

COBLENTZ PATCH DUFFY & BASS LLP
ONE FERRY BUILDING, SUITE 200, SAN FRANCISCO, CALIFORNIA 94111-4213
415.391.4800 · FAX 415.989.1663

1 JEFFREY G. KNOWLES (State Bar No. 129754)
JULIA D. GREER (State Bar No. 200479)
2 COBLENTZ PATCH DUFFY & BASS LLP
One Ferry Building, Suite 200
3 San Francisco, California 94111-4213
Phone : (415) 391-4800
4 Facsimile: (415) 989-1663
Email: ef-jgk@cpdb.com,
5 ef-jdg@cpdb.com

6 RALPH A. DENGLER*
CHARLES H. CHEVALIER+
7 GIBBONS P.C.
One Gateway Center
8 Newark, NJ 07102
Phone : (973) 596-4825
9 Facsimile: (973) 639-6381
Email: rdengler@gibbonslaw.com

10 * Admitted *Pro Hac Vice*
11 + *Pro Hac Vice* to be filed

12 Attorneys for Plaintiff
NOBELBIZ, INC.

13 Pursuant to Civ. L.R. 3-4, additional counsel are
14 listed on the signature page.

15 UNITED STATES DISTRICT COURT
16 NORTHERN DISTRICT OF CALIFORNIA
17 OAKLAND DIVISION
18

19 NOBELBIZ, INC.,

20 Plaintiff,

21 v.

22 SAFESOFT SOLUTIONS, INC.,

23 Defendant.

Case No. 13-02423-YGR

RELATED CASES:
CV 13-01773 YGR
CV 13-01846 YGR

CORRECTED AMENDED COMPLAINT

Action Filed: May 29, 2013
Trial Date: None Set

24
25
26 Plaintiff, NobelBiz, Inc. (“NobelBiz”), by and through its counsel, Coblentz, Patch, Duffy
27 & Bass LLP and Gibbons P.C., as for its Amended Complaint against Defendant, SafeSoft
28

COBLENTZ PATCH DUFFY & BASS LLP
ONE FERRY BUILDING, SUITE 200, SAN FRANCISCO, CALIFORNIA 94111-4213
415.391.4800 · FAX 415.989.1663

1 Solutions, Inc. (hereafter referred to as “SafeSoft” or “Defendant”), states as follows:

2 **THE PARTIES**

3 1. Plaintiff NobelBiz is a privately held company incorporated under the laws of the
4 State of Delaware, and having its principal place of business at 5973 Avenida Encinas, Suite 202,
5 Carlsbad, California 92008. NobelBiz is a provider of telecommunications solutions to call
6 centers worldwide.

7 2. Upon information and belief, Defendant is a corporation organized and existing
8 under the laws of the State of California, having its principal place of business at 20950 Warner
9 Center Lane, Suite A, Woodland Hills, California 91367-6537 and having a registered agent Nima
10 Hakimi located at 20316 Angelina Place, Woodland Hills California, 91364.

11 **JURISDICTION AND VENUE**

12 3. This is an action for patent infringement arising under the patent laws of the United
13 States, Title 35 of the United States Code § 1, *et seq.*

14 4. This Court has subject matter jurisdiction over this action pursuant to 28 U.S.C. §§
15 1331 and 1338(a).

16 5. This Court has personal jurisdiction over Defendant because of Defendant’s
17 continuous and systematic business contacts with the State of California, including clients using
18 its infringing service in California, and targeted advertising of its infringing service to potential
19 clients in California.

20 6. Venue is appropriate in this district pursuant to 28 U.S.C. §§ 1391(b) and (c),
21 and/or 28 U.S.C. § 1400(b).

22 7. SafeSoft has made its infringing mark, Local Touch, available in this District. Exs.
23 A-C. Some potential purchasers in this District of NobelBiz’s LocalTouch™ service are likely to
24 be confused by SafeSoft’s Local Touch.

25 8. On information and belief, SafeSoft has also made its infringing products
26 (discussed further below) available in this District. Exs. A-F.

