

**IN THE UNITED STATES DISTRICT COURT
FOR THE EASTERN DISTRICT OF WISCONSIN
GREEN BAY DIVISION**

ORION ENERGY SYSTEMS, INC.

Plaintiff,

v.

ENERGY BANK, INC. and Neal R. Verfuerrth,
Defendants.

Civil Action No. 16-cv-01250

JURY TRIAL DEMANDED

**FIRST AMENDED COMPLAINT FOR PATENT INFRINGEMENT
AND OTHER RELIEF**

Plaintiff Orion Energy Systems, Inc. (“Orion”), through its undersigned counsel, alleges as follows against Defendant Energy Bank, Inc. (“Energy Bank”) and Defendant Neal R. Verfuerrth (“Verfuerrth”), collectively “Defendants”:

INTRODUCTION

1. Orion is a leader in the transformation of commercial and industrial buildings to state-of-the-art, energy efficient, solid state lighting systems through original and retrofit solutions. Orion was founded in 1996 and is headquartered in Manitowoc, WI.

2. Orion manufactures and markets a cutting edge portfolio of products encompassing light emitting diode (“LED”) lighting with modular designs. Orion’s products provide flexible, cost-effective, and safe lighting fixtures for retrofit into existing spaces and long term solutions for new spaces.

3. For approximately sixteen years, Mr. Neal R. Verfuerrth, had been employed by Orion, most recently for a number of years as Chief Executive Officer. Mr. Verfuerrth resigned in October 2012 and on November 8, 2012, the Board terminated Mr. Verfuerrth’s employment

for cause. Mr. Verfuert had been associated with Orion for sixteen years prior to leaving to form Energy Bank, a competitor with Orion with respect to energy efficient lighting systems. On October 14, 2012, Mr. Verfuert formed Defendant Energy Bank, Inc.

4. Energy Bank is alleged herein to have made unauthorized use of Orion's patented technology, and to have misrepresented that Energy Bank owns or is authorized to use Orion's intellectual property. Energy Bank has engaged in the manufacture and sale of lighting systems that use Orion's intellectual property.

NATURE OF THE CASE

5. This action arises under 35 U.S.C. § 271 for Energy Bank's infringement of U.S. Patent No. 8,337,043 (the "'043 patent") and U.S. Patent No. 8,858,018 (the "'018 patent") (collectively "the patents-in-suit"), under 15 U.S.C. § 1125 of the Lanham Act, and Wisconsin law.

THE PARTIES

6. Plaintiff Orion is a corporation organized under the laws of the State of Wisconsin and headquartered at 2210 Woodland Drive, Manitowoc, WI 54220.

7. On information and belief, Defendant Energy Bank, Inc. is a corporation organized under the laws of the State of Wisconsin and has its principal place of business at 4466 Custer Street, Manitowoc, WI 54220, and may be served through its registered agent, Neal R. Verfuert at 4466 Custer Street, Manitowoc, WI 54220.

8. On information and belief, Defendant Neal R. Verfuert is an individual who resides at 4466 Custer Street, Manitowoc, WI 54220.

JURISDICTION AND VENUE

9. This action arises under the patent laws of the United States, 35 U.S.C. § 271 *et seq.* and under the Lanham Act 15 U.S.C. § 1051 *et seq.* and under Wisconsin common law. This

Court has subject matter jurisdiction under 28 U.S.C. §§ 1331, 1338(a), and 1367.

10. Venue is proper in this Court pursuant to 28 U.S.C. §§ 1391(b) and (c) and 1400(b).

11. Personal jurisdiction exists over Energy Bank because Energy Bank resides in Wisconsin, conducts business in Wisconsin, including by maintaining its headquarters in Wisconsin, and because infringement has occurred and continues to occur in Wisconsin by, *inter alia*, Energy Bank's sale and offers to sell infringing products.

