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ADOBE SYSTEMS INCORPORATED

UNITED STATES DISTRICT COURT
SOUTHERN DISTRICT OF CALIFORNIA
SAN DIEGO DIVISION

ADOBE SYSTEMS INCORPORATED,
a Delaware Corporation,

Plaintiff,

v.

SELECT RETRIEVAL, LLC, a Texas
Limited Liability Corporation,

Defendant.

Case No. 3:12-cv-2342-GPC-WMC

**FIRST AMENDED COMPLAINT
FOR DECLARATORY
JUDGMENT**

DEMAND FOR JURY TRIAL

(REDACTED VERSION)

Plaintiff Adobe Systems Incorporated (“Adobe”) hereby alleges as follows
for this First Amended Complaint against Select Retrieval, LLC (“Select
Retrieval”):

PARTIES

1. Plaintiff Adobe is a Delaware corporation with its principal place of

1 business at 345 Park Avenue, San Jose, CA 95110.

2 2. On information and belief, Defendant Select Retrieval is a limited
3 liability company organized under the laws of Texas with its principal place of
4 business at 777 Enterprise Drive, Hewitt, Texas 76643.

5 JURISDICTION AND VENUE

6 3. This action is based on the patent laws of Title 35 of the United States
7 Code, § 1 *et seq.*, with a specific remedy sought under the Federal Declaratory
8 Judgments Act, 28 U.S.C. §§ 2201 and 2202. An actual, substantial, and
9 continuing justiciable controversy exists between Adobe and Select Retrieval that
10 requires a declaration of rights by this Court.

11 4. This Court has subject matter jurisdiction over this action pursuant to
12 28 U.S.C. §§ 1331 and 1338(a).

13 5. This Court has personal jurisdiction over Select Retrieval by virtue of
14 Select Retrieval's enforcement of one of the patents that are the subject of this suit
15 in this District against numerous entities, including Adobe customer [REDACTED]
16 [REDACTED]. *See Select Retrieval, LLC v.*
17 *American Apparel, LLC et al.*, Case No. 3:11-cv-02158-GPC-WMC.

18 6. Venue is proper in this judicial district pursuant to 28 U.S.C. §§ 1391
19 and 1400 because Select Retrieval is subject to personal jurisdiction in this judicial
20 district and is therefore deemed to reside in this district pursuant to 28 U.S.C.
21 § 1391(c).

22 7. Adobe maintains an office in San Diego. Adobe's San Diego
23 operations include support for its Digital Marketing technology. In addition, Adobe
24 acquired portions of the relevant Digital Marketing technology from entities, at
25 least one of whom operated offices in San Diego. Accordingly, on information and
26 belief, there are fact witnesses in this judicial district.

27 8. Additionally, on information and belief, Adobe expects to seek
28 discovery from third-party witnesses in this judicial district. For example, United

1 States Patent No. 5,241,671 (“’671 patent”) is prior art to one of the patents-in-suit.
2 Six of the listed inventors of the ’671 patent (Harold Kester, Eduardo Munevar,
3 Greg Bestick, Ron Carlton, Dave Maatman, and Derryl Rogers) are listed on the
4 ’671 patent as residing in this judicial district and, as such, would be subject to
5 service of process here.

6 NOTICE OF RELATED CASES

7 9. The present action is related to *Select Retrieval, LLC v. American*
8 *Apparel, LLC et al.*, Case No. 3:11-cv-02158-GPC-WMC. In the *American*
9 *Apparel* case, Select Retrieval sued a number of companies, including Adobe
10 licensee [REDACTED], for infringement of U.S. Patent No. 6,128,617 (“’617
11 patent”), one of the patents at issue in the present case. Both cases involve Select
12 Retrieval and are based on the same or similar claims, namely Select Retrieval’s
13 assertion of patent infringement by Adobe’s customers. Both cases involve the
14 same property (e.g., Select Retrieval’s patent) and events (e.g., [REDACTED]
15 digital marketing activities which may implicate Adobe’s Digital Marketing
16 technologies). Adobe has agreed to defend and indemnify [REDACTED] against
17 Select Retrieval’s claims in the *American Apparel* case. Select Retrieval’s
18 infringement claims in the *American Apparel* case have been dismissed, but the
19 case has not yet closed.

20 10. The *American Apparel* action was originally filed in this District and is
21 currently assigned to the Honorable Gonzalo P. Curiel.

22 FACTUAL BACKGROUND

23 11. Adobe develops, sells, and licenses many software programs for
24 computers and electronic devices, including such technologies as Acrobat, Flash,
25 and PostScript. Through its Digital Marketing business unit, Adobe also provides
26 software and services related to merchandising and web hosting, including its
27 Digital Marketing technology. Adobe’s Digital Marketing technology includes a
28 product offering, formerly called “Mercado,” which, among other things, enables

1 customers to offer search functionality on their e-commerce websites that allows
2 visitors to refine searches based on categories such as price, color, brand, and size.
3 For some customers, the hosted merchandising technology and services run on
4 servers controlled by Adobe and can be used by Adobe's licensees to execute
5 online merchandising strategies. For other customers, Adobe provides software and
6 services for a hosting solution external to Adobe.

