

**IN THE UNITED STATES DISTRICT COURT
FOR THE NORTHERN DISTRICT OF ILLINOIS, EASTERN DIVISION**

CONAIR CORPORATION,

Plaintiff,

v.

De Bin Liu d/b/a Barberium's,

Defendant.

CASE No. 21 cv 1663

The Hon. Sara L. Ellis

JURY TRIAL DEMANDED

**COMPLAINT FOR DESIGN PATENT INFRINGEMENT
AND TRADE DRESS INFRINGEMENT**

Plaintiff Conair Corporation ("Conair") complains of De Bin Liu doing business as Barberium's and Barberiums (collectively "Barberium's") as follows:

JURISDICTION AND VENUE

1. Jurisdiction exists under 28 U.S.C. §§ 1331 and 1338(a) because this is an action for infringement of Conair's patent rights and for violation of Section 43(a) of the Lanham Trademark Act, 15 U.S.C. § 1125(a).

2. Defendant is subject to personal jurisdiction in Illinois and in this judicial district and division because it has transacted business here by selling, offering to sell or distributing hair-care products (including the GoldLUX Pro personal trimmer) that violates Conair's intellectual property rights. Defendant is also reaching out to do business with Illinois residents by operating one or more commercial, interactive Internet Stores through which Illinois residents can purchase infringing products. Defendant has targeted sales from Illinois residents by operating an online store that offers shipping to Illinois, and upon information and belief, has sold infringing products to residents of Illinois. The Defendant is also committing tortious acts in Illinois. Upon information and belief, Barberium's and/or its owners reside in this District.

3. Venue is proper under the general federal venue statute, 28 U.S.C. § 1391(d), and under the specific venue provision relating to patent-infringement cases, 28 U.S.C. § 1400(b).

PARTIES

4. Conair is a Delaware corporation headquartered in and has sales and marketing offices in Stamford, Connecticut. Conair owns and has standing to sue for infringement of United States Patent No.: D905,345, entitled “Hair Shaver with Adjustment Tool.”

5. On information and belief, Barberium’s is an Illinois person or entity doing business under the Barberium’s name, somewhere in the greater-Chicago area. Barberium’s has previously and is presently making, using, selling, offering for sale, and/or importing into the U.S. personal trimmers that infringe the ’345 patent (hereinafter also referred to as the “patent-in-suit”). Barberium’s has infringed the patent-in-suit either directly or through acts of contributory infringement or inducement in violation of 35 U.S.C. § 271 and 289.

6. Barberium’s has taken active steps at concealment of its legal identity to avoid or delay actions such as this one. Barberium’s operates a superficially slick-looking website, which closer scrutiny shows the shady and unlawful nature of its business. Barberium’s provides only generic contact information by way of an “info@” email address and a single contact phone number with a Chicago-based “773” area code. Terms, conditions and privacy policy links do not reveal the name of the governing entity. Barberium’s uses a privacy service to conceal its identity and contact information through its domain name registration. Further, although it has misused the “Circle R” in promotional materials (implying that it owns a valid United States Trademark Registration (see below)), the Federal Register has no record of any such registration, and thus no identifiable information about the Defendant Barberium’s.

7. Despite his steps of active concealment, on information and belief, De Bin Liu is an individual residing at 3318 South Hoyne Avenue in Chicago and is the sole owner and operator of Barberiums.



(available at <https://www.instagram.com/p/CFZ4erQFLem/?hl=en>) (last visited Mar. 24, 2021).¹

8. Defendant Barberium's operates its online storefront through a third-party, Shopify, Inc. According to Barberium's terms of service, "Our store is hosted on Shopify Inc. They provide us with the online e-commerce platform that allows us to sell our products and services to you."

9. Barberium's and Shopify are contractually bound. Barberium's purchases services from Shopify. Specifically, under its contract with Shopify, Barberium's licenses Shopify's "subscription-based software [, which ...] allows anyone to set up an online store and sell their products." (<https://www.shopify.com/blog/what-is-shopify>). According to Shopify's own website:

Out of the box, Shopify is your one-stop-shop to run your business: you get a storefront, a payment processor, a shipping partner, a back office, and marketing headquarters, all in one. These are the core functions of running a business. (<https://www.shopify.com/blog/what-is-shopify#2>)

10. Upon information and belief, Barberium's processes payments for purchase of its infringing products through Shopify.

¹ Unless otherwise noted, each cited URL was last visited on the filing date of the complaint.

