

UNITED STATES DISTRICT COURT  
SOUTHERN DISTRICT OF FLORIDA

Case Number:

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	)	
IT'S A 10, INC., a Florida Corporation,	)	
	)	
Plaintiffs,	)	
	)	
v.	)	
	)	<b>Plaintiff Demands Trial by Jury</b>
ITS-A-TEN.COM, an unknown business	)	
entity, DAVID SIMMS, an individual and	)	
ADAM SIMMS, an individual,	)	
	)	
Defendants.	)	
	)	

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**COMPLAINT**

Plaintiff **It's a 10, Inc.**, by and through their undersigned attorneys, alleges and avers as follows:

**NATURE OF THIS ACTION**

This is an action on behalf of Plaintiff It's a 10, Inc., the owner of the federal trademark registration for the mark IT'S A 10 (Reg. No. 3,420,182) ("Mark"), for trademark infringement, trademark dilution, unfair competition, cyberpiracy, false advertising and false designation of origin in violation of 15 U.S.C. § 1125(a) *et seq.* and unfair competition under statutory and common law of Florida against Defendants Its-a-Ten.com, Adam Simms and David Simms (collectively "Defendants").

Despite knowledge of Plaintiff's extensive use and federal rights in the mark IT'S A 10, Defendants intentionally obtained, used and continue to use the identical or confusingly similar Internet domain names, [its-a-10.com](http://its-a-10.com) and [its-a-ten.com](http://its-a-ten.com) (referred to collectively herein

as “Infringing Domain Names”) for the illegal promotion and advertising of their own business and to divert consumers to their websites and profit from the goodwill and reputation associated with Plaintiff’s IT’S A 10 mark.

Plaintiff seeks: (a) injunctive relief prohibiting Defendants from any further infringement of Plaintiff’s IT’S A 10 mark; (b) an order requiring the transfer of the Infringing Domain Names to Plaintiff and any other domain names owned or controlled by Defendants confusingly similar to Plaintiff’s Mark and (c) money damages, attorneys’ fees and costs for Defendant’s past and continuing infringement of the Mark.

### **The Parties**

1. Plaintiff **It’s a 10, Inc.** is, and at all times material hereto has been, a corporation organized under the laws of the state of Florida with its place of business in Deerfield Beach, Florida.

2. On information and belief, Defendant **Its-a-Ten.com**, an unknown business entity, engaged in commercial Internet activity located at the Infringing Domain Names, and is an Internet business jointly operated by Adam Simms and David Simms, who are individuals that reside in the state of Ohio.

3. On information and belief, Defendant **David Simms** is an individual residing in the state of Ohio, and has obtained, uses, owns or co-owns and controls the Infringing Domain Names and conducts commercial transactions through the Infringing Domain Names.

4. On information and belief, Defendant **Adam Simms** is an individual residing in the state of Ohio, and has obtained, uses, owns or co-owns and controls the Infringing Domain Names and conducts commercial transactions through the Infringing Domain Names.

### **Jurisdiction and Venue**

5. The Court has jurisdiction under 15 U.S.C.A. § 1121 and 28 U.S.C.A. §§ 1331 and 1338(a) in that this case arises under the Trademark Act of the United States, 15 U.S.C.A. §§ 1051 *et seq.*

6. The Court has jurisdiction of the unfair competition claims under the provisions of 28 U.S.C.A. § 1338(b).

7. This Court has jurisdiction pursuant to the supplemental jurisdiction provisions of 28 U.S.C. § 1367.

8. This Court has personal jurisdiction over Defendants since Defendants have engaged in business activities in, and directed to, this district, and have intentionally committed a tortious act within this district or have committed a tortious act outside of the State of Florida causing injury to Plaintiff in this judicial district and Defendants have intentionally directed their infringing activities to the state of Florida and this judicial district and, upon information and belief, sell products within the State of Florida and this judicial district and the exercise of personal jurisdiction would be otherwise constitutionally permissible over Defendants.

9. Venue is proper in this district pursuant to 28 U.S.C. §1391(b) because a substantial part of the events giving rise to Plaintiff's claim occurred in this district, including, *inter alia*, Defendants committed trademark infringement in this district, Defendants' commercial website is accessible and intentionally directed to Florida consumers in this district, Plaintiff has its principal place of business in this district, Plaintiff sell its It's a 10 products in this district, and Plaintiff has been injured in this district by Defendants' infringing activities.

