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SEP 23 2005

LUTHER D. THOMAS, Clerk
By: *[Signature]* Deputy Clerk

RICH USA

UNITED STATES DISTRICT COURT
NORTHERN DISTRICT OF GEORGIA
ATLANTA DIVISION

OUTSIDE THE BOX INNOVATIONS,
LLC, d/b/a UNION RICH USA,

Plaintiff,

v.

TRAVEL CADDY, INC.,
and
ROOSTER PRODUCTS d/b/a
THE ROOSTER GROUP

Defendants.

Civil Action

File No.

1:05-CV-2482

-ODE

COMPLAINT

Plaintiff, OUTSIDE THE BOX INNOVATIONS, LLC D/B/A UNION RICH USA ("Union Rich"), files this Complaint against Defendants, TRAVEL CADDY, INC., ("Travel Caddy") and ROOSTER PRODUCTS D/B/A THE ROOSTER GROUP ("Rooster Group"), showing as follows

INTRODUCTION

1. This is an action brought under the Declaratory Judgment Act, 28 U.S.C §§ 2201 and 2202, and the United States Patent Act, 35 U.S.C. § 1 *et seq.* for a declaration that Union Rich's products do not infringe any valid claims of any patents issued by the United States Patent & Trademark Office to Defendant,

FORMS RECEIVED
Consent To US Mag.
Pretrial Instructions _____
Title VII EOC _____
[Signature]

Travel Caddy, including U.S. Patent No. 6,823,992 (the “’992 Patent”) issued on November 30, 2004.

2 This also is an unfair competition and deceptive trade practices action brought by the Plaintiff pursuant to the Lanham Act (15 U.S.C. § 1025 *et seq.*) and section 10-1-372(a)(8) of the Official Code of Georgia Annotated relating to material false and misleading statements made in commerce by or on behalf of Defendants, Travel Caddy and Rooster Group unlawfully disparaging Union Rich and its products.

SUBJECT MATTER JURISDICTION

3 This Court has original jurisdiction to adjudicate the declaratory judgment patent claim and the Lanham Act claims in this action pursuant to 28 U.S.C. § 1338(a) and has pendent jurisdiction to adjudicate the associated state law unfair competition deceptive trade practices claim pursuant to 28 U.S.C. § 1338(b).

VENUE

4. Venue is proper in this Court pursuant to 28 U.S.C. § 1391(b) because Defendant regularly engages in business in this District, and a substantial part of the events giving rise to the claims in this action occurred in this District.

THE PARTIES

5 Union Rich is a Florida limited liability company with its principal place of business at 1301 West Copans Road, Building G, Suite 9, Pompano Beach Florida 33064.

6. Union Rich distributes *inter alia* hardware products to retailers, including Home Depot U.S A., Inc (“Home Depot”), a Delaware corporation with its principal place of business at 2455 Paces Ferry Road, Atlanta, Georgia 30339.

7 Defendant Travel Caddy is an Illinois corporation with its principal place of business located at 800 Elgin Road, Evanston, Illinois 60201

8 Defendant Rooster Group is an entity of unknown form with its principal place of business located at 17280 N Green Mountain Road, San Antonio, Texas 78247 To the best of Plaintiff’s knowledge and belief, Rooster Group distributes Travel Caddy products.

FACTS GIVING RISE TO THIS ACTION

9. The ‘992 Patent, which is titled “Tool Carrying And Storage Case,” was issued on November 30, 2004 listing Travel Caddy as the assignee thereof. A true and correct copy of the ‘992 Patent is attached hereto as Plaintiff’s Exhibit 1.

10. Prior to the issuance of said patent, on June 15, 2004, counsel for Travel Caddy sent cease and desist correspondence to one of Union Rich’s

customers, Home Depot, advising of a pending patent application relating to a “Tool Carrying and Storage Case,” and in that correspondence claimed that Home Depot’s “item # 412997 Husky Heavy-Duty ProTool Bag” product likely “will infringe the TCI patent once it issues.” A true and correct copy of said correspondence is attached hereto as Plaintiff’s Exhibit 2.

11 The “Husky Heavy-Duty ProTool Bag” product marketed by Home Depot which was the focus of the June 15 cease and desist correspondence was supplied by Union Rich.

12. The pending patent application referenced in the June 15 cease and desist correspondence matured into the ‘992 Patent, Plaintiff’s Exhibit 1.

13. Ultimately, the June 15 cease and desist correspondence was forwarded to Union Rich, and on August 9, 2004 its counsel responded by letter to Travel Caddy’s counsel advising of counsel’s conclusion “the claims [of the patent] do not read on the Husky Bag.” A true and correct copy of said correspondence is attached hereto as Plaintiff’s Exhibit 3.

