

UNITED STATES DISTRICT COURT  
SOUTHERN DISTRICT OF NEW YORK

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RIVER LIGHT V, L.P. and TORY BURCH	:	
LLC,	:	
	:	
Plaintiffs,	:	
	:	13cv3669 (DLC)
-v-	:	
	:	<u>OPINION &amp; ORDER</u>
LIN & J INTERNATIONAL, INC., YOUNGRAN	:	
KIM, LJ BRAND, INC., and NJ LIN & J	:	
INTERNATIONAL, INC.,	:	
	:	
Defendants.	:	
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APPEARANCES:

For Plaintiffs River Light V, L.P. and Tory Burch LLC:

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For Defendants Lin & J International, Inc., Youngran Kim, LJ Brand, Inc., and NJ Lin & J International, Inc.:

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DENISE COTE, District Judge:

Plaintiffs River Light V, L.P. and Tory Burch LLC  
  
(together, "Tory Burch" or "Plaintiffs") bring this action for  
counterfeiting and trademark infringement, among other things,

against defendants Youngran Kim ("Kim") and three companies she controls, Lin & J International, Inc., LJ Brand, Inc., and NJ Lin & J International, Inc. (together, "Lin & J," and with Kim, "Defendants"). Tory Burch now moves for summary judgment on these two claims. For the reasons that follow, Tory Burch's motion is granted in part.

### **BACKGROUND**

The facts below, drawn from Tory Burch's submissions in support of the instant motion and a prior motion for sanctions, are undisputed.<sup>1</sup> All reasonable inferences are drawn in Defendants' favor, as non-movants.

#### **I. Tory Burch**

Tory Burch is a well-known fashion brand. Tory Burch opened its doors in 2004; it now has 120 stores across the world, including more than 60 in the United States, and its fashion line appears in more than 3,000 department and specialty stores worldwide.

##### **A. Tory Burch Logo**

Tory Burch's products typically feature prominently one of several variations on its logo, which is composed of two stylized letter "T"s, one upside-down and stacked atop the other, forming a cross-like figure (the "T-over-T Design"). The

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<sup>1</sup> As explained below, Defendants' opposition to this motion was stricken.

original TT Logo was created in 2003 by a brand development company, MODCo Creative, LLC, with direction from Tory Burch's eponymous founder ("Ms. Tory Burch"). It features a T-over-T Design inscribed within a circle (the "TT Logo"), as pictured here:



Since 2004, the TT Logo has been used continuously by Tory Burch as a source identifier on its products, packaging, hangtags, labels, shopping bags, gift boxes, stationary, and storefronts, as well as in its patterns, products, marketing and promotional materials, and advertisements.

In late 2008, Tory Burch designed sunglasses featuring the TT Logo split between the end pieces of the glasses and the stem of the sunglasses' arms (called "temples"), as pictured below:



The fold between the end pieces and temples created a vertical split within the TT Logo ("Split TT Logo"). After these

sunglasses were first sold in 2009, Tory Burch began using the Split TT Logo on other Tory Burch products. Since 2009, Tory Burch has used the Split TT Logo to identify the source of the products on which it appears, including jewelry, clothing, and accessories. Tory Burch has also continuously used the T-over-T Design without a circle (the "Bare TT Logo") on a variety of products, including jewelry, to identify Tory Burch as the source. Since at least January 15, 2006, Tory Burch has used the "Tory Burch" word mark on products including jewelry to identify its source.

**B. The Popularity of Tory Burch's Brand**

Tory Burch has invested hundreds of millions of dollars in developing, advertising, and promoting Tory Burch products featuring the TT Logo. Tory Burch has a major presence on a variety of social media platforms -- for instance, the Tory Burch brand has more than one million "likes" on Facebook. Tory Burch has generated many millions of dollars each year since 2007. The Tory Burch brand has been featured on Oprah Winfrey's talk show and the television series "Gossip Girl" and has been worn by celebrities including Beyonce Knowles-Carter, Cameron Diaz, the Duchess of Cambridge Catherine Middleton, and First Lady Michelle Obama. In 2008, Ms. Tory Burch won the Accessories Designer of the Year award from the Council of Fashion Designers of America. In the last two years, Forbes has

referred to the TT Logo as "iconic" and "distinctive," the New York Times has called the TT Logo "near-ubiquitous," and the Wall Street Journal has noted the TT Logo is "as instantly recognizable as those of brands established generations prior."

**C. Tory Burch Trademarks**

In September 2003, Tory Burch filed a trademark application with the United States Patent and Trademark Office ("PTO") for use of the TT Logo on jewelry, handbags, clothing, and accessories. The application claimed a first use in commerce date of February 1, 2004. This trademark was registered on December 13, 2005 and received registration number 3,029,795 (the "TT Logo Trademark"); Tory Burch has used this mark continuously since 2004. Since then, Tory Burch has received ten other trademarks for use of the TT Logo in connection with goods ranging from socks to leather key chains to dog collars to cell phone cases. Tory Burch has not filed a trademark application with the PTO for use of the Split TT Logo on jewelry, although Tory Burch has applied for and received four trademark registrations for the Split TT Logo in connection with other goods, including eyewear. Tory Burch applied for a trademark of the Bare TT Logo for use in connection with jewelry on August 30, 2012, citing a first use in commerce date of January 31, 2011. This trademark was registered with the PTO on July 9, 2013 and received registration number 4,363,739 (the

"Bare TT Logo Trademark"). Tory Burch also received a registered trademark in the "Tory Burch" word mark in connection with jewelry on May 13, 2008, with a first use in commerce date of January 16, 2006 and registration number 3,428,816 (the "'Tory Burch' Trademark"). Tory Burch also owns copyright registrations for the TT Logo and Split TT Logo.<sup>2</sup>

#### **D. Sales Channels**

Tory Burch maintains strict quality control standards over its products, and sales of authentic Tory Burch products are limited to a network of authorized retailers including high-end department stores, quality boutiques, Tory Burch's own storefronts, and Tory Burch's online store. Tory Burch jewelry retails for between \$78 and \$450. Tory Burch products are marketed to a wide range of consumers, predominately women, in all different age groups and demographics.