7 12. On information and belief, Select Retrieval's business is licensing and
8 enforcement of its patents, which it does not practice.

9 13. On information and belief, Select Retrieval purports to be the owner of
10 U.S. Patent No. 5,953,724 ("724 patent"). The '724 patent is entitled "Global
11 Database Library Data Structure For Hierarchical Graphical Listing Computer
12 Software." A copy of the '724 patent is attached as Exhibit A.

13 14. On information and belief, Select Retrieval purports to be the owner of
14 U.S. Patent No. 6,128,617 ("617 patent"). The '617 patent is entitled "Data
15 Display Software With Actions And Links Integrated With Information." A copy
16 of the '617 patent is attached as Exhibit B.

17 15. Collectively, the '724 patent and the '617 patent will be referred to as
18 the "patents-in-suit."

19 **I. SELECT RETRIEVAL HAS ACCUSED ADOBE OF SUPPLYING**
20 **TECHNOLOGY THAT INFRINGES THE PATENTS-IN-SUIT**

21 16. On September 15, 2011, Select Retrieval filed a complaint in this
22 District ("California Action") against multiple defendants, including American
23 Apparel, LLC; Art.com, Inc.; AutoZone, Inc.; BBCK Enterprises, Inc.; BBJ Soldco
24 LLC; Beach Audio, Inc.; Beauty Encounter, Inc.; Blue Ribbon Motoring, LLC;
25 Boot Barn, Inc.; Build.com, Inc.; Buy.com, Inc.; Cost Plus, Inc.; Costume Craze,
26 LLC; Drill Spot, LLC; eBay Inc.; Everything Furniture Inc.; FC Organizational
27 Products, LLC d/b/a FranklinCovey Co.; Fredericks of Hollywood Stores, Inc.;
28 Guess ?, Inc.; HauteLook, Inc.; Pacific Sunwear of California Inc.; Patagonia, Inc.;

1 PETCO Animal Supplies Inc.; Road Runner Sports Inc.; Sheet Music Plus, LLC;
2 Shutterfly, Inc.; Skechers U.S.A., Inc.; Sonic Electronix, Inc.; The Gap, Inc.; Tiny
3 Prints, Inc.; Tool King LLC; U.S. Auto Parts Network, Inc. d/b/a USAPN, Inc.;
4 West Marine Products, Inc.; and Wine.com, Inc. [REDACTED]

5 [REDACTED] is a licensee of the Adobe Digital Marketing technology.

6 Select Retrieval's claims against all defendants in the California Action have been
7 dismissed, but the case has not yet closed.

8 17. The California Action is not the only litigation Select Retrieval has
9 filed on the patents-in-suit. On June 2, 2011, Select Retrieval filed a complaint in
10 the Northern District of Illinois ("Illinois Action") against multiple defendants,
11 including ABT Electronics, Inc.; Ace Hardware Corp.; Action Village, LLC;
12 Calumet Photographic, Inc.; Chelsea & Scott, Ltd.; Euromarket Designs, Inc., d/b/a
13 Crate and Barrel; Fansedge Inc.; OfficeMax, Inc.; OpticsPlanet, Inc.; Sears
14 Holdings Corp.; Walgreen Co.; Whitney Automotive Group, Inc.; W.W. Grainger,
15 Inc.; and ULTA Salon, Cosmetics & Fragrance, Inc. The only remaining
16 defendants in the Illinois Action are [REDACTED] and [REDACTED]
17 [REDACTED], both of whom are licensees of the Adobe Digital
18 Marketing technology.

19 18. On August 15, 2011, Select Retrieval filed a complaint in the Middle
20 District of Florida ("Florida Action") against multiple defendants, including Aqua
21 Superstore, Inc.; Belk Ecommerce, LLC; Benchmark Brands, Inc.; Chico's FAS
22 Inc.; ivgStores, LLC; Lowe's Companies, Inc.; Lumber Liquidators, Inc.; Market
23 America, Inc.; RoomsToGo.com, Inc.; The Home Depot Inc.; Thompson and
24 Company of Tampa Inc.; V. F. Corporation; Vitacost.com, Inc.; and Winchester
25 Carpet & Rug Company. [REDACTED], one of the named defendants in the
26 Florida Action, is a licensee of the Adobe Digital Marketing technology. The
27 Florida Action has been dismissed.

