

**IN THE UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF DELAWARE**

SENSORMATIC ELECTRONICS, LLC,

Plaintiff,

v.

PROSEGUR SECURITY USA, INC.,

Defendant.

Civil Action No. _____

DEMAND FOR JURY TRIAL

COMPLAINT FOR PATENT INFRINGEMENT

Plaintiff Sensormatic Electronics, LLC (“Sensormatic”), by and through its attorneys, brings this action for patent infringement against Prosegur Security USA, Inc. (“Prosegur” and “Defendant”).

NATURE OF ACTION

1. This is an action for infringement of United States Patent No. 9,734,683 (“the ’683 patent” or “the Asserted Patent”), under the Patent Act, 35 U.S.C. § 271, based on Prosegur’s unauthorized manufacture, use, offer for sale, and/or sale in the United States, and/or importation into the United States of at least the nanotag pin tag (“nanotag” or “Accused Product”) and its acts that induce and/or contribute to the use of the Accused Product.

PARTIES

2. Sensormatic is a limited liability company organized and existing under the laws of the state of Nevada and having a principal place of business at 6600 Congress Ave, Boca Raton, FL 33487.

3. On information and belief, Prosegur is a corporation organized and existing under the laws of the state of Delaware and having a principal place of business at 512 Herndon Parkway, Herndon, VA 20170.

JURISDICTION AND VENUE

4. This action arises under the Patent Act, 35 U.S.C. § 1 *et seq.*, including in particular 35 U.S.C. §§ 271, 281, 283, 284, and 285.

5. This Court has jurisdiction over the subject matter of this action under 28 U.S.C. §§ 1331, 1338, 2201, and 2202.

6. This Court has personal jurisdiction over Prosegur because it is incorporated in the State of Delaware and therefore is at home in Delaware, and because, upon information and belief, it conducts business and has committed acts of patent infringement within the State of Delaware. On information and belief, Prosegur is subject to personal jurisdiction in Delaware because, among other things, Prosegur maintains continuous and systematic contacts with the State of Delaware, and has purposefully availed itself of the benefits and protections of Delaware's laws, such that it should reasonably anticipate being haled into court here.

7. Venue is proper in this District as to Prosegur under 28 U.S.C. § 1400 because it resides in this District.

BACKGROUND

8. Sensormatic has been a leader in retail solutions since its founding in 1966. Sensormatic was founded after theft of wine bottles from a Kroger supermarket. Sensormatic began with ground-breaking anti-theft pedestals and tags, and has continued to develop cloud-based technology and next-generation technology. Sensormatic has been a pioneer in electronic article surveillance since its founding, including in the use of electronic article surveillance (EAS) tags.

9. Sensormatic owns the '683 patent with all substantial rights, including the exclusive right to sue for infringement.

THE PATENTS-IN-SUIT

10. The United States Patent and Trademark Office, after full and fair examination, duly and legally reissued the '683 patent on August 15, 2017, entitled "Modular and adaptable sensor system with integrated lock," and naming Sergio M. Perez as inventor. A true and correct copy of the '683 patent is attached hereto as Exhibit A. The '683 patent issued from Application No. 15/151,793, filed on May 11, 2016.

11. The claims of the '683 patent are valid, enforceable, and currently in full force and effect until the expiration of the '683 patent on May 11, 2036.

DEFENDANT'S INFRINGING ACTS

12. Prosegur sells products that directly infringe or induce and/or contribute to infringement of the '683 patent, including at least the nanotag. In addition, Prosegur provides customers with instructions, product information, technical information, installations, and services for using the nanotag, that, among other things, instruct the user to act in an infringing manner. Prosegur's products also contributorily infringe, as they are not staple articles of commerce having a substantial noninfringing use.

COUNT I: INFRINGEMENT OF THE '683 PATENT

13. The allegations of paragraphs 1–12 are realleged and incorporated herein by reference.

14. Prosegur has infringed, and is continuing to infringe, literally or under the doctrine of equivalents, at least claim 11 of the '683 patent, in violation of 35 U.S.C. § 271(a), (b), (c).

15. Prosegur has known of the '683 patent since at least February 28, 2022, when Sensormatic and Johnson Controls sent a letter to Prosegur explaining that the nanotag infringes claim 11 of the '683 patent. Prosegur additionally received a claim chart showing how the nanotag infringes claim 11 of the '683 patent on May 6, 2022.

