

1 OTTO O. LEE, CA Bar No. 173987
olee@iplg.com
2 KEVIN VIAU, CA Bar No. 275556
kviau@iplg.com
3 INTELLECTUAL PROPERTY LAW GROUP LLP
1871 The Alameda, Suite 250
4 San Jose, California 95126
Telephone: (408) 286-8933
5 Facsimile: (408) 286-8932

6 *Attorneys for Plaintiffs*

7
8 **IN THE UNITED STATES DISTRICT COURT**
9 **FOR THE NORTHERN DISTRICT OF CALIFORNIA**

10 HONWELL PRODUCTS (HK) LIMITED, a
11 Hong Kong Corporation, and DONGGUAN
12 HONWELL ELECTRONICS INDUSTRIAL
CO., LTD., a China Corporation.

13 Plaintiffs,

14 v.

15 PERCH ACQUISITION CO 12, LLC, a
16 Delaware Corporation, PERCH ACQUISITION
17 CO 36, LLC, a Delaware Corporation, WHELE,
18 LLC, a Delaware Corporation, RAZOR
GROUP GmbH, a Germany Company,
19 LONDON JOHNSON, INC., a Texas
20 Corporation, BRIAN P. JOHNSON, an
Individual, and DOES 1 through 25, inclusive,

21 Defendants.

Case No.:

**COMPLAINT FOR DECLARATORY
JUDGMENT OF PATENT INVALIDITY AND
UNENFORCEABILITY**

22
23 Plaintiffs Honwell Products (HK) Limited and Dongguan Honwell Electronics Industrial Co.,
24 Ltd., for their Complaint against Defendants Perch Acquisition Co 12, LLC, Perch Acquisition Co
25 36, LLC, Whele, LLC, Razor Group GmbH, London Johnson, Inc., and Brian P. Johnson
26 (collectively, "Defendants"), hereby alleges as follows:
27
28

Case No.:
COMPLAINT

Honwell v. Perch, et al.

PARTIES

1
2 1. Plaintiff Honwell Products (HK) Limited (“HONWELL”) is a Hong Kong
3 corporation, with its principal place of business at Flat H, 16/F, Block 7, Tierra Verde, No. 33 Tsing
4 King Road, Tsing Yi, Hong Kong.

5 2. Plaintiff Dongguan Honwell Electronics Industrial Co., Ltd. (“DONGGUAN”), a
6 sister company of HONWELL, is a China corporation, with its principal place of business at No.3,
7 Xiaolong Road, Yuan Shan Bei Village, Changping Town, Dongguan City, Guangdong, China.

8 3. On information and belief, Defendant Perch Acquisition Co 12, LLC (“PERCH”) is a
9 Delaware corporation with its principal place of business at 251 Little Falls Drive, Wilmington, DE
10 19808 doing business in and with the State of California and this District.

11 4. On information and belief, Defendant Perch Acquisition Co 36, LLC (“PERCH”) is a
12 Delaware corporation with its principal place of business at 251 Little Falls Drive, Wilmington, DE
13 19808 doing business in and with the State of California and this District.

14 5. On information and belief, Defendant Whele, LLC (“WHELE”), the holding company
15 of Perch Acquisition Co 12, LLC and Perch Acquisition Co 36, LLC, is a Delaware corporation with
16 its principal place of business at 251 Little Falls Drive, Wilmington, DE 19808 doing business in and
17 with the State of California and this District.

18 6. On information and belief, Defendant Razor Group GmbH (“RAZOR”), the company
19 which acquired WHELE, is a German limited liability company with its principal place of business at
20 Ritterstraße 16-18, 10969 Berlin, Germany doing business in and with the state of California and this
21 District.

22 7. On information and belief, Defendant London Johnson, Inc. (“LJ”) is a Texas
23 corporation with its principal place of business at 4525 Cole Ave. Unit 1534, Dallas, TX 75205 doing
24 business in and with State of California and this District.

25 8. On information and belief, Defendant Brian P. Johnson is an individual who resides in
26 Dallas, TX, United States.

