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MADONNA LOUISE VERONICA CICCONE,

8 MATERIAL GIRL BRAND, LLC, MG ICON, LLC

9 and MACY'S RETAIL HOLDINGS, INC.

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

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

16  
17 Plaintiff,

18 vs.

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  
24 Defendants.

CASE NO. CV 10 6195-SJO (JCx)

**DEFENDANT MACY'S RETAIL  
HOLDINGS, INC.'S ANSWER TO  
FIRST AMENDED COMPLAINT**

**DEMAND FOR JURY TRIAL**

1 Defendant Macy's Retail Holdings, Inc. ("Macy's"), for itself alone, hereby  
2 answers Plaintiff L.A. Triumph, Inc.'s ("L.A. Triumph") First Amended Complaint  
3 ("FAC") as follows:

4 **JURISDICTION AND VENUE**

5 1. Answering paragraph 1 of the FAC, Macy's admits that this Court has  
6 jurisdiction over these federal question trademark claims under the Lanham Act.

7 2. Answering paragraph 2, Macy's admits that venue is proper in this District.

8 **PARTIES**

9 3. Macy's lacks sufficient information and belief to answer the allegations of  
10 paragraph 3 and, therefore, denies each and every allegation therein.

11 4. Macy's lacks sufficient information or belief to answer the allegations of  
12 paragraph 4 and, therefore, denies each and every allegation therein.

13 5. Macy's lacks sufficient information or belief to answer the allegations of  
14 paragraph 5 and, therefore, denies each and every allegation therein.

15 6. Macy's lacks sufficient information and belief to answer the allegations of  
16 paragraph 6 and, therefore, denies each and every allegation therein.

17 7. Answering paragraph 7, Macy's admits and alleges that it is a corporation  
18 existing under the laws of New York with its principal place of business in Cincinnati,  
19 Ohio. Macy's further admits and alleges that it operates retail department stores in  
20 California and other parts of the United States.

21 8. Macy's denies the allegations of paragraph 8.

22 **FACTS COMMON TO ALL COUNTS**

23 9. Macy's lacks sufficient information or belief to answer the allegations of  
24 paragraph 9 and, therefore, denies each and every allegation therein.

25 10. Macy's lacks sufficient information or belief to answer the allegations of  
26 paragraph 10 and, therefore, denies each and every allegation therein.

27 11. Answering paragraph 11, Macy's admits that the public record discloses that  
28 there was a trademark registration filed by O.C. Mercantile with the California Secretary

1 of State, No. 102808, for "Material Girl" on about August 5, 1997, but allege that said  
2 trademark registration expired on or about August 5, 2007. Except as expressly admitted  
3 and alleged herein, Macy's lacks sufficient information or belief to answer the other  
4 allegations of paragraph 11 and, therefore, denies said allegations.

5 12. Macy's lacks sufficient information or belief to answer the allegations of  
6 paragraph 12 and, therefore, denies each and every allegation therein.

7 13. Macy's lacks sufficient information or belief to answer the allegations of  
8 paragraph 13 and, therefore, denies each and every allegation therein.

9 14. Macy's lacks sufficient information or belief to answer the allegations of  
10 paragraph 14 and, therefore, denies each and every allegation therein.

11 15. Macy's lacks sufficient information or belief to answer the allegations of  
12 paragraph 15 and, therefore, denies each and every allegation therein.

13 16. Macy's denies the allegations of paragraph 16.

14 17. Answering paragraph 17, Macy's admits and alleges that MG Icon in 2010  
15 has been involved in selling a line of juniors' clothing for young women utilizing the  
16 mark "Material Girl" including through Macy's. Except as expressly admitted and  
17 alleged herein, Macy's denies the other allegations of paragraph 17.

18 18. Macy's lacks sufficient information or belief to answer the allegations of  
19 paragraph 18 and, therefore, denies each and every allegation therein.

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

25 20. Answering paragraph 20, Macy's admits that MG Icon obtained certain  
26 rights to the "Material Girl" name, and that MG Icon, among others, is responsible for  
27 manufacturing the "Material Girl" line of juniors' clothing. Except as expressly admitted  
28 and alleged herein, Macy's denies the other allegations of paragraph 20.

1        21.    Answering paragraph 21, Macy's admits and alleges that Macy's is a retailer  
2 currently selling, advertising, and promoting the "Material Girl" line of juniors' clothing.  
3 Except as expressly admitted and alleged herein, Macy's denies the other allegations of  
4 paragraph 21.

5        22.    Macy's denies the allegations of paragraph 22.

6                    **ANSWER TO FIRST CLAIM FOR RELIEF**

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

8        23.    Answering paragraph 23, Macy's incorporates by reference paragraphs 1  
9 through 22, inclusive, of this Answer as if set forth in full herein.

10       24.    Macy's is not a party to the First Claim for Relief which is not alleged  
11 against Macy's and, therefore, is not answering paragraph 24.

12       25.    Macy's is not a party to the First Claim for Relief which is not alleged  
13 against Macy's and, therefore, is not answering paragraph 25.

14                    **ANSWER TO SECOND CLAIM FOR RELIEF**

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

16       26.    Answering paragraph 26, Macy's incorporates by reference paragraphs 1  
17 through 25, inclusive, of this Answer as if set forth in full herein.

