

1 ANTON HANDAL (Bar No. 113812)
2 anh@handal-law.com
3 PAMELA C. CHALK (Bar No. 216411)
4 pchalk@handal-law.com
5 GABRIEL HEDRICK (Bar No. 220649)
6 ghedrick@handal-law.com
7 HANDAL & ASSOCIATES
8 1200 Third Avenue, Suite 1321
9 San Diego, California 92101
10 Tel: 619.544.6400
11 Fax: 619.696.0323

12 Attorneys for Plaintiff
13 e.Digital Corporation

14 **UNITED STATES DISTRICT COURT**
15 **SOUTHERN DISTRICT OF CALIFORNIA**

16 e.Digital Corporation,
17 Plaintiff,

18 v.

19 Kingston Technology Company, Inc.,
20 Defendant.

Case No. 3:13-cv-2906-H-BGS

**FIRST AMENDED COMPLAINT
FOR PATENT INFRINGEMENT**

DEMAND FOR JURY TRIAL

**Assigned to the Honorable
Judge Marilyn L. Huff**

Courtroom 15A (Annex)

21 Plaintiff e.Digital Corporation (“e.Digital” or “Plaintiff”), by and through its
22 undersigned counsel, complains and alleges against Defendant Kingston
23 Technology Company, Inc. (“Kingston ” or “Defendant”) as follows:

24 **NATURE OF THE ACTION**

25 1. This is a civil action for infringement of a patent arising under the
26 laws of the United States relating to patents, 35 U.S.C. § 101, *et seq.*, including,
27 without limitation, 35 U.S.C. §§ 271, 281. Plaintiff e.Digital seeks a preliminary
28 and permanent injunction and monetary damages for the infringement of its U.S.

1 Patent No. 5,839,108.

2 **JURISDICTION AND VENUE**

3 2. This court has subject matter jurisdiction over this case for patent
4 infringement under 28 U.S.C. §§ 1331 and 1338(a) and pursuant to the patent laws
5 of the United States of America, 35 U.S.C. § 101, *et seq.*

6 3. Venue properly lies within the Southern District of California
7 pursuant to the provisions of 28 U.S.C. §§ 1391(b), (c), and (d) and 1400(b). On
8 information and belief, Defendant conducts substantial business directly and/or
9 through third parties or agents in this judicial district by selling and/or offering to
10 sell the infringing products and/or by conducting other business in this judicial
11 district. Furthermore, Plaintiff e.Digital is headquartered and has its principal
12 place of business in this district, engages in business in this district, and has been
13 harmed by Defendant's conduct, business transactions and sales in this district.

14 4. This Court has personal jurisdiction over Defendant because, on
15 information and belief, Defendant transacts continuous and systematic business
16 within the State of California and the Southern District of California. In addition,
17 this Court has personal jurisdiction over the Defendant because, on information
18 and belief, this lawsuit arises out of Defendant's infringing activities, including,
19 without limitation, the making, using, selling and/or offering to sell infringing
20 products in the State of California and the Southern District of California. Finally,
21 this Court has personal jurisdiction over Defendant because, on information and
22 belief, Defendant has made, used, sold and/or offered for sale its infringing
23 products and placed such infringing products in the stream of interstate commerce
24 with the expectation that such infringing products would be made, used, sold
25 and/or offered for sale within the State of California and the Southern District of
26 California.

27 5. Upon information and belief, certain of the products manufactured by
28 Defendant Kingston have been and/or are currently sold and/or offered for sale at,

1 among other places, the J& R Electronics website located at <http://www.jr.com> to
2 consumers including, but not limited to, consumers located within the State of
3 California.

4 6. Upon information and belief, certain of the products manufactured by
5 Defendant Kingston have been and/or are currently sold and/or offered for sale at,
6 among other places, the Best Buy website located at <http://www.bestbuy.com> to
7 consumers including, but not limited to, consumers located within the State of
8 California and/or at the Best Buy store located at 5151 Mission Center Rod, San
9 Diego, California 92108.

10 **PARTIES**

11 7. Plaintiff e.Digital is a Delaware corporation with its headquarters and
12 principal place of business at 16870 West Bernardo Drive, Suite 120, San Diego,
13 California 92127.

14 8. Upon information and belief, Defendant Kingston is a corporation
15 registered and lawfully existing under the laws of the State of Delaware, with an
16 office and principal place of business located at 17600 Newhope Street, Fountain
17 Valley, California 92708.

18 **THE ASSERTED PATENT**

19 9. On November 17, 1998, the United States Patent and Trademark
20 Office duly and legally issued United States Patent No. 5,839,108 (“the ’108
21 patent”) entitled “Flash Memory File System In A Handheld Record And Playback
22 Device,” to its named inventors Norbert P. Daberko and Richard K. Davis.
23 Plaintiff e.Digital is the assignee and owner of the entire right, title and interest in
24 and to the ’108 patent and has the right to bring this suit for damages and other
25 relief. A true and correct copy of the ’108 patent is attached hereto as Exhibit A.

