

**UNITED STATES DISTRICT COURT
SOUTHERN DISTRICT OF NEW YORK**

_____	:	
MARIO VALENTINO S.P.A.,	:	
	:	
Plaintiff,	:	
	:	
v.	:	1:22 CV 8984
	:	
FASHIONPHILE GROUP, LLC,	:	JURY TRIAL DEMANDED
	:	
Defendant.	:	
_____	:	

**COMPLAINT FOR TRADEMARK INFRINGEMENT,
FALSE ADVERTISING AND UNFAIR COMPETITION**

Plaintiff Mario Valentino S.p.A. (“Mario Valentino”, “MV” or “Plaintiff”) alleges the following for its claims against Defendant Fashionphile Group, LLC (“Fashionphile” or “Defendant”).

Jurisdiction and Venue

1. This Court has personal jurisdiction over Defendant as Fashionphile maintains a permanent place of business in the Southern District of New York (“Judicial District”) and/or regularly ships goods from this Judicial District, and/or regularly solicits business and ships goods to consumers located in this Judicial District.

2. Additionally, Defendant maintains a permanent location to “authenticate” items, as well as to display items for sale in a “showroom” to prospective consumers in this Judicial District at 601 West 26th Street, Suite 400B, Floor 4, New York, NY 10001. (See Exhibit 1).

3. Defendant also regularly and systematically advertises, markets and promotes goods in an infringing manner to prospective consumers in this Judicial District. Id.

4. Therefore, Defendant has purposefully availed itself of doing business in New York and this Judicial District.

5. This Court has jurisdiction over the subject matter of this action pursuant to Section 39 of the Lanham Act, 15 U.S.C. § 1121, 28 U.S.C. §§ 1331 and 1338(a) for the claims arising out of the violations of Sections 32 and Section 43 of the Lanham Act, has supplemental jurisdiction pursuant to 28 U.S.C. § 1367 for the claims arising out of the violation of Sections 349, 350, and 360-1 of the New York Business Law, and all other claims arising under the common law of the State of New York; and has jurisdiction pursuant to 28 U.S.C. §§ 1338(b) and 1367 for the claims under the common law of unfair competition.

6. Venue is proper in this district pursuant to: (i) 28 U.S.C. § 1391(b)(2) because a substantial part of the events or omissions giving rise to the claims occurred in this district, and (ii) 28 U.S.C. § 1391(b)(3) because Defendant is subject to personal jurisdiction in this district.

Parties

7. MV is an Italian joint stock company with its principal place of business in Naples, Italy, Europe.

8. On information and belief, Defendant is a Delaware limited liability company formed on or about February 21, 2019 with a permanent place of business in this Judicial District.

Factual Background

Mario Valentino

9. Mario Valentino is the first and senior owner of the registrations of the VALENTINO family of trademarks on leather handbags and similar goods in the United States.

10. Mario Valentino was founded in the 1950s by a shoemaker of the same name.

11. MV subsequently expanded into other leather goods, including handbags.

12. Mr. Mario Valentino, himself a famous designer whose name and reputation have been celebrated for decades and whose brand and fine leather goods have been associated with the likes of Karl Lagerfeld, Giorgio Armani and Jacqueline Onassis, founded the Mario Valentino business in Italy in 1952, well before Defendant launched its business.

13. Attached to this Complaint as Exhibit 2 is one of MV's U.S. Trademark Registrations ("MV Trademark"): U.S. Trademark Reg. No. 951,621, registered on January 30, 1973 for "VALENTINO" in International Class 18 for "handbags and luggage."

Facts

14. In May 2022, MV discovered that products offered for sale on the website <http://www.fashionphile.com> apparently owned and/or operated by Fashionphile were being advertised using MV's Trademark in a manner that is not authorized to promote goods that were neither manufactured by, purchased from or authorized by Mario Valentino (or its exclusive licensee) in the United States.

15. Fashionphile was informed in a cease and desist letter sent by counsel for Mario Valentino that its unauthorized use of the MV Trademark on or in connection with the advertising and sale of unauthorized goods in this manner constitutes the infringing use of Mario Valentino's registered marks in commerce.

16. Mario Valentino demanded that Fashionphile immediately cease and desist selling these goods in this manner; and within seven (7) days of that letter provide to Mario Valentino the total number of items and gross sales of goods sold using this manner of advertising; the date(s) that such advertising and sales began; the date(s) that such advertising and sales ceased; and any instructions given to it by anyone regarding these advertisements. Fashionphile did not comply with Mario Valentino's demands

17. Despite follow-up cease and desist letters, and despite Fashionphile continuing to represent that it would comply with Mario Valentino's demands, it has not done so..

