

1 and False Designation of Origin in violation of 15
2 U.S.C. § 1125(a); (3) Dilution of a Famous Mark in
3 violation of 15 U.S.C. § 1125(c); (4) "Cybersquatting"
4 in violation of 15 U.S.C. § 1125(d); and (5) two claims
5 of Patent Infringement in violation of 35 U.S.C. § 271.
6 Plaintiff requests as relief \$4 million (\$2 million per
7 defendant) in statutory damages pursuant to 15 U.S.C. §
8 1117(c)(2), a permanent injunction, and various orders.

9 The Motion was set for hearing on September 10,
10 2014, and was taken under submission by the Court on
11 September 4, 2014 [16]. The Court, having reviewed all
12 papers submitted pertaining to this Motion, **NOW FINDS**
13 **AND RULES AS FOLLOWS:** The Court **GRANTS in part and**
14 **DENIES in part** Plaintiff's Motion for Default Judgment.

15 I. BACKGROUND

16 Plaintiff Deckers is an American corporation that
17 designs, markets, and sells footwear and other
18 merchandise under its UGG® brand. Compl. ¶¶ 6, 14-19.
19 Plaintiff owns the trademark "UGG," a valid and
20 incontestible trademark registered with the U.S. Patent
21 & Trademark Office (hereinafter referred to as the "UGG
22 Trademark"). Compl. ¶¶ 15-17. Plaintiff and its
23 predecessors in interest have continuously used the UGG
24 trademark since at least 1979, and since acquiring the
25 UGG trademark and its business goodwill in 1995,
26 Plaintiff has continuously sold footwear, clothing, and
27 accessories under the UGG trademark. Compl. ¶ 15, 16.
28 Plaintiff's UGG®-brand products are distributed and

1 sold to consumers throughout the United States,
2 including on the Internet through Plaintiff's website,
3 www.ugg.com. Compl. ¶ 14.

4 Plaintiff also owns two United States design
5 patents, registered with the U.S. Patent & Trademark
6 Office as design patent No. D616,189 and No.D599,999.
7 Compl. ¶ 20-21. Plaintiff has not granted to
8 Defendants any form of consent to use Plaintiff's
9 patents or the UGG Trademark. Compl. ¶¶ 17, 22.

10 Defendant Ozwear is an Australian business that
11 sells products, including sheepskin footwear, that bear
12 a label that includes the "UGG" mark. Compl. ¶ 7; Mot.
13 for Default J. ("Mot.") at 22-23, Decl. Of Robert L.
14 Holmes; id. at 28-46, Exs. A-D. Ozwear owns or
15 operates the website ozwearuggs.com.au, through which
16 Ozwear sells its products to United States customers,
17 including customers in California. Compl. ¶ 10-12.
18 Defendant Adams is an Australian citizen who is the
19 owner or agent of Ozwear and who, through the website
20 ozwearuggs.com.au, sells Ozwear products bearing the
21 "UGG" mark in the United States, including in
22 California. Compl. ¶¶ 8-12; Mot. at 22-23, Holmes
23 Decl. ¶¶ 2-5; id. at 32-46, Exs. B-D.

24 Plaintiff alleges that Defendants Ozwear and Adams
25 have and continue to knowingly and willfully infringe
26 on Plaintiff's UGG Trademark by advertising,
27 manufacturing for sale, offering for sale, importing,
28 or selling counterfeit products bearing Plaintiff's UGG

1 Trademark in the United States through Defendants'
2 Internet website, ozwearuggs.com.au. Compl. ¶¶ 12, 27-
3 36. Plaintiff also alleges that Defendants, through
4 ozwearuggs.com.au, sell footwear in the United States
5 that infringes on the ornamental design protected in
6 two of Plaintiff's design patents, Patent No. D599,999
7 and Patent No. D616,189. Compl. ¶¶ 25-26, 65-72, &
8 Exs. B-C.

9 Plaintiff filed this action against Defendants on
10 March 26, 2014 [1]. The Summons and Complaint were
11 served on Defendants on April 10, 2014. Mot. at 4; *id.*
12 at 26, Wang Decl. ¶ 2. Proofs of service for
13 Defendants were filed on May 7, 2014 [9]. On May 30,
14 2014, Plaintiff requested the Clerk to enter default
15 against Defendants [11]. The Clerk entered Defendants'
16 default on June 3, 2014 [13, 14]. On July 31, 2014,
17 Plaintiff filed this Motion for Default Judgment
18 against Defendants [15]. On July 31, 2014, Plaintiff
19 served Defendants with this Motion, Notice of Motion,
20 and supporting papers. Mot. at 26-27, Wang Decl. ¶ 7.
21 To date, Defendants have not filed responsive pleadings
22 or otherwise appeared in this action.

23 II. LEGAL STANDARD

24 Federal Rule of Civil Procedure 55 governs the
25 entry of default judgment: "[w]hen a party against whom
26 a judgment for affirmative relief is sought has failed
27 to plead or otherwise defend . . ., the clerk must
28 enter the party's default." Fed. R. Civ. P. 55(a).

1 After default is properly entered, a party seeking
2 relief other than a sum certain must apply to the Court
3 for a default judgment. See Fed. R. Civ. P. 55(b). A
4 party moving for default judgment by the Court must
5 satisfy both procedural and substantive requirements.

6 When application is made to the Court for default
7 judgment, the application must comply with the
8 procedural requirements in Federal Rules of Civil
9 Procedure 55 and 56, and must comply with Local Rule
10 55-1. Vogel v. Rite Aid Corp., 992 F. Supp. 2d 998,
11 1006 (C.D. Cal. 2014).

12 Substantively, the decision to grant or deny
13 default judgment is within the discretion of the
14 district court. Vogel, 992 F. Supp. 2d at 1005; see
15 Fed. R. Civ. P. 55. The Ninth Circuit has established
16 seven factors to assist the court in determining
17 whether default judgment is substantively appropriate:
18 (1) the possibility of prejudice to the plaintiff;
19 (2) the merits of the plaintiff's substantive claim;
20 (3) the sufficiency of the complaint;
21 (4) the sum of money at stake in the action;
22 (5) the possibility of a dispute concerning material
23 facts;
24 (6) whether default was due to excusable neglect; and;
25 (7) the strong policy underlying the Federal Rules of
26 Civil Procedure that favors decisions on the merits.
27 Eitel v. McCool, 782 F.2d 1470, 1472-73 (9th Cir.
28 1986). When analyzing whether entry of default

1 judgment is substantively proper, the factual
2 allegations in the complaint are taken as true, as all
3 factual allegations in the complaint, except those
4 proving the amount of actual damages, are deemed
5 admitted by the defaulting party once default has been
6 properly entered against that party. Geddes v. United
7 Financial Grp., 559 F.2d 557, 560 (9th Cir. 1977); see
8 Fed. R. Civ. P. 8(b)(6).

