

IN THE UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF MASSACHUSETTS

05 11001 EFH

ROLLERBLADE USA CORP.,

Plaintiff

v.

INCHWORM, INC.,

Defendant.

C.A. No.

MAGISTRATE JUDGE MBB

RECEIPT # 64286
AMOUNT \$ 250
SUMMONS ISSUED yes
LOCAL RULE 4.1 1
WAIVER FORM 1
MCF ISSUED 1
BY DPTY. CLK. F.O.M
DATE 5/12/05

COMPLAINT FOR DECLARATORY JUDGMENT

This is an action for a declaratory judgment under 28 U.S.C. §§ 2201 and 2202 that U.S. Patent No. 6,883,254, U.S. Patent No. 6,817,116, U.S. Patent No. 6,807,754, U.S. Patent No. 6,574,888, and U.S. Patent No. 6,438,872 (collectively, "the Inchworm Patents") are invalid, unenforceable, and/or not infringed by plaintiff Rollerblade USA Corp. ("Rollerblade").

I. The Parties

1. Rollerblade is a New Jersey corporation with its principal place of business at 3705 Quakerbridge Road, Hamilton, New Jersey. Rollerblade designs, manufactures, and markets in-line roller skates and related products.

2. Defendant Inchworm, Inc. ("Inchworm") is, on information and belief, a Massachusetts corporation with its principal place of business at 850 Albany Street, Boston, Massachusetts.

3. Inchworm is, on information and belief, affiliated with Harry Miller Co., Inc., which, like Inchworm, has its principal place of business at 850 Albany Street, Boston, Massachusetts.

II. The Inchworm Patents

4. Mr. Harry Miller is named as an inventor on each of the Inchworm Patents. According to the information provided on the Inchworm Patents, Mr. Miller is a resident of Weston, Massachusetts.

5. Each of the Inchworm Patents is entitled “Expandable Shoe and Shoe Assemblies” and the claims of all of the Inchworm Patents relate to size-adjustable shoes.

6. All of the Inchworm patents are “related” to each other, i.e., they all claim priority from the same patent application.

7. On information and belief, Inchworm is currently the owner of all right, title, and interest in the Inchworm patents.

III. Jurisdiction and Venue

8. This Court has subject matter jurisdiction in that this action arises under the patent laws of the United States, 35 U.S.C. § 101, *et seq.*, and thus presents a federal question under 28 U.S.C. § 1331 and one in which exclusive jurisdiction exists in federal court under 28 U.S.C. § 1338. This Court also has subject matter jurisdiction under 28 U.S.C. § 1332 because there is complete diversity between the parties and the amount of controversy exceeds \$75,000, exclusive of interest and costs.

9. This Court has personal jurisdiction over Inchworm, Inc. pursuant to Mass. G.L. c. 223A, § 3.

10. Venue is proper in this judicial district under 28 U.S.C. § 1391(b) and (c).

IV. Background

11. On information and belief, Inchworm transacts and does business in the Commonwealth of Massachusetts, including selling goods and services related to the subject matter of the Inchworm Patents.

12. Inchworm has threatened Rollerblade with litigation of the alleged infringement of at least three of the Inchworm patents.

13. On or about November 5, 2004, Inchworm sent a letter to Rollerblade's parent company, specifically alleging that Rollerblade infringes U.S. Patent No. 6,438,872 and U.S. Patent No. 6,574,888. The letter contends that "Rollerblade USA is making and offering for sale size-adjustable in-line skates that infringe Inchworm's US Patents Nos. 6,438,872 and 6,574,888."

14. The parties have had subsequent contacts in which Rollerblade has denied infringement of the Inchworm patents and Inchworm has maintained its position that Rollerblade is infringing at least certain Inchworm patents. For example, on February 1, 2005, Inchworm sent a letter to Rollerblade's counsel, specifically alleging infringement of U.S. Patent No. 6,438,872, U.S. Patent No. 6,574,888, and U.S. Patent No. 6,817,116.

15. On or about April 22, 2005, Inchworm filed a complaint in the U.S. District Court for the Western District of Washington, alleging that entities identified as "Rollerblade, Inc." and "Nordica S.p.A." infringe three of the Inchworm Patents (U.S. Patent No. 6,438,872, U.S. Patent No. 6,574,888, and U.S. Patent No. 6,817,116).

