

**IN THE UNITED STATES DISTRICT COURT  
EASTERN DISTRICT OF TEXAS  
MARSHALL DIVISION**

**NOVELPOINT TRACKING LLC**

Plaintiff,

v.

**TOSHIBA AMERICA INFORMATION  
SYSTEMS, INC. A/K/A TAIS**

Defendant.

**Case No. 2:12-cv-780**

**PATENT CASE**

**JURY TRIAL DEMANDED**

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**AMENDED COMPLAINT**

NovelPoint Tracking LLC files this Amended Complaint against Toshiba America Information Systems, Inc. (“Defendant”) for infringement of United States Patent No. 6,442,485.

**THE PARTIES**

1. Plaintiff NovelPoint Tracking LLC (“NPT”) is a Texas limited liability company with its principal place of business at 1300 Ballantrae Dr., Allen TX, 75013 in the Eastern District of Texas.

2. Defendant Toshiba America Information Systems, Inc. is a California Corporation with its principal place of business at 9740 Irvine Boulevard, Irvine, California 92618. Clicking on the “Consumer Products” link on Defendant’s home page directs inquiries made by persons such as NPT (with a zip code of 75013) to purchase the Toshiba products online at [Toshibadirect.com](http://Toshibadirect.com) for shipment anywhere in the United States, including to customers located in the Eastern District of Texas. Defendant’s Registered Agent in the State of Texas is CT Corporation System located at 350 N. St. Paul St., suite 2900, Dallas, Texas 75201. Toshiba products are offered for sale through retailers and distributors within the District such as Best

Buy (whose website directs visitors such as NPT with a zip code of 75013 to its stores in the District such as its store at 8720 State Hwy. 121, McKinney, Texas 75070).

**NATURE OF THE ACTION**

3. This is a civil action for infringement of United States Patent No. 6,442,485 (the “Patent-in-Suit”), arising under the Patent Laws of the United States, 35 U.S.C. § 1 *et seq.*

**JURISDICTION AND VENUE**

4. This Court has jurisdiction over the subject matter of this action pursuant to 28 U.S.C. §§ 1331 (Federal Question) and 1338(a) (Patents).

5. Venue is proper in this Court pursuant to 28 U.S.C. §§ 1391(b) and 1400(b) because Defendant has committed acts of infringement in this district and is deemed to reside in this district for purposes of this action.

6. This Court has personal jurisdiction over Defendant and venue is proper in this district because Defendant has committed, and continues to commit, acts of infringement in the State of Texas, including in this district and/or has engaged in continuous and systematic activities in the State of Texas, including in this district.

**THE PATENT-IN-SUIT**

7. The Patent-in-Suit, entitled “Method and Apparatus for an Automatic Vehicle Location, Collision Notification, and Synthetic Voice,” was duly and legally issued by the United States Patent and Trademark Office on August 27, 2002. A copy of the Patent-in-Suit is attached hereto as Exhibit A.

8. NPT is the exclusive owner of all rights, title, and interest in the Patent-in-Suit, including the right to exclude others and to enforce, sue and recover damages for past and future infringement thereof.

**KNOWLEDGE OF THE PATENT-IN-SUIT**

9. NPT filed its original Complaint in this matter on 8 December 2013 asserting the Patent-in-Suit.

10. Defendant has therefore had knowledge of the Patent-in-Suit, its subject matter, and NPT's averments regarding Toshiba's infringement thereof, for more than two months.

**COUNT I: DIRECT INFRINGEMENT OF THE PATENT-IN-SUIT**

11. NPT incorporates paragraphs 1 through 10 by reference as if fully stated herein.

12. The Patent-in-Suit is valid and enforceable.

13. Defendant has directly infringed, and continues to directly infringe, one or more claims of the Patent-in-Suit under 35 U.S.C. § 271(a), either literally and/or under the doctrine of equivalents, by making, using, selling, offering for sale, and/or importing products and/or methods encompassed by those claims.

