

**UNITED STATES DISTRICT COURT  
DISTRICT OF MINNESOTA**

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RENPURE LLC,  
a Nevada Limited Liability Corporation,

Court File No. \_\_\_\_\_

Plaintiff,

vs.

REN LIMITED,  
a United Kingdom Corporation,

Defendant.

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**COMPLAINT FOR DECLARATORY JUDGMENT, CANCELLATION  
OF A REGISTERED TRADEMARK AND DAMAGES**

Plaintiff, Renpure LLC., by and through undersigned counsel, for its  
Complaint against Ren Limited, states as follows:

1. This is an action for declaratory judgment under the Federal Declaratory Judgment Act, 28 U.S.C. §§2201 and 2202, for cancellation of the “REN” trademark registration number 2,718,853, pursuant to 15 U.S.C. §1064(3) and §1119, and for damages pursuant to 15 U.S.C. §1120.
2. This Court has subject matter jurisdiction over Plaintiff’s federal claims pursuant to 15 U.S.C. §1121, and 28 U.S.C. §§1331 and 1338 in that this Complaint raises federal questions arising under the Lanham Act, 15 U.S.C. §1125, and under 15 U.S.C. §1119.
3. Venue is proper in this judicial district under 28 U.S.C. §1391(b)(1) in that Defendant, upon information and belief, is subject to personal jurisdiction in this district

and is thus deemed to reside here; and under 28 U.S.C. §1391(d), as Defendant is an alien corporation.

4. Defendant is subject to personal jurisdiction in Minnesota pursuant to Minnesota's long arm statute MN Statute 116B.11, as Defendant transacts business at least with Sephora stores located within the State of Minnesota.

#### THE PARTIES

5. RENPURE LLC ("Renpure") is a limited liability corporation organized under the laws of Nevada with its principal place of business at 720 Old Shady Oak Road, Eden Prairie, MN 55344.

6. REN LIMITED ("Defendant") is a company organized under the laws of the United Kingdom, with its principal place of business at 65 New Cavendish Street, London, England W1G 7LS.

#### THE FACTS

7. Defendant is the owner of a trademark "REN" registered in Great Brittan and Northern Ireland on May 21, 1999. Exhibit 1.

8. On May 27, 2003, based upon the foregoing registration, Defendant caused to be registered in the United States the trademark "REN", Registration No. 2,718,853. Exhibit 2.

9. The registration of the "REN" trademark in the United States was based upon the following description of goods: "Cosmetics; cosmetic preparations for skin care; cosmetic kits comprising any combination of lip gloss, lipstick, lip-liner, eye-shadow, mascara, eye-liner and/or blusher; skincare lotions, creams and preparations; toiletries, namely,

perfumes, body washes, cleansers and body sprays; perfumery; essential oils for personal use; antiperspirants, deodorants and body sprays; lipsticks and lip balms; bath preparations, namely, bath crystals and oils; soap; cotton wool for cosmetic purposes; cotton sticks for cosmetic purposes; dentifrices; denture cleaning preparations; mouthwashes; depilatory preparations; nail care preparations; nail polish; nail polish removers; false nails; false eyelashes; emery boards; bleaching preparations for cosmetic purposes; hair lotions, hair mousses, hair gels, hair waxes and hair sprays; hair colorants and dyes; shaving preparations; after-shave lotions; sun-tanning preparations; fake tanning preparations; talcum powder". Exhibit 2.

10. On or about July 23, 2009, Defendant caused to be filed with the United States Patent and Trademark Office ("USPTO") a Combined Declaration of Use and Incontestability Under Sections 8 & 15. Exhibit 3.

11. The Declaration (exhibit 3) was signed by the CEO of Defendant, Antony Buck, below the following language:

"The undersigned, being hereby warned that willful false statements and the like are punishable by fine or imprisonment, *or* both, under Section 1001 of Title 18 of the United States Code, and that such willful false statements may jeopardize the validity of this document, declares that I am properly authorized to execute this document on behalf of the Owner: and all statements made of my own knowledge are true and all statements made on information and belief are believed to be true." Exhibit 3.

12. The above referred declaration, signed by the Defendant's CEO, Antony Buck, in February of 2009, also stated in part:

"The Owner has used the above-identified mark in commerce for five (5) consecutive years after the date of registration or the date of publication under Section 12(c), and is still using the mark in commerce on or in

connection with all goods listed in the above-identified registration, except for the following:”. Exhibit 3.

13. Defendant listed no exceptions on the subject declaration, confirming that the “REN” trademark had been used in commerce on or in connection with all the goods listed in paragraph 9 of this Complaint, for five (5) consecutive years. Exhibit 3.

14. On information and belief, the following goods were not used in U.S. commerce on or in connection with the “REN” mark for five (5) consecutive years beginning in May of 2003: cosmetic kits comprising any combination of lip gloss, lipstick, lip-liner, eye-shadow, mascara, eye-liner and/or blusher; essential oils for personal use; antiperspirants, deodorants and body sprays; lipsticks and lip balms; bath crystals; cotton wool for cosmetic purposes; cotton sticks for cosmetic purposes; dentifrices; denture cleaning preparations; mouthwashes; depilatory preparations; nail care preparations; nail polish; nail polish removers; false nails; false eyelashes; emery boards; bleaching preparations for cosmetic purposes, hair lotions, hair mousses, hair gels, hair waxes and hair sprays; hair colorants and dyes; sun-tanning preparations; fake tanning preparations; talcum powder.

