

**IN THE UNITED STATES DISTRICT COURT
NORTHERN DISTRICT OF ILLINOIS
EASTERN DIVISION**

NEWSRING INDUSTRIAL)	
CORPORATION,)	
)	
Plaintiff,)	
)	
vs.)	Case No. 06 C 0397
)	
MASS DISTRIBUTORS WAREHOUSE,)	Judge Robert W. Gettleman
INC., D.J. PAYNE CORP. and STEVEN H.)	
BERLIANT,)	Magistrate Judge Cole
)	
Defendants.)	

**PLAINTIFF NEWSRING INDUSTRIAL
CORPORATION'S FIRST AMENDED COMPLAINT**

Plaintiff, NEWSRING INDUSTRIAL CORPORATION ("Newspring"), by and for its First Amended Complaint in the above-captioned matter, states as follows:

THE PARTIES

1. Newspring is a corporation with its principal place of business located at 35 O'Brien Street, Kearny, New Jersey 07032 and incorporated in the State of New Jersey. Newspring is a wholly-owned company of Pactiv Corporation, a publicly traded company (NYSE: PTV) with its headquarters in Lake Forest, Illinois and a leading producer of specialty packaging products for the consumer and foodservice/food packaging markets.

2. On information and belief, Defendant Mass Distributors Warehouse, Inc. ("Mass Distributors"), is an entity having a place of business at 900 Morse Avenue, Elk Grove Village, Illinois, 60007 and is incorporated in the State of Illinois.

3. On information and belief, Defendant D.J. Payne Corp. (“D.J. Payne”) is an entity having a place of business at 900 Morse Avenue, Elk Grove Village, Illinois, 60007 and is incorporated in the State of Illinois.

4. On information and belief, Steven H. Berliant is the incorporator, controlling shareholder and controlling principal of Mass Distributors and D.J. Payne.

JURISDICTION AND VENUE

5. This Court has subject matter jurisdiction in this matter pursuant to 28 U.S.C. §§ 1331, 1338 and 1367.

6. Under 28 U.S.C. §§ 1391(b), 1391(c) and 1400(b), venue is appropriate in this judicial district. Defendants Mass Distributors and D.J. Payne are incorporated, and have a regular and established place of business in this judicial district. Defendant Steve Berliant resides and conducts regular business in this judicial district. All infringement and other causes of action have occurred in this judicial district. All Defendants are subject to personal jurisdiction in this district.

NEWSPRING’S PATENTS

7. On February 11, 1997, Jeffrey Chen applied to the U.S. Patent and Trademark Office (“PTO”) for a design patent, application number 29/066,299. U.S. Patent No. D415420 (the “‘420 patent”) issued on October 19, 1999. A copy of the ‘420 patent is attached as Exhibit A hereto.

8. Jeffrey Chen assigned the ‘420 patent to Newspring.

9. The ‘420 patent is a design patent claiming figures depicting a round container.

10. On January 14, 2000, Jeffrey Chen applied to the PTO for a utility patent with application number 09/483,350. On May 6, 2001, U.S. Patent No. 6,196,404 B1 (the “‘404 patent”) issued. A copy of the ‘404 patent is attached as Exhibit B hereto.

11. Jeffrey Chen assigned the ‘404 patent to Newspring.

12. The ‘404 patent is a utility patent for features of the container seal with protrusion.

THE VERSAtainer® PRODUCT TRADE DRESS

13. Newspring has successfully developed a new container that is marketed under the registered trademark VERSAtainer® (“VERSAtainer®”). The VERSAtainer® is an attractive, high quality food container utilizing features disclosed in the ‘420 and ‘404 patents.

14. Newspring’s VERSAtainer® products are sold, typically via distributors, to a wide range of end users such as restaurants, educational and government institutions with food-service programs. The relevant market for Newspring is characterized by purchasers who associate certain designs with certain manufacturers such as Newspring.

15. Although not part of the ‘420 Patent, certain other distinctive features of the VERSAtainer® identify the product to the public and are, thus, relevant to Newspring’s trade dress claim. Specifically, among other things, the model numbers of the different shaped products, the colors of the opaque plastic bottom of the container, and the type of packaging contribute to the distinctive image and customer identification of the VERSAtainer®.

16. The VERSAtainer® is available in either black or white. Those colors do not aid in performing the function of the VERSAtainer®.

17. The design of the VERSAtainer®, including those elements that are the subject of the ‘420 Patent, and also including the black and white color of the container bottoms, has

acquired a secondary meaning in that it signifies to the purchasing distributor or commercial end user that the product emanates from Newspring.

