

**UNITED STATES DISTRICT COURT  
MIDDLE DISTRICT OF FLORIDA  
TAMPA DIVISION**

OTTLITE TECHNOLOGIES, INC., a  
Delaware corporation,

Plaintiff,

CASE NO.: 8:09-cv-608-VCM-TBM

vs.

VERILUX, INC., a Connecticut corporation,

Defendant. \_\_\_\_\_ /

**FIRST AMENDED COMPLAINT  
DECLARATORY AND INJUNCTIVE RELIEF REQUESTED**

Plaintiff, OttLite Technologies, Inc., by its attorneys, Fowler White Boggs P.A., for its first amended complaint against defendant Verilux, Inc., alleges as follows:

**INTRODUCTION**

1. This is an action for a declaratory judgment that the claims of United States Patent No. 7,484,867 (“the '867 Patent”), a copy of which is attached as Exhibit E, are invalid and that the '867 Patent is unenforceable and that no valid and enforceable claims of the '867 Patent are infringed by OttLite Technologies, Inc., either directly or as an inducing or contributory infringer.

**THE PARTIES**

2. OttLite Technologies, Inc. is a Delaware corporation having an address and principal place of business at 1214 West Cass Street, Tampa, Florida 33606-1342.

3. Upon information and belief, Verilux, Inc. is a Connecticut corporation, having its principal place of business at 340 Mad River Park, Suite 1, Waitsfield, Vermont 05673.

#### **JURISDICTION AND VENUE**

4. This Court has jurisdiction over the subject matter of this action pursuant to 28 U.S.C. §§ 1331, 1338, 2201 and 2202.

5. This Court has personal jurisdiction over Verilux, Inc. by virtue of the fact that, upon information and belief, Verilux, Inc. and/or its licensees have regularly solicited business in this state.

6. Venue is proper in this district pursuant to 28 U.S.C. § 1391(d).

#### **FACTS COMMON TO THE COUNTS**

7. OttLite Technologies, Inc. promotes, markets, offers for sale and sells goods in the field of lamps, including, *inter alia*, the 3-in-1 Craft Lamp.

8. OttLite Technologies, Inc. is the owner of the OTTLITE brand, which is well known and respected by its customers and is especially well respected within the crafting community for lamps having improved color fidelity and for reducing eye strain in applications involving detail work.

9. Upon information and belief, U.S. Pat. Appl. No. 11/311,744, entitled “Configurable Lamp Set” is the U.S. patent application that issued as the '867 Patent.

10. Upon information and belief, U.S. Pat. Appl. No. 11/311,744 was filed on December 19, 2005.

11. Upon information and belief, U.S. Pat. Appl. No. 11/311,744 claims the benefit of U.S. Provisional Application No. 60/701,168, which was filed on July 21, 2005, and U.S. Pat. Appl. No. 11/311,744 does not claim priority to any other applications, domestic or foreign.

12. Upon information and belief, the '867 Patent is owned by Verilux, Inc.

13. Upon information and belief, Verilux, Inc. was the applicant for the '867 Patent (the "Applicant").

14. The 3-in-1 Craft Lamp is a design based on earlier Craft Lamp designs of OttLite Technologies, Inc., including the Arial 2-in-1 Lamp, sold in 1998, and the FlexArm Plus Lamp, sold in 2003 (collectively the "Earlier Craft Lamps"). See Exhibit A, Instructions for the 27W Arial 2-in-1 Lamp, PS145M, and Exhibit B, Instructions for the 18w FlexArm Plus Lamp, OLFX18TC.

