

UNITED STATES DISTRICT COURT
SOUTHERN DISTRICT OF FLORIDA

CASE NO.:

SHOES FOR CREWS, LLC,
a Florida limited liability company,

Plaintiff,

v.

ECLIPSE IP, LLC,
a Florida limited liability company,

Defendant.

COMPLAINT FOR DECLARATORY JUDGMENT

The Plaintiff, SHOES FOR CREWS, LLC, sues the Defendant, ECLIPSE IP, LLC, for a declaratory judgment of its rights under the Patent Act, and complains as follows:

JURISDICTION AND VENUE

1. This is an action to declare the rights of the parties pursuant to the Federal Declaratory Judgment Act, 28 U.S.C. § 2201, and the Patent Laws of the United States, 35 U.S.C. § 271, et seq.

2. This court has subject matter jurisdiction of this action pursuant to 28 U.S.C. § 1338(a).

3. This court has personal jurisdiction over Defendant pursuant to Fla. Stat. Ch. 48.193(1) and (2) by virtue of its substantial, continuous and not isolated activity in the Southern District of Florida, including having a principal place of business within Palm Beach County, Florida and, upon information and belief, by virtue of transacting its business of seeking,

negotiating and entering patent license agreements with alleged infringers situated within this District and throughout the State of Florida.

4. Venue is proper in this District, pursuant to 28 U.S.C. § 1391, because Defendant is subject to personal jurisdiction in the District, and because a substantial part of the events giving rise to this claim for declaratory relief and the subject matter thereof occurred within the District, including, without limitation, that Plaintiff received a cease-and-desist letter from Defendant in this District, and that Plaintiff and Defendant each have a principal place of business is located in this District.

THE PARTIES

5. Plaintiff is a Florida limited liability company having its principal place of business at 250 South Australian Avenue, 17th Floor, West Palm Beach, Florida 33401. It is in the business of providing slip-resistant safety footwear to workers in various service and industrial areas.

6. Defendant is a Florida limited liability company having its principal place of business at 711 SW 24th Avenue, Boynton Beach, Florida 33435. It is in the business of soliciting patent license agreements with alleged infringers.

BACKGROUND

7. Defendant is the owner by assignment of U.S. Patent No. 8,564,459, entitled “Systems and Methods for a Notification System That Enable User Changes to Purchase Order Information for Delivery and/or Pickup of Goods and/or Service” and issued on October 22, 2013 (“the ‘459 Patent”). A copy of the ‘459 Patent is attached as Exhibit “A” hereto.

8. On April 11, 2014, counsel for Defendant sent a cease-and-desist letter to Plaintiff, alleging infringement of the ‘459 Patent by virtue of the use of automated messaging

features in Plaintiff's online ordering systems¹. The letter included a claim chart purporting to demonstrate infringement of Claim 1, a "representative claim" of the '459 Patent, and demanded payment of a licensing fee. A copy of the letter is attached as Exhibit "B" hereto.

9. Defendant is a known non-practicing entity or "patent troll" which essentially uses patents to extract money from target companies it accuses of patent infringement. It manufactures and sells nothing but patent licenses. A recent search on Docket Navigator, attached as Exhibit "C" hereto, indicates Defendant has been party to dozens of infringement actions in the past three years based on its patent portfolio, including the '459 Patent.

10. Plaintiff's online ordering systems lack particular elements, and their use does not include the performance of particular steps, required for literal infringement of the '459 Patent, nor do these elements or steps occur under the doctrine of equivalents.

11. Upon information and belief, the '459 Patent is invalid.

12. Based on the positions and arguments set forth in Defendant's letters, and Plaintiff's knowledge of Defendant's apparent business model, it appears nothing Plaintiff could say or do would dissuade Defendant from persisting in its unfounded monetary demands.

13. As a result of Defendant's April 11, 2014 letter, an actual case or controversy exists between the parties. Defendant's accusations of patent infringement and monetary demands threaten potentially serious consequences to Plaintiff's business operations.

14. Because of the serious nature of Defendant's infringement accusations and monetary demands, Plaintiff believes that these accusations and demand must be addressed now, or else they will persist and cause damage to Plaintiff as a result.

¹ The letter contains an apparent typographical error in so much as it refers to Plaintiff's website as "www.hm.com", which is the website for H&M stores, another apparent licensing target of Defendant.

15. Plaintiff is entitled to be able to continue using its online ordering systems in an atmosphere free of Defendant's unfounded accusations and demands, and therefore believes that it is necessary to invoke the protections of the Federal Declaratory Judgment Act in this matter.

COUNT I
DECLARATORY JUDGMENT FOR NON-INFRINGEMENT OF THE '459 PATENT

16. This Count seeks a declaration of rights pursuant to the protections of the Federal Declaratory Judgment Act, 28 U.S.C. § 2201. Plaintiff repeats and realleges Paragraphs 1 – 15 above.

17. Plaintiff has not made, used, offered to sell or sold or imported any online ordering system covered by any claim of the '459 Patent, nor operated a system according to the method claimed therein.

18. Plaintiff has not contributorily infringed or induced the infringement of the '459 Patent.

19. Plaintiff is in need of, and entitled to, a judicial declaration that it has not infringed the '459 Patent via its accused online ordering system.

COUNT II
DECLARATORY JUDGMENT FOR INVALIDITY OF THE '459 PATENT

20. This Count seeks a declaration of rights pursuant to the protections of the Federal Declaratory Judgment Act, 28 U.S.C. § 2201. The Plaintiff repeats and realleges Paragraphs 1 – 15 above.

21. Upon information and belief, the '459 Patent is invalid for lack of patentable subject matter, pursuant to 35 U.S.C. § 101.

22. Plaintiff has reason to further question the validity of the '459 Patent in light of the prior art, pursuant to 35 U.S.C. §§ 102 and 103. Further investigation and discovery are required in this regard.

23. Plaintiff is in need of, and entitled to, a judicial declaration that the '459 Patent is invalid and unenforceable.

DEMAND FOR JURY TRIAL

The Plaintiff requests that all issues in this case be tried to a jury.

PRAYER FOR RELIEF

WHEREFORE, Plaintiff prays that this Court enter judgment that:

- A. Plaintiff has not committed any act of infringement of the '459 Patent with respect to Plaintiff's online ordering systems;
- B. The '459 Patent is invalid and unenforceable;
- C. This case is exceptional, under 35 U.S.C. § 285, and that the Defendant reimburse the Plaintiff's reasonable attorney fees and costs incurred in connection therewith; and
- D. Grant the Plaintiff such other relief as this Court deems appropriate.

Respectfully submitted,

s/ Brian M. Taillon

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