## **II. Lin & J**

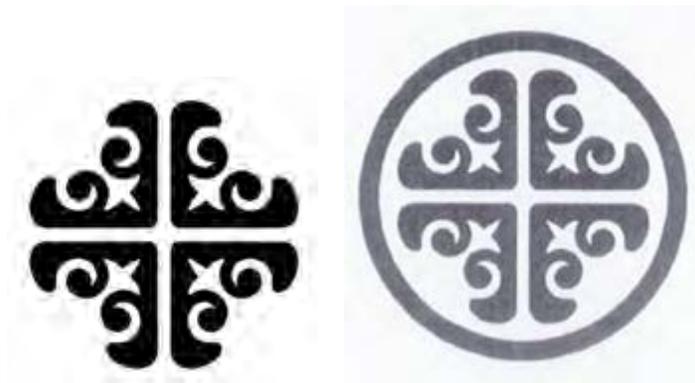
Kim created Lin & J International, Inc. in 2005, and LJ Brand, Inc. and NJ Lin & J International, Inc. in 2013. All three remain wholly owned and controlled by Kim. Defendants manufacture, promote, and sell fashion jewelry including earrings, necklaces, pendants, cuffs, bangles, and bracelets. Kim herself chooses what Defendants sell, including the Accused

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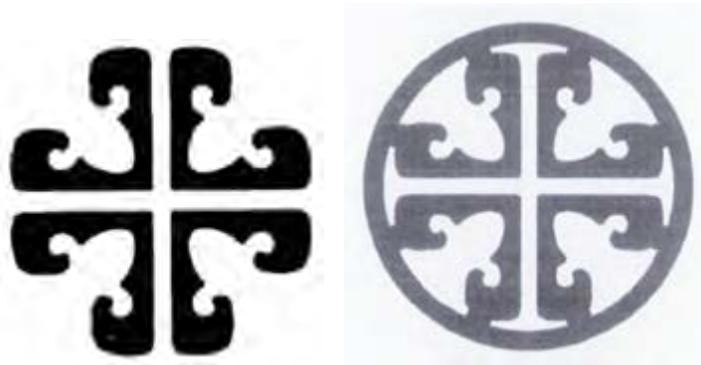
<sup>2</sup> U.S. Reg. No. VA 1-768-387 (TT Logo); U.S. Reg. No. VA 1-880-129 (Split TT Logo).

Products, and authorized the sales of the Accused Products. Each Lin & J entity sells the Accused Products in wholesale and retail channels, in storefronts and online. Third-party retailers who purchase the Accused Products wholesale sell them both in storefronts and online.

The Accused Products bear one of two designs. Defendants call the first the "Isis Cross Design"; it is pictured below.



The second is the so-called "Predecessor Design," pictured here:



In a counterclaim for trademark infringement (the "Trademark Counterclaim"), Defendants asserted that Tory Burch products "bear[] . . . and infring[e] on Lin & J's Isis Cross design trademark" and that "Tory Burch's use of the Isis Cross design is likely to lead to and result in confusion, deception and

mistake in the minds of consumers, the public and the trade” and “is likely to create a false impression and deceive customers, the public and the trade into believing that Lin & J has infringed on . . . Tory Burch’s trademark.”

A number of the Accused Products closely resemble Tory Burch jewelry not just in their use of the Isis Cross Design or Predecessor Design, but in all respects. Below, pictures of genuine Tory Burch jewelry appear on the left; pictures of similar Lin & J products appear on the right.

Tory Burch



Lin & J





Defendants have sold more than 1.5 million of the Accused Products to at least 420 direct customers, including wholesalers, distributors, and retailers, and nearly all of that between 2012 and the present. Defendants' sales of the Accused Products were approximately \$523,000 in 2012, \$2.3 million in 2013, and \$1.1 million between January 1, 2014 and June 30, 2014.

Kim claims the Accused Products are "high quality fashion accessories" and "high quality jewelry." She identifies the ultimate consumers of the Accused Products as "a wide range of women . . . in all different age groups and demographics."

In their invoices, Defendants have referred to one of the Accused Products, pictured below, as the "Tory Burch Style Stretch Ring."



One of Defendants' customers, C & L Trading of Miami, described the Accused Products as "T.B. Cross" in purchase orders. For instance, in a purchase order dated January 6, 2013 for hundreds of the Accused Products, each of the item descriptions begins with "T.B. Cross," and includes products like "T.B. CROSS LEATHER WIDE BRACELET," "T.B. CROSS W/ STONE EARRINGS," and "T.B. CROSS 30 [INCH] LONG NECLACE [sic] SET." Tiffany Walden ("Walden"), Tory Burch's Senior Counsel -- Director of Intellectual Property and Brand Enforcement, has identified 213 retailers who have referred to Tory Burch in marketing the Accused Products.

### **III. Surveys**

Tory Burch hired RL Associates, a survey research and consulting firm, to study the extent to which women were

confused as to the source of the Accused Products.<sup>3</sup> RL Associates' study (the "Tory Burch Survey") surveyed women between the ages of 21 and 59 who said they were interested in women's fashion and regularly read a women's fashion magazine or blog. The Tory Burch Survey found that 26% of respondents, and 57% of respondents who reported having heard of Tory Burch, identified Tory Burch as the source of authentic Tory Burch jewelry. 31% of respondents, and 53% of respondents who had heard of Tory Burch, identified Tory Burch as the source of the Accused Products bearing the Isis Cross Design. 25% of respondents, and 51% of respondents who had heard of Tory Burch, identified Tory Burch as the source of the Accused Products bearing the Predecessor Design. Tory Burch's expert concluded, on the basis of the Survey, that there is a strong likelihood, in the post-sale context, that the source of the Accused Products would be misidentified as Tory Burch.

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<sup>3</sup> Tory Burch has submitted a second expert report, authored by Dr. Russell Mangum, concluding that Tory Burch suffered substantial lost profits from Defendants' sale of the Accused Products. Tory Burch has also submitted Defendants' expert rebuttal report, authored by Dr. Warren J. Keegan ("Keegan"). Keegan concludes that the Accused Products are not similar to Tory Burch products and do not compete with Tory Burch products, as the Accused Products are "low cost entry-level costume jewelry" of "limited quality" while Tory Burch jewelry is "finely manufactured . . . [and] of high quality."

#### **IV. Tory Burch Discovers Defendants' Operation**

Tory Burch polices its intellectual property, including the trademarks referenced above, through investigations into possible counterfeiters, serving enforcement letters, filing law suits, and cooperating with law enforcement and customs to seize counterfeit goods. Walden conducts such investigations into possible counterfeit goods.

In the summer of 2012, Walden began to notice an increasing number of retailers and e-retailers selling jewelry not produced or authorized by Tory Burch bearing designs similar to the Split TT Logo and describing this jewelry as "Tory Burch," "Tory Burch Logo," "Tory Burch knockoff," "Tory," and "TB." As Walden would later discover, much of this jewelry had been produced by Defendants and is described above as the Accused Products. This trend continued in 2013. Google Image searches for "Tory Burch" plus a type of jewelry (e.g., "earrings" or "bangle bracelet") were generating dozens of images of the Accused Products. In some instances, the Accused Products appeared as the first search results in a Google Image search, ahead of genuine Tory Burch jewelry.

