

DUANE H. MATHIOWETZ (SBN 111831)
dmathiwetz@mffmlaw.com
MORGAN FRANICH FREDKIN SIAMAS & KAYS LLP
333 W. San Carlos Street, Suite 1050
San Jose, California 95110
Telephone: (408) 288-8288
Facsimile: (408) 288-8325

KEITH A. RABENBERG (pro hac vice TBF)
Keith.Rabenberg@stinson.com
JOHN R. SCHROEDER (pro hac vice TBF)
John.Schroeder@stinson.com
STINSON LLP
7700 Forsyth Boulevard, Suite 1100
St. Louis, Missouri 63105
Telephone: 314.863.0800
Facsimile: 314.863.9388

Attorneys for Plaintiffs Columbia Insurance Co. and
MiTEk Inc.

UNITED STATES DISTRICT COURT
NORTHERN DISTRICT OF CALIFORNIA

COLUMBIA INSURANCE, CO., and MITEK
INC,

Plaintiffs,

v.

SIMPSON STRONG-TIE COMPANY INC.,

Defendant.

Case No.

**COMPLAINT FOR PATENT
INFRINGEMENT**

DEMAND FOR JURY TRIAL

COMPLAINT

Plaintiffs Columbia Insurance Co. (“Columbia”) and MiTek Inc. (f/k/a MiTek USA, Inc.) (“MiTek”) (collectively “Plaintiffs”), for their Complaint against Defendant Simpson Strong-Tie Company Inc. (“Simpson”), state as follows:

PARTIES

1. Plaintiff Columbia is incorporated under the laws of Nebraska having a principal place of business in Omaha, Nebraska.

2. Plaintiff MiTek is incorporated under the laws of Missouri having a principal place of business in Chesterfield, Missouri.

3. Upon information and belief, Defendant Simpson is incorporated under the laws of California having a principal place of business located at 5956 W. Las Positas Boulevard, Pleasanton, California 94588.

JURISDICTION AND VENUE

4. This is an action for patent infringement under 35 U.S.C. § 271. The Court has subject matter jurisdiction under 28 U.S.C. §§ 1331 and 1338(a).

5. The Court has personal jurisdiction over Simpson in that Simpson is a California corporation with its principal place of business located in Pleasanton, California.

6. Venue is proper in this District under 28 U.S.C. §§ 1391(c) and 1400(b) because Simpson has committed acts of infringement and has a regular and established place of business in this District.

PATENT-IN-SUIT

7. On June 11, 2019, the United States Patent and Trademark Office duly and legally issued U.S. Patent No. 10,316,510 (“the ‘510 patent”), entitled “Hanger for Fire Separation Wall.” A copy of the ‘510 patent is attached as Exhibit A.

8. The ‘510 patent issued from U.S. Patent Application No. 16/225,517 (“the ‘517 application”).

9. Columbia is the owner of the ‘510 patent and holds all rights to sue for past, present, and future infringement of the ‘510 patent.

10. MiTek is the exclusive licensee of the ‘510 patent.

FACTS

11. Among other products, MiTek manufactures and sells hangers used in the construction of buildings and structures for connecting structural components (e.g., trusses or joists) to wall framing.

12. Often, fire separation walls are required in structures, such as in multifamily housing, to prevent fires from spreading between adjoining units.

13. Typically, fire-retardant sheathing, such as gypsum board, is used along the face of the fire separation walls to improve the wall’s resistance to fire.

14. Trusses and joists cannot be hung from the fire-retardant sheathing and, instead, must be hung from the wall framing.

15. When using traditional hangers for connecting trusses and joists to wall framing, to allow the trusses or joists to be hung from the wall framing, cutouts were required in the fire-retardant sheathing for the entire cross sections of the trusses or joists.

16. The cutout for an entire cross section of a truss or joist creates a large discontinuity in the fire-retardant sheathing, thus decreasing the wall’s resistance to fire.