9 Additionally, “[w]hen entry of judgment is sought
10 against a party who has failed to plead or otherwise
11 defend, a district court has an affirmative duty to
12 look into its jurisdiction over both the subject matter
13 and the parties.” In re Tuli, 172 F.3d 707, 712 (9th
14 Cir.1999). When assessing whether jurisdiction is
15 proper, “a court must also determine whether the
16 service of process on the party against whom default
17 judgment is requested is adequate.” DFSB Kollektive
18 Co. v. Tran, No. 11-CV-01049-LHK, 2011 WL 6730678, at
19 *6 (N.D. Cal. Dec. 21, 2011).

20 **III. ANALYSIS**

21 **A. Subject Matter and Personal Jurisdiction**

22 1. Subject Matter Jurisdiction

23 The Court has subject matter jurisdiction over
24 Plaintiff’s claims pursuant to 28 U.S.C. § 1338, 15
25 U.S.C. § 1121, and 28 U.S.C. § 1331.

26 2. Personal Jurisdiction

27 For a district court to properly exercise personal
28 jurisdiction over a nonresident defendant, the forum

1 state's laws must provide a basis for exercising
2 personal jurisdiction, and the assertion of personal
3 jurisdiction must comport with due process.
4 CollegeSource, Inc. v. AcademyOne, Inc., 653 F.3d 1066,
5 1073-74 (9th Cir. 2011).

6 The California long-arm statute permits the
7 exercise of jurisdiction "on any basis not inconsistent
8 with the Constitution . . . of the United States."
9 Cal. Civ. Proc. Code § 410.10. This language renders
10 California's long-arm statute "coextensive with federal
11 due process requirements" so that only a due-process
12 analysis is required. See CollegeSource, 653 F.3d at
13 1073 (citation omitted).

14 Due process requires a nonresident defendant to
15 have "certain minimum contacts" with the forum state
16 "such that the maintenance of the suit does not offend
17 traditional notions of fair play and substantial
18 justice." Int'l Shoe Co. v. Washington, 326 U.S. 310,
19 316 (1945). The defendant's contacts must be "such
20 that the [defendant] should reasonably anticipate being
21 haled into court there." World-Wide Volkswagen Corp.
22 v. Woodson, 444 U.S. 286, 297 (1980).

23 As both Defendants are "nonresidents" of
24 California, Compl. ¶¶ 7-10, Plaintiff must show that
25 Defendants have sufficient contacts with California to
26 justify personal jurisdiction. Sufficient contacts can
27 be established by proving either general or specific
28 personal jurisdiction. Id.

1 a. *Specific Personal Jurisdiction*

2 A district court may assert specific personal
3 jurisdiction over a defendant if the defendant has
4 "purposefully directed" his activities at the forum and
5 if the plaintiff's alleged claims and injuries "arise
6 out of or relate to those activities." Burger King
7 Corp. v. Rudzewicz, 471 U.S. 462, 472-73 (1985).

8 The Ninth Circuit applies a three-part test to
9 determine whether the exercise of specific jurisdiction
10 over a nonresident defendant comports with due process:

11 (1) The non-resident defendant must purposefully
12 direct his activities or consummate some
13 transaction with the forum or resident thereof; or
14 perform some act by which he purposefully avails
15 himself of the privilege of conducting activities
16 in the forum, thereby invoking the benefits and
17 protections of its laws;

18 (2) the claim must be one which arises out of or
19 relates to the defendant's forum-related
20 activities; and

21 (3) the exercise of jurisdiction must comport with
22 fair play and substantial justice, i.e. it must be
23 reasonable.

24 Boschetto v. Hansing, 539 F.3d 1011, 1016 (9th Cir.
25 2008). The plaintiff bears the burden of establishing
26 the first two prongs. Id. If the plaintiff
27 establishes both prongs, the defendant then bears the
28 burden of making a "compelling case" that the exercise

1 of jurisdiction would not be reasonable. Id.

2 The Court finds that it has specific personal
3 jurisdiction over Defendants. Plaintiff has made a
4 prima facie showing that Defendants have purposefully
5 directed their activities at residents in this forum
6 state and that Plaintiff's claims and injuries "arise
7 out of or relate to" Defendants' infringing activities
8 in this forum. Burger King Corp. v. Rudzewicz, 471
9 U.S. 462, 472-73 (1985). Plaintiff has alleged facts,
10 deemed admitted by Defendants' default, Derek Andrew,
11 Inc. v. Poof Apparel Corp., 528 F.3d 696, 702 (9th Cir.
12 2008), that Defendants sell and ship infringing
13 products to California residents through Defendants'
14 website, ozwearuggs.com.au, and that such infringing
15 products are the subject of Plaintiff's claims and
16 injuries in this Action. Though Defendants' have the
17 burden of establishing unreasonableness, the Court
18 finds that its exercise of personal jurisdiction over
19 Defendants is not unreasonable after *sua sponte*
20 assessing the Ninth Circuit's seven "reasonableness"
21 factors. See Schwarzenegger v. Fred Martin Motor Co.,
22 374 F.3d 797, 801-02 (9th Cir. 2004).

23 **B. Service of Process**

24 Defendants are both residents of New South Wales,
25 Australia; Defendant Adams is an individual, and
26 Defendant Ozwear is a business. Compl. ¶¶ 8, 10; Mot.
27 at 23, Holmes Decl. Plaintiff's proofs of service
28 indicate that Defendants were personally served by an

1 Australian private process server named Joseph Khoury
2 from Clark International Pty. Ltd. in Caringbah, New
3 South Wales, Australia. Dckt. # 9, 10.

4 Rule 4 of the Federal Rules of Civil Procedure
5 governs service of process, and subsection (f) allows a
6 foreign individual to be served by "any internationally
7 agreed means of service," such as the Hague Convention
8 on the Service Abroad of Judicial and Extrajudicial
9 Documents ("Hague Service Convention"). Fed. R. Civ.
10 P. 4(f)(1). Subsection (h)(2) allows service on a
11 foreign corporation "in any manner prescribed by Rule
12 4(f) for serving an individual, except personal service
13 under (f)(2)(C)(I)." Fed. R. Civ. P. 4(h)(2).

