UNITED STATES DISTRICT COURT
DISTRICT OF DELAWARE

STEVEN MADDEN, LTD.,	:	
Plaintiff,	:	C.A. No. 19-cv-1509-LPS
vs.	:	JURY TRIAL DEMANDED
ROTHY'S, INC.,	:	
Defendant.	:	

SECOND AMENDED COMPLAINT FOR DECLARATORY JUDGMENT

Plaintiff Steven Madden, Ltd. ("Madden" or "Plaintiff"), by and through its counsel Farnan LLP, Debevoise & Plimpton LLP, and Amster, Rothstein & Ebenstein, LLP, for its Second Amended Complaint against Defendant Rothy's, Inc. ("Rothy's" or "Defendant"), alleges as follows:

NATURE OF THE ACTION

1. This is a declaratory judgment action arising under the Declaratory Judgment Act, 28 U.S.C. §§ 2201 *et. seq.*, the Patent Act, 35 U.S.C. §§ 1, *et seq.*, and the Trademark Act, 15 U.S.C. §§ 1051 *et seq.*

2. As discussed herein, this action arises out of a substantial, immediate, and real controversy between the parties based on threats that Rothy's has made against Madden regarding Rothy's alleged patent and trademark rights relative to certain Madden footwear.

3. In a bad faith attempt to stifle legitimate competition in the footwear industry, Rothy's threatened to sue Madden for patent and trade dress infringement in connection with Madden's sale of its "Rosy Flat" shoe. Specifically, Rothy's has alleged infringement of three design patents, namely, U.S. Design Patent Nos. D831,325 ("the '325 Patent"), D844,313 ("the

’4,313 Patent”), and D831,313 (“the ’1,313 Patent”), (collectively, the “Asserted Patents,” true and correct copies of which are respectively attached as Exhibits A-C). Rothy’s also referred to the Asserted Patents to define an alleged trade dress for “The Point” shoe, which is depicted in Exhibit D. Rothy’s defined The Point shoe trade dress as “our client’s signature pointed toe flat with its distinctive pointed toe and vamp, seamless 3D knitted upper, slim profile, sleek outsole” (hereinafter, the “Point trade dress”). *See* Exhibit D, p. 5.

4. Rothy’s assertions that Madden infringes Rothy’s patents are entirely baseless and without merit. Indeed, Rothy’s design patents do not cover Rothy’s own footwear, let alone Madden’s Rosy Flat shoe. The design patents are directed toward, *inter alia*, the ornamental design of a flat ballet slipper having a flat, wide-bodied profile. By stark contrast, Madden’s Rosy Flat shoe does not have the appearance of a flat ballet slipper, nor does it have a wide-bodied profile. While there are many other differences as well, this difference alone leads to the inescapable conclusion that no ordinary observer comparing the Rosy Flat shoe to the Asserted Patents would believe that the two designs are substantially similar. Rothy’s threat to sue Madden for patent infringement is reckless and made in bad faith.

5. Although The Point shoe is not covered by the Asserted Patents, Rothy’s nevertheless marks The Point shoe with such patents on its website. Such conduct violates 35 U.S.C. § 292 since Rothy’s falsely marks The Point shoe for the purpose of deceiving the public (including Madden) into believing that the Asserted Patents preclude it from making, using, offering for sale, and selling footwear having a design corresponding to The Point shoe. Madden has suffered a competitive injury as a result of Rothy’s false marking of its products with its patents and seeks recovery of damages adequate to compensate Madden for its injury.

6. Rothy's asserted trade dress claims are equally without merit. Rothy's has no federal trade dress registration, nor can it establish that it has any trade dress rights in The Point shoe. To define a protectable claim for product configuration trade dress, Rothy's must allege (1) a precise expression of the character and scope of the claimed trade dress for which it claims trade dress protection or how any of the claimed features are distinctive; (2) facts that demonstrate that the claimed trade dress is non-functional; and (3) facts that demonstrate that the claimed trade dress has secondary meaning.

7. Rothy's cannot meet this burden. Specifically, Rothy's failed to offer a precise expression of the character and scope of the specific features for which it claims trade dress protection or how any of the claimed features are distinctive. Instead, Rothy's merely defines its alleged trade dress in The Point shoe as covering generic features, such as a "pointed toe and vamp, seamless 3D knitted upper, slim profile, sleek outsole." *See* Exhibit D, p. 5. Rothy's description of its alleged trade dress is of the type federal courts have specifically condemned. *See, e.g., Eliya, Inc. v. Steven Madden, Ltd.*, 749 F. Appx. 43 (2d Cir. 2018).

8. Of course, those features are not, and cannot possibly be, distinctive and acquire secondary meaning. They are common features of shoes sold throughout the marketplace. For example, a pointed toe and vamp are ubiquitous in women's shoes, and Rothy's attempt to snatch these features from the public domain and obtain exclusive rights to them through trade dress protection, if successful, would undermine restrictions in copyright and patent law that are designed to avoid monopolization of these designs.

9. Making matters worse, Rothy's takes an inconsistent stance with how it defines its trade dress, resulting in claims to ownership of multiple trade dresses. Its trade dress definitions are litigation-driven, changing from litigation to litigation. In this regard, Rothy's has

already brought lawsuits against two other competitors, JKM Technologies, LLC and Giesswein Walkwaren AG. In each lawsuit, Rothy's has changed its trade dress definition in an attempt to cover the accused product, resulting in three different trade dress definitions that are all tied to the same patents and apply to similar products.

10. Rothy's has also failed to overcome the statutory presumption of functionality that attaches to a non-registered trade dress. Indeed, the pointed toe and vamp in The Point trade dress are functional features because, *inter alia*, they help the user put and keep the shoe on. These features also function to provide a certain aesthetic to the shoe.

11. This declaratory judgment action is required because Rothy's assertions are baseless and will impact Madden's ability to sell its accused Rosy Flat shoe. Rothy's reckless assertion of its intellectual property rights against Madden must immediately be stopped.

