UNITED STATES DISTRICT COURT
SOUTHERN DISTRICT OF NEW YORK

HERMÈS INTERNATIONAL and
HERMÈS OF PARIS, INC.,

Plaintiffs,

-against-

"MASON ROTHSCHILD" a/k/a SONNY ESTIVAL,

Defendant.

CIVIL ACTION NO.

22-CV-00384 (JSR)

PLAINTIFFS' MEMORANDUM OF LAW IN OPPOSITION TO DEFENDANT'S MOTION FOR RECONSIDERATION

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Plaintiffs Hermès International and Hermès of Paris, Inc. (collectively, "Hermès"), by and through its undersigned counsel, respectfully submits this memorandum of law, and the accompanying Declaration of Francesca A. Rogo, Esq. ("Rogo Decl."), in opposition to the Motion for Reconsideration (the "Motion") submitted by defendant Sonny Estival a/k/a Mason Rothschild a/k/a Mason Aston Rothschild a/k/a Mason Aston ("Estival")[1] concerning the Court's Opinion and Order dated March 13, 2024 (the "Order") denying Estival's Motion for Clarification of the Scope of the Order of Permanent Injunction (the "Injunction"). .

INTRODUCTION

Estival's Motion is yet another diversion, wasting the time and resources of the parties and the Court. The Order denying Estival's request for a "clarification" of the Permanent Injunction clearly states that, without more information concerning a proposed exhibition, the Court cannot grant Estival's request to authorize the display of the MetaBirkins at that exhibition. Rather than pointing to evidence or legal authority overlooked by the Court, Estival's Motion improperly proffers new evidence and new legal arguments. Estival submits a declaration from Mia Sundberg that directly contradicts her testimony at the evidentiary hearing. Estival, who raised the issue concerning the text accompanying the display of MetaBirkins at the exhibition, creates a strawman requirement—one never issued by the Court—and then challenges its sufficiency.

It must be noted that prior to Estival's original application, Hermès explained that it might have no issue with the proposed exhibition and tried to obtain relevant information. Rather than obtain that information, Estival chose to make the application. Hermès repeated its position in its papers and then again in correspondence with counsel prior to the evidentiary hearing.

[1] For ease of reference, Hermès adopts the same naming convention as the Court has done, using Defendant's birth name.

Neither Estival nor the Spirit Museum would provide that requested information. The Order denies Estival's request because of the wholesale lack of information. Sadly, rather than simply providing the required information, Estival filed the current Motion, wasting yet more time and money.[2] The Motion should be denied.

BACKGROUND

The Order explains that Court's central concern about the proposed Spirit Museum exhibition is ensuring that it complies with the Injunction's requirement that Estival refrain from conduct (and authorizing others' conduct) from creating consumer confusion. Estival refuses to provide such information. Even if this Motion complied with the rules governing motions for reconsideration (and it does not), the information that Estival has supplied is still insufficient to overturn the Order. l. In this regard, the circumstances surrounding Estival's Motion are informative.

On December 12, 2023, Estival filed a declaration averring that he could not satisfy the judgment and still owed substantial sums to his counsel. ECF No. 202 at ¶¶ 3-4. Putting aside whether that testimony is accurate—and there is reason to believe it is not (*see, e.g.,* Dkt Nos. 204-207)—Estival's counsel, Lex Lumina, confirmed that it was owed substantial sums by Estival. ECF No. 201 at 3. Yet 10 days later, Estival commenced yet more proceedings, culminating in the Order, and now, the Motion.

Estival originally approached Hermès at about 7:50 PM on Friday December 22, 2023, with minimal information, stating that if Hermès did not agree to Estival's authorization of the Spirit Museum's exhibition, they would need to make an application on December 26 or 27.

[2] In light of the submission of new evidence, new arguments, and futility of the Motion, Hermès originally decided to move for fees under 28 U.S.C. § 1927. *See* April 8, 2024 Minute Entry. Though Hermès's position has not changed, Hermès intends to make a larger fee application under the Lanham Act for fees in connection with the action. *See* February 24, 2023 Minute Order. As such, to avoid duplication, Hermès does not make a separate application here.