27 9. On information and belief, Defendant Brian P. Johnson is the owner of LJ.
28

INTELLECTUAL PROPERTY LAW GROUP LLP
1871 The Alameda, Suite 250
San Jose, California 95126

1 10. On information and belief, Defendants DOES 1 through 25, inclusive, are other parties
2 not yet identified who have contributed to the fraudulent filing of the subject patents or have engaged
3 in one or more of the wrongful practices alleged herein. The true names, whether corporate,
4 individual or otherwise, of Defendants 1 through 25, inclusive, are presently unknown to Plaintiff,
5 which therefore sues said Defendants by such fictitious names, and will seek leave to amend this
6 Complaint to show their true names and capacities when same have been ascertained.

7 11. On information and belief, at all times relevant hereto each of the Defendants was the
8 agent, affiliate, officer, director, manager, principal, alter-ego, and/or employee of the remaining
9 Defendants and was at all times acting within the scope of such agency, affiliation, alter-ego
10 relationship and/or employment; and actively participated in or subsequently ratified and/or adopted
11 each of the acts or conduct alleged, with full knowledge of all the facts and circumstances, including,
12 but not limited to, full knowledge of each violation of Plaintiff’s rights and the damages to Plaintiff
13 proximately caused thereby.

NATURE OF THIS ACTION

14
15 12. This is an action for declaratory judgment of invalidity and unenforceability arising
16 under the patent laws of the United States, Title 35 of the United States Code relating to the
17 following patents:

- 18 (i) U.S. Patent No. D827,606;
19 (ii) U.S. Patent No. D797,963 (“the ‘963 patent”);
20 (iii) U.S. Patent No. D904,667 (“the ‘667 patent”);
21 (iv) U.S. Patent No. D932,679 (“the ‘679 patent”);
22 (v) U.S. Patent No. D851,789 (“the ‘789 patent”);
23 (vi) U.S. Patent No. D903,927 (“the ‘927 patent”);
24 (vii) U.S. Patent No. D933,281 (“the ‘281 patent”);
25 (viii) U.S. Patent No. D828,606;
26 (ix) U.S. Patent No. D933,039 (“the ‘039 patent”);
27 (x) U.S. Patent No. D825,792 (“the ‘792 patent”);
28 (xi) U.S. Patent No. D869,291 (“the ‘291 patent”);

- 1 (xii) U.S. Patent No. D927,463 (“the ‘463 patent”);
- 2 (xiii) U.S. Patent No. D857,963 (“the ‘963 patent”);
- 3 (xiv) U.S. Patent No. D936,265 (“the ‘265 patent”);
- 4 (xv) U.S. Patent No. D827,619 (“the ‘619 patent”);
- 5 (xvi) U.S. Patent No. D806,677 (“the ‘677 patent”);
- 6 (xvii) U.S. Patent No. D965,196 (“the ‘196 patent”);
- 7 (xviii) U.S. Patent No. D979,537 (“the ‘537 patent”);
- 8 (xix) U.S. Patent No. D979,538 (“the ‘538 patent”);
- 9 (xx) U.S. Patent No. D996,395 (“the ‘395 patent”);
- 10 (xxi) U.S. Patent No. D999,187 (“the ‘187 patent”); and
- 11 (xxii) U.S. Patent No. D1002066 (“the ‘066 patent”) (collectively, “the patents-in-suit”). A

12 true and correct copy of the patents-in-suit are attached hereto as Exhibit 1.

13 **JURISDICTION, VENUE AND INTRADISTRICT ASSIGNMENT**

14 13. The Court has subject matter jurisdiction pursuant to 28 U.S.C. §§ 1331 and 1338.

15 14. This Court has personal jurisdiction over Defendants under the California long-arm
16 statute because the issuance of the patents-in-suit has caused harm to Plaintiff in this District and as,
17 on information and belief, Defendants have made significant sales of products practicing the patents-
18 in-suit in California and this District. On information and belief, Defendants and each of them have
19 conducted significant commercial activities in California and this District, obtained significant
20 revenues and profits in and from California and this District derived specifically from sales of
21 products practicing the patents-in-suit, and purposefully directed significant actions directly related to
22 the patents-in-suit to California and this District including by, on information and belief, claiming
23 ownership of the patents-in-suit in California and this District, thereby making the exercise of
24 jurisdiction over Defendant fair and reasonable, generally and/or specifically.

25 15. Venue is proper in this District under 28 U.S.C. § 1391(b) and (c), as alleged directly
26 hereinabove. On information and believe, Defendants and each of them have transacted significant
27 business in this District with respect to products practicing the patents-in-suits. On information and
28 belief, Defendants have claimed ownership of the patents-in-suit in this District. Venue is proper as a

1 substantial part of the events or omissions giving rise to the claim occurred in this District. Venue is
2 further appropriate as the Defendants are subject to personal jurisdiction in this District as alleged
3 above.

