

IN THE UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF DELAWARE

OMNIVISION TECHNOLOGIES, INC.,

Plaintiff,

v.

RE SECURED NETWORKS, LLC

Defendant.

C.A. No. _____

JURY TRIAL DEMANDED

COMPLAINT

Plaintiff, OmniVision Technologies, Inc. (“OmniVision” or “Plaintiff”) for its Complaint against RE Secured Networks, LLC (“RESN” or “Defendant”) by and through its attorneys, allege as follows:

NATURE OF THE ACTION

1. This is an action for declaratory judgment of non-infringement arising under the Patent Laws of the United States, 35 U.S.C. § 1, *et seq.* and the Federal Declaratory Judgment Act, 28 U.S.C. §§ 2201 and 2202, and for other relief the Court deems just and proper.

2. OmniVision seeks relief from the Court because RESN and the purported previous owner of the U.S. Patent Nos. 7,323,671 and 7,800,145 (collectively, “Asserted Patents”) have raised baseless claims of patent infringement against OmniVision’s products. OmniVision has repeatedly responded to the infringement allegations, explaining why its products do not infringe the Asserted Patents. Nonetheless, on February 9, 2024, RESN’s agent, Erich Spangenberg, asserted to Robert Cleary, Jr., OmniVision’s General Counsel, that RESN would sue OmniVision if OmniVision refused to pay the demanded license fee. OmniVision

refused to pay a licensing fee and an actual conversy concerning infringement of the Asserted Patents exists between OmniVision and RESN.

3. OmniVision brings this declaratory judgment action to remove the cloud of uncertainty regarding RESN's infringement allegations.

PARTIES

4. Plaintiff OmniVision is a corporation organized and existing under the laws of the State of Delaware, with a principal place of business at 4275 Burton Drive, Santa Clara, CA 95054. OmniVision is a fabless semiconductor organization that designs and develops digital imaging technology.

5. Defendant RESN is a limited liability company organized and existing under the laws of the State of Delaware. Defendant may be served with process by serving its registered agent, MWE Corporate Services, LLC, 1000 North West Street, Suite 140, Wilmington, Delaware 19801.

6. RESN has represented that it has offices at 2633 McKinney Ave., Suite 130-740, Dallas, Texas 75204. This address corresponds to a UPS Store.

JURISDICTION AND VENUE

7. This action for a declaratory judgment of non-infringement under the patent laws of the United States, 35 U.S.C. § 1 *et seq.*, and the Declaratory Judgment Act, 28 U.S.C. §§ 2201, 2202.

8. This Court has subject matter jurisdiction pursuant to 28 U.S.C. §§ 1331, 1337, 1338, 2201, and 2202.

9. This Court has personal jurisdiction over RESN because it is organized and existing under the laws of the State of Delaware.

10. Venue is proper in this judicial district pursuant to 28 U.S.C. §§ 1391 and 1400(b)

and 15 U.S.C. § 15(a) because the RESN resides, is incorporated, and/or has agents in this District.

PATENTS-IN-SUIT

11. U.S. Patent No. 7,323,671 (“the ’671 patent”) is entitled, “Method and Apparatus for Varying a CMOS Sensor Control Voltage,” and names Zeynep Toros, Richard Mann, Selim Bencuya, Chi-Shao (Sergi) Lin, and Jiafu Luo as inventors. The ’671 patent issued on January 29, 2008. According to assignment records at the United States Patent and Trademark Office (“USPTO”), RESN is the current owner of the ’671 patent. A copy of the ’671 patent is attached as Exhibit A.

12. U.S. Patent No. 7,800,145 (“the ’145 patent”) is entitled, “Method and Apparatus for Controlling Charge Transfer in CMOS Sensors with a Transfer Gate Work Function,” and names Zeynep Toros, Richard Mann, and Selim Bencuya as inventors. The ’145 patent issued on September 21, 2010. According to assignment records at the USPTO, RESN is the current owner of the ’145 patent. A copy of the ’145 patent is attached as Exhibit B.

13. Attached as Exhibit C is a true and correct copy of the assignment records from the USPTO pertaining to the ’671 patent.

14. Attached as Exhibit D is a true and correct copy of the assignment records from the USPTO pertaining to the ’145 patent.

15. RESN has authorized agents to act on its behalf in asserting infringement of the ’671 and ’145 patent by and seeking license fees from OmniVision.

ACTS GIVING RISE TO THIS ACTION

16. The Asserted Patents were previously asserted before the United States International Trade Commission in Investigation No. 337-TA-1231, entitled, *In re Certain Digital Imaging Devices and Products Containing the Same and Components Thereof* based on a complaint filed on September 25, 2020. Multiple Samsung entites were named as Respondents.

Pictos Technologies, Inc. f/k/a Imperium IP Holdings (Cayman), Ltd. (“Pictos”), the previous owner of the Asserted Patents, was named as the complainant.

17. On May 21, 2021, Pictos asserted patent infringement against multiple Samsung entities in the United States District Court for the Eastern District of Texas, including the Asserted Patents, in Case No. 4:21-cv-00376.

18. Between October 2021 and May 2022, OmniVision engaged in various conversations and correspondence with agents of Pictos, including Vincent Capone and Gregory Ewing. The agents of Pictos provided claim charts to which OmniVision responded by identifying errors in the infringement contentions.

19. On July 6, 2022, RESN purchased the Asserted Patents from Pictos. Ex. C at 7; Ex. D at 7. The assignment of the Asserted Patents from Pictos to RESN includes the right to recover damages for “past, present, and future infringement.” *Id.*

20. In October 2022, Vincent Capone informed OmniVision’s General Counsel that Lillian Shaked of Skaked & Co. Law Offices and Erich Spangenberg of IPwe were leading the group that acquired the Asserted Patents and set up an introductory call.

