

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

DEFTONES, a California general partnership,

Plaintiff,

v.

THE PARTNERSHIPS and
UNINCORPORATED ASSOCIATIONS
IDENTIFIED ON SCHEDULE “A,”

Defendants.

Case No. 24-cv-09073

COMPLAINT

Plaintiff Deftones, a California general partnership (“Plaintiff”) hereby brings the present action against the Partnerships and Unincorporated Associations Identified on Schedule A attached hereto (collectively, “Defendants”) and alleges as follows:

I. JURISDICTION AND VENUE

1. This Court has original subject matter jurisdiction over Plaintiff’s claims pursuant to 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.

2. Venue is proper in this Court pursuant to 28 U.S.C. § 1391, and this Court may properly exercise personal jurisdiction over Defendants because Defendants structure their business activities to target consumers in the United States, including Illinois, through at least the fully interactive e-commerce stores operating under the aliases identified on Schedule A attached hereto (the “Seller Aliases”). Specifically, Defendants have targeted sales to Illinois residents by setting up and operating e-commerce stores that target United States consumers, offer shipping to the United States, including Illinois, accept payment in U.S. dollars and, on information and belief,

sell products using infringing and counterfeit versions of Plaintiff's federally registered trademark (collectively, the "Unauthorized Products") to residents of Illinois. Each of the Defendants is committing tortious acts in Illinois, is engaging in interstate commerce, and has wrongfully caused Plaintiff substantial injury in the state of Illinois.

II. INTRODUCTION

3. Plaintiff filed this case to prevent e-commerce store operators who trade upon Plaintiff's reputation and goodwill from further selling and/or offering for sale Unauthorized Products. Defendants create e-commerce stores under one or more Seller Aliases and then advertise, offer for sale, and/or sell Unauthorized Products to unknowing consumers. E-commerce stores operating under the Seller Aliases share identifiers, such as design elements and similarities of the Unauthorized Products offered for sale, establishing that a logical relationship exists between them, and that Defendants' counterfeiting operation arises out of the same transaction, occurrence, or series of transactions or occurrences. Defendants take advantage of a set of circumstances, including the anonymity and mass reach afforded by the Internet and the cover afforded by international borders, to violate Plaintiff's intellectual property rights with impunity. Defendants attempt to avoid liability by operating under one or more Seller Aliases to conceal both their identities, locations, and the full scope and interworking of their counterfeiting operation. Plaintiff is forced to file this action to combat Defendants' counterfeiting of its registered trademark, as well as to protect consumers from purchasing Unauthorized Products over the Internet. Plaintiff has been, and continues to be, irreparably damaged through consumer confusion and dilution of its valuable trademark because of Defendants' actions and therefore seeks injunctive and monetary relief.

III. THE PARTIES

4. Plaintiff, Deftones, is a California general partnership consisting of the current band members of Deftones, with its principal place of business in California. Deftones owns the trademark asserted in this action.

5. Deftones is an influential American band from Sacramento, California. The band was formed in 1988 by Chino Moreno (frontman), Stephen Carpenter (lead guitarist), Abe Cunningham (drummer), and the late Chi Cheng (bassist). Keyboardist and turntablist Frank Delgado joined in 1990. Born from the alternative metal scene, Deftones has continually defied genre classification and has successfully weaved a rich tapestry of styles into its music. Deftones' genre-defying sound blends a wide range of alternative metal, nu-metal shoegaze, post-metal, and electronic influences, crafting a dynamic and ever-evolving musical journey. Deftones stands as a pioneer of sounds that challenge and transcend traditional genre expectations. The band's experimental nature has led critics to describe Deftones as "the Radiohead of metal."

6. Across nine studio albums and a handful of compilations, extended plays and live offerings, Deftones has firmly established itself as a leader in the metal music world. Deftones has sold over 10 million albums worldwide, with several albums renowned and critically acclaimed. Albums like *White Pony*, *Adrenaline*, and *Around the Fur* have achieved RIAA certifications. *White Pony*, Deftones' 2000 landmark album, earned Platinum certification from the RIAA, signifying over 1 million units sold in the United States, and received Gold certifications from the ARIA, BPI, and MC, recognizing significant sales in Australia, the United Kingdom, and Canada, respectively. Moreover, Deftones has had several songs, and four albums, make an impact on the Billboard 200 charts.

