

## I. INTRODUCTION

1  
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).

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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 ¶ 5e, 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  
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28 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 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").  
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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  
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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](http://www.paperjamz.com), [www.paperjamzstore.com](http://www.paperjamzstore.com), [www.wow-wee-paper-jamz-guitar.com](http://www.wow-wee-paper-jamz-guitar.com),  
8 [www.wowwee.com](http://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).  
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15 On the [www.paperjamz.com](http://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.  
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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).

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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  
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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  
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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).

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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).

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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  
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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 ).

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.

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  
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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  
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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.

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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  
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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 (9<sup>th</sup>  
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.

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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  
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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."<sup>1</sup>

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)).

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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 <sup>1</sup> 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.  
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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  
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1 Gibson instruments, thereby creating cheaply made replicas of the Gibson Trademarks and is selling  
2 them to the public.

3 Additionally, because the defendant WowWee boldly uses of the *exact* Gibson owned word  
4 marks LES PAUL®, FLYING V®, EXPLORER®, and S-G® to promote their counterfeit items  
5 which exhibit the famous Les Paul Body Shape Design® Trademark, the Les Paul Peg-Head®  
6 Trademark, the Bell Cover Design® Trademark, the Flying V Body Shape Design® Trademark, the  
7 Explorer Body Shape Design® Trademark, the Kramer Peg-Head® Trademark, and the SG Body  
8 Design® Trademark, this is even more evidence that there is a similarity in the marks that leads to  
9 consumer confusion.  
10

11 Most importantly, on defendant WowWee's own website it includes a video of a consumer  
12 who confused regarding the Paper Jamz counterfeit Flying V and the Gibson Flying V Body Shape  
13 Design® Trademark. (*See Declaration of Bruce Mitchell at ¶17 and Exhibit LL*). This is clear  
14 evidence of consumer confusion. AMF, Inc. v. Sleekcraft Boats, (599 F.2d 341 (9th Cir. 1979)).  
15

16 **iii. The Alleged Infringer's Intent In Selecting The Mark**

17 It is clear that WowWee intended to use the extensive fame and goodwill of the Gibson  
18 Trademarks when it designed, named and marketed the infringing products (they admit this fact on  
19 their website). It is clear at, but a glance, that the Rock 1 version of the Paper Jamz product is a  
20 knock-off of the Les Paul Body Shape Design® Trademark (*See Exhibits A, M, and Q to Declaration*  
21 *of Bruce Mitchell*). As is the similar case between the knock-off versions of Rock 4, 5, and 6 of the  
22 Paper Jamz products when compared to Gibson's Flying V Body Shape Design® Trademark, the  
23 Explorer Body Shape Design® Trademark, and the SG Body Design® Trademark (*See Exhibits D,E,*  
24 *G, R, S, & T to Declaration of Bruce Mitchell*).  
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1 In addition, the Unauthorized Products not only infringe upon the distinctive trademark  
2 shapes of Gibson, but due to the fact that these knock off designs also utilize the Gibson word marks,  
3 such acts can only be seen as intentionally deceptive. WowWee uses the Flying V Body Design ®  
4 Trademark with the FLYING V Trademark, e.g., the Paper Jamz FLYING V (Dec of Bruce Mitchell,  
5 Exhibit R). It is clear that Defendants' advertising is attempting to build upon the goodwill and fame  
6 of the Gibson Trademarks, all to the detriment of Gibson. Of note, is that the advertisements are not  
7 comparing their products, but rather using the Gibson Trademarks as bait on a lure to catch the  
8 general public unawares, and secure increased revenue on the behalf of the Defendants, while at the  
9 same time damaging the image of true Gibson products. If Gibson cannot police its trademarks, and  
10 ensure that they are used either by Gibson, itself or under license, the marks would be copied industry  
11 wide and render the Gibson marks worthless (Declaration of Henry Juskiewicz at ¶ 28). That is not  
12 the purpose of the Lanham Trademark Act, but rather it is to protect the holders of registered  
13 trademarks from infringement and to protect the public at large from confusion in the marketplace  
14 due to the existence of counterfeit goods bearing federally registered trademarks.

