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19 ATTORNEYS FOR PLAINTIFF  
20 OPTICURRENT, LLC

21 **UNITED STATES DISTRICT COURT**  
22 **NORTHERN DISTRICT OF CALIFORNIA**

23 OPTICURRENT, LLC  
24  
25 Plaintiff,  
26  
27 vs.  
28 ON SEMICONDUCTOR CORPORATION,  
29  
30 Defendant.

CASE NO. 3:21-cv-1425

**PLAINTIFF'S ORIGINAL  
COMPLAINT**

**DEMAND FOR JURY TRIAL**

1 Plaintiff OPTICURRENT, LLC files this Original Complaint against Defendant ON  
2 SEMICONDUCTOR COPRORATION alleging as follows:

3 **I. THE PARTIES**

4 1. OPTICURRENT, LLC (“Plaintiff”) is a Texas Limited Liability Company, with a  
5 principal place of business at 705B Mulberry Ave, Celebration, FL 34747.

6 2. Defendant ON SEMICONDUCTOR CORPORATION (“Defendant”) is a  
7 corporation organized and existing under the laws of the State of Delaware, with a principal  
8 place of business in Phoenix, AZ. Defendant may be served with process by serving Keith D.  
9 Jackson, CEO, 5005 East McDowell Road, Phoenix, AZ 85008 or by serving CT Corporation at  
10 3800 N. Central Avenue, Suite 460, Phoenix, AZ 85012.

11 **II. JURISDICTION AND VENUE**

12 3. This is an action for infringement of a United States patent. Federal question  
13 jurisdiction is conferred to this Court over such action under 28 U.S.C. §§ 1331 and 1338(a).

14 4. Defendant resides in this District and has had minimum contacts with the  
15 Northern District of California such that this venue is fair and reasonable. Defendant has  
16 transacted and, at the time of the filing of this Complaint, is transacting business within the  
17 Northern District of California. Defendant maintains and operates a “Design & Solution  
18 Engineering” operation in San Jose, California as well as a “Design & Solution Engineering”  
19 operation in Santa Clara, California. According to Defendant’s website, the Santa Clara  
20 operation “focuses on development of power management solutions” among other things.<sup>1</sup>  
21 Upon information and belief, the Santa Clara operation is located at 2975 Stender Way, Santa  
22 Clara, CA 95054. Defendant has registered subsidiaries within California, such as ON  
23 Semiconductor Connectivity Solutions, Inc.

24  
25  
26  
27 <sup>1</sup> <https://www.onsemi.com/about/company/global-locations>



1 and under the Doctrine or Equivalents, of Claim 1 of the '623 Patent and awarded a reasonable  
2 royalty based on three percent (3%) of sales. On June 5, 2019, the Court issued its Order Re  
3 Post-Trial Motions, upholding the jury's finding of infringement, and granting Plaintiff's Motion  
4 for Ongoing Royalty of 3.5%. Power Integrations elected to drop its validity challenge on the  
5 eve of trial, and the jury was not tasked with a finding of invalidity. Following appeal, the  
6 United States Court of Appeals for the Federal Circuit affirmed the District Court decision in its  
7 Mandate issued on October 2, 2020. *See* Appellate Case No. 2019-2141 and 2019-2172 at Dkt.  
8 No. 69.  
9

10 9. Following the jury trial, Power Integrations requested an *ex parte* reexamination  
11 of the '623 Patent. That proceeding has since concluded, with the United States Patent Office  
12 confirming the claim under reexamination (Claim 1 of the '623 Patent) as patentable, without  
13 amendment. This is the same patent claim that the jury found Power Integrations to infringe and  
14 is a part of Plaintiff's allegation of infringement by Defendant herein.  
15

16 10. On June 19, 2019, Plaintiff filed its second lawsuit against Power Integrations,  
17 Inc. That case was likewise assigned to Judge Edward Chen and is currently pending as Civil  
18 Action No. 3:19-cv-3563.

