

**IN THE UNITED STATES DISTRICT COURT
FOR THE EASTERN DISTRICT OF VIRGINIA
RICHMOND DIVISION**

Brooks Sports, Inc.)	
)	
Plaintiff,)	Case No. <u>3:24-cv-668</u>
)	
v.)	JURY TRIAL DEMANDED
)	
PUMA SE,)	
)	
Defendant.)	
)	
)	
)	

COMPLAINT

Plaintiff Brooks Sports, Inc. (“Brooks” or “Plaintiff”), by and through their undersigned counsel, file this Complaint against PUMA SE (“PUMA” or “Defendant”) and allege as follows upon actual knowledge with respect to themselves and their own acts, and upon knowledge, information, and belief as to all other matters:

NATURE OF THE ACTION

1. This is an action for declaratory judgment of noninfringement of a United States Patent pursuant to the Declaratory Judgment Act, 28 U.S.C. §§ 2201-2202, and the Patent Laws of the United States, 35 U.S.C. §§ 1 *et seq.*

2. Brooks is a leader in developing and implementing new technologies for performance running shoes and has maintained the largest market share in adult performance running footwear for ten consecutive quarters in the United States national retail market. For the past two years, PUMA has waged a worldwide legal campaign against Brooks on multiple fronts, involving trademarks and patents. Recently, PUMA accused Brooks’ recent addition to its highly

successful Glycerin running shoe product line of infringement of another utility patent. Brooks refuses to wait and see when and where PUMA will sue for infringement.

3. Brooks seeks declaratory judgment that none of the claims of U.S. Patent No. 12,096,825 (“the ’825 Patent”; Ex. A) are infringed by Brooks’ line of Glycerin 21 running shoes (including the Glycerin 21, the Glycerin GTS 21, the Glycerin StealthFit 21, and the Glycerin StealthFit GTS 21) (collectively, the “Glycerin 21 product line”), and for such other relief as the Court deems just and proper.

4. Plaintiff seeks this relief because PUMA has threatened to hold Brooks liable for patent infringement, specifically alleging that Brooks’ Glycerin 21 product line infringes claims 1-30 of its then-unpublished Application No. 18/651,163 (“the ’163 Application”), which issued as claims 1-11, 13-21, and 23-32 of the ’825 Patent. PUMA’s threat against Brooks creates an actual and justiciable controversy between Plaintiff and Defendant.

THE PARTIES

5. Plaintiff Brooks Sports, Inc. is a corporation organized and existing under the laws of Washington State and maintains its principal place of business at 3400 Stone Way N, Suite 500, Seattle, WA 98103.

6. Defendant PUMA SE is organized and existing under the laws of Germany, with its principal place of business at Puma Way 1, 91074 Herzogenaurach, Germany. PUMA is a multinational company that designs and manufactures athletic and casual footwear, apparel, and accessories. PUMA SE does not have facilities within the United States.

JURISDICTION AND VENUE

7. The Court has subject matter jurisdiction over this action pursuant to 28 U.S.C. §§ 1331 and 1338(a), because this action involves claims arising under the patent laws of the

United States, 35 U.S.C. §§ 1, *et seq.*, and under the Declaratory Judgment Act, 28 U.S.C. §§ 2201 and 2202.

8. As PUMA is the assignee of record for the '825 Patent, the Court has personal jurisdiction over PUMA pursuant to 35 U.S.C. § 293, which states that “[e]very patentee not residing in the United States may file in the Patent and Trademark Office a written designation stating the name and address of a person residing within the United States on whom may be served process or notice of proceedings affecting the patent or rights thereunder” and that “if no person has been designated, the United States District Court for the Eastern District of Virginia shall have jurisdiction and summons shall be served by publication or otherwise as the court directs.” Further, “[t]he court shall have the same jurisdiction to take any action respecting the patent or rights thereunder that it would have if the patentee were personally within the jurisdiction of the court.” *Id.* PUMA does not reside in the United States. PUMA’s principal place of business is in Germany, and it has not filed a written designation stating the name and address of a person residing within the United States on whom process or notice of proceedings affecting the '825 Patent may be served. As a result, this Court has personal jurisdiction over PUMA.

9. In the alternative, PUMA is subject to this Court’s specific personal jurisdiction consistent with the principles of due process and Federal Rule of Civil Procedure 4(k)(2) because: (1) Brooks’ claim arises under federal law, as set forth above; (2) PUMA is not subject to jurisdiction in any state’s courts of general jurisdiction; and (3) exercising jurisdiction is consistent with the United States Constitution and laws.

