

ORIGINAL

IN THE SUPREME COURT OF OHIO

| | | |
|----------------------|---|--------------------------------------|
| STATE OF OHIO, |) | Case No. 2008-2490 |
| |) | |
| Plaintiff-Appellant, |) | On Appeal from the |
| |) | Lake County Court of Appeals, |
| v. |) | Eleventh Appellate District |
| |) | |
| JUANITA M. TROISI |) | |
| |) | Court of Appeals Case No. 2008-L-060 |
| Defendant-Appellee. |) | |

MERIT BRIEF OF APPELLEE JUANITA M. TROISI

Dominic J. Vitantonio (0052058)
Argie, D'Amico & Vitantonio
6449 Wilson Mills Road
Mayfield Village, Ohio 44143-3402
(440) 449-3333

COUNSEL FOR APPELLEE, JUANITA M. TROISI

Charles E. Coulson (0008667)
Prosecuting Attorney, Lake County, Ohio

Teri R. Daniel (0082157)
Assistant Prosecuting Attorney
Administration Building
105 Main Street, P.O. Box 490
Painesville, Ohio 44077
(440) 350-2683

COUNSEL FOR APPELLANT, STATE OF OHIO

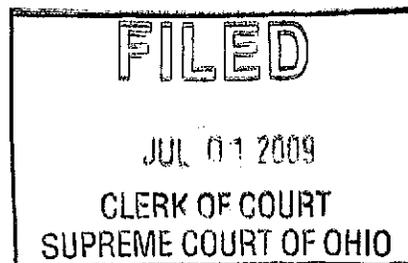
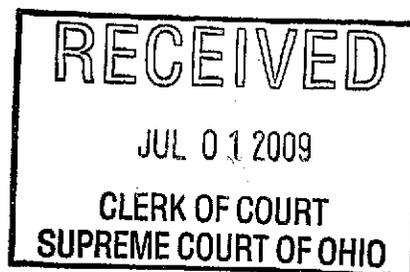


TABLE OF CONTENTS

TABLE OF
AUTHORITIES.....IV

ANSWERS TO APPELLANT’S CONTENTIONS.....1

(1) APPELLEE’S ANSWERS TO THE CONTENTIONS OF
APPELLANT RAISED IN PROPOSITION OF LAW NO.1
CONCERNING REVERSALS OF CONVICTIONS
BASED UPON INSUFFICIENT EVIDENCE VERSUS
CONVICTIONS BASED UPON PROCEDURAL
DEFICIENCIES, THE DISTINCTIONS BETWEEN
THE TWO TYPES OF REVERSALS AND THE LAW
CONCERNING OF RETRIALS IN SUCH CASES.....1

(2) APPELLEE’S ANSWER TO THE CONTENTIONS
OF APPELLANT RAISED IN PROPOSITION OF LAW NO. 2.....9

(A) THE CONTENTIONS OF APPELLANT CONCERNING
THE DEFINITION OF “COUNTERFEIT MARK”
AND HOW THE ELEMENT OF “SPURIOUSNESS”
RELATES TO IT.....9

(B) THE CONTENTIONS OF APPELLANT CONCERNING
WHETHER THE PROSECUTION IS REQUIRED TO
INTRODUCE INTO EVIDENCE CERTIFIED COPIES
OF THE TRADEMARKS AT ISSUE TO ESTABLISH
THAT THEY ARE REGISTERED ON THE PRINCIPAL
REGISTER IN THE UNITED STATES PATENT AND
TRADEMARK OFFICE, AND WHETHER THE
ELEVENTH DISTRICT COURT OF APPEALS
IMPOSED SUCH A REQUIREMENT.....12

(C) THE CONTENTIONS OF APPELLANT CONCERNING
THE DIFFERENT METHODS OF PROOF THAT MAY BE
EMPLOYED IN A TRADEMARK COUNTERFEITING
PROSECUTION IN ORDER TO SATISFY THE
DEFINITION OF "COUNTERFEIT MARK"16

(D) THE CONTENTIONS OF APPELLANT CONCERNING
THE EFFECT OF FEDERAL CASE LAW ON THE
OPINION OF THE ELEVENTH DISTRICT COURT OF APPEALS.....22

(3) CONCLUSION.....27

TABLE OF AUTHORITIES

| | <u>Page</u> |
|---|-------------|
| <u>CASES:</u> | |
| <i>Lockhart v. Nelson</i> (1988), 488 U.S. 33, 109 S.Ct. 285..... | 6 |
| <i>United States v. DeFreitas</i> (2000), 92 F.Supp.2d 272..... | 18, 25, 26 |
| <i>United States v. Guerra</i> (2002), 293 F.3d 1279..... | 18, 23, 24 |
| <i>United States v. Park</i> (2006), 164 Fed. Appx. 584..... | 24 |
| <i>United States v. Xu</i> , No. H-07-362, slip op. (S.D. Tex. Dec. 4,2008) | 27 |
| <u>STATUTES:</u> | |
| 18 U.S.C. 2320..... | 25, 26 |
| R.C. 2913.34..... | 2, 4, 5,12 |
| R.C.2913.34(F)..... | 8 |
| R.C. 2913.34(F)(1)(a)(i)..... | 2, 4,14 |
| <u>RULES OF EVIDENCE</u> | |
| Evid.R. 702..... | 20 |
| Evid.R. 704..... | 4 |

APPELLEE'S ANSWERS TO APPELLANT'S CONTENTIONS

(1)

APPELLEE'S ANSWERS TO THE CONTENTIONS OF APPELLANT RAISED IN PROPOSITION OF LAW NO.1 CONCERNING REVERSALS OF CONVICTIONS BASED UPON INSUFFICIENT EVIDENCE VERSUS CONVICTIONS BASED UPON PROCEDURAL DEFICIENCIES, THE DISTINCTIONS BETWEEN THE TWO TYPES OF REVERSALS AND THE LAW CONCERNING OF RETRIALS IN SUCH CASES.

In section I A. of its merit brief the appellant, State of Ohio ("the State") sets forth the substantive law concerning the distinction between (1) criminal convictions that are reversed based upon insufficient evidence (which are not re-triable) versus (2) those convictions that are reversed based upon a "procedural deficiency," such as the improper admission of evidence (which are re-triable if the evidence, taken as a whole (including the improperly admitted evidence) is legally sufficient to sustain a conviction. The appellee, Juanita Troisi ("Troisi") has no objection or disagreement with the manner in which that body of law has been characterized by the State. However, Troisi does disagree with the manner in which the State submits that that body of law applies to the case at bar, and disagrees with the State's interpretation of the substance of the decision of the Eleventh District Court of Appeals below.