12. Madden seeks declarations that its products, including the Rosy Flat shoe, do not infringe the Asserted Patents or The Point trade dress, that Rothy's lacks any protectable trade dress rights in The Point shoe, that Madden does not infringe such alleged trade dress rights, and that Rothy's has suffered no, and will not suffer any, cognizable damages or loss of goodwill because of Madden's production and sale of the Rosy Flat shoe and similar products. Madden also seeks a declaration that Rothy's falsely marks its products with patents that do not cover the same.

THE PARTIES

13. Madden is a business entity organized under the laws of the State of Delaware having a principal place of business at 52-16 Barnett Avenue, Long Island City, New York, 11104.

14. Upon information and belief, Rothy's is a corporation organized and existing under the laws of the State of Delaware and has its principal place of business in California.

JURISDICTION AND VENUE

15. This action arises under the Trademark and Patent Laws of the United States, 15 U.S.C. §§ 1051 *et seq*. and 35 U.S.C. §§ 1 *et seq*., and seeks a specific remedy based upon the laws authorizing actions for declaratory judgment in the courts of the United States, 28 U.S.C. §§ 2201 and 2202. This Court has subject matter jurisdiction over this action pursuant to 28 U.S.C. §§ 2201, 1331 and 1338(a).

16. This Court has personal jurisdiction over Rothy's because, *inter alia*, it is incorporated in Delaware.

17. Venue is proper in this District because, *inter alia*, Rothy's, a Delaware corporation, resides in this District. *See* 28 U.S.C. § 1391(b)(1).

18. An actual case or controversy exists between the parties and is currently ripe for adjudication in this District. Rothy's has sent a cease and desist letter to Madden, threatening legal action. Rothy's has also sent similar cease and desist letters raising many of the same patent and trade dress infringement claims to multiple other companies, and followed up in two such circumstances by suing two other companies for virtually the same alleged patent and trademark infringement as Rothy's has alleged against Madden. *See Rothy's, Inc. v. JKM Technologies, LLC et al.*, Civ. No. 3:18-cv-00067 (W.D. Va. Aug. 16, 2018); *Rothy's, Inc. v. Giesswein Walkwaren AG*, Civ. No. 5:19-cv-03071 (N.D. Cal. June 3, 2019).

19. The contents of the letter to Madden are substantially similar to the subject matter of the lawsuits that Rothy's has filed against JKM Technologies and Giesswein: the letter asserts that Madden's production and sale of the Rosy Flat shoe infringes multiple design patents held

by Rothy's (many of which Rothy's has also asserted against JKM Technologies and Giesswein in the pending litigations), and also promotes confusion among consumers as to the source or origin of those flats. Rothy's has generally asserted that Madden is engaging in acts of patent infringement, federal trade dress infringement, dilution and misappropriation, and has demanded that Madden immediately cease and desist from producing or selling its Rosy Flat shoe and similar products.

20. Madden's products, including the Rosy Flat shoe, do not infringe the Asserted Patents or alleged The Point trade dress, and the alleged The Point trade dress is, in any event, not protectable.

21. Rothy's demands and its underlying assertions of patent and trademark infringement threaten injury to Madden, have created a reasonable apprehension of litigation, and have placed a cloud over Madden's rights to continue producing and selling its flat.

FACTS

22. Madden provides on-trend footwear, handbags and accessories to women and men. Madden products are sold worldwide in over 80 countries. Madden was founded in 1990 by its founder Steve Madden and prides itself as a company with vision that is on the cutting edge of trends. This continued vision has led Madden to become a true lifestyle and destination brand for footwear, handbags, and accessories.

Defendant's Design Patents

23. The Asserted Patents are directed towards two different designs.

24. The first design is covered by the '4,313 Patent and '1,313 Patent (collectively, the "Group 1 Patents"), which all claim a flat ballet slipper having a flat, wide-bodied profile with a rounded toe design, among other things.

25. The second design is covered by the ’325 Patent and does not claim any toe design. Rather, the ’325 Patent covers a design in which a band is provided above the heel of the shoe, wherein the band is a different color than the rest of the shoe.

26. As discussed herein, the Rosy Flat shoe is substantially different from and does not infringe the Group 1 and the ’325 Patents.

The Group 1 Patents

27. As discussed above, the Group 1 Patents include the ’4,313 Patent and ’1,313 Patent. Both patents cover the same shoe design, except that the ’4,313 Patent disclaims (by dashed lines) certain features as part of the design (e.g., the sole).

The ’4,313 Patent

28. Upon information and belief, Rothy’s is the owner of the ’4,313 Patent, filed on September 6, 2018 and issued on April 2, 2019. The ’4,313 Patent claims priority to a chain of patents, whose parent was filed on December 18, 2014.

29. The ’4,313 Patent claims protection over “the ornamental design for a portion of a shoe, as shown and described” in the ’4,313 Patent. (*See* Exhibit B). This design focuses only on the basic shape of the shoe upper.

30. As shown in Figures 5 and 6 of Exhibit B (reproduced below), the claim of the ’4,313 Patent is limited to, *inter alia*, a flat ballet slipper having a flat, wide-bodied profile with a rounded toe, similar to a narrow parabola:

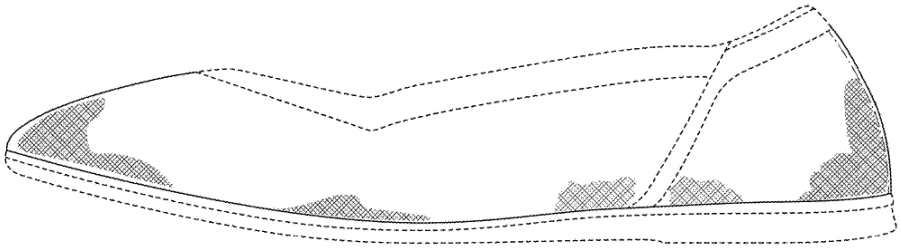


FIG. 5

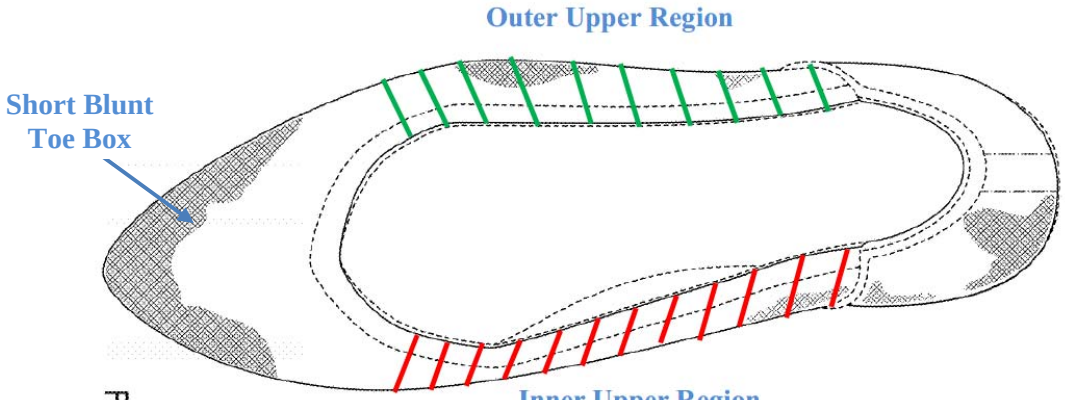


FIG. 6

31. As shown by the green and red cross-hatching added to Figure 6, the shoe flares outwardly from the upper towards the sole, thereby creating regions referred to herein as the "Inner Upper Region" and the "Outer Upper Region." The Inner Upper Region and the Outer Upper Region give the claimed shoe an overall wide-bodied flat appearance.

32. As also shown in Figure 6 of Exhibit B, as part of the flat wide-bodied profile, the shoe has a short, blunt toe box.

The '1,313 Patent

33. Upon information and belief, Rothy's is the owner of the '1,313 Patent, filed on October 20, 2017 and issued on October 23, 2018. The '1,313 Patent claims priority to a chain of patents, whose parent was filed on December 18, 2014.

34. The ’1,313 Patent claims protection over “the ornamental design for a shoe, as shown and described.” (*See* Exhibit C). The ’1,313 Patent claims a first embodiment depicted in Figures 1-7 of Exhibit C, as well as a second embodiment depicted in Figures 8-14 of Exhibit C. As shown in Figures 6 and 13 of Exhibit C (reproduced below), the claims of both embodiments are limited to, *inter alia*, a shoe with the same rounded toe claimed in the ’4,313 Patent. Also, as in the ’4,313 Patent, both embodiments in the ’1,313 Patent have a flat wide-bodied profile with the same Outer Upper Region, Inner Upper Region, and short, blunt toe box. The ’1,313 Patent appears to be narrower in scope than the ’4,313 Patent because it claims additional features of the shoe such as the sole, a mid-sole and added ornamentation on the upper.

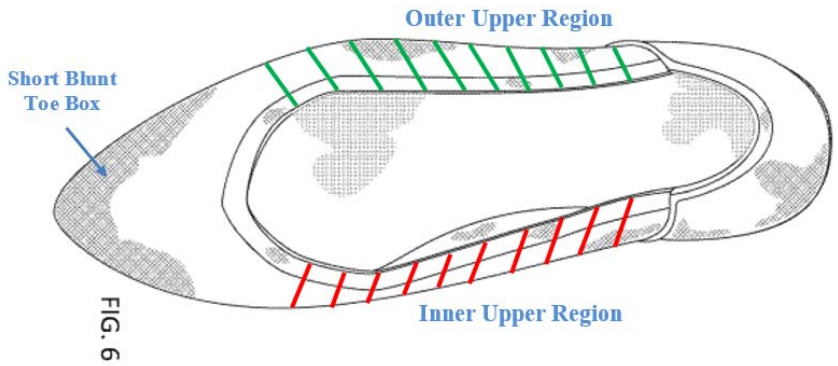


FIG. 6

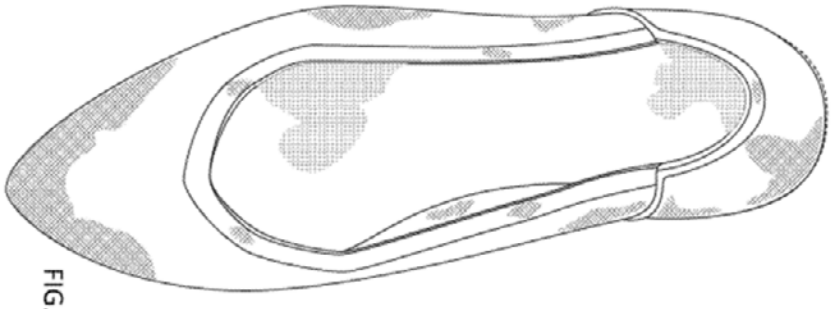


FIG. 13

35. The primary difference between the two embodiments in the ’1,313 Patent is that the first embodiment covers the sole and heel of the shoe (*see* Figure 5, Exhibit C), whereas the

second embodiment does not since these components are drawn with dashed lines (*see* Figure 12, Exhibit C). The first embodiment, as shown below in Figure 5, also includes a mid-sole.