28 19. On September 13, 2011, Select Retrieval filed a complaint in the

1 district of Delaware (“First Delaware Action”) against multiple defendants,
 2 including AmeriMark Direct LLC; Ann Inc.; BabyAge.com, Inc.;
 3 BarnesandNoble.com LLC; Barneys New York, Inc.; BJ’s Wholesale Club, Inc.;
 4 Bulbs.com Incorporated; Cabela’s Incorporated; CPA2Biz, Inc.; Crocs, Inc.;
 5 Wayfair LLC; Dell, Inc.; Dick’s Sporting Goods, Inc.; Dillard’s, Inc.; Eastern
 6 Mountain Sports, Inc.; eBags, Inc.; Express, LLC; GNC Holdings, Inc.; Green
 7 Mountain Coffee Roasters, Inc.; Hanover Direct, Inc.; Ice.com, Inc.; J&P Cycles,
 8 LLC; Karmaloop, Inc.; Liberty Media Corporation; Liquidity Services, Inc.;
 9 Macy’s, Inc.; NBA Media Ventures, LLC; NFL Enterprises, LLC; NHL
 10 Enterprises, LP; Oriental Trading Company, Inc.; Overstock.com, Inc.; PC Mall,
 11 Inc.; PetSmart, Inc.; Quidsi, Inc.; Ritz Interactive, Inc.; Scholastic Corporation;
 12 Shoebuy.com, Inc.; SkyMall, Inc.; Staples, Inc.; Systemax, Inc.; Tech for Less,
 13 LLC; Buckle, Inc.; The Sports Authority, Inc.; Tiffany & Co.; Toys “R” Us, Inc.;
 14 VS Holdings, Inc.; Wal-Mart Stores, Inc.; Philips Electronics North America
 15 Corporation; LG Electronics USA, Inc.; Sharp Electronics Corporation;
 16 1800Mattress.com, LLC; 3balls.com, Inc.; American Greetings Corporation; B&H
 17 Foto & Electronics Corp.; Bluefly, Inc.; Charming Shoppes, Inc.; Christian Book
 18 Distributors, LLC; CompSource, Inc.; Decorative Product Source, Inc.; Foot
 19 Locker, Inc.; Hayneedle, Inc.; Henry Modell & Company, Inc.; Kenneth Cole
 20 Productions, Inc.; L.L. Bean, Inc.; Luxi Group, LLC; Nebraska Furniture Mark,
 21 Inc.; Paragon Sporting Goods Co., LLC; PC Connection, Inc.; Public Broadcasting
 22 Service; Redcats USA, Inc.; Robert E. Axelrod Associates, Inc.; Ross-Simons, Inc.;
 23 Brown Shoe Company, Inc.; TABcom, LLC; Toolfetch, LLC; Under Armour, Inc.;
 24 Ellison Systems, Inc. d/b/a Shoplet.com; Star Creations, Inc. d/b/a AJ Madison; J &
 25 R Electronics Inc.; and New Moosejaw, LLC. Five of the named defendants in the
 26 First Delaware Action are licensees of the Adobe Digital Marketing technology:

27 [REDACTED]
 28 [REDACTED]

1 [REDACTED]. Only one other non-Adobe licensee remains in the
2 First Delaware Action. The First Delaware Action is still pending.

3 20. On September 14, 2011, Select Retrieval filed a complaint in the
4 District of Oregon ("Oregon Action") against multiple defendants, including Altrec,
5 Inc.; Adidas America, Inc.; Adidas AG; Amazon.com, Inc.; Bag Borrow or Steal,
6 Inc.; Costco Wholesale Corporation; Evolucion Innovations, Inc.; iStores, Inc.;
7 Motorcycle Superstore, Inc.; Musician's Friend, Inc.; Nordstrom, Inc.; Oakley, Inc.;
8 Sierra Trading Post Inc.; Sur La Table, Inc.; Gerler and Son, Inc.; Huppins Hi-Fi
9 Photo & Video, Inc.; drugstore.com, Inc.; Harry and David Holdings, Inc.; and T-
10 Mobile USA, Inc. [REDACTED], two of the
11 named defendants in the Oregon Action, are licensees of the Adobe Digital
12 Marketing technology. The Oregon Action has been dismissed.

13 21. On January 6, 2012, Select Retrieval filed a complaint in the District
14 of Maine ("Maine Action") against L.L. Bean, Inc. [REDACTED] is a licensee of the
15 Adobe Digital Marketing technology. The Maine Action has been stayed pending
16 resolution of this action.

17 22. On November 9, 2012, Select Retrieval filed a complaint in the
18 District of Delaware ("Second Delaware Action") against MotoSport, Inc.
19 [REDACTED] is a licensee of the Adobe Digital Marketing technology. The Second
20 Delaware Action has been dismissed.

21 23. Select Retrieval alleges that [REDACTED]
22 [REDACTED], all of whom are
23 Adobe licensees (collectively, the "Adobe Licensees"), infringe the '617 patent "by
24 making, using, owning, operating, and/or maintaining one or more websites . . . that
25 embody the inventions claimed in the '617 Patent."