12. Personal jurisdiction exists over Mr. Verfueth because he is domiciled in Wisconsin.

FACTUAL BACKGROUND

13. Orion is the current assignee, and the sole and exclusive owner of all right, title and interest in United States Patent No. 8,337,043, entitled "Modular Light Fixture With Power Pack." The '043 patent was duly and legally issued by the United States Patent and Trademark Office ("USPTO") on December 25, 2012. A copy of the '043 patent is attached hereto as Exhibit A, ECF 1-1.

14. Orion is the current assignee, and the sole and exclusive owner of all right, title and interest in United States Patent No. 8,858,018, entitled "Modular Light Fixture With Power Pack." The '018 patent was duly and legally issued by the USPTO on October 14, 2014. A copy of the '018 patent is attached hereto as Exhibit B, ECF 1-2.

15. On information and belief, on October 14, 2012, shortly after he ceased serving as CEO of Orion, Mr. Verfueth filed paperwork with the Wisconsin Secretary of State to incorporate his new company, Energy Bank, Inc.

16. Energy Bank describes its LightSource products as modular LED lighting platforms, state-of-the-art, and energy efficient, designed for quick and easy installation. The

LightSource product also comes with an optional plug n' play power supply.

17. Energy Bank promotes those products in interstate commerce at least via its website energybankinc.com. Energy Bank's website makes misleading statements about its products, falsely suggesting that Energy Bank owns the rights to the inventions claimed in Orion's patent portfolio.

18. A snapshot of Energy Bank's website, taken September 12, 2016, includes a list of more than 60 patents owned by Orion, including the patents-in-suit. See Exhibit C, ECF 1-3.

19. Energy Bank, through its website, implies that the list of 60 patents are owned by Energy Bank stating, for example: "Welcome to energybank, where we proudly design, manufacture and integrate LED Done Right®, a unique and refreshingly different approach. energybank was founded by one of the nation's top 500 inventors, Neal R. Verfueth, who has 62 US patents issued, 84 applications filed and 639 total citations in the areas of lighting, controls and daylighting technology. Based on timeless principles of physics, his inventions have been installed in 10,000 facilities worldwide, including 150 of the Fortune 500. At energybank, we are shaping the future narrative of the illumination industry with bold, industry-leading LED designs and proprietary innovations." See Exhibit C, ECF 1-3.

20. Energy Bank falsely implies it has rights in the Orion patents.

21. Energy Bank also includes on its website numerous awards and recognitions, including, but not limited to, "Presidential Visit 2009 and 2011" and "2008 Product of the Year." Orion won these awards and Presidential Visits, not Energy Bank. See Exhibit D, ECF 1-4.

22. Energy Bank falsely takes credit for Orion's accomplishments and recognitions.

23. While he was the CEO of Orion and before Mr. Verfueth founded Energy Bank, he assigned to Orion all right, title, and interest in his inventions, including any inventions previously developed, discovered, made, authored or conceived by him and any such future

inventions created during the term of his employment. See ECF 15-3, p.3, ¶1A.

24. As specifically identified in Verfuert's Employment Agreement, "Expiration of this Agreement will not affect the rights or obligations of the parties hereunder arising out of, or relating to, circumstances occurring prior to the expiration of this Agreement, which rights and obligations will survive the expiration of this Agreement." ECF 15-3, p.2 ¶ 1.

25. The Employment Agreement also specified that Orion pay Mr. Verfuert \$950,000 in a lump sum cash payment in consideration of terminating his previous employment agreement with Orion and "to irrevocably transfer, convey and assign all of [Verfuert's] right, title and interest in and to all Intellectual Property Work Product and all other Innovations developed, discovered, made, authored or conceived by [Verfuert], whether prior to the date of this Agreement or during the term of this Agreement, to [Orion]." ECF 15-3, p.2 ¶ 1A.

26. In addition to his Employment Agreement, Mr. Verfuert also signed a separate Assignment document acknowledging that his assignment was supported by valuable consideration, which was filed in the USPTO (the "PTO Assignment") in support of patent applications directed to his inventions. ECF 15-1, p.3; 15-2, p. 7.

