**IN THE UNITED STATES DISTRICT COURT**
**FOR THE DISTRICT OF DELAWARE**

| | | |
|---|---|---|
| WARN INDUSTRIES, INC., a Delaware corporation, | ) | Civil Action No. |
| Plaintiff, | ) | |
| v. | ) | |
| SUPERWINCH, LLC, a Delaware. limited liability company, | ) | JURY TRIAL DEMANDED |
| Defendant | ) | |

## COMPLAINT

Plaintiff Warn Industries, Inc. ("Warn"), herby asserts claims of patent infringement against Superwinch, LLC ("Superwinch"), and alleges as follows:

## PARTIES

1. Warn is a Delaware corporation, with its principal place of business located in Clackamas County, Oregon.

2. Upon information and belief, Superwinch is a Delaware limited liability company, with its principal place of business at 20750 SW 115th Ave, Tualatin, Oregon 97062.

## JURISDICTION AND VENUE

3. This is an action arising under the patent laws of the United States, 35 U.S.C. § 271, et. seq. The Court, therefore, has subject matter jurisdiction pursuant to 28 U.S.C. §§ 1331 and 1338(a).

4. Superwinch is subject to this Court's personal jurisdiction because (1) it is incorporated in this district, (2) upon information and belief, it has conducted such continuous and systematic business so as to feel at home in this district, and (3) upon information and belief, it has committed and/or induced acts of patent infringement in this District by importing, marketing,

offering for sale, and selling their infringing products in this District.

5. Venue is proper pursuant to 28 U.S.C. § 1400 because Superwinch resides in this district.

**PATENT-IN-SUIT**

6. Warn is owner of all right, title, and interest in and to U.S. Patent No. 9,266,702 ("the '702 Patent"), which issued on February 23, 2016, and is entitled "Winch." A true and correct copy of the '702 Patent is attached hereto as Exhibit A. Warn brings this action to seek injunctive relief and recovery of damages arising out of Superwinch's infringement of the '702 Patent.

7. Independent claim 3 and dependent claims 4 and 5 of the'702 Patent, asserted by Warn in this action, are reproduced below (formatting added for clarity).

> 3. A winch, comprising:
>
> a motor having
>
> a motor housing including
>
> a motor case and
>
> a first drum support directly coupled to said motor case for closing an end of said motor case,
>
> said motor including an armature terminal electrically coupling an armature of the motor to a control unit of the winch and
>
> field terminals electrically coupling a field coil assembly of the motor to the control unit,
>
> the armature terminal and field terminals attached to said first drum support; and
>
> a rotatable drum drivingly connected to said motor and supported by said first drum support and a second drum support.
>
> 4. The winch according to claim 3,

wherein said first drum support includes an isolator for electrically isolating said armature terminal and said field terminals from said first drum support and

wherein a plurality of o-rings surround the armature terminal and field terminals between a top portion and bottom portion of the isolator to provide a seal around each of the armature terminal and field terminals.

5. The winch according to claim 3,

said armature terminal and said field terminals being linearly aligned with one another along a top side of the first drum support and

wherein the first drum support is directly coupled to the motor case by corresponding mounting bosses on the motor case and the first drum support.

**BACKGROUND**

8. Warn designs, engineers, and manufactures winches, off-road vehicle accessories, and all-wheel drive (AWD) disconnects.

9. Warn makes and sells a line of winches under the brand name ZEON, certain models of which are covered by the ’702 Patent (“Warn’s Patented Winches”).

10. In compliance with 35 U.S.C. § 287, Warn’s Patented Winches are marked as covered by the ’702 Patent. Specifically, Warn’s Patented Winches have a label indicating that patent information can be found at www.warn.com/patents, which is a page on Warn’s publicly-accessible website titled “Warn Industries Virtual Patent Marking” that identifies Warn’s Patented Winches as covered by the ’702 Patent.

11. Upon information and belief, Superwinch has been on notice of the ’702 Patent since at least the date upon which Warn began marking its Patented Winches.

12. Warn has invested significant time and expense in developing its ZEON line of winches, which are built for jeeps, trucks, and SUVs. Warn employs engineers that develop

cutting-edge solutions to the many challenging issues that arise in personal-use winching operations for jeeps, trucks, and other consumer motor vehicles. In addition to the ’702 Patent, Warn’s extensive research and development efforts in the ZEON winches have also resulted in numerous awards including,

- 2013 SEMA International Product Awards for the ZEON 8000-S from FB Life (China), Action 4x4 Magazine (France), and Overlander 4WD Magazine (China); and
- 2014 SEMA International Product Awards for the ZEON Platinum 10-S from FB Life, Action 4x4 Magazine, and Overlander 4WD Magazine.

13. On information and belief, Superwinch makes, has made, imports, uses, offers to sell, and sells products that infringe the claims of the ‘702 Patent, including, but, upon information and belief, not limited to, winches that are marketed and sold as the Superwinch EXP 8,000 and the Superwinch EXP 10,000 (the “Infringing Products”).

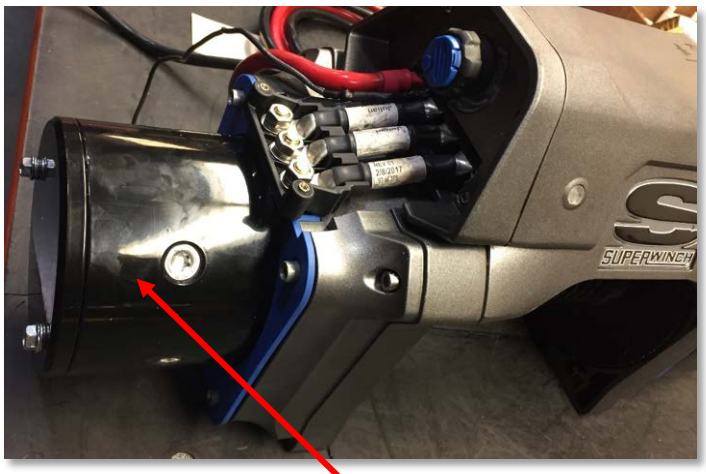
14. Superwinch is not a licensee of the ’702 Patent, nor does Superwinch receive its Infringing Products from a licensee of the ’702 Patent.

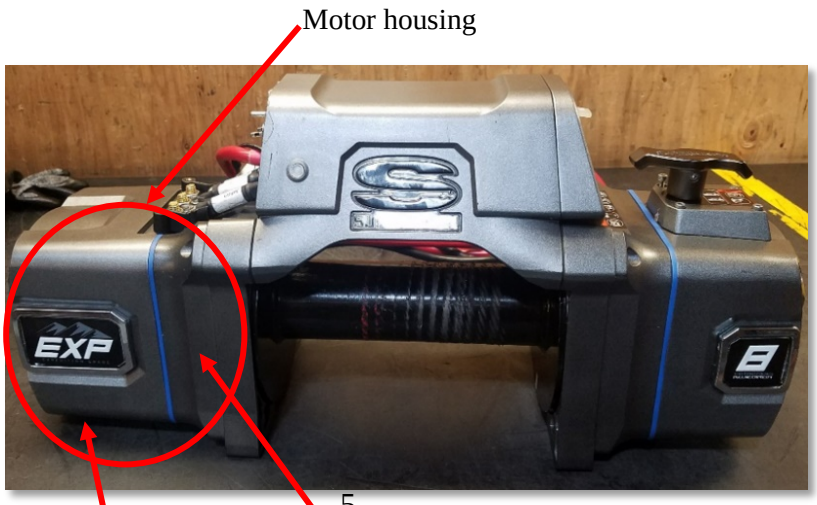
**COUNT I: INFRINGEMENT ON THE ’702 PATENT—SUPERWINCH EXP 8,000**

15. Warn realleges and incorporates by reference each of the preceding paragraphs.

16. The Superwinch EXP 8,000 infringes upon at least claims 3–5 of the ’702 Patent because it has elements that embody each of the limitations of claims 3–5. Specifically, as shown below (in a fair and accurate photo of the Superwinch EXP 8,000), the Superwinch EXP 8,000 is a winch.


