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8
9 UNITED STATES DISTRICT COURT
10 CENTRAL DISTRICT OF CALIFORNIA

12 DECKERS OUTDOOR
13 CORPORATION, a Delaware
14 Corporation,

14 Plaintiff,

15 v.

16 MARKS AND SPENCER PLC, a United
17 Kingdom Public Limited Company; and
18 DOES 1-10, inclusive,

19 Defendants.

) CASE NO.

) **COMPLAINT FOR DAMAGES AND
EQUITABLE RELIEF:**

- 14 **1. TRADE DRESS INFRINGEMENT;**
15 **2. TRADE DRESS INFRINGEMENT
UNDER CALIFORNIA COMMON
LAW;**
16 **3. PATENT INFRINGEMENT – U.S.
PATENT NO. D599,999;**
17 **4. UNFAIR COMPETITION
CALIFORNIA UNFAIR BUSINESS
PRACTICES ACT, CAL. BUS. &
PROF. CODE, § 17200, ET. SEQ.;**
18 **5. UNFAIR COMPETITION UNDER
CALIFORNIA COMMON LAW.**

JURY TRIAL DEMANDED

1 ascertained. Deckers is informed and believes and based thereon alleges that said
2 Defendant and DOES 1 through 10, inclusive, are in some manner responsible for the
3 wrongs alleged herein, and that at all times referenced each was the agent and servant
4 of the other Defendant and was acting within the course and scope of said agency and
5 employment.

6 7. Deckers is informed and believes, and based thereon alleges, that at all
7 relevant times herein, Defendant and DOES 1 through 10, inclusive, knew or
8 reasonably should have known of the acts and behavior alleged herein and the damages
9 caused thereby, and by their inaction ratified and encouraged such acts and behavior.
10 Deckers further alleges that Defendant and DOES 1 through 10, inclusive, have a non-
11 delegable duty to prevent or not further such acts and the behavior described herein,
12 which duty Defendant and DOES 1 through 10, inclusive, failed and/or refused to
13 perform.

14 **ALLEGATIONS COMMON TO ALL CAUSES OF ACTION**

15 **A. Deckers' UGG® Brand**

16 8. Deckers has been engaged in the design, distribution, marketing, offering
17 for sale, and sale of footwear since 1975. Deckers owns several brands of footwear
18 including UGG®, Koolaburra®, Teva®, Sanuk®, and Hoka One One®.

19 9. Deckers' UGG® brand remains one of the most recognized and relevant
20 comfort shoe brands in the industry. Since 1979, when the UGG® brand was founded,
21 the popularity of UGG® boots has steadily grown across the nation and even the
22 globe. The UGG® brand has always been and remains highly coveted by consumers.
23 This commitment to quality has helped to propel the UGG® brand to its current,
24 overwhelming level of popularity and cemented its status as a luxury brand.

25 10. In 2000, UGG® boots were first featured on Oprah's Favorite Things®
26 where Oprah emphatically declared on national television how much she
27 "LOOOOOVES her UGG boots." The popularity of UGG® brand footwear has grown
28 exponentially since then with celebrities including Kate Hudson and Sarah Jessica

1 Parker among a myriad of others regularly donning them. UGG® sheepskin boots
2 have become a high fashion luxury item and can be found on fashion runways around
3 the world.

4 11. Deckers' UGG® products are distributed and sold to consumers through
5 authorized retailers throughout the United States at point-of-sale and on the Internet,
6 including through its UGG® Concept Stores and its website www.ugg.com.

7 **B. Defendant's Infringing Activities**

8 12. The present lawsuit arises from Defendant's design, manufacture,
9 distribution, advertisement, marketing, offering for sale, and sale of footwear which
10 infringe upon Deckers' rights to the "Bailey Button Trade Dress" and D599,999 Patent
11 ("Accused Products")

12 13. Upon information and belief, Defendant is engaged in the retail sale of a
13 wide range of apparel, accessories, and home merchandise. Defendant manufactures,
14 designs, advertises, markets, distributes, offers for sale, and/or sells footwear for
15 children under its "M&S Kids" line.

16 14. Upon information and belief, Defendant has designed, manufactured,
17 advertised, marketed, distributed, offered for sale, and/or sold Accused Products,
18 exemplar shown below, via its website www.marksandspencer.com (hereinafter the
19 "Marks and Spencer Website"), which is accessible to consumers nationwide,
20 including those within this judicial district.



28 15. The Accused Product shown above was purchased from the Marks and

1 Spencer Website and shipped to and received in this judicial district.

2 16. Deckers is informed and believes and herein alleges that Defendant is a
3 competitor and has introduced Accused Products into the stream of commerce in an
4 effort to exploit Deckers' reputation in the market established in the UGG® Bailey
5 Button Boot.

