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**UNITED STATES DISTRICT COURT
CENTRAL DISTRICT OF CALIFORNIA**

SOUTHERN CALIFORNIA EDISON
COMPANY and EDISON
INTERNATIONAL,

Plaintiffs,

v.

VIVINT SOLAR, INC.,

Defendant.

Case No. 17-8388

COMPLAINT FOR:

- (1) FEDERAL TRADEMARK INFRINGEMENT**
- (2) FEDERAL TRADEMARK COUNTERFEITING**
- (3) FALSE DESIGNATION OF ORIGIN**
- (4) FEDERAL TRADEMARK DILUTION**
- (5) FEDERAL FALSE ADVERTISING**
- (6) CALIFORNIA COMMON LAW PASSING OFF**
- (7) CALIFORNIA STATUTORY TRADEMARK DILUTION**

DEMAND FOR JURY TRIAL

1 **COMPLAINT**

2 1. Plaintiffs Southern California Edison Company (“SCE”) and Edison
3 International (“EIX”) (individually and jointly, “Edison”) bring this lawsuit to protect
4 both their customers and their good will from the unauthorized, misleading, and
5 intimidating conduct of Defendant Vivint Solar, Inc. (“Defendant”) and its sales force.
6 Edison is not a competitor of Vivint Solar, and this lawsuit is not about lost customers
7 or lost sales. Edison strongly supports renewable energy and readily facilitates solar
8 connectivity for SCE customers in Southern California. However, Edison can no
9 longer allow Defendant and its agents to continue misleading SCE customers and
10 trading on Edison’s good will by impersonating Edison representatives and using
11 counterfeit Edison trademarks in its marketing efforts.

12 2. Despite repeated requests from Edison that Defendant halt its
13 unauthorized and unlawful practices, Defendant has persisted in employing aggressive
14 and misleading door-to-door solicitations. During these solicitations, Defendant’s
15 representatives falsely state that they represent or are affiliated with Edison,
16 deceptively display Edison’s name, logo, and other trademarks, and illegitimately
17 attempt to trade on Edison’s goodwill in the course of marketing Defendant’s products
18 and services.

19 3. To address and remedy this continuing misconduct, Edison alleges the
20 following claims against Defendant: (1) trademark infringement under 15 U.S.C.
21 § 1114; (2) counterfeiting under 15 U.S.C. §§ 1114 and 1116(d); (3) false designation
22 of origin under 15 U.S.C. § 1125(a); (4) trademark dilution under 15 U.S.C.
23 § 1125(c); (5) false advertising under 15 U.S.C. § 1125(a); (6) California common law
24 passing off; and (7) California statutory trademark dilution under California Business
25 and Professions Code § 14247, *et seq.*

NATURE OF THE ACTION

1
2 4. Plaintiff SCE is one of the nation’s largest electric utilities, serving a
3 population of approximately 15 million in a 50,000-square-mile service area within
4 Central, Coastal, and Southern California. SCE is wholly-owned by Plaintiff EIX.

5 5. For over 100 years, Edison has carefully cultivated its name and
6 reputation as a trusted provider of high quality, cost-effective electricity and related
7 services to millions of Californians. Edison’s common law and federally registered
8 trademarks (the “Edison Marks”) have been in continuous use for many years, are
9 closely associated with Edison, and are well known and famous among consumers.
10 By using the Edison Marks in a misleading and deceptive manner, Defendant has
11 sought to profit from consumer confusion and has infringed the Edison Marks as well
12 as Edison’s other rights in its name, business, and goodwill.

13 6. Edison is and has long been a strong supporter of renewable energy and
14 whole-heartedly supports its customers who decide to install solar on their homes and
15 businesses. Edison, through SCE, has facilitated solar connectivity for more than
16 220,000 residential and commercial customers in Southern California, and connects an
17 average of 4,400 solar customers to the electric grid each month. In addition to
18 interconnecting these solar systems, SCE also purchases from third parties, and
19 delivers to its customers, more solar energy than any other utility in the nation.