17. The Superwinch EXP 8,000, as shown below (in fair and accurate photos of the Superwinch EXP 8,000), has "a motor having a motor housing including a motor case and a first drum support directly coupled to said motor case for closing an end of said motor case."

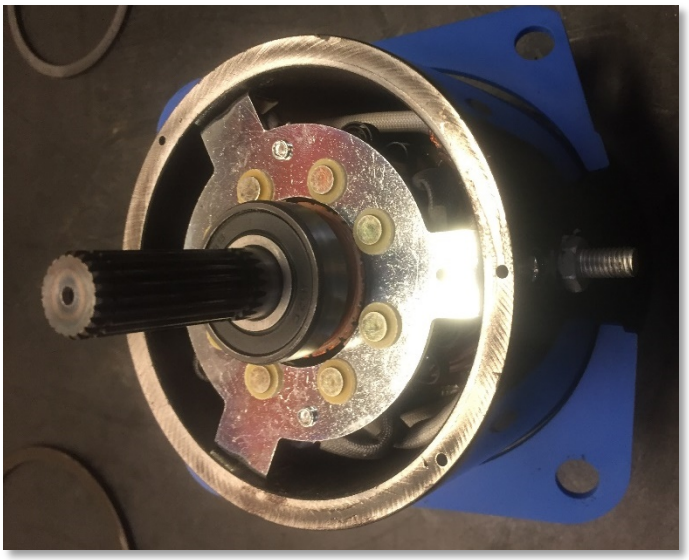


18. The Superwinch EXP 8,000 as shown below (in fair and accurate photos of the Superwinch EXP 8,000), and in the image depicted in connection with Paragraph 20 below, has "an armature terminal electrically coupling an armature of the motor to a control unit of the winch …"

Armature

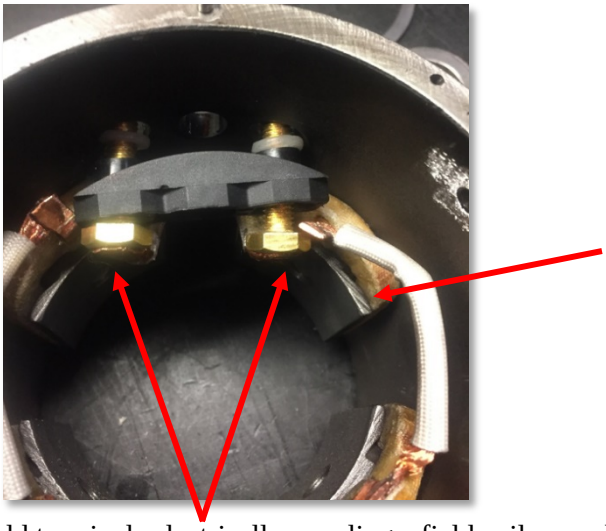
Brush plate



Armature terminal electrically coupling an armature of the motor to a control unit of the winch

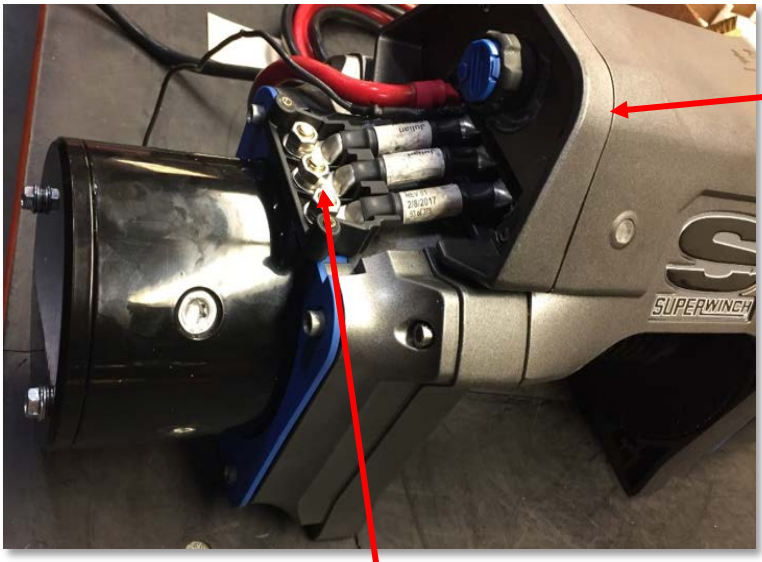
Brush plate

19. The Superwinch EXP 8,000 as shown below (in a fair and accurate photo of the Superwinch EXP 8,000), and in the image depicted in connection with Paragraph 20 immediately below, has "field terminals electrically coupling a field coil assembly of the motor to the control unit."

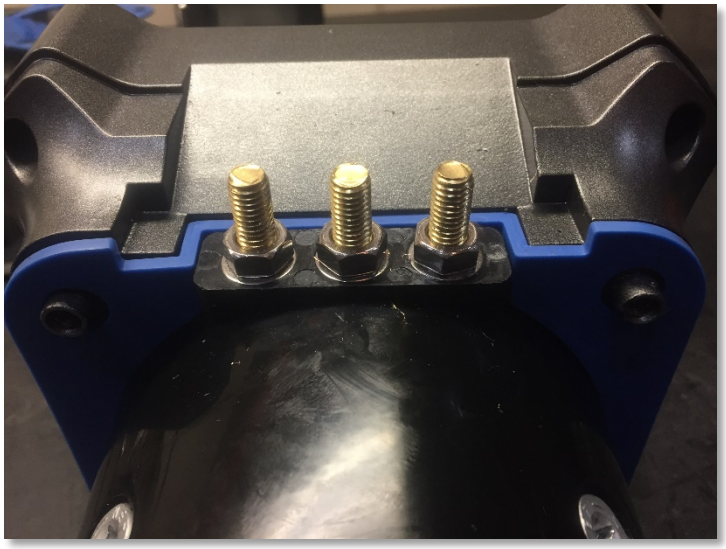



Field terminals electrically coupling a field coil assembly of the motor to the control unit

20. The Superwinch EXP 8,000 as shown below (in a fair and accurate photo of the Superwinch EXP 8,000) has armature and field terminals that are electrically coupled to the control unit.




