

**IN THE UNITED STATES DISTRICT COURT
FOR THE NORTHERN DISTRICT OF TEXAS
DALLAS DIVISION**

ICON LASER SOLUTIONS, LLC,

Plaintiff,

v.

AEROPOSTALE, INC.,

Defendant.

Civil Action No. 3:15-cv-3310

JURY TRIAL DEMANDED

FIRST AMENDED COMPLAINT FOR PATENT INFRINGEMENT

Plaintiff ICON LASER SOLUTIONS, LLC files this First Amended Complaint against Defendant AEROPOSTALE, INC., alleging as follows:

I. THE PARTIES

1. Plaintiff ICON LASER SOLUTIONS, LLC (“Plaintiff” or “Icon Laser”) is a limited liability company organized and existing under the laws of the State of Texas, with a principal place of business in Dallas, Texas.

2. On information and belief, AEROPOSTALE, INC., (“Defendant” or “Aeropostale”) is a Delaware corporation with a principal place of business in New York, NY. Defendant may be served with process by serving its Registered Agent: Corporation Service Company, 2711 Centerville Rd., Wilmington, DE 19808.

II. JURISDICTION AND VENUE

3. This is an action for infringement of a United States patent. Federal question jurisdiction over such action is conferred on this Court under 28 U.S.C. §§ 1331 and 1338(a).

4. On information and belief, Defendant has had minimum contacts with the Dallas Division of the Northern District of Texas such that this venue is fair and

reasonable. Defendant has committed such purposeful acts or transactions in this district that it reasonably should know and expect that it could be hauled into this Court as a consequence of such activity. Upon information and belief, Defendant has transacted and, at the time of the filing of this Complaint, is transacting business within the Dallas Division of the Northern District of Texas.

5. For these reasons, personal jurisdiction exists and venue is proper in this Court under 28 U.S.C. §§ 1391(b) and (c) and 28 U.S.C. § 1400(b).

III. PATENT INFRINGEMENT

6. On October 22, 1996, United States Patent No. 5,567,207 was duly and legally issued for a “Method for Marking and Fading Textiles with Lasers.” A true and correct copy of the ‘207 Patent is attached hereto as Exhibit “A” and made a part hereof. The ‘207 Patent is referred to as the “Patent-in-Suit.”

7. By way of assignment, Plaintiff owns all substantial rights in and to the Patent-in-Suit, including the exclusive rights to enforce the Patent against infringers and to collect damages for all relevant times, and including the right to prosecute this action.

8. Generally speaking, the ‘207 Patent relates to the use of a laser to color fade and selectively alter textile materials in an environmentally friendly manner.

9. On information and belief, Defendant, through itself and/or one or more of its entities, subsidiaries, affiliates, business divisions, or business units, directly infringed the ‘207 Patent pursuant to 35 U.S.C. § 271, including at least 35 U.S.C. § 271(g), by importing into the United States or offering to sell, selling, or using within the United States certain textile products that were made during the term of the ‘207 Patent by a process or processes that fall within the scope of one or more claims of the ‘207 Patent (“the ‘207 Patent Processes”), including at least claims 1, 2, 3, 22, and 23, without authority from Plaintiff, including but not limited to Rivington

Skinny Men's Jeans and Straight Leg Men's Jeans, as well as other products made by the '207 Patent Processes (collectively, the "Aeropostale Products").

10. Pursuant to 35 U.S.C. § 287(b)(1)(B), the limitations on remedies contained in section 287(b)(2) are not available to a defendant who "owns or controls, or is owned or controlled by, the person who practiced the patented process." *See* 35 U.S.C. § 287(b)(1)(B).

11. On information and belief, Defendant owned or controlled the entity or entities who practiced the '207 Patent Processes. As an example, at a minimum, Defendant has exerted and exerts control over its suppliers and vendors, including its suppliers and vendors for the Aeropostale Products, through the use of quality control standards, audits of factory conditions, and requiring suppliers and vendors to adhere to Aeropostale's Code of Conduct. *See* http://theaeroway.com/?page_id=46; http://theaeroway.com/?page_id=49; http://theaeroway.com/?page_id=51.

12. The Committee Notes to 35 U.S.C. § 287(b)(2) indicate that the "provision was not intended to protect retailers with the 'resources to send agents to other countries to seek suppliers,' who 'should be able and willing to exercise more vigilance' in avoiding infringement." *See Infosint, S.A. v. H. Lundbeck A/S*, 612 F.Supp.2d 402, 404-05 (S.D.N.Y. 2009). *See also* S. Rep. 100-83.

