

1 Irvine, CA 92606
2 Phone: 800-562-6439
3 Fax: 800-562-6504

4 **WAL-MART STORES, INC.**

5 Counsel: Rosalyn Mitchell (in house)
6 Fax: 479-277-5991
7 Phone: 479-204-6574

8 Address: 702 SW 8th Street
9 Bentonville, AR 72716

10 Registered Agent: The Corporation Trust Company
11 Corporation Trust Center
12 1209 Orange Street
13 Wilmington, DE 19801
14 Phone: 302-658-7581
15 Fax: 302-655-5049

16 **AMAZON.COM, INC.**

17 Counsel: Not known at this moment

18 Address: 410 Terry Avenue North
19 Seattle, WA 98109-5210

20 Registered Agent: Corporation Service Company
21 2711 Centerville Road, Suite 400
22 Wilmington, DE 19808
23 Phone: 800-927-9800
24 Fax: 302-636-5454

25 **BIG LOTS STORES, INC.**

26 Counsel: Not known at this moment

27 Address: 300 Phillipi Road
28 PO Box 28512
Columbus, OH 43228-5311

Registered Agent: CSC-Lawyers Incorporating Service
50 W. Broad Street, Suite 1800

-xiv-

EX PARTE APPLICATION OF PLAINTIFF GIBSON GUITAR CORP. FOR A TEMPORARY
RESTRAINING ORDER AND AN ORDER TO SHOW CAUSE RE: PRELIMINARY
INJUNCTION; MEMORANDUM OF POINTS AND AUTHORITIES IN SUPPORT THEREOF

1
2
3
4
5
6
7
8
9
10
11
12
13
14
15
16
17
18
19
20
21
22
23
24
25
26
27
28

Columbus, OH 43215
Phone: 800-927-9800
Fax: 302-636-5454

KMART CORPORATION

Counsel: Not known at this moment

Address: 3333 Beverly Road
Hoffman Estates, IL 60179
Phone: 847-286-2500
Fax: 847-286-5500

Registered Agent: The Corporation Company
30600 Telegraph Road, Suite 2345
Bingham Farms, MI 48025

TARGET CORPORATION

Counsel: Michael J Kroll (in house)
Fax: 612-696-3399
Phone: 612-696-2249

Address: 1000 Nicollet Mall
Minneapolis, MN 55403
Phone: 612-304-6073
Fax: 612-696-5400

Registered Agent: No Agent on File With Secretary of State

TOYS”R”US DELAWARE, INC

Counsel: Not known at this moment

Address: One Geoffrey Way
Wayne, NJ 07470-2030

Registered Agent: The Prentice-Hall Corporation System, Inc.
2711 Centerville Road, Suite 400
Wilmington, DE 19808
Phone: 302-636-5440
Fax: 302-636-5454

1 **WALGREEN CO.**

2 Counsel: Not known at this moment

3 Address: 200 Wilmot Road
4 Deerfield, IL 60015

5 Registered Agent: Illinois Corporation Service Company
6 801 Adlai Stevenson Drive
7 Springfield, IL 62703
8 Phone: 888-690-2882
9 Fax: 302-636-5454

8 **BROOKSTONE COMPANY, INC.**

9 Counsel: Not known at this moment

10 Address: One Innovation Way
11 Merrimack, NH 03054

12 Registered Agent: Thomas P. Manson, Esq.
13 1000 Elm Street, 20FI
14 Manchester, NH 03101
15 Phone: 603-621-7100
16 Fax: 603-621-7111

15 **BEST BUY CO., INC.**

16 Counsel: Not known at this moment

17 Address: 7601 Penn Avenue South
18 Richfield, MN 55423

19 Registered Agent: C T Corporation System Inc.
20 100 South 5th Street, Suite 1075
21 Minneapolis, MN 55402
22 Phone: 612-333-4315
23 Fax: 612-333-2524

23 **EBAY INC.**

24 Counsel: Not known at this moment

25 Address: 2145 Hamilton Avenue

1 San Jose, CA 95125

2 Registered Agent: National Registered Agents, Inc.
3 160 Greentree Drive, Suite 101
4 Dover, DE 19904
5 Phone: 302-674-4089
6 Fax: 302-674-5266

6 **TOYWIZ, INC.**

7 Counsel: Not known at this moment

8 Address: 363 Spook Rock Rd. Building K
9 Suffern, NY 10901

10 Registered Agent: Barr, Post & Associates
11 664 Chestnut Ridge Road
12 Spring Valley, NY 10977
13 Phone: 845-352-4080
14 Fax: 845-352-6777

13 **HSN, INC.**

14 Counsel: Not known at this moment

15 Address: 1 HSN Drive
16 St. Petersburg, FL 33729

17 Registered Agent: National Registered Agents, Inc.
18 160 Greentree Drive, Suite 101
19 Dover, DE 19904
20 Phone: 302-674-4089
21 Fax: 302-674-5266

21
22
23
24
25
26

1 Respectfully submitted,

2 DATED: November ____, 2010 BATES & BATES, LLC

3

4

5

6

7

8

9

10

11

12

13

14

15

16

17

18

19

20

21

22

23

24

25

26

ANDREA E. BATES
MICHAEL A. BOSWELL
Attorneys for PLAINTIFF
GIBSON GUITAR CORP.