BACKGROUND

11. Conair owns the '345 patent and has worked diligently to commercialize the inventions claimed within it. Conair designer Vito Carlucci perfected a sleek, consumer-friendly ornamental design embodied in the '345 patent as shown in one of the patent figures, below (N.B. “ghosting” or dotted lines indicate matter not part of the design patent claim):

U.S. Patent Dec. 15, 2020 Sheet 2 of 6 US D905,345 S

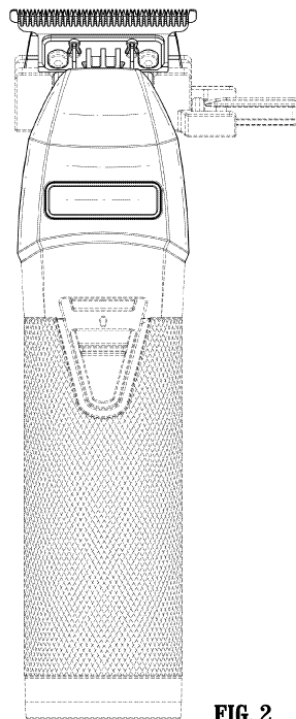


FIG. 2

12. As a result of Conair’s commercialization efforts, Conair has experienced dramatic commercial success worldwide with its embodiments of this patent – the BabyliSSPRO® Outlining Trimmer. Conair’s success has attracted countless knock-off efforts and attempts to free ride on Conair’s success. Defendant is now among them.

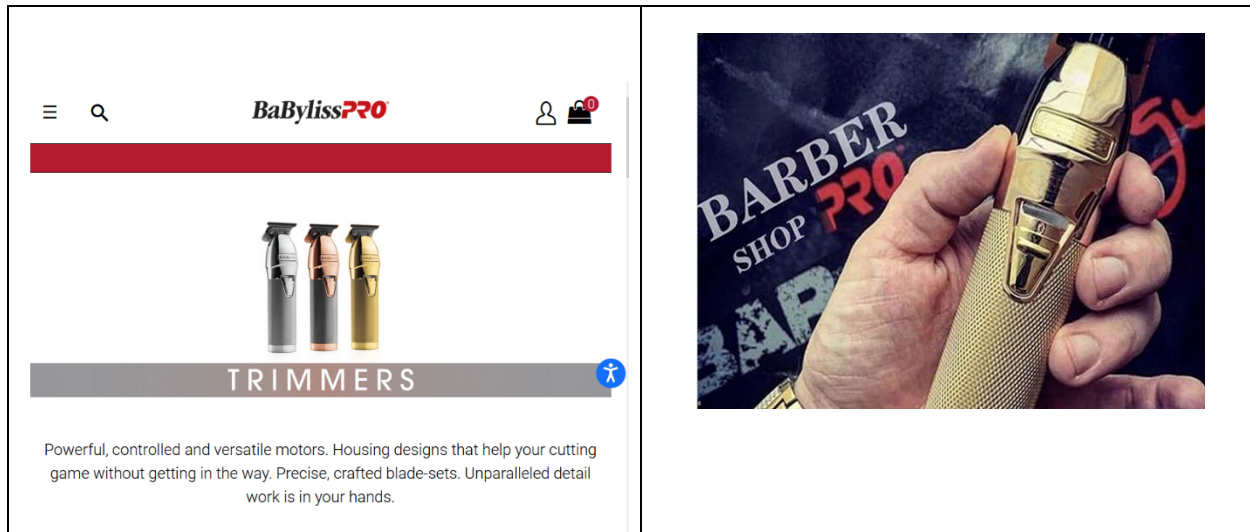
13. BabyliSSPRO® Outlining Hair Trimmers target the men’s grooming segment, with particular focus on barbers and hair care professionals, though their appeal is not limited to men or professionals. Conair has used a particular trade dress for the BabyliSSPRO® Outlining Hair Trimmers consistently in its marketing, including on its website located on the internet at <https://babyliSSpro.com/trimmers>. It is currently available in a variety of outlooks, including but

not limited to black, rose, silver and gold. Among all of the diverse BabylissPRO® products, the gold version of this product is what we have placed as the first item shown on the opening webpage at www.babylisspro.com.

14. Defendant Barberium's advertises and sells infringing hair-styling devices on *at least* the following website: <https://barberiums.com/products/the-professional-barber-hair-clipper> and also promotes its infringing products on Instagram and Facebook, among other websites. To an ordinary observer, those accused devices appear substantially and confusingly similar to claimed aspects of Conair's patented design, and to Conair's commercial product:



15. Barberium's also promotes its outlining trimmer in ways that mimic Conair's marketing and promotion, including copying its product naming convention (e.g., Conair's "GOLDFX" vs. Barberium's "GoldLUX"), and also copies aspects of Conair's stylized "PRO" logo in its marketing materials as shown below:



16. Moreover, Barberium's has also copied and reproduced as its own, marketing materials that Conair has created for sales and marketing. Specifically, Conair uses the image below left to market and sell the BaBylissPRO GoldFX outline trimmer, while Barberium's uses the image below right to market its own knock-off product:



17. Conair owns distinctive, aesthetic, non-functional trade dress in its BabylistPRO® Outlining Trimmers. Conair has used and highlighted this trade dress consistently in its marketing, including on its website located on the Internet, *e.g.*, at <https://babylistpro.com/FX787S.html>.

18. The trade dress of the BabylistPRO® Outlining Trimmers is recognizable by the first-of-its-kind exposed “T- Blade” with a 360 degree skeleton housing, knurled barbell grip, 360 degree skeleton housing, the Logo plate rounded corner rectangle and positioning, the shape of the bottom cap, the chevron shape of the on/off switch and the shape of the upper housing, for example.

