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8 **United States District Court**  
9 **Central District of California**

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11 DECKERS OUTDOOR CORPORATION,

12 Plaintiff,

13 v.

14 ROMEO & JULIETTE, INC.; THOMAS  
15 ROMEO; and DOES 1-10, inclusive,

16 Defendants.  
17

Case № 2:15-cv-02812-ODW (PLAx)

**ORDER GRANTING IN PART AND  
DENYING IN PART DEFENDANTS'  
MOTION FOR SUMMARY  
JUDGMENT [101]**

18 **I. INTRODUCTION**

19 Plaintiff Deckers Outdoor Corporation designs and sells “UGG” brand boots  
20 and owns several design patents related to those boots. Defendant Romeo & Juliette,  
21 Inc., owned by Defendant Thomas Romeo, also designs and sells boots under the  
22 brand names BearPaw and Attix. Deckers alleges that several of Defendants’ boot  
23 styles infringe on three of its design patents: (1) U.S. Patent No. D599,999 (“the ’999  
24 patent”); (2) U.S. Patent No. D616,189 (“the ’189 patent”); and (3) U.S. Patent No.  
25 D582,650 (“the ’650 patent”). Defendants now move for summary judgment on their  
26 affirmative defenses of laches and equitable estoppel with respect to the ’650 patent  
27 and ’999 patent. The Court concludes that equitable estoppel indisputably bars  
28 assertion of the ’650 patent, but that a reasonable jury could find against Defendants

1 on both laches and equitable estoppel with respect to the '999 patent. Accordingly,  
2 the Court **GRANTS** Defendants' Motion with respect to the '650 patent and **DENIES**  
3 the Motion with respect to the '999 patent.<sup>1</sup> (ECF No. 101.)

## 4 **II. BACKGROUND**

5 As previously noted, the two patents relevant to this Motion are the '999 patent  
6 and the '650 patent. (Statement of Uncontroverted Facts ("SUF") 4, 6, 8, ECF No.  
7 110.) The '999 patent claims the boot design embodied in Deckers' Bailey Button  
8 boot, and the '650 patent claims the design embodied in its Classic Cardy boot. (SUF  
9 52.) Deckers alleges that Defendants' Victorian boot, Abigail Youth boot, Abigail  
10 Toddler boot, Diva boot, and Elena boot<sup>2</sup> infringe on the '999 patent, and that  
11 Defendants' Knit Tall boot infringes on the '650 patent. (See Compl. ¶¶ 22, 44, ECF  
12 No. 1; Opp'n at 1 n.2, ECF No. 109.)

13 Deckers began selling its Classic Cardy boot in Spring 2008. (SUF 53.) In late  
14 2008, Deckers sued fifteen defendants in a single action, alleging that each of them  
15 designed boots that infringed on the '650 patent. (SUF 13, 14.) In March 2009,  
16 Deckers sent a cease-and-desist letter to Defendants, claiming that Defendants' Knit  
17 Tall boot infringed on the '650 patent. (SUF 17.) In the letter, Deckers asserted that it  
18 was "committed to aggressively protecting its [intellectual property] rights" and  
19 enclosed a copy of the 2008 lawsuit Deckers had filed against those fifteen  
20 defendants. (SUF 17–18.) A month later, Defendants offered to cease production of  
21 the Knit Tall boot and to pay Deckers \$1,500, which was based on Defendants' sale of  
22 240 Knit Tall boots to date. (SUF 21; Alaniz Decl., Ex. 7, ECF No. 103-4.) Deckers  
23 never responded to this offer (SUF 23), and there is no indication that Defendants ever  
24 ceased production of the boot.

25 In November 2010, Deckers filed a lawsuit against Defendants in which it  
26 asserted trade dress infringement and dilution claims. (SUF 27.) Deckers alleged that

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27 <sup>1</sup> After considering the papers submitted by the parties, the Court deemed the matter appropriate  
28 for decision without oral argument. Fed. R. Civ. P. 78(b); C.D. Cal. L.R. 7-15.

