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

HONG KONG YU'EN E-COMMERCE CO. LIMITED, Plaintiff, v. THE INDIVIDUALS, CORPORATIONS, LIMITED LIABILITY COMPANIES, PARTNERSHIPS AND UNINCORPORATED ASSOCIATIONS IDENTIFIED IN SCHEDULE "A" HERETO, Defendants.	**Case No. 1:24-cv-12483-EEB-MDW** **Honorable Judge Elaine E. Bucklo** **Magistrate M. David Weisman**

PLAINTIFF'S RESPONSE IN OPPOSITION TO DEFENDANT FUNLINGO'S MOTION TO DISMISS

Plaintiff HONG KONG YU'EN E-COMMERCE CO. LTD., ("Plaintiff"), by and through its counsel, the Bayramoglu Law Offices, LLC, opposes the Motion to Dismiss filed by Defendant Funlingo ("Defendant"). In support of its Opposition, Plaintiff states as follows:

I. INTRODUCTION

Defendant seeks to dismiss Plaintiff's claims against it by challenging the sufficiency of Plaintiff's First Amended Complaint (the "Complaint") [Dkt. No. 27], alleging it was improperly joined and that service of process was improper. However, when viewed in light of the proper case law and legal standards, the Complaint has stated substantial and sufficient allegations to overcome Defendant's request fo dismissal under Rule 12(b)(6). Defendant's further request to dismiss Plaintiff's claims under Rule 20(a)(2) and for lack of proper service should likewise be denied, consistent with the decisions in this judicial district.

II. APPLICABLE LEGAL STANDARDS

A. Rule 12(b)(6) Standards.

A motion to dismiss under Federal Rule of Civil Procedure 12(b)(6) challenges the sufficiency of the complaint, not its merits. *Gibson v. City of Chicago*, 910 F.2d 1510, 1520 (7th Cir. 1990). In considering a Rule 12(b)(6) motion, the Court accepts as true all well-pleaded facts in a complaint and draws all reasonable inferences from those facts in the plaintiff's favor. *See Kubiak v. City of Chicago*, 810 F.3d 476, 480-81 (7th Cir. 2016). To survive a Rule 12(b)(6) motion, the complaint must assert a facially plausible claim and provide fair notice to the defendant of the claim's basis. *Ashcroft v. Iqbal*, 556 U.S. 662, 678 (2009); *Bell Atl. Corp. v. Twombly*, 550 U.S. 544, 555 (2009); *Adams v. City of Indianapolis*, 742 F.3d 720, 728-29 (7th Cir. 2014). A claim is facially plausible "when the plaintiff pleads factual content that allows the court to draw the reasonable inference that the defendant is liable for the misconduct alleged." *Iqbal*, 556 U.S. at 678. As demonstrated below, Plaintiff's allegations for trademark infringement and injunctive relief meet these standards.

B. Rule 20(a)(2) Standards.

Under Federal Rule of Civil Procedure 20(a)(2), a plaintiff is required to demonstrate that joinder is appropriate. *See Ilustrata Servicos Design, Ltda. v. P'ships & Unincorporated Ass'ns Identified on Schedule "A"*, No. 21-CV-05993, 2021 WL 5396690, at *1 (N.D. Ill. Nov. 18, 2021); *NFL Properties LLC v. P'ships & Unincorporated Ass'ns Identified on Schedule "A"*, No. 21-CV-05522, 2021 WL 4963600, at *1 (N.D. Ill. Oct. 26, 2021); *H-D U.S.A., LLC v. P'ships & Unincorporated Ass'ns Identified on Schedule "A",* No. 21-CV-01041, 2021 WL 780486, at *1 (N.D. Ill. Mar. 1, 2021); *see also Estée Lauder Cosms. Ltd.*, 334 F.R.D. at 185. "'In assessing whether the requirements of Rule 20(a)(2) are met, courts must accept the factual allegations in a plaintiff's complaint as true.'" (quoting *Desai v. ADT Sec. Servs., Inc.*, No. 11 C 1925, 2011 WL 2837435, at *3 (N.D. Ill. July 18, 2011).

