

1 Sid Leach (#019519)  
SNELL & WILMER L.L.P.  
2 One Arizona Center  
400 East Van Buren  
3 Phoenix, AZ 85004-2202  
Telephone: (602) 382-6372  
4 Facsimile: (602) 382-6070  
E-mail: sleach@swlaw.com

5 J. Rick Taché (#024246)  
SNELL & WILMER L.L.P.  
6 600 Anton Blvd., Suite 1400  
7 Costa Mesa, CA 92626  
Telephone: (714) 427-7039  
8 Facsimile: (714) 427-7799  
E-mail: rtache@swlaw.com

9 Attorneys for Plaintiff philosophy, inc.

10  
11 **IN THE UNITED STATES DISTRICT COURT FOR THE  
DISTRICT OF ARIZONA**

12  
13 philosophy, inc.,

14 *Plaintiff,*

15 vs.

16 Kate Somerville Skin Care, LLC,

17 *Defendant.*

Civil Action No. 2:07-cv-1695

**COMPLAINT FOR TRADEMARK  
INFRINGEMENT, UNFAIR  
COMPETITION AND LANHAM ACT  
VIOLATIONS**

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19  
20 Plaintiff, philosophy, inc., by and through its undersigned attorneys, complains of  
21 Defendant and alleges as follows:

22 **PARTIES**

23 1. Plaintiff, philosophy, inc. (“Philosophy”) is a corporation incorporated  
24 under the laws of the State of Arizona and has a principal place of business at 3809 East  
25 Watkins Street, Phoenix, Arizona 85034.

26 2. Defendant Kate Somerville Skin Care, LLC. (“KSSC”) is a limited liability  
27 company organized under the laws of the State of California. Upon information and  
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1 belief, Defendant's principal place of business is at 8428 Melrose Place, Suites E&F,  
2 Los Angeles, California 90069.

3 **JURISDICTION AND VENUE**

4 3. This civil action includes claims for trademark infringement and false  
5 designation of origin, false descriptions, and unfair competition arising under the  
6 Trademark Act of 1946, and specifically for trademark infringement under 15 U.S.C.  
7 §1114(1) and for violations of Section 43(a) of the Lanham Act, codified at 15 U.S.C.  
8 §1125, together with pendent claims under state law for unfair competition and trademark  
9 infringement.

10 4. This Court has subject matter jurisdiction of claims based upon alleged  
11 violations of the Lanham Act pursuant to 15 U.S.C. §1121(a) without regard to the  
12 amount in controversy or to the lack of diversity of the citizenship of the parties. This  
13 Court also has jurisdiction pursuant to 28 U.S.C. §1331, 28 U.S.C. §1338(a) and 28  
14 U.S.C. §1338(b).

15 5. This civil action further includes claims for common law trademark  
16 infringement and unfair competition under the laws of the State of Arizona. Philosophy is  
17 a citizen of the State of Arizona, and Defendant is a citizen of the State of California. The  
18 amount in controversy exceeds the sum or value of Seventy-Five Thousand Dollars  
19 (\$75,000), exclusive of interest and costs.

20 6. This Court has subject matter jurisdiction of the state law claims of unfair  
21 competition pursuant to 28 U.S.C. § 1332(a), and also under the principals of  
22 supplemental jurisdiction provided in 28 U.S.C. § 1367.

23 7. Venue in this district is proper pursuant to 28 U.S.C. §1391(b) & (c). A  
24 substantial part of the events giving rise to the claim occurred in this judicial district, a  
25 substantial part of the property (trademarks and goodwill) that is the subject of this action  
26 is situated in this judicial district, and/or the Defendant resides or may be found in this  
27 judicial district within the meaning of the venue statute.

28

**BACKGROUND**

1  
2 8. Philosophy is a leading provider of high quality skin care products and  
3 cosmetics. Philosophy started in Arizona from virtually nothing and has grown into a  
4 significant business in the State of Arizona.

5 9. Over the years, Philosophy has expended large sums of money advertising  
6 its goods and services, and promoting its products and trademarks. Philosophy has  
7 developed considerable goodwill in its business and in its trademarks. Philosophy is  
8 recognized by the general consuming public of the United States as a source of quality  
9 skin care products and cosmetics. Philosophy has, by its use and promotion, developed a  
10 nationwide reputation.

11 10. Philosophy is the owner of the valid, subsisting, and incontestable United  
12 States Trademark Registration No. 2,006,904 for the trademark HOPE IN A JAR,  
13 registered October 8, 1996, for creams, lotions, moisturizers, cleansers, washes, masks  
14 and toners in International Class 3. A true and correct copy of Registration No. 2,006,904  
15 is attached hereto as Exhibit A and is incorporated herein by reference.

