

UNITED STATES DISTRICT COURT
CENTRAL DISTRICT OF ILLINOIS
PEORIA DIVISION

MAUI JIM, INC., an Illinois Corporation,

Plaintiff,

vs.

NYS COLLECTION, LLC,

Defendant.

No.

**MAUI JIM'S COMPLAINT FOR PATENT
INFRINGEMENT OF U.S. DES. PAT.
NO. D481,059 AND DEMAND FOR
JURY TRIAL**

EQUITABLE RELIEF SOUGHT

MAUI JIM'S COMPLAINT AND JURY DEMAND

Plaintiff Maui Jim, Inc. files this Complaint and Jury Demand against Defendant NYS Collection, LLC upon personal knowledge as to its own actions and upon information and belief as to all other matters.

PARTIES

1. Plaintiff Maui Jim, Inc. ("Maui Jim") is an Illinois Corporation with its principal place of business located in Peoria, Illinois.
2. Defendant NYS Collection, LLC ("NYS") is a Delaware Limited Liability Corporation with a principal place of business at 550 39th Street, Brooklyn, New York 11232.

JURISDICTION AND VENUE

3. This Court has subject matter jurisdiction over this action under 28 U.S.C. §§ 1331 and 1338(a).

4. Based upon 28 U.S.C. § 1391, venue is proper in this district because NYS is subject to personal jurisdiction in this district.

5. This Court has personal jurisdiction over NYS because, *inter alia*, NYS has conducted business in this District and has taken other actions that result in jurisdiction over it being proper in this District.

FACTUAL BACKGROUND

6. On August 14, 2002, Walter Hester and Jennifer Egbert filed for patent protection on a new and unique design for sunglasses. Mr. Hester and Ms. Egbert assigned all rights in the design to Maui Jim, Inc.

7. The United States Patent and Trademark Office evaluated Mr. Hester's and Ms. Egbert's new eyewear design and, after considering many prior eyewear designs, determined that Mr. Hester's and Ms. Egbert's design was new and original. Accordingly, the United States Patent Office awarded United States Design Patent No. D481,059 (the '059 Patent) on October 21, 2003 to Maui Jim, Inc. A copy of the '059 Patent is attached as Exhibit 1.

8. By assignment from Mr. Hester and Ms. Egbert, Maui Jim owns all rights and title to the '059 patent, including full rights in and to the claims and causes of action in this suit.

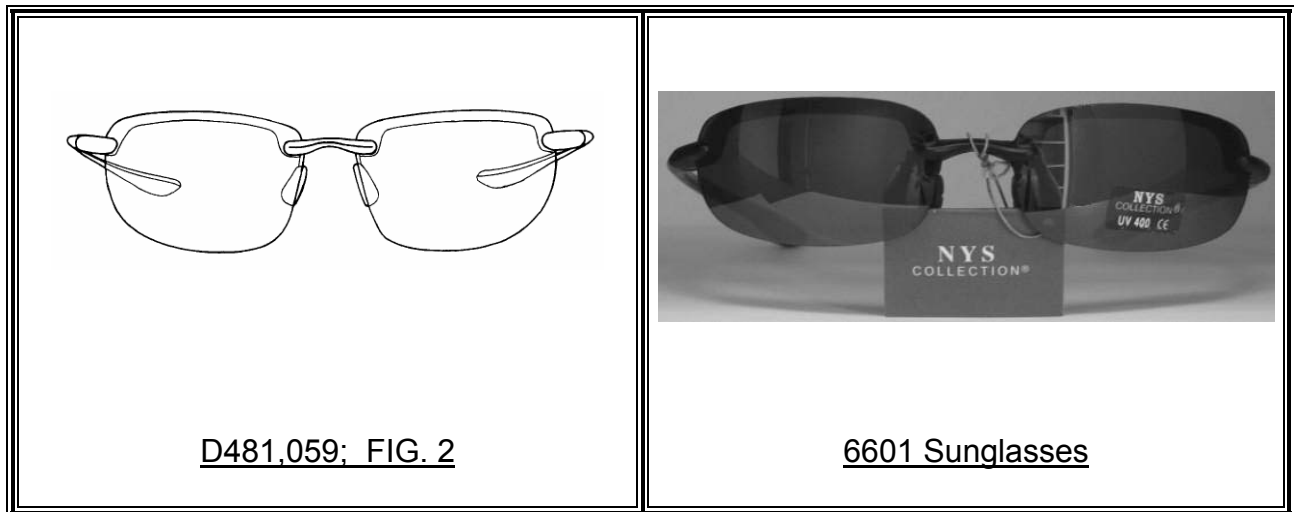
9. Maui Jim markets Mr. Hester and Ms. Egbert's design in its popular MJ Sport® line of sunglasses under the name Ho'okipa.

