

1 MITCHELL + COMPANY
2 Brian E. Mitchell (SBN 190095)
3 *brian.mitchell@mc lawoffices.com*
4 Marcel F. De Armas (SBN 289282)
5 *mdearmas@mc lawoffices.com*
6 4 Embarcadero Center, Suite 1400
7 San Francisco, California 94111
8 Tel: 415-766-3514
9 Fax: 415-402-0058

10 Attorneys for Plaintiff
11 INCASE DESIGNS, CORP

12 UNITED STATES DISTRICT COURT
13 FOR THE CENTRAL DISTRICT OF CALIFORNIA

14 INCASE DESIGNS, CORP.

15 Plaintiff,

16 v.

17 ECLIPSE IP, LLC,

18 Defendant.

Case No.: 5:14-cv-02023-GW-AJW

**AMENDED COMPLAINT FOR
DECLARATORY JUDGMENT**

DEMAND FOR JURY TRIAL

1 Plaintiff Incase Designs, Corp (“Plaintiff” or “Incase”) complains as follows:

2 **NATURE OF ACTION**

3 1. This is an action seeking Declaratory Judgment that twenty-two United
4 States Patent (“Patents-in-Suit” or “Eclipse Patent Portfolio”), which are owned by
5 Defendant Eclipse IP, LLC (“Eclipse” or “Defendant”), have not been infringed by
6 Incase and are invalid.

7 2. This action arises under the Declaratory Judgment Act, 28 U.S.C. §§
8 2201 and 2202, and the Patent Laws of the United States, Title 35 of the United
9 States Code.

10 **THE PARTIES**

11 3. Incase is a California corporation and a global leader in the design,
12 development, manufacture, and sale of carrying cases, bags, and covers for
13 consumer electronics.

14 4. On information and belief, Eclipse purports to be a Texas limited
15 liability company with a place of business at 711 SW 24th, Boyton Beach, Florida
16 33435. On information and belief, Eclipse is the owner of the Patents-in-Suit.

17 5. Upon information and belief, Eclipse is in the business of patent
18 licensing through the threat of litigation.

19 6. Upon information and belief, a key part of Eclipse’s business model is
20 sending letters, emails, and making telephone calls threatening patent litigation and
21 following through on that threat.

22 **JURISDICTION AND VENUE**

23 7. The Court has subject matter jurisdiction of this action under 28 U.S.C.
24 §§ 1331 and 1338(a) in that it arises under the United States Patent Laws.

25 8. This Court has personal jurisdiction over the Defendant pursuant to the
26 laws of the State of California, including California’s long-arm statute and
27 California Code of Civil Procedure § 410.10.

1 9. Eclipse has filed at least 36 cases asserting patent infringement in this
2 District, and has been involved in 115 lawsuits involving the Eclipse Patent
3 Portfolio nationwide.

4 10. Eclipse has litigated the Patents-in-Suit in this judicial district more
5 than any other district.

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

7 **PATENTS-IN-SUIT / ECLIPSE PATENT PORTFOLIO**

8 12. On October 10, 2006, U.S. Patent No. 7,119,716 (the ‘716 Patent),
9 entitled Response Systems and Methods for Notification Systems for Modifying
10 Future Notifications was issued. Claims 1, 2, 4, 6, 7, 18, 19, 20, 41, 43, 44, 45, and
11 46 of the ‘716 Patent were found to be invalid for failing to satisfy 35 U.S.C. § 101.

12 13. On June 20, 2006, U.S. Patent No. 7,064,681 (the ‘681 Patent), entitled
13 Response Systems and Methods for Notification Systems was issued. The ‘681
14 Patent resulted from a continuation application of the ‘716 Patent’s application.
15 Claims 1, 3, 4, and 6 of the ‘681 Patent were found to be invalid for failing to satisfy
16 35 U.S.C. § 101.

