

UNITED STATES DISTRICT COURT
EASTERN DISTRICT OF NEW YORK

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Roche Diabetes Care, Inc., Roche Diabetes Care
GmbH, and Hoffmann-La Roche, Inc.,

Plaintiffs,

ORDER
24-CV-03625 (DG) (RML)

-against-

JMD Enterprises d/b/a DKY Store USA, JMD
International, Dileep Kumar Yadav, Abhishek Jain,
Medical Hub_USA Store, Ratnakar Sharma,
Authentic Indian Store, and Atikur Rahman,

Defendants.

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DIANE GUJARATI, United States District Judge:

On May 20, 2024, Plaintiffs Roche Diabetes Care, Inc., Roche Diabetes Care GmbH, and Hoffmann-La Roche, Inc. (collectively, “Plaintiffs” or “Roche”) commenced this action against JMD Enterprises d/b/a DKY Store USA, JMD International, Dileep Kumar Yadav, Abhishek Jain, Medical Hub_USA Store, Ratnakar Sharma, Authentic Indian Store, and Atikur Rahman (collectively, “Defendants”), alleging federal trademark infringement in violation of 15 U.S.C. §§ 1114(1)(a) and (b); federal unfair competition in violation of 15 U.S.C. § 1125(a)(i)(A); common law unfair competition; state law trademark dilution; state law deceptive business practices; unjust enrichment; importation of goods bearing infringing marks in violation of 15 U.S.C. § 1124; false description and designation of origin in commerce; and federal false advertising. *See generally* Complaint, ECF No. 1.

Also on May 20, 2024, Plaintiffs filed an *ex parte* Motion for Temporary Restraining Order and Order to Show Cause for a Preliminary Injunction, ECF No. 3, together with supporting documents, including Plaintiffs’ Memorandum of Law, ECF No. 9, and Declarations of Kerri McAleavey, ECF No. 10; Hannah Coleman, ECF No. 10-1; Chandan Sharma, ECF No.

10-2; Keith Verner, ECF No. 10-3; Patrick Barron, ECF No. 10-4; Debra Robinson, ECF No. 10-5; Connor Brooks, ECF No. 10-6; and Geoffrey Potter, ECF No. 10-7.¹


On May 22, 2024, the Court held an *ex parte* conference, at which the Court addressed Plaintiffs' submissions; directed Plaintiffs to file revised versions of the documents filed at ECF Nos. 3 and 5; and reserved decision on Plaintiffs' outstanding requests. *See* Minute Entry dated May 22, 2024.² On May 23, 2024, Plaintiffs filed revised versions of the documents filed at ECF Nos. 3 and 5. *See* Motion for Order to Show Cause for a Preliminary Injunction, Motion for Temporary Restraining Order (the "Motion"), ECF No. 14; ECF No. 15 (revised Proposed Letter of Request to Judicial Authorities of the Honorable High Court of Delhi at New Delhi).

Plaintiffs request that the Court issue an order directing, *inter alia*, that Defendants and their principals, agents, officers, directors, members, servants, employees, successors, assigns and all other persons in concert and participation with them, shall, upon service of such order, be immediately temporarily restrained from engaging in any or all of the following acts in U.S. commerce:

1. Purchasing, selling, distributing, marketing, manufacturing, or otherwise using any of the Accu-Chek Marks (as defined herein) on any counterfeit or authentic product, or any marks confusingly similar thereto in connection with any products. The "Accu-Chek Marks" are defined as the following:

¹ Also on May 20, 2024, Plaintiffs filed, *inter alia*, a Proposed Sealing Order, ECF No. 4; a Proposed Letter of Request to the Judicial Authorities of the Honorable High Court of Delhi at New Delhi, ECF No. 5; a Proposed Asset Freeze Order, ECF No. 6; a Proposed Expedited Party Discovery Order, ECF No. 7; and a Proposed Order Permitting Electronic Service, ECF No. 8. Each of Plaintiffs' submissions to date has been filed *ex parte* and under seal.

² With respect to Plaintiffs' sealing request, *see* ECF No. 4, the Court stated that it would permit the caption of the case and all documents and orders filed in the case to remain under seal until further order of the Court. *See* Minute Entry dated May 22, 2024.