14 Additionally in said correspondence, Plaintiff’s Exhibit 3, it was pointed out to Travel Caddy’s counsel that “many of the claims [e.g claims 1 through 3] of the Application [which matured into the ‘922 Patent] require ‘a single continuous, closed loop binding joining the fabric covering the generally

rigid panels and the flexible panels ' The Husky Bag uses no such single closed loop binding. Accordingly, we see no reason why Home Depot . . . should cease distribution of the Husky Bag ”

15. In said correspondence, Plaintiff's Exhibit 3, Union Rich's counsel also inquired of Travel Caddy's counsel, "If you believe we have misunderstood the scope of the claims that are being pursued in the application or their relevance to the Husky Bag we would certainly appreciate your comments."

16. On November 4, 2004, counsel for Travel Caddy replied to the above-referenced response, Plaintiff's Exhibit 3, advising that the pending patent application had been allowed and clarified that Travel Caddy's infringement assertions related to Claim 4 of the pending patent. A true and correct copy of said correspondence is attached hereto as Plaintiff's Exhibit 4.

17 In response to the November 4, 2004 letter, Plaintiff's Exhibit 4, counsel for Union Rich wrote a letter to Travel Caddy's counsel on November 23, 2004 informing counsel it did not appear that the accused product was within the scope of Claim 4, but nonetheless Union Rich had requested a comprehensive analysis A true and correct copy of said correspondence is attached hereto as Plaintiff's Exhibit 5.

18. Thereafter, by letter December 2, 2004, counsel for Union Rich provided counsel for Travel Caddy a detailed explanation as to why the accused product does not infringe any claim of the '992 patent, specifically Claim 4 noting as follows.

Turning now to the second independent claim, Claim 4 requires a pair of 'generally *semi-rigid*, fabric covered. .end panel[s] having a generally rectangular lower section ..and a generally triangular upper section which is *flexible*.' Thus, claim 4 requires that the end panels be constructed in a particular manner; namely, semi-rigid, yet flexible in the upper section. Upon reviewing the specification of the patent, it becomes clear that the flexible upper section of the end panels allows them to be folded inward, for example, as shown in Figure 7.

The Husky Bag clearly uses no such end panels; rather, it uses end panels constructed from an integral piece of rigid material, which is fabric-covered. Thus, the lower portion and the upper portion of the Husky Bag end panels have the same rigidity, neither of which is flexible. Therefore, there can be no legitimate claim that the Husky Bag infringes on claim 4.

A true and correct copy of said correspondence is attached hereto as Plaintiff's Exhibit 6

19 In said letter, Plaintiff's Exhibit 6, Union Rich's counsel also demanded that Travel Caddy cease misrepresenting to Union Rich's customer that Union Rich's product infringes the Travel Caddy patent.

20 On December 17, 2004, counsel for Travel Caddy responded to the above-referenced letter of December 2, 2004, Plaintiff's Exhibit 6, but rather than explain any deficiencies in Union Rich's infringement analysis and non-

infringement conclusions merely offered a conclusory assertion that the Home Depot Husky Bag product infringed the patent and then for the first time claimed that Home Depot's Electrician CarryAlls Product No 189281 also infringes "Claims 1-3 of the '992 patent." A true and correct copy of said correspondence is attached hereto as Plaintiff's Exhibit 7.

21. In said correspondence, Plaintiff's Exhibit 7, Travel Caddy also rejected Union Rich's demand that Travel Caddy cease misrepresenting to Union Rich's customers that the Union Rich Products infringe the Travel Caddy patent

22. Thereafter, Travel Caddy's counsel informed Union Rich's counsel of another pending patent application, the '319 application, which Travel Caddy contended would cover the Union Rich products, and later provided a copy of the applied for claims.

23. Upon analysis, it became apparent that, as with the '992 Patent, the pending patent application did not cover the Union Rich Electrician Bag being marketed by Home Depot and by letter dated February 21, 2005, Travel Caddy's counsel was so informed. A true and correct copy of said correspondence is attached hereto as Plaintiff's Exhibit 8.

24. Specifically, in the February 21 correspondence, Plaintiff's Exhibit 8, Travel Caddy's counsel was informed that the '992 Patent clearly did not cover the Electrician Bag for the following reason.

The '992 Patent includes two independent claims, claims 1 and 4. Among its limitations, claim 1 requires a pair of 'generally rigid, fabric covered end panel[s]' and 'flexible, fabric front [and back] panel[s].' Thus, claim 1 requires end panels that are rigid and front and back panels that are flexible. Similarly, among its limitations, claim 4 requires a pair of 'generally semi-rigid, fabric covered end panel[s]' and 'flexible, fabric front [and back] panel[s].' Thus, claim 4 requires end panels that are semi-rigid and front and back panels that are flexible.

