

**IN THE UNITED STATES DISTRICT COURT  
FOR THE SOUTHERN DISTRICT OF FLORIDA  
MIAMI DIVISION**

Optikam Tech Inc.,

*Plaintiff,*

v.

American Bright Signs, Inc. (dba ACEP USA),  
ACEP Group, and ACEP France,

*Defendants.*

Civil Action No.

**JURY TRIAL DEMANDED**

**COMPLAINT FOR PATENT INFRINGEMENT**

Plaintiff Optikam Tech, Inc. (“Optikam” or “Plaintiff”), by its attorneys, hereby alleges patent infringement against Defendants American Bright Signs, Inc. (dba ACEP USA), ACEP Group, and ACEP France (collectively, “ACEP” or “Defendants”), as follows:

**NATURE OF THE ACTION**

1. This is an action for patent infringement under the Patent Laws of the United States, 35 U.S.C. 1 *et seq.*, including 35 U.S.C. §§ 271, 281, 283, 284, and 285. Optikam alleges that Defendants have infringed, directly and/or indirectly, Optikam’s United States Patent No. 11,579,472 (the “’472 Patent” or “Asserted Patent”). A true and correct copy of the ’472 Patent is attached hereto as Exhibit A.

2. The ’472 Patent covers technologies that utilize time-of-flight scanners, e.g., light detection and ranging (Lidar) systems, to determine the measurements needed to fabricate lenses for eyeglasses that are customized for the individual. The technology described in the ’472 Patent allows for quick, convenient, safe, and accurate contactless measurements.

3. As described herein, the use of Defendants’ “Smart Mirror 4 Pro” (the “Accused Product”) infringes one or more claims of the ’472 Patent.

4. As described herein, Defendants have directly infringed one or more claims of the '472 patent under 35 U.S.C. § 271(a) and indirectly infringed one or more claims of the '472 Patent under 35 U.S.C. § 271(b) and (c).

5. As described herein, Defendants' past, current, and ongoing infringement has been and continues to be willful.

6. Optikam seeks monetary damages and injunctive relief for Defendants' infringement of the '472 Patent.

### **PARTIES**

7. Plaintiff Optikam is a corporation organized and existing under the laws of Canada, having a registered address of 787 Liege West, Montreal, Quebec, H3N 1B1, Canada. For well over a decade, Optikam has been engaged in the research and development of technology to improve the eyewear dispensing process, including through optimizing how digital measurements of lenses for eyewear is performed. Optikam currently markets and sells its own products which compete directly in the United States market with the Accused Product.

8. Upon information and belief, Defendant ACEP Group is a corporation organized and existing under the laws of France, having a registered address of 88 rue Jouffroy d'Abbas, Paris, France 75017.

9. Upon information and belief, Defendant ACEP France is a corporation organized and existing under the laws of France, having a registered address of 88 rue Jouffroy d'Abbas, Paris, France 75017.

10. Upon information and belief, Defendant American Bright Signs, Inc. (doing business as ACEP USA) is a corporation organized and existing under the laws of the state of Florida, having a regular and established place of business at 80 SW 8<sup>th</sup> St, STE 2000, Miami, FL,

33130. Based on publicly available information, Defendant American Bright Signs, Inc. (doing business as ACEP USA) is a subsidiary of ACEP Group.

11. Upon information and belief, Defendants make, use, sell, offer to sell, import, advertise, promote, and/or educate third parties (including its customers) regarding products, including but not limited to the Smart Mirror 4 Pro (the “Accused Product.”)

### **JURISDICTION AND VENUE**

12. This civil action arises under the Patent Laws of the United States, 35 U.S.C. § 1 *et seq.*, including without limitation 35 U.S.C. §§ 271, 281, 283, 284, and 285.

13. This Court has subject matter jurisdiction over this action under 28 U.S.C. §§ 1331, 1332, and 1338(a).

14. This Court has specific and general personal jurisdiction over Defendants consistent with the requirements of the Due Process Clause of the United States Constitution and the Florida Long Arm Statute. Plaintiff’s cause of action arises, at least in part, from Defendants’ contacts with and activities in this District and the State of Florida.

