

1 Peter C. Bernhard, Esq. (NSB 734)  
2 Judah Zakalik, Esq. (NSB 9228)  
3 Bullivant Houser Bailey P.C.  
3883 Howard Hughes Pkwy., Ste. 550  
4 Las Vegas, NV 89169  
5 Telephone: 702-669-3600  
6 Facsimile: 702-650-2995  
7 *Attorneys for Plaintiffs*

8 **UNITED STATES DISTRICT COURT**  
9 **DISTRICT OF NEVADA**

10 -----X  
11 ESTÉE LAUDER COSMETICS LTD. and :  
12 MAKE-UP ART COSMETICS INC., :  
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Plaintiffs,

-against-

SANG CHUNG d/b/a BASIC and SE CHUNG  
d/b/a BASIC

Defendants.

Civil Action No.

2:07-CV-01384

**COMPLAINT**

Plaintiffs Estée Lauder Cosmetics Ltd. (“Estée Lauder”) and Make-Up Art Cosmetics Inc. (“Make-Up Art”)(collectively referred to as “Plaintiffs”), by their attorneys Bullivant Houser Bailey P.C., allege on knowledge as to their own acts and otherwise on information and belief as follows:

**NATURE OF THE ACTION**

1. This is an action for trademark infringement, false designation of origin, false advertising, and unfair competition in violation of the laws of the United States and the State of Nevada. Plaintiffs seek an injunction, damages and related relief.

1 **JURISDICTION AND VENUE**

2 2. This Court has jurisdiction over this matter pursuant to 15 U.S.C. § 1121 and 28  
3 U.S.C. §§ 1331, 1338 and 1367. Plaintiffs' claims are predicated upon the Lanham Trademark  
4 Act of 1946, as amended, 15 U.S.C. § 1051, et seq., and related claims under the statutory and  
5 common law of the State of Nevada. Venue is properly founded in this district pursuant to 28  
6 U.S.C. § 1391 (b) and (c).  
7

8 **THE PARTIES**

9 3. Plaintiff Estée Lauder Cosmetics Ltd. is a Canadian corporation with its principal  
10 place of business at 767 5<sup>th</sup> Avenue, New York, New York 10153.

11 4. Plaintiff Make-Up Art Cosmetics Inc. is a Delaware corporation with its principal  
12 place of business at 767 5<sup>th</sup> Avenue, New York, New York 10153.

13 5. Defendant Sang Chung ("Sang Chung") is an individual doing business as  
14 BASIC, with locations at the Boulevard Mall, 3680 South Maryland Parkway, Suite 143, Las  
15 Vegas, Nevada 89119 and the Meadows Mall, 4300 Meadows Lane, Las Vegas, Nevada 89107.  
16

17 6. Defendant Se Chung ("Se Chung") is an individual doing business as BASIC,  
18 with locations at the Boulevard Mall, 3680 South Maryland Parkway, Suite 143, Las Vegas,  
19 Nevada 89119 and the Meadows Mall, 4300 Meadows Lane, Las Vegas, Nevada 89107 (Sang  
20 Chung and Se Chung are collectively referred to as "Basic" or "Defendants"). Basic has sold  
21 (and is selling) the infringing products at issue in this case and other products in Nevada and this  
22 judicial district.  
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**THE MAC TRADEMARKS**

1  
2 7. Estée Lauder is engaged in the manufacture, distribution and sale in interstate and  
3 foreign commerce of high-end merchandise, including but not limited to cosmetics, all of which  
4 are sold in high quality retail stores, major department stores and over the Internet.

5  
6 8. Since at least as early as 1985, Estée Lauder merchandise has been widely  
7 advertised, offered for sale and sold throughout the United States and the world under various  
8 registered and common law trademarks, including, but not limited to, MAC, the Stylized M·A·C  
9 trademark, M-A-C-P-R-O and the Stylized M·A·C PRO LASH trademark (collectively the  
10 “MAC Trademarks”). The MAC Trademarks have at all times been owned exclusively by Estée  
11 Lauder, its affiliates and/or its predecessors. Make-Up Art has the exclusive right to use the  
12 MAC Trademarks (hereinafter Make-Up Art will be referred to as the party advertising, offering  
13 for sale and selling products with the MAC Trademarks).

14  
15 9. Among the products marketed by Make-Up Art using the MAC Trademarks are  
16 the “Mac Pro Lash” mascara and the “Mac Lipgelée” lipglass. The “Mac Pro Lash” mascara and  
17 the “Mac Lipgelée” lipglass, which prominently feature the MAC Trademarks, have achieved  
18 substantial success in the marketplace.

