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 INTERCONNECT DEVICES, INC.

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UNITED STATES DISTRICT COURT
 NORTHERN DISTRICT OF CALIFORNIA

INTERCONNECT DEVICES, INC.,
 Plaintiff,
 v.
 JOHNSTECH INTERNATIONAL CORP.,
 Defendant.

Case No. 3:14-cv-01113-JD
 Hon. James Donato

JOHNSTECH INTERNATIONAL CORP., ,
 Counterclaimant,
 v.
 INTERCONNECT DEVICES, INC.,
 Counter-Defendant.

1 Plaintiff Interconnect Devices, Inc. (“IDI”) brings this First Amended Complaint against
2 Defendant Johnstech International Corp. (“Johnstech”) for a Declaratory Judgment that (1) IDI
3 has not infringed U.S. Patent Nos. 7,059,866, 7,722,361, 7,338,293 and 7,445,465; (2) that U.S.
4 Patent Nos. 7,059,866, 7,722,361, 7,338,293 and 7,445,465 are invalid pursuant to 35 U.S.C.
5 §§101, 102, 103 and 112; and (3) that this is an “exceptional” case under 35 U.S.C. § 285 and for
6 an award of all of IDI’s attorneys’ fees and costs.

7 **THE PARTIES**

8 1. Plaintiff Interconnect Devices, Inc. is a Delaware corporation with a principal
9 place of business at 5101 Richland Avenue, Kansas City, KS 66106.

10 2. Defendant Johnstech International Corporation is a Minnesota corporation with a
11 principal place of business at 1210 New Brighton Blvd., Minneapolis, MN 55413.

12 **JURISDICTION**

13 3. Plaintiff brings this action under the Federal Declaratory Judgment Act, 28 U.S.C.
14 § 2201.

15 4. This Court has subject matter jurisdiction over this matter pursuant to 28 U.S.C.
16 § 1331 (Federal Question) and § 1338(a) (Patent).

17 5. Upon information and belief, this Court has personal jurisdiction over Johnstech
18 because it has established minimum contacts with the forum. Johnstech maintains its Sales,
19 Service, & Innovation Center in Santa Clara, California, and, on information and belief, has
20 maintained this office in this district since 1995. On information and belief, the lead inventor of
21 two of the patents-in-suit resides in this district and developed the purported inventions described
22 in the patents-in-suit in this district. Johnstech has placed and continues to place products into the
23 stream of commerce, which stream is directed at this district, and knows or should know that such
24 products are used throughout the United States, including in this district. Further, Johnstech is
25 registered to do business in California and maintains an agent for service of process in this
26 district.

VENUE

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2 6. Venue is proper in this Court pursuant to 28 U.S.C. §§ 1391(b) and (c), and
3 § 1400(b) because a substantial part of the events giving rise to this action occurred within this
4 Judicial District, and because a corporation defendant shall be deemed to reside in any judicial
5 district in which it is subject to personal jurisdiction. In addition, Johnstech maintains its Sales,
6 Service, & Innovation Center in Santa Clara, California, and, on information and belief, the lead
7 inventor of two of the patents-in-suit resides in this district and developed the purported
8 inventions described in the patents-in-suit in this district. Further, IDI maintains a sales and
9 applications engineering office in this district in Milpitas, California.

THE PATENTS-IN-SUIT

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11 7. On June 13, 2006, the United States Patent and Trademark Office (“USPTO”)
12 issued U.S. Patent No. 7,059,866 (“the ‘866 Patent”), entitled “Integrated Circuit Contact to Test
13 Apparatus.” Mathew L. Gilk is the named inventor on the face of the ‘866 Patent. On
14 information and belief, the ‘866 Patent is assigned to Johnstech. A true and correct copy of the
15 ‘866 Patent is attached hereto as Exhibit A.

16 8. On May 25, 2010, the USPTO issued U.S. Patent No. 7,722,361 (“the ‘361
17 Patent”), entitled “Test Socket.” Jose E. Lopez, Dennis B. Shell, and Mathew L. Gilk are the
18 named inventors on the face of the ‘361 Patent. On information and belief, the ‘361 Patent is
19 assigned to Johnstech. A true and correct copy of the ‘361 Patent is attached hereto as Exhibit B.