15. On information and belief, ACEP has sufficient minimum contacts with the forum because Defendants transact substantial business in the State of Florida and in this District. On information and belief, Defendants have employees in this District.

16. On information and belief, Defendants have purposely manufactured, used, sold, marketed, promoted, offered for sale, and/or distributed the Accused Product, which infringes one or more claims of the ’472 Patent, including but not limited to claim 17, throughout the United States, the State of Florida, and in this District.

17. On information and belief, Defendants have (themselves and/or through the activities of subsidiaries, affiliates, agents or intermediaries) committed acts of patent infringement

in the United States, the State of Florida and this District by performing the claimed methods using the Accused Product.

18. On information and belief, Defendants have (themselves and/or through the activities of subsidiaries, affiliates, agents or intermediaries) induced or contributed to acts of patent infringement by others in the United States, the State of Florida and this District by offering to sell or selling the Accused Products and inducing infringement of the claimed methods by others.

19. On information and belief, Defendants regularly conduct and solicit business in, engage in other persistent courses of conduct in, and/or derive substantial revenue from goods and services provided to residents of this District and the State of Florida.

20. On information and belief, Defendants do continuous and systematic business in the State of Florida and this District, including advertising, using, offering for sale, or selling the Accused Products.

21. On information and belief, Defendants ACEP Group and ACEP France act through American Bright Signs Inc. (dba ACEP USA) to conduct business, solicit business, and commit infringement throughout the United States, including in the State of Florida, and in this District.

22. On information and belief, Defendant ACEP Group operates the ACEP website (<https://acep.tech/home.html>) which is publicly available throughout the United States, including in the State of Florida, and in this District, and is utilized to advertise, market, promote, offer to sell and/or sell the Accused Product. (*See Ex. C; see also ACEP Website at Contact Us (describing ACEP Group as “manager of this website.”)*)

23. On information and belief, Defendant ACEP Group has further sponsored courses available throughout the United States, including in the State of Florida, and in this District, which

courses are utilized by Defendants ACEP Group, ACEP France, and American Bright Signs Inc. (dba ACEP USA) to advertise, market, promote, offer to sell and/or sell the Accused Product.

24. On information and belief, Defendant ACEP France is the assignee of ACEP's United States patent application(s), which Defendants ACEP Group, ACEP France, and American Bright Signs Inc. (dba ACEP USA) use to advertise or market the Accused Product throughout the United States, including in the State of Florida, and in this District.

25. On information and belief, Defendant American Bright Signs Inc. (dba ACEP USA) is a subsidiary of ACEP France, which is a subsidiary of ACEP Group.

26. On information and belief, each of Defendants ACEP Group, ACEP France, and American Bright Signs Inc. (dba ACEP USA) directly advertise, market, promote, offer to sell and/or sell the Accused Product throughout the United States, including in the State of Florida, and in this District.

27. On information and belief, each of Defendants ACEP Group, ACEP France, and American Bright Signs Inc. (dba ACEP USA) directly profit from sales of the Accused Product throughout the United States, including in the State of Florida, and in this District.

28. Accordingly, Defendants have established minimum contacts with the forum and purposefully availed itself of the benefits of Florida, and the exercise of personal jurisdiction over Defendants would not offend traditional notions of fair play and substantial justice.

29. Venue is proper in this Court under 28 U.S.C. §§ 1391 and 1400(b) because Defendants are subject to personal jurisdiction in this District and have committed acts of patent infringement in this District. Defendants have a regular and established place of business, including at least 80 SW 8<sup>th</sup> St, STE 2000, Miami, FL, 33130 in this District. Defendants make, use, sell, market, promote and/or offer to sell the Accused Product within this District, including

via their website (<https://acep.tech/home.html>), through distributors, through direct sales and/or through trade shows. Defendants regularly do and solicit business in this District and have the requisite minimum contacts with the District such that this venue is a fair and reasonable one.

