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RICHARD W. WIEKING
CLERK, U.S. DISTRICT COURT
NORTHERN DISTRICT OF CALIFORNIA

Attorneys Plaintiff,
SEMTECH CORPORATION

UNITED STATES DISTRICT COURT
NORTHERN DISTRICT OF CALIFORNIA

SEMTECH CORPORATION

Plaintiff,

v.

TECHNOLOGY LICENSING
CORPORATION, PIXEL
INSTRUMENTS CORPORATION, AND
J. CARL COOPER,

Defendants.

C V

Case No. 2082

KAW

COMPLAINT FOR DECLARATORY
JUDGMENT OF PATENT NON-
INFRINGEMENT, INVALIDITY AND
UNENFORCEABILITY

Plaintiff Semtech Corporation ("Semtech") hereby alleges as follows:

NATURE OF THE ACTION

1. This is an action for a declaratory judgment of non-infringement, invalidity, and unenforceability of United States Patent Nos. U.S. RE40,411E (the "411 patent") and RE40,412E (the "412 Patent") (collectively, the "Cooper Patents").

PARTIES

2. Plaintiff Semtech is a corporation organized and existing under the laws of Delaware, and has its corporate headquarters at 200 Flynn Road, Camarillo, California, 93012-8790. Semtech is engaged in the business of, among other things, designing, manufacturing, and selling, high-quality analog and mixed-signal semiconductor products. Semtech recently

1 acquired Gennum Corporation, a leading supplier of high speed analog and mixed-signal
2 semiconductors. Gennum Corporation designed, manufactured and supplied the Accused
3 Products in this action.

4 3. Defendant Technology Licensing Corporation ("TLC") is a Nevada corporation
5 with its principal place of business in Carson City, Nevada. TLC is in the business of enforcing
6 the Cooper Patents and suing companies for infringement of those patents. TLC does not practice
7 any of the Cooper Patents.

8 4. On information and belief, Defendant Pixel Instruments Corporation ("Pixel") is a
9 California corporation with its principal place of business in Los Gatos, California.

10 5. On information and belief, Defendant Cooper is an individual residing in Monte
11 Sereno, California.

12 JURISDICTION AND VENUE

13 6. This action arises under the Declaratory Judgment Act, 28 U.S.C. §§ 2201 *et. seq.*,
14 and under the patent laws of the United States, Title 35 of the United States Code. The Court has
15 jurisdiction over this action pursuant to 35 U.S.C. §§ 271, *et. seq.*, and 28 U.S.C. §§ 1331, 1338,
16 and 2201-2202.

17 7. Venue is proper in this District under 28 U.S.C. §§ 1391 and 1400(b) because a
18 substantial part of the events giving rise to the claims at issue occurred in this District.

19 8. This Court has personal jurisdiction over each of the Defendants by virtue of the
20 business activities they conduct within the State of California and within this District, resulting in
21 sufficient minimum contacts with this forum and because they have committed acts within
22 California and this judicial district giving rise to this action such that the exercise of jurisdiction
23 over it would not offend traditional notions of fair play and substantial justice.

24 INTRADISTRICT ASSIGNMENT

25 9. This case is an Intellectual Property Action under Civil Local Rule 3-2(c) and,
26 pursuant to Civil Local Rule 3-5(b), shall be assigned on a district-wide basis.

27 THE COOPER PATENTS

1 10. United States Patent Application No. 08/165,688, was filed on December 13,
2 1993, and issued as U.S. Patent No. 5,486,869. The '412 Patent is a reissue of U.S. Patent No.
3 5,486,869, reissued on July 1, 2008.

4 11. United States Patent Application No. 08/566,484, which is a continuation-in-part
5 application of Application No. 08/165,688, was filed on December 4, 1995, and issued as U.S.
6 Patent No. 5,754,250 on May 19, 1998. A true and correct copy of the '250 Patent, which is also
7 entitled "Synchronizing Signal Separating Apparatus And Method," is attached as Exhibit 2 to
8 this Complaint.

9 12. The '411 Patent is a reissue of U.S. Patent No. 5,754,250, reissued on July 1,
10 2008.

11 13. Plaintiff is informed and believes that each of the Defendants has an ownership
12 interest in the Cooper Patents.

