

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

JOHNSON CONTROLS TECHNOLOGY  
COMPANY,

Plaintiff,

V.

DISTECH CONTROLS INC.,

Defendant.

$$\begin{array}{c} ) \\ ) \\ ) \\ ) \\ ) \\ ) \\ ) \\ ) \\ ) \end{array}$$

Civil Action No. 20-961-MN

## DEMAND FOR JURY TRIAL

**FIRST AMENDED COMPLAINT FOR PATENT INFRINGEMENT**

Plaintiff Johnson Controls Technology Company (“JCTC” or “Plaintiff”), by and through its attorneys, brings this amended action for patent infringement against Distech Controls Inc. (“Distech” or “Defendant”).

### NATURE OF ACTION

1. This is an action for infringement of United States Patent Nos. 6,369,716 (“the ’716 patent”), 7,025,281 (“the ’281 patent”), and 9,952,074 (“the ’074 patent”) (collectively, “Asserted Patents”), under the Patent Act, 35 U.S.C. § 271, based on Defendant’s unauthorized manufacture, use, offer for sale, and/or sale in the United States, and/or importation into the United States of at least ECY-VAV, ECB-VAV, and ECL-VAV Controller devices (collectively, “VAV Controller(s)”), Allure series RT and HP Communicating Thermostats (collectively, “Allure Thermostat(s)”), the EC-gfx program, and the ECLYPSE Connected System Controller (“Eclipse Controller”) (collectively, “Accused Product(s)”) and its acts that induce and/or contribute to the use of the Accused Products.

2. The Accused Products and methods of using the Accused Products (“Accused Methods”) relate to Defendant’s Accused Products and their use(s).

### **PARTIES**

3. Johnson Controls Technology Company is a company organized and existing under the laws of the State of Michigan and having a place of business at 40600 Ann Arbor Rd E Ste 201 Plymouth, MI 48170.

4. On information and belief, Distech Controls Inc. is a British Columbia Company organized and existing under the laws of Canada, having its corporate offices and principal place of business at 4205 Place de Java, Brossard, Quebec, J4Y 0C4, Canada.

### **JURISDICTION AND VENUE**

5. This action arises under the Patent Act, 35 U.S.C. § 1 *et seq.*, including in particular 35 U.S.C. §§ 271, 281, 283, 284, and 285.

6. This Court has exclusive jurisdiction over the subject matter of this action under 28 U.S.C. §§ 1331, 1338, 2201, and 2202.

7. On information and belief, Distech Controls Inc. is subject to personal jurisdiction in Delaware because, among other things, Distech Controls Inc., itself and through its subsidiaries and/or corporate affiliates, maintains continuous and systematic contacts with the state of Delaware, and has purposefully availed itself of the benefits and protections of Delaware's laws, such that it should reasonably anticipate being haled into court here. In particular, on information and belief, Distech Controls Inc. employs Delaware residents, employs senior employees, including a sales manager, who are responsible for directing Distech Controls Inc.'s product lines at Delaware-based buyers and users, and partners with other entities who direct the sale of Distech Controls Inc. branded products into Delaware, including at least Dynatech Controls, Inc.

8. On information and belief, Distech Controls Inc. is subject to personal jurisdiction in the State of Delaware, because it (either directly, or through its corporate affiliates), develops,

manufactures, imports, markets, offers to sell, and/or sells the Accused Products and encourages others to practice the Accused Methods throughout the United States, including in the State of Delaware and therefore targets and transacts business within the State of Delaware.

9. Venue is proper in this District as to Distech Controls Inc. under 28 U.S.C. § 1391 and 28 U.S.C. § 1400 because Distech Controls Inc. is a corporation organized and existing under the laws of Canada and is subject to personal jurisdiction in this judicial district.

### **BACKGROUND**

10. Johnson Controls International, plc (“JCI”) has been a leader in the field of building and energy management systems since it was founded in 1885 as Johnson Electric Services Company—two years after its founder, Warren Johnson, first patented an electric room thermostat. As a result of its over 130 years of innovation, JCI has a leading portfolio of building technology and solutions that transform and enhance the environments where people live, work, learn, and play.