21. Claim 3 of the ’702 Patent requires armature and field terminals “attached to said first drum support.” The Superwinch EXP 8,000 as shown below (in a fair and accurate photo of the Superwinch EXP 8,000) has armature and field terminals that are attached to the field coil flux ring, which securely nests into the drum support, such that the armature and field terminals are located within an indent notched into the first drum support and roughly align with the edge of the first drum support:



22. Attaching the armature and field terminals to the field coil flux ring, which securely nests into the drum support, such that the armature and field terminals are located within an indent notched into the first drum support and roughly align with the edge of the first drum support is substantially equivalent to attaching the armature and field terminals to the first drum support because the differences between attaching the terminals to the first drum support and attaching the terminals to the field coil flux ring, which securely nests into the drum support, such that the armature and field terminals are located within an indent notched into the first drum support are insubstantial, and because substantially the same function is achieved in substantially the same way to obtain substantially the same result. Specifically, the functions served by attaching the terminals to the first drum support include (1) providing access to the terminals whether the motor case is present or removed; (2) providing additional stability to the terminals; (3) locating the terminals in close proximity to the control unit to reduce manufacturing complexity and cost, (4) orienting the terminals to be in close proximity to one another, aligned, and planar to reduce manufacturing complexity and cost and to improve adaptability, e.g., utilization of a remote; and (5) locating the armature terminal, and the associated brush plate assembly, in close proximity to the drum and drum support for heat dissipation. The same functions are achieved by attaching the terminals to the field coil flux ring such that the terminals are located within an indent notched into the first drum support. The way in which these functions are achieved in the patent is by attaching the armature and field terminals to the drum support. The functions are similarly achieved in the Superwinch EXP 8,000 by attaching the terminals to the field coil flux ring, which securely nests into the drum support, such that the field terminals are located within an indent notched into the first drum support. The results achieved by attaching the terminals to the drum support include (1) providing access to the terminals whether the motor case is present or removed; (2) providing

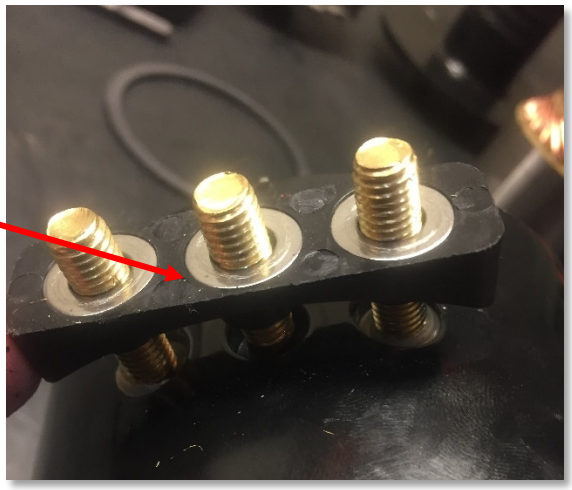
additional stability to the terminals; (3) locating the terminals in close proximity to the control unit to reduce manufacturing complexity and cost, (4) orienting the terminals to be in close proximity to one another, aligned, and planar to reduce manufacturing complexity and cost and to improve adaptability, e.g., utilization of a remote; and (5) locating the armature terminal, and the associated brush plate assembly, in close proximity to the drum and drum support for heat dissipation. The same results are achieved in the Superwinch EXP 8,000 by attaching the terminals to the field coil flux ring, which securely nests into the drum support, such that the armature and field terminals are located within an indent notched into the first drum support.

23. The Superwinch EXP 8,000, as shown below (in a fair and accurate photo of the Superwinch EXP 8,000) contains "a rotatable drum drivingly connected to said motor and supported by said first drum support and a second drum support."

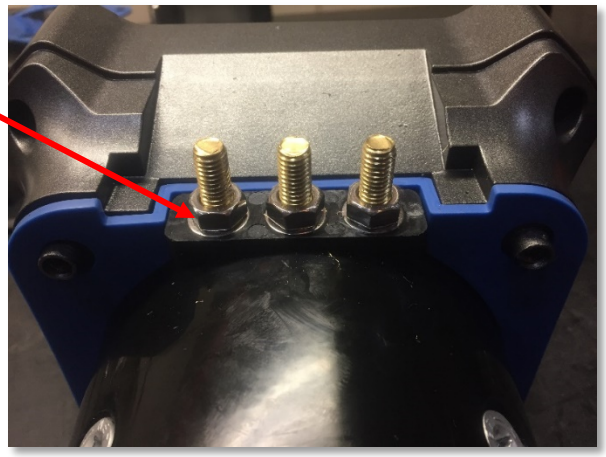

24. The Superwinch EXP 8,000 also infringes upon claim 4 of the '702 Patent. Claim 4 requires, in part, that "said first drum support includes an isolator for electrically isolating said armature terminal and said field terminals from said first drum support." The Superwinch EXP

8,000, as shown below (in fair and accurate photos of the Superwinch EXP 8,000), includes this limitation of claim 4 of the ’702 Patent because the Superwinch EXP 8,000 has an “isolator for electrically isolating said armature terminal and said field terminals from said first drum support …” attached to the field coil flux ring, which securely nests into the drum support, such that the field terminals are located within an indent notched into the first drum support. Attaching the isolator to the field coil flux ring, which securely nests into the drum support, as opposed to attaching it to the drum support, is insubstantially different, and accomplishes substantially the same function in substantially the same way to achieve substantially the same result. Specifically, including the isolator as part of the drum support, when the terminals are attached to the drum support, achieves the functions of electrically isolating the terminals from the drum support and providing a mechanical mounting aid to support and control the terminal positions. Including an isolator attached to the field coil flux ring, which securely nests into the drum support, such that armature and field terminals are located within an indent notched in the first drum support, achieves these same functions. The way in which the functions are achieved is also substantially the same in both applications, using an isolator to isolate the terminals from the drum support and provide a mechanical mounting aid to support and control the terminal positions. The results are also the same—the terminals are electrically isolated from the drum support and enjoy a mechanical mounting that supports and controls the terminal positions.

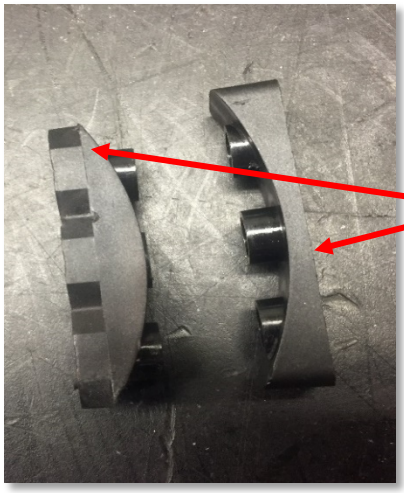
Isolator for electrically isolating said armature terminal and said field terminals from said first drum support



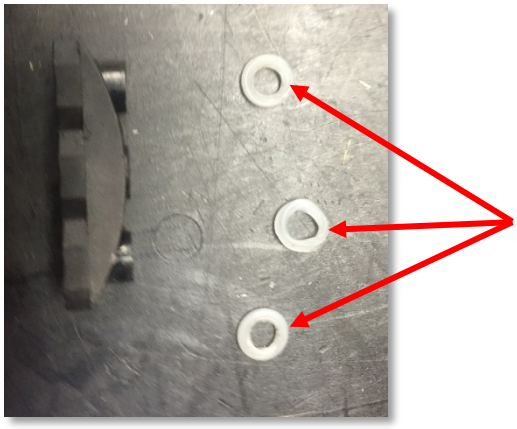
Isolator attached to field coil flux ring such that terminals are located within an indent notched in the first drum support