Walden uncovered a number of users promoting the Accused Products on various social media platforms. While monitoring Facebook, Walden discovered more than 70 Facebook users promoting the Accused Products. Walden also found eighteen

Pinterest users promoting the Accused Products and describing them as "Tory Burch" jewelry. Some of these promotional "pins" were then "repinned" by other Pinterest users -- in one case, by 1,700 other users. Surveillance of Instagram turned up 41 Instagram users promoting the Accused Products and describing them as "Tory Burch" or "Tory Burch inspired" jewelry. Similarly, monitoring of eBay and Etsy uncovered dozens of users promoting the Accused Products and describing them as "Tory Burch" or "Tory Burch inspired."

In addition, Walden found 64 online stores selling the Accused Products, many of which described them as "Tory Burch" or "Tory Burch inspired" jewelry. Storefronts, including the retailers Curlz & Dots Monogramming, Molly and Zoey, Silhouette Boutique, and Haute Pink Boutique, were also selling the Accused Products and referring to them as "Tory Burch" or "Tory." All told, Walden has found 213 retailers selling the Accused Products, many of which refer to the jewelry as "Tory Burch" or "Tory."

In at least one case, the Accused Products have been advertised by a retailer under the TT Logo. At least two retailers, Closet Envy and Monkee's, have sold both authentic Tory Burch products and the Accused Products. Closet Envy advertised the Accused Products as "knock off Tory Burch" products.

The Accused Products generally retail for between \$10 and \$30. In some cases, the retail price of the Accused Products is quite close to the retail price of Tory Burch jewelry it resembles. For example, an unauthorized necklace manufactured by Defendants was sold for \$42 and unauthorized earrings produced by Defendants was sold for \$32 at Closet Envy.

On March 3, 2013, Walden sent the retailer Jewelria an enforcement letter after an investigator purchased certain Accused Products from Jewelria. Jewelria responded, identifying defendant Lin & J as one of its two suppliers. In a March 27, 2013 e-mail to Walden, counsel for Jewelria advised that Lin & J had told Jewelria it "has some arrangement with [Tory Burch] that allows the sale of the products it manufactures to be sold." No such arrangement existed.

On April 29, 2013, Walden sent an enforcement letter to retailer Sam Mi Wholesale ("Sam Mi") after an investigator purchased certain Accused Products from Sam Mi. After receiving this letter, Soon Kim, an employee of Sam Mi, contacted Lin & J, the supplier of Sam Mi's Accused Products. Lin & J then provided Sam Mi with false invoices that substantially understate the amount of Unauthorized Jewelry sold by Lin & J to Sam Mi and change the product description for certain items from "Isis Cross" -- which Tory Burch had identified as an infringing design -- to "Snowflake."

On May 6, 2013, an agent from the United States Customs and Border Protection ("U.S. Customs") e-mailed Walden to advise that Lin & J's Accused Products had been seized, as they "appear to be of very low quality and with [the officer's] expertise in handling all types of commodities . . . looks counterfeit." On March 19, 2014, an officer on the New York City Police Department Peddler Task Force e-mailed Walden to advise that Lin & J Accused Products had been seized, as "[t]hey look close to Tory Burch."

**V. Spoliation & Fabrication of Evidence by Defendants**

In the fall of 2012, Kim learned that Tory Burch had sent cease-and-desist letters to Lin & J clients. Kim then contacted the law firm of Troutman Sanders LLP to discuss applying to register a trademark. On January 30, 2013, Kim filed two trademark applications through Troutman Sanders. The first was for the logo Kim had been using to identify Lin & J products to date -- on banners and hangtags, for example (the "Isis Creative Logo"). That logo bears no resemblance to the TT Logo.<sup>4</sup> The second application was for the Isis Cross Design (the "Isis Cross Application"). The specimen submitted to the PTO in

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<sup>4</sup> The PTO rejected the application to trademark the Isis Creative Logo on April 3, 2013, citing the likelihood of confusion with other registered marks. Lin & J has abandoned that application.

support of the Isis Cross Application is pictured with a hangtag bearing the Isis Creative Logo.

On May 16, 2013, the PTO rejected the Isis Cross Application, finding that Lin & J had not used the Isis Cross Design as a trademark identifying the source of its goods, but instead as "merely a decorative or ornamental feature of the goods/packaging of the goods." Two weeks later, on May 31, Tory Burch filed the instant suit. Defendants were served on June 3. Shortly afterward, Kim hired the Song Law Firm to handle Defendants' defense, as well as the Isis Cross Application. Sometime in 2013, Kim created LJ Brand, Inc. to sell products bearing the Isis Cross and a new website, [www.isiscross.com](http://www.isiscross.com).

On July 18, Defendants filed their answer and counterclaims, including the Trademark Counterclaim alleging that the TT Logo infringed Defendants' trademark in the Isis Cross. Two days before, Defendants made substantive modifications to sixteen invoices from 2009 that they subsequently produced to Tory Burch as evidence of sales of Isis Cross products.

On August 15 and 16, 2013, Kim fabricated four collection books prominently featuring Isis Cross products and the Isis Cross Design that purport to be from 2009, 2010, 2011, and 2012 (the "False Collection Books"). The False Collection Books include pages welcoming customers to Lin & J. The majority of

the digital images of Isis Cross products used to create the False Collection Books were taken on August 15 or 16. On August 16, the initial pretrial conference was held in this action. At that conference, counsel for Defendants represented that they had been using the Isis Cross Design in jewelry since 2003.

On September 3, 2013, Lin & J submitted new specimens to the PTO in support of the Isis Cross Application, including the False Collection Book for 2012. The specimens also include pictures of the storefront of Wona Trading showing Isis Cross products sold under an Isis Cross sign. Those pictures were staged by Lin & J. Lin & J employees asked Wona Trading to briefly place the Isis Cross sign in its storefront to permit Lin & J to take pictures, explaining that Lin & J was being sued by Tory Burch for counterfeiting. The sign was removed immediately after Lin & J's pictures were taken. The Isis Cross Application continued to assert the Isis Cross Design was first used in commerce as of January 19, 2009. Kim admits she was warned that "willful false statements" were punishable by fine or imprisonment.

On October 8, 2013, to assist in mediation, Lin & J produced limited discovery purporting to evidence the history of its use of the Isis Cross Design. In that discovery, Lin & J produced invoices from 2005 to 2013. Lin & J produced -- and has to this day produced -- only a single invoice showing the

sale of an Isis Cross product for each of the years 2005, 2006, and 2007, and few invoices for years prior to 2012. A later forensic examination of Defendants' invoices revealed that all of these invoices dated before December 22, 2011 had been substantively modified years after the date they were created. In many of these invoices, the Isis Cross product appears at the bottom of the invoice. An examination of Defendants' invoicing system established that items added to an invoice after-the-fact would be added to the bottom of the invoice.