14 Because the United States and Australia are parties
15 to the Hague Service Convention, "compliance with the
16 Convention is mandatory." Volkswagenwerk
17 Aktiengesellschaft v. Schlunk, 486 U.S. 694, 705
18 (1099); see Private International Law: Serving a Legal
19 Document Across International Borders, Australian Gov.
20 Attorney-General's Dep't,
21 <http://www.ag.gov.au/Internationalrelations/PrivateInternationalLaw/Pages/Servingalegaldocumentacrossinternationalborders.aspx> (last visited Sept. 16, 2014). The
22 Hague Service Convention allows for personal service of
23 both defendants so long as the "State of destination
24 does not object." Hague Convention on the Service
25 Abroad of Judicial and Extrajudicial Documents, art. 10
26 20 U.S.T. 361 (1956). With regard to Article 10 of the

1 Convention, Australia allows for personal service of
2 process and "does not object to the use of private
3 process servers, diplomatic channels or local agents."
4 Private International Law: Serving a Legal Document
5 Across International Borders, Australian Gov.,
6 Attorney-General's Dep't
7 <http://www.ag.gov.au/Internationalrelations/PrivateInternationalLaw/Pages/Servingalegaldocumentacrossinternationalborders.aspx> (last visited Sept. 16, 2014). More
8
9 specifically, the rules of civil procedure of New South
10 Wales allow for personal service of process by private
11 process servers for both individuals and businesses.
12
13 See New S. Wales, Unif. Civ. P. R. 10.5, 10.9,
14 10.10(2)(a), 10.11, 10.22 (2005), available at
15 http://www.austlii.edu.au/au/legis/nsw/consol_reg/ucpr2005305/index.html; see also DFSB Kollektive Co. v.
16 Tran, No. 11-CV-01049-LHK, 2011 WL 6730678, at *6 (N.D.
17 Cal. Dec. 21, 2011); see also Declarations of
18 Australia, Hague Conference on Private Int'l Law,
19 http://www.hcch.net/index_en.php?act=status.comment&csid=1062&disp=resdn (last visited Sept. 17, 2014).

22 Because Plaintiff's personal method of service
23 complies with the Hague Service Convention, it complies
24 with Fed. R. Civ. P. 4(f)(1). Plaintiff's proper
25 service of Defendant Ozwear under Fed. R. Civ. P.
26 4(f)(1) complies with Fed. R. Civ. P. 4(h)(2).
27 Plaintiff's service on Defendants was proper.

28 **C. Procedural Requirements**

1 The Clerk properly entered Defendants' default on
2 June 3, 2014, and to date, Defendants have not
3 responded or appeared in this Action. Upon reviewing
4 Plaintiff's Motion, the Court finds that Plaintiff has
5 satisfied the applicable procedural requirements for
6 entry of default judgment.

7 **D. Substantive Factors**

8 The Court finds that, on the whole, the Eitel
9 factors weigh in favor of entry of default judgment as
10 to all of the claims that Plaintiff submitted for
11 default judgment except for Plaintiff's Cybersquatting
12 claim under 15 U.S.C. § 1125(d).

13 *1. Prejudice to Plaintiff*

14 Plaintiff has established that it will suffer prejudice
15 if a default judgment is not entered. See Vogel, 992
16 F. Supp. 2d at 1007; Compl. ¶ 35-39. Plaintiff claims
17 it has suffered and will continue to suffer injury from
18 Defendants' alleged infringement of Plaintiff's UGG
19 Trademark and design patents. See Compl. ¶¶ 35-39. If
20 the Court declined to grant default judgment in this
21 case, Plaintiff would be prejudiced because Plaintiff
22 lacks other recourse to recover damages for its injury
23 or means to prevent the defendant from causing further
24 harm. Moroccanoil, Inc. v. Allstate Beauty Prods.,
25 Inc., 847 F. Supp. 2d 1197, 1201 (C.D. Cal. 2012).
26 This factor favors default judgment.

27 *2. & 3. Merits of Substantive Claim & Sufficiency of*
28 *Complaint*

1 Lanham Act Claims

2 1. Trademark Infringement & Unfair Competition/False
3 Designation of Origin Claims

4 To prevail on a trademark infringement claim under
5 15 U.S.C. § 1114, a plaintiff must show: (1) it owns
6 the trademark at issue; (2) the defendant has used in
7 commerce without authorization, "any reproduction,
8 counterfeit, copy, or colorable imitation" of the
9 plaintiff's registered mark in connection with the
10 sale, offering for sale, distribution, or advertising
11 of goods; and (3) the defendant's use of the mark is
12 "likely to cause confusion, or to cause mistake, or to
13 deceive." See 15 U.S.C. § 1141(1)(a)-(b).

14 To prevail on a claim under § 1125(a) (use of
15 counterfeit mark, unfair competition, false designation
16 of origin), Plaintiff must show that Defendants, "in
17 connection with any goods or services, or any container
18 for goods, use in commerce any word, term, name,
19 symbol, or device, or any combination thereof, or any
20 false designation of origin, false or misleading
21 description of fact, or false or misleading
22 representation of fact" that "is likely to cause
23 confusion, or to cause mistake, or to deceive as to the
24 affiliation, connection, or association of such person
25 with another person, or as to the origin, sponsorship,
26 or approval of his or her goods, services, or
27 commercial activities by another person." 15 U.S.C. §
28 1125(a)(1)(A).

1 When analyzing a claim under sections 1114(1) and
2 11125(a), the same standard applies for both claims:
3 "that [the defendant] is using a mark confusingly
4 similar to [the plaintiff's] valid, protectable
5 trademark." Brookfield Commc'ns, Inc. v. W. Coast
6 Entm't Corp., 174 F.3d 1036, 1046 & n.6, 1047 n.8 (9th
7 Cir. 1999).

8 Plaintiff has sufficiently pleaded facts to show
9 that Defendants have used, and are using, a mark
10 confusingly similar to Plaintiff's valid UGG Trademark.
11 First, Plaintiff's Complaint asserts that Plaintiff
12 owns the UGG Trademark, registered as U.S. Trademark
13 Registration No. 3,050,925, and that the mark is valid
14 and incontestible. Compl. ¶ 16, Ex. A. Plaintiff
15 alleges that Defendants' use of the UGG mark is
16 unauthorized. Compl. ¶¶ 30-32. Plaintiff shows that
17 the UGG mark used by Defendants is a "reproduction,
18 counterfeit, copy, or colorable imitation" of the UGG
19 Trademark by providing images of Defendants' UGG mark,
20 which looks nearly identical to the UGG Trademark
21 Plaintiff registered with the Patent and Trademark
22 Office. Compl. ¶ 25; *id.* at 20, Ex. A. Plaintiff
23 sufficiently alleges and shows that Defendants use the
24 mark "in commerce." Compl. ¶¶ 22-25, 28-36; Mot. at
25 Exh. D.

26 As to the final requirement, "likelihood of
27 confusion," Plaintiff alleges that Defendants' use of
28 the UGG mark creates a "likelihood of confusion"

1 because Defendants' UGG mark is "identical with or
2 substantially indistinguishable from the [Plaintiff's]
3 UGG mark" and is placed on merchandise that looks like
4 merchandise sold by Deckers' UGG brand. See Compl. ¶¶
5 23, 30.