19  
20 10. As a result of Make-Up Art’s exclusive and extensive use and promotion of the  
21 MAC Trademarks, these marks have acquired enormous value and recognition in the United  
22 States and throughout the world. The MAC Trademarks are well known to the consuming public  
23 and trade as identifying and distinguishing Make-Up Art exclusively and uniquely as the source  
24 of the high quality merchandise to which the MAC Trademarks are applied.

25  
26 11. On April 30, 1991, the Stylized M·A·C Trademark was entered on the Principal  
27 Register of the United States Patent and Trademark Office as Registered Trademark

1 No. 1,642,532. On July 4, 2000, the M-A-C-P-R-O Trademark was entered on the Principal  
2 Register of the United States Patent and Trademark Office as Registered Trademark  
3 No. 2,364,828. On May 12, 2003, the Stylized M·A·C PRO LASH Trademark was entered on  
4 the Principal Register of the United States Patent and Trademark Office as Registered Trademark  
5 No. 2,716,306. On December 6, 2005, the MAC Trademark was entered on the Principal  
6 Register of the United States Patent and Trademark Office as Registered Trademark No.  
7 3,023,827. Copies of these registrations are attached hereto as Exhibit "A". These registrations  
8 are valid and subsisting and are in full force and effect.  
9

10 12. Registered Trademarks Nos. 1,642,532 and 2,364,828 have achieved  
11 incontestable status pursuant to 15 U.S.C. § 1065.

12 **THE VIVA GLAM TRADEMARK**

13 13. Make-Up Art is engaged in the manufacture, distribution and sale in interstate and  
14 foreign commerce of high-end merchandise, including but not limited to cosmetics, all of which  
15 are sold in high quality retail stores, major department stores and over the Internet.  
16

17 14. Since at least as early as 1992, Make-Up Art has widely advertised, offered for  
18 sale and sold lipsticks throughout the United States and the world under the VIVA GLAM  
19 trademark (the "VIVA GLAM Trademark"). The VIVA GLAM Trademark has at all times  
20 been owned exclusively by Make-Up Art or its predecessors.  
21

22 15. VIVA GLAM is one of the fashion world's most successful and glamorous  
23 fundraising initiatives of all time. 100% of the retail selling price of all VIVA GLAM products,  
24 are donated to the MAC AIDS Fund. To date, over \$70 million from the sale of VIVA GLAM  
25 products has been donated to the MAC AIDS Fund.  
26  
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1 Plaintiffs, and/or (c) such Infringing Products are being offered to consumers with the  
2 sponsorship and/or approval of Plaintiffs.

3 21. Defendants' aforementioned acts were willful and intentional, in that Defendants  
4 either knew that said products bore marks confusingly similar to the MAC Trademarks and the  
5 VIVA GLAM Trademark, or willfully ignored such fact. Defendants' acts were undertaken in a  
6 deliberate effort to cause confusion and mistake among the consuming public as to the source,  
7 affiliation and/or sponsorship of said products, and to gain the benefit of the enormous goodwill  
8 associated with the MAC Trademarks and the VIVA GLAM Trademark.  
9

10 **FIRST CLAIM FOR RELIEF**  
11 **(TRADEMARK INFRINGEMENT)**

12 22. Plaintiffs repeat and reallege the allegations set forth in paragraphs 1 through 21  
13 above as if fully set forth herein.

14 23. Defendants' use of the MAC Trademarks and the VIVA GLAM Trademark,  
15 without Plaintiffs' consent, constitutes trademark infringement in violation of 15 U.S.C. § 1114,  
16 in that, among other things, such use is likely to cause confusion, deception and mistake among  
17 the consuming public and trade as to the source, approval or sponsorship of the Infringing  
18 Products.  
19

20 24. Defendants' misconduct has injured Plaintiffs in an amount to be determined at  
21 trial and has caused and will continue to cause irreparable injury to Plaintiffs, for which Plaintiffs  
22 have no adequate remedy at law.

23 **SECOND CLAIM FOR RELIEF**  
24 **(FALSE DESIGNATION OF ORIGIN)**

25 25. Plaintiffs repeat and reallege the allegations set forth in paragraphs 1 through 24  
26 above as if fully set forth herein.  
27  
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1 **FOURTH CLAIM FOR RELIEF**  
2 **(COMMON LAW TRADEMARK INFRINGEMENT AND UNFAIR COMPETITION)**

3 31. Plaintiffs repeat and reallege the allegations set forth in paragraphs 1 through 30  
4 above as if fully set forth herein.

5 32. Defendants' foregoing actions constitute trademark infringement and unfair  
6 competition in violation of the common law of the State of Nevada.

