

**IN THE UNITED STATES DISTRICT COURT
FOR THE EASTERN DISTRICT OF NEW YORK**

SATCO PRODUCTS, INC.

Plaintiff,

v.

THE REGENTS OF THE
UNIVERSITY OF CALIFORNIA

Defendant.

Civil Action No. 2:19-cv-6444

JURY DEMAND

COMPLAINT FOR DECLARATORY JUDGMENT

SATCO Products, Inc. (“Satco”) brings this complaint for declaratory judgment against Defendant The Regents of The University of California (“UC”) and alleges as follows:

INTRODUCTION

1. This is an action for a declaratory judgment of arising under the Declaratory Judgment Act, 28 U.S.C. §§ 2201 and 2202, and the patent laws of the United States, 35 U.S.C. § 1 *et seq.* Satco requests a judicial declaration that U.S. Patent Nos. 7,781,789 (“’789 patent”); 9,240,529 (“’529 patent”); 9,859,464 (“’464 patent”); 10,217,916 (“’916 patent”); 8,124,991 (“’991 patent”); 8,294,166 (“’166 patent”); 8,368,109 (“’109 patent”); 8,835,959 (“’959 patent”); 8,860,051 (“’051 patent”) and 10,454,010 (“’010 patent”) (collectively, the “UC Patents”) are not infringed by Satco.

2. A true and correct copy of the ’789 patent is attached as exhibit A.

3. A true and correct copy of the ’529 patent is attached as exhibit B.

4. A true and correct copy of the ’464 patent is attached as exhibit C.

5. A true and correct copy of the ’916 patent is attached as exhibit D.

6. A true and correct copy of the ’991 patent is attached as exhibit E.

7. A true and correct copy of the ’166 patent is attached as exhibit F.

8. A true and correct copy of the ’109 patent is attached as exhibit G.

9. A true and correct copy of the '959 patent is attached as exhibit H.
10. A true and correct copy of the '051 patent is attached as exhibit I.
11. A true and correct copy of the '010 patent is attached as exhibit J.

PARTIES

12. Plaintiff Satco is a company organized and existing under the laws of the State of New York with its principal place of business located within this judicial district, at 110 Heartland Blvd., Brentwood, New York 11717.

13. Defendant UC is a California constitutional corporation with a principal place of business at 1111 Franklin St., Oakland, California 94607.

14. UC claims to be the owner and assignee of the UC Patents.

JURISDICTION AND VENUE

15. This action arises under the Patent Laws of the United States, 35 U.S.C. §§ 101 *et seq.*, including 35 U.S.C. § 271. This Court has subject matter jurisdiction over this matter pursuant to 28 U.S.C. §§ 2201 and 2202, as well as 28 U.S.C. §§ 1331 and 1338(a).

16. An immediate, real, and justiciable controversy exists between Satco and UC as to whether Satco's filament-LED products infringe the UC Patents for the reasons described in more detail below.

17. This Court has personal jurisdiction over UC because it purposefully directed the activities described below at this forum, including by sending a letter dated October 7, 2019 to a resident of this forum, Ebulb Inc. ("Ebulb"), alleging that Ebulb's sale of Satco products infringes the UC Patents.

18. A true and correct copy of the October 7, 2019 letter to Ebulb is attached as Exhibit K.

19. Satco is also a resident of this district. As described below, UC has also purposefully directed patent enforcement activities at Satco, at Satco's products, and at Satco's customers.

20. By directing its patent enforcement activities at residents of this forum, UC has purposefully availed itself of the benefits and protections of New York's laws such that it should reasonably anticipate being haled into court here.

21. Venue is proper in the Eastern District of New York pursuant to 28 U.S.C. §§ 1391 and §1400(b).

FACTUAL BACKGROUND

22. On multiple occasions, UC wrote to Satco's customers, alleging that Satco's products infringe the UC Patents, and demanding that Satco's customers pay for a license to the UC Patents.

