

UNITED STATES DISTRICT COURT
SOUTHERN DISTRICT OF NEW YORK

<p>BH BRAND, INC.</p> <p>Plaintiff,</p> <p>v.</p> <p>ELAN-POLO, INC., d/b/a ELAN POLO INTERNATIONAL.</p> <p>Defendant.</p>
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Civil Action No.

(JURY TRIAL DEMANDED)

COMPLAINT

Plaintiff BH Brand, Inc. (“BH Brand” or “Plaintiff”), by its attorneys, hereby complains of Defendant Elan-Polo, Inc. (d/b/a Elan Polo International, hereinafter “Elan Polo” or “Defendant”) as follows:

JURISDICTION AND VENUE

1. This is an action for patent infringement arising under the Patent Laws of the United States, 35 U.S.C. §101 *et seq.*; for trademark infringement and unfair competition under Section 43 of the Lanham Act, 15 U.S.C. §1125; and for unfair competition under the law of the State of New York. This Court has jurisdiction over the federal claims of this action pursuant to 28 U.S.C. §1331, 28 U.S.C. §1338, and 15 U.S.C. §1121, and has jurisdiction over the state claims under 28 U.S.C. §1338(b) and further pursuant to its supplemental jurisdiction under 28 U.S.C. §1367. The state claims asserted herein are so related to the federal claims as to form part of the same case or controversy.

2. This action arises from Defendant's use, sale, offer for sale, and/or importing of products, and conduct of activities, that infringe Plaintiff's design patent and trade dress.

3. This Court has personal jurisdiction over Defendant in that Defendant has engaged in acts constituting doing business in the State of New York, including in this judicial district and have intentionally directed their tortious activities toward the State of New York, including this judicial district. Defendant has committed acts of intellectual property infringement in New York, including this judicial district, and have delivered the accused products into the stream of commerce with the expectation that they will be purchased by consumers in the State of New York, including this judicial district. Defendant has sold products, including products that are the subject of this Complaint, to consumers in the State of New York, including this judicial district.

4. Venue is proper in this Court, pursuant to 28 U.S.C. §§1391(b) - (d) and 28 U.S.C. §1400(b), in that Defendant is a corporation subject to personal jurisdiction within this judicial district and has committed acts of patent infringement in this judicial district.

THE PARTIES

5. Plaintiff BH Brand, Inc. (“Plaintiff” or “BH Brand”) is a corporation organized and existing under the laws of the State of New York, and having a principal place of business located at 10 W 33rd St, New York, New York 10001.

6. Upon information and belief, Defendant Elan Polo is a corporation organized and existing under the laws of Missouri and having a principal place of business at 2005 Walton Road, Overland, MO 63114.

7. Upon information and belief, Elan Polo makes, uses, offers for sale, sells, imports and/or distributes footwear and shoe products in the United States, including products sold in this judicial district.

FACTS

**PLAINTIFF’S PATENT
AND TRADE DRESS**

8. BH Brand is a company which specializes in the design, development, advertisement, promotion, and sale of shoe products (“BH Brand’s Products”).

9. Plaintiff’s unique and innovative shoe products are well known throughout the United States and foreign countries as a result of the popular products that Plaintiff has designed, introduced, and commercialized in interstate and international commerce.

10. On December 2, 2014, United States Design Patent No. D718,517 S, entitled “Shoe” was duly and lawfully issued to Plaintiff for its inventions by the United States Patent and Trademark Office (hereafter “the ‘517 patent”). A copy of the ‘517 patent is attached as Exhibit 1 hereto.

11. Plaintiff has used its patent on a wide variety of shoes sold in interstate commerce, and has generated extensive revenue from the sale of goods using its patented designs.

12. Plaintiff has invested significant time, funds, and effort into its products.

13. As a result of Plaintiff’s efforts and promotional, advertising, and marketing activities, Plaintiff’s product designs have become widely known throughout the United States and worldwide.

14. Plaintiff sells its shoe products throughout the United States.

15. Attached as Exhibit 2 hereto are images showing an example of Plaintiff’s shoe products.

16. Plaintiff has expended significant time, funds, and effort in designing developing, promoting, marketing and popularizing aesthetically appealing and attractive product designs for its line of shoe products.

17. Plaintiff is the owner of all right, title and interest in and to the trade dress rights associated with its shoe products.

18. As a result of Plaintiff's substantial effort and investment in designing, developing, promoting, advertising and marketing its shoes, consumers throughout the United States have come to associate those products with Plaintiff, and Plaintiff's products have become highly regarded amongst the consuming public.