20 9. On March 4, 2008, the USPTO issued U.S. Patent No. 7,338,293 (“the ‘293
21 Patent”), entitled “Circuit Contact to Test Apparatus.” Mathew L. Gilk is the named inventor on
22 the face of the ‘293 Patent. On information and belief, the ‘293 Patent is assigned to Johnstech.
23 A true and correct copy of the ‘293 Patent is attached hereto as Exhibit C.

24 10. On November 4, 2008, the USPTO issued U.S. Patent No. 7,445,465 (“the ‘465
25 Patent”), entitled “Test Socket.” Jose E. Lopez, Dennis B. Shell, and Mathew L. Gilk are the
26 named inventors on the face of the ‘465 Patent. On information and belief, the ‘465 Patent is
27 assigned to Johnstech. A true and correct copy of the ‘465 Patent is attached hereto as Exhibit D.

28

FACTUAL BACKGROUND

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2 11. IDI provides spring contact probe based technology, including connectors,
3 advanced semiconductor test sockets, ATE interfaces and spring contact probes. For over three
4 decades, test engineers and product designers have turned to IDI for the most reliable interconnect
5 designs available. IDI is the originator of the spring contact probe test socket and continues to be
6 the leader of innovations in the semiconductor test industry.

7 12. On February 25, 2014, Johnstech's counsel set a cease and desist letter ("the
8 Letter") to IDI, alleging that IDI's Archimedes test pin and socket directly infringes Johnstech's
9 '866 Patent, '361 Patent, and '465 Patent. A true and correct copy of the Letter is attached hereto
10 as Exhibit D.

11 13. The Letter stated that its purpose was to advise IDI "of the consequences of
12 infringement of one or more of these patents." It stated that Johnstech "is aware that [IDI] will be
13 exhibiting products at the upcoming BITS conference in Phoenix, AZ in March 2014" and
14 warned that if IDI exhibits the Archimedes product, Johnstech "will consider that an intentional
15 infringement."

16 14. The Letter demanded a response in less than five business days, and stated that if
17 Johnstech "do[es] not hear from [IDI] by March 1, 2014, we shall assume that settlement is of no
18 interest, and continued infringement will certainly be willful."

19 15. On May 9, 2014, Johnstech filed its Answer and Counterclaims in response to
20 IDI's Complaint in this action. (Doc. No. 19) Johnstech alleged that IDI infringes Johnstech's
21 '866 Patent, '361 Patent, and '465 Patent. In addition, Johnstech alleged that IDI infringes
22 Johnstech's '293 Patent.

23 16. By virtue of the foregoing, there is a continuing justiciable controversy between
24 the parties as to IDI's right to make, use, offer to sell and sell its Archimedes product, and as to
25 the validity, enforceability and scope of the patents in suit.

FEDERAL DECLARATORY JUDGMENT ACT

26
27 17. Pursuant to the Federal Declaratory Judgment Act, 28 U.S.C. § 2201, this Court
28 may declare the rights and other legal relations of any interested party.

1 18. As set forth in the Letter, Johnstech has asserted that IDI infringes Johnstech's
2 '866 Patent, '361 Patent, and '465 Patent. As set forth in Johnstech's Answer and Counterclaims,
3 Johnstech has asserted that IDI infringes Johnstech's 293 Patent.

4 19. A real and actual substantial controversy exists between IDI and Johnstech.

5 20. IDI and Johnstech have adverse legal interests with respect to the threats of patent
6 infringement made by Johnstech against IDI.

7 21. Johnstech has made antagonistic claims that are immediate and that indicate
8 imminent and inevitable litigation.

9 22. The interests of the parties will be best served if this Court enters a Declaratory
10 Judgment setting forth the rights of the parties with respect to this dispute.

11 23. The relief sought by IDI will resolve the controversy relative to the respective
12 interests of IDI and Johnstech.

13 **COUNT I**

14 **DECLARATORY JUDGMENT OF NON-INFRINGEMENT OF THE '866 PATENT**

15 24. Each of paragraphs 1 through 23 is incorporated herein by reference.

16 25. On information and belief, '866 Patent is assigned to Johnstech.

17 26. IDI has not infringed and does not infringe any valid claim of the '866 Patent.

