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6 **IN THE UNITED STATES DISTRICT COURT**
7 **FOR THE DISTRICT OF ARIZONA**
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9 Luxottica Group SpA,
10 Plaintiff,

11 v.

12 MySpecs Limited, et al.,
13 Defendants.
14

No. CV-23-01393-PHX-ROS

ORDER

15 Plaintiff Luxottica Group S.p.A. owns a variety of trademarks associated with Ray-
16 Ban eyewear. (Doc. 1, “Compl.” at ¶¶ 7–12). Defendant Shai Rozio owns and manages
17 Defendant MySpecs Limited, an online retailer. *Id.* at ¶¶ 5–6. Plaintiff alleges Defendants
18 are selling merchandise using counterfeit trademarks. Defendants seek dismissal of the
19 Complaint. (Doc. 14, “Mot.”). But the Complaint contains sufficient allegations to require
20 an answer.

21 **BACKGROUND**

22 Plaintiff alleges the following facts in the Complaint. Plaintiff manufactures,
23 markets, and sells eyewear under a plethora of brands, including Ray-Ban. Plaintiff also
24 operates more than 7,000 optical and retail stores worldwide. *Id.* at ¶¶ 7–8. Plaintiff holds
25 a variety of registered trademarks associated with the Ray-Ban brand (“Ray-Ban
26 Trademarks”) which have become “widely recognized and exclusively associated by
27 consumers, the public, and the trade as being high quality products sources from Luxottica
28 Group.” *Id.* at 10–17.

1 In February 2021, Plaintiff discovered Defendants’ distribution of sunglasses
2 bearing counterfeits of the Ray-Ban Trademarks. *Id.* at ¶ 18. In February 2021, Plaintiff’s
3 investigator purchased two pairs of sunglasses bearing counterfeits of one or more of the
4 Ray-Ban Trademarks from Defendants’ “MySpecs” online storefront. *Id.* at ¶ 19. On
5 September 8, 2021, Plaintiff sent Defendants a cease-and-desist letter demanding
6 Defendants cease advertising and selling counterfeit merchandise and submit information
7 to Plaintiff detailing the source of the counterfeit Ray-Ban merchandise. *Id.* at ¶ 20.
8 Defendants did not respond. *Id.* Between September 2021 and November 2022, Plaintiff’s
9 investigator purchased seven more pairs of sunglasses from Defendants’ online storefronts
10 and determined each of the items bore counterfeit Ray-Ban Trademarks. *Id.* at ¶¶ 21–28.
11 On July 14, 2023, Plaintiff filed the present action seeking damages and an injunction
12 preventing Defendants from selling merchandise containing counterfeit Ray-Ban
13 Trademarks.

14 ANALYSIS

15 A pleading must contain a “short and plain statement of the claim showing that the
16 pleader is entitled to relief.” Fed. R. Civ. P. 8(a)(2). “To survive a motion to dismiss, a
17 complaint must contain sufficient factual matter, accepted as true, to ‘state a claim to relief
18 that is plausible on its face.’” *Ashcroft v. Iqbal*, 556 U.S. 662, 678 (2009) (quoting *Bell Atl.*
19 *Corp. v. Twombly*, 550 U.S. 544, 555 (2007) (internal citations omitted)). “[W]here the
20 well-pleaded facts do not permit the court to infer more than the mere possibility of
21 misconduct, the complaint” has not adequately shown the pleader is entitled to relief. *Id.*
22 at 679. Although federal courts ruling on a motion to dismiss “must take all of the factual
23 allegations in the complaint as true, [they] ‘are not bound to accept as true a legal
24 conclusion couched as a factual allegation.’” *Id.* at 678 (quoting *Twombly*, 550 U.S. at
25 555).

26 Plaintiff’s sole cause of action alleges trademark infringement by Defendants under
27 Section 32 of the Lanham Act, 15 U.S.C. § 1114. Compl. at ¶¶ 39–44. Section 32 of the
28 Lanham Act prohibits the “use in commerce” of “any reproduction, counterfeit, copy, or

1 colorable imitation of a registered mark in connection with the sale, offering for sale,
2 distribution, or advertising of any goods or services on or in connection with which such
3 use is likely to cause confusion, or to cause mistake, or to deceive.”
4 15 U.S.C. § 1114(1)(a). To successfully bring a trademark infringement claim, a plaintiff
5 must allege “(1) that it has a protectible ownership interest in the mark; and (2) that the
6 defendant’s use of the mark is likely to cause consumer confusion.” *Network Automation*
7 *Inc. v. Advanced Sys. Concepts, Inc.*, 638 F.3d 1137, 1144 (9th Cir. 2011).

