

UNITED STATES DISTRICT COURT
SOUTHERN DISTRICT OF FLORIDA

CASE NO:

AMERICAN REGISTRY, LLC,
a Florida Limited Liability Company,

Plaintiff,

v.

CASTLE CONNOLLY MEDICAL LTD.,

Defendant.

COMPLAINT

Plaintiff, AMERICAN REGISTRY, LLC, (“**AMERICAN REGISTRY**” or “**Plaintiff**”), by and through the undersigned counsel, sues the Defendant, CASTLE CONNOLLY MEDICAL LTD. (“**CASTLE CONNOLLY**” or “**Defendant**”), for Breach of Contract and Patent Infringement, and alleges as follows:

NATURE OF CLAIMS/SUBJECT MATTER JURISDICTION

1. This is an action against CASTLE CONNOLLY for patent infringement under the patent laws of the United States, 35 U.S.C. §101, et seq. and for breach of contract.
2. This Court has subject matter jurisdiction over this action pursuant to 28 U.S.C. §§ 1331, 1338, and 1367(a).

THE PARTIES

3. Plaintiff, AMERICAN REGISTRY, is a Florida limited liability company with its principal place of business located at 1020 N.W. 6th Street, Deerfield Beach, Florida 33445.

4. Upon information and belief, Defendant, CASTLE CONNOLLY, is a Delaware limited liability company with its principal place of business located at 42 West 24th Street, 2nd Floor, New York, New York 10010.

PERSONAL JURISDICTION AND VENUE

5. Personal jurisdiction over CASTLE CONNOLLY is properly established in this District because, upon information and belief, CASTLE CONNOLLY has sufficient contacts in the State of Florida, including, but not limited to, in the Southern District of Florida, and has purposefully avails itself of the benefits and protections of the State of Florida by knowingly selling and/or offering to sell infringing products and services or otherwise conducting business in this State, and more specifically, in this District.

6. Personal jurisdiction over CASTLE CONNOLLY is also established in this District pursuant to Florida's Long Arm Statute (Florida Statute §48.193 et. seq.), as, upon information and belief, the tortious acts complained of herein were committed in the State of Florida, including in this District; the property infringed upon is situated in the State of Florida, as discussed in detail hereinafter; the infringing acts were directed at AMERICAN REGISTRY, an entity operating in Florida; and CASTLE CONNOLLY has engaged in substantial activity in Florida.

7. Moreover, the written agreement that forms the basis of the action(s) being brought against CASTLE CONNOLLY herein, entitled *Recognition Program Strategic Partnership Agreement* (the "**Partnership Agreement**"), a copy of which is attached as **Exhibit A**, contains a "Governing Law, Jurisdiction and Venue" clause agreed to by the Parties and provides: (i) the laws of the State of Florida governs the Partnership Agreement; (ii) Palm Beach County, Florida is the exclusive venue for any action arising out of or in connection with the Partnership Agreement; (iii) the Parties consent to personal jurisdiction and venue in Palm Beach County, Florida; and (iv) the

Parties waive any affirmative defenses to Palm Beach County being the exclusive venue and/or having such personal jurisdiction over the Parties.

8. Therefore, the Court's exercise of jurisdiction over CASTLE CONNOLLY does not offend the traditional notions of fair play and substantial justice.

9. Venue is properly established in this District pursuant to 28 U.S.C. §1391(b) as, upon information and belief, DEFENDANT has sufficient contacts in the Southern District of Florida to be deemed to reside in this District and therefore subject to this Court's personal jurisdiction and/or because DEFENDANT has engaged in acts of patent infringement within this District, said acts being the subject of this Complaint. Additionally, as above-mentioned, the Partnership Agreement at issue contains a forum selection clause that governs Palm Beach County, Florida has the exclusive venue for any suits, actions, or proceedings between the Parties arising out of or in connection with the Partnership Agreement, and the Parties waive any affirmative defenses to the contrary.

AMERICAN REGISTRY'S U.S. PATENT

10. On or about June 10, 2008, U.S. Patent No. 7,386,800 (the "**'800 Patent'**") was duly and lawfully issued for methods and systems for producing personalized, customized achievement recognition items (the "**Patented Invention'**"). A copy of the '800 Patent is attached as **Exhibit B.**

11. AMERICAN REGISTRY is the owner by way of assignment of all rights and title in and to the '800 Patent.

12. AMERICAN REGISTRY has never authorized DEFENDANT to make, use, sell, offer to sell, and/or import into the United States, and/or its territories, any personalized, customized achievement recognition items, or methods or systems for producing the same, as recited in the claims of the '800 Patent, or to otherwise practice the Patented Invention.

AMERICAN REGISTRY'S BUSINESS RELATIONSHIP WITH DEFENDANT

13. On or about November 2, 2017, AMERICAN REGISTRY and CASTLE CONNOLLY entered into the *Recognition Program Strategic Partnership Agreement*. See **Ex. A**.