Rule 20(a)(2) allows defendants to be joined in the same action if: (1) the claims against them are asserted "with respect to or arising out of the same transaction, occurrence, or series of transactions or occurrences," and (2) there is a "question of law or fact common to all defendants." Fed. R. Civ. P. 20(a)(2)(A)–(B). To decide "whether the rights asserted arise out of the same transaction or occurrence, courts should 'consider the totality of the claims, including the nature of the claims, the legal basis for recovery, the law involved, and the respective factual backgrounds.'" *Estée Lauder*, 334 F.R.D. at 185 (quoting *Ross ex rel. Ross v. Bd. of Educ. of Twp. High Sch. Dist. 211*, 486 F.3d 279, 284 (7th Cir. 2007)).

C. Legal Standards for Service of Process

Federal Rule of Civil Procedure 4(h)(2) permits service of process on a corporation outside the United States as prescribed by Rule 4(f). Rule 4(f)(1) allows for service "by any internationally agreed means of service[,]" including procedures "authorized by the Hague Convention on the Service Abroad of Judicial and Extrajudicial Documents," and Rule 4(f)(3) permits service "by other means not prohibited by international agreement, as the court orders."

Rule 4(f)(3) allows a court to order service through a variety of methods, "including publication, ordinary mail, mail to the defendant's last known address, delivery to the defendant's attorney, telex, and most recently, email," provided there is no international agreement directly to the contrary. *Rio Props., Inc. v. Rio Intern. Interlink*, 284 F.3d 1007, 1016 (9th Cir. 2002). However, to comport with due process, "the method of service crafted by the district court must be 'reasonably calculated, under all the circumstances, to apprise interested parties of the pendency of the action and afford them an opportunity to present their objections." *Mullane v. Cent. Hanover Bank & Trust Co.*, 339 U.S. 306, 314, 70 S. Ct. 652, 94 L. Ed. 875 (1950)). Rule 4(h)(2), which governs service of process upon a foreign corporation, allows service to be made "in any manner prescribed for individuals by subdivision (4)(f) except personal delivery." Therefore, service by alternative means is proper here because (1) it was previously ordered by the Court in the Temporary Restraining Order ("TRO") [Dkt. 23], (2) it is not prohibited by international agreement, and (3) it is reasonably calculated, under the circumstances, to apprise the party of the action.

Application of the foregoing Rule 12(b)(6), Rule 20(a)(2), and service of process standards to the Defendant's Motion Dismiss compels its denial.

III. ARGUMENT

A. The Complaint States a Plausible Claim Against Defendant

1. <u>Plaintiff has Adequately Alleged an Actionable Trademark Infringement Claim</u>

Plaintiff's Complaint asserts claims for relief for federal trademark infringement, federal unfair competition, federal false designation of origin, and the violation of the Uniform Deceptive Trade Practices Act. [Dkt. No. 27.] The gravamen for each of these claims is the unauthorized use of the Modlily Trademark (Plaintiff's "Brand Trademark") to sell, advertise, display, or offer to sell Defendant's competing products. Accordingly, if Plaintiff establishes a likelihood of success that Defendant is infringing its Brand Trademark, it has a commensurate likelihood of success on its asserted claims for relief. A defendant is liable for trademark infringement and counterfeiting under the Lanham Act if it, "without the consent of the registrant, use[s] in commerce any reproduction, copy, or colorable imitation of a registered mark in connection with the sale, offering for sale, distribution, or advertising of any goods ... which such use is likely to cause confusion, or to cause mistake, or to deceive." 15 U.S.C. § 1114(1).

A federal trademark infringement claim has two elements. *See* 15 U.S.C. § 1125(a). A trademark holder must show "that its mark is protected under the Lanham Act" and that the challenged mark is likely to cause confusion among consumers. *Barbecue Marx, Inc. v. 551 Ogden, Inc*., 235 F.3d 1041, 1043 (7th Cir. 2000). In this case, Plaintiff's Brand Trademark is distinctive and is registered with the United States Patent and Trademark Office ("USPTO"). (Mangano Decl. Dkt. No. 7 ¶ 4.) Plaintiff's Brand Trademark registrations are valid, subsisting, and in full force and effect. (*Id.*) The registrations for the Brand Trademark constitutes prima facie evidence of their validity and of Plaintiff's exclusive right to use them pursuant to 15 U.S.C. §1057(b). Furthermore, Plaintiff has not licensed or authorized Defendant to use its Brand Trademark, and Defendant is not an authorized retailer of genuine Modlily brand products. (Mangano Decl. Dkt. No. 7 ¶ 4; En Fang Decl. Dkt. No. 11 ¶ 5.)