23. On July 30, 2019, Mr. Seth D. Levy of Nixon Peabody wrote a letter addressed to Mr. Enrique Colbert, the General Counsel of Wayfair, Inc. and its affiliated entities (collectively, "Wayfair"). In the letter, Mr. Levy stated that he was writing on behalf of UC to notify Wayfair that the Satco products containing filament light-emitting diodes ("LEDs") that they offered for sale "practice UC's patented inventions."

24. A true and correct copy of the July 30, 2019 letter to Wayfair is attached as Exhibit L.

25. On October 7, 2019, Mr. Levy wrote a letter addressed to Mr. William DeCamp, the President and Owner of Radiant Solutions Group, LLC ("Radiant"). In the letter, Mr. Levy stated that he was writing on behalf of UC to notify Radiant that the Satco products containing filament LEDs that they offered for sale "practice UC's patented inventions."

26. A true and correct copy of the October 7, 2019 letter to Radiant is attached as Exhibit M.

27. On October 7, 2019, Mr. Levy wrote a letter addressed to Mr. Paul McLellan, President of Service Lighting, Inc. ("Service Lighting"). In the letter, Mr. Levy stated that he was writing on behalf of UC to notify Service Lighting that the Satco products containing filament LEDs that they offered for sale "practice UC's patented inventions."

28. A true and correct copy of the October 7, 2019 letter to Service Lighting is attached as Exhibit N.

29. On October 7, 2019, Mr. Levy wrote a letter addressed to Mr. Abraham Cohen, Chief Executive Officer of Ebulb. In the letter, Mr. Levy stated that he was writing on behalf of UC to notify Ebulb that the Satco products containing filament LEDs that they offered for sale “practice UC’s patented inventions.”

30. Ebulb is a corporation organized under the laws of the State of New York, with a place of business at 425 Greenpoint Avenue, Brooklyn, NY 11222, which is in this forum.

31. The October 7, 2019 letter to Ebulb was sent via Federal Express to Ebulb’s place of business in this forum.

32. In each of the letters sent by UC to Wayfair, Radiant, Service Lighting, and Ebulb (collectively, the “UC Letters”), Mr. Levy invited Satco’s Customers “to take a non-exclusive license from UC so that its activities are authorized under the relevant patents.”

33. The UC Letters stated that “by importing, using (e.g., for display purposes), offering to sell, and/or selling UC’s patented filament LED technology without a license,” Wayfair, Radiant, Service Lighting, and Ebulb are “infringing UC’s applicable patents.” Each of the UC Letters provided a list of “UC’s current United States patent holdings pertaining to filament LED lighting products,” which included each of the UC Patents.

34. Each of the UC Letters further provided a list of “infringing products,” including “as illustrative examples” Satco filament-LED products such as the “Satco S9571 LED CA11 Bulb,” the “Satco S9875 LED A19 Bulb,” the “Satco S9870 LED G16 1/2 Bulb,” and the “4W E12 Dimmable LED Edison Candle Light Bulb.”

35. The UC Letters additionally stated that “UC takes protecting its intellectual property rights seriously,” and “[b]y way of illustration, enclosed with” the letter a copy of a complaint filed on July 30, 2019 on behalf of UC with the U.S. International Trade Commission (“ITC”), in which UC asserted that several retailers infringed four patents in the list provided in

the letters of “UC’s current United States patent holdings pertaining to filament LED lighting products.”

36. Each of the UC Letters further stated that “[l]awsuits seeking money damages for patent infringement were filed contemporaneously against each of these retailers.”

37. Additionally, UC has contacted Satco directly to discuss its allegation that Satco products infringe and that Satco is required to take a license to the UC Patents. As part of its direct communication with Satco, UC asked Satco to sign a confidentiality agreement, and Satco signed a confidentiality agreement with UC.