17 14. On September 26, 2006, U.S. Patent No. 7,113,110 (the ‘110 Patent),
18 entitled Stop List Generation Systems and Methods Based upon Tracked PCD’s and
19 Responses from Notified PCD’s was issued. The ‘110 Patent resulted from a
20 continuation application of the ‘716 Patent’s application. Claims 1, 2, 7, and 8 of the
21 ‘110 Patent were found to be invalid for failing to satisfy 35 U.S.C. § 101.

22 15. On January 15, 2008, U.S. Patent No. 7,319,414 (the ‘414 Patent),
23 entitled Secure Notification Messaging Systems and Methods Using Authentication
24 Indicia was issued. The ‘414 Patent resulted from a continuation application of the
25 ‘716 Patent, which had claims invalidated for claiming unpatentable subject matter.

26 16. On January 20, 2009, U.S. Patent No. 7,479,899 (the ‘9,899 Patent),
27 entitled Notification Systems and Methods Enabling a Response to Cause
28

1 Connection Between a Notified PCD and a Delivery or Pickup Representative was
2 issued. The ‘9,899 Patent resulted from a continuation application of the ‘716
3 Patent, which had claims invalidated for claiming unpatentable subject matter.

4 17. On January 20, 2009, U.S. Patent No. 7,479,900 (the ‘900 Patent),
5 entitled Notification Systems and Methods that Consider Traffic Flow Predicament
6 Data was issued. The ‘900 Patent resulted from a divisional application of the ‘716
7 Patent, which had claims invalidated for claiming unpatentable subject matter.

8 18. On January 20, 2009, U.S. Patent No. 7,479,901 (the ‘901 Patent),
9 entitled Mobile Thing Determination Systems and Methods Based upon User-
10 Device Location was issued. The ‘901 Patent claims priority to the ‘716 Patent,
11 which had claims invalidated for claiming unpatentable subject matter.

12 19. On January 27, 2009, U.S. Patent No. 7,482,952 (the ‘952 Patent),
13 entitled Response Systems and Methods for Notification Systems for Modifying
14 Future Notifications was issued. The ‘952 Patent resulted from a divisional
15 application of the ‘716 Patent, which had claims invalidated for claiming
16 unpatentable subject matter.

17 20. On March 17, 2009, U.S. Patent No. 7,504,966 (the ‘966 Patent),
18 entitled Response Systems and Methods for Notification Systems for Modifying
19 Future Notifications was issued. The ‘966 Patent claims priority to the ‘716 Patent,
20 which had claims invalidated for claiming unpatentable subject matter.

21 21. On May 5, 2009, U.S. Patent No. 7,528,742 (the ‘742 Patent), entitled
22 Response System and Methods for Notification Systems for Modifying Future
23 Notifications was issued. The ‘742 Patent claims priority to the ‘716 Patent, which
24 had claims invalidated for claiming upatentable subject matter.

25 22. On May 26, 2009, U.S. Patent No. 7,538,691 (the ‘691 Patent), entitled
26 Mobile Thing Determination Systems and Methods Based upon User-Device
27
28

1 Location was issued. The '691 Patent claims priority to the '716 Patent, which had
2 claims invalidated for claiming upatentable subject matter.

3 23. On July 14, 2009, U.S. Patent No. 7,561,069 (the '069 Patent), entitled
4 Notification Systems and Methods Enabling a Response to Change Particulars of
5 Delivery or Pickup was issued. The '069 Patent resulted from a divisional
6 application of the '716 Patent, which had claims invalidated for claiming
7 upatentable subject matter

8 24. On January 25, 2011, U.S. Patent No. 7,876,239 (the '239 Patent),
9 entitled Secure Notification Messaging Systems and Methods Using Authentication
10 Indicia was issued. The '239 Patent resulted from a continuation application of the
11 '414 Patent, which resulted from a continuation application of the '716 Patent,
12 which had claims invalidated for claiming unpatentable subject matter.

