

U.S. Patent Nos. 7,119,716 (“the ’716 Patent”), 7,319,414 (“the ’414 Patent”), 7,479,899 (“the ’899 Patent”), 7,482,952 (“the ’952 Patent”), and 7,876,239 (“the ’239 Patent”) (collectively, the “Patents-in-Suit”); and (ii) each of the asserted claims of the Patents-in-Suit are invalid pursuant to 35 U.S.C. §§ 101, 102, 103, and/or 112. True and correct copies of the ’716, ’414, ’899, ’952, and ’239 patents are attached as Exhibits A-E, respectively.

THE PARTIES

3. Plaintiff FedEx Services is a corporation organized under the laws of Delaware and having a principal place of business at 3610 Hacks Cross Road, Building A, Memphis, Tennessee, 38120.

4. FedEx Services operates combined sales, marketing, administrative, and information-technology (“IT”) functions in shared service operations that support the transportation business segments that operate under the FedEx brand.

5. FedEx Services operates in this judicial district, including maintenance of sales offices in Conley, Georgia and Atlanta, Georgia.

6. Upon information and belief, Defendant Eclipse IP LLC is a corporation organized under the laws of Florida, having a principal place of business at 115 NW 17th Street, Delray Beach, Florida, 33444.

7. Upon information and belief, Eclipse's registered agent and managing member is Pete A. Sirianni III. Eclipse's registered corporate address in Delray Beach, Florida is, according to Palm Beach County tax records, a single-family house in a residential neighborhood purportedly owned by Mr. Sirianni.

8. Upon information and belief, Eclipse is the owner by assignment of the right, title and interest of at least seventeen issued United States Patents, including the Patents-in-Suit.

9. Upon information and belief, Eclipse is a nonpracticing patent entity and does not manufacture, produce, and/or sell any products or services.

JURISDICTION AND VENUE

10. This Court has jurisdiction over the subject matter of this action pursuant to 28 U.S.C. §§ 1331 and 1338, and the Declaratory Judgment Act, 28 U.S.C. §§ 2201 and 2202 based on federal question jurisdiction.

11. This court has personal jurisdiction over the Defendant pursuant to the laws of the State of Georgia, including Georgia's long-arm statute, OCGA § 9-10-91.

12. Eclipse consented to personal jurisdiction in this Judicial District in a case involving four of the five Patents-in-Suit. *United Parcel Service, Inc. v. Eclipse IP LLC*, Case No. 1:11-cv-02138-CAP, Dkt. No. 27, ¶11.

13. Upon information and belief, Scott A. Horstemeyer, the named inventor and assignor of the Patents-in-Suit to Eclipse, resides in this Judicial District. Mr. Horstemeyer and his law firm, Thomas Horstemeyer, LLP, also located in this Judicial District, prosecuted the Patents-in-Suit.

14. Upon information and belief, Mr. Horstemeyer entered into an agreement with Eclipse in this Judicial District in order to assign the Patents-in-Suit to Eclipse.

15. Upon information and belief, Mr. Horstemeyer is an agent, principal, owner, and/or beneficiary of Eclipse.

16. Venue is proper in this Court pursuant to 28 U.S.C. §§ 1391 and 1400.

THE PATENTS-IN-SUIT

17. The '716 Patent is titled "Response Systems and Methods for Notification Systems for Modifying Future Notifications," and was filed on November 12, 2003. The '716 Patent is attached as Exhibit A.

18. The '414 Patent is titled "Secure Notification Message Systems and Methods Using Authentication Indicia," and was filed on June 2, 2004. The '414 Patent is attached as Exhibit B.

19. The '899 Patent is titled "Notification Systems and Methods Enabling A Response to Cause Connection Between a Notified PCD and a Delivery or

Pickup Representative,” and was filed June 2, 2004. The ’899 Patent is attached as Exhibit C.

20. The ’952 Patent is titled “Response Systems and Methods for Notification Systems for Modifying Future Notifications,” and was filed August 29, 2006. The ’952 Patent is attached as Exhibit D.

21. The ’239 Patent is titled “Secure Notification Messaging Systems and Methods Using Authentication Indicia,” and was filed October 26, 2007. The ’239 Patent is attached as Exhibit E.

**ECLIPSE THREATS AND LITIGATION AGAINST FEDEX SERVICES’
CUSTOMERS**

22. On or about March 11, 2011, Matthew G. McAndrews of the law firm Niro Haller & Niro, counsel for Eclipse, sent a letter to Larry Wilcher, General Counsel for Bass Pro, Inc., demanding that Bass Pro pay a license fee of \$150,000 in exchange for a license to all of Eclipse’s patents, including the Patents-in-Suit. A true and correct copy of that letter is attached hereto as Exhibit F.

23. In the letter sent to Bass Pro, Eclipse alleged that Bass Pro’s information systems infringe the Patents-in-Suit, in particular through email notifications that include “an embedded hyperlink that allows a customer to track

the progress of a shipment” by communicating with “a second party having access to particulars of the pickup or delivery,” e.g., FedEx Services. *See* Exhibit F.

