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UNITED STATES DISTRICT COURT  
CENTRAL DISTRICT OF CALIFORNIA

AECOM ENERGY &  
CONSTRUCTION, INC.,  
  
Plaintiff,  
  
v.  
  
JOHN RIPLEY; TODD HALE;  
GARY TOPOLEWSKI; HENRY  
BLUM; BUD ZUKALOFF;  
"MORRISON KNUDSEN  
CORPORATION;" "MORRISON-  
KNUDSEN COMPANY, INC.;"  
"MORRISON-KNUDSEN SERVICES,  
INC.;" and "MORRISON-  
KNUDSEN INTERNATIONAL  
INC.,"  
  
Defendants.

CV 17-5398-RSWL-SSx  
**REDACTED BY THE COURT**  
ORDER re: Plaintiff's  
Motion for Summary  
Judgment and for  
Permanent Injunction  
against Defendants Gary  
Topolewski; Morrison  
Knudsen Corporation;  
Morrison-Knudsen  
Company, Inc.; Morrison-  
Knudsen Services, Inc.;  
and Morrison-Knudsen  
International Inc. [157]

Currently before the Court is Plaintiff AECOM Energy & Construction, Inc.'s ("Plaintiff") Motion for Summary Judgment and Permanent Injunction [157] ("Motion"). Having reviewed all papers submitted pertaining to this Motion, the Court **NOW FINDS AND**

1 **RULES AS FOLLOWS:** the Court **GRANTS** Plaintiff's Motion  
2 against Defendants Gary Topolewski, Morrison Knudsen  
3 Corporation, Morrison-Knudsen Company, Inc., Morrison-  
4 Knudsen Services, Inc., and Morrison-Knudsen  
5 International Inc.

## 6 **I. BACKGROUND**

### 7 **A. Factual Background**

#### 8 1. Plaintiff's Corporate History

9 Morrison Knudsen Corporation ("MK") was a renowned  
10 multinational construction and engineering firm  
11 responsible for many notable projects, including the  
12 Hoover Dam, the San Francisco-Oakland Bay Bridge, and  
13 the Trans-Alaska Pipeline. Pl.'s Statement of  
14 Uncontroverted Facts ("Pl.'s SUF") ¶ 3(b), ECF No. 173.

15 MK has used many trademarks including: "MORRISON  
16 KNUDSEN," the MKO logo, and "MKCO MORRISON KNUDSEN"  
17 (collectively, the "MK Marks"). Id. ¶ 17(b).  
18 Plaintiff maintained trademark registrations for the MK  
19 Marks until February 2016, id. ¶ 17(b)-(c), and  
20 continues to use MK's logo and corporate history in  
21 many of its current promotional materials. Id. ¶ 17  
22 (listing exemplars); Decl. of Charles Szurgot ("Szurgot  
23 Decl.") ¶ 8, Exs. 1-7, ECF No. 175.

24 In 1996, MK merged with Washington Construction  
25 Group, Inc. ("WGI"), while continuing to operate under  
26 the name "Morrison Knudsen Corporation." Szurgot Decl.  
27 ¶ 5. In 2000, MK changed its name to WGI. Id. In  
28 2007, URS Corp. ("URS") acquired WGI, and in 2014,

1 AECOM, the parent company of Plaintiff AECOM Energy &  
2 Construction, Inc., acquired URS and its subsidiaries.  
3 Id. ¶¶ 6-7.

4 2. Defendants' Use of MK Name

5 Plaintiff alleges that, beginning in 2008,  
6 Defendants Gary Topolewski, Morrison Knudsen  
7 Corporation, Morrison-Knudsen Company, Inc., Morrison-  
8 Knudsen Services, Inc., and Morrison-Knudsen  
9 International Inc., (collectively, the "Defendants"),  
10 undertook an elaborate scheme to pass themselves off as  
11 MK and take advantage of MK's good reputation. Pl's.  
12 Mem. re Mot. for Summ. J. ("Mot.") 4:8-9, ECF No. 172.

13 a. "*Morrison-Knudsen Services, Inc.*"

14 Morrison-Knudsen Services, Inc. was an affiliate of  
15 MK incorporated in Nevada in 1982 under a different  
16 name, but changed its name to Morrison-Knudsen  
17 Services, Inc. in 1983. Decl. of Diana M. Torres  
18 ("Torres Decl.") ¶ 19, ECF No. 174; id., Ex. Q,  
19 Corporate Records of Morrison-Knudsen Services, Inc.  
20 947-52, 954-55, ECF No. 174-17. In 2002, MK dissolved  
21 Morrison-Knudsen Services, Inc. through its Vice  
22 President and General Counsel. Id., Ex. Q at 987-89.

23 In 2008, defaulting Defendant Todd Hale<sup>1</sup> filed a  
24 Certificate of Revival with the Nevada Secretary of  
25 State's office for Morrison-Knudsen Services, Inc.,  
26

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27 <sup>1</sup> Default was entered by the Clerk against Defendant Todd  
28 Hale, as well as Defendants Henry Blum, John Ripley and Bud  
Zukaloff, on December 4, 2017 [77].

1 swearing under penalty of perjury that he had authority  
2 to do so from the company's board of directors. Id.,  
3 Ex. Q at 990-93, ECF No. 174-17. The Certificate of  
4 Revival lists defaulting Defendant Henry Blum as Vice  
5 President and defaulting Defendant John Ripley as  
6 Secretary. Id., Ex. Q at 991. In 2008, Hale filed the  
7 annual list of officers and directors listing Morrison-  
8 Knudsen Services' address as 2049 Century Park East,  
9 Suite 3850, Los Angeles, California 90067. Id., Ex. Q  
10 at 996. Around 2007 or 2008, Blum contacted Defendant  
11 Topolewski about reviving "Morrison Knudsen." Torres  
12 Decl. Ex. B, at 25:19-26:9, 27:5-6. Defendant  
13 Topolewski was later listed as President and Secretary  
14 in 2010; Chairman in 2011; Chairman, Director, and  
15 President in 2014; Secretary and Director in 2016; and  
16 President, Secretary, and Director in 2017. Id., Ex.  
17 Q, at 996-1005.

18 b. *"Morrison Knudsen Corporation"*

19 MK incorporated Morrison Knudsen of Viet Nam ("MK  
20 Viet Nam") in 1996 and dissolved it in 2002. Torres  
21 Decl. ¶ 20, Ex. R, Corporate Records of Morrison  
22 Knudsen Corp. 1019-21, 1029-30, ECF No. 174-18. In  
23 October 2014, Defendants Topolewski and Blum filed a  
24 Certificate of Revival with the Nevada Secretary of  
25 State, seeking to reinstate MK Viet Nam and declaring,  
26 under penalty of perjury, that they had authority to do  
27 so from MK Viet Nam's board of directors. Id. at 1033-  
28 35. The Certificate of Revival listed Defendant

1 Topolewski as President, Secretary, and Treasurer;  
2 defaulting Defendant Blum as Vice President; and  
3 defaulting Defendants Ripley and Hale as Directors.  
4 Id. The address for each was listed as 2049 Century  
5 Park East, Suite 3850, Los Angeles, California 90067.  
6 Id. at 1033.

7 Later that month, after MK Viet Nam was revived,  
8 Defendant Topolewski filed a Certificate of Amendment  
9 with the Nevada Secretary of State to change the name  
10 of MK Viet Nam to "Morrison Knudsen Corporation." Id.  
11 at 1036. The annual list of officers filed on January  
12 27, 2016 reflects the name change. Id. at 1037.

13 c. *"Morrison-Knudsen International Inc." and*  
14 *"Morrison-Knudsen Company"*

15 Plaintiff also alleges the names of two unrelated  
16 entities, E Planet Communications, Inc. ("E Planet")  
17 and Westland Petroleum Corporation ("Westland"), were  
18 changed to make them appear to be MK affiliates. Pl.'s  
19 Mot. at 4:28-5:7.

20 First, E Planet was incorporated in Nevada in 2011.  
21 Torres Decl. ¶ 21, Ex. S, Corporate Records of  
22 Morrison-Knudsen Int'l Inc. 1050, ECF No. 174-19. As  
23 of 2012, the company's records listed Defendant  
24 Topolewski as E Planet's President and Secretary. Id.  
25 In May 2016, defaulting Defendant Zukaloff filed a  
26 Certificate of Amendment with the Nevada Secretary of  
27 State to change the name of E Planet Communications,  
28 Inc. to "Morrison-Knudsen International Inc." Id. at

1 1065.

2 Second, Westland was incorporated in Nevada in 1926  
3 and fell out of good standing in 2013. Torres Decl. ¶  
4 22, Ex. T, Corporate Records for Morrison-Knudsen  
5 Company, Inc., 1068-74, 1087-88, ECF No. 174-20. In  
6 October 2016, John Anderson, listed as Vice President  
7 of Westland, filed a Certificate of Reinstatement for  
8 Westland with the Nevada Secretary of State. Torres  
9 Decl. in Supp. Prelim. Inj. Ex. 4, 150-152, ECF No. 19-  
10 4. The records listed Westland Petroleum's address as  
11 2049 Century Park East, Suite 3850, Los Angeles,  
12 California 90067. Id. at 151. The Nevada Secretary of  
13 State granted reinstatement sometime that month, and on  
14 October 18, 2016, defaulting Defendant Ripley filed a  
15 Certificate of Amendment with the Nevada Secretary of  
16 State to change Westland's name to "Morrison-Knudsen  
17 Company, Inc." Id.

18 d. *Websites and Press Releases*

19 On March 25, 2008, Defendant Morrison Knudsen  
20 Corporation registered the domain names [www.morrison-  
knudsen.com](http://www.morrison-<br/>21 knudsen.com) and [www.morrison-knudsen.net](http://www.morrison-knudsen.net). Torres Decl.  
22 ¶¶ 9-10; id. Exs. E-F, Whois Record. The website  
23 contained promotions of MK's history, current AECOM  
24 projects, a current business relationship AECOM has  
25 with a construction equipment maker, and the website  
26 also offered to sell construction equipment used in  
27 MK's projects. See Pl.'s SUF ¶ 2(b),(f), ¶ 4(a)-  
28 (b),(k)-(n).

1 "Morrison Knudsen" issued three press releases  
2 claiming original MK projects and announcing: (1) on  
3 March 16, 2016, "Morrison Knudsen Awarded \$570 Million  
4 Environmental Clean Up Project"; (2) on June 30, 2016,  
5 "Morrison Knudsen Awarded \$36 Million Mine Engineering  
6 Contract"; and (3) on April 11, 2017, "Morrison Knudsen  
7 awarded \$1.2 Billion Construction and Engineering  
8 Contract". Torres Decl. ¶¶ 16-18, Exs. N-P, ECF Nos.  
9 174-14, 174-15, 174-16.

10 3. Take Over of the MK Marks

11 On November 10, 2014, defaulting Defendant Hale  
12 submitted a "change of address" form to the United  
13 States Patent and Trademark Office ("USPTO"). Decl. of  
14 Annette Bottaro-Walklet ("Walklet Decl.") ¶ 6, ECF No.  
15 14; id. Ex. F., ECF No. 14-1. The contact information  
16 listed in the USPTO records for two of Plaintiff's  
17 registered trademarks ("MORRISON KNUDSEN" and "MKCO  
18 MORRISON KNUDSEN") was changed from Plaintiff's  
19 addresses, to Hale's email address [todd.hale@morrison-  
knudsen.com](mailto:todd.hale@morrison-<br/>20 knudsen.com), and the physical address of 2049 Century  
21 Park East, Suite 3850, Los Angeles, California 90067.  
22 See Torres Decl. ¶ 23, Ex. U, USPTO Record, ECF No.  
23 174-21.