## **FACTUAL BACKGROUND**

### **I. Optikam's Patent**

30. Plaintiff Optikam solely owns all rights, titles, and interests in and to the '472 Patent, including the exclusive rights to bring suit with respect to any infringement thereof.

31. The '472 Patent entitled "System and Method of Obtaining Fit and Fabrication Measurements For Eyeglasses Using Depth Map Scanning" was duly and legally issued on February 14, 2023, by the United States Patent and Trademark Office ("USPTO").

32. The '472 Patent lists Bassem El-Hajal, Marco Lancione, Piotr Szymborski, and Luc Jalbert as inventors.

33. The '472 Patent was duly and legally issued from U.S. Patent Application No. 16/813,692 (the "'692 Application"), filed on March 9, 2020.

34. The '472 Patent claims priority to U.S. Patent Application No. 15/853,703, filed on December 22, 2017.

35. The '472 Patent claims patent-eligible subject matter and is valid and enforceable. The '472 Patent is presumed valid under 35 U.S.C. § 282.

36. The '472 Patent describes, *inter alia*, a system and method for determining the measurements needed by a lens fabricator to correctly fit prescription eyeglasses to an individual using a time-of-flight system (*e.g.*, Lidar systems) to scan the individual wearing the eyeglass frames producing at least one depth map, wherein the data from each depth map contains distance information between the time-of-flight scanner and the face. (Ex. A ('472 Patent) at *e.g.*, 2:59-

3:6.) Common measurement points are identified within one or more depth maps and utilized to calculate three-dimensional coordinates for the measurement points, and fabrication measurements are calculated between the various three-dimensional coordinates and used to fabricate prescription lenses. (*Id.* at 3:7-15.)

37. The novel systems and methods discovered by the Optikam inventors are reflected in exemplary claim 17 of the '472 Patent, which recites:

Claim 17. A method of obtaining measurements needed to correctly fabricate prescription lenses, said method comprising the steps of:

providing eyeglass frames into which said lenses are to be set;

providing an electronic device having a camera, a time-of-flight scanner, and a processor, wherein said processor runs application software that uses said time-of-flight scanner to measure scan distances between said time-of-flight scanner and an object being scanned;

scanning said eyeglass frames while being worn, therein producing at least one depth map, wherein said scan distances are in a first measurement scale;

identifying said common measurement points within said at least one depth maps utilizing said application software;

identifying said common measurement points in said at least one depth maps and said scan distances to generate three-dimensional coordinates for said measurement points in said first measurement scale; and

calculating fabrication measurements between said three dimensional coordinates in said first measurement scale utilizing said application software.

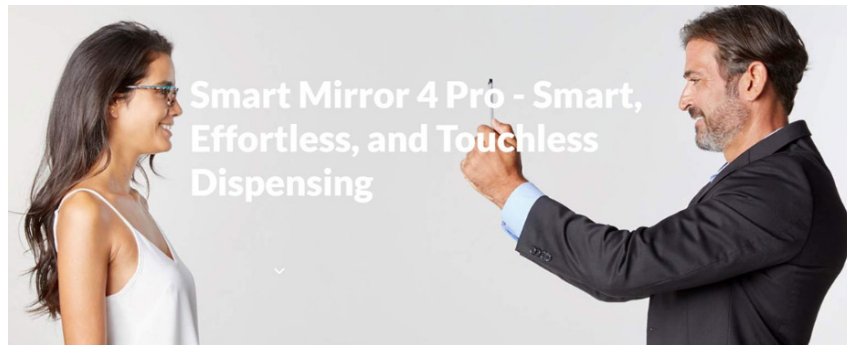
(*Id.* at 10:23-45 (claim 17).)

