

IN THE UNITED STATES DISTRICT COURT
FOR THE WESTERN DISTRICT OF TEXAS
AUSTIN DIVISION

MASAKAZU USHIJIMA

Plaintiff,

v.

SAMSUNG ELECTRONICS CO., LTD. and
SAMSUNG ELECTRONICS AMERICA, INC.

Defendants.

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Case No. 1:16-CV-585

Jury Demanded

PLAINTIFF'S ORIGINAL COMPLAINT

Masakazu Ushijima brings this action against Samsung Electronics Co., Ltd., and Samsung Electronics America, Inc., and alleges as follows:

THE PARTIES

1. Plaintiff Masakazu Ushijima ("Plaintiff" or "Ushijima") is a Japanese citizen residing in Tokyo, Japan.

2. Samsung Electronics Co., Ltd. ("SEC") is a corporation organized and existing under the laws of the Republic of Korea, with its principal place of business at Samsung Main Building, 250, Taepyeongno 2-ga, Jung-gu, Seoul 100-742, Republic of Korea.

3. Samsung Electronics America, Inc. ("SEA" and, collectively with SEC, "Samsung") is a subsidiary of SEC, and is a corporation organized and existing under the laws of the State of New York, with its principal place of business at 105 Challenger Road, Ridgefield Park, New Jersey 07660-2106. Samsung may be served with process by serving its registered agent, CT Corporation System, 350 N. Saint Paul St., Dallas, Texas 75201-4201.

4. Upon information and belief, SEC and SEA, by virtue of their corporate relationship with one another (e.g., the parent-subsiary-affiliate relationship, as well as from a corporate governance perspective), each shared the same knowledge with respect to the patent-in-suit. Examples of this include the fact that identical individuals testified at times on behalf of both SEC and SEA in *Ushijima I*. Further, upon information and belief, identical individuals have held officer, director, and/or management positions at both SEC and SEA.

JURISDICTION AND VENUE

5. This action arises under the patent laws of the United States, Title 35 United States Code, particularly §§ 271 and 281. This Court has jurisdiction over the claim for patent infringement under 28 U.S.C. §§ 1331 and 1338(a).

6. Personal jurisdiction exists generally over Samsung because both SEC and SEA have sufficient minimum contacts with the forum as a result of business conducted within the State of Texas and within the Western District of Texas. Personal jurisdiction also exists specifically over Samsung because both SEC and SEA, directly or through subsidiaries or intermediaries, made, used, offered for sale, sold, or imported products or services within the State of Texas and within the Western District of Texas, that infringed the patent-in-suit.

7. Venue is proper in this Court under Title 28 United States Code §§ 1391(b) and (c) and 1400(b).

TRIAL OF USHIJHIMA I

8. On April 10, 2012, Mr. Ushijima sued Samsung for infringement of U.S. Patent No. 5,495,405 (“the ‘405 patent,” attached as Exhibit A) in the lawsuit styled: *Ushijima v. Samsung Electronics Co. Ltd., et al.*, Case No. 1:12-cv-318-LY, in the United States District Court, Western District of Texas, Austin Division (referred to herein as “*Ushijima I*”).

9. *Ushijima I* culminated in a multi-day trial before this Court from February 23 to March 3, 2015. Prior to the trial, Samsung ultimately contended that Mr. Ushijima had not asserted infringement allegations concerning Samsung laptop style computer products, and refused to produce any discovery concerning laptop computer products. Mr. Ushijima contended that he clearly asserted infringement allegations that concerned laptop computer products.

10. The dispute concerning Samsung's refusal to produce discovery concerning laptop style computer products was brought to the Court's attention, and on January 9, 2015, before the jury was seated in *Ushijima I*, Mr. Ushijima and Samsung entered into a Stipulation Regarding Laptop Computers ("Stipulation"), which is attached hereto as Exhibit B.

