

1 QUINN EMANUEL URQUHART & SULLIVAN, LLP
 Charles K. Verhoeven (Cal. Bar No. 170151)
 charlesverhoeven@quinnemanuel.com
 2 Michael D. Powell (Cal. Bar No. 202850)
 mikepowell@quinnemanuel.com
 3 Michelle A. Clark (Cal. Bar No. 243777)
 michelleclark@quinnemanuel.com
 4 50 California Street, 22nd Floor
 San Francisco, California 94111
 5 (415) 875-6600
 (415) 875-6700 (facsimile)
 6

7 Patrick T. Schmidt (Cal. Bar No. 274777)
 patrickschmidt@quinnemanuel.com
 8 865 S. Figueroa Street, 10th Floor
 Los Angeles, California 90017
 (213) 443-3000
 9 (213) 443-3100 (facsimile)

10 Attorneys for Plaintiff Google Inc.

11 UNITED STATES DISTRICT COURT
 12 CENTRAL DISTRICT OF CALIFORNIA
 13

14 GOOGLE INC.,
 15 Plaintiff,
 16
 17 v.
 18 SIMPLeAIR, INC.; JOHN PAYNE;
 and TIM VON KAENEL,
 19 Defendants.
 20

CASE NO. 2:16-cv-3758
FIRST AMENDED COMPLAINT
DEMAND FOR JURY TRIAL

1 Plaintiff Google Inc. (“Google”) seeks a declaration that Google does not
2 directly or indirectly infringe United States Patent Nos. 9,356,899 (the “’899
3 Patent”) and 9,380,106 (the “’106 Patent”), either literally or under the doctrine of
4 equivalents, and/or that the ’899 and ’106 Patents are unenforceable, as follows:

5 **NATURE OF THE ACTION**

6 1. This is an action for a declaratory judgment of non-infringement and
7 unenforceability arising under the patent laws of the United States, Title 35 of the
8 United States Code and the Declaratory Judgment Act. Google requests this relief
9 because defendant SimpleAir, Inc. (“SimpleAir”) has filed four lawsuits claiming
10 that Google infringes some or all of the claims of U.S. Patent Nos. 7,035,914 (the
11 “’914 Patent”), 6,021,433 (the “’433 Patent”), 8,601,154 (the “’154 Patent”),
12 8,572,279 (the “’279 Patent”), 8,656,048 (the “’048 Patent”), and 8,639,838 (the
13 “’838 Patent”) (collectively, the “Previously Asserted Patents”) by making and
14 using the Google Cloud Messaging, GCM for Chrome, and Android Cloud to
15 Device Messaging (C2DM) services (collectively referred to herein as “GCM
16 services”), as well as by providing applications (“apps”) that use the GCM services.
17 All of the Previously Asserted Patents are from a single patent family,¹ are
18 terminally-disclaimed to the ’433 Patent, share a common specification, and are in
19 fact one invention. SimpleAir has engaged in a pattern of filing successive litigation
20 against Google using the Previously Asserted Patents, despite the fact that both a
21 jury and the Federal Circuit have found that Google does not infringe SimpleAir’s
22 claimed invention.

23 2. SimpleAir, by and through its outside counsel, have made clear through
24 direct threats to Google’s counsel, as well as through SimpleAir’s history of serial

25
26 ¹ Specifically, the ’838 and ’048 Patents are continuations of the and ’433 and
27 ’914 Patents and are co-continuations of the previously-adjudicated ’279 and ’154
28 Patents.

1 litigation, that they intend to bring continuous, successive lawsuits against Google
2 until Google takes a license. Although Google has prevailed on its position that it
3 does not infringe the Previously Asserted Patents, Google now seeks a declaratory
4 judgment of non-infringement and unenforceability regarding the newest patents
5 issued to SimpleAir.

6 3. The '899 Patent issued on May 31, 2016 and is a continuation of the
7 Previously Asserted Patents. The '899 Patent shares the same specification and is
8 also terminally disclaimed to the patent term of the '433 Patent. A copy of the '899
9 Patent is attached hereto as **Exhibit A**.

