

**IN THE UNITED STATES DISTRICT COURT
FOR THE WESTERN DISTRICT OF TEXAS**

ICONTROL NETWORKS, INC.,

Plaintiff,

v.

JOAO CONTROL & MONITORING

SYSTEMS, LLC,

Defendant.

Civil Action No. 1:15-cv-755-LY

FIRST AMENDED COMPLAINT FOR DECLARATORY JUDGMENT

Plaintiff Icontrol Networks, Inc. (“Icontrol”) files this First Amended Complaint for Declaratory Judgment against Defendant Joao Control & Monitoring Systems, LLC (“JCMS”). Icontrol seeks declaratory relief pursuant to 28 U.S.C. §§ 2201 and 2202, declaring United States Patent Nos. 6,542,076; 6,549,130; 6,587,046; 7,277,010 and 7,397,363 (collectively, the “patents-in-suit”) to be invalid and not infringed.

PARTIES

1. Plaintiff Icontrol is a Delaware corporation with its principal place of business located at 555 Twin Dolphin Drive, Suite 280, Redwood City, CA 94065.
2. On information and belief, JCMS is a limited liability company organized and existing under the laws of the state of Delaware. On information and belief, JCMS maintains its principal place of business at 122 Bellevue Place, Yonkers (Westchester County), New York 10703.

JURISDICTION AND VENUE

3. This Court has subject matter jurisdiction over Icontrol's request for a declaratory judgment under 28 U.S.C. §§ 2201 and 2202.

4. This action arises under the patent laws of the United States, 35 U.S.C. §§ 100 et seq., which are within the subject matter jurisdiction of this Court under 28 U.S.C. §§ 1331 and 1338(a).

5. JCMS is subject to general and specific personal jurisdiction in this judicial district based upon its purposeful, systematic, and continuous contacts with Texas, including filing suit for patent infringement in this District. On February 12, 2014, JCMS filed a case in this District against Protect America, Inc., in which it alleges infringement of the identical patents-in-suit. *See Joao Control & Monitoring Systems, LLC v. Protect America, Inc.*, (W.D. Tex., Case No. 1:14-cv-134-LY). Accordingly, JCMS is subject to personal jurisdiction in this forum. Moreover, this Court has previously construed claims of the patents-in-suit in its Markman order dated August 18, 2015. (Case No. 1:14-cv-134-LY, Dkt. 109).

6. Venue is proper in this Court under 28 U.S.C. § 1391(b)(2) because Icontrol has substantial operations within this District, and because in an action pending in Delaware styled *Joao Control & Monitoring Systems, LLC, v. Time Warner Cable Inc.*, Case No. 1:14-cv-524 (D. Del. Filed on April 23, 2014) ("TWC case"), JCMS has accused Icontrol's software platform as deployed by Time Warner Cable of infringing the patents-in-suit, and those accused home security products in the TWC case are made within this District.

7. Venue is also proper under 28 U.S.C. §1391(c) because JCMS is subject to personal jurisdiction within this judicial District by virtue of its lawsuit against Protect America, Inc.

FACTUAL BACKGROUND

8. JCMS purports to be the owner of US Patent No. 6,542,076 (the “’076 patent”). The ’076 patent, on its face, is entitled “Control, Monitoring and/or Security Apparatus and Method” and issued on April 1, 2003. A true and correct copy of the ’076 patent is attached hereto as Exhibit A.

9. JCMS purports to be the owner of US Patent No. 6,549,130 (the “’130 patent”). The ’130 patent, on its face, is entitled “Control Apparatus and Method for Vehicles and/or for Premises” and issued on April 15, 2003. A true and correct copy of the ’130 patent is attached hereto as Exhibit B.

10. JCMS purports to be the owner of US Patent No. 6,587,046 (the “’046 patent”). The ’046 patent, on its face, is entitled “Monitoring Apparatus and Method” and issued on July 1, 2003. A true and correct copy of the ’046 patent is attached hereto as Exhibit C.

11. JCMS purports to be the owner of US Patent No. 7,277,010 (the “’010 patent”). The ’010 patent, on its face, is entitled “Monitoring Apparatus and Method” and issued on October 2, 2007. A true and correct copy of the ’010 patent is attached hereto as Exhibit D.

