

UNITED STATES DISTRICT COURT
 SOUTHERN DISTRICT OF NEW YORK

-----	X	
	:	
UMBRA LLC,	:	
	:	
	:	
Plaintiff,	:	<u>COMPLAINT</u>
	:	<u>AND JURY DEMAND</u>
-against-	:	
	:	
	:	
OXO INTERNATIONAL, LTD.	:	
	:	
	:	
Defendant	:	
	:	
-----	X	

Plaintiff Umbra LLC (“Umbra”), for its Complaint against defendant Oxo International, Ltd. (“Oxo”) alleges as follows:

NATURE OF THE ACTION

1. This action seeks monetary and equitable relief for patent infringement in violation of the Patent Act (35 U.S.C. § 1 *et seq.*) and specifically in violation of at least 35 U.S.C. § 271.

THE PARTIES

2. Plaintiff Umbra is a New York limited liability company having its principal place of business at 1705 Broadway Street, Buffalo, New York 14212. Umbra does business in this judicial district.

3. On information and belief, defendant Oxo is a limited partnership existing under the laws of the state of Texas, with a registered office at One Helen of Troy Plaza, El Paso, TX, 79912, with a regular and established place of business at 601 West 26th Street, Suite 1050, New York, NY 10001. Oxo does business in this judicial district.

JURISDICTION AND VENUE

4. This Court has jurisdiction over the subject matter of this action pursuant to 28 U.S.C. §§ 1331 and 1338.

5. The court has personal jurisdiction over Oxo because Oxo has a regular and established place of business in this District.

6. The Court further has personal jurisdiction over Oxo because Oxo has engaged in the following acts in this judicial district: transacting and soliciting business, contracting to supply goods, advertising and marketing infringing, supplying and selling goods to buyers, and selling goods through online sales to customers, in violation of Umbra's patent rights.

7. Venue is proper in this judicial district pursuant to 28 U.S.C. §§ 1391(b), (d), and 1400(b), because on information and belief, Oxo resides in this district, and further because Oxo has engaged in the complained-of acts of infringement in this judicial district and has a regular and established place of business in this district.

PRELIMINARY STATEMENT

8. This action arises out of Oxo's violation of Umbra's protected intellectual property rights. Oxo is distributing and selling a paper tower holder that infringes Umbra's rights in U.S. Patent D550,488 patent (the "488 Patent"), which is owned by Umbra. Umbra seeks a permanent injunction prohibiting Oxo from infringing and profiting from Umbra's intellectual property, as well as damages sufficient to compensate Umbra for Oxo's infringing conduct.

FACTUAL BACKGROUND

9. Over a period of 30 years, Umbra has developed and maintained, at considerable expense, in the United States and worldwide, valuable patent and trade dress

protection, a valuable trade name, a reputation for excellence, and valued relationships with retailers and customers.

10. To develop and maintain these assets and associated good will, and to protect its innovative designs, Umbra has invested substantial amounts of money, time, and other resources.

11. Among the products that Umbra has developed and honed over time is the Tug One Handed Paper Towel Holder.

12. The design for the Tug One Handed Paper Towel Holder was developed in 2005 after extensive time, labor, and development costs.

13. After months of development with various vendors to achieve the correct design, Umbra created the initial design of the Tug Power Towel Holder.

14. In the years the Tug One Handed Paper Towel Holder has been sold, over 700,000 units have been sold to date, with monetary sales of over \$3.1 million to date.

The '488 Patent and the Tug One Handed Paper Towel Holder

15. On or about March 8, 2006, Jason Nip and Paul Rowan filed a design patent application with the United States Patent and Trademark Office (the "PTO") claiming the ornamental design for a rolled product dispenser. On or about February 24, 2006, Nip and Rowan assigned their interest in the application to Umbra Inc., which assignment was recorded by the PTO on March 8, 2006. On or about February 20, 2007, Umbra Inc. assigned its interest in the application to Umbra LLC (the Plaintiff in this action), which assignment was recorded by the PTO on February 21, 2007. On September 11, 2007, the PTO duly and legally issued United States Design Patent No. D550,488 (the "'488 Patent"), showing and describing the design for a

“[r]olled product dispenser” with Umbra as the assignee. A true and correct copy of the ‘488 Patent is attached hereto as Exhibit A.