26 **COUNT ONE**

27 **INFRINGEMENT OF THE ’108 PATENT BY DEFENDANT**

28 10. Plaintiff re-alleges and incorporates by reference each of the

1 allegations set forth in paragraphs 1 through 9 above.

2 11. The accused products include but are not limited to Kingston's Flash
3 Memory Storage products including but not limited to its USB, SSD, SD,
4 microSD, and/or Compact Flash products. The primary and substantial purpose of
5 the accused products is to write to and store data in electronic format in non-
6 volatile flash memory.

7 12. Kingston has directly and indirectly infringed and is directly and
8 indirectly infringing Claim 1 of the '108 patent in violation of 35 U.S.C. § 271, *et*
9 *seq.*, by making, using, offering for sale, selling in the United States and/or
10 importing into the United States without authority, the accused products identified
11 above. Claim 1 of the '108 patent teaches a method of memory management for a
12 non-volatile storage medium. The method comprises several steps, which generally
13 involves, without limitation, writing electronic data segments from volatile,
14 temporary memory to a non-volatile, long-term storage medium by linking data
15 segments according to a number of specified steps.

16 13. Plaintiff alleges that at least as of the date of the filing of the
17 originally filed complaint in this matter, if not sooner, Kingston knew or should
18 have known of the existence of Claim 1 of the '108 patent and the fact that the
19 accused products infringe said Claim 1.

20 14. Plaintiff alleges that Kingston sold, sells, offers to sell, ships, or
21 otherwise delivers the accused products to customers or end-users with all the
22 features required to infringe Claim 1 of the '108 patent. Upon information and
23 belief, Kingston knows that the accused products infringe Claim 1 of the '108
24 patent and intends to induce third parties to include its customers and end-users to
25 also infringe Claim 1 of the '108 patent.

26 15. Upon information and belief, the accused products, alone or in
27 combination with other products, directly or, alternatively, under the doctrine of
28 equivalents practice each of the limitations of independent Claim 1 of the '108

1 patent when they are used for their normal and intended purpose of writing to and
2 storing electronic data on non-volatile memory. Thus, Kingston directly infringes
3 Claim 1 of the '108 patent in violation of 35 U.S.C. § 271(a) when it demonstrates,
4 tests or otherwise uses the accused products in the United States.

5 16. By way of example, Kingston's demonstration and how-to videos,
6 posted by Kingston on Kingston's website(s) or other public websites, show
7 Kingston and/or its authorized agents or employees migrating or transferring data
8 from the memory of one or more devices to one or more of the accused products.
9 An example can be found on Kingston's website at
10 <http://www.kingston.com/us/support/technical/products?model=SV300S3> and/or
11 on Kingston's YouTube channel at
12 <https://www.youtube.com/watch?v=KdT2t5416WA#t=98> and/or
13 <https://www.youtube.com/watch?v=3e1ZzvTOuXI>. Such conduct evidences
14 Kingston's act of direct infringement of Claim 1 of the '108 patent.

15 17. Plaintiff alleges on information and belief that Kingston uses, makes,
16 sells, offers to sell and/or imports the accused products knowing that they will be
17 used by its customers and end-users for writing and storing electronic data to non-
18 volatile memory utilizing the steps described in Claim 1 of the '108 patent.
19 Kingston's product literature, instructional and/or informational materials, and/or
20 instructional and/or informational videos advertise and encourage customers to use
21 the accused product(s) to store electronic data in the accused products utilizing the
22 methods of memory management taught by Claim 1 of the '108 patent and in a
23 manner it knows infringes upon Claim 1 of the '108 patent.

24 18. Kingston also provides operating manuals, user or installation guides,
25 instructional and "how-to" videos, answers to frequently asked questions on its
26 website and other public websites, or other instructional material that instruct
27 customers and end-users on how to connect the accused products and use them as
28 non-volatile storage devices for electronic data. Among other things, Kingston's

1 informational materials lay out step-by-step instructions on how to write data into
2 the memory of the accused products – a process that utilizes the method disclosed
3 in Claim 1 of the '108 patent and which Kingston knows (at the least as of the
4 filing of the original complaint if not sooner) infringes the method taught in Claim
5 1 of the '108 patent. Plaintiff believes that Kingston directs consumers and end-
6 users to consult and utilize such instructional videos and other informational
7 material.

8 19. Plaintiff believes and thereupon alleges that Kingston is aware that its
9 customers and end-users are using the accused products in an infringing manner
10 based on, among other things: 1) the discussions, questions, answers, and/or
11 comments posted and/or discussed on its “Google+ Hangouts” website, the
12 Kingston website, or other public websites where Kingston’s authorized agents,
13 customers and/or end-users discuss and disclose the use of the accused products for
14 non-volatile electronic data storage, a process which Kingston knows infringes
15 upon Claim 1 of the '108 patent; and/or 2) the fact that Kingston encourages its
16 customers and end-users to use the accused products in an infringing manner as set
17 forth in the preceding Paragraphs.