13 **DEFENDANTS' ENFORCEMENT OF THE COOPER PATENTS**

14 14. One line of integrated circuit products designed and sold by Semtech are video
15 sync separators. Defendants have accused certain of these video sync separators of infringing the
16 Cooper Patents, including but not limited to the Gennum 1881, 4x81, and 4x82 chips ("the
17 Accused Video Sync Separators").

18 15. Over the last several years, Defendants have sent numerous letters to Plaintiff's
19 customers charging that their use of certain of the Accused Video Sync Separators infringe the
20 '411 and '412 Patents. On information and belief, Defendants' allegations of infringement are
21 based entirely on the operation/functionality of the Accused Video Sync Separators. By its
22 letters, Defendants have engaged in a concerted campaign of enforcement, threatening to assert or
23 asserting the Cooper patents against Plaintiff's customers based on their purchase of the Accused
24 Video Sync Separators and incorporation of the chips into the customer's own products.

25 16. On February 9, 2009, Defendant TLC filed suit against Harris in the United States
26 District Court, Northern District of Illinois, Case No. 1:09-cv-00820 (the "Harris Action"),
27 alleging that various of Harris' products infringe the '411 and '412 Patents. Harris is a customer
28 of Plaintiff, and purchases the Accused Video Sync Separators for incorporation into its own

1 products. On information and belief, Defendants' allegations of infringement in the Harris Action
2 against those Harris products using the Accused Video Sync Separators are based entirely on the
3 operation/functionality of the Accused Video Sync Separators.

4 17. On October 17, 2011, Defendant TLC filed suit against Ross Video in the United
5 States District Court, Northern District of Illinois, Case No. 11-cv-7324 (the "Ross Video
6 Action"), alleging that various of Ross Video's products infringe the '411 and '412 Patents. Ross
7 Video is a customer of Plaintiff, and purchases the Accused Video Sync Separators for
8 incorporation into its own products. On information and belief, Defendants' allegations of
9 infringement in the Ross Video Action against those Ross Video products using the Accused
10 Video Sync Separators are based entirely on the operation/functionality of the Accused Video
11 Sync Separators.

12 18. On December 1, 2011, Defendant TLC filed suit against Pelco in United States
13 District Court, Northern District of Illinois, Case No. 11-cv-7324 (the "Pelco Action"), alleging
14 that various of Pelco's products infringe the '411 and '412 Patents. Pelco is a customer of
15 Plaintiff, and purchases the Accused Video Sync Separators for incorporation into its own
16 products. On information and belief, Defendants' allegations of infringement in the Pelco Action
17 against those Pelco products using the Accused Video Sync Separators are based entirely on the
18 operation/functionality of the Accused Video Sync Separators.

19 19. As a distributor of the Accused Video Sync Separators, Semtech has certain
20 contractual indemnity obligations to its customers relating to claims of infringement. Pursuant to
21 those obligations, certain customers, including Harris and Ross Video, have tendered to Semtech
22 claims made by Defendants against such customers for infringement based on such customers'
23 use of the Accused Video Sync Separators.

24 **COUNT I**

25 **(By Plaintiff Semtech Against All Defendants)** 26 **(Declaratory Judgment of Non-infringement of the Cooper Patents)**

27 20. Plaintiff reallege and incorporate by reference paragraphs one through nineteen as
28 if fully set forth herein.

21. Defendants have stated that the Accused Video Sync Separators, and products incorporating such chips, infringe the Cooper Patents.

22. Plaintiff have not infringed and do not infringe, either directly or indirectly, any valid and enforceable claim of the Cooper Patents.

23. As a result of the acts described in the foregoing paragraphs, there exists a substantial controversy of sufficient immediacy and reality to warrant the issuance of a declaratory judgment.

24. An actual and justiciable controversy exists between Plaintiff on the one hand, and Defendants on the other, as to whether the Cooper Patents are infringed by Plaintiff and/or their customers. A judicial declaration is necessary and appropriate so that Plaintiff may ascertain their rights regarding the Cooper patents.

COUNT II

(By Plaintiff Semtech against All Defendants) (Declaratory Judgment of Invalidity of the Cooper Patents)

25. Semtech realleges and incorporates by reference paragraphs one through twenty-four above as if fully set forth herein.

