

**UNITED STATES DISTRICT COURT
FOR THE SOUTHERN DISTRICT OF TEXAS
HOUSTON DIVISION**

BERNARDO® FOOTWEAR, L.L.C.,	§	
	§	
Plaintiff,	§	
	§	
- against -	§	Civil Action No. H-06-1613
	§	
BROWN SHOE, J&A SHOE CO.,	§	JURY TRIAL DEMANDED
PAYLESS SHOESOURCE, INC.,	§	
MICHAEL KORS (USA), INC.,	§	
NEW CENTURY FOOTWEAR,	§	
INC., WHITE HOUSE/BLACK	§	
MARKET, INC.,	§	
	§	
Defendant.		

PLAINTIFF'S VERIFIED AMENDED COMPLAINT

Plaintiff Bernardo Footwear, L.L.C. (hereinafter, "Bernardo"), files this complaint against Defendants, Brown Shoe, J&A Shoe Co., Payless ShoeSource, Inc., Schwartz & Benjamin, and White House/Black Market, Inc. (herein, collectively, "Defendants"). Bernardo alleges as follows:

I. PARTIES

1. Plaintiff, Bernardo is a limited liability company organized under the existing laws of the State of Texas and has an office and principal place of business at 9330 West Airport, Suite 190 Houston, Texas 77031. Bernardo is a maker of better grade women's footwear and handbags. Bernardo has its own design and product development team of Dennis and Lynne Comeau who live and work in Florence, Italy. All Bernardo products are conceptually designed, and hand crafted with great attention to detail. A key element to Bernardo's success has been its original designs.

2. Defendant, Brown Shoe, upon information and belief, is a corporation organized under the laws of the State of New York. Brown Shoe is doing business in Texas, and on information and belief, has an office and place of business at 8300 Maryland Avenue, St. Louis, Missouri 63105. Brown Shoe may be served with process by serving its registered agent C T Corporation System 111 Eighth Avenue, New York, New York 10011.

3. Defendant, J&A Shoe Co., upon information and belief, is a corporation organized under the laws of the State of California. J&A Shoe Co. is doing business in Texas, and on information and belief, has a principal place of business at 198 W. 146th St., Gardena, California 90248. J&A Shoe Co. may be served with process by serving its registered agent, Alex Kats 198 W. 146th Gardena, California 90248.

4. Defendant, Payless ShoeSource, Inc., upon information and belief, is a corporation organized under the laws of the State of Kansas. Payless ShoeSource is doing business in Texas, and on information and belief, has a principal place of business at 3231 SE 16th Avenue, Topeka, Kansas 66607. Payless ShoeSource may be served with process by serving its registered agent, Corporation Service Company 701 Brazos Street Suite 1050, Austin, Texas 78701.

5. Defendant, New Century Footwear, Inc., upon information and belief, is a corporation organized under the laws of the State of Delaware. New Century Footwear, Inc. is doing business in Texas, and on information and belief, has a principal place of business at 20 W. 57th Street Ste. 4, New York, New York 10019-3917. New Century Footwear, Inc. may be served with process by serving its registered agent Corporation Service Company 2711 Centerville Road Suite 400 Wilmington, Delaware 19808.

6. Defendant, Michael Kors (USA), Inc., upon information and belief, is a corporation organized under the laws of the State of Delaware. Michael Kors (USA), Inc. is doing business in Texas, and on information and belief, has a principal place of business at 11 W. 42nd St. FRNT 1 New York, New York 10036-8002. Michael Kors (USA), Inc. may be served with process by serving its registered agent, Capitol Corporate Services, Inc. 800 Brazos Suite 1100, Austin, Texas 78701.

7. Defendant, White House/Black Market, Inc., upon information and belief, is a corporation organized under the laws of the State of Florida. White House/Black Market, Inc. is doing business in Texas, and on information and belief, has a principal place of business at 11215 Metro Parkway, Fort Myers, Florida 33912. White House/Black Market may be served with process by serving its registered agent, National Registered Agents, Inc. 1614 Sidney Baker Street, Kerrville, Texas 78028.