<sup>2</sup> Defendants generally describe these as their "one-button boots."

1 Defendants' Knit Tall boot infringed on the trade dress embodied in Deckers' Classic  
2 Cardy boot. (*See* SUF 28.) At no time did Deckers assert any patent infringement  
3 claims in that lawsuit. (SUF 34.) In February 2012, the parties settled the case. (SUF  
4 35.) As part of the settlement, Defendants agreed to make certain changes to the  
5 design of the Knit Tall boot. (Bereda Decl., Ex. 3, ECF Nos. 111, 112.) In exchange,  
6 Deckers agreed that once Defendants made those changes, any similarities between  
7 the Knit Tall boot and the Classic Cardy boot would not be deemed to infringe on  
8 Deckers' trade dress rights. (*Id.*) And while the agreement appeared to contemplate  
9 the continued sale of the Knit Tall boot, the agreement also stated that "[n]othing  
10 herein shall be deemed a waiver of any intellectual property claims not asserted in the  
11 Litigation." (*Id.*)

12 In April 2015, Deckers filed the instant action, alleging (among other things)  
13 that Defendants' Knit Tall boot infringes on the '650 patent and that Defendants' one-  
14 button boots infringe on the '999 patent. (ECF No. 1.) Between 2009 and the filing  
15 of this lawsuit, Deckers sold nearly 750,000 knit boots and 700,000 one-button boots.  
16 (SUF 48, 51.) Defendants' Motion for Summary Judgment concerning these two  
17 infringement claims is now before the Court for decision.

### 18 III. LEGAL STANDARD

19 A court "shall grant summary judgment if the movant shows that there is no  
20 genuine dispute as to any material fact and the movant is entitled to judgment as a  
21 matter of law." Fed. R. Civ. P. 56(a). Courts must view the facts and draw reasonable  
22 inferences in the light most favorable to the nonmoving party. *Scott v. Harris*, 550  
23 U.S. 372, 378 (2007). A disputed fact is "material" where the resolution of that fact  
24 might affect the outcome of the suit under the governing law, and the dispute is  
25 "genuine" where "the evidence is such that a reasonable jury could return a verdict for  
26 the nonmoving party." *Anderson v. Liberty Lobby, Inc.*, 477 U.S. 242, 248 (1968).  
27 Conclusory or speculative testimony in affidavits is insufficient to raise genuine issues  
28 of fact and defeat summary judgment. *Thornhill's Publ'g Co. v. GTE Corp.*, 594 F.2d

1 730, 738 (9th Cir. 1979). Moreover, though the court may not weigh conflicting  
2 evidence or make credibility determinations, there must be more than a mere scintilla  
3 of contradictory evidence to survive summary judgment. *Addisu v. Fred Meyer*, 198  
4 F.3d 1130, 1134 (9th Cir. 2000). Where the moving and nonmoving parties’ versions  
5 of events differ, courts are required to view the facts and draw reasonable inferences  
6 in the light most favorable to the nonmoving party. *Scott*, 550 U.S. at 378.

#### 7 **IV. DISCUSSION**

8 Defendants argue that Deckers’ infringement claim concerning the ’999 patent  
9 and the ’650 patent are barred by laches and equitable estoppel. (*See generally* ECF  
10 No. 101.) The Court concludes that the ’650 patent is barred by equitable estoppel  
11 and thus does not address laches with respect to that patent. However, the Court  
12 concludes that genuine issues of fact remain preclude summary judgment on both  
13 equitable estoppel and laches with respect to the ’999 patent.

##### 14 **A. The ’650 Patent**

15 Defendants argue that Deckers’ failure to assert the ’650 patent for six years  
16 after sending the cease-and-desist letter led Defendants to believe that Deckers had  
17 abandoned the claim. (Mot. at 18–22, ECF No. 101.) Defendants contend that it  
18 made substantial investments in marketing and selling their allegedly infringing Knit  
19 Tall boot in reliance that on Deckers’ misleading inaction, and thus it would be  
20 inequitable to permit Deckers to proceed with its infringement claims now. (*Id.* at 22–  
21 23.) The Court agrees.