8 Defendant’s Motion to Dismiss presents three arguments. First, the Complaint does
9 not set forth sufficient facts linking Defendant to the sunglasses purchased by Plaintiff’s
10 investigator. Second, the Complaint does not adequately identify which trademarks were
11 misused. And third, the Complaint does not contain sufficient facts alleging a likelihood
12 of consumer confusion. All three arguments fail.

13 Defendants first argue Plaintiff does not sufficiently “tie[] the purchased sunglasses
14 to Defendants except for the conclusory statement that Luxottica Group’s investigator
15 visited Defendants’ online storefront and purchased sunglasses.” Mot. at 3 (internal
16 quotations omitted). Defendants argue Plaintiff must allege additional facts, such as
17 receipts, screenshots, or shipping materials associated with the order to establish the
18 sunglasses were ordered and received from Defendants. *Id.* at 4. That is incorrect. A party
19 may not rely on assertions “so vague or broad so as to fail to provide notice of the
20 allegations.” *Transamerica Life Ins. Co. v. Jurin*, No. 14-cv-1881, 2014 WL 3519205
21 (N.D. Cal. July 16, 2014); *see also Gustavson v. Wrigley Sales Co.*, 961 F. Supp. 2d 1100,
22 1131 (N.D. Cal. 2013) (“[N]either Rule 8(a), nor the Supreme Court’s decisions in
23 *Twombly* and *Iqbal* require a plaintiff to prove her case the moment she files her
24 complaint.”). But a party need not plead every single fact or piece of evidence that
25 underlies its claim at this stage.

26 Plaintiff has alleged seven separate instances of its investigator purchasing
27 sunglasses from Defendants, including the date of each purchase, the online storefront the
28 purchase was made through, the price paid for each pair of sunglasses, and descriptions

1 and photographs of the sunglasses and accessories received. Compl. at ¶¶ 19–26. That
2 Plaintiff did not also include photographs of the receipts issued for these purchases does
3 not render these allegations implausible or insufficient to state a claim for relief.

4 Defendants’ second argument is the Complaint does not identify which trademark
5 Defendants allegedly infringed. Mot. at 4. That is, Plaintiff has more than one trademark
6 and Defendants believe the Complaint should have identified each alleged misuse of each
7 trademark. As support for this claim, Defendants misrepresent the effect of *Ketab Corp.*
8 *v. Mesriani and Assocs., P.C.* on the present case. 734 Fed. App’x 401 (9th Cir. 2018).
9 Defendants claim *Ketab* requires Plaintiff to show how the trademarks on Defendants’
10 products are “incorrect or inconsistent” with the Ray-Ban Trademarks, presumably through
11 a detailed analysis or side-by-side comparison of the Ray-Ban Trademarks and each of the
12 several alleged counterfeit marks on each product. Mot. at 5. Defendants argue Plaintiff,
13 like the *Ketab* plaintiff, “failed to allege with specificity which of its particular alleged
14 marks” the defendants “infringed upon and how.” *Ketab*, 734 Fed. App’x. at 406. But
15 Plaintiff has offered far more than the plaintiff in *Ketab*.

16 In *Ketab*, among several other fatal deficiencies, the plaintiff did not even identify
17 or provide examples or images of an entire category of its own marks it claimed were
18 infringed upon. *Ketab Corp. v. Mesriani & Assocs.*, No. 14-cv-7241, 2015 WL 5050512,
19 at *1 (C.D. Cal. Aug. 26, 2015), *aff’d in part, vacated in part, remanded sub nom. Ketab*
20 *Corp. v. Mesriani & Assocs., P.C.*, 734 F. App’x 401 (9th Cir. 2018). Here, Plaintiff
21 specifically identifies each of the eight Ray-Ban Trademarks it alleges Defendant has
22 infringed upon, including an image of each mark, its registration number, and a description
23 of the goods the mark is used on. Compl. at ¶ 12. Further, images of the products allegedly
24 received from Defendants display marks bearing facial similarity to the identified Ray-Ban
25 Trademarks. *Id.* at ¶¶ 19–26. Plaintiff’s identification of its Ray-Ban Trademarks, along
26 with the specific allegations that each pair of sunglasses and accessories purchased from
27 Defendants bore counterfeits of one or more of the Ray-Ban Trademarks, are sufficient.