27

28

TABLE OF CONTENTS

1
2
3
4
5
6
7
8
9
10
11
12
13
14
15
16
17
18
19
20
21
22
23
24
25
26
27
28

PAGE

TABLE OF CONTENTSxix

TABLE OF AUTHORITIES..... xx

I. INTRODUCTION..... 1

II. STATEMENT OF FACTS 5

 A. Plaintiff Exclusively Owns the Gibson Trademarks 5

 B. The Gibson Trademarks Enjoy Worldwide Fame..... 5

 C. Defendant’s Illegal Activities..... 6

 D. Defendant eBay’s Contributory Infringement
 of the Gibson Trademarks..... 8

III. A TEMPORARY RESTRAINING ORDER IS NECESSARY
 TO PREVENT TRADEMARK INFRINGEMENT 9

 A. GIBSON has Satisfied The Standards For Granting A
 Temporary Restraining Order And A Preliminary Injunction 9

 B. GIBSON has Demonstrated An Indisputable Likelihood of
 Success On the Merits Of Its Federal Trademark
 Infringement Claims 10

 i. Strength of the Marks.....11

 ii. Similarity of the Marks 12

 iii. The Alleged Infringer’s Intent In
 Selecting the Mark 13

 iv. Likelihood of Expansion in Product Lines 14

 C. Plaintiff Will Suffer Irreparable Harm In The Absence of
 Preliminary Injunctive Relief..... 15

1
2
3
4
5
6
7
8
9
10
11
12
13
14
15
16
17
18
19
20
21
22
23
24
25
26
27
28

D. The Balance of Equities Tips In Favor of Plaintiff 16
E. An Injunction Is In the Public Interest..... 19
IV. CONCLUSION..... 19

-xx-

TABLE OF AUTHORITIES

PAGE

STATUES AND RULES

1
2
3
4 15 U.S.C. §1057(b) 10
5 15 U.S.C. §1114..... 10
6
7 Fed. R. Civ. P. 65(c).....18
8 TMEP §1207.01(a)(v)..... 15
9

CASES

10
11 AMF, Inc. v. Sleekcraft Boats
12 599 F. 2d 341, 348-49 (9th Cir. 1979)...11, 13
13 Brunner v. Bawcom
14 U.S. Dist. LEXIS 96341, 2010 WL 3724436, *4 (D.Mont., Sept. 15, 2010) 4
15 Cadence Design Systems, Inc. v. Avant! Corp.
16 125 F.3d 824, 829 (9th Cir. 1997)..... 17
17 Connecticut Gen. Life Ins. Co. v. New Images of Beverly Hills,
18 321 F. 3d 878, 882 (9th Cir. 2003)..... 18
19 CPG Products Corp. v. Perceptual Play, Inc.
20 221 USPQ 88 (TTAB 1983) 15
21 Cytosport, Inc. v. Vital Pharm., Inc.
22 617 F.Supp.2d 1051, 1081-1082 (E.D.Cal.2009) 16
23 Eclipse Associates Ltd. v. Data General Corp.
24 894 F. 2d 1114, 1118 (9th Cir. 1990)..... 11
25 Freecycle Network, Inc. v. Oey
26 505 F.3d 898, 901 (9th Cir. 2007)..... 10
27 Goto.com, Inc. v. Walt Disney Co.
28