10 4. The '106 Patent issued on June 28, 2016 and is a continuation of the
11 Previously Asserted Patents. The '106 Patent shares the same specification and is
12 also terminally disclaimed to the patent term of the '433 Patent. A copy of the '106
13 Patent is attached hereto as **Exhibit B**.

14 5. The '899 and '106 Patents are not infringed and are unenforceable
15 against Google. Google seeks declaratory judgment to that effect so that it may
16 remove from Google's GCM services the haze that SimpleAir's litigation
17 continuously seeks to impose.

18 **THE PARTIES**

19 6. Google is a corporation organized and existing under the laws of the
20 state of Delaware, with its principal place of business at 1600 Amphitheatre
21 Parkway, Mountain View, California, 94043. Google provides GCM services,
22 which allow application developers to send messages from their servers to devices.

23 7. On information and belief, SimpleAir is a corporation with its principal
24 place of business in Los Angeles County, California. Although SimpleAir has
25 alleged in the past that its principal place of business is an office in Plano, Texas,
26 Google is informed and believes that SimpleAir has no employees in Texas. On
27
28

1 information and belief, all of SimpleAir’s officers—John Payne, Mike Mirel, Tim
2 von Kaenel, and Seth Weisberg—reside in California, in or around Los Angeles.

3 8. On information and belief, John Payne is an individual residing in Los
4 Angeles County. Mr. Payne is a principal of SimpleAir, Inc. and a named inventor
5 of the ’899 and ’106 Patents. Mr. Payne has signed and submitted multiple
6 declarations, both individually and jointly with Mr. von Kaenel, to the PTO during
7 the prosecution of the ’899 and ’106 Patents as well as the Previously Asserted
8 Patents.

9 9. On information and belief, Tim von Kaenel is an individual residing in
10 Los Angeles County. Mr. von Kaenel is a principal of SimpleAir, Inc. and a named
11 inventor of the ’899 and ’106 Patents. Mr. von Kaenel has signed and submitted
12 multiple declarations, both individually and jointly with Mr. Payne, to the PTO
13 during the prosecution of the ’899 and ’106 Patents as well as the Previously
14 Asserted Patents.

15 **JURISDICTION AND VENUE**

16 10. This action arises under the Declaratory Judgment Act, 28 U.S.C. §
17 2201, and under the patent laws of the United States, 35 U.S.C. §§ 100-390.

18 11. This Court has subject matter jurisdiction over this action under 28
19 U.S.C. §§ 1331, 1338(a), and 2201(a).

20 12. This Court has personal jurisdiction over SimpleAir. Among other
21 things, SimpleAir has continuous and systematic business contacts with California.
22 All four of SimpleAir’s executives reside in California. SimpleAir’s principal and
23 only business is patent licensing and litigation, and that business is conducted by its
24 executives in or around Los Angeles, its patent prosecutors in Westlake Village, and
25 by its litigation counsel in Santa Monica. The “nerve center” or place where
26 SimpleAir’s officers direct, control, and coordinate SimpleAir’s activities is in the
27 Los Angeles area.

28

1 13. This Court also has personal jurisdiction over the individual
2 defendants, Messrs. Payne and von Kaenel, who are named inventors on the '433,
3 '914, '279, '154, '048, '838, '899, and '106 Patents (collectively the "SimpleAir
4 Patents") and are principals of SimpleAir, Inc. Messrs. Payne and von Kaenel
5 reside in or around Los Angeles County, California. Messrs. Payne and von Kaenel
6 have personally participated and controlled the prosecution of SimpleAir's patents
7 and its serial litigation against Google. As set forth herein, Messrs. Payne and von
8 Kaenel also submitted signed declarations with the PTO during prosecution of
9 SimpleAir's patents that included inaccurate and/or fraudulent representations. As
10 such, Messrs. Payne and von Kaenel individually and collectively are in actual
11 and/or *de facto* control of SimpleAir.