17 **iv. Likelihood of Expansion of the Product Lines**

18 The holder of a registered trademark is presumed to have the ability to expand its product  
19 lines within the realm of its trademark, unless the trademark registration. Thus Gibson can in fact  
20 utilize the Gibson Trademarks in connection with musical play instruments. In fact, Gibson has  
21 already done so, marketing an electric guitar to kids between the ages of 10 to 15 years of age, that  
22 was sold within the same channels of trade that is being utilized by the Defendants (Declaration of  
23 Bruce Mitchell at ¶ 18, and the associated Exhibit MM). Gibson has also licensed its patented  
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1 technology which enables the Rock Band® series to utilize a Fender Stratocaster® within the game  
2 (*Id.* at ¶ 17#).

3 A trademark owner is entitled to protection against the registration of a similar mark on  
4 products that might reasonably be expected to be produced by him in the normal expansion of his  
5 business. The test is whether purchasers would believe the product or service is within the registrant's  
6 logical zone of expansion (In re 1st USA Realty Professionals, Inc., 84 USPQ2d 1581 (TTAB 2007);  
7 CPG Products Corp. v. Perceptual Play, Inc., 221 USPQ 88 (TTAB 1983); TMEP §1207.01(a)(v)).

8 Here, Gibson has already expanded its product lines to areas that encompass what the Defendants are  
9 peddling to the general public. The result is confusion on the part of the consuming public, as to who  
10 these products are affiliated with, confusion exacerbated by the manner and means in which the  
11 goods have been manufactured (*e.g.*, the shapes) and the way in which they have been promoted  
12 (“styled like a famous Gibson,” “made to resemble a Gibson SG while the Rock Style 1 is made to  
13 look like the famous Gibson Les Paul. You can choose from your favorite styles of guitar, with the  
14 styles ranging from the classic Fender Stratocaster the “Gibson Flying V Design” “is molded just  
15 like the genuine matter, allowing you to play on a Gibson Flying V . . .”) (Declaration of Bruce  
16 Mitchell at ¶ 15, and 16, and attached Exhibit NN). The Defendants’ own words speak for  
17 themselves. This is pure trademark infringement, an attempt to hijack the fame and goodwill  
18 associated with the prestigious Gibson Trademarks.  
19  
20  
21

22 **C. Plaintiff Will Suffer Irreparable Harm In The Absence of Preliminary Injunctive**  
23 **Relief**

24 The second of the four criteria for injunctive relief as set forth in Winter is that the plaintiff  
25 establish that it is likely to suffer irreparable harm in the absence of preliminary  
26

1 relief. Winter, 129 S.Ct. 365, 375-376.

2 In trademark cases, once the registrant establishes a likelihood of confusion between  
3 the registrant's mark and the challenger's mark, it is ordinarily presumed the registrant will  
4 suffer irreparable harm if injunctive relief is not granted (Vision Sports, Inc. v. Mellville  
5 Corp., 888 F.2d 609, 612 n.3 (9th Cir. 1989) *See also* Marlyn Nutraceuticals, Inc. v. Murcos Pharma  
6 GmbH & Co., 571 F. 3d 873, 877 (9th Cir. 2009) (in trademark cases, irreparable injury is presumed  
7 based on a likelihood of success on the merits); and TMX Funding, Inc. v. Impero Technologies, Inc.,  
8 2010 U.S. Dist. LEXIS 68843, \*19-20, 2010 WL 2745484, \*7 (N.D. Cal.2010) (noting that post-  
9 Winter, "the Ninth Circuit has reaffirmed the ability of a district court to presume harm upon a  
10 showing of the likelihood of success on the merits of a trademark infringement claim."). "In  
11 trademark cases, irreparable harm is typically found in a plaintiff's loss of control over their business  
12 reputation, loss of trade and loss of goodwill" (Maxim Integrated Products, Inc. v. Quintana, 654 F.  
13 Supp. 2d 1024, 1035 (N.D. Cal. 2009) The cases hold that "[i]ntangible injuries such as damage to . . .  
14 goodwill qualify as irreparable harm" (Rent-A-Center, Inc. v. Canyon Television & Appliance  
15 Rental, Inc., 944 F. 2d 597, 603 (9<sup>th</sup> Cir. 2001).