2. <u>The Notice Pleading Standard Has Been Met</u>

Defendant's first request seeks to dismiss, pursuant to Rule 12(b)(6), Plaintiff's federal trademark infringement claim. In support of this completely untenable position, Defendant relies only on Plaintiff's submission of evidence of Defendant's infringement of Plaintiff's registered Brand Trademark as shown in Exhibit 1 to the Declaration of Shawn A. Mangano [Dkt. No. 8-1]. By doing so, however, Defendant disingenuously ignores all the other allegations contained in Plaintiff's trademark infringement claim and the expressly incorporated supporting allegations asserted in thirty-four (34) factually detailed paragraphs. [*See* Dkt. No. 27 ¶¶ 1-30, 31-67.] When these allegations are fully considered, the futility of Defendant's arguments are demonstrated.

The submission of evidence along with Plaintiff's Motion for Temporary Restraining Order showing Defendant's 129 infringing links using the Brand Trademark in the URL [Dkt. No. 8-1] significantly strengthens Plaintiff's case against Defendant's Motion to Dismiss for insufficient specificity in the complaint. In the 7th Circuit, a complaint must provide sufficient factual details to state a plausible claim for relief and give the defendant fair notice of the grounds for the claim, as required under Rule 8(a)(2) and Rule 12(b)(6). *CAE, Inc. v. Clean Air Eng'g, Inc.,* 267 F.3d 660, 267 F.3d 660 (7th Cir. 2001); *Camasta v. Jos. A. Bank Clothiers, Inc*., 761 F.3d 732, 761 F.3d 732 (7th Cir. 2014). While the complaint itself must meet these standards, the additional evidence of infringing links bolsters Plaintiff's position by demonstrating a factual basis for the allegations.

First, the evidence of Defendant's 129 infringing URLs provides "specific facts" that support the legal claims asserted in the Complaint, which is critical under the plausibility standard established in *Bell Atl. Corp. v. Twombly* and *Ashcroft v. Iqbal*. A claim is plausible when the plaintiff pleads factual content that allows the court to draw a reasonable inference of liability. *Dix v. Edelman Fin. Servs., LLC,* 978 F.3d 507*, Mitchell v. Doherty,* 37 F.4th 1277*, Jauquet v. Green Bay Area Catholic Educ., Inc.,* 996 F.3d 802. The number of infringing links demonstrates a pattern of trademark misuse, which raises the claim above a speculative level and presents a coherent narrative that "holds together." *Bilek v. Fed. Ins. Co.*, 8 F.4th at 586; *Adams v. City of Indianapolis*, 742 F.3d 720. The evidence of infringing links also shows that plaintiff has conducted a thorough investigation and substantiated the allegations, which aligns with the purpose of Rule 9(b) –to ensure that plaintiffs do more than make conclusory statements before filing a complaint. *Camasta v. Jos. A. Bank Clothiers, Inc*., 761 F.3d 732; *Adams v. City of Indianapolis*, 742 F.3d 720.

This evidence further addresses the "who, what, when, where, and how" of the alleged infringement, which is often required to meet the particularity standards for pleadings in the 7th Circuit. *Camasta v. Jos. A. Bank Clothiers, Inc.*, 761 F.3d 732, *Interlease Aviation Investors II (ALOHA) L.L.C. v. Vanguard Airlines, Inc*., 262 F. Supp. 2d 898 (N.D. Ill. 2003). By identifying specific URLs where the trademark was allegedly misused, the plaintiff provides concrete examples of the alleged infringement, thereby giving Defendant fair notice of the claims and the grounds upon which they rest. *See CAE, Inc. v. Clean Air Eng'g, Inc.*, 267 F.3d 660; *Camasta v. Jos. A. Bank Clothiers, Inc.*, 761 F.3d 732. This level of detail counters any possible argument from the Defendant that the Complaint is vague or lacks sufficient specificity.

Finally, by also providing this evidence to Defendant, Plaintiff has further addressed concerns about vagueness or lack of detail in the Complaint. Defendant is put on notice of the specific instances of alleged infringement, which satisfies the notice requirement under Rule 8(a)(2). *Bilek v. Fed. Ins. Co*., 8 F.4th 581; *Cincinnati Life Ins. Co. v. Beyrer*, 722 F.3d 939. This ensures that Defendant is adequately informed of the claims and can prepare a defense, thereby reducing the likelihood of dismissal for insufficient specificity.

