

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

Rockwell Automation, Inc., Plaintiff, v. InvestPic, LLC Defendant.	Civil Action No. <u>17-cv-258</u> JURY TRIAL DEMANDED
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COMPLAINT

Plaintiff Rockwell Automation, Inc. (“Rockwell”), by its attorneys and for its complaint, alleges and states as follows:

THE PARTIES

1. Rockwell is a Delaware corporation having a principal place of business at 1201 South 2nd Street, Milwaukee, Wisconsin 53204-2410, within the Eastern District of Wisconsin.

2. On information and belief, Defendant InvestPic, LLC (“InvestPic”) is a Delaware limited liability company, with a place of business in Greenwich, Connecticut.

NATURE OF THE ACTION, JURISDICTION AND VENUE

3. Plaintiff Rockwell brings this action for violation of Wisconsin Statute 100.197 and seeking a declaratory judgment that it does not infringe any enforceable claim of InvestPic’s U.S. Patent No. 6,349,291 (the “291 patent”) despite false, misleading and deceptive claims to the contrary made in a patent notification letter sent to Rockwell by InvestPic.

4. On information and belief, Defendant InvestPic is the owner by assignment of the '291 patent, entitled "Method and system for analysis, display and dissemination of financial information using resampled statistical methods." A true and correct copy of the '291 patent is attached as Exhibit A.

5. On information and belief, InvestPic claims to own all rights, title and interest in and to the '291 patent and claims to possess all rights of recovery. InvestPic also has claimed in writing that Rockwell has infringed the '291 patent.

6. This Court has subject matter jurisdiction pursuant to 35 U.S.C. § 271 *et seq.*, and 28 U.S.C. §§ 1331, 1338, 1367 and 2201-02.

7. On December 20, 2016, InvestPic's counsel sent a letter to Rockwell alleging that Rockwell infringes the '291 patent (the "InvestPic Letter"). *See* December 20, 2016 Letter from Michael Shore to Blake Moret (attached hereto as Exhibit B).

8. The InvestPic Letter does not contain i) the name and physical address of the owners of the '291 patent, ii) an identification of each claim of each patent being asserted, iii) factual allegations and an analysis setting forth in detail InvestPic's theory of each claim of the '291 patent and how each such claim relates to Rockwell's product, service, process or technology or iv) an identification of each pending or completed court or administrative proceeding, including any proceeding before the U.S. Patent and Trademark Office ("PTO"), concerning each patent or pending patent as required by Wisconsin Statute 100.197 §§ 2(a)(3)-(6), respectively.

9. Additionally, the InvestPic Letter includes false, misleading and deceptive information in violation of Wisconsin Statute 100.197, § 2(b). Specifically, the InvestPic Letter states that "[t]he '291 patent's claims were recently held valid" and "the '291 patent claims have

been established as valid” by the United States Court of Appeals for the Federal Circuit (“Federal Circuit”) in *In re Varma*, 816 F.3d 1352 (Fed. Cir. 2016). These statements are false, misleading and deceptive in multiple respects.

10. The Federal Circuit did not hold that the claims of the ‘291 patent were valid; rather, it held that a subset of claims of the ‘291 patent are not invalid over particular prior art. Accordingly, the statement that the Federal Circuit has held the ‘291 patent claims are “valid” is false.

11. Additionally, the Federal Circuit’s decision in *In re Varma* remanded many of the claims to be further reexamined for invalidity. This means that many of the claims of the ‘291 patent “have **[not]** been established as valid” despite InvestPic’s false, misleading and deceptive statements to the contrary.

12. Finally, the InvestPic Letter fails to address the fact that reexaminations of the ‘291 patent remain pending at the PTO. The ‘291 patent is the subject of two reexamination proceedings, Reexamination Control No. 95/001,939 and Reexamination Control No. 90/012,366 (the “Reexaminations”). InvestPic has amended 24 of the 31 claims of the ‘291 patent in the Reexaminations and further amendments or claim cancellations are possible in the still-ongoing Reexaminations. Accordingly, many of the claims listed on the face of the ‘291 patent have been amended and additional claims may be cancelled or further amended, and will have no legal effect until the reexaminations are completed and certificates are issued by the PTO. InvestPic’s assertion that the Federal Circuit “established [the ‘291 patent] claims as valid” without mentioning the multiple reexamination proceedings is misleading and deceptive.

