

**Majority Opinion** >

UNITED STATES DISTRICT COURT FOR THE  
SOUTHERN DISTRICT OF NEW YORK

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ADASA INC., Plaintiff, -against- R-PAC  
INTERNATIONAL LLC (f/k/a R-Pac International  
Corp., and f/k/a RIC Merger Sub LLC),  
Defendant.

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24 Civ. 6102 (AKH)

December 3, 2024, Filed

December 3, 2024, Decided

For Adasa Inc., Plaintiff: Glenn Orman, PRO  
HAC VICE, Jonathan Suder, Richard Wojcio, Jr,  
Friedman, Suder & Cooke, Fort Worth, TX;  
William J. Pinilis, William J. Pinilis, Esq.,  
Morristown, NJ.

For R-Pac International LLC, formerly known as,  
R-Pac International Corp., formerly known as,  
RIC Merger Sub LLC, Defendant: Ramsey M. Al-  
Salam, LEAD ATTORNEY, Perkins Coie LLP,  
Seattle, WA; Gene W. Lee, Perkins Coie LLP,  
New York, NY; Stevan Stark, Seattle, WA.

ALVIN K. HELLERSTEIN, United States District  
Judge.

ALVIN K. HELLERSTEIN

**ORDER  
DENYING  
MOTION TO**

**DISMISS**

ALVIN K. HELLERSTEIN, U.S.D.J.:

Defendant moves to dismiss Plaintiff's patent  
infringement complaint, averring that Plaintiff has  
not stated a claim upon which relief may be  
granted. I deny Defendant's motion.

To survive a motion to dismiss under **Fed. R.  
Civ. P. 12(b)(6)**, "a complaint must contain  
sufficient factual matter, accepted as true, to  
'state a claim to relief that is plausible on its  
face.' *Ashcroft v. Iqbal*, **556 U.S. 662**, 678  
(2009) (quoting *Bell Atl. Corp. v. Twombly*, **550  
U.S. 544**, 570 (2007)). In evaluating the  
complaint, I must "accept all well-pleaded factual  
allegations in the complaint as true" and  
"construe all reasonable inferences in the light  
most favorable to the plaintiff." *Lynch v. City of  
New York*, **952 F.3d 67**, 74-75 (2d Cir. 2020)  
(citation omitted).

I hold that Plaintiff has properly pleaded direct  
infringement. Federal law provides that "whoever  
without authority makes, uses, offers to sell, or  
sells any patented invention, within the United  
States . . . infringes the patent." **35 U.S.C. §  
271(a)**. Notwithstanding the presumption against  
extraterritoriality, even if an infringing product is  
made or used abroad, it is nonetheless covered  
under the statute's ambit if "a substantial level of  
sales activity" occurred "within the United  
States." *Carnegie Mellon Univ. v. Marvell Tech.  
Grp.*, **807 F.3d 1283**, 1309-10 (Fed. Cir. 2015).  
Here, Plaintiff's well-pleaded complaint—which I

must accept as true—alleges that Defendant operates more than a dozen sales offices across the U.S., Compl. ¶ 67; that its infringing products are sold and offered for sale in the U.S. irrespective of where they are physically produced or encoded, *id.* at ¶¶ 67, 74; that orders are routed to Defendant's domestic offices and servers to generate and transmit encoding data, *id.* at ¶ 70; that order information is directed to U.S.-based offices for invoicing, *id.* at ¶ 71; and that Defendant's employees negotiate agreements with customers—including product specifications—in the U.S., *id.* at ¶ 72. The foregoing is sufficient, at this stage, to properly plead direct infringement.

I also hold that Plaintiff has properly pleaded inducement and contributory infringement. See **35 U.S.C. § 271(b)**, (c). "In order to succeed on a claim of inducement, the patentee must show, first that there has been direct infringement, and second that the alleged infringer knowingly induced infringement and possessed specific intent to encourage another's infringement." *Enpias Display Device Corp. v. Seoul Semiconductor Co.*, **909 F.3d 398**, 407 (Fed. Cir. 2018) (citation omitted). And "to succeed on a claim of contributory infringement, in addition to proving an act of direct infringement, plaintiff must show that defendant knew that the combination for which its components were especially made was both patented and infringing and that defendant's components have no substantial non-infringing uses." *Lucent Techs. v. Gateway, Inc.*, **580 F.3d 1301**, 1320 (Fed. Cir. 2009) (internal citation and quotations omitted). Plaintiff has satisfied these strictures. Here, Plaintiff has not only properly pleaded

direct infringement, but has also satisfactorily alleged Defendant's knowledge, see Compl. at ¶ 85, and intent, see *id.* at ¶¶ 81-83, 89. And Plaintiff has also adequately pleaded how "the combination for which its components were especially made was both patented and infringing," see *id.* at ¶¶ 41-63, 70, as well as how Defendant's components lack a substantial non-infringing use, see *id.* at ¶ 79, sufficient to survive a motion to dismiss. Accordingly, I deny Defendant's motion to dismiss in its entirety.

No later than fourteen (14) days from the entry of this Order, Defendant shall file its answer to the complaint. See **Fed. R. Civ. P. 12(a)(4)(A)**. After issue is drawn, the parties shall follow the procedure outlined in Section 2(g) of my Individual Rules regarding a hearing pursuant to *Markman v. Westview Instruments, Inc.*, **517 U.S. 370** (1996).

The Clerk shall terminate ECF No. 21.

SO ORDERED.

Dated: December 3, 2024

New York, New York

/s/ Alvin K. Hellerstein

ALVIN K. HELLERSTEIN

United States District Judge

## General Information

<b>Case Name</b>	Adasa Inc. v. R-Pac Int'l LLC
<b>Court</b>	U.S. District Court for the Southern District of New York
<b>Date Filed</b>	Tue Dec 03 00:00:00 EST 2024
<b>Parties</b>	ADASA INC., Plaintiff, -against- R-PAC INTERNATIONAL LLC (f/k/a R-Pac International Corp., and f/k/a RIC Merger Sub LLC), Defendant.
<b>Topic(s)</b>	Civil Procedure; Patent Law