

**UNITED STATES DISTRICT COURT  
SOUTHERN DISTRICT OF FLORIDA**

Case No.: 10-CV-60524-Zloch/Rosenbaum

**PLASTICASE, INC.**, a Foreign  
corporation,

Plaintiff,

v.

**INVICTA WATCH COMPANY OF  
AMERICA, INC.**, a Florida corporation,

Defendant.

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**FIRST AMENDED COMPLAINT FOR PATENT INFRINGEMENT, FALSE  
DESIGNATION OF ORIGIN AND UNFAIR COMPETITION**

**INJUNCTIVE RELIEF SOUGHT**

Plaintiff, Plasticase, Inc. (hereinafter “Plasticase”), by and through undersigned counsel, hereby sues Defendant, Invicta Watch Company of America (hereinafter “Invicta”), and alleges as follows:

**NATURE OF THE ACTION**

1. This is an action for patent infringement, false designation of origin, and unfair competition in connection with Invicta’s making, importing, offering for sale and selling plastic watch cases that are virtually identical to the designs covered by United States design patents owned and duly assigned to Plasticase. Invicta requested and obtained sample cases from Plasticase, which it then used to manufacture knock-offs that have been widely advertised online and through television programs and sold throughout the United States. Invicta's infringing conduct has damaged Plasticase and inflicted irreparable harm.

2. Plasticase seeks, *inter alia*, disgorgement of Invicta's profits from the sale of infringing products, and injunctive relief.

### **JURISDICTION AND VENUE**

3. This Court has original jurisdiction over the claims for patent infringement, false designation of origin, and unfair competition under 28 U.S.C. §§ 1331 and 1338(a) in that said claims arise under the Patent Laws of the United States, 35 U.S.C. § 1 et seq. and the United States Trademark Statute, 15 U.S.C. § 1051, et seq. This Court has supplemental jurisdiction over the remaining related state and common law claims under 28 U.S.C. § 1367.

4. This Court has *in personam* jurisdiction over Invicta pursuant to FLA. STAT. § 48.193, in that: (a) Invicta is operating, conducting, engaging or carrying on a business, in the State of Florida; (b) Invicta has committed tortious acts within the State of Florida; and (c) Invicta is engaged in substantial and not isolated activity within the State of Florida.

5. Venue is proper in this District pursuant to 28 U.S.C. § 1391(b) because Invicta is a resident in this District and because a substantial part of the events giving rise to the claim occurred in this District.

### **THE PARTIES**

6. Plasticase is a corporation organized and existing under the laws of Canada, with its principal place of business located at 1059 Boulevard des Entreprises Ouest, Terrebonne, Quebec, Canada, J6Y 1V2.

7. Upon information and belief, Invicta is a corporation organized and existing under the laws of the State of Florida, with its principal place of business located at 3069 Taft Street, Hollywood, Florida, 33021.

### **PLASTICASE'S BUSINESS**

8. Since 1996, Plasticase has been involved in the business of manufacturing high quality plastic storage cases used in connection with a wide range of products and sold in a variety of markets.

9. Plasticase cases are designed and used store all types of equipment and materials, including, photographic equipment, timepieces, medical equipment, testing equipment, and are even used as fashion accessories.

10. Plasticase products are sold throughout the world, including in the United States. Plasticase products are sold to businesses and directly to the public through "business-to-business" channels and through retail channels respectively.

11. As a result of the originality and high quality of its products, Plasticase has developed a reputation for excellence and innovation which has generated millions of dollars in sales and many loyal customers.

### **PLASTICASE'S PATENTS**

12. On October 21, 2008, U.S. Patent No. D578,759 (the "'759 Patent"), entitled "Case With Side Latches" was issued by the United States Patent and Trademark Office, covering an ornamental design for a storage case. The application from which the '759 Patent issued was filed on May 31, 2007. A true and correct copy of the '759 Patent is attached as Exhibit "A" hereto.

