

**UNITED STATES DISTRICT COURT
DISTRICT OF MINNESOTA**

SKIPPRINT, LLC

Plaintiff,

v.

THE JOHN ROBERTS COMPANY

Defendant.

Case No. _____

**COMPLAINT FOR PATENT
INFRINGEMENT, PERMANENT
INJUNCTION AND DAMAGES**

DEMAND FOR JURY TRIAL

For its Complaint against Defendant The John Roberts Company (“Defendant”), Plaintiff SkipPrint, LLC (“SkipPrint”) alleges as follows:

THE PARTIES

1. Plaintiff SkipPrint LLC (“SkipPrint”) is a Delaware corporation having a principal place of business at 1875 Century Park East, Suite 700, Los Angeles, CA 90067.

2. On information and belief, Defendant The John Roberts Company (“John Roberts”) is a corporation with its principal place of business at 9687 East River Road, Minneapolis, Minnesota 55433.

JURISDICTION AND VENUE

3. This is a civil action for patent infringement arising under the Patent Act of the United States, 35 U.S.C. §§ 1 *et seq.* This court has subject matter jurisdiction of such federal question claims pursuant to 28 U.S.C. §§ 1331 and 1338(a).

4. Venue is proper under 28 U.S.C. §§ 1391(b), 1391(c) and 1400(b) in that the acts and transactions complained of herein were conceived, carried out, made

effective, and had effect within the State of Minnesota and within this district, among other places. Defendant resides in this judicial district by virtue of its business activities in this district, has committed acts of infringement in this judicial district, or has committed acts of contributory infringement and inducement of infringement within this judicial district.

SKIPPRINT'S PATENTS-IN-SUIT

5. On June 13, 2000, the United States Patent & Trademark Office duly and legally issued United States Letters Patent No. 6,076,080 (“the ‘080 Patent”), entitled “FORMS ORDER ENTRY SYSTEM.” A true and correct copy of this patent is attached hereto as Exhibit A.

6. The ‘080 patent claims, among other things, computer-based forms order entry systems. This invention enables an efficient, innovative, and user-friendly electronic online forms order entry process.

7. The ‘080 patent is owned by The Standard Register Company. To allow enforcement and protection of this patent and the technology it represents, in December 2012, The Standard Register Company executed an exclusive license agreement with SkipPrint, LLC (“Standard Register Exclusive License Agreement”) and, by this Standard Register Exclusive License Agreement, granted SkipPrint the exclusive right to practice, enforce, and sublicense, among other rights, the ‘080 Patent, effective December 31, 2012. A true and correct copy of the Standard Register Exclusive License Agreement is attached hereto as Exhibit B and incorporated herein by reference.

8. On September 9, 1997, the United States Patent & Trademark Office duly and legally issued United States Letters Patent No. 5,666,493 (“the ‘493 Patent”), entitled “SYSTEM FOR MANAGING CUSTOMER ORDERS AND METHOD OF IMPLEMENTATION.” A true and correct copy of this patent is attached hereto as Exhibit C.

9. On May 23, 2006, the United States Patent & Trademark Office duly and legally issued United States Letters Patent No. 7,050,995 (“the ‘995 Patent”), entitled “SYSTEM FOR MANAGING ORDERS AND METHOD OF IMPLEMENTATION.” A true and correct copy of this patent is attached hereto as Exhibit D.

10. On June 6, 2006, the United States Patent & Trademark Office duly and legally issued United States Letters Patent No. 7,058,596 (“the ‘596 Patent”), entitled “SYSTEM FOR MANAGING ORDERS AND METHODS OF IMPLEMENTATION.” A true and correct copy of this patent is attached hereto as Exhibit E.

11. The ‘493, ‘995, and ‘596 patents are owned by Lykes Bros, Inc. To allow enforcement and protection of this patent and the technology it represents, in December, 2012, Lykes Bros., Inc. executed an exclusive license agreement with SkipPrint, LLC (“Lykes Bros. Exclusive License Agreement”) and, by this Lykes Bros. Exclusive License Agreement, granted SkipPrint the exclusive right to practice, enforce, and sublicense, among other rights, the ‘995 Patent. A true and correct copy of the Lykes Bros. Exclusive License Agreement is attached hereto as Exhibit F and incorporated herein by reference.

