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UNITED STATES DISTRICT COURT
CENTRAL DISTRICT OF CALIFORNIA

Valentino S.p.A.,
Plaintiff,
v.
Mario Valentino S.p.A., et al.,
Defendants.

Case No. LA CV19-06306 JAK
(GJSx)
**REQUEST FOR
INTERNATIONAL JUDICIAL
ASSISTANCE**

1 To the Registrar of the Supreme Court of Singapore:

2 In conformity with Article 3 of the Hague Convention on the Taking of
3 Evidence Abroad in Civil or Commercial Matters, March 18, 1970, 23 U.S.T. 2555
4 (the “Hague Convention”), the United States District Court for the Central District of
5 California, Western Division (this “Court”), presents its compliments to the
6 Appropriate Judicial Authority of the Republic of Singapore (“Singapore”) and
7 requests international judicial assistance to obtain evidence to be used in a civil
8 proceeding before this Court in the above-captioned matter. A trial on this matter
9 before this Court is not yet scheduled, however this Court has set a deadline of
10 November 22, 2021 for acquiring evidence in this matter.

11 The accessibility of evidence in the present case is governed by the
12 international pretrial discovery procedures under the Hague Convention. Singapore
13 and the United States are signatories to the Hague Convention. The evidence sought
14 is required solely for use in the above-captioned civil proceeding and for no other
15 purpose, and, if obtained, will be introduced in the above-captioned proceeding.

16 **I. REQUEST**

17 This Court requests the assistance described herein as necessary in the interests
18 of justice. The assistance is that the Appropriate Judicial Authority of Singapore
19 compel the appearance of: (1) the individual Susan Lim Wie, who was a former
20 Director of Bowley Investments Pte Ltd. (“Bowley”) (which was organized under the
21 laws of Singapore and was struck off the Singapore companies register with effect
22 from 6 April 2017); and (2) the below-named entity, Esteem Management Services
23 Pte Ltd. (“Esteem”) (which is organized under the laws of Singapore) by its
24 representative Susan Lim Wie (the current Director of Esteem), in order to obtain
25 necessary testimonial evidence in Exhibit A and produce documents relevant to the
26 above-captioned proceeding. Susan Lim Wie shall be referred to as the “Deponent”
27 herein.

28

1 This Court also requests that the Deponent and Esteem produce copies of the
2 specified documents in Exhibit B, which are relevant to the above-captioned
3 proceeding.

4
5 Details of Deponent:

6 Susan Lim Wie
7 Esteem Management Services Pte Ltd.
8 133 Cecil Street #16-01
9 Keck Seng Tower
10 Singapore 069535

11 Details of Esteem:

12 Esteem Management Services Pte Ltd.
13 133 Cecil Street #16-01
14 Keck Seng Tower
15 Singapore 069535

16 This Court requests that testimony from the Deponent be taken under oath or
17 affirmation by the below-named Singapore solicitors appointed by Valentino. This
18 Court hereby authorizes Valentino, by its below-named counsel (“Authorized
19 Representative”) and its below-named Singapore solicitors, to make the application
20 on behalf of Valentino for judicial assistance of the Appropriate Judicial Authority
21 of Singapore to obtain an order for the examination of witnesses and for attendance
22 and for production of documents in relation to the above-captioned proceeding
23 pending before this Court and to act on behalf of this Court in relation to these
24 requests.

25 Authorized Representative:

26 Louis S. Ederer
27 Louis.Ederer@arnoldporter.com
28 Arnold & Porter Kaye Scholer LLP
 250 West 55th Street
 New York, NY 10019-9710

1 U.S.A.
2 Tel.: +1.212.836.8000
3 Fax: +1.212.836.8689

4 Singapore solicitors appointed by Valentino:

5 Dr Stanley Lai, S.C. / Toh Jia Yi / Lim Yong Sheng David
6 stanley.lai@allenandgledhill.com / toh.jiayi@allenandgledhill.com /
7 david.lim@allenandgledhill.com
8 Allen & Gledhill LLP
9 One Marina Boulevard #28-00
10 Singapore 018989
11 Tel.: +65 6890 7838
12 Fax: +65 6302 3231

13 **II. FACTUAL BACKGROUND**

14 Plaintiff Valentino S.p.A. (“Valentino”) has filed a Complaint against
15 Defendants Mario Valentino S.p.A. (“MV”) and Yarch Capital, LLC (“Yarch”, and,
16 together with MV, “Defendants”) alleging that Defendants have taken various steps
17 to deceive consumers in the United States into believing that Defendants’ handbags
18 are Valentino’s handbags in violation of United States federal trademark and unfair
19 competition law and California unfair competition law. Valentino has also alleged
20 that Defendants are infringing two of its United States Design Patents for handbags.

