

AO 120 (Rev. 3/04)

TO: Mail Stop 8 Director of the U.S. Patent and Trademark Office P.O. Box 1450 Alexandria, VA 22313-1450	REPORT ON THE FILING OR DETERMINATION OF AN ACTION REGARDING A PATENT OR TRADEMARK
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In Compliance with 35 U.S.C. § 290 and/or 15 U.S.C. § 1118 you are hereby advised that a court action has been filed to the U.S. District Court, **Western District of New York** on the following Patents or Trademarks:

DOCKET NO. 08-CV-0638C	DATE FILED 8/26/2008	U.S. DISTRICT COURT Western District of New York
PLAINTIFF GIBRALTAR INDUSTRIES, INC., et al.,		DEFENDANT EUROASIA PRODUCTS, INC.
PATENT OR TRADEMARK NO.	DATE OF PATENT OR TRADEMARK	HOLDER OF PATENT OR TRADEMARK
1 7,252,221		
2		
3		"see attached copy of complaint"
4		
5		

In the above--entitled case, the following patent(s)/ trademark(s) have been included:

DATE INCLUDED	INCLUDED BY	<input type="checkbox"/> Amendment <input type="checkbox"/> Answer <input type="checkbox"/> Cross Bill <input type="checkbox"/> Other Pleading
PATENT OR TRADEMARK NO.	DATE OF PATENT OR TRADEMARK	HOLDER OF PATENT OR TRADEMARK
1		
2		"see attached copy of complaint"
3		
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5		

In the above--entitled case, the following decision has been rendered or judgement issued:

DECISION/JUDGEMENT

CLERK	(BY) DEPUTY CLERK	DATE
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Copy 1—Upon initiation of action, mail this copy to Director Copy 3—Upon termination of action, mail this copy to Director
 Copy 2—Upon filing document adding patent(s), mail this copy to Director Copy 4—Case file copy

THE UNITED STATES DISTRICT COURT
WESTERN DISTRICT OF NEW YORK

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GIBRALTAR INDUSTRIES, INC.,)
SOLAR GROUP, INC.,)
)
Plaintiffs,) Case No.
)
- against -) **JURY TRIAL DEMANDED**
)
EUROASIA PRODUCTS, INC.,)
Defendant.)
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COMPLAINT

Plaintiffs Gibraltar Industries, Inc. ("Gibraltar") and Solar Group, Inc. ("Solar") (collectively "Plaintiffs"), by their attorneys, Lippes Mathias Wexler Friedman LLP, for their complaint against Defendant EuroAsia Products, Inc. ("EuroAsia" or "Defendant") allege as follows:

I. PRELIMINARY STATEMENT

1. This is an action for correction of inventorship pursuant to 35 U.S.C. § 256 to substitute the true inventor of the U. S. Patent No. 7,252,221 ("the '221 Patent") and to compel its assignment to Solar, or, in the alternative, for a declaratory judgment of invalidity of the '221 Patent for fraud in the procurement by knowingly and falsely naming as the inventor thereof one who is not, and for breach of contract, fraud, misappropriation of trade secrets, and unjust enrichment.

II. THE PARTIES

2. Plaintiff Gibraltar is a leading manufacturer, processor and distributor of products for the building, industrial, and automotive markets and is located at 3556 Lake Shore Road #100, Buffalo, New York 142191.

3. Plaintiff Solar is and has been at all times relevant to this action a wholly-owned subsidiary of Gibraltar.

4. On information and belief, Defendant is a corporation that does business throughout the United States and has a regular and established place of business at 3956 Town Center Blvd. #166, Orlando, Florida 32837.

III. JURISDICTION AND VENUE

5. This action arises under the Patent Laws of the United States, Title 35, United States Code, and common law. This Court has subject matter and declaratory judgment jurisdiction over this action pursuant to 28 U.S.C. §§ 1331, 1338(a) and 2201, and supplemental jurisdiction over the common law claims under 28 U.S.C. § 1367(a). This Court also has subject matter jurisdiction pursuant to 28 U.S.C. § 1332 based on diversity of citizenship between Plaintiffs and Defendant, the amount in controversy exceeding \$75,000, exclusive of interest and costs.

6. Venue is proper in this district pursuant to 28 U.S.C. § 1391(c) and 1400(b).

7. This Court has personal jurisdiction over Defendant because Defendant regularly transacts business and actively targets customers throughout the State of New York and within this judicial district.

IV. FACTUAL BACKGROUND

8. At least as early as December 6, 2004, Robert Beckman ("Beckman"), a former employee of Home Impression, Inc., a division of Plaintiff Solar, conceived and reduced to practice, in the course of his employment, an invention for a mailbox door restraint, the teachings of which were later disclosed in patent application number 11/241,616, filed on September 30,

2005 ("616 Application") in the name of John M. Bowers ("Bowers"), and in the subsequently issued '221 Patent.

