

**IN THE UNITED STATES DISTRICT COURT  
FOR THE NORTHERN DISTRICT OF ILLINOIS  
EASTERN DIVISION**

**SHISEIDO AMERICAS  
CORPORATION,**

*Plaintiff,*

v.

**THE PARTNERSHIPS AND  
UNINCORPORATED ASSOCIATIONS  
IDENTIFIED ON SCHEDULE “A,”**

*Defendants.*

**CIVIL ACTION NO. 1:21-03075**

**JURY TRIAL DEMANDED**

**PLAINTIFF’S ORIGINAL COMPLAINT**

Plaintiff, Shiseido Americas Corporation (“Shiseido” or “Plaintiff”), by and through its counsel, Baker McKenzie, brings this Original Complaint against the Partnerships and Unincorporated Associations identified on Schedule A attached hereto (collectively, “Defendants”) and alleges as follows:

**I. PARTIES**

1. Plaintiff, Shiseido Americas Corporation, is a corporation organized and existing under the laws of the State of Delaware with a principal place of business at 390 Madison Avenue, New York, New York 10017. Shiseido Americas Corporation owns all right, title, and interest in and to the SHISEIDO Trademarks (defined herein) for use in connection with a range of goods and services.

2. Upon information and belief, Defendants are individuals and business entities who primarily reside in the People’s Republic of China or other foreign jurisdictions. Defendants conduct business throughout the United States, including within the State of Illinois and this

Judicial District, through the operation of fully interactive, commercial websites, and online marketplaces listed in Schedule A. Each Defendant targets the United States, including Illinois, and has offered to sell, and on information and belief, has sold and continues to offer and sell counterfeit Shiseido products to consumers within the United States, including the State of Illinois.

3. On information and belief, many of the Defendants are an interrelated group of counterfeiters working in active concert to knowingly and willfully manufacture, import, distribute, offer for sale, and sell products and to provide retail and store services using counterfeit versions of the SHISEIDO Trademarks in the same transaction, occurrence, or series of transactions or occurrences.

4. Defendants' identities are currently unknown because Defendants, in perpetrating their illegal and unauthorized actions, have intentionally hidden their identities and the full scope of their counterfeiting operations. If Defendants provide additional credible information regarding their identities, Shiseido will take appropriate steps to amend this Complaint as permitted by the Federal Rules of Civil Procedure.

## **II. JURISDICTION AND VENUE**

5. This is an action for trademark infringement and counterfeiting. As set forth below, Defendants' unlawful actions constitute federal trademark infringement and counterfeiting under Section 32 of the Lanham Act, 15 U.S.C. §1114, false designation of origin under Section 43(a) of the Lanham Act, 15 U.S.C. §1125(a), and violation of the Illinois Uniform Deceptive Trade Practices Act, 815 ILCS § 510, *et seq.* This Court has original subject matter jurisdiction over the claims in this action under the provisions of the Lanham Act, 15 U.S.C. §1051, *et seq.*, 28 U.S.C. §1338(a)–(b) and 28 U.S.C. §1331.

6. Under 28 U.S.C. § 1337(a), this Court has supplemental jurisdiction over the claims arising under the laws of the State of Illinois because the state law claims are so related to the federal claims that they form part of the same case or controversy and derive from a common nucleus of operative facts.

7. Venue is proper in this district under 28 U.S.C. §1331, and this Court may exercise personal jurisdiction over Defendants since each of the Defendants directly targets business activities toward consumers in the United States, including Illinois, through at least the fully interactive, commercial Internet stores operating under the Defendants' domain names (such domains, the "Defendant Domain Names") and/or the online marketplaces as defined and identified in Schedule A attached hereto (collectively, the "Online Stores"). Specifically, Defendants are reaching out to do business with Illinois residents by operating one or more Online Stores through which Illinois residents can purchase products using counterfeit versions of Shiseido's trademarks. Upon information and belief, each of the Defendants has targeted Illinois residents by operating Online Stores that accept payment in U.S. dollars and offer to sell and ship products to the United States, including Illinois, that use infringing and counterfeit versions of Shiseido's federally registered trademarks. Each of the Defendants is, thus, committing tortious acts in Illinois, is engaging in interstate commerce, and is wrongfully causing Shiseido substantial injury in the State of Illinois.