7 33. Defendants' misconduct has injured Plaintiffs in an amount to be determined at  
8 trial and has caused and will continue to cause irreparable injury to Plaintiffs, for which Plaintiffs  
9 have no adequate remedy at law.

10 **FIFTH CLAIM FOR RELIEF**  
11 **(DECEPTIVE TRADE PRACTICES UNDER N.R.S. § 598.0915)**

12 34. Plaintiff repeats and realleges each and every allegation set forth in paragraphs 1  
13 through 33 above as if fully set forth herein.

14 35. In the course of conducting their business, Defendants knowingly made false  
15 representations as to affiliation, connection and/or association with Plaintiffs by using marks that  
16 were confusingly similar to Plaintiffs' trademarks and otherwise engaged in deceptive trade  
17 practices.  
18

19 36. Defendants' misconduct has injured Plaintiffs and has caused and will continue to  
20 cause irreparable injury to Plaintiffs, for which Plaintiffs have no adequate remedy at law.

21 **PRAYER FOR RELIEF**

22 WHEREFORE, Plaintiffs demand that a judgment be entered granting the following  
23 relief:  
24

25 1. Preliminarily and permanently enjoining and restraining Defendants and their  
26 affiliates, divisions, officers, directors, principals, servants, employees, successors and assigns,  
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1 and all those in active concert or participation with them from:

2 (a) Imitating, copying or making unauthorized use of the MAC Trademarks  
3 and/or the VIVA GLAM Trademark;

4 (b) Manufacturing, importing, exporting, distributing, circulating, selling,  
5 offering for sale, advertising, promoting or displaying the Infringing Products or any  
6 other products bearing any marks confusingly similar to the MAC Trademarks and/or the  
7 VIVA GLAM Trademark, either individually or in conjunction with other words, marks  
8 or designs;

9 (c) Using any mark confusingly similar to any of the MAC Trademarks  
10 and/or the VIVA GLAM Trademark in connection with the manufacture, promotion,  
11 advertisement, display, sale, offering for sale, production, import, export, circulation or  
12 distribution of any product in such manner as to relate or connect, or tend to relate or  
13 connect, such product in any way with Plaintiffs or to any goods sold, sponsored,  
14 approved by, or connected with Plaintiffs;

15 (d) Engaging in any other activity constituting unfair competition with  
16 Plaintiffs, or constituting an infringement of any of the MAC Trademarks and/or the  
17 VIVA GLAM Trademark or of Plaintiffs' rights in, or their rights to use or exploit such  
18 trademarks, or the reputation and the goodwill associated with the MAC Trademarks  
19 and/or the VIVA GLAM Trademark;

20 (e) Making any statement or representation whatsoever, with respect to the  
21 Infringing Products, that falsely designates Plaintiffs as the origin of the goods, or that is  
22 false or misleading with respect to Plaintiffs; and  
23  
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1 (f) Engaging in any other activity, including the effectuation of assignments  
2 or transfers of their interests in marks confusingly similar to the MAC Trademarks and/or  
3 the VIVA GLAM Trademark, the formation of other corporations, partnerships,  
4 associations or other entities or the utilization of any other devices, for the purpose of  
5 circumventing, evading, avoiding or otherwise violating the prohibitions set forth in  
6 subsections 1(a) through 1(e) above.

7  
8 2. Directing that Defendants deliver for destruction all products, labels, tags,  
9 artwork, prints, signs, packages, dies, wrappers, receptacles and advertisements in their  
10 possession, custody or control bearing any marks confusingly similar to the MAC Trademarks  
11 and/or the VIVA GLAM Trademark, including all plates, molds, matrices and other means of  
12 making such infringements of the MAC Trademarks and/or the VIVA GLAM Trademark.

13  
14 3. Directing such other relief as the Court may deem appropriate to prevent the trade  
15 and public from deriving any erroneous impression that any products at issue in this case that  
16 have been offered for sale, sold or otherwise circulated or promoted by Defendants are  
17 authorized by Plaintiffs or are related to or associated in any way with Plaintiffs' products.

18  
19 4. Awarding Plaintiffs all damages sustained by them as a result of Defendants'  
20 wrongful acts, and trebling those amounts, pursuant to 15 U.S.C. § 1117.

21  
22 5. Requiring Defendants to account and pay over to Plaintiffs all profits realized by  
23 their wrongful acts, and trebling those amounts, pursuant to 15 U.S.C. § 1117.

24  
25 6. Awarding Plaintiffs their reasonable attorneys' fees, costs and pre-judgment  
26 interest.

