

**IN THE UNITED STATES DISTRICT COURT  
FOR THE DISTRICT OF CONNECTICUT**

MAYBORN USA INC.

Plaintiff,

v.

SORENSEN RESEARCH AND  
DEVELOPMENT TRUST

Defendant.

CIVIL ACTION NO.:

Jury Trial Demanded

**COMPLAINT FOR DECLARATORY RELIEF**

Plaintiff MAYBORN USA INC. (hereinafter referred to as “Mayborn” or “Plaintiff”), for its Complaint against Defendant SORENSEN RESEARCH & DEVELOPMENT TRUST (hereinafter referred to as “Sorensen” or “Defendant”), alleges as follows:

1. This is an action for Declaratory Judgment and other relief brought under the Federal Declaratory Judgment Act, 28 U.S.C. §§ 2201-02.
2. Plaintiff Mayborn is a corporation organized and existing under the laws of the State of New York, having a principal place of business at 175 Post Road West, Westport, Connecticut 06880-4643, and is doing business in this State and District.
3. Upon information and belief, Defendant Sorensen is a trust organized according to California law, having a principal place of business at 7040 Avenida Encinas, Suite 104-277, Carlsbad, California 92011, and may be served with a summons and complaint at that address. Upon information and belief, Defendant Sorensen purports to be the owner of U.S. Patent No. 6,960,316 (hereinafter referred to as “the ’316 patent”), and is a non-practicing entity (i.e., it does not practice the alleged invention of the ’316 patent).

4. This Court has jurisdiction over the subject matter of this action on the following grounds:

- (a) 28 U.S.C. §§ 1331, this being a civil action arising under the laws of the United States;
- (b) 28 U.S.C. § 1337(a), this being a civil action arising under an Act of Congress regulating commerce and protecting trade and commerce; and
- (c) 28 U.S.C. § 1338(a), this being a civil action arising under an Act of Congress relating to alleged patent rights.

5. This Court may declare the rights and other legal relations of the parties in this case under 28 U.S.C. § 2201, and Rule 57, Fed.R.Civ.P., because an actual and justiciable controversy exists concerning the rights of, and legal relations between, Plaintiff Mayborn and Defendant Sorensen.

6. This Court has personal jurisdiction over Defendant Sorensen consistent with the principles underlying the U.S. Constitution and Conn. Gen. Stat. § 52-59b because, among other things, Sorensen sent demand letters to Mayborn which is located in this State and District creating in Plaintiff a reasonable apprehension of suit by Sorensen and because any injury caused to Plaintiff occurred in the State of Connecticut and this District where Plaintiff Mayborn's U.S. operations are headquartered.

7. Venue is proper in this Court under the provisions of 28 U.S.C. § 1391 and/or § 1400 because, among other things, this is an action arising out of allegations of patent infringement and because Plaintiff is in this District and a substantial part of the events giving rise to Plaintiff's claims occurred in this District, and upon information and belief, Defendant is subject to personal jurisdiction in this District.

8. On or about February 16, 2011, Defendant Sorensen sent a letter to Ms. Brenda Liistro at Plaintiff Mayborn USA's U.S. headquarters in Westport, Connecticut, alleging that Defendant Sorensen is the owner of the '316 patent entitled "Injection-Molded Plastic Container or Closure with Turned-Under Rim and Method of Injection Molding Same," which was issued on November 1, 2005. A copy of Defendant's letter of February 16, 2011, is attached hereto as Exhibit 1. (A copy of the '316 patent is attached hereto as Exhibit 2).

9. The February 16, 2011, letter alleges infringement of Sorensen's alleged patent rights by virtue of Mayborn's marketing of container lids referred to as the "TOMMEE TIPPEE® Container Lids." Among other things, Sorensen's letter states that Mayborn's TOMMEE TIPPEE® Container Lids constitute "at least one line of MAYBORN products that [Sorensen's] inspection shows to infringe the '316 patent" and further asserts that "[t]his letter constitutes a notice of patent infringement in violation of 35 U.S.C. §271."

10. The February 16, 2011, letter further states that "[s]hould MAYBORN fail to diligently investigate this matter upon receipt of this notice, it will be considered a breach of MAYBORN'S affirmative duty to investigate allegations of patent infringement."

11. The February 16, 2011, letter further states that "licensing the '316 patented technology will allow it to continue to enjoy all the benefits and competitive advantages offered by this useful patent" and goes on to list "scores of businesses" that Sorensen alleges to have entered patent licenses with Sorensen.

12. On or about March 16, 2011, Plaintiff communicated receipt of Defendant's February 16<sup>th</sup> demand letter and indicated that an investigation with respect to the '316 patent and the accused product was ongoing.