7. Deftones has received various awards and nominations recognizing its impact on the music industry. Deftones won: (1) the 2001 Grammy Award for Best Metal Performance for their song “Elite”; (2) the 2022 Grammy Award for Best Remixed Recording for "Passenger (Mike Shinoda Remix)"; (3) the 2016 Kerrang! Lifetime Achievement Award; (4) the 2007 Kerrang! Classic Songwriter Award; (5) and the 2013 Revolver Golden Gods Award for Album of the Year for the album *Koi No Yokan*. These accolades reflect Deftones’ continued influence and success in the music industry.

8. With a strong fan base, Plaintiff markets and sells a variety of Deftones-branded products, including apparel such as hoodies, t-shirts, and hats; vinyl and records; games; and other merchandise bearing Plaintiff’s DEFTONES trademark (collectively, “Deftones Products”). Deftones Products have become enormously popular and even iconic, driven by Plaintiff’s quality standards and innovative designs. Among the purchasing public, Deftones Products are instantly recognizable as such. Deftones Products are distributed and sold to consumers through Plaintiff’s official Deftones store, <https://shopdeftones.com>.

9. Plaintiff has used the DEFTONES trademark for many years and has continuously sold products under its DEFTONES trademark (the “Deftones Trademark”). As a result of this long-standing use, strong common law trademark rights have amassed in the Deftones Trademark. Plaintiff’s use of the mark has also built substantial goodwill in the Deftones Trademark. The Deftones Trademark is a famous mark and valuable asset of Plaintiff. Deftones Products typically include the Deftones Trademark.

10. The Deftones Trademark is registered with the United States Patent and Trademark Office and is included below.

Registration Number	Trademark	Registration Date	Goods and Services
2,369,966	DEFTONES	Jul. 25, 2000	For: clothing, namely - jackets, shirts and hats in class 025. For: entertainment services, namely - live performances by a musical group in class 041.

11. The U.S. registration for the Deftones Trademark is valid, subsisting, and in full force and effect, and is incontestable pursuant to 15 U.S.C. § 1065. The registration for the Deftones Trademark constitutes *prima facie* evidence of its validity and of Plaintiff's exclusive right to use the Deftones Trademark pursuant to 15 U.S.C. § 1057(b). A true and correct copy of the United States Registration Certificate for the Deftones Trademark is attached hereto as **Exhibit 1**.

12. The Deftones Trademark is exclusive to Plaintiff and is displayed extensively on Deftones Products and in marketing and promotional materials. The Deftones Trademark is also distinctive when applied to Deftones Products, signifying to the purchaser that the products come from Plaintiff, or its licensees, and are manufactured to Plaintiff's quality standards. Whether Plaintiff manufactures the products itself or contracts with others to do so, Plaintiff has ensured that products bearing the Deftones Trademark are manufactured to the highest quality standards.

13. The Deftones Trademark is a famous mark, as that term is used in 15 U.S.C. § 1125(c)(1), and has been continuously used and never abandoned. The success of Deftones, in addition to the marketing of Deftones Products, has enabled the Deftones brand to achieve widespread recognition and fame and has made the Deftones Trademark one of the most well-known mark in the music industry. The widespread fame, outstanding reputation, and significant

goodwill associated with the Deftones brand have made the Deftones Trademark a valuable asset of Plaintiff.

14. Products bearing the Deftones Trademark have been the subject of substantial and continuous marketing and promotion. Plaintiff has marketed and promoted, and continues to market and promote, the Deftones Trademark in the industry and to consumers through traditional print media, authorized retailers, social media sites, point of sale material, and its official Deftones store, <https://shopdeftones.com>.

15. Plaintiff has expended substantial time, money, and other resources advertising, promoting, and marketing Deftones Products. Deftones Products have also been the subject of extensive unsolicited publicity due to the longstanding success of the Deftones brand. As a result, products bearing the Deftones Trademark are widely recognized and exclusively associated by consumers as being high-quality products sourced from Plaintiff or Plaintiff's licensees. The Deftones Trademark has achieved tremendous fame and recognition, adding to the inherent distinctiveness of the mark. As such, the goodwill associated with the Deftones Trademark is of immeasurable value to Plaintiff.

16. Deftones Products are sold only by Plaintiff or through authorized licensees and are recognized by the public as being exclusively associated with the Deftones brand.