18. Fashionphile's website still displays hundreds of the infringements of Mario Valentino's Trademark that MV brought to Fashionphile's attention at the end of May 2022.

19. Furthermore, to this day, MV has not received any of the information demanded from Fashionphile.

20. Fashionphile was most recently warned by MV that:

Once litigation is commenced, in addition to being entitled to all this information in discovery as well as injunctive relief, Mario Valentino will not agree to resolve this dispute without payment of monetary compensation for all past and present infringement, as well as its attorneys' fees, costs and expenses.

21. No further response has been forthcoming from Fashionphile since August 24, 2022.

22. As of today, nearly four hundred (400) women's handbags and clutches are advertised on Fashionphile's website as "VALENTINO" at prices ranging from \$200 to \$2,800. (See Exhibit 3).

FIRST CLAIM FOR RELIEF

**Federal Trademark Infringement
In Violation of Section 32 of the Lanham Act**

(15 U.S.C. § 1114)

23. All previous paragraphs are incorporated by reference as if fully set forth herein.

24. MV hereby repeats each and every allegation set forth above as it fully set forth herein.

25. Section 32(1)(a) of the Lanham Act, 15 U.S.C. § 1114(1)(a), prohibits any person from using in commerce, without the consent of the registrant:

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 . . .

26. The MV Trademark is federally registered and is incontestable.

27. MV's Trademark is distinctive and are associated in the mind of the public with MV.

28. Additionally, based on MV's extensive advertising, sales, and the popularity of its respective products, the MV Trademark has acquired secondary distinctiveness so that the public associates this trademark with MV.

29. Defendant has used unauthorized reproductions of the MV Trademark in connection with the advertising, sale, offering for sale and/or distribution of goods for its own financial gain.

30. MV has not authorized Defendant's use of the MV Trademark in this manner.

31. Defendant's unauthorized use of the MV Trademark on or in connection with the advertising, marketing and sale of goods constitutes the infringing use of the MV Trademark in commerce.

32. Defendant's conduct has caused substantial and irreparable injury to the public, MV, the MV Trademark, and the substantial goodwill represented thereby.

33. Accordingly, as complained of herein, Defendant has engaged in trademark infringement in violation of 15 U.S.C. § 1114.

34. Defendant's acts have caused, and will continue to cause, irreparable injury to MV.

35. MV has no adequate remedy at law and is thus entitled to damages in an amount yet to be determined.

36. Defendant's conduct in continuing to advertise and sell merchandise using the unauthorized MV Trademark is willful and intentional, and thus this constitutes an exceptional case.

SECOND CLAIM FOR RELIEF

False Association

15 U.S.C. § 1125 (a) (1) (A)

37. All previous paragraphs are incorporated by reference as if fully set forth herein.

38. MV hereby repeats each and every allegation set forth above as it fully set forth herein.

39. Section 43(a) of the Lanham Act, 15 U.S.C. § 1125(a)(1)(A) provides, in relevant part, that:

Any person who, on or in connection with any goods or services, or any container for goods, uses in commerce any word, term, name, symbol, or device, or any combination thereof, or any false designation of origin, false or misleading description of fact, or false or misleading representation of fact, which—(1)(a) 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 . . . shall be liable in a civil action by any person who believes that he or she is or is likely to be damaged by such act.

40. By making unauthorized use, in interstate commerce, of MV's Trademark and/or MV's common law rights therein, Defendant has used a false designation of origin that is likely to cause confusion, mistake or deception as to the affiliation or connection of Defendant with MV and as to the origin, sponsorship, association or approval of Defendant's goods by MV, in violation of Section 43(a) of the Lanham Act, 15 U.S.C. § 1125(a)(1)(A).

41. Defendant's acts constitute the use in commerce of false designations of origin and false and/or misleading descriptions or representations, tending to falsely or misleadingly describe

and/or represent Defendant's products as those of MV in violation of Section 43(a) of the Lanham Act, 15 U.S.C. § 1125(a)(1)(A).

42. Accordingly, as complained of herein, Defendant has engaged in false association in violation of 15 U.S.C. § 1125(a)(1)(A).