13. Because the InvestPic Letter includes false, misleading and deceptive information, InvestPic is in violation of Wisconsin Statute 100.197 § 2(b).

14. Rockwell has been harmed by InvestPic's violation of Wisconsin Statute 100.197 § 2(b).

15. Additionally, on information and belief, the InvestPic Letter was sent in bad-faith. On information and belief, the InvestPic Letter includes demonstrably false and misleading statements that were known to be false and misleading by InvestPic and its counsel when it sent the InvestPic Letter to Rockwell. On information and belief, InvestPic's decision to knowingly send a false and misleading patent notification letter to Rockwell was made in bad-faith in an attempt to coerce Rockwell into taking a license to the '291 patent.

16. This Court has personal jurisdiction over InvestPic in this action because, on information and belief, InvestPic has established minimum contacts with the forum and asserting personal jurisdiction would not violate due process. On information and belief, InvestPic knowingly sent the InvestPic Letter to Rockwell in this forum in bad-faith in an attempt to coerce Rockwell into purchasing a license from InvestPic in this forum. On information and believe, InvestPic's tortious act is in violation of Wisconsin Statute 100.197 and has caused and continues to cause Rockwell injury in this forum. Additionally, on information and belief, InvestPic does business in this forum by soliciting sales of its intellectual property, including through the bad-faith assertions and offers made in its InvestPic Letter, and by its acts has caused and continues to cause Rockwell injury in this forum, including by asserting the '291 patent against Rockwell in this forum.

17. Venue is proper in this District under 28 U.S.C. §§ 1391(b) and 1391(c) because, among other reasons, InvestPic is subject to personal jurisdiction in this judicial district, InvestPic has conducted business in this District, or because a substantial part of the events or omissions giving rise to the claims herein occurred in this judicial district.

COUNT I – VIOLATION OF WISCONSIN STATUTE 100.197

18. Rockwell hereby restates and re-alleges the allegations set forth in the preceding paragraphs and incorporates them by reference.

19. The InvestPic Letter sent to Rockwell by InvestPic’s counsel on December 20, 2016 alleging that Rockwell infringes the ‘291 patent is a “Patent Notification” as that term is used in Wisconsin Statute 100.197.

20. Rockwell is engaged in substantial and not isolated activities within this state and received a “Patent Notification” from InvestPic. Rockwell is therefore a “Target” as that term is used in Wisconsin Statute 100.197.

21. The InvestPic Letter fails to contain all of the information that must be set forth in a patent notification, including i) the name and physical address of the owners of the ‘291 patent, ii) an identification of each claim of each patent being asserted, iii) factual allegations and an analysis setting forth in detail InvestPic’s theory of each claim of the ‘291 patent and how each such claim relates to Rockwell’s product, service, process or technology or iv) an identification of each pending or completed court or administrative proceeding, including any proceeding before the PTO, concerning each patent or pending patent in violation of Wisconsin Statute 100.197 § 2(a)(3)-(6), respectively.

22. Additionally, the InvestPic Letter includes false, misleading and deceptive information in violation of Wisconsin Statute 100.197 § 2(b). Specifically, the InvestPic Letter states that “[t]he ‘291 patent’s claims were recently held valid” and “the ‘291 patent claims have been established as valid” by the Federal Circuit when they were not. Rather, the Federal Circuit stated that, based on amendments to some of the claims of the ‘291 patent, those claims were not

invalid over specific pieces of prior art. However, despite its awareness that many of the claims were not addressed by the Federal Circuit, while the validity of other claims were remanded to the PTO for further proceedings, InvestPic still falsely and knowingly alleged that the claims of the '291 patent were held to be valid.

23. The InvestPic Letter also fails to address the fact that reexaminations of, and reissues based upon, the '291 patent, wherein InvestPic has already amended 24 of the 31 claims of the '291 patent, remain pending at the PTO. Likewise, InvestPic fails to mention in the InvestPic Letter that further amendments or claim cancellations are possible in the still-ongoing Reexaminations. Accordingly, many of the claims listed on the face of the '291 patent have been amended and additional claims may be cancelled or amended further, and will have no legal effect until the Reexaminations are completed and certificates of reexamination are issued by the PTO. InvestPic's assertion that the Federal Circuit "established [the '291 patent] claims as valid" without mentioning the multiple reexamination proceedings is misleading and deceptive.

