

IN THE UNITED STATES DISTRICT COURT
FOR THE WESTERN DISTRICT OF WISCONSIN

MICHAEL J. CURL,

Plaintiff,

v.

GLASS MECHANIX,
4881 W. Hacienda Ave., #6
Las Vegas, NV 89118,

Defendant.

ORDER

04-C-218-C

Plaintiff, a resident of Monroe, Wisconsin, has filed this declaratory judgment action brought pursuant to 28 U.S.C. § 2201, seeking a declaration that his patent nos. 6,485,281 and 6,663,371 are valid. Because plaintiff is proceeding without a lawyer, I construe his complaint liberally to include an alternative request for a declaration that defendant's patent no. 5,122,0422 is invalid.

In his complaint, plaintiff alleges that he and the defendants have patented devices for repairing windshield glass. Plaintiff alleges also that defendant has contacted his distributors and is demanding that they stop selling plaintiff's equipment on the ground that plaintiff's patents infringe its patent.

A threshold question in every federal case is whether the plaintiff has made out a "case or controversy" between himself and the defendant within the meaning of Article III. See Warth v. Seldin, 422 U.S. 490, 498 (1975). In patent cases, actions for declaratory judgment are governed by case law from the Federal Circuit rather than the law of the regional circuit courts. Shell Oil Co. v. Amoco Corp., 970 F.2d 885 (Fed. Cir. 1992). Ordinarily, "there is never a need or occasion for . . . a declaration [of patent validity]. Patents are born valid and remain so until proven otherwise." Fromson v. Advance Offset Plate, Inc., 755 F.2d 1549, 1555 (Fed. Cir. 1985). Rather, courts either declare a patent invalid in response to a successful validity challenge or hold that the party challenging validity failed to carry its burden. "A patent should not be declared 'valid' by a court because other challengers may be able to prove invalidity using different evidence." Durango Associates, Inc. v. Reflange, Inc., 843 F.2d 1349, 1356 n.4 (Fed Cir. 1988).

Nevertheless, courts apply a two-part test to determine whether the plaintiff has established an actual controversy in a declaratory judgment suit in a patent case. The complaint must allege facts from which an inference may be drawn that 1) defendant's conduct has created on the part of the plaintiff a reasonable apprehension that the defendant will bring a lawsuit if the plaintiff continues the allegedly infringing activity; and 2) plaintiff has actually produced the device at issue or is prepared to produce the

device at issue. Shell Oil v. Amoco Corp., 970 F.2d at 887.

My tentative view is that plaintiff has alleged sufficient facts to establish an actual controversy. That he has actually produced the allegedly infringing device is evident from his allegation that it is being distributed through his distributors. Moreover, defendants' alleged directives to plaintiff's distributors to cease distributing plaintiff's product on the ground that the product infringes its device are sufficient to create in plaintiff a reasonable apprehension that he will be sued if he continues to distribute the product.

Accordingly, plaintiff should take prompt steps to serve his complaint on the defendant. Under Fed. R. Civ. P. 4(m), a plaintiff has 120 days after filing a complaint in which to serve the defendant. However, that is an outside limit with few exceptions. This court requires that a plaintiff act diligently in moving his case to resolution. If plaintiff acts promptly, he should be able to serve his complaint on the defendant well before the deadline for doing so established in Rule 4.

To help plaintiff understand the procedure for serving a complaint on a corporation, I am enclosing with this memorandum a copy of document titled "Procedure for Serving a Complaint on a Corporation in a Federal Lawsuit." In addition, I am enclosing to plaintiff an extra copy of his complaint and forms he will need to send to the defendant in accordance with the procedures set out in Option 1 of the memorandum.

ORDER

IT IS ORDERED that plaintiff promptly serve his complaint on the defendant corporation and file proof of service of his complaint as soon as service has been accomplished. If, by July 12, 2003, plaintiff fails to submit proof of service of his complaint on the defendant or explain his inability to do so, I will direct plaintiff to show cause why his case should not be dismissed for lack of prosecution.

Entered this 12th day of April, 2004.

BY THE COURT:

BARBARA B. CRABB
District Judge