11. Since its founding, JCI has made significant investments in the engineering, design, and development of building and energy management systems and technologies and has secured patent protection for its innovations.

12. Today, JCI remains an industry and market leader. JCTC, as JCI’s technology holding company, holds over 210 issued U.S. patents and more than 240 pending U.S. patent applications, including related to building automation, energy optimization, and similar technologies.

### **THE PATENTS-IN-SUIT**

13. The ’716 patent, entitled “System and method for controlling air quality in a room,” was duly and legally issued on April 9, 2002, naming Mustafa Abbas, John E. Seem, and Bernard Philippe Nicolas Clement as the inventors. A true and correct copy of the ’716 patent is

attached hereto as Exhibit A. Plaintiff JCTC is the assignee and lawfully owns all right, title, and interest in the '716 patent, including the right to sue for infringement thereof.

14. The '281 patent, entitled "Programmable thermostat incorporating air quality protection," was duly and legally issued on April 11, 2006, naming Michael R. DeLuca as the inventor. A true and correct copy of the '281 patent is attached hereto as Exhibit B. Plaintiff JCTC is the assignee and lawfully owns all right, title, and interest in the '281 patent, including the right to sue for infringement thereof.

15. The '074 patent, entitled "HVAC system with automated flow direction detection," was duly and legally issued on April 24, 2018, naming Mark G. Freund, Troy A. Goldschmidt, Gary W. Gavin, Brandon A. Sloat, and Timothy C. Gamroth as the inventors. A true and correct copy of the '074 patent is attached hereto as Exhibit C. Plaintiff JCTC is the assignee and lawfully owns all right, title, and interest in the '074 patent, including the right to sue for infringement thereof.

#### **DEFENDANT'S INFRINGING ACTS**

16. Defendant provides hardware, software, and services that directly infringe or induce and/or contribute to infringement of the Asserted Patents, including the VAV Controllers, Allure Thermostats, Eclipse Controller, and other products with similar functionality. In addition to providing hardware, software, and services, Defendant provides its customers with instructions, product information, and technical information for using the hardware, software, and services that, among other things, instruct the customer to act in an infringing manner.

#### **Infringement of the '716 Patent**

17. On information and belief, Defendant directly and/or through distributors or resellers, makes, sells, and offers for sale, the EC-gfx program and the Eclipse Controller products that infringe the '716 patent and induce others, including customers, purchasers, users,

or a combination thereof, to perform, either literally or under the doctrine of equivalents, each and every step of at least claim 1 of the '716 patent. A claim chart comparing the claim elements of claim 1 of the '716 patent to the induced use of the EC-gfx program in combination with the Eclipse Controller products sold by Defendant for use in the claimed method is attached as Exhibit D.

#### **Infringement of the '281 Patent**

18. On information and belief, Defendant directly and/or through distributors or resellers, makes, sells, and offers for sale, the Allure Thermostat products that directly infringe the '281 patent, either literally or under the doctrine of equivalents, and uses the Allure Thermostat products that directly infringe the '281 patent. Defendant induces others, including customers, purchasers, users, or a combination thereof, to use the infringing Allure Thermostat products and has contributed, and continues to contribute, to the infringement of at least claim 1 of the '281 patent. A claim chart comparing the claim elements of claim 1 of the '281 patent to the Allure Thermostat products sold by Defendant for use in the claimed method is attached as Exhibit E.

#### **Infringement of the '074 Patent**

19. On information and belief, Defendant directly and/or through distributors or resellers, makes, sells, and offers for sale, VAV Controller products that directly infringe the '074 patent, either literally or under the doctrine of equivalents, and use its VAV Controller products to directly infringe the '074 patent. Defendant induces others, including customers, purchasers, users, or a combination thereof, to use the infringing VAV Controllers and has contributed, and continues to contribute, to the infringement of at least claim 1 of the '074 patent. A claim chart comparing the claim elements of claim 1 of the '074 patent to the VAV Controller products sold by Defendant for use in the claimed method is attached as Exhibit F.

