

J137-5389

UNITED STATES DISTRICT COURT  
SOUTHERN DISTRICT OF NEW YORK

|                         |   |                                |
|-------------------------|---|--------------------------------|
| -----X                  | : | Civil Action No.               |
| E. Mishan & Sons, Inc., | : |                                |
|                         | : |                                |
| <i>Plaintiff,</i>       | : |                                |
| v.                      | : | <b>COMPLAINT FOR</b>           |
|                         | : | <b>DECLARATORY JUDGMENT OF</b> |
| Caraway Home, Inc.      | : | <b>PATENT NON-INFRINGEMENT</b> |
|                         | : |                                |
| <i>Defendant.</i>       | : |                                |
| -----X                  | : |                                |

E. Mishan & Sons, Inc. ("Emson"), by its attorneys, for its Complaint against Caraway Home, Inc. ("Caraway") alleges as follows:

**Nature of the Action**

1. This is an action for a Declaratory Judgment of non-infringement of U.S. Design Patent No. D921,421 (the "D'421 Patent").

**The Parties**

2. Emson is a New York corporation with a place of business at 230 Fifth Avenue, New York, New York.

3. Caraway is a Delaware corporation with a place of business at 147 W. 26th Street, Floor 4, New York, New York 10001.

**Jurisdiction and Venue**

4. The Court has federal question jurisdiction because this action arises under the Patent Laws of the United States, 35 U.S.C. §§ 1 et seq, and under the Federal Declaratory Judgment Act, 28 U.S.C. §§ 2201 and 2202. The Court has subject matter jurisdiction over this action pursuant to 28 U.S.C. §§ 1331, 1338(a), 2201 and 2202.

5. The Court also has personal jurisdiction over Caraway because Caraway resides in this district, and on information and belief, transacts business in New York, has committed tortious acts within this district and without this district having injurious consequences within this district, and Caraway is otherwise within the jurisdiction of the Court.

6. Venue is proper in this district pursuant to 28 U.S.C. §§ 1391 and/or 1400(b).

### **Factual Background**

#### **A. Emson**

7. For over seventy years, Emson has marketed, sold and advertised consumer products in this Judicial District and elsewhere through multiple trade channels including, e.g., direct response advertising, Internet websites, TV shopping channels, and via online retailers.

8. Emson currently markets and sells an extensive range of cookware (pots and pans, bakeware, grills and fryers, and kitchenware), kitchen electrics, household goods, flashlights, lights, and garden hoses, among other consumer products.

9. Since September 2015, Emson has been marketing cookware under the trademark “Gotham Steel.”

10. Emson sells Gotham Steel cookware sets on Amazon.com.

11. Selling on Amazon is highly advantageous as Amazon provides extensive online marketplace exposure.

12. Amazon assigns each product listing on its website a unique Amazon Standard Identification Number (“ASIN”).

13. Emson's "Gotham Steel 11 Pc Ceramic Pots and Pans Set" (the "Accused Product") was listed on Amazon on or about May 25, 2024 under ASIN B0CYQZLYMZ.

14. The Accused Product includes the following items:

- 9.5-inch fry pan
- 9.5-inch fry pan lid
- 11-inch fry pan and lid
- 2qt saucepan and lid
- 3qt saucepan and lid
- 6qt stock pot and lid
- stainless steel steamer

15. Except for their size, the design of each of the lids is the same.

B. Caraway's Acts

16. On July 29, 2024, Amazon notified Emson that Amazon had deactivated the listing for ASIN B0CYQZLYMZ (the "Deactivated ASIN"). A copy of the Amazon notice is attached hereto as **Exhibit 1**.

17. The listing was deactivated because Amazon received a report from a rights owner alleging that the listing may infringe on the right's owner's design patent. Amazon's notice identified the rights owner details as: Andrew Bochner, [andrew@bochner.law](mailto:andrew@bochner.law).

18. Upon information and belief, Andrew Bochner is Caraway's counsel, and filed the Amazon Complaint on Caraway's behalf.

19. Amazon's deactivation notice identifies the following communication from Andrew Bochner ([andrew@bochner.law](mailto:andrew@bochner.law)):

"At least the frying pan lid in the accused listing is almost identical to the lid covered by the asserted patent such that an ordinary observer would confuse the two designs to be the same. Specifically, the frying pan lid has an almost flat surface and includes one small aperture on

the lid's surface. These substantial similarities make the frying pan lid indistinguishable from the lid covered by the asserted patent.”