10. Maui Jim has promoted the unique design of the Ho'okipa sunglasses in print and electronic media. The Ho'okipa sunglasses have enjoyed great commercial success.

FIRST CLAIM FOR RELIEF – NYS'S INFRINGEMENT OF U.S. DES. PAT. NO.

D481,059

11. Defendant NYS has been and is infringing the '059 patent. In so doing, NYS is capitalizing on the success of the Maui Jim Ho'okipa sunglasses by making, selling, offering for sale, and/or importing into the United States sunglasses under the model number "6601" ("6601 sunglasses") that are substantially the same as the novel design claimed in the '059 patent. NYS sells sunglasses through carts in shopping malls, including in this District, and through web vendors including www.BargainDepot.net. Figure 2 of the '059 patent is show below next to a photograph of the 6601 sunglasses purchased from www.BargainDepot.net. The 6601 sunglasses purchased from www.BargainDepot.net are labeled with the "6601" model number and the NYS Collection® logo.



12. The NYS 6601 sunglasses are sold as being “comparable in design” to Maui Jim’s sunglasses. (See www.BargainDepot.net webpage print-out attached as Exhibit 3).

13. Maui Jim's Ho'okipa sunglasses are marked under the '059 patent in accordance with 35 U.S.C. § 287(a).

14. NYS has been offering for sale or selling the 6601 sunglasses since at least June 2004.

15. NYS has willfully infringed the '059 patent, and will continue to willfully infringe the patent until it ceases all of its infringing acts, thus warranting an assessment of increased damages and attorneys fees pursuant to 35 U.S.C. §§ 284 and 285.

16. Maui Jim has been damaged by NYS’s infringement and will continue to suffer irreparable injury unless the Court enjoins NYS from continuing its wrongful conduct.

17. Pursuant to 35 U.S.C. §§ 283, Maui Jim requests that the Court enjoin NYS from continuing to infringe the '059 patent.

18. Pursuant to 35 U.S.C. §§ 271, 281, and 284, Maui Jim seeks an award of damages in an amount to be determined by the trier of fact.

19. Pursuant to 35 U.S.C. §§ 289, Maui Jim seeks an award of statutory damages.

PRAYER FOR RELIEF

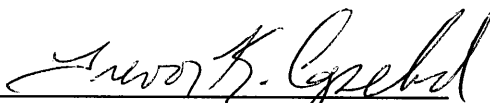
Maui Jim respectfully requests that the Court enter judgment against NYS, and award Maui Jim the following relief:

- a. Declaration that the '059 patent is valid, enforceable, and infringed by NYS;
- b. Temporary and permanent injunctive relief enjoining NYS, its officers, directors, employees, agents, attorneys, successors, and assigns, and all persons acting on its behalf, in privity or concert with it, or within its control from making, using, selling, offering to sell, importing, or otherwise infringing the '059 patent, and requiring it to deliver all infringing sunglasses in its possession, custody or control to Maui Jim for destruction;
- c. Damages for infringement of Maui Jim's '059 patent, including at least statutory damages under 35 U.S.C. § 289;
- d. Increased damages and attorneys fees;
- e. Prejudgment and post-judgment interest at the highest rates authorized by law; and
- f. Costs of court.

JURY DEMAND

Pursuant to Fed. R. Civ. P. 38 and CDIL-LR 38.1, Maui Jim demands a jury trial.

Dated: June 28, 2006

By: 
James R. Sobieraj (Lead Counsel CDIL-LR 11.2)
Jason C. White (*Admission Pending*)
Trevor K. Copeland

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MAUI JIM, INC.