## **PLAINTIFF'S BUSINESS AND TRADEMARK RIGHTS**

10. Plaintiff It's a 10, Inc. is a leader in the sale and innovation of hair care products and is the owner of the famous "It's a 10" hair care line, which was launched in 2006, and in less than a half decade, has become a multi-million dollar corporation. Plaintiff has invested considerable efforts, resources and financial expenditures promoting, marketing and selling these products under the distinctive mark IT'S A 10. Plaintiff has spent approximately \$10 million to date on the advertising and promotion of the It's a 10 hair products and has invested an immeasurable amount of time and effort in the development of their unique product line.

11. Plaintiff is the owner of the U.S. trademark registration for the mark IT'S A 10 for "a full line of hair care products; namely, shampoos, conditioners, styling gels, hair lotions and hair sprays." This trademark registration is valid and subsisting, and constitutes constructive use of Plaintiff's IT'S A 10 mark throughout the United States, as well as constructive notice of Plaintiff's rights in the IT'S A 10 mark. A copy of the trademark registration is attached herein as Exhibit A;

12. Plaintiff sells its It's a 10 products to some of the largest distributors in the world, including distributors in this judicial district. The sale of the It's a 10 products from inception in 2006 to date exceed \$100 million at the retail level. The It's a 10 products are sold in numerous outlets, including major retail chains and countless professional hair salons worldwide.

13. As a result of Plaintiff's considerable efforts, Plaintiff has achieved huge commercial success both in the United States and abroad in connection with the It's a 10 hair care product line and the IT'S A 10 mark is famous and widely recognized to consumers in the beauty and hair care market.

14. Numerous well-known publications such as *People*, *US Magazine*, *Martha Stewart Wedding Magazine*, *In Style* and *Seventeen* have recognized Plaintiff's It's a 10 hair care

products. Moreover, Plaintiff's It's a 10 hair care products have earned recognition among professional salons and consumers as a high-quality product, receiving glowing reviews from consumers and celebrities alike.

15. Plaintiff is also the owner of the domain name [itsa10haircare.com](http://itsa10haircare.com). Plaintiff's website generates business and goodwill for Plaintiff and allows Plaintiff to communicate with potential business contacts, while maintaining relationships with a vast range of consumers.

16. Plaintiff's It's a 10 mark is used in interstate commerce by Plaintiffs in connection with the sale, offering for sale, distribution and promotion of Plaintiff's goods. Plaintiff's mark is distinctive and was distinctive at the time of all acts alleged herein.

17. There is a substantial demand for the goods associated with the IT'S A 10 mark and the goodwill associated with the It's a 10 mark is Plaintiff's most valuable asset.

### **DEFENDANTS' INFRINGING ACTS**

17. Since long before the acts of Defendants as described herein, Plaintiff It's a 10, Inc. continuously marketed, promoted and sold its hair care products under the mark IT'S A 10 throughout the U.S. and abroad.

18. Plaintiff has never authorized, licensed or otherwise permitted Defendants to use its IT'S A 10 mark or any other confusingly similar variation thereof.

19. Despite both actual and constructive knowledge of Plaintiff's prior rights in the mark IT'S A 10, Defendants intentionally obtained, used and are using the infringing domain names [its-a-ten.com](http://its-a-ten.com) and [its-a-10.com](http://its-a-10.com) for the purposes of operating an Internet business that sells Plaintiff's It's a 10 products ("Infringing Websites").

20. Plaintiff is informed, believes and thereon alleges that Defendants intentionally registered, used and continue to use, the Infringing Domain Names in bad faith to confuse

consumers into believing that the Infringing Websites are affiliated with, sponsored or approved by Plaintiff It's a 10, Inc. in order to drive traffic and sales to their Infringing Websites. By Defendant Adam Simms's own admission as contained in his email of April 5, 2010 (attached and discussed below) the Infringing Websites have "tens of thousands of registered buying customers" that have purchased the It's a 10 hair care products sold on Defendants' Infringing Websites

21. The Infringing Domain Names have caused a likelihood of confusion and actual confusion (as further discussed below) and will continue to cause such confusion if Defendants' infringing activities do not cease. Defendants have further exploited this confusion by prominently displaying the name "It's-a-Ten" as Defendants' company name at the top of Defendants' homepage located at [www.its-a-ten.com](http://www.its-a-ten.com), and referring to the products as "It's a Ten hair products."

