

**IN THE UNITED STATES DISTRICT COURT  
FOR THE EASTERN DISTRICT OF MICHIGAN**

BOS GMBH & CO. KG and BOS  
AUTOMOTIVE PRODUCTS, INC.,

Plaintiffs,

v.

MACAUTO USA, INC., KUNSHAN  
MACAUTO AUTOMOBILE PARTS  
INDUSTRY CO., LTD., and MACAUTO  
INDUSTRIAL CO., LTD.,

Defendants.

Case No. \_\_\_\_\_

**JURY TRIAL DEMANDED**

**COMPLAINT FOR PATENT INFRINGEMENT**

Plaintiffs BOS GmbH & Co. KG (“BOS Germany”) and BOS Automotive Products, Inc. (“BOS USA”) (collectively, “BOS” or “Plaintiffs”) hereby assert a claim for patent infringement against Defendants Macauto USA, Inc. (“Macauto USA”), Kunshan Macauto Automobile Parts Industry Co., Ltd. (“Macauto China”), and Macauto Industrial Co., Ltd. (“Macauto Taiwan”) (collectively, “Macauto” or “Defendants”), and in support thereof allege, based on actual knowledge as to Plaintiffs’ own activities and on information and belief as to the activities of others, as follows:

### **Nature of the Action**

1. This is an action for patent infringement arising under the patent laws of the United States, 35 U.S.C. § 1 *et seq.*, specifically including 35 U.S.C. § 271.

2. As set forth in detail below, Macauto USA, Macauto China and Macauto Taiwan have infringed U.S. Patent No. 7,188,659 (“the ‘659 Patent”), both individually and through their combined actions, in connection with supplying certain retractable rear window shades to automobile manufacturers and/or automotive parts suppliers in the United States, including but not limited to the retractable rear window shades installed on certain 2017 Lincoln Continentals sold by the Lincoln Motor Company.

### **The Parties**

3. BOS Germany is a company organized under the laws of Germany, with its principal place of business at Ernst-Heinkel-Strasse 2, Ostfildern, Germany 73760. BOS Germany is the owner of the ‘659 Patent.

4. BOS USA is a corporation organized under the laws of the State of Delaware, with its principal place of business at 2956 Waterview Drive, Rochester Hills, Michigan 48309, within this judicial district. BOS USA is a wholly owned subsidiary of B&O Holding GmbH, which is in turn wholly owned by BOS Germany. The Rochester Hills facility serves as both the North American headquarters for BOS’ business and as BOS’ customer service center for the North

American automotive industry. BOS USA is the exclusive licensee of the ‘659 Patent.

5. Macauto USA is a corporation organized under the laws of the State of New York, with its principal place of business at 80 Excel Drive, Rochester, New York 14621. Macauto USA is registered to do business in the State of Michigan, and it maintains an engineering and sales office at 2654 Elliott Avenue, Troy, Michigan 48083, within this judicial district. Macauto USA is a wholly owned subsidiary of the Macauto Group GmbH (“the Macauto Group”).

6. Macauto China is a corporation organized under the laws of China, with its headquarters at No. 369, Jinyang East Road, Lujia, Kunshan, 215331, China. Macauto China is a wholly owned subsidiary of the Macauto Group.

7. Macauto Taiwan is a corporation organized under the laws of Taiwan, with its headquarters at No. 13, Lane 762, Chungshan North Road, Yung Kang District 710, Tainan City, Taiwan. Macauto Taiwan is the parent corporation of the Macauto Group.

8. BOS USA sells retractable rear window shades to customers in the United States, serving the same market in which Macauto sells its infringing products.

**Jurisdiction and Venue**

9. This Court has subject matter jurisdiction over this patent infringement action pursuant to 28 U.S.C. §§ 1331 and 1338(a).

10. This Court has personal jurisdiction over Macauto USA pursuant to the Michigan Long-arm Statute, Mich. Comp. Laws § 600.715, at least because Macauto USA: (i) has transacted business in Michigan, (ii) has committed acts of infringement in Michigan, (iii) maintains an office in Michigan, and (iv) has entered into contracts to furnish material in Michigan. More particularly, on information and belief, Macauto USA, working through its office in Troy, Michigan, has contracted to supply, and has supplied, infringing retractable rear window shades to automobile manufacturers and/or automotive parts suppliers located within this judicial district, including but not necessarily limited to Lincoln Motor Company in Dearborn, Michigan.

