

**UNITED STATES DISTRICT COURT
SOUTHERN DISTRICT OF FLORIDA**
Miami Division
CASE NO.: 11-24068-CIV-Martinez/McAliley

LOUIS VUITTON MALLETIER, S.A. and
EMILIO PUCCI INTERNATIONAL B.V.,

Plaintiffs,

v.

YANGQUAN LU and DOES 1-10,

Defendants.

**MEMORANDUM OF POINTS AND AUTHORITIES
IN SUPPORT OF PLAINTIFFS' *EX PARTE* APPLICATION**

Plaintiffs submit this Memorandum of Points and Authorities in support of their *Ex Parte* Application for Entry of Temporary Restraining Order and Preliminary Injunction (the "*Ex Parte* Application for TRO").

I. INTRODUCTION

Plaintiffs, Louis Vuitton Malletier, S.A. ("Louis Vuitton") and Emilio Pucci International B.V. ("Pucci") (together, "Plaintiffs") are suing Defendants YangQuan Lu ("Lu") and Does 1-10 (collectively "Defendants") for trademark counterfeiting and infringement, false designation of origin, and cybersquatting.¹ As alleged in Plaintiffs' Complaint, the named Defendant and various unknown associates are, *inter alia*, promoting, advertising, distributing, offering for sale and/or selling counterfeit and infringing Louis Vuitton and Pucci branded products within this Judicial District through the fully interactive commercial Internet websites operating under their domain names (the "Subject Domain Names") and wrongfully using Pucci's trademark in two of the Subject Domain Names.

Defendants' unlawful activities have caused and will continue to cause irreparable injury to Plaintiffs. Among other things, Defendants have (1) deprived Plaintiffs of their rights to determine the manner in which their respective trademarks are presented to the public through merchandising; (2) defrauded the public into thinking Defendants' goods are valuable,

¹ Only Plaintiff Pucci is alleging a claim for cybersquatting.

authorized goods of Louis Vuitton and Pucci; (3) deceived the public as to Plaintiffs' sponsorship and/or association of Defendants' goods and the websites through which such goods are marketed and sold; and (4) wrongfully traded and capitalized on Plaintiffs' respective reputations and goodwill and the commercial value of Plaintiffs' respective trademarks. Defendants should not be permitted to continue their unlawful activities and should be enjoined from using Plaintiffs' trademarks in connection with their domain names and their counterfeit goods.

II. STATEMENT OF FACTS

A. Louis Vuitton's Rights.

Louis Vuitton is, and at all times relevant hereto has been, the owner of all rights in and to the federally registered trademarks identified in Paragraph 5 of the Declaration of Nikolay Livadkin in Support of Plaintiff's *Ex Parte* Application for TRO ("Livadkin Decl."), filed herewith (the "Louis Vuitton Marks"). See also United States Trademark Registrations of the Louis Vuitton Marks at issue ("Louis Vuitton Trademark Registrations") attached as Exhibit A to the Livadkin Declaration. The Louis Vuitton Marks are used in connection with the manufacture and distribution of, among other things handbags, pocket wallets, shoulder bags, purses, belts, shoes, boots, sunglasses, and watches. The Louis Vuitton Marks are symbols of Louis Vuitton's quality, reputation, and goodwill and have never been abandoned. (Livadkin Decl. ¶¶ 6, 7, 10.) Moreover, Louis Vuitton has expended substantial time, money, and other resources developing, advertising, and otherwise promoting its trademarks. (Livadkin Decl. ¶ 6.) Accordingly, the Louis Vuitton Marks qualify as famous marks as the term is used in 15 U.S.C. § 1125(c)(1).

Furthermore, Louis Vuitton has extensively used, advertised, and promoted its Marks in the United States in association with handbags, pocket wallets, shoulder bags, purses, belts, shoes, boots, sunglasses, watches, and related goods and has carefully monitored and policed the use of the Louis Vuitton Marks. (Livadkin Decl. ¶¶ 7, 10.) As a result of Louis Vuitton's efforts, members of the consuming public readily identify products bearing the Louis Vuitton Marks as being quality merchandise sponsored and approved by Louis Vuitton. (*Id.*) Accordingly, the Louis Vuitton Marks have achieved secondary meaning as identifiers of high quality handbags, pocket wallets, shoulder bags, purses, belts, shoes, boots, sunglasses, watches, and other goods.

B. Pucci's Rights.

Pucci is, and at all times relevant hereto has been, the owner of all rights in and to the federally registered trademark identified in Paragraph 8 of the Livadkin Decl. (the "Pucci Mark"). See also United States Trademark Registration of the Pucci Mark at issue ("Pucci Trademark Registration") attached as Exhibit B to the Livadkin Declaration. The Pucci Mark is used in connection with the manufacture and distribution of, among other things, dresses. The Pucci Mark is a symbol of Pucci's quality, reputation, and goodwill and has never been abandoned. (Livadkin Decl. ¶¶ 8-10.) Moreover, Pucci has expended substantial time, money, and other resources developing, advertising, and otherwise promoting its trademark. (Livadkin Decl. ¶ 9.) Accordingly, the Pucci Mark qualifies as a famous mark as the term is used in 15 U.S.C. § 1125(c)(1).

Furthermore, Pucci has extensively used, advertised, and promoted its Mark in the United States in association with dresses and related goods and has carefully monitored and policed the use of the Pucci Mark. (Livadkin Decl. ¶ 10.) As a result of Pucci's efforts, members of the consuming public readily identify products bearing the Pucci Mark as being quality merchandise sponsored and approved by Pucci. (Id.) Accordingly, the Pucci Mark has achieved secondary meaning as an identifier of high quality dresses and other goods.

