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**UNITED STATES DISTRICT COURT
FOR THE
SOUTHERN DISTRICT OF NEW YORK**

Shenzhen OKT Lighting Co., Ltd.
Plaintiff,

v.

JLC-TECH LLC,
Defendant.

Civil Action No. 20-5062

**OKT's COMPLAINT FOR
DECLARATORY RELIEF**

JURY DEMANDED

Date: July 1, 2020

Plaintiff Shenzhen OKT Lighting Co., Ltd. ("OKT") brings this declaratory judgment action against the Defendant, JLC-TECH LLC, ("JLC"), and for its cause of action alleges as follows:

THE PARTIES

1. OKT is a Chinese company organized under the laws of the People's Republic of China, with its principal place of business at 2076 Jincheng Rd. Shajing, Bao'an, SZ 518104, CN.

¹ Application / admission to this Court pending.

2. On information and belief, JLC is a Massachusetts limited liability company, with its principal place of business located at 370 Corporate Park, Pembroke, Massachusetts, 02359.

JURISDICTION AND VENUE

3. OKT incorporates the preceding paragraphs herein by reference.

4. On information and belief, JLC is the owner, by assignment, of the entire right, title and interest in and to U.S. Patent No. 10,508,805 (“the ‘805 Patent”), issued on December 17, 2019.

5. This is a civil action arising under the Patent Laws of the United States (35 U.S.C. § 1 et seq.), and under the Declaratory Judgment Act (28 U.S.C. § 2201, et seq.) for a declaratory judgment that Plaintiff and its customers do not infringe JLC’s ‘805 patent, and that the ‘805 patent is invalid and unenforceable.

6. The Court has jurisdiction over the subject matter of this complaint under 28 U.S.C. §§ 1331, 1338(a), 2201 and 2202.

7. This Court has original jurisdiction over the subject matter of this complaint pursuant to 28 U.S.C. § 1331 (federal question), 28 U.S.C. § 1338(a) (patents), and 28 U.S.C. § 2201, 2202 (declaratory judgment).

8. This Court has personal jurisdiction over JLC because JLC has established minimum contacts with the forum such that the exercise of jurisdiction would not offend traditional notions of fair play and substantial justice.

9. On information and belief, from May 5 through May 7, 2015, JLC attended and exhibited its T-Bar LED light fixture product at the 2015 LightFair International Trade Show in New York, NY, specifically at the Javits Center, within the Southern District of New York. See Ex. A.

10. On information and belief, LightFair is the most important annual lighting exhibition trade show in the United States, and a unique opportunity for manufacturers of architectural lighting to not only exhibit their designs but to compete and establish new customer relationships while cementing existing ones.

11. During the 2017 LightFair International Show in Pennsylvania, JLC sued OKT in the Eastern District of Pennsylvania, No. 17- 02043, for allegedly infringing U.S. Patent No. 8,177,385 (“the ‘385 Patent”). See Ex. B at 3. The ‘385 Patent was a “grandparent” of the more recently granted ‘805 Patent, at issue here. Shortly after filing suit, JLC notified OKT that it intended to seek a temporary restraining order requiring OKT to remove all its allegedly infringing products from the 2017 LightFair show, as well as cease manufacture and sale of the 2017 version of OKT’s T-Bar lights. *Id.* The case was later settled and dismissed after OKT withdrew the 2017 T-Grid version from the market, which was later replaced with a design-around, which is OKT’s current T-Grid product.

12. Since then, on information and belief, JLC has continued to attend significant lighting shows in this district. For example, on information and belief, JLC attended and exhibited its T-Bar LED light fixture product in the October 2018 SDA Lighting Showcase trade show at the Metropolitan Pavilion, 125 W 18th St, New York, NY 10011, which is within the Southern District of New York’s jurisdiction. See Ex. C (<https://www.facebook.com/jlctech/photos/a.284433514932749/2019679221408161/?type=3>, last visited July 1, 2020).

13. On information and belief, the ‘805 Patent was granted on December 17, 2019.

14. On information and belief, “LightFair 2020 Is canceled due to Covid-19 concerns.” See Ex. D (<https://www.lightfair.com/tradeshow/exhibitors>, last visited July 1, 2020).

15. The next LightFair International Trade Show will again be held in New York, NY, specifically at the Javits Center, from May 18 to May 20, 2021, within the Southern District of New York. See Ex. E (<https://www.lightfair.com/>, last visited July 1, 2020).

16. On January 14, 2020, JLC sent a letter directed to an OKT customer, Arlee Lighting Corporation, at 125 Doughty Boulevard, Inwood, NY 11096 (“Arlee”), which is within the Southern District of New York. Ex. B.