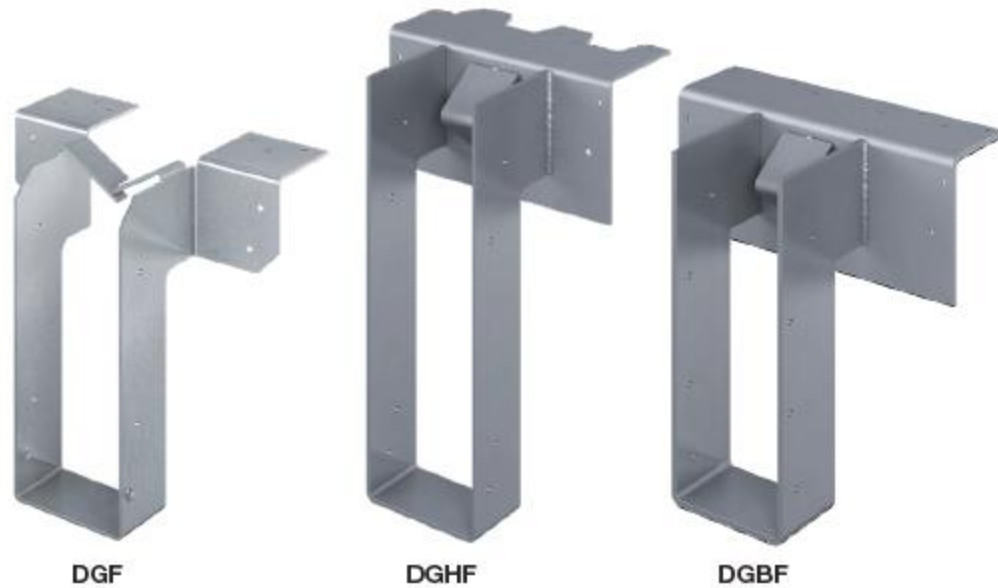
17. The ‘510 patent pertains to an improvement in hangers for connecting trusses and joists to wall framing, whereby the truss hanger includes (1) a channel-shaped portion configured to receive the structural component, (2) an extension portion extending from channel-shaped portion and configured to extend through the sheathing, and (3) a connection portion configured for attachment to the top surface of the plate of a wall.

18. The extension portion, as claimed in the ‘510 patent, spaces the channel-shaped portion and the connection portion apart by a distance sized large enough to permit the fire-retardant sheathing to be received between the channel-shaped portion and the connection portion.

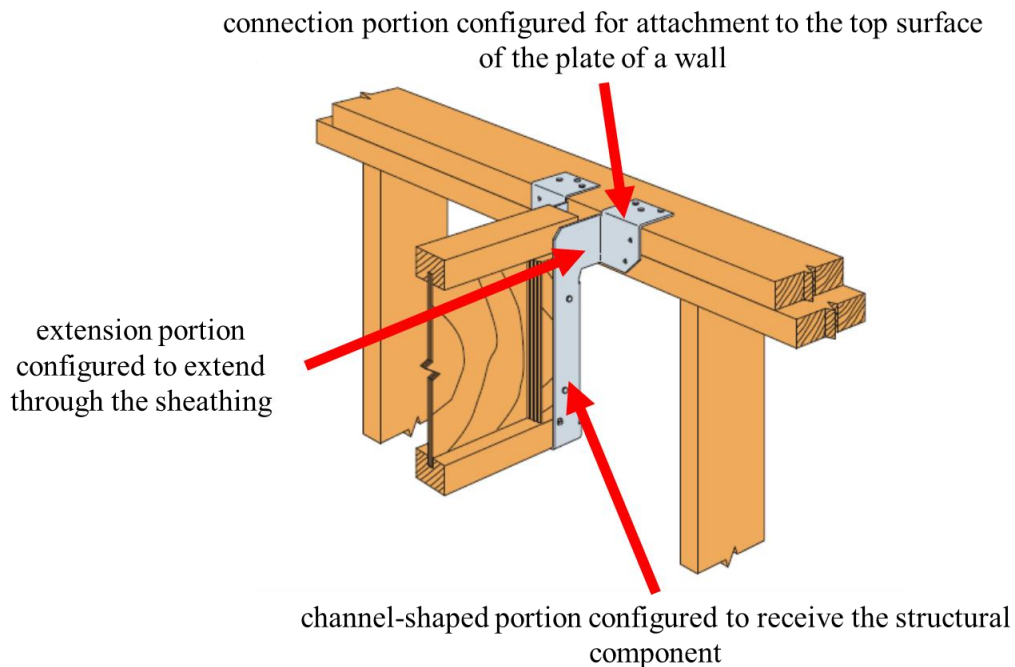
19. On information and belief, Simpson has made, used, sold, or offered for sale Strong-Tie Fire Wall Hangers that are adapted for connecting a trusses and joist to walls.

