

CV-03 6103

UNITED STATES DISTRICT COURT

Eastern District of New York

RECEIVED  
U.S. DISTRICT COURT, E.D.N.Y.  
IN CLERK'S OFFICE  
LONG ISLAND COURTHOUSE

★ DEC 03 2003 ★

ENTERED

★ \_\_\_\_\_ ★

.....  
J. D'Addario & Company, Inc.

Plaintiff

v.

Civil Action No. \_\_\_\_\_

W. L. Gore & Associates, Inc.

Defendant

December 3, 2003

.....

FEUERSTEIN, J.

BOYLE, M.

COMPLAINT FOR DECLARATORY JUDGMENT

1. Plaintiff, J. D'Addario & Company, Inc., is a corporation incorporated under the laws of the State of New York, and has its principal place of business in this district at 595 Smith Street, Farmingdale, New York 11735 (hereinafter, "J. D'Addario")

2. Defendant, W. L. Gore & Associates Inc., is a corporation incorporated under the laws of the State of Delaware, and has its principal executive office at Little Falls Centre Two, 2751 Centerville Road, Wilmington, Delaware 19808 (hereinafter, "Gore").

3. On information and belief, Gore is registered to do business in the State of New York.

4. Jurisdiction of this Court arises under the federal Declaratory Judgment Act, Title 28, United States Code, Sections 2201 and 2202, and under the laws of the United States concerning actions relating to patents, Title 28, United States Code, Section 1338 (a).

5. Venue is proper in this district, under Title 28, United States Code, Sections 1391 (b) and (c).

6. J. D'Addario has for many years been a world-renowned manufacturer of musical instrument strings, some of which it markets under the J. D'Addario brand and other brands, and some of which it manufactures for other string suppliers to market under private label brands.

7. On information and belief, Gore or its authorized agents have been doing business in this district and purposefully marketing a wide variety of industrial and consumer products, including musical instrument strings, in this district.

8. J. D'Addario and Gore are competitors in the field of musical instrument strings, in this district.

9. On information and belief, Gore owns the entire right, title, and interest in U.S. Letters Patent No. 5,883,319 issued on March 16, 1999, for "Strings for Musical Instruments". (Exhibit A)

10. On information and belief, Gore owns the entire right, title and interest in U.S. Letters Patent No. 6,528,709 issued on March 4, 2003, for "Strings for Musical Instruments". (Exhibit B)

11. Plaintiff J. D'Addario has made and/or offered for sale within the past six years and since the issuance of both of said Letters Patent, certain coated musical instrument strings under the EXP trademark as described in the accompanying excerpts from a J. D'Addario catalogue. (Exhibit C).

12. There is an actual and continuing justiciable controversy within this district between J. D'Addario and Gore as to Gore's right to threaten or maintain suit for infringement of one or both of said Letters Patent, and as to the validity and scope thereof, and as to whether any of plaintiff's products infringe any valid claim thereof.

13. During early 2000, J. D'Addario was developing the EXP line of music instrument strings, in which the windings on the wound EXP strings were pre-coated with polyurethane before winding on a core wire.

14. During mid 2000, J. D'Addario realized that claim 40 of Gore's U.S. Patent 5,883,319 (hereinafter, "the '319 patent"), if valid and enforceable, presented a risk of infringement with respect to the EXP wound strings.

15. During mid 2000, J. D'Addario found prior art that had not been considered by the examiner in allowing claim 40 of the '319 patent and that J. D'Addario believed invalidated claim 40.

16. During the period August through October 2000, J. D'Addario identified and sent this prior art to Gore's patent attorney, with notice that J. D'Addario intended to formally introduce the EXP line of strings in January 2001 and that such strings would not infringe the '319 patent because claim 40 thereof was invalid in view of the prior art.

17. In October 2000, at a trade show, J. D'Addario gave Gore a sample beta test prototype set of the EXP strings.

18. Attorneys and management for Gore and J. D'Addario met on December 1, 2000 in this district to discuss, *inter alia*, the prior art J. D'Addario had furnished to Gore in relation to claim 40 of the '319 patent, at which meeting Gore stated that it had other pending patent rights that should be of concern to J. D'Addario.

19. At the meeting on December 1, 2000, J. D'Addario summarized to Gore the construction of the wound EXP strings to be launched in January 2001.

20. On information and belief, Gore filed U.S. Patent App. No. 09/735,882 (hereinafter, "the '882 application") on December 12, 2000, claiming a chain of priority

from the application which matured into the '319 patent, but containing numerous new claims that were drafted with the calculated purpose of reading on the plaintiff's EXP strings while avoiding the prior art plaintiff had furnished Gore in October 2000.

21. During early 2001, J. D'Addario discovered additional prior art that J. D'Addario considered self-evidently powerful for invalidating any potentially troublesome claims that Gore might secure in the pending application.

22. On information and belief, when Gore received a Notice of Allowance on the pending '882 application, Gore initiated a meeting with J. D'Addario that eventually took place on December 16, 2002 in this district.

23. At the meeting of December 16, 2002, Gore stated its intention to enforce its intellectual property in the patent to be granted on the allowed '882 application.

24. On information and belief, Gore has informed other manufacturers of coated strings that they require a license from Gore.