20 7. Although Edison facilitates solar connectivity, neither EIX nor SCE is in
21 the business of providing and installing solar panels for residential customers. Rather,
22 independent solar companies contract with customers to install the equipment that
23 SCE connects to the electric grid. Neither EIX nor SCE is a competitor of Defendant
24 or of any residential solar company.

25 8. Defendant is an independent solar company that uses door-to-door sales
26 representatives to target residential customers in SCE’s service area. Although

1 Defendant is in no way affiliated with Edison, or sponsored, endorsed, or
2 recommended by Edison, Defendant's sales representatives throughout Southern
3 California regularly hold themselves out as Edison employees, partners, or affiliates to
4 gain customers' trust and induce customers to purchase Defendant's products and
5 services. SCE has received numerous complaints from its customers that, during
6 Defendant's door-to-door solicitations, Defendant's representatives have falsely stated
7 that they are "from Edison" or "in partnership with Edison," and have gone so far as
8 to use counterfeit Edison logos and trademarks on their clothing and other materials to
9 falsely imply a connection to Edison. On information and belief, Defendant also
10 knowingly uses and directs third party sales and marketing firms that misleadingly
11 portray Defendant as related to, connected to, or affiliated with Edison.

12 9. While Edison strongly supports solar power, it does not support
13 misleading business practices that misuse its trademarks or confuse and alienate its
14 customers. With this lawsuit, Edison seeks to stop Defendant, its sales agents, and its
15 representatives from misrepresenting themselves as affiliated with Edison to trade on
16 Edison's goodwill and reputation in gaining access to SCE's customers. SCE has
17 received numerous complaints from customers who have been confused and, in some
18 cases, intimidated and frightened by Defendant's aggressive and misleading sales
19 tactics.

20 10. Defendant's unauthorized use of the Edison Marks is causing harm to
21 Edison through infringement and dilution of the Edison Marks, false designation of
22 origin and passing off, and false advertising as described in more detail below.
23 Moreover, by using the Edison Marks, Defendant is sowing customer distrust in
24 legitimate Edison representatives, impeding Edison's ability to perform its business
25 functions, and is potentially driving customers away from solar power by associating
26 the energy source with deceptive and fraudulent business practices.

1 11. Defendant is well aware that its conduct is infringing and otherwise
2 unlawful. Since June 2016, SCE has been in repeated contact with Defendant
3 concerning the behavior of Defendant's sales representatives and their use of the
4 Edison Marks. SCE's own customers have questioned Defendant's representatives
5 directly about their misrepresentations and misuse of the Edison Marks. Despite
6 being on notice of this unlawful behavior for over a year, Defendant's agents and
7 representatives have continued their misrepresentations and deceptive conduct
8 unabated. In fact, Edison is informed and believes that Defendant's conduct is
9 escalating, given the egregiousness of the recent conduct reported by SCE's
10 customers.

11 12. Edison is not alleging that it lost profits or electricity sales because of the
12 unlawful practices of Defendant, and Edison seeks no monetary damages related to
13 Defendant's sales or profits. Edison's primary goal with this lawsuit is to obtain an
14 injunction and stop Defendant from confusing and harassing its customers and
15 misusing its trademarks. To the extent monetary relief is requested, it is meant solely
16 to deter Defendant's misleading conduct.

17 **JURISDICTION AND VENUE**

18 13. This Court has original jurisdiction over the subject matter of this action
19 pursuant to 15 U.S.C. § 1121, 28 U.S.C. § 1331, and 28 U.S.C. § 1338, and has
20 supplemental jurisdiction over the state law claims pursuant to 28 U.S.C. § 1367.
21 These claims arise from the same aggregate core of facts, most notably Defendant's
22 use in commerce of the Edison Marks for the purposes of advertising, promoting, and
23 selling its products and services.

24 14. This Court has personal jurisdiction over Defendant because this action
25 arises out of Defendant's conduct in the state of California and Defendant has
26 substantial, repeated contacts in this state.

1 15. Venue is proper in this district pursuant to 28 U.S.C. § 1391(b) because a
2 substantial part of the events giving rise to the claims have occurred in this district.

