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25 **UNITED STATES DISTRICT COURT**
26 **CENTRAL DISTRICT OF CALIFORNIA**

27 JIAXING SUPER LIGHTING
28 ELECTRIC APPLIANCE CO., LTD.,
et al.,

Plaintiffs,

v.

MAXLITE, INC.,

Defendant.

Case No. 2:19-cv-04047-PSG-MAA

**ANSWER TO COMPLAINT AND
COUNTERCLAIMS**

DEMAND FOR JURY TRIAL

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ANSWER TO COMPLAINT

Defendant MaxLite, Inc. (“MaxLite”) by and through the undersigned counsel, hereby answers the Complaint of Plaintiffs Super Lighting Electric Appliance Co., Ltd. (“Super Lighting”) and Obert, Inc. (“Obert”) (collectively, “Plaintiffs”) for Patent Infringement dated May 8, 2019 (“Complaint”). Except as specifically admitted, MaxLite denies each of the allegations of the Complaint. MaxLite alleges on information and belief as follows:

Parties¹

- 1. MaxLite is without knowledge or information sufficient to form a belief as to the truth of the allegations contained in Paragraph 1 of the Complaint, and on that basis denies each and every such allegation.
- 2. MaxLite is without knowledge or information sufficient to form a belief as to the truth of the allegations contained in Paragraph 2 of the Complaint, and on that basis denies each and every such allegation.
- 3. Admitted.

Background of the Parties

- 4. MaxLite is without knowledge or information sufficient to form a belief as to the truth of the allegations contained in Paragraph 4 of the Complaint, and on that basis denies each and every such allegation.
- 5. MaxLite is without knowledge or information sufficient to form a belief as to the truth of the allegations contained in Paragraph 5 of the Complaint, and on that basis denies each and every such allegation.

¹ For convenience and ease of reference, MaxLite uses section headings in this Answer that correspond to section headings used in the Complaint. Through its use of said section headings, MaxLite does not admit any allegation and therefore denies each and every such allegation.

1 12. MaxLite restates and incorporates by reference its responses to the
2 allegations contained in paragraph 12 as though fully set forth herein. MaxLite
3 admits that it has a regular and established place of business in this District at 1148
4 Ocean Cir., Anaheim, CA 92896. MaxLite does not contest for the purposes of this
5 action that venue is proper in this District. MaxLite denies any remaining
6 allegations of Paragraph 12 of the Complaint.

7 **MaxLite’s Alleged Infringement of the Patents-in-Suit**

8 13. MaxLite admits that charts were attached to the Complaint as Exhibits
9 11-21. MaxLite denies any remaining allegations of Paragraph 13 of the
10 Complaint.

11 14. Denied. MaxLite denies that it has infringed any of the Patents-in-
12 Suit.

13 15. MaxLite denies that Super Lighting provided notice to MaxLite on
14 September 26, 2018 of any Super Lighting product, including Double Ended Type
15 B tube LEDs. MaxLite denies any remaining allegations of Paragraph 15 of the
16 Complaint.

17 16. MaxLite admits that it received a letter and an associated presentation
18 from Super Lighting on November 28, 2018, and that the letter described Super
19 Lighting’s licensing program. MaxLite denies that on November 28, 2018 it was
20 provided notice of the “Patents-in-Suit” as that term is defined in the Complaint.
21 MaxLite denies that specific features and functionality of any claim of the ‘826
22 Patent, the ‘265 Patent, the ‘662 Patent, the ‘536 Patent, or the ‘897 Patent were
23 identified by Super Lighting on November 28, 2018. MaxLite denies that any
24 feature of any specific product was identified in Super Lighting’s November 28,
25 2018 letter or associated presentation. MaxLite denies that any of its products
26 infringe claims 18 and 28 of the ‘174 Patent. MaxLite denies any remaining
27 allegations of Paragraph 16 of the Complaint.
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1 17. MaxLite admits that the parties exchanged correspondence after
2 November 28, 2018, and that MaxLite received an e-mail from Super Lighting on
3 December 5, 2018. MaxLite denies the remaining allegations of Paragraph 17 of
4 the Complaint.

5 18. MaxLite admits that an additional exchange of correspondence
6 occurred after December 5, 2018, including on January 18, 2019. MaxLite admits
7 that the January 18, 2019 correspondence identified a single MaxLite product that
8 Super Lighting alleged infringed the ‘265 Patent, and a single MaxLite product that
9 Super Lighting alleged infringed the ‘662 Patent. MaxLite admits a claim chart
10 was attached for the ‘662 Patent and a single MaxLite product. MaxLite denies
11 that a claim chart was attached concerning the ‘265 Patent. MaxLite denies that
12 any of its products infringe the ‘265 Patent or the ‘662 Patent. MaxLite denies the
13 remaining allegations of Paragraph 18 of the Complaint.

14 19. MaxLite admits it received correspondence from Super Lighting on
15 February 14, 2019. MaxLite denies that this correspondence “further indicated to
16 MaxLite that MaxLite was infringing the ‘174, ‘265, and ‘662 Patents and
17 specifically identified to MaxLite that it was additionally infringing the ‘536
18 Patent.” MaxLite denies that it infringes the ‘174 Patent, the ‘265 Patent, the ‘662
19 Patent or the ‘536 Patent. MaxLite denies the remaining allegations of Paragraph
20 19 of the Complaint.

21 20. Denied.

22 21. MaxLite denies that, at least by November 28, 2018, it was provided
23 notice of the “Patents-in-Suit,” as that term is defined in the Complaint. MaxLite
24 denies that, at least by November 28, 2018, it was provided notice of any specific
25 features and functionality Super Lighting accused of infringement for the ‘826
26 Patent, the ‘265 Patent, the ‘662 Patent, the ‘536 Patent, and the ‘897 Patent.
27 MaxLite denies any remaining allegations of Paragraph 21 of the Complaint.
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Count IV

(Infringement of U.S. Patent No. 10,208,897)

45. MaxLite restates and incorporates by reference its responses to the allegations contained in Paragraphs 1-44 of the Complaint as though fully set forth herein.

46. MaxLite admits that a copy of what purports to be the ‘897 Patent was attached to the Complaint as Exhibit 4. MaxLite denies that the ‘897 Patent is valid and enforceable. MaxLite denies that the ‘897 Patent was duly and legally issued. MaxLite admits that Exhibit 4 recites that the ‘897 Patent issued on Feb. 19, 2019. MaxLite denies any remaining allegations of Paragraph 46 of the Complaint.

- 47. Denied.
- 48. Denied.
- 49. Denied.
- 50. Denied.
- 51. Denied.

Count V

(Infringement of U.S. Patent No. 9,807,826)

52. MaxLite restates and incorporates by reference its responses to the allegations contained in Paragraphs 1-51 of the Complaint as though fully set forth herein.

53. MaxLite admits that a copy of what purports to be the ‘826 Patent was attached to the Complaint as Exhibit 5. MaxLite denies that the ‘826 Patent is valid and enforceable. MaxLite denies that the ‘826 Patent was duly and legally issued. MaxLite admits that Exhibit 5 recites that the ‘826 Patent issued on Oct. 31, 2017. MaxLite denies any remaining allegations of Paragraph 53 of the Complaint.

- 54. Denied.
- 55. Denied.
- 56. Denied.

1 57. Denied.

2 58. Denied.

3 **Count VI**

4 **(Infringement of U.S. Patent No. 9,897,265)**

5 59. MaxLite restates and incorporates by reference its responses to the
6 allegations contained in Paragraphs 1-58 of the Complaint as though fully set forth
7 herein.

8 60. MaxLite admits that a copy of what purports to be the '265 Patent was
9 attached to the Complaint as Exhibit 6. MaxLite denies that the '265 Patent is valid
10 and enforceable. MaxLite denies that the '265 Patent was duly and legally issued.
11 MaxLite admits that Exhibit 6 recites that the '265 Patent issued on Feb. 20, 2018.
12 MaxLite denies any remaining allegations of Paragraph 60 of the Complaint.

