

**UNITED STATES DISTRICT COURT FOR
THE DISTRICT OF COLORADO**

Civil Action No.

ZENTS, INC.,
a Colorado corporation,

Plaintiff,

V.

LATHER, INC.,

a California Corporation

Defendant.

**COMPLAINT FOR DECLARATORY JUDGMENT AND CANCELLATION OR
MODIFICATION OF DEFENDANT'S REGISTRATION**

Plaintiff, Zents, Inc. ("Zents"), by and through its undersigned counsel, hereby submits this Complaint for Declaratory Judgment and Cancellation or Modification of Defendant's Registration.

I. PARTIES

1. Zents is a Colorado corporation with its principal place of business located at 6811 Broadway, Boulder, Colorado 80221.

2. Lather, Inc. (the "Defendant") is a California Corporation with its principal place of business at 76 North Fair Oaks Avenue, Pasadena, California, 91103.

II. JURISDICTION AND VENUE

3. This Court has jurisdiction over the subject matter pursuant to § 39 of the Trademark Act of 1946, 15 U.S.C. §1121, 28 U.S.C. §1331 and 28 USC § 1338, this matter involving a federal question and arising under Acts of Congress relating to trademarks and unfair competition.

4 Venue is proper pursuant to 28 U.S.C. §1391(b) and (c), as the Defendant is a corporation subject to personal jurisdiction in Colorado.

5. Personal jurisdiction is proper in Colorado pursuant to §13-1-124(a), C.R.S., as the Defendant has sent a cease and desist letter to Zents in Colorado claiming that Zents use of a square design emanating from Colorado is both likely to be mistaken with the Defendant's registered mark and is likely to dilute the Defendant's registered mark.

III. GENERAL ALLEGATIONS

6. Zents is a manufacturer and distributor of body care and fragrance products.

7. Zents distributes its body care and fragrance products throughout the United States.

8. Since 1999, Zents and its predecessor in interest have been the owner of United States Patent and Trademark Office Registration No. 2,227,701 for the mark ZENTS for perfume having first used such mark in 1997.

9. Since at least as early as 2001 and, perhaps as early as 1998, Zents and its predecessor in interest have used a square to market body care and fragrance products.

10. The squares used by Zents contain, depending on the product, different designs within the square. The square designs used by Zents appear in conjunction with Zents' registered mark.

11. Both prior to and subsequent to Zents' adoption of a square design, many other third parties have used a square design to advertise and market body care and fragrance products.

12. Nevertheless, on January 22, 2008, the Defendant sent Zents a letter claiming that Zents use of a square design will cause consumers to mistakenly conclude that the Defendant and Zents are "somehow affiliated or associated." See Exhibit 1 attached hereto.

13. The Defendant also asserts in Exhibit 1 that Zents' use of a square design will dilute the Defendant's "LATHER design."

14. In support of the Defendant's claims the Defendant cites in Exhibit 1 to USPTO Registration No. 3,062,032, owned by the Defendant and issued on February 28, 2006, for the word Lather and a square design (the "Defendant's Registration"). The design in the Defendant's Registration is completely in the color black.

15. The Defendant states in Exhibit 1 that Zents must cease and desist all use of a square design in its advertising and marketing within ten days from the date of Exhibit 1.

16. Furthermore, the Defendant states in Exhibit 1 that if Zents' agrees to cease use of a square design on the Defendant's timetable it will forego an accounting of damages for past sales and allow a reasonable phase out period. The Defendant goes on to state that if Zents refuses the Defendant "will be less concillatory."

IV. FIRST CLAIM FOR RELIEF
(DECLARATORY JUDGMENT AS TO INFRINGEMENT)

17. Zents incorporates all prior allegations.

18. This claim for relief is made pursuant to Fed. R. Civ. P. 57 and 28 U.S.C. §2201.

19. The Defendant's position that Zents must cease and desist from use of a square design is unwarranted because Zents use of a square design predates the Defendant's registration and application.