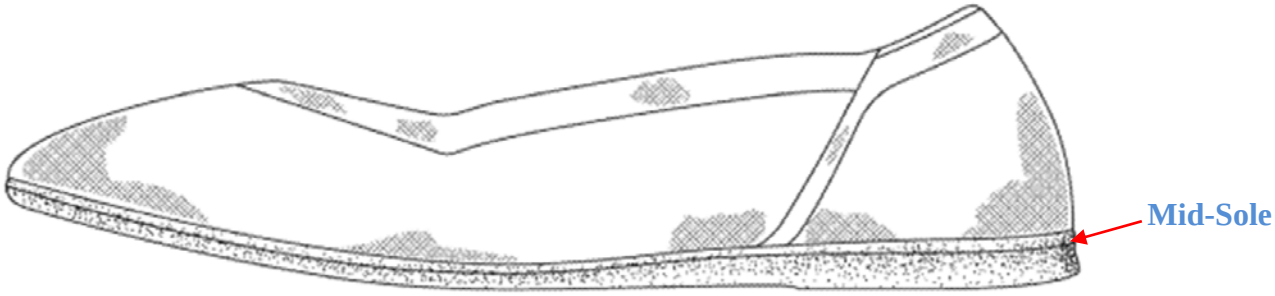


FIG. 5

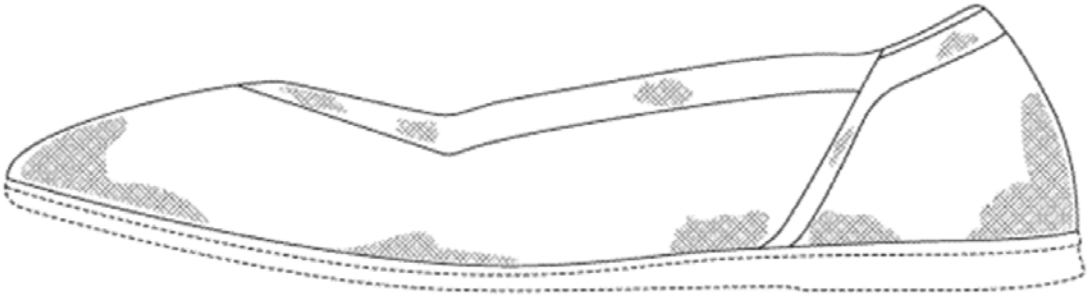


FIG. 12

36. Further, in the first embodiment as shown in Figure 7 of Exhibit C below, the bottom of the sole and heel have a coiled pattern that repeats in a series of rows.

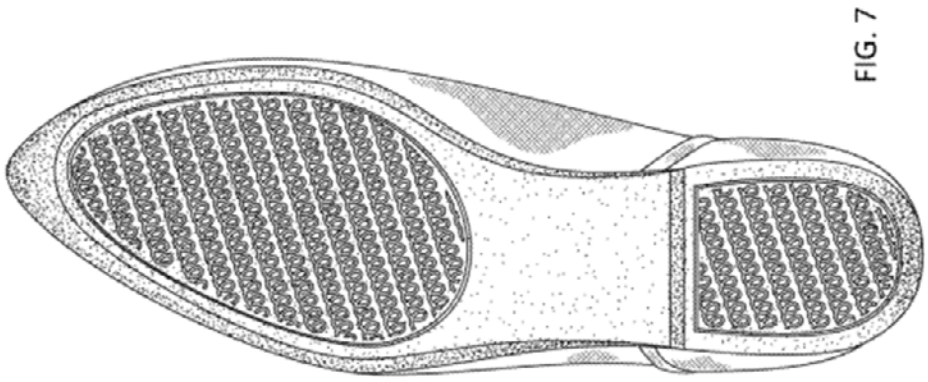


FIG. 7

The ’325 Patent

37. Upon information and belief, Rothy’s is the owner of the ’325 Patent, filed on October 17, 2017 and issued on October 23, 2018. The ’325 Patent claims priority to a chain of patents, whose parent was filed on December 18, 2014.

38. The ’325 Patent claims protection over “the ornamental design for a shoe, as shown and described” in the ’325 Patent. (*See* Exhibit A).

39. The claim in the ’325 Patent is limited to the precise shoe features that are drawn in the patent in solid black lines as shown below:

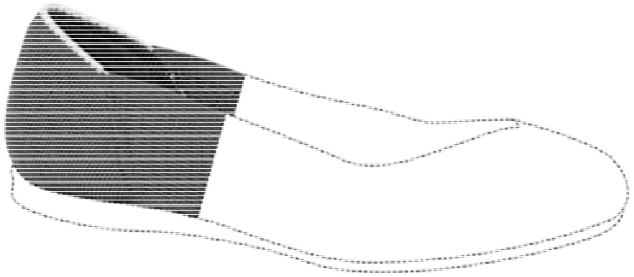


FIG. 1

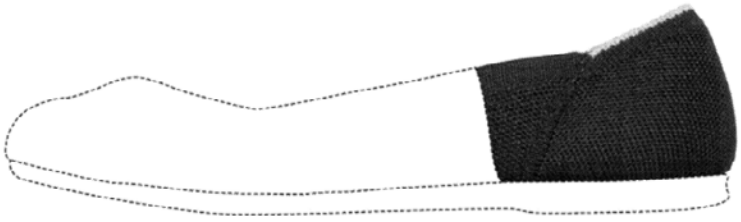
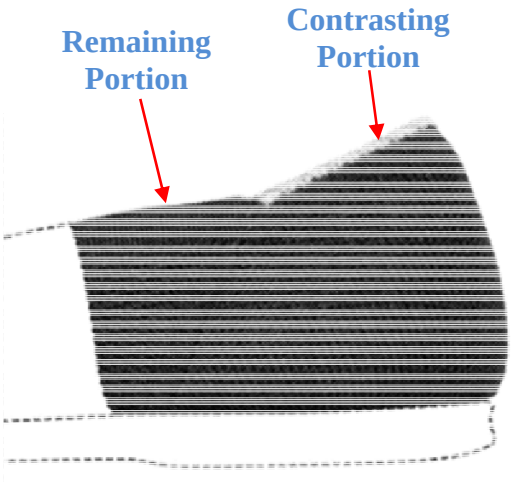


FIG. 5

40. As shown in the above drawings, the remainder of shoe is drawn in dashed lines. Thus, the ’325 Patent only covers the rear upper of the shoe.