### **III. FACTUAL BACKGROUND**

9. Like many other luxury goods manufacturers, Shiseido has been battling counterfeit goods throughout the globe. In recent years, this problem has increased substantially with infringements occurring through online marketplaces and websites. Thus, Shiseido filed this action to stop the online sale of unauthorized and unlicensed counterfeit cosmetics and related

products using Shiseido's federally registered trademarks (the "Counterfeit Products"). The sellers of these Counterfeit Products are trading on Shiseido's goodwill and reputation by offering for sale and selling goods bearing Shiseido's federally registered trademarks, without any license or

authorization, including without limitation NARS and



10. Upon information and belief, Defendants create and operate the Online Stores and design them to appear to be selling genuine Shiseido-branded products, while actually infringing Shiseido's trademarks and selling Counterfeit Products to unknowing consumers. The Online Stores have common features, such as design elements and similarities of the Counterfeit Products offered for sale, establishing a logical relationship among the Defendants and suggesting that their counterfeiting operation arises out of the same transaction, occurrence, or series of transactions or occurrences. Further establishing a logical relationship among the Defendants is the existence of webpages, such as sellerdefense.cn, that allow counterfeitors to coordinate with each other regarding brands that have filed anti-counterfeiting actions and how to avoid counterfeiting suits, among other topics. Defendants further attempt to avoid liability by going to great lengths to conceal both their identities and the full scope and interworking of their counterfeiting operation. Defendants have and continue to willfully and maliciously advertise, offer for sale, and sell Shiseido counterfeits.

11. Shiseido filed this action to combat Defendants' infringement and counterfeiting of its federally registered trademarks, as well as to protect unknowing consumers from purchasing Counterfeit Products over the Internet. Shiseido has been and continues to be irreparably damaged through consumer confusion, dilution, and tarnishment of its valuable trademarks because of Defendants' actions. Defendants' ongoing unlawful activities should be restrained. Thus, Shiseido seeks injunctive and monetary relief.

12. In particular, Shiseido is a world-famous beauty company that designs, manufactures, and distributes cosmetics, skincare and related products under a prestigious portfolio of brands, including SHISEIDO, NARS, Clé de Peau Beauté, Drunk Elephant, Laura Mercier and bareMinerals. Shiseido's parent company, Shiseido Company, Limited, was founded in 1872 and is one of the oldest cosmetics companies in the world, and since then has been a leading beauty manufacturer, retailer, and service provider. In the United States and around the world, Shiseido's brands have come to symbolize high quality in cosmetics, and Shiseido's brands are among the most recognizable cosmetic products in the world. Shiseido Americas Corporation was founded in 1988 to manage the Americas operations of the company. NARS, the Shiseido brand infringed in this case, was founded in 1994 and acquired by Shiseido in 2000.

13. Shiseido's products are recognized worldwide by the trademarks NARS and



. In fact, Shiseido products always include at least one of Shiseido's federally registered trademarks.

14. The NARS and NARS-formative trademarks have been used in commerce on and in connection with cosmetics and related products continuously for decades. Since Shiseido's acquisition of the NARS brand in 2000, Shiseido has extensively marketed, advertised, and promoted its NARS cosmetics throughout the United States.