3 **THE PARTIES**

4 16. Southern California Edison Company is a corporation organized under
5 the laws of the State of California with its principal place of business located at 2244
6 Walnut Grove Ave., Rosemead, CA 91770.

7 17. Edison International is a corporation organized under the laws of the
8 State of California with its principal place of business located at 2244 Walnut Grove
9 Ave., Rosemead, CA 91770.

10 18. Vivint Solar, Inc. is a corporation organized under the laws of the State
11 of Delaware with its principal place of business located at 1800 W. Aston Blvd., Lehi,
12 UT 84043.

13 **EDISON'S HISTORY**

14 19. Edison is a California institution that began as the Visalia Electric Light
15 and Gas Company in 1886. The utility business incorporated in 1909 under the
16 Southern California Edison Company name, which has been in continuous use for
17 over a century while SCE has provided power to generations of Californians. Edison
18 fueled the growth of a significant part of California and helped turn the state into an
19 engine of the American economy by providing vital power to farmers, cities, and
20 industry, and enabling the widespread adoption of electrical appliances and machines
21 throughout the early 1900s.

22 20. Edison has also been at the forefront of developing and supporting clean
23 and renewable power sources, whether hydroelectric power in the early 1900s or,
24 more recently, wind and solar power. In 1970, SCE launched a Research,
25 Development, and Demonstration Department to gain hands-on experience with
26 renewable technologies such as wind and solar power. This department worked

1 closely with the Electric Power Research Institute in Palo Alto and the Energy
2 Research and Development Administration of the U.S. Department of Energy to
3 develop clean energy sources. In 1975, SCE initiated energy conservation programs
4 and shifted its focus from marketing the usage of more electricity to encouraging its
5 customers to use electricity more efficiently. In 1978, SCE established the Wind
6 Energy Research Center in Palm Springs, California to further assess wind as a viable
7 alternative power source. In 1982, SCE began operating the Coolwater plant in the
8 Mojave Desert – later named Solar One – as the nation’s first large-scale solar electric
9 generation site. The 10-megawatt facility was the largest plant of its type in the world
10 and the first commercial plant in the U.S. to use solar thermal technology.

11 21. Edison’s support for renewable, environmentally friendly energy sources
12 continues to this day. Edison, through SCE, connects an average of 4,400 solar
13 customers to the electric grid monthly, equal to a solar customer coming online every
14 10 minutes. SCE maintains a website to guide customers adopting solar power,
15 [https://www.sce.com/wps/portal/home/residential/generating-your-own-power/solar-](https://www.sce.com/wps/portal/home/residential/generating-your-own-power/solar-power/)
16 [power/](https://www.sce.com/wps/portal/home/residential/generating-your-own-power/solar-power/), and helps customers and contractors revolutionize the marketplace by
17 encouraging the widespread adoption of this new energy source. In addition to
18 interconnecting customers’ solar systems, SCE also purchases from third parties, and
19 delivers to its customers, more solar energy than any other utility in the nation.

20 22. As a result of Edison’s targeted, community-conscious growth, and its
21 strong, customer-oriented service, Edison is now a large, famous company. In 2016,
22 Edison had revenues of almost \$12 billion and approximately 12,400 full-time
23 employees. Through SCE, Edison currently serves about 15 million people in a
24 50,000 square-mile service area in Central and Southern California, covering about
25 430 cities, and plans to invest billions over the next three years to expand and
26 strengthen California’s electric system and infrastructure.

1 23. EIX’s and SCE’s reputations, and the impact of the companies on the
2 everyday lives of Californians, is undeniable and has helped develop a substantial
3 amount of goodwill in the Edison Marks. Edison’s activities have also received
4 substantial national news coverage, including from the New York Times,
5 <http://www.nytimes.com/2009/02/12/science/earth/12solar.html>, and CNBC,
6 [https://www.cnn.com/2017/09/22/in-california-a-major-utility-is-teaming-up-with-
7 tesla-to-boost-the-staying-power-of-renewables.html](https://www.cnn.com/2017/09/22/in-california-a-major-utility-is-teaming-up-with-tesla-to-boost-the-staying-power-of-renewables.html).

