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 CLERK U.S. DISTRICT COURT
 CENTRAL DIST. OF CALIF.
 LOS ANGELES

13 Attorneys for Plaintiff LA TRIUMPH, Inc.

14 **UNITED STATES DISTRICT COURT**
 15 **CENTRAL DISTRICT OF CALIFORNIA**

16 L.A. TRIUMPH, INC, a California
 17 corporation,
 18
 19 Plaintiff,
 20
 21 v.
 22
 23 MADONNA LOUISE VERONICA
 24 CICCONA, an individual; MATERIAL
 25 GIRL BRAND, LLC, a Delaware limited
 26 liability company; MG ICON, a Delaware
 27 limited liability company; MACY'S
 28 RETAIL HOLDINGS, INC, a Delaware
 corporation; and DOES 1 through 10,
 inclusive,
 Defendants.

Case No. CV-10-06195 SJO (JC)

FIRST AMENDED COMPLAINT FOR:

- (1) **DECLARATORY RELIEF**; and
- (2) **VIOLATION OF LANHAM ACT 43(A).**

DEMAND FOR JURY TRIAL

1 L.A. Triumph, Inc. (“LA Triumph” or “Plaintiff”), by and through its attorneys of
2 record, complains against Material Girl Brand, LLC (“MGB”), Madonna Louise Veronica
3 Ciccone (“Madonna”), MG Icon, LLC (“MG Icon”), Macy’s Retail Holdings, Inc
4 (“Macy’s”), and DOES 1 through 10 (collectively “Defendants”) alleging as follows:

5 **JURISDICTION AND VENUE**

6 1. The jurisdiction of this Court is based on 28 U.S.C. §§ 1331 and 2201-02
7 (Federal Declaratory Judgment Act) because of claims involving questions of rights and
8 responsibilities pursuant to federal trademark laws (the Lanham Act). Thus, this Court has
9 subject matter jurisdiction pursuant to 28 U.S.C. § 1338.

10 2. Venue is proper in this District under 28 U.S.C. §§ 1391(b)(2) and (c) in that
11 the claim arises in this Judicial District and the Plaintiff and Defendants may be found and
12 transact business in this Judicial District.

13 **PARTIES**

14 3. Plaintiff is a corporation existing under the laws of California, with its
15 principal place of business located in Cerritos, California, in the County of Los Angeles.

16 4. Defendant MGB is a limited liability company existing under the laws of
17 Delaware . MGB’s United States Trademark Office Application No. 77/886,045 indicates
18 that MGB is a Delaware limited liability company, and on that basis, Plaintiff is informed
19 and believes that MGB’s principle place of business is denoted as an accounting firm in
20 Century City, California as provided on Application No. 77/886,045, which accounting
21 firm on information and belief is Madonna’s and MGB’s accounting firm.

22 5. Defendant MG Icon is a limited liability company existing under the laws of
23 Delaware, with its principal place of business located in New York, New York.

24 6. Defendant Madonna is an individual residing in New York, New York. On
25 information and belief, Plaintiff alleges that Madonna is the principal of MGB and a 50%
26 owner of MG Icon.

1 7. Defendant Macy's is a corporation existing under the laws of Delaware, with
2 its principal place of business located in Cincinnati, Ohio. Macy's owns and operates a
3 chain of retail department stores throughout the United States, including in Los Angeles
4 County, California.

5 8. DOES 1-10 are sued by their fictitious names herein. When their true identity
6 is ascertained, this Complaint will be amended to so state them. On information and belief,
7 the DOE defendants are those who acted in concert with MGB and Madonna, are alter egos
8 or agents of MGB and Madonna in perpetrating the acts described herein, or are
9 contributing to the infringements alleged herein.

10 **FACTS COMMON TO ALL COUNTS**

11 9. LA Triumph has itself been continually selling and marketing clothes under
12 the "Material Girl" mark since 2003 itself and since 1997 through its predecessor-in-
13 interest, OC Mercantile Corporation ("OC Mercantile").

14 10. Specifically, since 1996 OC Mercantile specialized in the manufacture and
15 distribution of clothing, including that for men, women, juniors¹, and children.

16 11. On or about 1997, OC Mercantile started a line of juniors' clothing for women
17 under the trade name "Material Girl." Concurrently therewith, OC Mercantile filed a
18 trademark registration with the California Secretary of State for "Material Girl" on January
19 1997, which registration was issued by the State of California.

20 12. OC Mercantile advertised and sold its "Material Girl" brand nationwide to
21 retailers including Nordstrom, Ross, and other large retail chains from 1997 to 2003.

22 13. In 2003, LA Triumph succeeded OC Mercantile and continued the sale of the
23 same types of clothes under the same "Material Girl" brand both in California and
24 nationwide.

25 _____
26 ¹ "Juniors" is a clothing industry term that generally refers to individuals between the ages
27 of 15 and 30.