9. The design concepts, teachings and the invention that was later incorporated into and claimed in the '221 Patent by Defendant was disclosed by Beckman to Defendant pursuant to a confidentiality and non-disclosure agreement that had been executed previously in March 1999 between Home Impressions, Inc. and Defendant ("Confidentiality Agreement") and which remained in force and effect at the time Bowers filed the '616 Application.

10. Nevertheless, on September 30, 2005, Bowers, knowing that Beckman and not he was the true inventor thereof, filed the '616 Application in his own name, assigned the '616 Application to EuroAsia, which permitted it to issue as the '221 Patent on August 7, 2007.

11. In June 2006 Gibraltar purchased Home Impressions, Inc., including all of its business and technology know-how, intellectual property and trade secrets, from the owners thereof, Robert Lackey and Robert Lackey Jr. ("the Lackeys").

12. At no time did Bowers or the Defendant obtain the consent or permission of the Lackeys, Home Impressions, Inc. and/or the Plaintiffs to claim any rights in the subject matter of the '616 Application or the '221 Patent.

13. In December of 2007 Plaintiffs received a letter dated November 30, 2007 from the Defendant (the "2007 letter"), announcing the issuance of the '221 Patent and "invited" Plaintiffs to contact Defendant if it was interested in using the '221 Patent or any other of Defendant's patents.

14. Following up on its 2007 letter, in June of 2008, Defendant sent a second letter to Plaintiffs, dated May 30, 2008, entitled "Letter of Invitation to License" (the "2008 letter"). The 2008 letter reminded Plaintiffs of the 2007 letter and stated that "your [Plaintiffs'] company is

enjoying benefits of use from our proprietary intellectual property" and that several of Plaintiffs' mailboxes "utilized" the '221 Patent and "invited" Plaintiffs to take a license under the patent. In so doing, Defendant misappropriated Plaintiffs' invention and trade secrets and then fraudulently and deceptively obtained patent protection for them.

15. Now, Defendant is "inviting" Plaintiffs to take a license from the Defendant for the use of Plaintiffs' own invention.

V. COUNT 1 (CORRECTION OF INVENTORSHIP)

16. Plaintiffs repeat and reallege each and every allegation set forth in Paragraphs 1 through 15 as if fully set forth herein.

17. This claim for equitable relief for the correction of inventorship of the '221 Patent arises pursuant to 35 U.S.C. § 256.

18. Bowers is not the true inventor of the '221 Patent.

19. Home Impressions, Inc.'s former employee Beckman is the first and true inventor of the concept designs, teachings and invention disclosed in the '616 Application and claimed in the '221 Patent.

20. Beckman's invention, which is disclosed in the '616 Application and claimed in the '221 Patent, was conceived and reduced to practice while Beckman was employed by Home Impressions, Inc.

21. Prior to receiving the 2007 letter Plaintiffs were unaware that Defendant had filed the '616 Application and had obtained the '221 Patent.

22. On information and belief, neither Defendant nor Bowers notified the PTO of Beckman's disclosure of the design concepts, teachings and invention disclosed in the '616 Application claimed in the '221 Patent.

23. The '221 Patent must either be declared invalid by reason of its failure to name the true and correct inventor thereon or corrected to name Beckman as the sole and true inventor thereof and the patent assigned to Solar.

VI. COUNT 2 (BREACH OF CONTRACT)

24. Plaintiffs repeat and reallege each and every allegation set forth in Paragraphs 1 through 23 as if fully set forth herein.

25. Pursuant to the Confidentiality Agreement between Home Impressions, Inc. and Defendant, Defendant was not to use or disclose to any third party confidential information disclosed by the Lackeys, their employees, agents, business entities, affiliates or any of its successors or assigns for a period of five (5) years following the transmittal of such confidential information,

26. Since the execution of the Confidentiality Agreement, the Lackeys, their employees, his agents, his business entities, affiliates, successors and assigns have and continue to conduct business with the Defendant.

27. On or about December 2004, pursuant to the Confidentiality Agreement, Beckman disclosed to Bowers the design concepts, teachings, and invention claimed in the '221 Patent.

28. On September 30, 2005 Defendant filed the '616 Application with the PTO which later issued as the '221 Patent.

29. The '221 Patent contains Plaintiffs' design concepts, teachings and invention that had been disclosed to the Defendant by Beckman and subsequently misappropriated by Defendant for its own use and benefit in breach of the Confidentiality Agreement.