10. Venue is proper in this judicial district pursuant to 28 U.S.C. §§ 1391 and 1400. Pursuant to 28 U.S.C. § 1391(c)(3), PUMA does not reside in the United States and thus may be sued in any judicial district where the court has personal jurisdiction. Additionally, pursuant to 28

U.S.C. § 1391(b)(3), venue in this District is proper because PUMA is subject to this Court's jurisdiction under 35 U.S.C. § 293.

**BROOKS AND ITS HIGHLY SUCCESSFUL
GLYCERIN RUNNING SHOE LINE**

11. Brooks sells its products in more than 50 countries worldwide and is well regarded in the industry. In 2024 alone, Brooks won the “best workout shoe” at the NBC Select Wellness Awards, the “best [shoe] for recovery and easy runs” at the Self Sneaker Awards, and took home awards from Men's Health for the “year's best sneakers” and from Runner's World for the “best daily trainers.” See Brooks Running, *The Glycerin StealthFit 21 is Recognized among the Best Workout Shoes for Women with an NBC Select Best of Wellness Award*, STRAVA, (Aug. 28, 2024), <https://www.strava.com/clubs/81417/posts/31909827>; Sara Coughlin, *The 2024 SELF Sneaker Awards: 30 Top-Notch Pairs for Basically Every Activity*, SELF, (Aug. 21, 2024), <https://www.self.com/story/self-sneaker-awards-2024>; Brett Williams & Ted Stafford, *The 2024 Men's Health Sneaker Awards*, MEN'S HEALTH (Aug. 14, 2024), <https://www.menshealth.com/style/a61807163/mens-health-sneaker-awards-2024/>; Adam Schram, *The 14 Best Running Shoes of 2024*, RUNNER'S WORLD, (Jul. 19, 2024), <https://www.runnersworld.com/gear/a19663621/best-running-shoes/>. Brooks shoes are worn by world-class athletes, most recently at the 2024 Paris Olympic Games. Brooks sponsored numerous Olympians and Paralympians, including 1500m silver medalist, Josh Kerr, heptathlete, Chari Hawkins, and rugby player, Ilona Maher.

12. For over two decades, Brooks has sold its Glycerin line of running shoes—and the shoes have been very successful. Justin Kent, a multiple time Canadian National team member and marathoner, stated that over the years, “the Glycerin's popularity has engulfed the North American market.” See Justin Kent, *Dare I say, but could this be the best Brooks Glycerin ever?*,

RACKETS & RUNNERS, (2022), <https://racketsandrillers.ca/blogs/running/brooks-glycerin-20-review>.

BROOKS' GLYCERIN 21 PRODUCT LINE

13. Brooks started wear testing its Glycerin 21 product line in December 2021, and the line was first released for sale in December 2023.



Brooks' Glycerin 21 Men's Running Shoe

14. Immediately, the industry press took notice of Brooks' latest entry in the Glycerin family. In February 2024, a Men's Health reviewer noted he was "immediately impressed by how smooth and comfortable my strides felt," but the Glycerin 21 was "lightweight" with "durability and stability" calling it "a solid pick for my people out there that absolutely dig comfort." See Eric Sung & Talene Appleton, *11 Best Brooks Running Shoes in 2024, Tested by Fitness Experts*, MEN'S HEALTH (Feb. 22, 2024), <https://www.menshealth.com/fitness/g46816575/best-brooks-running-shoes/>. A few days later, Runner's World hailed the Glycerin 21 as having "top-tier

cushioning, support and stability” that was “tried and tested.” See Rachel Boswell, *Brooks Glycerin 21: Tried and tested*, RUNNER’S WORLD (Feb. 27, 2024), <https://www.runnersworld.com/uk/gear/shoes/a46925217/brooks-glycerin-21-review/>. The running public agrees, as the Glycerin 21 product line has been a successful addition to the Brooks line of running shoes.

THE HISTORY BETWEEN THE PARTIES

15. Brooks has a substantial history of litigation with PUMA. PUMA has waged a worldwide trademark litigation campaign against Brooks, due to Brooks’ use of the word “nitro” as an abbreviation for nitrogen in the context of nitrogen-infused midsole technology for athletic shoes, even though Brooks began using this technology before PUMA. In July 2022, PUMA and its U.S. subsidiary first sued Brooks in the United States alleging trademark infringement over the word “nitro.” Later in the summer of 2022, PUMA fired its second volley in Europe, also based on allegations of trademark infringement over the word “nitro.” PUMA sought and obtained preliminary relief in the Netherlands, including prejudgment seizure of substantial Brooks assets necessary for Brooks to conduct its European business operations. PUMA followed that up by filing trademark actions against Brooks in Germany in the fall of 2022 and in the United Kingdom in the spring of 2023.

