

UNITED STATES DISTRICT COURT
SOUTHERN DISTRICT OF NEW YORK

COTR INC.,

Plaintiff,

v.

MAKEUP ERASER GROUP, LLC

Defendant.

Civil Action No.

(JURY TRIAL DEMANDED)

COMPLAINT

Plaintiff COTR Inc. (“COTR” or “Plaintiff”), by its attorneys, hereby complains of Defendant Makeup Eraser Group, LLC (“Makeup Eraser” or “Defendant”) and alleges as follows, upon actual knowledge with respect to itself and its own acts, upon information and belief as to all other matters:

INTRODUCTION

1. COTR brings this action seeking a declaratory judgment that COTR’s “The Miracle Makeup Remover Cloth” does not infringe Defendant’s Utility Patent No. 9,609,983 (“the ‘983 patent”) entitled Facial Cleansing Pad.

2. COTR also seeks a declaratory judgment that it does not infringe Defendant’s alleged trademarks, Registration Nos. 4,759,528, 4,759,527 or 4,876,242, nor does it infringe on any alleged trade dress rights asserted by Defendant.

3. COTR also seeks a declaratory judgment that the ‘983 patent is invalid.

4. COTR also seeks a declaratory judgment that Defendant does not have any valid trade dress or trademark rights, and/or does not have rights in the breadth or form that it is asserting.

5. COTR also seeks damages for Defendant's tortious interference with COTR's business relationships.

THE PARTIES

6. COTR is a corporation organized and existing under the laws of the State of Delaware, and having a principal place of business at 37 West 39th Street, Suite 601, New York, New York 10018.

7. Upon information and belief, Makeup Eraser Group, LLC is a corporation organized and existing under the laws of the State of Arizona having a principal place of business at 20783 N 83rd Avenue Suite 105 Peoria, Arizona 85382.

JURISDICTION AND VENUE

8. This is an action arising under the Patent Laws of the United States, 35 U.S.C. §§101 *et seq.*, under the Lanham Act, 15 U.S.C. § 1051, *et seq.*, and the Federal Declaratory Judgment Act, 28 U.S.C. §§ 2201 and 2202.

9. This Court has jurisdiction over the federal claims of this action pursuant to 28 U.S.C. §1331, 28 U.S.C. §1338, and the Declaratory Judgment Act, 28 U.S.C. §§ 2201 and 2202.

10. This Court has personal jurisdiction over Defendant because Defendant has engaged in acts constituting doing business in the State of New York, including in this judicial district. Defendant transacts and does business, including selling and promoting products containing the patented designs that Defendant asserts that COTR has infringed.

11. Venue is proper in this district under 28 U.S.C. §1400(b) in that COTR has been accused of committing acts of infringement in this district, and has a regular and established place of business in this district.

FACTS

12. COTR is a company that sells consumer products.

13. COTR uses the name Modern Millennial for their sales on Amazon.

14. COTR has offered the Miracle Face Erase product at issue in this litigation for sale to customers in the United States. An image of its Miracle Face Erase product is attached hereto as Exhibit 1.

15. Likewise, COTR has registered its trademark “Miracle Face Erase” and received registration with the United States Patent and Trademark Office, Registration No. 5,157,587 for “cloths for removing make-up”.

16. To date, Makeup Eraser has engaged in several communications with COTR in which Makeup Eraser has alleged that COTR’s product infringes Makeup Eraser’s intellectual property rights.

17. Makeup Eraser has alleged that sales of COTR’s product constitutes patent, trademark, and trade dress infringement and has threatened to bring a lawsuit against COTR for the same.

18. As a result of Defendant’s threats of litigation and the circumstances surrounding those threats, an actual, present, and justiciable controversy has arisen between COTR and Makeup Eraser regarding COTR’s sale of its Miracle Face Erase product.

19. Further, Makeup Eraser has interfered with COTR’s sales online, such as, for example, filing a complaint to Amazon, complaint ID number 913557131, alleging that COTR’s product infringes upon Makeup Eraser’s intellectual property rights.