20. On information and belief, Simpson’s Strong-Tie Fire Wall Hangers are available in three models: DGF, DGHF, and DGBF. The DGF, DGHF, and DGBF models of Simpson’s Strong-

Tie Fire Wall Hangers are shown as follows:



21. Simpson's Strong-Tie Fire Wall Hangers (DGF model shown below) include a channel-shaped portion configured to receive the structural component, an extension portion extending from channel-shaped portion and configured to extend through the sheathing, and a connection portion configured for attachment to the top surface of the plate of a wall.



22. In a letter dated May 28, 2019, Columbia's counsel notified Simpson that the claims of the '517 application had been allowed and identified that the DGF, DGHF, and DGBF models of Simpson's Strong-Tie Fire Wall Hangers fell within the scope of the allowed claims.

23. The May 28, 2019 letter suggested that Simpson "immediately arrange to stop selling and offering for sale the DGF, DGHF and DGBF Fire Wall Hangers by June 11, 2019, as well as any others that infringe [the claims of the '510 patent that were to issue from the '517 application]."

COUNT I

Infringement of U.S. Patent No. 10,316,510

24. Plaintiffs incorporate by reference Paragraphs 1 through 23 above, as if fully set forth herein.

25. On information and belief, the DGF, DGHF, and DGBF models of Simpson's Strong-Tie Fire Wall Hangers infringe at least claims 1, 13, and 20 of the '510 patent.

26. On information and belief, Simpson directly infringes at least claims 1, 13, and 20 of the '510 patent under 35 U.S.C. § 271(a) by making, using, selling, or offering for sale the DGF, DGHF, and DGBF models of Simpson's Strong-Tie Fire Wall Hangers within the United States.

27. Simpson was on notice that the '510 patent would grant eminently no later than when Simpson received the May 28, 2019 letter.

28. On information and belief, Simpson's infringement has been knowing and willful.

29. Plaintiffs are without an adequate remedy at law and will be irreparably harmed if the Court does not enter an order enjoining Simpson from infringing the '510 patent.

PRAYER FOR RELIEF

WHEREFORE, Columbia and MiTek request that the Court enter judgment against Defendant Simpson and respectfully pray that the Court enter an order:

A. Finding that Defendant Simpson has directly infringed U.S. Patent No. 10,316,510 under 35 U.S.C. § 271(a);

B. Finding that Defendant Simpson's infringement has been willful;

C. Enjoining Defendant Simpson and its respective officers, agents, servants, employees, and attorneys, and all of those persons in active concert or participation with any of them

1 from directly or indirectly infringing any claim of U.S. Patent No. 10,316,510;

2 D. Awarding compensatory damages to Plaintiffs under 35 U.S.C. § 284;

3 E. Trebling the damage award under 35 U.S.C. § 284;

4 F. Awarding Plaintiffs pre-judgment and post-judgment interest;

5 G. Finding this to be an exceptional case under 35 U.S.C. § 285 and awarding Plaintiffs
6 their reasonable attorneys' fees and expenses in this action;

7 H. Awarding Plaintiffs their costs in this action; and

8 I. Awarding such other and further relief as the Court deems just and proper.

9 **DEMAND FOR JURY TRIAL**

10 Under Rule 38(b) of the Federal Rules of Civil Procedure, Columbia and MiTek demand a
11 trial by jury of all issues so triable.

12
13 Dated: August 12, 2019

Respectfully submitted,

14
15 By: /s/ Duane H. Mathiowetz

Duane H. Mathiowetz

dmathiowetz@mffmlaw.com

16 MORGAN, FRANICH, FREDKIN SIAMAS &
17 KAYS LLP

333 W. San Carlos Street, Suite 1050

San Jose, California 95110

18 Telephone: (408) 288-8288

19 Facsimile: (408) 288-8325

20 Keith A. Rabenberg

Keith.Rabenberg@stinson.com

21 John R. Schroeder

John.Schroeder@stinson.com

22 STINSON LLP

7700 Forsyth Boulevard, Suite 1100

23 St. Louis, Missouri 63105

24 Telephone: 314.863.0800

25 Facsimile: 314.863.9388
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