27
28

COBLENTZ PATCH DUFFY & BASS LLP
ONE FERRY BUILDING, SUITE 200, SAN FRANCISCO, CALIFORNIA 94111-4213
415.391.4800 · FAX 415.989.1663

NOBELBIZ’S PATENTS

The 8,135,122 Patent

9. On March 13, 2012, the USPTO issued United States Patent No. 8,135,122 (“the ‘122 patent”), entitled “SYSTEM AND METHOD FOR MODIFYING COMMUNICATION INFORMATION (MCI).” A copy of the ‘122 patent is attached hereto as Exhibit G.

10. NobelBiz is the assignee of the ‘122 patent.

11. By way of a general description, the ‘122 patent discloses a system for processing a telephone call from a call originator (also referred to as a calling party) to a call target (also referred to as a receiving party), where the system accesses a database storing outgoing telephone numbers, selects a replacement telephone number from the outgoing telephone numbers based on the telephone number of the call target, and originates an outbound call to the call target with a modified outgoing caller identification (“caller ID”). *See, e.g.*, ‘122 patent, Abstract.

12. In practice, the invention of the ‘122 patent allows a calling party in one geographical location to originate a call to a receiving party in another geographical location, and for the caller ID or calling party number (“CPN”) (“caller ID” and “CPN” collectively hereafter, “caller ID”) of that call to appear to the receiving party as a telephone number from the receiving party’s local geographical region (e.g., area code) instead of the calling party’s actual telephone number that would have a caller ID from the calling party’s geographical region.

The 8,565,399 Patent

13. On October 22, 2013, the United States Patent and Trademark Office issued United States Patent No. 8,565,399 (“the ‘399 patent”), entitled “SYSTEM AND METHOD FOR MODIFYING COMMUNICATION INFORMATION (MCI)” attached hereto as Exhibit H.

14. NobelBiz is the assignee of the ‘399 patent.

15. By way of a general description, the ‘399 patent discloses a system for processing a telephone call from a call originator (calling party) to a call target (receiving party), comprising a database for storing telephone numbers, as well as a processor to select from the database a

COBLENTZ PATCH DUFFY & BASS LLP
ONE FERRY BUILDING, SUITE 200, SAN FRANCISCO, CALIFORNIA 94111-4213
415.391.4800 · FAX 415.989.1663

1 telephone number based on the call target’s area code, to set caller identification (or caller ID) data
2 to the selected number, and to transmit the caller ID data to the call target.

3 16. In practice, the invention of the ‘399 patent allows a calling party’s number to
4 appear local or from the same area code as the receiving party.

5 Award-Winning Patented Service

6 17. NobelBiz has embodied features of the ‘122 and ‘399 patents in its LocalTouch™
7 service.

8 18. LocalTouch™ is designed to enhance the effectiveness of, e.g., outbound
9 teleservice call centers, such as collection agencies and marketing firms, by increasing contact
10 rates between calling parties and receiving parties.

11 19. For example, by implementing the novel process of the ‘122 and ‘399 patents,
12 LocalTouch™ has been shown to increase contact rates between calling parties and receiving
13 parties by over thirty percent (30%).

14 20. LocalTouch™ has also received professional approval in the form of the
15 Technovation Award from the American Teleservices Association (“ATA”) in 2006, as well as the
16 Fulcrum Award from the ATA in 2009.

17
18 **DEFENDANT’S INFRINGING SYSTEM**

19 21. Defendant is a provider of, *inter alia*, contact or call center software and services.

20 22. These services include Market Dialer, Market Dialer Lite, Market Dialer Pro,
21 Outbound Call Center and Blended Call Center (hereinafter, “SafeSoft Services” or “Defendant’s
22 Services.”).

23 23. Upon information and belief, the SafeSoft Services contain a database for storing
24 outgoing telephone numbers.

25 24. Upon information and belief, the SafeSoft Services contain a processor to process a
26 trigger comprising a telephone number of the call target.

