

UNITED STATES DISTRICT COURT
SOUTHERN DISTRICT OF INDIANA
INDIANAPOLIS DIVISION

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INDIANA MILLS &)
MANUFACTURING, INC., and)
DAVE KALER)

Plaintiffs,)

CIVIL ACTION NO.

vs.)

TRITON BOAT COMPANY, L.P.)

Defendant.)

1:04-CV-0371 SEB - VSS

COMPLAINT FOR DECLARATORY JUDGMENT

The Plaintiffs, Indiana Mills & Manufacturing, Inc. (“IMMI”) and Dave Kaler, for their Complaint against the Defendant, Triton Boat Company, L.P. (“Defendant”), allege and state:

ALLEGATIONS COMMON TO ALL COUNTS

Parties and Jurisdiction

1. IMMI is a corporation organized under the laws of the State of Indiana and having its principal place of business in Westfield, Indiana.

2. Dave Kaler (“Kaler”) is an employee of IMMI and is a citizen of Indiana. As an IMMI employee, Kaler has an obligation to assign to IMMI any and all rights in any inventions created in whole or part by him during the scope of his employment.

3. On information and belief, Defendant is a limited partnership organized under the laws of the State of Tennessee and doing business in the United States, including the State of Indiana.

4. This action arises under the patent laws of the United States, 35 U.S.C. § 1 *et seq.*, and seeks a declaration of rights pursuant to the Federal Declaratory Judgment Act, 28 U.S.C. § 2201 *et seq.* to include correction of inventorship under 35 U.S.C. § 256.

5. The amount in controversy exceeds the sum of \$75,000, exclusive of interest and costs.

6. This Court has subject matter jurisdiction over this Complaint pursuant to 28 U.S.C. §§ 1331, 1332, 1338, 1367 and 2201.

7. Venue in this district is proper pursuant to 28 U.S.C. §§ 1391 and 1400.

The Source of the Controversy

8. IMMI develops, manufactures, and sells a wide variety of safety devices, including web belts and retractors for use with web belts.

9. One such retractor is model number 53541-B made by Indiana Marine Company (“IMCO”), a Division of IMMI (IMMI as used hereinafter refers to IMMI alone, and/or IMMI and IMCO collectively).

10. Defendant manufactures and sells boats, which include IMMI retractors.

11. Sometime in early 1999, a representative of Defendant asked IMMI to supply webbing for a strap handle for use on Defendant’s boats.

12. On or about April 1, 1999, Defendant faxed to IMMI a drawing representing a web belt attached at one end to a rotary retractor and at the other end to a handle for use with a boat. The drawing included written dimensions.

13. Kaler, an IMMI employee at the time, added comments to the right side of the drawing and also drew in the additional feature of a "web guide" before faxing the drawing back to Defendant on or about April 5, 1999.

14. On or about May 17, 1999, Defendant added to Kaler's return facsimile further comments and dimensions.

15. On or about June 22, 1999, U.S. Patent Application Number 09/338,201 for a "Retractable Handle For Marine Craft" was filed naming Defendant's Vice President, Paul J. Rieger, as the sole inventor. The application specifically cited IMCO's retractor number 53451-B, and described and claimed a web guide member. Defendants neither informed IMMI of the patent application, nor named any of IMMI's/IMCO's employees, including at least Kaler, as inventors.

16. The 09/338,201 application issued as United States Patent Number 6,109,200 (the "'200 patent") on or about August 29, 2000.

17. On or about August 20, 2002, Defendant filed a reissue patent application seeking to broaden the original claims of the '200 patent. On or about November 11, 2003, the United States Patent and Trademark Office (the "PTO") issued United States Patent RE 38,302 (the "'302 patent"). At least claims 7 and 15 of the '302 patent claim a "guide."

18. On information and belief, Defendant is the recorded assignee of all rights, title and interest in the '302 patent.

19. On or about January 22, 2004, Defendant's patent counsel sent to IMMI and its patent counsel a cease-and-desist letter demanding, among other things, that IMMI cease making, using or selling a device that some of the claims of the '302 patent allegedly cover.