24 On November 11, 2015, defaulting Defendant Zukaloff  
25 submitted a document to the USPTO purporting to assign  
26 the registered trademark "MKCO MORRISON KNUDSEN" from  
27 Washington Group International (a previous name of  
28 Plaintiff) to Defendant Morrison Knudsen Corporation,

1 listed at 2049 Century Park East, Suite 3850, Los  
2 Angeles, California 90067. Id. ¶ 24, Ex. V, USPTO  
3 Record, ECF No. 174-22. On March 26, 2016, Defendant  
4 Morrison Knudsen Corporation filed a new application  
5 with the USPTO to register the mark "MORRISON KNUDSEN,"  
6 declaring under penalty of perjury that they owned the  
7 mark and claiming a first-use date of April 18, 1933.  
8 See id. Ex. W, ECF No. 174-23.

9 **B. Procedural Background**

10 Plaintiff filed its Complaint [1] on July 21, 2017,  
11 alleging the following claims:

- 12 1) False Designation of Origin
- 13 2) False Advertising
- 14 3) Cyberpiracy
- 15 4) California Common Law Unfair Competition
- 16 5) California Statutory Unfair Competition
- 17 6) California Statutory False Advertising
- 18 7) Petition for Cancellation of Registered Mark

19 Plaintiff filed a Motion for Preliminary Injunction  
20 [11] on August 1, 2017. This Court granted Plaintiff's  
21 Motion for Preliminary Injunction [45] on September 28,  
22 2017. The Clerk of Court entered default against  
23 Defendants Todd Hale, Henry Blum, John Ripley, and Bud  
24 Zukaloff [77] on December 4, 2017.

25 On July 24, 2018 Plaintiff filed the instant Motion  
26 for Summary Judgment and Permanent Injunction [157]  
27 against the remaining Defendants: Gary Topolewski;  
28 Morrison Knudsen Corporation; Morrison-Knudsen Company,



1 Inc.; Morrison-Knudsen Services, Inc.; and Morrison-  
2 Knudsen International Inc. The Court entered a joint  
3 stipulation on July 31, 2018 [167], setting August 17,  
4 2018, as Defendants' deadline to file their Opposition.  
5 Plaintiff filed a Response on August 20, 2018 [184],  
6 claiming that its Motion should be granted because  
7 Defendants failed to timely file their Opposition.  
8 Defendants then filed a Memorandum of Good Cause for  
9 its Late-Filed Opposition [186] on August 20, 2018, and  
10 its Opposition [187] on August 21, 2018. Plaintiff  
11 filed its Second Reply [201] in response to Defendants'  
12 Opposition on September 4, 2018.

## 13 II. DISCUSSION

### 14 A. Legal Standard

15 Federal Rule of Civil Procedure 56(a) states that a  
16 "court shall grant summary judgment" when "the movant  
17 shows that there is no genuine dispute as to any  
18 material fact and the movant is entitled to judgment as  
19 a matter of law." Fed. R. Civ. P. 56(a). A fact is  
20 "material" for purposes of summary judgment if it might  
21 affect the outcome of the suit, and a "genuine" issue  
22 exists if the evidence is such that a reasonable fact-  
23 finder could return a verdict for the nonmovant.

24 Anderson v. Liberty Lobby, Inc., 477 U.S. 242, 248  
25 (1986). The evidence, and any inferences based on  
26 underlying facts, must be viewed in the light most  
27 favorable to the nonmovant. Twentieth Century-Fox Film  
28 Corp. v. MCA, Inc., 715 F.2d 1327, 1328-29 (9th Cir.

1 1983). In ruling on a motion for summary judgment, the  
2 court's function is not to weigh the evidence, but only  
3 to determine if a genuine issue of material fact  
4 exists. Anderson, 477 U.S. at 255.

5 Under Rule 56, the party moving for summary  
6 judgment has the initial burden to show "no genuine  
7 dispute as to any material fact." Fed. R. Civ. P.  
8 56(a); see Nissan Fire & Marine Ins. Co. v. Fritz Cos.,  
9 210 F.3d 1099, 1102-03 (9th Cir. 2000). The burden  
10 then shifts to the non-moving party to produce  
11 admissible evidence showing a triable issue of fact.  
12 Nissan Fire & Marine Ins., 210 F.3d at 1102-03.

### 13 **B. Discussion**

#### 14 1. Defendants' Late-Filed Opposition

15 On July 31, 2018, the Court entered a joint  
16 stipulation extending Defendants' deadline to file  
17 their Opposition to August 17, 2018 [167]. However, on  
18 August 20, 2018, Plaintiff filed a response addressing  
19 the fact that Defendants had not yet filed their  
20 Opposition [184]. Defendants then filed their  
21 Opposition on August 21, 2018 [187]. With their  
22 Opposition, Defendants filed a Memorandum of Points and  
23 Authorities re Good Cause for the Court to Accept the  
24 Late-Filed Opposition [186]. Defendants argue that the  
25 short delay did not prejudice or impact Plaintiff  
26 because Plaintiff still had 15 days to file its Reply  
27 pursuant to the stipulation, a week longer than  
28 contemplated under Local Rules 7-9 and 7-10.

1 Regardless, Local Rule 7-12 prohibits the Court from  
2 granting a motion solely based on the failure to file  
3 an opposition within the deadline for motions pursuant  
4 to Fed. Rule Civ. P. 56. As such, the Court will  
5 exercise its discretion to consider the late-filed  
6 Opposition and rule on the merits of Plaintiff's  
7 Motion.

8 2. Defendants' Evidentiary Objections

9 a. *Declarations*

10 Defendants make numerous evidentiary objections  
11 [189] to the following: (1) Declaration of Diana M.  
12 Torres [174], (2) Declaration of Tara McAdam Kassal  
13 [157-2], (3) Declaration of Lea Ann Russell [175-3],  
14 (4) Declaration of Ed Toms [175-4], and (5) Declaration  
15 of Charles Szurgot [175]. The Court **OVERRULES**  
16 Defendants' evidentiary objections because they "are  
17 boilerplate and devoid of any specific argument or  
18 analysis as to why any particular exhibit or assertion  
19 in a declaration should be excluded." United States v.  
20 HIV Cat Canyon, Inc., 213 F. Supp. 3d 1249, 1257 (C.D.  
21 Cal. 2016); see also Stonefire Grill, Inc. v. FGF  
22 Brands, Inc., 987 F. Supp. 2d 1023, 1033 (C.D. Cal.  
23 2013)(refusing to "scrutinize each objection and give a  
24 full analysis of identical objections"); Amaretto Ranch  
25 Breedables v. Ozimals, Inc., 907 F. Supp. 2d 1080, 1081  
26 (N.D. Cal. 2012)("This Court need not address  
27 boilerplate evidentiary objections."); Capitol Records,  
28 LLC v. BlueBeat, Inc., 765 F. Supp. 2d 1198, 1200 n.1

1 (C.D. Cal. 2010)(noting that "it is often unnecessary  
2 and impractical" to scrutinize "boilerplate recitations  
3 of evidentiary principles or blanket  
4 objections")(citation omitted).

5 b. *Evidence in Support of Plaintiff's Reply*

6 Defendants also object to Exhibit 4 to Plaintiff's  
7 Reply in Support of its Motion [209] consisting of  
8 three press releases, in which Defendants announce  
9 contracts totaling \$1.806 billion. See Defs.' Obj.,  
10 ECF No. 216. Defendants argue that Plaintiff cannot  
11 rely on these press releases because they were  
12 disclosed after the close of discovery. A party must  
13 make certain initial disclosures "without awaiting a  
14 discovery request," including a "computation of each  
15 category of damages claimed." Fed. R. Civ. P.  
16 26(a)(1)(A)(iii). Where a party fails to disclose  
17 information required by Rule 26, "the party is not  
18 allowed to use that information or witness to supply  
19 evidence on a motion, at a hearing, or at trial, unless  
20 the failure was substantially justified or is  
21 harmless." Fed. R. Civ. P. 37(c)(1). Moreover, the  
22 Court detailed in its Order re Oral Argument [229] that  
23 Plaintiff was substantially justified in its delay in  
24 disclosing the press release given Defendants lengthy  
25 history of bad faith litigation practices,<sup>2</sup> and no

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26  
27 <sup>2</sup> Plaintiff stated in its Initial Disclosure it is seeking  
28 Defendants' "profits and advantages received" from using the MK  
brand, and repeatedly requested Defendants' provide a calculation

1 prejudice to Defendants as a result. See Order re Oral  
2 Argument, ECF No. 229. For these reasons, the Court  
3 **OVERRULES** Defendants' Objection to the three press  
4 releases.

5 3. Plaintiff's Evidentiary Objections

6 Plaintiff makes several evidentiary objections to  
7 the Declaration of Drew Sherman in Support of  
8 Defendants' Opposition ("Sherman Decl.") [187-1].

9 First, Plaintiff objects to Defendants' use of a Senior  
10 Thesis from Boise State University on MK ("Senior  
11 Thesis"). See Sherman Decl., Ex. A at 7-10, ECF No.  
12 187-1. Defendants rely on a one-page excerpt from the  
13 Senior Thesis for its proposition that MK changed its  
14 name to rid a "tarnished reputation." Def.'s Stmt. of  
15 Genuine Disputes of Fact ("SGDF") ¶ 2(b), ECF No. 188.  
16 Plaintiff argues that Sherman has no personal knowledge  
17 of who the author is, the author's background, how the  
18 Senior Thesis was created, or what materials the author  
19 considered. Pl's Evidentiary Objs. 1:13-16, ECF No.  
20 203. As required by Rule 56, documentary materials  
21 need authentication through affidavits or declarations  
22 from individuals with personal knowledge of the  
23 document. Zoslaw v. MCA Distrib. Corp., 693 F.2d 870,  
24 883 (9th Cir. 1982). While Sherman states it is a  
25 "true and correct copy of the Senior Thesis from Boise

26 \_\_\_\_\_  
27 of its revenue since then. See Order re Oral Argument 3-4, ECF  
28 No. 229. Defendants, however, never provided such information,  
despite Court order and several deadline extensions. Id. at 4.

1 State University," Defendants have not established  
2 Sherman has the personal knowledge required to  
3 authenticate the document. See Fed. R. Evid. 602, 901.  
4 Additionally, Defendants rely on the Senior Thesis for  
5 its content containing a quote of a former MK worker  
6 stating, "[b]ut just imagine the value of the name and  
7 reputation and history they're wiping out with that one  
8 stroke." See Ex. A at 10. Because these statements  
9 are hearsay and not admissible under an exception, the  
10 Court **SUSTAINS** Plaintiff's Objections. See Fed. R.  
11 Evid. 802-803.

12 Plaintiff also objects to the following exhibits on  
13 the grounds that Defendants never produced them during  
14 discovery: (1) Trademark Registrations, see Sherman  
15 Decl. ¶¶ 7-9, Exs. B1-B26; (2) State of Ohio Forms, see  
16 id. at ¶¶ 10-11, Exs. C1-C27; and (3) USPTO  
17 Registration, see id. at ¶¶ 20-21, Ex. F. Because the  
18 Court does not rely on the objected-to-evidence, the  
19 Court **SUSTAINS as MOOT** this objection.

20 Finally, Plaintiff objects to forty pages of the  
21 Szurgot Deposition Transcript Defendants submitted as  
22 Exhibit D to the Sherman Declaration because Defendants  
23 do not identify with specificity the portions of the  
24 transcript they rely upon. Pl.'s Objs. at 3:11-12. A  
25 party asserting a fact is genuinely disputed must  
26 support the assertion by "citing to particular parts of  
27 materials in the record, including depositions . . .  
28 ."). Fed. R. Civ. P. 56(c)(1)(A). Defendants cite

1 specifically to portions of the transcript in their  
2 Statement of Genuine Disputes, see SGDF ¶ 9, thus the  
3 Court **OVERRULES** this objection.

