

UNITED STATES DISTRICT COURT
EASTERN DISTRICT OF TEXAS
SHERMAN DIVISION

SUREFIRE, LLC,

Plaintiff,

v.

PENTAGON SCIENTIFIC CORP. d/b/a
PENTAGONLIGHT

Defendant.

CIVIL ACTION NO. 4:08cv146

JURY TRIAL DEMANDED

FIRST AMENDED COMPLAINT FOR PATENT INFRINGEMENT
AND FALSE ADVERTISING

Plaintiff SUREFIRE, LLC (“SureFire” or “Plaintiff”), hereby complains and alleges against Defendant PENTAGON SCIENTIFIC CORP. d/b/a PENTAGONLIGHT (“PentagonLight” or “Defendant”) as follows:

1. Plaintiff SureFire is a limited liability company organized and existing under the laws of the State of California, having a principal place of business in Fountain Valley, California.
2. Defendant PentagonLight is a corporation organized and existing under the laws of the State of California, having its principal place of business in South San Francisco, California.

JURISDICTION AND VENUE

3. This is a civil action for patent infringement arising under the patent laws of the United States of America, 35 U.S.C. § 1, *et seq.*, and false advertising under the federal Lanham Act 15 U.S.C. § 1051, *et. al.*

4. This Court has jurisdiction over the subject matter of the Complaint pursuant to 28 U.S.C. §§1331 & 1338.

5. This Court has personal jurisdiction over Defendant because, on information and belief, Defendant purposefully ships its infringing flashlights and flashlight components through established distribution channels into the State of Texas and the Eastern District of Texas, and Defendant's false advertisements are circulated in the State of Texas and the Eastern District of Texas. In addition, Defendant has sold its infringing flashlights and flashlight components through established retail channels in the State of Texas and the Eastern District of Texas, and is otherwise engaged in substantial and regular business in the State of Texas and the Eastern District of Texas.

6. Venue is proper under 28 U.S.C. §§1391(b) and (c) and 1400(b) because Defendant sells infringing products in the Eastern District of Texas and because Defendant is subject to personal jurisdiction in the Eastern District of Texas.

GENERAL ALLEGATIONS

7. SureFire has been engaged in the business of manufacturing and distributing flashlights and related products for more than twenty (20) years.

8. SureFire employs more than 500 people at its facilities in and around Fountain Valley, California, where it manufactures key components and assembles its products.

9. On April 24, 2001, United States Patent No. 6,222,138 (the '138 patent), on an invention entitled "Battery Operated Appliance, Flashlight and Switching Systems Technical Field" was duly and legally issued by the United States Patent and Trademark Office.

10. On March 4, 2008, United States Patent No. RE40,125 (the '125 patent), on an invention entitled "Battery Operated Appliance, Flashlight and Switching Systems" was duly and legally issued by the United States Patent and Trademark Office as a reissue of the '138 patent. A true and correct copy of the '125 patent is attached as Exhibit A of this Complaint.

11. On July 1, 1997, United States Patent No. 5,642,932 (the '932 patent), on an invention entitled "Combat-Oriented Flashlight" was duly and legally issued by the United States Patent and Trademark Office. A true and correct copy of the '932 patent is attached as Exhibit B of this Complaint.

12. The '138 patent was in force and effect from its issuance until its surrender upon issuance of the '125 patent, and the '125 and '932 patents have been in force and effect since their issuance. SureFire has been at all times, and still is, the owner of the entire right, title and interest in and to the '138, '125, and '932 patents.

13. SureFire manufactures and sells flashlights that incorporate and use the inventions claimed in the '125 and '932 patents. SureFire has placed the required statutory notice on all flashlights sold by SureFire under the '138, '125, and '932 patents.

14. PentagonLight markets and sells flashlights and related products in direct competition with SureFire.

15. PentagonLight has published numerous advertisements including either express or implied assertions that its flashlights are "Made in U.S.A." On information and belief, such assertions are false and misleading.

COUNT I

(INFRINGEMENT OF THE '125 PATENT)

16. SureFire realleges and incorporates the previous paragraphs of this Complaint as though set forth in full herein.

17. PentagonLight has used, manufactured, offered for sale, sold and/or caused to be imported into the United States flashlights, including without limitation flashlights

equipped with PentagonLight's TC1, TC2, TC3, TC4, MTC1, MTC2, MTC2, and TR3 tailcap switches, which literally and under the doctrine of equivalents infringe one or more claims of the '125 patent in violation of 35 U.S.C. §271.

18. PentagonLight is actively inducing others, including its customers, to infringe, and/or committing acts of contributory infringement, of one or more claims of the '125 patent through its activities related to making, using, importing, offering for sale, and/or selling their infringing products or causing infringing products to be made, used, imported, offered for sale, and/or sold in the United States, all in violation of 35 U.S.C. §271.

19. SureFire has been damaged and has suffered irreparable injury due to acts of infringement by PentagonLight and will continue to suffer irreparable injury unless PentagonLight's activities are enjoined.