21 As is particularly relevant to this request, in defense of Valentino’s
22 allegations, Defendants have argued, among other things, that their behavior is
23 protected because MV is the senior registrant, owner, and user of certain
24 “Valentino” trademarks in the United States. MV has also asserted counterclaims
25 for trademark infringement against Valentino based on MV’s alleged senior
26 registered trademark rights in the “Valentino” mark. However, documents in
27 Valentino’s possession indicate that MV transferred ownership of the relevant
28 trademarks to Bowley in 1996, that Bowley was the actual owner of such
trademarks during portions of the time period relevant to this litigation, including
until, at least, 2016, and that the Deponent and Esteem handled business affairs for

1 Bowley during the relevant time period and thus possesses relevant Bowley
2 documents. It also appears that Bowley itself was struck off of the Singapore
3 company register in 2017. Valentino believes that testimony and documents from
4 the Deponent and Esteem relating to Bowley will help determine the legitimacy of
5 Defendants' defense that MV is the senior registrant, owner, and user of the relevant
6 trademarks.

7 **III. PARTICULAR TESTIMONY AND DOCUMENTS REQUESTED**

8 This Court requests the assistance of the Appropriate Judicial Authority of
9 Singapore to compel the appearance of the Deponent in order to obtain the specific
10 testimonial evidence in Exhibit A from the Deponent (the "Particular Testimonial
11 Evidence") and to produce documents.

12 This Court also requests that the Deponent and Esteem produce copies of the
13 specified documents in Exhibit B (the "Particular Requested Documents").

14 **IV. SPECIFIC ADDITIONAL REQUESTS**

15 This Court requests that the Deponent be compelled to provide the Particular
16 Testimonial Evidence on or before September 22, 2021, so that the parties will have
17 sufficient time to review the testimony and conduct any further discovery for
18 additional necessary documents or testimony, in advance of the November 22, 2021
19 deadline this Court has set for acquiring such evidence.

20 This Court requests delivery and receipt of copies of the Particular Requested
21 Documents on or before September 8, 2021, so that the parties will have sufficient
22 time to review these documents and conduct any further discovery for additional
23 necessary documents or testimony, in advance of the November 22, 2021 deadline
24 this Court has set for acquiring such evidence.

25 This Court requests that, should any portion of this request be denied, on legal
26 grounds, that such denial not affect the remainder of this request. In the event that
27 any portion of this request is denied, this Court requests that the Authorized
28

1 Representative and this Court be immediately informed of such denial and the
2 grounds for such denial.

3 This Court requests that the Appropriate Judicial Authority of Singapore
4 provide this Court and the Authorized Representative, as soon as convenient, all
5 information regarding the acquisition of evidence sought by this request, including
6 the date, time, and place designated for the requested testimony of the Deponent and
7 Esteem's production of documents.

8 This Court requests that the Deponent's testimony be recorded and reduced to
9 verbatim written transcript, properly sealed and authenticated by the appropriate
10 authority for, and in accordance with the laws of, Singapore and returned to the
11 Authorized Representative for examination and use in this litigation.

12 This Court requests that the Authorized Representative be permitted to attend
13 and, if possible, also participate directly in the examination of the Deponent. If it is
14 not possible to attend the Deponent's examination in person due to the current travel
15 concerns/restrictions resulting from the COVID-19 crisis, or any other reason, it is
16 requested that the Authorized Representatives be allowed to attend the requested
17 deposition, and participate if permitted, by "real time" electronic video link from
18 within the United States, via SKYPE or an equivalent platform, to be transmitted
19 and viewed on laptop equipment provided by the Authorized Representative. The
20 Authorized Representative shall either provide, or be responsible for the cost of, all
21 video link services. If the video link process is permitted, it is requested that
22 notification and permission be given as soon as possible to allow for coordination
23 and set up of such services.

24 This Court requests that any documents produced be properly sealed and
25 authenticated by the appropriate authority for, and in accordance with the laws of,
26 Singapore. Any costs associated with acquisition, production, authentication or
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1 return of this evidence shall be the responsibility of the Authorized Representative
2 in this matter.

3 In the event that the evidence requested cannot be taken in the manner
4 requested, this Court requests that the evidence be obtained in a manner that
5 conforms to Singapore law for the formal taking of evidence.

6 This Court requests that the confidentiality of this request and its exhibits be
7 preserved to the maximum extent permitted under the laws of Singapore.