Quite distinctly, the Electrician Bag includes end walls and side walls, each constructed from a fabric-covered integral piece of reinforcing material. The reinforcing material used for the side walls is identical to the reinforcing material used for the end walls, creating a bag with walls, all of which are constructed from a material having the same degree of rigidity and flexibility. Thus, it is clear that the Electrician Bag does not infringe any claim of the '992 patent.

25. Further, in the February 21 correspondence, Plaintiff's Exhibit 8, Travel Caddy's counsel was similarly informed that the pending patent application clearly did not cover the Electrician Bag for the following reason:

With regard to the pending claims of the '319 application, if they were allowed to issue in the form in which you provided them to us, they each require a pair of 'end panel[s] having a generally rectangular, rigid lower section' or a pair of 'generally rigid, fabric covered end panel[s]' and 'flexible, fabric front [and back] panel[s].' As described above, the design of the Electrician Bag is quite distinct in that, for example, it includes walls that are all constructed from a material having the same degree of rigidity and flexibility. Thus, it is clear that the Electrician Bag is not covered by the pending claims of the '319 application.

26 Although Union Rich's counsel communicated regularly with counsel for Travel Caddy articulating in detail why the Union Rich products were not within the scope of the '992 Patent, nor within the scope of the subsequent pending patent application, neither Travel Caddy nor its counsel ever articulated to Union Rich any analysis supporting any contention the products were arguably within the scope of the patents other than conclusory assertions of infringement.

27 Travel Caddy and its distributor Rooster Group acting on Travel Caddy's behalf have continued to engage in a regular course of conduct repeatedly advising customers of Union Rich that Union Rich products infringe Travel Caddy's patent, and threatening enforcement actions relating to same.

28. Further, well subsequent to the continuing correspondence of counsel, including the items identified above, Travel Caddy and/or its distributor Rooster Group acting on Travel Caddy's behalf even went so far as to overtly state to Home Depot's purchasing agents that Travel Caddy's counsel had repeatedly put Union Rich's on notice of the infringing nature of Union Rich's products and misrepresented that Union Rich had ignored and failed to respond to any of the notices.

29 Thus, on March 25, 2005, counsel for Union Rich corresponded with Travel Caddy's counsel again demanding a cessation of the utterance by or on

behalf of Defendants of any false or misleading statements about the accused Husky branded products and the supplier of same. A true and correct copy of said correspondence is attached hereto as Plaintiff's Exhibit 9.

30. By letter dated May 19, 2005, counsel for Travel Caddy responded suggesting the parties pursue "a commercial resolution," rather than confirming that the infringements allegations would cease. A true and correct copy of said correspondence is attached hereto as Plaintiff's Exhibit 10.

31. By letter dated May 25, 2005, counsel for Union Rich again pleaded with counsel whether there was any arguable basis for Travel Caddy's infringement assertions inquiring "If you disagree with our analysis of non-infringement, please point out any aspect with which you disagree and provide us with your analysis." A true and correct copy of said correspondence is attached hereto as Plaintiff's Exhibit 11.

32. No response was received to the inquiry that Travel Caddy articulate any basis for its infringement contentions.

33. Rather Travel Caddy and its distributor Rooster Group acting on Travel Caddy's behalf have continued to engage in a regular course of conduct repeatedly advising customers of Union Rich that the Union Rich product infringe Travel Caddy's patent, and threatening enforcement actions relating to same.

34 The misrepresentations uttered by or on behalf of Defendants are literally false and materially misleading and Defendants either knew or in the exercise of ordinary diligence should have known that the products in issue are outside of the scope of the Travel Caddy patent.

35 Defendants have uttered said misrepresentations maliciously and without lawful justification in an intentional, or at least reckless disregard of Union Rich's lawful right to market the products in issue.

36. Unless Defendants cease said misrepresentations, Union Rich is likely to suffer irreparable injury.

37 As a result of Defendant's actions and threats, Union Rich and its customers, including Home Depot, are exposed to substantial uncertainty and risks arising out of the manufacture, use, sale, offering for sale, and/or importing of the accused Husky branded products.

COUNT I

DECLARATION OF NON-INFRINGEMENT OF TRAVEL CADDY PATENTS

38 Each of the foregoing paragraphs in this Complaint is hereby incorporated in this Count by reference.

39 Defendants have asserted that certain Husky branded products, namely the Husky ProTool Bag and Husky Electrician CarryAlls, which Union

Rich makes, sells and offers to sell in the United States infringe the '992 Patent as well as a soon to be issued patent and has threatened to enforce said patents against Plaintiff and its customer, Home Depot.

