

IN THE UNITED STATES DISTRICT COURT
FOR THE SOUTHERN DISTRICT OF FLORIDA

F.L.A. ORTHOPEDICS, INC., a
Florida Corporation,
Plaintiff,

CASE NO.: **04-60610**

JUDGE:

Magistrate: **CIV-GRAHAM**

vs.

MARK W. POWELL, an individual, and
WILLIAM R. POST, an individual,
Defendants.

**VERIFIED COMPLAINT FOR
DECLARATORY JUDGEMENT**

COMES NOW, F.L.A. ORTHOPEDICS, INC., (hereinafter "F.L.A. ORTHOPEDICS")
and sues MARK W. POWELL (hereinafter "POWELL") and WILLIAM R. POST
("hereinafter POST") alleging as follows:

INTRODUCTION

1. This is, inter alia, an action for a declaratory judgment of invalidity and non-infringement by Plaintiff, F.L.A. ORTHOPEDICS, of United States Patent 5,887,591, issued to Defendants, POWELL and POST.

1/84

PARTIES

2. Plaintiff, F.L.A. ORTHOPEDICS, is a Florida corporation, having its principal place of business at 2881 Corporate Way, Miramar, Florida 33025.
3. Upon information and belief, Defendant POWELL is an individual residing in Arkansas.
4. Upon information and belief, Defendant POST is an individual residing in West Virginia.
5. POWELL and POST are the named inventors on U.S. Patent 5,887,591 (hereinafter The '591 Patent").

JURISDICTION AND VENUE

6. This Complaint arises under the Federal Declaratory Judgment Act (28 U.S.C. § 2201) and the patent laws of the United States, specifically, it is an action arising under the acts of Congress relating to Patents 35 U.S.C. Sections 271, 281, et. seq. This Court has jurisdiction over the subject matter of this action pursuant to 28 U.S.C. § 1338(a) relating to original jurisdiction with respect to patents, and pursuant to 28 U.S.C. § 1331 for a federal question arising under the laws of the United States.
7. Venue properly lies in this district pursuant to 28 U.S.C. § 1391(b)(2); Defendants'

wrongful assertion of a patent they knew or should have known to be invalid occurred, in substantial part, in this venue. Upon information and belief, both POWELL and POST are subject to personal jurisdiction in this judicial district. Upon information and belief, Defendants' exclusive licensee does business in this district on an ongoing and systematic basis and both Defendants' and their licensee attempted to enforce the improperly obtained patent in this district. Plaintiff's damage from Defendants' tort occurred in this jurisdiction.

FACTS COMMON TO ALL COUNTS

8. The use of stock 'Ankle Foot Orthosis' (AFO's) and multi-purpose AFO's as night splints potentially curative to the plantar fasciitis condition was discovered in the mid to late 1980's.
9. The seminal article on the use of night splints "The Use of Night Splints for Treatment of Recalcitrant Plantar Fasciitis" was published in Foot & Ankle, Vol. 12, #3, December 1991.
10. AFO's to be used in connection with the treatment of plantar fasciitis were brought to market by several major manufacturers of orthopedic goods in the mid 1990's.
11. Upon information and belief, Orthomedics advertised and sold its "Stretch and Heel Splint" since at least early 1995 or before. That AFO contained "metatarsal foam pads for additional stretch on the Plantar Fascia." Exhibit A.

12. Upon information and belief, the “Universal Plantar Fasciitis Orthosis” by Orthomerica Products Inc., which features a standard AFO with “foam wedges” to increase the plantar fasciitis stretch, was advertised and offered for sale in 1995.
Exhibit B.
13. Upon information and belief, POWELL and POST as doctors, lecturers and writers in the field were familiar with the extant literature on the subject and with the products on the market.
14. Defendants knew or should have known that the ‘591 Patent was invalid based on the products available in the marketplace prior to their application, the existing publications and/or existing patents.
15. Upon information and belief, the Provisional Application, Serial No. 60/035,055, upon which the ‘591 Patent is based, was filed in January 1997, more than one (1) year after the advertising and sales of the Orthomedics and Orthomerica AFO’s featuring toe wedges for treatment of plantar fasciitis.
16. Upon information and belief, POWELL and POST exclusively licensed Alimed, Inc. under the ‘591 Patent.
17. Upon information and belief, said exclusive licensee, actively markets its orthopedic products in Florida, on an ongoing, systematic basis.
18. In January 2001, F.L.A. received a letter from President of Alimed, Inc., claiming infringement of the ‘591 Patent by the HEALWELL Night Splint. Exhibit C.

19. President of F.L.A. promptly responded, asserting that the use of a toe wedge is disclosed in prior art which pre-dates the '591 Patent. Exhibit D. F.L.A. asked that they be advised within 14 days if the assertion of the '591 Patent was to be maintained. No further response occurred.
20. Defendants were on further notice of the invalidating prior art as a result of F.L.A.'s letter to Alimed.
21. In January 2004, some of F.L.A.'s distributors received phone calls from POWELL and POST'S attorneys seeking information on the manufacturer of the HEALWELL Night Splint, the president's name and the address. This information was provided. Exhibit E.
22. Notwithstanding Defendants' knowledge that F.L.A. is the manufacturer and supplier of the HEALWELL Night Splints, Defendants sent F.L.A.'s dealers and distributors cease and desist letters asserting infringement of the '591 Patent in April 2004. Composite Exhibit F.
23. Defendants' contact of F.L.A.'s dealers and distributors is in bad faith given that Defendants knew or should have known about the invalidating prior art.
24. This contact of dealers and distributors rather than the known source of the allegedly infringing product is a harassment tactic engineered to interfere with F.L.A.'s relationships with its retailers and distributors.
25. The cease and desist letters demanded that the distributors cease and desist

immediately and provide an accounting of sales and inventory.