EXHIBIT 1



US00D481059S

(12) **United States Design Patent** (10) **Patent No.:** **US D481,059 S**
Egbert et al. (45) **Date of Patent:** **** Oct. 21, 2003**

(54) **SUNGLASSES**

(75) Inventors: **Jennifer Egbert**, Lahaina, HI (US);
Walter Hester, Lahaina, HI (US)

(73) Assignee: **Maui Jim, Inc.**, Peoria, IL (US)

(**) Term: **14 Years**

(21) Appl. No.: **29/165,676**

(22) Filed: **Aug. 14, 2002**

(51) **LOC (7) Cl.** **16-06**

(52) **U.S. Cl.** **D16/315; D16/316**

(58) **Field of Search** D16/101, 300-330,
D16/335; D29/109, 110; D24/110.2; 351/41,
44, 51, 52, 103-109, 158; 2/447-449

(56) **References Cited**

U.S. PATENT DOCUMENTS

D199,933 S * 12/1964 Shindler D16/316
D221,480 S * 8/1971 Tagnon D16/315

D247,440 S * 3/1978 Bloch D16/316
6,196,681 B1 * 3/2001 Canavan 351/106
D443,633 S * 6/2001 Lazarides D16/327
D464,982 S * 10/2002 Thixton et al. D16/316

* cited by examiner

Primary Examiner—Raphael Barkai

(74) *Attorney, Agent, or Firm*—Marshall, Gerstein & Borun

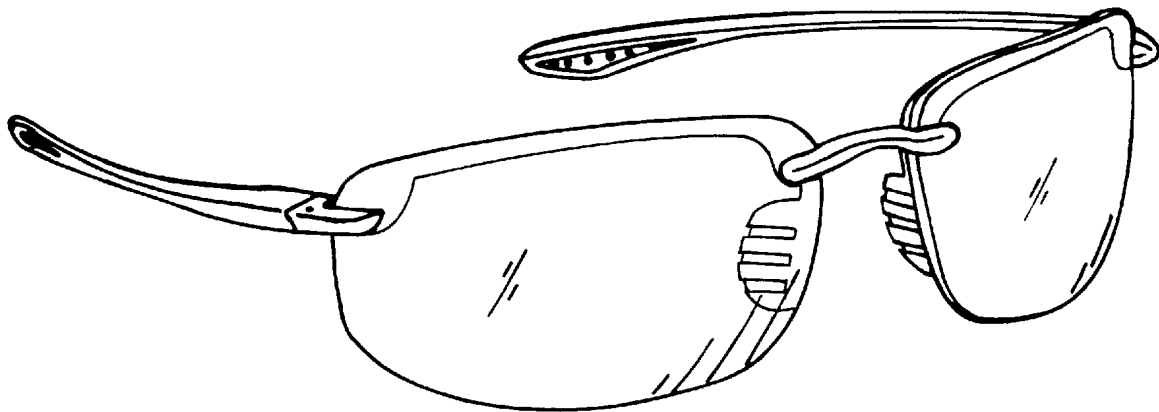
(57) **CLAIM**

The ornamental design for sunglasses, as shown and described.

DESCRIPTION

FIG. 1 is a perspective view of the sunglasses;
FIG. 2 is a front view of the sunglasses;
FIG. 3 is a rear view of the sunglasses;
FIG. 4 is a side view, the opposite side view being a mirror image thereof;
FIG. 5 is a top view; and,
FIG. 6 is a bottom view.

