

UNITED STATES DISTRICT COURT
DISTRICT OF MINNESOTA

_____)	
PLASTI DIP INTERNATIONAL, INC.)	Court File No.
)	
Plaintiff,)	
)	
v.)	<u>COMPLAINT</u>
)	
)	(Jury Trial Demanded)
RUST-OLEUM BRANDS COMPANY,)	
)	
Defendant.)	
_____)	

NATURE OF THE ACTION

By this suit, Plaintiff-owner of the PLASTI DIP mark seeks relief from the unlawful and unfairly competitive acts of Rust-Oleum Company in its adoption and use of the confusingly similar FLEXIDIP mark. This is an action for damages and injunctive relief arising out of defendant’s federal trademark infringement and unfair competition.

Plaintiff seeks an Order of Injunction, an Award of Money Damages and Attorneys’ Fees, and an Order instructing the United States Patent and Trademark Office to refuse to allow Defendant’s trademark application for FLEXIDIP as a federally-registered mark.

JURISDICTION AND VENUE

1. This Court has original jurisdiction over the subject matter of the Lanham Act claims pursuant to 15 U.S.C. §§ 1121(a), 28 U.S.C. §§ 1331 and 1338(a).

2. Defendant is subject to both general and specific jurisdiction because it conducts business in the State of Minnesota and within this jurisdiction. Venue is proper in this district pursuant to 28 U.S.C. § 1391.

THE PARTIES

3. The Plaintiff, Plasti Dip International, Inc. is a Minnesota corporation having its principal place of business at 3920 Pheasant Ridge Drive, in Blaine, Minnesota 55449.

4. The Defendant Rust-Oleum Brands Company is a Delaware corporation with its principal place of business at 11 E. Hawthorn Parkway, Vernon Hills, Illinois 60061.

FACTS

5. More than five decades ago, in 1959, Plaintiff started selling product under the PLASTI DIP name and mark. Since that time, Plaintiff has continuously sold, used and promoted its product under the PLASTI DIP name and mark.

6. More than three decades ago, in 1983, United States Trademark Registration No. 1235572 issued for the PLASTI DIP mark. Today, United States Trademark Registration No. 1235572 remains in full force and effect.

7. Over the life of this brand, Plaintiff has extensively used, advertised and promoted its PLASTI DIP mark. Plaintiff's product under the PLASTI DIP mark is well-known and in widespread use throughout the industry.

8. Eight months ago - despite the Plaintiff's long-standing rights – Defendant Rust-Oleum Brands Company signified its intent to nationally use an infringing mark (FLEXIDIP) to sell a same or similar product to Plaintiff's PLASTI DIP by filing a Trademark Application on an Intent-to-Use basis at the United States Patent & Trademark Office.

9. Five months ago, Defendant Rust-Oleum Brands Company started use of the infringing FLEXIDIP mark, and starting selling a same or similar product to that sold under Plaintiff's PLASTI DIP mark, to the same customers, through the same channels of trade.

10. Today, Defendant's product bearing the FLEXIDIP name is offered for sale and available for purchase over the Internet, in Minnesota and nationwide. Defendant's online promotions and advertising of the FLEXIDIP product have increased and expanded exponentially.

11. Defendant's activities amount to federal trademark infringement and federal unfair competition.

12. Defendant's use of the FLEXIDIP mark will create a substantial likelihood of confusion, deception, or mistake among Plaintiff's customers and potential customers.

**COUNT 1 – VIOLATION OF THE LANHAM ACT –
TRADEMARK INFRINGEMENT**

13. Plaintiff incorporates the allegations of Paragraphs 1-13 above.

14. Plaintiff owns an incontestable United States Trademark Registration Certificate for its PLASTI DIP mark.

15. Plaintiff uses its PLASTI DIP mark extensively in commerce.

16. Plaintiff's PLASTI DIP mark is distinctive, widely associated with Plaintiff and exclusively identifies Plaintiff's products and uses.

17. Defendant Rust-Oleum has used and continues to use the confusingly similar FLEXIDIP name in connection with a competing product in commerce.

18. Defendant Rust-Oleum's actions constitute trademark infringement under 15 U.S.C. §1114.

19. Defendant Rust-Oleum's continuing infringement of Plaintiff's PLASTI DIP mark has caused, and will continue to cause irreparable harm to Plaintiff, for which there is no remedy at law.

**COUNT 2 – VIOLATION OF THE LANHAM ACT –
FEDERAL UNFAIR COMPETITION**

20. Plaintiff incorporates the allegations of Paragraphs 1-20 above.

21. Defendant Rust-Oleum's use of the FLEXIDIP mark is designed to cause confusion, mistake or deception as to the affiliation, connection, or association of Defendant's goods with the goods of Plaintiff.

22. Defendant Rust-Oleum's activities are done with willful intent to cause confusion, mistake, or deception.

23. Defendant Rust-Oleum's activities violate 15 U.S.C. § 1125.

24. Defendant Rust-Oleum's actions have caused and will continue to cause irreparable harm and damage to Plaintiff.

**COUNT 3 – REFUSAL OR CANCELLATION OF U.S. APPLICATION
SERIAL NO. 86/085498**

25. Plaintiff incorporates the allegations of Paragraphs 1-25 above.

26. Pursuant to 15 U.S.C. §§ 1063, 1064 and 1119, a mark that is confusingly similar to another mark, and causes damage to the prior user, may be refused registration or cancelled by a court of law at any time.

27. Defendant Rust-Oleum is using in commerce marks identical or confusingly similar to Plaintiff's federally-registered PLASTI DIP mark in connection

with the sale, distribution, or marketing of products, in a manner likely to cause confusion, to cause mistake, or to deceive as to source or origin, among consumers.

28. As a longtime competitor and industry participant, Defendant was aware of Plaintiff and its PLASTI DIP mark before any sales of FLEXIDIP product were made in the United States. Despite such awareness, Defendant commenced use of the FLEXIDIP mark in the United States.

29. Plaintiff has been damaged by the acts of Defendant. Plaintiff has suffered, and, if the acts of Defendant are allowed to continue, will continue to suffer, irreparable injury for which Plaintiff has no adequate remedy at law.

30. Registration of the mark that is the subject of Application Serial No. 86/085498 is likely to damage Plaintiff, and therefore should not be permitted to register.

JURY TRIAL DEMANDED

31. Plaintiff hereby requests a trial on all issues so triable.

REQUEST FOR RELIEF

WHEREFORE Plaintiff requests judgment as follows:

1. That Defendant be preliminarily and permanently enjoined and restrained from using the "FLEXIDIP" mark or any other mark or trade name or engaging in any other conduct that creates a likelihood of misappropriation and dilution of Plaintiff's marks or trade names and the goodwill associated therewith.
2. That registration of Application Serial No. 86/085498 is denied.
3. That Defendant is required to pay Plaintiff damages for injuries sustained by Plaintiff.

4. That Defendant is required to pay Plaintiff all of its litigation expenses, including costs, disbursements, and reasonable attorneys' fees due to the deliberate and knowing nature of Defendant's actions and the exceptional nature of this case.

5. That the Plaintiff takes such other and further relief as the Court may deem just and proper.

Date: June 6, 2014

s/ Kristine Boylan

Kristine M. Boylan, Reg. No. 284634

Erin O. Dungan, Reg. No. 0386430

BRIGGS AND MORGAN, P.A.

80 South Eighth Street, Suite 2200

Minneapolis, Minnesota 55402

kboylan@briggs.com

edungan@briggs.com

Telephone: 612.977.8400

Facsimile: 612.977.8650

Counsel for Plasti Dip International, Inc.