C. Defendants Wrongfully Use the Plaintiffs' Trademarks in Connection With the Promotion and Sale of Counterfeit Goods.

Defendants do not have, nor have they ever had, the right or authority to use the Plaintiffs' Marks for any purpose. (Livadkin Decl. ¶ 12.) However, despite their known lack of authority to do so, Defendants are promoting and otherwise advertising, distributing, selling and/or offering for sale, at least, handbags, pocket wallets, shoulder bags, purses, belts, shoes, boots, sunglasses, and watches bearing counterfeit and infringing trademarks which are exact copies of the Louis Vuitton Marks ("Defendants' Goods"). (Livadkin Decl. ¶¶ 14-17; Tanori Decl. ¶¶ 4, 5 and Comp. Exs. A and B thereto; Declaration of Stephen M. Gaffigan in Support of Plaintiff's *Ex Parte* Application for TRO ("Gaffigan Decl.") ¶¶ 2-5, filed herewith, and Comp. Exs. B and C attached thereto; see also relevant web pages from Defendants' Internet websites operating under the Subject Domain Names ("Defendants' Websites") attached as Comp. Ex. A to the Gaffigan Decl. and attached as Comp. Ex. C to the Livadkin Decl.)

Given Defendants' slavish copying of the Plaintiffs' Marks, the overall design, color

scheme, and products, genuine goods bearing the Plaintiffs' Marks and Defendants' Goods sold under identical marks are indistinguishable to consumers, both at the point of sale and post-sale. By doing so, Defendants have created a false association between their counterfeit and infringing goods and websites, and Plaintiffs. Such false association is in violation of 15 U.S.C. § 1125(a) and is causing and will continue to cause irreparable harm to Plaintiffs.

As part of its ongoing investigation regarding the sale of counterfeit products, Plaintiffs retained Brandon Tanori ("Tanori") of Investigative Consultants to investigate the sale of counterfeit Louis Vuitton branded products by Defendants. (Livadkin Decl. ¶ 13; Tanori Decl. ¶ 3.) Tanori accessed one of the Internet websites operated by Defendants, luxuryaaa.com, and placed an order for the purchase of a Louis Vuitton branded watch, to be shipped directly to his address located in Miami, Florida. (Tanori Decl. ¶ 4 and Comp. Ex. A thereto.) Tanori finalized payment for the watch via Western Union Financial Services and the payee was identified as "YangQuan Lu." (Tanori Decl. ¶¶ 4, 5 and Comp. Exs. A and B thereto.)

Thereafter, the detailed web page listings of the Louis Vuitton branded watch purchased by Tanori via luxuryaaa.com were reviewed by Louis Vuitton's representative, Nikolay Livadkin, who is familiar with Louis Vuitton's genuine goods and trained to detect counterfeits. (Livadkin Decl. ¶¶ 3, 14-15.) Mr. Livadkin determined the watch to be a non-genuine, unauthorized Louis Vuitton product. (Livadkin Decl. ¶¶ 3, 14-15, 17.) Additionally, Mr. Livadkin reviewed and visually inspected the items bearing the Louis Vuitton Marks and the Pucci Mark offered for sale by Defendants via their Internet websites operating under each of the Subject Domain Names and determined the products were non-genuine, unauthorized Louis Vuitton and Pucci branded products. (Id. at ¶¶ 16, 17.)

Section 1127 of the Lanham Act defines a "counterfeit" as "a spurious mark which is identical with, or substantially indistinguishable from, a registered mark." 15 U.S.C. § 1127. Also, using the "ocular test" of direct comparison, courts have found that even marks which are slightly modified from the registered marks copied are to be considered counterfeit marks. See Fimab-Finanziaria Maglificio vs. Helio Import/Export, Inc., 601 F. Supp. 1 (S.D. Fla. 1983). A comparison of the Plaintiffs' Marks at issue to the marks and designs used by Defendants in connection with the sale of Defendants' Goods reveals the obvious counterfeit infringing nature of Defendants' Goods. (Compare Louis Vuitton's Trademark Registrations and Pucci's Trademark Registration (Exs. A and B to the Livadkin Decl.) with Defendants' Websites (Comp.

Ex. A to the Gaffigan Decl. and Comp. Ex. C to the Livadkin Decl.) Defendants' Goods are being promoted, advertised, sold, and offered for sale by Defendants within this Judicial District and throughout the United States. (Tanori Decl. ¶¶ 4, 5 and Comp. Exs. A and B thereto; and Defendants' Websites attached as Comp. Ex. A to the Gaffigan Decl. and Comp. Ex. C to the Livadkin Decl.) Defendants are making substantial sums of money by preying upon their customers and members of the general public, many of whom have no knowledge Defendants are defrauding them through the sale of worthless counterfeit goods. Defendants are also falsely representing to consumers and the trade that their goods are genuine, authentic, endorsed, and authorized by Plaintiffs. Ultimately, Defendants' Internet websites amount to nothing more than massive illegal operations, infringing on the intellectual property rights of Plaintiffs and others. The Subject Domain Names themselves are a substantial part of the means by which Defendants further their scheme and cause harm to Plaintiffs.