22. On information and belief, Defendants have extensively promoted its Infringing Websites on various social media and networking websites, including Facebook, Twitter, and YouTube. For example, Defendants created a Facebook page that prominently displays the Defendants' infringing company name "Its-a-Ten" along with links to the Infringing Websites and images of Plaintiff's It's a 10 products. A copy of Defendants' Facebook page is attached herein as **Exhibit B**.

23. On information and belief, Defendants misappropriated images of Plaintiff's products subject to copyright protection from Plaintiff's website for use on Defendants' Infringing Websites, Facebook page and other promotional Internet outlets.

24. Willful infringement is evident by the email of Defendant Adam Simms dated April 5, 2010 to Plaintiff, whereby Defendant Adam Simms threatens to redirect "tens of thousands of registered buying customers that have purchased Its-a-ten products" to other hair

care products if Defendants' supply of Plaintiff's It's a 10 products from a distributor (Plaintiff requested that the distributor cease sales to the owner of the Infringing Websites) was not restored. A copy of the said April 5 email is attached as **Exhibit C**.

25. Defendants' use of the company name "Its-a-Ten" along with the Infringing Domain Names and images of Plaintiff's products has caused actual consumer confusion as readily evidenced by Defendants' Facebook page, where consumers are allowed to post comments and such comments include: "Thank you for creating this stuff!" and "I had to contact you with a thank you. Your product is amazing!" (See **Exhibit B**).

26. Actual confusion is further evidenced by Defendant David Simms' email of August 4, 2010, whereby Defendant David Simms notes that Defendants' Infringing Websites are "still receiving emails" that were meant to be directed to Plaintiff (a copy of said August 4 email is attached hereto as **Exhibit D**). Such emails were misdirected to Defendants due to confusion based on Defendants' use of the identical or confusingly similar domain names. As confirmed in Defendant David Simms August 4 email, such misdirected emails are not only from customers, but from potential business clients of Plaintiff's.

27. On or about August 10, 2010, Plaintiff sent a cease and desist letter to Defendants informing them, *inter alia*, that Defendants were infringing and continued to infringe upon Plaintiff's valuable trademark rights.

28. On August 24, 2010, Defendant Adam Simms responded by email to the August 10, 2010 cease and desist letter informing Plaintiff that Defendants did not intend to cease use of the Infringing Domain Names. In the August 24 email, Defendants confirmed that they were aware of Plaintiff's federal trademark registration and that Defendants planned to continue such infringing activities, or, in the alternative, Plaintiff could purchase Defendants' business

operating under the business name and domain name its-a-ten.com and its-a-10.com from Defendants. A copy of the August 24, 2010 email is attached hereto as **Exhibit E**.

29. Defendant Adam Simms further admits in his email of August 24, 2010 that Defendants purchased the Infringing Domain Names for “retail sales” of Plaintiff’s It’s a 10 products and that they have spent “thousands of dollars” on advertising the Infringing Websites.

30. Upon even a cursory review of the facts in this case and the attached Exhibits, it is clear that Defendants use of the Infringing Domain Names was intentional and willful as (a) the goods sold on Defendants’ website are Plaintiff’s goods that prominently display the IT’S A 10 mark; (b) the emails from Defendants to Plaintiff attached as Exhibits D and E, respectively, admit the purpose for registering and using the Infringing Domain Names was for the retail sale of Plaintiff’s products, and (c) Defendants blatant disregard of Plaintiff’s request that they cease use of the Infringing Domain Names and (d) Defendants’ attempt in Exhibit E to sell their business, including the Infringing Domain Names, to Plaintiff.

31. The activities of Defendants complained of herein were and are done willfully in order to trade upon the goodwill and reputation of Plaintiff with reckless disregard of Plaintiff’s trademark rights and with actual and constructive knowledge that such conduct was and is in direct contravention of Plaintiff’s rights and was and is likely to confuse, mislead and deceive consumers as to the source, affiliation and sponsorship of Defendants’ goods and services, resulting in direct injury to Plaintiff’s business, reputation and goodwill.

**COUNT I**  
**FEDERAL TRADEMARK INFRINGEMENT**  
**(15 U.S.C. 1114)**

32. Plaintiff repeats and re-alleges all of the allegations contained in the preceding paragraphs of the Complaint as though the same were fully written herein.



33. Plaintiff is the owner of a valid and subsisting federal trademark registration for the mark **IT'S A 10** and has continuously used the mark in connection with hair care products since at least as early as July of 2006. A copy of the Registration Certificate is attached hereto as **Exhibit A**.

34. Despite Plaintiff's prior rights in the IT'S A 10 mark, Defendants, without Plaintiff's authorization, used in commerce the virtually identical or confusingly similar domain names, Its-a-10.com and Its-a-ten.com in connection with identical goods/services in order to profit off the goodwill and reputation Plaintiff has established in association with its IT'S A 10 mark and such use was intended to cause, has caused and is likely to continue to cause confusion, mistake and deception among consumers as to whether Defendants' Infringing Domain Names are affiliated with, sponsored or approved by Plaintiff It's a 10, Inc.

35. The foregoing acts of infringement have been and continue to be deliberate, willful and wanton, constituting an exceptional case within the meaning of 15 U.S.C. § 1117.

36. As a direct and proximate result of Defendants' infringement, Plaintiff has suffered, and will continue to suffer, monetary loss and irreparable injury to its business.

**COUNT II**  
**FEDERAL TRADEMARK DILUTION**  
**(15 U.S.C. § 1125(c))**

37. Plaintiff repeats and re-alleges all of the allegations contained in the preceding paragraphs of the Complaint as though the same were fully written herein.

38. Defendants registration and use of a virtually identical and confusingly similar mark to Plaintiff's distinctive IT'S A 10 mark commenced after Plaintiff's Mark became famous within the meaning of 15 U.S.C. § 1125(c) and further causes dilution of the distinctive quality of the IT'S A 10 mark, thereby constituting dilution of the Mark.

39. Upon information and belief, Defendants had knowledge of Plaintiff's use and federal registration of the mark IT'S A 10, and dilution of Plaintiff's It's a 10 mark was willful.

40. Plaintiff has been and continues to be damaged by Defendants' infringing activities.

### **COUNT III**

#### **FALSE DESIGNATION OF ORIGIN, FALSE ADVERTISING AND UNFAIR COMPETITION (15 U.S.C. §1125(a))**

41. Plaintiffs repeat and re-allege all of the allegations contained in the preceding paragraphs of the Complaint as though the same were fully written herein.

42. Defendants use in commerce of the Infringing Domain Names in order to profit off the goodwill and reputation associated with Plaintiff's IT'S A 10 mark was intended to cause, has caused and is likely to continue to cause confusion, mistake and deception among consumers as to whether Defendants' Infringing Domain Names are affiliated with, sponsored or approved by Plaintiff It's a 10, Inc

43. The foregoing acts of Defendants constitute a false designation of origin, unfair business practices and false and misleading descriptions and representations of fact, all in violation of Section 43(a) of the Lanham Act (15 U.S.C. § 1125(a)).

### **COUNT IV**

#### **COMMON LAW TRADEMARK INFRINGEMENT**

44. Plaintiff repeats and re-alleges all of the allegations contained in the preceding paragraphs of the Complaint as though the same were fully written herein.

45. The acts of Defendants complained of herein constitute trademark infringement in violation of Section 43(a) of the Lanham Act, 15 U.S.C. § 1125(a).

46. As a direct and proximate result of Defendants' infringement, Plaintiff has suffered, and will continue to suffer, monetary loss and irreparable injury to its business.

**COUNT V**  
**FLORIDA DECEPTIVE AND UNFAIR TRADE PRACTICES ACT**  
**(F.S.A. § 501)**

47. Plaintiff repeats and re-alleges all of the allegations contained in the preceding paragraphs of the Complaint as though the same were fully written herein.

48. Defendants have engaged in unfair and deceptive acts or practices by Defendants' use of the Infringing Domain Names in bad faith to drive traffic to Defendants' Infringing Websites and by creating a likelihood of public confusion as to the source of the goods and services in violation of Florida law.

49. Plaintiff has suffered damages relating to Defendants' violation of the Deceptive and Unfair Trade Practices Act F.S.A. § 501 by Defendant. The quantum of these damages will be proven at trial.

**COUNT VI**  
**COMMON LAW UNFAIR COMPETITION UNDER STATE LAW**

50. Plaintiff repeats and re-alleges all of the allegations contained in the preceding paragraphs of the Complaint as though the same were fully written herein.

51. As a result of Defendants' unlawful acts as described herein, Defendants have misappropriated valuable property rights of Plaintiff It's a 10, is trading on Plaintiff's goodwill and reputation associated with Plaintiff's IT'S A 10 mark, and has and continues to create a likelihood of confusion in violation of Florida state law.

