

# ADDENDUM

## ADDENDUM INDEX

SOURCE or ECF NO.	DESCRIPTION OF DOCUMENT	ADD. NO.
56	TEXT ORDER on briefing Emergency Motion to Set Bond and Stay Enforcement of Judgment Pending Appeal	ADD0001- ADD0002
43	ORDER granting Motion for Attorneys' Fees and Sanctions	ADD0003- ADD0038
42	ORDER regarding OSC and Imposing Sanctions on Ramey Firm Lawyers	ADD0039- ADD0082
10	CONSENT/DECLINATION to Proceed Before a US Magistrate Judge by Koji IP, LLC. (Kalra, Susan) (Filed on 6/10/2024)	ADD0083
12	NOTICE of Voluntary Dismissal <i>Notice of Voluntary Dismissal WITH Prejudice</i> by Koji IP, LLC (Kalra, Susan)	ADD0084- ADD0085
17	MOTION for leave to appear in Pro Hac Vice <i>by Benjamin Charkow for Defendant Renesas Electronics America Inc.</i> filed by Renesas Electronics America, Inc.	ADD0086- ADD0087
18	MOTION for Attorney Fees filed by Renesas Electronics America, Inc.	ADD0088- ADD0114
19-1	January 12, 2024 Email	ADD0265- ADD0270
20	CONSENT/DECLINATION to Proceed Before a US Magistrate Judge by Renesas Electronics America, Inc. (Crotty, Jason) (Filed on 6/26/2024)	ADD0735
22	Order by Magistrate Judge Peter H Kang granting in part 21 Joint Stipulation for Extension of Time. Response due July 31, 2024;	ADD0736- ADD0739

	Reply due August 14, 2024; In-Person Motion Hearing RESET for August 22, 2024 at 10:30 AM in San Francisco, Courtroom F.	
24-2	Declaration of William P. Ramey, III	ADD0740- ADD0745
24-8	Renasas Motion to Dismiss Koji's Plaintiff's Original Complain in Case 1:23-cv-01674-SKC, In the US District Court of Colorado	ADD0746- ADD0763
27	ORDER TO SHOW CAUSE. In-Person Hearing set for September 19, 2024 at 10:30 AM in San Francisco, Courtroom F, 15th Floor. Responses due September 12, 2024. Signed by Judge Peter H. Kang on 08/29/24.	ADD0764- ADD0779
28	RESPONSE TO ORDER TO SHOW CAUSE by Koji IP, LLC	ADD0780- ADD0808
28-1	Declaration of Susan Kalra In Support of Show Cause Order	ADD0809- ADD0817
28-2	Declaration of William P. Ramey, III In Support of Show Cause Order	ADD0818- ADD0828
28-3	Email chain July 11, 2023	ADD0829- ADD0833
28-4	Email chain July 20, 2023	ADD0834- ADD0836
28-9	Plaintiff's First Amended Complaint	ADD0837- ADD0920
28-12	Email chain January 30, 2024	ADD0921- ADD0924
28-13	Claim Chart for US Patent 10,790,703	ADD0925- ADD0935
28-14	May 31, 2024 Letter to William Ramey from Jason Crotty	ADD0936- ADD0973

28-15	Declaration of Jeffrey E. Kubiak In Support of Show Cause Order	ADD0974- ADD0987
28-17	Declaration of Carlos Gorrichategui	ADD0988- ADD0990
30	<b>**AMENDED**</b> Minute Entry for proceedings held before Magistrate Judge Peter H Kang: Show Cause Hearing held on 9/19/2024. Discussion held regarding Plaintiff's Show Cause Response. Court to issue written order. Matter submitted by all Parties. (This is a text-only entry generated by the court. There is no document associated with this entry.)	ADD0991- ADD0992
51-3	Declaration of Carlos Gorrichategui	ADD0993- ADD0995
52	MOTION Objection to set aside the Magistrates Order re 42 Order CORRECTED filed by Koji IP, LLC	ADD0996- ADD1022
52-2	Declaration of William P. Ramey, III to Objection	ADD1023- ADD1027
52-3	Transcript of September 19, 2024 Show Cause Hearing	ADD1028- ADD1097
52-7	Email chain from April 4, 2025	ADD1098- ADD1099
52-16	Declaration of Susan Kalra Administrative Motion to File Excess Pages	ADD1100- ADD1110
54	Emergency Motion to Set Bond and Stay Enforcement of Judgment Pending Appeal re 43 Order on Motion for Attorney Fees	ADD1111- ADD1128

54-3	Declaration of William P. Ramey, III	ADD1129- ADD1133
50	Stipulation and [proposed] Order to Amend Schedule in Case No. 3:24-cv-02996-CRB, <i>IN RE DREAMLAND BABY CO. WEIGHTED SLEEP PRODUCTS LITIGATION</i> , In the Northern District of California	ADD1134- ADD1139
294	PARTIES' PROPOSED AGENDA FOR CASE MANAGEMENT CONFERENCE NUMBER 6 (FEBRUARY 20, 2025) in Case No. 23-md-03087-BLF, <i>IN RE: FUTURE MOTION, INC. PRODUCTS LIABILITY LITIGATION</i> , In the Northern District of California	ADD1140- ADD1156
1-2	FIRST AMENDED CONSOLIDATED CLASS ACTION COMPLAINT in Case No. 3:23-cv-01033-RS, <i>IN RE BETTERHELP, INC. DATA DISCLOSURE CASES</i> , In the Northern District of California	ADD1157- ADD1161
53	Notice of Appeal	ADD1162- ADD1164
51	MOTION FOR RELIEF FROM NONDISPOSITIVE PRETRIAL ORDER OF MAGISTRATE JUDGE	ADD1165- ADD1189
57	Motion for Relief from Nondispositive Pretrial Order of Magistrate Judge	SADD1190- SADD1196
60	ORDER on Emergency Motion to Set Bond and Stay Enforcement of Judgment Pending Appeal	SADD1197- SADD1198
61	Modified ORDER on Emergency Motion to Set Bond and Stay Enforcement of Judgment Pending Appeal	SADD1199- SADD1200
15	ORDER Denying Application to Appear Pro Hac Vice and Order to Show Cause Why Sanctions Should Not Be Imposed in Case No. 3:25-cv-01842-LJC <i>Cooperative</i>	SADD1201- SADD1205

	<i>Entertainment, Inc. v. Alibaba Cloud US LLC</i> , Northern District of California	
16	Corrected Application to Appear Pro Hac Vice in Case No. 3:25-cv-01842-LJC <i>Cooperative Entertainment, Inc. v. Alibaba Cloud US LLC</i> , Northern District of California	SADD1206- SADD1290
5	Emergency Motion to Stay Enforcement of Penal Sanctions Pending Appeal From Case No. 25-1639 In the Federal Circuit Court of Appeals	SADD1291- SADD1326
71	Plaintiff's Notice of Filing Application with The United States Supreme Court in Case No. 3:24-cv-030389 In the Northern District of California	SADD1327- SADD1328
13	Notice of Application to the United State Supreme Court filed in the Case No. 25-1639 In the Federal Circuit Court of Appeals	SADD1329- SADD1333

**From:** ECF-CAND@cand.uscourts.gov  
**Sent:** Wednesday, April 9, 2025 9:06 PM  
**To:** efiling@cand.uscourts.gov  
**Subject:** Activity in Case 3:24-cv-03089-PHK Koji IP, LLC v. Renesas Electronics America, Inc.  
Order Setting Hearing on Motion

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**U.S. District Court**

**California Northern District**

**Notice of Electronic Filing**

The following transaction was entered on 4/9/2025 at 7:05 PM and filed on 4/9/2025

**Case Name:** Koji IP, LLC v. Renesas Electronics America, Inc.

**Case Number:** [3:24-cv-03089-PHK](#)

**Filer:**

**Document Number:** 56(No document attached)

**Docket Text:**

**[IN-CHAMBERS TEXT ONLY ORDER]:** The Court has received the [54] Emergency Motion to Set Bond and Stay Enforcement of Judgment Pending Appeal, which includes a request for expedited briefing from the Parties. The Court **ORDERS** Defendant to file a response (no longer than five pages in length) regarding only that portion of the Emergency Motion specifically addressed to the issue of the request for expedited briefing, including any issues under Civil Local Rules 7-10 and 7-11, setting forth Defendant's views on whether expedited briefing is necessary and/or appropriate, by no later than April 11, 2025. Unless and until the Court orders otherwise, the default briefing schedule under Civil Local Rule 7-3 **SHALL** remain in effect for the opposition and reply briefing on the substance of the Emergency Motion. An in-person hearing on the [54] Emergency Motion is **SET** for May 6, 2025 at 2:00 p.m. in Courtroom F on the 15th floor of the San Francisco courthouse. No remote appearances will be granted. Signed by Judge Peter H. Kang on 04/09/2025. *(This is a text-only entry generated by the court. There is no document associated with this entry.)* (phk1c2, COURT STAFF) (Filed on 4/9/2025)

3:24-cv-03089-PHK Notice has been electronically mailed to:

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**3:24-cv-03089-PHK Please see [Local Rule 5-5](#); Notice has NOT been electronically mailed to:**



UNITED STATES DISTRICT COURT  
NORTHERN DISTRICT OF CALIFORNIA  
SAN FRANCISCO DIVISION

KOJI IP, LLC,

Plaintiff,

v.

RENESAS ELECTRONICS AMERICA,  
INC.,

Defendant.

Case No. [24-cv-03089-PHK](#)

**ORDER GRANTING MOTION FOR  
ATTORNEYS' FEES AND SANCTIONS**

Re: Dkt. 18

“Exceptional cases are, by definition, the exception. But since *Octane's* change in the standard, the rule seems to be for prevailing parties to bring an exceptional case motion. This case is no exception. But it is exceptional.” *Universal Elecs., Inc. v. Universal Remote Control, Inc.*, No. SACV 12-00329 AG (JPRx), 2015 WL 12733442, at \*1 (C.D. Cal. Mar. 10, 2015), *aff'd*, 669 F. App'x 575 (Fed. Cir. Oct. 17, 2016).

This is the third in a series of identical patent infringement actions brought by Plaintiff Koji IP, LLC (“Koji”)—represented by the Ramey law firm—against Defendant Renesas Electronics America, Inc. (“REA”), asserting the exact same patent in each case. *See* Dkt. 1. The Parties have consented to proceed before a Magistrate Judge for all purposes, including the entry of a final judgment under 28 U.S.C. § 636(c). [Dkt. 10; Dkt. 20].

After the filing of this lawsuit and after the Parties exchanged correspondence, Koji filed a notice of voluntary dismissal with prejudice under Federal Rule of Civil Procedure 41(a)(1)(A)(i). [Dkt. 12]. Now before the Court is REA’s motion for attorneys’ fees under 35 U.S.C. § 285 and requesting that those fees be levied against not just Koji but also Koji’s counsel jointly and severally under 28 U.S.C. § 1927 and the Court’s inherent authority. [Dkt. 18]. Koji has filed an

ADD0003

1 opposition to REA’s motion and REA has filed a reply. [Dkt. 24; Dkt. 25]. The Court heard oral  
2 argument on the instant motion on August 22, 2024. *See* Dkt. 26. Having reviewed the Parties’  
3 written submissions and oral arguments, the Court **GRANTS** the motion in light of applicable  
4 legal standards for the reasons discussed herein.

5 On March 26, 2025, the Court issued an Order sanctioning Koji’s counsel in this matter.  
6 [Dkt. 27]. That Order discusses the procedural history and course of conduct in this case in further  
7 detail. Familiarity with that concurrently issued Order is assumed, and the factual discussion in  
8 that Order is incorporated herein.

### 9 **BACKGROUND**

10 Koji is the owner by assignment of U.S. Patent No. 10,790,703 (“the ’703 Patent”). The  
11 ’703 Patent, entitled “Smart Wireless Power Transfer Between Devices,” relates generally to a  
12 wireless power transfer system consisting of a “powering device” that is configured to wirelessly  
13 charge a “powered device.” The claims are, in general, directed to controlling wireless charging  
14 operations performed by the powering device based on how the charging operation affects the  
15 battery used to power the powering device.

16 On June 30, 2023, Koji—represented by the Ramey law firm—filed the first of three  
17 patent infringement lawsuits against REA in the District of Colorado (“First Action”) alleging  
18 infringement of the ’703 Patent. Complaint, *Koji IP, LLC v. Renesas Electronics America, Inc.*  
19 (*“Koji I”*), No. 1:23-cv-01674-SKC (D. Colo. Jun. 30, 2023), ECF No. 1. On August 25, 2023,  
20 REA filed a motion to dismiss Koji’s complaint in the First Action, pursuant to Federal Rules of  
21 Civil Procedure 12(b)(3) and 12(b)(6), arguing that venue in Colorado was improper and that the  
22 infringement allegations were inadequately pleaded. Motion to Dismiss, *Koji I*, No. 1:23-cv-  
23 01674-SKC (D. Colo. Aug. 25, 2023), ECF No. 14. On the merits, REA argued, specifically, that  
24 Koji’s direct infringement allegations were deficient because the accused product lacked  
25 components required to meet each limitation of each claim of the asserted patent, and that the  
26 indirect infringement claims were subject to dismissal for failure to allege REA’s pre-suit  
27 knowledge of the patent-in-suit. In lieu of filing an opposition to the motion to dismiss, on  
28 September 6, 2023, Koji instead filed a voluntary notice of dismissal of the First Action without

prejudice pursuant to Federal Rule of Civil Procedure 41(a)(1)(A)(i). Notice of Voluntary Dismissal of Case, *Koji I*, No. 1:23-cv-01674-SKC (D. Colo. Sept. 6, 2023), ECF No. 18.

Shortly thereafter, on November 8, 2023, Koji—through the same counsel, the Ramey law firm—filed a second, identical patent infringement lawsuit against REA in the Northern District of California (“Second Action”), using an identically worded complaint alleging infringement of the same ‘703 Patent against the same defendant, REA. Complaint, *Koji IP, LLC v. Renesas*

*Electronics America, Inc.* (“*Koji IP*”), No. 3:23-cv-05752-LJC (N.D. Cal. Nov. 8, 2023), ECF No.

1. That Second Action complaint was facially copied from the First Action complaint—indeed, several paragraphs in the Second Action complaint still contain language regarding jurisdiction and venue being proper in Colorado (the venue of the First Action, not the venue of the Second Action). *Id.* at ¶¶ 3, 5-6. On December 22, 2023, REA sent Koji a letter regarding the complaint in the Second Action, identifying what REA alleged to be multiple pleading and infringement accusation failures, including several deficiencies that were previously raised in its motion to dismiss the First Action in Colorado. [Dkt. 19-1 at 132-38]. In that letter, REA’s counsel advised Koji’s counsel that if the matter were to move forward, REA would seek to have the case declared exceptional and would seek an award of attorneys’ fees. *Id.* at 137.

In response, on January 3, 2024, Attorney William P. Ramey, III, on behalf of Koji, identified to REA three new products that Koji claimed also infringe the ‘703 Patent. [Dkt. 19-1 at 140 (“we also wanted to make you aware of the products that will be included in our infringement contentions,” identifying the PTX30W, REA RX111, and ISL1801 products)]. Notably, among the three REA products accused of infringing—and which Koji stated its intent to add to its infringement contentions in the Second Action—was the Renesas PTX30W product. *Id.* Mr. Ramey told REA that “we think there may be other products” at issue. *Id.* at 151. That same day, Mr. Ramey sent a separate email addressing some of the arguments in REA’s earlier letter regarding the allegedly insufficient direct infringement allegations in the claims chart attached to the complaint. *Id.* at 142.

On January 12, 2024, Mr. Ramey sent an email to REA’s counsel asking if REA had a settlement counteroffer, stating that: “Our initial offer was very low. Let me know if we can close

1 the case.” *Id.* at 152. REA’s counsel responded that same day, indicating that REA’s counteroffer  
2 would be for Koji to voluntarily dismiss this case, and in return, REA would not seek its fees and  
3 costs. *Id.* at 151. Later that same day (January 12, 2024), Mr. Ramey responded further on behalf  
4 of Koji, stating: “My client has agreed to accept \$5k in resolution of the case. While we think  
5 there may be other products, we extend this offer in good faith on what you have told us.” *Id.*

6 On January 18, 2024, REA responded in writing, arguing that Koji’s infringement  
7 allegations remained frivolous and presenting data sheets demonstrating that two of the newly  
8 accused products (the RX111 and ISL1801) were prior art, one of which predated the provisional  
9 application for the ‘703 patent by over two years. [Dkt. 19-1 at 158]. In that letter, REA’s  
10 counsel argued that the newly identified PTX30W does not infringe the ‘703 patent on several  
11 grounds, and further advised Koji’s counsel that if the matter were to move forward, REA would  
12 seek to have the case declared exceptional and would seek an award of attorneys’ fees. *Id.* at 158-  
13 59. In a further email on January 18, 2024, REA’s counsel reiterated REA’s position that the case  
14 should be voluntarily dismissed by Koji, in return for which REA would not seek fees or costs,  
15 and that otherwise, REA would file a motion to dismiss. *Id.* at 318.

16 Mr. Ramey, in response, sent an email to REA’s counsel, dated January 23, 2024, stating  
17 “[h]ere is another product we are accusing,” and attaching an infringement claims chart. [Dkt. 19-  
18 1 at 328]. That email was sent not only to REA’s counsel but also to Mr. Kubiak and Ms. Kalra,  
19 both counsel of record for Koji in this case. *Id.* The attachment to that email is a file titled,  
20 “EoU\_CC-US10790703\_ Koji Yoden - wireless power transfer v. Renesas Electronics's  
21 PTX130W\_PTX30W (Claim 1) GSS.pdf.” *Id.* The claims chart attached to Mr. Ramey’s January  
22 23, 2024 email accuses REA’s PTX130W/PTX30W product—the same product Mr. Ramey  
23 identified as an accused infringing product in his prior January 3, 2024 email. [Dkt. 19-1 at 329-  
24 38]. The claims chart includes excerpts from a data sheet for “PTX130W/PTX30W Hardware  
25 Integration.” *Id.* at 331. Koji’s infringement claims chart explicitly states that the PTX30W is  
26 included in the infringement accusation: “*Renesas Electronics's PTX130W/PTX30W (MUST BE*  
27 *BOUGHT TOGETHER IN ORDER TO ACHIEVE POWER TRANSFER) is a wireless power*  
28 *transfer system for wirelessly charging a powered device.*” *Id.* (emphasis in original). The claims

1 chart includes explicit accusations and images of REA’s PTX30W product. *Id.* at 333-35, 337-38  
2 (identifying PTX30W as part of the accused “receiver” and labeled as “Listener”); *id.* at 336  
3 (image labeled “PTX30W board” with accused PTX30W chip component circled in yellow as  
4 corresponding to claim limitation).

5 On January 23, 2024, REA’s counsel replied by email, arguing that the accused PTX30W  
6 product does not infringe for several reasons. *Id.* at 340. REA’s counsel informed Mr. Ramey,  
7 Mr. Kubiak, and Ms. Kalra—all recipients of this email—that REA intended to file a motion to  
8 dismiss. *Id.* Two weeks later, on January 30, 2024, Koji, in response, filed a voluntary notice of  
9 dismissal of the Second Action pursuant to Rule 41(a)(1)(A)(i). Notice of Voluntary Dismissal,  
10 *Koji II*, No. 3:23-cv-05752-LJC (N.D. Cal. Jan. 30, 2024), ECF No. 12. This Notice of Voluntary  
11 Dismissal—signed by both Mr. Ramey and Ms. Kalra—states that it purports to be “without  
12 prejudice” and states (without citation or support) that “each party shall bear its own costs,  
13 expenses and attorneys’ fees.” *Id.* at 2.

14 On May 22, 2024, Koji—still represented by the Ramey firm—filed the complaint in this  
15 Third Action against REA, again alleging infringement of the same ‘703 Patent. [Dkt. 1]. The  
16 claims chart attached to the complaint in this Third Action is identical (or nearly identical) to the  
17 claims chart Mr. Ramey sent to REA’s lawyer on January 23, 2024 in connection with the Second  
18 Action and prior to dismissal of that case. *Compare* Dkt. 1-2 at 2-11, *with* Dkt. 19-1 at 329-38.  
19 As with the claims chart sent in connection with the Second Action, the claims chart attached to  
20 the complaint in this Third Action accuses REA’s PTX130W/PTX30W. [Dkt. 1-2 at 4]. Like the  
21 claims chart sent by Mr. Ramey in connection with the Second Action, the claims chart attached to  
22 the Third Action complaint includes excerpts from a data sheet for REA’s “PTX120W/PTX30W  
23 Hardware Integration.” *Id.* Like the claims chart sent by Mr. Ramey in connection with the  
24 Second Action, the claims chart attached to the This Action complaint explicitly states that the  
25 PTX30W is included in the infringement accusation: “*Renesas Electronics's PTX130W/PTX30W*  
26 *(MUST BE BOUGHT TOGETHER IN ORDER TO ACHIEVE POWER TRANSFER) is a wireless*  
27 *power transfer system for wirelessly charging a powered device.*” *Id.* (emphasis in original).  
28 And, just like the Second Action claims chart, the claims chart attached to the Third Action

1 complaint includes the same explicit accusations and images of the Renesas PTX30W product. *Id.*  
2 at 6-8, 10-11 (identifying PTX30W as part of the accused “receiver” labeled as a “Listener”); *id.* at  
3 9 (image labeled “PTX30W board” with accused PTX30W chip component circled in yellow).

4 Two days after commencing this Third Action (but before service of process), Mr. Ramey,  
5 on behalf of Koji, sent a letter, dated May 24, 2024, directly to an in-house employee of REA (and  
6 not their counsel), enclosing a copy of the complaint in this Third Action as well as a demand to  
7 settle the case in its entirety for \$59,000. *Id.* at 374. The letter instructed REA to respond by  
8 email to both Mr. Ramey and Mr. Kubiak. *Id.* The letter stated that the offer would be withdrawn  
9 if REA responded to the complaint. *Id.*

10 On May 31, 2024, REA’s counsel sent a letter to Koji, stating that the Third Action was  
11 “plainly barred under Federal Rule of Civil Procedure 41(a)(1)(B) and should be promptly  
12 dismissed.” *Id.* at 376. REA’s counsel noted that “[t]he complaints are substantively identical and  
13 the Second and Third actions appear to be largely cut-and-paste versions of the First Action.” *Id.*  
14 REA’s counsel also noted that the fact that the dismissal of the Second Action included the phrase  
15 “without prejudice” was legally irrelevant for purposes of the impact of Rule 41 under the two-  
16 dismissal rule. *Id.* at 378. REA’s counsel further summarized the asserted reasons—previously  
17 asserted in connection with the Second Action—why the PTX30W does not infringe. *Id.* REA’s  
18 counsel also informed Koji’s counsel that “the facts strongly suggest that these cases were filed for  
19 an improper purpose: to leverage the substantial cost of litigation to obtain a modest settlement  
20 notwithstanding the absence of a meritorious claim.” *Id.* REA’s counsel reiterated that REA  
21 might seek an award of its fees under § 285. *Id.* at 379. Instead of responding on the merits, on  
22 June 12, 2024, Koji filed a notice of voluntary dismissal of this Third Action with prejudice  
23 pursuant to Rule 41(a)(1)(a)(i). [Dkt. 12].

24 Following Koji’s voluntary dismissal of this Third Action, on June 26, 2024, REA filed the  
25 instant motion, seeking reimbursement for the attorney fees it incurred in defending against the  
26 Second and Third Actions, pursuant to 35 U.S.C. § 285, and seeking to have those amounts levied  
27 against Koji’s counsel as sanctions, pursuant to 28 U.S.C. § 1927 and/or this Court’s inherent  
28 authority. [Dkt. 18].



## LEGAL STANDARDS

The so-called American Rule “generally requires each party to bear his own litigation expenses, including attorney’s fees, regardless whether he wins or loses.” *Fox v. Vice*, 563 U.S. 826, 832 (2011) (citing *Alyeska Pipeline Serv. Co. v. Wilderness Soc’y*, 421 U.S. 240, 247 (1975)). The general American Rule does not allow for fee-shifting by prevailing parties unless specifically authorized by law. *Peter v. Nantkwest, Inc.*, 589 U.S. 23, 29-30 (2019).

### **I. Attorneys’ Fees Under 35 U.S.C. § 285**

Section 285 of the Patent Act provides that, in patent actions, a court may award “reasonable attorney fees to the prevailing party” in “exceptional cases.” 35 U.S.C. § 285. Whether to award such fees is governed by Federal Circuit law. *See Realtime Adaptive Streaming LLC v. Netflix, Inc.*, 41 F.4th 1372, 1378 (Fed. Cir. 2022) (“Federal Circuit precedent applies to a district court’s decision to award fees pursuant to § 285. *Blackbird Tech LLC v. Health in Motion LLC*, 944 F.3d 910, 914 (Fed. Cir. 2019) (‘We apply Federal Circuit case[ ]law to the § 285 analysis, as it is unique to patent law.’)”).

“Under § 285, a district court ‘may award’ attorneys’ fees to ‘the prevailing party’ in ‘exceptional cases.’” *Realtime Adaptive Streaming*, 41 F.4th at 1378. “The text of § 285 . . . is patently clear. It imposes one and only one constraint on district courts’ discretion to award attorney’s fees in patent litigation: The power is reserved for ‘exceptional’ cases.” *Octane Fitness, LLC v. ICON Health & Fitness, Inc.*, 572 U.S. 545, 553 (2014).

“An ‘exceptional’ case is simply one that stands out from others with respect to the substantive strength of a party’s litigating position or the unreasonable manner in which the case was litigated.” *Dragon Intellectual Prop. LLC v. DISH Network LLC*, 101 F.4th 1366, 1369-70 (Fed. Cir. 2024) (quoting *Octane Fitness*, 572 U.S. at 554) (alterations omitted). “The party seeking fees must prove that the case is exceptional by a preponderance of the evidence[.]” *Energy Heating, LLC v. Heat-On-The-Fly, LLC*, 15 F.4th 1378, 1382 (Fed. Cir. 2021) (citing *Octane Fitness*, 572 U.S. at 557-58)). “[W]hether a patent case is exceptional is decided as a matter of discretion by a district court.” *OneSubsea IP UK Ltd. v. FMC Techs., Inc.*, 68 F.4th 1285, 1294 (Fed. Cir. 2023) (citing *Highmark Inc. v. Allcare Health Mgmt. Sys. Inc.*, 572 U.S.

559, 564 (2014)). “A district court must ‘provide a concise but clear explanation of its reasons for the fee award.’” *Elec. Commc’n Techs., LLC v. ShoppersChoice.com, LLC*, 963 F.3d 1371, 1376 (Fed. Cir. 2020) (quoting *Hensley v. Eckerhart*, 461 U.S. 424, 437 (1983)).

“[A] district court makes the exceptional-case determination on a case-by-case basis considering the totality of the circumstances.” *Energy Heating*, 15 F.4th at 1382 (citing *Octane Fitness*, 572 U.S. at 554). There is “no precise rule or formula” for making this determination. *Octane Fitness*, 572 U.S. at 554 (citing *Fogerty v. Fantasy, Inc.*, 510 U.S. 517, 534 (1994)). Relevant factors may include “frivolousness, motivation, objective unreasonableness (both in the factual and legal components of the case) and the need in particular circumstances to advance considerations of compensation and deterrence.” *Id.* at 554 n.6 (quoting *Fogerty*, 510 U.S. at 534 n.19). “[A] district court may award fees in the rare case in which a party’s unreasonable conduct—while not necessarily independently sanctionable—is nonetheless so ‘exceptional’ as to justify an award of fees.” *Id.* at 555. “[A] case presenting either subjective bad faith or exceptionally meritless claims may sufficiently set itself apart from mine-run cases to warrant a fee award.” *Id.* (citation omitted).

However, courts do not award attorneys’ fees as “a penalty for failure to win a patent infringement suit.” *Id.* at 548. The legislative purpose of the fee-shifting provision is to prevent “gross injustice,” not to punish a party for losing. *Munchkin, Inc. v. Luv n’ Care, Ltd.*, 960 F.3d 1373, 1378 (Fed. Cir. 2020) (citation omitted).

“Because § 285 commits the determination whether a case is ‘exceptional’ to the discretion of the district court, that decision is to be reviewed on appeal for abuse of discretion.” *Highmark*, 572 U.S. at 563. The abuse-of-discretion standard applies to “all aspects of a district court’s § 285 determination.” *Id.* at 564. “Section 285 demands a simple discretionary inquiry; it imposes no specific evidentiary burden, much less such a high one. Indeed, patent-infringement litigation has always been governed by a preponderance of the evidence standard[.]” *Octane Fitness*, 572 U.S. at 557.

## II. Sanctions Under 28 U.S.C. § 1927

“An attorney . . . who so multiplies the proceedings in any case unreasonably and



vexatiously may be required by the court to satisfy personally the excess costs, expenses, and attorneys’ fees reasonably incurred because of such conduct.” 28 U.S.C. § 1927. Whether to impose sanctions under § 1927 is governed by Ninth Circuit law. *United Cannabis Corp. v. Pure Hemp Collective, Inc.*, 66 F.4th 1362, 1367 (Fed. Cir. 2023) (“We review § 1927 motions under the law of the regional circuit.”). “The key term in the statute is ‘vexatiously’; carelessly, negligently, or unreasonably multiplying the proceedings is not enough.” *In re Girardi*, 611 F.3d 1027, 1061 (9th Cir. 2010).

“[S]anctions pursuant to section 1927 must be supported by a finding of subjective bad faith.” *Lake v. Gates*, --- F.4th ---, 2025 WL 815191, at \*5 (9th Cir. 2025) (quoting *Blixseth v. Yellowstone Mountain Club, LLC*, 796 F.3d 1004, 1007 (9th Cir. 2015)). “Bad faith is present when an attorney knowingly or recklessly raises a frivolous argument or argues a meritorious claim for the purpose of harassing an opponent.” *Id.* (quoting *Blixseth*, 796 F.3d at 1007) (alteration omitted). “A district court may find such bad faith ‘when an attorney has acted recklessly if there is something more,’ such as frivolousness, harassment, or an improper purpose.” *Indiezone, Inc. v. Rooke*, 720 Fed. Appx. 333, 337 (9th Cir. 2017). A “‘finding that the attorney recklessly or intentionally misled the court’ or ‘a finding that the attorney[] recklessly raised a frivolous argument which resulted in the multiplication of the proceedings’ amounts to the requisite level of bad faith. In addition, ‘recklessly or intentionally misrepresenting facts constitutes the requisite bad faith’ to warrant sanctions, as does ‘recklessly making frivolous filings.’” *Id.* (citations omitted).

“[W]ith § 1927 as with other sanction provisions, ‘district courts enjoy much discretion in determining whether and how much sanctions are appropriate.’” *Haynes v. City & Cnty. of S.F.*, 688 F.3d 984, 987 (9th Cir. 2012) (quoting *Trulis v. Barton*, 107 F.3d 685, 694 (9th Cir. 1995)) (alteration omitted).

### III. Sanctions Under the Court’s Inherent Authority

District courts have inherent authority to manage their own affairs. *Chambers v. NASCO, Inc.*, 501 U.S. 32, 43 (1991). This includes the power to order appropriate sanctions as discipline. *Id.* A district court “may award attorneys’ fees when the interests of justice so require.” *Hall v.*

*Cole*, 412 U.S. 1, 4-5 (1973). A court has the inherent power to levy fee-based sanctions “when the losing party has ‘acted in bad faith, vexatiously, wantonly, or for oppressive reasons.’” *Octane Fitness*, 572 U.S. at 557 (quoting *Alyeska Pipeline*, 421 U.S. at 258-59) (alterations omitted).

Whether to impose sanctions in the form of attorneys’ fees under this Court’s inherent authority is governed by Ninth Circuit law. *Realtime Adaptive Streaming*, 41 F.4th at 1377 (“Because a district court’s inherent power to impose sanctions in the form of attorneys’ fees is not a substantive patent question, we apply the law of the regional circuit, here, the Ninth Circuit.”).

To impose sanctions under its inherent power, the Court must find “bad faith or conduct tantamount to bad faith.” *Fink v. Gomez*, 239 F.3d 989, 994 (9th Cir. 2001). “For purposes of imposing sanctions under the inherent power of the court, a finding of bad faith does not require that the legal and factual basis for the action prove totally frivolous; where a litigant is substantially motivated by vindictiveness, obduracy, or mala fides, the assertion of a colorable claim will not bar the assessment of attorney’s fees.” *Id.* at 992 (quoting *In re Intel Secs. Litig.*, 791 F.2d 672, 675 (9th Cir. 1986)) (internal quotation marks omitted). “[S]anctions are justified when a party acts *for an improper purpose*—even if the act consists of making a truthful statement or a non-frivolous argument or objection.” *Id.* (citing *Intel*, 791 F.2d at 675) (emphasis in original).

The Court must exercise its inherent power with “restraint and discretion.” *Caputo v. Tungsten Heavy Powder Inc.*, 96 F.4th 1111, 1148 (9th Cir. 2024) (quoting *Chambers*, 501 U.S. at 44). Any award must “go no further than to redress the wronged party ‘for losses sustained’; it may not impose an additional amount as punishment for the sanctioned party’s misbehavior.” *Lu v. United States*, 921 F.3d 850, 859 (9th Cir. 2019) (quoting *Goodyear Tire & Rubber Co. v. Haeger*, 581 U.S. 101, 108 (2017)).

## **ANALYSIS**

### **I. Whether to Award Attorneys’ Fees under § 285**

#### **a. Whether REA is the Prevailing Party**

To be eligible for an award of fees under § 285, REA must first be the prevailing party. The Parties dispute whether, and the extent which, REA is the “prevailing party” for purposes of § 285. Whether a litigant is a prevailing party in a patent case is a question of Federal Circuit law.

1 *SSL Servs., LLC v. Citrix Sys., Inc.*, 769 F.3d 1073, 1086 (Fed. Cir. 2014) (“In a patent case,  
 2 Federal Circuit law governs the determination of which party has prevailed.”). “[F]or there to be a  
 3 prevailing party, there must be: (1) a change in the parties' legal relationship, and (2) the change  
 4 must be judicially sanctioned or otherwise carry sufficient judicial imprimatur.” *Buckhannon Bd.*  
 5 *& Care Home, Inc. v. W.V. Dep't of Health & Human Res.*, 532 U.S. 598, 605 (2001). “The  
 6 touchstone of the prevailing party inquiry must be the material alteration of the legal relationship  
 7 of the parties. This change must be marked by judicial imprimatur.” *O.F. Mossberg & Sons, Inc.*  
 8 *v. Timney Triggers, LLC*, 955 F.3d 990, 992 (Fed. Cir. 2020) (quoting *CRST Van Expedited, Inc.*  
 9 *v. EEOC*, 578 U.S. 419, 422 (2016)) (alteration omitted). A litigant “need not prevail on the  
 10 merits to be classified as a ‘prevailing party.’” *Id.* (citation omitted).

11 The Federal Circuit has held that a defendant “prevails” as the result of a Rule 41 dismissal  
 12 where the dismissal has “sufficient judicial imprimatur to constitute a ‘judicially sanctioned  
 13 change in the legal relationship of the parties.’” *Highway Equip. Co. v. FECO, Ltd.*, 469 F.3d  
 14 1027, 1034 (Fed. Cir. 2006) (quoting *Buckhannon*, 532 U.S. at 605). Such a change in the legal  
 15 relationship of the parties includes a voluntary dismissal with prejudice. *Raniere v. Microsoft*  
 16 *Corp.*, 887 F.3d 1298, 1307 (Fed. Cir. 2018) (“[T]he dismissal of a claim with prejudice, however,  
 17 is a judgment on the merits under the law of the Federal Circuit.”); *see also Highway Equip.*, 469  
 18 F.3d at 1032 (“[T]he question of the effect of a dismissal with prejudice on 35 U.S.C. § 285 is a  
 19 matter of Federal Circuit law.”).

20 With regard to this Third Action, the procedural history demonstrates that REA is the  
 21 prevailing party. As discussed above (and in further detail in the Court’s March 26, 2025 Order),  
 22 Koji authorized its counsel to first file this action on May 22, 2024. *See* Dkt. 28-2 at ¶ 14 (“I and  
 23 my client’s representative, Carlos Gorrichategui, Ph.D, discussed whether the sales of the newly  
 24 charted product had been included in the prior numbers and came to the conclusion it was not  
 25 based on what had been provided to Renesas in the prior lawsuits. . . . Accordingly, Koji asked  
 26 Ramey LLP to file a new lawsuit based on the newly charted product created by Sunatori and  
 27 Ramey LLP.”); Dkt. 28-17 at ¶ 11 (“On April 25, 2024, I told William Ramey that my team and I  
 28 revisited the Renesas Electronics claim chart and wanted to seek damages on a new product we

1 charted. I authorized the filing of the Third suit if we could. William Ramey informed me that we  
2 could file the Third lawsuit.”).

3 In response to correspondence from REA’s counsel, Koji agreed to voluntarily dismiss this  
4 case **with prejudice** on June 12, 2024. See Dkt. 28-17 at ¶¶ 12-13 (“On May 31, 2024, William  
5 Ramey forwarded us ‘2024.05.31 Letter to Koji IP re third case.pdf[.]’ I discussed the matter with  
6 William Ramey and authorized him to dismiss the suit to avoid a fight on a motion for  
7 sanctions.”); see also Dkt. 28-2 at ¶¶ 15-18 (“Renesas’s lawyer responded by letter on May 31,  
8 2024, that Koji’s lawsuit was foreclosed as it had been dismissed twice. The letter asked that the  
9 lawsuit be promptly dismissed. After further discussions with Renesas’s counsel, the lawsuit was  
10 dismissed with prejudice on June 12, 2024. . . . Koji instructed me to seek a dismissal with each  
11 party bearing its own fees and costs but Renesas refused. Rather than fight motion practice and  
12 increase the costs for both sides, I dismissed *with prejudice* Koji’s lawsuit over all products that  
13 might infringe the ‘703 patent.”) (emphasis in original).

14 The notice of voluntary dismissal filed by Koji explicitly states that the dismissal is with  
15 prejudice. [Dkt. 12]. A notice of voluntary dismissal operates immediately and does not require a  
16 further court order to effectuate the dismissal. See Fed. R. Civ. P. 41(a)(1)(A) (“Without a Court  
17 Order . . . the plaintiff may dismiss an action without a court order[.]”); *Com. Space Mgt. Co. v.*  
18 *Boeing Co.*, 193 F.3d 1074, 1077 (9th Cir. 1999) (“Because the dismissal is effective on filing and  
19 no court order is required, ‘[t]he filing of a notice of voluntary dismissal with the court  
20 automatically terminates the action as to the defendants who are the subjects of the notice.’”).  
21 Analogously, the Federal Circuit has held that “a voluntary dismissal with prejudice under Federal  
22 Rule of Civil Procedure 41(a)(2) ‘has the necessary judicial imprimatur to constitute a judicially  
23 sanctioned change in the legal relationship of the parties, such that the district court properly could  
24 entertain [the defendant’s] fee claim under 35 U.S.C. § 285.’” *Raniere v. Microsoft Corp.*, 887  
25 F.3d 1298, 1307-08 (Fed. Cir. 2018) (holding that order of dismissal with prejudice under Rule  
26 41(b) suffices to make defendants prevailing parties, where “[t]he dismissal of a claim with  
27 prejudice, however, is a judgment on the merits under the law of the Federal Circuit”).

28 Accordingly, the Court finds that REA is the prevailing party in this Third Action because

1 Koji voluntarily dismissed this case *with* prejudice. By definition, a dismissal with prejudice  
2 operates to change the legal relationship of the Parties with respect to the disputes raised in the  
3 Complaint in this action (for example, with regard to the Parties’ legal relationship under the  
4 doctrines of *res judicata* or claim preclusion, issues on which the Federal Circuit applies regional  
5 circuit law. *See Ford-Clifton v. Dep’t of Veterans Affairs*, 661 F.3d 655, 660 (Fed. Cir. 2011) (“A  
6 voluntary dismissal with prejudice is an adjudication on the merits for purposes of *res judicata*.”).

7 With regard to the Second Action, as an initial matter, the Court notes that the  
8 determination of the impact of the two dismissals (of the First and Second Actions) is now ripe for  
9 adjudication because it has been raised now in this Third Action. *See Com. Space Mgt.*, 193 F.3d  
10 at 1080. The Court finds that REA is also the prevailing party in the Second Action by operation  
11 of the “two-dismissal rule” under Rule 41(a)(1)(B). Specifically, Rule 41(a)(1)(B) provides, in  
12 pertinent part, that “[i]f the plaintiff previously dismissed any . . . action based on or including the  
13 same claim, a notice of dismissal operates as an adjudication on the merits.” As detailed above  
14 and in March 26, 2025 Order, Koji filed two identical cases (the first in Colorado, the second in  
15 this Court) against REA, asserting the exact same patent against the exact same products. *See* Dkt.  
16 28-2 at 10 n.7 (“The claim chart filed with the first lawsuit was the same claim chart filed with the  
17 second lawsuit.”); Dkt. 28-17 at ¶ 5 (“William Ramey informed me that we would likely lose the  
18 venue motion and I authorized him to dismiss the Colorado [sic], if we could refile elsewhere. I  
19 was informed the case would be refiled in California.”).

20 Mr. Gorrichategui of Koji authorized Mr. Ramey to dismiss the First Action in Colorado,  
21 and thus, Koji voluntarily dismissed the First Action by filing a voluntary notice of dismissal  
22 signed by Mr. Ramey as counsel for Koji—and not by stipulation signed by both Parties—under  
23 Rule 41(a)(1)(A)(i). [Dkt. 19-1 at 114]. After refileing the identical case here in the Northern  
24 District of California, Mr. Gorrichategui of Koji authorized dismissal, and thus, Koji voluntarily  
25 dismissed that Second Action, again by filing a voluntary notice of dismissal under Rule  
26 41(a)(1)(A)(i). [Dkt. 19-1 at 371]; *see also* Dkt. 28-2 at ¶¶ 11-13 (“On November 8, 2023, I had  
27 Susan Kalra refile the lawsuit in the Northern District of California and shortly thereafter began  
28 discussions with counsel for Renesas. . . . The lawsuit was dismissed due to the low sales

1 volume.”); Dkt. 28-17 at ¶ 5 (“Based on low sales volumes I authorized the dismissal of the  
2 lawsuit due to the low sales volumes.”).

3 The Federal Circuit has recognized that the two-dismissal rule under Rule 41(a)(1)(B) “by  
4 its terms applies only if ‘the plaintiff’ (in the action whose dismissal would become an  
5 adjudication on the merits) previously dismissed an action (based on or including the same claim).  
6 The plaintiff in the second action must be the same person as the plaintiff in the first action at the  
7 time of the voluntary dismissal.” *Astornet Techs. Inc. v. BAE Sys.*, 802 F.2d 1271, 1281 (Fed. Cir.  
8 2015). Here, there is no dispute that Koji is the same plaintiff in the First Action and the Second  
9 Action; there is no dispute that the cause of action asserting the same ‘703 patent in the Second  
10 Action was identical to the First Action (that is, the Second Action was a “refiled” version of the  
11 First Action with the identical claims chart attached to the complaints in each, with the only  
12 difference being the venue); and there is no dispute that Koji filed notices of voluntary dismissal  
13 in both the First Action and the Second Action.

14 Koji’s notice of voluntary dismissal of the Second Action facially states that the dismissal  
15 was *without* prejudice, but that labelling is of no legal import. “[T]he label a plaintiff attaches to a  
16 second Rule 41(a)(1) dismissal is irrelevant if a subsequent action is filed ‘based on or including  
17 the same claim,’ because Rule 41(a)(1) itself instructs that such a dismissal ‘operates as an  
18 adjudication upon the merits.’” *Com. Space Mgt.*, 193 F.3d at 1080; *see also Vanover v. Bohnert*,  
19 11 Fed. Appx. 679, 680-81 (8th Cir. 2001); 9 CHARLES ALAN WRIGHT & ARTHUR R. MILLER,  
20 FEDERAL PRACTICE AND PROCEDURE § 2368 (4th ed.) (“When a second dismissal is by notice  
21 under Rule 41(a), it is, by operation of the terms of the Federal Rule itself, an adjudication on the  
22 merits; thus, it is with prejudice *even if the notice states that the dismissal is without prejudice.*”)  
23 (emphasis added). While the Federal Circuit does not appear to have addressed the specific issue  
24 of “labelling” a second notice of dismissal, the great weight of precedent makes clear that a  
25 plaintiff cannot avoid the effect of Rule 41(a)(1)(B) merely by adding “without prejudice” to the  
26 dismissal notice. Indeed, the text of the rule expressly states that the dismissal of the second case  
27 “operates” as an adjudication on the merits—meaning that the operation or effect of the dismissal  
28 is a judgment on the merits, without providing any exception for the form or textual attempts to



1 avoid that operation. *See Robertshaw-Fulton Controls Co. v. Noma Elec. Corp.*, 10 F.R.D. 32, 34  
2 (D. Md. 1950) (“It is clear from this language that the plaintiff in the present case could not, by the  
3 mere recital in its notice of dismissal of July 22, 1949 that such notice is ‘without prejudice and  
4 without costs,’ defeat the express language of the Rule above quoted [Rule 41(a)(1)(B)].”). Koji’s  
5 position is not well-reasoned, because a party could avoid the operation of Rule 41(a)(1)(B) by  
6 merely adding the magic language “without prejudice” in a second notice of dismissal, thus  
7 rendering the Rule ineffective by easy and unconstrained expedient.

8 While the Parties have not identified Federal Circuit precedent affirming an award of fees  
9 based on a finding of a prevailing party under Rule 41(a)(1)(B)’s two-dismissal rule, the Federal  
10 Circuit has recognized the two-dismissal rule’s reach. Specifically, in *Astornet*, the Federal  
11 Circuit recognized that the two-dismissal rule applies “in the action whose dismissal would  
12 become an adjudication on the merits” where the same plaintiff had “previously dismissed an  
13 action (based on or including the same claim).” 802 F.3d at 1281 (finding two-dismissal rule did  
14 not apply to the facts in that case). By operation of Rule 41(a)(1)(B), a notice of voluntary  
15 dismissal in the second case operates as an adjudication on the merits and a dismissal with  
16 prejudice is “tantamount to a decision on the merits.” *Raniere*, 887 F.3d at 1307. The Supreme  
17 Court has held that a decision on the merits is not required for a party to be found the “prevailing  
18 party.” *CRST Van Expedited, Inc. v. EEOC*, 578 U.S. 419, 431-32 (2016). Analogously, the  
19 Federal Circuit has held that “as a matter of patent law” a dismissal with prejudice by court order  
20 under Rule 41(a)(2) “has the necessary judicial imprimatur to constitute a judicially sanctioned  
21 change in the legal relationship of the parties, such that the district court properly could entertain  
22 [defendant] FECO’s fee claim under 35 U.S.C. § 285.” *Highway Equip.*, 469 F.3d at 1035.

23 The Federal Circuit has made clear that the impact of two dismissals under Rule  
24 41(a)(1)(B) may only be raised and decided in a third case, if and when a third case is filed. *Com.*  
25 *Space Mgmt.*, 193 F.3d at 1080. As such, the instant Order in this Third Action is by definition a  
26 court order (and “judicial imprimatur”) which constitutes a judicially sanctioned change in the  
27 legal relationship of the Parties here. That is, to the extent that the notice of dismissal of the  
28 Second Action, standing in isolation, somehow does not have sufficient judicial imprimatur, this

1 very Order—which finds that the effect of the voluntary dismissal of the Second Action operates  
2 as an adjudication on the merits and which could not issue until this Third Action—constitutes a  
3 judicially sanctioned and recognized change in the legal relationship of the Parties that was  
4 effectuated by that second dismissal.

5 Other district courts faced with this scenario have concluded that the two-dismissal rule  
6 results in an adjudication on the merits and is therefore sufficient to confer “prevailing party”  
7 status on the defendant for purposes of § 285. *See, e.g., Realtime Adaptive Streaming LLC v.*  
8 *Netflix, Inc.*, No. CV-19-6361-GW-JCx, 2020 WL 8024356, at \*3 (C.D. Cal. Nov. 23, 2020), *aff’d*  
9 *on other grounds*, 41 F.4th 1372 (Fed. Cir. 2022); *Young Lee v. Summit Trustee Servs., LLC*, No.  
10 CV 19-3814-DMG (Ex), 2020 WL 10313718, at \*1 (C.D. Cal. Nov. 20, 2020) (“[U]nder the ‘two  
11 dismissal rule,’ the second dismissal operates as an adjudication on the merits of allegations of  
12 wrongful foreclosure, quiet title, violation of financial code, and unfair competition,  
13 notwithstanding that Plaintiff characterized the dismissal as ‘without prejudice.’”); *Uniloc USA,*  
14 *Inc. v. Blackberry Corp.*, No. 3:18-cv-1883-N, 2021 WL 12104812, at \*1 (N.D. Tex. July 1,  
15 2021). The Court is persuaded by these cases and their reasoning.

16 Accordingly, the Court finds that REA is the prevailing party in both the Second Action  
17 and this Third Action.

18 **b. Whether the Second and Third Actions are “Exceptional”**

19 In evaluating whether a case is “exceptional” for purposes of § 285, the Court has  
20 discretion to consider various non-exclusive factors, including “the litigant’s objective  
21 unreasonableness in litigating the case, subjective bad faith, frivolousness, motivation, and the  
22 need in particular circumstances to advance considerations of compensation and deterrence.”  
23 *Bayer CropScience AG v. Dow AgroSciences LLC*, 851 F.3d 1302, 1306 (Fed. Cir. 2017) (citing  
24 *Octane Fitness*, 572 U.S. at 554 & n.6).

25 Koji’s Litigating Position

26 A case presenting “exceptionally meritless claims may sufficiently set itself apart from  
27 mine-run cases to warrant a fee award.” *Octane Fitness*, 572 U.S. at 555. An objectively baseless  
28 patent case is one in which the patentee’s assertions—whether manifested in its infringement



allegations or its claim construction positions—are “such that no reasonable litigant could reasonably expect success on the merits.” *Taurus IP, LLC v. DaimlerChrysler Corp.*, 726 F.3d 1306, 1327 (Fed. Cir. 2013) (quoting *Dominant Semiconductors Sdn. Bhd. v. OSRAM GmbH*, 524 F.3d 1254, 1260 (Fed. Cir. 2008)); *Forest Labs., Inc. v. Abbott Labs.*, 339 F.3d 1324, 1330 (Fed. Cir. 2003) (“A frivolous infringement suit is one which the patentee knew, or on reasonable investigation, should have known, was baseless.”).

Courts in this District have found that a plaintiff’s failure to adequately investigate their patent infringement claim “weighs in favor of finding that [the] case is exceptional.” *Yufa v. TSI Inc.*, No. 09-cv-01315-KAW, 2014 WL 4071902, at \*3 (N.D. Cal. Aug. 14, 2014) (awarding § 285 fees where the plaintiff failed to purchase or test any of the accused products to support its infringement claims); *IPVX Patent Holdings, Inc. v. Voxernet LLC*, No. 5:13-cv-01708 HRL, 2014 WL 5795545, at \*6 (N.D. Cal. Nov. 6, 2014).

As discussed in detail in this Court’s March 26, 2025 Order, it is clear that Koji’s counsel conducted zero (or near-zero) pre-filing investigation regarding the effect of the dismissal of the Second Action on Koji’s ability to file this Third Action under the “two dismissal” rule of Rule 41(a)(1)(B). [Dkt. 21]. Koji admits that the First Action filed in Colorado was identical to the Second Action filed in this Court. [Dkt. 28 at 16 (“Koji admits that it refiled the same infringement allegations it previously dismissed in Colorado in the Northern District of California.”)]. Koji admits that it voluntarily dismissed the First Action under Rule 41 by notice. *Id.* at 15. And Koji admits that it voluntarily dismissed the identical Second Action under Rule 41 by notice. *Id.* at 16-17. Because Koji previously dismissed the same claim in the First Action, the notice of dismissal in the Second Action operated as an adjudication on the merits. Fed. R. Civ. P. 41(a)(1)(B).

At the August 22, 2024 hearing, Ms. Kalra was unable to identify any pre-filing inquiry by herself (or by any other Ramey LLP attorney) regarding Rule 41’s effect here, and regarding whether or not the complaint in this Third Action was warranted by existing law or any other permissible basis under Rule 11. Ms. Kalra was equally unable to identify whether any of the Ramey LLP lawyers performed any pre-filing inquiry as to the impact of the dismissal filed in the

1 Second Action prior to the filing of that notice of dismissal. At the hearing and in the briefing on  
2 the instant motion, Plaintiff’s counsel was unable to cite any law of which they were aware prior  
3 to filing the complaint in this Third Action which reasonably supported the position that the  
4 dismissals of the complaints in the previous two actions avoided an adjudication on the merits  
5 under Rule 41.

6 In the opposition to the fees motion here, Koji argues that its “actions in filing multiple  
7 lawsuits have been explained and have presented ‘a persuasive explanation for the course of  
8 litigation’ and therefore Koji would not be liable under Rule 41 either.” [Dkt. 24 at 20-21 (citing  
9 *Milkcrate Athletics, Inc. v. Adidas Am., Inc.*, 619 F. Supp. 3d 1009 (C.D. Cal. 2022)). The  
10 *Milkcrate* case cited by Koji does *not* discuss an exception to the dispositive effect of the two prior  
11 dismissals under Rule 41.

12 In *Milkcrate*, the issue was whether or not the Court should award costs and fees to the  
13 defendant under Federal Rule of Civil Procedure 41(d). *Id.* at 1024-28; *see* Fed. R. Civ. P. 41(d)  
14 (“If a plaintiff who previously dismissed an action in any court files an action based on or  
15 including the same claim against the same defendant, the court . . . may order the plaintiff to pay  
16 all or part of the costs of that previous action[.]”). Indeed, the quote from *Milkcrate* cited by  
17 Koji’s opposition brief here is taken out of context—the full text of the sentence states that “[a]n  
18 ‘award under Rule 41(d) is appropriate’ where ‘the [movant] has failed to present a persuasive  
19 explanation for the course of litigation’ and the nonmovant shows it has ‘incurred needless  
20 expenditures as a result.’” *Milkcrate*, 619 F. Supp. 3d at 1025. *Milkcrate* was concerned with  
21 whether to award costs to the defendant under Rule 41(d), not whether to award fees under § 285.  
22 Indeed, Koji itself confusingly argues that “Renesas did not move under Rule 41.” [Dkt. 24 at 20].

23 Further, even if somehow the “persuasive explanation for the course of litigation” rule in  
24 *Milkcrate* for avoiding costs under Rule 41(d) were somehow analogized to or extended by  
25 implication to Rule 41(a)(1)(B), the application of that rule in *Milkcrate* is contrary to Koji’s  
26 opposition. In *Milkcrate*, the court actually *awarded* costs to the defendant because the plaintiff  
27 filed a second action after dismissing a previous action, where the allegations in both cases  
28 concerned “the same operative facts and include[d] the same copyright infringement claim at

1 issue[.]” 619 F. Supp. 3d at 1025-26. That is the same situation here—Koji filed this Third  
2 Action even after voluntarily dismissing the previous two cases, even though all three cases  
3 concerned the same operative facts and included the same patent infringement claims at issue. If  
4 anything, *Milkcrate* teaches that an award of costs is appropriate in the analogous factual situation  
5 as is present here, due to a failure to present a “persuasive explanation for the course of litigation”  
6 where multiple suits are filed and dismissed.

7 At the hearing on the Order to Show Cause, Mr. Ramey admitted that *Milkcrate* is not  
8 legal support for an exception under Rule 41(a)(1)(B) for filing the complaint in this Third Action  
9 after previously dismissing two identical or substantially identical prior complaints. Mr. Ramey  
10 also admitted that *Milkcrate* is not support for the assertion that he somehow “knew” based on his  
11 experience of any such exception to Rule 41 that would have allowed or excused the filing of the  
12 third complaint here. The record shows that Koji (and its lawyers) did not analyze *Milkcrate* or  
13 any definitive cases on the issues as part of any pre-filing diligence before filing the Third Action  
14 complaint here. In his declaration in opposition to the instant motion, Mr. Ramey states that, in  
15 responding to REA’s counsel *after* the Third Action was already filed, “[o]ur opinion was that the  
16 dismissal of the Colorado lawsuit did not count as a prior dismissal for purposes of Rule 41 as it  
17 was done on venue grounds and to conserve the resources of the parties. However, further  
18 research did not provide a definitive case on the issues so Koji decided to dismiss the lawsuit with  
19 prejudice before Renesas would be required to expend resources answering or otherwise  
20 responding.” [Dkt. 24-2 at ¶ 17]. Similarly, in response to the Order to Show Cause, the Ramey  
21 law firm attorneys simply refer to their unexplained “opinion” that the dismissal of the first  
22 lawsuit in Colorado somehow did not count for purposes of Rule 41, that based on their years of  
23 experience there are unidentified “exceptions” to Rule 41, and that they “believed” the  
24 circumstances allowed them to refile the complaint. [Dkt. 28-1 at ¶ 12; Dkt. 28-2 at ¶ 17; Dkt. 28-  
25 3 at ¶ 20].

26 Koji has provided no legal support which justifies the filing of the third complaint here. At  
27 best, Koji argues that the prior dismissals were motivated by a desire to reduce costs and out of  
28 concern for the convenience to the Parties. [Dkt. 24 at 8-10]. Koji argues that the dismissal of the

1 First Action in Colorado occurred after Koji received sworn statements from REA “that likely  
2 established that the location relied upon for venue was not a location of Renesas, Koji dismissed  
3 its lawsuit on September 6, 2023 without burdening the court or Renesas to address the  
4 arguments.” *Id.* at 8. Koji’s brief concludes this argument with a circular statement that “[t]he  
5 dismissal was filed solely to effectuate dismissal.” *Id.* Similarly, with regard to the Second  
6 Action, Koji argues that REA “maintained that the sales volume of the accused product was very  
7 low. Koji and its counsel looked for additional products from [REA] but were unable to locate  
8 any at the time. Therefore, to not burden [REA], on January 30, 2024, Koji agreed to dismiss  
9 without prejudice its lawsuit, to which [REA] agreed. The lawsuit was dismissed due to the low  
10 sales volume.” *Id.*

11 There is no provision of Rule 41 which somehow exempts the impact of a voluntary  
12 dismissal if it is allegedly to avoid burdening the court or parties to address arguments, or if it is  
13 due to low sales volumes of accused products. The Ninth Circuit has held that Rule 41 “does not  
14 consider the plaintiff’s reasons for seeking a voluntary dismissal” and that “[t]he Rule does not  
15 require an inquiry into the circumstances of the two dismissals.” *Lake at Las Vegas Investors*  
16 *Grp., Inc. v. Pac. Malibu Devel. Corp.*, 933 F.2d 724, 727 (9th Cir. 1991); *Thomas v. Wells Fargo*  
17 *Bank, N.A.*, No. C 13-02065 JSW, 2013 WL 5313458, at \*3 (N.D. Cal. Sept. 23, 2013) (“[T]he  
18 Rule [Rule 41] does not to provide the Court with any discretion to avoid the impact of the two–  
19 dismissal rule based on the Plaintiff’s understanding or motivation in dismissing the second  
20 action.”). Indeed, in response to the Order to Show Cause, Koji’s lawyers admitted that the First  
21 Action was dismissed because Koji determined it would lose a motion to dismiss or transfer for  
22 improper venue, and thus, not merely to reduce burdens. [Dkt. 28 at 15 (“The first [lawsuit] was  
23 dismissed by Koji when it determined that it would likely lose a venue motion.”)]. At the Order to  
24 Show Cause hearing, Mr. Ramey conceded that he was unable to locate any case law supporting  
25 the position that voluntary dismissal for “convenience” or to reduce costs (by avoiding a fight over  
26 venue) is exempt from Rule 41’s impact. [Dkt. 40 at 50:22-51:20].

27 More significantly, Koji proffers no evidence that Koji (or its lawyers) performed any  
28 diligence on the Rule 41 issue prior to filing this Third Action. Instead, Koji admits that the

1 reason for filing this Third Action was because “sales of the newly charted product” were not  
2 included in Koji’s “prior numbers” for damages calculations. [Dkt. 24 at 4]. That is, Koji’s only  
3 identified pre-filing investigation was to find a basis to assert higher damages claims and demand  
4 a higher settlement, which Koji did immediately upon filing this Third Action, by raising its  
5 demand from five thousand dollars at the end of the Second Action to fifty-nine thousand dollars  
6 upon filing the Third Action. [Dkt. 19-1 at 151, 374].

7 As discussed in detail in the March 26, 2025 Order, the Court is deeply troubled by Koji’s  
8 lack of diligence and apparent disregard for the two-dismissal rule issue prior to filing the Third  
9 Action. The two-dismissal rule “was intended to eliminate ‘the annoying of a defendant by being  
10 summoned into court in successive actions and then, if no settlement is arrived at, requiring him to  
11 permit the action to be dismissed and another one commenced at leisure.’” *Cooter & Gell v.*  
12 *Hartmax Corp.*, 496 U.S. 384, 397 (1990) (citation omitted). Koji has identified no legally  
13 permissible excuses for its failures to investigate the Rule 41 issues, and its post-hoc arguments  
14 about reducing burdens or convenience are simply irrelevant to Rule 41 (as is the only case law  
15 cited by Koji).

16 The Court **FINDS** that Koji’s filing of the complaint in this Third Action was frivolous and  
17 legally baseless, and lacked adequate pre-suit diligence on the Rule 41 issues. The timing of  
18 Koji’s immediate settlement demand after filing the Third Action, and Koji’s avowed reason for  
19 filing the Third Action (simply to demand a higher settlement figure than was demanded during  
20 the Second Action) was an improper motivation and amounts to harassment. The Court **FINDS**  
21 that Koji litigated with subjective bad faith, that Koji’s approach to litigating this Third Action  
22 was objectively unreasonable where no reasonable litigant could reasonably expect success on the  
23 merits, and that Koji’s actions were at least reckless, if not willfully blinding themselves to the  
24 defects in the Third Action, coupled with more conduct (including making misrepresentations to  
25 this Court, as discussed below). The Court therefore **FINDS** that the Third Action is an  
26 exceptional case.

27 With regard to the Second Action, as detailed above, during the course of that lawsuit Koji  
28 continued to add accused products to the case. Specifically, Renesas’s counsel sent Koji’s counsel

1 a letter on December 22, 2023 detailing numerous arguments why the infringement allegations  
2 against the exemplary product accused in the claims chart attached to the complaint. [Dkt. 19-1 at  
3 132]. In response, on January 3, 2024, Mr. Ramey sent an email adding three additional products  
4 to Koji's infringement contentions in the case. *Id.* at 140. After investigating, on January 18,  
5 2024 REA's counsel replied by letter, explaining that two of the new accused products added to  
6 the Second Action are prior art to the '703 patent, attaching as evidence data sheets for the two  
7 prior art products. *Id.* at 158. Koji never responded to that letter and never commented on the  
8 issue of whether it had accused prior art products of infringement. Instead, on January 23, 2024,  
9 Mr. Ramey sent REA's counsel a claims chart purporting to show infringement of '703 claim 1 by  
10 the third product (the PTX130W/PTX30W) listed in the January 3, 2024 email. *Id.* at 328-38.

11 "A century-old axiom of patent law holds that a product 'which would literally infringe if  
12 later in time anticipates if earlier.'" *Upsher-Smith Labs. v. Pamlab, L.L.C.*, 412 F.3d 1319, 1322  
13 (Fed. Cir. 2005). The Federal Circuit has affirmed the grant of summary judgment of invalidity of  
14 a patent where the patentee accused the defendant's products of infringing the patent and where it  
15 turned out that those accused products were for sale in the prior art time period. *See Vanmoor v.*  
16 *Wal-Mart Stores, Inc.*, 201 F.3d 1363, 1366-67 (Fed. Cir. 2000) ("[T]he entire basis of the patent  
17 infringement claim is Vanmoor's (the patentee's) contention that the accused cartridges infringe  
18 the '331 patent. . . . Although Wal-Mart and the manufacturers bore the burden of proving that the  
19 cartridges that were the subject of the pre-critical date sales anticipated the '331 patent, that burden  
20 was satisfied by Vanmoor's allegation that the accused cartridges infringe the '331 patent."); *see*  
21 *also Gammino v. Sw. Bell Tel., L.P.*, 512 F. Supp. 2d 626, 635-38 (N.D. Tex. Mar. 23, 2007) ("In  
22 this case, [patentee] Gammino has accused two of [defendant] SWB's call-blocking services. . . .  
23 These services were implemented in SWB's central office switches and were publicly available for  
24 purchase before Gammino even conceived of his invention. . . . [SWB's] burden of proving  
25 anticipation was satisfied by Gammino's allegation that the accused call-blocking services  
26 infringed his patents. Stated differently, the fact that Gammino bases his infringement claims  
27 against SWB on SWB's own prior art call-blocking services renders the claims of his patents  
28 invalid."), *aff'd*, 267 Fed. Appx. 949 (Fed. Cir. 2008) ("No purpose would be served by simply



1 retracing the analysis of the district court, which is fully sufficient to resolve this appeal.”).

2       The factual situation here is similar to those in *Realtek Semiconductor Corp. v. Marvell*  
3 *Semiconductor, Inc.*, No. C-04-4265 MMC, 2005 WL 3634617 (N.D. Cal. Nov. 21, 2005). There,  
4 the patentee sued Marvell for infringing a Realtek patent, and Realtek accused several Marvell  
5 products by model number. During discovery, Marvell established that Realtek was in possession  
6 of a report from a consultant which showed the prior art date of the accused Marvell product.  
7 Thus, after Marvell showed in discovery that one of the specifically accused Marvell products was  
8 prior art to the Realtek patent, Marvell served a Rule 11 notice on Realtek and filed a motion for  
9 summary judgment of invalidity of the asserted patent because the accused Marvell product was  
10 prior art to the patent. Subsequently, Realtek granted Marvel a covenant not to sue and sought  
11 dismissal of the case. Marvell then filed a motion for attorneys’ fees under § 285. *Id.* at \*1-2.

12       In finding the case exceptional, Judge Chesney wrote that “[patentee] Realtek initiated the  
13 instant litigation ‘without investigating the facts staring them in the face.’ Moreover, Realtek does  
14 not explain why it continued to pursue the instant lawsuit after April 8, 2005, the date on which  
15 Marvell produced sales data showing numerous sales of the accused product during the year 2000.  
16 . . . Realtek knew or should have known, before filing the instant lawsuit, that it had no chance of  
17 success on the merits of its infringement claim, because Marvell's allegedly infringing product was  
18 made and sold before the invention date of the '608 patent.” *Id.* at \*5-6. Judge Chesney held that  
19 Realtek acted in subjective bad faith in filing the action, ultimately awarding Marvell roughly  
20 \$550,000 in fees and expenses. *Id.* at \*6, 8.

21       Here, as in *Realtek*, the plaintiff accused products of infringing, where those products were  
22 shown by documentary evidence to be prior art. Here, as in *Realtek*, the plaintiff continued to  
23 pursue the case even after being made aware that it had accused prior art products of infringement,  
24 after documentary evidence showing the products are prior art was disclosed, and after defense  
25 counsel raised concerns about Rule 11 violations, sanctions under § 1927, and attorneys’ fees  
26 under § 285. [Dkt. 19-1 at 158-59]. Here, as in *Realtek*, the plaintiff did not offer persuasive  
27 explanation for its lack of diligence in investigating the products prior to accusing them of  
28 infringement, and did not offer persuasive explanation for why it continued to pursue the lawsuit

1 for some period of time after being made aware of the facts. While the time frame here is shorter  
2 than in *Realtek* (Koji accused the prior art products of infringement on January 3, 2024 and  
3 ultimately filed the notice of voluntary dismissal of the Second Action on January 30, 2024), the  
4 conduct is strikingly similar.

5 As noted, Koji never responded to REA about the fact that Koji accused two prior art  
6 products of infringing the '703 patent. And in the opposition to the instant motion, Koji does not  
7 provide any persuasive argument on this issue. As discussed in the detailed timeline above, after  
8 Koji added the new accused products to the Second Action (on January 3, 2024), Koji sent two  
9 emails on January 12, 2024, seeking a settlement counteroffer and making a settlement demand of  
10 five thousand dollars. *Id.* at 318-19. And then on January 23, 2024, Koji sent another  
11 infringement claims chart for a third product recently added to the case, without discussing the  
12 accused prior art products.

13 In light of the facts discussed above and in light of the applicable legal standards, the Court  
14 **FINDS** that, starting on January 3, 2024 and thereafter, Koji litigated the Second Action with  
15 subjective bad faith by accusing infringement by products which Koji knew no later than January  
16 18, 2024—and with the exercise of minimal diligence, should have known prior to adding them to  
17 the infringement contentions in this case—were prior art products. The Court finds that Koji's  
18 accusation of prior art products was frivolous and objectively unreasonable, because no reasonable  
19 litigant could reasonably expect success on the merits of such a position. Koji's insistence on  
20 pursuing settlement demands during this period of the Third Action, and Koji's avowed reason for  
21 filing the Third Action (simply to demand a higher settlement figure than was demanded during  
22 the Second Action) was an improper motivation and amounts to harassment. The Court **FINDS**  
23 that Koji's actions were at least reckless, if not willfully blinding themselves to the defects in the  
24 Third Action, coupled with more conduct (including making misrepresentations to this Court, as  
25 discussed below). The Court therefore **FINDS** that the Second Action is an exceptional case from  
26 January 3, 2024 onward.

27 Koji's Manner of Litigation

28 REA also argues that the Second and Third Actions were exceptional because of the



unreasonable manner in which they were litigated. Specifically, REA argues that Koji filed these lawsuits solely to extract nuisance settlements, stressing that: (1) Koji made repeated settlement offers “far below the cost of defense” during each case (particularly at the outset of each); (2) Koji strategically avoided any testing of the merits of its patent infringement claims in all three lawsuits; and (3) Koji had actual notice of the weakness of its claims as well as of REA’s intention to seek fees under § 285.

Koji’s manner of litigation and the broader context of its lawsuit against REA are relevant to the Court’s inquiry under § 285. *SFA Sys., LLC v. Newegg, Inc.*, 793 F.3d 1344, 1350 (Fed. Cir. 2015) (“[A] pattern of litigation abuses characterized by the repeated filing of patent infringement actions for the sole purpose of forcing settlements, with no intention of testing the merits of one’s claims, is relevant to a district court’s exceptional case determination under § 285.”); *Elec. Comm’n Techs., LLC v. ShoppersChoice.com, LLC*, 963 F.3d 1371, 1377 (Fed. Cir. 2020) (“ECT’s demand for a low-value settlement—ranging from \$15,000 to \$30,000—and subsequent steps—such as failure to proceed in litigation past claim construction hearings—indicates the use of litigation to achieve a quick settlement with no intention of testing the strength of the patent or its allegations of infringement.”). As discussed above, in the Second and Third Actions, Koji made settlement demands as low as \$5K and only as high as \$59K. According to American Intellectual Property Law Association’s “2019 Report of the Economic Survey” (which reports on median costs of patent litigation as reported by the survey participants), the median reported fees costs for defending the lowest risk category of patent infringement case (less than \$1 million at risk) filed by a non-practicing entity through claim construction was \$250,000, and the median fees and costs for defending such a case through trial and appeal was \$750,000. *See* <https://ipwatchdog.com/wp-content/uploads/2021/08/AIPLA-Report-of-the-Economic-Survey-Relevant-Excerpts.pdf> (last visited March 28, 2025). Reported decisions on fee awards in patent cases (such as the *Realtek* case discussed previously) similarly demonstrate that Koji’s \$59K demand was well below the cost of litigation and barely above the AIPLA survey’s reported fees and costs to defend a case through initial case management of \$40,000. *Id.* Indeed, even Koji’s lead counsel Mr. Ramey stated that Koji’s “initial offer was very low.” [Dkt. 19-1 at 152].

1 Notice of a frivolous position is relevant to the exceptional case analysis. *See Thermolife*  
2 *Int'l LLC v. GNC Corp.*, 922 F.3d 1347, 1357 (Fed. Cir. 2019) (“[O]ne consideration that can and  
3 often should be important to an exceptional-case determination is whether the party seeking fees  
4 ‘provide[d] early, focused, and supported notice of its belief that it was being subjected to  
5 exceptional litigation behavior.’”). Here, as detailed above, REA provided notice to Koji in the  
6 Second Action that the manner of litigating that case raised Rule 11 issues, sanctions issues under  
7 § 1927, as well as exceptional litigation behavior under § 285. And as soon as the Third Action  
8 was filed, Renesas gave similar notice to Koji, particularly with regard to the two-dismissal rule  
9 issue.

10 More significantly, the Court takes special note of the apparent misrepresentations by Koji  
11 in its brief opposing fees and in the declarations opposing this motion and in response to the Order  
12 to Show Cause. As detailed above, one of Koji’s arguments why the two-dismissal rule should  
13 not apply is because the claim in the Second Action somehow differed from the claim in the Third  
14 Action, primarily because the claims chart attached to the complaint in the Second Action accused  
15 a different product than in the claims chart attached to the complaint in the Third Action. [Dkt. 24  
16 at 9]. In briefing, Koji stated flatly that, for the Third Action, “Koji asked Ramey LLP to file a  
17 new lawsuit based on the newly charted product. On May 22, 2024, Koji filed the new lawsuit,  
18 accusing the entirely different Renesas system.” *Id.* at 8-9. Similarly, Koji stated in its brief that  
19 “[o]n reflection that a charted product was not included in the sales volume, Koji filed a new  
20 lawsuit accusing a new product.” *Id.* at 9; *see also id.* at 17 (“Ramey LLP determined that the  
21 additional product charted had not been accounted for in the sales volume and advised its client  
22 that the suit could be refiled as new complaint against was against a new product. On May 22,  
23 2024, Koji filed a new lawsuit against Renesas asserting the ‘703 patent against a new product that  
24 was not previously sued”). Mr. Ramey’s declaration in opposition to the instant motion makes  
25 similar averments under oath. Dkt. 24-2 at ¶¶ 12-14 And in response to the Order to Show Cause,  
26 all three lawyers of record for Koji, as well as Koji’s corporate representative Mr. Gorrichategui,  
27 made similar statements under oath. Dkt. 28-2 at ¶¶ 12-14; Dkt. 28-1 at ¶¶ 9-10; Dkt. 28-15 at ¶  
28 21; Dkt. 28-17 at ¶¶ 7-12.

1 The troubling aspect of Koji's statements and the sworn declarations of its lawyers and  
2 corporate head is that they are demonstrably misleading and misrepresent the facts. As detailed  
3 above, during the pendency of the Second Action, on January 3, 2024, Mr. Ramey identified three  
4 REA products as newly accused infringing products *in the Second Action*, and he explicitly stated  
5 that Koji was adding these products to its infringement contentions. [Dkt. 19-1 at 140]. One of  
6 the three accused products added to the Second Action by Mr. Ramey on January 3, 2024 was the  
7 REA product model number PTX130W/PTX30W. And, as discussed above, on January 23, 2024,  
8 Mr. Ramey (along with Mr. Kubiak and Ms. Kalra as cc recipients) communicated with REA's  
9 counsel, stating "[h]ere is another product we are accusing," and attaching an infringement claims  
10 chart for the PTX130W/PTX30W. *Id.* at 328-38.

11 Koji's representation that the Third Action accused a "new" or "completely different"  
12 product of infringement is false. The claims chart attached to the complaint in this Third Action is  
13 the same claims chart Koji sent to REA in connection with the Second Action. *Compare* Dkt. 1-2  
14 at 2-11, *with* Dkt. 19-1 at 329-38. Both claims charts accuse the PTX130W/PTX30W, include the  
15 same excerpts from a data sheet for the "PTX130W/PTX30W Hardware Integration," and state  
16 expressly that the PTX30W is included in the infringement accusation: "*Renesas Electronics's*  
17 *PTX130W/PTX30W (MUST BE BOUGHT TOGETHER IN ORDER TO ACHIEVE POWER*  
18 *TRANSFER) is a wireless power transfer system for wirelessly charging a powered device.*" Both  
19 claims charts also include the same explicit accusations and images of the REA PTX30W product,  
20 with the same block diagrams and images of the PTX30W board with the same annotations.

21 As discussed in detail in the Court's March 26, 2025 Order, the breadth of the infringement  
22 pleadings and requests for relief for patent infringement in both the Second Action complaint and  
23 the Third Action complaint are virtually identical. Both complaints are drafted so as to explicitly  
24 *not* limit Koji's infringement allegations in either case solely to the products identified in the  
25 claims charts attached to each complaint. From the literal face of the pleadings alone, Koji  
26 asserted literally the same cause of action in the Second and Third Actions based on alleged  
27 infringement of the '703 patent. Thus, even putting aside the fact that Mr. Ramey expressly  
28 included the PTX130W/PTX30W as an accused product during the Second Action, and then

1 attached the same claims chart accusing that product for the complaint in this Third Action, the  
2 face of the two complaints completely belies Koji's argument that the product in the Third Action  
3 was "new." The assertion that the Third Action is "new" or accused a "new product" is simply not  
4 borne out by the express language of the two complaints when compared to each other.

5 Accordingly, on this record and in light of the applicable legal standards, the Court **FINDS**  
6 that the relevant factors weigh in favor of finding that the entirety of the Third Action is an  
7 exceptional case, and that the Second Action starting from January 3, 2024 and thereafter is an  
8 exceptional case, such that fees under § 285 are warranted.

## 9 **II. Sanctions Under § 1927**

10 REA ask the Court to levy the fees against Koji's counsel as a sanction, pursuant to § 1927  
11 and the Court's inherent powers. [Dkt. 18 at 24]. REA argues that such sanctions are warranted  
12 under § 1927 because the attorneys' conduct—"pursuing baseless infringement claims and filing  
13 the Third Action despite the two dismissal rule operating as an adjudication on the merits"—was  
14 "reckless." *Id.*

15 Koji and its lawyers oppose REA's request for sanctions, arguing that: (1) REA has made  
16 "no showing" that its counsel acted in bad faith or with reckless disregard of their duties to the  
17 Court; (2) this was "routine litigation" with "no evidence to the contrary;" and (3) REA's request  
18 for sanctions "is designed to have a chilling effect on Ramey LLP and its ability to file lawsuits."  
19 [Dkt. 24 at 21].

20 As discussed above, the Court **FINDS** that the litigation of the Third Action was conducted  
21 with subjective bad faith and that the filing of the Third Action's complaint was frivolous. Mr.  
22 Ramey advised Mr. Gorrichategui that the Third Action could be filed based solely (as far as the  
23 record demonstrates) on whether or not more damages (and a higher settlement demand) could be  
24 sought for the allegedly "newly charted" product (the PTX130W/PTX30W as discussed above,  
25 which was demonstrably not new). The Ramey lawyers' filing of the Third Action, without  
26 performing any adequate pre-filing investigation into the two-dismissal rule issue under Rule 41,  
27 multiplied the proceedings vexatiously. The filing of the Third Action was vexatious because, as  
28 discussed above and in the March 26, 2025 Order, upon filing the Third Action, Mr. Ramey

1 immediately communicated with REA to demand a settlement amount more than ten times higher  
2 than what Koji had demanded just a few months earlier during the Second Action. As discussed  
3 above and in the March 26, 2025 Order, this conduct amounted to harassment.

4 During the Second Action, Koji's counsel accused two prior art products of infringement  
5 and told REA that these products "will be included in our infringement contentions" in that  
6 Second Action. [Dkt. 19-1 at 140]. This necessarily required REA and its counsel to investigate  
7 the accused products, determine that they were prior art, obtain the evidence to show their prior art  
8 dates, draft a response letter to Koji, and then follow up in further emails. *Id.* at 158-316. Mr.  
9 Ramey's addition of these products obviously multiplied the proceedings because his actions  
10 precipitated additional arguments and meet and confers between counsel about the merits of the  
11 case. Much of the activity in modern federal court litigation (particularly patent litigation)  
12 consists of correspondence, phone calls, and exchanges between counsel even without formal  
13 discovery or Patent Local Rule disclosures, and certainly long before additional pleadings or briefs  
14 are filed on the docket. And for all the reasons discussed above and in the Court's March 26, 2025  
15 Order, Mr. Ramey's multiplication of the proceedings in the Second Action amounted to  
16 harassment and vexatious conduct. At a minimum, Mr. Ramey's actions were reckless or  
17 undertaken with willful blindness and were coupled with additional troubling behavior.

18 Again, as discussed above and in the March 26, 2025 Order, the actions of Koji's counsel  
19 here were undertaken with subjective bad faith. "[S]anctions pursuant to section 1927 must be  
20 supported by a finding of subjective bad faith." *Lake*, --- F.4th ----, 2025 WL 815191, at \*5  
21 (quoting *Blixseth*, 796 F.3d at 1007). "Bad faith is present when an attorney knowingly or  
22 recklessly raises a frivolous argument or argues a meritorious claim for the purpose of harassing  
23 an opponent." *Id.* (quoting *Blixseth*, 796 F.3d at 1007) (alteration omitted). "A district court may  
24 find such bad faith 'when an attorney has acted recklessly if there is something more,' such as  
25 frivolousness, harassment, or an improper purpose." *Indiezone*, 720 Fed. Appx. At 337.

26 A "finding that the attorney recklessly or intentionally misled the court" or "a finding that  
27 the attorney[] recklessly raised a frivolous argument which resulted in the multiplication of the  
28 proceedings' amounts to the requisite level of bad faith. In addition, 'recklessly or intentionally

misrepresenting facts constitutes the requisite bad faith’ to warrant sanctions, as does ‘recklessly making frivolous filings.’” *Id.* (citations omitted).

As discussed above, Mr. Ramey, Mr. Kubiak, and Ms. Kalra all misrepresented the facts regarding whether or not REA’s PTX130W/PTX30W was a “new” product in the Third Action as compared to the Second Action. Mr. Ramey expressly and directly accused the PTX130W/PTX30W of infringing in the Second Action. Mr. Ramey, along with Mr. Kubiak and Ms. Kalra, communicated the PTX130W/PTX30W claims chart to REA during the Second Action. Mr. Ramey and Ms. Kalra signed the complaint in this Third Action, which attached the same claims chart accusing the PTX130W/PTX30W sent to REA during the Second Action.

Despite this, Mr. Ramey submitted a declaration to this Court under oath averring that this Third Action was “accusing an entirely different Renesas system.” [Dkt. 28-2 at ¶ 14]. Ms. Kalra likewise stated under oath that this Third Action—which she refers to as the “new lawsuit in this Court”—was “accusing an entirely different Renesas system through a complaint I approved.” [Dkt. 28-1 at ¶ 10]. Mr. Kubiak similarly declared under oath that the infringement accusation in this Third Action was for “a new product,” even though he was on the email during the Second Action when the claims chart for this same product was sent to REA. [Dkt. 28-15 at ¶ 19].

It is clear from the record in this case that Mr. Ramey was personally and directly involved in the decision-making for the troubling actions taken here. For example, Koji’s corporate representative, Mr. Gorrichategui, stated under oath that, after the voluntary dismissal of the Second Action, “[o]n April 25, 2024, I told William Ramey that my team and I revisited the Renesas Electronics claim chart and wanted to seek damages on a new product we charted. I authorized the filing of the Third suit if we could. William Ramey informed me that we could file the Third lawsuit.” [Dkt. 28-17 at ¶ 11]. First, Mr. Gorrichategui’s sworn statement that the Third Action involved “a new product we charted” is again demonstrably misleading—the PTX30W was directly at issue in the Second Action. This misrepresentation of facts is further support for the finding of bad faith as against Koji itself for the award of fees discussed above. Second, and more importantly for § 1927, Mr. Gorrichategui’s declaration demonstrates that Mr. Ramey advised Koji expressly that they could file the Third Action simply to seek more damages without



any evidence in the record as to any pre-filing diligence (or even mention) of the two-dismissal rule under Rule 41(a)(1)(B).

Additionally, as discussed in the March 26, 2025 Order, Mr. Ramey misrepresented the timing and reasons for Ramey firm lawyers' failure to file *pro hac vice* applications in this and dozens of other cases, by trying to place the blame for that decision on an alleged directive from Mr. Gorrichategui in 2022. Mr. Ramey's declaration in that regard was demonstrably false in light of the numerous failures to file *pro hac vice* applications for numerous other clients prior to 2022.

As discussed above, Koji's counsels' conduct during this litigation was exceptionally unjustified and undertaken with bad faith (and at least recklessness or willful blindness): despite knowing facts from the outset that should have put these lawyers on notice that pre-filing inquiry into the two-dismissal rule was necessary before filing the Third Action, these lawyers did not conduct an adequate pre-filing investigation (and according to the declarations, the only investigation was whether the allegedly "new" product could be accused in the Third Action for an increase in damages claimed). Through this conduct (including misrepresenting facts to this Court), Koji was able to drag out this litigation across three cases in two separate venues, forcing REA to incur significant additional expenses in numerous ways, including briefing on the instant motion and the time and effort expended to correspond with Koji's counsel regarding the merits of the cases.

The Ninth Circuit has made clear that the filing of a complaint cannot be the basis for sanctions under § 1927. *See In re Keegan Mgmt. Co., Sec. Litig.*, 78 F.3d 431, 435 (9th Cir. 1996) ("Because [§ 1927] authorizes sanctions only for the 'multipli[cation of] proceedings,' it applies only to unnecessary filings and tactics once a lawsuit has begun. We have twice expressly held that § 1927 cannot be applied to an initial pleading."). Accordingly, the Court limits the sanctions under § 1927 to exclude any attorneys' fees incurred by REA with regard to work undertaken to respond to the complaint in the Third Action, but to include work subsequent to that time period including the time spent on the instant motion and any work undertaken with regard to the Order to Show Cause. The conduct of Koji's lawyers here with regard to the Second Action all took



place after that action had commenced, and thus, is not impacted by the limitation of *Keegan*. Therefore, pursuant to § 1927, the Court **FINDS** that the three Ramey law firm lawyers—Mr. Ramey, Mr. Kubiak, and Ms. Kalra—shall be jointly and severally liable along with Koji for the fees awarded to REA with regard to the time period of the Second Action discussed above (January 3, 2024 onward), and with regard to fees incurred by REA separate from and after the work undertaken to respond to the complaint in the Third Action, up to and including the present.

### III. Sanctions Under the Court's Inherent Powers

REA argues that imposing the fee award against Koji's lawyers as a sanction is also appropriate under the Court's inherent authority, because "the filing and re-filing of these cases is conduct tantamount to bad faith." [Dkt. 18 at 24-26].

Koji and its lawyers oppose REA's request for sanctions as against the lawyers on the same grounds argued to oppose sanctions under § 1927: (1) REA has made "no showing" that its counsel acted in bad faith or with reckless disregard of their duties to the Court; (2) this was "routine litigation" with "no evidence to the contrary;" and (3) REA's request for sanctions "is designed to have a chilling effect on Ramey LLP and its ability to file lawsuits." [Dkt. 24 at 21].

For all the reasons discussed above with regard to § 1927, with respect to the Court's inherent power to issue sanctions, the Court **FINDS** find that Koji's counsel's actions were "tantamount to bad faith." *Christian v. Mattel, Inc.*, 286 F.3d 1118, 1131 (9th Cir. 2002). As discussed above, the filing and prosecution of the Third Action (without any adequate pre-filing investigation into the Rule 41 issue) was subjective bad faith, frivolous, and undertaken vexatiously, for improper purpose, and to harass REA. And, as discussed above, the accusation of prior art products in the Second Action was similarly done with subjective bad faith, frivolous, and undertaken vexatiously, for improper purpose, and to harass REA. Further, the three lawyers here misrepresented facts to this Court, as detailed above.

"The filing of a complaint may be sanctioned pursuant to Rule 11 or a court's inherent power, but it may not be sanctioned pursuant to § 1927." *Keegan*, 78 F.3d at 435. Accordingly, the Court will not limit the sanctions under its inherent powers and will not exclude any attorneys' fees incurred by Renesas with regard to work undertaken to respond to the complaint in the Third

1 Action. Therefore, in the full exercise of the Court’s inherent authority, the Court **FINDS** that the  
2 three Ramey law firm lawyers—Mr. Ramey, Mr. Kubiak, and Ms. Kalra—shall be jointly and  
3 severally liable along with Koji for the fees awarded to REA with regard to the time period of the  
4 Second Action discussed above (January 3, 2024 onward), and with regard to fees incurred by  
5 Renesas with regard to the entirety of the Third Action, up to and including the present.

#### 6 **IV. Amount of Fees**

7 Having determined that attorney fees are warranted under § 285, the Court must determine  
8 the reasonable amount of the award. *See Mathis v. Spears*, 857 F.2d 749, 754 (Fed. Cir. 1988)  
9 (“Section 285’s requirement that the fees awarded be ‘reasonable’ is a safeguard against excessive  
10 reimbursement.”).

11 The customary method of determining attorney fees is known as the lodestar method. The  
12 Court must first calculate a “lodestar” figure by “multiplying the number of hours reasonably  
13 expended on the litigation times a reasonable hourly rate.” *Vargas v. Howell*, 949 F.3d 1188,  
14 1194 (9th Cir. 2020) (citing *Blum v. Stenson*, 465 U.S. 886, 888 (1984)). The lodestar figure is  
15 presumptively reasonable. *City of Burlington v. Dague*, 505 U.S. 557, 562 (1992). While this  
16 lodestar amount is presumed to represent an appropriate fee, under certain circumstances, a court  
17 may then adjust the award upward or downward to take into account special factors. “Only in rare  
18 instances should the lodestar figure be adjusted on the basis of other considerations.” *United*  
19 *States v. \$28,000.00 in U.S. Currency*, 802 F.3d 1100, 1108 (9th Cir. 2015) (quoting *Harris v.*  
20 *Marhoefer*, 24 F.3d 16, 18 (9th Cir. 1994)).

21 Here, REA has submitted supporting materials for its request for fees as of June 26, 2024,  
22 totaling \$37,503.50. [Dkt. 18 at 26]. However, as discussed herein, the fee award includes only a  
23 portion of the time spent on the Second Action and, for the Third Action, potentially extends  
24 beyond June 2024. The Supreme Court has cautioned for “the need in particular circumstances to  
25 advance considerations of compensation and deterrence.” *Octane*, 572 U.S. at 554 n.6 (quoting  
26 *Fogerty*, 510 U.S. at 534 n.19). Here, compensation and deterrence considerations are adequately  
27 served by requiring Koji to pay for the portions of the Second Action attributable to the accusation  
28 of prior art products. It is axiomatic that requiring a plaintiff to pay a defendant's fees for portions

of the case that were not exceptional is beyond the purposes of § 285, would be punitive instead of compensatory, and could have some impact in unintentionally deterring legitimate claims.

Further, as discussed above, the calculation of fees to be awarded jointly and severally as against both Koji and the three lawyers under § 1927 differs from the fees to be awarded jointly and severally under the Court's inherent authority. Accordingly, updated and edited submissions from REA are required for the Court to be able to meaningfully determine (a) the total amount of fees to be awarded under § 285 as against Koji and awarded jointly and severally as against both Koji and the three Ramey lawyers under the Court's inherent powers, and (b) the subset of fees to be awarded jointly and severally as against Koji and the three Ramey lawyers under § 1927.

A final word on sanction: again, as discussed in the March 26, 2025 Order, the conduct here is truly extraordinary. Contrary to Koji's arguments that this litigation was "routine," the facts detailed here demonstrate a pattern and practice of egregious behavior by the lawyers involved. In particular, the manner of litigation here, including the misrepresentations by counsel, is unprecedented in the decades of the undersigned's experience in patent law and litigation both on and off the bench. The robust, constitutionally derived patent system depends on attorneys adhering at a minimum to the rules of law and legal guidelines for the normative prosecution of meritorious claims and pursuit of appropriate defenses. This Order is specific to the conduct detailed herein, which is decidedly not a mine-run case.

### CONCLUSION

Accordingly, **IT IS ORDERED THAT:**

1. The motion for fees and sanctions [Dkt. 18] is **GRANTED**.
2. REA **SHALL** submit a complete justification for the fees it seeks, by no later than **April 14, 2025**, including justification for the rates charged and the time spent, organized to facilitate the Court's review and adjustment of the requested fees. REA's submission shall be organized in a way which readily enables the Court to determine (a) the total amount of fees to be awarded under § 285 as against Koji and to be awarded jointly and severally as against both Koji and the three Ramey lawyers under the Court's inherent authority, and (b) the subset of fees to be awarded jointly and severally as against Koji and the three

1 Ramey lawyers under § 1927.

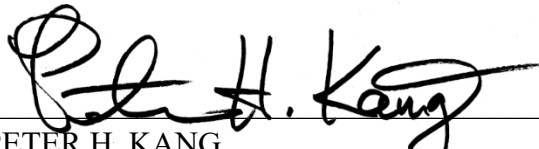
- 2 3. Koji **SHALL** file its objections, if any, to REA's submission, by no later than **April 28,**  
3 **2025.** REA may file a response to Koji's objections, if any, by no later than **May 5, 2025.**
- 4 4. Attorneys William P. Ramey, III, Jeffrey E. Kubiak, and Susan S.Q. Kalra are each  
5 **SANCTIONED** for their conduct detailed herein under both § 1927 and the Court's  
6 inherent authority.
- 7 5. The Court finds that monetary sanctions alone are not sufficient to deter the conduct at  
8 issue here and finds that additional monetary sanctions would not be appropriate  
9 compensation and would not serve the goal of deterrence. Accordingly, in the full exercise  
10 of the Court's inherent authority, the Court further **ORDERS** Mr. Ramey, Mr. Kubiak, and  
11 Ms. Kalra to each complete at least two hours of in-person, California bar-approved CLE  
12 classes on Federal Court Litigation (one hour of which shall include a Legal Ethics  
13 component or credit), and at least an additional two hours of in-person, California bar-  
14 approved CLE on Patent Litigation (one hour of which shall include a Legal Ethics  
15 component or credit), by no later than **March 31, 2026.** Mr. Ramey, Mr. Kubiak, and Ms.  
16 Kalra **SHALL** each file with the Court a certification, under oath, that each has completed  
17 such CLE by the deadline (attaching any certificate of completion from the CLE  
18 provider(s)), where such certification shall be filed within **ten (10) business days** of the  
19 completion of each such CLE course.
- 20 6. In the exercise of the Court's inherent authority, by no later than **May 1, 2025,** Mr. Ramey,  
21 Mr. Kubiak, and Ms. Kalra **SHALL** each self-report the sanctions imposed on them herein  
22 and provide a copy of this Order to the relevant disciplinary committees or offices of the  
23 State Bar of California, the State Bar of Texas, the bar of the United States District Court  
24 for the District of Colorado, the United States Patent and Trademark Office, and any other  
25 state or federal bars of which they are members. Within **ten (10) business days** of  
26 completing the self-reporting requirements, these attorneys **SHALL** file with this Court a  
27 certification under oath certifying they have self-reported as required.
- 28 7. In the exercise of the Court's inherent authority, by no later than **May 1, 2025** each of

these attorneys **SHALL** self-report the sanctions imposed on them herein and provide a copy of this Order to the Northern District of California's Standing Committee of Professional Conduct, to the judges presiding over every other case currently pending in the Northern District of California in which any of these attorneys' names appears on any filings or pleadings (including all cases in which their names appear as "*pro hac vice* anticipated" or similar language), and as an attachment to any motion for *pro hac vice* admission filed by or on behalf of any of these lawyers in any action filed in this Court **during the next five years**. Within **ten (10) business days** of completing these self-reporting requirements, these attorneys **SHALL** file with this Court a certification under oath certifying they have self-reported as required.

8. As noted, the record indicates that the conduct at issue here resulted from practices or policies of the Ramey law firm with regard to failure to conduct reasonable pre-filing inquiry before filing a third complaint after two prior voluntary dismissals of the same cause of action. Therefore, the Court further **ORDERS** Mr. Ramey, Mr. Kubiak, and Ms. Kalra to provide all attorneys of the Ramey law firm copies of this Order as well as copies of all educational materials received in connection with the CLE courses ordered above. The required distribution of this Order shall be completed by no later than **April 7, 2025**. The required distribution of CLE educational materials shall be completed within **ten (10) business days** of the completion of each of the CLE courses ordered herein. The certifications ordered above **SHALL** include certifications by Mr. Ramey and Mr. Kubiak of the distribution of this Order and the CLE educational materials to all Ramey firm lawyers. The Court **SHALL** retain jurisdiction over these attorneys, pending completion of the payments, CLEs, and certifications required by this Order, and to ensure proper compliance with this Order and the Court's directives.

**IT IS SO ORDERED.**

Dated: March 31, 2025

  
PETER H. KANG  
United States Magistrate Judge

UNITED STATES DISTRICT COURT  
NORTHERN DISTRICT OF CALIFORNIA  
SAN FRANCISCO DIVISION

KOJI IP, LLC,

Plaintiff,

v.

RENESAS ELECTRONICS AMERICA,  
INC.,

Defendant.

Case No. [24-cv-03089-PHK](#)

**ORDER REGARDING OSC AND  
IMPOSING SANCTIONS ON RAMEY  
FIRM LAWYERS**

Re: Dkt. 27

“**Every** member of the bar of this Court **and any attorney permitted to practice in this Court** under Civil L.R. 11 **must** . . . [b]e familiar with **and comply with** the standards of professional conduct required of members of the State Bar of California.” Civil L.R. 11-4 (emphasis added).

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This is a patent infringement action. But this Order goes beyond patent law and touches on issues relevant to the rules of professional conduct for federal practitioners.

The Parties have consented to proceed before a Magistrate Judge for all purposes, including entry of a final judgment under 28 U.S.C. § 636(c). *See* Dkts. 10, 20. Now before the Court are responses and supplemental briefing from Plaintiff’s counsel from the Ramey law firm—Attorneys William P. Ramey, III, Susan S.Q. Kalra, and Jeffrey E. Kubiak—with respect to this Court’s Order to Show Cause (“OSC”). *See* Dkts. 28, 33, 38. The Court issued the OSC, on August 29, 2024, regarding why these attorneys should not be sanctioned under Federal Rule of Civil Procedure 11 and the Court’s inherent authority. [Dkt. 27]. In connection with Defendant’s motion for attorneys’ fees and sanctions, Defendant’s counsel brought to the Court’s attention

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information indicating that Plaintiff's counsel may have been engaging in the unauthorized practice of law in this Court and/or aiding and abetting the unauthorized practice of law. [Dkt. 25 at 15]. The Court will issue a separate Order on that motion for fees and sanctions which are legally unrelated to the issues at hand. With regard to the OSC, the Court held a hearing on September 19, 2024. *See* Dkts. 30, 40. After post-hearing briefing, the matter is now deemed submitted and the Court turns to its analysis, starting with a brief summary of the relevant procedural history.

### **RELEVANT BACKGROUND**

#### **I. The Ramey Firms Filed and Voluntarily Dismissed Three Patent Infringement Lawsuits on Behalf of the Same Plaintiff Asserting the Exact Same Patent Against the Exact Same Defendant in Each Case.**

On May 22, 2024, Plaintiff commenced this patent infringement action against Defendant. *See* Dkt. 1. This is the *third* lawsuit filed by one or all of these attorneys of the Ramey LLP firm on behalf of Koji IP, LLC; and in all three lawsuits, the Ramey firm (on behalf of its client Koji) accused Renesas Electronics America, Inc. of infringing U.S. Patent No. 10,790,703. *See* Complaint *Koji IP, LLC v. Renesas Electronics America, Inc.* ("*Koji P*"), No. 1:23-cv-01674-SKC (D. Colo. Jun. 30, 2023), ECF No. 1; Complaint, *Koji IP, LLC v. Renesas Electronics America, Inc.* ("*Koji IP*"), No. 3:23-cv-05752-LJC (N.D. Cal. Nov. 8, 2023), ECF No. 1.

These Ramey firm lawyers filed voluntary dismissals of each of the first two *Koji v. Renesas* actions under Federal Rule of Civil Procedure 41. *See* Notice of Voluntary Dismissal, *Koji I*, No. 1:23-cv-01674-SKC (D. Colo. Sept. 6, 2023), ECF No. 18; Notice of Voluntary Dismissal, *Koji II*, No. 3:23-cv-05752-LJC (N.D. Cal. Jan. 30, 2024), ECF No. 12. These lawyers then filed the third *Koji v. Renesas* lawsuit (the case currently at hand) less than a year after voluntarily dismissing the second identical lawsuit. [Dkt. 1]. As with those two prior lawsuits, Plaintiff voluntarily dismissed this Third Action on June 12, 2024. [Dkt. 12]. When they filed the voluntary dismissal of this third *Koji v. Renesas* case, the lawyers here filed no explanation for their basis for filing the case in the first instance (despite the clear mandates of Federal Rule of Civil Procedure 41(a)(1)(B)).



## II. Unauthorized Practice of Law.

On June 26, 2024, Defendant filed a motion for attorneys' fees and sanctions. [Dkt. 18]. Plaintiff opposed, and Defendant filed a reply. [Dkt. 24; Dkt. 25]. In the reply brief, Defendant raised the issue of the potential unauthorized practice of law by Plaintiff's counsel, Mr. Ramey. [Dkt. 25 at 15]. The Court heard oral argument on that motion on August 22, 2024. *See* Dkt. 26. Ms. Kalra (another Ramey firm lawyer) appeared as counsel for Plaintiff at that hearing, but the other Ramey firm lawyers identified on the pleadings (Mr. Ramey and Mr. Kubiak) did not appear. During oral argument, counsel for Defendant raised additional details on the alleged unauthorized practice of law by Mr. Ramey.

In this matter, Ms. Kalra—who during the relevant time period here and until recently was registered on the Court's electronic case filing ("ECF") system as counsel of record for Plaintiff—filed the complaint, civil cover sheet, report on the filing of a patent action, certificate of interested entities, and proposed summons. *See* Dkts. 1-5. The documents filed by Ms. Kalra in this case state that they originated from the law offices of Ramey LLP, 5020 Montrose Blvd., Suite 800, Houston, Texas 77006. Ms. Kalra is a member of the Northern District of California bar and an active member of the State Bar of California in good standing.

The body of the text of the complaint is signed by Ms. Kalra and identifies her to be Plaintiff's counsel ("Susan S.Q. Kalra (CA State Bar No. 16740)"). [Dkt. 1 at 7]. Ms. Kalra and Mr. Ramey *both* signed the jury demand on the final page of the complaint, and they are identified therein as "Attorneys for Plaintiff." *Id.* at 8. The front page of the complaint includes the names of these two attorneys and similarly identifies them as "Attorneys for Plaintiff." *Id.* at 1. The final page of the complaint is signed by these two attorneys but also includes the name and contact information for another attorney from the Ramey LLP firm, Mr. Kubiak (also there identified as one of the "Attorneys for Plaintiff"). *Id.* at 8. In the signature block on the last page of the complaint, both Mr. Ramey and Mr. Kubiak have the words "*pro hac vice* anticipated" next to their names along with Texas Bar numbers. *Id.* Mr. Ramey's signature appears not just on the complaint but also on several other documents filed in this case on behalf of Plaintiff. For example, the notice of voluntary dismissal in this case was signed by both Ms. Kalra and Mr.

Ramey—both identified as “Attorneys for Plaintiff”—and Mr. Ramey includes the “*pro hac vice* anticipated” language after his name in that filing as well. [Dkt. 12 at 2].

By affixing “*pro hac vice* anticipated” next to their names in documents filed on the docket since the earliest days of this case, Mr. Ramey and Mr. Kubiak appear to indicate their intent to seek *pro hac vice* admission to this Court for this matter. The problem is that, to date, neither has filed (and no attorney has filed) a motion on either Mr. Ramey’s or Mr. Kubiak’s behalf seeking *pro hac* status in this case.