17. JLC began the letter by alleging that it “manufactures, markets, and sells linear LED lighting, including the T-BAR LED™” -- the fixture it exhibited at the 2015 and 2018 light shows mentioned above, within the Southern District of New York. *Id.*

18. In the letter, JLC accuses Arlee of infringing JLC’s recently granted ’805 Patent by selling OKT’s T-Grid design-around product. *Id.*

19. Among other things, JLC emphasizes that it sued OKT *during the 2017 LightFair International Show* and had threatened to move for a TRO seeking removal of OKT’s T-Grid from the show:

During the 2017 LightFair International Show [in Pennsylvania], JLC-Tech filed a Complaint in the United States District Court for the Eastern District of Pennsylvania ***for patent and copyright infringement against Shenzhen OKT Lighting Co.*** See JLC-Tech LLC and JLC-Tech IP LLC v. OKT Lighting, a/k/a Shenzhen OKT Lighting Co., Ltd. a/k/a OKT International Lighting Group, Ltd., Civil Action No. 2:17-cv-02043- GJP. ***After being notified of JLC-Tech’s intent to move forward with a motion for a temporary restraining order seeking the removal of the infringing product from display or offer for sale at 2017 LightFair International, OKT agreed to remove all its infringing products from the show, cease future manufacture and sale of infringing LED T-Bar lights, and cease use of JLC-Tech’s copyrighted images.*** JLC-Tech

voluntary dismissed the case without prejudice so long as OKT complied with JLC-Tech's settlement demands, including prohibiting future sales of the infringing products within the United States and prohibiting use of JLC-Tech's copyrighted images. *Id.* at 3 (emphasis added).

20. Notably, the above-quoted paragraph emphasizes that OKT agreed to remove its exhibit from the 2017 LightFair without mentioning that the removed product was not OKT's *current* T-Grid product, but rather it was a *previous* version and that the current version is an improved, innovative version covered by OKT's own patent, U.S. Patent No. 10,125,934, which was granted on November 13, 2018 after being found patentable by the U.S. Patent and Trademark Office over JLC's T-Bar as disclosed in its '385 Patent.

21. Preparing for a show of the magnitude and importance of LightFair International show takes months, if not years, and JLC's suit *during* the 2017 show along with its threatened TRO caused substantial harm not only to OKT's competitive position for the T-Grid, but also to all the time, money and effort OKT put into preparing for the show.

22. On information and belief, it is well known within the industry that the next LightFair International show, which OKT and its customers including Arlee plan to attend, is slated to occur in New York.

23. On information and belief, LightFair has already begun to collect applications for those interested in exhibiting at the next LightFair International show in New York. See <https://www.lightfair.com/prospectus?apply=1> (last visited July 1, 2020).

24. In summary, on information and belief, JLC has:

- a. repeatedly attended and exhibited its competing T-Bar LED lighting product at trade shows in the Southern District of New York;
- b. previously sued OKT for itself exhibiting a prior version of its own T-Grid product at trade shows;

- c. recently sent a patent infringement accusation letter to OKT customer Arlee in the Southern District of New York, in part emphasizing JLC's prior suits as well as how it threatened to move for a TRO seeking the removal of OKT's T-Grid from display or offer for sale at a LightFair trade show; and
- d. has threatened OKT's customer Arlee residing within the Southern District of New York, knowing that the next opportunity for OKT and Arlee to exhibit and sell the T-Grid and to compete with JLC's T-Bar at LightFair will be at the Javits Center in the Southern District of New York in 2021.

25. As such, the transactions and occurrences that are the subject of the present controversy arise directly out of:

- a. JLC's threat against OKT's customer Arlee in this district;
- b. the direct impact JLC's threat potentially has upon OKT's relationships with Arlee and other customers within this district;
- c. the competition between JLC and OKT, including their respective customers and representatives, at critical trade shows such as LightFair and SDA Lighting Showcase in this district;
- d. the direct impact JLC's threat potentially has on the ability of OKT and its customers including Arlee *to exhibit T-Grid at trade shows* in this district, including the next LightFair International trade show at the Javits Center in 2021; and
- e. the ability of OKT and its customers including Arlee to *compete with JLC's T-Bar products* for sales in this district, including through exhibitions at trade shows in this district such as the next LightFair 2021 at the Javits Center.

26. It should be noted that this is not a situation where a declaratory judgment defendant's sales of its product that reaches the forum through a stream of commerce has little connection to the defendant's patent. On information and belief, JLC's patent was in fact obtained in part specifically due to representations to the U.S. Patent and Trademark Office regarding JLC's sales, marketing and competitive position of the T-Bar.