27
28

COBLENTZ PATCH DUFFY & BASS LLP
ONE FERRY BUILDING, SUITE 200, SAN FRANCISCO, CALIFORNIA 94111-4213
415.391.4800 · FAX 415.989.1663

1 25. Upon information and belief, the SafeSoft Services contain a processor to select
2 from the database a telephone number that has the same area code as the call target’s area code.

3 26. Upon information and belief, the SafeSoft Services contain a processor to set caller
4 ID data to the selected number.

5 27. Upon information and belief, the SafeSoft Services contain a processor to transmit
6 the caller ID data to the call target.

7 28. Upon information and belief, Paragraphs 23-27 are practiced in the SafeSoft
8 Services using a local caller ID feature (the “Local Caller ID Feature”).

9 29. SafeSoft, for example, has provided the Local Caller ID Feature under the name
10 “Local Touch.” Exs. A-C.

11 Local Touch is a feature that allows you to set a custom telephone
12 number that appears local to your called party Studies show
13 that prospects are more likely to answer the telephone if the caller
14 line ID displays a local number, instead of a remote area code, or a
15 ‘1-800’ number. Local Touch can significantly increase your
outbound campaign connects rates and list penetration. . . . Local
Touch increases the opportunities for your agents to connect with
live prospects and boosts the overall performance of your call
center!

16 Ex. A; Exs. B-C.

17 30. SafeSoft’s Local Caller ID Feature “allows you to control the outbound Caller ID
18 based on the area code of the lead that is being dialed. You may add as many different area codes
19 as you like” Ex. D; Ex. E; Ex. F (“Set campaign-specific outbound Caller IDs”).

20 31. Upon information and belief, the SafeSoft Services practice each and every element
21 of one or more claims of the ‘122 and ‘399 patents.

22 **COUNT I – PATENT INFRINGEMENT OF THE ‘122 PATENT**

23 32. NobelBiz restates and incorporates by reference paragraphs 1 through 31 as if
24 stated fully herein.

25 33. On information and belief, and in violation of 35 U.S.C. § 271(a), Defendant has,
26 literally and under the doctrine of equivalents, infringed the ‘122 patent and still is, literally and
27 under the doctrine of equivalents, infringing the ‘122 patent, by, among other things, making,
28

COBLENTZ PATCH DUFFY & BASS LLP
ONE FERRY BUILDING, SUITE 200, SAN FRANCISCO, CALIFORNIA 94111-4213
415.391.4800 · FAX 415.989.1663

1 using, offering for sale, and/or selling its SafeSoft Services and will continue to do so unless such
2 infringing activities are enjoined by this Court.

3 34. Upon information and belief, Defendant is willfully infringing the ‘122 patent by
4 offering to sell and selling the SafeSoft Services in the United States, including within this judicial
5 district.

6 (a) Prior to this lawsuit, Defendant had knowledge of NobelBiz’s ‘122 patent.
7 As acknowledged by SafeSoft, its competitors are at least Five 9 and LiveVox. Exs. I-K.
8 SafeSoft has “been competing with Five9 from day one, and they ’re [SafeSoft’s] closest match
9 from a competitive standpoint.” Ex. I; *see also* Exs. J-K. This close analysis of its competitors in
10 a small market means SafeSoft either knew or should have known of the lawsuits against Five 9
11 and LiveVox instituted in April 2012 involving the ‘122 patent.

12 (b) Further, SafeSoft’s use of NobelBiz’s LocalTouch™ mark as its own is, by
13 itself, a plausible basis for establishing that SafeSoft was aware of the patented technology of
14 NobelBiz’s LocalTouch™ service (or the ‘122 patent).

15 (c) Defendant has disregarded and continues to disregard an objectively high
16 likelihood that its actions constitute infringement of the ‘122 patent. This objectively-defined risk
17 has been known or is so obvious that it should have been known to Defendant. SafeSoft, even
18 having knowledge of the ‘122 patent, continued to offer a Local Caller ID Feature and provided a
19 “Local Touch” feature.

