

**UNITED STATES DISTRICT COURT  
SOUTHERN DISTRICT OF NEW YORK**

AMEZIEL, INC.,

Plaintiff,

v.

WIESNER PRODUCTS, INC.,

Defendant.

C.A. No. 1:20-cv-02095-AKH

**JURY TRIAL DEMANDED**

**FIRST AMENDED COMPLAINT**

Plaintiff Ameziel, Inc. d/b/a SONGMICS (“Ameziel” or “Plaintiff”), by its undersigned attorneys, files this First Amended Complaint against defendant Wiesner Products Inc. d/b/a Studio 3B (“Wiesner” or “Defendant”) and alleges as follows:

**NATURE OF THE ACTION**

1. Ameziel brings this action seeking a declaratory judgment that Ameziel’s products do not infringe Wiesner’s U.S. Reissued Patent No. RE45,533, titled *Clothing Hanger* (“the ’533 patent”) and listing Samuel V. Cohen as the inventor. Ameziel also seeks a declaratory judgment that the ’533 patent is invalid. A true and correct copy of the ’533 patent is attached as Exhibit 1.

**THE PARTIES**

2. Ameziel, Inc. is a California corporation with a principal place of business at 4215 E Airport Drive, Ontario, CA 91761, doing business as SONGMICS.

3. On information and belief, Defendant Wiesner Products Inc. is a New York corporation with a principal place of business at 1333 Broadway, 6th Fl. New York, NY 10018, doing business under the name of Studio 3B.

**JURISDICTION AND VENUE**

4. This is a civil action for declaratory judgment brought under the Declaratory Judgment Act, 28 U.S.C. §§ 2201 and 2202, and arises under the Patent Laws of the United States, Title 35 of the United States Code (35 U.S.C. §§ 100 *et seq.*).

5. This Court has subject matter jurisdiction over the action pursuant to 28 U.S.C. §§ 1331 and 1338(a), as it involves claims arising under the Patent Laws of the United States including but not limited to 35 U.S.C. § 271.

6. This Court has personal jurisdiction over Wiesner because, on information and belief, Wiesner resides and/or is incorporated in New York.

7. This Court also has personal jurisdiction over Wiesner because, on information and belief, Wiesner transacts business within the State of New York including marketing and selling products to customers in New York and maintaining websites with access and promoting sales in New York, and has committed the acts alleged in this Complaint in the State of New York including sending cease and desist letters to Ameziel from New York.

8. Venue is proper in this judicial district pursuant to 28 U.S.C. §§ 1391(b), 1391(c), and 1400(b).

**FACTUAL BACKGROUND**

9. Ameziel is in the business of designing, manufacturing, selling, and promoting quality home necessities including clothing hangers.

10. Over the years, Ameziel has become one of the top sellers for affordable, functional household products on Amazon.com (“Amazon”).

11. On information and belief, Wiesner is a wholesale distributor of footwear and apparel.

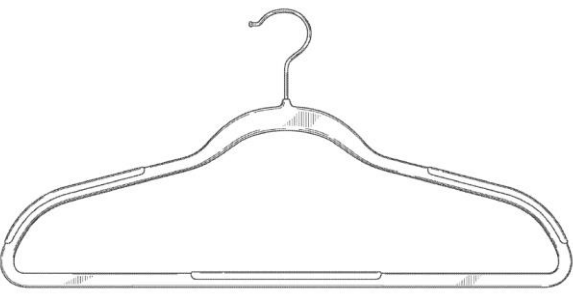
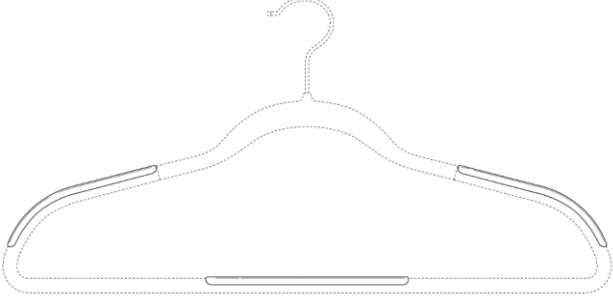
12. The company’s line of business includes selling household products online, such as clothing hangers.

