

UNITED STATES DISTRICT COURT
SOUTHERN DISTRICT OF NEW YORK

<p>LVL XIII BRANDS, INC., <i>a New York corporation,</i></p> <p><i>Plaintiff,</i></p> <p>– vs. –</p> <p>LOUIS VUITTON MALLETIER SA, and LOUIS VUITTON NORTH AMERICA INC.,</p> <p><i>Defendants.</i></p>	<p>DOCKET NO. 14-cv-04869 (PAE)</p> <p>REDACTED - TO COMPLY WITH COURT ORDER</p>
<p>LOUIS VUITTON MALLETIER SA, and LOUIS VUITTON NORTH AMERICA INC.,</p> <p><i>Counterclaimants,</i></p> <p>– vs. –</p> <p>LVL XIII BRANDS, INC., <i>a New York corporation,</i></p> <p><i>Counterclaim Defendant.</i></p>	

**MEMORANDUM OF LAW IN SUPPORT OF LVL XIII BRANDS,
INC.’S MOTION FOR SUMMARY JUDGMENT AND IN OPPOSITION
TO DEFENDANTS’ MOTION FOR SUMMARY JUDGMENT**

Ronald D. Coleman (RC 3875)
Joel G. MacMull (JM 8239)
ARCHER & GREINER, P.C.
44 Wall Street, Suite 1285
New York, New York 10005
rcoleman@archerlaw.com
jmacmull@archerlaw.com
*Attorneys for Plaintiff / Counterclaimant
LVL XIII Brands, Inc.*

TABLE OF CONTENTS

	Page
TABLE OF AUTHORITIES	iv
PRELIMINARY STATEMENT	1
STATEMENT OF FACTS	3
ARGUMENT	9
I. SUMMARY JUDGMENT STANDARD.....	9
II. LVL XIII’S METAL TOE PLATE IS PROTECTABLE AS A SOURCE INDICATOR FOR ITS LINE OF LUXURY ATHLETIC FOOTWEAR.	10
A. LVL XIII’s Metal Toe Plate is an inherently distinctive trademark.	10
B. Alternatively, LVL XIII’s Metal Toe Plate is protectable as product packaging trade dress.....	13
1. Trade dress is protected as either “product packaging” or “product design.”	14
a. If the LVL XIII Toe Plate is trade dress, it is inherently distinctive.....	15
b. LVL XIII’s product packaging trade dress is non- functional.	17
C. LVL XIII’s trade dress is protectable as product design.	18
1. New York law does not require a showing of secondary meaning.....	18
2. The factual record readily demonstrates the secondary meaning in the Metal Toe Plate.	20
D. Louis Vuitton’s examples of third-party use are irrelevant or unsubstantiated.....	25
III. LOUIS VUITTON’S USE OF A METAL TOE PLATE ON ITS ON THE ROAD SNEAKER THAT IS SUBSTANTIALLY SIMILAR TO THE LVL XIII METAL TOE PLATE WAS AND IS LIKELY TO CAUSE CONFUSION.....	27
A. LVL XIII’s Metal Toe Plate Mark is strong, inherently distinctive and deserving of protection against directly competing goods.....	27
B. The parties’ marks are virtually identical for purposes of trademark law.....	28
C. The goods in association with which the marks are used are identical.....	29
D. There is no “gap” between the two markets to be bridged.	30

TABLE OF CONTENTS

(continued)

	Page
E. There is substantial proof of actual confusion and resulting harm.	30
F. Defendants’ actions give rise to an inference of bad faith.....	32
G. Defendants’ OTR Sneaker is of inferior quality, causing harm to LVL XIII.....	34
H. The Relative sophistication of buyers increases a likelihood of confusion.....	34
IV. LVL XIII IS ENTITLED TO SUMMARY JUDGMENT ON ITS FEDERAL UNFAIR COMPETITION CLAIMS.	35
V. LVL XIII IS ENTITLED TO SUMMARY JUDGMENT ON ITS STATE LAW CLAIMS AS A MATTER OF LAW.....	36
VI. LVL XIII IS ENTITLED TO A PERMANENT INJUNCTION AND DAMAGES.....	38
A. Louis Vuitton should be permanently enjoined from selling footwear bearing the LVL XIII Metal Toe Plate.	38
B. LVL XIII is Entitled to Actual Damages.....	38
C. LVL XIII is Entitled to Punitive Damages.	39
VII. LVL XIII IS ENTITLED TO SUMMARY JUDGMENT DISMISSING EACH OF DEFENDANTS’ COUNTERCLAIMS.....	39
A. Defendants’ claims are barred by the affirmative defenses of laches and acquiescence.....	40
VIII. PLAINTIFF IS ENTITLED TO SUMMARY JUDGMENT ON DEFENDANTS’ CLAIM FOR DECLARATORY RELIEF.....	45
IX. PLAINTIFF IS ENTITLED TO SUMMARY JUDGMENT ON LOUIS VUITTON’S CLAIM FOR A MANDATORY INJUNCTION.....	46
X. PLAINTIFF IS ENTITLED TO SUMMARY JUDGMENT ON LOUIS VUITTON’S FEDERAL TRADEMARK INFRINGEMENT CLAIM.....	51
A. Louis Vuitton cannot establish a likelihood of confusion between the parties’ marks.....	51
1. The parties’ marks are dissimilar.....	51
2. The strength of the LV Initials Logo Marks are seriously diminished by extensive third-party use.	52
3. Despite Louis Vuitton’s allegations of the existence of actual confusion, there is no record evidence of actual confusion.....	53

TABLE OF CONTENTS
(continued)

	Page
XI. PLAINTIFF IS ENTITLED TO SUMMARY JUDGMENT ON LOUIS VUITTON’S FEDERAL FALSE DESIGNATION OF ORIGIN AND UNFAIR COMPETITION CLAIM.....	54
XII. PLAINTIFF IS ENTITLED TO SUMMARY JUDGMENT ON LOUIS VUITTON’S STATE LAW CLAIM.....	54
CONCLUSION.....	55

TABLE OF AUTHORITIES

	Page(s)
Federal Cases	
<i>A&H Sportswear Co., Inc. v. Victoria’s Secret Stores, Inc.</i> , 926 F. Supp. 1233 (E.D. Pa. 1996), <i>aff’d</i> , 166 F.3d 191 (3d Cir. 1999).....	43
<i>Abercrombie & Fitch v. Hunting World, Inc.</i> , 537 F.2d 4 (2d Cir. 1976)	11, 16
<i>Adidas-Salomon Ag v. Target Corp.</i> , 228 F. Supp. 2d 1192 (D. Or. 2002)	28
<i>Allens Creek/Corbetts Glen Preservation Group, Inc. v. Caldera</i> , 88 F.Supp.2d 77 (W.D.N.Y. 2000).....	42
<i>American Home Prods. Corp. v. Johnson Chem. Co.</i> , 589 F.2d 103 (2d Cir. 1978).....	43
<i>Amini Innovation Corp. v. McFerran Home Furnishings, Inc.</i> , 68 F. Supp. 3d 1170, 1174 (C.D. Cal. 2014)	22
<i>Arista Records LLC v. Usenet.com., Inc.</i> , 2008 U.S. Dist. LEXIS 95514 (S.D.N.Y. Nov. 24, 2008).....	45
<i>Aromatique Inc. v. Gold Seal, Inc.</i> , 28 F.3d 863 (8th Cir. 1994)	10
<i>Bear U.S.A. v. Kim</i> , 71 F. Supp. 2d 237 (S.D.N.Y. 1999).....	26
<i>Best Cellars, Inc. v. Grape Finds at Dupont, Inc.</i> , 90 F. Supp. 2d 431 (S.D.N.Y. 2000).....	17, 30
<i>Blisscraft of Hollywood v. United Plastics Co.</i> , 294 F.2d 694 (2d Cir. 1961).....	11
<i>Bruce Lee Enters., LLC v. A.V.E.L.A., Inc.</i> , 2013 U.S. Dist. LEXIS 31155 (S.D.N.Y. Mar. 6, 2013)	36
<i>Burberry Ltd. v. Designers Imps., Inc.</i> , 2010 U.S. Dist. LEXIS 3605 (S.D.N.Y. Jan. 19, 2010)	37
<i>C-Cure Chem. Co. v. Secure Adhesives Corp.</i> , 571 F. Supp. 808 (W.D.N.Y. 1983).....	49

<i>Cadbury Beverages, Inc. v. Cott Corp.</i> , 73 F.3d 474 (2d Cir. 1996).....	29
<i>Calvin Klein Jeanswear Co. v. Tunnel Trading</i> , 2001 U.S. Dist. LEXIS 18738 (S.D.N.Y. Nov. 16, 2001).....	36
<i>Cartier, Inc. v. Four Star Jewelry Creations, Inc.</i> , 348 F. Supp. 2d 217 (S.D.N.Y. 2004).....	18, 19
<i>Cartier Int’l B. V. v. Ben-Menachem</i> , No. 06 Civ. 3917, 2007 U.S. Dist. LEXIS 95366 (S.D.N.Y. Jan. 3, 2008).....	35
<i>Cartier v. Aaron Faber, Inc.</i> , 512 F. Supp. 2d 165 (S.D.N.Y. 2007).....	38
<i>Celotex Corp. v. Catrett</i> , 477 U.S. 317 (1986).....	10
<i>Centaur Communs. Ltd. v. A/S/M Communs., Inc.</i> , 652 F. Supp. 1105 (S.D.N.Y. 1987).....	23
<i>Centaur Communs., Ltd. v. A/S/M Communs., Inc.</i> , 830 F.2d 1217 (2d Cir. 1987).....	21, 24, 33
<i>Chandon Champagne Corp. v. San Marino Wine Corp.</i> , 335 F.2d 531 (2d Cir. 1964).....	11
<i>Christian Louboutin S.A. v. Yves Saint Laurent Am.Holding, Inc.</i> , 696 F.3d 206 (2d Cir. 2012).....	20
<i>CJ Prods. LLC v Snuggly Plushez LLC</i> , 809 F. Supp. 2d 127 (E.D.N.Y. 2011)	35
<i>Coach Leatherware Co. v. Ann Taylor, Inc.</i> , 933 F.2d 162 (2d Cir. 1991).....	36, 53
<i>The Comic Strip, Inc. v. Fox Television Stations, Inc.</i> , 710 F. Supp. 976 (S.D.N.Y. 1989).....	41
<i>Conopco, Inc. v. Campbell Soup Co.</i> , 95 F.3d 187 (2d Cir. 1996).....	40, 43
<i>Constellation Brands, Inc. v. Arbor Hill Assocs.</i> , 535 F. Supp. 2d 347 (W.D.N.Y. 2008).....	12
<i>Country Floors, Inc. v. A. P’ship Composed of Cheryl Mizak & Alan Mizak</i> , 1993 U.S. Dist. LEXIS 20213 (D. Conn. June 10, 1993).....	12

<i>Dallas Cowboys Cheerleaders, Inc. v. Pussycat Cinema, Ltd.</i> , 604 F.2d 200 (2d Cir. 1979).....	12
<i>Dana Braun, Inc. v. SML Sport Ltd.</i> , 2003 U.S. Dist. LEXIS 21349 (S.D.N.Y. Nov. 24, 2003).....	52, 53
<i>In re Dayan</i> , 61 Fed. App'x. 695 (Fed. Cir. 2003).....	46
<i>De Beers</i> , 2005 U.S. Dist. LEXIS 9307.....	36
<i>De Beers LV Trademark Ltd. v. DeBeers Diamond Syndicate Inc.</i> , 440 F. Supp. 2d 249 (S.D.N.Y. 2006).....	27, 32
<i>Dena Corp. v. Belvedere Inter., Inc.</i> , 950 F.2d 1555 (Fed. Cir. 1991).....	49
<i>In re Dial-A-Mattress Operating Corp.</i> , 240 F.3d 1341 (Fed. Cir. 2001).....	46
<i>DiCola v. SwissRe Holding (N. Am.), Inc.</i> , 996 F.2d 30 (2d Cir. 1993).....	27
<i>Dow Jones & Co.v. Harrods Ltd.</i> , 346 F.3d 357 (2nd Cir. 2003).....	45
<i>Driving Force, Inc. v. Manpower, Inc.</i> , 498 F. Supp. 21 (E.D. Pa. 1980).....	49
<i>Dunn Computer Corp. v. Loudcloud, Inc.</i> , 133 F. Supp. 2d 823 (E.D. Va. 2001).....	47
<i>E.G.L. Gem Lab Ltd. v. Gem Quality Institute, Inc.</i> , 90 F. Supp. 2d 277 (S.D.N.Y. 2000).....	54
<i>In re Ebs Data Processing, Inc.</i> , 212 U.S.P.Q. 964 (T.T.A.B. 1981).....	49
<i>Ellis v. Tribune Television Co.</i> , 443 F.3d 71 (2d Cir. 2006).....	48, 50, 51
<i>Estee Lauder Inc. v. The Gap, Inc.</i> , 108 F.3d 1503 (2d Cir.1997).....	27, 53
<i>F.D.I.C. v. Giammettei</i> , 34 F.3d 51 (2d Cir. 1994).....	27
<i>Fendi Adele S.R.L. v. Burlington Coat Factory Warehouse Corp.</i> , 642 F. Supp. 2d 276 (S.D.N.Y. 2009).....	38

<i>Franklin Res., Inc. v. Franklin Credit Mgmt. Corp.</i> , 988 F. Supp 322 (S.D.N.Y. 1997).....	53
<i>Fruit-Ices Corp. v. Coolbrands Int’l, Inc.</i> , 335 F. Supp. 2d 412 (S.D.N.Y. 2004).....	18
<i>Fun-Damental Too, Ltd.</i> , 111 F.3d 993 (2d Cir. 1997)	17
<i>Genesee Brewing Co., v. Stroh Brewing Co.</i> , 124 F.3d 137 (2d Cir. 1997).....	17, 20
<i>GMA Accessories, Inc. v. Idea Nuova, Inc.</i> , 157 F. Supp. 2d 234 (S.D.N.Y. 2000).....	47
<i>GTFM, Inc. v. Solid Clothing, Inc.</i> , 215 F. Supp. 2d 273 (S.D.N.Y. 2002).....	25, 37
<i>Gucci Am., Inc. v. Duty Free Apparel, Ltd.</i> , 286 F. Supp. 2d 284 (S.D.N.Y. 2003).....	38
<i>H.W. Carter & Sons, Inc. v. William Carter Co.</i> , 913 F. Supp. 796 (S.D.N.Y. 1996).....	43
<i>Hot Wax, Inc. v. Turtle Wax,</i> Inc. 191 F.3d 813 (7th Cir. 1999)	40
<i>Ideal Steel Supply Corp. v. Anza</i> , 652F.3d 310, 326 (2d Cir. 2011).....	33
<i>Ikelionwu v. U.S.</i> , 150 F.3d 233 (2d Cir. 1998).....	40
<i>Inc. Publ’g Corp. v. Manhattan Magazine, Inc.</i> , 616 F. Supp. 370 (S.D.N.Y. 1985), <i>aff’d without op.</i> , 788 F.2d. 3 (2d Cir. 1986)	41
<i>Indianapolis Colts Inc. v. Metropolitan Baltimore Football Club L.P.</i> , 34 F.3d 410 (7th Cir. 1994)	25
<i>Jahr USA Publishing v. Meredith Corp.</i> , 991 F.2d 1072 (2d Cir. 1993).....	11, 52
<i>Jeffrey Milstein, Inc. v. Greger, Lawlor, Roth, Inc.</i> , 58 F.3d 27 (2d Cir. 1995)	15
<i>Jewish Sephardic Yellow Pages, Ltd. v. DAG Media, Inc.</i> , 478 F. Supp. 2d 340 (E.D.N.Y. 2006)	14

<i>Johnson v. Nayack Hosp.</i> , 86 F.3d 8 (2d Cir. 1996).....	48
<i>Kraft Foods Group Brands LLC v. Cracker Barrel Old Country Store, Inc.</i> , 735 F.3d 735 (7th Cir. 2013)	25
<i>L.A. Gear, Inc. v. Thorn MeAn Shoe Co.</i> , 988 F.2d 1117 (Fed. Cir. 1993).....	24, 25
<i>L’Oreal USA, Inc. v. Trend Beauty Corp.</i> , 2013 U.S. Dist. LEXIS 115795 (S.D.N.Y. Aug. 15, 2013).....	17
<i>Lane Capital Mgmt. v. Lane Capital Mgmt.</i> , 15 F. Supp. 2d 389 (S.D.N.Y. 1998).....	12, 35
<i>Laureyssens v. Idea Group, Inc.</i> , 964 F.2d 131 (2d Cir. 1992).....	18
<i>Lois Sportswear, U.S.A., Inc. v. Levi Strauss & Co.</i> , 799 F.2d 867 (2d Cir. 1986).....	29, 34, 36, 54
<i>Lopez v. Gap, Inc.</i> , 883 F. Supp. 2d 400 (S.D.N.Y. 2012).....	20
<i>Louis Vuitton Malletier v. Burlington Coat Factory Warehouse Corp.</i> , 426 F.3d 532 (2d Cir. 2005).....	28
<i>Louis Vuitton Malletier v. Dooney & Bourke, Inc.</i> , 454 F.3d 108 (2d Cir. 2006).....	20
<i>Mana Prods. v. Columbia Cosmetics Mfg.</i> , 65 F.3d 1063 (2d Cir. 1995).....	17
<i>Maternally Yours v. Your Maternity Shop</i> , 234 F.2d 538 (2d Cir. 1956).....	24
<i>Maverick Recording Co. v. Chowdhury</i> , 2008 U.S. Dist. LEXIS 63783 (E.D.N.Y. Aug. 19, 2008).....	46
<i>Morningside Group, Ltd. v. Morningside Capital Group, L.L.C.</i> , 182 F.3d 133 (2d Cir. 1999).....	29, 30, 34
<i>Mortellito v. Nina of California, Inc.</i> , 335 F. Supp. 1288 (S.D.N.Y. 1972).....	23
<i>Murphy Door Bed Co. v. Interior Sleep Systems, Inc.</i> , 874 F.2d 95 (2d Cir. 1989).....	39

Nabisco v. Warner-Lambert Co.,
32 F. Supp. 2d 690 (S.D.N.Y. 1999).....9

New Colt Holding Corp. v. RJG Holdings of Fla., Inc.,
312 F. Supp. 2d 195 (D. Conn. 2004).....26

Nina Ricci, S.A.R.L. v. Gemcraft Ltd.,
612 F. Supp. 1520 (S.D.N.Y. 1985).....42

Nora Beverages, Inc. v. Perrier Grp. of Am., Inc.,
269 F.3d 114 (2d Cir. 2001).....14, 15

Paddington Corp. v. Attiki Imps. & Distributions,
996 F.2d 577 (2d Cir. 1993).....11, 17

