

TO: Mail Stop 8 Director of the U.S. Patent and Trademark Office P.O. Box 1450 Alexandria, VA 22313-1450	REPORT ON THE FILING OR DETERMINATION OF AN ACTION REGARDING A PATENT OR TRADEMARK
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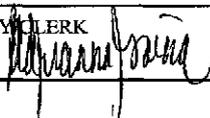
In Compliance with 35 U.S.C. § 290 and/or 15 U.S.C. § 1116 you are hereby advised that a court action has been filed in the U.S. District Court San Diego on the following Patents or Trademarks:

DOCKET NO.	DATE FILED	U.S. DISTRICT COURT
08-CV-0940-W-LSP	05/28/2008	Southern District of California
PLAINTIFF		DEFENDANT
BMW of North America, LLC et al		Bluestar Wheels, Inc.
PATENT OR TRADEMARK NO.	PATENT OR TRADEMARK NO.	PATENT OR TRADEMARK NO.
1 See complaint D560,152	6	11
2 D522,949 D560,585	7	12
3	8	13
4	9	14
5	10	15

In the above-entitled case, the following patent(s)/trademark(s) have been included:

DATE INCLUDED	INCLUDED BY		
	<input type="checkbox"/> Amendment	<input type="checkbox"/> Answer	<input type="checkbox"/> Cross Bill <input type="checkbox"/> Other Pleading
PATENT OR TRADEMARK NO.	PATENT OR TRADEMARK NO.	PATENT OR TRADEMARK NO.	PATENT OR TRADEMARK NO.
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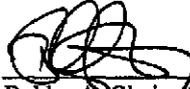
In the above-entitled case, the following decision has been rendered or judgment issued:

DECISION/JUDGMENT 		
CLERK	(BY) DEPUTY CLERK	DATE
W. Samuel Hamrick, Jr.		5/16/08

1 (d) the Court award prejudgment interest and costs of this action.

2 6. BMW recover such other relief as the Court may deem appropriate.

3
4 Respectfully submitted,

5 

6 Bobby A. Ghajar (SBN 198719)
7 HOWREY LLP
8 550 South Hope Street, Suite 1100
9 Los Angeles, CA 90071
10 Telephone: (213) 892-1800
11 Facsimile: (213) 892-2300

6 Dated: May 27, 2008

10 OF COUNSEL:
11 Kevin J. Healy, Esq.
12 BMW OF NORTH AMERICA, LLC
13 300 Chestnut Ridge Road
14 Woodcliff Lake, NJ 07677
15 Telephone: (201) 307-4000

14 Counsel for Plaintiff
15 BMW of North America, LLC

10 John G. Froemming, Esq. (*pro hac vice* application
11 to be submitted)
12 Michael J. Bell, Esq. (*pro hac vice* application to be
13 submitted)
14 David M. Jaquette, Esq. (*pro hac vice* application to
15 be submitted)
16 HOWREY LLP
17 1299 Pennsylvania Avenue, N.W.
18 Washington, D.C. 20004
19 Telephone: (202) 783-0800
20 Facsimile: (202) 383-6610

21 *Attorneys for Plaintiffs*
22 BMW of North America, LLC
23 and Bayerische Motoren Werke AG
24
25
26
27
28

1 Dale J. Giali (SBN 150382)
HOWREY LLP
2 4 Park Plaza, Suite 1700
Irvine, CA 92614
3 Telephone: (949) 721-6900
Facsimile: (949) 266-5529
4 gialid@howrey.com

5 John G. Froemming (*pro hac vice* application not yet submitted)
Michael J. Bell (*pro hac vice* application not yet submitted)
6 HOWREY LLP
1299 Pennsylvania Avenue, N.W.
7 Washington, D.C. 20004
Telephone: (202) 783-0800
8 Facsimile: (202) 383-6610

9 *Attorneys for Plaintiffs BMW of North America, LLC and*
Bayerische Motoren Werke AG
10

11 UNITED STATES DISTRICT COURT
12 SOUTHERN DISTRICT OF CALIFORNIA

13 BMW of North America, LLC, et al.,
14 Plaintiffs,
15 v.
16 Bluestar Wheels, Inc.,
17 Defendant.

Case No. 08-CV-0940W LSP

NOTICE OF VOLUNTARY DISMISSAL

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TO THE COURT, CLERK, PLAINTIFF AND ITS ATTORNEYS:

PLEASE TAKE NOTICE that pursuant to Rule 41(a) of the Federal Rules of Civil Procedure, plaintiffs voluntarily dismiss the above-referenced action with prejudice.