27. Mr. Verfuert also agreed in his PTO Assignment that, among other things, he would "provide all reasonable assistance to [Orion], its successors and assigns, in obtaining and enforcing proper title in and protection for said invention or inventions, improvements, and modifications under the intellectual property laws of the United States and countries foreign thereto." ECF 15-1, p. 5; *see also* ECF 15-3, p.14, ¶ 7(c)(iii).

28. Mr. Verfuert also agreed in his PTO Assignment that, among other things, he "has the full and unencumbered right to sell, assign, and transfer the interests sold, assigned, and transferred herein, and that [Verfuert] has not executed and will not execute any document or instrument in conflict herewith." ECF 15-1, p.5.

29. Mr. Verfueth further executed an inventor's Declaration which was submitted to the USPTO in connection with the application for the '043 Patent (which is also the parent of the asserted '018 Patent) (the "PTO Declaration"). ECF 15-4.

30. In his sworn PTO Declaration, Mr. Verfueth attested that, among other things, he was the original, first, and joint inventor of the invention; that the invention was not known or ever used by others in the United States, or patented or described in any printed publication in any country, before he and his joint inventors invented it; that the invention was not patented or described in any printed publication in any country, or in public use or on sale in the United States for more than one year prior to the filing date of the U.S. application; and, that the invention met other requirements of patentability. ECF 15-4, p.2-3.

31. When Mr. Verfueth left Orion, the application that later matured into the '043 Patent was pending before the USPTO. ECF 1-1. Orion subsequently filed the application that matured into the '018 Patent as a continuation-in-part of the underlying '043 patent application. ECF 1-2.

32. Orion duly recorded Mr. Verfueth's assignment of his rights in the inventions underlying these applications with the USPTO.

**COUNT ONE
INFRINGEMENT OF THE '043 PATENT**

33. Orion hereby incorporates the allegations of Paragraphs 1 through 32 of this Complaint as if fully set forth therein.

34. Orion is the owner of all right, title, and interest in the '043 patent.

35. Defendant Energy Bank has been, is currently, and unless enjoined will continue to infringe, contribute to the infringement of, and/or induce others to infringe one or more claims of the '043 patent.

36. Energy Bank had knowledge of the '043 patent at least because Mr. Verfuert is a named inventor of the '043 patent.

37. In taking the acts herein alleged to constitute induced infringement, Energy Bank knew or should have known that its acts would result in the actual infringement by one or more of its customers of one or more of the claims of the '043 patent, and thereby intended such infringement. Energy Bank's acts did, in fact, induce such infringement of one or more claims of the '043 patent.

38. With respect to the acts herein alleged to constitute contributory infringement, Energy Bank knew that the products and/or components thereof identified herein as having been supplied by Energy Bank were especially made or especially adapted for use in an infringing combination, and that such specific products and/or components thereof were not staple articles or commodities of commerce suitable for substantial non-infringing use.

39. Energy Bank has infringed the '043 patent by, among other things, making, using, offering to sell, selling, installing, configuring, or operating within the United States the LightSource Product by encouraging its customers to use the patented features of the '043 patent. The LightSource product is pictured here:



40. Energy Bank has infringed at least claim 16 of the '043 patent. Exemplary

reasons why Energy Bank infringes claim 16 are as follows:

- a. Claim 16 is a method that includes “providing a preassembled light fixture, wherein the light fixture comprises a first raceway and a second raceway configured to have a power pack extending at least partially between the first and second raceway.” As illustrated in the picture above, and upon information and belief, the LightSource product includes a first raceway, a second raceway, and a power pack as described in claim 16. Energy Bank’s product literature touts “quick and easy installation.”
- b. Claim 16 further recites, “a detachable cover provided over the power pack and extending between the first and second raceways, and a power input connector coupled to the detachable cover and configured to receive power from a power source and to direct power to the power pack, the power input connector configured to be coupled to the power source without removing the detachable cover from the light fixture.” As illustrated in the picture above in paragraph 39, and upon information and belief, the LightSource product includes a detachable cover, power input connector, and power source as described by claim 16.
- c. Claim 16 further recites, “connecting the power input connector to a power supply line electrically coupled to the power source without removing the detachable cover.” As described in the literature on Energy Bank’s website, and as shown below, the LightSource product includes a power input connector as described in claim 16, where the power input connector can be connected to the power supply line electrically coupled to the power source without removing the detachable cover.