D. Defendants Wrongfully Use the Pucci Trademark in Connection Their Subject Domain Names.

Additionally, Defendants have fraudulently registered multiple domain names at issue using names which are identical or confusingly similar to the famous Pucci Mark. Further, Defendants' Internet websites operating under the Subject Domain Names emiliopuccioutlet.com and emiliopuccioutletdress.com are advertising and offering for sale, at least, dresses bearing counterfeits and infringements of the Pucci Mark. (Livadkin Decl. ¶¶ 16, 17). Defendants' use of the Pucci Mark in the Subject Domain Names emiliopuccioutlet.com and emiliopuccioutletdress.com is without Pucci's consent or authorization. (Livadkin Decl. ¶ 17). By doing so, Defendants have created a false association between their counterfeit and infringing goods and websites, and Pucci. Such false association is in violation of 15 U.S.C. § 1125(a) and is causing and will continue to cause irreparable harm to Pucci. Moreover, Defendants' registration of the domain names which incorporate Pucci's registered trademark constitutes cyberpiracy in violation of 15 U.S.C. § 1125(d). The Subject Domain Names emiliopuccioutlet.com and emiliopuccioutletdress.com are a substantial part of the means by which Defendants further their scheme and cause harm to Pucci.

III. ARGUMENT

A. A Temporary Restraining Order is Essential to Prevent Immediate Injury.

Rule 65(b) of the Federal Rules of Civil Procedure provides, in part, that a temporary

restraining order may be granted without written or oral notice to the opposing party or that party's counsel where "it clearly appears from the specific facts shown by affidavit . . . that immediate and irreparable injury, loss, or damage will result to the applicant before the adverse party or that party's attorney can be heard in opposition." This is such a case.

Defendants herein fraudulently promote, advertise, sell, and offer for sale substantial quantities of goods bearing counterfeits of the Plaintiffs' Marks via their Internet websites operating under the Subject Domain Names. By their actions, Defendants are creating a false association in the minds of consumers between the Defendants and the Plaintiffs. Specifically, Defendants are wrongfully using counterfeits of the Plaintiffs' Marks on their websites and wrongfully using the Pucci Marks in their domain names to increase traffic to their illegal website businesses which offer consumers a variety of counterfeit Louis Vuitton and Pucci branded goods. The entry of a temporary restraining order would serve to immediately stop Defendants from benefiting from their wrongful use of the Plaintiffs' Marks and preserve the status quo until such time as a hearing can be held. Thus, a temporary restraining order is appropriate. See Dell Inc. v. BelgiumDomains, LLC, Case No. 07-22674 2007 WL 6862341, at *2 (S.D. Fla. Nov. 21, 2007) (finding *ex parte* relief more compelling where Defendants' scheme "is in electronic form and subject to quick, easy, untraceable destruction by Defendants."); In re Vuitton et Fils, S.A., 606 F.2d 1 (2d Cir. 1979) (holding that *ex parte* temporary restraining orders are indispensable to the commencement of an action when they are the sole method of preserving a state of affairs in which the court can provide effective final relief.).

In the absence of a temporary restraining order without notice, Defendants can and, based upon Plaintiffs' counsel's past experience, will significantly alter the status quo before the Court can determine the parties' respective rights. Specifically, the Internet websites at issue are under Defendants' complete control. Thus, Defendants have the ability to modify registration data and content, change hosts and, most importantly, redirect traffic to other websites they control. (Gaffigan Decl. ¶¶ 6-7.) Such modifications can literally happen in the span of a few minutes after Defendants are provided with notice of this action. (Id.) Plaintiffs' counsel has learned through multiple prior cases that, upon notice of a lawsuit, counterfeit website owners typically immediately set up a redirect which essentially informs a search engine that the website being crawled has permanently moved to another domain and instructs the search engine to divert traffic to the other website. (Id. at ¶¶ 8, 9 and Comp. Ex. D attached thereto, examples of website

redirection.) In the circumstances present in this case, Defendants could use the redirect to push new traffic from the Subject Domain Names to new domains not yet identified in the Complaint. (*Id.*) The result would be to slingshot the new domains to the top of the search engine results pages by leveraging the Internet traffic to the domains in suit which was built through the illegal use of the Plaintiffs' Marks. (*Id.*) In short, Defendants would completely erase the status quo by transferring all of the benefits of their prior illegal activities to new websites. Plaintiffs' counsel has seen this precise pattern of behavior occur in a number of cases. (*Id.* at 9.)

Moreover, federal courts have long recognized that civil actions against counterfeiters – whose very business is built around the deliberate misappropriation of rights and property belonging to others – present special challenges that justify proceeding on an *ex parte* basis. Columbia Pictures Indus., Inc. v. Jasso, 927 F. Supp 1075, 1077 (N.D. Ill. 1996) (observing that “proceedings against those who deliberately traffic in infringing merchandise are often useless if notice is given to the infringers”).² This Court should prevent an injustice from occurring by issuing an *ex parte* temporary restraining order which precludes Defendants from continuing to display their infringing content via the websites operating under the Subject Domain Names and which temporarily removes control over the websites from Defendants. Only such an order will prevent ongoing irreparable harm and maintain the status quo.

B. Standard for Temporary Restraining Order and Preliminary Injunction.

In this Circuit, the standard for obtaining a temporary restraining order and the standard for obtaining a preliminary injunction are the same. See Emerging Vision, Inc. v. Glachman, Case No. 10-cv-80734, 2010 WL 3293346, at *3 (S.D. Fla. June 29, 2010) (citing Siegel v. LePore, 120 F. Supp. 2d 1041 (S.D. Fla. 2000) *aff'd* 2000 WL 1781946 (11th Cir. 2000)). In order to obtain a temporary restraining order or a preliminary injunction, a party must establish “(1) a substantial likelihood of success on the merits; (2) that irreparable injury will be suffered if the relief is not granted; (3) that the threatened injury outweighs the harm the relief would inflict on the non-movant; and (4) that entry of the relief would serve the public interest. Schiavo ex rel.

