

100 ✓ 64
MJD/JTG

IN THE UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF MINNESOTA

**JOHN MEZZALINGUA ASSOCIATES,
INC., (d/b/a PPC) a Delaware corporation,**

Case No: _____

Plaintiff,

vs.

**PACE ELECTRONICS, INC. (d/b/a
PACE INTERNATIONAL), a Minnesota
corporation,**

Defendant.

COMPLAINT

JURY DEMANDED

John Mezzalingua Associates, Inc., d/b/a PPC ("PPC"), hereby complains against defendant Pace Electronics, Inc. ("Pace"), and alleges as follows:

I. THE PARTIES

1. PPC is a corporation organized and existing under the laws of the State of Delaware, and has its principal place of business at 6176 Molloy Road, East Syracuse, New York, 13057.

2. Upon information and belief, Pace is a corporation organized and existing under the laws of the State of Minnesota and has its principal place of business at 3582 Technology Drive NW, Rochester, Minnesota, 55901.

II. JURISDICTION AND VENUE

3. This is a civil action by PPC for patent infringement committed by Pace, which arises under the patent laws of the United States, including 35 U.S.C. §§ 271, 281, 283, 284, and 285.

4. This is a civil action for misappropriation of trade dress under Sections 34, 35, 36 and 43 of the Lanham Act, Title 15 U.S.C. §§ 1116, 1117, 1118 and 1125.

SCANNED
JAN 10 2010
U.S. DISTRICT COURT MPLS

5. This Court has original jurisdiction over the subject matter of this action pursuant to 28 U.S.C. § 1331, 28 U.S.C. § 1338(a), § 1338(b) and 15 U.S.C. § 1121.

6. PPC further alleges on information and belief, that Pace has sold or contracted for the sale of infringing goods to its customers throughout the world, including customers within the State of Minnesota. These actions by Pace relate to and, in part, give rise to the claims asserted herein by PPC, and have resulted in injury to PPC.

7. Pace is subject to the personal jurisdiction of this Court because, on information and belief, Pace is a Minnesota corporation and has its principal place of business in the State of Minnesota.

8. Pursuant to 28 U.S.C. § 1391(c), Pace is deemed to reside in this judicial district for purposes of venue.

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

III. FACTUAL BACKGROUND

10. PPC is an innovator and world leader in telecommunications connector technology.

11. One of PPC's technological innovations is protected by United States Patent No. 7,118,416 ("416 patent") directed to "cable connector with elastomeric band." A true and correct copy of the '416 patent is attached hereto as Exhibit A.

12. The '416 patent issued on October 10, 2006 to inventors Noah Montena and Michael T. Fox.

13. PPC is the owner by assignment of the '416 patent.

14. PPC has not licensed Pace to practice the '416 patent and Pace has no right or authority to license others to practice the '416 patent.

15. PPC is a world leader in telecommunication connector technology. PPC is, and has been, extensively engaged in the business of designing, manufacturing and nationwide

marketing and distributing of coaxial cable connectors, including those marketed under the "EX" branded series. PPC's EX connectors have been extensively advertised and sold throughout the United States.

16. Prior to Pace's infringing acts, PPC has continuously sold the EX connectors throughout the world.

17. The external appearance, or trade dress, of PPC's EX connectors is unique and distinctive ("EX Connector Trade Dress"). Exhibit B attached hereto includes an image of a PPC EX connector (bottom connector).

18. PPC has invested substantially in efforts to develop recognition and goodwill for its EX Connector Trade Dress among both PPC's direct customers and the consuming public generally. These efforts include, *inter alia*, substantial investment in design, advertising and distribution of products incorporating the EX Connector Trade Dress.

19. Through, *inter alia*, these efforts, the EX Connector Trade Dress has become a valuable asset to PPC, symbolizing its quality products and PPC's good will. Additionally, the EX Connector Trade Dress has become widely known in the minds of the consuming public and in the trade as identifying connectors which originate from PPC.

20. On information and belief, despite its knowledge of PPC's EX Connector Trade Dress, and the rights associated with it, Pace adopted, imitated, and used such trade dress in connection with infringing connectors distributed by Pace, including interstate distribution of Pace's MVP-RG6-U connector. An image of a Pace MVP-RG6-U connector is shown in Exhibit B (top connector).