15. Shiseido is the owner of the right, title, and interest in and to the following federal trademark registrations, among others (collectively, the "SHISEIDO Trademarks"):

Trademark	Registration No.	Goods and Services
NARS	4617508	(Int'l Class: 21) cosmetic brushes
	5354874	(Int'l Class: 03) cosmetics, cosmetic preparations, non-medicated skin care

Trademark	Registration No.	Goods and Services
		preparations, sun block preparations, sunscreen preparations (Int'l Class: 21) cosmetics brushes
NARS	2250695	(Int'l Class: 03) cosmetics, namely, nail polish, nail enamels, lipstick, lip liner, lip gloss, lip cream, non-medicated lip balm, makeup, skin concealers, rouge, blush, eye liner, eye shadow, mascara, eyebrow pencil, face powder, and sun block preparations
NARS	6003095	(Int'l Class: 03) perfume
	5915300	(Int'l Class: 03) perfume
NARS CHEEK STUDIO	4928245	(Int'l Class: 03) cosmetics (Int'l Class: 21) cosmetic brushes
NARS	2813231	(Int'l Class: 03) body oil, cosmetic pencils, pre- moistened cosmetic tissues, pre- moistened cosmetic towelettes, pre- moistened cosmetic wipes, skin cream, skin lotion, skin moisturizer
NARS CLIMAX	5667556	(Int'l Class: 03) cosmetics and cosmetic preparations, excluding body oils and fragrances
NARS LAGUNA	4416694	(Int'l Class: 03) blush; cosmetic pencils; cosmetics; eyeliner pencils; facial concealer; foundation; lip gloss; lip liner; lipstick; make-up powder; mascara; nail polish
NARSISSIST	5309038	(Int'l Class: 03) cosmetics and cosmetic preparations

Trademark	Registration No.	Goods and Services
	2675564	(Int'l Class: 03) facial toner; facial softening lotion; skin cleansing foam; skin cleansing cream; skin exfoliating powder; skin moisturizer; skin cream moisturizer; and gel water cream facial mask
AUDACIOUS	4933307	(Int'l Class: 03) cosmetics, namely, lipstick, lipstain, lip gloss, lip balm, lip liners and mascara
AUDACIOUS	5921481	(Int'l Class: 03) cosmetics; perfumery; fragrances
ORGASM	5273549	(Int'l Class: 03) blush; cosmetics; lip gloss; nail polish
ORGASM	4128939	(Int'l Class: 03) cosmetics, toilet preparations and perfumery products, namely, lipsticks, lip gloss, lip liners, lip balms, lip palettes; eye shadows, eye lining pencils, liquid eye liners, eye makeup, mascara, eyebrow pencils, eye palettes; blushers, multi-use cosmetic sticks, foundation makeup, pressed powder, loose powder, makeup remover, powders and gels for use on face, cleansers, namely, facial cleansers and skin cleansers; moisturizers for the face and body, toners, eye creams; non-medicated skin care creams, lotions, oils, sprays, and gels for the face and body; lotions; nail polish, nail enamel, nail polish remover; fragrances for personal use, perfumes; bronzers
BELLE DE JOUR	2161312	(Int'l Class: 03) cosmetics, namely, lipstick
JUNGLE RED	2129982	(Int'l Class: 03) cosmetics, namely, lipstick
THE MULTIPLE	2128347	(Int'l Class: 03) cosmetics, namely, multipurpose highlighter for lips, cheeks, and eyes

Trademark	Registration No.	Goods and Services
MAKEUP YOUR MIND	2496489	(Int'l Class: 03) cosmetics, namely, nail polish, nail enamels, lip stick, lip liner, lip gloss, lip cream, non-medicated lip balm, makeup, skin concealers, rouge, blush, eye liner, eye shadow, mascara, eyebrow pencil, face powder, and sun block preparations
SUPERVIXEN	4729501	(Int'l Class: 03) Lip gloss

16. The above-listed registrations for the SHISEIDO Trademarks are valid, subsisting, and in full force and effect. Moreover, many are incontestable under 15 U.S.C. § 1065, and serve as *prima facie* evidence of the validity of the registrations, Shiseido's ownership of the SHISEIDO Trademarks, and of Shiseido's exclusive right to use the SHISEIDO Trademarks in commerce on or in connection with all of the goods identified in the registrations under 15 U.S.C. § 1057(b) and § 1115(a). Furthermore, the registrations are constructive notice of Shiseido's claim of ownership of the SHISEIDO Trademarks pursuant to 15 U.S.C. § 1072. True and correct copies of the United States Registration Certificates for the above-listed SHISEIDO Trademarks are attached hereto as Exhibit 1.