38. Based on its actions as described above, UCSB can be reasonably inferred to have demonstrated its intent to enforce the UC Patents, and Satco is under a reasonable apprehension that it or its customers will be sued by UC for infringement of the UC Patents by Satco products. Accordingly, as further described herein, an actual and justiciable controversy exists between Satco and UC as to whether Satco infringes any of the UC Patents.

39. Satco does not infringe the ’789 patent, for example because none of Satco’s filament-LED lighting products contain an LED that “resides on a transparent plate in a lead frame,” as required by independent claim 28 of the ’789 patent.

40. Satco does not infringe the ’529 patent, for example because none of Satco’s filament-LED lighting products contain an LED that “resides on or above a transparent plate in the lead frame,” as required by independent claims 1 and 13 of the ’529 patent.

41. Satco does not infringe the ’464 patent, for example because none of Satco’s filament-LED lighting products contain an LED chip that is “mounted on the lead frame and placed on on or above the transparent plate” in “a lead frame including a transparent plate,” as required by independent claims 1 and 11 of the ’464 patent.

42. Satco does not infringe the ’916 patent, for example because none of Satco’s filament-LED lighting products contain an LED that “resides on or above a transparent plate in the lead frame,” as required by independent claims 1 and 13 of the ’916 patent.

43. Satco does not infringe the '991 patent, for example because none of Satco's filament-LED lighting products contain LEDs wherein "at least a portion of an N-face surface of the n-type layer is roughened to increase scattering and extraction of light," as required by independent claims 1 and 21 of the '991 patent, nor do they contain LEDs manufactured by a process that includes the step of "roughening at least a portion of an N-face surface of the n-type layer to increase scattering and extraction of light," as required by independent claim 15 of the '991 patent.

44. Satco does not infringe the '166 patent, for example because none of Satco's filament-LED lighting products contain a "transparent substrate or sub-mount attached to the p-type side of the III-nitride layers only" of an LED, as required by independent claim 1 of the '166 patent, nor do they contain LEDs fabricated by "attaching a transparent substrate or sub-mount attached to a p-type side of the III-nitride layers only", as required by independent claim 22 of the '166 patent.

45. Satco does not infringe the '109 patent, for example because none of Satco's filament-LED lighting products contain "a III-nitride based light emitting diode (LED) structure grown on an n-type Gallium Nitride (GaN) substrate," as required by independent claim 1 of the '109 patent; nor do they contain LEDs fabricated by "growing a light emitting diode (LED) structure on an n-type Gallium Nitride (GaN) substrate," as required by independent claim 14 of the '109 patent; nor do they contain "a light emitting diode (LED) Structure grown on or above the GaN substrate" as required by independent claim 16 of the '109 patent.

46. Satco does not infringe the '959 patent, for example because none of Satco's filament-LED lighting products contain first and second shaped optical elements that "comprise inverted cone shapes," as required by independent claims 1 and 15 of the '959 patent.

47. Satco does not infringe the '051 patent, for example because none of Satco's filament-LED lighting products contain a phosphor layer "wherein at least a portion of a top surface of the phosphor layer is roughened, textured, or patterned," as required by independent claims 1 and 11 of the '051 patent.

48. Satco does not infringe the '010 patent, for example because none of Satco's filament-LED lighting products contain "a cathode on a first end of the sapphire plate and an anode on a second end of the sapphire plate, wherein the cathode and anode provide structural support to the sapphire plate and are adapted to provide an electrical connection between the light emitting device and a structure outside the light emitting device," as required by independent claim 1 of the '010 patent.

COUNT ONE

Declaratory Judgment Of Noninfringement Of The '789 Patent

49. Satco restates and realleges each of the assertions set forth in Paragraphs 1 through 48 above.

50. Satco has not infringed and does not infringe the '789 patent directly or indirectly, either literally or under the doctrine of equivalents, for at least the reasons specifically set forth above.

51. There is an actual controversy, within the meaning of 28 U.S.C. § 2201 and § 2202, between Satco and UC concerning the non-infringement of the '789 patent.