The case of *H-D U.S.A., LLC v. SunFrog, LLC,* No. 17-CV-711-JPS, 2017 U.S. Dist. LEXIS 119573 (E.D. Wis. July 31, 2017*)*, supports Plaintiff's position that a trademark used in the post-domain path of a URL is entitled to protection when it is associated with counterfeit products. This case is particularly persuasive in the 7th Circuit, and contrasts with Defendant's reliance on *Interactive Products Corp. v. A2Z Mobile Office Solutions, Inc*., 326 F.3d 687, 698 (6th Cir. 2003), and *Instant One Media, Inc. v. EZfaux Decor, LLC*, No. 1:19-cv-00540-WMR, 2022 WL 4596641 (N.D. Ga. July 26, 2022).

Defendant misleadingly quoted following statement from *Sunfrog,* "[t]he Seventh Circuit has not opined on this topic, and there appear to be no courts that have disagreed with Interactive Products." Dkt. 66 at 8; *Sunfrog,* 2017 U.S. Dist. LEXIS 119573 at 9-10. However, the Court in *Sunfrog* went on to state "[n]evertheless, the Court finds this case to be distinguishable. In *Interactive Products* and *Patmont*, the accused infringers only used the marks to identify or comment upon genuine, not counterfeit, products, and the use of the marks was not intended to generate confusion as to source. 2017 U.S. Dist. LEXIS 119573 at 10; *See also Instant One Media,* *Inc. v. Ezfauxdecor, LLC*, 2022 U.S. Dist. LEXIS 182802; § 7.06 INTERACTION OF INFRINGEMENT, DILUTION, AND ACPA; § 2.25 METATAGS AND LINKS. Similarly, in *Instant One Media, Inc.*, the court found the presence of a trademark in a post-domain URL did not constitute infringement, but noted that the plaintiff failed to demonstrate that the defendant was responsible for the URL's creation or that it was linked to counterfeit products. *Instant One Media, Inc. v. Ezfauxdecor, LLC*, 2022 U.S. Dist. LEXIS 182802. § 7.06 INTERACTION OF INFRINGEMENT, DILUTION, AND ACPA; § 2.25 METATAGS AND LINK.

The distinction made in *SunFrog* was the presence of counterfeit products. The use of a trademark in a post-domain URL linked to counterfeit goods undermines the fair use defense and strengthens the argument for infringement. This case highlights the importance of the nature of the products involved and the intent behind the use of the trademark, which differs significantly from the cases cited by the Defendant. Here, the products are women's fashion clothing and Defendant has used the Brand Trademark to lure consumers searching for Plaintiff's genuine goods to its URLs where it offers for sale knock off versions of Plaintiff's products.

3. Joinder is Proper

Defendant's requests dismissal based on the alleged improper joinder of all named Schedule "A" defendants in this action. [Dkt. No. 66 at pg. 8.] As a threshold matter, the moving Defendant simply does not have standing to challenge the joinder of dismissed, non-appearing defendants. Defendant does not have legal rights in the interests of third parties – they only have rights in their own legal remedies and interests. *Cf Elk Grove Unified Sch. Dist. v. Newdow*, 512 U.S. 1, 12 (2004); *Superior MRI Services, Inc. v. Alliance Healthcare Services, Inc*., 778 F.3d 502, 504, 506 (5th Cir. 2015). Even if the Defendant's joinder challenge is considered, it must be denied because the Plaintiff's allegations fully and factually comply with the requirements of Rule 20(a)(2).

As noted earlier, "'[i]n assessing whether the requirements of Rule 20(a)(2) are met, courts must accept the factual allegations in a plaintiff's complaint as true.'" *Estée Lauder*, 334 F.R.D. at 185 (quoting, 2011 WL 2837435, at *3). Rule 20(a)(2) provides that defendants may only be joined in the same action if: (1) the claims against them are asserted "with respect to or arising out of the same transaction, occurrence, or series of transactions or occurrences," and (2) there is a "question of law or fact common to all defendants." Fed. R. Civ. P. 20(a)(2)(A)–(B). To decide "whether the rights asserted arise out of the same transaction or occurrence, courts should 'consider the totality of the claims, including the nature of the claims, the legal basis for recovery, the law involved, and the respective factual backgrounds.'" *Estée Lauder*, 334 F.R.D. at 185 (quoting *Ross ex rel. Ross*, 486 F.3d at 284).