The record reveals that Mr. Ramey and Mr. Kubiak are out-of-state attorneys who are acting as Plaintiff’s litigation counsel in this case. The information provided by Ms. Kalra at the hearing on August 22, 2024 made clear that Mr. Ramey was engaged in the bulk of legal activity in litigating this case. As noted, neither Mr. Ramey nor Mr. Kubiak are licensed to practice law in California. Neither individual had sought, much less been granted, *pro hac vice* status in this case. The docket shows plainly that there was no application for *pro hac vice* admission filed on their behalf at the time of the filing of the complaint in this action, despite the instructions for the timing of such a motion in the Northern District of California’s Civil Local Rules. *See* Civil L.R. 11-3(b).

As noted above, this is the third in a trilogy of cases filed by these attorneys on behalf of this same Plaintiff alleging infringement by this same Defendant of the same asserted patent. The Second Action was filed in this Court on November 8, 2023. *Koji II*, No. 3:23-cv-05752-LJC (N.D. Cal. Nov. 8, 2023), ECF No. 1. The identification of Plaintiff’s counsel in the complaint in that Second Action is identical in all material respects to the complaint in this Third Action: Ms. Kalra and Mr. Ramey signed the complaint on the final page under the jury demand language; Ms. Kalra signed the body of the complaint; both Ms. Kalra and Mr. Ramey are identified on the face sheet and in the signature block on the final page as “Attorneys for Plaintiff;” and Mr. Kubiak is further identified as one of the “Attorneys for Plaintiff” in the signature block on the final page. Both Mr. Ramey and Mr. Kubiak list their Texas bar numbers and include the notation “*pro hac vice* anticipated” in the signature block on the last page (and, for Mr. Ramey, on the face sheet) of that *Koji II* complaint. No application for *pro hac vice* admission was ever filed on behalf of

either Mr. Ramey or Mr. Kubiak in the Second Action and certainly none was filed at the time of the filing of the complaint in that case (again despite the strictures in the Civil Local Rules).

At the motion hearing on August 22, 2024, counsel for Defendant brought to the Court's attention the fact that Mr. Ramey has appeared as counsel on pleadings in numerous cases in this District prior to the current action. Based on the Court's further investigation, it became clear that Mr. Ramey and Mr. Kubiak have regularly litigated numerous cases in the Northern District of California without being members of the California bar or the Northern District of California's Bar and without seeking *pro hac vice* admission in virtually all of these prior cases.

To date, the Court has identified at least **fifty-six other** civil actions in the Northern District of California in which Mr. Ramey registered as an attorney of record for a party on the docket for each of those cases, or at a minimum, signed the pleadings identifying himself to be the plaintiff's counsel with "*pro hac vice*" status or "*pro hac vice* anticipated" language added. *See CyboEnergy, Inc. v. Duracell Power Center, LLC*, No. 3:24-cv-08891-LJC (filed 12/10/24) (attorney to be noticed); *WirelessWerx IP, LLC v. Zipline Int'l, Inc.*, No. 3:24-cv-08462-PHK (filed 11/26/24) (attorney to be noticed); *Kephart Consulting, LLC v. AxxonSoft US, Inc.*, No. 4:24-cv-06770-KAW (filed 9/26/24) (lead attorney); *VDPP, LLC v. Roku, Inc.*, No. 5:24-cv-05303-VKD (filed 8/16/24) (signed complaint with "*pro hac vice*"); *mCom IP, LLC v. WestAmerica Bancorporation*, No. 3:24-cv-03609-SK (filed 6/14/24) (signed jury demand with "*pro hac vice* anticipated"); *Autonomous IP, LLC v. Lyft, Inc.*, No. 3:24-cv-03348-RFL (filed 6/4/24) (attorney to be noticed); *Linfo IP, LLC v. Alibaba Grp. (U.S.) Inc.*, No. 3:24-cv-03098-RS (filed 5/22/24) (lead attorney); *WFR IP, LLC v. Alibaba Grp. (U.S.) Inc.*, No. 3:24-cv-02179-TSH (filed 4/12/24) (signed complaint with "*pro hac vice*"); *Linfo IP, LLC v. Third Love, Inc.*, No. 4:24-cv-02195-HSG (filed 4/12/24) (signed complaint with "*pro hac vice*"); *Flick Intelligence, LLC v. HTC Am. Inc.*, No. 5:24-cv-02201-NC (filed 4/12/24) (signed complaint with "*pro hac vice* anticipated"); *PacSec3, LLC v. Radware, Inc.*, No. 3:24-cv-02146-AGT (filed 4/10/24) (signed complaint with "*pro hac vice* anticipated"); *VDPP, LLC v. Xiaomi USA, LLC*, No. 5:24-cv-01783-EKL (filed 3/22/24) (lead attorney); *VDPP, LLC v. Vivitek Corp.*, No. 5:24-cv-01781-BLF (filed 3/22/24) (attorney to be noticed); *VDDP, LLC v. Motorola Mobility LLC*, No. 3:24-cv-01672-LJC

(filed 3/18/24) (lead attorney); *WirelessWerx IP, LLC v. Lyft, Inc.*, No. 5:24-cv-01144-VKD (filed 2/26/24) (attorney to be noticed); *WirelessWerx IP, LLC v. Wing Aviation LLC*, No. 4:24-cv-01040-YGR (filed 2/21/24) (signed jury demand with “*pro hac vice* anticipated”); *SmartWatch MobileConcepts, LLC v. Google, LLC*, No. 3:24-cv-00937-RFL (filed 2/16/24) (lead attorney); *Missed Call, LLC v. Twilio Inc.*, No. 3:24-cv-00681-LB (filed 2/5/24) (lead attorney); *Missed Call, LLC v. RingCentral, Inc.*, No. 3:23-cv-06728-TLT (filed 12/31/23) (signed jury demand with “*pro hac vice* anticipated”); *Missed Call, LLC v. 8x8, Inc.*, No. 3:23-cv-06723-VC (filed 12/30/23) (signed jury demand with “*pro hac vice* anticipated”); *WirelessWerx IP, LLC v. OnFleet, Inc.*, No. 3:23-cv-06724-AMO (filed 12/30/23) (signed complaint and jury demand with “*pro hac vice* anticipated”); *WirelessWerx IP, LLC v. Life360, Inc.*, No. 3:23-cv-06725-AMO (filed 12/30/23) (signed complaint and jury demand with “*pro hac vice* anticipated”); *Mesa Digital, LLC v. Quanta Comp. USA, Inc.*, No. 3:23-cv-06711-VC (filed 12/29/23) (signed jury demand with “*pro hac vice* anticipated”); *CyboEnergy, Inc. v. N. Elec. Power Tech., Inc.*, No. 4:23-cv-06121-JST (filed 11/27/23) (signed complaint with “*pro hac vice* anticipated”); *Koji IP, LLC v. Energous Corp.*, No. 4:23-cv-05750-HSG (filed 11/8/23) (attorney to be noticed); *Vilox Techs., LLC v. Salesforce, Inc.*, No. 3:23-cv-05047-AMO (filed 10/2/23) (attorney to be noticed); *Fare Techs. LLC v. Lyft, Inc.*, No. 3:23-cv-04935-RFL (filed 9/26/23) (attorney to be noticed); *Flick Intelligence, LLC v. Google, LLC*, No. 3:23-cv-04803-TLT (filed 9/19/23) (attorney to be noticed); *HyperQuery, LLC v. LG Elecs. U.S.A., Inc.*, No. 3:23-cv-04725-JCS (filed 9/14/23) (attorney to be noticed); *VDPP, LLC v. Vivo, Inc.*, No. 5:23-cv-04241-NC (filed 8/18/23) (lead attorney); *Ask Sydney, LLC v. Google, LLC*, No. 3:23-cv-03955-JD (filed 8/8/23) (attorney to be noticed); *Safecast Ltd. v. Google, LLC*, No. 5:23-cv-03128-PCP (filed 6/23/23) (lead attorney); *Haley IP, LLC v. Motive Techs., Inc.*, No. 4:23-cv-02923-HSG (filed 6/14/23) (lead attorney); *ALD Social, LLC v. Apple, Inc.*, No. 3:23-cv-02695-JSC (filed 5/31/23) (attorney to be noticed); *Silent Commc’n, LLC v. Adobe, Inc.*, No. 3:23-cv-02696-TLT (filed 5/31/23) (attorney to be noticed); *Flick Intelligence LLC v. Niantic, Inc.*, No. 3:23-cv-02219-TLT (filed 5/5/23) (jury demand with “*pro hac vice* anticipated”); *WirelessWerx IP, LLC v. Google, LLC*, No. 4:23-cv-01852-JST (filed 4/17/23) (attorney to be noticed); *WirelessWerx IP, LLC v. Uber Techs., Inc.*, No. 3:23-cv-00990-AMO

(filed 3/3/23) (attorney to be noticed); *Street Spirit IP LLC v. Meta Platforms, Inc. f/k/a Facebook, Inc.*, No. 3:23-cv-00879-WHA (filed 2/27/23) (signed complaint and jury demand with “*pro hac vice* anticipated”); *Street Spirit IP LLC v. Instagram et al.*, No. 3:23-cv-00883-WHA (filed 2/27/23) (signed complaint and jury demand with “*pro hac vice* anticipated”); *Street Spirit IP LLC v. LinkedIn Corp.*, No. 3:23-cv-00884-AMO (filed 2/27/23) (signed complaint and jury demand with “*pro hac vice* anticipated”); *ALD Social LLC v. Verkada, Inc.*, No. 3:23-cv-00049-JSC (filed 1/5/23) (attorney to be noticed); *Escapex IP LLC v. Google LLC*, No. 3:22-cv-08711-VC (filed 12/13/22) (attorney to be noticed); *ESIGNATURE SOFTWARE, LLC v. Adobe, Inc.*, No. 3:22-cv-05962-JSC (filed 10/12/22) (attorney to be noticed); *Traxcell Techs., LLC v. Google LLC*, No. 3:22-cv-04807-JSC (filed 8/22/22) (lead attorney); *Valjakka v. Netflix, Inc.*, No. 4:22-cv-01490-JST (filed 3/9/22) (lead attorney); *CyboEnergy, Inc. v. N. Elec. Power Tech., Inc.*, No. 3:21-cv-08534-SI (filed 11/2/21) (lead attorney); *Riggs Tech. Holdings, LLC v. Vagaro, Inc.*, No. 3:21-cv-07927-TSH (filed 10/8/21) (attorney to be noticed); *PacSec3, LLC v. Juniper Networks, Inc.*, No. 5:21-cv-07812-EJD (filed 10/6/21) (attorney to be noticed); *Apple Inc. v. Traxcell Techs. LLC*, No. 3:21-cv-06059-EMC (filed 8/5/21) (attorney to be noticed); *DATREC, LLC v. Prognosis, Inc.*, No. 3:21-cv-01595-JCS (filed 3/5/21) (lead attorney); *NetSoc, LLC v. LinkedIn Corp.*, No. 3:20-cv-00483-VC (filed 1/22/20) (lead attorney); *NetSoc, LLC v. Quora, Inc.*, No. 3:19-cv-06518-VC (filed 10/11/19) (lead attorney); *Global Equity Mgmt. (SA) Pty. Ltd. v. Alibaba.com Inc.*, No. 3:17-cv-02177-WHA (filed 4/19/17) (lead attorney); *Global Equity Mgmt. (SA) Pty. Ltd. v. eBay, Inc.*, No. 3:17-cv-02178-WHA (filed 4/19/17) (lead attorney); *Global Equity Mgmt. (SA) Pty. Ltd. v. Alibaba Grp. Holding, Ltd.*, No. 3:17-cv-02435-WHA (filed 4/28/17) (attorney of record).

Mr. Ramey sought *pro hac vice* admittance in **only ten of those fifty-six cases** (three of which occurred subsequent to the OSC hearing). See *WirelessWerx IP, LLC v. Zipline Int’l, Inc.*, No. 3:24-cv-08462-PHK (application filed 3/4/25 averring *pro hac vice* granted “4” times in the twelve months prior); *Kephart Consulting, LLC v. AxonSoft US, Inc.*, No. 4:24-cv-06770-KAW (application filed on 2/24/25 averring “3” times in the twelve months prior); *CyboEnergy, Inc. v. Duracell Power Center, LLC*, No. 3:24-cv-08891-LJC (application filed 12/12/24 averring “0”



times in the twelve months prior); *WirelessWerx IP, LLC v. Lyft, Inc.*, No. 5:24-cv-01144-VKD (application filed on 4/29/24 averring “0” times in the twelve months prior); *CyboEnergy, Inc. v. N. Elec. Power Tech., Inc.*, No. 3:21-cv-08534-SI (application filed on 3/23/24 averring “1” time in the twelve months prior); *Safecast Ltd. v. Google, LLC*, No. 5:23-cv-03128-PCP (application filed on 8/3/23 averring “1” time in the twelve months prior); *Traxcell Techs., LLC v. Google LLC*, No. 3:22-cv-04807-JSC (application filed on 10/28/22 averring “3” times in the twelve months prior); *Apple Inc. v. Traxcell Techs. LLC*, No. 3:21-cv-06059-EMC (application filed on 2/8/22 averring “n/a” times in the twelve months prior); *DATREC, LLC v. Prognosis, Inc.*, No. 3:21-cv-01595-JCS (application filed on 4/14/21); *NetSoc, LLC v. Quora, Inc.*, No. 3:19-cv-06518-VC (application filed on 11/26/19).

The Court has likewise identified at least **seventeen other** civil actions in the Northern District of California (not including the Second Action or this Third Action) in which Mr. Kubiak registered as an attorney of record for a party on the docket for each of those cases, or at a minimum, is designated in the pleadings as a party’s counsel with “*pro hac vice*” or “*pro hac vice anticipated*” status language added. *See VDPP, LLC v. Roku, Inc.*, No. 5:24-cv-05303-VKD (filed 8/16/24) (“*pro hac vice*”); *mCom IP, LLC v. WestAmerica Bancorporation*, No. 3:24-cv-03609-SK (filed 6/14/24) (“*pro hac vice anticipated*”); *Autonomous IP, LLC v. Lyft, Inc.*, No. 3:24-cv-03348-RFL (filed 6/4/24) (lead attorney); *Linfo IP, LLC v. Alibaba Grp. (U.S.) Inc.*, No. 3:24-cv-03098-RS (filed 5/22/24) (“*pro hac vice anticipated*”); *WFR IP, LLC v. Alibaba Grp. (U.S.) Inc.*, No. 3:24-cv-02179-TSH (filed 4/12/24) (“*pro hac vice*”); *Linfo IP, LLC v. Third Love, Inc.*, No. 4:24-cv-02195-HSG (filed 4/12/24) (“*pro hac vice*”); *VDPP, LLC v. Xiaomi USA, LLC*, No. 5:24-cv-01783-EKL (filed 3/22/24) (“*pro hac vice*”); *WirelessWerx IP, LLC v. Wing Aviation LLC*, No. 4:24-cv-01040-YGR (filed 2/21/24) (“*pro hac vice anticipated*”); *SmartWatch MobileConcepts, LLC v. Google, LLC*, No. 3:24-cv-00937-RFL (filed 2/16/24) (attorney to be noticed); *Missed Call, LLC v. RingCentral, Inc.*, No. 3:23-cv-06728-TLT (filed 12/31/23) (“*pro hac vice anticipated*”); *Missed Call, LLC v. 8x8, Inc.*, No. 3:23-cv-06723-VC (filed 12/30/23) (“*pro hac vice anticipated*”); *WirelessWerx IP, LLC v. OnFleet, Inc.*, No. 3:23-cv-06724-AMO (filed 12/30/23) (“*pro hac vice anticipated*”); *WirelessWerx IP, LLC v. Life360, Inc.*, No. 3:23-cv-06725-

AMO (filed 12/30/23) (“*pro hac vice* anticipated”); *Koji IP, LLC v. Energous Corp.*, No. 4:23-cv-05750-HSG (filed 11/8/23) (“*pro hac vice* anticipated”); *Flick Intelligence, LLC v. Google, LLC*, No. 3:23-cv-04803-TLT (filed 9/19/23) (lead attorney); *Haley IP, LLC v. Motive Techs., Inc.*, No. 4:23-cv-02923-HSG (filed 6/14/23) (lead attorney); *Silent Commc’n, LLC v. Adobe, Inc.*, No. 3:23-cv-02696-TLT (filed 3/31/23) (attorney to be noticed).

Mr. Kubiak admits that he sought *pro hac* admission in this Court **only once** ever. [Dkt. 28-15 at ¶ 11 (“I acknowledge that I filed only a single *pro hac vice* application.”)]; see *SmartWatch MobileConcepts, LLC v. Google, LLC*, No. 3:24-cv-00937-RFL (application filed on 5/22/24 averring that Mr. Kubiak had been granted *pro hac* admission by the Court “0” times in the twelve months preceding the application). In that application for *pro hac vice* admission, Mr. Kubiak identifies Ms. Kalra as his local co-counsel.

The Court has identified at least **forty-five other** patent cases in the Northern District of California in which Ms. Kalra is identified as an attorney of record on the docket along with either Mr. Ramey or Mr. Kubiak, where one or both of them are listed as counsel of record or in the pleadings or filings as plaintiff’s counsel with “*pro hac vice*” or “*pro hac vice* anticipated” status. See *Kephart Consulting, LLC v. AxxonSoft US, Inc.*, No. 4:24-cv-06770-KAW (filed 9/26/24) (Ramey listed as Lead Attorney on docket and Ms. Kalra listed as local counsel in original *pro hac vice* application); *VDPP, LLC v. Roku, Inc.*, No. 5:24-cv-05303-VKD (filed 8/16/24) (Ramey signed complaint with “*pro hac vice*,” Kubiak identified as “*pro hac vice*”); *mCom IP, LLC v. WestAmerica Bancorporation*, No. 3:24-cv-03609-SK (filed 6/14/24) (Ramey signed jury demand with “*pro hac vice* anticipated,” Kubiak listed as “*pro hac vice* anticipated”); *Autonomous IP, LLC v. Lyft, Inc.*, No. 3:24-cv-03348-RFL (filed 6/4/24) (Ramey listed as attorney to be noticed; Kubiak identified as lead attorney); *Linfo IP, LLC v. Alibaba Grp. (U.S.) Inc.*, No. 3:24-cv-03098-RS (filed 5/22/24) (Ramey listed as lead attorney; Kubiak listed as “*pro hac vice* anticipated”); *WFR IP, LLC v. Alibaba Grp. (U.S.) Inc.*, No. 3:24-cv-02179-TSH (filed 4/12/24) (Ramey signed complaint with “*pro hac vice*,” Kubiak listed as “*pro hac vice*”); *Linfo IP, LLC v. Third Love, Inc.*, No. 4:24-cv-02195-HSG (filed 4/12/24) (Ramey signed complaint with “*pro hac vice*,” Kubiak listed as “*pro hac vice*”); *Flick Intelligence, LLC v. HTC Am. Inc.*, No. 5:24-cv-02201-NC (filed



4/12/24) (Ramey signed complaint with “*pro hac vice* anticipated”); *PacSec3, LLC v. Radware, Inc.*, No. 3:24-cv-02146-AGT (filed 4/10/24) (Ramey signed complaint with “*pro hac vice* anticipated”); *VDPP, LLC v. Xiaomi USA, LLC*, No. 5:24-cv-01783-EKL (filed 3/22/24) (Ramey lead attorney; Kubiak listed as “*pro hac vice*”); *VDPP, LLC v. Vivitek Corp.*, No. 5:24-cv-01781-BLF (filed 3/22/24) (Ramey attorney to be noticed); *VDDP, LLC v. Motorola Mobility LLC*, No. 3:24-cv-01672-LJC (filed 3/18/24) (Ramey lead attorney); *WirelessWerx IP, LLC v. Lyft, Inc.*, No. 5:24-cv-01144-VKD (filed 2/26/24) (Ramey attorney to be noticed); *WirelessWerx IP, LLC v. Wing Aviation LLC*, No. 4:24-cv-01040-YGR (filed 2/21/24) (Ramey signed jury demand with “*pro hac vice* anticipated;” Kubiak listed as “*pro hac vice* anticipated”); *SmartWatch MobileConcepts, LLC v. Google, LLC*, No. 3:24-cv-00937-RFL (filed 2/16/24) (Ramey lead attorney; Kubiak listed as attorney to be noticed); *Missed Call, LLC v. Twilio Inc.*, No. 3:24-cv-00681-LB (filed 2/5/24) (Ramey lead attorney); *Missed Call, LLC v. RingCentral, Inc.*, No. 3:23-cv-06728-TLT (filed 12/31/23) (Ramey signed jury demand with “*pro hac vice* anticipated;” Kubiak listed as “*pro hac vice* anticipated”); *Missed Call, LLC v. 8x8, Inc.*, No. 3:23-cv-06723-VC (filed 12/30/23) (Ramey signed jury demand with “*pro hac vice* anticipated;” Kubiak listed as “*pro hac vice* anticipated”); *WirelessWerx IP, LLC v. OnFleet, Inc.*, No. 3:23-cv-06724-AMO (filed 12/30/23) (Ramey signed complaint and jury demand with “*pro hac vice* anticipated;” Kubiak listed as “*pro hac vice* anticipated”); *WirelessWerx IP, LLC v. Life360, Inc.*, No. 3:23-cv-06725-AMO (filed 12/30/23) (Ramey signed complaint and jury demand with “*pro hac vice* anticipated;” Kubiak listed as “*pro hac vice* anticipated”); *Mesa Digital, LLC v. Quanta Comp. USA, Inc.*, No. 3:23-cv-06711-VC (filed 12/29/23) (Ramey signed jury demand with “*pro hac vice* anticipated”); *CyboEnergy, Inc. v. N. Elec. Power Tech., Inc.*, No. 4:23-cv-06121-JST (filed 11/27/23) (Ramey signed complaint with “*pro hac vice* anticipated”); *Koji IP, LLC v. Energous Corp.*, No. 4:23-cv-05750-HSG (filed 11/8/23) (Ramey attorney to be noticed; Kubiak listed as “*pro hac vice* anticipated”); *Vilox Techs., LLC v. Salesforce, Inc.*, No. 3:23-cv-05047-AMO (filed 10/2/23) (Ramey attorney to be noticed); *Fare Techs. LLC v. Lyft, Inc.*, No. 3:23-cv-04935-RFL (filed 9/26/23) (Ramey attorney to be noticed); *Flick Intelligence, LLC v. Google, LLC*, No. 3:23-cv-04803-TLT (filed 9/19/23) (Ramey attorney to be noticed; Kubiak listed as lead attorney);

VDPP, LLC v. Vivo, Inc., No. 5:23-cv-04241-NC (filed 8/18/23) (Ramey lead attorney); Safecast  
 Ltd. v. Google, LLC, No. 5:23-cv-03128-PCP (filed 6/23/23) (Ramey lead attorney); Haley IP,  
 LLC v. Motive Techs., Inc., No. 4:23-cv-02923-HSG (filed 6/14/23) (Ramey on brief “*pro hac vice*  
*anticipated*,” Kubiak lead attorney); ALD Social, LLC v. Apple, Inc., No. 3:23-cv-02695-JSC  
 (filed 5/31/23) (Ramey attorney to be noticed); Silent Commc’n, LLC v. Adobe, Inc., No. 3:23-cv-  
 02696-TLT (filed 5/31/23) (Ramey attorney to be noticed; Kubiak listed as lead attorney); Flick  
 Intelligence LLC v. Niantic, Inc., No. 3:23-cv-02219-TLT (filed 5/5/23) (Ramey signed jury  
 demand with “*pro hac vice anticipated*”); Street Spirit IP LLC v. Meta Platforms, Inc. f/k/a  
 Facebook, Inc., No. 3:23-cv-00879-WHA (filed 2/27/23) (Ramey signed complaint and jury  
 demand with “*pro hac vice anticipated*”); Street Spirit IP LLC v. Instagram et al., No. 3:23-cv-  
 00883-WHA (filed 2/27/23) (Ramey signed complaint and jury demand with “*pro hac vice*  
*anticipated*”); Street Spirit IP LLC v. LinkedIn Corp., No. 3:23-cv-00884-AMO (filed 2/27/23)  
 (Ramey signed complaint and jury demand with “*pro hac vice anticipated*”); ALD Social LLC v.  
 Verkada, Inc., No. 3:23-cv-00049-JSC (filed 1/5/23) (Ramey attorney to be noticed); Escapex IP  
 LLC v. Google LLC, No. 3:22-cv-08711-VC (filed 12/13/22) (Ramey attorney to be noticed);  
 ESIGNATURE SOFTWARE, LLC v. Adobe, Inc., No. 3:22-cv-05962-JSC (filed 10/12/22) (Ramey  
 attorney to be noticed); Traxcell Techs., LLC v. Google LLC, No. 3:22-cv-04807-JSC (filed  
 8/22/22) (Ramey lead attorney); Valjakka v. Netflix, Inc., No. 4:22-cv-01490-JST (filed 3/9/22)  
 (Ramey lead attorney); CyboEnergy, Inc. v. N. Elec. Power Tech., Inc., No. 3:21-cv-08534-SI  
 (filed 11/2/21) (Ramey lead attorney); Riggs Tech. Holdings, LLC v. Vagaro, Inc., No. 3:21-cv-  
 07927-TSH (filed 10/8/21) (Ramey attorney to be noticed); Apple Inc. v. Traxcell Techs. LLC, No.  
 3:21-cv-06059-EMC (filed 8/5/21) (Ramey attorney to be noticed); NetSoc, LLC v. Quora, Inc.,  
 No. 3:19-cv-06518-VC (filed 10/11/19) (Ramey lead attorney).

As noted above, Mr. Ramey has only filed applications for *pro hac vice* admission in ten of  
 these cases (the majority of which were filed *after* the OSC issued in this case), and Mr. Kubiak  
 has only filed one *pro hac vice* application in this Court ever. Ms. Kalra was listed as local  
 counsel for Mr. Ramey and Mr. Kubiak in their *pro hac vice* applications, including in the most  
 recent Kephart Consulting case, where the original *pro hac vice* application was denied, and a

renewed application was filed listing a different local counsel (apparently after Ms. Kalra separated from the Ramey law firm). *See* No. 24-cv-06770-KAW, ECF Nos. 26, 29.

At the August 22, 2024 hearing, counsel for Defendant brought to the Court's attention that Mr. Ramey has also appeared as counsel without obtaining *pro hac* admission in numerous cases in the Central District of California. Based on this Court's investigation thus far, Mr. Ramey has appeared as counsel in at least **thirty-seven** cases in the Central District of California (thirty-three of which were filed in 2022 or later) and Mr. Kubiak has appeared as counsel in at least **ten** of those cases. It appears that Mr. Ramey and Mr. Kubiak have similarly failed to seek *pro hac vice* admission in many of those cases despite receiving notices from that court that their *pro hac vice* applications were due, and they appear to have continued to litigate those cases even after receiving such notices. *See, e.g.,* Notice of Pro Hac Vice Application Due, *VDPP, LLC v. Mazda Motor of Am. Inc.*, No. 8:24-cv-00571-JWH-ADS (C.D. Cal. Mar. 18, 2004), ECF No. 11.

This is not the first time Mr. Ramey, or his law firm, have been faced with sanctions for improper conduct involving failure to follow local rules or procedures on *pro hac vice* admission. *See Nimitz Techs. LLC v. CNET Media, Inc.*, No. 21-1247-CFC, 2022 WL 17338396, at \*7-8 (D. Del. Nov. 30, 2022) (noting that, because "Mr. Ramey chose not to appear" at a court-ordered hearing regarding his failure to obtain new local counsel to sponsor his *pro hac* admission, the court "found that Mr. Ramey's willful disregard . . . warranted sanctions"). More recently, on March 11, 2025, a Magistrate Judge in the Southern District of Florida issued a Report and Recommendation on a motion for attorney fees and sanctions in another patent infringement action in which Mr. Ramey and his law firm represented the plaintiff. *mCom IP, LLC v. City Nat'l Bank of Fla.*, No. 23-23427-Civ-Scola/Lett, 2024 U.S. Dist. LEXIS 43754 (S.D. Fla. Mar. 11, 2025). There, the court noted conduct which is shockingly similar to the conduct at issue here: "[f]or the duration of the litigation," a local attorney, Victoria Briant, had been "the only counsel of record" for the plaintiff, even though "the case was actually litigated by [the plaintiff's] national lead counsel, . . . Attorney William Ramey from RAMEY LLC, a law firm based in Houston, Texas, [who] never entered an appearance or moved for *pro hac vice* admission." *Id.* at \*3-4. In recommending that sanctions be imposed against the plaintiff's counsel, the *mCom* court explicitly

1 admonished Mr. Ramey and the local attorney for their conduct, noting that “[d]espite failing to  
2 move for *pro hac vice* admission or otherwise appearing in this matter, Attorney Ramey  
3 functioned in a primary role spearheading the interactions with Defendant’s counsel, while Briant  
4 took a back-seat.” *Id.* at \*14-15.

5 These sanctions involving similar violations of *pro hac vice* rules are better viewed within  
6 a larger context of a pattern of sanctions ordered against Mr. Ramey, Ms. Kalra, and the Ramey  
7 firm (and its clients) across a range of issues and cases nationwide. *See, e.g., ESCAPEX IP, LLC*  
8 *v. GOOGLE LLC*, No. 23-CV-10839 (VSB) (VF), 2025 WL893739, at \*10-11 (S.D.N.Y. Mar. 24,  
9 2025) (“As other courts have noted, Plaintiff’s counsel has a track record of commencing  
10 ‘frivolous suits’ against ‘tech giant[s]’ like Google, for the purpose of ‘forc[ing] a modest  
11 settlement . . . on the assumption that the tech giant will prefer to capitulate than fight back. . . .  
12 The conduct by Plaintiff’s counsel’s here is part of a long pattern of similar behavior that warrants  
13 deterrence through an award under § 1927.”); *EscapeX IP LLC v. Google LLC*, No. 22-cv-08711-  
14 VC, 2024 WL 557729, at \*1 (N.D. Cal. Feb. 12, 2024) (“Here, the attorneys for EscapeX acted  
15 recklessly by filing a frivolous Rule 59(e) motion that unreasonably multiplied the proceedings of  
16 this case. . . . Therefore, Google is entitled to reimbursement of its reasonable attorneys’ fees and  
17 costs in the amount of \$63,525.30 to be levied jointly and severally against EscapeX’s attorneys,  
18 William P. Ramey, III and Susan S.Q Kalra.”); *VDPP, LLC v. Volkswagen Grp. of Am., Inc.*, No.  
19 H-23-2961, 2024 WL 3856797, at \*2 (S.D. Tex. Aug. 13, 2024) (“VDPP’s misconduct infected  
20 the entire litigation. It is entirely fitting to require VDPP to pay all of Volkswagen’s fees to defeat  
21 a case that never should have been filed.”); *WPEM, LLC v. SOTI Inc.*, No. 2:18-CV-00156-JRG,  
22 2020 WL 555545, at \*7 (E.D. Tex. Feb. 4, 2020) (“In sum, the Court finds that WPEM wholly  
23 failed to conduct an invalidity and enforceability pre-filing investigation and ignored obvious  
24 issues that should have been readily apparent to it had it adequately [sic] them as part of its own  
25 preparation for litigation. WPEM’s failures cause this case to stand out from an ordinary case and  
26 warrant a fee recovery by SOTI.”).

27 The Ramey law firm’s client base and approach to the practice of law is no secret to those  
28 in the patent litigation community—the firm files multitudes of lawsuits on behalf of patent

assertion entities and typically settles them quickly for relatively low value amounts. *See* Lauren Castle, *Lawyer Big Tech Loves to Hate Wears Backlash as Badge of Honor*, BLOOMBERG LAW, <https://news.bloomberglaw.com/us-law-week/lawyer-big-tech-loves-to-hate-wears-backlash-as-badge-of-honor> (last visited March 17, 2025). According to a recent database search, the Ramey firm appears to be counsel of record in over 150 pending and active patent cases nationwide. *See* Number of Active Patent Cases Involving Ramey Firm as Counsel of Record, Docket Navigator, [https://search.docketnavigator.com/patent/search/patent\\_cases](https://search.docketnavigator.com/patent/search/patent_cases) (search using term “Ramey” in “Firms” field, select “Ramey” search term, follow hyperlink to View Results, select “Active” option under “Case Status” Filter).

It is quite likely that the volume-focused and quick-settlement nature of the Ramey law firm’s practice motivated these attorneys’ decisions to largely avoid filing *pro hac vice* applications and to seek *pro hac* admission in only a handful of cases. Mr. Ramey admitted as much at the OSC hearing. The *pro hac* admission fee in this District is \$328 for each attorney in each case—multiply that number even by one hundred cases for one attorney and that obviously yields a significant cost to a firm and its clients. Mr. Ramey himself stated at the OSC hearing that the motivation to avoid these costs is particularly acute given that so many of the Ramey firm’s cases settle in the relatively early stages of litigation. By avoiding these *pro hac* fees over the years, the Ramey law firm has saved a substantial amount of money, but at a cost to the Court, the public, and the profession.

## **DISCUSSION**

### **I. Rule 11 Violations**

As summarized above, on June 26, 2024, Defendant filed a motion seeking attorneys’ fees as a prevailing party under 35 U.S.C. § 285, as well as seeking sanctions under 28 U.S.C. § 1927 and the Court’s inherent powers. [Dkt. 18]. While that motion references Federal Rule of Civil Procedure 11, the basis for the request for fees rests on § 285 and the basis for the request for sanctions rests on § 1927 and the Court’s inherent powers.

Based on the Parties’ briefing on that motion as well as the representations of counsel during the August 22, 2024 hearing, the Court grew concerned of the possibility that the pre-suit

1 investigation conducted by Plaintiff's counsel prior to filing the complaint in this Third Action  
2 was so inadequate that potential Rule 11 sanctionable conduct could be implicated. Because  
3 Defendant did not seek sanctions under Rule 11 (and thus, did not follow the safe harbor  
4 procedures), and because the Court raised the issue of the potential for Rule 11 sanctions *sua*  
5 *sponte*, the Court provided Plaintiff and its counsel, the Ramey lawyers, notice and a reasonable  
6 opportunity to respond as to why they should not be sanctioned under Rule 11 for the conduct  
7 detailed at length in the OSC. *See* Fed. R. Civ. P. 11(c)(3); *Mellow v. Sacramento Cnty.*, 365 F.  
8 App'x 57 (9th Cir. Jan. 25, 2010). "Rule 11 sanctions may be imposed only in response to claims  
9 that are not 'warranted by existing law or by a nonfrivolous argument for the extension,  
10 modification or reversal of existing law.'" *United Nat. Ins. Co. v. R&D Latex Corp.*, 242 F.3d  
11 1102, 1115-16 (9th Cir. 2001) (quoting Fed. R. Civ. P. 11(b)(2)). "This standard is applied with  
12 particular stringency where, as here, the sanctions are imposed on the court's own motion[;] . . .  
13 *sua sponte* sanctions 'will ordinarily be imposed only in situations that are akin to a contempt of  
14 court.'" *Id.* (quoting *Barber v. Miller*, 146 F.3d 707, 711 (9th Cir. 1999)) (alteration omitted).

15 As discussed above, the Court issued the OSC on August 29, 2024, ordering the Ramey  
16 law firm attorneys to respond and to show cause why they should not be sanctioned pursuant to  
17 Rule 11 and the Court's inherent authority. [Dkt. 27]. The fifteen-page OSC discusses in detail  
18 the conduct at issue and explicitly provides the Ramey lawyers notice and an opportunity to  
19 respond as to why they should not be sanctioned under Rule 11 and the Court's inherent authority  
20 for such conduct. *See* Fed. R. Civ. P. 11(c)(B).

21 The Ramey firm filed their response to the OSC on September 12, 2024, including a brief,  
22 declarations from each of the three Ramey lawyers at issue, a declaration from a technical  
23 consultant working with the Ramey firm on this case, a declaration from the manager of Plaintiff  
24 Koji, and several exhibits. [Dkt. 28]. The Court conducted a hearing on the OSC on September  
25 19, 2024, at which all three Ramey firm lawyers appeared. [Dkt. 30]. At the hearing, the Ramey  
26 lawyers requested leave to submit supplemental legal authority which the Court granted. [Dkt.  
27 32]. The Ramey lawyers filed their supplemental briefing on September 20, 2024. [Dkt. 33].

28 Rule 11 requires at least one counsel of record to sign every pleading, written motion, or



1 other paper presented to the Court. Fed. R. Civ. P. 11(a). “By presenting to the court a pleading,  
2 written motion, or other paper—whether by signing, filing, submitting, or later advocating it—an  
3 attorney . . . certifies” that the paper is not “frivolous” or meant to further “any improper purpose”  
4 and that it was submitted “after an inquiry reasonable under the circumstances.” Fed. R. Civ. P.  
5 11(b).

6 Rule 11 authorizes the Court to impose sanctions on an attorney who fails to conduct a  
7 reasonable pre-filing inquiry if the paper at issue lacks merit or is otherwise frivolous. *In re*  
8 *Keegan Mgmt. Co. Sec. Litig.*, 78 F.3d 431, 434 (9th Cir. 1996). Sanctions imposed under Rule 11  
9 are limited to that which is sufficient to deter “repetition of such conduct or comparable conduct  
10 by others similarly situated.” Fed. R. Civ. P. 11(c)(2). Rule 11 sanctions may include  
11 nonmonetary directives, orders to pay penalties to the court, and monetary awards for “reasonable  
12 attorney’s fees and other expenses directly resulting from the violation.” Fed. R. Civ. P. 11(c)(4).  
13 The Court has wide and substantial discretion regarding the application of Rule 11 sanctions. *See*  
14 *Hudson v. Moore Bus. Forms, Inc.*, 836 F.2d 1156, 1163 (9th Cir. 1987) (“The district court has  
15 wide discretion in determining the appropriate sanction for a Rule 11 violation.”); Fed. R. Civ. P.  
16 11(b)(3).

17 The standard for determining whether a paper is frivolous is one of objective  
18 reasonableness at the time of the attorney’s signature. *Christian v. Mattel, Inc.*, 286 F.3d 1118,  
19 1127 (9th Cir. 2002). “Frivolous filings are ‘those that are both baseless and made without a  
20 reasonable and competent inquiry.’” *Est. of Blue v. Cnty. of L.A.*, 120 F.3d 982, 985 (9th Cir.  
21 1997) (quoting *Buster v. Griesen*, 104 F.3d 1186, 1190 (9th Cir. 1997)). Before imposing Rule 11  
22 sanctions, the Court “must conduct a two-prong inquiry to determine: (1) whether the complaint is  
23 legally or factually ‘baseless’ from an objective perspective, and (2) if the attorney has conducted  
24 ‘a reasonable and competent inquiry’ before signing and filing it.” *Christian*, 286 F.3d at 1127.

25 The Ramey lawyers admit that the First Action filed in Colorado (*Koji I*) was identical to  
26 the Second Action filed in this Court (*Koji II*). [Dkt. 28 at 16 (“Koji admits that it refiled the same  
27 infringement allegations it previously dismissed in Colorado in the Northern District of  
28 California.”)]. They admit that they voluntarily dismissed the *Koji I* lawsuit under Rule 41 by



1 notice. *Id.* at 15. And they admit that they voluntarily dismissed the identical *Koji II* lawsuit  
2 under Rule 41 by notice. *Id.* at 16-17. By operation of Rule 41(a)(1)(B), “if the plaintiff  
3 previously dismissed any federal- or state-court action based on or including the same claim, a  
4 notice of dismissal operates as an adjudication on the merits.” Because *Koji*’s lawyers previously  
5 dismissed the same claim in *Koji I*, the notice of dismissal in *Koji II* operated as an adjudication on  
6 the merits. The issue then is what justification the Ramey lawyers had for filing the exact same  
7 lawsuit a third time, after the two previous dismissals, and what pre-filing inquiry those lawyers  
8 conducted to determine whether such filing was warranted before launching this third lawsuit.

9 At the August 22, 2024 hearing, Ms. Kalra was unable to identify any pre-filing inquiry by  
10 herself or any other Ramey LLP attorney (much less reasonable inquiry supported by law)  
11 regarding Rule 41’s effect here, and regarding whether or not the complaint in this Third Action  
12 was warranted by existing law or any other permissible basis under Rule 11. Ms. Kalra was  
13 equally unable to identify whether any of the Ramey LLP lawyers performed any pre-filing  
14 inquiry as to the impact of the dismissal filed in the Second Action prior to the filing of that notice  
15 of dismissal. At the hearing and in the briefing on the motion for fees and sanctions, Plaintiff’s  
16 counsel was unable to cite any law of which they were aware prior to filing the complaint in this  
17 Third Action which reasonably supported the position that the dismissals of the complaints in the  
18 previous two identical actions avoided an adjudication on the merits under Rule 41.

19 Similarly, in response to the OSC, the Ramey lawyers failed to cite any authority which  
20 would have supported the filing of the complaint in this Third Action in light of Rule 41, either  
21 based on existing law or any other permissible bases under Rule 11. The response to the OSC  
22 argues that “William Ramey relied on his over 20 years of experience in refiling the lawsuit” for  
23 this Third Action. [Dkt. 28 at 18]. Mr. Ramey’s personal experience is not legal authority for  
24 avoiding the impact of the previous two dismissals under Rule 41.

25 In the response briefing, Plaintiff’s counsel argues that “Rule 41 specifically allows a  
26 lawsuit to be filed more than twice if there is . . . ‘a persuasive explanation for the course of  
27 litigation.’” *Id.* There is no such “specific” language allowing a lawsuit to be filed a third time in  
28 Rule 41. The response further argues that “Ramey knew there were exceptions that allowed the

1 refiling of a complaint, in cases where there is ‘a persuasive explanation for the course of  
2 litigation.’” *Id.* (citing *Milkcrate Athletics, Inc. v. Adidas Am., Inc.*, 619 F. Supp. 3d 1009 (C.D.  
3 Cal. 2022)). The *Milkcrate* case cited by the Ramey lawyers is wholly inapposite to Rule 11 and  
4 does *not* discuss an exception to the dispositive effect of the two prior dismissals under Rule 41.

5 In *Milkcrate*, there was no issue presented regarding potential sanctions under Rule 11.  
6 Instead, the issue there was whether the Court should award costs and fees to the defendant under  
7 Federal Rule of Civil Procedure 41(d). 619 F. Supp. 3d at 1024-28. Indeed, the quote from  
8 *Milkcrate* cited by the Ramey lawyers in the response to the OSC is taken out of context—the full  
9 text of the sentence reads: “An ‘award under Rule 41(d) is appropriate’ where ‘the [movant] has  
10 failed to present a persuasive explanation for the course of litigation’ and the nonmovant shows it  
11 has ‘incurred needless expenditures as a result.’” *Id.* at 1025 (citation omitted).

12 To reiterate, *Milkcrate* was concerned with whether to award fees and costs to the  
13 defendant under Rule 41(d). *Milkcrate* does not concern whether to impose court-ordered  
14 sanctions *sua sponte* under Rule 11(c)(3) (which would be payable to the Court)—and the Ninth  
15 Circuit has recognized the important distinction between sanctions to be awarded based on a  
16 motion of a party versus sanctions imposed based on a court’s initiative under Rule 11. *Barber*,  
17 146 F.3d at 711. There is simply no discussion in *Milkcrate* which sets forth any kind of  
18 “exception” under Rule 41(a)(1)(B). There is no discussion of a rule in *Milkcrate* which would  
19 “specifically” allow for the filing of a duplicative third complaint which asserts the same cause of  
20 action by the same plaintiff against the same defendant involving the same patent (after two  
21 previous voluntary dismissals). There is no discussion in *Milkcrate* of Rule 41(a)(1)(B), of any  
22 “exception” under that rule, or of any impact of the ruling on how to analyze Rule 11 *sua sponte*  
23 sanctions.

24 Further, even if the “persuasive explanation for the course of litigation” rule in *Milkcrate*  
25 for avoiding costs under Rule 41(d) was somehow analogized to or extended by implication to  
26 Rule 41(a)(1)(B), the application of that rule in *Milkcrate* is contrary to the Ramey lawyers’  
27 response. In *Milkcrate*, the court awarded costs to the defendant because the plaintiff filed a  
28 second action after dismissing a previous action, where the allegations in both actions concerned

1 “the same operative facts and include the same copyright infringement claim at issue[.]” 619 F.  
2 Supp. 3d at 1025-26. That same situation exists here—the Ramey lawyers filed this Third Action  
3 even after dismissing the previous two cases, even though all three cases concern the same  
4 operative facts and include the same patent infringement claims. If anything, *Milkcrate* instructs  
5 that an award of costs is appropriate in the analogous factual situation as is present here.

6 At the OSC hearing, Mr. Ramey admitted that *Milkcrate* is not legal support for an  
7 exception under Rule 41(a)(1)(B) for filing a third complaint after previously dismissing two  
8 identical or substantially identical prior complaints. Mr. Ramey also admitted that *Milkcrate* is  
9 not support for the assertion that he somehow “knew” based on his experience of any such  
10 exception to Rule 41 that would have allowed or excused the filing of the third complaint here.  
11 That is, Mr. Ramey did not analyze *Milkcrate* as part of his prefiling diligence before filing the  
12 third complaint here. Indeed, in their declarations in response to the OSC, the Ramey law firm  
13 attorneys simply refer to their unexplained “opinion” that the dismissal of the First Action in  
14 Colorado somehow did not count for purposes of Rule 41, that based on their years of experience  
15 there are unidentified “exceptions” to Rule 41, and that they “believed” the circumstances allowed  
16 them to refile the complaint. [Dkt. 28-1 at ¶ 12; Dkt. 28-2 at ¶ 17; Dkt. 28-3 at ¶ 20].

17 The response to the OSC only cites *Milkcrate* to support the position that an “exception” to  
18 Rule 41(a)(1)(B) somehow exists in the law, and as discussed above, that case does not support  
19 the assertion. Accordingly, the Ramey lawyers provided no legal support for their assertion that  
20 they were somehow justified in filing the third complaint here. None of their declarations state  
21 that they performed legal research into the issue before filing the third complaint, and none state  
22 that they even knew about the inapposite *Milkcrate* case before filing the third complaint. At best,  
23 they are left merely with reliance on their years of experience and factual arguments about  
24 convenience to the parties. The argument that the dismissal of the First Action in Colorado “was  
25 more akin to convenience and not a merits dismissal” is unpersuasive because nothing in that  
26 original dismissal states that the dismissal was for mere convenience, and there is no provision of  
27 Rule 41 which somehow exempts the impact of a voluntary dismissal if it is allegedly “for  
28 convenience” or to “reduce costs” as Plaintiff’s lawyers now argue. [Dkt. 28 at 15-16].

Further, the Ramey lawyers admit that the First Action was dismissed because they understood they would lose the pending motion to dismiss for improper venue. [Dkt. 28 at 15 (“The first [lawsuit] was dismissed by Koji when it determined that it would likely lose a venue motion.”)]. At the OSC hearing, Mr. Ramey conceded that he was unable to locate any case law supporting the position that voluntary dismissal for “convenience” or to reduce costs (by avoiding a fight over venue) is exempt from Rule 41’s impact. [Dkt. 40 at 50:22-51:20]. In their supplemental brief, the Ramey lawyers argue that a dismissal on venue grounds does not operate as a decision on the merits, citing *Perrin v. TRW Info Services*, 990 F.2d 1259 (9th Cir. 1993). [Dkt. 33 at 3 n.7]. The problem is that the dismissal on venue grounds in *Perrin* was a result of an order dismissing the case issued by the district court, not as a result of the operation of voluntary dismissal under Rule 41. The other defect in the Ramey lawyers’ argument is that the dismissal of the First Action here was *not* on venue grounds. Motivation to file a voluntary dismissal is not a dismissal on venue grounds—the legal basis for a voluntary dismissal is Rule 41 (and not a ruling or finding that venue was improper). The argument that the “basis” for the dismissal was that Koji did not want to contest an improper venue motion is not the same thing as a dismissal on venue grounds, and it does not transform a voluntary dismissal (which here was unqualified and made no reference to venue on its face) into a dismissal on venue grounds. The Ramey lawyers cite no law in their OSC response that supports the assertion that a voluntary dismissal motivated by a venue issue is treated as a dismissal on venue grounds. And the Ramey lawyers make no averment in their declarations that they researched or even considered this issue in their prefiling inquiry before filing this Third Action.

More fundamentally, the Ramey lawyers’ argument about whether the dismissal of the First Action was a “decision on the merits” is a red herring. Under Rule 41, it is the dismissal of the second lawsuit (identical to the first lawsuit) which results in an adjudication on the merits. Rule 41 has no language which turns on whether or not the first dismissal was “on the merits” or not. As long as the first dismissal was voluntary and by notice under Rule 41(a)(1)(B), and as long as the first case was “based on or including the same claim” as in the second case, then the notice of dismissal of the second case operates as an adjudication on the merits.

1           The Ramey lawyers’ argument that this Third Action somehow differed from the scope of  
2           the previous two dismissed actions is unsupported by the record. [Dkt. 28 at 18]. The Ramey  
3           lawyers argue that the patent infringement claims chart appended to the third complaint “charted a  
4           new product that had not been alleged as infringing in the prior suit.” *Id.* That argument  
5           misrepresents the breadth of the pleading of the second complaint (and thus, the breadth of the  
6           dismissal of that case). The second complaint avers that “Defendant [Renesas] maintains,  
7           operates, and administers systems, products, and services that infringes [sic] one or more of claims  
8           1-4 of the ’703 patent. . . . Support for the allegations of infringement may be found in the chart  
9           attached as Exhibit B. These allegations of infringement are preliminary and are therefore subject  
10          to change.” [Dkt. 19-1 at 119-20]. The prayer for relief in the second complaint specifically  
11          requests that the court “award Plaintiff an accounting for acts of infringement not presented at trial  
12          and an award by the Court of additional damage for any such acts of infringement” and seeks “a  
13          decree addressing future infringement that . . . awards damages for future infringement in lieu of  
14          an injunction in an amount consistent with the fact that for future infringement the Defendant will  
15          be an adjudicated infringer of a valid patent[.]” *Id.* at 121-22. Thus, the face of the second  
16          complaint encompassed more than just the specific exemplary product in the claims chart attached  
17          to that complaint, specifically sought relief against Renesas for all present and future infringement,  
18          and specifically reserved the right to change the allegations of infringement.

19          The fact that the third complaint attached a claims chart for a different product than the one  
20          specifically charted for the second complaint myopically ignores the scope of the allegations of  
21          infringement in the second complaint (which facially covered all present, future, and any other  
22          alleged infringing products, not limited to the one in the claims chart). In this regard, it is  
23          noteworthy that only a few months separated the dismissal of the Second Action and the filing of  
24          the Third Action—and the evidence for the allegedly “new” product charted for the third  
25          complaint is dated November 22, 2023, well before the date of dismissal of the second complaint.  
26          The “new” product charted for the Third Action complaint existed at the time of the Second  
27          Action and—in light of the literal breadth of the pleading accusing Renesas of infringement in the  
28          second complaint—that “new” product was already subsumed in the infringement accusations in

1 the Second Action.

2 The argument relying on the allegedly “new” claims chart attached to the third complaint  
3 similarly ignores the scope of the infringement allegations in the third complaint. The Ramey  
4 lawyers ignore the fact that the scope of the infringement allegations in the third complaint  
5 completely mirror and duplicate the scope of the infringement allegations in the second dismissed  
6 complaint. Both complaints use the same language. As with the second complaint, the third  
7 complaint avers that “Defendant [Renesas] maintains, operates, and administers systems, products,  
8 and services that infringes [sic] one or more of claims 1-4 of the ’703 patent. . . . Support for the  
9 allegations of infringement may be found in the chart attached as Exhibit B. These allegations of  
10 infringement are preliminary and are therefore subject to change.” [Dkt. 1 at 3-4]. The prayer for  
11 relief in the third complaint (just like the second complaint) specifically requests that the court  
12 “award Plaintiff an accounting for acts of infringement not presented at trial and an award by the  
13 Court of additional damage for any such acts of infringement” and seeks “a decree addressing  
14 future infringement that . . . awards damages for future infringement in lieu of an injunction in an  
15 amount consistent with the fact that for future infringement the Defendant will be an adjudicated  
16 infringer of a valid patent[.]” *Id.* at 6. Thus, just like the second complaint, the face of the third  
17 complaint encompasses more than just the specific exemplary product in the claims chart attached  
18 to the complaint, specifically seeks relief against Renesas for all present and future infringement at  
19 the time, and specifically reserves the right to change the allegations of infringement.

20 In sum, the Ramey lawyers’ argument that they were justified in filing the third complaint  
21 because the claims chart attached to that complaint was for a “new” or “different” product which  
22 was not explicitly identified as infringing in the Second Action is unavailing. The breadth of the  
23 Second Action encompassed that “new” product by literally stating that the infringement  
24 allegations were subject to change and thus not limited to the one specific product in the claims  
25 chart attached to the second complaint. That “new” product existed as of November 2023, the  
26 same month the second complaint was filed, and months before the Second Action was voluntarily  
27 dismissed. And, conversely, the breadth of the third complaint facially reaches beyond the one  
28 exemplary product identified in the claims chart attached to that third complaint, and like the

1 second complaint specifies that the allegations of infringement were subject to change. And  
2 because Koji's lawyers voluntarily dismissed the second complaint by notice under Rule 41, that  
3 served as an adjudication on the merits and barred filing the identically worded third complaint.

4 Further, at the OSC hearing, Mr. Ramey was unable to identify any pre-filing inquiry by  
5 himself or any other Ramey LLP attorney (much less reasonable inquiry supported by law)  
6 regarding the effect of Rule 41 on whether the complaint in this Third Action was warranted by  
7 existing law or any other permissible basis under Rule 11. That is, the citation to case law  
8 (*Milkcrate* discussed above) in the OSC response and in the attorneys' declarations is a *post hoc*  
9 attempt to justify the conduct at issue. Mr. Ramey was equally unable to identify whether any of  
10 the Ramey LLP lawyers performed any pre-filing inquiry as to the impact of the dismissal filed in  
11 the Second Action prior to the filing of that dismissal. Plaintiff's counsel was likewise unable to  
12 cite any law of which they were aware *prior to filing the complaint in this Third Action* which  
13 reasonably supported the position that the dismissals of the complaints in the previous two actions  
14 avoided an adjudication on the merits under Rule 41, and thus, which reasonably supported the  
15 filing of the complaint in this Third Action.

16 The course of action the Ramey lawyers took after filing the third complaint is further  
17 illustrative. The Ramey lawyers admit that immediately after filing the third complaint, "a copy  
18 was sent to the Defendant with a proposed settlement letter." [Dkt. 28 at 12]. That is, like the  
19 general approach the Ramey firm employs, the Ramey lawyers here sought immediate payment in  
20 settlement of this Third Action before litigating the issues on the merits. And more importantly,  
21 the Ramey lawyers sought settlement payment without having done any diligence into whether the  
22 third complaint was justifiably filed under Rule 41. When confronted with the Rule 41 issue by  
23 Renesas's counsel, Koji's lawyers here simply dismissed this Third Action rather than litigate the  
24 issue on the merits. This course of action is indicative of an attempt to harass Renesas, by filing a  
25 third lawsuit without proper prefiling inquiry solely to attempt to eke out a settlement payment.  
26 The quick voluntary dismissal of the third complaint supports a finding that this Third Action was  
27 not filed in a good faith attempt to vindicate Koji's patent rights on the merits; rather, that early  
28 dismissal is evidence of a quickly abandoned and failed attempt to try to obtain settlement



1 payment from Renesas. Based on the record as a whole, the Court **FINDS** that the filing of the  
2 third complaint here and counsel's failures to perform pre-filing inquiry into the Rule 41 issues  
3 constitute bad faith and are akin to a contempt of court on the part of the three Ramey law firm  
4 lawyers.

5 Accordingly, in light of the totality of the factual record and pursuant to applicable legal  
6 standards, the Court **FINDS** that these three Ramey law firm attorneys engaged in bad faith  
7 litigation and violated their obligations under Rule 11 with regard to this case. None of these  
8 attorneys performed any pre-filing investigation (much less an adequate inquiry) as to the impact  
9 of the prior dismissals on the ability to file the complaint in this Third Action under Rule 41.  
10 None of these attorneys proffered an adequate or reasonable justification for their failure to do so.  
11 The conduct by these attorneys here is similar to the conduct sanctioned under Rule 11 in *Sanai v.*  
12 *Sanai*, 408 F. App'x 1 (9th Cir. 2010). In *Sanai*, the sanctioned parties filed duplicative causes of  
13 action in a second action after the court there dismissed the first action. *Id.* at 2. There, "[t]he  
14 court ordered appellants to show cause why they should not be sanctioned for realleging claims  
15 the court had dismissed, gave them an opportunity to be heard, and thereafter made an express  
16 finding that they had acted in bad faith." *Id.* at 2-3. The Ninth Circuit affirmed the imposition of  
17 Rule 11 sanctions. *Id.* Here, as in *Sanai*, the bad faith abuse of the litigation system is evident  
18 from the record.

19 Accordingly, for all the reasons discussed herein, the Court **SANCTIONS** these three  
20 Ramey law firm attorneys under Rule 11 in light of the applicable legal standards for *sua sponte*  
21 Rule 11 sanctions and in light of the record as a whole, after giving them notice and an  
22 opportunity to respond.

## 23 **II. Sanctions Under the Court's Inherent Authority**

24 As noted above, Renesas's motion for fees also includes a request for imposition of  
25 sanctions under the Court's inherent powers. [Dkt. 18 at 24]. "[T]he district court has the  
26 inherent authority to impose sanctions for bad faith, which includes a broad range of willful  
27 improper conduct." *Fink v. Gomez*, 239 F.3d 989, 992 (9th Cir. 2001). "The imposition of  
28 sanctions under the inherent power of the court is proper where counsel has 'willfull[y] abuse[d]

1 judicial process' or otherwise conducted litigation in bad faith.” *In re Itel Sec. Litig.*, 791 F.2d  
2 672, 675 (9th Cir. 1986) (citations omitted). “For purposes of imposing sanctions under the  
3 inherent power of the court, a finding of bad faith ‘does not require that the legal and factual basis  
4 for the action prove totally frivolous; where a litigant is substantially motivated by vindictiveness,  
5 obduracy, or *mala fides*, the assertion of a colorable claim will not bar the assessment of attorney's  
6 fees.’” *Id.* (citation omitted).

7 At the August 22, 2024 hearing, Ms. Kalra attempted to raise, but then withdrew, an  
8 argument that this Court somehow lacks jurisdiction to consider disciplining either Mr. Ramey or  
9 Mr. Kubiak under Rule 11 because they were never admitted *pro hac vice* in this case. As the  
10 Court indicated at that hearing, the Court was prepared to grant Mr. Ramey and Mr. Kubiak *pro*  
11 *hac vice* status *sua sponte* to address any such procedural argument, but none of the attorneys  
12 argued lack of jurisdiction in direct response to the OSC. The Court does not lack jurisdiction  
13 since both Mr. Ramey and Mr. Kubiak appeared on the pleadings (either in the signature block  
14 and/or on the cover page) and Mr. Ramey signed at least some pleadings. *See Holgate v. Baldwin*,  
15 425 F.3d 671, 677 (9th Cir. 2005) (“The signing requirement in Rule 11 makes clear that any  
16 attorney who, at any time, certified to the court that a pleading complies with Rule 11 is subject to  
17 the rule, even if the attorney later withdraws from the case.”). Further, the fact that Koji  
18 voluntarily dismissed this third lawsuit does not deprive the Court of jurisdiction to oversee  
19 discipline of these attorneys. *See Itel*, 791 F.2d at 675 (A lawyer cannot “escape sanctions for  
20 misconduct simply by withdrawing from a case before opposing counsel applies for sanctions.”).

21 Notably, Mr. Ramey does not argue that his conduct falls outside Rule 11 because he  
22 signed only the last page of each of the complaints in the Second and Third Actions (but not the  
23 penultimate page of those documents). Mr. Kubiak likewise does not argue that his conduct falls  
24 outside Rule 11’s ambit because he personally did not sign the complaints in the Second and Third  
25 Actions, but is merely listed as one of the Attorneys for Plaintiff on those pleadings. *See Fed. R.*  
26 *Civ. P. 11* advisory committee’s note to 1993 amendment (“The sanction should be imposed on  
27 the persons—whether attorneys, law firms, or parties—who have violated the rule or who may be  
28 determined to be responsible for the violation. . . . The revision [to subsection (c)] permits the

1 court to consider whether other attorneys in the firm, co-counsel, other law firms, or the party  
2 itself should be held accountable for their part in causing a violation.”); *see also Religious Tech.*  
3 *Ctr. v. Gerbode*, No. CV 93-2226 AWT, 1994 WL 228607, at \*5 (C.D. Cal. May 2, 1994) (“[T]he  
4 court has the authority to sanction a co-counsel law firm, as well as the primary offending firm,  
5 even though co-counsel did not sign the offending pleading.”); *Blossom v. Blackhawk Datsun,*  
6 *Inc.*, 120 F.R.D. 91, 101-02 (S.D. Ind. 1988) (holding that attorney, who did not “sign” the  
7 pleading but whose name appeared on the pleading, waived any objection that he did not “sign”  
8 the pleading forming the basis of Rule 11 sanctions where the attorney “ratified that everything in  
9 the case was done with his full knowledge and approval” and admitted that “any violation known  
10 to exist in th[e] case was the result of his own conduct”).

11 However, even assuming Rule 11 somehow did *not* govern these attorneys’ conduct here,  
12 the Court **FINDS** that all three attorneys are subject to sanctions under the Court’s inherent  
13 powers with regard to their conduct discussed herein. *See Chambers v. NASCO, Inc.*, 501 U.S. 32,  
14 50 (1991) (“[W]hen there is bad-faith conduct in the course of litigation that could be adequately  
15 sanctioned under the rules, the court ordinarily should rely on the rules rather than the inherent  
16 power. But if in the informed discretion of the court, neither the statute nor the rules are up to the  
17 task, the court may safely rely on its inherent power.”).

18 As discussed in detail above, the three Ramey law firm attorneys engaged in bad faith  
19 litigation here. Attorneys Ramey, Kalra, and Kubiak failed to investigate an obvious and serious  
20 issue and undertook actions in filing the third complaint in ways which are cause for grave  
21 concern. “Sanctions are available for a variety of types of willful actions, including recklessness  
22 when combined with an additional factor such as frivolousness, harassment, or an improper  
23 purpose.” *Fink*, 239 F.3d at 994. As discussed above, the filing of the third complaint without  
24 investigating the Rule 41 issue was willful, if not reckless, and that filing was frivolous in light of  
25 the two previous dismissals. The immediate willful attempt to seek settlement payment from  
26 Renesas after filing the unfounded third complaint was harassment and tantamount to bad faith.

27 The Court therefore exercises its discretion and **FINDS** that sanctions under the Court’s  
28 inherent powers are also appropriate here, particularly to the extent Rule 11 somehow does not

1 apply to these three lawyers.

### 2 **III. The Unauthorized Practice of Law**

3 Attorneys practicing in the Northern District of California must either be members of the  
4 Court's bar, or alternatively, admitted to practice in a particular case pending in the Court *pro hac*  
5 *vice*. See Civil L.R. 11-1(a), 11-3. Neither Mr. Ramey nor Mr. Kubiak is a member of the  
6 Northern District of California Bar. See *United States v. Author Servs., Inc.*, 804 F.2d 1520 (9th  
7 Cir. 1986) ("It is well established that a court may take judicial notice of its own records.");  
8 *Hymes v. Procnier*, 428 F.2d 824, 824 (9th Cir. 1970) ("Of course, the district court can take  
9 judicial notice of its own records[.]").

10 One prerequisite to be admitted to the Bar of this Court is that an attorney must be an  
11 active member in good standing of the Bar of the State of California. See Civil L.R. 11-1(b).  
12 Neither Mr. Ramey nor Mr. Kubiak is a member of the Bar of the State of California. See  
13 *Castillo-Perez v. I.N.S.*, 212 F.3d 518, 524 n.6 (9th Cir. 2000) (taking judicial notice of the  
14 membership records of the State Bar of California); *White v. Martel*, 601 F.3d 882, 885 (9th Cir.  
15 2010) (taking judicial notice of state bar records regarding attorney disciplinary proceedings).  
16 Accordingly, Mr. Ramey and Mr. Kubiak may not practice in the Northern District of California  
17 unless they are admitted (on a case-by-case basis) to appear *pro hac vice*.

18 "[T]here is no fundamental right to appear *pro hac vice*." *Paciulan v. George*, 38 F. Supp.  
19 2d 1128, 1144 (N.D. Cal. 1999), *aff'd*, 229 F.3d 1226 (9th Cir. 2000); see *Frazier v. Heebe*, 482  
20 U.S. 641, 647 (1987) (describing attorneys admitted *pro hac vice* as "one-time or occasional  
21 practitioners"). "The district court has the power to deny or revoke an attorney's *pro hac vice*  
22 status, which is grounded within the court's inherent power 'to control admission to its bar and to  
23 discipline attorneys who appear before it.' The court's decision to do so is reviewed for abuse of  
24 discretion." *Robles v. In the Name of Humanity*, 2018 WL 2329728 at \*4 (N.D. Cal. May 23,  
25 2018) (citation omitted).

26 Civil Local Rule 11-3, which sets forth the requirements for *pro hac vice* applications,  
27 provides that an attorney who is a member in good standing and eligible to practice before the Bar  
28 of any United States Court or of the highest Court of any State may in a particular case be

permitted to practice within this District on a *pro hac vice* basis upon application and discretion of this Court. Civil L.R. 11-3(a). Relevant here, an attorney seeking *pro hac vice* status must submit their application and admission fee “*at the time of the filing of a complaint or the attorney’s first appearance in the case.*” Civil L.R. 11-3(b) (emphasis added). Further, an attorney who “regularly engage[s] in the practice of law in the State of California” is disqualified from *pro hac vice* admission (absent certain exceptions not germane here). Civil L.R. 11-3(c). In addition to the application documents, an applicant for *pro hac vice* admission must pay the fee for such admission at the time of the application (currently set at \$328 per applicant, per case). Civil L.R. 11-3(e); see <https://www.cand.uscourts.gov/about/clerks-office/court-fees/>.

The Court may impose sanctions for violations of its local rules concerning *pro hac vice* admission. See Civil L.R. 11-8 (“A person who exercises, or pretends to be entitled to exercise, any of the privileges of membership in the bar of this Court, when that person is not entitled to exercise such privileges, may be referred to the Standing Committee in addition to any action authorized by applicable law.”) It is axiomatic that the Court has authority to enforce its local rules. 28 U.S.C. § 2071. A district court’s order regarding compliance with local rules is reviewed for abuse of discretion and broad deference is given to a court’s interpretation of its local rules. *Bias v. Moynihan*, 508 F.3d 1212, 1223 (9th Cir. 2007).

Canon 3(B)(6) for the Code of Conduct for United States Judges provides that “[a] judge should take appropriate action upon receipt of reliable information indicating the likelihood that . . . a lawyer violated applicable rules of professional conduct.” The unauthorized practice of law and the aiding of another’s unauthorized practice of law violate California’s ethical rules and such conduct may lead to disciplinary proceedings and other adverse consequences. See California Rules of Professional Conduct 5.5(a)-(b); State Bar of California Rule 1-300 (prohibiting unauthorized practice of law); CAL. BUS. & PROF. CODE § 6125 (“No person shall practice law in California unless the person is an active member of the State Bar.”). The unauthorized practice of law and the aiding of another’s unauthorized practice of law also violate this Court’s standards for professional conduct and may lead to disciplinary proceedings and other adverse consequences.

Mr. Ramey and Mr. Kubiak are both members of the State Bar of Texas. The Texas

Disciplinary Rules of Professional Conduct provide, among other things, that a lawyer shall not “practice law in a jurisdiction where doing so violates the regulation of the legal profession in that jurisdiction[.]” Texas Disciplinary Rule of Professional Conduct 5.05(a). A lawyer is subject to sanctions by the State Bar of Texas “for conduct occurring in another jurisdiction or resulting in lawyer discipline in another jurisdiction.” *See* Texas Rules of Disciplinary Procedure CC.2 (defining sanctionable attorney conduct to include “[a]ttorney conduct that occurs in another jurisdiction, including before any federal court or federal agency, and results in the disciplining of an attorney in that other jurisdiction”).

As noted, these attorneys filed three successive cases on behalf of this same Plaintiff, Koji, against this same Defendant, Renesas, asserting infringement of the same patent in each case. The first of the three cases was filed in the District of Colorado. *See* Complaint, *Koji I*, No. 23-cv-01674-SKC (D. Colo. June 30, 2023), ECF No. 1. Mr. Ramey signed the complaint in the First Action, he is listed as counsel on the civil cover sheet, and he signed the notice of voluntary dismissal of the first case. *Id.* The complaint in the First Action lists both Mr. Ramey and Mr. Kubiak as “Attorneys for KOJI IP, LLC.” *Id.* The Court takes judicial notice that Mr. Ramey, Mr. Kubiak, and Ms. Kalra are all members in good standing of the District of Colorado’s Bar. The District of Colorado’s Standards of Professional Conduct adopt the Colorado Rules of Professional Conduct for members of the Colorado Bar Association. D.C.COLO.LAttyR 2(a). The Colorado Rules of Professional Conduct provide, among other things, that a lawyer shall not “practice law in a jurisdiction where doing so violates the regulation of the legal profession in that jurisdiction[.]” Colo. R. Prof’l. Cond. 5.5(a)(2).

Further, the Court takes judicial notice that Mr. Ramey and Mr. Kubiak are registered to practice as patent attorneys before the United States Patent and Trademark Office (“USPTO”). The USPTO’s Rules of Professional Conduct provide, among other things, that a “practitioner shall not practice law in a jurisdiction in violation of the regulation of the legal profession in that jurisdiction, or assist another in doing so.” 37 C.F.R. § 11.505. A registered patent attorney is subject to discipline for “professional misconduct” by the USPTO, where misconduct includes being “publicly disciplined on ethical or professional misconduct grounds by any duly constituted



authority of: (1) A State, [or] (2) The United States.” *Id.* § 11.804(h)(1)-(2).

As noted, pursuant to Civil Local Rule 11-3(c), an attorney who is “regularly engaged in the practice of law in the State of California” is ineligible for *pro hac vice* admission. Given the sheer number of cases in this District alone in which Mr. Ramey and Mr. Kubiak have been involved in recent years, had they properly filed motions for *pro hac vice* admission in these cases, they would certainly have reached the point of disqualification for *pro hac* admission due to their regular engagement in the practice of law in California. *See, e.g., Guguni v. Chertoff*, No. C 08-1850 JL, 2008 WL 2080788, at \*1 (N.D. Cal. May 14, 2008) (denying *pro hac vice* application on grounds of regular practice in California for attorney who appeared in the Northern District in at least five other cases); *see also Wang v. Future Motion, Inc.*, 646 F. Supp. 3d 1147, 1151-52 (N.D. Cal. 2022) (denying *pro hac vice* application for attorney who appeared in at least one new case each year since 2002 in the Northern District of California). The Court also notes that, for purposes of determining whether these attorneys have been regularly engaged in the practice of law in California, the numerous cases in which they have also appeared in the Central District of California discussed above would further weigh in favor of that finding. *See Wang*, 646 F. Supp. 3d at 1152 (noting attorney Berman has appeared in 189 cases in the Central District of California and finding “that [attorney] Berman appearing as an attorney in over 480 California federal cases is pertinent to the Court’s analysis of whether Berman is ‘regularly engaged in the practice of law’ in California”).

As discussed above, the Ramey firm’s business model includes filing and then quickly settling patent infringement lawsuits. In response to the OSC, Mr. Kubiak admitted that “[a] decision was made by Mr. Ramey to attempt reduce costs on cases that resolved quickly, by not automatically filing a request for *pro hac vice* admission.” [Dkt. 28-15 at 4]. In that regard, Mr. Ramey’s declaration admits the following:

A decision was made by me, at the request of [Koji’s] Carlos Gorrichategui in early 2022, a client manager, to attempt reduce costs on cases that resolved quickly, by not automatically filing a request for *pro hac vice* admission. Beginning in around 2022, I directed that Ramey LLP stopped filing for *pro hac vice* applications in all cases but I incorrectly left a signature line with an attorney, that, if the case progressed, would later seek *pro hac vice* admission. That was my

mistake.

[Dkt. 28-2 at 7]. At the OSC hearing, Mr. Ramey conceded that the out-of-state attorneys at his firm purposefully avoid filing *pro hac vice* motions in this Court to avoid the *pro hac* application fees, because so few cases proceed beyond the pleading stages in light of the business model under which so many of his law firm's cases settle early for low or nuisance value.

Mr. Ramey's declaration is not accurate or candid, because as shown above, the Ramey lawyers have failed to file applications for *pro hac vice* admission in dozens of cases pre-dating the alleged 2022 request from Koji to stop filing such applications. Mr. Ramey's attempt to lay responsibility for the lack of *pro hac vice* applications on his client's request in 2022 is contrary to the objective facts. The Ramey firm represented numerous plaintiffs in this Court prior to 2022 without filing applications for *pro hac vice* admission. Nothing supports the averment in the declaration that this practice was spurred by Koji. Accordingly, the Court is troubled by Mr. Ramey's apparent attempt to deflect responsibility and obfuscate the timing of his law firm's practices in this declaration.

The Court **FINDS** that the two out-of-state attorneys from the Ramey firm do, in fact, regularly practice law in California, given the number of cases involving these attorneys in the Northern District of California and the Central District of California identified to date. If Mr. Ramey and Mr. Kubiak had properly filed applications for *pro hac vice* admission in each of the listed cases above and had they accurately listed the number of times they applied previously for *pro hac vice* admission, their *pro hac vice* applications filed at this point would be denied on the grounds that they are regularly engaged in the practice of law in California.

As discussed above, Mr. Ramey and his firm have been sanctioned by numerous other courts across the country. Mr. Ramey's and the Ramey law firm's long history of repeated instances of rules violations and noncompliance impacts the Court's decision regarding the imposition of sanctions here. It is clear that the conduct at issue in this case is not due to excusable neglect or oversight. Rather, as admitted, the conduct here was based on a conscious decision to avoid the application fees. By failing consistently to file for *pro hac vice* admission, this pattern of conduct all but deprived this Court (and other judges in California) of the

1 information necessary to determine whether or not the Ramey attorneys from Texas are regularly  
2 engaged in the practice of law in California. While an attorney's failure to pay *pro hac* admission  
3 fees in any one case may involve relatively minor costs, the repeated nature of the rules violations  
4 here and the pattern of conduct makes clear that this conduct is capable of repetition (and indeed  
5 has been repeated) while evading review, because the early settlement of the Ramey firm's cases  
6 has impeded other courts' abilities to address the conduct squarely.

7 The conduct here is consistent with a pattern and practice of violating and flouting ethical  
8 rules. *See ZT IP, LLC v. VMware, Inc.*, No. 3:22-CV-0970-X, 2023 WL 1785769, at \*3 (N.D.  
9 Tex. Feb. 6, 2023) ("[W]hether it acted in ignorance or negligence, ZT looks worse because of its  
10 counsel's previous failure in a similar situation [to comply with Rule 11]. . . . ZT finds itself in a  
11 similar position today with [Attorney William Ramey] again serving as counsel. The standard for  
12 an exceptional case does not change based on counsel's previous failures; however, a previous  
13 warning about certain pre-filing failures aids the Court in finding frivolousness, motivation, and  
14 the need to advance considerations of compensation and deterrence.").

15 Accordingly, in light of the totality of the factual circumstances and pursuant to applicable  
16 legal standards, the Court **FINDS** that Mr. Ramey and Mr. Kubiak have in this case, and  
17 repeatedly and knowingly in many other cases, engaged in the unauthorized practice of law in the  
18 Northern District of California and in the State of California; have in this case, and repeatedly and  
19 knowingly in many other cases, violated applicable rules of professional conduct to which they are  
20 bound due to their licensing in various jurisdictions; have in this case, and repeatedly and  
21 knowingly in many other cases, violated the Northern District of California's Civil Local Rules  
22 (including, especially, the rules governing *pro hac vice* admissions); and have failed to provide  
23 sufficient justification for these instances of repeated willful misconduct.

24 Further, the Court **FINDS** that Ms. Kalra has in this case, and repeatedly and knowingly in  
25 many other cases, aided and abetted Mr. Ramey and Mr. Kubiak in engaging in their unauthorized  
26 practice of law in this Court and in the State of California; has in this case, and repeatedly and  
27 knowingly in many other cases, violated the California Rules of Professional Conduct and the  
28 Northern District of California's guidelines for professional conduct; has in this case, and

1 repeatedly and knowingly in many other cases, violated the Northern District of California's Civil  
2 Local Rules (including especially the rules governing *pro hac vice* admissions); and has failed to  
3 provide sufficient justification for these instances of repeated misconduct.

4 The Court therefore **ORDERS** that Attorneys Ramey, Kubiak, and Kalra are hereby  
5 sanctioned as set forth further in this Order, pursuant to the Court's inherent authority, the Court's  
6 authority under the Civil Local Rules, and the Court's authority under Rule 11 and applicable law.

#### 7 **IV. Deterrence of Future Conduct**

8 The conduct at issue here sparked significant discussion both in the briefing and at oral  
9 argument. The manner in which these attorneys indicate they have or would modify their  
10 approach to the practice of law impacts the nature and extent of sanctions the Court has  
11 considered. *See* Fed. R. Civ. P. 11 advisory committee's note to 1983 amendment (A "court,  
12 however, retains the necessary flexibility to deal appropriately with violations of the rule. It has  
13 discretion to tailor sanctions to the particular facts of the case, with which it should be well  
14 acquainted."); *In re Yagman*, 796 F.2d 1165, 1182-83 (9th Cir. 1986) ("Each case must be taken  
15 individually and evaluated in light of its own peculiar circumstances. If sanctions are warranted  
16 by those circumstances, the court should not waiver in imposing them. In so doing, however, the  
17 court must be meticulously aware that this precarious balance can only be maintained if the  
18 sanctions are justly imposed. . . . It also means that the amount of the sanctions and the manner in  
19 which they are imposed cannot be inconsistent with the purpose and directive of the authority on  
20 which the sanctions are based."); *Cooter & Gell v. Hartmax Corp.*, 496 U.S. 384, 404 (1990)  
21 ("The district court is best acquainted with the local bar's litigation practices and thus best situated  
22 to determine when a sanction is warranted to serve Rule 11's goal of specific and general  
23 deterrence.").

24 At the OSC hearing, Mr. Ramey represented to this Court that he and his law firm changed  
25 their procedures so that neither his name nor Mr. Kubiak's name would appear on future filings or  
26 pleadings (even though they would continue to work on cases pending in this Court in the future).  
27 Mr. Ramey represented that the only counsel named on the pleadings would be Ms. Kalra because  
28 she is a member of the California bar. Mr. Ramey and Mr. Kubiak indicated no intention to obtain

1 California State Bar membership, and at the hearing, declined the Court's suggestion that they  
2 take the California bar exam given how frequently they litigate in California.

3 In essence, Mr. Ramey's plan to avoid the same issues detailed in this Order going forward  
4 is to work on California cases by ghostwriting pleadings, briefs, and infringement contentions, as  
5 well as lead settlement negotiations, all in the background without informing the judge (or their  
6 opponents) of the substantial work they are doing on those cases. According to Mr. Ramey, the  
7 plan for all members of the Ramey firm who are not members of the California bar is to identify  
8 only Ms. Kalra (or any member of the California bar who signs pleadings in their own name) as  
9 the sole counsel of record for their clients, and thus, as the only attorney subject to a court's  
10 express oversight and discipline.

11 The flaw in this plan is that Mr. Ramey leads *all* litigation at his firm, from strategy, to  
12 client communications, to settlement negotiations. Further, under the proposed plan, other out-of-  
13 state lawyers from the Ramey firm's Texas office would continue to perform the actual, detailed,  
14 and significant legal work to analyze and interpret patent claims, develop infringement theories,  
15 work with expert consultants, and prepare infringement claims charts—just as happened in this  
16 case with regard to Mr. Kubiak. As admitted in the attorney declarations, Ms. Kalra relied heavily  
17 on Mr. Ramey and Mr. Kubiak for virtually all substantive work in preparing and filing the  
18 complaint here.

19 The Court is further aware of the number and volume of cases in California involving the  
20 Ramey firm. If, going forward, only Ms. Kalra (or some other California lawyer) is the sole  
21 attorney of record for all Ramey firm clients litigating in California, there would eventually arise  
22 questions as to how one lawyer can ethically and responsibly prepare, make inquiry and  
23 investigation, and then sign pleadings in dozens of patent lawsuits all pending at the same time.  
24 As members of the IP bar are well aware, patent lawsuits are typically complicated and time  
25 consuming; the Northern District of California's promulgation of specific Patent Local Rules  
26 unique to patent cases is in part a recognition of the unique challenges in the effective  
27 management of patent cases as compared to other subject matter areas. The long experience of the  
28 undersigned with patent litigation informs these concerns—it appears impractical (if not highly

1 improbable) for one local California attorney, such as Ms. Kalra, to fully comply with their  
2 obligations under Rule 11 for every pleading or filing in dozens of co-pending and active patent  
3 lawsuits. *See Little v. JB Pritzker for Governor*, No. 18 C 6954, 2021 WL 1165097, at \*7 n.2  
4 (N.D. Ill. Mar. 26, 2021) (“[I]t is the attorney’s job to bite off only what he can competently  
5 chew.”).

6 Further, this proposed remedial plan by Mr. Ramey and his firm would not appear to  
7 obviate the unauthorized practice of law by Mr. Ramey and Mr. Kubiak in future cases in  
8 California federal courts. As the Ninth Circuit has instructed, “[a]dmissions rules and procedure  
9 for federal court are independent of those that govern admission to practice in state courts.”  
10 *Winterrowd v. Am. Gen. Annuity Ins. Co.*, 556 F.3d 815, 820 (9th Cir. 2009) (citing *In re Poole*,  
11 222 F.3d 618, 620–22 (9th Cir.2000)). “This is true even ‘when admission to a federal court is  
12 predicated upon admission to the bar of the state court of last resort.’” *Id.* (quoting *Poole*, 222  
13 F.3d at 620).

14 As noted, only lawyers admitted to this Court’s bar may practice in cases in this District,  
15 and this Court’s Civil Local Rules prohibit *pro hac vice* admission for lawyers who “regularly  
16 engage in the practice of law in the State of California” (absent certain exceptions not germane  
17 here). Civil L.R. 11-3(c). Given how many California cases Mr. Ramey and Mr. Kubiak have  
18 worked on in recent years, it is likely that they have already maxed out on their *pro hac*  
19 admissions. If they continue to work on California cases as they have done in the past, but simply  
20 avoid putting their names on the pleadings, that merely hides the identities of the lawyers actually  
21 working on the bulk of the case from the court. The Ramey firm is not planning to transfer the  
22 control and lead of cases to Ms. Kalra (or some other California lawyer). As represented to this  
23 Court, the Ramey firm’s plan is to continue to perform the bulk of substantive work, including  
24 overall case strategy, from their offices in Texas. Such an arrangement has been held to be the  
25 unauthorized practice of law in a sister federal court in California. *See G&G Closed Circuit*  
26 *Events, LLC v. Hernandez*, No. 3:22-cv-00398-JAH-MDD, 2023 WL 5020259, at \*2-3 (S.D. Cal.  
27 Aug. 7, 2023).

28 The Ramey firm plan is particularly concerning with respect to Ms. Kalra (or the sole



California lawyer listed on the pleadings) because the practical effect of the plan is for that sole local attorney to essentially act as a pass-through for work product prepared by out-of-state lawyers, and as the sole California lawyer, she would bear the initial and perhaps primary risk under Rule 11. As noted above, a magistrate judge in the Southern District of Florida recently recommended that sanctions be imposed against the Ramey firm’s local counsel (and sole counsel on the pleadings) in another patent case, where the Ramey firm appears to have followed the same plan they intend to follow in this Court going forward:

[Ramey’s local counsel] Attorney Briant, as the only counsel of record in this matter for the plaintiff, unreasonably and without sufficient diligence allowed this matter to proceed when all facts compelled a different response.... Attorney Briant's conduct resulted from following the lead of Attorney William Ramey. Operating behind the scenes and driving the process, attorneys for the Defendant often found themselves working with Attorney Ramey, who never filed a notice of appearance or attempted to pro hac vice himself as a party to the case.... Despite failing to move for pro hac vice admission or otherwise appearing in this matter, Attorney Ramey functioned in a primary role spearheading the interactions with Defendant's counsel, while Briant took a back-seat.

*mCom IP*, 2025 U.S. Dist. LEXIS 43754, at \*13-15.

While “reliance on forwarding co-counsel may in certain circumstances satisfy an attorney's duty of reasonable inquiry,” the Ninth Circuit has made clear that “[i]n relying on another lawyer, . . . counsel must ‘acquire[] knowledge of facts sufficient to enable him to certify that the paper is well-grounded in fact.’ An attorney who signs the pleading cannot simply delegate to forwarding co-counsel his duty of reasonable inquiry.” *Unioil, Inc. v. E.F. Hutton & Co.*, 809 F.2d 548, 558 (9th Cir. 1986) (citation omitted). As noted above, given the high-volume nature of the Ramey firm’s practice, there appear to be non-trivial risks as to one lawyer’s ability to perform a reasonable inquiry for the numerous active co-pending cases involving that firm in this Court alone (much less in the entirety of California). *Cf. In re Qinghe Liu*, 2024 USPTO OED LEXIS 27 (U.S. PTO Nov. 21, 2024) (suspending lawyer who was designated as attorney of record in over 1,000 trademark applications in a two-year period).

The proposed plan for future conduct by the Ramey firm—in reaction to the OSC and apparently in anticipation of this Order—also appears to be an attempt to avoid exposing Mr.

Ramey and other out-of-state lawyers in his firm to the supervision and discipline of the Northern District of California in future patent cases. The undersigned is cognizant that California lawyers can, within the bounds of the rules of professional conduct, rely on work product from non-California lawyers in appropriate circumstances. *See Gabriel Techs. Corp. v. Qualcomm Inc.*, No. 08cv1992 AJB (MDD), 2013 WL 410103, at \*12 (S.D. Cal. Feb. 1, 2013) (“As a general matter, the Court recognizes that local counsel plays a unique role in the litigation process. The local rules require out-of-state attorneys to acquire local counsel, and often local counsel serves primarily in an administrative capacity for the limited purpose of filing documents with the Court.”). There are limits, however, and merely rubber-stamping the work product of an out-of-state lawyer exposes a California lawyer to risks which require careful consideration and procedures to ethically avoid. *Id.* (noting that, while “the reasonable inquiry required for local counsel under Rule 11 may not be the same as that required for lead counsel in many situations,” the rule “remains applicable and sanctions may be imposed against local counsel when appropriate under the circumstances”). Further, an out-of-state lawyer who ghostwrites work product and works more than occasionally on a case in this Court does not enjoy blanket immunity from supervision by a California district court. *Winterrowd*, 556 F.3d at 825 (“An out of state attorney must still apply for *pro hac vice* admission if that attorney appears in court, signs pleadings, or is the exclusive contact in a case with the client or opposing counsel.”). Therefore, as discussed below, the Court finds that the Ramey firm’s plan is properly the subject of consideration as to deterrence of future conduct when crafting and considering the sanctions herein.

### **CONCLUSION**

The Court’s analysis of the issues in this Order is not a critique of the IP plaintiffs’ bar or of non-practicing entities; as discussed in detail herein, the failures that resulted in the conclusions here are specific to the actions taken (or not taken) by the three attorneys at issue on the extraordinary facts presented in the record. In this Court’s many decades of experience in the law (particularly patent litigation), the facts here are truly extraordinary, evincing a pattern of conduct spanning many cases, over many years, specific to this one law firm and its namesake attorney.

Accordingly, **IT IS ORDERED THAT:**

- 1       1. The Order to Show Cause [Dkt. 27] is **DISCHARGED-IN-PART** subject to and as  
2       discussed by this Order.
- 3       2. Attorneys William P. Ramey, III, Jeffrey E. Kubiak, and Susan S.Q. Kalra are each  
4       sanctioned for their conduct detailed herein.
- 5       3. By no later than **April 26, 2025** each of these attorneys **SHALL** self-report the sanctions  
6       imposed on them herein and provide a copy of this Order to the relevant disciplinary  
7       committees or offices of the State Bar of California, the State Bar of Texas, the Bar of the  
8       United States District Court for the District of Colorado, the United States Patent and  
9       Trademark Office, and any other state or federal bars of which they are members. Within  
10      **ten (10) business days** of completing the self-reporting requirements, these attorneys  
11      **SHALL** file with this Court a certification under oath certifying they have self-reported as  
12      required.
- 13      4. By no later than **April 26, 2025** each of these attorneys **SHALL** self-report this sanction  
14      and provide a copy of this Order to the Northern District of California's Standing  
15      Committee of Professional Conduct, to the judges presiding over every other case currently  
16      pending in the Northern District of California in which any of these attorneys' names  
17      appears on any filings or pleadings (including all cases in which their names appear as  
18      "*pro hac vice* anticipated" or similar language), to the Central District of California's  
19      Standing Committee on Professional Conduct, and as an attachment to any motion for *pro*  
20      *hac vice* admission filed by or on behalf of any of these lawyers in any action filed in a  
21      California federal court **during the next five years**. Within **ten (10) business days** of  
22      completing these self-reporting requirements, these attorneys **SHALL** file with this Court  
23      a certification under oath certifying they have self-reported as required.
- 24      5. As discussed, Mr. Ramey has worked on and appeared on the pleadings in forty-six other  
25      cases in the Northern District of California without filing the required motion for *pro hac*  
26      *vice* admission. The fee for *pro hac vice* admission is currently \$328. By working on each  
27      of these cases without applying for *pro hac vice* admission, Mr. Ramey appropriated for  
28      himself the privilege of practicing in the Northern District of California as if he had been

admitted, without allowing each judge in each of those cases to determine from the relevant facts whether or not Mr. Ramey was regularly engaged in the practice of law in the State of California and thus ineligible for *pro hac vice* admission. Mr. Ramey has repeatedly engaged in the unauthorized practice of law in this Court (including in this case) and in other California federal courts. Further, Mr. Ramey deprived the Court of the *pro hac vice* fee he would have otherwise paid for working on each of these cases, which totals \$15,088. Mr. Ramey is the founding, named partner and managing partner of his law firm, according to his law firm's website, with over twenty years of experience, and he is the avowed lead counsel representing his client in this and other cases. The Court further finds that Mr. Ramey's declaration in response to the OSC was less than candid and borders on misleading, in that Mr. Ramey placed responsibility on his client, Koji, for the decision to not file *pro hac vice* applications since 2022, even though (as detailed above) Mr. Ramey has appeared in numerous other cases in this District prior to 2022 without filing *pro hac vice* applications and without representing Koji. Additionally, as detailed herein, Mr. Ramey knowingly directed the filing of the third complaint on behalf of Plaintiff Koji against Defendant Renesas asserting the exact same patent, despite voluntarily dismissing two prior identical cases. Mr. Ramey offered no legally supported excuses for filing the complaint in this case, identified no reasonable inquiry prior to the filing in light of Rule 41, and as discussed, this amounted to bad faith, harassment, and an abuse of the federal court system. An attorney of his experience level should know better than undertake all of these actions, and he admits that he knowingly undertook the conduct at issue here. The undersigned therefore **PERSONALLY SANCTIONS Attorney William P. Ramey III** triple the amount of unpaid *pro hac vice* fees otherwise due, for **a total of \$45,264**, for his intentional conduct herein and to deter him (and others) from such conduct in the future. Mr. Ramey **SHALL** pay this amount directly and personally (and this amount shall not be paid by his law firm or by his client) by no later than **April 26, 2025**, to the Clerk of the United States District Court for the Northern District of California. Mr. Ramey **SHALL** attach a copy of this Order to his payment.

6. As discussed, Mr. Kubiak has worked on and appeared on the pleadings in sixteen cases in the Northern District of California without filing the required motion for *pro hac vice* admission. The fee for *pro hac vice* admission is currently \$328. By working on each of these cases without applying for *pro hac vice* admission, Mr. Kubiak appropriated for himself the privilege of practicing in the Northern District of California as if he had been admitted, without allowing each judge in each of those cases to determine from the relevant facts whether or not Mr. Kubiak was regularly engaged in the practice of law in the State of California and thus ineligible for *pro hac vice* admission. Mr. Kubiak has repeatedly engaged in the unauthorized practice of law in this Court (including in this case) and in other California federal courts. Further, Mr. Kubiak deprived the Court of the *pro hac vice* fee he would have otherwise paid for working on each of these cases, which totals \$5,248. Mr. Kubiak has “acknowledge[d] that my prior practice [of not filing *pro hac vice* applications] was in error.” [Dkt. 28-15 at ¶ 13]. Mr. Kubiak has been a partner of the Ramey firm since 2012, according to the firm’s website, and has been practicing law for over twenty years. Additionally, as detailed herein, Mr. Kubiak knowingly participated in the preparation for and the filing of the third complaint on behalf of Plaintiff Koji against Defendant Renesas asserting the exact same patent, despite voluntarily dismissing two prior identical cases. Mr. Kubiak offered no legally supported excuses for filing the complaint in this case, identified no reasonable inquiry prior to the filing in light of Rule 41, and as discussed, this amounted to bad faith, harassment, and an abuse of the federal court system. An attorney of his experience should know better than undertake all of these actions, and he admits to having knowingly undertaken the conduct here. The Court therefore **PERSONALLY SANCTIONS Attorney Jeffrey E. Kubiak** double the amount of unpaid *pro hac vice* fees due, for **a total of \$10,496**, for his conduct herein and to deter him (and others) from such conduct in future. Mr. Kubiak **SHALL** pay this amount directly and personally (and this amount shall not be paid by his law firm or by his client), by no later than **April 26, 2025**, to the Clerk of the United States District Court for the Northern District of California. Mr. Kubiak **SHALL** attach a copy of this Order to his

1 payment.

2 7. Ms. Kalra worked as Counsel of the Ramey firm from February 2023 until quite recently.  
3 As of the date of the OSC hearing, she was still Counsel with the Ramey firm, but  
4 according to that firm's website and her current firm's website, she appears to have  
5 separated from the Ramey firm in either November or December 2024. Since February  
6 2023, Ms. Kalra worked on and appeared on the pleadings in at least thirty-five cases filed  
7 in the Northern District of California in which Mr. Ramey failed to file the required motion  
8 for *pro hac vice* admission, and in at least sixteen cases filed in this Court in which Mr.  
9 Kubiak failed to file the required *pro hac vice* application. The fee for *pro hac vice*  
10 admission is currently \$328. By working on each of these cases without ensuring the filing  
11 of the requisite motion for *pro hac vice* admission on behalf of other attorneys of her law  
12 firm, Ms. Kalra aided and abetted Mr. Ramey and Mr. Kubiak in their unauthorized  
13 practice of law in this Court, without allowing each judge in each of those cases to  
14 determine from the relevant facts whether or not Mr. Ramey and Mr. Kubiak were  
15 regularly engaged in the practice of law in the State of California and thus ineligible for  
16 *pro hac vice* admission. Ms. Kalra has repeatedly aided and abetted Mr. Ramey and Mr.  
17 Kubiak to engage in the unauthorized practice of law in this Court (including in this case)  
18 and in other California federal courts. Further, Ms. Kalra aided and abetted the deprivation  
19 of the *pro hac vice* fees due to this Court that Mr. Ramey would have otherwise paid for  
20 working on each of the thirty-five cases in which they were co-counsel, which totals  
21 \$11,480. Similarly, Ms. Kalra's actions aided and abetted the deprivation of the *pro hac*  
22 *vice* fees due to this Court that Mr. Kubiak would have otherwise paid for working on each  
23 of the sixteen cases in which they were co-counsel, which totals \$5,248. Thus, the total  
24 *pro hac vice* application fees which were never paid due to Ms. Kalra's actions totals  
25 \$16,728. Ms. Kalra "acknowledge[s] that the firm's prior practice [of avoiding filing *pro*  
26 *hac vice* applications] was in error[.]" [Dkt. 28-1 at ¶ 22. Ms. Kalra has been a member of  
27 the California bar for over thirty years. Additionally, as detailed herein, Ms. Kalra  
28 knowingly signed and filed the third complaint on behalf of Plaintiff Koji against



Defendant Renesas asserting the exact same patent, despite voluntarily dismissing two prior identical cases. Ms. Kalra offered no legally supported excuses for filing the complaint in this case, identified no reasonable inquiry prior to the filing in light of Rule 41, and as discussed, this amounted to bad faith, harassment, and an abuse of the federal court system. Ms. Kalra avers in her declaration that “at all times, I was acting as lead attorney on all California matters and William Ramey and Jeffrey Kubiak were practicing under my license.” [Dkt. 28-1 at ¶ 22]. Ms. Kubiak nowhere explains (and did not explain at the OSC hearing) how an out-of-state attorney can “practice under the license” of a California attorney without being admitted *pro hac vice*. Mr. Ramey and Mr. Kubiak similarly failed to explain how they could “practice under” Ms. Kalra’s bar admission or license in California without being admitted *pro hac vice*. [Dkt. 28-15 at ¶ 13; Dkt. 28-2 at ¶ 20]. An attorney of Ms. Kalra’s experience level should know better than undertake all of these actions, and she admits to having knowingly undertaken the conduct at issue here. Because Ms. Kalra aided and abetted the conduct at issue, and because Ms. Kalra appears to have separated from the Ramey firm (and thus, is no longer involved in the business practices at issue here in the foreseeable future), the Court therefore **PERSONALLY SANCTIONS Attorney Susan S.Q. Kalra** by a reduced one-half of the amount of *pro hac vice* application fees that would have otherwise been paid for the two attorneys she aided and abetted, for **a total of \$8,364**, for her conduct herein and to deter her (and others) from such conduct in future. Ms. Kalra **SHALL** pay this amount directly and personally (and this amount shall not be paid by the Ramey law firm or by Koji) by no later than **April 26, 2025**, to the Clerk of the United States District Court for the Northern District of California. Ms. Kalra **SHALL** attach a copy of this Order to his payment.

8. To be clear, while the amounts of monetary sanctions imposed are derived from the amount of *pro hac vice* fees that went unpaid, the Court utilized that rubric within its discretion to rationally and proportionally determine an appropriate amount of monetary sanctions to impose for all of the conduct and failures described herein. Further, as indicated, the Court enhanced or diminished the amount based on unpaid *pro hac vice* fees

as a reflection of the level of responsibility for each attorney in the conduct at issue, the seriousness of the conduct, and as a deterrent for future conduct.

9. As discussed in detail herein, Mr. Ramey informed the Court of his intention to undertake future work in this Court and in other California district courts by simply removing his (and Mr. Kubiak's) names from the pleadings. As discussed, this course of action raises concerns, particularly as to how it would be ethically, professionally, and competently administered. The record indicates that the Ramey firm has followed that practice in at least one other district court, and has been subject to sanctions along with its local counsel for their conduct using this plan. The Court therefore finds that monetary sanctions alone are not sufficient to deter the conduct at issue and finds that additional monetary sanctions would not be proportionate and would not serve the goal of deterrence under Rule 11. Accordingly, the Court further **ORDERS** Mr. Ramey and Mr. Kubiak to each complete at least two hours of in-person, California bar-approved CLE classes on Legal Ethics and/or Professional Conduct, and at least an additional two hours of in-person, California bar-approved CLE on Law Practice Management, all such CLE to be completed by no later than **March 27, 2026**. Mr. Ramey and Mr. Kubiak **SHALL** file with the Court a certification, under oath, that each has completed such CLE by the deadline (attaching any certificate of completion from the CLE provider(s)), where such certification shall be filed within **ten (10) business days** of the completion of each such CLE course.

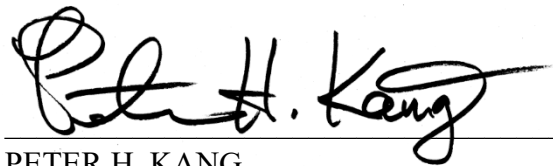
10. As noted, the record indicates that the conduct at issue here resulted from practices or policies of the Ramey law firm with regard to handling (and not filing) *pro hac vice* applications and a failure to conduct reasonable pre-filing inquiry before filing a third complaint after two prior voluntary dismissals of the same cause of action. Therefore, the Court further **ORDERS** Mr. Ramey and Mr. Kubiak to provide all attorneys of the Ramey law firm copies of this Order as well as copies of all educational materials received in connected with the CLE courses ordered above. The required distribution of this Order **SHALL** be completed by no later than **April 2, 2025**. The required distribution of CLE educational materials within the Ramey firm **SHALL** be completed within **ten (10)**

**business days** of the completion of each of the CLE courses ordered herein. The certifications ordered above **SHALL** include certifications by Mr. Ramey and Mr. Kubiak of the distribution of this Order and the CLE educational materials to all Ramey firm lawyers.

11. The Court **SHALL** retain jurisdiction over these attorneys, pending completion of the payments, CLEs, and certifications required by this Order, and to ensure proper compliance with this Order and the Court's directives.

**IT IS SO ORDERED.**

Dated: March 26, 2025



PETER H. KANG  
United States Magistrate Judge

UNITED STATES DISTRICT COURT  
NORTHERN DISTRICT OF CALIFORNIA

KOJI IP, LLC,

Plaintiff(s)

v.

RENESAS ELECTRONICS AMERICA,  
INC.

Defendant(s).

Case No. C 5:24-cv-03089

CONSENT OR DECLINATION  
TO MAGISTRATE JUDGE  
JURISDICTION

**INSTRUCTIONS:** Please indicate below by checking **one** of the two boxes whether you (if you are the party) or the party you represent (if you are an attorney in the case) choose(s) to consent or decline magistrate judge jurisdiction in this matter. Sign this form below your selection.

☒ **Consent to Magistrate Judge Jurisdiction**

In accordance with the provisions of 28 U.S.C. § 636(c), I voluntarily **consent** to have a United States magistrate judge conduct all further proceedings in this case, including trial and entry of final judgment. I understand that appeal from the judgment shall be taken directly to the United States Court of Appeals for the Ninth Circuit.

**OR**

☐ **Decline Magistrate Judge Jurisdiction**

In accordance with the provisions of 28 U.S.C. § 636(c), I **decline** to have a United States magistrate judge conduct all further proceedings in this case and I hereby request that this case be reassigned to a United States district judge.

DATE: 2024-06-10

NAME: Susan S.Q. Kalra

COUNSEL FOR  
(OR "PRO SE"): KOJI IP, LLC,

/s/ Susan S.Q. Kalra

*Signature*

ADD0083

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*Attorneys for Plaintiff*  
Koji IP, LLC

**IN THE UNITED STATES DISTRICT COURT  
FOR THE NORTHERN DISTRICT OF CALIFORNIA  
SAN JOSE DIVISION**

KOJI IP, LLC,

Plaintiff,

v.

RENESAS ELECTRONICS  
AMERICA, INC.,

Defendant.

Case No.: 3:24-cv-03089-PHK

**PLAINTIFF'S NOTICE OF  
VOLUNTARY DISMISSAL WITH  
PREJUDICE**

**JURY TRIAL DEMANDED**

Pursuant to Federal Rule 41 (a)(1)(A)(i), the Plaintiff, Koji IP, LLC, hereby files this notice of dismissal of this action for all of Plaintiff's claims as Defendant has not answered or filed a motion for summary judgment. The dismissal of Plaintiff's claims shall be WITH PREJUDICE as to the asserted patent and each party

1 shall bear its own costs, expenses and attorneys' fees.

2  
3  
4 Dated: June 12, 2024

Respectfully submitted,

5 RAMEY LLP

6  
7 /s/ Susan S.Q. Kalra

Susan S.Q. Kalra (CA State Bar No. 16740)

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21 ***Attorneys for Plaintiff***

22 ***Koji IP, LLC***



UNITED STATES DISTRICT COURT  
NORTHERN DISTRICT OF CALIFORNIA

KOJI IP, LLC ,  
Plaintiff(s),  
v.  
RENESAS ELECTRONICS  ,  
Defendant(s).