19 **IV. COUNT 1: PATENT INFRINGEMENT**

20 11. On October 25, 2005, United States Patent No. 6,958,623 ("the '623 Patent") was  
21 duly and legally issued for a "THREE TERMINAL NONINVERTING TRANSISTOR  
22 SWITCH." A true and correct copy of the '623 Patent is attached hereto as Exhibit "A" and  
23 made a part hereof.  
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1           12.     The inventor of the ‘623 Patent, Mr. James Congdon, first conceived of, and  
2 reduced to practice, the invention covered by Claim 1 of the ‘623 Patent at least as early as  
3 February 23, 1997.

4           13.     The ‘623 Patent incorporates by reference an earlier patent issued to the same  
5 inventor, namely U.S. Patent No. 5,134,323 (“the ‘323 Patent”). As described in the ‘623 Patent,  
6 the earlier ‘323 Patent design presented some undesirable drawbacks, most notably the leakage  
7 of current between the second and third terminals of the switch when the switch is in its off  
8 switching state. Col. 4, l. 62 through Col. 5, l. 10.

9           14.     The ‘623 Patent is referred to as the “Patent-in-Suit.” Generally speaking, the  
10 ‘623 Patent relates to transistor switches used in semiconductor devices, and more specifically  
11 relates to a novel circuit design that, among other things, minimizes current leakage between the  
12 second and third terminal of such a transistor switch. Claim 1 of the ‘623 Patent is directed  
13 towards a three terminal, noninverting transistor switch. As explained by the ‘623 Patent,  
14 noninverting transistor switches typically comprise at least four terminals: “one terminal being  
15 connected to an input signal, another terminal being connected to a load, another terminal being  
16 connected to ground and the last terminal being connected to a power supply in order to provide  
17 a ‘second’ inversion for the switch.” Col. 1, ll. 39-43. By contrast, the ‘623 Patent defines  
18 noninverting transistor switches which comprise only three terminals as having “a first terminal  
19 connected to an input signal, a second terminal connected to ground and a third terminal  
20 connected to a load. Noninverting transistor switches which comprise only three terminals do  
21 not require a fourth terminal connected to a power supply, thereby rendering noninverting  
22 transistor switches which comprise only three terminals more desirable than noninverting  
23 transistor switches which comprise at least four terminals.” Col. , ll. 47-55. The three terminal  
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1 noninverting transistor switch set forth in the '623 Patent refers to a switch that is capable of  
2 deriving the necessary power to operate the components in the switch directly from its own  
3 load/output terminal, e.g., from the high voltage power located at the drain of the switch, thus  
4 saving cost, weight, and/or volume by reducing the number of required components and/or pins.  
5 The '623 Patent provides further advantages over prior designs by reducing current leakage and  
6 by introducing hysteresis.

7  
8 15. By way of assignment, Plaintiff is the owner of all right, title and interest in and  
9 to the '623 Patent, with all rights to enforce it against infringers and to collect damages for all  
10 relevant times, including the right to prosecute this action.

11 16. Defendant, without authority, consent, right, or license, and in direct infringement  
12 of the '623 Patent, manufactures, has manufactured, makes, has made, uses, imports, has  
13 imported, markets, sells, or offers for sale systems or products that directly infringe one or more  
14 claims of the '623 Patent. By way of example only, Defendant's FSQ500L product family,  
15 NCP1027 product family, NCP1028 product family, NCV1060 product family, NCV1063  
16 product family, NCV1072 product family, NCV1075 product family, NCV1076 product family,  
17 NCV1077 product family, NCP1070 product family, NCP1071 product family, NCP1072  
18 product family, NCP1075 product family, NCP1075A/B product family, NCP1076 product  
19 family, NCP1076A/B product family, NCP1077 product family, NCP1077A/B product family,  
20 NCP1079A/B product family, and any other similarly structured or functioning products that  
21 include a three terminal non-inverting switch in accordance with the '623 Patent ("Accused  
22 Products"), directly infringe at least Claim 1 of the '623 Patent. Plaintiff has examined publicly  
23 available documentation to determine whether it believes these product model numbers infringe  
24 Claim 1 of the '623 Patent and specifically reserves its right to amend based on this review and  
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1 subject to further confirmation through discovery. To be clear, this Complaint identifies the  
2 above products for representative purposes only, and alleges infringement of at least Claim 1 of  
3 the '623 Patent by all other similarly structured or functioning products that include a three  
4 terminal non-inverting switch in accordance with the '623 Patent. The Accused Products  
5 include all future generations of the infringing design, as well as any successor products or later-  
6 released products that utilize a similar and/or identical infringing design.