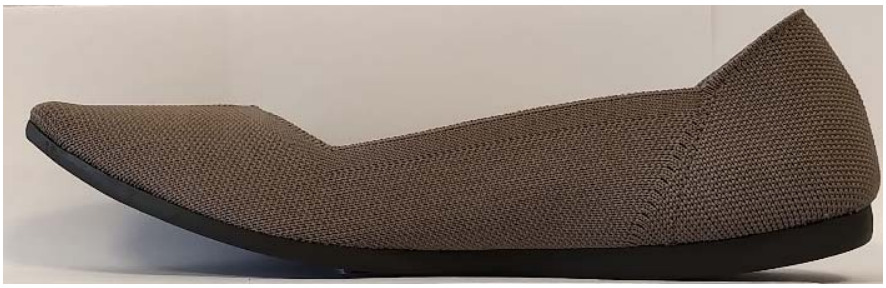
41. As indicated in the patent, “[t]he Figures include a contrasting portion, which is designated to show that the portion can be any color, and in particular, a color different than the remaining portion of the shoe in the Figures.” (*Id.*).

An excerpt of Figure 5 is annotated below to show the contrasting portion:



The Dispute Over Madden's Rosy Flat Shoe

42. Madden recently began selling the Rosy Flat shoe. Top, side, and bottom views of the Rosy Flat shoe are shown in the photographs below:



43. On August 2, 2019, counsel for Rothy's sent a notice letter (the "Notice Letter") to Madden, claiming ownership of "intellectual property rights . . . partly evidenced by United States Design Patents Nos. D768,366, D804,156, D831,325, D833,729, D836,314, D831,313, and D844,313, along with numerous other design patents and trademark registrations worldwide. (All of the foregoing collectively referred to herein as the 'Rothy's Intellectual Property.')." (*See* Exhibit D).

44. The Notice Letter accused the Rosy Flat shoe of infringing "the Rothy's Intellectual Property, including without limitation, Rothy's design patent and trade dress rights in Rothy's 'The Point.'" (*Id.* at 4.) As set forth above, Rothy's defined The Point trade dress as "our client's signature pointed toe flat with its distinctive pointed toe and vamp, seamless 3D knitted upper, slim profile, sleek outsole." (*Id.*) There are at least five problems with these allegations.

Non-Infringement of the Asserted Patents

45. ***First***, Rothy's accuses the Rosy Flat shoe of infringing the Group 1 Patents (which claim a rounded toe portion shaped like a narrow parabola). The Rosy Flat shoe does not infringe the Group 1 Patents because it does not have the flat, wide-bodied profile claimed in this Group. As shown in the below comparison, the Rosy Flat shoe does not have the claimed Inner Upper Region at all. Indeed, the Inner Side of the Rosy Flat shoe is so narrow that it tapers

inward such that it cannot even be seen from a top view. By contrast, the Inner Upper Region in Figure 6 of the '4,313 Patent, common to all Group 1 Patents, is so wide that it flares outward and is readily visible from a top view. Similarly, the Outer Side of the Rosy Flat shoe has a very narrow width and tapers inward, whereas the Outer Upper Region in Figure 6 of the '4,313 Patent is much wider and flares outward. (*See* Exhibit B).

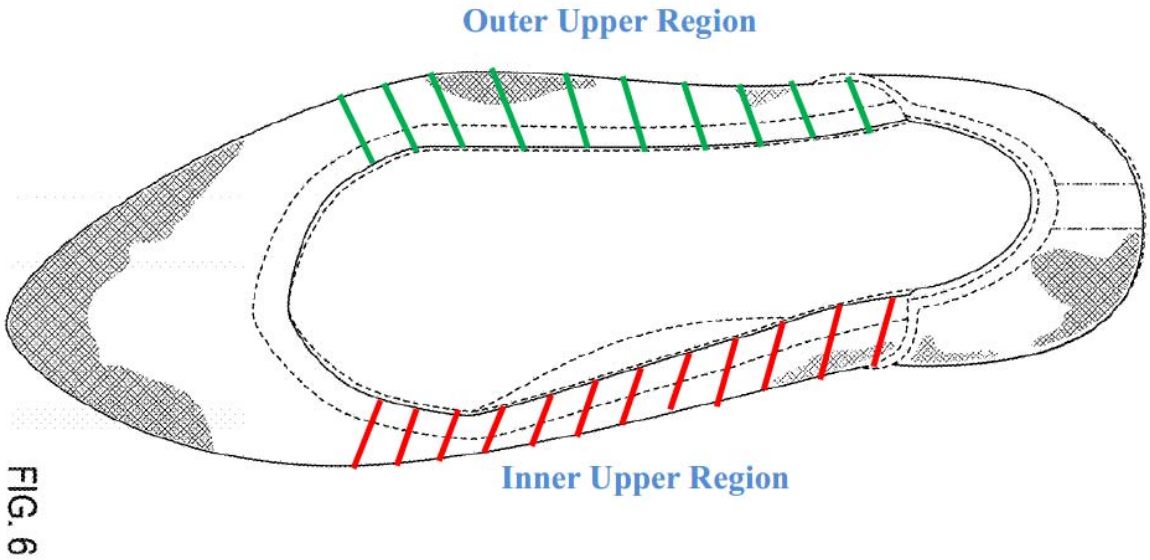
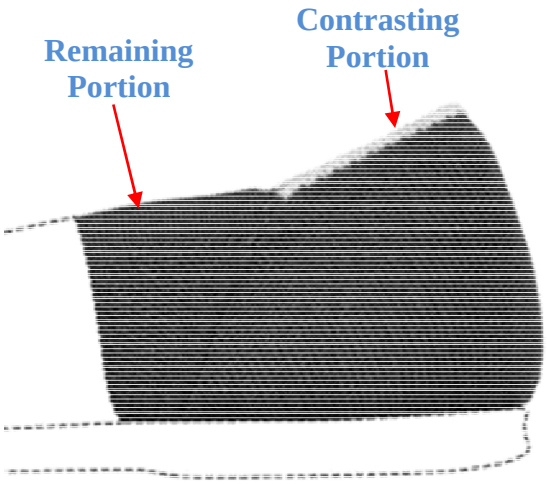


FIG. 6

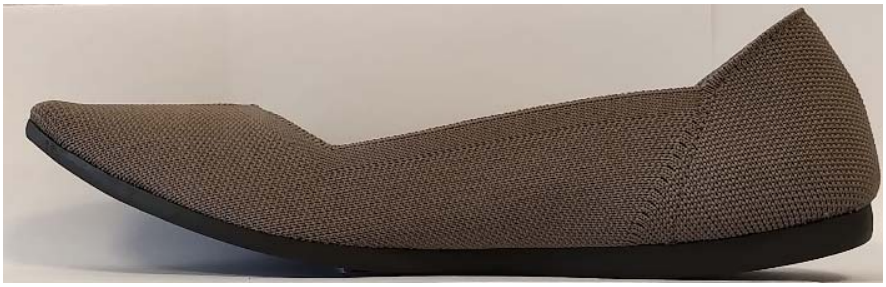
46. Moreover, the toe portion in the Rosy Flat is much narrower, longer, and has a sharper point, whereas the toe portion claimed in the Group 1 Patents is wider and has a blunt, parabola-shaped tip.