In section I B. of its merit brief the State asserts that "the Eleventh District Court of Appeals failed to act in accordance with the distinction between insufficient evidence and procedural deficiency . . . [and] reversed the defendant's conviction based on what it termed 'sufficiency' when the real issue was the improper admission of evidence." The State's entire

argument in support of this assertion is its contention that the dissenting judge in the court of appeals was correct in his opinion that “the state’s evidence in this case, an expert opinion regarding the identity of the actual trademarks¹ combined with the defendant’s confession, was sufficient” to sustain the State’s burden of proving that the allegedly offending marks were “identical with or substantially indistinguishable from a mark that is registered on the principal register in the United States patent and trademark office,” which is an element of the offense imposed by subsection (F)(1)(a)(i) of the trademark counterfeiting statute, R.C. 2913.34. However, if one carefully reads the pertinent language of the court of appeals, then the inescapable conclusion is that, based upon the kind of evidence that was adduced in the trial

¹ It is not clear what the dissent means by the term “actual trademarks.” That being said, given the very precisely defined terms of art in the trademark counterfeiting statute, the ambiguity of this term, used in this manner, makes it very dangerous.

It should be noted that the statute contains no prohibitions whatsoever concerning “actual trademarks.” Furthermore, it should be clear that no conviction may be lawfully obtained under the section pursuant to which Troisi was convicted herein, for acts of copying and/or otherwise exploiting an “actual trademark” of a manufacturer, if it is not contemporaneously proven that the “actual trademark” is one that “is registered on the principle register in the United States patent and trademark office.” Indeed, the main problem with the conviction that was obtained below is that there was insufficient evidence to prove this “registration” element.

On this note, consider that the court of appeals’s majority also used the term “actual trademark,” but it used it in the phrase “actual trademarks registered in the principle register of the United States patent and trademark office.” There is no ambiguity here, as the precise language of the actual element of the offense is included.

below, it was impossible to establish this element of the offense:

With the statutory definition in mind, the state was required to prove appellant: (1) Knowingly; (2) sold, offered for sale, or otherwise disposed of goods in her possession; (3) knowing that a spurious trademark was affixed to or otherwise used in connection with the goods; and (4) the spurious trademark: (a) is identical with or substantially indistinguishable from a mark that is registered on the principal register in the United States patent and trademark office for the particular purse, jewelry or item, and (b) is likely to cause confusion or mistake or to deceive other persons.

. . . appellant's challenge is directed at the manner in which the state attempted to prove element (4)(a). Appellant alleges that the testimony of Tim Richissin, the state's intellectual property counterfeiting expert, by itself, was inadequate to prove the subject goods bore a "spurious" or "counterfeit" mark as defined by statute. We agree with appellant's argument.

* * * * *

Over defense objection, Mr. Richissin defined "trademark counterfeiting" as "[c]opying the registered trademark of a property owner." He further testified, again over objection, he is "one of the more knowledgeable people in Northeast Ohio about trademark counterfeiting." According to Mr. Richissin, he is able to personally distinguish counterfeit goods from authentic goods due to his training and experience in this area.

During direct examination, Mr. Richissin was provided certain examples of goods seized from appellant and asked to identify whether the items were, in his estimation, counterfeit . . . Mr. Richissin concluded each, over strenuous objections by defense counsel, were knock-offs and therefore counterfeit. At the conclusion of direct examination, Mr. Richissin testified, again over objection, that the trademarks on the merchandise he inspected were "identical or substantially indistinguishable from the genuine trademark."

During the defense's case-in-chief, defense counsel called Mr. Richissin as a witness. During defense counsel's direct examination of Mr. Richissin, the witness testified he had never obtained a record from the United States patent and trademark office. He further testified he had never personally viewed the trademarks from the principal register of any items he testified were counterfeit. After the conclusion of Mr. Richissin's testimony, defense counsel rested.

The state neither submitted certified copies of the authentic trademarks of the companies whose marks were at issue nor any other evidence of the actual trademarks registered in the principal register of the United States patent and trademark office. In essence, aside from Mr. Richissin's assurances that the goods were counterfeit (as defined by Richissin himself) the record is devoid of *any evidence* from which the jury could conclude that the items seized bore a trademark "identical with or substantially indistinguishable from a mark that is registered on the principal register in the United States patent and trademark office . . ." as required by R.C. 2913.34(F)(1)(a)(i). R.C. 2913.34 specifically requires the state to prove, beyond a reasonable doubt, that a "counterfeit mark" was attached or affixed to the goods in question. The definition of "counterfeit mark" is precisely defined in the statute and requires proof that the mark be "identical with or substantially indistinguishable from" the marks registered with the United States patent and trademark office. Without evidence that the goods bore a counterfeit mark as defined in the law, there can be no violation of the trademark counterfeiting statute.

Although Mr. Richissin testified the items he inspected, each of which were affixed with a recognizable trademark emblem of some kind, were inauthentic based upon multiple factors, it is merely from these observations that he was able to conclude the items represented instances of 'trademark counterfeiting.' Given the statute, the supportive testimony for his conclusions is basically insufficient to meet the statutory definition of the crime of trademark counterfeiting set forth under R.C. 2913.34.

In particular, Mr. Richissin's definition of "trademark counterfeiting" (i.e., 'copying the registered trademark of a property owner') is overly broad and does not embrace the precise legal definition of "trademark counterfeiting." Moreover, it appears the state, perhaps inadvertently, blurred the foregoing distinction by repeatedly asking Mr. Richissin, in light of *his* conception of trademark counterfeiting, whether a given item is 'authentic or counterfeit.' Such questions illustrate that the state was attempting to meet its burden by using an informal or colloquial understanding of 'trademark counterfeiting' as opposed to the specific statutory definition.

We recognize that Evid.R. 704 permits an expert to provide testimony by way of opinion or inference that embraces the ultimate issue for the jury. However, simply because Mr. Richissin could so testify does not imply his testimony, by itself, was adequate to meet the state's burden. To the contrary, Mr. Richissin's testimony was premised upon an essentially subjective or, at best, non-legal definition of the phrase "trademark counterfeiting." We acknowledge that

Mr. Richissin did, on direct examination, draw the blank conclusion that the items he inspected were "either identical or substantially indistinguishable from the genuine trademark." However, Mr. Richissin later testified he had never seen the genuine trademarks as they appear on the principal register in the United States patent and trademark office. Because he had never viewed the genuine trademarks and the state failed to submit some evidence of the same, Mr. Richissin's initial conclusion completely lacks evidentiary support.

