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**UNITED STATES DISTRICT COURT  
SOUTHERN DISTRICT OF NEW YORK**

OTTER PRODUCTS, LLC,

Plaintiff,

v.

4PX EXPRESS USA INC.;

Defendant.

CASE NO.

**COMPLAINT**

Plaintiff Otter Products, LLC (“Otter Products”) (“Plaintiff”), through their attorneys complaining of 4PX Express USA Inc. (“Defendant”) hereby alleges as follows:

**STATEMENT OF THE CASE**

1. Plaintiff is the designer and distributor of the highest quality and most recognizable cell phone, and other electronics, protective cases in the world. Unfortunately, great success attracts clandestine companies and individuals unjustly enriching themselves by distributing cheap unauthorized imitation cell phone cases in order to fool unsuspecting consumers and the public.

2. These counterfeit cell phone cases provide little, if any, protection to consumer’s expensive electronics and, therefore, Defendant is not only causing great harm to Plaintiff but to the general public as well.

3. Through its brand protection enforcement efforts, Plaintiff learned of the distribution of a great amount of knock-off cell phone cases being distributed by Defendant.

4. This is not the first time that Defendant have been accused of counterfeiting and trademark infringement concerning their distribution of knock-off merchandise. In fact, according to public records, on July 10, 2018, the Federal Bureau of Investigation had direct knowledge of a Chinese-based affiliated company of Defendant distributing counterfeit Apple products. Despite this knowledge and despite two (2) cease and desist letters and follow up correspondence, Defendant continued to distribute their illegal cell phone cases. Defendant infringement is clearly willful.

5. This action concerns the distribution of large quantities of merchandise bearing counterfeits and infringements of Plaintiff's federally registered trademarks in the United States. Defendant has willfully infringed Plaintiff's valuable trademarks, creating a strong likelihood of confusion among consumers who expect that merchandise bearing Plaintiff's trademarks will be genuine product by Plaintiff, and causing both monetary and other irreparable injury to Plaintiff and the public at large.

6. This is a suit by Plaintiff against Defendant for: (i) counterfeiting and infringement of registered trademarks in violation of Section 32 of the Lanham Act, 15 U.S.C. § 1114; (ii) federal trademark dilution in violation of Section 43(a) of the Lanham Act, 15 U.S.C. § 1125(c); (iii) unfair competition, false designation of origin, and false description in violation of Section 43(a) of the Lanham Act, 15 U.S.C. § 1125(a); ); (iv) unlawful importation of goods bearing registered United States trademarks in violation of Section 526(a) of the Tariff Act, 19 U.S.C. § 1526(a); and (v) unfair and deceptive business practices in violation of N.Y. Gen. Bus. L. § 349.

### **JURISDICTION AND VENUE**

7. This Court has jurisdiction over the federal trademark claims asserted in this action under 15 U.S.C. § 1121, and 28 U.S.C. § 1331 and 28 U.S.C. § 1338. This Court has

supplemental subject matter jurisdiction over state law claims pursuant to 28 U.S. C. § 1367(a) in that the state law claims form part of the same case or controversy as the federal claims.

8. Defendant is subject to the Court’s jurisdiction because they have committed the acts complained of herein in this District and do business in this District. Specifically, Defendant have shipped a large amount of infringing merchandise into this District and specifically into Rockland County, NY and Defendant is registered to do business in New York.

9. Defendant is subject to the jurisdiction of this Court pursuant to and in accordance with Rule 4 of the Federal Rules of Civil Procedure.

10. Venue is proper in this District pursuant to 28 U.S.C. § 1391(b).

### **PARTIES**

11. Otter Products is a limited liability company duly organized and existing under the laws of the State of Colorado and having its principal place of business located at 209 S. Meldrum Street, Fort Collins, CO 80521.

12. Upon information and belief, Defendant is a California company with its principal place of business located at 5600-5650 Grace Place, Commerce, CA 90022. Defendant is registered and authorized to do business in the State of New York.