13. Defendant has the resources to send, and on information and belief does send, agents to other countries to seek suppliers, including suppliers for the Aeropostale Products. As such, Defendant should be able and willing to exercise more vigilance in avoiding infringement.

14. The Committee Notes to 35 U.S.C. § 287(b)(2) further indicate that an importer who is "closely connected" to the party using the patented process cannot use the 287(b)(2) safe harbor provision. *Samsung Electronics Co., Ltd. v. Nvidia*, 2015 WL 9200460 *9 (E.D.Va. Dec.

16, 2015). *See also* S. Rep. 100-83.

15. On information and belief, Defendant is closely connected to the entity or entities who practiced the '207 Patent Processes. For example, Defendant's website states, "[w]e work in partnership with our vendors and suppliers to ensure all that products meet our expectations for quality, design, construction, fit and performance as outlined in the Aeropostale Quality Assurance Manual." *See* http://theaeroway.com/?page_id=46.

16. The Committee Notes to 35 U.S.C. § 287(b) further indicate that the rationale behind the safe harbor provision in section 287(b)(2) was "to shelter only purchasers who are remote from the manufacturer and not in the position to protect themselves in contracts with the party who is actually using the [patented] process." *See Infosint, S.A.*, 612 F.Supp.2d at 404-05. *See also* S. Rep. 100-83.

17. On information and belief, Defendant was in the position to protect itself through the use of contracts with the entity or entities who practiced the '207 Patent Processes. For example, Defendant's website states, "[t]he Aeropostale Manufacturing Policies and Procedures (the 'Policies and Procedures') apply to all vendors and factories that manufacture products (each a 'Manufacturer') for Aeropostale, including its affiliates and subsidiaries." *See* http://theaeroway.com/?page_id=49. Such a statement indicates that Defendant contractually requires its suppliers and/or vendors to meet certain standards and/or provide indemnification.

18. On information and belief, the Aeropostale Products were not materially changed by a subsequent process or became a trivial or nonessential component of another product following the performance of the '207 Patent Processes.

19. In light of the applicability of 35 U.S.C. § 287(b)(1), for at least the reasons alleged in the preceding paragraphs, Plaintiff is not required to allege notice of infringement under 35 U.S.C. 287(b)(2) to be entitled to a remedy for infringement.

20. As a result of Defendant's infringement of the '207 Patent, Plaintiff has suffered damage. Plaintiff is entitled to recover from Defendant damages adequate to compensate for such infringement, which have yet to be determined.

21. Defendant is, thus, liable to Plaintiff in an amount that adequately compensates Plaintiff for Defendant's infringements, which, by law, cannot be less than a reasonable royalty, together with interest and costs as fixed by this Court under 35 U.S.C. § 284.

V. JURY DEMAND

Plaintiff hereby requests a trial by jury pursuant to Rule 38 of the Federal Rules of Civil Procedure.

VI. PRAYER FOR RELIEF

WHEREFORE, Plaintiff respectfully requests that the Court find in its favor and against Defendant, and that the Court grant Plaintiff the following relief:

- a. Judgment that one or more claims of the Patent-in-Suit have been directly infringed, either literally or under the doctrine of equivalents, by Defendant;
- b. An order adjudging that the Aeropostale Products were produced by processes that presumptively infringe under 35 U.S.C. § 295;
- c. Judgment that Defendant account for and compensate Plaintiff for all damages suffered by and costs incurred by Plaintiff because of Defendant's infringing activities and other conduct complained of herein;
- d. That Plaintiff be granted pre-judgment and post-judgment interest on the damages caused by Defendant's infringing activities and other conduct complained of herein;
- e. That the Court declare this an exceptional case and award Plaintiff its reasonable attorney's fees and costs in accordance with 35 U.S.C. § 285, to the extent permitted by law and equity; and
- f. That Plaintiff be granted such other and further relief as the Court may deem just and proper under the circumstances.

Dated: March 17, 2016

Respectfully submitted,

/s/ Timothy E. Grochocinski
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CERTIFICATE OF SERVICE

The undersigned hereby certifies that a copy of the foregoing was served on all counsel of record on March 17, 2016 via the Court's CM/ECF system.

/s/ Timothy E. Grochocinski
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