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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
2 **I. FORMAL INFORMATION**

3 Sender and Requesting Judicial Authority:

4 United States District Court
5 Central District of California
6 Roybal Federal Building and United States Courthouse
7 255 E. Temple Street
8 Courtroom 640, 6th Floor
9 Los Angeles, CA 90012
10 U.S.A.

11 Central Authority of the Requested State and competent authority:

12 Tribunal de première instance
13 Rue de l'Athénée 6-8
14 Case postale 3736
15 1211 Genève 3
16 Switzerland

17 Person to whom the executed request is to be returned:

18 Honorable Gail J. Standish
19 United States Magistrate Judge
20 United States District Court
21 Central District of California
22 Roybal Federal Building and United States Courthouse
23 255 E. Temple Street
24 Courtroom 640, 6th Floor
25 Los Angeles, CA 90012
26 U.S.A.

27 Names and addresses of the parties and their representatives:

28 Plaintiff:

Valentino S.p.A.
Via Filippo Turati 16/18
Milan, Italy 20121

Represented by:

Louis S. Ederer
Louis.Ederer@arnoldporter.com
Arnold & Porter Kaye Scholer LLP
250 West 55th Street

1 New York, NY 10019-9710
2 U.S.A.
3 Tel.: +1.212.836.8000
4 Fax: +1.212.836.8689

5 Defendants:

6 Mario Valentino S.p.A.
7 Via Fontanelle, 85
8 Napoli, Campania, 80136, Italy

9 Represented by:

10 Joseph C. Gioconda
11 joseph.gioconda@giocondalaw.com
12 GIOCONDA LAW GROUP PLLC
13 100 Park Avenue, 16th Floor
14 New York, NY 10017
15 U.S.A.
16 Tel.: (212) 235-1220
17 Fax: (888) 697-9665

18 Yarch Capital, LLC
19 303 North Glenoaks Blvd., #200
20 Burbank, CA 91502
21 U.S.A.

22 Represented by:

23 David H. Boren
24 dboren@rlfflp.com
25 RITHOLZ LEVY FIELDS LLP
26 10940 Wilshire Boulevard
27 Suite 1600
28 Los Angeles, CA 90024
U.S.A.
Tel.: (310) 443-4176

29 **II. NATURE AND PURPOSE OF THE PROCEEDINGS**

30 In conformity with Article 3 of the Hague Convention on the Taking of
31 Evidence Abroad in Civil or Commercial Matters, March 18, 1970, 23 U.S.T. 2555

1 (the “Hague Convention”), the United States District Court for the Central District
2 of California, Western Division (this “Court”), presents its compliments to the
3 appropriate judicial authority of the Canton of Geneva (“Appropriate Judicial
4 Authority of Geneva”) and requests international judicial assistance to obtain
5 evidence to be used in in the trial of a civil proceeding before this Court in the
6 above-captioned matter. A trial on this matter before this Court is not yet
7 scheduled, however this Court has set a deadline of March 18, 2022 for acquiring
8 evidence in this matter.

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

15 **III. REQUEST**

16 This Court requests the assistance described herein as necessary in the
17 interests of justice. The assistance is that the Appropriate Judicial Authority of
18 Geneva compel the appearance of Ninel De Favari and Finakey SA in order to
19 obtain necessary testimonial evidence in **Exhibit A**. Ninel De Favari and Finakey
20 SA shall be referred to collectively as the “Deponent” herein.

21 This Court also requests that the Appropriate Judicial Authority of Geneva
22 compel the Deponent to produce copies of the specified documents in **Exhibit B**,
23 which are relevant to the above-captioned proceeding.

24 Details of Deponent:

25 Ninel De Favari
26 Rue du Clos 6
1207 Geneva, Switzerland

1 Finakey SA
2 Place de St-Gervais 1
3 GENÈVE, 1201 Switzerland

4 This Court requests that testimony from the Deponent be taken under oath or
5 affirmation by the Appropriate Judicial Authority of Geneva. This Court requests
6 that the below-named counsel of Valentino S.p.A. (“Authorized Representative”)
7 and its below-named Swiss lawyers be permitted to attend and, if possible, also
8 participate directly in the examination of the Deponent or ask supplementary
9 questions.

