

UNITED STATES DISTRICT COURT
EASTERN DISTRICT OF WISCONSIN

H-D U.S.A., LLC,

Plaintiff,

v.

JULIE MAYO, a/k/a Shelly LaRocca
d/b/a West Coast Charms
d/b/a 5th Avenue Pets
d/b/a Charms from the Heart,

Defendant.

Case No. 14-CV-654-JPS

ORDER

This matter is before the Court on the Motion for Default Judgment filed by Plaintiff H-D U.S.A., LLC ("H-D") against Julie Mayo a/k/a Shelly LaRocca d/b/a West Coast Charms, d/b/a 5th Avenue Pets d/b/a Charms from the Heart (collectively, "Defendant") on Claims 1, 2, 3, 5, 6 and 7 of H-D's Complaint.

Having evaluated and found persuasive H-D's Motion for Default Judgment and supporting declarations, the Court finds that: (1) H-D owns valid and protectable trademark rights in the HARLEY-DAVIDSON trademark and the Bar & Shield Logo trademark (collectively, the "H-D Marks") for a wide range of products and services including jewelry; (2) the H-D Marks are famous trademarks; (3) Defendant's floating charms, photo charms, and photo disks shown below bear counterfeits of the H-D Marks (collectively, the "Counterfeit Products") and Defendant's promotion, sales, and distribution of the Counterfeit Products is likely to cause confusion with the H-D Marks and thus constitutes trademark counterfeiting and trademark infringement in violation of 15 U.S.C. § 1114(1) (Claims 1 and 2), trademark infringement, false designation of origin, unfair competition in violation of

15 U.S.C. § 1125(a)(1)(A) (Claim 3), trademark infringement and unfair competition in violation of Wisconsin Statutes § 132 et. seq. (Claim 6), and trademark infringement and unfair competition under common law (Claim 7); (4) Defendant's unauthorized use of the H-D Marks is also likely to create an association arising from the similarity between Defendant's counterfeits of the H-D Marks and the genuine H-D Marks that impairs the distinctiveness of those marks and harms the reputation of those marks, and thus constitutes dilution by blurring and dilution by tarnishment in violation of 15 U.S.C. § 1125(c) (Claim 5); and (5) Defendant's actions and violations were willful and deliberate with respect to all of the above claims.

Defendant's Counterfeit Products

Floating Charm



Photo Charm



Photo Disk



Having found good cause for the entry of default judgment against Defendant,

IT IS HEREBY ORDERED that:

- A. This Court has personal jurisdiction over H-D and Defendant.
- B. Defendant, together with her employees, agents, partners, related companies, affiliates, and all persons in active concert or participation with any of them who receive actual notice of this Order by personal service or otherwise, is hereby PERMANENTLY ENJOINED, effective immediately (unless otherwise specified below):

1. From manufacturing, assembling, promoting, advertising, offering, selling, and distributing the Counterfeit Products and from using the H-D Marks, any other trademarks owned by H-D, and any trademarks and logos that are confusingly similar to or likely to dilute any such marks by blurring or by tarnishment including, but not limited to, use on any products, product packaging and labeling, stationery, invoices, websites, social media sites, signage, and promotional and advertising materials, or as or as part of any trademarks, business names, domain names, e mail addresses, URLs, metatags, screen names, social media names, keywords, or other identifiers;

2. From representing by any means whatsoever, directly or indirectly, that Defendant, any of Defendant's websites, any products or services offered by Defendant, including but not limited to the Counterfeit Products, or any activities undertaken by Defendant, emanate from or are associated or connected in any way with, or are sponsored by H-D; and

3. From assisting, aiding or abetting any other person or business entity in engaging in or performing any of the activities referred to in subparagraphs B.1-2 above.

C. Defendant, together with her employees, agents, partners, related companies, affiliates, and all persons in active concert or participation with any of them who receive actual notice of this Order by personal service or otherwise, is hereby ORDERED, within ten (10) days after H-D emails this Order to Defendant at the following email addresses with which H-D has previously communicated with Defendant, *charmsfromtheheart@yahoo.com* and *jmfinds01@yahoo.com* (regardless of whether such emails are received or

acknowledged by Defendant) and sends this Order to Defendant via Federal Express to the address listed in paragraph 4 of the Complaint, to remove all of the Counterfeit Products and all unauthorized uses of the H-D Marks from: (a) all websites owned, operated, used, or controlled by Defendant including, but not limited to the websites *5thavenuepets.com*, *5thavenuepets.net*, *5thavenuepet.net*, *5thavenuepet.com*, *westcoastcharms.com*, *charmsfromtheheart.net*, *horizonwholesalers.com*, *norcalcharms.com*, and *norcalcharms.net* (collectively, the "Websites"); and (b) all of Defendant's stores or presences on all third-party websites including, but not limited to, *eBay.com* and *Etsy.com*.