13. On October 28, 2008, U.S. Patent No. D579,202 (the "'202 Patent"), entitled "Case" was issued by the United States Patent and Trademark Office, covering an ornamental design for a storage case. The application from which the '202 Patent issued was filed on May 31, 2007. A true and correct copy of the '202 Patent is attached as Exhibit "B" hereto.

14. Plasticase is the owner by assignment of the '759 and '202 Patents.

15. The '759 and '202 Patents are in full force and effect as of the date of this Complaint and all times relevant to the allegations herein.

16. Subsequent to the filing of the '759 and '202 Patents, Plasticase began manufacturing and selling a line of storage cases embodying the designs covered by the '759 and '202 Patents. This line of storage cases is sold under the NANUK™ trademark and includes model numbers 905 and 915. True and correct copies of pages from Plasticase's product catalog illustrating the NANUK™ 905 and 915 storage cases are attached as Exhibit "C" hereto.

17. Plasticase's NANUK™ 905 case embodies the ornamental design claimed in the '759 Patent and all NANUK™ 905 cases sold by Plasticase since at least as early as June 2009 bear the marking "U.S. Patents D578,759."

18. Plasticase's NANUK™ 915 case embodies the ornamental design claimed in the '202 Patent and all NANUK™ 915 cases sold by Plasticase since at least as early as June 2009 bear the marking "U.S. Patents D579,202."

**INVICTA'S ACTS OF INFRINGEMENT, FALSE DESIGNATION OF ORIGIN, AND UNFAIR COMPETITION**

19. On June 3, 2009, Invicta's C.E.O., Eyal Lalo ("Lalo"), e-mailed Plasticase requesting that Plasticase provide a quote and samples for storage cases in two (2) sizes suitable for storage of 4 and 12 watches respectively. In subsequent discussions with Invicta, Lalo provided further specifications for the requested cases.

20. On June 12, 2009, Plasticase provided Invicta with a price quote for the manufacture of customized NANUK™ model 905 and 915 cases meeting Invicta's requested specifications.

21. On June 15, 16 and 30, 2009, Plasticase mailed sample cases to Invicta meeting the requested specifications. Except for the printing of Invicta's logo on the lid of the sample cases, and custom foam inserts inside the cases, the sample cases were identical to NANUK<sup>TM</sup> model 905 and 915 cases sold commercially by Plasticase.

23. Plasticase received no further communications from Invicta in connection with the price quotation or sample cases and assumed that Invicta had decided not to order its cases.

24. Upon information and belief, at least as early as July 2009, Invicta displayed and offered for sale Plasticase's NANUK<sup>TM</sup> 905 and 915 cases to customers. Invicta then sold to clients throughout the United States who placed orders as a result of such offers for sale, knock-off versions of Plasticase's NANUK<sup>®</sup> model 905 and 915 cases.

25. On or about January 27, 2010, Plasticase received a communication from one of its United States clients expressing congratulations after having seen two of Plasticase's cases being offered for sale by Invicta through the ShopNBC television shopping channel and ShopNBC's website found at <[www.shopnbc.com](http://www.shopnbc.com)>.

26. Upon receipt of this communication, Plasticase verified that Invicta was offering for sale cases identical to Plasticase's NANUK<sup>TM</sup> models 905 and 915 through ShopNBC's television channel and internet website. True and correct copies of pages from ShopNBC's website offering for sale NANUK<sup>TM</sup> models 905 and 915 cases are attached as Exhibit "D" hereto.

27. Plasticase has since also confirmed that Invicta has advertised for sale, in its own catalogs cases identical to Plasticase's NANUK<sup>TM</sup> models 905 and 915. True and correct copies of pages from Invicta's catalog offering for sale cases identical to Plasticase's NANUK<sup>TM</sup> models 905 and 915 are attached as Exhibit "E" hereto.