HOWREY LLP
John G. Froemming
Michael J. Bell
Dale J. Giali

Dated: September 24, 2008

/s/
by: _____
Dale J. Giali

*Attorneys for Plaintiffs BMW of North America, LLC and
Bayerische Motoren Werke AG*

PROOF OF SERVICE

I am employed in the County of Orange, State of California. I am over the age of 18 and not a party to the within action. My business address is 4 Park Plaza, Suite 1700, Irvine, CA 92614.

On September 24, 2008, I served on the interested parties in said action the within:

NOTICE OF VOLUNTARY DISMISSAL

by placing true copies thereof in a sealed envelope(s) addressed as stated below and causing such envelope(s) to be deposited in the U.S. Mail at Irvine, California.

Bernard L. Kleinke, Esq.
DUCKOR SPRADLING METZGER & WYNNE
3043 4th Avenue
San Diego, CA 92103

Counsel for Bluestar Wheels, Inc.

(MAIL) I am readily familiar with this firm's practice of collection and processing correspondence for mailing. Under that practice it would be deposited with the U.S. postal service on that same day in the ordinary course of business. I am aware that on motion of party served, service is presumed invalid if postal cancellation date or postage meter date is more than 1 day after date of deposit for mailing in affidavit.

I declare under penalty of perjury that I am employed in the office of a member of the bar of this Court at whose direction the service was made and that the foregoing is true and correct.

Executed on September 24, 2008, at Irvine, California.

Genevieve Ramirez

/s/

(Signature)

ORIGINAL

1 Bobby A. Ghajar, Esq. (SBN 198719)
HOWREY LLP
2 550 South Hope Street, Suite 1100
Los Angeles, CA 90071
3 Telephone: (213) 892-1800
4 Facsimile: (213) 892-2300

FILED
MAY 28 2008
CLERK, U.S. DISTRICT COURT
SOUTHERN DISTRICT OF CALIFORNIA
BY *[Signature]* DEPUTY

5 John G. Froemming, Esq. (*pro hac vice* application to be submitted)
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7 1299 Pennsylvania Avenue, N.W.
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10 Attorneys for Plaintiffs

11 UNITED STATES DISTRICT COURT
12 SOUTHERN DISTRICT OF CALIFORNIA

13
14 BMW of North America, LLC and)
15 Bayerische Motoren Werke AG,)
16 Plaintiffs,)
17 v.)
18 Bluestar Wheels, Inc.,)
19 Defendant.)
20)
21)

Case No: '08 CV 0940 W LSP

**COMPLAINT FOR DESIGN
PATENT INFRINGEMENT AND
UNFAIR COMPETITION**

22 Plaintiffs BMW of North America, LLC and Bayerische Motoren Werke AG (collectively
23 "BMW") seek injunctive and monetary relief from Defendant Bluestar Wheels, Inc. (hereinafter,
24 "Bluestar" or "Defendant") for design patent infringement and unfair competition. As alleged more
25 fully below, Defendant has violated and continues to violate the Patent Act, 35 U.S.C. § 271, the
26 Trademark Act of 1946 as amended, 15 U.S.C. §§ 1051 *et seq.* (the "Lanham Act"), and California law
27 through its sale of wheel rims that infringe Plaintiffs' design patents.

[Handwritten mark]

PARTIES

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2 1. Plaintiff BMW of North America, LLC ("BMW NA") is a Delaware limited liability
3 company with its principal place of business at 300 Chestnut Ridge Road, Woodcliff Lake, New Jersey
4 07677. BMW NA is a wholly owned subsidiary of BMW (US) Holding Corporation, a Delaware
5 corporation, which is a wholly owned subsidiary of Bayerische Motoren Werke AG. BMW NA is the
6 exclusive authorized distributor of BMW automotive and related products in the United States.

7 2. Plaintiff Bayerische Motoren Werke AG ("BMW AG") is a corporation organized
8 under the laws of the Federal Republic of Germany with its principal place of business at 80788
9 Munich, Germany. BMW AG manufactures motor vehicles, parts and other products for sale in
10 Germany and for export and sale throughout the world.