Pelman v. McDonald’s Corp.,
396 F. Supp. 2d 439 (S.D.N.Y. 2005).....37

Perfect Fit Indus., Inc., 618 F.2d at 95336

Perfect Pearl Co. v. Majestic Pearl & Stone, Inc.,
887 F. Supp. 2d 519 (S.D.N.Y. 2012).....13

Playboy Enters. v. Chuckleberry Publ’g, Inc.,
511 F. Supp. 486 (S.D.N.Y. 1981).....30

Playtex Prods., Inc. v. Georgia-Pacific Corp.,
390 F.3d 158 (2d Cir. 2004).....10

Polaroid Corp. v. Polarad Elecs., Corp.,
287 F.2d 492 (2d Cir. 1961).....27, 35, 51

Polo Fashions, Inc. v. Extra Special Products, Inc.,
451 F. Supp. 555 (S.D.N.Y. 1978).....12

President & Trs. of Colby Coll., 508 F.2d 804 (1st Cir. 1975).....22

*Profitness Physical Therapy Center v. Pro-Fit Orthopedic and Sports Physical
Therapy P.C.*,
314 F.3d 62 (2d Cir. 2002).....44, 45

Qualitex Co. v. Jacobson Products Co.,
514 U.S. 159 (1995).....16, 18

Redken Labs., Inc. v. Clairol, Inc.,
501 F.2d 1403 (9th Cir. 1974)43

Robins Island Preservation Fund, Inc. v. Southold Dev. Corp.,
959 F.2d 409 (2d Cir. 1992), *cert. denied*, 506 U.S. 1001 (1992).....40

Romag Fasteners, Inc. v. Fossil, Inc.,
29 F. Supp. 3d 85, 102 (D. Conn. 2014).....42

Scarves By Vera, Inc. v. Todo Imports Ltd.,
544 F.2d 1167 (2d Cir. 1976).....26

Schieffelin & Co. v. Jack Co. of Boca, Inc.,
850 F. Supp. 232 (S.D.N.Y. 1994).....30

Securitron Magnalock Corp. v. Schnabolk,
65 F.3d 256 (2d Cir. 1995).....37

In re Slokevage,
441 F.3d 957 (Fed. Cir. 2006).....12, 13, 15

The Sports Auth., Inc. v. Prime Hospitality Corp.,
89 F.3d 955 (2d Cir. 1996).....52

Spraying Sys. Co. v. Delavan, Inc.,
975 F.2d 387 (7th Cir. 1992)53

Starbucks Corp. v. Wolfe’s Borough Coffee, Inc.,
2004 U.S. Dist. LEXIS 19239 (S.D.N.Y. Sept. 28, 2004).....54

Sterling Drug, Inc. v. Bayer AG,
792 F. Supp. 1357 (S.D.N.Y. 1992), *vacated in part on other grounds*, 14
F.3d 733 (2d Cir. 1994).....53

Strange Music, Inc. v. Strange Music, Inc.,
326 F. Supp. 2d 481 (S.D.N.Y. 2004).....52

Streetwise Maps, Inc. v. VanDam, Inc.,
159 F.3d 739 (2d Cir. 1988).....28, 53

Sunenblick v. Harrell,
895 F. Supp. 616 (S.D.N.Y. 1995).....30

Sunward Electronics, Inc. v. McDonald,
362 F.3d 17 (2d Cir. 2004).....32

In re Swift & Co.,
42 C.C.P.A. 223 F.2d 950 (C.C.P.A. 1955).....12

In re Tam,
808 F.3d 1321 (Fed. Cir. 2015).....50

TCPIP Holding Co. v. Haar Communications Inc.,
2004 U.S. Dist. LEXIS 13543 (S.D.N.Y. July 19, 2004)9

<i>THOIP v. Walt Disney Co.</i> , 736 F. Supp. 2d 689 (S.D.N.Y. 2010).....	35
<i>Thomas Nelson, Inc. v. Cherish Books, Ltd.</i> , 595 F. Supp. 989 (S.D.N.Y. 1984).....	30
<i>Tiny Tot Sports, Inc. v. Sporty Baby, LLC</i> , 2005 U.S. Dist. LEXIS 18137 (S.D.N.Y. Aug. 24, 2005).....	14
<i>Top Producer Sys. v. Software Sciences Ltd.</i> , 1997 U.S. Dist. LEXIS 12368 (D. Or. July 21, 1997).....	47, 50
<i>Traffix Devices v. Mktg. Displays</i> , 532 U.S. 23 (2001).....	18
<i>Twentieth Century Fox</i> , 155 F. Supp. 2d at 20	54
<i>Two Pesos, Inc. v. Taco Cabana, Inc.</i> , 505 U.S. 763 (1992).....	10, 11
<i>Versace S.p.A. v. Versace</i> , 2003 U.S. Dist. LEXIS 14858 (S.D.N.Y. Aug. 27, 2003).....	9
<i>Virgin Enters. Ltd. v. Nawab</i> , 335 F.3d 141 (2d Cir. 2003).....	10, 28, 29, 51
<i>W.E. Bassett Co. v. Revlon, Inc.</i> , 435 F.2d 656 (2d Cir. 1970).....	26
<i>Wal-Mart Stores, Inc. v. Samara Bros., Inc.</i> , 529 U.S. 205 (2000).....	11, 15, 16
<i>Wilton v. Seven Falls Co.</i> , 515 U.S. 277 (1995).....	45
<i>Yurman Design</i> , 262 F.3d 101 (2d Cir. 2001).....	15
State Cases	
<i>DePinto v. Ashley Scott, Inc.</i> , 222 A.D.2d 288, 635 N.Y.S.2d 215 (1st Dept. 1995).....	54
Federal Statutes	
15 U.S.C. § 1062(a)	41
15 U.S.C. § 1063(a)	41
15 U.S.C. § 1114(1)	35

15 U.S.C. § 1116.....	38
15 U.S.C. § 1119.....	47
15 U.S.C. § 1125.....	35
15 U.S.C. § 1125(a)	35, 38
15 U.S.C. § 1127.....	35
28 U.S.C. § 2201(a)	45
Lanham Act.....	<i>passim</i>
Lanham Act § 6, 15 U.S.C. § 1056.....	47, 49
Lanham Act § 7(e), 15 U.S.C. § 1057(e).....	48
Lanham Act § 35(a), 15 U.S.C.A. §1117(a).....	38, 40
Section 37 of the Lanham Act	47
Section 43(a) of the Lanham Act.....	<i>passim</i>
Lanham Act § 43(a)(1)(A).....	54
State Statutes	
N.Y. Deceptive Business Practices, Gen. Bus. L. § 349.....	37, 39, 54
Rules	
Fed. R. Civ. P. 1.....	10
Fed. R. Civ. P. 15(b)(2).....	13
Fed. R. Civ. P. 56.....	27
Fed. R. Civ. P. 56(c)	9
Fed. R. Evid. 706	25
Regulations	
37 C.F.R. § 2.101	41
37 C.F.R. § 2.67	50

Other Authorities

J. Thomas McCarthy, *McCarthy on Trademarks & Unfair Comp.*, § 8:710

McCarthy § 8:12.5012

McCarthy § 8:1316

McCarthy § 15:1218

McCarthy § 15:15-1718

McCarthy § 15:1719

McCarthy § 15:2019

McCarthy § 15:4822

McCarthy, § 31:440

McCarthy § 32:11113

McCarthy § 32:19525

Restatement (Third) of Unfair Competition § 16 cmt. a (1995)14

PRELIMINARY STATEMENT

Antonio Brown (“Brown”) started his company, LVL XIII Brands, Inc. (pronounced “Level 13”, hereinafter “LVL XIII”) in December 2012 on what was, unquestionably, a “shoe-string” budget. What he lacked in capital, however, he made up for in resourcefulness and marketing acumen, harnessing the power of the Internet to develop a loyal brand that responded to LVL XIII’s style innovation and street attitude. His winning mix of social media leadership, urban hip, and bona fide penetration into a desirable consumer market – upscale luxury sneakers – was not only noticed by his fans, customers and a steadily-growing circle of national and international fashion media and recognizable superstars in the African American entertainment and fashion worlds. LVL XIII’s viral success was noticed, the facts suggest, by defendants Louis Vuitton Malletier SA and Louis Vuitton North America, Inc. (collectively, “Louis Vuitton”), who, the facts affirmatively show, targeted, appropriated and all but destroyed his enterprise.

Louis Vuitton did this to feed an Old World “house of style” that had long run dry of creativity and had no clue of how to design and sell fashion for a subculture that the record shows Antonio Brown had not only captivated but which had, in fact, itself produced Antonio Brown. It was no surprise that he succeeded in penetrating the market for his luxury sneakers because he knew it intimately in a way Louis Vuitton never could. Among the celebrities drawn to LVL XIII’s cutting-edge sneaker styles that all contain a distinctive rectangular metal plate across the front of the shoe toe (the “Metal Toe Plate” or “Mark”) were male supermodel Tyson Beckford and recording artists Chris Brown and Jason Derulo, the last of whom chose – on his own initiative – LVL XIII sneakers for two live performances on ABC’s *Good Morning America* in the summer and fall of 2013, months before Louis Vuitton debuted its infringing On the Road Sneaker (“OTR Sneaker”) in the U.S in early March 2014. LVL XIII’s business grew, generating growing social media “buzz” and sneaker revenues of \$141,241 in just six months. Antonio Brown’s dream of becoming a rare minority-group player in the white-dominated luxury goods industry was in reach.

Louis Vuitton did not set out to destroy that dream when it decided to knock off the LVL XIII Mark – not exactly. It was nothing personal, or racial. It was just business. The question was not **if** Louis Vuitton would infringe someone else’s sneaker design for the Spring / Summer season of 2014 – it was **whose** design it would rip off. Desperate to invigorate its lagging sales, it had nonetheless heard rumblings that the initial men’s footwear designs conceived for its Men’s Spring/Summer 2014 Fashion Show (“2014 Runway Show”) looked too much like Converse’s iconic “Jack Purcell” men’s casual shoe for comfort. Louis Vuitton needed a proven design, but not one from a rival from which it had be concerned would bring a legal challenge. In contrast, LVL XIII’s startup profile, relatively small sales and quick adoption in key markets, plus the novelty of the Mark – i.e., the metal toe plate – seemed like a much wiser source of “inspiration.”

Louis Vuitton quickly rolled out its OTR Sneaker, with a toe plate which, from any reasonable distance, instantly evoked the LVL XIII Mark among anyone familiar with the market. Consumers and the trade were, indeed, quickly confused. And if the typical harm associated with “forward confusion” were not enough for LVL XIII to endure, it also suffered from “reverse confusion, whereby retail store buyers who had been interested in adding LVL XIII’s athletic footwear to their inventory in the spring of 2014 suddenly balked after encountering promotions for the OTR Sneaker – erroneously concluding that the startup LVL XIII must have infringed the item being sold by the older, established, “respectable” Louis Vuitton!

Disaster followed for LVL XIII. Louis Vuitton’s response has been, unsurprisingly, to follow the axiom that the best defense is a good offense, brushing off all attempts at settlement and filing its own tortured infringement counterclaims against LVL XIII, notwithstanding the utter silence from Louis Vuitton while LVL XIII applied for the very federal trademark registration that eventually issued on May 27, 2014 for its LVL XIII word mark (U.S. Reg. No. 4539506) (hereinafter the “LVL XIII Word Mark”) and which is the subject of those “infringement” counterclaims!

That distraction – and waste of plaintiff’s resources and the Court’s time – aside, with respect to the underlying dispute, defendants have produced no evidence that would raise material fact questions to rebut the essentially undisputed facts that underlie LVL XIII’s claims of liability for infringement of the Metal Toe Plate. Hence, these issues are ripe for summary judgment, though not in the least along the lines defendants suggest. Rather, the submissions of the two sides demonstrate that this case is as simple as it sounds: Louis Vuitton willfully infringed the distinctive trademark of the much smaller start-up LVL XIII under the mistaken belief that, because of its sheer size and dominance within the luxury goods market, it could do so with impunity.¹ On the actual record, however, and based on the law, the Court should use this juncture, at which so much, if not all, of the issues in dispute are ripe for adjudication, to correct defendants’ serious misperception. They have infringed LVL XIII’s rights, and should be called to account.

STATEMENT OF FACTS²

Brown has long loved footwear and had a keen appreciation for, and interest in, luxury fashion brands. (Deposition testimony of Antonio Brown attached as Exhibit 1 to the Declaration of Joel MacMull sworn to on February 16, 2016 (“MacMull Decl.”) (hereinafter “Brown Tr.”) at 135:10-19.) His dream of one day starting a luxury footwear company began in the mid-2000s, when he began to collect images of footwear as a hobby. (*Id.*, at 135:12-137:6; MacMull Decl., Ex. 2) Computer folders were filled with all sorts of varied influences, as he drew upon the rich history of Europe’s *haute couture* fashion houses like Lanvin and Gucci, but also more accessible American-influenced street-wear brands like Nike. (MacMull Decl., Ex. 3.) By the summer of

¹ Louis Vuitton’s failure to timely file the entirety of its summary judgment submissions by the January 21, 2016 deadline set in the Court’s briefing schedule, without either a request for leave or even a post facto explanation is in keeping with its apparent sense of entitlement in both commerce and in proceedings in this Court. (*Compare* Dkt. No. 97 *with* Dkt. Nos. 107-112.) *See also* § 3.3 of the SDNY Electronic Case Filing Rules & Instructions (ed., June 8, 2015) (“Electronic filing **must** be completed before midnight local time where the Court is located in order to be considered timely filed that day”) (emphasis added.)

² All the contents of the Statement of Facts are found, as are their sources in the record, in the L. Civ. R. 56.1 Statement, the parties’ Joint Stipulated Facts entered on January 15, 2016 (Dkt. No 102) (“JSF”), the declarations submitted on behalf of LVL XIII and their accompanying exhibits; or otherwise as specifically cited.

2012, and realizing that he wanted to “be his own boss,” Brown decided to revisit his collection of footwear imagery and starting a luxury athletic footwear company. (Brown Tr. at 135:7-19.) Marshalling his resources and drawing on his network of business associates with knowledge of the fashion industry, Brown called in all the personal favors he could, including modest capital contributions from friends and family. (*Id.*, at 12:22-13:6.) Initial capital contributions were invested in footwear development, as artists and graphic designers were brought in to bring Brown’s visions to life. (*Id.*, at 30:8-13; 34:15-22.) As valuable as these assets were to the new endeavor, at its core perhaps nothing was so important as its designs. (MacMull Decl., Ex. 4.)

The early designs conceived by Antonio Brown in September 2012, all of which feature plaintiff’s distinctive Metal Toe Plate, served as the basis for LVL XIII’s first sneaker collection. (*Id.*) Refinements followed, and computer-aided designs (“CAD”) drawings were prepared by October, 2012. (Brown Tr. at 142:17-25; MacMull Decl., Ex. 5.) These CAD drawings, with precise material measurements for all aspects of the sneakers including the Metal Toe Plate, were then submitted to a factory in Hong Kong for fabrication of samples. (Brown Tr. at 143:7-12; MacMull Decl., Ex. 5.) Prototypes were prepared, designs refinements completed, and manufacturing adjustments made over the next few months. In December of 2012 LVL XIII was incorporated in New York. (JSF, ¶ 1.) By March of 2013, LVL XIII began to prepare a formal business plan with the help of a third-party vendor (Brown Tr. at 35:20-36:7), completing the plan after its sneakers hit the market in the hopes of attracting additional investors. (Brown Tr. at 35:20-36:18; MacMull Decl., Ex. 6.) The initial price point for LVL XIII’s sneakers ranged from \$500-\$1200 per pair, in line with its chosen demographic of young, affluent, urban-influenced males. (JSF ¶¶ 4, 9.)

To protect its brand, LVL XIII filed two trademark registration applications in March 2013. (JSF, ¶¶ 11-12.) On March 4, 2013, U.S. Application Serial No. 85,865,370 (the “‘370 Application”) was filed for the standard character wordmark “LVL XIII” on an intent-to-use basis

(the LVL XIII Word Mark). On March 6, 2013, U.S. Application Serial No. 85,868,102, was filed, on an intent-to-use basis, which was a “design mark” only for the Metal Toe Plate (The “‘102 Application”). (JSF, ¶ 12.)

Meanwhile LVL XIII geared up for a 2013 summer product release. It focused on designing its website and advertising generally, gaining traction with the media, and important upcoming tradeshows in New York and Las Vegas. (Brown Tr. at 57:18-25.) The official public release of LVL XIII’s first sneaker collection occurred at the Project Sole event in New York City from July 21 to July 23, 2013, where it displayed its sneakers featuring the Metal Toe Plate to buyers. (*Id.*; *see also id.* at 72:5-19; MacMull Decl., Ex. 7.) A lavish launch party in New York City, hosted by African American male supermodel Tyson Beckford, and attended by the media, rounded out the week’s festivities. (Brown Tr. at 149:3-6; 151:15-19; 188:16-21; MacMull Decl., Ex. 8). LVL XIII immediately began taking orders and deposits from retailers. (Brown Tr. at 72:9-73:9.)

The Project Sole debut was amplified by the nationwide television appearance, on July 19, 2013, of then–23 year-old pop megastar Jason Derulo on *Good Morning America* wearing LVL XIII sneakers, those distinctive Metal Toe Plates gleaming in the klieg lights as he danced acrobatically for the cameras. (Declaration of Darius Baptist sworn to February 9, 2016 (“Baptist Decl.”), ¶ 14; Brown Tr. at 87:12-19; 89:2-11; 159:19-24.) The “buzz” generated from Derulo’s *Good Morning America* appearance and other publicity was immense. LVL XIII funneled the publicity favoring its conspicuously-visible sneakers through its well-organized social media channels, which in turn resulted in even greater, and even more traditional, media coverage, including *Details*, *Ebony*, *Paper*, and Conde Nast’s footwear industry bible, *Footwear News*. (Brown Tr. at 176:4;175:14-176:20; 177:12-22; MacMull Decl., Exs. 9 and 10.)

Social media has been a cornerstone of LVL XIII’s brand development, a medium that Antonio Brown intentionally chose as an alternative to the fashion industry’s historical model of expensive, glossy print advertisements in a handful of favored, elite outlets. (Brown Tr. at 175:14-

177:8.) Instagram and Twitter served as Brown’s and LVL XIII’s cyber version of *Vogue Magazine* on the cheap and with an appropriate appeal to a market that identified with not only the message but the medium itself. As a result, LVL XIII’s social media accounts had over 50,000 “followers” by April 2013 – i.e., **before its sneakers even hit the market**, which would not occur until later than summer. (*Id.* at 185:8-17; 363:2-364:10; Declaration of Wendi Sloane in Support of Defendants’ Motion for Summary Judgment dated January 22, 2016 (“Sloane Decl.”), Ex. 41.) These “followers,” or fans, **all** recognized the brand, by definition; axiomatically, they recognized the product, because it only had one: Luxury athletic footwear, all of which – each and every shoe – bore the Metal Toe Plate.