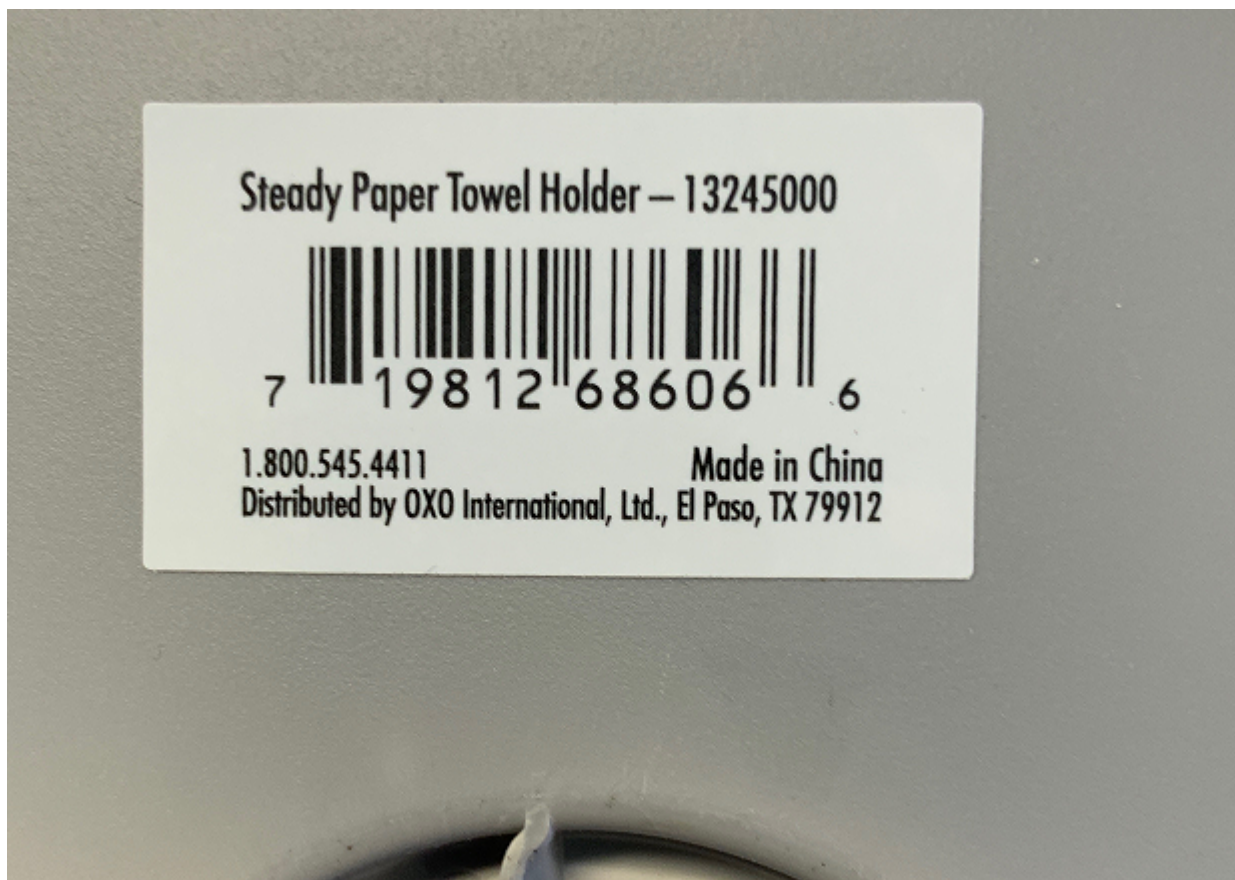
16. Umbra is the owner of the entire right, title, and interest in and to the ‘488 Patent, and as such, has the right to sue and recover for past, present, and future infringement of the ‘488 Patent and to obtain the relief claimed in this Complaint. The ‘488 Patent is in full force and effect.