### **FACTUAL ALLEGATIONS**

#### **A. Plaintiff’s Famous Products and Trademarks**

13. Otter Products began with the entrepreneurial vision of its founder, Curt Richardson. An injection molder by trade, Richardson designed the first “OtterBox” in 1995. The first OtterBox was a durable waterproof box used to keep electronics dry while participating in outdoor sports such as kayaking or fishing. However, through iterative design changes, what started as a waterproof box evolved into a line of functional, durable, and award-winning personal electronics cases. Today, Otter Products’ OtterBox® cases stand as one of the best-

selling brands of mobile phone and tablet cases worldwide, with cases for a broad variety personal electronics.

14. Since its inception, Otter Products has marked their brands' products (OtterBox<sup>®</sup> respectively) with trademarks that have come to symbolize their profound company heritage, entrepreneurial spirit, and superior craftsmanship. This reputation started with the design of the first OtterBox<sup>®</sup> in 1995 and has since expanded into a robust global marketplace. From its prescient inceptions to its products' establishment as household name, Plaintiff has expended great amounts of time, money, and effort advertising and promoting its trademarks globally, including throughout the United States and in this District. As a result of these investments and its widespread success, Plaintiff has developed considerable goodwill and reputations for the highest quality products. Plaintiff has continuously used their trademarks to distinguish their OtterBox<sup>®</sup> products, as well as uphold these reputations.

15. Plaintiff is the owner of various trademarks registered with the United States Patent and Trademark Office ("USPTO"). Such trademarks include, but are not limited to the following, among others:

| Trademark | USPTO<br>Registration<br>Number | Registration<br>Date | Goods  |
|-----------|---------------------------------|----------------------|--|
| OTTERBOX  | 3788534                         | 08/25/2009           | IC 009. US 021<br>023 026 036<br>038. G & S:<br>Protective cases<br>for handheld<br>electronic<br>devices,<br>namely,<br>portable music<br>players,<br>portable video<br>players, cell<br>phones and<br>computers;<br>specially<br>adapted<br>protective<br>carrying cases<br>for computers. |

|                 |         |            |  |
|-----------------|---------|------------|--|
| OTTER BOX       | 3788535 | 05/11/2010 | IC 009. US 021 023 026 036 038. G & S: Protective cases for handheld electronic devices, namely, portable music players, portable video players, cell phones and computers; specially adapted protective carrying cases for computers.                           |
| <b>OTTERBOX</b> | 4602221 | 09/09/2014 | IC 009. US 021 023 026 036 038. G & S: Protective covers and cases for handheld electronic devices, namely, cell phones, portable media players, tablets, personal digital assistants, e-book readers, and computers; protective covers and cases for computers. |
| DEFENDER SERIES | 4616874 | 10/07/2014 | IC 009. US 021 023 026 036 038. G & S: Protective covers and cases for personal electronic devices, namely, cell phones.   |
| DEFENDER SERIES | 3623789 | 05/19/2009 | IC 009. US 021 023 026 036 038. G & S: Protective cases for interactive, handheld electronic devices, namely, portable music players, portable video players and   |

|   |         |            |  |
|---|---------|------------|--|
|   |         |            | tablet computers.  |
|  | 3791318 | 05/18/2010 | IC 009. US 021 023 026 036 038. G & S: Protective cases for handheld electronic devices, namely, portable music players, portable video players, cell phones and computers; specially adapted protective carrying cases for computers.   |
| STRADA SERIES   | 4864518 | 12/1/2015  | IC 009. US 021 023 026 036 038. G & S: Protective cases and covers for personal electronic devices, namely, mobile phones, smartphones, tablets, computers, e-book readers, portable media players; Bags, folios and carrying cases specially adapted for personal electronic devices, namely, mobile phones, smartphones, tablets, computers, e-book readers, portable media players. |

|  |                |                   |  |
|--|----------------|-------------------|--|
| <p>STATEMENT SERIES</p>  | <p>4952893</p> | <p>05/03/2016</p> | <p>IC 009. US 021 023 026 036 038. G &amp; S: Protective cases, covers, bags, and carrying cases for personal electronic devices, namely, mobile phones, smartphones, tablet computers, and e-book readers</p>   |
| <p style="text-align: center;">  </p> | <p>5356304</p> | <p>12/12/2017</p> | <p>IC 009. US 021 023 026 036 038. G &amp; S: Protective cases and covers for mobile electronic devices, namely, smartphones, tablet computers; protective cases and covers adapted to accommodate external accessories for use with mobile electronic devices, namely, smartphones, tablet computers; accessories specially adapted for use with protective cases and covers for smartphones, tablet computers, namely, batteries and power management systems in the nature of external batteries, battery boxes and battery chargers.</p> |

