

and JG are similar, if not identical (i.e., Juicy Girl), to the Juicy Marks in name alone. The contexts in which they are found are likely to cause further confusion. The design mark utilized by Defendants shown above, in Section Part I.B., for example, is similar in both name and design to a number of Plaintiff's marks. That design mark incorporates the word "Juicy," the initials "JG," a stylized gothic script, and the image of a crown similar to that used in some of Plaintiff's marks. The images below, with Plaintiff's on the left and Defendants' on the right, provide another example of the similarities between one of Defendants' marks and one of Plaintiff's:



Juicy Couture

(Samuelson Decl. Ex. A)



(Suen Deposition Ex. 20.)

The parties' marks also appear in similar contexts as both are used in the sale, packaging and promotion of women's apparel and accessories. Both parties use their marks on the products themselves, as well as in advertisements and promotions in traditional and social media outlets. Plaintiff has presented compelling evidence of similarities between its advertising campaigns and Defendants' promotional materials, called "stylebooks." (Tr. 84; Pl.'s Hearing Exs. 3-5.) Two promotional images presented at the hearing, for example, featured a blonde woman modeling a black tracksuit with gold writing along the pant leg—Plaintiff's which says Juicy Couture and Defendants' which says JG (Samuelson Dec. ¶ 15; Screenshot from www.juicylicious.com.hk ("Tarbutton Decl. Ex. N).) Both images also use gothic lettering—Defendants' on the tracksuit and Plaintiff's in the advertisement's text. (*Id.*) Defendants' stylebooks also contain many key themes and motifs found in Plaintiff's marketing materials, primarily what has been characterized as a "California-based" setting and theme. Other similarities include the use of a

similar color pink, and motifs such as hearts, graffiti, the British flag and leopard and tartan prints. (Tr. 77-84; Pl.'s Hearing Exs. 3-5.) Because of these similarities—between both the marks themselves and the context in which they are used—an ordinary consumer could conclude that the products derive from the same source. See Stix Prods. Inc. v. United Merchs. & Mfrs., Inc., 295 F. Supp. 479, 493-94 (S.D.N.Y. 1968). This factor favors Plaintiff.

3. The Competitive Proximity of the Products.

The third Polaroid factor considers the extent to which the parties' products compete with each other for customers. See Brennan's, 360 F.3d at 134. In considering this factor, courts examine “the nature of the products themselves and the structure of the relevant market,” including “the manner in which the products are advertised, and the channels through which the goods are sold.” Cadbury Beverages v. Cott Corp., 73 F.3d 474, 480 (2d Cir. 1996) (citing Vitarroz v. Borden, Inc., 644 F.2d 960, 967 (2d Cir. 1981)). Here, the parties' products are advertised and sold in the same channels. Both parties sell apparel and accessories on the Internet and target women and girls as consumers.

One distinguishing feature, however, is that Defendants have only sold products in the United States through the Internet, whereas a substantial percentage of Plaintiff's sales in the United States are through brick and mortar stores. This means that shoppers who exclusively purchase in retail locations will not be at risk of encountering Defendants' products and being confused as to the source of the goods. See New Look Party Ltd. v. Louise Paris Ltd., No. 11 Civ. 6433 (NRB), 2012 WL 251976, at *7 (S.D.N.Y. Jan. 11, 2012) (finding “the fact that plaintiff does not sell its clothing in any physical locations in the United States” when the defendant does “weighs heavily against finding a likelihood of confusion”). Nonetheless, insofar

as Defendants' products are available online to United States consumers, the parties' products are in close competitive proximity. Accordingly, this factor weighs in favor of Plaintiff.

4. Whether Plaintiff Will Bridge the Gap

"The term 'bridging the gap' is used to describe the senior user's interest in preserving avenues of expansion and entering into related fields." NYC Triathlon LLC v. NYC Triathlon Club, Inc., 704 F. Supp. 2d 305, 338 (S.D.N.Y. 2010) (quoting CLASS Promotions, Inc. v. DS Magazines, Inc., 753 F.2d 14, 18 (2d Cir. 1985)). No evidence has been presented of a gap of this sort. This factor thus favors neither party.

5. Actual Confusion

Plaintiff has not presented any evidence of actual confusion and this factor similarly favors neither party. The Court notes, however, that "actual confusion need not be shown to prevail under the Lanham Act, since actual confusion is very difficult to prove and the Act requires only a likelihood of confusion as to source." Savin Corp. v. Savin Grp., 391 F.3d 439, 459 (2d Cir. 2004) (quoting Lois Sportswear, 799 F.2d at 875).