16. On April 25, 2005, U.S. Patent No. 6,883,254 issued.

17. Rollerblade has a reasonable apprehension that Inchworm will file suit against Rollerblade (*i.e.*, "Rollerblade USA Corp.") for infringement of the Inchworm Patents.

18. Rollerblade has a reasonable apprehension that Inchworm will amend the complaint filed in the Western District of Washington to name Rollerblade (*i.e.*, “Rollerblade USA Corp.”) as a defendant.

19. Rollerblade has a reasonable apprehension that Inchworm will file suit against Rollerblade, alleging infringement of U.S. Patent No. 6,883,254, and U.S. Patent No. 6,807,754, which were not identified in the complaint that Inchworm filed against “Rollerblade Inc.” and “Nordica S.p.A.” in the Western District of Washington.

20. An actual controversy exists between the parties with respect to the validity, enforceability and infringement of each of the Inchworm Patents.

21. Rollerblade’s products and services do not infringe any claim of the Inchworm Patents.

22. The Inchworm Patents are invalid for failure to meet the conditions of patentability of 35 U.S.C. § 101, *et seq.*

23. When prosecuting the Inchworm Patents, Inchworm and the inventors misled the United States Patent and Trademark Office (the “PTO”) and failed to disclose material information to the PTO, including but not limited to Inchworm’s failure to disclose the prior art reference U.S. Patent No. 5,678,833 and U.S. Patent No. 5,913,526, both entitled “Adjustable Fit In-Line Skate.” Inchworm failed to disclose material information with the intent of deceiving the PTO.

24. Each of the Inchworm Patents is unenforceable because Inchworm committed inequitable conduct in procuring the Inchworm Patents.

Count I
Declaratory Judgment of Noninfringement
(U.S. Patent No. 6,883,254)

25. Rollerblade incorporates the allegations of the preceding paragraphs as if fully set forth herein.

26. No Rollerblade product or service infringes U.S. Patent No. 6,883,254.

27. An actual and justiciable controversy exists between Rollerblade and Inchworm concerning infringement of U.S. Patent No. 6,883,254.

28. Rollerblade is entitled to a declaration that U.S. Patent No. 6,883,254 is not infringed by any Rollerblade product or service.

Count II
Declaratory Judgment of Invalidity
(U.S. Patent No. 6,883,254)

29. Rollerblade incorporates the allegations of the preceding paragraphs as if fully set forth herein.

30. U.S. Patent No. 6,883,254 is invalid under 35 U.S.C. §§ 101 *et seq.*

31. An actual and justiciable controversy exists between Rollerblade and Inchworm concerning the validity of U.S. Patent No. 6,883,254.

32. Rollerblade is entitled to a declaration that U.S. Patent No. 6,883,254 is invalid.

Count III
Declaratory Judgment of Unenforceability
(U.S. Patent No. 6,883,254)

33. Rollerblade incorporates the allegations of the preceding paragraphs as if fully set forth herein.

34. When prosecuting the 6,883,254 patent, Inchworm and the inventors misled the United States Patent and Trademark Office (the "PTO") and failed to disclose material

information to the PTO, including but not limited to Inchworm's failure to disclose the prior art references U.S. Patent No. 5,678,833 and U.S. Patent No. 5,913,526, both entitled "Adjustable Fit In-Line Skate."

35. Inchworm knew of such information during prosecution of this patent.

36. Inchworm's failure to disclose such material information was with the intent of deceiving the PTO.

37. An actual and justiciable controversy exists between Rollerblade and Inchworm concerning the enforceability of U.S. Patent No. 6,883,254.

38. Rollerblade is entitled to a declaration that U.S. Patent No. 6,883,254 is unenforceable.

Count IV
Declaratory Judgment of Noninfringement
(U.S. Patent No. 6,817,116)

39. Rollerblade incorporates the allegations of the preceding paragraphs as if fully set forth herein.

40. No Rollerblade product or service infringes U.S. Patent No. 6,817,116.

41. An actual and justiciable controversy exists between Rollerblade and Inchworm concerning infringement of U.S. Patent No. 6,817,116.

