

UNITED STATES DISTRICT COURT  
SOUTHERN DISTRICT OF INDIANA  
INDIANAPOLIS DIVISION

U.S. DISTRICT COURT  
INDIANAPOLIS DIVISION  
2013 JUL 19 PM 1:44

SOUTHERN DISTRICT  
OF INDIANA  
LAURA A. BRIGGS  
CLERK

ROYAL PURPLE, LLC, )  
 )  
Plaintiff, )  
 )  
 v. )  
 )  
LIQUI MOLY GmbH, and )  
LIQUI MOLY USA, INC. )  
 )  
Defendants. )

CASE NO. **1 : 13 -CV- 1155 SEB -MJD**  
JURY TRIAL DEMANDED

COMPLAINT

Plaintiff, ROYAL PURPLE, LLC (“Royal Purple” or “Plaintiff”), files this Complaint against Defendants LIQUI MOLY GmbH and LIQUI MOLY USA, INC. (“Defendants”) as set forth below. In support of this Complaint, Royal Purple alleges as follows:

I. PARTIES

1. Royal Purple is a limited liability company organized and existing under the laws of the State of Delaware, and has a principal place of business at 2780 Waterfront Parkway E. Drive, Suite 200, Indianapolis, Indiana 46214.

2. Liqui Moly GmbH is a limited liability company organized and existing under the laws of Germany, with its principal place of business at Jerg-Wieland-Strasse 4, 89081 Ulm, Germany.

3. Liqui Moly USA, Inc. is a corporation organized and existing under the laws of the state of Delaware, with its principal place of business at 400 Oser Ave., Suite 1650, Hauppauge, NY 11788.

## II. JURISDICTION AND VENUE

4. This is an action for trademark infringement, unfair competition and dilution under the Trademark Act of 1946, as amended, 15 U.S.C. § 1051 et seq. (“Lanham Act”), including 15 U.S.C. §§ 1114, 1125; dilution under the Indiana common law; and trademark infringement, unfair competition and unjust enrichment under Indiana common law.

5. This Court has original jurisdiction over the subject matter of this action under 15 U.S.C. §§ 1121 and 1125 and 28 U.S.C. §§ 1331, 1338 for claims arising under the Lanham Act. This Court further has original jurisdiction over the subject matter of this action under 28 U.S.C. § 1367 for claims so related to the Lanham Act claims that they form part of the same case or controversy under Article III of the United States Constitution.

6. Within this Judicial District, Liqui Moly GmbH has been and is engaged in distributing, offering to sell, and selling products that infringe Royal Purple’s trademarks and in acts that constitute unfair competition, and dilution. For at least these reasons, Liqui Moly GmbH is subject to the personal jurisdiction of this Court.

7. Within this Judicial District, Liqui Moly USA, Inc. has been and is engaged in distributing, offering to sell, and selling products that infringe Royal Purple’s trademarks and in acts that constitute unfair competition, and dilution. For at least these reasons, Liqui Moly USA, Inc. is subject to the personal jurisdiction of this Court.

8. Venue is proper in this Judicial District pursuant to 28 U.S.C. § 1391 (b) and (c) because a substantial part of the events or omissions giving rise to the claims stated herein occurred in this Judicial District.

## III. ROYAL PURPLE AND ITS TRADEMARKS

9. For more than two decades, Royal Purple has engaged in the business of providing high-performance lubricants for automobiles, off-road vehicles, motorcycles, and marine and racing applications. In association with such products, Royal Purple adopted and has used the color purple as a trademark (the "Mark" or the "Royal Purple Mark") in interstate and intrastate commerce since at least 1985. The color purple was chosen to symbolize the extraordinarily high quality of Royal Purple's products given that, historically, the color purple was so expensive to produce that it was a color used only by royalty. The awareness of the outstanding quality of Royal Purple's lubricants rapidly spread among industrial users and racing enthusiasts to such an extent that there are now over 20,000 retailers in the United States selling Royal Purple's lubricants.