10 Authorized Representative:

11 Louis S. Ederer
12 Louis.Ederer@arnoldporter.com
13 Arnold & Porter Kaye Scholer LLP
14 250 West 55th Street
15 New York, NY 10019-9710
16 U.S.A.
17 Tel.: +1.212.836.8000
18 Fax: +1.212.836.8689

19 Swiss Lawyers Appointed by Valentino:

20 Rodolphe Gautier
21 Rodolphe.gautier@walderwyss.com
22 Walder Wyss Ltd.
23 Rue d’Italie 10
24 P.O. Box
25 1211 Geneva 3, Switzerland
26 Tel.: +41 58 658 30 00
27 Fax: +41 58 658 59 59

28 Markus Frick
Markus.frick@walderwyss.com
Walder Wyss Ltd.
Seefeldstrasse 123
P.O. Box,
8034 Zurich, Switzerland
Tel.: +41 58 658 58 58
Fax: +41 58 658 59 59

1 **IV. FACTUAL BACKGROUND**

2 Plaintiff Valentino S.p.A. (“Valentino”) has filed a Complaint against
3 Defendants Mario Valentino S.p.A. (“MV”) and Yarch Capital, LLC (“Yarch”, and,
4 together with MV, “Defendants”) alleging that Defendants have taken various steps
5 to deceive consumers in the United States into believing that Defendants’ handbags
6 are Valentino’s handbags in violation of United States federal trademark and unfair
7 competition law and California unfair competition law. Valentino has also alleged
8 that Defendants are infringing two of its United States design patents (USD 695,517
9 and USD 697,713) for handbags. Defendants deny that they engaged in any
10 deceptive conduct, infringed any valid patents, or harmed Valentino.

11 As is particularly relevant to this request, Valentino previously deposed a
12 director of Bowley during the relevant period of time, Susan Lim Wie. Ms. Lim
13 Wie, however, testified that she was merely a nominal director. She further testified
14 that the Deponent—Ms. De Faveri, in her capacity as an officer of Finakey SA—
15 was the director of Bowley from whom she took instruction and was therefore
16 knowledgeable of Bowley’s operations and decision-making. Furthermore, MV has
17 stated in discovery that the Deponent advised MV in connection with the
18 agreements between MV and Bowley. Valentino believes that testimony and
19 documents from the Deponent relating to Bowley will help determine the legitimacy
20 of Defendants’ defense and MV’s claim that MV is the senior registrant, owner, and
21 user of the relevant trademarks.

22 In defense of Valentino’s allegations, Defendants have argued, among other
23 things, that their behavior is protected because MV is the senior registrant, owner,
24 and user of certain “Valentino” trademarks in the United States. MV has also
25 asserted counterclaims for trademark infringement against Valentino based on MV’s
26 alleged senior registered trademark rights in the “Valentino” mark. Yarch
27

1 distributes “Valentino”-branded products in the United States pursuant to a 2013
2 trademark license agreement between MV and Yarch.

3 Valentino contends that documents in Valentino’s possession indicate that
4 MV transferred ownership of the relevant trademarks to a Singapore-registered
5 company called Bowley Investments Pte Ltd. (“Bowley”) pursuant to a 1996
6 Agreement between Bowley and MV (the “1996 Agreement”). The 1996
7 Agreement recites that Chelspire Limited Tudor House had carried out a market
8 research study and desired to acquire the MV trademarks. The 1996 Agreement
9 further recites that “Chelspire considered it appropriate to associate with other
10 investors via BOWLEY for the purpose of the above transaction subject to
11 Chelspire maintaining a majority shareholding.” Thus, based on the 1996
12 Agreement, Valentino contends that Chelspire appears to have been the majority
13 investor in Bowley for the purpose of carrying out the transaction effectuated by the
14 1996 Agreement. Pursuant to the paragraph 1 of the 1996 Agreement, “MV
15 transfers to BOWLEY as per the provisions of this Agreement the ownership of all
16 of its world-wide registered Trademarks”

17 MV denies that the effect of the 1996 Agreement was to transfer any rights in
18 the trademarks. MV contends that the purpose of the 1996 Agreement was to create
19 a security interest in the trademarks in Bowley’s favor and that at all times true
20 ownership remained with MV.

21 In 2001, MV and Bowley entered into another written agreement (the “2001
22 Agreement”) in which MV agreed, *inter alia*, to provide Bowley with know-how
23 necessary to manufacture products commercialized by Bowley. In 2016, Bowley
24 and MV entered into another agreement (the “2016 Agreement”). The 2016
25 Agreement recites that Bowley’s costs of maintaining registration and defense of the
26 MV trademarks are too expensive compared to the income they generate. As a
27

1 result, “Effective 1 July 2016, BOWLEY transfers to MV the property in fact and in
2 law of the Trademarks, in consideration of one peppercorn (if demanded).”

