

IN THE UNITED STATES DISTRICT COURT
FOR THE SOUTHERN DISTRICT OF MISSISSIPPI
WESTERN DIVISION

RONALDO DESIGNER JEWELRY, INC.

PLAINTIFF

VS.

CIVIL ACTION NO. 5:14-cv-73(DCB)(MTP)

PHILLIP PRINZO

DEFENDANT

ORDER GRANTING MOTION FOR PRELIMINARY INJUNCTION

This cause is before the Court on the plaintiff Ronaldo Designer Jewelry, Inc. ("Ronaldo")'s Motion for Preliminary Injunction (**docket entry 31**). Ronaldo moves for a preliminary injunction pursuant to Fed.R.Civ.P. 65(a) to (1) enjoin the plaintiff, Phillip Prinzo ("Prinzo"), from copying, manufacturing, reproducing, importing, publishing, displaying, distributing, transmitting, selling or otherwise placing on the market the jewelry, marketing and advertising materials which Ronaldo contends infringe upon Ronaldo's copyrights, trademarks, and trade dress ("Infringing Works" or "Works"); (2) to require Prinzo to immediately withdraw from all sales outlets any and all inventory of the jewelry, marketing, and advertising materials which Ronaldo contends infringe upon Ronaldo's copyrights, trademarks, and trade dress; and (3) to require Prinzo to identify each and every person or entity from whom Prinzo has acquired any and all Infringing Works and to whom Prinzo has licensed, assigned, or otherwise transferred the right to reproduce, manufacture, display, distribute, or sell jewelry which Ronaldo contends infringes upon

Ronaldo's copyrights, trademarks, and trade dress.

Ronaldo makes its motion on grounds that immediate and irreparable injury, loss, or damage will result to Ronaldo if Prinzo, or those with whom Prinzo is in concert or privity, are permitted to copy, reproduce, manufacture, import, market, display, promote, distribute, license, and sell the Infringing Works. Ronaldo also makes its motion on grounds that immediate and irreparable injury will result to Ronaldo if an injunction is not granted.

Ronaldo's Verified Complaint seeks relief from copyright infringement, trademark infringement, trade dress infringement, unfair competition, and false advertising. The Complaint also seeks a permanent injunction restraining Prinzo from infringing Ronaldo's Catalogs and Designs, Works, Trade Dress, and trademark; from manufacturing, reproducing, importing, publishing, displaying, distributing, transmitting, selling, or otherwise placing on the market the Infringing Works; and from using such Catalogs and Designs, Works, Trade Dress, and trademark without authorization. Complaint, p. 6.

In response to the Motion for Preliminary Injunction, Prinzo states that "[s]ome of the pieces I make may be similar to Ronaldo's but they are not identical." Response, p. 2. In rebuttal, Ronaldo states: "Plaintiff does not seek to prevent Defendant from making wire jewelry. Plaintiff simply seeks an

injunction preventing Defendant from copying Plaintiff's copyrighted designs and trade dress. The Defendant should in no way be restricted from making his own original wire jewelry designs." Plaintiff's Reply, p. 1.

The decision whether to grant a preliminary injunction is within the discretion of the district court. Allied Mktg. Group, Inc. v. CDL Mktg., Inc., 878 F.2d 806, 809 (5th Cir. 1989). "[A] preliminary injunction is [meant] to preserve the status quo and thus prevent irreparable harm until the respective rights of the parties can be ascertained during a trial on the merits." Exhibitors Poster Exch., Inc. v. Nat'l Screen Serv. Corp., 441 F.2d 560, 560 (5th Cir.1971)(per curiam)(citations omitted).

"[A movant] seeking a preliminary injunction must show: (1) a substantial likelihood of success on the merits, (2) a substantial threat that [the movant] will suffer irreparable harm if the injunction is not granted, (3) that the threatened injury outweighs any damage that the injunction might cause the [non-movant], and (4) that the injunction will not disserve the public interest." Nichols v. Alcatel USA, Inc., 532 F.3d 364, 372 (5th Cir.2008) (citing Planned Parenthood of Houston & S.E. Tex. v. Sanchez, 403 F.3d 324, 329 (5th Cir.2005)). Because a preliminary injunction is an "extraordinary remedy," the movant must "clearly carr[y] the burden as to all four elements." Guy Carpenter & Co., Inc. v. Provenzale, 334 F.3d 459, 464 (5th Cir.2003)(citing Kern River Gas

Transmission Co. v. Coastal Corp., 899 F.2d 1458, 1462 (5th Cir. 1990)).

Intellectual property law looks more favorably upon this form of injunctive relief than do other areas of law. Courts recognize the social and commercial importance of protecting the intangible rights inhering in a copyrighted work, and have noted that "the public interest can only be served by upholding copyright protections." See, e.g., Apple Computer, Inc. v. Franklin Computer Corp., 714 F.2d 1240, 1255 (3rd Cir. 1983), cert. denied 464 U.S. 1033 (1984).