Because there was no evidence presented that would allow the jury to conclude the goods bore a counterfeit mark that was identical with or substantially indistinguishable from a registered trademark, the jury was allowed to render a verdict based only upon Mr. Richissin's non-legal conception of this ultimate issue. Irrespective of the propriety of the jury instructions, the jury heard no evidence regarding the first prong of the definition of a "counterfeit mark." Hence, under these circumstances, Mr. Richissin's testimony was both misleading and legally insufficient to prove the ultimate issue which his testimony embraced.

Our review of the body of Ohio law in this area reveals that no court has addressed the basic elements of the crime of "trademark counterfeiting." Accordingly, our construction and analysis of this issue is a matter of first impression. In our view, the statutory elements of the crime of "trademark counterfeiting" are unambiguously set forth under R.C. 2913.34. The statute requires the state to prove the trademark affixed to the purported knock-off merchandise is identical with or substantially indistinguishable from that which is properly registered with the United States trademark and patent office. This is a specific, express element of the crime for which appellant was prosecuted. However, as outlined above, the state failed to offer any substantive evidence to prove this element of the crime. We therefore hold this "gap" in the evidentiary chain necessitates a reversal of appellant's conviction for "trademark counterfeiting."

Therefore, based upon this very precise and methodical analysis by the court of appeals, it is clear that the court did not vacate the conviction as a result of a "procedural deficiency." Instead, the conviction was vacated because the prosecution presented evidence that was legally insufficient to support all of the essential elements of the crime charged. This is simply an

example of a case that was inadequately presented from an evidentiary standpoint, by the prosecution.

Based upon the state of the evidence that was adduced at trial, as methodically outlined by the court of appeals, all of the evidence concerning the essential element of “identical with or substantially indistinguishable from a mark that is registered on the principal register in the United States patent and trademark office” was considered. However, even considering all of this evidence, it was *impossible* for the jury to conclude (from the standpoint of legal sufficiency and based upon the statutory definition of “counterfeit mark”) that the allegedly offending marks were “identical with or substantially indistinguishable from a mark that is registered on the principal register in the United States patent and trademark office.” This is because the jury was given no evidence of what such a registered mark looked like – by his own admission the expert witness had never personally viewed such a registered mark – and the record does not contain any other evidence whatsoever to establish what such a registered mark looks like. Because of this very obvious reality, the jury did not have before it a depiction of a registered trademark from which it (as the fact-finder) could lawfully conclude that the allegedly offending marks were “counterfeit marks” according to the definition set forth in the statute. Therefore, the reversal was indeed based upon the insufficiency of the evidence as a whole, and the retrial doctrine of Lockhart v. Nelson (1988), 488 U.S. 33 does not permit a retrial.

As previously pointed out, it is the State’s contention that the reversal by the court of appeals herein was based upon a “procedural deficiency,” as opposed to “insufficient evidence, and that the State should therefore be able to retry Troisi; and the State’s entire argument in

support of this position is the opinion of the dissenting judge that “the state’s evidence in this case, an expert opinion regarding the identity of the actual trademarks combined with the defendant’s confession, was sufficient” to support the conviction. In this regard it should be noted that the “defendant’s confession” that is referred to was elicited through the trial testimony of Sgt. Tavano. Sgt. Tavano testified that after he arrested Troisi he read her Miranda rights to her and then questioned her. Troisi told Sgt. Tavano (and reduced to a signed writing) the following: (1) that she was selling the “copy bags,” (2) that it was an “error to sell them,” and (3) that she never told anyone that they were “authentic.” Sgt. Tavano testified that he directly asked Troisi: “Do you know the merchandise you were selling and brought to 10350 Chillicothe Road was counterfeit designer merchandise?” Troisi replied: “Yes, I knew that the purses and wallets were not authentic.” This is the extent of her “confession.” (Tr. 103-111.)

It is submitted that a defendant’s statement (or opinion, belief or “confession”) concerning whether certain merchandise is “counterfeit” is not dispositive of the “counterfeit mark” analysis that is called for by the statute herein. It is further submitted that any such statement of a defendant is virtually, if not completely, immaterial to the statutory inquiry. Like Richissin, a defendant who is selling “copy bags” may have a definition of “counterfeit” in mind that is significantly different from the statutory definition of “counterfeit mark.” Furthermore, even if a defendant specifically stated that he/she was aware of the statutory definition and that his/her opinion was based upon that definition, the opinion would still not be dispositive. Twelve jurors might well have a different opinion when called upon to compare the allegedly offending mark with “a mark that is registered on the principal register in the United States patent and

trademark office.” The jury might conclude that the marks bear a resemblance to one another, but that are not “identical with or substantially indistinguishable from” one another. Or, the jury might conclude that it is not the case that the use of the mark “is likely to cause confusion or mistake or to deceive other persons.”² Pursuant to the language of R.C. 2913.34(F), the proof of both of these things is necessary in order to sustain a conviction. This is why it is *necessary* for

² An example of how/why this might happen is illustrated in the direct examination of Richissin. He was questioned concerning the “counterfeit” Louis Vuitton bag that he bought from Troisi in his undercover capacity. He characterized the bag as a “not very good knock-off.” He testified that the “LV” on the bag is the trademark (but there is no evidence that this “LV” is “registered on the principal register in the United States patent and trademark office”). But he testified that “the LV’s are in the wrong position on the bag, which is a red flag for us to look at . . . These LV’s should be in a crossing pattern and should be very symmetrical, and they’re not. They’re out of position. You know, when we look at a bag like this, on a one-to-ten scale, this would be a two or a three.” (Tr. 200-201.) In other words, it is clear that, according to Richissin, a fair conclusion would be that the mark that was used on the purchased Louis Vuitton bag was *not* “identical with or substantially indistinguishable from” a federally registered Louis Vuitton trademark, as required for a conviction under the statute. Furthermore, because of this “two or a three on a scale of one-to-ten” opinion, it is fair to say that a jury might also conclude that the use of the mark on the purchased bag was *not* “likely to cause confusion or mistake or to deceive other persons.” However, all of this was lost on the jury, as it was never given the required standard with which to draw a comparison, nor the registered mark with which to make the comparison. Instead, they were given the conclusion of an “expert,” with its attendant air of lawful authority, that the bags were “counterfeit.” Of course, as pointed out by the court of appeals, he was using his own definition of “counterfeit,” rather than the definition set forth in the statute.

the jury to compare two marks, one against the other.

