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MADONNA LOUISE VERONICA CICCONE,

8 MATERIAL GIRL BRAND, LLC, MG ICON, LLC

and MACY'S RETAIL HOLDINGS, INC.

9
10 **UNITED STATES DISTRICT COURT**
11 **CENTRAL DISTRICT OF CALIFORNIA**
12 **WESTERN DIVISION**
13

14 L.A. TRIUMPH, INC., a California
15 corporation,

16 Plaintiff,

17 vs.

18
19 MADONNA LOUISE VERONICA
CICCONE, an individual; MATERIAL
20 GIRL BRAND, LLC, a Delaware limited
liability company; MG ICON, a Delaware
21 limited liability company; MACY'S
RETAIL HOLDINGS, INC., a Delaware
22 corporation; and DOES 1 through 10,

23 Defendants.
24

CASE NO. CV 10 6195-SJO (JCx)

**DEFENDANTS MATERIAL GIRL
BRAND, LLC AND MG ICON'S
ANSWER TO FIRST AMENDED
COMPLAINT**

DEMAND FOR JURY TRIAL

1 Defendants Material Girl Brand, LLC, now known as MG Icon, LLC (“MG Icon”)
2 (collectively “Defendants”), for themselves alone, hereby answer Plaintiff L.A. Triumph,
3 Inc.’s (“L.A. Triumph”) First Amended Complaint (“FAC”) as follows:

4 **JURISDICTION AND VENUE**

5 1. Answering paragraph 1, Defendants admit that this Court has jurisdiction
6 over these federal question trademark claims under the Lanham Act.

7 2. Answering paragraph 2, Defendants admit that venue is proper in this
8 District.

9 **PARTIES**

10 3. Defendants lack sufficient information and belief to answer the allegations
11 of paragraph 3 and, therefore, deny each and every allegation therein.

12 4. Answering paragraph 4, Defendants admit and allege that Defendant
13 Material Girl Brand, LLC is a Delaware limited liability company. In 2010, Material
14 Girl Brand LLC changed its name to MG Icon, LLC. Defendants lack sufficient
15 information or belief to answer the other allegations of paragraph 4 and, therefore, deny
16 those other allegations.

17 5. Defendant MG Icon admits the allegations in paragraph 5.

18 6. Answering paragraph 6, Defendants lack sufficient information or belief to
19 answer the allegation that Madonna resides in New York, New York and, on that basis,
20 denies said allegations. Defendants deny the other allegations of paragraph 6.

21 7. Defendants lack sufficient information and belief to answer the allegations
22 of paragraph 7 and, therefore, deny each and every allegation therein.

23 8. Defendants deny the allegations of paragraph 8.

24 **FACTS COMMON TO ALL COUNTS**

25 9. Defendants lack sufficient information or belief to answer the allegations of
26 paragraph 9 of the FAC and, therefore, deny each and every allegation therein.

27 10. Defendants lack sufficient information or belief to answer the allegations of
28 paragraph 10 of the FAC and, therefore, deny each and every allegation therein.

1 11. Answering paragraph 11, Defendants admit that the public record discloses
2 that there was a trademark registration filed by O.C. Mercantile with the California
3 Secretary of State, No. 102808, for "Material Girl" on about August 5, 1997, but allege
4 that said trademark registration expired on or about August 5, 2007. Except as expressly
5 admitted and alleged herein, Defendants lack sufficient information or belief to answer
6 the other allegations of paragraph 11 and, therefore, deny said allegations.

7 12. Defendants lack sufficient information or belief to answer the allegations of
8 paragraph 12 of the FAC and, therefore, deny each and every allegation therein.

9 13. Defendants lack sufficient information or belief to answer the allegations of
10 paragraph 13 of the FAC and, therefore, deny each and every allegation therein.

11 14. Defendants lack sufficient information or belief to answer the allegations of
12 paragraph 14 of the FAC and, therefore, deny each and every allegation therein.

13 15. Defendants lack sufficient information or belief to answer the allegations of
14 paragraph 15 of the FAC and, therefore, deny each and every allegation therein.

15 16. Defendants deny the allegations of paragraph 16.

16 17. Answering paragraph 17, Defendants admit and allege that MG Icon in 2010
17 has been involved in selling a line of juniors' clothing for young women utilizing the
18 mark "Material Girl" including through Macy's. Except as expressly admitted and
19 alleged herein, Defendants deny the other allegations of paragraph 17.