8 **THE EDISON MARKS**

9 24. EIX and SCE are the lawful owners of numerous federal trademark
10 registrations and applications for the Edison Marks, including the following registered
11 trademarks and applications that Edison collectively owns in whole or in part:
12 Registration Nos. 4735589, 4491677, 4455232, 4367461, 3769254, 2409730,
13 1862786, 1496165, 1459556, and 2102608, and Application Serial Nos. 87507681
14 and 87507961. These registrations cover a wide range of goods and services,
15 including generating and transmitting electricity, providing information in the fields of
16 energy use and load management, and promoting public awareness regarding the need
17 for conservation of energy. In other words, these registrations cover the type of goods
18 and services that Defendant is purporting to provide to consumers.

19 25. Specifically, the Edison Marks include the names “SCE” and
20 “SOUTHERN CALIFORNIA EDISON,” and the famous green and yellow sunburst
21 logo, which is often used in conjunction with trademarked names in the following
22 manner:



1 26. Edison has engaged consumers and provided high-quality goods and
2 services bearing the Edison Marks since the early 1900s and has promoted those
3 goods and services extensively through numerous channels of trade. Because of the
4 prominence and everyday ubiquity of Edison’s name and businesses, and all of
5 Edison’s related advertisements, services, and products, the Edison Marks have
6 become widely known to the public, both in California and across the United States,
7 to refer to EIX and SCE. Substantial goodwill has developed in the Edison Marks and
8 in the goods and services offered by Edison. The Edison Marks are inherently
9 distinctive and are inextricably connected to the services and products Edison
10 provides.

11 **DEFENDANT’S INFRINGING USE**

12 27. Since at least 2016, Defendant has been marketing and selling its
13 residential solar products in Southern California by using the Edison Marks without
14 Edison’s permission. In multiple ways, through its deceptive and misleading sales
15 practices, Defendant has sought to benefit from the goodwill and reputation that
16 Edison has painstakingly built over 100 years in connection with the delivery of
17 energy to millions of Californians. SCE has received numerous calls and online
18 complaints from its customers all over Southern California – from Santa Barbara to
19 Riverside to Orange County – concerning misleading sales practices by Defendant’s
20 representatives who associate themselves verbally and visually with Edison while
21 using aggressive, off-putting sales tactics. Specifically, SCE’s customers have
22 complained of the following types of behavior by Defendant:

- 23 • Defendant’s sales representatives repeatedly telling Edison’s customers that
24 they are “from” Edison, “affiliated with” Edison, or in “partnership with”
25 Edison in order to gain customers’ trust;

- 1 • Defendant’s sales representatives displaying counterfeit Edison trademarks
2 and logos on paperwork that they show to customers in the course of their
3 solicitations;
- 4 • Defendant’s sales representatives wearing clothing bearing counterfeit
5 Edison Marks in an attempt to create a false association between Defendant
6 and Edison;
- 7 • Defendant’s sales representatives using claims of their alleged association
8 with Edison as an excuse to enter customers’ property and obtain
9 information from their electricity meter or billing statement;
- 10 • Defendant’s sales representatives becoming belligerent or agitated after
11 customers challenge Defendant’s association with Edison; and
- 12 • Defendant’s sales representatives soliciting elderly individuals for business
13 and misleading them about Defendant’s association with Edison.

14 28. Below are several specific examples of Defendant’s recent misconduct as
15 reported by SCE customers:

- 16 • On June 2, 2017, two Vivint representatives knocked on an SCE customer’s
17 door in East Chino, California. Video footage captured by the customer’s
18 doorbell camera shows that one of the representatives claimed to be “from
19 Edison” and insisted that he was there to “fill out” the customer’s “forms.”
20 The Vivint representatives sought to enter the customer’s house, and the
21 customer later filed a police report documenting the representatives’
22 aggressive behavior.
- 23 • On July 14, 2017, a Vivint Solar representative solicited an SCE customer in
24 Huntington Beach, California. The representative had a prominent patch
25 bearing Edison’s sunburst logo and the name “Southern California Edison”
26 on the upper right corner of his shirt. The customer allowed the

1 representative to enter her back yard and check her electricity meter because
2 she believed he was with Edison.