|                     |         |            |   |
|---------------------|---------|------------|---|
| DEFENDER SERIES PRO | 5726083 | 04/16/2019 | IC 009. US 021 023 026 036 038. G & S: Protective cases, carrying cases, casings, and covers for portable electronic devices, namely, cell phones, tablet computers, cases and holsters specially adapted for holding or carrying mobile electronic devices, namely, mobile phones, tablet computers. |
| TRACTION SERIES     | 5910713 | 11/12/2019 | IC 009. US 021 023 026 036 038. G & S: Protective cases and covers for personal electronic devices, namely, mobile phones, smartphones, and tablet computers.   |
| VUE SERIES          | 5727921 | 04/16/2019 | IC 009. US 021 023 026 036 038. G & S: Protective cases, covers, bags, and carrying cases for personal electronic devices, namely, mobile phones, smartphones, tablet computers, and e-book readers.  |

|                          |         |            |  |
|--------------------------|---------|------------|--|
| FIGURA SERIES            | 5765856 | 05/28/2019 | IC 009. US 021 023 026 036 038. G & S: Protective cases, covers, bags, and carrying cases for personal electronic devices, namely, mobile phones, smartphones, tablet computers, and e-book readers. |
| STATEMENT SERIES MODERNE | 5765857 | 05/28/2019 | IC 009. US 021 023 026 036 038. G & S: Protective cases, covers, bags, and carrying cases for personal electronic devices, namely, mobile phones, smartphones, tablet computers, and e-book readers. |
| LUMEN SERIES             | 6073954 | 06/09/2020 | IC 009. US 021 023 026 036 038. G & S: Protective covers and cases for handheld electronic devices, namely, cell phones, smartphones and personal digital assistants.                                |
| OTTERBOX                 | 6077573 | 06/16/2020 | IC 009. US 021 023 026 036 038. G & S: Protective display screen covers for tablet computers, smart phones and electronic reading devices; Stands, mounts, covers                                    |

|             |         |            |   |
|-------------|---------|------------|---|
|             |         |            | and cases specifically adapted for electronic devices, namely, speakers, microphones, smart speakers, display screens, and smart displays; Protective cases for laptop computer, tablet computers, and accessories for laptop and tablet computers, namely, keyboards and speakers. |
| WAKE        | 6126479 | 08/11/2020 | IC 009. US 021 023 026 036 038. G & S: Protective cases and covers for mobile electronic devices, namely, smartphones, tablet computers, electronic reading devices and mobile electronic devices.  |
| VIVA SERIES | 6149005 | 09/08/2020 | IC 009. US 021 023 026 036 038. G & S: Protective cases, covers, and carrying cases for personal electronic devices, namely, mobile phones, smartphones, and tablet computers.  |

(hereinafter collectively referred to as the “Plaintiff’s Registered Trademarks ”).

16. The Plaintiff's Registered Trademarks are valid, in full force and effect, protectable and exclusively owned by Plaintiff. Plaintiff have continuously used the Plaintiff's Registered Trademarks during all time periods relevant to Plaintiff's claims. As a result, a select Plaintiff's Registered Trademarks have become incontestable pursuant to 15 U.S.C. § 1065.

17. The Plaintiff's Registered Trademarks have been used regularly in interstate commerce, including within this District, to identify and distinguish Plaintiff's high-quality merchandise including, but not limited to, dirt resistant mobile phone cases, dirt resistant tablet cases, shock resistant mobile phone cases, shock resistant tablet cases, drop resistant mobile phone cases, drop resistant tablet cases, mobile phone accessories, tablet accessories, and other goods.