26. The letters stated that if the distributors did not respond within two (2) weeks of the date of the letter “we will advise our client to take all available action to remedy your past infringement and enjoin all future infringement under the ‘591 Patent.”
27. The letters also purport to learn the identity of the manufacturer although that information was previously provided.
28. F.L.A. Orthopedics itself did not receive such a cease and desist letter, although the Defendants were well aware that F.L.A. is the manufacturer of the HEALWELL Night Splint and had all necessary contact information.
29. As a direct result of Defendants’ letters to F.L.A.’s distributors, F.L.A. had to undertake to indemnify said distributors in the event of litigation.
30. As a result of the most recent cease and desist letters, F.L.A. has a current, real apprehension that Defendants will file suit against it.

**COUNT I
DECLARATORY JUDGMENT FOR
PATENT INVALIDITY/NON-INFRINGEMENT**

31. F.L.A. ORTHOPEDICS alleges and incorporates by reference, as if fully set forth herein, all of the allegations contained in paragraphs 1 - 30 of the Complaint.
32. By letters to F.L.A. ORTHOPEDICS’ dealers and distributors, dated April 19,

2004, Defendants, though their attorneys, charged that F.L.A. ORTHOPEDICS' sales of its HEALWELL Night Splint infringe U.S. Patent 5,887,591 (hereinafter the "'591 Patent").

33. Said letters conclude with a threat to "take all available action to remedy [the] past infringement and enjoin all future infringement under the '591 Patent" should F.L.A. Orthopedics's distributors fail agree to cease and desist within two (2) weeks of the date of the letter.
34. Plaintiff has a current, real apprehension and belief that Defendants will file suit against it and/or its retailers in the near future if F.L.A. ORTHOPEDICS continues to manufacture and sell the HEALWELL Night Splint.
35. As a result of Defendants' allegations contained in the April 19, 2004 letters, an actual controversy now exists regarding the validity and/or infringement of the '591 Patent.
36. Patent 5,887,591 is invalid for failing to meet one or more of the conditions of patentability specified in Title 35 of the U.S. Code.
37. Defendants' Patent is pre-dated by publications and goods in the market place at least one year before Defendants' application for patent.
38. No claims of the '591 Patent can be validly construed to be infringed by F.L.A. ORTHOPEDICS' HEALWELL Night Splint, which is the equivalent of the earlier market predecessors heretofore mentioned.

WHEREFORE, Plaintiff, F.L.A. ORTHOPEDICS requests that judgement be entered against POWELL and POST and in F.L.A. ORTHOPEDICS' favor as follows:

(A) Declaring that United States Patent No. 5,887,591 is invalid and void in law;

(B) Declaring that United States Patent No. 5,887,591 is, as to each of the claims therein, not infringed by the F.L.A. ORTHOPEDICS' HEALWELL Night Splint.

(C) Awarding reasonable attorney's fees pursuant to 35 U.S.C. 285;

(D) Any other relief and awards that this Court may deem just and equitable.

COUNT II PATENT MISUSE

39. F.L.A. ORTHOPEDICS alleges and incorporates by reference, as if fully set forth herein, all of the allegations contained in paragraphs 1 - 30 of the Complaint.

40. F.L.A. had a business relationship with its distributor Advanced Brace concerning the sale of the HEALWELL Night Splint.

41. Defendants knew or should have known that the '591 Patent is invalid based on prior art, products on the market and publications available over one (1) year prior to Defendants' filing date.

42. Defendants wrongfully asserted the '591 Patent against F.L.A.'s distributor.

43. As a result of Defendants' unjustified threats to its distributor, Plaintiff was forced to commit to indemnify the distributor.

44. The unlawful, inequitable and intentional actions of Defendants may continue to be ongoing as F.L.A. has numerous distributors and dealers and F.L.A. has no adequate remedy at law to prevent future interference with business relationships.

WHEREFORE, Plaintiff, F.L.A. ORTHOPEDICS requests that judgement be entered against POWELL and POST and in F.L.A. ORTHOPEDICS' favor as follows:

(A) Enjoin Defendants from further contacting F.L.A. Orthopedics dealers and distributors with assertions of patent infringement.

(B) Requiring Defendants to issue a letter of retraction to counteract the effects of the April 19, 2004 letter send to dealers and distributors of F.L.A.

(C) Any other relief and awards that this Court may deem just and equitable, including trebled monetary damages should Plaintiff begin to suffer monetary losses as a result of Defendants' actions

COUNT III DECLARATORY JUDGMENT OF ESTOPPEL

45. F.L.A. ORTHOPEDICS alleges and incorporates by reference, as if fully set forth herein, all of the allegations contained in paragraphs 1 - 28 of the Complaint.

46. The Defendants through misleading conduct, led F.L.A. to reasonably infer that the Defendants did not intend to enforce the '591 Patent after the January 2001 correspondence.

47. F.L.A. relied on the silence following F.L.A.'s demand for a response within two weeks to the January 2001 letter.

48. Due to its reliance, F.L.A. will be materially prejudiced in that its profits from sales of the HEALWELL Night Splint have increased in the last three and a half years.

49. WHEREFORE, Plaintiff, F.L.A. ORTHOPEDICS requests that judgement be entered against POWELL and POST and in F.L.A. ORTHOPEDICS' favor as follows:

(A) Declaring that Defendants are estopped from pursuing their infringement claim against F.L.A. Orthopedics and its distributors.