38. Optikam currently markets and sells its own product (the "OptikamPad") which practices the inventions claimed in the '472 patent and which compete directly in the United States market with the Accused Product. But for the infringement of the '472 Patent, any sales captured by Defendants would be captured by Optikam. As discussed herein, Optikam seeks at minimum such lost profits resulting from Defendants' infringement.

## II. The Accused Product (Defendants' Smart Mirror 4 Pro)

39. Based upon public information, Defendants make, use, sell, offer to sell, import, advertise, promote, and/or educate third parties (including its customers) regarding the Smart Mirror 4 Pro (the "Accused Product"), including via their website, through distributors, through direct sales and/or through trade shows. The use of the Accused Product infringes one or more claims of the '472 Patent, including but not limited to claim 17.

40. For example, according to public information, including a course sponsored by ACEP through the American Board of Opticianry (the "ACEP Course"), the "Smart Mirror 4 Pro" provides for "fast, convenient, precise, accurate, and safe measurements" and "takes the accurate and precise position of wear (POW) measurements without physical contact," as demonstrated below:



(See Ex. B (ACEP Course) available at <https://www.2020mag.com/ce/smart-mirror-4-pro---f>).

41. Moreover, based on public information, the Smart Mirror 4 Pro uses a "**LIDAR scanner**" to take digital measurements including but not limited to "pupillary distances, pupillary heights and vertex distance" and "without physical contact" and "without attachment(s)." (See Ex. C (<https://acep.tech/smart-mirror-4-pro.html>)). Based on public information the "Smart Mirror 4 Pro retains all the measurements needed to manufacture lenses according to the needs of each wearer" (*id.*), as demonstrated below:





(Ex. D.)

### III. ACEP's Direct and Indirect Infringement

42. Defendants make, use, sell, market, promote and/or offer to sell the Accused Product throughout the United States, including via the ACEP website (<https://acep.tech/home.html>), which website indicates it is managed by ACEP Group, and through distributors, through direct sales and/or through trade shows. As discussed herein, the use of the Accused Product infringes one or more claims of the '472 Patent, including but not limited to claim 17.

43. Defendants are not licensed to the '472 Patent, either expressly or implicitly, nor do they enjoy or benefit from any rights in or to the '472 Patent whatsoever. Defendants have never been authorized to practice the '472 Patent.

44. Defendants' unauthorized use of the inventions claimed in the '472 Patent allow for faster, more convenient, more accurate, and safer contactless measurements, which further drives sales of Defendants' products more broadly, including but not limited to the Accused Product.

45. Upon information and belief based upon public information, Defendants and third parties (including Defendants' customers) use the Accused Product to infringe one or more claims

of the '472 Patent, including claim 17. For example, the Accused Product is used by Defendants and third parties (including Defendant's customers) to calculate fabrication measurements by performing each of the following steps: (1) providing eyeglass frames into which lenses are to be set, (2) using an electronic device having a camera, a time-of-flight scanner, and a processor running software that uses the time-of-flight scanner to measure scan distances between the time-of-flight scanner and an object being scanned, (3) scanning the eyeglass frames while being worn to produce at least one depth map, wherein said scan distances are in a first measurement scale, (4) identifying common measurement points in the depth map(s) using the application software, (5) generating three-dimensional coordinates in the first measurement scale using said common measurement points and scan distances, and (6) calculating fabrication measurements between said three dimensional coordinates in the first measurement scale using the application software. (*See, e.g.*, Exs. B-D; *see also* Defendants' website (<https://acep.tech/home.html>).)

46. Upon information and belief based on public information, Defendants direct the end-users as to how to use the Accused Product, including to calculate fabrication measurements and/or fabricate lenses, which use infringes one or more claims of the '472 Patent, including claim 17.

47. Upon information and belief based on public information, Defendants are liable for direct infringement, literally and/or under the doctrine of equivalents, pursuant to 35 U.S.C. § 271(a), including based on Defendants' use of the Accused Product to calculate fabrication measurements in the United States using an infringing method.