18 20. As alleged above, incorporated herewith, and based upon information
19 and belief, Plaintiff alleges that Kingston, without authority, has induced and
20 continues to induce infringement of the '108 patent in violation of 35 U.S.C. §
21 271(b) inasmuch as:

- 22 a. The accused products infringe Claim 1 during the normal use of
23 the accused products by Kingston’s customers and/or end-users;
- 24 b. Kingston has known and has been continuously aware of the '108
25 patent since at least the filing of the original complaint in this
26 action, if not sooner;
- 27 c. Kingston has acted in a manner that encourages and continues to
28 encourage others to infringe Claim 1 of the '108 patent by, among

1 other things, intentionally instructing and/or encouraging
2 customers and end-users to use the accused products in a manner
3 that Kingston knows or should have known would cause them to
4 infringe the '108 patent;

5 d. Kingston sells, distributes, and supplies the accused products to
6 customers and end-users with the intent that the products be used
7 in an infringing manner;

8 e. Kingston provides operating manuals, installation guides,
9 instructional videos, or other instructional material designed to
10 instruct customers and end-users to use the products in an
11 infringing manner; and,

12 f. Kingston advertises, markets, and promotes the use of the accused
13 products in an infringing manner.

14 21. As alleged above, incorporated herewith, and based upon information
15 and belief, Plaintiff alleges that Kingston has contributed and continues to
16 contribute to the infringement of Claim 1 of the '108 patent in violation of 35
17 U.S.C. § 271(c) inasmuch as:

18 a. The accused products infringe Claim 1 of the '108 patent during
19 the normal use of the accused products by Kingston's customers
20 and/or end-users;

21 b. Kingston has known and has been continuously aware of the '108
22 patent since at least the filing of the original complaint in this
23 action, if not sooner;

24 c. Kingston imports into the United States, sells and/or offers to sell
25 within the United States products that (a) practice the method of
26 memory management of Claim 1 of the '108 patent; and, (b)
27 Kingston knows that the same constitute material infringing
28 component(s) of the accused products, which were made and/or

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- especially adapted for use in the accused products;
- d. The memory management component(s) and methods of the accused products are not staple articles of commerce suitable for substantial non-infringing use with respect to the '108 patent; and,
- e. Kingston sells, has sold, and/or has supplied the accused products knowing of Plaintiff's '108 patent and knowing that the accused products incorporate Plaintiff's patented method and/or were specially adapted for use in a way which infringes the '108 patent.

22. As alleged above, Plaintiff alleges that Kingston had notice of the '108 patent and knowledge of infringement of Claim 1 of the '108 patent since at least the filing of the original complaint in this matter, if not sooner. Kingston has and continues to sell products that practice the '108 patent after acquiring knowledge of infringement.

PRAYER FOR RELIEF

WHEREFORE, Plaintiff prays for relief and judgment as follows:

- 1. That Defendant be declared to have infringed the Patent-in-Suit;
- 2. That Defendant, Defendant's officers, agents, servants, employees, and attorneys, and those persons in active concert or participation with them, be preliminarily and permanently enjoined from infringement of the Patent-in-Suit, including but not limited to any making, using, offering for sale, selling, or importing of unlicensed infringing products within and without the United States;
- 3. Compensation for all damages caused by Defendant's infringement of the Patent-in-Suit to be determined at trial;
- 4. A finding that this case is exceptional and an award of reasonable attorneys fees pursuant to 35 U.S.C. § 285;
- 5. Granting Plaintiff pre-and post-judgment interest on its damages, together with all costs and expenses; and,
- 6. Awarding such other relief as this Court may deem just and proper.

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HANDAL & ASSOCIATES

Dated: March 21, 2014

By: /s/Pamela C. Chalk
Anton N. Handal
Pamela C. Chalk
Gabriel G. Hedrick
Attorneys for Plaintiff
e.Digital Corporation

DEMAND FOR JURY TRIAL

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Plaintiff hereby demands a trial by jury on all claims.

HANDAL & ASSOCIATES

Dated: March 21, 2014

By: /s/Pamela C. Chalk
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Attorneys for Plaintiff
e.Digital Corporation

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CERTIFICATE OF SERVICE

The undersigned hereby certifies that a true and correct copy of the foregoing document has been served on this date to all counsel of record, if any to date, who are deemed to have consented to electronic service via the Court’s CM/ECF system per CivLR 5.4(d). Any other counsel of record will be served by electronic mail, facsimile and/or overnight delivery upon their appearance in this matter.

I declare under penalty of perjury of the laws of the United States that the foregoing is true and correct. Executed this 21st day of March, 2014 at San Diego, California.

HANDAL & ASSOCIATES

Dated: March 21, 2014

By: /s/Pamela C. Chalk
Anton N. Handal
Pamela C. Chalk
Gabriel G. Hedrick
Attorneys for Plaintiff
e.Digital Corporation