14. Defendant's Toshiba Thrive is an example of an infringing product and/or method.

**COUNT II: INDUCED INFRINGEMENT**

15. NPT incorporates paragraphs 1 through 14 by reference as if fully stated herein.

16. Third party resellers and retailers including Sears and Amazon have infringed, and continue to infringe, one or more claims of the Patent-in-Suit under 35 U.S.C. § 271(a), either literally and/or under the doctrine of equivalents, by using, selling, and/or offering for sale in the United States, and/or importing into the United States, products supplied by Defendant.

17. The Toshiba Thrive, for example, is currently in stock and being offered for sale by numerous retailers and distributors, including Sears and Amazon.

18. Defendant is “proud to work with fine companies that sell [Toshiba’s] products” and currently encourages members of the public to “[b]uy direct from one of [Toshiba’s] retailers or visit their online store[s].” Defendant’s website currently includes links to at least 10 partner retailers of Defendant’s products, including WalMart and Amazon. These links are not limited to store location finders, but include the current Toshiba products offered for sale by many of Defendant’s partners. For example, Defendant provides a link encouraging website users to buy Toshiba products, including the Toshiba Thrive, “direct from” its partner Amazon’s website.

19. Retailers and resellers of Defendant’s products are not limited to those linked and promoted on Defendant’s website. Unlisted retailers and resellers such as Sears and eBay are currently offering the Toshiba Thrive for sale in the US.

20. Defendant encourages companies to become “Preferred Partners” of Toshiba, which “recognize[s] [their] important role in [Toshiba’s] success” by offering them “[a] full spectrum of programs, services, perks, discounts, resources and value-added extras to help [them] find, win, retain and grow customers.” For example, in addition to basics like training, discounts, and sales materials and tools, Toshiba offers a “Deal Registration Program... show[ing]... respect for your channel expertise and relationship with the customer,” a “quick turnaround bid service... [to] submit bids for... opportunities that require special discounts on Toshiba products,” “Build-to-Order Capabilities” which permit Preferred Partners to “go above and beyond the ordinary by providing unique solutions to... customers through custom product configurations,” “Product Trade-In and Recycling” for their customers, and “Preferred Partner Branding... [to d]istinguish yourself in the marketplace.”

21. Even greater support is provided to “Preferred Partner[s] Plus,” who enjoy “Dedicated Toshiba Field Support” (“a team of skilled Toshiba professionals at your disposal to

support your needs”), “Marketing Development Funds,” a “New Business Opportunity Leads program,” and an even deeper discount structure.

22. Toshiba’s Preferred Partners include companies in Athens, Jefferson, Hallsville, Longview, and Marshall, Texas within the Eastern District of Texas.

23. Defendant has induced infringement, and continues to induce infringement, of one or more claims of the Patent-in-Suit under 35 U.S.C. § 271(b) by actively, knowingly, and intentionally inducing current infringement of the Patent-in-Suit by making, using, importing, and selling or otherwise supplying products to other parties such as Sears and Amazon, with the knowledge and intent that such third parties are using, selling, or offering for sale products supplied by Defendant to infringe the Patent-in-Suit; and with the knowledge and intent to encourage and facilitate such infringement through Defendant’s website and extensive, tailored partner benefit programs.

24. Defendant’s Toshiba Thrive is an example of an infringing product and/or method.

### **COUNT III: CONTRIBUTORY INFRINGEMENT**

25. NPT incorporates paragraphs 1 through 24 by reference as if fully stated herein.

26. Defendant has directly promoted non-staple products for sale to the general public in the United States that it specifically identifies and describes as components for use or inclusion in other products, including components constituting a material part of the inventions of the Patent-in-Suit in infringing products like the Toshiba Thrive such as the AT&T 4G HSPA+ Thrive update (the “4G Update”) promoted at \$80 allowing users to get on the mobile internet when WiFi is unavailable. Similarly relevant components for up to thirty different Thrive model numbers, including, for example, the H000033470 GPS antenna for the Thrive AT

105 PDA01U-00101-F, are currently being offered for sale by the National Parts Depot. Toshiba's website instructs users looking for GPS and other components for Thrive tablets to "purchase service parts (modem/ethernet replacement cables, printed circuit boards, display panels, drives, plastics, etc.) for in and out of warranty systems from National Parts Depot at 800-331-4829," and provides a link to the Toshiba search page on National Parts Depot's website where components for specific products, including Thrive tablets, may be ordered.