17. Defendants are unknown individuals and business entities who own and/or operate one or more of the e-commerce stores under the Seller Aliases identified on Schedule A and/or other seller aliases not yet known to Plaintiff. On information and belief, Defendants reside and/or operate in foreign jurisdictions and redistribute products from the same or similar sources in those locations. Defendants have the capacity to be sued pursuant to Federal Rules of Civil Procedure 17(b).

18. On information and belief, Defendants, either individually or jointly, operate one or more e-commerce stores under the Seller Aliases listed in Schedule A attached hereto. Tactics used by Defendants to conceal their identities and the full scope of their operation make it virtually impossible for Plaintiff to learn Defendants' true identities and the exact interworking of their counterfeit network. If Defendants provide additional credible information regarding their identities, Plaintiff will take appropriate steps to amend the Complaint.

IV. DEFENDANTS' UNLAWFUL CONDUCT

19. The success of the Deftones brand has resulted in significant counterfeiting of the Deftones Trademark. Because of this, Plaintiff has implemented an anti-counterfeiting program that involves investigating suspicious websites and online marketplace listings identified in proactive Internet sweeps. Recently, Plaintiff has identified many fully interactive e-commerce stores offering Unauthorized Products on online marketplace platforms such as Amazon.com, Inc. ("Amazon"), WhaleCo, Inc. ("Temu"), and Walmart, Inc. ("Walmart"), including the e-commerce stores operating under the Seller Aliases. The Seller Aliases target consumers in this Judicial District and throughout the United States. According to a report prepared for The Buy Safe America Coalition, most counterfeit products now come through international mail and express courier services (as opposed to containers) due to increased sales from offshore online counterfeiters. *The Counterfeit Silk Road: Impact of Counterfeit Consumer Products Smuggled Into the United States*, prepared by John Dunham & Associates (**Exhibit 2**).

20. Because counterfeit products sold by offshore online counterfeiters do not enter normal retail distribution channels, the US economy lost an estimated 300,000 or more full-time jobs in the wholesale and retail sectors alone in 2020. *Id.* When accounting for lost jobs from suppliers that would serve these retail and wholesale establishments, and the lost jobs that would

have been induced by employees re-spending their wages in the economy, the total economic impact resulting from the sale of counterfeit products was estimated to cost the United States economy over 650,000 full-time jobs that would have paid over \$33.6 billion in wages and benefits. *Id.* Additionally, it is estimated that the importation of counterfeit goods costs the United States government nearly \$7.2 billion in personal and business tax revenues in the same period. *Id.*

21. Online marketplace platforms like those used by Defendants do not adequately subject new sellers to verification and confirmation of their identities, allowing counterfeiters to “routinely use false or inaccurate names and addresses when registering with these e-commerce platforms.” **Exhibit 3**, Daniel C.K. Chow, *Alibaba, Amazon, and Counterfeiting in the Age of the Internet*, 40 NW. J. INT’L L. & BUS. 157, 186 (2020); *see also* report on “Combating Trafficking in Counterfeit and Pirated Goods” prepared by the U.S. Department of Homeland Security’s Office of Strategy, Policy, and Plans (Jan. 24, 2020), attached as **Exhibit 4**, and finding that on “at least some e-commerce platforms, little identifying information is necessary for a counterfeiter to begin selling” and that “[t]he ability to rapidly proliferate third-party online marketplaces greatly complicates enforcement efforts, especially for intellectual property rights holders.” Counterfeiters hedge against the risk of being caught and having their websites taken down from an e-commerce platform by establishing multiple virtual storefronts. **Exhibit 4** at p. 22. Since platforms generally do not require a seller on a third-party marketplace to identify the underlying business entity, counterfeiters can have many different profiles that can appear unrelated even though they are commonly owned and operated. **Exhibit 4** at p. 39. Further, “[e]-commerce platforms create bureaucratic or technical hurdles in helping brand owners to locate or identify sources of counterfeits and counterfeiters.” **Exhibit 3** at 186-187. Specifically, brand owners are

forced to “suffer through a long and convoluted notice and takedown procedure only [for the counterfeit seller] to reappear under a new false name and address in short order.” *Id.* at p. 161.