11. The pre-trial Stipulation concerning laptop style computer products provided for, among other things, a dismissal of Samsung's laptop computer products from the trial of *Ushijima I* without prejudice to the refile of Mr. Ushijima's claims of infringement of the '405 patent in the future. *Id.* **As alleged herein, the products Ushijima accuses of infringement in the instant case are Samsung's laptop computer products that do not include any of the inverter circuit transformer cores that were the principal subject of the trial in *Ushijima I*.**

12. The Stipulation further provided for the tolling of Mr. Ushijima's claims against Samsung for a period of three (3) years, preserving all rights and benefits he would otherwise have as of the day the Stipulation was entered. *Id.*

13. At the *Ushijima I* trial, Mr. Ushijima limited his infringement allegations to Samsung televisions and computer monitors. Neither the Court nor the jury heard evidence of infringement of Samsung laptop style computer products.

14. Each of the Samsung television and computer monitor products accused of infringing the '405 patent during the trial of *Ushijima I* included an inverter circuit transformer

with cores designated as either EE, EFD, EER, EEL and/or UU. *See* Verdict Form entered March 3, 2015, attached hereto as Exhibit C.

15. During the trial of *Ushijima I*, Samsung placed heavy emphasis on its transformer cores designated as either EE, EFD, EER, EEL and/or UU, and Samsung's belief that only products with "rod shaped" transformer cores could infringe the '405 patent.

16. The jury in *Ushijima I* returned a verdict finding that the EE Core and UU Core products accused of infringement did not infringe claims 4 and 5 of the '405 patent. *Id.* **As alleged herein, the products Ushijima accuses of infringement in the instant case do not include any of the EE Cores or the UU Core that were the subject of the trial in Ushijima I.**

17. The jury in *Ushijima I* also returned a verdict finding that the asserted claims of the '405 patent were not invalid for the various reasons asserted by Samsung. *Id.*

18. This Court entered Final Judgment on June 2, 2015. *See* Final Judgment entered March 3, 2015, attached hereto as Exhibit D.

THE PATENT

19. On February 27, 1996, the '405 patent, entitled "Inverter Circuit for Use with Discharge Tube" was duly and legally issued ("the '405 patent"). A true and correct copy of the '405 patent is attached as Exhibit A.

20. The '405 patent expired on August 29, 2014.

21. Pursuant to 35 U.S.C. § 282, the '405 patent is presumed valid.

22. In *Ushijima I*, Samsung sought to invalidate the '405 patent on the grounds that it was anticipated, obvious, lacked an adequate written description, and was not enabling.

23. The jury in *Ushijima I* reached a verdict as to the validity of the ‘405 patent and found that claims 4 and 5 of the ‘405 patent are not invalid for any of the grounds raised by Samsung. *See* Exhibit C.

24. Samsung is estopped from asserting the invalidity of claims 4 and 5 in the ‘405 patent on any ground which was raised or could have been raised during the *Ushijima I*.

25. Mr. Ushijima is the owner by assignment of the entire right, title, and interest in the ‘405 patent, including the right to sue and collect damages for past, present, and future infringement (to the extent those remedies are available to him).

26. Prior to filing this suit, Mr. Ushijima complied with the marking requirement pursuant to 35 U.S.C. § 287(a) and is thus entitled to recover past damages for Samsung’s infringement of the ‘405 patent, as more fully described below.

**COUNT I: FIRST CLAIM FOR RELIEF
(INFRINGEMENT OF THE ‘405 PATENT)**

27. Samsung has infringed claims 4 and 5 of the ‘405 patent by making, using, selling, offering for sale within the United States, leasing, and/or importing into the United States, certain laptop computer products that infringe claims 4 and 5 of the ‘405 patent.