14. As a result of the Partnership Agreement between the Parties, AMERICAN REGISTRY created the entire physical awards display program for CASTLE CONNELLY, including, but not limited to, the design of the award/recognition displays and the marketing campaign for same, including without limitation, the personalized emails to the award recipients.

15. AMERICAN REGISTRY was the exclusive third-party provider for CASTLE CONNOLLY and was responsible for the production and fulfillment for the award/recognition displays, including, but not limited to, the plaques, which CASTLE CONNOLLY did not offer to its award recipients prior to its partnership with AMERICAN REGISTRY.

16. As a result of the commencement of this strategic partnership between the Parties, and pursuant to the Partnership Agreement, specifically the confidentiality provision contained therein, AMERICAN REGISTRY divulged to CASTLE CONNOLLY, amongst other confidential information and trade secrets; (i) its confidential sales and marketing mechanisms, (ii) its carefully worded written communications to award recipients, that are *only* accessible to award recipients and not to anyone else, and (iii) the method to effectively utilize AMERICAN REGISTRY'S intellectual property assets, including the '800 Patent that AMERICAN REGISTRY owns for its technology platform, amongst other methods and processes, for the offer and sale of customized award displays and other personalized recognition products.

17. None of the foregoing confidential information, along with other confidential and proprietary sales techniques, targets, and tangible assets were known to CASTLE CONNOLLY or generally available to CASTLE CONNOLLY prior to the execution of the Partnership Agreement.

18. AMERICAN REGISTRY also shared with CASTLE CONNOLLY the sales results generated by AMERICAN REGISTRY as required by the Partnership Agreement.

19. CASTLE CONNOLLY agreed not to disclose to any outside party any of the confidential and/or proprietary documents and non-public information that related to the Partnership Agreement and to the business operations of AMERICAN REGISTRY to which CASTLE CONNOLLY had gained access to solely pursuant to, or as a result of, the Partnership Agreement. *See Ex. A*, at p. 2, “*Confidentiality*.”

20. Instead of complying with the above-detailed obligation(s), CASTLE CONNOLLY handed the keys of the proverbial AMERICAN REGISTRY’S car to a replacement contractor, Wright’s Media, Inc. (“**Wright’s Media**”), who now, upon information and belief, designs, markets, produces and fulfills the award/recognition display for CASTLE CONNOLLY, using the confidential and/or proprietary information that AMERICAN REGISTRY had disclosed to CASTLE CONNOLLY as a result of the Partnership Agreement.

21. CASTLE CONNOLLY has copied the carefully worded, non-public emails directed to award participants that AMERICAN REGISTRY specifically created for CASTLE CONNOLLY under the terms of the Partnership Agreement, which include the plaques designed by AMERICAN REGISTRY, and now sends the exact same emails and content to its award recipients, which not only violates the confidentiality clause of the Partnership Agreement, but also violates AMERICAN REGISTRY’S ‘800 Patent as detailed below.

DEFENDANT’S INFRINGING ACTIONS

22. Upon information and belief, CASTLE CONNOLLY, has and continues to make, use, sell, offer to sell, and/or import into the United States, and/or its territories, including, but not limited to, within the Southern District of Florida, a personalized, customized achievement recognition item produced via a method and system having an on-line interactive network site

including a personalized network page with a pre-populated list of one or more achievements from which a user can customize and personalize specifications for the personalized, customized achievement recognition item (the “**CASTLE CONNOLLY Method and System**”). For example, attached hereto as **Exhibit C**, are copies of printouts from CASTLE CONNOLLY’S website that are illustrative of a personalized, customized achievement recognition item which may be produced via a method and system having an on-line interactive network site, including a personalized network page with a pre-populated list of one of more achievements from which a user can customize and personalize specifications for the personalized, customized achievement recognition item.

23. The CASTLE CONNOLLY Method and System includes a method and system having an online interactive network site including a personalized network page with a pre-populated list of one or more achievements from which a user can customize and personalize specifications for a personalized, customized achievement recognition item, which encompasses the Patented Invention and infringes the ‘800 Patent.

24. The ‘800 Patent is specifically referenced in the Agreement, thereby placing CASTLE CONNOLLY on actual notice of AMERICAN REGISTRY’S rights. *See Ex. A*, pg. 1.