20. SureFire has suffered and will continue to suffer substantial damages by reason of PentagonLight's act of patent infringement alleged above, and SureFire is entitled to recover from PentagonLight the damages sustained as a result of PentagonLight's acts.

21. PentagonLight has willfully and deliberately infringed the '125 patent in disregard of SureFire's rights.

COUNT II

(INFRINGEMENT OF THE '932 PATENT)

22. SureFire realleges and incorporates the previous paragraphs of this Complaint as though set forth in full herein.

23. PentagonLight has used, manufactured, offered for sale, sold and/or caused to be imported into the United States flashlights, including without limitation the PentagonLight K2 "Porcupine" flashlight, which literally and under the doctrine of equivalents infringe one or more claims of the '932 patent in violation of 35 U.S.C. §271.

24. PentagonLight is actively inducing others, including its customers, to infringe, and/or committing acts of contributory infringement, of one or more claims of the '932 patent through its activities related to making, using, importing, offering for sale, and/or selling their infringing products or causing infringing products to be made, used, imported, offered for sale, and/or sold in the United States, all in violation of 35 U.S.C. §271.

25. SureFire has been damaged and has suffered irreparable injury due to acts of infringement by PentagonLight and will continue to suffer irreparable injury unless PentagonLight's activities are enjoined.

26. SureFire has suffered and will continue to suffer substantial damages by reason of PentagonLight's act of patent infringement alleged above, and SureFire is entitled to recover from PentagonLight the damages sustained as a result of PentagonLight's acts.

27. PentagonLight has willfully and deliberately infringed the '932 patent in disregard of SureFire's rights.

COUNT III

(FALSE ADVERTISING IN VIOLATION OF 15 USC § 1125(a))

28. SureFire realleges and incorporates the previous paragraphs of this Complaint as though set forth in full herein.

29. PentagonLight's false and misleading statements in its commercial advertising and promotion misrepresent the origin of its goods and either deceive or have the tendency to deceive a substantial segment of potential consumers.

30. PentagonLight's deception is material in that it is likely to influence the consumer's purchasing decision.

31. PentagonLight's advertisements and packaging were disseminated in interstate commerce.

32. SureFire has been injured as a result of PentagonLight's false and misleading advertisements.

PRAYER FOR RELIEF

WHEREFORE, SureFire prays that judgment be entered by this Court in its favor and against PentagonLight as follows:

- A. That PentagonLight has infringed the '125 and '932 patents;
- B. That PentagonLight has induced infringement and/or contributorily infringed the '125 and '932 patents;
- C. That PentagonLight has falsely advertised in violation of Section 1125(a) of the Lanham Act;
- D. Permanently enjoining and restraining PentagonLight, its agents, affiliates, subsidiaries, servants, employees, officers, directors, attorneys and those persons in active concert with or controlled by PentagonLight from:
 - (i) further infringing the '125 or '932 patents;
 - (ii) inducing others to infringe the '125 or '932 patents;
 - (iii) publishing any advertisements that contain false or misleading statements of fact, including those statements set forth above;
- E. That PentagonLight's infringement of the '125 and '932 patents was willful;
- F. That PentagonLight's false advertising was willful and intentional;
- G. For an award of damages adequate to compensate SureFire for that damages it has suffered as a result of PentagonLight's conduct, including pre-judgment interest and a trebling of such damages due to PentagonLight's willful infringement and other conduct;
- H. That PentagonLight be directed to withdraw from distribution all infringing products and false advertisements, whether in the possession of PentagonLight or its

distributors or retailers, and that all infringing products or materials be impounded or destroyed;

I. That all false advertising materials be impounded or destroyed, and that PentagonLight be required to place corrective advertisements;

J. For monetary damages in an amount according to proof;

K. For interest on said damages at the legal rate from and after the date such damages were incurred;

L. That this is an exceptional case and for an award of SureFire's attorney fees and costs;

M. For such other relief as the Court may deem just and proper.

DEMAND FOR JURY TRIAL

Plaintiff SureFire hereby demands a jury trial as to all issues that are so triable.

Respectfully submitted,

By: Clyde M. Siebman

Clyde M. Siebman

Texas State Bar No. 18341600

Bryan H. Burg

Texas State Bar No. 03374500

**SIEBMAN, REYNOLDS, BURG,
PHILLIPS & SMITH, L.L.P.**

300 N. Travis St.

Sherman, TX 75090

Telephone: (903) 870-0070

Facsimile: (903) 870-0066

clydesiebman@siebman.com

bryanburg@siebman.com

JONATHAN HANGARTNER

Cal. Bar No. 196268

X-PATENTS, APC

5670 La Jolla Blvd.

La Jolla, CA 92037

Attorneys for SureFire, LLC

CERTIFICATE OF SERVICE

I hereby certify that the counsel of record who are deemed to have consented to electronic service are being served today with a copy of this document via the Court's CM/ECF system per Local Rule CV-5(a)(3). Any other counsel of record will be served by electronic mail, facsimile transmission and/or first class mail on this same date.

Dated: September 12, 2008

/s/ Clyde M. Siebman