7  
8 17. The Accused Products infringe the '623 Patent because, at a minimum, they  
9 include within their circuitry a three terminal non-inverting switch with a voltage stabilizer and a  
10 CMOS inverter, all of which are arranged in an infringing manner in accordance with Claim 1 of  
11 the '623 Patent. By providing the circuit in this configuration, the chip experiences, among other  
12 things, a lower amount of current leakage between the second and third terminal as described as  
13 a key advantage of the novel '623 Patent circuit design.

14  
15 18. In the absence of literal infringement, the Accused Products also infringe under  
16 the Doctrine of Equivalents because to the extent there are any differences between the Accused  
17 Products and the asserted claim, such differences are insubstantial.

18  
19 19. Further, Defendant induces infringement of one or more of the claims of the  
20 Patent-in-Suit by others and is therefore liable for its indirect infringement. Specifically, by way  
21 of example only, Defendant provides Accused Products to be incorporated into consumer  
22 electronic products used within the United States. For example, Defendant states in its public  
23 literature that its transistor switches may form part of a power supply system in many consumer  
24 electronic products, such as chargers/adapters for cell phones, PDAs, MP3/portable audio, and  
25 other auxiliary supplies, supplies for appliances, industrial systems, and so forth. Defendant also  
26 provides Accused Products to distributors for sale and offer for sale within the United States.

1 Defendant has had knowledge of, or was willfully blind to, the Patent-in-Suit and knowledge of,  
2 or was willfully blind, to the fact that its actions would induce infringement since at least as early  
3 as April 25, 2016.

4 20. Defendant possessed a specific intent to induce infringement by, at a minimum,  
5 providing product briefs, data sheets and/or instructions on how to incorporate the Accused  
6 Products into consumer electronic products in a way that would infringe the Patent-in-Suit.

7 21. Defendant has purposefully and voluntarily placed, or caused or encouraged to be  
8 placed, infringing products into the stream of commerce with the expectation that its products  
9 will be purchased by end users in the United States. The Accused Products include those  
10 products that are designed, manufactured, used, marketed and/or sold in the United States, as  
11 well as those products that are made abroad but are later used, imported and/or sold within the  
12 United States.

13 22. The Accused Products are sold as a single integrated circuit chip. The circuitry  
14 that provides all of the patented features is within the chip. Accordingly, the Accused Products  
15 constitute the smallest saleable unit containing the patented features. The three terminal  
16 noninverting transistor switch is the essential functionality of each of the Accused Products.

17 23. The earlier '323 Patent technology was licensed to a company called QBar Tech  
18 Inc. Although the '623 Patent offers an improvement to the '323 Patent, the technology present  
19 in the '323 Patent is comparable to the technology present in the '623 Patent. In Civil Action  
20 No. 3:17-cv-03597-EMC, the jury awarded a reasonable royalty after hearing evidence  
21 pertaining to the QBar Tech Inc. license, and that award was confirmed by Judge Chen as a 3%  
22 reasonable royalty with an ongoing royalty of 3.5%.





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- d. that Defendant’s infringement be found to be willful from the time Defendant became aware of its infringement, and that the Court award treble damages for the period of such willful infringement pursuant to 35 U.S.C. § 284;
- e. that Plaintiff be granted pre-judgment and post-judgment interest on the damages caused by Defendant’s infringing activities;
- f. that the Court declare this an exceptional case and award Plaintiff its reasonable attorney’s fees and costs in accordance with 35 U.S.C. § 285; and
- g. such other and further relief as the Court may deem just and proper under the circumstances.

Date: February 26, 2021.

Respectfully submitted,  
  
/s/ Lewis Hudnell, III  
  
Lewis Hudnell, III  
Hudnell Law Group, P.C.  
  
Of Counsel:  
  
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