlawful use of the ROYAL MOROCCAN mark, and their
14 sale and advertising of the Royal Moroccan Product constitute infringement in violation
15 of Section 32(a) of the Lanham Act, 15 U.S.C. § 1114(1).

16
17 38. On information and belief, Defendants, in engaging in the conduct
18 described herein, knowingly, intentionally and willfully intended to trade on the
19 reputation and goodwill of Moroccanoil, the Moroccanoil Trademarks and the
20 Moroccanoil Products, and to cause injury to Moroccanoil.

21
22 39. As a direct and proximate result of Defendants' unlawful acts alleged
23 herein, including infringement of the Moroccanoil Trademarks, Moroccanoil has
24 suffered and will continue to suffer injury to its business, goodwill and property.

25
26 40. Moroccanoil is entitled to recover from Defendants the damages it has
27 sustained and will sustain as a result of Defendants' wrongful conduct as alleged herein.
28 Moroccanoil is also entitled to recover from Defendants the gains, profits, and

1 advantages that Defendants have obtained as a result of the wrongful conduct alleged
2 herein. Moroccanoil is presently unable to ascertain the full extent of its damages, or
3 the gains, profits and advantages that Defendants have obtained by reason of their
4 wrongful conduct described herein.

5

6 41. Moroccanoil demands and is entitled to an accounting from each
7 Defendant, including all information necessary to permit Moroccanoil to determine the
8 gains, profits and advantages that Defendants have obtained by reason of their wrongful
9 conduct described herein.

10

11 42. Moroccanoil has no adequate remedy at law. Monetary compensation will
12 not afford Moroccanoil adequate relief. Defendants' acts and omissions as alleged
13 herein will engender the need for a multiplicity of judicial proceedings and will cause
14 damages to Moroccanoil that are difficult, if not impossible, to measure. Unless
15 Defendants are preliminarily and permanently enjoined from committing the unlawful
16 acts alleged including infringement of the Moroccanoil Trademarks, Moroccanoil will
17 continue to suffer irreparable harm. Injunctive relief is therefore appropriate pursuant
18 to 35 U.S.C. § 1116 to prevent Defendants from engaging in any further violations of
19 15 U.S.C. § 1114.

20

21

22

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24

**THIRD CLAIM FOR RELIEF
FOR FEDERAL TRADEMARK INFRINGEMENT
AND UNFAIR COMPETITION
(AGAINST INFRINGING DEFENDANTS)**

25

26

27

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43. Moroccanoil alleges and incorporates by reference each and every
allegation contained in Paragraphs 1 through 27, as if fully set forth herein.

1 44. Defendants' acts, including its acts of false advertising, trade dress
2 infringement and unfair competition are likely to cause confusion or to cause mistake or
3 to deceive as to the affiliation, sponsorship, or association of the Royal Moroccan
4 Product with Moroccanoil, or as to the origin, sponsorship or approval of the Royal
5 Moroccan Product by Moroccanoil. Defendants' conduct constitutes infringement of
6 Moroccanoil's unregistered trademarks and trade dress, as well as, unfair competition.
7 Such conduct is prohibited by 15 U.S.C. § 1125(a).

8
9 45. As a direct and proximate result of Defendants' unlawful acts as set forth
10 herein, including infringement of the Moroccanoil Trademarks and Moroccanoil Trade
11 Dress, and Defendants' unfair competition, Moroccanoil has suffered and will continue
12 to suffer injury to its business, goodwill and property.

13
14 46. As a proximate result of Defendants' wrongful conduct, Infringing
15 Defendants have been unjustly enriched while Moroccanoil has suffered damages of a
16 nature and in an amount according to proof at trial.

17
18 47. Moroccanoil is entitled to recover from Defendants the damages it has
19 sustained and will sustain as a result of Defendants' wrongful conduct as alleged herein.
20 Moroccanoil is also entitled to recover from Defendants the gains, profits, and
21 advantages that Defendants have obtained as a result of the wrongful conduct alleged
22 herein. Moroccanoil is presently unable to ascertain the full extent of its damages, or
23 the gains, profits and advantages that Defendants have obtained by reason of their
24 wrongful conduct described herein.