(B) Any other relief and awards that this Court may deem just and equitable.

TRIAL BY JURY IS DEMANDED OF ALL ISSUES TO TRIABLE

Respectfully submitted,



Lee Anne LeBlanc, Esquire

Fla. Bar No. 985,414

LAW OFFICE OF LEE ANNE LEBLANC

1835 E. Hallandale Beach Blvd. #344

Hallandale, Fl. 33009

Telephone: (954) 646-1175

Fax Line: (954) 927-6077

e-mail: ipfirm@aol.com

S i m p l i c i t y

STRETCH AND HEEL SPLINT

Orthomedics' Stretch and Heel is the ideal splint for alleviating Plantar Fasciitis, Achilles Tendinitis and other lower extremity overuse injuries. Easy to put on and adjust, it simplifies treatment with unique features like:

Convenient, adjustable, velcro stretch straps — no tools needed.

- Metatarsal foam pads for additional stretch on the Plantar Fascia.
- Variable stretch adjustment allows total ankle flexibility.
- The most efficient healing at the lowest cost.

"For sub-acute and chronic injuries, daily use of the Stretch and Heel Splint, several minutes to overnight, resolved discomfort and disability."

*Michael D. Allison, M.D., M.P.H.
Valley Orthopedic Associates
Renton, Washington 98055*

Available in S/M and M/L, the Stretch and Heel Splint fits either foot — and comes with Orthomedics' guaranteed quality, fast turnaround and outstanding service to simplify your life as well. Call Orthomedics, the largest, most experienced rehabilitation products company in the country

— where the art of patient caring is simply the best: 800-733-6999.

ORTHOMEDICS

180 North San Gabriel Boulevard, Pasadena, California
P.O. Box 5030 91107-0030, USA
Phone 818-796-8733 Fax: 818-796-9919



Stretch & Heel Night Splint

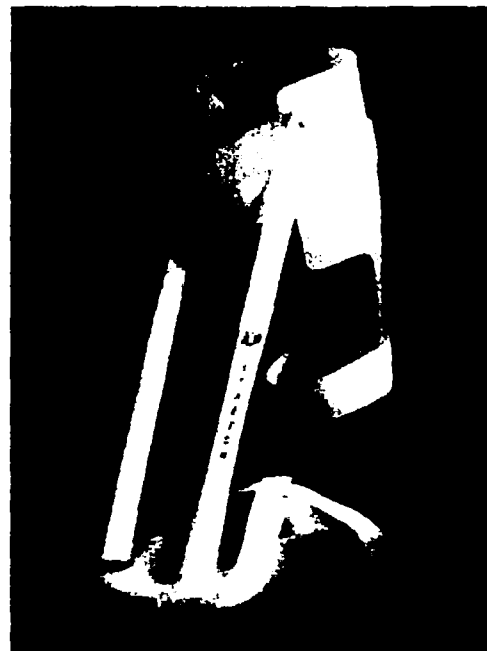
Orthomedics Stretch & Heel Night Splint, developed for the patient with Plantar Faciitis, is made to help alleviate this condition, as well as other lower extremity overuse injuries. The splint design places a consistent stretch on the soft tissue of the calf, achilles, and plantar fascia. The physiology of tendon/soft tissues show healing may occur more efficiently under slight tension. Flexibility also improves, reducing risk factors common to re-injury.

Indications

- o Plantar Fasciitis – acute to chronic states
- o Calf strains/tight calf muscles – acute to recurrent episodes
- o Achilles Tendinitis – sub-acute and chronic conditions
- o Post-operative contractures or stiffness

Features

- o 10 degrees of dorsiflexion built into splint with the ability to adjust the amount of stretch desired
- o Foam buttresses can be added to maximize Plantar Fascia stretch
- o Lightweight, comfortable to wear
- o Stretch velcro positioning straps secure splint to leg
- o Available in two sizes, fit both male & female
- o Optional T-bar assembly, attaches to bottom of foot plate to control rotation
- o Comes complete with two foam buttresses and adhesive-backed velcro to secure buttresses to foot plate
- o Also available in a neutral (90 degree) design



Stretch & Heel Night Splint & Foam Buttresses

Model	Size	Ladies' Shoe Sizes	Men's Shoe Sizes
4J0271	Small/Medium	Up to size 9	Up to size 8
4J0272	Medium/Large	9 1/2 and larger	8 1/2 and larger
4J0276	T-Bar Assembly (one size)		
6M0860	1 1/8" Foam Wedge Pad		
6M0861	1 1/8" Half Circle Foam Pad		

Your Local Distributor is:

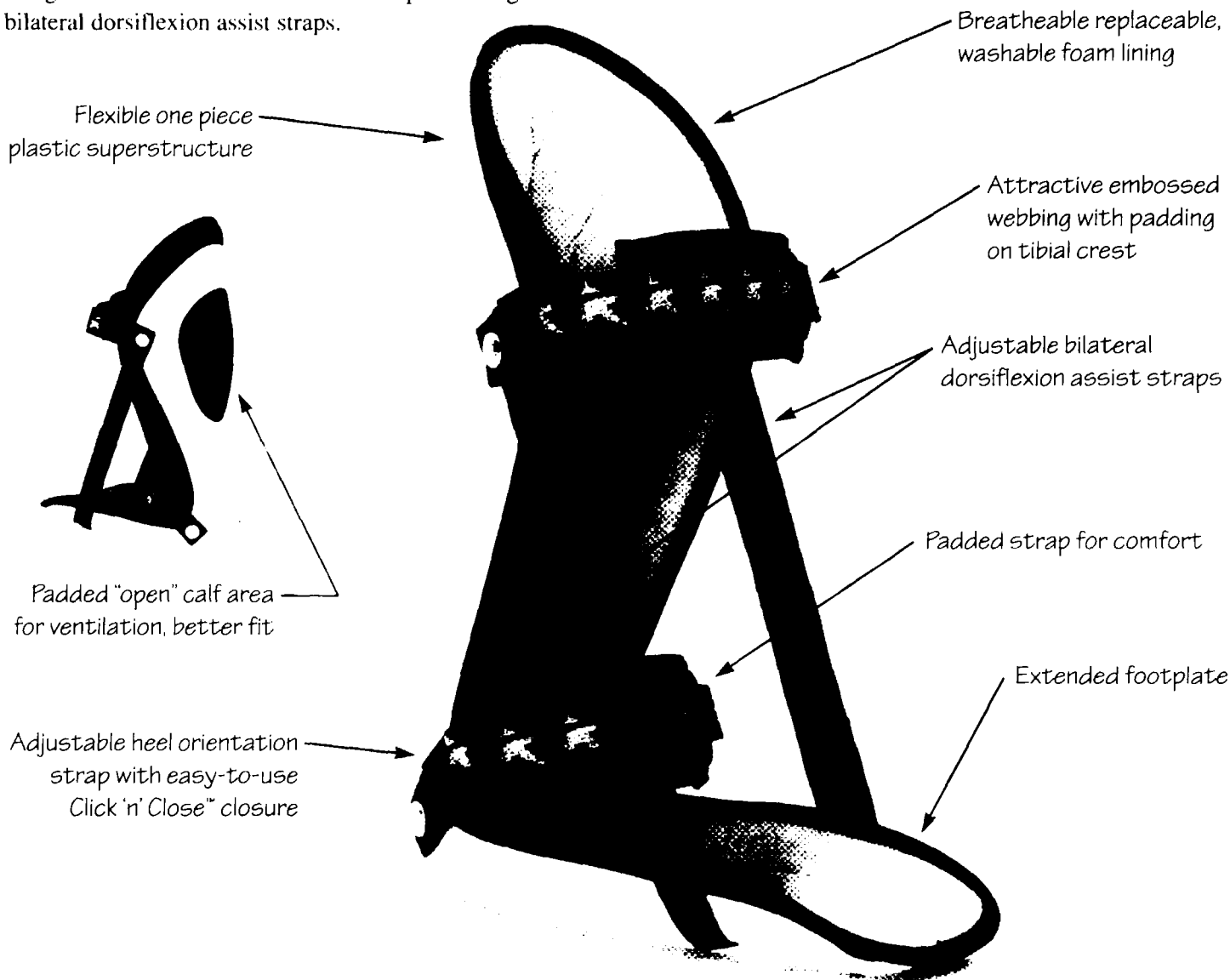
52704



Designed for maximum effectiveness, patient comfort and compliance, the Universal Plantar Fasciitis Orthosis (*UFO*[™]) incorporates a removable, washable Coolfoam[™] liner that actively wicks moisture away from the skin for enhanced hygiene.

UFO[™]
UNIVERSAL PLANTAR FASCIITIS ORTHOSIS

The *UFO*[™] is built with approximately 5° dorsiflexion, which can then be increased to the desired degree through the foam wedges included with each orthosis and positioning of the bilateral dorsiflexion assist straps.



UNIVERSAL SIZING - FITS LEFT OR RIGHT

Size	Model No.	Shoe Size	Brace Height
Small	3620	Men 5-7, Women -6	13"
Medium	3621	Men 7 1/2-10, Women 6 1/2+	14"
Large	3622	Men 10 1/2+	15"

For replacement liners add .01 suffix, (e.g. 3620.01)

ORTHOMERICA[®]
PRODUCTS, INC.

CALIFORNIA

800.637.4500

Fax 800.637.4501

FLORIDA

800.446.6770

Fax 800.638.9259

E-mail: orthomer@ix.netcom.com

<http://www.orthomerica.com>

PLAINTIFF'S
EXHIBIT





297 High Street
Dedham, MA 02026

January 8, 2001

Mr. Slautterback
President
FLA Orthopedics, Inc.
2881 Corporate Way
Miramar, FL 33027

Re: US Patent #588 7591

Dear Mr. Slautterback:

I have noticed in a recent issue of Biomechanics News that you are offering a Plantar Fasciitis Night Splint that seems to incorporate a toe wedge. This letter is to advise you that AliMed is the exclusive licensee of US Patent #588 7591. Please note that the subject patent covers the use of a toe wedge in conjunction with a night splint.

It would appear that there might be some conflict with this patent and your product as advertised in Biomechanics Magazine. It is AliMed's policy to protect its patents' rights vigorously.

Also, we are very aware of the extreme costs of litigation in today's environment.

Therefore, before turning this matter over to our intellectual property attorneys, I would be pleased to discuss the matter with you personally to see if we can resolve the issue.

May I hear from you within fourteen days of the date of this letter in order to mitigate any further action.

Sincerely,

Julian H. Cherubini
President

JHC/jmf



F·L·A
— ORTHOPEDICS —
INC.

January 17, 2001

Mr. Julian H. Cherubini
Alimed® inc.
297 High Street
Dedham, MA 02026

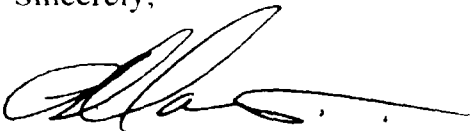
Dear Mr. Cherubini:

This is in regard to your letter of January 8, 2001 suggesting that FLA Orthopedics infringes your U.S. Patent 5887591.