20 35. In violation of 35 U.S.C. § 271(b), Defendant is indirectly infringing the ‘122
21 patent by offering to sell and selling the SafeSoft Services in the United States, including within
22 this judicial district.

23 (a) Defendant had pre-suit knowledge of the ‘122 patent as discussed above.

24 (b) Defendant also knowingly induced infringement and possessed specific
25 intent to encourage another’s infringement which led to direct infringement by a third party of one
26 or more claims of the ‘122 patent, e.g., call centers, by use of the SafeSoft Services, and by
27
28

COBLENTZ PATCH DUFFY & BASS LLP
ONE FERRY BUILDING, SUITE 200, SAN FRANCISCO, CALIFORNIA 94111-4213
415.391.4800 · FAX 415.989.1663

1 soliciting end users to purchase and use the SafeSoft Services, in this district and elsewhere in the
2 United States.

3 (c) Defendant, for example, provides and advertises to its customers the
4 benefits of the Local Caller ID Feature through user manuals and other marketing and instructional
5 materials. Exs. A-F.

6 (d) On information and belief, as another example, Defendant further offers a
7 “test-drive” and training where customers can learn or be instructed on how the Local Caller ID
8 Feature operate. Ex. L (“Are you ready to test-drive the leading cloud-based call center solution?
9 Sign-up now to experience our high-performance predictive dialer and productivity suite”); Ex. M;
10 Ex. I (SafeSoft “ensure[s] that . . . [their customers are] properly trained on all aspects of the
11 software . . .”).

12 (e) By following the materials (and the Local Caller ID Feature), these
13 customers can, are intended to, and do practice the ‘122 patent.

14 36. In violation of 35 U.S.C. § 271(c), Defendant has contributorily infringed and
15 continues to contributorily infringe by selling and/or offering to sell in the United States the Local
16 Caller ID Feature, which:

17 (a) constitute a material part of the invention of the ‘122 patent;

18 (b) are known by Defendant to be especially adapted for use in infringing the
19 ‘122 patent. Exs. A-F; and

20 (c) are not suitable for substantial noninfringing use. The Local Caller ID
21 Feature allows a calling party’s number to appear local or from the same area code as the
22 receiving party and thus, have no substantial use that do not infringe one or more claims of the
23 ‘122 patent.

24 **COUNT II – PATENT INFRINGEMENT OF THE ‘399 PATENT**

25 37. NobelBiz restates and incorporates by reference paragraphs 1 through 36 as if
26 stated fully herein.

27
28

1 38. On information and belief, and in violation of 35 U.S.C. § 271(a), Defendant has,
2 literally and under the doctrine of equivalents, infringed the ‘399 patent and still is, literally and
3 under the doctrine of equivalents, infringing the ‘399 patent, by, among other things, making,
4 using, offering for sale, and/or selling its SafeSoft Services and will continue to do so unless such
5 infringing activities are enjoined by this Court.

6 39. In violation of 35 U.S.C. § 271(b), Defendant is indirectly infringing the ‘399
7 patent since the service of this Amended Complaint by offering to sell and selling the SafeSoft
8 Services in the United States, including within this judicial district.

9 (a) Defendant had knowledge of the ‘399 patent at least as of upon service of
10 this Amended Complaint, including the ‘399 patent.

11 (b) Defendant also knowingly induced infringement and possessed specific
12 intent to encourage another’s infringement which led to direct infringement by a third party of one
13 or more claims of the ‘399 patent, e.g., call centers, by use of the SafeSoft Services, and by
14 soliciting end users to purchase and use the SafeSoft Services, in this district and elsewhere in the
15 United States.

16 (c) Defendant, for example, provides and advertises to its customers the
17 benefits of the Local Caller ID Feature through user manuals and other marketing and instructional
18 materials. Exs. A-F.

19 (d) On information and belief, as another example, Defendant further offers a
20 “test-drive” and training where customers can learn or be instructed on how the Local Caller ID
21 Feature operate. Ex. L (“Are you ready to test-drive the leading cloud-based call center solution?
22 Sign-up now to experience our high-performance predictive dialer and productivity suite”); Ex. M;
23 Ex. I (SafeSoft “ensure[s] that . . . [their customers are] properly trained on all aspects of the
24 software . . .”).

