

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

DEAL GENIUS, LLC, a Delaware Limited Liability Company,	)	
Plaintiff,	)	Civil Action No.: 1:21-cv-2046
v.	)	Judge: Honorable Joan B. Gottschall
O2COOL, LLC, a Delaware Limited Liability Company,	)	Magistrate: Honorable Jeffrey Cole
Defendant,	)	<b>Jury Trial Demanded</b>
O2COOL, LLC, a Delaware Limited Liability Company,	)	
Counter-Plaintiff,	)	
v.	)	
DEAL GENIUS, LLC, a Delaware Limited Liability Company,	)	
Counter-Defendant.	)	

**FIRST AMENDED COMPLAINT FOR DECLARATORY JUDGMENT**

Plaintiff, Deal Genius, LLC (“Deal Genius”), by its undersigned attorneys, for its Complaint against Defendant O2Cool, LLC (“O2Cool”), states as follows:

**THE PARTIES**

1. Deal Genius is a Delaware limited liability company having its principal place of business at 2828 North Pulaski Road, Unit C, Chicago, Illinois.
2. On information and belief, O2Cool is a Delaware limited liability company with its principal place of business at 300 South Riverside Plaza, Chicago, Illinois 60606.

## **JURISDICTION AND VENUE**

3. This Court has subject matter jurisdiction under 28 U.S.C. §§ 2201, 2202, 1331 and 1338(a), because this action arises under the laws of the United States, and particularly the Patent Act of the United States, 35 U.S.C. § 100 *et seq.*, and seeks relief under the Federal Declaratory Judgment Act.

4. On information and belief, personal jurisdiction over O2Cool is proper because O2Cool has a principal place of business in this District, and it regularly conducts and solicits business within this District. Further, this Court has personal jurisdiction over O2Cool because O2Cool directed patent infringement allegations to Deal Genius, which has its principal place of business in this District. Those allegations by O2Cool form the basis of this complaint.

5. Venue is proper in this District under 28 U.S.C. §§ 1391 because O2Cool is subject to personal jurisdiction in this District.

## **BACKGROUND**

6. Deal Genius is an online retailer, selling a variety of products including home goods, kitchenware, apparel, health and beauty products, fitness products, outdoor products and pet supplies.

7. Deal Genius sells items through its own website, [www.dealgenius.com](http://www.dealgenius.com), and through other retail websites such as [Amazon.com](http://Amazon.com) and [Walmart.com](http://Walmart.com) (“Third-Party Retailers”).

8. On March 22, 2021, Deal Genius received a notice from Amazon stating that O2Cool had filed a report with Amazon alleging that Deal Genius’s Simply Genius Personal Necklace Fan (“Deal Genius Fan”) infringes O2Cool’s U.S. Patent No. 7,828,524 (the “524 Patent”). Amazon also indicated that failure to resolve this matter promptly “may result in removal of your offers or your Amazon.com selling privileges.”

9. The next day, March 23, 2021, Deal Genius received a similar notice from Walmart indicating that O2Cool alleged the Deal Genius Fan infringed O2Cool's patent.

10. Because of their large customer base, the ability to sell through these Third-Party Retailers is critical to Deal Genius's business.

### **THE '524 PATENT**

11. The '524 Patent, attached hereto as Exhibit A, is entitled Necklace Style Portable Cooling Device. O2Cool purports to be the owner, by assignment, of all rights to the '524 Patent. Claim 1, which is reproduced below, is the only independent claim in the '524 Patent:

A cooling device adapted to be worn on the body of the user comprising,  
an enclosure having a plurality of continuous surfaces and including a front half portion, a rear half portion, and further defining a top and a bottom,  
a power source contained within said enclosure,  
fan means carried within said enclosure for creating an air stream,  
a motor interconnected with said fan means and by a motor shaft and connected to said power source for operating said fan means,  
actuation means for actuating said motor,  
an air inlet formed in said enclosure,  
an air discharge opening formed in said top of said enclosure and associated with said fan means for discharging the air stream created by said fan means,  
a duct associated with said air discharge opening, said duct commencing at a rearward end of the air discharge opening; and terminating at a forward end of

said air discharge opening, said duct further creating a cavity between said rearward end and said forward end adjacent to said air discharge opening,

said fan means comprising a centrifugal flow impeller having a plurality of blades,

said duct surrounding a first portion of the circumference of said centrifugal flow impeller and said plurality of blades,

said cavity surrounding a second portion of the circumference of said centrifugal flow impeller and said plurality of blades,

means for securing said cooling device onto the body of the user and positioning said cooling device in relation to the body of the user, said user defining a vertical plane, said top and bottom of said cooling device aligned in a resting plane and situated at an acute angle to the vertical plane of the user, and

whereby said cooling device is constructed to receive air from the air inlet, said duct and said plurality of blades of said centrifugal flow impeller redirecting said air perpendicularly from said air inlet into said cavity in the direction of the resting plane, said duct further redirecting said air from the resting plane into the vertical plane for discharge of the air through the discharge opening to effectively cool the user.