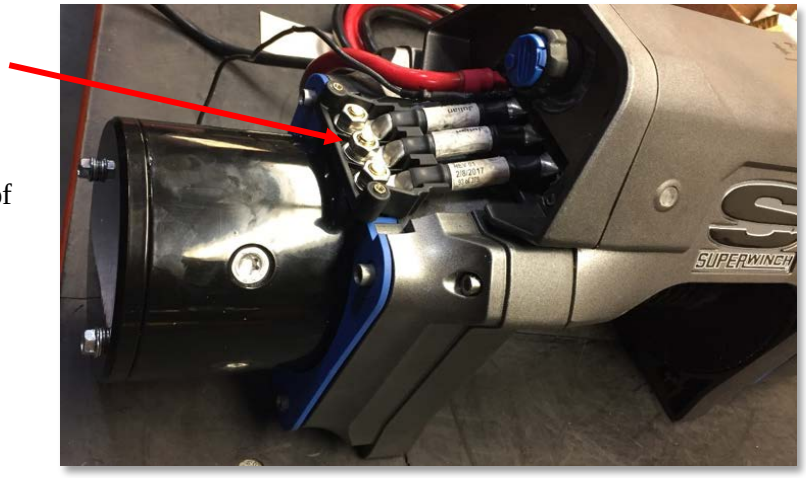
25. The Superwinch EXP 8,000, as shown below (in fair and accurate photos of the Superwinch EXP 8,000), meets the additional limitation of claim 4 of the ’702 Patent because the isolator of the Superwinch EXP 8,000 is an isolator “wherein a plurality of o-rings surround the armature terminal and field terminals between a top portion and bottom portion of the isolator to provide a seal around each of the armature terminal and field terminals.”



Top and bottom portion of isolator

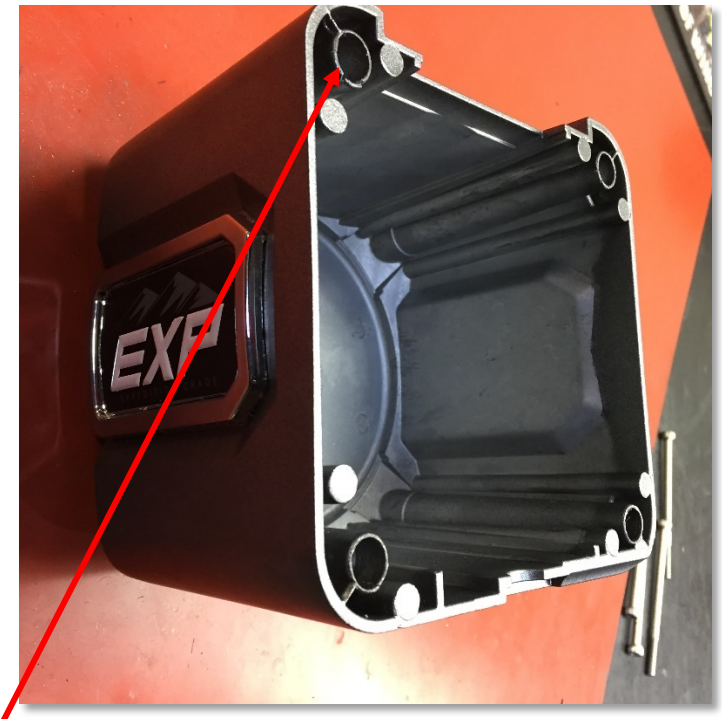



26. The Superwinch EXP 8,000 also infringes upon claim 5 of the '702 Patent. Claim 5 of the '702 Patent requires the armature terminal and field terminals be "linearly aligned with one another along a top side of the first drum support." As shown below (in a fair and accurate photo of the Superwinch EXP 8,000), the Superwinch EXP 8,000 meets this limitation:

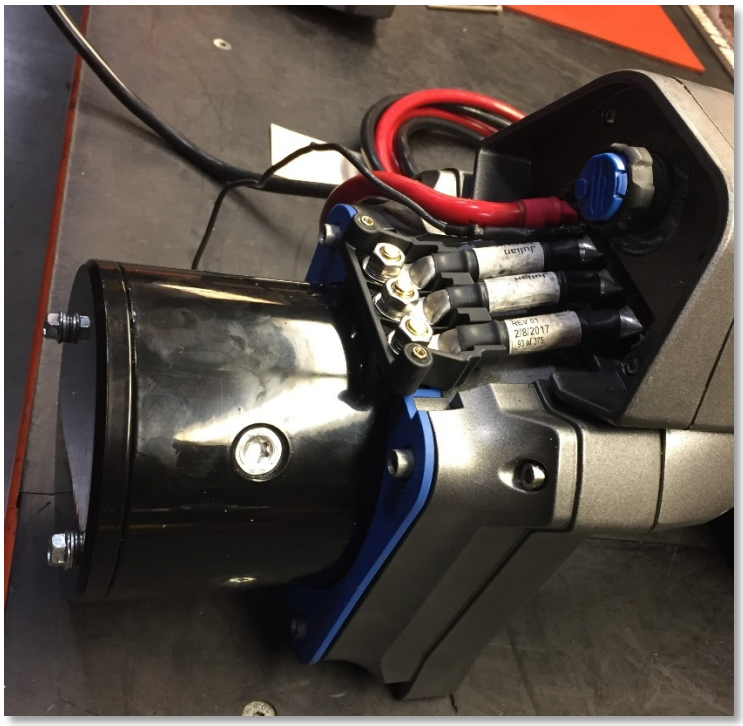



27. The Superwinch EXP 8,000, as shown below (in fair and accurate photos of the Superwinch EXP 8,000), also meets the additional limitation of claim 5 of the '702 Patent because "the first drum support is directly coupled to the motor case by corresponding mounting bosses on

the motor case and the first drum support."




Corresponding mounting bosses on the motor case and the first drum support for directly coupling the first drum support to the motor case



28. On information and belief, Superwinch has infringed and continues to infringe the '702 Patent literally and/or by equivalents under 35 U.S.C. § 271 by making, using, offering for sale, selling and/or importing the Superwinch EXP 8,000.

29. On information and belief, at least as of the filing of this Complaint, Superwinch's infringement of the '702 Patent is and has been willful and deliberate, and, further, Superwinch's continued infringement after the filing of this Complaint shall constitute willful and deliberate infringement of the '702 Patent.

30. Superwinch's ongoing infringement is irreparably harming Warn's business opportunities and sales. Because of Superwinch's infringement, Warn has already suffered and/or will continue to suffer loss of sales, price erosion, missed royalty opportunities, and loss of future earnings for the patented technologies of the '702 Patent. Superwinch's ongoing infringement will continue unless enjoined by this Court, preliminarily and/or permanently under 35 U.S.C. § 283.