21. On March 6, 2023, Raul Diaz Morales of Ona IP sent claim charts asserting infringement of at least claim 1 of the ’671 and ’145 patents by OmniVision’s OV24A Purecell[®] Plus-S series image sensor.

22. On April 29, 2023, Mr. Morales represented to OmniVision that RESN was the sole owner of the entire portfolio, Ona IP is advisor for RE Secure Network to license it, and IPwe is no longer involved and is not going to be involved. Nonetheless, Mr. Spangenberg was included on further correspondence.

23. Over the next few months, Mr. Morales sent at least 30 emails to OmniVision.

OmniVision substantively responded to Mr. Morales' emails, confirming why there is no infringement of the Asserted Patents.

24. On January 30, 2024, Mr. Morales asked for a call with OmniVision. On February 1, 2024, Mr. Morales explained that the purpose of the call was to present an offer.

25. On February 1, 2024, Mr. Spangenberg confirmed that he would be available for a call on February 9, 2024.

26. On February 9, 2024, Mr. Spangenberg spoke with Robert Cleary, Jr., General Counsel for OmniVision. Mr. Cleary maintained that OmniVision did not infringe the Asserted Patents and refused to agree to pay a licensing fee to RESN. Mr. Spangenberg informed Mr. Cleary that RESN would be filing suit and that he would be using the law firm of Russ August & Kabat to litigate the matter.

27. On information and belief, Mr. Spangenberg is authorized to act on behalf of RESN in choosing to select litigation counsel and cause RESN to bring a patent infringement cause of action related to at least claim 1 of the Asserted Patents accusing at least the OmniVision OV24A series image sensors.

28. Through Messrs. Spangenberg and Morales, RESN has expressly asserted that OmniVision has and continues to infringe claims of the Asserted Patents, and further, Mr. Spangenberg directly asserted that he would be bringing a patent infringement lawsuit against OmniVision, thus demonstrating the existence of an actual controversy between OmniVision and RESN regarding the Asserted Patents pursuant to 28 U.S.C. §§ 2201 and 2202. RESN's actions have created uncertainty over OmniVision's products and business. Absent a declaration of non-infringement, OmniVision will continue to suffer harm. For example, the RESN through its agents will continue to wrongfully allege that OmniVision infringes the Asserted Patents.

COUNT I

(DECLARATORY JUDGMENT OF NON-INFRINGEMENT OF THE '671 PATENT)

29. OmniVision hereby re-alleges and incorporates by reference, as if fully set forth herein, the allegations of Paragraphs 1 through 28.

30. As a result of the acts described in the preceding paragraphs, there exists an actual and judiciable controversy as to whether OmniVision's OV24A series image sensors infringe the '671 patent.

31. OmniVision has repeatedly explained to RESN that there is no infringement of the '671 patent. By way of example, claim 1 of the '671 patent requires, *inter alia*, "variable voltage circuitry including a voltage selector determining a control voltage." The OV24A series image sensors do not include this functionality.

32. OmniVision's OV24A1 image sensor has not and does not infringe the claims of the '671 patent literally or under the doctrine of equivalents. Because OmniVision does not directly infringe any claim of the '671 patent, OmniVision has not induced others to infringe or contributorily infringed any claims of the '671 patent.

33. OmniVision is entitled to a declaratory judgment that it does not and has not infringed, either literally or under the doctrine of equivalents, directly or indirectly, any valid and enforceable claim of the '671 patent under 35 U.S.C. § 1 *et seq.* Absent a declaration and order as sought by OmniVision, RESN will continue to wrongfully assert that OmniVision has infringed the '671 patent, thereby causing OmniVision irreparable injury and harm.

COUNT II

(DECLARATORY JUDGMENT OF NON-INFRINGEMENT OF THE '145 PATENT)

34. OmniVision hereby re-alleges and incorporates by reference, as if fully set forth herein, the allegations of Paragraphs 1 through 28.

35. As a result of the acts described in the preceding paragraphs, there exists an actual and judiciable controversy as to whether OmniVision's OV24A series image sensors infringe the '145 patent.

36. OmniVision has repeatedly explained to RESN that there is no infringement of the '145 patent. By way of example, claim 1 of the '145 patent requires, *inter alia*, "in an absence of the control voltage the control terminal creates an electric field tending to repel the electrons from a portion of the body." The OV24A series image sensors do not include this functionality.

37. OmniVision's OV24A1 image sensor has not and does not infringe the claims of the '145 patent literally or under the doctrine of equivalents. Because OmniVision does not directly infringe any claim of the '145 patent, OmniVision has not induced others to infringe or contributorily infringed any claims of the '145 patent.

38. OmniVision is entitled to a declaratory judgment that it does not and has not infringed, either literally or under the doctrine of equivalents, directly or indirectly, any valid and enforceable claim of the '145 patent under 35 U.S.C. § 1 *et seq.* Absent a declaration and order as sought by OmniVision, RESN will continue to wrongfully assert that OmniVision has infringed the '145 patent, thereby causing OmniVision irreparable injury and harm.

PRAYER FOR RELIEF

WHEREFORE, OmniVision prays for relief as follows:

- A. judgement in favor of OmniVision and against RESN;
- B. a declaration that OmniVision has not infringed and does not infringe any claim of the Asserted Patents;
- C. declaring that this case is exceptional under 35 U.S.C. § 285 and awarding OmniVision its attorney's fees and expenses in this action;
- D. awarding OmniVision its costs in this action; and
- E. such other relief as this Court deems just and proper.

DEMAND FOR JURY TRIAL

Pursuant to Federal Rule of Civil Procedure 38(b), OmniVision demands a trial by jury on all claims and issues on which a jury trial is available under applicable law.

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