15. On information and belief, the following goods were also not used in U.S. commerce on or in connection with the “REN” mark for five (5) consecutive years beginning in May of 2003: hair care preparations; shampoos; hair conditioners.

16. Antony Buck, as CEO of Defendant, knew in February of 2009, which of the company’s products were being sold into the United States, and knew the subject declaration (exhibit 3) was false.

17. On information and belief, as Defendant did not use the “REN” trademark for five (5) consecutive years in commerce on or in conjunction with the goods listed in paragraphs 14 and 15 of this Complaint, the declaration (exhibit 3) was knowingly false and fraudulent.

18. On information and belief, Defendant failed to use the “REN” trademark on or in connection with hair care preparations, shampoos, hair conditioners and the like, for three consecutive years after registration, and thus Defendant has abandoned the “REN” trademark for these goods in the United States.

19. Management personnel of Rempure have been selling shampoos and conditioners in the United States for over 30 years and are intimately familiar with competing products and the U.S. markets for such products.

20. Rempure and its aforementioned management have never encountered a shampoo or conditioner hair care product in the United States sold or distributed under the name “REN”.

21. Based upon the familiarity with hair care products and the retail U.S. markets for those products, Rempure began selling hair shampoos and hair conditioners under the brand name REN in 2012.

22. On or about June 18, 2012, Rempure received a cease and desist letter from counsel for Defendant, dated June 14, 2012, demanding that Rempure discontinue the use of “REN” on its hair shampoos and conditioners. Exhibit 4.

23. Rempure, having an apprehension of being sued for trademark infringement created by the subject cease and desist letter, now brings this action for declaratory relief.

COUNT I - DECLARATORY JUDGMENT

24. Renpure restates and incorporates by reference, as if fully set forth herein, the averments contained in the preceding paragraphs.

25. By virtue of the June 14, 2012 letter to Renpure demanding that Renpure cease and desist its use of “REN” on its shampoo and conditioner products, a controversy exists between the parties to this action that warrants the Court to declare whether Defendant can validly claim any intellectual property rights to the term “REN”. Until the court makes such a declaration, Renpure will be in doubt as to its rights.

26. Defendant does not have any valid or enforceable trademark rights in “REN”.

27. Defendant has abandoned the use of “REN” in connection with its use with hair care preparations, shampoos, hair conditioners and the like.

COUNT II: CANCELLATION - FRAUD – 15 U.S.C. §1064(3)

28. Renpure restates and incorporates by reference, as if fully set forth herein, the averments contained in the preceding paragraphs.

29. Defendant’s description of goods in its Combination Section 8 & 15 Declaration (exhibit 3) were knowingly false and made with the intent to be relied upon by the USPTO, and thus Defendant’s trademark rights in the mark “REN” were obtained by fraud and should be cancelled pursuant to 15 U.S.C. §1064(3) under the court’s authority pursuant to 15 U.S.C. §1119.

COUNT III - CIVIL LIABILITY FOR FALSE OR FRAUDULENT  
REGISTRATION UNDER 15 U.S.C. §1120

30. Renpure restates and incorporates by reference, as if fully set forth herein, the averments contained in the preceding paragraphs.

31. As set forth above, Registration No. 2,718,853 for the mark “REN” is invalid and unenforceable due to fraud on the USPTO.

32. Under 15 U.S.C. § 1120, Defendant is liable for damages that Renpure has sustained as a consequence of the false and fraudulent registration by Defendant of the name “REN”.

DEMAND FOR JURY TRIAL

33. Pursuant to Fed.R.Civ.P. 38(b), Renpure demands a jury trial on all matters triable before a jury.

DEMAND FOR RELIEF

WHEREFORE, Renpure demands judgment as follows:

- A. A declaratory judgment that Renpure’s use of the word “REN” is lawful and does not infringe on any rights of Defendant.
- B. A declaratory judgment that Defendant has abandoned the use of the trademark “REN” for use on or in conjunction with hair shampoos, hair conditioners and the like.
- C. A declaratory judgment that Defendant’s “REN” trademark was obtained by fraud and certify such declaratory judgment to the Director of the U.S. Patent and Trademark Office under 15 U.S.C.A. § 1119 for appropriate cancellation action, and instruct the U.S. Patent and Trademark Office and all applicable state offices to record the declaratory

judgment and cancel Registration Number 2,718,853 and all of Defendant's registrations filed with such Office and any state that reflect any intellectual property rights to the term "REN";

- D. A declaration that Defendant is liable to Renpure for violation of 15 U.S.C. §1120;
- E. Award damages to Renpure under 15 U.S.C. §1120;
- F. Grant Renpure a jury trial on all issues triable by a jury; and
- G. Grant Renpure such other and further relief, including costs and attorneys fees, as the Court deems just and proper.

Respectfully submitted,

**SKAAR ULBRICH MACARI, P.A.**

Dated: July 27, 2012

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**ATTORNEYS FOR RENPURE, INC.**