

**IN THE UNITED STATES DISTRICT COURT
FOR THE NORTHERN DISTRICT OF ILLINOIS**

**PROXIMITY SENSORS OF TEXAS,
LLC,**

Plaintiff,

v.

ROHM SEMICONDUCTOR U.S.A., LLC

Defendant.

Case No. 1:19-cv-208

PATENT CASE

JURY TRIAL DEMANDED

COMPLAINT FOR PATENT INFRINGEMENT

Plaintiff Proximity Sensors of Texas, LLC (“PST” or “Plaintiff”) files this Complaint against Rohm Semiconductor U.S.A., Inc. (“Rohm” or “Defendant”) for infringement of U.S. Patent No. 7,050,043 (“the ’043 patent,” “the patent-in-suit,” or “the asserted patent”).

THE PARTIES

1. PST is a Texas limited liability company with its principal place of business located at 1400 Preston Road, Suite 400, Plano, Texas 75093.

2. Rohm Semiconductor U.S.A., LLC is a Delaware corporation, having a principal place of business in Santa Clara, California and a regular and established place of business at 21925 W. Field Parkway, Suite 206, Deer Park, Illinois 60010. Rohm offers its products and/or services, including those accused herein of infringement, to customers and potential customers located in Illinois and in the Northern District of Illinois. Defendant is registered to do business in Illinois and may be served with process through its registered agent for service at Illinois Corporation Service, 801 Adlai Stevenson Drive, Springfield, Illinois 62703.

JURISDICTION AND VENUE

3. PST brings this action for patent infringement under the patent laws of the United States, namely 35 U.S.C. §§ 271, 281, and 284-285, among others. This Court has subject matter jurisdiction pursuant to 28 U.S.C. §§ 1331, 1338(a), and 1367.

4. Venue is proper in this judicial district pursuant to 28 U.S.C. §1400(b). Defendant has committed acts of infringement in this judicial district and has a regular and established place of business in this district. Specifically, Defendant maintains a regular and established place of business in this district at least at 21925 W. Field Parkway, Suite 206, Deer Park, IL 60010.

5. Defendant is subject to this Court's specific and general personal jurisdiction pursuant to due process and/or the Illinois Long Arm Statute, due at least to its substantial business in this State and judicial district, including: (a) at least part of its infringing activities alleged herein; and (b) regularly doing or soliciting business, engaging in other persistent conduct, and/or deriving substantial revenue from goods sold and services provided to Illinois residents.

COUNT I

(INFRINGEMENT OF U.S. PATENT NO. 7,050,043)

6. PST incorporates paragraph 1 through 5 herein by reference.

7. This cause of action arises under the patent laws of the United States, and in particular, 35 U.S.C. §§ 271, *et seq.*

8. PST is the owner of the '043 patent, entitled "Optical Apparatus," with all substantial rights to the '043 patent, including the exclusive right to enforce, sue, and recover damages for past and future infringement. A copy of the '043 patent is attached as Exhibit 1.

9. The '043 patent is valid, enforceable, and was duly issued in full compliance with Title 35 of the United States Code.

10. The '043 patent was subject to Reexamination Request No. 90/011,093, filed on July 14, 2010.

11. As a result of Reexamination Request No. 90/011,093, the United States Patent and Trademark Office issued Ex Parte Reexamination Certificate (8445th) on August 2, 2011.

12. Independent claims 1 and 7 of the '043 patent were amended in reexamination, and determined to be patentable in amended form as stated in Ex Parte Reexamination Certificate (8445th).

13. Independent Claim 1 of the '043 patent recites (as shown in Ex Parte Reexamination Certificate (8445th)):

An optical apparatus for use on an object surface, comprising:
an IC package structure, having a first compartment and a second compartment, wherein the first compartment has a first opening and the second compartment has a second opening, and wherein at least one of said first opening and said second opening is a partial opening partially uncovering said corresponding first compartment or second compartment at a side thereof;
a light emitting device bonded in the first compartment, wherein light emitted from the light emitting device passes through the first opening and is reflected by the object surface; and
an optical sensor bonded in the second compartment, and receiving the light reflected through the second opening from the object surface.

14. Original claims 2-6 and 8-12 of the '043 patent were determined to be patentable as a part of Reexamination Request No. 90/011,093 and Ex Parte Reexamination Certificate (8445th).

(Direct Infringement)

15. Defendant has, and continues to, directly infringe one or more claims of the '043 patent in this judicial district and elsewhere in the United States, including at least claims 1 and 5 by, among other things, making, using, selling, offering to sell, selling within, and/or importing

into, the United States proximity sensors, including but not limited to its Rohm rpr0521 proximity sensor (“the Rohm Accused Products”).

16. Attached hereto as Exhibit 2, and incorporated by reference, is an exemplary claim chart detailing how the Rohm Accused Products infringe the ’043 patent.

17. Defendant is liable for these direct infringements pursuant to 35 U.S.C. § 271.

(Indirect Infringement)

18. PST also contends that Defendant has, and continues to, indirectly infringe the ’043 patent by inducing manufacturers of devices that incorporate the Rohm Accused Products (*e.g.*, smartphones, tablets, etc.) to infringe at least claims 1 and 5 through their use of the Rohm Accused Products.

19. Defendant has had knowledge of the ’043 patent since at least service of the original complaint in this matter.

20. Despite having knowledge of the ’043 patent, Defendant has specifically intended and continues to specifically intend for manufacturers of devices that include the Rohm Accused Products to use, sell, offer to sell, and/or import such products in a manner that causes direct infringement of the ’043 patent, including at least claims 1 and 5.

21. More specifically, despite having knowledge of the ’043 patent, Defendant has provided, and continues to provide, instructional materials, datasheets, and other technical information about the Rohm Accused Products to manufacturers of devices that include the Rohm Accused Products that specifically cause, teach, and encourage manufacturers to use, offer to sell, sell and/or import the Rohm Accused Products via devices (*e.g.*, smartphones, tablets, etc.) that include the Rohm Accused Products.

22. PST has been damaged as a result of Defendant's infringing conduct described in this Court. Defendant is, thus, liable to PST in an amount that adequately compensates PST 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.

JURY DEMAND

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

PRAYER FOR RELIEF

PST asks that the Court find in its favor and against Defendant and that the Court grant PST the following relief:

- a. Judgment that one or more claims of the '043 patent have been infringed directly or indirectly either literally and/or under the doctrine of equivalents by Defendant;
- b. Judgment that Defendant account for and pay to Plaintiff all damages and costs incurred by Plaintiff because of Defendant's infringing activities and other conduct complained of herein;
- c. Judgment that Defendant account for and pay to Plaintiff a reasonable, ongoing, post-judgment royalty because of Defendant's infringing activities and other conduct complained of herein;
- d. That PST be granted pre-judgment and post judgment interest on the damages caused by Defendant's infringing activities and other conduct complained of herein; and
- e. That PST be granted such other and further relief as the Court may deem just and proper under the circumstances.

DATED: January 11, 2019

By: /s/ Timothy E. Grochocinski
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