12 14. Venue is proper in this District under 28 U.S.C. §§ 1391(b), (c), and
13 1400(b) because all defendants reside in this District, a substantial part of the events
14 giving rise to Google's claims occurred in this District, and because the defendants
15 are subject to personal jurisdiction here. In addition, Google is aware of no other
16 jurisdiction in which it could have brought suit against all of the defendants.

17 **SIMPLEAIR'S HISTORY OF LITIGATION AGAINST GOOGLE**

18 15. SimpleAir first sued Google in 2011, in Case No. 2:11-cv-00416 filed
19 in the Eastern District of Texas ("*SimpleAir I*"). In *SimpleAir I*, SimpleAir alleged
20 that Google infringed the '914 and '433 Patents, accusing Google's GCM services.
21 SimpleAir dismissed its infringement allegations as to the '433 Patent before trial
22 with prejudice. With respect to the '914 Patent, SimpleAir maintained that the
23 asserted claims encompassed all messaging technologies and was not limited to
24 those wherein the recipient could receive messages whether it was "online or
25 offline" to the Internet. Based on this erroneous construction, SimpleAir prevailed
26 at its first trial. However, on appeal, the Federal Circuit reversed the finding, held
27 that the claim construction SimpleAir had advocated was wrong as a matter of law
28

1 and, thus ordered that the District Court in the Eastern District of Texas enter
2 judgment of non-infringement for Google as its GCM services did not practice
3 SimpleAir's invention. A copy of the Federal Circuit's opinion is attached as
4 **Exhibit C.**

5 16. In holding that the GCM services do not use SimpleAir's invention, the
6 Federal Circuit relied heavily on the disclosure in the specification and refused to
7 countenance SimpleAir's argument that language it added to its claims in 2004
8 (which the Federal Circuit noted was "eight years after the 1996 priority date," *id.* at
9 10) could serve to broaden the scope of its patent protection beyond the invention
10 clearly contemplated by the specification. The Federal Circuit stated:

11
12 The district court construed the larger phrase— "whether said
13 devices are online or offline from a data channel associated with
14 each device"—to mean "whether the remote computing devices are
15 or are not connected via *the Internet* or another online service *to a*
16 *data channel* associated with each computing device at the time the
17 preprocessed data is received by the receivers." J.A. 140 (emphases
18 added). The court explained that "constru[ing] the data channel to
merely be the device's connection to the Internet" would "render the
additional language [i.e., 'from a data channel associated with each
device'] redundant." J.A. 139.

19 **The district court's construction is incorrect.** It is true that
20 "interpretations that render some portion of the claim language
21 superfluous are disfavored." . . . The preference for giving meaning
22 to all terms, however, is not an inflexible rule that supersedes all
23 other principles of claim construction. . . . As we have explained,
24 claims must always be read in light of the specification. . . .
25 **Importantly, the person of ordinary skill in the art is deemed to**
26 **read the claim term not only in the context of the particular**
27 **claim in which the disputed term appears, but in the context of**
28 **the entire patent, including the specification." *Id.***

The patent explains that, at the time of invention (i.e., 1996),
computer users could connect to information sources such as the

1 Internet using a modem. '914 patent col. 3 ll. 30–31, col. 7 ll. 27–28.
 2 Modems were known to enable communication over telephone lines.
 3 *Id.* col. 10-ll. 55–56, col. 11 l. 9. . . . By transmitting information
 4 wirelessly via the central broadcast server, *id.* col. 6 ll. 40–41, “***the***
 5 ***present invention***” enables “**remote computer 14 [to] receive**
 6 **information instantly—even while it is off-line (i.e., not connected**
 7 **to the Internet or some other on-line service),” *id.* col. 7 ll. 4–7**
 8 (emphases added). “Thus, a user has the ability to receive ‘on-line’
 9 information even when the user is ‘offline.’” *Id.* col. 7 ll. 7–9.