1 Claim, 5 Drawing Sheets



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FIG. I

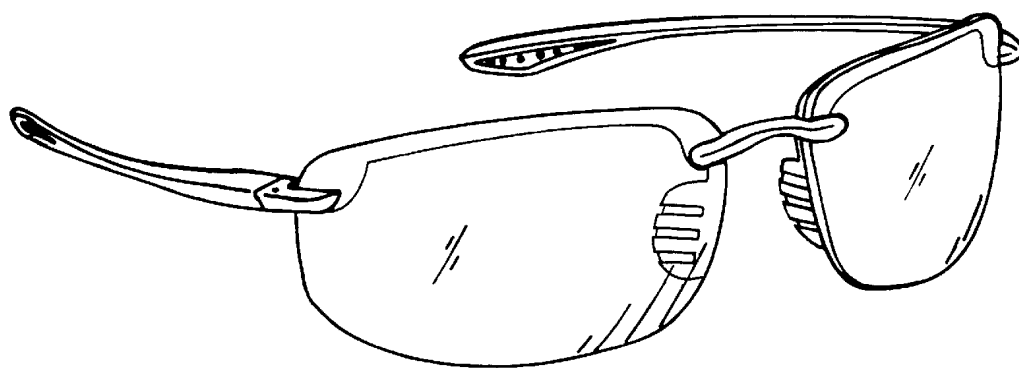


FIG. 2

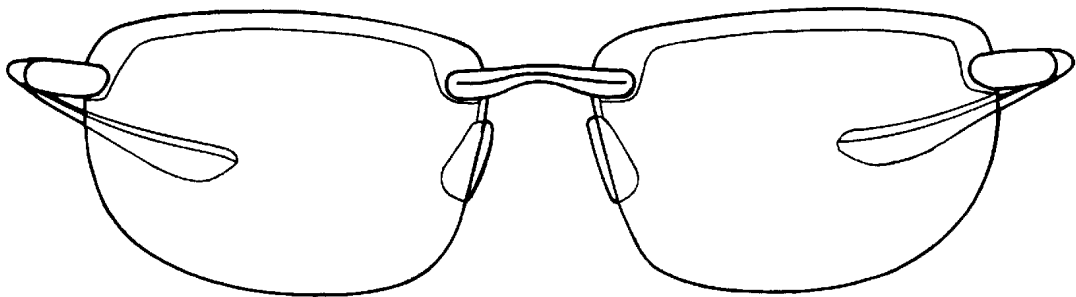
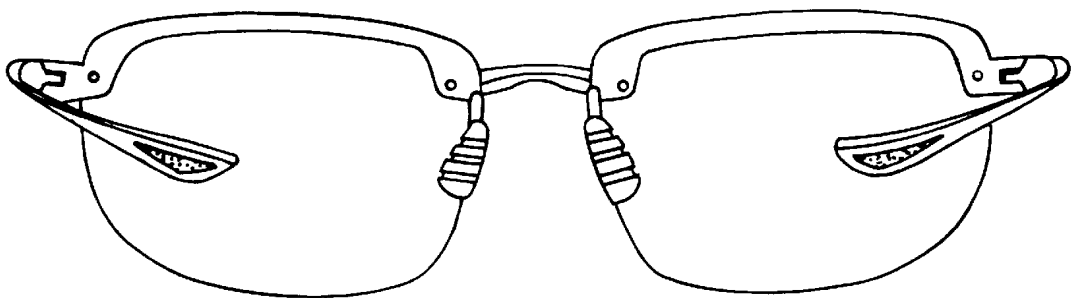


FIG. 3



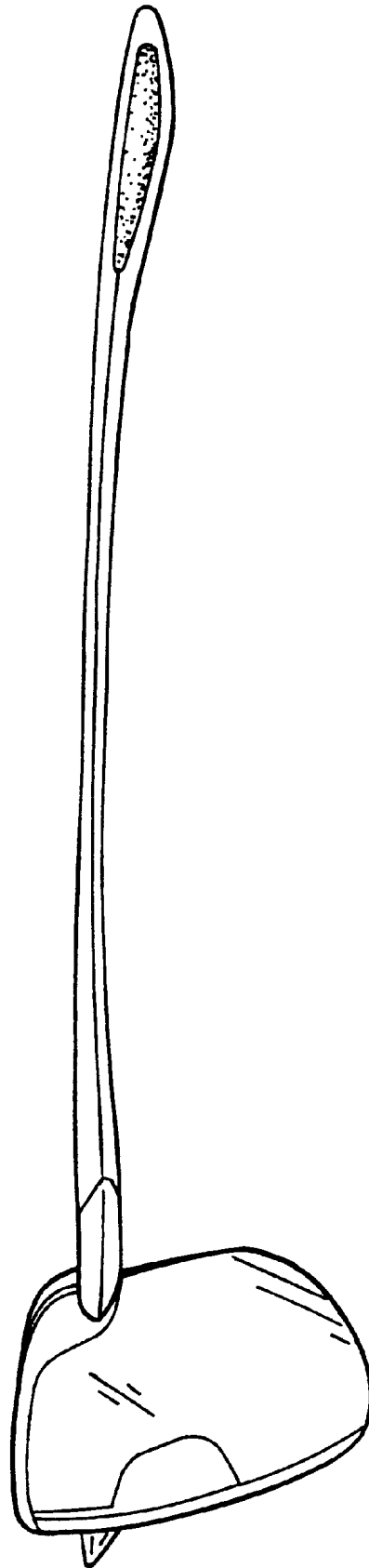
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FIG. 4



