

UNITED STATES DISTRICT COURT
SOUTHERN DISTRICT OF FLORIDA
CASE NO.

SHASHI, LLC, a Florida)
limited liability company,)
)
Plaintiff,)
)
vs.)
)
THIRTY THREE THREADS, INC.,)
a California Corporation)
)
)
Defendant.)
_____)

COMPLAINT

Plaintiff, Shashi, LLC ("Plaintiff"), by and through undersigned counsel, hereby files its Complaint against Thirty Three Threads, Inc. ("Defendant") and alleges as follows:

JURISDICTION AND VENUE

1. This is an action for injunctive and other relief under the patent laws of the United States, 35 U.S.C. §101, et seq., for design patent infringement. This is also an action for injunctive and other relief under the Federal Trademark Act, 15 U.S.C. §1051, et seq. ("Lanham Act"), particularly 15 U.S.C. §1125(a), for trade dress infringement and unfair competition. Plaintiff also asserts claims in accordance with common law rights, Fla. Stat. §495.161, for trade dress infringement and unfair competition.

2. This Court has jurisdiction over this action pursuant to 28 U.S.C. §§1331, 1338(a) and 1338(b). This Court also has jurisdiction pursuant to 15 U.S.C. §1121 and the doctrine of

supplemental jurisdiction, as set forth in 28 U.S.C. §1367.

3. Venue is proper under 28 U.S.C. §§1391(b) the wrongful acts committed by Defendant occurred in the Southern District of Florida, and a substantial part of the events or omissions giving rise to the claim occurred therein, or a substantial part of the property that is the subject of the action is situated therein.

4. Upon information and belief, jurisdiction is proper in that:

- a. Defendant has operated, conducted, engaged in, or carried on a business venture in this State, and the Southern District of Florida, from which this action arises, within the meaning of Fla. Stat. §48.193(1)(a);
or
- b. Defendant has committed tortious acts within this State, and the Southern District of Florida, including the infringement set forth herein, within the meaning of Fla. Stat. §48.193(1)(b); or
- c. Defendant has engaged in substantial and not isolated activity within this state, and the Southern District of Florida, within the meaning of Fla. Stat. §48.193(2).

THE PARTIES

5. Plaintiff is a limited liability corporation organized and existing under the laws of the State of Florida, and having an address at 2701 NW 2nd Avenue, Suite 101, Boca Raton, Florida 33431.

6. Upon information and belief, Defendant is a corporation organized and existing under the laws of the State of California, and having an address at 1330 Park Center Drive, Vista, California 92081.

FACTUAL BACKGROUND

7. Since approximately November, 2010, Plaintiff has been in the business of designing, causing to be manufactured, marketing, promoting, offering for sale, distributing and selling fitness apparel, namely a proprietary line of fitness socks that are particularly suited for use during Pilates, yoga, and barre workouts sold under the registered trademark "SHASHI®".

8. The SHASHI® socks include a closed or split-toe configuration, have a unique mesh top panel, and a novel arrangement of slip-resistant grip dots on the bottom of the sock.

9. Plaintiff has invested considerable time, creative effort, and resources to create its exclusive and innovative socks, and develop goodwill in the SHASHI® socks.

PLAINTIFF'S PATENT AND TRADE DRESS RIGHTS

10. Plaintiff is the owner of U.S. Design Patent No. D664,349 ("the '349 Patent") which was duly and lawfully issued on or about July 31, 2012, for the ornamental design for its innovative sock, as shown and described therein (all collectively hereafter the "patented design"). Plaintiff is also the owner of U.S. Design Patent No. D812,892 ("the '892 Patent") which was duly and lawfully

issued on or about March 20, 2018, for the ornamental design for its innovative sock, as shown and described therein ("all collectively hereafter the "patented design"). See Composite Exhibit A hereto.