The allegations against all named Schedule "A" defendants in this action concern the same transaction or series of transactions as required under Rule 20(a)(2)(A). Specifically, all defendants are alleged to be citizens of the People's Republic of China or its associated territories ("China"), all defendants operate online storefronts from China on the same online sales platform, Amazon, all defendants are alleged to have infringed the same trademark, Modlily, and selling the same styles of clothes as the Modlily brand, and all defendants are asserted to be working in concert through the same counterfeit network through which they acquire their competing Modlily brand products from the same manufacturing source and employ the same or similar distribution channels. (Dkt. 27 at ¶¶ 5, 13, 25-26, 29.).

Defendant attempts to incorrectly reference a different case that Plaintiff has filed, in an attempt to bolster its improper joinder claim. Defendant's reference to a separate case does not directly affect the substantive evaluation of the trademark infringement claim, as each case is evaluated on its own merits. *Int'l Kennel Club of Chi., Inc. v. Mighty Star, Inc*., 846 F.2d 1079.

The Court has discretion to consider such arguments but must ensure that its decision aligns with Rule 20's requirements and does not unfairly prejudice any party. *Cont'l Indem. Co. v. BII, Inc.*, 104 F.4th 630; *Dorsey v. Varga*, 55 F.4th 1094. The fact that Defendant was not served or publicly named in the referenced case, and that the original list of defendants is under seal further limits the relevance of the other case to the current proceedings. *See Harley-Davidson, Inc. v. Selectra Int'l Designs*, 861 F. Supp. 754. Additionally, sealed documents are generally inaccessible to the public and other parties, which restricts their use in the current case unless the court grants access. *Am. Bridal & Prom Indus. Ass'n v. P'ships & Unincorporated Ass'ns Identified on Schedule A*, 192 F. Supp. 3d 924. This procedural limitation underscores the need for the court to focus on the specific facts and claims in the current case when addressing a misjoinder claim. The sealed nature of the other case and the Defendant's lack of involvement in it further limit the relevance of the other case to the current proceedings. Accordingly, Defendant's request for dismissal for misjoinder should be denied.

B. Service of Process Was Proper Because Email Service Is Not Prohibited by the Hague Convention.

1. <u>The Hague Convention Does Not Apply Because Each Defendant's Actual and Accurate Address Was Unknown</u>

Article 1 of the Hague Convention states that [t]his Convention shall not apply where the address of the person to be served with the document is not known. Through the course of this action, the defendants have consistently tried to hide their true identities.

When Plaintiff sought to serve the Defendant electronically via email and through publication, the only identifying information available was an incomplete and unverified address on Amazon, and which used the alias, Xiamenyangpowangluokejiyouxiangongsi. Subsequently, Amazon provided the email it uses to communicate with the Defendant, and the unverified names and addresses the Defendant used to create its Amazon account to target U.S. consumers, which did not match the purported incomplete address on Defendant's Amazon seller page.

Defendants' true names and addresses remain unknown. As with many counterfeiters, fake names and addresses are used as a strategy to make any service under the Hague Convention an exercise in futility. This is precisely why the Hague Convention does not apply in this instance, where the name and address of the person to be served is unknown. Plaintiff has exercised reasonable diligence in attempting to discover a true name and physical address for service of process under the Hague Convention. *See Microsoft Corp. v. Does*, No. 12-CV-1335 (SJ)(RLM), 2012 U.S. Dist. LEXIS 162122, 2012 WL 5497946, at *2 (E.D.N.Y. Nov. 13, 2012) (concluding that plaintiffs used "diligent efforts" to identify defendants who "operate[d] via the Internet" and had "sophisticated means to conceal their identities and locations," and thus the Hague Convention was "not applicable"). Plaintiff's investigation produced nothing but conflicting names and addresses. Therefore, the Hague Convention does not apply.