10 ***

11 In light of this context, a [person having ordinary skill in the art] at
 12 the time of invention would understand that **a key aspect of the**
 13 **invention is the ability of a remote device to receive notifications**
 14 **even when it is not connected to the Internet** by traditional means.
 15 *See also id.* col. 2 ll. 51–54 (“[T]he present invention . . . provides a
 16 system and method for data communication connecting on-line
 17 networks with online and *off-line computers*.” (emphases added)).
 18 Therefore, the claim term “whether said devices are online or offline
 19 from a data channel associated with each device” is properly
 20 construed to mean “whether said devices are or are not connected to
 21 the Internet (or some other online service) via a data channel
 22 associated with each device.”

23 Ex. C at 15-17 (italics in original; bolding added by author).

24 17. In 2013, while *SimpleAir I* was pending, SimpleAir again sued Google
 25 in the Eastern District of Texas, asserting that Google’s GCM services infringed
 26 U.S. Patent No. 8,572,279 (the “’279 patent”), Civil Case No. 13-cv-00937. A few
 27 months later, SimpleAir filed a third lawsuit against Google, accusing the GCM
 28 services of infringing yet another related patent, the ’154 Patent, as well as the ’279
 Patent, Civil Case No. 14-cv-00011.² These lawsuits (collectively, “*SimpleAir*
II/III”) were consolidated for all purposes.

29 ² SimpleAir has not provided any explanation for bringing two successive
 30 lawsuits based on the ’279 Patent. Instead, in response to Google’s motion to
 31 dismiss the duplicative claims, SimpleAir simply filed an Amended Complaint and
 32 agreed to consolidate the actions.

1 18. On the eve of trial in *SimpleAir II/III*, SimpleAir dismissed its
2 infringement allegations as to the '154 Patent with prejudice after Google expended
3 time and resources defending against SimpleAir's infringement claims.

4 19. SimpleAir, however, proceeded to trial on the '279 Patent wherein the
5 jury returned a verdict of in Google's favor of no infringement. A copy of the jury
6 verdict sheet is attached as **Exhibit D**. A copy of the final judgment entered in the
7 *SimpleAir II/III* litigation is attached as **Exhibit E**.

8 20. Less than six months after the jury's verdict of non-infringement in
9 *SimpleAir II/III*, and just eight days after the Federal Circuit's ruling of non-
10 infringement as a matter of law in *SimpleAir I*, SimpleAir sued Google for a fourth
11 time, in Case No. 2:16-cv-388, filed in the Eastern District of Texas ("*SimpleAir*
12 *IV*"). In *SimpleAir IV*, which is currently pending, SimpleAir alleges that Google
13 infringes the '048 and '838 Patents, accusing Google's GCM services. The '048
14 and '838 Patents share a specification with, and are continuations in the same family
15 as, the '914 and '279 patents which Google has already been found not to infringe.³

16 21. An immediate, real, and justiciable controversy exists between Google
17 and SimpleAir as to whether Google infringes the '899 and '106 Patents, which
18 recently issued and which share a specification with, and are part of the same family
19 as, the Previously Asserted Patents. Like the Previously Asserted Patents, the '899
20 and '106 Patents are continuations of the '433 Patent and are subject to a terminal
21 disclaimer to preserve their patentability (over rejections for double-patenting).

22
23
24 ³ Google has filed a motion to dismiss the *SimpleAir IV* action on grounds of
25 claim preclusion and the *Kessler* doctrine in view of the two prior dismissals with
26 prejudice and the two prior judgments finding that Google's GCM service does not
27 practice SimpleAir's sole invention that has now been strategically spread among
28 hundreds of claims across numerous continuation patents. *SimpleAir, Inc. v.*
Google, Inc., 2:16-cv-00388-JRG, Dkt. 17 (E.D. Tex. May 17, 2016).

1 22. In communications relating to the prior litigations, counsel for
2 SimpleAir represented to counsel for Google that SimpleAir had additional patents
3 and expressly threatened to continue suing Google on the additional patents. Based
4 on these conversations and SimpleAir's previous practice of bringing additional
5 lawsuits against Google whenever new patents issue, Google fully expects
6 SimpleAir to assert the '899 and '106 Patents against it in future litigation.