11. This Court has personal jurisdiction over Macauto China pursuant to the Michigan Long-arm Statute, Mich. Comp. Laws § 600.715, at least because Macauto China has sold to Macauto USA in the United States infringing retractable rear window shades knowing that such products were specifically designed for, and intending that such products would be supplied to, automobile manufacturers and/or automotive parts suppliers located within this judicial district, including but not necessarily limited to Lincoln Motor Company in

Dearborn, Michigan. By supplying infringing products to Macauto USA knowing that they would be supplied to customers in Michigan, Macauto China purposefully directed its activities towards Michigan, and thus this Court's exercise of personal jurisdiction over Macauto China is reasonable and consistent with the requirements of the Due Process Clause of the United States Constitution.

12. This Court has personal jurisdiction over Macauto Taiwan pursuant to the Michigan Long-arm Statute, Mich. Comp. Laws § 600.715, at least because Macauto Taiwan: (i) has transacted business in Michigan, (ii) has committed acts of infringement in Michigan, and (iii) has entered into contracts to furnish material in Michigan. More particularly, on information and belief, Macauto Taiwan has designed, manufactured, imported and sold infringing retractable rear window shades to automobile manufacturers and/or automotive parts suppliers in Michigan, including but not necessarily limited to Ford Motor Company in Dearborn, Michigan. Further, by designing, manufacturing, importing and selling infringing products knowing that they would be supplied to automobile manufacturers and/or automotive parts suppliers in Michigan, Macauto Taiwan purposefully directed its activities towards Michigan, and thus this Court's exercise of personal jurisdiction over Macauto Taiwan is reasonable and consistent with the requirements of the Due Process Clause of the United States Constitution.

13. Venue may lie in this judicial district pursuant to 28 U.S.C. §§ 1391(b)-(d) and/or 1400(b) at least because Macauto USA is deemed to reside in this judicial district by virtue of maintaining an office here, and because a substantial part of the events giving rise to this infringement claim occurred here.

14. Joinder of BOS' claims against Macauto USA, Macauto China and Macauto Taiwan is permissible under 35 U.S.C. § 299 because (a) BOS is seeking to hold Defendants jointly and severally liable for infringement of the '659 Patent, and the claims against each Defendant arise out of the same transaction, occurrence, or series of transactions or occurrences relating to the making, using, importing, offering for sale, or selling of the same accused products, and (b) questions of fact common to all Defendants will arise in this action. More particularly, on information and belief, Macauto China and/or Macauto Taiwan design and/or manufacture the accused retractable rear window shades, Macauto China sells the accused retractable rear window shades to Macauto USA for resale to automobile manufacturers and/or automotive parts suppliers in the United States, and Macauto Taiwan sells and/or otherwise supplies the accused retractable rear window shades to automobile manufacturers and/or automotive parts suppliers in the United States.

**The Patent-in-Suit**

15. The '659 Patent, titled "Injection-Molded Plastic Guide Rail," was duly and legally issued by the United States Patent and Trademark Office on March 13, 2007. The '659 Patent issued from U.S. Patent Application No. 10/932,758 filed September 2, 2004, and it claims priority to German Patent Application No. 103 39 583 filed August 28, 2003. A true and correct copy of the '659 Patent is attached hereto as Exhibit A.

16. The '659 Patent is generally directed to a retractable window shade for an automobile having an improved guide rail arrangement for the shade that provides significant benefits in terms of ease and cost of manufacturing. In accordance with particular embodiments of the invention described in the patent, the guide rail arrangement may comprise two elongated molded parts, each of which has a connecting portion and an elongated section formed with a groove that is essentially free of undercuts. When the two parts are interconnected, their respective grooves define an undercut guide groove. Since neither of the elongated parts contain undercuts, it is advantageously possible to manufacture one of the two parts integrally with a section of the inside lining of the so-called "C-columns" of the vehicle (also called "C-pillars").