2. Defendant Did Receive Actual Notice of the Lawsuit from Plaintiff through its Email Account.

Defendant alleges they were not properly served. However, Plaintiff has evidence to show that Defendant received notice. Plaintiff's initial service email of the Complaint, TRO, and Summons was sent to Defendant Funlingo on January 3, 2025, to the email address provided by Amazon, which was successfully delivered. See **Exhibit A.** The copy of the TRO additionally listed all defendants named in this action, including Defendant Funlingo. [Dkt. No. 23 at pg. 10.] Plaintiff additionally served Defendant with the First Amended Complaint to the same email address on January 6, 2025, in response to the Court's December 20, 2025, minute order [Dkt. No. 22] requesting an unsealed amended complaint be filed by January 3, 2025. [Dkt. No 30]. The returned summons as well as a certificate of service regarding the First Amended Complaint were then filed on January 6, 2025, after service of the original Complaint, TRO, Summons, and First Amended Complaint were effectuated [Dkt. No. 29, 30.] Lastly, the Defendant was served a third time at the same email address on January 9, 2025, with copies of Plaintiff's motions to extend the TRO and motion for preliminary injunction, along with the link to a website with all case documents [Dkt. Nos. 31-32]. See **Exhibit B**. An erroneous list was attached as Exhibit 2 [Dkt No. 27-2] while unsealing the original complaint and re-attaching the original Schedule A on the First Amended Complaint, which was corrected through Plaintiff's Notice of Errata [Dkt No. 40.]

Counsel for Defendant also fails to acknowledge that Funlingo was properly named in the complaint through the fictitious name it chose to use on its Amazon seller page. Defendant was also served the TRO as a Defendant named in this case, which was served with the initial pleadings on January 3, 2025.

3. Email Service Pursuant to Rule 4(f)(3) was Proper Irrespective of the Purported Availability of Defendant's Physical Address.

As established above, Rule 4(f)(3) simply states that service can be effectuated "by any means not prohibited by international agreement." Rule 4(f)(3) does not mention any requirement regarding attempts to identify, verify or serve a defendant at a purported physical address prior to requesting alternative service. Rather, "Rule 4(f)(3) provides the Court with flexibility and discretion empowering courts to fit the manner of service utilized to the facts and circumstances of the particular case." *Strabala v. Zhang,* 318 F.R.D 81, 100 (N.D. Ill. 2016).

Court-directed electronic service pursuant to Rule 4(f)(3) is particularly appropriate where, like here, "there is a need for speed that cannot be met by following the Hague Convention method...", because of the injunctive relief sought by Plaintiff. *Strabala,* 318 F.R.D. at 110; *see also Volkswagen*, 20-cv-3131, at 3 (holding that electronic service was proper in part because of "the need for speed in obtaining injunctive relief"). Article 15 of the Hague Convention provides that alternate methods may be used if a Central Authority does not respond within six months. *Strabala,* 318 F.R.D. at 100. Even if a purported address is real and Defendants are available for service at those addresses, it is nearly certain that the Chinese Central Authority will exceed six months in its attempt to effectuate service. *See id.* (request for service via the Chinese Central Authority pending over six months); *see also Victaulic Co. v. Allied Rubber & Gasket Co., 2020 U.S. Dist. LEXIS 82150, at *3 (S.D. Cal. May 8, 2020).*

Defendant relies on the decision in *Luxottica Group S.p.A. v. Partnerships, et al.,* 391 F. Supp. 3d 816 (N.D. Ill. 2019) in support of its Motion, but the Court in *Luxottica Group* has subsequently permitted electronic service in similar cases involving Chinese-based e-commerce stores. *See, e.g., Spin Master Ltd., et al. v. California Pineapple Toy Store, et al*., No. 20-cv-00628 (N.D. Ill. Mar. 5, 2020). The *Luxottica Group* decision also does not demonstrate that this Court abused its discretion in granting electronic service, only that the Court in *Luxottica Group* came to a different decision when exercising its discretion under different circumstances. Indeed, this Court's ruling in *Volkswagen*, where it rejected the same arguments raised by Defendant, was decided after *Luxottica Group. Volkswagen,* 20-cv-3131, at 2-4. Without a way to timely notify defendants of the case, the harm to plaintiffs and consumers would go unaddressed. As such, service was proper.

This Court recently found that brand owners like Plaintiff face a "swarm of attacks" on their trademarks, and “filing individual causes of action against each counterfeiter ignores the form of harm"” that plaintiffs face. *Bose Corp. v. Operators of andwind, et al.*, No. 19-cv-07467 (N.D. Ill. Nov. 12, 2019) (Durkin, J.) (Docket Entry 46, p. 12). The same reasoning applies to allowing service via email to address a swarm of counterfeiters. Requiring trademark owners to comply with the Hague Convention creates tremendous obstacles that clearly favor the “swarm” of counterfeiters since there is no reasonable way to ascertain a truly accurate name and address. China-based online marketplaces often shroud their true identities using aliases and inaccurate information. Moreover, the "English" name, address and other identifying information used by a Chinese seller rarely translates accurately into Chinese as discussed in more detail below. This all makes service under the Hague Convention an exercise in futility.