II. JURISDICTION AND VENUE

8. This Court has jurisdiction over the subject matter of this action pursuant to 35 U.S.C. § 1 et. seq. and jurisdiction is properly based on Title 35 United States Code, particularly § 271, and title 28 United States Code, particularly § 1338(a).

9. Brown Shoe, upon information and belief, transacts business in this judicial district by manufacturing, selling, and/or offering to sell sandals as described and claimed in United States Patent No. D513,447, the design patent at issue in this lawsuit, and/or by conducting other business in this district.

10. J&A Shoe Co., upon information and belief, transacts business in this judicial district by manufacturing, selling, and/or offering to sell sandals as described and claimed

in United States Patent No. D513,447, the design patent at issue in this lawsuit, and/or by conducting other business in this district.

11. Payless ShoeSource, Inc., upon information and belief, transacts business in this judicial district by manufacturing, selling, and/or offering to sell sandals as described and claimed in United States Patent No. D513,447, the design patent at issue in this lawsuit, and/or by conducting other business in this district.

12. New Century Footwear, Inc., upon information and belief, transacts business in this judicial district by manufacturing, selling, and/or offering to sell sandals as described and claimed in United States Patent No. D513,447, the design patent at issue in this lawsuit, and/or by conducting other business in this district.

13. Michael Kors (USA), Inc., upon information and belief, transacts business in this judicial district by manufacturing, selling, and/or offering to sell sandals as described and claimed in United States Patent No. D513,447, the design patent at issue in this lawsuit, and/or by conducting other business in this district.

14. White House/Black Market, Inc., upon information and belief, transacts business in this judicial district by manufacturing, selling, and/or offering to sell sandals as described and claimed in United States Patent No. D513,447, the design patent at issue in this lawsuit, and/or by conducting other business in this district.

III. FACTS

15. Plaintiff, Bernardo, is the owner and assignee of U.S. Patent No. D513,447 S (Issued January 10, 2006, hereinafter referred to as "the '447 Patent") entitled "Sandal." A copy of the '447 Patent is attached as Exhibit A.

16. Bernardo at all times relevant thereto has had the right to enforce the '447 patent.

17. Bernardo was formed in 1947 for the primary purpose of designing and manufacturing women's footwear and handbags, including the sandal design claimed in the '447 patent. Bernardo garnered worldwide acclaim by offering high quality classic handmade sandals with a contemporary twist at a friendly price.

18. The "Medieval" Sandal, manufactured and sold by Bernardo, embodies the design claimed in the '447 design patent. Attached hereto, as Exhibit B, is a picture of Bernardo's "Medieval" sandal.

19. Bernardo sells its Medieval Sandal and other women's footwear to retail stores throughout the United States and through its own website as well as various resellers' websites. A pair of Medieval Sandals typically retails for \$89.

20. Plaintiff Bernardo is the owner of the '447 Patent and since its issuance in January 2006 has continually had the right to enforce it against infringers.

21. The overall impression conveyed by the Bernardo design that is alleged to embody Bernardo's trade dress is created from the custom fitted ring, leather straps and Lark's Head knot. The ring features a brushed finish which adds an elegant sophistication. The Bernardo style is also known by its unique white stitching that outlines the base of the sandals.

22. Bernardo regularly advertises its footwear and handbags. For the 2005 and 2006 Spring Seasons, Bernardo advertised the "Medieval Sandal" in Vogue Magazine and In Style Magazine. The amount spent on advertising the "Medieval Sandal" for the 2005 and 2006 Spring Seasons was \$96,686.34. Attached hereto, as Exhibit C, is the "Medieval" Sandal advertisement that ran in Vogue Magazine in 2005. Attached hereto,

as Exhibit D, is the "Medieval" Sandal advertisement featured in In Style in 2006. Attached hereto, as Exhibit E, is a spreadsheet and backup invoices showing expenses relating to the "Medieval" Sandal advertising.

23. Mr. Roy R. Smith, President of Bernardo, bought a pair of Franco Sarto "Toll" sandals manufactured by Brown Shoe at a Houston-area Dillard's on April 27, 2006, for \$69.00 plus applicable sales tax. The Toll is equipped with leather straps and an O-ring accent. Upon information and belief, Franco Sarto shoes are available at several retail outlets, including but not limited to Dillard's, Foley's, Lord & Taylor, Marshall Fields, and Macy's West. Attached hereto, as Exhibit F, is a picture of the Franco Sarto "Toll" shoe.