- 3 • On September 19, 2017, a Vivint representative solicited an SCE customer
4 in Santa Barbara, California, by claiming to be “in partnership” with
5 “Southern California Edison.” The customer provided the Vivint
6 representative access to his electricity meter and his personal identifying
7 information because of the Vivint representative’s claimed connection to
8 SCE.

9 29. Defendant has been on notice of its representatives’ misconduct since at
10 least July 2016, when SCE personnel began notifying Defendant of its representatives’
11 use of the Edison Marks and the complaints received from customers regarding
12 Defendant’s conduct. SCE has been in contact with Defendant since that time, and
13 has repeatedly raised concerns regarding Defendant’s misleading sales practices. SCE
14 communicated directly with Defendant’s District Sales Manager for Southern
15 California regarding Defendant’s misleading practices, and informed him about the
16 customer complaints received by SCE in connection with such practices. SCE also
17 repeatedly notified Defendant’s Sales Process and Interconnection Supervisor for
18 Southern California about Defendant’s misconduct, who promised on numerous
19 occasions to “elevate the issue” to his superiors. Thus, on information and belief,
20 Defendant’s officers, directors, and managing agents knew about and approved, either
21 explicitly or implicitly by inaction, the wrongful conduct at issue.

22 30. On information and belief, Defendant also engages and directs third party
23 marketing and sales firms to contact consumers on its behalf. Edison is informed and
24 believes that Defendant has a principal-agent relationship with these firms, and
25 Defendant has been on notice of their activities since at least July 2016. Because
26 Defendant did not terminate its principal-agency relationship with these marketing

1 firms even after receiving notice of their unauthorized and infringing use of the
2 Edison Marks, Defendant's use of and adoption of the Edison Marks was willful.
3 Defendant is vicariously liable for the infringement and other illegal conduct of its
4 marketing and sales firms.

5 31. Defendant's misleading and unauthorized use of the Edison Marks
6 can and does cause harm to Edison. Defendant's sales tactics have disturbed many
7 SCE customers, and the confusion and mistrust generated by Defendant's
8 infringing and diluting acts has harmed, and will continue to harm, Edison's
9 reputation and its ability to conduct business. Defendant's misrepresentations and
10 misuse of the Edison Marks creates a substantial risk that customers will attribute
11 to Edison the aggressive behavior of Defendant's agents and representatives.
12 Defendant's misrepresentations also create a substantial risk that customers in the
13 future will distrust anyone who identifies himself or herself as an Edison
14 representative, undermining Edison's ability to perform certain legitimate business
15 functions, such as entering customers' property to perform necessary inspections or
16 repairs. SCE customers who have signed contracts with Defendant based on their
17 mistaken belief that Defendant is associated with Edison may blame Edison for
18 Edison's inability to address future problems they experience with Defendant.
19 Because of Defendant's unlawful and intimidating sales practices, and based on
20 reports made by them, SCE's customers have been confused and uncomfortable
21 and have even feared for their safety due to the conduct of Defendant and its
22 agents, as described herein.

1 **FIRST CLAIM FOR RELIEF**

2 **Federal Trademark Infringement**

3 **15 U.S.C. § 1114**

4 32. Edison repeats, realleges, and incorporates herein by reference each and
5 every allegation contained in paragraphs 1 through 31.

6 33. Edison's registered Edison Marks have become well known and famous.
7 This is a result of both the Edison Marks' inherent distinctiveness, as well as the
8 extensive advertising and sales of goods and services bearing the Edison Marks, as
9 identified in paragraph 18 above.