18. Due to the overwhelming amount of resources exhausted by Plaintiff in order to create, protect, enforce, and promote the Plaintiff's Registered Trademarks, the Plaintiff's Registered Trademarks have achieved secondary meaning as identifiers of high quality merchandise including, but not limited to, dirt resistant mobile phone cases, dirt resistant tablet cases, shock resistant mobile phone cases, shock resistant tablet cases, drop resistant mobile phone cases, drop resistant tablet cases, mobile phone accessories, tablet accessories, and other goods.

19. The Plaintiff's Registered Trademarks are recognized around the world and throughout the United States by consumers as signifying authentic, high-quality OtterBox<sup>®</sup> and products. As such, the Plaintiff's Registered Trademarks qualify as famous marks as the term is used in 15 U.S.C. § 1125(c)(1) and achieved such fame prior to Defendant's conduct that is the subject of this Complaint.

**B. Defendant's Unauthorized Activities**

20. Upon information and belief, Defendant is importing, distributing, and using in interstate commerce merchandise bearing counterfeits and infringements of the Plaintiff's Registered Trademarks (the "Counterfeit Product").

21. Despite having notice of its illegal activities, Defendant continue to distribute a large amount of Counterfeit Product. Defendant is a willful infringer of the Plaintiff's Registered Trademarks causing irreparable harm to Plaintiff and the unsuspecting public who are being defrauded into purchasing such illegal merchandise.

22. Plaintiff regularly monitors the eBay.com ("eBay") marketplace for the sale of Counterfeit Product. As part of these policing efforts, Plaintiff routinely requests the shutdown of listings offering for sale and selling Counterfeit Products; make purchases of Counterfeit Product to obtain information about sellers; and send cease and desist letters to eBay users who are offering for sale and selling Counterfeit Product.

23. On or about March 2020, Plaintiff discovered a suspicious listing on eBay from the eBay seller known under the username "ch732671". Plaintiff's agent made a purchase from the "ch732671" eBay seller of a "OtterBox" cellphone case ("First Purchase").

24. Subsequently, Plaintiff reviewed the First Purchase and confirmed that the First Purchase was not authentic OtterBox merchandise and did, in fact, bear counterfeits and infringements of the Plaintiff's Registered Trademarks.

25. The return address on the First Purchase states: "Shipper Not Seller, 1000 High Street, Perth Amboy, NJ 08861". This is the return address for Defendant.

26. The First Purchase was the discovery of a far-reaching conspiracy to sell and distribute Counterfeit Product that stretches from eBay sellers overseas and being fulfilled by Defendant here in the United States.

27. Defendant is the United States company of a China-based parent and acts as a global logistics fulfillment and transportation company. Upon information and belief, Defendant imports merchandise from overseas and fulfill orders by shipping product when instructed to do so by its customers. Defendant operates storage and shipping facilities across the United States including the aforementioned location in Perth Amboy, NJ and one in Commerce, CA.

28. From March 2020 to January 2021, Plaintiff discovered and made purchases from ten (10) eBay sellers who all used Defendant's services to ship their Counterfeit Product. The additional sellers use similar eBay usernames, photographs for listings, and fraudulent contact information.

29. More concerning, these eBay sellers were distributing thousands of Counterfeit Product and new eBay accounts would keep springing up after the fraudulent ones were exposed and shut down by eBay.

30. Upon information, belief, and investigation, this scheme would operate as follows: 1) individuals overseas would use stolen or fraudulent contact information to open up an eBay account; 2) Defendant would import these individuals' Counterfeit Product into the United States; 3) Defendant would store this Counterfeit Product at its warehouses; and 4) Defendant would ship this Counterfeit Product to unsuspecting purchasers on eBay (the "Conspiracy").

31. This is not the first time that Defendant and/or its parent company has been accused of counterfeiting and trademark infringement in association with a scheme similar to the Conspiracy.

32. In February 2020, in the case United States v. Pavel Babichenko. et al., CR18-258-S-BLW (D.Idaho) Defendants China-based parent company was mentioned in a "Motion

to Dismiss Superseding Indictment for Ethnically Selective Prosecution and Enforcement.” A reported decision claims that in 2018, the FBI had knowledge of Defendant’s parent company’s distribution of counterfeit Apple products but chose to not pursue enforcement of the counterfeit product.