26 24. Select Retrieval has also alleged that [REDACTED] infringes the '724
27 patent "by making, using, selling, offering for sale or license, advertising and/or
28 importing in the United States, including within this judicial district, their products

1 and services on the Internet using methods or instrumentalities that embody the
 2 inventions claimed in the '724 Patent." In an amended complaint filed on
 3 September 14, 2011, Select Retrieval omitted allegations related to the '724 patent.
 4 Select Retrieval has refused to give [REDACTED], Adobe, or any of the other Adobe
 5 Licensees (other than [REDACTED]) a covenant not to sue on the '724 patent.

6 25. Select Retrieval has asserted in a publicly filed pleading in this District
 7 that Adobe and another manufacturer (Endeca) provide the technology that
 8 infringes the '617 patent:

9 Upon information and belief, [Select Retrieval] contends that
 10 discovery will show that many of the defendants in this action employ
 11 overlapping vendors and/or **suppliers of the infringing functionality**
 12 used on their websites. Upon information and belief, such vendors
 13 and/or suppliers **include, but are not limited to, Endeca and Adobe**
 14 **Omniture.**

15 Plaintiff Select Retrieval, LLC's Response to Defendants' Motion to Dismiss at 14,
 16 *Select Retrieval, LLC v. American Apparel, LLC et al.*, Case No. 3:11-cv-02158-
 17 GPC-WMC (S.D. Cal. Feb. 7, 2013) ECF No. 138 (emphasis added). Omniture
 18 was a previous name of the Adobe business unit that includes Adobe's Digital
 19 Marketing technologies such as the Mercado product.

20 26. Additionally, the Adobe Licensees provided to Adobe copies of the
 21 allegations made against them by Select Retrieval, represented that these allegations
 22 are based on customer use of the Adobe Digital Marketing technology, and
 23 requested defense and indemnity from Adobe. For example, [REDACTED]
 24 requested indemnity from Adobe, stating, "[P]aragraph 45 of the second amended
 25 Complaint [in the California Action] contains specific allegations which clearly
 26 trigger Adobe's indemnification obligations to [REDACTED]." Paragraph 45 of
 27 the second amended Complaint in the California Action states:

28 The '617 Patent covers a method and/or system that enable search
 functions and data retrieval, including website features such as
 category and feature based product searches. Such data retrieval is
 achieved by increasingly refined searches th [REDACTED] ively
 [REDACTED] information about the produ [REDACTED]
 [REDACTED] sells on its website. [REDACTED]

1 [REDACTED] website provides the progressively refined search functionality
2 ing infringing methods and/or systems so that its users and/or
3 customers have the ability to select from a series of categories, options,
and/or other product features such as, but not limited to, product and/or
information type, price, color, brand, and size.

4 Second Amended Complaint at 11, *Select Retrieval, LLC v. American Apparel,*
5 *LLC et al.*, Case No. 3:11-cv-02158-GPC-WMC (S.D. Cal. Apr. 2, 2012) ECF No.
6 169. Adobe's Digital Marketing technology as used by [REDACTED] provides
7 the ability to refine searches based on categories such as price, color, brand, and
8 size. While Adobe does not believe that its Digital Marketing technologies infringe
9 any valid claim of the '617 patent, Select Retrieval's and [REDACTED]
10 allegations place Adobe's technology in issue. Adobe has agreed to defend and
11 indemnify [REDACTED] against Select Retrieval's allegations.

12 27. As another example, in or about July 2012 Select Retrieval sent to
13 [REDACTED] a claim chart describing Select Retrieval's infringement allegations
14 related to the '617 patent. In the claim chart, Select Retrieval states that "product
15 features or categories" on [REDACTED] website are "action control elements"
16 claimed in the '617 patent. On information and belief, [REDACTED] uses Adobe's
17 Digital Marketing technology in the display of the challenged product features or
18 categories. While Adobe does not believe that its technology infringes any valid
19 claim of the '617 patent, Select Retrieval's allegations place Adobe technology at
20 issue. Adobe has agreed to defend and indemnify [REDACTED] against Select
21 Retrieval's allegations.

22 [REDACTED] As another example, on or about December 17, 2012 Select Retrieval
23 sent to [REDACTED] a claim chart describing Select Retrieval's infringement allegations
24 related to the '617 patent. In the claim chart, Select Retrieval specifically accuses
25 Adobe's Mercado product of supplying one or more elements of claims 1 and 12 of
26 the '617 patent. For example, asserted claim 1 recites that the accused
27 instrumentality must "form[] a database query according to the action control
28 element selection." [REDACTED]

FENWICK & WEST LLP
ATTORNEYS AT LAW
MOUNTAIN VIEW

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[REDACTED]

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[REDACTED]

[REDACTED]

[REDACTED] The Mercado Search
Server is provided by Adobe.