28. The Samsung laptop style computer products that infringe the ‘405 patent include, **at least**, the following models whose infringement are ascertainable through publicly available information and inspection: Laptop models Q310, R610, P460, P560, R519, further including at least the following model numbers: NP-P460-AA01US, NP-P460-AA02US, NP-P460-AA04US, NP-P560-AA03US, NP-P560-AS02US, NP-P560-AS03US, NP-Q310-AA01US, NP-Q310-AA02US, NP-R519-FA01US, NP-R610-AS01US, and NP-R610-AS03US, and including Samsung inverter boards designated BA44-00248A, BA44-00249A, or BA44-00250A. At least these Samsung products, the inverter boards, as well as those that are similar in design and

functionality and are currently unknown to Mr. Ushijima despite his efforts to ascertain them, are referred to herein as the “Accused Laptop Products”.

29. Independent claims 4 of the ‘405 patent reads as follows:

4. An inverter circuit for a discharge tube comprising:

a leakage flux type step-up transformer having an elongated core disposed in substantially a center of said step-up transformer, a primary winding and a secondary winding, said primary winding and secondary winding being wound about said elongated core in juxtaposed relation with each other along said core so that said secondary winding has a portion near to said primary winding which magnetically close couples with said primary winding and a portion remote from said primary winding which magnetically loose couples with said primary winding;

a discharge tube connected across said secondary winding; and

a resonance circuit composed of a parasitic or stray capacitance produced mainly in the close coupling portion of said secondary winding, the loose coupling portion of said secondary winding, and a parasitic or stray capacitance produced in the circumference of said discharge tube,

said resonance circuit producing a high voltage by the resonance thereof that is supplied to said discharge tube in order to turn said discharge tube on.

30. Claims 5 of the ‘405 patent, which depends from claim 4, includes the following additional limitation:

5. The inverter circuit according to claim 4, further including a capacitor connected in parallel with said discharge tube.

31. In *Ushijima I*, the parties agreed to the construction of certain claim terms found in claim 4 of the ‘405 patent. The Court adopted these constructions. These agreed and adopted constructions are as follows:

- (a) “a primary winding” means “the winding of a transformer which is on the input side”;
- (b) “a secondary winding” means “the winding of a transformer which is on the output side”; and

- (c) “in order to” means “sufficient to.”

32. In its Memorandum Opinion and Order Regarding Claims Construction, attached as Exhibit E, in addition to the parties’ agreed constructions, this Court construed certain terms and phrases from claims 4 and 5 of the ‘405 patent in *Ushijima I* as follows:

- (a) The Court held that the preamble to claim 4, “[a]n inverter circuit for a discharge tube,” is not limiting and that the inventors clearly intended for the claimed invention “to be used in the context of the discharge lamps discussed in the specification”;
- (b) “a leakage flux type step-up transformer” means “a step-up transformer with a portion of the secondary winding having leakage flux sufficient to serve as the inductive component of a resonance circuit”;
- (c) “an elongated core disposed in substantially a center of said step-up transformer” means “an elongated core, exclusive of an EE or EI type core, disposed in substantially a center of said step-up transformer”;
- (d) “magnetically close couples with said primary winding” means “magnetically interacts with the primary winding to serve mainly as a normal secondary winding to effect step-up operation”;
- (e) “magnetically loose couples with said primary winding” means “magnetically interacts with the primary winding to serve mainly as the inductive component of a resonance circuit”;
- (f) “composed of” has its “plain and ordinary meaning as an open transition phrase”; and
- (g) That claim 5, “[t]he inverter circuit according to claim 4, further including a capacitor connected in parallel with said discharge tube,” is “not indefinite and should be afforded its plain and ordinary meaning.” *Id.*

33. In view of the parties’ agreed constructions and the Court’s constructions of claim terms found in claims 4 and 5 of the ‘405 patent during *Ushijima I*, Mr. Ushijima has determined that each of the Samsung laptop models specifically identified in ¶ 28 above includes each of the elements of claims 4 and 5 of the ‘405 patent. A preliminary chart, based on publically available information, mapping the infringement of Accused Laptop Products is attached as Exhibit F to this

Complaint. This chart may be modified based upon information obtained from Samsung or from third parties, obtained through the discovery of this lawsuit.