12. JCMS purports to be the owner of US Patent No. 7,397,363 (the “’363 patent”). The ’363 patent, on its face, is entitled “Control and/or Monitoring Apparatus and Method” and issued on July 8, 2008. A true and correct copy of the ’363 patent is attached hereto as Exhibit E.

13. Icontrol develops software platforms which are deployed by leading home security companies, cable companies, and other service providers.

14. In the TWC case, JCMS has accused Icontrol’s software platform as deployed by Time Warner Cable of infringing the patents-in-suit. JCMS has specifically identified features of

Icontrol's software platform and included screenshots of Icontrol's products in its infringement contentions in the TWC case.

15. Through its infringement contentions served in the TWC case and in communications with counsel for Icontrol, JCMS has indicated its intent to bring an action against Icontrol directly for infringement of the patents-in-suit.

16. Approximately half of Icontrol's US operations are located in this District, specifically, in Austin, Texas. Further, the accused home security product in the TWC case, which is Icontrol's software platform as deployed by Time Warner Cable, is developed by Icontrol in Austin, Texas.

17. There exists an immediate and continuing justiciable controversy between Icontrol and JCMS as to the validity and infringement of the patents-in-suit, and Icontrol has a reasonable apprehension that JCMS will file an action alleging infringement of the patents-in-suit in this District.

18. JCMS's lawsuits and infringement allegations threaten actual and imminent injury to Icontrol, which can be redressed by judicial relief; further, that injury is of sufficient immediacy and reality to warrant the issuance of a declaratory judgment. Absent a declaration of noninfringement and/or invalidity of the patents-in-suit, JCMS's continued wrongful assertions of infringement related to the use of Icontrol's products will cause Icontrol harm.

FIRST CLAIM

(Declaratory Judgment of Non-Infringement of U.S. Patent No. 6,542,076)

19. Each allegation contained in the preceding paragraphs above is incorporated by reference as though fully set forth herein.

20. Icontrol has not, and is not now, infringing any claim of the '076 patent.

21. Icontrol has not, and is not now, inducing or contributing to infringement of any claim of the '076 patent.

22. There exists an actual and justiciable controversy between the parties as to whether Icontrol is infringing or has infringed any claim of the '076 patent.

23. Icontrol is entitled to a declaratory judgment in its favor that it has not infringed, contributorily infringed or induced infringement of any claim of the '076 patent.

SECOND CLAIM

(Declaratory Judgment of Invalidity of U.S. Patent No. 6,542,076)

24. Each allegation contained in the preceding paragraphs above is incorporated by reference as though fully set forth herein.

25. There exists an actual and justiciable controversy between the parties as to the validity of the '076 patent.

26. Icontrol is entitled to a declaratory judgment in its favor that the claims of the '076 patent are invalid for failure to meet one or more requirements of Title 35 of the United States Code, including but not limited to §§ 101, 102, 103, 112, 115, 116, and/or 256.

THIRD CLAIM

(Declaratory Judgment of Non-Infringement of U.S. Patent No. 6,549,130)

27. Each allegation contained in the preceding paragraphs above is incorporated by reference as though fully set forth herein.

28. Icontrol has not, and is not now, infringing any claim of the '130 patent.

29. Icontrol has not, and is not now, inducing or contributing to infringement of any claim of the '130 patent.

30. There exists an actual and justiciable controversy between the parties as to whether Icontrol is infringing or has infringed any claim of the '130 patent.

31. Icontrol is entitled to a declaratory judgment in its favor that it has not infringed, contributorily infringed or induced infringement of any claim of the '130 patent.

FOURTH CLAIM

(Declaratory Judgment of Invalidity of U.S. Patent No. 6,549,130)

32. Each allegation contained in the preceding paragraphs above is incorporated by reference as though fully set forth herein.

33. There exists an actual and justiciable controversy between the parties as to the validity of the '130 patent.

34. Icontrol is entitled to a declaratory judgment in its favor that the claims of the '130 patent are invalid for failure to meet one or more requirements of Title 35 of the United States Code, including but not limited to §§ 101, 102, 103, 112, 115, 116, and/or 256.

FIFTH CLAIM

(Declaratory Judgment of Non-Infringement of U.S. Patent No. 6,587,046)

35. Each allegation contained in the preceding paragraphs above is incorporated by reference as though fully set forth herein.