52. Satco is therefore entitled to a declaratory judgment that it has not infringed the '789 patent, directly or indirectly, either literally or under the doctrine of equivalents.

COUNT TWO

Declaratory Judgment Of Noninfringement Of The '529 Patent

53. Satco restates and realleges each of the assertions set forth in Paragraphs 1 through 48 above.

54. Satco has not infringed and does not infringe the '529 patent directly or indirectly, either literally or under the doctrine of equivalents, for at least the reasons specifically set forth above.

55. There is an actual controversy, within the meaning of 28 U.S.C. § 2201 and § 2202, between Satco and UC concerning the non-infringement of the '529 patent.

56. Satco is therefore entitled to a declaratory judgment that it has not infringed the '529 patent, directly or indirectly, either literally or under the doctrine of equivalents.

COUNT THREE

Declaratory Judgment Of Noninfringement Of The '464 Patent

57. Satco restates and realleges each of the assertions set forth in Paragraphs 1 through 48 above.

58. Satco has not infringed and does not infringe the '464 patent directly or indirectly, either literally or under the doctrine of equivalents, for at least the reasons specifically set forth above.

59. There is an actual controversy, within the meaning of 28 U.S.C. § 2201 and § 2202, between Satco and UC concerning the non-infringement of the '464 patent.

60. Satco is therefore entitled to a declaratory judgment that it has not infringed the '464 patent, directly or indirectly, either literally or under the doctrine of equivalents.

COUNT FOUR

Declaratory Judgment Of Noninfringement Of The '916 Patent

61. Satco restates and realleges each of the assertions set forth in Paragraphs 1 through 48 above.

62. Satco has not infringed and does not infringe the '916 patent directly or indirectly, either literally or under the doctrine of equivalents, for at least the reasons specifically set forth above.

63. There is an actual controversy, within the meaning of 28 U.S.C. § 2201 and § 2202, between Satco and UC concerning the non-infringement of the '916 patent.

64. Satco is therefore entitled to a declaratory judgment that it has not infringed the '916 patent, directly or indirectly, either literally or under the doctrine of equivalents.

COUNT FIVE

Declaratory Judgment Of Noninfringement Of The '991 Patent

65. Satco restates and realleges each of the assertions set forth in Paragraphs 1 through 48 above.

66. Satco has not infringed and does not infringe the '991 patent directly or indirectly, either literally or under the doctrine of equivalents, for at least the reasons specifically set forth above.

67. There is an actual controversy, within the meaning of 28 U.S.C. § 2201 and § 2202, between Satco and UC concerning the non-infringement of the '991 patent.

68. Satco is therefore entitled to a declaratory judgment that it has not infringed the '991 patent, directly or indirectly, either literally or under the doctrine of equivalents.

COUNT SIX

Declaratory Judgment Of Noninfringement Of The '166 Patent

69. Satco restates and realleges each of the assertions set forth in Paragraphs 1 through 48 above.

70. Satco has not infringed and does not infringe the '166 patent directly or indirectly, either literally or under the doctrine of equivalents, for at least the reasons specifically set forth above.

71. There is an actual controversy, within the meaning of 28 U.S.C. § 2201 and § 2202, between Satco and UC concerning the non-infringement of the '166 patent.

72. Satco is therefore entitled to a declaratory judgment that it has not infringed the '166 patent, directly or indirectly, either literally or under the doctrine of equivalents.

COUNT SEVEN

Declaratory Judgment Of Noninfringement Of The '109 Patent

73. Satco restates and realleges each of the assertions set forth in Paragraphs 1 through 48 above.

74. Satco has not infringed and does not infringe the '109 patent directly or indirectly, either literally or under the doctrine of equivalents, for at least the reasons specifically set forth above.

75. There is an actual controversy, within the meaning of 28 U.S.C. § 2201 and § 2202, between Satco and UC concerning the non-infringement of the '109 patent.