12. On October 5, 1999, the United States Patent & Trademark Office duly and legally issued United States Letters Patent No. 5,963,641 (“the ‘641 Patent”), entitled “DEVICE AND METHOD FOR EXAMINING, VERIFYING, CORRECTING, AND APPROVING ELECTRONIC DOCUMENTS PRIOR TO PRINTING, TRANSMISSION, OR RECORDING.” A true and correct copy of this patent is attached hereto as Exhibit G.

13. The ‘641 patent claims, among other things, computer-based pre-flight systems and methods. This invention enables an efficient, innovative, and user-friendly system for pre-flight electronic documents intended for printing.

14. The ‘641 patent is owned by the Markzware corporation. To allow enforcement and protection of this patent and the technology it represents, in February, 2013, Markzware executed an exclusive license agreement with SkipPrint, LLC (“Markzware Exclusive License Agreement”) and, by this Markzware Exclusive License Agreement, granted SkipPrint the exclusive right to practice, enforce, and sublicense, among other rights, the ‘641 Patent, effective February 26, 2013. A true and correct copy of the Markzware Exclusive License Agreement is attached hereto as Exhibit H and incorporated herein by reference.

15. John Roberts was put on notice of these patents as early as July 11, 2014 when SkipPrint sent a letter to John Roberts notifying John Roberts of its infringing activities. Attached as Exhibit I is a true and correct copy of the letter. Therefore, John Roberts had knowledge of the patents-in-suit as early as July 11, 2014.

CLAIM I
INFRINGEMENT OF U.S. PATENT NO. 6,076,080

16. Plaintiff incorporates herein by reference the allegations set forth in paragraphs 1-15 of the Complaint as though fully set forth herein.

17. On information and belief, Defendant John Roberts has been and now is infringing the '080 patent in the State of Minnesota, including claim 1 for example, in this judicial district, and elsewhere in the United States by providing their web-based online storefront system(s), including, but not limited to XMPie, to at least their U.S. customers over the Internet through their storefront online services, which can be found at <http://www.johnroberts.com/services/storefront-fulfillment/>.

18. By making, using, selling, and offering for sale such systems, and all like products and related services that are covered by one or more claims of the '080 patent, Defendant John Roberts has infringed and continues to directly infringe the '080 Patent, including infringement under 35 U.S.C. § 271(a) and (f).

19. Defendant John Roberts' storefront online services are accompanied with online marketing, encouraging its customers to operate these systems and services in an infringing manner. These services can be found, for example, at <http://www.johnroberts.com/services/storefront-fulfillment/>.

20. On information and belief, as a result of Defendant John Roberts' encouragement, through at least its online marketing, Defendant John Roberts' customers were induced to operate these systems and services, namely Defendant John Roberts' storefront online services, in an infringing manner. For instance, Defendant John

Roberts' customers would visit <http://www.johnroberts.com/services/storefront-fulfillment/> and follow the instructions set forth at this site to operate the accused systems and services in an infringing manner.

21. Accordingly, Defendant has also indirectly infringed and continues to indirectly infringe the '080 patent by actively inducing others to cause direct infringement—specifically, customers and partners of Defendant—who operate these systems and methods that embody or otherwise practice one or more claims of the '080 patent when Defendant had knowledge of the '080 patent and knew or should have known that their actions would induce direct infringement by others and intended that their actions would induce direct infringement by others.

22. On information and belief, Defendant will continue to infringe the '080 Patent unless enjoined by this Court.

23. On information and belief, Defendant's infringement of the '080 Patent is, has been, and continues to be willful and deliberate.

24. As a direct and proximate result of Defendant's infringement of the '080 Patent, SkipPrint has been, and continues to be damaged in an amount yet to be determined.

25. Unless a preliminary and permanent injunction are issued enjoining Defendant and its officers, agents, servants and employees, and all others acting on their behalf or in concert with Defendant, from infringing the '080 Patent, SkipPrint, will be greatly and irreparably harmed.

CLAIM II
INFRINGEMENT OF U.S. PATENT NO. 7,050,995

26. Plaintiff incorporates herein by reference the allegations set forth in paragraphs 1-25 of the Complaint as though fully set forth herein.