Therefore, for all of the reasons set forth above, the vacatur of Troisi's conviction was based upon insufficient evidence and retrial is barred.

(2)

**APPELLEE'S ANSWERS TO THE CONTENTIONS
OF APPELLANT RAISED IN PROPOSITION OF LAW NO. 2**

(A)

**THE CONTENTIONS OF APPELLANT CONCERNING THE DEFINITION OF
"COUNTERFEIT MARK" AND HOW THE ELEMENT
OF "SPURIOUSNESS" RELATES TO IT.**

In section II A. of its merit brief the State argues as follows:

The [court of appeals] read the definition of counterfeit mark very narrowly to focus only on the first condition – that the mark be identical [with] or substantially indistinguishable from one on the principal registry. But in so doing, the Court of Appeals lost sight of the "spurious" aspect of the definition . . . the definition of counterfeit mark must be read in a broader context to take the spurious nature of the mark into consideration . . . contrary to the assertions of the [court of appeals] a simple comparison of a mark on a good such as a handbag and a certified copy of a mark from the principal registry will not allow the jury to make a determination as to the authenticity of the mark . . . By their very definition, the counterfeit marks would be nearly identical to actual marks, and without further information [i.e., the expert testimony], the jury would be unable to make a determination as to the spurious nature of a mark as required by the definition of counterfeit mark.

The State seems to be arguing that the expert testimony was useful in proving that the marks that were attached to the bags that were being sold by Troisi were in fact "spurious." Troisi does not disagree with this proposition. Indeed, "spuriousness" is a sub-element of the definition of "counterfeit mark." That being said, it is a fact that the spurious nature of the marks was never

at issue and was adequately established. "Spuriousness" was clearly established by Richissin. Richissin testified that when he purchased one of the "counterfeit" bags (in his undercover capacity) Troisi plainly indicated to him that the bag was not "real." Furthermore, in her "confession" to the police at the scene of the raid Troisi admitted that the merchandise was "not authentic." Therefore, "spuriousness" was established. However, at trial Richissin's testimony was not used in the limited manner. To the contrary, it was used in a much different and broader way, and ultimately misapplied to satisfy all three elements of the "counterfeit mark" definition.

At trial Richissin's testimony was used to usurp the fact-finding function of the jury, by substituting his opinion as to what is or is not "authentic," "counterfeit" or "genuine" (and in so doing, confusing the issue) for the jury's right and duty under the statute to draw its own conclusion by making a comparison between the allegedly offending mark and the properly registered mark, in order to determine whether each particular allegedly offending mark was "identical with or substantially indistinguishable from" a corresponding mark that was "registered on the principal register in the United States patent and trademark office."

An example of how Richissin's testimony might have been useful in establishing the element of "spuriousness," but was instead used to usurp the fact-finding function of the jury is illustrated in Richissin's testimony concerning the Tiffany jewelry:

The Tiffany jewelry – all of the Tiffany jewelry – has distinctive marks on the jewelry that would immediately tell us that it's counterfeit . . . The most distinctive feature on the jewelry is the numbers 925. 925 is a hallmark symbol for Tiffany jewelry, especially in the heart and the pendant and the – what some people call the dog tag type of jewelry for Tiffany. That 925 is never found on the front of the jewelry; it's always found stamped on the rear of the jewelry, and on these tags it's stamped on the front of the jewelry. The jewelry itself is sort of a plastic-y type of

metal, as opposed to genuine silver, and it's just – the font is different on it than the genuine Tiffany font. The spacing is wrong on the lettering to accommodate that 925 numbering that they put on the front that shouldn't be on there. So, basically, the whole piece is wrong . . . the Tiffany & Company logo is also incorrect . . . [i]t should be on a long or like an oblong type of piece on the inside.

..

This testimony would be sufficient to establish that the "925" mark in question was "spurious" (setting aside for a moment the effect of his conclusion/opinion that the jewelry is "counterfeit"). However, the next two questions that are presented in the statutory "counterfeit mark" inquiry are (1) whether the "925" mark that was used on this particular piece of jewelry was "identical with or substantially indistinguishable from a mark that is registered on the principal register in the United States patent and trademark office," and (2) whether the use of the mark on this particular piece of jewelry "is likely to cause confusion or mistake or to deceive other persons." These two questions are obviously ideally suited to resolution by ordinary people without special skills, such as jurors, and certainly do not require the assistance of expert testimony. However, not only was the jury not given the data/evidence with which to make the required comparison, but they were instead told by an "expert" that the jewelry is "counterfeit." This is precisely why the court of appeals accurately pointed out that "Mr. Richissin's testimony was both misleading and legally insufficient to prove the ultimate issue which his testimony embraced" and resulted in the State "attempting to meet its burden by using an informal or colloquial understanding of "trademark counterfeiting" as opposed to the specific statutory definition."

(B)

**THE CONTENTIONS OF APPELLANT CONCERNING
WHETHER THE PROSECUTION IS REQUIRED TO INTRODUCE INTO EVIDENCE
CERTIFIED COPIES OF THE TRADEMARKS AT ISSUE TO ESTABLISH
THAT THEY ARE REGISTERED ON THE PRINCIPAL REGISTER IN THE
UNITED STATES PATENT AND TRADEMARK OFFICE,
AND WHETHER THE ELEVENTH DISTRICT COURT OF APPEALS
IMPOSED SUCH A REQUIREMENT.**

In section II B. of its merit brief the State argues that the court of appeals "dictated a requirement for the State to introduce certified copies of the marks from the principal registry." The State suggests that the "narrow reading of the definition of counterfeit mark" by the court of appeals "hinders the State's ability to prosecute R.C. 2913.34 cases," because this "narrow reading" does not permit them to make their case using expert testimony.

Firstly, it is a misconception of the opinion of the court of appeals to conclude that it "dictated a requirement for the State to introduce certified copies of the marks from the principal registry" in order to properly or successfully prosecute a trademark counterfeiting case such as the one at bar. Nowhere in the opinion did the court of appeals articulate such a requirement.