16. As the trademark cases dragged on, PUMA filed a flurry of nine new patent applications in the United States, claiming priority to existing applications, starting in November 2022 and ending in September 2023. Once these patents issued, in June 2024, PUMA filed yet another lawsuit against Brooks, this time a patent infringement case over Brooks’ Hyperion Elite MD and LD, Hyperion Elite 4, Hyperion Max 2, and Aurora BL product lines, all of which predate the filing of the nine patent applications but not necessarily the date to which the applications claim

priority. It was with this backdrop that Brooks received the most recent salvo from PUMA, the subject of this lawsuit.

PUMA FILES ITS PATENT APPLICATION

17. After the Glycerin 21 product line was released and after it received positive comments in the trade papers, on April 30, 2024, PUMA filed the '163 Application, titled "Outsole Pattern for an Article of Footwear" on an expedited basis with the United States Patent and Trademark Office ("USPTO"). The '163 Application claims priority to Application No. 18/505,674 ("the '674 Application"), which in turn claims priority to Application No. 17/396,912 ("the '912 Application"), filed on August 9, 2021. The '163 Application lists Arnaud Redon and Christopher Dunning as inventors. The '163 Application was allowed on August 5, 2024, but due to the expedited nature of the prosecution, the application did not publish until August 22, 2024.

PUMA THREATENS TO HOLD BROOKS LIABLE FOR PATENT INFRINGEMENT

18. In the meantime, on August 7, 2024, two days after allowance, PUMA SE, through its counsel, sent a letter to Brooks' counsel alleging that Brooks' entire Glycerin 21 product line (including the Glycerin 21, Glycerin GTS 21, Glycerin StealthFit 21, and Glycerin StealthFit GTS 21) infringed claims 1-30 of its then-unpublished '163 Application. (Ex. B.) PUMA attached claim charts outlining its allegations.

19. PUMA closed its letter promising that:

Unless Brooks timely ceases its manufacture, use, sale, offer for sale and importation of the Glycerin 21 family of shoes and all other products that meet the claims of the '163 Application, Brooks will be fully liable to PUMA for its infringement of the patent that will soon issue from the '163 Application, including for infringement of PUMA's provisional rights under 35 U.S.C. § 154(d) upon publication of the '163 Application on August 22, 2024.

(Ex. B at 1.)

20. PUMA boldly insisted that Brooks should “destroy all existing inventory of the referenced products on or before August 22, 2024,” which notably is before any exclusionary patent right would have issued to PUMA. (Ex. B at 2.) PUMA gave Brooks only seven days to comply with its demands. On August 22, 2024, PUMA notified Brooks of the publication of its application, and again demanded a response to its allegations. Although PUMA’s threat of patent infringement litigation was evident and although Brooks took the threat seriously based on the specificity of the letter and its history with PUMA, Brooks was left in the dark as to exactly where, when, or how PUMA might strike next.

THE ’825 PATENT

21. On September 24, 2024, the ’163 Application issued as the ’825 Patent. (Ex. A.) PUMA is the assignee of the ’912 Application, the predecessor application to the ’825 Patent, by assignment from Mr. Redon and Mr. Dunning, executed in August 2021. (Ex. C.) As shown in Exhibit C, both Mr. Redon and Mr. Dunning assigned to PUMA all their rights, title, and interest in the ’912 Application as well as any later applications claiming priority to this application, including the ’163 Application, now the ’825 Patent. Through counsel, on August 5, 2024, PUMA recorded Exhibit C with the USPTO Patent Assignment Database specifically in connection with the ’163 Application, at Reel: 068180 and Frame: 0480.

22. The abstract of the ’825 Patent describes the invention as:

A sole for an article of footwear, which has a medial side, a lateral side, a forefoot region, a midfoot region, and a heel region, includes a set of ridges concentrically aligned around and emanating outwardly from an epicenter. The epicenter is disposed within the forefoot region and is closer to the medial side than the lateral side. The set of ridges is disposed in each of the forefoot region, the midfoot region, and the heel region. A set of spaces extends concentrically between respective ridges of the set of ridges. The set of ridges includes a plurality of short portions having a height that is smaller than heights of adjacent tall portions of the set of

ridges. A flex zone is defined by at least some of the plurality of short portions and is configured to flex more than one or more stiffening zones of the sole.