11 3. Upon information and belief, Defendant Bluestar Wheels, Inc. is a California
12 corporation with its principal place of business at 215 S. Highway 101 Suite 201, San Diego, CA
13 92121.

14 **JURISDICTION AND VENUE**

15 4. This is an action arising under the patent and trademark laws of the United States,
16 specifically Titles 35 and 15 of the United States Code, 35 U.S.C. § 271 and 15 U.S.C. § 1051 *et seq.*

17 5. This Court has personal jurisdiction over Defendant because Defendant resides in and
18 conducts business in California.

19 6. This Court has jurisdiction over the subject matter of this action under 15 U.S.C. § 1121
20 and 28 U.S.C. §§ 1331 and 1338(a) and 1338(b), and has supplemental jurisdiction under 28 U.S.C. §
21 1367(a) over BMW's claims under California law.

22 7. Venue is proper in this District under 28 U.S.C. § 1391(b), as Defendant has its
23 principal place of business in this District and, upon information and belief, a substantial part of the
24 events or omissions giving rise to the claims herein occurred and are occurring in this District.
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COUNT I
DESIGN PATENT INFRINGEMENT
U.S. DESIGN PATENT NO. 560,152
(35 U.S.C. §271)

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5 16. BMW realleges and incorporates the allegations set forth in paragraphs 1 through 15
6 herein.

7 17. Defendant is infringing U.S. Design Patent No. 560,152 in violation of 35 U.S.C § 271
8 by making, using, offering for sale and/or selling products that are covered by the '152 patent in the
9 United States.

10 18. Defendant's acts complained of herein have been willful, deliberate and with conscious
11 disregard of BMW's U.S. design patent rights.

12 19. As a result of Defendant's infringement, Plaintiffs have suffered and will continue to
13 suffer damages. Upon information and belief, Defendant's infringement will persist unless enjoined
14 by this Court.

15 20. The acts complained of herein constitute design patent infringement in violation of 35
16 U.S.C. § 271.

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18 **COUNT II**
DESIGN PATENT INFRINGEMENT
U.S. DESIGN PATENT NO. 522,949
(35 U.S.C. §271)

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21 21. BMW realleges and incorporates the allegations set forth in paragraphs 1 through 20
22 herein.

23
24 22. Defendant is infringing U.S. Design Patent No. 522,949 in violation of 35 U.S.C § 271
25 by making, using, offering for sale and/or selling products that are covered by the '949 patent in the
26 United States.

1 23. Defendant's acts complained of herein have been willful, deliberate and with conscious
2 disregard of BMW's U.S. design patent rights.

3 24. As a result of Defendant's infringement, Plaintiffs have suffered and will continue to
4 suffer damages. Upon information and belief, Defendant's infringement will persist unless enjoined
5 by this Court.

6 25. The acts complained of herein constitute design patent infringement in violation of 35
7 U.S.C. § 271.

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9 **COUNT III**
10 **DESIGN PATENT INFRINGEMENT**
11 **U.S. DESIGN PATENT NO. 560,585**
12 **(35 U.S.C. §271)**

13 26. BMW realleges and incorporates the allegations set forth in paragraphs 1 through 25
14 herein.

15 27. Defendant is infringing U.S. Design Patent No. 560,585 in violation of 35 U.S.C § 271
16 by making, using, offering for sale and/or selling products that are covered by the '585 patent in the
17 United States.

18 28. Defendant's acts complained of herein have been willful, deliberate and with conscious
19 disregard of BMW's U.S. design patent rights.

20 29. As a result of Defendant's infringement, Plaintiffs have suffered and will continue to
21 suffer damages. Upon information and belief, Defendant's infringement will persist unless enjoined
22 by this Court.

23 30. The acts complained of herein constitute design patent infringement in violation of 35
24 U.S.C. § 271.

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COUNT IV
FEDERAL UNFAIR COMPETITION, FALSE DESIGNATION OF ORIGIN
(Lanham Act § 43(a), 15 U.S.C. § 1125)

31. BMW realleges and incorporates the allegations set forth in paragraphs 1 through 30 herein.

32. Defendant's unauthorized use of BMW's design patents in connection with the sale of wheel rims that are not made or authorized by BMW and Defendant's claim that such wheels "are manufactured in an original equipment plant" falsely indicates that Defendant and its products and services are connected with, sponsored by, affiliated with, or related to BMW.

