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10 Attorney for Plaintiff
11 METROTILE MANUFACTURING DBA
12 METRO ROOF PRODUCTS

10 IN THE UNITED STATES DISTRICT COURT
11 FOR THE CENTRAL DISTRICT OF CALIFORNIA

13 METROTILE MANUFACTURING, a
14 California general partnership d/b/a
15 METRO ROOF PRODUCTS,

16 Plaintiff

17 vs.

18 METROTILE EUROPE, NV a Belgium
19 business entity;

20 VARITILE, INC., a Delaware Corporation;
21 and DOES 1 through 10, inclusive,

22 Defendants
23

Case No. SAC14-00272 JLS (DFMx)

**FIRST AMENDED COMPLAINT
FOR PATENT INFRINGEMENT
AND TRADEMARK
INFRINGEMENT**

DEMAND FOR JURY TRIAL

24 **1. JURISDICTION AND VENUE**

25 1. This is a civil action arising under the patent and trademark laws of the
26 United States, 35 U.S.C. §§ 1, *et seq.* and 15 U.S.C. §1051 *et seq.* Consequently, this
27 Court has original subject matter jurisdiction over this suit pursuant to 28 U.S.C. §§
28 1331 and 1338(a).

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1 each of the Defendants have acted in concert and participated with each concerning
2 each of the claims in this Complaint.

3 9. METRO ROOF is informed and believes, and on that basis alleges, that
4 each of the Defendants were empowered to act as the agent, servant, and/or employee
5 for each of the other Defendants, and the acts alleged to have been done by each of
6 them were authorized, approved and/or ratified by each of the other Defendants.

7 10. Upon information and belief, roofing products of METROTILE
8 EUROPE are marketed under the trademarks METROTILE and/or VARITILE.

9 11. Upon information and belief METROTILE EUROPE and VARITILE
10 have the same business address in Belgium.

11 12. Upon information and belief, METROTILE EUROPE directed the
12 formation VARITILE.

13 13. Upon information and belief VARITILE distributes the products of
14 METROTILE EUROPE in the United States.

15 14. Upon information and belief, the business of VARITILE is limited to the
16 promotion, marketing, and sales of products manufactured by METROTILE
17 EUROPE.

18 15. Upon information and belief, METROTILE EUROPE directs or controls
19 the operation of VARITILE.

20 16. Upon information and belief, VARITILE's sales of tile products have
21 been substantially limited to sales to customers in the United States.

22 17. Upon information and belief, the domain name www.varitile.com is
23 owned by METROTILE EUROPE.

24 18. Upon information and belief, that METROTILE EUROPE, and
25 VARITILE, each have the same Chief Executive Officer.

26 19. Upon information and belief, VARITILE employs a sales director who
27 resides in the state of Oregon, having responsibility for sales of Metrotile and/or
28 Varitile products in the United States.

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20. Upon information and belief, METROTILE EUROPE and VARITILE market products to customers residing in the state of California, and in this judicial district.

21. METROTILE EUROPE and VARITILE have promoted roofing products at trade shows in the United States, including but not limited to the International Roofing Exhibition in Las Vegas, Nevada during February 2014.

22. METROTILE EUROPE and VARITILE have also promoted the sale of roofing products at the International Builders trade show in Las Vegas, Nevada.

3. THE PATENTS-IN-SUIT

23. On August 15, 2006 United States Patent No. D526,727 (“the ‘727 patent”), entitled Metal Roof Tile, was duly and legally issued by the United States Patent and Trademark Office. A true and correct copy of the ‘727 patent is attached as Exhibit 1 hereto.

24. On September 5, 2006 United States Patent No. D527,835 (“the ‘835 patent”), entitled Metal Roof Tile, was duly and legally issued by the United States Patent and Trademark Office. A true and correct copy of the ‘835 patent is attached as Exhibit 2 hereto.

25. On August 7, 2001 United States Patent No. 6,269,603 (“the ‘603 patent”), entitled Roofing or Sheathing, was duly and legally issued by the United States Patent and Trademark Office. A true and correct copy of the ‘603 patent is attached as Exhibit 3 hereto.