FLA performed a patent review prior to producing its night splint product. The use of a toe wedge is disclosed in much of the prior art which pre-date your position. See Stano Patent 5799659 as but one example. Further, we are aware of product(s) on the market utilizing similar wedges to ours which pre-date your patent as well.

Please advise within fourteen (14) days that you contemplate no action against FLA Orthopedics, Inc., in this matter.

Sincerely,




E.G. Slautterback
President

cc: Lee Anne LeBlanc, Esquire



DocOrtho.com

Confidential Memo

Date: January 26, 2004
To: File
From: Charles J Plesher 
Subject: Telephone Call Regarding Night Splint Patent Infringement
cc: E. G. Slaughterback - FLA Orthopedics, Inc.

On Tuesday morning, January 13, 2004, Judy picked up a telephone message from a woman named Lynn at (304) 368-2022 asking for information on the HealWell Night Splint. When Judy returned the call, she was asked the following:

Who manufactures the HealWell Night Splint? Judy replied FLA Orthopedics, Inc.

Name and address for the presidents of FLA Orthopedics, Inc. and DocOrtho.com

At this point Judy asked the woman why she needed this information and was told that she was calling regarding a patent infringement. Judy placed the call on hold, told me about it and I picked up the call. I asked how I could be of assistance. She said that she was asked to obtain the name and address of the presidents of DocOrtho.com and other companies that were selling the HealWell Night Splint. This information was needed because of a patent infringement. I told her that we did not manufacture the product, just distributed it. She said that she was given a list of companies to call by her boss. She asked if I was the president of DocOrtho.com. I replied that I was the General Manager. She asked for the spelling of my name and to confirm my mailing address. She said that a letter would be sent regarding a patent infringement related to this product. I asked if she could share the patent number that was being infringed. She told me that this information was in her boss's office and the door was locked. I asked for the name of the law firm and was told Jackson Kelly LP. I asked where she was located and was told Fairmont, WV. She asked if I knew the name of the president of FLA Orthopedics and the address. I gave her Jerry's name and the corporate address in Miramar. I asked if she could provide me with any other information regarding this matter and was told that a letter from her boss would follow.

When I hung up the phone I noticed that it was just before noon (lunchtime). I waited till just after 1:00 and called Jerry to fill him in on the phone call.



1000 TECHNOLOGY DRIVE, SUITE 1310 • FAIRMONT, WV 26554 • TELEPHONE: 304-368-2000 • TELECOPIER: 304-368-2020
www.jacksonkelly.com

WRITER'S DIRECT DIAL
(304) 284-4109
WRITER'S E-MAIL ADDRESS
clondon@jacksonkelly.com

April 19, 2004

CERTIFIED MAIL – RETURN RECEIPT REQUESTED #7002 0510 0000 8102 7872

Advanced Brace
1619 W. Irving Blvd., Ste. 2
Irving, TX 75061-7226

Re: U.S. Patent No. 5,887,591

Dear Sir/Madam:

Our clients, William Post and Mark Powell, recently learned that your company is making, offering for sale and/or selling foot orthotic restraints which include all of the elements of many of the claims of, and therefore infringe, their U.S. Patent No. 5,887,591 (the “591 Patent”), a copy of which is enclosed. Also enclosed are copies from the websites www.ankle-foot.com and www.bracesupport.com showing some of these infringing products manufactured and/or sold by your company.

Specifically, your company's products appear to infringe many if not all of the Claims of the '591 Patent directed to a foot orthotic restraint that retains the foot and phalanges in a predetermined dorsiflexion position and a method for treatment of recalcitrant plantar fasciitis. The broadest claims of the patent are Claim 1, for the product, and Claim 18, for the method, each of which is recited below:

Claim 1: A restraint for retaining a generally planar foot in a predetermined dorsiflexion position comprising:

- a foot plate;
- a lifting member located atop said foot plate; and
- means for attaching said foot plate to an underside of a foot;

wherein said lifting member fixedly positions toes of the foot at a greater slope than the generally planar underside of the foot.

Claim 18: The method for treatment of recalcitrant plantar fasciitis comprising the steps of:

- placing a lifting member on a foot plate;
- strapping said foot plate to a bottom of a foot; and

Advance Brace
April 19, 2004
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- varying a degree of dorsiflexion of metatarsalphalangeal joints by placing differently sized said lifting members on said foot plate;

wherein said lifting member fixedly positions toes of the foot at a greater slope than the generally planar underside of the foot.

From the pictures on the webpages, it is clear that your company's products include all of the elements of Claim 1 of the '591 Patent, and therefore infringe the broadest claim of the patent. Furthermore, by selling these products to consumers, the company is inducing infringement of the patent as the consumer, in using your company's products, engages in each of the steps of the method claimed in Claim 18 of the '591 Patent. Many if not all of the remaining claims which are dependent on Claim 1 of the '591 Patent are similarly infringed by your company's products.