16 This is the reason that there is a presumption of irreparable harm when there has been  
17 trademark infringement, such as is the case here.

18 **D. The Balance of Equities Tips In Favor of Plaintiff**

19 A court balancing the equities will look to the possible harm that could befall the  
20 various parties (Cytosport, Inc. v. Vital Pharm., Inc., 617 F.Supp.2d 1051, 1081-1082  
21 (E.D.Cal.2009)). In this case, plaintiff Gibson is likely to suffer irreparable harm to its business and  
22 the goodwill it has built in the Gibson Trademarks over fifty years, particularly in the United States.  
23  
24  
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26



1 Unless enjoined, the proliferation of the unlicensed use of the Gibson Trademarks will  
2 irreparably harm GIBSON by: (1) undermining Gibson's substantial investment in the Gibson  
3 Trademarks; (2) eliminating Gibson's control over distribution of its federally registered trademarks;  
4 (3) harming Gibson's reputation with third party licensees; and diminishing the sales of future  
5 products displaying the Gibson Trademarks by Gibson and its authorize retailers ( Declaration of  
6 Henry Juskiewicz at ¶ 28).

8 Gibson has invested millions of dollars developing, promoting and advertising goods that bear  
9 the Gibson Trademarks. In the absence of injunctive relief, Defendants will continue to profit from  
10 the sales of the illegal goods while Gibson will be harmed by the continued distribution of these  
11 counterfeit items to the public. The lack of injunctive relief will therefore result in the loss of  
12 goodwill to the public and licensees encourage infringers to increase operations, and discourage anti-  
13 piracy enforcement – all of which is great and irreparable harm. In contrast, Defendants will only  
14 suffer the loss of the revenue from the sales of illicit  
15 Unauthorized Products utilizing the Gibson Trademarks. But that is the risk Defendants assumed  
16 when they decided to participate actively in an illegal business activity. The law is clear that the  
17 economic harm that befalls a pirate is not cognizable in the balance of hardships (Cadence Design  
18 Systems, Inc. v. Avant! Corp., 125 F.3d 824, 829 (9th Cir. 1997) (profit lost from enjoined sales of  
19 infringing goods not cognizable harm); Triad Sys Corp. v. Southeastern Express Co., 64 F. 3d 1330,  
20 1338 (9th Cir. 1995) (“Where the only hardship that the defendants will suffer is lost profits from an  
21 activity which has been shown likely to be infringing, such an argument in defense merits little  
22 equitable consideration.”) Moreover, the Defendants retail businesses appear to involve the supply of  
23 many types of products, of which the items bearing the Gibson Trademarks are but a few. They will,  
24  
25  
26

1 presumably, continue to supply these other products, despite the granting of any injunctive relief  
2 preventing the sale and distribution of the Unauthorized Products. Because of the irreparable harm to  
3 Gibson and because the balance of hardships tips strongly in favor of Gibson, Gibson is entitled to a  
4 temporary restraining order and preliminary injunction.

5  
6 Additionally, Plaintiff is willing to post a bond to protect Defendants' interest pending the  
7 outcome of this litigation, although Plaintiff strongly believes that the bond should be minimal based  
8 on the merits of its case and the strong likelihood it will prevail.