36. Icontrol has not, and is not now, infringing any claim of the '046 patent.

37. Icontrol has not, and is not now, inducing or contributing to infringement of any claim of the '046 patent.

38. There exists an actual and justiciable controversy between the parties as to whether Icontrol is infringing or has infringed any claim of the '046 patent.

39. Icontrol is entitled to a declaratory judgment in its favor that it has not infringed, contributorily infringed or induced infringement of any claim of the '046 patent.

SIXTH CLAIM

(Declaratory Judgment of Invalidity of U.S. Patent No. 6,587,046)

40. Each allegation contained in the preceding paragraphs above is incorporated by reference as though fully set forth herein.

41. There exists an actual and justiciable controversy between the parties as to the validity of the '046 patent.

42. Icontrol is entitled to a declaratory judgment in its favor that the claims of the '046 patent are invalid for failure to meet one or more requirements of Title 35 of the United States Code, including but not limited to §§ 101, 102, 103, 112, 115, 116, and/or 256.

SEVENTH CLAIM

(Declaratory Judgment of Non-Infringement of U.S. Patent No. 7,277,010)

43. Each allegation contained in the preceding paragraphs above is incorporated by reference as though fully set forth herein.

44. Icontrol has not, and is not now, infringing any claim of the '010 patent.

45. Icontrol has not, and is not now, inducing or contributing to infringement of any claim of the '010 patent.

46. There exists an actual and justiciable controversy between the parties as to whether Icontrol is infringing or has infringed any claim of the '010 patent.

47. Icontrol is entitled to a declaratory judgment in its favor that it has not infringed, contributorily infringed or induced infringement of any claim of the '010 patent.

EIGHTH CLAIM

(Declaratory Judgment of Invalidity of U.S. Patent No. 7,277,010)

48. Each allegation contained in the preceding paragraphs above is incorporated by reference as though fully set forth herein.

49. There exists an actual and justiciable controversy between the parties as to the validity of the '010 patent.

50. Icontrol is entitled to a declaratory judgment in its favor that the claims of the '010 patent are invalid for failure to meet one or more requirements of Title 35 of the United States Code, including but not limited to §§ 101, 102, 103, 112, 115, 116, and/or 256.

NINTH CLAIM

(Declaratory Judgment of Non-Infringement of U.S. Patent No. 7,297,363)

51. Each allegation contained in the preceding paragraphs above is incorporated by reference as though fully set forth herein.

52. Icontrol has not, and is not now, infringing any claim of the '363 patent.

53. Icontrol has not, and is not now, inducing or contributing to infringement of any claim of the '363 patent.

54. There exists an actual and justiciable controversy between the parties as to whether Icontrol is infringing or has infringed any claim of the '363 patent.

55. Icontrol is entitled to a declaratory judgment in its favor that it has not infringed, contributorily infringed or induced infringement of any claim of the '363 patent.

TENTH CLAIM

(Declaratory Judgment of Invalidity of U.S. Patent No. 7,297,363)

56. Each allegation contained in the preceding paragraphs above is incorporated by reference as though fully set forth herein.

57. There exists an actual and justiciable controversy between the parties as to the validity of the '363 patent.

58. Icontrol is entitled to a declaratory judgment in its favor that the claims of the '363 patent are invalid for failure to meet one or more requirements of Title 35 of the United States Code, including but not limited to §§ 101, 102, 103, 112, 115, 116, and/or 256.

PRAYERS FOR RELIEF

WHEREFORE, Icontrol requests that the Court:

A. Enter a declaratory judgment that Icontrol and the purchasers of Icontrol's products do not infringe and have not infringed, either individually or jointly, directly or indirectly, literally or under the doctrine of equivalents, contributed to the infringement of, or induced the infringement of any claim of the patents-in-suit.

B. Enter a declaratory judgment declaring the patents-in-suit are invalid, void, and unenforceable.

C. Declare this case to be exceptional under 35 U.S.C. § 285, and enter a judgment awarding Icontrol its costs and reasonable attorneys' fees and expert witness fees in this action.

D. Award Icontrol such further relief as the Court may deem just and proper.

JURY DEMAND

Icontrol demands a trial by jury on all issues so triable.

Dated: August 27, 2015

Respectfully submitted,

/s/ Steven G. Schortgen

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