13 61. Denied.

14 62. Denied.

15 63. Denied.

16 64. Denied.

17 65. Denied.

18 **Prayer for Relief**

19 66. MaxLite denies that Plaintiffs are entitled to any relief whatsoever,
20 whether as sought in the Prayer for Relief of its Complaint or otherwise in this
21 action.

22 **Demand for Jury Trial**

23 67. MaxLite admits that Plaintiffs have demanded a trial by jury of this
24 action.

25 **General Denial**

26 68. MaxLite denies each and every allegation contained in the Complaint
27 that was not specifically admitted above.

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AFFIRMATIVE DEFENSES

69. Without admitting or implying that MaxLite bears the burden of proof as to any of them, MaxLite asserts, on information and belief, the following affirmative defenses to the allegations set forth in the Complaint.

First Affirmative Defense

(Noninfringement of the ‘536 Patent)

70. MaxLite has not infringed any valid claim of the ‘536 Patent.

Second Affirmative Defense

(Noninfringement of the ‘174 Patent)

71. MaxLite has not infringed any valid claim of the ‘174 Patent.

Third Affirmative Defense

(Noninfringement of the ‘662 Patent)

72. MaxLite has not infringed any valid claim of the ‘662 Patent.

Fourth Affirmative Defense

(Noninfringement of the ‘897 Patent)

73. MaxLite has not infringed any valid claim of the ‘897 Patent.

Fifth Affirmative Defense

(Noninfringement of the ‘826 Patent)

74. MaxLite has not infringed any valid claim of the ‘826 Patent.

Sixth Affirmative Defense

(Noninfringement of the ‘265 Patent)

75. MaxLite has not infringed any valid claim of the ‘265 Patent.

Seventh Affirmative Defense

(Invalidity of the ‘536 Patent)

76. The ‘536 Patent, and each claim thereof, is invalid for failing to comply with the requirements of the patent laws of the United States, including one or more of the requirements specified in Sections 101, 102, 103, 112, and/or 116 of Title 35 of the United States Code.

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Eighth Affirmative Defense

(Invalidity of the '174 Patent)

77. The '174 Patent, and each claim thereof, is invalid for failing to comply with the requirements of the patent laws of the United States, including one or more of the requirements specified in Sections 101, 102, 103, 112, and/or 116 of Title 35 of the United States Code.

Ninth Affirmative Defense

(Invalidity of the '662 Patent)

78. The '662 Patent, and each claim thereof, is invalid for failing to comply with the requirements of the patent laws of the United States, including one or more of the requirements specified in Sections 101, 102, 103, 112, and/or 116 of Title 35 of the United States Code.

Tenth Affirmative Defense

(Invalidity of the '897 Patent)

79. The '897 Patent, and each claim thereof, is invalid for failing to comply with the requirements of the patent laws of the United States, including one or more of the requirements specified in Sections 101, 102, 103, 112, and/or 116 of Title 35 of the United States Code.

Eleventh Affirmative Defense

(Invalidity of the '826 Patent)

80. The '826 Patent, and each claim thereof, is invalid for failing to comply with the requirements of the patent laws of the United States, including one or more of the requirements specified in Sections 101, 102, 103, 112, and/or 116 of Title 35 of the United States Code.

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Twelfth Affirmative Defense

(Invalidity of the ‘265 Patent)

81. The ‘265 Patent, and each claim thereof, is invalid for failing to comply with the requirements of the patent laws of the United States, including one or more of the requirements specified in Sections 101, 102, 103, 112, and/or 116 of Title 35 of the United States Code.

Thirteenth Affirmative Defense

(No Entitlement to Injunctive Relief)

82. Plaintiffs are not entitled to injunctive relief as they have, at a minimum, no irreparable injury and an adequate remedy at law for MaxLite’s alleged infringement of the Patents-in-Suit. Plaintiffs will be unable to establish that (1) they have suffered any injury, let alone an irreparable injury; (2) remedies available at law, such as monetary damages, would be inadequate to compensate for any injury; (3) considering the balance of hardships between Plaintiffs and MaxLite, a remedy in equity is warranted; and (4) the public interest would not be disserved by a permanent injunction.

Fourteenth Affirmative Defense

(Lack of Notice, Failure to Mark)

83. Any claims for damages for alleged infringement of the Patents-in-Suit are barred or limited due to failure to satisfy the requirements of 35 U.S.C. § 287. Super Lighting sells products that Super Lighting understands practice the Patents-in-Suit, but Super Lighting has failed to mark its practicing products with the required notice under 35 U.S.C. § 287. Further, on information and belief Super Lighting has licensed the Patents-in-Suit to Obert, and Obert has failed to mark its licensed products with the required notice under 35 U.S.C. § 287. Thus, any damages to which Plaintiffs could be entitled for alleged infringement of the Patents-in-Suit are limited to any infringement occurring after Plaintiffs filed their Complaint in this action.

1 **Fifteenth Affirmative Defense**

2 **(No Willful Infringement)**

3 84. MaxLite has not intentionally, willfully, or deliberately infringed any
4 claim of the Patents-in-Suit.

5 **Pre-suit Communications**

6 85. On November 28, 2018, Super Lighting sent to MaxLite a “Notice re
7 Super Lighting’s Patent License Program” (“the Notice”). The Notice is attached
8 as Exhibit 1. The Notice purported to inform MaxLite that Super Lighting was
9 “promoting its patent license program.” This Notice further stated “[t]hrough this
10 program, your company may gain the access to Super Lighting’s technological
11 development” and “[t]he technology in this license program believably shall benefit
12 you and increase the value of your products. Please consider to apply for this
13 license program and to join Super Lighting in offering better and more advanced
14 products to the customers.” Although the Notice also stated that Super Lighting
15 “does not tolerate any trespassing to its technology and will not hesitate to take any
16 legal action in order to protect its rights and benefits on the technology,” the Notice
17 did not mention MaxLite’s products, or accuse any MaxLite product of infringing
18 any of Super Lighting’s patents, including the Patents-in-Suit.

19 86. The Notice attached a “PowerPoint introduction of Super Lighting’s
20 patent license program” (“the PowerPoint”). The PowerPoint is attached as Exhibit
21 2. The PowerPoint identified more than 60 U.S. patents and approximately 14 U.S.
22 patent publications. The PowerPoint generically claimed that these patents are
23 related to “Tube LEDs,” but provided no information regarding how each of these
24 patents and publications are related to Tube LEDs, what types of Tube LEDs are
25 covered by each of these patents and publications, or how any claim of any patent
26 or publication should be read on any product, including any MaxLite product. The
27 PowerPoint did not identify MaxLite by name, nor did the PowerPoint identify or
28 accuse any MaxLite product of infringing any of Super Lighting’s patents,

1 including the Patents-in-Suit. The PowerPoint included slides on claims 18 and 28
2 of the '174 patent, highlighting certain terms, but did not include any information
3 regarding how these terms should be read on any product, including any MaxLite
4 product.

5 87. Upon information and belief, the Notice and the PowerPoint are the
6 "letter" and "associated presentation" identified by Super Lighting in Paragraph 16
7 of the Complaint. To the extent that Paragraph 16 of the Complaint alleges that the
8 Notice provided "specific features and functionality of" MaxLite's products "that
9 practice the Patents-in-Suit," such allegation is not true. To the extent Paragraph
10 16 of the Complaint alleges that the PowerPoint included information regarding the
11 MaxLite products "covered by Super Lighting's patents," such allegation is not
12 true.