10 34. As described above in detail, Defendant is using in commerce, without
11 Edison's authorization or consent and in an explicitly misleading manner, the Edison
12 Marks in connection with the advertisement, offering for sale, and/or sale of
13 Defendant's products and services. Edison is informed and believes, and on that basis
14 alleges, that Defendant is doing so with the intent to unfairly compete against other
15 solar contractors, to trade upon Edison's reputation and goodwill by causing
16 confusion and mistake among customers and the public, and to deceive the public into
17 believing that Defendant's products and services are associated with, sponsored by, or
18 approved by Edison, when they are not. Defendant's unauthorized use of imitations
19 of Edison's registered Edison Marks, or confusingly similar variations of the Edison
20 Marks, is likely to cause confusion, mistake, or deception in violation of
21 15 U.S.C. § 1114.

22 35. Defendant's acts complained of herein were willful and deliberate and
23 have caused harm to Edison and its customers. Because of Defendant's ongoing
24 unlawful actions, Edison is entitled to an injunction to prevent Defendant from
25 continuing its wrongful actions.
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SECOND CLAIM FOR RELIEF
Federal Trademark Counterfeiting
15 U.S.C. § 1114 & 1116(d)

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36. Edison repeats, realleges, and incorporates herein by reference each and every allegation contained in paragraphs 1 through 35.

37. Edison’s registered Edison Marks have become well known and famous. This is a result of both the Edison Marks’ inherent distinctiveness, as well as the extensive advertising and sales of goods and services bearing the Edison Marks.

38. As described above, Defendant has used a spurious mark, without authorization from Edison, that is identical to or substantially indistinguishable from Edison’s registered Edison Marks, listed above in paragraph 18, and which constitutes use of a counterfeit mark in violation of 15 U.S.C. § 1114.

39. The Edison Marks are registered for use on some of the same goods and services with which Defendant has used the counterfeit marks. These goods and services include generating and transmitting electricity, providing information in the fields of energy use and load management, and promoting public awareness regarding the need for conservation of energy. However, neither EIX nor SCE competes with Vivint in the residential solar energy market.

40. In light of the foregoing, Edison is entitled to injunctive relief prohibiting Defendant from using the Edison Marks or any marks identical and/or confusingly similar thereto for any purpose. Edison is also entitled to attorneys’ fees and statutory damages pursuant to 15 U.S.C. § 1117(c).

THIRD CLAIM FOR RELIEF

False Designation of Origin

15 U.S.C. § 1125(a)(1)(A)

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4 41. Edison repeats, realleges, and incorporates herein by reference each and
5 every allegation contained in paragraphs 1 through 40.

6 42. The Edison Marks and the Edison name are used in commerce, are non-
7 functional, are distinctive, and have acquired substantial secondary meaning in the
8 marketplace.

9 43. As described above in detail, Defendant is using in commerce, without
10 Edison's authorization or consent and in an explicitly misleading manner, imitations
11 of the Edison Marks and the Edison name, in connection with the advertisement,
12 offering for sale, and/or sale of Defendant's products and services. Defendant's
13 actions described above constitute false designation of origin in violation of 15 U.S.C.
14 § 1125(a)(1)(A).

15 44. Edison is informed and believes, and on that basis alleges, that Defendant
16 had actual knowledge of Edison's ownership and prior use of the Edison Marks and
17 the Edison name before commencing the conduct complained of herein.

18 45. Edison is informed and believes, and on that basis alleges, that Defendant
19 is engaging in the conduct complained of herein with the intent to compete unfairly
20 against other solar providers, to trade upon Edison's reputation and goodwill by
21 causing confusion and mistake among customers and the public, and to deceive the
22 public into believing that Defendant's products are associated with, sponsored by, or
23 approved by Edison, when they are not.

24 46. As a result of the acts complained of herein, Defendant has created a
25 likelihood of injury to Edison's business reputation and to the reputation and goodwill
26 surrounding the Edison Marks and the Edison name, and a strong likelihood of

1 consumer confusion as to the source, origin, or relationship of Defendant's and
2 Edison's goods and services. Edison customers have specifically told Edison that,
3 because of Defendant's misconduct, they are wary of anyone claiming to be from
4 Edison entering their property, thereby harming Edison's ability to perform legitimate
5 and necessary business functions.