15. The Earlier Craft Lamps included, in a single packaged offering, a light fixture head for holding a lamp having a switch located thereon for interrupting the supply of electrical power to the lamp and being adjustable to a plurality of locations, the lamp comprising a fluorescent lamp, an extension piece, a light fixture base connectable to either a stem or the extension piece, a light fixture clamp coupling, wherein the light fixture clamp coupling comprises a C-clamp with a threaded clamping member, and the light fixture assemblies of the Earlier Craft Lamps were configurable as: a floor light fixture including the light fixture head, the extension piece and the light fixture base, a desk light fixture including a light fixture head and the light fixture base, and an attachable light fixture including the light fixture head and the light fixture clamp coupling, and the light fixture assembly kits of

the Earlier Craft Lamps were freely re-configurable in desk/floor and attachable light fixture configurations.

16. The FlexArm Plus Lamp included a flexible stem connected to the light fixture head on one end and on the opposite end was connectable re-configurably at the flexible stem: directly to the extension piece, indirectly via the extension piece to the light fixture base or directly to the light fixture clamp, such that the light fixture head was adjustable to a plurality of locations, as a desk/floor lamp or attachable light fixture.

17. The Arial 2-in-1 Lamp included two rigid arm sections pivotably connected at one end to the light fixture head and at an opposite end to a housing that contained a ballast, such that the light fixture head was adjustable to a plurality of locations, and the housing was connectable re-configurably at the housing that contained the ballast: directly to the extension piece, indirectly to the base and directly to the light fixture clamp, as a desk/floor lamp or attachable light fixture.

18. The Earlier Craft Lamps were on sale, sold and published more than one year prior to the earliest priority date of the '867 Patent, and upon information and belief were widely known within the industry and were widely used by customers of OttLite Technologies, Inc. prior to the invention of subject matter claimed in the '867 Patent by Edmund Farmer, purported inventor of the subject matter of the '867 Patent.

19. In a letter dated February 19, 2009, Wesley W. Whitmyer Jr., Esq., of St. Onge Steward, Johnston & Reens LLC, a law firm representing Verilux, Inc. in its intellectual property matters, wrote to OttLite Technologies, Inc. on behalf of Verilux, Inc. asserting that Verilux, Inc. owns the '867 Patent and accusing OttLite Technologies, Inc. of

infringing one or more of the claims contained in the '867 Patent by offering for sale and selling the 3-in-1 Craft Lamp; and Verilux, Inc. demanded that OttLite Technologies, Inc. immediately stop making, using, offering for sale, and selling any products, including the 3-in-1 Craft Lamp; and threatened that Verilux, Inc. shall consider appropriate action to enforce its intellectual property rights. See Exhibit C, Letter from counsel to Verilux, Inc., February 19, 2009.

20. As a result of the aforementioned letter and based on the threats made therein, OttLite Technologies, Inc. has a reasonable fear and apprehension that Verilux, Inc. will commence an action for patent infringement against it in the United States, and an actual and justiciable controversy therefore exists between OttLite Technologies, Inc., the plaintiff, and Verilux, Inc., the defendant.

### **FIRST CAUSE OF ACTION**

#### **Declaratory Judgment for Patent Invalidity**

21. OttLite Technologies, Inc. repeats and realleges each and every allegation of paragraphs 1 through 20 as though fully set forth herein.

22. The '867 Patent is invalid for failure to comply with the requirements of Title 35 U.S.C. relating to patentability of inventions.

23. Marcus T. Schudel, a U.S. resident of the State of Michigan, filed a U.S. patent application, U.S. Pat. Appl. No. 05/909,198, entitled "Lamp" on May 25, 1978 ("the Schudel Application"). The Schudel Application describes a lamp made from a tubular element having a bottom end for receiving a mounted element having a fixture for re-configurable mounting by a clamp coupling to a wheelchair or on a base to form a floor lamp

disposable adjacent to a chair or a table. The Schudel Application was published and issued on December 11, 1979 as U.S. Pat. No. 4,178,625, more than one year prior to the filing date of the application that matured into the '867 Patent and more than one year prior to the '867 Patent's earliest priority date. See Exhibit D, U.S. Pat. No. 4,178,625.