6 17. Upon information and belief, Defendant may have sold additional
7 products that infringe upon Deckers' design patents and trade dresses. Deckers may
8 seek leave to amend as additional information becomes available through discovery.

9 18. Deckers has not granted a license or any other form of permission to
10 Defendant with respect to its trademarks, design patents, trade dresses, or other
11 intellectual property.

12 19. Deckers is informed and believes and herein alleges that Defendant has
13 acted in bad faith and that Defendant's acts have misled and confused and were
14 intended to cause confusion, or to cause mistake, or to deceive as to the affiliation,
15 connection, or association of the Accused Products with Deckers, or as to the origin,
16 sponsorship, or approval of the Accused Products by Deckers.

17 **FIRST CLAIM FOR RELIEF**

18 **(Trade Dress Infringement - 15 U.S.C. § 1125(a))**

19 20. Deckers incorporates herein by reference the averments of the preceding
20 paragraphs as though fully set forth herein.

21 21. The UGG® Bailey Button boot was introduced in 2009 and the "Bailey
22 Button Boot Trade Dress" is unique and distinctive, consisting of a combination of the
23 following non-functional elements:

- 24 i Classic suede boot styling made famous by the UGG® brand;
- 25 i Overlapping of front and rear panels on the lateral side of the boot shaft;
- 26 i Curved top edges on the overlapping panels;
- 27 i Exposed fleece-type lining edging the overlapping panels and top of the
28 boot shaft; and

1 i One or more buttons (depending on the height of the boot) prominently
2 featured on the lateral side of the boot shaft adjacent the overlapping panels
3 (hereinafter “Bailey Button Boot Trade Dress”).



11 22. The Bailey Button Boot Trade Dress, which is a composite of the above-
12 referenced features, is non-functional in its entirety, visually distinctive, and is unique
13 in the footwear industry.

14 23. The design of the Bailey Button Boot Trade Dress is neither essential to
15 its use or purpose nor does it affect the cost or quality of the boot. There are numerous
16 other designs available that are equally feasible and efficient, none of which
17 necessitate copying or imitating the Bailey Button Boot Trade Dress. The aforesaid
18 combination of features provides no cost advantages to the manufacturer or utilitarian
19 advantages to the consumer. These features, in combination, serve only to render
20 Deckers’ UGG® Bailey Button boots distinct and recognizable as goods originating
21 from Deckers’ UGG® brand.

22 24. The Bailey Button Boot Trade Dress is an original design by Deckers and
23 has achieved a high degree of consumer recognition and secondary meaning, which
24 serves to identify Deckers as the source of footwear featuring said trade dress.

25 25. The Bailey Button Boot Trade Dress is one of the most well-recognized
26 and commercially successful styles of Deckers’ UGG® brand of footwear, having been
27 featured on Deckers’ advertising and promotional materials as well as in various trade
28 publications. Furthermore, the Bailey Button Boot Trade Dress has been featured in

1 connection with various celebrities, has received a large volume of unsolicited media
2 attention, and has graced the pages of many popular magazines nationwide and
3 internationally.

4 26. Deckers has spent substantial time, effort, and money in designing,
5 developing, advertising, promoting, and marketing the UGG® brand and its line of
6 footwear embodying the Bailey Button Boot Trade Dress. Deckers spends millions of
7 dollars annually on advertising of UGG® products, which include products bearing the
8 Bailey Button Boot Trade Dress.

9 27. Deckers has sold hundreds of millions of dollars worth of UGG®
10 products bearing the Bailey Button Boot Trade Dress.

11 28. Due to its long use, extensive sales, and significant advertising and
12 promotional activities, Deckers' Bailey Button Boot Trade Dress has achieved
13 widespread acceptance and recognition among the consuming public and trade
14 throughout the United States.

15 29. There are numerous other boot designs in the footwear industry, none of
16 which necessitate copying or imitating the Bailey Button Boot Trade Dress. However,
17 due to the popularity and consumer recognition achieved by the Bailey Button boot,
18 said design has often been the subject of infringement by third-parties, including
19 Defendant.

20 30. Deckers is informed and believes and herein alleges that Defendant is a
21 competitor and has introduced Accused Products into the stream of commerce in an
22 effort to exploit Deckers' reputation in the market established in the UGG® Bailey
23 Button Boot.