4 4. Summary Judgment

5 Plaintiff seeks summary judgment on each of  
6 Plaintiff's causes of action. The Court addresses  
7 these in turn.

8 a. *False Designation of Origin*

9 "Section 43(a) of the Lanham Act, 15 U.S.C.  
10 § 1125(a), forbids the use of false designations of  
11 origin and false descriptions or representations in the  
12 advertising and sale of goods and services." Smith v.  
13 Montoro, 648 F.2d 602, 603 (9th Cir. 1981). "Passing  
14 off," which consists of the "selling of a good or  
15 service of one's own creation under the name or mark of  
16 another," has consistently been held to violate section  
17 43(a). Id. at 604. To succeed on its false  
18 designation claim for "passing off," Plaintiff must  
19 prove that Defendants "(1) use[d] in commerce (2) any  
20 word, false designation of origin, false or misleading  
21 description, or representation of fact, which (3) is  
22 likely to cause confusion or misrepresents the  
23 characteristics of his or another person's goods or  
24 services." Freecycle Network, Inc. v. Oey, 505 F.3d  
25 898, 902 (9th Cir. 2007).<sup>3</sup>

---

26  
27 <sup>3</sup> Defendants argue that to prove false designation,  
28 Plaintiff must demonstrate (1) that it owns a valid, protectable  
trademark, and (2) that Defendant used the mark in a manner

1 i. *Use in Commerce*

2 "[C]ommunications made on public websites" satisfy  
3 the use in commerce requirement. Nat'l Grange of the  
4 Order of Patrons of Husbandry v. Cal. State Grange, No.  
5 2:16-201 WBS DB, 2016 WL 6696061, at \*4 (E.D. Cal. Nov.  
6 15, 2016)(citing United States v. Sutcliffe, 505 F.3d  
7 944, 952-53 (9th Cir. 2007)(holding that "use of the  
8 internet is intimately related to interstate  
9 commerce"))).

10 Plaintiff argues that Defendants used the MK Marks<sup>4</sup>  
11 on their website, [www.morrison-knudsen.com](http://www.morrison-knudsen.com) and  
12 [www.morrison-knudsen.net](http://www.morrison-knudsen.net)<sup>5</sup> to pass themselves off as  
13 "Morrison-Knudsen." Plaintiff states as an  
14 uncontroverted fact that "Defendants," collectively,  
15 all used the MK Marks on the websites. Pl.'s SUF ¶1.  
16 Defendants jointly filed one Statement of Genuine  
17 Dispute of Facts ("SGDF"), in which they also refer to

18 \_\_\_\_\_  
19 likely to cause confusion. Def.'s Opp'n at 5:19-23. However, as  
20 Plaintiff points out, this is the test for traditional trademark  
21 infringement, and not the test for false designation of origin  
22 for "passing off." Dep't of Parks & Recreation v. Bazaar Del  
23 Mundo, Inc., 448 F.3d 1118, 1124 (9th Cir. 2006)(reciting the  
24 above test "to prevail on [a] claim of trademark infringement").  
Thus, Plaintiff need not prove ownership of the marks to prove  
its false designation claim. Defendants' lengthy argument and  
evidence put forth to claim that Plaintiff is not the owner or  
senior user of the MK Marks is thus irrelevant.

25 <sup>4</sup> The word mark MORRISON KNUDSEN, the MK logo, and the  
26 combined word and design mark MKCO MORRISON KNUDSEN are referred  
to each as an "MK MARK," and collectively as the "MK MARKS."

27 <sup>5</sup> These two domain names refer to the same website, just  
28 available at two different domains. Torres Decl. ¶ 5, Ex. B,  
Topolewski Dep., 81:14-23, ECF No. 174-2.



1 themselves collectively as "Defendants." See Defs.'  
2 SDGF, ECF No. 188. In their Opposition, Defendants  
3 briefly argue that Plaintiff did not articulate which  
4 "uncontroverted fact" applies to each Defendant.  
5 Def.'s Opp'n 2:10-11, ECF No. 187. However, nowhere in  
6 Defendants' SGDF did any of the Defendants dispute  
7 Plaintiff's grouping of them together. And neither did  
8 Defendants dispute Plaintiff's claim that all of the  
9 Defendants used the website. Defendants one-sentence  
10 argument with no cited authority or evidence in their  
11 Opposition is insufficient to create a genuine issue of  
12 material fact. U.S. v. Baisden, No. 1:06-cv-01368-AWI-  
13 MJS, 2013 WL 1222101, at \*7 (E.D. Cal. Mar. 25, 2013)(a  
14 party may not "create a 'genuine' issue of 'material'  
15 fact simply by making assertions in [their] legal  
16 memoranda.")(citing Helmich v. Kennedy, 796 F.2d 1441,  
17 1443 (11th Cir. 1986)).

18 In their SGDF, Defendants only dispute the website  
19 to the extent it is identical and confusingly similar  
20 to the MK Marks, and that they registered the domain  
21 names with a bad faith intent. Def.'s SGDF ¶¶ 10-11.  
22 Because Defendants did not dispute Plaintiff's  
23 contention that the Defendants all used the MK Marks  
24 collectively on the website, for the purposes of this  
25 Motion the Court takes this fact as true. See Beard v.  
26 Banks, 548 U.S. 521, 527 (2006)(finding that because  
27 the plaintiff failed to specifically challenge the  
28 facts identified in the defendant's statement of

1 undisputed facts, the plaintiff was "deemed to have  
2 admitted the validity of the facts" in the statement);  
3 Heinemann v. Satterberg, 731 F.3d 914, 917 (9th Cir.  
4 2013)("As the text of the 2010 rule states, the  
5 opposing party's failure to respond to a fact asserted  
6 in the motion permits a court to 'consider the fact  
7 undisputed for purposes of the motion.'")(citing Fed.  
8 R. Civ. P. 56(e)(2)). Hereinafter, the Court takes  
9 Plaintiff's assertion throughout its SUF that  
10 "Defendants" collectively acted together as true for  
11 all remaining claims in this Action due to Defendants'  
12 failure to dispute the grouping of them together.

13 Moreover, Plaintiff provided evidence that this  
14 website was used by all Defendants collectively.  
15 Defendant Morrison Knudsen Corporation registered both  
16 of the domain names on behalf of all Defendants. Pl.'s  
17 SUF ¶1(a); Torres Decl. ¶¶ 9-10, Exs. E-F, ECF Nos.  
18 174-5, 174-6 (showing registration of the websites).<sup>6</sup>

19 \_\_\_\_\_  
20 <sup>6</sup> In its Second Set of Requests for Admission ("RFA Set 2"),  
21 Plaintiff requested Defendant Topolewski admit that he or someone  
22 acting on his behalf registered the domain names. Torres Decl.  
23 Ex. D, 240:3-9. Defendant failed to respond. Torres Decl. ¶ 7.  
24 Pursuant to Fed. R. Civ. P. 36(a)(3), a matter is deemed admitted  
25 unless, within 30 days after being served, the party serves on  
26 the requesting party a written answer or objection addressed to  
27 the matter and signed by the party or its attorney. Thus,  
28 Plaintiff's RFA Set 2 is deemed admitted as to Defendant  
Topolewski, and the Court can properly rely on the admissions in  
deciding summary judgment. See Layton v. Int'l Ass'n of  
Machinists and Aerospace Workers, 285 Fed. Appx. 340, 341 (9th  
Cir. 2008)("There is no dispute that [plaintiff] did not respond  
on time; the facts were thus admitted without the need for any  
further action by the court or the parties."); Conlon v. United  
States, 474 F. 3d 616, 621 (9th Cir. 2007)("Unanswered requests

1 None of the Defendants dispute that the website was  
2 used as one website by the Corporate Defendants.<sup>7</sup>  
3 Torres Decl. Ex. B, 81:14-19 (deposition testimony of  
4 Defendant Topolewski stating that the Corporate  
5 Defendants' website was at [www.morrison-knudsen.com](http://www.morrison-knudsen.com)).  
6 The entire website portrays Defendants as "Morrison-  
7 Knudsen." See Torres Decl. Ex G., 259, ECF No. 174-7  
8 (banner reading "About MK - MORRISON-KNUDSEN"); id. at  
9 260 (banner reading "Contact Us - MORRISON-KNUDSEN").  
10 Defendants Morrison Knudsen Corporation and Morrison-  
11 Knudsen Services were both directly listed on the  
12 website. Id. at 260. The website also lists the North  
13 American headquarters address as 2049 Century Park  
14 East, Suite 3850, Los Angeles, California 90067. See  
15 id. This is the same address listed on the records for  
16 each Corporate Defendant and Defendant Topolewski in  
17 his capacity as an officer of at least one of the  
18 Corporate Defendants. Id. Ex. R at 1034 (showing both  
19 Morrison Knudsen Corporation's address and Defendant  
20 Topolewski's address as its president); id. Ex. Q at  
21 996 (address for Morrison-Knudsen Services); id. Ex, S  
22 at 1066 (address for Morrison-Knudsen International);

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for admissions may be relied on as the basis for granting summary  
25 judgment."). Hereinafter, this applies to any reference to  
Torres Decl. Ex. D, Pl.'s RFA Set 2.

26

<sup>7</sup> Hereinafter, "Corporate Defendants" refers to Defendants  
27 Morrison Knudsen Corporation, Morrison-Knudsen Services, Inc.,  
Morrison-Knudsen Company, Inc., and Morrison-Knudsen  
28 International Inc.

1 and Torres Decl. ISO Prelim. Inj. Ex. 4, 151, ECF No.  
2 19-4 (address for Morrison-Knudsen Company, Inc.).

3 Moreover, all of the Corporate Defendants used an  
4 email address associated with the domain name,  
5 [info@morrison-knudsen.com](mailto:info@morrison-knudsen.com). Torres Decl. Ex. B, at  
6 24:9-20. This email address was also used to receive  
7 potential bids and inquiries from [www.morrison-  
knudsen.com](http://www.morrison-<br/>8 knudsen.com). See Davis Decl. ¶ 10, Ex. L, ECF No. 36-1  
9 (Mr. Davis' email inquiring about "MK" stating he  
10 "stumbled on" the website); Torres Decl. Ex. M, 933-  
11 935, ECF No. 178-1 (email inquiring about potential  
12 bid). Defendant Topolewski also used an email  
13 associated with the domain name, [gary@morrison-  
knudsen.com](mailto:gary@morrison-<br/>14 knudsen.com). Torres Decl. Ex. B, at 75:21-23.

15 When asked to identify the factual basis for  
16 Defendants' "advertising, marketing, and promotional  
17 materials" that they "performed or were in any way  
18 involved in the projects accomplished by the Original  
19 MK" shown on their website, the four Corporate  
20 Defendants and Defendant Topolewski collectively  
21 responded that "Responding Parties revived an abandoned  
22 company." See Torres Decl. ISO Pl.'s Reply ¶ 10, Ex.  
23 7, Def.'s Supp. Resp. to First and Second Set of  
24 Interrogs., 7:19-26, ECF No. 202-7. Defendants have  
25 not put forth any evidence that they did not use the  
26 website to advertise themselves as "Morrison Knudsen."

27 Thus, there is no triable issue that all of the  
28 Defendants used the website, satisfying the first

1 element. To the extent "Defendants'" use of the  
2 website applies to the remaining claims, it refers to  
3 all Defendants collectively.