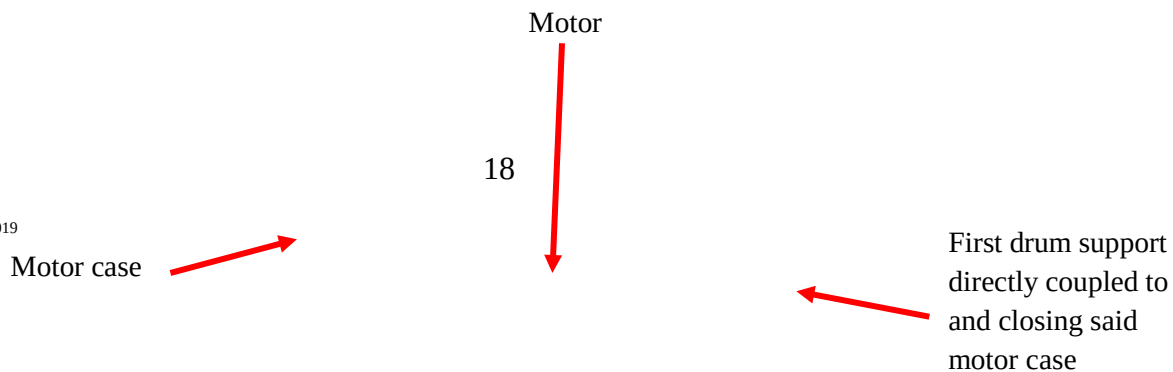
31. Warn is entitled to damages for Superwinch's infringement and may be entitled to enhanced damages and attorneys' fees under 35 U.S.C. §§ 284 and 285.

**COUNT II: INFRINGEMENT ON THE '702 PATENT—SUPERWINCH EXP 10,000**

32. Warn realleges and incorporates by reference each of the preceding paragraphs.

33. The Superwinch EXP 10,000 infringes upon at least claims 3–5 of the '702 Patent because it has elements that embody each of the limitations of claims 3-5. Specifically, as shown below (in a fair and accurate photo of the Superwinch EXP 10,000), the Superwinch EXP 10,000 is a winch.


34. The Superwinch EXP 10,000, as shown below (in fair and accurate photos of the Superwinch EXP 10,000), has "a motor having a motor housing including a motor case and a first drum support directly coupled to said motor case for closing an end of said motor case."

