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

GIANNI VERSACE S.R.L.,

Plaintiff,

- against -

FASHION NOVA, INC.,

Defendant.

Case No. 2:19-cv-10074-PA-RAO

**COUNTERCLAIMS FOR  
DECLARATION OF NON-  
INFRINGEMENT AND  
INVALIDITY**

District Judge: Percy Anderson  
Complaint Filed: Nov. 25, 2019

For its counterclaims against Gianni Versace S.r.l. (hereinafter, “Versace”), Counterclaimant, Fashion Nova, Inc. (hereinafter, “Fashion Nova”), alleges on knowledge as to its own conduct and on information and belief as to all other matters, as follows:

**Jurisdiction and Venue**

1  
2 1. These Counterclaims arise out of the causes of actions asserted in the  
3 Complaint, and further arise under the Federal Declaratory Judgment Act, 28  
4 U.S.C. §§ 2201 *et seq.*

5 2. This Court has original jurisdiction over this action pursuant to 28  
6 U.S.C. §§ 1331 and 1338, and 15 U.S.C. § 1121.

7 3. This Court has personal jurisdiction over Versace because, by filing  
8 its Complaint in this Court, Versace has consented to personal jurisdiction in this  
9 District.

10 4. Venue is proper in this District under 28 U.S.C. § 1391.

**Facts Common To All Counts**

11  
12 5. Fashion Nova is a global fashion brand and leader in the fast-fashion  
13 and e-commerce apparel industries.

14 6. Fashion Nova was established in 2006, with a single retail mall store  
15 in the San Fernando Valley in Los Angeles, California. Adhering to the mantra  
16 that women of all colors and sizes can wear sexy, body-conscious clothing,  
17 Fashion Nova has achieved tremendous notoriety and success and grown to a  
18 highly successful business. Today, Fashion Nova markets and sells a diverse  
19 range of lifestyle clothing and accessories for men, women, and children, with six  
20 retail stores in major shopping malls throughout Southern California, a dynamic  
21 consumer website located at [www.FashionNova.com](http://www.FashionNova.com) selling its products

1 nationally and internationally with new offerings daily, and substantial marketing  
2 on its frequently-updated social media feeds, including on the social media  
3 platforms Facebook, Instagram, Twitter, Pinterest, Snapchat, and YouTube.

4 7. In particular, the explosive growth of Fashion Nova's social media  
5 accounts has spurred its consumer reach and catapulted its ongoing sales growth.  
6 Fashion Nova's social media presence today includes more than 17 million  
7 followers on Instagram, nearly 2.5 million followers on Facebook, and over  
8 146,000 followers on Twitter, and continues to grow.

9 8. Fashion Nova has also achieved international acclaim and recognition  
10 through its partnerships and/or endorsements from celebrities such as platinum-  
11 selling rapper Cardi B.

12 9. As a result of its substantial marketing and promotional activities and  
13 the avid popularity of its products among the public, in 2018, Fashion Nova was  
14 the #1 most searched fashion label on Google

15 10. As part of its business, Fashion Nova developed the trade name  
16 "Fashion Nova", and the stylized logo "FASHIONNOVA" as depicted below  
17 (collectively, the "Fashion Nova Marks"), to identify it as the source of its  
18 products:

19  
20 FASHIONNOVA  
21

11. Fashion Nova is the owner of numerous U.S. Trademark Registrations and pending U.S. Trademark Applications filed with the U.S. Patent and Trademark Office (the “USPTO”) for the Fashion Nova Marks, including:

[b] U.S. Trademark Reg. No. 4,785,854, issued by the USPTO in August 4, 2015, for “Blouses; Dresses; Pants” in International Class 25;

[d] U.S. Trademark Reg. No. 5,276,297, issued by the USPTO on August 29, 2017, for “Jewelry” in International Class 14;

[f] U.S. Trademark Reg. No. 5,591,086, issued by the USPTO on October 23, 2018, for “Downloadable computer software for the exhibition and sale of consumer merchandise” in International Class 9;

1 [g] U.S. Trademark Reg. No. 5,869,081, issued by the USPTO on  
2 September 24, 2019, for “Blouses; Bodysuits; Bottoms as clothing; Dresses; Hats;  
3 Jackets; Jumpsuits; Leggings; Pants; Rompers; Shirts; Shorts; Skirts; Sweaters;  
4 Undergarments” in International Class 25;

5 [h] U.S. Trademark Reg. No. 5,886,070, issued by the USPTO on  
6 October 15, 2019, for “Computerized on-line ordering featuring general consumer  
7 merchandise; Computerized on-line ordering services in the field of apparel,  
8 fashion accessories, jewelry, and footwear; On-line retail store services featuring  
9 apparel, fashion accessories, jewelry, and footwear” in International Class 35;

10 [i] Pending U.S. Trademark App. No. 87324722, filed by Fashion  
11 Nova with the USPTO on February 4, 2017 and published for opposition by the  
12 USPTO on June 13, 2017, for “Cosmetics” in International Class 3.