Optional
plug`n play
power supplies



Winsta (WAGO)



MATE-N-LOK



41. On information and belief, Energy Bank has willfully infringed and continues to willfully infringe one or more claims of the '043 patent despite its knowledge of the '043 patent and despite an objectively high likelihood that the sale and use of the accused product would directly and indirectly infringe one or more claims of the '043 patent.

42. As a direct and proximate consequence of Energy Bank's infringement of the '043 patent, Orion has suffered and will continue to suffer irreparable injury and damages, in an amount that an award of money would never be adequate to fully remedy, for which Orion is entitled to relief. Orion seeks damages, as well as injunctive relief against further infringement.

COUNT TWO INFRINGEMENT OF THE '018 PATENT

43. Orion hereby incorporates the allegations of Paragraphs 1 through 42 of this Complaint as if fully set forth therein.

44. Orion is the owner of all right, title, and interest in the '018 patent.

45. Defendant Energy Bank has been, is currently, and unless enjoined will continue to infringe, contribute to the infringement of, and/or induce others to infringe one or more claims

of the '043 patent.

46. Energy Bank had knowledge of the '018 patent at least because Mr. Verfuert is a named inventor of the '018 patent.

47. In taking the acts herein alleged to constitute induced infringement, Energy Bank knew or should have known that its acts would result in the actual infringement by one or more of its customers of one or more of the claims of the '018 patent, and thereby intended such infringement. Energy Bank's acts did, in fact, induce such infringement of one or more claims of the '043 patent.

48. With respect to the acts herein alleged to constitute contributory infringement, Energy Bank knew that the products and/or components thereof identified herein as having been supplied by Energy Bank were especially made or especially adapted for use in an infringing combination, and that such specific products and/or components thereof were not staple articles or commodities of commerce suitable for substantial non-infringing use.

49. Energy Bank has infringed the '018 patent by making, using, offering to sell, selling, installing, configuring, or operating within the United States the LightSource Product by encouraging its customers to use the patented features of the '018 patent. The LightSource product is pictured here:



50. Energy Bank has infringed and continues to directly infringe at least claim 1 of the '018 patent. Exemplary reasons why Energy Bank infringes claim 1 are as follows:

- a. Claim 1, as described in the preamble as at “a light fixture,” requires “a first raceway at a first end of the light fixture; a second raceway at a second opposing end of the light fixture; at least one support structure extending between and coupled to the first and second raceways.” As illustrated in the picture above, the LightSource product includes a first raceway, a second raceway, and at least one support structure as described in the claim.
- b. Claim 1 further recites “a plurality of light emitting diodes (LEDs) coupled to the at least one support structure and spaced apart along at least a portion of a length of the at least one support structure between the first and second ends of the light fixture.” As also illustrated in the picture above, on information and belief, the LightSource product includes a plurality of LED lights that are spaced apart along at least a portion of the length of the support structure.
- c. Claim 1 further recites “a power pack extending between the first and second raceways, wherein the power pack includes at least one driver configured to be electrically coupled to the plurality of LEDs, power input wiring that is configured to receive power for the light fixture, and a detachable cover provided substantially over the at least one driver and the power input wiring.” As illustrated in the picture above, on information and belief, the LightSource product includes a power pack as described in claim 1.

- d. Claim 1 further recites “a modular power input connector coupled to the power pack, wherein the modular power input connector is configured to allow a power cord to supply power to the light fixture without removing the cover.” As described in the literature on Energy Bank’s website, and as shown below, the LightSource product includes a modular power input connector as described in claim 1.