9 Fed. R. Civ. P. 65 (c) provides that a bond be posted "in an amount that the court considers  
10 proper to pay the costs and damages sustained by any party found to have been wrongfully enjoined  
11 or restrained." A bond "may not be required, or may be minimal, when the harm to the enjoined party  
12 is slight or where the movant has demonstrated a likelihood of success" (Ticketmaster L.L.C. v.  
13 RMG Technologies, Inc., 507 F. Supp. 2d 1096, 1116 (C.D. Cal. 2007); *see also* Connecticut Gen.  
14 Life Ins. Co. v. New Images of Beverly Hills, 321 F. 3d 878, 882 (9th Cir. 2003) ("bond amount may  
15 be zero if there is no evidence the party will suffer damages from the injunction."). Here, there is  
16 little prospect that any of Defendants' legitimate interests would be impinged by an order requiring  
17 them to cease distribution of the goods bearing the Gibson Trademarks. However, if the Court  
18 requires that a bond be posted, GIBSON submits that the bond should not exceed \$10,000 since that  
19 amount is more than sufficient to account for the unlikely possibility that Defendants would be  
20 "wrongly enjoined or restrained," from selling these plainly illegal devices (Fed. R. Civ. P. 65 (c);  
21 *see, e.g.,* Iconix, Inc. v. Tokuda, 457 F. Supp. 2d 969, 1002 (N.D. Cal. 2006) (setting bond at \$10,000  
22 for preliminary injunction in copyright infringement action); Microsoft Corp. v. Very Competitive  
23 Computer Products Corp., 671 F. Supp. 1250, 1252 (N.D. Cal. 1987) (setting bond at \$10,000 for  
24  
25  
26

1 preliminary injunction in copyright infringement action); Nintendo of America, Inc. v. Computer &  
2 Entertainment, Inc., 1996 U.S. Dist. LEXIS 20975, \*15, 1996 WL 511619, \*6 (W.D. Wa. 1996)  
3 (setting bond at \$10,000 for preliminary injunction in copyright and trademark infringement action).

4 Based thereon, Plaintiff respectfully contends that the balance of equities tips in its favor and  
5 favors the issuance of injunctive relief and that a bond, if necessary, be minimal.

6  
7 **E. An Injunction Is In The Public Interest**

8 In the trademark context, courts often define the public interest as the right of the public not to  
9 be deceived or confused (Moroccanoil, Inc. v. Moroccan Gold, LLC, 590 F. Supp.2d 1271, 1282  
10 (C.D. Cal. 2008) (quoting Opticians Ass'n of Am. v. Indep. Opticians of Am., 920 F.2d 187, 198 (3d.  
11 Cir. 1990)). Courts also recognize that the public interest favors injunctive relief in trademark  
12 infringement cases (*See, e.g.*, Promatek Industries, Ltd. v. Equitrac Corp., 300 F. 3d 808, 813 (7th  
13 Cir. 2002).

14  
15 On the other hand, no public benefit results from Defendants' activities. Public policy  
16 certainly does not support trademark infringement as a means to facilitate trademark counterfeiting.  
17 If the Court finds a likelihood of confusion between marks, it may also find that the public interest  
18 weighs in favor of granting injunctive relief (Maxim Integrated Products, Inc. v. Richard Quintana,  
19 et al., 654 F.Supp.2d 1024, 1036 (N.D. Cal.2009). In this case, not only is there a likelihood of  
20 confusion; rather, there has been at least one example of "actual" confusion by one of Plaintiff's own  
21 customers. Thus, injunctive relief is warranted.

22  
23 **V. CONCLUSION**

24 Pursuant to the factors set forth by the U.S. Supreme Court in Winter, 129 S.Ct. at 375-376,  
25 Plaintiff has established 1) that it is likely to succeed on the merits; 2) that it is likely to suffer  
26


1 irreparable harm in the absence of preliminary relief; 3) that the balance of equities tip in its favor;  
2 and 4) that an injunction is in the public interest.