20. The Defendant's position that Zents must cease and desist from use of a square design is unwarranted because the Defendant's mark is a common geometric shape which is not inherently distinctive and because the Defendant can not show that such square design has ever achieved a secondary meaning with the consuming public.

21. The Defendant's position that Zents must cease and desist is unwarranted because Zents use of a square design containing designs within the square and using its federally registered mark is sufficiently distinct from the Defendant's use of a solid black square design with the word LATHER as to not likely to cause confusion, or to cause mistake or to deceive as to the source or sponsorship of the parties' products.

22. There is thus a justiciable controversy as to whether Zents' use of a square design containing various patterns in the square is likely to create mistake as to source and origin with the Defendant's use of a solid black square in that there is a substantial controversy between parties having adverse legal interests of sufficient immediacy and reality that the issuance of a declaratory judgment will resolve. In particular, Zents has a real and reasonable apprehension that it will be subject to a suit for liability if it continues to market its products using a square design in any manner.

WHEREFORE, Zents requests the relief at the end of this Complaint.

V. SECOND CLAIM FOR RELIEF
(DECLARATORY JUDGMENT AS TO DILUTION)

23. Zents incorporates all prior allegations.

24. The Defendant's position that Zents' use of a square design is diluting the Defendant's LATHER design is unwarranted because the Defendant's design is neither famous nor distinctive.

25. The Defendant's position that Zents' use of a square design is diluting the Defendant's LATHER design is unwarranted because Zents began using a square design prior to the Defendant's design allegedly becoming famous.

26. Thus there is a justiciable controversy as to whether Zents' use of a square design containing various patterns in the square is likely to dilute the LATHER design in that there is a substantial controversy between parties having adverse legal interests of sufficient immediacy and reality that the issuance of a declaratory judgment will resolve. In particular, Zents has a real and reasonable apprehension that it will be subject to a suit for liability if it continues to market its products using a square design in any manner.

WHEREFORE, Zents requests the relief at the end of this Complaint.

**VI. THIRD CLAIM FOR RELIEF
(MODIFICATION OR CANCELLATION OF REGISTRATION)**

27. Zents incorporates all prior allegations.

28. This claim for relief is made pursuant to 15 U.S.C. § 1119.

29. Since the square design is a common geometric symbol, the Defendant should not have been issued a federal registration that included the LATHER design.

30. In the alternative to the above, the Defendant should have been required by the United States Patent and Trademark Office to disclaim the LATHER design apart from the word mark LATHER.

WHEREFORE, Zents requests the following:

a. The Court declare that Zents use of a square design predates the Defendant's registration and application.

b. The Court declare that the Defendant's mark is a common geometric shape which is not inherently distinctive and that the Defendant can not show that such square design has ever achieved a secondary meaning with the consuming public.

c. The Court declare that Zents use of a square design is not likely to cause confusion, or to cause mistake or to deceive as to the source or sponsorship of the parties' products.

d. The Court declare that Zents is not unfairly competing with the Defendant.

e. The Court declare that the LATHER design is not famous nor distinctive.

f. The Court declare that Zents is not diluting the LATHER design.

g. The Court declare that Zents began using a square design before the LATHER design became famous.

h. The Court award Zents its costs and attorneys' fees pursuant to applicable rule or statute.

i. The Court award such other and proper relief as it deems just and proper in the premises.

Respectfully submitted this 31st day of January 2008.

ZENTS, INC.