1 202 F.3d 1199, 1205 (9th Cir. 2000)..... 11, 12

2 Iconix, Inc. v. Tokuda

3 457 F. Supp. 2d 969, 1002 (N.D. Cal. 2006) 18

4 In re 1st USA Realty Professionals, Inc.

5 84 USPQ2d 1581 (TTAB 2007) 15

6 Inwood Laboratories Inc. v. Ives Laboratories, Inc.

7 456 U.S. 844, 853-854 (1982)..... 8

8 Lockheed Martin Corp. v. Network Solutions, Inc.

9 194 F.3d 980, 983 (9th Cir. 1999)..... 9

10 Marlyn Nutraceuticals, Inc. v. Murcos Pharma GmbH & Co.

11 571 F. 3d 873, 877 (9th Cir. 2009)..... 16

12 Maxim Integrated Products, Inc. v. Quintana

13 654 F. Supp. 2d 1024, 1035 (N.D. Cal. 2009) 16, 19

14 McGee v. International Life Ins. Co.

15 355 U.S. 220, 223, 78 S.Ct. 199, 2 L.Ed.2d 223 (1957)..... 4

16 Metro Pub., Ltd. v. San Jose Mercury News

17 987 F. 2d 637, 640 (9th Cir. 1993)..... 11

18 Microsoft Corp. v. Very Competitive Computer Products Corp.

19 671 F. Supp. 1250, 1252 (N.D. Cal. 1987) 18

20 Moroccanoil, Inc. v. Moroccan Gold, LLC

21 590 F. Supp.2d 1271, 1282 (C.D. Cal. 2008) 19

22 Nintendo of America, Inc. v. Computer & Entertainment, Inc.

23 1996 U.S. Dist. LEXIS 20975, *15, 1996 WL 511619, *6 (W.D. Wa. 1996) 19

24 Opticians Ass'n of Am. v. Indep. Opticians of Am.

25 920 F.2d 187, 198 (3d. Cir. 1990)..... 19

26 Park Inns International v. Pacific Plaza Hotels, Inc.

27 5 F.Supp.2d 762, 764 (D.Ariz. 1998)..... 4

28 Perfect 10, Inc. v. Visa Int'l Service Ass'n

494 F.3d 788, 807 (9th Cir. 2007)..... 9

1 Promatek Industries, Ltd. v. Equitrac Corp.
 2 300 F. 3d 808, 813 (7th Cir. 2002)..... 19

3 Rent-A-Center, Inc. v. Canyon Television & Appliance Rental, Inc.
 4 944 F. 2d 597, 603 (9th Cir. 2001)..... 16

5 Sierra On-Line, Inc. v. Phoenix Software, Inc.
 6 739 F.2d 1415, 1422 (9th Cir. 1984)..... 10

7 State of Alaska v. Native Village of Venetic
 8 856 F.2d 1384, 1389 (9th Cir. 1988)..... 9

9 Stormans, Inc. v. Selecky
 10 Nos. 07-36039, 07-36040, 2009 WL 194550, at 13 (9th Cir., July 8, 2009)..... 10

11 Sun Microsystems, Inc. v. Microsoft Corp.
 12 21 F. Supp. 2d 1109, 1118 (N.D. Cal 1998)..... 10

13 Tech Heads, Inc. v. Desktop Service Center, Inc.
 14 105 F.Supp.2d 1142, 1150-51 (D.Or. 2000) 4

15 Textile Unlimited, Inc. v. A. BMH & Co.
 16 240 F.3d 781, 786 (9th Cir. 2001)..... 10

17 Ticketmaster L.L.C. v. RMG Technologies, Inc.
 18 507 F. Supp. 2d 1096, 1116 (C.D. Cal. 2007) 18

19 Tiffany v. eBay
 20 (2010) 600 F.3d 93 9

21 TMX Funding, Inc. v. Impero Technologies, Inc.
 22 2010 U.S. Dist. LEXIS 68843, *19-20, 2010 WL 2745484, *7
 (N.D. Cal.2010)..... 16

23 Triad Sys Corp. v. Southeastern Express Co.
 24 64 F. 3d 1330, 1338 (9th Cir. 1995)..... 17

25 Vision Sports, Inc. v. Mellvile Corp.
 26 888 F.2d 609, 612 n.3 (9th Cir. 1989)..... 16

27 Walter v. Mattel, Inc.
 28 210 F.3d 1108, 1111 (9th Cir. 2000)..... 11

1
2
3
4
5
6
7
8
9
10
11
12
13
14
15
16
17
18
19
20
21
22
23
24
25
26
27
28

Winter v. Natural Res. Def. Council, Inc.
 129 S. Ct. 365, 374 (2008) 10, 15, 16, 19

Yash Raj Films (USA), Inc. v. Sidhu
 2010 U.S. Dist. LEXIS 25988, *17-18, 2010 WL 1032792, *7
 (E.D. Cal. 2010) 10

1 I. INTRODUCTION

2 Plaintiff Gibson Guitar Corp. (hereinafter "Gibson") is engaged in the business of developing,
3 manufacturing and selling musical instruments, including guitars, basses and mandolins under the
4 famous Gibson® trademark for over a century. Gibson guitars are sold worldwide. Gibson's
5 instruments have gained worldwide recognition and reputation, winning awards for their design
6 (Declaration of Henry Juskiewicz at ¶'s 18, 19, 20, and 21).