17. The SHISEIDO Trademarks are exclusive to Shiseido and are displayed extensively on or in close connection with Shiseido products, Shiseido packaging, and in Shiseido's marketing and promotional materials. Shiseido products have long been popular around the world and have been extensively promoted at significant annual expense. Shiseido products have also been the subject of extensive unsolicited publicity resulting from their high-quality, innovative designs and renown as desired luxury items. Shiseido products have been featured in leading publications and newspapers such as *InStyle*, *Harper's Bazaar*, *Elle*, *Vanity Fair*, *GQ*, *Men's Health*, *Vogue*, *W Magazine*, *Esquire*, and *The New York Times*. Specifically, NARS products are lauded throughout the industry and have won numerous awards, including: NARS

Blush in Orgasm, Allure Magazine 2020 Readers' Choice Awards and Instyle Magazine 2018 Best Beauty Buys; Lip Pigment, Allure Magazine 2020 Best of Beauty Awards and Instyle Magazine 2020 Best Beauty Buys; Climax Mascara, CEW 2019 Best New Eye Makeup; Radiant Creamy Concealer, Allure Magazine 2018 Readers' Choice Awards; and Soft Matte Complete Concealer, Allure Magazine 2017 Best of Beauty Awards. Because of these and other factors, the NARS brand and the SHISEIDO Trademarks have become famous throughout the United States.

18. To maintain the prestige of the NARS brand and SHISEIDO Trademarks and to ensure that consumers receive the type of service commensurate with Shiseido's reputation for luxury and quality products, Shiseido authorizes its NARS cosmetics to be sold exclusively through NARS boutiques or Shiseido's network of authorized retailers around the world, as well as online at <https://www.narscosmetics.com/>.

19. Under the NARS brand, Shiseido operates social media accounts to promote and advertise its products, including Instagram, Twitter, Facebook, Snapchat, and YouTube. Shiseido's primary NARS Instagram account, @narsissist, has over 8 million followers. Further, the NARS Cosmetics Facebook page boasts over 2.9 million likes and followers. The recognition of the NARS brand and SHISEIDO Trademarks among the public at large is enhanced not only by Shiseido's own extensive advertising efforts and select distribution, but also by fashion editorials and press coverage of Shiseido, as well as the coverage of Shiseido on social media platforms by influencers, celebrities, and cosmetic aficionados. Such press coverage reaches millions of consumers.

20. As the result of Shiseido's exclusive and extensive use of the SHISEIDO Trademarks, Shiseido is recognized as the source of any products bearing one or more of the SHISEIDO Trademarks. Due to the worldwide public acceptance, overwhelming fame, and great

recognition of products bearing or sold under the SHISEIDO Trademarks, these trademarks have come to represent an enormous amount of goodwill for Shiseido and have caused goods bearing the SHISEIDO Trademarks—even unauthorized goods—to be in great demand.

21. Shiseido, however, has gone to great lengths to protect its name and to enforce the SHISEIDO Trademarks. Shiseido actively seeks to protect and enforce its intellectual property rights by working with industry associations, anti-counterfeiting organizations, private investigators, and law enforcement authorities, including customs authorities in the United States and internationally, and also regularly monitors and investigates suspicious online marketplaces. Through those efforts, Shiseido has discovered hundreds, if not thousands, of counterfeit products being sold at physical locations and, more recently, over the Internet. Indeed, Shiseido has seen unauthorized use of one or more of the SHISEIDO Trademarks rise dramatically through the proliferation of online stores and marketplace listings on platforms such as eBay, AliExpress, DHgate, and other such platforms, as listed on Schedule A.

22. Commercial Internet stores, like the Defendants' Online Stores, are estimated to receive tens of millions of visits per year and to generate over \$135 billion in annual online sales. Internet websites like the Defendants' Online Stores are also estimated to annually contribute to tens of thousands of lost jobs for legitimate businesses and broader economic damages such as lost tax revenue.