25
26 48. Moroccanoil demands and is entitled to an accounting from each
27 Defendant, including all information necessary to permit Moroccanoil to determine the
28

1 gains, profits and advantages that Defendants have obtained by reason of their wrongful
2 conduct described herein.

3
4 49. Moroccanoil has no adequate remedy at law. Monetary compensation will
5 not afford Moroccanoil adequate relief. Defendants' acts and omissions as alleged
6 herein will engender the need for a multiplicity of judicial proceedings and will cause
7 damages to Moroccanoil that are difficult, if not impossible, to measure. Unless
8 Defendants are preliminarily and permanently enjoined from committing the unlawful
9 acts alleged, including infringement of the Moroccanoil Trademarks, Moroccanoil will
10 continue to suffer irreparable harm. Injunctive relief is therefore appropriate pursuant
11 to 35 U.S.C. § 1116 to prevent Defendants from engaging in any further violations of
12 15 U.S.C. § 1125(a).

13
14 50. Defendants' acts and omissions as alleged herein were committed
15 knowingly, intentionally and willfully with the intent to trade on Moroccanoil's
16 goodwill in the Moroccanoil Products, the Moroccanoil Trademarks and trade dress.
17 As such, this is an exceptional case within the meaning of 15 U.S.C. § 1117(a) and
18 damages should be trebled and attorneys' fees awarded.

19
20 **PRAYER**

21 WHEREFORE, Moroccanoil prays for an award as follows:

22
23 1. For an adjudication that the mark ROYAL MOROCCAN is likely to
24 infringe and cause confusion in respect of the Moroccanoil Trademarks for the goods
25 specified in the Royal Moroccan Application;

26
27 2. For adjudication that Royal Moroccan's trade dress is likely to infringe
28 and cause confusion in respect of the Moroccanoil Trade Dress for hair care goods;

1 3. For a preliminary and permanent injunction requiring Defendants to
2 abandon its Trademark Application for ROYAL MOROCCAN or from using the mark
3 ROYAL MOROCCAN on any of the specified goods in commerce;

4
5 4. For preliminary and permanent injunctive relief against all Defendants,
6 and each of them, and their officers, agents, attorneys, representatives and assigns, and
7 all persons acting in active concert or participation with them, from doing any of the
8 following acts, either directly or indirectly, and from doing any act prefatory to the
9 prohibited acts:

10
11 a. Using any of Moroccanoil's Trademarks, in a manner prohibited by
12 law or regulation;

13
14 b. Otherwise infringing any trademark, trade dress or other intellectual
15 property right owned or controlled by Moroccanoil;

16
17 c. Causing a likelihood of confusion, deception, or mistake as to the
18 source, nature, or quality of Moroccanoil's goods or causing confusion, deception or
19 mistake as to the source, nature or quality of Defendants' goods;

20
21 d. Using any false designation of origin or false representation
22 concerning any of Defendants' goods;

23
24 e. Violating any statute, decision, rule or regulation of any
25 governmental entity in the course of the offering, disposition or sales of any of the
26 Royal Moroccan Product;

1 f. Soliciting, assisting, aiding or abetting any other person or business
2 entity in engaging in or performing any of the activities referred to in the above
3 subparagraphs "a" through "e".

4
5 5. For an order directing Defendants, and each of them, to file with this Court
6 and serve on MoroccanOil within 30 days after service of an injunction, a report in
7 writing under oath, setting forth in detail the manner and form in which Defendants
8 have complied with the injunction;

9
10 6. For an order requiring Defendants, and each of them, to deliver to
11 MoroccanOil all products, literature, advertising, and other material bearing any
12 infringing trademarks or a use of any trademark constituting federal, California state or
13 common law unfair competition;

14
15 7. For an order requiring Defendants to account for all sales and transfers of
16 any of the Royal Moroccan Product, including an order that they submit to MoroccanOil
17 immediately all records of all purchases, sales, and other materials pertaining to the
18 acquisition and distribution of the Royal Moroccan Product;

19
20 8. For an accounting from each Defendant of all profits, monies and
21 advantages that Defendants have obtained by reason of their wrongful conduct;

22
23 9. For an award of money damages in the amount of at least \$2,000,000
24 pursuant to the remedies as provided by 15 U.S.C. §§ 1116, 1117; 1125; and all other
25 statutory and common law bases;