24. Each of the elements in the claims of the '867 Patent relating to, *inter alia*, the 3-in-1 Craft Lamp are directly anticipated or otherwise rendered obvious over description of the Lamp in the Schudel Application.

25. Upon information and belief, the published and issued Schudel Application was never cited to or considered by the United States patent examiner during the prosecution of the application that matured into the '867 Patent.

26. Upon information and belief, the purported inventor, the Applicant, and the Applicant's representatives and agents never disclosed the existence of the Schudel Application to the patent examiner during the examination process of the application that issued as the '867 Patent.

27. Upon information and belief, the purported inventor, the Applicant, and the Applicant's representatives and agents never disclosed the existence of the Earlier Craft Lamps to the patent examiner during the examination process of the application that issued as the '867 Patent.

28. Upon information and belief, each of the elements in the claims of the '867 Patent relating to, *inter alia*, the 3-in-1 Craft Lamp are directly anticipated or otherwise rendered obvious over the sales and offers for sale of the Earlier Craft Lamps, either alone or taken in combination with each other and the Schudel Application.

29. Accordingly, defendant's patent in suit, the '867 Patent, is invalid and void, because the alleged invention was described in a printed publication, was patented, was sold, and was on sale more than one year prior to the earliest priority date of the '867 Patent and more than one year prior to the date of filing of the '867 Patent.

30. The claims of the '867 Patent, owned by Verilux, Inc., are anticipated by the Schudel Application or one of the Earlier Craft Lamps, under 35 U.S.C. § 102, or alternatively, the claims of the '867 Patent, owned by Verilux, Inc., are invalid as being obvious over the Schudel Application, the Earlier Craft Lamps, or a combination of the Schudel Application and the Earlier Craft Lamps, within the meaning of 35 U.S.C. § 103.

## **SECOND CAUSE OF ACTION**

### **Declaratory Judgment for the Inequitable Conduct and Fraud on the Patent & Trademark Office**

31. OttLite Technologies, Inc. repeats and realleges each and every allegation of paragraphs 1 through 20 and 21 through 30 as though fully set forth herein.

32. Upon information and belief, the patentee, the purported inventor, or a representative or agent of the patentee or the purported inventor of the application which matured into the '867 Patent caused the application to be filed or allowed the application to continue to be prosecuted before the United States Patent & Trademark Office with full knowledge that the subject matter of the application had previously been invented by another, was described in a printed publication, was described in an issued patent, was sold in the U.S., or was on sale in the U.S. more than one year prior to the December 19, 2005 filing date of the application that matured into the '867 Patent, or had other information that was material to the patentability of the application which matured into the '867 Patent.

33. Upon information and belief, the patentee, the purported inventor, or a representative or agent of the patentee or the purported inventor of the application which matured into the '867 Patent was aware of the existence of the Earlier Craft Lamps of OttLite Technologies, Inc. at least as early as February 3, 2009.

34. Upon information and belief, the patentee, the purported inventor, or a representative or agent of the patentee or the purported inventor of the application which matured into the '867 Patent was specifically aware of the 3-in-1 Craft Lamp and that OttLite Technologies, Inc. had been selling some version of the 3-in-1 Craft Lamp before the December 19, 2005 filing date of the application which matured into the '867 Patent or before the February 3, 2009 date of issue of the '867 Patent, and never disclosed this to the patent examiner that examined the application which matured into the '867 Patent for the examiner's consideration.

35. The sales and offers for sale of the Earlier Craft Lamps constitute information particularly material and relevant to patentability that should have been disclosed to the patent examiner during prosecution of the application which matured into the '867 Patent.

36. Upon information and belief, no person having an affirmative duty to disclose the existence of the sales or offers for sale of the Earlier Craft Lamps disclosed any information about the Earlier Craft Lamps to the patent examiner during the patent examination process.

