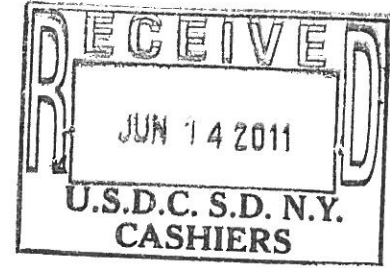


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Ariel S. Peikes (AP-9157)  
apeikes@grr.com  
Gottlieb, Rackman & Reisman, P.C.  
270 Madison Avenue, 8<sup>th</sup> Floor  
New York, New York 10016  
Phone: (212) 684-3900 • Fax: (212) 684-3999

Local Counsel for Plaintiff  
Moroccanoil, Inc.



William C. Conkle (SB# 76103)  
w.conkle@conklelaw.com  
(Pro Hac Vice application forthcoming)  
Courtney M. Ryan (SB# 267656)  
c.ryan@conklelaw.com  
(Pro Hac Vice application forthcoming)  
CONKLE, KREMER & ENGEL  
Professional Law Corporation  
3130 Wilshire Boulevard, Suite 500  
Santa Monica, California 90403-2351  
Phone: (310) 998-9100 • Fax: (310) 998-9109

Counsel for Plaintiff Moroccanoil, Inc.

UNITED STATES DISTRICT COURT  
SOUTHERN DISTRICT OF NEW YORK

MOROCCANOIL, INC.,

Plaintiff,

v.

TOTAL BEAUTY SUPPLIES, LTD.;  
and DOES 1 through 10 inclusive,

Defendants.

Civil Action No:

COMPLAINT

Plaintiff MoroccanOil, Inc., for its complaint against the defendants herein, alleges the following on knowledge as to Plaintiff and otherwise on information and belief:

### **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), 28 U.S.C. § 1338 (b) (Original Jurisdiction - Unfair Competition) and 28 U.S.C. § 1367 (Supplemental Jurisdiction).

### **VENUE**

2. Venue is proper in this District under 28 U.S.C. § 1391(b)(1) because while diversity exists, it is not the sole basis for jurisdiction, and the named defendant resides in this district. Venue is also proper under § 1391(b)(2) because a substantial part of the events giving rise to the claims occurred in this judicial district.

### **SUMMARY OF MOROCCANOIL'S CLAIMS**

3. Plaintiff MoroccanOil, Inc., a California corporation (“Plaintiff”) distributes throughout the United States professional, “salon only” hair care products (“MoroccanOil Products”). All of the MoroccanOil Products contain a signature ingredient, argan oil, that is produced from the kernels of the argan tree which is native to Morocco. MoroccanOil Products bear one or more federally registered trademarks including the mark “MOROCCANOIL.” MoroccanOil Oil Treatment is the most popular product in the line of MoroccanOil Products. It is packaged in 3.4 fluid-ounce amber colored, druggist-style bottles with black screw-on caps.

4. Defendant Total Beauty Supplies, Ltd. (“Total Beauty”) is distributing and selling counterfeit Moroccanil Oil Treatment products. The counterfeit Moroccanil Oil Treatment products distributed and sold by Total Beauty: (a) are packaged in nearly identical 3.4 fluid ounce, amber colored, druggist-style bottles with black screw-on caps, (b) have rectangular-shaped, light blue labels that appear identical to those of Moroccanil including imitations of the Moroccanil trademarks, logos and information describing the contents and the usage of the product, that are indistinguishable from genuine Moroccanil Oil Treatment, and (c) contain counterfeit oil inside the bottles that has a color and fragrance similar to that of genuine Moroccanil Oil Treatment, but which is not the genuine Moroccanil Product.

5. Moroccanil has purchased from Total Beauty a number of products that have the physical indicia, both visually and olfactory, of counterfeit. Such physical indicia includes the affixation of batch code 216GH. The physical indicia of counterfeiting on the counterfeit product purchased from defendant Total Beauty show it to be the same as other identical products purchased from other sellers, which were tested by a laboratory and were determined to be counterfeit. Based on the physical indicia of the product sold by Defendant, these products are counterfeit.

6. Moroccanil does not sell its products to Total Beauty since Total Beauty is not an authorized Moroccanil supplier or distributor.

#### **THE PLAINTIFF**

7. Moroccanil, Inc., is a California corporation doing business from its principal place of business at 16311 Ventura Boulevard, Suite 1200, Los Angeles, California. Moroccanil distributes Moroccanil Products throughout the United

States. Plaintiff MoroccanOil, Inc. and its predecessors are referred to herein as “MoroccanOil” or “Plaintiff.”

### **THE DEFENDANTS**

8. Plaintiff is informed and believes that defendant Total Beauty Supplies, Ltd. (“Total Beauty”), is a New York corporation having its principal place of business at 650 W. 181<sup>st</sup> Street, New York, NY 10033.

9. On information and belief, there are other entities and individuals that: (a) supply, distribute or sell counterfeit products to the named defendant; (b) are the agent, employee, principal, or co-conspirator of the named defendant and have acted within the scope of such agency, employment, conspiracy, joint venture or partnership relations in committing the acts alleged herein and, as such, caused injury and damage to Plaintiff as described herein, and/or; (c) have a unity of interest and ownership with the named defendant such that any individuality and separateness between them and the named defendant never existed or has ceased to exist, and to adhere to the fiction of separate and distinct existence from the named defendant would permit an abuse of corporate and other entity privileges, would sanction fraud, and would promote injustice.