On January 31, 2014, Defendants produced the remainder of the relevant invoices to Tory Burch. A later forensic examination of those invoices showed that many of those invoices had been substantively modified on December 17 or December 31, 2013. Many invoices listing "Filigree" or "Snowflake" as the final item were last substantively modified on December 17; many invoices listing "Tory Burch Style Stretch Ring" were last modified on December 31. Defendants produced the original Sam Mi invoices, not the modified invoices. Defendants also produced all four of the False Collection Books without noting that they had been created years after the years from which they purport to date.

In April 2014, Tory Burch served Lin & J customers identified in the Lin & J invoices with subpoenas requesting the customers' copies of those invoices. The invoices produced by

Lin & J's customers do not match Lin & J's invoices for years before 2012, as they do not show the purchase of Isis Cross products.

The parties agreed to hire neutral forensic computer expert Andrew Donofrio ("Donofrio") to collect the native files corresponding to Lin & J's invoices from Lin & J's computer system. Donofrio visited Lin & J's office and collected these files on April 30, 2014. He found that many of these invoices had been last substantively modified the day before, on April 29. The earliest invoice produced by Lin & J that was not substantively modified after its creation is dated December 22, 2011. Donofrio returned on July 1 to test Lin & J's invoicing system to determine what actions change the "last modified" date for invoices. He determined that only substantive actions that change the invoice data alter that date. Viewing, exporting, or printing invoices does not alter that date. Tory Burch's own expert, Andrew Rosen ("Rosen"), reviewed the data collected by Donofrio and confirmed his conclusions.

## **VI. Sanctions**

Tory Burch moved for sanctions on August 29, 2014, citing Defendants' spoliation of invoice data and fabrication of evidence including the False Collection Books. Defendants voluntarily dismissed their Trademark Counterclaim on September 5. A hearing was held on November 4 and November 5.

The Court found that Defendants had altered the invoice data and produced falsified invoices and the False Collection Books to Tory Burch in order to, at the very least, fabricate evidence of use of the Isis Cross Design prior to December 22, 2011. Defendants agreed that their remaining counterclaims, as well as certain affirmative defenses, were related to the spoliation and fabrication of evidence. Accordingly, the Court held Defendants would not be permitted to introduce this evidence and that a jury would be entitled to an instruction advising it of Defendants' spoliation and fabrication of evidence. The Court dismissed Defendants' remaining counterclaims with prejudice and struck the affirmative defenses relating to the tainted evidence. In addition, Tory Burch was granted costs and fees incurred in uncovering Defendants' spoliation and fraud on the Court, bringing the motion for sanctions, and litigating Defendants' counterclaims, among other things.

#### **VII. Defendants' Summary Judgment Opposition Papers**

On September 10, 2014, Tory Burch brought the instant motion for summary judgment on its claims for counterfeiting and trademark infringement. Defendants' opposition was due September 29. On September 29, Howard Myerowitz ("Myerowitz"), counsel for Defendants, requested, on consent, an extension to October 1. He represented that his computer system crashed over

the weekend. The Court granted the request. On October 1, Myerowitz requested an extension to October 2. The Court again granted the extension but noted the October 2 deadline was firm.

On October 3, Tory Burch wrote the Court to advise that Myerowitz had not served them with Defendants' opposition papers (the "Opposition Papers"). On October 6, Myerowitz filed a letter with the Court representing that he had confirmed with his paralegal that the Opposition Papers had been mailed to Tory Burch on October 2. Later that day, Tory Burch wrote the Court with further evidence that the Opposition Papers had not been mailed on October 2: a mailing label showing the package containing the Opposition Papers had departed Newark Liberty International Airport at 7 a.m. on October 5. In a letter to the Court of October 7, Myerowitz maintained his story and chastised Tory Burch's counsel for making "outrageous and baseless accusations."

Following receipt of Myerowitz's letter of October 7, the Court entered an Order finding good cause to believe he had misrepresented the mailing date. The Court ordered a forensic examination of Myerowitz's computer system to determine when the Opposition Papers were completed and set a hearing date.

On October 9, Myerowitz wrote the Court to admit that Defendants' Opposition Papers were mailed on October 3, not October 2, and to apologize for his repeated misrepresentations.

At a hearing on November 6, the evidence showed that Myerowitz was composing the Opposition Papers through the afternoon of October 3, knew the Opposition Papers were mailed on October 3, and knowingly misrepresented their mailing date to the Court.

Despite the fact that the Opposition Papers were untimely and Defendants' counsel had lied to the Court to hide this fact, the Court permitted Defendants an opportunity to submit a redline of the Opposition Papers, excising all passages that referred to evidence tainted by Defendants' spoliation and fabrication. Defendants submitted a redline on November 6 that continued to rely on such evidence. Accordingly, by Order of November 12, Defendants' Opposition Papers were stricken. As a result, Tory Burch's motion is unopposed.

## **DISCUSSION**

### **I. Summary Judgment Standard**

Summary judgment may not be granted unless all of the submissions taken together "show[] that there is no genuine dispute as to any material fact and the movant is entitled to judgment as a matter of law." Fed. R. Civ. P. 56(a). The moving party bears the burden of demonstrating the absence of a material factual question, and in making this determination, the court must view all facts in the light most favorable to the non-moving party. Eastman Kodak Co. v. Image Technical Servs., Inc., 504 U.S. 451, 456 (1992); Holcomb v. Iona Coll., 521 F.3d

130, 132 (2d Cir. 2008). Once the moving party has asserted facts showing that the non-movant's claims cannot be sustained, the opposing party must "set out specific facts showing a genuine issue for trial," and cannot "rely merely on allegations or denials" contained in the pleadings. Fed. R. Civ. P. 56(e); see also Wright v. Goord, 554 F.3d 255, 266 (2d Cir. 2009). Nor may a party "rely on mere speculation or conjecture as to the true nature of the facts to overcome a motion for summary judgment," as "[m]ere conclusory allegations or denials cannot by themselves create a genuine issue of material fact where none would otherwise exist." Hicks v. Baines, 593 F.3d 159, 166 (2d Cir. 2010) (citation omitted). "A submission in opposition to (or in support of) summary judgment need be considered only to the extent that it would . . . be[] admissible at trial." Doe ex rel. Doe v. Whelan, 732 F.3d 151, 157 (2d Cir. 2013) (citation omitted). Only disputes over material facts -- "facts that might affect the outcome of the suit under the governing law" -- will properly preclude the entry of summary judgment. Anderson v. Liberty Lobby, Inc., 477 U.S. 242, 248 (1986).