20. Emson did not have the opportunity to present any non-infringement defenses to Amazon before Amazon delisted the Accused Product.

21. As a result of the deactivation, Amazon returned all Accused Products in its inventory to Emson and imposed certain fees on Emson.

22. Emson's representative contacted Amazon and determined that the design patent was the D'421 patent.

23. The D'421 patent, entitled “Cookware Lid,” was issued on June 8, 2021. It claims: “The ornamental design for cookware lid, as shown and described.” A true and correct copy of the D'421 patent is attached hereto as **Exhibit 2**.

24. Caraway is listed as the assignee on the face of the D'421 patent.

25. On information and belief, Caraway is the owner of the D'421 Patent.

26. In an effort to reactivate the Amazon listing, on August 6, 2024, Emson submitted an appeal of Amazon's deactivation including a letter of non-infringement prepared by its legal counsel. A true and correct copy of the letter is attached hereto as **Exhibit 3**.

27. On August 14, 2024, Amazon rejected Emson's appeal. A true and correct copy of Amazon's notice is attached hereto as **Exhibit 4**.

28. As indicated in Amazon's August 14<sup>th</sup> response, in order to have the deactivated ASIN reinstated, Amazon required Emson to submit one of the following:

(a) “a court order stating you are allowed to sell the products and hence are not violating Amazon policy for each of the listings mentioned in the deactivation notification.”

(b) “A letter of non-infringement from legal counsel.”

(c) “Work directly with the rights owner who reported the violation to submit a retraction.”

However, Emson had submitted a non-infringement letter from counsel on August 6<sup>th</sup>. As noted below, Emson’s further attempts to obtain a retraction from Caraway’s counsel were also unsuccessful. An order of this Court is needed to reinstate the Deactivated ASIN.

29. On August 14, 2024, Emson’s counsel sent a letter to Mr. Bochner and the CEO of Caraway requesting that Caraway immediately contact Amazon and withdraw the Amazon Complaint. The letter provided a detailed explanation of the differences between the lids of the Accused Product and the D’421 Patent. The letter requested a reply no later than August 16, 2024. A true and correct copy of the August 14, 2024 letter is attached hereto as **Exhibit 5**.

30. Emson’s counsel and Mr. Bochner spoke by phone August 24, 2024 but did not resolve the matter. Caraway did not retract its Amazon Complaint.

31. The Amazon listing for the Accused Product, ASIN B0CYQZLYMZ, continues to be deactivated and, as a consequence, Emson has not been able to sell the Accused Product on Amazon since July 29, 2024.

32. As a direct result of Caraway’s objectively baseless infringement report, Emson’s sales of the Accused Product on Amazon dropped to zero.

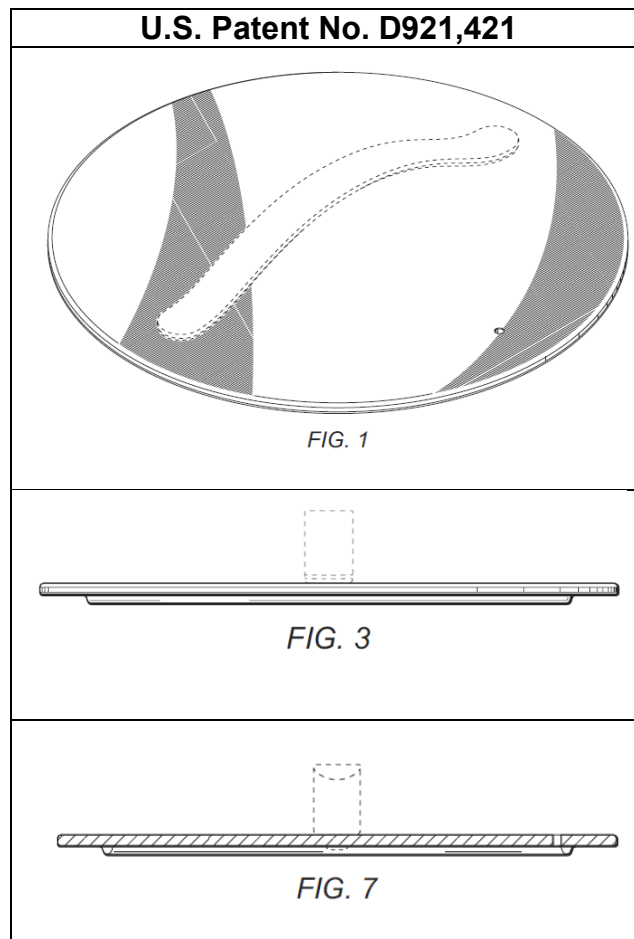
33. Caraway is a seller of cookware, including cookware sets, and advertises, offers and sells cookware through Amazon.