6 "Likelihood of confusion" is the "central element"
7 of a trademark infringement claim. GoTo.com, Inc. v.
8 Walt Disney Co., 2020 F.3d 1199, 1205 (9th Cir. 2000).
9 The "likelihood of confusion" issue "can be recast as
10 the determination of whether the similarity of the
11 marks is likely to confuse customers about the source
12 of the products." Id. (internal quotation marks and
13 citations omitted). The Ninth Circuit considers eight
14 factors, termed the Sleekcraft factors, to determine
15 likelihood of confusion: (1) strength of the mark; (2)
16 proximity of the goods; (3) similarity of the marks;
17 (4) evidence of actual confusion; (5) marketing
18 channels used; (6) type of goods and the degree of care
19 likely to be exercised by the purchaser; (7)
20 defendant's intent in selecting the mark; and (8)
21 likelihood of expansion of the product lines. AMF Inc.
22 v. Sleekcraft Boats, 599 F.2d 341 (9th Cir. 1979).
23 When infringement is alleged to have occurred via a
24 website, the three most important factors are the
25 similarity of the marks, the proximity (or relatedness)
26 of the goods or services, and the simultaneous use of
27 the Web as a marketing channel. GoTo.com, 202 F.3d at
28 1205. Upon considering the Sleekcraft factors, the

1 Court finds that Plaintiffs have established
2 "likelihood of confusion."

3 The first factor requires a showing that the mark
4 at issue is strong enough to be entitled to the
5 protection of trademark laws. Because Plaintiff's UGG
6 Trademark is a federally registered trademark,
7 Plaintiff is entitled to a presumption that the UGG
8 Trademark is protected under the Lanham Act. UGG
9 Holdings, Inc. v. Severn, No. 04-1137, 2005 WL 5887187,
10 at *3 (C.D. Cal. 2005) ("The federal registration of a
11 trademark with the USPTO constitutes 'prima facie
12 evidence of the validity of the registered mark,
13 ownership of the mark and of the registrant's exclusive
14 right to use the registered mark.'" (citing 15 U.S.C.
15 §§ 1057(b), 1115(a); Brookfield, 174 F.3d at 1046-47)).
16 Defendants have not rebutted the presumption. See Tie
17 Tech, Inc. v. Kinedyne Corp., 296 F.3d 778, 783 (9th
18 Cir. 2002).

19 The second factor considers whether the relatedness
20 of the goods bearing the contested mark is likely to
21 cause consumer confusion. "Related goods are generally
22 more likely than unrelated goods to confuse the public
23 as to the producers of the goods." Brookfield, 174
24 F.3d at 1055. Plaintiff has sufficiently shown that
25 Plaintiff and Defendants manufacture, advertise, or
26 sell related goods. See Mot. at 6. Plaintiff's images
27 of its own patented designs and Defendants' footwear
28 establish that the goods sold by Plaintiff and

1 Defendants are not only related, but look almost
2 identical. Compl. ¶ 25, Exs. B-C; Mot. at Exs. A, D,
3 F. Further, both Plaintiff and Defendants sell other
4 merchandise and "accessories," like hats and gloves
5 made of sheepskin or sheepskin-like material, that look
6 similar. See Compl. ¶¶ 15, 23, 56. Compare
7 www.ozwearuggs.com.au/collections/accessories
8 (Defendants' website), with [www.ugg.com/womens-](http://www.ugg.com/womens-accessories)
9 [accessories](http://www.ugg.com/womens-accessories) (Plaintiff's website). This factor weighs
10 in favor of a likelihood of confusion.

11 The third factor considers the similarity of the
12 marks at issue. Plaintiff alleges that "[a] comparison
13 of the marks on Defendants' products to Deckers' [UGG
14 Trademark] reveals identical copying." Mot. at 6. The
15 similarity of Plaintiff's UGG Trademark and the UGG
16 mark used by Defendants is immediately apparent upon
17 viewing the two marks: both marks display the letters
18 "UGG" in all caps, centered, and prominent in a large
19 font; both marks are black in color; both marks are in
20 very similar font; both marks are placed in the same
21 location—the lower back side of the footwear, near the
22 heel area; and Defendants' product label includes the
23 word "Australian" in smaller font below, which is
24 similar to the way Deckers' UGG-brand marketing
25 appears. Compl. ¶ 25, Ex. A; Mot. at Exs. A, D, E; see
26 GoTo.com, Inc. v. Walt Disney Co., 202 F.3d 1199, 1206
27 (9th Cir. 2000). Because the two marks are "similar in
28 terms of sight, sound, and meaning by examining the

1 actual situations in which consumers are likely to
2 read, hear, and consider the meaning of the terms,"
3 this factor weighs in favor of likelihood of confusion.
4 Network Automation, Inc. v. Advanced Sys. Concepts,
5 Inc., 638 F.3d 1137 (9th Cir. 2011).

6 The fourth factor looks for evidence of actual
7 confusion in the marketplace. Plaintiff asserts that
8 mere purchases made by consumers of Defendants'
9 products bearing the UGG mark "evidences actual
10 confusion as to their source and origin." Mot. at 6-7;
11 see Compl. ¶¶ 23, 25, 31, 33, 36. This conclusory
12 statement is not sufficient to show actual confusion.
13 But due to "the difficulty of garnering such evidence,
14 the failure to prove instances of actual confusion is
15 not dispositive," and the factor is heavily weighed
16 only when the particular circumstances of the case
17 indicate that such evidence should have been available
18 and proven. Brookfield, 174 F.3d at 1050. In this
19 case, because Defendants have placed the "UGG" mark on
20 products that look very similar to Plaintiff's
21 products, and because Plaintiff was unable to engage in
22 discovery due to Defendants' default, a lack of
23 evidence of actual confusion is not dispositive.

24 The fifth factor considers whether both plaintiff
25 and defendant use the same "marketing channels" for the
26 products at issue, as "[c]onvergent marketing channels
27 increase the likelihood of confusion." M2 Software,
28 Inc. v. Madacy Entm't, 421 F.3d 1073, 1083 (9th Cir.

1 2005) (internal quotation marks and citations omitted).
2 "[T]he Web, as a marketing channel, is particularly
3 susceptible to a likelihood of confusion since . . . it
4 allows for competing marks to be encountered at the
5 same time, on the same screen." GoTo.com, 202 F.3d at
6 1207. Both Plaintiff and Defendants use the Internet
7 and their respective websites as marketing channels for
8 their UGG-labeled products that are similar in
9 appearance and features. Compl. ¶¶ 14, 23, 25, Exs. B,
10 C. Because there is "significant overlap in
11 [Plaintiff's and Defendants'] advertising markets,"
12 this factor weighs in favor of a likelihood of
13 confusion. M2 Software, 421 F.3d at 1083.