11. Plaintiff's unique patented design and appearance in and of the SHASHI® socks is recognizable as the style and work and trade dress of Plaintiff. Plaintiff's trade dress consists of an overall look or commercial impression resulting from the arbitrary selection and combination of certain non-functional features, namely, in an ankle-length grip sock, a semi-opaque or partially transparent mesh panel disposed on the top surface of the sock which is made of a sheer fabric dissimilar to that of the remainder of the sock (all collectively hereafter "Plaintiff's Product Trade Dress"). In alternative embodiments, the Plaintiff's Product Trade Dress may further incorporate a field of rhinestones adorning the mesh panel (further incorporated into "Plaintiff's Product Trade Dress). Examples of Plaintiff's Product Trade Dress are attached as composite Exhibit B.

12. Prior to the acts of Defendant complained of herein, Plaintiff adopted and used in commerce its distinctive Product Trade Dress for its SHASHI® socks. Such use has been continuous since its inception.

13. Since prior to the infringing acts of Defendant complained of herein, Plaintiff has achieved significant commercial

success and substantial sales, advertising, and promotion of its socks utilizing Plaintiff's Product Trade Dress, throughout the State of Florida and the United States, including the Southern District of Florida.

14. By virtue of its unique style and continuous and widespread use, and since prior to the infringing acts of Defendant complained of herein, Plaintiff's Product Trade Dress has developed a secondary meaning and significance, and has been readily recognizable as distinguishing Plaintiff's goods from the goods of others.

DEFENDANT'S INFRINGING ACTIVITY

15. Upon information and belief, at least as early as 2018, Defendant began manufacturing, marketing, and selling competing and infringing socks designed for the Pilates, yoga, and barre industry.

16. Defendant has engaged in, and it is believed will continue to engage in a deliberate and willful scheme to trade upon and to misappropriate for itself the vast goodwill represented and symbolized by the Plaintiff's Product Trade Dress, and to infringe upon and utilize the design shown in the '349 Patent and the '892 Patent, all without Plaintiff's consent thereof.

17. The acts of Defendant complained of herein constitute willful and intentional infringement of Plaintiff's Product Trade Dress and rights in and to the '349 Patent and the '892 Patent, and

are in total disregard of Plaintiff's rights, and were commenced and it is believed will continue.

18. Upon information and belief, subsequent to the issuance of the '349 Patent and the '892 Patent, and the original sales of goods by or on behalf of Plaintiff embodying Plaintiff's patented and trade dress design, Defendant commenced and has continued making, importing, using, selling, and/or offering for sale, within the Southern District of Florida and elsewhere, unauthorized socks utilizing and embodying the patented and trade dress design described and claimed in the '349 Patent, the '892 Patent, and Plaintiff's Product Trade Dress (the "Infringing Socks"). Sample photographs of the Infringing Socks are attached as Composite Exhibit C.

19. Particularly, through its sub-brand Tavi Noir, Defendant has offered for sale a sock under the name "MADDIE" which infringes at least the '349 Patent, the '892 Patent, and Plaintiff's Product Trade Dress (further incorporated into "the Infringing Socks").

20. Additionally, through its sub-brand ToeSox, Defendant has offered for sale a sock under the name "LUNA" which infringes at least Plaintiff's Product Trade Dress (further incorporated into "the Infringing Socks").

21. Defendant's unauthorized sales of the Infringing Socks and related marketing activities commenced long after substantial sales in commerce of authorized goods by Plaintiff embodying

Plaintiff's patented design, Plaintiff's Product Trade Dress, and subsequent to the acquisition of rights and secondary meaning in Plaintiff's Product Trade Dress accruing to Plaintiff.

22. Defendant's aforesaid use of the Infringing Socks is designed and is calculated and is likely to cause confusion, to cause mistake, and to deceive current and prospective customers as to the origin or sponsorship of Defendant's goods and to falsely cause the consuming public to believe that Defendant's goods are the goods of Plaintiff, or are sponsored, licensed, authorized, or approved by Plaintiff, all to the detriment of Plaintiff, the trade, and the public.