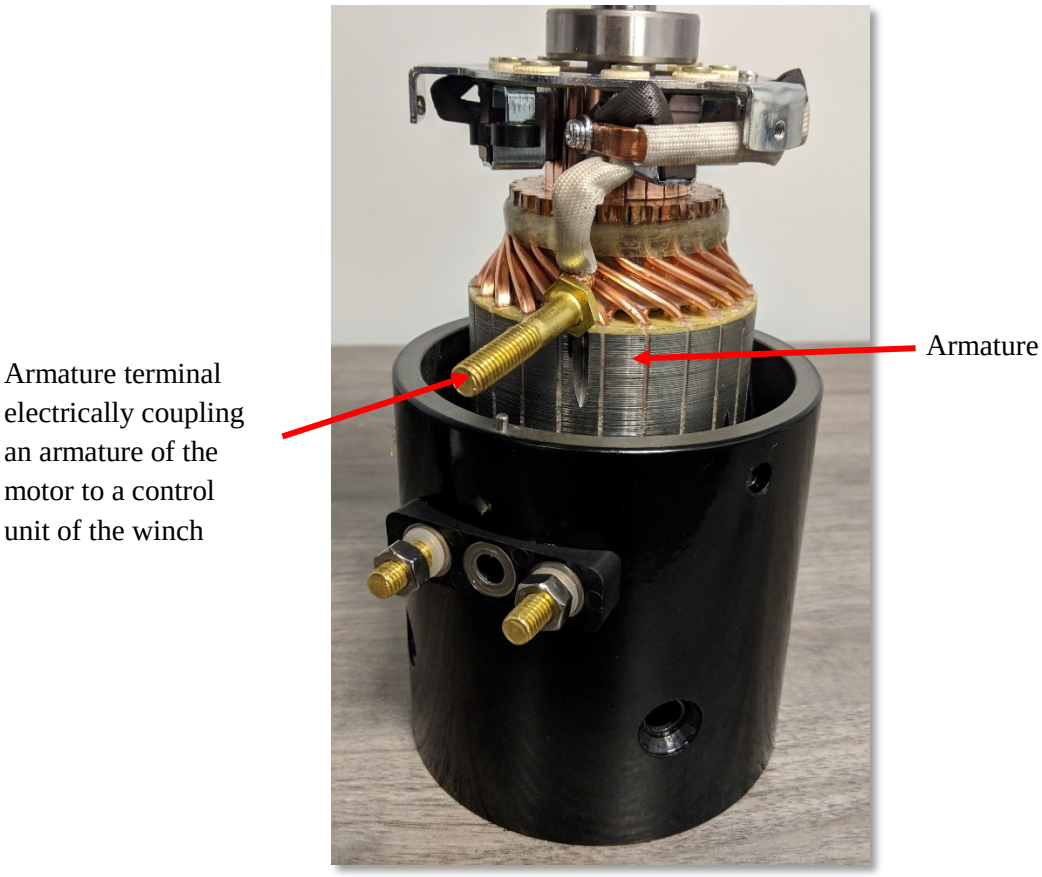



Motor housing

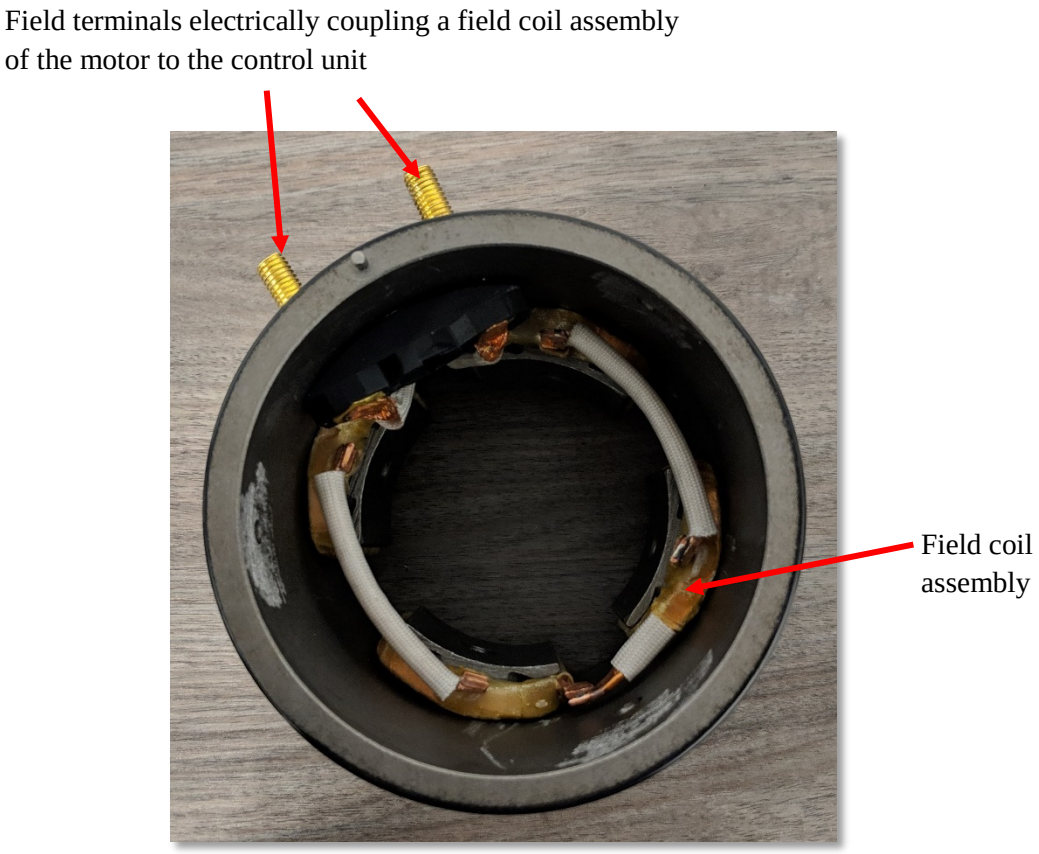

Motor case

First drum support directly coupled to and closing said motor case

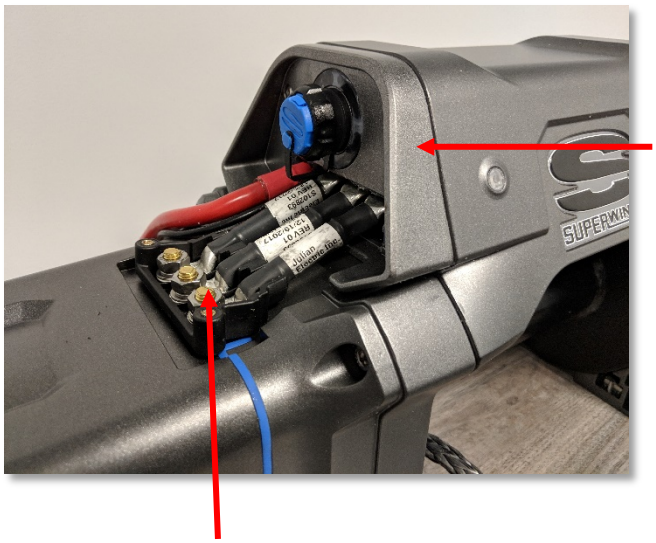
35. The Superwinch EXP 10,000, as shown below (in a fair and accurate photo of the Superwinch EXP 10,000), and in the image depicted in connection with Paragraph 37 below, has "an armature terminal electrically coupling an armature of the motor to a control unit of the winch."



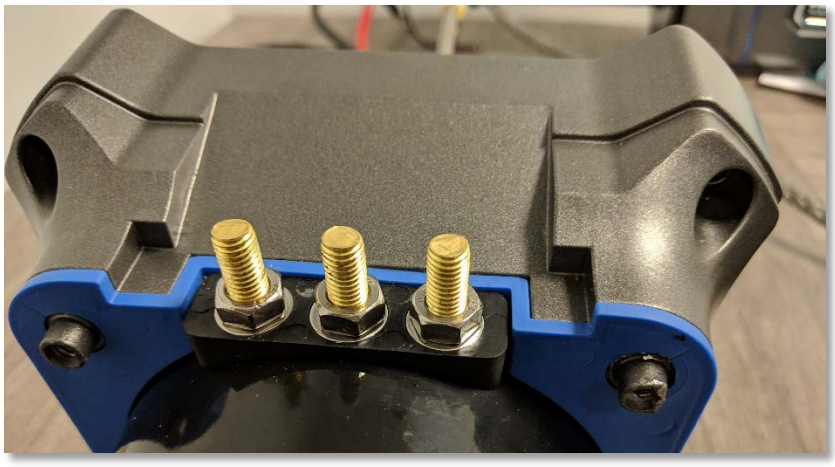

36. The Superwinch EXP 10,000, as shown below (in a fair and accurate photo of the Superwinch EXP 10,000), and in the image depicted in connection with Paragraph 37 immediately below, has "field terminals electrically coupling a field coil assembly of the motor to the control unit."




37. The Superwinch EXP 10,000, as shown below (in a fair and accurate photo of the Superwinch EXP 10,000) has armature and field terminals that are electrically coupled to the control unit.




38. Claim 3 of the ’702 Patent requires armature and field terminals “attached to said first drum support.” The Superwinch EXP 10,000 as shown below (in a fair and accurate photo of the Superwinch EXP 10,000) has armature and field terminals that are attached to the field coil flux ring, which securely nests into the drum support, such that the armature and field terminals are located within an indent notched into the first drum support and roughly align with the edge of the first drum support:

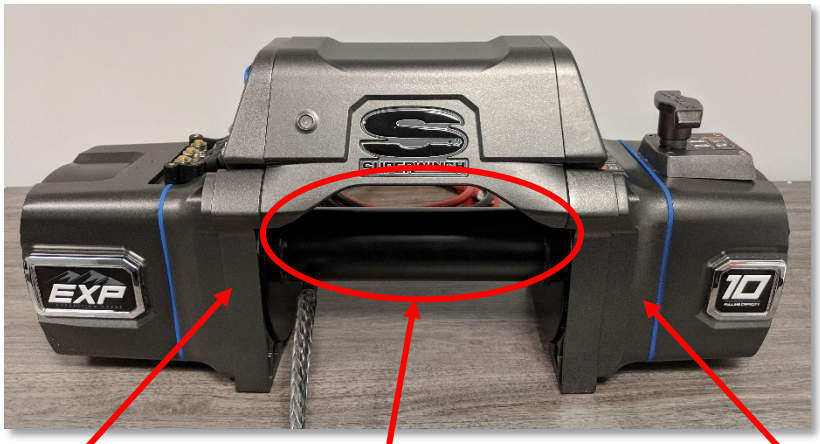


39. Attaching the armature and field terminals to the field coil flux ring, which securely

nests into the drum support, such that the armature and field terminals are located within an indent notched into the first drum support and roughly align with the edge of the first drum support is substantially equivalent to attaching the armature and field terminals to the first drum support because the differences between attaching the terminals to the first drum support and attaching the terminals to the field coil flux ring, which securely nests into the drum support, such that the armature and field terminals are located within an indent notched into the first drum support are insubstantial, and because substantially the same function is achieved in substantially the same way to obtain substantially the same result. Specifically, the functions served by attaching the terminals to the first drum support include (1) providing access to the terminals whether the motor case is present or removed; (2) providing additional stability to the terminals; (3) locating the terminals in close proximity to the control unit to reduce manufacturing complexity and cost, (4) orienting the terminals to be in close proximity to one another, aligned, and planar to reduce manufacturing complexity and cost and to improve adaptability, e.g., utilization of a remote; and (5) locating the armature terminal, and the associated brush plate assembly, in close proximity to the drum and drum support for heat dissipation. The same functions are achieved by attaching the terminals to the field coil flux ring, which securely nests into the drum support, such that the terminals are located within an indent notched into the first drum support. The way in which these functions are achieved is by attaching the armature and field terminals to the drum support. The functions are similarly achieved in the Superwinch EXP 10,000 by attaching the terminals to the field coil flux ring, which securely nests into the drum support, such that the field terminals are located within an indent notched into the first drum support. The results achieved by attaching the terminals to the drum support include (1) providing access to the terminals whether the motor case is present or removed; (2) providing additional stability to the terminals; (3) locating the terminals

in close proximity to the control unit to reduce manufacturing complexity and cost, (4) orienting the terminals to be in close proximity to one another, aligned, and planar to reduce manufacturing complexity and cost and to improve adaptability, e.g., utilization of a remote; and (5) locating the armature terminal, and the associated brush plate assembly, in close proximity to the drum and drum support for heat dissipation. The same results are achieved in the Superwinch EXP 10,000 by attaching the terminals to the field coil flux ring, which securely nests into the drum support, such that the armature and field terminals are located within an indent notched into the first drum support.