4 ii. *False Designation of Origin, False or*  
5 *Misleading Description, or*  
6 *Representation of Fact*

7 Plaintiff has put forth ample, undisputed evidence  
8 that Defendants' website claims the original MK's  
9 accomplishments as their own. In the website's "About  
10 MK" section, Defendants describe the history of the  
11 original MK dating back to 1912 as its own, including  
12 projects such as the Hoover Dam, Cam Ranh Bay, and  
13 Trans-Alaska Pipeline. Torres Decl. ¶ 11, Ex. G, at  
14 255, 362; *id.* ¶ 5. It is also undisputed that the  
15 website offers for sale used construction equipment  
16 bearing the MK logo. *Id.* Ex. G, at 309-316. Such  
17 representation of the original MK's history on a  
18 website is sufficient to satisfy this element. See  
19 Nat'l Grange of the Order of Patrons of Husbandry, No.  
20 2:16-201 WBS DB, 2016 WL 6696061, at \*5 (E.D. Cal. Nov.  
21 15, 2016)("Uncredited references to another entity's  
22 history and achievements may constitute 'false or  
23 misleading' representations as to give rise to  
24 liability under section 43(a)."); ITEX Corp. v. Glob.  
25 Links Corp., 90 F. Supp. 3d 1158, 1171 (D. Nev.  
26 2015)(trade exchange's claim to forty-year history of  
27 unaffiliated company violates section 43(a)).

28 Rather than discussing the elements of false  
designation, Defendants argue at length that there is a

1 triable issue as to Plaintiff's ownership and whether  
2 it is senior user of the mark. This argument is  
3 irrelevant as ownership is not a required element for  
4 false designation. Even if it were, while Defendants  
5 are correct that registrations for the MK Marks have  
6 been listed under prior corporate names, the undisputed  
7 evidence shows that Plaintiff is the same entity that  
8 has retained the same legal rights to the MK Marks  
9 throughout a series of corporate name changes and  
10 mergers. See Pl.'s SUF ¶ 17(a). First, Defendants do  
11 not dispute that MK merged with Washington Construction  
12 Group, Inc. ("WGI") in 1996, while continuing to  
13 operate under the name "Morrison Knudsen Corporation".<sup>8</sup>  
14 Szurgot Decl. ¶ 5, ECF No. 175. And in 2000, MK  
15 changed its name to WGI. Id. Defendants also do not  
16 dispute that in 2007, URS Corp. ("URS") acquired WGI,  
17 and in 2014, AECOM, the parent company of Plaintiff  
18 AECOM Energy & Construction, Inc., acquired URS and its  
19 subsidiaries. Szurgot Decl. ¶¶ 6-7. Without citing  
20 any legal authority, Defendants argue that Plaintiff  
21 did not obtain the right to the MK Marks because WGI  
22 "just kept deciding to change its name." Opp'n at  
23 11:9-10. However, whether Plaintiff's predecessors

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25 <sup>8</sup> Defendants argue that MKCO's registration in 1993 was  
26 under the name Morrison Knudsen Corporation, and thus it is  
27 unclear whether Plaintiff acquired the registration. This  
28 argument fails given that it is undisputed WGI merged with  
Morrison Knudsen Corporation in 1996, thus acquiring the  
registration.

1 changed names has no effect on the trademark rights  
2 passed to Plaintiff through its acquisition of URS.  
3 See Fresno Motors, LLC v. Mercedes Benz USA, LLC, 771  
4 F.3d 1119, 1125 (9th Cir. 2014) (“A fact is material  
5 only if it might affect the outcome of the case . . .  
6 .”). As such, there is no genuine issue that any  
7 representation of the MK history on the website is a  
8 false representation.

9           iii.       *Likelihood of Confusion*

10       As to likelihood of confusion, courts consider  
11 eight factors referred to as the Sleekcraft factors.<sup>9</sup>  
12 Where the use of a name or mark is identical to that of  
13 the plaintiff on the very same goods and services for  
14 which the plaintiff uses the name or mark, that alone  
15 can be “case-dispositive” before a full balancing of  
16 the Sleekcraft factors. See Stone Creek, Inc. v. Omnia  
17 Italian Design, Inc., 875 F.3d 426, 432 (9th Cir.  
18 2017)(citing Opticians Ass’n of Am. v. Indep. Opticians  
19 of Am., 920 F.2d 187, 195 (3d Cir. 1990) (“[L]ikelihood  
20 of confusion is inevitable, when, as in this case, the  
21 identical mark is used concurrently by unrelated  
22 entities.”)). Indeed, courts have found likelihood of

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23  
24       <sup>9</sup> The eight factors include: (1) strength of the allegedly  
25 infringed mark; (2) proximity or relatedness of the goods;  
26 (3) similarity of the sight, sound, and meaning of the marks;  
27 (4) evidence of actual confusion; (5) degree to which the  
28 marketing channels converge; (6) type of goods and degree of care  
consumers are likely to exercise in purchasing them; (7) intent  
in selecting the allegedly infringing mark; and (8) likelihood of  
expansion of the product lines. AMF Inc. v. Sleekcraft Boats,  
599 F.2d 341, 348-49 (9th Cir. 1979).

1 confusion solely on the fact that the marks and  
2 services are identical. See Park 'N Fly, Inc. v.  
3 Dollar Park and Fly, Inc., 782 F.2d 1508, 1509 (9th  
4 Cir. 1986)(finding where marks and services provided  
5 are identical, and marketing channels are convergent,  
6 there is a likelihood of confusion despite no evidence  
7 of actual confusion, weak mark, and no intent to  
8 capitalize).

9 Here, Plaintiff has put forth evidence that the  
10 marks on Defendants' website are identical and used in  
11 the same market to sell the same services and goods,  
12 including construction contracts and construction  
13 equipment. See Torres Decl. Ex. G, at 255-57.  
14 Additionally, Defendants' website offered for sale  
15 construction equipment bearing the MK logo. See id. at  
16 309-16; id. Ex. B, Topolewski Dep. at 87-89  
17 (acknowledging it is the red MK logo on the equipment).  
18 The entire website features the MKO logo and Morrison  
19 Knudsen name on each page. See generally Torres Decl.,  
20 Ex. G; GoTo.com, Inc. v. Walt Disney Co., 202 F.3d  
21 1199, 1206 (9th Cir. 2000)(holding that plaintiff is  
22 likely to succeed on section 43(a) claim where  
23 defendant used "glaringly similar" website logos). The  
24 Ninth Circuit has found it to be clear error "to find  
25 no likelihood of confusion when two products with  
26 virtually identical marks are in the same market."  
27 Honor Plastic Indus. Co. v. Lollicup USA, Inc., 462 F.  
28 Supp. 2d 1122, 1132 (E.D. Cal. 2006)(citing Lindy Pen



1 Co. v. Bic Pen Corp., 796 F.2d 254, 257 (9th Cir.  
2 1986)).

3 Even a consideration of the key factors shows a  
4 likelihood of confusion. First, as to strength of the  
5 mark, there is substantial evidence of MK's reputation  
6 and legacy dating back to 1912 for projects such as the  
7 Hoover Dam, San Francisco-Oakland Bay Bridge, and the  
8 Trans-Alaska Pipeline. See Szurgot Decl. ¶ 4; Torres  
9 Decl. ¶ 13, Ex. J (TIME Magazine cover featuring MK  
10 founder). The strength of MK as a brand is evident  
11 from both parties' continuous use of its history in its  
12 marketing. See, e.g., Torres Decl. ¶ 11, Ex. G, at  
13 255-57, 362 (showing MK projects on Defendants'  
14 websites); id. ¶¶ 16-18, Exs. N, O, P (press releases  
15 claiming MK's signature projects).

16 Additionally, Plaintiff has shown actual confusion.  
17 Defendants do not dispute that a former AECOM employee,  
18 Brandon Davis, confused Defendants' website for the  
19 original MK. See Davis Decl. ¶¶ 3-9, ECF No. 36. When  
20 Mr. Davis found the website [www.morrison-knudsen.com](http://www.morrison-knudsen.com),  
21 he emailed [info@morrison-knudsen.com](mailto:info@morrison-knudsen.com) on April 18, 2013,  
22 and inquired whether MK survived the sale from WGI to  
23 URS. See id., Ex. L, ECF No. 36-1. Mr. Davis received  
24 a response stating, "the entire group of MK companies  
25 are separate from URS now." See id. Mr. Davis later  
26 spoke to Defendant Topolewski on the phone, and based  
27 on what Defendant Topolewski told him, "believed that  
28 Gary and the people working for the Morrison Knudsen

1 company with which he was affiliated were employees of  
2 some spun off entity of the iconic Morrison Knudsen  
3 companies." Id. ¶ 9. In 2015, Mr. Davis contacted  
4 Defendant Topolewski again for a potential bid under  
5 the belief that it was the original MK. See id. ¶¶ 10-  
6 11 ("I would never have suggested that my colleague  
7 contact Gary at Morrison-Knudsen.com if I had known  
8 they were not legitimately operating the iconic  
9 Morrison Knudsen . . .").<sup>10</sup> Based on Mr. Davis'  
10 actual confusion, future confusion is likely.  
11 Sleekcraft, 599 F.2d at 352 ("Evidence that use of the  
12 two marks has already led to confusion is persuasive  
13 proof that future confusion is likely.").

14 Finally, Plaintiff has put forth undisputed  
15 evidence showing that each Defendants' intent in  
16 selecting the MK Marks was to pass themselves off as  
17 MK. Defendants Morrison-Knudsen Services and Morrison  
18 Knudsen Corporation (formally MK Viet Nam) both assumed  
19 the identify of original MK entities, rather than  
20 creating their own business. See Torres Decl. Ex. Q,  
21 at 990-93 (revival of Morrison-Knudsen Services); id.  
22 Ex. R, at 1033-35 (revival of MK Viet Nam). Defendant  
23 Topolewski was the one who revived MK Viet Nam in 2014  
24 (later changed to Morrison Knudsen Corporation) and  
25

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26  
27 <sup>10</sup> Throughout this entire exchange, Defendant Topolewski was  
28 serving as an officer for Defendant Morrison-Knudsen Services,  
Inc. and Defendant Morrison Knudsen Corporation (formally MK Viet  
Nam). Torres Decl. Ex. Q at 996-1005; id. Ex. S, at 1053.

1 signed under penalty of perjury that he was authorized  
2 by a court or the entity to do so. Id. And Defendants  
3 Morrison-Knudsen International, Inc., and Morrison-  
4 Knudsen Company, Inc. both changed their names to  
5 assume an MK identity. Id. Ex. S, at 1065 (E Planet  
6 changing its name to Morrison-Knudsen International,  
7 Inc.); id. Ex. T, at 1091 (Westland changing name to  
8 Morrison-Knudsen Company). No one affiliated with the  
9 original MK, URS, or AECOM gave any of the Defendants  
10 permission to do so. Szurgot Decl. ¶ 13.

11 Neither do any of the Defendants dispute that they  
12 were all involved in the revival of "Morrison Knudsen"  
13 or offer any evidence to the contrary. When asked to  
14 identify the factual basis for Defendants'  
15 "advertising, marketing, and promotional materials"  
16 that they "performed or were in any way involved in the  
17 projects accomplished by the Original MK" on their  
18 website, the four Corporate Defendants and Defendant  
19 Topolewski collectively responded that "Responding  
20 Parties revived an abandoned company." See Torres  
21 Decl. ISO Pl.'s Reply ¶ 10, Ex. 7, Def.'s Supp. Resp.  
22 to First and Second Set of Interrogs., 7:19-26, ECF No.  
23 202-7. Additionally, when asked about the Corporate  
24 Defendants and the original MK, Defendant Topolewski  
25 testified at his deposition "they were one in the  
26 same," and that "we [Topolewski and Corporate  
27 Defendants] revived Morrison Knudsen." Torres Decl. ¶  
28 5; id. Ex. B, Topolewski Dep. at 91:9-23.

1 The evidence that Defendants knew of MK's history,  
2 and claimed it for their own upon reviving it without  
3 permission, supports a likelihood of confusion.  
4 Entrepreneur Media, Inc. v. Smith, 279 F.3d 1135, 1148  
5 (9th Cir. 2002)("[I]ntent to deceive is strong evidence  
6 of a likelihood of confusion.")(citations omitted).