23. Defendant commenced its infringing activities described herein without the consent of Plaintiff, in deliberate, knowing, and wanton disregard of the rights of Plaintiff and to Plaintiff's irreparable damage, unless restrained by this Court.

COUNT I - DESIGN PATENT INFRINGEMENT of the '349 Patent

24. Plaintiff incorporates herein each and every allegation set forth in Paragraphs 1 through 23 as if fully set forth herein.

25. Defendant's aforesaid acts, including the unauthorized manufacture, import, use, sales, and/or offering for sale of goods embodying the design shown in the '349 Patent, constitute infringement of and/or inducement to infringe the '349 Patent, directly and/or under the doctrine of equivalents.

26. Defendant's aforesaid acts have deprived Plaintiff of

sales that Plaintiff otherwise would have made.

27. Defendant's aforesaid acts have caused and will cause great and irreparable injury to Plaintiff, and unless said acts are restrained by this Court, they will be continued and Plaintiff will continue to suffer great and irreparable injury.

28. Plaintiff has no adequate remedy at law.

COUNT II - DESIGN PATENT INFRINGEMENT of the '892 Patent

29. Plaintiff incorporates herein each and every allegation set forth in Paragraphs 1 through 23 as if fully set forth herein.

30. Defendant's aforesaid acts, including the unauthorized manufacture, import, use, sales, and/or offering for sale of goods embodying the design shown in the '892 Patent, constitute infringement of and/or inducement to infringe the '892 Patent, directly and/or under the doctrine of equivalents.

31. Defendant's aforesaid acts have deprived Plaintiff of sales that Plaintiff otherwise would have made.

32. Defendant's aforesaid acts have caused and will cause great and irreparable injury to Plaintiff, and unless said acts are restrained by this Court, they will be continued and Plaintiff will continue to suffer great and irreparable injury.

Plaintiff has no adequate remedy at law.

COUNT III - FALSE DESIGNATION, DESCRIPTION, AND REPRESENTATION UNDER THE LANHAM ACT, 15 U.S.C. §1125(a) - PRODUCT TRADE DRESS

33. Plaintiff incorporates herein each and every allegation

set forth in Paragraphs 1 through 23 as if fully set forth herein.

34. Subsequent to Plaintiff's establishment of its rights in Plaintiff's Product Trade Dress, Defendant intentionally commenced to use in commerce, and upon information and belief, will continue to use in commerce the Infringing Socks which are a reproduction, copy, and colorable imitation of the Plaintiff's Product Trade Dress, despite Plaintiff's prior use thereof and the public recognition thereof, constituting use in commerce of a word, term, name, symbol, or device, or combination thereof, or a false designation of origin, false or misleading description of fact, or a false or misleading representation of fact that is likely to cause confusion, or to cause mistake, or to deceive as to affiliation, connection, or association with Plaintiff, or origin, sponsorship, or approval of Defendant's goods by Plaintiff.

35. Defendant's aforesaid acts constitute unfair competition, false designation of origin, and/or false description or representation in violation of §43(a) of the Lanham Act, 15 U.S.C. §1125(a).

36. Defendant's aforesaid acts have harmed Plaintiff's reputation, severely damaged Plaintiff's goodwill, and upon information and belief, have diverted sales from Plaintiff.

37. Defendant's aforesaid acts have caused and will continue to cause great and irreparable injury to Plaintiff, and unless said acts are restrained by this Court, they will be continued and

Plaintiff will continue to suffer great and irreparable injury.

38. Plaintiff has no adequate remedy at law.

**COUNT IV - UNFAIR COMPETITION/COMMON LAW TRADE
DRESS INFRINGEMENT OF PRODUCT TRADE DRESS**

39. Plaintiff incorporates herein each and every allegation set forth in Paragraphs 1 through 23 as if fully set forth herein.

40. Defendant's aforesaid acts constitute infringement, misappropriation, and misuse of Plaintiff's Product Trade Dress, unfair competition, palming-off and passing-off against Plaintiff, and unjust enrichment of Defendant, all in violation of Plaintiff's rights at common law and under the law of the State of Florida in accordance with Fla. Stat. §495.161.

