

UNITED STATES DISTRICT COURT
DISTRICT OF MINNESOTA

JAY S. CANTWELL,

Case No.: _____

Plaintiff,

vs.

JURY TRIAL DEMANDED

3M COMPANY, a Delaware corporation,
and 3M INNOVATIVE PROPERTIES
COMPANY, a Delaware corporation,

Defendants.

COMPLAINT FOR PATENT INFRINGEMENT

Plaintiff, Jay S. Cantwell ("Plaintiff"), by and through his attorneys of record, brings this action against Defendants 3M company and 3M Innovative Properties Company (Collectively, "Defendants" or "3M") to stop Defendants' infringement of Plaintiff's patented masking tape technology. For its Complaint against Defendants, Plaintiff alleges and states as follows:

I. NATURE OF THE ACTION

1. This is a civil action arising under the laws of the United States, 35 U.S.C. § 1, *et seq.*, for patent infringement. Plaintiff seeks damages and injunctive relief as provided in 35 U.S.C. §§ 281, 283-85.

II. PARTIES

2. Plaintiff, Jay S. Cantwell ("Cantwell") is, and was at all relevant times hereto, a resident of the State of Missouri with a residence address at 14 Prinz Circle, Saint Charles, MO 63303.

3. Upon information and belief, Defendant 3M Company is a corporation organized and existing under the laws of the State of Delaware, with its principal place of business at 3M Center, St. Paul, Minnesota 55133, in this judicial district.

4. Upon information and belief, Defendant 3M Innovative Properties Company is a corporation organized and existing under the laws of the State of Delaware, with its principal place of business at 3M Center, St. Paul, Minnesota 55133, in this judicial district.

III. JURISDICTION

5. This Court has subject matter jurisdiction pursuant of 28 U.S.C. § § 1331 and 1338(a) because the claims alleged herein arise under the Constitution of the United States of American and the patent laws of the United States, 35 U.S. 1, *et seq.*

6. Jurisdiction is also properly vested in this Court by virtue of the fact that there is diversity of citizenship between the parties and the amount in controversy exceeds \$75,000.00.

7. This Court has personal jurisdiction over Defendants because Defendants reside in this judicial district and have committed acts of patent infringement in this judicial district, have systematic and continuous contacts in this judicial district, regularly transact business within this judicial district, and regularly avail themselves of the benefits of this judicial district.

IV. VENUE

8. Venue is proper in this Court pursuant to 28 U.S.C. § § 1391(b) and 1400(b). Defendants have committed or induced acts of infringement by third parties or contributed to acts of infringement by third parties, and/or advertise, market, sell, and/or offer to sell products, including infringing products, in this judicial district.