42. Rollerblade is entitled to a declaration that U.S. Patent No. 6,817,116 is not infringed by any Rollerblade product or service.

Count V
Declaratory Judgment of Invalidity
(U.S. Patent No. 6,817,116)

43. Rollerblade incorporates the allegations of the preceding paragraphs as if fully set forth herein.

44. U.S. Patent No. 6,817,116 is invalid under 35 U.S.C. §§ 101 *et seq.*

45. An actual and justiciable controversy exists between Rollerblade and Inchworm concerning the validity of U.S. Patent No. 6,817,116.

46. Rollerblade is entitled to a declaration that U.S. Patent No. 6,817,116 is invalid.

Count VI
Declaratory Judgment of Unenforceability
(U.S. Patent No. 6,817,116)

47. Rollerblade incorporates the allegations of the preceding paragraphs as if fully set forth herein.

48. When prosecuting the 6,817,116 patent, Inchworm and the inventors misled the United States Patent and Trademark Office (the “PTO”) and failed to disclose material information to the PTO, including but not limited to Inchworm’s failure to disclose the prior art references U.S. Patent No. 5,678,833 and U.S. Patent No. 5,913,526, both entitled “Adjustable Fit In-Line Skate.”

49. Inchworm knew of such information during prosecution of this patent.

50. Inchworm’s failure to disclose such material information was with the intent of deceiving the PTO.

51. An actual and justiciable controversy exists between Rollerblade and Inchworm concerning the enforceability of U.S. Patent No. 6,817,116.

52. Rollerblade is entitled to a declaration that U.S. Patent No. 6,817,116 is unenforceable.

Count VII
Declaratory Judgment of Noninfringement
(U.S. Patent No. 6,807,754)

53. Rollerblade incorporates the allegations of the preceding paragraphs as if fully set forth herein.

54. No Rollerblade product or service infringes U.S. Patent No. 6,807,754.

55. An actual and justiciable controversy exists between Rollerblade and Inchworm concerning infringement of U.S. Patent No. 6,807,754.

56. Rollerblade is entitled to a declaration that U.S. Patent No. 6,807,754 is not infringed by any Rollerblade product or service.

Count VIII
Declaratory Judgment of Invalidity
(U.S. Patent No. 6,807,754)

57. Rollerblade incorporates the allegations of the preceding paragraphs as if fully set forth herein.

58. U.S. Patent No. 6,807,754 is invalid under 35 U.S.C. §§ 101 *et seq.*

59. An actual and justiciable controversy exists between Rollerblade and Inchworm concerning the validity of U.S. Patent No. 6,807,754.

60. Rollerblade is entitled to a declaration that U.S. Patent No. 6,807,754 is invalid.

Count IX
Declaratory Judgment of Unenforceability
(U.S. Patent No. 6,807,754)

61. Rollerblade incorporates the allegations of the preceding paragraphs as if fully set forth herein.

62. When prosecuting the 6,807,754 patent, Inchworm and the inventors misled the United States Patent and Trademark Office (the "PTO") and failed to disclose material

information to the PTO, including but not limited to Inchworm's failure to disclose the prior art references U.S. Patent No. 5,678,833 and U.S. Patent No. 5,913,526, both entitled "Adjustable Fit In-Line Skate."

63. Inchworm knew of such information during prosecution of this patent.

64. Inchworm's failure to disclose such material information was with the intent of deceiving the PTO.

65. An actual and justiciable controversy exists between Rollerblade and Inchworm concerning the enforceability of U.S. Patent No. 6,807,754.

66. Rollerblade is entitled to a declaration that U.S. Patent No. 6,807,754 is unenforceable.

Count X
Declaratory Judgment of Noninfringement
(U.S. Patent No. 6,574,888)

67. Rollerblade incorporates the allegations of the preceding paragraphs as if fully set forth herein.

68. No Rollerblade product or service infringes U.S. Patent No. 6,574,888.

69. An actual and justiciable controversy exists between Rollerblade and Inchworm concerning infringement of U.S. Patent No. 6,574,888.

70. Rollerblade is entitled to a declaration that U.S. Patent No. 6,574,888 is not infringed by any Rollerblade product or service.