27. On information and belief, Defendant John Roberts has been and now is infringing the '995 patent in the State of Minnesota, including claims 17 and 32 for example, in this judicial district, and elsewhere in the United States by providing their web-based online storefront system(s) and/or fulfillment systems(s), including, but not limited to EFI Monarch and Veracore Pro-Mail, to at least their U.S. customers over the Internet through their use of their online store front system, which can be found at <http://www.johnroberts.com/services/storefront-fulfillment/>.

28. By making, using, selling, and offering for sale such systems, and all like products and related services that are covered by one or more claims of the '995 patent, Defendant John Roberts has infringed and continues to directly infringe the '995 Patent, including infringement under 35 U.S.C. § 271(a) and (f).

29. On information and belief, Defendant will continue to infringe the '995 Patent unless enjoined by this Court.

30. On information and belief, Defendant's infringement of the '995 Patent is, has been, and continues to be willful and deliberate.

31. As a direct and proximate result of Defendant's infringement of the '995 Patent, SkipPrint has been and continues to be damaged in an amount yet to be determined.

32. Unless a preliminary and permanent injunction are issued enjoining Defendant and its officers, agents, servants and employees, and all others acting on their behalf or in concert with Defendant, from infringing the '995 Patent, SkipPrint, will be greatly and irreparably harmed.

CLAIM III
INFRINGEMENT OF U.S. PATENT NO. 5,666,493

33. Plaintiff incorporates herein by reference the allegations set forth in paragraphs 1-32 of the Complaint as though fully set forth herein.

34. On information and belief, Defendant John Roberts has been and now is infringing the '493 patent in the State of Minnesota, including claim 2 for example, in this judicial district, and elsewhere in the United States by providing their web-based online storefront system(s) and/or fulfillment systems(s), including, but not limited to EFI Monarch and Veracore Pro-Mail, to at least their U.S. customers over the Internet through their use of their online store front system, which can be found at <http://www.johnroberts.com/services/storefront-fulfillment/>.

35. By making, using, selling, and offering for sale such systems, and all like products and related services that are covered by one or more claims of the '493 patent, Defendant John Roberts has infringed and continues to directly infringe the '493 Patent, including infringement under 35 U.S.C. § 271(a) and (f).

36. On information and belief, Defendant will continue to infringe the '493 Patent unless enjoined by this Court.

37. On information and belief, Defendant's infringement of the '493 Patent is, has been, and continues to be willful and deliberate.

38. As a direct and proximate result of Defendant's infringement of the '493 Patent, SkipPrint has been and continues to be damaged in an amount yet to be determined.

39. Unless a preliminary and permanent injunction are issued enjoining Defendant and its officers, agents, servants and employees, and all others acting on their behalf or in concert with Defendant, from infringing the '493 Patent, SkipPrint, will be greatly and irreparably harmed.

CLAIM IV
INFRINGEMENT OF U.S. PATENT NO. 7,058,596

40. Plaintiff incorporates herein by reference the allegations set forth in paragraphs 1-39 of the Complaint as though fully set forth herein.

41. On information and belief, Defendant John Roberts has been and now is infringing the '596 patent in the State of Minnesota, including claim 4 for example, in this judicial district, and elsewhere in the United States by providing their web-based online storefront system(s) and/or fulfillment systems(s), including, but not limited to EFI Monarch and Veracore Pro-Mail, to at least their U.S. customers over the Internet through their use of their online store front system, which can be found at <http://www.johnroberts.com/services/storefront-fulfillment/>.

42. By making, using, selling, and offering for sale such systems, and all like products and related services that are covered by one or more claims of the '596 patent,

Defendant John Roberts has infringed and continues to directly infringe the '596 Patent, including infringement under 35 U.S.C. § 271(a) and (f).

43. On information and belief, Defendant will continue to infringe the '596 Patent unless enjoined by this Court.

44. On information and belief, Defendant's infringement of the '596 Patent is, has been, and continues to be willful and deliberate.

45. As a direct and proximate result of Defendant's infringement of the '596 Patent, SkipPrint has been and continues to be damaged in an amount yet to be determined.