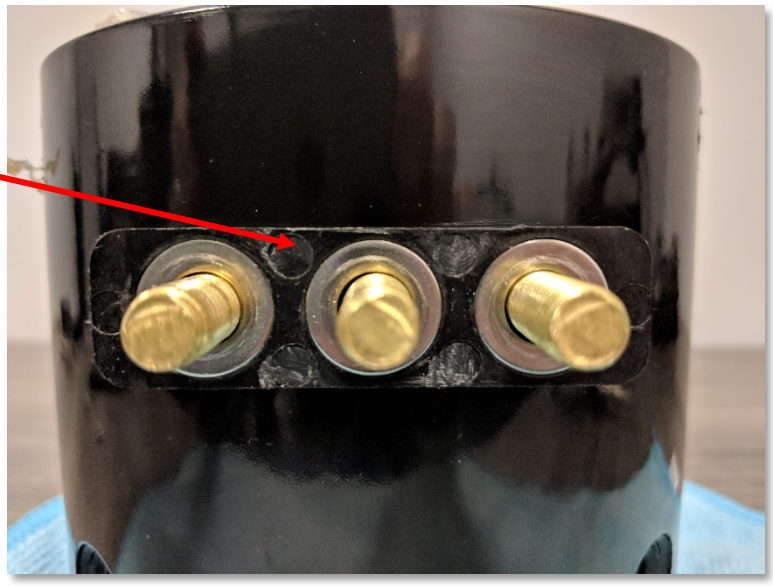
40. The Superwinch EXP 10,000, as shown below (in a fair and accurate photo of the Superwinch EXP 10,000) contains "a rotatable drum drivingly connected to said motor and supported by said first drum support and a second drum support."



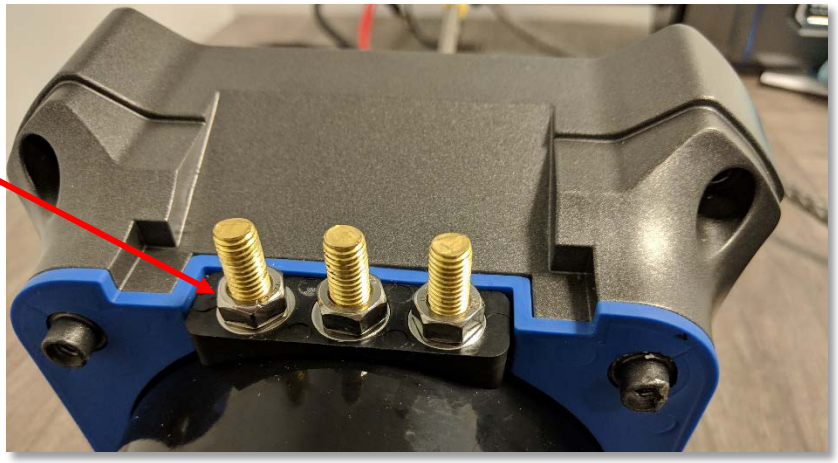

41. The Superwinch EXP 10,000 also infringes upon claim 4 of the '702 Patent. Claim 4 requires, in part, that "said first drum support includes an isolator for electrically isolating said armature terminal and said field terminals from said first drum support." The Superwinch EXP

10,000, as shown below (in fair and accurate photos of the Superwinch EXP 10,000), includes this limitation of claim 4 of the '702 Patent because the Superwinch EXP 10,000 has an "isolator for electrically isolating said armature terminal and said field terminals from said first drum support …" attached to the field coil flux ring, which securely nests into the drum support, such that the field terminals are located within an indent notched into the first drum support. Attaching the isolator to the field coil flux ring, which securely nests into the drum support, as opposed to attaching it to the drum support, is insubstantially different, and accomplishes substantially the same function in substantially the same way to achieve substantially the same result. Specifically, including the isolator as part of the drum support, when the terminals are attached to the drum support, achieves the functions of electrically isolating the terminals from the drum support and providing a mechanical mounting aid to support and control the terminal positions. Including an isolator attached to the field coil flux ring, which securely nests into the drum support, such that armature and field terminals are located within an indent notched in the first drum support achieves these same functions. The way in which the functions are achieved is also substantially the same in both applications, using an isolator to isolate the terminals from the drum support and provide a mechanical mounting aid to support and control the terminal positions. The results are also the same—the terminals are electrically isolated from the drum support and enjoy a mechanical mounting that supports and controls the terminal positions.

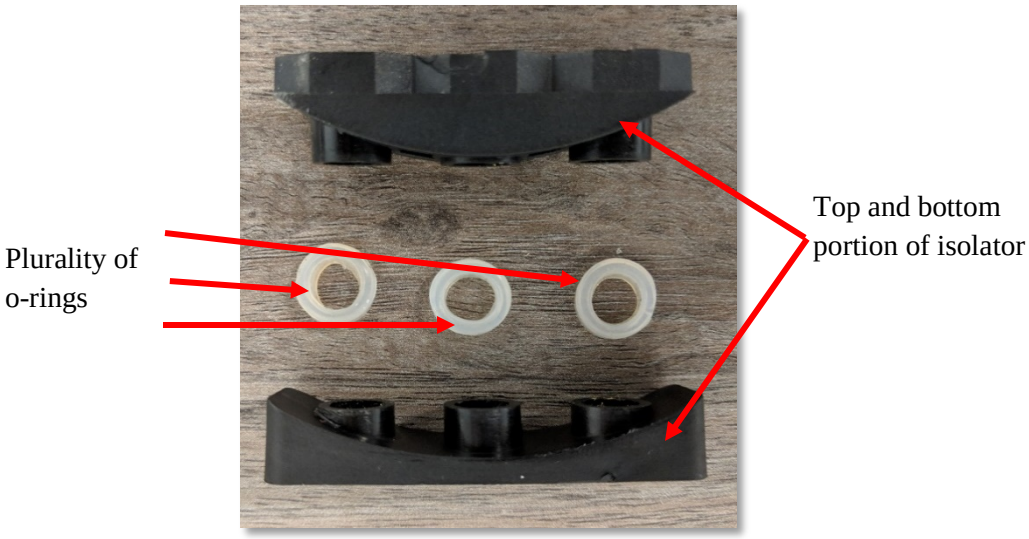
Isolator for electrically isolating said armature terminal and said field terminals from said first drum support



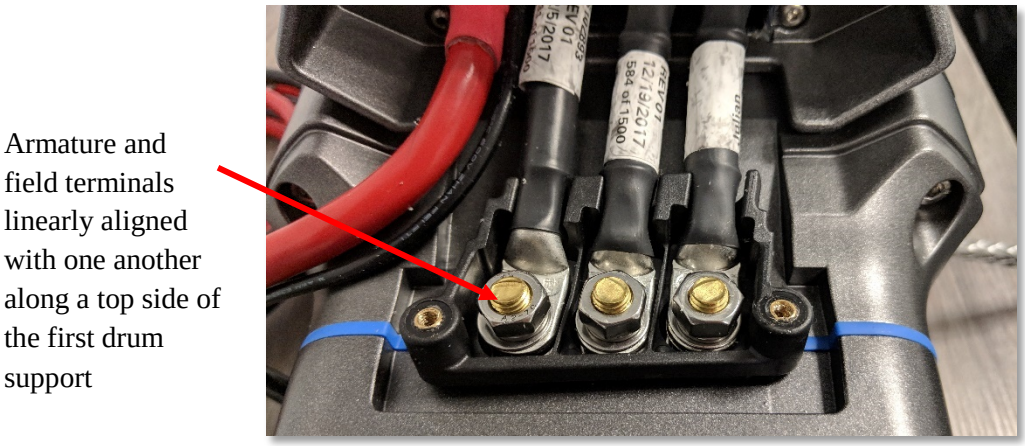
Isolator attached to field coil flux ring such that terminals are located within an indent notched in the first drum support