33. On January 27, 2021, Plaintiff’s counsel sent Defendant a cease and desist letter putting them on specific notice of their illegal activities, demanding that they immediately cease the distribution Counterfeit Product, and comply with further demands.

34. Defendant did not respond to the cease and desist letter.

35. Despite this notice, Defendant continued its unauthorized activity concerning Plaintiff’s Registered Trademarks.

36. On February 8, 2021, Plaintiff’s counsel sent another email to Defendant but did not receive a response. Tracking information shows that this email has been opened by Defendant.

37. Despite the cease and desist letter and additional demands by Plaintiff’s counsel for Defendant to cease the infringement, Defendant’s distribution of Counterfeit Product continued.

38. On April 12, 2021, Plaintiff’s counsel sent a third email to Defendant concerning the ongoing sales but did not receive a response. Tracking information shows that this email has been opened by Defendant.

39. Subsequent to January 27, 2021, the date of the cease and desist letter to Defendant, an additional twelve (12) eBay sellers using Defendant’s services shipped Counterfeit Product to agents for Plaintiff.

40. Clearly Defendant took no affirmative action to stop the Distribution of Counterfeit Product.

41. On May 17, 2021, Plaintiff's counsel emailed and mailed another formal letter again demanding that the distribution of Counterfeit Product cease. Tracking information shows that this email has been opened by Defendant.

42. Again, Defendant did not respond to the second cease and desist letter.

43. Despite the two (2) cease and desist letters and additional demands by Plaintiff's counsel for Defendant to cease the infringement, Defendant's distribution of Counterfeit Product continued.

44. Subsequent to May 17, 2021, the date of the second cease and desist letter to Defendant, an additional six (6) eBay sellers using Defendant's services shipped Counterfeit Product to agents for Plaintiff.

45. In total, twenty-eight (28) different purchases have been made of Counterfeit Product that was shipped by Defendant. These cases are just the tip of the iceberg of Defendant's illegal activity as there are thousands of more Counterfeit Product that Defendant has distributed.

46. Defendant, through, the two (2) cease and desist letters and subsequent emails were on full notice that their actions were illegal but continued to infringe the Plaintiff's Registered Trademarks . Defendant's infringement is clearly willful.

47. Defendant's distribution of the Counterfeit Products in the United States constitutes an illegal use in commerce of the Plaintiff's Registered Trademarks in connection with the sale, offering for sale, or distribution of the Counterfeit Products.

48. The Counterfeit Products distributed by Defendant were not manufactured, authorized, or sponsored by Plaintiff. Thus, consumers will be confused and disappointed by the differences between the Counterfeit Products distributed by Defendant and genuine Plaintiff merchandise manufactured and sold by Plaintiff or their affiliates.

49. As a result of Defendant's actions, Plaintiff is losing profits from lost sales of genuine product, is suffering a loss of enormous goodwill created in its Plaintiff's Registered Trademarks, and will continue to suffer such loss if Defendant is allowed to continue its illegal activity.

50. Upon information and belief, Defendant has knowingly and willfully engaged in its illicit activities in direct violation of Plaintiff's rights and/or have shown a blatant disregard for the same. For these reasons, this qualifies as an exceptional case under 15 U.S.C. § 1117(a).

51. Plaintiff has suffered irreparable injury as a direct and proximate result of Defendant's wrongful distribution of the Counterfeit Products.

52. Plaintiff has no adequate remedy at law.

53. Defendant's unlawful acts will undoubtedly persist without judicial intervention. As such, Defendant must be restrained and enjoined from further violating Plaintiff's well-established rights in and to the Plaintiff's Registered Trademarks.

**FIRST CLAIM FOR RELIEF**  
**(Trademark Counterfeiting, 15 U.S.C. § 1114)**

54. Plaintiff hereby realleges and incorporates by reference all prior allegations as set forth in Paragraphs 1 through 53.

55. Defendant has knowingly, intentionally, and without the consent of Plaintiff used in commerce reproductions, counterfeits, and/or copies of the Plaintiff's Registered Trademarks in connection with the importation and distribution of illicit goods covered by USPTO registrations for the Plaintiff's Registered Trademarks . Such use is likely to: cause confusion or mistake or deceive consumers; cause consumers to believe Defendant's illicit merchandise is affiliated with, sponsored by, authorized or approved by, or is otherwise associated with Plaintiff despite the fact that it is not.

