

**IN THE UNITED STATES DISTRICT COURT
FOR THE WESTERN DISTRICT OF NEW YORK**

BOS GMBH & CO. KG,)	
)	
Plaintiff,)	Civil Action No. _____
v.)	
)	
MACAUTO USA, INC., and KUNSHAN)	
MACAUTO)	JURY TRIAL DEMANDED
)	
Defendant.)	
)	
_____)	

COMPLAINT FOR PATENT INFRINGEMENT

Plaintiff BOS GmbH & Co. KG (“BOS”) for its complaint against Defendants Macauto USA, Inc. (“Macauto USA”), and Kunshan Macauto (“Macauto China”) hereby demands a jury trial and alleges as follows:

THE PARTIES

1. Plaintiff BOS is a corporation organized and existing under the laws of Germany with its principal place of business at Ernst-Heinkel-Strasse 2, Ostfildern, Germany 73760.
2. Defendant Macauto USA is a corporation organized under the laws of New York State with its principal place of business at 80 Excel Drive, Rochester, New York 14621.
3. Defendant Macauto China is a company incorporated under the laws of China with its headquarters at No. 369, Jin Yang East Road, Lujia, Kunshan, Jiangsu, People’s Republic of China.

JURISDICTION AND VENUE

4. This is a complaint for infringement of U.S. Patent No. 6,422,291 B1, as confirmed through Reexamination Certificate (8951st) U.S. Patent 6,422,291 C1, (collectively

“the ‘291 patent”) pursuant to 35 U.S.C. § 271 *et seq.* A copy of the ‘291 patent is attached as Exhibit A and a copy of the Reexamination Certificate is attached as Exhibit B to this Complaint.

5. This Court has subject matter jurisdiction over BOS’s claim pursuant to 28 U.S.C. §§ 1331 and 1338.

6. BOS has the exclusive right to sue for past, present and future infringement of the ‘291 patent, and alone has standing and authority to bring this complaint against the Defendants for infringement of the ‘291 patent.

7. Defendant Macauto China manufactures powered rear window sunshades, which it sells and ships to Macauto USA with port of delivery in Rochester, New York. Upon information and belief, these powered rear window sunshades are sold as available equipment on at least the 2010 and 2011 model years of Buick Lacrosse automobiles.

8. Defendant Macauto USA, sells, offers to sell and/or imports into the United States powered rear window sunshades, which are manufactured and shipped into the United States by Macauto China. Upon information and belief, Defendants’ powered rear window sunshades are sold as available equipment on at least the 2010 and 2011 model years of Buick Lacrosse automobiles.

9. This Court has personal jurisdiction over Macauto USA because it is incorporated in New York State and its headquarters are located in Rochester, New York.

10. This Court has personal jurisdiction over Macauto China because Macauto China delivers into the United States, including this judicial district, powered rear window sunshades that infringe the ‘291 patent.

11. Venue in this Court is appropriate and is based on 28 U.S.C. § 1391, and 28 U.S.C. § 1400.

The '291 Patent

12. On July 23, 2002, the United States Patent and Trademark Office (“USPTO”) issued United States Patent No. 6,422,291 B1, entitled “Roll-Up Blind with Stowable Guiding Members for the Window of a Vehicle.”

13. The '291 patent is generally directed to roll-up window blinds for automobile window panes, such as rear window panes. The blind may be retracted into a slot on a shelf below the rear window when not in use. The inventive roll-up blind is provided with guide elements to prevent unwanted contact with the glass pane, and does not require additional recesses or openings in the area of the slot for enabling retraction of the blind into the slot.

14. Claim 1 of the '291 patent contained an error at column 8, line 47. On December 21, 2010, the USPTO issued a certificate of correction that replaced the term “transferring” at that location with the term “transfer by.” A copy of the certificate of correction is attached as Exhibit C to this Complaint.

15. The claims of the '291 patent have been examined twice by the U.S. Patent and Trademark Office. The USPTO first determined the patentability of the claims in connection with the original patent application, Serial Number 09/762,374, and later, as described in more detail below, the USPTO confirmed the patentability of the claims in connection with a reexamination challenge apparently filed by one or more Macauto entities.

The Macauto Group and Its Infringement of the '219 Patent

16. Macauto Industrial Co., Ltd., (“Macauto Taiwan”) is the parent company of a collection of interlocking companies known as the Macauto Group. The Macauto Group includes the Defendants in this action, Macauto China and Macauto USA, as well as other companies, including Crack Mythology International Ltd., which is the parent organization to

Macauto China. Macauto USA and Macauto China are wholly owned subsidiaries of the Macauto Group.

17. On March 4, 2010, BOS sent a letter to Macauto Taiwan, the parent company of the Macauto Group, informing it of BOS's '291 patent. Upon information and belief, BOS's March 4, 2010 letter was received by Macauto Taiwan by at least March 20, 2010. Also by this date, and upon information and belief, members of the Macauto Group had been making, selling and importing into the United States the powered rear window sunshades that are at issue in this lawsuit.

18. BOS and Macauto Taiwan subsequently attempted to resolve BOS's claims of infringement of the '291 patent. Macauto Taiwan neither identified other members of the Macauto Group as having responsibility for the alleged infringement, nor did it otherwise disclaim responsibility for any allegedly infringing activity. Upon information and belief, Macauto USA and Macauto China had knowledge of the '291 patent, through Macauto Taiwan, at least as early as March or April 2010.

19. Upon information and belief, Macauto Taiwan, acting as the head of the Macauto Group, encouraged other members of the Macauto Group, including Macauto USA and Macauto China, to continue infringing the '291 patent after it received notification of the '291 patent. Upon information and belief, Macauto Taiwan had the ability to control Macauto USA and Macauto China in connection with their allegedly infringing activity.