22 Equitable estoppel is a complete defense to a patent infringement claim. *A.C.*  
23 *Aukerman Co. v. R.L. Chaides Const. Co.*, 960 F.2d 1020, 1028 (Fed. Cir. 1992) (en  
24 banc), *abrogated on other grounds by SCA Hygiene Prod. Aktiebolag v. First Quality*  
25 *Baby Prod., LLC*, 137 S. Ct. 954 (2017). To establish the defense, the defendant must  
26 prove each of the following elements: (1) “[t]he patentee, through misleading conduct,  
27 leads the alleged infringer to reasonably infer that the patentee does not intend to  
28 enforce its patent against the alleged infringer”; (2) “[t]he alleged infringer relies on

1 that conduct”; (3) “[d]ue to its reliance, the alleged infringer will be materially  
2 prejudiced if the patentee is allowed to proceed with its claim.” *Id.*

3 **1. Misleading Conduct**

4 This element is satisfied where “[t]he alleged infringer . . . know[s] or [is]  
5 reasonably . . . able to infer that the patentee has known of the former’s activities for  
6 some time,” and the patentee engages in conduct that “support[s] an inference that the  
7 patentee did not intend to press an infringement claim against the alleged infringer.”  
8 *A.C. Aukerman Co.*, 960 F.2d at 1042. “Conduct” by the patentee that is sufficient to  
9 trigger an equitable estoppel defense “may include specific statements, action,  
10 inaction, or silence where there was an obligation to speak.” *Id.* at 1028. Silence or  
11 inaction alone is insufficient to give rise to equitable estoppel; rather, silence or  
12 inaction “must be combined with other facts respecting the relationship or contacts  
13 between the parties to give rise to the necessary inference that the claim against the  
14 defendant is abandoned.” *Id.* at 1043–44. “In the most common situation, the  
15 patentee specifically objects to the activities currently asserted as infringement in the  
16 suit and then does not follow up for years.” *Id.* at 1042; *see also, e.g., Advanced*  
17 *Hydraulics, Inc. v. Otis Elevator Co.*, 525 F.2d 477, 482 (7th Cir. 1975) (patentee’s  
18 conduct was misleading where it issued a cease and desist letter threatening immediate  
19 action but failed to take any action for five years).

20 Here, there is no question that Deckers’ conduct was misleading—and  
21 egregiously so. Deckers’ March 2009 letter stated that it was aware of Defendants’  
22 Knit Tall boot style and the boot’s ostensible similarity to the ’650 design patent, and  
23 that Deckers intended to vigorously enforce its patent rights. Yet despite an ongoing  
24 and litigious relationship between Deckers and Defendants, Deckers failed to assert  
25 any such claims for the next six years. First, Deckers never added Defendants to the  
26 2008 lawsuit it filed against fifteen defendants for infringing the ’650 patent. Second,  
27 despite suing Defendants for trade dress infringement and dilution with respect to the  
28 Knit Tall boot, Deckers did not assert any patent infringement claims as to that very

1 same boot. In fact, the settlement agreement arising from that lawsuit clearly  
2 contemplated Defendants continuing to manufacture and sell the Knit Tall boot (albeit  
3 with slight modifications). Finally, a further three years of silence passed before  
4 Deckers filed this action. Based on these facts, any reasonable factfinder would  
5 conclude that Deckers had led Defendants to believe that it no longer intended to  
6 assert the '650 patent.