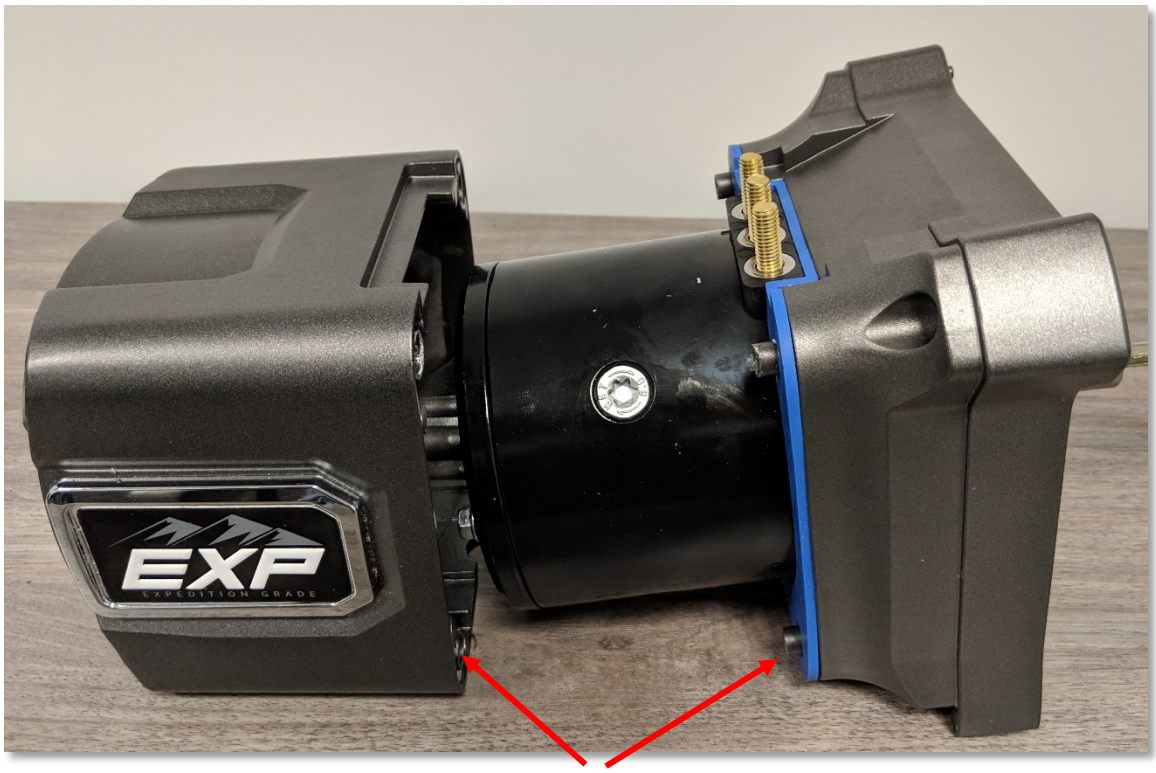
42. The Superwinch EXP 10,000, as shown below (in fair and accurate photos of the Superwinch EXP 10,000), meets the additional limitation of claim 4 of the ’702 Patent because the isolator of the Superwinch EXP 10,000 is an isolator “wherein a plurality of o-rings surround the armature terminal and field terminals between a top portion and bottom portion of the isolator to provide a seal around each of the armature terminal and field terminals.”




43. The Superwinch EXP 10,000 also infringes upon claim 5 of the ’702 Patent. Claim 5 of the ‘702 Patent requires the armature terminal and field terminals be “linearly aligned with one another along a top side of the first drum support.” As shown below (in a fair and accurate photo of the Superwinch EXP 10,000), the Superwinch EXP 10,000 meets this limitation:




44. The Superwinch EXP 10,000, as shown below (in a fair and accurate photo of the Superwinch EXP 10,000), also meets the additional limitation of claim 5 of the ’702 Patent because “the first drum support is directly coupled to the motor case by corresponding mounting bosses on the motor case and the first drum support.”




Corresponding mounting bosses on the motor case and the first drum support for directly coupling the first drum support to the motor case

45. On information and belief, Superwinch has infringed and continues to infringe the '702 Patent literally and/or by equivalents under 35 U.S.C. § 271 by making, using, offering for sale, selling and/or importing the Superwinch EXP 10,000.

46. On information and belief, at least as of the filing of this Complaint, Superwinch's infringement of the '702 Patent is and has been willful and deliberate, and, further, Superwinch's continued infringement after the filing of this Complaint shall constitute willful and deliberate infringement of the '702 Patent.

47. Superwinch's ongoing infringement is irreparably harming Warn's business opportunities and sales. Because of Superwinch's infringement, Warn has already suffered and/or will continue to suffer loss of sales, price erosion, missed royalty opportunities, and loss of future earnings for the patented technologies of the '702 Patent. Superwinch's ongoing infringement will

continue unless enjoined by this Court, preliminarily and/or permanently under 35 U.S.C. § 283.

48. Warn is entitled to damages for Superwinch's infringement and may be entitled to enhanced damages and attorneys' fees under 35 U.S.C. §§ 284 and 285.

## DAMAGES AND RELIEF

49. As a consequence of Superwinch's infringement of the '702 Patent, Warn has been damaged in an amount not yet determined and will suffer additional irreparable damage unless Superwinch's infringing acts are enjoined by this Court.

## PRAYER FOR RELIEF

WHEREFORE, Warn respectfully requests that the Court enter judgment against Superwinch:

A. Determining that Superwinch has infringed and continues to infringe one or more claims of the '702 Patent;

B. A preliminary and permanent injunction enjoining Superwinch, its respective officers, agents, servants, directors, employees, and attorneys, and all persons acting in concert or in participation with it, directly or indirectly, or any of them who receive actual notice of the judgment, from further infringing the '702 Patent.

C. Ordering Superwinch to account for and pay to Warn all damages suffered by Warn as a consequence of Superwinch's infringement of the '702 Patent, together with all pre-judgment and post-judgment interests and costs as fixed by the Court;

D. A declaration that Superwinch's infringement of the '702 Patent has been willful and that this case is exceptional under 35 U.S.C. § 285;

E. Enhanced damages, costs, and attorneys' fees if appropriate under 35 U.S.C. §§ 284 and 285;

F. Granting Warn such other and further relief as the Court may deem just and proper.

**DEMAND FOR JURY TRIAL**

In accordance with Federal Rule of Civil Procedure 38(b), Warn demands a trial by jury on all issues so triable.

Dated: February 1, 2019

OF COUNSEL:

Barry F. Irwin, P.C.
Reid Huefner
Adam Reis
**Irwin IP LLC**
1333 Burr Ridge Parkway, Suite 200
Burr Ridge, IL 60527
(*Pro Hac Vice* Motions to be filed)
Dated: February 1, 2019

**SAUL EWING ARNSTEIN & LEHR LLP**

*/s/Elizabeth S. Fenton*
Elizabeth S. Fenton (#5563)
1201 N. Market Street, Suite 2300
Wilmington, DE 19801
(302) 421-6800
elizabeth.fenton@saul.com

*Attorneys for Warn Industries, Inc.*