10. Since adopting the color purple as its trademark, Royal Purple has continuously used the color purple as a trademark in interstate and intrastate commerce in connection with the advertising, promotion, and sales of its lubricant products. Royal Purple has used the color purple as a trademark on product packaging, labels, and containers, and has incorporated the color purple as a trademark into its lubricant products themselves. Royal Purple has extensively used and promoted the color purple as its trademark such that the color purple is closely identified with Royal Purple's products, and has gained widespread public recognition.

11. Royal Purple is the owner of several federal trademark registrations for the color purple as applied to lubricants and additives for lubricants and fuels, including:

U.S. Registration No. 2,691,774 for lubricating oils for automotive uses and lubricants for industrial and household uses in International Class 4.

U.S. Registration No. 2,953,996 for lubricants oils for automotive uses and lubricants for industrial and household uses in International Class 4;

True and correct copies of the above-identified federal registrations are attached hereto as

Exhibit A.

12. U.S. trademark registration Nos. 2,953,996 and 2,691,774 are incontestable and prima facie evidence of Royal Purple's exclusive right to use the color purple in commerce throughout the United States on the goods specified in the registrations.

13. Further, Royal Purple is the owner of federal trademark registrations for the color purple as applied to related goods, including U.S. Registration No. 3,819,988. Further still, Royal Purple is the owner of several U.S. federal trademark registrations for "ROYAL PURPLE" and for other marks incorporating the word "PURPLE" as applied to various goods, including U.S. Registration Nos. 2,125,544 for ROYAL PURPLE; 2,223,271 for ROYAL PURPLE SYNTHETIC MOTOR OIL; 2,335,522 for ROYAL PURPLE & Design; 2,353,660 for PURPLE ICE; 2,369,880 for ROYAL PURPLE ULTRA PERFORMANCE & Design; 3,099,780 for PURPLE EXTREME, and; 3,689,740 for ROYAL PURPLE.

14. As a result of the care and skill exercised by Royal Purple in the conduct of its business, and the high quality of Royal Purple's products offered under its Mark, as well as the long-running, extensive advertising, promotion, and sale of the Royal Purple products associated with the Mark, Royal Purple's Mark has acquired strong secondary meaning and the consuming public and trade throughout the United States widely recognizes and associates the Mark with the Plaintiff, Royal Purple.

15. As a further result of Royal Purple's longstanding, widespread, and continuous use of its Mark, and as a result of the substantial investments made via significant advertising and promotional activities, and widespread distribution of its superior products, Royal Purple's Mark has become famous among those in the trade as well as the consuming public, and Royal Purple's Mark has come to serve to identify Royal Purple's popular lubricants and related goods,

and to distinguish Royal Purple's goods from those of others.

16. Royal Purple has acquired and now enjoys substantial goodwill and valuable reputation through its Mark. The maintenance of high standards of quality and excellence for Royal Purple's goods and services has contributed to this valuable goodwill and reputation.

17. The goodwill embodied in Royal Purple's Mark, and consequently Royal Purple's valuable reputation and credibility in the industry, depend on the integrity of Royal Purple's Mark being exclusively associated with Royal Purple's products, and not of any other source.

#### IV. DEFENDANTS' UNLAWFUL ACTIVITIES

18. Recently, Royal Purple became aware of the Defendants' use of the color purple in marketing its lubricants in interstate and intrastate commerce. Upon information and belief, the Defendants sell Liqui Moly brand and Lubra Moly brand motor oil (the "Liqui Moly products"), both of which have containers/packaging colored purple prior to sale.

19. The Defendants are not affiliated with or sponsored by Royal Purple and have not been authorized by Royal Purple to use its Mark or any confusingly similar marks. The use by the Defendants of Royal Purple's Mark is likely to cause confusion, mistake, or deception as customers or potential customers encountering the Liqui Moly products, packaging, labeling, advertising, and signage, may mistakenly assume that Defendants or their products are in some way sponsored, endorsed, approved by, or connected with Royal Purple when, in fact, that is not the case.