28. On January 27 and February 1, 2010, Plasticase contacted Lalo to inquire whether an order for NANUK<sup>TM</sup> cases would be forthcoming from Invicta.

29. On February 2, 2010, Lalo e-mailed Plasticase to advise that Invicta would be “passing on the opportunity.”

30. On information and belief, shortly after receiving the sample cases from Plasticase in June 2009, Invicta forwarded the sample cases to a manufacturer in China and requested that knock-off copies of the sample cases be manufactured for Invicta.

31. Invicta has caused the Chinese manufacturer to produce tens of thousands of the knock-off cases.

32. Invicta imported, or caused to be imported on its behalf and for its benefit, tens of thousands of the knock-off cases into the United States.

33. Invicta has offered for sale and sold the knock-off cases throughout the United States, including within this District.

34. On information and belief, Invicta has sold the knock-off cases throughout the United States with actual knowledge that they would be re-sold to consumers in the United States.

35. The knock-off cases are in all respects virtually identical copies of Plasticase’s NANUK<sup>TM</sup> models 905 and 915 cases and of the designs covered by the ‘759 and ‘202 Patents. To wit, attached as Exhibits “F” and “G” hereto are charts comparing the designs shown in the ‘759 and ‘202 Patents with those of Plasticase’s genuine NANUK<sup>TM</sup> models 905 and 915 cases and Invicta’s knock-off cases.

**COUNT I**  
**INFRINGEMENT OF U.S. PATENT NO. D578,759**

36. Plasticase re-alleges and incorporates hereto by reference paragraphs 1-35 of this

Complaint as though fully set forth herein.

37. Invicta has infringed and continues to infringe the '759 Patent. Invicta has imported into the United States, sold and offered for sale cases that are virtually identical to the ornamental design claimed in the '759 Patent, and will continue to do so unless enjoined by this Court.

38. In addition, through the sale of its knock-off products to others for resale, Invicta has induced infringement of the '759 Patent by others and has committed acts of contributory infringement of the '759 Patent.

39. Invicta's infringement of the '759 Patent has been willful and malicious and with actual or constructive knowledge that Plasticase is the owner of a patent claiming the infringed design.

40. Plasticase has sustained damages as a result of the infringing acts of Invicta.

41. Plasticase has suffered and will continue to suffer irreparable harm unless infringement of the '759 Patent is enjoined.

**COUNT II**  
**INFRINGEMENT OF U.S. PATENT NO. D579,202**

42. Plasticase re-alleges and incorporates hereto by reference paragraphs 1-35 of this Complaint as though fully set forth herein.

43. Invicta has infringed and continues to infringe the '202 Patent. Invicta has imported into the United States, sold and offered for sale cases that are virtually identical to the ornamental design claimed in the '202 Patent, and will continue to do so unless enjoined by this Court.

44. In addition, through the sale of its knock-off products to others for resale, Invicta has induced infringement of the '202 Patent by others and has committed acts of contributory

infringement of the '202 Patent.

45. Invicta's infringement of the '202 Patent has been willful and malicious and with actual or constructive knowledge that Plasticase is the owner of a patent claiming the infringed design.

46. Invicta's infringement of the '202 Patent has been willful and malicious and with actual or constructive knowledge that Plasticase is the owner of a patent claiming the infringed design.

47. Plasticase has sustained damages as a result of the infringing acts of Invicta.

48. Plasticase has suffered and will continue to suffer irreparable harm unless infringement of the '202 Patent is enjoined.

**COUNT III**  
**FALSE DESIGNATION OF ORIGIN UNDER 15 U.S.C. 1125(a)**

49. Plasticase re-alleges and incorporates hereto by reference paragraphs 1-35 of this Complaint as though fully set forth herein.

50. Invicta displayed and offered for sale Plasticase's NANUK<sup>TM</sup> model 905 and 915 cases. Invicta then sold to clients throughout the United States who placed orders as a result of such offer for sale, knock-off versions of Plasticase's NANUK<sup>TM</sup> model 905 and 915 cases.