23. Here, Defendants facilitate sales by designing the Online Stores so that they appear to unknowing consumers to be authorized online retailers, outlet stores, or wholesalers. Specifically, the Online Stores operated by Defendants use one or more of the SHISEIDO Trademarks without authorization on or in connection with the sales of products that are not genuine Shiseido products. For example, the Defendants use the trademarks NARS or



for the purpose of confusing unknowing consumers into believing that they are purchasing a genuine Shiseido product. Defendants' Online Stores also appear legitimate and accept payment in, among others, U.S. dollars via major credit cards, Alipay, Western Union, Moneygram, T/T, and PayPal. Defendants further perpetuate the illusion of legitimacy by offering customer service and using indicia of authenticity and security that consumers have come to associate with authorized retailers, including the Visa®, MasterCard®, Discover®, and/or PayPal® logos. To be clear, Shiseido has not licensed or authorized Defendants to use any of the SHISEIDO Trademarks, and none of the Defendants is an authorized retailer of genuine Shiseido products. Thus, Defendants are using trademarks owned by Shiseido without authorization and creating confusion about the source of the counterfeit products being sold through the Online Stores.

24. Many of the Defendants also deceive unknowing consumers by using the SHISEIDO Trademarks without authorization within the content, text, and/or meta tags of their websites and online marketplaces in order to attract various search engines crawling the Internet looking for sites relevant to consumer searches for Shiseido products. Additionally, upon information and belief, Defendants use other unauthorized search engine optimization (SEO) tactics and social media spamming so that the Online Stores listings are at or near the top of relevant search results and misdirect consumers searching for genuine Shiseido products. Other Defendants only show the Shiseido products in product images while using strategic item titles and descriptions that will trigger their listings when consumers are searching for Shiseido products.

25. As further evidence of their illegal activity, Defendants go to great lengths to conceal their identities and often use multiple fictitious names and addresses to register and to operate their network of Online Stores. On information and belief, Defendants regularly create

new websites and online marketplace accounts on various platforms using the identities listed in Schedule A to the Complaint, as well as other unknown fictitious names. These registration patterns are one of many common tactics used by the Defendants to conceal their identities and the full scope and interworking of their counterfeiting operations, and to avoid being shut down.

26. Even though Defendants operate under multiple fictitious names, there are numerous similarities among the Online Stores operated by the Defendants reflecting that they are interrelated and that their counterfeiting activity arises from the same set of transactions or occurrences. For example, counterfeit products for sale on the Online Stores bear similar irregularities and indicia of being counterfeit, suggesting that the counterfeit products were manufactured by and come from a common source, and that some of the Defendants are interrelated. For example, many of the Defendants use the same or similar pictures to advertise the same types of counterfeit goods, accept payment through the same channels, and represent themselves to be located in the same areas. Further, the Online Stores also include other notable common features, including use of the same shopping cart platforms, check-out methods, lack of contact information, identically or similarly priced items, the same incorrect grammar and misspellings, similar hosting services, and the use of the same text and images, including content copied from Shiseido's official NARS website, <https://www.narscosmetics.com/>. Indeed, in view of these undeniable similarities among the Defendants, it is likely that the majority of them share the same owner.

27. Moreover, these counterfeiters conspire and communicate together to avoid detection and being named in an enforcement action. For example, through websites, such as sellerdefense.cn, these counterfeiters constantly monitor U.S. lawsuits and communicate with each other about how to sell counterfeit products without detection, as well as how to transfer funds

beyond a U.S. court's jurisdiction once they become aware that a lawsuit has been filed. Thus, because this action presents common questions of law and fact, and because, at a minimum, Shiseido's claims for relief arise from the same series of transactions or occurrences, these Defendants should be joined in the same lawsuit. To do otherwise would permit the Defendants to likely avoid suit altogether, given their interrelated nature, and to frustrate Shiseido's attempts to enforce its intellectual property rights.