14 The sixth factor looks at the degree of care with
15 which a purchaser would choose the type of good at
16 issue. "Low consumer care . . . increases the
17 likelihood of confusion." Network Automation, Inc. v.
18 Advanced Sys. Concepts, Inc., 638 F.3d 1137, 1152 (9 th
19 Cir. 2011). Plaintiff's Motion shows that Defendants
20 sell some of their UGG-marked footwear for fairly high
21 prices, around \$250 to \$300 per pair of boots. Mot. at
22 32-33, Ex. B. The higher the price of a product, the
23 more it can be assumed that a purchaser will exercise a
24 greater degree of care, which decreases the likelihood
25 of confusion. Brookfield, 174 F.3d at 1060. Because
26 of the arguably high price of the footwear and the
27 greater sophistication of Internet purchasers today,
28 GoTo.com, 202 F.3d at 1209, this factor weighs slightly

1 against a finding of a likelihood of confusion.

2 The seventh factor considers the defendant's intent
3 in selecting the mark at issue. "This factor favors
4 the plaintiff where the alleged infringer adopted his
5 mark with knowledge, actual or constructive, that it
6 was another's trademark." Brookfield, 174 F.3d at
7 1059. Plaintiff alleges that Defendants used the UGG
8 mark willfully, with actual knowledge of Deckers'
9 ownership of the UGG Trademark. Compl. ¶¶ 23, 34, 62.
10 This factor favors a likelihood of confusion.

11 The eighth factor, likelihood of expansion of
12 product lines, is "relatively unimportant where two
13 companies already compete to a significant extent."
14 Brookfield, 174 F.3d at 1060. Plaintiff asserts that
15 it is already using the UGG Trademark in the class of
16 goods exploited by Defendants so that the intention to
17 expand product lines is irrelevant. Mot. at 7.
18 Because both Plaintiff and Defendant are selling the
19 same type of products with very similar features, this
20 factor is not relevant and thus does not weigh against
21 a finding of a likelihood of confusion.

22 The Sleekcraft factors, on the whole, support a
23 finding of a likelihood of confusion.

24 2. Dilution of a Famous Mark Claim

25 To prevail on a claim for dilution of a famous mark
26 under § 1125(c), Plaintiff must show that Defendants'
27 use of its UGG mark is likely to cause dilution of a
28 famous mark through blurring or tarnishment. 15 U.S.C.

1 § 1125(c). Plaintiff has alleged sufficient facts to
2 establish that its UGG mark is "famous" under 15 U.S.C.
3 1125(c) and that Defendants are liable for dilution by
4 both blurring and tarnishment. See Compl. ¶¶ 43-44, 48,
5 57, 62; Mot. at 24-25, Young Decl.

6 3. Cybersquatting

7 To prevail on a claim for cybersquatting under 15
8 U.S.C. § 1125(d), Plaintiff must show that 1)
9 Defendants have or had a "bad faith intent to profit
10 from that mark" and 2) "registers, traffics in, or uses
11 a domain name that" is identical or confusingly similar
12 to a mark that was "distinctive" or "famous" at the
13 time of registration of the domain name, or causes
14 dilution of a mark that was famous at the time of the
15 domain name's registration. 15 U.S.C. § 1125(d)(1)(A).

16 Plaintiffs allege that Defendants used the UGG
17 Trademark with a bad faith intent to profit from that
18 trademark by claiming that Defendants knowingly and
19 willfully placed the UGG Trademark in the domain names
20 of Defendants' two websites ("ozwearuggs.com" and
21 "ozwearuggs.com.au"), which sell products similar to
22 those sold by Deckers, in order to benefit from the
23 goodwill associated with the UGG Trademark. Compl. ¶
24 62. Plaintiff alleges that its UGG Trademark was
25 famous "before and at the time of the registration of
26 Defendants' domain names." Compl. ¶ 61.

27 An important question in this case is whether using
28 the term "uggs" is "confusingly similar to" or

1 "dilutes" the UGG trademark. Defendants use the term
2 "uggs" in their domain names, not the Plaintiff's
3 trademark, "UGG." The word "uggs" is a term for a type
4 of sheepskin boot, while Deckers' registered trademark,
5 "UGG," is not a generic product term.¹ See Andrew Terry
6 & Heather Forrest, Where's the Beef? Why Burger King Is
7 Hungry Jack's in Australia and Other Complications in
8 Building a Global Franchise Brand, 28 Nw. J. Int'l L. &
9 Bus. 171, 189 (2008).

10 In most cases, merely adding an "s" to the end of
11 an otherwise distinctive trademark still creates a
12 "confusingly similar" mark (e.g.,
13 "nationalgeographics.com" is confusingly similar to
14 nationalgeographic.com). But where adding an "s" turns
15 the mark into a generic product name that would not be
16 protected under the Lanham Act,² the likelihood of

18 ¹ For example, no one asks for an "ugg," but a
19 customer may be looking for "uggs" or "ugg boots." See
20 Terry & Forrest, Where's the Beef?, 28 Nw. J. Int'l L.
21 & Bus. at 189.

23 ² Yellow Cab Co. of Sacramento v. Yellow Cab of Elk
24 Grove, Inc., 419 F.3d 925, 927 (9th Cir. 2005)
25 ("Generic marks are not capable of receiving protection
26 because they identify the product, rather than the
27 product's source." (internal quotation marks and
28

1 confusion is significantly diminished.³ For instance,
2 if the trademark was "CHIP" plastics, the word "chips"
3 in a domain name would not necessarily be "confusingly
4 similar" to the trademark "CHIP." The key word in the
5 analysis is "confusingly."

6 The fact that Defendants include "ozwear" in their
7 domain names further undermines Plaintiff's claim of
8 *confusing* similarity. By including "ozwear" in the
9 domain names, confusion is diminished, if not
10 eradicated: a consumer is expressly put on notice that
11 this is not a Deckers UGG-brand website. After

12 _____
13 citations omitted)).

14 ³ An additional consideration is that First
15 Amendment issues could be triggered if a person is
16 enjoined from using a generic product term in his
17 domain name. Cf., e.g., Toyota Motor Sales, U.S.A.,
18 Inc. v. Tabari, 610 F.3d 1171, 1176 (9th Cir. 2010)
19 (reviewing a permanent injunction in a trademark
20 infringement case that prohibited the mark "LEXUS" in
21 any domain name of the defendant's and holding that the
22 injunction was too broad under the First Amendment
23 because it prohibited domain names "that on their face
24 dispel any confusion as to sponsorship or
25 endorsement").
26
27
28

1 reviewing Plaintiff's allegations, the Court finds that
2 Plaintiff does not allege sufficient facts to show that
3 Defendants' use of the term "uggs" in Defendants'
4 domain names is "confusingly similar" to Plaintiff's
5 UGG Trademark. Plaintiff also does not allege
6 sufficient facts to show that the term "uggs" in
7 Defendants' domain names dilutes Plaintiff's famous UGG
8 mark. See 15 U.S.C. § 1125(c).

9 Thus, the Court finds that Plaintiff has failed to
10 allege sufficient facts to establish Defendants'
11 liability for cybersquatting under 15 U.S.C. § 1125(d).

12 Patent Infringement Claims

13 Patent infringement is defined in 35 U.S.C. §
14 271(a): "whoever without authority makes, uses, offers
15 to sell, or sells any patented invention, within the
16 United States or imports into the United States any
17 patented invention during the term of the patent
18 therefor, infringes the patent."