10. Plaintiff is ignorant of the true identities and participation of the entities and individuals described in Paragraph 9 of this Complaint and therefore sues them by the fictitious names of Does 1 through 10. Plaintiff will seek to amend the Complaint to state the true identities of Does 1 through 10 when ascertained.

## THE MOROCCANOIL PRODUCTS

11. Genuine MoroccanOil Oil Treatment is packaged in 3.4 fluid ounce, amber colored, druggist-style bottles with black screw-on caps. The light blue, rectangular-shaped front labels of the MoroccanOil Oil Treatment contain the MoroccanOil logo with an orange-colored “M” and the word “MOROCCANOIL” in white, capital letters vertically up the left hand side of the label, as well as the words “Oil treatment for all hair types,” “MoroccanOil Series,” and “alcohol free” in English, French and Spanish. The light blue, rectangular-shaped back labels of the MoroccanOil Oil Treatment contain the MoroccanOil logo with “MOROCCANOIL” in orange, capital letters, a description of the product and its usage in English, French and Spanish, the ingredient list, and the words “Sold Exclusively By Professional Salons.” Each genuine bottle includes a sticker that extends from the top of the bottle cap down to the front of the bottle that includes the MoroccanOil logo with an orange “M” with the word “MoroccanOil” through it in white letters, and the words “The Original” in English and French. MoroccanOil Products bear the trademarks, trade names and trade dress described below.

12. MoroccanOil applies Uniform Code Council barcode numbers to its products. These barcodes are widely used by manufacturers, distributors and sellers to keep track of and identify the products they sell. MoroccanOil was issued an EAN-13 (international) UPC manufacturer number of 7290011 by the Uniform Code Council. The first three numbers, 729, refer to the fact that MoroccanOil manufactures its Oil Treatment products in Israel. UPC barcode number 7290011-521011 refers to the 3.4 ounce size of MoroccanOil Oil Treatment (collectively “MoroccanOil UPC Number”). MoroccanOil prints the MoroccanOil UPC Number on the labels of all of its Oil Treatment products during their manufacture.

13. The following images are true and correct photographs of the front and back side of a bottle of genuine Moroccanoil Oil Treatment:



### **MOROCCANOIL'S INTELLECTUAL PROPERTY**

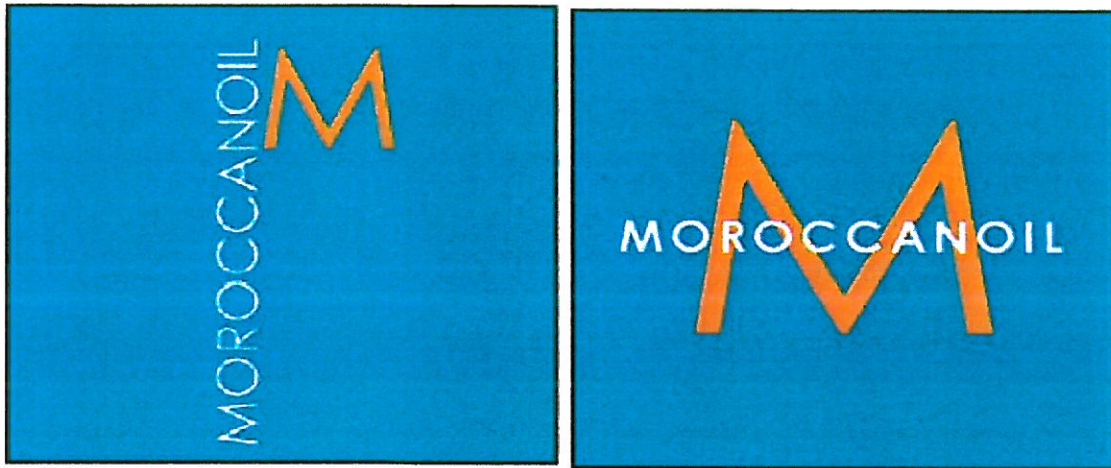
14. Moroccanoil is the owner of numerous federally registered trademarks including: the word “MOROCCANOIL”(U.S. Reg. No. 3,478,807), the vertical “M Moroccanoil Design” (U.S. Reg. No. 3,684,910), and the horizontal “M Moroccanoil Design” (U.S. Reg. No. 3,684,909). The trademarks are registered in Class 3 on the Principal Register of the United States Patent and Trademark Office which includes soaps and cosmetics. These trademarks are collectively referred to as “Moroccanoil Trademarks.”

15. The following images are true and correct photographs of the Moroccanoil Trademarks:

TRADEMARK  
PRINCIPAL REGISTER

MOROCCANOIL

USPTO Registration No. 3,478,807



USPTO Registration No.  
3,684,910

USPTO Registration No.  
3,684,909

16. Moroccanoil's trade dress encompasses the size, shape, color, wording, graphics, packaging and overall appearance of the Moroccanoil Products as well as the placement and position of the Moroccanoil Trademarks on the labels and packaging ("Moroccanoil Trade Dress"). Moroccanoil Trade Dress is non-functional, inherently distinctive, and has become uniquely associated with Moroccanoil in the marketplace as the source of these products.