

IN THE UNITED STATE DISTRICT COURT  
FOR THE DISTRICT OF DELAWARE

SUNPOWER CORPORATION,

Plaintiff,

v.

PANELCLAW, INC.,

Defendants.

C. A. No. 12-1633-GMS

JURY TRIAL DEMANDED

**SECOND AMENDED COMPLAINT FOR PATENT INFRINGEMENT**

Plaintiff SunPower Corporation (“SunPower”) hereby alleges as follows:

**THE PARTIES**

1. SunPower is incorporated under the laws of the state of Delaware, and has a regular and established place of business at 77 Rio Robles, San Jose, CA 95134.
2. Upon information and belief, defendant PanelClaw, Inc. (“PanelClaw” or “Defendant”) is incorporated under the laws of the state of Delaware, with a principal place of business located at 1600 Osgood Street, Suite 2023, North Andover, MA 01845.

**JURISDICTION AND VENUE**

3. This action arises under the patents laws of the United States, Title 35 U.S.C. § 1 et seq. This Court has subject matter jurisdiction under 28 U.S.C. §§ 1331 and 1338(a).
4. Upon information and belief, this Court has personal jurisdiction over defendant PanelClaw for at least the reason that it is organized under the laws of the state of Delaware, in this judicial District.
5. Upon information and belief, venue is proper in this Court pursuant to 28 U.S.C. §§ 1391(b), (c) and 1400 because Defendant is subject to personal jurisdiction in this judicial District.

## GENERAL ALLEGATIONS

6. PanelClaw's products include its "Grizzly Bear" and "Polar Bear" flat roof solutions that are used for the installation of photovoltaic energy systems on building roofs.

7. According to PanelClaw's website, "Polar Bear® Gen II is the next generation in flexible ballasted solar mounting systems for commercial flat roof applications" (Ex. C (Polar Bear Tech Spec)) and "Grizzly Bear® Gen II is an environmentally friendly ballasted solar mounting solution for commercial flat roof applications." (Ex. D (Grizzly Bear Tech Spec)) PanelClaw refers to its customers' use of its solutions as a "photovoltaic project." Ex. E (Polar Bear installation video); Ex. F (Grizzly Bear installation video).)

8. PanelClaw advertises that the "Polar Bear" system is "suitable in areas with basic wind speeds of up to 120 mph (193 km/h)" (Ex. C (Polar Bear Tech Spec)) and the "Grizzly Bear" system is "suitable primarily in areas with basic wind speeds of up to 100 mph (160 km/h)." (Ex. D (Grizzly Bear Tech Spec)) PanelClaw advertises that its systems have undergone "extensive wind tunnel testing." (Ex. E (Polar Bear installation video); Ex. F (Grizzly Bear installation video).)

9. PanelClaw provides instructional videos for installation of its "Grizzly Bear" and "Polar Bear" systems. Ex. E (Polar Bear installation video); Ex. F (Grizzly Bear installation video).)

10. Upon information and belief, PanelClaw has mounted photovoltaic energy systems using its "Grizzly Bear" and "Polar Bear" solutions on flat roofs at least to test the wind speed suitability and for instructional purposes. Testing of wind speed suitability and instructional purposes requires an installed photovoltaic energy system.

11. PanelClaw provides installation instructions for its "Grizzly Bear" and "Polar Bear" solutions. PanelClaw identifies the "six easy steps" for installation of photovoltaic modules using PanelClaw's solutions, including "provid[ing] precise ballast drawings, detailing support, ballast and module placement." Ex. E (Polar Bear installation video); *See also* Ex. F (Grizzly Bear installation video)(setting forth "five easy steps" for installation.)

12. PanelClaw “will carefully coordinate every stage of the process” with its customers. (Ex. C (Polar Bear Tech Spec); Ex. D (Grizzly Bear Tech Spec).)