26. METRO ROOF is the sole owner of and is listed with the U.S. Patent and Trademark Office as assignee of record of the ‘727 patent, having standing to sue and recover damages for infringement of the ‘727 patent, including all claims for damages by reason of past, present or future infringement.

27. METRO ROOF is the sole owner of and is listed with the U.S. Patent and Trademark Office as assignee of record of the ‘603 patent, having standing to sue and recover damages for infringement of the ‘603 patent, including all claims for

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damages by reason of past, present or future infringement.

28. METRO ROOF is the sole owner of and is listed with the U.S. Patent and Trademark Office as assignee of record of the '835 patent, having standing to sue and recover damages for infringement of the '835 patent, including all claims for damages by reason of past, present or future infringement.

29. METRO ROOF markets products under the '727 patent under the designation MetroRoman Tile. Marketing materials illustrating the MetroRoman tile product sold by METRO ROOF are attached hereto as Exhibit 5. The materials indicate that the MetroRoman product is covered by the '727 patent.

30. METRO ROOF markets products under the '835 patent under the designation Metro Tile. Marketing materials illustrating the Metro Tile product sold by METRO ROOF are attached hereto as Exhibit 6. The materials indicate that the Metro Tile product is covered by the '835 patent.

31. METRO ROOF markets products manufactured under the '603 patent under the designation MetroShingle Tile. Marketing materials illustrating the MetroShingle tile product sold by METRO ROOF are attached hereto as Exhibit 7. The materials indicate that the MetroShingle Tile product is covered by the '603 patent.

4. ACCUSED PRODUCTS

32. VARITILE is offering for sale and/or selling metal roofing products manufactured by METROTILE EUROPE under the designation Varitile Roman. A copy of materials evidencing sales of products under the designations Roman and Varitile Roman, by VARITILE, is attached hereto as Exhibit 9.

33. VARITILE is offering for sale and/or selling metal roofing products manufactured by METROTILE EUROPE under the designation Varitile Bond. A copy of materials evidencing sales of products under the designation Varitile Bond, by VARITILE, is attached hereto as Exhibit 10.

34. VARITILE is offering for sale and/or selling metal roofing products

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manufactured by METROTILE EUROPE under the designation Varitile Shingle. A copy of materials evidencing sales of products under the designation Varitile Shingle, by VARITILE, is attached hereto as Exhibit 11.

35. The design of the products sold by VARITILE under the designation Varitile Roman is substantially similar to the design of products sold by METRO ROOF under the term MetroRoman Tile.

36. The construction of the products sold by VARITILE under the designation Varitile Shingle is substantially similar to the construction of products sold by METRO ROOF under the term MetroShingle Tile.

37. The design of the products sold by VARITILE under the designation Varitile Bond is substantially similar to the design of products sold by METRO ROOF under the term MetroTile.

38. The design of tile products sold by VARITILE under the designation Varitile Roman is substantially similar to the tile design illustrated in the '727 patent.

39. The products sold by VARITILE under the designation Varitile Shingle are constructed as set forth in on or more claims of the '603 patent.

40. The design of tile products sold by VARITILE under the designation Varitile Bond is substantially similar to the tile design illustrated in the '835 patent.

41. The United States Patent and Trademark Office granted a federal trademark registration of "METRO TILE" for metal roofing and roof components, namely, roof tile, roof hips and ridge pieces, valley pieces, roof and fascia flashing and trims as Registration No. 2,548,950, and a trademark registration of "METROTILE" for manufacturing services for others in the field of metal roofing and roofing components, namely, roof hips and ridge pieces, valley pieces, roof and fascia flashing and trims and transportable metal building as Registration No. 4,052,337. A copy of such trademark registrations are attached as Exhibits 13 and 14.

42. METRO ROOF has used and continues to use the trademarks METRO

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TILE and METROTILE and other Metro derivative marks, in connection with the manufacturing and sale of roofing products since before VARITILE or METROTILE EUROPE began marketing roof products in the United States.

