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ZEP SOLAR, INC., TRINA SOLAR (U.S.), INC.,
8 and CHANGZHOU TRINA SOLAR ENERGY CO., LTD

9 UNITED STATES DISTRICT COURT
10 NORTHERN DISTRICT OF CALIFORNIA
11 SAN FRANCISCO DIVISION

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CV 11 3800

13 ZEP SOLAR, INC., a California
14 Corporation; TRINA SOLAR (U.S.), INC.,
15 a Delaware Corporation; and
16 CHANGZHOU TRINA SOLAR ENERGY
CO., LTD, a People's Republic of China
Corporation,

17 Plaintiffs,

18 vs.

19 WESTINGHOUSE SOLAR, INC.
(formerly known as AKEENA SOLAR,
20 INC.), a Delaware corporation, and
ANDALAY SOLAR, INC., a California
21 Corporation,

22 Defendants.

Case No. CV _____

**COMPLAINT FOR DECLARATORY
JUDGMENT OF NON-INFRINGEMENT
AND INVALIDITY OF U.S. PATENT
NUMBER 7,987,641**

DEMAND FOR JURY TRIAL

1 **INTRODUCTION**

2 Plaintiffs Zep Solar, Inc. (“Zep”), Trina Solar (U.S.), Inc. and Changzhou Trina Solar
3 Energy Co., Ltd (Trina entities referred to collectively as “Trina”) bring this action for a
4 declaration of non-infringement and invalidity of U.S. Patent Number 7,987,641 (the “Patent-in-
5 Suit”). Defendants Westinghouse Solar, Inc. (“Westinghouse,” formerly known as Akeena Solar,
6 Inc.) and Andalay Solar, Inc. (“Andalay”) have made many assertions of infringement against
7 Zep, Trina and other Zep licensees regarding the Patent-in-Suit. Indeed, there is ongoing
8 litigation already underway in this District regarding a related patent against Zep and a
9 distribution partner. *See* Case No. CV 09 5040 JSW (N.D. Cal.) (“Related Action”).

10 In light of Defendants’ campaign of threats and actual litigation, there exists a case or
11 controversy regarding the Patent-in-Suit. Defendants’ claims of infringement and threats
12 regarding the Patent-In-Suit are tactics to gain leverage in the marketplace by hanging a black
13 cloud over Zep in order to scare away licensees like Trina. There is no doubt that the parties have
14 a very real controversy. Defendants Westinghouse and Andalay have already sued Zep once in
15 the Related Action pending before Honorable Judge White, and have repeatedly threatened to do
16 so again by asserting the Patent-in-Suit. This dispute is accordingly appropriate for adjudication.

17 **COMPLAINT FOR DECLARATORY JUDGMENT**

18 Plaintiffs Zep and Trina assert the following claims against Defendants Westinghouse
19 Solar, Inc. and Andalay Solar, Inc.:

20 **NATURE OF THE ACTION**

21 1. This is an action for a declaratory judgment of non-infringement and invalidity,
22 arising under the Declaratory Judgment Act, 28 U.S.C. § 2201, *et seq.* and the Patent Laws of the
23 United States, 35 U.S.C. § 1 *et seq.* Zep seeks a declaration of non-infringement and invalidity
24 regarding U.S. Patent No. 7,987,641 (attached hereto as Exhibit A).
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1 **THE PARTIES**

2 2. Plaintiff Zep is a California corporation with its principal place of business in San
3 Rafael, California.

4 3. Plaintiff Trina Solar (U.S.), Inc. is a Delaware corporation with its principal place
5 of business in San Jose, California.

6 4. Plaintiff Changzhou Trina Solar Energy Co., Ltd is a People's Republic of China
7 corporation with its principal place of business in Changzhou, Jiangsu, People's Republic of
8 China.

9 5. Upon information and belief, Defendant Westinghouse is a Delaware corporation
10 with its principal place of business in Campbell, California.

11 6. Upon information and belief, Defendant Andalay is a California corporation with
12 its principal place of business in Campbell, California. Upon information and belief, Andalay is a
13 wholly owned subsidiary of Westinghouse.

14 **JURISDICTION (Civil L.R. 3-5(a)) AND VENUE**

15 7. This action arises under the Federal Declaratory Judgments Act, 28 U.S.C. §§
16 2201 and 2202 for a declaration that pursuant to the Patent Laws of the United States, 35 U.S.C. §
17 1 *et seq.*, that the claims of U.S Patent 7,987,641 are not infringed and are invalid.