[REDACTED] On September 30, 2013, Select Retrieval sent to [REDACTED] an amended
claim chart describing Select Retrieval's infringement allegations related to the
'617 patent (a copy of which is attached as Exhibit D). [REDACTED]

[REDACTED]

[REDACTED]

1 [REDACTED]

2 [REDACTED]

3 [REDACTED]

4 [REDACTED]

5 [REDACTED]

6 [REDACTED]

7 [REDACTED]

8 [REDACTED]

9 [REDACTED]

10 [REDACTED]

11 [REDACTED]

12 [REDACTED]

13 [REDACTED]

14 [REDACTED]

15 [REDACTED]

16 [REDACTED]

17 [REDACTED]

18 [REDACTED]

19 [REDACTED]

20 [REDACTED]

21 [REDACTED]

22 [REDACTED]

23 [REDACTED]

24 [REDACTED]

25 [REDACTED]

26 [REDACTED]

27 [REDACTED]

28 [REDACTED]

While Adobe does not believe that Mercado infringes any valid claim of the '617 patent, Select Retrieval's allegations place Adobe technology at issue. Adobe has agreed to defend and indemnify [REDACTED] against Select Retrieval's allegations.

[REDACTED] As another example, on or about December 17, 2012 Select Retrieval sent to [REDACTED] a claim chart describing Select Retrieval's infringement allegations related to the '617 patent. In the claim chart, Select Retrieval specifically accuses Adobe's Mercado product of supplying one or more elements of claims 1 and 12 of the '617 patent. For example, one of the asserted claims contains an element whereby an accused instrumentality must "form[] a database query according to the action control element selections." [REDACTED]

25 [REDACTED]

26 [REDACTED]

27 [REDACTED]

28 [REDACTED]

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[REDACTED]

On September 30, 2013, Select Retrieval sent to [REDACTED] an amended claim chart describing Select Retrieval's infringement allegations related to the '617 patent (a copy of which is attached as Exhibit F). [REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

1 [REDACTED]
2 [REDACTED]
3 While Adobe does not believe that Mercado infringes any valid claim of the '617
4 patent, Select Retrieval's allegations place Adobe technology at issue. Adobe has
5 agreed to defend and indemnify [REDACTED] against Select Retrieval's allegations.

6 32. In each of its actions against the Adobe Licensees, Select Retrieval
7 identifies Adobe's Digital Marketing technologies, such as Mercado, as providing
8 essential limitations of the '617 patent, particularly back-end technology for
9 querying a database. Adobe's Digital Marketing technologies, such as Mercado, do
10 not meet this, or any other limitation, of the '617 patent. In the Illinois, Maine, and
11 First Delaware Actions, all of the defendants except one are Adobe Licensees.
12 Select Retrieval's allegations in those actions are focused on the methods used by
13 the Adobe Licensees.

14 33. Adobe has agreed to defend and indemnify all of the Adobe Licensees
15 Select Retrieval has accused of infringing the '617 patent.

16 **II. COURTS HAVE HELD THAT ADOBE HAS A SUBSTANTIAL**
17 **INTEREST IN SELECT RETRIEVAL'S INFRINGEMENT CLAIMS**

18 34. After Adobe agreed to defend and indemnify the Adobe Licensees,
19 two district courts have held that Adobe has a "substantial" or "protectable" interest
20 in Select Retrieval's allegations regarding infringement of the '617 patent.¹

21 35. In the Maine Action, the district court held that "[b]ecause Adobe's
22 technology drives L.L. Bean's site navigation, and because it is this technology
23 which is alleged to infringe Select Retrieval's patent, and because Adobe has
24 acknowledged an obligation to defend and indemnify L.L. Bean, Adobe has
25 established a substantial interest in this litigation." Order on Adobe's Motion to
26 Intervene and Stay at 5–6, *Select Retrieval, LLC v. L.L. Bean, Inc.*, Case No. 2:12-

27 ¹ Two courts held that Adobe did not have a significant protectable interest in
28 Select Retrieval's allegations of infringement of the '617 patent, but both decisions
were issued *before* Adobe filed notices advising the court that it had agreed to
defend and indemnify the Adobe Licensees.

1 cv-00003-NT (D. Me. Mar. 15, 2013) ECF No. 42.

2 36. In the First Delaware Action, the U.S. District Court held:

3 Deciding how much of Adobe's technology is at issue is not an easy
4 issue. On the other hand, at oral argument, Plaintiff did not dispute
5 that Adobe had a duty to defend and indemnify its five clients. (D.I.
6 636, at 35). (Adobe's lawyers were then representing four of the five
7 clients. I believe they are now representing all five.). The fact that
8 Adobe has acknowledged its duty to defend and indemnify is a fairly
9 strong indicator that its technology is indeed at issue in these cases.
Further, the fact that these five Adobe clients (as well as at least four
more Adobe clients in the four related cases) all are alleged to infringe
the patent suggests that Adobe's technology may be the common link
that provides a basis to believe each of the nine or more companies
infringes the patent. Thus, I do not think it is necessary to delve into
the technology here to conclude that Adobe does have a significant
protectable interest.

10 Memorandum Order at 2–4, *Select Retrieval, LLC v. AmeriMark Direct, LLC et al.*,
11 Case No. 1:11-cv-00812-RGA (D. Del. Jul. 3, 2013) ECF No. 663.