5. COUNT I

(Infringement Of The ‘727 Patent By METROTILE EUROPE and VARITILE)

43. METRO ROOF realleges and incorporates by reference the allegations stated in paragraphs 1 through 42 of this Complaint.

44. METROTILE EUROPE and VARITILE have infringed, and continue to infringe, directly or indirectly, the ‘727 patent within the meaning of 35 U.S.C. § 271 by making, using, selling, distributing, offering for sale and/or importing products that infringe the ‘727 patent in the United States and/or by inducing others to do so.

45. To the extent required by law, METRO ROOF has complied with the provisions of 35 U.S.C. § 287 with respect to the ‘727 patent.

46. METROTILE EUROPE has known of the ‘727 patent since at least as early as December 20, 2010.

47. VARITILE has known of the ‘727 patent since approximately the date of its formation.

48. By acts of infringement of the ‘727 patent by METROTILE EUROPE and VARITILE, METROTILE EUROPE and VARITILE have injured METRO ROOF, and METRO ROOF is entitled to recover damages adequate to compensate it for such infringement under 35 U.S.C. §§ 281 and 289.

49. METRO ROOF has suffered, and will continue to suffer, irreparable injury as a result of infringement of the ‘727 patent by METROTILE EUROPE and VARITILE. Pursuant to 35 U.S.C. § 283, METRO ROOF is entitled to a permanent injunction against further infringement.

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6. COUNT II
(Infringement Of The ‘603 Patent by METROTILE EUROPE and VARITILE)

50. METRO ROOF realleges and incorporates by reference the allegations stated in paragraphs 1 through 49 of this Complaint.

51. METROTILE EUROPE and VARITILE have infringed, and continue to infringe, directly or indirectly, the ‘603 patent within the meaning of 35 U.S.C. § 271 by making, using, selling, distributing, offering for sale and/or importing products that infringe the ‘603 patent in the United States, and/or inducing others to do so.

52. To the extent required by law, METRO ROOF has complied with the provisions of 35 U.S.C. § 287 with respect to the ‘603 patent.

53. METROTILE EUROPE has known of the ‘603 patent since at least as early as December 20, 2010.

54. VARITILE has known of the ‘603 patent since approximately the date of its formation.

55. By acts of infringement of the ‘603 patent by METROTILE EUROPE and VARITILE, METROTILE EUROPE and VARITILE have injured METRO ROOF, and METRO ROOF is entitled to recover damages adequate to compensate it for such infringement from VARITILE and METROTILE EUROPE under 35 U.S.C. §§ 281 and 289.

56. METRO ROOF has suffered, and will continue to suffer, irreparable injury as a result of infringement of the ‘603 patent by METROTILE EUROPE and VARITILE. Pursuant to 35 U.S.C. § 283, METRO ROOF is entitled to a permanent injunction against further infringement.

7. COUNT III
(Infringement Of The ‘835 Patent by METROTILE EUROPE and VARITILE)

57. METRO ROOF realleges and incorporates by reference the allegations

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stated in paragraphs 1 through 56 of this Complaint.

58. METROTILE EUROPE and VARITILE have infringed, and continue to infringe, directly or indirectly, the ‘835 patent within the meaning of 35 U.S.C. § 271 by making, using, selling, distributing, offering for sale and/or importing products that infringe the ‘835 patent in the United States, and/or inducing others to do so.

59. To the extent required by law, METRO ROOF has complied with the provisions of 35 U.S.C. § 287 with respect to the ‘835 patent.

60. METROTILE EUROPE has known of the ‘835 patent since at least as early as December 20, 2010.

61. VARITILE has known of the ‘835 patent since approximately the date of its formation.

62. By acts of infringement of the ‘835 patent by METROTILE EUROPE and VARITILE, METROTILE EUROPE and VARITILE have injured METRO ROOF, and METRO ROOF is entitled to recover damages adequate to compensate it for such infringement from METROTILE EUROPE under 35 U.S.C. §§ 281 and 289.