7 Deckers argues that its conduct was not misleading because it expressly carved  
8 out unasserted intellectual property claims from the release in the settlement  
9 agreement—which would include unasserted claims for patent infringement.<sup>3</sup> Under  
10 the circumstances, however, this is insufficient to raise a genuine issue of fact as to  
11 whether Deckers' conduct was misleading. By that point, there were simply too many  
12 other indicia that Deckers no longer had any interest in asserting the '650 patent with  
13 respect to the Knit Tall boot. A general carve-out of any “intellectual property claims  
14 not asserted in this litigation” would thus have done little to suggest to Defendants  
15 that a claim for patent infringement concerning *this* specific boot style was still on the  
16 table. Instead, Defendants would have likely (and reasonably) assumed that the carve-  
17 out related to intellectual property claims concerning *other* boot styles that were not  
18 the subject of the litigation. As a result, the Court concludes that Defendants have  
19 satisfied this element.

## 20 **2. Reliance**

21 This element is satisfied where “[t]he accused infringer . . . show[s] that . . . it  
22 substantially relied on the misleading conduct of the patentee in connection with  
23 taking some action.” *A.C. Aukerman*, 960 F.2d at 1042–43. “To show reliance, the  
24 infringer must have had a relationship or communication with the plaintiff which lulls

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25 <sup>3</sup> Deckers asserts numerous other reasons why it did not unreasonably delay in bringing suit.  
26 (See generally Opp'n at 3–7, 9–13.) It is unclear if these arguments relate only to Defendants'  
27 laches defense or whether they are also intended to rebut Defendants' equitable estoppel defense. If  
28 the latter, they fail because Deckers does not show that Defendants were aware of any of these  
reasons. See *A.C. Aukerman*, 960 F.2d at 1034 (unlike laches, “equitable estoppel focuses on what  
the defendant has been led to reasonably believe from the plaintiff's conduct”).

1 the infringer into a sense of security in [engaging in the infringing activity].” *Id.* at  
2 1043. This element is satisfied for much the same reasons previously described.  
3 Defendants offered in 2009 to cease selling the boot if Deckers so wished. Despite  
4 this, Deckers ignored the offer, failed to assert any infringement claims despite  
5 ongoing litigation between the two regarding that exact boot, and then implicitly  
6 accepted Defendants’ continued sale of the boot in settling that action. The only  
7 reasonable inference from the evidence is that Defendants continued selling the boot  
8 after April 2009 in reliance on Deckers’ misleading conduct.

### 9 **3. Prejudice**

10 “Finally, the accused infringer must establish that it would be materially  
11 prejudiced if the patentee is now permitted to proceed. . . . [T]he prejudice may be a  
12 change of economic position or loss of evidence.” *A.C. Aukerman*, 960 F.2d at 1043.  
13 Defendants assert both economic and evidentiary prejudice. As to economic  
14 prejudice, Defendants note that they have sold nearly 750,000 pairs of knit boots to  
15 date in reliance on Deckers’ misleading conduct. (Mot. at 9–10, 13–17.) Defendants  
16 also assert that they invested substantial resources to develop and market the Knit Tall  
17 boots. (*Id.*) As to evidentiary prejudice, Defendants argue that a critical witness—  
18 Jean Romeo—passed away in 2011, and that she was the only person who would have  
19 remembered the design process for the Knit Tall boot. (*Id.* at 7–9, 13–17.)  
20 Defendants also argue that evidence relating to numerous potential prior art references  
21 are no longer available to support their invalidity counterclaims. (*Id.*)

22 The Court concludes that Defendants have suffered clear economic prejudice as  
23 a result of Deckers’ misleading conduct. In their April 2009 letter to Deckers,  
24 Defendants offered to completely cease selling the Knit Tall boot and to pay \$1,500 to  
25 Deckers, which was based on profits from selling 240 Knit Tall boots. Had Deckers  
26 accepted the offer, this would have been the extent of Defendants’ loss (or at least  
27 something close to it). Now, six years later, Defendants have sold over 750,000 knit  
28 boots, a substantial portion of which form the basis of Deckers’ damages claim.

