

ORIGINAL

**UNITED STATES DISTRICT COURT  
EASTERN DISTRICT OF NEW YORK**

**FILED**  
IN CLERK'S OFFICE  
U.S. DISTRICT COURT E.D.N.Y.  
★ FEB 11 2009 ★

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TRACFONE WIRELESS, INC., a Delaware Corporation,

Plaintiff,

-against-

KAMLASH RANI a/k/a Rani Kamlash, individually; RAJNI RANI, individually; PARVEEN K. KUNDRA, individually; DK WIRELESS INC., a New York corporation, d/b/a Wireless Touch and Talk 2 Me; ADVANTAGE WIRELESS, INC., a New York corporation; MOHINDER SINGH, individually; FRIENDLY CELLULAR, INC., a New York Corporation; IA COMMUNICATION, INC., a New York corporation; AJAY MEHTA, individually; VINNY PATEL, individually; JOHN DOES 1-50; and XYZ COMPANIES 1-50,

Defendants.

INDEX NO. 1:08-CV-00707-DLI-RLM

**AMENDED FINAL JUDGMENT AND PERMANENT INJUNCTION  
AGAINST DEFENDANTS VINNY PATEL AND ADVANTAGE WIRELESS, INC**

Plaintiff, TracFone Wireless, Inc. ("TracFone"), brought the above-captioned lawsuit against Defendants Vinny Patel, individually ("Patel") and Advantage Wireless, Inc. ("Advantage"), (collectively "Defendants") alleging that Defendants are engaged in an unlawful enterprise involving the acquisition, sale and alteration of large quantities of TracFone and TracFone's NET10 branded prepaid wireless telephones ("TracFone/NET10 Prepaid Phones" or "Phones") purchased from various retail outlets such as Wal-Mart, Target and Sam's Club, the solicitation and payment of others to bulk purchase TracFone/NET10 Prepaid Phones for Defendants' benefit, computer hacking and erasing or otherwise disabling the prepaid software

(“TracFone/NET10 Prepaid Software”) installed in the Phones essential for consumers to access TracFone’s prepaid wireless network, or reselling the Phones to others who disable the software, and ultimately selling the altered Phones as new under TracFone’s trademarks for the unauthorized use outside of the TracFone prepaid wireless system for profit (the “Bulk Resale Scheme”).

As a result of Defendants’ involvement in the Bulk Resale Scheme, TracFone asserted claims against the Defendants for federal trademark infringement under 15 U.S.C. § 1114; federal unfair competition under 15 U.S.C. § 1125(a); contributory trademark infringement; copyright infringement under Title 17 of the United States Code; circumvention of technological measures that control access to copyrighted software and trafficking in services that circumvent technological measures protecting copyrighted software under 17 U.S.C. § 1201, *et. seq.* as a violation of the Digital Millennium Copyright Act (“DMCA”); breach of contract; tortious interference with prospective contractual relationships; common law unfair competition; dilution of TracFone’s trademarks under N.Y. Gen. Bus. Law § 360-1; unjust enrichment; and deceptive trade practices under N.Y. Gen. Bus. Law § 349. Accordingly, it is hereby,

**ORDERED, ADJUDGED and DECREED** that:

1. This Court has jurisdiction over all the parties and all of the claims set forth in TracFone’s complaint.

2. The Court finds that TracFone owns all right, title, and interest in and to Incontestable United States Trademark Registration No. 2,114,692, issued November 18, 1997, for TracFone and Incontestable United States Trademark Registration No. 2,71,017, issued September 9, 2003, for TracFone (the “TracFone Trademarks”). The TracFone Trademarks are valid, incontestable, distinctive, protectable, famous, have acquired secondary meaning and are

associated exclusively with TracFone. TracFone also holds a valid copyright on the TracFone Prepaid Software.

3. The Court finds that the Defendant's involvement in the Bulk Resale Scheme constitutes federal trademark infringement under 15 U.S.C. § 1114; federal unfair competition under 15 U.S.C. § 1125(a); contributory trademark infringement; copyright infringement under Title 17 of the United States Code; circumvention of technological measures that control access to copyrighted software and trafficking in services that circumvent technological measures protecting copyrighted software under 17 U.S.C. § 1201, *et. seq.* as a violation of the DMCA; breach of contract; tortious interference with prospective contractual relationships; common law unfair competition; dilution of TracFone's trademarks under N.Y. Gen. Bus. Law § 360-1; unjust enrichment; and deceptive trade practices under N.Y. Gen. Bus. Law § 349.

4. The Court further finds that Defendants' participation in the Bulk Resale Scheme has caused substantial and irreparable harm to TracFone, and will continue to cause substantial and irreparable harm to TracFone unless enjoined.

5. TracFone is entitled to injunctive relief and damages on the claims set forth in the Amended Complaint.

6. On November 27, 2006, the Librarian of Congress, upon the recommendation of the Register of Copyrights, issued a Final Rule setting forth six (6) classes of copyrighted works that are exempt from the provisions of the DMCA, including:

Computer programs in the form of firmware that enable wireless telephone handsets to connect to a wireless telephone communication network, when circumvention is accomplished for the sole purpose of lawfully connecting to a wireless telephone communication network.