56. Defendant's use of the counterfeit marks was willful and done with the knowledge that the marks are counterfeit, and as such, Defendant's acts constitute willful trademark counterfeiting in violation of Section 32 of the Lanham Act, 15 U.S.C. § 1114.

57. Defendant's acts constitute use in commerce of the Plaintiff's Registered Trademarks.

58. Not only are Defendant directly liable for infringement due to importing and distributing its Counterfeit Merchandise but since it had both general and specific notice of such illegal activity but continued to provide its importing and shipping services to the sellers of the Counterfeit Product, Defendant are also contributorily liable for trademark counterfeiting.

59. For the aforementioned reasons, Plaintiff is entitled to: (a) damages for all of Defendant's profits derived from their unlawful conduct and/or Plaintiff's lost profits from sales of genuine goods due to Defendant's conduct, trebled, to the full extent provided under Sections 35(a) and 35(b) of the Lanham Act, 15 U.S.C. § 1117(a)-(b), or alternatively, statutory damages in the amount of up to \$2,000,000 for each mark counterfeited as provided by 15 U.S.C. § 1117(c) of the Lanham Act; and (b) reasonable attorneys' fees, investigative fees, and pre-judgment interest according to 15 U.S.C. § 1117(b).

60. Plaintiff has no adequate remedy at law for Defendant's ongoing wrongful conduct. Plaintiff has been, and absent injunctive relief will continue to be, irreparably harmed by Defendant's actions.

**SECOND CLAIM FOR RELIEF**  
**(Trademark Infringement, 15 U.S.C. §1114)**

61. Plaintiff hereby realleges and incorporates by reference all prior allegations as set forth in Paragraphs 1 through 53.

62. Defendant has knowingly, intentionally, and without the consent of Plaintiff

used in commerce reproductions, counterfeits, and/or copies of the Plaintiff's Registered Trademarks in connection with the importation and distribution of goods covered by USPTO registrations for the Plaintiff's Registered Trademarks . Such use is likely to: cause confusion or mistake or deceive consumers; cause consumers to believe Defendant's illicit merchandise is affiliated with, sponsored by, authorized or approved by, or is otherwise associated with Plaintiff despite the fact that it is not.

63. Defendant's use of the infringing marks was willful and done with the knowledge that the marks are infringing, and as such, Defendant's acts constitute willful trademark infringement in violation of Section 32 of the Lanham Act, 15 U.S.C. § 1114.

64. Defendant's acts constitute use in commerce of the Plaintiff's Registered Trademarks.

65. Not only is Defendant directly liable for infringement due to importing and distributing its Counterfeit Merchandise but since it had both general and specific notice of such illegal activity but continued to provide its importing and shipping services to the sellers of the Counterfeit Product, Defendant is also contributorily liable for trademark infringement.

66. For the aforementioned reasons, Plaintiff is entitled to: (a) damages for all of Defendant's profits derived from their unlawful conduct and/or Plaintiff's lost profits from sales of genuine goods due to Defendant's conduct to the full extent provided under Section 35(a) of the Lanham Act, 15 U.S.C. § 1117(a); and (b) reasonable attorneys' fees, investigative fees, and pre-judgment interest according to 15 U.S.C. § 1117(b).

67. Plaintiff has no adequate remedy at law for Defendant's ongoing wrongful conduct. Plaintiff has been, and absent injunctive relief will continue to be, irreparably harmed by Defendant's actions.

**THIRD CLAIM FOR RELIEF**  
**(Unfair Competition, False Designation of Origin & False Description,**  
**15 U.S.C. §1125(a))**

68. Plaintiff hereby realleges and incorporates by reference all prior allegations as set forth in Paragraphs 1 through 53.