17. Umbra has advertised, offered for sale, and sold throughout the United States a paper towel holder commonly known as and marketed as the Tug One Handed Paper Towel Holder, or simply the Tug Paper Towel Holder, which embodies the design and drawings of the ‘488 Patent.

18. Pursuant to 35 U.S.C. § 287, since on or about the issue date of the ‘488 Patent, Umbra has marked each Tug One Handed Paper Towel Holder it has designed, manufactured, and sold in accordance with the ‘488 Patent with the full patent number for the ‘488 Patent.

19. On information and belief, without Umbra’s authorization, Oxo advertises, offers for sale, distributes, and sells a knock-off copy of Umbra’s Tug One Handed Paper Towel Holder under at least the name “OXO Good Grips Stainless Steady Paper Towel Holder” and/or “OXO Good Grips Stainless Steel Paper Towel Holder” (the “Infringing Product”) in this judicial district and throughout the United States, for example on the OXO website (oxo.com) and through distributors such as Bed Bath & Beyond. *See, e.g.* <https://www.oxo.com/categories/cleaning-organization/kitchen/oxo-good-grips-steady-paper-towel-holder.html>, (last visited June 7, 2019 at 4:08 PM EDT).

20. The Infringing Product is marked as “Distributed by OXO International, Ltd., El Paso, TX 79912.”



21. Recently, on or about March of 2019, Umbra discovered that Oxo was selling and distributing the Infringing Product. In view thereof, on April 19, 2019, Umbra emailed Oxo International Ltd., informing it of Oxo’s infringement of the ‘488 Patent and advising Oxo that Umbra would file a Complaint against Oxo absent an agreement that Oxo cease and desist from its infringing conduct and provide an accounting of its infringement in place by April 30, 2019.

22. Despite such notice of its infringement, Oxo never responded to this letter from Umbra’s counsel.

23. Despite notice being provided to Oxo of its infringing conduct, Oxo has knowingly advertised, offered for sale, distributed, and sold the Infringing Patented Product.

24. Oxo has disregarded and violated Umbra's rights in the '488 Patent. Umbra has no other recourse than requesting assistance from the Court.

COUNT I
Infringement of the '488 Patent

25. Umbra incorporates by reference as though fully set forth herein the allegations contained in paragraphs 1 through 24 above.

26. On information and belief, Oxo has infringed and continues to infringe the '488 Patent by using, offering to sell, selling, promoting, and/or importing the Infringing Product, in this District and elsewhere in the United States without Umbra's authorization in violation of 35 U.S.C. § 271(a).

27. On information and belief, Oxo has also contributed to the infringement of the '488 Patent and/or actively induced others to infringe the '488 Patent by encouraging and promoting the use, manufacture, importation, sale, and/or offer for sale by others of the Infringing Patented Product, in this District and elsewhere in the United States, in violation of 35 U.S.C. § 271(b).

28. The Infringing Product is substantially the same to the '488 Patent and the Tug One Handed Paper Towel Holder in the eye of an ordinary observer, giving such attention as a purchaser usually gives.

29. In particular, the Infringing Patented Product is substantially similar to the '488 Patent in the following ways: both the '488 Patent and the Infringing Patented Product have a three-piece appearance with a three-finned vertically oriented shaft attached to a separate circular base and a separate flared headpiece.