The court of appeals pointed out that the definition of "counterfeit mark" is "precisely defined in the statute," and specifically pointed out the identical-with-or-substantially-indistinguishable-from prong of the definition. The court also observed that "the state neither submitted certified copies of the authentic trademarks of the companies whose marks were at issue nor any other evidence of the actual trademarks registered in the principal register of the United States patent and trademark office." The court further observed that the expert's definition of "trademark counterfeiting" was "overly broad" and "significantly" different from "the precise

legal definition" dictated by the statute.³ The court further observed that, by electing to prosecute the case in the fashion that it did, "the state was attempting to meet its burden by using informal or colloquial understanding of "trademark counterfeiting" as opposed to the specific statutory definition." Based upon these facts and observations, the court of appeals reasoned and held as follows:

Because there was no evidence presented that would allow the jury to conclude the goods bore a counterfeit mark that was identical with or substantially indistinguishable from a registered trademark, the jury was allowed to render a verdict based only upon Mr. Richissin's non-legal conception of this ultimate issue. Irrespective of the propriety of the jury instructions, the jury heard no evidence regarding the first prong of the definition of a "counterfeit mark." Hence, under these circumstances, Mr. Richissin's testimony was both misleading and legally insufficient to prove the ultimate issue which his testimony embraced.

* * * * *

The statute requires the state to prove the trademarks affixed to the purported

³ On direct examination the following exchange took place:

Q: What is trademark counterfeiting?

MR. VITANTONIO: Objection.

JUDGE LUCCI: Overruled.

A: Copying the registered trademark of a property owner.

(See, page 188 of the trial court transcript).

The court of appeals rightly observed that: "Although this definition may be sufficient in Mr. Richissin's business of intellectual property crime investigation, the statutory definition differs significantly from this open-ended conception." (See pages 10-11 of the opinion of the court of appeals).

knock-off merchandise is identical with or substantially indistinguishable from that which is properly registered with the United States patent and trademark office. This is a specific, express element of the crime for which appellant was prosecuted. However, as outlined above, the state failed to offer any substantive evidence to prove this element of the crime. We therefore hold [that] this "gap" in the evidentiary chain necessitates a reversal of appellant's conviction for "trademark counterfeiting."

* * * * *

Because the state introduced no evidence of the marks as they appear on the principal registry, the jury was unable to measure Mr. Richissin's testimony against the proper statutory definition set forth under R.C.2913.34(F)(1)(a)(i). By allowing him to draw his conclusion without introducing evidence of the marks as they exist on the principal registry, the issue of whether the marks were counterfeit was taken from the jury. Therefore, Mr. Richissin's testimony, which carried with it the air of authority beyond that of general lay testimony, acted to usurp the jury's role.

Therefore, the court of appeals did not dictate a requirement for the State to introduce certified copies of the marks from the principal registry. The court merely (and accurately) pointed out that in the trial of the case below there was no "evidence of the marks as they exist on the principal registry." Therefore, the reasoning is, the fact-finder did not have sufficient evidence from which to make a required comparison in order to address the identical-with-or-substantially-indistinguishable-from prong of the definition – that is, there was insufficient evidence in the trial court record to allow the jury to make the statutorily required comparison/finding that the allegedly offending mark was "identical with or substantially indistinguishable from a mark that is registered on the principal register of the United States patent and trademark office," which is an essential element of the crime of trademark counterfeiting. Thus, instead of the jury being able to draw this conclusion by sifting the actual evidence admitted at trial through the statutory definition, the jury in this case was basically

dictated to: either accept the opinion of the "expert" that the goods are "counterfeit," or not.

There was no reason for the jury not to accept it, as it was un-rebutted and, as the court of appeals observed, it "carried with it an air of authority beyond that of general lay testimony" and therefore "acted to usurp the jury's role." Because of this the jury was not able to realize that its duty to apply the statutory definition of "counterfeit mark" was being side-stepped. The court of appeals clearly and thoroughly explained this rationale in its opinion. This being said, as opposed to dictating a "certified copy" evidentiary requirement, it is fair to say that the court of appeals pointed out the lack of production of "certified copies of the authentic trademarks" in this case because this would appear to be the simplest and most straight-forward way of furnishing the jury with the data/evidence that would allow *the jury* to make the required comparison between the allegedly offending mark and the (properly registered) mark in question.

The "certified copy" method was simply *not* dictated or imposed by the court of appeals as a requirement for future prosecutions. However, based upon all of the foregoing, it is respectfully submitted that the reasonable litigant/advocate must admit that the easiest, most effective and most sensible way to set the stage for the comparison that is called for by the trademark counterfeiting statute is to simply introduce into evidence a certified copy of a document from the United States patent and trademark office that depicts the registered mark in question so that it can be laid side-by-side with the allegedly offending mark and the comparison thereby made by the fact-finder.

(C)

**THE CONTENTIONS OF APPELLANT CONCERNING
THE DIFFERENT METHODS OF PROOF THAT MAY BE
EMPLOYED IN A TRADEMARK COUNTERFEITING PROSECUTION
IN ORDER TO SATISFY THE DEFINITION OF "COUNTERFEIT MARK."**

In section II B. of its merit brief the State next proceeds to identify "four methods available to the State to prove that the marks were counterfeit," and proceeds to apparently analyze the relative merits and/or shortcomings of each.

The first method identified by the State concerns the introduction of "certified copies of the marks from the principal registry of the United States patent and trademark office." In connection with this the States submits that "[a] search of the federal registry may reveal hundreds, if not thousands, of individual marks for one trademark." It appears that the State is suggesting that the production of certified copies of marks from the appropriate federal registry in trademark counterfeiting prosecutions is a hardship and/or a difficult task, or that it represents a significant and/or an undue burden.

However, in the case at bar there was on the order of 1900 pieces of merchandise at issue and a total of approximately thirteen manufacturers whose marks were the subject of alleged trademark counterfeiting (i.e., Gucci, Prada, Coach, Dior, Fendi, Dooney & Bourke, Tiffany, Burberry, Liz Claiborne, Kate Spade, Chanel, Louis Vuitton and Versace). Furthermore, there were multiple copies of many of the goods/items, so that the same evidence could/would apply to discrete batches of merchandise. Notwithstanding those observations, it is submitted that in a criminal prosecution that is initiated by the State, wherein the accused's personal liberty is at

stake, it certainly is not unreasonable to require the prosecution to introduce a number of documents (or other forms of evidence) that is consistent with the nature and scope of the charges that it decided to level and that is required to satisfy each essential element of the offense.