13. Ameziel and Wiesner are competitors at least in the business of selling household products.

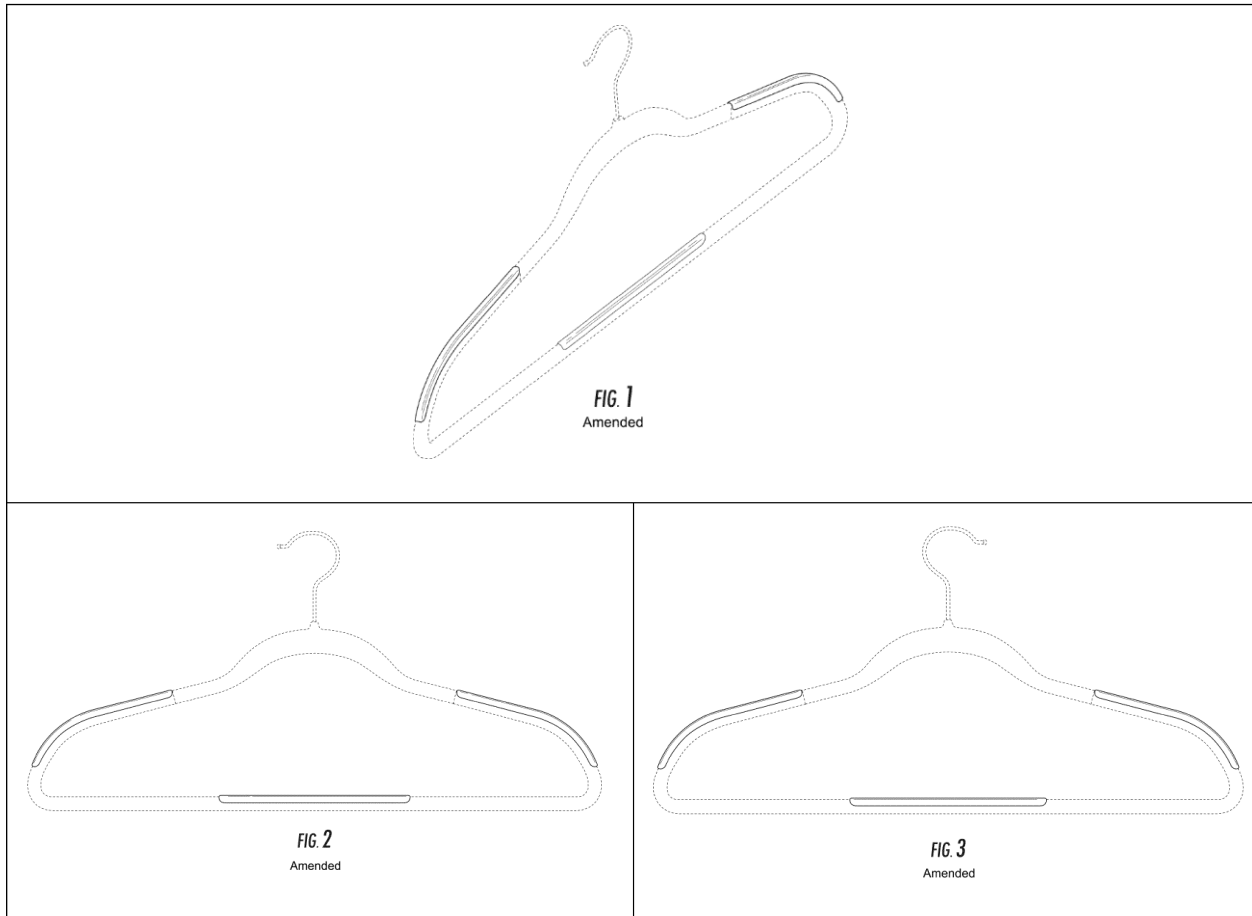
14. On July 5, 2011, the United States Patent Office issued a design patent, U.S. Pat. No. D640,876, for a particular design directed to clothing hangers whose earliest filing date is December 6, 2010.