21. Pace's use of PPC's EX Connector Trade Dress in connection with its own connectors is a false designation of origin, a false representation, wrongfully and falsely designates Pace's products as originating from or connected with PPC, and constitutes utilization of false descriptions and false representations in interstate commerce.

IV. FIRST CAUSE OF ACTION

Infringement of the '416 Patent

22. By this reference PPC realleges and incorporates the foregoing paragraphs as though fully set forth herein.

23. PPC alleges on information and belief that Pace has infringed and continues to infringe the '416 patent by making, using, selling, offering for sale within the United States, or importing into the United States products that embody one or more of the claims of the '416 patent, or by contributing to infringement, inducing others to infringe the '416 patent, or carrying out acts constituting infringement under 35 U.S.C. § 271(f). By way of example and not limitation, one such act of infringement is the importation, manufacture, use, sale and/or offer for sale of Pace's MVP-RG6-U connector.

24. PPC alleges, on information and belief, that unless and until enjoined by this Court, Pace will continue to infringe the '416 patent.

25. The conduct of Pace as set forth above gives rise to a claim for infringement of the '416 patent, pursuant to at least 35 U.S.C. §§ 271 and 281.

26. PPC alleges on information and belief that Pace will continue to infringe the '416 patent subsequent to receiving notice of the initiation of this action despite an objectively high likelihood that its actions constitute infringement, thereby making its actions both willful and deliberate.

27. By reason of the foregoing, PPC is entitled to injunctive and monetary relief against Pace, pursuant to 35 U.S.C. §§ 283, 284, and 285.

V. SECOND CAUSE OF ACTION

Federal Unfair Competition

28. By this reference PPC realleges and incorporates the foregoing paragraphs as though fully set forth herein.

29. Pace's use of PPC's EX Connector Trade Dress in its own products is deceptive and is likely to cause mistake and confusion regarding whether Pace's goods and services originate from PPC, or are sponsored or approved of by PPC.

30. Pace's use of PPC's EX Connector Trade Dress in its products is deceptive and is likely to cause mistake and confusion regarding whether Pace is affiliated, connected or associated with PPC.

31. By reason of at least the foregoing, Pace's use of PPC's EX Connector Trade Dress in its coaxial connectors, including, but not limited to, Pace's MVP-RG6-U connector, gives rise to a cause of action pursuant to Section 43(a)(1)(A) of the Lanham Act, 15 U.S.C. § 1125(a)(1)(A).

32. Upon information and belief, Pace has infringed PPC's EX Connector Trade Dress and other intellectual property rights with the intent to cause confusion and mistake and to deceive both with respect to the origin, sponsorship and approval of its goods and services by PPC, and with respect to whether Pace is affiliated, connected or associated with PPC.

33. Upon information and belief, Pace has infringed PPC's EX Connector Trade Dress and other intellectual property rights with willful and deliberate disregard for the rights of PPC and the consuming public to be free from the deception and likelihood of confusion and mistake to which Pace's conduct gives rise.

34. By reason of Pace's infringement of PPC's EX Connector Trade Dress and other acts of unfair competition, PPC has suffered damages and irreparable harm.

35. By reason of the foregoing, PPC is entitled to monetary and injunctive relief pursuant to Sections 34-36 of the Lanham Act, 15 U.S.C. §§ 1116 - 1118, as more fully set forth below.

36. Pace's acts are in violation of Section 43(a) of the Lanham Act, 15 U.S.C. § 1125(a).

37. Pace's violation has caused, and unless enjoined by this Court will continue to cause, irreparable damage and injury to PPC. By reason of Pace's infringement of PPC's trade

dress and other acts of unfair competition, PPC has suffered damages and irreparable harm. PPC has no adequate remedy at law.

38. By reason of the foregoing, PPC is entitled to monetary and injunctive relief pursuant to at least Sections 34-36 of the Lanham Act, 15 U.S.C. §§ 1116 - 1118, as more fully set forth hereinbelow.

