

TUCKER ELLIS LLP
Chicago ♦ Cleveland ♦ Columbus ♦ Houston ♦ Los Angeles ♦ San Francisco ♦ St. Louis

1 TUCKER ELLIS LLP
Howard A. Kroll SBN 100981
2 howard.kroll@tuckerellis.com
515 South Flower Street
3 Forty-Second Floor
Los Angeles, CA 90071-2223
4 Telephone: 213.430.3400
Facsimile: 213.430.3409

5 Attorneys for Plaintiff
6 VERRAGIO, LTD.

7
8 UNITED STATES DISTRICT COURT
9 EASTERN DISTRICT OF CALIFORNIA

11 VERRAGIO, LTD.,) Case No. 1:16-cv-01647-SKO
12 Plaintiff,)
13 v.) **CONSENT JUDGMENT AND PERMANENT**
14 MALAKAN DIAMOND CO.,) **INJUNCTION AGAINST MALAKAN**
15 Defendant.) **DIAMOND CO.**
16)
17) (Doc. 89)
18)
19)
20)
21 MALAKAN DIAMOND CO.,)
22 Counterclaimant/Crossclaimant,)
23 v.)
24 VERRAGIO, LTD.; AE JEWELERS, INC.; AE)
25 JEWELERS OF APPLETON, LLC; HAROLD)
26 JAFFE JEWELRY, INC.; JENSEN JEWELERS)
27 OF IDAHO, LLC; and DOES 1 to 10, inclusive,)
28 Counterclaim and Crossclaim)
Defendants.)

CONSENT JUDGMENT AND PERMANENT INJUNCTION

1
2 Plaintiff Verragio, Ltd. (“Verragio”), and Defendant Malakan Diamond Co. (“Malakan”), have
3 entered into a confidential settlement agreement to resolve this matter. As part of this agreement,
4 Verragio and Malakan agree to the entry of this Consent Judgment and Permanent Injunction against
5 Malakan.

6 Therefore, it is hereby ORDERED, ADJUDGED and DECREED as follows:

7 1. This case is a civil action arising under the Trademark and Copyright Laws of the United
8 States, 15 U.S.C. §§ 1051, et seq. and 17 U.S.C. §§ 101, et seq., respectively. This Court has
9 jurisdiction over the claims which relate to copyright infringement pursuant to 15 U.S.C. § 1121, 17
10 U.S.C. § 501, and 28 U.S.C. §§ 1331 and 1338(a).

11 2. Venue is proper in this Court pursuant to 28 U.S.C. §§ 1391(b) and 1400(a).

12 3. Verragio is a New York corporation with its principal place of business at 330 Fifth
13 Avenue, 5th Floor, New York, NY 10001.

14 4. Malakan is a California corporation with its principal place of business at 1354 W.
15 Herndon Ave., Fresno, CA 93711.

16 5. Barry Nisguretsky (“Nisguretsky”) is the Chief Executive Officer of Verragio.

17 6. Among Nisguretsky’s jewelry designs are Style Nos. D100, AFN 5005 CU, AFN 5060
18 CU and INS 7061R, each an original design comprising copyrightable subject matter under the laws of
19 the United States.

20 7. At all relevant times, Nisguretsky complied in all respects with the Copyright Acts, 17
21 U.S.C. § 101, et seq., and secured the exclusive rights and privileges in and to the copyrights of D100
22 (VA 1-818-420), AFN 5005 CU (VA 1-848-332), AFN 5060 CU (VA 1-866-432) and INS 7061R (VA
23 1-818-623) (collectively the “Verragio Copyrights”). Copies of the Certificates of Registration from the
24 Register of Copyrights for the Verragio Copyrights, as well as the deposit copies of the Verragio
25 Copyrights, are attached to this Consent Judgment as Exhibit A.

26 8. Nisguretsky has exclusively licensed his copyrighted jewelry designs to Verragio,
27 including Style Nos. D100, AFN 5005 CU, AFN 5060 CU and INS 7061R.
28

1 9. Since its creation, Style Nos. D100, AFN 5005 CU, AFN 5060 CU and INS 7061R have
2 been manufactured by Verragio or under its authority.

3 10. The Verragio Copyrights are valid and enforceable.

4 11. Each engagement ring in Verragio’s Insignia Collection, as well as in most of the other
5 Verragio collections, contains the Verragio Crest. The Verragio Crest, as it applies to jewelry, “consists
6 of the configuration of a crest in the shape of a crown with three points featured as a part of a ring
7 design.” Verragio owns a United States trademark registration for the Verragio Crest, Registration No.
8 4,336,434. A copy of the registration certificate for this is attached to this Consent Judgment as Exhibit
9 B.

10 12. The Verragio Crest is unique and distinctive and, as such, designates a single source of
11 origin.

12 13. The Verragio Crest is valid and enforceable.

13 14. Malakan sold and/or offered to sell rings pictured in Exhibit C (collectively, the
14 “Malakan Rings”).