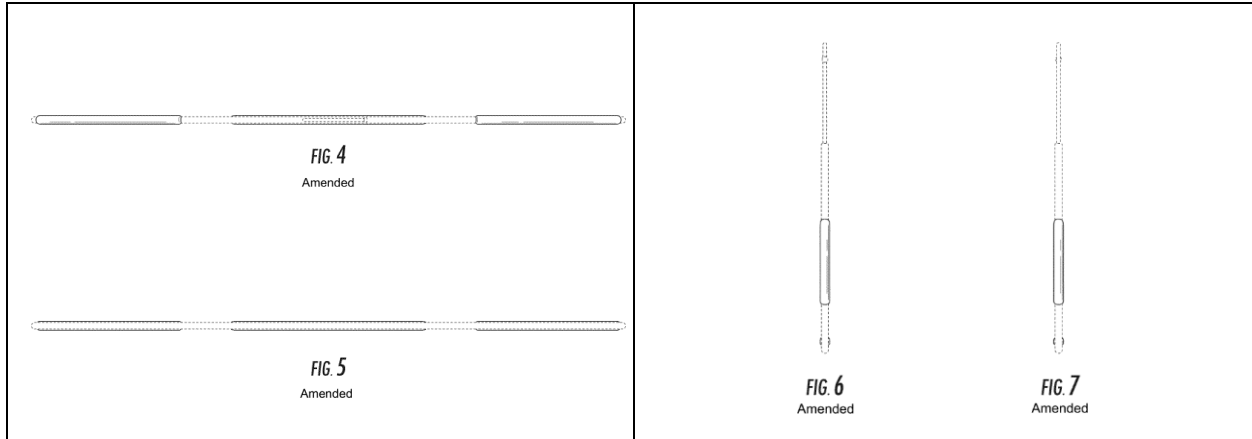
15. U.S. Patent No. D640,876 was subsequently reissued as the ’533 patent on June 2, 2015.

16. During re-issuance proceedings, Wiesner amended the claims at the United States Patent and Trademark Office (“USPTO”) to remove the hanger body as a limitation and broaden the claim to the arrangement of the gripping elements of the hanger—at the locations where clothes are affixed to the hanger—irrespective of the hanger body. A comparison of the claims is provided below.

Originally Issued Claims	Re-Issued Claims
	

17. The '533 patent claims the following design (illustrated by the solid lines):





18. Ameziel has sold certain clothing hanger products on Amazon, which it internally refers to as the UCRP 50 Series (“the 50 Series”).

19. An example of Ameziel’s 50 Series clothing hanger is depicted below.



20. On or about November 8, 2019, Ameziel received a letter from Wiesner’s attorneys accusing Ameziel of infringing the ’533 patent for selling the 50 Series products on Amazon.

21. On or about November 19, 2019, Wiesner instructed Amazon to remove Ameziel’s listing of the 50 Series products due to the alleged infringement of the ’533 patent.

22. However, the design claimed in the ’533 patent is not novel and, in any event, is merely an obvious variant of prior art hanger designs, such as Korean Patent Registration No. 30-0550154 (“Korean ’154”). A true and correct copy of the Korean ’154 and a certified translation

thereof are attached as Exhibits 2 and 3, respectively.

23. The design claimed in the '533 patent therefore does not qualify for patent protection. The '533 patent is invalid under one or more sections of 35 U.S.C. §§ 101, *et seq.*

24. The '533 patent is invalid because the alleged design is dictated by function rather than any ornamental feature.

25. The '533 patent is also invalid because the alleged design is not ornamental.

26. For example, the hanger features claimed in the '533 patent are functional, in that, among other things, it prevents garments from slipping off the clothing hangers.

27. The arrangement and configuration of the three non-slip pads are dictated by the requirement that they come into contact with the clothing positioned at those locations, not by any ornamental considerations.

28. In addition, and on information and belief, Samuel V. Cohen is not the actual and first inventor, and merely derived the claimed design from others such as, for example, the Korean '154.

29. As shown below, the same design is disclosed in at least the Korean '154.

30. The application for the Korean '154 was filed on May 12, 2009.

31. The Korean '154 published on January 14, 2010.

32. Specifically, it published in the Korea Intellectual Property Rights Information Services (KIPRIS) database, provided by the Korea Institute of Patent Information (KIPI) on behalf of the Korean Intellectual Property Office (KIPO), on January 14, 2010.

33. The Korean '154 qualifies as a "printed publication," as that term is used in 35 U.S.C. § 102(a) (pre-AIA).

34. The Korean '154 was "patented," as that term is used in 35 U.S.C. § 102(a) (pre-

AIA).

35. The Korean '154 is a Korean design registration.

36. The Korean '154 published before the December 10, 2010 filing date of the '533 patent. The Korean '154 is therefore presumptively prior art to the '533 patent.