**PLAINTIFF'S NON-INFRINGEMENT OF
DEFENDANT'S ALLEGED PATENT**

20. Makeup Eraser Group, LLC is listed as the owner of the '983 patent. A copy of the '983 patent is attached as Exhibit 2.

21. The '983 patent is legally limited to the scope of the patent claims set forth therein.

22. COTR's product does not infringe the claims of the '983 patent because the accused product does not fall within the scope of the claims.

**INVALIDITY OF
DEFENDANT'S ALLEGED PATENT**

23. The '983 patent is invalid for failure to comply with one or more of the conditions for patentability set forth in the Patent Laws of the United States Code, Title 35 at least in Sections 102, 103, and 112.

24. The '983 patent should be declared invalid due to the fact that, *inter alia*, it is anticipated by and/or obvious over the prior art under Sections 102 and 103 respectively, and/or is invalid under the provisions of Section 112, including, but not limited to, indefiniteness.

**PLAINTIFF'S NON-INFRINGEMENT OF
DEFENDANT'S ALLEGED TRADEMARKS**

25. Makeup Eraser Group, LLC is listed as the owner of the Makeup Eraser stylized mark, trademark registration no. 4,759,528. A copy of the trademark is attached as Exhibit 3.

26. Makeup Eraser Group, LLC is listed as the owner of the Makeup Eraser word mark, trademark registration no. 4,759,527. A copy of the trademark is attached as Exhibit 4.

27. Makeup Eraser Group, LLC is listed as the owner of a cleansing pad design, trademark registration no. 4,876,242. A copy of the trademark is attached as Exhibit 5.

28. Makeup Eraser disclaimed the word “makeup” in both of the Makeup Eraser trademarks, namely, registration nos. 4,759,528 and 4,759,527.

29. Likewise, the word “erase” or “eraser” is very common in the marks in international class 3 relating to cosmetic products and cosmetic removal products.

30. Further, the cleansing pad design in trademark registration no. 4,876,242 is not the same design which COTR’s product takes.

31. COTR is the licensee of the Miracle Face Erase word mark, trademark registration no. 5,157,587. A copy of the trademark is attached as Exhibit 6.

32. COTR has been lawfully using its Miracle Face Erase trademark on its cleansing cloth products.

33. Plaintiff COTR’s “Miracle Face Erase” is not confusingly similar with Defendant’s “Makeup Eraser.” For example, “Miracle Face Erase” does not contain the word “makeup” at all. Additionally, “Miracle Face Erase” is consists of three words and not two unlike Makeup Eraser.

34. In fact, the only term that Defendant could assert is “erase” and “eraser.” However, Defendant does not have exclusive rights to the use of the word “erase” or “eraser.” Those words are commonly used by third parties in the marketplace in connection with the same, and related, goods and services.

35. Based on, *inter alia*, the applicable facts of the parties’ respective usages, third party trademark usage in the marketplace, and the meaning and use of the terms in question, there is no likelihood of confusion under the applicable legal standards.

36. COTR's product and the use of its mark Miracle Face Erase does not infringe on any of Makeup Eraser's alleged trademarks.

**PLAINTIFF'S NON-INFRINGEMENT OF
DEFENDANT'S ALLEGED TRADE DRESS**

37. Makeup Eraser alleges that it has certain trade dress rights in the look of its product.

38. Under the applicable legal standards, COTR disputes that Makeup Eraser has the alleged trade dress rights in the breadth and/or form that it is trying to assert.

39. Moreover, this trade dress, if any, is limited to the exact look and design of Makeup Eraser's product, or a confusingly similar version thereof.

40. COTR's product and packaging is not sufficiently similar to Makeup Eraser's product and packaging such that there would be confusion.

41. For example, the boxes of the various packaging are different sizes and shapes from each other.

42. The font and verbiage on the two packaging are different as well.

43. The product content within the packages are different, as COTR includes pairings and various products within the same box.