4 16. This is an Intellectual Property Action subject to district-wide assignment in San
5 Francisco, Oakland, or San Jose pursuant to Civil Local Rule 3-2(c).

6 **FACTUAL BACKGROUND**

7 17. In or around 2015, HONWELL started to sell products to LJ, including lighting and
8 sound devices and their accessories.

9 18. From the start of HONWELL and LJ’s business relationship, an implied agreement
10 between HONWELL and LJ existed that HONWELL is the sole owner of all intellectual property
11 rights related to the products sold by HONWELL, including copyright and patent rights in the
12 designs of the products (the implied contractual “Term”).

13 19. From the start of HONWELL and LJ’s business relationship, an implied agreement
14 between HONWELL and LJ existed that the designs of the patents-in-suit belong to HONWELL
15 while LJ will have the exclusive right to sell in the United States on the condition that (i) LJ and its
16 successor-in-business must place “all” purchase orders with HONWELL; (ii) the patents-in-suit were
17 made for the protection of HONWELL’S product designs in the United States; and (iii) LJ re-assigns
18 the patents-in-suit to HONWELL upon HONWELL’s request.

19 20. At a time unbeknownst to HONWELL, LJ or part of LJ’s business was acquired by a
20 subsidiary of Whele LLC (“WHELE”), namely PERCH.

21 21. It was understood that upon PERCH’s acquisition of LJ or part of LJ’s business,
22 PERCH would also be agreeable to the Term.

23 22. After the acquisition, PERCH and/or WHELE continued to purchase products from
24 HONWELL in the past two years. The last purchase order PERCH/WHELE placed with
25 HONWELL took place about three months ago.

26 23. PERCH and/or WHELE purchased products from DONGGUAN on at least May 16,
27 2023.

28

INTELLECTUAL PROPERTY LAW GROUP LLP
1871 The Alameda, Suite 250
San Jose, California 95126

1 24. It was recently discovered that LJ had registered design patents in the United States,
2 patents (i)-(xvi), without HONWELL’s consent, and later, PERCH/WHELE also registered design
3 patents in the United States, patents (xvii)-(xxii) without HONWELL’s consent.

4 25. Around September 18, 2023, HONWELL discovered that PERCH/WHELE has been
5 offering for sale and selling a lighting product through Amazon protected under at least the
6 invalid/unenforceable U.S. Patent No. D828,606.

7 26. On or around September 18, 2023, HONWELL sent a letter to PERCH/WHELE
8 stating that at least U.S. Patent No. D828,606 was secretly procured without HONWELL’s
9 knowledge.

10 27. Upon filing the application that matured into U.S. Patent No. D828,606, Brian P.
11 Johnson executed a declaration that stated, “I believe that I am the original inventor or an original
12 joint inventor of a claimed invention in the application.” U.S. Patent No. D828,606 Inventor
13 Declaration, attached hereto as Exhibit 2. The declaration notes, “I hereby acknowledge that any
14 willful false statement made in this declaration is punishable under 18 U.S.C. 1001 by fine or
15 imprisonment of not more than five (5) years, or both.” *Id.*

16 28. Brian P. Johnson is not the correct inventor of U.S. Patent No. D828,606.

17 29. Mr. Tang Kong Kin is the inventor or co-inventor of at least U.S. Patent No.
18 D828,606.

19 30. On or around September 29, 2023, HONWELL sent a letter to PERCH stating that at
20 least the ‘196 patent, the ‘537 patent, and the ‘538 patent have been secretly procured without
21 HONWELL’S knowledge.

22 31. Upon filing the applications that matured into the ‘196 patent, the ‘537 patent, and the
23 ‘538 patent, Brian P. Johnson executed a declaration that stated, “I believe that I am the original
24 inventor or an original joint inventor of a claimed invention in the application.” The ‘196 patent, the
25 ‘537 patent, and the ‘538 patent Inventor Declaration, attached hereto as Exhibit 3. The declaration
26 notes, “I hereby acknowledge that any willful false statement made in this declaration is punishable
27 under 18 U.S.C. 1001 by fine or imprisonment of not more than five (5) years, or both.” *Id.*
28

1 32. Brian P. Johnson is not the correct inventor of the ‘196 patent, the ‘537 patent, and the
2 ‘538 patent.

