

IN THE UNITED STATES DISTRICT COURT
FOR THE SOUTHERN DISTRICT OF INDIANA
INDIANAPOLIS DIVISION

DEXAS INTERNATIONAL, LTD.,	§	
	§	Civil Action No.
Plaintiff,	§	
	§	<u>1:18-cv-1105</u>
v.	§	
	§	JURY DEMANDED
MENARD, INC.,	§	
	§	
Defendant.	§	

**ORIGINAL COMPLAINT WITH REQUEST FOR PERMANENT INJUNCTIVE
RELIEF AND DAMAGES AND JURY DEMAND**

Plaintiff, Dexas International, Ltd., for its complaint against Defendant Menard, Inc., would respectfully show the Court as follows:

I. PARTIES

1. Plaintiff Dexas International, Ltd. (“Dexas”) is a Texas limited partnership with its principal place of business at 585 South Royal Lane, Suite 200, Coppell, TX 75019.

2. Defendant Menard, Inc. is a Wisconsin corporation with its principal place of business at 5101 Menard Drive, Eau Claire, WI 54703.

II. JURISDICTION AND VENUE

3. Count I is an action for patent infringement arising under the Patent Laws of the United States, 35 U.S.C. §§ 101, et seq., with subject matter jurisdiction based on 28 U.S.C. §1338(a). Count II is an action for copyright infringement arising under the Copyright Laws of

the United States, 17 U.S.C. §§ 101, et seq., with subject matter jurisdiction based on 28 U.S.C. §1338(a).

4. The Court has personal jurisdiction over Defendant, and venue is proper in this District, in that Defendant has sufficient contacts in the State of Indiana and this District to satisfy Due Process. In addition, Defendant is a foreign for-profit corporation registered with the Indiana Secretary of State to do business in Indiana. Venue is proper in the Southern District of Indiana under 28 U.S.C. §§1400(a) and (b) with §§1391(b), (c) and (d).

III. COUNT I - PATENT INFRINGEMENT

5. Dexas is the exclusive licensee of United States Design Patent No. D563,739 entitled “Cutting Board With Snap-In Pop Strainer,” (“the ‘739 Patent”) duly issued on March 11, 2008 by the United States Patent and Trademark Office, a copy of which is attached hereto as Pleading Exhibit A. Dexas’s rights under the exclusive license include, without limitation, the right to sue and receive damages for past, present, and future patent infringement.

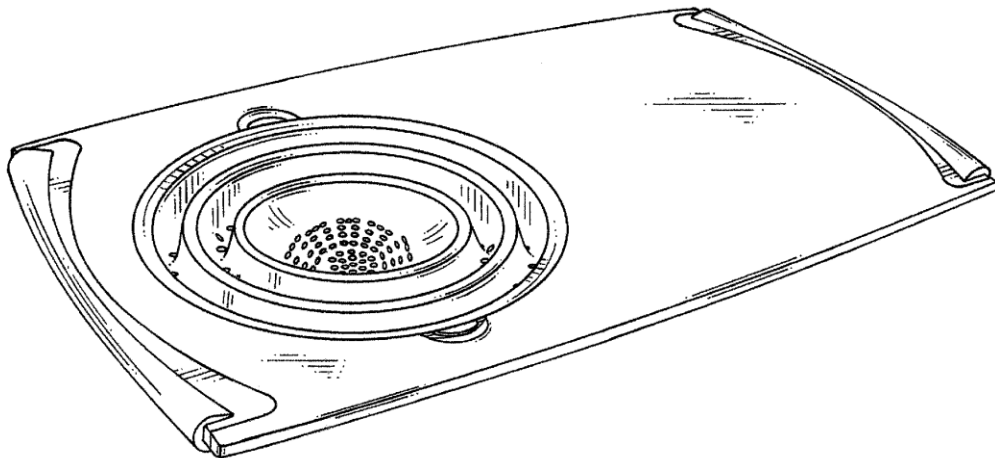


FIG. 1 of United States Design Patent No. D563,739

6. Defendant is infringing the ‘739 Patent by making, selling, offering for sale,

importing, and/or using a product embodying the Plaintiff's patented invention.



Defendant's Infringing Product

7. Defendant's infringing product has been sold and is on sale at Menards retail stores in this Judicial District and Division and elsewhere, labeled under the brand "household trends" [capitalization, sic] and the product name "Collapsible Colander Cutting Board Set," bearing UPC code 789185550936. By way of further reference, the SKU number 4736763 appears on a Menards cash register receipt for the purchase of such product. Defendant's insert label and said receipt are shown in Pleading Exhibit B. Defendant will continue to infringe the '739 Patent unless enjoined by the Court.