20. Upon information and belief, before Defendants began using the color purple as a trademark on their products, packaging, and labels to promote their products (products that directly compete with Royal Purple's products), the Defendants knew Royal Purple used the

Royal Purple Mark to promote its products.

21. Upon information and belief, the Defendants have performed the acts identified above with wrongful purpose and knowledge of the Royal Purple Mark in order to trade upon Royal Purple's extensive goodwill, including using Royal Purple's Mark to draw attention to the Defendants' Liqui Moly products.

22. Royal Purple's Mark was first used in the State of Indiana and elsewhere in the United States long before the Defendants first used the color purple in and on its products and packaging to promote the Liqui Moly products anywhere in the United States.

23. Royal Purple's Mark was first used in interstate commerce in the United States long before the Defendants first used the color purple in and on its products and packaging to promote the Liqui Moly products in interstate commerce.

24. Royal Purple's Mark has priority over the Defendants' use of the color purple as a product identifier in the State of Indiana and throughout the United States.

#### V. EFFECT OF DEFENDANTS' UNLAWFUL ACTIVITIES

25. The Defendants' unauthorized use of Royal Purple's Mark is likely to cause confusion, to cause mistake, and/or to deceive customers and potential customers of the parties into believing that Defendants' goods and services originate with Royal Purple, are associated with Royal Purple, are sponsored by Royal Purple, are offered with the approval of Royal Purple, and/or are offered under Royal Purple's supervision and control, and/or that there exists at least some affiliation, connection, or association of the Defendants with Royal Purple.

26. The Defendants' unauthorized use of Royal Purple's Mark falsely designates the origin of the Liqui Moly products and services, and falsely and misleadingly describes and represents facts with respect to Defendants and their products and services.

27. The Defendants' unauthorized use of Royal Purple's Mark enables the Defendants to trade on, and receive the benefit of, goodwill built up at great labor and expense by Royal Purple over many years, and to gain acceptance for the Liqui Moly products and services not solely on its own merits, but on the reputation and goodwill of Royal Purple's Mark, and Royal Purple's products and services.

28. The Defendants' unauthorized use of Royal Purple's Mark is likely to dilute the distinctive quality of Royal Purple's Mark.

29. The Defendants' unauthorized use of Royal Purple's Mark unjustly enriches the Defendants at Royal Purple's expense. The Defendants have been, and continue to be, unjustly enriched by obtaining a benefit from Royal Purple by taking undue advantage of Royal Purple and its goodwill. Specifically, the Defendants have taken undue advantage of Royal Purple by trading on and profiting from the goodwill in Royal Purple's Mark developed and owned by Royal Purple, resulting in the Defendants wrongfully obtaining a monetary and reputational benefit for their own business, goods, and services.

30. The Defendants' unauthorized use of Royal Purple's Mark removes from Royal Purple the ability to control the nature and quality of products and services provided under Royal Purple's Mark, and places the valuable reputation and goodwill of Royal Purple in the hands of the Defendants, over whom Royal Purple has no control.

31. Unless these acts of the Defendants are restrained by this Court, they will continue to cause irreparable injury to Royal Purple and to the public for which there is no adequate remedy at law.

COUNT ONE  
TRADEMARK INFRINGEMENT UNDER FEDERAL LAW – 15 U.S.C. § 1114

32. Royal Purple repeats and re-alleges the allegations above, as if fully set forth

herein.

33. The Defendants' acts complained of above constitute infringement of one or more of the Royal Purple Marks, and are in violation of 15 U.S.C. § 1114.

34. The acts of the Defendants complained of above deceive the relevant consuming public into accepting and purchasing the Defendants' goods and services in the mistaken belief that they are Royal Purple's goods or services, or that they are sponsored by, connected with, or supplied under the supervision of Royal Purple.

35. As a result of the Defendants' acts, Royal Purple has already suffered damage and will continue to suffer damage, while the Defendants profit at Royal Purple's expense. Unless the Defendants are enjoined, Royal Purple has no adequate remedy at law and will be irreparably harmed.