**COUNT I: INFRINGEMENT OF THE '716 PATENT**

20. The allegations of paragraphs 1-19 are realleged and incorporated herein by reference.

21. JCTC is the assignee and owner of all right, title, and interest in the '716 patent and JCTC has the legal right to enforce the patent, sue for infringement, and seek equitable relief and damages.

22. The '716 patent is valid, enforceable, and was duly issued in full compliance with Title 35 of the United States Code.

23. Defendant has indirectly infringed, and is continuing to indirectly infringe, literally or under the doctrine of equivalents, at least independent claim 1 of the '716 patent, in violation of 35 U.S.C. § 271(b).

24. Defendant knowingly, actively induced, and continues to knowingly induce third-party direct infringers—such as Defendant's customers and end users—to practice the patented invention of at least claim 1 of the '716 patent by making, using, offering for sale, and selling the infringing EC-gfx program and the Eclipse Controller products and by encouraging and facilitating infringement by creating and distributing instructional, product, and technical materials related to the infringing EC-gfx program and Eclipse Controller products that direct those third-party direct infringers to make and use the patented invention of at least claim 1. On information and belief, Defendant has knowledge that the induced acts constitute patent infringement, in violation of 35 U.S.C. § 271(b).

25. Defendant's acts of indirect infringement of the '716 patent are willful, and have been caused and will continue to cause substantial damages and irreparable harm to Plaintiff, and Plaintiff has no adequate remedy at law.

**COUNT II: INFRINGEMENT OF THE '281 PATENT**

26. The allegations of paragraphs 1-25 are realleged and incorporated herein by reference.

27. JCTC is the assignee and owner of all right, title, and interest in the '281 patent and JCTC has the legal right to enforce the patent, sue for infringement, and seek equitable relief and damages.

28. The '281 patent is valid, enforceable, and was duly issued in full compliance with Title 35 of the United States Code.

29. Defendant has directly and indirectly infringed, and is continuing to directly and indirectly infringe, literally or under the doctrine of equivalents, at least independent claim 1 of the '281 patent, in violation of 35 U.S.C. § 271(a), (b), and (c).

30. Defendant has directly infringed, and is continuing to directly infringe, literally or under the doctrine of equivalents, at least claim 1 of the '281 patent by making, using, selling, and/or offering for sale infringing Allure Thermostat products in the United States, in violation of 35 U.S.C. § 271(a).

31. Defendant knowingly, actively induced and continues to knowingly induce third-party direct infringers—such as Defendant's customers and end users—to practice the patented inventions of at least claim 1 of the '281 patent by making, using, offering for sale, and selling infringing Allure Thermostat products and by encouraging and facilitating infringement by creating and distributing instructional, product, and technical materials related to the infringing Allure Thermostat products. Defendant has knowledge that the induced acts constitute patent infringement, in violation of 35 U.S.C. § 271(b).

32. Defendant's infringing Allure Thermostat products are apparatuses especially made or adapted for infringing use, and Defendant sells and has sold infringing Allure

Thermostat products for use in the patented inventions claimed in the '281 patent. Defendant knowingly contributed to, and continues to contribute to, the infringement of the '281 patent by others in this District—such as Defendant's customers and end users—by selling or offering for sale components of infringing Allure Thermostat products in this District, wherein the infringing Allure Thermostat products constitute a material part of the patented inventions claimed in the '281 patent, and which are not staple articles or commodities of commerce suitable for a substantial noninfringing use, in violation of 35 U.S.C. § 271(c).

33. Defendant's acts of direct and indirect infringement of the '281 patent are willful, and have been caused and will continue to cause substantial damages and irreparable harm to Plaintiff, and Plaintiff has no adequate remedy at law.

### **COUNT III: INFRINGEMENT OF THE '074 PATENT**

34. The allegations of paragraphs 1-33 are realleged and incorporated herein by reference.

35. JCTC is the assignee and owner of all right, title, and interest in the '074 patent and JCTC has the legal right to enforce the patent, sue for infringement, and seek equitable relief and damages.