22. Defendants have targeted sales to Illinois residents by setting up and operating e-commerce stores that target United States consumers using one or more Seller Aliases, offer shipping to the United States, including Illinois, accept payment in U.S. dollars and, on information and belief, sell Unauthorized Products to residents of Illinois.

23. Defendants concurrently employ and benefit from similar advertising and marketing strategies. For example, Defendants facilitate sales by designing the e-commerce stores operating under the Seller Aliases so that they appear to unknowing consumers to be authorized online retailers, outlet stores, or wholesalers. E-commerce stores operating under the Seller Aliases appear sophisticated and accept payment in U.S. dollars in multiple ways, including via credit cards, Amazon Pay, PayPal and/or Stripe. E-commerce stores operating under the Seller Aliases often include content and images that make it very difficult for consumers to distinguish their stores from an authorized retailer. Plaintiff has not licensed or authorized Defendants to use the Deftones Trademark, and none of the Defendants are authorized retailers of Deftones Products.

24. Many Defendants also deceive unknowing consumers by using the Deftones Trademark within the content, text, and/or meta tags of their e-commerce stores to attract consumers using search engines to find websites relevant to Deftones Products. Other e-commerce stores operating under the Seller Aliases omit using the Deftones Trademark in the item title to evade enforcement efforts while using strategic item titles and descriptions that will trigger their listings when consumers are searching for Deftones Products.

25. E-commerce store operators like Defendants commonly engage in fraudulent conduct when registering the Seller Aliases by providing false, misleading and/or incomplete

information to e-commerce platforms to prevent discovery of their true identities and the scope of their e-commerce operation.

26. E-commerce store operators like Defendants regularly register or acquire new seller aliases for the purpose of offering for sale and selling Unauthorized Products. Such seller alias registration patterns are one of many common tactics used by e-commerce store operators like Defendants to conceal their identities and the full scope and interworking of their counterfeiting operation, and to avoid being shut down.

27. Even though Defendants operate under multiple fictitious aliases, the e-commerce stores operating under the Seller Aliases often share unique identifiers, such as templates with common design elements that intentionally omit contact information or other information for identifying Defendants or other Seller Aliases they operate or use. E-commerce stores operating under the Seller Aliases include other common features, such as registration patterns, accepted payment methods, check-out methods, keywords, advertising tactics, similarities in price and quantities, the same incorrect grammar and misspellings, and/or the use of the same text and images. Additionally, Unauthorized Products for sale by the Seller Aliases bear similar irregularities and indicia of being counterfeit to one another, suggesting that the Unauthorized Products were manufactured by and come from a common source and that Defendants are interrelated.

28. E-commerce store operators like Defendants communicate with each other through QQ.com chat rooms and utilize websites, like sellerdefense.cn, that provide tactics for operating multiple online marketplace accounts and evading detection by brand owners. Websites like sellerdefense.cn also tip off e-commerce store operators like Defendants of new intellectual property infringement lawsuits filed by brand owners, such as Plaintiff, and recommend that e-

commerce operators cease their infringing activity, liquidate their associated financial accounts, and change the payment processors that they currently use to accept payments in their online stores.

29. Counterfeiters such as Defendants typically operate under multiple seller aliases and payment accounts so that they can continue operation despite Plaintiff's enforcement. E-commerce store operators like Defendants maintain off-shore bank accounts and regularly move funds from their financial accounts to offshore accounts outside the jurisdiction of this Court to avoid payment of any monetary judgment awarded to Plaintiff.

30. Defendants are working in active concert to knowingly and willfully manufacture, import, distribute, offer for sale, and sell Unauthorized Products in the same transaction, occurrence, or series of transactions or occurrences. Defendants, without any authorization or license from Plaintiff have, jointly and severally, knowingly and willfully used and continue to use the Deftones Trademark in connection with the advertisement, distribution, offering for sale, and sale of Unauthorized Products into the United States and Illinois over the Internet.

31. Defendants' unauthorized use of the Deftones Trademark in connection with the advertising, distribution, offering for sale, and sale of Unauthorized Products, including the sale of Unauthorized 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 Plaintiff.

COUNT I
TRADEMARK INFRINGEMENT AND COUNTERFEITING (15 U.S.C. § 1114)

32. Plaintiff hereby re-alleges and incorporates by reference the allegations set forth in the preceding paragraphs.

33. This is a trademark infringement action against Defendants based on their unauthorized use in commerce of counterfeit imitations of the Deftones Trademark in connection

with the sale, offering for sale, distribution, and/or advertising of infringing goods. The Deftones Trademark is a highly distinctive mark. Consumers have come to expect the highest quality from Deftones Products offered, sold, or marketed under the Deftones Trademark.