(Ex. A at Abstract.)

23. The '825 Patent has thirty-three total claims, including three independent claims. Each independent claim recites a “sole for an article of footwear having a medial side, a lateral side, a forefoot region, a midfoot region, and a heel region,” where the sole must comprise: “a set of ridges concentrically aligned around and emanating outwardly from an epicenter that is disposed within the forefoot region and closer to the medial side than the lateral side,” “a set of spaces that extend concentrically between respective ridges of the set of ridges,” and a “flex zone” “configured to flex more than one or more stiffening zones of the sole” amongst other limitations.

DECLARATORY JUDGMENT IS APPROPRIATE

24. Brooks has sold or offered for sale the products accused by PUMA of infringing the '825 Patent in the United States and within the statute of limitations for patent infringement and continues to do so. Therefore, while Brooks specifically denies any act of infringement, either directly or indirectly, either literally or under the doctrine of equivalents, based on PUMA's recent litigation activities against Brooks and PUMA's August 7, 2024 letter, Brooks has a reasonable apprehension that PUMA may file another action against Brooks and allege that Brooks has infringed or is infringing the '825 Patent.

25. PUMA's wrongful assertion of the '825 Patent against Brooks' products has caused and will continue to cause Brooks irreparable injury and damage.

26. Brooks' Glycerin 21 product line does not infringe and has not infringed, either directly, indirectly, or under the doctrine of equivalents, any claim of the '825 Patent. In view of PUMA's allegations in its August 7, 2024 letter that Brooks' Glycerin 21 product line infringes

the '825 Patent, a substantial controversy exists between the parties which is of sufficient immediacy and reality to warrant declaratory relief.

COUNT I
(Declaratory Judgment of Non-infringement of the '825 Patent)

27. Brooks repeats and incorporates by reference all prior allegations above.

28. An actual controversy, within the meaning of 28 U.S.C. §§ 2201 and 2202, exists between Brooks and PUMA at least with respect to PUMA's assertion that Brooks' Glycerin 21 product line infringes one or more claims of the '825 Patent.

29. Brooks' allegedly infringing products do not practice or include all of the claimed elements of any claim of the '825 Patent, either literally or under the doctrine of equivalents, including at least the following, each of which is recited in all of claims 1-33 of the '825 Patent: "a set of ridges concentrically aligned around and emanating outwardly from an epicenter that is disposed within the forefoot region and closer to the medial side than the lateral side" and "a set of spaces that extend concentrically between respective ridges of the set of ridges." At least on this basis, Brooks' allegedly infringing products cannot infringe claims 1-33 of the '825 Patent, because no product in Brooks' Glycerin 21 product line meets each and every limitation of any claim of the '825 Patent.

30. Brooks expressly reserves the right to assert additional grounds of noninfringement after having the ability to conduct discovery and the Court has construed the claims, if necessary.

31. In view of the foregoing, Brooks seeks and is entitled to declaratory judgment that the use, sale, and offer for sale of its Glycerin 21 product line do not infringe any claim of the '825 Patent. A judicial determination of the respective rights of the parties with respect to noninfringement of the claims of the '825 Patent is necessary and appropriate under 28 U.S.C. § 2201 to resolve the parties' dispute regarding alleged infringement of the '825 Patent.

RESERVATION OF RIGHTS

32. Brooks reserves its right to supplement with additional claims or defenses as discovery proceeds in this matter.

DEMAND FOR JURY TRIAL

33. Pursuant to Rule 38(b) of the Federal Rules of Civil Procedure, Brooks demands a trial by jury on all issues so triable.

PRAYER FOR RELIEF

WHEREFORE, Brooks demands judgment as follows:

- A. Declaratory judgment that Brooks' use, sale, offer for sale, and/or importation of its Glycerin 21 product line, does not infringe any claim of the '825 Patent directly, indirectly, or under the doctrine of equivalents;
- B. A declaration that this action is an exceptional case under 35 U.S.C. § 285;
- C. An award to Brooks of attorneys' fees and costs incurred in this action; and
- D. A grant of such other and further relief as this Court deems just, equitable, and proper.

Dated: September 24, 2024

Respectfully submitted,

/s/ Elizabeth D. Ferrill

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