Harold R. Bruno, III
Robinson Waters & O'Dorisio, P.C.
1099 18th Street, Suite 2600
Denver, Colorado 80202
Telephone: (303) 297-2600

Plaintiff's Address:

6811 Broadway
Boulder, Colorado 80221

BLAKELY SOKOLOFF TAYLOR & ZAFMAN

A LIMITED LIABILITY PARTNERSHIP INCLUDING LAW CORPORATIONS

TELEPHONE (310) 207-3800

FACSIMILE (310) 820-5988
(310) 820-5270

BSTZ_MAIL@BSTZ.COM
WWW.BSTZ.COM

INTELLECTUAL PROPERTY LAW

12400 WILSHIRE BOULEVARD
SEVENTH FLOOR
LOS ANGELES, CALIFORNIA 90025-1040

OTHER OFFICES

ORANGE COUNTY/COSTA MESA, CA
SILICON VALLEY/SUNNYVALE, CA
DENVER, CO
PORTLAND/BEAVERTON, OR
SEATTLE, WA

January 22, 2008

VIA FEDERAL EXPRESS

ZENTS
6811 Broadway
Denver, CO 80221

Re: Unauthorized Use of LATHER DESIGN

To Whom it May Concern:

We represent Lather, Inc. in connection with its intellectual property matters. Our client has expended considerable resources promoting and marketing its products and services, and in doing so, has generated a substantial amount of goodwill in the appearance of its products. In addition, it owns a federal trademark registration for the LATHER logo, namely, U. S. Registration No. 3,062,032 in Class 3 *for non-medicated skin care preparations; hair care preparations, hair shampoos and conditioners, hair gels, skin soaps, skin lotions, skin masks, skin moisturizers, skin cleansers, hair lotions, sun care lotions, sunscreens, skin creams, hair removing creams, hair styling creams, skin toners, non-medicated lip balms, bath lotions, bath oils, essential oils for personal use, aromatherapy oils.* (See enclosed)

The LATHER logo and the features displayed on our client's packaging are the embodiment of our client's reputation and goodwill and for a third party to use it without its authorization, is tantamount to putting that very reputation and goodwill at risk. As depicted in the attached photographs, the LATHER design consisting of a colored square on the exterior of its products, is quite distinctive.

It has recently come to our attention that Zents is selling the exact same types of products, namely health and beauty aid products, in packaging featuring a colored square quite similar to the LATHER design logo (see attached photographs of Zents products). As a result, we believe that consumers will mistakenly conclude that our client is somehow affiliated or associated with your company. Moreover, your use of a similar design features dilutes consumer recognition of our client's well-known LATHER design in that consumers may not immediately associate the design with our client in the future. In short, your decision to use our client's design will no doubt dilute our client's rights in



BLAKELY SOKOLOFF TAYLOR & ZAFMAN
A LIMITED LIABILITY PARTNERSHIP INCLUDING LAW CORPORATIONS

ZENTS
January 22, 2008
Page 2

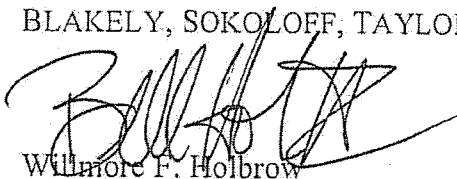
the design and cause people to mistakenly believe that your business is somehow affiliated with, endorsed or licensed by our client. This cannot be tolerated.

Simply stated, the substantial goodwill developed by our client in the logo is an extremely valuable asset, and one that our client is committed to aggressively protecting. Accordingly, we hereby demand, on behalf of our client, that you immediately cease and desist from any and all further use of the similar design displayed on your present packaging. Moreover, we further demand that you provide us with written confirmation of your acquiescence to the above request within ten (10) business days of receipt of this letter. At this juncture, our client will provide you with a limited window of opportunity to take immediate corrective measures and provide us with the assurances requested above. If you immediately comply with our demands, our client may be willing to (i) forego an accounting of damages for past sales, and (ii) allow a reasonable period of time for you to phase out use of the logo. If you refuse, our client will be less conciliatory.

We look forward to hearing from you within the stated deadline. We trust you respect the intellectual property rights of others and that there will be no need for legal proceedings to abate the subject conduct.