Also, in further comment on this "certified copy" method of proof, the State submits that: "[a]dditionally, a certified copy of the mark may not provide the jury with the necessary information as to whether the mark is spurious." It is acknowledged that the "spurious" nature of the mark is a proof requirement that is imposed upon the State in trademark counterfeiting prosecutions by virtue of the statutory definition of "counterfeit mark." It is submitted that there are various effective ways to prove "spuriousness," including the testimony of an expert, statements/admissions of the defendant, the testimony of a manufacturer, etc. That being said, it is not clear what the proof requirement of "spuriousness" has to do with the utility (or not) of the "certified copy" method of satisfying the identical-with-or-substantially-indistinguishable-from prong of the definition of "counterfeit mark," unless it is simply being pointed out that the State would prefer a single method of proof that would allow it to satisfy both of these aspects of the definition of "counterfeit mark." Nevertheless, whatever the merits of this dual-purpose approach might be, it is clear that the expert testimony method that the State used in the trial of the case at bar did not serve both purposes. It at best was sufficient to prove that the marks were spurious. However, that matter was not at issue during the trial and is not now being contested.

The second method identified by the State concerns the introduction of "authentic pieces of merchandise for direct comparison by the jury." The State suggests that this might be a "viable

option" in some trademark counterfeiting cases, but that it would be "nearly impossible" in the case at bar, because (1) there were "over 1900 pieces of merchandise" herein and (2) some of the pieces "do not have a genuine counterpart to allow a direct comparison." The undersigned does not disagree with the potential viability of this option as a means of satisfying the State's burden of proof. However, it is not without its own unique limitations.

If the State introduces an "authentic piece of merchandise" for the purpose of proving that an allegedly offending piece is in violation of the statute, then it is asking the jury to compare the mark on the allegedly offending piece to the mark on the "authentic piece" for purposes of determining whether the former is "identical with or substantially indistinguishable from" the latter. However, if one is bound by the full statutory definition of "counterfeit mark," then before the mark from the "authentic piece" qualifies as an appropriate mark for comparison, it must first be shown that the said mark is "registered on the principal register in the United States patent and trademark office." The requirement for this showing cannot be escaped. Having come full circle then, it is again submitted that the simplest and most straight-forward means of accomplishing this required element of proof might be to simply introduce a certified copy of a document showing that the mark that appears on the "authentic piece" that is being shown to the jury is indeed "registered on the principal register in the United States patent and trademark office."⁴ If such a "registration" showing is not made then, as was stated by the court of appeals in the case

⁴ This is generally the method that was employed in United States v. Guerra (2002), 293 F.3d 1279; and in United States v. DeFreitas (2000), 92 F.Supp.2d 272. See discussion below.

at bar, there is a "gap" in the evidentiary chain, and any verdict obtained would be based upon insufficient evidence.

The third method identified by the State is the "expert witness" method that was employed by the State in the trial of the case at bar. The State claims that this was "the best method available" in the case at bar, and that "[t]he sheer volume of the evidence required the testimony of an expert." The State further argued that:

Selecting a sample of the counterfeit merchandise was not an option because the jury would lose sight of the magnitude of the crime. Expert testimony allowed the jury to fully appreciate the scope of the defendant's conduct without having to engage in a direct comparison of over 1900 pieces of merchandise. Plus, the expertise of the witness allowed the jury to draw its own conclusion as to the spurious nature of the goods.

However, for all of the reasons discussed above, and for all of those pointed out by the court of appeals, the expert testimony in the trial of the case at bar was both misleading and insufficient to satisfy the elements of the offense, thereby leaving a "gap" in the evidentiary chain, and it usurped the role of the jury. Also, as previously mentioned, even though there was a very large number of items, there were only about thirteen manufacturers and there were multiple copies of many of the goods/items, so that the same comparative evidence could have been applied to a manageable number of batches of merchandise. Finally, as previously mentioned, although this may well have been a useful method of establishing "spuriousness," it was not sufficient to satisfy the identical-with-or-substantially-indistinguishable-from prong of the element of "counterfeit mark."

Regarding the expert testimony in the trial of the case at bar and Troisi's assertion that it

usurped the role of the jury, the State argues that this is “an antiquated view of the rules of evidence,” and continues that:

The defendant’s assertion also overlooks the fact that an expert witness’s testimony is subject to cross examination and is weighed by the jury in making its decision. The purpose of an expert witness is to testify to matters beyond the knowledge or experience possessed by lay jurors. Evid. R. 702. Mr. Richissin’s testimony was based on specialized information, and he was qualified as an expert.

This argument completely misses the mark and illustrates that the State is not focusing on the essence of the opinion of the court of appeals. It is undeniable that the identical-with-or-substantially-indistinguishable-from element of the statute herein *requires* that the fact-finder engage in a comparison between the allegedly offending mark and a mark that is “registered on the principal register in the United States patent and trademark office.” It is also undeniable that such a comparison is ideally suited to resolution by ordinary people without special skills (and does not require special skills), such as jurors, and certainly does not require the assistance of an expert witness with special skills. It does not take specialized skills to, for example, look at the visual qualities of a “C” mark on a handbag that is alleged to run afoul of the “trademark counterfeiting” statute and compare it to the visual qualities of a “C” mark that is “registered on the principal register in the United States patent and trademark office,” and to thereby arrive at a conclusion concerning whether the former “C” mark is “identical with or substantially indistinguishable from” the latter, and whether the use of the allegedly offending mark “is likely to cause confusion or mistake or to deceive other persons.” As the court of appeals pointed out,

the expert testimony might have been useful, but for a purpose other than opining on the ultimate issue in the case, which because of its nature is to be decided by the factfinder, not an expert:

To explain, it is patent that Mr. Richissin's definition of "trademark counterfeiting" differed significantly from the statutory elements requiring proof of "trademark counterfeiting" under Ohio law. As these definitions differed, the testimony could have been properly introduced had the state laid a foundation to establish this distinction. Introducing this distinction to the jury may have benefitted the state because, in doing so, it may have triggered the introduction of evidence relating to the actual trademarks of the goods at issue as they appear in the principal registry of the United States patent and trademark office. In so doing, the jury would have had the opportunity to weigh Mr. Richissin's conclusions against the actual trademark emblems and determine, *for itself*, whether the marks were counterfeit pursuant to the statute. However, without laying this foundation, the jury was not only confused as to the proper standard, it was misled into believing Mr. Richissin's testimony sufficed to establish [that] the marks at issue were counterfeit. This ultimate conclusion was a factual issue to be determined by the jury based upon the evidence before it. As emphasized throughout our analysis, such defects in the state's strategy and proof are fatal and, as a result, the matter must be reversed. *[Emphasis Supplied.]*

The fourth and final method identified by the State asserts that "the State should be able to introduce evidence of a defendant's confession," indicating that the defendant "was aware that the merchandise was counterfeit and that she intended to sell it to the public." The State continues by observing that: "In fact, this was part of defendant's defense at trial: everyone knew the goods were fake. The nature of the goods was not a contested issue at trial."