25 (e) By following the materials (and the Local Caller ID Feature), these
26 customers can, are intended to, and do practice the ‘399 patent.

27
28

COBLENTZ PATCH DUFFY & BASS LLP
ONE FERRY BUILDING, SUITE 200, SAN FRANCISCO, CALIFORNIA 94111-4213
415.391.4800 · FAX 415.989.1663

1 40. In violation of 35 U.S.C. § 271(c), Defendant has contributorily infringed and
2 continues to contributorily infringe since the service of this Amended Complaint, by selling and/or
3 offering to sell in the United States the Local Caller ID Feature, which:

4 (a) constitute a material part of the invention of the ‘399 patent;
5 (b) are known by Defendant since at least as of upon the service of this
6 Amended Complaint, including the ‘399 patent, to be especially adapted for use in infringing the
7 ‘399 patent. Exs. A-F; and

8 (c) are not suitable for substantial noninfringing use. The Local Caller ID
9 Feature allows a calling party’s number to appear local or from the same area code as the
10 receiving party and thus, have no substantial use that do not infringe one or more claims of the
11 ‘399 patent.

12 41. NobelBiz will be substantially and irreparably harmed if Defendant’s infringement
13 of the ‘122 and ‘399 patents is not enjoined. Plaintiffs do not have an adequate remedy at law.

14 42. NobelBiz is entitled to recover from the Defendant the damages sustained as a
15 result of Defendant’s infringing acts.

16 **COUNT III: FALSE DESIGNATION OF ORIGIN AND FALSE REPRESENTATION**
17 **UNDER SECTION 43(a) OF THE LANHAM ACT**

18 43. NobelBiz restates and incorporates by reference paragraphs 1 through 42 as if
19 stated fully herein.

20 44. NobelBiz is the owner of valid, common law trademark rights in and to the
21 LocalTouch™ trademark based on its continuous use of that mark throughout the United States
22 from July 20, 2005 through the present.

23 45. Defendant has used, and upon information and belief, continues to use
24 NobelBiz’s LocalTouch™ mark in commerce in conjunction with Defendant’s Service, without
25 NobelBiz’s consent. Exs. A-C.

26 46. NobelBiz’s rights in and to the LocalTouch™ mark are prior to Defendant’s
27 foregoing infringing conduct.

28

COBLENTZ PATCH DUFFY & BASS LLP
ONE FERRY BUILDING, SUITE 200, SAN FRANCISCO, CALIFORNIA 94111-4213
415.391.4800 · FAX 415.989.1663

1 47. Defendant’s aforesaid acts constitute the use in commerce of false designations of
2 origin and false and misleading representations, which have caused and are likely to cause
3 confusion and to deceive as to the affiliation, connection and association of Defendant with
4 NobelBiz, and as to the source and origin of Defendant’s Service; and misrepresents the nature,
5 characteristics and/or quality of Defendant’s Service in violation of section 43(a) of the Lanham
6 Act, 15 U.S.C. § 1125(a).

7 48. The aforesaid acts of Defendant have caused and will continue to cause
8 irreparable injury to NobelBiz, and unless such acts are restrained by this Court, they will be
9 continued and NobelBiz and the public will continue to suffer irreparable injury.

10 **COUNT IV: TRADEMARK INFRINGEMENT UNDER COMMON LAW**

11 49. NobelBiz restates and incorporates by reference paragraphs 1 through 48 as if
12 stated fully herein.

13 50. Defendant’s acts constitute an infringement of NobelBiz’s LocalTouch™ mark in
14 violation of the common law.

15 51. The aforesaid acts of Defendant have caused and continue to cause NobelBiz
16 damages in a manner that cannot be fully measured or compensated in economic terms and for
17 which there is no adequate remedy at law.

18 52. The infringing actions of Defendant has damaged, and will continue to damage,
19 NobelBiz’s rights, reputation and goodwill.