69. Defendant's importation and distribution of goods bearing the Plaintiff's Registered Trademarks constitutes use in commerce of false designations of origin and false and misleading descriptions and representations that Defendant's illicit merchandise is affiliated with, sponsored by, authorized or approved by, or is otherwise associated with Plaintiff despite the fact that it is not. As a result of Defendant's unauthorized use of the Plaintiff's Registered Trademarks, the public is likely to be misled and confused as to the source, sponsorship, or affiliation of Defendant's counterfeit merchandise.

70. Defendant's sale, offering for sale, distribution, or advertising of goods bearing the Plaintiff's Registered Trademarks constitutes unfair competition as it is intended to cause confusion and deceive consumers and trades upon the established reputation and goodwill of Plaintiff.

71. Defendant's conduct is willful, intended to reap the benefit of Plaintiff's established goodwill, and violates Section 43(a) of the Lanham Act, 15 U.S.C. § 1125(a), all to the severe detriment of Plaintiff.

72. Defendant's acts entitle Plaintiff to damages for all of Defendant's profits derived from their past unlawful conduct and/or for all of Plaintiff's lost profits from lost sales of genuine goods due to Defendant's conduct, trebled, to the full extent provided under Sections 35(a) and 35(b) of the Lanham Act, 15 U.S.C. §1117(a)-(b), or in the alternative to statutory damages under Section 35(c) of the Lanham Act, 15 U.S.C. §1117(c).

73. Plaintiff has no adequate remedy at law for Defendant's ongoing wrongful conduct. Plaintiff has been, and absent injunctive relief will continue to be, irreparably harmed by Defendant's actions.

**FOURTH CLAIM FOR RELIEF**  
**(Federal Trademark Dilution, 15 U.S.C. § 1125(c))**

74. Plaintiff hereby reallege and incorporate by reference all prior allegations as set forth in Paragraphs 1 through 53.

75. Defendant's use of the Plaintiff's Registered Trademarks or marks confusingly similar thereto in order to sell their products constitutes Defendant's commercial use in commerce of the Plaintiff's Registered Trademarks.

76. The Plaintiff's Registered Trademarks are world famous and distinctive. They achieved such status long prior to Defendant's activities complained of herein.

77. Defendant's use of the Plaintiff's Registered Trademarks constitutes tarnishment of the Plaintiff's Registered Trademarks.

78. Plaintiff is suffering and will continue to suffer irreparable harm from Defendant's dilutive activities.

79. Defendant's acts as aforesaid are diluting the distinctive quality of the Plaintiff's Registered Trademarks in violation of Section 43(c) of the Lanham Act, 15 U.S.C. § 1125(c).

80. Defendant has intentionally and willfully appropriated the Plaintiff's Registered Trademarks and traded on Plaintiff's reputation.

81. Defendant's wrongful acts of dilution will continue unless enjoined by this Court.

**FIFTH CLAIM FOR RELIEF**  
**(Unlawful Importation of Goods Bearing Registered United States Trademarks in Violation of Section 526(a) of the Tariff Act, 19 U.S.C. § 1526(a))**

82. Plaintiff hereby re-alleges and incorporates by reference all prior allegations as set forth in Paragraphs 1 through 53.

83. Defendant's acts alleged herein constitute the importation of merchandise which bears imitations of the Plaintiff's Registered Trademarks without Plaintiff's consent, in violation of Section 526(a) of the Tariff Act, 19 U.S.C. § 1526(a).

84. Defendant's use of the infringing marks was willful, intentional, and done with the knowledge that the marks are counterfeit marks, as defined in Section 34(d) of the Lanham Act, 15 U.S.C. § 1116(d).

85. Defendant's acts entitle Plaintiff to damages for all of Defendant's profits derived from their past unlawful conduct and/or for all of Plaintiff's lost profits from lost sales of genuine goods due to Defendant's conduct, trebled, to the full extent provided under Sections 35(a) and 35(b) of the Lanham Act, 15 U.S.C. § 1117(a)-(b), or in the alternative to statutory damages under Section 35(c) of the Lanham Act, 15 U.S.C. § 1117(c).

86. Plaintiff has no adequate remedy at law for Defendant's ongoing wrongful conduct. Plaintiff has been, and absent injunctive relief will continue to be, irreparably harmed by Defendant's actions.