27. Components offered directly for sale by Defendant, including the 4G Update and the H000033470, are especially made or adapted for use with specific Toshiba products identified by Defendant, including products for sale directly by Defendant, and products available through retailers, resellers, and other partners of Toshiba.

28. On information and belief, such components, including the 4G Update and the H000033470, have no substantial non-infringing use.

29. Defendant and/or its subsidiaries have contributed, and continue to contribute, to the infringement by one another, and by their resellers, retailers, and other partners, of one or more claims of the Patent-in-Suit under 35 U.S.C. § 271(c) by making, using, selling, offering for sale, and/or importing Defendant's products, knowing that those products constitute a material part of the inventions of the Patent-in-Suit, knowing that those products are especially made or adapted to infringe the Patent-in-Suit, and knowing that those products are not staple articles of commerce suitable for substantial noninfringing use.

**REMEDIES ISSUES COMMON TO ALL COUNTS**

30. NPT incorporates paragraphs 1 through 29 by reference as if fully stated herein.

31. Toshiba is a Japanese company based in Tokyo, Japan, which disclosed an astonishing 750 subsidiaries located around the world in its 2012 Annual Report.

32. Defendant is a global company with many functionally distinct facilities in different countries which could be associated with Toshiba or any one of its subsidiaries, but any or all of which could be associated with revenues related to the US manufacture, use, sale, offer for sale, or import of infringing products such as the Dell Venue. For example, Defendant's Pathumthani plant in Thailand supplies chips incorporated in both Toshiba and non-Toshiba tablets which make their way to many countries.

33. Defendant's numerous subsidiaries are not all reported using the same accounting methods. In particular, some subsidiaries are consolidated while others are accounted for using the equity method.

34. NPT has been and continues to be damaged by Defendant's infringement of the Patent-in-Suit. These damages are governed by patent law, not by tax or other accounting considerations, and NPT is entitled to damages-related discovery based on patent law.

35. Defendant's actions complained of herein are causing irreparable harm and damages to NPT and will continue to do so unless and until Defendant is enjoined and restrained by the Court.

36. Defendant's conduct in infringing the Patent-in-Suit renders this case exceptional within the meaning of 35 U.S.C. § 285.

37. Defendant's infringement has been willful since at least the filing of NPT's original Complaint.

**JURY DEMAND**

38. Plaintiff NPT hereby demands a trial by jury on all issues so triable.

**PRAYER FOR RELIEF**

WHEREFORE, NPT prays for judgment as follows:

A. That Defendant has infringed one or more claims of the patent-in-suit;

B. That Defendant account for and pay all damages necessary to adequately compensate NPT for infringement of the patent-in-suit, such damages to be determined by a jury, and that such damages be trebled and awarded to NPT with pre-judgment and post-judgment interest;

C. That Defendant and its officers, directors, agents, servants, affiliates, employees, divisions, branches, subsidiaries, parents, and all others acting in concert or actively participating with them, be permanently enjoined from directly or indirectly infringing the patent-in-suit; or, in the alternative, judgment that Defendant account for and pay to NPT an ongoing post-judgment royalty reflecting Defendant's deliberate continuing infringement;

D. That this case be declared an exceptional case within the meaning of 35 U.S.C. § 285 and that NPT be awarded the attorney fees, costs, and expenses that it incurs prosecuting this action; and

E. That NPT be awarded such other and further relief as this Court deems just and proper.

DATED: March 8, 2013

Respectfully submitted,

/s/ Everett Upshaw  
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**ATTORNEY FOR PLAINTIFF**



**CERTIFICATE OF SERVICE**

I hereby certify that the foregoing document was filed electronically on March 8, 2013 pursuant to Local Rule CV-5(a) and has been served on all counsel who are deemed to have consented to electronic service.

By: /s/ Everett Upshaw  
Everett Upshaw