26
27 10. For damages in an amount according to proof at trial and trebled as
28 permitted by law;

1 11. For an order requiring that all gains, profits, or advantages derived by
2 Defendants by their wrongful conduct be disgorged to Moroccanoil to the fullest extent
3 allowed by law;

4
5 12. For punitive and exemplary damages in an amount sufficient to punish
6 defendants and defer such conduct in the future;

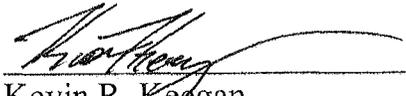
7
8 13. For attorneys' fees;

9
10 14. For costs; and

11
12 For such other and further relief as the Court deems just and proper.

13
14 Dated: January 20, 2012

William C. Conkle
Mark C. Riedel
Kevin R. Keegan, members of
CONKLE, KREMER & ENGEL
Professional Law Corporation

15
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17
18
19 By: 
20 Kevin R. Keegan
21 Attorneys for Plaintiff Moroccanoil, Inc.
22
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DEMAND FOR JURY TRIAL

Plaintiff, MoroccanOil, Inc., demands trial by jury of all triable issues.

Dated: January 20, 2012

William C. Conkle
Mark C. Riedel
Kevin R. Keegan, members of
CONKLE, KREMER & ENGEL
Professional Law Corporation

By: 

Kevin R. Keegan
Attorneys for Plaintiff MoroccanOil, Inc.

1 **PROOF OF SERVICE**

2 **STATE OF CALIFORNIA, COUNTY OF LOS ANGELES**

3 At the time of service, I was over 18 years of age and **not a party to this action.**
4 I am employed in the County of Los Angeles, State of California. My business address
is 3130 Wilshire Boulevard, Suite 500, Santa Monica, California 90403-2351.

5 On January 26, 2012, I served true copies of the following document(s) described
6 as **MOROCCANOIL'S FIRST AMENDED COMPLAINT** on the interested parties
in this action as follows:

7 Michael N. Cohen, Esq.
8 COHEN I. P. LAW GROUP, P.C.
9 9025 Wilshire Blvd., Suite 301
Beverly Hills, CA 90211
10 Phone: 310-288-4500
11 Fax: 310-246-9980
12 Email: *michael@patentlawip.com*

13 **BY OVERNIGHT DELIVERY:** I enclosed said document(s) in an envelope or
14 package provided by the overnight service carrier and addressed to the persons at the
15 addresses listed in the Service List. I placed the envelope or package for collection and
overnight delivery at an office or a regularly utilized drop box of the overnight service
carrier or delivered such document(s) to a courier or driver authorized by the overnight
service carrier to receive documents.

16 I declare under penalty of perjury under the laws of the United States of America
17 that the foregoing is true and correct and that I am employed in the office of a member
of the bar of this Court at whose direction the service was made.

18 Executed on January 26, 2012, at Santa Monica, California.

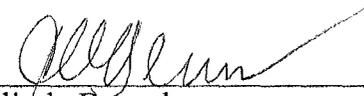
19
20 
21 Erlinda Bernabe
22
23
24
25
26
27
28

Exhibit 4

1 COHEN I.P. LAW GROUP, P.C.
2 Michael N. Cohen (Cal. Bar. No. 225348)
3 9025 Wilshire Blvd., Suite 301
4 Beverly Hills, California 90211
5 Tel: 310-288-4500
6 Fax: 310-246-9980
7 michael@patentlawip.com

8 Attorneys for Defendant,
9 YAIR GOLAN

10
11 **UNITED STATES DISTRICT COURT**
12 **FOR THE CENTRAL DISTRICT OF CALIFORNIA**

13 MOROCCANOIL, a California
14 Corporation,

15 Plaintiff,

16 vs.

17 YAIR GOLAN, an individual; GIDON
18 ZAFT, an individual; ROYAL
19 MOROCCAN, CORP. a Florida
20 corporation; Y.P. GOLAN TRADE, LTD.
21 An Israeli entity; and DOES 1-10,
22 inclusive,

23 Defendants.

Case No.: CV-11-01974 SJO(JEMx)

**YAIR GOLAN'S ANSWER TO
AMENDED COMPLAINT**

24 Defendant YAIR GOLAN, ("Y.P.") hereby answers the First Amended
25 Complaint of Plaintiff as follows:

26 **JURISDICTION**

27 1. Answering Paragraph 1, admitted.