7 Defendants' only argument offers legal conclusions,  
8 with no authority or evidence, that because Defendants  
9 are the current owners of the MK Marks there cannot be  
10 confusion by Defendants' use of the marks. This is  
11 insufficient to create a triable issue of fact. See  
12 Hutchinson v. United States, 838 F.2d 390, 392 (9th  
13 Cir. 1988)("The party opposing the summary judgment may  
14 not rest on conclusory allegations, but must set forth  
15 facts showing there is a genuine issue for trial.").  
16 Defendant Morrison Knudsen Corporation only became the  
17 current owner by deceiving the USPTO and cutting off  
18 Plaintiff's chain of communication with the USPTO.<sup>11</sup>  
19 Regardless, as mentioned above, ownership is not a  
20 required element for false designation of origin. Even  
21 in viewing the evidence in light most favorable to  
22 Defendants, the evidence shows that Plaintiff acquired

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24 <sup>11</sup> Defendants do not dispute that multiple false documents  
25 were submitted under penalty of perjury to the USPTO to obtain  
26 control of the MK Marks. For example, on November 10, 2016,  
27 defaulting Defendant Hale submitted a change of address form to  
28 the USPTO seeking to change the address of the owner of the  
MORRISON KNUDSEN mark from WGI's address (the former name of MK  
prior to Plaintiff's acquisition) to Defendants' address. See  
Bottaro-Walklet Decl. ¶ 6, Ex. F.

1 MK through its acquisition of URS, and Defendants use  
2 of the MK Marks and its history create a likelihood of  
3 confusion.

4 In sum, Plaintiff has put forth undisputed evidence  
5 showing Defendants used their website to pass  
6 themselves off as the original MK, and the Court **GRANTS**  
7 Plaintiff's Motion on this claim as to all Defendants.

8 *b. Defendants' Abandonment Defense Fails*

9 Defendants argue that Plaintiff has abandoned its  
10 use of the MK Marks and therefore has no right to bring  
11 its trademark claims under the Lanham Act. Opp'n 5:6-  
12 16. To prove abandonment of the MK Marks, Defendants  
13 must establish "(1) discontinuance of trademark use and  
14 (2) intent not to resume such use." Electro Source,  
15 Ltd. Liab. Co. v. Brandess-Kalt-Aetna Grp., Inc., 458  
16 F.3d 931, 935 (9th Cir. 2006). Non-use requires  
17 "complete cessation or discontinuance of trademark  
18 use." Yucaipa Corp. Initiatives Fund I, LP v. Hawaiian  
19 Airlines, Inc., No. cv 13-9060, 2014 WL 12564354, at \*2  
20 (C.D. Cal. Dec. 17, 2014)(citations omitted). "Even a  
21 single instance of use is sufficient against a claim of  
22 abandonment of a mark if such use is made in good  
23 faith." Carter-Wallace, Inc. v. Proctor & Gamble Co.,  
24 434 F.2d 794, 804 (9th Cir. 1970).

25 Defendants argue there is a prima facie case of  
26 abandonment because it has been sixteen years since  
27 Plaintiff "started walking away" from the MK Marks and  
28 any use since then has been a "token use." Opp'n at

1 13:17-19, 14:26-28, 15:1-12. A "token use" is a use  
2 "undertaken without bona fide commercial intent in a  
3 mere attempt to reserve the mark for future use."  
4 Pollution Denim & Co. v. Pollution Clothing Co., 547 F.  
5 Supp. 2d 1132, 1142 n.40 (C.D. Cal. 2007)(citing Chance  
6 v. Pac-Tel Teletrac Inc., 242 F.3d 1151, 1159 (9th Cir.  
7 2001)). Here, Plaintiff proffers ample evidence of its  
8 use of the MK Marks and MK's history in its promotional  
9 materials, bid documents, client presentations, and at  
10 booths and conferences.<sup>12</sup> See Pl.'s SUF 17(h)-(oo).  
11 Plaintiff used the MK Marks in its marketing to  
12 identify its goods and services. Kassal Decl. ¶ 4  
13 ("AECOM leverages iconic projects from its heritage  
14 companies . . . to differentiate itself from  
15 competitors . . . ."). Such use is sufficient to  
16 defeat Defendants' argument for abandonment. See Wells  
17 Fargo & Co. v. ABD Ins. & Fin. Servs., Inc., 758 F.3d  
18 1069, 1072 (9th Cir. 2014), as amended (Mar. 11,  
19 2014)(finding use of a mark in promotional materials,  
20

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21  
22 <sup>12</sup> Plaintiff has provided twenty-one examples of the use of  
23 the MK Marks in promotional materials from 2008 to 2016. See  
24 Szurgot Decl. ¶ 10. The materials repeatedly refer to  
25 Plaintiff's history through MK as its heritage company. See  
26 e.g., id. Ex. 13 at 49, 52 (listing MK under "Heritage Company  
27 Experience"); Ex. 14 at 56, 57 ("URS, through predecessor firm,  
28 Morrison-Knudsen"); Ex. 17 at 65 ("URS and its heritage  
companies, WGI and Morrison-Knudsen, started building their long  
reputations heavy civil constructors in 1912 and have over 70  
years of history . . . ."); Ex. 34 (2016 AECOM-URS Company  
History template listing MK under "previous company names"); Ex.  
37 at 126 ("AECOM legacy firm, Morrison-Knudsen, was one of the  
consortium of firms that built the Hoover Dam.").

1 including "customer presentations and solicitations,"  
2 is sufficient use to defeat an argument for  
3 abandonment). This is true even though Plaintiff has  
4 acquired MK through a series of acquisitions and name  
5 changes. *Id.* at 1071 (plaintiff Wells Fargo acquired  
6 the original company, changed its name, and continued  
7 to display the original company's mark on customer  
8 presentations and solicitations). Defendants have not  
9 put forth evidence showing an intent by Plaintiff to  
10 completely cease using the MK Marks. Consequently,  
11 there is no genuine issue of material fact and  
12 Defendants' abandonment defense fails.

13 *c. False Advertising*

14 To succeed on its claim for false advertising under  
15 the Lanham Act,<sup>13</sup> Plaintiff must prove:

16 (1) a false statement of fact by the defendant  
17 in a commercial advertisement about its own or  
18 another's product; (2) the statement actually  
19 deceived or has the tendency to deceive a  
20 substantial segment of its audience; (3) the  
21 deception is material, in that it is likely to  
22 influence the purchasing decision; (4) the  
23 defendant caused its false statement to enter  
24 interstate commerce; and (5) the plaintiff has  
25 been or is likely to be injured as a result of  
26 the false statement, either by direct diversion  
27 of sales from itself to defendant or by a  
28 lessening of the goodwill associated with its  
products.

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13 Plaintiff also alleges violations of California Business  
and Professions Code sections 17200 and 17500, which similarly  
prohibit misleading advertising. However, these state law claims  
are not substantively addressed because the state claims are  
"substantially congruent" to the Lanham Act claims. *JHP Pharm.,  
Ltd. Liab. Co. v. Hospira, Inc.*, 52 F. Supp. 3d 992, 997 n.4  
(C.D. Cal. 2014).

1 Southland Sod Farms v. Stover Seed Co., 108 F.3d 1134,  
2 1139 (9th Cir. 1997).

3 To establish the first element, statements can be  
4 "literally false, either on [their] . . . face or by  
5 necessary implication," or "literally true but likely  
6 to mislead or confuse customers." Id. at 1139. Here,  
7 all of the Defendants have made numerous false  
8 statements claiming MK's historical accomplishments as  
9 their own. Defendants collectively represent, on  
10 [www.morrison-knudsen.com](http://www.morrison-knudsen.com), that they completed projects  
11 including the Hoover Dam, San Francisco-Oakland Bay  
12 Bridge, Trans-Alaska Pipeline, NASA's Space Kennedy  
13 Center, Olmsted Dam Construction, Addison Aiport,  
14 Miami-Dade Expressway Authority, and Snoqualmie Pass.  
15 See Torres Decl. ¶ 11, Ex. G, at 267-71, 293-95, 335-  
16 36, 362, 389-391. These are just a few examples of the  
17 numerous projects Defendants have claimed, that either  
18 the original MK completed prior to its acquisition by  
19 AECOM or that are current AECOM projects. See Olson  
20 Decl. ¶ 3, ECF No. 17 (listing forty-one projects shown  
21 on Defendants' website). These statements are  
22 literally false, and Defendants have not put forth  
23 evidence to the contrary.

24 As to the second and third elements, where a  
25 statement is literally false or the defendant  
26 intentionally set out to deceive, both actual deception  
27 and materiality are presumed. See Itex Corp. v. Glob.  
28 Links Corp., 90 F. Supp. 3d 1158, 1173 (D. Nev.



1 2015)("[I]f the statements at issue are found to be  
2 literally false, the court may presume materiality . .  
3 . .")(citations omitted); U-Haul Int'l Inc. v. Jartran,  
4 Inc., 793 F.2d 1034, 1040-41 (9th Cir. 1986). Because  
5 the statements here on Defendants' websites claiming  
6 MK's accomplishments are literally false, actual  
7 deception and materiality can be presumed. Even  
8 without the presumptions, AECOM's former employee Mr.  
9 Davis' belief that Defendants are the original MK, see  
10 supra Section B.4.a, is direct evidence that  
11 Defendants' use of the MK Marks on its websites are  
12 material and likely to deceive. See Skydive Arizona,  
13 Inc. v. Quattrocchi, 673 F.3d 1105, 1111 (9th Cir.  
14 2012)(finding testimony of a consumer purchase based on  
15 defendant's online representations and advertisements  
16 direct evidence of materiality).

17 As to the fourth element, it is undisputed that  
18 Defendants caused their false statements to enter  
19 interstate commerce, as they collectively used their  
20 online website and email addresses connected to the  
21 same domain name. See supra Section II.B.4.a;  
22 Sutcliffe, 505 F.3d at 953 (holding the internet is an  
23 instrumentality and channel of interstate commerce).

24 Defendants do not address any of the above  
25 elements, and only argue there is a genuine issue as to  
26 the last element, that Plaintiff cannot show any injury  
27 because Plaintiff failed to supplement its initial  
28 disclosures with its damages calculation. Opp'n at

1 17:1-18. However, whether or not Plaintiff  
2 sufficiently disclosed its calculation is irrelevant  
3 because monetary damages is not the only manner in  
4 which a party can suffer injury under the Lanham Act.  
5 See Lexmark Int'l, Inc. v. Static Control Components,  
6 Inc., 134 S. Ct. 1377, 1393 (2014)(stating that  
7 injuries such as "damage to . . . business reputation .  
8 . . are injuries to precisely the sorts of commercial  
9 interests the [Lanham] Act protects"); Neighborhood  
10 Assistance Corp. of Am. v. First One Lending Corp., No.  
11 SACV 12-463-DOC (MLGx), 2012 WL 1698368, at \*18 (C.D.  
12 Cal. May 15, 2012)("Loss of good will or the loss of  
13 the ability to control one's own reputation is a  
14 cognizable harm under the Lanham Act.")(citing Stuhbarg  
15 Int'l Sales Co., Inc. v. John D. Brush and Co., Inc.,  
16 240 F.3d 832, 841 (9th Cir. 2001)).

17 Here, Plaintiff has provided evidence to show that  
18 Defendants' false statements on their website have  
19 lessened the goodwill in the MK brand, including that  
20 Plaintiff no longer has control over its business  
21 reputation. See Szurgot Decl. ¶ 12 ("The use by  
22 another of MK's goodwill, including their use of [MK  
23 Marks], MK's history and MK's projects and  
24 accomplishments . . . dilutes AECOM's legacy and  
25 diminishes AECOM's right and ability to market the  
26 heritage of MK as one of the great American companies  
27 that helped make AECOM what it is today."); Kassal  
28 Decl. ¶ 7 ("Defendants are sullyng AECOM's hard earned

1 reputation." ). As Defendants do not provide any  
2 evidence to the contrary, there is no triable issue  
3 that Plaintiff has suffered and is likely to continue  
4 to suffer injury in the loss of its goodwill in the MK  
5 brand.