13 12. As a result of Fashion Nova’s widespread use and extensive  
14 promotion, marketing, advertising, and use of the Fashion Nova Marks, the  
15 Fashion Nova Marks have become famous, and are nationally and intentionally  
16 recognized as associated with the fast-fashion, e-commerce brand.

17 13. At all relevant times, Fashion Nova’s advertising and marketing,  
18 including all social media marketing, relating to the accused products at issue in  
19 the Complaint prominently displayed one or both of the Fashion Nova Marks,  
20 clearly designating Fashion Nova as the source of the products.

1           14. Furthermore, Fashion Nova did not itself design and produce the  
2 accused products at issue in the Complaint, but rather procured them from U.S.-  
3 based vendors that represented to Fashion Nova that the accused designs – the  
4 designs with respect to which Versace has claimed to own rights in this action –  
5 were obtained from a Korean company which claimed to be the original creator  
6 and copyright-owner of the designs. As such, Fashion Nova has acted innocently  
7 at all relevant times to this action, under the good faith belief that it was duly  
8 authorized to market and sell the products at issue by the rights-owner thereof.

9           15. Based on Versace’s continued accusations and demands concerning  
10 the accused products at issue in its Complaint, there is an actual controversy  
11 between Fashion Nova and Versace in that Versace contends that the accused  
12 products at issue in its Complaint infringes, dilutes, and/or otherwise violates  
13 copyright, trademark, trade dress, and/or other common law rights allegedly  
14 owned by Versace, and Fashion Nova contends that they do not.

15                                   **FIRST COUNTERCLAIM**  
16                                   **(Declaration of Non-Infringement)**  
   **(28 U.S.C. § 2201 et seq.)**

17           16. Fashion Nova repeats and incorporates by reference the allegations  
18 set forth in all prior paragraphs of the Counterclaims as though fully set forth  
19 herein.

20           17. An actual case or controversy exists between the parties by virtue of  
21 Versace’s Complaint against Fashion Nova, in which Versace alleged that Fashion

1 Nova infringes, dilutes, and/or otherwise violates copyright, trademark, trade  
2 dress, and common law rights allegedly owned by Versace by Fashion Nova's  
3 alleged design, manufacture, production, marketing, promotion, offer for sale,  
4 sale, and distribution of certain apparel products.

5 18. Fashion Nova has denied all liability to Versace with respect to all  
6 matters alleged in the Complaint.

7 19. Based on the foregoing allegations, there exists between the parties a  
8 substantial controversy of sufficient immediacy and reality to warrant declaratory  
9 relief.

10 20. Fashion Nova's alleged design, manufacture, production, marketing,  
11 promotion, offer for sale, sale, and distribution of the accused apparel products  
12 identified in the Complaint do not infringe, dilute, or violate any copyright,  
13 trademark, trade dress, or common law rights owned by Versace.

14 21. Fashion Nova is therefore entitled to a judicial determination that the  
15 accused apparel products identified in the Complaint do not infringe, dilute, or  
16 violate any copyright, trademark, trade dress, or common law rights owned by  
17 Versace.

**SECOND COUNTERCLAIM**  
**(Declaration of Copyright Registration Invalidity)**  
**(28 U.S.C. § 2201 *et seq.*; 17 U.S.C. § 411[b])**

22. Fashion Nova repeats and incorporates by reference the allegations set forth in all prior paragraphs of the Counterclaims as though fully set forth herein.

23. An actual case or controversy exists between the parties by virtue of Versace's pre-litigation allegations of copyright infringement against Fashion Nova beginning in approximately July 2019, and the Complaint for, *inter alia*, copyright infringement filed by Versace against Fashion Nova.

24. In its Complaint and pre-litigation allegations of copyright infringement, Versace alleged that Fashion Nova has infringed copyright rights in six works of 2-d art allegedly owned by Versace (collectively, the "Works At Issue").

25. Upon information and belief, Versace applied to register copyright claims for the Works At Issue with the U.S. Copyright Office in October 2019 – months after first accusing Fashion Nova of infringing its alleged copyright rights in and to the Works At Issue.

26. Upon information and belief, in its copyright applications for the Works At Issue, Versace claimed that it is the exclusive copyright claimant of the Works At Issue, and that the Works At Issue are each original works of authorship



1 created by Gianni Versace, who subsequently transferred the copyrights thereto to  
2 Versace by written agreement.