Very truly yours,

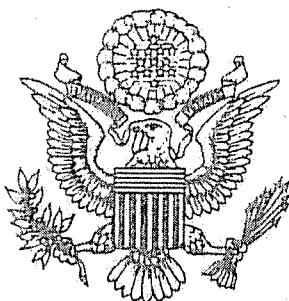
BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN, LLP



Willmore F. Holbrow

WFHIII/mp
cc: Lather, Inc.

The United States of America



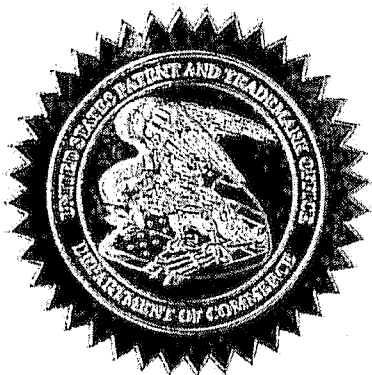
CERTIFICATE OF REGISTRATION
PRINCIPAL REGISTER

The Mark shown in this certificate has been registered in the United States Patent and Trademark Office to the named registrant.

The records of the United States Patent and Trademark Office show that an application for registration of the Mark shown in this Certificate was filed in the Office; that the application was examined and determined to be in compliance with the requirements of the law and with the regulations prescribed by the Director of the United States Patent and Trademark Office; and that the Applicant is entitled to registration of the Mark under the Trademark Act of 1946, as Amended.

A copy of the Mark and pertinent data from the application are part of this certificate.

To avoid CANCELLATION of the registration, the owner of the registration must submit a declaration of continued use or excusable non-use between the fifth and sixth years after the registration date. (See next page for more information.) Assuming such a declaration is properly filed, the registration will remain in force for ten (10) years, unless terminated by an order of the Commissioner for Trademarks or a federal court. (See next page for information on maintenance requirements for successive ten-year periods.)



Jon W. I. Dudas

Director of the United States Patent and Trademark Office

Int. Cl.: 3

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

United States Patent and Trademark Office

Reg. No. 3,062,032

Registered Feb. 28, 2006

TRADEMARK
PRINCIPAL REGISTER



LATHER, INC. (CALIFORNIA CORPORATION)
76 NORTH FAIR OAKS AVENUE
PASADENA, CA 91103

FOR: NON-MEDICATED SKIN CARE PREPARATIONS; HAIR CARE PREPARATIONS, HAIR SHAMPOOS AND CONDITIONERS, HAIR GELS, SKIN SOAPS, SKIN LOTIONS, SKIN MASKS, SKIN MOISTURIZERS, SKIN CLEANSERS, HAIR LOTIONS, SUN CARE LOTIONS, SUNSCREENS, SKIN CREAMS, HAIR REMOVING CREAMS, HAIR STYLING CREAMS, SKIN TONERS, NON-MEDICATED LIP BALMS, BATH LOTIONS, BATH OILS, ESSENTIAL OILS FOR PERSONAL USE, AROMATHER-

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

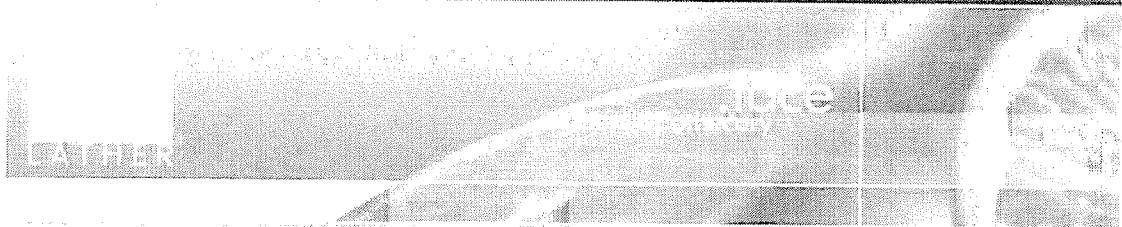
FIRST USE 1-0-1999; IN COMMERCE 1-0-1999.