19. The appearance of Plaintiff's products are inherently distinctive symbols which serve as trade dress of Plaintiff in interstate commerce, both in the United States and elsewhere.

20. The appearance of Plaintiff's shoe products has also acquired secondary meaning, and is recognized as identifying Plaintiff's high-quality products.

21. Plaintiff's trade dress and associated intellectual property and goodwill directed to its shoe products, are valuable assets of Plaintiff.

22. Plaintiff's shoe products exhibit its distinctive and characteristic product design. Specifically, and as further identified and depicted in Exhibit 2, the Plaintiff's shoe product configuration trade dress constitutes a shoe having a upper, preferably of mesh and/or neoprene, with an outsole design having a pattern of indentations providing the outer appearance of toes, and curved indentations along the sides (hereinafter, "Plaintiff's Trade Dress").

23. The appearance of the configuration of Plaintiff's shoe products is protectable, distinctive, non-functional trade dress.

**DEFENDANT'S INFRINGEMENT OF
PLAINTIFF'S PATENT AND TRADE DRESS**

24. During the term of the Plaintiff's patent, Defendant has manufactured, offered for sale, sold, used, and/or imported products embodying the patented design of the '517 patent, and engaged in activities infringing the same.

25. In addition to its acts of patent infringement, Defendant has offered for sale, sold, and/or distributed, false, unauthorized copies of Plaintiff's Trade Dress throughout the United States.

26. The unauthorized products that Defendant has offered for sale, sold and/or distributed include but are not limited to products bearing the "Nerf" brand.

27. Attached as Exhibit 3 are images of an example of Defendant's accused product that Defendant has offered for sale, sold and/or distributed, and is continuing to offer for sale, sell, and/or distribute, in interstate commerce in the United States.

28. Defendant's product, shown in Exhibit 3, is a deceptive and confusing knock-off of Plaintiff's intellectual property.

29. Defendant's acts have been without license or authority of Plaintiff.

30. Defendant's bad faith activities have caused and will continue to cause actual deception and confusion, as well as a likelihood of deception and

confusion, in the marketplace among consumers, and extensive damage to Plaintiff and its business, goodwill and reputation.

31. Upon information and belief, Defendant's activities have been deliberate and willful.

32. Defendant has illegally profited from their infringement of Plaintiff's patented design and trade dress.

WILLFUL INFRINGEMENT

33. Upon information and belief, Defendant's activities have been deliberate and willful.

34. Upon information and belief, Defendant is aware of Plaintiff's designs, and has deliberately chosen to use, sell, and offer for sale, products intended to copy or imitate those designs.

35. Upon information and belief, Defendant is also aware of the Plaintiff's trade dress, and has deliberately chosen to offer for sale and sell highly similar products intended to cause confusion with Plaintiff's trade dress.

36. Defendant's actions have caused and are causing irreparable damage to Plaintiff.

37. Plaintiff has been damaged by Defendant's bad faith activities and will continue to be damaged unless Defendant is restrained and enjoined by this Court.

38. Plaintiff has no adequate remedy at law.

39. Plaintiff has been damaged by Defendant's illegal actions in an amount to be determined by a jury and this Court, including recovery and relief for Plaintiff's lost sales, lost profits, and damage to its reputation and good will, and/or a disgorgement of Defendant's revenues and profits.

COUNT I
PATENT INFRINGEMENT
(35 U.S.C. §101 et seq.)

40. Plaintiff repeats and re-alleges each and every allegation contained in the preceding paragraphs as if fully set forth herein.

41. This claim arises under 35 U.S.C. §101 et seq.

42. This Court has jurisdiction over this claim pursuant to 28 U.S.C. §1331.

43. Defendant's acts constitute infringement of the '517 patent, under 35 U.S.C. §271 et seq.

44. Upon information and belief, Defendant's acts of infringement were and are willful and deliberate.

45. Defendant has profited from their infringing activities.

46. As a result of Defendant's conduct, Plaintiff has been substantially harmed, and has suffered actual damages, including lost profits, and has been forced to retain legal counsel and pay costs of court to bring this action.

COUNT II
LANHAM ACT TRADEMARK INFRINGEMENT
AND UNFAIR COMPETITION
(15 U.S.C. §1125(a))

47. Plaintiff repeats and re-alleges each and every allegation contained in the preceding paragraphs, as if fully set forth herein.