The style sensibility of LVL XIII’s sneakers resonated particularly well among young African American males. Recording artist Chris Brown, following Jason Derulo’s lead earlier that summer, also took an interest in the brand. He modeled a pair of LVL XIII sneakers in September 2013 during a photoshoot for the Fall 2013 issue of *Annex Man Magazine*, a publication for young black men, on which he appears on the cover. (Brown Tr. at 87:18-19; MacMull Decl., Exs. 9 and 10.) In August, 2013, LVL XIII exhibited its sneakers at the Magic Show, another key industry event, in Las Vegas to wholesalers, retailers, press and celebrities, which, in turn, led to more “buys.” (Brown Tr. at 153:6-25.) In late September of 2013, a photo of Chris Brown wearing LVL XIII’s sneakers was posted to the “microblog” and social networking website, Tumblr. (*Id.* at 89:20-90:8; MacMull Decl., 21.) Sales of the LVL XIII’s sneakers were steady and growing just six months following the products’ launch, totaling \$141,241 in 2013. (Brown Tr. at 172:8-11; MacMull Decl., Ex. 11; JSF ¶ 34.)

The circle of those interested in the excitement surrounding the LVL XIII sneaker during 2013 extended further, and more ominously, than Antonio Brown and his tens, and eventually hundreds of thousands, of fans realized at the time. [REDACTED]

[REDACTED]

[REDACTED]

[REDACTED] On June 10, 2013, [REDACTED]

[REDACTED]

[REDACTED] (Sloan Decl., Ex. 21; emphasis in

original.) Her email cautioned that, [REDACTED]

[REDACTED]

[REDACTED]

[REDACTED] (Sloane Decl., Ex. 23.) [REDACTED]

[REDACTED] – its toe now brandishing, instead of (big) [REDACTED] (small) LVL XIII's

Metal Toe Plate. (*Id.*; MacMull Decl., Ex. 17.)

The urgency with which [REDACTED] needed to complete the OTR Sneaker's redesign less than two weeks before the 2014 Runway Show is evident from the face of his email. (Sloane Decl., Ex.

1, ¶ 5) He writes: [REDACTED]

[REDACTED] (*Id.*, Ex. 23.) The pressure on [REDACTED]

[REDACTED], coupled with the company's

depressed sales as Asia's once red-hot markets cooled, was the backdrop that drove the calculated,

cutthroat risk assessment behind its calculated infringement. (MacMull Decl, Ex. 18.) Risking

legal trouble with [REDACTED] was out. But Antonio Brown, whoever he was, was not a problem who

could not be managed by Louis Vuitton. Voila!

It was during a March visit to Brazil, while working on LVL XIII's second sneaker collection, when the problem named Antonio was "congratulated" by Shaundel Hall, a stylist to celebrities including Nick Cannon and Kanye West, about what Hall assumed, based on the similarity between the two, was LVL XIII's "collaboration" with Louis Vuitton on the latter's new OTR Sneaker. (Brown Tr. at 385:12-386:11; MacMull Decl., Ex. 12; Declaration of Shaundel Hall sworn to on February 6, 2016 ("Hall Decl."), ¶¶ 6-11.) Brown immediately contacted his trademark counsel, expressing grave concern. (MacMull Decl., Ex. 13.) After speaking with counsel, he was able to take some solace, he thought, in the progress of his applications to register his trademarks. On July 10, 2013, the PTO had already issued a Notice of Publication for the LVL XIII Mark registration, and the Metal Toe Plate application received its own Notice of Publication less a month later on August 7, 2013. (JSF, ¶¶ 22, 24.) Both applications then successfully cleared the opposition period, the PTO issuing Notices of Allowance in September and October, 2013, respectively, for each mark. (*Id.*, ¶¶ 25-26.) After filing Statements of Use in the spring of 2014 for both the '102 and '370 Applications, which were accepted in due course, registration seemed imminent, as is the case in the overwhelming number of cases. (JSF, ¶¶ 37-39, 42.)

Indeed, registration for the LVL XIII Word Mark issued on May 27, 2014, while the Metal Toe Plate mark was queued for routine processing of its registration by mid-July of that year. (*Id.*, ¶¶ 41-42.) But, by July 2014, this litigation had already been filed and Louis Vuitton was on actual notice that LVL XIII intended to prosecute its claims for trademark infringement. (Complaint, Dkt. No. 1 "Compl."; MacMull Decl., Ex. 14.) By the time the PTO issued its Notice of Acceptance of the Statement of Use for the '102 Application on July 15, 2014 (JSF, ¶ 42) LVL XIII's litigation counsel was attempting to resolve this dispute with Louis Vuitton's in-house counsel – when the progress of the '102 Application took a most unusual turn.

Despite the issuance of a Notice of Acceptance of Statement of Use just three days earlier

(JSF, ¶ 42), the PTO issued a new Office Action in connection with the ‘102 Application on July 18, 2014 (“Second Office Action”). (JSF ¶ 43; Sloane Decl., Ex. 32.) The Second Office Action required, for the first time, several amendments to the already-approved ‘102 Application. (Sloane Decl., Ex. 32.) Among these was that LVL XIII “disclaim the design of the rectangular shape of the shoe plate because the mark consists of a nondistinctive feature of a product design that is not registrable on the Principal Register without sufficient proof of acquired distinctiveness.” (*Id.*) There is no record of communication between Louis Vuitton’s representatives and the PTO in connection with the almost unheard-of retraction of the PTO’s Notice of Acceptance of Statement of Use in favor of an office action that could all but have been written by defendants for purposes of this litigation. Nor is there any explanation for this occurrence, which was relatively fortuitous (though, as set out in detail below, legally of trivial significance) for Louis Vuitton. But to the extent its occurrence frames the obstacles being placed before Antonio Brown and LVL XIII to vindicate their rights here, and the opportunity concomitantly set before this Court to do justice and restore those rights in this matter, that happenstance is relevant, even if its cause may never see the light of day. These motions present that opportunity.

ARGUMENT

I. SUMMARY JUDGMENT STANDARD

Summary judgment should be granted if “there is no genuine issue as to any material fact and . . . the moving party is entitled to a judgment as a matter of law.” Fed. R. Civ. P. 56(c). Such motions are regularly granted in trademark cases brought under Section 43(a) of the Lanham Act. *See e.g., TCPIP Holding Co. v. Haar Communications Inc.*, 2004 U.S. Dist. LEXIS 13543 (S.D.N.Y. July 19, 2004); *Versace S.p.A. v. Versace*, 2003 U.S. Dist. LEXIS 14858 (S.D.N.Y. Aug. 27, 2003). On a motion for summary judgment, the facts are viewed in the light most favorable to the nonmoving party. *Nabisco v. Warner-Lambert Co.*, 32 F. Supp. 2d 690, 694 (S.D.N.Y. 1999). Rule 56(c) “mandates the entry of summary judgment . . . against a party who

fails to make a showing sufficient to establish the existence of an element essential to that party's case, and on which that party will bear the burden of proof at trial." *Celotex Corp. v. Catrett*, 477 U.S. 317, 322 (1986). Summary judgment is "designed to secure the just, speedy and inexpensive determination of every action." *Id.* at 327 (quoting Fed. R. Civ. P. 1).

II. LVL XIII'S METAL TOE PLATE IS PROTECTABLE AS A SOURCE INDICATOR FOR ITS LINE OF LUXURY ATHLETIC FOOTWEAR.

"A claim of trademark infringement . . . is analyzed under [a] familiar two-prong test . . ." *Virgin Enters. Ltd. v. Nawab*, 335 F.3d 141, 146 (2d Cir. 2003). "The test looks first to whether the plaintiff's mark is entitled to protection, and second to whether defendant's use of the mark is likely to cause consumers confusion as to the origin or sponsorship of the defendant's goods." *Id.* at 146. "The first of these questions relates closely to the second, because a trademark's distinctiveness – the key consideration in assessing its protectability – is also a factor in determining the likelihood of confusion." *Playtex Prods., Inc. v. Georgia-Pacific Corp.*, 390 F.3d 158, 161 (2d Cir. 2004). An unregistered mark is entitled to protection under the Lanham Act if it would qualify for registration as a trademark. *See Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 767-68 (1992). The standard for such protection is that the mark must serve, either through acquired distinctiveness or inherent distinctiveness, to distinguish the plaintiff's goods from those of others. *See id.* at 769. This same standard applies to trade dress. *Aromatique Inc. v. Gold Seal, Inc.*, 28 F.3d 863, 868 (8th Cir. 1994); *see also*, J. Thomas McCarthy, *McCarthy on Trademarks & Unfair Comp.* ("McCarthy"), § 8:7 citing *Aromatique*; T.M.E.P. § 1202.02 ("Trade dress constitutes a 'symbol' or 'device' with the meaning of § 2 of the Trademark Act.")

A. LVL XIII's Metal Toe Plate is an inherently distinctive trademark.

"[A] mark is inherently distinctive if [its] intrinsic nature serves to identify a particular source. In the context of word marks, courts have applied the now-classic test originally formulated by Judge Friendly, in which word marks that are 'arbitrary' ('Camel' cigarettes), 'fanciful' ('Kodak' film), or 'suggestive' ('Tide' laundry detergent) are held to be inherently distinctive."

Wal-Mart Stores, Inc. v. Samara Bros., Inc., 529 U.S. 205, 210-11 (2000), citing *Abercrombie & Fitch v. Hunting World, Inc.*, 537 F.2d 4, 10-11 (2d Cir. 1976). Arbitrary, fanciful, or suggestive marks are considered “inherently distinctive,” and are therefore automatically entitled to protection under the Lanham Act without demonstrating secondary meaning. *See Two Pesos*, 505 U.S. at 768. The *Abercrombie* continuum of distinctiveness also applies to trade dress. *See Paddington Corp. v. Attiki Imps. & Distributions*, 996 F.2d 577, 583 (2d Cir. 1993). And where, as here, the plaintiff has an inherently distinctive trademark, its rights in the mark vest as soon as it is affixed to products and the products are sold. *See Blisscraft of Hollywood v. United Plastics Co.*, 294 F.2d 694, 700 (2d Cir. 1961). Hence, legal protection against subsequent use of the same or a similar mark is available as soon as actual use is commenced, provided there is a likelihood of confusion. *See Chandon Champagne Corp. v. San Marino Wine Corp.*, 335 F.2d 531, 534 (2d Cir. 1964).

There can be no serious dispute that LVL XIII’s Metal Toe Plate is an arbitrary or fanciful design used in an unfamiliar way – uniform in its size and location on the toe of the outsole of each sneaker – to identify LVL XIII’s entire line of men’s luxury sneakers. The uniqueness of this use of the Metal Toe Plate is attested to by LVL XIII’s expert, Prof. Charles Colman, a scholar of fashion design. “While LVL XIII’s product designs have varied in imaginative and innovative ways within the aesthetic parameters appropriate to the relevant segment of the market,” he writes, “the placement of the metal toe plate in a regular and consistent manner on LVL XIII’s shoes has most likely served, since its inception, **not** as product design, or even product packaging, but rather, as a conventional trademark” (MacMull Decl., Ex. 19 (hereinafter “Report”), ¶ 23; emphasis in original; *see also* ¶¶ 24-26.) This is exactly how the law defines arbitrary marks: commonplace words or symbols used in connection with a specific product or service, that, critically, **otherwise lack any connection with the product or service**. *See e.g., Gruner + Jahr USA Publishing v. Meredith Corp.*, 991 F.2d 1072, 1075-76 (2d Cir. 1993).

The Metal Toe Plate is no less arbitrary a trademark because it also has aesthetic merit. An

ornamental design can be inherently distinctive if it is arbitrary and distinctive and if its principal function is to identify and distinguish the source of the goods to which it is applied. *See In re Swift & Co.*, 42 C.C.P.A. 223 F.2d 950, 953-954 (C.C.P.A. 1955). As explained by the Second Circuit in *Dallas Cowboys Cheerleaders, Inc. v. Pussycat Cinema, Ltd.*, 604 F.2d 200 (2d Cir. 1979), while a cheerleading uniform is axiomatically “aesthetic,” it is inherently distinctive **precisely** because of the arbitrary combination of colors and accessories of which it is composed. *Id.* at 203-204.

That a mark is “arbitrary” is frequently determined on summary judgment or in the context of a permanent injunction in this Circuit. *See e.g., Polo Fashions, Inc. v. Extra Special Products, Inc.*, 451 F. Supp. 555, 525 (S.D.N.Y. 1978) (on motion for a permanent injunction, court concluded that “as a common word or symbol applied in an unfamiliar way, POLO and the Polo Player Logo qualify as arbitrary and therefore will be automatically protected”); *Lane Capital Mgmt. v. Lane Capital Mgmt.*, 15 F. Supp. 2d 389, 394 (S.D.N.Y. 1998) (granting summary judgment that plaintiff’s mark, LANE CAPITAL MANAGEMENT, was arbitrary); *Constellation Brands, Inc. v. Arbor Hill Assocs.*, 535 F. Supp. 2d 347, 363 (W.D.N.Y. 2008) (on motion for summary judgment, court ruled that ARBOR HILL mark is arbitrary and is entitled to protection); *Country Floors, Inc. v. A. P’ship Composed of Cheryl Mizak & Alan Mizak*, 1993 U.S. Dist. LEXIS 20213, at *12, (D. Conn. June 10, 1993) (summary judgment finding that independent of registration, plaintiff’s COUNTRY FLOORS mark “is more analogous to an arbitrary term like IVORY soap than it is to a simple descriptive mark”).³

³ Even if the Metal Toe Plate were not arbitrary, as a threshold matter Louis Vuitton’s inquiry, i.e., whether LVL XIII’s toe plate is trade dress product design or trade dress packaging is an issue of **fact**, not of law. This was resolved definitively in *In re Slokevage*, 441 F.3d 957, 959-960 (Fed. Cir. 2006), a case on which Louis Vuitton relies in its own brief. (LV Mem. at 15.) *See also McCarthy* § 8:12.50.

Slokevage is particularly instructive here for LVL XIII has been unable to locate a single on-point authority in which the parties’ principal dispute, as here, centered on whether the symbol at issue was properly characterized as a trademark versus trade dress. Thus, in the absence of any authority to resolve this critical question, i.e., whether the *res* at issue is a trademark or trade dress, plaintiff can conceive of no reason why this inquiry is not also “akin to

B. Alternatively, LVL XIII's Metal Toe Plate is protectable as product packaging trade dress.

The law and facts cited above, as well as the analysis by Prof. Colman, are compelling in their convergence on the conclusion that LVL XIII's Metal Toe Plate is an inherently distinctive trademark. Compelled as it is to prevent the Court from reaching that conclusion, Louis Vuitton essentially argues that: (i) LVL VIII has "admitted" "that its Metal Toe Plate Design comprised product design, not a trademark,"⁴ and (ii) the PTO's Second Office Action "is strong evidence that the Toe Plate Design is product design and that it cannot be protected without proof of secondary meaning." (LV Mem. at 15-16.) Neither of these arguments can be sustained by the facts or law, as demonstrated below.

LVL XIII's purported "admission" is based on a strained and, as it turns out, entirely imagined interpretation of language used in the '102 Application, which Louis Vuitton maintains proves that LVL XIII contemplated trade dress and not a trademark registration at the time the application was filed. First, defendants' argument is based on the doctrine of "file wrapper estoppel," which binds parties in patent litigation to statements made in application proceedings in front of the PTO. But that doctrine is "inapplicable to trademark litigation." *Perfect Pearl Co. v. Majestic Pearl & Stone, Inc.*, 887 F. Supp. 2d 519, 535 n.11 (S.D.N.Y. 2012), citing *McCarthy* § 32:111. Additionally, the attorney who filed that application, Erik Pelton, Esq., in his Declaration, states that neither the use of the word "design" in the '102 Application, nor the existence of a "three-dimensional configuration" indicates or even suggests trade dress was

determining whether a trademark is inherently distinctive or whether a mark is descriptive, which are questions of fact." *Slokevage*, 441 F.3d at 959.

⁴ Louis Vuitton also argues that LVL XIII conceded that the '102 Application is trade dress in its Answer as well as language in the '102 application addressed above. (LV Mem. at 16, citing SoF ¶¶ 122-123.) Defendants cite no authority for the proposition that an admission of this sort would, at the pleading stage, would be controlling under any circumstances. But under Fed. R. Civ. P. 15(b)(2), which states any issue "not raise[d] by the pleadings is tried by the parties' express or implied consent, it must be treated in all respects as if raised in the pleadings," in light of the rest of the pleadings that single "admission" can hardly be said outweigh the other pleadings, admissions, denials and other submissions by both parties in this matter.

contemplated in his filing. The PTO, he explains, makes no such distinctions in its treatment of trademark registrations. Consequently, he does not do so either in preparing applications to register trademarks. (Declaration of Erik Pelton sworn to on February 11, 2016 (“Pelton Decl.”), ¶¶ 7-18.)

Louis Vuitton’s reliance on the Second Office Action is also unavailing, especially considering the PTO’s unexplained, which is not to say suspiciously timed, about-face on the key issue in dispute. “[P]reliminary determinations of the PTO examiner [are] given little weight . . . **The apparent vacillation of the PTO examiner in regard to [the applicant]’s submissions, . . . only serves to confirm the Court’s reluctance to premise its ruling on these preliminary determinations.**” *Tiny Tot Sports, Inc. v. Sporty Baby, LLC*, 2005 U.S. Dist. LEXIS 18137, at *14 n.7 (S.D.N.Y. Aug. 24, 2005; emphasis added). Compare, *Jewish Sephardic Yellow Pages, Ltd. v. DAG Media, Inc.*, 478 F. Supp. 2d 340, 366-367 (E.D.N.Y. 2006) (“DAG amended its application to the Supplemental Register and was granted registration”).

Defendants have not demonstrated, either by these “procedural” sleights of hand or their confused arguments to force the LVL XIII Metal Toe Plate into a trade dress “package,” that it belongs there. In recognition, however, of the ambiguities in some of the decisions addressing this area of law, LVL XIII addresses below why even LVL XIII is entitled to summary judgment under a trade dress paradigm of recovery.