6 47. Defendant's acts complained of herein were willful and deliberate and
7 have caused harm to Edison and its customers, and such harm will continue to
8 increase unless Defendant is enjoined from its wrongful actions.

9 **FOURTH CLAIM FOR RELIEF**

10 **Federal Trademark Dilution**

11 **15 U.S.C § 1125(c)**

12 48. Edison repeats, realleges, and incorporates herein by reference each and
13 every allegation contained in paragraphs 1 through 47.

14 49. By virtue of the decades of use and the extensive public awareness of
15 Edison and its goods and services, the Edison Marks are famous among consumers
16 and became famous long before Defendant's use of the Edison Marks.

17 50. Defendant's use of the famous Edison Marks, or nearly identical and
18 confusingly similar variations thereof, in advertising and selling its products and
19 services, is and has been for Defendant's own commercial gain.

20 51. Defendant's use of the famous Edison Marks, or nearly identical and
21 confusingly similar variations thereof, in advertising its products and services dilutes
22 the distinctive quality of the Edison Marks and is likely to cause actual dilution of the
23 Edison Marks, thereby impairing the Edison Marks' capability of identifying and
24 distinguishing Edison's, or its licensees,' goods and services.

25 52. Defendant's use of the famous Edison Marks, or nearly identical and
26 confusingly similar variations thereof, in advertising for its products and services, has

1 also tarnished the famous Edison Marks by creating an association between the Edison
2 Marks and the aggressive, intimidating, and off-putting behavior of Defendant's
3 representatives.

4 53. Defendant's acts complained of herein were willful and deliberate and
5 have caused harm to Edison and its customers, and such harm will continue to
6 increase unless Defendant is enjoined from its wrongful actions.

7 **FIFTH CLAIM FOR RELIEF**

8 **Federal False Advertising**

9 **15 U.S.C. § 1125(a)(1)(B)**

10 54. Edison repeats, realleges, and incorporates herein by reference each and
11 every allegation contained in paragraphs 1 through 53.

12 55. Defendant's actions described above and specifically, without limitation,
13 Defendant's unauthorized use of the Edison Marks and the Edison name, and
14 confusingly similar variations thereof, in commerce to advertise, market, and sell its
15 products and services, and its express and/or implied representations that its products
16 and services originated with or are associated with or endorsed or approved by Edison,
17 constitute false advertising in violation of 15 U.S.C. § 1125(a)(1)(B).

18 56. Defendant knew or should have known that its representations and
19 conduct were false and/or likely to mislead consumers.

20 57. Defendant's acts complained of herein were willful and deliberate and
21 have caused harm to Edison and its customers, and such harm will continue to
22 increase unless Defendant is enjoined from its wrongful actions.

23 **SIXTH CLAIM FOR RELIEF**

24 **California Common Law Passing Off**

25 58. Edison repeats, realleges, and incorporates herein by reference each and
26 every allegation contained in paragraphs 1 through 57.

1 59. By virtue of the acts complained of herein, Defendant intentionally
2 caused a likelihood of confusion among the public in violation of the common law of
3 the State of California.

4 60. The purpose, tendency, and effect of Defendant's unauthorized use of the
5 Edison Marks, or confusingly similar variations thereof, in the manner alleged above,
6 is to enable Defendant to deceive the public by passing off Defendant's products and
7 services as being produced, sponsored, endorsed, or otherwise approved by or
8 connected with Edison.

9 61. Defendant's use of the Edison Marks, or confusingly similar variations
10 thereof, in advertising and offering to sell its products and services, is likely to cause
11 confusion, mistake, or deception as to the source or origin of Defendant's products
12 and services, and said use constitutes infringement of Edison's rights with respect to
13 the Edison Marks and the Edison name.

14 62. Defendant's acts complained of herein were willful and deliberate and
15 have caused harm to Edison and its customers, including at least nominal damages,
16 and such harm will continue to increase unless Defendant is enjoined from its
17 wrongful actions.