1 (Compl., Prayer for Relief ¶¶ 6, 7, 9, ECF No. 1.) The substantial increase in  
2 Defendants’ exposure constitutes clear economic harm. *See A.C. Aukerman*, 960 F.2d  
3 at 1033 (“[A] patentee may [not] intentionally lie silently in wait watching damages  
4 escalate, particularly where an infringer, if he had had notice, could have switched to a  
5 noninfringing product.” (citations omitted)); *Aspex Eyewear Inc. v. Clariti Eyewear,*  
6 *Inc.*, 605 F.3d 1305, 1312 (Fed. Cir. 2010) (“Clariti’s development of its AirMag®  
7 business, in reliance on Aspex’s silence after its aggressive letters, represents a  
8 significant change in economic position and constitutes material prejudice sufficient to  
9 support equitable estoppel.”). Moreover, Defendants likely suffered economic harm  
10 in the form of lost business opportunity—that is, had Deckers accepted Defendants’  
11 offer to cease selling the product in 2009, the time and money Defendants  
12 subsequently invested in the Knit Tall boot could have been spent on other products or  
13 business ventures.

14 Based on the clear economic prejudice Defendants suffered, the Court need not  
15 address the evidentiary prejudice Defendants purportedly suffered.

#### 16 **4. Intentional Copying**

17 Deckers argues that Defendants should be precluded from asserting an equitable  
18 estoppel defense because they intentionally copied Deckers’ boot designs. (Opp’n at  
19 13–14.) An alleged infringer may be precluded from asserting an equitable estoppel  
20 defense where the infringer “has engaged in particularly egregious conduct that would  
21 change the equities significantly in plaintiff’s favor.” *A.C. Aukerman*, 60 F.2d at  
22 1033. This includes conscious copying of the patentee’s invention or design. *Id.* at  
23 1033, 1044. However, conscious copying does not automatically preclude an  
24 equitable estoppel defense; rather, it is simply another factor for the Court to weigh in  
25 determining whether the equities are in the infringer’s favor. *Id.*

26 Deckers points to the following as evidence of copying: (1) Defendants have a  
27 “history of knocking-off UGG® styles beginning in or around 2009”; (2) the visual  
28 appearance of Defendants’ boots are nearly identical to the boots depicted in Deckers’



1 patents; (3) customer reviews of Defendants’ products characterize them as “cheaper”  
2 versions of UGG® boots; (4) e-mails from Defendants’ employees discussing the  
3 possibility of “duplicating” the look of UGG® boots; and (5) the absence of any  
4 evidence (including design sketches) showing how Defendants conceived of the  
5 infringing boots in this action. (Opp’n at 13–14; SUF 89–99.)

6 This evidence does not tip the equities in Deckers’ favor. First, Deckers’ bare  
7 assertion that Defendants have “a history” of knocking off UGG® styles is not  
8 supported by any evidence and thus is meaningless on summary judgment. Second,  
9 while substantial similarity in the appearance of certain boots may give rise to an  
10 inference of copying, customers’ subjective perceptions of the similarity between  
11 these boots add nothing to the conscious copying inquiry. Third, none of the evidence  
12 of conscious copying (aside from the purported visual similarity between the ’650  
13 patent and the Knit Tall boot) relate specifically to the Knit Tall boot, and thus it is  
14 unclear that this evidence should even factor into the equation here. *Cf. Salas v.*  
15 *Sierra Chem. Co.*, 59 Cal. 4th 407, 432 (2014) (noting that “the equitable doctrine of  
16 unclean hands applies when a plaintiff has acted unconscionably, in bad faith, or  
17 inequitably *in the matter in which the plaintiff seeks relief*. The misconduct which  
18 brings the clean hands doctrine into operation must relate directly to the transaction  
19 concerning which the complaint is made, i.e., it must pertain to the very subject matter  
20 involved and affect the equitable relations between the litigants.” (citations omitted)  
21 (emphasis added)). Whatever relevant evidence of conscious copying remains after  
22 these considerations is insufficient to create a genuine issue as to the application of  
23 equitable estoppel. Deckers could have nipped this entire dispute in the bud in April  
24 2009 by accepting Defendants’ offer to cease selling the Knit Tall boot. Deckers can  
25 hardly complain about Defendants’ purported copying of its design when it so easily  
26 could have stopped the copying virtually at its inception—and at almost no cost to  
27 Deckers.