13 88. On December 5, 2018, in response to a number of emails from
14 MaxLite's General Counsel, Super Lighting responded by email to MaxLite's
15 General Counsel ("the December 5 Email"). The December 5 Email is attached as
16 Exhibit 3. Upon information and belief, the December 5 Email is the
17 correspondence identified by Super Lighting in Paragraph 17 of the Complaint.
18 The December 5 Email includes a generic claim that Super Lighting "also
19 discovered several products sold on your [MaxLite's] brand infringe Super
20 Lighting's patents." The December 5 Email did not identify any specific Super
21 Lighting Patent, did not identify any specific MaxLite product, and did not include
22 any information regarding how any patent claim should be read on any MaxLite
23 Product. Further, Super Lighting's December 5 Email conceded that "it might be
24 difficult for MaxLite to identify infringement." Finally, in the December 5 Email,
25 Super Lighting told MaxLite that its "team will assist you in determining whether
26 the products MaxLite purchases from other companies infringe Super Lighting's
27 patents." The December 5 Email did not offer "to further explain to MaxLite the
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1 bases for Super Lighting’s infringement allegations” as alleged in Paragraph 17 of
2 the Complaint.

3 89. On January 15, 2019, MaxLite’s General Counsel emailed Super
4 Lighting, informing Super Lighting that MaxLite’s manufacturer of LED tube
5 lights has “several non-infringement opinions on this technology.” This email
6 further requested a claim chart from Super Lighting, because “without it, it is
7 difficult to assess any alleged infringement claims.”

8 90. On January 18, 2019, Super Lighting again emailed MaxLite’s
9 General Counsel (“the January 18 Email”). The January 18 Email and its four
10 attachments are attached as Exhibit 4. Upon information and belief, the January 18
11 Email is the correspondence identified by Super Lighting in Paragraph 18 of the
12 Complaint. The January 18 Email identified MaxLite’s L11.5T8DE440-CG4 as
13 “covered by our patents, for example US Pat. Nos. 9,897,265 and 9,497,821,” and
14 identified MaxLite’s L25T5DF450-CG4 as “covered by our patents, for example,
15 US Pat. No. 9,723,662.” The January 18 Email attached an analysis by Super
16 Lighting of “MaxLite’s LED tube model L25T5DF450-CG4 in view of our ‘662
17 patent” and “MaxLite’s LED tube model L11.5T8DE440-CG4 in view of our ‘821
18 Patent.” U.S. Patent No. 9,497,821 is not asserted in this action. To the extent
19 Paragraph 18 of the Complaint alleges that the January 18 Email “provided
20 infringement charts” regarding the ‘265 Patent, such allegation is not true.

21 91. On February 12, 2019, MaxLite’s General Counsel again emailed
22 Super Lighting, indicating that MaxLite has “been trying to obtain additional
23 technical information from our other vendor but have been delayed because of the
24 [Chinese New Year] holiday. This email further expressed a willingness to have a
25 meeting date and stated that “[w]e think it is important to have complete
26 information before we meet.”
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1 designer of the L11.5T8DE440-CG4 product, nor is it the manufacturer or designer
2 of any of the circuitry contained in that product. The information required to form
3 a belief as to infringement of the L11.5T8DE440-CG4 product, by the '536 Patent,
4 was not in MaxLite's hands prior to the filing of this lawsuit. MaxLite asked Super
5 Lighting for a claim chart for any alleged infringing activities. Super Lighting
6 informed MaxLite that it would provide analysis of any potential infringement to
7 MaxLite regarding the L11.5T8DE440-CG4 product and the '536 Patent. Super
8 Lighting never provided any such analysis. Therefore, MaxLite had a legitimate
9 basis to believe that its L11.5T8DE440-CG4 product did not infringe the '536
10 Patent prior to the filing of the Complaint. Further, MaxLite's activities prior to the
11 lawsuit—asking Super Lighting for a claim chart and waiting for infringement
12 analysis that was promised by Super Lighting—were reasonable and in no way
13 egregious.

14 95. MaxLite has not and does not willfully infringe the '174 Patent. Prior
15 to the filing of the complaint in this action, MaxLite had no rational basis to believe
16 that its importation, use, offers for sale, or sales of its L11.5T8DE440-CG4 product
17 infringed the '174 Patent. For example, MaxLite is not the manufacturer or
18 designer of the L11.5T8DE440-CG4 product, nor is it the manufacturer or designer
19 of any of the circuitry contained in that product. The information required to form
20 a belief as to infringement of the L11.5T8DE440-CG4 product, by the '174 Patent,
21 was not in MaxLite's hands prior to the filing of this lawsuit. MaxLite asked Super
22 Lighting for a claim chart for any alleged infringing activities. Super Lighting
23 informed MaxLite that it would provide analysis of any potential infringement to
24 MaxLite regarding the L11.5T8DE440-CG4 product and the '174 Patent. Super
25 Lighting never provided any such analysis. Therefore, MaxLite had a legitimate
26 basis to believe that its L11.5T8DE440-CG4 product did not infringe the '174
27 Patent prior to the filing of the Complaint. Further, MaxLite's activities prior to the
28 lawsuit—asking Super Lighting for a claim chart and waiting for infringement

1 analysis that was promised by Super Lighting—were reasonable and in no way
2 egregious.

3 96. MaxLite has not and does not willfully infringe the ‘897 Patent. Prior
4 to the filing of the complaint in this action, MaxLite had no rational basis to believe
5 that its importation, use, offers for sale, or sales of its L11.5T8DE440-CG4 product
6 or L25T5DF450-CG4 infringed the ‘897 Patent. For example, MaxLite is not the
7 manufacturer or designer of the L11.5T8DE440-CG4 product or the L25T5DF450-
8 CG4 product, nor is it the manufacturer or designer of any of the circuitry
9 contained in those products. The information required to form a belief as to
10 infringement of the L11.5T8DE440-CG4 and L25T5DF450-CG4 product, by the
11 ‘897 Patent, was not in MaxLite’s hands prior to the filing of this lawsuit. MaxLite
12 asked Super Lighting for a claim chart for any alleged infringing activities. Super
13 Lighting never informed MaxLite that it may be infringing the ‘897 Patent in any
14 manner. Further, Super Lighting informed MaxLite that it would provide analysis
15 of any potential infringement to MaxLite regarding the L11.5T8DE440-CG4
16 product and the L25T5DF450-CG4 product. Super Lighting never provided any
17 such analysis. Therefore, MaxLite had a legitimate basis to believe that its
18 L11.5T8DE440-CG4 product and L25T5DF450-CG4 product did not infringe the
19 ‘897 Patent prior to the filing of the Complaint. Indeed, the ‘897 Patent did not
20 issue until February 19, 2019, after Super Lighting stopped communicating with
21 MaxLite. Further, MaxLite’s activities prior to the lawsuit—asking Super Lighting
22 for a claim chart and waiting for infringement analysis that was promised by Super
23 Lighting—were reasonable and in no way egregious. Without pre-suit willful
24 infringement, Super Lighting is not entitled to a finding of willful infringement in
25 this action.

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1 97. MaxLite has not and does not willfully infringe the ‘826 Patent. Prior
2 to the filing of the complaint in this action, MaxLite had no rational basis to believe
3 that its importation, use, offers for sale, or sales of its 12T8AB440-CG product
4 infringed the ‘826 Patent. For example, MaxLite is not the manufacturer or
5 designer of the 12T8AB440-CG product, nor is it the manufacturer or designer of
6 any of the circuitry contained in those products. The information required to form
7 a belief as to infringement of the 12T8AB440-CG product, by the ‘826 Patent, was
8 not in MaxLite’s hands prior to the filing of this lawsuit. MaxLite asked Super
9 Lighting for a claim chart for any alleged infringing activities. Super Lighting
10 never informed MaxLite that it may be infringing the ‘897 Patent in any manner.
11 Super Lighting also never identified the 12T8AB440-CG product as potentially
12 infringing any of Super Lighting’s patents. Therefore, as Super Lighting had
13 identified other potential infringing products and other potential patents that were
14 infringed, but never the ‘826 Patent or the 12T8AB440-CG product, MaxLite had a
15 legitimate basis to believe that its 12T8AB440-CG product did not infringe the
16 ‘826 Patent prior to the filing of the Complaint. Further, MaxLite’s activities prior
17 to the lawsuit—asking Super Lighting for a claim chart and waiting for
18 infringement analysis that was promised by Super Lighting—were reasonable and
19 in no way egregious.