20. On or about February 11, 2004, IMMI's patent counsel replied to the cease-and-desist letter. This reply attached a copy of the May 17, 1999, return facsimile and requested that Defendant proceed to name Kaler as a co-inventor of the '302 patent.

21. In a letter dated February 18, 2004, Defendant's patent counsel restated the cease-and-desist demands and stated that if Defendant could not disprove that Kaler is an inventor, then Defendant would file with the U.S. Patent and Trademark Office a disclaimer of all "claims that contain a reference to a web guide."

COUNT I - DECLARATORY JUDGMENT OF INVENTORSHIP/OWNERSHIP

22. IMMI and Kaler incorporate paragraphs 1-21 as if fully restated herein.

23. There exists an actual controversy between the parties, including whether Kaler should be an inventor of the '302 patent and whether IMMI should be a rightful joint owner of the '302 patent by virtue of Kaler's inventive contributions to the '302 patent and his on-going obligation to assign his patent rights to IMMI.

24. Based upon the parties' dispute as to whether Kaler is a joint inventor and at least in part on Defendant's threats to disclaim the claims that contain subject matter invented by Kaler, IMMI has a reasonable apprehension that Defendant will attempt to disclaim at least claims 7 and 15 of the '302 patent in an attempt to divest Kaler and thereby IMMI of ownership rights in the '302 patent, thereby causing irreparable harm without adequate remedy at law.

25. The omission of Kaler from the '302 patent arose without any deceptive intent on the part of Kaler.

26. By virtue of drawing the guide on Defendant's drawing, Kaler, and by assignment IMMI, are entitled to a determination that Kaler is an inventor on the '302 patent and that IMMI is an assignee and co-owner of the '302 patent.

COUNT II - DECLARATORY JUDGMENT OF NON-INFRINGEMENT

27. IMMI incorporates paragraphs 1-21 as if fully restated herein.

28. Based upon Defendant's cease-and-desist demands, and its threatened further action by its patent attorneys, IMMI has a reasonable apprehension that Defendant will attempt to sue IMMI for infringement of the '302 patent.

29. IMMI is entitled to a declaratory judgment that as a co-owner of the '302 patent it cannot be found guilty of infringement.

WHEREFORE, the Plaintiffs, Dave Kaler and Indiana Mills & Manufacturing, Inc., respectfully request the Court to award the following relief:

1. That the Court declare, pursuant to 35 U.S.C. § 256 and in accordance with 35 U.S.C. §§ 101, 111, and 116, that Kaler be named a joint inventor of the '302 patent;

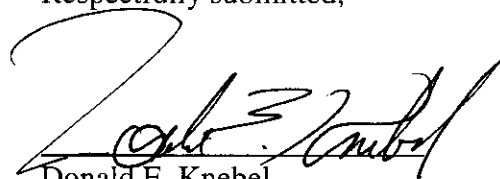
2. That the Court enter an order mandating that the '302 patent be corrected to reflect Kaler as an inventor;

3. That the Court declare that IMMI is an assignee and co-owner of the '302 patent;

4. That the Court enter an order mandating that the '302 patent be corrected to reflect IMMI as an assignee and co-owner;

5. That the Court declare that, as a co-owner of the '302 patent, IMMI cannot be found guilty of infringement of the '302 patent;
6. That Defendant be enjoined from taking any action regarding the '302 patent, including filing in the United States Patent and Trademark Office a disclaimer of any claims of the '302 patent, that is against Kaler's ownership and inventorship interests;
7. That if Defendant has already taken any such action regarding the '302 patent against Kaler's ownership and inventorship interests, including filing in the United States Patent and Trademark Office a disclaimer of any claims of the '302 patent, then Defendant be enjoined immediately to reverse or rescind such action including the immediate withdrawing of any disclaimer of any of the claims of the '302 patent already filed in the United States Patent and Trademark Office;
8. That IMMI be awarded its costs of this action; and
9. That IMMI be awarded all other just and proper relief.

Respectfully submitted,



Donald E. Knebel
Jeffrey A. Michael
James R. Sweeney II
BARNES & THORNBURG
11 South Meridian Street
Indianapolis, IN 46204
(317) 236-1313

Attorneys for Plaintiffs,
Indiana Mills & Manufacturing, Inc.
and Dave Kaler