

UNITED STATES DISTRICT COURT
WESTERN DISTRICT OF NEW YORK

CHAPIN MANUFACTURING, INC.,

Plaintiff,

- vs -

W.W. GRAINGER, INC.,

Defendant.

COMPLAINT

Civil Action No. _____

Jury Trial Demanded

Plaintiff Chapin Manufacturing, Inc. ("Chapin"), by and through its attorneys Jaeckle Fleischmann & Mugel, LLP, as and for its Complaint against the Defendant W.W. Grainger, Inc. ("Grainger") alleges as follows:

PARTIES

1. At all times hereinafter mentioned, Plaintiff Chapin was, and still is, a corporation created under the laws of the State of New York, having a principal place of business in this District at 700 Ellicott Street, Batavia, New York.

2. Upon information and belief, and at all times hereinafter mentioned, Defendant Grainger was and is a corporation created under the laws of the State of Illinois, having a principal place of business located at 100 Grainger Parkway, Lake Forest, Illinois.

NATURE OF ACTION

3. This is an action for patent infringement arising under the patent laws of the United States, 35 U.S.C. § 1 *et seq.*, and for unfair competition under state common and statutory laws by virtue of Defendant Grainger's infringement of certain patents held by Chapin and its associated acts of unfair competition in connection therewith

Patent
D 590,043
D 591,387
D 594,087

D 564,0685
D 431,2795

JURISDICTION AND VENUE

4. Jurisdiction herein is based upon 28 U.S.C. §§ 1331, 1332, 1338, 2201 and 2202, in that (1) this action arises out of the patent laws of the United States, 35 U.S.C. § 1 *et seq.* and/or (2) the plaintiff and defendant are citizens of different states and the amount in controversy herein exceeds \$75,000.00.

5. In particular, and without limitation:

A. Grainger does business in the State of New York and within this District, and is registered with the New York Secretary of State to do so;

B. Grainger has committed acts of patent infringement within this District by selling, distributing, and/or offering to sell or distribute products (as more specifically identified herein) which fall within the scope of the patents-in-suit (as more fully identified below);

C. Grainger owns and operates an interactive website which is directed and available to customers in this District, which offers products for sale within this District (including the products alleged to infringe herein); and

D. Grainger owns and operates a wholesale and/or retail "brick and mortar" sales location within this District at 50 McKesson Parkway, Buffalo, New York and, upon information and belief, in connection therewith has sales representatives, employees, inventory, bank accounts, and other assets located here.

6. In addition to all other legal bases for this Court to exercise personal jurisdiction over Defendant in this action, courts within the State in which this District is located have personal jurisdiction over the Defendant pursuant to NY CPLR 302(a)(i).

7. For these reasons, among others, venue is also proper in this Court pursuant to 28 U.S.C. §§ 1391(b) and (c) and 1400(b).

BACKGROUND

8. Plaintiff Chapin has been and continues to be in the business of, among other things, manufacturing, selling, and distributing compressed air sprayers.

9. Defendant Grainger, upon information and belief, is in the business of, among other things, manufacturing, selling and distributing various industrial supplies, including compressed air sprayers.

10. Chapin, the world's leader in compressed air sprayer technology, has invested substantial money and effort in the features and overall design of its sprayers and their component parts. Chapin actively protects the intellectual property which resides within its sprayers and their component parts, including by the prosecution, issuance, and maintenance of both design and utility patents, and the pursuit of those who infringe thereon.

THE PATENTS-IN-SUIT

11. Plaintiff Chapin is the sole owner and holder of the following United States patents (the "Patents-in-Suit"), which are valid and enforceable and the terms of which are not expired:

A. Design patent D590,043, titled "Sprayer Tank" and issued on April 7, 2009 (the "'043 patent"), a copy of which is annexed hereto as **Exhibit A**.

B. Design patent D591,387, titled "Tank for Backpack Sprayer" and issued on April 28, 2009 (the "'387 patent"), a copy of which is annexed hereto as **Exhibit B**.

C. Design patent D594,087, titled "Sprayer Tank" and issued on June 9, 2009 (the "'087 patent"), a copy of which is annexed hereto as **Exhibit C**.

D. Design patent D564,068S, titled "Shoulder Portion of a Sprayer Tank and Cap" and issued on March 11, 2008 (the "'068 patent"), a copy of which is annexed hereto as **Exhibit D**.

E. Design patent D431,279S, titled "Tank for a Hand Operated Sprayer" and issued on September 26, 2000 (the "'279 patent"), a copy of which is annexed hereto as **Exhibit E**.

GRAINGER'S INFRINGEMENT

12. Chapin has been supplying various of its sprayer models to Grainger, one of the largest industrial supply companies in the world, for Grainger's distribution to end users since at least 1979. Included in the sprayers supplied by Chapin to Grainger for redistribution were Chapin models which fall within the scope of the Patents-in-Suit.

13. In or about August, 2011, Chapin learned that Grainger was offering for sale to its customers exact or substantially similar "knock-offs" of the Chapin sprayers, including sprayers previously supplied by Chapin to Grainger, which included design features claimed in the Patents-in-Suit and selling them under Grainger's "Westward" private label. Even though Grainger had, on or about November 1, 2008, agreed to give Chapin "the opportunity to quote on Products if and when a decision is made to add a private label offering" to Grainger's sprayer product line and Chapin was already making the sprayers being knocked off, Chapin was not given the opportunity to bid on the "Westward" sprayers. A copy of the "November 1, 2008 Agreement" is attached hereto as **Exhibit F**.

14. These "Grainger knock-offs" each include one or more design features that are the subject of at least the following Patents-in-Suit held by Chapin:

Model	Patents
Westward 12U479	US D590,043 S US D591,387 S US D594,087 S
Westward 12U477 Westward 12U472	US D564,068 S US D620,556 S
Westward 12U469 Westward 12U478 Westward 12U480	US Des. 431,279

15. Upon information and belief, these Grainger knock-offs of Chapin sprayers were manufactured at the special direction of Grainger to be identical, or practically identical, copies of Chapin sprayers and their patented design features. Indeed, Grainger went so far as to copy verbatim, in the same font, same colors, and same size the warning labels used by Chapin and affixed them to the Grainger knock-offs. Grainger now advertises its imitation Chapin sprayers side-by-side with genuine Chapin sprayers which Grainger continues to sell and distribute, even using advertising copy Chapin had provided to Grainger for use in connection with Chapin sprayers.

FIRST CAUSE OF ACTION

(Infringement of '043 Patent)

16. Chapin realleges and incorporates by reference the allegations contained in paragraphs 1 through 15 above as if fully set forth herein.

17. Grainger's Westward 12U479 sprayer infringes the '043 patent, as a comparison of the patent's figures and the 12U479 sprayer shows: