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5 Attorney for Plaintiff
MGI DIGITAL TECHNOLOGY S.A.

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8 **UNITED STATE DISTRICT COURT**
9 **FOR THE CENTRAL DISTRICT OF CALIFORNIA**

10 MGI DIGITAL TECHNOLOGY S.A.,

Case No. 8:22-cv-00979

11 Plaintiff(s)

COMPLAINT

12 v.

JURY TRIAL DEMANDED

13 DUPLO U.S.A. CORPORATION,

14 Defendant(s).

15
16 Plaintiff MGI Digital Technology S.A. (“MGI”), by and through its attorneys,
17 for its Complaint against defendant Duplo U.S.A. Corporation. (“**Defendant**” or
18 “Duplo”), alleges as follows:

19 1. This is an action for patent infringement arising under the patent laws
20 of the United States, Title 35, United States Code.

21 **PARTIES**

22 2. MGI is a company organized and existing under the laws of France and
23 having its principal place of business in Fresnes, France.

24 3. MGI is a manufacturer of digital printing and finishing presses with
25 over 40 years of innovation experience in the graphics industry. MGI distributes its
26 digital printing and finishing presses throughout the world either directly or through
27 one or more subsidiaries, including within the United States.

28 4. Defendant Duplo is a corporation that is incorporated in California with
a principal place of business in 3050 South Daimler Street Santa Ana, CA 92705.

5. Defendant is the US, Canadian and Latin American, distributor of various graphical arts printing and finishing products for its Japanese parent company. Among these products are various print embellishment machines used to produce printed materials that have textured and tactile enhancements applied through spot coating and curing of ultraviolet curable ink.

JURISDICTION

6. This court has original jurisdiction over the subject matter of this action pursuant to 28 U.S.C. §§ 1331 and 1338(a).

7. Personal jurisdiction over Defendant is proper in this District because Defendant is a California corporation with its principal place of business in this judicial district and it has availed itself of the rights and benefits of the laws of California. Defendant Duplo is subject to general and specific personal jurisdiction in this judicial district.

VENUE

8. Venue is proper in this district under 28 U.S.C. §§ 1391(b) and 1400(b).

FACTS

The Asserted Patents

9. U.S. Patent No. 8,506,031 (“**the ’031 Patent**”) entitled “Ink Jet Printer And Method For Depositing A Protective Layer On A Substrate” was duly and legally issued on August 13, 2013. Attached as Exhibit 1 is a true and correct copy of the ’031 Patent, which is incorporated herein by reference.

10. U.S. Patent No. 8,783,806 (“**the ’806 Patent**”) entitled “Ink Jet Printer And Method For Depositing A Protective Layer On A Substrate” was duly and legally issued on July 22, 2014. Attached as Exhibit 2 is a true and correct copy of the ’806 Patent, which is incorporated herein by reference.

11. U.S. Patent No. RE45,067 (“**the ’067 Patent**”) entitled “Numerical Jet Machine For The Application Of A Coating Onto A Substrate” was duly and legally

1 issued on August 12, 2014. Attached as Exhibit 3 is a true and correct copy of the
2 '067 Patent, which is incorporated herein by reference.

3 12. U.S. Patent No. 9,422,449 ("**the '449 Patent**") entitled "Varnish
4 Composition Transferrable by Inkjet Suitable for Sublimable or Thermal Transfer
5 Ink" was duly and legally issued on August 23, 2016. Attached as Exhibit 4 is a true
6 and correct copy of the '449 Patent, which is incorporated herein by reference.

7 13. MGI is the assignee of the entire right, title, and interest in the '031
8 Patent, the '806 Patent, the '449 Patent, and the '067 Patent (collectively the
9 "**Asserted Patents**").

10 **Defendant's Infringing Activities and Products**

11 14. Defendant has and continues to directly infringe the Asserted Patents
12 by selling and offering for sale the DDC-810 Digital Spot UV Coater ("**the DDC-**
13 **810**") and the DDC-8000 Digital Spot UV Coater ("**the DDC-8000**") and UV
14 curable varnish ink for use therewith in the United States and importing into the
15 United States the DDC-810 and the DDC-8000 and UV curable varnish ink for use
16 therewith that embody or use the inventions claimed in the Asserted Patents.