51. Invicta's actions above constitute the misrepresentation of the nature, characteristics and qualities of knock-off cases sold by Invicta in interstate commerce.

52. Invicta's actions above are likely to cause confusion and/or caused actual confusion as to the origin, sponsorship, or approval of knock-off cases sold by Invicta in interstate commerce.

53. Invicta's acts constitute violations of Section 43(a) of the Lanham Act, as amended, 15 U.S.C. § 1125(a).

54. By reason of the acts of Invicta herein alleged, Plasticase has suffered and, unless Invicta is restrained from continuing its wrongful acts, will continue to suffer serious and irreparable harm for which it has no adequate remedy at law.

**COUNT IV**  
**FLORIDA COMMON LAW UNFAIR COMPETITION**

55. Plasticase re-alleges and incorporates hereto by reference paragraphs 1-35 of this Complaint as though fully set forth herein.

56. Invicta displayed and offered for sale Plasticase's NANUK<sup>TM</sup> model 905 and 915 cases. Invicta then sold to clients throughout the State of Florida who placed orders as a result of such offer for sale, knock-off versions of Plasticase's NANUK<sup>TM</sup> model 905 and 915 cases.

57. Invicta's actions above constitute the misrepresentation of the nature, characteristics and qualities of knock-off cases sold by Invicta in Florida.

58. Invicta's actions above are likely to cause confusion and/or caused actual confusion as to the origin, sponsorship, or approval of knock-off cases sold by Invicta in Florida.

59. Invicta's acts constitute unfair competition under the common law of the State of Florida.

60. By reason of the acts of Invicta herein alleged, Plasticase has suffered and, unless Invicta is restrained from continuing its wrongful acts, will continue to suffer serious and irreparable harm for which it has no adequate remedy at law.

**WHEREFORE**, Plaintiff Plasticase prays that the Court:

A. Enter a judgment that Invicta has infringed, induced infringement and contributed to the infringement of U.S. Patent No. D578,759;

B. Enter a judgment that Invicta has infringed, induced infringement and contributed to the infringement of U.S. Patent No. D579,202;

C. Enter a judgment that Invicta has committed acts of false designation of origin and unfair competition under Federal and State law.

D. Order Invicta to pay damages under 35 U.S.C. 285 and 289 to adequately compensate Plasticase for Invicta's patent infringement, including an award of Invicta's profits from its infringement of U.S. Patent Nos. D578,759 and D579,202, together with pre- and post-judgment interest;

E. Order Invicta to pay damages under 15 U.S.C. 1117 to adequately compensate Plasticase for Invicta's acts of false designation of origin and unfair competition

F. Find that Invicta's acts of patent infringement, false designation of origin and unfair competition were willful and malicious and award treble damages to Plasticase under 35 U.S.C. 284 and 15 U.S.C. 1117;

G. Find this to be an exceptional case of patent infringement, false designation of origin, and unfair competition and award reasonable attorneys' fees to Plasticase under 35 U.S.C. 285 and 15 U.S.C. 1117;

H. Award such other and further relief as the Court deems just and equitable

**DEMAND FOR JURY TRIAL**

Plasticase hereby demands a trial by jury of all issues so triable.

Dated: August 9, 2010

Respectfully submitted,

**LOTT & FRIEDLAND, P.A.**

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*Attorneys for Plaintiff,  
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**CERTIFICATE OF SERVICE**

I hereby certify that on August 9, 2010, I electronically filed the foregoing document with the Clerk of the Court using CM/ECF. I also certify that the foregoing document is being served this day on all counsel of record or pro se parties identified on the attached Service List in the manner specified, either via transmission of Notices of Electronic Filing generated by CM/ECF or in some other authorized manner for those counsel or parties who are not authorized to receive electronically Notices of Electronic Filing.

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