20 18. Defendants lack sufficient information or belief to answer the allegations of
21 paragraph 18 and, therefore, deny each and every allegation therein.

22 19. Answering paragraph 19, Defendants admit that Material Girl Brand, LLC,
23 now known as MG Icon, LLC, filed a United States Trademark Application on
24 December 4, 2009 for the "Material Girl" mark for clothing in international class 025 and
25 other classes under application No. 77/886,045. Except as expressly admitted and
26 alleged herein, Defendants deny the other allegations of paragraph 19.

27 20. Answering paragraph 20, Defendants admit that MG Icon obtained certain
28 rights to the "Material Girl" name, and that MG Icon, among others, is responsible for

1 manufacturing the “Material Girl” line of juniors’ clothing. Except as expressly admitted
2 and alleged herein, Defendants deny the other allegations of paragraph 20.

3 21. Answering paragraph 21, Defendants admit and allege that Macy’s is a
4 retailer currently selling, advertising, and promoting the “Material Girl” line of juniors’
5 clothing. Except as expressly admitted and alleged herein, Defendants deny the other
6 allegations of paragraph 21.

7 22. Defendants deny the allegations of paragraph 22.

8 **ANSWER TO FIRST CLAIM FOR RELIEF**

9 **(Declaratory Relief against MGB, Madonna, and MG Icon under 28 U.S.C. § 2201)**

10 23. Answering paragraph 23, Defendants incorporate by reference paragraphs 1
11 through 22, inclusive, of this Answer as if set forth in full herein.

12 24. Answering paragraph 24, Defendants admit and allege that MG Icon
13 contends that it has the right to use the “Material Girl” mark in clothing, and that
14 Material Girl Brand, LLC, now known as MG Icon, LLC, filed an application for, and is
15 entitled to, a federal trademark registration for the “Material Girl” mark for, *inter alia*,
16 class 025 clothing. Defendants also admit and allege that MG Icon contends that
17 Plaintiff has no right to interfere with MG Icon’s use of, and application to register, the
18 “Material Girl” mark. Except as expressly admitted and alleged herein, Defendants lack
19 sufficient information or belief to answer the other allegations of paragraph 24 and,
20 therefore, deny those allegations.

21 25. Defendants deny the allegations of paragraph 25.

22 **ANSWER TO SECOND CLAIM FOR RELIEF**

23 **(Violation of Lanham Act § 43(a) against MGB and DOES 1-10)**

24 26. Answering paragraph 26, Defendants incorporate by reference paragraphs 1
25 through 25, inclusive, of this Answer as if set forth in full herein.

26 27. Defendants lack sufficient information or belief to answer the allegations of
27 paragraph 27 of the FAC and, therefore, deny said allegations.

1 28. Defendants lack sufficient information or belief to answer the allegations of
2 paragraph 28 of the FAC as to Plaintiff and, therefore, deny said allegations.

3 29. Answering paragraph 29, Defendants admit and allege that MG Icon and/or
4 Macy's has in 2010 and continues to advertise, distribute and sell certain clothing using
5 the name Material Girl. Defendants lack sufficient information or belief to answer the
6 other allegations of paragraph 29 of the FAC and, therefore, deny said allegations.

7 30. Defendants deny the allegations of paragraph 30.

8 31. Defendants deny the allegations of paragraph 31.

9 32. Defendants deny the allegations of paragraph 32.

10 **AFFIRMATIVE DEFENSES**

11 **FIRST AFFIRMATIVE DEFENSE**

12 **(Failure to State a Claim for Relief)**

13 1. Plaintiff's FAC, and each claim for relief therein, fails to state facts
14 sufficient to constitute a claim for relief against Defendants.

15 **SECOND AFFIRMATIVE DEFENSE**

16 **(Prior Use)**

17 2. Defendants or their predecessors in interest have used the "Material Girl"
18 mark since in or about 1985, which is more than a decade before Plaintiff's alleged use.

19 **THIRD AFFIRMATIVE DEFENSE**

20 **(Abandonment)**

21 3. Plaintiff's registration of the "Material Girl" mark was limited to the State of
22 California, expired on or about August 5, 2007, and has been abandoned by Plaintiff.

23 **FOURTH AFFIRMATIVE DEFENSE**

24 **(No Likelihood of Confusion)**

25 4. Defendants contend that Plaintiff's uses of the "Material Girl" name and
26 trademark were and are improper. In any event, there is no likelihood of confusion for
27 the public due to Defendants' uses of the "Material Girl" name and mark; indeed, it is
28 Plaintiff's use of the name and mark which is likely to cause confusion for the public.