44. Likewise, the product sold by COTR is different in shape and appearance than Makeup Eraser's product. It is also made up of a different fiber content and includes tabs and loops which are not found in Makeup Eraser's product.

45. COTR's product and packaging is different overall from Makeup Eraser's product and packaging.

46. COTR's product does not infringe Makeup Eraser's trade dress rights, if any.

**DEFENDANT'S TORTIOUS INTERFERENCE WITH
PLAINTIFF'S BUSINESS RELATIONSHIP**

47. Plaintiff COTR and Defendant Makeup Eraser are competitors in the field of makeup remover products.

48. Among other vendors, Plaintiff sells its product on Amazon with which it has a business relationship.

49. Defendant has contacted Amazon and halted all sales of COTR's Miracle Face Erase product.

50. Defendant's actions were intended to interfere with Plaintiff's sales and its relationship with Amazon.

51. Defendant has intentionally intended to interfere, and has interfered, with Plaintiff's relationship with its vendor.

52. Defendant's interference was done with malice.

53. Defendant's interference was done without lawful justification.

54. Defendant's interference has caused damage to Plaintiff COTR.

COUNT I

(Declaration of Non-Infringement of Defendant's Alleged Patent)

55. COTR repeats and re-alleges each and every allegation set forth in the preceding paragraphs of this Complaint.

56. Defendant has asserted that COTR's sale of its Miracle Face Erase product infringes the '983 patent and has threatened to bring a lawsuit against COTR. An actual, present, and justiciable controversy has arisen between Defendant and COTR concerning COTR's use and sale of its make-up remover cloth.

57. COTR seeks declaratory judgment that its manufacture, use, offer for sale, and/or sale of COTR's Miracle Face Erase product does not infringe on Makeup Eraser's alleged utility patent, and does not otherwise violate any of Defendant's patent rights under federal law including, but not limited to, 35 U.S.C. §§ 101, *et seq.*

COUNT II

(Declaration of Invalidity of Defendant's Alleged Patent)

58. COTR repeats and re-alleges each and every allegation set forth in the preceding paragraphs of this Complaint.

59. The '983 patent for a facial cleansing pad is invalid under 35 USC §102, 103, and/or 112 of the Patent Laws.

60. COTR seeks declaratory judgment that the '983 patent is invalid for any and all grounds of invalidity available under federal law, the Patent Act, including, but not limited to, 35 U.S.C. §§ 102, 103, and 112.

61. COTR reserves the right to amend its allegations and/or this Complaint to add any further defenses once further discovery has been conducted in this matter.

COUNT III

(Declaration of Non-Infringement of Defendant's Alleged Trademarks)

62. COTR repeats and re-alleges each and every allegation set forth in the preceding paragraphs of this Complaint.

63. Defendant has asserted that COTR's sale of its Miracle Face Erase product, infringes on its trademarks, namely, Trademark Registration Nos. 4,759,528, 4,759,527, and 4,876,242 and has threatened to bring a lawsuit against COTR. An actual, present, and

justiciable controversy has arisen between Defendant and COTR concerning COTR's use and sale of its make-up remover cloth.

64. COTR seeks declaratory judgment that its manufacture, use, offer for sale, and/or sale of COTR's Miracle Face Erase product does not infringe on Makeup Eraser's alleged trademarks, and does not otherwise violate any of Defendant's trademark rights under the Lanham Act.

COUNT IV

(Declaration of Non-Infringement of Defendant's Alleged Trade Dress)

65. COTR repeats and re-alleges each and every allegation set forth in the preceding paragraphs of this Complaint.

66. Defendant has asserted that COTR's sale of its Miracle Face Erase product, infringes on its Trade Dress and has threatened to bring a lawsuit against COTR. An actual, present, and justiciable controversy has arisen between Defendant and COTR concerning COTR's use and sale of its make-up remover cloth.