13. On or about March 18, 2011, Defendant Sorensen sent another letter alleging infringement of Sorensen's alleged patent rights by Mayborn's TOMMEE TIPPEE® Container Lids to Mr. Steve Parkin of Mayborn's parent, Mayborn Group Limited in Cramlington Northumberland, United Kingdom.

14. On or about May 9, 2011, Mayborn's patent attorneys sent e-mail correspondence to Mr. Chris Kuczynski of Sorensen to inform Sorensen that a substantive response to Sorensen's letters dated February 16, 2011, and March 18, 2011, would be provided by the end of the week of May 20, 2011.

15. On or about May 9, 2011, in response to the communication noted in paragraph 14 above, Mr. Kuczynski responded by e-mail and attached "SRD's [Sorensen's] injection molding portfolio agreement," noting that "SRD [Sorensen] is prepared to offer this portfolio of patents for the same \$300,000 offer."

16. On or about May 20, 2011, Mayborn's representatives sent Sorensen a letter detailing the process used to make the TOMMEE TIPPEE® Container Lids and outlining why this process does not infringe any valid and enforceable claims of the '316 patent.

17. On or about July 11, 2011, Defendant Sorensen sent a letter to Mayborn's representatives in response to Mayborn's May 20<sup>th</sup> letter alleging that "the letter of May 20, 2011 is based on an unsubstantiated assertion of non-infringement and therefore this matter is not closed." Sorensen's July 11<sup>th</sup> letter further stated that "Sorensen R&D believes that in Mayborn's process it is substantially likely that the Outer Surface Portion is removed from the core part contemporaneously with the interior surface as required by independent Claims 1 and 6 of the '316 patent" and asserts that another of Mayborn's products, "the TOMMEE TIPPEE® Weaning Bowl Lids are substantially likely under 35 U.S.C. § 295 to have been fabricated

utilizing a process that infringes the '316 patent.” Sorensen’s July 11<sup>th</sup> letter further stated that “[i]f Mayborn cannot provide Sorensen R&D with such evidence [of non-infringement], we will presume that its assertion of non-infringement is disingenuous and no such evidence exists.”

18. Sorensen’s letter dated July 11, 2011, further asserted that “Mayborn’s refusal to resolve this matter by **August 12, 2011**, will trigger commencement of suit against Mayborn.” (Emphasis in original). Sorensen’s July 11<sup>th</sup> letter goes on to note that it has “extensively litigated several of its patents with companies such as DaimlerChrysler, Black & Decker, and BMW” and “suggest[s] that Mayborn does not make the same mistakes that those who have elected litigation have made.” Sorensen’s July 11<sup>th</sup> letter closes by offering to provide Mayborn a “discounted license fee of \$240,000 to allow Mayborn to import, sell, offer for sale, or use the described technology or product in the United States.”

19. On or about August 11, 2011, Mayborn provided Sorensen with confidential information under a confidentiality and non-disclosure agreement dated July 29, 2011, regarding the process used to make the accused TOMMEE TIPPEE® Container Lids and Weaning Bowl Lids (“the Accused Products”). Such information included a Declaration signed under oath by Mr. Michael Brabbs, Mayborn Group’s Technical Development Manager since 2004 and an engineer in the field of injection-molded processes for over thirty-four (34) years. The Declaration details the process used to manufacture the Accused Products and illustrates how the process does not practice the claimed method of the '316 patent. Also included with Mayborn’s August 11<sup>th</sup> letter was a copy of an engineering drawing of the tool used to manufacture the Accused Products. At Sorensen’s request, Mayborn an provided additional engineering drawing to Sorensen on September 21, 2011, showing greater detail of the tool structure.

20. On or about January 4, 2012, Defendant Sorensen sent a letter to Mayborn's representatives alleging that "[a]fter careful analysis of the drawings and for the reasons provided below, the process described by Mayborn does infringe at least claim 1 of the '316 patent." Sorensen's January 4<sup>th</sup> letter reasserted that Sorensen "does not desire to incur the expense of additional legal action" and renewed the offer "to provide Mayborn a discounted license fee of \$240,000." Sorensen's January 4<sup>th</sup> letter further noted that the offer "is revoked on **February 3, 2012** and a substantially higher licensing fee will be demanded from Mayborn as an infringer." (Emphasis in original). Sorensen's January 4<sup>th</sup> letter closed by requesting that Mayborn provide "any substantial, factual, and documented reason why Sorensen R&D should not proceed to make [Mayborn] the subject of Sorensen R&D's next lawsuit for infringement of the '316 patent."