28 **VENUE**

1. Answering Paragraph 2, admitted.

THE PLAINTIFF

3. Answering Paragraph 3, Y.P. lacks information sufficient to form a belief as

1 to the truth of said allegations and, on that basis, denies each and every
2 allegation contained therein.

3 **THE DEFENDANTS**

- 4 4. Answering Paragraph 4, Y.P. admits that he is not a citizen of the United
5 States and that he resides in Israel. As to all other allegations of paragraph 4,
6 denied.
- 7 5. Answering Paragraph 5, Y.P. lacks information sufficient to form a belief as
8 to the truth of said allegations and, on that basis, denies each and every
9 allegation contained therein.
- 10 6. Answering Paragraph 6, Y.P. lacks information sufficient to form a belief as
11 to the truth of the allegations in regards to the address and business of Royal
12 Moroccan Corp. In regards to www.royalmoroccan.com, Y.P. denies that
13 Defendant Royal Moroccan Corp, is the owner of the website.
- 14 7. Answering Paragraph 7, admitted.
- 15 8. Answering Paragraph 8, Y.P. lacks information sufficient to form a belief as
16 to the truth of said allegations and, on that basis, denies each and every
17 allegation contained therein.
- 18 9. Answering Paragraph 9, Y.P. lacks information sufficient to form a belief as
19 to the truth of said allegations and, on that basis, denies each and every
20 allegation contained therein.
- 21 10. Answering Paragraph 10, Y.P. denies each and every allegation contained
22 therein. In regards to the acts of other defendants, Y.P. lacks information
23 sufficient to form a belief as to the truth of said allegations and, on that basis,
24 denies each and every allegation contained therein.
- 25 11. Answering Paragraph 11, Y.P. denies each and every allegation contained
26 therein. In regards to the acts of other defendants, Y.P. lacks information
27 sufficient to form a belief as to the truth of said allegations and, on that basis,
28 denies each and every allegation contained therein.

1 **MOROCCAN'S INTELLECTUAL PROPERTY AND PRODUCTS**

2 12. Answering Paragraph 12, Y.P. lacks information sufficient to form a belief as
3 to the truth of said allegation of Moroccan oil distribution. However, Y.P.
4 denies Moroccan oil's characterization of the use of "argan oil" as its
5 "signature ingredient". Y.P. admits that Argan oil is produced from the nut
6 kernel of the argan tree native to the Mediterranean.

7 13. Answering Paragraph 13, Y.P. lacks information sufficient to form a belief as
8 to the truth of said allegation in regards to Moroccan oil's use of its alleged
9 trademarks. Y.P. admits that Moroccan oil has a trademark registration with
10 the United State Patent and Trademark in Class 3. However, Y.P. denies
11 each and every other allegation contained therein.

12 14. Answering Paragraph 14, Y.P. lacks information sufficient to form a belief as
13 to the truth of said allegations and, on that basis, denies each and every
14 allegation contained therein.

15 15. Answering Paragraph 15, Defendants denies each and every allegation
16 contained therein.

17 **THE PERTINENT MOROCCANOIL PRODUCTS**

18 16. Answering Paragraph 16, Y.P. lacks information sufficient to form a belief as
19 to the truth of said allegations and, on that basis, denies each and every
20 allegation contained therein.

21 17. Answering Paragraph 17, Y.P. lacks information sufficient to form a belief as
22 to the truth of said allegations and, on that basis, denies each and every
23 allegation contained therein.

24 **DEFENDANTS' CONFUSINGLY SIMILARY PRODUCTS**

25 18. Answering Paragraph 18, admitted.

26 19. Answering Paragraph 19, admitted.

27 20. Answering Paragraph 20, Y.P. admits that it distributes a product bearing the
28 mark ROYAL MOROCCAN.

1 21. Answering Paragraph 21, Y.P. denies each and every allegation contained
2 therein.

3 22. Answering Paragraph 22, Y.P. denies each and every allegation contained
4 therein.

5 23. Answering Paragraph 23, Y.P. admits it operates a website at
6 <http://www.royalmoroccan.com>. As to all other allegations of Paragraph 23,
7 Y.P. denies.