24 31. The Accused Products produced, distributed, advertised and offered for
25 sale by Defendant are boots bear confusingly similar reproductions of the Bailey
26 Button Boot Trade Dress, such as to cause a likelihood of confusion as to the source,
27 sponsorship or approval by Deckers of Defendant's products.

28 32. Defendant's use of Deckers' Bailey Button Boot Trade Dress is without

1 Deckers' permission or authority and in total disregard of Deckers' rights to control its
2 intellectual property.

3 33. Defendant's use of Deckers' Bailey Button Boot Trade Dress is likely to
4 lead to and result in confusion, mistake or deception, and is likely to cause the public
5 to believe that Defendant's products are produced, sponsored, authorized, or licensed
6 by or are otherwise connected or affiliated with Deckers, all to the detriment of
7 Deckers.

8 34. Deckers has no adequate remedy at law.

9 35. In light of the foregoing, Deckers is entitled to injunctive relief
10 prohibiting Defendant from using Deckers' Bailey Button Boot Trade Dress, or any
11 designs confusingly similar thereto, and to recover all damages, including attorneys'
12 fees, that Deckers has sustained and will sustain, and all gains, profits and advantages
13 obtained by Defendant as a result of its infringing acts alleged above in an amount not
14 yet known, as well as the costs of this action.

15 **SECOND CLAIM FOR RELIEF**

16 **(Trade Dress Infringement under California Common Law)**

17 36. Deckers incorporates herein by reference the averments of the preceding
18 paragraphs as though fully set forth herein.

19 37. Defendant's infringement of the Bailey Button Boot Trade Dress
20 constitutes common law trade dress infringement in violation of the common law of
21 the state of California.

22 38. Defendant's unauthorized use of the Bailey Button Boot Trade Dress has
23 caused and is likely to cause confusion as to the source of Defendant's products, all to
24 the detriment of Deckers.

25 39. Defendant's acts are willful, deliberate, and intended to confuse the public
26 and to injure Deckers.

27 40. Deckers has no adequate remedy at law to compensate it fully for the
28 damages that have been caused and which will continue to be caused by Defendant's

1 infringing conduct, unless they are enjoined by this Court.

2 41. The conduct herein complained of was extreme, outrageous, and was
3 inflicted on Deckers in reckless disregard of Deckers' rights. Said conduct was
4 despicable and harmful to Deckers and as such supports an award of exemplary and
5 punitive damages in an amount sufficient to punish and make an example of
6 Defendant, and to deter it from similar conduct in the future.

7 42. In light of the foregoing, Deckers is entitled to injunctive relief
8 prohibiting Defendant from infringing the Bailey Button Boot Trade Dress, and to
9 recover all damages, including attorneys' fees, that Deckers has sustained and will
10 sustain, and all gains, profits and advantages obtained by Defendant as a result of its
11 infringing acts alleged above in an amount not yet known, and the costs of this action.

12 **THIRD CLAIM FOR RELIEF**

13 **(Patent Infringement - U.S. Patent No. D599,999)**

14 43. Deckers incorporates herein by reference the averments of the preceding
15 paragraphs as though fully set forth herein.

16 44. Deckers is the owner of numerous design patents to the various styles of
17 footwear it offers under its UGG® brand. These design patents include but are not
18 limited to the "Bailey Button" boot (U.S. Patent No. D599,999 issued on September
19 15, 2009), a true and correct copy of which is attached hereto and incorporated herein
20 as Exhibit A (" '999 Patent").

21 45. Deckers is the owner by assignment of all right, title and interest in and to
22 the '999 Patent.

23 46. The Accused Products that Defendant has caused to be produced,
24 distributed, advertised, marketed, offered for sale, and/or sold within the United States,
25 and/or has imported into the United States bear a design that is substantially similar to
26 the '999 Patent in direct violation of 35 U.S.C. § 271.

27 47. Defendant's aforesaid infringing acts are without Deckers' permission or
28 authority and are in total disregard of Deckers' right to control its intellectual property.

1 believing that Defendant's goods are authorized, licensed, affiliated, sponsored, and/or
2 approved by Deckers, thus constituting a violation of the California Unfair Business
3 Practices Act, Cal. Bus. & Prof. Code, § 17200, et. seq.

4 56. The deceptive, unfair and fraudulent practices set forth herein have been
5 undertaken with knowledge by Defendant willfully with the intention of causing harm
6 to Deckers and for the calculated purpose of misappropriating Deckers' goodwill and
7 business reputation.

8 57. Defendant's acts have caused and will continue to cause irreparable injury
9 to Deckers. Deckers has no adequate remedy at law to compensate it fully for the
10 damages that have been caused and which will continue to be caused by Defendant's
11 unlawful acts, unless it is enjoined by this Court.