19 Plaintiff alleges infringement of two design
20 patents. See Compl. at Ex. B-C. A design patent is
21 infringed if "the patented design, or any colorable
22 imitation thereof," is applied to "any article of
23 manufacture for the purpose of sale." 35 U.S.C. § 289;
24 see also McIntire v. Sunrise Specialty Co., 944
25 F.Supp.2d 933, 937 (E.D. Cal. 2013) (citing Arminak &
26 Assocs., Inc. v. Saint-Gobain Calmar, Inc., 501 F.3d
27 1314, 1319 (Fed. Cir. 2007). To satisfy Section 289,
28 the plaintiff must allege facts sufficient for a fact-

1 finder to conclude that "an ordinary observer familiar
2 with the patented product would be deceived into
3 believing that the accused product is the same as the
4 patented design." Amini Innovation Corp. v. KTY Int'l
5 Mktg., 768 F. Supp. 2d 1049, 1055 (C.D. Cal. 2011)
6 (citing Egyptian Goddess, Inc. v. Swisa, Inc., 543 F.3d
7 665, 681 (Fed. Cir. 2008)).

8 Plaintiff's patents are "presumed valid" under 35
9 U.S.C. § 282, as Defendants have not challenged the
10 patents' validity. Plaintiff provides images of its
11 patented designs and photographs of the footwear sold
12 by Defendants through ozwearuggs.com.au to show the
13 similarity of Defendants' and Plaintiff's designs.
14 Compl. at Exs. B-C; Mot. at Exs. A, D, E-F. Both
15 Defendants' and Plaintiff's products have similar, if
16 not identical, ornamental designs consisting of a side
17 slit in the material on the outward side of the upper
18 portion of the boot with fur protruding from the slit
19 and with the slit fastened together by buttons hooked
20 to a band that is attached to the opposite side of the
21 slit. See id. Plaintiff's images are sufficient for a
22 fact-finder to conclude that an ordinary observer
23 familiar with Plaintiff's patented product would be
24 deceived into believing that the Defendants' product is
25 the same as the patented design. See Egyptian Goddess,
26 Inc. v. Swisa, Inc., 543 F.3d 665, 681 (Fed. Cir.
27 2008)). Plaintiff has alleged sufficient facts to
28 prove Defendants' liability for patent infringement.

1
2 While Plaintiff has failed to prove its
3 cybersquatting claim under 15 U.S.C. § 1125(d), it has
4 proved the majority of its claims, including trademark
5 infringement, dilution of a famous mark, and patent
6 infringement of two design patents. Thus, this factor
7 weighs in favor of default judgment as to the claims
8 sufficiently proved by Plaintiff.

9 *4. Sum of Money at Stake in Action*

10 Default judgment is disfavored when a large amount
11 of money is involved and is unreasonable in light of
12 the potential loss caused by the defendant's actions.
13 Vogel v. Rite Aid Corp., 992 F. Supp. 2d 998, 1012
14 (C.D. Cal. 2014). Here, Plaintiff seeks a large amount
15 of money—\$4 million in statutory damages. But a large
16 amount of money, by itself, is not necessarily
17 unreasonable; the court must balance "the amount of
18 money at stake in relation to the seriousness of the
19 defendant's conduct." Vogel, 992 F. Supp. 2d at 1012
20 (internal quotation marks, alterations, and citations
21 omitted). Because Plaintiff is requesting statutory
22 damages, the Court has discretion to award a damages
23 amount it deems just. 15 U.S.C. § 1117(c)(2). Thus,
24 despite Plaintiff's request for \$4 million, the Court's
25 authority to determine the amount of damages ensures
26 that the award will correspond to "the seriousness of
27 the defendant's conduct." See IO Grp., Inc. v. Jordon,
28 708 F. Supp. 2d 989, 999 (N.D. Cal. 2010). This factor

1 does not weigh against default judgment.

2 *5. Disputed Material Facts*

3 Because Defendants have failed to respond or appear
4 in this action, there is no possibility of a dispute
5 concerning material facts, as all facts alleged in the
6 Complaint, except those relating to the amount of
7 actual damages, are deemed admitted once default has
8 been entered against a party. Geddes v. United
9 Financial Grp., 559 F.2d 557, 560 (9th Cir. 1977); see
10 Fed. R. Civ. P. 8(b)(6). This factor weighs in favor
11 of default judgment.

12 *6. Excusable Neglect*

13 There is no indication that Defendants have
14 defaulted due to excusable neglect. Plaintiff served
15 Defendants properly and has also provided Defendants
16 with a copy of its Motion for Default Judgment; to
17 date, Defendants have not appeared. See, e.g.,
18 Moroccanoil, 847 F. Supp. 2d at 1202. This factor
19 weighs in favor of default judgment.

20 *7. Policy Favoring Decisions on the Merits*

21 While cases "should be decided upon their merits
22 whenever reasonably possible," Eitel, 782 F.2d at 1472,
23 when a party, like Defendants, has failed to appear or
24 respond in an action, default judgment may be the only
25 just manner to remedy a violation of rights, see
26 Moroccanoil, 847 F. Supp. 2d at 1203. This factor does
27 not weigh against default judgment.

28 Balancing the Eitel factors, the Court finds that

1 the factors weigh almost uniformly in favor of default
2 judgment and, thus, that default judgment is proper as
3 to all of Plaintiff's claims submitted for default
4 judgment except for Plaintiff's cybersquatting claim
5 under 15 U.S.C. § 1125(d).

6 **D. Requested Relief**

7 1. Statutory Damages

8 The court has "wide latitude" and discretion in
9 determining the amount of damages and other relief to
10 award upon default judgment,⁴ especially when a
11 plaintiff elects statutory damages. Elektra Entm't
12 Grp. Inc. v. Crawford, 226 F.R.D. 388, 394 (C.D. Cal.
13 2005)). Plaintiff requests \$4 million in statutory
14 damages, specifically \$2 million "per defendant,"
15 pursuant to 15 U.S.C. 1117(c)(2). Mot. at i. Section
16 1117(c)(2) states that when a plaintiff proves "the use
17
18

19 ⁴ Monetary damages are appropriate in a default
20 judgment if the amount is a liquidated sum or capable
21 of mathematical calculation, such as when statutory
22 damages are elected; in such a case, the actual amount
23 of monetary damages do not need to be "proved up" at an
24 evidentiary hearing. HTS, Inc. v. Boley, 954 F. Supp.
25 2d 927, 947-48 (D. Ariz. 2013) (citing Davis v.
26 Fendler, 650 F.2d 1154, 1161 (9th Cir. 1981)).
27
28

1 of a counterfeit mark⁵ . . . in connection with the
2 sale, offering for sale, or distribution of goods or
3 services," the plaintiff may elect to recovery
4 statutory damages rather than actual damages. 15
5 U.S.C. § 1117(c). Subsection (2) states that "if the
6 court finds that the use of the counterfeit mark was
7 willful, not more than \$2,000,000 per counterfeit mark
8 per type of goods or services sold, offered for sale,
9 or distributed, as the court considers just." 15
10 U.S.C. § 1117(c)(2). Because Plaintiff sufficiently
11 alleged Defendants' "use of a counterfeit mark" and
12 that such use by Defendants was willful, Plaintiff is
13 entitled to elect statutory damages pursuant to 15
14 U.S.C. § 1117(c)(2).