76. Satco is therefore entitled to a declaratory judgment that it has not infringed the '109 patent, directly or indirectly, either literally or under the doctrine of equivalents.

COUNT EIGHT

Declaratory Judgment Of Noninfringement Of The '959 Patent

77. Satco restates and realleges each of the assertions set forth in Paragraphs 1 through 48 above.

78. Satco has not infringed and does not infringe the '959 patent directly or indirectly, either literally or under the doctrine of equivalents, for at least the reasons specifically set forth above.

79. There is an actual controversy, within the meaning of 28 U.S.C. § 2201 and § 2202, between Satco and UC concerning the non-infringement of the '959 patent.

80. Satco is therefore entitled to a declaratory judgment that it has not infringed the '959 patent, directly or indirectly, either literally or under the doctrine of equivalents.

COUNT NINE

Declaratory Judgment Of Noninfringement Of The '051 Patent

81. Satco restates and realleges each of the assertions set forth in Paragraphs 1 through 48 above.

82. Satco has not infringed and does not infringe the '051 patent directly or indirectly, either literally or under the doctrine of equivalents, for at least the reasons specifically set forth above.

83. There is an actual controversy, within the meaning of 28 U.S.C. § 2201 and § 2202, between Satco and UC concerning the non-infringement of the '051 patent.

84. Satco is therefore entitled to a declaratory judgment that it has not infringed the '051 patent, directly or indirectly, either literally or under the doctrine of equivalents.

COUNT TEN

Declaratory Judgment Of Noninfringement Of The '010 Patent

85. Satco restates and realleges each of the assertions set forth in Paragraphs 1 through 48 above.

86. Satco has not infringed and does not infringe the '010 patent directly or indirectly, either literally or under the doctrine of equivalents, for at least the reasons specifically set forth above.

87. There is an actual controversy, within the meaning of 28 U.S.C. § 2201 and § 2202, between Satco and UC concerning the non-infringement of the '010 patent.

88. Satco is therefore entitled to a declaratory judgment that it has not infringed the '010 patent, directly or indirectly, either literally or under the doctrine of equivalents.

PRAYER FOR RELIEF

WHEREFORE, Satco respectfully requests that the Court enter judgment in its favor against UC, granting the following relief:

- a. A declaration that Satco does not infringe the '789 patent, directly or indirectly, either literally or under the doctrine of equivalents.
- b. A declaration that Satco does not infringe the '529 patent, directly or indirectly, either literally or under the doctrine of equivalents.
- c. A declaration that Satco does not infringe the '464 patent, directly or indirectly, either literally or under the doctrine of equivalents.
- d. A declaration that Satco does not infringe the '916 patent, directly or indirectly, either literally or under the doctrine of equivalents.
- e. A declaration that Satco does not infringe the '991 patent, directly or indirectly, either literally or under the doctrine of equivalents.
- f. A declaration that Satco does not infringe the '166 patent, directly or indirectly, either literally or under the doctrine of equivalents.
- g. A declaration that Satco does not infringe the '109 patent, directly or indirectly, either literally or under the doctrine of equivalents.
- h. A declaration that Satco does not infringe the '959 patent, directly or indirectly, either literally or under the doctrine of equivalents.
- i. A declaration that Satco does not infringe the '051 patent, directly or indirectly, either literally or under the doctrine of equivalents.
- j. A declaration that Satco does not infringe the '010 patent, directly or indirectly, either literally or under the doctrine of equivalents.
- k. A judgment that this is an exceptional case and an award to Satco of its costs and reasonable attorneys' fees incurred in this action as provided by 35 U.S.C. § 285; and
- l. An award of costs, and expenses as allowed by law;
- m. Such other and further relief as the Court may deem just and proper under the circumstances.

DEMAND FOR JURY TRIAL

Pursuant to Rule 38(b) of the Federal Rules of Civil Procedure, Satco demands jury trial on all issues and claims so triable.

Dated: November 14, 2019

Respectfully submitted,

/s/ Scott J. Bornstein

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