17. BOS Germany is the owner by assignment of the '659 Patent, having received the entire right, title and interest in and to the inventions covered by the

‘659 Patent, as well as all patents and patent applications related thereto, in an Assignment from the named inventors executed between August 10 and August 18, 2004.

18. BOS USA holds an exclusive license to practice the ‘659 Patent in the United States pursuant to an oral agreement with BOS Germany. Under the terms of that agreement, BOS Germany also promised to exclude others from practicing the ‘659 Patent in the United States, and granted BOS USA a conditional right to initiate suit for infringement of the ‘659 Patent in the event that BOS Germany declines to do so.

**COUNT I**  
**Infringement of U.S. Patent No. 7,188,659**

19. BOS incorporates by reference the allegations in Paragraphs 1 through 18 above.

20. Macauto USA, Macauto China and Macauto Taiwan are directly infringing, inducing others to infringe, and/or contributorily infringing one or more claims of the ‘659 Patent, either literally or under the doctrine of equivalents, by virtue of selling and offering to sell in the United States, and importing into the United States, retractable rear window shade products that satisfy each and every limitation of the asserted claims.

21. On information and belief, Macauto’s infringing retractable rear window shade products are available for purchase as an option, either separately or



as part of an option package, on certain vehicles manufactured and/or sold in the United States by Lincoln Motor Company, including but not limited to the 2017 Lincoln Continental.

22. An example of how Macauto's accused products infringe the '659 Patent follows, based on the information currently available to BOS. This example is not intended to limit the scope of BOS' infringement claim in any way, and is intended to be without prejudice to BOS' ability to assert different or additional claims of the '659 Patent against Macauto and/or to apply such claims to the accused products differently in view of additional information that BOS may acquire during the course of the litigation.

23. Claim 22 of the '659 Patent recites as follows:

22. A guide rail arrangement for window shades in motor vehicles comprising

an first part in the form of an elongated molded part, said first part including a first connecting portion and an elongated section formed with a groove that is essentially free of undercuts and extends continuously over at least a part of the length of the guide rail arrangement,

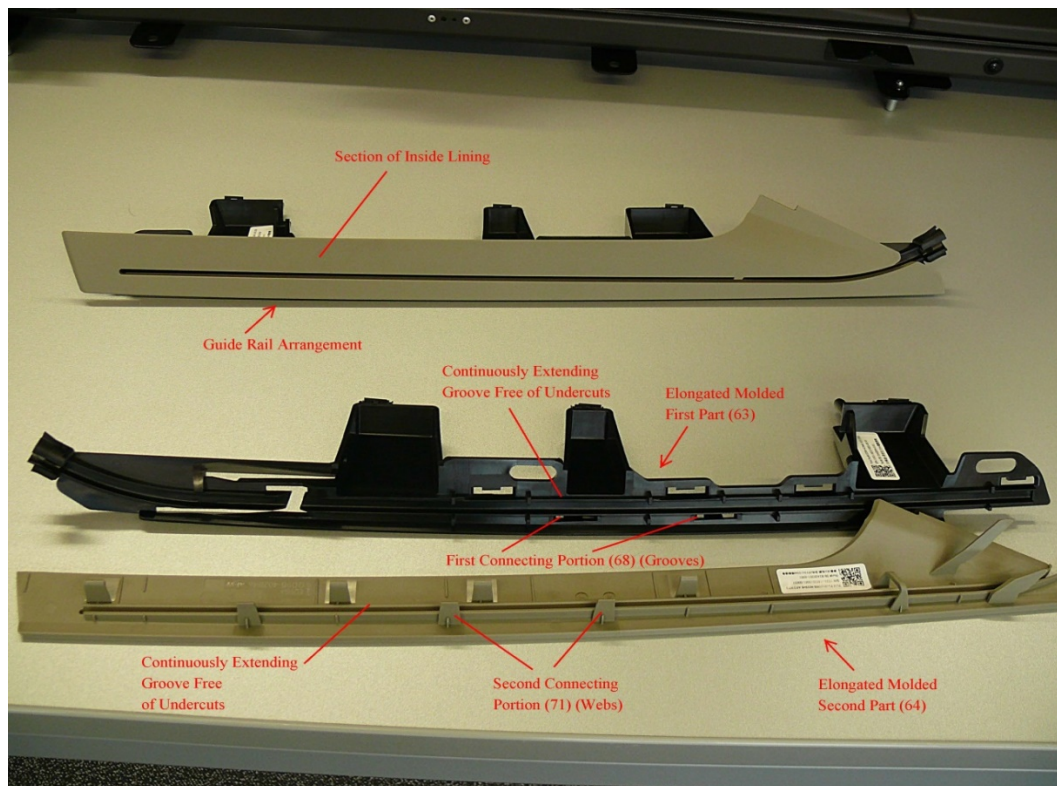
a second part in the form of an elongated molded part, said second part having a second connecting portion and an elongated section formed with a groove that is essentially free of undercuts and extends continuously over at least a part of the length of said guide rail arrangement; and