SAMSUNG'S DIRECT INFRINGEMENT

34. Samsung directly infringed at least claims 4 and 5 of the '405 patent, either literally or under the doctrine of equivalents, by making, using, selling, offering for sale in the United States, and/or importing into the United States, the Accused Laptop Products. *See* Exhibit F.

SAMSUNG'S INDUCEMENT OF INFRINGEMENT

35. Samsung has had actual knowledge of the '405 patent since as early as 1997 when Samsung discussed with Mr. Ushijima the prospects of using his patented inverter technology. At least by early 2001 Samsung began featuring the patented technology in its LCD products sold outside the United States. In May of 2001, Samsung wrote to Mr. Ushijima to discuss his patented technology, including the '405 patent. Mr. Ushijima's companies used the patented technology in their own products, made and sold outside the United States. In 2006, Samsung invited Mr. Ushijima to meet concerning issues related to the patented technology.

36. Upon information and belief, SEC and SEA, by virtue of their corporate relationship, knew of, or were willfully blind towards, the '405 patent, at least since 1997 when Samsung discussed with Mr. Ushijima the prospects of using his patented technology.

37. Mr. Ushijima was not aware of any specific finished Samsung products sold in the U.S. that practiced his '405 patent until 2011. Although Samsung practiced the technology claimed in the '405 patent outside the United States at least as early as 2001, upon information and belief, Samsung did not begin infringing the '405 in the United States any earlier than mid-2006 with respect to Accused Laptop Products.

38. Since becoming aware of, or being willfully blind towards, the '405 patent, on information and belief, Samsung continued to intentionally, actively, and knowingly make, use, sell, offer to sell, and/or import one or more Accused Laptop Products through their retailers, resellers, distributors, websites (including but not limited to www.samsung.com/us/consumer/index/html and/or www.samsungparts.com), as well as in other ways.

39. Since becoming aware of, or being willfully blind towards, the '405 patent, Samsung's advertising, sales, and/or technical materials in relation to the Accused Laptop Products have intentionally, actively, knowingly, and willfully contained and continue to contain instructions, directions, suggestions, and/or invitations that intentionally, actively, and knowingly invite, entice, lead on, influence, encourage, prevail on, move by persuasion, cause, and/or influence the public, Samsung's distributors, retailers, customers, and/or website users to purchase and/or use Accused Laptop Products, and thereby directly infringe at least claims 4 and 5 of the '405 patent, either literally or under the doctrine of equivalents.

40. Since becoming aware of, or being willfully blind towards, the '405 patent, Samsung was willfully blind or knew that the public's, the distributors', the retailers', the customers' and/or the website users' acts relative to purchasing and using Accused Laptop Products directly infringed, either literally or under the doctrine of equivalents, at least claims 4 and 5 of the '405 patent, because the inverter circuit boards were specifically designed to make the laptop screen operate, and without it, the laptop cannot be used for its intended purpose..

41. For these reasons, Samsung is liable for inducing infringement of the '405 patent, either literally or under the doctrine of equivalents.

SAMSUNG'S CONTRIBUTORY INFRINGEMENT

42. At least for the reasons stated above, Samsung had actual knowledge of, or were willfully blind towards, the '405 patent.

43. Since becoming aware of, or being willfully blind towards, the '405 patent, Samsung has intentionally, actively, and knowingly sold, offered to sell, or imported inverter circuit boards for infringing LCD backlit laptop style computer products within the United States.

44. The subject inverter circuit boards are a component of a patented machine, manufacture, and/or combination because the inverter circuit boards meet at least one element of at least claim 4 and 5 of the '405 patent, either literally or under the doctrine of equivalents. *See* Exhibit F.