8 24. Answering Paragraph 24, Y.P. denies each and every allegation contained
9 therein.

10 25. Answering Paragraph 25, admitted.

11 26. Answering Paragraph 26, Y.P. denies each and every allegation contained
12 therein.

13 27. Answering Paragraph 27, Y.P. denies each and every allegation contained
14 therein.

15 **FIRST CLAIM FOR RELIEF DECLARATORY RELIEF**

16 28. Y.P. incorporates all previous responses to the above paragraphs as if fully
17 recited here.

18 29. Answering Paragraph 29, admitted.

19 30. Answering Paragraph 30, Y.P. denies each and every allegation contained
20 therein.

21 31. Answering Paragraph 31, Y.P. denies each and every allegation contained
22 therein.

23 32. Answering Paragraph 32, Y.P. denies each and every allegation contained
24 therein.

25 **SECOND CLAIM FOR RELIEF FOR TRADEMARK**
26 **INFRINGEMENT**

27 33. Y.P. incorporates all previous responses to the above paragraphs as if fully
28 recited here.

1 34. Answering Paragraph 34, Y.P. admits that Moroccanoil owns certain
2 registered trademarks. As to all other allegations of Paragraph 34, denied.

3 35. Answering Paragraph 35, Y.P. denies each and every allegation contained
4 therein.

5 36. Answering Paragraph 36, Y.P. denies each and every allegation contained
6 therein.

7 37. Answering Paragraph 37, Y.P. denies each and every allegation contained
8 therein.

9 38. Answering Paragraph 38, Y.P. denies each and every allegation contained
10 therein.

11 39. Answering Paragraph 39, Y.P. denies each and every allegation contained
12 therein.

13 40. Answering Paragraph 40, Y.P. denies each and every allegation contained
14 therein.

15 41. Answering Paragraph 41, Y.P. denies each and every allegation contained
16 therein.

17 42. Answering Paragraph 42, Y.P. denies each and every allegation contained
18 therein.

19 **THIRD CLAIM FOR RELIEF FOR FEDERAL TRADEMARK**
20 **INFRINGEMENT AND UNFAIR COMPETITION**

21 43. Y.P. incorporates all previous responses to the above paragraphs as if fully
22 recited here.

23 44. Answering Paragraph 44, Y.P. denies each and every allegation contained
24 therein.

25 45. Answering Paragraph 45, Y.P. denies each and every allegation contained
26 therein.

27 46. Answering Paragraph 46, Y.P. denies each and every allegation contained
28 therein.

1 47. Answering Paragraph 47, Y.P. denies each and every allegation contained
2 therein.

3 48. Answering Paragraph 48, Y.P. denies each and every allegation contained
4 therein.

5 49. Answering Paragraph 49, Y.P. denies each and every allegation contained
6 therein.

7 50. Answering Paragraph 50, Y.P. denies each and every allegation contained
8 therein.

9

10 **AFFIRMATIVE DEFENSES**

11 **First Affirmative Defense**

12 (Failure to State a Claim, FRCP 12(b)(6))

13

14 As a separate and first affirmative defense to the Complaint, and to the
15 purported causes of action set forth therein, Y.P. allege that the Complaint fails to
16 state facts sufficient to constitute a cause of action.

17

18 **Second Affirmative Defense**

19 (Estoppel)

20 As a separate and first affirmative defense to the Complaint, and to the
21 purported causes of action set forth therein,
22

23 **Third Affirmative Defense**

24 (Waiver)

25

26 The Complaint, and each and every claim alleged therein, is barred by the
27 doctrine of waiver.

28

1 Plaintiff cannot establish any statutory or other basis for the recovery of attorneys'
2 fees.

3 **Ninth Affirmative Defense**

4
5 **(Failure to State a Claim for Exemplary or Punitive Damages)**

6 The Complaint, and each and every claim alleged therein, fails to support a
7 claim for an award of exemplary or punitive damages against Y.P.

8
9 **Tenth Affirmative Defense**

10 (No Injury or Damage)

11 The Complaint, and each and every claim alleged therein, is barred because
12 Y.P. alleges that Plaintiff has not been injured or damaged as a proximate result of
13 any act or omission for which Y.P. is responsible.