1. Trade dress is protected as either “product packaging” or “product design.”

“A product’s trade dress encompasses the overall design and appearance that make the product identifiable to consumers.” *Nora Beverages, Inc. v. Perrier Grp. of Am., Inc.* (“*Nora Beverages II*”), 269 F.3d 114, 118 (2d Cir. 2001). Product packaging is the archetypal, long-recognized type of trade dress: “the appearance of labels, wrappers, boxes, envelopes, and other containers used in packaging a product as well as displays and other materials used in presenting the product to prospective purchasers.” Restatement (Third) of Unfair Competition § 16 cmt. a (1995). The purpose of trade dress law is “to protect an owner of a dress in informing the public

of the source of its products, without permitting the owner to exclude competition from functionally similar products.” *Jeffrey Milstein, Inc. v. Greger, Lawlor, Roth, Inc.*, 58 F.3d 27, 33 (2d Cir. 1995); *see also, Nora Beverages II*, 269 F.3d at 119.

LVL XIII is entitled to relief for Louis Vuitton’s infringement of its trade dress under § 43(a) of the Lanham Act by proving that: (1) the LVL XIII trade dress is protectable because it is either inherently distinctive or has established distinctiveness; (2) there is a likelihood of confusion between LVL XIII’s sneakers and the OTR Sneaker; and (3) the trade dress is not functional. *See Yurman Design*, 262 F.3d 101, 115-116 (2d Cir. 2001).

a. If the LVL XIII Toe Plate is trade dress, it is inherently distinctive.

The Supreme Court resolved the issue Louis Vuitton seeks to advance here, namely, that product design can never be inherently distinctive in *Wal-Mart Stores, Inc. v. Samara Brothers, Inc.*, 529 U.S. 205, 207 (2000). As demonstrated above, LVL XIII’s Metal Toe Plate is not product design at all; rather, it is an inherently distinctive trademark and secondary meaning need not be shown. But to the extent the Metal Toe Plate has anything at all to do with the category of trade dress, as opposed to a “classical” trademark (a factual, not a legal, determination under *In re Slokevage*, 441 F.3d 957) — it could, in any event, only be trade dress in a manner that is analogous to product **packaging**, not trade dress product **design**, as Louis Vuitton urges.

This distinction, it turns out, is important because a claimant asserting infringement of unregistered product design trade dress must prove the design has acquired secondary meaning. *Wal-Mart*, 529 U.S. at 207. In *Wal-Mart*, the Supreme Court made clear that its holding applied only to product design, not **packaging** trade dress. Thus, certain types of packaging **may** be properly classified as inherently distinctive. “The attribution of inherent distinctiveness to certain categories of word marks and **product packaging** derives from the fact that the very purpose of attaching a particular word to a product, or encasing it in a distinctive packaging, is most often to identify the source of the product.” *Wal-Mart*, 529 U.S. at 212 (emphasis added).

“[W]here it is reasonable to assume consumer predisposition to take packaging as an indication of source, then inherent distinctiveness **will** be found.” *McCarthy* § 8:13 (emphasis in original). Of course, an indicator of source is precisely what LVL XIII is marketing here by virtue of affixing its Metal Toe Plate onto its **entire line** of luxury athletic footwear – a critical fact Louis Vuitton acknowledges. (Sloane Decl., Ex. 35; *see also* Brown Tr. at 65:11-22; MacMull Decl., Ex. 20.)

Indeed, there can no real dispute that “it is reasonable to assume consumer predisposition to take [LVL XIII’s] packaging” – its affixing of the Metal Toe Plate to the outsole – as an indication of source here. LVL XIII’s advertising has consistently reinforced this inherent distinctiveness in the product, cued the viewer in visual depictions of the product to the Metal Toe Plate and, by extension, the Mark as a source for differentiating LVL XIII’s products in the marketplace. (MacMull Decl., Exs. 9, 10 and 20; Brown Tr. at 65:12-66:6 (describing the editorial spread in *Paper Magazine* as a reenactment of The Last Supper, wherein the subjects’ feet are intentionally facing toward the camera, thereby capturing “the metal plates even at a distance ... “ and focusing the viewers’ gaze specifically on the Mark); Report ¶¶ 22-26.) The record evidence demonstrates it is “reasonable to assume consumer predisposition” to treat the Metal Toe Plate as a source indicator.

LVL XIII’s Mark would, in fact, be entitled to protection as inherently distinctive product packaging, even if viewed as suggestive, arbitrary or fanciful.⁵ “Courts must evaluate the distinctiveness of a trade dress ‘by looking at all its elements and considering the total impression

⁵ Louis Vuitton argued in its pre-conference letter that the “*Abercrombie* test is of doubtful applicability to marks other than words,” citing *Wal-Mart*, 529 U.S. at 210-213 and *McCarthy* § 8.13. (Dkt. No. 95.) But *Wal-Mart* was **not** critical of the *Abercrombie* test as applied to non-word marks. In fact, *Wal-Mart* tacitly endorsed the *Abercrombie* test for non-word marks, referencing its own prior decision in *Qualitex Co. v. Jacobson Products Co.*, 514 U.S. 159, 162-163 (1995) which concerned whether green colored dry-cleaning pads and, by extension colors generally, could ever be inherently distinctive. The Court wrote: “**Reasoning by analogy** to the *Abercrombie & Fitch* test developed for word marks, we noted that a product’s color is unlike a ‘fanciful,’ ‘arbitrary,’ or ‘suggestive’ mark, since it does not ‘almost automatically tell a customer that [it] refers to a brand,’ and does not ‘immediately . . . signal a brand or a product ‘source,’” *Wal-Mart*, 529 U.S. at 212 (quoting *Qualitex*, 514 U.S. at 163; emphasis added.)

the trade dress gives to the observer.” *L’Oreal USA, Inc. v. Trend Beauty Corp.*, 2013 U.S. Dist. LEXIS 115795, at *65-66 (S.D.N.Y. Aug. 15, 2013), citing *Fun-Damental Too, Ltd.*, 111 F.3d 993, 1000 (2d Cir. 1997) and *Paddington Corp.*, 996 F.2d at 584. This is an easy showing to make for product packaging (as opposed to product design), because “the varieties of labels and packaging available to wholesalers and manufacturers are virtually unlimited . . . a product’s trade dress typically will be arbitrary or fanciful and meet the inherently distinctive requirement for § 43(a) protection.” *Paddington Corp.*, 996 F.2d at 583.

Therefore, to the extent this Court concludes LVL XIII’s claims sound in “trade dress” rather than ‘trademark’ law, LVL XIII has established the first element of its claim. The “dress” for each of LVL XIII’s entire line sneakers, i.e., the Metal Toe Plate, is inherently distinctive: a uniform metallic plate, uniform in its size and location on the footwear and bearing the stamp “L-V-L X-I-I-I.” These elements are used in LVL XIII’s presentation of each product in the luxury shoe line offered to the public. Second, because the trade dress for each of the products at issue is inherently distinctive, LVL XIII need not show secondary meaning.⁶ LVL XIII has therefore established the first element in demonstrating trade dress infringement.

b. LVL XIII’s product packaging trade dress is non-functional.⁷

“[A] product feature is functional, and cannot serve as a trademark, if it is **essential** to the use or purpose of the article or if it affects the cost or quality of the article, that is, if exclusive use

⁶ The Mark also functions as a common law trademark under the Lanham Act through its acquisition of secondary meaning. *See Fun-Damental Too, Ltd.* 111 F.3d at 1000. As discussed *infra*, secondary meaning exists where “the public is moved in any degree to buy an article because of its source.” *Genesee Brewing Co., v. Stroh Brewing Co.*, 124 F.3d 137, 143 n.4 (2d Cir. 1997) (citation omitted).

⁷ In *L’Oreal USA, Inc. v. Trend Beauty Corp.*, 2013 U.S. Dist. LEXIS 115795, at *68 (S.D.N.Y. Aug. 15, 2013), this Court wrote: “A defendant ‘bears the burden of proving functionality as a defense to [a] plaintiff’s claim of infringement,’” (quoting *Mana Prods. v. Columbia Cosmetics Mfg.*, 65 F.3d 1063, 1068 (2d Cir. 1995)). *Mana Products*, however, was decided four years before the “Lanham Act was amended in 1999 to shift the burden of demonstrating non-functionality for an unregistered trade dress onto the party seeking relief. Previously, it had been an affirmative defense.” *Best Cellars, Inc. v. Grape Finds at Dupont, Inc.*, 90 F. Supp. 2d 431, 451, n.10 (S.D.N.Y. 2000). Nevertheless, should this Court conclude Louis Vuitton bears the burden of demonstrating the non-functionality of LVL XIII’s trade dress, it has failed to do so. Neither its Amended Counterclaims (Dkt No. 40 “Am. Counterclaims”) nor its Memorandum in Support of Summary Judgment raises the defense of functionality.

of the feature would put competitors at a significant non-reputation-related disadvantage.” *Qualitex*, 514 U.S. at 165 (internal quotation marks omitted; emphasis added). Here the Metal Toe Plate is not “essential” to the footwear as a matter of law – it is not, say, a red-colored sole. *See Traffix Devices v. Mktg. Displays*, 532 U.S. 23, 32 (2001). Nor do LVL XIII’s exclusive rights to its “trade dress” put competitors at a “significant non-reputation-related disadvantage.” *Id.*; *see also, Fruit-Ices Corp. v. Coolbrands Int’l, Inc.*, 335 F. Supp. 2d 412, 423 (S.D.N.Y. 2004) (packaging of frozen fruit bar was non-functional because it was not essential to the use, quality or purpose of the fruit bar, different packaging is available and successfully used by competitors).

C. LVL XIII’s trade dress is protectable as product design.

Louis Vuitton asserts that its intentional copying of the Metal Toe Plate is not actionable because what tens of thousands of LVL XIII fans readily recognize as LVL XIII’s trademark is no trademark at all. Plaintiff, defendants insist, cannot show secondary meaning. They are incorrect.

1. New York law does not require a showing of secondary meaning.

As an initial matter, Louis Vuitton fails to acknowledge the fact that that under New York law, unfair competition does not require a showing of “classic” Lanham Act–type secondary meaning. Rather, egregious conduct may be treated as a **substitute** for secondary meaning. “[U]nder New York’s common law of unfair competition, a producer’s trade dress is protected without proof of secondary meaning against practices imbued with an odor of bad faith. ... These practices include **palming off, actual deception, appropriation of another’s property, ... or deliberate copying**. Therefore, true innovators, at least under New York law, have adequate means of recourse against free-riders.” *Laureyssens v. Idea Group, Inc.*, 964 F.2d 131, 139 (2d Cir. 1992) (citations omitted; emphasis added); *see also Cartier, Inc. v. Four Star Jewelry Creations, Inc.*, 348 F. Supp. 2d 217, 250 (S.D.N.Y. 2004) (“no requirement to show secondary meaning for distinctive designs.”); *see McCarthy* §§ 15:12; 15:15-17.

The impetus behind New York’s policy is its concern “with the nature of the defendant’s

unjustified conduct [rather] than with the analytic symmetry” associated with a traditional trademark analysis. *McCarthy* § 15:20 (citation and quotations omitted). The facts here warrant such a “substitution,” including: (i) a strong inference of intentional copying; (ii) evidence of actual confusion causing damage; and (iii) plaintiff’s distinctive, popularly-acclaimed design.

Intentional Copying Louis Vuitton’s intentional copying may be reasonably inferred from the timeline of events leading up to the 2014 Runway Show; the testimony of LVL XIII’s expert regarding Louis Vuitton’s history of misappropriation with respect to smaller, vulnerable innovators in general and of LVL XIII’s Mark in particular in reaction to its creative stagnancy (Report ¶¶ 27-29, 31, 32, 37, 38, 39(b)); and the absence of any evidence from Louis Vuitton to document a timeline of independent conception and development for the hastily redesigned OTR Sneaker. (*Compare* Sloane Decl., Ex. 1 and Declaration of Fabrizio Viti sworn to January 21, 2016 (Dkt. No. 112) (“Viti Decl. II “), ¶ 9.) *with* Viti Tr. 66:18-67-13.)

Actual Confusion The presence of actual confusion between the products is not a fact regarding which a bona fide dispute can be said to exist. The record of actual confusion, including testimony by not only Antonio Brown but by fashion industry professionals and consumers who purchased the sneakers confirm the existence of actual confusion between plaintiff’s products and the OTR Sneaker as well as actual resulting damage to LVL XIII’s business resulting from it. *See McCarthy* § 15:17. (Brown Tr. 231:18-242:13; 302:20-303:8; 408:13-409:4; *see also* Baptist Decl., Hall Decl., Declaration of Eric Hamilton sworn to February 9, 2016 (“Hamilton Decl.”); Declaration of De’Von Johnson sworn to February 10, 2016 (“Johnson Decl.”); Declaration of Tavius Bolton sworn to February 10, 2016 (“Bolton Decl.”); and Declaration of Kathleen Roque sworn to February 10, 2016 (“Roque Decl.”).

Distinctiveness Lastly, the distinctive design of plaintiff’s Metal Toe Plate, discussed above at length, dispenses with the need for plaintiff to establish secondary meaning under New York law. *See Cartier, Inc.*, 348 F. Supp. 2d at 250.

2. The factual record readily demonstrates the secondary meaning in the Metal Toe Plate.

The Metal Toe Plate is, again, inherently distinctive. But the record so readily supports a finding of secondary meaning that it can support a summary judgment in LVL XIII's favor on that question. A trademark (or trade dress) will be found to have secondary meaning based evidence of "(1) advertising expenditures, (2) consumer studies linking the mark to a source, (3) unsolicited media coverage of the product, (4) sales success, (5) attempts to plagiarize the mark, and (6) length and exclusivity of the mark's use." *Christian Louboutin S.A. v. Yves Saint Laurent Am.Holding, Inc.*, 696 F.3d 206, 226 (2d Cir. 2012). No single factor is dispositive and not every factor needs to be proved. *See Louis Vuitton Malletier v. Dooney & Bourke, Inc.*, 454 F.3d 108, 118 (2d Cir. 2006). "The crucial question in a case involving secondary meaning always is whether the public is moved **in any degree** to buy an article because of its source." *Genesee Brewing Co.*, 124 F.3d at 143 n.4 (emphasis added). Here, that crucial question is answered in LVL XIII's favor.

Advertising In analyzing whether advertising expenditures weigh in favor of a finding of secondary meaning, "Targeted, albeit low-cost advertising, may establish the advertising factor." *Lopez v. Gap, Inc.*, 883 F. Supp. 2d 400, 425 (S.D.N.Y. 2012). This is particularly the case, where, as here, the "modest" scale of the business does not lend itself to "high cost-advertising." *Id.* LVL XIII advertised its sneakers extensively in both general media outlets and trade-oriented mediums prior to the OTR Sneaker's launch in March 2014. (Brown Tr. at 175:14-176:18; MacMull Decl., Exs. 9, 10 and 21.) LVL XIII also spent \$82,000 in 2013 alone in association with marketing, advertising and the promotion of its sneakers. (Brown Tr. at 150:8-151:9; JSF, ¶ 35; MacMull Decl., Ex. 11.) These costs included paying a public relations firm \$2500 a month beginning in 2013 to assist plaintiff in promoting its products. (Brown Tr. at 172:15-17; Deposition testimony of Lamont Johnson attached as Exhibit 22 to the MacMull Decl. (hereinafter "Johnson Tr.") at 52:15-53:23.) Moreover, the "majority" of LVL XIII's advertising budget was spent contemporaneously with the products' launch in July 2013, the need for which diminished

afterwards because LVL XIII had “so much momentum behind the brand with the celebrities that were wearing the shoes” such that there was “a frenzy over the brand.” (Brown Tr. at 151:15-23.) The result of this momentum was celebrity endorsements of an unusually high quality, mentioned above, for purposes of the demographic among whom LVL XIII’s sneakers resonate, namely, “‘urban male’ (i.e., African-American and African-American cultured-inclined) luxury footwear buyers between the ages of 17 and 36” (Report, ¶ 22; Brown Tr. at 45:23-46:5, 48:8-24; 87:12-20; 151:10-23; 284:23-25; 378:7-380:21.) LVL XIII’s advertising efforts unquestionably “were effective in causing the relevant group of consumers to associate” the Mark with LVL XIII. *See Centaur Communs., Ltd. v. A/S/M Communs., Inc.*, 830 F.2d 1217, 1222-23 (2d Cir. 1987) (“*Centaur IP*”) (plaintiff’s modest expenditure of \$10,000 over a three-year period for a direct mail solicitation was effective because test of secondary meaning is not the size of the expenditure used to create it but its effectiveness).

All this is in addition to LVL XIII’s savvy exploitation of low- and no-cost promotion via social media and his ability to link fans’ and media personal interest in him to his company, LVL XIII, and concomitantly to his product line – and, immediately, to its distinctive look, featuring the Metal Toe Plate. Brown amassed no less than 50,000 “followers” on such mainstream social media platforms as Instagram, Twitter and Facebook, comprising many fashion industry professionals, before the OTR Sneaker entered the U.S. market in March 2014. (Brown Tr. at 185:8-24; 201:11-204:9; 362:22- 364:10, 365:3-368:21; MacMull Decl., Ex. 21; Sloane Decl., Ex. 41; *see also* Colman Tr. at 59:24-64:25; 303:21-305:15.) In their contemporary, “Web 2.0” manifestations, these social media are designed for mobile platforms; are, as a rule, predominantly visually-oriented; and, therefore, they typically served to not only to build the LVL XIII “name” or “brand,” but also, consistently, images of its merchandise, all bearing the Metal Toe Plate. (Report, ¶¶ 19, 29, 30, 34, 39(d).) Through his mastery of these methods of promotion, Brown utilized his personal and professional appeal and design talent to promote his Mark by word-of-

mouth and through the endorsements of notable musicians and artists. This evidence of targeted advertising, as well as on-line promotion, weighs in favor of finding secondary meaning because “[t]here is no doubt that evidence of the seller’s efforts to expose buyers to the mark is relevant evidence from which secondary meaning may be inferred....” *McCarthy* § 15:48; *see also Amini Innovation Corp. v. McFerran Home Furnishings, Inc.*, 68 F. Supp. 3d 1170, 1174 (C.D. Cal. 2014) (plaintiff’s “substantial presence ... through social media” was sufficient to defeat defendant’s motion for summary judgment); *President & Trs. of Colby Coll.*, 508 F.2d 804, 808 (1st Cir. 1975).

Unsolicited Media Coverage There is also substantial proof of unsolicited media coverage of LVL XIII’s brand throughout 2013, and prior to the OTR Sneaker’s release in March 2014. (Baptist Decl., ¶¶ 11, 18 (explaining that he, as Jason Derulo’s stylist, approached LVL XIII in the spring of 2013 to obtain shoes for Derulo’s appearance on *Good Morning America* that July; MacMull Decl., Ex. 21 (chronicling unsolicited coverage prior to March 2014, including a Tumblr page dedicated to fashions worn by pop star Chris Brown; *see also* Johnson Tr. 67:6-68:13; 69-18:70:3; 71:8-21; 73:7-11; 74:5-75:6; Brown Tr. 164:13-166:6; 166:19:167:3; 180:8-11). LVL XIII’s sneakers also received additional unsolicited press coverage in the form of reviews, testimonials, and social media placements posted by “fans” of the sneakers, at no cost to LVL XIII – phenomena not considered in pre-social-media cases but which, given the premise of secondary meaning, there is no basis to omit from consideration.