D. If Defendant does not timely comply with Section C above, or if in the future Defendant resumes promotion or sale of the Counterfeit Products or otherwise violates any of Sections B.1-3 above, the Internet service providers and website hosting providers for any such noncompliant websites that Defendant owns, operates, uses, or controls, including, but not limited to the Websites, are hereby ORDERED to immediately remove all Counterfeit Products and all unauthorized uses of H-D's marks from all such websites now and in the future or, if that is not possible, to terminate all of the ISP and hosting services and to shut down any such noncompliant websites.

E. If Defendant does not timely comply with Section C above, or if in the future Defendant resumes promotion or sale of the Counterfeit Products or otherwise violates any of Sections B.1-3 above on any websites (including, but not limited to, the Websites), the domain name registries and registrars for any domain names registered or otherwise acquired by Defendant and used for any such noncompliant websites, even if the domain names do not contain the H-D Marks, are hereby ORDERED to immediately: (1) transfer ownership of any such domain names to H-D or its designees; (2)

disclose to H-D for all such domain names Defendant's contact information used in registering, purchasing, and acquiring such domain names (including Defendant's e-mail addresses, telephone numbers, postal mailing addresses, and any aliases); and (3) disclose and transfer to H-D or H-D's designees any additional domain names used by Defendant in violation of any of Sections B.1-3 above, even if the domain names do not contain the H-D Marks, that reside in Defendant's accounts at such registrars or that Defendant has registered with such registrars.

F. Within ten (10) days after the entry of this Order, Defendant is ORDERED to surrender for destruction to H-D at 3700 W. Juneau Avenue, Milwaukee, Wisconsin 53208 all products, merchandise, advertising and promotional materials, and other materials and things in Defendant's possession or control that bear counterfeits of the H-D Marks including, but not limited to, the Counterfeit Products and all associated packaging, labeling, and advertising and promotional materials for the Counterfeit Products.

G. Within ten (10) days after the entry of this Order, Defendant is ORDERED to provide to H-D: (a) the identity and complete contact information for all persons and entities from which Defendant received, obtained, or otherwise acquired the Counterfeit Products including, but not limited to, all manufacturers, wholesalers, distributors, suppliers, brokers, and retailers (the "Sources"); (b) a complete accounting of all Counterfeit Products received, obtained, or otherwise acquired by Defendant from each Source; and (c) a complete accounting of all Counterfeit Products sold, distributed, or otherwise disposed of by Defendant including, but not limited to, a complete list of all customers and recipients of the Counterfeit Products including their contact information (the "Customers") and the specific

products purchased or received by each Customer, the total revenues received by Defendant from the sales, distribution, or other disposition of the Counterfeit Products, and the total profits received by Defendant from the sales, distribution, or other disposition of the Counterfeit Products.

H. Within ten (10) days after the entry of this Order, Defendant is ORDERED to pay to H-D statutory damages for Defendant's willful counterfeiting of the H-D Marks in the amount of \$750,000, in accordance with 15 U.S.C. § 1117(c), of \$250,000 per mark per each of the three Counterfeit Products.

I. Defendant is ORDERED to pay H-D's attorneys' fees and costs in connection with this lawsuit, pursuant to 15 U.S.C. § 1117(a), in an amount to be later determined by the Court. H-D shall submit an application for attorneys' fees and costs pursuant to 15 U.S.C. § 1117(a) and Fed. R. Civ. P. 54(d) by no later than January 1, 2015.

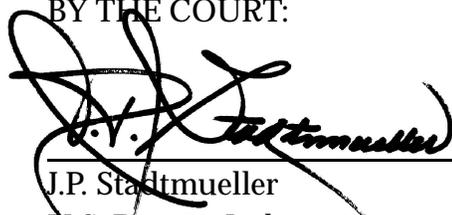
J. Defendant is ORDERED to file with this Court and serve on H-D's attorneys, within thirty (30) days after the date of entry of this Order, a report in writing and under oath setting forth in detail the manner and form in which she has complied with all of the terms of this Order.

K. Claim 4 of H-D's Complaint is DISMISSED without prejudice.

L. This Court will retain jurisdiction over the enforcement of this Order.

Dated at Milwaukee, Wisconsin, this 16th day of October, 2014.

BY THE COURT:



J.P. Stadtmueller
U.S. District Judge