48. This claim arises under the Lanham Act, 15 U.S.C. §1051 et seq.

49. This Court has jurisdiction over this claim pursuant to 28 U.S.C. §1331.

50. Defendant is intentionally using trade dress which is confusingly similar to Plaintiff's trade dress directed to shoe products in a manner that has caused and is likely to cause confusion, or to cause mistake, or to deceive as to the affiliation, connection, or association of Defendant with Plaintiff, or as to the origin, sponsorship, or approval of Defendant's goods by Plaintiff.

51. Defendant's activities, in selling and offering for sale products with trade dress which is confusingly similar to Plaintiff's trade dress, constitute unfair competition, false designation of origin, and false description and representations, and false advertising, in violation of Section 43(a) of the Lanham Act, 15 U.S.C. §1125(a).

52. Defendant's acts of infringement were and are willful and deliberate.

53. Defendant has profited from its illegal and bad faith activities.

54. Plaintiff has suffered, and continues to suffer, substantial damages as a result of Defendant's bad faith activities, in an amount to be determined by the jury and this Court.

**COUNT III
UNFAIR COMPETITION UNDER NEW YORK LAW**

55. Plaintiff repeats and re-alleges each and every allegation contained in the preceding paragraphs, as if fully set forth herein.

56. This claim arises under the common law of the State of New York.

57. This Court has jurisdiction over this claim pursuant to 28 U.S.C. §1367.

58. Plaintiff has created and promoted its product designs and packaging, including its trade dress, through extensive time, labor, skill and money.

59. Defendant has misappropriated the results of that labor and skill and those expenditures of Plaintiff.

60. Defendant has used designs that are confusingly similar to Plaintiff's in competition with Plaintiff, gaining an unfair advantage, because Defendant bore little or no burden of expense of development and promotion of those goods.

61. By knowingly using a confusingly similar product trade dress to compete against Plaintiff's goods, Defendant has also misappropriated a commercial advantage belonging to Plaintiff.

62. Defendant has also engaged in bad faith misappropriation of the labors of Plaintiff which is likely to cause confusion, and to deceive purchasers as to the origin of the goods.

63. Defendant's actions have caused significant commercial damage to Plaintiff.

64. Defendant's conduct is illegal and actionable under the common law of unfair competition of the State of New York.

65. Plaintiff has been injured by Defendant's illegal actions and is entitled to the remedies provided under New York law.

DAMAGES

66. Plaintiff is being irreparably harmed by Defendant's infringing activities, and has no adequate remedy at law.

67. Plaintiff has been extensively damaged by Defendant's intellectual property infringement in an amount to be determined by a jury and this Court.

68. Plaintiff seeks damages as a result of Defendant's infringement which include, but are not limited to: Plaintiff's lost sales, lost profits, damage to its reputation and good will and any and all other damages to

Plaintiff recoverable by law; and/or disgorgement of Defendant's revenues and profits from Defendant's sales of infringing products, associated parts thereof, and from conveyed sales, and any and all other advantages gained by Defendant from its infringing activities.

69. Plaintiff requests that this honorable Court assess enhanced damages against Defendant in the fullest amount permissible by law, including, but not limited to, treble damages under federal law and punitive damages under New York law, in view of the willful, egregious, malicious, and extensive nature of Defendant's bad faith activities complained of herein, and in view of the numerous violations, the willful nature of the violations, and the significant damage to Plaintiff, as set forth above.

JURY TRIAL DEMAND

70. Pursuant to Rule 38, Fed. R. Civ. P. Plaintiff hereby demands a trial by jury on all issues set forth herein that are properly triable to a jury.

PRAYER FOR RELIEF

WHEREFORE, Plaintiff respectfully requests that the Court, upon final hearing of this matter, grant the following relief against Defendant:

- A. That Defendant be adjudged to have engaged in patent infringement of Plaintiff's rights under U.S. Design Patent No. D718,517 S ("the '517 patent"), under 35 U.S.C. §101 *et seq.*;
- B. That Defendant be adjudged to have engaged in federal unfair

competition and trade dress infringement under Section 43 of the Lanham Act, 15 U.S.C. §1125;