3 33. Mr. Tang Kong Kin is the inventor or co-inventor of at least the ‘196 patent, the ‘537
4 patent, and the ‘538 patent.

5 34. Brian P. Johnson is not the correct inventor of the patents-in-suit, which include U.S.
6 Patent No. D828,606, the ‘196 patent, the ‘537 patent, and the ‘538 patent.

7 35. The patents-in-suit are invalid for failure to name the correct inventor or inventors.

8 36. The patents-in-suit are unenforceable for failure to name the correct inventor or
9 inventors.

10 37. Employees of HONWELL and HONWELL factories are correct inventors or co-
11 inventors of the patents-in-suit, including but not limited to, Zhang Zhen Xing and Jimi Pang.

12 38. An employee, including but not limited to, Ivan Yu, of a designing company Focus
13 Product Design is the correct inventor or co-inventor of the patents-in-suit.

14 39. A commissioned designer, including but not limited to, Ben Lai, is the correct inventor
15 or co-inventor of the patents-in-suit.

16 40. HONWELL perceives an idea for a product and creates concept drawings without
17 assistance/contribution of outsiders, including LJ.

18 41. HONWELL publishes the concept drawings to LJ.

19 42. Upon LJ’s interest, HONWELL creates prototype drawings and publishes the
20 prototype drawings to the factory for a quotation.

21 43. The factory publishes the prototypes to HONWELL and HONWELL delivers the
22 prototypes to LJ for placement of the purchase orders.

23 44. The concept drawings and the prototype drawings are closely similar.

24 45. The relationship between HONWELL and LJ is that of a buyer/customer only.

25 46. LJ and/or Brian P. Johnson are not involved in the design process.

26 47. LJ and/or Brian P. Johnson only selects which products they want to buy.

27 48. HONWELL designs the products disclosed in the patents-in-suit and LJ/Brian P.
28 Johnson, as a customer, purchases the products and resells them.

INTELLECTUAL PROPERTY LAW GROUP LLP
1871 The Alameda, Suite 250
San Jose, California 95126

1 49. LJ and/or Brian P. Johnson have never been involved in the design of the products
2 disclosed in the patents-in-suit.

3 50. There is an exclusive buy-sale relationship rather than co-inventorship relationship
4 between HONWELL and Brian P. Johnson.

5 51. Upon filing the applications that matured into the patents-in-suit, Brian P. Johnson
6 executed a declaration that stated, “I believe that I am the original inventor or an original joint
7 inventor of a claimed invention in the application.” The patents-in-suit Inventor Declaration, attached
8 hereto as Exhibit 4. The declaration notes, “I hereby acknowledge that any willful false statement
9 made in this declaration is punishable under 18 U.S.C. 1001 by fine or imprisonment of not more
10 than five (5) years, or both.” *Id.*

11 52. Employees of HONWELL and HONWELL factories, an employee of a designing
12 company, Focus Product Design and a commissioned designer are the correct inventors or co-
13 inventors of the patents-in-suit.

14 53. Based on HONWELL and LJ’s business relationship, implied agreement,
15 HONWELL’s business practices, HONWELL’s lack of notice of LJ patent filings, and HONWELL’s
16 lack of notice of PERCH/WHELE selling products protected under the invalid/unenforceable patents-
17 in-suit, Brian P. Johnson is either not the inventor or not the sole inventor of the patents-in-suit, and
18 all declarations of inventorship are false, rendering the patents-in-suit invalid, unenforceable, or both.

19 54. The one-year grace period for U.S. patent filings for the inventor’s own public
20 disclosures does not apply to Brian P. Johnson because he is not the correct inventor.

21 55. For all these reasons, an actual justiceable case or controversy exists between
22 HONWELL and Defendants regarding the validity and unenforceability of the patents-in-suit.

23 **CLAIM I**

24 **Declaration of Invalidity of the Patents-In-Suit**

25 56. Plaintiffs re-allege and incorporate by reference the allegations in each of the
26 preceding paragraphs as if fully set forth herein.

27 57. PERCH/WHELE claims to own all rights, titles, and interests in the patents-in-suit.
28

INTELLECTUAL PROPERTY LAW GROUP LLP
1871 The Alameda, Suite 250
San Jose, California 95126

1 58. There is an agreement between LJ and HONWELL that the patents-in-suit will be re-
2 assigned to HONWELL.