8 **V. OFFER OF RECIPROCAL ASSISTANCE**

9 This Court is willing to provide similar assistance to the judicial authorities of
10 Singapore. *See* 28 U.S.C. § 1782.

11 **VI. REIMBURSEMENT FOR COSTS**

12 Valentino's counsel (Louis S. Ederer of Arnold & Porter Kaye Scholer LLP,
13 250 West 55th Street, New York, NY 10019-9710) is willing to reimburse the
14 Appropriate Judicial Authority of Singapore for reasonable costs incurred in
15 executing this Court's Letter Rogatory.

16 DATED: July 15, 2021

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18 

19
20 _____
21 Honorable Gail J. Standish
22 United States Magistrate Judge
23 Roybal Federal Building and United States
24 Courthouse
25 255 E. Temple Street
26 Los Angeles, CA 90012
27 U.S.A.

28 Kiry K. Gray, Clerk of Court



By:



E. Carson, Deputy Clerk

[Seal of the court]

Exhibit A

Definitions

In regards to the requests for testimony below, the following definitions apply:

1. “Bowley” shall refer to Bowley Investments Pte Ltd., including but not limited to its officers, directors, employees, members, partners, subsidiaries, and affiliates, and all persons and entities acting on its behalf or as its representative or agent.

2. “Esteem” shall refer to Esteem Management Services Pte Ltd., including but not limited to its officers, directors, employees, members, partners, subsidiaries, and affiliates, and all persons and entities acting on its behalf or as its representative or agent.

3. “Mario Valentino” shall refer to Mario Valentino S.p.A., including but not limited to its officers, directors, employees, members, partners, subsidiaries, and affiliates, and all persons and entities acting on its behalf or as its representative or agent, including but not limited to Vincenzo Valentino.

4. “Mario Valentino USA Trademarks” shall refer to United States trademark rights to the terms “VALENTINO” or “V”, including U.S. Registration Nos. 0,951,621, 1,454,256, 5,343,376, and U.S. Serial No. 79/283,235, and all common law rights associated with the foregoing trademarks.

5. “Mario Valentino Trademarks” shall refer to any trademark or similar rights to the terms “VALENTINO” or “V”, to the extent such trademark rights are specifically stated to include United States trademark rights or to the extent it is not clearly stated whether such trademark rights do or do not include United States trademark rights.

6. “Moores” shall refer to Moores Rowland Singapore and Moores Rowland Consultants Pte. Ltd., including but not limited to their officers, directors, employees, members, partners, subsidiaries, and affiliates, and all persons and entities acting on their behalf or as their representatives or agents.

7. “USPTO” shall refer to the United States Patent and Trademark Office.

8. “You” or “Your” shall refer to Ms. Susan Lim Wie.

Requests for Testimony

1. Please explain Your role as Director of Bowley.
2. Please explain Your role as an employee of Esteem acting as representative of Bowley.
3. Please identify all agreements entered into between Bowley and Mario Valentino.
4. Please explain the relationship between Esteem and Bowley, including a description of all services Esteem provided to Bowley.
5. Please describe all services Esteem provided to Bowley related to Mario Valentino.
6. Please identify the trademark rights Mario Valentino assigned, transferred or otherwise conveyed to Bowley in 1996.
7. Please identify all rights and other consideration conveyed from Mario Valentino to Bowley in the 1996 agreement.
8. Please identify all consideration provided to Mario Valentino by Bowley in the 1996 agreement.
9. What rights to the Mario Valentino Trademarks remained with Mario Valentino pursuant to the 1996 agreement, if any?
 - a. Please identify all conditions, if any, placed on Mario Valentino's exercise of rights related to the Mario Valentino Trademarks by the 1996 agreement.
10. Please identify all Bowley agents or representatives with whom Mario Valentino communicated regarding the 1996 agreement between Mario Valentino and Bowley.
11. Please identify all Bowley agents or representatives with whom Esteem communicated regarding Mario Valentino.
12. Please identify all individuals who may have knowledge of the 1996 agreement between Mario Valentino and Bowley.

13. Please explain the purpose of Bowley's and Mario Valentino's agreement that the United States registrations of the Mario Valentino Trademarks at Reg. No. 0,951,621 and Reg. No. 1,454,256 would remain under the name of Mario Valentino.

14. When, if ever, did Bowley assign, transfer or otherwise convey ownership rights of the Mario Valentino USA Trademarks back to Mario Valentino?

15. Please identify all instances of assignments, transfers or conveyances of rights to the Mario Valentino Trademarks between Mario Valentino and Bowley.