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# **EXHIBIT A**

Int. Cls.: 3, 16 and 21

Prior U.S. Cls.: 2, 21, 23, 51 and 52

Reg. No. 1,642,532

**United States Patent and Trademark Office** Registered Apr. 30, 1991

**TRADEMARK  
PRINCIPAL REGISTER**



MAKE-UP ART (COSMETICS) LIMITED  
(CANADA CORPORATION), DBA MAKE-UP  
ART COSMETICS LIMITED  
233 CARLTON STREET  
TORONTO, ONTARIO M5R 1G2, CANADA

FOR: COSMETICS, NAMELY, EYE SHADOW,  
EYE MAKE-UP REMOVER, EYE LINER,  
FOUNDATION MAKE-UP, FACE POWDER,  
LIPSTICK, LIP GLOSS, LIP SHINER, MAS-  
CARA, NAIL POLISH, EYEBROW PENCIL,  
ROUGE, FACE SHIMMERS, HAIR TINTS,  
BODY LOTIONS, MOISTURE LOTION, MOIS-  
TURE TONICS, SKIN CLEANER, HAIR SHAM-  
POO, HAIR CONDITIONER, NON-MEDICATED  
HAIR CONDITIONER, NON-MEDICATED  
HAIR PREPARATIONS, DUSTING POWDER,  
FACIAL MOISTURIZERS, IN CLASS 3 (U.S.  
CLS. 51 AND 52).

FIRST USE 1-1-1983; IN COMMERCE  
11-1-1985.

FOR: COSMETIC PENCIL SHARPENERS, IN  
CLASS 16 (U.S. CL. 23).

FIRST USE 1-1-1983; IN COMMERCE  
11-1-1985.

FOR: COSMETIC CASES SOLD EMPTY, COS-  
METIC BRUSHES, DUSTERS FOR APPLYING  
MAKE-UP, LIP BRUSHES, AND COSMETIC  
SPONGES, IN CLASS 21 (U.S. CLS. 2 AND 21).

FIRST USE 1-1-1983; IN COMMERCE  
11-1-1985.

SER. NO. 73-734,276, FILED 6-6-1988.

RONALD R. SUSSMAN, EXAMINING ATTOR-  
NEY

**Int. Cls.: 3, 35, and 42**

**Prior U.S. Cls.: 1, 4, 6, 50, 51, 52, 100, 101, and 102**

**Reg. No. 2,364,828**

**United States Patent and Trademark Office**

**Registered July 4, 2000**

**TRADEMARK  
SERVICE MARK  
PRINCIPAL REGISTER**

**M-A-C-P-R-O**

MAKE-UP ART COSMETICS LTD. (CANADA CORPORATION)  
133 CARLTON STREET  
SUITE 201  
TORONTO, ONTARIO, M5A 2L2, CANADA

FOR: MAKE-UP, NAMELY, FOUNDATION, BLUSH, FACE POWDERS, FACE CREAMS, BLEMISH CONCEALERS, EYE SHADOW, EYE PENCILS, EYE CREAMS, LIPSTICK, LIP GLOSS, LIP PENCILS, LIP CONDITIONING CREAMS, MASCARA, LASH ENHANCING/PRIMING PREPARATIONS, EYE BROW PENCILS, EYE BROW GELS, EYE BROW CREAMS, MAKE-UP REMOVER, NAIL LACQUER AND NAIL CREAM; TOILETRIES, NAMELY, PERFUMES AND COLOGNES, ESSENTIAL OILS FOR PERSONAL USE AND THE MANUFACTURE OF FRAGRANCE; SKIN CARE PREPARATIONS, NAMELY, LOTIONS, MOISTURIZING CREAMS, GELS, TONICS, MASKS, TONERS, CLEANSERS AND POWDERS; SOAPS FOR PERSONAL USE, BATH SALTS, BATH OILS, BATH GELS, DEODORANTS FOR PERSONAL USE AND ANTIPERSPIRANTS; SHAVING

CREAMS, LOTIONS AND GELS; HAIR CONDITIONERS, SHAMPOO, HAIR GELS, HAIR SPRAYS, NON-MEDICATED HAIR THICKENING PREPARATIONS; SUN TAN LOTIONS, SUNTANNING PREPARATIONS, SUN BLOCK PREPARATIONS, BRONZING PREPARATIONS, BODY SPRAYS AND BODY WASHES, IN CLASS 3 (U.S. CLS. 1, 4, 6, 50, 51 AND 52).

FIRST USE 6-15-1998; IN COMMERCE 6-15-1998.

FOR: RETAIL STORE SERVICES FEATURING COSMETICS AND BEAUTY PRODUCTS, IN CLASS 35 (U.S. CLS. 100, 101 AND 102).

