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10 Attorneys for Plaintiff
11 NUTRITION EXPRESS CORPORATION

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

14 NUTRITION EXPRESS CORPORATION.

15 Plaintiff,

16 v.

17 ECLIPSE IP, LLC,

18 Defendant.

Case No.:

**COMPLAINT FOR DECLARATORY
JUDGMENT**

DEMAND FOR JURY TRIAL

1 Plaintiff Nutrition Express, Corporation (“Plaintiff” or “Nutrition Express”)
2 complains as follows:

3 **NATURE OF ACTION**

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

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

11 **THE PARTIES**

12 3. Nutrition Express is a California corporation and a leading nutrition
13 and supplement mail order company.

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. Eclipse is in the business of patent licensing through the threat of
18 litigation.

19 6. A key part of Eclipse’s business model is sending letters, emails, and
20 making telephone calls threatening patent litigation and following through on that
21 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 litigated the Patents-in-Suit in this judicial district 42 times.

3 10. Eclipse has been involved in 135 lawsuits involving the Eclipse Patent
4 Portfolio nationwide.

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

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

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

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

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

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

25 16. On January 20, 2009, U.S. Patent No. 7,479,899 (the ‘9,899 Patent),
26 entitled Notification Systems and Methods Enabling a Response to Cause
27 Connection Between a Notified PCD and a Delivery or Pickup Representative was
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1 issued. The ‘9,899 Patent resulted from a continuation application of the ‘716
2 Patent, which had claims invalidated for claiming unpatentable subject matter.

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

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

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

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

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

24 22. On May 26, 2009, U.S. Patent No. 7,538,691 (the ‘691 Patent), entitled
25 Mobile Thing Determination Systems and Methods Based upon User-Device
26 Location was issued. The ‘691 Patent claims priority to the ‘716 Patent, which had
27 claims invalidated for claiming unpatentable subject matter.

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

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

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

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

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

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

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

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

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

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

22 33. On April 29, 2014, U.S. Patent No. 8,711,010 (the '010 Patent),
23 entitled Notification Systems and Methods that Consider Traffic Flow Predicament
24 Data was issued. The '010 Patent claims priority to the '716 Patent, which had
25 claims invalidated for claiming unpatentable subject matter.

26 34. Collectively the twenty-two patents identified in paragraphs 12 to 33
27 are the Patents-in-Suit and the known Eclipse Patent Portfolio.
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1 35. All the Patents-in-Suit are related and claim priority to the ‘716 Patent.

2 **ECLIPSE’S THREATS AGAINST NUTRITION EXPRESS**

3 36. On or about January 2, 2015, Matt Olavi of the law firm Olavi Dunne
4 LLP, counsel for Eclipse, sent a letter to Don McFarland, Owner of Nutrition
5 Express, at Nutrition Express Torrance, California offices (the “Olavi letter”).

6 37. The Olavi letter asserts that Nutrition Express infringes the Eclipse
7 Patent Portfolio, warns that Eclipse “aggressively litigates patent infringement
8 lawsuits,” and gave February 6, 2015 as a cutoff date, after which, Eclipse
9 “assume[s] that [Nutrition Express is] not interested in resolving this matter without
10 litigation.” A true and correct copy of that letter is attached hereto as Exhibit 1.

11 38. In the Olavi letter, Eclipse alleges that the “electronic messaging
12 features of [Nutrition Express’s] online ordering system” infringes the claims of the
13 Eclipse Patents,” and provides three claims as representative examples of Nutrition
14 Express’s alleged infringement of the Eclipse Patent Portfolio.

15 39. On September 4, 2014, District Court Judge George H. Wu, presiding
16 over the case of *Eclipse IP LLC v. McKinley Equipment Corporation*, granted the
17 defendant’s Motion to Dismiss for Lack of Patentable Subject Matter, and
18 invalidated every claim he was asked to consider from the ‘681, ‘110, and ‘716
19 Patents. This included invalidating the asserted claims of one of the patents Eclipse
20 used as a representative example of Nutrition Express’s alleged infringement of the
21 Eclipse Patent Portfolio.

22 40. On or about February 4, 2015, Edward Turnbull, an individual
23 associated with Eclipse, place a telephone call to Mr. McFarland and left a
24 voicemail threatening litigation. He followed up with an email to Nutrition
25 Express’s customer care email, stating that Nutrition Express “will be moved into
26 line for litigation Monday,” February 9, 2015 (the “Turnbull email”).

1 41. The Turnbull email reaffirms Eclipse’s aggressive posture, and
2 concludes with the threat that litigation is imminent.

3 42. Eclipse’s first representative example of Nutrition Express alleged
4 infringement was Claim 1 of the ‘239 Patent. This claim is extremely similar to the
5 now invalid Claim 41 of the ‘416 Patent, except that it requires the party to have
6 authentication information.

7 43. Eclipse’s second representative example of Nutrition Express alleged
8 infringement was Claim 21 of the ‘716 Patent. This claim is nearly
9 indistinguishable from the now invalid Claims 1 and 18 of the ‘716 Patent except
10 that it is directed to updating contact information as opposed to completing tasks
11 generally.

12 44. Eclipse’s third representative example of Nutrition Express’s alleged
13 infringement was Claim 1 of the ‘9,899 Patent. This claim is similar to the now
14 invalid Claim 1 of the ‘110 Patent except that the communication is with a singular
15 personal communication device instead of communicating with a plurality of
16 personal communication devices.

17 45. These three representative examples were provided after Judge Wu had
18 ruled nearly identical claims invalid.

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

21 47. Eclipse’s letter, telephone call, and email, as well as pattern of
22 aggressive litigation show that there is a substantial controversy between the parties
23 having adverse legal interest, of sufficient immediacy and reality to warrant the
24 issuance of a declaratory judgment.

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FIRST CLAIM FOR RELIEF
(Declaratory Judgment of Non-Infringement of the Patents-in-Suit / Eclipse Patent Portfolio)

48. Nutrition Express incorporates by reference and realleges each of the allegations set forth in the preceding paragraphs as though fully set forth herein.

49. Nutrition Express’s online ordering system does not infringe the Patents-in-Suit, directly or indirectly.

50. Nutrition Express is not infringing, and has never infringed, any valid claim of the Patents-in-Suit either directly or indirectly, literally or under the doctrine of equivalents.

51. Nutrition Express is entitled to a judgment declaring that it has never infringed and is not infringing any valid claim of the Patents-in-Suit.

SECOND CLAIM FOR RELIEF
(Declaratory Judgment of Invalidity of the Patents-in-Suit / Eclipse Patent Portfolio)

52. Nutrition Express incorporates by reference and realleges each of the allegations set forth in preceding paragraphs as though fully set forth herein.

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

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

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

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DEMAND FOR JURY TRIAL

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

Dated: February 7, 2015

Respectfully submitted,

/s/ Brian E. Mitchell
Brian E. Mitcehl

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