34. Upon information and belief, Caraway and Emson are competitors in the marketing and sale of cookware products by virtue of their concurrent sales of cookware on Amazon.

C. Comparison of the Lid Designs of the D'421 Patent and Accused Product

35. The D'421 Patent has a single claim: "The ornamental design for cookware lid, as shown and described". (See Exhibit 2).

36. As shown in the figures of the D'421 Patent, the claimed cookware lid is a circular disc-shaped lid with a totally flat top surface.

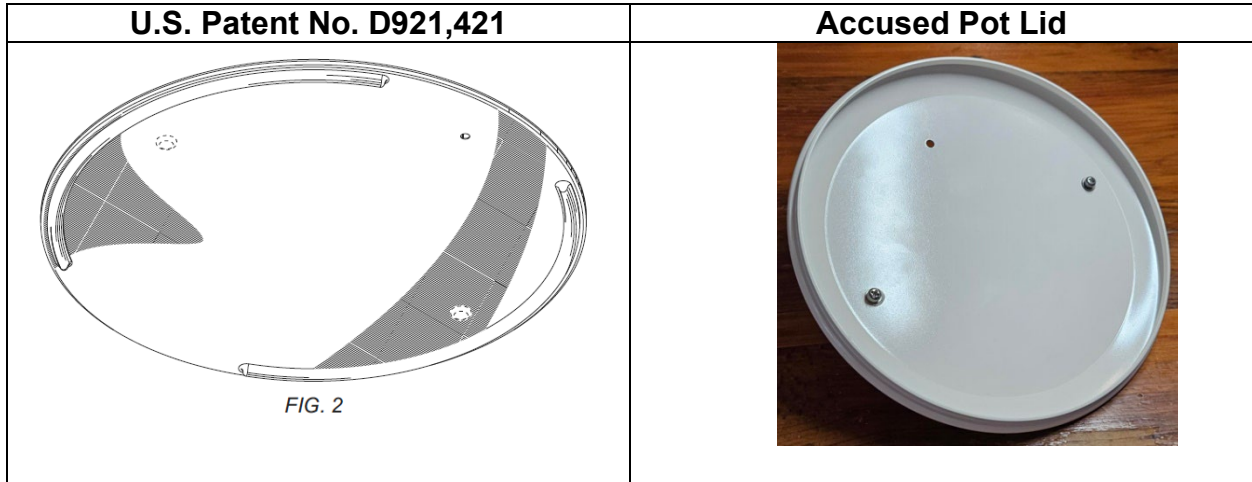


37. The lids in the cookware set of the Accused Product have a top surface that is beveled (sloping) near the circumferential perimeter and a convex center.