16 11. Philosophy has the exclusive right to use the trademark HOPE IN A JAR in  
17 commerce on or in connection with the goods identified in Registration No. 2,006,904.

18 12. Philosophy has continuously used the trademark HOPE IN A JAR in  
19 commerce on and in connection with the goods identified in Registration No. 2,006,904  
20 since at least as early as January 1, 1996. As a result, the trademark HOPE IN A JAR has  
21 become associated with Philosophy as the source of the identified goods and services.

22 13. Philosophy's HOPE IN A JAR products have been highly successful. The  
23 product has been featured nationwide on Oprah's television show three times in the last  
24 nine years and several times on QVC television during the same period of time. In  
25 addition, Philosophy has spent large sums advertising and promoting its HOPE IN A JAR  
26 trademark. Philosophy has, through its use in commerce, established valuable goodwill in  
27 its HOPE IN A JAR trademark.

28 14. In addition to Philosophy's registered trademark HOPE IN A JAR,

1 Philosophy has adopted and used the "... IN A JAR" formative as a trademark in other  
2 contexts and for other products and services, and has acquired prior common law  
3 trademark rights thereto. Philosophy's use of trademarks having the "... IN A JAR"  
4 formative was unique in the marketplace for cosmetics and skin care products. As a  
5 result, trademarks having the "... IN A JAR" formative have become associated with  
6 Philosophy as the source of the identified goods and services.

7 15. Defendant had knowledge of Philosophy's unique and distinctive trademark  
8 HOPE IN A JAR, and sought to capitalize upon the goodwill associated with that  
9 trademark by adopting the confusingly similar trademark KATE IN A JAR for a skin care  
10 product marketed and sold by Defendant in the same channels of trade that are used by  
11 Philosophy. Defendant's adoption of the KATE IN A JAR trademark was intentional and  
12 in bad faith.

13 16. On or about June 29, 2007, Philosophy filed a Notice of Opposition in the  
14 United States Patent and Trademark Office opposing Defendant's application for the  
15 KATE IN A JAR trademark, Opposition No. 91178123. In addition, Philosophy  
16 simultaneously sent Defendant a cease and desist letter requesting Defendant to cease all  
17 of its infringing activity.

18 17. Philosophy has, for more than two months, attempted, in good faith, to  
19 resolve the matter with Defendant. Philosophy was led to believe that Defendant wished  
20 to resolve the trademark disputes between the parties without resort to litigation, and  
21 consequently, refrained from filing suit seeking immediate injunctive relief against  
22 Defendant. Despite Philosophy's efforts, Defendant, knowingly and intentionally  
23 deceived Philosophy, and on September 1, 2007, launched its KATE IN A JAR product  
24 on QVC television and QVC's website, both of which display and offer Defendant's  
25 infringing skin care products for sale prominently displaying the infringing KATE IN A  
26 JAR trademark.

27 18. Philosophy uses QVC television and the Internet as important marketing and  
28 sales channels for its goods and services.

1           19. Defendant's use of the trademark KATE IN A JAR for skin care products  
2 sold in the same channels of trade as Philosophy's products and on the identical type of  
3 product offered to the same consumers is likely to cause confusion, or to cause mistake, or  
4 to deceive as to the affiliation, connection, or association of Defendant's business with  
5 Philosophy.

6           20. Defendant's use of the trademark KATE IN A JAR for skin care products  
7 sold in the same channels of trade as Philosophy's products and on the identical type of  
8 product offered to the same consumers is likely to cause confusion, or to cause mistake, or  
9 to deceive as to the origin, sponsorship, or approval of Defendant's goods, services, or  
10 commercial activities by Philosophy.

11           21. Defendant's use of the trademark KATE IN A JAR has caused and will  
12 continue to cause dilution, by blurring and by tarnishment, of the distinctive quality of  
13 Philosophy's trademark HOPE IN A JAR.

14           22. Philosophy's HOPE IN A JAR trademark has become widely recognized by  
15 the general consuming public of the United States as a source of quality products.

16           23. Defendant has placed its infringing products into the stream of commerce  
17 with the knowledge and intent that the products will be sold in the State of Arizona.  
18 Defendant serves the Arizona market through a regular and established distribution  
19 network that includes the Internet.

20           24. Defendant's products at issue in this case are available in this district via  
21 QVC television and via the Internet at QVC's website (www.qvc.com) and Defendant's  
22 website (www.katesomerville.com).

23           25. Defendant transacts business within this district, directly or indirectly, and  
24 derives substantial revenues from interstate and intrastate commerce.

25           26. Defendant has committed tortious acts within the district, and outside the  
26 district with the intent of having consequences within this district.