13. According to PanelClaw’s website, at least nine customers have installed photovoltaic energy systems on rooftops using PanelClaw’s “Polar Bear” solution: Texas Solar Power Company – 180 kW (Ex. G at 1); SolarCity – 390 kW (Ex. G at 2); Nexamp – 37 kW (Ex. G at 3); Narenco – 1,204 kW (Ex. G at 4); Broadway Electrical – 132 kW (Ex. G at 5); Namaste Solar – 210 kW (Ex. G at 6); groSolar – 100 kW (Ex. G at 7); EOS-Mercury Solar Systems – 112 kW and 81 kW (Ex. G at 8); SunDurance Energy – 1,826 kW (Ex. G at 9).

14. According to PanelClaw’s website, at least nine customers have installed photovoltaic energy systems on rooftops using PanelClaw’s “Grizzly Bear” solution: Argand Energy Solutions – 200 kW (Ex. H at 1); Ontility – 620 kW (Ex. H at 2); Main Street Power – 102 kW (Ex. H at 3); SolarCity – 362 kW, 463 kW and 572 kW (Ex. H at 4); Narenco – 306 kW, 1,204 kW and 1,208 kW (Ex. H at 5); Meadow Valley Electric – 227 kW (Ex. H at 6); Monolith Solar – 22 kW (Ex. H at 7); AEG Power Solutions – 28 kW (Ex. H at 8); Mountain Valley Electric – 220 kW (Ex. H at 9).

15. According to PanelClaw’s website, PanelClaw’s ETL listing includes modules from Motech. Upon information and belief, Motech modules are manufactured in Delaware.

16. Upon information and belief, defendant PanelClaw manufactures the “Grizzly Bear” and “Polar Bear” systems, and directly and through its affiliates, uses, imports, sells, and offers to sell the same throughout the United States, including Delaware.

17. Upon information and belief, defendant PanelClaw sells, imports, and/or offers to sell the “Grizzly Bear” and “Polar Bear” systems in Delaware.

### **FIRST CAUSE OF ACTION**

#### **INFRINGEMENT OF U.S. PATENT NO. 5,505,788**

18. The allegations of paragraphs 1-17 are incorporated as though full set forth herein.

19. SunPower was the assignee and sole owner of all right, title, and interest in United States Patent No. 5,505,788, entitled “Thermally regulated photovoltaic roofing assembly” (“the ’788 patent”), which was duly and legally issued on April 9, 1996. The term of the ’788 patent has now expired. A true and correct copy of the ’788 patent is attached hereto as Exhibit A.

20. Upon information and belief, during the term of the ’788 patent, defendant PanelClaw has infringed, induced infringement, and contributed to the infringement of the ’788 patent by making, using, importing, selling, and/or offering to sell devices, including the “Grizzly Bear” and “Polar Bear” systems, and/or inducing or contributing to the importation, use, offer for sale, and sale by others of such systems covered by one or more claims of the ’788 patent, all to the injury of SunPower.

21. Upon information and belief, during the term of the ’788 patent, defendant PanelClaw has infringed the ’788 patent by making, using, importing, selling, and/or offering to sell photovoltaic energy systems, using the “Grizzly Bear” and “Polar Bear” solutions, covered by one or more claims of the ’788 patent.

22. Upon information and belief, defendant PanelClaw was made aware of the ’788 patent by a letter from SunPower to PanelClaw, sent on August 8, 2012. The letter was addressed to Mr. Constantino Nicolaou.

23. Upon information and belief, defendant PanelClaw was aware of its customers’ photovoltaic energy systems using the “Grizzly Bear” and “Polar Bear” solutions. On information and belief, defendant PanelClaw’s customers’ photovoltaic energy systems made, used or sold during the term of the ’788 patent directly infringe one or more claims of the ’788 patent.

24. Defendant PanelClaw has infringed by contributing to and/or inducing its customers to make, use, sell, offer to sell, and/or import in this District and elsewhere in the United States, photovoltaic energy systems, using without limitation its “Grizzly Bear” and “Polar Bear” solutions, covered by one or more claims of the ’788 patent during its term, all to the injury of SunPower. The “Grizzly Bear” and “Polar Bear” solutions have no substantial non-

infringing use and are specially designed to work with the patented invention. Defendant's acts of infringement were done with knowledge of the SunPower patents and with the intent to encourage infringement.