FIRST USE 6-15-1998; IN COMMERCE 6-15-1998.

FOR: COSMETIC, MAKEUP AND BEAUTY CONSULTATION SERVICES, IN CLASS 42 (U.S. CLS. 100 AND 101).

FIRST USE 6-15-1998; IN COMMERCE 6-15-1998.  
OWNER OF U.S. REG. NO. 1,642,532.

SN 75-193,313, FILED 11-5-1996.

JENNIFER KRISP, EXAMINING ATTORNEY

**Int. Cl.: 3**

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

**Reg. No. 2,716,306**

**United States Patent and Trademark Office**

**Registered May 13, 2003**

**TRADEMARK  
PRINCIPAL REGISTER**

**MAC  
PRO LASH**

ESTEE LAUDER COSMETICS LTD. (CANADA  
CORPORATION)  
161 COMMANDER BOULEVARD  
AGINCOURT, ONTARIO, CANADA

NO CLAIM IS MADE TO THE EXCLUSIVE  
RIGHT TO USE "LASH", APART FROM THE MARK  
AS SHOWN.

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

SN 76-206,552, FILED 2-7-2001.

FIRST USE 7-1-2001; IN COMMERCE 7-1-2001.

SHAUNIA WALLACE, EXAMINING ATTORNEY

Int. Cls.: 3 and 44

Prior U.S. Cls.: 1, 4, 6, 50, 51, 52, 100 and 101

Reg. No. 3,023,827

**United States Patent and Trademark Office**

Registered Dec. 6, 2005

**TRADEMARK  
SERVICE MARK  
PRINCIPAL REGISTER**

**MAC**

ESTEE LAUDER COSMETICS LTD. (CANADA CORPORATION)

161 COMMANDER BOULEVARD  
AGINCOURT, CANADA M1S 3K9

FOR: COSMETIC PRODUCTS INCLUDING LIP-STICKS, LIP GLOSS, LIP LINERS, LIP BALMS, EYE SHADOWS, EYE LINING PENCILS, LIQUID EYE LINERS, EYE MAKEUP, MASCARA, EYEBROW PENCILS, ARTIFICIAL EYELASHES, BLUSHERS, BRONZERS, MULTI-USE COSMETIC STICKS, FOUNDATION MAKEUP, PRESSED POWDER, LOOSE POWDER, MAKEUP REMOVER, CONCEALERS, EYE PALETTES, LIP PALETTES, MAKE-UP KITS, MULTI-USE COLORED CREAMS, POWDERS AND GELS FOR USE ON FACE; NAIL POLISH, NAIL ENAMEL, NAIL POLISH REMOVER; NON-MEDICATED SKIN CARE PRODUCTS, NAMELY CLEANSERS, EXFOLIATORS, TONERS, EYE CREAMS, CLEANSING WIPES, MOISTURIZING SPRITZERS, TINTED MOISTURIZERS; FRAGRAN-

CES FOR PERSONAL USE, IN CLASS 3 (U.S. CLS. 1, 4, 6, 50, 51 AND 52).

FIRST USE 1-1-1983; IN COMMERCE 11-1-1985.

FOR: CONSULTATION SERVICES IN THE SELECTION AND USE OF COSMETICS, TOILETRIES AND BEAUTY TREATMENT, IN CLASS 44 (U.S. CLS. 100 AND 101).

FIRST USE 12-31-1987; IN COMMERCE 12-31-1987.

THE MARK CONSISTS OF STANDARD CHARACTERS WITHOUT CLAIM TO ANY PARTICULAR FONT, STYLE, SIZE, OR COLOR.

OWNER OF U.S. REG. NOS. 1,642,532 AND 2,495,240.

SER. NO. 78-581,906, FILED 3-7-2005.

JOHN WILKE, EXAMINING ATTORNEY



# **EXHIBIT B**

**Int. Cl.: 3**

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

**Reg. No. 2,369,642**

**United States Patent and Trademark Office**

**Registered July 25, 2000**

**TRADEMARK  
PRINCIPAL REGISTER**

**VIVA GLAM**

MAKE-UP ART COSMETICS INC. (DELAWARE  
CORPORATION)  
767 FIFTH AVENUE  
NEW YORK, NY 10153 , BY MERGER, BY CHANGE  
OF NAME MAKE UP ART COSMETICS LLC (NEW  
YORK LIMITED LIABILITY COMPANY) MEL-  
VILLE, NY 11747

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

FIRST USE 8-24-1992; IN COMMERCE 8-24-1992.

SER. NO. 75-053,966, FILED 2-6-1996.

KIMBERLY KREHELY, EXAMINING ATTORNEY