25. Upon information and belief, despite knowledge of the same, CASTLE CONNOLLY has and continues to infringe the ‘800 Patent in complete deliberate, wanton, and willful disregard of AMERICAN REGISTRY’S rights in and to the ‘800 Patent by making, using, selling, offering to sell, and/or importing into the United States, and/or its territories, a personalized, customized achievement recognition item produced via a method and system having an online interactive network site including a personalized network page with a pre-populated list of one or more achievements from which a user can customize and personalize specifications for the personalized, customized achievement recognition item which encompasses the Patented Invention

and infringes the ‘800 Patent, thereby deriving unlawful gains and profits. CASTLE CONNOLLY’S actions are evidenced by the printouts obtained from two separate personalized network pages that were specifically tailored and targeted to the pre-populated list of achievement recognition items, *i.e.*, “TOP DOCTOR for 5 Years,” and which said personalized, customized achievement recognition item is produced via a method and system having an online interactive network site where the eligible user can customize and personalize specifications for the achievement recognition item. *See Ex. C.*

26. Upon information and belief, CASTLE CONNOLLY will continue to infringe the ‘800 Patent in deliberate, wanton, and willful disregard of AMERICAN REGISTRY’S patent rights and to AMERICAN REGISTRY’S irreparable damage, unless restrained by this Court.

27. CASTLE CONNOLLY’S actions constitute infringement of the ‘800 Patent, directly and/or indirectly, literally and/or under the doctrine of equivalents, and such actions are deliberate, wanton, and willful.

28. Plaintiff has agreed to pay the undersigned attorney a reasonable attorneys’ fee to prosecute this action.

COUNT I – DIRECT INFRINGEMENT OF U.S. PATENT NO. 7,386,800

29. AMERICAN REGISTRY incorporates herein each and every allegation set forth in Paragraphs 1 through 28 of this Complaint, as if fully set forth herein.

30. Upon information and belief, CASTLE CONNOLLY’S aforesaid acts constitute direct infringement of independent claims 1, 9, 17, and 25 of the ‘800 Patent, either literally or under the doctrine of equivalents, pursuant to 35 U.S.C. §271(a).

31. Upon information and belief, CASTLE CONNOLLY had notice of its infringement, therefore, CASTLE CONNOLLY’S infringement of independent claims 1, 9, 17, and 25 of the ‘800 Patent has been willful, wanton, and deliberate.

32. The filing and service of this Complaint serve as actual notice and knowledge of infringement of the '800 Patent on the part of CASTLE CONNOLLY, such that all of CASTLE CONNOLLY'S post-suit infringement of claims 1, 9, 17, and 25 of the '800 Patent is willful, wanton, and deliberate.

33. CASTLE CONNOLLY'S aforesaid acts have caused and will continue to cause great and irreparable injury to AMERICAN REGISTRY, and, upon information and belief, unless said acts are restrained by this Court, they will continue.

34. AMERICAN REGISTRY has no adequate remedy at law.

COUNT II – INDIRECT INFRINGEMENT OF U.S. PATENT NO. 7,386,800

35. AMERICAN REGISTRY incorporates herein each and every allegation set forth in Paragraphs 1 through 28 of this Complaint, as if fully set forth herein.

36. Upon information and belief, CASTLE CONNOLLY'S aforesaid acts constitute indirect infringement of independent claims 1, 9, 17, and 25 of the '800 Patent, either literally or under the doctrine of equivalents, pursuant to 35 U.S.C. §271(b).

37. Upon information and belief, CASTLE CONNOLLY'S aforesaid acts were and continue to be with the specific intent and knowledge of actively inducing end users to produce a personalized, customized achievement recognition item via a method and system having an on-line interactive network site including a personalized network page with a pre-populated list of one or more achievements from which a user can customize and personalize specifications for the personalized, customized achievement recognition item in a manner which results in a direct infringement of claims 1, 9, 17, and 25 of the '800 Patent, either literally or under the doctrine of equivalents

38. Upon information and belief, CASTLE CONNOLLY had notice of its infringement, therefore, CASTLE CONNOLLY'S infringement of independent claims 1, 9, 17, and 25 of the '800 Patent has been willful, wanton, and deliberate.

39. The filing and service of this Complaint serve as actual notice and knowledge of infringement of the '800 Patent on the part of CASTLE CONNOLLY, such that all of CASTLE CONNOLLY'S post-suit infringement of claims 1, 9, 17, and 25 of the '800 Patent is willful, wanton, and deliberate.

40. CASTLE CONNOLLY'S aforesaid acts have caused and will continue to cause great and irreparable injury to AMERICAN REGISTRY, and, upon information and belief, unless said acts are restrained by this Court, they will continue.

41. AMERICAN REGISTRY has no adequate remedy at law.

COUNT III – BREACH OF CONTRACT

42. AMERICAN REGISTRY incorporates herein each and every allegation set forth in Paragraphs 1 through 28 of this Complaint, as if fully set forth herein.