24. Bass Pro is a FedEx Services customer and uses IT services from FedEx Services; Bass Pro uses those services in electronic shipment notifications that it provides to its customers. *See* Exhibit F.

25. On or about January 13, 2012, Matthew S. Harman of the law firm Harman Law LLC, counsel for Eclipse, sent a letter to Todd Morris, Chief Executive Officer of BrickHouse Security, demanding that BrickHouse pay a license fee of \$95,000 in exchange for a license to all of Eclipse’s patents, including the Patents-in-Suit. A true and correct copy of that letter is attached hereto as Exhibit G.

26. In the letter sent to BrickHouse, Eclipse alleged that BrickHouse’s information systems infringe the Patents-in-Suit, in particular through email notifications that include hyperlinks to FedEx Services systems for the retrieval of shipment information—“messaging and responding to information associated with orders and shipments,” according to Eclipse. *See* Exhibit G.

27. On June 5, 2012, Eclipse filed a patent-infringement lawsuit before the United States District Court for the Western District of North Carolina against Brickhouse Electronics, LLC d/b/a Brickhouse Security, (the “Eclipse I

litigation”), alleging that Brickhouse infringed, actively induced, and/or contributed to the infringement by others of the Patents-in-Suit. *See Eclipse IP LLC v. Brickhouse Electronics LLC*, No. 3:12-cv-00351-GCM-DLH (W.D.N.C. June 5, 2012). Specifically, Eclipse alleged that Brickhouse infringed the Patents-in-Suit by providing its customers with electronics shipment notifications that contain URL links to package-tracking information. Eclipse was represented in that suit by Raboteau T. Wilder, III, of the Stewart Law Offices. The suit was voluntarily dismissed by Eclipse on December 19, 2012.

28. Brickhouse is a FedEx Services customer, and uses IT services of FedEx Services; Brickhouse uses those services in electronic shipment notifications that it provides to its customers.

29. On or about February 28, 2012, Matthew S. Harman of the law firm Harman Law LLC, counsel for Eclipse, sent a letter to Dennis Boudreau, President and Chief Executive Officer of 1st in Video-Music World, Inc., and DiscountGolfWorld.com, demanding that 1st in Video-Music World pay a license fee of \$95,000 in exchange for a license to all of Eclipse’s patents, including the Patents-in-Suit. A true and correct copy of that letter is attached hereto as Exhibit H.

30. In the letter sent to 1st in Video-Music World, Eclipse alleged that 1st in Video-Music World, Inc.'s information systems infringe the Patents-in-Suit, in particular through email notifications that include hyperlinks to FedEx Services systems for the retrieval of shipment information—"messaging and responding to information associated with orders and shipments," according to Eclipse. *See* Exhibit H.

31. On September 7, 2012, Eclipse filed a patent-infringement lawsuit before the United States District Court for the Western District of North Carolina against 1st in Video-Music World, Inc., (the "Eclipse II litigation"), alleging that 1st in Video-Music World infringed, actively induced, and/or contributed to the infringement by others of the Patents-in-Suit. *See Eclipse IP LLC v. 1st in Video-Music World, Inc.*, No. 3:12-cv-00581-RJC-DCK (W.D.N.C. Sept. 7, 2012). Specifically, Eclipse alleges that 1st in Video-Music World infringes the Patents-in-Suit by providing its customers with electronics shipment notifications that contain URL links to package-tracking information. Eclipse is represented in that suit by Raboteau T. Wilder, III, of the Stewart Law Offices.

32. 1st in Video-Music World is a FedEx Services customer, and uses IT services of FedEx Services; 1st in Video-Music World uses those services in electronic shipment notifications that it provides to its customers.

33. The five Patents-in-Suit in the present declaratory-judgment action are the same five patents asserted by Eclipse against FedEx Services' customers in the demand letters described in Paragraphs 22, 25, and 29, and asserted in the lawsuits described in Paragraphs 27 and 31.

34. Upon information and belief, the technology accused of infringing the Patents-in-Suit in the demand letters and lawsuits described in Paragraphs 22, 25, 27, 29, and 31 utilizes IT services provided by FedEx Services to its customers.

35. Many businesses that ship packages to their own customers enter into agreements with FedEx Services regarding the use of notification, tracking, messaging, and other IT services that FedEx Services provides to these customers. Many of FedEx Services' agreements contain warranty or indemnification clauses.

36. Customers of FedEx Services contact FedEx after they have been threatened with liability for patent infringement or sued for alleged patent infringement.

37. After receiving threats from Eclipse, several customers contacted FedEx and notified FedEx of Eclipse's charges and further conveyed their belief that such charges related to the customer's use of FedEx Services' notification, tracking, messaging, or other IT services.

38. Some customers have specifically requested indemnification from FedEx Services against Eclipse's charges of patent infringement, making such requests based on indemnity, warranty, other clauses, or other aspects of agreements between FedEx Services and the customer that govern the customer's use of notification, tracking, messaging, or other IT services from FedEx Services.