7 **SIMPLEAIR OBTAINED THE '899 AND '106 PATENTS THROUGH**
8 **FRAUD ON THE PATENT OFFICE**

9 23. SimpleAir committed at least two (2) separate affirmative acts and/or
10 knowing omissions during prosecution of the '899 and '106 Patents, which together
11 or individually, constitute inequitable conduct. First, SimpleAir knowingly and
12 intentionally included five (5) named inventors on the '899 and '106 Patents, despite
13 being well aware that only one individual, Mr. John Payne, could plausibly be
14 considered an inventor of the claimed invention. In addition, despite having
15 disclosed substantial litigation material to the U.S. Patent and Trademark Office
16 ("PTO") in various IDS's when such material was helpful to SimpleAir's position, it
17 intentionally omitted the Federal Circuit opinion circumscribing the scope of
18 SimpleAir's invention to systems and methods that allow remote devices to receive
19 messages/notifications whether they are online or offline from the Internet.

20 **SimpleAir Failed To Identify The Real Inventor Of The '899 and '106**
21 **Patents⁴**

22 _____
23 ⁴ The allegations contained herein are based on public disclosures during the
24 pretrial conferences and trials in *SimpleAir I* and *SimpleAir II/III*. The deposition
25 transcripts of Mr. Payne were designated by SimpleAir pursuant to the protective
26 order entered in *SimpleAir II/III* and Google reserves the right to seek leave to cross-
27 use the testimony and other evidence from the prior litigations in this case.
28 However, no Confidential or Highly Confidential – Attorneys Eyes Only material
was used to prepare or is reflected in the allegations contained herein.

1 24. SimpleAir named the same inventors on the '899 and '106 Patents that
2 it had named on each of the previously-issued patents in this family: Messrs. Payne,
3 von Kaenel, Wang, Odell, Starr, and Katz. SimpleAir did so, however, despite its
4 awareness during the prosecution of the applications leading to the '899 and '106
5 Patents that none of the inventors but one contributed any of the claimed inventive
6 material and that the rest of the inventors were not properly named. Specifically,
7 SimpleAir failed to inform the PTO that none of the named inventors other than Mr.
8 Payne contributed to the conception of the claimed invention.

9 25. In April 2015, Mr. Payne testified that he alone conceived of each
10 element of the claims of the patents asserted in *SimpleAir II/III* (which relate to the
11 same invention as the '899 and '106 Patents), and that he did so before ever
12 discussing the subject matter of the invention with any of the other five named
13 inventors on the patents. *See* Dkt. 316 (10/1/2015 Tr. at 17:13-28:18, 34:1-42:13
14 (public versions)). Mr. Payne testified that only **after** conceiving of the claims did
15 he disclose the ideas to other individuals named on the patents. *Id.* Indeed, at least
16 two of the named inventors were not even employees of the original assignee of the
17 invention at the time of alleged conception and, thus, could not plausibly have
18 contributed to the conception of the invention as is required under the patent law in
19 order to be joined as an inventor. *Id.*

20 26. “[E]ach person claiming to be a joint inventor must have contributed to
21 the conception of the invention.” *Acromed Corp. v. Sofamor Danek Grp., Inc.*, 253
22 F.3d 1371, 1379 (Fed. Cir. 2001). Consequently, **all named inventors other than**
23 **Mr. Payne are misjoined** and the '899 and '106 Patents are invalid due to the
24
25
26
27
28

1 incorrect inventorship. 35 U.S.C. § 256 (2000); *Pannu v. Iolab Corp.*, 155 F.3d
2 1344, 1350 (Fed. Cir. 1998).⁵

3 27. SimpleAir has not presented any sworn testimony or other evidence to
4 refute or explain Mr. Payne’s prior sworn testimony that he alone conceived of the
5 entire invention reflected in the ’279 and ’154 Patents. And because the ’899 and
6 ’106 Patents are continuations of the ’279 and ’154 Patents, share the same
7 inventors, and are terminally disclaimed to those patents, the misjoinder of the five
8 additional named inventors carries over to the ’899 and ’106 Patents.