12. The application that resulted in the '524 patent, U.S. Patent Application No. 11/588,943 ("943 Application"), was filed on October 30, 2006.

13. On December 2, 2009, the Examiner at the United States Patent and Trademark Office rejected all 15 claims of the '943 Application. The Examiner rejected claim 1 as being

anticipated by U.S. Patent No. 2,826,758, and as being unpatentable over U.S. Patent No. 6,666,647 in view of U.S. Patent No. 5,749,359.

14. In response to the Examiner's December 2, 2009 rejection, the applicant made several amendments to the '943 Application. One such amendment was the addition of the following limitation to claim 1: "means for positioning said cooling device in relation to the body of the user, said user defining a vertical plane, said top and bottom of said cooling device aligned in a resting plane and situated at an acute angle to the vertical plane of the user" (the "Means for Positioning Element").

15. This type of claim element is commonly referred to as a "means-plus-function" claim element. Pursuant to 35 U.S.C. § 112, "An element in a claim for a combination may be expressed as a means or step for performing a specified function without the recital of structure, material, or acts in support thereof, and such claim shall be construed to cover the corresponding structure, material, or acts described in the specification and equivalents thereof."

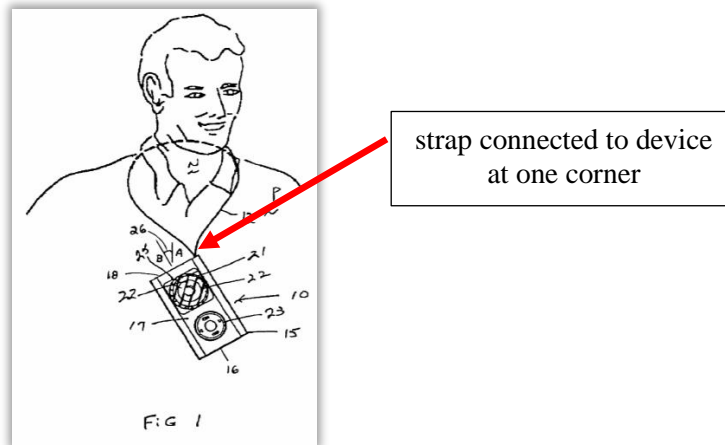
16. Therefore, in adding a means-plus-function element to claim 1, the applicant also had to ensure that the specification described the structure corresponding to this function. Accordingly, through the same amendment, the applicant also amended the specification of the application as follows:

It will also be observed from a view of figure 1 of the drawings once again, that the strap 12 is connected to the device at one corner of the enclosure 15 which causes the device 10 to hang at an angle. In this manner, the top 18 and bottom 16 of the cooling device are aligned in the resting plan B which is situated at an acute angle 26 to the vertical plane B of the user.

(Emphasis original, representing the language added by the applicant to the specification through the amendment).

17. Thus, as the amendment states, the structure disclosed in the specification for performing the claimed function of positioning the device at an acute angle to the vertical plane is a strap connected to the device at one corner.

18. This structure, which is the only structure disclosed in the specification for performing the Means for Positioning Element, is depicted in Figure 1 of the '943 Application, and in the resulting '524 Patent, as shown below:



19. On June 29, 2010, the Examiner again rejected all pending claims in the '943 Application. In this rejection, the Examiner noted that in addition to the “Means for Positioning Element,” a separate limitation of claim 1 required a “means for securing said cooling device onto the body of the user” (the “Means for Securing Element”). As separate means-plus-function limitations, the Means for Positioning Element and Means for Securing Element required unique corresponding structures. Yet both limitations relied on the strap to perform the stated functions. Therefore, the Examiner rejected claim 1 for failing to meet the requirements of 35 U.S.C. § 112.

20. In response, the applicant again amended the claims, combining these two limitations into a single limitation covering a means for both securing and positioning the device.

21. On August 19, 2010, the Examiner issued a Notice of Allowance. In his Reasons for Allowance, the Examiner explained that the invention claimed is an improvement comprising “a means for both securing the device on the body of a user as well as positioning the device in relation to the body such that the device is situated at an acute angle to the vertical plane of the user. The particular, disclosed securing/positioning means being in the form of a lanyard/strap attached to the corner of the enclosure.”

### **THE DEAL GENIUS FAN**

22. The Deal Genius Fan is a wearable fan that can hang around the neck of a user. It is a seasonal product, which is generally expected to sell at higher volumes during warmer months of the year.