71 Fed. Reg. 68472 (Nov. 27, 2006) (amending 37 C.F.R. § 201.40(b)). The Court finds that this new exemption does not absolve the Defendant of liability for his violations of the DMCA as

alleged in TracFone's complaint, because Defendants' conduct as alleged in this case does not come within the scope of the new exemption. Defendants' purchase and resale of the TracFone handsets was for the purpose of reselling those handsets for a profit, and not "for the sole purpose of lawfully connecting to a wireless telephone communication network." Because the exemption does not apply to the conduct alleged in this case, there is no need for the Court to address the validity of the exemption or the circumstances surrounding its enactment.

7. Final judgment is hereby entered as follows: (a) against Defendant Advantage Wireless, Inc., and in favor of the Plaintiff, TracFone Wireless, Inc., on all of the claims set forth in TracFone's complaint, in the principal amount of FIVE MILLION DOLLARS AND ZERO CENTS (\$5,000,000.00), which shall bear interest at the legal rate, for which let execution issue forthwith; and (b) against Defendant Vinny Patel, individually, and in favor of the Plaintiff, TracFone Wireless, Inc., on all of the claims set forth in TracFone's complaint, in the principal amount of ONE MILLION DOLLARS AND ZERO CENTS (\$1,000,000.00), which shall bear interest at the legal rate, for which let execution issue forthwith; and

8. Defendants and each and all of their representatives, agents, employees, independent contractors, relatives, associates, servants and any and all persons and entities in active concert and participation with them who receive notice of this order shall be and hereby are PERMANENTLY ENJOINED from:

- a. purchasing and/or selling any wireless mobile phone that they know or should know bears, or previously bore, any TracFone Trademark, NET10 Trademark and/or any other trademark owned or used by TracFone ("TracFone/NET10 Handsets"). Specifically, Defendants are enjoined from purchasing and/or selling all TracFone/NET10 Handsets currently offered for sale by TracFone, or that may

be offered for sale in the future, as listed and updated from time to time on TracFone's and NET10's websites, [http://tracfone.com/activation\\_pick\\_brand.jsp](http://tracfone.com/activation_pick_brand.jsp) and [www.net10.com](http://www.net10.com), including without limitation the following TracFone/NET10 handsets:

Motorola W175	Motorola V170	Nokia 1221
Motorola W260g	Motorola V171	Nokia 1600
Motorola W376g	Motorola C155	Nokia 2285
Motorola W370R	Motorola C343	LG 400G
Motorola W370	Motorola V60i	LG 3280
Motorola W375	Nokia 2126	LG CG225
Motorola C261	Nokia 2126i	LG 1500
Motorola C139	Nokia 2600	LG 200C
PINK Motorola C139	Nokia 1100	Kyocera K126C
Motorola V176	Nokia 1112	

- b. reflashing and/or unlocking of any TracFone/NET10 Handset;
- c. accessing, altering, erasing, tampering with, deleting or otherwise disabling TracFone's proprietary prepaid cellular software contained within any and all models of TracFone/NET10 Handsets;
- d. facilitating or in any way assisting other persons or entities who Defendant knows or should know are engaged in reflashing and/or unlocking TracFone/NET10 Handsets and/or hacking, altering, erasing, tampering with, deleting or otherwise disabling the software installed in TracFone/NET10 Handsets;
- e. facilitating or in any way assisting other persons or entities who Defendant knows or should know are engaged in any of the acts prohibited under this permanent injunction including, without limitation, the buying and/or selling of unlocked TracFone/NET10 Handsets; and

f. knowingly using the TracFone Trademarks or any other trademark owned or used by TracFone, or that is likely to cause confusion with TracFone's Trademarks, without TracFone's prior written authorization.

9. The address of Defendant Vinny Patel is 8940 239th Street, Floor 1, Bellerose, NY 11426.

10. The address of Defendant Advantage is 196 West Marie Street, Hicksville, NY 11801.

11. The address of Plaintiff, TracFone Wireless, Inc. is 9700 NW 112<sup>th</sup> Avenue, Miami, FL 33178.

12. The Court retains jurisdiction over this matter and the parties to this action in order to punish any violation of the terms of this Permanent Injunction by a finding of contempt and a payment of damages to TracFone Wireless, Inc. in an amount of \$5,000 for each TracFone/NET10 Handset that Defendant is found to have purchased, sold, or unlocked in violation of this injunction, or \$500,000.00, whichever is greater.

13. The prevailing party in any proceeding to enforce compliance with the terms of this Permanent Injunction shall be entitled to an award of its attorneys' fees and costs.

14. This case remains pending against the other defendants named in TracFone's pleadings. The Court finds that there is no just reason for delay of the entry of judgment against Defendants Vinny Patel, individually, and Advantage Wireless, Inc., and therefore directs the Clerk to enter Judgment as set forth herein. *See* Fed. R. Civ. P. 54(b).

**DONE AND ORDERED** in Brooklyn, New York, this \_\_\_\_ day of \_\_\_\_\_, 200\_\_.

\_\_\_\_\_  
THE HONORABLE DORA L. IRIZARRY  
UNITED STATES DISTRICT JUDGE

*Pursuant to the Court's order of February 4, 2009, amended judgment is hereby entered as described above.*

By \_\_\_\_\_

*Clerk  
Chief Deputy 2/11/09.*

Copies furnished to:

Counsel and pro se litigants of record.