18. In the wholesale market for commercial food containers, products are typically known industry-wide by their model numbers, and secondary meaning attaches to those model numbers as indicators of source, manufacturer and commercial affiliation of the product. Newspring's most prominent models of the VERSAtainer® are Model Nos. 718, 723, 729, 838, 868 and 888 (the "718", "723", "729", "838", "868" and "888").

19. The food container industry knows and readily recognizes the 718, 723, 729, 838, 868 and 888 as distinctive and innovative products of Newspring and associates the numeric model designations with Newspring as the source of manufacture and commercial affiliation of the product. The 718, 723, 729, 838, 868 and 888, when applied to plastic food containers and within the wholesale market for commercial food containers, have acquired secondary meaning.

20. Newspring developed packaging of the VERSAtainer® in 150/150 combo packaging where 150 lids and 150 bases of the containers, respectively, are compactly stacked separately in cartons to effectively utilize shipping/storage space.

21. The food container industry knows and readily recognizes 150/150 combo packaging with Newspring as the source of manufacture and commercial affiliation of the product. The 150/150 combo packaging, when applied to plastic food containers and within the wholesale market for commercial food containers, has acquired secondary meaning.

DEFENDANTS' INFRINGING ACTIVITIES

22. For several years, the Defendants have acted as major distributor of Newspring's VERSAtainer products. Thus, the purchasing public has come to identify Defendants as a legitimate source of Newspring VERSAtainer® patented products.

23. More recently, the Defendants have dramatically reduced their purchases of Newspring VERSAtainer® products.

24. On information and belief, as substitute products, the Defendants have been offering for sale and selling their infringing containers (“the infringing goods”).

25. On information and belief, the infringing goods are round and rectangular plastic containers with transparent lids and opaque bases.

26. On information and belief, the infringing goods bear model numbers that are similar too and/or identical to the model numbers on similar Newspring VERSAtainer® products

27. On information and belief, the Defendants have been offering for sale and selling the infringing goods under the brand name “Skyline”.

28. Attached hereto as Exhibit C is a picture of a round container with a black base and transparent lid.

29. On information and belief, the Defendants have been offering for sale and selling one or more round container products similar to that included in Exhibit C.

30. On information and belief, the Defendants have been offering for sale and selling one or more round container products similar to that included in Exhibit C under the brand name “Skyline”.

31. Attached hereto as Exhibit D is a picture of a rectangular container with a black base and transparent lid.

32. On information and belief, the Defendants have been offering for sale and selling one or more rectangular container products similar to that included in Exhibit D.

33. On information and belief, the Defendants have been offering for sale and selling one or more rectangular container products similar to that included in Exhibit D under the brand name "Skyline".

34. On information and belief, the infringing products include those similar to those included as Exhibits C and D.

35. On information and belief, the Defendants have approached and continue to approach persons or entities in the market for plastic food containers, including Newspring's previous VERSAtainer® customers, and offered to sell to these customers Defendants' infringing products.

36. On information and belief, the Defendants now market, offer for sale and sell infringing goods to customers within the Northern District of Illinois.

37. On information and belief, the infringing goods employ the design claimed in the '420 Patent.

38. On information and belief, the infringing goods employ the technology claimed in the '404 Patent.

39. On information and belief, by marketing, offering for sale and selling infringing goods Defendants are infringing the '420 patent.

40. On information and belief, by marketing, offering for sale and selling infringing goods Defendants are infringing the '404 patent.

41. The design of the infringing products is essentially identical to the design of Newspring's VERSAtainer® products.

42. The infringing products contain many of the other distinctive trade dress attributes of the VERSAtainer® products.

COUNT I-PATENT INFRINGEMENT

43. To the extent applicable, Newspring realleges and incorporates by reference paragraphs 1 through 42 hereof as though fully set forth herein.

44. This cause of action arises under the Patent Act, 35 U.S.C. § 101 et seq.

45. On information and belief, the Defendants have marketed, sold and offered to sell the infringing products.

46. On information and belief, Defendants' conduct amounts to infringement of the '420 patent.

47. On information and belief, Defendants' conduct amounts to infringement of the '404 patent.

48. The Defendants' acts violate Newspring's rights under the patent laws of the United States.

49. Newspring notified the public of its rights under the '420 patent and the '404 patent in accordance with 35 U.S.C. § 287.

50. On information and belief, the Defendants' acts of infringement were and continue to be knowing and willful in violation of Newspring's rights under the patent laws of the United States and the '420 patent and the '404 patent.

51. The Defendants' knowing and willful acts of patent infringement are continuing and ongoing.

52. On information and belief, the Defendants will not cease committing the wrongful acts alleged in this Complaint without this Court's intervention.

53. Newspring has suffered monetary damages due to the wrongful acts of patent infringement by the Defendants, including without limitation sales unfairly lost and/or diverted to them, all to the detriment of Newspring.