20 98. MaxLite has not and does not willfully infringe the ‘265 Patent. Prior
21 to the filing of the complaint in this action, MaxLite had no rational basis to believe
22 that its importation, use, offers for sale, or sales of its L11.5T8DE440-CG4 product
23 or U15.5T8SE240 product infringed the ‘265 Patent. For example, MaxLite is not
24 the manufacturer or designer of the L11.5T8DE440-CG4 product or the
25 U15.5T8SE240 product, nor is it the manufacturer or designer of any of the
26 circuitry contained in those products. The information required to form a belief as
27 to infringement of the L11.5T8DE440-CG4 and U15.5T8SE240 product, by the
28 ‘265 Patent, was not in MaxLite’s hands prior to the filing of this lawsuit. MaxLite

1 asked Super Lighting for a claim chart for any alleged infringing activities. Super
2 Lighting informed MaxLite that it would provide analysis of any potential
3 infringement to MaxLite regarding the L11.5T8DE440-CG4 product and the ‘265
4 Patent. Super Lighting never provided any such analysis. Further, Super Lighting
5 never identified the U15.5T8SE240 product as potentially infringing any of Super
6 Lighting’s patents, including the ‘265 Patent. Therefore, MaxLite had a legitimate
7 basis to believe that its L11.5T8DE440-CG4 product and U15.5T8SE240 product
8 did not infringe the ‘265 Patent prior to the filing of the Complaint. Further,
9 MaxLite’s activities prior to the lawsuit—asking Super Lighting for a claim chart
10 and waiting for infringement analysis that was promised by Super Lighting—were
11 reasonable and in no way egregious.

12 **No Egregious Conduct**

13 99. MaxLite has not and does not willfully infringe any of the Patents-in-
14 Suit because MaxLite’s conduct was not egregious and therefore does not warrant
15 enhanced damages.

16 100. MaxLite’s response to any alleged infringement allegations was
17 reasonable conduct and does not warrant enhanced damages. MaxLite’s response
18 to Super Lighting’s allegations of infringement, to the extent they exist, was to seek
19 claim charts so that MaxLite could assess those allegations. MaxLite also sought
20 additional information from a vendor who supplies the products accused of
21 infringement and suggested having a meeting with Super Lighting once MaxLite
22 had complete information regarding Super Lighting’s infringement allegations.

23 101. Similarly, MaxLite’s subsequent communications with Super Lighting
24 were reasonable conduct, and do not warrant enhanced damages. MaxLite kept
25 Super Lighting apprised of the information it required in order to evaluate for itself
26 whether it infringed any of Super Lighting’s patents, requested that information
27 from Super Lighting, and suggested having a meeting with Super Lighting.

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COUNTERCLAIMS

Pursuant to Rule 13 of the Federal Rules of Civil Procedure, MaxLite, Inc. (“MaxLite”) for its Counterclaims against Super Lighting Electric Appliance Co., Ltd. (“Super Lighting”) and Obert, Inc. (“Obert”) (collectively, “Counterclaim Defendants”) alleges as follows:

Parties

106. MaxLite is a corporation organized and existing under the laws of the State of New Jersey, having its principal place of business at 12 York Avenue, West Caldwell, Essex County, New Jersey 07006

107. Super Lighting alleges that it is a corporation organized and existing under the laws of the People’s Republic of China with its principal place of business at No. 1288 Jiachuang Rd., Xiuzhou Area, Jiaxing, Zhejiang, China.

108. Obert alleges that it is the North American affiliate of Super Lighting and a corporation organized under the laws of the State of California with its principal place of business at 1380 Charles Willard St., Carson, CA 90746. Obert further alleges that it operates a sales office and warehouse at that address in Carson, CA, serving customers in the U.S. market, and plans to operate a factory at that address by 2020.

Jurisdiction and Venue

109. These Counterclaims arise under federal law, and this Court has subject matter jurisdiction pursuant to 28 U.S.C. §§ 1331 and 1338(a), the Declaratory Judgment Act, 28 U.S.C. §§ 2001 and 2002, and the Patent Laws of the United States, 35 U.S.C. §§ 101, et seq.

110. This Court has personal jurisdiction over Counterclaim Defendants because each has consented to jurisdiction in the state of California by bringing the present action and because at least some of the complained-of acts occurred in this judicial district.

1 111. Venue for this counterclaim is proper in this judicial district pursuant
2 to 28 U.S.C. §§ 1391 and 1400(b) by virtue of Counterclaim Defendants’
3 admission in the Complaint that venue is proper in this district.

4 112. Super Lighting claims to be the owner of U.S. Patent Nos. 9,689,536
5 (“the ‘536 Patent”), 9,841,174 (“the ‘174 Patent”), 9,723,662 (“the ‘662 Patent”),
6 10,208,897 (“the ‘897 Patent”), 9,807,826 (“the ‘826 Patent”), and 9,897,265 (“the
7 ‘265 Patent”) (collectively, “the Patents-in-Suit”), and Obert claims to be the
8 exclusive licensee of the Patents-in-Suit.

9 **Pre-Suit Communications**

10 113. On November 28, 2018, Super Lighting sent to MaxLite a “Notice re
11 Super Lighting’s Patent License Program” (“the Notice”). The Notice is attached
12 as Exhibit 1.

13 114. The Notice purported to inform MaxLite that Super Lighting was
14 “promoting its patent license program.” This Notice further stated “[t]hrough this
15 program, your company may gain the access to Super Lighting’s technological
16 development” and “[t]he technology in this license program believably shall benefit
17 you and increase the value of your products. Please consider to apply for this
18 license program and to join Super Lighting in offering better and more advanced
19 products to the customers.”

20 115. Although the Notice also stated that Super Lighting “does not tolerate
21 any trespassing to its technology and will not hesitate to take any legal action in
22 order to protect its rights and benefits on the technology,” the Notice did not
23 mention MaxLite’s products, or accuse any MaxLite product of infringing any of
24 Super Lighting’s patents, including the Patents-in-Suit.

25 116. The Notice attached a “PowerPoint introduction of Super Lighting’s
26 patent license program” (“the PowerPoint”). The PowerPoint is attached as Exhibit
27 2.

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1 117. The PowerPoint identified more than 60 U.S. patents and
2 approximately 14 U.S. patent publications.

3 118. The PowerPoint generically claimed that these patents are related to
4 “Tube LEDs,” but provided no information regarding how each of these patents
5 and publications are related to Tube LEDs, what types of Tube LEDs are covered
6 by each of these patents and publications, or how any claim of any patent or
7 publication should be read on any product, including any MaxLite product.

8 119. The PowerPoint did not identify MaxLite by name, nor did the
9 PowerPoint identify or accuse any MaxLite product of infringing any of Super
10 Lighting’s patents, including the Patents-in-Suit.

11 120. The PowerPoint included slides on claims 18 and 28 of the ‘174
12 patent, highlighting certain terms, but did not include any information regarding
13 how these terms should be read on any product, including any MaxLite product.

14 121. Upon information and belief, the Notice and the PowerPoint are the
15 “letter” and “associated presentation” identified by Super Lighting in Paragraph 16
16 of the Complaint.

17 122. To the extent that Paragraph 16 of the Complaint alleges that the
18 Notice provided “specific features and functionality of” MaxLite’s products “that
19 practice the Patents-in-Suit,” such allegation is not true.