**SIXTH CLAIM FOR RELIEF**  
**(Unfair and Deceptive Business Practices, N.Y. Gen. Bus. L. § 349)**

87. Plaintiff hereby realleges and incorporates by reference all prior allegations as set forth in Paragraphs 1 through 53.

88. The wrongful conduct of Defendant, including but not limited to, the distribution of Counterfeit Products constitutes materially misleading and deceptive trade practices under New York General Business Law § 349.

89. This wrongful conduct was consumer-oriented within the meaning of Section

349, as it is the intent of Defendant to distribute Counterfeit Product into the marketplace and therefore harm the general consuming public.

90. Because of this deceptive conduct, Plaintiff has been and will continue to be damaged both monetarily and in ways impossible to remedy through monetary judgment.

**PRAYER FOR RELIEF**

**WHEREFORE**, Plaintiff respectfully request that the Court order the following relief:

I. That the Court enter an injunction ordering that Defendant, their agents, servants, employees, and all other persons in privity or acting in concert with them be enjoined and restrained from:

- a) using any counterfeit or infringement of the Plaintiff's Registered Trademarks to identify any goods not authorized by Plaintiff;
- b) counterfeiting or infringing the Plaintiff's Registered Trademarks by importing, manufacturing, distributing, selling, offering for sale, advertising, promoting, displaying any products bearing any simulation, reproduction, counterfeit, or copy of the Plaintiff's Registered Trademarks ;
- c) using any simulation, reproduction, counterfeit, or copy of the Plaintiff's Registered Trademarks in connection with the importation, promotion, advertisement, display, sale, offering for sale, manufacture, production, circulation or distribution of any unauthorized products in such fashion as to relate or connect, or tend to relate or connect, such products in any way to Plaintiff, or to any goods sold, manufactured, sponsored or approved by, or connected with Plaintiff,
- d) making any statement or representation whatsoever, or using any false designation of origin or false description, or performing any act, which can or is likely to lead the trade or public, or individual members thereof, to believe that any services provided, products manufactured, distributed, sold or offered for sale, or rented by Defendant are in any way associated or connected with Plaintiff;
- e) engaging in any other conduct constituting an infringement of the Plaintiff's Registered Trademarks , of Plaintiff's rights in, or to use or to exploit, said trademark, or constituting any weakening of Plaintiff's names, reputations, and goodwill.

II. That Defendant be required to deliver to Plaintiff for destruction all unauthorized materials bearing any of the Plaintiff's Registered Trademarks in association with unauthorized

goods and the means for production of same pursuant to 15 U.S.C. § 1118.

III. Requiring Defendant to pay to Plaintiff such damages for all of Defendant's profits derived from their unlawful conduct and/or Plaintiff's lost profits from sales of genuine goods due to Defendant's infringement, counterfeiting, false designation of origin, unfair competition trebled to the full extent provided under Sections 35(a) and 35(b) of the Lanham Act, 15 U.S.C. § 1117(a)-(b), or alternatively, statutory damages in the amount of up to \$2,000,000 for each mark counterfeited as provided by 15 U.S.C. § 1117(c) of the Lanham Act.

IV. Ordering that Defendant compensate Plaintiff for the costs of this action, reasonable attorneys' fees, investigative fees, and pre-judgment interest according to 15 U.S.C. § 1117(b).

V. Plaintiff be awarded their actual damages and attorneys' fees pursuant to N.Y. Gen. Bus. L. § 349.

VI. Defendant be required to pay pre-judgment interest on all damages and profits awards.

VII. Directing that this Court retain jurisdiction of this action for the purpose of enabling Plaintiff to apply to the Court at any time for such further orders and interpretation or execution of any Order entered in this action, for the modification of any such Order, for the enforcement or compliance therewith and for the punishment of any violations thereof.

VIII. Ordering that pursuant to 11 U.S.C. § 523(a)(6), Defendant be prohibited from a discharge under 11 U.S.C. § 727 for malicious, willful, and fraudulent injury to Plaintiff.

IX. Awarding to Plaintiff such other and further relief as the Court may deem just and proper, together with the costs and disbursements that Plaintiff have incurred in connection with this action.

**LEE LAW PLLC**

Dated: May 25, 2021



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