

**IN THE UNITED STATES DISTRICT COURT  
FOR THE WESTERN DISTRICT OF TEXAS  
AUSTIN DIVISION**

**HELEN OF TROY TEXAS  
CORPORATION, HELEN OF TROY  
NEVADA CORPORATION, HOT NEVADA,  
INC., AND OXO INTERNATIONAL, LTD.**

**Plaintiffs,**

**v.**

**SORENSEN RESEARCH &  
DEVELOPMENT,**

**Defendant.**

**CIVIL ACTION NO. 1:11-CV-457  
JURY TRIAL DEMANDED**

**COMPLAINT FOR DECLARATORY JUDGMENT**

Plaintiffs Helen of Troy Texas Corporation, Helen of Troy Nevada Corporation, HOT Nevada, Inc., and OXO International, Ltd. (collectively “Helen of Troy and OXO”) file this complaint under 35 U.S.C. §271 et seq. of the U.S. Patent laws for declaratory judgment against Defendant Sorensen Research & Development (“Sorensen”) and allege the following:

**PARTIES**

1. Helen of Troy Texas Corporation is a privately held Texas Corporation with its principal place of business at 1 Helen of Troy Plaza, El Paso, Texas 79912. Helen of Troy Nevada Corporation is a Nevada Corporation with its principal place of business at 1 Helen of Troy Plaza, El Paso, Texas 79912. HOT Nevada Inc. is a Nevada Corporation with its principal place of business at 1 Helen of Troy Plaza, El Paso, Texas 79912. OXO International, Ltd. is a Texas

limited partnership with its principal place of business at 1 Helen of Troy Plaza, El Paso, Texas 79912.

2. Helen of Troy Nevada Corporation, HOT Nevada Inc., and OXO International, Ltd. are subsidiaries of Helen of Troy Texas Corporation.

3. On information and belief, Defendant Sorensen Research & Development is a California trust with its principal place of business at 9930 Mesa Rim Road, Suite 300, San Diego, California 92121.

### **JURISDICTION AND VENUE**

4. This Court has jurisdiction over the subject matter of this action pursuant to 28 U.S.C. §§ 1331 and 1338(a) because this action involves substantial claims arising under the United States Patent Act, 35 U.S.C. § 1 *et seq.*

5. This Court may declare the rights and other legal relations of the parties pursuant to the Federal Declaratory Judgments Act, 28 U.S.C. §§ 2201 and 2202, because there is a case of actual controversy within the Court's jurisdiction to provide a declaratory judgment that Plaintiffs do not infringe U.S. Patent No. 6,599,460 (the "'460 patent") and that the '460 patent is invalid.

6. This Court has personal jurisdiction over Sorensen because Sorensen has constitutionally sufficient contacts with Texas to make personal jurisdiction proper in this Court. More specifically, the acts giving rise to the existing controversy were committed by Sorensen in this Judicial District.

7. Venue is proper in this Court pursuant to 28 U.S.C. § 1391(b) and (c). Sales of the product accused of infringement by Sorensen are managed by Plaintiff OXO in El Paso, Texas, which is located in this district.

### EXISTENCE OF AN ACTUAL CONTROVERSY

8. On April 28, 2011, Chris Kuczynski, an attorney for Sorensen, sent a demand letter (“the demand letter”) to Gerald J. Rubin, President and CEO of Helen of Troy, at Mr. Rubin’s address: 1 Helen of Troy Plaza, El Paso, Texas 79912. A true and correct copy of this letter is attached as Exhibit A.

9. The demand letter’s subject line reads, “RE: Helen ot [sic] Troy Limited, Helen of Troy Nevada Corporation, HOT Nevada, Inc., and OXO International, Ltd.’s (“OXO”) apparent unauthorized usage of the technology taught in United States Patent No. 6,599,460; OXO Good Grips Colander . . . .”

10. In the demand letter, Sorensen states that “[t]his letter constitutes a notice of patent infringement in violation of 35 U.S.C. § 271.” *See* Exhibit A, pg. 3 of 5. The demand letter includes further threatening statements such as:

(a) “. . . at least one line of OXO products that our inspection shows to infringe the ’460 patent . . . .” is the OXO Good Grips Colander. *Id.* at pg. 2 of 5;

(b) “OXO must obtain a license and release under the ’460 patent for the products it imported into, manufactured, offered for sale and/or sold within the United States. This requirement extends to any additional infringing OXO products that we have not yet identified. OXO has a legal duty to avoid infringement of United States patents. OXO’s manufacture of its products outside the United States does not avoid infringement liability when infringing products were imported into the United States.” *Id.*;

(c) “Should OXO fail to diligently investigate this matter upon receipt of this notice, it will be considered a breach of OXO’s affirmative duty to investigate allegations of patent infringement.” *Id.* at pg. 3 of 5;

(d) "... OXO is ultimately responsible for the infringement of the '460 patent in making, importing, offering for sale or selling its products and components. OXO's liability holds regardless of whether it makes these parts itself or through a third-party. Neither production of the Accused Products through manufacturing agents, nor production of the Accused Products outside of the United States excuses OXO's liability for infringement of the '460 patent." *Id.* at pg. 4 of 5;