16. Please explain any actions taken or policies put in place by Bowley to control the use of the Mario Valentino USA Trademarks during the period of time such trademark rights were owned by Bowley.

17. Was Bowley aware of any sales in or into the United States of products bearing the Mario Valentino USA Trademarks during the period of time such trademark rights were owned by Bowley?

a. If yes, please identify such sales and Bowley's involvement in such sales.

18. Please describe any services Mario Valentino provided to Bowley pursuant to the Contract, dated June 30, 2001, entered into between Bowley and Mario Valentino.

19. Please describe any actions taken or products sold by Bowley in connection with the Contract, dated June 30, 2001, entered into between Bowley and Mario Valentino.

20. Please identify all payments made by Bowley to Mario Valentino.

a. Please identify all consideration provided by Mario Valentino to Bowley in exchange for each such payment.

b. Please identify any services provided to Bowley by Mario Valentino in exchange for such payments.

c. Please identify any payments made by Bowley to Mario Valentino in exchange for the transfer of any rights to the Mario Valentino USA Trademarks.

21. Please identify any monies transferred from Bowley to Mario Valentino in order to fund, or in reimbursement for any payments made by Mario Valentino to fund, the fees or other costs associated with any filings with the USPTO regarding the Mario Valentino USA Trademarks.

22. Please identify any monies transferred from Bowley to Mario Valentino in order to fund, or in reimbursement for any payments made by Mario Valentino to fund, any litigations or other enforcement proceedings filed or participated in by Mario Valentino or Bowley regarding the Mario Valentino USA Trademarks.

23. Please identify all payments made by Mario Valentino to Bowley.

- a. Please identify all consideration provided by Bowley to Mario Valentino in exchange for each such payment.
- b. Please identify any services provided to Mario Valentino by Bowley in exchange for such payments.
- c. Please identify any payments made by Mario Valentino to Bowley in exchange for the transfer of any rights to the Mario Valentino USA Trademarks.

24. Please identify all monies transferred between Bowley and Esteem regarding the Mario Valentino Trademarks or agreements between Bowley and Mario Valentino.

25. Please identify all filings Bowley made with the USPTO regarding the Mario Valentino USA Trademarks.

26. Please identify all filings with the USPTO regarding the Mario Valentino USA Trademarks provided to Bowley by Mario Valentino.

27. Was Bowley aware of Mario Valentino's filing of an Application for Combined Declaration of Use and/or Excusable Nonuse/Application for Renewal of Registration, submitted to the USPTO on December 6, 2012, which listed Mario Valentino as the owner of the United States Trademark, Reg. No. 0951621?

- a. If yes, please describe any communications from Bowley to Mario Valentino regarding such filing.

28. Please explain Bowley's involvement in the 2013 license agreement between Mario Valentino and Yarch Capital, LLC.

29. Were You aware of the 2013 license agreement between Mario Valentino and Yarch Capital, LLC?
- a. Please explain Your awareness of, and involvement in the 2013 license agreement between Mario Valentino and Yarch Capital, LLC.
 - b. Please explain any input or instructions You provided to Mario Valentino regarding the 2013 license agreement between Mario Valentino and Yarch Capital, LLC.
30. Please describe all restrictions or input Bowley imposed on the 2013 license agreement between Mario Valentino and Yarch Capital, LLC.
31. Please identify all Bowley agents or representatives with whom Mario Valentino communicated regarding the 2013 license agreement between Mario Valentino and Yarch Capital, LLC.
32. Please identify all Bowley agents or representatives with whom Mario Valentino communicated regarding the Agreement, signed on June 15, 2016, entered into between Mario Valentino and Bowley.
33. Please identify all Bowley agents or representatives with whom Mario Valentino communicated regarding the Contract, dated June 30, 2001, entered into between Mario Valentino and Bowley.
34. Please identify all Bowley agents or representatives who participated in Bowley's control over and management of the Mario Valentino USA Trademarks, and explain the nature of their involvement.
35. Please explain Your role in the negotiation, drafting, execution, and performance of the 2016 Agreement between Mario Valentino and Bowley.
36. Did Bowley receive any payments from Mario Valentino pursuant to the 2016 Agreement between Mario Valentino and Bowley?

Exhibit B

Definitions

In regards to the document requests below, the following definitions apply:

1. “Bowley” shall refer to Bowley Investments Pte Ltd., including but not limited to its officers, directors, employees, members, partners, subsidiaries, and affiliates, and all persons and entities acting on its behalf or as its representative or agent.