27           27. Defendant has specifically directed its conduct and activities at the State of  
28 Arizona, and at consumers in the State of Arizona, by selling and distributing products

1 that are likely to cause confusion, or to cause mistake, or to deceive consumers in the  
2 State of Arizona.

3 28. Defendant was aware of and knew about Philosophy, and specifically  
4 directed its intentional conduct at the State of Arizona knowing that injuries caused by its  
5 unfair competition would be felt in the State of Arizona. Defendant knew or should have  
6 known that it would cause injury to Philosophy and that injury would be suffered by  
7 Philosophy in the State of Arizona as a result of its unfair competition with Philosophy.

8  
9 **COUNT I – TRADEMARK INFRINGEMENT  
UNDER 15 U.S.C. § 1114 AND STATE LAW**

10 29. Philosophy incorporates by reference the allegations of paragraphs 1  
11 through 28.

12 30. Registration No. 2,006,904 gives Philosophy the exclusive right to use the  
13 trademark HOPE IN A JAR in commerce on and in connection with certain skin care  
14 products identified in the Registration, *i.e.*, creams, lotions, moisturizers, cleansers,  
15 washes, masks and toners in International Class 3.

16 31. In addition, Philosophy has established common law trademark rights in the  
17 trademark HOPE IN A JAR.

18 32. Philosophy's use of the distinctive trademark HOPE IN A JAR as a source  
19 of quality goods and services has acquired secondary meaning.

20 33. Philosophy's trademark HOPE IN A JAR has become distinctive of  
21 Philosophy as a source of quality goods and services.

22 34. Defendant's use of the trademark KATE IN A JAR on similar skin care  
23 products in competition with Philosophy in the same channels of trade and on the identical  
24 type of product offered to the same consumers is likely to cause confusion, or to cause  
25 mistake, or to deceive. Philosophy's products and Defendant's infringing products are  
26 both sold on QVC's television channel and its website. In addition, Defendant's  
27 infringing products and Philosophy's products are both sold on the Internet.

28 35. Defendant's actions constitute trademark infringement in violation of 28

1 U.S.C. § 1114.

2 36. Defendant's acts of trademark infringement were undertaken with  
3 knowledge of Philosophy's trademark, and Defendant's adoption of the KATE IN A JAR  
4 trademark was intentional and in bad faith. Defendant sought to capitalize upon the  
5 goodwill associated with Philosophy's trademark HOPE IN A JAR by adopting the  
6 confusingly similar trademark KATE IN A JAR for skin care products. Defendant's  
7 trademark infringement has been willful and deliberate.

8 37. Defendant's acts of trademark infringement have caused damage to  
9 Philosophy.

10 38. Philosophy has suffered irreparable harm, and has no adequate remedy at  
11 law.

12 **COUNT II – FALSE DESIGNATION OF ORIGIN AND UNFAIR**  
13 **COMPETITION UNDER 15 U.S.C. § 1125(a)**

14 39. Philosophy incorporates by reference the allegations of paragraphs 1  
15 through 38.

16 40. Defendant's use of the trademark KATE IN A JAR for Defendant's skin  
17 care products sold in the same channels of trade as Philosophy's products and on the  
18 identical type of product offered to the same consumers, is likely to cause confusion, or to  
19 cause mistake, or to deceive as to the affiliation, connection, or association of Defendant's  
20 business with Philosophy, or as to origin, sponsorship, or approval of Defendant's goods,  
21 services, or commercial activities by Philosophy, in violation of 15 U.S.C. § 1125(a).

22 41. Defendant's use of the mark KATE IN A JAR for skin care products sold in  
23 the same channels of trade as Philosophy's products and on the identical type of product  
24 offered to the same consumers, is likely to cause confusion, or to cause mistake, or to  
25 deceive as to the affiliation, connection, or association of Defendant's business with  
26 Philosophy, or as to the origin, sponsorship, or approval of Defendant's goods, services,  
27 or commercial activities by Philosophy, in violation of 15 U.S.C. § 1125(a).

28 42. On information and belief, the acts of Defendant described above were, and

1 are deliberately calculated to confuse, and/or deceive the public, and said acts, constitute  
2 willful and deliberate violations of 15 U.S.C. § 1125(a).

3 43. By reason of the acts of Defendant alleged herein, Philosophy has suffered,  
4 and will continue to suffer irreparable damage; and unless Defendant is restrained, the  
5 damage and irreparable harm to Philosophy will increase.

6 44. Philosophy has no adequate remedy at law.

7  
8 **COUNT III – UNFAIR COMPETITION**

9 45. Philosophy incorporates by reference the allegations of paragraphs 1  
10 through 44.