Rogo Decl., Ex. 1. Estival provided no details concerning the exhibition or how it would comply with the Injunction. As such, On December 25, 2023, Hermès responded with the following:

> Can you please provide us with any contracts, communications, and/or materials that detail the plans, people and/or entities that are or have been involved, and any other pertinent information about the planned exhibit.
>
> Once we have the information, we will discuss with the client and advise of whether we agree with your analysis.

Id.

After Estival responded without the requested information, Hermès tried to explain the issues further in a detailed email on December 26, 2023. *Id.* That correspondence noted that Hermès may not take any issue with an exhibit, and that (as Estival counsel repeatedly noted) there are plenty of art projects about Hermès—even some critical of Hermès—where there is no risk of consumer confusion and Hermès has not acted. Hermès also asked whether this was urgent. *Id.* Estival's expert, Dr. Blake Gopnik, has been planning this exhibition since the summer of 2022, and the exhibition still is not listed on the Spirit Museum's website.

After about three weeks, Estival again responded, providing sparse information with the ultimatum that if Hermès disagreed, Estival would need Court intervention. *Id.* Hermès raised Estival's alleged impecuniousness and asked again why this issue required immediate resolution. *Id.*. Estival's counsel repeated its stance and insistence on imminent resolution. *Id.*, Ex. 2. As of the Motion, Estival has failed to identify the urgency, and the exhibition still is not mentioned (let alone scheduled) on the Spirit Museum's website. *See, e.g.*, Exhibitions, THE SPIRIT MUSEUM, https://spritmuseum.se/utstallningar/ (last visited April 10, 2024).

As he has done throughout, Estival responded with an application deriding Hermès and its counsel, concluding that clarifying the Injunction "will avoid further groundless threats from Hermès—against both Mr. Rothschild and third parties not subject to the Order—as well as the

possibility of needless and wasteful collateral litigation." ECF No. 213 at 5. This was repeated in Estival's reply papers, where he concludes:

> Given Hermès' threats of further litigation over this issue, however, Mr. Rothschild seeks confirmation from the Court that he would not be in violation of the Order by giving such permission. The Court should answer this straightforward question to put this matter to rest and avoid wasteful and harassing collateral litigation efforts threatened by Hermès.

ECF No. 219 at 3.

But as the Court can see from the correspondence included here, Hermès only tried to cooperate and avoid disputes. Indeed, on February 8, 2024, as the parties were set to call the Court to schedule the hearing, Hermès again sought to reach an accord. Rogo Decl., Ex. 3. Similar requests were made on February 14 and February 16. *Id.* Even though it was clear that the Court likely ordered the evidentiary hearing to obtain at least some of the same information Hermès sought, Estival continued to respond that no further information existed. On February 13, 2024, Hermès reached out to the Spirit Museum to ask similar questions. *Id.*, Ex. 4. No response was ever provided, though Ms. Sundberg acknowledged receiving that correspondence. Transcript of February 20, 2024 Evidentiary Hearing ("Hearing Tr.") at 14.

Estival and his counsel have stated that he is of limited means and has no financial interest in the exhibition. The Spirit Museum still has not advertised the exhibition and did not make any applications here. Under these circumstances, and with Hermès trying to reach a resolution throughout, the obvious question is: why did Estival choose to make the original application? Likewise, why further drive up costs with the Motion rather than simply provide the information necessary? The irresistible inference is that Estival had a motive which was less than

straight forward.[3] Once the evidentiary hearing concluded, Estival's counsel commented that they intended to use the transcript to supplement their appeal. Rogo Decl. ¶ 1. Upon being confronted by Hermès's counsel about whether this was the motive for the application, Estival's counsel said it was not. *Id.* Yet a mere two days later Estival's counsel wrote that Estival "intends to file a motion with the Second Circuit to request that the Court make the transcript from Tuesday's hearing (attached) part of the record on appeal, as the questioning of Dr. Gopnik and Ms. Sundberg by the court is highly relevant to the parties' legal arguments on the merits." *Id.*, Ex. 5. On March 7, 2024, Estival filed a motion to supplement, with a supporting declaration from Mr. Millsaps. *Id.*, Ex. 6. That declaration takes a great deal of issue with the Court's evidentiary hearing—well after a Jury found that Estival intentionally misled consumers—and argues that the Court's questioning is relevant to the proceedings through trial (and provides a less than thorough and accurate description of attempts to "avoid a dispute.") *Id.*

Estival's Motion, even if successful, would not alter the Order to allow the Spirit Museum to show the exhibition. Estival clearly is in touch with Dr. Gopnik and the Spirit Museum. In the 15 weeks since Estival first contacted Hermès, he has filed three briefs and five declarations, the last brief and declaration as part of this Motion. Estival should have just provided the salient information.