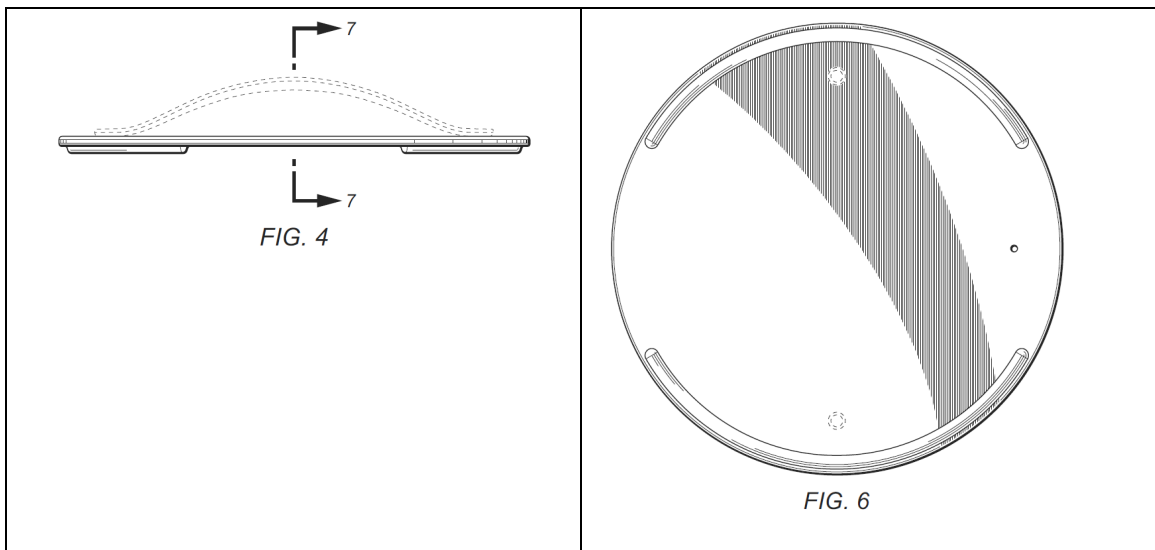


38. As illustrated in Figure 2 of the D'421 patent, the bottom side of the claimed lid includes two separate semi-circular flanges.

39. The bottom side of the lid in the cookware set of the Accused Product does not have two separate flanges, but has a flange that comprises a single, continuous circular wall.



40. As shown in Figs. 2, 3 and 7 of the D'421 Patent above, and Figs. 4 and 6 below, the bottom surface of the lid claimed in the D'421 patent, aside from the two flanges, is also flat.





41. As seen in the above photo of the Accused Product, the lid's bottom surface, aside from the 360° circular flange, is also beveled and concave (i.e., not flat).

42. A visual comparison of the patented design and Accused Product reveals that they are plainly dissimilar.

43. Due to the foregoing differences and other differences, the Accused Product does not infringe the D'421 Patent.

44. Despite unequivocal differences between the designs of the lids of the Accused Product and the D'421 Patent, Caraway has asserted that the Accused Product infringes the D'421 Patent.

45. Emson has given Caraway notice of the substantial differences in the designs.

46. Nevertheless, Caraway has not withdrawn the allegation of infringement which it filed with Amazon.

47. Caraway knows that the Accused Product does not and cannot infringe the D'421 Patent.

### **Count I**

#### **Declaratory Judgment Non-Infringement of U.S. Patent No. D921,421**

48. The allegations of each of the foregoing paragraphs are incorporated by reference as if fully set forth herein.

49. Caraway has asserted in its Amazon Complaint that the lids of the cookware set comprising the Accused Product infringe the D'421 Patent, which Emson denies.

50. The Accused Product does not infringe the D'421 Patent.

51. As a result of Caraway's actions and statements to Amazon, there is an actual controversy between Emson and Caraway as to whether the lids of the Accused Product infringe the D'421 Patent.

52. Emson seeks a declaratory judgment that making, using, offering to sell, selling, and importing the Accused Product does not infringe the D'421 Patent.

53. Caraway's patent infringement allegations regarding the D'421 Patent have caused and, unless restrained and enjoined, will continue to cause irreparable harm to Emson that cannot be adequately quantified or compensated by monetary damages alone and for which there is no adequate remedy at law.

54. Caraway's conduct as alleged herein constitutes an exceptional case under 35 U.S.C. § 285, entitling Emson to the attorneys' fees and costs incurred in this action to vindicate its legal rights and to restore its ability to compete fairly.

### **REQUEST FOR RELIEF**

WHEREFORE, Emson prays for judgment in its favor against Caraway and its affiliates, partners, officers, directors, agents, representatives, servants, employees, attorneys and all persons, firms or corporations in active concert, privity, or participation with any of them for the following relief:

- A. A judgment that the Accused Product does not infringe the D'421 Patent.
- B. A preliminary and permanent injunction enjoining Caraway, its affiliates, partners, officers, directors, agents, servants, employees, attorneys, representatives, successors, assigns, and all persons, firms, or corporations in active concert, privity, or participation with any of them, from:
  - a. asserting the D'421 Patent against the Accused Product;

b. otherwise interfering with sale of the Accused Product.

C. An order directing Caraway, and its affiliates, partners, officers, directors, agents, servants, employees, attorneys, representatives, successors, assigns, and all persons, firms, or corporations in active concert, privity, or participation with any of them, to immediately withdraw any complaint filed against the Accused Product with any ecommerce site, including Amazon.com.

D. That the Court declare this case an "exceptional case" under 35 U.S.C. § 285 and award Emson its reasonable attorney's fees together with its costs.

E. Such other and further relief as this Court may deem just and proper.

November 21, 2024

Respectfully submitted,

*s/ John Zaccaria*

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