Optional
plug 'n play
power supplies



Winsta (WAGO)



MATE-N-LOK

51. On information and belief, Energy Bank has willfully infringed and continues to willfully infringe one or more claims of the '018 patent despite its knowledge of the '018 patent and despite an objectively high likelihood that the sale and use of the accused product would directly and indirectly infringe one or more claims of the '018 patent.

52. As a direct and proximate consequence of Energy Bank’s infringement of the '018 patent, Orion has suffered and will continue to suffer irreparable injury and damages, in an amount that an award of money would never be adequate to fully remedy, for which Orion is entitled to relief. Orion seeks damages, as well as injunctive relief against further infringement.

COUNT THREE
VIOLATION OF THE LANHAM ACT § 1125
FALSE DESIGNATIONS OF ORIGIN AND FALSE DESCRIPTIONS

53. Orion hereby incorporates the allegations of Paragraphs 1 through 52 of this Complaint as if fully set forth therein.

54. Energy Bank's false and misleading claims regarding Orion's patents and Orion's accomplishments and awards in connection with its offers for sale and the sale its of products and services in interstate commerce constitutes false or misleading descriptions of fact, or false or misleading representations of fact, which are likely to deceive a substantial number of potential customers as to the nature of Energy Bank's products, thereby likely influencing their purchasing decisions in violation of 15 U.S.C. § 1125(a)(1).

55. Upon information and belief, Energy Bank's past and continued activities and conduct have been willful and deliberate, and knowingly and intentionally designed to misrepresent the nature of its goods and to deceive potential customers.

56. On information and belief, Orion has been injured by Energy Bank's false and misleading statements, and is likely to be injured in the future by, among other things, the diversion of sales from Orion to Energy Bank.

57. Energy Bank's activities, on information and belief, have, and will continue to cause irreparable injury and damage to Orion unless restrained by this Court.

58. Orion's remedy at law for Defendant's violations of 15 U.S.C. § 1125(a) is inadequate to fully and completely compensate it.

59. Accordingly, Orion is entitled to recover its damages, as well as Energy Bank's profits received as a result of those activities and conduct, and the costs of this action pursuant to 15 U.S.C. § 1117(a).

COUNT FOUR
BREACH OF CONTRACT

60. Orion hereby incorporates the allegations of Paragraphs 1 through 59 of this Complaint as if fully set forth therein.

61. As reflected in his Employment Agreement, Mr. Verfuert assigned all right, title and interest in and to all Intellectual Property Work Product and all other Innovations developed, discovered, made, authored or conceived by Verfuert, whether prior to the date of this Agreement or during the term of this Agreement, to Orion. ECF 15-3, p. 3 ¶ 1A; see also p. 15 ¶ (7)(c).

62. As also reflected in his Employment Agreement, Mr. Verfuert agreed to execute all papers necessary and to provide proper assistance, during and subsequent to his employment to enable Orion to obtain for itself or others all right, title, and interest patent and other legal protection for such Innovations. ECF 15-3, p. 15 ¶ (7)(c)(iii).

63. Mr. Verfuert executed the PTO Assignment document where he assigned to Orion of his rights in the invention relating to “Modular Light Fixture With Power Pack” for good and valuable consideration of all right, title, and interest in his inventions, including any inventions previously developed, discovered, made, authored or conceived and any such future inventions created during the term of his employment. ECF 15-1.

64. Mr. Verfuert’s PTO Assignment also assured that, among other things, that he had the full and unencumbered right to sell, assign, and transfer the interests sold, assigned, and transferred herein, and that he has not executed and will not execute any document or instrument in conflict herewith. ECF 15-1, p. 5.

65. Mr. Verfuert’s PTO Assignment also assured that he agreed, “to provide all reasonable assistance to [Orion], its successors and assigns, in obtaining and enforcing proper

title in and protection for said invention or inventions, improvements, and modifications under the intellectual property laws of the United States and countries foreign thereto.” ECF 15-1, p. 5.