20 123. To the extent Paragraph 16 of the Complaint alleges that the
21 PowerPoint included information regarding the MaxLite products “covered by
22 Super Lighting’s patents,” such allegation is not true.

23 124. On December 5, 2018, in response to a number of emails from
24 MaxLite’s General Counsel, Super Lighting responded by email to MaxLite’s
25 General Counsel (“the December 5 Email”). The December 5 Email is attached as
26 Exhibit 3.

27 125. Upon information and belief, the December 5 Email is the
28 correspondence identified by Super Lighting in Paragraph 17 of the Complaint.

1 126. The December 5 Email includes a generic claim that Super Lighting
2 “also discovered several products sold on your [MaxLite’s] brand infringe Super
3 Lighting’s patents.”

4 127. The December 5 Email did not identify any specific Super Lighting
5 Patent, did not identify any specific MaxLite product, and did not include any
6 information regarding how any patent claim should be read on any MaxLite
7 Product.

8 128. Further, Super Lighting’s December 5 Email conceded that “it might
9 be difficult for MaxLite to identify infringement.”

10 129. Finally, in the December 5 Email, Super Lighting told MaxLite that its
11 “team will assist you in determining whether the products MaxLite purchases from
12 other companies infringe Super Lighting’s patents.”

13 130. The December 5 Email did not offer “to further explain to MaxLite the
14 bases for Super Lighting’s infringement allegations” as alleged in Paragraph 17 of
15 the Complaint.

16 131. On January 15, 2019, MaxLite’s General Counsel emailed Super
17 Lighting, informing Super Lighting that MaxLite’s manufacturer of LED tube
18 lights has “several non-infringement opinions on this technology.” This email
19 further requested a claim chart from Super Lighting, because “without it, it is
20 difficult to assess any alleged infringement claims.”

21 132. On January 18, 2019, Super Lighting again emailed MaxLite’s
22 General Counsel (“the January 18 Email”). The January 18 Email and its four
23 attachments are attached as Exhibit 4.

24 133. Upon information and belief, the January 18 Email is the
25 correspondence identified by Super Lighting in Paragraph 18 of the Complaint.

26 134. The January 18 Email identified MaxLite’s L11.5T8DE440-CG4 as
27 “covered by our patents, for example US Pat. Nos. 9,897,265 and 9,497,821,” and
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1 identified MaxLite’s L25T5DF450-CG4 as “covered by our patents, for example,
2 US Pat. No. 9,723,662.”

3 135. The January 18 Email attached an analysis by Super Lighting of
4 “MaxLite’s LED tube model L25T5DF450-CG4 in view of our ‘662 patent” and
5 “MaxLite’s LED tube model L11.5T8DE440-CG4 in view of our ‘821 Patent.”

6 136. U.S. Patent No. 9,497,821 is not asserted in this action.

7 137. To the extent Paragraph 18 of the Complaint alleges that the January
8 18 Email “provided infringement charts” regarding the ‘265 Patent, such allegation
9 is not true.

10 138. On February 12, 2019, MaxLite’s General Counsel again emailed
11 Super Lighting, indicating that MaxLite has “been trying to obtain additional
12 technical information from our other vendor but have been delayed because of the
13 [Chinese New Year] holiday.

14 139. This email further expressed a willingness to have a meeting date and
15 stated that “[w]e think it is important to have complete information before we
16 meet.”

17 140. On February 14, 2019, Super Lighting emailed MaxLite’s General
18 Counsel (“the February 14 Email”). The February 14 Email is attached as Exhibit
19 5.

20 141. Upon information and belief, the February 14 Email is the
21 correspondence identified by Super Lighting in Paragraph 19 of the Complaint.

22 142. The February 14 Email identifies a handful of Super Lighting patents,
23 including the ‘662 Patent, the ‘174 Patent, the ‘265 Patent, and the ‘536 Patent, and
24 states that Super Lighting “believe[s] based on our initial analyses some of
25 MaxLite’s products may also infringe the claims of these patents for example,
26 L11.5T8DE440-CG4, L12T8DE340-CG4 and L25T5DF450-CG4. We will forward
27 you our analyses once available.”
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1 143. The February 19 Email does not “further indicate to MaxLite that
2 MaxLite was infringing the ‘174, 265, and ‘662 Patents” nor does it “specifically
3 identif[y] to MaxLite that it was additionally infringing the ‘536 Patent” as alleged
4 by Paragraph 19 of the Complaint.

5 144. The February 19 Email rather claims that MaxLite’s products “*may*
6 also infringe the claims of these patents” (emphasis added) and promised Super
7 Lighting’s analysis, once available.

8 145. Super Lighting never provided the analysis promised in the February
9 14 Email.

10 146. MaxLite did not hear from Super Lighting again between the February
11 14 Email and the initiation of this action regarding the Patents-in-Suit or any
12 potential infringement by MaxLite.

13 147. MaxLite did not “subsequently refuse[] to engage in meetings to
14 resolve the issues raised by Super Lighting” or “ignor[e] additional request for
15 meetings” as alleged in Paragraph 20 of the Complaint, as no requests for meetings
16 were made by Super Lighting subsequent to the February 14 Email.

17 **Count I**

18 **(Declaratory Judgment of Non-Infringement of the ‘536 Patent)**

19 148. MaxLite incorporates the allegations in Paragraphs 1-105 of the
20 Answer and Affirmative Defenses above, and Paragraphs 106-147 of these
21 Counterclaims as if fully set forth herein.

22 149. An actual controversy exists between MaxLite and Counterclaim
23 Defendants as to MaxLite’s alleged infringement of the ‘536 Patent.

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1 150. MaxLite has not infringed and does not infringe any valid and
2 enforceable claim of the ‘536 Patent. For example, according to the diagrams in
3 Exhibit 11 of the Complaint, MaxLite’s LED Tube L11.5T8DE440-CG4 does not
4 meet the “installation detection module, coupled to the power loop and configured
5 to generate a control signal having at least one pulse and to temporarily cause a
6 current to be conducted in a detection path during the pulse-on time of the control
7 signal for detecting an installation state between the LED tube lamp and a lamp
8 socket” limitation of claim 1 of the ‘536 Patent.

9 151. MaxLite has not and does not willfully infringe the ‘536 Patent. Prior
10 to the filing of the complaint in this action, MaxLite had no rational basis to believe
11 that its importation, use, offers for sale, or sales of its L11.5T8DE440-CG4 product
12 infringed the ‘536 Patent. For example, MaxLite is not the manufacturer or
13 designer of the L11.5T8DE440-CG4 product, nor is it the manufacturer or designer
14 of any of the circuitry contained in that product. The information required to form
15 a belief as to infringement of the L11.5T8DE440-CG4 product, by the ‘536 Patent
16 was not in MaxLite’s hands prior the filing of this lawsuit. MaxLite asked Super
17 Lighting for a claim chart for any alleged infringing activities. Super Lighting
18 informed MaxLite that it would provide analysis of any potential infringement to
19 MaxLite regarding the L11.5T8DE440-CG4 product and the ‘536 Patent. Super
20 Lighting never provided any such analysis. Therefore, MaxLite had a legitimate
21 basis to believe that its L11.5T8DE440-CG4 product did not infringe the ‘536
22 Patent prior to the filing of the Complaint. Further, MaxLite’s activities prior to the
23 lawsuit—asking Super Lighting for a claim chart and waiting for infringement
24 analysis that was promised by Super Lighting—were reasonable and in no way
25 egregious. Without pre-suit willful infringement, Super Lighting is not entitled to a
26 finding of willful infringement in this action.