47. As a result of these and other differences, the Rosy Flat shoe cannot infringe the Group 1 Patents because in the eye of an ordinary observer, giving such attention as a purchaser usually gives, the Group 1 Patents are not substantially the same and as such the resemblance is not such to deceive such an observer inducing him or her to purchase one supposing it to be the other. *Egyptian Goddess Inc. v. Swisa, Inc.*, 543 F.3d 665, 670 (Fed. Cir. 2008).

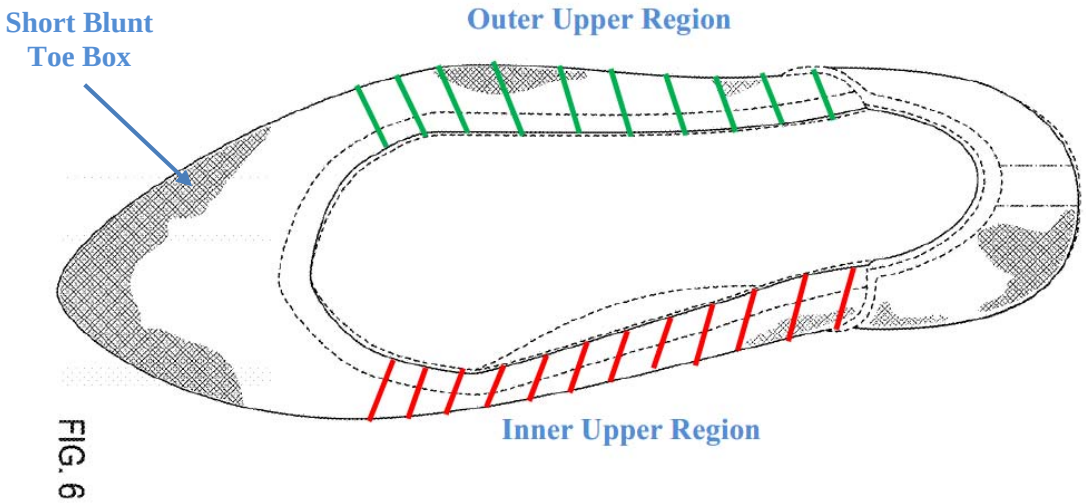
48. ***Second***, Rothy's contends that the Rosy Flat shoe infringes the '325 Patent, which requires a band around the upper perimeter of the heel that has a color that differs from the colors in the rest of the shoe, as shown in Figure 5 (excerpted from Exhibit A and annotated below):



49. However, as shown below, this claim is without merit since there is no colored band around the upper edge of the heel of the Rosy Flat shoe. There is no contrasting portion that differs from the color of the rest of the shoe.



50. ***Third***, The Point shoe is not covered by the Group 1 Patents, yet Rothy's marks The Point shoe with such patents on its website, as shown in the webpages from Rothy's website attached as Exhibit E. The Point shoe does not have at least the flat, wide-bodied configuration claimed in the Group 1 Patents. Indeed, as shown in the below comparison, The Point shoe is much narrower and does not include regions that flare outward from the side of the shoe, nor does it include the short blunt toe box of these patents:



51. Such conduct constitutes false patent marking under 35 U.S.C. § 292, since Rothy's marks The Point shoe with the Group 1 Patents for the purpose of deceiving the public (including Madden) into believing that such patents preclude it from making, using, offering for sale, and selling footwear having a design corresponding to The Point shoe. Madden has suffered

a competitive injury as a result of Rothy's false marking of its products with its patents and seeks recovery of damages adequate to compensate Madden for its injury.

52. ***Fourth***, Rothy's does not and cannot define a protectable trade dress. To define a protectable claim for product configuration trade dress, Rothy's must allege (1) a precise expression of the character and scope of the claimed trade dress for which it claims trade dress protection or how any of the claimed features are distinctive; (2) facts that demonstrate that the claimed trade dress is non-functional; and (3) facts that demonstrate that the claimed trade dress has secondary meaning. Rothy's cannot meet any of these requirements.

53. Rothy's definition of the Point trade dress is "our client's signature pointed toe flat with its distinctive pointed toe and vamp, seamless 3D knitted upper, slim profile, sleek outsole" (Exhibit D at 4), but that does not come close to the required precise expression of the character and scope of the specific features for which it claims trade dress protection or how any of the claimed features are distinctive.

54. Instead, to define its trade dress, Rothy's uses vague, categorical descriptions of features that could apply to any ballet flat. For example, Rothy's claims that its trade dress includes a "distinctive pointed toe and vamp," without explaining what makes the pointed toe and vamp distinctive or how these features are distinctive. Of course, there is no plausible explanation since these features have been included in shoes sold in the marketplace for many decades. For example, the ASOS flat has a pointed toe, pointed vamp, a slim profile and sleek outsole:

See https://us.asos.com/asos-design/asos-design-levels-high-vamp-ballet-flats-in-black-snake/prd/11620589 (last visited August 20, 2019).

55. The "slim profile" and a "sleek outsole" claimed in The Point trade dress are likewise so broad and vague that the consumer has no clue what portions of the shoe these descriptions cover. Of course, these are generic descriptions that cannot possibly be protectable by trade dress since so many other women's shoes in the marketplace would fit this description.