3 A Temporary Restraining Order and a Preliminary Injunction will ensure protection of  
4 Plaintiff from further infringement of its Registered Trademarks as well as the public's right to  
5 distinguish between competing sources of goods and services. Accordingly, Plaintiff respectfully  
6 requests that the court enjoin Defendants' infringement in the form of the order proposed and filed  
7 concurrently herewith.  
8

9 Respectfully submitted,

10 DATED: November 19, 2010

BATES & BATES, LLC

11  
12 

13 ANDREA E. BATES  
14 MICHAEL A. BOSWELL  
15 Attorneys for PLAINTIFF  
16 GIBSON GUITAR CORP  
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# Exhibit 4

1 ANDREA E. BATES, ESQ, SBN 192491  
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7 Attorneys for  
Plaintiff  
8 GIBSON GUITAR CORP.,

9  
10 UNITED STATES DISTRICT COURT  
CENTRAL DISTRICT OF CALIFORNIA

11 GIBSON GUITAR CORP., a Delaware ) Case No. CV10-8884 RGK (RZx)  
12 corporation, )  
13 ) DECLARATION OF ANDREA E. BATES IN  
Plaintiff, ) SUPPORT OF PLAINTIFF’S EX PARTE  
14 vs. ) APPLICATION FOR A TEMPORARY  
15 ) RESTRAINING ORDER AND ORDER TO  
WOWWEE USA, INC., a California ) SHOW CAUSE RE: PRELIMINARY  
16 corporation; WAL-MART STORES, INC., a ) INJUNCTION  
17 Delaware corporation; AMAZON.COM, INC., )  
a Delaware corporation; BIG LOTS STORES, ) LOCAL RULES 7-19, 7-19.1  
18 INC., an Ohio corporation; K MART  
CORPORATION, a Michigan corporation; )  
19 TARGET CORPORATION, a Minnesota )  
corporation; TOYS “R” US-DELAWARE, ) Date:  
20 INC., a Delaware corporation; WALGREEN ) Time:  
CO., an Illinois corporation; BROOKSTONE ) Dept.: 805  
21 COMPANY, INC., a New Hampshire )  
corporation; BEST BUY CO. INC., a ) Judge: Judge R. Gary Klausner  
22 Minnesota corporation; EBAY INC., a  
23 Delaware corporation, TOYWIZ, INC., a New  
24 York corporation, HSN, Inc. a Delaware  
corporation, and DOES 1 through 100,  
25 Defendants,

1  
2  
3 **DECLARATION OF ANDREA E. BATES**

4 I, Andrea E. Bates, declare as follows:  
5

6 1. Unless otherwise stated as based upon information and belief, the facts set forth  
7 in this declaration are personally known to me and I have first knowledge of these facts. If  
8 called upon to testify during court of this action, I could, and I would competently testify  
9 thereto under oath. I am over 18 and a party to this action.  
10

11 2. I am an attorney licensed to practice law before the courts in the State of California  
12 and the federal Central District of California. I am a partner in the law firm of Bates & Bates, LLC,  
13 which is counsel of record for Plaintiff GIBSON GUITAR CORP. (hereinafter "GIBSON"), a  
14 Delaware corporation.  
15

16 3. Pursuant to the Standing Order For Newly Cases Assigned To Judge R. Gary  
17 Klausner, ¶9 (Ex Parte Applications), Plaintiff has begun to electronically serve all the Defendants  
18 via facsimile the Application and Notice of the Ex Parte Application For A Temporary Restraining  
19 Order And An Order To Show Cause Re: Preliminary Injunction to the Defendants, and Proposed  
20 Order, including notifying Defendants that an opposition shall be filed no later than 3 p.m. on the first  
21 business day following service. Because of the number of the Defendants, and the size of the  
22 accompanying papers, the service has not yet been completed as of the time this declaration is filed  
23 with the court, but is being completed simultaneously therewith.  
24

25 4. For those Defendants listed below that I am aware to have counsel, I have also faxed  
26 them in addition to the respective companies registered agents for process with the Application and  
27