² See also Louis Vuitton Malletier, S.A. v. Chunqiu, Case 11-cv-60999-JEM (S.D. Fla. May 17, 2011) (Order granting *Ex Parte* Application for Temporary Restraining Order); Abercrombie & Fitch Trading Co. v. Zhiyong, Case 0:11-cv-60913-JEM (S.D. Fla. May 2, 2011) (same); Tiffany (NJ) LLC v. Zheng, Case 11-cv-60171-CMA (S.D. Fla. Feb. 1, 2011) (same); Gucci America, Inc. v. Zhou, Case 1:11-cv-22734-PAS (S.D. Fla. August 18, 2011) (same); Louis Vuitton Malletier, S.A. v. Feng, Case 11-cv-60811-DMM (S.D. Fla. April 25, 2011) (same); Louis Vuitton Malletier, S.A. v. Wang, Case 11-cv-60805-JIC (S.D. Fla. April 22, 2011) (same); Louis Vuitton Malletier, S.A. v. Li, Case 11-cv-60611-WPD (S.D. Fla. March 28, 2011) (same).

Schindler v. Schiavo, 403 F.3d 1223, 1225-26 (11th 2005); see also Levi Strauss & Co. v. Sunrise Int'l Trading Inc., 51 F.3d 982, 985 (11th Cir. 1995) (affirming entry of preliminary injunction and freezing of assets). Plaintiffs' evidence establishes all of the relevant factors. Accordingly, preliminary injunctive relief is appropriate.

1. Probability of Success on the Merits of Plaintiffs' Claims.

a) Plaintiffs Are Likely to Succeed on Their Counterfeiting Claim.

Title 15 U.S.C. §1114 provides liability for trademark infringement if, without the consent of the registrant, a defendant uses "in commerce any reproduction, counterfeit, copy, or colorable imitation of a registered mark: which is likely to cause confusion, or to cause mistake, or to deceive." Plaintiffs must demonstrate (1) ownership of the trademarks at issue; (2) Defendants' use of the marks is without authorization from Plaintiffs; and (3) Defendants' use is likely to cause confusion, mistake, or deception as to the source, affiliation, or sponsorship of Defendants' Goods. See 15 U.S.C. § 1114(1). Plaintiffs' evidence submitted herewith satisfies the three requirements of 15 U.S.C. § 1114.

The first two elements of Plaintiffs' trademark infringement claim are easily met. The Louis Vuitton Marks and the Pucci Mark are respectively owned by Louis Vuitton and Pucci and are registered on the Principal Register of the United States Patent and Trademark Office, and all the marks have become "incontestable" under 15 U.S.C. §§ 1058 and 1065. (See Livadkin Decl. ¶¶ 4, 5, 7, 8 and Exs. A and B thereto, Louis Vuitton and Pucci Trademark Registrations.) See also Ocean Bio-Chem, Inc. v. Turner Network Television, Inc., 741 F. Supp. 1546, 1554 (S.D. Fla. 1990) ("Incontestable status provides conclusive evidence of the registrant's exclusive right to use the registered mark, subject to §§ 15 and 33(b) of the Lanham Act."). Moreover, Defendants do not have, nor have they ever had, the right or authority to use the Plaintiffs' Marks. (Livadkin Decl. ¶ 12.)

The Eleventh Circuit uses a seven-factor test in determining the third element, likelihood of confusion. See Ross Bicycles, Inc. v. Cycles USA, Inc., 765 F.2d 1502, 1506 (11th Cir. 1985). These factors, as outlined in Safeway Store, Inc. v. Safeway Discount Drugs, Inc., are: (1) the strength of the mark; (2) the similarity of marks; (3) the similarity of the goods; (4) similarity of the sales methods; (5) the similarity of advertising media; (6) defendants' intent; and (7) evidence of actual confusion. See 675 F.2d 1160, 1164 (11th Cir. 1982); see also Lipscher v.

LRP Publ'ns, Inc., 266 F.3d 1305, 1303 (11th Cir. 1997). The seven factors listed are to be weighed and balanced and no single factor is dispositive. (Id.)

(1) Strength of the Marks.

A trademark's strength is determined by viewing the mark in its entirety as it appears in the marketplace. See Lone Star Steakhouse and Saloon, Inc. v. Longhorn Steaks, Inc., 106 F.3d 355, 362 (11th Cir. 1997). The spectrum of protectability and strength for trademarks is divided into four primary types of designations: (1) coined, fanciful or arbitrary; (2) suggestive; (3) descriptive; and (4) generic. See Two Pesos, Inc. v. Taco Cabana, Inc., 505 U.S. 763, 768, 112 S. Ct. 2753, 120 L. Ed. 2d 615 (1992). Arbitrary or fanciful marks are the strongest. Moreover, arbitrary/fanciful and suggestive marks are deemed inherently distinctive and entitled to protection. (See id.) It cannot be seriously disputed that the Plaintiffs' Marks are strong, arbitrary and fanciful marks. (See Livadkin Decl. ¶¶ 4, 5, 7, 8 and Exs. A and B thereto, Louis Vuitton and Pucci Trademark Registrations.)

In addition to their inherent strength, the Plaintiffs' Marks have also acquired secondary meaning. Plaintiffs have each expended substantial time, labor, skill, and expense in developing, advertising, and promoting their respective trademarks. (Livadkin Decl. ¶¶ 6, 7, 9, 10.) The Plaintiffs' Marks enjoy widespread recognition and are prominent in the minds of consumers. (Id.) Indeed, products bearing the Plaintiffs' Marks are among the best selling luxury goods in the United States. (Id.)