18 27. There is an actual, substantial and immediate controversy between the adverse
19 interests of IDI and Johnstech as to whether IDI's use, making, sale or offering for sale of its
20 Archimedes test pin and socket infringes the claims of the '866 Patent.

21 28. IDI is entitled to a Judicial Declaration and Order that IDI has not infringed and
22 does not infringe, either directly or indirectly, literally or under the doctrine of equivalents, any
23 valid claim of the '866 Patent.

24 **COUNT II**

25 **DECLARATORY JUDGMENT OF INVALIDITY OF THE '866 PATENT**

26 29. Each of paragraphs 1 through 28 is incorporated herein by reference.

27 30. On information and belief, '866 Patent is assigned to Johnstech.

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1 31. The '866 Patent is invalid for failure to satisfy one or more of the conditions of
2 patentability set forth in Title 35 of the United States Code, including, but not limited to, 35
3 U.S.C. §§ 101, 102, 103, and 112.

4 32. An actual, substantial and immediate controversy exists between IDI and
5 Johnstech as to whether the claims of the '866 Patent are valid.

6 33. IDI is entitled to a Judicial Declaration and Order that the '866 Patent is invalid.

7 **COUNT III**

8 **DECLARATORY JUDGMENT OF NON-INFRINGEMENT OF THE '361 PATENT**

9 34. Each of paragraphs 1 through 33 is incorporated herein by reference.

10 35. On information and belief, the '361 Patent is assigned to Johnstech.

11 36. IDI has not infringed and does not infringe any valid claim of the '361 Patent.

12 37. There is an actual, substantial and immediate controversy between the adverse
13 interests of IDI and Johnstech as to whether IDI's use, making, sale or offering for sale of its
14 Archimedes test pin and socket infringes the claims of the '361 Patent.

15 38. IDI is entitled to a Judicial Declaration and Order that IDI has not infringed and
16 does not infringe, either directly or indirectly, literally or under the doctrine of equivalents, any
17 valid claim of the '361 Patent.

18 **COUNT IV**

19 **DECLARATORY JUDGMENT OF INVALIDITY OF THE '361 PATENT**

20 39. Each of paragraphs 1 through 38 is incorporated herein by reference.

21 40. On information and belief, the '361 Patent is assigned to Johnstech.

22 41. The '361 Patent is invalid for failure to satisfy one or more of the conditions of
23 patentability set forth in Title 35 of the United States Code, including, but not limited to, 35
24 U.S.C. §§ 101, 102, 103, and 112.

25 42. An actual, substantial and immediate controversy exists between IDI and
26 Johnstech as to whether the claims of the '361 Patent are valid.

27 43. IDI is entitled to a Judicial Declaration and Order that the '361 Patent is invalid.

28 **COUNT V**

1 **DECLARATORY JUDGMENT OF NON-INFRINGEMENT OF THE '293 PATENT**

2 44. Each of paragraphs 1 through 43 is incorporated herein by reference.

3 45. On information and belief, '293 Patent is assigned to Johnstech.

4 46. IDI has not infringed and does not infringe any valid claim of the '293 Patent.

5 47. There is an actual, substantial and immediate controversy between the adverse
6 interests of IDI and Johnstech as to whether IDI's use, making, sale or offering for sale of its
7 Archimedes test pin and socket infringes the claims of the '293 Patent.

8 48. IDI is entitled to a Judicial Declaration and Order that IDI has not infringed and
9 does not infringe, either directly or indirectly, literally or under the doctrine of equivalents, any
10 valid claim of the '293 Patent.

11 **COUNT VI**

12 **DECLARATORY JUDGMENT OF INVALIDITY OF THE '293 PATENT**

13 49. Each of paragraphs 1 through 48 is incorporated herein by reference.

14 50. On information and belief, '293 Patent is assigned to Johnstech.

15 51. The '293 Patent is invalid for failure to satisfy one or more of the conditions of
16 patentability set forth in Title 35 of the United States Code, including, but not limited to, 35
17 U.S.C. §§ 101, 102, 103, and 112.

18 52. An actual, substantial and immediate controversy exists between IDI and
19 Johnstech as to whether the claims of the '293 Patent are valid.

20 53. IDI is entitled to a Judicial Declaration and Order that the '293 Patent is invalid.

21 **COUNT VII**

22 **DECLARATORY JUDGMENT OF NON-INFRINGEMENT OF THE '465 PATENT**

23 54. Each of paragraphs 1 through 53 is incorporated herein by reference.