**COUNT VII**  
**CYBERPIRACY**  
**(15 U.S.C. § 1125(d))**

42. Plaintiff repeats and re-alleges all of the allegations contained in the preceding paragraphs of this complaint as though the same were fully written herein.

43. By the actions alleged above, Defendants intentionally registered, used and will continue to use the virtually identical and confusingly similar domain names, its-a-ten.com and its-a-10.com in a bad faith effort to profit off of Plaintiff's reputation and goodwill associated with Plaintiff's IT'S A 10 mark.

44. Plaintiff's Mark was distinctive and famous prior to Defendants' registration and use of the Infringing Domain Names.

45. As a direct and proximate result of Defendants' unlawful conduct, Plaintiff has suffered irreparable harm to its valuable IT'S A 10 mark. Unless Defendants are restrained from further infringement of the IT'S A 10 mark, Plaintiff will continue to be irreparably harmed.

#### **COUNT VIII** **UNJUST ENRICHMENT**

52. Pleading in the alternative, Defendants intentionally used and continue to use a mark identical (or nearly identical) and confusingly similar to Plaintiff's IT'S A 10 Mark to divert consumers to the Infringing Websites in order to induce the sale of Plaintiff's It's a 10 products from Defendants' Infringing Websites. As a result of Defendants' infringing activities, Defendants have been unjustly enriched at Plaintiff's detriment and expense. The unauthorized use of Plaintiff's IT'S A 10 mark and the unauthorized use of depictions of Plaintiff's It's a 10 products conferred a monetary benefit upon Defendants and Defendants received and had knowledge of such monetary benefit; Defendants voluntarily realized and retained such benefit and the circumstances are as such that it would be inequitable to allow Defendants to retain such

monetary benefits and principles of equity and good conscience require that Defendants make restitution to Plaintiff for damages related thereto.

### **DEMAND FOR JURY TRIAL**

Plaintiff demands trial by jury on all issues triable to a jury.

### **PRAAYER FOR RELIEF**

WHEREFORE, Plaintiff respectfully requests that the Court entered judgment against Defendants as follows:

1. That the Court issue temporary and permanent injunctive relief against Defendants and that Defendants, their agents, servants, employees, attorneys, representatives, successors and assigns and all persons, firms, or corporations in active concert or participation with Defendants be enjoined and restrained preliminarily and permanently from:

- (a) directly or indirectly infringing Plaintiff's IT'S A 10 mark and/or holding themselves out as Its-a-ten or Its-a-10 or any confusingly similar variation thereof;
- (b) registering, using or trafficking any domain names that are confusingly similar to Plaintiff's Mark, including but not limited to domain names containing Plaintiff's Mark or any confusingly similar variation thereof;  
and
- (c) using any trademark, domain name, trade name or any other designation of source that is confusingly similar to Plaintiff's IT'S A 10 mark for the

promotion, marketing or advertising of any product or service (“Infringing Promotional Content”).

2. That the Court order Defendants to remove any and all Infringing Promotional Content that currently exists in the marketplace, including without limitation any and all references to the Infringing Domain Names found on the internet websites YouTube, Twitter and Facebook;

3. That the Court order the transfer of the Infringing Domain Names to Plaintiff It’s a 10, Inc. or the forfeiture or cancellation of the Infringing Domain Names;

4. That the Court award Plaintiff It’s a 10, Inc. all damages caused by Defendants as a result of Defendants’ unlawful acts;

5. That the Court award Plaintiff treble damages and punitive damages as provided by law;

6. That the Court award Plaintiff all gains, profits, and advantages derived from Defendants’ unlawful acts;

7. That Plaintiff recovers from Defendants its costs of this action, attorneys’ fees, and prejudgment and post-judgment interest; and

8. That the Court grant Plaintiff all other relief as the Court may deem just and proper.

Dated: July 25, 2011

Respectfully submitted,

*Michael J. Sacks*

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Michael Sacks FBN: 65625  
Brush & Sacks  
7210 Wisteria Avenue  
Parkland, FL 33076  
(954)575-8691  
email: msacks@bellsouth.net

OF COUNSEL:  
Edward P. Kelly  
Merry L. Biggerstaff  
Tiajolloff & Kelly LLP  
The Chrysler Building 37<sup>th</sup> floor  
405 Lexington Avenue  
New York New York 10174  
212 490 3285  
212 490 3295 (fax)