Case No. 3:24-cv-03089-PHK

**APPLICATION FOR ADMISSION OF  
ATTORNEY PRO HAC VICE  
(CIVIL LOCAL RULE 11-3)**

I, Benjamin Charkow, an active member in good standing of the bar of  
New York, hereby respectfully apply for admission to practice pro hac  
vice in the Northern District of California representing: RENESAS ELECTRONICS AM in the  
above-entitled action. My local co-counsel in this case is Jason A. Crotty, an  
attorney who is a member of the bar of this Court in good standing and who maintains an office  
within the State of California. Local co-counsel's bar number is: 196036.

15 W. 26th St., 7th Fl., New York, NY 10010

MY ADDRESS OF RECORD

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LOCAL CO-COUNSEL'S ADDRESS OF RECORD

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LOCAL CO-COUNSEL'S TELEPHONE # OF RECORD

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LOCAL CO-COUNSEL'S EMAIL ADDRESS OF RECORD

I am an active member in good standing of a United States Court or of the highest court of  
another State or the District of Columbia, as indicated above; my bar number is: 4215208.

A true and correct copy of a certificate of good standing or equivalent official document  
from said bar is attached to this application.

I have been granted pro hac vice admission by the Court 0 times in the 12 months  
preceding this application.

ADD0086

1 I agree to familiarize myself with, and abide by, the Local Rules of this Court, especially  
 2 the Standards of Professional Conduct for attorneys and the Alternative Dispute Resolution Local  
 3 Rules. I declare under penalty of perjury that the foregoing is true and correct.

4 Dated: June 26, 2024 Benjamin Charkow  
 5 APPLICANT

6 

---

---

7  
 8 ORDER GRANTING APPLICATION  
 9 FOR ADMISSION OF ATTORNEY PRO HAC VICE

10  
 11 IT IS HEREBY ORDERED THAT the application of Benjamin Charkow is  
 12 granted, subject to the terms and conditions of Civil L.R. 11-3. All papers filed by the attorney  
 13 must indicate appearance pro hac vice. Service of papers upon, and communication with, local co-  
 14 counsel designated in the application will constitute notice to the party.

15 Dated: \_\_\_\_\_

16  
 17 \_\_\_\_\_  
 18 UNITED STATES DISTRICT/MAGISTRATE JUDGE

United States District Court  
 Northern District of California

19  
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 28

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RENESAS ELECTRONICS AMERICA INC.

UNITED STATES DISTRICT COURT  
NORTHERN DISTRICT OF CALIFORNIA  
SAN FRANCISCO DIVISION

KOJI IP, LLC,

Plaintiff,

v.

RENESAS ELECTRONICS AMERICA,  
INC.,

Defendant.

Case No.: 3:24-cv-03089-PHK

**DEFENDANT RENESAS ELECTRONICS  
AMERICA INC.'S NOTICE OF MOTION  
AND MOTION FOR ATTORNEYS' FEES  
(35 U.S.C. § 285)**

Hearing Date: August 2, 2024  
Time: 1:00 p.m.  
Hon. Peter H. Kang

**NOTICE OF MOTION**

TO ALL PARTIES AND THEIR ATTORNEYS OF RECORD:

PLEASE TAKE NOTICE that, on Friday, August 2, 2024, at 1:00 p.m., a hearing will be held before the Honorable Peter H. Kang at the San Francisco Courthouse, Courtroom F – 15th Floor, 450 Golden Gate Ave., San Francisco, CA 94102 on Defendant Renesas Electronics America Inc.'s Motion for Attorneys' Fees.

**TABLE OF CONTENTS**

STATEMENT OF RELIEF .....	1
MEMORANDUM OF POINTS AND AUTHORITIES .....	1
I. INTRODUCTION.....	1
II. FACTUAL BACKGROUND .....	1
A. Overview .....	1
B. The Asserted Patent.....	2
C. The First Action .....	4
D. The Second Action .....	4
E. The Third Action .....	5
F. Ramey LLP: Koji’s Counsel and Business Partner.....	6
III. LEGAL STANDARD .....	7
IV. ARGUMENT .....	8
A. REA is the Prevailing Party .....	8
B. These Cases are Exceptional .....	11
C. Bases for Sanctions Against Koji’s Counsel.....	18
V. AMOUNT OF FEES .....	20
VI. CONCLUSION .....	21

**TABLE OF AUTHORITIES**

<b><u>Cases</u></b>	<b><u>Page(s)</u></b>
<i>Bayer CropScience AG v. Dow AgroSciences LLC</i> , 851 F.3d 1302 (Fed. Cir. 2017) .....	8
<i>Blackbird Tech LLC v. Health In Motion LLC</i> , 944 F.3d 910 (Fed. Cir. 2019) .....	15, 16
<i>Bright v. United States</i> , 603 F.3d 1273 (Fed. Cir. 2010) .....	11
<i>Bristol-Myers Squibb Co. v. Ben Venue Labs., Inc.</i> , 246 F.3d 1368 (Fed. Cir. 2001) .....	16
<i>Buckhannon Bd. &amp; Care Home, Inc. v. W. Virginia Dep't of Health &amp; Human Res.</i> , 532 U.S. 598 (2001) .....	8
<i>Buster v. Greisen</i> , 104 F.3d 1186 (9th Cir. 1997) .....	17
<i>Camacho v. Bridgeport Fin., Inc.</i> , 523 F.3d 973 (9th Cir. 2008) .....	20
<i>Cap Co., Ltd. v. McAfee, Inc.</i> , No. 14-CV-05068-JD, 2015 WL 4734951 (N.D. Cal. Aug. 10, 2015) .....	13
<i>Commercial Space Management Co., Inc. v. The Boeing Co., Inc.</i> , 193 F.3d 1074 (9th Cir. 1999) .....	9, 10
<i>CRST Van Expedited, Inc. v. EEOC</i> , 578 U.S. 419 (2016) .....	8, 11
<i>CTD Networks LLC v. Microsoft Corp.</i> , No. W-22-CV-01049-XR, 2023 WL 5417141 (W.D. Tex. Aug. 22, 2023) .....	13
<i>Eon-Net LP v. Flagstar Bancorp.</i> , 653 F.3d 1314 (Fed. Cir. 2011) .....	7, 16
<i>EscapeX IP LLC v. Google LLC</i> , No. 22-cv-08711-VC, 2023 WL 5257691 (N.D. Cal. Aug. 16, 2023) .....	<i>passim</i>
<i>Estate of Blue v. Cnty. of Los Angeles</i> , 120 F.3d 982 (9th Cir. 1997) .....	17
<i>Fink v. Gomez</i> , 239 F.3d 989 (9th Cir. 2001) .....	18

1	<i>First Time Videos, LLC v. Oppold,</i>	
2	No. 6:12-cv-1493-Orl-36KRS, 2013 WL 12094410 (M.D. Fla. Sept. 16, 2013) .....	10
3	<i>Freedman Seating Co. v. Am. Seating Co.,</i>	
4	420 F.3d 1350 (Fed. Cir. 2005) .....	13
5	<i>Geovector Corp. v. Samsung Elecs. Co. Ltd.,</i>	
6	No. 16-CV-02463-WHO, 2017 WL 76950 (N.D. Cal. Jan. 9, 2017) .....	13
7	<i>Gonzalez v. City of Maywood,</i>	
8	729 F.3d 1196 (9th Cir. 2013) .....	20
9	<i>Hensley v. Eckerhart,</i>	
10	461 U.S. 424 (1983) .....	20
11	<i>Highway Equip. Co. v. FECO, Ltd.,</i>	
12	469 F.3d 1027 (Fed. Cir. 2006) .....	8, 10
13	<i>Inventor Holdings, LLC v. Bed Bath &amp; Beyond, Inc.,</i>	
14	876 F.3d 1372 (Fed. Cir. 2017) .....	15
15	<i>Kelly v. Wengler,</i>	
16	822 F.3d 1085 (9th Cir. 2016) .....	20
17	<i>Lumen View Tech. LLC v. Findthebest.com, Inc.,</i>	
18	811 F.3d 479 (Fed. Cir. 2016) .....	8
19	<i>Melamed v. Blue Cross of Cal.,</i>	
20	557 F. App'x 659 (9th Cir. 2014) .....	9
21	<i>Nat'l Oilwell Varco, L.P. v. Omron Oilfield &amp; Marine, Inc.,</i>	
22	676 Fed. Appx. 967 (Fed. Cir. 2017) .....	17
23	<i>Octane Fitness, LLC v. ICON Health &amp; Fitness, Inc.,</i>	
24	572 U.S. 545 (2014) .....	7
25	<i>Ortiz &amp; Assocs. Consulting, LLC v. VIZIO, Inc.,</i>	
26	No. 3:23-CV-00791-N, 2024 WL 815553 (N.D. Tex. Feb. 27, 2024) .....	7, 19
27	<i>Owens v. Kaiser Found. Health Plan, Inc.,</i>	
28	244 F.3d 708 (9th Cir. 2001) .....	9
	<i>Pickman v. Am. Express Co., No. C,</i>	
	11-05326 WHA, 2012 WL 258842 (N.D. Cal. Jan. 27, 2012) .....	9
	<i>Power Mosfet Techs., L.L.C. v. Siemens AG,</i>	
	378 F.3d 1396 (Fed. Cir. 2004) .....	8
	<i>Q-Pharma, Inc. v. Andrew Jergens Co.,</i>	
	360 F.3d 1295 (Fed. Cir. 2004) .....	8



1	<i>Rambus Inc. v. Infineon Techs. AG</i> ,	
2	318 F.3d 1081 (Fed. Cir. 2003).....	18
3	<i>Raniere v. Microsoft Corp.</i> ,	
4	887 F.3d 1298 (Fed. Cir. 2018).....	8
5	<i>Realtime Adaptive Streaming LLC v. Netflix, Inc.</i> ,	
6	41 F.4th 1372 (Fed. Cir. 2022) .....	10
7	<i>Realtime Adaptive Streaming LLP v. Netflix, Inc.</i> ,	
8	No. CV 19-6361-GW-JCx, 2020 WL 8024356 (C.D. Cal. Nov. 23, 2020) .....	10
9	<i>Richter v. Oracle Am., Inc.</i> ,	
10	No. 22-CV-04795-BLF, 2023 WL 8586690 (N.D. Cal. Dec. 8, 2023) .....	17
11	<i>Rothschild Connected Devices Innovations, LLC v. Guardian Prot. Servs.</i> ,	
12	858 F.3d 1383 (Fed. Cir. 2017).....	7
13	<i>Ruegsegger v. Caliber Home Loans, Inc.</i> ,	
14	No. SA CV 20-00531-DOC-KES, 2020 WL 2549934 (C.D. Cal. May 19, 2020) .....	9
15	<i>Ryan v. Editions Ltd. W., Inc.</i> ,	
16	786 F.3d 754 (9th Cir. 2015).....	20
17	<i>Schering Corp. v. Geneva Pharms., Inc.</i> ,	
18	339 F.3d 1373 (Fed. Cir. 2003).....	16
19	<i>SFA Sys., LLC v. Newegg Inc.</i> ,	
20	793 F.3d 1344 (Fed. Cir. 2015).....	7, 15, 16
21	<i>Shipping &amp; Transit, LLC v. Hall Enterprises, Inc.</i> ,	
22	No. CV 16-06535-AG-AFM, 2017 WL 3485782 (C.D. Cal. July 5, 2017) .....	16
23	<i>Stephens v. Tech Int'l, Inc.</i> ,	
24	393 F.3d 1269 (Fed. Cir. 2004).....	15
25	<i>Taurus IP, LLC v. DaimlerChrysler Corp.</i> ,	
26	726 F.3d 1306 (Fed. Cir. 2013).....	14
27	<i>Thermolife Int'l LLC v. GNC Corp.</i> ,	
28	922 F.3d 1347 (Fed. Cir. 2019).....	17
	<i>TIP Sys., LLC v. Phillips &amp; Brooks/Gladwin, Inc.</i> ,	
	529 F.3d 1364 (Fed. Cir. 2008).....	13
	<i>Uniloc USA, Inc. v. Blackberry Corp.</i> ,	
	No. 3:18-CV-1883-N, 2021 WL 12104812 (N.D. Tex. July 1, 2021) .....	10
	<i>United Cannabis Corp. v. Pure Hemp Collective Inc.</i> ,	
	66 F.4th 1362 (Fed. Cir. 2023).....	8

<i>Verna IP Holdings, LLC v. Alert Media, Inc.</i> , No. 6:21-CV-00422-ADA, 2023 WL 5918320 (W.D. Tex. Sept. 11, 2023).....	7
<i>Viavi Sols. Inc. v. Platinum Optics Tech. Inc.</i> , No. 5:20-CV-05501-EJD, 2023 WL 3236896 (N.D. Cal. May 2, 2023).....	8
<i>Vilox Techs., LLC v. Salesforce, Inc.</i> , No. 23-CV-05047-AMO, 2024 WL 2807924 (N.D. Cal. May 31, 2024).....	13
<b><u>Statutes</u></b>	
28 U.S.C. § 1927 .....	18
28 U.S.C. § 2072 .....	11
35 U.S.C. § 285 .....	1, 7, 10, 11
<b><u>Rules</u></b>	
Cal. R. Prof. Conduct 4.2 .....	6
Fed. R. Civ. P. 41 .....	5, 9, 10, 11
N.D. Cal. Civil L.R. 11-4 .....	6

**STATEMENT OF RELIEF**

Defendant Renesas Electronics America Inc. (“REA”) moves to recover its attorneys’ fees from Plaintiff Koji IP, LLC (“Koji”) pursuant to 35 U.S.C. § 285.

**MEMORANDUM OF POINTS AND AUTHORITIES****I. INTRODUCTION**

REA brings this motion to address Koji’s relentless pursuit of frivolous patent infringement claims, a crusade spanning three lawsuits in two courts. The cases were pursued in a slipshod manner that imposed unnecessary costs on REA. Along the way, Koji has cycled through a series of supposedly infringing products while strategically avoiding litigation on the merits. Despite knowing REA was represented, Koji also directly contacted in-house counsel at Renesas. REA repeatedly informed Koji that it would move for sanctions, but Koji continued to file and assert frivolous claims. The result was three consecutive voluntary dismissals.

The facts demonstrate that these cases were filed for an improper purpose: to leverage the substantial cost of litigation to obtain a settlement notwithstanding the absence of a meritorious claim. REA is the prevailing party and for the reasons detailed below, those cases are “exceptional.” Accordingly, pursuant to 35 U.S.C. § 285, REA seeks the fees improperly imposed on it by Koji. Although the fees sought by REA are relatively modest, an award will serve to deter future frivolous claims.

**II. FACTUAL BACKGROUND****A. Overview**

Koji filed three patent infringement actions against REA, each asserting that REA products infringe claims 1-4 of U.S. Patent No. 10,790,703 (“the ’703 patent”):

- *Koji IP, LLC v. Renesas Electronics America, Inc.*, Case No. 1:23-cv-01674-SKC (D. Cal.) (“First Action”), filed on June 30, 2023, and voluntarily dismissed on September 6, 2023.
- *Koji IP, LLC v. Renesas Electronics America, Inc.*, Case No. 3:23-cv-05752-LJC (N.D. Cal.) (“Second Action”), filed on November 8, 2023, and voluntarily dismissed on January 30, 2024.

- *Koji IP, LLC v. Renesas Electronics America, Inc.*, Case No. 3:24-cv-03089-PHK (N.D. Cal.) (“Third Action”), filed on May 22, 2024, and voluntarily dismissed on June 12, 2024.

The complaints in these actions are substantively identical and the Second and Third Actions are largely cut-and-paste versions of the First Action. REA has not been the only target: Koji has also asserted the ’703 patent against Energous Corp. (Case No. 4:23-cv-05750 (N.D. Cal.)), and GuRu Wireless, Inc. (Case No. 2:24-cv-03713 (C.D. Cal.)). The Energous case quickly settled, and the GuRu Wireless case is pending.

### **B. The Asserted Patent**

The ’703 patent (“Smart wireless power transfer between devices”) relates to a system consisting of a charging device (referred to as a “powering device”) that is configured to wirelessly charge another device (“powered device”). (*See* Ex. A (Abstract)).<sup>1</sup> The patent also states that the powering device may be powered by a battery (“battery power source”). (*Id.* at claim 1; *see also, e.g., id.*, 8:40-9:8; Fig. 5 (referring to battery 109).) The claims are directed to controlling wireless charging operations performed by a powering device based on how the charging operation affects the battery used to power the powering device. (*See, e.g., id.*, 40:62-41:8.) The patent differentiates between battery 109 of the powering device and battery 209 of the powered device. (*See, e.g., id.*, 9:10-16; 10:54-64; Fig. 6.) In other words, the ’703 patent is explicit about there being two separate batteries, one that supplies power to the powering device for charging and a second on the powered device that is charged. All four claims are system claims and Claim 1 is representative:

A wireless power transfer system for wirelessly charging a powered device, comprising:

- a battery power source for supplying power to the wireless power transfer system;
- wireless communication circuitry for establishment of a close-range wireless communication over which a message associated with the powered device is communicated from the powered device; and
- wireless powering circuitry including a transmitter configured to emit electromagnetic waves to form a radiative powering region within which the electromagnetic waves can be received by wireless powered circuitry of the powered device to generate power for charging a battery in the

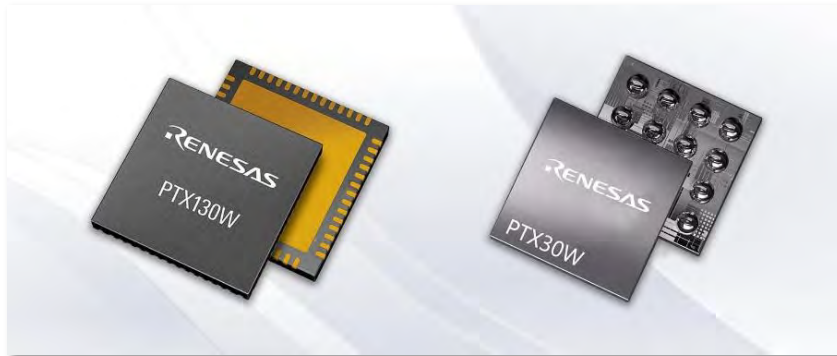
<sup>1</sup>All cited Exhibits are attached to the Declaration of Benjamin Charkow filed herewith.

powered device, the wireless powering circuitry being configured to be activated when the close-range wireless communication is established,

- wherein transmission power of the wireless communication circuitry is so controlled as to make a range of the close-range wireless communication substantially narrower than a range of the radiative powering region,
- wherein the message is issued by the powered device when a battery level of the battery is below a predetermined threshold, and the wireless powering circuitry is configured to be activated in response to receipt of the message from the powered device over the established close-range wireless communication, and
- wherein, when the wireless power transfer system is powered by the battery power source, a determination is made whether a level of drop in a battery level of the battery power source in a given time period is below a threshold, so that activation of the wireless powering circuitry is allowed only when the level of drop is determined to be below the threshold.

(*Id.* at claim 1.) Thus, the claims are directed to a “wireless power transfer system” containing at least a “battery power source” and “transmitter” that operates as a powering device for charging a battery of a “powered device,” with requirements on both the powering and powered sides of the system.

To support its contentions, Koji attached claim charts to the complaints, but those charts lack any reasonable substance and combine multiple products. For most limitations, the charts simply parrot the claim language without explaining *how* the alleged infringement occurs. (*See* Ex. B-2, Ex. H-2, D.I. 1-2.) All the accused REA products have been semiconductor devices or evaluation kits for semiconductor devices. The accused REA products are not wireless power transfer systems that include a “battery power source” or a “transmitter.” Rather, they are *components* that REA customers can use in systems they design and manufacture. For example, a representative image of the REA components accused in the Third Action is provided below:



1           **C.       The First Action**

2           The First Action was filed on June 30, 2023, in the District of Colorado. (*See* Ex. B.)  
3           The accused product was the P9222-R-EVK evaluation kit (“P9222-EVK”; *see* Ex. BB) and, as  
4           demonstrated in detail below, the infringement allegations were frivolous. At the outset, REA  
5           also told Koji that there were nominal U.S. sales of the accused product (approximately \$5,000).  
6           Thus, even putting aside the substantive challenges to Koji’s claims, there was no possibility of  
7           meaningful damages. (*See* Ex. C.)

8           The complaint alleged that venue was appropriate because a third-party sales  
9           representative of REA was located in Colorado. (*See* Exs. B, C.) However, because venue  
10          cannot be based on the location of a third party, REA informed Koji that the case had been filed  
11          in the wrong court. (*See id.*) But Koji steadfastly maintained that Colorado was proper (*See*  
12          Ex. D at 4), forcing REA to file a motion to dismiss for improper venue (and other shortcomings,  
13          including infringement and pleading deficiencies). (*See* Ex. F.) Although it had insisted that  
14          venue was proper, Koji responded to the motion by voluntarily dismissing the case rather than  
15          filing an opposition. (*See* Ex. G.) Thus, the cost of the motion (including a declaration from an  
16          REA employee regarding venue) was entirely avoidable and unnecessary. Importantly, the REA  
17          motion to dismiss plainly made Koji aware of some of the many critical deficiencies with its  
18          case, including inescapable conclusion that the accused REA products could not infringe the  
19          claims of the ’703 patent.

20          **D.       The Second Action**

21          Nevertheless, Koji filed the Second Action in this Court on November 8, 2023. (*See*  
22          Ex. H.) Although plainly already aware of many substantive shortcomings, the new complaint  
23          fixed nothing. Instead, it was a cut-and-paste of the original complaint — so much so that  
24          allegations about venue and personal jurisdiction being proper in Colorado remained. (*Id.*, ¶¶ 3-  
25          6.) On December 22, 2023, REA sent Koji a letter, again detailing numerous inadequacies,  
26          including non-infringement, but also multiple pleading failures. (*See* Ex. I.) Many of these  
27          issues were raised in the First Action. Koji never responded to that letter. Rather, it apparently  
28

1 scoured the REA website searching for other wireless charging products that it could accuse of  
2 infringement.

3 On January 3, 2024, Koji identified three new supposedly infringing products. (*See*  
4 Ex. J.) Predictably, the claims against these newly identified products were even more frivolous.  
5 On January 18, 2024, REA responded in writing, noting that the supposed infringement  
6 allegations were frivolous because, again, the accused products did not include, among others, a  
7 “battery power source” or a “transmitter.” (*See* Ex. N.) Moreover, as detailed below, *two of the*  
8 *newly accused REA products were clearly sold before the earliest priority date of the ’703*  
9 *patent, making them prior art. (Id.)*

10 On January 30, 2024, the day after REA sought to meet and confer regarding another  
11 motion to dismiss (*see* Ex. T), Koji voluntarily dismissed the Second Action (*see* Ex. U).  
12 Pursuant to the two dismissal rule (set forth in detail below), this second dismissal operated as an  
13 adjudication on the merits against Koji. *See* Fed. R. Civ. P. 41(a)(1)(B). Thus, the matter should  
14 have been concluded.

#### 15 **E. The Third Action**

16 Undeterred, Koji filed the Third Action on May 22, 2024 (D.I. 1). The new complaint  
17 abandoned the previously accused product in favor of one identified during the meet and confer  
18 for the Second Action. (However, the products that predate the ’703 patent were not accused in  
19 the Third Action, and Koji simply ignored that it had alleged that prior art products infringe.) As  
20 detailed below, Koji’s infringement allegations were again baseless.

21 Koji sent the complaint to REA but did *not serve* REA with any summons to appear in  
22 court. Along with the copy of the complaint, Koji included a letter offering to settle for \$59,000.  
23 (*See* Ex. V.) The letter stated that the proposed amount was not a “valuation” of the merits, but  
24 rather was based on a supposed shared desire to avoid litigation costs. The letter stated that the  
25 offer would be withdrawn if REA responded to the complaint. (*Id.*) In other words, Koji offered  
26 a settlement far below the cost of litigation even before it formally served the complaint.

27 On May 31, 2024, REA sent a letter to Koji explaining that the case had already been  
28 resolved by operation of the two dismissal rule, and (again) identifying substantive defects with



1 the case. (*See* Ex. W.) That letter plainly notified Koji that REA continued to be represented by  
2 the same counsel that had represented it in the first two actions. (*See id.*) Nevertheless, on  
3 June 7, 2024, Koji’s counsel, Mr. Ramey, sent an email directly to Mr. Makasi Yabe — in house  
4 counsel at Renesas Electronics Corporation (the parent company of REA) — seeking to settle the  
5 matter. (*See* Ex. X (“We are hopeful to discuss an early resolution with you”).) Contacting a  
6 party known to be represented is a violation of the rules of professional responsibility in  
7 California. *See* Cal. R. Prof. Conduct 4.2; *see also* N.D. Cal. Civil L.R. 11-4. Counsel for  
8 Renesas sent a letter flagging the issue and asking that future communications be directed to  
9 them. (*See* Ex. Y.)

10 Shortly thereafter, Koji dismissed its case for the third time (D.I. 12), this time explicitly  
11 with prejudice.

12 **F. Ramey LLP: Koji’s Counsel and Business Partner**

13 All three actions were filed by William P. Ramey, III and other lawyers at Ramey LLP.  
14 The Certificate of Interested Entities (D.I. 4) states that Ramey LLP also has an interest in the  
15 outcome of the litigation. Thus, as to the cases brought against REA, it appears that Ramey LLP  
16 is both counsel and client. According to the LexisNexis legal analytics platform Lex Machina,  
17 Mr. Ramey is counsel on approximately 195 active patent cases, and Ramey LLP consistently  
18 ranks among the most active plaintiff-side patent litigation firms in the United States. (*See*  
19 Ex. Z.) The overwhelming majority of cases filed by Ramey LLP appear to be quickly settled or  
20 dismissed: the median time to termination is 149 days. (*Id.* at 2.) Notwithstanding a docket of  
21 nearly 200 active patent infringement cases, the website for Ramey LLP identifies only six  
22 lawyers at the firm.

23 Clients of Ramey LLP have already been ordered to pay attorneys’ fees for similar  
24 actions in this District and others. *See EscapeX IP LLC v. Google LLC*, No. 22-cv-08711-VC,  
25 2023 WL 5257691 (N.D. Cal. Aug. 16, 2023). In awarding fees in the *EscapeX* case, Judge  
26 Chhabria stated: “This was, in short, an effort to force a modest settlement by pestering a tech  
27 giant with a frivolous suit on the assumption that the tech giant will prefer to capitulate than fight  
28 back.” *Id.* at \*2. Not only did the Court grant a motion to award fees under § 285, it also

1 pointedly stated that the “attorneys for EscapeX are lucky that Google did not separately ask the  
2 Court to impose sanctions on them.” *Id.* at \*1; *see also Ortiz & Assocs. Consulting, LLC v.*  
3 *VIZIO, Inc.*, No. 3:23-CV-00791-N, 2024 WL 815553, at \*2 (N.D. Tex. Feb. 27, 2024) (granting  
4 fees under § 285 and noting “history of filing and dismissing suits,” “making a settlement  
5 demand below the cost of defense” and “substantive weakness” of litigation position); *Verna IP*  
6 *Holdings, LLC v. Alert Media, Inc.*, No. 6:21-CV-00422-ADA, 2023 WL 5918320, at \*2 (W.D.  
7 Tex. Sept. 11, 2023) (finding litigation conduct “objectively unreasonable” after adverse  
8 *Markman* ruling).

### 9 III. LEGAL STANDARD

10 “The court in exceptional cases may award reasonable attorney fees to the prevailing  
11 party.” 35 U.S.C. § 285. An exceptional case is “one that stands out from others with respect to  
12 the substantive strength of a party’s litigating position (considering both the governing law and  
13 the facts of the case) or the unreasonable manner in which the case was litigated.” *Octane*  
14 *Fitness, LLC v. ICON Health & Fitness, Inc.*, 572 U.S. 545, 554 (2014). Courts consider “the  
15 totality of the circumstances” when deciding whether a case is “exceptional.” *Id.* In making the  
16 determination, courts consider factors such as frivolousness, motivation, objective  
17 unreasonableness and the need to advance considerations of deterrence. *Id.* at 554 n.6.

18 Filing an action for an improper purpose — such as attempting to leverage the cost of  
19 litigation into a quick settlement regardless of the merits — is relevant to the “exceptional case”  
20 inquiry. *See, e.g., SFA Sys., LLC v. Newegg Inc.*, 793 F.3d 1344, 1350 (Fed. Cir. 2015) (“[A]  
21 pattern of litigation abuses characterized by the repeated filing of patent infringement actions for  
22 the sole purpose of forcing settlements, with no intention of testing the merits of one’s claims, is  
23 relevant to a district court’s exceptional case determination under § 285.”); *see also Eon-Net LP*  
24 *v. Flagstar Bancorp*, 653 F.3d 1314, 1327 (Fed. Cir. 2011) (noting that settlement offers that  
25 were “less than ten percent of the cost that [a defendant] expended to defend suit — effectively  
26 ensured that [a plaintiff’s] baseless infringement allegations remain unexposed”); *see also*  
27 *Rothschild Connected Devices Innovations, LLC v. Guardian Prot. Servs.*, 858 F.3d 1383 (Fed.  
28

1 Cir. 2017) (reversing decision declining to award fees where court failed to consider patent  
2 holder’s nuisance value lawsuits against third parties).

3 Pre-suit diligence is a factor that may be considered in the totality-of-circumstances  
4 analysis of whether a case is exceptional. *See Bayer CropScience AG v. Dow AgroSciences LLC*,  
5 851 F.3d 1302, 1307 (Fed. Cir. 2017); *Lumen View Tech. LLC v. Findthebest.com, Inc.*, 811 F.3d  
6 479, 481–83 (Fed. Cir. 2016). At a minimum, any competent pre-suit investigation into  
7 infringement requires a party “interpret the asserted patent claims and compare the accused  
8 device with those claims before filing a claim alleging infringement.” *Q-Pharma, Inc. v. Andrew*  
9 *Jergens Co.*, 360 F.3d 1295, 1300-01 (Fed. Cir. 2004).

#### 10 **IV. ARGUMENT**

##### 11 **A. REA is the Prevailing Party**

12 A litigant is a prevailing party if (1) there is a change in the parties’ legal relationship  
13 (2) that has the necessary judicial imprimatur to be judicially sanctioned. *See Buckhannon Bd. &*  
14 *Care Home, Inc. v. W. Virginia Dep’t of Health & Human Res.*, 532 U.S. 598 (2001)). While a  
15 decision on the merits is not required, *see CRST Van Expedited, Inc. v. EEOC*, 578 U.S. 419,  
16 431-32 (2016), dismissal of a party’s infringement suit with prejudice is “tantamount to a  
17 decision on the merits” and is sufficient to establish an opposing party as prevailing. *Raniere v.*  
18 *Microsoft Corp.*, 887 F.3d 1298, 1307 (Fed. Cir. 2018); *see also Highway Equip. Co. v. FECO,*  
19 *Ltd.*, 469 F.3d 1027, 1035 (Fed. Cir. 2006) (a voluntary dismissal with prejudice “has the  
20 necessary judicial imprimatur to constitute a judicially sanctioned change in the legal  
21 relationship of the parties”).

22 REA is the prevailing party because Koji dismissed the instant action with prejudice (D.I.  
23 12). *See United Cannabis Corp. v. Pure Hemp Collective Inc.*, 66 F.4th 1362 (Fed. Cir. 2023);  
24 *Power Mosfet Techs., L.L.C. v. Siemens AG*, 378 F.3d 1396, 1416 (Fed. Cir. 2004) (“The  
25 dismissal of a claim with prejudice, however, is a judgment on the merits under the law of the  
26 Federal Circuit.”); *Viavi Sols. Inc. v. Platinum Optics Tech. Inc.*, No. 5:20-CV-05501-EJD, 2023  
27 WL 3236896 (N.D. Cal. May 2, 2023).

1 REA is also the prevailing party in the Second Action because Koji twice dismissed  
2 pursuant to Rule 41(a)(1)(A), and Rule 41(a)(1)(B) states: “if the plaintiff previously dismissed  
3 any federal- or state-court action based on or including the same claim, a notice of dismissal  
4 operates as an adjudication on the merits.” This provision is known as the “two dismissal rule.”  
5 *See e.g., Commercial Space Management Co., Inc. v. The Boeing Co., Inc.*, 193 F.3d 1074, 1076  
6 (9th Cir. 1999). The policy behind the two dismissal rule is to “eliminate the annoying of a  
7 defendant by being summoned into court in successive actions and then, if no settlement is  
8 arrived, requiring him to permit the action to be dismissed and another one commenced at  
9 leisure.” *Pickman v. Am. Express Co.*, No. C 11–05326 WHA, 2012 WL 258842, at \*3 (N.D.  
10 Cal. Jan. 27, 2012) (citation omitted). In other words, the rule was designed for precisely these  
11 circumstances.

12 The inquiry under Rule 41(a)(1)(B) is not whether the claims in the various complaints  
13 are exactly the same, but whether the lawsuits arise from the “same transactional nucleus of  
14 facts” such that the claims are “all grounds for recovery which could have been asserted, whether  
15 they were or not, in a prior suit between the same parties.” *Owens v. Kaiser Found. Health Plan,*  
16 *Inc.*, 244 F.3d 708, 714 (9th Cir. 2001) (quotation marks and citation omitted). “Thus, as long as  
17 a defendant was ‘twice voluntarily dismissed under Rule 41’ with respect to ‘substantially the  
18 same’ claims, then dismissal with prejudice is proper ‘under the two dismissal rule.’”  
19 *Ruegsegger v. Caliber Home Loans, Inc.*, No. SA CV 20-00531-DOC-KES, 2020 WL 2549934,  
20 at \*1 (C.D. Cal. May 19, 2020) (*quoting Melamed v. Blue Cross of Cal.*, 557 F. App’x 659, 661-  
21 62 (9th Cir. 2014)). As detailed above, each of the three cases Koji brought against REA involve  
22 the same allegation that REA products infringe claims 1-4 of the ’703 patent. Accordingly, the  
23 actions arise out of the “same transactional nucleus of facts.” *Owens*, 244 F.3d at 714. Thus, the  
24 two dismissal rule applies, and dismissal of the Second Action operated as an “adjudication on  
25 the merits.” Fed. R. Civ. P. 41(a)(1)(B).<sup>2</sup>

26  
27  
28 <sup>2</sup> Although the dismissal of the Second Action stated that it was without prejudice  
(Ex. U), that label is irrelevant. *See Commercial Space Management*, 193 F.3d at 1080 (“the  
label a plaintiff attaches to a second Rule 41(a)(1) dismissal is irrelevant if a subsequent action is

1 As a dismissal pursuant to Rule 41(a)(1)(A) deprives the court of jurisdiction upon its  
2 filing, the Ninth Circuit has held that whether a second dismissal is subject to the two dismissal  
3 rule is an issue that becomes ripe and can be determined *only in a third action*, if and when one  
4 is filed. *See Commercial Space Management*, 193 F.3d at 1076. Thus, it is appropriate for the  
5 Court to assess whether REA is a “prevailing party” in the Second Action in the Third Action.  
6 Indeed, under *Commercial Space Management*, there is no earlier time to do it.

7 Although the Federal Circuit has not squarely addressed the issue, several courts have  
8 held that an adjudication on the merits pursuant to the two dismissal rule makes a defendant the  
9 prevailing party for § 285 purposes. *See Realtime Adaptive Streaming LLC v. Netflix, Inc.*, No.  
10 CV 19-6361-GW-JCx, 2020 WL 8024356, at \*3 (C.D. Cal. Nov. 23, 2020), *aff’d*, 41 F.4th 1372  
11 (Fed. Cir. 2022)<sup>3</sup>; *Uniloc USA, Inc. v. Blackberry Corp.*, No. 3:18-CV-1883-N, 2021 WL  
12 12104812 (N.D. Tex. July 1, 2021); *but see First Time Videos, LLC v. Oppold*, No: 6:12-cv-  
13 1493-Orl-36KRS, 2013 WL 12094410, at \*5 (M.D. Fla. Sept. 16, 2013), *aff’d*, 559 F. App’x 931  
14 (11th Cir. 2014).

15 An adjudication on the merits pursuant to the two dismissal rule plainly changes the  
16 parties’ legal relationship. And Rule 41 itself requires the conclusion that such a dismissal  
17 carries a sufficient judicial imprimatur for a defendant to be awarded prevailing party status (*i.e.*,  
18 the lawsuit has ended with an adjudication on the merits). *See Realtime Adaptive Streaming*,  
19 2020 WL 8024356, at \*3-5; *cf. Highway Equip.*, 469 F.3d at 1035 (voluntary dismissal with  
20  
21  
22

23 filed ‘based on or including the same claim,’ because Rule 41(a)(1) itself instructs that such a  
24 dismissal ‘operates as an adjudication upon the merits.’”) (quoting Fed. R. Civ. P. 41(a)(1)).

25 <sup>3</sup> On appeal, the Federal Circuit sidestepped the issue. *See Realtime Adaptive Streaming*  
26 *LLC v. Netflix, Inc.*, 41 F.4th 1372, 1375 n.2 (“On appeal, Realtime challenges whether its two  
27 voluntary dismissals rendered Netflix a prevailing party. But we need not resolve that question  
28 here.”). However, Judge Reyna issued a separate opinion stating: “I dissent in part because I  
also believe that the district court did not err in determining that two voluntary dismissals  
without prejudice is sufficient to confer prevailing party status under 35 U.S.C. § 285.” *Id.* at  
1381 (Reyna, J., concurring-in-part and dissenting-in-part).

1 prejudice under Rule 41(a)(2) carries necessary judicial imprimatur to award prevailing party  
2 status).<sup>4</sup>

3 Common sense undermines the notion that a defendant cannot “prevail”  
4 unless the relevant disposition is on the merits. Plaintiffs and defendants  
5 come to court with different objectives. A plaintiff seeks a material  
6 alteration in the legal relationship between the parties. A defendant seeks  
7 to prevent this alteration to the extent it is in the plaintiff’s favor. The  
8 defendant, of course, might prefer a judgment vindicating its position  
9 regarding the substantive merits of the plaintiff’s allegations. The  
10 defendant has, however, fulfilled its primary objective whenever the  
11 plaintiff’s challenge is rebuffed, irrespective of the precise reason for the  
12 court’s decision.

13 *CRST*, 578 U.S. at 431. REA met its objective and Koji’s challenge was “rebuffed” when the  
14 dismissal was filed, such dismissal operating as an adjudication on the merits and precluding  
15 Koji from bringing the claim again. REA is thus the prevailing party in both the Second and  
16 Third Actions.

#### 17 **B. These Cases are Exceptional**

18 Koji’s cases against REA are “exceptional” because of the frivolous nature of the  
19 infringement claims and the re-filing of the same claims even after there was an adjudication on  
20 the merits. Moreover, these cases were filed for an improper purpose, to leverage the cost of  
21 litigation to obtain a quick settlement without regard to the merits of the action. Koji also  
22 accused prior art products, rendering the asserted patent invalid and Mr. Ramey improperly  
23 contacted Renesas in-house counsel to settle the case despite knowing that Renesas was  
24 represented. Koji and its counsel also had express written notice: REA repeatedly identified the  
25 many deficiencies of Koji’s cases and stated that it might seek its fees under § 285. But Koji  
26 continued filing and pursuing frivolous claims. Considering the totality of the circumstances, the  
27 Second and Third Actions are “exceptional.”

#### 28 **1. Koji’s Infringement Allegations Were Frivolous**

As set forth above, Claim 1 (and each claim of the patent) requires a “battery power  
source” and a “transmitter” on the powering side, among other limitations. Thus, to show

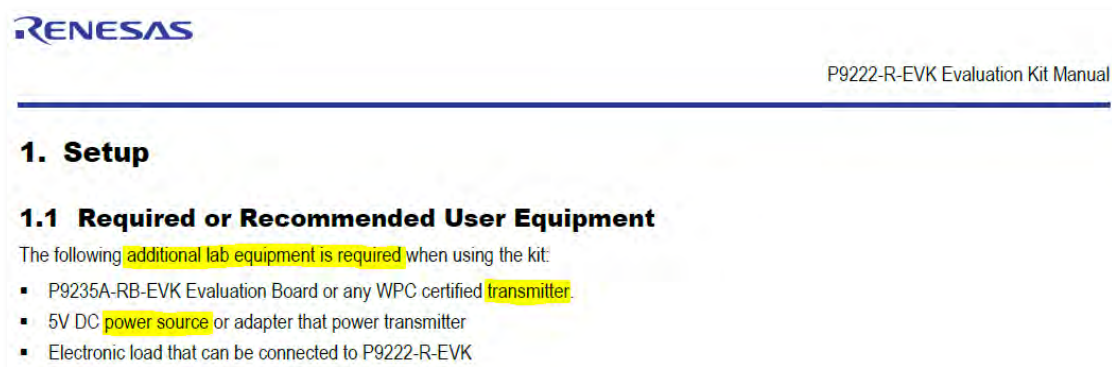
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<sup>4</sup> The Rules themselves reflect the judicial imprimatur of the U.S. Supreme Court. *See* 28 U.S.C. § 2072; *see also Bright v. United States*, 603 F.3d 1273 (Fed. Cir. 2010) (the Federal Rules of Civil Procedure are deemed to have the force and effect of a federal statute).



1 infringement of any claim, Koji would need to demonstrate that a single REA product satisfied  
 2 both limitations (as well as the other limitations in the claims). As detailed above as to the  
 3 Second Action, REA put Koji on notice via the motion to dismiss in the First Action that the  
 4 P9222-EVK lacked at least a “battery power source” and a “transmitter.” (*See* Ex. F at 9.)  
 5 Nevertheless, Koji filed the Second Action with the same infringement allegations.

6 The P9222-EVK Manual — relied upon by Koji as the basis for its infringement claims  
 7 — demonstrates that the P9222-EVK contains neither a “battery power source” nor a  
 8 “transmitter.” It states that “additional lab equipment is required when using the kit,” including a  
 9 “power source” and a “WPC certified transmitter”:



17 (*See* Ex. AA at 5 (highlighting added).) Thus, the document *cited by Koji* demonstrates that the  
 18 P9222-EVK does not infringe. Moreover, the power supply that would be used with this type of  
 19 evaluation kit would be a bench power supply, a common piece of laboratory equipment that  
 20 obtains power from an outlet. That is not a *battery* power source, as required by the claims.  
 21 Predictably, Koji abandoned its assertion that the P9222 product infringed in the Third Action,  
 22 highlighting the frivolousness of that claim.

23 The Third Action purported to accuse “Renesas Electronics’s PTX130W/PTX30W.” *See*  
 24 (D.I. 1-2 (claim chart).) However, these are two separate products (*see* Exs. BB, CC) and Koji  
 25 also cited to the PTX130W-30W-EVK evaluation kit, a third product. Koji also cites a  
 26 document entitled “PTX130W/PTX30W Hardware Integration” (“Integration Manual”) which  
 27 sets forth guidelines regarding how an REA customer might integrate those REA components  
 28 into a customer product. (*See* D.I. 1-2; Ex. DD (Integration Manual).) Although the claim chart



1 suggests otherwise, the Integration Manual does not describe an actual product. Rather, it shows  
2 an *exemplary application* that could include REA components and describes how they might be  
3 integrated. Thus, the “accused product” is not product at all. Rather, it is an amalgam of three  
4 separate products and an example from a guidance document.

5 Under the “all elements” rule, an accused device must contain each limitation of the  
6 claim, either literally or by an equivalent, to be infringing. *See, e.g., TIP Sys., LLC v. Phillips &*  
7 *Brooks/Gladwin, Inc.*, 529 F.3d 1364, 1379 (Fed. Cir. 2008) (*quoting Freedman Seating Co. v.*  
8 *Am. Seating Co.*, 420 F.3d 1350, 1358 (Fed. Cir. 2005)). Accordingly, Koji’s attempt to  
9 combine different products is improper. *See, e.g., Geovector Corp. v. Samsung Elecs. Co. Ltd.*,  
10 No. 16-CV-02463-WHO, 2017 WL 76950, at \*4 (N.D. Cal. Jan. 9, 2017) (“This hodgepodge of  
11 different attributes from various different accused products and third-party sources is insufficient  
12 to chart a single product against all elements of Claim 1.”); *Cap Co., Ltd. v. McAfee, Inc.*, No.  
13 14-CV-05068-JD, 2015 WL 4734951, at \*2 (N.D. Cal. Aug. 10, 2015) (“Infringement cannot be  
14 shown by a muddled hash of elements from different products...”).<sup>5</sup>

15 Even putting aside the improper combining of multiple products, Koji’s infringement  
16 allegations are baseless. For example, Fig. 1 of the REA Integration Manual depicts a block  
17 diagram of an exemplary application, with the two accused REA components indicated by gray  
18 shading.

19  
20  
21  
22  
23 <sup>5</sup> Improperly cobbling together features from separate products appears to be something  
24 of a specialty of Ramey LLP. *See, e.g., Vilox Techs., LLC v. Salesforce, Inc.*, No. 23-CV-05047-  
25 AMO, 2024 WL 2807924, at \*2 (N.D. Cal. May 31, 2024) (“Vilox’s cobbling together of  
26 different screenshots, features, and products falls short.”); *CTD Networks LLC v. Microsoft*  
27 *Corp.*, No. W-22-CV-01049-XR, 2023 WL 5417141, at \*6 (W.D. Tex. Aug. 22, 2023) (“As the  
28 Court has repeatedly reminded Plaintiff, it cannot mix and match across products in this  
fashion.”); *EscapeX*, 2023 WL 5257691, at \*1 (“EscapeX’s initial and first amended complaints  
cobbed together features from two different YouTube products to allege infringement of its  
purported patent.”). All these cases involved parties represented by Ramey LLP.  
Notwithstanding these admonitions, Ramey LLP lawyers continue to improperly combine  
features from multiple products.

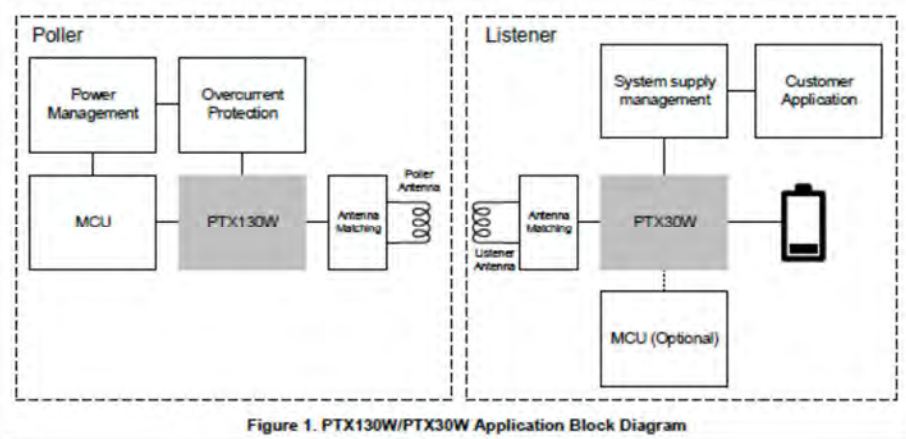


Figure 1. PTX130W/PTX30W Application Block Diagram

(Ex. EE at 3.) Notably, the battery and transmitter (*i.e.*, poller antenna) are *not* included in either of the REA components, nor are the microcontroller or other power management components.

As to “battery power source,” Koji’s claim chart points to the PTX30W, which is on the “listener” (*i.e.*, powered device) side of the system. (*See* D.I. 1-2 at 5.) As indicated above, the ’703 patent is clear that the alleged invention is directed to systems with two batteries, one that supplies power to the powering device for performing wireless charging and a second on the powered device that is charged via the powering device. However, Koji alleged infringement of the battery power source of the powering device based only on a battery of a “powered device” being charged, not a battery of a “powering device” providing the charging. Koji’s assertion is completely nonsensical in that the battery that is being charged cannot also be the battery that is supplying the power to perform the charging. Additionally, for the last two “wherein” clauses, the Koji claim chart identifies the “power management” component in Figure 1. (*See id.* at 10-11.) As indicated above, that component is not part of the PTX130W, and such a component (and its manner of operation) would be selected by an REA customer for that customer’s application.

For these reasons, the infringement claims in the Second and Third Actions are baseless. It is particularly frivolous to cobble together multiple products and a guidance document and yet still have multiple missing limitations and infringement allegations based on a physical impossibility (*i.e.*, a battery that recharges itself). *See, e.g., Taurus IP, LLC v. DaimlerChrysler Corp.*, 726 F.3d 1306, 1327 (Fed. Cir. 2013) (an objectively baseless or frivolous patent case is

one “that no reasonable litigant could reasonably expect success on the merits.”); *Stephens v. Tech Int’l, Inc.*, 393 F.3d 1269, 1273–74 (Fed. Cir. 2004) (“A frivolous infringement suit is one which the patentee knew or, on reasonable investigation, should have known was baseless.”) (quotation marks and citation omitted). Moreover, it is appropriate for the Court to consider “the need to deter similarly weak arguments in the future.” *Inventor Holdings, LLC v. Bed Bath & Beyond, Inc.*, 876 F.3d 1372, 1377–78 (Fed. Cir. 2017); *see also Blackbird Tech LLC v. Health In Motion LLC*, 944 F.3d 910, 917 (Fed. Cir. 2019).

## 2. Koji’s Actions Against REA Were Filed for an Improper Purpose

It is improper to leverage the high cost of patent litigation to obtain a quick nominal settlement notwithstanding the absence of meritorious claims. *See, e.g., SFA Sys.*, 793 F.3d at 1350. As detailed above, Koji’s infringement allegations have changed but have nevertheless consistently been frivolous. Koji also promptly sought nominal settlements based not on the strength of the infringement case or information regarding sales of the accused products, but on litigation costs. Additionally, Koji refused to engage on the substance of the case and strategically avoided motion practice that would have tested its claims. Even after REA identified the incurable defects in its case, Koji continued to file additional lawsuits, none of which addressed the previously identified defects.<sup>6</sup> In short, this case has all the hallmarks of a case filed for an improper purpose, namely, to leverage the high cost of litigation to obtain a settlement regardless of the merits. In addition to the baselessness of the infringement claims addressed above, the following are additional aspects of the totality of the circumstances that demonstrate that these actions were filed for an improper purpose.

***Quick Settlement Offers Below the Cost of Defense:*** Koji made settlement offers far below the cost of defense, including as low as \$5,000. (*See Ex. M.*) Even before serving the

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<sup>6</sup> During the Second Action, REA sent a detailed letter setting forth the many pleading inadequacies of the Koji complaint (*e.g.*, insufficient detail to allege infringement under *Iqbal/Twombly*, and failure to properly plead inducement and contributory infringement, including pleading knowledge of the patent, knowledge of infringement, and no substantial non-infringing use). (*See Ex. I.*) The letter included comprehensive citations to cases from the Federal Circuit and this District. (*Id.*) Koji dismissed its case rather than have the complaint tested via a motion to dismiss. Nevertheless, Koji filed a substantively identical complaint in the Third Action.

1 complaint in the Third Action, Koji proposed a \$59,000 settlement. (*See* Ex. V.) The amounts  
2 demanded are a tiny fraction of the cost of defense in a typical patent case and indicate that Koji  
3 sought to leverage the cost of litigation to quickly obtain a nominal settlement. *See, e.g.,*  
4 *Blackbird Tech*, 944 F.3d at 910 (no abuse of discretion in awarding § 285 fees where plaintiff  
5 make multiple settlement demands that were far less than anticipated cost of defense) (*citing*  
6 *Eon-Net*, 653 F.3d at 1327 (affirming district court determination that plaintiff “acted in bad faith  
7 by exploiting the high cost to defend complex litigation to extract a nuisance value settlement”)).

8 ***Accusing Prior Art Products:*** In its effort to find additional products to accuse to  
9 salvage the Second Action, Koji accused REA prior art products of infringement. (*See* Ex. J.)  
10 The earliest Koji application was filed in December 2016 (Ex. A at 1, (60)), but the allegedly  
11 infringing products have datasheets dated May 2016 (RX111) and July 2014 (ISL1801). (*See*  
12 Ex. N.) It is well-established that a product “which would literally infringe if later in time  
13 anticipates if earlier.” *See, e.g., Schering Corp. v. Geneva Pharms., Inc.*, 339 F.3d 1373, 1379  
14 (Fed. Cir. 2003) (*quoting Bristol–Myers Squibb Co. v. Ben Venue Labs., Inc.*, 246 F.3d 1368,  
15 1378 (Fed. Cir. 2001).) Koji has never explained how the claims of the ’703 patent can be valid  
16 when two allegedly infringing products predate the earliest potential priority date. At a  
17 minimum, accusing the prior art indicates that Koji’s due diligence was essentially non-existent.  
18 *See also EscapeX*, 2023 WL 5257691, at \*1 (“[a] basic online search would have revealed that  
19 the accused ‘Auto Add’ feature predated EscapeX’s patent.”).

20 ***Avoidance of the Merits:*** Koji dismissed the First Action rather than oppose REA’s  
21 motion to dismiss (*see supra*) and dismissed the Second Action when REA proposed meeting  
22 and conferring on an REA motion to dismiss in that Action (*see* Exs. T, U). Koji did not respond  
23 to multiple substantive letters. The strategic avoidance of any exercise testing the merits of  
24 patent infringement claims is a relevant § 285 factor. *See SFA Sys.*, 793 F.3d at 1350 (“[A]  
25 pattern of litigation abuses characterized by the repeated filing of patent infringement actions for  
26 the sole purpose of forcing settlements, with no intention of testing the merits of one’s claims, is  
27 relevant to a district court’s exceptional case determination under § 285.”); *Shipping & Transit,*  
28 *LLC v. Hall Enterprises, Inc.*, No. CV 16–06535–AG–AFM, 2017 WL 3485782, at \*8 (C.D. Cal.

1 July 5, 2017) (“[t]hese tactics present a compelling need for deterrence and to discourage  
2 exploitative litigation by patentees who have no intention of testing the merits of their claims.”).

3 **Prior Notice of Frivolousness:** REA repeatedly informed Koji that its claims were  
4 baseless and that it might seek fees under § 285 if the action was not promptly dismissed. *See*  
5 Exs. C, E, I (“[p]lease be advised that if this matter moves forward, Renesas will seek to have  
6 this case declared “exceptional” under § 285 and it will seek its fees), L, N (“please be again  
7 advised that if this matter moves forward, Renesas will seek to have this case declared  
8 “exceptional” under § 285 and it will seek its fees.”), R, W (“[p]lease be again advised that if this  
9 matter moves forward, Renesas will seek to have this case declared “exceptional” under § 285  
10 and it will seek its fees.”). Notice of a frivolous position is relevant to the exceptional case  
11 analysis. *See generally Thermolife Int’l LLC v. GNC Corp.*, 922 F.3d 1347, 1357 (Fed. Cir.  
12 2019) (“Recently, we have stressed that one consideration that can and often should be important  
13 to an exceptional-case determination is whether the party seeking fees ‘provide[d] early, focused,  
14 and supported notice of its belief that it was being subjected to exceptional litigation behavior.”)  
15 (citation omitted); *Nat’l Oilwell Varco, L.P. v. Omron Oilfield & Marine, Inc.*, 676 Fed. Appx.  
16 967, 973 (Fed. Cir. 2017) (affirming award of fees where party was “on notice” of potentially  
17 frivolous position based on information provided by opposing party yet took no remedial action);  
18 *EscapeX*, 2023 WL 5257691, at \*1 (“Google placed EscapeX on notice of the baselessness of its  
19 claims early and often, urging it to dismiss the case.”). In these cases, REA repeatedly put Koji  
20 on notice via: (1) a motion to dismiss, (2) multiple letters, and (3) multiple emails. Yet not only  
21 did it do nothing to remedy its position, Koji filed more cases against REA.

### 22 3. Filing an Action That Was Barred by Preclusion

23 As set forth above, the Third Action was barred under the two dismissal rule because the  
24 dismissal of the Second Action operated as an adjudication on the merits. The Ninth Circuit has  
25 held — in the Rule 11 context — that asserting claims barred by *res judicata* is baseless. *See,*  
26 *e.g., Buster v. Greisen*, 104 F.3d 1186, 1190 (9th Cir. 1997); *Estate of Blue v. Cnty. of Los*  
27 *Angeles*, 120 F.3d 982, 985 (9th Cir. 1997); *see also Richter v. Oracle Am., Inc.*, No. 22-CV-  
28 04795-BLF, 2023 WL 8586690, at \*4 (N.D. Cal. Dec. 8, 2023) (“The Ninth Circuit has

1 recognized that cases are frivolous when they are filed despite being barred by preclusion, and a  
2 reasonable and competent inquiry would have led to this conclusion.”). In the context of § 285,  
3 the result should be the same as it is “exceptional” to file an action that is precluded where a  
4 reasonable inquiry would have revealed that preclusion. Moreover, the filing of a precluded case  
5 indicates that any pre-suit investigation was wildly inadequate.

#### 6 **4. Improperly Contacting a Represented Party**

7 REA’s counsel sent a detailed letter regarding the Third Action on May 31, 2024 (Ex. W)  
8 but on June 7, 2024, Koji’s counsel sent an email to Renesas in-house counsel seeking to settle  
9 the case (Ex. X). As set forth above, this was a violation of the California rules of professional  
10 contact, which can be considered under § 285. *See, e.g., Rambus Inc. v. Infineon Techs. AG*,  
11 318 F.3d 1081, 1106 (Fed. Cir. 2003) (litigation misconduct and unprofessional behavior  
12 relevant to § 285 analysis).

#### 13 **C. Bases for Sanctions Against Koji’s Counsel**

14 When an attorney unreasonably or vexatiously multiplies the proceedings, courts may  
15 require the attorney to personally satisfy “the excess costs, expenses, and attorneys’ fees  
16 reasonably incurred because of such conduct.” 28 U.S.C. § 1927. To impose sanctions under  
17 § 1927, a court must find that the attorney’s conduct was at least reckless. *See Fink v. Gomez*,  
18 239 F.3d 989, 993 (9th Cir. 2001). For the reasons set forth above, Ramey LLP’s actions were at  
19 least reckless. At a minimum, just pursuing baseless infringement claims and filing the Third  
20 Action despite the two dismissal rule operating as an adjudication on the merits was “reckless.”

21 Courts also have the inherent power to levy sanctions, including attorneys’ fees, when a  
22 party has acted in bad faith, vexatiously, wantonly, or for oppressive reasons. *See, e.g., id.* at  
23 991. Under the court’s inherent power, sanctions are only available “if the court specifically  
24 finds bad faith or conduct tantamount to bad faith.” *Id.* at 994. “[M]ere recklessness, without  
25 more, does not justify sanctions under a court’s inherent power[,]” but “recklessness when  
26 combined with an additional factor such as frivolousness, harassment, or an improper purpose”  
27 can be sufficient. *Id.* at 993-94. For the reasons set forth above, including the prior sanction by  
28



1 Judge Chabbria on similar grounds, the filing and re-filing of these cases is conduct tantamount  
2 to bad faith.

3 Indeed, REA submits that it is essentially impossible for a small law firm (six lawyers are  
4 noted on the website) to properly and ethically litigate nearly 200 patent infringement cases  
5 simultaneously, let alone conduct adequate pre-filing investigations to file multiple new actions  
6 virtually every week. (For example, on the *day* Ramey LLP filed the Third Action (May 22,  
7 2024), it also filed four other patent infringement actions. (See Ex. Z at 3-4.)) The inevitable  
8 result of a small law firm adopting a high-volume patent infringement business model is the  
9 filing of lawsuits with minimal pre-suit investigation, as appears to have occurred here. For the  
10 cases that do not immediately settle, a series of missed deadlines and inattention to basic  
11 litigation obligations surely follows.<sup>7</sup> Tasks are foisted on the defendant (and the court),  
12 imposing costs on them. But to Ramey LLP, this appears to be a feature not a bug, since the  
13 entire point is to leverage the cost of litigation into settlements notwithstanding the absence of  
14 meritorious claims.

15 These same Ramey LLP lawyers have also been reprimanded in no uncertain terms for  
16 similar behavior in this District. See *EscapeX*, 2023 WL 5257691, at \*1 (“It is obvious that  
17 EscapeX conducted no serious pre-suit investigation and that this case was frivolous from the  
18

19 <sup>7</sup> Infrequent minor oversights are part of litigation and are generally accommodated as a  
20 matter of professional courtesy. But in these cases, they appear to indicate a deliberate decision  
21 by Koji’s counsel to avoid spending time on basic litigation tasks and imposing unnecessary  
22 costs on REA. As examples, REA pointed out that the complaint in Second Action contained  
23 personal jurisdiction and venue allegations for Colorado, surely the result of sloppy cutting-and-  
24 pasting. (See Ex. I.) Koji promised to file an amended complaint, but REA had to repeatedly  
25 prod Koji’s counsel to file it, as otherwise REA would have had to file a motion to dismiss on an  
26 issue that it had assured would be corrected. (See Exs. L, M.) Although counsel for REA had  
27 not yet appeared, Koji did not serve the Amended Complaint, creating issues regarding the due  
28 date for an REA motion to dismiss. Koji’s counsel also failed to reach out regarding the Rule 26  
statement, so REA did (Ex. P), only to receive a sloppily revised statement recycled from another  
case. (See Ex. S.) For a case that had less than a dozen docket entries before it was dismissed,  
this amounts to Koji’s counsel essentially doing no work in a case that it initiated. Rather, it  
foisted tasks onto REA, which took deadlines and litigation obligations seriously. Cf. *Ortiz &  
Assocs.*, 2024 WL 815553, at \*1 (noting failure to “comply with the Court’s discovery deadlines,  
including deadlines to serve infringement contentions and discovery requests”). For a small firm  
supposedly litigating approximately 200 patent cases (and constantly filing more), slipshod work  
is assured, making the actions in these cases at least reckless and, REA submits, tantamount to  
bad faith.



1 start.”). The *EscapeX* decision was issued before the Ramey LLP lawyers filed both the Second  
2 and Third Actions, yet it appears to have had little deterrent effect.

3 For these reasons, sanctions under § 1927 and the court’s inherent powers against Koji’s  
4 counsel of record are also appropriate.

#### 5 **V. AMOUNT OF FEES**

6 To calculate an award of attorneys’ fees, district courts apply “the lodestar method,  
7 multiplying the number of hours reasonably expended by a reasonable hourly rate.” *Ryan v.*  
8 *Editions Ltd. W., Inc.*, 786 F.3d 754, 763 (9th Cir. 2015). “A reasonable hourly rate is ordinarily  
9 the prevailing market rate in the relevant community.” *Kelly v. Wengler*, 822 F.3d 1085, 1099  
10 (9th Cir. 2016) (quotation marks and citation omitted). “[T]he burden is on the fee applicant to  
11 produce satisfactory evidence – in addition to the attorney’s own affidavits – that the requested  
12 rates are in line with those prevailing in the community for similar services by lawyers of  
13 reasonably comparable skill, experience and reputation.” *Camacho v. Bridgeport Fin., Inc.*,  
14 523 F.3d 973, 980 (9th Cir. 2008) (quotation marks and citation omitted). The party requesting  
15 fees also bears “the burden of submitting billing records to establish that the number of hours”  
16 requested are reasonable. *Gonzalez v. City of Maywood*, 729 F.3d 1196, 1202 (9th Cir. 2013).  
17 The number of hours should not exceed the number of hours that reasonable competent counsel  
18 would bill for similar services. *See Hensley v. Eckerhart*, 461 U.S. 424, 434 (1983).

19 As set forth in the Declaration of Jason A. Crotty filed herewith, the total fees sought  
20 (that have been invoiced to date) are \$37,503.50. REA’s counsel’s rates are below those  
21 frequently approved in this district and the number of hours expended and the overall amount  
22 sought are exceptionally reasonable given Koji’s ever-changing infringement claims,  
23 communications and correspondence with Koji’s counsel, and analysis of the issues. REA is  
24 also entitled to fees that have not yet been invoiced to REA and for the fees associated with this  
25 motion. Having prevailed on the merits in the Second and Third Actions, REA seeks fees only  
26 for the Second and Third Actions, but not the First Action.

1 **VI. CONCLUSION**

2 For the reasons set forth above, the Court should find that REA is the “prevailing party”  
3 in both the Second and Third Actions and that Koji’s and its counsel’s litigation tactics and  
4 conduct make those cases “exceptional.” Upon such a finding, the Court should order that Koji  
5 and its counsel be jointly and severally liable for REA’s attorneys’ fees in those actions.

6  
7 Dated: June 26, 2024

Respectfully submitted,

8 MACHOFF BRENNAN

9 By: /s/ Jason A. Crotty  
10 Jason A. Crotty  
Benjamin Charkow

11 *Attorneys for Defendant*  
12 RENESAS ELECTRONICS AMERICA INC.  
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**From:** [William Ramey](#)  
**To:** [Jason Crotty](#); [Susan Kalra](#)  
**Cc:** [Benjamin Charkow](#)  
**Subject:** Rule 408 Discussion; Koji IP, LLC v. Renesas Electronics America, Inc. (N.D. Cal.) -- correspondence  
**Date:** Friday, January 12, 2024 1:41:38 PM

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Given the low sales volume, my client has agreed to accept \$5k in resolution of the case.

While we think there may be other products, we extend this offer in good faith on what you have told us.

Bill

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**From:** Jason Crotty <JCrotty@mabr.com>  
**Sent:** Friday, January 12, 2024 3:31 PM  
**To:** William Ramey <wramey@rameyfirm.com>; Susan Kalra <skalra@rameyfirm.com>; LitigationParalegals <LitParalegals@rameyfirm.com>  
**Cc:** Benjamin Charkow <BCharkow@mabr.com>  
**Subject:** RE: Koji IP, LLC v. Renesas Electronics America, Inc. (N.D. Cal.) -- correspondence

Bill:

Given the absence of merit to the existing claims (and the proposed new accused products as well), the Renesas counter-offer is voluntary dismissal by Koji IP and Renesas will not seek its fees and costs. Although we will, of course, discuss all of Koji's future settlement offers with Renesas, I do not foresee a change in their position.

Thank you for the information regarding the amended complaint and have a good weekend.

Jason A. Crotty  
Maschoff Brennan  
450 Sansome St., Ste. 1005  
San Francisco CA 94111  
(415) 969-6918

---

**From:** William Ramey <wramey@rameyfirm.com>  
**Sent:** Friday, January 12, 2024 1:25 PM  
**To:** Jason Crotty <JCrotty@mabr.com>; Susan Kalra <skalra@rameyfirm.com>; LitigationParalegals <LitParalegals@rameyfirm.com>  
**Cc:** Benjamin Charkow <BCharkow@mabr.com>  
**Subject:** RE: Koji IP, LLC v. Renesas Electronics America, Inc. (N.D. Cal.) -- correspondence

Hi Jason,

Did your client have a counter-offer?

Our initial offer was very low. Let me know if we can close the case.

Bill

---

**From:** Jason Crotty <[JCrotty@mabr.com](mailto:JCrotty@mabr.com)>

**Sent:** Friday, January 12, 2024 3:22 PM

**To:** William Ramey <[wramey@rameyfirm.com](mailto:wramey@rameyfirm.com)>; Susan Kalra <[skalra@rameyfirm.com](mailto:skalra@rameyfirm.com)>;  
LitigationParalegals <[LitParalegals@rameyfirm.com](mailto:LitParalegals@rameyfirm.com)>

**Cc:** Benjamin Charkow <[BCharkow@mabr.com](mailto:BCharkow@mabr.com)>

**Subject:** RE: Koji IP, LLC v. Renesas Electronics America, Inc. (N.D. Cal.) -- correspondence

Bill:

At last check, it does not appear that Koji IP has filed the amended complaint it previously stated it would file. If an amended complaint is not filed promptly, Renesas will have to move to dismiss the current complaint on grounds that include the obvious cut-and-paste errors regarding venue and personal jurisdiction. Please let us know ASAP whether Koji IP intends to file the amended complaint and on what date.

Thank you for your prompt attention to this time-sensitive matter.

Jason A. Crotty  
Maschoff Brennan  
450 Sansome St., Ste. 1005  
San Francisco CA 94111  
(415) 969-6918

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**From:** Jason Crotty <[JCrotty@mabr.com](mailto:JCrotty@mabr.com)>

**Sent:** Wednesday, January 10, 2024 6:00 PM

**To:** William Ramey <[wramey@rameyfirm.com](mailto:wramey@rameyfirm.com)>; Susan Kalra <[skalra@rameyfirm.com](mailto:skalra@rameyfirm.com)>;  
LitigationParalegals <[LitParalegals@rameyfirm.com](mailto:LitParalegals@rameyfirm.com)>

**Cc:** Benjamin Charkow <[BCharkow@mabr.com](mailto:BCharkow@mabr.com)>

**Subject:** RE: Koji IP, LLC v. Renesas Electronics America, Inc. (N.D. Cal.) -- correspondence

Bill:

Just confirming that Koji IP will be filing an amended complaint tomorrow. I believe you are within the time period to amend as of right, so I do not believe you need a stipulation, but if your understanding is different, please let me know.

Jason A. Crotty

ADD0266





(415) 969-6918

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**From:** William Ramey <[wramey@rameyfirm.com](mailto:wramey@rameyfirm.com)>  
**Sent:** Wednesday, January 3, 2024 7:59 AM  
**To:** Jason Crotty <[lcrotty@mkwllp.com](mailto:lcrotty@mkwllp.com)>; Susan Kalra <[skalra@rameyfirm.com](mailto:skalra@rameyfirm.com)>  
**Cc:** Benjamin Charkow <[bcharkow@mkwllp.com](mailto:bcharkow@mkwllp.com)>; LitigationParalegals <[LitParalegals@rameyfirm.com](mailto:LitParalegals@rameyfirm.com)>  
**Subject:** RE: Koji IP, LLC v. Renesas Electronics America, Inc. (N.D. Cal.) -- correspondence

Hi Jason,

Here is a response that should clear the issues:

**[1.1] Defendant contends:**

Putting aside the remainder of the claims — much of which does not appear to be performed by the accused product — Claim 1 (and all the claims of the asserted patent) require at least a “battery power source” and “wireless powering circuitry including a transmitter.”

Thus, as set forth in the motion to dismiss in the Colorado case, to infringe Claim 1 (or any other claim), Koji IP would need to demonstrate that the accused product had both a “battery power source” and a “transmitter.” The accused product is the Renesas P9222-R- EVK Evaluation Kit, a product that allows customers and potential customers of Renesas to evaluate the features and functionality of a Renesas wireless power receiver product.

However, the P9222-R-EVK Evaluation Kit Manual relied upon by Koji IP demonstrates that neither of these components is in the accused product. Specifically, the P9222-R-EVK Manual states that “additional lab equipment is required when using the kit,” including a power supply (i.e., a battery power source) and a transmitter:

As shown above, **the accused product does not include either a “battery power supply” or a “transmitter.”** Koji IP’s claim chart alleges that the P9222-R-EVK Manual “describes” a “battery power source” but does not allege that it is actually contained in the P9222-R-EVK Evaluation Kit, because it cannot plausibly be alleged. The same is true of the “transmitter.”

**[1.1] Plaintiff contends:**

It is clear that the infringing Renesas product is "Renesas Electronics's EVK Evaluation Kit", not P9222-R-EVK alone as Renesas Electronics America contends. In fact, "Renesas Electronics's EVK Evaluation Kit" includes both Renesas's EVK Receiver and Renesas's EVK Transmitter.

In order to complete the Setup, a battery is required, just as any functional device that is sold with "BATTERIES NOT INCLUDED" or "COMPONENT STEREO SYSTEM" may infringe a utility patent. Furthermore, US10790703 does not require a battery to be hard-wired, i.e., soldered to the board.

Please let me know when we can discuss.

Bill

---

**From:** Jason Crotty <[lcrotty@mkwllp.com](mailto:lcrotty@mkwllp.com)>  
**Sent:** Friday, December 22, 2023 1:55 PM  
**To:** William Ramey <[wramey@rameyfirm.com](mailto:wramey@rameyfirm.com)>; Susan Kalra <[skalra@rameyfirm.com](mailto:skalra@rameyfirm.com)>  
**Cc:** Benjamin Charkow <[bcharkow@mkwllp.com](mailto:bcharkow@mkwllp.com)>  
**Subject:** Koji IP, LLC v. Renesas Electronics America, Inc. (N.D. Cal.) -- correspondence

ADD0269



Counsel:

Please see the attached correspondence. If you would like to discuss, please let me know. Thanks,  
and Happy Holidays.

Jason A. Crotty  
Mauriel Kapouytian Woods LLP  
450 Sansome St., Ste. 1005  
San Francisco CA 94111  
(415) 969-6918

**CAUTION:** External Sender

**CAUTION:** External Sender

**CAUTION:** External Sender

ADD0270

UNITED STATES DISTRICT COURT  
NORTHERN DISTRICT OF CALIFORNIA

KOJI IP, LLC,

Plaintiff(s),

v.

RENESAS ELECTRONICS AMERICA

Defendant(s).

Case No. 3:24-cv-03089-PHK

**CONSENT OR DECLINATION  
TO MAGISTRATE JUDGE  
JURISDICTION**

**INSTRUCTIONS:** Please indicate below by checking **one** of the two boxes whether you (if you are the party) or the party you represent (if you are an attorney in the case) choose(s) to consent or decline to magistrate judge jurisdiction in this matter. Sign this form below your selection.

☒ **CONSENT to Magistrate Judge Jurisdiction**

In accordance with the provisions of 28 U.S.C. § 636(c), I voluntarily **consent** to have a United States magistrate judge conduct all further proceedings in this case, including trial and entry of final judgment. I understand that appeal from the judgment shall be taken directly to the United States Court of Appeals for the Ninth Circuit.

**OR**

☐ **DECLINE Magistrate Judge Jurisdiction**

In accordance with the provisions of 28 U.S.C. § 636(c), I **decline** to have a United States magistrate judge conduct all further proceedings in this case and I hereby request that this case be reassigned to a United States district judge.

DATE: June 26, 2024

NAME: Jason A. Crotty

/s/ Jason A. Crotty

*Signature*

COUNSEL FOR  
(OR "PRO SE"):

Defendant Renesas Electronics  
America Inc.



1 WHEREAS, due to prior commitments for Plaintiff, the Parties have agreed to extend  
2 the briefing schedule and modify the hearing date for the Motion as set forth below.

3 NOW THEREFORE, pursuant to Civil L.R. 6-1(b) and 6-2, the Parties, through their  
4 respective counsel, hereby stipulate as follows:  
5

6 The deadlines for the parties to complete briefing on the Motion are extended as set  
7 forth below, as is the parties' proposed hearing date for the Motion:

- 8 • July 31, 2024: Koji's deadline to respond.
- 9 • August 14, 2024: Renesas' deadline to reply.
- 10 • August 23, 2024: Hearing on Renesas' Motion for Attorneys' Fees.

11 August 22, 2024 at 10:30 AM

12  
13  
14 **IT IS SO STIPULATED AND AGREED.**

15  
16  
17 Dated: July 3, 2024

18 Respectfully submitted,

19 RAMEY LLP

20 /s/ Susan S.Q. Kalra

21 Susan S.Q. Kalra (CA State Bar No. 16740)

22 5020 Montrose Blvd., Suite 800

23 Telephone: (800) 993-7499

24 Fax: (832) 900-4941

25 Email: skalra@rameyfirm.com

26 /s/ William P. Ramey, III

27 William P. Ramey, III (pro hac vice anticipated)

28 5020 Montrose Blvd., Suite 800

Houston, Texas 77006

Telephone: (713) 426-3923

Fax: (832) 689-9175

Email: wramey@rameyfirm.com

***Attorneys for Plaintiffs***  
**Koji IP, LLC**

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**RENESAS ELECTRONICS AMERICA INC.**

**FILER'S ATTESTATION**

I, Susan S.Q. Kalra, am the ECF user whose ID and password are being used to file this  
**STIPULATION AND ~~PROPOSED~~ ORDER EXTENDING THE BRIEFING**  
**SCHEDULE REGARDING DEFENDANT MOTIVE TECHNOLOGIES, INC.'S**  
**MOTION TO DISMISS THE COMPLAINT PURSUANT TO FED. R. CIV. P. 12(b)(6).**  
In compliance with Civil L.R. 5-1(h)(3), I attest that all other signatories listed, and on whose  
behalf the filing is submitted, have concurred in the filing of this document.

/s/ Susan S.Q. Kalra  
Susan S.Q. Kalra

**ORDER**

**PURSUANT TO STIPULATION, IT IS SO ORDERED.**

DATED: July 5, 2024

A handwritten signature in black ink, appearing to read "Peter H. Kang", is written over a horizontal line.

HONORABLE PETER H. KANG  
UNITED STATES MAGISTRATE JUDGE

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*Attorneys for Plaintiff*  
KOJI IP, LLC

**IN THE UNITED STATES DISTRICT COURT  
FOR THE NORTHERN DISTRICT OF CALIFORNIA  
SAN FRANCISCO DIVISION**

KOJI IP, LLC,  
  
Plaintiff,  
  
v.  
  
RENESAS ELECTRONICS AMERICA,  
INC.,  
  
Defendant.

Case No.: 3:24-cv-03089-PHK

**DECLARATION OF WILLIAM P.  
RAMEY, III IN SUPPORT OF  
RESPONSE TO RENESAS  
ELECTRONICS AMERICA, INC.'S  
MOTION FOR ATTORNEYS' FEES**

**Date: August 22, 2024  
Time: 10:30 a.m.  
Judge Peter H. Kang**



**DECLARATION OF WILLIAM P. RAMEY, III**

I, William Ramey, declare as follows:

1. My name is William P. Ramey, III. I am over the age of 21. I have personal knowledge of the facts contained herein, which are true and correct. If called as a witness, I could competently testify to these statements.

2. I am licensed to practice law in the state of Texas and am an attorney with the law firm of Ramey LLP. I represent the Plaintiff in the above-captioned lawsuit.

3. In addition to reliance on my highly competent staff and the other attorneys at the Ramey LLP firm, I also used resources including litigation support services from Simon Sunatori. I am confident in the support I receive and received from Mr. Sunatori because he is an experienced patent professional.

4. Plaintiff Koki IP, LLC (“Koji”) sued Defendant Renesas Electronic Americas, Inc., (“Renesas”) alleging that Renesas infringes U.S. Pat. Nos. 10,790,703 (“the ’703 Patent”), entitled “Smart Wireless Power Transfer Between Devices” (“Patent-in-Suit”) in the District of Colorado on June 30, 2023.

5. Renesas’s in-house counsel and director of intellectual property, Mr. Masaki Yabe, directly contacted me On July 3, 2023 about the lawsuit filed a few days earlier. Mr. Yabe offered to discuss a royalty rate for the alleged infringement and requested an extension, which was freely offered. On July 11, 2023, Mr. Yabe agreed to waive service of the summons. Exhibit A is a true and correct copy of an e-mail chain between William P. Ramey, III and Mr. Yabe.

6. On July 20, 2023, Jason Crotty appeared as counsel for Renesas and opened a dialogue with me at Ramey LLP. Mr. Crotty asked that the suit be dismissed because there was low sales

1 volume, Renesas disagreed with infringement, and venue was improperly based on a distributor.

2 Exhibit B is a true and correct copy of an e-mail chain between me and Jason Crotty.

3 7. I, on behalf of Koji, immediately began communicating with Defendant about the case,  
4 including both infringement and Defendant's contention that venue was improper.

5 8. For venue, I provided evidence that we believed showed that Renesas controlled the sales  
6 agent., in that Renesas listed the location as its location:

7

8 <http://www.renesas.com/us/en/BUY/sample/locations>

9 **Sales Locations**

10 Country / Region:  Type: ☐ Distributor ☐ Sales Representative ☐ Value Added Reseller

Location	Description	Contact Info	Type
Mountain US	<b>AKI GIBB</b> Colorado & Wyoming: 2181 So. Grape St Denver, CO 80222  Utah, Idaho, Montana: 4252 Cresthaven Ln. Lehi, UT 84043	Colorado & Wyoming: Phone: 303.756.0700 Fax: 303.756.3135  Utah, Idaho, Montana: Phone: 303.756.0700 Fax: 303.756.3135  Web: <a href="http://www.akigibb.com">www.akigibb.com</a> Contact: <a href="mailto:info@akigibb.com">info@akigibb.com</a>	Sales Representative

15 1

16 Exhibit D is a true and correct copy of an July 26, 2023 e-mail chain containing a screen shot  
17 from Defendant's website that we used for venue.

18 9. For infringement, Koji provided a rebuttal to Renesas position, a portion of which is  
19 reproduced here with the reminder in Exhibit E:

20  
21  
22  
23  
24  
25  
26  
27  
28 <sup>1</sup> Ex. D, July 26, 2023 e-mail chain containing screenshot from Renesas website.

1 Additionally, the claims do not appear to read on the accused product, as they appear directed primarily to the transmission side, and the P9222-R EVK is essentially a low power receiver product.  
 2 • US10790703: "Smart wireless power transfer between devices"  
 3 Claim 1 of US10790703 is a "Tx wireless power transfer system for wirelessly charging a powered device" which encompasses both transmitter and receiver. Therefore, there is no "primarily to the transmitter side" or "primarily to the receiver side". Renesas Electronics America's P9222-R EVK is Qi certified, i.e., it must follow both Qi's Power Transfer Protocol and Qi's Power Receiver Protocol.

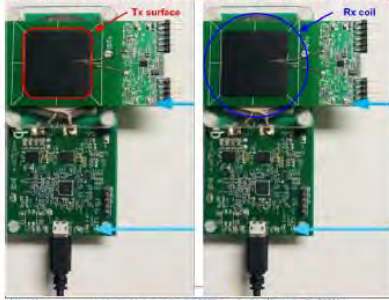
4 • Qi Specifications | Wireless Power Consortium

5 <https://www.wirelesspowerconsortium.com/data/specifications/3.0/3.0w1.1.3-public.zip>  
 In fact, Renesas Electronics America's own document admits that Renesas product "P9235A-RB-EVK Evaluation Board or any other Qi certified transmitter can be used as the power transmitter", as shown below:

6 The P9222-R-EVK Wireless Power Evaluation Board can be used to demonstrate the features and performance of the P9222-R 5W Wireless Power Receiver in low power 2.5W applications such as in earbuds charging cases. The P9222-R-EVK can also supply up to 5W power. IDT's P9235A-RB-EVK Evaluation Board or any other Qi certified transmitter can be used as the power transmitter for P9222-R-EVK evaluation board testing.

7 <https://www.renesas.com/www/resources/mal/p9222-r-evk-evaluation-board-manual-m3481a>

8 Renesas Electronics America wrote:  
 Even if that issue were somehow overcome, our analysis also indicates that the P9222-R EVK does not perform several limitations of the independent claims, including, as examples, the last three "wherein" limitations in Claim 1.  
 9 Renesas Electronics America describes "P9222-R EVK PCB boards act as a spacer between Tx surface and Rx coil" and depicts Tx surface narrower than Rx coil (i.e., transmission power of the wireless communication circuitry is so controlled as to make a range of the close-range wireless communication substantially narrower than a range of the radiative power region).



2 Exhibit E is a true and

correct copy of the claim chart rebuttal sent to Renesas in an e-mail chain. I substantively addressed each of Renesas noninfringement positions.

10. After receiving these sworn statements, which were not previously provided to me and likely established that the location relied upon for venue was not a location of Renesas, Koji dismissed its lawsuit on September 6, 2023 without burdening the court or Renesas to address the arguments. The dismissal was filed solely to effectuate dismissal and reduce the costs for all parties. Exhibit F is a true and correct of Defendant's Motion to Dismiss, Doc. No. 14 at 3 from Cause No. 1:23-cv-1674.

11. On November 8, 2023, I refiled the lawsuit in the Northern District of California and immediately began discussions with counsel for Renesas about additional accused products, even providing a chart for the product to show that its infringement allegations were good which

<sup>2</sup> Ex. M, claim chart attached to August 1, 2023 e-mail chain, to the Ramey Decl.

1 substantively addressed Renesas noninfringement arguments. Exhibit G is a true and correct  
2 copy of the Original Complaint filed under cause number 5:23-cv-05750. Exhibit H is a true  
3 and correct copy of an e-mail chain dated January 23, 2024. Exhibit I is a true and correct copy  
4 of a claim chart directed to a new product accused of infringement.

5  
6 12. Renesas maintained that the sales volume of the accused product was very low. I and  
7 personnel at Koji looked for additional products from Defendant but were unable to locate any  
8 at the time.

9  
10 13. Therefore, to not burden Renesas, on January 30, 2024, I agreed to dismiss without  
11 prejudice its lawsuit, to which Renesas agreed. The lawsuit was dismissed due to the low sales  
12 volume. Defendant had not filed any motions in the case or otherwise appeared or responded.  
13 Exhibit J is a true and correct copy of a January 30, 2024 e-mail chain.

14  
15 14. Shortly thereafter, I and my client's representative, Carlos Gorrichategui, Ph.D,  
16 discussed whether the sales of the newly charted product had been included in the prior numbers  
17 and came to the conclusion it was not based on what had been provided to Renesas in the prior  
18 lawsuit. Accordingly, Koji asked Ramey LLP to file a new lawsuit based on the newly charted  
19 product created by Sunatori and Ramey LLP. On May 22, 2024, Koji filed the new lawsuit,  
20 accusing an entirely different Renesas system. Both Ramey LLP and Koji believed the lawsuit  
21 to be well founded and the infringement read to be good at the time of filing, that it was brought  
22 in good faith. Exhibit C is a true and correct copy of an e-mail chain dated June 7, 2024  
23 forwarding the complaint to in-house counsel that had contacted me previously.

24  
25 15. Renesas's lawyer responded by letter on May 31, 2024, that Koji's lawsuit was  
26 foreclosed as it had been dismissed twice. The letter asked that the lawsuit be promptly  
27 dismissed. After further discussions with Renesas's counsel, the lawsuit was dismissed with  
28

1 prejudice on June 12, 2024. Renesas had not entered an appearance or filed any document in the

2 case. The case was less than two months old. Exhibit L is a true and correct copy of a Letter

3 from Defendant's counsel to Ramey LLP.

4 16. Mistakenly, a copy of the new lawsuit was e-mailed directly to Renesas's in-house

5 counsel that had contacted Ramey LLP directly. After being advised by Renesas's counsel of

6 the error, no further contact was had with the client. Ramey LLP updated its procedures to ensure

7 that the contact does not repeat for this or other matters.

8 17. Renesas's counsel responded that the previous dismissal was in effect with prejudice and

9 therefore the current lawsuit should be dismissed. Our opinion was that the dismissal of the

10 Colorado lawsuit did not count as a prior dismissal for purposes of Rule 41 as it was done on

11 venue grounds and to conserve the resources of the parties. However, further research did not

12 provide a definitive case on the issues so Koji decided to dismiss the lawsuit with prejudice

13 before Renesas would be required to expend resources answering or otherwise responding.

14 18. Koji instructed me to seek a dismissal where each party bearing its own fees and costs

15 but Renesas refused. Rather than fight motion practice and increase the costs for both sides, I

16 dismissed with *prejudice* Koji's lawsuit over all products that might infringe the '703 patent.

17 Notably, when Koji dismissed, Renesas had not entered an appearance. Renesas only entered

18 an appearance to file its motion for fees.

19 I declare under penalty of perjury under the laws of the United States of America that the

20 foregoing is true and correct.

21 Executed on July 31, 2024.

22 William P. Ramey, III

23 

# EXHIBIT F





## **TABLE OF CONTENTS**

I. INTRODUCTION.....	1
II. FACTUAL BACKGROUND .....	2
III. LEGAL STANDARD.....	5
IV. ARGUMENT .....	7
A. By Basing Its Claim for Venue on the Address of an REA Sales Representative, Koji’s Venue Assertion Fails .....	7
B. Because the Accused Product Lacks Two Limitations, Koji’s Direct Infringement Allegations Must Be Dismissed .....	9
C. With No Allegations of Pre-Suit Knowledge, All Pre-Suit Indirect Infringement Claims Should Be Dismissed.....	9
V. CONCLUSION.....	11
CERTIFICATE OF COMPLIANCE .....	12

## TABLE OF AUTHORITIES

<b>Cases</b>	<b>Page(s)</b>
<i>Alvarado v. KOB–TV, L.L.C.</i> , 493 F.3d 1210 (10th Cir. 2007) .....	7, 9
<i>Behegen v. Amateur Basketball Ass’n of U.S.A.</i> , 744 F.2d 731 (10th Cir. 1984) .....	5
<i>BIAX Corp. v. Motorola Solutions, Inc.</i> , No. 10–cv–03013–PAB–KLM, 2012 WL 502727 (D. Col. Feb. 15, 2012) .....	6-7
<i>Bovino v. Levensger Co.</i> , No. 14–cv–00122–RM–KLM, 2015 WL 1064082 (D. Col. Mar. 9, 2015).....	10
<i>Dental Monitoring SAS v. Align Technology, Inc.</i> , No. C 22-07335, 2023 WL 4297570 (N.D. Cal. June 30, 2023) .....	10
<i>GFF Corp. v. Associated Wholesale Grocers, Inc.</i> , 130 F.3d 1381 (10th Cir. 1997) .....	7
<i>Global-Tech Appliances, Inc. v. SEB S.A.</i> , 563 U.S. 754 (2011) .....	9
<i>H&amp;H Transformer, Inc. v. Battelle Energy All., L.L.C.</i> , No. 09–cv–00442–WYD–BNB, 2009 WL 3530370 (D. Colo. Oct. 23, 2009).....	5
<i>Hildebrand v. Wilmar Corp.</i> , No. 17–cv–02821–PAB–MEH, 2018 WL 1535505 (D. Col. Mar. 29, 2018).....	8
<i>In re Cray Inc.</i> , 871 F.3d 1355 (Fed. Cir. 2017) .....	6, 8
<i>Indus. Constructors Corp. v. U.S. Bureau of Reclamation</i> , 15 F.3d 963 (10th Cir. 1994) .....	7
<i>Laitram Corp. v. Rexnord, Inc.</i> , 939 F.2d 1533 (Fed. Cir. 1991) .....	6
<i>Mas–Hamilton Grp. v. LaGard, Inc.</i> , 156 F.3d 1206 (Fed. Cir. 1998) .....	6, 9
<i>Nagim v. Jackson</i> , No. 10–cv–00328–PAB–KLM, 2010 WL 4318896 (D. Colo. Aug. 10, 2010) .....	5

<i>Sonos, Inc. v. Google LLC</i> , 591 F. Supp. 3d 638 (N.D. Cal. 2022) .....	5-7
<i>TC Heartland, LLC v. Kraft Foods Grp. Brands, LLC</i> , 581 U.S. 258 (2017) .....	5-7
<i>Tex. Instruments Inc. v. Cypress Semiconductor Corp.</i> , 90 F.3d 1558 (Fed. Cir. 1996) .....	6
<i>TMJ Implants, Inc. v. Aetna, Inc.</i> , 498 F.3d 1175 (10th Cir. 2007) .....	7
<b>Statutes</b>	
28 U.S.C. § 1391 .....	2, 5
28 U.S.C. § 1400 .....	2, 5-8
<b>Rules</b>	
Fed. R. Civ. P. 12(b)(6) .....	1, 7
Fed. R. Civ. P. 12(b)(3) .....	1, 5, 8

Defendant Renesas Electronics America, Inc. (“REA” or “Renesas”), by and through the undersigned counsel, hereby moves to dismiss the action filed by Plaintiff Koji IP, LLC (“Koji IP”) for improper venue pursuant to Federal Rule of Civil Procedure Rule 12(b)(3) and/or for failure to state a claim upon which relief can be granted pursuant to Federal Rule of Civil Procedure 12(b)(6).

## **I. INTRODUCTION**

REA is a California corporation with headquarters in the San Francisco Bay Area. The Complaint erroneously alleges that REA is located at the address of an REA sales representative located in Colorado. REA informed Koji IP of this error, but it insisted that its venue allegations were proper. Because REA is not located at the address set forth in the Complaint, venue is improper, and the case should be dismissed pursuant to Rule 12(b)(3).

Additionally, the patent infringement allegations are insufficient. It is black letter law that to be found liable for direct infringement, REA’s accused product must meet each limitation of an asserted claim. The document on which Koji IP bases its infringement allegations demonstrates that the accused product cannot directly infringe any claim of the asserted patent because it does not come with (*i.e.*, is missing) at least two limitations required by each claim in the asserted patent. Thus, the direct infringement allegations should be dismissed with prejudice, as amendment would be futile. Under no circumstances could Koji IP amend its complaint to include allegations that these missing limitations are met by the accused product.

Finally, Koji IP alleges that REA induced infringement and contributed to the infringement by third parties, but it provides no factual support for these theories. Further, Koji IP implicitly acknowledges that it has no evidence of pre-complaint knowledge of the asserted patent. As a result, the pre-complaint allegations of indirect infringement must also be dismissed.

## **II. FACTUAL BACKGROUND**

REA is a semiconductor company incorporated in California with headquarters in the San Francisco Bay Area. (See O'Sullivan Decl., ¶ 2.) The Complaint states: “On information and belief, Defendant is a corporation organized and existing under the laws of the State of CA, with a regular and established place of business located [a]t 2181 So. Grape St., Denver, CO 80222.” (Complaint (Dkt. No. 1), ¶ 2.) As to venue, the complaint states: “Defendant has committed acts of infringement and has a regular and established place of business in this District.” (*Id.*, ¶ 6.)<sup>1</sup>

The Denver address cited by Koji IP appears to have been divined from the REA website, which identifies third-party distributors and sales representatives. As set forth below, the Denver address is that of a sales representative, AKI GIBB.

---

<sup>1</sup> The Complaint also makes allegations regarding venue under 28 U.S.C. § 1391(b). As set forth below, the Supreme Court has squarely held that venue in patent cases is *exclusively* governed by 28 U.S.C. § 1400, so the allegations under other provisions are irrelevant.

https://www.renesas.com/us/en/buy-sample/locations

## Sales Locations

Country / Region  
- Any -

Type  
☐ Distributor  
☐ Sales Representative  
☐ Value Added Reseller

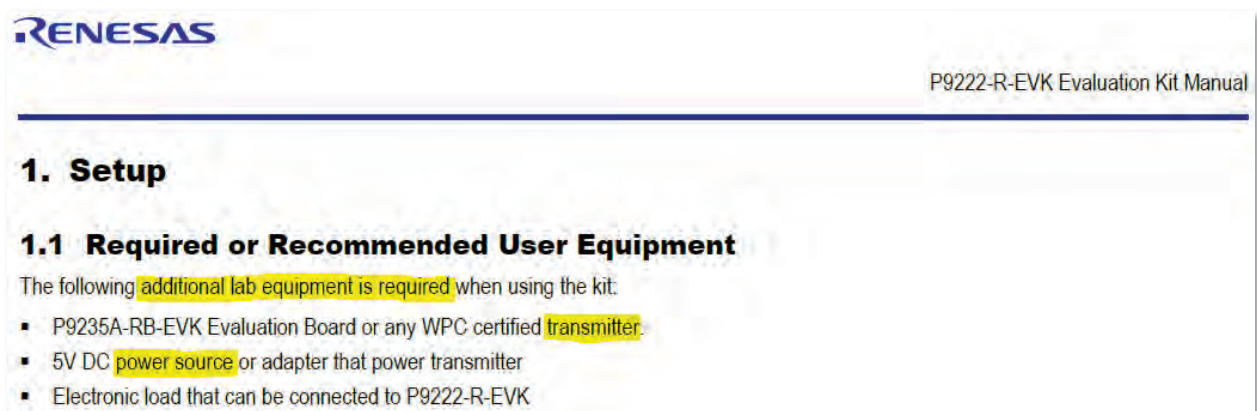
Apply

Location	Description	Contact Info	Type
Mountain US	<b>AKI GIBB</b> Colorado & Wyoming: 2181 So. Grape St Denver, CO 80222  Utah, Idaho, Montana: 4252 Cresthaven Ln. Lehi, UT 84043	Colorado & Wyoming: Phone: 303 756 0700 Fax: 303 756 3135  Utah, Idaho, Montana: Phone: 303 756 0700 Fax: 303 756 3135  Web: <a href="http://www.akigibb.com">www.akigibb.com</a> Contact: <a href="mailto:info@akigibb.com">info@akigibb.com</a>	Sales Representative

The relationship between AKI GIBB and REA is governed by a Sales Representative Agreement which states that the relationship is that of “principal and selling representative.” (O’Sullivan Decl., ¶ 5.) The agreement states that AKI GIBB is an independent contractor and not an employee or agent of REA. (*Id.*) REA does not own or control AKI GIBB, nor does it have any say in the day-to-day operations of AKI GIBB. (*Id.*, ¶ 6.) REA does not own or lease the AKI GIBB facility and does not have employees at AKI GIBB. (*Id.*)

As to infringement, the Complaint alleges that REA: (1) directly infringes and (2) induces and contributes to infringement by unspecified third parties. (See Complaint, ¶¶ 9-12.) The Complaint includes a perfunctory claim chart that purports to allege infringement of Claim 1 by the Renesas P9222-R-EVK evaluation kit (“P9222”). (See Complaint, Ex. B (Dkt. No. 1-2).) The claim chart relies exclusively on the REA manual for the P9222 (“P9222 Manual”) and includes an internet link to that document. (See *id.*)

Claim 1 (and in fact each claim of the asserted patent) requires, among other limitations, a “**battery power source**” and “wireless powering circuitry including a **transmitter** configured to emit electromagnetic waves to form a radiative powering region.” (See Complaint, Ex. A (Dkt. No. 1-1) at pg 69 of 70 (emphasis added).) Thus, to infringe Claim 1 or any other claim of the asserted patent, Koji IP would need to demonstrate that the accused product had both a battery power source and a transmitter. However, the P9222 Manual relied upon by Koji IP demonstrates that neither of these components is included in the accused product. Specifically, the P9222 Manual states that “**additional lab equipment is required** when using the kit,” **including a power supply (i.e., a battery power source) and a transmitter**:



(See Crotty Decl., Ex. A at 5) (emphasis added).)

As shown above, the P9222 does not include either a power supply or a transmitter. Koji IP’s claim chart alleges that the P9222 Manual “describes” a “battery power source” but does not allege that it is actually contained in the P9222. (See Complaint, Ex. B at 3.) The same is true of the “transmitter.” (See *id.* at 4.)



Koji IP alleges that REA induced infringement or contributed to infringement by its customers but does not allege that REA was aware of the asserted patent before the complaint was filed. (See Complaint, ¶¶ 11-12.) Instead, Koji IP simply states that it “reserves the right to amend and add inducement pre-suit if discovery reveals an earlier date of knowledge” other than the date of filing of the Complaint. (See *id.*, ¶ 11, n.1.)

### III. LEGAL STANDARD

“The standard under 12(b)(3) is generally the same as a motion to dismiss for lack of personal jurisdiction.” *H&H Transformer, Inc. v. Battelle Energy All., L.L.C.*, No. 09–cv–00442–WYD–BNB, 2009 WL 3530370, at \*3 (D. Colo. Oct. 23, 2009). Thus, the plaintiff bears the burden of making a prima facie showing that venue is proper. See *Behegen v. Amateur Basketball Ass’n of U.S.A.*, 744 F.2d 731, 733 (10th Cir. 1984); *Nagim v. Jackson*, No. 10–cv–00328–PAB–KLM, 2010 WL 4318896, at \*2 (D. Colo. Aug. 10, 2010).

The Supreme Court has unequivocally held that 28 U.S.C. § 1400(b) exclusively governs venue determinations in patent infringement cases. See *TC Heartland, LLC v. Kraft Foods Grp. Brands, LLC*, 581 U.S. 258, 266 (2017) (“§ 1400(b) ‘is the sole and exclusive provision controlling venue in patent infringement actions, and is not to be supplemented by § 1391(c).’” (citation omitted)). Section 1400(b) provides that venue is proper “in the judicial district where the defendant resides, or where the defendant has committed acts of infringement and has a regular and established place of business.” 28 U.S.C. § 1400(b).

The Supreme Court has held that, “[a]s applied to domestic corporations, ‘residence’ in § 1400(b) refers only to the State of incorporation.” *TC Heartland*, 581 U.S. at 270. Establishing venue under the “regular and established place of business” provision entails three requirements: “(1) there must be a physical place in the district; (2) it must be a regular and established place of business; and (3) it must be the place of the defendant.” *In re Cray Inc.*, 871 F.3d 1355, 1360 (Fed. Cir. 2017). The first element requires “a physical, geographical location in the district from which the business of the defendant is carried out.” *Id.* at 1362. To meet the second requirement, the business must operate in a permanent and steady manner. *See id.* at 1362–63. The final element requires that the defendant “establish or ratify the place of business.” *Id.* at 1363.

To establish liability for direct infringement, “the accused . . . process must contain every limitation of the asserted claim.” *Tex. Instruments Inc. v. Cypress Semiconductor Corp.*, 90 F.3d 1558, 1563 (Fed. Cir. 1996) (citing *Laitram Corp. v. Rexnord, Inc.*, 939 F.2d 1533, 1535 (Fed. Cir. 1991)). “If even one limitation is missing or not met as claimed, there is no literal infringement.” *Mas–Hamilton Grp. v. LaGard, Inc.*, 156 F.3d 1206, 1211 (Fed. Cir. 1998) (citations omitted).

After *Twombly/Iqbal*, courts require that allegations of indirect infringement plead facts regarding knowledge of the patent (for both inducement and contributory infringement) and substantial non-infringing use (for contributory infringement). *See, e.g., BIAx Corp. v. Motorola Solutions, Inc.*, No. 10–cv–03013–PAB–KLM, 2012 WL

502727, at \*3 (D. Col. Feb. 15, 2012) (collecting cases). Conclusory allegations that merely parrot the statutory language are insufficient. See *id.*

In evaluating a Rule 12(b)(6) motion to dismiss, courts may consider not only the complaint itself, but also attached exhibits and documents incorporated into the complaint by reference. See *Indus. Constructors Corp. v. U.S. Bureau of Reclamation*, 15 F.3d 963, 964–65 (10th Cir. 1994); *TMJ Implants, Inc. v. Aetna, Inc.*, 498 F.3d 1175, 1180 (10th Cir. 2007). “[T]he district court may consider documents referred to in the complaint if the documents are central to the plaintiff’s claim and the parties do not dispute the documents’ authenticity.” *Alvarado v. KOB–TV, L.L.C.*, 493 F.3d 1210, 1215 (10th Cir. 2007) (internal quotation and citation omitted). “[F]actual allegations that contradict ... a properly considered document are not well-pleaded facts that the court must accept as true.” *GFF Corp. v. Associated Wholesale Grocers, Inc.*, 130 F.3d 1381, 1385 (10th Cir. 1997).

#### IV. ARGUMENT

##### A. By Basing Its Claim for Venue on the Address of an REA Sales Representative, Koji’s Venue Assertion Fails

Koji IP does not allege that REA “resides” in Colorado (nor could it, as it is a California corporation). The Supreme Court has held that “residence” in § 1400(b) refers only to the State of incorporation. See *TC Heartland*, 581 U.S. at 269.

