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9
10 **UNITED STATES DISTRICT COURT**
11 **SOUTHERN DISTRICT OF CALIFORNIA**

12
13 e.Digital Corporation,
14 Plaintiff,

15 v.

16 JVC Americas Corp.; and, JVC
Kenwood Corporation.

17
18 Defendants.
19
20

Case No. '13CV0356 MMAMDD

**COMPLAINT FOR PATENT
INFRINGEMENT**

DEMAND FOR JURY TRIAL

21 Plaintiff e.Digital Corporation (“e.Digital” or “Plaintiff”), by and through its
22 undersigned counsel, complains and alleges against JVC Americas Corp. and, JVC
23 Kenwood Corporation (collectively, “JVC”) as follows:

24 **NATURE OF THE ACTION**

25 1. This is a civil action for infringement of a patent arising under the
26 laws of the United States relating to patents, 35 U.S.C. § 101, *et seq.*, including,
27 without limitation, § 281. Plaintiff e.Digital seeks a preliminary and permanent
28 injunction and monetary damages for the infringement of its U.S. Patent Nos. 5,

1 839, 108; 5,842,170; 5,742,737; and 5,491,774.

2 **JURISDICTION AND VENUE**

3 2. This court has subject matter jurisdiction over this case for patent
4 infringement under 28 U.S.C. §§ 1331 and 1338(a) and pursuant to the patent laws
5 of the United States of America, 35 U.S.C. § 101, *et seq.*

6 3. Venue properly lies within the Southern District of California
7 pursuant to the provisions of 28 U.S.C. §§ 1391(b), (c), and (d) and 1400(b). On
8 information and belief, Defendant conducts substantial business directly and/or
9 through third parties or agents in this judicial district by selling and/or offering to
10 sell the infringing products and/or by conducting other business in this judicial
11 district. Furthermore, Plaintiff e.Digital is headquartered and has its principal
12 place of business in this district, engages in business in this district, and has been
13 harmed by Defendant's conduct, business transactions and sales in this district.

14 4. This Court has personal jurisdiction over Defendants because, on
15 information and belief, Defendants transact continuous and systematic business
16 within the State of California and the Southern District of California. In addition,
17 this Court has personal jurisdiction over the Defendants because, on information
18 and belief, this lawsuit arises out of Defendants' infringing activities, including,
19 without limitation, the making, using, selling and/or offering to sell infringing
20 products in the State of California and the Southern District of California. Finally,
21 this Court has personal jurisdiction over Defendants because, on information and
22 belief, Defendants have made, used, sold and/or offered for sale its infringing
23 products and placed such infringing products in the stream of interstate commerce
24 with the expectation that such infringing products would be made, used, sold
25 and/or offered for sale within the State of California and the Southern District of
26 California.

27 **PARTIES**

28 5. Plaintiff e.Digital is a Delaware corporation with its headquarters and

1 principal place of business at 16870 West Bernardo Drive, Suite 120, San Diego,
2 California 92127.

3 6. Upon information and belief, Defendant JVC Americas Corp. is a
4 company registered and lawfully existing under the laws of the State of Delaware,
5 with an office and principal place of business located at 1700 Valley Road, Wayne,
6 New Jersey 07470.

7 7. Upon information and belief, Defendant JVC Kenwood Corporation is
8 a company registered and lawfully existing under the laws of Japan, with an office
9 and principal place of business located at 3-12, Moriyacho, Kanagawa-ku,
10 Yokohama-shi, Kanagawa, 221-0022, Japan.

11 **THE ASSERTED PATENTS**

12 8. On November 17, 1998, United States Patent No. 5,839,108 (“the
13 ’108 patent”) entitled “Flash Memory File System In A Handheld Record And
14 Playback Device,” was duly and legally issued by the United States Patent and
15 Trademark Office. The named inventors are Norbert P. Daberko and Richard K.
16 Davis. e.Digital is the assignee and owner of the entire right, title and interest in
17 and to the ’108 patent and has the right to bring this suit for damages and other
18 relief. A true and correct copy of the ’108 patent is attached hereto as Exhibit A.