56. Rothy's likewise cannot legitimately claim exclusive rights over any seamless 3D knitted upper since this technology is widespread in the marketplace and is not unique to Rothy's products.

57. As further evidence that Rothy's has not and cannot proffer a precise expression of the character and scope of the specific features for which it claims trade dress protection or how any of the claimed features are distinctive, Rothy's ties the definition of The Point trade dress to all of the Asserted Patents, including the narrow parabola shaped portion claimed in the Group 1 Patents, as illustrated by the drawings included with each of the Group 1 Patents. This

is the epitome of a trade dress claim that is neither specific in scope nor in character, and it certainly is not distinctive.

58. As even further evidence that Rothy's has not and cannot proffer a precise expression of the character and scope of The Point trade dress, The Point trade dress definition is litigation induced, as it is inconsistent with the trade dress definitions Rothy's proffers in the pending Virginia and California litigations.

59. In particular, Rothy's has already brought lawsuits against two other competitors, JKM Technologies, LLC and Giesswein Walkwaren AG in Virginia and California, respectively. In each lawsuit, Rothy's has changed its trade dress definition to apply to each accused product, resulting in three different trade dress definitions that are all tied to several of the same patents as well as to similar products.

60. Here, because the accused Rosy Flat shoe has a pointy toe and vamp, Rothy's defines the allegedly infringed Rothy's trade dress as a "distinctive pointed toe and vamp, seamless 3D knitted upper, slim profile, sleek outsole." (Exhibit D at 4.) Rothy's then ties its asserted trade dress to all seven of its patents, some of which are directed to a shoe having a toe that is relatively pointy, as well as other patents that are directed to a shoe having a rounded toe. (*Id.*)

61. In the JKM case, because the accused shoe has a rounded toe and pointed vamp, Rothy's offers a different trade dress definition to cover the rounded toe shape (instead of a pointed toe as asserted against Madden): "the signature round toe with a distinctive pointed vamp, seamless 3D knitted upper, slim profile and sleek outsole." Rothy's tied this trade dress to some of the same patents that it used to define the trade dress asserted against Madden.

62. In the Giesswein Walkwaren case, the most recent case filed, because the accused shoe has a rounded and not a pointed vamp, Rothy's offers a third and different trade dress definition that seeks to cover a vamp having any shape (instead of the pointed vamp asserted against Madden and JKM). Rothy's uses the same definition from the JKM case, but simply changes the vamp description from "distinctive pointed vamp" to just "distinctive vamp": "the signature round toe, seamless 3D knitted upper with distinctive vamp, slim profile and sleek outsole." Once again, Rothy's tied this trade dress to some of the same patents that it used to define the trade dress asserted against Madden.

63. In all, Rothy's has concocted three different trade dress definitions, resulting in claims to three different trade dresses seeking to cover almost all of the women's shoes it sells, all drawn from the same group of patents and having several of the same patents in common. These litigation-driven trade dress definitions further show that Rothy's has not and cannot offer a precise expression of the character and scope of the specific features for which it claims trade dress protection.

64. Rothy's also cannot meet its burden of overcoming the statutory presumption that its asserted trade dress is functional. A product feature has a utilitarian functionality "'if it is ***essential to the use or purpose*** of the article or if it affects the cost or quality of the article.'" *Sweet Street Desserts, Inc. v. Chudleigh's Ltd.*, 655 Fed. Appx. 103, 109 (3d Cir. 2016) (quoting *TrafFix Devices, Inc. v. Marketing Displays, Inc.*, 532 U.S. 23, 32 (2001)) (emphasis added). A feature is ***aesthetically functional*** if the right to use it exclusively would "put competitors at a significant non-reputation-related disadvantage that would restrict competition in the market." *Id.* (internal quotations omitted). Here, The Point trade dress claims functional features that fall under both categories.

65. For example, the claimed seamless 3D upper aids in putting and keeping the shoe on the wearer, and also makes the shoe easier to manufacture. A 3D knitted upper is also aesthetically functional. This knitting process creates the value sought to be gained from purchasing the shoe, including being comfortable, lightweight, and breathable. Thus, such features are essential to the use or purpose of the shoe and directly affect its cost and quality and cannot be used to comprise part of a protectable trade dress.

66. The pointed toe and vamp likewise function to help put the shoe on and keep it on, and are also aesthetically functional. Similarly, the claimed "slim profile" and "sleek outsole" both provide The Point shoe and any shoe of that type with a slim fit for ample flexibility.

67. Rothy's also cannot meet its burden of proving that The Point trade dress has acquired secondary meaning. As a product configuration, Rothy's The Point trade dress cannot be inherently distinctive, and Rothy's has the burden to show that its trade dress has acquired distinctiveness through secondary meaning—that in the minds of the public, the primary significance of the trade dress is to identify the source of the product rather than the product itself. *Wal-Mart Stores v. Samara Bros.*, 529 U.S. 205, 216 (2000).

68. On information and belief, The Point shoe was launched less than five years ago, which is not enough time to acquire any secondary meaning. Also, the generic design in question of a pointed toe and vamp is but one of only a few available options to manufacturers of flat-style shoes. In short, the toe and vamp can only be pointed or rounded. The extremely limited combinations of these designs pre-date the formation of Rothy's company by at least half a century. Accordingly, no facet of Rothy's generic methodology—both in manufacturing nor

resultant appearance—is a design novelty in an industry that has been making shoes with these features for many years.

69. Rothy's notice letter points to a series of articles that discuss its footwear products and unsolicited media coverage. However, none of these articles establish that consumers are able to distinguish "The Point" from any other similar shoe.

70. Simply put, The Point trade dress does not claim any protectable features and is not infringed.

71. Rothy's allegations of patent and trademark infringement against Madden, which Madden denies, have created a substantial, immediate, and real controversy between the parties as to the enforceability of Rothy's claimed trade dress rights and non-infringement of the Asserted Patents and Rothy's alleged The Point trade dress. A valid and justiciable case or controversy thus has arisen and exists between Madden and Rothy's within the meaning of 28 U.S.C. § 2201. A judicial determination is necessary to determine Rothy's trade dress rights and the issue of non-infringement. A judgment would serve a useful purpose in settling the legal issues, and a judgment would resolve the controversy and offer relief from uncertainty.