45. The subject inverter circuit boards are a material part of the invention of at least claims 4 and 5 of the '405 patent, either literally or under the doctrine of equivalents, because the majority of the elements of claims 4 and 5 are present in the inverter circuit boards, either literally or under the doctrine of equivalents, and for the reasons stated herein, in relation to the lack of substantial non-infringing use. *See*, for example, Exhibit F.

46. The subject inverter circuit boards are especially made or especially adapted for use in the infringement of at least claims 4 and 5 of the '405 patent, either literally or under the doctrine of equivalents, because the combination of the inverter circuit boards with LCD backlit laptop style computer products directly infringe the '405 patent, either literally or under the doctrine of equivalents.

47. Since becoming aware of, or being willfully blind towards, the '405 patent, Samsung was willfully blind or knew that the subject inverter circuit boards were especially

made or especially adapted for use in the infringement of at least claims 4 and 5 of the '405 patent, either literally or under the doctrine of equivalents, for the reasons stated above and below.

48. The subject inverter circuit boards are not a staple article or commodity of commerce suitable for substantial non-infringing use because the only substantial use of the inverter circuit boards is to be installed as an essential component of LCD backlit laptop style computers, which combination directly infringe at least claims 4 and 5 of the '405 patent, either literally or under the doctrine of equivalents.

49. Since becoming aware of, or being willfully blind towards, the '405 patent, Samsung was willfully blind or knew that the subject inverter circuit boards were not a staple article or commodity of commerce suitable for substantial noninfringing use.

50. By selling, offering to sell, and/or importing into the United States one or more of the subject inverter circuit boards and/or the components thereof, Samsung has contributed to the infringement by the public, the distributors, the retailers, the customers, and the website users who import, make, use, sell, offer to sell, lease, and/or offer to lease infringing laptop style computer products, and thus directly infringe at least claims 4 and 5 of the '405 patent, either literally or under the doctrine of equivalents.

51. For these reasons, SEC and SEA are contributory infringers of at least claims 4 and 5 of the '405 patent, either literally or under the doctrine of equivalents.

DAMAGES

52. Samsung's acts of infringement of the '405 patent as alleged above have injured Mr. Ushijima and thus Mr. Ushijima is entitled to recover damages which in no event can be less

than a reasonable royalty, including its costs, and pre-judgment and post-judgment interest pursuant to 35 U.S.C. § 284.

WILLFUL INFRINGEMENT

53. Samsung has infringed the ‘405 patent despite an objectively high likelihood that their actions constituted infringement of these valid patents.

54. Samsung knew or should have known this objectively high likelihood, at least because the ‘405 patent has been the subject of communications from Samsung since at least May of 2001.

55. Because Samsung willfully infringed the ‘405 patent, Ushijima is permitted under 35 U.S.C. § 284 to recover treble the amount of actual damages sustained by the Plaintiff.

DEMAND FOR JURY TRIAL

56. Ushijima hereby demands a jury trial on all claims and issues triable of right by a jury.

PRAYER FOR RELIEF

WHEREFORE, Plaintiff Masakazu Ushijima prays for entry of judgment:

- A. That Defendants have infringed one or more claims of the ‘405 patent.
- B. That Defendants account for and pay to Plaintiff all damages caused by the infringement of the ‘405 patent, which by statute can be no less than a reasonable royalty;
- C. That the Court increase the damages up to three times the amount found or assessed;
- D. That Plaintiff be granted pre-judgment and post-judgment interest on the damages caused to him by reason of Defendants’ infringement of the ‘405 patent;
- E. That the Court declare this case exceptional, in favor of Plaintiff, under 35 U.S.C. § 285 and that Plaintiff be granted his attorneys’ fees in this action;
- F. That costs be awarded to Plaintiff;

G. That Plaintiff be granted such other and further relief that is just and proper under the circumstances.

Dated: May 18, 2016

Respectfully submitted,

/s/ Matthew J.M. Prebeg

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