12 **III. THERE IS AN ACTUAL CONTROVERSY OF SUFFICIENT**
13 **IMMEDIACY AND REALITY BETWEEN ADOBE AND SELECT**
14 **RETRIEVAL TO WARRANT ISSUANCE OF A DECLARATORY**
15 **JUDGMENT**

16 37. Select Retrieval has asserted that Adobe-supplied instrumentalities
17 such as Mercado meet elements of the asserted claims. For at least some of the
18 Adobe Licensees, Adobe provides a hosted service, where key elements of the
19 accused conduct occur on Adobe's computers. Adobe continues to both sell and
20 provide hosted services for its Digital Marketing technologies. The Adobe
21 Licensees have taken the position that the instrumentalities alleged to infringe the
22 patents-in-suit include Adobe-supplied instrumentalities. They have demanded
defense and indemnity from Adobe, which Adobe has agreed to provide.

23 38. Adobe first became aware of the patents-in-suit as early as July 21,
24 2011, when Adobe received a request for defense and indemnity from [REDACTED]
25 The request included correspondence from Select Retrieval's counsel to [REDACTED]
26 which identified both patents-in-suit by number. A copy of the request is attached
27 as Exhibit G.

28 39. Select Retrieval's infringement contentions against the Adobe

1 Licensees allege that Adobe supplied technology that the Adobe Licensees use in
2 the accused e-commerce websites to infringe the '617 patent. By referring to
3 Adobe's manuals and to the other materials Adobe has provided to its customers in
4 its infringement contentions, Select Retrieval has asserted that the Adobe Licensees
5 are using the Adobe-supplied technology in the manner in which Adobe instructs its
6 customers to use the technology, as reflected in the user manuals, thereby inducing
7 the Adobe Licensees' direct infringement. In addition, by referring to Adobe's
8 manuals and to the other materials Adobe has provided to its customers in its
9 infringement contentions, Select Retrieval has asserted that the Adobe-supplied
10 technology satisfies essential elements of the asserted claims that, when combined
11 with the Adobe Licensees' own technology, contributes to the Adobe Licensees'
12 infringement.

13 40. Adobe believes that it does not infringe any claim of the patents-in-
14 suit. Both of the patents-in-suit are invalid.

15 41. As a result of the allegations made by Select Retrieval against the
16 Adobe Licensees, and Adobe's assertions to the contrary, there is an actual
17 controversy of sufficient immediacy and reality between Adobe and Select
18 Retrieval regarding the non-infringement, validity, and enforceability of the
19 patents-in-suit as it pertains to the Adobe licensed technology and services,
20 particularly Adobe's Digital Marketing technology such as Mercado. For example,
21 were Select Retrieval successfully able to prove infringement of a valid and
22 enforceable claim, Adobe may be liable for direct infringement.

23 42. This controversy is between parties having adverse legal interests and
24 is of sufficient immediacy and reality to warrant issuance of a declaratory judgment
25 under 28 U.S.C. § 2201(a) as to the validity and enforceability of the patents-in-suit
26 and the alleged infringement of the patents-in-suit by Adobe or its technology.

**FIRST CLAIM FOR RELIEF
(DECLARATORY JUDGMENT OF
NON-INFRINGEMENT OF THE '617 PATENT)**

43. Adobe restates and incorporates by reference the allegations in the preceding paragraphs of this Complaint.

44. This is an action for declaratory judgment of non-infringement of any valid and enforceable claim of the '617 patent.

45. Select Retrieval has alleged and continues to allege that websites using the Adobe Digital Marketing technology are covered by the '617 patent. Select Retrieval has commenced litigation against the Adobe Licensees and several other companies regarding this matter, alleging that they infringe "by making, using, owning, operating, and/or maintaining one or more websites . . . that embody the inventions claimed in the '617 Patent."

46. Adobe's Digital Marketing technology does not infringe and has not infringed any valid and enforceable claim of the '617 patent. The Adobe Licensee's use of Adobe's Digital Marketing technology has not infringed and will not infringe any valid and enforceable claim of the '617 patent. The claim limitations that Select Retrieval contends are met by Adobe-supplied technology do not meet those claim limitations, and for this reason there is no infringement of the '617 patent.

47. Therefore, there exists a substantial controversy between Adobe and Select Retrieval, parties having adverse legal interests, of sufficient immediacy and reality to warrant the issuance of a declaratory judgment that Adobe and its licensees have not infringed and do not infringe any valid and enforceable claim of the '617 patent based on the manufacture, licensing, or use of the Adobe Digital Marketing technology.

48. An actual and justiciable controversy exists regarding the alleged infringement of the '617 patent by Adobe or the Adobe Licensees. Adobe accordingly requests a judicial determination of its rights, duties, and obligations

1 with regard to the '617 patent.

2 49. A judicial declaration is necessary and appropriate so that Adobe may
3 ascertain its rights regarding the '617 patent.

