

IN THE UNITED STATES DISTRICT COURT
FOR THE WESTERN DISTRICT OF TEXAS
WACO DIVISION

PROFECTUS TECHNOLOGY LLC,

Plaintiff,

v.

GOOGLE LLC,

Defendant.

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Civil Action No. 6:20-cv-00101

JURY

COMPLAINT FOR PATENT INFRINGEMENT

Plaintiff Profectus Technology LLC, a Texas limited liability company (“Profectus”), by and through its undersigned counsel, brings this action against Google LLC (sometimes referred to herein as “Google” or “Defendant”), and alleges the following:

NATURE OF THE ACTION

1. This is an action under Title 35 of the United States Code for willful infringement of United States Patent No. 6,975,308 (“the ’308 Patent”) based on Defendant Google’s unauthorized manufacture, use, importation, offers for sale, and/or sales of infringing products, including but not limited to the Google Nest Hub (also known as the “Google Home Hub”) and the Google Nest Hub Max (collectively, the “the Accused Products” or the “Nest Hubs”), in the United States of America.

THE PARTIES

2. Plaintiff Profectus is a Texas limited liability company.

3. Defendant Google is a Delaware limited liability company with a principal place of business located at 1600 Amphitheatre Parkway, Mountain View, California 94043. Google may

be served with process through its registered agent, the Corporation Service Company d/b/a CSC – Lawyers Incorporating Service Company, 211 East 7th Street, Suite 620, Austin, Texas 78701. On information and belief, Google is registered to do business in the State of Texas and has been since at least November 2006.

JURISDICTION AND VENUE

4. This is an action for patent infringement arising under the patent laws of the United States of America, Title 35 of the United States Code.

5. This Court has subject matter jurisdiction over Plaintiff's claims pursuant to 28 U.S.C. §§ 1331 and 1338(a), as they are substantial claims arising under the patent laws of the United States, Title 35 of the United States Code.

6. This Court has personal jurisdiction over Google because (i) Google maintains one or more permanent places of business within the Western District of Texas, including at 500 West 2nd Street, Austin, Texas 78701; (ii) Google regularly solicits business, engages in other persistent courses of conduct, and derives revenue from goods and services provided to businesses and individuals within the Western District of Texas; and (iii) Google has committed, and has actively induced others to commit, acts of infringement within the State of Texas and this judicial district by, *inter alia*, offering to sell, selling, and actively inducing people to use the infringing Google Nest Hubs within the Western District of Texas.

7. Venue is proper in this judicial district under 28 U.S.C. § 1400(b) because Google has a regular and established place of business in the Western District of Texas and has committed, and/or induced others to commit, acts of patent infringement within the Western District of Texas. Google has a regular and established place of business within the Western District of Texas at 500 West 2nd Street, Austin, Texas 78701. Upon information and belief, Google has over 1,100

employees in the Western District of Texas. Google has leased and will entirely occupy a 35-story office building in downtown Austin, Texas at West Cesar Chavez and Nueces streets. In addition, Google has committed, and has actively induced others to commit, acts of infringement within this judicial district by, *inter alia*, offering to sell, selling, and actively inducing people to use the infringing Google Nest Hubs within the Western District of Texas.

THE PATENT-IN-SUIT

8. On December 13, 2005, the United States Patent and Trademark Office (“USPTO”) duly and legally issued the ’308 Patent, entitled “Digital Picture Display Frame,” after full and fair examination. A true and correct copy of the ’308 Patent is attached to this complaint as **Exhibit A** and is incorporated herein for all purposes.

9. The USPTO issued the ’308 Patent to Frank W. Bitetto and James J. Bitetto, the joint inventors of the inventions claimed in the ’308 Patent. Frank W. Bitetto and James J. Bitetto are the sole members and owners of Profectus.

10. On or about September 9, 2011, Frank W. Bitetto and James J. Bitetto validly assigned their entire right, title and interest in and to the ’308 Patent to Profectus. The assignment was duly recorded at reel 027246, frame 0136 of the patent assignment records of the USPTO on or about November 17, 2011.

11. Profectus is therefore the assignee of all rights, title, and interest in and to the ’308 Patent and possess all rights of recovery under the ’308 Patent, including the right to recover damages for past infringement.

12. The ’308 Patent and all claims of the ’308 Patent are presumed valid under 35 U.S.C. § 282.

13. The claims of the '308 Patent have been construed by a federal district court in connection with previous litigation against other parties. *See* Memorandum Opinion and Order (Doc. 320), *Profectus Technology LLC v. Huawei Technologies Co. Ltd.*, Case No. 6:11-CV-474 (E.D. Tex. Apr. 17, 2014) (the “*Huawei*” case). The United States Court of Appeals for the Federal Circuit affirmed the district court’s ruling on appeal. *Profectus Tech. LLC v. Huawei Techs. Co.*, 823 F.3d 1375 (Fed. Cir. 2016).