ARGUMENT

I. STANDARD

"A motion for reconsideration is governed by Local Civil Rule 6.3." *Kamdem-Ouaffo v. Balchem Corp.*, No. 17-CV-02810 (PMH), 2023 WL 2266536, at *2 (S.D.N.Y. Feb. 28, 2023); *see also Senisi v. John Wiley & Sons, Inc.*, No. 13-CV-03314, 2016 WL 1045560, at *1

[3] Estival's suggestion that this is a lofty First Amendment endeavor to have a "discussion" about the MetaBirkins and the verdict, rings hollow when he complains that the Jury Verdict that he intentionally misled the public be ignored.

(S.D.N.Y. Mar. 15, 2016). "A motion for reconsideration will generally be denied unless the moving party can point to controlling decisions or data that the court overlooked matters ... that might reasonably be expected to alter the conclusion reached by the court." *Mr. Water Heater Enters., Inc. v. 1-800-Hot Water Heater, LLC*, No. 08-CV-10959 (WHP), 2010 WL 286683, at *1 (S.D.N.Y. Jan. 20, 2010). "Importantly, a reconsideration motion is not a vehicle (i) to 'introduce additional facts not in the record on the original motion'; (ii) to 'advance[ ] new arguments or issues that could have been raised on the original motion'; or (iii) to 'relitigate an issue already decided.'" *Huzhou Chuangtai Rongyuan Inv. Mgmt. P'ship v. Qin*, No. 21-CV-9221 (KPF), 2024 WL 262741, at *1 (S.D.N.Y. Jan. 24, 2024) (quoting *Silverberg v. DryShips Inc.*, No. 17-CV-4547 (SJF) (ARL), 2018 WL 10669653, at *2 (E.D.N.Y. Aug. 21, 2018); (collecting cases); *accord Analytical Survs., Inc. v. Tonga Partners, L.P.*, 684 F.3d 36, 52 (2d Cir. 2012), *as amended* (July 13, 2012)). Instead, the granting of a motion for reconsideration is appropriate "*only* if the movant points to an intervening change in controlling law, the availability of new evidence, or the need to correct a clear error or prevent manifest injustice," *Kamdem-Ouaffo*, 2023 WL 2266536, at *2 (cleaned up and emphasis added).

II. ESTIVAL'S ARGUMENT IMPERMISSIBLY RAISES NEW LEGAL ARGUMENTS AND, EVEN IF PROPERLY RAISED, IS MERITLESS

A. Point One: Estival's Argument Concerning Representations of Counsel and the Spirit Museum's New Statements Impermissibly Relies on New Evidence and is Nonetheless Meritless

Estival argues that the Court incorrectly determined that his counsel, Lex Lumina, misrepresented key facts to the Court. *First*, it is unclear how this is appropriate for a motion for reconsideration under Local Rule 6.3. Nothing in the Court's decision would be impacted by this. *Second*, the motion is based on new evidence, not evidence that the Court overlooked. Ms. Sundberg's declaration improperly contradicts her prior sworn testimony and is internally inconsistent.

1. Ms. Sundberg's testimony was clear that no decision regarding the exhibit text had been made.

The January 26 2024 Declaration of Rhett O. Millsaps II, ECF No. 215 ("Millsaps Decl."), included the representation that Mr. Millsaps and his partner Chris Sprigman "spoke to representatives of the Spiritmuseum" and that the museum representatives "confirmed the following details about the planned exhibition" including, importantly, that:

> "[t]he museum intends to display MetaBirkins using a computer or a screen alongside exhibit text that would identify Mr. Rothschild as the artist responsible for MetaBirkins, explain that Hermès sued over the MetaBirkins and won a trial against Mr. Rothschild in the U.S. for trademark infringement, and further explain that Mr. Rothschild is challenging that result on appeal."

Millsaps Decl ¶ 3.

Ms. Sundberg's testimony at the evidentiary hearing was clear that no such decision had been made. Ms. Sundberg testified, "[w]e have not yet decided whether we will discuss the lawsuit in text context, in text of the exhibition. We have not at all each reached the point where we started to discuss, Dr. Blake and I, what the context of the text around this artwork will be." Hearing Tr. at 12.