(e) "OXO is the party that offers to sell and sells these products in the United States. Therefore, OXO is liable as a direct infringer for those products which infringe United States patents, including the '460 patent." *Id.*

(f) "OXO must recognize that licensing the '460 patented technology will allow it to continue to enjoy all the benefits and competitive advantages offered by this useful patent. By contrast, failure to license its usage of the '460 patented technology can only lead to the risk and expense of litigation, an award of damages, and attorneys' fees." *Id.* at pg. 5 of 5; and

(g) "[t]o protect Sorensen R&D's intellectual property rights, we cannot allow OXO's unlicensed usage to continue." *Id.*

11. On information and belief, since 2003, Sorensen ranks sixth as the most patent litigious entity, having sued at least thirty-four times on patents that Sorensen does not practice.

12. Indeed, on December 4, 2007, Sorensen filed a patent infringement suit against one or more of the Helen of Troy and OXO entities: *Sorensen ex rel. Sorensen Research and Development Trust v. Helen of Troy Texas Corp. et al.*, No. 3:07-cv-2278 (S.D. Cal.). In the California action, Sorensen accused Helen of Troy and OXO of infringing U.S. Patent No. 4,935,184 (the "'184 patent") and its foreign equivalents. Like the '460 patent, the '184 patent also had claims directed to injection molding of plastic products.

13. Upon information and belief, Sorensen is solely a licensing entity, and without enforcement, it receives no benefits from the '460 patent.

14. OXO's Good Grips Colander is not manufactured by any method claimed in the '460 patent and Sorensen has no evidence to support its allegations that it does.

15. Plaintiffs Helen of Troy and OXO reasonably believe that, under all the circumstances, there is a substantial and immediate, existing controversy between Plaintiffs and Sorensen due to the infringement allegations in Sorensen's demand letter and Sorensen's past licensing and enforcement activities against Plaintiffs. In light of the May 28, 2011 deadline imposed by Sorensen, this controversy is of sufficient immediacy and reality to warrant the issuance of a declaratory judgment.

#### **COUNT I – DECLARATORY JUDGMENT OF NONINFRINGEMENT**

16. Plaintiffs re-allege and incorporate by reference the allegations in contained in paragraphs 1 through 14.

17. On information and belief, Sorenson is the owner of the '460 patent, issued on July 29, 2003 and entitled "Prevention of Void-Based-Irregularity Formation in Thin-Wall, Injection-Molded Plastic Product." A true and correct copy of the '460 patent is attached as Exhibit B.

18. OXO makes, offers for sale, and sells plastic kitchen utensils including the plastic colander accused by Sorenson of infringing the '460 patent.

19. Based on Sorenson's past conduct, including filing a patent infringement lawsuit against Helen of Troy and OXO, and its current threats and allegations contained in Sorenson's demand letter, Helen of Troy and OXO believe, in good faith, that Sorenson will commence suit against Helen of Troy and OXO. Because OXO makes and sells the colander that Sorenson claims infringes the '460 patent, there is a substantial, continuing, and justiciable controversy between

Helen of Troy and OXO, on the one hand, and Sorenson, on the other hand, relating to the alleged infringement of the '460 patent.

20. No claim of the '460 patent can be validly construed to be infringed by any product made or sold by Plaintiffs Helen of Troy or OXO. Helen of Troy and OXO, and their divisions and subsidiaries, do not, via the OXO Good Grips Colander, or any other of Plaintiffs' products or processes, individually or collectively, infringe, either directly, indirectly, by contribution, or by inducement, or in any other way, any claim of the '460 patent, either literally or under the doctrine of equivalents, willfully or otherwise.

21. Accordingly, Plaintiffs Helen of Troy and OXO are entitled to a declaratory judgment that they do not infringe any claim of the '460 patent.

#### **COUNT II – DECLARATORY JUDGMENT OF INVALIDITY**

22. Plaintiffs re-allege and incorporate by reference the allegations in contained in paragraphs 1 through 21.

23. One or more claims of the '460 patent are invalid for failure to comply with one or more of the conditions for patentability set forth in 35 U.S.C. §§ 101, 102, 103, and 112.

24. Accordingly, Helen of Troy and OXO are entitled to a declaratory judgment that the claims of the '460 patent are invalid.

#### **PRAYER FOR RELIEF**

WHEREFORE, Plaintiffs pray for the following relief:

A. A declaratory judgment that Plaintiffs Helen of Troy and OXO, and their subsidiaries and divisions, do not, via the OXO Good Grips Colander, or any other of Plaintiffs' products or processes, individually or collectively, infringe, and have not infringed, literally or

by equivalents, directly or by inducement or contributory infringement, any claim of the '460 patent;

B. A declaratory judgment that the claims of the '460 patent are invalid;

C. A judgment finding this case exceptional and awarding Plaintiffs their costs and reasonable attorneys' fees under 35 U.S.C. § 285;

D. A judgment awarding Plaintiffs such other and further relief as is just and equitable.

### **JURY DEMAND**

Plaintiffs demand that all claims and causes of action raised in this complaint against Defendant be tried to a jury.

Dated: June 2, 2011

Respectfully submitted,

/s/ Roderick B. Williams

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