OWNER OF U.S. REG. NOS. 2,553,156, 2,861,919 AND OTHERS.

THE MARK CONSISTS OF A SQUARE DESIGN WITH THE WORD LATHER AT ITS BASE.

SER. NO. 76-640,026, FILED 6-6-2005.

JUDITH HELFMAN, EXAMINING ATTORNEY

[home](#)[about us](#)[resources](#)[press](#)[hotel](#)[wholesale](#)[contact](#)[login](#)[view cart](#)[face](#)[body](#)[treatment](#)[hair](#)[men](#)[aromatherapy](#)[soap](#)[gift ideas](#)[accessories](#)[baby](#)

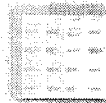
Items: 0

Total: \$0.00

sweet almond exfoliating creme

This crème-based, skin smoothing facial treatment contains natural bamboo and jojoba beads which gently exfoliate away dead surface cells, revitalizing the skin and revealing a glowing complexion. Sweet almond oil conditions and softens the skin, while Kaolin (white) clay absorbs excess oil and draws out impurities. Rosehip oil is rich in Vitamin C, providing antioxidant protection and improving skin texture. Ivy extract, balm mint extract and bitter almond oil create the aroma of well-being and relaxation for the skin. This scrub is gently enough for dry and sensitive skin types.

Use: Apply to clean, damp skin with fingers or a soft facial brush. Gently massage in a circular motion, then remove with warm water. Use 1 - 2 times weekly, as needed.



LATHER Face Chart

Click here to find out more about choosing the right LATHER product for your skin type.



Price 2 oz. (\$23.00)

Quantity

☐ Ingredients☐ E-mail to a friend

[home](#)[about us](#)[resources](#)[press](#)[hotel](#)[wholesale](#)[contact](#)[login](#)[view cart](#) 

body
modern apothecary

[face](#)[body](#)[treatment](#)[hair](#)[men](#)[aromatherapy](#)[soap](#)[gift ideas](#)[accessories](#)[baby](#)

Items: 0

Total: \$0.00

orange blossom hydrating body mist *NEW*

This light and silky body spray gently softens and refreshes skin with nourishing avocado oil, algae extract and borage seed oil. Aromatic orange blossom (neroli) oil immediately soothes dry, sensitive or irritated skin.

Use: Spritz on damp skin to moisturize after bathing, to soothe parched skin after sun exposure or whenever extra moisture is needed.

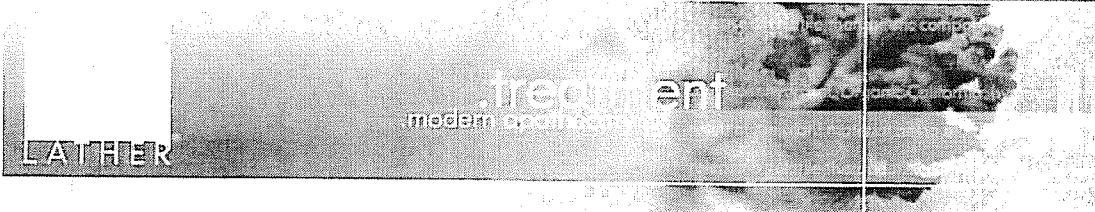


Price 5 oz (\$14.00)

Quantity

[Ingredients](#)[E-mail to a friend](#)

[home](#)
[about us](#)
[resources](#)
[press](#)
[hotel](#)
[wholesale](#)
[contact](#)
[login](#)
[view cart](#)




- face
- body
- treatment
- hair
- men
- aromatherapy
- soap
- gift ideas
- accessories
- baby

Items: 0

Total: \$0.00

lip protector SPF 15 - spearmint & tea tree *NEW*

This protective lip balm contains broad spectrum sun protection as well as soothing and moisturizing oils to keep lips hydrated and prevent cracking and chapping. Formulated with royal jelly rich in B-vitamins, minerals and amino acids, and pure beeswax to form a long-lasting barrier against the elements. The combination of spearmint and tea tree oils contributes a cooling and refreshing scent and flavor.