3 59. Brian P. Johnson is the sole named inventor of the patents-in-suit.

4 60. The actual inventors of the patents-in-suit are employees of HONWELL and
5 HONWELL factories, employee of Focus Product Design, and/or a commissioned designer.

6 61. The correct inventor or inventors of an invention that is the subject of a patent is
7 material to that patent.

8 62. Plaintiffs have been damaged and continue to be damaged as a result of the fraudulent
9 patent registration and intentional conduct by Defendants as alleged herein.

10 63. A substantial, immediate, and real controversy therefore exists between HONWELL,
11 DONGGUAN and Defendants as to whether the patents-in-suit are invalid under the provisions of 35
12 U.S.C. § 101 et seq, including as a result of anticipation, obviousness, and failure to name the correct
13 inventive entity. A judicial declaration is necessary to determine the validity of the patents-in-suit.

14 64. It is therefore necessary that this Court provide and enter declaratory relief on behalf
15 of Plaintiffs under 28 U.S.C. § 2201 finding invalidity of the patents-in-suit.

16 65. If this Court does not enter the Declaratory Relief requested by Plaintiffs, the certain
17 Plaintiffs will suffer significant additional injury and irreparable harm as a result of Defendants’
18 continued use of the patents-in-suit in violation of Plaintiffs’ legal rights over the patents-in-suit.

19 **CLAIM II**

20 **Declaration of Unenforceability of the Patents-In-Suit**

21 66. Plaintiffs re-allege and incorporate by reference the allegations in each of the
22 preceding paragraphs as if fully set forth herein.

23 67. PERCH/WHELE claims to own all rights, titles, and interests in the patents-in-suit.

24 68. Brian P. Johnson is the sole named inventor of the patents-in-suit, to which he
25 assigned his rights to PERCH/WHELE.

26 69. Brian P. Johnson executed inventor declarations in association with the applications
27 that issued as the patents-in-suit stating that he “is the original inventor” of the claimed invention.

28 Brian P. Johnson is not the inventor of the inventions claimed in the patents-in-suit and executed his

1 declarations knowing it was false, and he did so with intent to deceive the U.S. Patent and Trademark
2 Office.

3 70. HONWELL has information and evidence that the correct inventor of the design
4 claimed in the patents-in-suit were employees of HONWELL and HONWELL factories - Zhang
5 Zhen Xing and Jimi Pang, an employee of a designing company, Focus Product Design - Ivan Yu,
6 and/or a commissioned designer - Ben Lai.

7 71. The correct inventor or inventors of an invention that is subject of a patent is material
8 to that patent.

9 72. A substantial, immediate, and real controversy therefore exists whether the patents-in-
10 suit are unenforceable due to inequitable conduct for failure to name the correct inventor or inventors.
11 A judicial declaration is necessary to determine the parties' respective rights regarding the
12 enforceability of the patents-in-suit.

13 **PRAYER FOR RELIEF**

14 WHEREFORE, Plaintiffs pray for judgment against Defendants as follows:

15 73. For a declaratory judgment that the patents-in-suit registered by Defendants are
16 invalidated.

17 74. For an order and judgment finding that this case is an exceptional one pursuant to 35
18 U.S.C. § 285 and that Plaintiffs be awarded their fees, costs, expenses, and disbursements incurred in
19 relation to this action, including their reasonable attorneys' fees and investigative expenses.

20 75. For an order and judgment sustaining each of the causes of actions set forth herein
21 against Defendants.

22 76. For an order and judgment requiring Defendants to pay such other damages and
23 monetary relief as the Court deems fit under the circumstances, or as may be sought by Plaintiffs
24 according to proof at trial; and

25 77. For any and all other relief as the Court deems just and reasonable.
26
27
28

1
2
3
4
5
6
7
8
9
10
11
12
13
14
15
16
17
18
19
20
21
22
23
24
25
26
27
28

Respectfully submitted,

Dated: August 14, 2024

By: /s/ Otto O. Lee
Otto O. Lee
Kevin Viau
INTELLECTUAL PROPERTY LAW GROUP LLP
1871 The Alameda, Suite 250
San Jose, California 95126
Telephone: (408) 286-8933
Facsimile: (408) 286-8932

Attorneys for Plaintiffs

INTELLECTUAL PROPERTY LAW GROUP LLP
1871 The Alameda, Suite 250
San Jose, California 95126