26. Semtech contends that, to the extent any claims of the Cooper Patents could be construed to apply to the Accused Video Sync Separators, the Cooper Patents are invalid for failure to meet the conditions of patentability and/or otherwise comply with one or more Sections of 35 U.S.C. § 101 *et seq.*

27. An actual and justiciable controversy exists between Semtech on one hand, and Defendants on the other, as to whether the Cooper Patents are valid. A judicial declaration is necessary and appropriate so that Semtech may ascertain its rights regarding the Cooper patents.

COUNT III

(By Plaintiff Semtech against All Defendants) (Declaratory Judgment of Unenforceability of the Cooper Patents)

28. Plaintiff re-allege and incorporate by reference Paragraphs one through twenty-seven above as if fully set forth herein.

29. During prosecution of the applications for the '869 and '250 Patents, J. Carl Cooper, and/or the prosecuting attorneys, and/or others associated with the filing and prosecution

1 of the applications for the '869 and '250 Patents had knowledge of and/or were in possession of
2 the National Semiconductor LM1881 video sync separator and/or datasheets regarding the
3 LM1881 video sync separator.

4 30. The National Semiconductor LM1881 video sync separator and/or datasheets
5 regarding the LM1881 video sync separator are prior art that was material to the patentability of
6 one or more claims of the '869 and '250 Patents.

7 31. The National Semiconductor LM1881 video sync separator and/or datasheets
8 regarding the LM1881 video sync separator were not disclosed to the United States Patent and
9 Trademark Office during the filing and prosecution of the applications for the '869 and '250
10 Patents. The named inventor, and/or the prosecuting attorneys, and/or others associated with the
11 filing and prosecution of the applications for the '869 and '250 Patents, withheld information
12 regarding the National Semiconductor LM1881 video sync separator and datasheets regarding the
13 LM1881 video sync separator with an intent to deceive the United States Patent and Trademark
14 Office.

15 32. During prosecution of the applications for the '869 and '250 Patents, J. Carl
16 Cooper, and/or the prosecuting attorneys, and/or others associated with the filing and prosecution
17 of the applications for the '869 and '250 Patents had knowledge of the VSG200 sync separator.

18 33. The VSG200 sync separator was prior art that was material to the patentability of
19 one or more claims of the '869 and '250 Patents.

20 34. The VSG200 sync separator was not disclosed to the United States Patent and
21 Trademark Office during the filing and prosecution of the applications for the '869 and '250
22 Patents. The named inventor, and/or the prosecuting attorneys, and/or others associated with the
23 filing and prosecution of the applications for the '869 and '250 Patents withheld information
24 regarding the VSG200 sync separator with an intent to deceive the United States Patent and
25 Trademark Office.

26 35. An actual and justiciable controversy exists between Plaintiff on the one hand, and
27 Defendants on the other, as to whether the Cooper Patents are unenforceable. A judicial
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1 declaration is necessary and appropriate so that Plaintiff may ascertain its rights regarding the
2 Cooper Patents.

3 **PRAYER FOR RELIEF**

4 WHEREFORE, Plaintiff respectfully requests that judgment be entered in their favor and
5 prays that the court grant the following relief:

6 A. A declaration that the Accused Video Sync Separators have not infringed and do
7 not infringe, either directly or indirectly, any valid and enforceable claim of the Cooper Patents;

8 B. A declaration that the claims of the Cooper Patents are invalid;

9 C. A declaration that the Cooper Patents are unenforceable;

10 D. An order enjoining Defendants, their officers, directors, agents, counsel, servants,
11 and employees, and all persons in active concert or participation with any of them, from charging
12 infringement of or instituting any action for infringement of the Cooper Patents against Semtech,
13 or any of its customers;

14 E. An order declaring that Plaintiff are the prevailing party and that this is an
15 exceptional case under 35 U.S.C. § 285 and award Plaintiff their reasonable attorneys fees,
16 expenses, and costs in this action; and

17 F. Such other and further relief as this Court may deem just and proper.

18 Dated: April 25, 2012

JONES DAY

19
20 By: 

21 Gregory L. Lippetz

22 Attorneys for Plaintiff
23 SEMTECH CORPORATION
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