25. Defendant's acts of infringement have injured and damaged SunPower.

## **SECOND CAUSE OF ACTION**

### **INFRINGEMENT OF U.S. PATENT NO. RE38,988**

26. The allegation of paragraphs 1-25 are incorporated as though fully set forth herein.

27. SunPower is now the assignee and sole owner of all right, title, and interest in United States Patent No. RE38,988, entitled "Lightweight, self-ballasting photovoltaic roofing assembly" ("the '988 patent"), which was duly and legally issued on February 28, 2006. A true and correct copy of the '988 patent is attached hereto as Exhibit B.

28. Upon information and belief, defendant PanelClaw has been and is now infringing, inducing infringement, and contributing to the infringement of the '988 patent by making, using, importing, selling, and/or offering to sell devices, including the "Grizzly Bear" and "Polar Bear" systems, and/or inducing or contributing to the importation, use, offer for sale, and sale by others of such systems covered by one or more claims of the '988 patent, all to the injury of SunPower.

29. Upon information and belief, during the term of the '988 patent, defendant PanelClaw has infringed the '988 patent by making, using, importing, selling, and/or offering to sell photovoltaic energy systems, using the "Grizzly Bear" and "Polar Bear" solutions, covered by one or more claims of the '988 patent.

30. The '988 patent resulted from a re-issue of U.S. Patent No. 5,746,839, which itself duly and legally issued on May 5, 1998 ("the '839 patent").

31. Upon information and belief, defendant PanelClaw was aware of the '839 patent no later than March 27, 2008, when PanelClaw or its agent filed an Information Disclosure Statement with the U.S. Patent and Trademark Office in patent application no. 12/056,791, assigned to PanelClaw, which listed the '839 patent as prior art.

32. Upon information and belief, defendant PanelClaw was made aware of the '988 patent by a letter from SunPower to PanelClaw, sent on August 8, 2012. The letter was addressed to Mr. Constantino Nicolaou.

33. Upon information and belief, defendant PanelClaw was aware of its customers' photovoltaic energy systems using the "Grizzly Bear" and "Polar Bear" solutions. On information and belief, defendant PanelClaw's customers' photovoltaic energy systems directly infringe one or more claims of the '988 patent.

34. Defendant PanelClaw has been and is now infringing by contributing to and/or inducing its customers to make, use, sell, offer to sell, and/or importing in this District and elsewhere in the United States, photovoltaic energy systems, using without limitation its "Grizzly Bear" and "Polar Bear" systems, covered by one or more claims of the '988 patent, all to the injury of SunPower. The "Grizzly Bear" and "Polar Bear" systems have no substantial non-infringing use and are specially designed to work with the patented invention. Defendant's acts of infringement were done with knowledge of the SunPower patents and with the intent to encourage infringement.

35. Defendant's acts of infringement have injured and damaged SunPower.

36. Defendant's infringement has caused irreparable injury to SunPower and will continue to cause irreparable injury until defendant is enjoined from further infringement by this Court.

#### **PRAYER FOR RELIEF**

WHEREFORE, Plaintiff requests the following relief:

- (a) judgment against Defendant as to infringement of the '788 patent;

- (b) judgment against Defendant as to infringement of the '988 patent;
- (c) a permanent injunction preventing Defendant and its officers, directors, agents, servants, employees, attorneys, licensees, successors, assigns, and customers, and those in active concert or participation with any of them, from infringing and from inducing, contributing to, or otherwise causing the infringement of the '988 patent by making, using, importing, offering to sell or selling any device that infringes any claim of the '988 patent;
- (d) judgment against defendants for money damages sustained as a result of defendants' infringement of the '788 and '988 patents;
- (e) costs and reasonable attorneys' fees incurred in connection with this action pursuant to 35 U.S.C. § 285;
- (f) an accounting of any additional damages accrued before entry of judgment; and
- (g) such other and further relief as this Court finds just and proper.

**JURY DEMAND**

Plaintiff requests trial by jury.

Dated: April 15, 2013

FISH & RICHARDSON P.C.

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