1 14. Between 1997 and present day, LA Triumph and its predecessor have sold
2 millions of dollars of the “Material Girl” brand of clothes in commerce throughout the
3 United States, and have spent large sums in its promotion and advertisement.

4 15. Plaintiff has received national exposure for its unique and fashionable apparel
5 designs under the “Material Girl” mark and takes enormous pride in its reputation for
6 excellence and quality workmanship.

7 16. Plaintiff is entitled to the exclusive use and benefit of the “Material Girl”
8 mark, which has been in continuous use since 1997.

9 17. Recently, in 2010, Plaintiff became aware that Defendants started promoting,
10 advertising, and selling a line of juniors’ clothing for young women under the mark
11 “Material Girl,” including advertising and selling such clothes at the website
12 <http://materialgirlcollection.com/>, which on information and belief is owned by MGB
13 and/or MG Icon and which links to the retail outlet Macy’s website whereby consumers can
14 purchase such infringing “Material Girl” clothes online.

15 18. Defendants’ clothing line for young women has garnered significant press
16 attention for its risqué advertising campaign. Plaintiff’s “Material Girl” clothing line retails
17 at the same general price point and in the same general retail space as the Defendant’s
18 infringing clothes.

19 19. Further, MGB has improperly filed a United States Trademark Application for
20 the “Material Girl” mark for clothing in *inter alia* international class 025 for clothing,
21 under application number 77/886,045 on December 4, 2009 as an “intent to use
22 application.”

23 20. Plaintiff is informed and believes that Madonna and MGB licensed the
24 “Material Girl” name to MG Icon. Further, Plaintiff is informed and believes that MG Icon
25 is responsible for manufacturing MGB and Madonna’s infringing line of “Material Girl”
26 line of juniors’ clothing.

1 21. Plaintiff is also informed and believes that Macy's is one retailer currently
2 selling, advertising, and promoting the infringing "Material Girl" line of juniors' clothing
3 in its retail establishments across the nation. This Complaint will be amended to add name
4 DOE Defendants when appropriate as a result of discovery.

5 22. Defendants' conduct has confused and is likely to confuse the public by
6 creating the erroneous impression that Defendants' products have been manufactured,
7 approved, sponsored, endorsed or guaranteed by, or in some way are affiliated with, the
8 Plaintiff.

9 **FIRST CLAIM FOR RELIEF**

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

11 23. LA Triumph incorporates paragraphs 1 through 22 above as if set forth fully
12 herein.

13 24. There exists a live, substantial controversy and dispute between Plaintiff, on
14 the one hand, and Defendants Madonna, MGB, and MG Icon on the other hand, over: (1)
15 Defendants' right to use the "Material Girl" mark in clothing; and (2) their right to secure a
16 trademark registration on the "Material Girl" mark. As to the first issue, Plaintiff contends
17 that it is the senior user of the mark in interstate commerce nationwide in the goods and
18 classes of apparel and fashion and as such Defendants have no right to use the "Material
19 Girl" brand in clothing. Defendants on information and belief and as evidenced by
20 Defendants' infringing use of the "Material Girl" mark and pending federal registration
21 application contend otherwise. As to the second issue, Plaintiff contends that Defendants
22 have no right to issuance of a federal registration on the "Material Girl" mark in the
23 clothing, apparel or fashion classes (*inter alia* international class 025). Defendants on
24 information and belief contend otherwise as evidenced by their federal application. As
25 such, the parties have adverse interests of immediate concern and a live, justiciable
26 controversy, which warrants issuance of a declaratory judgment.

1 25. Plaintiff seeks a declaration that it is the rightful owner of the “Material Girl”
2 mark with respect to clothing, that Defendants have no right to sell clothes under the
3 “Material Girl” brand, and for an order by this court to deny registration of Defendants’
4 United States Trademark Application 77/886,045.

5 **SECOND CLAIM FOR RELIEF**

6 **(Violation of Lanham Act § 43(a) against MGB, MG Icon, Macy’s and Does 1-10)**

7 26. LA Triumph incorporates paragraphs 1 through 25 above as if set forth fully
8 herein.

9 27. In connection with its product and service offerings Plaintiff has continuously
10 used the mark “Material Girl” over the past thirteen years in connection with the marketing,
11 distribution and sale of Plaintiff’s junior clothing.

12 28. “Material Girl” is inherently distinctive. In the alternative, because of
13 Plaintiff’s exclusive and extensive use of the mark “Material Girl”, this trademark has
14 acquired considerable value and has become well known to the consuming public as
15 identifying and distinguishing Plaintiff exclusively and uniquely as the source of juniors’
16 clothing, and thus “Material Girl” has acquired a secondary meaning.

17 29. MGB, MG Icon, Macy’s and Does 1-10 (collectively “Infringing Defendants”)
18 have in the past and will continue to advertise, distribute, and sell under the name “Material
19 Girl”. Plaintiff does not consent to or authorize such infringing use by the Infringing
20 Defendants of the mark “Material Girl”.