6 Accordingly, the Court **GRANTS** Plaintiff's Motion  
7 for Summary Judgment on its false advertising claim as  
8 to all Defendants. Because Plaintiff is successful on  
9 its false advertising claim, the Court also **GRANTS**  
10 Plaintiff's Motion as to the claims for: (1) California  
11 Common Law Unfair Competition; (2) California Statutory  
12 Unfair Competition; and (3) California Statutory False  
13 Advertising.<sup>14</sup>

14 d. *Cyberpiracy*

15 To succeed on a claim for cyberpiracy under 15  
16 U.S.C. § 1125(d), Plaintiff must show Defendants (1)  
17 register, traffic in, or use a domain name, (2) that  
18 was "identical or confusingly similar to" a mark that  
19 was distinctive at the time of registration, with (3) a  
20 "bad faith intent to profit from that mark." GoPets  
21 Ltd. v. Hise, 657 F.3d 1024, 1030 (9th Cir.  
22 2011)(quoting 15 U.S.C. § 1125(d)).

23 First, it is undisputed that Defendant Morrison  
24 Knudsen Corporation registered two domain names on  
25 March 25, 2008: [www.morrison-knudsen.com](http://www.morrison-knudsen.com) and

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26  
27 <sup>14</sup> These claims arise under Cal. Bus. & Prof. Code §§ 17200,  
28 17500, which are "substantially congruent" to the Lanham Act  
claims. See JHP Pharm., Ltd. Liab. Co. v. Hospira, Inc., 52 F.  
Supp. 3d 992, 997 n.4 (C.D. Cal. 2014).

1 [www.morrison-knudsen.net](http://www.morrison-knudsen.net). See Torres Decl. ¶ 7, Exs.  
2 E-F, Whois Lookup. Defendants also do not dispute that  
3 this is the same website used by all of the Defendants.

4 Second, these names are identical to the MK Marks.  
5 See GoPets, 657 F.3d at 1032 (finding domain names  
6 "gopets.mobi," "gopetssite.com," "goingpets.com,"  
7 "egopets.com," and "mygopets.com," among others,  
8 identical to the mark "GoPets"). They are also  
9 confusingly similar because they simply hyphenate the  
10 Morrison Knudsen name. See Brookfield Commc'ns, Inc.  
11 v. W. Coast Entm't Corp., 174 F.3d 1036, 1045 (9th Cir.  
12 1999)("Web users often assume, as a rule of thumb, that  
13 the domain name of a particular company will be the  
14 company name followed by '.com.'")(citations omitted).

15 While these domain names are identical, Plaintiff  
16 must also show the Morrison Knudsen name was a  
17 distinctive mark at the time of registration. A  
18 registered trademark is presumed to be distinctive.  
19 Zobmondo Entm't, Ltd. Liab. Co. v. Falls Media, Ltd.  
20 Liab. Co., 602 F.3d 1108, 1113-14 (9th Cir.  
21 2010)("Where the [US]PTO issues a registration . . .  
22 the presumption is that the mark is inherently  
23 distinctive."). Defendants argue that because they  
24 currently hold the trademark registrations to the MK  
25 Marks, there is a complete bar to this claim. Opp'n at  
26 18:1-6. However, whether or not Defendants hold a  
27 trademark registration today is irrelevant because the  
28 cyberpiracy analysis looks to whether there is a

1 distinctive mark "at the time of registration of the  
2 domain name . . . ." 15 U.S.C. §  
3 1125(d)(1)(A)(ii)(I)(emphasis added). The current  
4 trademark holder has no bearing on whether in 2008,  
5 when Defendants registered the domain names, they were  
6 identical to a distinctive mark. At that time,  
7 Plaintiff held a valid registered trademark in MORRISON  
8 KNUDSEN.<sup>15</sup> See Bottaro-Walklet Decl. ¶ 5, ECF No. 14.  
9 Defendant Morrision Knudsen Corporation did not obtain  
10 trademark registration in MORRISON KNUDSEN until 2016.  
11 See Torres Decl. ¶ 28, Ex. Z, ECF No. 174-26. Thus, it  
12 is undisputed that the mark was distinctive at the time  
13 the domains were registered.

14 Finally, Plaintiff must prove that Defendants had a  
15 "bad faith intent to profit" from the MORRISON KNUDSEN  
16 mark when they registered their domain name. 15 U.S.C.  
17 § 1125(d)(1)(A)(i). The statute lists nine factors to  
18 consider when determining whether a defendant has acted  
19 with a bad faith intent to profit from the use of a  
20 mark. See 15 U.S.C. § 1125(d)(1)(B)(I)-(IX). However,  
21 courts are not limited to these listed factors in  
22 making a determination of a bad faith intent. See  
23 Interstellar Starship Servs., Ltd. v. Epix, Inc., 304  
24 F.3d 936, 946 (9th Cir. 2002) ("Congress did not mean

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25  
26 <sup>15</sup> As of 2008, Plaintiff, through its heritage companies,  
27 including MK, was the registered owner of Registration Numbers  
28 1,716,505 (MKCO MORRISON KNUDSEN) and 1,744,815 (MORRISON  
KNUDSEN). Torres Decl. ¶ 24, Ex. U at 1097-1100 (showing prior  
registration belonging to WGI); Szurgot Decl. ¶¶ 5-7.

1 these factors to be an exhaustive list"); Sporty's Farm  
2 L.L.C. v. Sportsman's Mkt., Inc., 202 F.3d 489, 498 (2d  
3 Cir. 2000)("The factors are, instead, expressly  
4 described as indicia that 'may' be considered along  
5 with other facts.")(quoting § 1125(d)(1)(B)(i)(I)).

6 There is ample evidence of each Defendants' bad  
7 faith intent to profit. The first factor looks at the  
8 intellectual property rights in the domain name. See  
9 15 U.S.C. § 1125(d)(1)(B)(i)(I). As already  
10 discussed, Plaintiff owned the registered MORRISON  
11 KNUDSEN mark at the time Defendant Morrison Knudsen  
12 Corporation registered the domain names containing the  
13 mark on behalf of all Defendants. The second factor  
14 looks to the extent to which the name is commonly used  
15 to identify that person. See 15 U.S.C.  
16 § 1125(d)(1)(B)(i)(II). The MORRISON KNUDSEN Mark was  
17 widely known to refer to the original MK (not  
18 Defendants) and its iconic projects including the  
19 Hoover Dam, the San Francisco-Oakland Bay Bridge, and  
20 the Trans-Alaska Pipeline. Kassal Decl. ¶¶ 4-6. The  
21 third factor looks to prior use, if any, of the domain  
22 name. See 15 U.S.C. § 1125(d)(1)(B)(i)(III).

23 Defendant Topolewski admits that he had no use of the  
24 MK Marks, let alone knew of MK as of 2008, and the  
25 records show that none of the Corporate Defendants had  
26 used the name prior to 2008. See Torres Decl. Ex. B,  
27 at 132:10-12, 245:8-17; Torres Decl. Ex. Q at 990  
28 (showing Morrison-Knudsen Services revived in 2008);

1 Torres Decl. Ex. R, at 1035 (showing MK Viet Nam (later  
2 Morrison Knudsen Corporation) was not revived until  
3 2014); Torres Decl. Ex. S, at 1062 (showing E Planet  
4 did not change its name to Morrison-Knudsen  
5 International Inc. until 2016); Torres Decl. Ex. T, at  
6 1091 (showing Westland did not change its name to  
7 Morrison-Knudsen Company, Inc. until 2016).

8 The fifth factor looks to "the person's intent to  
9 divert consumers from the mark owner's online location  
10 to a site accessible under the domain name that could  
11 harm the goodwill represented by the mark . . .". See  
12 15 U.S.C. § 1125(d)(1)(B)(i)(V). As discussed, the  
13 Defendants' use the websites to represent  
14 accomplishments associated with the MK marks, claiming  
15 such accomplishments as their own. Szurgot Decl. ¶ 11,  
16 Ex. C, at 41-43. At least one of the websites appeared  
17 in search results for "Morrison Knudsen." Szurgot  
18 Decl. ¶ 16, Ex. 46. And Defendant Topolewski does not  
19 dispute he represented to Mr. Davis through their  
20 conversations that the "Morrison Knudsen company with  
21 which he was affiliated were employees of some spun off  
22 entity of the iconic Morrison Knudsen companies."  
23 Davis Decl. ¶¶ 4-7. Further, the overall intent to use  
24 the mark in Defendants' collective revival of the  
25 original MK, as previously discussed, shows a bad faith  
26 intent. See supra section II.B.4.a. This evidence  
27 demonstrates a bad faith intent to profit. See Solid  
28 Host, NL v. Namecheap, Inc., 652 F. Supp. 2d 1092, 1109

1 (C.D. Cal. 2009)(for bad faith, "the defendant must  
2 intend to profit specifically from the goodwill  
3 associated with another's trademark").

4 Defendants do not offer any evidence creating a  
5 triable issue that they did not demonstrate a bad faith  
6 intent to profit from the MK Marks, and instead only  
7 argue that before the cancellation of the MK Marks in  
8 2016, Plaintiff had started letting the MK Marks cancel  
9 as early as 2002. SGDF ¶ 11. This argument fails for  
10 the same reason Defendants' abandonment defense fails.  
11 See supra Section II.B.4.b. Accordingly, the Court  
12 **GRANTS** summary judgment on this claim as to all  
13 Defendants.

14 e. *Cancellation of Registered Mark*

15 The Lanham Act permits cancellation of a registered  
16 trademark on the basis of fraud. 15 U.S.C. § 1064(3).  
17 To succeed on its cancellation claim, Plaintiff must  
18 show there was a registration obtained by another who,  
19 (1) made a false representation regarding a material  
20 fact, while (2) knowing it was false; (3) intended to  
21 induce action in reliance on the misrepresentation; (4)  
22 caused reasonable reliance; and (5) proximately caused  
23 damage. See Robi v. Five Platters, Inc., 918 F.2d  
24 1439, 1444 (9th Cir. 1990).

25 Plaintiff provided undisputed facts showing false  
26 representations were made to the USPTO regarding the MK  
27 Marks. Defendant Morrison Knudsen Corporation made  
28 false representations to the USPTO by assigning



1 Registration No. 1,744,815 for the MORRISON KNUDSEN  
2 mark from Plaintiff (WGI at the time) to Defendant  
3 Morrison Knudsen Corporation. Torres Decl. ¶ 24; id.,  
4 Ex. V. Defaulting Defendant Hale also changed the  
5 address with the USPTO for Registration Nos. 1,716,505  
6 and 1,744,815 from Plaintiff (WGI at the time) to  
7 Morrison Knudsen Corporation. Torres Decl. ¶ 23; id.  
8 Ex. U. Finally, in its application for the mark  
9 MORRISON KNUDSEN, Defendant Morrison Knudsen  
10 Corporation represented to the USPTO that its first use  
11 of the mark was as early as 1933. Id. ¶ 25, Ex. W.  
12 Thus, there is no triable issue as to the first  
13 element.

14 As to the second element, Defendants argue that  
15 there is a genuine issue whether they knew of the  
16 falsity of the representations. Plaintiff argues that  
17 in making the representations, Morrison Knudsen  
18 Corporation knew they were falsely claiming ownership  
19 of the MK Marks. Plaintiff relies on the deposition  
20 testimony of Defendant Topolewski, that, despite  
21 Defendant Morrison Knudsen Corporation's claim their  
22 first use of the Marks was in 1933, Topolewski had not  
23 heard of Morrison Knudsen until "[m]aybe 2007," that  
24 none of the other Defendants ever used the MK Marks  
25 prior to 2008, and that none of the Defendants have  
26 ever actually used the MK Marks for construction  
27 services. Torres Decl. ¶ 5, Ex. B, at 59, 134-135.