14. Profectus accused Motorola Mobility LLC (formerly known as Motorola Mobility Inc.) of infringement of the '308 Patent in *Profectus Technology LLC v. Motorola Mobility LLC*, Case No. 6:11-CV-674 (E.D. Tex) (the “*Motorola Mobility*” case), which was filed on December 16, 2011.

15. Profectus served Motorola Mobility, Inc. with a complaint alleging infringement of the '308 Patent in the *Motorola Mobility* case on April 16, 2012.

16. Effective on May 22, 2012, Google acquired one hundred percent (100%) of the ownership of Motorola Mobility, Inc.

17. Google became a “privy” of Motorola Mobility, Inc. for purposes of 35 U.S.C. § 315(b) when it acquired one hundred percent of Motorola Mobility, Inc.

18. As a privy of Motorola Mobility, Inc., Google is barred from seeking *inter partes* review of the '308 Patent under 35 U.S.C. § 315(b).

19. On June 22, 2012, Motorola Mobility, Inc. changed its name to Motorola Mobility LLC.

20. On September 26, 2012, the *Motorola Mobility* case and the *Huawei* case were consolidated, with the *Huawei* case being the lead case.

21. Google has had actual knowledge of the '308 Patent since at least as early as May 22, 2012.

22. The claims of the '308 Patent are understandable to a person of ordinary skill in the art who has the requisite education, training, and experience with the technology at issue in this action.

DEFENDANT GOOGLE AND THE ACCUSED PRODUCT

23. Without authorization from Profectus, Google makes, uses (including by testing), offers to sell, and sells within the United States, and imports into the United States, a digital picture display frame—the Google Nest Hub and Google Nest Hub Max.

24. Google has previously marketed the Google Nest Hub as the Google Home Hub.

25. Google is not, now or at any time, licensed under the '308 Patent.

26. Google infringes at least claims 1, 2, 3, 4, 5, 6, 7, 8, 9, 12, 29, and 30 of the '308 Patent, literally and/or under the doctrine of equivalents.

27. Further, customers of Google who purchase the Accused Products directly infringe at least claims 1, 2, 3, 4, 5, 6, 7, 8, 9, 12, 29, and 30 of the '308 Patent, literally and/or under the doctrine of equivalents, by using the Accused Products per instructions provided by Defendant Google.

DEFENDANT'S WILLFULNESS

28. Google has had actual knowledge of the '308 Patent and the scope of its claims since at least as early as May 2012, when it acquired Motorola Mobility, Inc. during the pendency of the *Motorola Mobility* case.

29. Moreover, Profectus placed Google on actual notice of its infringement of the '308 Patent by a letter dated March 8, 2019, and addressed to Google's General Counsel, at Google's

principal place of business, 1600 Amphitheater Parkway, Mountain View, California 94043 (the “Notice Letter”). A true and correct copy of the Notice Letter (without enclosures) is attached hereto as **Exhibit B** and is incorporated herein for all purposes.

30. A true and correct copy of the proof of delivery of the Notice Letter (with signature redacted), delivered May 11, 2019, is attached hereto as **Exhibit C** and is incorporated herein for all purposes.

31. Google has had actual knowledge of the ’308 Patent and Profectus’s allegations of infringement since at least as early as May 11, 2019, when the Notice Letter was delivered to Google’s General Counsel.

32. Google never provided a substantive response to the Notice Letter.

33. After receipt of the Notice Letter, Google continued to make, use (including by testing), offer to sell, and sell within the United States, and import into the United States, the infringing Google Nest Hub in conscious disregard of Profectus’s rights.

34. In addition, after receipt of the Notice Letter, Google introduced the Google Nest Hub Max and began to make, use (including by testing), offer to sell, and sell within the United States, and import into the United States, the infringing Google Nest Hub Max in conscious disregard of Profectus’s rights.

35. Despite its actual knowledge of the ’308 Patent and Profectus’s allegations of infringement, Google has continued to make, use (including by testing), offer to sell, and sell within the United States, and import into the United States, the Accused Products.

36. Google’s infringement of the ’308 Patent has been, and continues to be, willful and in conscious disregard of Profectus’s rights.

37. For the reasons set out herein, Google's conduct in infringing the '308 Patent has been willful, wanton, malicious, in bad faith, deliberate, consciously wrongful, and flagrant, and characteristic of a pirate.

38. Google had actual knowledge of the '308 Patent before it developed and released the Accused Devices, which were released on or after October 22, 2018.

COUNT I
DIRECT PATENT INFRINGEMENT

39. Profectus incorporates by reference the paragraphs above as if fully set forth herein.

40. Without license or authorization and in violation of 35 U.S.C. § 271(a), Google infringes one or more claims of the '308 Patent in this judicial district and throughout the United States, literally and/or under the doctrine of equivalents.