40. Each of the claims of the patent in suit specify multiple limitations, or elements.

41. For an accused product to constitute an infringement, it must contain structure corresponding to each and every specific limitation of least one claim of a patent.

42. The '992 Patent contains four claims.

43. Among other limitations specified in claims 1, 2 and 3 of the '992 patent, to constitute an infringement of any of those claims, an accused product must contain both front and back sides consisting of "flexible, fabric . . . panel[s]" and "a single continuous, closed loop binding joining the fabric covering the generally rigid [end] panels and the flexible [front and back] panels."

44. None of the products manufactured by or for Union Rich contain both of these features and thus do not infringe any of these claims of the '992 patent or any other Travel Caddy patents, directly or indirectly either literally or under the Doctrine of Equivalents.

45. Among other limitations specified in claim 4 of the '992 patent, to constitute an infringement of that claim, an accused product must contain both "semi-rigid . . . end panels with . . . a generally triangular upper section which is flexible" and non-rigid front and back panels consisting of "flexible, fabric "

46 None of the products manufactured by or for Union Rich contain both of these features and thus do not infringe claim 4 of the '992 patent or any other Travel Caddy patents, directly or indirectly either literally or under the Doctrine of Equivalents.

47 Union Rich and Home Depot are thus entitled to manufacture, use and sell the products alleged to be infringements

48 By reason of the above, there exists an actual and justiciable controversy between Union Rich and the Defendants with respect to the validity of the asserted patents and the accusations that Union Rich and Home Depot's are infringing same.

49. Based upon Defendants' threats, Union Rich has a reasonable apprehension of suit concerning the Travel Caddy patents Therefore, an actual case or controversy exists as to whether the Union Rich products infringe any claims of said patents, thereby entitling Union Rich to a declaration of its rights.

COUNT II

FEDERAL UNFAIR COMPETITION

50. Each of the foregoing paragraphs in this Complaint is hereby incorporated in this Count by reference.

51 Defendants' representations about Union Rich and its products were uttered in the course of commercial advertising or promotion of Defendants' products and constitute material misrepresentations in commerce of the nature, characteristics, qualities of Union Rich's goods and commercial activities

52. Said false or materially misleading representations uttered about Plaintiff by or on behalf of the Defendants have damaged or are likely to damage Union Rich.

53. Said actions of Defendant constitute violations of section 43(a)(1)(B) of the Lanham Act, 15 U.S.C. § 1125(a)(1)(B)

COUNT III

GEORGIA DECEPTIVE TRADE PRACTICES

54. Each of the foregoing paragraphs in this Complaint is hereby incorporated in this Count by reference.

55 Defendants, while in the course of business have disparaged the goods and business of Union Rich through false and misleading representations of fact.

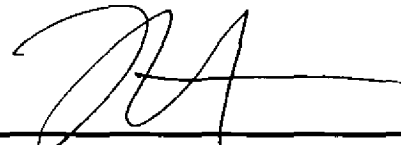
56. Said actions of Defendant constitute violations of section 10-1-372(a)(8) of the Official Code of Georgia Annotated.

57 Defendants, disparagement of the goods and business of Union Rich has been willfully committed knowing the utterances to be deceptive.

WHEREFORE, Plaintiff prays for relief, jointly and severally against Defendants as follows:

- A. Trial by jury on all issues so triable;
- B. A declaration that the Husky Heavy-Duty ProTool Bag and the Electrician CarryAlls manufactured for Union Rich do not infringe, either directly, indirectly, contributorily or otherwise, any valid and enforceable claim of the '992 Patent or any other Travel Caddy patent;
- C An Order providing that Defendants and all of its officers, agents, servants, employees, attorneys, privies, and those persons in active concert or participation with them, be preliminarily and permanently enjoined from making any commercial or promotional communication, publication, distribution, dissemination, broadcast or otherwise public dissemination of any false or misleading representations that either the ProTool Bag or the Electrician CarryAlls constitute an infringement of any patent;

- D. An award to Plaintiff of its damages incurred as a result of Defendants as a result of the unlawful unfair competition and deceptive trade practices involved in this action with prejudgment interest thereon;
- E. Trebling of said award pursuant to 15 U.S.C. § 1117,
- F. An award to Plaintiff of interest on any judgment rendered in this action;
- G. An assessment against Defendants of the costs of this action, including Plaintiff's reasonable attorneys' fees; and
- H. Any further relief to which Plaintiff may appear entitled.



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