25. After issuance of the '709 patent from the '882 application, Gore requested that J. D'Addario and its attorneys attend a meeting at the offices of Gore on May 29, 2003 at which meeting Gore accused D'Addario of patent infringement and explained in detail why it believed J. D'Addario's EXP strings were covered by certain specified claims of the '709 patent and that J. D'Addario must be licensed by Gore in order to continue marketing the EXP strings.

26. At the May 29, 2003 meeting, J. D'Addario denied infringement and explained why the claims asserted by Gore were invalid.

27. On or about September 18, 2003, Gore sent a proposal to J. D'Addario in this district, which reiterated Gore's assertion that the EXP strings infringe the '709

patent, and further stated that the situation has reached an impasse which on its current course is likely to lead to litigation.

28. On November 11, 2003, Gore's in-house counsel sent a threatening ultimatum letter to the attorneys for J. D'Addario, in which Gore reiterated its infringement assertion by stating that Gore continues to believe that it has a valid patent that covers D'Addario's EXP coated guitar strings, and demanding a response within seven (7) days from the date of its letter. (Exhibit D).

29. As a result of Gore's accusations of infringement and pattern of conduct culminating in the ultimatum letter of November 11, J. D'Addario has a reasonable apprehension that Gore will soon file suit for infringement of U.S. Patent No. 6,528,709.

30. On information and belief, as of November 15, 2003, the U.S. Patent and Trademark Office database does not show that claim 40 of U.S. Patent No. 5,883,319 has been disclaimed by Gore, or that Gore has filed an application for reissue of said '319 patent.

31. On information and belief, Gore has not informed J. D'Addario that the EXP strings do not infringe claim 40 of U.S. Patent No. 5,883,319.

32. As a result of the foregoing facts and Gore's pattern of conduct, plaintiff has a reasonable apprehension that in filing a suit against plaintiff for infringement of the '709 patent, Gore will include a count for infringement of claim 40 of the '319 patent.

33. At least some claims of U.S. Patent No. 6,528,709 are invalid and no claims are enforceable against plaintiff, for one or more of the reasons that:

- (a) Plaintiff has not infringed any valid claims of said patent.

- (b) The specification does not contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art or science to which it pertains, or with which it is most nearly connected, to make the claimed invention.
- (c) The claims are excessively vague and indefinite and so do not distinctly point out and define the invention.
- (d) In light of the prior art at the time the alleged invention was made, the subject matter as claimed in the patent would have been obvious to one of ordinary skill in the art to which the alleged invention relates and does not constitute patentable invention.
- (e) More than one year prior to the effective filing date of the application which matured into the patent, the alleged invention was patented or described in printed publications in this or in foreign countries, or was in public use or on sale in this country.
- (f) Before the alleged invention or discovery by the patentee, the alleged invention was known or used by others than the alleged inventor and was on sale in this country.

34. At least claim 40 of U.S. Patent No. 5,883,319 is invalid and unenforceable against plaintiff, for one or more of the reasons that:

- (a) Plaintiff has not infringed any valid claims of said patent.
- (b) The specification does not contain a written description of the invention, and of the manner and process of making and using it, in such full, clear,

concise, and exact terms as to enable any person skilled in the art or science to which it pertains, or with which it is most nearly connected, to make the claimed invention.

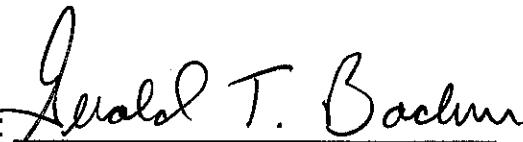
- (c) In light of the prior art at the time the alleged invention was made, the subject matter as claimed in the patent would have been obvious to one of ordinary skill in the art to which the alleged invention relates and does not constitute patentable invention.
- (d) More than one year prior to the filing of the application which matured into the patent, the alleged invention was patented or described in printed publications in this or in foreign countries, or was in public use or on sale in this country.
- (e) Before the alleged invention or discovery by the patentee, the alleged invention was known or used by others than the alleged inventor and was on sale in this country.

WHEREFORE, plaintiff demands:

- (a) Entry of judgment that said defendant is without right or authority to threaten or to maintain suit against plaintiff or its customers for alleged infringement of U.S. Patent Nos. 5,883,319 or 6,528,709; that said patents contain claims that are invalid; and that said patents are not infringed by plaintiff or its customers by the making, selling, offering for sale, or using of any music instrument string product made or sold or used by plaintiff.

- (b) Entry of judgment for its costs and reasonable attorney fees incurred by plaintiff herein.
- (c) Such other and further relief as the Court may deem appropriate.

Respectfully Submitted,  
THE PLAINTIFF  
J. D'ADDARIO & COMPANY, INC.

By: 

Gerald. T. Bodner  
Federal Bar No, GB-9456  
Bodner & O'Rourke, LLP  
425 Broadhollow Road  
Suite 108  
Melville, New York 11747  
Tel. (631) 249-7500  
Fax (631) 249-4508  
Email: [gbodner@bodnerorourke.com](mailto:gbodner@bodnerorourke.com)



L. James Ristas  
Federal Bar No. ct09316  
Alix, Yale & Ristas, LLP  
750 Main Street  
Hartford, Connecticut 06103-2721  
Tel. (860) 527-9211  
Fax (860) 527-9025  
Email: [jimristas@pctlaw.com](mailto:jimristas@pctlaw.com)



**EXHIBITS**  
**VIEWABLE**  
**IN**  
**CLERK'S**  
**FILE**