21. On or about January 25, 2012, Mayborn's representatives sent Sorensen a letter declining Sorensen's offer for a license under the '316 patent and providing revenue information with respect to the Accused Products in the U.S. from February 2011 through December 2011.

22. On or about January 26, 2012, Defendant Sorensen sent Mayborn a letter reasserting that "the Accused Products meet the 'contemporaneously' limitation of at least independent claim 1" of the '316 patent. Sorensen's January 26<sup>th</sup> letter further restated Sorensen's offer to provide Mayborn with a license under the '316 patent "for a standard royalty rate of \$240,000" and noted that the "standard pre-litigation royalty rate demanded by Sorensen R&D will not be offered again should litigation be necessary to resolve this dispute." Sorensen's January 26<sup>th</sup> letter again closed by requesting that Mayborn provide "any substantial, factual, and documented reason why Sorensen R&D should not proceed to make [Mayborn] the subject of

Sorensen R&D's next lawsuit for infringement of the '316 patent" and demanded that such information be provided "no later than **February 24, 2012.**" (Emphasis in original).

23. On or about February 13, 2012, Mayborn's representatives sent Sorensen a letter including still frames from video footage taken of a tool demonstrating the process of manufacturing the Accused Products. Mayborn's February 13<sup>th</sup> letter described the process with reference to the still frames and explained how the process does not infringe the claims of the '316 patent. In particular, Mayborn explained that as the mold opens, the product remains fully engaged with the stripper plate of the mold assembly, while the core part of the mold assembly separates from the product, and that the product separates from the stripper plate only after the core part was separated from the product. Accordingly, Mayborn explained to Sorensen that it is not possible for the product to be ejected from both the stripper plate and the core part "contemporaneously" as is required by the claims of the '316 patent. Mayborn further requested that Sorensen provide confirmation that the assertions against the Mayborn products have been dropped.

24. On or about April 3, 2012, Defendant Sorensen sent another letter to Mayborn's representatives alleging that the video footage of the tool provided in Mayborn's February 13<sup>th</sup> letter was "stage[d]" and not an accurate representation of the process used to make the Accused Products. Sorensen's April 3<sup>rd</sup> letter restated Sorensen's offer to license the '316 patent and again closed by urging Mayborn to provide "any substantial, factual, and documented reason why Sorensen R&D should not proceed to make [Mayborn] the subject of Sorensen R&D's next lawsuit for infringement of the '316 patent" and demanded that such information be provided "no later than **April 30, 2012.**" (Emphasis in original).

25. On April 30, 2012, Mayborn's representatives sent Sorensen a letter including further explanation in detail why the video footage of Mayborn's process, from which the stills provided to Sorensen were taken, was not "stage[d]" as alleged by Sorensen, and offering to provide Sorensen with the actual video footage to prove that the footage was not "stage[d]." Mayborn also stated that it would consider letting a Sorensen representative attend and view manufacturing of the Accused Products, and further stated that Mayborn has fully and accurately responded to all of Sorensen's questions and purported concerns regarding the '316 patent, that 35 U.S.C. § 295 is inapplicable and that Mayborn does not bear any burden to show that it does not infringe the '316 patent. Mayborn asked that Sorensen confirm its agreement with the foregoing no later than May 15, 2012.

26. On or about May 1, 2012, Sorensen sent another letter to Mayborn's representatives alleging that it is not relying on statements that Mayborn "faked" the video footage of its process, but that nonetheless Sorensen asserts that the video footage has no evidentiary value. Sorensen again demanded that Mayborn pay a license fee of \$240,000, and stated that the offer would be "revoked on **May 25, 2012.**" (Emphasis in original).

27. Mayborn does not infringe, and has not infringed, any valid and enforceable patent rights of Sorensen, including any rights in the '316 patent. In particular, the manufacturing process used to make the Accused Products does not practice "contemporaneously removing the inner surface and the outer surface of the lower portion of the given segment at the given level from one of the separated mold parts," as required by all of the claims of the '316 patent.

28. In the manufacturing process used to make the Accused Products, the undercut of the lid of the Accused Products is molded between a cavity part of a mold on one side and a core



part of the mold and stripper plate on the other side. Opposing surfaces of the undercut contact the core part and the stripper ring, respectively. Once the lid has been formed, the mold opens slightly, and the lid is retained on the core part. The core part remains attached to an interior surface of the lid and undercut, and the stripper plate remains attached to an exterior surface. The stripper plate is then moved relative to the core part, causing the interior surface of the undercut to be pulled off the core part.

29. In the process described in paragraph 28 above, the interior surface is removed from the core part while the portion of the exterior surface remains in contact with the stripper plate as a result of relative movement between the stripper plate and the core part.