41. Defendant's acts have harmed Plaintiff's reputation, severely damaged Plaintiff's goodwill, and upon information and belief, have diverted sales from Plaintiff.

42. Defendant's aforesaid acts have caused and will continue to cause great and irreparable injury to Plaintiff, and unless said acts are restrained by this Court, they will be continued and Plaintiff will continue to suffer great and irreparable injury.

43. Plaintiff has no adequate remedy at law.

WHEREFORE, Plaintiff prays:

A. That this Court will adjudge that the '349 Patent and the '892 Patent are valid, enforceable, and have been infringed as a direct and proximate result of the acts and/or inducement of

Defendant as set forth herein, in violation of Plaintiff's rights under 35 U.S.C. §101, et seq.

B. That Plaintiff's Product Trade Dress has been infringed as a direct and proximate result of the acts of Defendant as set forth herein, in violation of Plaintiff's rights under the Lanham Act, 15 U.S.C. §1051 et seq., and the common law and under the law of the State of Florida in accordance with Fla. Stat. §495.161.

D. That this Court will adjudge that Defendant has competed unfairly with Plaintiff as set forth in this Complaint, in violation of Plaintiff's rights under the Lanham Act, 15 U.S.C. §1125(a), and the common law.

E. That Defendant, and all officers, directors, agents, servants, employees, attorneys, successors, and assigns, and all persons in active concert or participation therewith, be permanently enjoined and restrained from further infringing manufacture, use, sale, offer for sale and import of the Infringing Socks, and all other infringements of the '349 Patent and the '892 Patent.

F. That Defendant, and all officers, directors, agents, servants, employees, attorneys, successors, and assigns, and all persons in active concert or participation therewith, be permanently enjoined and restrained from further infringing manufacture, use, sale, offer for sale, and import of the Infringing Socks, and all other designs likely to be confused with

or infringe Plaintiff's Product Trade Dress described herein.

G. That Defendant be required to deliver up for destruction all Infringing Socks, and other written or printed material in the possession or control of Defendant which embody or bear the Infringing Socks, and all plates, molds, matrices, and other means from making the aforesaid items.

H. That Defendant be directed to file with this Court and to serve upon Plaintiff within ten (10) days after service of the injunction issued in this action, a written report, under oath, setting forth in detail the manner of compliance with the above.

I. That Plaintiff recover damages adequate to compensate for the Defendant's patent infringement, but in no event less than a reasonable royalty for the use made of the patented design by Defendant, and in addition to the amount of actual damages found, such sums shall be in an amount three (3) times the amount of the actual damages found.

J. That in addition thereto, Plaintiff have and recover the profits of Defendant derived from the use of the infringing designs under the '349 Patent and the '892 Patent, pursuant to 35 U.S.C. § 289.

K. That Plaintiff recover the Defendant's profits and the damages of Plaintiff arising from Defendant's acts of trade dress infringement and unfair competition, pursuant to 15 U.S.C. §1117.

L. That Plaintiff have and recover, pursuant to the laws of

the State of Florida, and common law, in addition to its actual damages, punitive damages in an amount which the Court deems just and proper.

M. That Plaintiff have and recover both pre-judgment and post-judgment interest on each and every damage award.

N. That the Court find this case to be exception and award Plaintiff its reasonable attorney fees incurred in this action, pursuant to 15 U.S.C. §1117, 35 U.S.C. §285, and as otherwise authorized.

O. That Plaintiff have and recover its taxable costs and disbursements herein, pursuant to 15 U.S.C. §1117, and as otherwise authorized.

P. That Plaintiff have and recover such further relief as the Court may deem just and proper.

JURY DEMAND

Plaintiff demands a trial by jury as to all issues triable of right by a jury.

Respectfully submitted,

Dated: April 16, 2018
Miami, Florida

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