Title 35 of the United States Code, Section 271, defines the infringement of a patented invention as encompassing any of the following actions:

- (a) . . . whoever without authority makes, uses, offers to sell, or sells any patented invention, within the United States, or imports into the United States any patented invention during the term of the patent therefor, infringes the patent.
- (b) Whoever actively induces infringement of a patent shall be liable as an infringer.
- (c) Whoever offers to sell or sells within the United States or imports into the United States a component of a patented machine, manufacture, combination, or composition, or a material or apparatus for use in practicing a patented process, constituting a material part of the invention, knowing the same to be especially made or especially adapted for use in an infringement of such patent, and not a staple article or commodity of commerce suitable for substantial non-infringing use, shall be liable as a contributory infringer. . . .
- (f) (1) Whoever without authority supplies or causes to be supplied in or from the United States all or a substantial portion of the components of a patented invention, where such components are uncombined in whole or in part, in such manner as to actively induce the combination of such components outside of the United States in a manner that would infringe the patent if such combination occurred within the United States, shall be liable as an infringer.
- (2) Whoever without authority supplies or causes to be supplied in or from the United States any component of a patented invention that is especially made or especially adapted for use in the invention and not a staple article or commodity of commerce

Advance Brace
April 19, 2004
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suitable for substantial noninfringing use, where such component is uncombined in whole or in part, knowing that such component is so made or adapted and intending that such component will be combined outside of the United States in a manner that would infringe the patent if such combination occurred within the United States, shall be liable as an infringer. . . .

Title 35, Section 281 of the United States Code grants each patentee the right and remedy of a civil action for infringement of his patent, which includes the right to enjoin an infringer (§ 283), and the right to receive from the infringer compensatory damages (no less than a reasonable royalty) plus interest and costs, subject to trebling (§ 284), and in exceptional cases, attorneys' fees (§ 285).

We demand that your company immediately cease and desist from further infringement of our clients' patent. Furthermore, we demand a complete accounting of all infringing products sold by your company, and an accounting of all such products still in inventory. Also, if your company is obtaining these products from another source, you must identify the source so our client can take appropriate action.

If we do not hear from you by May 3, 2004, we will advise our client to take all available action to remedy your past infringement and enjoin all future infringement under the '591 Patent.

Sincerely,

Eric H. London

Enclosures

Plantar Fasciitis Night Splint



The HealWell Night Splint can be used for the following conditions:
Plantar Fasciitis, Achilles
Tendinitis, Plantarflexion
Contractures, Heel Spurs,
Equinus Conditions, Pronation
Syndromes, Muscle Tightening
and Runner's Cramp

The HealWell Night splint is designed to comfortably position the foot in a controlled amount of dorsiflexion to provide a gentle stretch to the plantar fascia and Achilles Tendon. This gentle stretch helps reduce the muscle contracture, inflammation and associated pain. It has also been clinically proven to reduce symptoms of plantar fasciitis.

The HealWell Plantar Fasciitis Night Splint should not be used in the following conditions:

- Plantarflexion Contracture Greater than 10 degrees
- Uncontrollable, Severe Plantarflexion Spasticity
- Weight Bearing Activities

Features of the Night Splint

- Comfortably positions the foot in a controlled amount of dorsiflexion (0°-10°)
- Adjustable bilateral dorsiflexion straps
- Easy push lock buckles
- Three strategically placed comfortable padded straps
- Removable foam wedge provides additional toe extension
- Removable C3 liner with Orthowick to help wick moisture into the Microban foam inner layer
- Strong Kydex plastic helps prevent torquing at critical areas
- liner is treated with Microban Antimicrobial Protection, an agent that is part of the liner's molecular structure and helps to provide continuous control over the growth of certain odor and stain causing bacteria, yeast and fungi
- Lightweight, low-profile
- Made of spring-action plastic with ventilated calf area to allow for comfort and breathability



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WRITER'S DIRECT DIAL
(304) 284-4109
WRITER'S E-MAIL ADDRESS
elondon@jacksonkelly.com

April 19, 2004

CERTIFIED MAIL – RETURN RECEIPT REQUESTED #7002 0510 0000 8102 7797

American Orthopedic Supports
21000 Boca Rio Road, Ste A-16
Boca Raton, FL 33433

Re: U.S. Patent No. 5,887,591

Dear Sir/Madam:

Our clients, William Post and Mark Powell, recently learned that your company is making, offering for sale and/or selling foot orthotic restraints which include all of the elements of many of the claims of, and therefore infringe, their U.S. Patent No. 5,887,591 (the “591 Patent”), a copy of which is enclosed. Also enclosed are copies from the websites: www.plantarfasciitisbrace.com and www.americanorthopedics.com showing some of these infringing products manufactured or sold by your company.

Specifically, your company’s products appear to infringe many if not all of the Claims of the '591 Patent directed to a foot orthotic restraint that retains the foot and phalanges in a predetermined dorsiflexion position and a method for treatment of recalcitrant plantar fasciitis. The broadest claims of the patent are Claim 1, for the product, and Claim 18, for the method, each of which is recited below:

Claim 1: A restraint for retaining a generally planar foot in a predetermined dorsiflexion position comprising:

- a foot plate;
- a lifting member located atop said foot plate; and
- means for attaching said foot plate to an underside of a foot;

wherein said lifting member fixedly positions toes of the foot at a greater slope than the generally planar underside of the foot.

Claim 18: The method for treatment of recalcitrant plantar fasciitis comprising the steps of:

- placing a lifting member on a foot plate;
- strapping said foot plate to a bottom of a foot; and



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- varying a degree of dorsiflexion of metatarsalphalangeal joints by placing differently sized said lifting members on said foot plate;

wherein said lifting member fixedly positions toes of the foot at a greater slope than the generally planar underside of the foot.

From the pictures on the webpages, it is clear that your company's products include all of the elements of Claim 1 of the '591 Patent, and therefore infringe the broadest claim of the patent. Furthermore, by selling these products to consumers, the company is inducing infringement of the patent as the consumer, in using your company's products, engages in each of the steps of the method claimed in Claim 18 of the '591 Patent. Many if not all of the remaining claims which are dependent on Claim 1 of the '591 Patent are similarly infringed by your company's products.