3 MV denies that the legal effect of the 2016 Agreement was to transfer
4 trademark rights back to MV. MV contends that the purpose of the 2016
5 Agreement was to terminate the security interest in the 2016 Agreement.

6 **V. PARTICULAR TESTIMONY AND DOCUMENTS REQUESTED**

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

11 This Court also requests that the Appropriate Judicial Authority of Geneva
12 compel the Deponent produce copies of the specified documents in **Exhibit B** (the
13 “Particular Requested Documents”).

14 MV and Yarch respectfully reserve their rights under Switzerland’s laws and
15 European Union’s laws to object to any and all Particular Testimonial Evidence and
16 Particular Requested Documents.

17 **VI. SPECIFIC ADDITIONAL REQUESTS**

18 This Court requests that the Deponent be compelled to provide the Particular
19 Testimonial Evidence on or before January 31, 2022, so that the parties will have
20 sufficient time to review the testimony and conduct any further discovery for
21 additional necessary documents or testimony, in advance of the March 18, 2022
22 deadline this Court has set for acquiring such evidence.

23 This Court requests delivery and receipt of copies of the Particular Requested
24 Documents on or before January 31, 2022, so that the parties will have sufficient
25 time to review these documents and conduct any further discovery for additional
26 necessary documents or testimony, in advance of the March 18, 2022 deadline this
27 Court has set for acquiring such evidence.

1 This Court requests that, should any portion of this request be denied, on legal
2 grounds, that such denial not affect the remainder of this request. In the event that
3 any portion of this request is denied, this Court requests that the Authorized
4 Representative and this Court be immediately informed of such denial and the
5 grounds for such denial.

6 This Court requests that the Appropriate Judicial Authority of Geneva provide
7 this Court and the Authorized Representative, as soon as convenient, all information
8 regarding the acquisition of evidence sought by this request, including the date,
9 time, and place designated for the requested testimony of the Deponent and the
10 production of documents.

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

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

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

6 In the event that the evidence requested cannot be taken in the manner
7 requested, this Court requests that the evidence be obtained in a manner that
8 conforms to Geneva law for the formal taking of evidence.

9 This Court requests that the confidentiality of this request and its exhibits be
10 preserved to the maximum extent permitted under the laws of Geneva.

11 **VII. OFFER OF RECIPROCAL ASSISTANCE**

12 This Court is willing to provide similar assistance to the judicial authorities of
13 Geneva and Switzerland. *See* 28 U.S.C. § 1782.

14 **VIII. REIMBURSEMENT FOR COSTS**

15 Valentino's counsel (Louis S. Ederer of Arnold & Porter Kaye Scholer LLP,
16 250 West 55th Street, New York, NY 10019-9710) is willing to reimburse the
17 Appropriate Judicial Authority of Geneva for reasonable costs incurred in executing
18 this Court's Letter Rogatory.

19 **IX. CLERK TO SEND DIRECTLY TO THE APPROPRIATE JUDICIAL**
20 **AUTHORITY OF GENEVA**

21 Valentino shall provide the Clerk of the Central District of California (the
22 "Clerk") a certified French translation of this order. The Clerk is hereby
23 ORDERED to directly send an original of this order to the Appropriate Judicial
24 Authority of Geneva, along with the certified French translation provided by
25 Valentino.

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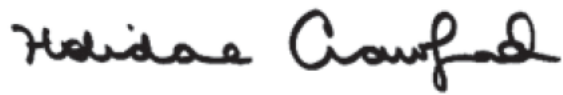
DATED: January 7, 2022 _____



Honorable Gail J. Standish
United States Magistrate Judge
United States District Court
Central District of California
Roybal Federal Building and United States
Courthouse
255 E. Temple Street
Courtroom 640, 6th Floor
Los Angeles, CA 90012
U.S.A.



[Seal of the court]



Holidae Crawford
Deputy Clerk

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. “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.
3. “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.
4. “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.
5. “USPTO” shall refer to the United States Patent and Trademark Office.
6. “You” or “Your” shall refer to Ninel de Faveri.

Requests for Testimony

1. If you can recall, please explain the purpose for which Bowley was formed.
2. If you can recall, please explain the genesis of the relationship between Mario Valentino and Bowley and/or Chelspire Limited.