(2) Similarity of the Marks.

Likelihood of confusion is greater when an infringer uses the exact trademark. Turner Greenberg Assocs. v. C & C Imps., 320 F. Supp. 2d 1317, 1332 (S.D. Fla. 2004). Defendants are using marks which are identical to the Plaintiffs' Marks. (Compare Plaintiffs' Trademarks Registrations (Exs. A and B to the Livadkin Decl.) with Defendants' Websites (Comp. Ex. A to the Gaffigan Decl. and Comp. Ex. C to the Livadkin Decl.)

(3) Similarity of the Goods.

"The greater the similarity between the products and services, the greater the likelihood of confusion." John H. Harland Co. v. Clarke Checks, Inc., 711 F.2d 966, 976 (11th Cir. 1983) (citing Exxon Corp. v. Texas Motor Exchange, Inc., 628 F.2d 500, 505 (5th Cir. 1980)). Defendants are selling the same types of goods Plaintiffs sell, i.e., handbags, pocket wallets,

shoulder bags, purses, belts, shoes, boots, sunglasses, watches, and dresses. (Livadkin Decl. ¶¶ 4-10; see generally, Defendants' Websites attached as Comp. Ex. A to the Gaffigan Decl. and attached as Comp. Ex. C to the Livadkin Decl.) Because they bear counterfeit Louis Vuitton and Pucci trademarks, Defendants' Goods appear virtually identical to Plaintiffs' genuine products in the consumer market. Standing alone, this similarity can be held sufficient to establish a likelihood of confusion. See John H. Harland Co. v. Clarke Checks, Inc., 711 F.2d 966, 976 (11th Cir. 1983).

(4) Similarity of Sales Method and Advertising Method.

Convergent marketing channels increase the likelihood of confusion. See Turner Greenburg Assocs., 320 F. Supp. 2d at 1332. Both Plaintiffs and Defendants sell, distribute and advertise their products using, at least, one of the same marketing channels, the Internet, in the same geographical distribution areas within the United States, including the Southern District of Florida. (Livadkin Decl. ¶¶ 6, 9; Tanori Decl. ¶¶ 4, 5 and Comp. Exs. A and B thereto; see generally Defendants' Websites attached as Comp. Ex. A to the Gaffigan Decl. and attached as Comp. Ex. C to the Livadkin Decl.) Thus, the conditions of purchase for both parties are unmistakably identical. Moreover, both target the same general customers, and as such, Plaintiffs are directly competing with Defendants' products.

(5) Defendants' Intent.

In this District, it has been held that when an alleged infringer adopts a mark "with the intent of obtaining benefit from the plaintiff's business reputation, 'this fact alone may be sufficient to justify the inference that there is confusing similarity.'" Turner Greenberg Assocs., 320 F. Supp. 2d at 1333 citing Carnival Corp. v. Seaescape Casino Cruises, Inc., 74 F. Supp. 2d 1261, 1268 (S.D. Fla. 1999). In a case of clear-cut copying such as this, it is appropriate to infer Defendants intended to benefit from Plaintiffs' respective reputations, to the detriment of Plaintiffs. See Playboy Enterprises, Inc. v. P.K. Sorren Export Co. Inc. of Florida, 546 F. Supp. 987, 996 (S.D. Fla. 1982). Defendants obviously adopted the Plaintiffs' Marks with the intention of reaping the benefits of Plaintiffs' world-famous reputations for making high caliber goods. In fact, many of Defendants' Websites contain open admissions that the goods offered for sale thereon are "replicas." (See, e.g., Comp. Ex. A to the Gaffigan Decl., pp. 53, 79-84; Comp. Ex. C to the Livadkin Decl., pp. 53-55). At a bare minimum, Defendants are acting with willful blindness or with reckless disregard for Plaintiffs' trademark rights. See Chanel, Inc. v. Italian

Activewear of Fla., Inc., 931 F.2d 1472, 1476 (11th Cir. 1991) (accepting willful blindness may provide the requisite intent). Hence, Defendants cannot seriously contend that they did not intend to reap the benefits of Plaintiffs' world-famous reputations for the purpose of defrauding the public.

(6) Evidence of Actual Confusion.

Actual confusion is unnecessary to establish infringement since the test is likelihood of confusion. See Frehling Enters. v. Int'l Select Group, Inc., 192 F.3d 1330, 1340 (11th Cir. 1999). In this case, however, it is reasonable to infer actual confusion exists in the marketplace based upon the circumstantial evidence available. Defendants are advertising, offering to sell, and selling counterfeit goods identical in appearance to those sold by Plaintiffs. (See Livadkin Decl. ¶¶ 5, 6, 8, 9, 14-17 and Exs. A and B thereto; Tanori Decl. ¶¶ 4, 5 and Comp. Exs. A and B thereto; and Defendants' Websites attached as Comp. Ex. A to the Gaffigan Decl and attached as Comp. Ex. C to the Livadkin Decl.) Even if buyers are told of the bogus nature of Defendants' Goods, other consumers viewing Defendants' Goods in a post-sale setting will obviously be confused, because they are viewing goods bearing the Plaintiffs' Marks which undeniably creates the impression they are viewing genuine goods sold or authorized by Plaintiffs. Such post-sale confusion is entirely actionable. See Remcraft Lighting Products, Inc. v. Maxim Lighting, Inc., 706 F. Supp. 855, 859 (S.D. Fla. 1989) ("The likelihood of confusion need not occur at wholesale level when the end user will be confused."); Rolex Watch U.S.A., Inc. v. Forrester, 2 U.S.P.Q.2d 1292, 1986 WL 15668, at *4 (S.D. Fla. Dec. 9, 1986), ("[I]t is clear that the Court need not find actual confusion on the part of the actual purchasers of [defendant's] products. The proper test is "likelihood of confusion," and the likely confusion may be on the part of observers ... or second-hand purchasers.").