63. METRO ROOF has suffered, and will continue to suffer, irreparable injury as a result of infringement of the ‘835 patent by METROTILE EUROPE and VARITILE. Pursuant to 35 U.S.C. § 283, METRO ROOF is entitled to a permanent injunction against further infringement.

COUNT I
TRADEMARK INFRINGEMENT
(By Metrotile Europe and Veritile)

64. The allegations of Paragraphs 1-63 are repeated and realleged as if fully set forth herein.

65. This cause of action arises under the Federal Trademark Act (15 U.S.C. § § 1051-1127) and is for trademark infringement involving the METROTILE EUROPE’s and VERITILE’s use in commerce of the designations METROTILE or METROTILE EUROPE in the certification, marketing and offering of roofing

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products in the United States in a manner that infringes METRO ROOF’s registered trademarks METRO TILE and/or METROTILE in violation of 15 U.S.C. § 1114(1).

66. The METROTILE and/or METROTILE EUROPE designations used by VARITILE and METROTILE EUROPE are so similar to METRO ROOF’s federally registered METRO TILE and METROTILE marks as to be likely to cause consumer confusion, deception and mistake.

67. Upon information and belief, by their acts herein complained of, METROTILE EUROPE and VARITILE have made substantial profits to which they are not equitably entitled.

68. By the aforementioned acts herein complained of, METRO ROOF has suffered great detriment in a sum which cannot be ascertained at this time.

69. VARITILE and METROTILE EUROPE threaten to, and unless restrained, continues to act complained of herein, all to METRO ROOF’s irreparable damage, and it will be extremely difficult to ascertain the amount of compensation which could afford METRO ROOF adequate relief.

PRAYER FOR RELIEF

WHEREFORE METRO ROOF respectfully asks this Court to enter judgment against METROTILE EUROPE and VARITILE, and against each of their respective subsidiaries, successors, parents, affiliates, officers, directors, agents, servants, employees, and all persons in active concert or participation with them, which grants the following relief:

- A. Entry of judgment in favor of METRO ROOF and against METROTILE EUROPE and VARITILE;
- B. A determination that METROTILE EUROPE and VARITILE have directly or indirectly infringed the ‘727, the ‘835 and the ‘603 patents owned by METRO ROOF;
- C. A determination that METROTILE EUROPE and VARITILE have infringed METRO ROOF’s federally-registered METRO TILE and METROTILE

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trademarks.

D. An award of damages adequate to compensate METRO ROOF for patent infringement that has occurred, but in no event less than a reasonable royalty as permitted by 35 U.S.C. § 284;

E. An award of damages adequate to compensate METRO ROOF for willful trademark infringement that has occurred;

F. Prejudgment interest from the date the infringement began;

G. Treble damages as provided under 35 U.S.C. § 284;

H. A finding that this case is exceptional and an award to METRO ROOF of its reasonable attorneys’ fees and costs as provided by 35 U.S.C §280 and/or 15 U.S.C. § 1117;

I. Entry of a preliminary and permanent injunction that VARITILE and METROTILE EUROPE and each of them, their affiliates, employees, and all those acting in concert with them, be enjoined from infringing the ‘727, ‘835 and ‘603 patents, and from use of the “METROTILE” and “METROTILE EUROPE” marks, or any confusing similar designation, as a mark or name or component of a mark or name in connection with the marketing and offering of roofing products in the United States; and

J. Such other relief that METRO ROOF is entitled to under law, and any other and further relief that this Court or jury may deem just and proper.

Dated: November 20, 2014

STETINA BRUNDA GARRED & BRUCKER

By: /s/Bruce B. Brunda
Bruce B. Brunda
Attorney for Plaintiff
METROTILE MANUFACTURING dba
METRO ROOF PRODUCTS

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DEMAND FOR JURY TRIAL

Plaintiff Metrotile Manufacturing dba Metro Roof Products hereby demands a jury trial in this action.

Dated: November 20, 2014 STETINA BRUNDA GARRED & BRUCKER

By: /s/Bruce B. Brunda
Bruce B. Brunda
Attorney for Plaintiff
METROTILE MANUFACTURING dba
METRO ROOF PRODUCTS

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