3 27. The Copyright Office subsequently issued copyright registrations for  
4 the Works At Issue, naming Versace as copyright claimant, under U.S. Copyright  
5 Registration Nos. VA 2-176-201, VA 2-173-519, VA 2-175-854, VA 2-176-199,  
6 VA 2-176-205, and VA 2-176-545 (collectively, the “Versace Copyright  
7 Registrations”).

8 28. Upon information and belief, the Works At Issue are not original  
9 works of authorship created by Gianni Versace, the individual identified as the  
10 works’ author by Versace in its copyright applications for the Works At Issue.

11 29. Upon information and belief, at the time it filed its copyright  
12 applications underlying the Versace Copyright Registrations with the U.S.  
13 Copyright Office, Versace knew that the Works At Issue are not original works of  
14 authorship created by Gianni Versace, the individual identified in the applications  
15 as the author of the works.

16 30. Upon information and belief, in its copyright applications filed with  
17 the U.S. Copyright Office, Versace knowingly misrepresented that the Works At  
18 Issue are original works of authorship created by Gianni Versace, the individual  
19 identified in the applications as the author of the works, when in fact that is not the  
20 case.

1           31. Upon information and belief, had the U.S. Copyright Office been  
2 correctly informed that the Works At Issue are not original works of authorship  
3 created by Gianni Versace, the individual Versace identified as the author of the  
4 Works At Issue in the applications underlying the Versace Copyright  
5 Registrations, the Copyright Office would have refused to register the Works At  
6 Issue in Versace's name under the Versace Copyright Registrations.

7           32. As a result, pursuant to 17 U.S.C. § 411, the Versace Copyright  
8 Registrations are invalid and incapable of supporting Versace's copyright claims  
9 as to the Works At Issue.

10           33. Fashion Nova therefore seeks a judicial determination that the  
11 Versace Copyright Registrations are invalid and incapable of supporting Versace's  
12 copyright claims as to the Works At Issue, and seeks a judgment directing Versace  
13 to request the Register of Copyrights to cancel the Versace Copyright  
14 Registrations.

15                           **FASHION NOVA'S PRAYER FOR RELIEF**

16           WHEREFORE, Fashion Nova respectfully requests that the Court enter  
17 judgment in its favor as follows:

18           (a) That the Complaint and each and every purported claim for relief  
19 therein be dismissed with prejudice;

20           (b) That the Court issue a declaration that Fashion Nova's accused  
21 apparel products identified in the Complaint do not:

- 1 [i] infringe upon any copyright rights of Versace or otherwise  
2 violate the U.S. Copyright Act, 17 U.S.C. § 101 *et seq.*;
- 3 [ii] infringe upon any trademark or trade dress rights of Versace or  
4 on any common law rights Versace may have accrued;
- 5 [iii] violate any of Sections 32, 43(a), or 43(c) of the Lanham Act  
6 [15 U.S.C. §§ 1114, 1125(a), 1125(c)];
- 7 [iv] dilute any trademark or trade dress owned by Versace under  
8 the California anti-dilution statute [Cal. & Bus. Prof. Code §  
9 14247] or the anti-dilution law of any other state;
- 10 [v] constitute unfair competition under the common law of any  
11 state; or
- 12 [vi] constitute unfair and deceptive trade practices under the  
13 California Unfair Business Practices Act [Cal. & Bus. Prof.  
14 Code §§ 17200 *et seq.*] or the unfair and deceptive trade  
15 practices law of any other state.

16 (c) That the Court issue a declaration that the Versace Copyright  
17 Registrations are invalid and incapable of supporting Versace's copyright claims  
18 as to the Works At Issue;

19 (d) That the Court direct Versace to request the Register of Copyrights to  
20 cancel the Versace Copyright Registrations;

1 (e) That the Court award Fashion Nova its attorneys' fees, costs, and  
2 disbursements in accordance with 17 U.S.C. § 505;

3 (f) That the Court determine that this is an exceptional case under 15  
4 U.S.C. § 1117(a) and award Fashion Nova its attorneys' fees, costs, and  
5 disbursements in accordance therewith; and,

6 (g) That the Court award Fashion Nova such other and further relief as  
7 the Court deems just and proper.

8  
9 Dated: Los Angeles, CA  
January 9, 2020

10 Respectfully submitted,

11 /s/ *John F. Olsen*

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21 *Counsel for Fashion Nova, Inc.*

**PROOF OF SERVICE**

I hereby certify that on January 9, 2020, the foregoing COUNTERCLAIMS was filed electronically. Notice of this filing will be sent to all parties by operation of the Court's electronic filing system. Parties may access this filing through the Court's system.

/s/ *John F. Olsen*

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John F. Olsen