VI. PRAYER FOR RELIEF

WHEREFORE, PPC prays for judgment against Pace as follows:

- A. A judgment finding Pace liable for infringement of the '416 patent;
- B. An Order of this Court pursuant to at least 35 U.S.C. § 283 permanently enjoining Pace, its agents and servants, and any and all parties acting in concert with any of them, from: directly or indirectly infringing in any manner the '416 patent, whether by making, using, selling, offering to sell, or importing into the United States any product falling within the scope of any of the claims of the '416 patent; engaging in acts constituting contributory infringement of any of the claims of the '416 patent; or inducing others to engage in any of the aforementioned acts or otherwise;
- C. An Order of this Court pursuant to at least 35 U.S.C. § 283 directing Pace to destroy its entire stock of infringing products within the United States;
- D. An award of damages to PPC, in an amount to be proven at trial, pursuant to at least 35 U.S.C. § 284;
- E. Trebling of PPC's damages in view of the willful infringement by Pace, and the award of such trebled damages to PPC pursuant to at least 35 U.S.C. § 284;
- F. An award to PPC of prejudgment interest, pursuant to at least 35 U.S.C. § 284;
- G. An award to PPC of its costs in bringing this action, pursuant to at least 35 U.S.C. § 284, and Rule 54(d)(1) of the Federal Rules of Civil Procedure;
- H. That this be declared an exceptional case, and that PPC be awarded its attorneys' fees and expenses, pursuant to at least 35 U.S.C. § 285;
- I. An award of post-judgment interest, pursuant to at least 28 U.S.C. § 1961(a);

J. That this Court enter judgment that Pace has violated Section 43(a) of the Lanham Act and has engaged in common law unfair competition by utilizing PPC's EX Connector Trade Dress and has injured PPC's business and business reputation and good will by utilizing such trade dress.

K. That this Court enter judgment that Pace deliver up for destruction by this Court, or by authorized agents of PPC, all advertising and promotional materials, labels, cartons, brochures, catalogues, business stationery, calling cards, information sheets, posters, signs and any or all other printed or graphic materials of any type, including the plates, molds, or other means for producing the same, which bear or show the trade dress of Pace's Infringing Connectors, or any colorably similar variations or simulations thereof.

L. For a permanent injunction enjoining Pace, its officers, agents, servants, employees and attorneys, and those in active concert or participation with them, and Pace's successors and assigns from:

1. Further advertising, offering for sale, selling or distributing goods or services not originating with PPC and bearing or incorporating the EX Connector Trade Dress or any colorably similar variations or simulations thereof, or that is likely to be mistaken or confused with PPC's EX Connector Trade Dress or is likely to create the erroneous impression that Pace or Pace's products originate with PPC, are endorsed by PPC, are sponsored by PPC, or that Pace and its products and services are in any way connected with those of PPC;

2. Competing unfairly with PPC, as complained of in this Complaint.

M. That Pace be directed to file with this Court and serve on PPC within thirty days after the service of an injunction, a report in writing under oath, setting forth in detail the manner and form in which Pace has complied with the Court-ordered injunctions.

N. That this Court enter judgment that Pace has deliberately and intentionally carried on the activities in violation of Section 43(a) of the Lanham Act and constituting unfair competition complained of herein.

O. That Pace be required to account for and pay to PPC any and all profits derived by Pace, and all damages sustained by PPC, by reason of the activities in violation of Section 43(a) of the Lanham Act and unfair competition complained of in this Complaint, that those amounts be trebled pursuant to 15 U.S.C. § 1117.

P. That PPC have, and recover from Pace, PPC's reasonable attorneys fees pursuant to the provisions of Title 15 U.S.C. § 1117 because of the calculated and deliberate nature of the activities of Pace sought to be enjoined hereby, and additional reasons which makes this an exceptional case warranting such an award.

Q. That Pace be required to pay punitive damages to PPC.

R. That PPC be awarded its costs of this action.

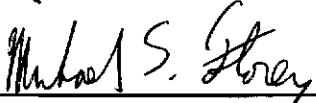
S. For such other and further relief as the Court deems just, proper, and equitable.

VII. DEMAND FOR JURY

PPC demands TRIAL BY JURY of all causes so triable.

DATED: January 7, 2010

Respectfully Submitted,

By 
Michael E. Florey (#214322)
David A. Gerasimow (#0389309)
FISH & RICHARDSON, P.C.
3200 RBC Plaza
60 South Sixth Street
Minneapolis, MN 55402
Telephone: 612-335-5070
Facsimile: 612-288-9696
florey@fr.com
gerasmiow@fr.com

Sterling A. Brennan*
C. J. Veverka*
WORKMAN NYDEGGER, P.C.
60 East South Temple
Salt Lake City, UT 84010
Telephone: 801-533-9800
Facsimile: 801-328-1707

*moving for *pro hac vice* admission

Attorneys for PPC and JOHN Mezzalingua Associates,
Inc.