Indeed, these third-party, unsolicited online endorsements, juxtaposed against fan-posted images of LVL XIII sneakers, reveal more about popular enthusiasm for plaintiff’s footwear than any anonymous survey of persons of undisclosed ethnic identity and cultural affinity. Many of these accolades are expressed using the laudatory urban vernacular that underlies LVL XIII’s contemporary – and entirely authentic – urban marketing approach, and include comments like: “Dope”, “Amazing!”, “NICE REAL NICE ...” “Classic”, “Must have”, “I’m in love with this

footwear!!!”, “The shoes look great”, “Sweet”, “Hot!”, “Hell Yeah These Are Dope,” “Sick!!!”, “I’m Soo damn ready” (*see* Sloane Decl., Ex. 41 at pp. 4-6; 10-12.)

But that is not all; these same individual social media pages which reference LVL XIII or its shoes have received **hundreds** of “likes” in connection with each page. (*Id.*, showing the number of individual “likes” ranging from 1,534 to 2,283.) Accordingly, this factor too points in plaintiff’s favor.

Sales Success LVL XIII earned gross revenues of \$141,241 from essentially a dead start in July 2013 to December of that year in sales of footwear bearing the Mark. (Brown Tr. at 169:17-170:4; 172:8-11; 410:7-22; JSF, ¶ 34; MacMull Decl., Ex. 11.) After commencing the lawsuit in June 2014, LVL XIII stopped selling its shoes for a number of months. (Brown Tr. at 447:18-25; 449:12-451:25.) One reason for that decision was that some retailers refused to carry LVL XIII shoes precisely because of the consumer confusion that is the subject matter of this lawsuit. (*Id.* at 408:13-409:4; 438:15-439:3; 442:6-443:13; 448:2-10.) Under such circumstances, plaintiff’s relatively modest sales are not grounds for rewarding defendants’ conduct by denying relief to LVL XIII. *See Mortellito v. Nina of California, Inc.*, 335 F. Supp. 1288, 1290 (S.D.N.Y. 1972) (“it is obvious that [plaintiff] unlike a giant corporation, has not spread her fame into every nook and corner of the land. Yet she has done enough, with her meager means, to become well-known as a designer in needlepoint canvasses”; finding one year annual sales of \$184,000 to be sufficient for purposes of establishing of secondary meaning). Because in the context of a small business LVL XIII’s sales volume need not mirror that of a large national retailer, and in light of the conduct by defendant that depressed its sales, this factor too, favors plaintiff.

Attempts to Plagiarize the Mark “A deliberate attempt to plagiarize the first user’s mark is evidence that the mark has acquired secondary meaning.” *Centaur Communs. Ltd. v. A/S/M Communs., Inc.*, 652 F. Supp. 1105, 1109 (S.D.N.Y. 1987). The circumstantial evidence here, and the failure of Louis Vuitton – which had the ability to rebut it, to do so – supports the inference

that Louis Vuitton deliberately copied LVL XIII's Metal Toe Plate in June 2013, as set forth in detail above. Notably absent from the record is any "credible explanation" for why the metal toe plate that appeared on its OTR Sneaker is so striking similar to LVL XIII's Mark, and how it suddenly appeared only months after LVL XIII's did. *See Centaur II*, 830 F.2d at 1224 (absent a "credible explanation" for defendant's adoption of plaintiff's mark, obvious similarities between the marks led to inference of copying). Indeed, Fabrizio Viti's sworn statement submitted in support of defendants' motion that "[t]he final shape of the metal plate of the OTR Sneaker is not a rectangle" but rather was "intended as a subtle reference to [Converse's] Jack Purcell Smile" is all the more incredible given his prior sworn testimony to the contrary. (*Compare* Viti Decl. II, ¶ 9 *with* Viti Tr. at 23:11-23 ("So we changed it and made the metal plaque more of a **rectangular** design."))

Length and Exclusivity of the Mark's Use Contrary to Louis Vuitton's mistaken suggestion, there is no rule as to the length of time a symbol must be in use before it can achieve secondary meaning. *See Centaur II*, 830 F.2d at 1225 ("Of course, no absolute time span can be posited as a yardstick in cases involving secondary meaning"). Indeed, secondary meaning has routinely been found in instances soon after adoption of a mark, including in *Maternally Yours v. Your Maternity Shop*, 234 F.2d 538, 541, 544 (2d Cir. 1956) (eleven months) and, notably, in *L.A. Gear, Inc. v. Thorn MeAn Shoe Co.*, 988 F.2d 1117 (Fed. Cir. 1993), where the Federal Circuit upheld a finding of secondary meaning for trade dress within five months, relying on Second Circuit precedent in writing words that apply squarely to this case:

The district court found that L.A. Gear's Hot Shots design had acquired secondary meaning during the period from its introduction in December 1987 to the time infringement began in May 1988. Appellants argue that this period of time was too short for the acquisition of secondary meaning.

The effect of mass exposure achievable with today's communications media cannot be ignored in determination of secondary meaning. Fashion items take readily to development of secondary meaning upon mass media promotion, for the fashion status of the source is often part of the commercial value of fashion items. L.A.

Gear's advertising and promotion were extensive, and public demand for this design was shown, by sales figures, to have been rapidly achieved.

988 F.2d at 1130 (citations omitted). This factor weighs strongly in plaintiff's favor.

Consumer Surveys LVL XIII did not commission a consumer survey. "There are ... very practical reasons for not using a survey, not the least of which is the large expense involved. A prudent cost-benefit analysis may well result in a conscientious litigator's decision not to use a survey." *McCarthy* § 32:195. As set out with extensive authority in plaintiff's brief in connection with defendants' motion to exclude the testimony of Prof. Charles E. Colman's expert testimony, a survey is not a requirement to recover damages in the presence of other evidence.⁸ *See e.g., GTFM, Inc. v. Solid Clothing, Inc.*, 215 F. Supp. 2d 273, 294 (S.D.N.Y. 2002). Given the serious methodological errors that pervade Louis Vuitton's own consumer survey⁹, this factor can hardly be said to weigh in defendants' favor. Accordingly, to the extent it is considered at all, it is neutral.

In sum, even to the extent secondary meaning is considered, there can be no dispute that the Metal Toe Plate has acquired secondary meaning, as no less than five of the six factors favor plaintiff.

D. Louis Vuitton's examples of third-party use are irrelevant or unsubstantiated.

Louis Vuitton takes the strange tack, considering its own industry position, of trying to defend against trademark infringement by citing alleged third party uses of the Mark. (*See, e.g.,* Am. Answer at ¶¶ 22-39; Declaration of Maureen Harmon, etc., Jan. 21, 2016 ("Harmon Decl.");

⁸ Consumer surveys have also been roundly criticized. For example, Judge Richard Posner of the Seventh Circuit has repeatedly taken on the reliability of consumer survey evidence. First, in *Indianapolis Colts Inc. v. Metropolitan Baltimore Football Club L.P.*, 34 F.3d 410 (7th Cir. 1994), he called the battle of experts "frequently unedifying," referring to the survey researcher's techniques as "tricks" and a study in "black arts." *Id.* at 416. He suggested that courts should appoint a neutral expert to conduct the necessary studies, pursuant to Fed. R. Evid. 706. *See id.* at 415. Judge Posner has also noted that "[c]onsumer surveys conducted by party-hired expert witnesses are prone to bias." *Kraft Foods Group Brands LLC v. Cracker Barrel Old Country Store, Inc.*, 735 F.3d 735, 741 (7th Cir. 2013). There, he opined that "caution is required in the screening of proposed experts on consumer surveys," and suggested that other types of expert testimony would be preferable, such as by experts on consumer psychology. *Id.* at 742. Many of these same criticisms are noted in the course of the testimony of LVL XIII's expert witness, Charles Colman. (Colman Tr. 52:19-54:23; 138:15-139:23; 147:12-148:10; 292:12-23; 310:21-312:4.)

⁹ *See* LVL XIII's Memorandum of Law in Support of its Motion to Exclude Defendants' Expert Dr. Michael Mazis's Opinions, Testimony and Survey dated February 16, 2016 being filed contemporaneously herewith.

see also LV Mem. at 1-2, 4, 25, 30.) Unfortunately for Louis Vuitton, the vast majority of these references have little probative value here, and what remains evidences the **strength** of plaintiff's mark, not the opposite.

First, LVL XIII, as it applies to this case, is only asserting rights in the Metal Toe Plate with respect to men's sneakers; not women's shoes, boots, or even men's footwear generally, thus negating the probative value of much of Louis Vuitton's "evidence," which is not so restricted. (Report, ¶¶ 25-26.) *See W.E. Bassett Co. v. Revlon, Inc.*, 435 F.2d 656, 661 (2d Cir. 1970) ("third-party products cited by [defendant] range from very different to slightly different products from [plaintiff's], most of the third-party products have names slightly different from [plaintiff's], or else the third-parties did not promote their ... with as much effort and money as [plaintiff] did"); *New Colt Holding Corp. v. RJG Holdings of Fla., Inc.*, 312 F. Supp. 2d 195, 229 (D. Conn. 2004) (rejecting evidence of third-party uses not relevant to market claimed by plaintiff).

Moreover, while Louis Vuitton submits Internet printouts of alleged third-party use of metal accents on men's and women's shoes and boots generally, it does not offer **evidence** of use of the third-party marks at issue, or **evidence** of how or even if those uses were promoted in commerce, much less whether they were recognized by consumers in any way. These submissions are of no probative value. *See Scarves By Vera, Inc. v. Todo Imports Ltd.*, 544 F.2d 1167, 1173-74 (2d Cir. 1976) ("Defendant introduced no evidence that these trademarks were actually used by third parties, that they were well promoted or that they were recognized by consumers. . . . The record does not contain any evidence to support the claim that plaintiff's trademark was weakened by uses of similar marks by third parties."); *see also, Bear U.S.A. v. Kim*, 71 F. Supp. 2d 237, 255 (S.D.N.Y. 1999) (quoting *Scarves By Vera* and finding third-party "evidence" similarly unpersuasive).

Accordingly, LVL XIII satisfies the first requirement for establishing trademark

infringement and unfair competition under Section 43(a) of the Lanham Act.¹⁰

III. LOUIS VUITTON’S USE OF A METAL TOE PLATE ON ITS ON THE ROAD SNEAKER THAT IS SUBSTANTIALLY SIMILAR TO THE LVL XIII METAL TOE PLATE WAS AND IS LIKELY TO CAUSE CONFUSION.

Likelihood of confusion between two marks is measured applying the factors set forth in *Polaroid Corp. v. Polarad Elecs., Corp.*, 287 F.2d 492 (2d Cir. 1961): (1) strength of the plaintiff’s mark; (2) degree of similarity between the marks; (3) proximity of the parties’ goods and services in the marketplace; (4) likelihood that the plaintiff will bridge any gap between it and defendant; (5) actual confusion; (6) the defendant’s intent in adopting its mark; (7) quality of the defendant’s product; and (8) sophistication of buyers. *See id.* at 495. In balancing these factors, “courts generally should not treat any single factor as dispositive; nor should a court treat the inquiry as mechanical process by which the party with the greatest number of factors wins. Instead, the court should focus on the ultimate question of whether consumers are likely to be confused.” *De Beers LV Trademark Ltd. v. DeBeers Diamond Syndicate Inc.*, 440 F. Supp. 2d 249, 274 (S.D.N.Y. 2006).

A. LVL XIII’s Metal Toe Plate Mark is strong, inherently distinctive and deserving of protection against directly competing goods.

“[T]he distinctiveness or ‘strength’ of a mark measures its capacity to indicate the source of the goods or services with which it is used.” *Estee Lauder Inc. v. The Gap, Inc.*, 108 F.3d 1503, 1510 (2d Cir.1997) (citation omitted). “Strength” in this context encompasses two concepts:

The first and most important is inherent strength, also called “inherent distinctiveness.” . . . The second sense of the concept of strength of a mark is “acquired distinctiveness,” *i.e.*, fame, or the extent to which prominent use of the mark in commerce has resulted in a high degree of consumer recognition.

¹⁰ In so moving, LVL XIII simultaneously seeks the dismissal of Louis Vuitton’s First, Second and Third affirmative defenses on precisely the same grounds as set forth above. (*See Am. Counterclaims.*) “Where a plaintiff uses a summary judgment motion, in part, to challenge the legal sufficiency of an affirmative defense – on which the defendant bears the burden of proof at trial – a plaintiff ‘may satisfy its Rule 56 burden by showing that there is an absence of evidence to support an essential element of the non-moving party’s case.’” *F.D.I.C. v. Giammettei*, 34 F.3d 51, 54 (2d Cir. 1994) (quoting *DiCola v. SwissRe Holding (N. Am.), Inc.*, 996 F.2d 30, 32 (2d Cir. 1993) (alterations and other internal quotation marks omitted)).

Virgin Enters., 335 F.3d at 147 (citations omitted). The distinctiveness of a mark is its “ability to identify goods sold under it as coming from one particular source.” *Streetwise Maps, Inc. v. VanDam, Inc.*, 159 F.3d 739, 743 (2d Cir. 1988). As discussed extensively in Section II.A, *supra*, the Metal Toe Plate is a strong trademark deserving protection under Section 43(a) of the Lanham Act, akin to Polo’s Polo player symbol. Moreover, as also set forth at length above, even if the Mark were not inherently distinctive, because of plaintiff’s offering and promotion of more than a dozen sneaker styles beginning in the summer of 2013, accompanied by a viral Internet, social media and conventional media campaign, sales and extensive advertising for a small company, and demonstrated consumer recognition that the sneakers bearing the Metal Toe Plate come from LVL XIII, the Mark has acquired distinctiveness, and this factor also favors LVL XIII.

B. The parties’ marks are virtually identical for purposes of trademark law.

The similarity of the marks is a key factor in determining likelihood of confusion. *See Louis Vuitton Malletier v. Burlington Coat Factory Warehouse Corp.*, 426 F.3d 532, 537 (2d Cir. 2005). “To apply this factor, courts must analyze the mark’s overall impression on a consumer, considering the context in which the marks are displayed and the ‘totality of factors that could cause confusion among prospective purchasers.’” *Id.* (internal citations omitted). Here, the marks are virtually identical because the engraved characters ‘LVL XIII’ are insignificant to plaintiff’s use of a rectangular metal toe plate on its footwear as a source identifier in the relevant commercial context, i.e., as a narrow rectangular metallic plate worn on the toe of footwear and perceived either at a distance or from a height typically of five feet or more, such that the characters are not dominant aspects of the mark for purposes of the dispute between the parties. *See Adidas-Salomon Ag v. Target Corp.*, 228 F. Supp. 2d 1192, 1212 (D. Or. 2002) (noting that “a consumer encountering defendants’ shoes at Target may be initially drawn to them because they appear to be Adidas shoes from a distance.”)

Both LVL XIII and Louis Vuitton use a metal toe plate precisely in the same place.

Moreover, both parties use the device in the same way, namely, on the toe of the outsole of their respective men's sneakers. And because each of LVL XIII's sneaker models possesses a different and distinctive "upper" utilizing varying designs and materials, with the Metal Toe Plate serving to inform the consumer by virtue of its consistent shape and location that the sneaker is part of the line of sneakers manufactured by the LVL XIII (Report, ¶¶ 23-24, 26, 31-32, 38, 39(a) and (b) Slone Decl., Ex. 35), to the extent there is any difference in the appearance between the two metal toe plates, the difference is, as a matter of law, of no significance. *See Virgin*, 335 F.3d at 149 (use of identical mark lessened importance of arguable differences between fonts, appearance of marks in given context).¹¹ Therefore, this factor strongly favors LVL XIII.

C. The goods in association with which the marks are used are identical.

The inquiry into the proximity of the parties' offerings concerns whether and to what extent the two products compete with each other. *See Morningside Group, Ltd. v. Morningside Capital Group, L.L.C.*, 182 F.3d 133, 140 (2d Cir. 1999). Accordingly, the court considers "the nature of the products themselves and the structure of the relevant market," including "the class of customers to whom the goods are sold, the manner in which the products are advertised, and the channels through which the goods are sold." *Cadbury Beverages, Inc. v. Cott Corp.*, 73 F.3d 474, 480 (2d Cir. 1996) (citation omitted). A claimant need not show that defendants' products compete directly with its offerings in order to prevail. *See Virgin*, 335 F.3d at 150. Articles of clothing bearing similar marks are often found likely to cause confusion. *See, e.g., Lois Sportswear, U.S.A., Inc. v. Levi Strauss & Co.*, 799 F.2d 867, 876 (2d Cir. 1986).

Here the products at issue are identical for purposes of a likelihood of confusion analysis.

¹¹ Louis Vuitton's Fourth Affirmative Defense asserts that it is "not using a toe plate design that is confusingly similar" to plaintiff's Mark because the OTR Sneaker's metal toe plate "is not rectangular in shape" (Am. Counterclaims, Fourth Affirmative Defense). However, Louis Vuitton's Fabrizio Viti admitted that the OTR Sneaker's metal toe plate is rectangular, testifying "[t]he first design [of the toe plate] was very similar to the ... Converse [design]. So we changed it made the metal plaque more of a **rectangular** design." (Viti Tr. at 7:4-8; 23:11-23; emphasis added.) Accordingly, Viti's resulting testimony now in support of summary judgment cannot be credited. (Viti Decl. II, ¶ 9.)

Both LVL XIII and Vuitton manufacture and sell men's sneakers, featuring a metal toe plate located on the toe of the outsole, with a retail cost of each pair exceeding \$495.00. (*Compare* Sloane Decl., Ex. 35 with Ex. 27 and Ex. 28; LV Mem. at 1, 5, 7 at 11; Deposition testimony of Giovanna Battaglia attached as Exhibit 25 to the MacMull Decl. (hereinafter "Battaglia Tr.") at 68:17-70:10.) Both LVL XIII's sneakers and Vuitton's OTR Sneaker are sold in retail stores and online. (*Compare* Brown Tr. 75:3-7; 281:13-25; 291:25-293:15; MacMull Decl., Ex. 26 and Sloane Ex. 35 with Battaglia Tr. 48:19-49:5.) The products are the same for purposes of determining likelihood of confusion, and this factor strongly favors plaintiff. *See Thomas Nelson, Inc. v. Cherish Books, Ltd.*, 595 F. Supp. 989, 991 (S.D.N.Y. 1984) (plaintiff's series of romance novels and defendant's series of Christian romance novels were the same for purposes of likelihood of confusion); *Playboy Enters. v. Chuckleberry Publ'g, Inc.*, 511 F. Supp. 486, 488, 490 (S.D.N.Y. 1981) (*Playmen* magazine was similar to *Playboy* in terms of content, format, and appearance, and differences between them magazines were "superficial").