19 9. On November 24, 1998, United States Patent No. 5,842,170 (“the
20 ’170 patent”) entitled “Method For Editing In Hand Held Recorder,” was duly and
21 legally issued by the United States Patent and Trademark Office. The named
22 inventors are Norbert P. Daberko, Richard K. Davis, and Richard D. Bridgewater.
23 e.Digital is the assignee and owner of the entire right, title and interest in and to the
24 ’170 patent and has the right to bring this suit for damages and other relief. A true
25 and correct copy of the ’170 patent is attached hereto as Exhibit B.

26 10. On April 21, 1998, United States Patent No. 5,742,737 (“the ’737
27 patent”) entitled “Method For Recording Voice Messages On Flash Memory In A
28 Hand Held Recorder,” was duly and legally issued by the United States Patent and

1 Trademark Office. The named inventors are Norbert P. Daberko, Richard K.
2 Davis, and Richard D. Bridgewater. e.Digital is the assignee and owner of the
3 entire right, title and interest in and to the '737 patent and has the right to bring this
4 suit for damages and other relief. A true and correct copy of the '737 patent is
5 attached hereto as Exhibit C.

6 11. On October 17, 2012, the United States Patent and Trademark Office
7 issued a Reexamination Certificate for the '737 patent, canceling Claim 5 and
8 adding new Claim 13, which is substantially identical to former claim 5. A true
9 and correct copy of the Reexamination Certificate is attached hereto as Exhibit D.

10 12. On February 13, 1996, United States Patent No. 5,491,774 (“the ‘774
11 patent”) entitled “Handheld Record And Playback Device With Flash Memory,”
12 was duly and legally issued by the United States Patent and Trademark Office.
13 The named inventors are Elwood G. Norris, Norbert P. Daberko, and Steven T.
14 Brightbill. e.Digital is the assignee and owner of the entire right, title and interest
15 in and to the '774 patent and has the right to bring this suit for damages and other
16 relief. A true and correct copy of the '774 patent is attached hereto as Exhibit E.

17 13. On August 14, 2012, the United States Patent and Trademark Office
18 issued a Reexamination Certificate for the '774 patent. A true and correct copy of
19 the Reexamination Certificate is attached hereto as Exhibit F.

20 COUNT ONE

21 **INFRINGEMENT OF THE '108 PATENT BY DEFENDANTS**

22 14. Plaintiff re-alleges and incorporates by reference each of the
23 allegations set forth above.

24 15. Upon information and belief, Defendants, without authority, (a) have
25 directly infringed and continue to directly infringe the '108 patent by making,
26 using, offering to sell, or selling within the United States, or importing into the
27 United States, products that practice claim 5 of the '108 patent in violation of 35
28 U.S.C. § 271(a); (b) have induced and continue to induce infringement of claim 5

1 of the '108 patent in violation of 35 U.S.C. § 271(b); and (c) have contributed and
2 continue to contribute to the infringement of claim 5 of the '108 patent in violation
3 of 35 U.S.C. § 271(c).

4 16. The accused products for purposes of the '108 patent include but are
5 not limited to the JVC GCPX10US camera; the JVC GS-TD1BUS, GZ-
6 HM960BUS, GZE200AUS, GZ-EX210AUS, GZ-EX-215, GZ-EX250AUS, GZ-
7 V500BUS, GZ-VX700BUS, GZ-VX705, GZ-GX1BUS, GZE10AUS, GZ-HM40,
8 GZ-HM440AUS, GZ-HM450, GZ-HM650, GZ-HM670, GZ-HM690, GZ-
9 HM320BUS, GZHM300, GZ-HD520BUS, GZ-HM550BUS, GZ-HM860BUS,
10 GY-H150U, GY-HM150E, GY-HM710U, GY-HM750U, GY-HM790U, GY-
11 HM600U, GY-HM650U, GY-HMQ10U, and GY-HMZ1U camcorders; and the
12 JVC GV-LS2W and GV-LS1B live streaming remote cameras.