said connecting parts of said first and second parts being interconnectable to position and retain the first and second parts

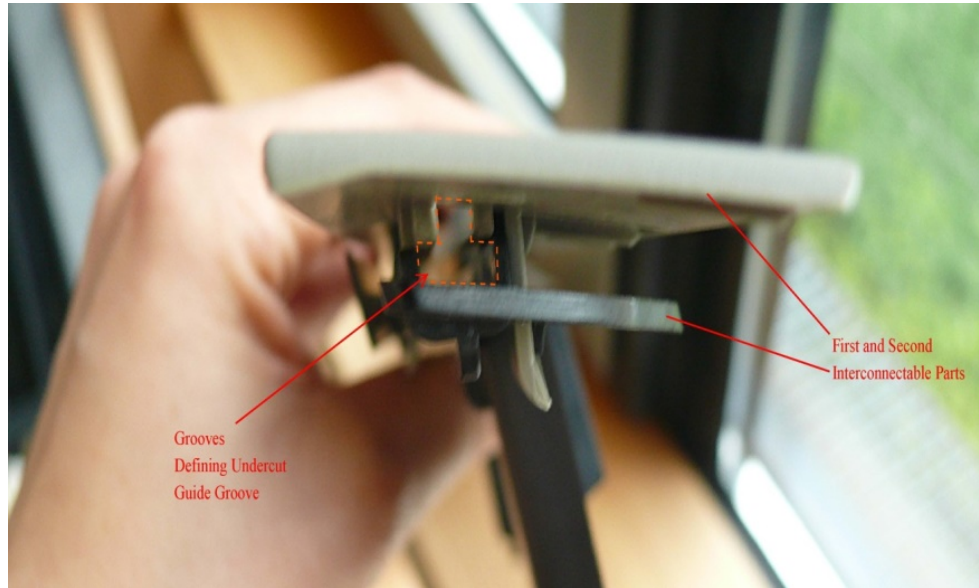
relative to one another with said grooves of said first and second parts defining an undercut guide groove.

'659 Patent at 9:17-33 (internal reference numbers omitted). On information and belief, Macauto's accused retractable rear window shade products satisfy each and every limitation of claim 22.

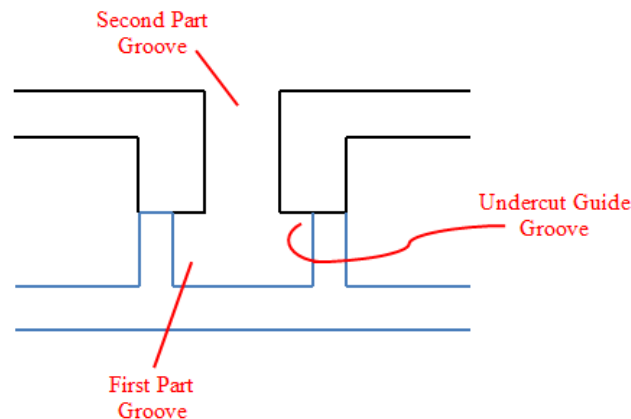
24. The guide rail portion of a sample of Macauto's accused retractable rear window shade products, which was purchased from Huntington Ford in Rochester Hills, Michigan on August 17, 2016, is depicted in the photograph below, shown assembled in the upper portion of the photograph and disassembled in the lower portion, with annotations identifying where various elements of claim 22 can be found:



25. In the photograph below, the first and second parts are shown interconnected via the connecting portions. It can be seen that the grooves of the first and second parts come together to define an undercut guide groove, shown by the dashed red outline:



26. The drawing below depicts a cross-sectional view of one guide rail in the accused product, showing more clearly how the upper and lower parts come together to form the undercut guide groove:



27. The foregoing photographs and illustration confirm that Macauto's accused retractable rear window shade products literally satisfy each and every element of at least claim 22, thus literally infringing the '659 Patent. To the extent any element of claim 22 is deemed not to be literally satisfied, the accused products would nevertheless still infringe under the doctrine of equivalents because any differences between the claimed invention and the accused products are insubstantial.

28. Macauto USA sells the accused retractable rear window shade products to automobile manufacturers and/or automotive parts suppliers in this judicial district and elsewhere in the United States. In addition, Macauto USA imports the accused products into the United States, as evidenced by the bill of lading report attached hereto as Exhibit B. Macauto USA thus directly infringes the '659 Patent in violation of 35 U.S.C. § 271(a).

29. Macauto China sells the accused retractable rear window shade products to Macauto USA for resale to automobile manufacturers and/or automotive parts suppliers in the United States. Macauto China manufactures or otherwise acquires the accused products in China and then ships them to Macauto USA pursuant to purchase orders that specify FOB ("Free on Board") shipping to Rochester, New York, such that legal title to the infringing products does not pass from Macauto China to Macauto USA until the products are in the United States.

Accordingly, this activity constitutes a sale of the accused products in the United States by Macauto China. Macauto China thus directly infringes the '659 Patent in violation of 35 U.S.C. § 271(a).

30. Macauto Taiwan sells the accused retractable rear window shade products to automobile manufacturers and/or automotive parts suppliers in this judicial district and elsewhere in the United States, including but not necessarily limited to Ford Motor Company, as evidenced by the bill of lading report attached hereto as Exhibit B. Macauto Taiwan thus directly infringes the '659 Patent in violation of 35 U.S.C. § 271(a).

31. Macauto USA, Macauto China and Macauto Taiwan are each aware of the '659 Patent. By letter dated December 12, 2013, a lawyer representing the Macauto Group and Macauto Taiwan contacted BOS Germany seeking a license under "the patent family DE 103 39 583 B1," which includes the '659 Patent. By letter dated January 28, 2014, a lawyer representing BOS Germany responded that no such license would be granted. Consequently, Macauto USA, Macauto China and Macauto Taiwan know that the sale and use of the accused retractable rear window shade products infringes the '659 Patent.

32. Macauto China sells the accused retractable rear window shade products to Macauto USA in the United States knowing and intending that Macauto USA will resell those products to automobile manufacturers and/or

automotive parts suppliers in the United States, and Macauto China encourages and assists Macauto USA in such resale through the provision of marketing and/or product literature (e.g., installation instructions, user guides), all while knowing that such resale by Macauto USA and subsequent use by drivers will infringe the '659 Patent. Accordingly, Macauto China is inducing infringement of the '659 Patent by Macauto USA and drivers in violation of 35 U.S.C. § 271(b).

33. Macauto USA sells the accused retractable rear window shade products to automobile manufacturers and/or automotive parts suppliers in the United States intending that such customers will resell those products, either installed in a vehicle (in the case of automobile manufacturers) or as part of a retractable window shade assembly that is sold to an automobile manufacturer for installation in a vehicle (in the case of automotive parts suppliers). In either case, Macauto USA knows that such resales by its customers and subsequent use by drivers will infringe the '659 Patent, and Macauto USA encourages and assists its customers in such resales through the provision of marketing literature, product literature (e.g., installation instructions, user guides), customer service, and warranty support. Accordingly, Macauto USA is inducing infringement of the '659 Patent by its customers and drivers in violation of 35 U.S.C. § 271(b).