24. Mr. Roy R. Smith, President of Bernardo, bought a pair of Athena Alexander "Ben" sandals manufactured by J&A Shoe Co. at a Houston-area Nordstrom in April 2006, for \$69.95 plus applicable sales tax. Mr. Roy R. Smith also bought a pair of Athena Alexander "Leta" sandals manufactured by J&A Shoe Co. at a Houston-area Nordstrom in July 2006, for \$79.95 plus applicable sales tax. Attached hereto, as Exhibit G, is a picture of the Athena Alexander "Ben" sandal. Attached hereto, as Exhibit H, is a picture of the Athena Alexander "Leta" sandal.

25. Mr. Roy R. Smith, President of Bernardo, bought a pair of Michael Kors "Metallic Thong" sandals manufactured by New Century Footwear, Inc. at Nordstrom in April 2006, for \$330.00 plus applicable sales tax. Upon information and belief, Michael Kors shoes are available at several retail outlets, including but not limited to Neiman Marcus and Saks Fifth Avenue. Attached hereto, as Exhibit I, is a picture of the Michael Kors "Metallic Thong" sandal.

26. Mr. Roy R. Smith, President of Bernardo, bought a pair of “Maris Ring Thong” sandals manufactured by Payless ShoeSource at Payless on April 27, 2006, for \$16.99 plus applicable sales tax. The “Maris Ring Thong” sandal can be bought at Payless ShoeSource stores nationwide. Attached hereto, as Exhibit J, is a picture of the “Maris Ring Thong” sandal.

27. Mr. Roy R. Smith, President of Bernardo, bought a pair of women’s “Ring Thong” sandals manufactured by White House/Black Market from a Houston-area store manager on May 1, 2006. The shoe can be purchased at White House/Black Market stores nationwide. Attached hereto, as Exhibit K, is a picture of the White House/Black Market sandal.

28. Defendants have wrongfully appropriated the ‘447 design and have been manufacturing virtually identical looking sandals to those disclosed and claimed. An ordinary observer would view the Defendants’ sandals and the Bernardo Medieval Sandal or the ‘447 patent as substantially the same and as infringing the ‘447 patent.

29. Upon information and belief, Defendants’ infringing activities have caused and, unless enjoined by this Court, will continue to cause, irreparable injury including loss of sales and profits, which Bernardo would have made but for the infringement by Brown Shoe, J&A Shoe Co., Schwartz & Benjamin, Payless ShoeSource, and White House/Black Market, unless they are enjoined by this Court.

IV. PATENT INFRINGEMENT

30. Plaintiff hereby realleges and incorporates by reference the allegations of paragraphs 1-29 of this Complaint as if fully set forth herein.

31. On January 10, 2006, United States Patent No. D513,447 (the '447 patent) entitled "Sandal" was duly and legally issued. A true and correct copy of the '447 patent is attached as Exhibit A.

32. Pursuant to 35 U.S.C. § 282, the above-listed United States Patent is presumed valid.

33. Dennis Comeau is the inventor of the '447 patent. The '447 patent has been assigned to Bernardo Footwear, L.L.C.

34. Upon information and belief, Brown Shoe has infringed and continues to infringe the claim of the '447 Sandal design patent by its manufacture, use, offer for sale and/or sale of the Franco Sarto "Toll" Sandal.

35. Upon information and belief, J&A Shoe Co. has infringed and continues to infringe the claim of the '447 Sandal design patent by its manufacture, use, offer for sale and/or sale of the Athena Alexander "Ben" and "Leta" Sandals.

36. Upon information and belief, Schwartz & Benjamin has infringed and continues to infringe the claim of the '447 Sandal design patent by its manufacture, use, offer for sale and/or sale of the Michael Kors "Metallic Thong" Sandal.

37. Upon information and belief, White House/Black Market has infringed and continues to infringe the claim of the '447 Sandal design patent by its manufacture, use, offer for sale and/or sale of the Women's Ring Thong Sandal.

38. Upon information and belief, Payless ShoeSource has infringed and continues to infringe the claim of the '447 Sandal design patent by its manufacture, use, offer for sale and/or sale of the "Maris Ring" Thong sandal.