14
15 **Eleventh Affirmative Defense**

16 (No Bad Faith Intent To Profit)

17 Plaintiff's claims are barred insofar as Y.P. never had any bad faith intent to
18 profit from any use of Plaintiff's claimed trademark.

19
20 **Twelfth Affirmative Defense**

21 (Fraud in the Procurement)

22 Plaintiff's Complaint, and each and every cause of action therein, and all of
23 it, is barred because Plaintiff fraudulently procured the trademark registrations.

24
25 **Thirteenth Affirmative Defense**

26 (Invalid Trademark)

1 Plaintiff's Complaint, and each and every cause of action therein, and all of
2 it, is barred because Plaintiff's purported trademark registrations are invalid.

3 **Fourteenth Affirmative Defense**

4 (Failure to Mitigate Damages)

5
6 Plaintiff has failed to make reasonable efforts to mitigate its damages, if any,
7 in whole or in part. Plaintiff's recovery, if any, against Y.P. is barred by Plaintiff's
8 failure to mitigate the damages alleged in Plaintiff's Complaint. If not completely
9 barred, Plaintiff's recovery against Y.P. must be reduced to the extent to which
10 Plaintiff's damages, if any, were caused by Plaintiff's failure to mitigate their
11 damages properly.
12
13

14 **Fifteenth Affirmative Defense**

15 (DOES)

16
17 Y.P. alleges, that it is not legally responsible for the acts and/or omissions of
18 those Defendants named herein as DOES.
19
20

21 **Sixteenth Affirmative Defense**

22 (Reservation of Right to Amend)

23
24 The Y.P. reserves the right to amend this Answer to assert any and all
25 additional claims and defenses when, and if warranted, in the course of further
26 discovery, investigation, and/or preparation for trial.
27
28

WHEREFORE, Y.P. prays for judgment as follows:

1. That Plaintiff takes nothing by way of its Complaint;
 2. That the Complaint be dismissed;
 3. That Y.P. is awarded its costs of suit incurred herein;
 4. That Plaintiff's fraudulently obtained trademark registrations be cancelled;
 5. That Y.P. be awarded its reasonable attorneys' fees incurred herein;
- and
6. For such other and further relief as the Court deems just and proper.

DEMAND FOR JURY TRIAL

Pursuant to Rule 38(b) of the Federal Rules of Civil Procedure, Y.P. respectfully requests a trial by jury of any and all issues on which a trial by jury is available under applicable law.

Cohen I.P. Law Group, P.C.

Date: February 13, 2012

By: /s/ Michael N. Cohen
Michael N. Cohen
Attorneys for YAIR GOLAN

1 PROOF OF SERVICE

2 STATE OF CALIFORNIA, COUNTY OF LOS ANGELES

3 At the time of service, I was over 18 years of age and **not a party to this action.**
4 I am employed in the County of Los Angeles, State of California. My business address
is 3130 Wilshire Boulevard, Suite 500, Santa Monica, California 90403-2351.

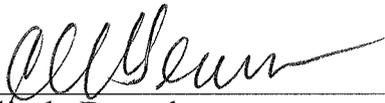
5 On March 9, 2012, I served true copies of the following document(s) described
6 as **MOROCCANOIL, INC.'S MOTION TO SUSPEND** on the interested parties in
this action as follows:

7 Michael N. Cohen, Esq.
8 Cohen I.P. Law Group, P.C.
9 9025 Wilshire Blvd., Suite 301
Beverly Hills, CA 90211
Phone: (310) 288-4500
Fax: (310) 246-9980

10
11 **BY OVERNIGHT DELIVERY:** I enclosed said document(s) in an envelope or
12 package provided by the overnight service carrier and addressed to the persons at the
addresses listed in the Service List. I placed the envelope or package for collection and
13 overnight delivery at an office or a regularly utilized drop box of the overnight service
carrier or delivered such document(s) to a courier or driver authorized by the overnight
14 service carrier to receive documents.

15 I declare under penalty of perjury under the laws of the State of California that
the foregoing is true and correct.

16 Executed on March 9, 2012, at Santa Monica, California.

17
18 
19 _____
20 Erlinda Bernabe
21
22
23
24
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26
27
28