The Order explained that Estival (including his counsel), Dr. Gopnik, and the Spirit Museum failed to provide "any details whatsoever about how the exhibit will describe" the MetaBirkins NFTs. Order at 9. That continues to be true. This portion of the Motion is directed solely to the issue of details concerning that text—and while counsel and Ms. Sundberg say that they have had discussions, they have withheld any additional details of that text. As such, there are no circumstances under which the Motion could impact the Order, let alone point to evidence overlooked.

2. The Motion improperly relies on the Sundberg Declaration, which is new evidence, and even if new evidence were allowed, the Sundberg Declaration is impermissible for contradicting prior sworn testimony.

Estival avers that "Ms. Sundberg did, in fact, tell [Estival]'s counsel prior to submission of the Motion papers that 'the museum would explain in the exhibit showing MetaBirkins that Hermès sued and won a trial against [Estival] over the MetaBirkins artworks, and that [Estival] is challenging that result on appeal.'" Motion at 6 (quoting March 27, 2024 Declaration of Mia Sundberg ("Sundberg Decl.") ¶ 2). To the extent that this relies on new evidence, it is improper for this Motion. More important, though, it contradicts Ms. Sundberg's prior, unequivocal testimony.

As indicated above, Ms. Sundberg testified to the contrary. Hearing Tr. at 12. In response to the Court's direct questioning, Ms. Sundberg also was clear that the text would not explain that the MetaBirkins are "an example of an artist who has explicitly made it his project to deceive someone. That would not be a way of expressing myself in a text in an exhibition." *Id.* at 13–14. Put plainly, Ms. Sundberg was eschewing mentioning the essence of the Jury verdict, and in particular, the Jury's ruling on Estival's First Amendment argument. Thus, her statement now that she would discuss the Jury Verdict is, at least, questionable.

In addition, Ms. Sundberg now testifies that "*[h]aving considered the matter* further since the [February 20, 2024 evidentiary hearing,] we do intend to convey that information in the exhibit if we are able to include the MetaBirkins artworks." *Id.* (emphasis added). This is an internal contradiction which is not explained. Obviously, if a decision had to be made, the matter would not need to be considered further. This tension raises additional questions, and certainly undercuts the credibility of Ms. Sundberg's declaration.

The Sundberg Declaration has all of the characteristics (save being filed on summary judgment) of what has been referred to as a declaration creating a sham issue of fact. As this

Court has explained, subsequent declarations which conflict with earlier testimony "should be struck, since 'factual issues created solely by an affidavit crafted to oppose a summary judgment motion are not 'genuine' issues for trial.'" *Poppington LLC v. Brooks*, No. 20-CV-8616 (JSR), 2022 WL 2121478, at *2 (S.D.N.Y. June 13, 2022) (Rakoff, J.) (quoting *Hayes v. New York City Dep't of Corr.*, 84 F.3d 614, 619 (2d Cir. 1996)). "The sham issue of fact doctrine has primarily been applied where a party submits sworn testimony that contradicts the party's own prior statements, but it may also apply where a party submits contradictory evidence from non-party witnesses to defeat summary judgment." *Gilani v. Teneo, Inc.*, No. 20-CV-1785 (CS), 2022 WL 220087, at *10 (S.D.N.Y. Jan. 25, 2022), *aff'd*, No. 22-169, 2022 WL 17817895 (2d Cir. Dec. 20, 2022). The contradictions between deposition and affidavit must be "inescapable and unequivocal," and the relevant issues must have been "thoroughly and clearly explored in the deposition." *Gilani*, 2022 WL 220087, at *9 (cleaned up). The same rationale is applicable here, where the declaration testimony is directly contradictory to testimony thoroughly explored during an evidentiary hearing.

The contradictions between Ms. Sundberg's declaration and her prior testimony are inescapable and unequivocal. Ms. Sundberg was aware of the issues being raised at the evidentiary hearing, had no problem understanding the Court's questions, and answered fully at the time. As indicated above, counsel for Hermès reached out twice with questions that were similar to those raised by the Court, including the following "Mr. Rothschild counsel indicated that there would be a discussion of the lawsuit as part of the exhibition. If that is accurate, can you provide that text to us?" Ms. Sundberg provides no reason for giving new testimony which was at odds with her prior testimony. And of course, neither Ms. Sundberg, nor Estival, nor Estival's counsel have provided any detail of that discussion or the text which is "intended."