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1 152. MaxLite's conduct was not egregious and therefore does not warrant
2 enhanced damages. MaxLite's response to any alleged infringement allegations
3 was reasonable conduct and does not warrant enhanced damages. MaxLite's
4 response to Super Lighting's allegations of infringement, to the extent they exist,
5 was to seek claim charts so that MaxLite could assess those allegations. MaxLite
6 also sought additional information from a vendor who supplies the products
7 accused of infringement and suggested having a meeting with Super Lighting once
8 MaxLite had complete information regarding Super Lighting's infringement
9 allegations. Similarly, MaxLite's subsequent communications with Super Lighting
10 were reasonable conduct, and do not warrant enhanced damages. MaxLite kept
11 Super Lighting apprised of the information it required in order to evaluate for itself
12 whether it infringed any of Super Lighting's patents, requested that information
13 from Super Lighting, and suggested having a meeting with Super Lighting.
14 MaxLite's response to Super Lighting's licensing offer was reasonable conduct and
15 does not warrant enhanced damages. MaxLite believed the licensing offer was
16 given to MaxLite by mistake and reached out to Super Lighting by email for
17 clarification. MaxLite then engaged in the conduct described in this paragraph.

18 153. To resolve the legal and factual questions raised by Counterclaim
19 Defendants, and to afford relief from the uncertainty and controversy that
20 Counterclaim Defendants' accusations have precipitated, MaxLite is entitled to a
21 declaratory judgment that MaxLite has not and does not infringe any valid and
22 enforceable claim of the '536 Patent, and that any alleged infringement is not
23 deliberate, willful or exceptional and does not warrant an award of treble damages
24 pursuant to 35 U.S.C. § 284 and attorneys' fees pursuant to 35 U.S.C. § 285.

25 154. Further, Counterclaim Defendants baseless allegations of willful
26 infringement of the '536 Patent, including those in Paragraph 29 of the Complaint,
27 are exceptional and warrant an award of attorneys' fees pursuant to 35 U.S.C. §
28 285.

Count II

(Declaratory Judgment of Non-Infringement of the ‘174 Patent)

155. MaxLite incorporates the allegations in Paragraphs 1-105 of the Answer and Affirmative Defenses above, and Paragraphs 106-154 of these Counterclaims as if fully set forth herein.

156. An actual controversy exists between MaxLite and Counterclaim Defendants as to MaxLite’s alleged infringement of the ‘174 Patent.

157. MaxLite has not infringed and does not infringe any valid and enforceable claim of the ‘174 Patent. For example, according to the diagrams in Exhibits 12 and 13 of the Complaint, MaxLite’s LED Tube L11.5T8DE440-CG4 does not meet at least the “receiving the pulse signal by a switch circuit coupled on a power loop of the LED tube lamp, wherein the switch circuit is conducted during a pulse-on period of the pulse signal to cause the power loop to be conductive” limitation of claim 18 of the ‘174 Patent, or at least the “installation detection module, coupled on a power loop of the LED tube lamp and configured to generate a pulse signal for controlling a conduction state of the power loop and detect a sampling signal on the power loop during a pulse-on time of the pulse signal” limitation of claim 28 of the ‘174 Patent.

158. MaxLite has not and does not willfully infringe the ‘174 Patent. Prior to the filing of the complaint in this action, MaxLite had no rational basis to believe that its importation, use, offers for sale, or sales of its L11.5T8DE440-CG4 product infringed the ‘174 Patent. For example, MaxLite is not the manufacturer or designer of the L11.5T8DE440-CG4 product, nor is it the manufacturer or designer of any of the circuitry contained in that product. The information required to form a belief as to infringement of the L11.5T8DE440-CG4 product, by the ‘174 Patent was not in MaxLite’s hands prior to the filing of the lawsuit. MaxLite asked Super Lighting for a claim chart for any alleged infringing activities. Super Lighting informed MaxLite that it would provide analysis of any potential infringement to

1 MaxLite regarding the L11.5T8DE440-CG4 product and the ‘174 Patent. Super
2 Lighting never provided any such analysis. Therefore, MaxLite had a legitimate
3 basis to believe that its L11.5T8DE440-CG4 product did not infringe the ‘174
4 Patent prior to the filing of the Complaint. Further, MaxLite’s activities prior to the
5 lawsuit—asking Super Lighting for a claim chart and waiting for infringement
6 analysis that was promised by Super Lighting—were reasonable and in no way
7 egregious. Without pre-suit willful infringement, Super Lighting is not entitled to a
8 finding of willful infringement in this action.

9 159. MaxLite’s conduct was not egregious and therefore does not warrant
10 enhanced damages. MaxLite’s response to any alleged infringement allegations
11 was reasonable conduct and does not warrant enhanced damages. MaxLite’s
12 response to Super Lighting’s allegations of infringement, to the extent they exist,
13 was to seek claim charts so that MaxLite could assess those allegations. MaxLite
14 also sought additional information from a vendor who supplies the products
15 accused of infringement and suggested having a meeting with Super Lighting once
16 MaxLite had complete information regarding Super Lighting’s infringement
17 allegations. Similarly, MaxLite’s subsequent communications with Super Lighting
18 were reasonable conduct, and do not warrant enhanced damages. MaxLite kept
19 Super Lighting apprised of the information it required in order to evaluate for itself
20 whether it infringed any of Super Lighting’s patents, requested that information
21 from Super Lighting, and suggested having a meeting with Super Lighting.
22 MaxLite’s response to Super Lighting’s licensing offer was reasonable conduct and
23 does not warrant enhanced damages. MaxLite believed the licensing offer was
24 given to MaxLite by mistake and reached out to Super Lighting by email for
25 clarification. MaxLite then engaged in the conduct described in this paragraph.

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1 165. MaxLite has not infringed and does not infringe any valid and
2 enforceable claim of the '662 Patent. For example, according to the diagrams in
3 Exhibits 14 and 15 of the Complaint, MaxLite's LED Tube L13T8DF440-CG4 and
4 MaxLite's LED Tube L25T5DF450-CG4 do not meet at least the "a filament-
5 simulating circuit electrically connected to a first bi-pin terminal and a second bi-
6 pin terminal of the LED lamp, each of the first and the second bi-pin terminals
7 having a current flowing from one pin to the other pin of the respective bi-pin
8 terminal via the filament-simulating circuit during a pre-head process executed by a
9 ballast" limitation of claim 23 of the '662 Patent.

10 166. MaxLite's conduct was not egregious and therefore does not warrant
11 enhanced damages. MaxLite's response to any alleged infringement allegations
12 was reasonable conduct and does not warrant enhanced damages. MaxLite's
13 response to Super Lighting's allegations of infringement, to the extent they exist,
14 was to seek claim charts so that MaxLite could assess those allegations. MaxLite
15 also sought additional information from a vendor who supplies the products
16 accused of infringement and suggested having a meeting with Super Lighting once
17 MaxLite had complete information regarding Super Lighting's infringement
18 allegations. Similarly, MaxLite's subsequent communications with Super Lighting
19 were reasonable conduct, and do not warrant enhanced damages. MaxLite kept
20 Super Lighting apprised of the information it required in order to evaluate for itself
21 whether it infringed any of Super Lighting's patents, requested that information
22 from Super Lighting, and suggested having a meeting with Super Lighting.
23 MaxLite's response to Super Lighting's licensing offer was reasonable conduct and
24 does not warrant enhanced damages. MaxLite believed the licensing offer was
25 given to MaxLite by mistake and reached out to Super Lighting by email for
26 clarification. MaxLite then engaged in the conduct described in this paragraph.

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1 and generates the installation detection result” limitation of claim 1 of the ‘897
2 Patent.

