

**IN THE UNITED STATES DISTRICT COURT
FOR THE NORTHERN DISTRICT OF TEXAS
DALLAS DIVISION**

SHAKE-N-GO FASHION, INC.,

Plaintiff,

v.

JENNY BEAUTY SUPER CENTER

Defendant.

Civil Action No. 11-cv-3379

Jury Trial Demanded

ORIGINAL COMPLAINT

Plaintiff Shake-N-Go Fashion, Inc. (“Plaintiff”) files this Original Complaint (“Complaint”) against Jenny Beauty Super Center (“Defendant”) and would respectfully show the Court as follows:

PARTIES

1. Plaintiff Shake-N-Go Fashion, Inc. is a corporation, organized and existing under the laws of New York, having its principal place of business at 83 Harbor Road, Port Washington, New York 11050.

2. Upon information and belief, Defendant Jenny Beauty Super Center (“Defendant”) is an entity that owns and operates three beauty supply stores at the following locations: 3328 Mansfield Highway, Forth Worth, Texas 76119; 6322 Meadowbrook Drive, Forth Worth, Texas 76112; and 4343 Gannon Lane, Dallas, Texas 75237.

JURISDICTION AND VENUE

3. This is an action for trademark infringement, unfair competition and dilution arising under the Trademark Act of 1946, 15 U.S.C. §§ 1051, *et seq.*

4. This Court has original subject matter jurisdiction over this action pursuant to 28 U.S.C. §§ 1331, 1332 and 1338 because this is an action for trademark infringement.

5. This Court has personal jurisdiction over Defendant because Defendant exists and regularly transacts business in this judicial district with citizens of this state.

6. Venue is proper in this judicial district under 28 U.S.C. §§ 1391 (b).

7. Plaintiff is seeking damages from the Defendants in excess of \$75,000.

FACTS

8. Established in 1991, Plaintiff is one of the world's largest manufacturers of hair extensions, wigs, hair pieces and accessories. Plaintiff markets and sells these hair products in the United States under a variety of trademarks, including the MILKY WAY trademark (identified below).

9. Plaintiff is the owner of United States Trademark Registration No. 2,187,687 (hereinafter, the "687 Registration"), which issued on September 8, 1998 for the MILKY WAY trademark, and currently covers "hair products made of fibers, namely, hair ornaments, hair pieces, hair weaves and wigs." The '687 Registration is valid, unrevoked, and uncanceled, and has attained incontestable status. A copy of the '687 Registration certificate is attached hereto as Exhibit A.

10. Plaintiff is also the owner of United States Trademark Registration No. 3,615,766 (hereinafter, the "766 Registration"), which issued on May 5, 2009 for the MILKY WAY Mark, as applied to "hair products, namely, hair pieces, wigs, hair braids, hair extensions, ponytails and hair weaves." The '766 Registration is valid, unrevoked and uncanceled. A copy of the '766 Registration certificate is attached hereto as Exhibit B.

11. Plaintiff is the exclusive owner of the entire right, title and interest in the MILKY WAY mark in all its forms, including the '687 Registration and '766 Registration, and all

accompanying common law rights as applied to various hair products, including hair extensions, wigs, hair pieces and ponytails (collectively, the “MILKY WAY Mark”).

12. Since at least as early as October, 1992, Plaintiff has been using the MILKY WAY Mark in commerce, and as a result of vigorous promotion and extension commercial use, Plaintiff’s MILKY WAY Mark has built up significant good will in the marketplace with consumers and has become famous in association with a range of hair products.

13. Since that date, Plaintiff has been promoting, marketing, selling and/or distributing hair products bearing the MILKY WAY Mark extensively throughout the United States, including Texas.

14. Upon information and belief, Defendant recently began selling hair extensions at its three Texas locations under the trademark MILKY WAY.

15. Defendant is not an authorized dealer of Plaintiff and Plaintiff has not authorized or consented to Defendant using Plaintiff’s MILKY WAY trademark.