COUNT I
(Declaration That Madden Does Not Infringe the '325 Patent)

72. Madden incorporates by reference as if fully set forth herein the averments contained within the preceding paragraphs 1 through 71, inclusive.

73. Based on the differences between the '325 Patent design and the Madden Rosy Flat shoe, no ordinary observer could possibly be deceived into thinking that the Rosy Flat shoe design was the same shoe design as in the '325 Patent.

74. In view of the foregoing, Madden seeks a declaratory judgment that the Rosy Flat shoe does not infringe the '325 Patent.

COUNT II
(Declaration That Madden Does Not Infringe the ’4,313 Patent)

75. Madden incorporates by reference as if fully set forth herein the averments contained within the preceding paragraphs 1 through 74, inclusive.

76. Based on the differences between the ’4,313 Patent design and the Madden Rosy Flat shoe, no ordinary observer could possibly be deceived into thinking that the Rosy Flat shoe design was the same shoe design as in the ’4,313 Patent.

77. In view of the foregoing, Madden seeks a declaratory judgment that the Rosy Flat shoe does not infringe the ’4,313 Patent.

COUNT III
(Declaration That Madden Does Not Infringe the ’1,313 Patent)

78. Madden incorporates by reference as if fully set forth herein the averments contained within the preceding paragraphs 1 through 77, inclusive.

79. Based on the differences between the ’1,313 Patent design and the Madden Rosy Flat shoe, no ordinary observer could possibly be deceived into thinking that the Rosy Flat shoe design was the same shoe design as in the ’1,313 Patent.

80. In view of the foregoing, Madden seeks a declaratory judgment that the Rosy Flat shoe does not infringe the ’1,313 Patent.

COUNT IIV
(Declaration That Defendant Lacks Protectable, Valid Trade Dress Rights in The Point Shoe Design)

81. Madden incorporates by reference as if fully set forth herein the averments contained within the preceding paragraphs 1 through 80, inclusive.

82. Rothy’s has no protectable trade dress in The Point shoe.

83. In view of the foregoing, Madden seeks a declaratory judgment that Rothy's lacks any protectable trade dress rights in the design of The Point shoe.

COUNT V
(Declaration that Madden Does Not Infringe Defendant's Purported Trade Dress Rights in The Point Shoe Design)

84. Madden incorporates by reference as if fully set forth herein the averments contained within the preceding paragraphs 1 through 83, inclusive.

85. Madden's sale of the Rosy Flat shoe does not and cannot infringe any protectable trade dress rights in The Point shoe.

86. This Court thus should declare that Madden has not infringed Rothy's alleged trade dress rights.

COUNT VI
(False Patent Marking)
(35 U.S.C. § 292.)

87. Madden incorporates by reference as if fully set forth herein the averments contained within the preceding paragraphs 1 through 86, inclusive.

88. Rothy's has marked The Point with patents, including but not limited to the Group 1 Patents, that it knows do not cover The Point in order to (and with an intent to) deceive the public, including Madden, into suffering a competitive injury.

89. The foregoing acts of Rothy's have violated 35 U.S.C. § 292, which provides for a recovery of damages by Madden to adequately compensate Madden for the amount of the injury.

WHEREFORE, Madden respectfully requests that this Court enter judgment in favor of Madden and against Rothy's, and issue an Order:

A. Declaring that the Rosy Flat shoe does not infringe the '325 Patent;

B. Declaring that the Rosy Flat shoe does not infringe the ’4,313 Patent;

C. Declaring that the Rosy Flat shoe does not infringe the ’1,313 Patent;

D. Declaring that Rothy’s falsely marked The Point shoe with the ’4,313 and ’1,313 Patents and awarding Madden the maximum amount of damages allowed under 35 U.S.C, § 292 and any applicable caselaw;

E. Declaring that Rothy’s lacks trade dress rights in the design of The Point shoe;

F. Declaring that Madden has not infringed any alleged trade dress rights Rothy’s claims in the design of The Point shoe;

G. Declaring that Rothy’s is not entitled to any injunctive relief with respect to Madden’s sale of the Rosy Flat shoe or any of Madden’s similar products, and thus is not entitled to any relief under patent law, the Lanham Act, or any similar state law;

H. Permanently enjoining Rothy’s from asserting to Madden and its current or prospective customers that Madden’s sales of the Rosy Flat shoe constitute infringement of Rothy’s patent rights, including the Asserted Patents;

I. Declaring that this case is exceptional and awarding Madden its attorneys’ fees and cost pursuant 35 U.S.C. § 285 and 15 U.S.C. § 1117(a); and

J. Granting Madden such other and further relief as the Court may deem just and proper.

Plaintiff demands a jury trial.

Dated: November 4, 2019

Respectfully submitted,

FARNAN LLP

/s/ Brian E. Farnan

Brian E. Farnan (Bar No. 4089)
Michael J. Farnan (Bar No. 5165)
919 N. Market St., 12th Floor
Wilmington, DE 19801
Telephone : (302) 777-0300
Fax : (302) 777-0301
bfarnan@farnanlaw.com
mfarnan@farnanlaw.com

OF COUNSEL:

Douglas A. Miro
Benjamin Charkow
AMSTER, ROTHSTEIN & EBENSTEIN LLP
90 Park Avenue
New York, New York 10016
Tel.: (212) 336-8000
Fax: (212) 336-8001
dmiro@arelaw.com
bcharkow@arelaw.com

David H. Bernstein (admitted *pro hac vice*)
Megan K. Bannigan (admitted *pro hac vice*)
Kathryn C. Saba (admitted *pro hac vice*)
DEBEVOISE & PLIMPTON LLP
919 Third Avenue
New York, New York 10022
(212) 909-6000
dhbernstein@debevoise.com
mkbannigan@debevoise.com
ksaba@debevoise.com

Attorneys for Plaintiff Steven Madden, Ltd.