24 55. On information and belief, the '465 Patent is assigned to Johnstech.

25 56. IDI has not infringed and does not infringe any valid claim of the '465 Patent.

26 57. There is an actual, substantial and immediate controversy between the adverse
27 interests of IDI and Johnstech as to whether IDI's use, making, sale or offering for sale of its
28 Archimedes test pin and socket infringes the claims of the '465 Patent.

1 58. IDI is entitled to a Judicial Declaration and Order that IDI has not infringed and
2 does not infringe, either directly or indirectly, literally or under the doctrine of equivalents, any
3 valid claim of the '465 Patent.

4 **COUNT VI**

5 **DECLARATORY JUDGMENT OF INVALIDITY OF THE '465 PATENT**

6 59. Each of paragraphs 1 through 58 is incorporated herein by reference.

7 60. On information and belief, the '465 Patent is assigned to Johnstech.

8 61. The '465 Patent is invalid for failure to satisfy one or more of the conditions of
9 patentability set forth in Title 35 of the United States Code, including, but not limited to, 35
10 U.S.C. §§ 101, 102, 103, and 112.

11 62. An actual, substantial and immediate controversy exists between IDI and
12 Johnstech as to whether the claims of the '465 Patent are valid.

13 63. IDI is entitled to a Judicial Declaration and Order that the '465 Patent is invalid.

14 **PRAYER FOR RELIEF**

15 **WHEREFORE**, IDI respectfully requests that the Court enter judgment in its favor and
16 against Johnstech as follows:

17 A. The Court enter judgment that the '866 Patent is not infringed by IDI.

18 B. The Court enter judgment that the '866 Patent is invalid.

19 C. The Court enter judgment that the '361 Patent is not infringed by IDI.

20 D. The Court enter judgment that the '361 Patent is invalid.

21 E. The Court enter judgment that the '293 Patent is not infringed by IDI.

22 F. The Court enter judgment that the '293 Patent is invalid.

23 G. The Court enter judgment that the '465 Patent is not infringed by IDI.

24 H. The Court enter judgment that the '465 Patent is invalid.

25 I. The Court find this case to be an "exceptional case" pursuant to 35 U.S.C. § 285
26 and award IDI its attorneys' fees in this action; and

27 J. The Court enter an order for such other and further relief as this Court deems just
28 and proper.

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Dated: June 5, 2014

SNELL & WILMER L.L.P.

By: /s/ Brian G. Arnold

Brian G. Arnold

Marjorie A. Witter

Attorneys for Plaintiff
INTERCONNECT DEVICES, INC.

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DEMAND FOR JURY TRIAL

IDI hereby demands a jury trial on any issue triable of right by a jury pursuant to Rule 38 of the Federal Rules of Civil Procedure.

Dated: June 5, 2014

SNELL & WILMER L.L.P.

By: /s/ Brian G. Arnold

Brian G. Arnold
Marjorie A. Witter

Attorneys for Plaintiff
INTERCONNECT DEVICES, INC.

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CERTIFICATE OF SERVICE

I am a citizen of the United States and employed in Los Angeles, California. I am over the age of eighteen years and not a party to the within-entitled action. My business address is 350 S. Grand Avenue, Suite 2600, Los Angeles, California 90071.

On June 5, 2014, I served the **FIRST AMENDED COMPLAINT** upon the parties and/or counsel listed and by the methods indicated on the attached Service List.

I declare upon the penalty of perjury that the foregoing is true and correct, and that I am employed in the office of a member of the bar of this Court at whose direction the service was made. Executed on June 5, 2014, at Los Angeles, California.

/s/ Tracey L. Waters

Tracey L. Waters

1 **SERVICE LIST**

2 The following parties were served via ECF notice on May 13, 2014.

3

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5 Brian G. Arnold	barnold@swlaw.com, twaters@swlaw.com
6 Marjorie A. Witter	mwitter@swlaw.com, fmoralde@swlaw.com
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11 The following party was served via U.S. Mail on June 5, 2014.

12

13 Courtland C. Merrill
 14 Anthony Ostlund Baier & Louwagie, P.A.
 15 90 South Seventh Street
 Suite 3600
 Minneapolis, MN 55402

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