36. The '074 patent is valid, enforceable, and was duly issued in full compliance with Title 35 of the United States Code.

37. Defendant has directly and indirectly infringed, and is continuing to directly and indirectly infringe, literally or under the doctrine of equivalents, at least independent claim 1 of the '074 patent, in violation of 35 U.S.C. § 271(a), (b), and (c).

38. Defendant has directly infringed, and is continuing to directly infringe, literally or under the doctrine of equivalents, at least claim 1 of the '074 patent by making, using, selling,



and/or offering for sale infringing VAV controllers in the United States, in violation of 35 U.S.C. § 271(a).

39. Defendant knowingly, actively induced and continues to knowingly induce third-party direct infringers—such as Defendant’s customers and end users—to practice the patented inventions of at least claim 1 of the ’074 patent by making, using, offering for sale, and selling infringing VAV controllers and by encouraging and facilitating infringement by creating and distributing instructional, product, and technical materials related to the infringing products. Defendant has knowledge that the induced acts constitute patent infringement, in violation of 35 U.S.C. § 271(b).

40. Defendant’s infringing VAV controllers are apparatuses especially made or adapted for infringing use, and Defendant sells and have sold infringing VAV controllers for use in the patented inventions claimed in the ’074 patent. Defendant knowingly contributed to, and continues to contribute to, the infringement of the ’074 patent by others in this District—such as Defendant’s customers and end users—by selling or offering for sale components of infringing VAV controllers in this District, wherein the infringing VAV controllers constitute a material part of the patented inventions claimed in the ’074 patent, and are not staple articles or commodities of commerce suitable for a substantial noninfringing use, in violation of 35 U.S.C. § 271(c).

41. Defendant’s acts of direct and indirect infringement of the ’074 patent are willful, and have been caused and will continue to cause substantial damages and irreparable harm to Plaintiff, and Plaintiff has no adequate remedy at law.

#### **EXCEPTIONAL CASE**

42. The allegations of paragraphs 1-41 are realleged and incorporated herein by reference.

43. On information and belief, Defendant is, and/or has been, aware of the Asserted Patents and Defendant's actions render this an exceptional case under 35 U.S.C. § 285.

**REQUEST FOR RELIEF**

**WHEREFORE**, Plaintiff respectfully requests the following relief:

(A) A judgment that Defendant has infringed the '281 and '074 patents in violation of 35 U.S.C. § 271(a);

(B) A judgment that Defendant has actively induced infringement of the '716, '281, and '074 patents in violation of 35 U.S.C. § 271(b);

(C) A judgment that Defendant has contributorily infringed the '281 and '074 in violation of 35 U.S.C. § 271(c);

(D) A judgment temporarily, preliminarily, or permanently enjoining Defendant, its parents, subsidiaries, affiliates, divisions, officers, agents, servants, employees, directors, partners, representatives, all individuals and entities in active concert and/or participation with it, and all individuals and/or entities within its control from engaging in patent infringement of the '716, '281, and '074 patents;

(E) Ordering Defendant to account and pay damages adequate to compensate Plaintiff for Defendant's infringement of the '716, '281, and '074 patents, including pre-judgment and post-judgment interest and costs pursuant to 35 U.S.C. § 284;

(F) Ordering an accounting for any infringing sales not presented at trial and an award by the court of additional damages for any such infringing sales;

(G) Ordering that the damages award be increased up to three times the actual amount assessed pursuant to 35 U.S.C. § 284;

(H) Declaring this case exceptional and awarding Plaintiff its reasonable attorney fees pursuant to 35 U.S.C. § 285;

- (I) Costs and expenses in this action; and
- (J) Such other and further relief as the Court deems just and proper.

**JURY TRIAL DEMAND**

Plaintiff demands a trial by jury on all claims and issues so triable under Federal Rule of Civil Procedure 38(b).

DATED: November 17, 2020

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