15 a. "*Per Defendant*" Request

16 Plaintiff requests \$2 million "per defendant" for
17 Defendants' trademark infringement. Mot. at 15.
18 Because the two defendants in this case are acting

19 ⁵ ". . . the term "counterfeit mark" means- (i) a
20 counterfeit of a mark that is registered on the
21 principal register in the United States Patent and
22 Trademark Office for such goods or services sold,
23 offered for sale, or distributed and that is in use,
24 whether or not the person against whom relief is sought
25 knew such mark was so registered" 15 U.S.C. §
26
27
28 1116(d)(1)(B)(i).

1 effectively as a single entity, the Court, in its
2 discretion, will not award a statutory damage award
3 "per defendant." See, e.g., Carpet Crops, Inc. v.
4 Carpet Crops, LLC, No. 11-00561, 2012 WL 3929783, at
5 *1, *7 (D. Nev. Sept. 6, 2012) (refusing to award
6 statutory damages "per defendant" under 15 U.S.C. §
7 1117(c) when the two defendants were a corporation and
8 an individual who ran the corporation; instead, the
9 court awarded statutory damages only per infringing
10 mark according to the language of Section 1117).

11 *b. Appropriate Statutory Damages Amount*

12 Neither the Lanham Act nor clear precedent provides
13 guidelines for courts to use when determining an
14 appropriate award of statutory damages for trademark
15 infringement. Wine Grp., LLC. v. USA Cal. Fengshiya
16 Wine Grp., Ltd., No. 11-0421, 2011 WL 3189361, at *3
17 (C.D. Cal. July 26, 2011). For guidance, district
18 courts have looked to copyright infringement cases that
19 awarded statutory damages under the Copyright Act,
20 which contains similar statutory damages provisions
21 with similar legislative purposes as those in the
22 Lanham Act.⁶

24
25 ⁶ "[C]ourts faced with determining statutory damages
26 under the Lanham Act have often been guided by the body
27 of case law developed to interpret the similar
28 statutory damage provision in the Copyright Act, 17

1 In the context of copyright infringement, the U.S.
2 Supreme Court noted that awarding mere "restitution of
3 profit and reparation of injury" would "fall short of
4 an effective sanction for enforcement of the copyright
5 policy" and that deterrence of future infringement and
6 related wrongful conduct was a proper purpose for a
7 damages award, "[e]ven for uninjurious and unprofitable
8 invasions of copyright." F.W. Woolworth Co. v.
9 Contemporary Arts, 344 U.S. 228, 233 (1990). In light
10 of Woolworth, the Ninth Circuit has held that the
11 amount of a statutory damages award under the Copyright
12 Act need not resemble the amount of the plaintiff's
13 actual damages; for instance, in Pausa, the Ninth
14 Circuit, acknowledging both the discretion of the trial
15 court and the policy of deterrence, upheld an award of
16 the maximum allowable statutory damages under the
17 Copyright Act even though the plaintiff had only
18 suffered nominal damages. Peer Int'l Corp. v. Pausa
19 Records, Inc., 909 F.2d 1332, 1336-37 (9th Cir. 1990).

20 Plaintiff has sufficiently alleged that Defendants
21 willfully and knowingly used the UGG counterfeit mark

22 _____
23 U.S.C. § 504(c)." Phillip Morris USA Inc. v. Shalabi,
24 352 F. Supp. 2d 1067, 1075 (C.D. Cal 2004); see also
25 Microsoft Corp. v. Nop, 549 F. Supp. 2d 1233, 1237
26 (E.D. Cal. 2008)(listing seven factors).
27
28

1 on counterfeit footwear that was sold in the United
2 States through Defendants' website. Such intentional
3 and knowing infringement justifies a high award of
4 damages to deter Defendants and others, see Woolworth,
5 344 U.S. at 233, and to compensate Plaintiff for
6 damages it could not discover due to Defendants'
7 failure to appear or respond in this action, see
8 Castworld, 219 F.R.D. 494, 501-02 (C.D. Cal. 2003).
9 Such wrongful conduct by Defendants, combined with
10 Defendants' failure to dispute Plaintiff's requested
11 damages amount, persuades the Court that a high damage
12 award within statutory bounds is reasonable and just.
13 Thus, as Plaintiff has alleged one counterfeit mark,
14 the "UGG" mark, and at least one type of goods,
15 footwear, a maximum statutory damages award of \$2
16 million under 15 U.S.C. § 1117(c)(2) is appropriate in
17 this case.

18 2. Injunctive Relief

19 Plaintiff seeks permanent injunctive relief
20 pursuant to 15 U.S.C. § 1116(a) and 35 U.S.C. § 283.
21 Compl. ¶¶ 39, 52, 59, 67, 71; Mot. at 1. This Court
22 has statutory authority to grant such relief in its
23 discretion. 15 U.S.C. § 1116(a); 35 U.S.C. § 283.

24 The Supreme Court requires that, before a district
25 court grants a permanent injunction, the movant must
26 satisfy a four-factor test by showing: "(1) that it has
27 suffered an irreparable injury; (2) that remedies
28 available at law, such as monetary damages, are

1 inadequate to compensate for that injury; (3) that,
2 considering the balance of hardships between the
3 plaintiff and defendant, a remedy in equity is
4 warranted; and (4) that the public interest would not
5 be disserved by a permanent injunction." eBay, Inc. v.
6 MercExchange, LLC, 547 U.S. 388, 391 (2006); see also
7 Amini Innovation Corp. v. KTY Int'l Mktg., 768 F. Supp.
8 2d 1049 (C.D. Cal. 2011).

9 *1. & 2. Irreparable Harm & Inadequacy of Legal Remedies*

10 Actual irreparable harm must be demonstrated to
11 obtain a permanent injunction. Herb Reed Enters., LLC
12 v. Fla. Entm't Mgmt., Inc., 736 F.3d 1239, 1249 (9th
13 Cir. 2013). Plaintiff must show that "remedies at law,
14 such as monetary damages, are inadequate to compensate
15 for the injury" arising from Defendants' infringement.
16 *Id.* at 1249-50. Plaintiff has sufficiently alleged
17 that it has suffered irreparable injury to its business
18 goodwill and reputation due to Defendants' infringing
19 activities and that, even after receiving a statutory
20 damages award, Plaintiff's injury will not be fully
21 remedied by a monetary award because its injury is hard
22 to compute and Defendants will continue their
23 infringing activity if not enjoined by the Court. See
24 Mot. at 11-12; Compl. ¶ 25, 29; Mot. at 25, Young Decl.