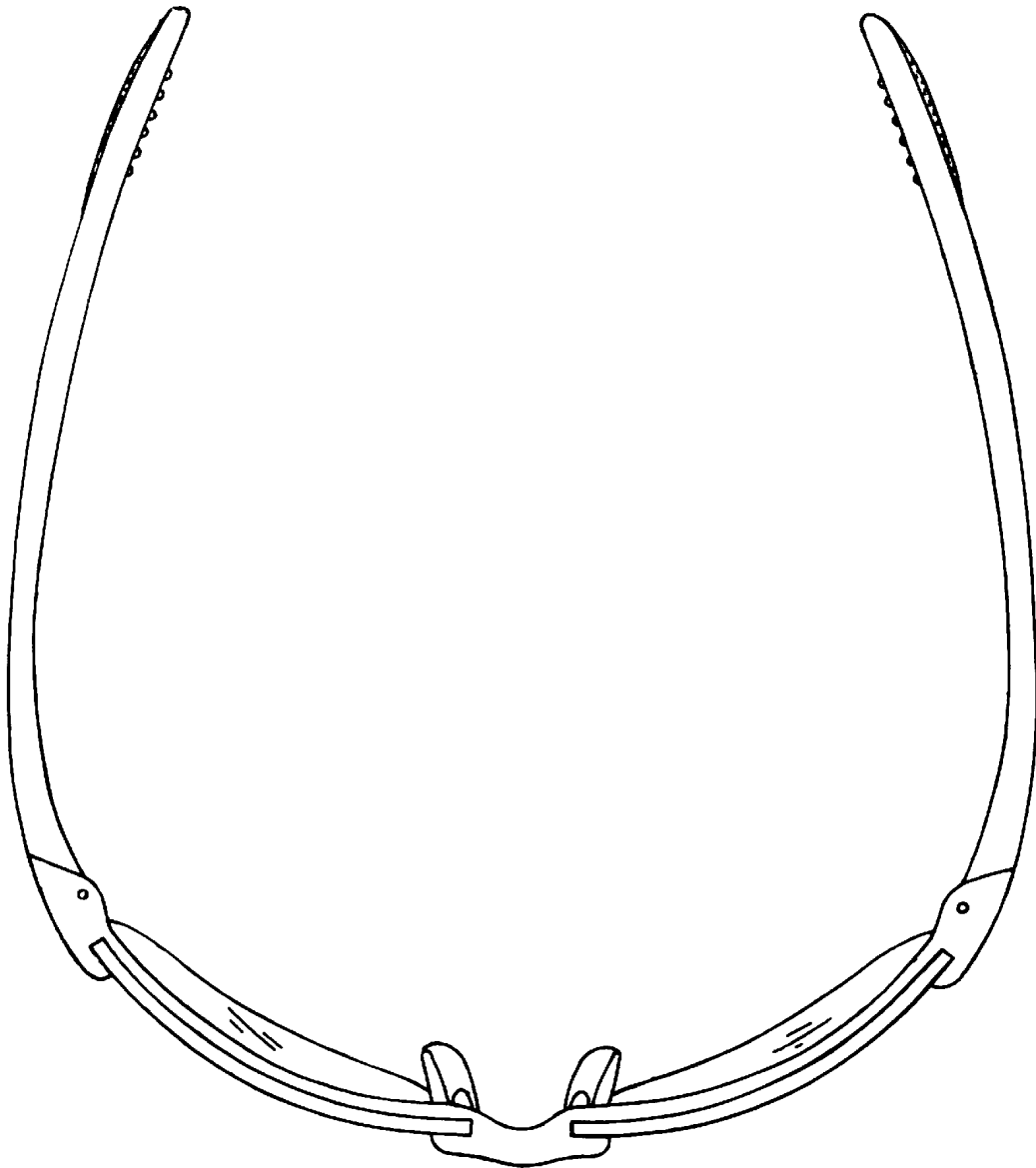
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FIG. 5