39. FedEx Services' relationship with its customers and Eclipse's threats or suits against those customers have placed FedEx in jeopardy of facing lawsuits from its customers based on indemnity, warranty, other clauses, or other aspects of agreements between FedEx Services and the customer that govern the customer's use of notification, tracking, messaging, or other IT services from FedEx Services.

40. Eclipse's statements and filings against FedEx Services' customers, combined with the legal relationship between FedEx Services and its customers, create an actual case or controversy as to whether FedEx Services and its customers are infringing any valid claim of the Patents-in-Suit.

41. Eclipse's statements and filings, and the legal relationship between FedEx Services and its customers, show that there is a substantial controversy, between parties having adverse legal interests, of sufficient immediacy and reality to warrant the issuance of a declaratory judgment.

42. FedEx Services continues to use its notification and shipment tracking technology that Eclipse has accused FedEx Services' customers of using to infringe the Patents-in-Suit, and FedEx Services' customers continue to use the notification, tracking, messaging, or other IT services.

43. In an attempt to deprive the Court of jurisdiction, Eclipse granted covenants to FedEx Services' parent corporation, FedEx Corporation, and to FedEx's customers.

44. Eclipse's covenant to FedEx Corporation relinquishes causes of action that Eclipse may have against FedEx Corporation or its subsidiaries based on infringement of the Patents-in-Suit.

45. Eclipse's covenant to FedEx's customers, however, only relinquishes limited claims against the customers. Eclipse reserves claims against FedEx customers for infringement that includes a step or element of a patent claim that is allegedly performed or implemented solely by the customer or its agent along with the customer's intended use of FedEx's notification, tracking, messaging, or other IT services.

COUNT I

DECLARATION OF NONINFRINGEMENT

46. Paragraphs 1-45 are incorporated by reference as if fully restated herein.

47. Eclipse has asserted that FedEx Services' customers infringe claims of the Patents-in-Suit by using shipment-notification and tracking-technology systems and/or services provided by FedEx Services.

48. FedEx Services' shipment-notification and tracking-technology systems, as used by FedEx Services' customers, do not infringe any valid and asserted claim of the Patents-in-Suit because they do not satisfy all the limitations of those claims.

49. FedEx Services' shipment-notification and tracking-technology systems and/or services, as used by FedEx Services' customers, do not infringe any valid and asserted claim of the Patents-in-Suit because FedEx is licensed to practice those claims.

50. Based on Eclipse's statements against FedEx Services' customers, an actual case or controversy exists as to whether FedEx Services' customers infringe any valid or enforceable claim of the Patents-in-Suit, and FedEx is entitled to a declaration that its customers do not infringe any valid claim of the Patents-in-Suit.

COUNT II

DECLARATION OF INVALIDITY

51. Paragraphs 1-45 are incorporated by reference as if fully restated herein.

52. At least the claims that Eclipse has asserted against FedEx Services' customers are invalid under the United States Patent Act, 35 U.S.C. § 1 *et seq.*, including 35 U.S.C. §§ 101, 102, 103, and/or 112.

53. At least the claims that Eclipse has asserted against FedEx Services' customers are invalid pursuant to 35 U.S.C. §§ 102 and/or 103 because they are anticipated and/or rendered obvious by the prior art.

54. At least the claims that Eclipse has asserted against FedEx Services' customers are invalid pursuant to 35 U.S.C. § 102(f) because the applicant and sole named inventor did not himself invent the subject matter sought.

55. One or more claims of the Patents-in-Suit are invalid pursuant to 35 U.S.C. § 112 because they are indefinite, not enabled, and/or lack sufficient written description.

56. Based on Eclipse's statements against FedEx Services' customers, an actual case or controversy exists as to whether FedEx's customers infringe any

valid or enforceable claim of the Patents-in-Suit, and FedEx Services is entitled to a declaration that the Patents-in-Suit are invalid.

JURY DEMAND

FedEx Services demands a jury on all issues so triable.

PRAYER FOR RELIEF

WHEREFORE, FedEx Services respectfully requests the following relief:

- A. A judgment that Plaintiff FedEx Services' customers utilizing FedEx Services' technology do not infringe any valid claim of the Patents-in-Suit;
- B. A judgment that the asserted claims of the Patents-in-Suit are invalid and/or unenforceable;
- C. That this case be found an exceptional case under 35 U.S.C. § 285, entitling FedEx Services to be awarded the attorney fees, costs, and expenses that it incurs in prosecuting this action;
- D. Such other and further relief as the Court may deem just and proper.

Dated: May 31, 2013

Respectfully submitted,

/s/Matthew T. Nesbitt

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CERTIFICATE OF SERVICE

Counsel for Plaintiff FedEx Corporate Services, Inc. hereby certifies that on May 31, 2013, the foregoing AMENDED COMPLAINT FOR DECLARATORY JUDGMENT OF PATENT NONINFRINGEMENT AND INVALIDITY and accompanying exhibits were electronically filed with the Clerk of Court using the CM/ECF system, which will automatically send notification of such filing to the following attorneys of record for Plaintiff.

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