8 Gibson is the sole and exclusive owner of the following registered United States trademarks:

9 (1) The Les Paul Body Shape Design®, U.S. Trademark Reg. No. 1782606 (hereinafter "Les Paul
10 Body Shape Design® Trademark") (See Declaration of Henry Juskiewicz at ¶ 5; Declaration of
11 Bruce Mitchell at ¶ 5(a) , and accompanying exhibit "A"); (2) The Les Paul Peg-Head Design®, U.S.
12 Trademark Reg. No. 1020485 (hereinafter "Les Paul Peg-Head® Trademark") (See Declaration of
13 Henry Juskiewicz at ¶ 65; Declaration of Bruce Mitchell at ¶ 5(b) , and accompanying exhibit "B");
14 The Bell Shaped Truss Rod Cover Design®, U.S. Trademark Reg. No. 1022637 (hereinafter "the
15 Bell Cover Design® Trademark") (See Declaration of Henry Juskiewicz at ¶ 5; Declaration of
16 Bruce Mitchell at ¶ 5(c), and accompanying exhibit "C"); The Flying V Body Shape Design Body
17 Shape Design®, U.S. Trademark Reg. No. 2051790 (hereinafter "Flying V Body Shape Design®
18 Trademark" (See Declaration of Henry Juskiewicz at ¶ 8; Declaration of Bruce Mitchell at ¶ 5(d),
19 and accompanying exhibit "D"); The Explorer Body Shape Design®, U.S. Trademark Reg. No.
20 2053805 (hereinafter "Explorer Design® Trademark") (See Declaration of Henry Juskiewicz at ¶ 5;
21 Declaration of Bruce Mitchell at ¶ 5€ , and accompanying exhibit "E"); (6) The Kramer Peg-Head
22 Design®, U.S. Trademark Reg. No. 1567052 (hereinafter "Kramer Peg-Head® Trademark") (See
23 Declaration of Henry Juskiewicz at ¶10; Declaration of Bruce Mitchell at ¶ 5(f), and accompanying
24
25
26
27

1 exhibit "F"); (7) The SG Body Design®, U.S. Trademark Reg. No. 2215791 (hereinafter "SG Body
2 Design® Trademark") (See Declaration of Henry Juskiewicz at ¶ 11; Declaration of Bruce Mitchell
3 at ¶ 5(g), and accompanying exhibit "G"); (8) The word mark "LES PAUL"® Trademark, U.S.
4 Trademark Reg. No. 1539282 (hereinafter the "LES PAUL® Trademark) (See Declaration of Henry
5 Juskiewicz at ¶ 13; Declaration of Bruce Mitchell at ¶ 5(h) , and accompanying exhibit "H"); (9)
6 The word mark "FLYING V"® Trademark, U.S. Trademark Reg. 1216644 (hereinafter the
7 "FLYING V® Trademark) (See Declaration of Henry Juskiewicz at ¶ 12; Declaration of Bruce
8 Mitchell at ¶ 5(i) , and accompanying exhibit "I"); (10) The word mark "EXPLORER"® Trademark,
9 U.S. Trademark Reg. 2641548 (hereinafter the "EXPLORER® Trademark) (See Declaration of
10 Henry Juskiewicz at ¶ 15; Declaration of Bruce Mitchell at ¶ 5(j) , and accompanying exhibit "J");
11 (11) The word mark "S-G"® Trademark, U.S. Trademark Reg. 1045872 (hereinafter the
12 "EXPLORER® Trademark) (See Declaration of Henry Juskiewicz at ¶ 14; Declaration of Bruce
13 Mitchell at ¶ 5(k) , and accompanying exhibit "K"); (12) The word mark "GIBSON"® Trademark,
14 U.S. Trademark Reg. 1545311 (hereinafter the GIBSON® Trademark) (See Declaration of Henry
15 Juskiewicz at ¶ 16; Declaration of Bruce Mitchell at ¶ 5(l), and accompanying exhibit "L")
16 (collectively "Gibson Trademarks").
17
18

19 Plaintiff has recently learned that defendants WOWWEE USA, INC. (hereinafter
20 "WowWee"), WAL-MART STORES, INC. (hereinafter "WAL-MART"), AMAZON.COM, INC.
21 (hereinafter "AMAZON"), BIG LOTS STORES, INC. (hereinafter "BIG LOTS"), KMART
22 CORPORATION (hereinafter "KMART"), TARGET CORPORATION (hereinafter "TARGET"),
23 TOYS "R" US-DELAWARE, INC. (hereinafter "TOYS "R" US"), WALGREEN CO. (hereinafter
24 "WALGREENS"), BROOKSTONE COMPANY, INC. (hereinafter "BROOKSTONE"), BEST BUY
25
26

1 CO. INC. (hereinafter "BEST BUY"), TOYWIZ, INC. (hereinafter "TOYWIZ") and HSN, INC.
2 (hereinafter "HSN") (collectively "Defendants") are selling musical play instruments worldwide,
3 including the United States, that infringe upon the Gibson Trademarks ("Unauthorized Products").
4 Defendant WowWee is the manufacturer and distributor of the play instruments and the remaining
5 defendants (the "Retail Defendants") offer those items for sale either online, in physical locations, or
6 both. The Unauthorized Products are being advertised by WowWee on its websites
7 (www.paperjamz.com, www.paperjamzstore.com, www.wow-wee-paper-jamz-guitar.com,
8 www.wowwee.com, among others) as either Guitar Style 1/Country 1 (attached as Exhibit "M" to the
9 Declaration of Bruce Mitchell), Guitar Style 4/Rock 4 (attached as Exhibit "N" to the Declaration of
10 Bruce Mitchell), Guitar Style 5/Rock 5 (attached as Exhibit "O" to the Declaration of Bruce
11 Mitchell), and Guitar Style 6/Rock 6 (attached as Exhibit "P" to the Declaration of Bruce Mitchell).
12 These Unauthorized Products are identical to the Gibson Trademarks and clearly infringe on the
13 Gibson Trademarks (See Exhibits "Q," "R," "S," and "T" to the Declaration of Bruce Mitchell).
14