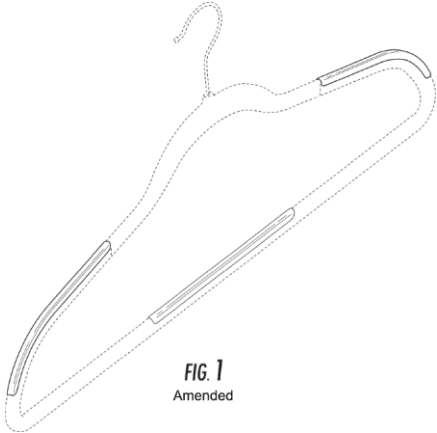
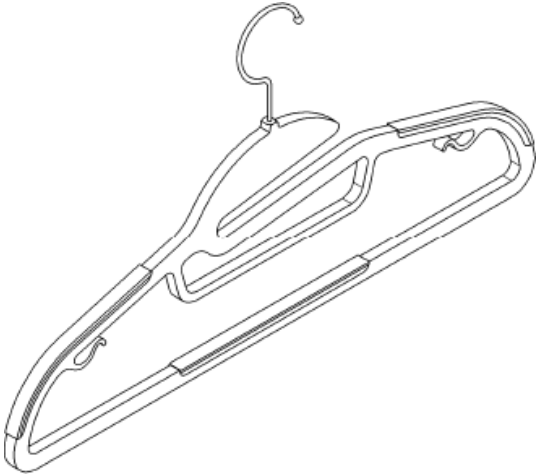
37. On information and belief, the Korean '154 published before Samuel V. Cohen conceived of the design claimed in the '533 patent.

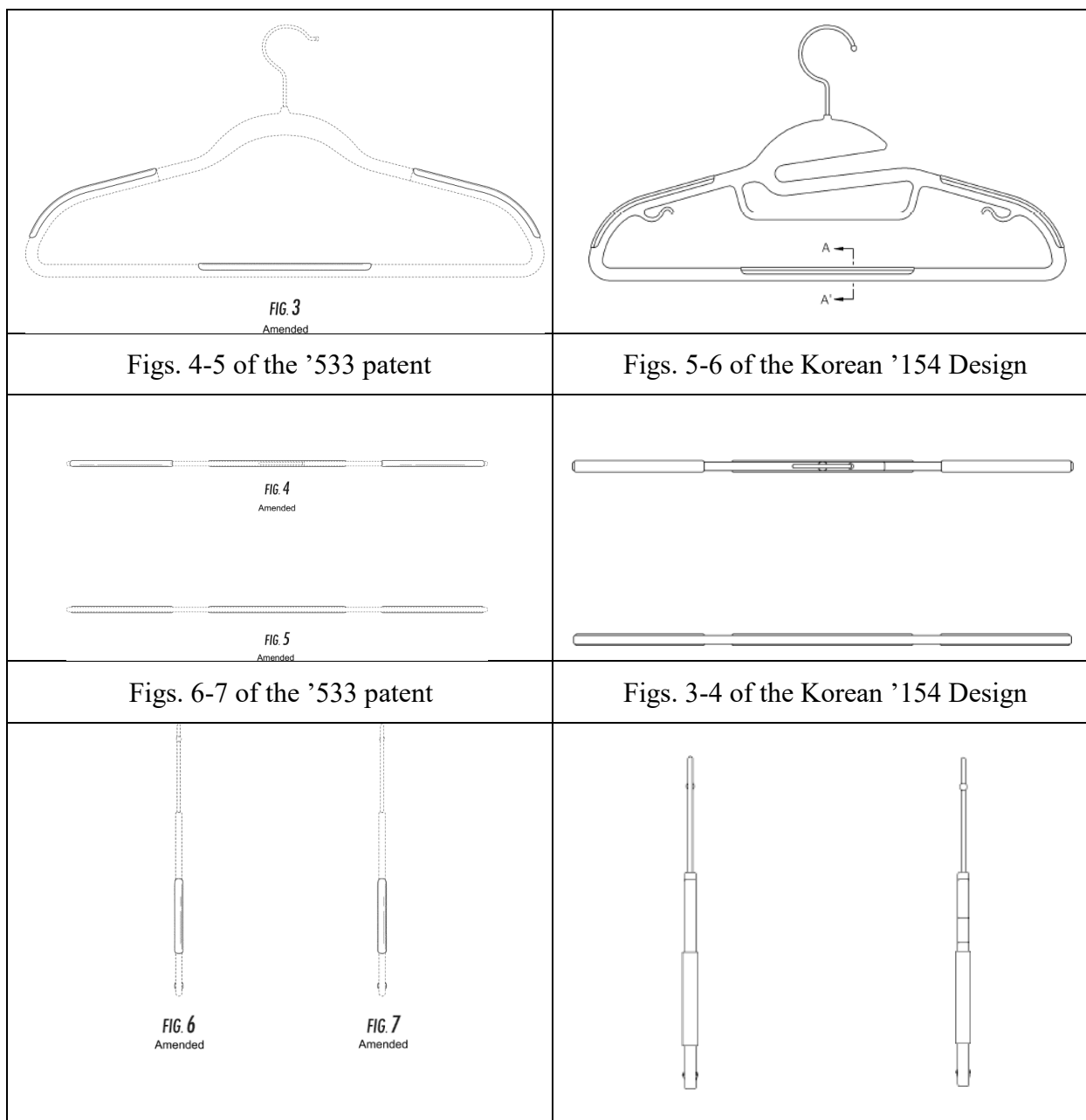
38. On information and belief, the Korean '154 published before the date of invention of the subject matter claimed in the '533 patent.