13 25. On November 29, 2011, U.S. Patent No. 8,068,037 (the '037 Patent),
14 entitled Advertisement Systems and Methods for Notification Systems was issued.
15 The '037 Patent claims priority to the '716 Patent, which had claims invalidated for
16 claiming unpatentable subject matter.

17 26. On July 31, 2012, U.S. Patent No. 8,232,899 (the '2,899 Patent),
18 entitled Notification System and Methods Enabling Selection of Arrival or
19 Departure Times of Tracked Mobile Things in Relation to Locations was issued.
20 The '2,899 Patent claims priority to the '716 Patent, which had claims invalidated
21 for claiming unpatentable subject matter.

22 27. On August 14, 2012, U.S. Patent No. 8,242,935 (the '935 Patent),
23 entitled Notification System and Methods Where a Notified PCD Causes
24 Implementation of a Task(s) Based Upon Failure to Receive a Notification was
25 issued. The '935 Patent claims priority to the '716 Patent, which had claims
26 invalidated for claiming unpatentable subject matter.

27
28

1 28. On October 10, 2012, U.S. Patent No. 8,284,076 (the '076 Patent),
2 entitled Systems and Methods for a Notification System that Enable User Changes
3 to Quantity of Goods and/or Services for Deliver and/or Pickup was issued. The
4 '076 Patent claims priority to the '716 Patent, which had claims invalidated for
5 claiming unpatentable subject matter.

6 29. On January 29, 2013, U.S. Patent No. 8,362,927 (the '927 Patent),
7 entitled Advertisement Systems and Methods for Notification Systems was issued.
8 The '927 Patent claims priority to the '716 Patent, which had claims invalidated for
9 claiming unpatentable subject matter.

10 30. On February 5, 2013, U.S. Patent No. 8,368,562 (the '562 Patent),
11 entitled Systems and Methods for a Notification System that Enable User Changes
12 to Stop Location for Delivery and/or Pickup of Good and/or Service was issued. The
13 '562 Patent claims priority to the '716 Patent, which had claims invalidated for
14 claiming unpatentable subject matter.

15 31. On September 10, 2013, U.S. Patent No. 8,531,317 (the '317 Patent),
16 entitled Notification Systems and Methods Enabling Selection of Arrival or
17 Departure Times of Tracked Mobile Things in Relation to Locations was issued.
18 The '317 Patent claims priority to the '716 Patent, which had claims invalidated for
19 claiming unpatentable subject matter.

20 32. On October 22, 2013, U.S. Patent No. 8,564,459 (the '459 Patent),
21 entitled Systems and Methods for a Notification System that Enable User Changes
22 to Purchase Order Information for Delivery and/or Pickup of Goods and/or Services
23 was issued. The '459 Patent claims priority to the '716 Patent, which had claims
24 invalidated for claiming unpatentable subject matter.

25 33. On April 29, 2014, U.S. Patent No. 8,711,010 (the '010 Patent),
26 entitled Notification Systems and Methods that Consider Traffic Flow Predicament
27
28

1 Data was issued. The ‘010 Patent claims priority to the ‘716 Patent, which had
2 claims invalidated for claiming unpatentable subject matter.

3 34. Collectively the twenty-two patents identified in paragraphs 12 to 33
4 are the Patents-in-Suit and the known Eclipse Patent Portfolio.

5 35. All the Patents-in-Suit are related and claim priority to the ‘716 Patent.

6 **ECLIPSE’S THREATS AGAINST INCASE**

7 36. On or about August 15, 2014, Matt Olavi of the law firm Olavi Dunne
8 LLP, counsel for Eclipse, sent a letter to Tony Held, CEO of Incase, at Incase’s
9 Chino, California offices (the “Olavi letter”).

10 37. The Olavi letter asserts that Incase infringes the Eclipse Patent
11 Portfolio, warns that Eclipse “aggressively litigates patent infringement lawsuits,”
12 and gave September 19, 2014 as a cutoff date, after which, Eclipse “assume[s] that
13 [Incase is] not interested in resolving this matter without litigation.” A true and
14 correct copy of that letter is attached hereto as Exhibit 1.

