

1 1. **PERMANENT INJUNCTION.** Defendant, and any person or entity acting in
2 concert with, or at the direction of Defendant, including any and all agents, servants, employees,
3 partners, assignees, distributors, suppliers, resellers and any others over which Defendant may
4 exercise control, is hereby restrained and enjoined, pursuant to 15 United States Code
5 (“U.S.C.”) §1116(a) and 35 U.S.C. §283, from engaging in, directly or indirectly, or authorizing
6 or assisting any third party to engage in, any of the following activities in the United States and
7 throughout the world:

8 (i). copying, manufacturing, importing, exporting, purchasing, marketing,
9 selling, offering for sale, distributing or dealing in any product or service that uses, or otherwise
10 making any use of, any of BMW’s intellectual properties, including but not limited to, BMW®,
11 M®, and/or MINI® trademarks and/or Plaintiffs’ design patents D493,404; D504,382;
12 D515,491; D516,989; D527,334; D551,149; D560,585; D584,210; D597,015; D615,018 C1;
13 D617,243; D617,712; D631,813; D635,078; D643,794; and D671,477 (collectively hereinafter
14 “BMW’s Intellectual Properties”), and/or any intellectual property that is confusingly or
15 substantially similar to, or that constitutes a colorable imitation of, any BMW Intellectual
16 Properties, whether such use is as, on, in or in connection with any trademark, service mark,
17 trade name, logo, design, Internet use, website, domain name, metatags, advertising,
18 promotions, solicitations, commercial exploitation, television, web-based or any other program,
19 or any product or service, or otherwise;

20 (ii). advertising or displaying images and/or photographs of non-genuine
21 BMW automobile wheel rims with a BMW®, M®, and/or MINI® center cap or badge;

22 (iii). advertising or selling non-genuine BMW automobile rims, center caps, or
23 badges;

24 (iv). using BMW Intellectual Properties, including but not limited to the
25 BMW®, M®, and MINI® trademarks in advertising to suggest that non-genuine BMW
26 products being advertised are sponsored by, endorsed by, or are otherwise affiliated with BMW
27 and/or advertising non-genuine BMW automobile wheel rims and other non-genuine BMW
28 automotive parts using descriptions that imply that the products are genuine BMW products;

1 (v). using, advertising or displaying BMW's trademarks, including but not
2 limited to BMW®, M®, or MINI®-trademarks, to suggest that non-genuine BMW products
3 being advertised are manufactured, sponsored or endorsed by BMW or advertising non-genuine
4 BMW automobile parts or related products using descriptions that imply the products are
5 genuine BMW products. Defendant may, however, use "BMW" or other BMW wordmarks to
6 advertise non-BMW products with fair use descriptions such as 'for BMW automobiles' or 'fits
7 BMW model _____,' or similar language, provided that "BMW" and any other BMW
8 wordmarks that are used are in the identical font, format, size, and color as, and no more
9 prominently displayed than the surrounding text. In no event may any BMW logos, design
10 marks, or other graphical trademarks be used under this exception;

11 (vi). performing or allowing others employed by or representing Defendant, or
12 under Defendant's control, to perform any act or thing which is likely to injure Plaintiffs, any
13 BMW Intellectual Properties, including but not limited to the BMW®, M®, and MINI®
14 trademarks and/or Plaintiffs' design patents, and/or Plaintiffs' business reputation or goodwill,
15 including making disparaging, negative, or critical comments regarding Plaintiffs or their
16 products and services;

17 (vii). engaging in any acts of trademark infringement, false designation of
18 origin, dilution, unfair competition, design patent infringement, or other act which would tend
19 damage or injure Plaintiffs; and/or

20 (viii). using any Internet domain name or website that includes any of Plaintiffs'
21 trademarks or design patents, including but not limited to the BMW®, M®, and MINI® marks
22 and/or design patents D493,404; D504,382; D515,491; D516,989; D527,334; D551,149;
23 D560,585; D584,210; D597,015; D615,018 C1; D617,243; D617,712; D631,813; D635,078;
24 D643,794; and D671,477.

25 2. Defendant is ordered to deliver immediately for destruction all counterfeit,
26 infringing or otherwise unauthorized products, including automobile wheel rims, center caps,
27 emblems, badges, labels, signs, prints, packages, wrappers, receptacles and advertisements
28 relating thereto, in its possession and/or under its control embodying, comprised, utilizing

1 and/or bearing any BMW Intellectual Properties, or any simulation, reproduction, counterfeit,
2 copy or colorable imitations thereof, and all plates, molds, heat transfers, screens, matrices and
3 other means of making the same, to the extent that any of these items are in Defendant's
4 possession.

5 3. This Permanent Injunction shall be deemed to have been served upon Defendant
6 at the time of its execution by the Court.

7 4. The Court finds there is no just reason for delay in entering this Permanent
8 Injunction against Defendant, and, pursuant to Federal Rule of Civil Procedure 54(a), the Court
9 directs immediate entry of this Permanent Injunction against Defendant.


10 5. Defendant will be making an agreed-upon payment to Plaintiffs, as more
11 particularly described in a separate Settlement Agreement.

12 6. **NO APPEALS AND CONTINUING JURISDICTION.** No appeals shall be
13 taken from this Permanent Injunction, and the parties waive all rights to appeal. This Court
14 expressly retains jurisdiction over this matter to enforce any violation of the terms of this
15 Permanent Injunction by Defendant.

16 7. **NO FEES AND COSTS.** Each party shall bear their own attorneys' fees and
17 costs incurred in this matter.

18 8. **DISMISSAL.** Upon entry of this Permanent Injunction against Defendant, the
19 case shall be dismissed in its entirety.

20
21 IT IS SO ORDERED, ADJUDICATED and DECREED this 13th day of
22 October, 2015.

23 
24 _____
25 HON. EDWARD M. CHEN
26 United States District Court Judge
27 Northern District of California
28