

1 MITCHELL + COMPANY
2 Brian E. Mitchell (SBN 190095)
3 *brian.mitchell@mcollawoffices.com*
4 Marcel F. De Armas (SBN 289282)
5 *mdearmas@mcollawoffices.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 ACCO BRANDS CORPORATION

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

14 ACCO BRANDS CORPORATION ,
15 Plaintiff,
16 v.
17 ECLIPSE IP, LLC,
18 Defendant.

Case No.: 2:15-cv-1753

**COMPLAINT FOR DECLARATORY
JUDGMENT**

DEMAND FOR JURY TRIAL

1 Plaintiff ACCO Brands Corporation (“Plaintiff” or “ACCO”) complains as
2 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. ACCO is a Delaware corporation and a leader in, among other things,
13 branded office products. ACCO has created, developed, and/or acquired multiple
14 brands including, but not limited to, Day Runner.

15 4. On information and belief, Eclipse purports to be a Texas limited
16 liability company with a place of business at 711 SW 24th, Boyton Beach, Florida
17 33435. On information and belief, Eclipse is the owner of the Patents-in-Suit.

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

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

23 **JURISDICTION AND VENUE**

24 7. The Court has subject matter jurisdiction of this action under 28 U.S.C.
25 §§ 1331 and 1338(a) in that it arises under the United States Patent Laws.

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

4 9. Eclipse has filed at least 36 cases asserting patent infringement in this
5 District, and litigated the Patents-in-Suit in this judicial district at least 46 times.

6 10. Eclipse has been involved in at least 146 lawsuits involving the Eclipse
7 Patent Portfolio nationwide.

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

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

10 12. On October 10, 2006, U.S. Patent No. 7,119,716 (the ‘716 Patent),
11 entitled Response Systems and Methods for Notification Systems for Modifying
12 Future Notifications was issued. Claims 1, 2, 4, 6, 7, 18, 19, 20, 41, 43, 44, 45, and
13 46 of the ‘716 Patent were found to be invalid for failing to satisfy 35 U.S.C. § 101.

14 13. On June 20, 2006, U.S. Patent No. 7,064,681 (the ‘681 Patent), entitled
15 Response Systems and Methods for Notification Systems was issued. The ‘681
16 Patent resulted from a continuation application of the ‘716 Patent’s application.
17 Claims 1, 3, 4, and 6 of the ‘681 Patent were found to be invalid for failing to satisfy
18 35 U.S.C. § 101.

19 14. On September 26, 2006, U.S. Patent No. 7,113,110 (the ‘110 Patent),
20 entitled Stop List Generation Systems and Methods Based upon Tracked PCD’s and
21 Responses from Notified PCD’s was issued. The ‘110 Patent resulted from a
22 continuation application of the ‘716 Patent’s application. Claims 1, 2, 7, and 8 of the
23 ‘110 Patent were found to be invalid for failing to satisfy 35 U.S.C. § 101.

24 15. On January 15, 2008, U.S. Patent No. 7,319,414 (the ‘414 Patent),
25 entitled Secure Notification Messaging Systems and Methods Using Authentication
26 Indicia was issued. The ‘414 Patent resulted from a continuation application of the
27 ‘716 Patent, which had claims invalidated for claiming unpatentable subject matter.

28

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

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

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

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

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

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

27
28

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

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

10 24. On January 25, 2011, U.S. Patent No. 7,876,239 (the ‘239 Patent),
11 entitled Secure Notification Messaging Systems and Methods Using Authentication
12 Indicia was issued. The ‘239 Patent resulted from a continuation application of the
13 ‘414 Patent, which resulted from a continuation application of the ‘716 Patent,
14 which had claims invalidated for claiming unpatentable subject matter.

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

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

24 27. On August 14, 2012, U.S. Patent No. 8,242,935 (the ‘935 Patent),
25 entitled Notification System and Methods Where a Notified PCD Causes
26 Implementation of a Task(s) Based Upon Failure to Receive a Notification was
27
28

1 issued. The '935 Patent claims priority to the '716 Patent, which had claims
2 invalidated for claiming unpatentable subject matter.

3 28. On October 10, 2012, U.S. Patent No. 8,284,076 (the '076 Patent),
4 entitled Systems and Methods for a Notification System that Enable User Changes
5 to Quantity of Goods and/or Services for Deliver and/or Pickup was issued. The
6 '076 Patent claims priority to the '716 Patent, which had claims invalidated for
7 claiming unpatentable subject matter.