48. Upon information and belief based on public information, Defendants are liable for induced infringement, literally and/or under the doctrine of equivalents, pursuant to 35 U.S.C. §

271(b), including based on Defendants' inducement of others to use the Accused Product to calculate fabrication measurements in the United States using an infringing method.

49. Upon information and belief based on public information, Defendants are liable for contributory infringement, literally and/or under the doctrine of equivalents, pursuant to 35 U.S.C. § 271(c), including based on Defendants offering to sell or selling within the United States or importing into the United States the Accused Product for use in practicing the claimed methods, knowing the Accused Product was a material part of the infringing method and knowing the same to be especially made or especially adapted for use in the infringing manner and not a staple article or commodity of commerce suitable for substantial non-infringing uses.

50. Upon information and belief based on public information, Defendants induce, direct, and instruct users of the Accused Product who perform every step of the claimed methods and directly infringe one or more claims of the '472 Patent, including claim 17. To the extent more than one entity is involved in performing the claimed methods, Defendants are liable for inducing or contributing to such divided infringement. Specifically, to the extent more than one entity is involved, each of the claimed steps are performed pursuant to a joint enterprise or at the direction or control of one entity.

#### **IV. Optikam's Notice of Infringement and Defendants' Knowing and Willful Infringement**

51. Upon information and belief, Defendants have been aware of the '472 Patent since on or near its date of issuance on February 14, 2023.

52. Upon information and belief, Defendants' infringement of the '472 Patent has been knowing, intentional, and willful since the date of issuance of the '472 Patent.

53. Further, Optikam provided Defendants with actual notice of the '472 Patent and the infringement alleged herein by sending a letter dated April 14, 2023 (“Optikam’s Notice Letter”) to Defendant ACEP Group.

54. The Optikam Notice Letter identified the '472 Patent to Defendants and described how the use of the Accused Product infringed the '472 Patent.

55. As of the date of this Complaint, Defendants have not provided any response to the Optikam Notice Letter and have continued to engage in its infringing acts unabated.

56. Defendants’ decision to continue making, advertising, promoting, offering to sell, selling, and/or importing the Accused Product in view of Optikam’s '472 Patent and its infringement allegations set forth in the April 14, 2023 Optikam Notice Letter is deliberate and egregious.

57. Thus, Defendants have been willfully infringing the '472 Patent at least since April 14, 2023.

**COUNT 1: INFRINGEMENT OF U.S. PATENT NO. 11,579,472**

58. Optikam repeats and re-alleges the allegations in the Paragraphs above as though fully set forth in their entirety.

59. The USPTO duly issued the '472 Patent on February 14, 2023 after full and fair examination of Application No. 16/813,692.

60. Optikam owns all substantial rights, interest, and title in and to the '472 Patent, including the sole and exclusive right to prosecute this action and enforce the '472 Patent against infringers, and to collect damages for all relevant times.

61. Pursuant to 35 U.S.C. § 282, the '472 Patent is presumed valid.

62. Defendants have directly infringed and continue to directly infringe, literally and/or under the doctrine of equivalents, one or more claims of the '472 Patent, including but not limited to claim 17, by using the Accused Product in a manner which infringes the claims.

63. Defendants have had knowledge of the '472 Patent since its issuance, and at least as of the date of Optikam's Notice Letter.

64. Defendants have also indirectly infringed and continue to indirectly infringe one or more claims of the '472 Patent, including at least claim 17, by inducing others to directly infringe the claims of the '472 Patent. Defendants have induced and continue to induce its subsidiaries, partners, affiliates, agents, customers, and/or end-users, to directly infringe, literally and/or under the doctrine of the equivalents, one or more claims of the '472 Patent by using the Accused Product. Defendants have taken active steps, directly and/or through contractual relationships with others, with the specific intent to cause them to use the Accused Product in a manner that infringes one or more claims of the '472 Patent, including, for example, claim 17. Such steps by Defendants include, among other things, advising or directing personnel, contractors, agents and/or end-users to use the Accused Product in an infringing manner; advertising and promoting the use of the Accused Product in an infringing manner; and/or distributing instructions that guide users to use the Accused Product in an infringing manner. Defendants are performing these steps, which constitute induced infringement, with knowledge of the '472 Patent and with knowledge that the induced acts constitute infringement. Defendants are aware that the normal and customary use of the Accused Product by others would infringe the '472 Patent. Defendants' inducement is ongoing.