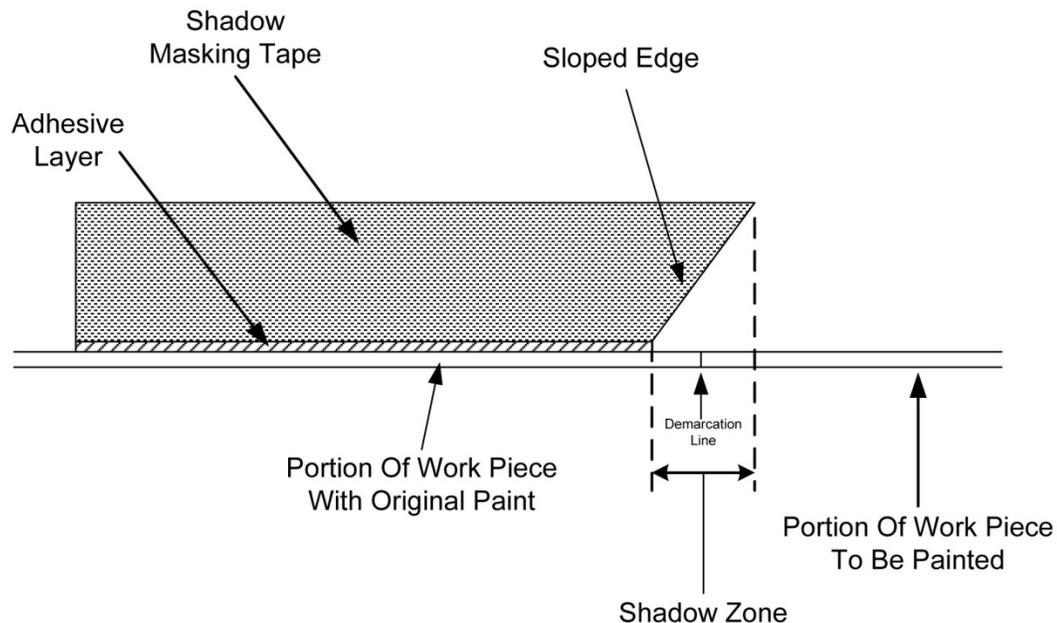
V. THE PATENT IN SUIT

9. On July 28, 1998 the United States Patent and Trademark Office issued U.S. Patent No. 5,786,028 entitled "Masking Tape and Method" to Plaintiff (hereinafter, the '028 Patent which is attached hereto as Exhibit No. 1).

10. As stated in its Abstract, the '028 Patent is directed to “[a] masking tape used in spray application or removal of coatings along a demarcation line. The tape is engineered so that during the spraying process the coating being applied or the abrasive grit being used to remove a coating makes substantially no contact with the lateral edge of the tape along a shadow zone flanking the demarcation line.” Such a construction of the masking tape results in a more esthetically pleasing appearance of the finished work piece.

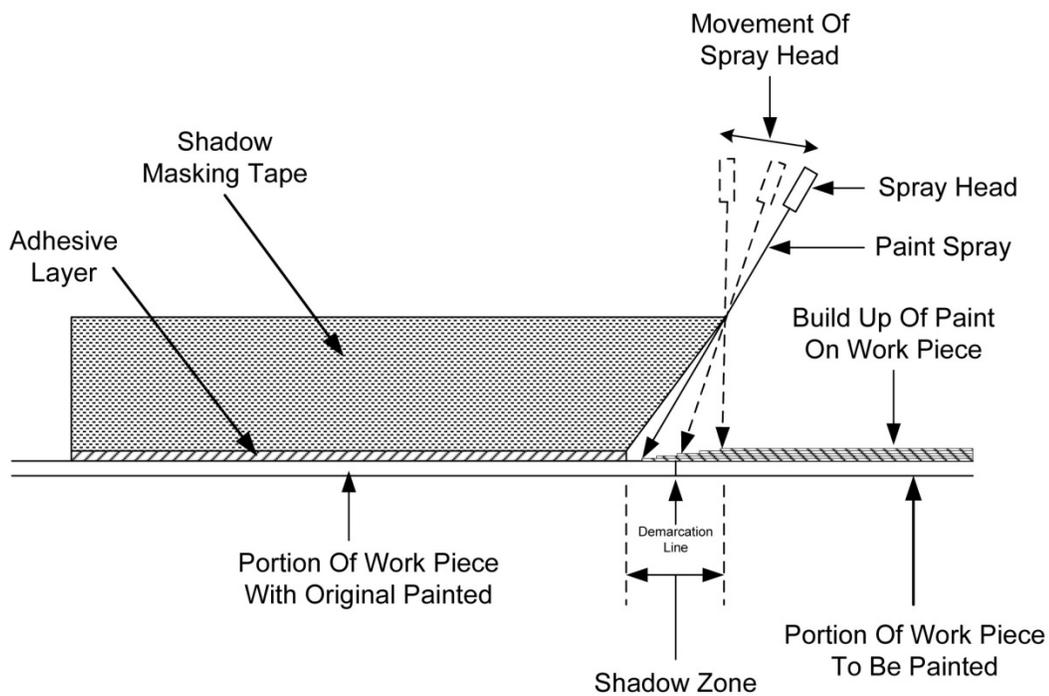
11. The masking tape described and claimed in the '028 Patent achieves its beneficial results by using a “shadow masking technique”.

12. Such a technique is illustrated in the drawing below:



13. The shadow masking tape includes a sloped edge and an adhesive layer for affixing the tape to a work piece to be painted. The work piece includes a portion with original paint and a portion requiring the application of new paint. Where the two portions meet a demarcation line is formed as indicated in the above drawing. The purpose of the shadow masking tape is to form a shadow zone around the demarcation line which will allow the new paint to blend in with the old paint in order to achieve a smooth transition from new to old paint. Thus, use of the shadow masking tape eliminates the need to repaint the entirety of a work piece when only a portion of the work piece requires painting.