19. The BabylistPRO® Outlining Trimmer trade dress symbolizes the quality of Conair products, and has become distinctive to Conair through widespread use and advertising, which has exposed it to many people, especially in the hair-care industry and its important consumer subgroups (*e.g.*, barbers). Conair has used the BabylistPRO® Outlining Trimmer trade dress in a consistent and continuous fashion in commerce through its website, in print marketing material, and on the websites and marketing material of its authorized dealers throughout the United States.

20. The BabylistPRO® Outlining Trimmer trade dress is aesthetic and non-functional, and through consistent and continuous use it has come to identify the Conair products, and the public recognizes the trade dress and associates it with Conair and its products. The trade dress has become an asset of substantial value and is strongly associated with a single product line and source, namely the Conair BabylistPRO® Outlining Trimmer products.

21. The products have been featured in numerous publications since release, featured on countless YouTube reviews, and shared widely by Conair and third parties on social media. Conair’s products won the Rum Barber’s Trimmer of the Year award in both 2019 and 2020.

22. The BabylistPRO® Outlining Hair Trimmers are some of Conair’s most successful products, in terms of sales, popularity and brand loyalty among its users. Conair has invested millions in research, development, marketing, sales and brand awareness among its users. Conair

has experienced dramatic commercial success worldwide with these products. The Conair products thus have a trade dress that has acquired a secondary meaning.

23. As can be seen in the photographs above taken from the parties' respective web sites, Defendant has copied and used the BabyLissPRO® Outlining Trimmer trade dress in connection with its advertising and marketing of the confusingly similar accused devices in interstate commerce with the intention of misleading, deceiving or confusing consumers as to the origin of the accused products while trading on Conair's reputation and good will.

24. The infringement by Defendant of the BabyLissPRO® Outlining Trimmer trade dress is likely to cause confusion, deception, and mistake among consumers and potential consumers of the Conair product.

COUNT I **DESIGN PATENT INFRINGEMENT**

25. Plaintiff repeats and realleges the allegations contained in paragraphs 1 through 24 of this complaint as if fully set forth herein.

26. Defendant has infringed and continues to infringe the '345 patent either directly or indirectly through acts of contributory infringement or inducement in violation of 35 U.S.C. §§ 271 and 289 by making, using, selling, importing and/or offering to sell infringing products, namely the Fineness hair-curling device. Additional infringing models may be identified through discovery.

27. Defendant's infringement, contributory infringement and/or inducement to infringe has injured Conair and it, therefore, is entitled to recover damages adequate to compensate it for such infringement, but in no event less than a reasonable royalty. On information and belief, Defendant has had knowledge of the '345 patent, and its infringement has been willful.

28. Defendant's infringement, contributory infringement and/or inducement to infringe has injured and will continue to injure Conair, unless and until this Court enters an injunction, which prohibits further infringement and specifically enjoins further manufacture, use, sale, importation and/or offer for sale of products or services that come within the scope of the '345 patent.

COUNT II
FEDERAL TRADE DRESS INFRINGEMENT/UNFAIR COMPETITION

29. Plaintiff repeats and realleges the allegations contained in paragraphs 1 through 24 of this complaint as if fully set forth herein.

30. Defendant's activities complained of herein constitute infringement of Conair's trade dress and unfair competition in violation of 15 U.S.C. § 1125(a) to the injury and detriment of Plaintiff.

31. As a direct and proximate result of Defendant's infringement, Conair has suffered and will continue to suffer loss of income, profits and good will and defendants will continue to unfairly acquire income, profits, and good will.

JURY DEMAND

Pursuant to Rule 38(b) of the Federal Rules of Civil Procedure, Conair requests a trial by jury on all issues presented that can properly be tried to a jury.

PRAYER FOR RELIEF

THEREFORE, Conair ask this Court to enter judgment against Defendant and against its subsidiaries, affiliates, agents, servants, employees and all persons in active concert or participation with them, including Shopify, granting the following relief:

A. An injunction permanently prohibiting further infringement, inducement and contributory infringement of the patent-in-suit;

B. An injunction permanently prohibiting further infringement of Conair's trade dress;

C. An award of damages adequate to compensate Conair for the infringement that has occurred, together with prejudgment interest from the date infringement began;

D. All other damages permitted by 35 U.S.C. § 284;

E. Additional damages as expressly provided for in the case of a design patent under 35 U.S.C. § 289;

F. Additional damages as expressly provided for in the case of Lanham Act violations under 15 U.S.C. §§ 1116-18, including a permanent injunction enjoining Defendant's acts of trade

dress infringement; recovery of Defendant's profits, any damages sustained by Plaintiffs, the costs of the action; and destruction of the infringing articles;

G. A finding that this case is exceptional and an award to Conair of its attorneys' fees and costs as provided by 35 U.S.C. § 285;

H. An award of costs; and

I. Such other and further relief as this Court or a jury may deem proper and just.

Dated: July 9, 2021

Respectfully submitted,

/s/ Michael La Porte

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