23. The Deal Genius Fan is depicted in the image below:



24. The Deal Genius Fan does not infringe the '524 Patent as it does not have a strap connected to the device at one corner.

**CORRESPONDENCE BETWEEN THE PARTIES**

25. On March 24 and April 5, 2021, Deal Genius’s counsel sent letters to O2Cool’s counsel setting forth the above analysis, and demanding that O2Cool withdraw the allegations made to Amazon and Walmart concerning the Deal Genius Fan. O2Cool’s counsel refused, thereby necessitating the filing of this suit.

**COUNT I – DECLARATORY JUDGMENT OF  
NONINFRINGEMENT OF THE ’524 PATENT**

26. Deal Genius adopts and incorporates paragraphs 1 through 25 above by reference and for this paragraph 26 of Count I.

27. As a result of the acts set forth in the preceding paragraphs, an actual and justiciable controversy exists between Deal Genius and O2Cool as to Deal Genius’s non-infringement of the ’524 Patent.

28. A judicial declaration is necessary and appropriate so that Deal Genius may definitively establish its rights with respect to the sale of the Deal Genius Fan in view of the ’524 Patent.

29. Such a determination is further necessary to bar O2Cool from continuing to misuse the ’524 Patent through assertions of infringement by Deal Genius to Third-Party Retailers.

30. The Deal Genius Fan does not infringe any claims of the ’524 Patent directly or indirectly, literally or under the doctrine of equivalents for at least the reason that it does not include a strap connected to one corner of the device, nor an equivalent thereof.

31. On information and belief, O2Cool knew or should have known that the Deal Genius Fan does not infringe the ’524 Patent.



32. O2Cool intentionally approached Third-Party Retailers just prior to the warmer months when the Deal Genius Fan is expected to reach higher sales volumes, and alleged that the Deal Genius Fan infringes the '524 even though it does not infringe.

33. O2Cool's conduct was egregious as exemplified by its attempt to improperly expand the scope of claim 1 of the '524 Patent to cover a product that does not include a strap connected to one corner of the device, nor an equivalent thereof.

34. O2Cool's conduct makes this case an exceptional case, entitling Deal Genius to an award of its fees and costs.

35. Pursuant to the Federal Declaratory Judgment Act, 28 U.S.C. § 2201, *et seq.*, Deal Genius seeks a declaration that it does not infringe any claim of the '524 Patent.

**COUNT II – DECLARATORY JUDGMENT OF INVALIDITY OF THE '524 PATENT**

36. Deal Genius adopts and incorporates paragraphs 1 through 35 above by reference and for this paragraph 36 of Count II.

37. As a result of the acts set forth in the preceding paragraphs, an actual and justiciable controversy exists between Deal Genius and O2Cool as to the validity of the '524 Patent.

38. All claims of the '524 Patent are invalid under 35 U.S.C. § 112 at least because the following claim limitation is indefinite: “whereby said cooling device is constructed to receive air from the air inlet, said duct and said plurality of blades of said centrifugal flow impeller redirecting said air perpendicularly from said air inlet into said cavity in the direction of the resting plane, said duct further redirecting said air from the resting plane into the vertical plane for discharge of the air through the discharge opening to effectively cool the user.”

39. For example, the term “effectively cool the user” is indefinite because it is a purely subjective term. The user is not defined, and whether a user would be effectively cooled or whether the device would effectively cool the user is a matter of opinion.

40. Pursuant to the Federal Declaratory Judgment Act, 28 U.S.C. § 2201, *et seq.*, Deal Genius seeks a declaration that the ’524 Patent is invalid.

### **JURY DEMAND**

41. Deal Genius demands a jury trial on all issues so triable.

### **PRAYER FOR RELIEF**

**WHEREFORE**, Plaintiff Deal Genius, LLC respectfully prays for a declaratory judgment against O2Cool as follows:

- A. A declaration that Deal Genius does not infringe any claim of the ’524 Patent;
- B. A declaration that all claims of the ’524 are invalid;
- C. An order declaring that Deal Genius is a prevailing party and that this is an exceptional case, awarding Deal Genius its costs, expenses and reasonable attorneys’ fees pursuant to 35 U.S.C. § 285.
- D. Such other and further relief as this Court deems just and reasonable.

Dated: June 3, 2021

Respectfully submitted,

By: /s/ Ron N. Sklar

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**CERTIFICATE OF SERVICE**

The undersigned attorney hereby certifies that all counsel of record who are deemed to have consented to electronic service are being served with a copy of this document via the Court's CM/ECF system on June 3, 2021.

/s/ Ron N. Sklar  
Attorney for Deal Genius, LLC