16. Upon information and belief, Defendant offers no warranty or return policy for the hair extensions it is selling under the MILKY WAY trademark, which is substantially and materially different from the warranty and return policy offered by Plaintiff for the sale of its hair products through its authorized dealers, such that the goods are materially different from those sold by Plaintiff under the MILKY WAY Mark.

17. Upon information and belief, Defendant has circulated advertisements promoting, among other things, hair extensions under the MILKY WAY trademark. A copy of such an advertisement is attached as Exhibit C.

18. The MILKY WAY trademark being used by Defendant is identical to Plaintiff’s registered, incontestable trademark MILKY WAY.

19. Upon information and belief, Defendant markets its MILKY WAY products to the same class of consumers as Plaintiff markets its MILKY WAY products, and through identical channels of trade.

COUNT ONE

(Federal Trademark Infringement under 15 U.S.C. § 1114)

20. Plaintiff repeats and realleges paragraphs 1 through 19 of this Complaint as if fully set forth herein.

21. Without the consent or authorization of Plaintiff, and having knowledge of Plaintiff's prior rights in the MILKY WAY Mark, Defendant has used the MILKY WAY Mark in connection with hair products, including hair extensions.

22. Upon information and belief, Defendant's use of Plaintiff's MILKY WAY Mark in an unauthorized, deceptive manner has independently and cumulatively had the effect of confusing consumers as to the affiliation and/or sponsorship of Defendant with Plaintiff.

23. Defendant's use of the MILKY WAY Mark is likely to cause and is causing confusion, mistake and deception among the general purchasing public as to the origin of Defendant's infringing products, and is likely to deceive consumers into believing that Defendant's sales are associated with, or are otherwise authorized by Plaintiff, all to the damage and detriment of Plaintiff's reputation, goodwill and sales.

24. Upon information and belief, Defendant's use of the MILKY WAY Mark was done with the intention to cause confusion and to deceive the general purchasing public.

25. Defendant's use of the MILKY WAY Mark therefore constitutes an infringement of Plaintiff's '687 Registration under 15 U.S.C. § 1114.

26. Plaintiff has no adequate remedy at law. If Defendant's activities are not enjoined, Plaintiff will continue to suffer irreparable harm and injury to Plaintiff's goodwill and reputation.

COUNT TWO

(Federal Trademark Infringement under 15 U.S.C. § 1114)

27. Plaintiff repeats and realleges paragraphs 1 through 26 of this Complaint as if fully set forth herein.

28. Based on the above allegations, Defendant's use of the MILKY WAY Mark also constitutes an infringement of Plaintiff's '766 Registration under 15 U.S.C. § 1114.

29. Plaintiff has no adequate remedy at law. If Defendant's activities are not enjoined, Plaintiff will continue to suffer irreparable harm and injury to Plaintiff's goodwill and reputation.

COUNT THREE

(Federal Unfair Competition Under 15 U.S.C. § 1125(a))

30. Plaintiff repeats and realleges paragraphs 1 through 29 of this Complaint as if fully set forth herein.

31. The goods sold by Defendant are the same type of products as those sold by Plaintiff in connection with Plaintiff's MILKY WAY Mark and, as such, Defendant's use is likely to cause confusion to the general purchasing public.

32. By intentionally misappropriating and using the MILKY WAY Mark, with knowledge of Plaintiff's prior rights in Plaintiff's Mark, Defendant misrepresents and falsely describes to the general public the origin and source of Defendant's goods and creates a likelihood of confusion or mistake by the consuming public.

33. Defendant's unauthorized and unlicensed use of the MILKY WAY Mark creates express and implied misrepresentations that Defendant's conduct was authorized or approved by Plaintiff, all to Defendant's profit and Plaintiff's great damage and injury.

34. Defendant's use of the MILKY WAY Mark therefore constitutes an infringement of Plaintiff's rights in its MILKY WAY Mark under 15 U.S.C. § 1125(a).