Estival seems to argue that the Motion is needed to "correct a clear error or prevent manifest injustice." *Kamdem-Ouaffo*, 2023 WL 2266536, at *2 (cleaned up). Estival points to neither a clear error nor manifest injustice. Ms. Sundberg's testimony at the evidentiary hearing was precise and should not be subject to later collateral attack just because Estival is unhappy with the result.[4]

Estival further argues that a single caveat in Dr. Gopnik's testimony was overlooked by the Court, but that is clearly not the case. The Court explicitly referred to Dr. Gopnik's testimony and noted Dr. Gopnik testimony that if language about the verdict were included, it would necessarily be cursory. Order at 7. The Court even referenced its concerns that Dr. Gopnik, the exhibit's curator, is openly hostile to the Jury Verdict. Order at 8–9. The Court clearly did not overlook these facts.

B. Point Two: Estival's First Amendment Argument Impermissibly Raises New Legal Arguments And, Even If Properly Raised, Is Meritless

Roughly 40% of the Motion is focused on brand new arguments and authority. That section of Estival's brief is titled "[C]onstruing the injunction to prohibit [Estival] from giving the requested permission violates the First Amendment." This is a brand-new argument, and it is wrong.

Estival's original application included a five-paged, single spaced letter brief accompanied by two declarations (Estival and Millsaps). In further support of the application, Estival submitted a reply brief, also accompanied by two declarations (Estival and Sprigman). Estival's sole argument concerning the First Amendment was a conclusory one:

[4] Estival seems to argue that Dr. Gopnik's testimony is somehow clarifying. This is a red herring. *First*, Dr. Gopnik was non-committal. *Second*, the Court explicitly references Dr. Gopnik's testimony. *Third*, Dr. Gopnik clearly testified that the final text would be decided by the Spirit Museum (Hearing Tr. at 8:7–16) and, as indicated, Ms. Sundberg testified that they had not yet reached the point of discussing the issue. *Id.* at 12:13–23.

> Mr. Rothschild has a strong First Amendment interest in authorizing the public display of his MetaBirkins artworks, and, in particular, in public discussion of his artwork and the legal dispute connected to it. *See, e.g., Hurley v. Irish–American Gay, Lesbian and Bisexual Grp. of Boston*, 515 U.S. 557, 569 (1995) (The protection of the First Amendment is not limited to written or spoken words, but includes other mediums of expression, including music, pictures, films, photographs, paintings, drawings, engravings, prints, and sculptures). Interpreting the Order to restrain Mr. Rothschild from authorizing the Museum's display of MetaBirkins artworks would be a restraint on speech that is not justified by the protection of any cognizable trademark interest under U.S. law.

Letter Application, ECF No. 213 at 5.

The Motion does not discuss the *Hurley* case. Rather, the First Amendment argument contains eleven new case citations. Though the original application contained some citation to the record, in support of its argument, the Motion contains four record citations (ECF Nos. 24-21, 144, 149, and 159)[5] that were not included in the original application.

As the Court is well aware, Estival's original motion focused predominantly on issues of trademark and copyright law, and whether the Lanham Act could be applied extraterritorially. Letter Motion at 4–5 (ECF No. 213). Estival does not "point[] to an intervening change in controlling law" nor brings to the Courts attention "controlling authority or factual matters . . . which were *overlooked*." *Kamdem-Ouaffo*, 2023 WL 2266536, at *2 ; *Mr. Water Heater Enters.*, 2010 WL 286683, at *2 (cleaned up and emphasis added). Instead, Estival impermissibly asserts new legal arguments which were not before the Court on his original motion. *See Mr. Water Heater Enters.*, 2010 WL 286683, at *1. On this basis alone, Estival's Motion should be denied.

[5] Estival's Letter Application (ECF No. 213) cited to the trial transcript (specifically, ECF No. 149 at 126:20-127:4). The Motion cites to the same day at trial, but to a different portion (ECF No. 149 at 198:9-199:19). *See* ECF No. 233 at 9.