41. Google directly infringes at least claims 1, 2, 3, 4, 5, 6, 7, 8, 9, 12, 29, and 30 of the '308 Patent in violation of 35 U.S.C. § 271(a) by, among other things, making, using (including by testing), offering for sale, and selling within the United States, and importing into the United States, the Accused Products.

42. Google's direct infringement of the '308 Patent is further demonstrated by the claim chart for claim 1 attached hereto as **Exhibit D**, which are incorporated herein for all purposes.

43. Similarly, Google infringes claim 2, 3, 4, 5, 6, 7, 8, 9, 12, 29, and 30 of the '308 Patent under a similar analysis as that propounded in **Exhibit D**.

44. Profectus reserves the right to modify its infringement theories as discovery progresses in this case, and it shall not be estopped for infringement contention or claim construction purposes by the claim charts it is providing with this complaint. The claim charts are intended to satisfy the notice requirements of Rule 8(a)(2) of the Federal Rules of Civil Procedure.

The claim charts are not Plaintiff Profectus's preliminary or final infringement contentions or preliminary or final claim construction positions.

45. Since at least as early as October 22 2018 (or the release date of the Accused Products), or alternatively, at least as early as May 11, 2019, Google has known that its Accused Products infringe one or more claims of the '308 Patent.

46. Google's acts of infringement have been, and continue to be, willful, deliberate, and in conscious disregard of Plaintiff's rights, as shown, at least in part, by Google's refusal to substantively respond to the Notice Letter, and by Google's refusal to discontinue infringing the '308 Patent despite actual knowledge that the Accused Devices infringe one or more claims of the '308 Patent.

47. Plaintiff Profectus has suffered damages as a result of Google's acts of infringement of the '308 Patent, and Profectus will continue to be damaged by such infringement unless enjoined by this Court.

COUNT II

INDIRECT INFRINGEMENT

48. Profectus incorporates by reference the paragraphs above as if fully set forth herein.

49. In addition to and/or in the alternative to direct infringement, upon information and belief, Google's customers directly infringe the '308 Patent by using the Accused Products in the United States, and Google indirectly infringes by actively inducing its customers' infringement.

50. Defendant encourages and intends for its customers to use the Accused Products in a manner that infringes the '308 Patent. For example, through its public website, (*e.g.*, <https://support.google.com/googlenest/answer/9136909?hl=en>), Google advises, encourages, and instructs its customers to use the Accused Products in a manner that infringes one or more claims of the '308 Patent.

51. Furthermore, Google knew its actions would induce infringement of one or more claims of the '308 Patent by its customers. Since at least as early as May 11, 2019, or alternatively, at least as early as October 22, 2018, Google has known that its Accused Products infringe one or more claims of the '308 Patent.

52. Despite its actual knowledge of the '308 Patent and Profectus's allegations of infringement, Google has continued to advise, encourage, and instruct its customers to use the Accused Products in a manner that infringes one or more claims of the '308 Patent.

53. Use of the Accused Products by Google's customers directly infringes at least claims 1, 2, 3, 4, 5, 6, 7, 8, 9, 12, 29, and 30 of the '308 Patent, literally or under the doctrine of equivalents.

54. Defendant is thus liable for actively inducing its customers' infringement of the '308 Patent under 35 U.S.C. § 271(b).

55. Google's acts of actively inducing infringement have been, and continue to be, willful, deliberate, and in conscious disregard of Plaintiff's rights, as shown, at least in part, by Google's refusal to substantively respond to the Notice Letter, and by Google's refusal to discontinue infringing the '308 Patent despite actual knowledge that the Accused Products infringe one or more claims of the '308 Patent.

56. Profectus has suffered damages as a result of Google's acts of active inducement of infringement of the '308 Patent, and Profectus will continue to be damaged by such infringement unless enjoined by this Court.

PRAYER

WHEREFORE, Plaintiff Profectus requests entry of judgment against Google:

- a. Adjudging that Defendant has infringed the '308 Patent in violation of 35 U.S.C. §§ 271(a) and/or 271(b);
- b. Finding that Defendant's infringement of the '308 Patent has been willful;
- c. Ordering an accounting of all infringing acts, including, but not limited to, those acts not presented at trial;
- d. Awarding Plaintiff damages under 35 U.S.C. § 284 adequate to compensate Plaintiff for the infringement, including, but not limited to, pre-judgment and post-judgment interest and costs;
- e. Ordering that the damages award be increased up to three times the actual amount pursuant to 35 U.S.C. § 284 in view of Defendant's willful infringement;
- f. Finding that this is an exceptional case and awarding Profectus its costs and reasonable attorney fees incurred in this action pursuant to 35 U.S.C. § 285; and
- g. Awarding such other and further relief, both at law and in equity, that the Court deems just and proper.

DEMAND FOR JURY TRIAL

Plaintiff Profectus hereby demands a trial by jury on all claims and issues so triable under Rule 38 of the Federal Rules of Civil Procedure.

Dated: February 10, 2020.

Respectfully submitted,

/s/ Casey Griffith

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