2. “Esteem” shall refer to Esteem Management Services Pte Ltd., including but not limited to its officers, directors, employees, members, partners, subsidiaries, and affiliates, and all persons and entities acting on its behalf or as its representative or agent.

3. “Mario Valentino” shall refer to Mario Valentino S.p.A., including but not limited to its officers, directors, employees, members, partners, subsidiaries, and affiliates, and all persons and entities acting on its behalf or as its representative or agent, including but not limited to Vincenzo Valentino.

4. “Mario Valentino USA Trademarks” shall refer to United States trademark rights to the terms “VALENTINO” or “V”, including U.S. Registration Nos. 0,951,621, 1,454,256, 5,343,376, and U.S. Serial No. 79/283,235, and all common law rights associated with the foregoing trademarks.

5. “Mario Valentino Trademarks” shall refer to any trademark or similar rights to the terms “VALENTINO” or “V”, to the extent such trademark rights are specifically stated to include United States trademark rights or to the extent it is not clearly stated whether such trademark rights do or do not include United States trademark rights.

Document Requests

1. The agreement entered into between Bowley and Mario Valentino in 1996 (the “**1996 Agreement**”) referred to in the preamble of a draft Licence Agreement between Mario Valentino, Yarch Capital LLC Company and Bowley enclosed in the email from Serge Levy of Yarch Capital, LLC to Vincenzo Valentino of Mario Valentino dated 20 April 2013.

2. Written correspondence in 1996 between Bowley and Mario Valentino regarding the 1996 Agreement.
3. Written correspondence in 1996 between Bowley and Esteem regarding the 1996 Agreement.
4. Written correspondence from 1999 between Bowley and Mario Valentino regarding the Contract, dated June 30, 2001, entered into between Mario Valentino and Bowley.
5. Written correspondence from 1999 between Bowley and Esteem regarding the Contract, dated June 30, 2001, entered into between Mario Valentino and Bowley.
6. Written correspondence from February to April 2013 between Bowley and Mario Valentino regarding a potential Licence Agreement between Mario Valentino, Yarch Capital LLC Company and Bowley regarding the Mario Valentino Trademarks (a draft of which was enclosed in the email from Serge Levy of Yarch Capital, LLC to Vincenzo Valentino of Mario Valentino dated 20 April 2013).
7. Written correspondence from February to April 2013 between Bowley and Esteem regarding a potential Licence Agreement between Mario Valentino, Yarch Capital LLC Company and Bowley regarding the Mario Valentino Trademarks (a draft of which was enclosed in the email from Serge Levy of Yarch Capital, LLC to Vincenzo Valentino of Mario Valentino dated 20 April 2013).
8. Written correspondence from April to June 2016 between Bowley and Mario Valentino regarding the Agreement between Mario Valentino and Bowley transmitted from Susan Lim to Vincenzo Valentino on June 15, 2016.
9. Written correspondence from April to June 2016 between Bowley and Esteem regarding the Agreement between Mario Valentino and Bowley transmitted from Susan Lim to Vincenzo Valentino on June 15, 2016.
10. Written correspondence between Bowley and Mario Valentino transmitting the certificate of registration of the VALENTINO trademark registered as a United States Trademark, Reg. No. 0951621.
11. Written correspondence between Bowley and Mario Valentino transmitting the Application for Combined Declaration of Use and/or Excusable Nonuse/Application for Renewal of Registration of the VALENTINO trademark

registered as a United States Trademark, Reg. No. 0951621, filed on behalf of Mario Valentino with the United States Patent and Trademark Office on December 6, 2012.

12. Documents evidencing the payments made from Bowley to Mario Valentino in connection with the payment of costs or fees associated with enforcement of rights in the Mario Valentino USA Trademarks via cease and desist letters or litigation proceedings.

13. Documents evidencing the payments made from Bowley to Mario Valentino in connection with the payment of costs or fees associated with the litigation filed in the United States District Court for the Central District of California on November 28, 2011 by Mario Valentino SpA, Valentino SpA, Valentino USA Inc, and Valentino Fashion Group SpA against MDG International Inc and Bryant Young Soo Chun, at Case No. 2:11-cv-09826-JFW-AJW.

14. Documents evidencing the payments made from Bowley to Mario Valentino in connection with the payment of costs or fees associated with the filing with the United States Patent and Trademark Office on December 6, 2012 of the Application for Combined Declaration of Use and/or Excusable Nonuse/Application for Renewal of Registration of the VALENTINO trademark registered as a United States Trademark, Reg. No. 0951621.