Thus, the only plausible ground for venue in Colorado is if REA has “a regular and established place of business” in the state. 28 U.S.C. § 1400(b). Koji IP erroneously alleges that REA is located at the business address of one of its sales representatives. (See Complaint, ¶ 2.) Broadly speaking, sales representatives make

sales calls to generate new business, handle purchase orders that come in from customers in the territory and relay those purchase orders to REA. (O’Sullivan Decl., ¶ 4.) But they do not buy products or store products for REA. (*Id.*)

AKI GIBB is a manufacturer’s sales representative serving the OEM market in the Rocky Mountain Region and a separate company from REA. (See *id.*, ¶ 5.) The REA-AKI GIBB relationship is governed by a Sales Representative Agreement. (*Id.*) Under that agreement, the relationship is that of “principal and selling representative” and under the agreement AKI GIBB is an independent contractor and not an employee or agent of REA. (*Id.*) REA does not own or control AKI GIBB, nor does it have any say in the day-to-day operations of AKI GIBB. (*Id.*, ¶ 6.) Moreover, REA does not own or lease the AKI GIBB facility. (*Id.*) Nor does REA have employees at AKI GIBB. (*Id.*)

Accordingly, AKI GIBB’s facilities are not a regular and established place of business of REA. See *In re Cray Inc.*, 871 F.3d at 1363 (“the regular and established place of business’ must be ‘the place of the defendant.’” (citing 28 U.S.C. § 1400)); *Hildebrand v. Wilmar Corp.*, No. 17–cv–02821–PAB–MEH, 2018 WL 1535505, at \*4 (D. Col. Mar. 29, 2018) (“the physical locations of [defendant’s] distributors do not constitute [defendant’s] places of business.”). Nor has REA ratified the AKI GIBB place of business as its own. See *In re Cray Inc.*, 871 F.3d at 1363. Because AKI GIBB’s facilities are not a regular and established place of business of REA, Koji IP’s venue allegations fail, and the Complaint should be dismissed pursuant to Rule 12(b)(3).

### **B. Because the Accused Product Lacks Two Limitations, Koji's Direct Infringement Allegations Must Be Dismissed**

As set forth above, each claim of the asserted patent requires, among other limitations, a “battery power source” and “wireless powering circuitry including a transmitter configured to emit electromagnetic waves to form a radiative powering region.” (Complaint, Ex. A at pg. 69 of 70.) The P9222 Manual used by Koji IP for its infringement allegations demonstrates that the accused product does not have either of these limitations.<sup>2</sup> (See Crotty Decl., Ex. A.) The P9222 Manual states that “additional lab equipment is required when using the kit,” ***including a power supply (i.e., a battery) and a transmitter.*** (See *id.* at 5 (emphasis added).) Without these components, the accused product cannot satisfy the limitations of *any* claim of the asserted patent. Accordingly, the direct infringement allegations must be dismissed. See, e.g., *Mas–Hamilton Grp.*, 156 F.3d at 1211 (“If even one limitation is missing or not met as claimed, there is no literal infringement.”) (citations omitted).

### **C. With No Allegations of Pre-Suit Knowledge, All Pre-Suit Indirect Infringement Claims Should Be Dismissed**

Both inducement and contributory infringement require a plaintiff to plead knowledge of the patent. See *Global-Tech Appliances, Inc. v. SEB S.A.*, 563 U.S. 754,

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<sup>2</sup> The P9222 Manual was extensively cited in the Koji IP claim chart, attached as Exhibit B to the Complaint (Dkt. No. 1-2), and an internet link to it was also included in the chart. Accordingly, the P9222 Manual is central to the infringement claims and its authenticity cannot be disputed. Thus, the court can consider the P9222 Manual in its entirety as to this motion. See, e.g., *Alvarado*, 493 F.3d at 1215 (10th Cir. 2007) (“[T]he district court may consider documents referred to in the complaint if the documents are central to the plaintiff's claim and the parties do not dispute the documents' authenticity.” (internal quotation and citation omitted)).

765-66 (2011) (holding that “induced infringement under § 271(b) requires knowledge that the induced acts constitute patent infringement” just as allegations of contributory infringement under § 271(c) require knowledge); *Sonos, Inc. v. Google LLC*, 591 F. Supp. 3d 638, 648 (N.D. Cal. 2022) (granting motion to dismiss on the issue of indirect infringement finding that “provision of a massive, pre-filing copy of the complaint one day prior to filing it in Texas” was inadequate to satisfy the knowledge requirement for indirect infringement); *Dental Monitoring SAS v. Align Technology, Inc.*, No. C 22-07335, 2023 WL 4297570, at \*7 (N.D. Cal. June 30, 2023) (granting motion to dismiss indirect infringement claims, noting that “sending a notice letter [which was not sent in this case] is an easy, cost-effective way to establish knowledge . . .”).

Koji IP does not allege that REA had any pre-complaint knowledge of the asserted patent, alleging in the Complaint the REA has had knowledge “from at least the filing date of the lawsuit” and that Koji IP “reserves the right to amend and add inducement pre-suit if discovery reveals an earlier date of knowledge.” (Complaint, ¶¶ 11-12; *id.*, ¶ 11, n.1.) Thus, the claims of pre-complaint indirect infringement must be dismissed. *See, e.g., Bovino v. Levenger Co.*, No. 14-cv-00122-RM-KLM, 2015 WL 1064082, at \*4 (D. Col. Mar. 9, 2015) (“Because Plaintiff fails to plead any facts as to Defendant's knowledge prior to the filing of the Complaint, any claim as to induced infringement which occurred prior to the filing of the Complaint is not adequately pled and fails to state a claim.”).

## V. CONCLUSION

For the reasons set forth above, the allegations regarding venue in Colorado are inadequate and the Complaint should be dismissed for improper venue. Additionally, the direct infringement allegations must be dismissed because the accused products lack components required to meet each limitation of each claim of the asserted patent. Lastly, the pre-complaint indirect infringement claims must be dismissed because there are no allegations that REA had knowledge of the asserted patent.

Respectfully submitted,

s/ Jason A. Crotty

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### **CERTIFICATE OF COMPLIANCE**

In compliance with D.C.COLO..LPtR 17, the undersigned states that there are 2,603 words in this brief, which does not exceed the 10,000 words, double spaced, in Arial 12-point font limit for dispositive motions.

Dated: August 25, 2023

s/ Jason A. Crotty  
**Jason A. Crotty**

### **CERTIFICATE OF SERVICE**

I hereby certify that a true and correct copy of the foregoing was electronically filed on August 25, 2023, with the Clerk of Court using the CM/ECF system, which will send notification of such filing to the following email address:

William P. Ramey, III  
littigation@rameyfirm.com

s/ Jason A. Crotty

**Jason A. Crotty**

UNITED STATES DISTRICT COURT  
NORTHERN DISTRICT OF CALIFORNIA  
SAN FRANCISCO DIVISION

KOJI IP, LLC,  
Plaintiff,

v.

RENESAS ELECTRONICS AMERICA,  
INC.,  
Defendant.

Case No. [24-cv-03089-PHK](#)

**ORDER TO SHOW CAUSE**

Plaintiff's counsel, Attorneys William P. Ramey, III, Susan S.Q. Kalra, and Jeffrey E. Kubiak, are **ORDERED TO SHOW CAUSE** why they should not be referred to the State Bar of California, as well as the other bars of which they are members, for the unauthorized practice of law and/or aiding and abetting the unauthorized practice of law, as well as why they should not be sanctioned pursuant to this Court's inherent authority and Federal Rule of Civil Procedure 11, as discussed herein.

**I. Unauthorized Practice of Law**

On May 22, 2024, Plaintiff commenced this patent infringement action against Defendant. See Dkt. 1. This is the **third** lawsuit filed by one or all of these attorneys of the Ramey LLP firm on behalf of Koji IP, LLC asserting that Renesas Electronics America, Inc. is infringing U.S. Patent No. 10,790,703. See Complaint *Koji IP, LLC v. Renesas Electronics America, Inc.* ("Koji I"), No. 1:23-cv-01674-SKC (D. Colo. Jun. 30, 2023), ECF No. 1; Complaint, *Koji IP, LLC v. Renesas Electronics America, Inc.* ("Koji IP"), No. 3:23-cv-05752-LJC (N.D. Cal. Nov. 8, 2023), ECF No. 1. The previous two actions were voluntarily dismissed by these attorneys under Federal Rule of Civil Procedure 41. See Notice of Voluntary Dismissal, *Koji I*, No. 1:23-cv-01674-SKC

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(D. Colo. Sept. 6, 2023), ECF No. 18; Notice of Voluntary Dismissal, *Koji II*, No. 3:23-cv-05752-LJC (N.D. Cal. Jan. 30, 2024), ECF No. 12. As with those two prior lawsuits, Plaintiff voluntarily dismissed this Third Action on June 12, 2024. [Dkt. 12]. On June 26, 2024, Defendant filed a motion for attorney fees. [Dkt. 18]. Plaintiff opposed, and Defendant filed a reply. [Dkts. 24, 25]. In the reply brief, Defendant raised the issue of the potential unauthorized practice of law by Plaintiff's counsel, Mr. Ramey. [Dkt. 25 at 15]. The Court heard oral argument on that motion for fees on August 22, 2024. *See* Dkt. 26. Ms. Kalra appeared as counsel for Plaintiff at that hearing, but Mr. Ramey and Mr. Kubiak did not appear. During oral argument, counsel for Defendant raised additional details on the alleged unauthorized practice of law.

In this matter, Ms. Kalra, who is registered on the Court's electronic case filing system as counsel of record for Plaintiff, filed the complaint, civil cover sheet, report on the filing of a patent action, certificate of interested entities, and proposed summons. *See* Dkts. 1-5. The documents filed by Ms. Kalra in this case state that they originated from the law offices of Ramey LLP, 5020 Montrose Blvd., Suite 800, Houston, Texas 77006. Ms. Kalra is a member of the Northern District of California bar and an active member of the State Bar of California in good standing.

The body of the text of the complaint is signed by Ms. Kalra and identifies her to be Plaintiff's counsel ("Susan S.Q. Kalra (CA State Bar No. 16740)"). [Dkt. 1 at 7]. Ms. Kalra and Mr. Ramey both signed the jury demand on the final page of the complaint, and they are identified therein as "Attorneys for Plaintiff." *Id.* at 8. The front page of the complaint includes the names of these two attorneys and similarly identifies them as "Attorneys for Plaintiff." *Id.* at 1. The final page of the complaint is signed by these two attorneys but also includes the name and contact information for another attorney from Ramey LLP, Mr. Kubiak (identified as one of the "Attorneys for Plaintiff"). *Id.* at 8. In the signature block on the last page of the complaint, both Mr. Ramey and Mr. Kubiak have the words "*pro hac vice* anticipated" next to their names along with Texas Bar numbers. *Id.* Mr. Ramey's signature appears not just on the complaint but also on several other documents filed on behalf of Plaintiff in this case.

By affixing "*pro hac vice* anticipated" next to their names in documents filed on the docket since the earliest days of this case, Mr. Ramey and Mr. Kubiak appear to indicate their intent to

1 seek *pro hac vice* admission to this Court for this matter. To date, neither has filed (and no  
2 attorney has filed) a motion on either Mr. Ramey's or Mr. Kubiak's behalf seeking *pro hac* status  
3 in this case. The notice of voluntary dismissal in this case was signed by both Ms. Kalra and Mr.  
4 Ramey—both identified as “Attorneys for Plaintiff”—and Mr. Ramey includes the “*pro hac vice*  
5 anticipated” language after his name in that filing as well. [Dkt. 12 at 2].

6 Attorneys practicing in the Northern District of California must either be members of the  
7 Court's bar, or alternatively, admitted to practice in a particular case pending in the Court *pro hac*  
8 *vice*. See Civil L.R. 11-1(a), 11-3. Neither Mr. Ramey nor Mr. Kubiak is a member of the  
9 Northern District of California Bar. See *United States v. Author Servs., Inc.*, 804 F.2d 1520 (9th  
10 Cir. 1986) (“It is well established that a court may take judicial notice of its own records.”). A  
11 prerequisite for admission to the Bar of this Court is that an attorney must be an active member in  
12 good standing of the State Bar of California. See Civil L.R. 11-1(b). The Court takes judicial  
13 notice that neither Mr. Ramey nor Mr. Kubiak is a member of the State Bar of California. See  
14 *Castillo-Perez v. I.N.S.*, 212 F.3d 518, 524 n.6 (9th Cir. 2000) (taking judicial notice of the  
15 membership records of the State Bar of California). Accordingly, Mr. Ramey and Mr. Kubiak  
16 may not practice in the Northern District of California unless they are admitted (on a case-by-case  
17 basis) to appear *pro hac vice*.

18 “[T]here is no fundamental right to appear *pro hac vice*.” *Paciulan v. George*, 38 F. Supp.  
19 2d 1128, 1144 (N.D. Cal. 1999), *aff'd*, 229 F.3d 1226 (9th Cir. 2000); see *Frazier v. Heebe*, 482  
20 U.S. 641, 647 (1987) (describing attorneys admitted *pro hac vice* as “one-time or occasional  
21 practitioners”). Civil Local Rule 11-3, which sets forth the requirements for *pro hac vice*  
22 applications, provides that an attorney who is a member in good standing and eligible to practice  
23 before the Bar of any United States Court or of the highest Court of any State may in a particular  
24 case be permitted to practice within this District on a *pro hac vice* basis upon application and  
25 discretion of this Court. Relevant here, an attorney seeking *pro hac vice* status must submit their  
26 application and admission fee “**at the time of the filing of a complaint** or the attorney's first  
27 appearance in the case.” Civil L.R. 11-3(b) (emphasis added). Further, an attorney who  
28 “regularly engage[s] in the practice of law in the State of California” is disqualified from *pro hac*

1 vice admission (absent certain exceptions not germane here). Civil L.R. 11-3(c). In addition to  
2 the application documents, an applicant for *pro hac vice* admission must pay the fee for such  
3 admission at the time of the application (currently set at \$328 per applicant, per case). Civil L.R.  
4 11-3(e); see <https://www.cand.uscourts.gov/about/clerks-office/court-fees/>.

5 The record reveals that Mr. Ramey and Mr. Kubiak are out-of-state attorneys who are  
6 acting as Plaintiff's litigation counsel in this case. The information provided by Ms. Kalra at the  
7 hearing on August 22, 2024 makes clear that Mr. Ramey has engaged in, and continues to engage  
8 in, the bulk of legal activity in litigating this case. As noted, neither Mr. Ramey nor Mr. Kubiak  
9 are licensed to practice law in California. Neither individual has sought (much less been granted)  
10 *pro hac vice* status in this case. The docket shows plainly that there was no application for *pro*  
11 *hac vice* admission filed on their behalf at the time of the filing of the complaint in this current  
12 action. See Civil L.R. 11-3(b).

13 As discussed above, this is the third in a trilogy of cases filed by these attorneys on behalf  
14 of this same Plaintiff alleging infringement by this same Defendant of the same asserted patent.  
15 The Second Action was filed in this Court on November 8, 2023. The complaint in that case is  
16 identical in all material respects to the complaint in this case: Ms. Kalra and Mr. Ramey signed the  
17 complaint on the final page under the jury demand language, Ms. Kalra signed the body of the  
18 complaint, both are identified on the face sheet and in the signature block on the final page as  
19 "Attorneys for Plaintiff," and Mr. Kubiak is further identified as one of the "Attorneys for  
20 Plaintiff" in the signature block on the final page. Both Mr. Ramey and Mr. Kubiak list their  
21 Texas bar numbers and include the notation "*pro hac vice* anticipated" in the signature block on  
22 the last page (and, for Mr. Ramey, on the face sheet) of that complaint. No application for *pro hac*  
23 *vice* admission was ever filed on behalf of either Mr. Ramey or Mr. Kubiak in the Second Action  
24 and certainly none was filed at the time of the filing of the complaint in that action.

25 At the hearing on August 22, 2024, counsel for Defendant brought to the Court's attention  
26 the fact that Mr. Ramey has appeared as counsel on pleadings in numerous cases in this District  
27 prior to the current action. Based on the Court's further investigation, it appears that Mr. Ramey  
28 and Mr. Kubiak have regularly litigated cases in this Court without being members of the Bar of

1 this Court and without seeking *pro hac vice* admission in virtually all of these prior cases.

2 The Court has identified at least fifty-three (53) **other** civil actions in the Northern District  
 3 of California in which Mr. Ramey registered as an attorney of record on the docket, or at a  
 4 minimum, signed the pleadings identifying himself to be the plaintiff's counsel with "*pro hac*  
 5 *vice*" status or "*pro hac vice* anticipated" (where forty-three of those fifty-three cases are from the  
 6 last two years alone). See *VDPP, LLC v. Roku, Inc.*, No. 5:24-cv-05303-VKD (filed 8/16/24)  
 7 (signed complaint with "*pro hac vice*"); *mCom IP, LLC v. WestAmerica Bancorporation*, No.  
 8 3:24-cv-03609-SK (filed 6/14/24) (signed jury demand with "*pro hac vice* anticipated");  
 9 *Autonomous IP, LLC v. Lyft, Inc.*, No. 3:24-cv-03348-RFL (filed 6/4/24) (attorney to be noticed);  
 10 *Linfo IP, LLC v. Alibaba Grp. (U.S.) Inc.*, No. 3:24-cv-03098-RS (filed 5/22/24) (lead attorney);  
 11 *WFR IP, LLC v. Alibaba Grp. (U.S.) Inc.*, No. 3:24-cv-02179-TSH (filed 4/12/24) (signed  
 12 complaint with "*pro hac vice*"); *Linfo IP, LLC v. Third Love, Inc.*, No. 4:24-cv-02195-HSG (filed  
 13 4/12/24) (signed complaint with "*pro hac vice*"); *Flick Intelligence, LLC v. HTC Am. Inc.*, No.  
 14 5:24-cv-02201-NC (filed 4/12/24) (signed complaint with "*pro hac vice* anticipated"); *PacSec3,*  
 15 *LLC v. Radware, Inc.*, No. 3:24-cv-02146-AGT (filed 4/10/24) (signed complaint with "*pro hac*  
 16 *vice* anticipated"); *VDPP, LLC v. Xiaomi USA, LLC*, No. 5:24-cv-01783-EKL (filed 3/22/24) (lead  
 17 attorney); *VDPP, LLC v. Vivitek Corp.*, No. 5:24-cv-01781-BLF (filed 3/22/24) (attorney to be  
 18 noticed); *VDDP, LLC v. Motorola Mobility LLC*, No. 3:24-cv-01672-LJC (filed 3/18/24) (lead  
 19 attorney); *WirelessWerx IP, LLC v. Lyft, Inc.*, No. 5:24-cv-01144-VKD (filed 2/26/24) (attorney to  
 20 be noticed); *WirelessWerx IP, LLC v. Wing Aviation LLC*, No. 4:24-cv-01040-YGR (filed  
 21 2/21/24) (signed jury demand with "*pro hac vice* anticipated"); *SmartWatch MobileConcepts, LLC*  
 22 *v. Google, LLC*, No. 3:24-cv-00937-RFL (filed 2/16/24) (lead attorney); *Missed Call, LLC v.*  
 23 *Twilio Inc.*, No. 3:24-cv-00681-LB (filed 2/5/24) (lead attorney); *Missed Call, LLC v.*  
 24 *RingCentral, Inc.*, No. 3:23-cv-06728-TLT (filed 12/31/23) (signed jury demand with "*pro hac*  
 25 *vice* anticipated"); *Missed Call, LLC v. 8x8, Inc.*, No. 3:23-cv-06723-VC (filed 12/30/23) (signed  
 26 jury demand with "*pro hac vice* anticipated"); *WirelessWerx IP, LLC v. OnFleet, Inc.*, No. 3:23-  
 27 cv-06724-AMO (filed 12/30/23) (signed complaint and jury demand with "*pro hac vice*  
 28 anticipated"); *WirelessWerx IP, LLC v. Life360, Inc.*, No. 3:23-cv-06725-AMO (filed 12/30/23)



(signed complaint and jury demand with “*pro hac vice* anticipated”); *Mesa Digital, LLC v. Quanta Comp. USA, Inc.*, No. 3:23-cv-06711-VC (filed 12/29/23) (signed jury demand with “*pro hac vice* anticipated”); *CyboEnergy, Inc. v. N. Elec. Power Tech., Inc.*, No. 4:23-cv-06121-JST (filed 11/27/23) (signed complaint with “*pro hac vice* anticipated”); *Koji IP, LLC v. Energous Corp.*, No. 4:23-cv-05750-HSG (filed 11/8/23) (attorney to be noticed); *Vilox Techs., LLC v. Salesforce, Inc.*, No. 3:23-cv-05047-AMO (filed 10/2/23) (attorney to be noticed); *Fare Techs. LLC v. Lyft, Inc.*, No. 3:23-cv-04935-RFL (filed 9/26/23) (attorney to be noticed); *Flick Intelligence, LLC v. Google, LLC*, No. 3:23-cv-04803-TLT (filed 9/19/23) (attorney to be noticed); *HyperQuery, LLC v. LG Elecs. U.S.A., Inc.*, No. 3:23-cv-04725-JCS (filed 9/14/23) (attorney to be noticed); *VDPP, LLC v. Vivo, Inc.*, No. 5:23-cv-04241-NC (filed 8/18/23) (lead attorney); *Ask Sydney, LLC v. Google, LLC*, No. 3:23-cv-03955-JD (filed 8/8/23) (attorney to be noticed); *Safecast Ltd. v. Google, LLC*, No. 5:23-cv-03128-PCP (filed 6/23/23) (lead attorney); *Haley IP, LLC v. Motive Techs., Inc.*, No. 4:23-cv-02923-HSG (filed 6/14/23) (lead attorney); *ALD Social, LLC v. Apple, Inc.*, No. 3:23-cv-02695-JSC (filed 5/31/23) (attorney to be noticed); *Silent Commc’n, LLC v. Adobe, Inc.*, No. 3:23-cv-02696-TLT (filed 5/31/23) (attorney to be noticed); *Flick Intelligence LLC v. Niantic, Inc.*, No. 3:23-cv-02219-TLT (filed 5/5/23) (jury demand with “*pro hac vice* anticipated”); *WirelessWerx IP, LLC v. Google, LLC*, No. 4:23-cv-01852-JST (filed 4/17/23) (attorney to be noticed); *WirelessWerx IP, LLC v. Uber Techs., Inc.*, No. 3:23-cv-00990-AMO (filed 3/3/23) (attorney to be noticed); *Street Spirit IP LLC v. Meta Platforms, Inc. f/k/a Facebook, Inc.*, No. 3:23-cv-00879-WHA (filed 2/27/23) (signed complaint and jury demand with “*pro hac vice* anticipated”); *Street Spirit IP LLC v. Instagram et al.*, No. 3:23-cv-00883-WHA (filed 2/27/23) (signed complaint and jury demand with “*pro hac vice* anticipated”); *Street Spirit IP LLC v. LinkedIn Corp.*, No. 3:23-cv-00884-AMO (filed 2/27/23) (signed complaint and jury demand with “*pro hac vice* anticipated”); *ALD Social LLC v. Verkada, Inc.*, No. 3:23-cv-00049-JSC (filed 1/5/23) (attorney to be noticed); *Escapex IP LLC v. Google LLC*, No. 3:22-cv-08711-VC (filed 12/13/22) (attorney to be noticed); *ESIGNATURE SOFTWARE, LLC v. Adobe, Inc.*, No. 3:22-cv-05962-JSC (filed 10/12/22) (attorney to be noticed); *Traxcell Techs., LLC v. Google LLC*, No. 3:22-cv-04807-JSC (filed 8/22/22) (lead attorney); *Valjakka v. Netflix, Inc.*, No. 4:22-cv-01490-

JST (filed 3/9/22) (lead attorney); *CyboEnergy, Inc. v. N. Elec. Power Tech., Inc.*, No. 3:21-cv-08534-SI (filed 11/2/21) (lead attorney); *Riggs Tech. Holdings, LLC v. Vagaro, Inc.*, No. 3:21-cv-07927-TSH (filed 10/8/21) (attorney to be noticed); *PacSec3, LLC v. Juniper Networks, Inc.*, No. 5:21-cv-07812-EJD (filed 10/6/21) (attorney to be noticed); *Apple Inc. v. Traxcell Techs. LLC*, No. 3:21-cv-06059-EMC (filed 8/5/21) (attorney to be noticed); *DATREC, LLC v. PrognoCIS, Inc.*, No. 3:21-cv-01595-JCS (filed 3/5/21) (lead attorney); *NetSoc, LLC v. LinkedIn Corp.*, No. 3:20-cv-00483-VC (filed 1/22/20) (lead attorney); *NetSoc, LLC v. Quora, Inc.*, No. 3:19-cv-06518-VC (filed 10/11/19) (lead attorney); *Global Equity Mgmt. (SA) Pty. Ltd. v. Alibaba.com Inc.*, No. 3:17-cv-02177-WHA (filed 4/19/17) (lead attorney); *Global Equity Mgmt. (SA) Pty. Ltd. v. eBay, Inc.*, No. 3:17-cv-02178-WHA (filed 4/19/17) (lead attorney); *Global Equity Mgmt. (SA) Pty. Ltd. v. Alibaba Grp. Holding, Ltd.*, No. 3:17-cv-02435-WHA (filed 4/28/17) (attorney of record).

It appears that Mr. Ramey sought *pro hac vice* admittance in only seven (7) of those fifty-three (53) cases (and as discussed he never filed a *pro hac vice* application in this Third Action or in the Second Action). See *WirelessWerx IP, LLC v. Lyft, Inc.*, No. 5:24-cv-01144-VKD (application filed on 4/29/24 averring *pro hac vice* granted “0” times in the prior twelve months); *Safecast Ltd. v. Google, LLC*, No. 5:23-cv-03128-PCP (application filed on 8/3/23 averring *pro hac vice* granted “1” time in the prior twelve months); *Traxcell Techs., LLC v. Google LLC*, No. 3:22-cv-04807-JSC (application filed on 10/28/22 averring *pro hac vice* granted “3” times in the prior twelve months); *CyboEnergy, Inc. v. N. Elec. Power Tech., Inc.*, No. 3:21-cv-08534-SI (application filed on 3/23/22 averring *pro hac vice* granted “1” time in the prior twelve months); *Apple Inc. v. Traxcell Techs. LLC*, No. 3:21-cv-06059-EMC (application filed on 2/8/22 averring *pro hac vice* granted “n/a” times in the prior twelve months); *DATREC, LLC v. PrognoCIS, Inc.*, No. 3:21-cv-01595-JCS (application filed on 4/14/21); *NetSoc, LLC v. Quora, Inc.*, No. 3:19-cv-06518-VC (application filed on 11/26/19).

The Court has likewise identified at least seventeen (17) **other** cases (not including this case or the Second Action) in the Northern District of California in which Mr. Kubiak registered as an attorney of record on the docket, or at a minimum, is designated in the pleadings as a party’s

counsel with “*pro hac vice*” or “*pro hac vice anticipated*” status. *See VDPP, LLC v. Roku, Inc.*, No. 5:24-cv-05303-VKD (filed 8/16/24) (“*pro hac vice*”); *mCom IP, LLC v. WestAmerica Bancorporation*, No. 3:24-cv-03609-SK (filed 6/14/24) (“*pro hac vice anticipated*”); *Autonomous IP, LLC v. Lyft, Inc.*, No. 3:24-cv-03348-RFL (filed 6/4/24) (lead attorney); *Linfo IP, LLC v. Alibaba Grp. (U.S.) Inc.*, No. 3:24-cv-03098-RS (filed 5/22/24) (“*pro hac vice anticipated*”); *WFR IP, LLC v. Alibaba Grp. (U.S.) Inc.*, No. 3:24-cv-02179-TSH (filed 4/12/24) (“*pro hac vice*”); *Linfo IP, LLC v. Third Love, Inc.*, No. 4:24-cv-02195-HSG (filed 4/12/24) (“*pro hac vice*”); *VDPP, LLC v. Xiaomi USA, LLC*, No. 5:24-cv-01783-EKL (filed 3/22/24) (“*pro hac vice*”); *WirelessWerx IP, LLC v. Wing Aviation LLC*, No. 4:24-cv-01040-YGR (filed 2/21/24) (“*pro hac vice anticipated*”); *SmartWatch MobileConcepts, LLC v. Google, LLC*, No. 3:24-cv-00937-RFL (filed 2/16/24) (attorney to be noticed); *Missed Call, LLC v. RingCentral, Inc.*, No. 3:23-cv-06728-TLT (filed 12/31/23) (“*pro hac vice anticipated*”); *Missed Call, LLC v. 8x8, Inc.*, No. 3:23-cv-06723-VC (filed 12/30/23) (“*pro hac vice anticipated*”); *WirelessWerx IP, LLC v. OnFleet, Inc.*, No. 3:23-cv-06724-AMO (filed 12/30/23) (“*pro hac vice anticipated*”); *WirelessWerx IP, LLC v. Life360, Inc.*, No. 3:23-cv-06725-AMO (filed 12/30/23) (“*pro hac vice anticipated*”); *Koji IP, LLC v. Energous Corp.*, No. 4:23-cv-05750-HSG (filed 11/8/23) (“*pro hac vice anticipated*”); *Flick Intelligence, LLC v. Google, LLC*, No. 3:23-cv-04803-TLT (filed 9/19/23) (lead attorney); *Haley IP, LLC v. Motive Techs., Inc.*, No. 4:23-cv-02923-HSG (filed 6/14/23) (lead attorney); *Silent Commc’n, LLC v. Adobe, Inc.*, No. 3:23-cv-02696-TLT (filed 3/31/23) (attorney to be noticed).

Mr. Kubiak appears to have sought *pro hac* admission in this Court only one time ever. *See SmartWatch MobileConcepts, LLC v. Google, LLC*, No. 3:24-cv-00937-RFL (application filed on 5/22/24 averring that Mr. Kubiak had been granted *pro hac* admission by the Court “0” times in the twelve months preceding the application). In that application for *pro hac vice* admission, Mr. Kubiak identifies Ms. Kalra as his local co-counsel. *Id.*

At the August 22, 2024 hearing, counsel for Defendant brought to the Court’s attention that Mr. Ramey has appeared as counsel in numerous cases in the Central District of California. Based on the Court’s investigation thus far, Mr. Ramey has appeared as counsel in at least thirty-

seven cases in the Central District of California (thirty-three of which were filed in 2022 or later) and Mr. Kubiak has appeared as counsel in at least ten of those cases. It appears that Mr. Ramey and Mr. Kubiak have similarly failed to seek *pro hac vice* admission in many of those cases despite receiving notices from that court that their *pro hac vice* applications were due, and they appear to have continued to litigate those cases even after receiving such notices. *See, e.g.*, Notice of Pro Hac Vice Application Due, *VDPP, LLC v. Mazda Motor of Am. Inc.*, No. 8:24-cv-00571-JWH-ADS (C.D. Cal. Mar. 18, 2004), ECF No. 11.

The Court may impose sanctions for violations of its local rules concerning *pro hac vice* admission. *See* Civil L.R. 11-8 (“A person who exercises, or pretends to be entitled to exercise, any of the privileges of membership in the bar of this Court, when that person is not entitled to exercise such privileges, may be referred to the Standing Committee in addition to any action authorized by applicable law.”) It is axiomatic that the Court has authority to enforce its local rules. 28 U.S.C. § 2071. A district court’s Order regarding compliance with local rules is reviewed for abuse of discretion and broad deference is given to a court’s interpretation of its local rules. *Bias v. Moynihan*, 508 F.3d 1212, 1223 (9th Cir. 2007).

Canon 3(B)(6) for the Code of Conduct for United States Judges provides that “[a] judge should take appropriate action upon receipt of reliable information indicating the likelihood that . . . a lawyer violated applicable rules of professional conduct.” The unauthorized practice of law and the aiding of another’s unauthorized practice of law violate California’s ethical rules and such conduct may lead to disciplinary proceedings and other adverse consequences. *See* California Rules of Professional Conduct 5.5(a)-(b); State Bar of California Rule 1-300 (prohibiting unauthorized practice of law); Cal. Bus. & Prof. Code § 6125 (“No person shall practice law in California unless the person is an active member of the State Bar.”). The unauthorized practice of law and the aiding of another’s unauthorized practice of law also violate this Court’s standards for professional conduct and may lead to disciplinary proceedings and other adverse consequences.

Mr. Ramey and Mr. Kubiak are both members of the State Bar of Texas. The Texas Disciplinary Rules of Professional Conduct provide, among other things, that a lawyer shall not “practice law in a jurisdiction where doing so violates the regulation of the legal profession in that

jurisdiction[.]” Texas Disciplinary Rule of Professional Conduct 5.05(a). A lawyer is subject to sanctions by the State Bar of Texas “for conduct occurring in another jurisdiction or resulting in lawyer discipline in another jurisdiction.” *See* Texas Rules of Disciplinary Procedure CC.2 (defining sanctionable attorney conduct to include “[a]ttorney conduct that occurs in another jurisdiction, including before any federal court or federal agency, and results in the disciplining of an attorney in that other jurisdiction”).

As noted, these attorneys filed three cases on behalf of this same Plaintiff against this same Defendant asserting infringement of the same patent in each case. The first of the three cases was filed in the District of Colorado. *See* Complaint, *Koji I*, No. 23-cv-01674-SKC (D. Colo. June 30, 2023), ECF No. 1. Mr. Ramey signed the complaint in the First Action, he is listed as counsel on the civil cover sheet, and he signed the notice of voluntary dismissal. The complaint in the First Action lists both Mr. Ramey and Mr. Kubiak as “Attorneys for KOJI IP, LLC.” The Court takes judicial notice that Mr. Ramey, Mr. Kubiak, and Ms. Kalra are all members in good standing of the District of Colorado’s Bar. The District of Colorado’s Standards of Professional Conduct adopt the Colorado Rules of Professional Conduct for members of the state bar of Colorado. D.C. Colo. LAttyR 2(a). The Colorado Rules of Professional Conduct provide, among other things, that a lawyer shall not “practice law in a jurisdiction where doing so violates the regulation of the legal profession in that jurisdiction[.]” Colo. RPC 5.5(a)(2).

As noted, the current case (and the previously dismissed cases) are patent infringement cases filed by these attorneys on behalf of Koji against Renesas, asserting infringement of the same ‘703 patent in each case. The Court takes judicial notice that Mr. Ramey and Mr. Kubiak are registered to practice as patent attorneys before the United States Patent and Trademark Office (“USPTO”). The USPTO’s Rules of Professional Conduct provide, among other things, that a “practitioner shall not practice law in a jurisdiction in violation of the regulation of the legal profession in that jurisdiction, or assist another in doing so.” 37 C.F.R. § 11.505. A registered patent attorney is subject to discipline for “professional misconduct” by the USPTO where misconduct includes being “publicly disciplined on ethical or professional misconduct grounds by any duly constituted authority of: (1) A State, [or] (2) The United States.” *Id.* § 11.804(h)(1)-(2).

As discussed herein, these attorneys are **ORDERED** to show cause why they should not be disciplined and why they should not be referred to appropriate authorities for (1) the unauthorized practice of law by Mr. Ramey and/or Mr. Kubiak, and/or (2) the aiding and abetting of each of their unauthorized practice of law.

## II. Rule 11 Violations

As discussed above, on June 26, 2024, Defendant filed a motion for attorneys' fees under 35 U.S.C. § 285. *See* Dkt. 18. Based on the Parties' briefing on that motion as well as the representations of counsel during the August 22, 2024 hearing, the Court is concerned that the pre-suit investigation conducted by Plaintiff's counsel prior to filing the complaint was inadequate such that Rule 11 sanctions are warranted.

Federal Rule of Civil Procedure 11 requires at least one counsel of record to sign every pleading, written motion, or other paper presented to the Court. Fed. R. Civ. P. 11(a). "By presenting to the court a pleading, written motion, or other paper—whether by signing, filing, submitting, or later advocating it—" the attorney certifies that the paper is not "frivolous" or meant to further "any improper purpose" and that it was submitted "after an inquiry reasonable under the circumstances." Fed. R. Civ. P. 11(b).

Rule 11 authorizes the Court to impose sanctions on an attorney who fails to conduct a reasonable pre-filing inquiry if the paper at issue lacks merit or is otherwise frivolous. *In re Keegan Mgmt. Co. Sec. Litig.*, 78 F.3d 431, 434 (9th Cir. 1996). Sanctions imposed under Rule 11 are limited to that which is sufficient to deter "repetition of such conduct or comparable conduct by others similarly situated." Fed. R. Civ. P. 11(c)(2). Rule 11 sanctions may include nonmonetary directives, orders to pay penalties to the court, and monetary awards for "reasonable attorney's fees and other expenses directly resulting from the violation." Fed. R. Civ. P. 11(c)(4). The Court has substantial discretion regarding the application of Rule 11 sanctions. *See* Fed. R. Civ. P. 11(b)(3).

The standard for determining whether a paper is frivolous is one of objective reasonableness at the time of the attorney's signature. *Christian v. Mattel, Inc.*, 286 F.3d 1118, 1127 (9th Cir. 2002). "Frivolous filings are 'those that are both baseless and made without a



reasonable and competent inquiry.” *Est. of Blue v. Cnty. of L.A.*, 120 F.3d 982, 985 (9th Cir. 1997) (quoting *Buster v. Griesen*, 104 F.3d 1186, 1190 (9th Cir. 1997)). Before imposing Rule 11 sanctions, the Court “must conduct a two-prong inquiry to determine: (1) whether the complaint is legally or factually ‘baseless’ from an objective perspective, and (2) if the attorney has conducted ‘a reasonable and competent inquiry’ before signing and filing it.” *Christian*, 286 F.3d at 1127.

As discussed, this is the third case in which one or more of the Ramey LLP attorneys signed a complaint on behalf of the same Plaintiff against the same Defendant asserting infringement of the same patent. The first two cases were voluntarily dismissed under Rule 41(a)(1)(A)(i) pursuant to notices of dismissal filed by one or more of these same attorneys. Under Rule 41(a)(1)(B), the second dismissal “operates as an adjudication on the merits.” At the August 22, 2024 hearing, Ms. Kalra was unable to identify any pre-filing inquiry by herself or any other Ramey LLP attorney (much less reasonable inquiry supported by law) regarding the effect of Rule 41 on whether or not the complaint in this Third Action was warranted by existing law or any other permissible basis under Rule 11. Ms. Kalra was equally unable to identify whether any of the Ramey LLP lawyers performed any pre-filing inquiry as to the impact of the dismissal filed in the Second Action prior to the filing of that dismissal. At the hearing and in the briefing, Plaintiff’s counsel was unable to cite any law of which they were aware *prior to filing the complaint in this (the third case)* which reasonably supported the position that the dismissals of the complaints in the previous two actions failed to avoid an adjudication on the merits under Rule 41, and thus, which reasonably supported the filing of the third complaint.

Further, in the context of patent infringement actions, Rule 11 “require[s] that an attorney interpret the pertinent claims of the patent at issue before filing a complaint alleging patent infringement.” *Antonious v. Spalding & Evenflo Cos., Inc.*, 275 F.3d 2066, 1072 (Fed. Cir. 2002). “[A]n attorney’s proposed claim construction is subject to the Rule 11(b)(2) requirement that all legal arguments be nonfrivolous.” *Id.* Rule 11 requires that the attorney compare the accused device with the construed patent claims; this is a question of fact and must therefore comply with Rule 11(b)(3)’s requirement that all allegations and factual contentions have evidentiary support. *Id.* at 1073-74. “The attorney may consult with his client but *may not rely solely on the client’s*



1 *lay opinion* that the accused device infringes the patent.” *Id.* at 1074 (emphasis added). Rule 11  
2 requires, at a minimum, “that an attorney interpret the asserted patent claims and compare the  
3 accused device with those claims before filing a claim alleging infringement.” *Q-Pharma, Inc. v.*  
4 *Andrew Jergens Co.*, 360 F.3d 1295, 1300 (Fed. Cir. 2004).

5 Based on the information presented to the Court to date, it appears that Ms. Kalra and Mr.  
6 Kubiak did not themselves perform any infringement analysis at all under Rule 11 prior to filing  
7 the complaints in either the Second Action or this Third Action. The record indicates that prior to  
8 filing the complaint in both lawsuits, Mr. Ramey relied entirely on an infringement study  
9 performed by a non-attorney consultant, Mr. Sunatori. Nothing presented to the Court  
10 demonstrates that either of the attorneys who signed the complaints undertook any interpretation  
11 of the asserted patent claims prior to the filing of those documents pursuant to Rule 11. And  
12 nothing presented indicates that either Ms. Kalra or Mr. Ramey compared the accused devices  
13 with those claims, as interpreted, prior to filing the complaints in the Second Action or this Third  
14 Action. It appears that Ms. Kalra and Mr. Ramey relied entirely on the lay opinion of Mr.  
15 Sunatori prior to filing the complaints in both actions.

16 Accordingly, the Court is concerned that Rule 11 violations occurred with regard to the  
17 lack of pre-filing diligence regarding the impact of the prior dismissals on the complaint in this  
18 case under Rule 41, as well as the lack of adequate pre-filing diligence regarding the infringement  
19 analysis prior to the filing of the complaints in both the Second Action and this Third Action.

20 Therefore, as discussed herein, these attorneys are **ORDERED** to show cause why they  
21 should not be sanctioned under Rule 11 with regard to (1) their pre-filing inquiry and the baseless  
22 assertion of the Third Complaint under Rule 41, and/or (2) their pre-filing inquiry and the baseless  
23 assertion of the infringement allegations in the Third Complaint.

### 24 **III. Court’s Inherent Authority**

25 As discussed above, the Court is concerned about the action (or inaction) by Attorneys  
26 Ramey, Kalra, and Kubiak in a number of areas. As noted, Mr. Kubiak appears on the pleadings  
27 in the Second Action and in this Third Action, but he did not himself sign the pleadings. Further,  
28 at the August 22, 2024 hearing, Ms. Kalra attempted to raise, but then withdrew, an argument that

1 this Court somehow lacks jurisdiction to consider disciplining either Mr. Ramey or Mr. Kubiak  
2 because they were never admitted *pro hac vice* in this case. As the Court indicated at that hearing,  
3 the Court is prepared to grant them *pro hac vice* status sua sponte to address any such procedural  
4 argument, if any is raised. The Court further recognizes that Mr. Ramey signed the last page of  
5 each of the complaints in the Second and Third Actions but not the penultimate page of those  
6 documents. The Court is cognizant of the possibility that Mr. Ramey may argue that Rule 11 does  
7 not reach his conduct because he did not sign the body of the complaints but only the pages with  
8 the jury demands. The Court recognizes that Mr. Kubiak did not himself personally sign the  
9 Second or Third Complaints but is listed as one of the Attorneys for Plaintiff on those pleadings.

10 Accordingly, the Court further **ORDERS** all three attorneys to show cause why they  
11 should not be sanctioned under the Court's inherent powers with regard to their conduct discussed  
12 herein. *See Chambers v. NASCO, Inc.*, 501 U.S. 32, 50 (1991) ("A court must, of course, exercise  
13 caution in invoking its inherent power, and it must comply with the mandates of due process, both  
14 in determining that the requisite bad faith exists and in assessing fees. . . . Furthermore, when there  
15 is bad-faith conduct in the course of litigation that could be adequately sanctioned under the rules,  
16 the court ordinarily should rely on the rules rather than the inherent power. But if in the informed  
17 discretion of the court, neither the statute nor the rules are up to the task, the court may safely rely  
18 on its inherent power.").

19 As detailed above, there are three general categories of conduct which the Court is  
20 considering with regard to whether sanctions are appropriate under the full breadth of the Court's  
21 inherent powers: (1) the unauthorized practice of law and/or abetting the unauthorized practice of  
22 law; (2) inadequate pre-filing inquiry regarding the impact of the prior dismissals under Rule 41  
23 before the complaint was filed in this Third Action; and (3) inadequate pre-filing analysis of  
24 infringement (including claim interpretation in light of the specification and file history) by these  
25 attorneys prior to the filing of the complaints in the Second Action and in this Third Action.

26 Accordingly, **IT IS ORDERED THAT:**

- 27 1. By no later than **September 12, 2024**, Attorneys William P. Ramey, III, Jeffrey E. Kubiak,  
28 and Susan S.Q. Kalra shall each respond in writing to this Order and shall **SHOW CAUSE**


as to why this Court should not take appropriate action, including imposing sanctions, for their conduct discussed in detail herein.

2. The responses from each of these attorneys shall address all of the conduct and issues discussed here, and shall specifically address: (a) whether Mr. Ramey or Mr. Kubiak has engaged in the unauthorized practice of law in this Court and in California (and if not, why not); (b) whether Ms. Kalra has aided or abetted the unauthorized practice of law by these individuals in this Court and in California (and if not, why not); (c) whether Mr. Ramey or Mr. Kubiak has aided or abetted the unauthorized practice of law by the other in this Court and in California (and if not, why not); (d) whether these attorneys performed any reasonable pre-filing inquiry regarding the impact of the earlier dismissals **before** they filed the complaint in this case (and if so, what that inquiry consisted of); (e) whether these attorneys performed any reasonable pre-filing infringement analysis (including claim interpretation) **before** they filed the complaints in the Second Action and in this Third Action (and if so, what that pre-filing inquiry consisted of). Each of these attorneys **SHALL** submit declarations under penalty of perjury in support of their showings.
3. If the responses to this Order (including the declarations) do not show sufficient cause, the Court will consider sanctions. Accordingly, the responses shall also specifically address (a) whether the Court should report this matter (and/or Order these attorneys to self-report) to the State Bar of California, the State Bar of Texas, the Bar of the U.S. District Court for the District of Colorado, the U.S. Patent and Trademark Office, or other state bars; (b) whether the Court should refer this matter to the Northern District of California's Standing Committee of Professional Conduct and/or the Northern District of California's Chief District Judge for further investigation; and (c) whether the Court should impose monetary sanctions, non-monetary directives, and/or other discipline on these attorneys, and if so, in what amount or form.
4. As discussed at the August 22, 2024 hearing, an in-person Order to Show Cause Hearing is **SET** for **September 19, 2024 at 10:30 a.m.** in the San Francisco courthouse, Courtroom F before the undersigned. Ms. Kalra is **ORDERED** to provide a courtesy copy of this Order

1 to Mr. Ramey and Mr. Kubiak promptly. The Court **ORDERS** Mr. Ramey, Mr. Kubiak,  
2 and Ms. Kalra to attend **IN PERSON**. Remote appearances will not be permitted.

3 **IT IS SO ORDERED.**

4 Dated: August 29, 2024

5   
6 PETER H. KANG  
United States Magistrate Judge

United States District Court  
Northern District of California

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10  
11 **IN THE UNITED STATES DISTRICT COURT**  
12 **FOR THE NORTHERN DISTRICT OF CALIFORNIA**  
13 **SAN FRANCISCO DIVISION**

14 KOJI IP, LLC,  
15  
16 Plaintiff,  
17  
18 v.  
19  
20 RENESAS ELECTRONICS AMERICA,  
21 INC.,  
22  
23 Defendant.

Case No.: 3:24-cv-03089-PHK

24 **RAMEY LLP'S RESPONSE TO SHOW**  
25 **CAUSE ORDER**

26 **Date: September 19, 2024**  
27 **Time: 10:30 a.m.**  
28 **Magistrate Judge Peter H. Kang**

**TABLE OF CONTENTS**

I.	INTRODUCTION AND RESPONSE TO THE ALLEGED UNAUTHORIZED PRACTICE OF LAW .....	1
II.	RELEVANT FACTUAL BACKGROUND.....	4
III.	RELEVANT LAW .....	10
IV.	ARGUMENT - SANCTIONS UNDER RULE 11 OR THE COURT’S INHERENT POWER ARE NOT WARRANTED.....	11
A.	Plaintiff Conducted an Adequate Pre-suit Investigation.....	17
B.	Ramey LLP’s Lawyers Conduct Was Very Reasonable .....	18
C.	There Was No Merit Decision Of Plaintiff’s Claims.....	19
D.	Rule 11 Sanctions are Not Warranted.....	19
E.	Sanctions Under the Court’s Inherent Power are Not Warranted.....	22
F.	Sanctions Under §1927, Rule 11 or the Court’s Inherent Power are not Warranted.....	24
V.	CONCLUSION.....	25

## TABLE OF AUTHORITIES

### Cases

<i>Antonious v. Spalding &amp; Evenflo Companies, Inc.</i> , 275 F.3d 1066 .....	10, 20
<i>Checkpoint Sys., Inc. v. All-Tag Sec. S.A.</i> , 858 F.3d 1371 (Fed. Cir. 2017) .	11, 18, 24
<i>Edwards v. Gen. Motors Corp.</i> , 153 F.3d 242 (5 <sup>th</sup> Cir.1998) .....	11, 24
<i>Fed. Deposit Ins. Corp. v. Maxxam, Inc.</i> , 523 F.3d 566 (5 <sup>th</sup> Cir. 2008).....	10
<i>Gomez v. Vernon</i> , 255 F.3d 1118 (9 <sup>th</sup> Cir. 2001).....	1, 10, 22
<i>In re Crystal Cathedral Ministries</i> , No. 2:12-BK-15665-RK, 2020 WL 1649619, (Bankr. C.D. Cal. Mar. 31, 2020), aff'd, No. 2:12-BK-15665-RK, 2021 WL 2182975 (B.A.P. 9 <sup>th</sup> Cir. May 28, 2021) .....	20, 23
<i>In re Keegan Mgmt. Co., Sec. Litig.</i> , 78 F.3d 431 (9 <sup>th</sup> Cir. 1996) .....	15, 17, 23
<i>Jenkins v. Methodist Hosp. of Dallas</i> , 478 F.3d 255 (5 <sup>th</sup> Cir. 2007) .....	10
<i>Johnson Worldwide Assocs. v. Zebco Corp.</i> , 175 F.3d 985 (Fed. Cir. 1999).....	16
<i>Judin v. United States</i> , 110 F.3d 780 (Fed. Cir. 1997) .....	17, 20
<i>MeetrixIP, LLC v. Citrix Sys., Inc.</i> , No. 1:16-CV-1033-LY, 2017 WL 5986191 (W.D. Tex. Dec. 1, 2017) .....	16
<i>Milkcrate Athletics, Inc. v. Adidas Am., Inc.</i> , 619 F. Supp. 3d 1009 (C.D. Cal. 2022) .....	14, 15, 20
<i>N. Telecom Ltd. v. Samsung Elecs. Co.</i> , 215 F.3d 1281 (Fed. Cir. 2000) .....	16
<i>Park-In-Theatres v. Perkins</i> , 190 F.2d 137 (9 <sup>th</sup> Cir. 1951) .....	12
<i>Phillips v. AWH Corp.</i> , 415 F.3d 1303 (Fed. Cir. 2005) ( <i>en banc</i> ).....	16
<i>Pisony v. Commando Construction, Inc.</i> , W-17-CV-00055-ADA, 2019 WL 928406 (W.D. Tex. Jan. 23, 2019) .....	16
<i>Shopify Inc. v. Express Mobile, Inc.</i> , No. 20-MC-80091-JSC, 2020 WL 4732334 (N.D. Cal. Aug. 14, 2020) .....	3
<i>Thorner v. Sony Computer Entm't Am. LLC</i> , 669 F.3d 1362, 1365 (Fed. Cir. 2012) .....	16



1	United Energy Owners Comm., Inc. v. United States Energy Management	
2	Systems, Inc., 837 F.2d 356 (9 <sup>th</sup> Cir. 1988).....	10
3	<i>View Eng'g, Inc. v. Robotic Vision Sys., Inc.</i> , 208 F.3d 981	
4	(Fed.Cir.2000).....	1, 14, 15
5	<i>Watts v. XLSys., L.P.</i> , No. 1:06-cv-653-LY, 2008 WL 5731945 (W.D. Tex.	
6	July 1, 2008).....	16
7	<b>Rules &amp; Regulations</b>	
8	Fed. R. Civ. P. 11(b)(1).....	10, 19

1 Ramey LLP ("Ramey LLP") files this Response to the Court's Show Cause Order dated  
2 August 29, 2024 ("Show Cause Order")<sup>1</sup> showing the Court that the Show Cause Order should  
3 be discharged without further order because:<sup>2</sup>

- 4 1. Ramey and all other attorneys at Ramey LLP were representing clients in California  
5 under the California Bar license of Susan Kalra and as Registered Patent Agents of  
6 the United States Patent & Trademark Office;
- 7 2. Ramey LLP's attorneys complied with its prefiling investigation by charting the  
8 accused product against a claim of the '703 patent;<sup>3</sup> and,
- 9 3. The conduct of Ramey LLP's attorneys was not in bad faith, or conduct that  
10 constituted or was tantamount to bad faith, to support a sanction under the Court's  
11 inherent power.<sup>4</sup>

12  
13  
14 **I. INTRODUCTION AND RESPONSE TO THE ALLEGED UNAUTHORIZED**  
15 **PRACTICE OF LAW**

16 Ramey LLP and its lawyers, William P. Ramey, III; Susan Kalra; and, Jeffrey Kubiak,  
17 respectfully respond to the Court's Show Cause Order<sup>5</sup> by first acknowledging that immediately  
18 upon Ms. Kalra reporting of the August 22, 2024 hearing, changes were made into the practice  
19 at Ramey LLP for all matters, including:

- 20  
21 1. For all matters, only admitted attorney's names are on pleadings, whether as a  
22

23  
24  
25 <sup>1</sup> Doc. No. 27.

26 <sup>2</sup> This response is filed on behalf of William P. Ramey, III, Susan Kalra and Jeffrey Kubiak,  
each of which has filed sworn declarations in support of this response.

27 <sup>3</sup> See, e.g., *View Eng'g, Inc. v. Robotic Vision Sys., Inc.*, 208 F.3d 981, 986 (Fed.Cir.2000).

28 <sup>4</sup> *Gomez v. Vernon*, 255 F.3d 1118, 1134 (9th Cir. 2001).

<sup>5</sup> Doc. No. 27.

1 member of the bar or by pro hac vice and

2 2. No longer is an attorney be listed on pleadings as *pro hac vice anticipated* or  
3 otherwise unless that attorney is admitted.<sup>6</sup>  
4

5 Ramey LLP did not intend by its use of *pro hac vice anticipated* to indicate that it was practicing  
6 law in California or aiding another's practice of law.<sup>7</sup> It has always been the practice of Ramey  
7 LLP to work under the bar admission of Susan Kalra on cases pending in California.<sup>8</sup> Ramey  
8 LLP is not aware of any case where Ms. Kalra was not listed as the attorney of record but  
9 acknowledges that *pro hac vice* applications were not filed in all cases for the other attorneys.<sup>9</sup>  
10

11  
12 Ramey LLP always intended to file a motion pro hac vice as a case progressed, once past  
13 pleading stage.<sup>10</sup> A decision was made by William Ramey, at the request of Carlos  
14 Gorrichategui in early 2022, a client manager, to attempt reduce costs on cases that resolved  
15 quickly, by not automatically filing a request for *pro hac vice* application.<sup>11</sup> Beginning in around  
16 2022, Ramey LLP stopped filing for *pro hac vice* applications in all case but incorrectly left a  
17 signature line with an attorney, that, if the case progressed, would later seek *pro hac vice*  
18 admission.<sup>12</sup>  
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20  
21 While not intending to violate an ethical rule of the California State Bar, Rule of Practice  
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24 <sup>6</sup> Declaration of William P. Ramey, III ("Ramey Decl.") at ¶19.

25 <sup>7</sup> Ramey Decl. at ¶20.

26 <sup>8</sup> Ramey Decl. at ¶20.

27 <sup>9</sup> Ramey Decl. at ¶20.

28 <sup>10</sup> Ramey Decl. at ¶21.

<sup>11</sup> Ramey Decl. at ¶21.

<sup>12</sup> Ramey Decl. at ¶21.

1 of this Court, or an ethical rule or rule of practice of any other State Bar, licensing authority or  
2 court, Ramey LLP acknowledges that its prior practice was in error and has corrected that issue.  
3 However, at all times, Ms. Kalra was acting as lead attorney on all California matters and  
4 William Ramey and Jeffrey Kubiak were practicing under her license.<sup>13</sup> Further, as this Court  
5 acknowledged,<sup>14</sup> Mr. Ramey and Mr. Kubiak are licensed by the United States Patent &  
6 Trademark Office. Therefore, Mr. Ramey and Mr. Kubiak are authorized to advise its client  
7 Koji on issues of claim scope, validity, and claim coverage as it relates to the claims of the ‘703  
8 patent,<sup>15</sup> especially when working under the license of Ms. Kalra, who while having years of  
9 experience in analyzing patent claim scope is not licensed by the USPTO.<sup>16</sup>  
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12 Ramey LLP additionally left the signature block of Ramey and/or Kubiak on pleadings  
13 for Notice functions in an effort to assist Ms. Kalra who beginning in the summer of 2023,  
14 experienced some personal issues.<sup>17</sup> Ramey LLP and its lawyers were not intending to flout the  
15 rules of the court but rather work with a colleague going through a difficult period and making  
16 sure no filing got missed. There was no deceptive intent involved or intent to indicate that either  
17 William Ramey or Jeffrey Kubiak was licensed to practice law in California.<sup>18</sup> Further, Ms.  
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23 <sup>13</sup> Ramey Decl. at ¶22; Declaration of Susan Kalra (“Kalra Decl.”), at ¶¶2-4.

24 <sup>14</sup> Doc. No. 27 at 10.

25 <sup>15</sup> *Shopify Inc. v. Express Mobile, Inc.*, No. 20-MC-80091-JSC, 2020 WL 4732334, at \*5 (N.D.  
26 Cal. Aug. 14, 2020) (recognizing that individuals licensed by the USPTO may give opinions as  
to infringement).

27 <sup>16</sup> Ramey Decl. at ¶22; Kalra Decl. at ¶ 5.

28 <sup>17</sup> Ramey Decl. at ¶23; Kalra Decl. at ¶6; Supplemental Declaration of Susan Kalra (filed  
under seal).

<sup>18</sup> Ramey Decl. at ¶23; Kubiak Decl. at ¶14.

1 Kalra was not aiding or abetting the unauthorized practice of law as she was always licensed.<sup>19</sup>  
2 Each of William Ramey, Susan Kalra and Jeffrey Kubiak do not believe referral to a state bar,  
3 licensing authority or court for discipline is necessary. The conduct will not happen again and  
4 each lawyer apologizes to the Court. There was no intent by any lawyer at Ramey LLP to violate  
5 any ethical rule of rule of the Court.<sup>20</sup>  
6

## 7 **II. RELEVANT FACTUAL BACKGROUND**

8 Plaintiff Koji IP, LLC (“Koji”) sued Defendant Renesas Electronics America, Inc.,  
9 (“Renesas”) alleging that Renesas infringes U.S. Pat. Nos. 10,790,703 (“the ‘703 Patent”),  
10 entitled “Smart Wireless Power Transfer Between Devices” (“Patent-in-Suit”) in the District of  
11 Colorado on June 30, 2023.<sup>21</sup> The claim chart used with the original complaint was prepared  
12 through the collaboration of Simon Sunatori, William Ramey, and Carlos Gorrichategui.<sup>22</sup> Prior  
13 to filing, and afterwards, William Ramey believed that the claim chart showed infringement as  
14 the elements of claim 1 of the ‘703 patent were mapped against Defendant’s product.<sup>23</sup> In short,  
15 the claims of the patent were compared to the accused devices.<sup>24</sup>  
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18 Renesas’s in-house counsel and director of intellectual property, Mr. Masaki Yabe,  
19 directly contacted Mr. Ramey On July 3, 2023 about the lawsuit filed a few days earlier. Mr.  
20 Yabe offered to discuss a royalty rate for the alleged infringement and requested an extension,  
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25 <sup>19</sup> Ramey Decl. at ¶23 Kalra Decl. at ¶¶2-4, 22.

26 <sup>20</sup> Ramey Decl. at ¶23; Kalra Decl. at ¶22; Kubiak Decl. at ¶13-14.

27 <sup>21</sup> Ramey Decl. at ¶4.

28 <sup>22</sup> Ramey Decl. at ¶24; Declaration of Simon Sunatori (“Sunatori Decl.”) at ¶¶8-11;  
Declaration of Carlos Gorrichategui, Ph.D (“Gorrichategui Decl.”) at ¶¶2-4, 14.

<sup>23</sup> Doc. No. 1-2; Ramey Decl. at ¶¶24-26.

<sup>24</sup> Ramey Decl. at ¶¶24-26.

which was freely offered. On July 11, 2023, Mr. Yabe agreed to waive service of the summons.<sup>25</sup>

On July 20, 2023, Jason Crotty appeared as counsel for Renesas and opened a dialogue with Ramey LLP. Mr. Crotty asked that the suit be dismissed because there was low sales volume, Renesas disagreed with infringement, and stated venue was improperly based on a distributor.<sup>26</sup> Koji immediately began communicating with Defendant about the case, including both infringement and Defendant's contention that venue was improper.<sup>27</sup> For venue, Koji provided evidence that it believed showed that Renesas controlled the sales agent, in that Renesas listed the location as its location:

The screenshot shows the 'Sales Locations' page on the Renesas website. It includes a search filter for 'Country / Region' (set to 'Any') and 'Type' (with options for Distributor, Sales Representative, and Value Added Reseller). Below the filter is a table of sales locations.

Location	Description	Contact Info	Type
Mountain US	<b>AKI GIBB</b> Colorado & Wyoming: 2181 So. Grape St Denver, CO 80222 Utah, Idaho, Montana: 4252 Cresthaven Ln. Lehi, UT 84043	Colorado & Wyoming: Phone: 303 756 0700 Fax: 303 756 3135 Utah, Idaho, Montana: Phone: 303 756 0700 Fax: 303 756 3135 Web: <a href="http://www.akihibb.com">www.akihibb.com</a> Contact: <a href="mailto:info@akihibb.com">info@akihibb.com</a>	Sales Representative

28

For infringement, Koji provided a rebuttal to Renesas position, a portion of which is reproduced here with the reminder in Exhibit E:

<sup>25</sup> Ex. A, July 3, 2023 e-mail chain (e-mail at the end of the chain), to the Ramey Decl.; Ramey Decl at ¶5.

<sup>26</sup> Ex. B, July 20, 2023 e-mail chain (July 18, 2023 e-mail from Crotty to Kubiak), to the Ramey Decl.; Ramey Decl. at ¶6.

<sup>27</sup> Ex. B, July 20, 2023 e-mail chain; Ramey Decl. at ¶7.

<sup>28</sup> Ex. D, screenshot from Renesas website embedded in July 26, 2023 e-mail chain, to the Ramey Decl.

Additionally, the claims do not appear to read on the accused product, as they appear directed primarily to the transmission side, and the P9222-R EVK is essentially a low power receiver product.  
 • US10790703: "Smart wireless power transfer between devices"  
 • Claim 1 of US10790703 is a "A wireless power transfer system for wirelessly charging a powered device" which encompasses both transmitter and receiver. Therefore, there is no "primarily to the transmitter side" or "primarily to the receiver side". Renesas Electronics America's P9222-R EVK is Qi certified, i.e., it must follow both Qi's Power Transfer Protocol and Qi's Power Receiver Protocol.

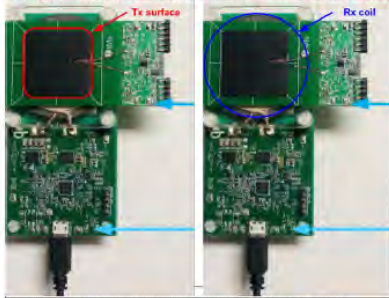
• Qi Specifications | Wireless Power Consortium

<https://www.wirelesspowerconsortium.com/documents/specifications/3.0/3.0rev12-public.pdf>  
 In fact, Renesas Electronics America's own document admits that Renesas product "P9235A-RB-EVK Evaluation Board" or any other Qi certified transmitter can be used as the power transmitter, as shown below.

The P9222-R-EVK Wireless Power Evaluation Board can be used to demonstrate the features and performance of the P9222-R 5W Wireless Power Receiver in low power 2.5W applications such as in earbuds charging cases. The P9222-R-EVK can also supply up to 5W power. IDT's P9235A-RB-EVK Evaluation Board or any other Qi certified transmitter can be used as the power transmitter for P9222-R-EVK evaluation board testing.

<https://www.renesas.com/www/docusource/ma/P9222-R-EVK/evaluation-board/ma/ma01m3441.pdf>

Renesas Electronics America wrote:  
 Even if that issue were somehow overcome, our analysis also indicates that the P9222-R EVK does not perform several limitations of the independent claims, including, as examples, the last three "wherein" limitations in Claim 1.  
 Renesas Electronics America describes "P9222-R EVK PCB boards act as a spacer between Tx surface and Rx coil" and depicts "Tx surface narrower than Rx coil, i.e., transmission power of the wireless communication circuitry is controlled as to make a range of the close-range wireless communication substantially narrower than a range of the radiative powering region."



29

William Ramey substantively addressed each of Renesas noninfringement positions.<sup>30</sup> Renesas did not further counter this argument but filed a motion to dismiss providing:

The relationship between AKI GIBB and REA is governed by a Sales Representative Agreement which states that the relationship is that of "principal and selling representative." (O'Sullivan Decl., ¶¶ 5.) The agreement states that AKI GIBB is an independent contractor and not an employee or agent of REA. (*Id.*) REA does not own or control AKI GIBB, nor does it have any say in the day-to-day operations of AKI GIBB. (*Id.*, ¶¶ 6.) REA does not own or lease the AKI GIBB facility and does not have employees at AKI GIBB. (*Id.*)

31

After receiving these sworn statements, which were not previously provided to Koji and that likely established that the location relied upon for venue was not a location of Renesas, Koji

<sup>29</sup> Ex. E, claim chart attached to August 1, 2023 e-mail chain, to the Ramey Decl.

<sup>30</sup> Ramey Decl. at ¶9.

<sup>31</sup> Ex. F, Doc. No. 14 at 3 from Cause No. 1:23-cv-1674, to the Ramey Decl.



1 dismissed its lawsuit on September 6, 2023 without burdening the court or Renesas to address  
2 the arguments. The dismissal was filed solely to effectuate dismissal and not a merits-based  
3 dismissal.<sup>32</sup>

4 On November 8, 2023, Koji refiled the lawsuit in the Northern District of California.<sup>33</sup>  
5 The claim charts used were those previously prepared<sup>34</sup> and where Renesas non-infringement  
6 position had been considered.<sup>35</sup> I and Koji immediately began discussions with counsel for  
7 Renesas about additional accused products,<sup>36</sup> Renesas maintained that the sales volume of the  
8 accused product was very low.<sup>37</sup> Koji and its counsel looked for additional products from  
9 Defendant.<sup>38</sup> However, to not burden Renesas, on January 30, 2024, Koji agreed to dismiss  
10 without prejudice its lawsuit, to which Renesas agreed.<sup>39</sup> The lawsuit was dismissed due to the  
11 low sales volume. Defendant had not filed any motions in the case or otherwise appeared or  
12 responded.<sup>40</sup>

13 Shortly thereafter, William Ramey and his client's representative, Carlos Gorrichategui,  
14 Ph.D, discussed whether the sales of a newly charted product that was located had been included  
15 in the prior numbers and came to the conclusion it was not based on what had been provided to  
16 Renesas in the prior lawsuit. Accordingly, Koji asked Ramey LLP to file a new lawsuit based  
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23 <sup>32</sup> Ramey Decl. at ¶10.

24 <sup>33</sup> Ex. G, Doc. No. 1 at 3 from Cause No. 5:23-cv-5750, to the Ramey Decl.

25 <sup>34</sup> Ramey Decl. at ¶¶11, 14, 27, 28; *Compare* Doc. No. 1-2 in 5:23-cv-05752 to Doc. No. 1-2 at 1:23-cv-01674.

26 <sup>35</sup> Ex. E, claim chart rebuttal attached to August 1, 2023 e-mail chain.

27 <sup>36</sup> Ex. H, January 23, 2024 e-mail chain, to the Ramey Decl.; Ramey Decl. at ¶12.

28 <sup>37</sup> Ramey Decl. at ¶12.

<sup>38</sup> Ramey Decl. at ¶11, 14; Gorrichategui Decl. at ¶¶9-11, 14.

<sup>39</sup> Ex. J, January 30, 2024 e-mail chain, to the Ramey Decl.

<sup>40</sup> Ramey Decl. at ¶13.

1 on the newly charted product.<sup>41</sup> On May 22, 2024, Koji filed the new lawsuit, accusing the  
2 entirely different Renesas system.<sup>42</sup>

3 Renesas's lawyer responded by letter on May 31, 2024, that Koji's lawsuit was  
4 foreclosed as it had been dismissed twice.<sup>43</sup> The letter asked that the lawsuit be promptly  
5 dismissed. After further discussions with Renesas's counsel, the lawsuit was dismissed with  
6 prejudice on June 12, 2024.<sup>44</sup> Renesas had not entered an appearance or filed any document in  
7 the case. The case was less than two months old.

8  
9 In summary, Plaintiff filed a first complaint in a venue it believed correct based on  
10 Defendant's website. Plaintiff's counsel engaged Defendant's counsel on both infringement and  
11 venue. Plaintiff provided an infringement chart with its allegations. Defendant provided  
12 evidence the venue was incorrect and rather than burden the court or Renesas with further  
13 pleading on a motion that likely would be granted, Koji dismissed the lawsuit to move it to  
14 California. Once in California, Koji engaged Renesas again and even provided an infringement  
15 chart of a new product but ultimately dismissed the lawsuit due to low sales the accused charted  
16 products in the complaint. Notably, Koji dismissed the lawsuit prior to Renesas needing to enter  
17 an appearance. On reflection that a charted product was not included in the sales volume, Koji  
18 filed a new lawsuit accusing a new product. As was standard practice for new lawsuits at the  
19 time, a copy was sent to the Defendant with a proposed settlement letter. Mistakenly, the copy  
20 was sent to Defendant's in-house counsel who had previously reached out on his own to Ramey  
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27 <sup>41</sup> Ramey Decl. at ¶14; Gorrichategui Decl. at ¶11.

28 <sup>42</sup> Ex. K, Doc. No. 1-2, to the Ramey Decl.

<sup>43</sup> Ex. L, Letter to Ramey from Crotty at 1, to the Ramey Decl.; Ramey Decl. at ¶15.

<sup>44</sup> Doc. No. 12.

1 LLP. Ramey LLP has updated its procedure to ensure that when outside counsel is known copies  
 2 are sent to outside counsel and not the defendant's in-house counsel.<sup>45</sup> No further direct contact  
 3 was made with Defendant after receiving Defendant's counsel's letter.<sup>46</sup>

4  
 5 Renesas's counsel responded that the previous dismissal was in effect with prejudice and  
 6 therefore the current lawsuit should be dismissed.<sup>47</sup> Ramey LLP's opinion was that the dismissal  
 7 of the Colorado lawsuit did not count as a prior dismissal for purposes of Rule 41 as it was done  
 8 on venue grounds and to conserve the resources of the parties.<sup>48</sup> William Ramey knew from his  
 9 over 20 years of practice that Rule 41 allowed, under certain circumstances, more than 2  
 10 dismissals.<sup>49</sup> However, further research did not provide a definitive case on the issues so Koji  
 11 decided to dismiss the lawsuit with prejudice before Renesas would be required to expend  
 12 resources answering or otherwise responding.<sup>50</sup> Koji instructed its counsel to seek a dismissal  
 13 where each party bearing its own fees and costs but Renesas refused.<sup>51</sup> Rather than fight motion  
 14 practice and increase the costs for both sides, Koji dismissed *with prejudice* its lawsuit over all  
 15 products that might infringe the '703 patent.<sup>52</sup> Notably, when Koji dismissed, Renesas had not  
 16 entered an appearance. Renesas only entered an appearance to file its motion for fees. Moreover,  
 17 prior to the motion for fees, Renesas had not filed a single document in the case. In short,  
 18 Renesas's activity was a few communications with opposing counsel.  
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24 <sup>45</sup> Ramey Decl. at ¶16.

25 <sup>46</sup> Ramey Decl. at ¶16.

26 <sup>47</sup> Ramey Decl. at ¶17.

27 <sup>48</sup> Ramey Decl. at ¶17.

28 <sup>49</sup> Ramey Decl. at ¶17.

<sup>50</sup> Ramey Decl. at ¶17.

<sup>51</sup> Ramey Decl. at ¶18.

<sup>52</sup> Doc. No. 12.

### III. RELEVANT LAW

Rule 11 sanctions address filings with a court, not alleged attorney misconduct.<sup>53</sup> Rule 11 expressly requires that an attorney presenting a pleading, motion, or other paper before a court certify that the attorney has performed “an inquiry reasonable under the circumstances” such that he can verify that (1) “it is not being presented for any improper purpose, such as to harass, cause unnecessary delay, or needlessly increase the cost of litigation,” (2) “the claims ... are warranted by existing law or by a nonfrivolous argument for extending, modifying, or reversing existing law;” (3) “the factual contentions have evidentiary support or, ... will likely have evidentiary support after a reasonable opportunity for further investigation or discovery.”<sup>54</sup> A Rule 11 analysis is a strictly objective inquiry and inquiries into any alleged motivation behind a filing are improper.<sup>55</sup> When a claim is charted against an accused product, the lawyers involved may only be sanctioned for violating Rule 11(b)(2) if a reasonable attorney would have concluded that the claim construction proposed by the lawyer was frivolous.<sup>56</sup>

The Ninth Circuit is clear that an award of sanctions under a court's inherent authority must be preceded by a finding of bad faith, or conduct that constituted or was tantamount to bad faith.<sup>57</sup>

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<sup>53</sup> Fed.R.Civ.P. 11; *see also United Energy Owners Comm., Inc. v. United States Energy Management Systems, Inc.*, 837 F.2d 356, 364–65 (9<sup>th</sup> Cir. 1988).

<sup>54</sup> Fed.R.Civ.P. 11(b)(1)–(3).

<sup>55</sup> *Fed. Deposit Ins. Corp. v. Maxxam, Inc.*, 523 F.3d 566, 580 (5<sup>th</sup> Cir. 2008); *Jenkins v. Methodist Hosp. of Dallas*, 478 F.3d 255, 264 (5<sup>th</sup> Cir. 2007).

<sup>56</sup> *Antonious v. Spalding & Evenflo Companies, Inc.*, 275 F.3d 1066, 1072–73 (Fed. Cir. 2002).

<sup>57</sup> *Gomez v. Vernon*, 255 F.3d 1118, 1134 (9<sup>th</sup> Cir. 2001).

1 **IV. ARGUMENT - SANCTIONS UNDER RULE 11 OR THE COURT'S**  
2 **INHERENT POWER ARE NOT WARRANTED.**

3 Renesas has made no showing that counsel for Koji should be independently sanctioned.  
4 There is simply no “evidence of bad faith, improper motive, or reckless disregard of the duty  
5 owed to the court.”<sup>58</sup> Here, the case was at the pleading stage and the case was dismissed prior  
6 to the other side entering an appearance. This is routine litigation and there is no evidence to the  
7 contrary. Sanctions against counsel for Koji would have a chilling effect on Ramey LLP and its  
8 ability to file lawsuits, is inappropriate and without legal basis. There is no evidence that Ramey  
9 LLP’s conduct (or the conduct of its lawyers) warrants sanction under the inherent power of the  
10 Court or Rule 11 as there is no bad faith conduct or conduct tantamount to bad faith and all  
11 pleadings were filed after a reasonable inquiry and with a good faith basis in the law and facts.  
12 There simply no evidence to overcome the presumption that the lawsuit was filed in good faith.<sup>59</sup>  
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14

15 Ramey LLP admits that it filed three cases on behalf of its client Koji against Renesas.  
16 The first was dismissed by Koji when it determined that it would likely lose a venue motion.<sup>60</sup>  
17 Rather than dismissed to increase costs, the case was dismissed to reduce costs. Koji had a good  
18 faith basis for claiming venue in Colorado and could have pressed the motion which it may have  
19 won or may have lost. In an effort to compromise, Koji dismissed, but not on the merits, rather  
20 to reduce costs for all parties and transfer the case. The only evidence before the Court is that  
21 the case was dropped to reduce cost. It is hard to fathom how an action to reduce cost, an action  
22 that is working with opposing counsel, can support a Rule 11 Sanction or a sanction under the  
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27 <sup>58</sup> *Edwards v. Gen. Motors Corp.*, 153 F.3d 242, 246 (5<sup>th</sup> Cir.1998).

28 <sup>59</sup> *Checkpoint Sys., Inc. v. All-Tag Sec. S.A.*, 858 F.3d 1371, 1376 (Fed. Cir. 2017).

<sup>60</sup> Ramey Decl. at ¶10.

1 Court's inherent power? Koji could have let the court in Colorado decide the venue motion  
2 which at worst would have resulted in dismissal or transfer to California. Therefore, Renesas in  
3 fact saved resources of the parties and the judiciary because of Koji's decision to dismiss.

4 Koji admits that it refiled the same infringement allegations it previously dismissed in  
5 Colorado in the Northern District of California.<sup>61</sup> The lawsuit was filed November 8, 2023 at  
6 the venue Renesas previously said was correct. As before, Koji opened communications with  
7 opposing counsel.<sup>62</sup> While Renesas counsel beats the drum that no response was received to its  
8 noninfringement position, such statement is false as Koji replied to each argument with a refuting  
9 claim chart.<sup>63</sup> That Renesas may disagree with the arguments is not unexpected in patent  
10 litigation. The chart and rebuttal are unrefuted evidence at this stage of the litigation that Koji's  
11 claims were made in good faith, as was the case in *Park-In-Theatres v. Perkins*.<sup>64</sup> That Renesas's  
12 lawyer claims that no response was made belies belief and illustrates that such false statements  
13 are only to make opposing counsel seem to have acted in an unreasonable manner. However,  
14 such was not the case here and it is tantamount to bad faith for Renesas's counsel to make such  
15 a false statement. Koji and its counsel worked the case with Defendant's counsel to  
16 expeditiously and economically resolve it, without burdening the court. Ultimately, Renesas  
17 maintained that the sales of the charted products in the second suit were very low, around \$4k.<sup>65</sup>  
18 Rather than add the new claim chart, Koji dismissed the lawsuit without prejudice as it further  
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25 <sup>61</sup> Doc. No. 1 in Cause No. 5:23-cv-5752.

26 <sup>62</sup> Ramey Decl. at ¶11.

27 <sup>63</sup> Ex. M; Ramey Decl. at ¶9.

28 <sup>64</sup> 190 F.2d 137, 143 (9th Cir. 1951) (a case approvingly cited by the Supreme Court for the standard of what are extraordinary circumstances for awarding fees under Section 285).

<sup>65</sup> Ex. B at July 28, 2024 e-mail.

1 investigated its claims.<sup>66</sup> The case was pending for two months. Renesas did not even enter an  
2 appearance or take any other action in the matter besides a few discussions with counsel for Koji.

3 Koji's manager approached Ramey LLP and asked if there were any claims left to pursue  
4 for a new product.<sup>67</sup> Upon review of the file, Ramey LLP determined that the additional product  
5 charted had not been accounted for in the sales volume and advised its client that the suit could  
6 be refiled as new complaint against was against a new product.<sup>68</sup> On May 22, 2024, Koji filed  
7 a new lawsuit against Renesas asserting the '703 patent against a new product that was not  
8 previously sued.<sup>69</sup>

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10  
11 Unexpectedly, Renesas claimed the lawsuit was barred by Rule 41. However, and less  
12 than 2 months later, Ramey LLP dismissed the lawsuit when it could not find authority  
13 equivocally stating that Renesas's position was incorrect and given the low sales volume. Ramey  
14 LLP believed it had a valid lawsuit as the claims were not the same claims made in the prior suit  
15 and the Ramey LLP did not believe the Colorado dismissal based on venue would count under  
16 Rule 41 as a prior dismissal.<sup>70</sup> William Ramey knew from his over twenty years of experience  
17 that there was an exception to Rule 41 dismissals that allowed a refiling in situations like this.<sup>71</sup>  
18 However, in not wanting to improperly maintain a lawsuit and in light of the fact the Defendant's  
19 counsel maintained that the sales of the newly charted product were small, the case was  
20 dismissed. At all times, Ramey LPP evaluated its position and modified that position to make  
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26 <sup>66</sup> Doc. No. 12.

27 <sup>67</sup> Gorrichategui Decl. at ¶11.

28 <sup>68</sup> Ramey Decl. at ¶14.

<sup>69</sup> Doc. No. 1 and 1-2 (suing a new Renesas product).

<sup>70</sup> Ramey Decl. at ¶17.

<sup>71</sup> Ramey Decl. at ¶17.



1 the litigation less burdensome to all parties.<sup>72</sup> Before filing the infringement action for the third  
2 time, a chart comparing a new product was prepared in collaboration by William Ramey and  
3 Simon Sunatori.<sup>73</sup> It is believed that this chart establishes the reasonableness of the pre-filing  
4 inquiry made in this patent infringement case under Rule 11.<sup>74</sup> Further, the Federal Circuit has  
5 found that such an analysis is evidence of compliance with Rule 11 for a patent infringement  
6 case.<sup>75</sup>

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9 Moreover, Rule 41 specifically allows a lawsuit to be filed more than twice if there is an  
10 explanation for why the Rule should not apply. William Ramey relied on his over 20 years of  
11 experience in refiling the lawsuit.<sup>76</sup> Ramey knew there were exceptions that allowed the refiling  
12 of a complaint, in cases where there is “a persuasive explanation for the course of litigation.”<sup>77</sup>  
13 Here, the dismissal in Colorado was more akin to convenience and not a merits dismissal.  
14 Further, the third lawsuit charted a new product that had not been alleged as infringing in the  
15 prior suit.

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18 Plaintiffs hire Ramey LLP and its lawyers for this experience, knowing how to conduct  
19 themselves in patent infringement litigation. However, given Defendant’s counsels requests and  
20 comments that the sales volume of the newly charted product were low, the lawsuit was  
21 ultimately dismissed with prejudice.<sup>78</sup> Under Rule 41 jurisprudence, the filing of the third  
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25 <sup>72</sup> Ramey Decl. at ¶26.

26 <sup>73</sup> Ramey Decl. at ¶26.

27 <sup>74</sup> See, e.g., *View Eng'g, Inc. v. Robotic Vision Sys., Inc.*, 208 F.3d 981, 986 (Fed. Cir. 2000).

28 <sup>75</sup> *View Eng'g, Inc. v. Robotic Vision Sys., Inc.*, 208 F.3d 981, 986 (Fed.Cir.2000).

<sup>76</sup> Ramey Decl. at ¶¶17, 27.

<sup>77</sup> *Milkcrate Athletics, Inc. v. Adidas Am., Inc.*, 619 F. Supp. 3d 1009 (C.D. Cal. 2022).

<sup>78</sup> Ramey Decl. at ¶28.

lawsuit was allowed.<sup>79</sup> Ramey LLP freely admits that the Court may probe the circumstances of the filing but the fact that the case law allows the filing is evidence that the filing was not so unreasonable as to warrant a Rule 11 sanction or a sanction under the Court's inherent power.<sup>80</sup>

As such, there is believed to be no evidence before this Court that that the any of the complaints filed against Defendant did not comply with Rule 11. Each chart compared the claims of the accused device against the elements of a claim from the '703 patent, namely claim 1, thus establishing a reasonable basis for the filing of each lawsuit.

The Federal Circuit court has construed Rule 11, in the context of patent infringement actions, to require that an attorney interpret the pertinent claims of the patent in issue before filing a complaint alleging patent infringement.<sup>81</sup> Here, the claim chart prepared prior to the filing of both the second<sup>82</sup> or third lawsuit adopted a plain and ordinary construction of the claims terms, needing no further construction.<sup>83</sup> Under Rule 11, because claim construction is a matter of law, an attorney's proposed claim construction is subject to the Rule 11(b)(2) requirement that all legal arguments be nonfrivolous. In the Ninth Circuit, an attorney's legal arguments using a standard of objective reasonableness.<sup>84</sup> To satisfy that requirement, there must be some basis in law to support each legal argument in the complaint.

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<sup>79</sup> *Milkcrate Athletics, Inc. v. Adidas Am., Inc.*, 619 F. Supp. 3d 1009 (C.D. Cal. 2022).

<sup>80</sup> *See, e.g., id.*

<sup>81</sup> *View Eng'g, Inc. v. Robotic Vision Sys., Inc.*, 208 F.3d 981, 986, 54 USPQ2d 1179, 1182 (Fed.Cir.2000).

<sup>82</sup> The claim chart filed with the first lawsuit was the same chart filed with the second lawsuit.

<sup>83</sup> Ramey Decl. at ¶25; Kalra Decl. at ¶25; Kubiak Decl. at ¶16.

<sup>84</sup> *In re Keegan Mgmt. Co., Sec. Litig.*, 78 F.3d 431, 434 (9th Cir. 1996).

1 For the law on claim construction, the Federal Circuit controls and there is a heavy bias  
2 towards a plain and ordinary meaning. During claim construction, the words of the claims  
3 themselves are used to define the scope of the patented invention.<sup>85</sup> In determining the meaning  
4 of the claims, “there is a ‘heavy presumption in favor of the ordinary meaning of claim  
5 language.’”<sup>86</sup> Ordinary meaning is defined as the “meaning that term would have to a person of  
6 ordinary skill in the art in question at the time of invention.”<sup>87</sup> In fact, there are only two  
7 situations where a sufficient reason exists to require the entry of a definition of a claim term  
8 other than its plain and ordinary meaning. The first arises if the patentee has chosen to be his or  
9 her own lexicographer by clearly setting forth an explicit definition for a claim term. The second  
10 is where the term or terms chosen by the patentee so deprive the claim of clarity that there is no  
11 means by which the scope of the claim may be ascertained from the language used.<sup>88</sup> Thus,  
12 William Ramey’s, Susan Kalra’s and Jeffrey Kubiak’s proposed claim constructions for the  
13 terms of the ‘703 patent as plain and ordinary meaning find support in the existing law and are  
14 not frivolous but rather well-founded and suffice for compliance with Rule 11(b)(2).  
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21 <sup>85</sup> *Phillips v. AWH Corp.*, 415 F.3d 1303, 1312 (Fed. Cir. 2005) (*en banc*).

22 <sup>86</sup> *Watts v. XLSys., L.P.*, No. 1:06-cv-653-LY, 2008 WL 5731945, at \*7 (W.D. Tex. July 1,  
23 2008) (quoting *Johnson Worldwide Assocs. v. Zebco Corp.*, 175 F.3d 985, 989 (Fed. Cir.  
24 1999)); *see also MeetrixIP, LLC v. Citrix Sys., Inc.*, No. 1:16-CV-1033-LY, 2017 WL  
25 5986191, at \*2 (W.D. Tex. Dec. 1, 2017) (citing *Thorner v. Sony Computer Entm’t Am. LLC*,  
26 669 F.3d 1362, 1365 (Fed. Cir. 2012)) (“The Federal Circuit has reaffirmed that a departure  
27 from the ordinary and customary meaning is the exception, not the rule.”).

28 <sup>87</sup> *Phillips*, 415 F.3d at 1313; *see also Pisony v. Commando Construction, Inc.*, W-17-CV-  
00055-ADA, 2019 WL 928406, at \*1 (W.D. Tex. Jan. 23, 2019). “[T]he person of ordinary skill  
in the art is deemed to read the claim term not only in the context of the particular claim in  
which the disputed term appears, but in the context of the entire patent, including the  
specification.” *Phillips*, 415 F.3d at 1313.

<sup>88</sup> *N. Telecom Ltd. v. Samsung Elecs. Co.*, 215 F.3d 1281, 1291 (Fed. Cir. 2000) *citing Johnson  
Worldwide Assocs. v. Zebco Corp.*, 175 F.3d 985, 990 (Fed. Cir. 1999).

1 In evaluating whether there is a Rule 11 violation for the pre-suit investigation, a counsel  
2 must make a reasonable effort to determine whether the accused device satisfies each of the  
3 claim limitations.<sup>89</sup> Here, detailed claim charts were prepared that compared the accused device  
4 against the claim elements, thus showing compliance with Rule 11(b)(3).  
5

6 The Ninth Circuit applies an objective-objective test such that an attorney may not be  
7 sanctioned under Rule 11 for either:  
8

- 9 1. filing a complaint well-founded in fact and law with what a court determines to have  
10 been an inadequate pre-suit investigation or  
11
- 12 2. filing a complaint found not to be well-founded in the law or fact but where there was  
13 an adequate pre-suit investigation.<sup>90</sup>  
14

15 In short, at a minimum, there must be a frivolous pleading for there to be a rule 11 violation. In  
16 the present case, there is no frivolous pleading as there was adequate investigation to make the  
17 both the legal and factual allegations in the complaint.

18 **A. Plaintiff Conducted an Adequate Pre-suit Investigation**

19 A primary concern in a Rule 11 analysis is the merits of the case, as filed. Here, Ramey  
20 LLP used technical resources, including both in-house and Simon Sunatori, to draft all claim  
21 charts in this matter. Mr. Sunatori is a professional engineer and has a Master's degree in  
22 Engineering who was engaged by DynaIP Deals to assist in identifying alleged infringing  
23 products.<sup>91</sup> Sunatori's diligence included comparing Renesas products to the claims of the '703  
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27 <sup>89</sup> *Judin*, 110 F.3d at 784, 42 USPQ2d at 1304.

28 <sup>90</sup> *In re Keegan Mgmt. Co., Sec. Litig.*, 78 F.3d 431, 434 (9th Cir. 1996).

<sup>91</sup> Sunatori Decl. at ¶3.

1 patent with the assistance of William Ramey of Ramey LLP.<sup>92</sup> Ramey LLP and Sunatori  
2 continued to work with one another to address Renesas's argument that it did not infringe,  
3 preparing counter arguments that were submitted to Renesas.<sup>93</sup> When sales were found to be  
4 low of the original accused instrumentality, Sunatori helped Ramey LLP locate a new product  
5 and helped develop the new claim charts.<sup>94</sup> In short, Ramey LLP asserted the patents against the  
6 Renesas devices only after collaboration with a technical expert, Sunatori who has over 25-years-  
7 experience with patents and research and development.<sup>95</sup> At this stage of the litigation, Ramey  
8 LLP asserts that the complaints were asserted in a good faith belief that infringement existed,  
9 and still exists.<sup>96</sup> There simply is no evidence that the lawsuits were not filed in good faith.<sup>97</sup>  
10 Moreover, Renesas did not put any evidence of bad faith in its motion.  
11

#### 12 **B. Ramey LLP's Lawyers Conduct Was Very Reasonable**

13  
14 There simply is no evidence that Ramey LLP acted unreasonably. In fact, the opposite  
15 is true, Renesas's counsel and Ramey LLP were in constant communication. Ramey LLP  
16 submitted charts in response to Renesas's noninfringement positions<sup>98</sup> and dismissed cases  
17 rather than increase the costs of litigation.<sup>99</sup> Had Ramey LLP dug its feet in and not dismissed,  
18 the case would be continuing, in Ramey LLP's opinion. However, to reduce risk for all parties,  
19 Koji dismissed its claims after engaging with Defendant's counsel. There is simply nothing  
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24 <sup>92</sup> Sunatori Decl. at ¶8.

25 <sup>93</sup> Sunatori Decl. at ¶¶10-11.

26 <sup>94</sup> Ramey Decl. at ¶14.

27 <sup>95</sup> Sunatori Decl. at ¶7.

28 <sup>96</sup> Ramey Decl. at ¶14.

<sup>97</sup> See, e.g., *Checkpoint Sys., Inc. v. All-Tag Sec. S.A.*, 858 F.3d 1371, 1376 (Fed. Cir. 2017) (presumption lawsuit is filed in good faith).

<sup>98</sup> Exs. I and D.

<sup>99</sup> Ramey Decl. at ¶9.

1 improper about such conduct. In fact, it should be encouraged. A Rule 11 or inherent power  
2 sanction would only work to discourage parties from openly communicating and working to  
3 resolve cases.

4  
5 **C. There Was No Merit Decision Of Plaintiff's Claims**

6 Renesas failed to obtain any ruling from a court that Koji's claims were not meritorious.  
7 Koji litigated in a timely and reasonable matter responding to the opposing counsel. Fees are  
8 not to be awarded under Rule 11 unless it is shown that there was no a reasonable inquiry such  
9 that the attorney can verify that (1) "it is not being presented for any improper purpose, such as  
10 to harass, cause unnecessary delay, or needlessly increase the cost of litigation," (2) "the claims  
11 ... are warranted by existing law or by a nonfrivolous argument for extending, modifying, or  
12 reversing existing law;" (3) "the factual contentions have evidentiary support or, ... will likely  
13 have evidentiary support after a reasonable opportunity for further investigation or discovery."<sup>100</sup>  
14 Here, Koji's lawyers complied with this duty and there is no evidence otherwise.  
15

16  
17 **D. Rule 11 Sanctions are Not Warranted**

18 The Court ordered a response as to (1) the pre-filing inquiry into the Complaint under  
19 Rule 41 and (2) the prefiling inquiry into the allegations in the Third Amended Complaint.<sup>101</sup>  
20 As set forth above, William Ramey knew based upon his over twenty years of legal experience  
21 that the law allows the filing of a complaint under certain circumstances even if twice  
22 dismissed.<sup>102</sup> The Ninth Circuit's test is whether there is "a persuasive explanation for the course  
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26  
27 <sup>100</sup> Fed. R. Civ. P. 11(b)(1)–(3).

28 <sup>101</sup> Doc. No. 27 at 13.

<sup>102</sup> Ramey Decl. at ¶19.

1 of litigation.”<sup>103</sup> Here, William Ramey believed there was a persuasive explanation and Susan  
2 Kalra relied on William Ramey in authorizing the filing of the complaint.<sup>104</sup> For Rule 11  
3 purposes, an attorney is allowed to rely upon another attorney.<sup>105</sup> However, that does not shield  
4 the attorney from liability under Rule 11. Moreover, while the Ninth Circuit reliance on  
5 forwarding co-counsel may in certain circumstances satisfy an attorney's duty of reasonable  
6 inquiry, the counsel must acquire knowledge of facts sufficient to enable them to certify that the  
7 paper is well-grounded in fact. An attorney who signs the pleading cannot simply delegate to  
8 forwarding co-counsel his duty of reasonable inquiry.<sup>106</sup> Here, Ms. Kalra, while not involved  
9 with preparing the claim charts was satisfied that they complied with Rule 11.<sup>107</sup> Ms. Kalra  
10 trusted the charts she was sent from Mr. Ramey because they had worked together for many  
11 years and she trusted his work.<sup>108</sup> Further, the charts have not been shown to frivolous to warrant  
12 a Rule 11 sanction,<sup>109</sup> rather the charts are a are well grounded in fact. The charts compare each  
13 element to the accused device: For the preamble of Claim 1:  
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23 <sup>103</sup> *Milkcrate Athletics, Inc. v. Adidas Am., Inc.*, 619 F. Supp. 3d 1009 (C.D. Cal. 2022).

24 <sup>104</sup> Ramey Decl. at ¶24.

25 <sup>105</sup> *See, e.g., Judin v. United States*, 110 F.3d 780, 785 (Fed. Cir. 1997).

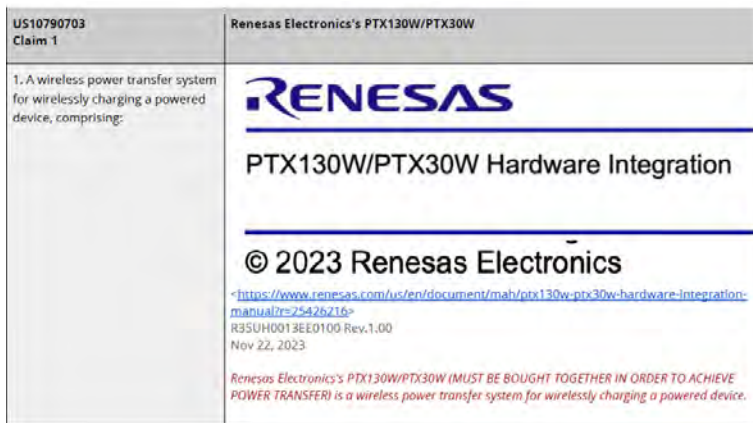
26 <sup>106</sup> *In re Crystal Cathedral Ministries*, No. 2:12-BK-15665-RK, 2020 WL 1649619, at \*36  
(Bankr. C.D. Cal. Mar. 31, 2020), *aff'd*, No. 2:12-BK-15665-RK, 2021 WL 2182975 (B.A.P.  
9th Cir. May 28, 2021)

27 <sup>107</sup> Ramey Decl. at ¶24; Kalra Decl. at ¶¶24-25.

28 <sup>108</sup> Ramey Decl. at ¶24; Kalra Decl. at ¶¶24-25.

<sup>109</sup> *Antonious v. Spalding & Evenflo Companies, Inc.*, 275 F.3d 1066, 1072–73 (Fed. Cir. 2002).





110 Koji identifies defendant's

accused product by web address and name, and with an explanation in red. For the next claim element, Koji identifies a product features webpage from Defendant:

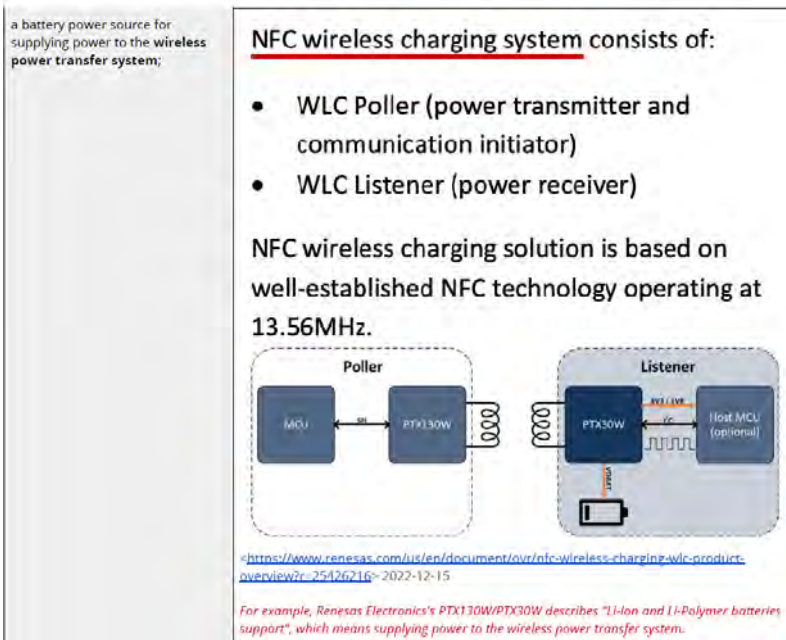
US10790703 Claim 1	Renesas Electronics's PTX130W/PTX30W																																														
a battery power source for supplying power to the wireless power transfer system;	<table border="1"> <thead> <tr> <th>Product features</th><th></th></tr> </thead> <tbody> <tr><td>Ultra-low power on-chip embedded core</td><td>✓</td></tr> <tr><td>Integrated PMIC solution</td><td>✓</td></tr> <tr><td>Integrated flexible battery charger with reverse current limiter</td><td>✓</td></tr> <tr><td>Integrated highly efficient active rectifier</td><td>✓</td></tr> <tr><td>Standalone mode of operation (without Host MCU)</td><td>✓</td></tr> <tr><td>Embedded power regulation control</td><td>✓</td></tr> <tr><td>Required PCB integration area (est.)</td><td>17 mm<sup>2</sup></td></tr> <tr><td>Rectification efficiency (AC to DC)</td><td>up to 92%</td></tr> <tr><td>Energy harvesting [W]</td><td>up to 1W</td></tr> <tr><td>Charging current range [mA]</td><td>5-250 mA</td></tr> <tr><td><u>Li-Ion and Li-Polymer batteries support</u></td><td>✓</td></tr> <tr><td>Charge status monitor</td><td>✓</td></tr> <tr><td>On-chip over-temperature detection/protection</td><td>✓</td></tr> <tr><td>Transparent data exchange channel</td><td>✓</td></tr> <tr><td>Shipping mode (support for battery protection)</td><td>✓</td></tr> <tr><td>System MCU supply output voltage, typ. [V]</td><td>1.8, 3.3 V</td></tr> <tr><td>Battery-less power supply output</td><td>✓</td></tr> <tr><td>JEITA support</td><td>✓</td></tr> <tr><td>Shipping mode current consumption, typ. [nA]</td><td>25 nA</td></tr> <tr><td>I2C clock frequency [kHz]</td><td>Up to 1 MHz</td></tr> <tr><td>Available packages</td><td>CSP16</td></tr> <tr><td>Temperature range [°C]</td><td>-40 to +85</td></tr> </tbody> </table> <p>&lt;https://www.renesas.com/us/en/document/tytr/nfc-wireless-charging-wlc-product-overview/r35uh0013ee0100&gt; 2022-12-15</p> <p><i>For example, Renesas Electronics's PTX130W/PTX30W describes "Li-Ion and Li-Polymer batteries support", which means the existence of a battery power source.</i></p>	Product features		Ultra-low power on-chip embedded core	✓	Integrated PMIC solution	✓	Integrated flexible battery charger with reverse current limiter	✓	Integrated highly efficient active rectifier	✓	Standalone mode of operation (without Host MCU)	✓	Embedded power regulation control	✓	Required PCB integration area (est.)	17 mm <sup>2</sup>	Rectification efficiency (AC to DC)	up to 92%	Energy harvesting [W]	up to 1W	Charging current range [mA]	5-250 mA	<u>Li-Ion and Li-Polymer batteries support</u>	✓	Charge status monitor	✓	On-chip over-temperature detection/protection	✓	Transparent data exchange channel	✓	Shipping mode (support for battery protection)	✓	System MCU supply output voltage, typ. [V]	1.8, 3.3 V	Battery-less power supply output	✓	JEITA support	✓	Shipping mode current consumption, typ. [nA]	25 nA	I2C clock frequency [kHz]	Up to 1 MHz	Available packages	CSP16	Temperature range [°C]	-40 to +85
Product features																																															
Ultra-low power on-chip embedded core	✓																																														
Integrated PMIC solution	✓																																														
Integrated flexible battery charger with reverse current limiter	✓																																														
Integrated highly efficient active rectifier	✓																																														
Standalone mode of operation (without Host MCU)	✓																																														
Embedded power regulation control	✓																																														
Required PCB integration area (est.)	17 mm <sup>2</sup>																																														
Rectification efficiency (AC to DC)	up to 92%																																														
Energy harvesting [W]	up to 1W																																														
Charging current range [mA]	5-250 mA																																														
<u>Li-Ion and Li-Polymer batteries support</u>	✓																																														
Charge status monitor	✓																																														
On-chip over-temperature detection/protection	✓																																														
Transparent data exchange channel	✓																																														
Shipping mode (support for battery protection)	✓																																														
System MCU supply output voltage, typ. [V]	1.8, 3.3 V																																														
Battery-less power supply output	✓																																														
JEITA support	✓																																														
Shipping mode current consumption, typ. [nA]	25 nA																																														
I2C clock frequency [kHz]	Up to 1 MHz																																														
Available packages	CSP16																																														
Temperature range [°C]	-40 to +85																																														

111

Wherein Koji identifies the element. For the next element, Koji includes another screenshot:

<sup>110</sup> Doc. No. 1-2 at 4 of 11.

<sup>111</sup> Doc. No. 1-2 at 5 of 11.



<sup>112</sup> wherein Koji explains

Defendants' wireless charging system from its own website. Koji proceeds through the next several elements to provide screenshots from Defendant's website that explain the functionality of the accused product.<sup>113</sup> No further showing is necessary to comply with Rule 11 at the pleading stage. Each of William Ramey, Susan Kalra and Jeffrey Kubiak have shown compliance with Rule 11.<sup>114</sup>

#### **E. Sanctions Under the Court's Inherent Power are Not Warranted**

The Ninth Circuit is clear that an award of sanctions under a court's inherent authority must be preceded by a finding of bad faith, or conduct that constituted or was tantamount to bad faith.<sup>115</sup> Here, there is no showing of bad faith.

<sup>112</sup> Doc. No. 1-2 at 6 of 11.

<sup>113</sup> Doc. No. 1-2 at 7-11/11.

<sup>114</sup> Ramey Decl. at ¶24.

<sup>115</sup> *Gomez v. Vernon*, 255 F.3d 1118, 1134 (9th Cir. 2001).

1 The Court requested that sanctions under the court's inherent power are addressed for (1)  
2 the unauthorized practice of law or abetting the unauthorized practice of law, (2) inadequate pre-  
3 filing inquiry regarding the impact of prior dismissals before the Third Amended Complaint was  
4 filed and (3) pre-filing analysis of infringement (including claim interpretation in light of the  
5 specification and file history) prior to filing the Second and Third Action.