39. As a result of Defendants' actions, Bernardo has suffered and continues to suffer substantial injury, including irreparable injury, and will result in damages to Bernardo, including loss of sales and profits, which Bernardo would have made but for the infringement by Defendants, unless the Defendants are enjoined by this Court.

V. DEMAND FOR JURY TRIAL

40. Plaintiff hereby demands a jury trial on all claims and issues.

VI. PRAYER FOR RELIEF

WHEREFORE, Plaintiff prays for judgment that:

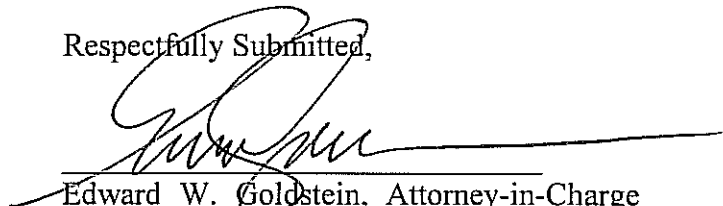
- A. Defendants each be held to have infringed the '447 patent;
- B. Granting a preliminary and permanent injunction restraining Defendants, its officers, directors, principals, agents, servants, employees, successors and assigns, and all individuals acting in concert or participation with them from infringing Bernardo's '447 design patent.
- C. The '447 Patent be declared valid and enforceable against Defendants.
- D. Plaintiff be awarded under 35 U.S.C. § 284, damages adequate to compensate them for Defendants' infringement of the '447 Patent, which in no event can be less than a reasonable royalty.
- E. Plaintiff be awarded its costs and prejudgment interest on their damages, as provided by 35 U.S.C. § 284;
- F. Defendants be required to pay Bernardo's attorneys' fees and court costs;
- G. That the court finds the Defendants' infringement of the '447 patent was willful;

H. That costs be awarded to Plaintiff;

I. That Plaintiff be granted such other and further relief as the Court may deem just and proper under the current circumstances.

Date: 8/15/06

Respectfully Submitted,



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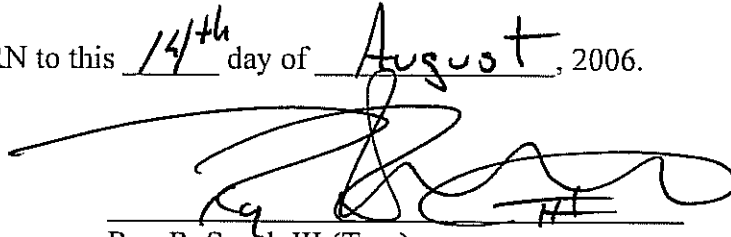
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Attorney(s) for Plaintiff

IX. VERIFICATION

I, Roy R. Smith III (Trae), verify pursuant to 28 U.S.C. § 1746 that I am President of Bernardo Footwear, L.L.C. and that I have read the foregoing Verified Complaint and know the contents thereof to be true based upon my own knowledge, information and belief, except as to such matters therein stated to be on information and belief, and as to those matters, I believe them to be true.

SUBSCRIBED AND SWORN to this 14th day of August, 2006.



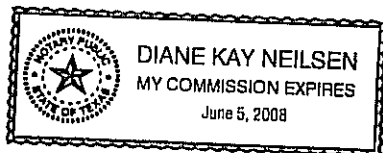
Roy R. Smith III (Trae)

STATE OF TEXAS

§
§
§

COUNTY OF HARRIS

BEFORE ME, the undersigned authority, on this 14th day of August, 2006, personally appeared Roy R. Smith, known to me to be the person whose name is subscribed to the foregoing instrument and acknowledged to me that he executed the same of his own free will for the purposes and consideration therein expressed.





Notary for the STATE OF TEXAS

CERTIFICATE OF SERVICE

The undersigned hereby certifies that all counsel of record who are deemed to have consented to electronic service are being served with a copy of this document via the Court's CM/ECF system per Local Rule CV-5(a)(3) on August 15, 2006. Any other counsel of record will be served by first class U.S. mail.

/s/ Edward W. Goldstein
Edward W. Goldstein