D. There is no "gap" between the two markets to be bridged.

"Bridging the gap" refers to the likelihood that the senior user (here, LVL XIII) will enter the market of the junior user (here, Louis Vuitton) in the future, or that consumers will perceive that this is likely to occur. *Morningside Group*, 182 F.3d at 141. Where, as here, the parties offer the same products, the "gap" is already bridged. *See, e.g., id.* at 141; *Best Cellars, Inc.*, 90 F. Supp. 2d at 456. This factor thus favors plaintiff.

E. There is substantial proof of actual confusion and resulting harm.

While actual confusion it not necessary to prove trademark infringement, "evidence of actual confusion is highly probative of the likelihood of confusion." *Sunenblick v. Harrell*, 895 F. Supp. 616, 630 (S.D.N.Y. 1995); *Schieffelin & Co. v. Jack Co. of Boca, Inc.*, 850 F. Supp. 232, 245 (S.D.N.Y. 1994). Here, the record is replete with instances of actual and material "forward" and "reverse" confusion and, a concomitant misattribution of plaintiff's Metal Toe Plate to Louis

Vuitton in the wake of the latter's infringement. (*See generally*, Baptist Decl.; Bolton Decl.; Hall Decl.; Hamilton Decl.; Johnson Decl.; and Roque Decl.; *see also* Brown Tr. at 231:18-237:17.) And the record shows that this confusion is not trivial, but has had a material and harmful effect on LVL XIII's business.

Brown testified about repeated incidents in which he had to advise celebrity stylists and magazine editors that they were incorrect in assuming a collaboration between LVL XIII and Louis Vuitton shortly after the OTR Sneaker debuted in the United States in March of 2014. (Brown Tr. at 231:18-233:9.) LVL XIII's public relations representative, Lamont Johnson, corroborated the occurrence of Brown's reports of confusion between LVL XIII's sneaker and the OTR Sneaker. (Johnson Tr. at 84:15-85:4.) Among the individuals confused by Louis Vuitton's "copycat" acts was Eric Hamilton. Brown testified that "[Hamilton] used to work for LVMH [Moet Hennessy Louis Vuitton SA], and he was also confused about the brand and whether or not it was a collaboration that was releasing in the marketplace, especially since he was an employee of LVMH." (Brown Tr. at 235:4-8; 237:14-17.) Confusion regarding LVL XIII's sponsorship or affiliation of Vuitton's OTR Sneaker occurred among others with knowledge of the luxury fashion industry. (Brown Tr. at 240:2-241:12.) Brown's social media followers and bona fide purchasers of LVL XIII's sneakers also expressed confusion over Louis Vuitton's OTR Sneaker. (Brown Dep. 386:14-387:17; Bolton Decl.; Roque Decl.) Testimony concerning the presence of actual confusion accords with LVL XIII's expert's findings as well. (Report, ¶¶ 30, 38, 39(a), (c)-(d).)

Louis Vuitton nonetheless denies that this evidence of confusion has any significance. All such reports, it says, either (i) came from "friends and colleagues" of Brown who could not have been confused, or (ii) are mere "observations" that are not tantamount to actual confusion. (LV Mem. at 32-34.) But these characterizations are not borne out by the record. For example, the declarations of disinterested bona fide LVL XIII's sneaker purchasers such as Tavius Bolton and Kathleen Roque disprove defendants' assertion that no "real people" were confused. As to their

claim that no one was “really” confused, this is simply editorializing, and is belied by the unequivocal statements of the declarants themselves. This factor favors LVL XIII.

F. Defendants’ actions give rise to an inference of bad faith.

The inquiry into willfulness or bad faith “considers whether the defendant adopted its mark with the intention of capitalizing on the plaintiff’s reputation and goodwill and on any confusion between his and the senior user’s product.” *De Beers*, 440 F. Supp. 2d at 278. As to the issue of intent “it is well established that wrongful intent is not a prerequisite to an action for trademark infringement or unfair competition, and that good faith is no defense.” *Sunward Electronics, Inc. v. McDonald*, 362 F.3d 17, 25 (2d Cir. 2004) (“under the [Lanham Act], no intent to deceive . . . need be shown[.] It is sufficient that the public may be deceived.”) (citations omitted).

Louis Vuitton claims that it was not aware of LVL XIII’s Metal Toe Plate when it adopted its own competing metal toe plate on its OTR Sneaker. Indeed, Louis Vuitton ups the credibility ante by claiming that it was not even **familiar** with LVL XIII or its footwear at the time it designed the OTR Sneaker. But as set forth above in the section addressing New York’s “egregious conduct” standard, Louis Vuitton’s narrative does not hold water. Moreover, its stubborn refusal to permit LVL XIII to depose the designer Mathieu Desmet, whose live testimony could have provided the key to the untold “story” of the inspiration for his rapid redesign “re-creation,” should be credited to plaintiff’s favor at this juncture. (MacMull Decl., Ex. 24 at 3.) While jockeying to avoid producing Desmet was a canny tactic indeed, as it turned out, in suppressing the testimony of the one witness most likely to acknowledge Louis Vuitton’s copying of the LVL XIII’s Metal Toe Plate, defendants’ success in employing that tactic should not obscure the wide evidentiary hole, one only Louis Vuitton could have filled during discovery, on a key issue in this case.

Indeed, even short of producing the witness whose testimony may have produced that elusive smoking gun, Louis Vuitton’s has not even submitted an affidavit or other documentation

tending to support independent creation.¹² For example, it is certainly odd that a corporate fashion institution such as Louis Vuitton would have conducted no U.S. trademark or design search prior to adopting the metal toe plate elements set forth in Desmet’s mock-up and sketch (Sloane Decl., Ex. 23; MacMull Decl., Ex. 12; Viti Tr. at 93:3-94:6.) Yet such searches which would have surely disclosed the existence of plaintiff’s Mark given that its filing date in March 2013. (JSF, ¶ 12.) Louis Vuitton’s “oversight” here – for no search has been produced, nor has its existence been acknowledged – is the all more remarkable in light of its in-house counsel’s express warning on June 10, 2013 that, “as we distance ourselves from [the Purcell] model, we have to make sure we don’t get closer to another brand’s model.” (Sloan Decl., Ex. 21.) Could such a warning possibly contemplate proceeding with a redesign without conducting clearance searches, when its import is the opposite?

The affidavits of Fabrizio Viti, dated October 26, 2015 and January 21, 2016, which include new factual claims that have never been the subject of cross-examination, are just as telling for what they omit as for it what they do say. (Sloane Decl., Ex. 1; Viti Decl. II.) Viti’s October affidavit, for example, simply ignores the legal worries Louis Vuitton’s in-house intellectual property personnel had with the initial designs of the OTR Sneaker vis-à-vis Converse’s “Jack Purcell” sneaker, which ultimately prompted the shoe’s redesign. (Sloane Decl., Ex. 1, ¶ 8.) The paltry proofs Louis Vuitton has submitted concern events that relate to the period only **after**, not before, plaintiff’s public offering of its sneakers in the U.S. market, and thus shed no light on the question of copying at all. (MacMull Decl., Exs. 9, 10 and 21.) *See, Centaur II*, 830 F.2d at 1224 (obvious similarities between plaintiff’s and defendant’s products, without a “credible explanation,” is “telling evidence” of copying). Accordingly, this factor, too, favors plaintiff.

¹² Of course, the existence of such testimony that, if credited, does not mean that summary judgment is appropriate. *See Ideal Steel Supply Corp. v. Anza*, 652F.3d 310, 326 (2d Cir. 2011) (credibility determinations may not be made at the summary judgment stage).

G. Defendants' OTR Sneaker is of inferior quality, causing harm to LVL XIII.

This factor generally looks to “whether defendant’s products or services are inferior to plaintiff’s, thereby tarnishing plaintiff’s reputation if consumers confuse the two.” *Morningside Group*, 182 F.3d at 142. Louis Vuitton claims it “is famous for the high quality and craftsmanship of its products,” but the record is well developed that the OTR Sneaker is not one of those products. Louis Vuitton does not even contend that its OTR Sneaker is of different or superior quality to LVL XIII. (LV Mem. at 35.) It could not, given the repeated reports of defects that plagued the OTR Sneaker from its inception. (Battaglia Tr. at 128:8-130:16; MacMull Decl., Ex. 28 (noting that by June 10, 2014, just a few short months after the OTR Sneaker’s release, Louis Vuitton’s store in Aventura, Florida “ha[s] seen .. damage [with the OTR Sneaker] happen multiple times already. I may have to give a refund [; are defects with this shoe] .. a[n] know[n] issue?”))

Louis Vuitton points to Brown’s testimony that plaintiff’s and defendants’ shoes are “essentially the same quality.” This testimony concerned the sneakers’ materials and the process by which they were constructed, however; not their workmanship or consumer satisfaction. (SoF, ¶ 98.) Indeed, even if the sneakers were of the same quality, this factor would tend to sway in LVL XIII’s direction because buyers would, isolating this prong, be more likely to substitute the products. *See Morningside Group*, 182 F.3d at 142 (“this factor cuts both ways”); *see also, Lois Sportswear*, 799 F.2d at 875 (high quality of alleged infringer’s product “actually may increase the likelihood of confusion as to source”). In any event, Louis Vuitton’s own documents confirming the existence of multiple defects with the OTR Sneaker, which is not found concerning LVL XIII’s product, is more telling than Antonio Brown’s testimony about the OTR Sneaker. This factor favors LVL XIII.

H. The Relative sophistication of buyers increases a likelihood of confusion.

This factor examines the sophistication of the relevant consumer to determine the likelihood that each would be confused or misled by the similarity of the different products at

issue. *See THOIP v. Walt Disney Co.*, 736 F. Supp. 2d 689, 714-715 (S.D.N.Y. 2010); *CJ Prods. LLC v Snuggly Plushez LLC*, 809 F. Supp. 2d 127, 155-56 (E.D.N.Y. 2011). Generally, a trained professional is less likely to be confused than an ordinary retail customer, and, the less expensive the product, the less sophisticated the retail consumer is presumed to be. *See CJ Prods. LLC*, 809 F. Supp. 2d at 155-56 (purchasing inexpensive toys for children does not require any sophistication on the part of the buyer).

Here, neither side has submitted evidence of the sophistication of the relevant consumers, namely, male consumers between the ages of 17-36 who purchase sneakers with a minimum price point of \$495.00. Despite the high price tag, this factor weighs in LVL XIII's favor for at least two reasons. First, several witnesses with luxury brand or high-end footwear-specific industry experience have testified to being confused between the OTR Sneaker and LVL XIII's sneakers. (Section, II.C.1, *supra*.) Second, where, as here, the products are identical and the marks are identical, the sophistication of buyers cannot be relied on to prevent confusion. *See Lane Capital*, 15 F. Supp. 2d at 400. Thus, to the extent it is considered at all, this factor also favors LVL XIII.

Accordingly, all of the *Polaroid* factors regarding which there is evidence favor LVL XIII, and the Court has grounds on this record to find a likelihood of confusion.¹³

IV. LVL XIII IS ENTITLED TO SUMMARY JUDGMENT ON ITS FEDERAL UNFAIR COMPETITION CLAIMS.

The intent of the Lanham Act "is to protect persons engaged in commerce against unfair competition." *Cartier Int'l B. V. v. Ben-Menachem*, No. 06 Civ. 3917, 2007 U.S. Dist. LEXIS 95366, at *35 (S.D.N.Y. Jan. 3, 2008), citing 15 U.S.C. § 1127. Courts in the Second Circuit have consistently found that because the elements required to succeed on an infringement claim under 15 U.S.C. § 1114(1)¹⁴ and unfair competition under 15 U.S.C. § 1125 are substantially similar, the

¹³ LVL XIII respectfully requests that the Court, upon reaching such a conclusion, also rely on it to dismiss Louis Vuitton's Fourth Affirmative defense. (Am. Counterclaims.) *See* footnote 10, *supra*.

¹⁴ A typographical error in the Complaint mistakenly asserts LVL XIII's federal trademark infringement claim under 15 U.S.C. § 1125(a) rather than § 1114(a). (Dkt. No. 1 at p. 14.) There is of course no confusion over the basis for

same analysis applies to claims under both statutes. *See Lois Sportswear*, 799 F.2d at 871. Accordingly, a claimant presenting a successful claim of trademark infringement need not present further proof to succeed on a claim of federal unfair competition. *See e.g., Calvin Klein Jeanswear Co. v. Tunnel Trading*, 2001 U.S. Dist. LEXIS 18738, at *19 n.4 (S.D.N.Y. Nov. 16, 2001). As discussed above in Sections II and III, because LVL XIII has presented a successful claim of trademark infringement, Louis Vuitton is also liable to LVL XIII on grounds of federal unfair competition under § 43(a).

V. LVL XIII IS ENTITLED TO SUMMARY JUDGMENT ON ITS STATE LAW CLAIMS AS A MATTER OF LAW.

“[I]t is easier for a plaintiff to establish the protectability of a mark for a New York common law unfair competition claim than to do so under Lanham Act Section 43(a). Under New York law, a plaintiff does not have to establish that a trade name has acquired secondary meaning within the relevant market to prevail. Rather, the plaintiff needs only to establish a likelihood of customer confusion.” *De Beers*, 2005 U.S. Dist. LEXIS 9307, at *21 n.6 citing *Coach Leatherware Co. v. Ann Taylor, Inc.*, 933 F.2d 162, 169 (2d Cir. 1991).

Thus, even if the Court finds that, based on the present record, it cannot find as a matter of law that the Metal Toe Plate is inherently distinctive or even that the Mark has acquired secondary meaning, LVL XIII is still entitled to protection under New York’s unfair competition law, which otherwise embraces the same likelihood of confusion analysis under Section 43(a) without requiring that a plaintiff satisfy either of these elements. *See Bruce Lee Enters., LLC v. A.V.E.L.A., Inc.*, 2013 U.S. Dist. LEXIS 31155, at *70 (S.D.N.Y. Mar. 6, 2013) (citing cases); *see also, Perfect Fit Indus., Inc.*, 618 F.2d at 953 (“New York law has concerned itself principally with whether or not the public is likely to be confused”). As set forth in Section III, *supra*, there can be no genuine dispute that LVL XIII has established a likelihood of confusion, where, as here, the parties are

plaintiff’s first claim for relief, which is further reflected by Louis Vuitton’s affirmative federal claims for infringement and unfair competition under the same statutory provisions. (Am. Counterclaims, at 48-52.)

using identical marks on identical goods sold to virtually identical customers.

Moreover, LVL XIII is also entitled to relief pursuant to N.Y. Deceptive Business Practices, Gen. Bus. L. § 349, which requires that a claimant show: (i) that the act, practice, or advertisement was consumer-oriented; (ii) that the act, practice, or advertisement was misleading in a material respect; and (iii) that the claimant was injured as a result of the deceptive act, practice, or advertisement. *See Pelman v. McDonald's Corp.*, 396 F. Supp. 2d 439, 444 (S.D.N.Y. 2005). While corporate competitors may bring a claim under this statute, they may do so only “so long as some harm to the public at large is at issue.” *Securitron Magnalock Corp. v. Schnabolk*, 65 F.3d 256, 264 (2d Cir. 1995). Courts in this district have routinely found violations of § 349, and therefore the requisite consumer-oriented behavior and resulting harm, in instances where a defendant used a designation “in a manner confusingly similar to [plaintiff’s] use of [its own] trademark, and caus[ed] actual confusion.” *GTFM, Inc.*, 215 F. Supp. 2d at 302; *see also Burberry Ltd. v. Designers Imps., Inc.*, 2010 U.S. Dist. LEXIS 3605, at *21 (S.D.N.Y. Jan. 19, 2010).

Here the existence of real public harm is neither amorphous nor absent from the record as defendants argue. Besides the arguments by LVL XIII’s expert, who has explicitly identified the particularized public harm suffered by virtue of Louis Vuitton’s misconduct, these harms have been corroborated by actual consumers of LVL XIII’s products. (*Compare* Report, ¶¶ 27-28, 39 *with* Bolton Decl., ¶¶ 5-6 *and* Roque Decl., ¶¶ 6-9.) Nor is there any question that Louis Vuitton engaged in deceptive acts by selling goods bearing LVL XIII’s Metal Toe Plate or that Louis Vuitton’s sale of the OTR Sneaker misleads consumers. Finally, the record has been made that Louis Vuitton has caused infringing products bearing LVL XIII Metal Toe Plate to enter the marketplace and has most assuredly harmed LVL XIII.

For these reasons, LVL XIII is entitled to summary judgment on its state law claims.

VI. LVL XIII IS ENTITLED TO A PERMANENT INJUNCTION AND DAMAGES.

A. Louis Vuitton should be permanently enjoined from selling footwear bearing the LVL XIII Metal Toe Plate.

Pursuant to 15 U.S.C. § 1116, a plaintiff is entitled to a permanent injunction as a standard remedy preventing any future trademark infringement by a defendant. To obtain a permanent injunction, a plaintiff must demonstrate “(1) actual success on the merits and (2) irreparable harm.” *Gucci Am., Inc. v. Duty Free Apparel, Ltd.*, 286 F. Supp. 2d 284, 290 (S.D.N.Y. 2003). LVL XIII has shown willful trademark infringement by Louis Vuitton. Louis Vuitton sold products bearing plaintiff’s Mark. Here, a permanent injunction preventing Louis Vuitton from selling any product bearing the Mark is appropriate. Such an injunction would both restrain Louis Vuitton from its infringing acts, provide a disincentive from future misconduct, put other potential wrongdoers on notice of the severe consequences of those acts and, of course, protect the plaintiff from further harm. *See Fendi Adele S.R.L. v. Burlington Coat Factory Warehouse Corp.*, 642 F. Supp. 2d 276, 303 (S.D.N.Y. 2009) (granting injunction to deter further trademark violations).

B. LVL XIII is Entitled to Actual Damages.

LVL XIII is entitled to actual damages for Louis Vuitton’s infringing conduct. The Lanham Act provides that a plaintiff is entitled to recover “(i) defendant’s profits, (ii) any damages sustained by the plaintiff, and (iii) the costs of the action.” 15 U.S.C. § 1117(a). Although the record here supports a finding of intentional conduct by defendants, “willfulness is not a prerequisite for an award of damages under § 1125(a).” *Cartier v. Aaron Faber, Inc.*, 512 F. Supp. 2d 165, 172 (S.D.N.Y. 2007) (citations omitted.)