The seven factors weigh overwhelmingly in Plaintiffs' favor. Plaintiffs have therefore shown a probability of success on the merits of their trademark counterfeiting claim.

b) Plaintiffs Are Likely to Succeed on their False Designation of Origin Claim.

As with a trademark infringement claim, the test for liability for false designation of origin under Section 43(a) of the Lanham Act, 15 U.S.C. § 1125(a), is also whether the public is likely to be deceived or confused by the similarity of the marks at issue. Two Pesos, Inc. v. Taco Cabana, Inc., 505 U.S. 763, 780, 112 S. Ct. 2753, 120 L.Ed.2d 615 (1992). Whether the violation

is called infringement, unfair competition or false designation of origin, the test is identical -- is there a "likelihood of confusion?" Id. Therefore, because Plaintiffs have established the merits of their trademark counterfeiting and infringement claims against Defendants, a likelihood of success is also shown as to Plaintiffs' second claim for false designation of origin.

c) Pucci is Likely to Succeed on its Cybersquatting Claim

The Anticybersquatting Consumer Protect Act ("ACPA") protects the owner of a distinctive or famous trademark from another's bad faith intent to profit from the trademark owner's mark by registering or using a domain name which is identical or confusingly similar to, or dilutive of, the trademark owner's mark without regard to the goods or services of the parties. 15 U.S.C. § 1125(d). To prevail under 15 U.S.C. § 1125(d), Pucci must prove that (1) its Mark is distinctive or famous and entitled to protection; (2) the Defendants' domain names are identical or confusingly similar to the Pucci Mark; and (3) the Defendants registered or used the domain names with a bad faith intent to profit. Bavaro Palace, S.A. v. Vacation Tours, Inc., 203 Fed.Appx. 252, 256, 2006 WL 2847233, at *3 (11th Cir. 2006). Pucci's evidence submitted herewith satisfies the requirements of 15 U.S.C. § 1125(d).

Defendants have registered multiple domain names, which incorporate the Pucci Mark in its entirety surrounded by descriptive or generic terms, rendering the marks nearly identical as compared to Pucci's trademark. See Victoria's Cyber Secret Ltd. P'ship v. V Secret Catalogue, Inc., 161 F. Supp. 2d 1339, 1351 (S.D. Fla. 2001) ("The taking of an identical copy of another's famous and distinctive trademark for use as a domain name creates a presumption of confusion among Internet users as a matter of law."). See also DaimlerChrysler v. The Net Inc., 388 F.3d 201, 205-06 (6th Cir. 2004) ("[A] domain name that incorporates a trademark is 'confusingly similar to' that mark if 'consumers might think that [the domain name] is used, approved, or permitted' by the mark holder."). Moreover, Courts have found that even slight differences between a domain name and a registered mark, such as the addition of minor or generic words to the disputed domain, is irrelevant. See Ford Motor Co. v. Greatdomains.Com, Inc., 177 F. Supp. 2d 635, 642 (E.D. Mich. 2001) ("unless words or letters added to the plaintiff's mark within the domain name clearly distinguish it from the plaintiff's usage, allegations that a domain name incorporates a protected mark generally will suffice.").

The ACPA lists nine nonexclusive factors for courts to consider in determining whether a domain name has been registered or used in "bad faith." See 15 U.S.C. § 1125(d)(1)(B)(i); see

also Victoria's Cyber Secret Ltd. P'ship, 161 F. Supp. 2d at 1346. The factors are not meant to be exclusive, and the Court may consider all relevant factors in making a determination of bad faith. Id. at 1347. Ultimately, each factor addresses whether “the defendant’s use of the disputed domain name is legitimate – i.e., for some purpose other than simply to profit from the value of the trademark.” Ford Motor Co., 177 F. Supp. 2d at 642. An examination of the bad faith factors compels the conclusion that Defendants’ registration and use of the pirated domain names violates 15 U.S.C. § 1125(d).

The first and third factors, § 1125(d)(1)(B)(I) and (III), are clearly present inasmuch as Defendants have no rights in the Pucci Mark, and Defendants have never used that Mark in connection with a bona fide offering of goods or services. Additionally, the fourth, fifth, and ninth factors, § 1125(d)(1)(B)(IV), (V) and (IX), weigh in favor of Pucci. As discussed above, Defendants have clearly intentionally incorporated the Pucci Mark in their domain names to divert consumers looking for Pucci’s Internet website to their own Internet websites for commercial gain. Such consumers are likely to be confused as to the source and sponsorship of Defendants’ Internet websites and mistakenly believe the websites are endorsed by and/or affiliated with Pucci. This is especially true in light of the fact that Defendants’ Internet websites are offering for sale counterfeit Pucci branded goods. (See Livadkin Decl. ¶¶ 16, 17; and Defendants’ Websites attached as Comp. Ex. A to the Gaffigan Decl and attached as Comp. Ex. C to the Livadkin Decl.)

Clearly, Defendants’ registration of the domain names, in order to sell and offer for sale counterfeit and infringing Pucci branded goods, knowing the domain names were identical or confusingly similar to Pucci’s indisputably famous and distinctive trademark ensures a likelihood of confusion among consumers. See House Judiciary Committee Report on H.R. 3028, H.R. Rep. No. 106-412 p. 13 (October 25, 1999) (“The more distinctive or famous a mark has become, the more likely the owner of that mark is deserving of the relief available under this act.”). Thus, Pucci has shown a likelihood of success on the merits of its cybersquatting claim.