28 Defendants argue Topolewski was only testifying for

1 himself personally, not as the 30(b)(6) witness for the  
2 Corporate Defendants, so his testimony is only  
3 speculative as to the Corporate Defendants' knowledge.  
4 SGDF ¶ 13. However, Defendant Topolewski has served as  
5 an officer for several of the Corporate Defendants,<sup>16</sup>  
6 and at the time both representations to the USPTO were  
7 made he was an officer of Morrison Knudsen Corporation.  
8 Torres Decl. Ex. R, at 1034. Additionally, the  
9 Corporate Defendants did not designate a witness to  
10 dispute any of Topolewski's testimony. Id. ¶ 9  
11 (Plaintiff took the non-appearance at deposition of  
12 each Corporate Defendant). Moreover, none of the  
13 Corporate Defendants existed prior to 2008, and none of  
14 the Defendants provide any evidence they used the MK  
15 Marks prior to 2008. Thus, there is no dispute that  
16 Defendant Morrison Knudsen Corporation knew that it had  
17 not used the MK Marks dating back to 1933. As such,  
18 there is no genuine issue as to this element.

19 There is also no genuine issue of material fact as  
20 to the remaining elements. The false representations  
21 to the USPTO were made in order to receive a trademark  
22

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23 <sup>16</sup> For Morrison-Knudsen Services, Inc., Topolewski was  
24 listed as: President and Secretary in 2010; Chairman in 2011;  
25 Chairman, Director, and President in 2014; Secretary and Director  
26 in 2016; and President and Secretary in 2017. See Torres Decl.,  
27 Ex. Q, at 996-1005. For Morrison Knudsen Corporation (formally  
28 MK Viet Nam), he was listed as: President, Secretary, Treasurer,  
and signed as an "Officer" in 2014. Id. Ex. R, at 1034.  
Finally, he was listed as the Secretary of E Planet in 2012,  
which later changed its name to Morrison Knudsen International  
Inc. Id. Ex. S, at 1053, 1062.

1 registration, the USPTO granted the registration in  
2 reliance on the false statements, and it resulted in  
3 harm to Plaintiff as it lost control over MK's  
4 identity, goodwill, and intellectual property rights.  
5 Consequently, the Court **GRANTS** Plaintiff's Motion for  
6 Summary Judgment as to this claim and cancels  
7 Defendants' registration.

8 f. *Defendants' Equitable Defenses Fail*

9 Defendants put forth one argument that Plaintiff  
10 waited nine years to bring this Action, to cover the  
11 defenses of estoppel, waiver, laches, unclean hands,  
12 and acquiescence. Opp'n at 21:5-10. This is  
13 insufficient to establish any of the defenses, as  
14 Defendants have not put forth evidence of the required  
15 elements of each defense.<sup>17</sup> See Devereaux v. Abbey, 263  
16 F.3d 1070, 1076 (9th Cir. 2001) ("When the nonmoving  
17 party has the burden of proof at trial, the party  
18 moving for summary judgment need only point out 'that  
19 there is an absence of evidence to support the  
20

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21 <sup>17</sup> For example, to establish waiver, Defendants would need  
22 to provide evidence showing a "clear, decisive, and unequivocal"  
23 intent by Plaintiff to relinquish its trademark rights.  
24 Marketquest Group, Inc. v. BIC Corp., No. 11-cv-618-BAS-JLB, 2018  
25 WL 2933518, at \*39 (S.D. Cal. June 12, 2018) (citing Groves v.  
26 Prickett, 420 F.2d 1119, 1125 (9th Cir. 1970)). For estoppel,  
27 Defendants would need evidence to prove each of the five  
28 elements: (1) Plaintiff knew of Defendants' actions; (2)  
Plaintiff's actions led Defendants to reasonably believe  
Plaintiff did not intend to enforce its trademark rights; (3)  
Defendants did not know that Plaintiff actually objected to  
Defendants' conduct; and (4) Defendants will be materially  
prejudiced if Plaintiff is allowed to proceed. Id.

1 nonmoving party's case.'")(internal citation omitted).

2 Moreover, Defendants rely solely on Plaintiff's  
3 30(b)(6) witness, Charles Szurgot, as evidence that  
4 Plaintiff waited nine years to bring this Action.  
5 Defendants rely on deposition testimony stating that  
6 Plaintiff has had outside and in-house counsel maintain  
7 its portfolio of registered marks to argue that it is  
8 logical Plaintiff knew of Defendants' actions when they  
9 changed the records with the USPTO. Sherman Decl. ¶¶  
10 12-16; id. Ex. D, at 81:9-14, 82:5-8 ("we certainly  
11 relied on in-house counsel to maintain our  
12 portfolio."). First, Defendants are incorrect to claim  
13 it would have been nine years, because defaulting  
14 Defendant Hale changed the addresses with the USPTO in  
15 2014, and not in 2008. See Torres Decl., Ex. U, at  
16 1097-99. Second, even in viewing these statements in  
17 the light most favorable to the Defendants, at most  
18 this deposition testimony establishes that Plaintiff  
19 relied in part on its outside counsel to manage their  
20 portfolio, but no where does Mr. Szurgot specifically  
21 mention the MK Marks or indicate any knowledge of  
22 infringement prior to bringing this Action. This  
23 evidence alone does not create a triable issue because  
24 Defendants only speculate as to what Plaintiff's  
25 personnel could have discovered in managing the marks,  
26 with no actual evidence of delay on Plaintiff's part.  
27 See McIndoe v. Huntington Ingalls Inc., 817 F.3d 1170,  
28 1173 (9th Cir. 2016)("Arguments based on conjecture or

1 speculation are insufficient . . . ."). Given that  
2 Defendants have put forth no evidence proving the  
3 required elements of any of the equitable defenses,  
4 there is no genuine issue of material fact and  
5 Defendants' defenses fail.

6       5. Permanent Injunction

7       A prevailing plaintiff seeking a permanent  
8 injunction must show: "(1) that it has suffered an  
9 irreparable injury; (2) that remedies available at law,  
10 such as monetary damages, are inadequate to compensate  
11 for that injury; (3) that, considering the balance of  
12 hardships between the plaintiff and defendant, a remedy  
13 in equity is warranted; and (4) that the public  
14 interest would not be disserved by a permanent  
15 injunction." La Quinta Worldwide LLC v. O.R.T.M., S.A.  
16 de C.V., 762 F.3d 867, 879 (9th Cir. 2014)(citations  
17 omitted).

18       Here, Plaintiff has demonstrated success on the  
19 merits. If an injunction were not granted, Plaintiff  
20 would suffer irreparable injury from the ongoing damage  
21 to its goodwill as a result of Defendants' deceptive  
22 tactics to take over the MK brand.<sup>18</sup> See Herb Reed

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23  
24       <sup>18</sup> The Court notes that Defendants' actions have shown an  
25 unwillingness to stop its infringement. Defendants have already  
26 been held in civil contempt for failure to comply with the  
27 preliminary injunction this Court issued. See Order re Civil  
28 Contempt, ECF No. 86. The preliminary injunction enjoined  
Defendants from using Defendants' corporate names, and from  
making any representation that Defendants are connected with the  
MK brand. Id. at 7:2-9. Instead of changing their names to  
clearly separate themselves from the MK brand, Defendants "simply

1 Enters., LLC v. Florida Entertainment Management, 736  
2 F.3d 1239, 1250 (9th Cir. 2013) (“Evidence of loss of  
3 control over business reputation and damage to goodwill  
4 could constitute irreparable harm.”). As detailed  
5 above in discussing the merits of Plaintiff’s claims,  
6 there is substantial evidence that Plaintiff has  
7 suffered a loss to control over its brand, goodwill,  
8 and intellectual property rights that cannot be  
9 quantified. Further, the balance of hardships favors  
10 Plaintiff because the potential hardship on Defendants  
11 is “purely economic,” while the hardship on Plaintiff  
12 is a complete loss of control over the brand and  
13 history of MK entities. See Diller v. Barry Driller,  
14 Inc., No. CV 12-7200 ABC EX, 2012 WL 4044732, at \*10  
15 (C.D. Cal. Sept. 10, 2012) (“It is no hardship to cease  
16 intentionally infringing someone else’s trademark  
17 rights.”). Finally, the public interest favors an  
18 injunction because the marks are identical and shown to  
19 have already caused actual confusion. Internet  
20 Specialties West, Inc. v. Milon-DiGiorgio Enters.,  
21 Inc., 559 F.3d 985, 993 n.5 (9th Cir. 2009) (“The public  
22 has an interest in avoiding confusion between two  
23 companies’ products.”). Thus, the Court **GRANTS**  
24 Plaintiff’s Motion for Permanent Injunction.

25  
26  
27 \_\_\_\_\_  
28 abbreviated Morrison Knudsen to MK.” Id. at 8:12-16. This Court  
found this act was “intentionally calculated by [Defendants] to  
deceive the public into belief that’ they were still affiliated  
with Morrison Knudsen.” Id. at 8:16-19.

1           6.   Damages

2           For violations of section 1125(a) or (d) of the  
3 Lanham Act, a plaintiff may recover "(1) defendant's  
4 profits, (2) any damages sustained by plaintiff, and  
5 (3) the costs of the action." 15 U.S.C. § 1117(a).  
6 Here, Plaintiff seeks actual damages by disgorgement of  
7 Defendants' profits in the amount of **REDACTED**.

8           A court may award disgorgement of profits under the  
9 Lanham Act where there is willful infringement. Stone  
10 Creek, Inc. v. Omnia Italian Design, Inc., 875 F.3d  
11 426, 439-40 (9th Cir. 2017). The Ninth Circuit has  
12 recognized three justifications for awarding an  
13 infringer's profits: (1) compensating the plaintiff for  
14 diverted sales; (2) preventing unjust enrichment; and  
15 (3) serving as a deterrent to infringers. Maier  
16 Brewing Co. v. Fleischmann Distilling Corp., 390 F.2d  
17 117, 123 (9th Cir. 1968). The Ninth Circuit also has  
18 suggested that where infringement is deliberate and  
19 willful, merely awarding a permanent injunction is  
20 insufficient. See Playboy Enters., Inc. v. Baccarat  
21 Clothing Co., Inc., 692 F.2d 1272, 1274 (9th Cir.  
22 1982)("[A]n award of little more than nominal damages .  
23 . . would fail to serve as a convincing deterrent to  
24 the profit maximizing entrepreneur who engages in  
25 trademark piracy.").

26           To demonstrate willful infringement, a party only  
27 needs to show "a connection between a defendant's  
28 awareness of its competitors and its actions at those

1 competitors' expense." Fifty-Six Hope Rd. Music, 778  
2 F.3d 1059, 1074 (9th Cir. 2015); see also D.C. Comics  
3 v. Towle, 802 F.3d 1012, 1026 (9th Cir. 2015) ("Willful  
4 trademark infringement occurs when the defendant's  
5 actions are 'willfully calculated to exploit the  
6 advantage of an established mark.'"); Lindy Pen Co.,  
7 Inc. v. Bic Pen Corp., 982 F.2d 1400, 1406 (9th Cir.  
8 1993)("Willful infringement carries a connotation of  
9 deliberate intent to deceive . . . [A]n account is  
10 proper only where the defendant is 'attempting to gain  
11 the value of an established name of another.'")  
12 *abrogated on other grounds by SunEarth, Inc. v. Sun*  
13 *Earth Solar Power Co., Ltd.*, 839 F.3d 1179 (9th Cir.  
14 2016).