15 On the www.paperjamz.com website, WowWee indicates that Defendants AMAZON, BEST
16 BUY, BIG LOTS, BROOKSTONE, KMART, TARGET, TOYS "R" US, WALGREENS AND
17 WAL-MART has locations where the public can purchase the Unauthorized Products (See Exhibit
18 "U" to the Declaration of Bruce Mitchell. Indeed, a review of the Defendants websites indicates that
19 the Unauthorized Products are widely available on-line (See Exhibits "V", "W", "X", "Y", "Z",
20 "AA", "BB", and "CC" to the Declaration of Bruce Mitchell). Each of those entities conducts
21 business within this district.
22
23
24
25
26

1 A review of the websites of the remaining defendants, EBAY, TOYWIZ and HSN, indicates
2 that the Unauthorized Products are available on-line to the public within this district, as well (See
3 Exhibits "DD", "EE", and "FF" to the Declaration of Bruce Mitchell).

4 Thus, Plaintiff Gibson is seeking emergency relief via this application for a temporary
5 restraining order and request for preliminary injunction to stop the infringing activities as soon as
6 possible.

7
8 Personal jurisdiction over each of these Defendants is proper because among other things they
9 have sold and distributed the Unauthorized Products in the Central District of California both in their
10 physical locations as well as through their websites (See Brunner v. Bawcom, U.S. Dist. LEXIS
11 96341, 2010 WL 3724436, *4 (D.Mont., Sept. 15, 2010) (holding that the defendant's single sale of
12 goods to the plaintiff in the forum satisfied the "purposeful availment" requirement for personal
13 jurisdiction, insofar as the defendant had "purposefully availed himself of the privilege of conducting
14 business [in the forum]") (citing McGee v. International Life Ins. Co., 355 U.S. 220, 223, 78 S.Ct.
15 199, 2 L.Ed.2d 223 (1957)). Finally, each of the Defendants operate an online retail business from a
16 highly-interactive website (See Tech Heads, Inc. v. Desktop Service Center, Inc., 105 F.Supp.2d
17 1142, 1150-51 (D.Or. 2000) (personal jurisdiction was proper when defendant's website had
18 interactive features and one sale to an Oregon resident was made via the website); see also Park Inns
19 International v. Pacific Plaza Hotels, Inc., 5 F.Supp.2d 762, 764 (D.Ariz. 1998) (personal jurisdiction
20 proper Arizona residents and travel agents used defendant's website to make on-line hotel
21 reservations).

22
23
24 Although Gibson sent cease and desist letters to the Defendants, none of the Defendants have
25 ceased selling the Unauthorized Products. Based on the foregoing, Plaintiff will suffer irreparable
26

1 harm if the Defendants are not immediately enjoined from manufacturing, marketing or selling the
2 Unauthorized Products.

3 **II. STATEMENT OF FACTS**

4 **A. Plaintiff Exclusively Owns the Gibson Trademarks**

5 Plaintiff owns uncontestable US trademark registrations for the Gibson Trademarks and has
6 used the Gibson Trademarks in connection musical instruments for over 50 years and in the case of
7 the GIBSON® Trademark it was first used in commerce in the late 1800s (See Exhibit L to Bruce
8 Mitchell).

9 **B. The Gibson Trademarks Enjoy Worldwide Fame**

10 Gibson's instrucments and, in turn, Gibson Trademarks have achieved a high level of fame
11 both domestically and abroad. Several of the most well-known national and international musicians
12 use Gibson's products which utilize the Gibson's Trademarks, including but not limited to: Keith
13 Richards of the Rolling Stones; Elvis Presley; Jan Akkerman; Billy Joe Armstrong of GreenDay;
14 Martin Barre of Jethro Tull; Jeff Beck of the Yardbirds; Dave Davies of the Kinks; Buck Dharma of
15 the Blue Oyster Cult; The Edge of U2; Ace Frehley of Kiss; Steve Howe of Yes and Asia; Mick
16 Jones of Foreigner; Lenny Kravitz; Bob Marley; Ted Nugent; Joe Perry of Aerosmith; Duane Allman
17 of the Allman Brother Band; John Lennon of the Beatles; Angus Young of AC/DC; James Hetfield of
18 Metallica; Jimmy Page of Led Zeppelin; Eddie Van Halen; Johnny Winter; Neil Young; Slash; and
19 Eric Clapton. (Declaration of Henry Juskiewicz at ¶ 19).