43. On or about November 2, 2017, AMERICAN REGISTRY and CASTLE CONNOLLY entered into the *Recognition Program Strategic Partnership Agreement* (the "**Partnership Agreement**"). *See Ex. A.*

44. As a result of CASTLE CONNOLLY'S execution of the Partnership Agreement, and in furtherance of AMERICAN REGISTRY'S obligation to perform thereunder, AMERICAN REGISTRY shared with CASTLE CONNOLLY its confidential proprietary information and trade secrets, which include, but are not limited to, its intellectual property assets and the method to utilize AMERICAN REGISTRY'S U.S. Patent No. 7,386,800 for the technology platform that was used to offer and sell the personalized recognition items for CASTLE CONNOLLY, proprietary concepts, research results, internal business plans, sales techniques and customer lists that each, on

their own, derive independent economic value and are not generally known nor readily ascertainable by proper means.

45. CASTLE CONNOLLY agreed not to disclose to any outside party any of the foregoing confidential and/or proprietary documents and non-public information that related to the Partnership Agreement and to the business operations of AMERICAN REGISTRY to which CASTLE CONNOLLY had gained access to solely pursuant to, or as a result of, the Partnership Agreement. *See Ex. A*, at p. 2, “*Confidentiality*.”

46. In direct contravention of the Confidentiality clause of the Partnership Agreement, CASTLE CONNOLLY disclosed to an outside party, namely Wright’s Media, the confidential and/or proprietary information and documents of AMERICAN REGISTRY that related to the Partnership Agreement and the business operations of AMERICAN REGISTRY.

47. CASTLE CONNOLLY now markets, through Wright’s Media, its award/recognition displays to award recipients using the carefully worded, non-public emails that AMERICAN REGISTRY specifically created for CASTLE CONNOLLY under the Partnership Agreement, and which was created using AMERICAN REGISTRY’S intellectual property assets, including the ‘800 Patent.

48. The foregoing actions and/or conduct by CASTLE CONNOLLY constitutes a material breach under the Partnership Agreement.

49. As a result of CASTLE CONNOLLY’S material breach of the Partnership Agreement, AMERICAN REGISTRY has suffered damages, and will continue to suffer damages.

PRAYER FOR RELIEF

WHEREFORE, Plaintiff, AMERICAN REGISTRY, LLC, prays:

A. That this Court adjudge that CASTLE CONNOLLY has infringed and is infringing AMERICAN REGISTRY’S rights in the ‘800 Patent, directly and indirectly, literally and under the

doctrine of equivalents, in violation of 35 U.S.C. §271, and that CASTLE CONNOLLY'S infringement has been and continues to be willful;

B. That AMERICAN REGISTRY be awarded damages adequate to compensate it for the damages it has suffered as a result of CASTLE CONNOLLY'S infringement of the '800 Patent, and that such damages be trebled, pursuant to 35 U.S.C. §284;

C. That AMERICAN REGISTRY be awarded damages adequate to compensate it for the damages it has suffered as a result of CASTLE CONNOLLY'S material breach of the Partnership Agreement;

D. That CASTLE CONNOLLY be ordered to pay pre-judgment interest to AMERICAN REGISTRY on all amounts awarded and post-judgment interest until paid at the maximum lawful rate;

E. That, pursuant to 35 U.S.C. §283, or as otherwise authorized, CASTLE CONNOLLY, its officers, agents, servants, employees, attorneys and all persons acting in concert or participation with it who receive actual notice of the Court's order, be permanently enjoined from:

- 1) directly or indirectly manufacturing, using, selling, offering for sale, or importing into the United States of its territories any personalized, customized achievement recognition item produced via a method and system having an on-line interactive network site including a personalized network page with a pre-populated list of one or more achievements from which a user can customize and personalize specifications for the personalized, customized achievement recognition item that infringes the '800 Patent, directly or indirectly, literally or under the doctrine of equivalents; and
- 2) attempting, causing, or assisting any of the above-described acts.

F. That the Court retain jurisdiction of this action for the purpose of enabling AMERICAN REGISTRY to apply to the Court at any time for such further orders and interpretation

or execution of any order entered in this action; for the modification of any such order; for the enforcement or compliance therewith; and for the punishment of any violations thereof;

G. That CASTLE CONNOLLY be ordered to pay AMERICAN REGISTRY'S attorneys' fees pursuant to the Partnership Agreement, and as provided by 35 U.S.C. §285, or as otherwise authorized;

H. That CASTLE CONNOLLY be ordered to pay AMERICAN REGISTRY'S taxable and nontaxable costs, as provided by 35 U.S.C. §284, Fed.R.Civ.P. 54, or as otherwise authorized; and

I. That AMERICAN REGISTRY be awarded such other and further relief, at law or in equity, as the Court may deem just and proper under the circumstances.

JURY DEMAND

Plaintiff, AMERICAN REGISTRY, LLC, demands a trial by jury as to all issues triable of right by a jury.

Dated: April 13, 2023.

Respectfully submitted,

/s/ Adam J. Steinberg
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