14. The following drawing illustrates the application of new paint on a work piece with existing paint using Plaintiff's shadow masking tape:

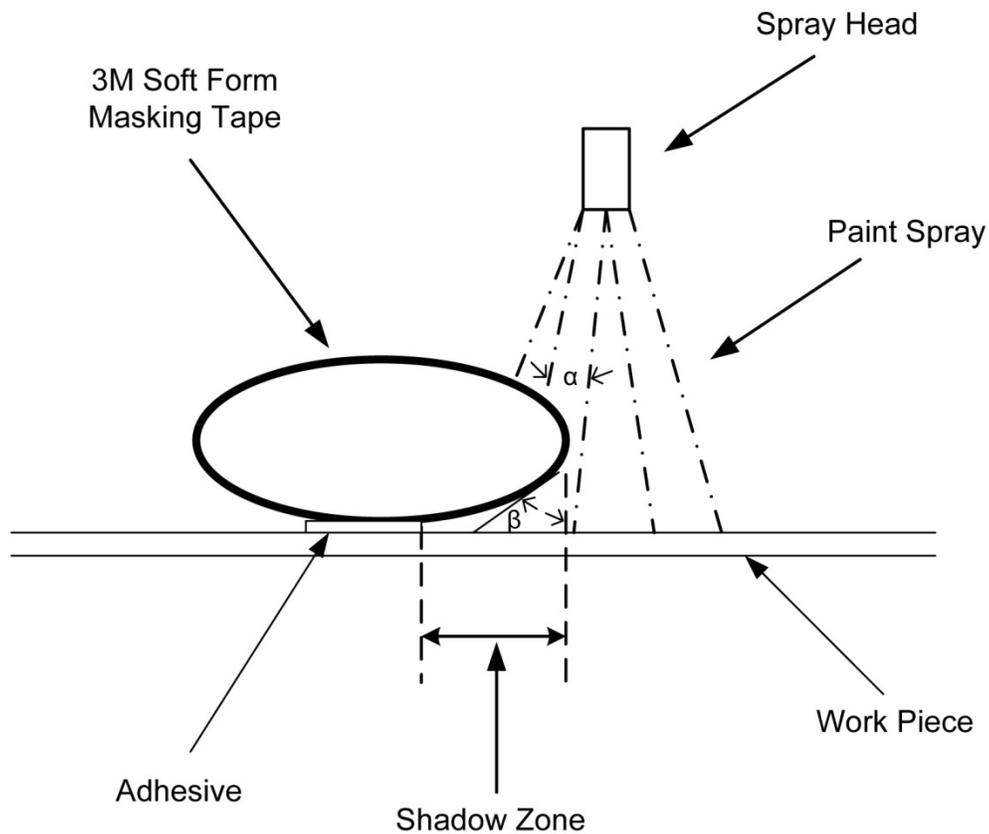


15. As the spray head is moved back and forth in the areas of the shadow zone, the sloped edge of the masking tape causes a gradual buildup of layers of paint in the shadow zone.

VI. DEFENDANTS' INFRINGING PRODUCTS

19. Upon information and belief, Defendants have directly infringed, and are continuing to directly infringe, one or more claims of the '028 Patent, literally and/or under the doctrine of equivalents, by making, using, offering to sell, and/or selling within the United States, and in this judicial district, a line of masking tape products which infringe the '028 Patent. These infringing products include products sold under the name "3M™ Soft Edge Foam Masking Tape", and from time to time, under other names.

20. A presentative illustration of the 3M products is shown below. The 3M tape is of tubular construction which also provides a shadow zone when adhered onto a work piece.



21. Upon information and belief, Defendants also sell a line of paint spray heads and related equipment for use with its infringing masking tape.

22. Upon information and belief, Defendants contribute to the infringement of the ‘028 Patent by selling the 3M masking tape to third parties who use a paint spray head acquired from parties other than Defendants.

23. Upon information and belief, Defendants induce acts of infringement of the ‘028 Patent by third parties by selling the 3M masking tape to such parties when Defendants know that the 3M masking tape has no purpose other than to be used to carry out infringement of the ‘028 Patent.

VII. DEFENDANTS’ PATENT INFRINGEMENT

24. The ‘028 Patent has 1 independent and 3 dependent claims. Below is a patent claim chart showing that claim 1 is infringed by the 3M product.