20 Pictures of Gibson products in famous musical performances date back well over 50 years (*Id.*
21 at ¶19). Many of those musicians have been elected to the Rock and Roll Hall of Fame, of which
22 Gibson is a proud sponsor (*Id.*). Additionally, Gibson has been covered in the press, both in the
23

1 United States and elsewhere, demonstrating as a testament to the fame and good will associated with
2 all the Gibson Trademarks. (Declaration of Henry Juskiewicz at ¶ 20).

3 As a result of the high quality of the Gibson's instruments and the extensive sales, licensing
4 and marketing, advertising and promotion of these instruments under the Gibson Trademarks, the
5 Gibson Trademarks have become famous trademarks that are widely and favorably known by
6 consumers in the United States and elsewhere as designating high quality and dependable products
7 originating exclusively from Gibson and its related companies (Declaration of Henry Juskiewicz at ¶
8 21).

9
10 **C. Defendant's Illegal Activities**

11 Defendant WowWee has improperly commenced the business of manufacturing, selling and
12 marketing various Unauthorized Products that utilize the famous marks of Gibson, specifically the
13 Gibson Trademarks. The remaining Defendants represent retailers who sell the Unauthorized
14 Products that display the Gibson Trademarks to the unassuming public.

15 Further, defendant WowWee has gone so far as to market its Unauthorized Products utilizing
16 the protected word marks of Gibson, namely, "GIBSON®," "LES PAUL®," "FLYING V®,"
17 "EXPLORER®," and "S-G®" (Declaration of Bruce Mitchell at ¶ 14). Gibson is the exclusive owner
18 of each of these respective trademarks, and it has not granted permission for any of the Defendants to
19 utilize these marks in conjunction with their Unauthorized Products (Declaration of Henry
20 Juskiewicz at ¶ 24).

21
22
23 WowWee has, itself, indicated that the Unauthorized Product which is identical to the
24 registered Gibson designs are "styled after the famous Gibson Les Paul" (Declaration of Bruce
25 Mitchell at ¶ 15 , and attached Exhibit GG); or the "famous Gibson Explorer" (Declaration of Bruce
26

1 Mitchell at ¶ 15, and attached Exhibit HH); or the “famous Gibson SG” (Declaration of Bruce
2 Mitchell at ¶ 15 , and attached Exhibit II); or the “famous Gibson Flying V Guitar” (Declaration of
3 Bruce Mitchell at ¶ 15 , and attached Exhibit JJ). Indeed, WowWee goes as far as to say the
4 following on its website, “The designs of each Paper Jamz guitar are similar to a classic that is highly
5 sought after. For example, the Rock Style 6 guitar in Series 1 of Paper Jamz is **made to resemble a**
6 **Gibson SG** while the Rock Style 1is made to look like the **famous Gibson Les Paul**. You can
7 choose from your favorite styles of guitar, with the styles ranging from the classic Fender Stratocaster
8 the “**Gibson Flying V Design**” (emphasis added) (Declaration of Bruce Mitchell at ¶ 15, and
9 attached Exhibit NN).

10
11 Defendant WowWee has even made the following bold statement in their advertising
12 “WowWee Paper Jamz Guitar is molded **just like the genuine matter, allowing you to play on a**
13 **Gibson Flying V** or a Fender Strat without experiencing to dispense hundreds of dollars” (emphasis
14 added) (Declaration of Bruce Mitchell at ¶ 16 , and attached Exhibit KK). The ad goes on to state
15 that three of its musical play instruments, Rock 4, 5, and 6, are in the “Flying V style,” “the Explorer
16 Style,” and “the SG style.” (Declaration of Bruce Mitchell at ¶ 17, and attached Exhibit KK). This
17 egregious and blatant use of the Gibson Trademarks, without the consent or license from Gibson is
18 unconscionable.
19

20
21 In Gibson’s experience, once irreparable damage to a trademark has been caused, it is nearly
22 impossible for the company to recover its goodwill (Declaration of Henry Juskiewicz at ¶ 28).

23 In the fall, Gibson contacted WowWee about its infringing activities (Declaration of Bruce
24 Mitchell at ¶ 8). However, despite communications between the parties and the demands by Gibson
25 that WowWee cease and desist its infringing activities and the manufacture and sale of counterfeit
26

1 parts, WowWee continued to do so. As a result, Gibson sent cease and desist letters to the remaining
2 Defendants on November 15 and 16, 2010. To date, only five of the Defendants have contacted
3 Gibson. One, Macys.com, Inc., appears to not be participating in the infringing activities, and thus
4 has not been named a party to this action. The remaining four, WAL-MART, TOYWIZ, TARGET
5 and Boscov (not a party to this action) indicated that they would look into the matter, but they have
6 failed to cease and desist their infringing activities and they along with the other retail defendants
7 continue to mislead the public in their offerings of counterfeit goods.