17 15. The DDC-810 is an apparatus as covered by at least claims 9–17 and
18 27–36 of the '806 Patent, claims 12–25 of the '031 Patent, and claims 1–34 of the
19 '067 Patent that deposits Ultra Violet ("UV") curable varnish ink onto a substrate in
20 various sized and shaped droplets at the direction of a computer controller based on
21 a thickness of the supplied UV curable varnish ink. The DDC-810 further deposits
22 the UV curable varnish ink in a manner consistent with at least claims 1–8 and 18–
23 26 of the '806 Patent and claims 1–11 of the '031 Patent.

24 16. Furthermore, as covered by claims 9–17 and 27–36 of the '806 Patent,
25 the DDC–810 includes a nozzle arrangement with a heater that heats the UV curable
26 varnish ink, a reservoir that can hold a product having a viscosity between 100 and
27 1000 centipoises, a device that grasps and transfers the substrate onto which the UV
28 curable varnish ink is deposited, and nozzles arranged in a ramp configuration.

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1 17. Further still, a reasonable opportunity for further investigation and
2 discovery is likely to provide evidentiary support that the DDC-810 is designed to
3 be used with various types of UV curable varnish ink including those covered by at
4 least claim 1 of the '449 Patent that (1) include a hardenable oligomer that
5 comprises epoxy resin, alone or in combination with another oligomer selected from
6 among polyesters and/or hexafunctional aliphatic urethane acrylates and/or (2) have
7 a weight ratio between a total of hardenable oligomer and a total of hardenable
8 monomer that is higher than 1:6 and lower than 1:2 while the hardenable oligomer
9 has a viscosity greater than 1 Pa·s at 23° C.

10 18. Moreover, a reasonable opportunity for further investigation and
11 discovery is likely to provide evidentiary support that the DDC-8000 operates in the
12 same manner as the DDC-810 except in that the DDC-8000 is a larger format
13 machine capable of printing on larger format substrates than the DDC-810.

14 19. On or about March 17, 2017, MGI gave Defendant Duplo notice of the
15 Asserted Patents, and Defendant Duplo has known of those Asserted Patents and its
16 infringement thereof since at least that date.

17 20. MGI instituted a patent infringement lawsuit in France against Duplo in
18 2017, claiming that the DDC-810 infringed MGI European patents that claim
19 priority to the same original filings as various Asserted Patents in this case. The
20 French trial courts found that the DDC-810 infringed various of MGI's European
21 patents that include claims similar to the claims of various Asserted Patents. *See*
22 *Digital Technology S.A. v. Duplo France S.A.R.L.*, Tribunal Judiciaire [TJ] [court of
23 original jurisdiction] Paris, Section 3, Chambre 3, Mar. 12, 2021, RG17/09735
24 Portalis No. 352J-W-B7B-CK4SQ.

25 21. Defendant's acts of infringement have been willful and in disregard for
26 the Asserted Patents, without any reasonable basis for believing that it had a right to
27 engage in the infringing conduct.

28 22. Defendant has been and is inducing infringement of the '031 Patent and

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1 the '806 Patent by actively and knowingly inducing others to make, use, sell, offer
2 for sale, or import the DDC-810 and the DDC-8000 that embody or use the
3 inventions claimed in the '031 Patent and the '806 Patent. Specifically, Defendant's
4 advertisement and promotion of its DDC-810 and the DDC-8000 products,
5 including its demonstration of such products at trade shows and other instructions to
6 users in the operation of its product, have specifically encouraged, aided, and
7 abetted infringement of the Asserted Patents.

8 23. Defendant has been and is continuing to contributorily infringe the '031
9 Patent and the '806 Patent by selling or offering to sell the DDC-810 and the
10 DDC-8000, knowing them to be especially made or especially adapted for practicing
11 the invention of the '031 Patent and the '806 Patent and not a staple article or
12 commodity of commerce suitable for substantial non-infringing use. Specifically,
13 normal use of Defendant's DDC-810 and the DDC-8000 products necessarily and
14 inherently infringe the '031 Patent and the '806 Patent, and the products have no
15 substantial non-infringing use.

16 24. Defendant's acts of infringement have been and are causing injury and
17 both damages, and irreparable harm to MGI, and will continue unless enjoined.

18 **COUNT ONE (Direct Infringement of the '806 Patent)**

19 25. MGI repeats and realleges paragraphs 1 through 24 hereof, as if fully
20 set forth herein.

21 26. Defendant has been and is infringing one or more claims of the '806
22 Patent, including at least claims 9–17 and 27–36 by making, using, selling, or
23 offering for sale in the United States, or importing into the United States, including
24 within this judicial district, UV spot coating printers, including those sold under the
25 names DDC-810 and DDC-8000, in violation of 35 U.S.C. § 271(a).

26 27. Defendant has been and is infringing the '806 Patent by making, using,
27 selling, or offering for sale in the United States, or importing into the United States,
28 including within this judicial district, Digital Spot UV Coater products, including

1 those sold under the names DDC-810 and DDC-8000.

2 28. Defendant's direct infringement has been, and continues to be knowing,
3 intentional, and willful.

4 29. Defendant's acts of direct infringement of the '806 Patent have caused
5 and will continue to cause MGI damages for which MGI is entitled to compensation
6 pursuant to 35 U.S.C. § 284.

7 30. Defendant's acts of direct infringement of the '806 Patent have caused
8 and will continue to cause MGI immediate and irreparable harm unless such
9 infringing activities are enjoined by this Court pursuant to 35 U.S.C. § 283. MGI has
10 no adequate remedy at law.

11 31. This case is exceptional and, therefore, MGI is entitled to an award of
12 attorney fees pursuant to 35 U.S.C. § 285.

13 **COUNT TWO (Inducing Infringement of the '806 Patent)**

14 32. MGI repeats and realleges paragraphs 1 through 31 hereof, as if fully
15 set forth herein.

16 33. Defendant has been and is inducing infringement of one or more claims
17 of the '806 Patent, including at least claims 1–8 and 18–26 by actively and
18 knowingly inducing others to make, use, sell, offer for sale, or import UV spot
19 coating printers that embody or use the invention claimed in the '031 Patent,
20 including those sold under the names DDC-810 and DDC-8000, in violation of 35
21 U.S.C. § 271(b).

22 34. Defendant has been and is inducing the infringement of the '806 Patent
23 by making, using, selling, or offering for sale in the United States, or importing into
24 the United States, including within this judicial district, Digital Spot UV Coater
25 products, including those sold under the names DDC-810 and DDC-8000.

26 35. Defendant's inducing infringement has been, and continues to be
27 knowing, intentional, and willful.

28 36. Defendant's acts of inducing infringement of the '806 Patent have

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1 caused and will continue to cause MGI damages for which MGI is entitled to
2 compensation pursuant to 35 U.S.C. § 284.

3 37. Defendant's acts of inducing infringement of the '806 Patent have
4 caused and will continue to cause MGI immediate and irreparable harm unless such
5 infringing activities are enjoined by this Court pursuant to 35 U.S.C. § 283. MGI has
6 no adequate remedy at law.

7 38. This case is exceptional and, therefore, MGI is entitled to an award of
8 attorney fees pursuant to 35 U.S.C. § 285.

9 **COUNT THREE (Contributing to Infringement of the '806 Patent)**

10 39. MGI repeats and realleges paragraphs 1 through 38 hereof, as if fully
11 set forth herein.

12 40. Defendant has been and is contributing to the infringement of one or
13 more claims of the '806 Patent, including at least claims 1–8 and 18–26 by selling or
14 offering to sell the DDC-810 and DDC-8000 UV spot coating printers, knowing
15 them to be especially made or especially adapted for practicing the invention of the
16 '806 Patent and not a staple article or commodity of commerce suitable for
17 substantial non-infringing use, in violation of 35 U.S.C. § 271(c).

18 41. Defendant has been and is contributing to the infringement of the '806
19 Patent by making, using, selling, or offering for sale in the United States, or
20 importing into the United States, including within this judicial district, Digital Spot
21 UV Coater products, including those sold under the names DDC-810 and
22 DDC-8000 UV.

23 42. Defendant's contributory infringement has been, and continues to be
24 knowing, intentional, and willful.

25 43. Defendant's acts of contributory infringement of the '806 Patent have
26 caused and will continue to cause MGI damages for which MGI is entitled to
27 compensation pursuant to 35 U.S.C. § 284.

28 44. Defendant's acts of contributory infringement of the '806 Patent have

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1 caused and will continue to cause MGI immediate and irreparable harm unless such
 2 infringing activities are enjoined by this Court pursuant to 35 U.S.C. § 283. MGI has
 3 no adequate remedy at law.

4 45. This case is exceptional and, therefore, MGI is entitled to an award of
 5 attorney fees pursuant to 35 U.S.C. § 285.

6 **COUNT FOUR (Direct Infringement of the '449 Patent)**

7 46. MGI repeats and realleges paragraphs 1 through 45 hereof, as if fully
 8 set forth herein.