65. Defendants have also indirectly infringed and continue to indirectly infringe by contributing to the infringement of one or more claims of the '472 Patent, including claim 17, by personnel, contractors, agents, customers, and/or other end users by encouraging them to use the

Accused Product to perform the steps of the patented process as described in one or more claims of the '472 Patent. The Accused Product has special features that are specifically designed to be used in an infringing way and that have no substantial uses other than for infringing one or more claims of the '472 Patent, including claim 17. The special features constitute a material part of the claimed invention of one or more claims of the '472 Patent and are not staple articles of commerce suitable for substantial non-infringing use. Defendants' contributory infringement is ongoing.

66. Defendants' actions are at least objectively reckless as to the risk of infringing a valid patent and this objective risk was known and/or should have been known by Defendants.

67. Defendants' direct and indirect infringement of the '472 Patent has been and continues to be willful, intentional, deliberate, and/or in conscious disregard of Optikam's rights under the '472 Patent.

68. Optikam has satisfied all statutory obligations required to collect pre-filing damages for the full period allowed by law for infringement of the '472 Patent.

69. Optikam has been damaged and continues to be damaged, including in the form of lost profits, as a result of the infringing conduct by Defendants alleged above.

70. Thus, Defendants are liable to Optikam in an amount that compensates it for such infringement, which by law cannot be less than a reasonable royalty, together with interest and costs as fixed by this Court under 35 U.S.C. § 284.

71. Optikam has suffered and continues to suffer irreparable harm, including through its loss of market share and goodwill, for which there is no adequate remedy at law. Optikam has and will continue to suffer this harm by virtue of Defendants' infringement of one or more claims of the '472 Patent. Defendants' actions have interfered with and will interfere with Optikam's ability to gain market share. The balance of hardships favors Optikam's ability to commercialize

its own patented technology. The public interest in allowing Optikam to enforce its right to exclude outweighs other public interest, which supports injunctive relief in this case.

**JURY DEMAND**

72. Optikam hereby requests a trial by jury on all issues so triable by right

**PRAYER FOR RELIEF**

WHEREFORE, Plaintiff Optikam respectfully requests the following relief:

- a. A judgment that Defendants have directly infringed, literally and/or under the doctrine of equivalents, and continue to directly infringe the Asserted Patent;
- b. A judgment that Defendants have indirectly infringed, including by inducing and/or contributing to infringement, literally and/or under the doctrine of equivalents, and continue to indirectly infringe the Asserted Patent;
- c. A permanent injunction restraining and enjoining Defendants and all persons, including its officers, directors, agents, servants, affiliates, employees, divisions, branches, subsidiaries, parents, and all others acting in active concert or participation therewith, from infringing the Asserted Patent, including by making, using, offering to sell, and/or selling in the United States and/or importing into the United States the Accused Product.
- d. That Plaintiff be awarded damages adequate to compensate it for Defendants' past, present, and/or future infringement of the '472 Patent, said damages being no less than a reasonable royalty and/or lost profits together with any pre-judgment and post-judgment interest as allowed by law, costs, and other damages permitted by 35 U.S.C. § 284;

- e. A judgment finding that Defendants' infringement of the Asserted Patent has been deliberate and willful, and an increased award of up to treble damages to Plaintiff pursuant to 35 U.S.C. § 284;
- f. A declaration that this is an exceptional case and an award of attorneys' fees pursuant to 35 U.S.C. § 285;
- g. An award of costs and expenses in this action; and
- h. Such other and further relief as the Court may deem just and proper.

Dated: September 19, 2023

Respectfully submitted,

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