Even when a summary judgment motion is unopposed, a court may not "automatically grant summary judgment." Jackson v. Fed. Exp., 766 F.3d 189, 194 (2d Cir. 2014). "Before summary judgment may be entered, the district court must ensure that each statement of material fact is supported by record evidence

sufficient to satisfy the movant's burden of production," and "the court must determine whether the legal theory of the motion is sound." Id.

## **II. Trademark Infringement Claim**

Trademark infringement claims under Sections 32 or 43(a) of the Lanham Act are analyzed in two stages. Christian Louboutin S.A. v. Yves Saint Laurent Am. Holdings, Inc., 696 F.3d 206, 216 (2d Cir. 2012). First, plaintiff must establish that its mark is entitled to protection. Id. Once a plaintiff proves the mark is entitled to protection, the plaintiff must then show that the "defendant's use of a similar mark is likely to cause consumer confusion." Id. at 217 (citation omitted).

Section 32(1)(a) of the Lanham Act grants the registrant of a trademark a cause of action against any person who, without the registrant's consent,

use[s] in commerce any reproduction, counterfeit, copy, or colorable imitation of a registered mark in connection with the sale, offering for sale, distribution, or advertising of any goods or services on or in connection with which such use is likely to cause confusion, or to cause mistake, or to deceive.

15 U.S.C. § 1114(a)(1). Section 43(a)(1) of the Lanham Act creates similar liability for the

use[] in commerce [of] any word, term, name, symbol, or device, or any combination thereof, or any false designation of origin, or misleading description of fact, or false or misleading representation of fact, which . . . is likely to cause confusion, or to cause mistake, or to deceive as to the affiliation,

connection, or association of such person with another person, or as to the origin, sponsorship, or approval of his or her goods, services, or commercial activities by another person.

15 U.S.C. § 1125(a)(1).

The Lanham Act defines “use in commerce” of a mark to mean [the mark] is placed in any manner on the goods or their containers or the displays associated therewith or on the tags or labels affixed thereto, or if the nature of the goods makes such placement impracticable, then on documents associated with the goods or their sale.

Id. Thus, “[a] plaintiff is not required to demonstrate that a defendant made use of the mark in any particular way to satisfy the ‘use in commerce’ requirement.” Kelly-Brown v. Winfrey, 717 F.3d 295, 305 (2d Cir. 2013). For the reasons that follow, Tory Burch is entitled to summary judgment as to Defendants’ liability for trademark infringement of Tory Burch’s TT Logo.<sup>5</sup>

**A. Entitled to Protection**

A mark’s registration with the PTO creates a presumption that the mark is valid and entitled to protection; a registered mark becomes “incontestable” after five years of continuous use, barring many defenses to alleged infringement. 15 U.S.C. § 1115(b); Wal-Mart Stores, Inc. v. Samara Bros., Inc., 529 U.S. 205, 209 (2000) (citing 15 U.S.C. §§ 1057(b), 1065). To be

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<sup>5</sup> While Tory Burch argues, in its memorandum of law, that Defendants are liable for counterfeiting the “Tory Burch” word mark in addition to the TT Logo, Tory Burch limits its infringement argument to the TT Logo.

entitled to protection, a mark must be "distinctive" rather than "generic," Louboutin, 696 F.3d at 216 (citation omitted), such that the mark is "capable of distinguishing the products it marks from those of others." Lane Capital Mgmt., Inc. v. Lane Capital Mgmt., Inc., 192 F.3d 337, 344 (2d Cir. 1999). A mark is "inherently distinctive if its intrinsic nature serves to identify a particular source." Louboutin, 696 F.3d at 216 (citation omitted).

"[S]tylized shapes or letters may qualify [as inherently distinctive], provided the design is not commonplace but rather unique or unusual in the relevant market." Star Indus., Inc. v. Bacardi & Co. Ltd., 412 F.3d 373, 382 (2d Cir. 2005). "The guiding principle in distinguishing protectable from unprotectable marks is that no one enterprise may be allowed to attain a monopoly on designs that its competitors must be able to use in order to effectively communicate information regarding their products to consumers." Id. In judging inherent distinctiveness, courts classify marks, in ascending order of distinctiveness, as "(1) generic; (2) descriptive; (3) suggestive; or (4) arbitrary or fanciful." Id. at 384-85 (citation omitted).

If a mark is not inherently distinctive, it may still "acquire distinctiveness by developing secondary meaning in the public mind." Louboutin, 696 F.3d at 216 (citation omitted).

"A mark has acquired secondary meaning when, in the minds of the public, the primary significance of a product feature is to identify the source of the product rather than the product itself." Id. (citation omitted). "The crucial question in a case involving secondary meaning always is whether the public is moved in any degree to buy an article because of its source." Id. at 226 (citation omitted). Relevant factors in determining secondary meaning include "(1) advertising expenditures, (2) consumer studies linking the mark to a source, (3) unsolicited media coverage of the product, (4) sales success, (5) attempts to plagiarize the mark, and, (6) length and exclusivity of the mark's use." Id. (citation omitted). Although distinctiveness is "an inherently factual inquiry . . . [where] the record contains sufficient undisputed facts to resolve the question of distinctiveness . . . [a court] may do so as a matter of law." Id.

Here, the TT Logo and Bare TT Logo are entitled to a presumption of protection, as they have been registered with the PTO in connection with jewelry. In addition, the TT Logo Trademark has become incontestable. And there is insufficient evidence in the record to permit any reasonable fact-finder to rebut this presumption.

Even in the absence of any presumption, the evidence establishes that the TT Logo<sup>6</sup> is entitled to protection, as there can be no dispute that the public is “moved in [some] degree to buy [Tory Burch products bearing the logo] because of [their] source.” Id. (citation omitted). Tory Burch has produced a consumer survey linking its logo to its brand; unsolicited media coverage noting the logo has become an “iconic” identifier of Tory Burch products; substantial sales success since the brand’s introduction in 2003; attempts to plagiarize the mark (at issue here); and more than ten years of exclusive use of the mark, apart from purported counterfeiters. Accordingly, the TT Logo has acquired secondary meaning.<sup>7</sup>

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<sup>6</sup> Because, as explained below, Tory Burch has established a likelihood of confusion between the Accused Products and the TT Logo, the Court need not separately consider the Bare TT Logo.