13 17. The accused products, alone or in combination with other products,
14 practice each of the limitations of independent claim 5 of the '108 patent.

15 18. Upon information and belief, Defendants, without authority, have
16 actively induced and continue to actively induce infringement of claim 5 of the
17 '108 patent in violation of 35 U.S.C. § 271(b) by causing others to directly infringe
18 the claims of the '108 patent and/or by intentionally instructing others how to use
19 the accused products in a manner that infringes claim 5 of the '108 patent. Plaintiff
20 also alleges that Defendants have induced and continue to induce infringement by
21 instructing customers to operate the products in an infringing manner and/or when
22 Defendants test or otherwise operates the accused products in the United States.

23 19. Upon information and belief, Defendants, without authority, have
24 contributed and continue to contribute to the infringement of claim 5 of the '108
25 patent in violation of 35 U.S.C. § 271(c) by importing into the United States,
26 selling and/or offering to sell within the United States accused products that (1)
27 embody and constitute a material part of the invention of the '108 patent, (2)
28 Defendants know to be especially adapted for use in infringing the '108 patent, and

1 (3) are not staple articles of commerce suitable for substantial non-infringing use
2 with respect to the '108 patent.

3 20. Based on information and belief, Plaintiff alleges that Defendants sell,
4 ship or otherwise deliver the accused products with all the features required to
5 infringe the asserted claims of the '108 patent. On information and belief, these
6 products are designed to implement the infringing features.

7 21. Defendants had knowledge of infringement of the '108 patent since at
8 least the filing of this complaint and perhaps as early as 2010 by virtue of the
9 Plaintiff's filing of complaints against others within Defendants' industry. On
10 information and belief, Defendants have continued to sell products that practice the
11 '108 patent after acquiring knowledge of infringement.

12 22. Upon information and belief, the infringement by Defendants has
13 been and is willful.

14 23. Plaintiff has been irreparably harmed by these acts of infringement
15 and has no adequate remedy at law. Upon information and belief, infringement of
16 the '108 patent is ongoing and will continue unless Defendants are enjoined from
17 further infringement by the court.

18 **COUNT TWO**

19 **INFRINGEMENT OF THE '170 PATENT BY DEFENDANTS**

20 24. Plaintiff re-alleges and incorporates by reference each of the
21 allegations set forth in paragraphs 1 through 13 above.

22 25. Upon information and belief, Defendants, without authority, (a) have
23 directly infringed and continue to directly infringe the '170 patent by making,
24 using, offering to sell, or selling within the United States, or importing into the
25 United States, products that practice one or more claims of the '170 patent in
26 violation of 35 U.S.C. § 271(a); (b) have induced and continue to induce
27 infringement of one or more claims of the '170 patent in violation of 35 U.S.C. §
28 271(b); and (c) have contributed and continue to contribute to the infringement of

1 one ore more claims of the '170 patent in violation of 35 U.S.C. § 271(c).

2 26. The accused products for purposes of the '170 patent include but are
3 not limited to the JVC GC-PX10US camera; and JVC GS-TD1BUS, GZ-
4 HM960BUS, GZ-E200AUS, GZ-EX210AUS, GZ-EX215, GZ-EX250AUS, GZ-
5 V500BUS, GZ-VX700BUS, GZ-VX705, GZ-GX1BUS, GZ-HM440AUS, GZ-
6 HM450, GZ-HM650, GZ-HM670, GZ-HM690, GZ-HM320BUS, GZ-HM300,
7 GZ-HD520BUS, GZ-HM550BUS, GZ-HM860BUS, GY-HM150U, GY-HM150E,
8 GY-HM710U, GY-HM750U, GY-HM790U, GY-HM600U, GY-HM650U, GY-
9 HMQ10U, and GY-HMZ1U camcorders.