COUNT TWO  
UNFAIR COMPETITION; FALSE DESIGNATION OF  
ORIGIN UNDER FEDERAL LAW – 15 U.S.C. § 1125 (a)

36. Royal Purple repeats and re-alleges the allegations above, as if fully set forth herein.

37. The acts of the Defendants complained of herein constitute unfair competition with respect to one or more of Royal Purple's federally registered, incontestable Marks in violation of Section 43(a) of the Lanham Act, 15 U.S.C. § 1125(a).

38. The acts of the Defendants complained of above are calculated to deceive the relevant consuming public into accepting and purchasing the Defendants' goods and services in the mistaken belief that they are Royal Purple's goods or services, or that they are sponsored by, connected with, or supplied under the supervision of Royal Purple.

39. As a result of the Defendants' acts, Royal Purple has already suffered damage and



will continue to suffer damage, while the Defendants profit at Royal Purple's expense. Unless the Defendants are enjoined, Royal Purple has no adequate remedy at law and will be irreparably harmed.

COUNT THREE  
DILUTION UNDER FEDERAL LAW – 15 U.S.C. § 1125 (c)

40. Royal Purple repeats and re-alleges the allegations above, as if fully set forth herein.

41. Royal Purple's Marks are famous, distinctive, and incontestable. The Defendants adopted Royal Purple's Marks after the Marks had become famous and distinctive, and the Defendants have diluted and/or harmed the value of Royal Purple's famous Marks.

42. The Defendants' acts complained of above constitute dilution of Royal Purple's Marks in violation of Section 43(c) of the Lanham Act, 15 U.S.C. § 1125(c).

43. As a result of the Defendants' acts, Royal Purple has already suffered damage and will continue to suffer damage, while the Defendants profit at Royal Purple's expense. Unless the Defendants are enjoined, Royal Purple has no adequate remedy at law and will be irreparably harmed.

COUNT FOUR  
DILUTION IN VIOLATION OF INDIANA CODE § 24-2-1-13.5

44. Royal Purple repeats and re-alleges the allegations above, as if fully set forth herein.

45. The Defendants' acts complained of above constitute dilution of one or more of Royal Purple's Marks and an injury to its business reputation in violation of § 24-2-1-13.5 of the Indiana Code.

46. The Defendants' conduct has injured, or is likely to injure, Royal Purple's business reputation and/or has diluted, or is likely to dilute, the distinctive quality of Royal

Purple's Marks, entitling Royal Purple at least to an injunction. Specifically, the Defendants' use of the color purple in and on their lubricant products and packaging is likely to injure Royal Purple's business reputation or likely to dilute Royal Purple's Marks.

47. As a result of the Defendants' acts, Royal Purple has already suffered damage and will continue to suffer damage, while the Defendants profit at Royal Purple's expense. Unless the Defendants are enjoined, Royal Purple has no adequate remedy at law and will be irreparably harmed.

COUNT FIVE  
COMMON LAW TRADEMARK INFRINGEMENT

48. Royal Purple repeats and re-alleges the allegations above, as if fully set forth herein.

49. Royal Purple owns all rights, title, and interest in and to the Marks, including all common law rights in the Marks.

50. The Defendants' acts complained of above are likely to cause confusion with one or more of Royal Purple's Marks in violation of the common law of the State of Indiana.

51. The Defendants' acts complained of above constitute trademark infringement in violation of the common law of the state of Indiana.

52. The Defendants' acts complained of above are calculated to deceive the relevant consuming public into accepting and purchasing the Liqui Moly goods and services in the mistaken belief that they are Royal Purple's goods or services, or that they are sponsored by, connected with, or supplied under the supervision of Royal Purple.

53. As a result of the Defendants' acts, Royal Purple has already suffered damage and will continue to suffer damage, while the Defendants profit at Royal Purple's expense. Unless the Defendants are enjoined, Royal Purple has no adequate remedy at law and will be irreparably

harmed.