28 For these reasons, the Court concludes that Deckers is equitably estopped from

1 asserting its claim for infringement of the '650 patent. The Court therefore does not  
2 address laches with respect to this patent.

3 **B. The '999 Patent**

4 **1. Equitable Estoppel**

5 Defendants argue that Deckers is also equitably estopped from asserting the  
6 '999 patent. Defendants contend that they began openly and notoriously selling their  
7 Victorian boot style in July 2009 and began selling their Abigail Youth boot style in  
8 December 2009. (Mot. at 4, ECF No. 101.) Both boot styles (at least in their current  
9 form) are similar in that they both have one large button on the side of the boot. (SUF  
10 81.) Although Deckers never sent a cease-and-desist letter to Defendants concerning  
11 either boot, Deckers asserted trade dress claims against Defendants concerning the  
12 Victorian boot style in the 2010 Action. (SUF 29; Alaniz Decl., Ex. 1, ECF No. 103.)  
13 Defendants allege that Deckers knew (or should have known) by 2009—or at least by  
14 2010—that it was selling “one-button boots,” and thus Deckers’ failure to assert a  
15 patent infringement claim until April 2015 was misleading. (Mot. at 12–13.) The  
16 Court concludes that genuine issues of fact preclude summary judgment here.

17 The overarching problem with Defendants’ argument is that they fail to  
18 distinguish among the myriad one-button boot styles that are the subject of this  
19 infringement claim. As previously noted, Defendants sell multiple “one-button boot”  
20 styles, five of which are at issue in this lawsuit. Despite this, Defendants do not even  
21 address three of the styles; they only address the Victorian boot style and the Abigail  
22 Youth boot style. Moreover, the facts Defendants assert concerning these two boot  
23 styles are ambiguous at best. For example, Deckers presents evidence that at the time  
24 of the 2010 Action, there was a style of Victorian boot had *two* buttons—one on each  
25 side of the boot. (SUF 75.) According to Deckers, this two-button version does not  
26 infringe on the '999 patent; only the one-button version at issue in this lawsuit does.  
27 (SUF 77.) Defendants do not dispute the existence of a two-button Victorian boot at  
28 the time of the 2010 Action. Moreover, the pictures of the Victorian boot in the

1 complaint in the 2010 Action depicts only one side of the boot, and thus it is not clear  
2 which version was at issue in that lawsuit. As a result, there is insufficient evidence  
3 for the Court to conclude that “the patentee has known of the [infringer’s] activities  
4 for some time,” as is required for an equitable estoppel defense. *A.C. Aukerman Co.*,  
5 960 F.2d at 1042.

6 Similarly, while Defendants state that they began selling the Abigail Youth boot  
7 in December 2009, they do not include any specific information (or evidence) as to  
8 where and how *that particular* style was sold and marketed; Defendants merely make  
9 broad and sweeping statements that it sold its “one-button boots” openly and  
10 notoriously. (Mot. at 4; SUF 24.) This is insufficient for the Court to infer that  
11 Deckers undoubtedly knew of the Abigail Youth style boot in December 2009.  
12 Finally, despite Defendants’ insistence that the 2010 Action included the same one-  
13 button boot styles at issue in this lawsuit, there is no evidence at all that the 2010  
14 Action ever included the Abigail Youth boot, the Abigail Toddler boot, the Diva boot,  
15 or the Elena boot. It is troubling that Defendants attempt to sweep all of these  
16 material differences between the various boot styles under the rug by broadly referring  
17 to them all as “one-button boots.”