10 27. The accused products, alone or in combination with other products,
11 practice each of the limitations of independent claims 1 and 7 and dependent
12 claims 2 through 5 and 8 through 12 of the '170 patent.

13 28. Upon information and belief, Defendants, without authority, have
14 actively induced infringement and continue to actively induce infringement of the
15 '170 patent in violation of 35 U.S.C. § 271(b) by causing others to directly infringe
16 the claims of the '170 patent and/or by intentionally instructing others how to use
17 the accused products in a manner that infringes the claims of the '170 patent. On
18 information and belief, Defendants have induced and continue to induce
19 infringement by instructing customers to operate the products in an infringing
20 manner and/or when Defendants test or otherwise operate the accused products in
21 the United States.

22 29. Upon information and belief, Defendants, without authority, have
23 contributed and continue to contribute to the infringement of the '170 patent in
24 violation of 35 U.S.C. § 271(c) by importing into the United States, selling and/or
25 offering to sell within the United States accused products that (1) embody and
26 constitute a material part of the invention of the '170 patent, (2) Defendants knows
27 to be especially adapted for use in infringing the '170 patent, and (3) are not staple
28 articles of commerce suitable for substantial non-infringing use with respect to the

1 '170 patent.

2 30. Based on information and belief, Plaintiff alleges that Defendants sell,
3 ship, or otherwise deliver the accused products with all the features required to
4 infringe the asserted claims of the '170 patent. On information and belief, these
5 products are designed to practice the infringing features.

6 31. Defendants had knowledge of infringement of the '170 patent since at
7 least the filing of this complaint and perhaps as early as 2010 by virtue of the
8 Plaintiff's filing of complaints against others within Defendants' industry. On
9 information and belief, Defendants have continued to sell products that practice the
10 '170 patent after acquiring knowledge of infringement.

11 32. Plaintiff alleges upon information and belief, that the infringement by
12 Defendants has been and is willful. Plaintiff has been irreparably harmed by these
13 acts of infringement and has no adequate remedy at law. Upon information and
14 belief, infringement of the '170 patent is ongoing and will continue unless
15 Defendants are enjoined from further infringement by the court.

16 **COUNT THREE**

17 **INFRINGEMENT OF THE '737 PATENT BY DEFENDANTS**

18 33. Plaintiff re-alleges and incorporates by reference each of the
19 allegations set forth in paragraphs 1 through 13 above.

20 34. Upon information and belief, Defendants, without authority, (a) have
21 directly infringed and continue to directly infringe the '737 patent by making,
22 using, offering to sell, or selling within the United States, or importing into the
23 United States, products that practice one or more claims of the '737 patent in
24 violation of 35 U.S.C. § 271(a); (b) have induced and continue to induce
25 infringement of one or more claims of the '737 patent in violation of 35 U.S.C. §
26 271(b); and (c) have contributed and continue to contribute to the infringement of
27 one or more claims of the '737 patent in violation of 35 U.S.C. § 271(c).

28 35. The accused products for purposes of the '737 patent include but are

1 not limited to the JVC GC-PX10US and GC-XA1 cameras; JVC GS-TD1BUS,
2 GZ-HM960BUS, GZ-E200AUS, GZ-EX210AUS, GZ-EX215, GZ-EX250AUS,
3 GZ-V500BUS, GZ-VX700BUS, GZ-VX705, GZ-GX1BUS, GZ-HM30AUS, GZ-
4 E10AUS, GZ-HM40, GZ-HM50RUS, GZ-HM440AUS, GZ-HM450, GZ-HM650,
5 GZ-HM670, GZ-HM690, GZ-HM320BUS, GZ-HM300, GZ-HD520BUS, GZ-
6 HM550BUS, GZ-HM860BUS, GY-HM150U, GY-HM150E, GY-HM710U, GY-
7 HM750U, GY-HM790U, GY-HM600U, GY-HM650U, GY-HMQ10U, GY-
8 HMZ1U camcorders; and JVC GV-LS2W and GV-LS1B live streaming remote
9 cameras.