28. In addition to operating under multiple fictitious names, Defendants in this case and defendants in other similar cases against online counterfeiters use a variety of other common tactics to evade enforcement efforts. For example, counterfeiters like Defendants will often register new websites and online marketplace accounts under new aliases once they receive notice of a lawsuit. Counterfeiters also typically ship products in small quantities via international mail to minimize detection by U.S. Customs and Border Protection.

29. Further, counterfeiters such as Defendants typically operate multiple credit card merchant accounts and PayPal accounts behind layers of payment gateways so that they can continue operation in spite of enforcement efforts by brand owners. On information and belief, Defendants maintain offshore bank accounts and regularly move funds from their PayPal accounts or other financial accounts to offshore bank accounts outside the jurisdiction of this Court.

30. Defendants, without any authorization or license from Shiseido, have knowingly and willfully used and continue to use the SHISEIDO Trademarks in connection with the advertisement, distribution, offering for sale, and sale of Counterfeit Products into the United States and Illinois over the Internet. Each Defendant Online Store offers shipping to the United States, including Illinois, and, on information and belief, each Defendant has sold counterfeit products into the United States, including Illinois.

31. Defendants' uses of the SHISEIDO Trademarks in connection with the advertising, distribution, offering for sale, and sales of counterfeit Shiseido products, including the sales of counterfeit Shiseido products into the United States, including Illinois, is likely to cause and has caused confusion, mistake, and deception by and among consumers, and is irreparably harming Shiseido.

**IV. CAUSES OF ACTION**  
**COUNT ONE – TRADEMARK INFRINGEMENT (15 U.S.C. §1114)**

32. Shiseido incorporates by reference paragraphs 1 through 31 as if fully set forth herein.

33. Shiseido is the exclusive owner of the SHISEIDO Trademarks. Shiseido's federal registrations are active, valid, and in full force and effect.

34. Defendants, without Shiseido's authorization, have used and continue to use in commerce counterfeit imitations of the federally registered SHISEIDO Trademarks in connection with the sale, offering for sale, distribution, and advertising of counterfeit cosmetics bearing one or more of the SHISEIDO Trademarks.

35. Defendants' infringing activities are likely to cause and actually are causing confusion, mistake, or deception among customers, potential customers, and the public as to the origin, sponsorship, or approval of the Counterfeit Products. Consumers are likely to be misled into believing that the Online Stores and sale of products bearing the SHISEIDO Trademarks are licensed, sponsored, or otherwise approved by Shiseido.

36. Upon information and belief, Defendants were on both actual and constructive notice of Shiseido's exclusive rights in the registered SHISEIDO Trademarks when they adopted the SHISEIDO Trademarks for use in advertising and marketing in their Online Stores, which offer for sale and sell infringing and counterfeit products that exactly or closely copy those sold by

Shiseido under the SHISEIDO Trademarks. Defendants' actions are designed to trade on the SHISEIDO Trademarks.

37. Defendants' unauthorized uses of the SHISEIDO Trademarks are willful, in bad faith, and with full knowledge of Shiseido's prior use of, exclusive rights in, and ownership of the SHISEIDO Trademarks, with full knowledge of the goodwill and reputation associated with the SHISEIDO Trademarks, and with full knowledge that Defendants have no right, license, or authority to use the SHISEIDO Trademarks or any other mark confusingly similar thereto. The knowing and intentional nature of the acts set forth herein renders this an exceptional case under 15 U.S.C. §1117(a).

38. Defendants' acts are intended to reap the benefit of the goodwill that Shiseido has created in the SHISEIDO Trademarks and constitute trademark infringement in violation of Section 32 of the Lanham Act, 15 U.S.C. §1114(1).

39. As a result of Defendants' conduct and infringement of the SHISEIDO Trademarks, Shiseido is entitled to recover actual and/or statutory damages to the maximum amount permitted by law or in equity, including under 15 U.S.C. § 1117.

40. Defendants' conduct has caused and is causing immediate and irreparable injury to Shiseido and will continue both to damage Shiseido and deceive the public unless enjoined by this Court. Shiseido has no adequate remedy at law for ongoing infringement.