30. In the manufacturing process used to make the Accused Products, after the interior of the undercut has been fully pulled off the core part, the lid falls out of the tool, thereby removing the exterior surface from contact with the stripper plate. Accordingly, this process does not practice “contemporaneously removing the inner surface and the outer surface of the lower portion of the given segment at the given level from one of the separated mold parts,” as required by all of the claims of the ’316 patent.

31. On information and belief, Defendant Sorensen is not aware of any information, other than pure speculation, that refutes the description of the process used to manufacture the Accused Products provided in paragraphs 27 through 30 above.

32. On information and belief, Defendant Sorensen is a non-practicing entity that derives its revenue from suing manufacturers of products and/or obtaining licensing fees from such manufacturers under the threat of suit.

33. There is an actual, substantial, and justiciable controversy between Plaintiff Mayborn and Defendant Sorensen of sufficient immediacy and reality to warrant the rendering of

a declaratory judgment by this Court. Defendant Sorensen has made numerous clear threats against Plaintiff sufficient to create a reasonable apprehension by Mayborn of suit by Sorensen concerning its alleged patent rights. Plaintiff is entitled to a judgment declaring its rights as requested herein.

### **COUNT I**

#### **DECLARATORY JUDGMENT REGARDING ALLEGATIONS OF PATENT INFRINGEMENT**

34. Plaintiff incorporates by reference paragraphs 1 through 33 above as if set forth fully herein.

35. There is an actual, substantial, and justiciable controversy between Plaintiff Mayborn and Defendant Sorensen concerning Sorensen's allegations that Plaintiff has infringed any valid claims of the '316 patent.

36. These allegations place a cloud over Plaintiff's business activities and will cause uncertainty among customers, prospective customers, suppliers, and others in the marketplace, likely leading Plaintiff and/or its related entities to lose sales and business opportunities.

37. The TOMMEE TIPPEE® Container Lids and Weaning Bowl Lids are made by a process that does not infringe any valid and enforceable claims of the '316 patent, as alleged by Sorensen.

38. Plaintiff is entitled to a judgment declaring that any and all making, using, selling, offering for sale, or importing into the United States of the Accused Products by Plaintiff is and has been lawful, and otherwise declaring that Plaintiff has not infringed any valid rights, if any exist, that Defendant Sorensen may hold in the '316 patent.

39. As a direct and proximate result of Sorensen's allegations of patent infringement against products made, used, sold, offered for sale, and/or imported into the United States by or

for Plaintiff, Plaintiff is suffering irreparable injury to its reputation and goodwill in an amount that cannot presently be ascertained and cannot be compensated adequately by monetary relief alone.

WHEREFORE, Plaintiff Mayborn USA prays that this Court enter judgment:

(a) Declaring that Plaintiff, and including specifically the TOMMEE TIPPEE®

Container Lids and Weaning Bowl Lids made, used, imported, sold and/or offered for sale by or for Plaintiff or its related entities, has not infringed and is not infringing any valid purported patent rights of Sorensen in the '316 patent, and otherwise has not violated any provision of the patent laws of the United States;

(b) Permanently enjoining Sorensen, its successors, assigns, and others from asserting the '316 patent against Plaintiff or its related entities with respect to the TOMMEE TIPPEE® Container Lids and Weaning Bowl Lids and any other product currently or previously made, used, imported, sold and/or offered for sale by Plaintiff or its related entities;

(c) Finding in favor of Plaintiff and declaring this case to be exceptional pursuant to 35 U.S.C. § 285;

(d) Awarding Plaintiff its attorneys' fees and other costs and expenses;

(e) Awarding interest to Plaintiff to the extent permitted by law; and

(f) Awarding to Plaintiff any such further relief as the Court deems just and proper.

**PLAINTIFF HEREBY DEMANDS A TRIAL BY JURY ON ALL ISSUES SO TRIABLE.**

This 25<sup>th</sup> day of May, 2012.

THE PLAINTIFF  
MAYBORN USA, INC.

By: /s/ James E. Nealon  
James E. Nealon (ct 08161)  
KELLEY DRYE & WARREN LLP  
Its Attorneys  
400 Atlantic Street  
Stamford, Connecticut 06901  
(203) 324-1400  
(203) 327-2669 (facsimile)  
[jnealon@kelleydrye.com](mailto:jnealon@kelleydrye.com)

Of Counsel:

Bruce J. Rose, N.C. Bar No. 20105  
ALSTON & BIRD LLP  
101 South Tryon Street, Suite 4000  
Charlotte, North Carolina 28280-4000  
(704) 444-1000 (telephone)  
(704) 444-1111 (facsimile)  
[bruce.rose@alston.com](mailto:bruce.rose@alston.com)