Price 0.15 oz. (\$6.50)

Quantity 1

Add



Ingredients

E-mail to a friend

Back

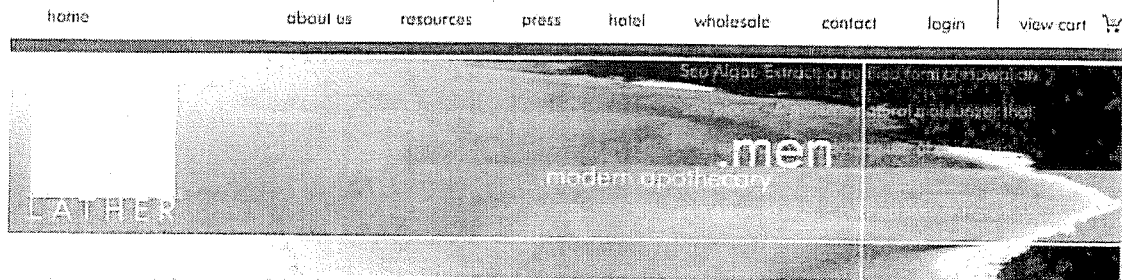
Proceed to Checkout

you may also want to consider:

	mint thyme moisturizer	\$18.00	Quantity
	lip protector SPF 15 - unscented *NEW*	\$6.50	Quantity

Search

Search



- ☐ face
- ☐ body
- ☐ treatment
- ☐ hair
- ☐ men
- ☐ aromatherapy
- ☐ soap
- ☐ gift ideas
- ☐ accessories
- ☐ baby

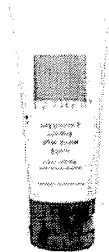
Search

Search

Items: 0 Total: \$0.00

peppermint cooling after shave balm

This alcohol-free, botanical after shave balm effectively soothes freshly shaved skin, while giving skin a rejuvenating "boost" from cooling peppermint oil. Shea butter and glycerin replenish moisture and help to reduce redness and razor burn, while aloe vera and allantoin provide calming relief to irritated skin. Tea tree oil purifies skin and helps to heal nicks and breakouts.



Price 2 oz. (\$18.00)

Quantity ☐ Ingredients☐ E-mail to a friend

you may also want to consider:



almond shave crème

\$19.00

Quantity



citrus soothing pre-shave oil

\$19.00

Quantity

Z E N T S

[PRODUCTS](#)[RETAILERS](#)[SHOPPING CART](#)[ABOUT US](#)[NEWS](#)[HELP](#)

HAND AND SHOWER WASH

Apply Zents Body Wash for lavishly clean, luxuriously moisturized skin. Rich shea butter permeates the skin's surface for a deep, noticeable softness. Herbal extracts of chamomile and St. John's Wort soothe tired skin while green tea extract detoxifies and protects. Made with the finest ingredients, Zents elegantly scented body wash instantly replenishes and restores the skin.



AVAILABLE IN TEN PURE SCENTS : CLICK THE SQUARES



SUN

ATTRIBUTES

BLEND: Warm and sensuous

NOTES: Vanilla, sweet orange, sandalwood, pink grapefruit

STYLE: Comforting and gentle

SIZE: 8 oz

PRICE: \$16.00

[CLICK FOR THE STORY BEHIND THE SCENT](#)[SAMPLE THE SCENTS](#)[BUY](#)

: Welcome to LATHER :

http://www.lather.com/scripts/prodView.asp?idproduc...