**COUNT TWO – TRADEMARK COUNTERFEITING (15 U.S.C. §1114)**

41. Shiseido incorporates by reference paragraphs 1 through 40 as if fully set forth herein.

42. This is an action for trademark counterfeiting against Defendants based on their promotion, advertisement, distribution, sale, and offering for sale counterfeit cosmetics products bearing one or more of the SHISEIDO Trademarks.

43. Defendants' counterfeiting activities are likely to cause and actually are causing confusion, mistake, and deception among the general consuming public as to the origin and quality of the Counterfeit Products.

44. Defendants' illegal acts are intended to reap the benefit of the goodwill that Shiseido has created in its SHISEIDO Trademarks and constitute counterfeiting of Shiseido's federally registered trademarks in violation of Section 32 of the Lanham Act, 15 U.S.C. §1114.

45. As a result of Defendants' conduct and infringement of the SHISEIDO Trademarks, Shiseido is entitled to recover actual and/or statutory damages to the maximum amount permitted by law or in equity, including under 15 U.S.C. § 1117.

46. Defendants' conduct has caused and is causing immediate and irreparable injury to Shiseido and will continue to both damage Shiseido and deceive the public unless enjoined by this Court. Shiseido has no adequate remedy at law for ongoing infringement.

**COUNT THREE – FALSE DESIGNATION OF ORIGIN (15 U.S.C. §1125(A))**

47. Shiseido incorporates by reference paragraphs 1 through 46 as if fully set forth herein.

48. Upon information and belief, Defendants' promotion, marketing, offering for sale, and sale of Counterfeit Products has created and is creating a likelihood of confusion, mistake, and deception among the general public as to the affiliation, connection, or association with Shiseido or the origin, sponsorship, or approval of Defendants' Counterfeit Products by Shiseido.

49. By using the SHISEIDO Trademarks on or in close connection with the Counterfeit

Products, Defendants create a false designation of origin and a misleading representation of fact as to the origin and sponsorship of the Counterfeit Products.

50. Defendants' false designation of origin and misrepresentation of fact as to the origin and/or sponsorship of the Counterfeit Products to the general public involves the use of counterfeit marks and is a willful violation of Section 43 of the Lanham Act, 15 U.S.C. §1125.

51. As a result of Defendants' conduct, including the violation of Section 43 of the Lanham Act, 15 U.S.C. § 1125, Shiseido is entitled to recover actual and/or statutory damages to the maximum amount permitted by law or in equity.

52. Defendants' conduct has caused and is causing immediate and irreparable injury to Shiseido and will continue to both damage Shiseido and deceive the public unless enjoined by this Court. Shiseido has no adequate remedy at law for ongoing infringement.

**COUNT FOUR – VIOLATION OF ILLINOIS  
UNIFORM DECEPTIVE TRADE PRACTICES ACT  
(815 ILCS §510, et seq.)**

53. Shiseido incorporates by reference paragraphs 1 through 52 as if fully set forth herein.

54. Defendants have knowingly and willfully engaged in deceptive trade practices violating Illinois law by passing off the Counterfeit Products as those of Shiseido, causing a likelihood of confusion and misunderstanding as to the source of their goods or services, causing a likelihood of confusion and misunderstanding as to an affiliation, connection, or association with genuine Shiseido products, using deceptive representations or designations of origin in connection with Shiseido products, and engaging in other deceptive conduct that creates a likelihood of confusion or misunderstanding among the public.

55. Defendants' infringing acts constitute a willful violation of the Illinois Uniform Deceptive Trade Practices Act, 815 ILCS § 510, et seq.

56. As a result of Defendants' conduct, including the violation of the Illinois Uniform Deceptive Trade Practices Act, Shiseido is entitled to recover actual and/or statutory damages to the maximum amount permitted by law or in equity.

57. Defendants' conduct has caused and is causing immediate and irreparable injury to Shiseido and will continue to both damage Shiseido and deceive the public unless enjoined by this Court. Shiseido has no adequate remedy at law for ongoing infringement.