34. Macauto Taiwan sells the accused products to automobile manufacturers and/or automotive parts suppliers in the United States intending that

such customers will resell those products, either installed in a vehicle (in the case of automobile manufacturer customers) or as part of a retractable window shade assembly that is sold to an automobile manufacturer for installation in a vehicle (in the case of automotive parts supplier customers). In either case, Macauto Taiwan knows that such resales by its customers and subsequent use by drivers will infringe the '659 Patent, and Macauto Taiwan encourages and assists its customers in such resales through the provision of marketing literature, product literature (e.g., installation instructions, user guides), customer service and warranty support (either itself or through Macauto USA). Accordingly, Macauto Taiwan is inducing infringement of the '659 Patent by its customers and drivers in violation of 35 U.S.C. § 271(b).

35. The accused retractable rear window shade products sold by Macauto China, Macauto USA and Macauto Taiwan constitute a material part of the invention covered by the '659 Patent and have no substantial noninfringing use. Moreover, Macauto China, Macauto USA and Macauto Taiwan sell the accused products within the United States knowing that they are especially adapted for use in a manner that infringes the '659 Patent, and intending that they be used in that manner. Accordingly, at least to the extent the accused products are sold to (a) automotive parts suppliers in the United States for installation in retractable rear window shade assemblies that are then sold to automobile manufacturers for



installation in vehicles, or (b) automobile manufacturers in the United States for installation in vehicles, Macauto China, Macauto USA and Macauto Taiwan are contributing to infringement of the '659 Patent in violation of 35 U.S.C. § 271(c).

36. Macauto's infringement of the '659 Patent has caused BOS to suffer substantial monetary harm, including lost profits and price erosion relating to BOS USA's sale of competing products in the same market served by Macauto USA.

37. Macauto's infringement of the '659 Patent has caused and will continue to cause irreparable harm to BOS for which there is no adequate remedy at law, including but not limited to lost market share and/or lost goodwill that BOS would otherwise garner as the recognized innovator and sole authorized source of supply for retractable rear window shades covered by the '659 Patent.

38. Macauto's infringement of the '659 Patent has been willful, done deliberately and with full knowledge that the importation, sale, offer to sell and use of the accused retractable rear window shade products infringes the '659 Patent, and without any reasonable, good-faith belief that the '659 Patent is invalid and/or not infringed, thereby justifying an increase in the damages to be awarded BOS up to three times the amount found or assessed, in accordance with 35 U.S.C. § 284.

39. Macauto's willful infringement of the '659 Patent renders this an exceptional case within the meaning of 35 U.S.C. § 285, justifying an award to BOS of its reasonable attorney fees incurred in connection with this litigation.



**PRAYER FOR RELIEF**

WHEREFORE, BOS Germany and BOS USA pray for a judgment in their favor granting the following relief:

A. A finding that Macauto USA, Macauto China and Macauto Taiwan have infringed the ‘659 Patent, holding them jointly and severally liable for such infringement;

B. A permanent injunction barring Macauto USA, Macauto China and Macauto Taiwan, and all persons acting in concert with them, from infringing the ‘659 Patent;

C. An award of monetary damages pursuant to 35 U.S.C. § 284 in an amount adequate to compensate BOS Germany and BOS USA for Macauto USA, Macauto China and Macauto Taiwan’s infringement of the ‘659 Patent;

D. An order requiring Macauto USA, Macauto China and Macauto Taiwan to pay BOS Germany and BOS USA supplemental damages for any continuing post-verdict infringement up until entry of the final judgment, with an accounting, as needed;

E. A finding that Macauto USA, Macauto China and Macauto Taiwan’s infringement of the ‘659 Patent has been willful;

F. An increase in the damages awarded to BOS Germany and BOS USA up to three times the amount found by the jury or assessed by the Court, pursuant to 35 U.S.C. § 284;

G. A finding that this is an exceptional case within the meaning of 35 U.S.C. § 285, and a corresponding award of BOS Germany and BOS USA's reasonable attorney fees incurred in connection with this litigation;

H. An award of pre-judgment interest, post-judgment interest and costs, in amounts to be fixed by the Court; and

I. Any additional and further relief the Court deems just and proper.

### **JURY DEMAND**

Pursuant to Federal Rule of Civil Procedure 38(b), BOS hereby demands a trial by jury on all issues so triable.

Dated: February 13, 2017

**KERR, RUSSELL AND WEBER, PLC**

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