27. For example, on information and belief, during prosecution of the application that led to the '805 Patent, JLC relied specifically on the design, sales, marketing and competitive position of the T-Bar, as the commercial embodiment of the then-pending patent claims, in order to overcome a rejection in view of the prior art,

28. According to the patent examiner's summary of a May 1, 2019 presentation made by JLC:

Mr. Porciatti presented the invention of the T-bar and explained the unique structural features of the T-bar such as the anchors and the reflectors of the light source covering and the applications of the T-bar in a suspended ceiling. Mr. Porciatti presented the market considerations of the invention and the company. Additionally, various competitors products were shown in the demonstration.

29. Following the interview and a related amendment and affidavit, the patent examiner allowed the pending claims.

30. Moreover, on information and belief, JLC has established and relied on long-term continuing business relationships, including sales, distribution and licensing relationships, with residents in various locations throughout New York, regarding its patented T-Bar LED light.

31. For example, as of the date of this complaint, JLC's website listed the following as representatives for JLC's T-Bar in New York:

Stan Deutsch Associates
(New York City, Long Island, Westchester & Rockland)
31-30 Hunters Point Avenue
Long Island City, NY 11101
T. (718)361-9150 F. (718)482-0541
Email - info@sdalighting.com
www.sdalighting.com

Light Spec
(Northern New York State; Rochester, Buffalo, Amherst, Albany & Syracuse)

ROCHESTER OFFICE
1501 Monroe Avenue
Rochester NY 14618
Phone: 585.242.8888 Fax: 585.256.8230
Email - blicata@lightspec.com

BUFFALO OFFICE
3960 Harlem Road, Suite 9
Amherst NY 14226
Phone: 716.836.0707 Fax: 716.836.3747
Email - smcivor@buf.lightspec.com

ALBANY OFFICE
636 Plank Road Center, Suite 205
Clifton Park NY 12065
Phone: 518.371.9214 Fax: 518.371.9232
Email - dleslie@alb.lightspec.com

https://www.tbardedsmartlight.com/pdf/JLC_TECH_SALES_REPRESENTATIVES.pdf (last visited July 1, 2020).

32. On information and belief, according to the Wayback Machine, JLC has maintained long-term continuing business relationships with at least the first representative on the list – Stan Deutsch Associates (“SDA Lighting”), JLC’s representative for New York City – since at least January 2014.

NEW YORK
Stan Deutsch Associates
31-30 Hunters Point Avenue
Long Island City NY 11101
T. (718)361-9150 F.(718)482-0541
Email - info@sdalighting.com
<http://www.sdalighting.com>

http://web.archive.org/web/20120813155014/http://tbardedsmartlight.com/pdf/JLC_TECH_SALES_REPRESENTATIVES.pdf (last visited June 30, 2020).

33. On information and belief, SDA Lighting has been exhibiting JLC’s T-Bar LED at lighting shows in New York City since at least September 2014.

34. For example, on information and belief, SDA Lighting exhibited JLC's T-Bar LED at the SDA Lighting Showcase 2014, September 15-17, 2014 at The Metropolitan Pavilion, 125 W 18th St, New York, NY 10011, which is within the Southern District of New York's jurisdiction. <https://www.vmsd.com/content/stan-deutsch-associates-ramps-plans-new-york-city-s-premier-lighting-showcase> (last visited July 1, 2020).

35. On information and belief, SDA Lighting also represented JLC at the 2015 LightFair International Trade Show in New York, NY, specifically at the Javits Center, within the Southern District of New York. <http://sda-lighting.com/Events.html> (last visited June 30, 2020).²

36. As noted above, supra ¶ 12, JLC and SDA Lighting exhibited JLC's T-Bar LED at the SDA Lighting Showcase at the The Metropolitan Pavilion again as recently as October 2018.

37. JLC's above-described activities and long-term continuing business relationships in New York, and particularly within the Southern District of New York, are more than sufficient contacts with the forum to justify the Court's exercise of both specific and general *in personam* jurisdiction over JLC.

38. A reasonable apprehension of suit is not necessary for declaratory judgment jurisdiction, but weighs in favor of finding a justiciable case and controversy suitable for declaratory judgment. *Indus. Models, Inc. v. SNF, Inc.*, 2017-1172, at *7

² As also noted above, this is not a situation where a declaratory judgment defendant's sales of its product that reaches the forum through a stream of commerce has little connection to the defendant's patent. JLC relied in part on its successful sales, marketing and competitive position of the T-Bar to overcome a rejection by the U.S. Patent and Trademark Office in view of prior art and secure the recent allowance of the '805 Patent. See *supra* ¶ 28.