15 15. Malakan and Malakan’s officers, directors, employees, representatives, agents,
16 successors-in-interest, parent corporations, subsidiary corporations, legal entities or persons controlled
17 by Malakan, and all other persons who are in active concert or participation with them, are hereby
18 permanently enjoined from:

19 a. Selling, offering to sell, imitating, copying, distributing, advertising, marketing or
20 manufacturing any ring protected by the Verragio Copyrights or rings that are substantially
21 similar to the Verragio Copyrights under the United States Copyright Law;

22 b. Selling, offering to sell, imitating, copying, distributing, advertising, marketing or
23 manufacturing any ring protected by the Verragio Crest or rings that are likely to cause
24 confusion with the Verragio Crest under the United States Trademark Law;

25 c. Selling, offering to sell, imitating, copying, distributing, advertising, marketing or
26 manufacturing any of the Malakan Rings, or rings that are substantially similar or likely to cause
27 confusion with the Malakan Rings under the United States Copyright and Trademark Laws; and
28

1 d. Knowingly assisting, aiding or abetting any other person or business entity in
2 engaging in or performing any of the activities referred to in subparagraphs 15(a) through 15(c)
3 above.

4 16. The parties waive notice of entry of this Consent Judgment and Permanent Injunction and
5 the right to appeal therefrom or to test its validity and consent to its immediate entry in accordance with
6 its terms. This Court expressly retains jurisdiction over this matter to enforce, implement or construe
7 this Consent Judgment and Permanent Injunction.

8 DATED: May 16, 2018

TUCKER ELLIS LLP

9
10 By: /s/Howard A. Kroll
11 Attorneys for Plaintiff
12 VERRAGIO, LTD.

13 DATED: May 16, 2018

14 YARRA, KHARAZI, CLASON &
15 ANIOTZBEHERE

16 By: /s/H. Ty Kharazi
17 Attorneys for Defendant
18 MALAKAN DIAMOND CO.

19 **ORDER**

20 IT IS SO ORDERED.

21 Dated: May 16, 2018

22 /s/ Sheila K. Oberto
23 UNITED STATES MAGISTRATE JUDGE
24
25
26
27
28

EXHIBIT A

EXHIBIT A

Certificate of Registration



This Certificate issued under the seal of the Copyright Office in accordance with title 17, *United States Code*, attests that registration has been made for the work identified below. The information on this certificate has been made a part of the Copyright Office records.

Maria A. Pallante

Register of Copyrights, United States of America

Registration Number
VA 1-818-420

Effective date of registration:
May 9, 2012

Title

Title of Work: D100

Completion/Publication

Year of Completion: 2011

Date of 1st Publication: April 1, 2012

Nation of 1st Publication: United States

Author

■ Author: BARRY NISGURETSKY

Author Created: jewelry design

Citizen of: United States

Domiciled in: United States

Copyright claimant

Copyright Claimant: Barry Nisguretsky

132 west 36th street, 8th floor, New York, NY, 10018, United States

Certification

Name: Barry Nisguretsky

Date: May 9, 2012



Certificate of Registration



This Certificate issued under the seal of the Copyright Office in accordance with title 17, *United States Code*, attests that registration has been made for the work identified below. The information on this certificate has been made a part of the Copyright Office records.

Maria A. Pallante

Register of Copyrights, United States of America

Registration Number
VA 1-848-332

Effective date of
registration:

December 1, 2012

Title

Title of Work: AFN-5005CU

Completion/Publication

Year of Completion: 2011

Date of 1st Publication: January 1, 2011

Nation of 1st Publication: United States

Author

Author: Barry Nisguretsky

Author Created: jewelry design

Citizen of: United States

Domiciled in: United States

Copyright claimant

Copyright Claimant: Barry Nisguretsky

132 west 36th street, 8th floor, New York, NY, 10018, United States

Certification

Name: Barry Nisguretsky

Date: December 1, 2012



50CU-2
40
50
VERI

Certificate of Registration



This Certificate issued under the seal of the Copyright Office in accordance with title 17, *United States Code*, attests that registration has been made for the work identified below. The information on this certificate has been made a part of the Copyright Office records.

Maria A. Pallante

Register of Copyrights, United States of America

Registration Number
VA 1-866-432

Effective date of registration:

June 17, 2013

Title

Title of Work: AFN-5060CU

Completion/Publication

Year of Completion: 2013

Date of 1st Publication: January 1, 2013

Nation of 1st Publication: United States

Author

▪ **Author:** Barry Nisguretsky

Author Created: jewelry design

Citizen of: United States

Domiciled in: United States

Copyright claimant

Copyright Claimant: Barry Nisguretsky

132 west 36th street, 8th floor, New York

Rights and Permissions

Organization Name: Verragio

Name: Barry Nisguretsky

Email: sales@verragio.com

Telephone: 212-868-8181

Address: 132 west 36th street

8th floor

New York, NY 10018

Certification

Name: Barry Nisguretsky

Date: June 17, 2013



Certificate of Registration



This Certificate issued under the seal of the Copyright Office in accordance with title 17, *United States Code*, attests that registration has been made for the work identified below. The information on this certificate has been made a part of the Copyright Office records.