Trademark	Registration Number(s)	Registration Date
ACCU-CHEK	2,403,536	November 14, 2000
ACCU-CHEK SMARTVIEW	4,230,563	October 23, 2012
ACCU-CHEK NANO SMARTVIEW	4,226,844	October 16, 2012
SOFTCLIX	1,780,139	July 6, 1993
ACCU-CHEK GUIDE	5,256,607	August 1, 2017
ACCU-CHEK GUIDE ME	6,042,931	April 28, 2020
ACCU-CHEK NANO	4,214,217	September 25, 2012
ACCU-CHEK AVIVA	3,071,846	March 21, 2006
ACCU-CHEK AVIVA COMBO	3,602,826	April 7, 2009
ACCU-CHEK AVIVA CONNECT	4,561,864	July 8, 2014
ACCU-CHEK AVIVA EXPERT	3,602,825	April 7, 2009
	5,363,165; 5,363,167; 5,363,168	December 26, 2017

2. Using any logo, trade name, or trademark confusingly similar to any of the Accu-Chek Marks which may be calculated to falsely represent or which has the effect of falsely representing that the services or products of any or all of the defendants or of others are sponsored by, authorized by, or in any way associated with Plaintiffs;
3. Infringing any of the Accu-Chek Marks;
4. Falsely representing any or all of Defendants as being connected with Plaintiffs, or sponsored by or associated with Plaintiffs, or engaging in any act which is likely to cause the trade, retailers and/or members of the purchasing public to believe that any or all of Defendants are associated with Plaintiffs;

5. Using any reproduction, counterfeit, copy, or colorable imitation of any of the Accu-Chek Marks in connection with the publicity, promotion, sale, or advertising of any product;
6. Affixing, applying, annexing, or using in connection with the sale of any goods, a false description or representation including words or other symbols tending to falsely describe or represent such goods as being Roche products, and from offering such goods in commerce;
7. Removing from their premises, or discarding, destroying, transferring, or disposing in any manner any information, computer files, electronic files, WhatsApp or text messages, business records (including but not limited to e-mail communications), or other documents relating to Defendants' assets and operations or relating in any way to the purchase, sale, manufacture, offer for sale, distribution, negotiation, importation, advertisement, promotion, or receipt of any products purporting to be Roche products, including without limitation any products bearing any of the Accu-Chek Marks; and
8. Assisting, aiding, or abetting any other person or business entity in engaging in or performing any of the activities referred to in subparagraphs (1) through (7) above.

* * *

“A party seeking a preliminary injunction must demonstrate: (1) ‘a likelihood of success on the merits or . . . sufficiently serious questions going to the merits to make them a fair ground for litigation and a balance of hardships tipping decidedly in the plaintiff’s favor’; (2) a likelihood of ‘irreparable injury in the absence of an injunction’; (3) that ‘the balance of

hardships tips in the plaintiff's favor'; and (4) that the 'public interest would not be disserved' by the issuance of an injunction." *Benihana, Inc. v. Benihana of Tokyo, LLC*, 784 F.3d 887, 895 (2d Cir. 2015) (alteration in original) (quoting *Salinger v. Colting*, 607 F.3d 68, 79-80 (2d Cir. 2010)). The party seeking injunctive relief "need only show a likelihood of success on the merits of at least one of [its] claims." *Home It, Inc. v. Wen*, No. 19-CV-07070, 2020 WL 353098, at *5 (E.D.N.Y. Jan. 21, 2020) (quotation omitted). In this Circuit, "the standard for an entry of a [temporary restraining order] is the same as for a preliminary injunction." *See Andino v. Fischer*, 555 F. Supp. 2d 418, 419 (S.D.N.Y. 2008) (citations omitted). A plaintiff seeking a temporary restraining order shall be entitled to a rebuttable presumption of irreparable harm upon a finding of likelihood of success on the merits for a violation identified in 15 U.S.C. § 1116(a). *See* 15 U.S.C. § 1116(a). Pursuant to Rule 65(b)(1) of the Federal Rules of Civil Procedure ("Rule 65(b)(1)"), a court "may issue a temporary restraining order without written or oral notice to the adverse party or its attorney only if . . . specific facts in an affidavit or a verified complaint clearly show that immediate and irreparable injury, loss, or damage will result to the movant before the adverse party can be heard in opposition" and "the movant's attorney certifies in writing any efforts made to give notice and the reasons why it should not be required." *See* Fed. R. Civ. P. 65(b)(1).

Having considered all of the filings to date in this action, including the declarations, and having heard from Plaintiffs at the May 22, 2024 *ex parte* conference, the Court concludes that Plaintiffs have shown a likelihood of success on at least some of their claims – specifically, Plaintiffs have carried their burden of demonstrating, at a minimum, a likelihood of success on their federal trademark infringement claims. *See* 15 U.S.C. § 1114. Plaintiffs have also submitted evidence demonstrating a likelihood of irreparable injury, including damage to

Plaintiffs' reputation and goodwill, absent a Temporary Restraining Order. The harm to Plaintiffs that would result from a denial of the request for a Temporary Restraining Order substantially outweighs any harm to Defendants that would result from a grant of the request. Issuance of the requested Temporary Restraining Order is in the public interest, particularly in light of the potential risk to public health and safety.

At this stage and on the record before the Court, the Court concludes that a Temporary Restraining Order is warranted.