- C. That Defendant be adjudged to have engaged in unfair competition and trademark infringement under the common law and statutory law of the State of New York.
- D. That the '517 patent, is duly and legally issued by the U.S. Patent Office, and is valid and enforceable;
- E. That Defendant, its officers, agents, servants, employees, representatives, distributors and all persons in concert or participation with Defendant be enjoined pursuant to 35 U.S.C. §283 from engaging in any activities which infringe Plaintiff's rights in the patent under 35 U.S.C. §271;
- F. That Defendant, its officers, agents, servants, employees, representatives, distributors and all persons in concert or participation with Defendant be preliminarily and permanently enjoined from engaging in any activities, including but not limited to making, using, importing, offering for sale and selling any products which infringe Plaintiff's rights in its Products, and/or advertising materials, including Plaintiff's rights in its trade dress;
- G. That Defendant, its officers, agents, servants, employees,

representatives, distributors, and all persons in concert or participation with Defendant be preliminarily and permanently enjoined from offering for sale, selling or marketing merchandise that tends in any way to deceive, mislead or confuse the public into believing that Defendant's merchandise in any way originates with, is sanctioned by, or is affiliated with Plaintiff;

- H. That Defendant, its officers, agents, servants, employees, representatives, distributors, and all persons in concert or participation with Defendant be preliminarily and permanently enjoined from otherwise competing unfairly with Plaintiff;
- I. That Defendant, its officers, agents, servants, employees, representatives, distributors, and all persons in concert or participation with Defendant be preliminarily and permanently enjoined from engaging in further acts of misrepresentation regarding Plaintiff and Plaintiff's products;
- J. That Defendant, its officers, agents, servants, employees, representatives, distributors, and all persons in concert or participation with Defendant be preliminarily and permanently enjoined from engaging in further deceptive and unfair business practices with respect to Plaintiff;
- K. That Defendant, its officers, agents, servants, employees,

representatives, distributors, and all persons in concert or participation with Defendant be preliminarily and permanently enjoined from engaging in further acts infringing Plaintiff's rights under New York law;

- L. That Defendant, its officers, agents, servants, employees, representatives, distributors, and all persons in concert or participation with them be ordered to provide a complete and full accounting of any and all U.S. and worldwide sales of the products accused in this Complaint, and/or products violating Plaintiff's rights.
- M. That Defendant be directed to file with this Court and serve on Plaintiff within thirty (30) days after service of the injunction, a report in writing, under oath, setting forth in detail the manner and form in which the Defendant has complied with the injunction;
- N. That Defendant be required to account for and pay over to Plaintiff any and all revenues and profits derived by it and all damages sustained by Plaintiff by reason of the acts complained of in this Complaint, including an assessment of interest on the damages so computed, and that the damages be trebled, pursuant to Section 35 of the Lanham Act, 15 U.S.C. §1117, as

well as 35 U.S.C. §§284 and 289, and all further applicable state and federal law;

- O. That Plaintiff obtain disgorgement of Defendant's profits and advantages attributable to or derived from the acts complained of in this Complaint in accordance with all applicable law and/or equity.
- P. That Defendant be required to account for and pay over to Plaintiff such actual damages as Plaintiff has sustained as a consequence of Defendant's infringement, in the amount of Plaintiffs' lost profits and/or a reasonable royalty, and that the damages relating to patent infringement be trebled pursuant to 35 U.S.C. §284, and to account for and pay to Plaintiff all of Defendant's gains, revenues, profits and advantages attributable to or derived by Defendant's infringement, pursuant to 35 U.S.C. §289, and all further applicable state and federal law;
- Q. That each such award of damages be enhanced to the maximum available for each infringement in view of Defendant's willful infringement of Plaintiff's rights;
- R. That Defendant be required to deliver up for impoundment during the pendency of this action, and for destruction

thereafter, all copies of the infringing materials in its possession or under its control and all materials, including molds and master models, used for making same;

- S. That Plaintiff be awarded punitive or exemplary damages under New York law because of the egregious, malicious, and tortious conduct of Defendant complained of herein;
- T. That Plaintiff recover the costs of this action including its expenses and reasonable attorney's fees pursuant to 15 U.S.C. §1117, 35 U.S.C. §285 and all further applicable state and federal law, because of the deliberate and willful nature of the infringing activities of Defendant sought to be enjoined hereby, which make this an exceptional case warranting such award;
- U. That Plaintiff be awarded pre-judgment and post-judgment interest;
- V. That Plaintiff obtain all further relief permitted under the laws of the United States and the State of New York; and,
- W. That Plaintiff obtain all such other and further relief as the Court may deem just and equitable.

Dated: November 24, 2015

/s/ Morris E. Cohen

Morris E. Cohen (MC-4620)
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