#### **V. JURY DEMAND**

58. Under Federal Rule of Civil Procedure 38(b), Shiseido demands a trial by jury of all issues so triable.

#### **VI. PRAYER FOR RELIEF**

WHEREFORE, Shiseido prays for relief as follows:

- 1) That Defendants, their affiliates, officers, agents, servants, employees, attorneys, and all persons acting for, with, by, through, under, or in active concert with them be temporarily, preliminarily, and permanently enjoined and restrained from:
  - a. using the SHISEIDO Trademarks or any reproductions, counterfeit copies, or colorable imitations thereof in any manner in connection with the distribution, marketing, advertising, offering for sale, or sale of any product that is not a genuine Shiseido product or is not authorized by Shiseido to be sold in connection with the SHISEIDO Trademarks;
  - b. passing off, inducing, or enabling others to sell or pass off (i) any product as a genuine Shiseido product or (ii) any other service or product produced by Shiseido that is not Shiseido's or is not produced under the authorization, control, or

supervision of Shiseido and, in either case, approved by Shiseido for sale under the SHISEIDO Trademarks;

- c. committing any acts calculated to cause consumers to believe that Defendants' Counterfeit Products are those sold or provided under the authorization, control, or supervision of Shiseido, or are sponsored by, approved by, or otherwise connected with Shiseido;
- d. further infringing the SHISEIDO Trademarks; and
- e. manufacturing, shipping, delivering, holding for sale, transferring, or otherwise moving, storing, distributing, returning, or otherwise disposing of, in any manner, products or inventory not manufactured by or for Shiseido, nor authorized by Shiseido to be sold or offered for sale, and which bear any of Shiseido's trademarks, including the SHISEIDO Trademarks, or any reproductions, counterfeit copies, or colorable imitations thereof;

2) Entry of an Order that, upon Shiseido's choosing, the registrant of the Defendant Domain Names shall be changed from the current registrant to Shiseido or its designee, and that the domain name registries for the Defendant Domain Names shall unlock and change the registrar of record for the Defendant Domain Names to a registrar of Shiseido's selection, and that the domain name registrars, including, but not limited to, GoDaddy Operating Company, LLC ("GoDaddy"), RU-CENTER-RU ("RU-Center"), and Fabulous.com Pty Ltd. ("Fabulous"), shall take any steps necessary to transfer the Defendant Domain Names to a registrar account of Shiseido's selection; or that the same domain name registries shall disable the Defendant Domain Names and make them inactive and non-transferable;

- 3) Entry of an Order that, upon Shiseido's request, those in privity with Defendants and those with notice of the injunction, including, without limitation, any online marketplace platforms such as eBay, Amazon, AliExpress, and DHgate web hosts, sponsored search engine or ad-word providers, credit cards, banks, merchant account providers, third party processors, and other payment processing service providers, such as PayPal, and Internet search engines such as Google, Bing and Yahoo (collectively, the "Third Party Providers") shall:
  - a. disable and cease providing services being used by Defendants, currently or in the future, to engage in the sale of goods using the SHISEIDO Trademarks; and
  - b. disable and cease displaying any advertisements used by or associated with Defendants in connection with the sale of counterfeit and infringing goods using the SHISEIDO Trademarks.
- 4) That Defendants account for and pay to Shiseido all profits realized by Defendants by reason of Defendants' unlawful acts herein alleged, and that the amount of damages for infringement of the SHISEIDO Trademarks be increased by a sum not exceeding three times the amount thereof as provided by 15 U.S.C. §1117;
- 5) In the alternative, that Shiseido be awarded statutory damages for willful trademark counterfeiting pursuant to 15 U.S.C. §1117(c)(2) of \$2,000,000 for each and every use of the SHISEIDO Trademarks;
- 6) That Shiseido be awarded its reasonable attorneys' fees and costs; and
- 7) Award any and all other legal or equitable relief that this Court deems just and proper.

Dated: June 8, 2021

/s/ Shima S. Roy

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