18       27.    Macy's lacks sufficient information or belief to answer the allegations of  
19 paragraph 27 and, therefore, denies said allegations.

20       28.    Macy's lacks sufficient information or belief to answer the allegations of  
21 paragraph 28 as to Plaintiff and, therefore, denies said allegations.

22       29.    Answering paragraph 29, Macy's admits and alleges that MG Icon and/or  
23 Macy's has in 2010, and continues to advertise and sell certain clothing using the name  
24 Material Girl. Macy's lacks sufficient information or belief to answer the other  
25 allegations of paragraph 29 and, therefore, denies said allegations.

26       30.    Macy's denies the allegations of paragraph 30.

27       31.    Macy's denies the allegations of paragraph 31.

28       32.    Macy's denies the allegations of paragraph 32.

1                                   **AFFIRMATIVE DEFENSES**

2                                   **FIRST AFFIRMATIVE DEFENSE**

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

4           1.     Plaintiff's FAC, and each claim for relief therein, fails to state facts  
5 sufficient to constitute a claim for relief against Macy's.

6                                   **SECOND AFFIRMATIVE DEFENSE**

7                                   **(Prior Use)**

8           2.     The other defendants or their predecessors-in-interest have used the  
9 "Material Girl" mark since in or about 1985, which is more than a decade before  
10 Plaintiff's alleged use.

11                                  **THIRD AFFIRMATIVE DEFENSE**

12                                  **(Abandonment)**

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

15                                  **FOURTH AFFIRMATIVE DEFENSE**

16                                  **(No Likelihood of Confusion)**

17           4.     Macy's contends that Plaintiff's uses of the "Material Girl" name and  
18 trademark were and are improper. In any event, there is no likelihood of confusion for  
19 the public due to Macy's' uses of the "Material Girl" name and mark; indeed, it is  
20 Plaintiff's use of the name and mark which is likely to cause confusion for the public.

21                                  **FIFTH AFFIRMATIVE DEFENSE**

22                                  **(Fair Use)**

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

1                                    **SIXTH AFFIRMATIVE DEFENSE**

2                                    **(Laches)**

3            6.       Plaintiff has failed for over 15 years to raise any issues with or contest prior  
4 uses of the "Material Girl" name and mark and Plaintiff's FAC is thus barred under the  
5 doctrine of laches.

6                                    **SEVENTH AFFIRMATIVE DEFENSE**

7                                    **(Estoppel)**

8            7.       Plaintiff's FAC is barred under the doctrine of estoppel. For example, when  
9 due diligence was done on the "Material Girl" trademark for registration purposes, there  
10 was no federal registration by Plaintiff, and the California registration had expired and  
11 was abandoned; co-defendants reasonably relied on this fact in applying to register and in  
12 using the "Material Girl" mark in the retail clothing applications alleged in the FAC.  
13 Furthermore, Plaintiff over the years never contacted defendants, or their related parties  
14 or representatives, to make any claims or complaints with respect to the "Material Girl"  
15 name.

16                                   **EIGHTH AFFIRMATIVE DEFENSE**

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

18            8.       Macy's is informed and believes, and thereon alleges, that Plaintiff procured  
19 its California trademark registration for "Material Girl" based on misstatements,  
20 omissions of fact, misrepresentations and/or fraud including, without limitation,  
21 representing in 1997 that to Plaintiff's, or Plaintiff's predecessor O.C. Mercantile's, best  
22 knowledge and belief, no other person, firm or corporation had the right to use such mark  
23 in California, either in identical form or in such near resemblance thereto as might be  
24 calculated to deceive or confuse.

25                                   **NINTH AFFIRMATIVE DEFENSE**

26                                   **(Unclean Hands)**

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

1                                    **TENTH AFFIRMATIVE DEFENSE**

2                                    **(No Damages)**

3            10.    Plaintiff has suffered no damages as a result of Macy's' uses of the  
4 "Material Girl" name and mark; indeed, Plaintiff, on information and belief, may have  
5 benefited from Macy's' use of the "Material Girl" name.

6                                    **ELEVENTH AFFIRMATIVE DEFENSE**

7                                    **(Sham Litigation)**

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

10                                   **TWELFTH AFFIRMATIVE DEFENSE**

11                                   **(Statute of Limitations)**

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

14           WHEREFORE, defendant Macy's Retail Holdings, Inc. prays for relief as follows:

- 15           1.    That plaintiff take nothing on its First Amended Complaint, and that this  
16 action be dismissed with prejudice;  
17           2.    For attorney's fees as allowed by law;  
18           3.    For its costs of suit herein; and  
19           4.    For such further and other relief as the Court deems just and proper.

20  
21 Dated: November 3, 2010

GREENBERG TRAURIG, LLP

22  
23 By: /s/ George M. Belfield

24 GEORGE M. BELFIELD

Attorneys for Defendants

25 MADONNA LOUISE VERONICA

26 CICCONE, MATERIAL GIRL BRAND,

LLC, MG ICON, LLC and

27 MACY'S RETAIL HOLDINGS, INC.  
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Dated: November 3, 2010

By: /s/ George M. Belfield  
 GEORGE M. BELFIELD  
 Attorneys for Defendants  
 MADONNA LOUISE VERONICA  
 CICCONE, MATERIAL GIRL BRAND,  
 LLC, MG ICON, LLC and  
 MACY'S RETAIL HOLDINGS, INC.