3. If you can recall, please describe the role of Chelspire Limited in connection with any agreements between Mario Valentino and/or Bowley and the purpose of any such agreements.

4. If you can recall, please identify all owners of Bowley.

5. If you can recall, please identify any financial or ownership interest Mario Valentino had or has in Bowley and/or Chelspire.

6. If you can recall, please explain Your role as Director of Bowley.

7. If you can recall, please identify the role of the following individuals with respect to Bowley and Mario Valentino Trademarks: Susan Lim Wie, Cherrielyn Brockett, Vielka Barrios, and Pedro Mendes.

8. If you can recall, with respect to any assignment or other conveyance of the Mario Valentino Trademarks between Bowley and Mario Valentino, please identify any other rights or property transferred from the assignor to the assignee along with the rights in the Mario Valentino Trademarks.

9. If you can recall, with respect to the 1996 Agreement between Bowley and Mario Valentino, please identify:

- a. The individuals involved in drafting and negotiating the agreement;
- b. Your and/or Bowley's understanding of the terms of the agreement and its purpose with respect to any assignment, license, or other conveyance of trademark rights;
- c. Any consideration paid or received by any party to the agreement;
- d. How responsibilities were divided in implementing the agreement as between Mario Valentino and Bowley, including with respect to exercise of quality control, maintenance of trademark registrations, designing products, manufacturing products, advertising products, handling customer complaints, and policing infringement; and
- e. The products offered by Bowley and/or Mario Valentino during the existence of the agreement and the extent of advertising and sales of those products inside and outside the United States.

10. If you can recall, 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.

11. If you can recall, please explain Bowley's involvement in the 2013 license agreement between Mario Valentino and Yarch Capital, LLC.

12. If you can recall, with respect to the 2001 Agreement between Bowley and Mario Valentino, please identify:

- a. The individuals involved in drafting and negotiating the agreement;
 - b. Your and/or Bowley's understanding of the terms of the agreement and its purpose with respect to any assignment, license, or other conveyance of trademark rights;
 - c. Any consideration paid or received by any party to the agreement;
 - d. How responsibilities were divided in implementing the agreement as between Mario Valentino and Bowley, including with respect to exercise of quality control, maintenance of trademark registrations, designing products, manufacturing products, advertising products, handling customer complaints, and policing infringement; and
 - e. The products offered by Bowley and/or Mario Valentino during the existence of the agreement and the extent of advertising and sales of those products inside and outside the United States.
13. If you can recall, please identify:
- a. The individuals involved in drafting and negotiating the agreement;
 - b. Your and/or Bowley's understanding of the terms of the agreement and its purpose with respect to any assignment, license, or other conveyance of trademark rights;
 - c. Any consideration paid or received by any party to the agreement; and
 - d. The products offered by Bowley and/or Mario Valentino during the existence of the agreement and the extent of advertising and sales of those products inside and outside the United States.

14. If you can recall, please explain the extent of Mario Valentino's use of the Mario Valentino USA Trademarks in the United States between (1) 1991 to 1996 and (2) 1996 to 2016.

15. For each document produced in response to a request for documents, please describe, to the extent you know, how the document was created, maintained, and located for production.

16. Have you provided all information within your knowledge responsive to the foregoing questions?

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. “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.
3. “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.
4. “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. Emails, letters, and transcripts/minutes of phone calls concerning the negotiation of the 1996 Agreement between Mario Valentino and Bowley (dated between November 1, 1996 to December 31, 1996), the 2001 Agreement between Mario Valentino and Bowley (dated between May 1, 2001 to June 30, 2001), and the 2016 Agreement between Mario Valentino and Bowley (dated between April 1, 2016 to May 31, 2016).
2. Emails, letters, and transcripts/minutes of phone calls from February to April 2013 between Bowley and Mario Valentino regarding a potential License Agreement between Mario Valentino, Yarch Capital LLC.

3. Emails, letters, and transcripts/minutes of phone calls between Mario Valentino and Bowley from April to May 2002 and from October to November 2002 concerning any filings with the United States Patent and Trademark Officer regarding the Mario Valentino USA Trademarks.

4. Accounting statements 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.

5. Accounting statements 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.

6. Accounting statements evidencing the payments made from Bowley to Mario Valentino in connection with the payment of costs or fees associated with any filings related to the Mario Valentino USA Trademarks/ with the United States Patent and Trademark Office.