

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

RR Donnelley and Sons Company,

Plaintiff,

v.

Canon, Inc. and Canon USA, Inc.,

Defendants.

Civil Action No. 20-cv-2115

JURY TRIAL DEMANDED

COMPLAINT FOR PATENT INFRINGEMENT

Plaintiff, RR Donnelley and Sons Company (hereafter “RRD” or “Plaintiff”), brings this action for patent infringement against Canon, Inc. and Canon USA, Inc. (collectively hereafter “Canon” or “Defendant”) and alleges as follows:

NATURE OF THE ACTION

1. This action arises under the patent laws of the United States, 35 U.S.C. §§ 101 *et seq.*, for infringement of U.S. Patent No. 6,327,599 (“the ‘599 patent”) and U.S. Patent No. 7,949,945 (“the ‘945 patent”)(collectively, “patents-in-suit”).
2. The ‘599 patent is entitled “Apparatus for Controlling an Electronic Press to Print Fixed and Variable Information” and was duly and legally issued by the United States Patent and Trademark Office on December 4, 2001 to James L. Warmus and Mark G. Dreyer. A copy of the ‘599 patent is attached hereto as Exhibit A.

3. The ‘945 patent” is entitled “Variable Text Processing for an Electronic Press” and was duly and legally issued by the United States Patent and Trademark Office on May 24, 2011 to James L. Warmus and Mark G. Dreyer. A copy of the ‘945 patent is attached hereto as Exhibit B.

4. The patents-in-suit were duly and legally assigned to RRD. RRD owns all right, title, and interest in, and to the patents-in-suit.

THE PARTIES

5. Plaintiff RRD is a Delaware corporation having its principal place of business at 35 West Wacker Drive, Chicago, Illinois 60601.

6. Plaintiff RRD is a leading global provider of multichannel business communications services and marketing solutions. Founded more than 155 years ago, RRD works collaboratively with more than 50,000 clients and 36,400 employees across 29 countries. RRD offers the industry’s most comprehensive offering of solutions designed to help companies—from Main Street to Wall Street—optimize customer engagement and streamline business operations across the complete customer journey. RRD offers a comprehensive portfolio of capabilities, experience and scale that enables organizations around the world to create, manage, deliver, and optimize their marketing and business communications strategies.

7. On information and belief, Defendant Canon, Inc. is a corporation organized and existing under the laws of Japan, having its principal place of business at 30-2, Shimomaruko 3-chome, Ohta- ku, Tokyo 146-8501, Japan. Defendant Canon USA, Inc. is a corporation organized and

existing under the laws of the State of New York, and has its principal place of business at One Canon Park, Melville, NY 11747.

JURISDICTION AND VENUE

10. This is a civil action arising under the Patent Laws of the United States, 35 U.S.C. §§ 101 et seq., for damages and injunctive relief as provided in 35 U.S.C. § 281 and §§ 283-285.

11. This Court has subject matter jurisdiction of this action under 28 U.S.C. §§ 1331 and 1338(a).

12. Personal jurisdiction over Canon is proper in this District because Canon is qualified to do business in the State of Illinois and may be served by its registered agent at Illinois Corporate Service Corp., 801 Adlai Stevenson Drive, Springfield, Il 62703. Moreover, on information and belief, Canon has committed direct and/or indirect acts of patent infringement throughout the State of Illinois, including within the Northern District of Illinois.

13. Venue is proper in this District under 28 U.S.C. §1391(b), (c) and 1400(b) because Defendant has regularly conducted business in this judicial district, and certain of the acts complained of herein occurred in this judicial district. Furthermore, Canon maintains a regular and established place of business in Chicago.

FACTUAL ALLEGATIONS

14. RRD is the owner of the patents-in-suit, with the right to collect damages for all relevant times, and has the right to prevent others from making, having made, using, offering for sale or

selling products or services covered by such patents, as well as the right to enforce the patents-in-suit with respect to Defendant Canon.

15. The patents-in-suit are generally directed to methods and apparatus for efficiently printing items, such as, without limitation, personalized direct mail pieces and individualized financial statements that contain both static and variable information.

16. Canon is engaged in the business of making, using, and selling, and causing to be offered for sale and sold, including without limitation within this District, digital color press systems that practice the inventions claimed in the patents-in-suit.

17. In 2009 RRD licensed Canon to its family of patents related to Variable Data Printing (“Canon License”). That license includes the patents-in-suit.

18. The Canon License provided Canon a license under the RRD patents. However, Canon’s rights under the Canon License were limited. The Canon License did not extend to a competitor company Océ N.V. (“Océ”) or Océ products in the event of an acquisition of Océ by Canon.

19. In 2010 Canon acquired Océ. Océ is one of the competitors listed in the Canon License that is excluded from being covered under the Canon License.