7 As discussed herein, there is no evidence or showing that any of the complaints filed by  
8 Koji or by its attorneys are improper under Rule 11. Each of William Ramey, Susan Kalra and  
9 Jeffrey Kubiak maintain that they performed an adequate investigation under the  
10 circumstances.<sup>116</sup> Moreover, Ms. Kalra relied on William Ramey and Jeffrey Kubiak in filing  
11 both the second and third complaints.<sup>117</sup> There is no evidence that either the second or third  
12 complaint fail to comply with Rule 11. In the Ninth Circuit, a rule 11 violation requires a  
13 frivolous pleading either upon the facts or the law. Here, as there is no frivolous pleading, there  
14 is no Rule 11 violation.<sup>118</sup>

16 Koji was prepared to test the merits of its infringement position,<sup>119</sup> but ultimately  
17 decided to dismiss due to other factors. Renesas's comment that a \$5,000 offer to settle is less  
18 than the cost of defense ignores the realities of the case, as it was Renesas that claimed sales  
19 were around \$4k.<sup>120</sup> Therefore, a \$5,000 settlement offer is not unrelated to the damages in the  
20 case but rather directly in line.

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25 <sup>116</sup> Ramey Decl. at ¶24; Kalra Decl. at ¶¶25-27; Kubiak Decl. at ¶15.

26 <sup>117</sup> *In re Crystal Cathedral Ministries*, No. 2:12-BK-15665-RK, 2020 WL 1649619, at \*36  
(Bankr. C.D. Cal. Mar. 31, 2020), *aff'd*, No. 2:12-BK-15665-RK, 2021 WL 2182975 (B.A.P.  
27 9th Cir. May 28, 2021).

28 <sup>118</sup> *In re Keegan Mgmt. Co., Sec. Litig.*, 78 F.3d 431, 434 (9th Cir. 1996).

<sup>119</sup> Ramey Decl. at ¶17.

<sup>120</sup> Ex. B at July 28, 2024 e-mail.

**F. Sanctions Under §1927, Rule 11 or the Court's Inherent Power are not Warranted.**

Renasas has made no showing that counsel for Koji should be independently sanctioned. There is simply no “evidence of bad faith, improper motive, or reckless disregard of the duty owed to the court.”<sup>121</sup> Here, the case was at the pleading stage and dismissed after counsel discussed the cases. This is routine litigation and there is no evidence to the contrary. Renesas’s request for sanctions against counsel for Koji is designed to have a chilling effect on Ramey LLP and its ability to file lawsuits, is inappropriate and without legal basis. Renesas has presented no evidence to the Court that Ramey LLP’s conduct (or the conduct of its lawyers) warrants sanction under Section 1927 or the inherent power of the Court. Renesas has failed to even allege the proper standard, that of bad faith, of which there is none. The petty comments by counsel for Renesas serve no purpose in this case or any other case. Here, the present case was dismissed prior to Renesas even entering an appearance. Counsel for Renesas’s appearance is the sole reason Renesas incurred expenses for this case. There simply no evidence to overcome the presumption that the lawsuit was filed in good faith.<sup>122</sup>

Ramey LLP has a mission of making patent litigation available to all patent owners with valid infringement claims. Ramey LLP is able to level the playing field by efficiently litigating patent infringement cases . Ramey LLP tries to make patent infringement litigation affordable for those patent infringement cases where the potential damages make the case unattractive to most firms. Ramey LLP believes all meritorious claims can be pursued and all intellectual

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<sup>121</sup> *Edwards v. Gen. Motors Corp.*, 153 F.3d 242, 246 (5<sup>th</sup> Cir.1998).

<sup>122</sup> *Checkpoint Sys., Inc. v. All-Tag Sec. S.A.*, 858 F.3d 1371, 1376 (Fed. Cir. 2017).

1 property owners deserve representation. That Renesas finds itself accused of infringing patents  
2 is not a commentary on Ramey LLP but rather the business practices of Renesas.

3 **V. CONCLUSION**

4 The Court's Show Cause Order should be discharged without sanction. Ramey LLP and  
5 its lawyers William Ramey, Susan Kalra and Jeffrey Kubiak have modified their practice to  
6 ensure that there is no further pleadings submitted with a lawyers name not already admitted into  
7 the court. There was no intent to deceive or violate any rule of a state bar, licensing authority,  
8 or court. However, Ramey LLP and its lawyers have modified their actions and the issue will  
9 not repeat.  
10

11 Further, the Court should discharge its Show Cause Order under Rule 11 and its inherent  
12 authority as Ramey LLP has shown that each of the complaints it filed were appropriately based  
13 under the then existing law and facts and there is no evidence that Ramey LLP or its lawyers  
14 intended to commit a fraud on the Court or engaged in conduct that was tantamount to fraud.  
15

16  
17  
18 Dated: September 12, 2024

Respectfully submitted,

19 RAMEY LLP

20 /s/ Susan S.Q. Kalra  
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28

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9 KOJI IP, LLC

10  
11 **IN THE UNITED STATES DISTRICT COURT**  
12 **FOR THE NORTHERN DISTRICT OF CALIFORNIA**  
13 **SAN FRANCISCO DIVISION**

14 KOJI IP, LLC,  
15 Plaintiff,

16 v.

17 RENESAS ELECTRONICS AMERICA,  
18 INC.,

19 Defendant.

Case No.: 3:24-cv-03089-PHK

**DECLARATION OF SUSAN KALRA**  
**IN SUPPORT OF RESPONSE TO**  
**SHOW CAUSE ORDER**

**Date: September 19, 2024**

**Time: 10:30 a.m.**

**Magistrate Judge Peter H. Kang**

**DECLARATION OF SUSAN KALRA**

I, Susan Kalra, declare as follows:

1. I am over the age of 21. I have personal knowledge of the facts contained herein, which are true and correct. If called as a witness, I could competently testify to these statements.

2. I am licensed to practice law in the state of California and am an attorney with the law firm of Ramey LLP. I represent the Plaintiff in the above-captioned lawsuit.

3. My office is located at 303 Twin Dolphin Drive, Suite 600, Redwood City, CA 94065. I have had a physical office in Suite 600 for approximately three years, including all of the time during which I have been employed by Ramey LLP. I have a key to my office door, which I will bring with me to the hearing.

4. I have been admitted to practice law in California continuously since December 1993.

5. I have been employed by Ramey LLP since early February 2023. Since that time, my practice has been almost exclusively patent litigation. Prior to becoming an employee of the firm, I worked on patent litigation matters with the firm since approximately October 2021, as local counsel. Since working with the firm, I have gained experience in analyzing patent claims scope; however, I am not admitted to practice before the USPTO, nor have I ever been.

6. As set forth more fully in my "Supplemental Declaration" filed herewith, beginning in the Summer of 2023 I experienced personal issues that have taken months to significantly improve. During that time, I relied on the highly competent Partners at the Ramey LLP firm to work on cases and court filings including claim charts, and I utilized the firm's staff to assist with filings. I reviewed documents including complaints and memoranda before they were filed. Also during this time I appeared in this Court on a number of cases – as I have ever since I



1 became an employee of the firm in February 2023 – at case management conferences and motion  
2 hearings.

3 7. Plaintiff Koki IP, LLC (“Koji”) sued Defendant Renesas Electronic Americas, Inc.,  
4 (“Renesas”) alleging that Renesas infringes U.S. Pat. Nos. 10,790,703 (“the ’703 Patent”),  
5 entitled “Smart Wireless Power Transfer Between Devices” (“Patent-in-Suit”). On November 8,  
6 2023, I filed the lawsuit in the Northern District of California (case no. 5:23-cv-05750). Based  
7 on my discussions with William P. Ramey, III, the named Partner of the firm, Koji had  
8 previously sued Renesas in the District of Colorado, and had dismissed the case without  
9 prejudice in September 2024 because the defendants had provided sufficient documentation to  
10 prove that venue was improper. It was my understanding that the defendants had agreed to the  
11 dismissal without prejudice.  
12

14 8. I understood from Mr. Ramey that he was already in communication with Renesas’s  
15 counsel, and that he would continue to communicate with counsel.  
16

17 9. On January 30, 2024, Koji filed a dismissal without prejudice. I understood from Mr.  
18 Ramey that Renesas agreed to a dismissal without prejudice, and that it was being dismissed  
19 because Renesas demonstrated that the sales volume of the accused product was very low.  
20 Renesas had not filed any motions in the case or otherwise appeared or responded to the  
21 complaint.  
22

23 10. On May 22, 2024, Koji filed a new lawsuit in this Court, accusing an entirely different  
24 Renesas system through a complaint I approved. Both Ramey LLP and Koji believed the lawsuit  
25 to be well founded and the infringement read to be good at the time of filing, that it was brought  
26 in good faith. Exhibit C to the Declaration of William P. Ramey, III (“Ramey Declaration”) is  
27  
28

1 a true and correct copy of an e-mail chain dated June 7, 2024 forwarding the complaint to in-  
2 house counsel that had contacted Mr. Ramey previously.

3 11. Renesas's lawyer responded by letter on May 31, 2024, that Koji's lawsuit was  
4 foreclosed as it had been dismissed twice. The letter asked that the lawsuit be promptly  
5 dismissed. After further discussions with Renesas's counsel, the lawsuit was dismissed with  
6 prejudice on June 12, 2024. Renesas had not entered an appearance or filed any document in the  
7 case. The case was less than two months old. Exhibit L to the Ramey Declaration is a true and  
8 correct copy of a Letter from Defendant's counsel to Ramey LLP.

9 12. Renesas's counsel responded that the previous dismissal was in effect with prejudice and  
10 therefore the current lawsuit should be dismissed. Our opinion was that the dismissal of the  
11 Colorado lawsuit did not count as a prior dismissal for purposes of Rule 41 as it was done on  
12 venue grounds and to conserve the resources of the parties. Based upon my over 20 years of  
13 practice, as with most rules, there are exceptions to a matter being dismissed with prejudice upon  
14 a second dismissal under rule 41. I believed the circumstances of the prior dismissals allowed  
15 the filing of the complaint. Mr. Ramey and I shared this understanding.

16 13. Koji instructed Mr. Ramey to seek a dismissal where each party bearing its own fees and  
17 costs but Renesas refused. Rather than fight motion practice and increase the costs for both sides,  
18 I dismissed *with prejudice* Koji's lawsuit over all products that might infringe the '703 patent.  
19 Notably, when Koji dismissed, Renesas had not entered an appearance. Renesas only entered  
20 an appearance to file its motion for fees.

21 14. After the August hearing in this matter, Mr. Ramey and I discussed the Court's  
22 requirements from the hearing. We immediately modified the practice at Ramey LLP such that

- 23 - For all matters, only admitted attorney's names are on pleadings, whether as a  
24

1 member of the bar or by pro hac and

- 2 - No longer is an attorney to be listed on pleadings as *pro hac vice anticipated* or  
3 otherwise unless admitted.  
4

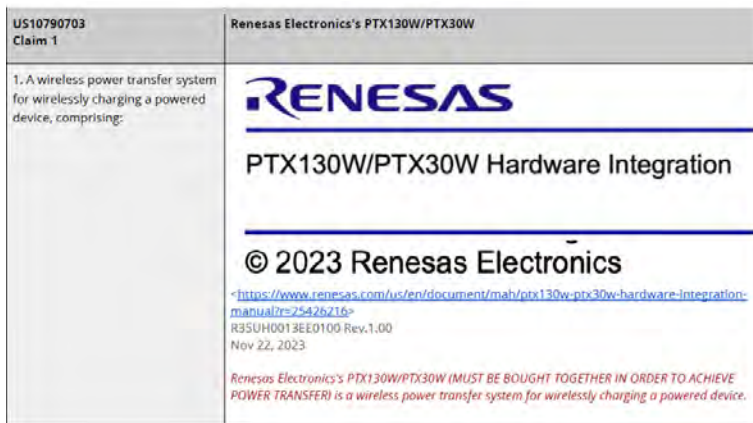
5 20. Neither I nor the other attorneys at Ramey LLP intended for the use of *pro hac vice*  
6 *anticipated* to indicate that it was practicing law in California or aiding another's practice of law.  
7 It has always been the practice of Ramey LLP to work under my California bar admission on  
8 cases pending in California. I am not aware of any case where I was not listed as the attorney of  
9 record but I acknowledge that *pro hac vice* applications were not filed in all cases for the other  
10 attorneys.  
11

12  
13 21. I always intended for the other lawyers to file a motion pro hac vice , and came to  
14 understand that they would do so and appear as a case progressed, once past pleading stage. This  
15 practice no longer occurs.  
16

17 22. I did not intend to an ethical rule of the California State Bar, Rule of Practice of this  
18 Court, or an ethical rule or rule of practice of any other State Bar, licensing authority or court  
19 and I acknowledge that the firm's prior practice was in error and I have ensured that the firm has  
20 corrected that issue. However, at all times, I was acting as lead attorney on all California matters  
21 and William Ramey and Jeffrey Kubiak were practicing under my license. Further, Mr. Ramey  
22 and Mr. Kubiak are licensed by the United States Patent & Trademark Office. Therefore, Mr.  
23 Ramey and Mr. Kubiak are authorized to advise Koji on issues of claim scope, validity, and  
24 claim coverage as it relates to the claims of the '703 patent. I trust the competent work of both  
25 Mr. Ramey and Mr. Kubiak.  
26  
27  
28

1 23. I allowed the signature block for Mr. Ramey and/or Mr. Kubiak on pleadings for Notice  
2 functions in an effort to assist me as beginning in the Summer of 2023, I was experiencing some  
3 personal issues. Ramey LLP and its lawyers were not intending to flout the rules of the court  
4 but rather work with me as I went through a difficult period and making sure no filings were  
5 missed. There was no deceptive intent involved or intent to indicate that either William Ramey  
6 or Jeffrey Kubiak was licensed to practice law in California. Further, I was not aiding or abetting  
7 the unauthorized practice of law as I was always licensed. Each of William Ramey, Jeffrey  
8 Kubiak, and I do not believe referral to a state bar, licensing authority or court for discipline is  
9 necessary. The conduct will not happen again and each lawyer apologizes to the Court. There  
10 was no intent by any lawyer at Ramey LLP to violate any ethical rule of rule of the Court.  
11  
12

13 24. I, while not involved with preparing the claim charts was satisfied that they complied  
14 with Rule 11 because competent staff and attorneys were involved in each charts preparations.  
15 I trusted the charts I was sent from Mr. Ramey because we had worked together for many years  
16 and I trusted his work. Further, the charts have not been shown frivolous as to warrant a Rule  
17 11 sanction, rather the charts are a are well grounded in fact. The charts compare each element  
18 to the accused device: For the preamble of Claim 1:  
19  
20  
21  
22  
23  
24  
25  
26  
27  
28



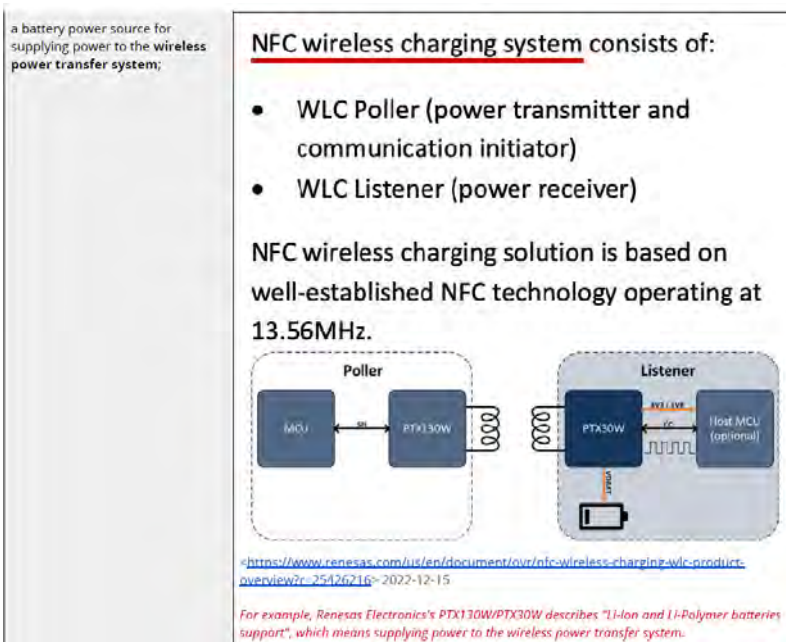
<sup>1</sup> Koji identifies defendant's accused product by web address and name, and with an explanation in red. For the next claim element, Koji identifies a product features webpage from Defendant:

US10790703 Claim 1	Renesas Electronics's PTX130W/PTX30W																																														
a battery power source for supplying power to the wireless power transfer system;	<table border="1"> <thead> <tr> <th>Product features</th><th></th></tr> </thead> <tbody> <tr><td>Ultra-low power on-chip embedded core</td><td>✓</td></tr> <tr><td>Integrated PMIC solution</td><td>✓</td></tr> <tr><td>Integrated flexible battery charger with reverse current limiter</td><td>✓</td></tr> <tr><td>Integrated highly efficient active rectifier</td><td>✓</td></tr> <tr><td>Standalone mode of operation (without Host MCU)</td><td>✓</td></tr> <tr><td>Embedded power regulation control</td><td>✓</td></tr> <tr><td>Required PCB integration area (est.)</td><td>17 mm<sup>2</sup></td></tr> <tr><td>Rectification efficiency (AC to DC)</td><td>up to 92%</td></tr> <tr><td>Energy harvesting [W]</td><td>up to 1W</td></tr> <tr><td>Charging current range [mA]</td><td>5-250 mA</td></tr> <tr><td><u>Li-Ion and Li-Polymer batteries support</u></td><td>✓</td></tr> <tr><td>Charge status monitor</td><td>✓</td></tr> <tr><td>On-chip over-temperature detection/protection</td><td>✓</td></tr> <tr><td>Transparent data exchange channel</td><td>✓</td></tr> <tr><td>Shipping mode (support for battery protection)</td><td>✓</td></tr> <tr><td>System MCU supply output voltage, typ. [V]</td><td>1.8, 3.3 V</td></tr> <tr><td>Battery-less power supply output</td><td>✓</td></tr> <tr><td>JEITA support</td><td>✓</td></tr> <tr><td>Shipping mode current consumption, typ. [nA]</td><td>25 nA</td></tr> <tr><td>I2C clock frequency [kHz]</td><td>Up to 1 MHz</td></tr> <tr><td>Available packages</td><td>CSP16</td></tr> <tr><td>Temperature range [°C]</td><td>-40 to +85</td></tr> </tbody> </table> <p><a href="https://www.renesas.com/us/en/document/tytr/nfc-wireless-charging-wlc-product-overview/r25426216">https://www.renesas.com/us/en/document/tytr/nfc-wireless-charging-wlc-product-overview/r25426216</a> 2022-12-15</p> <p><i>For example, Renesas Electronics's PTX130W/PTX30W describes "Li-Ion and Li-Polymer batteries support", which means the existence of a battery power source.</i></p>	Product features		Ultra-low power on-chip embedded core	✓	Integrated PMIC solution	✓	Integrated flexible battery charger with reverse current limiter	✓	Integrated highly efficient active rectifier	✓	Standalone mode of operation (without Host MCU)	✓	Embedded power regulation control	✓	Required PCB integration area (est.)	17 mm <sup>2</sup>	Rectification efficiency (AC to DC)	up to 92%	Energy harvesting [W]	up to 1W	Charging current range [mA]	5-250 mA	<u>Li-Ion and Li-Polymer batteries support</u>	✓	Charge status monitor	✓	On-chip over-temperature detection/protection	✓	Transparent data exchange channel	✓	Shipping mode (support for battery protection)	✓	System MCU supply output voltage, typ. [V]	1.8, 3.3 V	Battery-less power supply output	✓	JEITA support	✓	Shipping mode current consumption, typ. [nA]	25 nA	I2C clock frequency [kHz]	Up to 1 MHz	Available packages	CSP16	Temperature range [°C]	-40 to +85
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Wherein Koji identifies the element. For the next element, Koji includes another screenshot:

<sup>1</sup> Doc. No. 1-2 at 4 of 11.

<sup>2</sup> Doc. No. 1-2 at 5 of 11.



<sup>3</sup> wherein Koji explains

Defendants' wireless charging system from its own website. Koji proceeds through the next several elements to provide screenshots from Defendant's website that explain the functionality of the accused product.<sup>4</sup>

25. The claim chart prepared prior to the filing of both the second<sup>5</sup> or third lawsuit adopted a plain and ordinary construction of the claim terms, needing no further construction. The chart then compared the construed claim terms to the accused devices as shown in Doc. No. 1-2.

26. I used my best judgment at all times. Before filing the infringement action for the third time, a chart comparing a new product was prepared in collaboration between Mr. Ramey and Simon Sunatori. It is believed that this chart establishes the reasonableness of the pre-filing

<sup>3</sup> Doc. No. 1-2 at 6 of 11.

<sup>4</sup> Doc. No. 1-2 at 7-11/11.

<sup>5</sup> The claim chart filed with the first lawsuit was the same chart filed with the second lawsuit.

1 inquiry made in this patent infringement case under Rule 11. Further, the Federal Circuit has  
2 found that such an analysis is evidence of compliance with Rule 11 for a patent infringement  
3 case.

4  
5 27. I relied on my over 20 years of experience in filing the lawsuit that is the subject  
6 of this Order. As with most propositions in the law, there are exceptions that allowed the refiling  
7 of a complaint, in cases where there is “a persuasive explanation for the course of litigation,”<sup>6</sup>  
8 or where a previous dismissal was made pursuant to stipulation. Here, the dismissal in Colorado  
9 was more akin to convenience and not a merits dismissal. Further, the third lawsuit charted a  
10 new product that had not been alleged as infringing in the prior suit.

11  
12 28. My understanding of the relationship between Mr. Sunatori and Dynamic IP Deals  
13 LLC was incorrect. He is neither an owner nor an employee of Dynamic IP Deals LLC.

14 29. Plaintiffs hire Ramey LLP and its lawyers for this experience, knowing how to conduct  
15 themselves in patent infringement litigation. However, given Defendant’s counsel’s requests  
16 and comments that the sales volume of the newly charted product were low, the lawsuit was  
17 ultimately dismissed with prejudice.

18  
19 I declare under penalty of perjury under the laws of the United States of America that the  
20 foregoing is true and correct.

21 Executed on September 12, 2024.

22 /s/ Susan Kalra  
Susan Kalra

23  
24  
25  
26  
27  
28 <sup>6</sup> *Milkcrate Athletics, Inc. v. Adidas Am., Inc.*, 619 F. Supp. 3d 1009 (C.D. Cal. 2022).



Susan S.Q. Kalra (California State Bar No. 167940)  
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RAMEY LLP  
303 Twin Dolphin Drive, Suite 600  
Redwood City, CA 94065  
Telephone: (800) 993- 7499  
Fax: (832) 900-4941

*Attorneys for Plaintiff*  
KOJI IP, LLC

**IN THE UNITED STATES DISTRICT COURT  
FOR THE NORTHERN DISTRICT OF CALIFORNIA  
SAN FRANCISCO DIVISION**

KOJI IP, LLC,  
  
Plaintiff,  
  
v.  
  
RENESAS ELECTRONICS AMERICA,  
INC.,  
  
Defendant.

Case No.: 3:24-cv-03089-PHK

**DECLARATION OF WILLIAM P.  
RAMEY, III IN SUPPORT OF  
RESPONSE TO ORDER TO SHOW  
CAUSE**

**Date: September 19, 2024  
Time: 10:30 a.m.  
Judge Peter H. Kang**

**DECLARATION OF WILLIAM P. RAMEY, III**

I, William Ramey, declare as follows:

1. My name is William P. Ramey, III. I am over the age of 21. I have personal knowledge of the facts contained herein, which are true and correct. If called as a witness, I could competently testify to these statements.

2. I am licensed to practice law in the state of Texas and am an attorney with the law firm of Ramey LLP. I represent the Plaintiff in the above-captioned lawsuit.

3. In addition to reliance on my highly competent staff and the other attorneys at Ramey LLP, I also used resources including litigation support services from Simon Sunatori. I am confident in the support I receive and received from Mr. Sunatori because he is an experienced patent professional and I review his work.

4. Plaintiff Koji IP, LLC ("Koji") sued Defendant Renesas Electronic Americas, Inc., ("Renesas") alleging that Renesas infringes U.S. Pat. Nos. 10,790,703 ("the '703 Patent"), entitled "Smart Wireless Power Transfer Between Devices" ("Patent-in-Suit") in the District of Colorado on June 30, 2023.

5. Renesas's in-house counsel and director of intellectual property, Mr. Masaki Yabe, directly contacted me On July 3, 2023 about the lawsuit filed a few days earlier. Mr. Yabe offered to discuss a royalty rate for the alleged infringement and requested an extension, which was freely offered. On July 11, 2023, Mr. Yabe agreed to waive service of the summons. Exhibit A is a true and correct copy of an e-mail chain between me and Mr. Yabe.

6. On July 20, 2023, Jason Crotty appeared as counsel for Renesas and opened a dialogue with me at Ramey LLP. Mr. Crotty asked that the suit be dismissed because there was low sales

1 volume, Renesas disagreed with infringement, and venue was improperly based on a distributor.

2 Exhibit B is a true and correct copy of an e-mail chain between me and Jason Crotty.

3 7. I, on behalf of Koji, immediately began communicating with Defendant about the case,  
4 including both infringement and Defendant's contention that venue was improper. Exhibit E is  
5 a true and correct copy of an e-mail chain between me and Jason Crotty where I include our  
6 response to issues raised concerning infringement.

7 8. For venue, I provided evidence that we believed showed that Renesas controlled the sales  
8 agent, in that Renesas, on its own website, listed the location as its location:  
9

10 <http://www.renesas.com/ask/forbuyersample/locations>

11 **Sales Locations**

12 Country / Region:  Type: ☐ Distributor ☐ Sales Representative ☐ Value Added Reseller

Location	Description	Contact Info	Type
Mountain US	<b>AKI GIBB</b> Colorado & Wyoming: 2181 So. Grape St Denver, CO 80222 Utah, Idaho, Montana: 4252 Cresthaven Ln. Plehi, UT 84043	Colorado & Wyoming: Phone: 303 756 0700 Fax: 303 756 3135 Utah, Idaho, Montana: Phone: 303 756 0700 Fax: 303 756 3135 Web: <a href="http://www.aki-gibb.com">www.aki-gibb.com</a> Contact: <a href="mailto:info@aki-gibb.com">info@aki-gibb.com</a>	Sales Representative

13 14 15 16 17 18

19 Exhibit D is a true and correct copy of a July 26, 2023 e-mail chain containing a screen shot from  
20 Defendant's website that we used for venue.

21 9. For infringement, Koji provided its initial claim chart. Later Koji provided a rebuttal to  
22 Renesas position, a portion of which is reproduced here with the reminder in Exhibit E:  
23

24  
25  
26  
27  
28 <sup>1</sup> Ex. D, July 26, 2023 e-mail chain containing screenshot from Renesas website.

Additionally, the claims do not appear to read on the accused product, as they appear directed primarily to the transmission side, and the P9222-R EVK is essentially a low power receiver product.  
 • US10790703: "Smart wireless power transfer between devices"  
 • Claim 1 of US10790703: "A wireless power transfer system for wirelessly charging a powered device" which encompasses both transmitter and receiver. Therefore, there is no "primarily to the transmitter side" or "primarily to the receiver side".  
 • Renesas Electronics America's P9222-R EVK is Qi certified, i.e., it must follow both Qi's Power Transfer Protocol and Qi's Power Receiver Protocol.

• Qi Specifications | Wireless Power Consortium

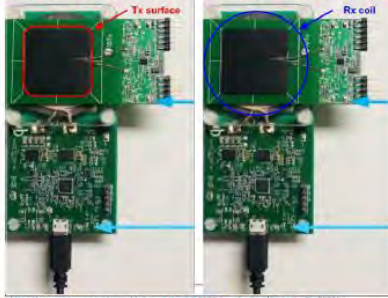
<https://www.wirelesspowerconsortium.com/data/specifications/qi/qi12/public.asp>

In fact, Renesas Electronics America's own document admits that Renesas product "P9222-R EVK Evaluation Board or any other Qi certified transmitter can be used as the power transmitter", as shown below:

The P9222-R-EVK Wireless Power Evaluation Board can be used to demonstrate the features and performance of the P9222-R 5W Wireless Power Receiver in low power 2.5W applications such as in earbuds charging cases. The P9222-R-EVK can also supply up to 5W power. IDT's P9235A-RB-EVK Evaluation Board or any other Qi certified transmitter can be used as the power transmitter for P9222-R-EVK evaluation board testing.

<https://www.renesas.com/us/en/resources/mal/p9222-r-evk-evaluation-board-q12-q12>

Renesas Electronics America wrote:  
 Even if that issue were somehow overcome, our analysis also indicates that the P9222-R EVK does not perform several limitations of the independent claims, including, as examples, the last three "wherein" limitations in Claim 1.  
 Renesas Electronics America describes "P9222-R EVK PCB boards act as a spacer between Tx surface and Rx coil" and depicts Tx surface narrower than Rx coil i.e., transmission power of the wireless communication circuitry is so controlled as to make a range of the close-range wireless communication substantially narrower than a range of the radiative power region.



<sup>2</sup> Exhibit E is a true and

correct copy of the claim chart rebuttal sent to Renesas in an e-mail chain. I substantively addressed each of Renesas noninfringement positions.

10. After receiving the sworn statements in Defendant's Motion to Dismiss, which were not previously provided to me and likely established that the location relied upon for venue was not a location of Renesas, Koji dismissed its lawsuit on September 6, 2023 without burdening the court or Renesas to address the arguments. The dismissal was filed solely to effectuate dismissal and reduce the costs for all parties. Exhibit F is a true and correct of Defendant's Motion to Dismiss, Doc. No. 14 at 3 from Cause No. 1:23-cv-1674.

11. On November 8, 2023, I had Susan Kalra refile the lawsuit in the Northern District of California and shortly thereafter began discussions with counsel for Renesas. Exhibit G is a true

<sup>2</sup> Ex. E, claim chart attached to August 1, 2023 e-mail chain, to the Ramey Decl.

1 and correct copy of the Original Complaint filed under cause number 5:23-cv-05750. Exhibit H  
2 is a true and correct copy of an e-mail chain dated January 23, 2024.

3 12. Renesas maintained that the sales volume of the accused product was very low. I and  
4 personnel at Koji looked for additional products from Defendant.

5  
6 13. Therefore, to not burden Renesas, on January 30, 2024, I agreed to dismiss without  
7 prejudice its lawsuit, to which Renesas agreed. The lawsuit was dismissed due to the low sales  
8 volume. Defendant had not filed any motions in the case or otherwise appeared or responded.  
9 Exhibit J is a true and correct copy of a January 30, 2024 e-mail chain.

10  
11 14. Shortly thereafter, I and my client's representative, Carlos Gorrichategui, Ph.D,  
12 discussed whether the sales of the newly charted product had been included in the prior numbers  
13 and came to the conclusion it was not based on what had been provided to Renesas in the prior  
14 lawsuit. Exhibit I is a true and correct copy of a claim chart directed to a new product accused  
15 of infringement. Accordingly, Koji asked Ramey LLP to file a new lawsuit based on the newly  
16 charted product created by Sunatori and Ramey LLP. Exhibit K is a true and correct copy of  
17 document number 1-2 filed in support of the Third lawsuit. On May 22, 2024, Koji filed the new  
18 lawsuit, accusing an entirely different Renesas system. Both Ramey LLP and Koji believed the  
19 lawsuit to be well founded and the infringement read to be good at the time of filing, that it was  
20 brought in good faith. Exhibit C is a true and correct copy of an e-mail chain dated June 7, 2024  
21 forwarding the complaint to in-house counsel that had contacted me previously.  
22

23  
24 15. Renesas's lawyer responded by letter on May 31, 2024, that Koji's lawsuit was  
25 foreclosed as it had been dismissed twice. The letter asked that the lawsuit be promptly  
26 dismissed. After further discussions with Renesas's counsel, the lawsuit was dismissed with  
27 prejudice on June 12, 2024. Renesas had not entered an appearance or filed any document in the  
28

1 case. The case was less than two months old. Exhibit L is a true and correct copy of a Letter  
2 from Defendant's counsel to Ramey LLP.

3 16. Mistakenly, a copy of the new lawsuit was e-mailed directly to Renesas's in-house  
4 counsel that had contacted Ramey LLP directly. After being advised by Renesas's counsel of  
5 the error, no further contact was had with the client. Ramey LLP updated its procedures to ensure  
6 that the contact does not repeat for this or other matters.

7  
8 17. Renesas's counsel responded that the previous dismissal was in effect with prejudice and  
9 therefore the current lawsuit should be dismissed. Our opinion was that the dismissal of the  
10 Colorado lawsuit did not count as a prior dismissal for purposes of Rule 41 as it was done on  
11 venue grounds and to conserve the resources of the parties. Based upon my over 20 years of  
12 practice, as with most rules, there are exceptions to a matter being dismissed with prejudice upon  
13 a second dismissal under rule 41. I believed the circumstances of the prior dismissals allowed  
14 the refiling of the complaint.

15  
16 18. Koji instructed me to seek a dismissal with each party bearing its own fees and costs but  
17 Renesas refused. Rather than fight motion practice and increase the costs for both sides, I  
18 dismissed *with prejudice* Koji's lawsuit over all products that might infringe the '703 patent.  
19 Notably, when Koji dismissed, Renesas had not entered an appearance. Renesas only entered  
20 an appearance to file its motion for fees.

21  
22 19. After the August hearing in this matter, Ms. Kalra and I discussed the Court's  
23 requirements from the hearing, in particular regarding appearing *pro hac vice*. We immediately  
24 modified the practice at Ramey LLP such that

- 25  
26 - For all matters, only admitted attorney's names are on pleadings, whether as a  
27 member of the bar or by *pro hac* and  
28

- 1           - No longer will an attorney be listed on pleadings as *pro hac vice anticipated* or  
2           otherwise unless admitted.  
3

4       20.     Neither I nor my attorneys at Ramey LLP intended for the use of *pro hac vice anticipated*  
5       to indicate that it was practicing law in California or aiding another's practice of law. It has  
6       always been the practice of Ramey LLP to work under the bar admission of Susan Kalra on cases  
7       pending in California. I am not aware of any case where Ms. Kalra was not listed as the attorney  
8       of record but acknowledges that *pro hac vice* applications were not filed in all cases for the other  
9       attorneys.  
10

11       21.     I and my lawyers at Ramey LLP always intended to file a motion *pro hac vice* as a case  
12       progressed, once past pleading stage. A decision was made by me, at the request of Carlos  
13       Gorrichategui in early 2022, a client manager, to attempt reduce costs on cases that resolved  
14       quickly, by not automatically filing a request for *pro hac vice* admission. Beginning in around  
15       2022, I directed that Ramey LLP stopped filing for *pro hac vice* applications in all cases but I  
16       incorrectly left a signature line with an attorney, that, if the case progressed, would later seek  
17       *pro hac vice* admission. That was my mistake.  
18  
19

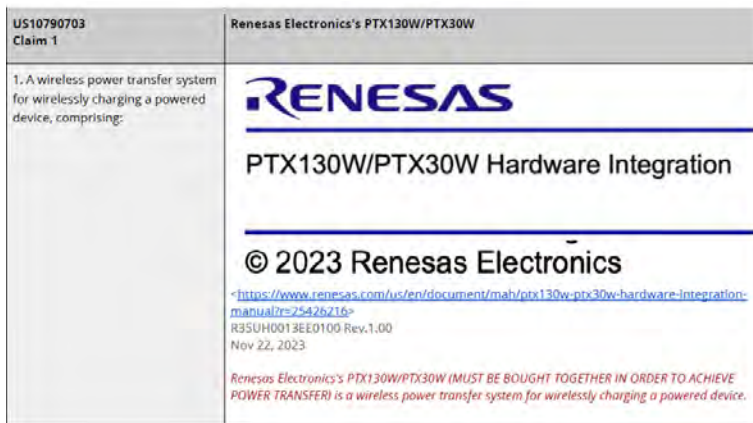
20       22.     I did not intend to violate any rule, ethical or otherwise, of the California State Bar, Rule  
21       of Practice of this Court, or an ethical rule or rule of practice of any other State Bar, licensing  
22       authority or court and I acknowledge that my prior prior practice was in error and I have corrected  
23       that issue. However, at all times, Ms. Kalra was acting as lead attorney on all California matters  
24       and William Ramey and Jeffrey Kubiak were practicing under her license. Further, I and Mr.  
25       Kubiak are licensed by the United States Patent & Trademark Office. Therefore, it is my  
26       understanding that I and Mr. Kubiak are authorized to advise Koji on issues of claim scope,  
27  
28



1 validity, and claim coverage as it relates to the claims of the '703 patent. With respect to the  
2 pleadings in California, we advised additionally while working under the license of Ms. Kalra,  
3 who while having years of experience in analyzing patent claim scope is not licensed by the  
4 USPTO.

5  
6 23. I mistakenly left the signature block of Ramey and/or Kubiak on pleadings for Notice  
7 functions in an effort to assist Ms. Kalra who beginning in the summer of 2023, experienced  
8 some personal issues. Ramey LLP and its lawyers were not intending to flout the rules of the  
9 court but rather work with a colleague going through a difficult period and making sure no filing  
10 got missed. There was no deceptive intent involved or intent to indicate that either I or Jeffrey  
11 Kubiak was licensed to practice law in California. Further, Ms. Kalra was not aiding or abetting  
12 the unauthorized practice of law as she was always licensed. Each of Susan Kalra, Jeffrey  
13 Kubiak, and I do not believe referral to an state bar, licensing authority or court for discipline is  
14 necessary. The conduct will not happen again and each lawyer apologizes to the Court. There  
15 was no intent by any lawyer at Ramey LLP to violate any ethical rule of rule of the Court.  
16  
17

18  
19 24. Ms. Kalra, while not involved with preparing the claim charts was satisfied that they  
20 complied with Rule 11 because I was involved in the chart's preparations. Ms. Kalra trusted the  
21 charts Mr. Kubiak and I sent her because we had worked together for years and she trusted our  
22 work. Further, the charts have not been shown to frivolous to warrant a Rule 11 sanction, rather  
23 the charts are well grounded in fact. The claim charts for the May 22, 2023 lawsuit compare  
24 each element to the accused device: For the preamble of Claim 1:  
25  
26  
27  
28



<sup>3</sup> Koji identifies defendant's

accused product by web address and name, and with an explanation in red. For the next claim element, Koji identifies a product features webpage from Defendant:

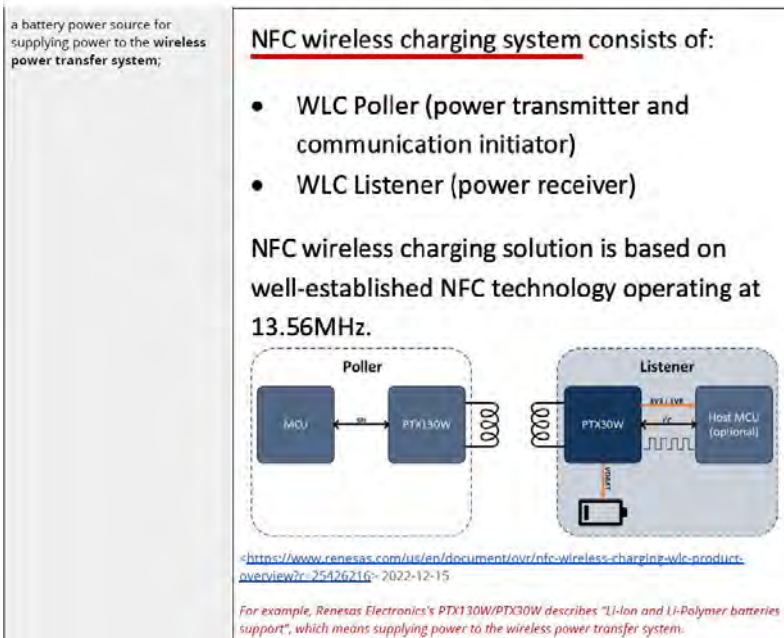
US10790703 Claim 1	Renesas Electronics's PTX130W/PTX30W																																														
a battery power source for supplying power to the wireless power transfer system;	<table border="1"> <thead> <tr> <th>Product features</th><th></th></tr> </thead> <tbody> <tr><td>Ultra-low power on-chip embedded core</td><td>✓</td></tr> <tr><td>Integrated PMIC solution</td><td>✓</td></tr> <tr><td>Integrated flexible battery charger with reverse current limiter</td><td>✓</td></tr> <tr><td>Integrated highly efficient active rectifier</td><td>✓</td></tr> <tr><td>Standalone mode of operation (without Host MCU)</td><td>✓</td></tr> <tr><td>Embedded power regulation control</td><td>✓</td></tr> <tr><td>Required PCB integration area (est.)</td><td>17 mm<sup>2</sup></td></tr> <tr><td>Rectification efficiency (AC to DC)</td><td>up to 92%</td></tr> <tr><td>Energy harvesting (W)</td><td>up to 1W</td></tr> <tr><td>Charging current range (mA)</td><td>5-250 mA</td></tr> <tr><td><u>Li-Ion and Li-Polymer batteries support</u></td><td>✓</td></tr> <tr><td>Charge status monitor</td><td>✓</td></tr> <tr><td>On-chip over-temperature detection/protection</td><td>✓</td></tr> <tr><td>Transparent data exchange channel</td><td>✓</td></tr> <tr><td>Shipping mode (support for battery protection)</td><td>✓</td></tr> <tr><td>System MCU supply output voltage, typ. (V)</td><td>1.8, 3.3 V</td></tr> <tr><td>Battery-less power supply output</td><td>✓</td></tr> <tr><td>JEITA support</td><td>✓</td></tr> <tr><td>Shipping mode current consumption, typ. (nA)</td><td>25 nA</td></tr> <tr><td>I2C clock frequency (kHz)</td><td>Up to 1 MHz</td></tr> <tr><td>Available packages</td><td>CSP16</td></tr> <tr><td>Temperature range (°C)</td><td>-40 to +85</td></tr> </tbody> </table> <p><a href="https://www.renesas.com/us/en/document/ovtr/nfc-wireless-charging-wlc-product-overview/r35uh0013ee0100">https://www.renesas.com/us/en/document/ovtr/nfc-wireless-charging-wlc-product-overview/r35uh0013ee0100</a> 2022-12-15</p> <p>For example, Renesas Electronics's PTX130W/PTX30W describes "Li-Ion and Li-Polymer batteries support", which means the existence of a battery power source.</p>	Product features		Ultra-low power on-chip embedded core	✓	Integrated PMIC solution	✓	Integrated flexible battery charger with reverse current limiter	✓	Integrated highly efficient active rectifier	✓	Standalone mode of operation (without Host MCU)	✓	Embedded power regulation control	✓	Required PCB integration area (est.)	17 mm <sup>2</sup>	Rectification efficiency (AC to DC)	up to 92%	Energy harvesting (W)	up to 1W	Charging current range (mA)	5-250 mA	<u>Li-Ion and Li-Polymer batteries support</u>	✓	Charge status monitor	✓	On-chip over-temperature detection/protection	✓	Transparent data exchange channel	✓	Shipping mode (support for battery protection)	✓	System MCU supply output voltage, typ. (V)	1.8, 3.3 V	Battery-less power supply output	✓	JEITA support	✓	Shipping mode current consumption, typ. (nA)	25 nA	I2C clock frequency (kHz)	Up to 1 MHz	Available packages	CSP16	Temperature range (°C)	-40 to +85
Product features																																															
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Integrated flexible battery charger with reverse current limiter	✓																																														
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Available packages	CSP16																																														
Temperature range (°C)	-40 to +85																																														

<sup>4</sup>

Wherein Koji identifies the element. For the next element, Koji includes another screenshot:

<sup>3</sup> Doc. No. 1-2 at 4 of 11.

<sup>4</sup> Doc. No. 1-2 at 5 of 11.



<sup>5</sup> wherein Koji explains

Defendants' wireless charging system from its own website. Koji proceeds through the next several elements to provide screenshots from Defendant's website that explain the functionality of the accused product.<sup>6</sup>

25. The claim chart prepared prior to the filing of both the second<sup>7</sup> or third lawsuit adopted a plain and ordinary construction of the claims terms, needing no further construction. I then compared the construed claim terms to the accused devices as shown in Doc. No. 1-2.

26. I used my best judgment at all times, to evaluate my Firm's and my position and modified that position to make the litigation less burdensome to all parties. Before filing the infringement action for the third time, a chart comparing a new product was prepared in collaboration between

<sup>5</sup> Doc. No. 1-2 at 6 of 11.

<sup>6</sup> Doc. No. 1-2 at 7-11/11.

<sup>7</sup> The claim chart filed with the first lawsuit was the same chart filed with the second lawsuit.

1 me and Simon Sunatori. It is believed that this chart establishes the reasonableness of the pre-  
2 filing inquiry made in this patent infringement case under Rule 11. Further, the Federal Circuit  
3 has found that such an analysis is evidence of compliance with Rule 11 for a patent infringement  
4 case.  
5

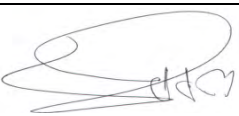
6 27. I relied on my over 20 years of experience in refiling the lawsuit. As with most  
7 propositions in the law, there are exceptions that allowed the refiling of a complaint, in cases  
8 where there is "a persuasive explanation for the course of litigation."<sup>8</sup> Here, the dismissal in  
9 Colorado was more akin to convenience and not a merits dismissal. Further, the third lawsuit  
10 charted a new product that had not been alleged as infringing in the prior suit.

11 28. Plaintiffs hire Ramney LLP and its lawyers for this experience, knowing how to conduct  
12 themselves in patent infringement litigation. However, given Defendant's counsels requests and  
13 comments that the sales volume of the newly charted product were low, the lawsuit was  
14 ultimately dismissed with prejudice.  
15

16 I declare under penalty of perjury under the laws of the United States of America that the  
17 foregoing is true and correct.  
18

19 Executed on September 12, 2024.

20 William P. Ramney, III

21 

22 8 *Milkroute Athletics, Inc. v. Adidas Am, Inc.*, 619 F. Supp. 3d 1009 (C.D. Cal. 2022).

# EXHIBIT A

**From:** Masaki Yabe  
**To:** Jeff Kubiak; William Ramey  
**Cc:** LitigationParalegals  
**Subject:** RE: KOJI IP, LLC, v. RENESAS ELECTRONICS AMERICA INC.  
**Date:** Tuesday, July 11, 2023 6:34:53 PM  
**Attachments:** [image001.png](#)

---

Dear Mr. Kubiak,

Thank you for your message, and I do agree waiver of service to REA, for automatic 60 days.

Kindest,

Masaki

---

**From:** Jeff Kubiak <jkubiak@rameyfirm.com>  
**Sent:** Saturday, July 8, 2023 4:24 AM  
**To:** Masaki Yabe <masaki.yabe.ue@renesas.com>; William Ramey <wramey@rameyfirm.com>  
**Cc:** LitigationParalegals <LitParalegals@rameyfirm.com>  
**Subject:** Re: KOJI IP, LLC, v. RENESAS ELECTRONICS AMERICA INC.

Mr. Yabe,

Right now we cannot file an extension as the summons has not been served.

However, if you agree to accept service and provided that we can stop service on our end, you automatically receive 60 days to answer instead of the standard 21 days to answer. If necessary, we can then file extensions to provide more time to answer. Courts typically frown on long extensions which is why I suggest accepting service.

Otherwise, once the summons is served we will file the extension.

Jeff

Jeffrey E Kubiak

Partner

Ramey LLP

5020 Montrose Blvd., Suite 800

Houston, Texas 77006

713-426-3923

832-900-4941 (fax)

713-294-2956 (cell)

[www.rameyfirm.com](http://www.rameyfirm.com)

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This e-mail may contain confidential information. If you are not the intended recipient, please delete this e-mail. If you have any questions, please call 713-426-3923.

---

**From:** Masaki Yabe <[masaki.yabe.ue@renesas.com](mailto:masaki.yabe.ue@renesas.com)>  
**Sent:** Wednesday, July 5, 2023 12:43 AM  
**To:** William Ramey <[wramey@rameyfirm.com](mailto:wramey@rameyfirm.com)>; Jeff Kubiak <[jkubiak@rameyfirm.com](mailto:jkubiak@rameyfirm.com)>  
**Cc:** LitigationParalegals <[LitParalegals@rameyfirm.com](mailto:LitParalegals@rameyfirm.com)>  
**Subject:** RE: KOJI IP, LLC, v. RENESAS ELECTRONICS AMERICA INC.

Bill-san,

Now I notice I read your message skipping "No" and mistakenly read "There is problem on the extension." I apologies my confusion. Anyway, I look forward to seeing as filed motion to extend. Thank you.

Kindest,

Masaki

---

**From:** Masaki Yabe  
**Sent:** Tuesday, July 4, 2023 9:57 PM  
**To:** William Ramey <[wramey@rameyfirm.com](mailto:wramey@rameyfirm.com)>; Jeff Kubiak <[jkubiak@rameyfirm.com](mailto:jkubiak@rameyfirm.com)>  
**Cc:** LitigationParalegals <[LitParalegals@rameyfirm.com](mailto:LitParalegals@rameyfirm.com)>  
**Subject:** RE: KOJI IP, LLC, v. RENESAS ELECTRONICS AMERICA INC.

Bill,

I got it. Thank you for letting us know your agreement with extension. I would appreciate it if you would file such within this week. Once confirmed, we are going to arrange a call. As you can tell, if we cannot confirm extension, I have to retain outside counsel to file answer in timely manner. By the way, as said, I have not yet confirmed the service on our US subsidiary. Please let me know the status of service.

Kindest,

Masaki

---

**From:** William Ramey <[wramey@rameyfirm.com](mailto:wramey@rameyfirm.com)>  
**Sent:** Tuesday, July 4, 2023 9:45 PM  
**To:** Masaki Yabe <[masaki.yabe.ue@renesas.com](mailto:masaki.yabe.ue@renesas.com)>; Jeff Kubiak <[jkubiak@rameyfirm.com](mailto:jkubiak@rameyfirm.com)>  
**Cc:** LitigationParalegals <[LitParalegals@rameyfirm.com](mailto:LitParalegals@rameyfirm.com)>  
**Subject:** RE: KOJI IP, LLC, v. RENESAS ELECTRONICS AMERICA INC.

No, we agree with the extension. We always agree with extensions.

We can get it on file for you.

Thanks,

Bill

---

**From:** Masaki Yabe <[masaki.yabe.ue@renesas.com](mailto:masaki.yabe.ue@renesas.com)>  
**Sent:** Tuesday, July 4, 2023 7:43 AM  
**To:** William Ramey <[wramey@rameyfirm.com](mailto:wramey@rameyfirm.com)>; Jeff Kubiak <[jkubiak@rameyfirm.com](mailto:jkubiak@rameyfirm.com)>  
**Cc:** LitigationParalegals <[LitParalegals@rameyfirm.com](mailto:LitParalegals@rameyfirm.com)>  
**Subject:** Re: KOJI IP, LLC, v. RENESAS ELECTRONICS AMERICA INC.

Bill,

ADD0831



You mean you disagree with any extension? If so, we are going to retain out side counsel to file answer in due course.

Kindest,

Masaki

---

差出人: William Ramey <[wramey@rameyfirm.com](mailto:wramey@rameyfirm.com)>

送信日時: Tuesday, July 4, 2023 9:24:05 PM

宛先: Masaki Yabe <[masaki.yabe.ue@renesas.com](mailto:masaki.yabe.ue@renesas.com)>; Jeff Kubiak <[jkubiak@rameyfirm.com](mailto:jkubiak@rameyfirm.com)>

CC: LitigationParalegals <[LitParalegals@rameyfirm.com](mailto:LitParalegals@rameyfirm.com)>

件名: RE: KOJI IP, LLC, v. RENESAS ELECTRONICS AMERICA INC.

Hi Masaki,

Let us discuss next week? There is no problem on the extension.

Are you free for a discussion?

Thanks,

Bill

William P. Ramey, III



5020 Montrose Bvd., Suite 800

Houston, Texas 77006

(713) 426-3923

(832) 900-4941 (facsimile)

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---

**From:** Masaki Yabe <[masaki.yabe.ue@renesas.com](mailto:masaki.yabe.ue@renesas.com)>

**Sent:** Monday, July 3, 2023 8:54 PM

**To:** William Ramey <[wramey@rameyfirm.com](mailto:wramey@rameyfirm.com)>; Jeff Kubiak <[jkubiak@rameyfirm.com](mailto:jkubiak@rameyfirm.com)>

**Subject:** KOJI IP, LLC, v. RENESAS ELECTRONICS AMERICA INC.

Dear Mr. Ramey

Greeting Mr. Ramey. I am Masaki Yabe, Director, IP Litigation Dept. , Renesas Electronics Corporation. I noticed the captioned case against our US subsidiary. While I have not yet studied the complaint well, it looks your client would seek early resolution.

Please note that at this moment, we have not yet retained outside counsel, but once we retain outside counsel and spent resource and cost, I will lose flexibility. In this regard, I would appreciate it if you would agree 90 days extension for answer, so that we can study your allegation without spending atty fee. As said, we have not yet retained outside counsel, and thus if you agree the above extension, we would appreciate it if you would prepare and file unopposed motion for such extension on behalf of both parties.

Meantime, if you agree such extension, we also happy to listen standard royalty rate for this matter, too.

Kindest,

Masaki Yabe

Director

IP Litigation Department

Legal Division

Renesas Electronics Corporation

ADD0832

E-mail: [masaki.yabe.ue@renesas.com](mailto:masaki.yabe.ue@renesas.com)

Tel : +81-3-6773-4429

URL : <http://www.renesas.com>

"This message contains information which may be confidential and privileged. Unless you are the addressee (or authorized to receive for the addressee), you may not use, copy, distribute or disclose to anyone the message or any information contained in the message. If you have received the message in error, please delete the message completely from your system. Thank you."

ADD0833

# EXHIBIT B

ADD0834

**From:** [Jason Crotty](#)  
**To:** [Jeff Kubiak](#); [William Ramey](#)  
**Cc:** [Jason Crotty](#)  
**Subject:** RE: Koji IP, LLC v. Renesas Electronics America, Inc. (D. Col.)  
**Date:** Thursday, July 20, 2023 1:44:47 PM

---

Jeff:

I think it makes sense to address the venue issue before an extension, let alone a series of extensions. Can you explain the basis for Colorado as the proper venue, as the address alleged in the complaint is not an address for Renesas.

I am happy to discuss if that would be useful.

Jason A. Crotty  
Mauriel Kapouytian Woods LLP  
450 Sansome St., Ste. 1005  
San Francisco CA 94111  
(415) 969-6918

---

**From:** Jeff Kubiak <[jkubiak@rameyfirm.com](mailto:jkubiak@rameyfirm.com)>  
**Sent:** Thursday, July 20, 2023 11:34 AM  
**To:** Jason Crotty <[Jcrotty@mkwllp.com](mailto:Jcrotty@mkwllp.com)>; William Ramey <[wramey@rameyfirm.com](mailto:wramey@rameyfirm.com)>  
**Subject:** [EXT] Re: Koji IP, LLC v. Renesas Electronics America, Inc. (D. Col.)

Mr Crotty,

The extension Mr Yabe has asked for is a bit problematic, he asked for 90 days. The courts frown on such long extensions. While we are trying to accommodate him we have asked if Renesas would waive service to provide the first 60 days of extension to answer. He seemed to indicate that Renesas would sign the waiver, therefore our paralegal forwarded the waiver of service form to Mr Yabe. When we reach the end of the 60 time under the waiver we can then file for another 30 day extension. While the summons was served on Renesas, we have not filed it with the court in anticipation of receiving the signed waiver.

If you agree with this plan please sign the attached waiver and return it to me and Ms Hueske.

If not, let me know how y'all would prefer to proceed.

Jeff

Jeffrey E Kubiak

Partner

Ramey LLP

5020 Montrose Blvd., Suite 800

Houston, Texas 77006

713-426-3923

832-900-4941 (fax)

713-294-2956 (cell)

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This e-mail may contain confidential information. If you are not the intended recipient, please delete this e-mail. If you have any questions, please call 713-426-3923.

---

**From:** Jason Crotty <[jcrotty@mkwllp.com](mailto:jcrotty@mkwllp.com)>

**Sent:** Tuesday, July 18, 2023 1:07 PM

**To:** Jeff Kubiak <[jkubiak@rameyfirm.com](mailto:jkubiak@rameyfirm.com)>; William Ramey <[wramey@rameyfirm.com](mailto:wramey@rameyfirm.com)>

**Subject:** Koji IP, LLC v. Renesas Electronics America, Inc. (D. Col.)

Gentlemen:

Renesas asked me to reach out regarding the Koji IP case. I understand you have been in contact with Masaki Yabe and an extension to respond has been granted.

I believe that Mr. Yabe also explained that the US sales for the past six years for the accused product amount to approximately \$4,000. Additionally, the claims do not appear to read on the accused product, as they appear directed primarily to the transmission side, and the P9222-R-EVK is essentially a low power receiver product. Even if that issue were somehow overcome, our analysis also indicates that the P9222-R-EVK does not perform several limitations of the independent claims, including, as examples, the last three "wherein" limitations in Claim 1.

Finally, the case was filed in an improper venue. The complaint alleges that REA has a facility at 2181 So. Grape St., Denver, CO 80222. However, REA is headquartered in [California](#). The address listed in the complaint appears to be that of a Renesas [distributor \(AKI GIBB\)](#) rather than REA. Thus, the case was filed in the wrong court.

For these reasons, the case should be voluntarily dismissed. Even putting aside the infringement issues, given the *de minimis* sales, there is nowhere near enough exposure to justify refiling in a proper court.

If you would like to discuss, please give me a call.

Jason A. Crotty  
Mauriel Kapouytian Woods LLP  
450 Sansome St., Ste. 1005  
San Francisco CA 94111  
(415) 969-6918

ADD0836

Case 3:24-cv-03089-PHK Document 28-9 Filed 09/12/24 Page 1 of 84

# EXHIBIT G

ADD0837

Susan S.Q. Kalra (CA State Bar No. 16740)  
Email: skalra@rameyfirm.com  
RAMEY LLP  
5020 Montrose Blvd., Suite 800  
Houston, Texas 77006  
Telephone: (800) 993-7499  
Fax: (832) 900-4941

William P. Ramey, III (*pro hac vice* anticipated)  
Email: wramey@rameyfirm.com  
RAMEY LLP  
5020 Montrose Blvd., Suite 800  
Houston, TX 77006  
Telephone: (713) 426-3923  
Fax: (832) 689-9175

*Attorneys for Plaintiff*  
Koji IP, LLC

**UNITED STATES DISTRICT COURT  
NORTHERN DISTRICT OF CALIFORNIA**

KOJI IP, LLC, a Texas Corporation,

Plaintiff,

v.

RENESAS ELECTRONICS  
AMERICA, INC., a California  
Corporation,

Defendant.

Case No.: 5:23-cv-05752

**PLAINTIFF'S COMPLAINT FOR  
PATENT INFRINGEMENT**

**(35 U.S.C. § 271)**

**JURY TRIAL DEMANDED**

Koji IP, LLC ("Plaintiff" or "Koji") files this Original Complaint and demand for jury trial seeking relief from patent infringement of the claims of U.S. Patent No. 10,790,703 ("the '703 patent") (referred to as the "Patent-in-Suit") by



1 Renesas Electronics America Inc. (“Defendant” or “Renesas”).

2 **I. THE PARTIES**

3  
4 1. Plaintiff is a Texas Limited Liability Company with its principal place of  
5 business located in Travis County, Texas.

6  
7 2. On information and belief, Defendant is a corporation organized and existing  
8 under the laws of the State of California, with a regular and established place of  
9 business located at 6024 Silver Creek Valley Road, San Jose, California 95138.

10  
11 3. On information and belief, Defendant sells and offers to sell products and  
12 services throughout Colorado, including in this judicial district, and introduces  
13 products and services that perform infringing methods or processes into the stream of  
14 commerce knowing that they would be sold in Colorado and this judicial district.  
15  
16 Defendant can be served with process through their registered agent, Corporation  
17 Service Company d/b/a CSC-Lawyers Incorporating Service, 2710 Gateway Oaks  
18 Dr., Sacramento, California 95833, at its place of business, or anywhere else it may  
19 be found.  
20

21 **II. JURISDICTION AND VENUE**

22  
23 4. This Court has original subject-matter jurisdiction over the entire action  
24 pursuant to 28 U.S.C. §§ 1331 and 1338(a) because Plaintiff’s claim arises under an  
25 Act of Congress relating to patents, namely, 35 U.S.C. § 271.

26  
27 5. This Court has personal jurisdiction over Defendant because: (i) Defendant is  
28 present within or has minimum contacts within the State of Colorado and this judicial

1 district; (ii) Defendant has purposefully availed itself of the privileges of conducting  
2 business in the State of Colorado and in this judicial district; and (iii) Plaintiff's cause  
3 of action arises directly from Defendant's business contacts and other activities in the  
4 State of Colorado and in this judicial district.

6 6. Venue is proper in this district under 28 U.S.C. §§ 1391(b) and 1400(b).  
7 Defendant has committed acts of infringement and has a regular and established place  
8 of business in this District. Further, venue is proper because Defendant conducts  
9 substantial business in this forum, directly or through intermediaries, including: (i) at  
10 least a portion of the infringements alleged herein; and (ii) regularly doing or  
11 soliciting business, engaging in other persistent courses of conduct and/or deriving  
12 substantial revenue from goods and services provided to individuals in Colorado and  
13 this District.

### 17 **III. INFRINGEMENT - Infringement of the '703 Patent**

18 7. On September 29, 2020, U.S. Patent No. 10,790,703 ("the '703 patent",  
19 included as Exhibit A and part of this complaint) entitled "Smart wireless power  
20 transfer between devices" was duly and legally issued by the U.S. Patent and  
21 Trademark Office. Plaintiff owns the '703 patent by assignment.

24 8. The '703 patent relates to novel and improved methods and systems for  
25 wireless power charging.

26 9. Defendant maintains, operates, and administers systems, products, and services  
27 that infringes one or more of claims 1-4 of the '703 patent, literally or under the  
28

1 doctrine of equivalents. Defendant put the inventions claimed by the '703 Patent into  
2 service (i.e., used them); but for Defendant's actions, the claimed-inventions  
3  
4 embodiments involving Defendant's products and services would never have been  
5 put into service. Defendant's acts complained of herein caused those claimed-  
6 invention embodiments as a whole to perform, and Defendant's procurement of  
7  
8 monetary and commercial benefit from it.

9 10. Support for the allegations of infringement may be found in the chart attached  
10 as Exhibit B. These allegations of infringement are preliminary and are therefore  
11  
12 subject to change.

13 11. Defendant has and continues to induce infringement. Defendant has actively  
14 encouraged or instructed others (e.g., its customers and/or the customers of its related  
15 companies), and continues to do so, on how to use its products and services (e.g., for  
16 wireless power charging) such as to cause infringement of one or more of claims 1-4  
17 of the '703 patent, literally or under the doctrine of equivalents. Moreover, Defendant  
18  
19 has known of the '703 patent and the technology underlying it from at least the filing  
20 date of the lawsuit.<sup>1</sup> For clarity, direct infringement is previously alleged in this  
21  
22 complaint.  
23

24 12. Defendant has and continues to contributorily infringe. Defendant has actively  
25 encouraged or instructed others (e.g., its customers and/or the customers of its related  
26

27  
28 <sup>1</sup> Plaintiff reserves the right to amend and add inducement pre-suit if discovery reveals an earlier date of knowledge.

1 companies), and continues to do so, on how to use its products and services (e.g., for  
2 wireless power charging) and related services such as to cause infringement of one or  
3 more of claims 1-4 of the '703 patent, literally or under the doctrine of equivalents.  
4 Further, there are no substantial non-infringing uses for Defendant's products and  
5 services. Moreover, Defendant has known of the '703 patent and the technology  
6 underlying it from at least the filing date of the lawsuit.<sup>2</sup> For clarity, direct  
7 infringement is previously alleged in this complaint.  
8

9  
10 13. Defendant has caused and will continue to cause Plaintiff damage by direct and  
11 indirect infringement of (including inducing infringement of) the claims of the '703  
12 patent.  
13

#### 14 **IV. JURY DEMAND**

15 Plaintiff hereby requests a trial by jury on issues so triable by right.  
16

#### 17 **V. PRAYER FOR RELIEF**

18 WHEREFORE, Plaintiff prays for relief as follows:  
19

- 20 a. enter judgment that Defendant has infringed the claims of the '703 patent;  
21 b. award Plaintiff damages in an amount sufficient to compensate it for  
22 Defendant's infringement of the Patents-in-Suit in an amount no less than a  
23 reasonable royalty or lost profits, together with pre-judgment and post-  
24 judgment interest and costs under 35 U.S.C. § 284;  
25

26  
27  
28 <sup>2</sup> Plaintiff reserves the right to amend and add inducement pre-suit if discovery reveals an earlier date of knowledge.

- c. award Plaintiff an accounting for acts of infringement not presented at trial and an award by the Court of additional damage for any such acts of infringement;
- d. declare this case to be “exceptional” under 35 U.S.C. § 285 and award Plaintiff its attorneys’ fees, expenses, and costs incurred in this action;
- e. declare Defendant’s infringement to be willful and treble the damages, including attorneys’ fees, expenses, and costs incurred in this action and an increase in the damage award pursuant to 35 U.S.C. § 284;
- f. a decree addressing future infringement that either (i) awards a permanent injunction enjoining Defendant and its agents, servants, employees, affiliates, divisions, and subsidiaries, and those in association with Defendant from infringing the claims of the Patents-in-Suit, or (ii) awards damages for future infringement in lieu of an injunction in an amount consistent with the fact that for future infringement the Defendant will be an adjudicated infringer of a valid patent, and trebles that amount in view of the fact that the future infringement will be willful as a matter of law; and
- g. award Plaintiff such other and further relief as this Court deems just and proper.

1 Dated: November 8, 2023

Respectfully submitted,

2 RAMEY LLP

3 /s/ Susan S.Q. Kalra

4 Susan S.Q. Kalra (CA State Bar No. 16740)

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9 *Attorneys for Plaintiff*

10 *Koji IP LLC*

**DEMAND FOR JURY TRIAL**

Plaintiff hereby requests a trial by jury on issues so triable by right.

Dated: November 8, 2023

Respectfully submitted,

**RAMEY LLP**

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Case 2:25-cv-00308-K Document 1-1 Filed 04/12/25 Page 1 of 84

# EXHIBIT A





US010790703B2

(12) **United States Patent**  
**Yoden**

(10) **Patent No.:** **US 10,790,703 B2**

(45) **Date of Patent:** **Sep. 29, 2020**

(54) **SMART WIRELESS POWER TRANSFER BETWEEN DEVICES**

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(71) Applicant: **Koji Yoden**, Tamba (JP)

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(72) Inventor: **Koji Yoden**, Tamba (JP)

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(\*) Notice: Subject to any disclaimer, the term of this patent is extended or adjusted under 35 U.S.C. 154(b) by 0 days.

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(21) Appl. No.: **15/843,092**

(22) Filed: **Dec. 15, 2017**

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US 2018/0175672 A1 Jun. 21, 2018

"How can I maximize the read distance of an NFC system", Mark Roberti, RFID Journal, Published Mar. 3, 2016, Accessed Online Feb. 22, 2019, <https://www.rfidjournal.com/blogs/experts/entry?11643> (Year: 2016).\*

(Continued)

**Related U.S. Application Data**

*Primary Examiner* — John T Trischler

(60) Provisional application No. 62/435,883, filed on Dec. 19, 2016.

(57) **ABSTRACT**

(51) **Int. Cl.**

**H02J 50/12** (2016.01)

**H02J 7/02** (2016.01)

**H02J 50/05** (2016.01)

**H02J 50/40** (2016.01)

**H02J 50/80** (2016.01)

(52) **U.S. Cl.**

CPC ..... **H02J 50/12** (2016.02); **H02J 7/025**

(2013.01); **H02J 50/05** (2016.02); **H02J 50/40**

(2016.02); **H02J 50/80** (2016.02)

(58) **Field of Classification Search**

CPC .. H02J 7/025; H02J 50/12; H02J 50/40; H02J 50/80; H02J 50/05

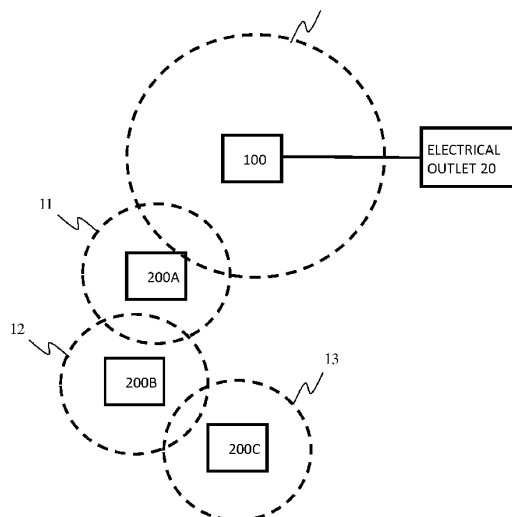
USPC ..... 320/108

See application file for complete search history.

In an aspect, a wireless power transfer system includes at least one powering device and at least one powered device. Each powering device includes powering circuitry for wireless power transfer to the powered device. Each powered device includes powered circuitry for reception of the wireless power transfer from the powering device. The powering device may include communication circuitry for a close-range wireless communication with the powered device, while the powered device may also include communication circuitry for the close-range wireless communication with the powering device, so as for the powering device and the powered device to discover each other through the communication. The powering device and powered device may conditionally activate and deactivate the powering circuitry and powered circuitry, respectively, based on the discovery using the close-range wireless communication.

**4 Claims, 40 Drawing Sheets**

NON-RADIATIVE OR RADIATIVE POWERING REGION 10



ADD0847

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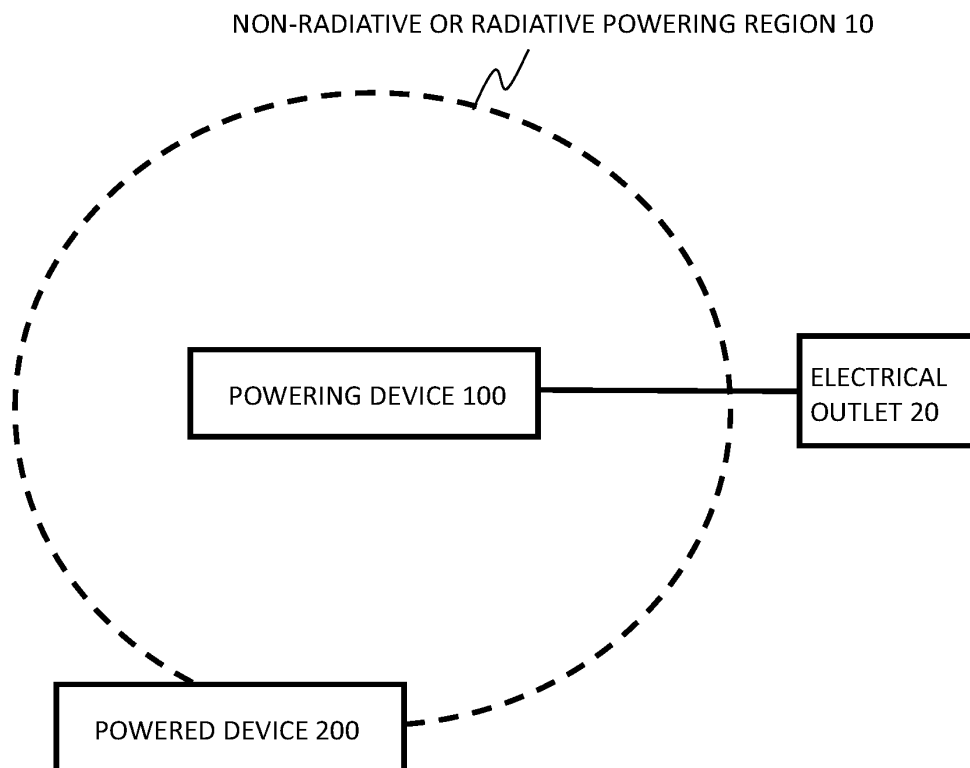
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**U.S. Patent**

Sep. 29, 2020

Sheet 1 of 40

**US 10,790,703 B2**



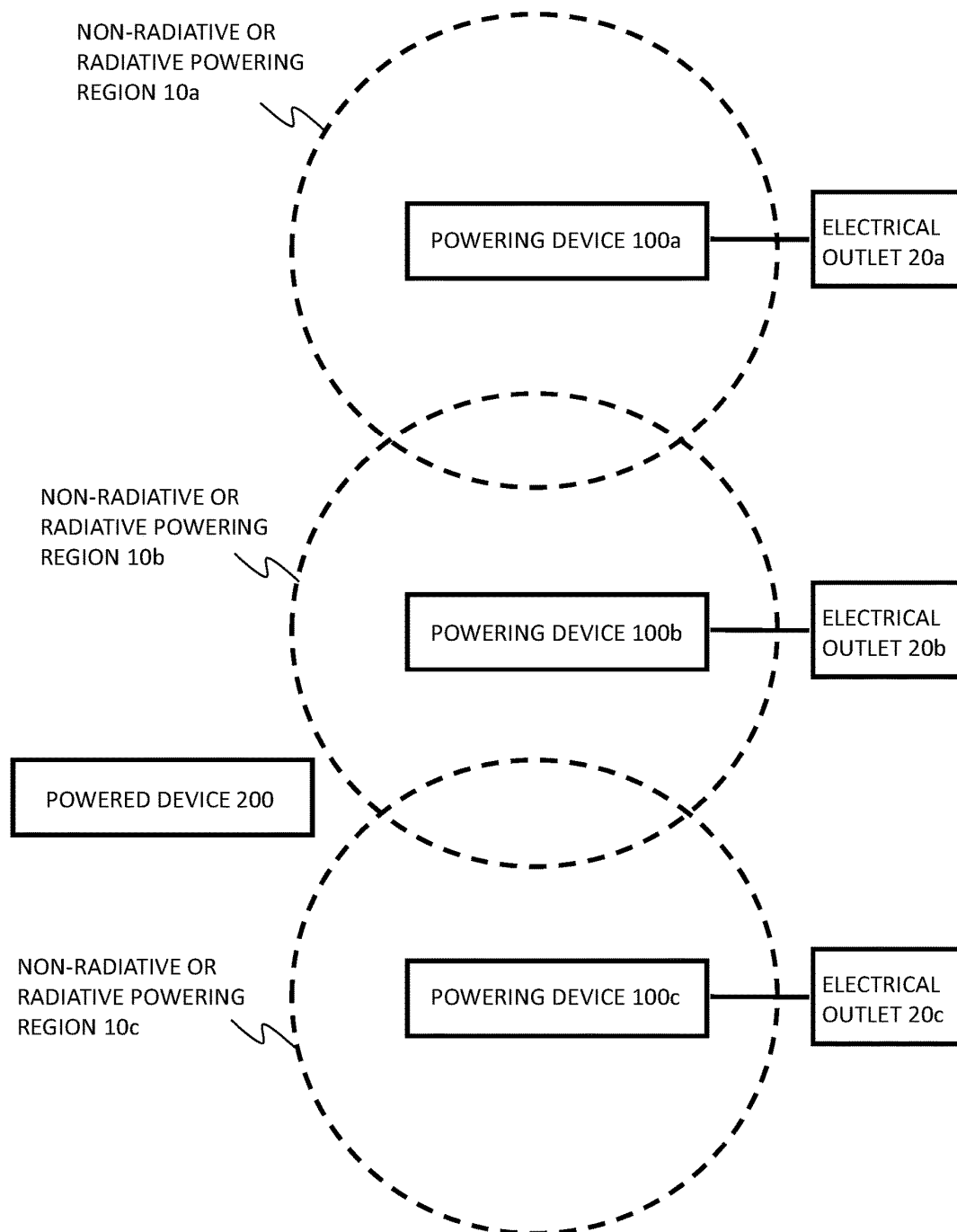
**FIG. 1**

**U.S. Patent**

Sep. 29, 2020

Sheet 2 of 40

**US 10,790,703 B2**



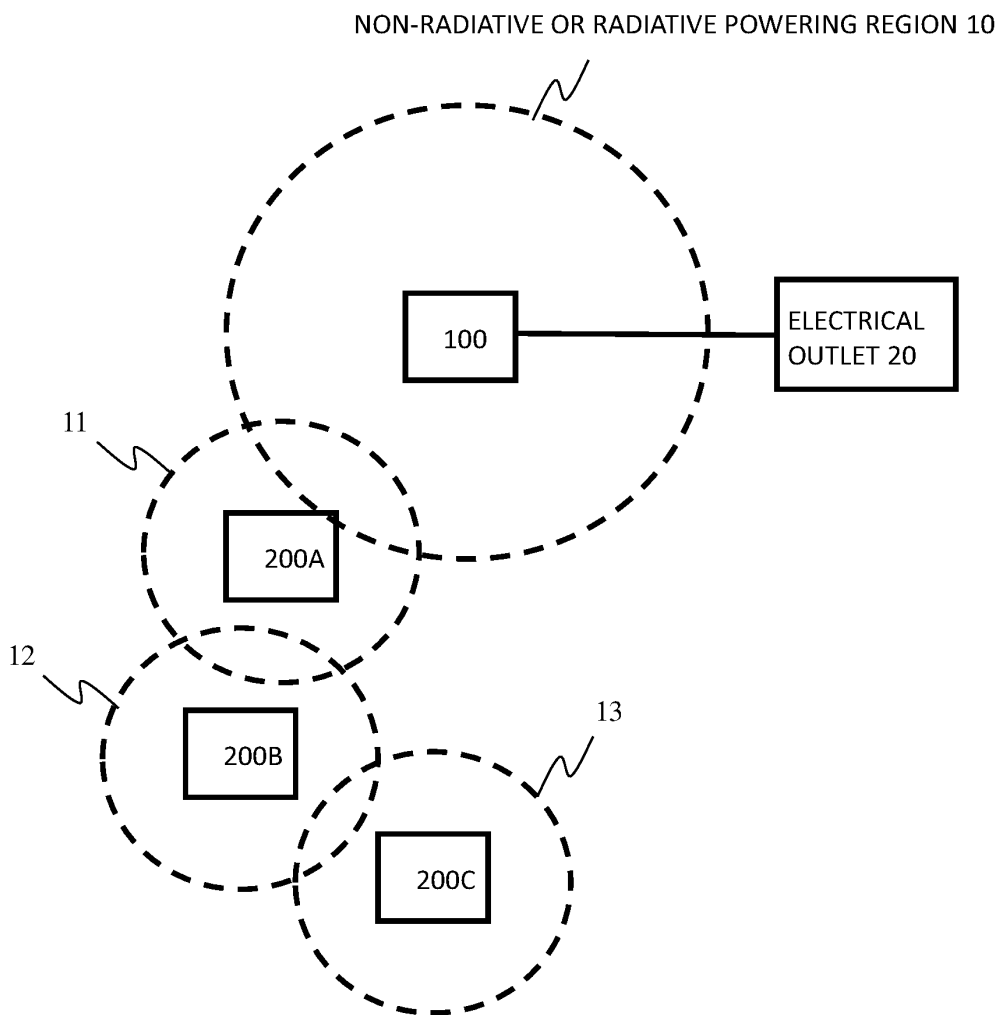
**FIG. 2**

**U.S. Patent**

Sep. 29, 2020

Sheet 3 of 40

**US 10,790,703 B2**



**FIG. 3**

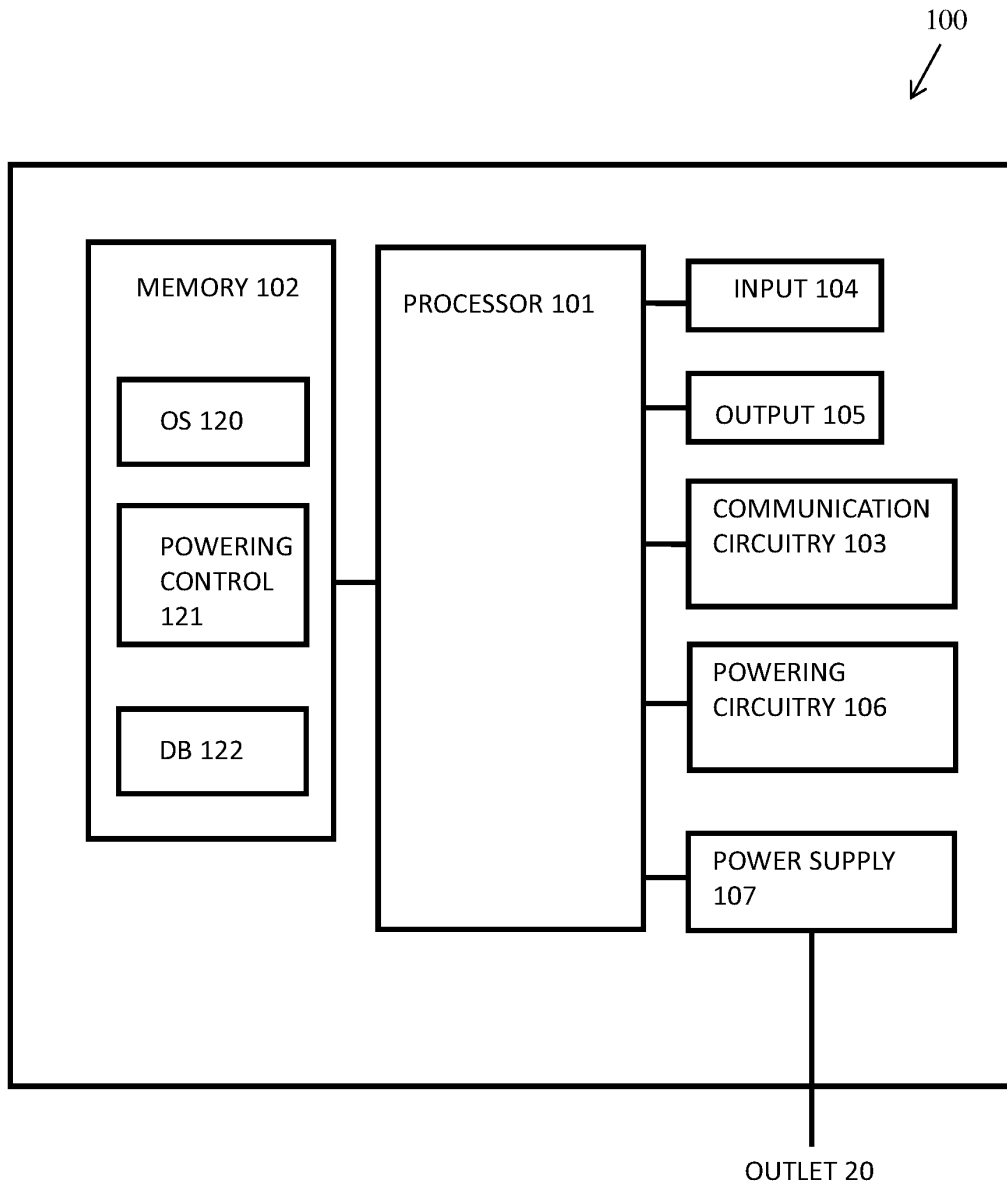


**U.S. Patent**

Sep. 29, 2020

Sheet 4 of 40

**US 10,790,703 B2**



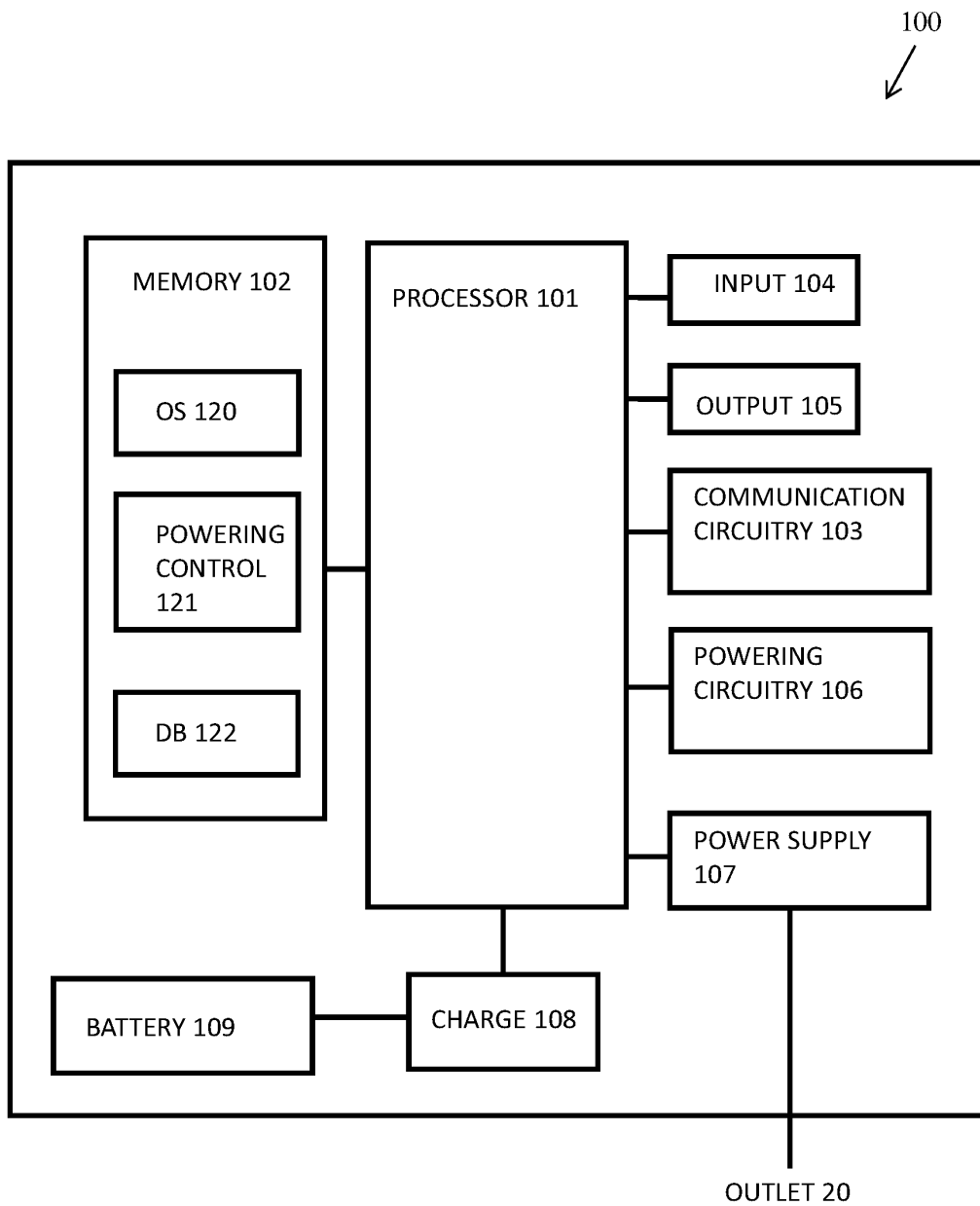
**FIG. 4**

**U.S. Patent**

Sep. 29, 2020

Sheet 5 of 40

**US 10,790,703 B2**

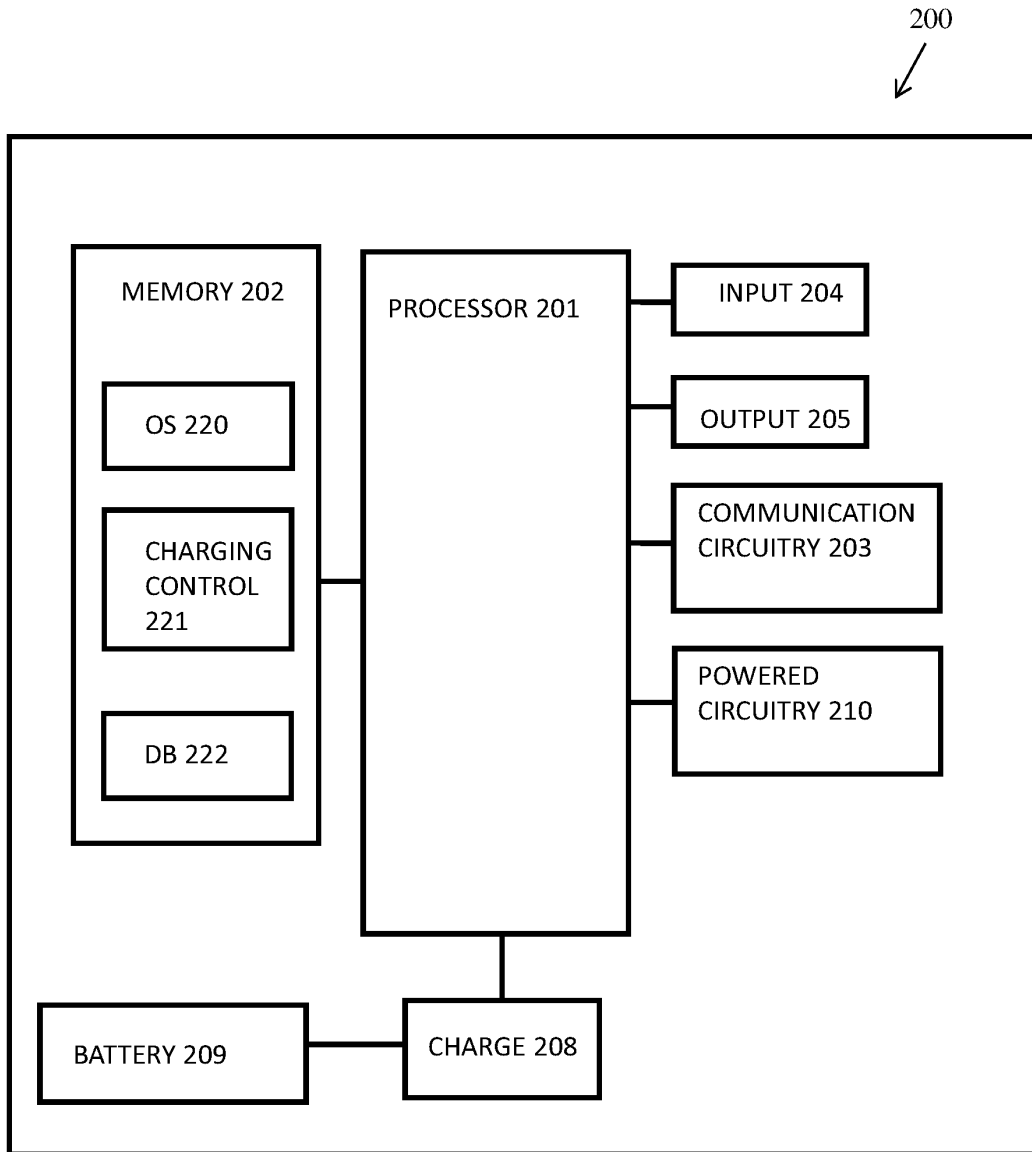


**U.S. Patent**

Sep. 29, 2020

Sheet 6 of 40

**US 10,790,703 B2**



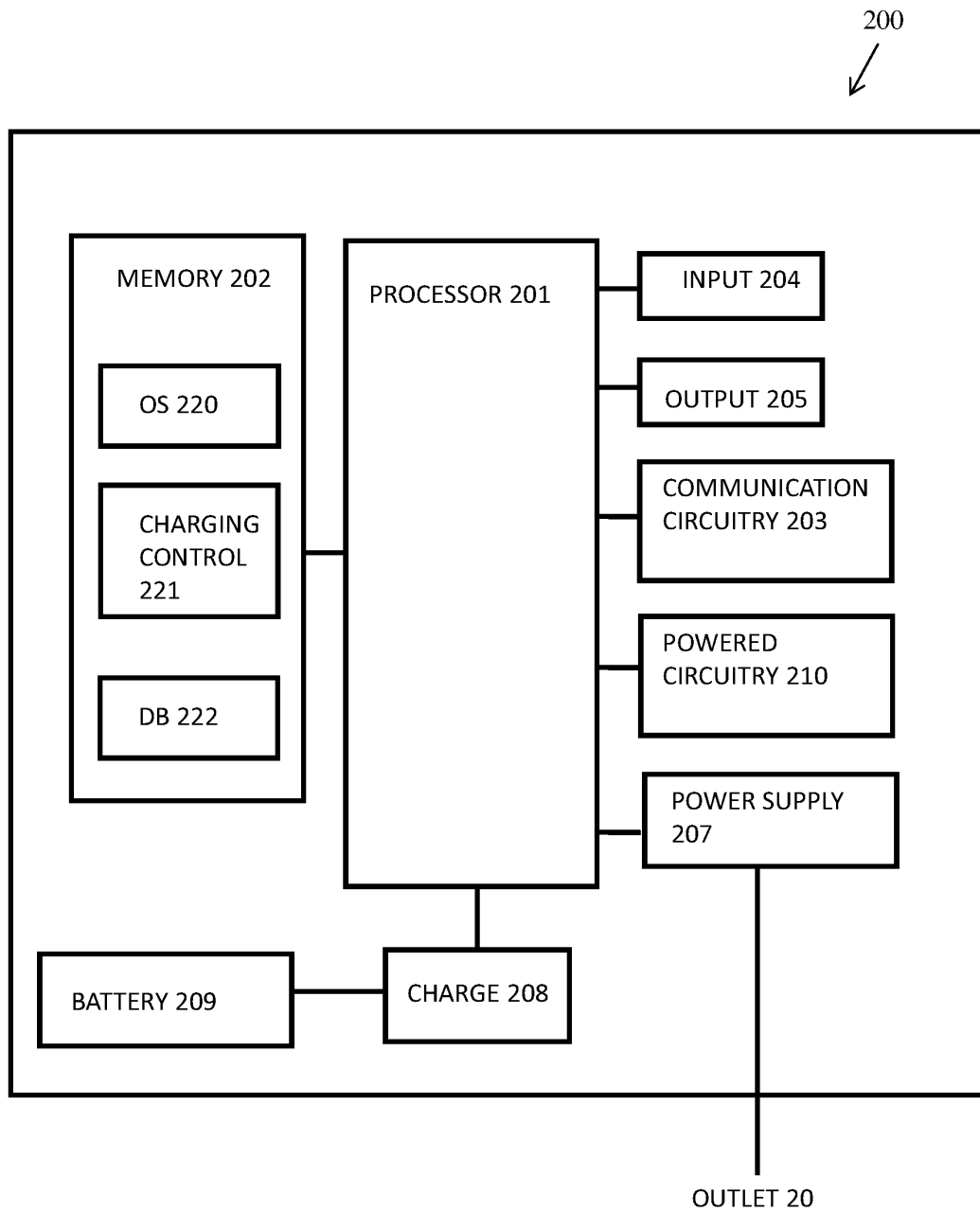
**FIG. 6**

**U.S. Patent**

Sep. 29, 2020

Sheet 7 of 40

**US 10,790,703 B2**



**U.S. Patent**

Sep. 29, 2020

Sheet 8 of 40

**US 10,790,703 B2**

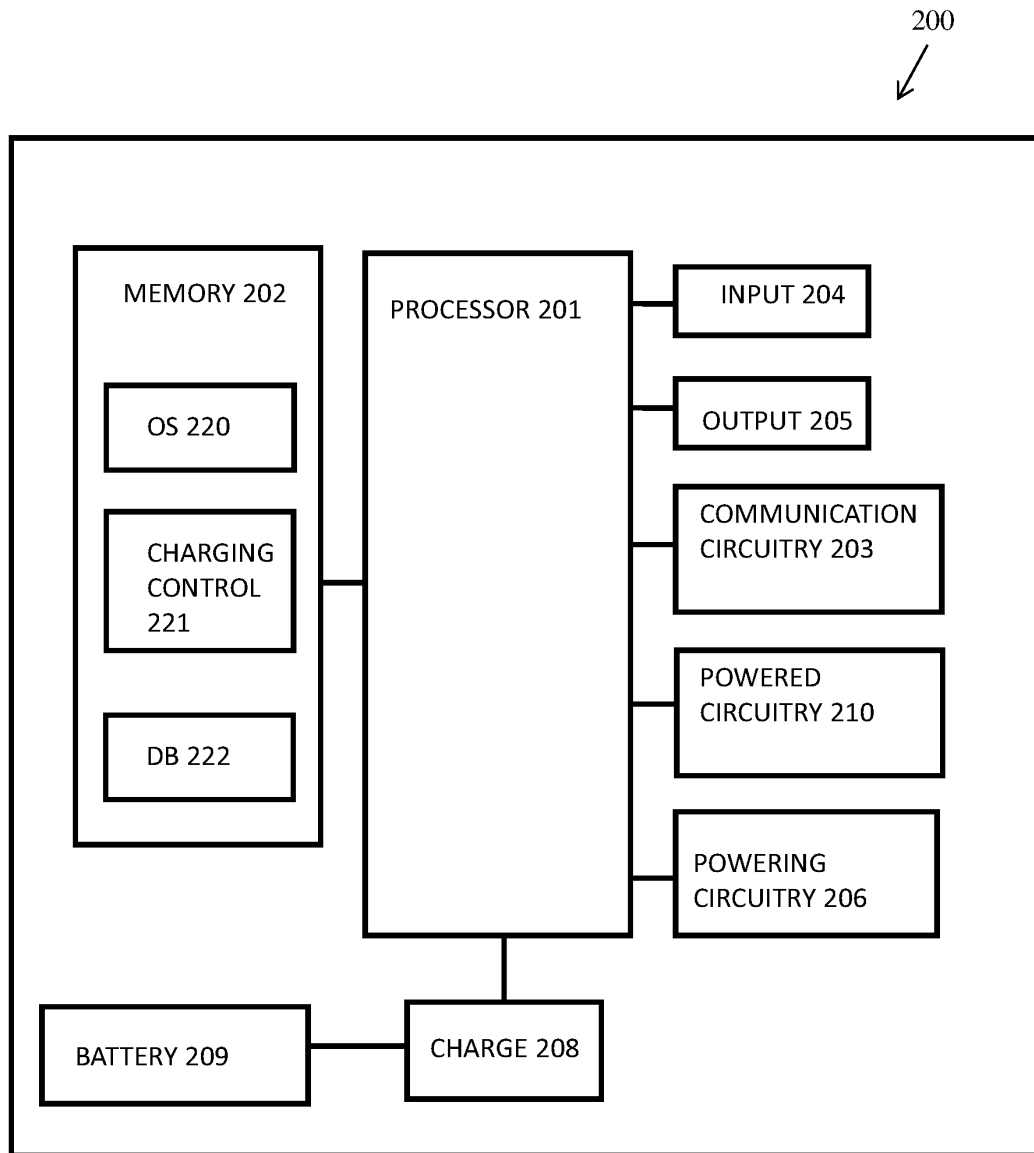


FIG. 8

DB 122

ALLOWED DEVICES	122a COMMUNICATION	122b STATUS
ID1	YES	STANDBY
ID2	YES	CHARGING
ID3	YES	N/A
ID4	NO	N/A
ID5	YES	STANDBY

DB 222

CONNECTABLE POWER SOURCES
ID A
ID B
ID C
ID D
ID E

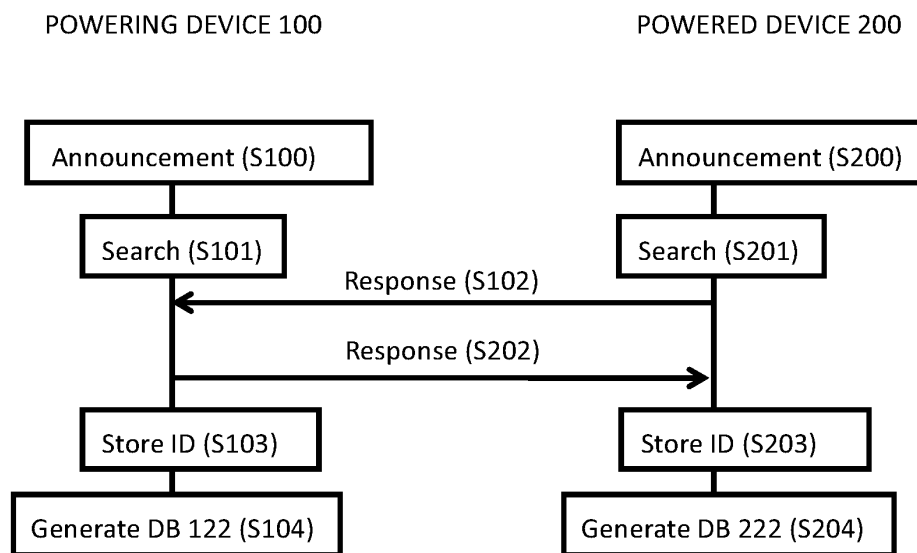
FIG. 9

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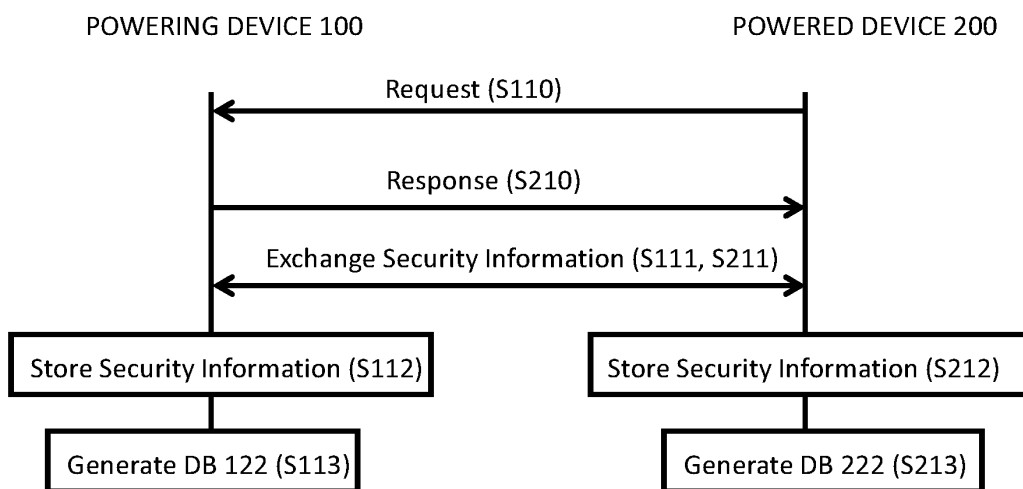
Sep. 29, 2020