66. Through his PTO Declaration, Mr. Verfueth’s further attested to certain statements related to the patentability of the “Modular Light Fixture With Power Pack” inventions, including: that he was the original, first, and joint inventor of the invention; that the invention was not known or ever used by others in the United States, or patented or described in any printed publication in any country, before he and his joint inventors invented it; that the invention was not patented or described in any printed publication in any country, or in public use or on sale in the United States for more than one year prior to the filing date of the U.S. application; and, that the invention met other requirements of patentability. ECF 15-4, p.2-3.

67. Orion has performed all of its obligations under the PTO Assignment contract.

68. Mr. Verfueth has breached the PTO Assignment contract by asserting, through his company Energy Bank, that the Patents In Suit are invalid. Specifically, Mr. Verfueth assigned his rights in the invention for generous compensation, and then he failed to provide reasonable assistance to protect the invention – in fact, he has taken the diametrically opposed view that the Patents In Suit are invalid. In doing so, Mr. Verfueth has breached the PTO Assignment contract.

69. Mr. Verfueth has also breached his implied duty of good faith and fair dealing with respect to the contracts by asserting, through his company Energy Bank, that the Patents In Suit are invalid.

70. Orion has been harmed by Mr. Verfueth’s breaches at least because Orion has had to and will continue to have to expend time and resources to litigate the validity of the patents the Mr. Verfueth previously assigned to Orion for valuable consideration.

PRAYER FOR RELIEF

Orion respectfully requests that the Court enter judgment against Energy Bank and Mr. Verfueth as follows:

- A. That the '043 patent has been infringed by Energy Bank;
- B. That Energy Bank's infringement of the '043 patent has been willful;
- C. An injunction against further infringement of the '043 patent;
- D. An award of damages adequate to compensate Orion for Energy Bank's infringement of the '043 patent, including pre-judgment interest and costs;
- E. That the '018 patent has been infringed by Energy Bank;
- F. That Energy Bank's infringement of the '018 patent has been willful;
- G. An injunction against further infringement of the '018 patent;
- H. An award of damages adequate to compensate Orion for Energy Bank's infringement of the '018 patent, including pre-judgment interest and costs;
- I. An award of all other damages permitted by 35 U.S.C. § 284;
- J. A determination that this is an exceptional case within the meaning of 35 U.S.C. § 285 and an award to Orion of its costs and reasonable attorneys' fees incurred in this action;
- K. Energy Bank pay damages incurred by Orion as a result of Energy Bank's unfair competition and false advertising including in the case of Energy Bank's violation of 15 U.S.C. § 1125(a), and treble damages or treble profits, whichever is greater;
- L. Pursuant to 15 U.S.C. § 1117, that Orion be awarded monetary relief in an amount to be fixed by the Court in its discretion as just, including: all profits received by Energy Bank from sales and revenues of any kind made as a result of its actions;
- M. The Court issue a preliminary injunction restraining, enjoying, and prohibiting Energy Bank and any of its officers, directors, agents, employees, representatives, successors,

assigns, attorneys, licensees, distributors, and all persons in active concert or participation with Defendant to be enjoined from directly or indirectly using Orion's patents to identify, market, distribute, advertise, promote, offer for sale, or provide infringing products or any related goods or services; and continuing acts of false advertising or unfair trade practices herein complained of, or doing any acts that may cause Energy Bank's goods to be mistaken for, confused with, or passed off as licensed under Orion's patents or authorized by Orion;

N. An award of damages adequate to compensate Orion for Mr. Verfuert's breach of contract;

O. Energy Bank be ordered to pay costs of this action, including attorney's fees, incurred by Orion in connection with Energy Bank's unlawful acts;

P. Awarding punitive and exemplary damages as the Court finds appropriate;

Q. Awarding interest, including prejudgment and post-judgment interest, on the foregoing sums; and

R. Such other relief as this Court deems just and proper.

DEMAND FOR JURY TRIAL

Orion Energy Bank Systems, Inc. demands trial by jury on all claims and issues so triable.

Dated: September 19, 2017

Respectfully submitted,

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