Ronaldo shows that its copyright, trademark, and trade dress infringement case has a high probability of success on the merits. Ronaldo and its predecessor-in-interest, Gold Craft Fashions, Inc. ("Gold Star"), have sold millions of items to jewelry stores and major retailers, generating millions of dollars in annual revenue in thirty-five states and five countries. Plaintiff's Memorandum, p. 1 (docket entry 32). Prinzo, as a former employee of Gold Craft, learned to make company-owned-and-designed jewelry and also served as a dealer of Gold Craft's products. Id. In 1994, Gold Craft and Prinzo terminated their relationship. The parties entered into a Mutual Release Agreement which does not grant Prinzo any right to sell or license intellectual property rights including any copyright or other rights to reproduce, sell or license jewelry design works, Trade Dress, or catalogs owned by Ronaldo and/or Gold

Craft. Id., p. 2. Ronaldo also asserts that it has learned that Prinzo is selling unauthorized copies of Ronaldo's Works, and is misrepresenting to jewelry retailers and other potential customers that he has the right to sell jewelry items depicted in Ronaldo's catalogs. Id.

Ronaldo shows that it will suffer irreparable business injury if its customers are confused into buying Prinzo's products believing they are genuine Ronaldo Collection designs. Ronaldo also shows that it will be irreparably harmed if its customers can go to Prinzo (or any of the retail outlets to which Prinzo sells) and purchase imitations of Ronaldo's products at prices lower than the prices Ronaldo's customers pay for the real Works.¹ Id., p.

¹ An illustrated comparison of Prinzo's products with those of Ronaldo, and other facts in support of Ronaldo's claims of copyright infringement, trademark infringement, and trade dress infringement are set forth in detail on pages 6 through 17 of Ronaldo's Memorandum (docket entry 32). In addition, Ronaldo has furnished the Court with the following appendices which will be attached to the Preliminary Injunction and incorporated by reference: Appendix 1 (materials that infringe upon Plaintiff's copyrights, Trade Dress, and "THE POWER OF PRAYER" BRACELET trademark (collectively the "Infringing Works")); Appendix 2 (copies of the Infringing Works); Appendix 3 (other jewelry or product substantially or confusingly similar to Ronaldo's Works, including without limitation "The Power of Prayer Bracelet," "The Tranquility Bracelet," "Stackable Bracelet," "THE "LOVE KNOT," "The Angelina Bracelet," "The Spring Time Bracelet," "I Love You," "TRC-S297 Birthstone Bracelet," "Forever Fellowship Bracelet," and the "Pearl of My Heart" Works); and Appendix 4 (materials using, incorporating, or containing Plaintiff's "THE POWER OF PRAYER" BRACELET® trademark or any mark or term similar thereto, or substantially similar to Plaintiff's copyrighted catalogs or website, including without limitation "Gold Craft Associates Dealer Handbook," "Gold Craft Fashions," and "Gold Craft Associates Fall Catalog 2000").

17. The threatened injury to Ronaldo therefore outweighs any damage that the injunction might cause Prinzo, and the injunction will not disserve the public interest.

Finally, Ronaldo asserts that the equities in this case favor a small bond requirement. Although the Federal Rules of Civil Procedure make the posting of security a prerequisite to granting the relief Ronaldo seeks, the Court has discretion to require whatever amount best serves the interests of justice. Fed.R.Civ.P. 65(c). The Court finds that any harm Prinzo may suffer due to the issuance of a preliminary injunction is limited, and results solely from Prinzo's decision to continue to sell copies of Ronaldo's Works. Ronaldo has made a prima facie case of copyright infringement, trademark infringement, and trade dress infringement, and is likely to succeed on the merits, having shown ownership, access, similarity, and likelihood of confusion. Ronaldo also stands to suffer irreparable harm if an injunction does not issue. The Court finds that a bond in the amount of One Thousand Dollars (\$1,000) will be sufficient security for the payment of any costs and damages that may be incurred or suffered in the event that Prinzo shall be found to have been wrongfully enjoined or restrained. See Registral.com, LLC v. Fisher Controls Intern., Inc., 2001 WL 34109376, *10 (S.D. Tex. June 28, 2001)(setting \$1,000 bond in trademark infringement case).

In light of the foregoing, the Court finds that a Preliminary

Injunction should issue and bond set accordingly.

IT IS HEREBY ORDERED that the plaintiff Ronaldo Designer Jewelry, Inc.'s Motion for Preliminary Injunction (**docket entry 31**) is GRANTED. A separate Preliminary Injunction shall be entered of even date herewith.

SO ORDERED, this the 19th day of September, 2016.

/s/ David Bramlette
UNITED STATES DISTRICT JUDGE