9 **D. Defendant EBay's Contributory Infringement of the Gibson Trademarks**

10 EBay supports on its site numerous examples of the infringement of the Gibson Trademarks
11 (Declaration of Bruce Mitchell at ¶ 13(i)). Accordingly, counsel for Gibson also sent EBay a cease
12 and desist letter, but to date there has been no response.

13 The standard for analyzing contributory liability claims was set forth by the Supreme Court in
14 the case of Inwood Laboratories Inc. v. Ives Laboratories, Inc. (456 U.S. 844, 853-854 (1982)). In
15 Inwood Laboratories, the Supreme Court re-affirmed the basic principle that "liability for trademark
16 infringement can extend beyond those who actually mislabel goods with the mark of another" (*Id.* at
17 853). Thus, "[e]ven if a manufacturer does not directly control others in the chain of distribution, it
18 can be held responsible for their infringing activities under certain circumstances" (*Id.* at 853-854).

19 Furthermore, the Court established a two-part test for evaluating contributory liability claims.
20 Specifically, if a manufacturer or distributor intentionally induces another to infringe a trademark, or
21 if it continues to supply its product to one whom it knows or has reason to know is engaging in
22 trademark infringement, the manufacturer or distributor is contributorially responsible for any harm
23 done as a result of the deceit (*Id.* at 854). This two-part test articulated by the Supreme Court in
24
25
26

1 Inwood, has been consistently followed and expounded upon by subsequent courts (*See, e.g. Perfect*
2 *10, Inc. v. Visa Int'l Service Ass'n*, 494 F.3d 788, 807 (9th Cir. 2007); Lockheed Martin Corp. v.
3 Network Solutions, Inc. 194 F.3d 980, 983 (9th Cir. 1999)).

4 A party cannot be willfully blind to claims of trademark infringement. Defendant EBay has
5 been notified of the claims of infringement, but to date it has done nothing to attempt to resolve the
6 situation, not even so much as a phone call to counsel for Gibson to determine the extent of the
7 problem. As can be seen from Exhibit DD to the Declaration of Bruce Mitchell, there are significant
8 offerings of counterfeit goods bearing the Gibson Trademarks being trafficked on defendant EBay's
9 site, yet it turns a blind eye. Given that it appears the defendant EBay claims to have a robust take
10 down procedure for allegedly counterfeit goods (*See generally Tiffany v. eBay* (2010) 600 F.3d 93),
11 it appears that instead of exercising that policy, it instead chooses to act willfully blind to the
12 blatantly obvious trademark infringement being conducted within its operations as it relates to the
13 Gibson Trademarks which are being infringed by the offending products.

14
15
16 As such, EBay should also be included within the TRO and preliminary injunction.

17 **III. A TEMPORARY RESTRAINING ORDER IS NECESSARY TO PREVENT**
18 **TRADEMARK INFRINGEMENT**

19 **A. GIBSON Has Satisfied The Standards For Granting A Temporary Restraining**
20 **Order And A Preliminary Injunction**

21 The standards in the Ninth Circuit for obtaining a temporary restraining order are identical to
22 those for obtaining a preliminary injunction (State of Alaska v. Native Village of Venetie, 856 F.2d
23 1384, 1389 (9th Cir. 1988). Gibson is entitled to preliminary injunctive relief where it shows: (1) a
24 likelihood of success on the merits; (2) a likelihood of irreparable harm absent a preliminary
25

1 injunction; (3) that the balance of equities tips in favor of issuing an injunction; and (4) that an
2 injunction is in the public interest (Winter v. Natural Res. Def. Council, Inc., 129 S. Ct. 365, 374
3 (2008); *See also* Stormans, Inc. v. Selecky, Nos. 07-36039, 07-36040, 2009 WL 194550, at 13 (9th
4 Cir., July 8, 2009). A preliminary injunction is a way to preserve the status quo and prevent
5 irreparable loss of rights before judgment (*See, e.g.*, Textile Unlimited, Inc. v. A. BMH & Co., 240 F.
6 3d 781, 786 (9th Cir. 2001); Sierra On-Line, Inc. v. Phoenix Software, Inc., 739 F.2d 1415, 1422
7 (9th Cir. 1984). Indeed, “public policy favors injunctive relief to remedy the infringement of
8 intellectual property rights.” (Yash Raj Films (USA), Inc. v. Sidhu, 2010 U.S. Dist. LEXIS 25988,
9 *17-18, 2010 WL 1032792, *7 (E.D. Cal. 2010). Courts may also consider whether the granting of a
10 preliminary injunction favors the public interest (Sun Microsystems, Inc. v. Microsoft Corp., 21 F.
11 Supp. 2d 1109, 1118 (N.D. Cal 1998). Both a temporary restraining order and preliminary injunction
12 are clearly proper here.