9 47. A reasonable opportunity for further investigation and discovery is
 10 likely to provide evidentiary support that Defendant has been and is infringing one
 11 or more claims of the '449 Patent, including at least claim 1 by making, using,
 12 selling, or offering for sale in the United States, or importing into the United States,
 13 including within this judicial district, UV curable varnish ink for use in spot coating
 14 printers, including those sold under the names DDC-810 and DDC-8000, in
 15 violation of 35 U.S.C. § 271(a).

16 48. A reasonable opportunity for further investigation and discovery is
 17 likely to provide evidentiary support that Defendant has been and is infringing the
 18 '449 Patent by making, using, selling, or offering for sale in the United States, or
 19 importing into the United States, including within this judicial district, UV curable
 20 varnish ink for use in spot coating printers, including those sold under the names
 21 DDC-810 and DDC-8000.

22 49. Defendant's direct infringement has been, and continues to be knowing,
 23 intentional, and willful.

24 50. Defendant's acts of direct infringement of the '449 Patent have caused
 25 and will continue to cause MGI damages for which MGI is entitled to compensation
 26 pursuant to 35 U.S.C. § 284.

27 51. Defendant's acts of infringement of the '449 Patent have caused and
 28 will continue to cause MGI immediate and irreparable harm unless such infringing

1 activities are enjoined by this Court pursuant to 35 U.S.C. § 283. MGI has no
2 adequate remedy at law.

3 52. This case is exceptional and, therefore, MGI is entitled to an award of
4 attorney fees pursuant to 35 U.S.C. § 285.

5 **COUNT FIVE (Direct Infringement of the '067 Patent)**

6 53. MGI repeats and realleges paragraphs 1 through 52 hereof, as if fully
7 set forth herein.

8 54. Defendant has been and is infringing the '067 Patent by making, using,
9 selling, or offering for sale in the United States, or importing into the United States,
10 including within this judicial district, UV spot coating printers, including those sold
11 under the names DDC-810 and DDC-8000, in violation of 35 U.S.C. § 271(a).

12 55. Defendant has been and is infringing one or more claims of the '067
13 Patent, including at least claims 1–15, 16–31, and 32–34 by making, using, selling,
14 or offering for sale in the United States, or importing into the United States,
15 including within this judicial district, Digital Spot UV Coater products, including
16 those sold under the names DDC-810 and DDC-8000.

17 56. Defendant's infringement has been, and continues to be knowing,
18 intentional, and willful.

19 57. Defendant's acts of infringement of the '067 Patent have caused and
20 will continue to cause MGI damages for which MGI is entitled to compensation
21 pursuant to 35 U.S.C. § 284.

22 58. Defendant's acts of infringement of the '067 Patent have caused and
23 will continue to cause MGI immediate and irreparable harm unless such infringing
24 activities are enjoined by this Court pursuant to 35 U.S.C. § 283. MGI has no
25 adequate remedy at law.

26 59. This case is exceptional and, therefore, MGI is entitled to an award of
27 attorney fees pursuant to 35 U.S.C. § 285.
28

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COUNT SIX (Direct Infringement of the '031 Patent)

60. MGI repeats and realleges paragraphs 1 through 59, as if fully set forth herein.

61. Defendant has been and is infringing one or more claims of the '031 Patent, including at least claims 12–25 by making, using, selling, or offering for sale in the United States, or importing into the United States, including within this judicial district, UV spot coating printers, including those sold under the names DDC-810 and DDC-8000, in violation of 35 U.S.C. § 271(a).

62. Defendant has been and is infringing the '031 Patent by making, using, selling, or offering for sale in the United States, or importing into the United States, including within this judicial district, Digital Spot UV Coater products, including those sold under the names DDC-810 and DDC-8000.

63. Defendant's direct infringement has been, and continues to be knowing, intentional, and willful.

64. Defendant's acts of direct infringement of the '031 Patent have caused and will continue to cause MGI damages for which MGI is entitled to compensation pursuant to 35 U.S.C. § 284.

65. Defendant's acts of direct infringement of the '031 Patent have caused and will continue to cause MGI immediate and irreparable harm unless such infringing activities are enjoined by this Court pursuant to 35 U.S.C. § 283. MGI has no adequate remedy at law.