43. Defendant's wrongful acts will continue unless and until enjoined by this Court.

44. Defendant's acts have caused and will continue to cause irreparable injury to MV.

45. MV has no adequate remedy at law and is thus damaged in an amount yet to be determined.

THIRD CLAIM FOR RELIEF

False Advertising

15 U.S.C. § 1125 (a) (1) (B)

46. All previous paragraphs are incorporated by reference as if fully set forth herein.

47. MV hereby repeats each and every allegation set forth above as it fully set forth herein.

48. Section 43(a) of the Lanham Act, 15 U.S.C. § 1125(a)(1)(B) provides, in relevant part, that:

Any person who, on or in connection with any goods or services, or any container for goods, uses in commerce any word, term, name, symbol, or device, or any combination thereof, or any false designation of origin, false or misleading description of fact, or false or misleading representation of fact, which—(1)(b) in commercial advertising or promotion, misrepresents the nature, characteristics, qualities, or geographic origin of his or her or another person's goods, services, or commercial activities shall be liable in a civil action by any person who believes that he or she is or is likely to be damaged by such act.

49. By making unauthorized use, in interstate commerce, of MV's Trademark and/or MV's common law rights therein, Defendant has used a false designation of origin that is likely to cause confusion, mistake or deception as to the affiliation or connection of Defendant with MV

and as to the origin, sponsorship, association or approval of Defendant's goods by MV, in violation of Section 43(a) of the Lanham Act, 15 U.S.C. § 1125(a)(1)(B).

50. Defendant's acts constitute the use in commerce of false designations of origin and false and/or misleading descriptions or representations, tending to falsely or misleadingly describe and/or represent Defendant's products as those of MV in violation of Section 43(a) of the Lanham Act, 15 U.S.C. § 1125(a)(1)(B).

51. Accordingly, by the conduct complained of herein, Defendant has engaged in false advertising in violation of 15 U.S.C. § 1125(a)(1)(B).

52. Defendant's wrongful acts will continue unless and until enjoined by this Court.

53. Defendant's acts have caused and will continue to cause irreparable injury to MV.

54. MV has no adequate remedy at law and is thus damaged in an amount yet to be determined.

FOURTH CLAIM FOR RELIEF

Deceptive Acts and Practices Unlawful In Violation of the New York General Business Law

(N.Y. Gen. Bus. Law §§ 349 and 350)

55. All previous paragraphs are incorporated by reference as if fully set forth herein.

56. MV hereby repeats each and every allegation set forth above as it fully set forth herein.

57. New York General Business Law, Section 349 states, in relevant part, that: "Deceptive acts or practices in the conduct of any business, trade or commerce or in the furnishing of any service in this state are hereby declared unlawful."

58. New York General Business Law, Section 350 states, in relevant part, that: "False advertising in the conduct of any business, trade or commerce or in the furnishing of any service in this state is hereby declared unlawful."

59. Through the importation, advertisement, distribution, offer to sell and sale of unauthorized products using the MV Trademark, Defendant has engaged in consumer-oriented conduct that has affected the public interest of New York and has resulted in injury to consumers in New York.

60. Defendant's deceptive acts or practices, as described herein, are materially misleading. Such acts or practices have deceived or have a tendency to deceive a material segment of the public to whom Defendant has directed their marketing activities, and MV has been injured thereby.

61. By the acts described above, Defendant has willfully engaged in deceptive acts or practices in the conduct of business and furnishing of services in violation of Section 349 and 350 of the New York General Business Law.

62. Defendant's acts have caused, and will continue to cause, irreparable injury to MV. MV has no adequate remedy at law and is thus damaged in an amount not yet determined.

FIFTH CLAIM FOR RELIEF

Trademark Infringement In Violation of New York State Common Law

63. All previous paragraphs are incorporated by reference as if fully set forth herein.

64. MV hereby repeats each and every allegation set forth above as it fully set forth herein.

65. Plaintiff owns all right, title and interest in and to the MV Trademark as described above, including all common law rights in the MV Trademark.

66. Defendant's use of the MV Trademark is unauthorized, and is likely to cause consumer confusion.

67. By the acts described above, Defendant has engaged in trademark infringement in violation of the common law of the State of New York.

68. Defendant's acts have caused, and will continue to cause, irreparable injury to MV. MV has no adequate remedy at law and is thus damaged in an amount not yet determined.