10 36. The accused products, alone or in combination with other products,
11 practice each of the limitations of independent claims 1, 4, 9, 11 (GY-HM150U,
12 GY-HM150E, GY-HM600U, and GY-HM650U only) and 13, and dependent
13 claims 2, 3, 6, 8, 10, and 12 of the '737 patent.

14 37. Upon information and belief, Defendants, without authority, have
15 actively induced infringement and continue to actively induce infringement of the
16 '737 patent in violation of 35 U.S.C. § 271(b) by causing others to directly infringe
17 the claims of the '737 patent and/or by intentionally instructing others how to use
18 the accused products in a manner that infringes the claims of the '737 patent. On
19 information and belief, Defendants have induced and continue to induce
20 infringement by instructing customers to operate the products in an infringing
21 manner and/or when Defendants test or otherwise operate the accused products in
22 the United States.

23 38. Upon information and belief, Defendants, without authority, have
24 contributed to and continue to contribute to the infringement of the '737 patent in
25 violation of 35 U.S.C. § 271(c) by importing into the United States, selling and/or
26 offering to sell within the United States accused products that (1) constitute a
27 material part of the invention of the '737 patent, (2) Defendants know to be
28 especially adapted for use in infringing the '737 patent, and (3) are not staple

1 articles of commerce suitable for substantial noninfringing use with respect to the
2 '737 patent.

3 39. Based on information and belief, Plaintiff alleges that Defendants sell,
4 ship, or otherwise deliver the accused products with all the features required to
5 infringe the asserted claims of the '737 patent. On information and belief, these
6 products are designed to practice the infringing features.

7 40. Defendants had knowledge of infringement of the '737 patent since at
8 least the filing of this complaint and perhaps as early as 2010 by virtue of the
9 Plaintiff's filing of complaints against others within Defendants' industry. On
10 information and belief, Defendants have continued to sell products that practice the
11 '737 patent after acquiring knowledge of infringement.

12 41. Upon information and belief, the infringement by Defendants has
13 been and is willful.

14 42. Plaintiff has been irreparably harmed by these acts of infringement
15 and has no adequate remedy at law. Upon information and belief, infringement of
16 the '737 patent is ongoing and will continue unless Defendant is enjoined from
17 further infringement by the court.

18 **COUNT FOUR**

19 **INFRINGEMENT OF THE '774 PATENT BY DEFENDANTS**

20 43. Plaintiff re-alleges and incorporates by reference each of the
21 allegations set forth in paragraphs 1 through 13 above.

22 44. Upon information and belief, Defendants, without authority, (a) have
23 directly infringed and continue to directly infringe the '774 patent by making,
24 using, offering to sell, or selling within the United States, or importing into the
25 United States, products that practice one or more claims of the '774 patent in
26 violation of 35 U.S.C. § 271(a); (b) have induced and continue to induce
27 infringement of one or more claims of the '774 patent in violation of 35 U.S.C. §
28 271(b); and (c) have contributed and continue to contribute to the infringement of

1 one ore more claims of the '774 patent in violation of 35 U.S.C. § 271(c).

2 45. The accused products for purposes of the '774 patent include but are
3 not limited to JVC GC-PX10US and GC-XA1 cameras; and JVC GS-TD1BUS,
4 GZ-HM960BUS, GZ-E200AUS, GZ-EX210AUS, GZ-EX215, GZ-EX250AUS,
5 GZ-V500BUS, GZ-VX700BUS, GZ-VX705, GZ-GX1BUS, GZ-HM30AUS, GZ-
6 E10AUS, GZ-HM40, GZ-HM50RUS, GZ-HM440AUS, GZ-HM450, GZ-HM650,
7 GZ-HM670, GZ-HM690, GZ-HM320BUS, GZ-HM300, GZ-HD520BUS, GZ-
8 HM550BUS, GZ-HM860BUS, GY-HM150U, GY-HM150E, GY-HM710U, GY-
9 HM750U, GY-HM790U, GY-HM600U, GY-HM650U, GY-HMQ10U, and GY-
10 HMZ1U camcorders.