21 30. The Infringing Defendants’ conduct has confused and is likely to confuse the
22 public and cause deception and mistake among the consuming public and trade by creating
23 the erroneous impression that the Infringing Defendants’ products have been manufactured,
24 approved, sponsored, endorsed or guaranteed by, or in some way are affiliated with, the
25 Plaintiff in violation of the Lanham Act 43(a), 15 U.S.C. §1125(a). Furthermore,
26 Defendants’ commercial advertising and promotion misrepresents an ongoing association
27 with Plaintiff and owing to the Infringing Defendants’ size and resources threatens to

1 overwhelm the market and crowd out the senior user. Irreparable harm and injury is actual
2 and ongoing, and is causing the Plaintiff injury to its business reputation and dilution of the
3 distinctive quality of Plaintiff's "Material Girl" trademark as a result of the Infringing
4 Defendants' conduct and Plaintiff is without adequate remedy at law.

5 31. Plaintiff is entitled to recover from the Infringing Defendants the damages
6 sustained as a result of the Infringing Defendants' acts in violation of §43(a). Plaintiff is at
7 present unable to ascertain the full extent of the monetary damages suffered by reason of
8 Defendants' acts.

9 32. Plaintiff is further entitled to recover from the Infringing Defendants the gains,
10 profits, and advantages the Infringing Defendants have obtained as a result of the Infringing
11 Defendants' acts in violation of §43(a).

12
13 **PRAYER FOR RELIEF**

14 WHEREFORE, Plaintiff prays the following relief and judgment be granted follows:

15 1. For a declaration that Plaintiff has senior rights as against all Defendants
16 (jointly and severally) to the mark "Material Girl" in commerce nationwide in the clothing
17 space;

18 2. For a declaration that all Defendants (jointly and severally) have no right to
19 use the mark "Material Girl" in connection with clothing sales, advertising or
20 merchandising;

21 3. For a declaration that MGB's pending Federal Trademark Application be
22 denied, and further a declaration jointly and severally against all Defendants to the extent
23 that they claim an interest in the application or future applications;

24 4. For Plaintiff's actual damages along with the Infringing Defendants' profits
25 attributable to their unlawful conduct according to proof to be proved at trial, and that such
26 liability be decreed jointly and severally against the Infringing Defendants;

1 5. For such further and additional relief as the Court may deem just and proper,
2 including pre-and post-judgment interest.

3
4
5 Dated: October 11, 2010 **ONE LLP**

6
7
8 By: _____

9 Imran F. Vakil
10 Attorneys for Plaintiff, LA TRIUMPH, Inc.

11
12
13 **DEMAND FOR JURY TRIAL**

14 Plaintiff LA TRIUMPH, Inc. hereby demands trial by jury of all issues so triable
15 under the law.

16
17 Dated: October 11, 2010 **ONE LLP**

18
19
20 By: _____

21 Imran F. Vakil
22 Attorneys for Plaintiff, LA TRIUMPH, Inc.

1 **PROOF OF SERVICE**

2 STATE OF CALIFORNIA, COUNTY OF ORANGE

3 I am employed in the County of Orange, State of California. I am over the age of 18
4 and not a party to the within action; my business address is 4000 MacArthur Boulevard,
West Tower, Suite 1100, Newport Beach, California 92660.

5 On October 12, 2010 I served the document (s) described as **FIRST AMENDED**
6 **COMPLAINT** in this action by placing the true copies thereof enclosed in sealed
envelopes addressed as follows:

7 **Nina D Boyajian**
8 Greenberg Traurig LLP
9 2450 Colorado Avenue, Suite 400E
10 Santa Monica, CA 90404-5524
310-586-6587
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Email: boyajiann@gtlaw.com

11 *Attorneys for Defendants Madonna Louise*
12 *Veronica Ciccone and Material Girl Brand, LLC*

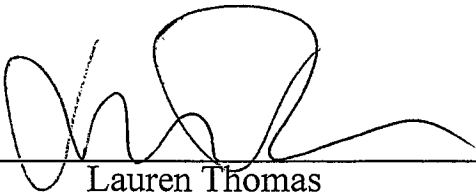
13 [X] (BY MAIL) I am "readily familiar" with the firm's practice for collection and
14 processing correspondence for mailing. Under that practice it would be
15 deposited with the U.S. Postal Service on that same day with postage thereon
16 fully prepaid at Newport Beach, California in the ordinary course of business.
I am aware that on motion of the party served, service is presumed invalid if
postal cancellation date or postage meter date is more than one day after date
of deposit for mailing in affidavit.

17 [X] (BY E-MAIL)

18 [] (BY OVERNIGHT DELIVERY) I caused said envelope (s) to be delivered
19 overnight via an overnight delivery service in lieu of delivery by mail to the
addressee (s).

20 Executed on October 12, 2010 at Newport Beach, California.

21 [X] (STATE) I declare under penalty of perjury under the laws of the State of
22 California that the above is true and correct.

23 
24 _____
25 Lauren Thomas