Here, Louis Vuitton, over LVL XIII’s objection, refused to turn over documents showing the actual profits attributable to its sale of its OTR Sneaker. (*Compare* Dkt. No. 70 *with* 73.) Rather, Louis Vuitton stipulated “**LVL XIII would receive an award based on revenue, not profit**” in the event LVL XIII were to be successful on its claims. (Dkt. No. 70; emphasis in original.) In

accepting Louis Vuitton's limited refusal to comply with its discovery obligations, the Court wrote, in part:

Therefore, the Court declines to compel defendants to provide their gross or net profit figures. However, defendants are forewarned that, if LVL XIII succeeds in proving the alleged trademark infringement and its entitlement to an award of lost profits, **LVL XIII will then be entitled to damages based on the total amount of sales, not defendants' profits.** Even though this figure unquestionably represents an overstatement of ... profits, having failed to submit any evidence of net revenue, costs, or other reductions, defendants cannot fairly complain.

(Dkt. No. 75 at 3; quotations and citations omitted; emphasis added). In discovery, LVL XIII elicited that Louis Vuitton generated \$764,000 in revenues from its sale of the OTR Sneaker from March 4 through September 13, 2014. (Battaglia Tr. at 64:22-65:5; JSF, ¶ 56) These revenues were attributable to the sale of 714 units. (*Id.* at 65:15-66:1; JSF, ¶ 56.) Accordingly, and in view of the foregoing arguments, LVL XIII is entitled to at least \$764,000 in damages arising from Louis Vuitton's infringing and unlawful conduct.

C. LVL XIII is Entitled to Punitive Damages.

Under New York law, an award of punitive damages for unfair competition is appropriate where defendant "acted knowingly and with reckless disregard" of plaintiff's rights. *Murphy Door Bed Co. v. Interior Sleep Systems, Inc.*, 874 F.2d 95, 103-104 (2d Cir. 1989). Having demonstrated that Louis Vuitton acted "knowingly and with reckless disregard" of LVL XIII's legitimate interests in its Mark, plaintiff prays that the Court enter an order awarding plaintiff treble damages in the amount of three times Louis Vuitton's total revenues attributable to the OTR Sneaker from March 4 through September 13, 2014, in an amount not less than \$2,292,000, plus applicable interest. (Dkt. No. 1, Wherefore Clause, ¶ G.)

VII. LVL XIII IS ENTITLED TO SUMMARY JUDGMENT DISMISSING EACH OF DEFENDANTS' COUNTERCLAIMS.

Louis Vuitton asserts counterclaims for (i) a declaratory judgment; (ii) a mandatory injunction; (iii) federal trademark infringement; (iv) violation of federal unfair competition law; and (v) deceptive business practices pursuant to N.Y. Gen. Bus. L § 349 based on LVL XIII's

alleged infringement of Louis Vuitton’s trademarks by virtue of selecting and using its LVL XIII Word Mark. (*See generally*, Am. Counterclaims.) Each of these claims warrant dismissal, both on the record in their own rights and because two preliminary defenses bar Louis Vuitton’s affirmative claims in their entirety.

A. Defendants’ claims are barred by the affirmative defenses of laches and acquiescence.

Laches¹⁵ is an equitable defense that bars both injunctive and monetary relief where, as here, a claimant unreasonably delays in commencing an action. *See Hot Wax, Inc. v. Turtle Wax, Inc.* 191 F.3d 813, 822 (7th Cir. 1999) (while “laches is an equitable doctrine, courts increasingly apply it in cases at law in which plaintiffs seek damages”). “The Lanham Act itself states that a plaintiff who has prevailed is entitled to monetary relief only ‘subject to the principles of equity.’” *McCarthy*, § 31:4, citing Lanham Act § 35(a), 15 U.S.C.A. §1117(a). The determination of whether laches bars Louis Vuitton from relief is a legal one that is entirely within the discretion of the trial court rather than the jury. *See Robins Island Preservation Fund, Inc. v. Southold Dev. Corp.*, 959 F.2d 409, 423 (2d Cir. 1992), *cert. denied*, 506 U.S. 1001 (1992). Laches will bar a recovery where: (1) the claimant knew of the defendant’s alleged misconduct; (2) the claimant inexcusably delayed in taking action; and (3) the defendant was prejudiced by the delay. *See e.g., Ikelionwu v. U.S.*, 150 F.3d 233, 237 (2d Cir. 1998); *Conopco, Inc. v. Campbell Soup Co.*, 95 F.3d 187, 192 (2d Cir. 1996). All of these elements are met here.

First, Louis Vuitton knew or should have known of LVL XIII’s intended use of both the Metal Toe Plate and the LVL XIII Word Mark on March 5th and 7th, 2013, respectively. That was the day after plaintiff applied for these marks with the PTO. Unlike a typical company which might merely be “put on notice” theoretically by such a filing, Louis Vuitton’s Rule 30(b)(6) corporate

¹⁵ There is a great deal of variance in the case law in discussing the equitable doctrine of “laches.” As used herein, “laches” refers to an unreasonable delay in filing suit; a failure to be timely or diligent. “Estoppel by laches” by contrast, is used to reference the type of delay in filing suit which causes prejudice to defendant and when weighed with all other relevant equitable factors, results in total bar to relief, be it injunctive, monetary or both.

designee, Tamara Taylor, testified that Louis Vuitton's Paris-based offices receive "**daily** reports" of all trademark applications filed with the PTO the previous day. (Deposition testimony of Tamara Taylor dated October 22, 2015 attached as Exhibit 29 to the MacMull Decl. ("Taylor Tr.") at 46:15-47:2; emphasis added.) Louis Vuitton was again clearly made aware of LVL XIII's interests in its marks by no later than August 7, 2013 – the date on which both the last of LVL XIII marks was published in the PTO's *Official Gazette* (Sloane Decl., Ex. 32; JSF, ¶¶ 22, 24), after which any party who believes it may be damaged by registration of the mark has thirty (30) days from the publication date to file either an opposition to registration or a request to extend the time to oppose. *See* 15 U.S.C. § 1063(a); *see also id.* § 1062(a); 37 C.F.R. § 2.101.

But Louis Vuitton took absolutely no action whatsoever against either of LVL XIII's marks after March 2013, including after the marks were published for opposition on July 10, 2013. (JSF, ¶ 22.) With no impediments to the application for the LVL XIII Word Mark, the PTO issued a registration for the LVL XIII Mark on May 27, 2014. (JSF, ¶ 41.) LVL XIII, of course, also relied, so to speak, on Louis Vuitton's silence, though that is a overstatement; it had no reason even to anticipate anything but silence from Louis Vuitton, because its trademarks have nothing to do with Louis Vuitton.

Despite freely admitting to having never objected to "LVL XIII's use or registration of the mark LVL XIII in connection with footwear prior to December 22, 2014" (MacMull Decl., Ex. 30), Louis Vuitton nonetheless just as freely asserted counterclaims for infringement and unfair competition six months after plaintiff commenced this action in June 2014, three months after it filed its initial Answer. (*Compare* Dkt. No. 18 *with* Dkt. No. 40.) This delay is, under these circumstances, inexcusable. *See e.g., The Comic Strip, Inc. v. Fox Television Stations, Inc.*, 710 F. Supp. 976 (S.D.N.Y. 1989) (no injunctive relief where last communications between plaintiff and defendant occurred in November and December 1988 and action not commenced until March 15, 1989); *Inc. Publ'g Corp. v. Manhattan Magazine, Inc.*, 616 F. Supp. 370, 397 (S.D.N.Y. 1985),

aff'd without op., 788 F.2d. 3 (2d Cir. 1986) (following trial on the merits, four-month delay held to have weakened plaintiff's argument that confusion was likely; application for permanent injunction and accounting denied); *Nina Ricci, S.A.R.L. v. Gemcraft Ltd.*, 612 F. Supp. 1520, 1530 (S.D.N.Y. 1985) (no injunctive relief where plaintiff sent cease and desist letters in December 1984, parties communicated by phone between January 16 and February 1, 1985, and action not filed until March 15, 1985); *see also, Romag Fasteners, Inc. v. Fossil, Inc.*, 29 F. Supp. 3d 85, 102 (D. Conn. 2014) (plaintiff's "five-month delay before filing suit was inexcusable"); *Allens Creek/Corbetts Glen Preservation Group, Inc. v. Caldera*, 88 F.Supp.2d 77, 83 (W.D.N.Y. 2000) (plaintiffs' eight-month delay between learning of defendants' alleged violation of Clean Water Act and commencement of legal action challenging construction project was unreasonable delay supporting defendants' laches defense).

Louis Vuitton also has no reasonable excuse for its long period of resting on its purported rights. It clearly had the financial resources to afford counsel and whatever litigation expenses would have been incurred had it acted sooner, actions which would have been consistent with its admitted "robust" and "zealous enforcement of its trademark interests in the United States." (Taylor Tr. at 46:10-14.) Nor has there been a material change in the nature of the goods provided under the LVL XIII marks, since LVL XIII first began to offer its footwear in the summer of 2013 and continued to do so through the time this action was commenced in June 2014. (Brown Tr. at 451:23-452:24; JSF, ¶¶ 21-23.) LVL XIII further expended significant resources completing its launch and nationwide distribution of its footwear subsequent to its introduction in July 2013. Moreover, Louis Vuitton has been aware since at least March 2013, when they first learned of LVL XIII's trademark applications, that the LVL XIII Word Mark was to be used in connection with the broad category of "footwear" without limitation.¹⁶ When the goods or services listed in a

¹⁶ This argument is not intended, nor should it be construed as, being at odds with plaintiff's statement above that "LVL XIII as it applies to this case, is only asserting rights in the Metal Toe Plate with respect to men's sneakers; not women's shoes, boots, or even men's footwear generally" (section II.D, *supra*). Of course, the doctrine of

registration are not limited to a specific subset, the registration covers the full range of goods or services described in the registration. *See e.g., Redken Labs., Inc. v. Clairol, Inc.*, 501 F.2d 1403, 1404 (9th Cir. 1974); *A&H Sportswear Co., Inc. v. Victoria's Secret Stores, Inc.*, 926 F. Supp. 1233, 1267, (E.D. Pa. 1996), *aff'd*, 166 F.3d 191 (3d Cir. 1999); *H.W. Carter & Sons, Inc. v. William Carter Co.*, 913 F. Supp. 796, 803 (S.D.N.Y. 1996). The LVL XIII Word Mark's registration to which Louis Vuitton failed to object or oppose therefore creates a strong presumption of the validity of the mark and of LVL XIII's exclusive right to use that mark in the broad category of goods specified in its registration. *See, e.g., H.W. Carter & Sons*, 913 F. Supp. at 803, *citing American Home Prods. Corp. v. Johnson Chem. Co.*, 589 F.2d 103, 106 (2d Cir. 1978).

Louis Vuitton delayed taking action at its own risk, and LVL XIII would suffer severe prejudice if it were enjoined from using its LVL XIII Word Mark in which it has created significant goodwill over the past three years while Louis Vuitton sat on its "rights." LVL XIII has steadily expanded the scope and quantity of goods offered under its marks since July 2013, including developing a new collection, but for a brief five- or six-month period of cessation in 2014 that was attributable to Louis Vuitton's infringement and the ill-effects of reverse confusion. (Brown Tr. at 408:13:409:18; 448:11-448:24; 451:23-452:24.) Requiring LVL XIII to change its name after Louis Vuitton's years of inaction would unfairly compromise those efforts spent establishing the brand and cause unfair prejudice to LVL XIII. *See e.g., Conopco, Inc.*, 95 F.3d at 192-93. The equitable doctrine of estoppel by laches should therefore bar Louis Vuitton from inflicting this undue prejudice on LVL XIII as Louis Vuitton simply cannot meet its burden to show an absence of genuine issue of material fact on the issue of laches.

laches goes to the heart of when a claimant had sufficient notice by which to assert its rights. Here, this should be presumed to be the earliest of all possible dates (March 2013) by virtue of not only testimony that Louis Vuitton receives a report of all trademark applications filed with the PTO the next day, but it, like the rest of mankind, has a clear understanding that "sneakers are a subset of shoes." (Deposition testimony of Michael Mazis, dated November 23, 2015 attached as Exhibit 31 to the MacMull Decl. ("Mazis Tr.") at 20:1-6.)

Louis Vuitton's counterclaims are also barred under the related doctrine of acquiescence, whose second and third elements are the same as those for laches, but which differs with respect to the first element, which in acquiescence is that the senior user **actively** represents that it will not assert a right or a claim against the junior user's adoption of the mark. *See ProFitness Physical Therapy Center v. Pro-Fit Orthopedic and Sports Physical Therapy P.C.*, 314 F.3d 62, 67 (2d Cir. 2002). Even then such a representation need not be express, but instead may be implicit based on direct interaction between the two parties and a failure to object when the junior user would reasonably expect to receive notice if the senior trademark user objected. *See id.* at 68.

Such an implied representation was made by Louis Vuitton in this case when its New York-based counsel, John Maltbie, was directly informed by LVL XIII's counsel in a face-to-face meeting on or about August 4, 2014, that plaintiff had been using its marks since at least as early as July 2013 and planned to continue doing so in the future. (MacMull Decl., 14; Dkt No. 33, ¶ 10(a) (acknowledging the parties exchanged information and attempted to settle the matter in August 2014).) Louis Vuitton's continuous silence and failure to take action against the use and registration of the LVL XIII Word Mark for another four-plus months after this in-person meeting served as "implicit assurance" that it would not assert any trademark rights against LVL XIII and, along with the prejudice that LVL XIII would suffer, justifies the application of the equitable doctrine of acquiescence to bar the relief sought here.

Additionally, Louis Vuitton's failure to object to the rampant third-party use of the letters "LV" in the apparel industry further induced LVL XIII to believe that Louis Vuitton would not object to its use of the LVL XIII Word Mark. (Answer and Affirmative Defenses to Amended Counterclaims (Dkt. No. 42) ("Answer"), Ninth Affirmative Defense.) Silence on the part of a claimant may give rise to acquiescence. *See ProFitness*, 314 F.3d at 68-69 (plaintiff's continued silence in response to defendant's counter to a cease and desist letter constitutes acquiescence). Here, it is not just Louis Vuitton's silence vis-à-vis LVL XIII's use that gives rise to acquiescence

(though that silence does give rise to LVL XIII's laches defense), its long silence as to the numerous, open, and obvious third-party trademark uses of the highly diluted, and hence weak, trademark formative "LV" in connection with apparel goods did so as well. *See id.* (MacMull Decl., Ex. 33.) As such, there remains no genuine issue of material fact concerning Louis Vuitton's clear acquiescence.

For all of the reasons stated above, all of the elements necessary to establish the affirmative defenses of either laches or acquiescence are present here, and the Court should bar Louis Vuitton's claims for injunctive and monetary relief on its counterclaims on these grounds alone.

VIII. PLAINTIFF IS ENTITLED TO SUMMARY JUDGMENT ON DEFENDANTS' CLAIM FOR DECLARATORY RELIEF.

The Court should also dispose of LV's First Counterclaim for relief seeking "a declaratory judgment that LVL XIII has no enforceable trademark rights." (Am. Counterclaims, ¶¶ 82-91.) This counterclaim is a mirror image of LVL XIII's Complaint as supported by the record and therefore should be dismissed as duplicative. (Answer, Third Affirmative Defense.) Not only is Louis Vuitton's claim defective as pled, the record is entirely bare of any evidence supporting its allegation of an "independent" case or controversy.

The Declaratory Judgment Act by its express terms vests a district court with discretion to determine whether it will or will not exert jurisdiction over a proposed declaratory action. The statute provides that in "a case of actual controversy within its jurisdiction ... any court of the United States ... may declare the rights and other legal relations of any interested party seeking such declaration, whether or not further relief is or could be sought." 28 U.S.C. § 2201(a). Courts have consistently interpreted this language as a broad grant of discretion to district courts to refuse to exercise jurisdiction over a declaratory action that they would otherwise be empowered to hear. *See Wilton v. Seven Falls Co.*, 515 U.S. 277, 286 (1995); *Dow Jones & Co. v. Harrods Ltd.*, 346 F.3d 357, 359 (2d Cir. 2003). Declaratory judgment counterclaims are thus routinely dismissed where, as here, the claims are mirror images of the plaintiff's allegations. *See Arista Records LLC*

v. Usenet.com., Inc., 2008 U.S. Dist. LEXIS 95514, at *14 (S.D.N.Y. Nov. 24, 2008) (dismissing defendant’s counterclaim for declaratory judgment as being mirror image of plaintiff’s copyright infringement claim); *Maverick Recording Co. v. Chowdhury*, 2008 U.S. Dist. LEXIS 63783, at *3 (E.D.N.Y. Aug. 19, 2008) (“The central issue in these cases is whether the defendants committed copyright infringement, and the defendants’ counterclaim seeking a declaratory judgment that they did not is duplicative and entirely redundant,” counterclaim dismissed).

Louis Vuitton’s First Counterclaim is a mirror image of LVL XIII’s cause of action for trademark infringement. (*Compare* Compl., ¶¶ 47-56 with Am. Counterclaims, ¶¶ 82-91.) To establish trademark infringement, LVL XIII must, as noted above, prove that it has valid rights in the trademarks it is seeking to enforce. Louis Vuitton seeks the reverse of what the Complaint seeks. LVL XIII seeks a determination that Louis Vuitton’s use of a metal toe plate infringes LVL XIII’s rights in its Mark. (Compl., ¶¶ 51-52.) Louis Vuitton merely seeks the opposite of this relief, i.e., a determination that its use of a metal toe plate does **not** infringe LVL XIII’s rights. (Am. Counterclaims, ¶ 87.) Because Louis Vuitton’s First Counterclaim is redundant, and reflects no independent case or controversy, and because, in fact, the record evidence and the law demonstrate to the contrary, defendants’ First Counterclaim should be dismissed.

IX. PLAINTIFF IS ENTITLED TO SUMMARY JUDGMENT ON LOUIS VUITTON’S CLAIM FOR A MANDATORY INJUNCTION.

Next, Louis Vuitton seeks “a mandatory injunction requiring LVL XIII to submit a disclaimer with respect to the ‘102 Application in the following standardized format: “No claim is made to the exclusive right to use ‘THE RECTANGULAR SHAPE OF THE TOE PLATE’ apart from the mark as shown.” (Counterclaims, ¶ 99.) “The purpose of a disclaimer is to permit the registration of a mark which is registrable as a whole but which contains matter which would not be registrable standing alone... .” T.M.E.P § 1213. Matter which is not registrable standing alone includes “matter which is merely descriptive.” *Id.* at 1213.02(a). Whether a mark is descriptive is a question of fact. *See In re Dayan*, 61 Fed. App’x. 695, 696 (Fed. Cir. 2003), citing *In re Dial-A-*

Mattress Operating Corp., 240 F.3d 1341, 1344 (Fed. Cir. 2001).