15 Here, Plaintiff has offered ample evidence of each  
16 Defendants' willful infringement by their efforts in  
17 taking over the MK brand. Defendants Morrison-Knudsen  
18 Services and Morrison Knudsen Corporation (formally MK  
19 Viet Nam) both assumed the identify of original MK  
20 entities. Defendant Topolewski was the one who revived  
21 MK Viet Nam in 2014 (later changed to Morrison Knudsen  
22 Corporation) and signed under penalty of perjury that  
23 he was authorized by a court or the entity to do so.  
24 Torres Decl. ¶ 20, Ex. R, at 1033-35. And Defendants  
25 Morrison-Knudsen International Inc. and Morrison  
26 Knudsen Company, Inc. both changed their names to  
27 assume an MK identity. No one affiliated with the  
28 original MK, URS, or AECOM gave any of the Defendants



1 permission to do so. Szurgot Decl. ¶ 13.

2 With respect to profits, a "plaintiff shall be  
3 required to prove defendant's sales *only*; defendant  
4 must prove all elements of cost or deduction claimed."  
5 15 U.S.C. § 1117(a)(emphasis added). To prove sales,  
6 Plaintiff provides three press releases announcing  
7 contracts Defendants received under the MK name and  
8 brand amounting to \$1.806 billion in revenue. See  
9 Torres Decl. ¶¶ 16-18, Exs. N-P. The three press  
10 releases include: (1) March 16, 2016 titled, "Morrison  
11 Knudsen Awarded \$570 Million Environmental Clean Up  
12 Project"; (2) June 30, 2016 titled, "Morrison Knudsen  
13 Awarded \$36 Million Mine Engineering Contract"; and (3)  
14 April 11, 2017 titled, "Morrison Knudsen awarded \$1.2  
15 Billion Construction and Engineering Contract". Torres  
16 Decl. ¶¶ 16-18, Exs. N-P, ECF Nos. 174-14, 174-15, 174-  
17 16. The press releases were the only evidence  
18 Plaintiff could rely on because Defendants have not  
19 provided adequate documentation of their revenue,  
20 profits, or costs, despite repeated requests for such  
21 information throughout discovery. The history of this  
22 litigation demonstrates a pattern in which Defendants  
23 continuously refused to comply with Plaintiff's  
24 discovery requests, Court orders, and evaded providing  
25 financial information.

26 During discovery, Plaintiff sought financial  
27 information to calculate damages in its Requests for  
28

1 Production ("RFP") Nos. 19, 20, 21<sup>19</sup> and Interrogatory  
2 No. 15.<sup>20</sup> Order re Mot. for Contempt. 9:4-8, 11:27-  
3 12:5, 13:22-24, ECF No. 154. On April 26, 2018, after  
4 Defendants' failure to provide such information, the  
5 Court ordered Defendants to provide supplemental  
6 discovery responses by May 15, 2018 [118]. Id. at  
7 1:20-25. On May 29, 2018, Plaintiff filed a Motion for  
8 Contempt, or in the Alternative, Motion to Compel  
9 Supplemental Discovery against Defendants for failing  
10 to comply with the April 26 Order [132]. Plaintiff  
11 argued, and the Court found, that Defendants'  
12 supplemental discovery response, including a two-page  
13 financial summary, was "plainly inadequate" because the  
14 summary did not provide information from January 2017  
15 forward. Order re Mot. for Contempt at 13:6-12. The  
16 Court ordered Defendants to respond to Plaintiff's  
17 Interrogatory No. 15 and RFP Nos. 19 and 20 by July 9,  
18 2018 [154]. Id. at 18:1-4. Specifically, the Court  
19 ordered Defendants to produce "all monthly, quarterly

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21 <sup>19</sup> RFP No. 19 requested "[a]ll documents relating to or  
22 reflecting any revenue received by any Defendant arising in any  
23 way relating to the use of the Morrison Knudsen name or logo . .  
24 . ."; RFP No. 20 requested "[a]ll tax returns and bank  
25 statements of any Corporate Defendant since such Corporate  
26 Defendant's Date of Inception."; and RFP No. 21 requested "[a]ll  
27 tax returns and bank statements of any Individual Defendant since  
28 2008." Order re Mot. for Contempt 11-16, ECF No. 154.

26 <sup>20</sup> Interrogatory No. 15 states, "[i]dentify all revenues and  
27 profits earned by Topolewski America, Inc. since its date of  
28 incorporation and how those revenues and profits, in whole or in  
part, are shared with or received by any of the Defendants." Id.  
at 9:4-8

1 and annual income statements, balance sheets and other  
2 financial statements of any Corporate Defendant." Id.  
3 at 13:12-20. Defendants missed that deadline, and did  
4 not file the supplemental responses until July 18,  
5 2018,<sup>21</sup> after several communications from Plaintiff.  
6 Order re Contempt 3:4-22, ECF No. 210. In the  
7 supplemental responses, Defendants refused to produce  
8 any documents created after January 1, 2017, even  
9 though the Court clearly ordered them to do so. Id. at  
10 18:1-10, 22:6-12. Despite several orders and ample  
11 time to provide further financial information,  
12 Defendants did not submit any additional financial  
13 documents.

14       Upon realizing Defendants would not provide  
15 Plaintiff further information, Plaintiff served its  
16 Supplemental Disclosure on July 17, 2018, including the  
17 three press releases. Even though the Court found that  
18 the two-page financial statement Defendants initially  
19 provided was inadequate, Plaintiff has conceded that in  
20 the absence of any showing of costs by Defendant,  
21 Plaintiff will accept the summary's showing of  
22 Defendants' total costs and expenses for 2013-2016 as  
23 **REDACTED**. Torres Decl. ¶ 15, Ex. M, 930-31, ECF No.

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24  
25       <sup>21</sup> Defendants served a joint set of "Further Supplemental  
26 Responses" on July 18, 2018; Defendant Topolewski served Third  
27 Supplemental Responses on July 23, 2018; and Corporate Defendants  
28 served their Third Supplemental Responses on July 31, 2018, only  
after Plaintiffs filed a Motion to Hold Defendants in Civil  
Contempt for Violating the Court's Order re Discovery and to  
Award Plaintiff Its Costs and Fees. Id. at 2:1-10.

1 178-1. The two-page financial summary was put forth  
2 collectively by all four Corporate Defendants showing  
3 that they claimed to share the total expenses listed  
4 from 2013 to 2016. Id. Thus, the total profits  
5 Plaintiff seeks is the \$1.806 billion in revenue as  
6 stated in the press releases, less the total costs and  
7 expenses of **REDACTED**, for a total of **REDACTED**.

8 In light of the significant amount of damages  
9 Plaintiff is seeking, the Court is more hesitant to  
10 rely solely on the press releases than it would be if  
11 there was a lesser amount at stake. However,  
12 Defendants do not offer any evidence or argument  
13 disputing Plaintiff's calculation of **REDACTED**, or offer  
14 any alternative calculation. Plaintiff clearly stated  
15 as an uncontroverted fact in its SUF that "Defendants  
16 have claimed to earn revenue totaling **REDACTED** " by  
17 issuing the three press releases. Nowhere in  
18 Defendants' SGDF or Opposition did they dispute the  
19 amount or deny earning the contracts. Defendants did  
20 not raise a genuine issue as to the accuracy of the  
21 press releases, or as to the amount the press releases  
22 state that Defendants were "awarded." The Court finds  
23 this telling.<sup>22</sup> The only genuine issue Defendants  
24 raised as to damages was that Plaintiff did not

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25  
26 <sup>22</sup> The Court surmises that Defendants' actions in failing to  
27 rebut the amount disclosed in the press releases and failing to  
28 provide financial information suggests the possibility that  
Defendants received more than what the three press releases  
accounted for.

1 disclose the press releases until after the close of  
2 discovery. See SGDF ¶ 6; Opp'n at 21:14-27. However,  
3 the Court has already rejected this argument and has  
4 deemed the press releases admissible. See supra,  
5 section II.B.2.b.

6 With no genuine issue raised by Defendants as to  
7 the amount, there is no other basis to compute damages  
8 than what Plaintiff has provided. Damages must only  
9 "be established with reasonable certainty," and they  
10 are not precluded merely "because they cannot be  
11 calculated with absolute exactness" so long as "a  
12 reasonable basis for computation ... exist[s]." Lindy  
13 Pen Co., 982 F.2d at 1407 (internal quotation marks  
14 omitted). Courts have accepted less precise estimates  
15 of damages where, as here, a defendant frustrates the  
16 discovery of a precise amount by refusing to cooperate  
17 in providing relevant discovery. See, e.g., Allergan  
18 Inc. v. Mira Life Group, Inc., No. SACV 04-36 JVS MLGX,  
19 2004 WL 2734822, at \*3 (C.D. Cal. June 9, 2004); Taylor  
20 Made Golf Co. v. Carsten Sports, Ltd., 175 F.R.D. 658,  
21 662 (S.D. Cal. 1997)(granting imprecise damages because  
22 "[w]hile perhaps not a product of its best efforts,  
23 Plaintiff's calculations are probably conservative and  
24 do not appear to be unreasonable under the  
25 circumstances"). "In the end, any 'uncertainty in the  
26 amount of damages should be borne by the wrongdoer.'" Spin  
27 Master, Ltd. v. Zombondo Entmt. LLCU, 944 F. Supp.  
28 2d 830, 840 (C.D. Cal. 2012) (quoting Adray v.

1 Adry-Mart, Inc., 76 F.3d 984, 989 (9th Cir. 1995)).  
2 The Second Circuit has held that "'where . . . the  
3 defendant controls the most satisfactory evidence of  
4 sales the plaintiff needs only establish a basis for a  
5 reasoned conclusion as to the extent of injury caused  
6 by the deliberate and wrongful infringement.'" Louis  
7 Vuitton S.A.v. Spencer Handbags Corp., 765 F.2d 966,  
8 973 (2d Cir. 1985)(noting that a court may have to rely  
9 on "indirect and circumstantial evidence" if a  
10 defendant fails to produce evidence on damages). Here,  
11 Defendants are in the best position to know their  
12 profits and are in control of the evidence of their  
13 profits, but did not provide any such information in  
14 discovery or argue that the **REDACTED** amount is  
15 incorrect.

16 Given Defendants' failure to comply throughout  
17 discovery and failure to raise a genuine issue as to  
18 damages, Plaintiff has met its burden of establishing  
19 Defendants' revenue. Without any argument or evidence  
20 provided by Defendant as to costs, the Court accepts  
21 Plaintiff's calculation for the total profits as  
22 **REDACTED**. Thus, the Court **GRANTS** Plaintiff's request  
23 for disgorgement of profits in the amount of **REDACTED**.

#### 24 7. Attorneys' Fees

25 "The court in exceptional cases may award  
26 reasonable attorney fees to the prevailing party." 15  
27 U.S.C. § 1117(a). A case is considered exceptional  
28 "when the infringement is malicious, fraudulent,

1 deliberate, or willful," however, no egregious conduct  
2 or bad faith is required. Fifty-Six Hope Road, 778  
3 F.3d at 1079. There is ample evidence that Defendants  
4 willfully and deliberately infringed upon the MK Marks  
5 in an elaborate scheme to pass themselves off as the  
6 original MK. Thus, this is an exceptional case  
7 entitling Plaintiff to attorneys' fees.

### 8 **III. CONCLUSION**

9 Based on the foregoing, the Court **GRANTS**  
10 Plaintiff's Motion for Summary Judgment and Permanent  
11 Injunction in its entirety against Defendants Gary  
12 Topolewski, Morrison Knudsen Corporation, Morrison-  
13 Knudsen Company, Inc., Morrison-Knudsen Services, Inc.,  
14 and Morrison-Knudsen International Inc. All dates  
15 currently on calendar are vacated. The Court declines  
16 to enter a final judgment until a Motion for Default  
17 Judgment is brought and a decision is made as to the  
18 remaining defaulting Defendants: Todd Hale, John  
19 Ripley, Bud Zukaloff, and Henry Blum.

20  
21 **IT IS SO ORDERED.**

22  
23 DATED: November 8, 2018

s/ RONALD S.W. LEW

24 **HONORABLE RONALD S.W. LEW**  
25 Senior U.S. District Judge  
26  
27  
28