30. The chart below demonstrates Oxo's infringement by comparing the Infringing Patented Product to the figures from the '488 Patent:

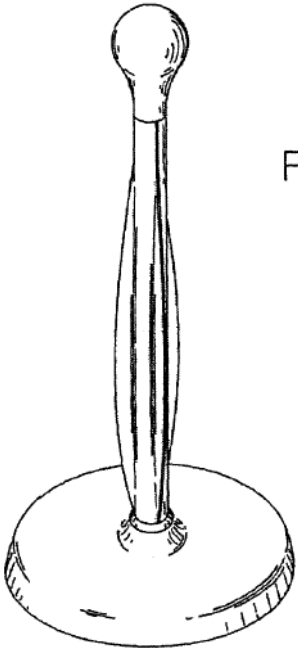

	The '488 Patent	The Infringing Patented Product
Figure 1	 <p>FIG. 1</p>	

Figure 2

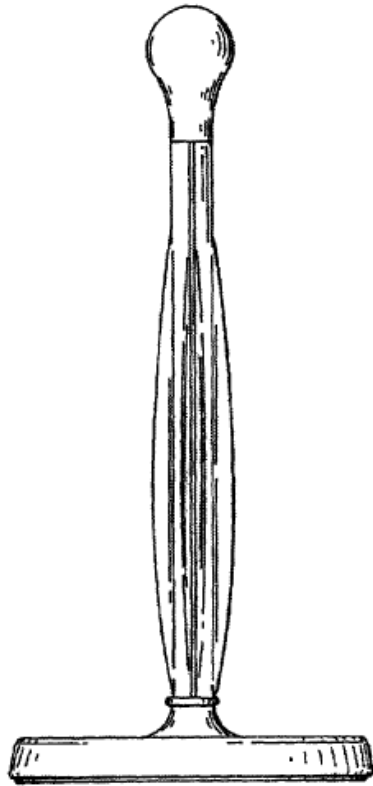
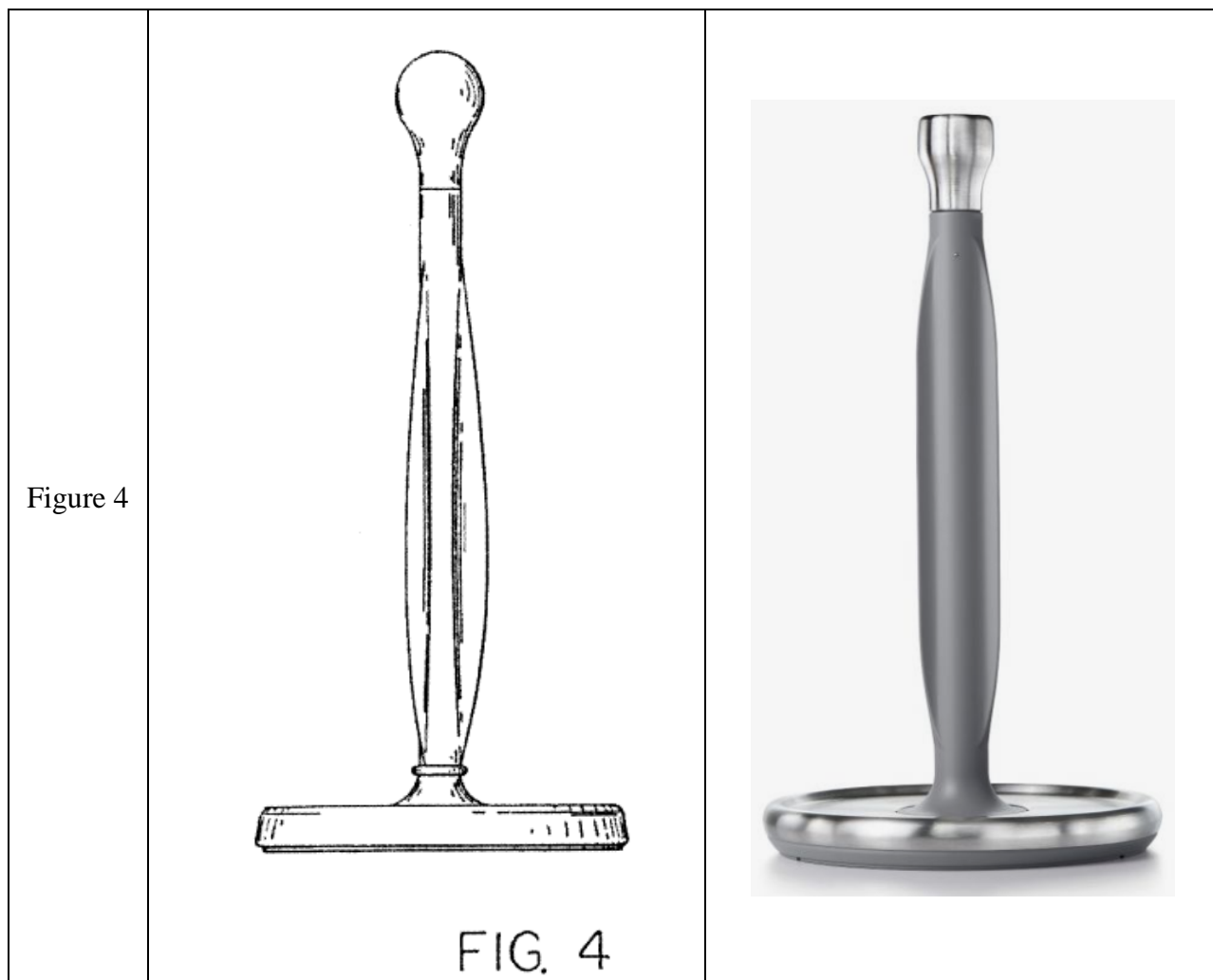