37. Upon information and belief, the evidence and inferences drawn from the facts shall show an intent to mislead or deceive the patent examiner by withholding information material to patentability of the application which matured into the '867 Patent



and/or making statements with the intent to mislead or deceive the patent examiner during prosecution of the '867 Patent.

38. In view of the foregoing, defendant failed in its duty of candor and its duty to disclose to the U.S. Patent & Trademark Office information of which it was aware that was material to the examination of the application that matured into the '867 Patent.

39. Therefore, the '867 Patent is invalid and/or unenforceable due to defendant's inequitable conduct and fraud upon the United States Patent & Trademark Office during prosecution and due to the issuance of said patent in violation of the Applicant's duty to disclose information material to patentability and/or under 35 U.S.C. §§ 101, 102 and 103.

### **THIRD CAUSE OF ACTION**

#### **Declaratory Judgment for Non-Infringement**

40. OttLite Technologies, Inc. repeats and realleges each and every allegation of paragraphs 1 through 20, 21 through 30 and 31 through 39 as though fully set forth herein.

41. OttLite Technologies, Inc.'s unique 3-in-1 Craft Lamp contains significant differences from the invention claimed in any valid and enforceable claims of the '867 Patent.

42. Specifically, the 3-in-1 Craft Lamp fails to incorporate any "stem" as that term is arranged and properly interpreted in light of the language of the claims, the specification and the prosecution history, and instead, the 3-in-1 Craft Lamp includes two rigid arm sections that may be adjusted by pivoting the two rigid arm sections to adjust the light fixture head.

43. With respect to claims 5-13 of the '867 Patent, the 3-in-1 Craft Lamp fails to incorporate a balast in a housing, wherein said housing comprises a protrusion extending

from an axial end of the housing opposite the end coupled to the flexible stem, and instead, the 3-in-1 Craft Lamp incorporates a balast into the light fixture head without any protrusion and the ballast is incorporated on the end of the light fixture head coupled to the flexible stem.

44. With respect to claim 26 of the '867 Patent, the 3-in-1 Craft Lamp fails to incorporate a flexible stem, and instead, the 3-in-1 Craft Lamp includes two rigid arm sections that may be adjusted by pivoting the two rigid arm sections to adust the light fixture head.

45. OttLite Technologies, Inc. has not directly infringed, induced the infringement of, nor has been a contributory infringer, of any of the claims of the '867 Patent.

#### **PRAYER FOR RELIEF**

WHEREFORE, plaintiff OttLite Technologies, Inc. prays that the Court enter judgment in its favor and against the Defendant Verilux, Inc.:

A. Declaring that United States Patent No. 7,484,867 is invalid, unenforceable and not infringed by OttLite Technologies, Inc.;

B. Declaring that OttLite Technologies, Inc. has not committed any act of infringement, contributory infringement or inducement to infringe of United States Patent No. 7,484,867 with respect to any products made, used, offered for sale, sold, or imported by OttLite Technologies, Inc. since February 3, 2009 the date that United States Patent No. 7,484,867 issued;

C. Restraining and enjoining Verilux, Inc. and all of its officers, agents, employees, representatives, and counsel, and all persons in active concert or participation

with any of them, directly or indirectly, from charging infringement or instituting any action for infringement of U.S. Patent No. 7,484,867 against OttLite Technologies, Inc. or any of its customers, vendors, distributors and contractors;

D. Pursuant to 35 U.S.C. § 285, awarding to OttLite Technologies, Inc. damages by a factor of three and its reasonable attorney's fees, expenses and costs in this action; and

E. Granting OttLite Technologies, Inc. such other and further relief as the Court deems just and proper.

DATED: May 28, 2009

s/Christopher Paradies  
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**CERTIFICATE OF SERVICE**

I HEREBY CERTIFY that on May 28, 2009, I electronically filed the foregoing with the Clerk of the Court by using the CM/ECF system, which will send a notice of electronic filing.

s/ Christopher Paradies  
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Christopher Paradies

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