

UNITED STATES DISTRICT COURT
NORTHERN DISTRICT OF FLORIDA
PENSACOLA DIVISION

WILLIAM J. SANDERS,
an individual,

Plaintiff,

v.

CASE NO. 3:07cv402mcr/md

BAY STATE CABLE TIES,
LLC, a Florida limited liability
company,

Defendants.

**COMPLAINT FOR CORRECTION OF INVENTORSHIP OF PATENT OR,
IN THE ALTERNATIVE, DECLARATORY JUDGMENT**

COMES NOW the Plaintiff, WILLIAM J. SANDERS ("SANDERS"), pursuant to 28 U.S.C. §2201, 35 U.S.C. §100 et.seq., and Rule 3, Federal Rules of Civil Procedure, by and through his undersigned attorney, and files this Complaint seeking the correction of inventorship of U.S. Patent No. 7,062,820 or, in the alternative, declaratory relief against BAY STATE CABLE TIES, LLC ("BAY STATE"), and in support thereof alleges as follows:

JURISDICTION AND VENUE

1. Plaintiff, WILLIAM J. SANDERS, is an individual residing at 845 Kellaire Drive, Destin, Florida 32540.
2. Defendant BAY STATE CABLE TIES, LLC is a Florida limited liability company with its principal place of business at 5680 John Givens Road, Crestview, Florida 32539.

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3. This action arises under 35 U.S.C. § 256 and 28 U.S.C. §2201.
4. Jurisdiction is proper in this court pursuant to 28 U.S.C. §1131 as this is a civil action arising under the laws of the United States.
5. Venue is proper in this court pursuant to 28 U.S.C. §1391 because, *inter alia*, the Defendant resides in this District and the events giving rise to this cause of action occurred primarily in this District.

GENERAL FACTUAL ALLEGATIONS

6. BAY STATE is the record owner of U.S. Patent No. 7,062,820 (“the ‘820 Patent”). The ‘820 Patent claims and describes a hand-removable tote box lid retainer. The patented tote box lid retainer includes a strap with an enclosure. The enclosure has a tooth-engaging pawl which engages teeth on the strap in a reverse pull-out resistant manner. A tab is provided on one side of the strap which can be pulled to separate the strap into two pieces. To facilitate the separation, a channel of reduced material thickness is provided near the tab. The channel continues across the strap toward the side of the strap opposite the tab. A copy of the ‘820 Patent is attached hereto as Exhibit A.
7. The ‘820 Patent claims the benefit of the filing date of Provisional Patent Application Serial No. 60/542,652 filed on February 6, 2004 (“the PPA”). A copy of the PPA is attached hereto as Exhibit B.
8. The PPA named Plaintiff SANDERS and Thomas R. Davidson as inventors. SANDERS was correctly named as an inventor of the PPA.
9. Although the patent application which resulted in the issuance of the ‘820 Patent describes and claims the same invention described in the PPA, SANDERS was not

named as an inventor of the '820 Patent. Instead, the patent application resulting in the '820 Patent named Robert L. Oestriech ("Oestriech") and Thomas R. Davidson as inventors.

10. SANDERS materially contributed to the invention, conception, and reduction to practice of the invention claimed in the '820 Patent. SANDERS is an inventor of the subject matter claimed in the '820 Patent.

11. Robert L. Oestriech did not contribute to the invention, conception, or reduction to practice of the invention claimed in the '820 Patent. Thus, Oestriech is not an inventor of the subject matter claimed in the '820 Patent.

12. The failure to name SANDERS as an inventor in the '820 Patent was not the result of any deceptive intent of SANDERS.

13. On or about March of 2007, BAY STATE began threatening SANDERS and at least one of SANDERS' customers with patent infringement lawsuits if they continued to sell tie straps which, in BAY STATE's view, infringed the '820 Patent. A copy of one of the threatening correspondences is attached as Exhibit C.

14. BAY STATE threats have seriously impacted SANDERS' relationship with his customers and have tarnished the reputation of SANDERS' business.

15. SANDERS is under a reasonable apprehension that he may be sued for patent infringement by BAY STATE. Accordingly, there presently exists a real controversy as to whether SANDERS should be named as an inventor of the '820 Patent and/or whether the '820 Patent is invalid.

16. SANDERS has been damaged, both economically and reputationally, by the failure to name SANDERS as an inventor of the '820 Patent.

COUNT I

(Correction of Inventorship Under 35 U.S.C. §256)

17. Paragraphs 1-16 above are incorporated herein by reference.

18. The failure to name SANDERS as an inventor of the '820 Patent was an error. This error occurred without the deceptive intent of SANDERS. The '820 Patent is therefore subject to correction to name Plaintiff as an inventor and remove Oestriech as a named inventor of the invention disclosed therein.

WHEREFORE Plaintiff respectfully requests a judgment ordering correction of U.S. Patent No. 7,062,820 and such other relief as the court deems proper and just.

COUNT II


(Declaratory Judgment of Patent Invalidity Under 28 U.S.C. §2201)

19. Paragraphs 1-16 above are incorporated herein by reference.

20. In the alternative to Count I, the failure to name SANDERS as an inventor to the '820 Patent was done knowingly and with deceptive intent by the applicants of the '820 Patent. Inappropriately naming Oestriech as an inventor was likewise done knowingly and with deceptive intent by the applicants of the '820 Patent. The '820 Patent should therefore be found invalid pursuant to 35 U.S.C. §§ 102(f), 116, 256 and 282.

WHEREFORE, Plaintiff respectfully requests in the alternative to the relief sought in Count I, a judgment declaring that U.S. Patent No. 7,062,820 is invalid in its entirety and such other relief as is just and proper.

Dated: September 19th, 2007



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