4 **SECOND CLAIM FOR RELIEF**
5 **(DECLARATORY JUDGMENT OF**
6 **NON-INFRINGEMENT OF THE '724 PATENT)**

7 50. Adobe restates and incorporates by reference the allegations in the
8 preceding paragraphs of this Complaint.

9 51. This is an action for declaratory judgment of non-infringement of any
10 valid and enforceable claim of the '724 patent.

11 52. Select Retrieval has alleged that websites using the Adobe Digital
12 Marketing technology are covered by the '724 patent. Select Retrieval filed a
13 complaint on June 2, 2011 in the Illinois Action against [REDACTED] asserting
14 infringement of the '724 patent based on [REDACTED] "making, using, selling,
15 offering for sale or license, advertising and/or importing in the United States,
16 including within this judicial district, their products and services on the Internet
17 using methods or instrumentalities that embody the inventions claimed in the '724
18 Patent." [REDACTED] uses the Adobe Digital Marketing technology to offer, among
19 other things, search functionality on its e-commerce website that allows visitors to
20 refine searches based on categories such as price, color, brand, and size.

21 53. On March 25, 2013, Adobe asked Select Retrieval to covenant not to
22 sue Adobe or any of its customers for infringement of the '724 patent. Select
23 Retrieval refused to provide the requested covenant. On June 24, 2013, Adobe
24 again asked Select Retrieval to covenant not to sue Adobe or its customers for
25 infringement of the '724 patent. Again, Select Retrieval refused to provide a
26 covenant not to sue. By refusing to provide a covenant not to sue, Select Retrieval
27 has retained the right to sue Adobe and its customers for any alleged infringement
28 of the '724 patent. By doing so, Select Retrieval has preserved this controversy at a
level of sufficient immediacy and reality that justifies the declaratory relief Adobe

1 seeks in this action.

2 54. Adobe's Digital Marketing technology does not infringe and has not
3 infringed any valid and enforceable claim of the '724 patent. [REDACTED] use of
4 Adobe's Digital Marketing technology has not infringed and will not infringe any
5 valid and enforceable claim of the '724 patent.

6 55. Therefore, there exists a substantial controversy between Adobe and
7 Select Retrieval, parties having adverse legal interests, of sufficient immediacy and
8 reality to warrant the issuance of a declaratory judgment that Adobe and its
9 licensees have not infringed and do not infringe any valid and enforceable claim of
10 the '724 patent based on the manufacture, licensing, or use of the Adobe Digital
11 Marketing technology.

12 56. An actual and justiciable controversy exists regarding the alleged
13 infringement of the '724 patent by Adobe or its licensee, [REDACTED]. Adobe
14 accordingly requests a judicial determination of its rights, duties, and obligations
15 with regard to the '724 patent.

16 57. A judicial declaration is necessary and appropriate so that Adobe may
17 ascertain its rights regarding the '724 patent.

18 **THIRD CLAIM FOR RELIEF**
19 **(DECLARATORY JUDGMENT OF**
20 **INVALIDITY OF THE '617 PATENT)**

21 58. Adobe restates and incorporates by reference the allegations in the
22 preceding paragraphs of this Complaint.

23 59. This is an action for declaratory judgment of invalidity of any and all
24 claims of the '617 patent.

25 60. Select Retrieval has alleged and continues to allege that websites using
26 the Adobe Digital Marketing technology are covered by the '617 patent. Select
27 Retrieval has commenced litigation against the Adobe Licensees and several other
28 companies regarding this matter, alleging that they infringe "by making, using,
owning, operating, and/or maintaining one or more websites . . . that embody the

1 inventions claimed in the '617 Patent."

2 61. Claims of the '617 patent are invalid because they fail to comply with
3 the conditions and requirements for patentability set forth in 35 U.S.C. § 1 *et seq.*,
4 including but not limited to 35 U.S.C. §§ 101, 102, 103, and 112. For example,
5 over 60 prior art references invalidate the '617 patent under 35 U.S.C. §§ 102
6 and/or 103. Asserted claims of the '617 patent are invalid for failure to provide
7 enablement and/or written description. The '617 patent is invalid for failure to
8 describe the best mode of carrying out the invention. These allegations are detailed
9 in Exhibit H (and the exhibits thereto) which are incorporated by reference as if
10 fully set forth herein.

11 62. Therefore, there exists a substantial controversy between Adobe and
12 Select Retrieval, parties having adverse legal interests, of sufficient immediacy and
13 reality to warrant the issuance of a declaratory judgment that each asserted claim of
14 the '617 patent is invalid.

15 63. Therefore, an actual and justiciable controversy exists regarding the
16 validity of the '617 patent. Adobe accordingly requests a judicial determination of
17 its rights, duties, and obligations with regard to the '617 patent.

18 64. A judicial declaration is necessary and appropriate so that Adobe may
19 ascertain its rights regarding the '617 patent.