COUNT II-TRADE DRESS INFRINGEMENT (Lanham Act)

54. To the extent applicable, Newspring realleges and incorporates by reference paragraphs 1 through 53 hereof as though fully set forth herein.

55. This cause of action arises under the Lanham Act, 15 U.S.C. § 1051 et seq.

56. The look of the VERSAtainer®, including without limitation its configuration and design, color, transparent lid, model number, packaging and other elements of its appearance, constitute a trade dress protectable under the trademark laws of the United States, 15 U.S.C. § 1051 et seq.

57. In connection with the infringing products, Defendants have engaged in the unauthorized use in commerce of Newspring's VERSAtainer® trade dress in a manner that is likely to cause confusion, mistake or to deceive another person as to the source, origin or affiliation of the Defendants' commercial activities and infringing product.

58. The acts of the Defendants constitute trade dress infringement in violation of 15 U.S.C. § 1125.

59. Defendants' wrongful acts of trade dress infringement are continuing and ongoing.

60. On information and belief, the conduct alleged in paragraphs 55-59, supra, has occurred in interstate commerce.

61. On information and belief, the Defendants' acts of infringement were and continue to be intentionally and knowingly in violation of Newspring's rights under the laws of the United States.

62. On information and belief, the Defendants will not cease committing the wrongful acts alleged in this Complaint without this Court's intervention.

63. Newspring has suffered and will continue to suffer monetary damages due to the wrongful acts of trade dress infringement by Defendants, including without limitation sales unfairly lost and/or diverted to the Defendants.

COUNT III-UNFAIR COMPETITION (Lanham Act)

64. To the extent applicable, Newspring realleges and incorporates by reference paragraphs 1 through 63 hereof as though fully set forth herein.

65. This cause of action arises under the Lanham Act, 15 U.S.C. § 1051 et seq.

66. On information and belief, in connection with the infringing goods, Defendants utilize words, terms and symbols that are similar to the VERSAtainer® Model Numbers.

67. On information and belief, in connection with promotion of their business and products, including the infringing goods, Defendants utilize the VERSAtainer® name and Model Numbers.

68. On information and belief, Defendants have publicly promoted themselves as a legitimate source of Newspring VERSAtainer® products.

69. On information and belief, the conduct alleged in paragraphs 65-67, supra, has occurred in interstate commerce.

70. On information and belief, the aforementioned conduct by Defendants is likely to cause confusion, to cause mistake and/or to deceive potential customers as to the origin, sponsorship, and/or approval of Defendants' goods and/or commercial activities by Newspring.

71. On information and belief, the relevant purchasing public perceives Defendants as a legitimate source of Newspring VERSAtainer® products.

72. On information and belief, the Defendants' acts of unfair competition have been and continue to be intentionally and knowingly in violation of Newspring's rights.

73. On information and belief, the Defendants will not cease committing the wrongful acts alleged of herein without this Court's intervention.

74. Newspring has suffered and will continue to suffer monetary damages due to the wrongful acts of unfair competition by Defendants, including without limitation sales unfairly lost and/or diverted to the Defendants.

**COUNT IV-UNFAIR COMPETITION (Illinois Uniform Deceptive Trade Practices Act
and Illinois Common Law)**

75. To the extent applicable, Newspring realleges and incorporates by reference paragraphs 1 through 74 hereof as though fully set forth herein.

76. This cause of action arises under the Illinois Uniform Deceptive Trade Practices Act (UDTPA) codified at 815 ILCS 510/1 *et. seq.* and the common law of the State of Illinois.

77. This Court has subject matter jurisdiction over this cause of action pursuant to 28 U.S.C. § 1367.

78. On information and belief, in the course of their business, the Defendants have marketed, used, sold, offered for sale and distributed in this State a reproduction, counterfeit,

copy, or colorable imitation of the VERSAtainer®'s trade dress on their infringing goods in a manner likely to cause confusion or misunderstanding as to the source of the infringing goods.

79. On information and belief, Defendants' goods are likely to confuse or mislead customers as to source because they contain, for example, design elements claimed in the '420 Patent and many of the other distinctive attributes of Newspring's VERSAtainer® products, including deceptively similar model numbers, packaging and identical colors.

80. On information and belief, Defendants' marketing, use, sale, offers for sale and distribution in this State of a reproduction, counterfeit, copy, or colorable imitation of the VERSAtainer®'s trade dress on their infringing goods in a manner likely to cause confusion or misunderstanding as to the source of the infringing goods, constitute deceptive acts in violation of 815 ILCS 510/2 §§ 2(a)(2) and 2(a)(12) and the common law of Illinois.