3 171. MaxLite has not and does not willfully infringe the ‘897 Patent. Prior
4 to the filing of the complaint in this action, MaxLite had no rational basis to believe
5 that its importation, use, offers for sale, or sales of its L11.5T8DE440-CG4 product
6 or L25T5DF450-CG4 infringed the ‘897 Patent. For example, MaxLite is not the
7 manufacturer or designer of the L11.5T8DE440-CG4 product or the L25T5DF450-
8 CG4 product, nor is it the manufacturer or designer of any of the circuitry
9 contained in those products. The information required to form a belief as to
10 infringement of the L11.5T8DE440-CG4 and L25T5DF450-CG4 product, by the
11 ‘897 Patent, was not in MaxLite’s hands prior to the filing of this lawsuit. MaxLite
12 asked Super Lighting for a claim chart for any alleged infringing activities. Super
13 Lighting never informed MaxLite that it may be infringing the ‘897 Patent in any
14 manner. Further, Super Lighting informed MaxLite that it would provide analysis
15 of any potential infringement to MaxLite regarding the L11.5T8DE440-CG4
16 product and the L25T5DF450-CG4 product. Super Lighting never provided any
17 such analysis. Therefore, MaxLite had a legitimate basis to believe that its
18 L11.5T8DE440-CG4 product and L25T5DF450-CG4 product did not infringe the
19 ‘897 Patent prior to the filing of the Complaint. Indeed, the ‘897 Patent did not
20 issue until February 19, 2019, after Super Lighting stopped communicating with
21 MaxLite. Further, MaxLite’s activities prior to the lawsuit—asking Super Lighting
22 for a claim chart and waiting for infringement analysis that was promised by Super
23 Lighting—were reasonable and in no way egregious. Without pre-suit willful
24 infringement, Super Lighting is not entitled to a finding of willful infringement in
25 this action.

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1 172. MaxLite's conduct was not egregious and therefore does not warrant
2 enhanced damages. MaxLite's response to any alleged infringement allegations
3 was reasonable conduct and does not warrant enhanced damages. MaxLite's
4 response to Super Lighting's allegations of infringement, to the extent they exist,
5 was to seek claim charts so that MaxLite could assess those allegations. MaxLite
6 also sought additional information from a vendor who supplies the products
7 accused of infringement and suggested having a meeting with Super Lighting once
8 MaxLite had complete information regarding Super Lighting's infringement
9 allegations. Similarly, MaxLite's subsequent communications with Super Lighting
10 were reasonable conduct, and do not warrant enhanced damages. MaxLite kept
11 Super Lighting apprised of the information it required in order to evaluate for itself
12 whether it infringed any of Super Lighting's patents, requested that information
13 from Super Lighting, and suggested having a meeting with Super Lighting.
14 MaxLite's response to Super Lighting's licensing offer was reasonable conduct and
15 does not warrant enhanced damages. MaxLite believed the licensing offer was
16 given to MaxLite by mistake and reached out to Super Lighting by email for
17 clarification. MaxLite then engaged in the conduct described in this paragraph.

18 173. To resolve the legal and factual questions raised by Counterclaim
19 Defendants, and to afford relief from the uncertainty and controversy that
20 Counterclaim Defendants' accusations have precipitated, MaxLite is entitled to a
21 declaratory judgment that MaxLite has not and does not infringe any valid and
22 enforceable claim of the '897 Patent, and that any alleged infringement is not
23 deliberate, willful or exceptional and does not warrant an award of treble damages
24 pursuant to 35 U.S.C. § 284 and attorneys' fees pursuant to 35 U.S.C. § 285.

25 174. Further, Counterclaim Defendants baseless allegations of willful
26 infringement of the '897 Patent, including those in Paragraph 51 of the Complaint,
27 are exceptional and warrant an award of attorneys' fees pursuant to 35 U.S.C. §
28 285.

Count V

(Declaratory Judgment of Non-Infringement of the ‘826 Patent)

175. MaxLite incorporates the allegations in Paragraphs 1-105 of the Answer and Affirmative Defenses above, and Paragraphs 106-174 of these Counterclaims as if fully set forth herein.

176. An actual controversy exists between MaxLite and Counterclaim Defendants as to MaxLite’s alleged infringement of the ‘826 Patent.

177. MaxLite has not infringed and does not infringe any valid and enforceable claim of the ‘826 Patent. For example, according to the diagrams in Exhibit 19 of the Complaint, MaxLite’s LED Tube 12T8AB440-CG does not meet at least the “mode switching circuit, coupled to the filter circuit and the driving circuit, configured to determine whether to perform a first driving mode or a second driving mode based on the first determined result signal” limitation of claim 1 of the ‘826 Patent.

178. MaxLite has not and does not willfully infringe the ‘826 Patent. Prior to the filing of the complaint in this action, MaxLite had no rational basis to believe that its importation, use, offers for sale, or sales of its 12T8AB440-CG product infringed the ‘826 Patent. For example, MaxLite is not the manufacturer or designer of the 12T8AB440-CG product, nor is it the manufacturer or designer of any of the circuitry contained in those products. The information required to form a belief as to infringement of the 12T8AB440-CG product, by the ‘826 Patent, was not in MaxLite’s hands prior to the filing of this lawsuit. MaxLite asked Super Lighting for a claim chart for any alleged infringing activities. Super Lighting never informed MaxLite that it may be infringing the ‘826 Patent in any manner. Super Lighting also never identified the 12T8AB440-CG product as potentially infringing any of Super Lighting’s patents. Therefore, as Super Lighting had identified other potential infringing products and other potential patents that were infringed, but never the ‘826 Patent or the 12T8AB440-CG product, MaxLite had a

1 legitimate basis to believe that its 12T8AB440-CG product did not infringe the
2 ‘826 Patent prior to the filing of the Complaint. Further, MaxLite’s activities prior
3 to the lawsuit—asking Super Lighting for a claim chart and waiting for
4 infringement analysis that was promised by Super Lighting—were perfectly
5 reasonable and in no way egregious. Without pre-suit willful infringement, Super
6 Lighting is not entitled to a finding of willful infringement in this action.

7 179. MaxLite’s conduct was not egregious and therefore does not warrant
8 enhanced damages. MaxLite’s response to any alleged infringement allegations
9 was reasonable conduct and does not warrant enhanced damages. MaxLite’s
10 response to Super Lighting’s allegations of infringement, to the extent they exist,
11 was to seek claim charts so that MaxLite could assess those allegations. MaxLite
12 also sought additional information from a vendor who supplies the products
13 accused of infringement and suggested having a meeting with Super Lighting once
14 MaxLite had complete information regarding Super Lighting’s infringement
15 allegations. Similarly, MaxLite’s subsequent communications with Super Lighting
16 were reasonable conduct, and do not warrant enhanced damages. MaxLite kept
17 Super Lighting apprised of the information it required in order to evaluate for itself
18 whether it infringed any of Super Lighting’s patents, requested that information
19 from Super Lighting, and suggested having a meeting with Super Lighting.

20 MaxLite’s response to Super Lighting’s licensing offer was reasonable conduct and
21 does not warrant enhanced damages. MaxLite believed the licensing offer was
22 given to MaxLite by mistake and reached out to Super Lighting by email for
23 clarification. MaxLite then engaged in the conduct described in this paragraph.

24 180. To resolve the legal and factual questions raised by Counterclaim
25 Defendants, and to afford relief from the uncertainty and controversy that
26 Counterclaim Defendants’ accusations have precipitated, MaxLite is entitled to a
27 declaratory judgment that MaxLite has not and does not infringe any valid and
28 enforceable claim of the ‘826 Patent, and that any alleged infringement is not

1 deliberate, willful or exceptional and does not warrant an award of treble damages
2 pursuant to 35 U.S.C. § 284 and attorneys’ fees pursuant to 35 U.S.C. § 285.

3 181. Further, Counterclaim Defendants baseless allegations of willful
4 infringement of the ‘826 Patent, including those in Paragraph 58 of the Complaint,
5 are exceptional and warrant an award of attorneys’ fees pursuant to 35 U.S.C. §
6 285.