28 Defendants’ third and final argument is Plaintiff’s allegations of a likelihood of

1 confusion are “mere legal conclusions” rendering Plaintiff’s claim subject to dismissal.
2 Mot. at 5–6. But this argument does not apply when the alleged instances of trademark
3 infringement involve counterfeit marks.

4 The Ninth Circuit has described a “counterfeit mark” as “a non-genuine mark
5 identical to the registered, genuine mark of another.” *Louis Vuitton Malletier, S.A. v.*
6 *Akanoc Sols., Inc.*, 658 F.3d 936, 946 (9th Cir. 2011). Allegations involving use of a
7 counterfeit mark are viewed differently than other instances of trademark infringement.
8 That is, courts within the Ninth Circuit normally assess the likelihood of consumer
9 confusion with an eight-factor test. But “it is unnecessary to perform the step-by-step
10 examination” in cases involving counterfeit marks “because counterfeit marks are
11 inherently confusing.” *Shalabi*, 352 F. Supp. 2d at 1073. Plaintiff plausibly alleges its
12 investigator purchased nine pairs of sunglasses from Defendants’ online storefronts
13 between February 2021 and November 2022 and determined each bore counterfeit
14 Ray-Ban Trademarks. Compl. at ¶¶ 19–27. While these allegations alone would suffice,
15 Plaintiff also alleges Defendants’ actions “have caused” and “are likely to continue to cause
16 confusion or mistake, or to deceive consumers, the public, and the trade into believing that
17 the Counterfeit Merchandise offered for sale and sold by Defendants is authentic or
18 authorized products of Luxottica Group.” *Id.* at ¶ 30.

19 Hoping to avoid this conclusion, Defendants offer misplaced authority. According
20 to Defendants, Plaintiff’s “conclusory allegations” are like those in *Carter v. Oath*
21 *Holdings, Inc.*, No. 17-cv-7086, 2018 WL 3067985 (N.D. Cal. June 21, 2018). But in
22 *Carter*, the plaintiff merely alleged the defendant’s counterfeit marks misrepresented the
23 “designation of origin” and that the counterfeit marks were “deceptive, confusing,” and
24 “likely to cause mistake.” *Id.* at *3. Plaintiff has offered far more factual detail than this.
25 As noted above, Plaintiff’s Complaint contains images of products bearing what appear to
26 be substantially identical marks to the identified Ray-Ban Trademarks and plausible
27 allegations that the products contain counterfeit (and thus, inherently confusing) marks.
28 Compl. at ¶¶ 12, 19–26. At this stage, these allegations are more than sufficient to allege

1 a likelihood of consumer confusion. *See, e.g., Ferrero S.p.A. v. Imex Leader, Inc.*,
2 No. 17-cv-2152, 2018 WL 11346538 (finding similarities in products and packaging based
3 in part on review of images in the complaint were sufficient to plead a likelihood of
4 consumer confusion).

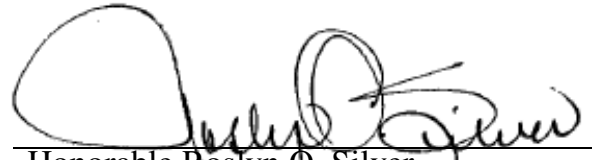
5 **CONCLUSION**

6 Plaintiff has adequately alleged its own investigation revealed Defendants engaged
7 in the marketing and sale of products containing counterfeit Ray-Ban trademarks. These
8 facts are sufficient to state a trademark infringement claim against Defendants at the motion
9 to dismiss stage.

10 Accordingly,

11 **IT IS ORDERED** Defendants' Motion to Dismiss (Doc. 14) is **DENIED**.

12 Dated this 5th day of January, 2024.

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16 Honorable Roslyn O. Silver
17 Senior United States District Judge
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