13
14
15 **B. GIBSON has Demonstrated An Indisputable Likelihood of Success On the Merits**
16 **Of Its Federal Trademark Infringement Claims**

17 To be liable for trademark infringement, someone must “(1) use in commerce (2) any word,
18 false designation of origin, false or misleading description, or representation of fact, which (3) is
19 likely to cause confusion or misrepresents the characteristics of his or another person’s goods or
20 services” (Freecycle Network, Inc. v. Oey, 505 F.3d 898, 901 (9th Cir. 2007).

21
22 To prove trademark infringement, Gibson must satisfy two basic elements: (1) a valid
23 protectable mark; and (2) a likelihood of confusion, mistake, or deception in Defendants’ use of the
24 trademark (15 U.S.C. §1114). GIBSON has done so. It is the owner of the uncontestable United
25 States trademark registrations for the Gibson Trademarks. Certificates of registration for these marks
26

1 are *prima facie* evidence of their validity and GIBSON's exclusive rights to use such marks (15
2 U.S.C. § 1057 (b)). (Exhibits A-L to the Declaration of Bruce Mitchell)

3 The Ninth Circuit does not apply any particular "test" for likelihood of consumer confusion,
4 but has identified a number of factors pertinent to "whether the public is likely to be deceived or
5 confused by the similarity of the marks as to source, relationship or sponsorship."¹

6 The 8-prong Sleekcraft test is a pliant one in which some factors are more important than
7 others (Goto.com, Inc. v. Walt Disney Co., 202 F.3d 1199, 1205 (9th Cir. 2000)). In the current
8 scenario, however, many of the 8 factors support Plaintiff's request for injunctive relief. Furthermore,
9 The Ninth Circuit has adopted these identical eight factors to test whether there is a likelihood of
10 confusion for the common-law and federal unfair competition claims (Walter v. Mattel, Inc., 210
11 F.3d 1108, 1111 (9th Cir. 2000)).

12
13
14 **i. Strength of the Marks**

15 The strength of a trademark is evaluated in terms of its conceptual strength and commercial
16 strength (Goto.com, Inc. v. Walt Disney Co., 202 F.3d 1199, 1207 (9th Cir. 2000)).

17 The Gibson Trademarks represent the strongest category of trademarks in that they bear no
18 logical relationship to the underlying product (i.e., arbitrary marks) and are deemed uncontestable
19 due to the duration of the registrations.
20

21 ¹ Eclipse Associates Ltd. v. Data General Corp., 894 F. 2d 1114, 1118 (9th Cir. 1990).
22 These factors include (1) strength or weakness of the plaintiff's trademark; (2) the degree of
23 similarity between defendant's design and the plaintiff's trademark; (3) whether the
24 trademarks are used on similar or related goods; (4) the similarities between the marketing
25 channels used by the plaintiff and the defendant; (5) any evidence of actual confusion; (6) the
26 intent of the defendant; (7) the type of goods and the degree to care likely to be exercised by
the purchaser; and (8) the likelihood of expansion of product lines. AMF, Inc. v. Sleekcraft
Boats, 599 F. 2d 341, 348-49 (9th Cir. 1979). Each of these factors is not necessarily
relevant to every case, thus the list functions as a guide. Metro Pub., Ltd. v. San Jose
Mercury News, 987 F. 2d 637, 640 (9th Cir. 1993).

1 The strength of Gibson Trademarks is further bolstered by the fact that Gibson is one of the
2 foremost and most well-known providers of guitars, electric guitars, and electric basses in the world,
3 and has been using the GIBSON® Trademark for well over 100 years, more than 50 for the other
4 Gibson Trademarks. The Gibson Trademarks have been used in musical performances by numerous
5 famous musicians, many who are members of the Rock and Roll Hall of fame. (Declaration of Henry
6 Juskiewicz at ¶ 19). The instruments used with the Gibson Trademarks, represent the pinnacle of
7 stringed musical instruments.
8

9 Unlike Gibson, WowWee appears to have only recently incorporated, specifically in 2007.
10 Accordingly this new business, rather than building its own goodwill is attempting to build its
11 company from the hard earned goodwill of Gibson and the Gibson Trademarks..
12

13 **ii. Similarity of the Marks**

14 Similarity of the marks is considered a critical question in the likelihood-of-confusion
15 analysis (Goto.com, Inc., 202 F.3d at 1205-1206). The Ninth Circuit in Goto.com has announced a
16 standard that (1) the marks must be considered in their entirety and as they appear in the marketplace;
17 (2) similarity is adjudged in terms of appearance, sound, and meaning; and (3) similarities are
18 weighed more heavily than differences (*Id.* at 1206).
19

20 Here, there can be no question that the shape trademarks held by Gibson, the Les Paul Body
21 Shape Design ® Trademark, the Les Paul Peg-Head® Trademark, the Bell Cover Design®
22 Trademark, the Flying V Body Shape Design® Trademark, the Explorer Body Shape Design®
23 Trademark, the Kramer Peg-Head® Trademark, and the SG Body Design® Trademark are quite
24 unique. In fact, WowWee has taken note of the goodwill and notoriety of the famous and unique
25
26