Count XI
Declaratory Judgment of Invalidity
(U.S. Patent No. 6,574,888)

71. Rollerblade incorporates the allegations of the preceding paragraphs as if fully set forth herein.

72. U.S. Patent No. 6,574,888 is invalid under 35 U.S.C. §§ 101 *et seq.*

73. An actual and justiciable controversy exists between Rollerblade and Inchworm concerning the validity of U.S. Patent No. 6,574,888.

74. Rollerblade is entitled to a declaration that U.S. Patent No. 6,574,888 is invalid.

Count XII
Declaratory Judgment of Unenforceability
(U.S. Patent No. 6,574,888)

75. Rollerblade incorporates the allegations of the preceding paragraphs as if fully set forth herein.

76. When prosecuting the 6,574,888 patent, Inchworm and the inventors misled the United States Patent and Trademark Office (the “PTO”) and failed to disclose material information to the PTO, including but not limited to Inchworm’s failure to disclose the prior art references U.S. Patent No. 5,678,833 and U.S. Patent No. 5,913,526, entitled “Adjustable Fit In-Line Skate.”

77. Inchworm knew of such information during prosecution of this patent.

78. Inchworm’s failure to disclose such material information was with the intent of deceiving the PTO.

79. An actual and justiciable controversy exists between Rollerblade and Inchworm concerning the enforceability of U.S. Patent No. 6,574,888.

80. Rollerblade is entitled to a declaration that U.S. Patent No. 6,574,888 is unenforceable.

Count XIII
Declaratory Judgment of Noninfringement
(U.S. Patent No. 6,438,872)

81. Rollerblade incorporates the allegations of the preceding paragraphs as if fully set forth herein.

82. No Rollerblade product or service infringes U.S. Patent No. 6,438,872.

83. An actual and justiciable controversy exists between Rollerblade and Inchworm concerning infringement of U.S. Patent No. 6,438,872.

84. Rollerblade is entitled to a declaration that U.S. Patent No. 6,438,872 is not infringed by any Rollerblade product or service.

Count XIV
Declaratory Judgment of Invalidity
(U.S. Patent No. 6,438,872)

85. Rollerblade incorporates the allegations of the preceding paragraphs as if fully set forth herein.

86. U.S. Patent No. 6,438,872 is invalid under 35 U.S.C. §§ 101 *et seq.*

87. An actual and justiciable controversy exists between Rollerblade and Inchworm concerning the validity of U.S. Patent No. 6,438,872.

88. Rollerblade is entitled to a declaration that U.S. Patent No. 6,438,872 is invalid.

Count XV
Declaratory Judgment of Unenforceability
(U.S. Patent No. 6,438,872)

89. Rollerblade incorporates the allegations of the preceding paragraphs as if fully set forth herein.

90. When prosecuting the 6,438,872 patent, Inchworm and the inventors misled the United States Patent and Trademark Office (the "PTO") and failed to disclose material

information to the PTO, including but not limited to Inchworm's failure to disclose the prior art references U.S. Patent No. 5,678,833 and U.S. Patent No. 5,913,526, both entitled "Adjustable Fit In-Line Skate."

91. Inchworm knew of such information during prosecution of this patent.

92. Inchworm's failure to disclose such material information was with the intent of deceiving the PTO.

93. An actual and justiciable controversy exists between Rollerblade and Inchworm concerning the enforceability of U.S. Patent No. 6,438,872.

94. Rollerblade is entitled to a declaration that U.S. Patent No. 6,438,872 is unenforceable.

Request for Relief

WHEREFORE, Rollerblade respectfully requests that this Court:

1. declare that none of Inchworm Patents is infringed (1) by any product made, used, imported, offered for sale, or sold by Rollerblade or (2) by any service performed by or on behalf of Rollerblade, or offered for sale or sold by Rollerblade;
2. declare that each of the Inchworm Patents is invalid
3. declare that each of the Inchworm Patents is unenforceable;
4. enter judgment in favor of Rollerblade on each of its claims;
5. award Rollerblade its attorneys' fees and costs in this action; and

6. grant to Rollerblade such further relief as is just and warranted under the circumstances.

ROLLERBLADE USA CORP.

By its attorneys,

A handwritten signature in black ink, appearing to read 'Matthew B. Lowrie', is written over a horizontal line.

Dated: May 13, 2005

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