46. Unless a preliminary and permanent injunction are issued enjoining Defendant and its officers, agents, servants and employees, and all others acting on their behalf or in concert with Defendant, from infringing the '596 Patent, SkipPrint, will be greatly and irreparably harmed.

CLAIM V
INFRINGEMENT OF U.S. PATENT NO. 5,963,641

47. Plaintiff incorporates herein by reference the allegations set forth in paragraphs 1-46 of the Complaint as though fully set forth herein.

48. On information and belief, Defendant John Roberts has been and now is infringing the '641 patent in the State of Minnesota, including claim 10 for example, in this judicial district, and elsewhere in the United States by providing or using their storefront online services, including, but not limited to XMPie, which can be found at <http://www.johnroberts.com/services/storefront-fulfillment>.

49. By making, using, selling, and offering for sale such systems, and all like products and related services that are covered by one or more claims of the '641 patent, Defendant John Roberts has infringed and continues to directly infringe the '641 Patent, including infringement under 35 U.S.C. § 271(a) and (f).

50. On information and belief, Defendant will continue to infringe the '641 Patent unless enjoined by this Court.

51. On information and belief, Defendant's infringement of the '641 Patent is, has been, and continues to be willful and deliberate.

52. As a direct and proximate result of Defendant's infringement of the '641 Patent, SkipPrint has been and continues to be damaged in an amount yet to be determined.

53. Unless a preliminary and permanent injunction are issued enjoining Defendant and its officers, agents, servants and employees, and all others acting on their behalf or in concert with Defendant, from infringing the '641 Patent, SkipPrint, will be greatly and irreparably harmed.

PRAYER FOR RELIEF

WHEREFORE, Plaintiff SkipPrint, LLC prays for judgment against the Defendant as follows:

(1) For a judicial determination and declaration that the Defendant has infringed, and continue to infringe, United States Letters Patent Nos. 6,076,080; 5,666,493; 7,050,995; 7,058,596; and 5,963,641;

(2) For a judicial determination and decree that the Defendant, its respective subsidiaries, officers, agents, servants, employees, licensees, and all other persons or entities acting or attempting to act in active concert or participation with them or acting on their behalf, be preliminarily and permanently enjoined from further infringement of the '080, '493, '995, '596, and '641 Patents;

(3) For a declaration that the Defendant notify all of its customers, vendors and users of the infringing system(s) and customers' participation in the infringement with Defendant's encouragement, and that Defendant encourage its customers, vendors and users to cease all such infringing actions;

(4) For a judicial decree that orders Defendant to account for and pay to SkipPrint, LLC all damages caused to SkipPrint, LLC by reason of Defendant's infringement pursuant to 35 U.S.C. Section 284, including enhanced damages under 35 U.S.C. Section 285;

(5) For an award of damages according to proof at trial;

(6) For a judicial order awarding to SkipPrint, LLC pre-judgment and post-judgment interest on the damages caused to it by Defendant's infringement; and

(7) For any such other and further relief as the Court may deem just and equitable.

DEMAND FOR JURY TRIAL

Plaintiff hereby demands a trial by jury of all issues so triable.

Date: August 13, 2014

Respectfully submitted,

By: s/ Jeffrey C. Brown

Jeffrey C. Brown (#0256948)
jeffb@SapientiaLaw.com
SAPIENTIA LAW GROUP PLLC
12 South Sixth Street, Suite 1242
Minneapolis, MN 55402
Telephone: (612) 756-7100
Facsimile: (612) 756-7101

Joseph K. Liu (CA Bar No. 216227)
jliu@onellp.com
Nate L. Dilger (CA Bar No. 196203)
ndilger@onellp.com
ONE LLP
4000 MacArthur Boulevard
West Tower, Suite 1100
Newport Beach, CA 92660
Telephone: (949) 502-2870
Facsimile: (949) 258-5081

C.J. Veverka (UT Bar No. 7110)
CVeverka@mabr.com
MASCHOFF BRENNAN
201 South Main Street, Suite 600
Salt Lake City, UT 84111
Telephone: (435) 252-1360
Facsimile: (435) 252-1361

Attorneys for Plaintiff SkipPrint, LLC