(Fed. Cir. Nov. 7, 2017); *Prasco, LLC v. Medicis Pharmaceutical Corp.*, 537 F.3d 1329, 1336 (Fed. Cir. 2008).

39. The previous assertion of the patent-in-suit against another competitor weighs in favor of finding a reasonable apprehension of suit, and thus a justiciable controversy. *Sherwood Med. Indus., Inc. v. Deknata*, 512 F.2d 724, 728 (8th Cir. 1975) (finding prior litigation, along with other factors, to create reasonable apprehension when prior litigation involved same patent).

40. As noted above, in 2017 JLC sued OKT in Pennsylvania for allegedly infringing the '805 Patent's grandparent, the '385 Patent.

41. The actions against OKT and its customers have now gone beyond imminent threat of suit, which was already established by JLC's letter to OKT's New York customer, Arlee Lighting Corporation, on January 14, 2020.

42. Just last month, on May 12, 2020, JLC sued another OKT customer, North American Lighting, LLC (NAL) in the District of Maryland, Civil Action No. DMD-1-20-cv-01203-1 (the "NAL Suit").

43. JLC alleges in the NAL Suit that OKT's design-around T-Grid product and the NAL-branded counterpart ("Mister T" per NAL branding) infringe the recently granted '805 Patent.

44. On information and belief, JLC's threats are likely to harm OKT's ability to sell its T-Grid within the forum, and to harm OKT's relationships with valued customers here, including but not limited to Arlee Lighting Corporation, absent relief from this Court.

45. On information and belief, particularly in view of JLC's pointed reference to LightFair in its threatening letter, it is also likely that Arlee Lighting will also decline to

exhibit OKT's T-Grid at important lighting showcases, including the upcoming 2021 LightFair International Trade Show in New York, NY, absent relief from this Court.

46. As such, there is no question that a justiciable controversy supports this Court's exercise of declaratory judgment jurisdiction over JLC.

47. For these and other reasons, this Court may assert jurisdiction over JLC in this declaratory judgment action.

48. Venue is proper in this District under 28 U.S.C. § 1391(b)-(d).

FIRST CLAIM FOR RELIEF

(Request for Declaratory Judgment of Non-Infringement of U.S. Patent No. 10,508,805)

49. OKT incorporates the preceding paragraphs herein by reference.

50. Plaintiff has not singly nor jointly infringed, contributed to the infringement of, nor induced infringement of any valid claim of U.S. Patent No. 10,508,805 as properly construed, either literally or under the doctrine of equivalents.

SECOND CLAIM FOR RELIEF

(Request for Declaratory Judgment of Invalidity of U.S. Patent No. 10,508,805)

51. OKT incorporates the preceding paragraphs herein by reference.

52. The '805 Patent is invalid for failing to satisfy one or more of the conditions of patentability under Title 35 of United States Code, including but not limited to Sections 101, 102, 103, and/or 112.

THIRD CLAIM FOR RELIEF

(Request for Declaratory Judgment of Unenforceability of U.S. Patent No. 10,508,805)

53. OKT incorporates the preceding paragraphs herein by reference.

54. The '805 Patent is unenforceable for failing to satisfy the conditions of enforceability required in law and equity.

PRAYER FOR RELIEF

WHEREFORE, OKT pray for a judgment against JLC and for the following relief:

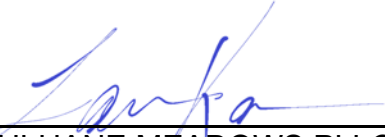
- A. Declare that OKT and its customers do not and have not infringed, contributed to the infringement, or induced infringement of any claims of the '805 Patent, either literally or under the doctrine of equivalents;
- B. Declare that the claims of the '805 Patent are invalid;
- C. Declare that the '805 Patent is unenforceable;
- D. Enter a preliminary and permanent injunction, enjoining JLC, its officers, agents, servants, employees, and attorneys, and those persons in active concert or participation with them who receive actual notice of the injunction, from threatening, initiating or continuing to prosecute patent infringement litigation against OKT, its customers, or any of their customers, dealers, agents, sellers, resellers, servants, or employees, or any prospective or present sellers, resellers, dealers, or users of OKT's or its customer's T-Grid products, or charging any of them either verbally or in writing with infringement of the '805 patent because of importation, manufacture, use, sale, or offering for sale of OKT's products;
- E. Declare this case exceptional under 35 U.S.C. § 285 and award OKT its reasonable attorneys' fees, expenses and costs incurred in the prosecution of this action; and
- F. All other relief that the Court may deem appropriate.

DEMAND FOR JURY TRIAL

Pursuant to Rule 38 of the Federal Rule of Civil Procedure, OKT demands a jury trial on all issues triable of right by a jury.

Dated: July 1, 2020

By:


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