Unfortunately, this is another illustration of the State's attempt to side-step the issue and not address head-on the essence of the opinion of the court of appeals and the kind of evidence that is relevant to and indeed necessary to carry out the "counterfeit mark" inquiry (as statutorily defined). Evidence that serves to establish "fake" would serve equally well to satisfy "spurious." However, it should be obvious that the conclusive nature of the goods as "fake" (or "spurious")

does not mean that they satisfy the definition of “counterfeit mark.” Indeed the statutory definition goes well beyond “fakeness” or “spuriousness.” Examples of merchandise that is “fake” but that does not satisfy the definition of “counterfeit mark” could easily be conceived of. It should also be obvious that a defendant’s opinion concerning whether certain merchandise is “counterfeit” (in a colloquial sense) is not only not dispositive of the “counterfeit mark” statutory inquiry, but is completely immaterial to that inquiry. As did Richissin, a defendant may have a definition of “counterfeit” in mind that is significantly different from the statutory definition of “counterfeit mark.” Furthermore, even if a defendant thought that he/she understood the statutory test, and drew a certain conclusion based upon that understanding, the consensus of twelve jurors applying the same statutory definition might well be different. Therefore, a confession, opinion or statement of a defendant concerning the “counterfeit” nature of the goods is of limited (or no) substantive value in the statutory “counterfeit mark” analysis.

(D)

**THE CONTENTIONS OF APPELLANT CONCERNING
THE EFFECT OF FEDERAL CASE LAW ON THE
OPINION OF THE ELEVENTH DISTRICT COURT OF APPEALS.**

In section II C. of its merit brief the State argues that federal case law interpreting the federal trademark counterfeiting statute “indicates that the Eleventh District Court of Appeals did not properly interpret the trademark counterfeiting statute.” It is agreed that it might be helpful to look to federal case law to look for guidance in connection with issues involving the identical-with-or-substantially-indistinguishable-from element of the Ohio statute, since the federal statute includes identical language. However, none of the federal cases cited by the State address a

scenario that is similar to the issue herein; to wit: the missing (and fatal) evidentiary link in the State's case below.

The first case cited by the State is United States v. Guerra (2002), 293 F.3d 1279. The State cites Guerra for the proposition that "the State may prove its case through nearly any available means, and the Eleventh District Court of Appeals should have accepted Mr. Richissin's testimony on this element."

However, it should be noted that in Guerra the court pointed out that in order to establish the identical-with-or-substantially-indistinguishable-from element under the federal statute, "the jury had been shown *registered* designs of the trademarks for each cigar, as well as various cigar labels or brands produced by authorized licensees. The jury therefore had a *valid basis for comparison* in determining whether the designs were 'identical or substantially identical.'" **[Emphasis Supplied.]** It is not at all clear how the Guerra case might help the State resolve any of the issues that were raised by the court of appeals herein concerning such matters as (1) Richissin's use of a definition of "counterfeit" that was different from the statutory definition, (2) the failure of the State to introduce any substantive evidence at the trial below to prove the element of identical-with-or-substantially-indistinguishable-from, or (3) Richissin's usurpation of the jury's role in connection with this element. As pointed out, Guerra tells us that the jury there was "shown registered designs of the trademarks" which gave them "a valid basis for comparison" in connection with the identical-with-or-substantially-indistinguishable-from element. In other words, **the jury** in Guerra was given the proper data/evidence to permit it to do a comparison and did indeed do a comparison! This is what is supposed to happen under the

Ohio statute, what did happen in Guerra, and what did not happen in the trial of the case below. It is not clear how this case supports the argument/position of the State herein.

The State then proceeds to introduce three other federal cases, indicating that they are all cases where the convictions “were affirmed [and] the government did not introduce certificates of registration to prove that the marks in question were identical or substantially indistinguishable from marks on the federal registry.” It is not clear whether the State is referencing these cases in support of its view that the Eleventh District Court of Appeals wrongfully “dictated a requirement for the State to introduce certified copies of the marks from the principal registry,” as asserted in section II B. of its merit brief; or in support of the proposition that valid convictions can be obtained in trademark counterfeiting cases without introducing certified copies of the federally registered mark. If it is for the former purpose, then as previously stated Troisi disagrees that the court of appeals dictated such a requirement. If it is for the latter purpose, then Troisi agrees with this proposition generally, but as will be pointed out below none of the three cases help support the proposition that the evidence that was presented against Troisi in the trial below was sufficient to support a finding that the identical-with-or-substantially-indistinguishable-from prong of the definition of “counterfeit mark” was satisfied. All of the cases are distinguishable in this respect, as they all indicate that there was indeed sufficient evidence in each to support the conviction.

The State cites United States v. Park (2006), 164 Fed. Appx. 584, where the defendant was convicted of selling counterfeit Louis Vuitton and Chanel merchandise. The State indicates that in the Park case the government introduced a complaint from a civil action that was filed in

connection with the sale of the counterfeit goods which indicated that the trademark holders had "registered" and used the marks in question. Also, the defendant's attorney in the civil case testified, as well as a special agent, that the goods in question contained marks that were identical to marks that were registered on the principal registry. Therefore, it sounds like there was sufficient evidence of federally registered marks in the Park case. This is different from the case at bar, where the court of appeals observed that, even though on direct examination Richissin drew "the blank conclusion that the items he inspected were 'either identical or substantially indistinguishable from the genuine trademark,'" he "later testified he had never seen the genuine trademarks as they appear on the principal register in the United States patent and trademark office. Because he had never viewed the genuine trademarks and the state failed to submit some evidence of the same, Mr. Richissin's initial conclusion completely lacks evidentiary support." It does not appear that the same evidentiary problem was present in Park. Also, the expert in Park was not operating under a definition of "counterfeit" that was different from the statutory definition, nor does it appear that the expert usurped the role of the jury. This case does not help resolve any of the issues in the within appeal.