2. Plaintiffs Are Suffering Irreparable Injury.

As the Eleventh Circuit expressed it: “[A] sufficiently strong showing of likelihood of confusion [caused by trademark infringement] may by itself constitute a showing of ... [a] substantial threat of irreparable harm.” Ferrellgas Ptnrs., L.P. v. Barrow, 143 Fed. Appx., 180, 191 (11th Cir. 2005) (citing McDonald’s Corp. v. Robertson, 147 F.3d 1301, 1310 (11th Cir.

1998). Such a finding of irreparable injury following a showing of likelihood of confusion is virtually always made in a case such as this, where Plaintiffs have demonstrated they will lose control of their respective reputations as a result of Defendants' activities. *Id.* A likelihood of confusion exists herein, because Defendants have engaged in counterfeiting activities using spurious designations indistinguishable from the Plaintiffs' Marks. Plaintiffs will suffer irreparable injury to their respective reputations if Defendants are allowed to continue their illegal activities. (Livadkin Decl. ¶ 18.)

3. The Balance of Hardship Tips Sharply in Plaintiffs' Favor.

Plaintiffs have expended substantial time, money and other resources to develop the quality, reputation and goodwill associated with the Plaintiffs' Marks. (Livadkin Decl. ¶¶ 6, 9.) Should Defendants be permitted to continue their trade in counterfeit goods, Plaintiffs will suffer substantial losses and damage to their respective reputations. (See *id.* at ¶ 11.) However, Defendants will suffer no legitimate hardship in the event a temporary restraining order is issued, because Defendants have no legal or equitable right to engage in their present counterfeiting activities.

4. The Relief Sought Serves the Public Interest.

Defendants are engaged in criminal activities and are directly defrauding the consuming public by palming off Defendants' Goods as genuine goods of Plaintiffs. The public has an interest in not being misled as to the origin, source or sponsorship of trademarked products. *Nailtiques Cosmetic Corp. v. Salon Sciences, Corp.*, 1997 WL 244746, 5, 41 U.S.P.Q.2d 1995, 1999 ((S.D. Fla.1997) ("The interests of the public in not being victimized and misled are important considerations in determining the propriety of granting injunctive relief.")).

C. The Equitable Relief Sought is Appropriate.

The Lanham Act authorizes courts to issue injunctive relief "according to principles of equity and upon such terms as the court may deem reasonable, to prevent the violation of any right of the registrant of a mark" 15 U.S.C. § 1116(a).

1. Entry of an Order Immediately Enjoining Defendants' Unauthorized and Unlawful Use of the Plaintiffs' Marks is Appropriate.

Plaintiffs request an order requiring Defendants immediately cease all use of the Plaintiffs' Marks, or substantially similar marks, including on or in connection with all Internet

websites and domain names owned and operated, or controlled by them. Such relief is necessary to stop the ongoing harm to Plaintiffs' trademarks and goodwill and to prevent Defendants from continuing to benefit from the increased traffic to their illegal website operations created by their unlawful use of the Plaintiffs' Marks. Many courts have authorized immediate injunctive relief in cases involving the unauthorized use of trademarks.³

2. Entry of an Order Prohibiting Transfer of the Domain Names During the Pendency of this Action is Appropriate.

To preserve the status quo, Plaintiffs seek an order temporarily modifying control of and prohibiting Defendants from transferring the Subject Domain Names to other parties. Under the operating rules of domain name registrars, defendants involved in domain name litigation easily can, and often will, change the ownership of a domain name and thereby frustrate the court's ability to provide relief to the plaintiff. (Gaffigan Decl. ¶¶ 6-7.) Moreover, defendants can and often do modify website content to thwart discovery and redirect traffic to thwart effective injunctive relief. (Gaffigan Decl. ¶¶ 8-9.) Accordingly, to preserve the status quo and ensure the possibility of eventual effective relief, courts in trademark cases involving domain names regularly grant such relief.⁴ Here, an interim order prohibiting Defendants from transferring the Subject Domain Names poses no burden on them, preserves the status quo, and ensures that this Court, after fully hearing the merits of this action, will be able to afford Plaintiffs full relief.

³ See, e.g., Louis Vuitton Malletier, S.A. v. Chunqiu, Case 0:11-cv-60999-JEM (S.D. Fla. May 17, 2011) (Order granting *Ex Parte* Application for Temporary Restraining Order); Abercrombie & Fitch Trading Co. v. Zhiyong, Case 0:11-cv-60913-JEM (S.D. Fla. May 2, 2011) (same); Acushnet Company v. Hainan, Case No. 1:11-cv-23557-UU (S.D. Fla. Nov. 3, 2011) (same); Gucci America, Inc., v. Zhang, Case No. 1:11-cv-23380-UU (S.D. Fla. Oct. 26, 2011) (Order adopting Magistrate's Report and Recommendation recommending granting of same *supra*); Tiffany (NJ) LLC v. Zheng, Case 11-cv-60171-CMA (S.D. Fla. Feb. 1, 2011) (Order granting *Ex Parte* Application for Temporary Restraining Order); Gucci America, Inc. v. Zhou, Case 1:11-cv-22734-PAS (S.D. Fla. August 18, 2011) (same); Louis Vuitton Malletier, S.A. v. Feng, Case 11-cv-60811-DMM (S.D. Fla. April 25, 2011) (same); Louis Vuitton Malletier, S.A. v. Wang, Case 11-cv-60805-JIC (S.D. Fla. April 22, 2011) (same); Abercrombie & Fitch Trading Co. v. Li, Case 0:11-cv-60340-PCH (S.D. Fla. March 2, 2011) (same); Chanel, Inc. v. Li, Case 0:11-cv-60417-WPD (S.D. Fla. March 3, 2011) (same).