34. Defendants have sold, offered to sell, marketed, distributed, and advertised, and are still selling, offering to sell, marketing, distributing, and advertising products using counterfeit reproductions of the Deftones Trademark without Plaintiff's permission.

35. Plaintiff owns the Deftones Trademark. Plaintiff's United States registration for the Deftones Trademark is in full force and effect. On information and belief, Defendants have knowledge of Plaintiff's rights in the Deftones Trademark and are willfully infringing and intentionally using infringing and counterfeit versions of the Deftones Trademark. Defendants' willful, intentional, and unauthorized use of the Deftones Trademark is likely to cause, and is causing, confusion, mistake, and deception as to the origin and quality of the Unauthorized Products among the general public.

36. Defendants' activities constitute willful trademark infringement and counterfeiting under Section 32 of the Lanham Act, 15 U.S.C. § 1114.

37. Plaintiff has no adequate remedy at law, and if Defendants' actions are not enjoined, Plaintiff will continue to suffer irreparable harm to its reputation and the goodwill of the Deftones Trademark.

38. The injuries and damages sustained by Plaintiff have been directly and proximately caused by Defendants' wrongful reproduction, use of advertisement, promotion, offering to sell, and/or sale of Unauthorized Products.

COUNT II
FALSE DESIGNATION OF ORIGIN (15 U.S.C. § 1125(a))

39. Plaintiff hereby re-alleges and incorporates by reference the allegations set forth in the preceding paragraphs.

40. Defendants' promotion, marketing, offering for sale, and sale of Unauthorized 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 Plaintiff or the origin, sponsorship, or approval of Defendants' Unauthorized Products by Plaintiff.

41. By using the Deftones Trademark in connection with the offering for sale and/or sale of Unauthorized Products, Defendants create a false designation of origin and a misleading representation of fact as to the origin and sponsorship of the Unauthorized Products.

42. Defendants' false designation of origin and misrepresentation of fact as to the origin and/or sponsorship of the Unauthorized 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.

43. Plaintiff has no remedy at law and will continue to suffer irreparable harm to its reputation and the associated goodwill of the Deftones brand if Defendants' actions are not enjoined.

PRAYER FOR RELIEF

WHEREFORE, Plaintiff Deftones prays for judgment against Defendants as follows:

1) That Defendants, their affiliates, officers, agents, servants, employees, attorneys, confederates, 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 Deftones Trademark 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 Deftones Product or is not authorized by Plaintiff to be sold in connection with the Deftones Trademark;

- b. passing off, inducing, or enabling others to sell or pass off any product as a Deftones Product or any other product produced by Plaintiff, that is not Plaintiff's or not produced under the authorization, control, or supervision of Plaintiff and approved by Plaintiff for sale under the Deftones Trademark;
 - c. committing any acts calculated to cause consumers to believe that Defendants' Unauthorized Products are those sold under the authorization, control, or supervision of Plaintiff, or are sponsored by, approved by, or otherwise connected with Plaintiff;
 - d. further infringing the Deftones Trademark and damaging Plaintiff's goodwill; 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 Plaintiff, nor authorized by Plaintiff to be sold or offered for sale, and which bear the Deftones Trademark;
- 2) Entry of an Order that, upon Plaintiff's request, those with notice of the injunction, including without limitation, any websites and/or online marketplace platforms such as Amazon, Temu, and Walmart, shall disable and cease displaying any advertisements used by or associated with Defendants in connection with the sale of counterfeit and infringing goods using the Deftones Trademark;
- 3) That Defendants account for and pay to Plaintiff all profits realized by Defendants by reason of Defendants' unlawful acts herein alleged, and that the amount of damages for

infringement of the Deftones Trademark be increased by a sum not exceeding three times the amount thereof as provided by 15 U.S.C. § 1117;

4) In the alternative, that Plaintiff 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 Deftones Trademark;

5) Plaintiff is further entitled to recover its attorney's fees and full costs; and

6) Award any and all other relief that this Court deems just and proper.

Dated this 27th day of September 2024.

Respectfully submitted,

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