Patent Claim 1	3M Product
A method for the spray application of paint to a surface of an object having a first section to be spray painted and a contiguous second section to be masked, said method comprising:	This is the purpose of the 3M product.
providing a flexible tape including a body with a top surface and a bottom surface connected by at least one lateral edge,	The 3M product is a flexible tape with a top surface and a bottom surface connected by at least one lateral edge;
said bottom surface having a pressure sensitive adhesive adapted to adhere to the second section,	The adhesive on the 3M product meets this requirement.
said bottom surface forming a vertex with the second section proximate but spaced from a demarcation line between the first and second sections, said lateral edge having a leading portion, said leading portion of said lateral	This limitation refers to the “shadow zone” which the 3M product has.

edge sloped upwardly and outwardly from the bottom surface and overhanging the vertex;	
<p>providing a spray head for spraying paint on the first section adjacent the tape at an included angle α between a leading edge of the spraying paint and the surface of the object,</p> <p>said angle α being greater than an included angle β between the second section and a line passing through the vertex and the extreme of the leading portion of the lateral edge, said leading portion of the lateral edge shadowing the vertex from the spray and forming a shadow zone about the vertex;</p>	<p>This limitation is met by the 3M product and the associated spray head for which the produce is designed to be used with.</p> <p>Upon information belief, this limitation is met by the 3M product.</p>
applying said tape to the object with the shadow zone between the vertex and the demarcation line between the first and second sections;	This limitation is met by the 3M product.
spraying a full-thickness layer of paint from the spray head on the first section. said second section being protected by the shadow zone;	This limitation is met by the 3M product and the associated spray head for which the produce is designed to be used with.
terminating spraying when the layer of paint at the demarcation line substantially reaches full-thickness before the paint flows into the shadow zone and makes contact with the lateral edge of the tape;	This limitation is met by the 3M product and the associated spray head for which the produce is designed to be used with.
allowing the paint to dry; and	This limitation is met by the 3M product.
removing the tape from the second section whereby a sharp demarcation line is formed between the first and second sections.	This limitation is met by the 3M product.

25. Defendants have profited by their infringing activities.

26. Plaintiff has been damaged by the infringing acts of Defendants in an amount to be proven at trial, but such amount is in excess of \$75,000.00 and includes all remedies available under the U.S. Patent Act.

VIII. DEFENDANT'S WILLFUL INFRINGEMENT

27. Plaintiff pioneered the development of a removable masking tape for use in painting a work piece along a demarcation line. Prior to Plaintiff's development, no such tapes were available in the industry.

28. Upon information and belief, Defendant 3M was made aware of Plaintiff's development through at least 3M distributors and others affiliated with 3M. In retrospect, it is clear that Defendants' infringing masking tape is based on the shadow zone concept developed by Plaintiff and that 3M appropriated that concept from Plaintiff and chose to willfully infringe the '028 Patent.

29. Based on that appropriation, Defendants' size and market domination ability has unfairly and illegally allowed Defendants to gain a large share of the masking tape market.

30. Defendants' unauthorized use of the '028 Patent has caused substantial injury to Plaintiff.

31. Upon information and belief, Defendants were at all relevant times aware of the '028 Patent and knowingly, willfully and deliberately disregarded and infringed the patent.

IX. PRAYER FOR RELIEF

WHEREFORE, Plaintiff Cantwell, having asserted a claim for relief, prays for a judgment against Defendant 3M and Defendant 3M Innovative Properties as follows:

1. A judgement that Defendants have infringed and are infringing the '028 Patent;
2. A judgement that Defendants' infringement was and is willful;
3. A permanent injunction against Defendants from infringing the '028 Patent;

4. An award of damages adequate to compensate Plaintiff for Defendants' patent infringement, such damages to be determined by a jury, and if necessary, an accounting adequate to compensate Plaintiff for the infringement;
5. An award of enhanced damages, including up to three times the amount found or assessed, based on Defendants' willful infringement;
6. An award of pre-judgement and post-judgement interest at the maximum rate allowed by law;
7. An order finding that this is an exceptional case and awarding Plaintiff his costs, expenses, disbursements, and reasonable attorney's fees under 35 U.S.C. § 285 and all other applicable statutes, rules and common law, and
8. Such other relief in law or equity, as this Court deems just and proper.

JURY TRIAL DEMAND

Plaintiff hereby makes his demand for a jury trial on all issues triable before a jury.

SHOEMAKER & SHOEMAKER, P.L.L.C.

Dated: September 9, 2019

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