The Court further concludes that Plaintiffs have met the requirements set forth in Rule 65(b)(1) such that a Temporary Restraining Order may issue without written or oral notice to Defendants. *See* Fed. R. Civ. P. 65(b)(1); ECF No. 10-7 ¶ 11. Geoffrey Potter, counsel for Plaintiffs, represents in his Declaration: Plaintiffs have not attempted to give notice to Defendants; Plaintiffs have set forth evidence demonstrating that Defendants are willful counterfeiters of dangerous medical devices that are based in India, sell their counterfeits online, and are likely to disappear, conceal evidence and their ill-gotten gains, and resume their counterfeiting under a different identity if given notice; and Plaintiffs have requested from the Court a Letter of Request supporting an *ex parte* seizure order by the Indian courts and providing notice or making this action publicly available would tip off Defendants and defeat the purpose of the requested seizure order. *See* ECF No. 10-7 ¶ 11. The ongoing trademark infringement described in Plaintiffs' submissions will result in immediate and irreparable injury to Plaintiffs, including damage to Plaintiffs' reputation and goodwill, and notice should not be required for the reasons asserted by Plaintiffs.

Plaintiffs' request for a Temporary Restraining Order, *see* ECF No. 14, is GRANTED.

Temporary Restraining Order

IT IS THEREFORE ORDERED that:

Defendants, their principals, agents, officers, directors, members, servants, employees, successors, assigns, and all other persons in concert and participation with them, shall, upon service of this Order, be immediately temporarily restrained, pursuant to Rule 65(b), from engaging in any or all of the following acts in U.S. commerce:

1. Purchasing, selling, distributing, marketing, manufacturing, or otherwise using any of the Accu-Chek Marks (as defined above) on any counterfeit or authentic product, or any marks confusingly similar thereto in connection with any products.
2. Using any logo, trade name, or trademark confusingly similar to any of the Accu-Chek Marks which may be calculated to falsely represent or which has the effect of falsely representing that the services or products of any or all of Defendants or of others are sponsored by, authorized by, or in any way associated with Plaintiffs;
3. Infringing any of the Accu-Chek Marks;
4. Falsely representing any or all of Defendants as being connected with Plaintiffs, or sponsored by or associated with Plaintiffs, or engaging in any act which is likely to cause the trade, retailers and/or members of the purchasing public to believe that any or all of Defendants are associated with Plaintiffs;
5. Using any reproduction, counterfeit, copy, or colorable imitation of any of the Accu-Chek Marks in connection with the publicity, promotion, sale, or advertising of any product;

6. Affixing, applying, annexing, or using in connection with the sale of any goods, a false description or representation including words or other symbols tending to falsely describe or represent such goods as being Roche products, and from offering such goods in commerce;
7. Removing from their premises, or discarding, destroying, transferring, or disposing in any manner any information, computer files, electronic files, WhatsApp or text messages, business records (including but not limited to e-mail communications), or other documents relating to Defendants' assets and operations or relating in any way to the purchase, sale, manufacture, offer for sale, distribution, negotiation, importation, advertisement, promotion, or receipt of any products purporting to be Roche products, including without limitation any products bearing any of the Accu-Chek Marks; and
8. Assisting, aiding, or abetting any other person or business entity in engaging in or performing any of the activities referred to in subparagraphs (1) through (7) above.

IT IS FURTHER ORDERED that the Temporary Restraining Order as set forth in subparagraphs (1) through (8) above shall be in effect for a period of 14 days from the entry of this Order, after which it shall expire absent further order of the Court.

Bond

IT IS FURTHER ORDERED that within three business days of the entry of this Order, Plaintiffs shall post an undertaking with the Clerk of Court in the form of a bond, cash, or check in the amount of \$10,000 as security to pay the costs and damages sustained by any party found

to have been wrongfully enjoined or restrained, and that such undertaking, if in the form of check or cash, shall be held in an interest-bearing account.

Preliminary Injunction

IT IS FURTHER ORDERED that Defendants shall appear before the Court on June 7, 2024 at 11:00 a.m. in Courtroom 4B South to show cause as to why a preliminary injunction, pursuant to Rule 65 of the Federal Rules of Civil Procedure, should not be issued enjoining Defendants in the manner set forth above for the duration of this litigation; and

IT IS FURTHER ORDERED that Defendants shall file and serve on Plaintiffs' counsel, Geoffrey Potter, by email at gpotter@pbwt.com and counterfeitrocheteststrips@pbwt.com any opposition by May 31, 2024. Plaintiffs shall file and serve on Defendants any reply by June 3, 2024; and

IT IS FURTHER ORDERED that Defendants are hereby put on notice that failure to attend the show cause hearing scheduled herein shall result in the issuance of a preliminary injunction, which shall be deemed to take effect immediately and which shall remain in effect during the pendency of this action.

SO ORDERED.

/s/ Diane Gujarati

DIANE GUJARATI
United States District Judge

Issued: May 24, 2024 at 8:45 p.m.
Brooklyn, New York