Sheet 10 of 40

**US 10,790,703 B2**



**FIG. 10**



**FIG. 11**

U.S. Patent

Sep. 29, 2020

Sheet 11 of 40

US 10,790,703 B2

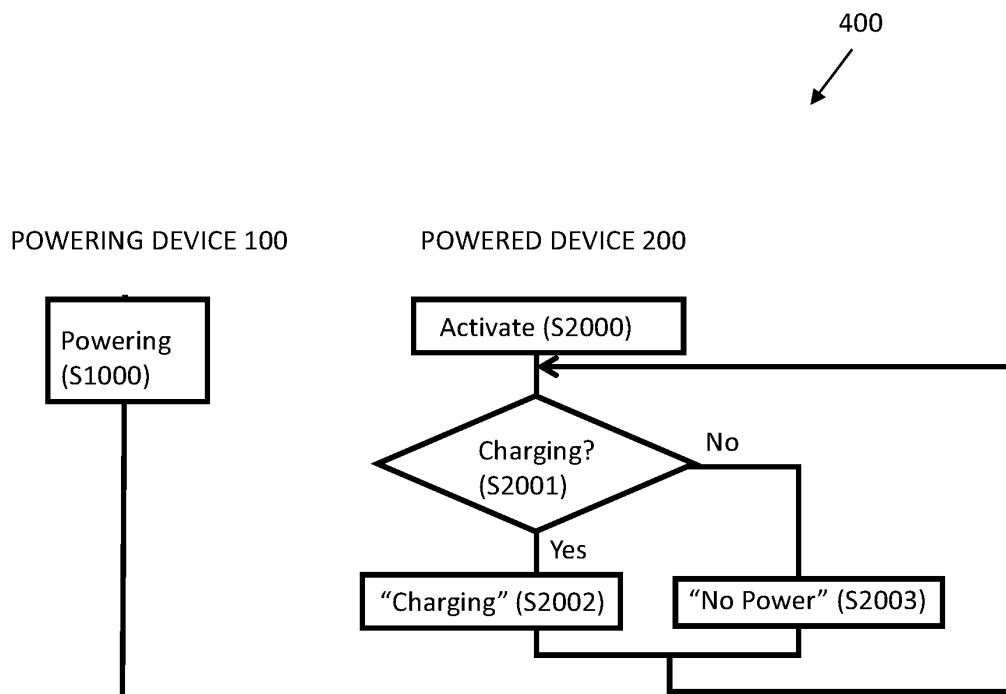


FIG. 12



U.S. Patent

Sep. 29, 2020

Sheet 12 of 40

US 10,790,703 B2

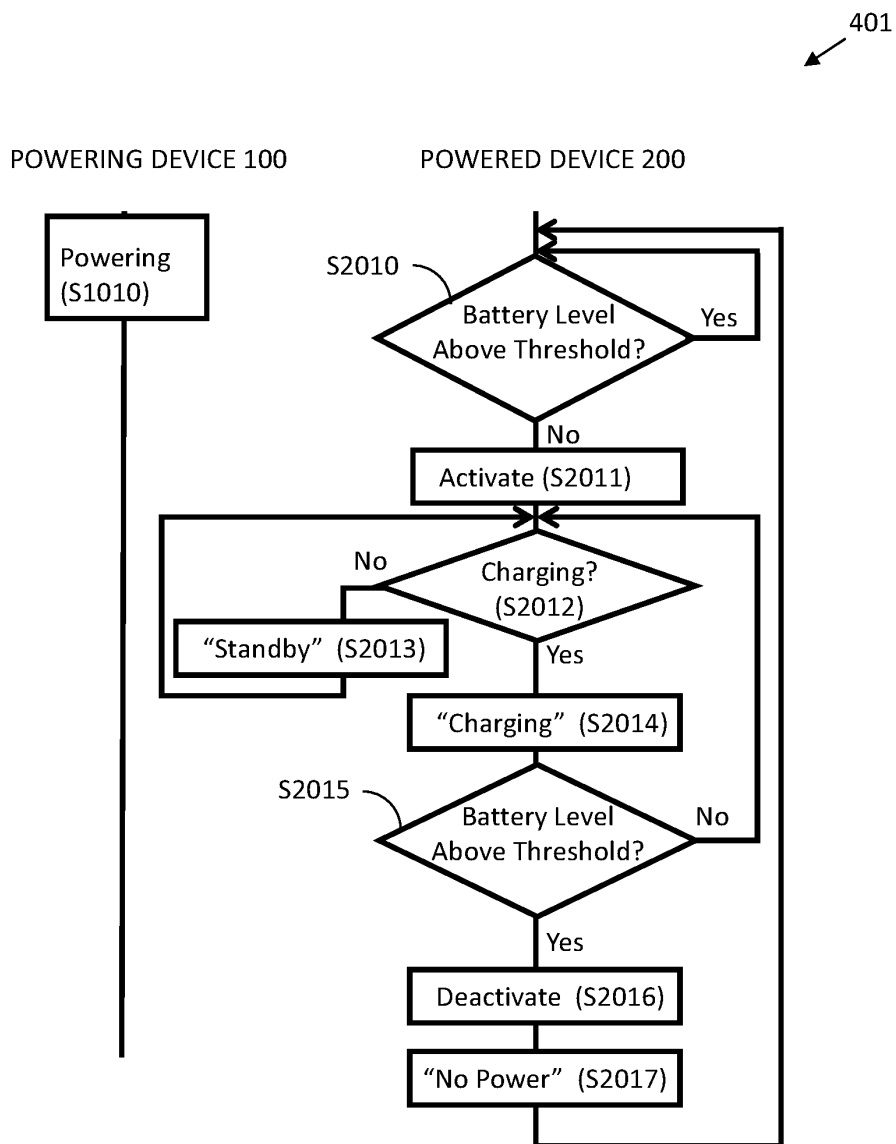


FIG. 13

U.S. Patent

Sep. 29, 2020

Sheet 13 of 40

US 10,790,703 B2

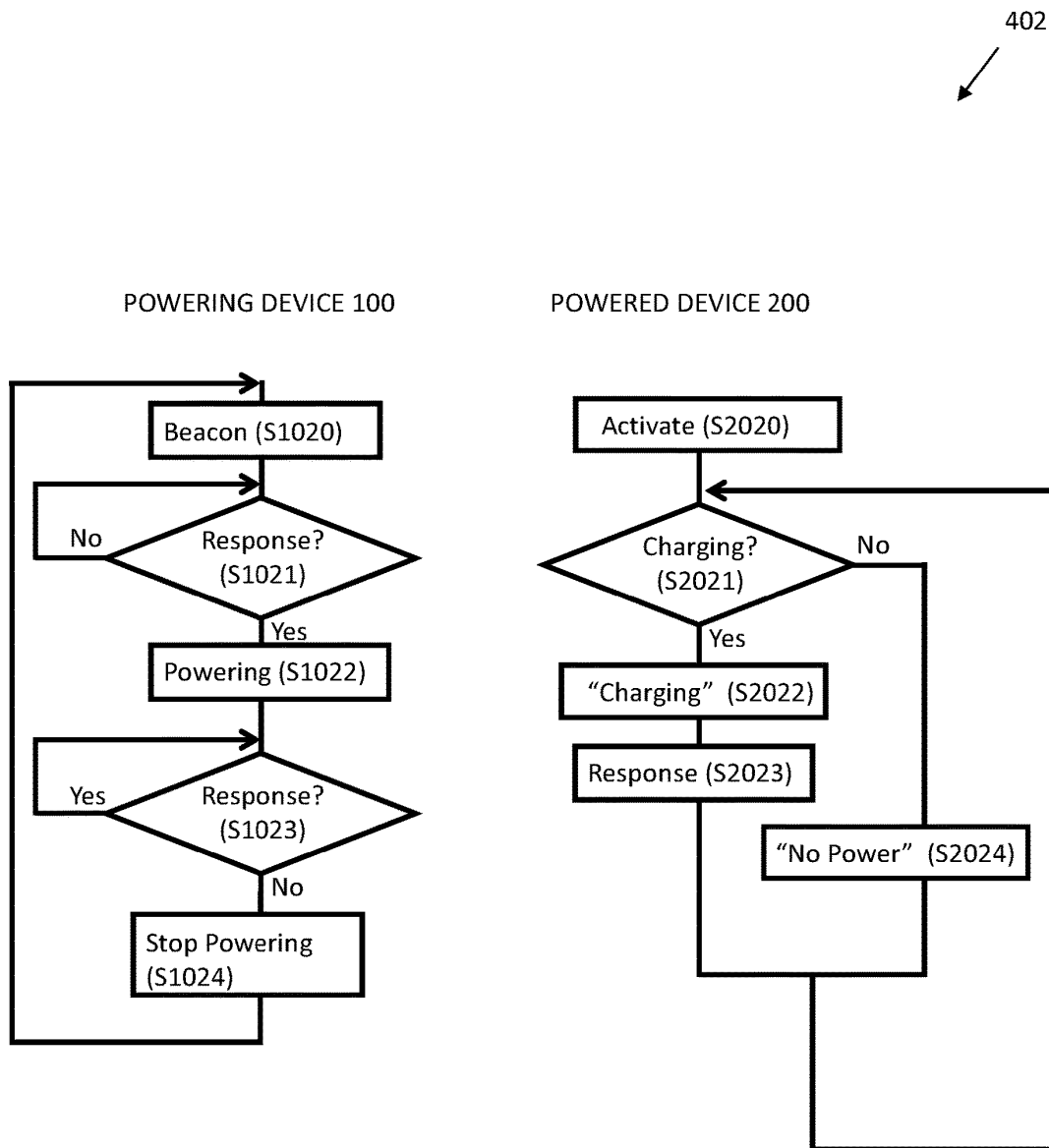


FIG. 14

U.S. Patent

Sep. 29, 2020

Sheet 14 of 40

US 10,790,703 B2

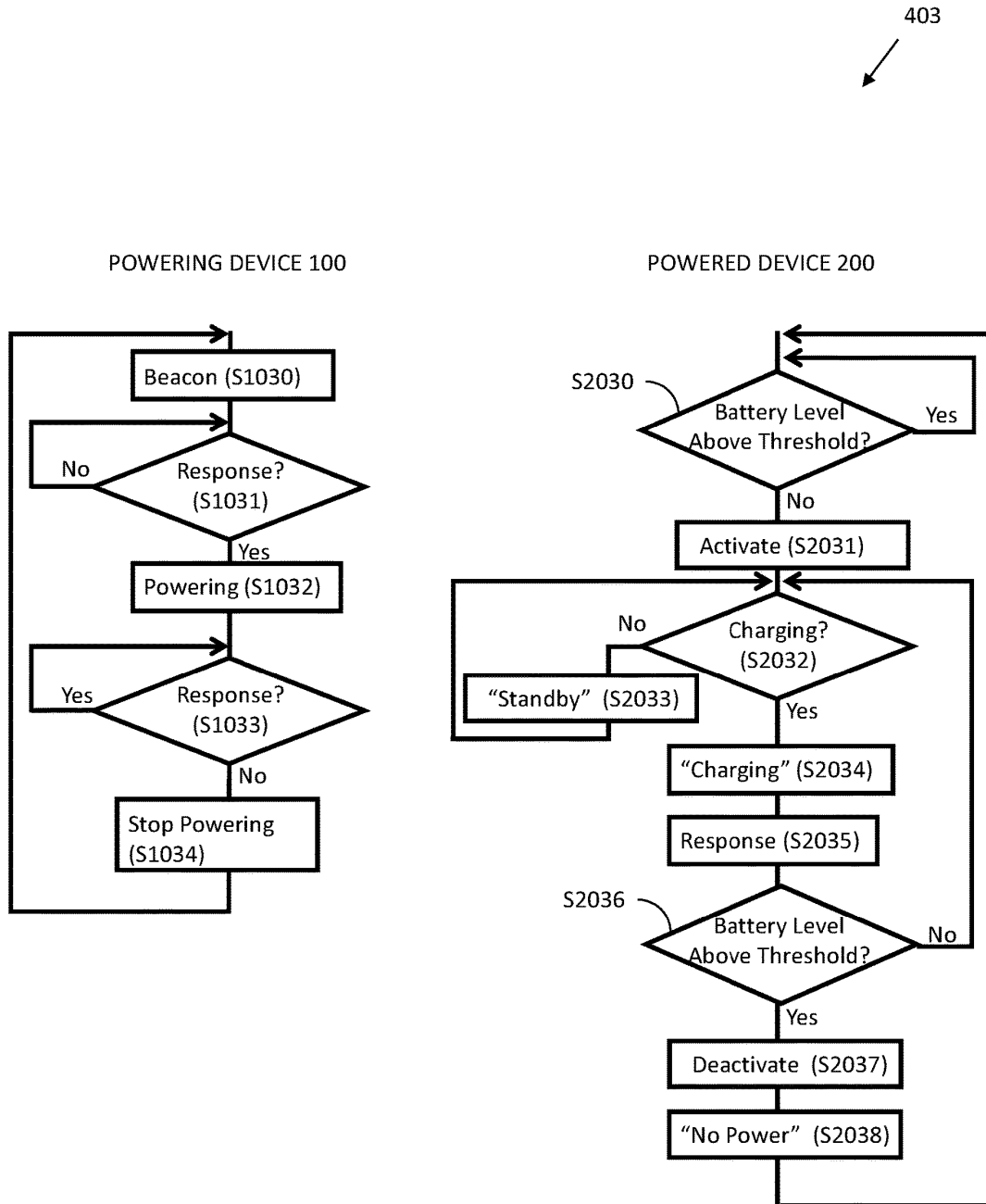


FIG. 15

U.S. Patent

Sep. 29, 2020

Sheet 15 of 40

US 10,790,703 B2

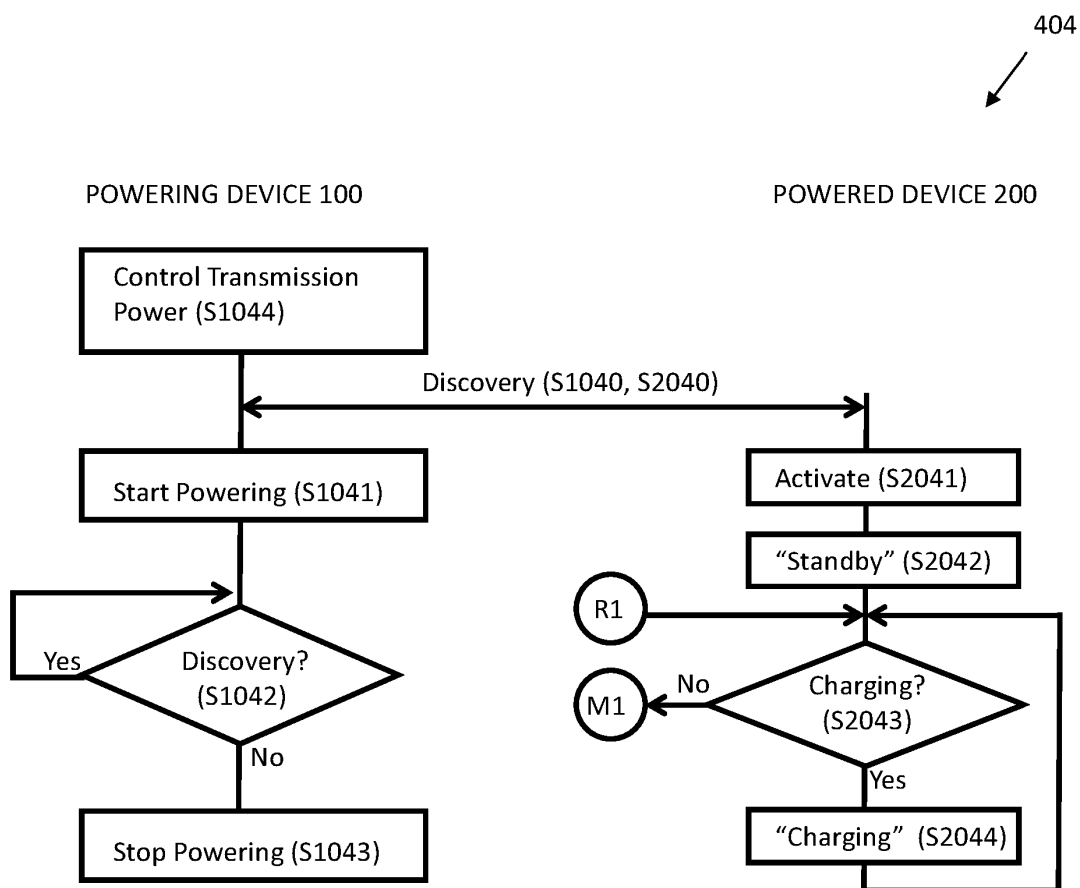


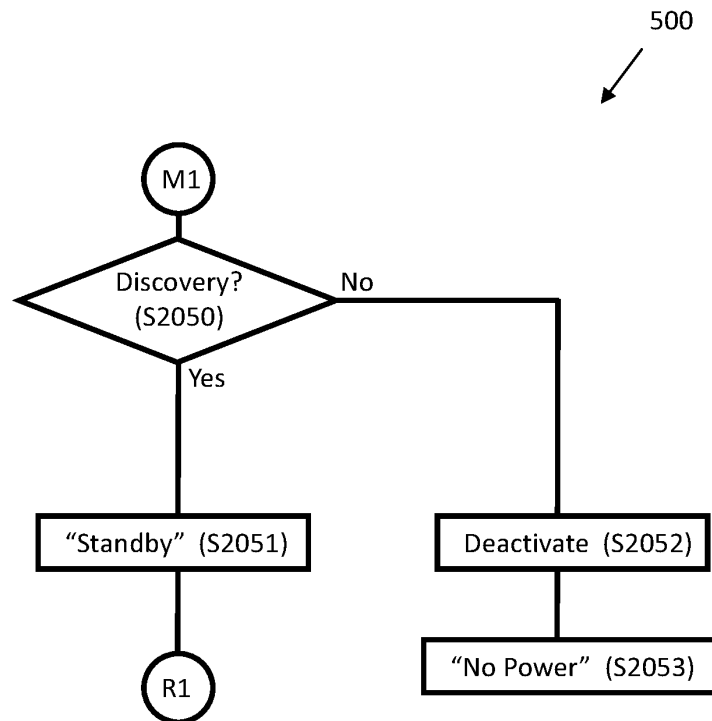
FIG. 16

**U.S. Patent**

Sep. 29, 2020

Sheet 16 of 40

**US 10,790,703 B2**



**FIG. 17**

U.S. Patent

Sep. 29, 2020

Sheet 17 of 40

US 10,790,703 B2

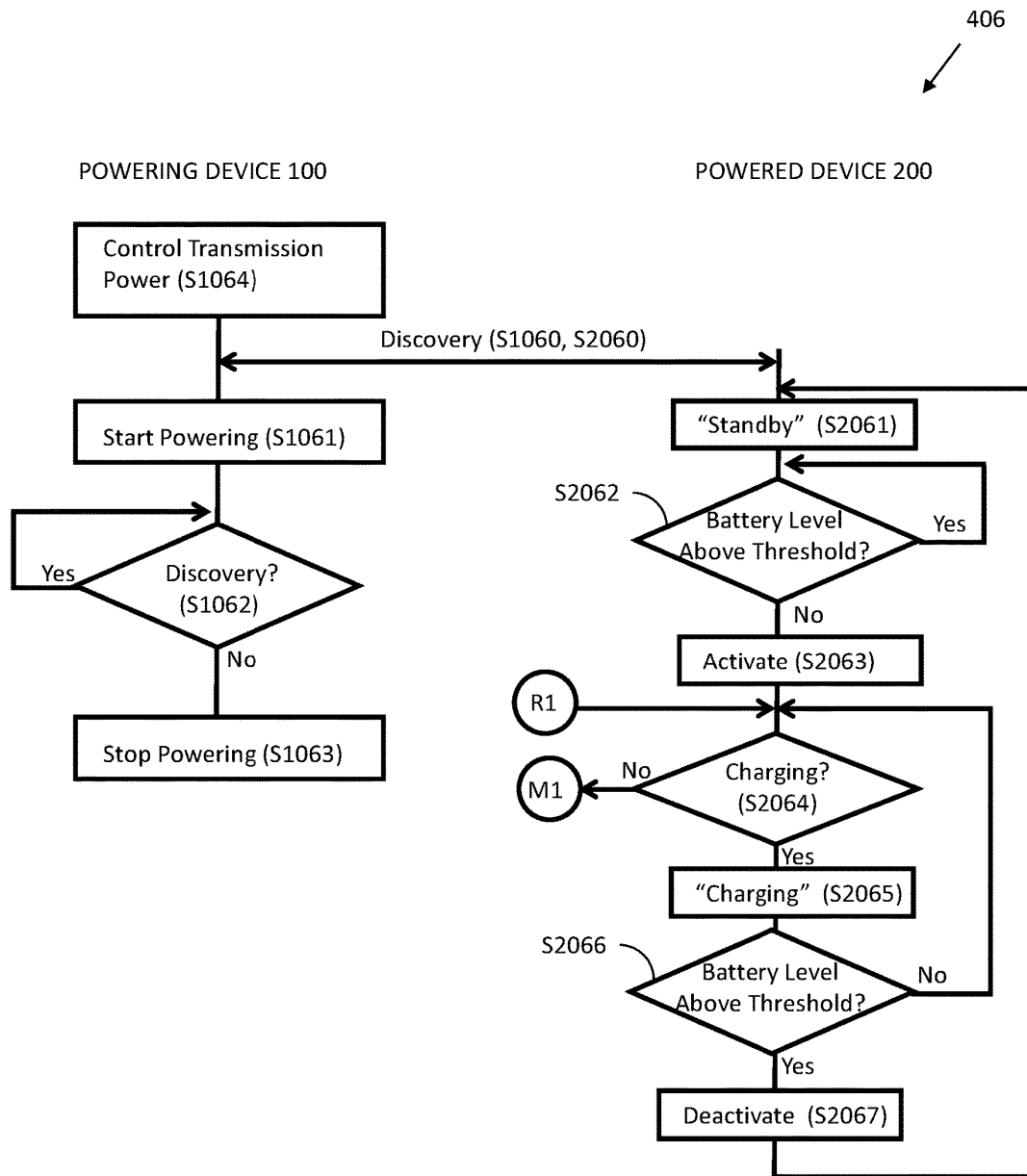


FIG. 18

U.S. Patent

Sep. 29, 2020

Sheet 18 of 40

US 10,790,703 B2

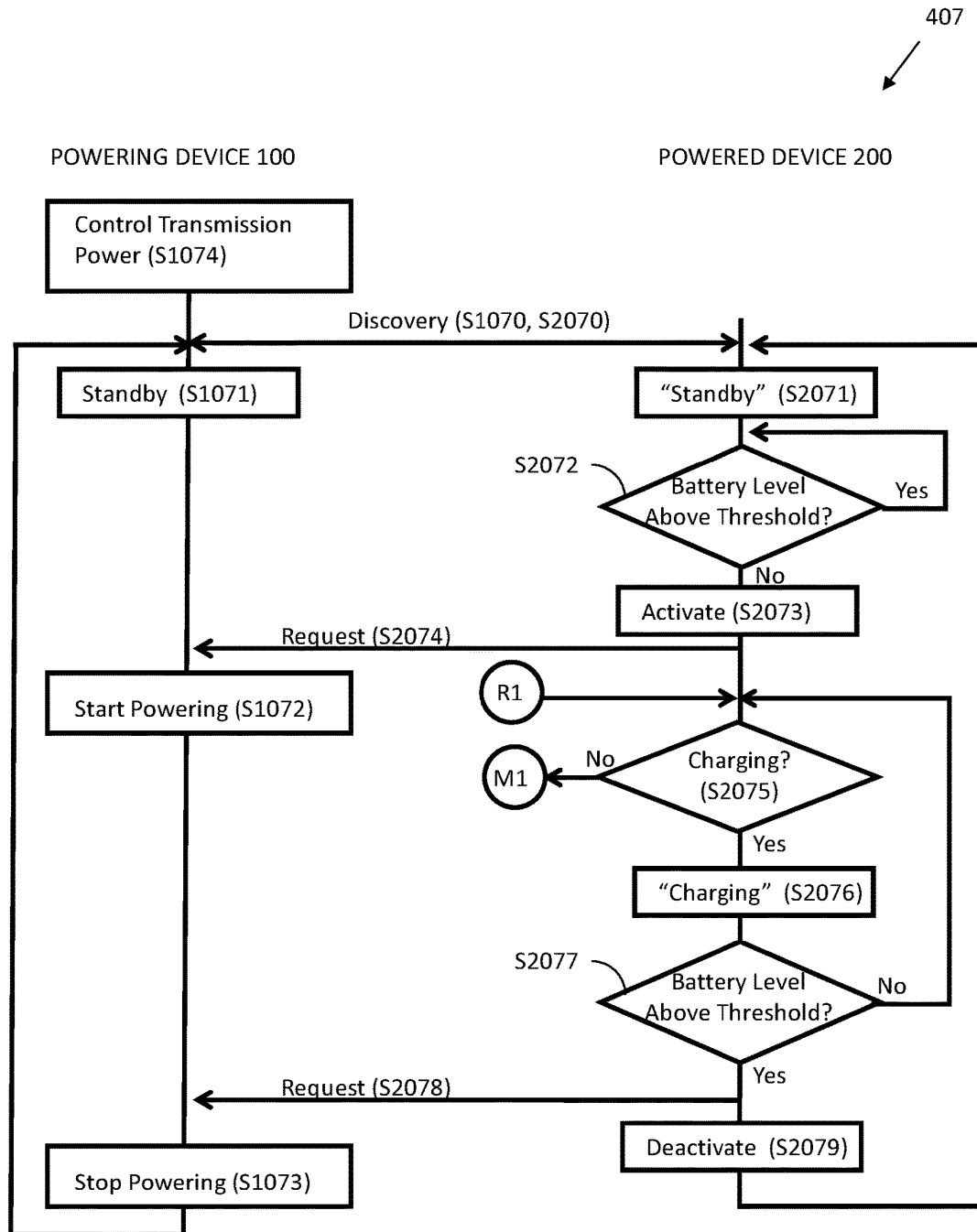


FIG. 19

U.S. Patent

Sep. 29, 2020

Sheet 19 of 40

US 10,790,703 B2

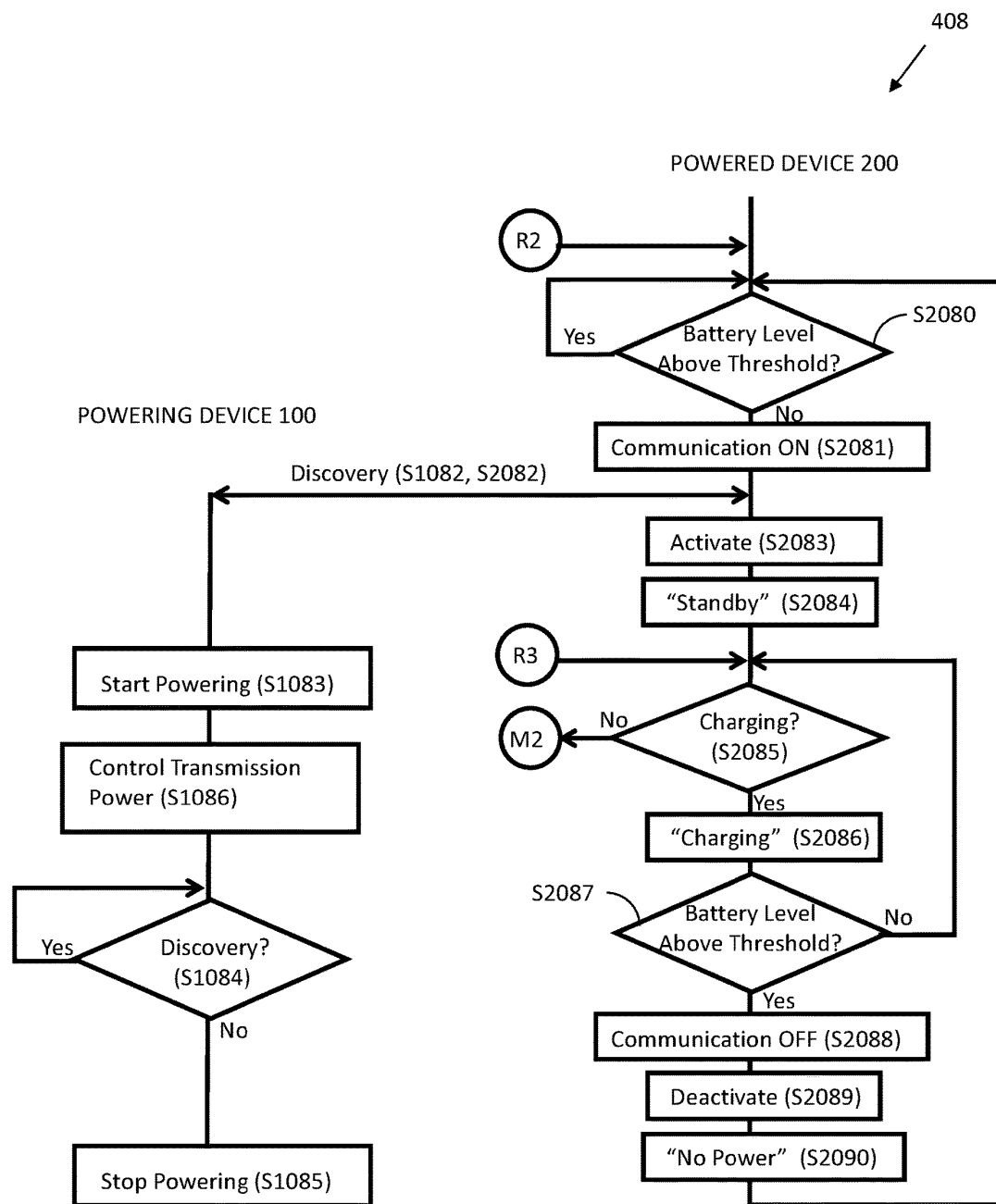


FIG. 20

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U.S. Patent

Sep. 29, 2020

Sheet 20 of 40

US 10,790,703 B2

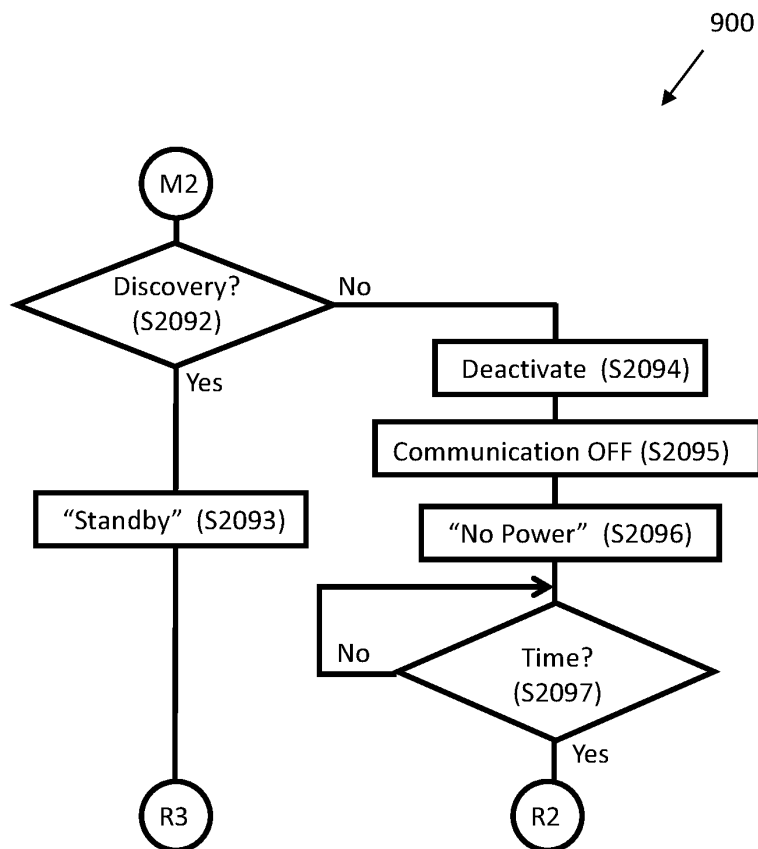


FIG. 21

U.S. Patent

Sep. 29, 2020

Sheet 21 of 40

US 10,790,703 B2

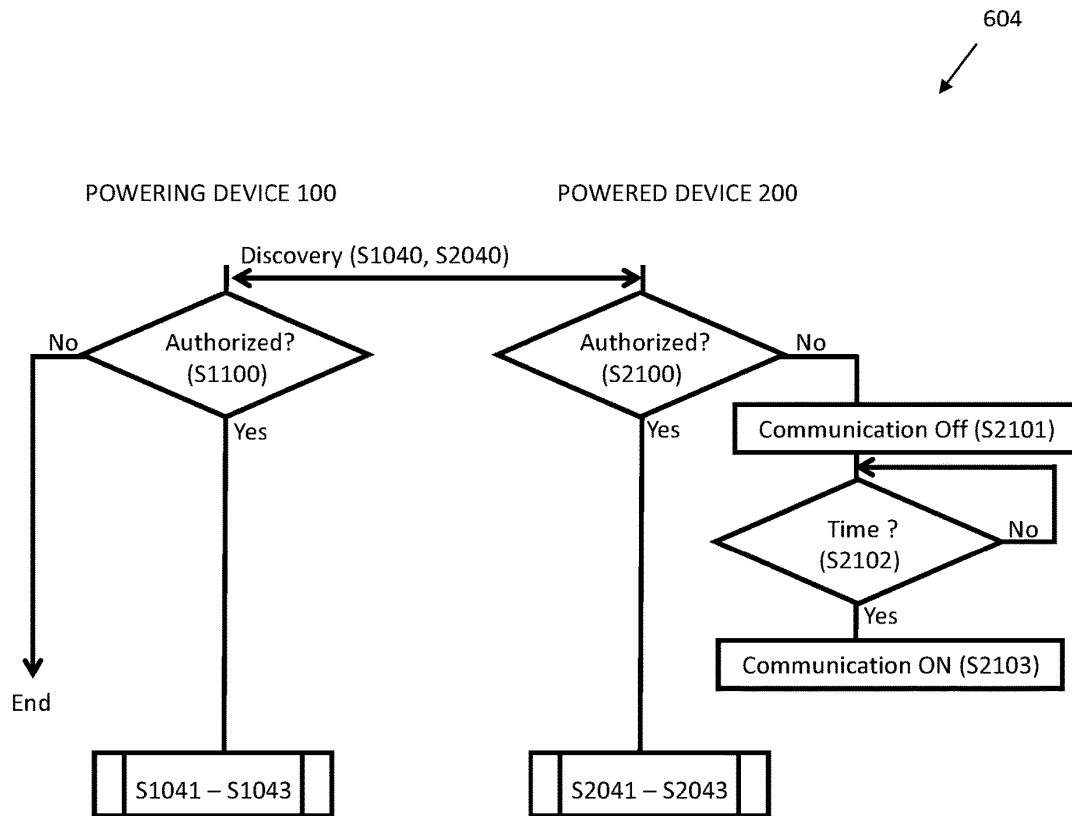


FIG. 22

U.S. Patent

Sep. 29, 2020

Sheet 22 of 40

US 10,790,703 B2

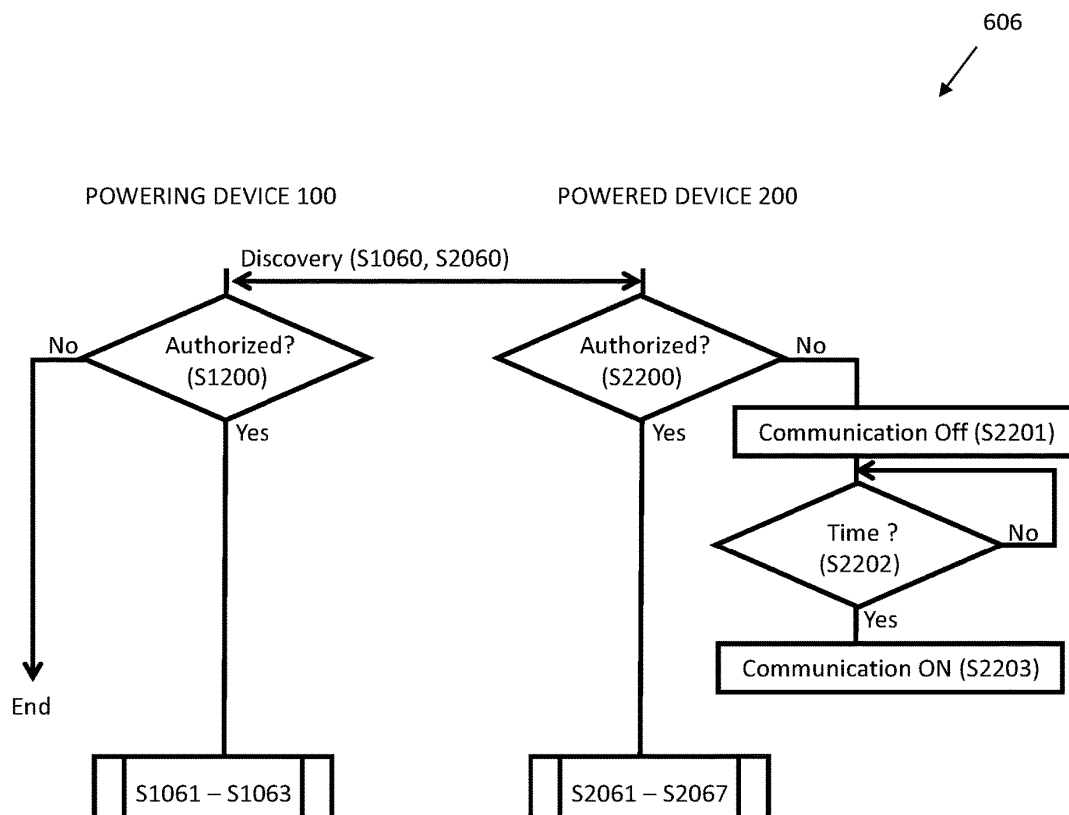


FIG. 23

U.S. Patent

Sep. 29, 2020

Sheet 23 of 40

US 10,790,703 B2

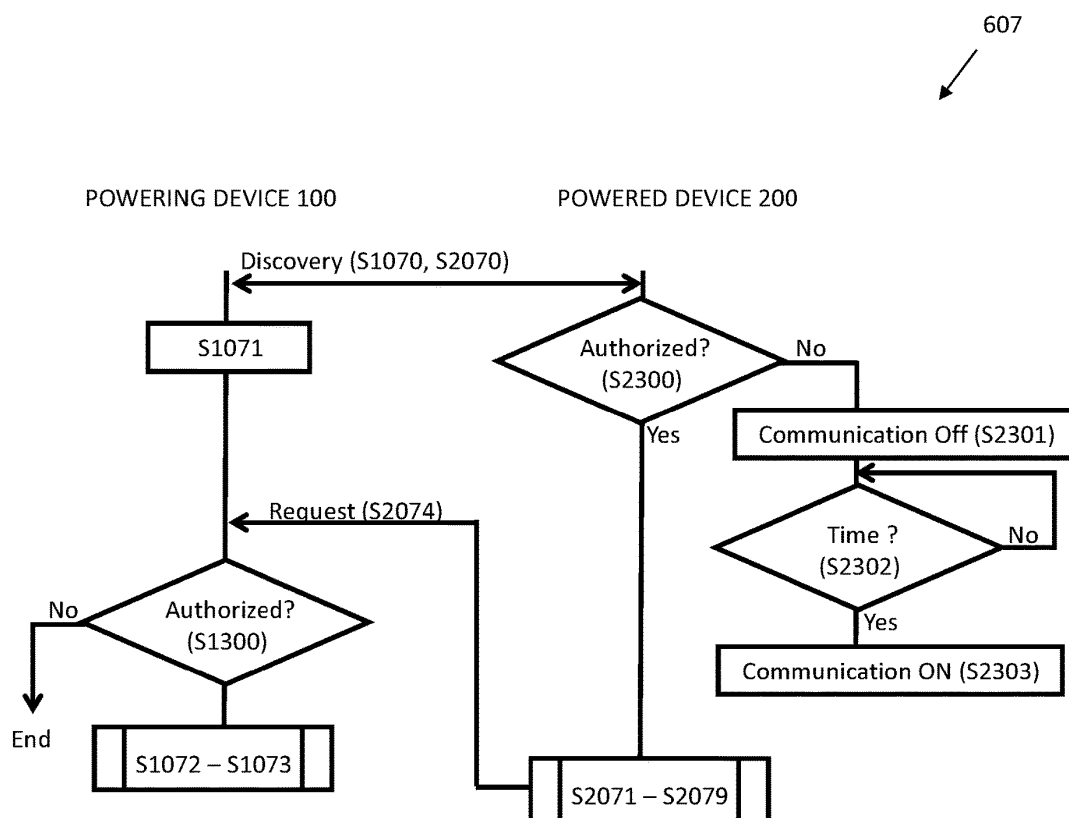


FIG. 24

U.S. Patent

Sep. 29, 2020

Sheet 24 of 40

US 10,790,703 B2

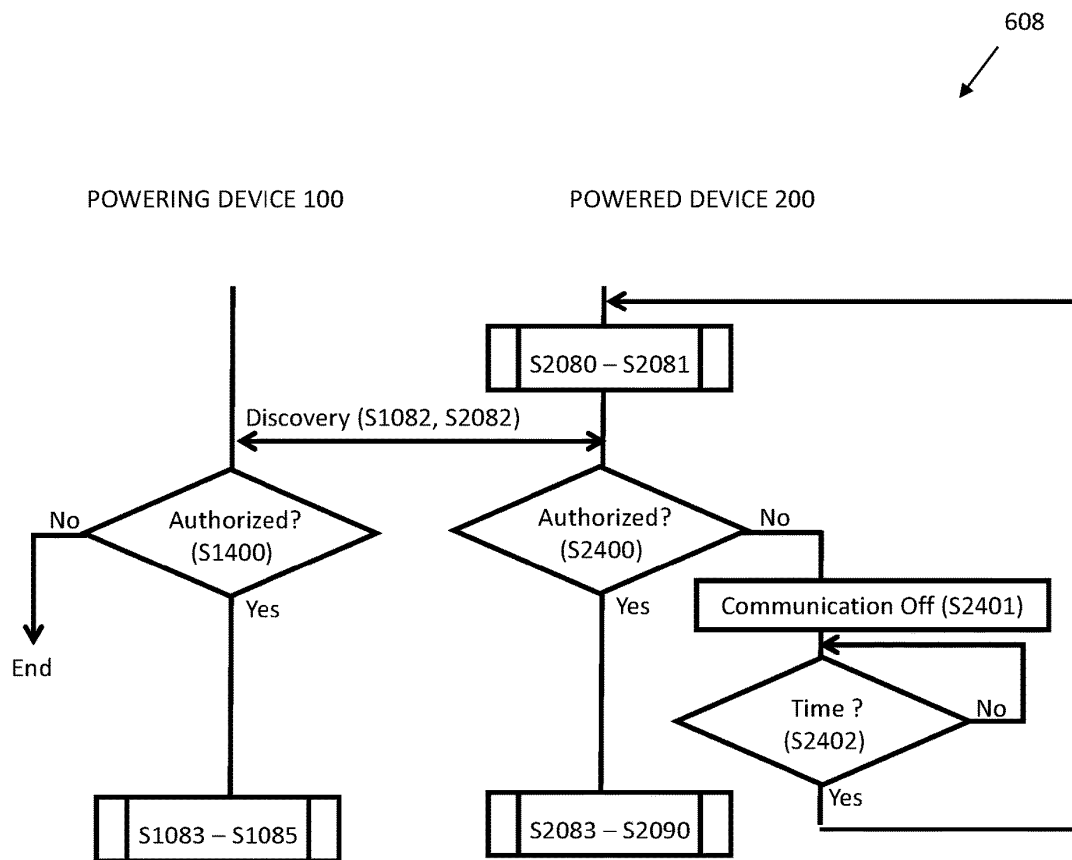


FIG. 25

U.S. Patent

Sep. 29, 2020

Sheet 25 of 40

US 10,790,703 B2

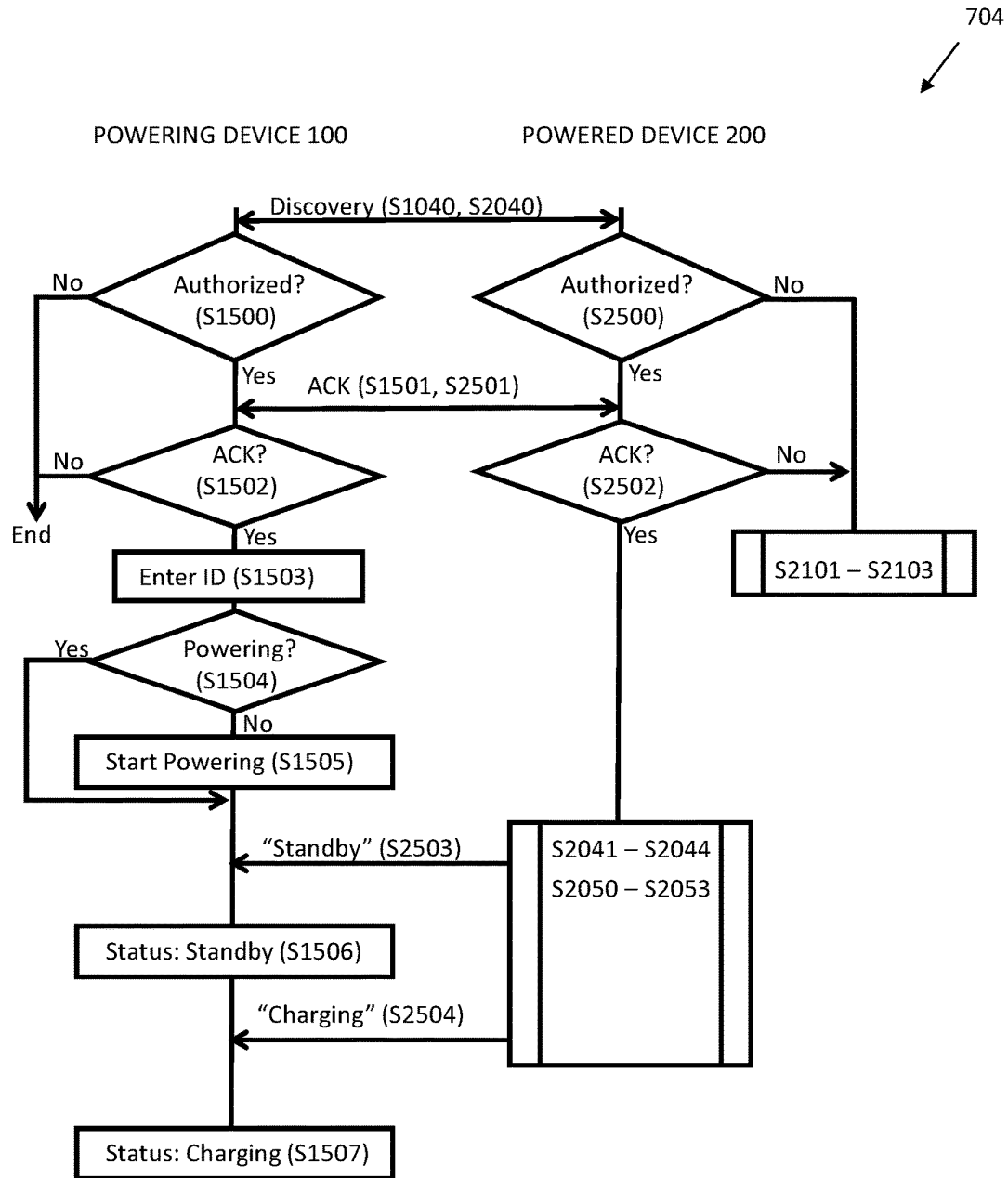


FIG. 26

U.S. Patent

Sep. 29, 2020

Sheet 26 of 40

US 10,790,703 B2

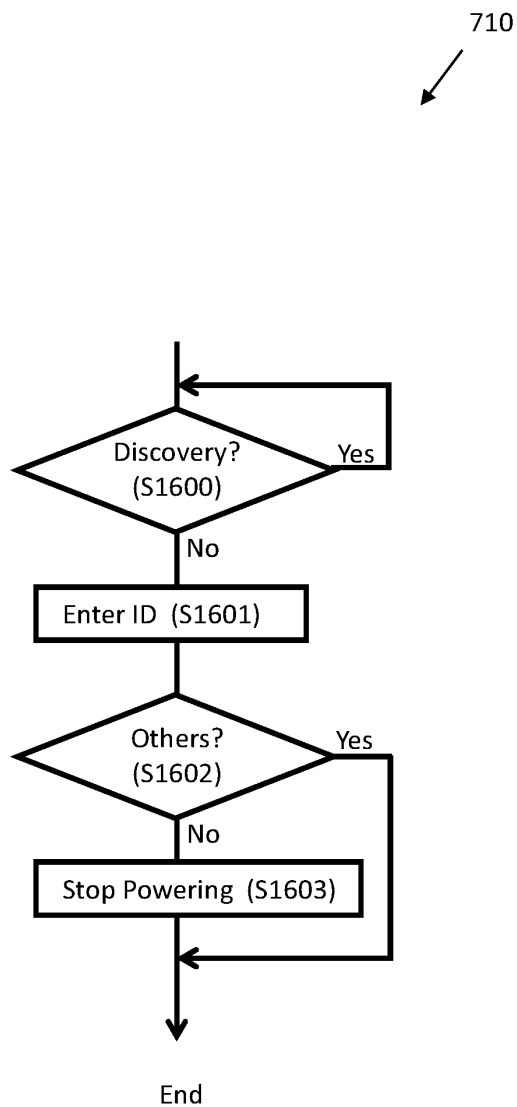


FIG. 27

U.S. Patent

Sep. 29, 2020

Sheet 27 of 40

US 10,790,703 B2

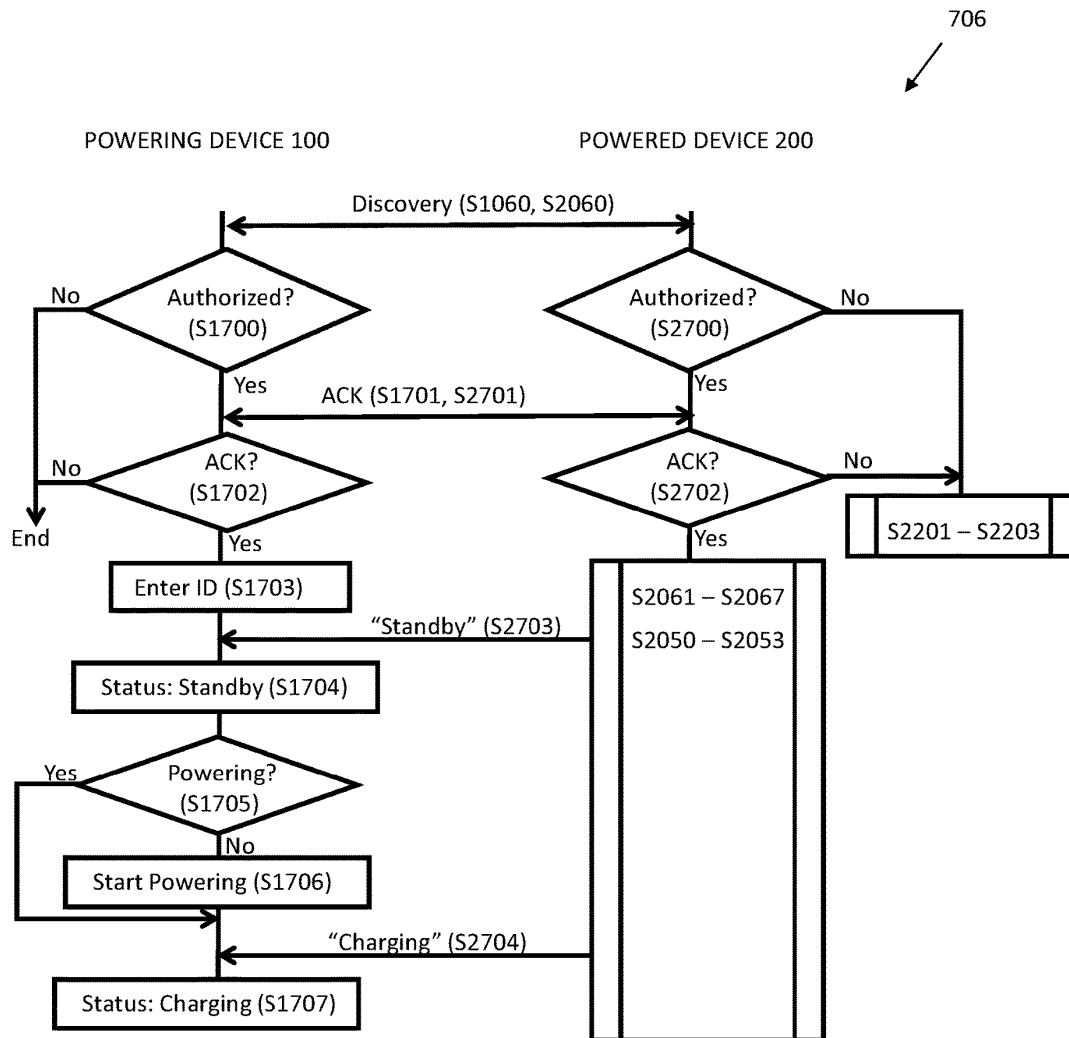


FIG. 28





U.S. Patent

Sep. 29, 2020

Sheet 29 of 40

US 10,790,703 B2

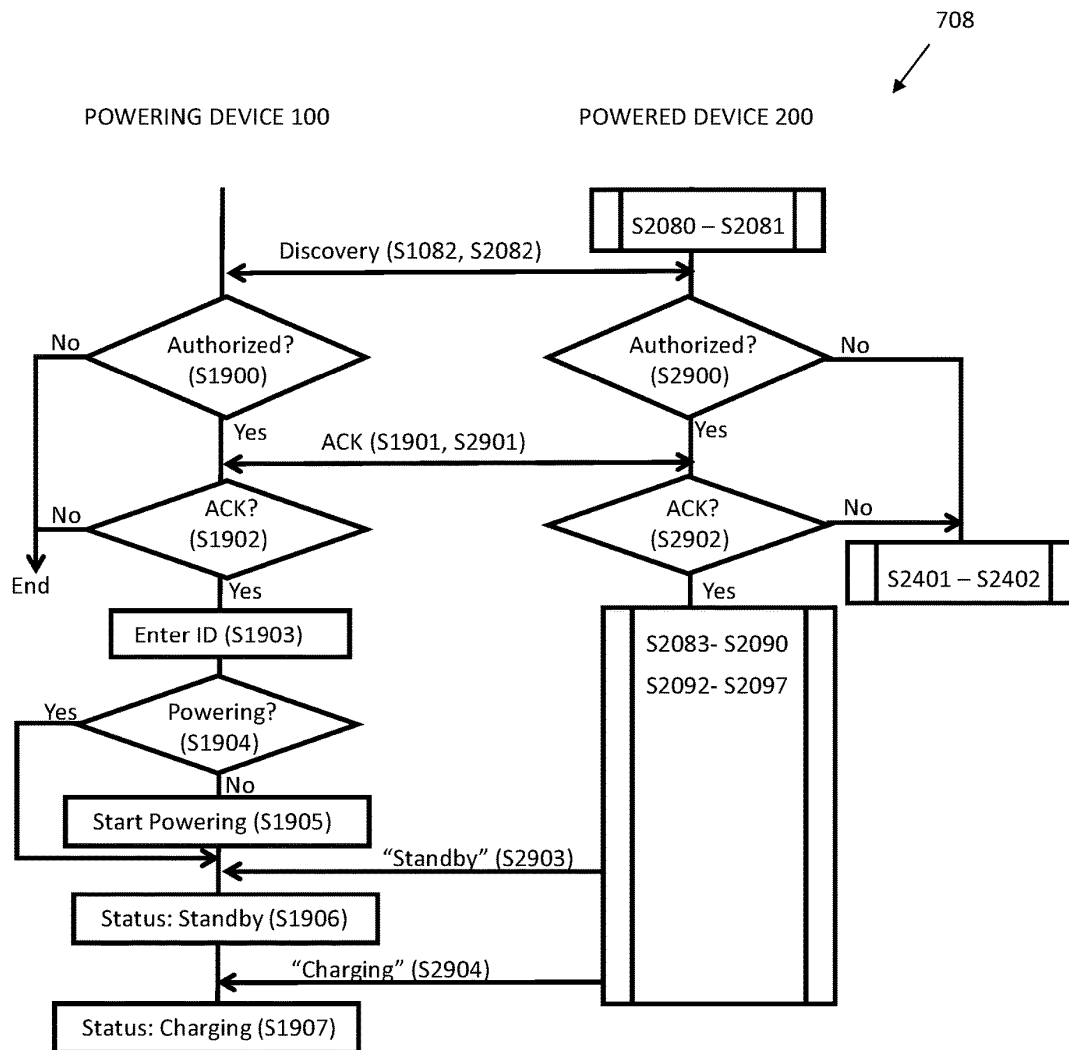


FIG. 30

U.S. Patent

Sep. 29, 2020

Sheet 30 of 40

US 10,790,703 B2

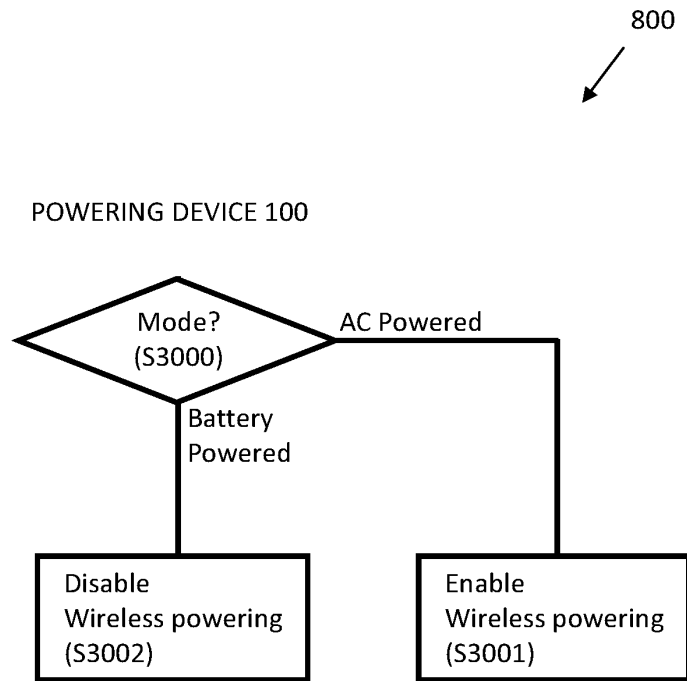


FIG. 31

U.S. Patent

Sep. 29, 2020

Sheet 31 of 40

US 10,790,703 B2

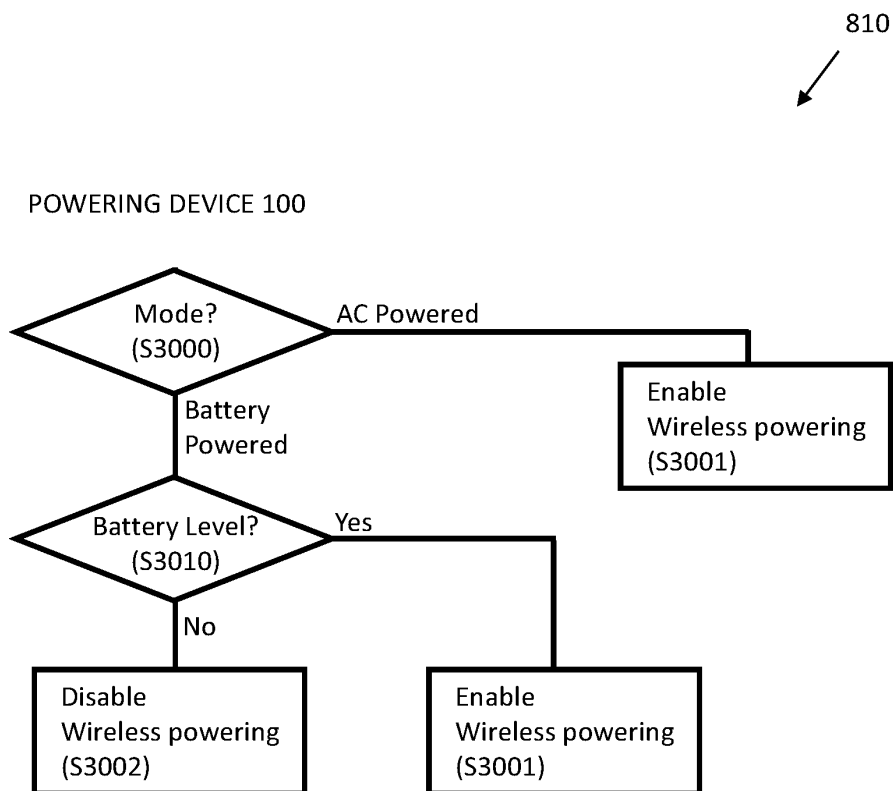


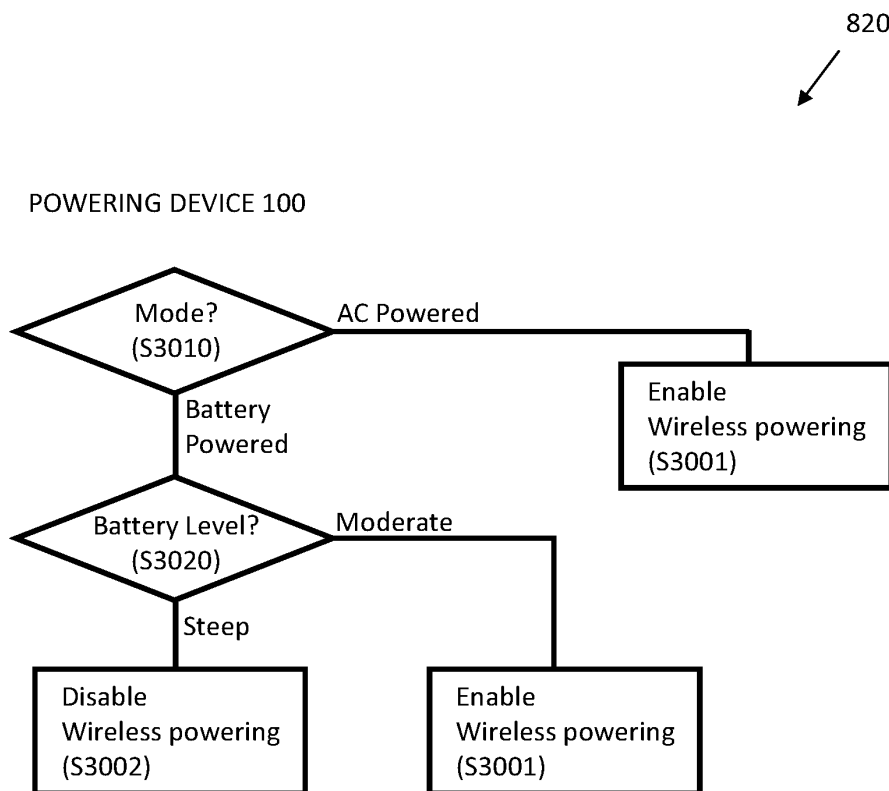
FIG. 32

**U.S. Patent**

Sep. 29, 2020

Sheet 32 of 40

**US 10,790,703 B2**



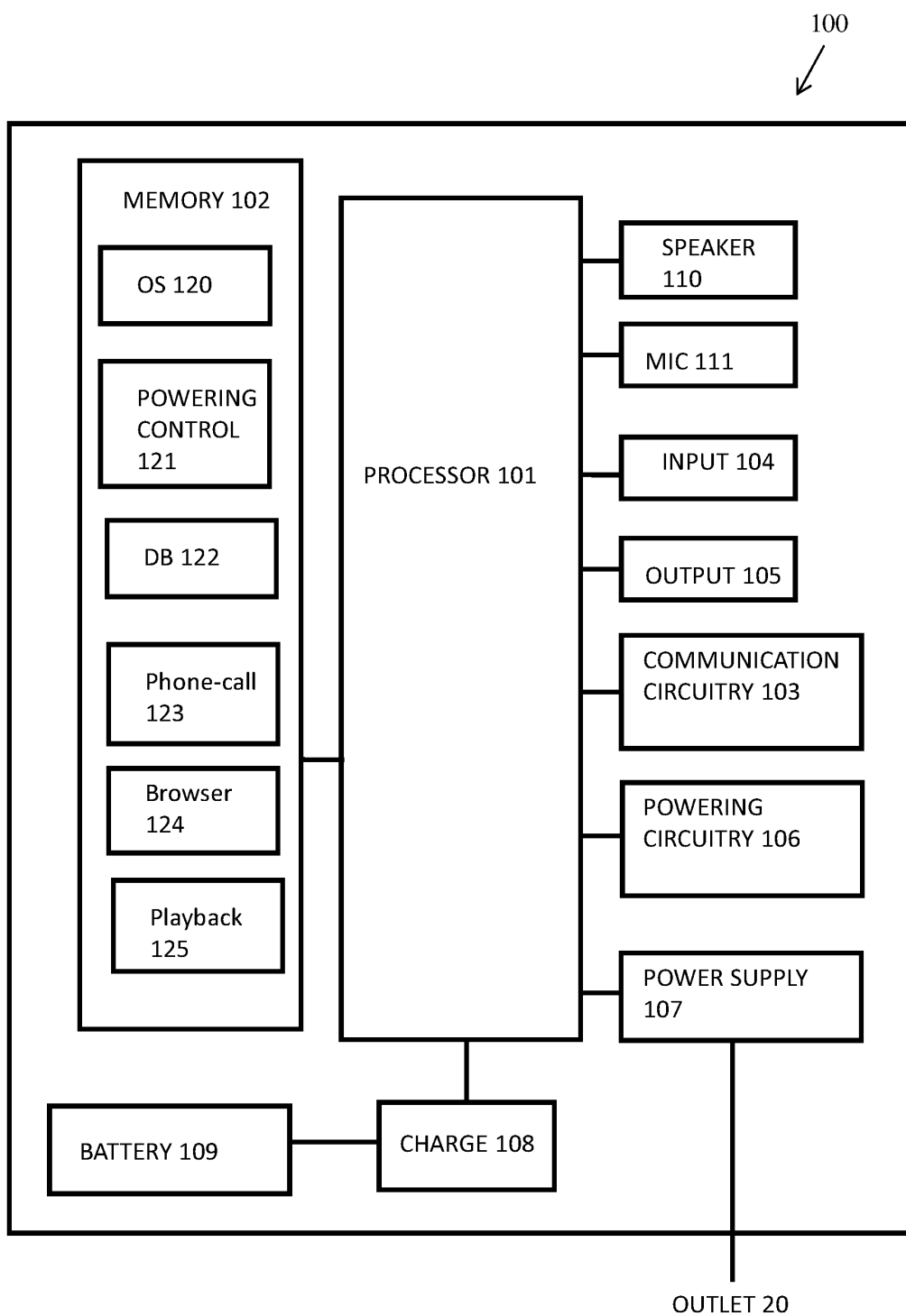
**FIG. 33**

**U.S. Patent**

Sep. 29, 2020

Sheet 33 of 40

**US 10,790,703 B2**



**FIG. 34**

ADD0884

U.S. Patent

Sep. 29, 2020

Sheet 34 of 40

US 10,790,703 B2

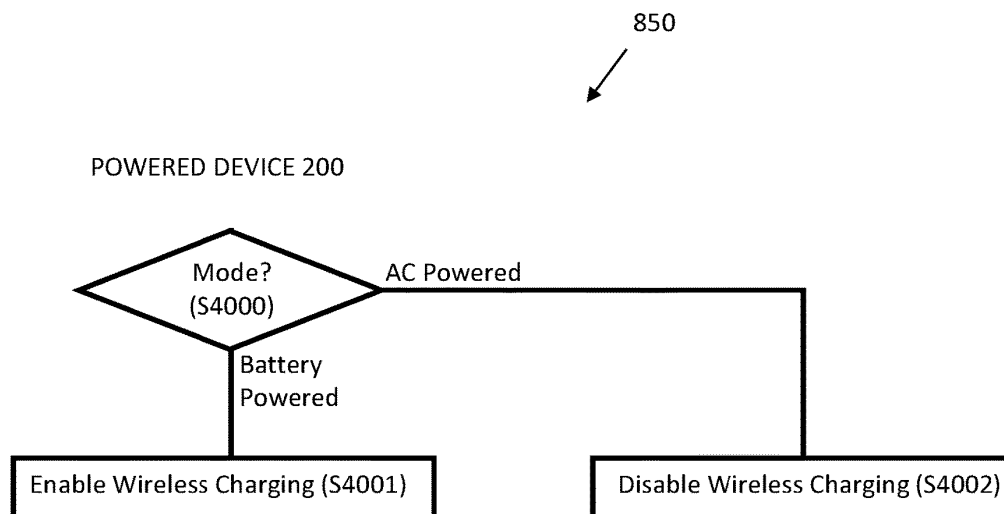


FIG. 35

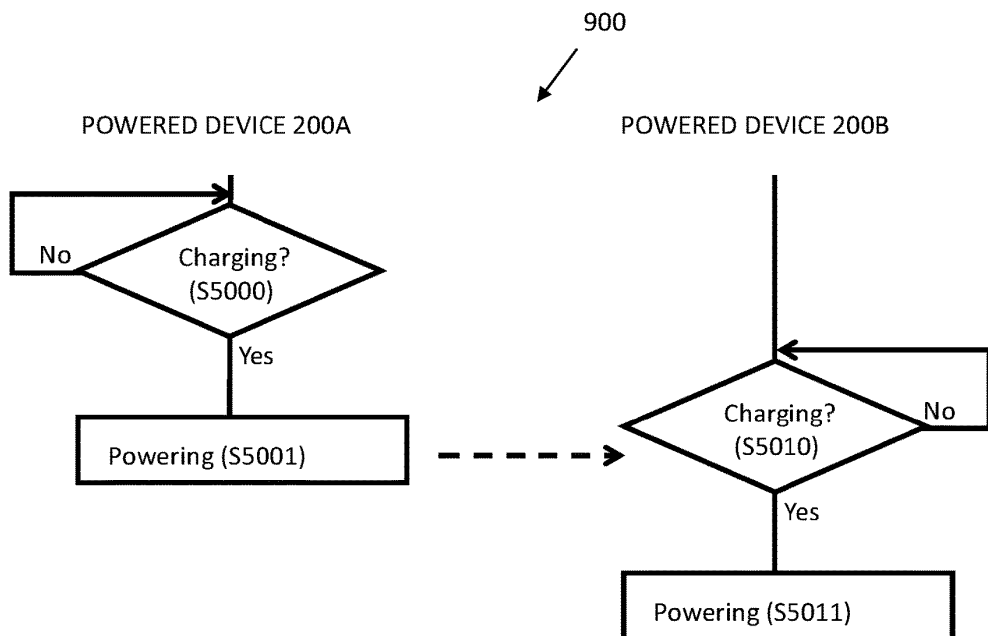


FIG. 36

U.S. Patent

Sep. 29, 2020

Sheet 35 of 40

US 10,790,703 B2

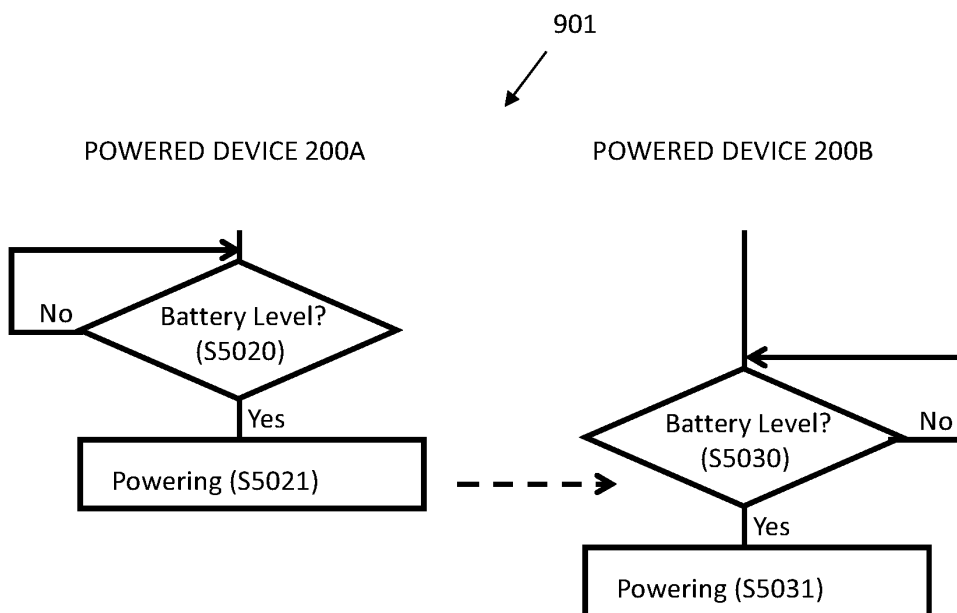


FIG. 37

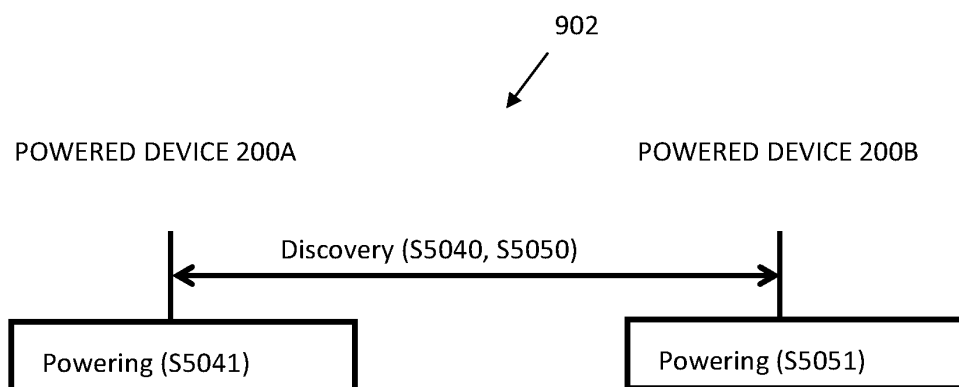


FIG. 38



U.S. Patent

Sep. 29, 2020

Sheet 36 of 40

US 10,790,703 B2

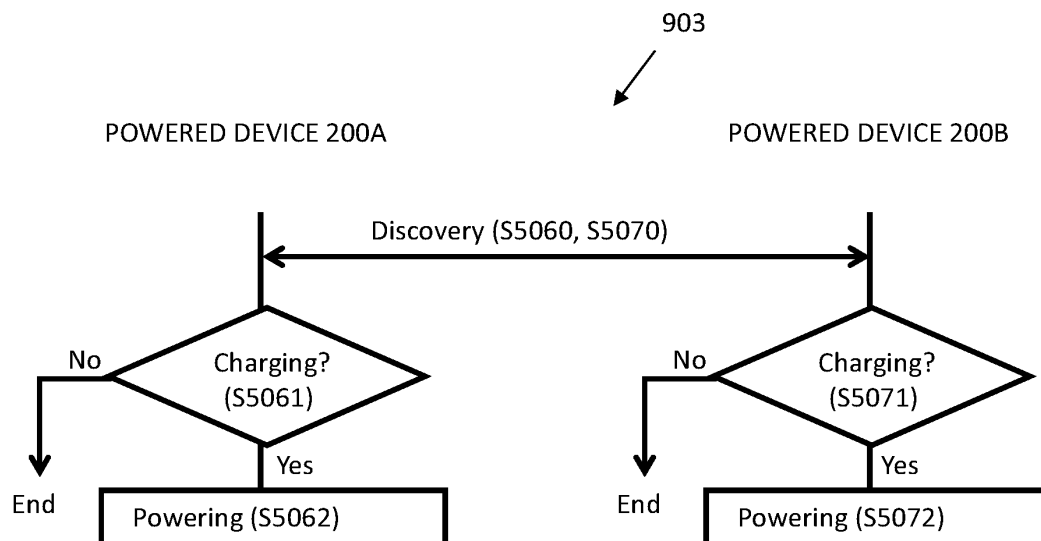


FIG. 39

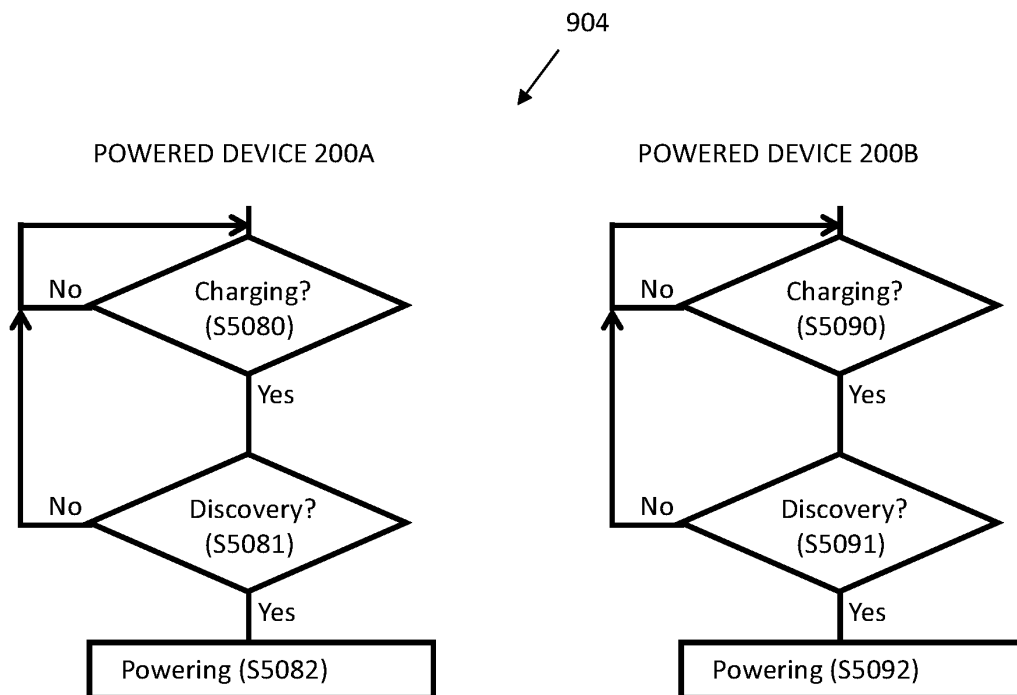


FIG. 40

**U.S. Patent**

Sep. 29, 2020

Sheet 37 of 40

**US 10,790,703 B2**

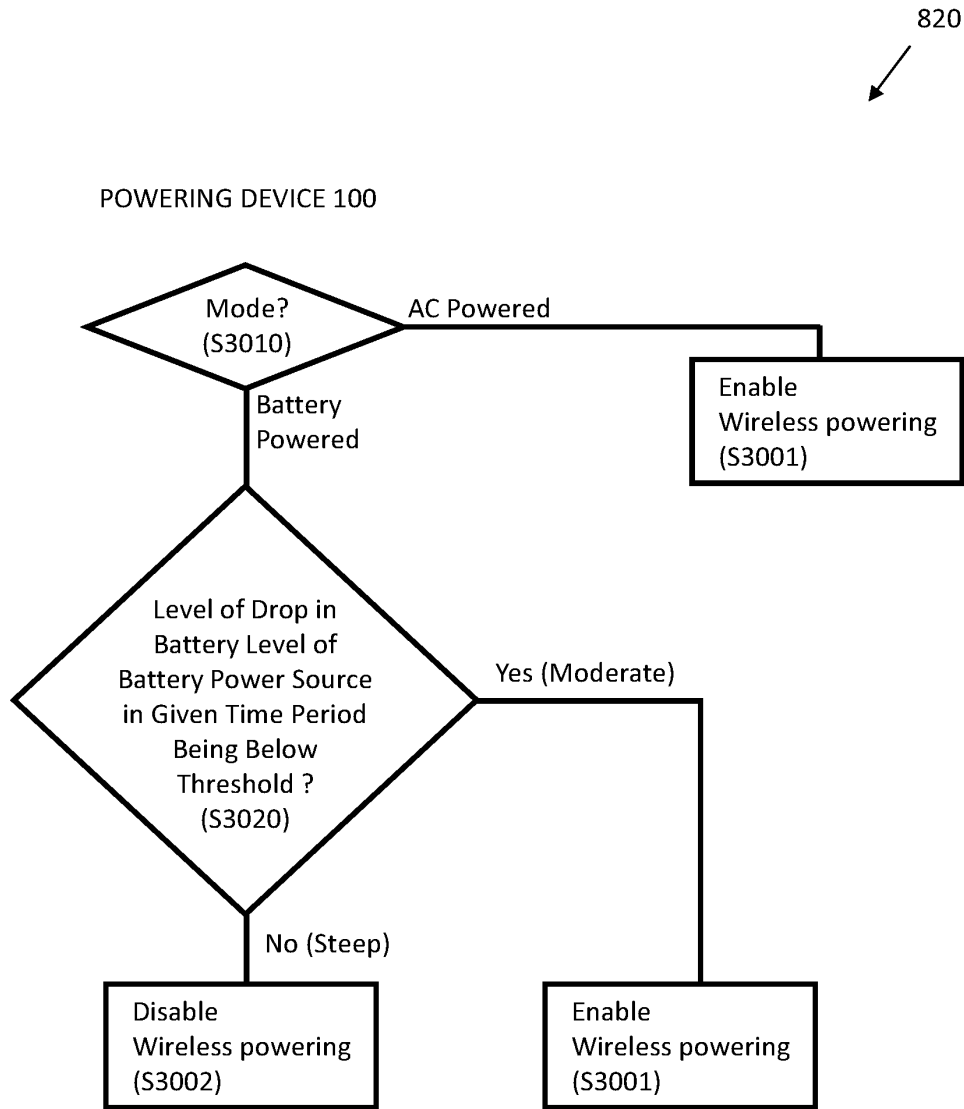


FIG. 41

U.S. Patent

Sep. 29, 2020

Sheet 38 of 40

US 10,790,703 B2

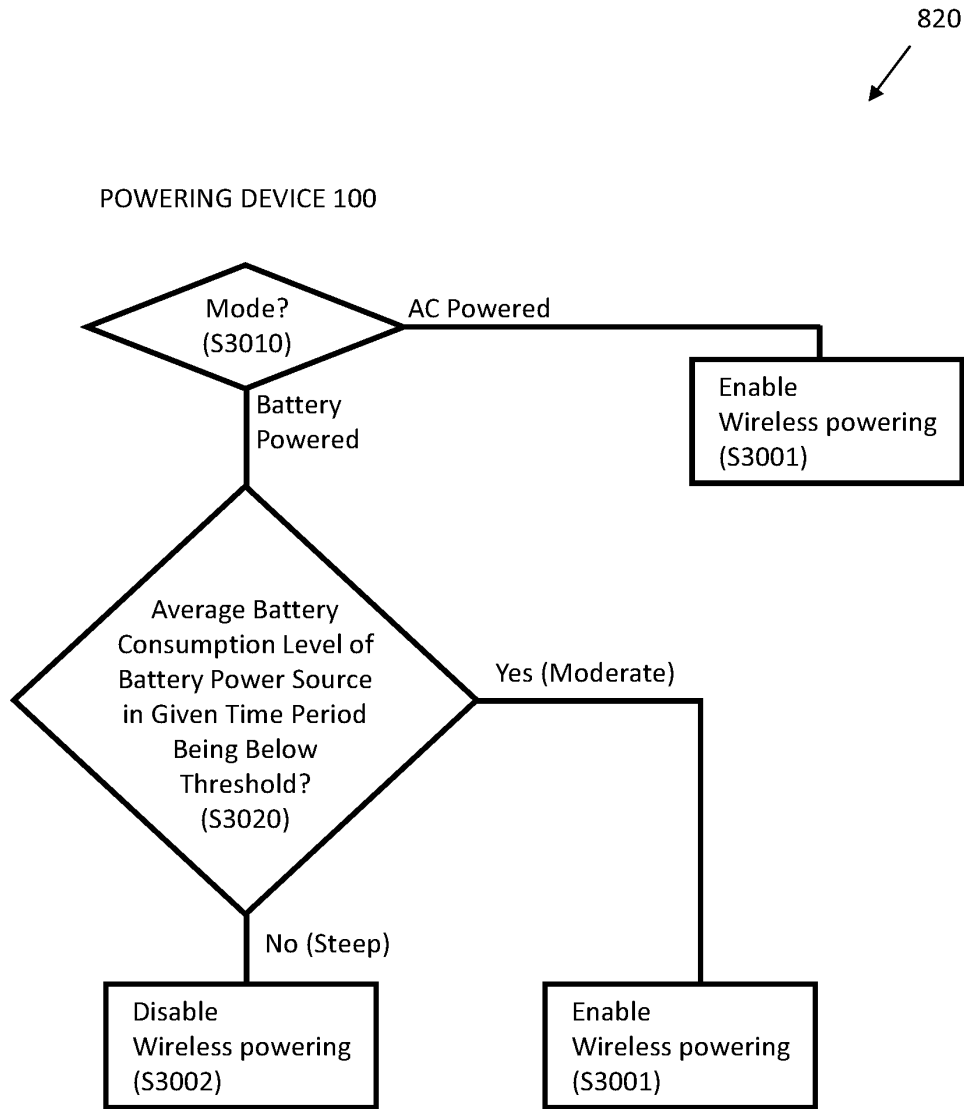


FIG. 42

U.S. Patent

Sep. 29, 2020

Sheet 39 of 40

US 10,790,703 B2

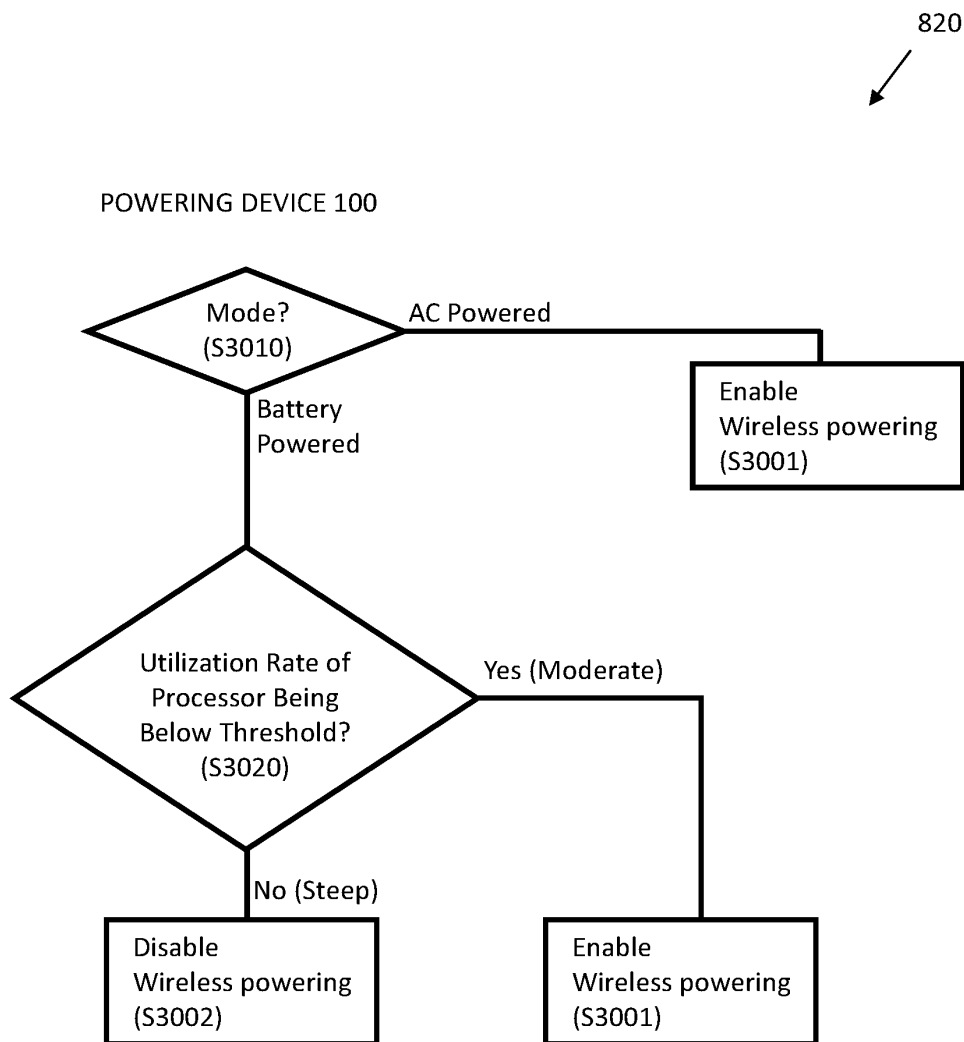


FIG. 43

U.S. Patent

Sep. 29, 2020

Sheet 40 of 40

US 10,790,703 B2

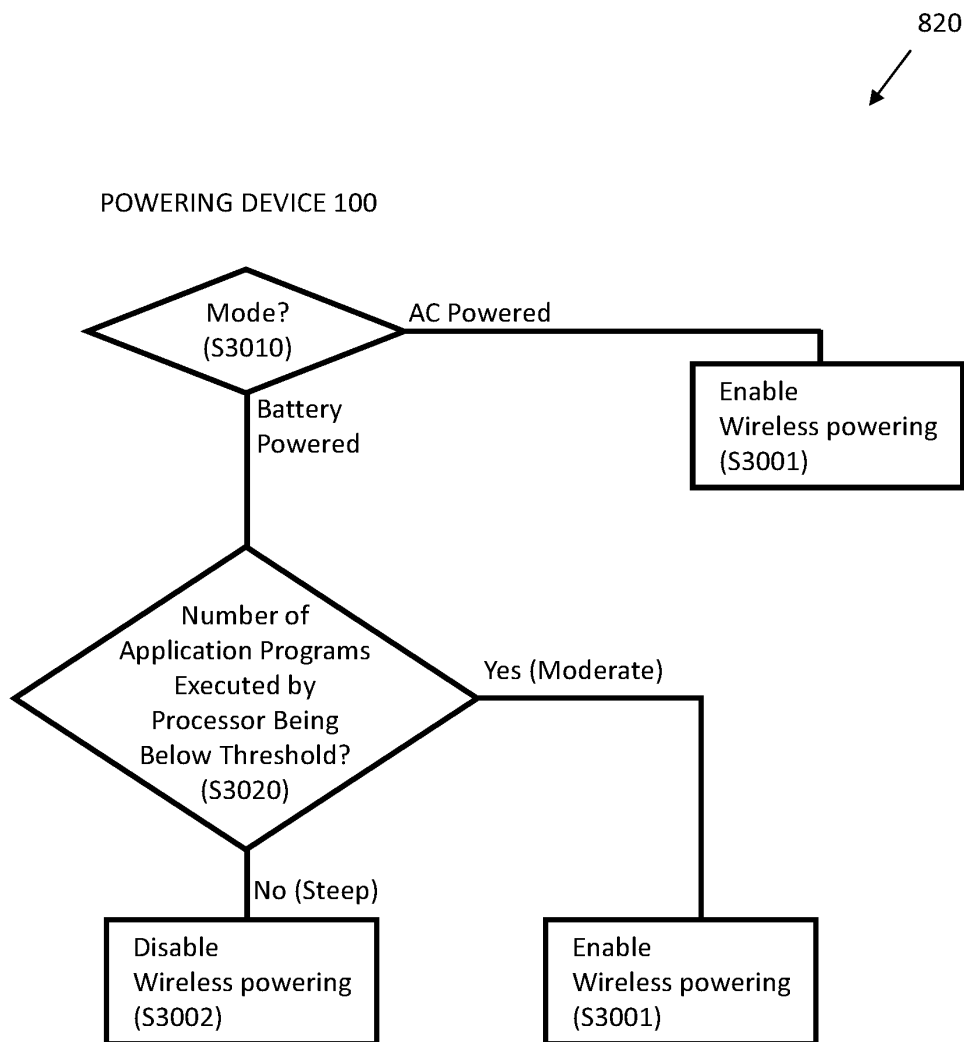


FIG. 44

US 10,790,703 B2

1

**SMART WIRELESS POWER TRANSFER  
BETWEEN DEVICES****CROSS REFERENCE TO RELATED  
APPLICATIONS**

This application claims the benefit of U.S. provisional patent application 62/435,883 filed on Dec. 19, 2016, entitled "Smart Wireless Power Transfer Between Devices", the content of which is incorporated herein by reference in its entirety.

**TECHNICAL FIELD**

The present disclosure relates to improved methods and systems for wireless power charging. More particularly, the present disclosure is directed to smart powering and charging between a wireless powering device and a wireless powered device.

**BACKGROUND**

Wireless power charging or wireless power transfer has been developed for wirelessly charging battery-powered portable devices without the need of use of a physical charging cable. A known typical wireless power transfer system employs some kind of coupling techniques such as inductive coupling and capacitive coupling to provide an electric or magnetic field between a powering device and a powered device, resulting in generation of power at the powered device. In another known wireless power transfer system, a powering device uses transmission of electromagnetic waves to a powered device which then generates power from received electromagnetic waves. Researchers today have been working hard to develop wireless power transfer technologies that are capable of charging more distant devices with more efficiency.

An object of the present invention is to provide solutions for wirelessly powering and charging powered devices in a smart manner.

**SUMMARY**

According to an aspect of the present invention, a wireless power transfer system includes at least one powering device and at least one powered device. Each powering device includes powering circuitry for wireless power transfer to the powered device. Each powered device includes powered circuitry for reception of the wireless power transfer from the powering device.

In an aspect of the present invention, the powering device may include communication circuitry for a close-range wireless communication with the powered device, while the powered device may also include communication circuitry for the close-range wireless communication with the powering device, so as for the powering device and the powered device to discover each other through the communication.

In an aspect of the present invention, the powering device may include a database managing information indicative of at least one powered device authorized to receive wireless power from the powering device; indicative of the presence or absence of communication with the powered device using the communication circuitry; and/or indicative of the status of reception of wireless power transfer by the powered device.

In an aspect of the present invention, the powered device may include a database managing information indicative of

2

at least one powering device from which the powered device is authorized to receive wireless power transfer.

In an aspect of the present invention, the powering device may be configured to: provide wireless power transfer with no regard to an explicit request from the powered device; provide wireless power transfer when an explicit request is issued by the powered device; or provide wireless power transfer upon discovering the powered device through communication using the communication circuitry.

In an aspect of the present invention, the powered device may be configured to: receive wireless power transfer with no regard to the battery level of a battery of the powered device; receive wireless power transfer when the battery level of a battery of the powered device is determined below a threshold; or receive wireless power transfer upon discovering the powering device through communication using the communication circuitry.

In an aspect of the present invention, the powering device may be configured to provide wireless power transfer on the condition that the powering device determines the powered device to be authorized to receive wireless power from the powering device.

In an aspect of the present invention, the powered device may be configured to receive wireless power transfer on the condition that the powered device determines itself to be authorized to receive wireless power transfer from the powering device.

In an aspect of the present invention, the powered device may provide indication of the status of its reception of wireless power transfer using an output of the powered device; and also may notify the powering device of the status so that the powering device may manage the notified status on the database.

In an aspect of the present invention, the powering device may be battery-powered and be configured to conditionally provide wireless power transfer: depending on whether or not the powering device is being battery-powered in operation; and/or depending on the status in connection with the battery level of a battery of the powering device.

In an aspect of the present invention, the powered device may include powering circuitry for wireless power transfer to another powered device for a daisy-chain wireless power transfer between two or more powered devices.

**DRAWINGS**

FIG. 1 is a schematic view illustrating a wireless powering system including a powering device **100** and a powered device **200**, according to some embodiments of the present invention.

FIG. 2 is a schematic view illustrating a wireless powering system including multiple powering devices **100** and a powered device **200**, according to some embodiments of the present invention.

FIG. 3 is a schematic view illustrating a wireless powering system including multiple powered devices **200** present in proximity to one another, according to some embodiments of the present invention.

FIG. 4 is a block diagram illustrating an exemplary configuration of a powering device **100**, according to some embodiments of the present invention.

FIG. 5 is a block diagram illustrating an exemplary configuration of a powering device **100** with a battery for battery-powered operation, according to some embodiments of the present invention.

## US 10,790,703 B2

3

FIG. 6 is a block diagram illustrating an exemplary configuration of a powered device 200, according to some embodiments of the present invention.

FIG. 7 is a block diagram illustrating an exemplary configuration of a powered device 200 with a power supply for AC-powered operation, according to some embodiments of the present invention.

FIG. 8 is a block diagram illustrating an exemplary configuration of a powered device 200 with powering circuitry for wireless power transfer to another powered device, according to some embodiments of the present invention.

FIG. 9 illustrates an exemplary configuration of a database resident on the powering device 100 (DB 122) and a database resident on the powered device 200 (DB 222), according to some embodiments of the present invention.

FIG. 10 is a flowchart illustrating a process for the powering device 100 and the powered device 200 discovering each other, according to some embodiments of the present invention.

FIG. 11 is a flowchart illustrating a process for the powering device 100 and the powered device 200 discovering each other, according to some embodiments of the present invention.

FIG. 12 is a flowchart illustrating a process 400 for wireless power transfer from the powering device 100 to the powered device 200, according to some embodiments of the present invention.

FIG. 13 is a flowchart illustrating a process 401 for wireless power transfer from the powering device 100 to the powered device 200, according to some embodiments of the present invention.

FIG. 14 is a flowchart illustrating a process 402 for wireless power transfer from the powering device 100 to the powered device 200, according to some embodiments of the present invention.

FIG. 15 is a flowchart illustrating a process 403 for wireless power transfer from the powering device 100 to the powered device 200, according to some embodiments of the present invention.

FIG. 16 is a flowchart illustrating a process 404 for wireless power transfer from the powering device 100 to the powered device 200, according to some embodiments of the present invention.

FIG. 17 is a flowchart illustrating a process 500 for wireless power transfer from the powering device 100 to the powered device 200, according to some embodiments of the present invention.

FIG. 18 is a flowchart illustrating a process 406 for wireless power transfer from the powering device 100 to the powered device 200, according to some embodiments of the present invention.

FIG. 19 is a flowchart illustrating a process 407 for wireless power transfer from the powering device 100 to the powered device 200, according to some embodiments of the present invention.

FIG. 20 is a flowchart illustrating a process 408 for wireless power transfer from the powering device 100 to the powered device 200, according to some embodiments of the present invention.

FIG. 21 is a flowchart illustrating a process 510 for wireless power transfer from the powering device 100 to the powered device 200, according to some embodiments of the present invention.

FIG. 22 is a flowchart illustrating a process 604 for wireless power transfer from the powering device 100 to the powered device 200, according to some embodiments of the present invention.

4

FIG. 23 is a flowchart illustrating a process 606 for wireless power transfer from the powering device 100 to the powered device 200, according to some embodiments of the present invention.

FIG. 24 is a flowchart illustrating a process 607 for wireless power transfer from the powering device 100 to the powered device 200, according to some embodiments of the present invention.

FIG. 25 is a flowchart illustrating a process 608 for wireless power transfer from the powering device 100 to the powered device 200, according to some embodiments of the present invention.

FIG. 26 is a flowchart illustrating a process 704 for wireless power transfer from the powering device 100 to the powered device 200, according to some embodiments of the present invention.

FIG. 27 is a flowchart illustrating a process 710 for wireless power transfer from the powering device 100 to the powered device 200, according to some embodiments of the present invention.

FIG. 28 is a flowchart illustrating a process 706 for wireless power transfer from the powering device 100 to the powered device 200, according to some embodiments of the present invention.

FIG. 29 is a flowchart illustrating a process 707 for wireless power transfer from the powering device 100 to the powered device 200, according to some embodiments of the present invention.

FIG. 30 is a flowchart illustrating a process 708 for wireless power transfer from the powering device 100 to the powered device 200, according to some embodiments of the present invention.

FIG. 31 is a flowchart illustrating a process 800 for conditional enablement of wireless power transfer at the powering device 100, according to some embodiments of the present invention.

FIG. 32 is a flowchart illustrating a process 810 for conditional enablement of wireless power transfer at the powering device 100, according to some embodiments of the present invention.

FIG. 33 is a flowchart illustrating a process 820 for conditional enablement of wireless power transfer at the powering device 100, according to some embodiments of the present invention.

FIG. 34 is a block diagram illustrating an exemplary configuration of a powering device 100 operable in a battery-powered mode and an AC-powered mode, according to some embodiments of the present invention.

FIG. 35 is a flowchart illustrating a process 850 for conditional reception of wireless power transfer at the powered device 200, according to some embodiments of the present invention.

FIG. 36 is a flowchart illustrating a process 900 for wireless power transfer from the powered device 200 to another powered device, according to some embodiments of the present invention.

FIG. 37 is a flowchart illustrating a process 901 for wireless power transfer from the powered device 200 to another powered device, according to some embodiments of the present invention.

FIG. 38 is a flowchart illustrating a process 902 for wireless power transfer from the powered device 200 to another powered device, according to some embodiments of the present invention.

## US 10,790,703 B2

5

FIG. 39 is a flowchart illustrating a process 903 for wireless power transfer from the powered device 200 to another powered device, according to some embodiments of the present invention.

FIG. 40 is a flowchart illustrating a process 904 for wireless power transfer from the powered device 200 to another powered device, according to some embodiments of the present invention.

FIG. 41 is a flowchart illustrating a detailed example of the process 820 for conditional enablement of wireless power transfer at the powering device 100, according to some embodiments of the present invention.

FIG. 42 is a flowchart illustrating a detailed example of the process 820 for conditional enablement of wireless power transfer at the powering device 100, according to some embodiments of the present invention.

FIG. 43 is a flowchart illustrating a detailed example of the process 820 for conditional enablement of wireless power transfer at the powering device 100, according to some embodiments of the present invention.

FIG. 44 is a flowchart illustrating a detailed example of the process 820 for conditional enablement of wireless power transfer at the powering device 100, according to some embodiments of the present invention.

## DETAILED DESCRIPTION

## Power Transfer System

Embodiments of the present invention are described with reference to the drawings. The embodiments described herein are for illustrative purpose only and not intended to limit the scope of protection defined by Claims.

In some embodiments, as depicted in FIG. 1, a wireless power transfer system includes a powering device 100 and a powered device 200. The powering device 100 is configured to wirelessly power the powered device 200 through a powering region 10 based on power supplied from a residential or commercial power distribution system via an electrical outlet 20. The powering region 10 may be a magnetic field provided by way of inductive coupling or resonant inductive coupling between coils of wire where the powering device 100 and the powered device 200 use the coils as a power transmitter and a power receiver respectively, in which case the powering region 10 is non-radiative. The powering region 10 may also be an electric field provided by way of capacitive coupling or resonant capacitive coupling between metal electrodes where the powering device 100 and the powered device 200 use the electrodes as a power transmitter and a power receiver respectively, in which case the powering region 10 is non-radiative. The powering region 10 may also be electromagnetic waves or sound waves in any frequency and wavelength, such as radio waves, microwaves, and ultrasonic waves, transmitted by a wireless transmitter of the powering device 100 to be received by a receiver of the powered device 200, in which case the powering region 10 is radiative.

In some embodiments, as depicted in FIG. 2, the power transfer system may include two or more powering devices 100 each of which provides their respective powering regions 10 based on power supplied via electrical outlets 20. In an example shown in FIG. 2, three powering devices 100a, 100b, and 100c provide the powering regions 10a, 10b, and 10c, respectively. The powering devices 100a, 100b, and 100c may be implemented in a way that the powering regions 10a, 10b, and 10c may overlap in part as shown in FIG. 2. In the embodiments, in response to moving

6

across the powering regions 10a, 10b, and 10c, the powered device 200 may “hand over” from a powering region to another, namely, may receive power through the powering regions 10a, 10b, and 10c in turns according to the order or direction of the moving. At an overlapping region where two or more powering regions overlap with one another, the powered device 200 may receive power through one, some, or all of the overlapping powering regions.

In some embodiments, as depicted in FIG. 3, the power transfer system may include two or more powered devices 200 each of which is provided with powering circuitry just as a powering device 100 to provide their respective powering regions. In an example shown in FIG. 3, three powered devices 200a, 200b, and 200c are present in the system to provide the powering regions 11, 12, and 13, respectively. The powered devices 200a to 200c are so operative as to provide power in a daisy chain or in parallel with one another to distribute power in the order from the powered device 200a nearest to the powering device 100 to the powered device 200c most distant from the powering device 100. In other words, the powered device 200a may wirelessly power the powered device 200b based on power generated by way of wireless power transfer from the powering device 100, and the powered device 200b may then wirelessly power the powered device 200c based on power generated by way of wireless power transfer from the powered device 200a. The powered device 200c may also perform wireless power transfer based on power generated by way of wireless power transfer from the powered device 200b. In this manner, the system may facilitate wireless power transfer between powered devices 200 in a daisy chain, allowing relay of power from a powered device 200 nearest to the powering device 100 to the last powered device 200 most distant from the powering device 100.

The powering device 100 may be a fixed or non-mobile power station installed in a house, office, or other buildings, or outside where the device 100 has access to at least one of the residential and commercial power distribution systems. The powering device 100 may also be a mobile, portable, or handheld power station that a user is able to carry to place at any desired location in the house, office, or other buildings, or outside where the device 100 has access to at least one of the residential and commercial power distribution systems. The powering device 100 may also be a powering port above or on which a vehicle or robot such as an unmanned air vehicle (UAV) or drone hovers or rests to get charged.