39. On information and belief, Defendant cannot establish a date of invention of the subject matter claimed in the '533 patent that is prior to January 14, 2010.

40. The Korean '154 is prior art to the '533 patent under 35 U.S.C. § 102(a) (pre-AIA).

41. The following is a side-by-side comparison of the '533 patent and the Korean '154:

Fig. 1 of the '533 patent	Fig. 1 of the Korean '154 Design
 <p>FIG. 1 Amended</p>	
Fig. 3 of the '533 patent	Fig. 2 of the Korean '154 Design



42. As such, the design claimed in the '533 Patent had been described in a printed publication (*i.e.*, the Korean '154) in a foreign country (*i.e.*, Korea), before the invention thereof.

43. The design claimed in the '533 Patent had been patented (*i.e.*, the Korean '154) in a foreign country (*i.e.*, Korea), before the invention thereof.

44. In addition, Ameziel's products including the 50 Series cannot infringe the '533 patent. Ameziel's products include nothing more than design features within the public domain.



45. Nevertheless, in good faith and in an effort to resolve the parties' dispute amicably, Ameziel engaged in a settlement negotiation with Wiesner during which Wiesner sought to license the '533 patent for a fee.

46. The negotiation spanned several months after Amazon removed the product listing of the 50 Series.

47. Ameziel never admitted any infringement of the '533 patent during negotiations.

48. On information and belief, Wiesner shut down negotiations with Ameziel upon learning of the Korean '154.

49. In February 2020, Wiesner sent Ameziel a second cease and desist letter ("February 2020 Letter") in which Wiesner terminated its offer to license the '533 patent, requested a settlement fee calculated using Ameziel's confidential information, and threatened to file a patent infringement lawsuit should Ameziel not respond to its demand by February 21, 2020.

50. For at least the reasons set forth above, an actual controversy has arisen and exists between the parties as to the validity of '533 patent and the alleged infringement by the manufacture and sale of Ameziel's products, including the 50 Series products.

#### **COUNT I – DECLARATION OF NON-INFRINGEMENT**

51. Ameziel repeats and incorporates by reference its allegations in each of the foregoing paragraphs as if fully set forth herein.

52. In its November 2019 Letter and February 2020 Letter, Wiesner avers that Ameziel infringes the '533 patent by at least manufacturing and selling the 50 Series.

53. The 50 Series products do not infringe any valid claim of the '533 patent.

54. For example, to the extent that Defendant argues that any alleged differences between the hanger design of Korean '154 and the claimed design of the '533 patent are sufficient for patentability, the differences between the 50 Series hangers and the claim of the '533 patent

likewise preclude infringement because an ordinary observer would not consider the 50 Series hangers and the claimed design substantially the same.

55. Further, Ameziel does not infringe, induce infringement of, and/or contributorily infringe, and has not infringed, induced infringement of, and/or contributorily infringed any valid claim of the '533 patent by manufacturing and selling its hanger products.

56. An actual case or controversy exists between Ameziel and Wiesner, based on Wiesner's claim that Ameziel's 50 Series products allegedly infringe the '533 patent.

57. Ameziel seeks and is entitled to a declaratory judgment that its 50 Series hangers do not infringe any valid claim of the '533 patent.

58. Without such declaratory relief, Ameziel will be irreparably harmed and damaged.

## **COUNT II – DECLARATION OF INVALIDITY OF THE ASSERTED PATENT**

59. Ameziel repeats and incorporates by reference its allegations in each of the foregoing paragraphs as if fully set forth herein.