7 **Count VI**

8 **(Declaratory Judgment of Non-Infringement of the ‘265 Patent)**

9 182. MaxLite incorporates the allegations in Paragraphs 1-105 of the
10 Answer and Affirmative Defenses above, and Paragraphs 106-181 of these
11 Counterclaims as if fully set forth herein.

12 183. An actual controversy exists between MaxLite and Counterclaim
13 Defendants as to MaxLite’s alleged infringement of the ‘265 Patent.

14 184. MaxLite has not infringed and does not infringe any valid and
15 enforceable claim of the ‘265 Patent. For example, according to the diagrams in
16 Exhibits 20 and 21 of the Complaint, MaxLite’s LED Tube U15.5T8SE240 product
17 and MaxLite’s LED Tube L11.5T8DE440-CG4 product do not meet the
18 “reinforcing portion...the reinforcing portion includes a platform and a bracing
19 structure; the bracing structure is fixedly connected to the platform and holds the
20 platform in place” limitation of claims 1, 2, and 3 of the ‘265 Patent. For further
21 example, according to the reverse engineering depicted in Exhibit 20 and 21 of the
22 Complaint, MaxLite’s LED Tube U15.5T8SE240 product and MaxLite’s LED
23 Tube L11.5T8DE440-CG4 product do not meet the “a reinforcing portion, the
24 reinforcing portion comprises a platform, and the light strip is disposed on the
25 platform” limitation of claims 15, 19, and 22 of the ‘265 Patent. Super Lighting in
26 Exhibits 20 and 21 of the Complaint reads the “light strip,” “reinforcing portion,”
27 “platform” and “bracing structure” limitations all on the flexible light strip of
28 MaxLite’s LED Tube U15.5T8SE240 product and MaxLite’s LED Tube

1 L11.5T8DE440-CG4 product. No reasonable interpretation of the “light strip,”
2 “reinforcing portion,” “platform” and “bracing structure” limitations would allow
3 these limitations to be read on MaxLite’s LED Tube U15.5T8SE240 product and
4 MaxLite’s LED Tube L11.5T8DE440-CG4 product as Super Lighting does in
5 Exhibits 20 and 21.

6 185. MaxLite has not and does not willfully infringe the ‘265 Patent. Prior
7 to the filing of the complaint in this action, MaxLite had no rational basis to believe
8 that its importation, use, offers for sale, or sales of its L11.5T8DE440-CG4 product
9 or U15.5T8SE240 product infringed the ‘265 Patent. For example, MaxLite is not
10 the manufacturer or designer of the L11.5T8DE440-CG4 product or the
11 U15.5T8SE240 product, nor is it the manufacturer or designer of any of the
12 circuitry contained in those products. The information required to form a belief as
13 to infringement of the L11.5T8DE440-CG4 and U15.5T8SE240 product, by the
14 ‘265 Patent, was not in MaxLite’s hands prior to the filing of this lawsuit. MaxLite
15 asked Super Lighting for a claim chart for any alleged infringing activities. Super
16 Lighting informed MaxLite that it would provide analysis of any potential
17 infringement to MaxLite regarding the L11.5T8DE440-CG4 product and the ‘265
18 Patent. Super Lighting never provided any such analysis. Further, Super Lighting
19 never identified the U15.5T8SE240 product as potentially infringing any of Super
20 Lighting’s patents, including the ‘265 Patent. Therefore, MaxLite had a legitimate
21 basis to believe that its L11.5T8DE440-CG4 product and U15.5T8SE240 product
22 did not infringe the ‘265 Patent prior to the filing of the Complaint. Further,
23 MaxLite’s activities prior to the lawsuit—asking Super Lighting for a claim chart
24 and waiting for infringement analysis that was promised by Super Lighting—were
25 reasonable and in no way egregious. Without pre-suit willful infringement, Super
26 Lighting is not entitled to a finding of willful infringement in this action.

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1 186. MaxLite's conduct was not egregious and therefore does not warrant
2 enhanced damages. MaxLite's response to any alleged infringement allegations
3 was reasonable conduct and does not warrant enhanced damages. MaxLite's
4 response to Super Lighting's allegations of infringement, to the extent they exist,
5 was to seek claim charts so that MaxLite could assess those allegations. MaxLite
6 also sought additional information from a vendor who supplies the products
7 accused of infringement and suggested having a meeting with Super Lighting once
8 MaxLite had complete information regarding Super Lighting's infringement
9 allegations. Similarly, MaxLite's subsequent communications with Super Lighting
10 were reasonable conduct, and do not warrant enhanced damages. MaxLite kept
11 Super Lighting apprised of the information it required in order to evaluate for itself
12 whether it infringed any of Super Lighting's patents, requested that information
13 from Super Lighting, and suggested having a meeting with Super Lighting.
14 MaxLite's response to Super Lighting's licensing offer was reasonable conduct and
15 does not warrant enhanced damages. MaxLite believed the licensing offer was
16 given to MaxLite by mistake and reached out to Super Lighting by email for
17 clarification. MaxLite then engaged in the conduct described in this paragraph.

18 187. To resolve the legal and factual questions raised by Counterclaim
19 Defendants, and to afford relief from the uncertainty and controversy that
20 Counterclaim Defendants' accusations have precipitated, MaxLite is entitled to a
21 declaratory judgment that MaxLite has not and does not infringe any valid and
22 enforceable claim of the '265 Patent, and that any alleged infringement is not
23 deliberate, willful or exceptional and does not warrant an award of treble damages
24 pursuant to 35 U.S.C. § 284 and attorneys' fees pursuant to 35 U.S.C. § 285.

25 188. Further, Counterclaim Defendants baseless allegations of infringement
26 of the '265 Patent and willful infringement of the '265 Patent, including those in
27 Paragraph 65 of the Complaint and Exhibits 20 and 21 to the Complaint, are
28 exceptional and warrant an award of attorneys' fees pursuant to 35 U.S.C. § 285.

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Prayer for Relief

WHEREFORE, MaxLite respectfully requests the following relief:

A. A judgment dismissing the Complaint against MaxLite with prejudice and a finding that Counterclaim Defendants take nothing by way of their Complaint;

B. A judgment declaring that MaxLite has not infringed, does not infringe, and has not willfully infringed the ‘536 Patent;

C. A judgment declaring that MaxLite has not infringed, does not infringe, has not induced infringement, and has not willfully infringed the ‘174 Patent;

D. A judgment declaring that MaxLite has not infringed and does not infringe the ‘662 Patent;

E. A judgment declaring that MaxLite has not infringed, does not infringe, and has not willfully infringed the ‘897 Patent;

F. A judgment declaring that MaxLite has not infringed, does not infringe, and has not willfully infringed the ‘826 Patent;

G. A judgment declaring that MaxLite has not infringed, does not infringe, and has not willfully infringed the ‘265 Patent;

H. Costs and expenses in this action;

I. A declaration that this is an exceptional case and an award of attorneys’ fees, disbursements, and costs of this action pursuant to 35 U.S.C. § 285;

J. Such other and further relief as the Court may deem just and proper.

Jury Demand

189. MaxLite demands a jury trial on all issues so triable.

1 Dated: July 12, 2019

Respectfully submitted,

2 /s/ David C. Radulescu

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CERTIFICATE OF SERVICE

I, David C. Radulescu, hereby declare:

I am over the age of eighteen years and not a party to the within action. My business address is 350 Fifth Avenue, Suite 6910, New York, NY 10118.

On July 12, 2019, I caused the following document, described as:

ANSWER TO COMPLAINT AND COUNTERCLAIMS

to be served via CM/ECF, upon all counsel of record registered to receive electronic filing, as indicated on the Court's website.

I declare under penalty of perjury that the above is true and correct.

Executed on July 12, 2019, in New York, NY.

Dated: July 12, 2019

/s/ David C. Radulescu
David C. Radulescu

Attorney for Defendant MaxLite, Inc.