FIG. 2







31. The overall ornamental design of the Infringing Patented Product is substantially the same as the '488 Patent.

32. Oxo had notice and actual knowledge of the '488 Patent since at least April 19, 2019.

33. Umbra is entitled to recover from Oxo the damages sustained by Umbra resulting from Oxo's wrongful acts in an amount subject to proof at trial.

34. In addition, Oxo's infringement of the '488 Patent has been willful and deliberate, entitling Umbra to increased damages under 35 U.S.C. § 284, to attorneys' fees and

costs incurred in prosecuting this action under 35 U.S.C. § 285 and to Oxo's total profits from the sale of the Infringing Product under 35 U.S.C. § 289.

WHEREFORE, plaintiff Umbra demands judgment against defendant

Oxo as follows:

- (1) Adjudging that defendant's Infringing Product infringes the '488 Patent;
- (2) Adjudging that defendant's infringement of the '488 was willful and deliberate, and deeming this case exceptional under 35 U.S.C. § 285;
- (3) Permanently enjoining the defendant, its subsidiaries, affiliates, parents, successors, assigns, officers, agents, servants, employees, attorneys, and all persons acting in concert or in participation with defendant, from infringing or inducing the infringement of the '488 Patent or U.S. Trademark Registration No. 4446194, and, specifically, from directly or indirectly making, using, selling, or offering for sale any products embodying the design of the '488 Patent during its term, without the express written authority of Umbra.
- (4) Awarding Umbra damages in connection with Count I in an amount to be determined at trial, and the trebling thereof, pursuant to 35 U.S.C. § 284 or, alternatively, damages in connection with Count I pursuant to 35 U.S.C. § 289 based on an accounting of defendant's profits derived from its acts of infringement;
- (5) Awarding Umbra its costs pursuant to 35 U.S.C. § 284 and its reasonable attorneys' fees pursuant to 35 U.S.C. § 285.
- (6) Awarding all such other and further relief as the Court deems just and proper under the circumstances.

New York, New York

Date: June 25, 2019

MINTZ LEVIN COHN FERRIS GLOVSKY AND
POPEO, P.C.

By: /s/ Michael R. Graif
Michael R. Graif, Esq.
Harold S. Laidlaw, Esq.
The Chrysler Center
666 Third Avenue
New York, NY 10017
Tel: (212) 935-3000
Fax: (212) 983-3115
MRGraif@mintz.com
HSLaidlaw@mintz.com

Attorneys for Plaintiff Umbra