The powered device 200 may be a battery-charged device in any form, including but not limited to a mobile, portable, or handheld device such as a smartphone, laptop, and handheld home appliance, a peripheral or slave device operative in connection with the powering device 100, and an Internet-of-Things (IoT) device such as a sensor operative to communicate with other powered devices 200 and/or with the powering device 100. The powered device 200 may also be a vehicle or robot such as a UAV or drone which is operative to rest on or hover above the powering device 100 for charging.

## Powering Device

In some embodiments, as depicted in FIG. 4, the powering device 100 includes a processor 101, a memory 102, communication circuitry 103, an input 104, an output 105, powering circuitry 106, and a power supply 107.

The processor 101 is a processing unit operative to execute computer programs resident on the memory 102 to



## US 10,790,703 B2

7

process various data and to control the components coupled to the processor **101**. The processor **101** may be a central processing unit (CPU), a micro processing unit (MPU), a digital signal processor (DSP), another general or dedicated processing unit, or combination thereof.

The memory **102** is coupled to the processor **101** and is operative to store one or more computer programs and/or various data for execution and/or use by the processor **101**. The memory **102** may be a read only memory (ROM), a random access memory (RAM), another memorizing component or computer-readable medium, or combination thereof. In some embodiments, the memory **102** stores at least an operating system (OS) **120**, a powering control program **121**, and a database (DB) **122**. The powering control program **121** is an application program configured to run on the OS **120** or part of the OS **120**, to control operation of wireless power transfer using the powering circuitry **106**. The DB **122** includes information indicative of the identifier of the powered device **200** and/or the status of wireless power transfer to the powered device **200**.

The communication circuitry **103** is coupled to the processor **101** and is operative to perform a wireless communication in accordance with at least one wireless communication standard for wireless communication with the powered device **200**. The communication circuitry **103** may be a single circuit designed to perform a communication in compliance with a single communication standard, or may be one or more single or combined circuits designed to perform communication in compliance with multiple communication standards. The wireless communication herein may include a wireless local area network (WLAN) or Wi-Fi communication in accordance with IEEE 802.11 standards; a wireless personal area network (WPAN) communication such as the Bluetooth and ZigBee in accordance with IEEE 802.15 standards, a Radio-Frequency Identification (RFID) communication, a Near-Field Communication (NFC), a ultrasonic communication, an IR communication, and the likes.

The input **104** is coupled to the processor **101**. The input **104** is operative to receive a user input made on the input **104** and feed signals indicative of the user input to the processor **101**. The input **104** may be a keyboard, keypad, or other similar mechanical key assembly with one or more mechanical keys. The input **104** may also be a touch-screen device integrated with a display, in which case the display **104** is operative to display a graphical user interface through which to receive the user input by detecting touches or taps made by the user onto the surface of the touch-screen device.

The output **105** is coupled to the processor **101**. The output **105** is operative to receive, from the processor **101**, graphical, visual, audible, or otherwise perceptual data to output video or sound, or otherwise generate perceptual output for notifying the user of some information in relation to the powering device **100**. For example, the output **105** may notify the user of the status of the operation of the powering device **100**. The output **105** may be a display such as a liquid crystal display (LCD) and an electro-luminescence (EL) display for visual output using graphics. The output **105** may also be a lighting or luminance device for visual output using one or more lighting sources each of which emits light in one or more colors. The output **105** may also be a loudspeaker for audible output using one or more tones.

The powering circuitry **106** is coupled to the processor **101**. Under control of the processor **101**, the powering circuitry **106** is turned on and off to be active or not active. The powering circuitry **106** is operative to wirelessly transfer power to the powered device **200** by providing the

8

powering region **10** in accordance with a wireless power transfer technique. An example of the power transfer technique may be inductive coupling or resonant inductive coupling, in which case the powering circuitry **106** may include a coil of wire and an oscillator. In the example, when the powering circuitry **106** is activated, the oscillator uses power supplied from the power supply **107** to feed a high frequency alternating current (AC) on the coil so that a magnetic field is created as the non-radiative powering region **10** between the coil and a coil of wire of the powered device **200** (i.e., a coil of wire in an after-mentioned powered circuitry **206**). Another example of the power transfer may be capacitive coupling or resonant capacitive coupling, in which case the powering circuitry **106** may include at least one electrode such as a metal plate and an oscillator. In the example, when the powering circuitry **106** is activated, the oscillator uses power supplied from the power supply **107** to apply an alternating voltage on the electrode so that an electric field is created as the non-radiative powering region **10** between the electrode and an electrode of the powered device **200** (i.e., an electrode in after-mentioned powered circuitry **206**). Another example of the power transfer may also be electromagnetic waves or sound waves in any frequency and wavelength, such as radio waves, microwaves, and ultrasonic waves, in which case the powering circuitry **106** may include a transmitter operative to emit the corresponding waves to provide the radiative powering region **10** within which a receiver of the powered device **200** (i.e., a receiver in an after-mentioned powered circuitry **206**) receives the waves.

The power supply **107** is coupled to the processor **101**. The power supply **107** is operative to generate power based on power from a residential or commercial power distribution system via an electrical outlet **20**, and to supply the power to all of or at least part of the components of the powering device **100**, namely, the components **101** to **106**. The power supply **107** may be supplied with power directly through a cable plugged into the outlet **20**, or by way of an AC adapter with the cable.

In some embodiments, as depicted in FIG. 5, the powering device **100** may further include charging circuitry **108** and a battery **109** to be battery-operated. The charging circuitry **108** is coupled to the processor **101**. The charging circuitry **108** is operative to charge the battery **109** using power supplied from the power supply **107**, using a rectifier, voltage controller, and/or other components well known in the art. The battery **109**, charged by the charging circuitry **108**, is a power source other than the power supply to store the charged power and supply the power to all of or at least part of the components of the powering device **100**, namely, the components **101** to **107**. The battery **109** may be a battery in any form, including but not limited to a lithium-ion rechargeable battery. In the embodiments, under control of the processor **101**, the powering device **100** may operate in either one of a first mode where the powering device **100** is powered by the power supply **107** without being powered by the battery **109** and a second mode where the powering device **100** is powered by the battery **109** without being powered by the power supply **107**. The powering device **100** may automatically choose to operate in the first mode when the powering device **100** is plugged into the outlet **20** so the power supply **107** is receiving power via the outlet **20**. The powering device **100** may automatically choose to operate in the second mode when the powering device **100** is not plugged into the outlet **20** so the power supply **107** is not receiving power via the outlet **20**. More particularly, the processor **101** may automatically change the mode from the

## US 10,790,703 B2

9

first one to the second one in response to detection of termination or failure of power supply via the outlet **20** whereas may automatically change the mode from the second one to the first one in response to detection of initiation or presence of power supply via the outlet **20**. Alternatively, the processor **101** may change the mode between the first and second ones in response to a manual user input using the input **104**.

## Powered Device

In some embodiments, as depicted in FIG. 6, the powered device **200** includes a processor **201**, a memory **202**, communication circuitry **203**, an input **204**, an output **205**, powered circuitry **210**, charging circuitry **208**, and a battery **209**.

The processor **201** is a processing unit operative to execute computer programs resident on the memory **202** to process various data and to control the components coupled to the processor **201**. The processor **201** may be a central processing unit (CPU), a micro processing unit (MPU), a digital signal processor (DSP), another general or dedicated processing unit, or combination thereof.

The memory **202** is coupled to the processor **201** and is operative to store one or more computer programs and/or various data for execution and/or use by the processor **201**. The memory **202** may be a read only memory (ROM), a random access memory (RAM), another memorizing component or computer-readable medium, or combination thereof. In some embodiments, the memory **202** stores at least an operating system (OS) **220**, a charging control program **221**, and a database (DB) **222**. The charging control program **221** is an application program configured to run on the OS **220** or part of the OS **220**, to control reception of wireless power transfer using the powered circuitry **210**. The DB **222** includes information indicative of the identifier of the powered device **200** and/or the identifier of the powering device **100**.

The communication circuitry **203** is coupled to the processor **201** and is operative to perform a wireless communication in accordance with at least one wireless communication standard for wireless communication with the powering device **100**. The communication circuitry **203** may be a single circuit designed to perform a communication in compliance with a single communication standard, or may be one or more single or combined circuits designed to perform communication in compliance with multiple communication standards. The wireless communication herein may include a wireless local area network (WLAN) or Wi-Fi communication in accordance with IEEE 802.11 standards; a wireless personal area network (WPAN) communication such as the Bluetooth and ZigBee in accordance with IEEE 802.15 standards, a Radio-Frequency Identification (RFID) communication, a Near-Field Communication (NFC), a ultrasonic communication, an IR communication, and the likes.

The input **204** is coupled to the processor **201**. The input **204** is operative to receive a user input made on the input **204** and feed signals indicative of the user input to the processor **201**. The input **204** may be a keyboard, keypad, or other similar mechanical key assembly with one or more mechanical keys. The input **204** may also be a touch-screen device integrated with a display, in which case the display **204** is operative to display a graphical user interface through which to receive the user input by detecting touches or taps made by the user onto the surface of the touch-screen device.

10

The output **205** is coupled to the processor **201**. The output **205** is operative to receive, from the processor **201**, graphical, visual, audible, or otherwise perceptual data to output video or sound, or otherwise generate perceptual output for notifying the user of some information in relation to the powered device **200**. For example, the output **205** may notify the user of the status of the operation of the powered device **200**. The output **205** may be a display such as a liquid crystal display (LCD) and an electro-luminance (EL) display for visual output using graphics. The output **205** may also be a lighting or luminance device for visual output using one or more lighting sources each of which emits light in one or more colors. The output **205** may also be a loudspeaker for audible output using one or more tones.

The powered circuitry **210** is coupled to the processor **201**. Under control of the processor **201**, the powered circuitry **210** is turned on and off to be active or not active. The powered circuitry **210** is operative to receive power wirelessly transferred by the powering device **100** within the powering region **10** in accordance with a wireless power transfer technique. An example of the power transfer technique may be inductive coupling or resonant inductive coupling, in which case the powered circuitry **210** may include a coil of wire and a rectifier. In the example, when the powered circuitry **210** is activated, the rectifier rectifies an alternating current generated by the coil within a magnetic field created by the coil of the powering device **100** (i.e., the coil in the above-mentioned powering circuitry **106**) to feed the rectified power to the charging circuitry **208**. A switch may be provided to enable and disable connection between the coil and the rectifier such that the switch is on to enable the connection when the powered circuitry **210** is activated whereas the switch is off to disable the connection when the powered circuitry **210** is deactivated. Another example of the power transfer may be capacitive coupling or resonant capacitive coupling, in which case the powered circuitry **210** may include at least one electrode such as a metal plate and a rectifier. In the example, when the powered circuitry **210** is activated, the rectifier rectifies an alternating current generated from an electric field created between the electrodes of the powering circuitry **106** and the powered circuitry **21** to feed the rectified power to the charging circuitry **208**. A switch may be provided to enable and disable connection between the electrode and the rectifier such that the switch is on to enable the connection when the powered circuitry **210** is activated whereas the switch is off to disable the connection when the powered circuitry **210** is deactivated. Another example of the power transfer may also be electromagnetic waves or sound waves in any frequency and wavelength, such as radio waves, microwaves, and ultrasonic waves, in which case the powered circuitry **210** may include a receiver operative to receive the corresponding waves within the radiative powering region **10**.

The charging circuitry **208** is coupled to the processor **201**. The charging circuitry **208** is operative to charge the battery **209** using power supplied from the powered circuitry **210**, using a rectifier, voltage controller, and/or other components well known in the art.

The battery **209**, charged by the charging circuitry **208**, is a power source to store the charged power and supply the power to all of or at least part of the components of the powered device **200**, namely, the components **201** to **210**. The battery **209** may be a battery in any form, including but not limited to a lithium-ion rechargeable battery.

In some embodiments, as depicted in FIG. 7, the powered device **200** may further include a power supply **207**. The power supply **207** is coupled to the processor **201**. The

## US 10,790,703 B2

11

power supply 207 is operative to generate power based on power from a residential or commercial power distribution system via an electrical outlet 20, and to supply the power to all of or at least part of the components of the powered device 200, namely, the components 201 to 210. The power supply 207 may be supplied with power directly through a cable plugged into the outlet 20, or by way of an AC adapter with the cable. In the embodiments, under control of the processor 201, the powered device 200 may operate in either one of a first mode where the powered device 200 is powered by the power supply 207 without being powered by the battery 209 and a second mode where the powered device 200 is powered by the battery 209 without being powered by the power supply 207. The powered device 200 may automatically choose to operate in the first mode when the powered device 200 is plugged into the outlet 20 so the power supply 207 is receiving power via the outlet 20. The powered device 200 may automatically choose to operate in the second mode when the powering device 100 is not plugged into the outlet 20 so the power supply 207 is not receiving power via the outlet 20. More particularly, the processor 201 may automatically change the mode from the first one to the second one in response to detection of termination or failure of power supply via the outlet 20 whereas may automatically change the mode from the second one to the first one in response to detection of initiation or presence of power supply via the outlet 20. Alternatively, the processor 201 may change the mode between the first and second ones in response to a manual user input using the input 204.

In some embodiments, as depicted in FIG. 8, the powered device 200 may further include powering circuitry 206 to be operative not only to receive wireless power transfer but also to provide wireless power transfer to relay wirelessly-received power to another powered device 200. In the embodiments, the powering circuitry 206 may be configured just as the powering circuitry 106 of the powering device 100: Under control of the processor 201, the powering circuitry 206 is turned on and off to be active or not active. The powering circuitry 206 is operative to wirelessly transfer power to another powered device 200 by providing the powering region 10 in accordance with a wireless power transfer technique. An example of the power transfer technique may be inductive coupling or resonant inductive coupling, in which case the powering circuitry 206 may include a coil of wire and an oscillator. In the example, when the powering circuitry 206 is activated, the oscillator uses power generated by the powered circuitry 210 to feed a high frequency alternating current (AC) on the coil so that a magnetic field is created as the non-radiative powering region 10 between the coil and a coil of wire of another powered device 200 (i.e., a coil of wire in powered circuitry 206 of another powered device 200). Another example of the power transfer may be capacitive coupling or resonant capacitive coupling, in which case the powering circuitry 206 may include at least one electrode such as a metal plate and an oscillator. In the example, when the powering circuitry 206 is activated, the oscillator uses power generated by the powered circuitry 210 to apply an alternating voltage on the electrode so that an electric field is created as the non-radiative powering region 10 between the electrode and an electrode of another powered device 200 (i.e., an electrode in powered circuitry 206 of another powered device 200). Another example of the power transfer may also be electromagnetic waves or sound waves in any frequency and wavelength, such as radio waves, microwaves, and ultrasonic waves, in which case the powering circuitry 206 may

12

include a transmitter operative to emit the corresponding waves to provide the radiative powering region 10 within which a receiver of another powered device 200 (i.e., a receiver in powered circuitry 206 of another powered device 200) receives the waves.

## DB122 DB222

In some embodiments, the powering device 100 may manage wireless power transfer to the powered device 200 using the DB 122. In the embodiments, the DB 122 may be generated by the processor 101 and stored on the memory 102. The OS 120 or the powering control program 121 may have the computer program instructions for the generation of the DB 122. The DB 122 manages one or more identifiers (IDs) each of which is unique to each powered device 200 for authentication to enable and disable wireless power transfer and for confirmation of the status of operation of each powered device 200. As depicted in FIG. 9, the DB 122 lists each unique ID (ID 1 through ID 5) uniquely assigned to a powered device 200 which is allowed or authorized to receive wireless power transfer from the powering device 100. The DB 122 may indicate, for example as depicted in the column 122a, the communication status for each listed powered device 200 where “yes” is entered for each ID of powered devices 200 which are in communication with the powering device 100 while “No” is entered for each ID of powered devices 200 which are not in communication with the powering device 100. The DB 122 may also indicate the status of reception of wireless power transfer for each listed powered device 200. As depicted in the column 122b, examples of the status include “charging” indicating that the corresponding powered device 200 is receiving wireless power transfer from the powering device 100 and charging the battery 209; “standby” indicating that the corresponding powered device 200 is ready for reception of wireless power transfer within the powering region 10 but is not receiving the wireless power transfer; and “N/A” indicating that the corresponding powered device 200 is not found within the powering region 10.

In some embodiments, the powered device 200 may manage reception of wireless power transfer from the powering device 100 using the DB 222. In the embodiments, the DB 222 may be generated by the processor 201 and stored on the memory 202. The OS 220 or the charging control program 221 may have the computer program instructions for the generation of the DB 222. The DB 222 manages one or more identifiers (IDs) each of which is unique to each powering device 100 for authentication to enable and disable reception of wireless power transfer. As depicted in FIG. 9, the DB 222 lists each unique ID (ID A through ID E) uniquely assigned to a powering device 100 from which the powered device 200 is allowed or authorized to receive wireless power transfer.

At least one of the DBs 122 and 222 may be generated by way of, upon, or in response to pairing of the powering device 100 and the powered device 200 through a wireless communication using the communication circuitry 103 and 203. The pairing may include the powering device 100 and the powered device 200 discovering one another by inter-communicating their respective unique IDs and/or other data related to security assurance with one another within a range of the wireless communication.

## Pairing/Discovery Process

An example of the pairing includes pairing by a known discovery process including but not limited to a Web Service



## US 10,790,703 B2

13

Dynamic Discovery (WSD) approved by Organization for the Advancement of Structured Information Standards (OASIS); Domain Name System (DNS)-based Service Discovery (DSN-SD) such as multicast DNS (mDNS) published as RFC 6762, Simple Service Discovery Protocol (SSDP) used in Universal Plug And Play (UPnP), Service Discovery Protocol (SDP) used in Bluetooth; and the likes. Typically, as depicted in FIG. 10, the discovery process may be achieved by way of announcement, advertisement, or notification of the presence by the powering device 100 and the powered device 200 using a multicast message (S100, S200); search for devices of interest by the powering device 100 and the powered device 200 using a multicast message (S101, S201); and response to the search by the powering device 100 and the powered device 200 using a unicast message (S102, S202). The discovery process may be performed, for example, through various wireless communications using the communication circuitry 103 and 203, such as a wireless local area network (WLAN) or Wi-Fi communication in accordance with IEEE 802.11 standards; a wireless personal area network (WPAN) communication such as the Bluetooth and ZigBee in accordance with IEEE 802.15 standards, a RFID communication, a NFC, a ultrasonic communication, an IR communication, and the likes. The discovery process may enable the powering device 100 and the powered device 200 to know the presence of one another and exchange the identifications, such as the media access control (MAC) addresses, IP addresses, Bluetooth Device (BD) addresses, Unique Identifiers (UID), uniquely assigned names, and other identification information depending at least in part on the wireless communication standard pursuant to which the communication circuitry 103 and 203 communicate. The discovery process may finish by the powering device 100 and the powered device 200 storing the exchanged IDs on the memories 102 and 202, respectively (S103, S203). The DBs 122 and 222 may be generated by the processors 101 and 201, respectively, upon or in response to the completion of the discovery process (S104, S204). The OS 120 or the powering control program 121 may have the computer program instructions for the steps S100 to S104 while the OS 220 or the charging control program 221 may have the computer program instructions for the steps S200 to S204.

Another example of the pairing includes pairing by way of exchange or share of security information such as a common encrypted key between the powering device 100 and the powered device 200, following the discovery process, followed by the discovery process, or in the course of the discovery process. Typically, as depicted in FIG. 11, the security information exchange process may be achieved by way of a request for the security information exchange by the powered device 200 operative as a slave (S110); a response to the request by the powering device 100 operative as a master (S210); and exchange of the security information between the powering device 100 and the powered device 200 (S111, S211). An example of the security information exchange includes pairing by exchange of a common encrypted key known as a Personal Information Number (PIN) or link key, in accordance with Bluetooth standard. The security information exchange process may finish by the powering device 100 and the powered device 200 storing the exchanged security information on the memories 102 and 202, respectively (S112, S212). The DBs 122 and 222 may be generated by the processors 101 and 201, respectively, upon or in response to the completion of the security information exchange process (S113, S213). The OS 120 or the powering control program 121 may have

14

the computer program instructions for the steps S110 to S113 while the OS 220 or the charging control program 221 may have the computer program instructions for the steps S210 to S213.

In some embodiments, at least one of the DBs 122 and 222 may be generated manually by a user. In the embodiments, the powering device 100 may receive a user input through the input 104 to enter the ID of the powered device 200, and in response to the input, generate the DB 122 by associating the entered ID with the ID of the powering device 100. Similarly, the powered device 200 may receive a user input through the input 204 to enter the ID of the powering device 100, and in response to the input, generate the DB 222 by associating the entered ID with the ID of the powered device 200.

## Power Transfer Processes

The following describes the detailed embodiments of wireless power transfer from the powering device 100 to the powered device 200 and/or between the powered devices 200.

FIG. 12 depicts an example of a detailed wireless power transfer process 400 according to some embodiments where wireless power transfer may be accomplished between the powering device 100 and the powered device 200 all the time. In the embodiments, as depicted in FIG. 12, the powering device 100 continuously remains the powering circuitry 106 active irrespective of or regardless of any request from the powered device 200 to continuously perform wireless power transfer (S1000). In other words, the powering device 100 may provide the powering region 10 all the time once the powered device 200 is within the range of the powering region 10. In the embodiments, the powered device 200 remains the powered circuitry 210 active all the time for reception of wireless power transfer (S2000), and continuously, periodically, or intermittently determines whether or not the powered device 200 is receiving wireless power transfer through the powered circuitry 210 to charge the battery 209 (S2001). The determination at the step S2001 may be achieved by determining whether or not the battery 209 is being charged by the charging circuitry 208 using power generated by the powered circuitry 210. The powered device 200 then indicates the status of reception of wireless power transfer depending on the determination result by use of the output 205 (S2002, S2003). Upon determining affirmatively, namely, determining that the battery 209 is being charged by the charging circuitry 208 using power generated by the powered circuitry 210 (S2001: Yes), the powered device 200 provides an indication showing that the powered device 200 is in a "Wireless Charging" mode where the powered device 200 is wirelessly charging the battery 209 using the powered circuitry 210 (S2002), whereas upon determining negatively, namely, determining that the battery 209 is not being charged by the charging circuitry 208 using power generated by the powered circuitry 210 (S2001: No), the powered device 200 provides an indication showing that the powered device 200 is in a "No Power" mode where the powered device 200 is not wirelessly charging the battery 209 using the powered circuitry 210 (S2003). For the process 400, the powering control program 121 may have the computer program instructions for the step S1000 while the charging control program 221 may have the computer program instructions for the steps S2000 to S2003.

FIG. 13 depicts an example of a detailed wireless power transfer process 401 according to some embodiments where wireless power transfer may be accomplished between the

US 10,790,703 B2

15

powering device 100 and the powered device 200 when the powered device 200 has a low battery level in the battery 209. In the embodiments, as depicted in FIG. 13, the powering device 100 continuously remains the powering circuitry 106 active irrespective of or regardless of any request from the powered device 200 to continuously perform wireless power transfer (S1010). In other words, the powering device 100 may provide the powering region 10 all the time once the powered device 200 is within the range of the powering region 10. In the embodiments, the powered device 200 with the powered circuitry 210 deactivated in a “No Power” mode where the powered device 200 is not wirelessly charging the battery 209, continuously, periodically, or intermittently monitors the battery level of the battery 209 by, for example, determining whether or not the battery level is sufficient above a first predetermined threshold while the powered circuitry 210 is not active (S2010). As long as the battery level is determined to be above the first predetermined threshold (S2010: Yes), the powered device 200 remains the powered circuitry 210 deactivated. Upon determining the battery level to be insufficient below the first predetermined threshold (S2010: No), the powered device 200 activates the powered circuitry 210 (S2011). Once the powered circuitry 210 is activated, the powered device 200 determines whether or not the battery 209 is being charged by the charging circuitry 208 using power generated by the powered circuitry 210 (S2012). If the battery 209 is determined to be not being charged by the charging circuitry 208 using power generated by the powered circuitry 210 (S2012: No), the powered device 200 provides an indication showing that the powered device 200 is in a “Standby” mode where the powered device 200 is not wirelessly charging the battery 209 while the powered circuitry 210 is activated and expecting the wireless charging will soon start (S2013). If the battery 209 is determined to be being charged by the powered circuit 210 (S2012: Yes), the powered device 200 provides an indication showing that the powered device 200 is in a “Wireless Charging” mode where the powered device 200 is wirelessly charging the battery 209 using the powered circuitry 210 (S2014). When in the “Wireless Charging” mode, the powered device 200 continuously, periodically, or intermittently monitors the battery level of the battery 209 by, for example, determining whether or not the battery level is sufficient above a second predetermined threshold (S2015). Preferably, the second predetermined threshold is set to be higher than the first predetermined threshold: For example, the first threshold may be set to be very low below the middle between the empty level and the fully-charged level, whereas the second threshold may be set to be relatively high near the fully-charged level of the battery 209. As long as the battery level of the battery 209 is determined to be below the second predetermined threshold, meaning that the battery 209 has been not yet charged sufficiently (S2015: No), the powered device 200 remains the powered circuitry 210 activated in order for the battery 209 to be charged through the powered circuitry 210. Upon determining that the battery level is above the second predetermined level as a result of the battery 209 being charged sufficiently (S2015: Yes), the powered device 200 deactivates the powered circuitry 210 (S2016). The powered device 200 then provides an indication showing that the powered device 200 is now in a “No Power” mode where the powered device 200 is not wirelessly receiving power transfer for charging the battery 209 (S2017), and returns to the battery level determination at the step S2010. For the process 401, the powering control program 121 may have the computer program instructions for the step S1010 while

16

the charging control program 221 may have the computer program instructions for the steps S2010 to S2017.

FIG. 14 depicts an example of a detailed wireless power transfer process 402 according to some embodiments where wireless power transfer may be accomplished and kept on the condition that the powered device 200 responds to wireless power transfer provided by the powering device 100. In the embodiments, as depicted in FIG. 14, the powering device 100 first operates in a “Beacon” mode where the powering device 100 does not remain the powering circuitry 106 always activated but instead just intermittently and instantaneously activates the powering circuitry 106 to “beacon” wireless power transfer (S1020). At the step S1020, the powering device 100 may provide an instantaneous wireless power transfer once in every predetermined beacon period. In the “Beacon” mode, the powering device 100 waits for a response to be received by the communication circuitry 103 from the powered device 200 (S1021). The response is designed as a responsive signal to be broadcasted by the powered device 200 through the communication circuitry 203 in response to the powered device 200 receiving the wireless power transfer. Absence of the response keeps the powering device 100 operative in the “Beacon” mode (S1021: No). In response to reception of the response through the communication circuitry 103 (S1021: Yes), the powering device 100 initiates continuous activation of the powering circuitry 106 to operate in a “Powering” mode (S1022). In the “Powering” mode, the powering device 100 remains the powering circuitry 106 active to continuously provide wireless power transfer. In the “Powering” mode, the powering device 100 continuously monitors reception of the responses through the communication circuitry 103 from the powered device 200 (S1023). A response is expected to be broadcasted by the powered device 200 every time the powered device 200 receives wireless power transfer or once in a predetermined period as long as the powered device 200 is receiving wireless power transfer. As long as the powering device 100 successfully receives the responses through the communication circuitry 103, the powering device 100 remains operation in the “Powering” mode (S1023: Yes). Upon failing to receive a predetermined number of responses (S1023: No), the powering device 100 stops continuous activation of the powering circuitry 106 to operate back in the “Beacon” mode (S1024). In the embodiments, the powered device 200 remains the powered circuitry 210 active for reception of wireless power transfer all the time (S2020), and continuously, periodically, or intermittently determines whether or not the powered device 200 is receiving wireless power transfer through the powered circuitry 210 to charge the battery 209 (S2021). The determination at the step S2021 may be achieved by determining whether or not the battery 209 is being charged by the charging circuitry 208 using power generated by the powered circuitry 210. The powered device 200 then indicates the status of reception of wireless power transfer depending on the determination result by use of the output 205 (S2022, S2024). Upon determining affirmatively, namely, determining that the battery 209 is being charged by the charging circuitry 208 using power generated by the powered circuitry 210 (S2021: Yes), the powered device 200 provides an indication showing that the powered device 200 is in a “Wireless Charging” mode where the powered device 200 is wirelessly charging the battery 209 using the powered circuitry 210 (S2022), whereas upon determining negatively, namely, determining that the battery 209 is not being charged by the charging circuitry 208 using power generated by the powered circuitry 210 (S2021: No), the powered

## US 10,790,703 B2

17

device 200 provides an indication showing that the powered device 200 is in a “No Power” mode where the powered device 200 is not wirelessly charging the battery 209 using the powered circuitry 210 (S2024). In the “Wireless Charging” mode, the powered device 200 continuously, periodically, or intermittently broadcasts response, namely, responsive signals designed to be broadcasted in response to reception of wireless power transfer using the communication circuitry 203 (S2023). According to the steps S1020 to S1024 and the steps S2020 to S2024, the continuous wireless power transfer is initiated when the powered device 200 comes in the powering region 10 and responds to the beacons wireless power transfer. Thereafter, the continuous wireless power transfer is terminated when the powered device 200 departs from the powering region 10 and cannot respond to the continuous power transfer. For the process 402, the powering control program 121 may have the computer program instructions for the steps S1020 to S1024 while the charging control program 221 may have the computer program instructions for the steps S2020 to S2024.

FIG. 15 depicts an example of a detailed wireless power transfer process 403 according to some embodiments where wireless power transfer may be accomplished and kept on the condition that the powered device 200 responds to wireless power transfer provided by the powering device 100. In the embodiments, as depicted in FIG. 15, the powering device 100 first operates in a “Beacon” mode where the powering device 100 does not remain the powering circuitry 106 always activated but instead just intermittently and instantaneously activates the powering circuitry 106 to “beacon” wireless power transfer (S1030). At the step S1030, the powering device 100 may provide an instantaneous wireless power transfer once in every predetermined beacon period. In the “Beacon” mode, the powering device 100 waits for a response to be received by the communication circuitry 103 from the powered device 200 (S1031). The response is designed as a responsive signal to be broadcasted by the powered device 200 through the communication circuitry 203 in response to the powered device 200 receiving the wireless power transfer. Absence of the response keeps the powering device 100 operative in the “Beacon” mode (S1031: No). In response to reception of the response through the communication circuitry 103 (S1031: Yes), the powering device 100 initiates continuous activation of the powering circuitry 106 to operate in a “Powering” mode (S1032). In the “Powering” mode, the powering device 100 remains the powering circuitry 106 active to continuously provide wireless power transfer. In the “Powering” mode, the powering device 100 continuously monitors reception of the responses through the communication circuitry 103 from the powered device 200 (S1033). A response is expected to be broadcasted by the powered device 200 every time the powered device 200 receives wireless power transfer or once in a predetermined period as long as the powered device 200 is receiving wireless power transfer. As long as the powering device 100 successfully receives the responses through the communication circuitry 103, the powering device 100 remains operation in the “Powering” mode (S1033: Yes). Upon failing to receive a predetermined number of responses (S1033: No), the powering device 100 stops continuous activation of the powering circuitry 106 to operate back in the “Beacon” mode (S1034). In the embodiments, the powered device 200 with the powered circuitry 210 deactivated in a “No Power” mode where the powered device 200 is not wirelessly charging the battery 209, continuously, periodically, or intermittently monitors the battery level of the battery 209 by, for example,

18

determining whether or not the battery level is sufficient above a first predetermined threshold while the powered circuitry 210 is not active (S2030). As long as the battery level is determined to be above the first predetermined threshold (S2030: Yes), the powered device 200 remains the powered circuitry 210 deactivated. Upon determining the battery level to be insufficient below the first predetermined threshold (S2030: No), the powered device 200 activates the powered circuitry 210 (S2031). While the powered circuitry 210 is activated, the powered device 200 determines whether or not the battery 209 is being charged by the charging circuitry 208 using power generated by the powered circuitry 210 (S2032). If the battery 209 is determined to be not being charged by the charging circuitry 208 using power generated by the powered circuitry 210 (S2032: No), the powered device 200 provides an indication showing that the powered device 200 is in a “Standby” mode where the powered device 200 is not wirelessly charging the battery 209 while the powered circuitry 210 is activated and expecting the wireless charging will soon start (S2033). If the battery 209 is determined to be being charged by the powered circuit 210 (S2032: Yes), the powered device 200 provides an indication showing that the powered device 200 is in a “Wireless Charging” mode where the powered device 200 is wirelessly charging the battery 209 using the powered circuitry 210 (S2034). In the “Wireless Charging” mode, the powered device 200 continuously, periodically, or intermittently broadcasts response, namely, responsive signals designed to be broadcasted in response to reception of wireless power transfer using the communication circuitry 203 (S2035). Also, in the “Wireless Charging” mode, the powered device 200 continuously, periodically, or intermittently monitors the battery level of the battery 209 by, for example, determining whether or not the battery level is sufficient above a second predetermined threshold (S2036). Preferably, the second predetermined threshold is set to be higher than the first predetermined threshold: For example, the first threshold may be set to be very low below the middle between the empty level and the fully-charged level, whereas the second threshold may be set to be relatively high near the fully-charged level of the battery 209. As long as the battery level of the battery 209 is determined to be below the second predetermined threshold, meaning that the battery 209 has been not yet charged sufficiently (S2036: No), the powered device 200 remains the powered circuitry 210 activated in order for the battery 209 to be charged through the powered circuitry 210. Upon determining that the battery level is above the second predetermined level as a result of the battery 209 having been charged sufficiently (S2036: Yes), the powered device 200 deactivates the powered circuitry 210 (S2037). The powered device 200 then provides an indication showing that the powered device 200 is now in a “No Power” mode where the powered device 200 is not wirelessly receiving power transfer for charging the battery 209 (S2038), and returns to the battery level determination at the step S2030. According to the steps S1030 to S1034 and the steps S2030 to S2038, the powered device 200 responds to the beacons wireless power transfer to make the powering device 100 start continuous wireless power transfer when the powered device 200 finds the battery 209 running short below the first predetermined level, whereas the powered device 200 does not make the powering device 100 start the continuous wireless power transfer even if the powered device 200 is within the range of the powering region 10 when the level of the battery 209 is sufficient. For the process 403, the powering control program 121 may have the computer program instructions



## US 10,790,703 B2

19

for the steps S1030 to S1034 while the charging control program 221 may have the computer program instructions for the steps S2030 to S2038.

FIG. 16 depicts an example of a detailed wireless power transfer process 404 according to some embodiments where wireless power transfer may be initiated in response to the powering device 100 and the powered device 200 discovering each other through a communication using the communication circuitry 103 and 203. In the embodiments, the powering device 100 operates in a “No Powering” mode where the powering device 100 does not provide wireless power transfer by remaining the powering circuitry 106 deactivated until a discovery, such as one in accordance with a discovery process as described above with reference to FIGS. 10 and 11, occurs. As depicted in FIG. 16, upon discovering the powered device 200 through the communication circuitry 103 in accordance with a discovery process (S1040), the powering device 100 initiates continuous activation of the powering circuitry 106 to operate in a “Powering” mode (S1041). In the “Powering” mode, the powering device 100 remains the powering circuitry 106 active to continuously provide wireless power transfer. In the “Powering” mode, the powering device 100 continuously, periodically, or intermittently determines whether or not the powering device 100 keeps discovering the powered device 200 (S1042). The powered device 200 is expected to be continuously discovered by the powering device 100 as long as the powered device 200 is near the powering device 100 enough for successful establishment of the communication through the communication circuitry 103 and 203. As long as the powering device 100 successfully discovers the powered device 200, the powering device 100 remains operation in the “Powering” mode (S1042: Yes). Upon failing to discover the powered device 200 (S1042: No), the powering device 100 stops continuous activation of the powering circuitry 106 to operate back in the “No Powering” mode (S1043). In the embodiments, the powered device 200, with the powered circuitry 210 deactivated, operates in a “No Power” mode where the powered device 200 is not wirelessly charging the battery 209 using the powered circuitry 210 until a discovery, such as one in accordance with a discovery process as described above with reference to FIGS. 10 and 11, occurs. As depicted in FIG. 16, upon discovering the powering device 100 through the communication circuitry 203 (S2040), the powered device 200 activates the powered circuitry 210 for reception of wireless power transfer (S2041). Upon activation of the circuitry 210, the powered device 200 provides, using the output 205, an indication showing that the powered device 200 is in a “Standby” mode where the powered device 200 is expecting that the wireless charging will start soon because the powering device 100 is sufficiently near the powered device 200 (S2042). In the “Standby” mode, the powered device 200 continuously, periodically, or intermittently determines whether or not the battery 209 is being charged by the charging circuitry 208 using power generated by the powered circuitry 210 (S2043). As long as the battery 209 is determined to be being charged by the charging circuitry 208 using power generated by the powered circuitry 210 (S2043: Yes), the powered device 200 provides, using the output 205, an indication showing that the powered device 200 is in a “Wireless Charging” mode where the powered device 200 is wirelessly charging the battery 209 using the powered circuitry 210 (S2044). If the battery 209 is determined to be not being charged by the charging circuitry 208 using power generated by the powered circuitry 210 (S2043: No), the process 404 goes to a process 500 as depicted in FIG. 17.

20

The process 500 starts by determination as to whether or not the powered device 200 is discovering the powering device 100 through the communication using the communication circuitry 203 (S2050). Upon determining that the powered device 200 is discovering the powering device 100 (S2050: Yes), the powered device 200 provides an indication showing that the powered device 200 is in the “Standby” mode where the powered device 200 is not wirelessly charging the battery 209 but expecting that the wireless charging will start soon because the powering device 100 is sufficiently near the powered device 200 (S2051), and then the process 500 returns to the process 404 at the step S2043. On the contrary, upon determining that the powered device 200 is no longer discovering the powering device 100 (S2050: No), the powered device 200 deactivates the powered circuitry 210 (S2052), and provides an indication showing that the powered device 200 is in a “No Power” mode where the powered device 200 is not wirelessly charging the battery 209 (S2053). The process 500 ends at the step S2053, and the process 404 does not proceed until the powered device 200 discovers the powering device 100 again at the step S2040. For the process 404, the powering control program 121 may have the computer program instructions for the steps S1040 to S1043 while the charging control program 221 may have the computer program instructions for the steps S2040 to S2044. For the process 500, the charging control program 221 may have the computer program instructions for the steps S2050 to S2053.

FIG. 18 depicts an example of a detailed wireless power transfer process 406 according to some embodiments where wireless power transfer may be accomplished in response to the battery level of the battery 209 running short when the powering device 100 and the powered device 200 have discovered each other through a communication using the communication circuitry 103 and 203. In the embodiments, the powering device 100 operates in a “No Powering” mode where the powering device 100 does not provide wireless power transfer by remaining the powering circuitry 106 deactivated until a discovery, such as one in accordance with a discovery process as described above with reference to FIGS. 10 and 11, occurs. As depicted in FIG. 18, upon discovering the powered device 200 through the communication circuitry 103 in accordance with a discovery process (S1060), the powering device 100 initiates continuous activation of the powering circuitry 106 to operate in a “Powering” mode (S1061). In the “Powering” mode, the powering device 100 remains the powering circuitry 106 active to continuously provide wireless power transfer. In the “Powering” mode, the powering device 100 continuously, periodically, or intermittently determines whether or not the powering device 100 keeps discovering the powered device 200 (S1062). The powered device 200 is expected to be continuously discovered by the powering device 100 as long as the powered device 200 is near the powering device 100 enough for successful establishment of the communication through the communication circuitry 103 and 203. As long as the powering device 100 successfully discovers the powered device 200, the powering device 100 remains operation in the “Powering” mode (S1062: Yes). Upon failing to discover the powered device 200 (S1062: No), the powering device 100 stops continuous activation of the powering circuitry 106 to operate back in the “No Powering” mode (S1063). In the embodiments, the powered device 200, with the powered circuitry 210 deactivated, operates in a “No Power” mode where the powered device 200 is not wirelessly charging the battery 209 using the powered circuitry 210 until a discovery, such as one in accordance

## US 10,790,703 B2

21

with a discovery process as described above with reference to FIGS. 10 and 11, occurs. As depicted in FIG. 18, upon discovering the powering device 100 through the communication circuitry 203 (S2060), the powered device 200 provides an indication, using the output 205, showing that the powered device 200 is now operating in a “Standby” mode where the powered device 200 is ready for activation of the powered circuitry 210 (S2061). In the “Standby” mode, the powered device 200 continuously, periodically, or intermittently monitors the battery level of the battery 209 by, for example, determining whether or not the battery level is sufficient above a first predetermined threshold (S2062). As long as the battery level is determined to be above the first predetermined threshold (S2062: Yes), the powered device 200 remains the powered circuitry 210 deactivated. Upon determining the battery level to be insufficient below the first predetermined threshold (S2062: No), the powered device 200 activates the powered circuitry 210 (S2063). While the powered circuitry 210 is activated, the powered device 200 continuously, periodically, or intermittently determines whether or not the battery 209 is being charged by the charging circuitry 208 using power generated by the powered circuitry 210 (S2064). As long as the battery 209 is determined to be being charged by the charging circuitry 208 using power generated by the powered circuitry 210 (S2064: Yes), the powered device 200 provides an indication, using the output 205, showing that the powered device 200 is in a “Wireless Charging” mode where the powered device 200 is wirelessly charging the battery 209 using the powered circuitry 210 (S2065). If the battery 209 is determined to be not being charged by the charging circuitry 208 using power generated by the powered circuitry 210 (S2064: No), the process 406 goes to the process 500 as discussed above with reference to FIG. 17. In the embodiments, the process 500 returns to the process 406 at the step S2064. In the embodiments, if the process 500 ends at the step S2053, the process 406 does not proceed until the powered device 200 discovers the powering device 100 again at the step S2060. In the “Wireless Charging” mode, the powered device 200 continuously, periodically, or intermittently monitors the battery level of the battery 209 by, for example, determining whether or not the battery level is sufficient above a second predetermined threshold (S2066). Preferably, the second predetermined threshold is set to be higher than the first predetermined threshold: For example, the first threshold may be set to be very low below the middle between the empty level and the fully-charged level, whereas the second threshold may be set to be relatively high near the fully-charged level of the battery 209. As long as the battery level of the battery 209 is determined to be below the second predetermined threshold, meaning that the battery 209 has been not yet charged sufficiently (S2066: No), the powered device 200 remains the powered circuitry 210 activated in order for the battery 209 to be charged through the powered circuitry 210. Upon determining that the battery level is above the second predetermined level as a result of the battery 209 having been charged sufficiently (S2066: Yes), the powered device 200 deactivates the powered circuitry 210 (S2067) to operate back in the “Standby” mode (S2061). For the process 406, the powering control program 121 may have the computer program instructions for the steps S1060 to S1063 while the charging control program 221 may have the computer program instructions for the steps S2060 to S2067.

FIG. 19 depicts an example of a detailed wireless power transfer process 407 according to some embodiments where wireless power transfer may be initiated in response to an

22

explicit request from the powered device 200 when the battery level of the battery 209 has run short. In the embodiments, the powering device 100 operates in a “No Powering” mode where the powering device 100 does not provide wireless power transfer by remaining the powering circuitry 106 deactivated until a discovery, such as one in accordance with a discovery process as described above with reference to FIGS. 10 and 11, occurs. As depicted in FIG. 19, upon discovering the powered device 200 through the communication circuitry 103 in accordance with a discovery process (S1070), the powering device 100 operates in a “Standby” mode where the powering device 100 still remains the powering circuit 106 deactivated but stands by for an explicit request for wireless power transfer from the powered device 200 (S1071). In the “Standby” mode, in response to the request for wireless power transfer from the powered device 200 through a communication using the communication circuitry 103 (S2074), the powering device 100 initiates continuous activation of the powering circuitry 106 to operate in a “Powering” mode (S1072). In the “Powering” mode, the powering device 100 remains the powering circuitry 106 active to continuously provide wireless power transfer unless an explicit request is made from the powered device 200 for termination of the wireless power transfer. In the “Powering” mode, in response to the request for the termination of the wireless power transfer from the powered device 200 through a communication using the communication circuitry 103 (S2078), the powering device 100 stops continuous activation of the powering circuitry 106 to operate back in the “Standby” mode (S1073). In the embodiments, the powered device 200, with the powered circuitry 210 deactivated, operates in a “No Power” mode where the powered device 200 is not wirelessly charging the battery 209 using the powered circuitry 210 until a discovery, such as one in accordance with a discovery process as described above with reference to FIGS. 10 and 11, occurs. As depicted in FIG. 19, upon discovering the powering device 100 through the communication circuitry 203 (S2070), the powered device 200 provides an indication, using the output 205, showing that the powered device 200 is now operating in a “Standby” mode where the powered device 200 is ready for activation of the powered circuitry 210 (S2071). In the “Standby” mode, the powered device 200 continuously, periodically, or intermittently monitors the battery level of the battery 209 by, for example, determining whether or not the battery level is sufficient above a first predetermined threshold (S2072). As long as the battery level is determined to be above the first predetermined threshold (S2072: Yes), the powered device 200 remains the powered circuitry 210 deactivated. Upon determining the battery level to be insufficient below the first predetermined threshold (S2072: No), the powered device 200 activates the powered circuitry 210 (S2073), and also sends a request for wireless power transfer to the powering device 100 over a communication using the communication circuitry 203 (S2074). After the transmission of the request, while the powered circuitry 210 is activated, the powered device 200 continuously, periodically, or intermittently determines whether or not the battery 209 is being charged by the charging circuitry 208 using power generated by the powered circuitry 210 (S2075). As long as the battery 209 is determined to be being charged by the charging circuitry 208 using power generated by the powered circuitry 210 (S2075: Yes), the powered device 200 provides an indication showing that the powered device 200 is in a “Wireless Charging” mode where the powered device 200 is wirelessly charging the battery 209 using the powered



## US 10,790,703 B2

23

circuitry 210 (S2076). If the battery 209 is determined to be not being charged by the charging circuitry 208 using power generated by the powered circuitry 210 (S2075: No), the process 407 goes to the process 500 as discussed above with reference to FIG. 17. In the embodiments, the process 500 returns to the process 407 at the step S2075. In the embodiments, if the process 500 ends at the step S2053, the process 407 does not proceed until the powered device 200 discovers the powering device 100 again at the step S2070. In the “Wireless Charging” mode, the powered device 200 continuously, periodically, or intermittently monitors the battery level of the battery 209 by, for example, determining whether or not the battery level is sufficient above a second predetermined threshold (S2077). Preferably, the second predetermined threshold is set to be higher than the first predetermined threshold: For example, the first threshold may be set to be very low below the middle between the empty level and the fully-charged level, whereas the second threshold may be set to be relatively high near the fully-charged level of the battery 209. As long as the battery level of the battery 209 is determined to be below the second predetermined threshold, meaning that the battery 209 has been not yet charged sufficiently (S2077: No), the powered device 200 remains the powered circuitry 210 activated in order for the battery 209 to be charged through the powered circuitry 210. Upon determining that the battery level is above the second predetermined level as a result of the battery 209 having been charged sufficiently (S2077: Yes), the powered device 200 sends a request for termination of the wireless power transfer to the powering device 100 over a communication using the communication circuitry 203 (S2078), and also deactivates the powered circuitry 210 (S2079) to operate back in the “Standby” mode (S2071). For the process 407, the powering control program 121 may have the computer program instructions for the steps S1070 to S1073 while the charging control program 221 may have the computer program instructions for the steps S2070 to S2079.

FIG. 20 depicts an example of a detailed wireless power transfer process 408 according to some embodiments where wireless power transfer may be initiated in response to discovery through a communication using the communication circuitry 103 and 203 which occurs only when the battery 209 has run short. In the embodiments, the powering device 100 operates in a “No Powering” mode where the powering device 100 does not provide wireless power transfer by remaining the powering circuitry 106 deactivated until a discovery, such as one in accordance with a discovery process as described above with reference to FIGS. 10 and 11, occurs. As depicted in FIG. 20, upon discovering the powered device 200 through the communication circuitry 103 in accordance with a discovery process (S1082), the powering device 100 initiates continuous activation of the powering circuitry 106 to operate in a “Powering” mode (S1083). In the “Powering” mode, the powering device 100 remains the powering circuitry 106 active to continuously provide wireless power transfer. In the “Powering” mode, the powering device 100 continuously, periodically, intermittently determines whether or not the powering device 100 keeps discovering the powered device 200 (S1084). The powered device 200 is expected to be continuously discovered by the powering device 100 as long as the powered device 200 is near the powering device 100 enough for successful establishment of the communication through the communication circuitry 103 and 203. As long as the powering device 100 successfully discovers the powered device 200, the powering device 100 remains operation in the

24

“Powering” mode (S1084: Yes). Upon failing to discover the powered device 200 (S1084: No), the powering device 100 stops continuous activation of the powering circuitry 106 to operate back in the “No Powering” mode (S1085). In the embodiments, the powered device 200 with the powered circuitry 210 and the communication circuitry 203 both deactivated in a “No Power” mode where the powered device 200 is not wirelessly charging the battery 209, continuously, periodically, or intermittently monitors the battery level of the battery 209 by, for example, determining whether or not the battery level is sufficient above a first predetermined threshold (S2080). As long as the battery level is determined to be above the first predetermined threshold (S2080: Yes), the powered device 200 remains the powered circuitry 210 and the communication circuitry 203 deactivated. Upon determining the battery level to be insufficient below the first predetermined threshold (S2080: No), the powered device 200 activates the communication circuitry 203 (S2081). As a result of the activation of the communication circuitry 203, the powered device 200 discovers the powering device 100 in accordance with a discovery process as described above with reference to FIGS. 10 and 11 (S2082). The discovery at the step S2082 accompanying with the discovery at the step S1082 function as a request for wireless power transfer and reception of the request, respectively. Accordingly, once the discovery at the steps S1082 and S2082 have occurred, wireless power transfer is expected to be initiated by the powering device 100. Upon the activation of the communication circuitry 203, the powered device 200 also, preferably substantially simultaneously, activates the powered circuitry 210 (S2083). Upon activation of the communication circuitry 203 and the powered circuitry 210, the powered device 200 provides an indication, using the output 205, showing that the powered device 200 is now operating in a “Standby” mode where the powered device 200 will soon be wirelessly charged by the powering device 100 (S2084). In the “Standby” mode, the powered device 200 continuously, periodically, or intermittently determines whether or not the battery 209 is being charged by the charging circuitry 208 using power generated by the powered circuitry 210 (S2085). As long as the battery 209 is determined to be being charged by the charging circuitry 208 using power generated by the powered circuitry 210 (S2085: Yes), the powered device 200 provides an indication, using the output 205, showing that the powered device 200 is in a “Wireless Charging” mode where the powered device 200 is wirelessly charging the battery 209 using the powered circuitry 210 (S2086). If the battery 209 is determined to be not being charged by the charging circuitry 208 using power generated by the powered circuitry 210 (S2085: No), the process 408 goes to a process 510 as depicted in FIG. 21. The process 510 starts by determination as to whether or not the powered device 200 is discovering the powering device 100 through the communication using the communication circuitry 203 (S2092). Upon determining that the powered device 200 is discovering the powering device 100 (S2092: Yes), the powered device 200 provides an indication showing that the powered device 200 is in a “Standby” mode where the powered device 200 is not wirelessly charging the battery 209 but expecting that the wireless charging will start soon (S2093), and then the process 510 returns to the process 408 at the step S2085. On the contrary, upon determining that the powered device 200 is no longer discovering the powering device 100 (S2092: No), the powered device 200 deactivates the powered circuitry 210 (S2094), and also, preferably substantially simultaneously deactivates the communication

US 10,790,703 B2

25

circuitry 203 (S2095). Upon deactivation of the powered circuitry 210 and the communication circuitry 203, the powered device 200 provides an indication showing that the powered device 200 is in a “No Power” mode where the powered device 200 is not wirelessly charging the battery 209 (S2096). The powered device 200 then starts counting a predetermined time, for example, a few seconds, several tens of seconds, or a few minutes for re-activation of the communication circuitry 203 (S2097). Upon completion of the counting of the predetermined time (S2097: Yes), the process 510 returns to the process 408 at the step S2080 for re-activation of the communication circuitry 203 depending on the battery level of the battery 209. For the process 408, the powering control program 121 may have the computer program instructions for the steps S1082 to S1085 while the charging control program 221 may have the computer program instructions for the steps S2080 to S2090. For the process 510, the charging control program 221 may have the computer program instructions for the steps S2092 to S2097.

According to preferable implementation for the processes 404 to 408 where the communication through the communication circuitry 103 and 203 is employed together with wireless power transfer through the powering circuitry 106 and the powered circuitry 210, the range of the communication through the communication circuitry 103 and 203 may be substantially as wide as or narrower to some extent than the range of the powering region 10. More particularly, according to the preferable implementation, for example, the transmission power of the communication circuitry 103 may be preset to provide the communication range that is substantially as wide as or narrower to some extent than the range of the powering region 10, or the powering device 100 controls the transmission power of the communication circuitry 103 to provide the communication range that is substantially as wide as or narrower to some extent than the range of the powering region 10 (S1044, S1064, S1074, and S1086 in FIGS. 16, 18, 19, and 20).

FIG. 22 depicts an example of a detailed wireless power transfer process 604 according to some embodiments where authority confirmation steps using the DB 122 and/or DB 222 are added to the above-mentioned process 404. In the embodiments, upon the discovery at the step S1040, the powering device 100, remaining in the “No Powering” mode with the powering circuitry 106 deactivated, checks the authority of the discovered powered device 200, namely, determines whether or not the discovered powered device 200 is authorized to be wirelessly powered by the powering device 100 with reference to the DB 122 (S1100). More particularly, if the powering device 100 finds the ID of the powered device 200 received in association with the discovery process being listed in the DB 122 as an authorized powered device, the powering device 100 determines that the discovered powered device 200 is authorized to receive wireless power transfer from the powering device 100. On the contrary, if the powering device 100 does not find the ID of the powered device 200 in the DB 122 as an authorized powered device, the powering device 100 determines that the discovered powered device 200 is not authorized to receive wireless power transfer from the powering device 100. Upon determining that the discovered powered device 200 is not authorized to receive wireless power transfer (S1100: No), the powering device 100 does not proceed to the “Powering” mode, and then the process 604 ends. Upon determining that the discovered powered device 200 is authorized to receive wireless power transfer (S1100: Yes), the process 604 proceeds to the steps S1041 to S1043. In the embodiments, at the step S1041, the powering device 100

26

initiates continuous activation of the powering circuitry 106 in the “Powering” mode in response to the affirmative determination at the step S1100. In the embodiments, upon the discovery at the step S2040, the powered device 200, remaining in the “No Power” mode with the powered circuitry 210 deactivated, checks the authority of the powered device 200 itself, namely, determines whether or not the powered device 200 is authorized to be wirelessly powered by the powering device 100 with reference to the DB 222 (S2100). More particularly, if the powered device 200 finds the ID of the powering device 100 received in association with the discovery process being listed in the DB 222 as a connectable power source, the powered device 200 determines that the powered device 200 is authorized to receive wireless power transfer from the discovered powering device 100. On the contrary, if the powered device 200 does not find the ID of the discovered powering device 100 in the DB 222 as a connectable power source, the powered device 200 determines that the powered device 200 is not authorized to receive wireless power transfer from the discovered powering device 100. Upon determining that the powered device 200 is authorized to receive wireless power transfer (S2100: Yes), the process 604 proceeds to the steps S2041 to S2043. In the embodiments, at the step S2041, the powered device 200 activates the powered circuitry 210 to operate in the “Wireless Charging” mode in response to the affirmative determination at the step S2100. On the contrary, upon determining that the powered device 200 is not authorized to receive wireless power transfer (S2100: No), the powered device 200 deactivates the communication circuitry 203 in order to prevent the discovery at the step S2040 from occurring for a predetermined time (S2101). The powered device 200 starts counting the predetermined time (S2102), and re-activates the communication circuitry 203 upon lapse of the predetermined time (S2103). For the process 604, the powering control program 121 may have the computer program instructions for the step S1100 while the charging control program 221 may have the computer program instructions for the steps S2100 to S2103. In the embodiments, the process 604 may include either one of the authority confirmation steps S1100 at the powering device 100 and the authority confirmation steps S2100 to S2103 at the powered device 200, or may include both.

FIG. 23 depicts an example of a detailed wireless power transfer process 606 according to some embodiments where authority confirmation steps using the DB 122 and/or DB 222 are added to the above-mentioned process 406. In the embodiments, upon the discovery at the step S1060, the powering device 100, remaining in the “No Powering” mode with the powering circuitry 106 deactivated, checks the authority of the discovered powered device 200, namely, determines whether or not the discovered powered device 200 is authorized to be wirelessly powered by the powering device 100 with reference to the DB 122 (S1200). More particularly, if the powering device 100 finds the ID of the powered device 200 received in association with the discovery process being listed in the DB 122 as an authorized powered device, the powering device 100 determines that the discovered powered device 200 is authorized to receive wireless power transfer from the powering device 100. On the contrary, if the powering device 100 does not find the ID of the powered device 200 in the DB 122 as an authorized powered device, the powering device 100 determines that the discovered powered device 200 is not authorized to receive wireless power transfer from the powering device 100. Upon determining that the discovered powered device 200 is not authorized to receive wireless power transfer

US 10,790,703 B2

27

(S1200: No), the powering device 100 does not proceed to the “Powering” mode, and the then the process 606 ends. Upon determining that the discovered powered device 200 is authorized to receive wireless power transfer (S1200: Yes), the process 606 proceeds to the steps S1061 to S1063. In the embodiments, at the step S1061, the powering device 100 initiates continuous activation of the powering circuitry 106 in the “Powering” mode in response to the affirmative determination at the step S1200. In the embodiments, upon the discovery at the step S2060, the powered device 200, remaining in the “No Power” mode with the powered circuitry 210 deactivated, checks the authority of the powered device 200 itself, namely, determines whether or not the powered device 200 is authorized to be wirelessly powered by the powering device 100 with reference to the DB 222 (S2200). More particularly, if the powered device 200 finds the ID of the discovered powering device 100 received in association with the discovery process being listed in the DB 222 as a connectable power source, the powered device 200 determines that the powered device 200 is authorized to receive wireless power transfer from the discovered powering device 100. On the contrary, if the powered device 200 does not find the ID of the discovered powering device 100 in the DB 222 as a connectable power source, the powered device 200 determines that the powered device 200 is not authorized to receive wireless power transfer from the discovered powering device 100. Upon determining that the powered device 200 is authorized to receive wireless power transfer (S2200: Yes), the process 606 proceeds to the steps S2061 to S2067. In the embodiments, at the step S2061, the powered device 200 starts operating in the “Standby” mode in response to the affirmative determination at the step S2200. On the contrary, upon determining that the powered device 200 is not authorized to receive wireless power transfer (S2200: No), the powered device 200 deactivates the communication circuitry 203 in order to prevent the discovery at the step S2060 from occurring for a predetermined time (S2201). The powered device 200 starts counting the predetermined time (S2202), and re-activates the communication circuitry 203 upon lapse of the predetermined time (S2203). For the process 606, the powering control program 121 may have the computer program instructions for the step S1200 while the charging control program 221 may have the computer program instructions for the steps S2200 to S2203. In the embodiments, the process 606 may include either one of the authority confirmation steps S1200 at the powering device 100 and the authority confirmation steps S2200 to S2203 at the powered device 200, or may include both.

FIG. 24 depicts an example of a detailed wireless power transfer process 607 according to some embodiments where authority confirmation steps using the DB 122 and/or DB 222 are added to the above-mentioned process 407. In the embodiments, in the “Standby” mode after the step S1070, in response to the request at the step S2074, the powering device 100, remaining in the “Standby” mode with the powering circuitry 106 deactivated, checks the authority of the discovered powered device 200, namely, determines whether or not the discovered powered device 200 is authorized to be wirelessly powered by the powering device 100 with reference to the DB 122 (S1300). More particularly, if the powering device 100 finds the ID of the powered device 200 received in association with the discovery process being listed in the DB 122 as an authorized powered device, the powering device 100 determines that the discovered powered device 200 is authorized to receive wireless power transfer from the powering device 100. On the contrary, if the powering device 100 does not find the ID of the powered

28

device 200 in the DB 122 as an authorized powered device, the powering device 100 determines that the discovered powered device 200 is not authorized to receive wireless power transfer from the powering device 100. Upon determining that the discovered powered device 200 is not authorized to receive wireless power transfer (S1300: No), the powering device 100 does not proceed to the “Powering” mode, and the then the process 607 ends. Upon determining that the discovered powered device 200 is authorized to receive wireless power transfer (S1300: Yes), the process 607 proceeds to the steps S1072 to S1073. In the embodiments, at the step S1072, the powering device 100 initiates continuous activation of the powering circuitry 106 in the “Powering” mode in response to the affirmative determination at the step S1300. In the embodiments, upon the discovery at the step S2070, the powered device 200, remaining in the “No Power” mode with the powered circuitry 210 deactivated, checks the authority of the powered device 200 itself, namely, determines whether or not the powered device 200 is authorized to be wirelessly powered by the powering device 100 with reference to the DB 222 (S2300). More particularly, if the powered device 200 finds the ID of the powering device 100 received in association with the discovery process being listed in the DB 222 as a connectable power source, the powered device 200 determines that the powered device 200 is authorized to receive wireless power transfer from the discovered powering device 100. On the contrary, if the powered device 200 does not find the ID of the discovered powering device 100 in the DB 222 as a connectable power source, the powered device 200 determines that the powered device 200 is not authorized to receive wireless power transfer from the discovered powering device 100. Upon determining that the powered device 200 is authorized to receive wireless power transfer (S2300: Yes), the process 607 proceeds to the steps S2071 to S2079. In the embodiments, at the step S2071, the powered device 200 activates the powered circuitry 210 to operate in the “Wireless Charging” mode in response to the affirmative determination at the step S2300. On the contrary, upon determining that the powered device 200 is not authorized to receive wireless power transfer (S2300: No), the powered device 200 deactivates the communication circuitry 203 in order to prevent the discovery at the step S2070 from occurring for a predetermined time (S2301). The powered device 200 starts counting the predetermined time (S2302), and re-activates the communication circuitry 203 upon lapse of the predetermined time (S2303). For the process 607, the powering control program 121 may have the computer program instructions for the step S1300 while the charging control program 221 may have the computer program instructions for the steps S2300 to S2303. In the embodiments, the process 607 may include either one of the authority confirmation steps S1300 at the powering device 100 and the authority confirmation steps S2300 to S2303 at the powered device 200, or may include both.

FIG. 25 depicts an example of a detailed wireless power transfer process 608 according to some embodiments where authority confirmation steps using the DB 122 and/or DB 222 are added to the above-mentioned process 408. In the embodiments, in the “No Powering” mode, upon the discovery at the step S1082, the powering device 100, remaining in the “No Powering” mode with the powering circuitry 106 deactivated, checks the authority of the discovered powered device 200, namely, determines whether or not the discovered powered device 200 is authorized to be wirelessly powered by the powering device 100 with reference to the DB 122 (S1400). More particularly, if the powering



US 10,790,703 B2

29

device 100 finds the ID of the powered device 200 received in association with the discovery process being listed in the DB 122 as an authorized powered device, the powering device 100 determines that the discovered powered device 200 is authorized to receive wireless power transfer from the powering device 100. On the contrary, if the powering device 100 does not find the ID of the powered device 200 in the DB 122 as an authorized powered device, the powering device 100 determines that the discovered powered device 200 is not authorized to receive wireless power transfer from the powering device 100. Upon determining that the discovered powered device 200 is not authorized to receive wireless power transfer (S1400: No), the powering device 100 does not proceed to the “Powering” mode, and then the process 608 ends. Upon determining that the discovered powered device 200 is authorized to receive wireless power transfer (S1400: Yes), the process 608 proceeds to the steps S1083 to S1085. In the embodiments, at the step S1083, the powering device 100 initiates continuous activation of the powering circuitry 106 in the “Powering” mode in response to the affirmative determination at the step S1400. In the embodiments, upon the discovery at the step S2082 when the communication circuitry 203 is activated in accordance with the steps S2080 to S2081, the powered device 200, remaining in the “No Power” mode with the powered circuitry 210 deactivated, checks the authority of the powered device 200 itself, namely, determines whether or not the powered device 200 is authorized to be wirelessly powered by the powering device 100 with reference to the DB 222 (S2400). More particularly, if the powered device 200 finds the ID of the powering device 100 received in association with the discovery process being listed in the DB 222 as a connectable power source, the powered device 200 determines that the powered device 200 is authorized to receive wireless power transfer from the discovered powering device 100. On the contrary, if the powered device 200 does not find the ID of the discovered powering device 100 in the DB 222 as a connectable power source, the powered device 200 determines that the powered device 200 is not authorized to receive wireless power transfer from the discovered powering device 100. Upon determining that the powered device 200 is authorized to receive wireless power transfer (S2400: Yes), the process 608 proceeds to the steps S2083 to S2090. In the embodiments, at the step S2083, the powered device 200 activates the powered circuitry 210 in response to the affirmative determination at the step S2400. On the contrary, upon determining that the powered device 200 is not authorized to receive wireless power transfer (S2400: No), the powered device 200 deactivates the communication circuitry 203 in order to prevent the discovery at the step S2082 from occurring for a predetermined time (S2401). The powered device 200 starts counting the predetermined time (S2402), and returns to the step S2080. For the process 608, the powering control program 121 may have the computer program instructions for the step S1400 while the charging control program 221 may have the computer program instructions for the steps S2400 to S2402. In the embodiments, the process 608 may include either one of the authority confirmation steps S1400 at the powering device 100 and the authority confirmation steps S2400 to S2402 at the powered device 200, or may include both.

FIG. 26 depicts an example of a detailed wireless power transfer process 704 according to some embodiments where authority confirmation steps and status management steps using the DB 122 and DB 222 are added to the above-mentioned process 404. In the embodiments, upon the discovery at the step S1040, the powering device 100,

30

remaining in the “No Powering” mode with the powering circuitry 106 deactivated, checks the authority of the discovered powered device 200, namely, determines whether or not the discovered powered device 200 is authorized to be wirelessly powered by the powering device 100 with reference to the DB 122 (S1500). More particularly, if the powering device 100 finds the ID of the powered device 200 received in association with the discovery process being listed in the DB 122 as an authorized powered device, the powering device 100 determines that the discovered powered device 200 is authorized to receive wireless power transfer from the powering device 100. On the contrary, if the powering device 100 does not find the ID of the powered device 200 in the DB 122 as an authorized powered device, the powering device 100 determines that the discovered powered device 200 is not authorized to receive wireless power transfer from the powering device 100. Upon determining that the discovered powered device 200 is not authorized to receive wireless power transfer (S1500: No), the powering device 100 does not proceed to the “Powering” mode, and then the process 704 ends. Upon determining that the discovered powered device 200 is authorized to receive wireless power transfer (S1500: Yes), the powering device 100 sends to the powered device 200 through the communication using the communication circuitry 103 a positive acknowledgement indicating that the powered device 200 is authorized to receive wireless power transfer from the powering device 100 (S1501). In parallel to the transmission of the positive acknowledgement, the powering device 100 also expects reception of the same kind of positive acknowledgement from the powered device 200, namely, the acknowledgement (S2501) indicating that the powered device 200 is authorized to receive wireless power transfer from the powering device 100. Upon receiving the positive acknowledgement along with the ID of the powered device 200 from the powered device 200 through the communication using the communication circuitry 103 (S1502: Yes), the powering device 100 enters the positive communication status, for example “Yes” as illustrated in the column 122a in FIG. 9, for the ID of the powered device 200 in the DB 122 (S1503). If the powering device 100 fails to receive the positive communication acknowledgement from the powered device 200 within a predetermined time (S1502: No), the powering device 100 does not proceed to the “Powering” mode, and then the process 704 ends. The step S1503 results in the DB 122 indicating that the powering device 100 is in communication with the powered device 200 through the communication using the communication circuitry 103. Upon the entrance at the step S1503, the powering device 100 determines whether or not the powering circuitry 106 is already active for wireless power transfer (S1504). The powering circuitry 106 is expected to be already active if the powering device 100 has discovered at least one other powered device and already started activation of the powering circuitry 106 for wirelessly powering the other powered device for which the positive communication status has been entered in the DB 122. If the powering circuitry 106 is already activated (S1504: Yes), the powering device 100 remains the powering circuitry 106 activated. Upon determining that the powering circuitry 106 deactivated (S1504: No), the powering device 100 starts activation of the powering circuitry 106 (S1505). During the wireless power transfer, the powering device 100 expects reception of status information indicative of any one operation status of the powered device 200 from the powered device 200. Upon receiving status information (S2503) indicative of a “Standby” mode from the powered device 200 through the

## US 10,790,703 B2

31

communication using the communication circuitry 106, the powering device 100 enters the “Standby” status as the operational status for the ID of the powered device 200, for example as illustrated in the column 122*b* in FIG. 9, in the DB 122 (S1506). While managing the ID of the powered device 200 in the “Standby” status, upon receiving status information (S2504) indicative of a “Wireless Charging” status from the powered device 200 through the communication using the communication circuitry 106, the powering device 100 enters the “Wireless Charging” status as the operational status for the ID of the powered device 200, for example as illustrated in the column 122*b* in FIG. 9 (S1507). In the embodiments, while managing the ID of the powered device 200 in the positive communication status after the step S1503, the powering device 100 performs a process 710 depicted in FIG. 27 for monitoring the communication with the powered device 200 in parallel to the process 704. As depicted in FIG. 27, the powering device 100 continuously, periodically, or intermittently determines whether or not the powering device 100 keeps discovering the powered device 200 (S1600). The powered device 200 is expected to be continuously discovered by the powering device 100 as long as the powered device 200 is near the powering device 100 enough for successful establishment of the communication through the communication circuitry 103 and 203. Upon failing to discover the powered device 200 (S1600: No), the powering device 100 enters a negative communication status, for example “No” as illustrated in the column 122*a* in FIG. 9, for the ID of the powered device 200 in the DB 122 (S1601). The step S1601 updates the communication status from the status where the powered device 200 is in communication with the powering device 100 into the status where the powered device 200 is no longer in communication with the powering device 100. The powering device 100 then determines, with reference to the DB 122, whether or not at least one other powered device has the positive communication status, namely, whether or not the powering device 100 is in communication with at least one other powered device 200 through the communication using the communication circuitry 103 (S1602). If no other powered device has the positive communication status, namely, the powering device 100 is not in communication with any other powered device 200 (S1602: No), the powering device 100 deactivates the powering circuitry 106 to stop wireless power transfer (S1603). If at least one other powered device has the positive communication status, namely, the powering device 100 is in communication with at least one other powered device 200 (S1602: Yes), the powering device 100 remains activation of the powering circuitry 106. This is because said at least one other powered device in communication with the powering device 100 is very likely to be receiving wireless power transfer from the powering device 100, and so the wireless power transfer would be interrupted if the powering device 100 stopped the powering circuitry 106. In the embodiments, as depicted in FIG. 26, upon the discovery at the step S2040, the powered device 200, remaining in the “No Power” mode with the powered circuitry 210 deactivated, checks the authority of the powered device 200 itself, namely, determines whether or not the powered device 200 is authorized to be wirelessly powered by the powering device 100 with reference to the DB 222 (S2500). More particularly, if the powered device 200 finds the ID of the powering device 100 received in association with the discovery process being listed in the DB 222 as a connectable power source, the powered device 200 determines that the powered device 200 is authorized to receive wireless power transfer from the discovered powering

32

device 100. On the contrary, if the powered device 200 does not find the ID of the discovered powering device 100 in the DB 222 as a connectable power source, the powered device 200 determines that the powered device 200 is not authorized to receive wireless power transfer from the discovered powering device 100. Upon determining that the powered device 200 is not authorized to receive wireless power transfer (S2500: No), the powering device 100 does not proceed to the “Powering” mode, and then the powered device 200 remains the communication circuitry 203 deactivated for a predetermined time in accordance with the steps S2101 to S2103. Upon determining that the powered device 200 is authorized to receive wireless power transfer (S2500: Yes), the powered device 200 sends to the powering device 100 through the communication using the communication circuitry 203 a positive acknowledgement indicating that the powered device 200 is authorized to receive wireless power transfer from the powering device 100 (S2501). In parallel to the transmission of the positive acknowledgement, the powered device 200 also expects reception of the same kind of positive acknowledgement from the powering device 100, namely, the acknowledgement indicating that the powered device 200 is authorized to receive wireless power transfer from the powering device 100. Upon receiving the positive acknowledgement along with the ID of the powering device 100 from the powering device 100 through the communication using the communication circuitry 203 (S2502: Yes), the powered device 200 starts operation in the “Standby” mode and/or the “Wireless Powering” mode in accordance with the steps S2041 to S2044 and S2050 to S2053. In the course of performance of the steps S2041 to S2044 and S2050 to S2053, upon starting operation in the “Standby” mode in accordance with the step S2042 or S2051, the powered device 200 sends to the powering device 100 status information indicative of the “Standby” mode in which the powered device 200 is in operation through the communication using the communication circuitry 203 (S2503). Similarly, upon starting operation in the “Wireless Charging” mode in accordance with the step S2044, the powered device 200 sends to the powering device 100 status information indicative of the “Wireless Charging” mode in which the powered device 200 is in operation through the communication using the communication circuitry 203 (S2504). In the embodiments, for the process 704, the powering control program 121 may have the computer program instructions for the steps S1500 to S1507 while the charging control program 221 may have the computer program instructions for the steps S2500 to S2504. For the process 710, the powering control program 121 may have the computer program instructions for the steps S1600 to S1603.

FIG. 28 depicts an example of a detailed wireless power transfer process 706 according to some embodiments where authority confirmation steps and status management steps using the DB 122 and DB 222 are added to the above-mentioned process 406. In the embodiments, upon the discovery at the step S1060, the powering device 100, remaining in the “No Powering” mode with the powering circuitry 106 deactivated, checks the authority of the discovered powered device 200, namely, determines whether or not the discovered powered device 200 is authorized to be wirelessly powered by the powering device 100 with reference to the DB 122 (S1700). More particularly, if the powering device 100 finds the ID of the powered device 200 received in association with the discovery process being listed in the DB 122 as an authorized powered device, the powering device 100 determines that the discovered powered device 200 is authorized to receive wireless power

## US 10,790,703 B2

33

transfer from the powering device 100. On the contrary, if the powering device 100 does not find the ID of the powered device 200 in the DB 122 as an authorized powered device, the powering device 100 determines that the discovered powered device 200 is not authorized to receive wireless power transfer from the powering device 100. Upon determining that the discovered powered device 200 is not authorized to receive wireless power transfer (S1700: No), the powering device 100 does not proceed to the “Powering” mode, and then the process 706 ends. Upon determining that the discovered powered device 200 is authorized to receive wireless power transfer (S1700: Yes), the powering device 100 sends to the powered device 200 through the communication using the communication circuitry 103 a positive acknowledgement indicating that the powered device 200 is authorized to receive wireless power transfer from the powering device 100 (S1701). In parallel to the transmission of the positive acknowledgement, the powering device 100 also expects reception of the same kind of positive acknowledgement from the powered device 200, namely, the acknowledgement (S2701) indicating that the powered device 200 is authorized to receive wireless power transfer from the powering device 100. Upon receiving the positive acknowledgement (S2701) along with the ID of the powered device 200 from the powered device 200 through the communication using the communication circuitry 103 (S1702: Yes), the powering device 100 enters the positive communication status, for example “Yes” as illustrated in the column 122a in FIG. 9, for the ID of the powered device 200 in the DB 122 (S1703). If the powering device 100 fails to receive the positive communication acknowledgement from the powered device 200 within a predetermined time (S1702: No), the powering device 100 does not proceed to the “Powering” mode, and then the process 706 ends. The step S1703 results in the DB 122 indicating that the powering device 100 is in communication with the powered device 200 through the communication using the communication circuitry 103. While managing the ID of the powered device 200 in the positive communication status, the powering device 100 waits for reception of information indicative of any status of the powered device 200 from the powered device 200. Upon receiving the status information (S2703) indicative of the “Standby” mode from the powered device 200 through the communication using the communication circuitry 103, the powering device 100 enters the “Standby” status as the operational status for the ID of the powered device 200, for example as illustrated in the column 122b in FIG. 9, in the DB 122 (S1704). Upon entrance of the “Standby” status at the step S1704, the powering device 100 determines whether or not the powering circuitry 106 is already active for wireless power transfer (S1705). The powering circuitry 106 is expected to be already active if the powering device 100 has discovered at least one other powered device and already started activation of the powering circuitry 106 for wirelessly powering the other powered device for which the positive communication status has been entered in the DB 122. If the powering circuitry 106 is already activated (S1705: Yes), the powering device 100 remains the powering circuitry 106 activated. Upon determining that the powering circuitry 106 deactivated (S1705: No), the powering device 100 starts activation of the powering circuitry 106 (S1706). During the wireless power transfer with the ID of the powered device 200 being managed in the “Standby” mode in the DB 122, the powering device 100 waits for reception of updated status information indicative of the status of the powered device 200 from the powered device 200. Upon receiving status

34

information (S2704) indicative of a “Wireless Charging” mode from the powered device 200 through the communication using the communication circuitry 106, the powering device 100 enters the “Wireless Charging” status as the operational status for the ID of the powered device 200, for example as illustrated in the column 122b in FIG. 9 (S1707). In the embodiments, while managing the ID of the powered device 200 in the positive communication status after the step S1703, the powering device 100 performs the process 710 depicted in FIG. 27 for monitoring the communication with the powered device 200 in parallel to the process 706. In the embodiments, as depicted in FIG. 28, upon the discovery at the step S2060, the powered device 200, remaining in the “No Power” mode with the powered circuitry 210 deactivated, checks the authority of the powered device 200 itself, namely, determines whether or not the powered device 200 is authorized to be wirelessly powered by the powering device 100 with reference to the DB 222 (S2700). More particularly, if the powered device 200 finds the ID of the powering device 100 received in association with the discovery process being listed in the DB 222 as a connectable power source, the powered device 200 determines that the powered device 200 is authorized to receive wireless power transfer from the discovered powering device 100. On the contrary, if the powered device 200 does not find the ID of the discovered powering device 100 in the DB 222 as a connectable power source, the powered device 200 determines that the powered device 200 is not authorized to receive wireless power transfer from the discovered powering device 100. Upon determining that the powered device 200 is not authorized to receive wireless power transfer (S2700: No), the powering device 100 does not proceed to the “Powering” mode, and then the powered device 200 remains the communication circuitry 203 deactivated for a predetermined time in accordance with the steps S2201 to S2203. Upon determining that the powered device 200 is authorized to receive wireless power transfer (S2700: Yes), the powered device 200 sends to the powering device 100 through the communication using the communication circuitry 203 a positive acknowledgement indicating that the powered device 200 is authorized to receive wireless power transfer from the powering device 100 (S2701). In parallel to the transmission of the positive acknowledgement, the powered device 200 also expects reception of the same kind of positive acknowledgement from the powering device 100, namely, the acknowledgement indicating that the powered device 200 is authorized to receive wireless power transfer from the powering device 100. Upon receiving the positive acknowledgement along with the ID of the powering device 100 from the powering device 100 through the communication using the communication circuitry 203 (S2702: Yes), the powered device 200 starts operation in the “Standby” mode and/or the “Wireless Charging” mode in accordance with the step S2061 to S2067 and S2050 to S2053. In the course of performance of the steps S2061 to S2067 and S2050 to S2053, upon starting operation in the “Standby” mode in accordance with the step S2061 or S2051, the powered device 200 sends to the powering device 100 status information indicative of the “Standby” mode in which the powered device 200 is in operation through the communication using the communication circuitry 203 (S2703). Similarly, upon starting operation in the “Wireless Charging” mode in accordance with the S2065, the powered device 200 sends to the powering device 100 status information indicative of the “Wireless Charging” mode in which the powered device 200 is in operation through the communication using the communication circuitry 203 (S2704).



US 10,790,703 B2

35

In the embodiments, for the process 706, the powering control program 121 may have the computer program instructions for the steps S1700 to S1707 while the charging control program 221 may have the computer program instructions for the steps S2700 to S2704.

FIG. 29 depicts an example of a detailed wireless power transfer process 707 according to some embodiments where authority confirmation steps and status management steps using the DB 122 and DB 222 are added to the above-mentioned process 407. In the embodiments, upon the discovery at the step S1070, the powering device 100, remaining in the “No Powering” mode with the powering circuitry 106 deactivated, checks the authority of the discovered powered device 200, namely, determines whether or not the discovered powered device 200 is authorized to be wirelessly powered by the powering device 100 with reference to the DB 122 (S1800). More particularly, if the powering device 100 finds the ID of the powered device 200 received in association with the discovery process being listed in the DB 122 as an authorized powered device, the powering device 100 determines that the discovered powered device 200 is authorized to receive wireless power transfer from the powering device 100. On the contrary, if the powering device 100 does not find the ID of the powered device 200 in the DB 122 as an authorized powered device, the powering device 100 determines that the discovered powered device 200 is not authorized to receive wireless power transfer from the powering device 100. Upon determining that the discovered powered device 200 is not authorized to receive wireless power transfer (S1800: No), the powering device 100 does not proceed to the “Powering” mode, and then the process 707 ends. Upon determining that the discovered powered device 200 is authorized to receive wireless power transfer (S1800: Yes), the powering device 100 sends to the powered device 200 through the communication using the communication circuitry 103 a positive acknowledgement indicating that the powered device 200 is authorized to receive wireless power transfer from the powering device 100 (S1801). In parallel to the transmission of the positive acknowledgement, the powering device 100 also expects reception of the same kind of positive acknowledgement from the powered device 200, namely, the acknowledgement (S2801) indicating that the powered device 200 is authorized to receive wireless power transfer from the powering device 100. Upon receiving the positive acknowledgement (S2801) along with the ID of the powered device 200 from the powered device 200 through the communication using the communication circuitry 103 (S1802: Yes), the powering device 100 enters the positive communication status, for example “Yes” as illustrated in the column 122a in FIG. 9, for the ID of the powered device 200 in the DB 122 (S1803). If the powering device 100 fails to receive the positive communication acknowledgement from the powered device 200 within a predetermined time (S1802: No), the powering device 100 does not proceed to the “Powering” mode, and then the process 707 ends. The step S1803 results in the DB 122 indicating that the powering device 100 is in communication with the powered device 200 through the communication using the communication circuitry 103. While managing the ID of the powered device 200 in the positive communication status, the powering device 100 waits for reception of information indicative of any status of the powered device 200 from the powered device 200. Upon receiving the status information (S2803) indicative of the “Standby” mode from the powered device 200 through the communication using the communication circuitry 103, the powering device 100 enters the

36

“Standby” status as the operational status for the ID of the powered device 200, for example as illustrated in the column 122b in FIG. 9, in the DB 122 (S1804). While managing the ID of the powered device 200 in the positive communication status in the DB 122, the powering device 100 waits for reception of the request (S2074) for wireless power transfer from the powered device 200. Upon receiving the request (S2074) from the powered device 200 through the communication using the communication circuitry 103, the powering device 100 determines whether or not the powering circuitry 106 is already active for wireless power transfer (S1805). The powering circuitry 106 is expected to be already active if the powering device 100 has discovered at least one other powered device and already started activation of the powering circuitry 106 for wirelessly powering the other powered device for which the positive communication status has been entered in the DB 122. If the powering circuitry 106 is already activated (S1805: Yes), the powering device 100 remains the powering circuitry 106 activated. Upon determining that the powering circuitry 106 deactivated (S1805: No), the powering device 100 starts activation of the powering circuitry 106 (S1806). During the wireless power transfer with the ID of the powered device 200 being managed in the “Standby” mode in the DB 122, the powering device 100 waits for reception of updated status information indicative of the status of the powered device 200 from the powered device 200. Upon receiving status information (S2804) indicative of the “Wireless Charging” mode from the powered device 200 through the communication using the communication circuitry 103, the powering device 100 enters the “Wireless Charging” status as the operational status for the ID of the powered device 200, for example as illustrated in the column 122b in FIG. 9 (S1807). While managing the ID of the powered device 200 in the “Wireless Charging” mode in the DB 122, upon receiving the request (S2078) for termination of the wireless power transfer, the powering device 100 enters the “Standby” mode as the operational status, for example as illustrated in the column 122b in FIG. 9, in the DB 122 (S1808). The entrance at the step S1808 results in the operational status of the powered device 200 being changed from the “Wireless Charging” mode back into the “Standby” mode. Upon the entrance of the operational status at the step S1808, the powering device 100 determines whether or not the powering device 100 manages the ID of at least one other powered device in the positive communication status, namely, whether or not the powering device 100 is in communication with at least one other powered device for wireless power transfer (S1809). If the powering device 100 is in communication with at least one other powered device for wireless power transfer (S1809: Yes), the powering device 100 remains the powering circuitry 106 activated because, otherwise, the wireless power transfer for said at least one other powered device would be interrupted. On the contrary, if the powering device 100 is not in communication with any other powered device (S1809: No), the powering device 100 deactivates the powering circuitry 106 to terminate the wireless power transfer (S1810). Also, in the embodiments, while managing the ID of the powered device 200 in the positive communication status after the step S1803, the powering device 100 performs the process 710 depicted in FIG. 27 for monitoring the communication with the powered device 200 in parallel to the process 707. In the embodiments, as depicted in FIG. 29, upon the discovery at the step S2070, the powered device 200, remaining in the “No Power” mode with the powered circuitry 210 deactivated, checks the authority of the powered device 200 itself,

US 10,790,703 B2

37

namely, determines whether or not the powered device 200 is authorized to be wirelessly powered by the powering device 100 with reference to the DB 222 (S2800). More particularly, if the powered device 200 finds the ID of the powering device 100 received in association with the discovery process being listed in the DB 222 as a connectable power source, the powered device 200 determines that the powered device 200 is authorized to receive wireless power transfer from the discovered powering device 100. On the contrary, if the powered device 200 does not find the ID of the discovered powering device 100 in the DB 122 as a connectable power source, the powered device 200 determines that the powered device 200 is not authorized to receive wireless power transfer from the discovered powering device 100. Upon determining that the powered device 200 is not authorized to receive wireless power transfer (S2800: No), the powering device 100 does not proceed to the “Powering” mode, and then the powered device 200 remains the communication circuitry 203 deactivated for a predetermined time in accordance with the steps S2301 to S2303. Upon determining that the powered device 200 is authorized to receive wireless power transfer (S2800: Yes), the powered device 200 sends to the powering device 100 through the communication using the communication circuitry 203 a positive acknowledgement indicating that the powered device 200 is authorized to receive wireless power transfer from the powering device 100 (S2801). In parallel to the transmission of the positive acknowledgement, the powered device 200 also expects reception of the same kind of positive acknowledgement from the powering device 100, namely, the acknowledgement (S1801) indicating that the powered device 200 is authorized to receive wireless power transfer from the powering device 100. Upon receiving the positive acknowledgement along with the ID of the powering device 100 from the powering device 100 through the communication using the communication circuitry 203 (S2802: Yes), the powered device 200 starts operation in the “Standby” mode and/or the “Wireless Charging” mode in accordance with the steps S2071 to S2079 and S2050 to S2053. In the course of performance of the steps S2071 to S2079 and S2050 to S2053, upon starting operation in the “Standby” mode in accordance with the step S2071 or S2051, the powered device 200 sends to the powering device 100 status information indicative of the “Standby” mode in which the powered device 200 is in operation through the communication using the communication circuitry 203 (S2803). Similarly, upon starting operation in the “Wireless Charging” mode in accordance with the step S2076, the powered device 200 sends to the powering device 100 status information indicative of the “Wireless Charging” mode in which the powered device 200 is in operation through the communication using the communication circuitry 203 (S2804). In the embodiments, for the process 707, the powering control program 121 may have the computer program instructions for the steps S1800 to S1810 while the charging control program 221 may have the computer program instructions for the steps S2800 to S2804.

FIG. 30 depicts an example of a detailed wireless power transfer process 708 according to some embodiments where authority confirmation steps and status management steps using the DB 122 and DB 222 are added to the above-mentioned process 408. In the embodiments, upon the discovery at the step S1080, the powering device 100, remaining in the “No Powering” mode with the powering circuitry 106 deactivated, checks the authority of the discovered powered device 200, namely, determines whether or not the discovered powered device 200 is authorized to be

38

wirelessly powered by the powering device 100 with reference to the DB 122 (S1900). More particularly, if the powering device 100 finds the ID of the powered device 200 received in association with the discovery process being listed in the DB 122 as an authorized powered device, the powering device 100 determines that the discovered powered device 200 is authorized to receive wireless power transfer from the powering device 100. On the contrary, if the powering device 100 does not find the ID of the powered device 200 in the DB 122 as an authorized powered device, the powering device 100 determines that the discovered powered device 200 is not authorized to receive wireless power transfer from the powering device 100. Upon determining that the discovered powered device 200 is not authorized to receive wireless power transfer (S1900: No), the powering device 100 does not proceed to the “Powering” mode, and then the process 708 ends. Upon determining that the discovered powered device 200 is authorized to receive wireless power transfer (S1900: Yes), the powering device 100 sends to the powered device 200 through the communication using the communication circuitry 103 a positive acknowledgement indicating that the powered device 200 is authorized to receive wireless power transfer from the powering device 100 (S1901). In parallel to the transmission of the positive acknowledgement, the powering device 100 also expects reception of the same kind of positive acknowledgement from the powered device 200, namely, the acknowledgement (S2901) indicating that the powered device 200 is authorized to receive wireless power transfer from the powering device 100. Upon receiving the positive acknowledgement (S2901) along with the ID of the powered device 200 from the powered device 200 through the communication using the communication circuitry 103 (S1902: Yes), the powering device 100 enters the positive communication status, for example “Yes” as illustrated in the column 122a in FIG. 9, for the ID of the powered device 200 in the DB 122 (S1903). If the powering device 100 fails to receive the positive communication acknowledgement from the powered device 200 within a predetermined time (S1902: No), the powering device 100 does not proceed to the “Powering” mode, and then the process 708 ends. The step S1903 results in the DB 122 indicating that the powering device 100 is in communication with the powered device 200 through the communication using the communication circuitry 103. Upon entrance of the communication status at the step S1903, the powering device 100 determines whether or not the powering circuitry 106 is already active for wireless power transfer (S1904). The powering circuitry 106 is expected to be already active if the powering device 100 has discovered at least one other powered device and already started activation of the powering circuitry 106 for wirelessly powering the other powered device for which the positive communication status has been entered in the DB 122. If the powering circuitry 106 is already activated (S1904: Yes), the powering device 100 remains the powering circuitry 106 activated. Upon determining that the powering circuitry 106 deactivated (S1904: No), the powering device 100 starts activation of the powering circuitry 106 (S1905). During the wireless power transfer, the powering device 100 expects reception of status information indicative of any one operation status of the powered device 200 from the powered device 200. Upon receiving status information (S2903) indicative of a “Standby” mode from the powered device 200 through the communication using the communication circuitry 106, the powering device 100 enters the “Standby” status as the operational status for the ID of the powered device 200, for example as illustrated in the column



## US 10,790,703 B2

39

122b in FIG. 9, in the DB 122 (S1906). While managing the ID of the powered device 200 in the “Standby” status, upon receiving status information (S2904) indicative of a “Wireless Charging” status from the powered device 200 through the communication using the communication circuitry 106, the powering device 100 enters the “Wireless Charging” status as the operational status for the ID of the powered device 200, for example as illustrated in the column 122b in FIG. 9 (S1907). Also, in the embodiments, while managing the ID of the powered device 200 in the positive communication status after the step S1903, the powering device 100 performs the process 710 depicted in FIG. 27 for monitoring the communication with the powered device 200 in parallel to the process 708. In the embodiments, as depicted in FIG. 30, upon the discovery at the step S2082 when the communication circuitry 203 has been activated in accordance with the steps S2080 to S2081, the powered device 200, remaining in the “No Power” mode with the powered circuitry 210 deactivated, checks the authority of the powered device 200 itself, namely, determines whether or not the powered device 200 is authorized to be wirelessly powered by the powering device 100 with reference to the DB 222 (S2900). More particularly, if the powered device 200 finds the ID of the powering device 100 received in association with the discovery process being listed in the DB 222 as a connectable power source, the powered device 200 determines that the powered device 200 is authorized to receive wireless power transfer from the discovered powering device 100. On the contrary, if the powered device 200 does not find the ID of the discovered powering device 100 in the DB 122 as a connectable power source, the powered device 200 determines that the powered device 200 is not authorized to receive wireless power transfer from the discovered powering device 100. Upon determining that the powered device 200 is not authorized to receive wireless power transfer (S2900: No), the powering device 100 does not proceed to the “Powering” mode, and then the powered device 200 remains the communication circuitry 203 deactivated for a predetermined time in accordance with the steps S2401 to S2402. Upon determining that the powered device 200 is authorized to receive wireless power transfer (S2900: Yes), the powered device 200 sends to the powering device 100 through the communication using the communication circuitry 203 a positive acknowledgement indicating that the powered device 200 is authorized to receive wireless power transfer from the powering device 100 (S2901). In parallel to the transmission of the positive acknowledgement, the powered device 200 also expects reception of the same kind of positive acknowledgement from the powering device 100, namely, the acknowledgement (S1901) indicating that the powered device 200 is authorized to receive wireless power transfer from the powering device 100. Upon receiving the positive acknowledgement along with the ID of the powering device 100 from the powering device 100 through the communication using the communication circuitry 203 (S2902: Yes), the powered device 200 starts operation in the “Standby” mode and/or the “Wireless Charging” mode in accordance with the steps S2083 to S2090 and S2092 to S2097. In the course of performance of the steps S2083 to S2090 and S2092 to S2097, upon starting operation in the “Standby” mode in accordance with the step S2084 or S2093, the powered device 200 sends to the powering device 100 status information indicative of the “Standby” mode in which the powered device 200 is in operation through the communication using the communication circuitry 203 (S2903). Similarly, upon starting operation in the “Wireless Charging” mode in accordance with the step S2086, the

40

powered device 200 sends to the powering device 100 status information indicative of the “Wireless Charging” mode in which the powered device 200 is in operation through the communication using the communication circuitry 203 (S2904). In the embodiments, for the process 708, the powering control program 121 may have the computer program instructions for the steps S1900 to S1907 while the charging control program 221 may have the computer program instructions for the steps S2900 to S2904.

## Battery-Powered Powering Device 100

In some embodiments, the powering device 100 comprises the battery 109 and the charging circuitry 108, as depicted in FIG. 5, so as to selectively operate using power provided by the battery 109 or using power provided via the outlet 20. The powering device 100 with the battery 109 for the battery-powered operation may be a portable, mobile, or handheld user device such as a smartphone, cellular phone, tablet, laptop, and other gadgets, appliances, and the likes, in which case the powered device 200 may be a peripheral device for use in connection with the powering device 100 such as a microphone, earphone(s), headphone, mouse, keyboard, stylus, and other accessories. FIG. 34 is a block diagram illustrating an exemplary configuration of the powering device 100 as a battery-powered mobile user device. As depicted in FIG. 34, the powering device 100 may include a loudspeaker 110 and a microphone 111, and stores phone-call application 123, browser 124, and a media playback application 125 on the memory 102. In the example of FIG. 34, the communication circuitry 103 may be configured to perform telephony communication in accordance with a cellular telephony protocol and also to get access to the Internet for Internet communications. The phone-call application 123 may include instructions that cause the processor 101 to perform and control telephone calls using the communication circuitry 103, loudspeaker 110, and microphone 111. The browser 124 may include instructions that cause the processor 101 to access to web sites through Internet communication using the communication circuitry 103. The media playback application 125 may include instructions that cause the processor 101 to play back media contents such as video clips, music, photos, etc. stored on the memory 102 or fetched over the Internet through Internet communication using the communication circuitry 103.

In the embodiments, the powering device 100 may enable and disable wireless power transfer depending on whether the powering device 100 is currently battery-powered or AC-powered. FIG. 31 depicts a process 800 for the enablement/disablement. As depicted in FIG. 31, the powering device 100 determines whether the powering device 100 is in operation in an AC-powered mode where the powering device 100 is powered by the power supply 107 via the outlet 20 or is powered by the battery 109 (S3000). Upon determining that the powering device 100 is currently AC-powered (S3000: AC-Powered), the powering device 100 enables or allows wireless power transfer (S3001). On the contrary, upon determining that the powering device 100 is currently battery-powered (S3000: Battery-Powered), the powering device 100 disables or prohibits wireless power transfer (S3002).

In the embodiments, the powering device 100 may enable and disable wireless power transfer depending on the battery level of the battery 109 when in operation in the battery-powered mode (S3000: Battery-Powered). FIG. 32 depicts a process 810 for the enablement/disablement. As depicted in FIG. 32, the powering device 100 determines whether or not

## US 10,790,703 B2

41

the battery level of the battery **109** is sufficient above a predetermined threshold (**S3010**). Upon determining that the battery level is above the threshold (**S3010**: Yes), the powering device **100** enables or allows wireless power transfer (**S3001**). On the contrary, upon determining that the battery level is low below the threshold (**S3010**: No), the powering device **100** disables or prohibits wireless power transfer (**S3002**).

In the embodiments, the powering device **100** may enable and disable wireless power transfer depending on whether the battery level of the battery **109** is currently or potentially declining moderately or steeply when in operation in the battery-powered mode (**S3000**: Battery-Powered). FIG. **33** depicts a process **820** for the enablement/disablement. As depicted in FIG. **33**, the powering device **100** determines whether the level of the battery **109** is declining or likely to be declining moderately below a predetermined threshold or steeply above the threshold (**S3020**). The determination may be one that involves comparing with a threshold that indicates or corresponds to the moderateness, steepness, or intensity in the load on the battery **109**. The determination herein may include, for example: determining whether or not the level of drop or decline in the battery level in a given time period is below a threshold, in which case affirmative determination represents the moderate decline while negative determination represents the steep decline (as illustrated in FIG. **41**); determining whether or not the current battery consumption level or an average battery consumption level, such as one that may be expressed by a milli-ampere (mA), in a given time period is below a threshold, in which case affirmative determination represents the moderate decline while negative determination represents the steep decline (as illustrated in FIG. **42**); determining whether or not the utilization or activity rate of the processor **101** is below a threshold, in which case affirmative determination represents the moderate decline while negative determination represents the steep decline (as illustrated in FIG. **43**); determining whether or not the number of the currently active application programs being run by the processor **101** is below a threshold, in which case affirmative determination represents the moderate decline while negative determination represents the steep decline (as illustrated in FIG. **44**); determining whether or not at least one specific application program, such as the phone-call application **123** and the media playback application **125**, each of which typically causes relatively higher load on the processor **101** resulting in high load on the battery **109** is being run by the processor **101**, in which case affirmative determination represents the steep decline while negative determination represents the moderate decline; determining whether or not at least one specific component, such as the loudspeaker **110** and the microphone **111**, is being activated by the processor **101** in accordance with the instructions of at least one specific application program such as the phone-call application **123** and the OS **120**, in which case affirmative determination represents the steep decline while negative determination represents the moderate decline; and determining whether or not the powering device **100** is in operation in a "Standby", "Sleep", "Hibernation", or similar power saving mode where at least one specific component such as the output **105** is intentionally deactivated or turned off by the processor **101** for saving power, in which case affirmative determination represents the moderate decline while negative determination represents the steep decline. Upon determining the moderate decline in the battery **109** (**S3020**: Moderate), the powering device **100** enables or allows wireless power transfer (**S3001**). On the contrary, upon determining the

42

steep decline in the battery **109** (**S3020**: Steep), the powering device **100** disables or prohibits wireless power transfer (**S3002**).

In the embodiments, the powering device **100** may perform the determinations at the steps **S3000**, **S3010**, and **S3020**: continuously, periodically, or intermittently during the wireless power transfer processes **400** to **708** as described with reference to FIGS. **12** to **30**; or at a given point of time such as, for example, before the activation of the powering circuitry **106** (**S1000**, **S1010**, **S1022**, **S1032**, **S1041**, **S1061**, **S1072**, **S1083**, **S1505**, **S1706**, **S1806**, **S1905**), upon the discovery (**S1040**, **S1060**, **S1070**, **S1082**), upon the affirmative determination as to reception of the response from the powered device **200** (**S1021**: Yes, **S1031**: Yes), upon the reception of the request from the powered device **200** (**S2074**), upon the affirmative determination as to the authority confirmation (**S1100**: Yes, **S1200**: Yes, **S1300**: Yes, **S1400**: Yes, **S1502**: Yes, **S1702**: Yes, **S1802**: Yes, **S1902**: Yes), and upon the entrance of the communication status in the DB **122** (**S1503**, **S1703**, **S1803**, **S1903**).

In the embodiments, the enablement of wireless power transfer may include enabling or allowing the activation of the powering circuitry **106** at the steps **S1000**, **S1010**, **S1022**, **S1032**, **S1041**, **S1061**, **S1072**, **S1083**, **S1505**, **S1706**, **S1806**, and **S1905**. The disablement of wireless power transfer may include disabling, prohibiting, preventing, or nullifying the activation of the powering circuitry **106** at the steps **S1000**, **S1010**, **S1022**, **S1032**, **S1041**, **S1061**, **S1072**, **S1083**, **S1505**, **S1706**, **S1806**, and **S1905**.

Ac-Powered Powered Device **200**

In some embodiments, the powered device **200** comprises the power supply **207**, as depicted in FIG. **7**, so as to selectively operate using power provided via the outlet **20** or using power provided by the battery **209**. In the embodiments, the powered device **200** may enable and disable wireless power charging depending on whether the powered device **200** is currently battery-powered or AC-powered. FIG. **35** depicts a process **850** for the enablement/disablement. As depicted in FIG. **35**, the powered device **200** determines whether the powered device **200** is in operation in an AC-powered mode where the powered device **200** is powered by the power supply **207** via the outlet **20** or is powered by the battery **209** (**S4000**). Upon determining that the powered device **200** is currently battery-powered (**S4000**: Battery-Powered), the powered device **200** enables or allows wireless power charging (**S4001**). On the contrary, upon determining that the powered device **200** is currently AC-powered (**S4000**: AC-Powered), the powered device **200** disables or prohibits wireless power charging (**S4002**).

In the embodiments, the powered device **200** may perform the determination at the step **S4000**: continuously, periodically, or intermittently during the wireless power charging processes **400** to **708** as described with reference to FIGS. **12** to **30**; or at a given point of time such as, for example, before the activation of the powered circuitry **210** (**S2000**, **S2011**, **S2020**, **S2031**, **S2041**, **S2063**, **S2073**, **S2083**), upon the discovery (**S2040**, **S2060**, **S2070**, **S2082**), upon the negative determination as to the battery level of the battery **209** (**S2010**: No, **S2030**: No, **S2062**: No, **S2072**: No, **S2080**: No), and upon the affirmative determination as to the authority confirmation (**S2100**: Yes, **S2200**: Yes, **S2300**: Yes, **S2400**: Yes, **S2502**: Yes, **S2702**: Yes, **S2802**: Yes, **S2902**: Yes).

In the embodiments, the enablement of wireless power charging may include enabling or allowing the activation of

## US 10,790,703 B2

43

the powered circuitry 210 at the steps S2000, S2011, S2020, S2031, S2041, S2063, S2073, and S2083. The disablement of wireless power transfer may include disabling, prohibiting, preventing, or nullifying the activation of the powered circuitry 210 at the steps S2000, S2011, S2020, S2031, S2041, S2063, S2073, and S2083.