15 38. The Olavi letter specifically identifies twenty of the twenty-two patents
16 in the Eclipse Patent Portfolio by patent number. The two unidentified patents—the
17 ‘317 and ‘010 Patents—in the Olavi letter are both related to the ‘716 Patent and
18 Eclipse has asserted the ‘317 Patent on five different occasions.

19 39. The Olavi letter states that a flash drive with copies of all the patents in
20 Eclipse Patent Portfolio is enclosed. On information and belief, all twenty-two of the
21 Patents-in-Suit, comprising the entire Eclipse Patent Portfolio, were included on this
22 flash drive.

23 40. In the Olavi letter, Eclipse alleges that the “electronic messaging
24 features of [Incase’s] online ordering system” infringes the claims of the Eclipse
25 Patents,” and provides three claims as representative examples of Incase’s alleged
26 infringement of the Eclipse Patent Portfolio.

27
28

1 41. On September 4, 2014, District Court Judge George H. Wu, presiding
2 over the case of *Eclipse IP LLC v. McKinley Equipment Corporation*, granted the
3 defendant’s Motion to Dismiss for Lack of Patentable Subject Matter, and
4 invalidated every claim he was asked to consider from the ‘681, ‘110, and ‘716
5 Patents. This included invalidating the asserted claims of one of the patents Eclipse
6 used as a representative example of Incase’s alleged infringement of the Eclipse
7 Patent Portfolio.

8 42. On or about September 19, 2014, Edward Turnbull, an individual
9 associated with Eclipse, place a telephone call to Incase, asking to speak with Mr.
10 Held. He followed up with an email to an Incase employee, attaching the Olavi
11 letter alleging infringement of the Patents-in-Suit (the “Turnbull email”).

12 43. The Turnbull email and attachment reaffirms Eclipse’s aggressive
13 posture, and concludes with the threat that Eclipse’s “next step will be litigation.”

14 44. The Turnbull email and attachment included patents, which had claims
15 declared invalid and included claims, as representative examples of Incase alleged
16 infringement, that claimed the same abstract ideas as the claims Judge Wu
17 invalidated.

18 45. Eclipse’s first representative example of Incase alleged infringement
19 was Claim 1 of the ‘239 Patent. This claim is extremely similar to the now invalid
20 Claim 41 of the ‘416 Patent, except that it requires the party to have authentication
21 information.

22 46. Eclipse’s second representative example of Incase alleged infringement
23 was Claim 21 of the ‘716 Patent. This claim is nearly indistinguishable from the
24 now invalid Claims 1 and 18 of the ‘716 Patent except that it is directed to updating
25 contact information as opposed to completing tasks generally.

26 47. Eclipse’s third representative example of Incase’s alleged infringement
27 was Claim 1 of the ‘9,899 Patent. This claim is similar to the now invalid Claim 1
28

1 of the '110 Patent except that the communication is with a singular personal
2 communication device instead of communicating with a plurality of personal
3 communication devices.

4 48. These three representative examples were provided both before and
5 again after Judge Wu had ruled nearly identical claims invalid.

6 49. Eclipse concludes the letter by offering a worldwide license to the
7 entire Eclipse Patent Portfolio in exchange for \$45,000 or threatening litigation.

8 50. Eclipse's letter, telephone call, and email, as well as pattern of
9 aggressive litigation show that there is a substantial controversy between the parties
10 having adverse legal interest, of sufficient immediacy and reality to warrant the
11 issuance of a declaratory judgment.

12 **FIRST CLAIM FOR RELIEF**

13 **(Declaratory Judgment of Non-Infringement of the**
14 **Patents-in-Suit / Eclipse Patent Portfolio)**

15 51. Incase incorporates by reference and realleges each of the allegations
16 set forth in the preceding paragraphs as though fully set forth herein.