6. Bad Faith

The "inquiry into willfulness or bad faith 'considers whether defendant adopted its mark with the intention of capitalizing on plaintiff's reputation and goodwill and on any confusion between his and the senior user's product.'" De Beers LV Trademark Ltd. v. DeBeers Diamond Syndicate, Inc., 440 F. Supp. 2d 249, 278 (S.D.N.Y. 2006) (quoting Savin, 391 F.3d at 460). Plaintiff argues that bad faith is evidenced by Defendants' knowledge of Plaintiff's U.S. rights in the Juicy Marks since at least early 2008 (when Plaintiff initiated the Hong Kong action) and Defendants' subsequent efforts to sell their products in the United States. (Pl.'s Mem. 16.)

Defendants maintain that they were the first to use the Juicy Girl mark in Hong Kong—a contention that is being actively litigated in the Hong Kong action—but make no representation that they were unaware of Plaintiff’s marks when they began to sell to consumers in the United States. Nonetheless, there is no direct evidence in the record before the Court that Defendants entered the U.S. market with the intention of “capitalizing on plaintiff’s reputation and goodwill.” See De Beers, 440 F. Supp. 2d at 278. According to Defendants, their sales to the U.S. are “*de minimis*” and “[i]n its normal course of business, [they] do[] not direct [their] advertising or marketing to the U.S.” (Defs.’ Opp’n 5-6.) While the glaring similarities between the marks and the context in which they are used suggest Defendants’ bad faith, the Court hesitates to make such a finding at this stage, particularly given Defendants’ outstanding claim to rightful ownership of the mark abroad, and the Court need not do so in light of its ultimate ruling.

7. Quality of the Products

This factor requires the Court to “consider[] whether the senior user’s reputation could be ‘tarnished by [the] inferior merchandise of the junior user.’” Cadbury Beverages, 73 F.3d at 483 (2d Cir. 1996) (quoting Scarves by Vera, Inc. v. Todo Imps. Ltd., 544 F.2d 1167, 1172 (2d Cir. 1976)). As a result, this factor “goes more to the harm that confusion can cause the plaintiff’s mark and reputation than to the likelihood of confusion.” Virgin Enters., Ltd. v. Nawab, 335 F.3d 141, 152 (2d Cir. 2003). Plaintiff argues that Defendants’ products are of an inferior quality and claims that as a result, there is a strong risk that Defendants’ use of the Juicy Marks will “jeopardize Plaintiff’s highly regarded and longstanding reputation.” (Pl.’s Mem. 17.) Defendants have submitted evidence of Hong Kong celebrity consumers and press coverage and accolades from the Hong Kong community, creating some doubt as to whether and to what

degree, Defendants' products are viewed in an inferior light. (Suen Decl. ¶¶ 9-11.) At this stage, without having examined the products themselves or having received evidence of a disparity in quality, the Court is unable to make a finding on this issue.

8. Consumers' Sophistication

The final Polaroid factor is "grounded on the belief that unsophisticated consumers aggravate the likelihood of confusion." Simon & Schuster, Inc. v. Dove Audio, Inc., 970 F. Supp. 279, 300 (S.D.N.Y. 1997). Courts have held that shopping for casual apparel does not require a heightened degree of care by the purchaser. See, e.g., THOIP v. Walt Disney Co., 736 F. Supp. 2d 689, 714-15 (S.D.N.Y. 2010) ("[A]lthough a consumer can be expected to "examine the shirt, consider alternatives, and even try it on," the purchase of a relatively inexpensive t-shirt does not call for "any degree of sophistication."); Phillips-Van Heusen Corp. v. Calvin Clothing Co., 444 F. Supp. 2d 250, 257 (S.D.N.Y. 2006) ("[T]he average clothing customer is not particularly sophisticated."). A prior decision in this district, however, has found that "consumers who are aware of [Juicy] Couture are fashion conscious" and "likely to be relatively sophisticated shoppers," Juicy Couture, Inc. v. L'Oreal USA, Inc., No. 04 Civ. 7203 (DLC), 2006 WL 1012939, at *29 (S.D.N.Y. Apr. 19, 2006), a proposition Juicy does not appear to dispute. (Pl.'s Mem. 18.) This factor does not favor either party.

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Having considered each of the Polaroid factors, the Court finds that Plaintiff has demonstrated a likelihood of confusion. The strength of Plaintiff's marks, similarities of the parties' marks and their competitive proximity, often considered the three most significant factors, all strongly favor Plaintiff. See Marks Org., Inc. v. Joles, 784 F. Supp. 2d 322, 330 (S.D.N.Y. 2011) ("[C]ourts generally hold that the first three factors [of the Polaroid test] are the