SIXTH CLAIM FOR RELIEF

Unfair Competition In Violation of the New York Common Law

69. All previous paragraphs are incorporated by reference as if fully set forth herein. .

70. Defendant has palmed off their goods as MV's, improperly trading upon the Plaintiff's goodwill and valuable rights in and to the MV Trademark.

71. Defendant has committed the above alleged acts willfully, and in conscious disregard of MV's rights, and MV is therefore entitled to exemplary and punitive damages pursuant to the common law of the State of New York in an amount sufficient to punish, deter and make an example of Defendant.

72. By the acts described above, Defendant has engaged in unfair competition in violation of the common law of the State of New York.

73. Defendant's acts have caused and will continue to cause irreparable injury to MV. MV has no adequate remedy at law and is thus damaged in an amount yet to be determined.

PRAYER FOR RELIEF

WHEREFORE, MV prays for judgment as follows:

1. For a FINAL JUDGMENT that:
 - a. Defendant has engaged in trademark infringement in violation of Section 32 of the Lanham Act, 15 U.S.C. § 1114;
 - b. Defendant has violated Section 43(a) of the Lanham Act, 15 U.S.C. § 1125(a);
 - c. Defendant has caused injury to MV's business reputation in violation of Section 360-1 of the New York General Business Law;

- d. Defendant has engaged in deceptive acts and practices unlawful in violation of Sections 349 and 350 of the New York General Business Law;
 - e. Defendant has engaged in trademark infringement in violation of the common law of the State of New York;
 - f. Defendant has engaged in unfair competition in violation of the common law of the State of New York.
 - g. That the above acts were done willfully, and/or intentionally.
2. For entry of an **ORDER** permanently enjoining and restraining Defendant, and its officers, agents, servants, employees and attorneys and all those in active concert or participation with any of them, from
- a. Using any reproduction, counterfeit, copy or colorable imitation of the MV Trademark (as defined herein) for and in connection with any goods or their packaging not authorized by MV;
 - b. Engaging in any course of conduct likely to cause confusion, deception or mistake, or to injure MV's business reputation or the MV Trademark;
 - c. Using any false description or representation, including words or other symbols tending falsely to describe or represent unauthorized goods or their packaging as being those of MV, or sponsored by or associated with MV, and from offering such goods into commerce;
 - d. Further infringing the MV Trademark by manufacturing, producing, distributing, circulating, selling, marketing, offering for sale, advertising, promoting, renting, displaying or otherwise disposing of any products or their packaging not authorized

by MV that bear any simulation, reproduction, counterfeit, copy or colorable imitation of the MV Trademark;

- e. Using any simulation, reproduction, counterfeit, copy or colorable imitation of the MV Trademark, in connection with the promotion, advertisement, display, sale, offering for sale, manufacture, production, circulation or distribution of any unauthorized products or their packaging in such fashion as to relate or connect, or tend to relate or connect, such products in any way to MV, or to any goods sold, manufactured, sponsored or approved by, or connected with MV;
- f. Making any statement or representation whatsoever, or using any false designation of origin or false description, or performing any act, which may or is likely to lead the trade or public, or individual members thereof, to believe that any products manufactured, distributed, or sold by Defendant are in any manner associated or connected with MV, or are sold, manufactured, licensed, sponsored, approved or authorized by MV;

3. Effecting assignments or transfers, forming new entities or associations or utilizing any other device for the purpose of circumventing or otherwise avoiding the prohibitions set forth in any Final Judgment or Order in this action; and

4. For entry of an **ORDER** requiring Defendant to disseminate corrective advertisements in a form approved by the Court to acknowledge its violations of the law hereunder, and to ameliorate the false and deceptive impressions produced by such violations.

5. For all such other relief as the Court may deem appropriate to prevent the trade and public from deriving any erroneous impression that any products or associated packaging manufactured, sold or otherwise circulated or promoted by Defendant are authorized by MV or related in any way to MV or its products.

6. For an assessment of the **ACTUAL DAMAGES** suffered by MV, trebled, and an award of all profits that Defendant has derived from using the MV Trademark, trebled, as well as costs and attorneys' fees to the full extent provided for by Section 35 of the Lanham Act, 15 U.S.C. § 1117.

7. For **ATTORNEY'S FEES** and **COSTS OF SUIT**, and for such other and further relief as the Court shall deem appropriate.

8. **A TRIAL BY JURY IS DEMANDED.**

October 21, 2022

Respectfully Submitted,



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