8. Defendant's infringement has caused Plaintiff to suffer damages and irreparable harm. Defendant will continue said acts of infringement unless permanently enjoined by this Court. On information and belief, said infringement was willful, making this an exceptional case.

9. As an additional remedy, Plaintiff is entitled to an award of Defendant's total profits earned from patent infringement.

10. Dexas has placed the required statutory marking and notice on all products made and sold by it under the '739 Patent in the relevant time period.

IV. COUNT II - COPYRIGHT INFRINGEMENT

11. In 2013, a Dexas employee created within the scope of his employment an original visual art work entitled "Dexas Cutting Board Photo." The work is a photograph of the cutting board of the '739 Patent in typical use. In 2014, the photograph was published in the product insert label used by Dexas with its version of the cutting board of the '739 Patent. A copy of the photograph is attached hereto as Pleading Exhibit C.

12. On April 4, 2018, Dexas applied for registration of the copyright to the photograph, by delivering electronically the deposit, application and fee required for registration to the United States Copyright Office. Dexas received Case Number 1-6443832071 for the application from the United States Copyright Office.

13. The "Dexas Cutting Board Photo" contains copyrightable subject matter under the laws of the United States, and Dexas owns all rights in the work and the copyright therein as a work for hire.

14. Dexas has complied with the laws of the United States as they relate to copyright, 17 U.S.C. §§ 101, et seq., and has secured the exclusive rights and privileges in and to the copyright of the photograph.

15. All publication, distribution and sale of the copyrighted work by or under the authorization of Dexas has been in conformity with the Copyright Laws of the United States, which no longer require a copyright notice to avoid loss of copyright.

16. In 2017, and possibly earlier, Defendant began selling the “household trends” “Collapsible Colander Cutting Board Set” referred to above with the label insert of Exhibit B, which includes an unauthorized copy of, or derivative work based upon, the copyrighted Texas Cutting Board Photo. On information and belief, the “household trends” “Collapsible Colander Cutting Board Set” with the infringing label insert is manufactured or imported by Defendant and sold retail to consumers. Thus, Defendant has manufactured, imported, published, sold and/or distributed the unauthorized copies of, or derivative works based upon, the Texas Cutting Board Photo, causing those copies or derivative works to be sold to consumers in this state and elsewhere.

17. The copyrighted and infringing photos are shown top and bottom for comparison on the following page.

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Dexas's Copyrighted Photo



Defendant's Infringing Label Insert (trimmed for emphasis)

18. Defendant's copyright infringement has caused Dexas damages and irreparable harm. Defendant will continue its infringement unless it is permanently enjoined.

PRAYER FOR RELIEF

WHEREFORE, PREMISES CONSIDERED, Plaintiff prays for judgment as follows:

1. That Defendant, its agents, servants and employees and all those in privity, concert or participation with any of them, be enjoined from making, using and selling any product in violation of Plaintiff's patent on the "Cutting Board With Snap-In Pop Strainer" design;

2. That Defendant, its agents, servants and employees and all those in privity, concert or participation with any of them, be enjoined from manufacturing, copying, duplicating, purchasing, making, using, selling, trading, renting, exchanging, lending, distributing, transporting, or dealing in any other way with any product, in violation of Dexas's copyright in the Dexas Cutting Board Photo work;

3. That Defendant be required to account for and pay over to Dexas all profits which it has derived from the infringement of Dexas's patent and copyright, all damages Dexas has suffered within the provisions of the Patent and Copyright Laws, with said damages under the patent claim trebled;

4. That Defendant be ordered to deliver up for destruction all products, labels, signs, prints, packages, dies, wrappers, receptacles and advertisements in its possession or under its control, including or referring to Dexas's patented design or Dexas's copyright in the "Dexas Cutting Board Photo" work, or both, or any simulation, reproduction, counterfeit, copy or colorable imitation thereof, and all plates, molds, matrices and other means of making the same;

5. That Defendant be required to pay Dexas its costs incurred herein, as well as reasonable attorneys' fees, as provided by the Patent and Copyright Laws;

6. That Defendant be required to pay Dexas pre-judgment interest on the amount awarded and post-judgment interest until paid, all at the lawful rate; and

7. That Dexas have such other and further relief as to this Court seems just and proper.

JURY DEMAND: Plaintiff demands a trial by jury on all issues triable to a jury.

DATED: April 11, 2018.

Respectfully submitted,

/s/ Deborah Pollack-Milgate
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