1 **FIFTH AFFIRMATIVE DEFENSE**

2 **(Fair Use)**

3 5. Plaintiff's claims are barred under the doctrine of fair use because
4 Defendants' use of the name "Material Girl" includes using the name to identify the
5 person endorsing MG Icon's business, i.e. Madonna, who popularized the name
6 "Material Girl," and gave it secondary meaning; Defendants' use of the "Material Girl"
7 name and mark does not describe or capitalize on plaintiff's use of "Material Girl."

8 **SIXTH AFFIRMATIVE DEFENSE**

9 **(Laches)**

10 6. Plaintiff has failed for over 15 years to raise any issues with or contest
11 Defendants' predecessors-in-interest's uses of the "Material Girl" name and mark and
12 Plaintiff's FAC is thus barred under the doctrine of laches.

13 **SEVENTH AFFIRMATIVE DEFENSE**

14 **(Estoppel)**

15 7. Plaintiff's FAC is barred under the doctrine of estoppel. For example, when
16 Defendants did their due diligence on the "Material Girl" trademark for registration
17 purposes, there was no federal registration by Plaintiff, and the California registration had
18 expired and was abandoned; Defendants reasonably relied on this fact in applying to
19 register and in using the "Material Girl" mark in the retail clothing applications alleged in
20 the FAC. Furthermore, Plaintiff over the years never contacted Defendants, or their
21 related parties or representatives, to make any claims or complaints with respect to the
22 "Material Girl" name.

23 **EIGHTH AFFIRMATIVE DEFENSE**

24 **(Misrepresentations and Fraud Re Plaintiff's Trademark Registration)**

25 8. Defendants are informed and believe, and thereon allege, that Plaintiff
26 procured its California trademark registration for "Material Girl" based on misstatements,
27 omissions of fact, misrepresentations and/or fraud including, without limitation,
28 representing in 1997 that to Plaintiff's, or Plaintiff's predecessor O.C. Mercantile's, best

1 knowledge and belief, no other person, firm or corporation had the right to use such mark
2 in California, either in identical form or in such near resemblance thereto as might be
3 calculated to deceive or confuse.

4 **NINTH AFFIRMATIVE DEFENSE**

5 **(Unclean Hands)**

6 9. Plaintiff's FAC is barred under the doctrine of unclean hands due to
7 Plaintiff's own inequitable conduct with respect to this matter.

8 **TENTH AFFIRMATIVE DEFENSE**

9 **(No Damages)**

10 10. Plaintiff has suffered no damages as a result of Defendants' uses of the
11 "Material Girl" name and mark; indeed, Plaintiff, on information and belief, may have
12 benefited from Defendants' use of the "Material Girl" name.

13 **ELEVENTH AFFIRMATIVE DEFENSE**

14 **(Sham Litigation)**

15 11. Plaintiff's FAC constitutes sham litigation filed for an improper purpose to
16 interfere with and suppress fair competition.

17 **TWELFTH AFFIRMATIVE DEFENSE**

18 **(Statute of Limitations)**

19 12. Plaintiff's FAC, and each claim for relief therein, is barred by the applicable
20 statutes of limitations.

21 WHEREFORE, defendants Material Girl Brand, LLC and MG Icon, LLC pray for
22 relief as follows:

- 23 1. That plaintiff take nothing on its First Amended Complaint, and that this
24 action be dismissed with prejudice;
- 25 2. For attorney's fees as allowed by law;
- 26 3. For their costs of suit herein; and
- 27 4. For such further and other relief as the Court deems just and proper.
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1 Dated: October 29, 2010

GREENBERG TRAURIG, LLP

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By: /s/ George M. Belfield

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GEORGE M. BELFIELD

Attorneys for Defendants

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MADONNA LOUISE VERONICA

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CICCONE, MATERIAL GIRL BRAND,

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LLC, MG ICON, LLC and

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MACY'S RETAIL HOLDINGS, INC.

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DEMAND FOR JURY TRIAL

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Defendants Material Girl Brand, LLC and MG Icon, LLC hereby demand a trial by

13

jury.

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Dated: October 29, 2010

GREENBERG TRAURIG, LLP

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By: /s/ George M. Belfield

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GEORGE M. BELFIELD

Attorneys for Defendants

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MADONNA LOUISE VERONICA

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CICCONE, MATERIAL GIRL BRAND,

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MACY'S RETAIL HOLDINGS, INC.

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