## Daisy Chain Powering

In some embodiments, the powered device 200 may also include powering circuitry 206 just like the powering device 100, as depicted in FIG. 8, to wirelessly power another powered device 200 nearby. As a result, the embodiments may provide daisy-chain powering in an environment including two or more powered devices 200 present in proximity to one another, as depicted in FIG. 3, in which: a powered device 200 in the powering region 10 wirelessly powered by the powering device 100 (200A in FIG. 3) provides another powering region 11 for wireless power transfer to at least one other nearby or neighboring powered device 200 out of the powering region 10; the powered device 200 out of the powering region 10 but wirelessly powered in the powering region 11 (200B in FIG. 3) provides further another powering region 12 for wireless power transfer to at least one other nearby powered device 200 out of the powering regions 10 and 11 (200C in FIG. 3); and accordingly the powering regions 11 to 13 are provided in turn by the multiple powered devices 200 from one closest to the powering device 100 (200A in FIG. 3) to one farthest from the powering device 100 (200C in FIG. 3).

FIG. 36 depicts a process 900 for the daisy-chain powering, illustrating an example of the daisy-chain powering between two powered devices 200A and 200B. In the embodiments, each powered device 200 continuously, periodically, or intermittently determines whether or not the powered device 200 is being charged through the powered circuitry 210 (S5000, S5010). The determination at the steps S5000 and S5010 may correspond to the determination at the step S2001, S2012, S2021, S2032, S2043, S2064, S2075, or S2085 in the above-mentioned processes. Upon determining that the powered device 200 is being charged through the powered circuitry 210 (S5000, S5010: Yes), the powered device 200 activates the powering circuitry 206 to provide for wireless power transfer (S5001, S5011). As long as the battery 209 is being charged by power generated by the powered circuitry 206, the powered device 200 may remain the powering circuitry 206 active. If the powered device 200A is present closest to the powering device 100 enough to be present in the powering region 10, the powered device 200A receives wireless power transfer from the powering device 100 and thus the battery 209 is charged by power generated by the powered circuitry 210 (S5000: Yes). So, the powered device 200A then activates the powering circuitry 206 to provide the powering region 11 (S5001). On the other hand, the powered device 200B out of the powering region 10 initially cannot be charged through the powered circuitry 206 (S5010: No), but in response to the provision of the powering region 11 by the powered device 200A at the step S5001, starts being charged through the powered circuitry 206 in the powering region 11 (S5010: Yes). So the powered device 200B then activates the powering circuitry 206 to provide the powering region 12 for wireless power transfer (S5011).

FIG. 37 depicts a process 901 for the daisy-chain powering, illustrating an example of the daisy-chain powering between two powered devices 200A and 200B. In the embodiments, each powered device 200 continuously, peri-

44

odically, or intermittently determines whether or not the battery level of the battery 209 is sufficient above a threshold (S5020, S5030). The determination at the steps S5020 and S5030 may correspond to the determination at the step S2010, S2015, S2030, S2036, S2062, S2066, S2072, S2077, S2080, or S2087 in the above-mentioned processes. Upon determining that the battery level of the battery 209 is sufficient above the threshold (S5020, S5030: Yes), the powered device 200 activates the powering circuitry 206 to provide for wireless power transfer (S5021, S5031). As long as the battery level of the battery 209 is sufficient above the threshold, the powered device 200 may remain the powering circuitry 206 active. If the powered device 200A is present closest to the powering device 100 enough to be present in the powering region 10, the battery level of the battery 209 in the powered device 200A tends to be kept sufficient above the threshold as the powered device 200A is charged through the powered circuitry 210 (S5020: Yes). So, the powered device 200A then activates the powering circuitry 206 to provide the powering region 11 (S5021). On the other hand, the powered device 200B out of the powering region 10 initially cannot be charged through the powered circuitry 206, resulting in the battery level of the battery 209 being below the threshold (S5030: No), but in response to the provision of the powering region 11 by the powered device 200A at the step S5021, starts being charged through the powered circuitry 206 in the powering region 11, resulting in the battery level of the battery 209 being above the threshold (S5030: Yes). So the powered device 200B then activates the powering circuitry 206 to provide the powering region 12 for wireless power transfer (S5031).

FIG. 38 depicts a process 902 for the daisy-chain powering, illustrating an example of the daisy-chain powering between two powered devices 200A and 200B. In the embodiments, each powered device 200 starts activation of the powering circuitry 206 (S5041, S5051) upon discovery of another powered device 200 through communication using the communication circuitry 203 (S5040, S5050). When the powered device 200B is present near the powered device 200A, the powered devices 200A and 200B discover each other so that the powered device 200A starts providing the powering region 11 for wireless power transfer to the powered device 200B.

FIG. 39 depicts a process 903 for the daisy-chain powering, illustrating an example of the daisy-chain powering between two powered devices 200A and 200B. In the embodiments, each powered device 200 determines whether or not the powered device 200 is being charged through the powered circuitry 210 (S5061, S5071) upon discovery of another powered device 200 through communication using the communication circuitry 203 (S5060, S5070). The powered device 200 starts activation of the powering circuitry 206 (S5062, S5072) when the battery 209 is being charged by power generated by the powered circuitry 210 (S5061, S5071: Yes) upon the discovery. The powered device 200A starts activation of the powering circuitry 206 to provide the powering region 11 if the powered device 200A is receiving wireless power transfer from the powering device 100 in the powering region 10 upon discovery of the powered device 200B (S5062). On the contrary, the powered device 200B out of the powering region 10 should make a negative determination at the step S5071 upon discovery of the powered device 200A. However, once the powered device 200B starts reception of wireless power transfer from the powered device 200A in the powering region 11 provided in accordance with the step S5062, the powered device 200B should make an affirmative determination at the step S5071



## US 10,790,703 B2

45

upon discovery of another powered device **200** (i.e., the powered device **200C**) to provide the powering region **12** for wireless power transfer to said another powered device **200** (S5072).

FIG. 40 depicts a process **904** for the daisy-chain powering, illustrating an example of the daisy-chain powering between two powered devices **200A** and **200B**. In the embodiments, each powered device **200** determines whether or not the powered device **200** is being charged through the powered circuitry **210** (S5080, S5090), and also determines whether or not the powered device **200** is currently discovering two or more devices in total through communication using the communication circuitry **203** (S5081, S5091). The determinations at the steps S5080 to S5081 or S5090 to S5091 may be made upon discovery of another powered device **200**, or may be made continuously, periodically, or intermittently. Upon determining affirmatively (S5081, S5091: Yes), the powered device **200** starts activation of the powering circuitry **206** to provide a powering region for wireless power transfer (S5082, S5092). In other words, the powered device **200** starts activation of the powering circuitry **206** on the condition that: (a) the battery **209** is being charged by power generated by the powered circuitry **210** and (b) the powered device **200** is in communication with two or more devices in total. The communication with two or more devices in total may include: communication with the powering device **100** and with at least one other powered device **200**; and communication with two or more other powered devices **200**. When the powered device **200A** in the powering region **10** wirelessly powered by the powering device **100** discovers the powered device **200B**, the powered device **200A** meets the condition that the powered device **200A** is being charged through the powered circuitry **210** (S5080: Yes) and the powered device **200A** is in communication with two or more devices, namely, the powering device **100** and the powered device **200B** (S5081: Yes), leading to activation of the powering circuitry **206** to provide the powering region **11** (S5082). On the contrary, the powered device **200B** does not meet the condition when the powered device **200B** is in communication with only the powered device **200A** even if the powered device **200B** is being charged through the powered circuitry **210** in the powering region **11**. However, once the powered device **200B** discovers another powered device **200** (i.e., the powered device **200C**) to be in communication with said another powered device **200**, the powered device **200B** meets the condition that the powered device **200B** is being charged through the powered circuitry **210** (S5090: Yes) and the powered device **200B** is in communication with two or more devices, namely, the powered devices **200A** and **200C** (S5091: Yes), leading to activation of the powering circuitry **206** to provide the powering region **12** (S5092).

## CONCLUSION AND NOTE

Various embodiments of the present invention as described above provide smart wireless power transfer between a powering device and a powered device. Further modifications and alternative embodiments will be apparent to those skilled in the art in view of this disclosure. Accordingly, the above description is to be construed as illustrative only and is for the purpose of teaching those skilled in the art a manner of carrying out the invention. It is to be understood that the forms of the invention herein shown and described are to be taken as exemplary embodiments. Various modifications may be made without departing from the scope of the invention. For example, equivalent elements or

46

materials may be substitute for those illustrated and described herein, and certain features of the invention may be utilized independently of the use of other features, all as would be apparent to one skilled in the art after having the benefit of this description of the invention. In addition, the terms “a” and “an” are generally used in the present disclosure to mean one or more.

What is claimed is:

1. A wireless power transfer system for wirelessly charging a powered device, comprising:

a battery power source for supplying power to the wireless power transfer system;

wireless communication circuitry for establishment of a close-range wireless communication over which a message associated with the powered device is communicated from the powered device; and

wireless powering circuitry including a transmitter configured to emit electromagnetic waves to form a radiative powering region within which the electromagnetic waves can be received by wireless powered circuitry of the powered device to generate power for charging a battery in the powered device, the wireless powering circuitry being configured to be activated when the close-range wireless communication is established,

wherein transmission power of the wireless communication circuitry is so controlled as to make a range of the close-range wireless communication substantially narrower than a range of the radiative powering region, wherein the message is issued by the powered device when a battery level of the battery is below a predetermined threshold, and the wireless powering circuitry is configured to be activated in response to receipt of the message from the powered device over the established close-range wireless communication, and

wherein, when the wireless power transfer system is powered by the battery power source, a determination is made whether a level of drop in a battery level of the battery power source in a given time period is below a threshold, so that activation of the wireless powering circuitry is allowed only when the level of drop is determined to be below the threshold.

2. A wireless power transfer system for wirelessly charging a powered device, comprising:

a battery power source for supplying power to the wireless power transfer system;

wireless communication circuitry for establishment of a close-range wireless communication over which a message associated with the powered device is communicated from the powered device; and

wireless powering circuitry including a transmitter configured to emit electromagnetic waves to form a radiative powering region within which the electromagnetic waves can be received by wireless powered circuitry of the powered device to generate power for charging a battery in the powered device, the wireless powering circuitry being configured to be activated when the close-range wireless communication is established,

wherein transmission power of the wireless communication circuitry is so controlled as to make a range of the close-range wireless communication substantially narrower than a range of the radiative powering region, wherein the message is issued by the powered device when a battery level of the battery is below a predetermined threshold, and the wireless powering circuitry is configured to be activated in response to receipt of the message from the powered device over the established close-range wireless communication, and

US 10,790,703 B2

47

wherein, when the wireless power transfer system is powered by the battery power source, a determination is made whether an average battery consumption level of the battery power source in a given time period is below a threshold, so that activation of the wireless powering circuitry is allowed only when the average battery consumption level is determined to be below the threshold.

3. A wireless power transfer system for wirelessly charging a powered device, comprising:

a battery power source for supplying power to the wireless power transfer system;

a processor;

wireless communication circuitry for establishment of a close-range wireless communication over which a message associated with the powered device is communicated from the powered device; and

wireless powering circuitry including a transmitter configured to emit electromagnetic waves to form a radiative powering region within which the electromagnetic waves can be received by wireless powered circuitry of the powered device to generate power for charging a battery in the powered device, the wireless powering circuitry being configured to be activated when the close-range wireless communication is established,

wherein transmission power of the wireless communication circuitry is so controlled as to make a range of the close-range wireless communication substantially narrower than a range of the radiative powering region, wherein the message is issued by the powered device when a battery level of the battery is below a predetermined threshold, and the wireless powering circuitry is configured to be activated in response to receipt of the message from the powered device over the established close-range wireless communication, and

wherein, when the wireless power transfer system is powered by the battery power source, a determination is made whether a utilization rate of the processor is below a threshold, so that activation of the wireless

48

powering circuitry is allowed only when the utilization rate is determined to be below the threshold.

4. A wireless power transfer system for wirelessly charging a powered device, comprising:

a battery power source for supplying power to the wireless power transfer system;

a processor;

an operating system;

application programs configured to be executed by the processor on the operating system;

wireless communication circuitry for establishment of a close-range wireless communication over which a message associated with the powered device is communicated from the powered device; and

wireless powering circuitry including a transmitter configured to emit electromagnetic waves to form a radiative powering region within which the electromagnetic waves can be received by wireless powered circuitry of the powered device to generate power for charging a battery in the powered device, the wireless powering circuitry being configured to be activated when the close-range wireless communication is established,


wherein transmission power of the wireless communication circuitry is so controlled as to make a range of the close-range wireless communication substantially narrower than a range of the radiative powering region, wherein the message is issued by the powered device when a battery level of the battery is below a predetermined threshold, and the wireless powering circuitry is configured to be activated in response to receipt of the message from the powered device over the established close-range wireless communication, and

wherein, when the wireless power transfer system is powered by the battery power source, a determination is made whether a number of application programs being executed by the processor is below a threshold, so that activation of the wireless powering circuitry is allowed only when the number of the application programs is determined to be below the threshold.

\* \* \* \* \*

Case 3:25-cv-00857-K Document 128-9 Filed 10/8/24 Page 60 of 84

# EXHIBIT B

US10790703 B2 Claim 1	Renesas Electronics's EVK Evaluation Kit
<p>1. A wireless power transfer system for wirelessly charging a powered device, comprising:</p>	<div data-bbox="431 552 589 583">  </div> <div data-bbox="919 558 1393 590"> <b>P9222-R-EVK Evaluation Kit Manual</b> </div> <div data-bbox="431 663 586 695"> <b>Description</b> </div> <div data-bbox="431 709 886 909"> <p>The P9222-R-EVK <b>Wireless Power</b> Evaluation Board can be used to demonstrate the features and performance of the P9222-R 5W <b>Wireless Power</b> Receiver in low power 2.5W applications such as in earbuds charging cases. The P9222-R-EVK can also supply up to 5W power. IDT's P9235A-RB-EVK Evaluation Board or any other Qi certified transmitter can be used as the power transmitter for P9222-R-EVK evaluation board testing.</p> </div> <div data-bbox="431 926 886 1150"> <p>The P9222-R-EVK demonstrates a high-efficiency, turnkey reference design and is supported by comprehensive online, digital resources to significantly expedite the design-in effort and enable rapid prototyping. The printed circuit board (PCB) has four layers. The total solution area (excluding coil) is approximately 70 mm<sup>2</sup> out of which 37 mm<sup>2</sup> is occupied by the components. A small 30×30mm power receiver coil is used in the design to meet small form-factor device requirements.</p> </div> <div data-bbox="431 1169 886 1430"> <p>Using the P9222-R Windows GUI and the P9222-R-EVK, customers can quickly customize operating parameters for their applications. Operating parameters such as foreign object detection (FOD) parameters can be configured by either writing to internal SRAM registers via the I2C interface, or by loading the user configuration generated by the P9222-R Windows GUI into an external EEPROM. The P9222-R-EVK has an on-board external EEPROM and connectors to plug-in the USB to an I2C programming dongle.</p> </div> <div data-bbox="948 663 1065 695"> <b>Features</b> </div> <div data-bbox="948 709 1403 1108"> <ul style="list-style-type: none"> <li>• WPC1.2.4 Baseline Power Profile (5W) compatible</li> <li>• Design optimized for low power (2.5W) applications with 30×30mm coil</li> <li>• Approximately 70mm<sup>2</sup> solution area</li> <li>• Schematic and layout files are available online</li> <li>• Works with the P9222-R Windows GUI</li> <li>• Easy configuration of design parameters through I2C interface</li> <li>• On-board external EEPROM for flexible design parameter updates</li> <li>• J12 connector compatible with the "USB-FTDI-V2-1" (FTDI) and ARM60 USB-to-I2C dongles</li> <li>• 4-layer PCB with 1oz copper</li> </ul> </div> <div data-bbox="948 1148 1117 1180"> <b>Kit Contents</b> </div> <div data-bbox="948 1192 1382 1220"> <ul style="list-style-type: none"> <li>• P9222-R-EVK Evaluation board including the coil assembly</li> </ul> </div> <div data-bbox="456 1453 1255 1491"> <p>© 2020 Renesas Electronics Corporation. All rights reserved.</p> </div> <div data-bbox="415 1507 1414 1539"> <p><a href="https://www.renesas.com/us/en/document/mah/p9222-r-evaluation-kit-manual?r=32315">https://www.renesas.com/us/en/document/mah/p9222-r-evaluation-kit-manual?r=32315</a></p> </div> <div data-bbox="415 1579 1393 1648"> <p>Renesas Electronics's EVK Evaluation Kit is a wireless power transfer system for wirelessly charging a powered device.</p> </div> <div data-bbox="415 1682 1341 1751"> <p>The reference includes subject matter disclosed by the claims of the patent after the priority date.</p> </div>



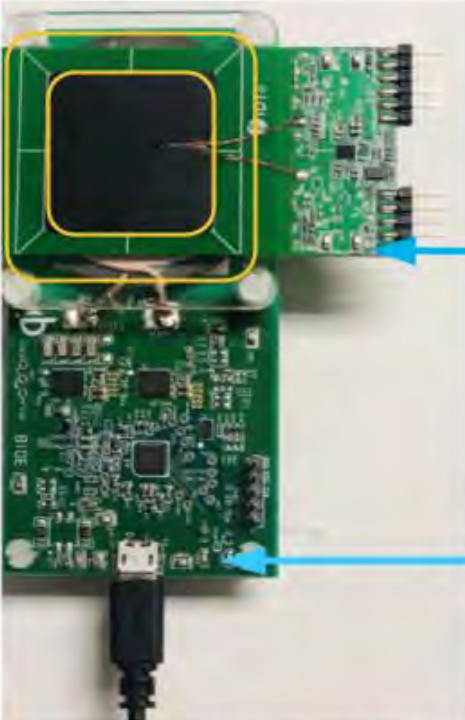
Case 2:23-cv-00575-K Document 128-9 Filed 11/08/23 Page 82 of 84

US10790703 B2 Claim 1	Renesas Electronics's EVK Evaluation Kit
a battery power source for supplying power to the wireless power transfer system;	<p><b>3.1 LDO Output Voltage (VOUT) Configuration</b></p> <p>The default VOUT voltage of the P9222-R-EVK is 5.0V. The user can change the default Vout voltage in accordance with specific user design requirements and store the modified configuration in the external EEPROM, or an external Applications Processor (AP) can adjust VOUT voltage continuously via the I2C interface. In addition, an external MCU can continuously read the battery voltage and change VOUT to lower the losses in the battery charger to optimize the total system efficiency. The P9222-R configurable Vout voltage range is from 3.5V to 12V.</p> <p><a href="https://www.renesas.com/us/en/document/mah/p9222-r-evaluation-kit-manual?r=32315">&lt;https://www.renesas.com/us/en/document/mah/p9222-r-evaluation-kit-manual?r=32315&gt;</a></p> <p>The reference describes a battery power source for supplying power to the wireless power transfer system.</p>

US10790703 B2 Claim 1	Renesas Electronics's EVK Evaluation Kit
wireless communication circuitry for establishment of a close-range wireless communication over which a message associated with the powered device is communicated from the powered device; and	<p><b>3.4.1 Modulation Capacitor and Interrupt Enables</b></p> <p>The P9222-R sends the communication packets to the transmitter using ASK modulation of the coil voltage. For ASK modulation, the P9222-R switches the capacitors on and off that are on the COM1, COM2, CMA, and CMB pins using internal MOSFETs. By default, the P9222-R switches only the MOSFETs on the COM1 and COM2 pins. ASK modulation depth can be increased by enabling the switches on the CMA and CMB pins. Measure the modulation depth on the transmitter demodulation circuitry, and if too small, adjust the ASK modulation depth by enabling the CMA and CMB switches. Modulation depth can also be increased by increasing the capacitor value. The AP can also change the ASK modulation depth by writing to the ASK modulation depth Registers (0xF4).</p> <p><a href="https://www.renesas.com/us/en/document/mah/p9222-r-evaluation-kit-manual?r=32315">&lt;https://www.renesas.com/us/en/document/mah/p9222-r-evaluation-kit-manual?r=32315&gt;</a></p> <p>The reference describes wireless communication circuitry for establishment of a close-range wireless communication over which a message associated with the powered device is communicated from the powered device.</p>



US10790703 B2 Claim 1	Renesas Electronics's EVK Evaluation Kit
<p>wireless powering circuitry including a transmitter configured to emit electromagnetic waves to form a radiative powering region within which the electromagnetic waves can be received by wireless powered circuitry of the powered device to generate power for charging a battery in the powered device, the wireless powering circuitry being configured to be activated when the close-range wireless communication is established,</p>	<p><b>3.4.1 Modulation Capacitor and Interrupt Enables</b></p> <p>The P9222-R sends the communication packets to the transmitter using ASK modulation of the coil voltage. For ASK modulation, the P9222-R switches the capacitors on and off that are on the COM1, COM2, CMA, and CMB pins using internal MOSFETs. By default, the P9222-R switches only the MOSFETs on the COM1 and COM2 pins. ASK modulation depth can be increased by enabling the switches on the CMA and CMB pins. Measure the modulation depth on the transmitter demodulation circuitry, and if too small, adjust the ASK modulation depth by enabling the CMA and CMB switches. Modulation depth can also be increased by increasing the capacitor value. The AP can also change the ASK modulation depth by writing to the ASK modulation depth Registers (0xF4).</p> <p>&lt;<a href="https://www.renesas.com/us/en/document/mah/p9222-r-evaluation-kit-manual?r=32315">https://www.renesas.com/us/en/document/mah/p9222-r-evaluation-kit-manual?r=32315</a>&gt;</p> <p>The reference describes wireless powering circuitry including a transmitter configured to emit electromagnetic waves to form a radiative powering region within which the electromagnetic waves can be received by wireless powered circuitry of the powered device to generate power for charging a battery in the powered device, the wireless powering circuitry being configured to be activated when the close-range wireless communication is established.</p>

US10790703 B2 Claim 1	Renesas Electronics's EVK Evaluation Kit
<p>wherein transmission power of the wireless communication circuitry is so controlled as to make a range of the close-range wireless communication substantially narrower than a range of the radiative powering region,</p>	 <p>Green LED on P9222-R-EVK indicates the wireless connection has been made</p> <p>Green LED on P9235A-RB-EVK indicates the wireless connection has been made</p> <p>&lt;<a href="https://www.renesas.com/us/en/document/mah/p9222-r-evaluation-kit-manual?r=32315">https://www.renesas.com/us/en/document/mah/p9222-r-evaluation-kit-manual?r=32315</a>&gt;</p> <p>The reference describes transmission power of the wireless communication circuitry is so controlled as to make a range of the close-range wireless communication substantially narrower than a range of the radiative powering region.</p>

US10790703 B2 Claim 1	Renesas Electronics's EVK Evaluation Kit
<p>wherein the message is issued by the powered device when a battery level of the battery is below a predetermined threshold, and the wireless powering circuitry is configured to be activated in response to receipt of the message from the powered device over the established close-range wireless communication, and</p> <p>wherein, when the wireless power transfer system is powered by the battery power source, a determination is made whether a level of drop in a battery level of the battery power source in a given time period is below a threshold, so that activation of the wireless powering circuitry is allowed only when the level of drop is determined to be below the threshold.</p>	<p><b>3.2 Current Limit (ILIM) Configuration</b></p> <p>The current limit threshold value is used to limit the output current of main LDO on the VOUT pin. If the output current reaches the target limit value, the VOUT voltage level will decrease due to the current limit setting if the output load is over the current limit level. The default ILIM value of the P9222-R-EVK is 1.6A. The user can change the default current limit value in accordance with specific user design requirements and store the modified configuration into an external EEPROM. In addition, after the P9222-R enters the power transfer phase, an external AP can adjust the ILIM value by writing to the ILIM_Set register (0x3D) via the I2C interface. The P9222-R firmware reads the internal register value in regular time base and updates the current limit value. The current limit can be incremented in steps of 100mA.</p> <p style="text-align: center;"><b>Current Limit (ILIM) = Decimal Value of 0x3D register * 0.1 (A)</b> <span style="float: right;"><b>Equation 2</b></span></p> <p>The default Current Limit value can be configured by writing a configuration file into the external EEPROM. The configuration file can be generated using the P9222-R Windows GUI. For information on how the configuration file can be generated using the P9222-R Windows GUI, see "VOUT Configuration Change Using an External EEPROM."</p> <p><a href="https://www.renesas.com/us/en/document/mah/p9222-r-evaluation-kit-manual?r=32315">https://www.renesas.com/us/en/document/mah/p9222-r-evaluation-kit-manual?r=32315</a></p> <p>The reference describes the message is issued by the powered device when a battery level of the battery is below a predetermined threshold, and the wireless powering circuitry is configured to be activated in response to receipt of the message from the powered device over the established close-range wireless communication.</p> <p>The reference describes when the wireless power transfer system is powered by the battery power source, a determination is made whether a level of drop in a battery level of the battery power source in a given time period is below a threshold, so that activation of the wireless powering circuitry is allowed only when the level of drop is determined to be below the threshold.</p>

# EXHIBIT J

ADD0921

**From:** [Jason Crotty](#)  
**To:** [William Ramey](#); [Susan Kalra](#); [Jeff Kubiak](#); [LitigationParalegals](#)  
**Cc:** [Benjamin Charkow](#)  
**Subject:** RE: Koji IP, LLC v. Renesas Electronics America, Inc. (N.D. Cal.) -- Draft FRCP 26 Report and meet and confer re motion to dismiss  
**Date:** Tuesday, January 30, 2024 11:58:19 AM

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Bill:

Thank you for the update. At this point in the litigation, I think Koji IP may be able to dismiss as of right, but let me know if that's not correct.

Jason A. Crotty  
Maschoff Brennan  
450 Sansome St., Ste. 1005  
San Francisco CA 94111  
(415) 969-6918

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**From:** William Ramey <[wramey@rameyfirm.com](mailto:wramey@rameyfirm.com)>  
**Sent:** Tuesday, January 30, 2024 9:51 AM  
**To:** Jason Crotty <[JCrotty@mabr.com](mailto:JCrotty@mabr.com)>; Susan Kalra <[skalra@rameyfirm.com](mailto:skalra@rameyfirm.com)>; Jeff Kubiak <[jkubiak@rameyfirm.com](mailto:jkubiak@rameyfirm.com)>; LitigationParalegals <[LitParalegals@rameyfirm.com](mailto:LitParalegals@rameyfirm.com)>  
**Cc:** Benjamin Charkow <[BCharkow@mabr.com](mailto:BCharkow@mabr.com)>  
**Subject:** RE: Koji IP, LLC v. Renesas Electronics America, Inc. (N.D. Cal.) -- Draft FRCP 26 Report and meet and confer re motion to dismiss

Hi Jason,

I have discussed the case with the client and the low sales volume does not justify further litigation. we can agree to a dismissal.

Thanks,

Bill

---

**From:** Jason Crotty <[JCrotty@mabr.com](mailto:JCrotty@mabr.com)>  
**Sent:** Monday, January 29, 2024 12:02 PM  
**To:** William Ramey <[wramey@rameyfirm.com](mailto:wramey@rameyfirm.com)>; Susan Kalra <[skalra@rameyfirm.com](mailto:skalra@rameyfirm.com)>; Jeff Kubiak <[jkubiak@rameyfirm.com](mailto:jkubiak@rameyfirm.com)>; LitigationParalegals <[LitParalegals@rameyfirm.com](mailto:LitParalegals@rameyfirm.com)>  
**Cc:** Benjamin Charkow <[BCharkow@mabr.com](mailto:BCharkow@mabr.com)>  
**Subject:** RE: Koji IP, LLC v. Renesas Electronics America, Inc. (N.D. Cal.) -- Draft FRCP 26 Report and meet and confer re motion to dismiss

Bill:

ADD0922



We have some time this afternoon to meet and confer on the motion to dismiss, though the issues have been covered at length in the prior motion and the correspondence. We will be filing soon.

Let us know. Thanks.

Jason A. Crotty  
Maschoff Brennan  
450 Sansome St., Ste. 1005  
San Francisco CA 94111  
(415) 969-6918

---

**From:** Jason Crotty <[JCrotty@mabr.com](mailto:JCrotty@mabr.com)>

**Sent:** Friday, January 26, 2024 9:50 AM

**To:** William Ramey <[wramey@rameyfirm.com](mailto:wramey@rameyfirm.com)>; Susan Kalra <[skalra@rameyfirm.com](mailto:skalra@rameyfirm.com)>; Jeff Kubiak <[jkubiak@rameyfirm.com](mailto:jkubiak@rameyfirm.com)>; LitigationParalegals <[LitParalegals@rameyfirm.com](mailto:LitParalegals@rameyfirm.com)>

**Cc:** Benjamin Charkow <[BCharkow@mabr.com](mailto:BCharkow@mabr.com)>

**Subject:** Koji IP, LLC v. Renesas Electronics America, Inc. (N.D. Cal.) -- Draft FRCP 26 Report and meet and confer re motion to dismiss

Bill:

Attached are our proposed inserts to the FRCP 26 report, as well as a redline. Because the draft provided by Koji IP appears to have been intended for a different case, the revisions appear extensive but many of them are simply factual corrections (*e.g.*, the title of the asserted patent). We are available to discuss at your convenience.

As we have indicated on several occasions, REA will be moving to dismiss based on the arguments set forth in the correspondence and in the motion in the original Colorado case. We have repeatedly sought a substantive response from Koji IP, but none has been forthcoming.

Because REA has not yet appeared in the case, Koji IP should have served the First Amended Complaint on REA. Notwithstanding that error, we intend to file the motion to dismiss today, as if the First Amended Complaint had been properly served. Although our positions have been made clear numerous times, we are available to meet and confer regarding the motion today. Please let us know if you are available to discuss today.

Alternatively, since a response to the First Amended Complaint is not technically due today, we could also talk on Monday if that is easier. Please let us know your availability on Monday.

Jason A. Crotty  
Maschoff Brennan  
450 Sansome St., Ste. 1005

ADD0923

San Francisco CA 94111  
(415) 969-6918

**CAUTION:** External Sender

ADD0924

# EXHIBIT K



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Patent Claims Analysis

of

US10790703: "Smart wireless power transfer between devices"

against

Renesas Electronics's PTX130W/PTX30W

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US10790703B2

United States

Inventor Koji Yoden

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Worldwide applications

2017 [US](#)

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15/843,092	Claims priority from a provisional application	<a href="#">62/435,883</a>	12/19/2016
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Total patentTerm Adjustments  
0

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## CLAIMS

1. A wireless power transfer system for wirelessly charging a powered device, comprising:

a battery power source for supplying power to the wireless power transfer system;

wireless communication circuitry for establishment of a close-range wireless communication over which a message associated with the powered device is communicated from the powered device; and


wireless powering circuitry including a transmitter configured to emit electromagnetic waves to form a radiative powering region within which the electromagnetic waves can be received by wireless powered circuitry of the powered device to generate power for charging a battery in the powered device, the wireless powering circuitry being configured to be activated when the close-range wireless communication is established,

wherein transmission power of the wireless communication circuitry is so controlled as to make a range of the close-range wireless communication substantially narrower than a range of the radiative powering region,

wherein the message is issued by the powered device when a battery level of the battery is below a predetermined threshold, and the wireless powering circuitry is configured to be activated in response to receipt of the message from the powered device over the established close-range wireless communication, and

wherein, when the wireless power transfer system is powered by the battery power source, a determination is made whether a level of drop in a battery level of the battery power source in a given time period is below a threshold, so that activation of the wireless powering circuitry is allowed only when the level of drop is determined to be below the threshold.

---

<b>US10790703</b> <b>Claim 1</b>	<b>Renesas Electronics's PTX130W/PTX30W</b>
1. A wireless power transfer system for wirelessly charging a powered device, comprising:	<div data-bbox="509 331 1088 428"></div> <div data-bbox="509 491 1559 554"><p>PTX130W/PTX30W Hardware Integration</p></div> <div data-bbox="509 697 1321 760"><p>© 2023 Renesas Electronics</p></div> <div data-bbox="483 785 1591 848"><p><a href="https://www.renesas.com/us/en/document/mah/ptx130w-ptx30w-hardware-integration-manual?r=25426216">&lt;https://www.renesas.com/us/en/document/mah/ptx130w-ptx30w-hardware-integration-manual?r=25426216&gt;</a></p></div> <div data-bbox="483 856 828 924"><p>R35UH0013EE0100 Rev.1.00 Nov 22, 2023</p></div> <div data-bbox="483 966 1591 1033"><p><i>Renesas Electronics's PTX130W/PTX30W (MUST BE BOUGHT TOGETHER IN ORDER TO ACHIEVE POWER TRANSFER) is a wireless power transfer system for wirelessly charging a powered device.</i></p></div>

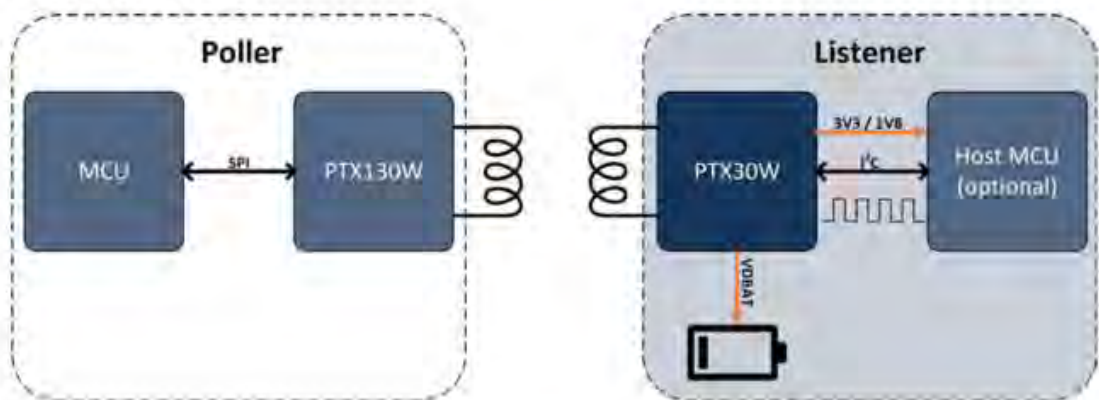
US10790703 Claim 1	Renesas Electronics's PTX130W/PTX30W																																														
a <b>battery power source</b> for supplying power to the wireless power transfer system;	<table border="1"> <thead> <tr> <th data-bbox="483 321 1219 359">Product features</th><th data-bbox="1219 321 1604 359"></th></tr> </thead> <tbody> <tr><td>Ultra-low power on-chip embedded core</td><td>✓</td></tr> <tr><td>Integrated PMIC solution</td><td>✓</td></tr> <tr><td>Integrated flexible battery charger with reverse current limiter</td><td>✓</td></tr> <tr><td>Integrated highly efficient active rectifier</td><td>✓</td></tr> <tr><td>Standalone mode of operation (without Host MCU)</td><td>✓</td></tr> <tr><td>Embedded power regulation control</td><td>✓</td></tr> <tr><td>Required PCB integration area (est.)</td><td>17 mm<sup>2</sup></td></tr> <tr><td>Rectification efficiency (AC to DC)</td><td>up to 92%</td></tr> <tr><td>Energy harvesting [W]</td><td>up to 1W</td></tr> <tr><td>Charging current range [mA]</td><td>5-250 mA</td></tr> <tr><td><u>Li-Ion and Li-Polymer batteries support</u></td><td>✓</td></tr> <tr><td>Charge status monitor</td><td>✓</td></tr> <tr><td>On-chip over-temperature detection/protection</td><td>✓</td></tr> <tr><td>Transparent data exchange channel</td><td>✓</td></tr> <tr><td>Shipping mode (support for battery protection)</td><td>✓</td></tr> <tr><td>System MCU supply output voltage, typ. [V]</td><td>1.8, 3.3 V</td></tr> <tr><td>Battery-less power supply output</td><td>✓</td></tr> <tr><td>JEITA support</td><td>✓</td></tr> <tr><td>Shipping mode current consumption, typ. [nA]</td><td>25 nA</td></tr> <tr><td>I2C clock frequency [kHz]</td><td>Up to 1 MHz</td></tr> <tr><td>Available packages</td><td>CSP16</td></tr> <tr><td>Temperature range [°C]</td><td>-40 to +85</td></tr> </tbody> </table> <p data-bbox="483 1230 1516 1297">&lt;<a href="https://www.renesas.com/us/en/document/ovr/nfc-wireless-charging-wlc-product-overview?r=25426216">https://www.renesas.com/us/en/document/ovr/nfc-wireless-charging-wlc-product-overview?r=25426216</a>&gt; 2022-12-15</p> <p data-bbox="483 1339 1591 1407"><i>For example, Renesas Electronics's PTX130W/PTX30W describes "Li-Ion and Li-Polymer batteries support", which means the existence of a battery power source.</i></p>	Product features		Ultra-low power on-chip embedded core	✓	Integrated PMIC solution	✓	Integrated flexible battery charger with reverse current limiter	✓	Integrated highly efficient active rectifier	✓	Standalone mode of operation (without Host MCU)	✓	Embedded power regulation control	✓	Required PCB integration area (est.)	17 mm <sup>2</sup>	Rectification efficiency (AC to DC)	up to 92%	Energy harvesting [W]	up to 1W	Charging current range [mA]	5-250 mA	<u>Li-Ion and Li-Polymer batteries support</u>	✓	Charge status monitor	✓	On-chip over-temperature detection/protection	✓	Transparent data exchange channel	✓	Shipping mode (support for battery protection)	✓	System MCU supply output voltage, typ. [V]	1.8, 3.3 V	Battery-less power supply output	✓	JEITA support	✓	Shipping mode current consumption, typ. [nA]	25 nA	I2C clock frequency [kHz]	Up to 1 MHz	Available packages	CSP16	Temperature range [°C]	-40 to +85
Product features																																															
Ultra-low power on-chip embedded core	✓																																														
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Temperature range [°C]	-40 to +85																																														

a battery power source for supplying power to the **wireless power transfer system**;

## NFC wireless charging system consists of:

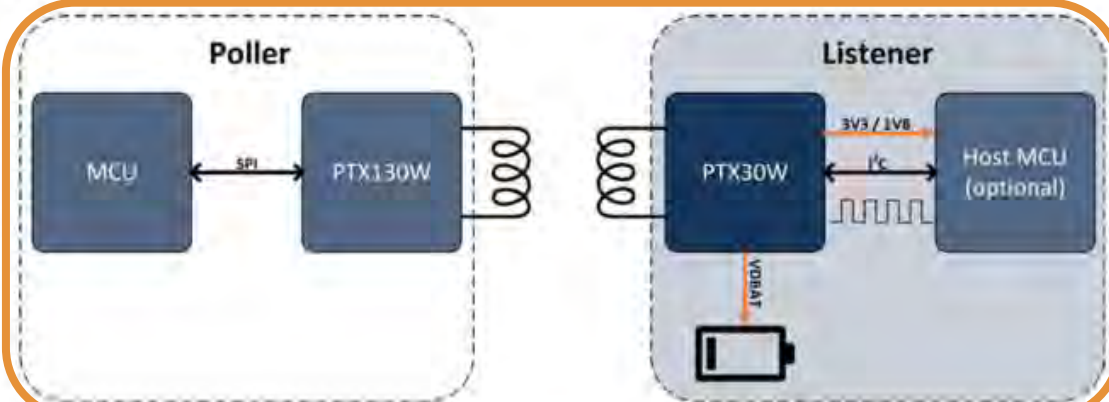
- WLC Poller (power transmitter and communication initiator)
- WLC Listener (power receiver)

NFC wireless charging solution is based on well-established NFC technology operating at 13.56MHz.

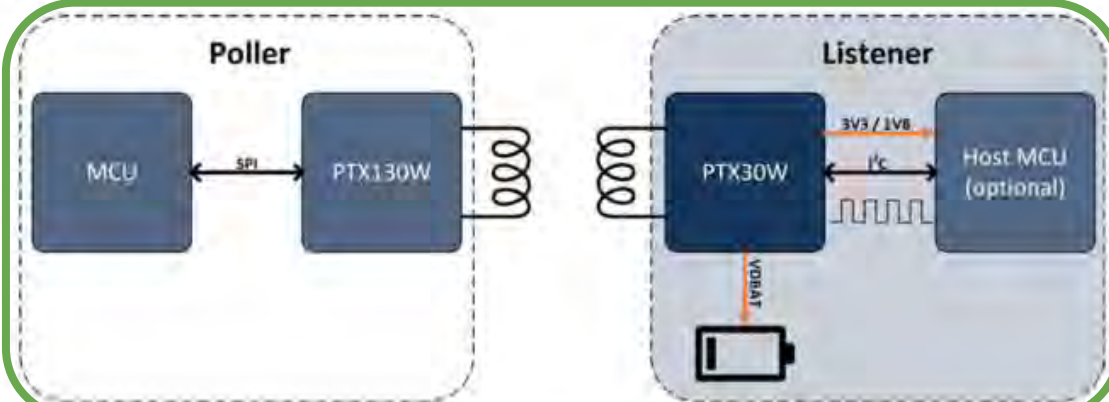


<<https://www.renesas.com/us/en/document/ovr/nfc-wireless-charging-wlc-product-overview?r=25426216>> 2022-12-15

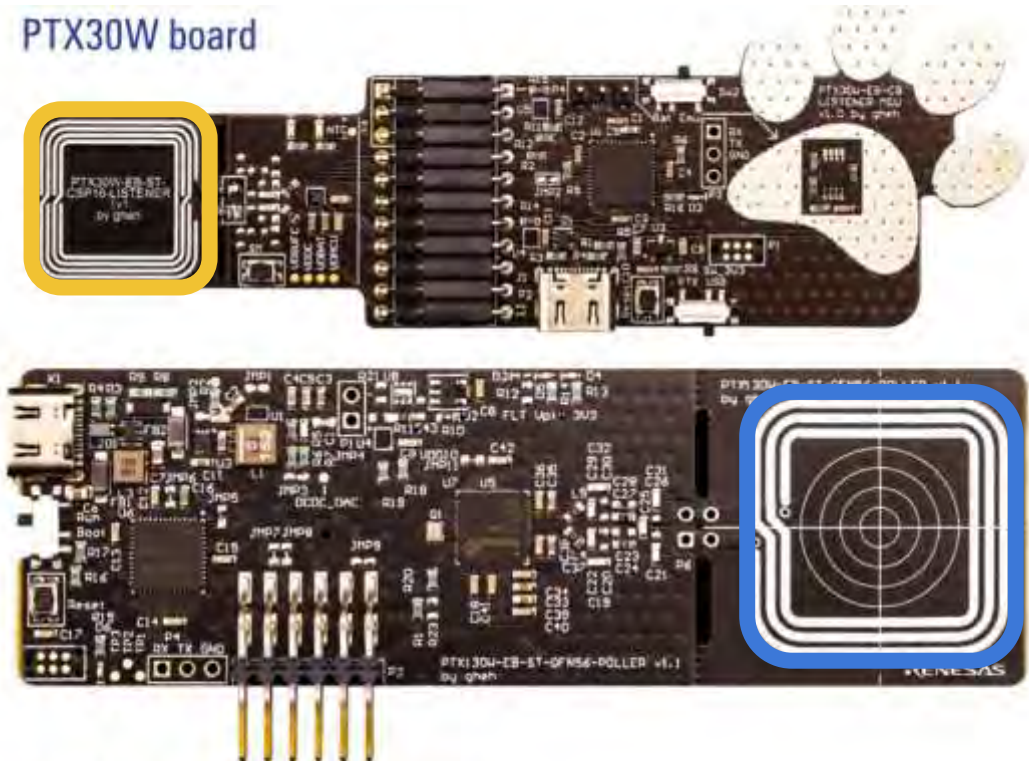
*For example, Renesas Electronics's PTX130W/PTX30W describes "Li-Ion and Li-Polymer batteries support", which means supplying power to the wireless power transfer system.*

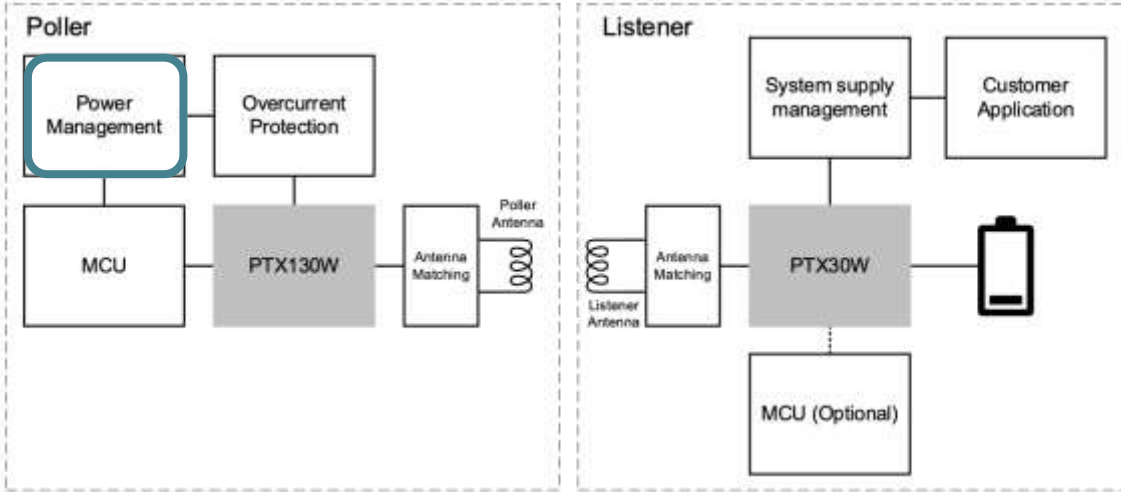
<b>US10790703</b> <b>Claim 1</b>	<b>Renesas Electronics's PTX130W/PTX30W</b>
<p><b>wireless communication circuitry</b> for establishment of a close-range wireless communication over which a <b>message</b> associated with the powered device is communicated from the powered device; and</p>	<p><b>NFC wireless charging system consists of:</b></p> <ul style="list-style-type: none"> <li>• <b>WLC Poller (power transmitter and communication initiator)</b></li> <li>• <b>WLC Listener (power receiver)</b></li> </ul> <p><b>NFC wireless charging solution is based on well-established NFC technology operating at 13.56MHz.</b></p>  <p>&lt;<a href="https://www.renesas.com/us/en/document/prb/ptx30w-nfc-wireless-charging-listener-ic-product-brief?r=25426216">https://www.renesas.com/us/en/document/prb/ptx30w-nfc-wireless-charging-listener-ic-product-brief?r=25426216</a>&gt; 2022-12-15</p> <p><i>For example, Renesas Electronics's PTX130W/PTX30W depicts and describes wireless communication circuitry for establishment of a close-range wireless communication (NFC wireless) over which a message associated with the powered device is communicated from the powered device. If there is communication, there should be exchange of messages. NFC is close-range wireless communication technology.</i></p>

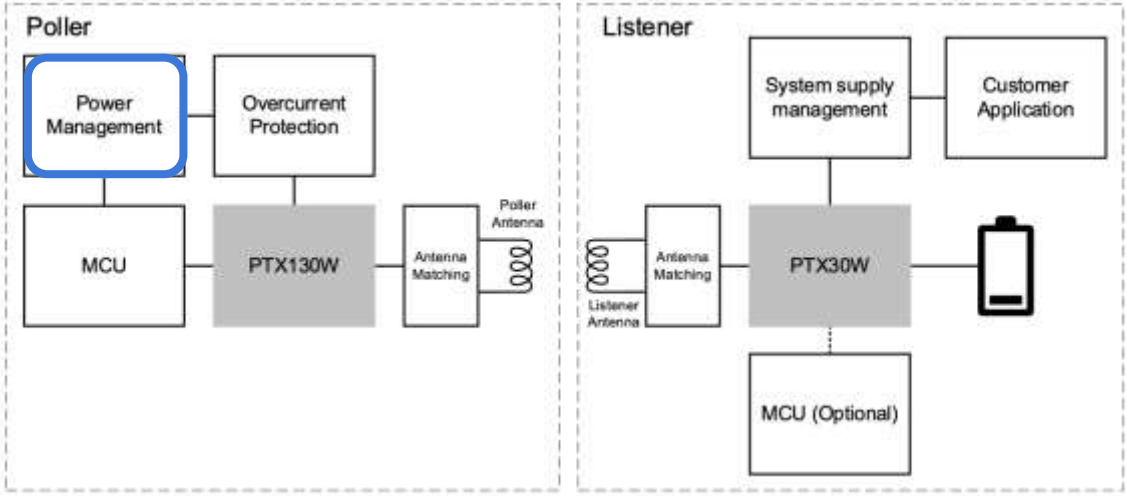


<b>US10790703</b> <b>Claim 1</b>	<b>Renesas Electronics's PTX130W/PTX30W</b>
<p><b>wireless powering circuitry</b> including a <b>transmitter</b> configured to emit electromagnetic waves to form a radiative powering region within which the electromagnetic waves can be received by wireless powered circuitry of the powered device to generate power for charging a battery in the powered device, the wireless powering circuitry being configured to be <b>activated when the close-range wireless communication is established</b>,</p>	<p><b>NFC wireless charging system consists of:</b></p> <ul style="list-style-type: none"> <li>• <u><b>WLC Poller (power transmitter and communication initiator)</b></u></li> <li>• <u><b>WLC Listener (power receiver)</b></u></li> </ul> <p><b>NFC wireless charging solution is based on well-established NFC technology operating at 13.56MHz.</b></p>  <p>&lt;<a href="https://www.renesas.com/us/en/document/prb/ptx30w-nfc-wireless-charging-listener-ic-product-brief?r=25426216">https://www.renesas.com/us/en/document/prb/ptx30w-nfc-wireless-charging-listener-ic-product-brief?r=25426216</a>&gt; 2022-12-15</p> <p><i>For example, Renesas Electronics's PTX130W/PTX30W describes WLC Poller (power transmitter and communication initiator) and WLC Listener (power receiver) which form wireless powering circuitry being configured to be activated when the close-range wireless communication is established. Transmitter and Receiver use electromagnetic waves to communicate. Charging is activated only when close-range communication is activated.</i></p>



<p><b>US10790703</b> <b>Claim 1</b></p>	<p><b>Renesas Electronics's PTX130W/PTX30W</b></p>
<p>wherein transmission power of the wireless communication circuitry is so controlled as to <b>make a range of the close-range wireless communication substantially narrower</b> than a range of the radiative powering region,</p>	<p><b>PTX30W board</b></p>  <p><b>WLC Poller (PTX130W) board</b></p> <p>&lt;<a href="https://www.renesas.com/us/en/document/mah/ptx130w-ptx30w-hardware-integration-manual?r=25426216">https://www.renesas.com/us/en/document/mah/ptx130w-ptx30w-hardware-integration-manual?r=25426216</a>&gt; 2022-12-15</p> <p><i>For example, Renesas Electronics's PTX130W/PTX30W depicts a close-range wireless communication (ABOVE, SMALL YELLOW) and a radiative powering region (BELOW, LARGE BLUE WITH CONCENTRIC CIRCLES), in which the close-range wireless communication is substantially narrower than the radiative powering region.</i></p>

<b>US10790703</b> <b>Claim 1</b>	<b>Renesas Electronics's PTX130W/PTX30W</b>
<p>wherein the <b>message is issued by the powered device when a battery level of the battery is below a predetermined threshold</b>, and the wireless powering circuitry is configured to be activated in response to receipt of the message from the powered device over the established close-range wireless communication, and</p>	<p>Using the VDDC node to supply the system requires power management on that node. The voltage present on the load is either directly the battery voltage when there is no RF field present, or a voltage roughly 300mV higher than the battery voltage, up to a maximum of 5.2V while it is charging. The limits on the VDDC current capability when driving the system are given in the datasheet.</p>  <p><a href="https://www.renesas.com/us/en/document/mah/ptx130w-ptx30w-hardware-integration-manual?r=25426216">https://www.renesas.com/us/en/document/mah/ptx130w-ptx30w-hardware-integration-manual?r=25426216</a> 2022-12-15</p> <p><i>For example, Renesas Electronics's PTX130W/PTX30W has power management which conducts "The voltage present on the load is either directly the battery voltage when there is no RF field present, or a voltage roughly 300mV higher than the battery voltage, up to a maximum of 5.2V while it is charging. The limits on the VDDC current capability when driving the system are given in the datasheet."</i></p>

<b>US10790703</b> <b>Claim 1</b>	<b>Renesas Electronics's PTX130W/PTX30W</b>
<p>wherein, when the wireless power transfer system is powered by the battery power source, a <b>determination is made whether a level of drop in a battery level of the battery power source in a given time period is below a threshold</b>, so that activation of the wireless powering circuitry is allowed only when the level of drop is determined to be below the threshold.</p>	<p>Using the VDDC node to supply the system requires power management on that node. The voltage present on the load is either directly the battery voltage when there is no RF field present, or a voltage roughly 300mV higher than the battery voltage, up to a maximum of 5.2V while it is charging. The limits on the VDDC current capability when driving the system are given in the datasheet.</p>  <p><a href="https://www.renesas.com/us/en/document/mah/ptx130w-ptx30w-hardware-integration-manual?r=25426216">https://www.renesas.com/us/en/document/mah/ptx130w-ptx30w-hardware-integration-manual?r=25426216</a> 2022-12-15</p> <p><i>For example, Renesas Electronics's PTX130W/PTX30W has power management which conducts "The voltage present on the load is either directly the battery voltage when there is no RF field present, or a voltage roughly 300mV higher than the battery voltage, up to a maximum of 5.2V while it is charging. The limits on the VDDC current capability when driving the system are given in the datasheet."</i></p>

# EXHIBIT L

ADD0936



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450 Sansome Street, Suite 1005  
San Francisco, California 94111

Jason A. Crotty  
jcrotty@mabr.com  
415.969.6918

May 31, 2024

William P. Ramey, III (wramey@rameyfirm.com)  
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5020 Montrose Blvd., Suite 800  
Houston, TX 77006

Re: *Koji IP, LLC v. Renesas Electronics America, Inc.*  
Case No. 5:24-cv-03089 (N.D. Cal.)

Dear Bill and Susan:

We understand that Koji IP has filed a *third* patent action against Renesas Electronics America, Inc. ("REA"), again alleging infringement of U.S. Patent No. 10,790,703. We previously set forth some of the numerous substantive shortcomings of Koji IP's allegations, but we never received substantive responses. Rather, Koji IP decided to twice dismiss its infringement claims. As a result, this new case is plainly barred under Federal Rule of Civil Procedure 41(a)(1)(B) and should be promptly dismissed. As detailed below, the dismissal of the second-filed action operated as an adjudication on the merits, precluding this action.

\* \* \*

Koji IP filed three patent infringement actions against REA, each asserting that certain REA products infringe claims 1-4 of the '703 patent:

- *Koji IP, LLC v. Renesas Electronics America, Inc.*, Case No. 1:23-cv-01674-SK (D. Col.) ("First Action"), filed on June 30, 2023.
- *Koji IP, LLC v. Renesas Electronics America, Inc.*, Case No. 3:23-cv-05752-LJC (N.D. Cal.) ("Second Action"), filed on November 8, 2023.
- *Koji IP, LLC v. Renesas Electronics America, Inc.*, Case No. 3:24-cv-03089-PHK (N.D. Cal.) ("Third Action"), filed on May 22, 2024.

The complaints are substantively identical and the Second and Third actions appear to be largely cut-and-paste versions of the First Action. Indeed, the complaint in the Second Action erroneously maintained personal jurisdiction and venue allegations directed to the District of Colorado, where Koji IP filed the First Action, rather than the Northern District of California.

The infringement allegations in all three complaints are repeated verbatim:

Defendant maintains, operates, and administers systems, products, and services that infringes one or more of claims 1-4 of the '703 patent, literally or under the



May 31, 2024

doctrine of equivalents. Defendant put the inventions claimed by the '703 Patent into service (i.e., used them); but for Defendant's actions, the claimed-inventions embodiments involving Defendant's products and services would never have been put into service. Defendant's acts complained of herein caused those claimed-invention embodiments as a whole to perform, and Defendant's procurement of monetary and commercial benefit from it.

After REA filed a motion to dismiss in the First Action, Koji IP filed a voluntary dismissal (D.I. 18) on September 6, 2023. Nevertheless, Koji IP filed the Second Action alleging the same infringement claims. After correspondence from REA identified substantive shortcomings of the Koji IP claims (several also identified in the motion to dismiss), Koji IP filed a voluntary dismissal (D.I. 12) in the Second Action on January 30, 2024. The dismissals are attached hereto as Exhibit 1, and they were effective upon filing. The matters were duly noted as terminated on their respective dockets.

\* \* \*

Federal Rule of Civil Procedure 41(a)(1)(A) provides that a plaintiff may voluntarily dismiss an action by filing a notice of dismissal or, where the defendant has answered or filed a motion for summary judgment, a stipulation of dismissal signed by all the parties that have appeared. Koji IP utilized this rule for its voluntary dismissals of the First and Second Actions.

Rule 41(a)(1)(B) sets forth the consequences of two dismissals:

(B) Effect. Unless the notice or stipulation states otherwise, the dismissal is without prejudice. But if the plaintiff previously dismissed any federal- or state-court action based on or including the same claim, a notice of dismissal operates as an adjudication on the merits.

This provision is known as the "two dismissal rule." See, e.g., *Commercial Space Management Co., Inc. v. The Boeing Co.*, 193 F.3d 1074, 1076 (9th Cir. 1999). The policy behind the two dismissal rule is to "eliminate the annoying of a defendant by being summoned into court in successive actions and then, if no settlement is arrived, requiring him to permit the action to be dismissed and another one commenced at leisure." *Pickman v. Am. Express Co.*, 2012 WL 258842, at \*3 (N.D. Cal. Jan. 27, 2012) (quoting *Cooter & Gell v. Hartmax Corp.*, 496 U.S. 384, 397 (1990)). In other words, the rule was designed for precisely these circumstances.

The relevant inquiry under Rule 41(a)(1)(A) is not whether the claims identified in the various complaints are exactly the same, but whether the lawsuits arise from the "same transactional nucleus of facts" such that the claims pleaded are "all grounds for recovery which could have been asserted, whether they were or not, in a prior suit between the same parties." *Owens v. Kaiser Found. Health Plan, Inc.*, 244 F.3d 708, 714 (9th Cir. 2001) (quotation marks and citation omitted).





May 31, 2024

"Thus, as long as a defendant was 'twice voluntarily dismissed under Rule 41' with respect to 'substantially the same' claims, then dismissal with prejudice is proper 'under the two dismissal rule.'" *Ruegsegger v. Caliber Home Loans, Inc.*, 2020 WL 2549934, \*1 (C.D. Cal. May 19, 2020) (quoting *Melamed v. Blue Cross of Cal.*, 557 F. App'x 659, 661-62 (9th Cir. 2014)).

As detailed above, all three cases involve the same allegation that REA products infringe claims 1-4 of the '703 patent. Accordingly, the lawsuits arise out of the "same transactional nucleus of facts." *Owens*, 244 F.3d at 714. Pursuant to the plain language of Rule 41(a)(1)(B), the two dismissal rule applies and dismissal of the Second Action operated as an "adjudication on the merits." Fed. R. Civ. P. 41(a)(1)(B).

Although the dismissal of the Second Action stated that it was without prejudice, that label is irrelevant. As the Ninth Circuit has stated: "the label a plaintiff attaches to a second Rule 41(a)(1) dismissal is irrelevant if a subsequent action is filed 'based on or including the same claim,' because Rule 41(a)(1) itself instructs that such a dismissal 'operates as an adjudication upon the merits.'" *Commercial Space Management Co., Inc.*, 193 F.3d at 1079 (quoting Fed. R. Civ. P. 41(a)(1)).

Thus, the claims in the Third Action are barred and should never have been filed in the first instance. If Koji IP has a different view, please promptly provide a detailed written explanation, with citation to relevant facts and governing law.

\* \* \*

As we previously indicated in the REA motion to dismiss the First Action (D.I. 14), and in correspondence regarding the Second Action, the substantive infringement claims against REA are also baseless. As an example, an accused product in the Third Action, the PTX30W, does not have a "battery power source," nor does it contain a "powered device" that issues "message[s]." It also does not appear to meet the limitations of the three "wherein" limitations of claim 1. Thus, there is no credible infringement claim against the PTX30W. As we previously indicated, other REA products accused of infringement by Koji IP pre-date the '703 patent, likely invalidating the asserted claims. Our prior letters and the motion to dismiss the First Action are attached hereto as Exhibit 2 and Exhibit 3, respectively. Koji IP never responded to the substantive issues raised by REA.

Koji IP was plainly aware of the manifest substantive failings of this case before it was filed, raising issues under Federal Rule of Civil Procedure 11 and 28 U.S.C. § 1927. As we have repeatedly stated, the facts strongly suggest that these cases were filed for an improper purpose: to leverage the substantial cost of litigation to obtain a modest settlement notwithstanding the absence of a meritorious claim.

\* \* \*

ADD0939





May 31, 2024

The infringement claims in these actions have been and remain frivolous and, in any event, are clearly barred under Rule 41(a)(1)(B). The Third Action should be promptly dismissed. Please again be advised that Renesas may seek to have at least this case declared “exceptional” under § 285 and it may seek its fees. See *generally EscapeX IP LLC v. Google LLC*, 2023 WL 5257691 (N.D. Cal. Aug 16, 2023).

If you have any questions, please let me know.

Sincerely,

Jason A. Crotty

ADD0940

# Exhibit 1

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

**KOJI IP, LLC,  
Plaintiff,**

**v.**

**RENESAS ELECTRONICS AMERICA,  
INC.,  
Defendant**

**Civil Action No. 1:23-cv-01674-SKC**

**JURY TRIAL DEMANDED**

**PLAINTIFF’S NOTICE OF VOLUNTARY DISMISSAL**

Pursuant to Federal Rule 41 (a)(1)(A)(ii), the Plaintiff, Koji IP, LLC hereby files this notice of dismissal of this action for all of Plaintiff’s claims against Defendant, Renesas Electronics America, Inc., as Defendant has not answered or filed a motion for summary judgment. The dismissal of Plaintiff’s claims shall be WITHOUT PREJUDICE as to the asserted patent and each party shall bear its own costs, expenses and attorneys’ fees.

Dated: September 6, 2023

Respectfully submitted,

/s/ William P. Ramey, III

William P. Ramey, III  
Texas Bar No. 24027643  
**Ramey LLP**  
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Houston, Texas 77006  
(713) 426-3923  
wramey@rameyfirm.com

*Attorneys for Koji IP, LLC*

**CERTIFICATE OF SERVICE**

The undersigned hereby certifies that September 6, 2023, the foregoing document was served on all counsel of record who have consented to electronic service via the Court's CM/ECF system per Local Rule CV-5(a)(3).

/s/ William P. Ramey, III  
William P. Ramey, III

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*Attorneys for Plaintiff*  
KOJI IP, LLC

**IN THE UNITED STATES DISTRICT COURT  
FOR THE NORTHERN DISTRICT OF CALIFORNIA**

KOJI IP, LLC,  
,

Plaintiff,

v.

RESESAS ELECTRONICS  
AMERICA, INC.,

Defendant.

Case No.: 3:23-cv-05752-LJC

**PLAINTIFF'S NOTICE OF  
VOLUNTARY DISMISSAL  
WITHOUT PREJUDICE**

**JURY TRIAL DEMANDED**

Pursuant to Federal Rule 41 (a)(1)(A)(i), the Plaintiff, Koji IP, LLC, hereby  
files this notice of dismissal of this action for all of Plaintiff's claims as Defendant  
has not answered or filed a motion for summary judgment. The dismissal of

1 Plaintiff's claims shall be WITHOUT PREJUDICE as to the asserted patent and each  
2 party shall bear its own costs, expenses and attorneys' fees.  
3

4  
5 Dated: January 30, 2024

Respectfully submitted,

6 RAMEY LLP

7  
8 /s/ Susan S.Q. Kalra

Susan S.Q. Kalra (CA State Bar No. 16740)

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16  
17  
18 /s/ William P. Ramey, III

William P. Ramey, III (pro hac vice anticipated)

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24 *Attorneys for Plaintiff*

25 *Koji IP, LLC*

## Exhibit 2





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Jason A. Crotty  
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December 22, 2023

William P. Ramey, III (wramey@rameyfirm.com)  
Susan S.Q. Kalra (skalra@rameyfirm.com)  
Ramey LLP  
5020 Montrose Blvd., Suite 800  
Houston, TX 77006

VIA EMAIL

Re: *Koji IP, LLC v. Renesas Electronics America, Inc.*  
Case No. 3:23-cv-05752-LJC (N.D. Cal.)

Counsel:

We represent Renesas Electronics America Inc. (“Renesas”) in the above-captioned case, which is a re-filed action based on a virtually identical case filed in June 2023 in the District of Colorado (Case No. 1:23-cv-01674-SKC). That case was dismissed by Koji IP after Renesas filed a motion to dismiss based on: (1) venue, and (2) substantive shortcomings regarding alleged infringement.

The re-filed action — with identical infringement allegations — may resolve the venue issue,<sup>1</sup> but the substantive issues have not and cannot be resolved. Like the first case, this action should not have been filed and should be promptly dismissed. Koji IP was plainly aware of the failings of this case — previously set forth by Renesas in the motion to dismiss in the Colorado action — before this action was filed, raising issues under Federal Rule of Civil Procedure 11 and 28 U.S.C. § 1927.

---

<sup>1</sup> Renesas is based in San Jose, so venue would be proper in the Northern District of California. However, due to obvious cut-and-paste errors, the complaint still refers to Colorado, so the allegations regarding both personal jurisdiction and venue are erroneous. See Complaint, ¶¶ 3, 5-6 (“Defendant sells and offers to sell products and services throughout Colorado, including in this judicial district, and introduces products and services that perform infringing methods or processes into the stream of commerce knowing that they would be sold in Colorado...”).

Mauriel Kapouytian Woods LLP  
December 22, 2023  
Page 2 of 7

Even putting aside the substantive shortcomings, Renesas has previously informed Koji IP that U.S. sales of the accused product are around \$5,000. There is virtually no royalty base and, therefore, no possibility of any damages award that could justify the re-filing of this matter.

These facts strongly suggest that this case was filed for an improper purpose: to leverage the substantial cost of litigation to obtain a modest settlement notwithstanding the absence of a meritorious claim.

\* \* \*

The sole asserted patent — U.S. Patent No. 10,790,703, entitled “Smart wireless power transfer between devices”) — contains four claims. Claim 1 is representative and it is reproduced below (emphasis added):

A wireless power transfer system for wirelessly charging a powered device, comprising:

- a *battery power source* for supplying power to the wireless power transfer system;
- wireless communication circuitry for establishment of a close-range wireless communication over which a message associated with the powered device is communicated from the powered device; and
- *wireless powering circuitry including a transmitter configured to emit electromagnetic waves* to form a radiative powering region within which the electromagnetic waves can be received by wireless powered circuitry of the powered device to generate power for charging a battery in the powered device, the wireless powering circuitry being configured to be activated when the close-range wireless communication is established,
- wherein transmission power of the wireless communication circuitry is so controlled as to make a range of the close-range wireless communication substantially narrower than a range of the radiative powering region,
- wherein the message is issued by the powered device when a battery level of the battery is below a predetermined threshold, and the wireless powering circuitry is configured to be activated in response to receipt of the message from the powered device over the established close-range wireless communication, and
- wherein, when the wireless power transfer system is powered by the battery power source, a determination is made whether a level of drop in a battery level of the battery power source in a given time period is below a threshold,

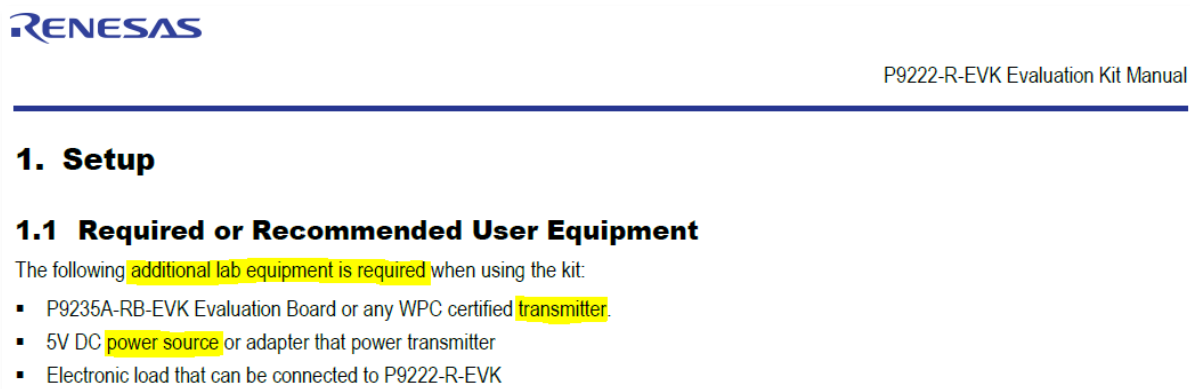
Mauriel Kapouytian Woods LLP  
 December 22, 2023  
 Page 3 of 7

so that activation of the wireless powering circuitry is allowed only when the level of drop is determined to be below the threshold.

Putting aside the remainder of the claims — much of which does not appear to be performed by the accused product — Claim 1 (and all the claims of the asserted patent) require at least a “battery power source” and “wireless powering circuitry including a transmitter.”

Thus, as set forth in the motion to dismiss in the Colorado case, to infringe Claim 1 (or any other claim), Koji IP would need to demonstrate that the accused product had both a “battery power source” and a “transmitter.” The accused product is the Renesas P9222-R-EVK Evaluation Kit, a product that allows customers and potential customers of Renesas to evaluate the features and functionality of a Renesas wireless power receiver product.

However, the P9222-R-EVK Evaluation Kit Manual relied upon by Koji IP demonstrates that neither of these components is in the accused product. Specifically, the P9222-R-EVK Manual states that “additional lab equipment is required when using the kit,” including a power supply (*i.e.*, a battery power source) and a transmitter:



<https://www.renesas.com/us/en/document/mah/p9222-r-evaluation-kit-manual>

As shown above, the accused product does not include either a “battery power supply” or a “transmitter.” Koji IP’s claim chart alleges that the P9222-R-EVK Manual “describes” a “battery power source” but does not allege that it is actually contained in the P9222-R-EVK Evaluation Kit, because it cannot plausibly be alleged. The same is true of the “transmitter.”

In short, the P9222-R-EVK Manual relied upon by Koji IP for its infringement allegations demonstrates that the accused product does *not* meet at least two limitations. Without these claimed components, the accused product cannot satisfy the limitations of any claim

Mauriel Kapouytian Woods LLP  
 December 22, 2023  
 Page 4 of 7

of the asserted patent. *See, e.g., Revolution Eyewear, Inc. v. Aspex Eyewear, Inc.*, 563 F.3d 1358, 1369 (Fed. Cir. 2009) (“Literal infringement requires that the accused device literally embodies every limitation of the claim.”); *Mas-Hamilton Grp. v. LaGard, Inc.*, 156 F.3d 1206, 1211 (Fed. Cir. 1998) (“If even one limitation is missing or not met as claimed, there is no literal infringement.”) (citations omitted); *Utto Inc. v. Metrotech Corp.*, 2022 WL 17968771, at \*5 (N.D. Cal. Oct. 4, 2022) (granting motion to dismiss when Plaintiff failed to “offer at least some factual allegation that could plausibly show that” a critical claim element was present); *Alterg, Inc. v. Boost Treadmills LLC*, 388 F. Supp. 3d 1133, 1143 (N.D. Cal. 2019) (finding direct infringement claim “inadequately pled” and granting motion to dismiss direct infringement claim where complaint lacked allegations that accused product practiced key limitation) . Accordingly, the direct infringement allegations are baseless and cannot be maintained.

Putting aside the limitations that are plainly missing, the “claim charts” attached to the complaint do not credibly allege infringement of other limitations. Those charts contain snippets of the P9222-R-EVK Manual with broad claim terms highlighted. An example is below. The charts then conclude, without analysis or explanation, that the limitation is somehow satisfied. That is accomplished by simply parroting the claim language. This is insufficient. *See, e.g., Ashcroft v. Iqbal*, 556 U.S. 662, 678 (2009) (“[A] formulaic recitation of the elements of a cause of action will not do.”) (quoting *Bell Atlantic Corp. v. Twombly*, 550 U.S. 544, 557 (2007)); *Bot M8 LLC v. Sony Corp. of Am.*, 4 F.4th 1342, 1353 (Fed. Cir. 2021) (“a plaintiff cannot assert a plausible claim for infringement under the *Iqbal/Twombly* standard by reciting the claim elements and merely concluding that the accused product has those elements”).

Mauriel Kapouytian Woods LLP  
 December 22, 2023  
 Page 5 of 7

US10790703 B2 Claim 1	Renesas Electronics's EVK Evaluation Kit
<p><b>wireless powering circuitry</b> including a <b>transmitter</b> configured to emit electromagnetic waves to form a radiative powering region within which the electromagnetic waves can be received by wireless powered circuitry of the powered device to generate power for charging a battery in the powered device, the wireless powering circuitry being configured to be <b>activated when the close-range wireless communication is established</b>,</p>	<p><b>3.4.1 Modulation Capacitor and Interrupt Enables</b></p> <p>The P9222-R sends the communication packets to the <u>transmitter</u> using ASK modulation of the coil voltage. For ASK modulation, the P9222-R switches the capacitors on and off that are on the COM1, COM2, CMA, and CMB pins using internal MOSFETs. By default, the P9222-R switches only the MOSFETs on the COM1 and COM2 pins. ASK modulation depth can be increased by enabling the switches on the CMA and CMB pins. Measure the modulation depth on the <u>transmitter</u> demodulation circuitry, and if too small, adjust the ASK modulation depth by enabling the CMA and CMB switches. <u>Modulation depth can also be increased by increasing the capacitor value.</u> The AP can also change the ASK modulation depth by writing to the ASK modulation depth Registers (0xF4).</p> <p><a href="https://www.renesas.com/us/en/document/mah/p9222-r-evaluation-kit-manual?r=32315">https://www.renesas.com/us/en/document/mah/p9222-r-evaluation-kit-manual?r=32315</a></p> <p>The reference describes wireless powering circuitry including a transmitter configured to emit electromagnetic waves to form a radiative powering region within which the electromagnetic waves can be received by wireless powered circuitry of the powered device to generate power for charging a battery in the powered device, the wireless powering circuitry being configured to be activated when the close-range wireless communication is established.</p>

Koji IP also alleges that Renesas indirectly infringes, both by inducing infringement and contributing to infringement by third parties. *See* Complaint, ¶¶ 11-12. However, both inducement and contributory infringement require a plaintiff to plead knowledge of the patent. *See, e.g., Global-Tech Appliances, Inc. v. SEB S.A.*, 563 U.S. 754, 765-66 (2011); *Sonos, Inc. v. Google LLC*, 591 F. Supp. 3d 638, 648 (N.D. Cal. 2022).

Koji IP does not assert that Renesas had any pre-complaint knowledge of the patent, alleging that Renesas has had knowledge “from at least the filing date of the lawsuit” and that Koji IP “reserves the right to amend and add inducement pre-suit if discovery reveals an earlier date of knowledge.” Moreover, both contributory and induced infringement require sufficient allegations of direct infringement.<sup>2</sup> *See, e.g., Medgraph, Inc. v. Medtronic, Inc.*, 843 F.3d 942, 948 (Fed. Cir. 2016). Additionally, there are no facts supporting an allegation that Renesas specifically intended that a third party infringe the patent and knew that the third party’s acts constituted infringement. *See, e.g., Fluidigm Corp. v. IONpath, Inc.*, 2020 WL 408988 (N.D. Cal. Jan. 24, 2020); *Aftechmobile Inc. v. Salesforce.com, Inc.*, 2020 WL

<sup>2</sup> For alleged induced infringement, Koji IP also fails to plead facts plausibly supporting a claim that the accused product does not have non-infringing uses. *See, e.g., Uniloc U.S.A., Inc. v. Logitech, Inc.*, 2018 WL 6025597 (N.D. Cal. Nov. 17, 2018) (granting motion to dismiss where plaintiff “fail[ed] to provide factual underpinnings for its allegations that there are no substantial noninfringing uses of the accused devices”).

Mauriel Kapouytian Woods LLP  
December 22, 2023  
Page 6 of 7

6129139 (N.D. Cal. Sept. 2, 2020), *aff'd*, 853 F. App'x 669 (Fed. Cir. 2021). Thus, any claims of pre-complaint indirect infringement must be dismissed.<sup>3</sup>

As we have indicated, sales of the accused product over the last six years amount to approximately \$5,000. Excluding the pre-notice alleged infringement would reduce that number substantially, resulting in a potential royalty base that would not even justify the filing fee for this action, let alone continued litigation.

We have identified only the substantive shortcomings that are obvious upon a cursory review of the complaint and the P9222-R-EVK Manual. The claims of the patent are unusual, and we do not believe, for example, that the accused product performs most of the wherein clauses of Claim 1.

\* \* \*

We believe this action is similar in many respects to *EscapeX IP LLC v. Google LLC*, 2023 WL 5257691 (N.D. Cal. 2023).<sup>4</sup> In that case, Judge Chhabria stated: “This was, in short, an effort to force a modest settlement by pestering a tech giant with a frivolous suit on the assumption that the tech giant will prefer to capitulate than fight back.” Not only did the Court grant Google’s motion to award fees under 35 U.S.C. § 285, it pointedly stated that the “attorneys for EscapeX are lucky that Google did not separately ask the Court to impose sanctions on them.” *Id.*

In this case, Koji IP knows about the substantive shortcomings from Renesas’s motion to dismiss in the prior Colorado action, and we have previously informed Koji IP that sales of the accused product are trivial. Nevertheless, Koji IP filed a new action based on the same inadequate allegations and *de minimis* potential exposure. The new complaint is riddled with obvious cut-and-paste errors and is substantively deficient.

Please be advised that if this matter moves forward, Renesas will seek to have this case declared “exceptional” under § 285 and it will seek its fees.

---

<sup>3</sup> The complaint also alleges no facts whatsoever regarding the theories of indirect infringement, but the law requires factual allegations. *See, e.g., Lifetime Indus., Inc. v. Trim-Lok, Inc.*, 869 F.3d 1372, 1379 (Fed. Cir. 2017) (“For an allegation of induced infringement to survive a motion to dismiss, a complaint must plead facts plausibly showing that the accused infringer specifically intended another party to infringe the patent and knew that the other party’s acts constituted infringement.”).

<sup>4</sup> *See also Verna IP Holdings, LLC v. Alert Media, Inc.*, 2023 WL 5918320 (W.D. Tex. 2023).



Mauriel Kapouytian Woods LLP  
December 22, 2023  
Page 7 of 7

\* \* \*

If Koji IP does not immediately dismiss this action, please promptly provide a detailed written response to the substantive issues raised in this letter, including citation to relevant facts and case law.

If you would like to discuss any of these issues, please give me a call.

Sincerely,

*Jason A. Crotty*





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January 18, 2024

William P. Ramey, III (wramey@rameyfirm.com)  
Susan S.Q. Kalra (skalra@rameyfirm.com)  
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Houston, TX 77006

Re: *Koji IP, LLC v. Renesas Electronics America, Inc.*  
Case No. 3:23-cv-05752-LJC (N.D. Cal.)

Dear Bill:

Koji IP has suggested that it will serve infringement contentions against additional Renesas products (RX111, ISL1801 and PTX30W). To date, Koji IP has failed to provide any claim charts or analysis to substantiate this supposed infringement.

Nevertheless, even a cursory analysis indicates that any such claims would be frivolous, again raising substantial concerns that this case was filed for an improper purpose: to leverage the substantial cost of litigation to obtain a modest settlement notwithstanding the absence of a meritorious claim.

None of the RX111, ISL1801 and PTX30W products include any of the wireless charging requirements of the claims (e.g., “battery power source” and “transmitter,” among others). Thus, there does not appear to be any plausible direct infringement case against these products. Nor is there any evidence of indirect infringement. Moreover, the RX111 and ISL1801 products were both on the market *before* the Koji IP provisional application was filed in December 2016. Attached are data sheets for the RX111 (May 2016) and the ISL1801 (July 2014) products. Even if there were somehow a viable direct infringement claim against them, the datasheets would be invalidating prior art.

These additional “accused” products appear to have been selected not because they plausibly include the limitations of the claims, but rather because they can be leveraged to expand the potential exposure to Renesas to encourage some sort of settlement. Because there are no credible infringement arguments against any of these products, however, there cannot be any non-frivolous claims directed towards them.

As we have previously stated, this action should not have been filed and should be promptly dismissed. Koji IP was plainly aware of the manifest failings of this case — previously set forth by Renesas in the motion to dismiss in the Colorado action — before this action was filed, raising issues under Federal Rule of Civil Procedure 11 and 28 U.S.C. § 1927. This case cannot be salvaged by casually asserting infringement by products that cannot infringe, especially products that would be prior art to the patent-in-suit.



William P. Ramey, III  
January 18, 2024

We note that Koji IP has not provided a written response to the numerous issues we raised in our prior letter, further indicating the lack of substantive merit. If Koji IP has a substantive response to the issues raised in this and our prior letter, please put that response in writing, with citation to relevant law and facts, and we will consider it.

Otherwise, please be again advised that if this matter moves forward, Renesas will seek to have this case declared “exceptional” under § 285 and it will seek its fees. *See generally EscapeX IP LLC v. Google LLC*, 2023 WL 5257691 (N.D. Cal. 2023). However, the best resolution of this case continues to be voluntary dismissal by Koji IP.

If you have any questions, please let me know.

Sincerely,

Jason A. Crotty

# Exhibit 3

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

Civil Action No. 1:23-cv-01674-SKC

KOJI IP, LLC,

Plaintiff,

v.

RENESAS ELECTRONICS AMERICA, INC.,

Defendant.

---

**DEFENDANT RENESAS ELECTRONICS AMERICA, INC.'S MOTION  
TO DISMISS PLAINTIFF'S ORIGINAL COMPLAINT FOR PATENT  
INFRINGEMENT**

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## **TABLE OF CONTENTS**

I. INTRODUCTION.....	1
II. FACTUAL BACKGROUND .....	2
III. LEGAL STANDARD.....	5
IV. ARGUMENT .....	7
A. By Basing Its Claim for Venue on the Address of an REA Sales Representative, Koji’s Venue Assertion Fails .....	7
B. Because the Accused Product Lacks Two Limitations, Koji’s Direct Infringement Allegations Must Be Dismissed .....	9
C. With No Allegations of Pre-Suit Knowledge, All Pre-Suit Indirect Infringement Claims Should Be Dismissed.....	9
V. CONCLUSION.....	11
CERTIFICATE OF COMPLIANCE .....	12

## TABLE OF AUTHORITIES

<b>Cases</b>	<b>Page(s)</b>
<i>Alvarado v. KOB-TV, L.L.C.</i> , 493 F.3d 1210 (10th Cir. 2007) .....	7, 9
<i>Behegen v. Amateur Basketball Ass’n of U.S.A.</i> , 744 F.2d 731 (10th Cir. 1984) .....	5
<i>BLAX Corp. v. Motorola Solutions, Inc.</i> , No. 10-cv-03013-PAB-KLM, 2012 WL 502727 (D. Col. Feb. 15, 2012) .....	6-7
<i>Bovino v. Levenger Co.</i> , No. 14-cv-00122-RM-KLM, 2015 WL 1064082 (D. Col. Mar. 9, 2015) .....	10
<i>Dental Monitoring SAS v. Align Technology, Inc.</i> , No. C 22-07335, 2023 WL 4297570 (N.D. Cal. June 30, 2023) .....	10
<i>GFF Corp. v. Associated Wholesale Grocers, Inc.</i> , 130 F.3d 1381 (10th Cir. 1997) .....	7
<i>Global-Tech Appliances, Inc. v. SEB S.A.</i> , 563 U.S. 754 (2011) .....	9
<i>H&amp;H Transformer, Inc. v. Battelle Energy All., L.L.C.</i> , No. 09-cv-00442-WYD-BNB, 2009 WL 3530370 (D. Colo. Oct. 23, 2009) .....	5
<i>Hildebrand v. Wilmar Corp.</i> , No. 17-cv-02821-PAB-MEH, 2018 WL 1535505 (D. Col. Mar. 29, 2018) .....	8
<i>In re Cray Inc.</i> , 871 F.3d 1355 (Fed. Cir. 2017) .....	6, 8
<i>Indus. Constructors Corp. v. U.S. Bureau of Reclamation</i> , 15 F.3d 963 (10th Cir. 1994) .....	7
<i>Laitram Corp. v. Rexnord, Inc.</i> , 939 F.2d 1533 (Fed. Cir. 1991) .....	6
<i>Mas-Hamilton Grp. v. LaGard, Inc.</i> , 156 F.3d 1206 (Fed. Cir. 1998) .....	6, 9
<i>Nagim v. Jackson</i> , No. 10-cv-00328-PAB-KLM, 2010 WL 4318896 (D. Colo. Aug. 10, 2010) .....	5

<i>Sonos, Inc. v. Google LLC</i> , 591 F. Supp. 3d 638 (N.D. Cal. 2022) .....	5-7
<i>TC Heartland, LLC v. Kraft Foods Grp. Brands, LLC</i> , 581 U.S. 258 (2017) .....	5-7
<i>Tex. Instruments Inc. v. Cypress Semiconductor Corp.</i> , 90 F.3d 1558 (Fed. Cir. 1996) .....	6
<i>TMJ Implants, Inc. v. Aetna, Inc.</i> , 498 F.3d 1175 (10th Cir. 2007) .....	7
<b>Statutes</b>	
28 U.S.C. § 1391 .....	2, 5
28 U.S.C. § 1400 .....	2, 5-8
<b>Rules</b>	
Fed. R. Civ. P. 12(b)(6) .....	1, 7
Fed. R. Civ. P. 12(b)(3) .....	1, 5, 8



Defendant Renesas Electronics America, Inc. (“REA” or “Renesas”), by and through the undersigned counsel, hereby moves to dismiss the action filed by Plaintiff Koji IP, LLC (“Koji IP”) for improper venue pursuant to Federal Rule of Civil Procedure Rule 12(b)(3) and/or for failure to state a claim upon which relief can be granted pursuant to Federal Rule of Civil Procedure 12(b)(6).

## **I. INTRODUCTION**

REA is a California corporation with headquarters in the San Francisco Bay Area. The Complaint erroneously alleges that REA is located at the address of an REA sales representative located in Colorado. REA informed Koji IP of this error, but it insisted that its venue allegations were proper. Because REA is not located at the address set forth in the Complaint, venue is improper, and the case should be dismissed pursuant to Rule 12(b)(3).

Additionally, the patent infringement allegations are insufficient. It is black letter law that to be found liable for direct infringement, REA’s accused product must meet each limitation of an asserted claim. The document on which Koji IP bases its infringement allegations demonstrates that the accused product cannot directly infringe any claim of the asserted patent because it does not come with (*i.e.*, is missing) at least two limitations required by each claim in the asserted patent. Thus, the direct infringement allegations should be dismissed with prejudice, as amendment would be futile. Under no circumstances could Koji IP amend its complaint to include allegations that these missing limitations are met by the accused product.

Finally, Koji IP alleges that REA induced infringement and contributed to the infringement by third parties, but it provides no factual support for these theories. Further, Koji IP implicitly acknowledges that it has no evidence of pre-complaint knowledge of the asserted patent. As a result, the pre-complaint allegations of indirect infringement must also be dismissed.

## **II. FACTUAL BACKGROUND**

REA is a semiconductor company incorporated in California with headquarters in the San Francisco Bay Area. (See O'Sullivan Decl., ¶ 2.) The Complaint states: “On information and belief, Defendant is a corporation organized and existing under the laws of the State of CA, with a regular and established place of business located [a]t 2181 So. Grape St., Denver, CO 80222.” (Complaint (Dkt. No. 1), ¶ 2.) As to venue, the complaint states: “Defendant has committed acts of infringement and has a regular and established place of business in this District.” (*Id.*, ¶ 6.)<sup>1</sup>

The Denver address cited by Koji IP appears to have been divined from the REA website, which identifies third-party distributors and sales representatives. As set forth below, the Denver address is that of a sales representative, AKI GIBB.

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<sup>1</sup> The Complaint also makes allegations regarding venue under 28 U.S.C. § 1391(b). As set forth below, the Supreme Court has squarely held that venue in patent cases is *exclusively* governed by 28 U.S.C. § 1400, so the allegations under other provisions are irrelevant.

https://www.renesas.com/us/en/buy-sample/locations

## Sales Locations

Country / Region  
- Any -

Type  
☐ Distributor  
☐ Sales Representative  
☐ Value Added Reseller

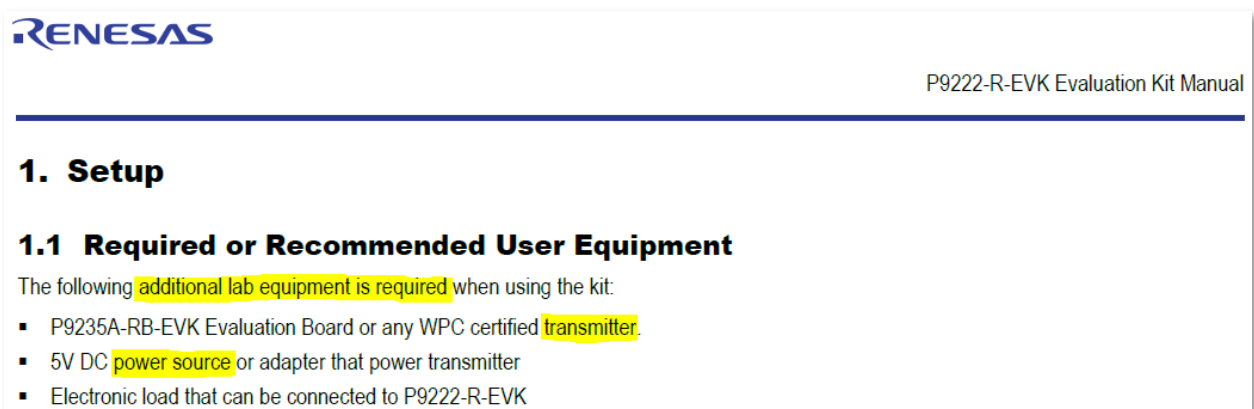
Apply

Location	Description	Contact Info	Type
Mountain US	<b>AKI GIBB</b> Colorado & Wyoming: 2181 So. Grape St Denver, CO 80222  Utah, Idaho, Montana: 4252 Cresthaven Ln. Lehi, UT 84043	Colorado & Wyoming: Phone: 303 756 0700 Fax: 303 756 3135  Utah, Idaho, Montana: Phone: 303 756 0700 Fax: 303 756 3135  Web: <a href="http://www.akigibb.com">www.akigibb.com</a> Contact: <a href="mailto:info@akigibb.com">info@akigibb.com</a>	Sales Representative

The relationship between AKI GIBB and REA is governed by a Sales Representative Agreement which states that the relationship is that of “principal and selling representative.” (O’Sullivan Decl., ¶ 5.) The agreement states that AKI GIBB is an independent contractor and not an employee or agent of REA. (*Id.*) REA does not own or control AKI GIBB, nor does it have any say in the day-to-day operations of AKI GIBB. (*Id.*, ¶ 6.) REA does not own or lease the AKI GIBB facility and does not have employees at AKI GIBB. (*Id.*)

As to infringement, the Complaint alleges that REA: (1) directly infringes and (2) induces and contributes to infringement by unspecified third parties. (See Complaint, ¶¶ 9-12.) The Complaint includes a perfunctory claim chart that purports to allege infringement of Claim 1 by the Renesas P9222-R-EVK evaluation kit (“P9222”). (See Complaint, Ex. B (Dkt. No. 1-2).) The claim chart relies exclusively on the REA manual for the P9222 (“P9222 Manual”) and includes an internet link to that document. (See *id.*)

Claim 1 (and in fact each claim of the asserted patent) requires, among other limitations, a “**battery power source**” and “wireless powering circuitry including **a transmitter** configured to emit electromagnetic waves to form a radiative powering region.” (See Complaint, Ex. A (Dkt. No. 1-1) at pg 69 of 70 (emphasis added).) Thus, to infringe Claim 1 or any other claim of the asserted patent, Koji IP would need to demonstrate that the accused product had both a battery power source and a transmitter. However, the P9222 Manual relied upon by Koji IP demonstrates that neither of these components is included in the accused product. Specifically, the P9222 Manual states that “**additional lab equipment is required** when using the kit,” **including a power supply (i.e., a battery power source) and a transmitter.**



(See Crotty Decl., Ex. A at 5) (emphasis added).)

As shown above, the P9222 does not include either a power supply or a transmitter. Koji IP’s claim chart alleges that the P9222 Manual “describes” a “battery power source” but does not allege that it is actually contained in the P9222. (See Complaint, Ex. B at 3.) The same is true of the “transmitter.” (See *id.* at 4.)

Koji IP alleges that REA induced infringement or contributed to infringement by its customers but does not allege that REA was aware of the asserted patent before the complaint was filed. (See Complaint, ¶¶ 11-12.) Instead, Koji IP simply states that it “reserves the right to amend and add inducement pre-suit if discovery reveals an earlier date of knowledge” other than the date of filing of the Complaint. (See *id.*, ¶ 11, n.1.)

### III. LEGAL STANDARD

“The standard under 12(b)(3) is generally the same as a motion to dismiss for lack of personal jurisdiction.” *H&H Transformer, Inc. v. Battelle Energy All., L.L.C.*, No. 09-cv-00442-WYD-BNB, 2009 WL 3530370, at \*3 (D. Colo. Oct. 23, 2009). Thus, the plaintiff bears the burden of making a prima facie showing that venue is proper. See *Behegen v. Amateur Basketball Ass’n of U.S.A.*, 744 F.2d 731, 733 (10th Cir. 1984); *Nagim v. Jackson*, No. 10-cv-00328-PAB-KLM, 2010 WL 4318896, at \*2 (D. Colo. Aug. 10, 2010).

The Supreme Court has unequivocally held that 28 U.S.C. § 1400(b) exclusively governs venue determinations in patent infringement cases. See *TC Heartland, LLC v. Kraft Foods Grp. Brands, LLC*, 581 U.S. 258, 266 (2017) (“§ 1400(b) ‘is the sole and exclusive provision controlling venue in patent infringement actions, and is not to be supplemented by § 1391(c).’” (citation omitted)). Section 1400(b) provides that venue is proper “in the judicial district where the defendant resides, or where the defendant has committed acts of infringement and has a regular and established place of business.” 28 U.S.C. § 1400(b).

The Supreme Court has held that, “[a]s applied to domestic corporations, ‘residence’ in § 1400(b) refers only to the State of incorporation.” *TC Heartland*, 581 U.S. at 270. Establishing venue under the “regular and established place of business” provision entails three requirements: “(1) there must be a physical place in the district; (2) it must be a regular and established place of business; and (3) it must be the place of the defendant.” *In re Cray Inc.*, 871 F.3d 1355, 1360 (Fed. Cir. 2017). The first element requires “a physical, geographical location in the district from which the business of the defendant is carried out.” *Id.* at 1362. To meet the second requirement, the business must operate in a permanent and steady manner. *See id.* at 1362–63. The final element requires that the defendant “establish or ratify the place of business.” *Id.* at 1363.

To establish liability for direct infringement, “the accused . . . process must contain every limitation of the asserted claim.” *Tex. Instruments Inc. v. Cypress Semiconductor Corp.*, 90 F.3d 1558, 1563 (Fed. Cir. 1996) (citing *Laitram Corp. v. Rexnord, Inc.*, 939 F.2d 1533, 1535 (Fed. Cir. 1991)). “If even one limitation is missing or not met as claimed, there is no literal infringement.” *Mas–Hamilton Grp. v. LaGard, Inc.*, 156 F.3d 1206, 1211 (Fed. Cir. 1998) (citations omitted).

After *Twombly/Iqbal*, courts require that allegations of indirect infringement plead facts regarding knowledge of the patent (for both inducement and contributory infringement) and substantial non-infringing use (for contributory infringement). *See, e.g., BIAx Corp. v. Motorola Solutions, Inc.*, No. 10–cv–03013–PAB–KLM, 2012 WL

502727, at \*3 (D. Col. Feb. 15, 2012) (collecting cases). Conclusory allegations that merely parrot the statutory language are insufficient. See *id.*

In evaluating a Rule 12(b)(6) motion to dismiss, courts may consider not only the complaint itself, but also attached exhibits and documents incorporated into the complaint by reference. See *Indus. Constructors Corp. v. U.S. Bureau of Reclamation*, 15 F.3d 963, 964–65 (10th Cir. 1994); *TMJ Implants, Inc. v. Aetna, Inc.*, 498 F.3d 1175, 1180 (10th Cir. 2007). “[T]he district court may consider documents referred to in the complaint if the documents are central to the plaintiff's claim and the parties do not dispute the documents' authenticity.” *Alvarado v. KOB-TV, L.L.C.*, 493 F.3d 1210, 1215 (10th Cir. 2007) (internal quotation and citation omitted). “[F]actual allegations that contradict ... a properly considered document are not well-pleaded facts that the court must accept as true.” *GFF Corp. v. Associated Wholesale Grocers, Inc.*, 130 F.3d 1381, 1385 (10th Cir. 1997).

#### **IV. ARGUMENT**

##### **A. By Basing Its Claim for Venue on the Address of an REA Sales Representative, Koji's Venue Assertion Fails**

Koji IP does not allege that REA “resides” in Colorado (nor could it, as it is a California corporation). The Supreme Court has held that “residence” in § 1400(b) refers only to the State of incorporation. See *TC Heartland*, 581 U.S. at 269.

Thus, the only plausible ground for venue in Colorado is if REA has “a regular and established place of business” in the state. 28 U.S.C. § 1400(b). Koji IP erroneously alleges that REA is located at the business address of one of its sales representatives. (See Complaint, ¶ 2.) Broadly speaking, sales representatives make

sales calls to generate new business, handle purchase orders that come in from customers in the territory and relay those purchase orders to REA. (O’Sullivan Decl., ¶ 4.) But they do not buy products or store products for REA. (*Id.*)

AKI GIBB is a manufacturer's sales representative serving the OEM market in the Rocky Mountain Region and a separate company from REA. (See *id.*, ¶ 5.) The REA-AKI GIBB relationship is governed by a Sales Representative Agreement. (*Id.*) Under that agreement, the relationship is that of “principal and selling representative” and under the agreement AKI GIBB is an independent contractor and not an employee or agent of REA. (*Id.*) REA does not own or control AKI GIBB, nor does it have any say in the day-to-day operations of AKI GIBB. (*Id.*, ¶ 6.) Moreover, REA does not own or lease the AKI GIBB facility. (*Id.*) Nor does REA have employees at AKI GIBB. (*Id.*)

Accordingly, AKI GIBB’s facilities are not a regular and established place of business of REA. See *In re Cray Inc.*, 871 F.3d at 1363 (“‘the regular and established place of business’ must be ‘the place of the defendant.’” (citing 28 U.S.C. § 1400)); *Hildebrand v. Wilmar Corp.*, No. 17–cv–02821–PAB–MEH, 2018 WL 1535505, at \*4 (D. Col. Mar. 29, 2018) (“the physical locations of [defendant’s] distributors do not constitute [defendant’s] places of business.”). Nor has REA ratified the AKI GIBB place of business as its own. See *In re Cray Inc.*, 871 F.3d at 1363. Because AKI GIBB’s facilities are not a regular and established place of business of REA, Koji IP’s venue allegations fail, and the Complaint should be dismissed pursuant to Rule 12(b)(3).



## **B. Because the Accused Product Lacks Two Limitations, Koji's Direct Infringement Allegations Must Be Dismissed**

As set forth above, each claim of the asserted patent requires, among other limitations, a “battery power source” and “wireless powering circuitry including a transmitter configured to emit electromagnetic waves to form a radiative powering region.” (Complaint, Ex. A at pg. 69 of 70.) The P9222 Manual used by Koji IP for its infringement allegations demonstrates that the accused product does not have either of these limitations.<sup>2</sup> (See Crotty Decl., Ex. A.) The P9222 Manual states that “additional lab equipment is required when using the kit,” ***including a power supply (i.e., a battery) and a transmitter.*** (See *id.* at 5 (emphasis added).) Without these components, the accused product cannot satisfy the limitations of *any* claim of the asserted patent. Accordingly, the direct infringement allegations must be dismissed. See, e.g., *Mas–Hamilton Grp.*, 156 F.3d at 1211 (“If even one limitation is missing or not met as claimed, there is no literal infringement.”) (citations omitted).

## **C. With No Allegations of Pre-Suit Knowledge, All Pre-Suit Indirect Infringement Claims Should Be Dismissed**

Both inducement and contributory infringement require a plaintiff to plead knowledge of the patent. See *Global-Tech Appliances, Inc. v. SEB S.A.*, 563 U.S. 754,

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<sup>2</sup> The P9222 Manual was extensively cited in the Koji IP claim chart, attached as Exhibit B to the Complaint (Dkt. No. 1-2), and an internet link to it was also included in the chart. Accordingly, the P9222 Manual is central to the infringement claims and its authenticity cannot be disputed. Thus, the court can consider the P9222 Manual in its entirety as to this motion. See, e.g., *Alvarado*, 493 F.3d at 1215 (10th Cir. 2007) (“[T]he district court may consider documents referred to in the complaint if the documents are central to the plaintiff's claim and the parties do not dispute the documents' authenticity.” (internal quotation and citation omitted)).

765-66 (2011) (holding that “induced infringement under § 271(b) requires knowledge that the induced acts constitute patent infringement” just as allegations of contributory infringement under § 271(c) require knowledge); *Sonos, Inc. v. Google LLC*, 591 F. Supp. 3d 638, 648 (N.D. Cal. 2022) (granting motion to dismiss on the issue of indirect infringement finding that “provision of a massive, pre-filing copy of the complaint one day prior to filing it in Texas” was inadequate to satisfy the knowledge requirement for indirect infringement); *Dental Monitoring SAS v. Align Technology, Inc.*, No. C 22-07335, 2023 WL 4297570, at \*7 (N.D. Cal. June 30, 2023) (granting motion to dismiss indirect infringement claims, noting that “sending a notice letter [which was not sent in this case] is an easy, cost-effective way to establish knowledge . . .”).

Koji IP does not allege that REA had any pre-complaint knowledge of the asserted patent, alleging in the Complaint the REA has had knowledge “from at least the filing date of the lawsuit” and that Koji IP “reserves the right to amend and add inducement pre-suit if discovery reveals an earlier date of knowledge.” (Complaint, ¶¶ 11-12; *id.*, ¶ 11, n.1.) Thus, the claims of pre-complaint indirect infringement must be dismissed. See, e.g., *Bovino v. Levensger Co.*, No. 14-cv-00122-RM-KLM, 2015 WL 1064082, at \*4 (D. Col. Mar. 9, 2015) (“Because Plaintiff fails to plead any facts as to Defendant's knowledge prior to the filing of the Complaint, any claim as to induced infringement which occurred prior to the filing of the Complaint is not adequately pled and fails to state a claim.”).

## V. CONCLUSION

For the reasons set forth above, the allegations regarding venue in Colorado are inadequate and the Complaint should be dismissed for improper venue. Additionally, the direct infringement allegations must be dismissed because the accused products lack components required to meet each limitation of each claim of the asserted patent. Lastly, the pre-complaint indirect infringement claims must be dismissed because there are no allegations that REA had knowledge of the asserted patent.

Respectfully submitted,

s/ Jason A. Crotty

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### **CERTIFICATE OF COMPLIANCE**

In compliance with D.C.COLO..LPtR 17, the undersigned states that there are 2,603 words in this brief, which does not exceed the 10,000 words, double spaced, in Arial 12-point font limit for dispositive motions.

Dated: August 25, 2023

s/ Jason A. Crotty  
**Jason A. Crotty**

### **CERTIFICATE OF SERVICE**

I hereby certify that a true and correct copy of the foregoing was electronically filed on August 25, 2023, with the Clerk of Court using the CM/ECF system, which will send notification of such filing to the following email address:

William P. Ramey, III  
littigation@rameyfirm.com

s/ Jason A. Crotty

**Jason A. Crotty**