20 **FOURTH CLAIM FOR RELIEF**
21 **(DECLARATORY JUDGMENT OF**
22 **INVALIDITY OF THE '724 PATENT)**

23 65. Adobe restates and incorporates by reference the allegations in the
24 preceding paragraphs of this Complaint.

25 66. This is an action for declaratory judgment of invalidity of any and all
26 claims of the '724 patent.

27 67. Select Retrieval has alleged that websites using the Adobe Digital
28 Marketing technology are covered by the '724 patent. Select Retrieval filed a
complaint on June 2, 2011 in the Illinois Action against [REDACTED] asserting

1 infringement of the '724 patent based on [REDACTED] "making, using, selling,
2 offering for sale or license, advertising and/or importing in the United States,
3 including within this judicial district, their products and services on the Internet
4 using methods or instrumentalities that embody the inventions claimed in the '724
5 Patent." [REDACTED] uses the Adobe Digital Marketing technology to offer, among
6 other things, search functionality on its e-commerce website that allows visitors to
7 refine searches based on categories such as price, color, brand, and size.

8 68. On March 25, 2013, Adobe asked Select Retrieval to covenant not to
9 sue Adobe or any of its customers for infringement of the '724 patent. Select
10 Retrieval refused to provide the requested covenant. On June 24, 2013, Adobe
11 again asked Select Retrieval to covenant not to sue Adobe or its customers for
12 infringement of the '724 patent. Again, Select Retrieval's refused to provide a
13 covenant not to sue. By refusing to provide a covenant not to sue, Select Retrieval
14 has retained the right to sue Adobe and its customers for any alleged infringement
15 of the '724 patent. By doing so, Select Retrieval has preserved this controversy at a
16 level of sufficient immediacy and reality that justifies the declaratory relief Adobe
17 seeks in this action.

18 69. The '724 patent is invalid for failure to meet one or more of the
19 conditions for patentability specified in Title 35, U.S.C., or the rules, regulations,
20 and law related thereto, including, without limitation, in 35 U.S.C. §§ 101, 102,
21 103, and 112, because the alleged invention lacks patentable subject matter; was
22 used or known by others in this country or was patented or described in a
23 publication before the date of the alleged invention; was patented or described in a
24 publication or was in public use or on sale for more than one year before the date of
25 the patent applications; was not invented by the named inventors; was invented by
26 another prior to the date of the alleged invention; was obvious in view of the prior
27 art; is indefinite; does not contain a proper written description; or does not disclose
28 the best mode of the invention. For example, all independent claims are invalid

1 under 35 U.S.C. § 112 for failure to enable or provide a written description of the
2 limitation “generic key fields.”

3 70. Therefore, there exists a substantial controversy between Adobe and
4 Select Retrieval, parties having adverse legal interests, of sufficient immediacy and
5 reality to warrant the issuance of a declaratory judgment that each asserted claim of
6 the ’724 patent is invalid.

7 71. Therefore, an actual and justiciable controversy exists regarding the
8 validity of the ’724 patent. Adobe accordingly requests a judicial determination of
9 its rights, duties, and obligations with regard to the ’724 patent.

10 72. A judicial declaration is necessary and appropriate so that Adobe may
11 ascertain its rights regarding the ’724 patent.

12 JURY DEMAND

13 Adobe hereby requests a trial by jury pursuant to Rule 38 of the Federal
14 Rules of Civil Procedure.

15 PRAYER FOR RELIEF

16 WHEREFORE, Adobe prays for judgment against Select Retrieval as
17 follows:

- 18 A. A declaration that Adobe’s technology is not covered by any valid and
19 enforceable claim of the ’617 patent, and that Adobe does not infringe
20 any valid and enforceable claim of the ’617 patent;
- 21 B. A declaration that Adobe’s technology is not covered by any valid and
22 enforceable claim of the ’724 patent, and that Adobe does not infringe
23 any valid and enforceable claim of the ’724 patent;
- 24 C. A declaration that Adobe’s licensees, including the Adobe Licensees,
25 do not infringe any valid and enforceable claim of the ’617 patent by
26 virtue of their use of Adobe technology;
- 27 D. A declaration that Adobe’s licensees, including the Adobe Licensees,
28 do not infringe any valid and enforceable claim of the ’724 patent by

virtue of their use of Adobe technology;

E. A declaration that the '617 patent is invalid;

F. A declaration that the '724 patent is invalid;

G. That this case is "exceptional" pursuant to 35 U.S.C. § 285, entitling Adobe to an award of its reasonable attorneys' fees;

H. That Adobe be awarded its reasonable costs incurred in this action; and

I. For such other relief as this Court deems just, reasonable, and proper.

Dated: October 4, 2013

FENWICK & WEST LLP

By: /s/ Virginia K. DeMarchi
Virginia K. DeMarchi

Attorneys for Plaintiff
ADOBE SYSTEMS INCORPORATED

FENWICK & WEST LLP
ATTORNEYS AT LAW
MOUNTAIN VIEW