33. Defendant's unauthorized use of BMW's design patents in connection with the sale of wheel rims that are not made or authorized by BMW and Defendant's claim that such wheels "are manufactured in an original equipment plant" has caused, and is likely to continue to cause confusion, mistake, and deception as to the source or sponsorship of Defendant and its products and services.

34. The acts of Defendant complained of herein constitute unfair competition, false designation of origin, and trade name infringement in violation of Section 43(a) of the Lanham Act, 15 U.S.C. § 1125(a).

35. Defendant's acts complained of herein have been deliberate, willful, and intentional, with full knowledge and in conscious disregard of BMW's rights in its design patent rights.

36. As a result of the foregoing alleged actions of Defendant, BMW has been injured and damaged. Unless the foregoing alleged actions of Defendant are enjoined, BMW will continue to suffer injury and damage.

COUNT V
UNFAIR COMPETITION
(California Unfair Competition Statute,
Cal. Bus. & Prof. Code § 17200 et seq.)

37. BMW re-alleges and incorporates the allegations set forth in paragraphs 1 through 36 herein.

1 38. The acts of Defendant complained of herein constitute unlawful and unfair competition
2 in violation of the California Unfair Competition Statute, Cal. Bus. & Prof. Code § 17200, as they are
3 likely to deceive and mislead the public.

4 39. As a result of the foregoing alleged actions of Defendant, Defendant has been unjustly
5 enriched and BMW has been injured and damaged. Unless the foregoing alleged actions of Defendant
6 are enjoined, BMW will continue to suffer injury and damage.

7
8 **COUNT VI**
9 **UNFAIR COMPETITION**
10 **(Common Law of California)**

11 40. BMW re-alleges and incorporates the allegations set forth in paragraphs 1 through 39
12 herein.

13 41. The acts of Defendant complained of herein constitute unfair competition in violation of
14 the common law of California.

15 42. As a result of the foregoing alleged actions, Defendant has been unjustly enriched and
16 BMW has been injured and damaged. Unless the foregoing alleged actions of Defendant are enjoined,
17 BMW will continue to suffer injury and damage.

18 **PRAYER FOR RELIEF**

19
20 WHEREFORE, BMW prays that:

- 21 1. Defendant be adjudged liable as to the foregoing claims.
22 2. Defendant, its agents, servants, employees, and all others in active concert or
23 participation with any of them, be permanently enjoined and restrained from:

- 24 (a) manufacturing, importing, marketing, advertising, offering to sell and/or selling
25 wheel rims that infringe upon BMW's U.S. Design Patent Nos. 560,152;
26 522,949; and 560,585;
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- 1 (b) claiming or otherwise suggesting that Defendant is an original equipment
2 ("OE") manufacturer, supplier or distributor for BMW; and
3 (c) doing any other act or thing likely to confuse, mislead, or deceive others into
4 believing that Defendant emanates from, or is connected with, sponsored or
5 approved by, BMW or that any of Defendant's products are otherwise
6 authorized by BMW.

7 3. Defendant, in accordance with Section 34(a) of the United States Trademark Act, 15
8 U.S.C. § 1116(a), be required to file with the Court, and serve upon Plaintiffs, within thirty (30)
9 days after the entry and service on Defendant of an injunction, a report in writing and under
10 oath, setting forth in detail the manner and form in which Defendant has complied with the
11 terms of such injunction.

12 4. For Defendant's repeated, willful, and deliberate design patent infringement:

- 13 (a) Defendant be held liable to the extent of its total profits from design patent
14 infringement, but no less than \$250, pursuant to 35 U.S.C. § 289; and
15 (b) the Court award BMW treble damages, pursuant to 35 U.S.C. § 284, and
16 declare this case exceptional and award BMW its attorneys' fees pursuant to 35
17 U.S.C. § 285.
18 (c) the Court award prejudgment interest and costs of this action.

19 5. Defendant be required to pay to BMW for its acts of unfair competition:

- 20 (a) in accordance with Section 35(a) of the United States Trademark Act, 15 U.S.C.
21 § 1117(a) and (b), an award of treble Plaintiffs' actual damages plus
22 Defendant's profits resulting from Defendant's unauthorized use of BMW's
23 design patents in connection with the sale of wheel rims that are not made or
24 authorized by BMW and Defendant's claim that such wheels "are manufactured
25 in an original equipment plant";
26 (b) punitive damages for Defendant's acts of unfair competition;
27 (c) BMW's attorneys' fees for this action; and
28