Estival raises two arguments: (i) a disclaimer—as of yet undrafted and undisclosed—will suffice to prevent confusion; and, (ii) the Court required the Spiritmuseum to identify Estival as a "fraud." Neither argument has merit.

It was Estival himself—not the Spiritmuseum—that made the current application. In so doing, Estival raised the issue of clarifying text that would accompany the MetaBirkins. This first came in correspondence from counsel and then was repeated in Estival's original application:

> The [M]useum intends to display MetaBirkins on a screen just as the images are available on the Internet. The museum intends to include mention of [this] lawsuit in the exhibit's description of the MetaBirkins artworks.

ECF No. 213 at 3.

In his reply, Estival said something similar:

> [T]he exhibit would make clear that the MetaBirkins are not affiliated with Hermès and Mr. Rothschild would receive no compensation . . .
>
> * * *
>
> The Spritmuseum has asked only for Mr. Rothschild's permission to display some of the MetaBirkins artworks along with text explaining that Hermès is not affiliated with MetaBirkins (and in fact sued Mr. Rothschild over MetaBirkins),[6]

ECF No. 219 at 1-2.

Estival never challenged the propriety of a disclaimer or accompanying text in his moving papers. To the contrary, he seemed to suggest that such text would be included, though,

[6] During the evidentiary hearing, Ms. Sunberg *only* discussed an "agree[ment] to have a disclaimer, that this has nothing with Hermes to do" in response to an email request sent from Hermès' counsel the day before. Hearing Tr. at 14. Nothing in Estival's various submissions indicate that this was discussed, let alone confirmed, with Estival's counsel ahead of the filing.

clearly he did not know the contents of such text. At the hearing, it was made clear that the foregoing representations were an overstatement of the Spirit Museum's intentions.

Estival now seems to argue that a disclaimer (or explanatory text) is sufficient. Of course, to date, Estival has not shown the disclaimer or explanatory text over which he seeks approval. Rather than point the Court to language that might have been overlooked, Estival basically argues that the Spirit Museum could ape the disclsaimer from his website, suggesting that the Court found it acceptable. ECF No. 224 at 9. This is incorrect. In denying Estival's motion for judgment as a matter of law, and granting the Injunction, the Court explained:

> A disclaimer to be displayed on the www.metabirkins.com website, social media accounts, and other platforms, and disseminated to purchasers of the NFTs would, in [Estival]'s view, [prevent confusion among the public]. The Court rejects this argument. It is at odds both with the jury's determination that Hermès proved that [Estival] had intentionally waived his First Amendment protection under *Rogers* and with Second Circuit caselaw on equitable remedies in the trademark context. It will be recalled that the jury determined that Hermès had shown by a preponderance of the evidence that "[Estival]'s use of the Birkin mark . . . was *intentionally designed* to mislead potential consumers into believing that Hermès was associated with [Estival]'s MetaBirkins project." ECF No. 143 at 21
>
> * * *
>
> As for [Estival]'s insistence that a disclaimer -- namely, "MetaBirkins are artworks by Mason Rothschild and are not affiliated with or endorsed or sponsored by Hermès," ECF No. 176 at 1 – would remedy any irreparable harm suffered by Hermès, this argument flies in the face of settled caselaw and the jury's verdict. Indeed, the Supreme Court itself, in the recent *Jack Daniel's Products* case, found such a disclaimer insufficient to avoid confusion. *Jack Daniel's Products*, slip op. at 7. In this Circuit, "a defendant must justify the effectiveness of its proposed disclaimers at the remedy stage." *Hamilton Int'l Ltd. v. Vortic LLC*, 13 F.4th 264, 274 n.4 (2d Cir. 2021). [Estival] does not come close to meeting this burden. [Estival's] proposed disclaimer is practically identical to the one that was displayed on the www.metabirkins.com website, the very same disclaimer that failed to convince jurors that he was not-liable under the Lanham Act. Still, knowing this, [Estival] makes no effort -- beyond

> stating, without evidence, that "[t]he use of a disclaimer . . . would balance" the interests of [Estival], Hermès, and the third parties -- to further defend this disclaimer.

Opinion and Order, ECF No. 191 at 23–24, 26–27.

Estival has not pointed the Court to any language the Court overlooked, while also being less than accurate in representing the Court's prior rulings.