11 46. The accused products, alone or in combination with other products,
12 practice each of the limitations of independent claims 33 and 34, and dependent
13 claims 2, 6 through 8, 10, 15 through 18, 23 through 26, and 28 through 31 of the
14 '774 patent.

15 47. Upon information and belief, Defendants, without authority, have
16 actively induced infringement and continues to actively induce infringement of the
17 '774 patent in violation of 35 U.S.C. § 271(b) by causing others to directly infringe
18 the claims of the '774 patent and/or by intentionally instructing others how to use
19 the accused products in a manner that infringes the claims of the '774 patent. On
20 information and belief, Defendants have induced and continue to induce
21 infringement by instructing customers to operate the products in an infringing
22 manner and/or when Defendants test or otherwise operate the accused products in
23 the United States.

24 48. Upon information and belief, Defendants, without authority, have
25 contributed to and continue to contribute to the infringement of the '774 patent in
26 violation of 35 U.S.C. § 271(c) by importing into the United States, selling and/or
27 offering to sell within the United States accused products that (1) constitute a
28 material part of the invention of the '774 patent, (2) Defendants know to be

1 especially adapted for use in infringing the '774 patent, and (3) are not staple
2 articles of commerce suitable for substantial noninfringing use with respect to the
3 '774 patent.

4 49. Based on information and belief, Plaintiff alleges that Defendants sell,
5 ship, or otherwise deliver the accused products with all the features required to
6 infringe the asserted claims of the '774 patent. On information and belief, these
7 products are designed to practice the infringing features.

8 50. Defendants had knowledge of infringement of the '774 patent since at
9 least the filing of this complaint and perhaps as early as 2010 by virtue of the
10 Plaintiff's filing of complaints against others within Defendants' industry. On
11 information and belief, Defendants have continued to sell products that practice the
12 '774 patent after acquiring knowledge of infringement.

13 51. Upon information and belief, the infringement by Defendants has
14 been and is willful.

15 52. Plaintiff has been irreparably harmed by these acts of infringement
16 and has no adequate remedy at law. Upon information and belief, infringement of
17 the '774 patent is ongoing and will continue unless Defendant is enjoined from
18 further infringement by the court.

19 **PRAYER FOR RELIEF**

20 WHEREFORE, Plaintiff prays for relief and judgment as follows:

- 21 1. That Defendants be declared to have infringed the Patents-in-Suit;
- 22 2. That Defendants' infringement of the Patents-in-Suit has been
23 deliberate and willful;
- 24 3. Preliminarily and permanently enjoining the Defendants' officers,
25 agents, servants, employees, and attorneys, and those persons in active concert or
26 participation with them, from infringement of the Patents-in-Suit, including but not
27 limited to any making, using, offering for sale, selling, or importing of unlicensed
28 infringing products within and without the United States;

1 4. Compensation for all damages caused by Defendants' infringement of
2 the Patents-in-Suit to be determined at trial;

3 5. Enhancing Plaintiff's damages up to three (3) times their amount
4 pursuant to 35 U.S.C. § 284;

5 6. Granting Plaintiff pre- and post-judgment interest on its damages,
6 together with all costs and expenses; and

7 7. Awarding such other relief as this Court may deem just and proper

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HANDAL & ASSOCIATES

10 Dated: February 12, 2013

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By: /s/ Gabriel G. Hedrick
Anton N. Handal
Gabriel G. Hedrick
Pamela C. Chalk
Attorneys for Plaintiff
e.Digital Corporation

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DEMAND FOR JURY TRIAL

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Plaintiff hereby demands a trial by jury on all claims.

HANDAL & ASSOCIATES

Dated: February 12, 2013

By: /s/ Gabriel G. Hedrick
Anton N. Handal
Gabriel G. Hedrick
Pamela C. Chalk
Attorneys for Plaintiff
e.Digital Corporation