The State next cites United States v. DeFreitas (2000), 92 F.Supp.2d, 272, which was a counterfeit Beanie Baby prosecution where the defendant was found guilty by a jury of conspiracy to knowingly traffic and attempt to traffic in counterfeit goods (18 U.S.C. 2320(a)) and of trafficking in counterfeit goods (18 U.S.C. 2320(a)). Following his conviction, the defendant moved for a judgment of acquittal and to set aside the guilty verdict. The federal district court overruled the motion, pointing out that the evidence that was introduced to the jury

“constitutes sufficient evidence to permit the jury to conclude that the Government has met its burden of proof that a ‘counterfeit mark’ was used under the meaning of [18 U.S.C.] 2320.” The court referenced the following evidence in support of this conclusion:

- (1) “actual samples of both the genuine and counterfeit Beanie Babies” were introduced into evidence, which “contained tags with various trademarks registered by Ty, Inc.,”
- (2) the CEO of Ty, Inc. testified concerning “various trademarks registered by Ty, Inc” and concerning “the validity of the marks on the genuine Beanie Babies;”
- (3) the jury had the opportunity “to compare the tags and the marks on the genuine and on the counterfeit Beanie Babies;”
- (4) each genuine Beanie Baby that was introduced into evidence “had a tag showing information about Ty, Inc.’s trademarks;” and
- (5) a 1998 Ty, Inc. catalogue was introduced into evidence, which stated as follows:

Ty and Beanie Babies are registered trademarks of Ty, Inc. @ 1998 Ty Inc. – Warning: All designs and catalog [sic] are registered with the U.S.A./UK Copyright Offices and U.S.A. Customs Restricted Branch. @ Ty, Inc. 1998. Ty, Inc. has taken and will continue to take vigorous legal action against those who have participated directly or indirectly in the copy, manufacture, sale, distribution or display of unauthorized product. Anyone having information concerning any unauthorized use of product is urged to contact the above company.

Obviously, in DeFreitas there was abundant evidence of a registered mark, and it is clear that the jury made an actual comparison of the relevant marks, which supported its conclusion

that the statutory "counterfeit mark" element was satisfied. It is not clear how this case would help resolve any of the issues in the within appeal.

The final federal case that is cited by the State is United States v. Xu, No. H-07-362, slip op. (S.D. Tex. Dec. 4, 2008), wherein the defendant was convicted for selling counterfeit prescription drugs. As pointed out by the State, a motion for an acquittal was denied because the trial court found that there was sufficient evidence for the case to go to the jury because there was sufficient evidence from which a reasonable inference could be drawn regarding the registration of the mark at issue, since an employee of the victim company testified that the symbol next to the product name was the registered mark. Therefore, the jury apparently had a registered mark with which to make a comparison. This is a much different scenario than that which is present in the case at bar. As pointed out by the court of appeals, Richissin "testified he had never seen the genuine trademarks as they appear on the principal register in the United States patent and trademark office. Because he had never viewed the genuine trademarks and the state failed to submit some evidence of the same, Mr. Richissin's initial conclusion completely lacks evidentiary support." Furthermore, Richissin was testifying from the perspective of his own colloquial understanding of the term "counterfeit," which was different from the statutory definition. Xu does not address any of these issues or in any way help to resolve them.

(3)

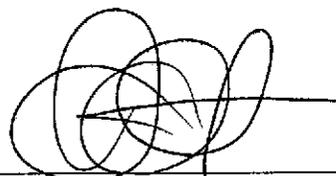
CONCLUSION

Whether they initially realized it or not, and regardless of how thoroughly it was considered, in the trial of the case below the State of Ohio simply embarked on an ill-conceived

trial strategy. Rather than present the jury with the allegedly offending marks (i.e., which were affixed to the allegedly offending pieces of merchandise that was being sold by the defendant) *and* the corresponding marks that are claimed to be the subject of trademark counterfeiting, *and* evidence that the latter mark is “registered on the principal register in the United States patent and trademark office,” so that the jury could discharge its duty and compare the marks and determine whether the former are “identical with or substantially indistinguishable from” the latter, and whether the use of the marks “is likely to cause confusion or mistake or to deceive other persons,” the State chose a very cumbersome, confusing and problematic route. The State chose to put an expert on the stand to testify concerning matters that do not require specialized knowledge and that are in fact ideally suited to consideration and resolution by lay persons, and to have that witness render opinions based upon a colloquial understanding of the critical concept of “counterfeiting,” as opposed to allowing a jury to apply the very specific statutory definition of the critical term of art “counterfeit mark.” This awkward trek only served to confuse the issues, ultimately permitting the expert to usurp the role of the jury, thereby leaving the jury with no meaningful role and no decision to make, except as to whether they should accept the conclusions of the expert concerning the propositions that the goods were “knock-offs,” “fake,” “not genuine,” “copies,” “not authentic,” etc. And the jury had no good reason not to accept these opinions of the expert, as they were delivered with an air of authority and were un-rebutted. Unfortunately, these opinions were also extremely misleading, as they prevented the jury from engaging in its primary and critical inquiry of fact: that is, arriving at a conclusion, based upon a comparison, and carefully guided by very specific statutory parameters. The jury was prevented

from performing this critical role. Fortunately, the court of appeals recognized this and remedied it. Finally, a careful reading of the decision of the court of appeals plainly illustrates that, considering all of the evidence, the state of the evidence was legally insufficient to sustain a jury's conclusion that the allegedly offending marks were "identical with or substantially indistinguishable from" the corresponding marks that were "registered on the principal register in the United States patent and trademark office," and that the use of the marks was "likely to cause confusion or mistake or to deceive other persons." Because of this, Troisi cannot be retried.

Respectfully submitted,^{*}



By:

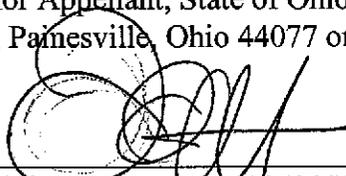
Dominic J. Vitantonio (0052058)
ARGIE, D'AMICO & VITANTONIO
6559 Wilson Mills Road
Mayfield Village, Ohio 44143

(440) 449-3333 (Phone)
(440) 449-4031 (Facsimile)

Attorney for Defendant-Appellee

PROOF OF SERVICE

A copy of the foregoing Merit Brief of Appellee Juanita M. Troisi was sent by regular U.S. Mail postage prepaid to Charles E. Coulson, Prosecuting Attorney, Lake County, Ohio and Teri R. Daniel, Assistant Prosecuting Attorney, Counsel for Appellant, State of Ohio, Administration Building, 105 Main Street, P.O. Box 490, Painesville, Ohio 44077 on this 30th day of June, 2009.



Dominic J. Vitantonio (0052058)
Attorney for Defendant-Appellee