A highly reliable and efficient means of reaching a swarm of counterfeiters is by using their emails they used to create their accounts on the online platform. It is the communication link created by each defendant to correspond with their U.S. customers. Equally important, the emails used by Plaintiff are also the emails used by each defendant to communicate with seller platforms such as Amazon - all of which are payment processors that hold Defendant's funds. Thus, Rule 4(f)(3) provides the Court with the flexibility to efficiently and effectively deal with a "swarm" of e-commerce counterfeiters by email service.

4. The Court Properly Ordered Electronic Services Under Fed. R. Civ. P. 4(f)(3).

Defendant argues that email service is prohibited by international agreement, namely the Hague Convention. Courts in this district have held otherwise. *See Strabala*, 318 F.R.D. at 115(citing *Maclean-Fogg Co. v. Ningbo Fastlink Equip. Co.*, 2008 U.S. Dist. LEXIS 97241, at *5 (N.D. Ill. Dec. 1, 2008))("[t]he Hague Convention does not prohibit service by email or facsimile"); *see Serenium, Inc. v. Zhou*, No. 20-cv-02132-BLF, 2020 U.S. Dist. LEXIS 94572, at *12 (N.D. Cal. May 29, 2020). Further, limiting alternative service methods to only those explicitly authorized by China would necessarily render Fed. R. Civ. P. 4(f)(3) superfluous and redundant of Fed. R. Civ. P. 4(f)(1).

If the Court were to order Plaintiff to serve defendants at their Chinese addresses, the service efforts in China will produce additional service delays in the future. Defendant's Motion, if granted, will most likely cause this case to be sluggish for months, if not years. Defendant's attempts to use improper service as their get-out-of-jail free card lacks factual and legal basis and should be therefore rejected.

5. Alternatively, Plaintiff Should Be Allowed to Serve Defendants by Serving their U.S. Counsel.

Counsel for Defendant did not mention in the Motion if they will accept service on Defendant's behalf. Due process does not require that the individuals served on behalf of foreign defendants have represented them or been authorized to accept service on their behalf. *Brown v. China Integrated Energy, Inc*., 285 F.R.D. 560, 565-66 (C.D. Cal. 2012) (authorizing service per Rule 4(f)(3) on China-based defendant's American counsel). Moreover, "[i]f valid service occurs in the United States, therefore, the Hague Convention is not implicated regardless of the location of the party." *Id*. District courts routinely direct service on an international defendant's U.S. counsel under Rule 4(f)(3) even if the counsel has not been expressly authorized to accept service on the defendant's behalf. *Zhang v. Baidu.com Inc*., 293 F.R.D. 508, 516 (S.D.N.Y. 2013) (holding that China-based defendant could be served via its U.S. counsel, and that because service on counsel occurs domestically, it does not involve the transmission of documents abroad and does not implicate the Hague Convention).

More importantly, courts have found that effecting service of process on counsel "erases any material doubt that [the defendant] will be provided with notice of the suit." *Huawei Techs. USA, Inc. v. Oliveira*, 2019 U.S. Dist. LEXIS 120533, 2019 WL 3253674, at *3 (E.D. Tex. July 19, 2019) (quoting *WorldVentures Holdings, LLC v. MaVie*, 2018 U.S. Dist. LEXIS 209348, at *14 (E.D. Tex. Dec. 12, 2018)). By effecting service of process on Defendant's known U.S. counsel, who are already representing Defendant in this matter, Defendant is reasonably certain to be apprised of the pending action.

III. CONCLUSION

Accordingly, for the reasons stated herein, Plaintiff respectfully requests that this Court deny Defendant's Motion to Dismiss.

DATED: May 14, 2025

Respectfully submitted,

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CERTIFICATE OF SERVICE

I hereby certify that on the 14th day of May 2025, I electronically filed the foregoing document with the clerk of the court for the U.S. District Court, Northern District of Illinois, Eastern Division, using the electronic case filing system. The electronic case filing system sent a "Notice of Electronic Filing" to the attorneys of record who have consented in writing to accept this Notice as service of this document by electronic means.

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