66. This case is exceptional and, therefore, MGI is entitled to an award of attorney fees pursuant to 35 U.S.C. § 285.

COUNT SEVEN (Inducing Infringement of the '031 Patent)

67. MGI repeats and realleges paragraphs 1 through 66 hereof, as if fully set forth herein.

68. Defendant has been and is inducing infringement of one or more claims of the '031 Patent, including at least claims 1–11 by actively and knowingly

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1 inducing others to make, use, sell, offer for sale, or import UV spot coating printers
2 that embody or use the invention claimed in the '031 Patent, including those sold
3 under the names DDC-810 and DDC-8000, in violation of 35 U.S.C. § 271(b).

4 69. Defendant has been and is inducing the infringement of the '031 Patent
5 by making, using, selling, or offering for sale in the United States, or importing into
6 the United States, including within this judicial district, Digital Spot UV Coater
7 products, including those sold under the names DDC-810 and DDC-8000.

8 70. Defendant's inducing infringement has been, and continues to be
9 knowing, intentional, and willful.

10 71. Defendant's acts of inducing infringement of the '031 Patent have
11 caused and will continue to cause MGI damages for which MGI is entitled to
12 compensation pursuant to 35 U.S.C. § 284.

13 72. Defendant's acts of inducing infringement of the '031 Patent have
14 caused and will continue to cause MGI immediate and irreparable harm unless such
15 infringing activities are enjoined by this Court pursuant to 35 U.S.C. § 283. MGI has
16 no adequate remedy at law.

17 73. This case is exceptional and, therefore, MGI is entitled to an award of
18 attorney fees pursuant to 35 U.S.C. § 285.

19 **COUNT EIGHT (Contributing to Infringement of the '031 Patent)**

20 74. MGI repeats and realleges paragraphs 1 through 73 hereof, as if fully
21 set forth herein.

22 75. Defendant has been and is contributing to the infringement of one or
23 more claims of the '031 Patent, including at least claims 1–11 by selling or offering
24 to sell the DDC-810 and DDC-8000 UV spot coating printers, knowing them to be
25 especially made or especially adapted for practicing the invention of the '031 Patent
26 and not a staple article or commodity of commerce suitable for substantial non-
27 infringing use, in violation of 35 U.S.C. § 271(c).

28 76. Defendant has been and is contributing to the infringement of the '031

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Patent by making, using, selling, or offering for sale in the United States, or importing into the United States, including within this judicial district, Digital Spot UV Coater products, including those sold under the names DDC-810 and DDC-8000.

77. Defendant's contributory infringement has been, and continues to be knowing, intentional, and willful.

78. Defendant's acts of contributory infringement of the '031 Patent have caused and will continue to cause MGI damages for which MGI is entitled to compensation pursuant to 35 U.S.C. § 284.

79. Defendant's acts of contributory infringement of the '031 Patent have caused and will continue to cause MGI immediate and irreparable harm unless such infringing activities are enjoined by this Court pursuant to 35 U.S.C. § 283. MGI has no adequate remedy at law.

80. This case is exceptional and, therefore, MGI is entitled to an award of attorney fees pursuant to 35 U.S.C. § 285.

WHEREFORE, MGI requests judgment against Defendant as follows:

1. Adjudging that Defendant has infringed, actively induced infringement of, and contributorily infringed the Asserted Patents, in violation of 35 U.S.C. § 271(a), (b), and (c);

2. Granting an injunction permanently enjoining Defendant, its employees, agents, officers, directors, attorneys, successors, affiliates, subsidiaries, and assigns, and all of those in active concert and participation with any of the foregoing persons or entities from infringing, contributing to the infringement of, or inducing infringement of the Asserted Patents;

3. Ordering Defendant to account and pay damages adequate to compensate MGI for Defendant's infringement of the Asserted Patents, including for any infringing acts not presented at trial and pre-judgment and post-judgment interest and costs, pursuant to 35 U.S.C. § 284;

1 4. Ordering an accounting for any infringing sales not presented at trial and
2 an award by the court of additional damages for any such infringing sales.

3 5. Ordering that the damages award be increased up to three times the actual
4 amount assessed, pursuant to 35 U.S.C. § 284;

5 6. Declaring this case exceptional and awarding MGI its reasonable attorney
6 fees, pursuant to 35 U.S.C. § 285; and

7 7. Awarding such other and further relief as this Court deems just and proper.

8 **JURY DEMAND**

9 MGI demands trial by jury on all claims, defenses, and issues so triable.
10

11 Respectfully submitted,

12 Dated: May 12, 2022

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15

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