67. COTR seeks declaratory judgment that its manufacture, use, offer for sale, and/or sale of COTR's Miracle Face Erase product does not infringe on Makeup Eraser's alleged Trade Dress, and does not otherwise violate any of Defendant's Trade Dress rights under the Lanham Act.

COUNT V

(Declaration of Invalidity of Defendant's Alleged Trademarks and Trade Dress Rights)

68. COTR repeats and re-alleges each and every allegation set forth in the preceding paragraphs of this Complaint.

69. Defendant has asserted that COTR's sale of its Miracle Face Erase product, infringes on its alleged trade dress, and on its trademarks, namely, Trademark Registration Nos. 4,759,528, 4,759,527, and 4,876,242 and has threatened to bring a lawsuit against COTR. An actual, present, and justiciable controversy has arisen between Defendant and COTR concerning COTR's use and sale of its make-up remover cloth.

70. COTR seeks declaratory judgment that Defendant does not have trade dress and/or trademark rights in the breadth and/or form that it is alleging and/or that any such rights are invalid under the Lanham Act and any and all applicable law.

COUNT VI

(Declaration of Lack of Damages to Defendant)

71. COTR repeats and re-alleges each and every allegation set forth in the preceding paragraphs of this Complaint.

72. COTR seeks declaratory judgment that Makeup Eraser has no claim for monetary damages from COTR's alleged activities because the patent asserted by Makeup Eraser is invalid and is not infringed.

73. COTR likewise seeks declaratory judgment that Makeup Eraser has no claim for monetary damages from COTR's alleged activities because the trademarks and trade dress asserted by Makeup Eraser are invalid and/or do not have the scope asserted, and are not infringed.

COUNT VII

(Defendant's Intentional Interference with Plaintiff's Business Relationship)

74. COTR repeats and re-alleges each and every allegation set forth in the preceding paragraphs of this Complaint.

75. Plaintiff has a protectable right in its relationship with Amazon.

76. Defendant has intentionally interfered with that right, and has done so with malice.

77. Defendant interfered in order to cause damage to Plaintiff COTR's relation business relationship with its vendor Amazon.

78. Defendant's interference has caused a loss to COTR.

79. Defendant's actions constitute tortious interference with business relationship.

PRAYER FOR RELIEF

WHEREFORE, pursuant to the Patent Act, 35 U.S.C. §§ 101 and 171, *et seq.*, the Lanham Act, 15 U.S.C. § 1051, *et seq.* and the Federal Declaratory Judgment Act, 28 U.S.C. §§ 2201 and 2202, and any and all other applicable law, COTR prays for relief as follows:

A. Judgment declaring that COTR and its affiliates and related companies and their customers and suppliers have the right to use, sell, offer for sale the Miracle Face Erase product, and that Plaintiff COTR's product does not infringe Defendant's patent rights, if any.

B. Judgment declaring that Makeup Eraser's '983 patent entitled "Facial Cleansing Cloth" is invalid.

C. Judgment declaring that COTR and its affiliates and related companies and their customers and suppliers have the right to use, sell, offer for sale the Miracle Face Erase product,

and that Plaintiff COTR's product does not infringe Defendant's trademark rights, if any.

D. Judgment declaring that COTR and its affiliates and related companies and their customers and suppliers have the right to use, sell, offer for sale the Miracle Face Erase product, and that Plaintiff COTR's product does not infringe Defendant's trade dress rights, if any.

E. Judgment declaring that Makeup Eraser does not have trademark and trade dress rights of the breadth and/or form that it is asserting and/or that any such rights are invalid.

F. Judgment awarding COTR its damages for Defendant's tortious interference with COTR's business relationship.

G. Judgment awarding COTR its costs and Attorney's fees under 15 U.S.C. § 1117 and 35 U.S.C § 285, and any other applicable laws.

H. Judgment awarding such other relief as this Court may deem just and proper.

Dated: June 16, 2017

/s/ Morris E. Cohen
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