Estival's original submissions suggested that the MetaBirkins would be exhibited by the Spirit Museum in a way that explained context and avoided confusion. Hermès opposed the application because of insufficient information, including about the accompanying text, and the Court expressed similar concerns. In seeking reconsideration, Estival merely argues again that he should be allowed to do what he wants with an undisclosed (and apparently as of yet unconceived) disclaimer. Estival is merely making the same arguments and doing so in a less than candid way. The motion should be denied on this basis as well.

Estival then creates a strawman, arguing that, in his opinion, the Court required the Spiritmuseum to call him a "fraud." The Court did no such thing, and Estival points to no language from the Order coming close to making such a requirement. Estival's argument is particularly nefarious because his original application stated that he had a "particular interest in the public discussion of his artworks *and the legal dispute connected to it*."[7] ECF No 213 at 5 (emphasis added). In deciding the cybersquatting claim, the Jury necessarily found that Estival "had a bad faith intent to profit from the Birkin mark." Jury Instructions, ECF No. 143 at 20. Likewise, in the First Amendment charge—which Hermès objected to and Estival embraced—Hermès was required to prove "by a preponderance of the evidence that [Estival]'s use of the Birkin mark was not just likely to confuse potential consumers but was intentionally designed to mislead potential consumers into believing that Hermes was associated with [Estival]'s

[7] As indicated below, it is unclear that Estival really has such an articulable interest.

MetaBirkins project. In other words, if Hermes proves that [Estival] actually intended to confuse potential customers, he has waived any First Amendment protection." *Id.* at 21. Estival, having injected this issue into the case and the Spirit Museum application, now has the temerity to suggest that the Court was wrong to ask about it.

As the proposed text still remains a mystery, it appears that Estival's so-called First Amendment interest is really just being able to dictate how the public will perceive this case. Indeed, Ms. Sundberg reinforced that position and undercut the statement that Estival seeks to discuss the "legal dispute connect to [the Metabirkins]" when she testified as follows:

> THE COURT: But you don't think it's important for the people who visit your exhibition that unlike Warhol, this alleged artist using a fake name designed his images in order to deceive the public into believing that Hermes was sponsoring his images?
>
> THE WITNESS: I'm not sure we would express it that way. Perhaps we would -- when you as I curate and when you write text for the public, you discuss things in a more opened-ended way. So I would not be telling my public, this is an artist who is a fraud. This is an example of an artist who has explicitly made it his project to deceive someone. That would not be a way of expressing myself in a text in an exhibition."

Hearing Tr. at 13–14.

Thus, it appears that Estival's statement concerning his First Amendment goals of discussing the case are, unsurprisingly, inaccurate at best. Clearly, the Jury's central finding was not part of the anticipated text, notwithstanding Estival's urging to the contrary. This conclusion is ineluctable when considering that, to date, no proposed text has been provided.

Most important, though, as stated, the Order did not condition the inclusion of the MetaBirkins images on any particular disclosures. The Order explicitly states that the Court cannot approve the requested permission because of the "lack of any details whatsoever about how the exhibit will describe Estival's MetaBirkins NFTs to the public." Order at 9. The Court's inquiry into any language the witnesses might have used in describing the jury verdict does not

amount to a compelled disclosure. This argument is a red herring, a waste of the Court's time, and plainly frivolous as it points to no legal or factual issues that the Court overlooked. The Motion should be denied on this ground.

C. Point Three: Estival's Motion For Reconsideration Does Not Point To Controlling Decisions Or Data That The Court Overlooked Concerning Promotion and Merchandising

Estival cannot and does not point to controlling decisions which the Court overlooked. Instead, his arguments are purely factual. Estival states that the Court, in determining that it could not know, "the basic details about the scope of [Estival's] permission" (Order at 5), overlooked facts which would have altered that conclusion. Estival points the Court to a single statement in his declaration that the museum "has not asked for my permission to use MetaBirkins images in any promotional materials or in merchandise, and I would not give such permission to the museum." February 7, 2024 Declaration of Mason Rothschild ¶ 4. Estival cannot reasonably argue that the Court *overlooked* this statement, nor can he reasonably argue that his single statement alone, particularly coming from a provenly unreliable source who has no control over the Spirit Museum, should give sufficient assurances to the Court. In fact, the Court held an evidentiary hearing to vet out the facts surrounding Estival's original application which was devoid of salient details. "Rather than assuage the Court's concerns, the evidentiary hearing . . . only compounded them." Order at 6.