18 8. This Court has subject matter jurisdiction under 28 U.S.C. §§ 1331, 1338(a) in that
19 this is a civil action arising out of the patent laws of the United States of America. This Court
20 also has subject matter jurisdiction under 28 U.S.C. §§ 2201 and 2202, because as shown below,
21 under all the circumstances, there is a real, immediate, definite, concrete, and substantial
22 controversy between Zep and Trina on one hand, and Westinghouse and Andalay on the other
23 hand, which requires specific relief, and these parties have adverse legal interests regarding patent
24 non-infringement and invalidity. On information and belief, together Defendant Westinghouse
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1 and its wholly-owned subsidiary Andalay have sufficient rights to prosecute a suit for
2 infringement of the Patent-In-Suit.

3 9. This Court has personal jurisdiction over Defendant Westinghouse because, on
4 information and belief, Westinghouse has its corporate headquarters and principal place of
5 business within this judicial district, and has engaged in substantial business within this forum
6 amounting to sufficient minimum contacts, including, but not limited to advertising, marketing,
7 and selling products to customers within or into California and this judicial district, as well as
8 employing personnel and/or representatives within this judicial district. Defendant Westinghouse
9 also has submitted to the personal jurisdiction of this Court by filing suit in and appearing in this
10 Court under its former name, Akeena Solar, in Case No. CV 09 5040 JSW.

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12 10. This Court has personal jurisdiction over Defendant Andalay because, on
13 information and belief, Andalay has its corporate headquarters and principal place of business
14 within this judicial district, and has engaged in substantial business within this forum amounting
15 to sufficient minimum contacts, including, but not limited to advertising, marketing, and selling
16 products to customers within or into California and this judicial district, as well as employing
17 personnel and/or representatives within this judicial district. Defendant Andalay also has
18 submitted to the personal jurisdiction of this Court by filing suit and appearing in this Court, in
19 Case No. CV 09 5040 JSW.

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21 11. Venue in this Court is proper pursuant to 28 U.S.C. §§ 1391(b) and (c) and
22 1400(b) because a substantial part of the events giving rise to Zep's and Trina's claims occurred
23 in this district and because Defendants reside in this district pursuant to 28 U.S.C. § 1391(c).
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1 Jack West, the C.T.O. of Zep Solar, alleging that Zep's product, described as the "Zep System for
2 solar module racking," "is covered by Andalay's patents and numerous pending patent
3 applications." That letter specifically cited the already issued U.S. Patent Number 7,406,800
4 (asserted in the Related Action), as well as U.S. Patent Application Number 2007/0295393, which
5 has issued as the Patent-In-Suit. Defendants asserted that then-pending application "cover[s] the
6 specific aspects of the solar module mounting and grounding system contained in the Zep System
7 product." That letter demanded that Zep "must immediately stop the sale or offer of sale of the
8 Zep System product," threatened that Zep may be liable for royalties dating back to 2004 and that
9 Zep may be subject to a preliminary injunction. That letter stated that Defendants had analyzed
10 Zep's product and referred any inquiries to Westinghouse's inside general counsel. Soon
11 thereafter, Defendants' outside attorneys sent a similar letter to Jeffrey Wolfe, the CEO of one of
12 Zep's business associates Global Resource Options, Inc. ("groSolar"), forwarding Defendants'
13 earlier letter and accusing groSolar of also infringing Defendants' "intellectual property."

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16 17. In October 2009, following through on its various threats, Defendants proved their
17 willingness to file suit against Zep and any of its licensees by initiating an action against Zep and
18 groSolar alleging infringement of U.S. Patent Number 7,406,800, which is closely related to the
19 Patent-in-Suit. *See* Related Action (Northern District of California Case No. CV 09 5040 JSW.)
20 That case is presently stayed pending completion of a reexamination in the U.S.P.T.O. *See* Order
21 Granting Defendants' Motion To Stay, Docket No. 54; Order Denying Plaintiff's Motion To Lift
22 Stay, Docket No. 75.

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24 18. Defendants' threats against Zep and its licensees have persisted since they initiated
25 the Related Action. Recently, outside counsel for Defendants again wrote to counsel for Zep and
26 referenced, "[a]s a reminder," patent application number 2007/0295393, the specific patent
27 application that issued as the Patent-In-Suit, and alleged that the now-patent covers "specific
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1 aspects of the solar module mounting and grounding system.” That letter stated “We hope that
2 your client’s infringement of Andalay’s intellectual property will stop immediately.”