COUNT FOUR

(Dilution of Trademarks Under 15 U.S.C. § 1125(c))

35. Plaintiff repeats and realleges paragraphs 1 through 34 of this Complaint as if fully set forth herein.

36. Plaintiff's MILKY WAY Mark has acquired strong recognition and fame in the marketplace as a result of its extensive use, advertising and publicity by Plaintiff.

37. Defendant's unauthorized and commercial use of Plaintiff's MILKY WAY Mark tends to, and does, dilute, tarnish and blur its distinctive quality and is diminishing and will destroy the public association of said trademark with Plaintiff in violation of 15 U.S.C. § 1125(c).

38. Plaintiff has no adequate remedy at law. If Defendant's activities are not enjoined, Plaintiff will continue to suffer irreparable harm and injury to Plaintiff's goodwill and reputation.

COUNT FIVE

(Common Law Trademark Infringement)

39. Plaintiff repeats and realleges paragraphs 1 through 38 of this Complaint as if fully set forth herein.

40. Plaintiff has built up valuable goodwill in its MILKY WAY Mark.

41. Defendant has, with full knowledge of Plaintiff's prior trademark rights and without authorization from Plaintiff, used an identical trademark to Plaintiff's MILKY WAY Mark to advertise, distribute, sell, and offer to sell hair products, including but not limited to hair extensions.

42. Defendant's acts as alleged herein are likely to cause confusion, mistake and deception to consumers as to the affiliation, connection or association of Defendant with Plaintiff.

43. Defendant's unauthorized acts constitute direct infringement of Plaintiff's trademark rights in violation of Texas common law.

44. Plaintiff has suffered, is suffering, and will continue to suffer irreparable injury for which Plaintiff has no adequate remedy at law. Plaintiff is therefore entitled to a permanent injunction against further infringing conduct by Defendant.

JURY DEMAND

Plaintiff hereby requests a trial by jury pursuant to Federal Rule of Civil Procedure 38.

PRAYER FOR RELIEF

WHEREFORE, Plaintiff respectfully requests that Defendant be cited to appear and answer herein and that, upon final trial hereof, Plaintiff be awarded the relief sought hereinabove against Defendant including, but not limited to:

A. Preliminarily and permanently restraining and enjoining Defendant and all persons in active concert and participation with Defendant, from:

1. using in any manner Plaintiff's MILKY WAY Mark, alone or in combination with any word or words which so resemble the MILKY WAY Mark as to be likely to cause confusion, deception or mistake on or in connection with the advertising,

offering for sale, or sale of any product not Plaintiff's, or not authorized by Plaintiff to be sold in connection with the MILKY WAY Mark;

2. committing any acts calculated to cause purchasers to believe that Defendant's products are those sold under the control and supervision of Plaintiff, or that Defendant is sponsored or approved by, or connected with, or guaranteed by, or operating under the control and supervision of Plaintiff;

3. otherwise competing unfairly with Plaintiff in any manner; and

requiring Defendant and all persons in active concert and participation with Defendant:

4. to deliver to Plaintiff for destruction any and all products, guarantees, circulars, price lists, labels, signs, prints, packages, wrappers, advertising matter, promotional, and other materials in the possession of Defendant or under Defendant's control bearing the MILKY WAY Mark, alone or in combination with any other words;

5. to forthwith deliver up for destruction their entire inventory of said products bearing the aforesaid infringing MILKY WAY Mark; and

6. to cease all advertising of the MILKY WAY Mark and retract all pending advertisements of the MILKY WAY Mark that have not yet been published.

B. That Defendant, within thirty (30) days after service of judgment with notice of entry thereof upon it, be required to file with the Court and serve upon Plaintiff a written report under oath setting forth in detail the manner in which Defendant has complied with paragraphs A(1) through A(6), supra.

C. Actual damages, costs, attorneys' fees, and an accounting of Defendant's profits attributable to Defendant's unauthorized use of Plaintiff's MILKY WAY Mark.

D. Punitive damages in an amount sufficient to punish Defendant for its infringement of Plaintiff's MILKY WAY Mark.

E. Any other and further relief as the Court may deem just and proper.

Dated: December 7, 2011

Respectfully submitted,

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