17 52. Incase's online ordering system does not infringe the Patents-in-Suit,
18 directly or indirectly.

19 53. Incase's is not infringing, and has never infringed, any valid claim of
20 the Patents-in-Suit either directly or indirectly, literally or under the doctrine of
21 equivalents.

22 54. Incase is entitled to a judgment declaring that it has never infringed and
23 is not infringing any valid claim of the Patents-in-Suit.

24
25
26
27
28

1 **SECOND CLAIM FOR RELIEF**

2 **(Declaratory Judgment of Invalidity of the**
3 **Patents-in-Suit / Eclipse Patent Portfolio)**

4 55. Incase incorporates by reference and realleges each of the allegations
5 set forth in preceding paragraphs as though fully set forth herein.

6 56. All of the claims of the Patents-in-Suit are invalid under the United
7 States Patent Act, including pursuant to 35 U.S.C. §§ 101, 102, 103, and 112.

8 57. All of the claims of the Patents-in-Suit are invalid pursuant to 35
9 U.S.C. § 101 because they purport to claim unpatentable abstract concepts. For
10 example, the some of the claims of the '716 Patent are directed to the abstract idea
11 of assigning someone to perform a task and then waiting until they complete it.

12 58. All of the claims of the Patents-in-Suit are invalid pursuant to 35
13 U.S.C. §§ 102 and/or 103 because they are anticipated or rendered obvious by prior
14 art.

15 59. All of the claims of the Patents-in-Suit are invalid pursuant to 35
16 U.S.C. § 112 because they are indefinite, not enabled, or lack sufficient written
17 description.

18 60. Based on Eclipse's letter, telephone call, and email to Incase, its threat
19 of litigation for patent infringement of the entire Eclipse Patent Portfolio, Eclipse's
20 pattern of litigation, and Incase's denial of infringement, an actual case or
21 controversy exists as to whether Incase infringes any valid or enforceable claim of
22 the Patents-in-Suit, and Incase is entitled to a declaration that the claims of the
23 Patents-in-Suit are invalid.

24 **REQUEST FOR RELIEF**

25 Therefore, Incase requests for judgment:

26 1. That Incase has not infringed any claim of the patents in the Eclipse
27 Patent Portfolio;

1 2. That the claims of the patents comprising the Eclipse Patent Portfolio
2 are invalid;

3 3. That Incase be awarded its costs of suit, and pre- and post-judgment
4 interest on any money judgment;

5 4. That the Court declare this to be an exceptional case pursuant to 35
6 U.S.C. § 285, and award Incase its reasonable attorney’s fees;

7 5. For such other relief as the Court deems proper.
8

9 Dated: October 15, 2014

Respectfully submitted,

10 */s/ Brian E. Mitchell*
11 _____

Brian E. Mitchell

12 Brian E. Mitchell
13 Marcel F. De Armas
14 MITCHELL + COMPANY
15 4 Embarcadero Center, Suite 1400
16 San Francisco, CA 94111
17 Telephone: (415) 766-3515
18 Facsimile: (415) 402-0058
brian.mitchell@mc lawoffices.com
mdearmas@mc lawoffices.com

19 Attorneys for Plaintiff
20 INCASE DESIGNS, CORP

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

DEMAND FOR JURY TRIAL

Plaintiff demands a jury trial on all claims as to which it has a right to a jury.

Dated: October 15, 2014

Respectfully submitted,

/s/ Brian E. Mitchell
Brian E. Mitcehll

Brian E. Mitchell
Marcel F. De Armas
MITCHELL + COMPANY
4 Embarcadero Center, Suite 1400
San Francisco, CA 94111
Telephone: (415) 766-3515
Facsimile: (415) 402-0058
brian.mitchell@mcollawoffices.com
mdearmas@mcollawoffices.com

Attorney for Plaintiff
INCASE DESIGNS, COPR