60. The application for the Korean '154 was filed on May 12, 2009.

61. The Korean '154 published on January 14, 2010.

62. Specifically, it published in the Korea Intellectual Property Rights Information Services (KIPRIS) database, provided by the Korea Institute of Patent Information (KIPI) on behalf of the Korean Intellectual Property Office (KIPO), on January 14, 2010.

63. The Korean '154 qualifies as a "printed publication," as that term is used in 35 U.S.C. § 102(a) (pre-AIA).

64. The Korean '154 was "patented," as that term is used in 35 U.S.C. § 102(a) (pre-AIA).

65. The Korean '154 is a Korean design registration.

66. The Korean '154 published before the December 10, 2010 filing date of the '533

patent.

67. The Korean '154 is therefore presumptively prior art to the '533 patent.

68. On information and belief, the Korean '154 published before Samuel V. Cohen conceived of the design claimed in the '533 patent.

69. On information and belief, the Korean '154 published before the date of invention of the subject matter claimed in the '533 patent.

70. On information and belief, Defendant cannot establish a date of invention of the subject matter claimed in the '533 patent that is prior to January 14, 2010.

71. The Korean '154 is prior art to the '533 patent under 35 U.S.C. § 102(a) (pre-AIA).

72. As set forth above, the design claimed in the '533 Patent had been described in a printed publication (*i.e.*, the Korean '154) in a foreign country (*i.e.*, Korea), before the invention thereof.

73. The design claimed in the '533 patent thus is anticipated and/or rendered obvious by at least the Korean '154. *See* Paragraph 40, *supra*.

74. It would have been obvious for an ordinary designer to adapt the gripping elements disclosed in the Korean '154 for application onto other existing hanger configurations. *See, e.g.*, U.S. Patent Application Publication No. 2004/0256425 (Exhibit 4).

75. Moreover, the '533 patent does not qualify for patent protection because the claimed design is dictated by function rather than ornamental features.

76. For example, the claimed arrangement of hanger grips are functional/non-ornamental.

77. Indeed, Wiesner explains on its website that it “*always* design[s] with everyday functionality in mind,” (Exhibit 5) and markets hangers that embody this design as having “non-slip padding to keep clothing in place” in precisely the same location as the claimed elements of the

'533 Patent. *See* Exhibits 6-10.

78. The '533 Patent is invalid and void for failure to comply with one or more sections of Title 35 of the United States Code including, without limitation, 35 U.S.C. §§ 101, 102, 103, 112 and/or 171.

79. An actual controversy exists between Ameziel and Wiesner regarding whether or not the '533 patent is invalid.

80. Ameziel seeks and is entitled to a declaratory judgment that the '533 patent is invalid for failure to satisfy one or more conditions of patentability set forth in 35 U.S.C. §§ 101, 102, 103, 112 and/or 171. Without such declaratory relief, Ameziel will be irreparably harmed and damaged.

**COUNT III – DECLARATION OF LACK OF DAMAGES TO WIESNER**

81. Ameziel repeats and incorporates by reference its allegations in each of the foregoing paragraphs as if fully set forth herein.

82. Ameziel seeks and is entitled to a declaratory judgment that Wiesner has no claim for damages from the alleged infringing activities because the '533 patent is invalid and because Ameziel has not infringed any claim of the asserted patent.

**PLAINTIFF'S PRAYER FOR RELIEF**

Wherefore, Ameziel respectfully requests that this Court enter judgment in its favor and grant the following relief:

(a) A declaration that Ameziel's products, including 50 Series hangers, have not infringed, induced infringement of, or contributorily infringed, and do not infringe, induce infringement of, and/or contributorily infringe the '533 patent;

(b) A declaration that the '533 patent, is invalid and void for failure to comply with one or more sections of Title 35 of the United States Code including, without limitation, 35 U.S.C. §§ 101, 102, 103, 112 and/or 171 and/or failure to comply with 37 C.F.R. § 1.56;

- (c) A declaration that Wiesner has no claim for damages from the alleged infringement of the '533 patent;
- (d) A declaration that this case is “exceptional” within the meaning of 35 U.S.C. § 285;
- (e) An award to Ameziel of its costs, attorney fees, and expenses pursuant to 35 U.S.C. § 285; and
- (f) An award to Ameziel of any and all other just and reasonable relief to which it is entitled.

**JURY DEMAND**

Ameziel requests a trial by jury as to all issues triable by a jury.

Dated: February 9, 2020

Respectfully submitted,

/s/ Jonathan D. Ball

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