25 *3. Balance of the Hardships*

26 Balancing the hardships involves considering the
27 "relative effect of granting or denying an injunction
28 on the parties." i4i Ltd. v. Microsoft Corp., 598 F.3d

1 831 (Fed. Cir. 2010). Plaintiff will be harmed by
2 continued infringement of its design patents and UGG
3 Trademark. Defendants, on the other hand, are engaged
4 in willful and knowing infringement and face no
5 hardship in permanently refraining from their
6 infringing activity. There is no hardship to a
7 defendant when a permanent injunction would merely
8 require the defendant to comply with law. See, e.g.,
9 DFSB Collective Co. v. Tran, (N.D. Cal., Dec. 21,
10 2011). The balance of the hardships tips in
11 Plaintiff's favor.

12 *4. Public Interest*

13 "[T]he touchstone of the public interest factor is
14 whether an injunction . . . strikes a workable balance
15 between protecting the [holder's] rights and protecting
16 the public from the injunction's adverse effects." *i4i*
17 *Ltd.*, 598 F.3d at 863. Here, granting a permanent
18 injunction would protect Plaintiff's federally
19 protected rights, which is in the public interest, and
20 would have no adverse effect on the public. See Amini,
21 768 F. Supp. 2d at 1057 ("allowing infringement of
22 intellectual property discourages future innovation by
23 failing to provide an adequate forum through which
24 [persons] can protect their own ideas").

25 The Court finds that Plaintiff is entitled to
26 injunctive relief. The terms of the injunctive relief
27 are stated below and in the Court's Judgment.

28

1 **IV. CONCLUSION**

2 Based on the foregoing, the Court **GRANTS in part**
3 **and DENIES in part** Plaintiff's Motion for Default
4 Judgment. The Court **DENIES** the Motion for Default
5 Judgment as to Plaintiff's Cybersquatting claim under
6 15 U.S.C. § 1125(d).

7 The Court **GRANTS** the Motion for Default Judgment as
8 to only the following claims:

9 (1) Trademark Infringement in violation of 15
10 U.S.C. §§ 1114(a) and 1125(a);

11 (2) Unfair Competition and False Designation of
12 Origin in violation of 15 U.S.C. § 1125(a);

13 (3) Dilution of a Famous Mark in violation of 15
14 U.S.C. § 1125(c); and

15 (4) Patent Infringement of Plaintiff's design
16 patents No. D599,999 and No. D616,189, in violation of
17 35 U.S.C. § 271;

18 and for the following relief:

19 1. Plaintiff is awarded statutory damages of two
20 million dollars (\$2,000,000) pursuant to 15 U.S.C. §
21 1117(c)(2), and post-judgment interest at the federal
22 statutory rate pursuant to 28 U.S.C. § 1961;

23 2. Defendants are each permanently enjoined from:
24 (a) importing, selling, marketing, offering for sale,
25 or advertising in the United States any goods or
26 materials bearing Plaintiff's UGG® Trademark, attached
27 for reference as Exhibit A, any colorable imitation of
28 the UGG® Trademark, or the mark "UGG";

1 (b) using Plaintiff's UGG® Trademark, or any
2 reproduction, copy, counterfeit, or colorable imitation
3 of the UGG® Trademark in the United States in
4 connection with the promotion, advertisement, display,
5 sale, offer for sale, manufacture, production,
6 circulation, or distribution of any products with such
7 design as to relate or connect, or tend to relate or
8 connect, in any way to Deckers' UGG® brand of products;

9 (c) using any trademark that imitates or is confusingly
10 similar to Plaintiff's UGG® Trademark;

11 (d) making any statement or representation whatsoever,
12 or using any false designation of origin or false
13 description, or performing any act, which can or is
14 likely to lead the trade or public, or individual
15 members thereof, to believe that any product
16 manufactured, distributed, or sold by Defendants is in
17 any manner associated with, sponsored by, or connected
18 with Plaintiff, or are sold, manufactured, licensed,
19 sponsored, approved, or authorized by Plaintiff;

20 (e) using any mark likely to dilute, as defined by 15
21 U.S.C. § 1125(c), Plaintiff's famous UGG mark;

22 (f) importing, offering for sale, or selling any
23 product not authorized by Plaintiff that is a
24 reproduction, copy, or colorable imitation of the
25 ornamental features of the design claimed in
26 Plaintiff's U.S. Patent No. D599,999, attached for
27 reference as Exhibit B, and/or the design claimed in
28 Plaintiff's U.S. Patent No. D616,189, attached for

1 reference as Exhibit C, with the ornamental features
2 including a vertical slit in the boot's material on the
3 outward side of the upper portion of the boot with fur
4 or fur-like material protruding from the slit and with
5 the slit fastened together, or overlaid, by buttons
6 hooked into a band that is attached to the material on
7 the opposite side of the slit from where the buttons
8 are attached to the material;

9 (g) using, linking to, exercising control over,
10 operating, hosting, or otherwise owning any domain name
11 or website, including, but not limited to,
12 ozwearuggs.com and ozwearuggs.com.au, to engage in
13 activity that violates the terms of this Order or that
14 is involved with the distribution, advertising,
15 offering for sale, or sale of any product that
16 infringes on Deckers UGG® Trademark, U.S. Patent No.
17 D599,999, and/or U.S. Patent No. D616,189; and

18 (h) effecting assignments or transfers, forming new
19 entities or associations or utilizing any device for
20 the purpose of circumventing or otherwise avoiding the
21 prohibitions in this Order or aiding, abetting,
22 contributing to, or otherwise assisting anyone from
23 infringing upon Plaintiff's UGG® Trademark, U.S. Patent
24 No. D599,999, and/or U.S. Patent No. D616,189;

25 3. Defendants are ordered to immediately, upon
26 Notice of this Order, transfer to Plaintiff, at the
27 address provided by Plaintiff, all footwear, products,
28 goods, labels, signs, packages, wrappers, receptacles,

1 advertisements, and/or materials in Defendants'
2 possession or control that bear the mark "UGG" or any
3 simulation, reproduction, counterfeit, copy, or
4 colorable imitation of Plaintiff's UGG® Trademark, as
5 well as any footwear bearing the patented design of
6 U.S. Patent No. D5999,999 or U.S. Patent No. D616,189.

7 The balance of Plaintiff's claims is dismissed,
8 including Plaintiff's state-law claims and federal
9 cybersquatting claim. A Final Judgment will follow.

10 **IT IS SO ORDERED.**

11
12 DATED: September 18, 2014

RONALD S.W. LEW

13 **HONORABLE RONALD S.W. LEW**
14 Senior U.S. District Judge
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