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FIG. 6

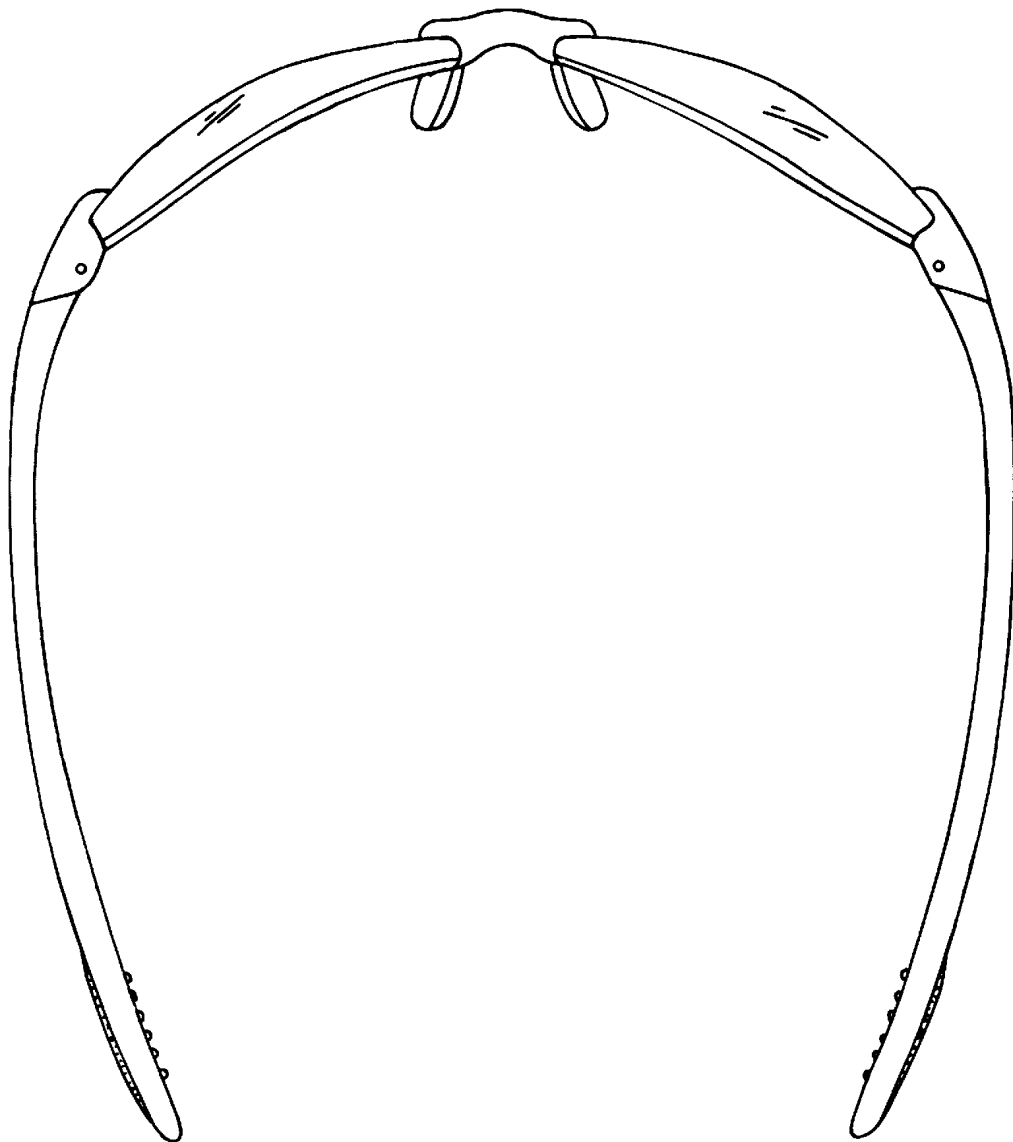


EXHIBIT 2

BargainDepot.net
1-877-729-1712

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PRODUCTS
»Product Search:

[Beach Towels](#)
[Bean Bags](#)
[Blankets](#)
[Candles](#)
[Collectible Mugs](#)
[Collegiate Merchandise](#)
[Greeting Cards](#)
[Handbags](#)
[MLB Merchandise](#)
[NASCAR Merchandise](#)
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[Sunglasses](#)

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