- ☐ face
- ☐ body
- ☐ treatment
- ☐ hair
- ☐ men
- ☐ aromatherapy
- ☐ soap
- ☐ gift ideas
- ☐ accessories
- ☐ baby

Search

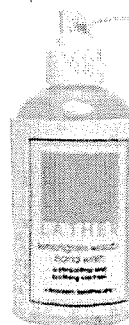
Search

lemongrass wasabi hand wash

Drawing on the natural antiseptic properties of wasabi, this hand wash combines extracts of this potent plant with stimulating lemongrass essential oil for a luxurious, liquid formula that cleanses, soothes and moisturizes. Using very mild cleansing agents, this gentle foaming cleanser is formulated to be non-drying and non-irritating. Rich natural oils protect and condition the skin, leaving hands incredibly soft and silky smooth.

Use: Apply to wet hands and work into lather. Rinse with warm water.

Items: 0 Total: \$0.00



Price 8.5 ounces (\$12.00)

Quantity 1 Add

Back

Proceed to Checkout

① Ingredients

② Product Press

③ E-mail to a friend

you may also want to consider:



AHA hand creme with evening
primrose 5.5 oz

\$18.00

Quantity



mandarin wasabi hand wash

\$12.00

Quantity

Page 1 of 2 [Back | Next]

Sign up to receive discounts and special offers

Enter email

Sign up

Term & Conditions. | Privacy Policy

© 2006, LATHER Inc. All rights reserved.

Z E N T S

PRODUCTS

RETAILERS

SHOPPING CART

ABOUT US

NEWS

HELP

LOTION

Each rich ZENTS lotion is highly fragrant with aromatherapeutic floral extracts and essential oils. ZENTS lotions are handmade with the finest ingredients. Use ZENTS lotions in combination with other ZENTS products. contains shea butter, green tea, chamomile & elder flower.

combinations

Try this combination: use your favorite lotion scent after the shower...refresh throughout the day with Zents Body Sprays in the same scent, or a complimentary one!

feedback

"I purchased (Petal) lotion, I love this stuff. I will be a forever wearer of this wonderful lotion and fragrance. WOW!!! Thank you for such a wonderful product."

-Stefanie



AVAILABLE IN TEN PURE SCENTS : CLICK THE SQUARES



SUN

ATTRIBUTES

BLEND: Warm and sensuous

NOTES: Vanilla, sweet orange, sandalwood, pink grapefruit

STYLE: Comforting and gentle

SIZE: 6 oz

PRICE: \$26.00

CLICK FOR THE STORY BEHIND THIS SCENT

SAMPLE THE SCENTS

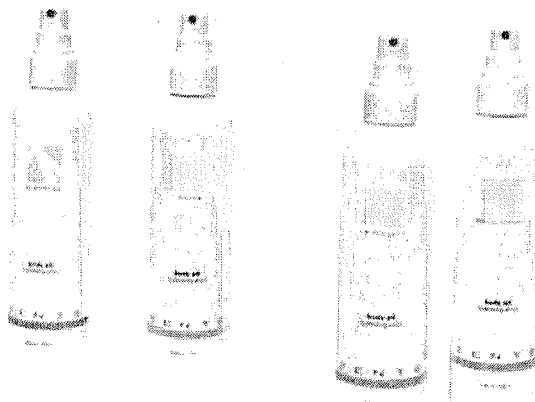
BUY

Z E N T S

[PRODUCTS](#)[RETAILERS](#)[SHOPPING CART](#)[ABOUT US](#)[NEWS](#)[HELP](#)

BODY OIL HYDRATING ELIXIR

This luxurious elixir spray feels light and silky on the skin. Nourishing jojoba, safflower, sunflower, and grapeseed oils give a sexy sheen, leaving skin gorgeously healthy and sublimely soft. Apply all over the body right out of the shower for maximum hydration.



AVAILABLE IN TEN PURE SCENTS : CLICK THE SQUARES



SUN

ATTRIBUTES

BLEND: Warm and sensual

NOTES: Vanilla, sweet orange, sandalwood, pink grapefruit

STYLE: Comforting and gentle

SIZE: 8.4oz

PRICE: \$30.00

[CLICK FOR THE STORY BEHIND THIS SCENT](#)[SAMPLE THE SCENTS](#)[BUY](#)