18 In sum, the Court cannot conclude that there was even any unwarranted delay in  
19 bringing suit, let alone delay that misled Defendants, and thus the Court declines to  
20 grant summary judgment on Deckers’ ’999 patent based on equitable estoppel.

## 21 **2. Laches**

22 Defendants also argue that the doctrine of laches bars assertion of the ’999  
23 patent. A laches defense is similar to an equitable estoppel defense, except that laches  
24 focuses on the unreasonableness of the patentee’s delay in bringing suit rather than on  
25 whether the patentee’s conduct misled the defendant.<sup>4</sup> To establish a laches defense,  
26 the defendant must show: (1) “the patentee’s delay in bringing suit was unreasonable

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27 <sup>4</sup> Of course, a patentee’s delay in bringing suit, when combined with other factors, will often  
28 mislead the infringer. *See A.C. Aukerman Co.*, 960 F.2d at 1043. Thus, these two defenses  
frequently overlap.

1 and inexcusable”; and (2) “the alleged infringer suffered material prejudice  
2 attributable to the delay.” *A.C. Aukerman Co.*, 960 F.2d at 1028. The Supreme Court  
3 recently held that laches does not bar recovery of damages where, as here, the patentee  
4 brings suit within the limitations period (i.e., within six years after the infringement  
5 occurred). *SCA Hygiene Prod. Aktiebolag v. First Quality Baby Prod., LLC*, 137 S.  
6 Ct. 954, 967 (2017). Nonetheless, laches may still bar injunctive relief. *SCA Hygiene*  
7 *Prod. Aktiebolag v. First Quality Baby Prod., LLC*, 807 F.3d 1311, 1332 (Fed. Cir.  
8 2015) (en banc), *vacated on other grounds*, 137 S. Ct. 954 (2017). To be entitled to  
9 injunctive relief, a patentee “must demonstrate: (1) that it has suffered an irreparable  
10 injury; (2) that remedies available at law, such as monetary damages, are inadequate  
11 to compensate for that injury; (3) that, considering the balance of hardships between  
12 the plaintiff and defendant, a remedy in equity is warranted; and (4) that the public  
13 interest would not be disserved by a permanent injunction.” *eBay Inc. v.*  
14 *MercExchange, L.L.C.*, 547 U.S. 388, 391 (2006). As the Federal Circuit recently  
15 held:

16           Consideration of laches fits naturally into this framework. . . . Many of  
17 the facts relevant to laches, such as the accused infringer’s reliance on the  
18 patentee’s delay, fall under the balance of the hardships factor. Unreasonable delay in bringing suit may also be relevant to a patentee’s  
19 claim that continued infringement will cause it irreparable injury. More  
20 than anything, district courts should consider all material facts, including  
21 those giving rise to laches, in exercising its discretion under *eBay* to grant  
or deny an injunction.

22 *SCA Hygiene Prod. Aktiebolag*, 807 F.3d at 1331.

23           Here, while Defendants extensively address the unreasonableness of Deckers’  
24 delay in bringing suit, Defendants do not address any of the *eBay* factors. As a result,  
25 Defendants have not shown that Deckers’ delay in bringing suit outweighs the other  
26 equitable factors that may favor entering an injunction. Consequently, Defendants  
27 have not met their burden of showing that the *only* reasonable conclusion is that  
28 injunctive relief is barred.

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**V. CONCLUSION**

For the reasons discussed above, the Court **GRANTS IN PART** and **DENIES IN PART** Defendants' Motion for Summary Judgment. (ECF No. 101.) The Court holds that Deckers' claim for infringement of the '650 patent is barred based on equitable estoppel. However, genuine issues of fact exist as to whether Deckers' claim for infringement of the '999 patent is barred by either laches or equitable estoppel.

**IT IS SO ORDERED.**

June 13, 2017

  
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**OTIS D. WRIGHT, II**  
**UNITED STATES DISTRICT JUDGE**