81. On information and belief, in the course of their business, Defendants have passed off their infringing goods as goods of Newspring, intentionally and with knowledge of the damage to and unfair appropriation of Newspring's rights.

82. The Defendants' acts of passing off its goods as those of Newspring constitute deceptive acts in violation of 815 ILCS 510/2 §§ 2(a)(1) and 2(a)(12) and the common law of Illinois.

83. On information and belief, the Defendants' acts of unfair competition were and continue to be willful and knowing, in violation of the rights of Newspring under the laws of the State of Illinois.

84. On information and belief, the Defendants will not cease committing the wrongful acts alleged in this Complaint without the intervention and injunction of this Court.

WHEREFORE, Newspring respectfully requests and demands judgment as follows:

a. That the Defendants and their agents, employees, assigns, and all persons acting under their control, be permanently enjoined from manufacturing, selling, attempting to sell, purchasing, promoting, storing, shipping, receiving, maintaining in their possession or otherwise exploiting in commerce the infringing products or any other product that (1) infringes the '420 patent and/or the '404 patent, (2) is confusingly similar in trade dress or otherwise to the VERSAtainer®, or (3) constitutes an unauthorized imitation of the VERSAtainer® or passing off of such an imitation as the VERSAtainer® product;

b. That plaintiff Newspring be awarded its actual and consequential damages in an amount necessary to compensate Newspring for the damages caused by the Defendants' conduct in violation of law and equity, including the patent infringement, trade dress infringement and unfair competition committed by Defendants.

c. That plaintiff Newspring be awarded the profits of the Defendants related to the infringing products, pursuant to 15 U.S.C. § 1117 and 35 U.S.C. § 289.

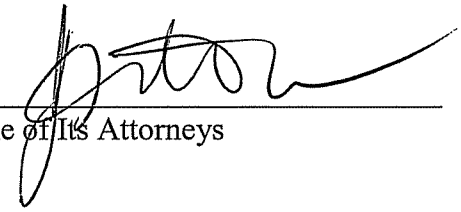
d. That plaintiff Newspring be awarded treble damages pursuant to 35 U.S.C. § 284 and 15 U.S.C. § 1117.

e. That the Court declare this an exceptional case and that plaintiff Newspring be awarded its costs and attorneys fees in this action pursuant to 35 U.S.C. § 285 and 15 U.S.C. § 1117.

f. That Newspring be awarded such further relief as the Court shall find just and equitable.

Respectfully submitted,

NEWSPRING INDUSTRIAL CORPORATION,
Plaintiff

By: 
One of Its Attorneys

Mr. Jonathan M. Weis - #06238340
Mr. Mitchell S. Chaban - #6226668
LEVIN GINSBURG
180 North LaSalle Street, Suite 3200
Chicago, Illinois 60601-2800
Telephone: 312-368-0100
Facsimile: 312-368-0111
Local Counsel

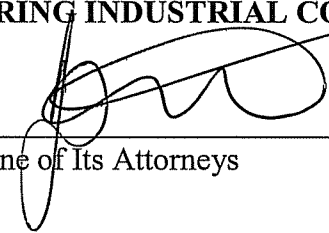
Mr. David E. De Lorenzi, *admitted pro hac vice*
Mr. Michael Cukor
Mr. Oren J. Warshavsky, *pro hac vice pending*
Ms. Sheila F. McShane
**GIBBONS, DEL DEO, DOLAN,
GRIFFINGER & VECCHIONE**
A Professional Corporation
One Riverfront Plaza
Newark, New Jersey 07102
Telephone: 973-596-4500
Attorneys for Plaintiff
Newspring Industrial Corporation

JURY DEMAND

Pursuant to Fed. R. Civ. P. 38(b), plaintiff Newspring Industrial Corporation hereby demands a jury trial on all issues.

Respectfully submitted,

NEWSPRING INDUSTRIAL CORPORATION,
Plaintiff

By:  _____
One of Its Attorneys

Mr. Jonathan M. Weis - #06238340
Mr. Mitchell S. Chaban - #6226668
LEVIN GINSBURG
180 North LaSalle Street, Suite 3200
Chicago, Illinois 60601-2800
Telephone: 312-368-0100
Facsimile: 312-368-0111
Local Counsel

Mr. David E. De Lorenzi, *admitted pro hac vice*
Mr. Michael Cukor
Mr. Oren J. Warshavsky, *pro hac vice pending*
Ms. Sheila F. McShane
**GIBBONS, DEL DEO, DOLAN,
GRIFFINGER & VECCHIONE**
A Professional Corporation
One Riverfront Plaza
Newark, New Jersey 07102
Telephone: 973-596-4500
Attorneys for Plaintiff
Newspring Industrial Corporation