Maria A. Pallante

Register of Copyrights, United States of America

Registration Number
VA 1-818-623

Effective date of registration:

April 3, 2012

Title

Title of Work: INS-7061R

Completion/Publication

Year of Completion: 2010

Date of 1st Publication: February 1, 2010

Nation of 1st Publication: United States

Author

▪ **Author:** Barry Nisguretsky

Author Created: jewelry design

Citizen of: United States

Domiciled in: United States

Copyright claimant

Copyright Claimant: Barry Nisguretsky

132 west 36th street, 8th floor, New York, NY, 10018, United States

Certification

Name: Barry Nisguretsky

Date: April 3, 2012



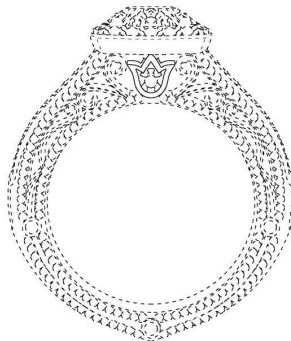
VERRAGIO

EXHIBIT B

EXHIBIT B

United States of America

United States Patent and Trademark Office



Reg. No. 4,336,434

VERRAGIO LTD. (NEW YORK CORPORATION)
132 WEST 36TH STREET, 8TH FLOOR
NEW YORK, NY 10018

Registered May 14, 2013

Int. Cl.: 14

FOR: JEWELRY MADE OF PRECIOUS AND SEMI-PRECIOUS GEMSTONES AND METALS,
IN CLASS 14 (U.S. CLS. 2, 27, 28 AND 50).

TRADEMARK

FIRST USE 4-15-2008; IN COMMERCE 4-15-2008.

SUPPLEMENTAL REGISTER

THE MARK CONSISTS OF THE CONFIGURATION OF A CREST IN THE SHAPE OF A CROWN WITH THREE POINTS FEATURED AS A PART OF A RING DESIGN. THE BROKEN LINES SHOWN IN THE DRAWING ARE INTENDED ONLY TO SHOW THE POSITION OF THE MARK AND ARE NOT CLAIMED AS A FEATURE OF THE MARK.

SER. NO. 85-497,442, FILED P.R. 12-16-2011; AM. S.R. 3-15-2013.

RENEE MCCRAY, EXAMINING ATTORNEY



Lea Street Lee

Acting Director of the United States Patent and Trademark Office

**REQUIREMENTS TO MAINTAIN YOUR FEDERAL
TRADEMARK REGISTRATION**

**WARNING: YOUR REGISTRATION WILL BE CANCELLED IF YOU DO NOT FILE THE
DOCUMENTS BELOW DURING THE SPECIFIED TIME PERIODS.**

Requirements in the First Ten Years*
What and When to File:

First Filing Deadline: You must file a Declaration of Use (or Excusable Nonuse) between the 5th and 6th years after the registration date. See 15 U.S.C. §§1058, 1141k. If the declaration is accepted, the registration will continue in force for the remainder of the ten-year period, calculated from the registration date, unless cancelled by an order of the Commissioner for Trademarks or a federal court.

Second Filing Deadline: You must file a Declaration of Use (or Excusable Nonuse) **and** an Application for Renewal between the 9th and 10th years after the registration date.*
See 15 U.S.C. §1059.

Requirements in Successive Ten-Year Periods*
What and When to File:

You must file a Declaration of Use (or Excusable Nonuse) **and** an Application for Renewal between every 9th and 10th-year period, calculated from the registration date.*

Grace Period Filings*

The above documents will be accepted as timely if filed within six months after the deadlines listed above with the payment of an additional fee.

**The United States Patent and Trademark Office (USPTO) will NOT send you any future notice or
reminder of these filing requirements.**

***ATTENTION MADRID PROTOCOL REGISTRANTS:** The holder of an international registration with an extension of protection to the United States under the Madrid Protocol must timely file the Declarations of Use (or Excusable Nonuse) referenced above directly with the USPTO. The time periods for filing are based on the U.S. registration date (not the international registration date). The deadlines and grace periods for the Declarations of Use (or Excusable Nonuse) are identical to those for nationally issued registrations. See 15 U.S.C. §§1058, 1141k. However, owners of international registrations do not file renewal applications at the USPTO. Instead, the holder must file a renewal of the underlying international registration at the International Bureau of the World Intellectual Property Organization, under Article 7 of the Madrid Protocol, before the expiration of each ten-year term of protection, calculated from the date of the international registration. See 15 U.S.C. §1141j. For more information and renewal forms for the international registration, see <http://www.wipo.int/madrid/en/>.

NOTE: Fees and requirements for maintaining registrations are subject to change. Please check the USPTO website for further information. With the exception of renewal applications for registered extensions of protection, you can file the registration maintenance documents referenced above online at <http://www.uspto.gov>.

EXHIBIT C

EXHIBIT C