12 58. In light of the foregoing, Deckers is entitled to all available relief
13 provided for in California Unfair Business Practices Act, Cal. Bus. & Prof. Code, §
14 17200, et. seq. including permanent injunctive relief.

15 **FIFTH CLAIM FOR RELIEF**

16 **(Unfair Competition Under California Common Law)**

17 59. Deckers incorporates herein by reference the averments of the preceding
18 paragraphs as though fully set forth herein.

19 60. Defendant's appropriation, adoption and use of the Bailey Button Boot
20 Trade Dress on its own footwear constitutes unfair competition in violation of the
21 common law of the state of California.

22 61. Defendant is a competitor of Deckers and has introduced Accused
23 Products into the stream of commerce in an effort to exploit Deckers' reputation in the
24 market established in the UGG® Bailey Button Boot.

25 62. Defendant's infringing acts were intended to capitalize on Deckers'
26 goodwill associated therewith for Defendant's own pecuniary gain. Deckers has
27 expended substantial time, resources and effort in creating and developing its unique
28 line of footwear that consumers recognize as originating from the UGG® brand. As a

1 result of Deckers' efforts, Defendant is now unjustly enriched and is benefiting from
2 property rights that rightfully belong to Deckers.

3 63. Defendant's acts are willful, deliberate, and intended to confuse the public
4 and to injure Deckers.

5 64. Deckers has no adequate remedy at law to compensate it fully for the
6 damages that have been caused and which will continue to be caused by Defendant's
7 infringing conduct, unless it is enjoined by this Court.

8 65. The conduct herein complained of was extreme, outrageous, and was
9 inflicted on Deckers in reckless disregard of Deckers' rights. Said conduct was
10 despicable and harmful to Deckers and as such supports an award of exemplary and
11 punitive damages in an amount sufficient to punish and make an example of
12 Defendant, and to deter it from similar conduct in the future.

13 **PRAYER FOR RELIEF**

14 WHEREFORE, Plaintiff Deckers Outdoor Corporation respectfully prays for
15 judgment against Defendant Marks and Spencer PLC as follows:

16 1. A Judgment that Defendant has infringed Deckers' Bailey Button Boot
17 Trade Dress and D599,999 Patent and that said infringement was willful;

18 2. An order granting temporary, preliminary and permanent injunctive relief
19 restraining and enjoining Defendant, and its agents, servants, employees, officers,
20 associates, attorneys, and all persons acting by, through, or in concert with any of them
21 from using Deckers' intellectual property, including, but not limited to:

22 a. manufacturing, importing, advertising, marketing, promoting,
23 supplying, distributing, offering for sale, or selling the Accused Products or any other
24 products which bear Deckers' Bailey Button Boot Trade Dress and/or any designs
25 confusingly similar thereto;

26 b. manufacturing, importing, advertising, marketing, promoting,
27 supplying, distributing, offering for sale, or selling the Accused Products or any other
28 products which infringe the D599,999 Patent and/or the overall appearance thereof;

1 c. engaging in any other activity constituting unfair competition with
2 Deckers, or acts and practices that deceive consumers, the public, and/or trade,
3 including without limitation, the use of designations and design elements used or
4 owned by or associated with Deckers; and

5 d. committing any other act which falsely represents or which has the
6 effect of falsely representing that the goods and services of Defendant are licensed by,
7 authorized by, offered by, produced by, sponsored by, or in any other way associated
8 with Deckers;

9 3. Ordering Defendant to recall from any distributors and retailers and to
10 deliver to Deckers for destruction or other disposition all remaining inventory of all
11 Accused Products and related items, including all advertisements, promotional and
12 marketing materials therefore, as well as means of making same;

13 4. Ordering Defendant to file with this Court and serve on Deckers within
14 thirty (30) days after entry of the injunction a report in writing, under oath setting forth
15 in detail the manner and form in which Defendant has complied with the injunction;

16 5. Ordering an accounting by Defendant of all gains, profits and advantages
17 derived from its wrongful acts pursuant to 15 U.S.C. § 1117(a) and 35 U.S.C. § 289;

18 6. Awarding Deckers all of Defendant's profits and all damages sustained by
19 Deckers as a result of Defendant's wrongful acts, and such other compensatory
20 damages as the Court determines to be fair and appropriate;

21 7. Awarding treble damages in the amount of Defendant's profits or
22 Deckers' damages, whichever is greater, for willful infringement;

23 8. Awarding applicable interest, costs, disbursements and attorneys' fees;

24 9. Awarding Deckers punitive damages in connection with its claims under
25 California law; and

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