24. Moreover, InvestPic fails to mention in the InvestPic Letter that many of the claims that were purportedly "held valid" by the Federal Circuit have been amended and contain additional claim elements not found in the claims that appear on the face of the '291 patent. On information and belief, InvestPic's failure to state that many of the claims of the '291 patent have been amended was done in bad faith to give the impression that the Federal Circuit ruled on the validity of all of the claims as they appear on the face of the '291 patent, when it did not. On information and belief, InvestPic's false, misleading and deceptive statements were made in bad faith with the intent of coercing Rockwell into purchasing a patent license from InvestPic despite InvestPic's knowledge that the claims on the face of the '291 patent are not operative let alone valid.

25. Because the InvestPic Letter includes false, misleading and deceptive information and was sent to Rockwell in bad-faith, InvestPic is in violation of Wisconsin Statute 100.197 § 2(b).

26. Rockwell has been and continues to be harmed by InvestPic's bad-faith violation of Wisconsin Statute 100.197 § 2(b).

COUNT II - DECLARATION OF NON-INFRINGEMENT

27. Rockwell hereby restates and re-alleges the allegations set forth in the preceding paragraphs and incorporates them by reference.

28. InvestPic, through counsel, has alleged that "Rockwell Automation is selling, offering to sell, using and making infringing articles, including Arena Simulation Software and other similar products" which are allegedly "covered by multiple claims of the '291 patent." *See* Exhibit B, InvestPic Letter. In the same communication, InvestPic, through counsel, provided "formal notice to Rockwell Automation regarding the existence of the '291 patent and InvestPic's contention that Rockwell Automation's activities infringe the '291 patent." *Id.*

29. Based on InvestPic's allegations of infringement of the '291 patent by Rockwell, an actual controversy has arisen and now exists between the parties as to whether Rockwell infringes the '291 patent.

30. Rockwell does not infringe and has not infringed, under any theory of infringement, including directly (whether individually or jointly), indirectly (whether contributorily or by inducement), or under the doctrine of equivalents, any enforceable claim of the '291 patent.

31. Pursuant to the Federal Declaratory Judgement Act, 28 U.S.C. § 2201 *et seq.*, Rockwell requests a declaration by the Court that it does not infringe and has not infringed,

under any theory of infringement (whether individually or jointly), indirectly (whether contributorily or by inducement), or under the doctrine of equivalents, any enforceable claim of the '291 patent.

PRAYER FOR RELIEF

WHEREFORE, Plaintiff Rockwell Automation, Inc. requests that this Court enter an order for the following:

1. declaring that Rockwell does not infringe, and has not infringed, under any theory of infringement, including directly (individually or jointly), indirectly (contributorily or by inducement) or under the doctrine of equivalents any enforceable claim of the '291 patent;
2. permanently enjoining InvestPic, and its respective officers, agents, servants, employees, attorneys and any other person acting on its or their behalf or in concert with them, from charging or threatening, orally or in writing, that the '291 patent has been infringed by Rockwell under any subsection of 35 U.S.C. § 271;
3. awarding Rockwell damages pursuant to Wisconsin Statute 100.197 § 3(2) adequate to compensate for InvestPic's violation of Wisconsin Statute 100.197 § 2(b);
4. awarding Rockwell its costs and reasonable attorney fees pursuant to Wisconsin Statute 100.197 § 3(3) for InvestPic's violation of Wisconsin Statute 100.197 § 2(b);

5. awarding Rockwell punitive damages pursuant to Wisconsin Statute 100.197 § 3(4) for InvestPic's violation of Wisconsin Statute 100.197 § 2(b);
6. awarding Rockwell pre-judgment and post-judgment interest;
7. a judicial determination that this case is "exceptional" under the Patent Act and awarding Rockwell its actual costs, expenses and reasonable attorneys' fees incurred in connection with this action under 35 U.S.C. § 285; and
8. awarding Rockwell such other and further relief as this Court deems just and equitable.

DEMAND FOR A JURY TRIAL

Plaintiff Rockwell Automation, Inc. demands a trial by jury on all issues so triable.

Dated: February 24, 2017

Respectfully submitted,

By: /s/ Paul J. Tanck

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