⁴ See, e.g., Louis Vuitton Malletier, S.A. v. Chunqiu, Case 0:11-cv-60999-JEM (S.D. Fla. May 17, 2011) (Order prohibiting Defendants from transferring domain names during pendency or until further Order of the Court); Abercrombie & Fitch Trading Co. v. Zhiyong, Case 0:11-cv-60913-JEM (S.D. Fla. May 2, 2011) (same); Chanel, Inc. v. Zhu, Case 10-cv-62489-JEM (S.D. Fla. Jan. 19, 2011) (same); Acushnet Company v. Hainan, Case No. 1:11-cv-23557-UU (S.D. Fla. Nov. 3, 2011) (same); Gucci America, Inc. v. Zhou, Case 1:11-cv-22734-PAS (S.D. Fla. August 18, 2011) (same); Louis Vuitton Malletier, S.A. v. Feng, Case 11-cv-60811-DMM (S.D. Fla. April 25, 2011) (same); Louis Vuitton Malletier, S.A. v. Wang, Case 11-cv-60805-JIC (S.D. Fla. April 22, 2011) (same); Louis Vuitton Malletier, S.A. v. Li, Case 0:11-cv-60611-WPD (S.D. Fla. March 28, 2011) (same); Abercrombie & Fitch Trading Co. v. Li, Case 0:11-cv-60340-PCH (S.D. Fla. March 2, 2011) (same).

Because the domain name registrars exercise effective control over whether or not domain names can be transferred, the Lanham Act explicitly provides for registrars to deposit domain name certificates with the court, thereby recognizing the court's control over use of the domain names. See 15 U.S.C. § 1114(2)(D); 15 U.S.C. § 1125(d)(2)(C); see also Philip Morris USA, Inc. v. Otamedia Ltd., 331 F. Supp. 2d 228, 230 (S.D.N.Y. 2004) (affirming registrar's decision to deposit certificate with court where registrant used web site to make infringing sales). By this mechanism, the parties, and this Court, are assured that the ownership of the domain names will not change while the action is proceeding. Accordingly, Plaintiffs also seek an interim order requiring the registrars for the Subject Domain Names to deposit domain name certificates.

3. Entry of an Order Modifying Control, Redirecting, and Disabling the Subject Domain Names is Appropriate.

In domain name trademark cases, courts recognize that an interim order redirecting, transferring, disabling, or canceling the offending domain names often may be the only means of affording a plaintiff interim relief that avoids irreparable harm.⁵ Accordingly, in order to gain control of, disable, and redirect the Subject Domain Names, Plaintiffs request the Court enter an order requiring the Registries which maintain the Top Level Domain (“TLD”) Zone files for the Subject Domain Names change the registrar of record for the Subject Domain Names to a holding account with the United States based Registrar GoDaddy.com, Inc., where they will be held in trust for the Court during the pendency of this action and set to automatically redirect to <http://servingnotice.com/lu2/index.html>.⁶ Upon such redirection, a copy of all of the pleadings,

⁵ See e.g., Louis Vuitton Malletier, S.A. v. Chunqiu, Case 0:11-cv-60999-JEM (S.D. Fla. May 17, 2011) (ordering that the top-level domain (TLD) Registries for the domains change the registrar of record to a holding account with the United States based Registrar GoDaddy.com, Inc.; also ordering that the Registrar set the domains to redirect to plaintiff's publication website and thereafter placing domains on lock status, preventing the modification or deletion of the domains by the registrars or the defendants); Abercrombie & Fitch Trading Co. v. Zhiyong, Case 0:11-cv-60913-JEM (S.D. Fla. May 2, 2011) (same); Acushnet Company v. Hainan, Case No. 1:11-cv-23557-UU (S.D. Fla. Nov. 3, 2011) (same); Tiffany (NJ) LLC v. Zheng, Case 11-cv-60171-CMA (S.D. Fla. Feb. 1, 2011) (same); Gucci America, Inc. v. Zhou, Case 1:11-cv-22734-PAS (S.D. Fla. August 18, 2011) (same); Louis Vuitton Malletier, S.A. v. Feng, Case 11-cv-60811-DMM (S.D. Fla. April 25, 2011) (same); Louis Vuitton Malletier, S.A. v. Wang, Case 11-cv-60805-JIC (S.D. Fla. April 22, 2011) (same); Louis Vuitton Malletier, S.A. v. Li, Case 0:11-cv-60611-WPD (S.D. Fla. March 28, 2011) (same); Abercrombie & Fitch Trading Co. v. Li, Case 0:11-cv-60340-PCH (S.D. Fla. March 2, 2011) (same).

⁶ Such relief regarding a change of registrars was granted by this Court in Louis Vuitton Malletier, S.A. v. Chunqiu, Case 0:11-cv-60999-JEM (S.D. Fla. May 17, 2011) and Abercrombie & Fitch Trading Co. v. Zhiyong, Case 0:11-cv-60913-JEM (S.D. Fla. May 2, 2011) and was also recently granted in Acushnet Company v. Hainan, Case No. 1:11-cv-23557-UU (S.D. Fla. Nov. 3, 2011); Gucci America, Inc., v. Zhang, Case No. 1:11-cv-23380-UU (S.D. Fla.

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