30. On information and belief, some time prior to June 2007, Defendant submitted mailbox designs that incorporated Bowers' concept and invention to the United States Postal Service ("USPS"). These misappropriated submissions were made without the knowledge or consent of Plaintiffs and solely for Defendant's use and benefit. On information and belief, as of June 2007, the USPS has approved four of Defendant's mailboxes, and Defendant is actively marketing these misappropriated designs.

31. Defendant's aforementioned acts of misappropriation, disclosure of Plaintiffs' confidential information and breach of contract continues.

32. Plaintiffs have been significantly damaged by Defendant's breach of contract.

VII. COUNT 3 (MISAPPROPRIATION OF TRADE SECRETS)

33. Plaintiffs repeat and reallege each and every allegation set forth in Paragraphs 1 through 32 as if fully set forth herein.

34. On or about December 2008 Beckman's invention and Home Impression, Inc.'s confidential business information, design concepts and trade secrets were disclosed to Defendant pursuant to the Confidentiality Agreement.

35. Defendant misappropriated Plaintiffs' confidential business information, design concepts, and trade secrets by disclosing Beckman's invention to the PTO and other third parties.

36. At no time did Home Impressions, Inc. or Plaintiffs consent to Defendant's use of their confidential business information, design concepts and trade secrets and Plaintiffs had no knowledge of Defendant's misappropriation until it received the 2007 letter.

37. Defendant willfully misappropriated Plaintiffs' confidential business information, design concepts and trade secrets and Defendant has been unjustly enriched by such misappropriation.

VIII. COUNT 4 (FRAUD)

38. Plaintiffs repeat and reallege each and every allegation set forth in Paragraphs 1 through 37 as if fully set forth herein.

39. Defendant, with intent to deceive, submitted the '616 Application to the PTO and obtained the '221 Patent in the name of Bowers.

40. At the time of the filing of the '616 Application, Bowers knew that Beckman was in fact the true inventor of the design concepts, teachings and invention disclosed in the '221 Patent and Defendant's certification to the PTO that Bowers was the inventor was false and made to intentionally mislead the PTO.

41. Defendant misrepresented to the PTO the true name of the inventor of the '221 Patent in order to induce the PTO to issue the patent in Bowers' name as inventor.

42. Relying on Defendant's misrepresentation, the PTO did in fact issue the '221 Patent in Bowers' name as inventor.

43. Plaintiffs have been significantly damaged by Defendant's misrepresentations to the PTO.

IX. COUNT 5 (UNJUST ENRICHMENT)

44. Plaintiffs repeat and reallege each and every allegation set forth in Paragraphs 1 through 43 as if fully set forth herein.

45. As an intended, direct, foreseeable and proximate cause of Defendant's wrongful and unjustifiable conduct, Plaintiffs are suffering and will continue to suffer injury as set forth herein, including an impoverishment and/or detriment in the form of lost business opportunities and lost profits.

46. Defendant has and continues to unjustly benefit from the exclusive patent rights unjustly obtained at the expense of Plaintiffs.

47. Plaintiffs are entitled to the return, by way of disgorgement, restitution, divestiture, and/or other equitable remedy, of such monies which unjustly enriched Defendant.

X. COUNT 6 (INVALIDITY OF THE '221 PATENT)

48. Plaintiffs repeat and reallege each and every allegation set forth in Paragraphs 1 through 47 as if fully set forth herein.

49. Defendant has procured the '221 Patent through fraud on the PTO by falsely naming Bowers as the inventor of the inventions disclosed and claimed therein, knowing at all times relevant thereto that Beckman was the sole and true inventor thereof.

50. By reason of Defendant's fraud on the PTO, the '221 Patent is invalid and/or unenforceable by Defendant.

WHEREFORE, Plaintiffs pray for a judgment against Defendant, as follows:

- (a) That the name of the inventor of the '221 Patent be corrected pursuant to 35 U.S.C. § 256 to reflect its true inventor Beckman and the patent be assigned to Solar, or, in the alternative, that the '221 Patent be declared invalid for fraud on the PTO;
- (b) That Defendant pay contract damages to Plaintiffs to an extent to be determined at a later time;
- (c) That Defendant pay actual, restitution, and exemplary damages to Plaintiffs;
- (d) That Defendant pay Plaintiffs' attorneys' fees and costs associated with this action;
- (e) That Defendant pay punitive damages for fraud;
- (f) That Defendant return to Plaintiffs, by way of disgorgement, restitution,

divestiture, and/or other equitable remedy, of such monies which unjustly enriched

Defendant;

(g) That Plaintiffs be granted such other and further relief as the Court may deem just and proper.

DEMAND FOR JURY TRIAL

Pursuant to Rule 38, Fed. R. Civ. P., Plaintiffs hereby demand a trial by jury for all issues triable of right by a jury in this case.

Date: August 26, 2008

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