18 63. Defendant's officers, managers, and/or directors were fully aware of
19 Defendant's wrongful, misleading and aggressive sales tactics that have confused,
20 angered, and frightened Edison's customers. By failing to take action to address these
21 sales practices given their knowledge of the wrongful conduct, Defendant's officers,
22 managers, and/or directors approved of the conduct and willfully allowed it to
23 continue.

24 64. Defendant's willful acts constitute acts of fraud, oppression, and malice.
25 Accordingly, Edison is entitled to exemplary and punitive damages pursuant to
26

1 California Civil Code § 3294(a). Edison is also entitled to attorneys' fees pursuant to
2 California Code of Civil Procedure § 1021.5.

3 **SEVENTH CLAIM FOR RELIEF**

4 **California Statutory Trademark Dilution**

5 **Cal. Business & Professions Code § 14247, et seq.**

6 65. Edison repeats, realleges, and incorporates herein by reference each and
7 every allegation contained in paragraphs 1 through 64.

8 66. By virtue of the decades of use and the extensive public awareness of
9 Edison and its goods and services, and the advertising and promotion of Edison and of
10 products and services bearing the Edison Marks, the Edison Marks are famous among
11 consumers in California.

12 67. Defendant's use of the famous Edison Marks, as well as confusingly
13 similar and near-identical variations thereof, in advertising and when selling its
14 products and services is, and has been, for Defendant's own gain.

15 68. Defendant's use of the famous Edison Marks, as well as confusingly
16 similar and near-identical variations thereof, in advertising and selling its products and
17 services, dilutes the distinctive quality of the Edison Marks and is likely to cause
18 actual dilution of the Edison Marks, thereby impairing the Edison Marks' capability of
19 identifying and distinguishing Edison's, or its licensees,' goods and services.

20 69. Defendant's use of the famous Edison Marks, or nearly identical and
21 confusingly similar variations thereof, in advertising its products and services, has
22 also tarnished the famous Edison Marks by creating an association between the Edison
23 Marks and the aggressive, intimidating, and off-putting behavior of Defendant's
24 representatives.

25 70. Defendant's acts complained of herein were willful and deliberate and
26 have caused harm to Edison and its customers, and such harm will continue to

1 increase unless Defendant is enjoined from its wrongful actions. Edison is also
2 entitled to attorneys' fees pursuant to California Code of Civil Procedure § 1021.5.

3 **PRAYER FOR RELIEF**

4 WHEREFORE, Edison prays for judgment against Defendant as follows:

5 A. For entry of a preliminary and permanent injunction prohibiting
6 Defendant and each of its agents, servants, owners, shareholders, partners, employees,
7 attorneys, assigns, and all others in privity or acting in concert with it, from
8 committing further infringing acts including:

9 a. Using any title, name, service mark, trademark, trade name, or
10 domain name that includes or is confusingly similar to any of the Edison Marks;

11 b. Registering or attempting to register, or pursuing any pending
12 application to register, any trade name, trademark or service mark that includes
13 or is confusingly similar to any of the Edison Marks;

14 c. Otherwise infringing or diluting Edison's trademarks, service
15 marks, and trade names, or otherwise injuring Edison's business reputation in
16 any manner.

17 B. For an order directing Defendant to deliver up for destruction all
18 merchandise, products, and other tangible items in its possession or under its control
19 that use the Edison Marks, or any confusingly similar variation thereof.

20 C. That the Court award Edison at least nominal damages, and award Edison
21 exemplary or punitive damages to the extent permitted by law.

22 D. That the Court award Edison statutory damages for trademark
23 counterfeiting pursuant to 15 U.S.C. § 1117(c).

1 E. For an award of the costs of suit, attorneys’ fees, pre-judgment interest
2 and such other and further relief as the Court deems just and proper.

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DATED: November 16, 2017

Respectfully submitted,

/s/ Andrew J. Thomas
Andrew J. Thomas
JENNER & BLOCK LLP

Attorneys for Plaintiffs

JURY DEMAND

Edison hereby demands trial by jury on all issues so triable.

DATED: November 16, 2017

Respectfully submitted,

/s/ Andrew J. Thomas

Andrew J. Thomas
JENNER & BLOCK LLP

Attorneys for Plaintiffs

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