Dismissal of this claim is appropriate on numerous grounds, all of which amount to different approaches to the same point, mainly that the relief requested is inappropriate – whether in terms of the Court’s statutory jurisdiction, Louis Vuitton’s standing or under the comity-like doctrine of primary jurisdiction. While the PTO has statutory power to grant, deny and cancel federal trademark registrations, and district courts have certain concurrent powers over registrations. Section 37 of the Lanham Act states rather broadly:

In any action **involving a registered mark** the court may determine the right to registration, order the cancelation of registrations, in whole or in part, restore cancelled registrations, and **otherwise rectify the register with respect to the registrations** of any party to the action.

15 U.S.C. § 1119 (emphasis added). A Section 37 claim, however, “must involve an existing ‘registered mark,’ not one that may come into existence in the future.” *Dunn Computer Corp. v. Loudcloud, Inc.*, 133 F. Supp. 2d 823, 831 (E.D. Va. 2001). *Accord, GMA Accessories, Inc. v. Idea Nuova, Inc.*, 157 F. Supp. 2d 234, 241 (S.D.N.Y. 2000) (dismissing claim to “cancel” mark in trademark application). While LVL XIII acknowledges that this action involves a registered mark, thus meeting the qualification set forth in the first clause of Section 37 above, the more precise question of whether a district court has the authority, and therefore jurisdiction, to enmesh itself in the administrative process of trademark registration by mandating a **disclaimer** was affirmatively rejected in *Top Producer Sys. v. Software Sciences Ltd.*, 1997 U.S. Dist. LEXIS 12368 (D. Or. July 21, 1997). As that court explained, “[N]either party has cited, nor can I find any statutory provision or case law which gives the court the jurisdiction to enter a disclaimer or cancel a mark based upon failure to disclaim. Accordingly, [this court] find[s] that [it] lack[s] jurisdiction to enter a disclaimer or to cancel a mark based upon failure to disclaim.” *Id.* at *7.

No such authority exists. Indeed, Lanham Act § 6, 15 U.S.C. § 1056 states:

- (a) **The Director may** require the applicant to disclaim an unregistrable component of a mark otherwise registrable. **An applicant** may voluntarily disclaim a component of a mark sought to be registered.

(emphasis added.) Moreover, Lanham Act § 7(e), 15 U.S.C. § 1057(e), further states in relevant part:

Upon application **of the owner** and payment of the prescribed fee, **the Director** for good cause may permit **any registration** to be amended or to be disclaimed in part: Provided, That the amendment or disclaimer does not alter materially the character of the mark. Appropriate entry shall be made in the records of the United States Patent and Trademark Office and upon the certificate of registration.

(emphasis added.) As the above language states, only the Director, applicant, or later registrant, has standing to disclaim a component of a mark; the statute does not provide a third-party such as Louis Vuitton, to intercede and make such a demand.

This counterclaim is also barred under the doctrine of primary jurisdiction, which is “appropriate whenever enforcement of the claim requires the resolution of issues which, under a regulatory scheme, have been placed within the special competence of an administrative body.” *Ellis v. Tribune Television Co.*, 443 F.3d 71, 81 (2d Cir. 2006) (citations and quotations omitted). The rationale for the doctrine arises from “a concern for maintaining uniformity in the regulation of an area entrusted to a federal agency, as well as a desire for utilizing administrative expertise.” *Id.* at 82 (internal citations omitted).

The test for determining whether application of the doctrine is appropriate is evaluated on a case-by-case basis, typically in consideration of the following four factors in this Circuit: (i) whether the question at issue is within the conventional experience of judges or whether it involves technical or policy considerations within the agency’s particular field of expertise; (ii) whether the question at issue is particularly within the agency’s discretion; (iii) whether there exists a substantial danger for inconsistent rulings; and (iv) whether a prior application to the agency has been made. *Id.* at 82-83 (citations and quotations omitted). If judicial abstention is appropriate the court “defers to the agency for advisory findings and either stays the pending action or dismisses it without prejudice. In doing so, the court must take care that its deferral does not unfairly disadvantage either party.” *Johnson v. Nayack Hosp.*, 86 F.3d 8, 11 (2d Cir. 1996).

Regarding the first factor, and in view of the above, any suggestion that disclaiming a component feature of a mark does not call upon the technical or policy considerations within PTO's designated field of expertise is not credible. *See Dena Corp. v. Belvedere Inter., Inc.*, 950 F.2d 1555, 1560 (Fed. Cir. 1991) ("A disclaimer shows that the applicant enjoys no exclusive rights to the disclaimed symbols apart from the composite mark."); *In re Ebs Data Processing, Inc.*, 212 U.S.P.Q. 964, 966 (T.T.A.B. 1981) ("Disclaimers are often required of portions of composite marks in order that it might be understood that a significant element of a composite mark is not being exclusively appropriated by itself apart from the composite."); *see also* T.M.E.P. § 1213, citing to the Director's discretion as set forth in Lanham Act § 6, 15 U.S.C. § 1056. The language of these citations alone simply reinforces the specialization conferred upon the PTO for this purpose; indeed, district courts have repeatedly deferred to the greater technical expertise of the PTO in a variety of instances in which the government's primary jurisdiction was not in dispute at all. *See C-Cure Chem. Co. v. Secure Adhesives Corp.*, 571 F. Supp. 808, 824 (W.D.N.Y. 1983) (court proceedings stayed under doctrine of primary jurisdiction pending outcome of T.T.A.B. cancellation proceeding; deferring to T.T.A.B. expertise); *Driving Force, Inc. v. Manpower, Inc.*, 498 F. Supp. 21, 26 (E.D. Pa. 1980) (proceedings stayed under doctrine of primary jurisdiction pending outcome of T.T.A.B. cancellation proceeding. In fact, the court in *Driving Force* refused to continue the stay pending an appeal from the Board decision, and followed the Board result. 538 F. Supp 57 (E.D. Pa. 1982).

Concerning the second factor, whether the decision to ultimately require LVL XIII to disclaim "the rectangular shape of the shoe toe plate" for footwear in International Class 25 as set forth in the '102 Application is unquestionably within the PTO's discretion. *See* Lanham Act § 6, 15 U.S.C. § 1056. As the Court of Appeals for the Federal Circuit noted just two months ago:

Under the Lanham Act, the PTO **must** register source-identifying trademarks **unless** the mark falls into one of several categories of marks precluded from registration. *Id.* § 1052 ("No trademark by which the goods of the applicant may be distinguished from the goods of others *shall be refused registration on the*

principal register on account of its nature unless” (emphasis added)).

In re Tam, 808 F.3d 1321, 1329 (Fed. Cir. 2015) (added emphasis in bold). Because it is within the discretion of the PTO (or an applicant or registrant, as the case may be) to determine whether a composite mark as used in commerce will remain unaffected without regard to the component in question, this factor weighs in favor of applying the primary jurisdiction doctrine.

The third factor, the danger of inconsistent rulings, is also present here. In addition to *Top Producer* in which the district court explicitly declined to exercise jurisdiction over a similar “demand”, the PTO is also simultaneously contemplating this same issue. *See Ellis*, 443 F.3d at 88 (“Courts should be especially solicitous in deferring to agencies that are simultaneously contemplating the same issues.”) And, while the PTO has, at LVL XIII’s request, currently suspended the ‘102 Application (JSF, ¶ 45), “an applicant’s request for a suspension of action under this section filed within the 6-month response period . . . may be considered **responsive** to the previous Office action.” 37 C.F.R. § 2.67; T.M.E.P. § 716.02(d) (emphasis added). Additionally, because the PTO has not issued a final determination as to the ‘102 Application, it cannot be said, despite Louis Vuitton’s suggestion to the contrary, that ordering a disclaimer is an issue ripe for this Court’s review. Thus, while the ‘102 Application is “dormant” by virtue of the PTO’s grant of a suspension pending the outcome of LVL XIII’s infringement claims in this case, the ‘102 Application is still nevertheless a “live” application before the PTO. (MacMull Delc., Ex. 34.)

The fourth factor, whether a prior application to the agency has been made, also counsels in favor of the doctrine being invoked here. *Ellis*, 443 F.3d at 89. Finally, to the extent Louis Vuitton might argue that referral to the PTO would result in undue delay and a rejection of practical considerations of judicial economy and a concomitant streamlining of judicial review, such arguments have explicitly been rejected by the Second Circuit. *See id.* at 90. The Supreme Court has consistently held that there are only two purposes to consider in determining whether to apply

the primary jurisdiction doctrine – uniformity and expertise. Judicial economy is not one of them. *See id.*

For all the foregoing reasons, Louis Vuitton’s second cause of action seeking a mandatory injunction should be dismissed.

X. PLAINTIFF IS ENTITLED TO SUMMARY JUDGMENT ON LOUIS VUITTON’S FEDERAL TRADEMARK INFRINGEMENT CLAIM.

Louis Vuitton asserts infringement by LVL XIII of its federally registered “LV Initials Logo Trademark[s]” under Section 43(a) of the Lanham Act. (Am. Counterclaims, ¶¶ 61-62; 100-112.) As discussed above, a successful claimant must demonstrate both parts of a two-pronged test. “The test looks first to whether the plaintiff’s mark is entitled to protection, and second to whether defendant’s use of the mark is likely to cause consumers confusion as to the origin or sponsorship of the defendant’s goods.” *Virgin*, 335 F.3d at 146. LVL XIII concedes the first prong of this test, but the not the second.

A. Louis Vuitton cannot establish a likelihood of confusion between the parties’ marks.

Again, in this Circuit a likelihood of confusion analysis is governed by the eight factors enunciated in the landmark *Polaroid Corp.* decision addressed at length above. *See Polaroid Corp.*, 287 F.2d at 495. Here, the discussion of these factors is limited to three factors of particular note: (i) the similarity of the parties’ marks; (ii) the impact of the use by third-parties of “LV” marks on the strength of the trademarks owned by Louis Vuitton; and (iii) the existence of actual confusion among consumers.¹⁷

1. The parties’ marks are dissimilar.

“In assessing similarity, courts look to the overall impression created by the logos and the

¹⁷ The *Polaroid* factor concerned with bad faith is also worthy of some comment here. In opposition, Louis Vuitton is likely to spend time trying to establish that LVL XIII adopted its LVL XIII Mark in bad faith, relying on everything from Brown’s conceded, longstanding knowledge of Louis Vuitton and its LV monogram mark (Brown Dep. 83:17-21); the purported inadequacies of LVL XIII’s trademark counsel in clearing the LVL XIII trademark; and the intentions of the graphic design firm retained by LVL XIII to develop its marketing materials years after LV Initials Logo trademark was first used in the U.S. All of this “evidence” is irrelevant, baseless, benign or all of the above, and

context in which they are found and consider the totality of factors that could cause confusion among prospective purchasers.” *Gruner + Jahr*, 991 F.2d at 1078. “In deciding whether the marks are similar as used, [a court does] not look just at the typewritten and aural similarity of the marks, but how they are presented in the marketplace.” *The Sports Auth., Inc. v. Prime Hospitality Corp.*, 89 F.3d 955, 962 (2d Cir. 1996).

Nothing in the record remotely suggests that anything approaching the LV Initials Logo mark has **ever** been used by LVL XIII, whose use of the Roman characters “L” and “V” has **always been** accompanied by the additional characters “L X-I-I-I”. The totality of these distinctions, past or present, between Louis Vuitton’s Initials Logo mark and LVL XIII’s LVL XIII Word Mark weighs against any likelihood of confusion. *See e.g., Strange Music, Inc. v. Strange Music, Inc.*, 326 F. Supp. 2d 481, 490-91 (S.D.N.Y. 2004) (finding dissimilar overall impression between marks whose “fonts, colors and emblems” were not alike); *Dana Braun, Inc. v. SML Sport Ltd.*, 2003 U.S. Dist. LEXIS 21349, at *31 (S.D.N.Y. Nov. 24, 2003) (finding no similar overall impression where the marks had “different color schemes, different design elements, and different typefaces”). That is why Louis Vuitton did not file an opposition in the first place.

2. The strength of the LV Initials Logo Marks are seriously diminished by extensive third-party use.

Because of its descriptive qualities as an abbreviation, the “LV” component of Louis Vuitton’s marks, which here comprises its **entire** mark, is frequently used by other companies as either a prefix, suffix, or the entirety of, their trademark or trade name. In the apparel goods industry, there are a number of other companies using “LV” in connection with their businesses and even more “LV” businesses in other industries. (MacMull Decl., Ex. 33.) These extensive

none of the evidence demonstrates any intent by LVL XIII to take a “free ride” on the LV monogram. Moreover, none of this can alter the incontrovertible fact that no trademark owner that believed confusion between its mark and that of another was likely would have done nothing for a period of more than two years, as Louis Vuitton did. This is particularly true here given the resources available to Louis Vuitton and its admission that it maintains a “robust enforcement campaign.” (Taylor Tr. at 46:10-14.) The béchamel sauce Louis Vuitton will try to throw at LVL XIII on this point will not stick.

third-party use weakens Louis Vuitton's marks because they demonstrate that consumers do not identify the term "LV" exclusively with Louis Vuitton, either in the broad category of luxury apparel goods or elsewhere. *See e.g., Streetwise Maps, Inc. v. Vandam, Inc.*, 159 F.3d 739, 744 (2d Cir. 1998); *Estee Lauder Inc. v. The Gap, Inc.*, 108 F.3d 1503, 1511 (2d Cir. 1997); *Franklin Res., Inc. v. Franklin Credit Mgmt. Corp.*, 988 F. Supp 322, 328 (S.D.N.Y. 1997). Indeed, "a Court may find that a mark does not infringe another mark where the common word between the two marks is used by many parties." *Dana Braun, Inc.*, 2003 U.S. Dist. LEXIS 21349, at *28. Further, Louis Vuitton cannot demonstrate that they own a family of marks when the common term in that "family" (Am. Counterclaims, ¶¶ 61-62) is used more commonly by third-parties than it is by the mark holder. *See Spraying Sys. Co. v. Delavan, Inc.*, 975 F.2d 387, 395 (7th Cir. 1992) (holding that no family of marks existed where the common component was descriptive without secondary meaning in and of itself). Certainly, Louis Vuitton has offered nothing in the way of admissible evidence in this case to support an alternative conclusion.

3. Despite Louis Vuitton's allegations of the existence of actual confusion, there is no record evidence of actual confusion.

It is a commonplace that while a trademark infringement claimant is not required to demonstrate actual consumer confusion in support of its claim, *Coach Leatherwear Co.*, 933 F.2d at 170-71, actual confusion is nevertheless the best evidence of a likelihood of confusion. *See Sterling Drug, Inc. v. Bayer AG*, 792 F. Supp. 1357, 1375 (S.D.N.Y. 1992), *vacated in part on other grounds*, 14 F.3d 733 (2d Cir. 1994). Louis Vuitton, always eager to have "the best" of everything, therefore alleged that it there was such confusion – alleging that "LVL XIII's conduct has caused, and will likely continue to cause, confusion, mistake, and deception among the general consuming public about the origin and quality of the [LV Initials Logo Trademark and Louis Vuitton's rights to the 'LV' initials.]" (Am. Counterclaims, ¶¶ 103, 106.) – even though it could not possibly have had a good faith basis to make this allegation in its pleading.

It never produced any evidence of such confusion, mistake or deception, and its 30(b)(6)

witness testified there was not any. (Battaglia Tr. at 116:23-118:2.) This counterclaim should be dismissed.

XI. PLAINTIFF IS ENTITLED TO SUMMARY JUDGMENT ON LOUIS VUITTON'S FEDERAL FALSE DESIGNATION OF ORIGIN AND UNFAIR COMPETITION CLAIM.

Louis Vuitton alleges false designation of origin and unfair competition under Section 43(a) of the Lanham Act (Am. Counterclaims, ¶¶ 113-119.) Under the Lanham Act § 43(a)(1)(A), to show unfair competition and false designation of origin, Louis Vuitton must prove “(i) the existence of a valid mark, and (ii) that the defendant’s actions are likely to confuse the buying public, that is, ‘an appreciable number of ordinarily prudent purchasers.’” *Twentieth Century Fox*, 155 F. Supp. 2d at 20 (quoting *E.G.L. Gem Lab Ltd. v. Gem Quality Institute, Inc.*, 90 F. Supp. 2d 277, 292 (S.D.N.Y. 2000)). Louis Vuitton’s Section 43(a) claims are governed by the same legal analysis as its federal infringement claims. *See, e.g., Lois Sportswear, U.S.A.*, 799 F.2d at 871; *Starbucks Corp. v. Wolfe’s Borough Coffee, Inc.*, 2004 U.S. Dist. LEXIS 19239, at *12 (S.D.N.Y. Sept. 28, 2004) (treating Lanham Act infringement and Section 43(a) claims together). Accordingly, because Louis Vuitton’s infringement claim fails, so too must its Section 43(a) claim.

XII. PLAINTIFF IS ENTITLED TO SUMMARY JUDGMENT ON LOUIS VUITTON'S STATE LAW CLAIM.

In addition to its federal claims, Louis Vuitton asserts violations of New York’s deceptive business practices pursuant to N.Y. Gen. Bus. L. § 349. Because there is no evidence in the record that even remotely supports this claim, this claim too must be dismissed. The legal test for a claim under this provision is set out above concerning LVL XIII’s affirmative claim against Louis Vuitton, in Section V, *supra*. Here, not only has Louis Vuitton failed to proffer any evidence of a likelihood of a “significant risk of harm to the public health,” *DePinto v. Ashley Scott, Inc.*, 222 A.D.2d 288, 635 N.Y.S.2d 215 (1st Dept. 1995), nor of any specific injury to the public interest whatsoever beyond a general likelihood of consumer confusion sounding entirely in trademark, it has failed to even allege such an injury altogether. (*See generally*, Am. Counterclaims.) This claim

was a makeweight from Day One, and, accordingly, dismissal is appropriate.

CONCLUSION

For all the foregoing reasons, LVL XIII Brands, Inc. respectfully requests this Court enter an Order (i) granting summary judgment in favor of plaintiff in its entirety; (ii) denying Louis Vuitton's motion in support of summary judgment in its entirety; (iii) dismissing Louis Vuitton's Amended Counterclaims in their entirety with prejudice; (iv) awarding plaintiff all of its reasonable attorneys' fees and costs incurred in connection with this litigation; and (v) awarding such other and further relief as this Court may deem just and appropriate.

Respectfully submitted,



Ronald D. Coleman (RC 3875)

Joel MacMull (JM 8239)

ARCHER & GREINER P.C.

44 Wall Street, 12th Floor

New York, NY 10005

Tel.: (212) 292-4998

Fax: (212) 461-2223

rcoleman@acherlaw.com

jmacmull@archerlaw.com

*Attorneys for Plaintiff /Counterclaimant
LVL XIII Brands, Inc.*

Dated: February 16, 2016