<sup>7</sup> Under the “aesthetic functionality doctrine,” “where an ornamental feature is claimed as a trademark and trademark protection would significantly hinder competition by limiting the range of adequate alternative designs,” no protection will be granted. Louboutin, 696 F.3d at 222 (citation omitted). “[C]ourts must carefully weigh the competitive benefits of protecting the source-identifying aspects of a mark against the competitive costs of precluding competitors from using the feature.” Id. (citation omitted). Defendants have never alleged or argued that the TT Logo is functional and therefore ineligible for protection. To the contrary, Defendants’ own Trademark Counterclaim alleged a protectable interest in the Isis Cross Design in connection with the Accused Products. In any case, no reasonable jury could find, on this record, that protecting the TT Logo would “significantly hinder competition by limiting the range of adequate alternative designs” in jewelry.

**B. Likelihood of Confusion**

Second, Tory Burch must establish "a probability of confusion, not a mere possibility," caused by the Accused Products, "affecting numerous ordinary prudent" persons. Star, 412 F.3d at 383 (citation omitted). Confusion giving rise to a claim of trademark infringement includes confusion as to "source, sponsorship, affiliation, connection, or identification." Id. (citation omitted). A plaintiff may show either "direct confusion" -- "a likelihood that consumers will believe that the [plaintiff] trademark owner sponsors or endorses the use of the challenged mark" -- or "reverse confusion" -- a likelihood that consumers "will believe that the [the owner of the challenged mark] is the source of [plaintiff's own] goods." Kelly-Brown, 717 F.3d at 304 (citation omitted).

This confusion need not occur at the point of sale; the Lanham Act also protects against "initial interest confusion" and "post-sale confusion." Malletier v. Burlington Coat Factory Warehouse Corp., 426 F.3d 532, 539 n.2 (2d Cir. 2005). Post-sale confusion may occur "when a manufacturer of knockoff goods offers consumers a cheap knockoff copy of the original manufacturer's more expensive product, thus allowing a buyer to acquire the prestige of owning what appears to be the more expensive product." Hermes Int'l v. Lederer de Paris Fifth Ave., Inc., 219 F.3d 104, 108 (2d Cir. 2000). In this context,

purchasers of the knockoff may “confus[e] the viewing public and achiev[e] the status of owning the genuine article at a knockoff price.” Id. at 109.

To determine whether there is a likelihood of confusion, courts look to the eight factors set out by Judge Friendly in Polaroid Corp. v. Polarad Elecs. Corp., 287 F.2d 492 (2d Cir. 1961):

- (1) strength of the trademark;
- (2) similarity of the marks;
- (3) proximity of the products and their competitiveness with one another;
- (4) evidence that the senior user may ‘bridge the gap’ by developing a product for sale in the market of the alleged infringer’s product;
- (5) evidence of actual consumer confusion;
- (6) evidence that the imitative mark was adopted in bad faith;
- (7) respective quality of the products; and
- (8) sophistication of consumers in the relevant market.

Kelly-Brown, 717 F.3d at 307 (citation omitted). Courts’ application of these factors is not to be “mechanical, but rather, [should] focus[] on the ultimate question of whether, looking at the products in their totality, consumers are likely to be confused” in the context (e.g., post-sale) alleged by plaintiff. Id. (citation omitted); see Burlington, 426 F.3d at 539 n.2. “Where the predicate facts are beyond dispute, the proper balancing of these factors is considered a question of

law.” Playtex Prods., Inc. v. Georgia-Pac. Corp., 390 F.3d 158, 162 (2d Cir. 2004), abrogated in unrelated part as recognized by Starbucks Corp. v. Wolfe’s Borough Coffee, Inc., 588 F.3d 97, 107 (2d Cir. 2009).

Here, even after finding all disputed facts in Defendants’ favor and drawing all reasonable inferences in their favor, the likelihood of confusion is clear. The Polaroid factors are discussed, in turn, below.

#### **1. Strength of the Mark**

The first factor, the strength of the mark, favors Tory Burch. The strength of the trademark is the mark’s “tendency to uniquely identify the source of the product,” and a mark is “strong to the extent that the mark is distinctive, either inherently or by virtue of having acquired secondary meaning.” Star, 412 F.3d at 384.

As indicated in the above analysis of distinctiveness, the TT Logo is a strong mark. The TT Logo is, itself, a very distinctive design. It is composed of an extremely stylized letter “T,” flipped and set atop an identical letter “T.” And as explained above, the factors relevant to a finding of secondary meaning clearly establish such meaning here. Indeed, in the last two years, Forbes has referred to the TT Logo as “iconic” and “distinctive” and the Wall Street Journal has noted the TT Logo is “as instantly recognized as those of brands

established generations prior.” Defendants’ own Trademark Counterclaim alleges that the TT Logo is so distinctive as an identifier of Tory Burch products that “customers, the public and the trade [are likely to] believ[e] that Lin & J has infringed on . . . Tory Burch’s trademark.” The TT Logo is a paradigmatic example of a design with strong secondary meaning. Accordingly, the TT Logo is a strong mark and this factor favors Tory Burch.

## **2. Similarity of the Marks**

The second factor, similarity of the marks, strongly favors Tory Burch. “[T]he law requires only confusing similarity, not identity.” Louis Vuitton Malletier v. Dooney & Bourke, Inc., 454 F.3d 108, 117 (2d Cir. 2006). While side-by-side comparison of the marks “may be a useful heuristic means of identifying the similarities and differences between two products,” courts are to “focus on actual market conditions and the type of confusion alleged.” Burlington, 426 F.3d at 534. Where, as here, plaintiff claims post-sale confusion, “market conditions must be examined closely to see whether the differences between the marks are likely to be memorable enough to dispel confusion on serial viewing.” Dooney, 454 F.3d at 117 (citation omitted). Courts are to look to “the mark’s overall impression on a consumer, considering the context in which the marks are displayed and the totality of factors that could cause confusion

among prospective purchasers.” Burlington, 426 F.3d at 537 (citation omitted).

Here, Defendants’ Predecessor Design and Isis Cross Design are quite similar to the TT Logo. As seen below, all three create the impression of a cross, with an internal division and certain stylistic embellishments along the stems and at the points.



From left to right: Tory Burch’s TT Logo, Lin & J’s Predecessor Design, and Lin & J’s Isis Cross.

Especially in the post-sale context, where many members of the public will not be able to compare the Accused Products to genuine Tory Burch products, or even to do more than glance at the Accused Products, these three designs give the same overall impression and are quite likely to cause confusion as to the source of the Accused Products. The vertical internal division present in the Lin & J designs but not the TT Logo is also unlikely “to be memorable enough to dispel confusion on serial viewing,” given that by 2009 -- more than two years before Lin & J’s unchanged invoices show use of either of its designs -- Tory Burch was using the Split TT Logo (the TT Logo with a vertical

internal division as well as horizontal one) on jewelry. Accordingly, the many members of the public familiar with the Tory Burch brand are less likely to make particular note of the vertical internal division, since that is also associated with the Tory Burch brand. And although a close side-by-side comparison reveals that the Isis Cross Design's embellishments include curls, that design retains the Predecessor Design's -- and the TT Logo's -- short barbs along the stem of the "T." Again, the overall impression is one of striking similarity likely to cause confusion in the post-sale context.