3 19. Trina is a licensee of Zep’s “Zep System,” which Defendants have claimed is
4 covered by its patents and applications, including specifically the patent application that issued as
5 the Patent-In-Suit. Defendants’ CEO Barry Cinnamon approached Trina’s U.S. Vice President of
6 Sales in April of this year and discussed with him the possibility of various negative
7 consequences of Trina’s cooperation with Zep. Mr. Cinnamon was also observed during the
8 recent Intersolar trade conference, which was held in San Francisco, California, from July 12-14,
9 2011, taking a number of pictures of the Zep/Trina offering in the Trina booth. Based on
10 Defendants’ assertions and insinuations that the Zep System infringes, Trina is now faced with
11 the decision of ceasing what it considers to be lawful activity, or facing a lawsuit.
12

13 20. Defendants have made similar assertions to other of Zep’s business associates and
14 licensees claiming that they are infringing Defendants’ purported intellectual property. On April
15 13, 2010, Westinghouse and Andalay proved their willingness to bring infringement claims
16 against Zep licensees by attempting to add as a defendant in the Related Action Canadian Solar,
17 Inc. (“CSI”), a Zep licensee. *See* Motion For Leave to File First Amended Complaint; Docket
18 No. 52. In a December 2010 letter Defendants claimed that CSI infringed another patent, and
19 also specifically referenced the then-pending application that has now issued as the Patent-In-
20 Suit, claiming that it covers “specific aspects of the solar module mounting and grounding
21 system.” On the same day Defendants sent a similar letter to another one of Zep’s business
22 associates, Upsolar America, Inc., alleging that Upsolar infringes “Andalay’s patents” by virtue
23 of the sale of products containing “a Zep solar frame,” and alleged that the application that issued
24 as the Patent-In-Suit “cover[s] specific aspects of the solar module mounting and grounding
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1 system.” That letter requested that Upsolar’s alleged “infringement of Andalay’s intellectual
2 property” “stop immediately.”

3 21. Accordingly, a substantial controversy of sufficient immediacy and reality exists
4 between Zep and Trina on one hand, and Defendants on the other, as to whether the Zep System
5 infringes any valid and enforceable claims of the Patent-In-Suit to warrant the issuance of a
6 declaratory judgment.
7

8 **COUNT I**

9 **DECLARATORY JUDGMENT OF NON-INFRINGEMENT**
10 **OF THE PATENT-IN-SUIT**

11 22. The allegations of paragraphs 1-21 of this Complaint are incorporated by reference
12 as though set forth in full herein.

13 23. The charges of infringement against Zep and Trina of the Patent-In-Suit and the
14 threats of suit have created an actual and justiciable controversy between Plaintiffs Zep and Trina
15 on one hand, and Defendants on the other, concerning whether Plaintiffs infringe any claim of the
16 Patent-in-Suit.
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18 24. Plaintiffs Zep and Trina do not infringe and have not infringed the Patent-in-Suit.

19 25. Accordingly, Plaintiffs Zep and Trina are entitled to and request a declaratory
20 judgment ruling that they do not infringe the Patent-in-Suit and granting Zep and Trina all other
21 declaratory relief to which they may be entitled.
22

23 **COUNT II**

24 **DECLARATORY JUDGMENT OF INVALIDITY**
25 **OF THE PATENT-IN-SUIT**

26 26. The allegations of paragraphs 1-25 of this Complaint are incorporated by reference
27 as though set forth in full herein.
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DATED: August 2, 2011

FARELLA BRAUN + MARTEL LLP

By: 
Jeffrey M. Fisher

Attorneys for Defendant
ZEP SOLAR, INC. AND TRINA SOLAR
(U.S.), INC., and CHANGZHOU TRINA
SOLAR ENERGY CO., LTD

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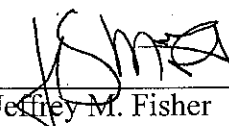
JURY DEMAND

Plaintiffs Zep Solar, Inc., Trina Solar (U.S.), Inc. and Changzhou Trina Solar Energy Co.,
Ltd demand a trial by jury on all issues presented herein.

Respectfully submitted,

DATED: August 2, 2011

FARELLA BRAUN + MARTEL LLP

By: 
Jeffrey M. Fisher

Attorneys for Defendant
ZEP SOLAR, INC. AND TRINA SOLAR
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