20 53. NobelBiz is entitled to an injunction restraining Defendant, its officers, agents,
21 and employees, and all persons acting in concert with Defendant, from engaging in further acts of
22 trademark infringement.

23 54. Such harm will continue and increase until Defendant is preliminarily and
24 permanently enjoined by this Court from its unlawful conduct.

25 55. NobelBiz is further entitled to recover from Defendant the actual damages that it
26 sustained and/or is likely to sustain as a result of Defendant’s wrongful acts. NobelBiz is
27
28

COBLENTZ PATCH DUFFY & BASS LLP
ONE FERRY BUILDING, SUITE 200, SAN FRANCISCO, CALIFORNIA 94111-4213
415.391.4800 · FAX 415.989.1663

1 presently unable to ascertain the full extent of the monetary damages that it has suffered and/or is
2 likely to suffer by reason of Defendant’s acts of trademark infringement.

3 56. NobelBiz is further entitled to recover from Defendant the gains, profits, and
4 advantages that Defendant has obtained as a result of its wrongful acts.

5 57. Plaintiff is presently unable to ascertain the full extent of the gains, profits, and
6 advantages that Defendant has realized by reason of its acts of trademark infringement.

7
8 **PRAYER FOR RELIEF**

9 Plaintiff requests that:

10 (a) Judgment be entered that Defendant has directly and indirectly infringed the
11 ‘122 and 399 patents;

12 (b) An accounting be had for the damages resulting from Defendant’s
13 infringement of the ‘122 patent, including, without limitation, lost profits caused by the infringing
14 activities of Defendant, and that the damages so ascertained be trebled and awarded together with
15 interest and costs;

16 (c) An accounting be had for the damages resulting from Defendant’s
17 infringement of the ‘399 patent, including, without limitation, lost profits caused by the infringing
18 activities of Defendant, and that the damages so ascertained be awarded together with interest and
19 costs;

20 (d) Judgment be entered that this is an exceptional case, and that NobelBiz is
21 entitled to its reasonable attorney fees pursuant to 35 U.S.C. § 285;

22 (e) A permanent injunction be issued, restraining and enjoining Defendant, its
23 officers, agents, attorneys, and employees, and those acting in privity or concert with them, from
24 engaging in the commercial manufacture, use, offer for sale, or sale within the United States, or
25 importation into the United States, of systems claimed in the ‘122 and ‘399 patents;

26 (f) For Damages to be proven at trial for violation of the Lanham Act and
27 common law trademark infringement, and as set forth in 15 U.S.C. § 1117(a);

28

COBLENTZ PATCH DUFFY & BASS LLP
ONE FERRY BUILDING, SUITE 200, SAN FRANCISCO, CALIFORNIA 94111-4213
415.391.4800 · FAX 415.989.1663

1
2
3
4
5
6
7
8
9
10
11
12
13
14
15
16
17
18
19
20
21
22
23
24
25
26
27
28

(g) For injunctive relief barring Defendant and its agents, employees, subsidiaries, licensees, successors, and assigns, and all other persons in active concert, privity or participation with it, from doing, abiding, causing or abetting any infringing use of NobelBiz’s LocalTouch™ mark or any confusingly similar trademarks in any way, including in advertising, promoting, or selling Defendant’s products and services, which infringe upon NobelBiz’s rights or compete unfairly with NobelBiz; and

(h) The Court award such other and further relief as the Court may deem just and proper under the circumstances.

DATED: October 23, 2013 COBLENTZ PATCH DUFFY & BASS LLP

By: /s/ Julia D. Greer
JULIA D. GREER
Attorneys for Plaintiff
NOBELBIZ, INC.

ANDREW P. MACARTHUR*
GIBBONS P.C.
One Pennsylvania Plaza, 37th Floor
New York, New York 10119
Phone: (212) 613-2000
Facsimile: (212) 290-2018
Email: amacarthur@gibbonslaw.com

* Admitted *Pro Hac Vice*
Attorneys for Plaintiff
NOBELBIZ, INC.