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

12 30. On February 5, 2013, U.S. Patent No. 8,368,562 (the '562 Patent),
13 entitled Systems and Methods for a Notification System that Enable User Changes
14 to Stop Location for Delivery and/or Pickup of Good and/or Service was issued. The
15 '562 Patent claims priority to the '716 Patent, which had claims invalidated for
16 claiming unpatentable subject matter.

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

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

27
28

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

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

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

8 **ECLIPSE’S THREATS AGAINST ACCO BRANDS CORPORATION**

9 36. On or about January 28, 2015, Matt Olavi of the law firm Olavi Dunne
10 LLP, counsel for Eclipse, sent a letter addressed to Mark Majeske, a former Director
11 of Day Runner, Inc. (the “Olavi letter”). Day Runner was formerly an operating
12 company that was acquired by Mead Westvaco Corporation in 2003. Day Runner is
13 now a brand that was acquired by ACCO through an acquisition of the Mead Office
14 Products Division of MeadWestVaco Corporation in 2012, which included the Day
15 Runner brand and Day Runner calendar products business. ACCO continues to
16 operate the Day Runner enterprise, including the Day Runner web site and e-
17 commerce platform, and does business under the Day Runner brand name.

18 37. The Olavi letter asserts that ACCO’s Day Runner web site and e-
19 commerce platform infringes the Eclipse Patent Portfolio, warns that Eclipse
20 “aggressively litigates patent infringement lawsuits,” and gave March 4, 2015 as a
21 cutoff date, after which, Eclipse “assume[s] that [ACCO is] not interested in
22 resolving this matter without litigation.” A true and correct copy of that letter is
23 attached hereto as Exhibit A.

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

28

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

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

10 41. Eclipse's first representative example of ACCO's alleged infringement
11 was Claim 1 of the '239 Patent. This claim is extremely similar to the now invalid
12 Claim 41 of the '416 Patent, except that it requires the party to have authentication
13 information.

14 42. Eclipse's second representative example of ACCO's alleged
15 infringement was Claim 21 of the '716 Patent. This claim is nearly
16 indistinguishable from the now invalid Claims 1 and 18 of the '716 Patent except
17 that it is directed to updating contact information as opposed to completing tasks
18 generally.

19 43. Eclipse's third representative example of ACCO's alleged infringement
20 was Claim 1 of the '9,899 Patent. This claim is nearly indistinguishable from the
21 now invalid Claim 1 of the '110 Patent except that the communication is with a
22 singular personal communication device instead of communicating with a plurality
23 of personal communication devices.

24 44. On or about February 3, 2015, Edward Turnbull, an individual
25 associated with Eclipse, sent an email to Teia Johnson, an ACCO employee,
26 enclosing another copy of the Olavi letter. He followed up with a telephone call
27 with Donald Walk, Chief IP counsel at ACCO.

28

1 45. On or about March 3, 2015, Mr. Turnbull sent an email to Mr. Walk,
2 enclosing a form license agreement and demanding \$30,000 for a “quick resolve.”
3 He followed up with another email on March 9, 2015, asking whether the offer has
4 been accepted.

5 46. Eclipse’s letter, emails, and telephone calls, as well as its pattern of
6 aggressive litigation, shows that there is a substantial controversy between the
7 parties having adverse legal interest, of sufficient immediacy and reality to warrant
8 the issuance of a declaratory judgment.

9 **FIRST CLAIM FOR RELIEF**

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

12 47. ACCO incorporates by reference and realleges each of the allegations
13 set forth in the preceding paragraphs as though fully set forth herein.

14 48. ACCO’s online ordering systems do not infringe the Patents-in-Suit,
15 directly or indirectly.

16 49. ACCO is not infringing, and has never infringed, any valid claim of the
17 Patents-in-Suit either directly or indirectly, literally or under the doctrine of
18 equivalents.

19 50. ACCO is entitled to a judgment declaring that it has never infringed
20 and is not infringing any valid claim of the Patents-in-Suit.

21 **SECOND CLAIM FOR RELIEF**

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

24 51. ACCO incorporates by reference and realleges each of the allegations
25 set forth in preceding paragraphs as though fully set forth herein.

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

28

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

Dated: March 10, 2015

Respectfully submitted,

/s/ Brian E. Mitchell
Brian E. Mitchell

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

Attorneys for Plaintiff
ACCO BRANDS CORPORATION

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: March 10, 2015

Respectfully submitted,

/s/ Brian E. Mitchell

Brian E. Mitchell

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@mcolawoffices.com
mdearmas@mcolawoffices.com

Attorneys for Plaintiff
ACCO BRANDS CORPORATION