COUNT SIX  
UNFAIR COMPETITION UNDER INDIANA COMMON LAW

54. Royal Purple repeats and re-alleges the allegations above, as if fully set forth herein.

55. The Defendants' acts as complained of above deceive the relevant consuming public into accepting and purchasing the Liqui Moly goods and services in the mistaken belief that they are Royal Purple's goods or services, or that they are sponsored by, connected with, or supplied under the supervision of Royal Purple.

56. The Defendants' adoption and use of the color purple on their lubricant products packaging to identify their lubricants and other goods constitutes unfair competition. By such use, the Defendants have represented that their goods are actually those supplied by Royal Purple. This use creates a likelihood that the public will be confused or deceived.

57. The Defendants' actions constitute dilution, unfair competition, palming off, unjust enrichment and misappropriation of Royal Purple's rights under Indiana common law.

58. As a result of the Defendants' acts, Royal Purple has already suffered damage and will continue to suffer damage, while the Defendants profit at Royal Purple's expense. Unless the Defendants are enjoined, Royal Purple has no adequate remedy at law and will be irreparably harmed.

COUNT SEVEN  
UNJUST ENRICHMENT

59. Royal Purple repeats and re-alleges the allegations above, as if fully set forth herein.

60. The acts of the Defendants complained of above constitute unjust enrichment of

the Defendants at the expense of Royal Purple.

JURY DEMAND

61. Royal Purple demands a trial by jury on all issues triable by jury.

PRAYER FOR RELIEF

WHEREFORE, Royal Purple prays for an order and judgment that:

A. The Defendants and their officers, directors, affiliates, subsidiaries, agents, servants, employees, attorneys and all persons acting in active concert or participation with any of them be preliminarily and permanently enjoined from:

- i. Using the color purple in their products or packaging, or any mark confusingly similar to the Royal Purple Marks, in the United States;
- ii. Committing any acts likely to cause the public to believe that any of Defendants' products and services are Royal Purple's products and services, or are authorized by, sponsored by, or in any way associated with Royal Purple, in whole or in part;
- iii. Otherwise competing unfairly with Royal Purple in any manner, including but not limited to, using a false designation of origin or false representations, which misrepresent the nature, characteristics or qualities, source or origin of the Defendants' products or other commercial activities; and/or,
- iv. Attempting, causing, or assisting any of the above-described acts.

B. The Defendants be ordered to take all steps necessary to destroy all remaining inventory of infringing lubricants that are colored purple or that are packaged or labeled with the color purple, such steps including obtaining and destroying all such product held or inventoried

by distributors and/or dealers.

C. The Defendants be ordered to file with the Court and serve on counsel for Royal Purple within fourteen (14) days after entry of any injunction issued by this Court in this action, a sworn written statement pursuant to 15 U.S.C. § 1116 setting forth in detail the manner and form in which the Defendants have complied with the injunction;

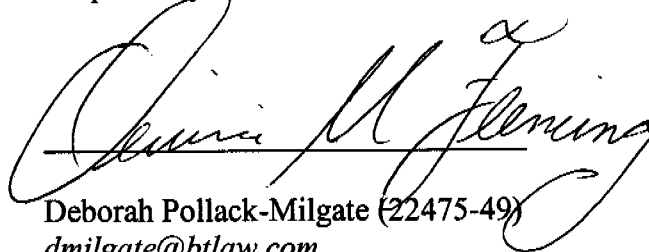
D. The Defendants be ordered to pay all damages Royal Purple has sustained as a result of the Defendants' activities, and that the damage be enhanced and at least trebled, such damages including but not limited to corrective advertising undertaken by Royal Purple, and including but not limited to those damages available under at least 15 U.S.C. § 1117 and Indiana common law, including court costs, expenses, enhanced damages, and attorney's fees;

E. An accounting be directed to determine the Defendants' profits resulting from their activities and that such profits be paid over to Royal Purple, increased as the Court finds to be just under the circumstances of this case;

F. The Defendants be ordered to pay Royal Purple's costs of this action, as well as pre-judgment interest on all amounts awarded, and post-judgment interest until paid, at the highest lawful rate;

G. Royal Purple has such other relief as the Court deems just and equitable.

Respectfully submitted,



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Dated: July 19, 2013

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