Moreover, it is important to note that the Accused Products resemble Tory Burch jewelry not just in these designs, but also in other features of the product. As noted above, certain jewelry among the Accused Products are otherwise designed to closely resemble genuine Tory Burch products. This increases the likelihood of confusion in the post-sale context, as the similarity among the TT Logo and Predecessor Design or Isis Cross Design is reinforced by similarities throughout the rest of the jewelry.

Tory Burch's survey confirms this, finding that a similar proportion of respondents identified Tory Burch as the source of both Tory Burch products and the Accused Products: 26% of respondents identified Tory Burch as the source of Tory Burch products, compared to 31% who identified Tory Burch as the

source of Accused Products with the Isis Cross Design and 25% of respondents who did the same for Accused Products bearing the Predecessor Design.

### **3. Proximity of the Products**

The third factor, the proximity of the products and their competitiveness with one another, also favors Tory Burch.<sup>8</sup> Tory Burch's products, like the Accused Products, are relatively affordable fashion jewelry. While the Accused Products often retail for less than Tory Burch products, sometimes they retail for similar prices. In some stores, the Accused Products were sold alongside Tory Burch products. As explained above, members of the public are quite likely to mistake the Accused Products for genuine Tory Burch products. This creates an incentive for purchasers of the Accused Products to "confus[e] the viewing public and achiev[e] the status of owning the genuine [Tory Burch] article at a [somewhat lower] price." Hermes, 219 F.3d at 109. And Tory Burch has produced an expert report showing substantial lost profits as a result of Defendants' sales of the Accused Products. On this record, any reasonable jury would find that these products directly compete with one another.

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<sup>8</sup> Tory Burch argues that this factor is irrelevant in the post-sale context, but does not explain why competitive proximity would not increase the likelihood of confusion. If the TT Logo and the Isis Cross Design or Predecessor Design were affixed to very different products, the likelihood of confusion would be diminished.

**4. "Bridge the Gap"**

The fourth factor, whether the senior user will "bridge the gap" by inserting a product into the alleged infringer's market, is "irrelevant" here, because the products "are already in competitive proximity" and thus "there is really no gap to bridge." Star, 412 F.3d at 387.

**5. Evidence of Actual Consumer Confusion**

The fifth factor, actual consumer confusion, strongly favors Tory Burch. Tory Burch's survey shows that a similar proportion of respondents identified Tory Burch as the source of both Tory Burch products and the Accused Products. In fact, a greater proportion of respondents erroneously identified the Accused Products bearing the Isis Cross Design as Tory Burch products (31%) than identified actual Tory Burch products as genuine (26%). The record includes no other survey. In addition, U.S. Customs agents, as well as New York City Peddler Task Force officers, seized some of the Accused Products believing them to be counterfeits of Tory Burch products. Accordingly, this factor strongly favors Tory Burch.

**6. Bad Faith**

The sixth factor, evidence that the imitative mark was adopted in bad faith, strongly favors Tory Burch as well. "Bad faith generally refers to an attempt by a junior user of a mark to exploit the good will and reputation of a

senior user by adopting the mark with the intent to sow confusion between the two companies' products." Star, 412 F.3d at 388. Such was the case here.

Here, the only reliable invoices produced by Defendants show that the Accused Products were first sold on December 22, 2011, while Tory Burch products were first sold in 2004 and became extremely popular in the following years. Cf. Star, 412 F.3d at 389 ("Bad faith may be inferred from the junior user's actual or constructive knowledge of the senior user's mark.") In an attempt to show that the Isis Cross Design had been used as a trademark prior to late 2011, Defendants fabricated the False Collection Books for the years 2009, 2010, 2011, and 2012 in August 2013. They presented the 2009 False Collection Book to the PTO, and each of the False Collection Books to Tory Burch in this action. Defendants also substantively altered invoices produced to Tory Burch to backdate their use of the Predecessor Design and Isis Cross Design.

In addition to Defendants' spoliation and fabrication of evidence to support Defendants' Trademark Counterclaim alleging that the Predecessor Design and Isis Cross Design were original -- which Defendants chose to voluntarily dismiss after Tory Burch filed its motion for sanctions --

Defendants marketed the Accused Products as Tory Burch knockoffs. Defendants themselves used the phrase "Tory Burch Style" to refer to one of the Accused Products in invoices to retailers; hundreds of these retailers then marketed the Accused Products with reference to "Tory Burch," "Tory," or "T.B." When Defendants learned that their customer Sam Mi had been contacted by Tory Burch, they did not contend that the Predecessor Design or Isis Cross Design did not infringe Tory Burch's intellectual property rights -- instead, Defendants falsified invoices for Sam Mi to hide the extent of Sam Mi's sale of Accused Products bearing the Isis Cross Design. The evidence of Defendants' bad faith is overwhelming, and is not rebutted by other record evidence. Accordingly, this factor strongly favors Tory Burch.

#### **7. Quality of the Products**

The seventh factor, the respective quality of the products, is neutral. According to Defendants' expert, Keegan, the Accused Products are inferior to genuine Tory Burch products; Tory Burch disputes this, noting that Defendants have represented that the Accused Products are "high quality." Should a jury find the quality inferior, this may "tarnish[] [Tory Burch]'s reputation if consumers confuse the two."

Morningside Grp. Ltd. v. Morningside Capital Grp., LLC, 182 F.3d

133, 142 (2d Cir. 1999). In the post-sale context, where many members of the general public will not be able to touch and closely examine the Accused Products, it appears unlikely that the persons confused would register any inferior quality. To the extent they did, this would also decrease the likelihood of confusion, to the extent they also knew genuine Tory Burch products were of higher quality. Should a jury find the quality similar, this would slightly increase the likelihood of confusion, but remove the threat that Tory Burch's brand would be tarnished by inferior quality. Either way, this factor has a very limited impact on the likelihood of confusion.

#### **8. Sophistication of Consumers**

The final factor, sophistication of consumers, somewhat favors Defendants. An analysis of consumer sophistication "considers the general impression of the ordinary purchaser, buying under the normally prevalent conditions of the market and giving the attention such purchasers usually give in buying that class of goods." Star, 412 F.3d at 390 (citation omitted). Where, as here, a plaintiff alleges post-sale confusion, the sophistication of the general public taking note of these products should be considered. There is limited evidence in the record about the sophistication of members of the public likely to take note of those products. The Tory Burch Survey indicates that between one-fourth and one-third of women between the ages

of 21 and 59 who read at least one fashion magazine or fashion blog on a "regular basis" recognized the Tory Burch brand. This suggests that those in the public who might be confused about the source of the Accused Products are somewhat sophisticated, as they are more knowledgeable about fashion than between three-quarters and two-thirds of woman who read a fashion publication regularly.