11 46. Defendant’s intentional adoption of a trademark confusingly similar to  
12 Philosophy’s registered trademark caused a likelihood of confusion between Defendant’s  
13 products and Philosophy’s products, and has diluted the distinctive quality of  
14 Philosophy’s trademark.

15 47. Defendant’s products bearing the mark KATE IN A JAR have been sold in  
16 the State of Arizona.

17 48. Defendant’s actions to capitalize upon the goodwill in Philosophy’s  
18 distinctive trademark constitute unfair competition.

19 49. By reason of the acts of Defendant alleged herein, Philosophy has suffered,  
20 and will continue to suffer irreparable damage; and unless Defendant is restrained, the  
21 damage and irreparable harm to Philosophy will increase.

22 50. Philosophy has no adequate remedy at law.

23 WHEREFORE, plaintiff Philosophy hereby prays for:

24 I. Judgment that Defendant’s conduct violates 15 U.S.C. §§ 1114 & 1125 (a),  
25 and that Defendant’s actions have been willful and in bad faith.

26 II. A temporary and permanent injunction enjoining Defendant, its agents,  
27 servants, employees, attorneys and those persons in active concert or participation with  
28 them from:

- 1           A.     advertising, offering for sale, marketing, distributing, selling or  
2           promoting any skin cares products or services using any false  
3           designation of origin, false or misleading description of fact, or any  
4           false or misleading representation of fact;  
5           B.     using in connection with any skin care products or services, any  
6           promotional materials, advertisements, fliers, brochures, proposals,  
7           labels, signs, contracts, invoices, or other materials printed, electronic  
8           or otherwise, or any Internet or on-line website, the trademark KATE  
9           IN A JAR; and

10           III.    A temporary and permanent injunction enjoining Defendant's acts of  
11           trademark infringement, and prohibiting Defendant from using any mark that is  
12           confusingly similar to Philosophy's HOPE IN A JARS trademark, ordering Defendant to  
13           recall all advertising and Internet web pages bearing the trademark KATE IN A JAR, and  
14           to deliver up under oath for destruction, all Internet web pages, promotional materials,  
15           advertisements, fliers, brochures, labels, signs, contracts, proposals, invoices, or other  
16           materials in its possession, custody or control which bear the trademark KATE IN A JAR,  
17           and to file with this Court in writing, under oath, setting forth in detail the manner in  
18           which Defendant has complied with this injunction.

19           IV.    A temporary and permanent injunction directing Defendant to conduct  
20           remedial advertising to dispel any confusion as to the affiliation, connection, or  
21           association of Defendant's business with Philosophy, or as to the origin, sponsorship, or  
22           approval of Defendant's goods, services, or commercial activities by Philosophy.

23           V.     An award of Defendant's profits, and in addition an award of all damages  
24           suffered by Philosophy.

25           VI.    Trebling the amount awarded to Philosophy in view of Defendant's  
26           knowing and willful infringement and deliberate violation and bad faith in connection  
27           therewith.

28           VII.   An award of punitive damages.

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- VIII. An award of all of Philosophy’s attorneys’ fees incurred in this action.
- IX. An award of costs to Philosophy.
- X. That Philosophy have such other and further relief as the Court may deem appropriate to ensure that Defendant’s unlawful acts are unprofitable, and to prevent further violations of law and acts of unfair competition.

DATED this 4th day of September, 2007.

SNELL & WILMER L.L.P.

By s/ Sid Leach  
Sid Leach (019519)  
One Arizona Center  
400 East Van Buren  
Phoenix, AZ 85004-2202  
(602) 382-6372

J. Rick Taché (024246)  
600 Anton Blvd., Suite 1400  
Costa Mesa, CA 92626  
(714) 427-7039

Attorneys for Philosophy, Inc.

## **EXHIBIT A**

Int. Cl.: 3

Prior U.S. Cls.: 1, 4, 6, 50, 51, and 52

Reg. No. 2,006,904

**United States Patent and Trademark Office** Registered Oct. 8, 1996

**TRADEMARK  
PRINCIPAL REGISTER**

**HOPE IN A JAR**

COSMEDIC CONCEPTS, INC. (ARIZONA CORPORATION), DBA BIOMEDIC CLINICAL CARE,  
8757 E. VIA DE COMMERCIO, SUITE 200  
SCOTTSDALE, AZ 85258

FOR: SKIN CARE PRODUCTS, NAMELY  
CREAMS, LOTIONS, MOISTURIZERS,  
CLEANSERS, WASHES, MASKS, AND

TONERS, IN CLASS 3 (U.S. CLS. 1, 4, 6, 50, 51 AND 52).

FIRST USE 1-1-1996; IN COMMERCE 1-1-1996.

SN 74-597,851, FILED 11-14-1994.

JUDITH GRUNDY, EXAMINING ATTORNEY