20. On April 7, 2011, BOS filed a lawsuit in the Northern District of Illinois, *BOS GmbH & Co. KG v. Macauto Industrial Co., Ltd.*, 11-cv-02363, (N.D. Ill.) ("the Illinois lawsuit"), against Macauto Taiwan alleging infringement of the '291 patent, particularly in connection with powered rear window sunshades in models of the 2010 and 2011 Buick

Lacrosse automobile. Members of the Macauto Group did not cease their infringing activity in response to the lawsuit.

21. On August 23, 2011, Macauto Taiwan, in a coordinated effort with Macauto USA and Macauto China, filed a motion to dismiss the Illinois lawsuit for lack of personal jurisdiction. Macauto Taiwan's Motion to Dismiss included sworn declarations of officers of Macauto USA and Macauto China. These officers, through their declarations, provided information about their respective companies and the Macauto Group, and further acknowledged the complaint in the Illinois action. Macauto Taiwan disputed the Illinois court's personal jurisdiction, but conceded that the U.S. District Court for the Western District of New York had personal jurisdiction over it.

22. On November 3, 2011, BOS and Macauto Taiwan filed a Joint Stipulation of Voluntary Dismissal Without Prejudice of the Illinois action. Macauto Taiwan, through counsel, stipulated to waive service of process pursuant to Fed. R. Civ. P. 4(d) for itself and related Macauto entities, including subsidiaries, for a future lawsuit brought in this judicial district.

23. Upon information and belief, no member of the Macauto Group abated or ceased any alleged patent infringement from the time of first knowledge of the '291 patent to the present. Upon information and belief, members of the Macauto Group have continuously made, imported and sold the accused sunshades for use in Buick Lacrosse automobiles from March 2010 until the present.

The Macauto Group's Unsuccessful Attempt to Invalidate the '291 Patent

24. Upon information and belief, Macauto Taiwan, Macauto USA, and/or Macauto China, in connection with their attorneys and other unknown parties, undertook a search for prior art related to the '291 patent after receiving the March 4, 2010 letter from BOS.

25. During the pendency of the Illinois action, Macauto Taiwan, Macauto USA, and/or Macauto China initiated a request for reexamination of the '291 patent, which was filed with the US Patent and Trademark Office on or about July 9, 2011. On August 3, 2011, the USPTO granted the request for reexamination of the '291 patent.

26. The reexamination request submitted to the USPTO on July 9, 2010 was 127 pages long, not including exhibits, and cited 9 alleged prior art references. Upon information and belief, Macauto Taiwan, Macauto USA, and/or Macauto China submitted to the USPTO all material prior art to the '219 patent of which any member of the Macauto Group was aware.

27. The reexamination request asserted that the claims of the '219 patent were obvious. None of the submitted prior art references in the reexamination were alleged to be anticipatory prior art.

28. The USPTO rejected Macauto's invalidity challenge. On February 28, 2012, the USPTO issued a notice of intent to issue a reexamination certificate confirming all claims of the '291 patent. Subsequently on April 10, 2012, the USPTO issued a reexamination certificate stating that "NO AMENDMENTS HAVE BEEN MADE TO THE PATENT" and "The patentability of claims 1-21 is confirmed." *See* Exhibit B.

CLAIM 1

INFRINGEMENT OF THE '291 PATENT

29. Defendants have infringed and continue to infringe the '291 patent by importing, selling and/or offering to sell powered rear window sunshades embodying the patented invention, or by inducing or contributing to the infringement by others of the '291 patent, and will continue to do so unless enjoined by this Court.

30. More specifically, upon information and belief, Macauto USA has infringed at least claim 1 of the '291 patent by importing, selling or offering for sale the powered rear window sunshades intended for use in certain models of the 2010 and 2011 Buick Lacrosse automobiles. Macauto China, upon information and belief, has infringed at least claim 1 of the '291 patent by making the powered rear window sunshades intended for use in certain models of the 2010 and 2011 Buick Lacrosse automobiles and selling those products to Macauto USA (FOB Rochester, New York, USA) with full knowledge of the '291 patent.

31. Upon information and belief, Defendants have caused and will cause, by their infringing conduct and by their inducement or contributing to infringement by others, irreparable harm to BOS for which there is no adequate remedy at law.

32. Upon information and belief, Defendants have engaged in their conduct willfully and in complete disregard of BOS's rights and interests.

33. As a result of Defendants' actions, BOS has suffered and continues to suffer substantial injury, including irreparable injury, which will result in damages to BOS, including loss of sales and profits, which BOS would have made but for the infringement by Defendants, unless Defendants are enjoined by this Court.

PRAYER FOR RELIEF

WHEREFORE, Plaintiff prays for judgment as follows:

- A. That the '291 patent was infringed by Defendants;
- B. That BOS be awarded all damages adequate to compensate it for Defendants' infringement by the manufacture, use, sale, offer for sale or importation in the United States of

powered rear window sunshades, such damages to be determined by a jury and that such damages be awarded to BOS with prejudgment and postjudgment interest;

C. That Defendants' infringement was willful, and awarding to BOS treble damages in light of Defendants' willful infringement;

D. That this case is exceptional under 35 U.S.C. § 285 and awarding BOS the attorneys' fees, costs, and expenses that it incurs in prosecuting this action; and

E. That BOS be awarded such other and further relief as this Court may deem just and proper.

JURY DEMAND

Plaintiff demands a trial by jury on all issues triable of right by a jury.

Respectfully submitted,

Date: May 30, 2012

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