Yet here, that same survey shows that nearly all of those women who might confuse the Accused Products for Tory Burch products would, in fact, do so, given that respondents who said they had "heard of Tory Burch" identified the Accused Products and authentic Tory Burch jewelry as Tory Burch products at approximately the same rate: 57% for Tory Burch products; 53% for the Isis Cross Design; and 51% for the Predecessor Design. "[W]hen, as here, there is a high degree of similarity between the parties' [products] and marks, the sophistication of the buyers cannot be relied on to prevent confusion." Morningside, 182 F.3d at 143 (citation omitted). This is especially true where plaintiff has "presented evidence of actual confusion" among the target consumers. Id. Here, sophistication did not reduce the likelihood of confusion. Accordingly, sophistication of consumers favors Defendants only very slightly or is neutral.

Of the eight Polaroid factors, five favor Tory Burch, one may very slightly favor Defendants, one is neutral, and one is

irrelevant. Of the five that favor Tory Burch, three of the most important factors -- the similarity of the marks, actual consumer confusion, and bad faith -- each strongly favored Tory Burch. See Burlington, 426 F.3d at 537 ("Of salient importance among the Polaroid factors is the 'similarity of the marks' test."); Savin Corp. v. Savin Grp., 391 F.3d 439, 459 (2d Cir. 2004) ("There can be no more positive or substantial proof of the likelihood of confusion than proof of actual confusion.") (citation omitted). Defendants themselves alleged a likelihood of confusion in their Trademark Counterclaim, and Kim maintained at her deposition that confusion was likely. It is clear, as a matter of law, that a substantial likelihood of confusion exists here. Accordingly, Tory Burch is entitled to summary judgment with respect to each of the Lin & J entities' liability on Tory Burch's trademark infringement claim.

### **III. Counterfeiting Claim**

#### **A. TT Logo**

Tory Burch also alleges that Defendants have engaged in trademark counterfeiting in violation of Section 32 of the Lanham Act, 15 U.S.C. § 1114. The Lanham Act defines "counterfeit" as "a spurious mark which is identical with, or substantially indistinguishable from, a registered mark." 15 U.S.C. § 1127. The TT Logo is registered via the TT Logo Trademark. To determine whether the accused mark is

"substantially indistinguishable from" the registered mark, courts are to consider consumers' experience with the marks. See Kelly-Brown, 717 F.3d at 314-15. Even from the perspective of a potential purchaser, the Predecessor Design and Isis Cross Design are "substantially indistinguishable" from the TT Logo. As noted above, even a side-by-side comparison reveals few differences. The largest difference is that Defendants' marks include a vertical division where the TT Logo as registered does not; but, pre-dating those marks, Tory Burch used a variation of the registered TT Logo, the Split TT Logo, in certain jewelry, and this variation included the same vertical division. Cf. Montres Rolex, S.A. v. Snyder, 718 F.2d 524, 532 (2d Cir. 1983) (holding, in the context of federal law prohibiting the importation of counterfeit goods as defined by the Lanham Act, that a mark is a "counterfeit" if it mimics the registered mark as it appears on actual merchandise, rather than as it appears on the registration certificate, noting that "counterfeiters copy actual merchandise, not registration certificates"). The Tory Burch Survey confirms that consumers found Lin & J's designs to be "substantially indistinguishable" from the TT Logo, as they identified the Accused Products as genuine Tory Burch products at approximately the same rate they correctly identified authentic Tory Burch jewelry. Likewise, the U.S. Customs agents and New York City Police Department Peddler Task

Force officers seized some of the Accused Products, unprompted, believing them to be Tory Burch counterfeits.

Moreover, the record evidence demands of any reasonable fact-finder the inference that Defendants were intentionally counterfeiting Tory Burch products. Defendants sold at least one of the Accused Products as "Tory Burch Style," and hundreds of Defendants' retailers marketed the Accused Products as "Tory Burch" products. Defendants subsequently falsified invoices and fabricated evidence of prior use of these marks. As noted above, many of the Accused Products appear nearly identical to genuine Tory Burch products in all respects -- not just the challenged marks. Defendants' clear intent to create counterfeit Tory Burch products confirms the conclusion that Lin & J's marks are "substantially indistinguishable" from the TT Logo.

Counterfeit marks are inherently confusing, and thus it is not clear that a distinct likelihood-of-confusion analysis is required for a counterfeit claim. See, e.g., Coach, Inc. v. Zhen Zhen Weng, 13cv445, 2014 WL 2604032, at \*13 (S.D.N.Y. June 9, 2014). Regardless, as the same Accused Products are at issue in both the trademark infringement and counterfeiting claims, the analysis above has equal force with respect to the counterfeiting claim. Accordingly, Tory Burch is entitled to

summary judgment as to each Lin & J entities' liability for counterfeiting the TT Logo.

**B. "Tory Burch" Word Mark**

Tory Burch also alleges that Defendants are liable under Section 32 of the Lanham Act for counterfeiting the "Tory Burch" word mark. The only evidence Tory Burch cites is Defendants' description of one of the Accused Products as "Tory Burch Style Stretch Ring" in invoices to customers. This description is not "identical with, or substantially indistinguishable from," the "Tory Burch" word mark used to brand authentic Tory Burch jewelry. It does not indicate that the ring is a genuine Tory Burch ring; rather, it plainly suggests it is a knockoff, made to look similar to an authentic Tory Burch ring. Accordingly, Tory Burch is not entitled to summary judgment on its claim for counterfeiting the "Tory Burch" word mark.

**IV. Defendant Kim's Personal Liability**

"To be liable for contributory trademark infringement, a defendant must have (1) intentionally induced the primary infringer to infringe, or (2) continued to supply an infringing product to an infringer with knowledge that the infringer is mislabeling the particular product supplied." Kelly-Brown, 717 F.3d at 314 (citation omitted). These principles apply in the same manner to trademark counterfeiting. Here, Kim authorized, directed, and was the moving force behind the design,

manufacture, marketing, and sale of the Accused Products. Accordingly, under the first prong of this test, Tory Burch is also entitled to summary judgment with respect to Kim's liability for trademark infringement and counterfeiting the TT Logo.

**CONCLUSION**

Tory Burch's September 10, 2014 motion for summary judgment as to Defendants' liability for trademark infringement and counterfeiting is granted, except as to liability for counterfeiting the "Tory Burch" word mark.

SO ORDERED:

Dated: New York, New York  
December 4, 2014

  
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DENISE COTE  
United States District Judge