It must be noted that Estivals' comment that he would not authorize the Spirit Museum to use the MetaBirkins in promotion and merchandizing is a bit odd. *First*, Estival's entire position throughout this case (and even to some degree here) is that permission is not required for artistic endeavors, even if they are commercial in nature. *Second*, Estival claim to copyright ownership is a dubious one—it is undisputed that a third party used Hermès's Birkin designs to create the MetaBirkins. *Third*, if this intent were as clear as it is now portrayed, why didn't Estival (and for

that matter, the Spirit Museum) enter into a written agreement that would obviate all of these questions? Certainly, the failure to do so does not demonstrate that the Injunction is being taken as seriously as it should be. Simply put, the Court had no reason to credit Estival's bald assertion about the Spirit Museum's future conduct.

Estival also argues that the Court should have asked about the museum's intent to use the Metabirkins images in connection with merchandise or promotional material and that, based on the subsequently filed Sundberg Declaration, it would have confirmed that no such promotion or merchandising was planned. This argument is particularly galling in light of the history set forth above. It is not the Court that is required to put on Estival's case for him. Estival refused to provide this information to Hermès and the Court before the evidentiary hearing and the Spirit Museum refused to response to Hermès. There was no reason for the Court to make inquiries about facts that Estival did not put forth, and Estival sites no authority to the contrary.

This argument is another red herring. The Court questioned Ms. Sundberg about the exhibition's discussion of the lawsuit in an effort to avoid further confusion, and it was *that* testimony which demonstrated that the risk of confusion was too great to permit Estival's request. In fact, the Court specifically responded to Ms. Sundberg's refusal to commit to the text by explaining "it seems to me that you've just told me that I can't permit this to happen because the whole point of my injunction is to prevent the further confusion of the public with respect to what the jury determined was a flatout fraud." Hearing Tr. at 14. The Court was under no obligation to ask additional questions once its concerns were confirmed.

Ms. Sundberg's statement standing alone remains insufficient. In her carefully crafted declaration—which given its form and citation to 28 U.S.C. § 1746 suggests at least some assistance of an attorney—Ms. Sundberg does not confirm that the Spirit Museum will refrain from using the MetaBirkins NFTs in relation to promotional material or merchandising; she

testifies only that the Spirit Museum "has no intention" of doing so. Sundberg Decl. ¶ 3. Given Estival's lack of candor throughout this case, and coyness concerning the facts and circumstances surrounding the exhibition, this is not enough. Simply put, this is not the kind of "concrete situation" required by a party seeking to clarify the scope of an injunction. *Paramount Pictures Corp. v. Carol Pub. Grp., Inc.*, 25 F. Supp. 2d 372, 374 (S.D.N.Y. 1998) (quoting *Regal Knitwear Co. v. Nat'l Lab. Rel. Bd.*, 324 U.S. 9, 15 (1945)). Nor is this introduction of additional facts not in the record on the original motion appropriate on a motion for reconsideration. *Huzhou Chuangtai Rongyuan*, 2024 WL 262741, at *1 . In any event, the Court did not overlook such a fact which was not on the record, and certainly did not overlook Estival's single declaratory statement.

CONCLUSION

Estival's Motion contains impermissibly raised new legal arguments, introduces additional facts not in the record on the original motion, and does not point the Court to any evidence or controlling case law it may have overlooked as required for the narrow scope of a Rule 6.3 motion for reconsideration. The Motion is improper and does not present a case worthy of granting the extraordinary remedy of reconsideration. Nor does the Motion assuage Hermès nor the Court's concerns about whether the exhibition will violate the Injunction. Even with the addition of the Sundberg declaration, there remain many unanswered questions about the exhibition. Specifically, there are still no concrete details regarding how the Jury Verdict will be described in the text accompanying the exhibition and how confusion will be avoided. Nor are there any descriptions of or commitments concerning the museum catalogues or other accompanying materials which may be made available to the public and whether the MetaBirkins NFTs would be included. As stated in the Order, there has been a lack of "any details whatsoever about how the exhibit will describe" the MetaBirkins NFTs, and that

continues to be true. Order at 9. For the foregoing reasons, Hermès respectfully requests that this Court denies Rothschild's Motion for Reconsideration.

Dated: April 10, 2024
New York, New York

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