Title 35 of the United States Code, Section 271, defines the infringement of a patented invention as encompassing any of the following actions:

- (a) . . . whoever without authority makes, uses, offers to sell, or sells any patented invention, within the United States, or imports into the United States any patented invention during the term of the patent therefor, infringes the patent.
- (b) Whoever actively induces infringement of a patent shall be liable as an infringer.
- (c) Whoever offers to sell or sells within the United States or imports into the United States a component of a patented machine, manufacture, combination, or composition, or a material or apparatus for use in practicing a patented process, constituting a material part of the invention, knowing the same to be especially made or especially adapted for use in an infringement of such patent, and not a staple article or commodity of commerce suitable for substantial non-infringing use, shall be liable as a contributory infringer. . . .
- (f) (1) Whoever without authority supplies or causes to be supplied in or from the United States all or a substantial portion of the components of a patented invention, where such components are uncombined in whole or in part, in such manner as to actively induce the combination of such components outside of the United States in a manner that would infringe the patent if such combination occurred within the United States, shall be liable as an infringer.
- (2) Whoever without authority supplies or causes to be supplied in or from the United States any component of a patented invention that is especially made or especially adapted for use in the invention and not a staple article or commodity of commerce

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suitable for substantial noninfringing use, where such component is uncombined in whole or in part, knowing that such component is so made or adapted and intending that such component will be combined outside of the United States in a manner that would infringe the patent if such combination occurred within the United States, shall be liable as an infringer. . . .

Title 35, Section 281 of the United States Code grants each patentee the right and remedy of a civil action for infringement of his patent, which includes the right to enjoin an infringer (§ 283), and the right to receive from the infringer compensatory damages (no less than a reasonable royalty) plus interest and costs, subject to trebling (§ 284), and in exceptional cases, attorneys' fees (§ 285).

We demand that your company immediately cease and desist from further infringement of our clients' patent. Furthermore, we demand a complete accounting of all infringing products sold by your company, and an accounting of all such products still in inventory. Also, if your company is obtaining these products from another source, you must identify the source so our client can take appropriate action.

If we do not hear from you by May 3, 2004, we will advise our client to take all available action to remedy your past infringement and enjoin all future infringement under the '591 Patent.

Sincerely,

Eric H. London

Enclosures

The JS-44 civil cover sheet and the information contained herein neither replace nor supplement the filing and service of pleadings or other papers as required by law, except as provided by local rules of court. This form, approved by the Judicial Conference of the United States in September 1974, is required for the use of the Clerk of Court for the purpose of initiating the civil docket sheet. (SEE INSTRUCTIONS ON THE REVERSE OF THE FORM.)

FLA ORTHOPEDICS, INC.,
a Florida Corporation

Mark W. Powell, an individual
and William R. Post, an individual

COUNTY OF RESIDENCE OF FIRST LISTED DEFENDANT _____
(IN U.S. PLAINTIFF CASES ONLY)

MAGISTRATE JUDGE
GARBER

304-368 2000

LEE ANNIE LEBLANC, FSW
1835 E. Holladay Blvd. Blvd. # 344
Holladay, F.L. 33009

ERIC H. LORCHEN | JACKSON KELLY PLLC
1000 TECHNOLOGY DRIVE #1310
FOUNTAIN, IN. 46055-4

(d) CIRCLE COUNTY WHERE ACTION AROSE: DADE, MONROE, BROWARD, PALM BEACH, MARTIN, ST. LUCIE, INDIAN RIVER, OKEECHOBEE, HIGHLANDS

(PLACE AN X IN ONE BOX ONLY)

☐ 2 U.S. Government Defendant ☐ 4 Diversity
(Indicate Citizenship of Parties)

III. CITIZENSHIP OF PRINCIPAL PARTIES (PLACE AN ☒ IN ONE BOX FOR PLAINTIFF
(For Diversity Cases Only) AND ONE BOX FOR DEFENDANT)

	PTF	DEF		PTF	DEF
Citizen of This State	<input checked="" type="checkbox"/>	<input type="checkbox"/>	Incorporated or Principal Place of Business In This State	<input checked="" type="checkbox"/>	<input type="checkbox"/>

Citizen of Another State ☐ 2 ☒ 2 Incorporated ~~and Principal Place~~ of Business In Another State ☐ 5 ☐ 5

Citizen or Subject of a ☐ U.S. ☐ Foreign Nation ☐ 6 ☐ 6
Foreign Country

(PLACE AN "X" IN ONE BOX ONLY)

☒ 1 Original Proceeding ☐ 2 Removed from State Court ☐ 3 Remanded from Appellate Court ☐ 4 Reinstated or Reopened ☐ 5 Transferred from another district (specify) ☐ 6 Multidistrict Litigation ☐ 7 Magistrate Judgment