20. Since at least 2013, Canon has been selling Océ products in the United States. Such sales are not licensed as they were specifically excluded from the Canon License.

21. Océ’s digital press systems for variable data printing applications, including without limitation the ProStream, ColorStream and ImageStream systems (“Océ Systems”), infringe claims of at least the ‘945 and ‘599 patents, and likely infringe other patents in the RRD variable

data printing portfolio. Canon promotes the use of Quadient/GMC Inspire software with its digital press systems, including Océ Systems, for creating customer communications, including variable data applications. For example, see the following links:

- https://www.canon.com.cy/for_work/business-products/production-printing/software/communication-process-management/quadient-inspire/
- <https://csa.canon.com/internet/portal/us/csa/products/details/software/production-software/quadient-inspire-enterprise/quadient-inspire-enterprise>
- https://lfpp.csa.canon.com/main/view_media.jsp?CONTENT%3C%3Ecnt_id=10134198673404461&FOLDER%3C%3Efolder_id=9852723696641506&bmUID=mprla7m

COUNT I (INFRINGEMENT OF U.S. PATENT NO. 6,327,599)

22. Plaintiff RRD incorporates paragraphs 1 through 21 as though fully set forth herein.

23. On information and belief, Océ Systems comprise a method of controlling an electronic press wherein the press includes a controller responsive to press commands.

24. On information and belief, Defendant Canon has infringed, induced infringement of, and/or contributorily infringed, and continues to infringe, induce infringement of, and/or contributorily infringe, one or more claims of the '599 patent, including at least claim 11, in violation of 35 U.S.C. § 271, literally or under the doctrine of equivalents, in this District and elsewhere in the United States, by its activities, including, but not limited to making, using, offering to sell, selling and/or importing Océ Systems.

25. On information and belief, brochures and instructional materials distributed by Canon instruct customers how to use the Océ Systems in accordance with one or more of the asserted claims of the '599 patent.

26. Canon has knowledge of the '599 patent and intended for its customers to use the Océ Systems identified above in a manner that infringes one or more claims of the '599 patent.

27. Canon's infringement, inducement of infringement and/or contributory infringement of at least claim 11 of the '599 patent has been and continues to be deliberate and willful, making this an exceptional case pursuant to 35 U.S.C. § 285.

28. RRD has been damaged and will be irreparably injured by Canon's continuing infringement of the '599 patent, for which RRD has no adequate remedy at law.

COUNT II (INFRINGEMENT OF U.S. PATENT NO. 7,949,945)

29. Plaintiff RRD incorporates paragraphs 1 through 28 as though fully set forth herein.

30. Océ Systems comprise a system for generating page files from a template file and records in a database wherein the template file comprises data designating a first variable text area and a second variable text area.

31. Defendant Canon has infringed, induced infringement of, and/or contributorily infringed, and continues to infringe, induce infringement of, and/or contributorily infringe, one or more claims of the '945 patent, including at least claim 1, in violation of 35 U.S.C. § 271, literally or under the doctrine of equivalents, in this District and elsewhere in the United States, by its

activities, including, but not limited to making, using, offering to sell, selling and/or importing Océ Systems.

32. On information and belief, brochures and instructional materials distributed by Canon instruct customers how to use the Océ Systems in accordance with one or more of the asserted claims of the '945 patent.

33. Canon has knowledge of the '945 patent and intended for its customers to use the Océ Systems identified above in a manner that infringes one or more claims of the '945 patent.

34. Canon's infringement, inducement of infringement and/or contributory infringement of at least claim 1 of the '945 patent has been and continues to be deliberate and willful, making this an exceptional case pursuant to 35 U.S.C. § 285.

35. RRD has been damaged and will be irreparably injured by Canon's continuing infringement of the '945 patent, for which RRD has no adequate remedy at law.

REQUEST FOR RELIEF

WHEREFORE, Plaintiff RRD requests the following relief:

A. A judgment that Canon has infringed, directly or indirectly, one or more claims of the '945 patent;

B. A judgment that Canon has infringed, directly or indirectly, one or more claims of the '599 patent;

- C. A judgment and order requiring Canon to pay RRD any and all damages, plus pre-judgment and post-judgment interest, as well as supplemental damages for any continuing post-verdict infringement up until entry of the final judgment with an accounting as needed;
- D. A judgment and order increasing the amount of actual damages by this Court, up to a trebled amount, because of the willful and deliberate nature of Canon's acts of infringement, as provided for in 35 U.S.C. § 284;
- E. A declaration that this is an exceptional case and an award of RRD's costs and attorneys' fees pursuant to 35 U.S.C. § 285; and,
- F. Such further and additional relief as this Court may deem just, proper, and equitable.

Dated: April 2, 2020

Respectfully submitted,

/s/ Richard T. McCaulley, Jr.
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