16. Prosecur has directly infringed, and is continuing to directly infringe, literally or under the doctrine of equivalents, at least claim 11 of the '683 patent by making, using, selling, and/or offering for sale the infringing nanotag products in the United States, in violation of 35 U.S.C. § 271(a).

17. As the claim chart attached at Exhibit B shows, the use of the nanotag infringes at least claim 11 of the '683 patent.

18. Prosecur knowingly, actively induced and continues to knowingly induce third-party direct infringers—such as Prosecur's customers and end users—to practice the patented inventions of at least claim 11 of the '683 patent by importing, making, using, offering for sale, and selling the infringing nanotag products and by encouraging and facilitating infringement by creating and distributing instructional, product, and technical materials related to the infringing products. For example, Prosecur's website provides instructions showing how to use the nanotag in an infringing manner. *See* <https://www.prosecur.us/security-solutions/electronic-article-surveillance>. Since at least February 28, 2022, Prosecur has had knowledge that the induced acts constitute patent infringement, in violation of 35 U.S.C. § 271(b).

19. Prosecur's infringing nanotag products are apparatuses especially made or adapted for infringing use, and Prosecur sells and has sold the infringing nanotag products for use in the patented inventions recited in at least claim 11 of the '683 patent. Prosecur knowingly contributed to, and continues to contribute to, the infringement of the '683 patent by others in this District—such as Prosecur's customers and end users—by selling or offering for sale the infringing nanotag products in this District, wherein the infringing nanotag products constitute a material part of the patented inventions recited in at least claim 11 of the '683 patent, and are not staple articles or commodities of commerce suitable for a substantial non-infringing use, in violation of 35 U.S.C. § 271(c). Upon information and belief, there is no non-infringing use for the nanotag products.

Since at least February 28, 2022, Prosecur has had knowledge of the '683 patent and of its infringement.

20. Prosecur's acts of infringement of the '683 patent were and are willful, and have caused and will continue to cause substantial damages and irreparable harm to Sensormatic, and Sensormatic has no adequate remedy at law.

21. Prosecur is, and/or has been, aware of the '683 patent since at least February 28, 2022. Prosecur's continued infringement actions render this an exceptional case under 35 U.S.C. § 285.

REQUEST FOR RELIEF

WHEREFORE, Sensormatic respectfully requests the following relief:

(A) A judgment that Prosecur has infringed the '683 patent in violation of 35 U.S.C. § 271(a);

(B) A judgment that Prosecur has actively induced infringement of the '683 patent in violation of 35 U.S.C. § 271(b);

(C) A judgment that Prosecur has contributorily infringed the '683 patent in violation of 35 U.S.C. § 271(c);

(D) A judgment temporarily, preliminarily, or permanently enjoining Prosecur, its parents, subsidiaries, affiliates, divisions, officers, agents, servants, employees, directors, partners, representatives, all individuals and entities in active concert and/or participation with it, and all individuals and/or entities within its control from engaging in patent infringement of the '683 patent;

(E) Ordering Prosecur to account and pay damages adequate to compensate Sensormatic for Prosecur's infringement of the '683 patent, including pre-judgment and post-judgment interest and costs pursuant to 35 U.S.C. § 284;

(F) Ordering an accounting for any infringing sales not presented at trial and an award by the Court of additional damages for any such infringing sales;

(G) Ordering that the damages award be increased up to three times the actual amount assessed pursuant to 35 U.S.C. § 284;

(H) Declaring this case exceptional and awarding Sensormatic its reasonable attorney fees pursuant to 35 U.S.C. § 285;

(I) Costs and expenses in this action; and

(J) Such other and further relief as the Court deems just and proper.

JURY TRIAL DEMAND

Sensormatic demands a trial by jury on all claims and issues so triable under Federal Rule of Civil Procedure 38(b).

DATED: January 11, 2023

Of Counsel:

Janine A. Carlan (*pro hac vice to be filed*)
Jasjit S. Vidwan (*pro hac vice to be filed*)
ARENTFOX SCHIFF LLP
1717 K Street, NW
Washington, DC 20006-5344
Ph: 202.857.6000
Fax: 202.857.6395
janine.carlan@afslaw.com
jasjit.vidwan@afslaw.com

YOUNG CONAWAY STARGATT & TAYLOR,LLP

/s/ Karen L. Pascale

Karen L. Pascale (#2903)
Robert M. Vrana (#5666)
Rodney Square
1000 North King Street
Wilmington, Delaware 19801
(302) 571-6600
kpascale@ycst.com
rvrana@ycst.com

*Attorneys for Plaintiff,
Sensormatic Electronics, LLC*