A CONTRACT	A TORTS	FORFEITURE/PENALTY	A BANKRUPTCY	A OTHER STATUTES	
<input type="checkbox"/> 110 Insurance <input type="checkbox"/> 120 Marine <input type="checkbox"/> 130 Miller Act <input type="checkbox"/> 140 Negotiable Instrument <input type="checkbox"/> 150 Recovery of Overpayment & Enforcement of Judgment <input type="checkbox"/> 151 Mediate Act <input type="checkbox"/> 152 Recovery of Defaulted Student Loans <input type="checkbox"/> 153 Recovery of Overpayment of Veterans' Benefits <input type="checkbox"/> 160 stockholders' Suits <input type="checkbox"/> 190 Other Contract <input type="checkbox"/> 195 Contract Enforcement Act	PERSONAL INJURY <input type="checkbox"/> 310 Airplane <input type="checkbox"/> 315 Airplane Product Liability <input type="checkbox"/> 320 Assault, Libel & Slander <input type="checkbox"/> 330 Federal Employees' Liability <input type="checkbox"/> 340 Marine <input type="checkbox"/> 345 Marine Product Liability <input type="checkbox"/> 350 Motor Vehicle <input type="checkbox"/> 355 Motor Vehicle Product Liability <input type="checkbox"/> 360 Other Personal Injury	PERSONAL INJURY <input type="checkbox"/> 362 Personal Injury Med. Malpractice <input type="checkbox"/> 365 Personal Injury Product Liability <input type="checkbox"/> 368 Asbestos, Personal Injury Product Liability PERSONAL PROPERTY <input type="checkbox"/> 370 Other Fraud <input type="checkbox"/> 371 Trusts & Wills <input type="checkbox"/> 380 Other Personal Property Damage <input type="checkbox"/> 385 Property Damage Product Liability	<input type="checkbox"/> 610 Agriculture <input type="checkbox"/> 620 Other Food & Drug <input type="checkbox"/> 625 Drug Related Seizure of Property 21 USC 881 <input type="checkbox"/> 630 Liquor Laws <input type="checkbox"/> 640 R.R. & Truck <input type="checkbox"/> 650 Airline Regs. <input type="checkbox"/> 660 Occupational Safety Health <input type="checkbox"/> 690 Other A LABOR <input type="checkbox"/> 710 Fair Labor Standards Act <input type="checkbox"/> 720 Labor Union Relations <input type="checkbox"/> 730 Labor Union Relations National Labor Relations Act <input type="checkbox"/> 740 Railway Labor Act <input type="checkbox"/> 790 Other Labor Litigation A <input type="checkbox"/> 791 Emp't. Ret. Inc. Security Act	<input type="checkbox"/> 422 Appeal 28 USC 158 <input type="checkbox"/> 423 Withdrawal 28 USC 157 A PROPERTY RIGHTS <input type="checkbox"/> 820 Copyright <input checked="" type="checkbox"/> 830 Patent <input type="checkbox"/> 840 Trademark B SOCIAL SECURITY <input type="checkbox"/> 861 S.A. 1954 <input type="checkbox"/> 862 S.A. Federal 907 <input type="checkbox"/> 863 DIWC DIWW 405eq <input type="checkbox"/> 864 SSID Title IV <input type="checkbox"/> 865 ESQ 405eq FEDERAL TAX SUITS <input type="checkbox"/> 870 Taxes (U.S. Plaintiff or Defendant) <input type="checkbox"/> 871 IRS Third Party 26 USC 7609	<input type="checkbox"/> 400 State Reapportionment <input type="checkbox"/> 410 Antitrust <input type="checkbox"/> 430 Banks and Banking <input type="checkbox"/> 450 Commerce/ICC Rates/etc <input type="checkbox"/> 460 Deportation <input type="checkbox"/> 470 Racketeer Influenced and Corrupt Organizations <input type="checkbox"/> 810 Selective Service <input type="checkbox"/> 850 Securities Commodities Exchange <input type="checkbox"/> 875 Customer Challenge 12 USC 3410 <input type="checkbox"/> 891 Agricultural Acts <input type="checkbox"/> 892 Economic Stabilization Act <input type="checkbox"/> 893 Environmental Matters <input type="checkbox"/> 894 Energy, Allocation Act <input type="checkbox"/> 895 Freedom of Information Act <input type="checkbox"/> 900 Appeal of Fee Determination under Equal Access to Justice <input type="checkbox"/> 950 Constitutionality of State Statutes <input type="checkbox"/> 890 Other Statutory Actions A OR B
A REAL PROPERTY	A CIVIL RIGHTS	PRISONER PETITIONS			
<input type="checkbox"/> 210 Land Encroachment <input type="checkbox"/> 220 Eminent Domain <input type="checkbox"/> 230 Rent Lease & Easement <input type="checkbox"/> 240 Torts to Land <input type="checkbox"/> 245 Tort Product Liability <input type="checkbox"/> 290 All Other Real Property	<input type="checkbox"/> 441 Voting <input type="checkbox"/> 442 Employment <input type="checkbox"/> 443 Housing Accommodations <input type="checkbox"/> 444 Welfare <input type="checkbox"/> 440 Other Civil Rights	<input type="checkbox"/> 510 Motion to Vacate Sentence HABEAS CORPUS: <input type="checkbox"/> 530 General <input type="checkbox"/> 535 Death Penalty <input type="checkbox"/> 540 Mandamus & Other <input type="checkbox"/> 550 Civil Rights <input type="checkbox"/> 555 Prison Condition			

VI. CAUSE OF ACTION (CITE THE U.S. CIVIL STATUTE UNDER WHICH YOU ARE FILING AND WRITE BRIEF STATEMENT OF CAUSE OF ACTION. DO NOT CITE JURISDICTIONAL STATUTES UNLESS DIVERSITY.)

28 USC 2201 and 28 USC 1338(a)

LENGTH OF TRIAL
via 5 days estimated (for both sides to try entire case)

Declaratory Judgment for Patent Invalidity

CHECK IF THIS IS A **CLASS ACTION**
☐ UNDER F.R.C.P. 23

CHECK YES only if demanded in complaint:

JURY DEMAND: ☒ YES ☐ NO

JUDGE

DOCKET NUMBER

DATE _____ SIGNATURE OF ATTORNEY OF RECORD _____

5 | 6 | 0 4

FOR OFFICE USE ONLY

RECEIPT # 2017 AMOUNT 10 APPLYING IEP- _____ JUDGE _____ MAG JUDGE _____