9 28. Although SimpleAir has been on notice of the inventorship error since
10 at least May 2015, SimpleAir continued to prosecute the applications that led to the
11 ’899 and ’106 Patents to issuance without any attempt to cure the improper
12 inventorship. Moreover, during the prosecution of the ’899 and ’106 Patents, both
13 defendant named inventors, as well as named inventor David Starr, submitted signed
14 declarations that they were inventors of at least one claim of the patent. *See*
15 **Exhibits F and G** (Oath and Declaration). These declarations were each false,
16 because no individual besides Mr. Payne could have invented any of the claims of
17

18 ⁵ In *SimpleAir II/III*, Google sought leave to file a summary judgment motion
19 on the issue of improper inventorship, but its request was denied. Subsequently,
20 SimpleAir sought to strike the portion of Google’s expert report addressing the
21 improper inventorship issues and sought *in limine* to preclude Google from asserting
22 the inventorship defense at trial to the jury. Although Google only learned the truth
23 about SimpleAir’s improper inventorship on April 22, 2015, and although Google
24 disclosed the basis for its inventorship defense during the fact discovery period
25 provided in the trial court’s scheduling order, the trial court granted SimpleAir’s
26 motions and precluded Google from pursuing the inventorship defense at trial on the
27 ground that Google had not timely disclosed the defense to SimpleAir. The trial
28 court, however, left open the option of allowing Google to assert its inventorship
theories as the basis for inequitable conduct after trial; as discussed above, this
option was unnecessary because the jury returned a verdict exonerating Google of
all of SimpleAir’s infringement claims.

1 the patents. Each of the declarants (and/or their agents), including Mr. Payne, knew
2 these were false statements.

3 29. SimpleAir had every incentive to hide the material misrepresentations
4 by the putative inventors. Had SimpleAir attempted to fix the inventorship
5 problems during prosecution, it would have highlighted the copious number of false
6 and fraudulent statements that SimpleAir has submitted to the PTO over the last
7 decade to maintain the patentability of its continuations. By way of example, but
8 not limitation, inventor John Payne and putative inventor Tim von Kaenel submitted
9 a “joint” declaration during reexamination of the ’914 Patent, to which the ’899 and
10 ’106 Patents claim priority. The joint declaration, in which the individual declarants
11 purported to corroborate each other’s testimony, was submitted for the purpose of
12 swearing behind a potentially invalidating prior art reference. It included details
13 regarding the Air Media Live product and business which SimpleAir relied on to
14 overcome the Examiner’s rejection based on the prior art and to establish that the
15 claimed subject matter should be entitled to the priority date of the related
16 provisional application. On information or belief, if the Examiner had been aware
17 that the declaration contained knowingly false statements (*e.g.*, mis-identifying Mr.
18 von Kaenel as a real inventor), he would not have afforded the declaration any
19 substantial weight in allowing the ’914 Patent to issue. This is just one example
20 where SimpleAir relied heavily on statements by an incorrectly named inventor to
21 salvage its claims. SimpleAir has submitted declarations from the incorrectly
22 named inventors in every single prosecution of its numerous continuations and each
23 of these submissions was both material and knowingly inaccurate.

24 30. As the Federal Circuit has instructed, submitting a false declaration
25 during a patent’s prosecution “is exactly the sort of ‘affirmative act[] of egregious
26 misconduct’ that renders the misconduct ‘material.’” *Intellect Wireless, Inc. v. HTC*
27 *Corp.*, 732 F.3d 1339, 1344 (Fed. Cir. 2013) (alteration in original) (quoting
28

1 *Therasense, Inc. v. Becton, Dickinson & Co.*, 649 F.3d 1276, 1292 (Fed. Cir. 2011)
2 (en banc)). In addition, the Federal Circuit has also found that—as a critical
3 requirement for obtaining a patent—inventorship is material. *PerSeptive Biosystems*
4 *Inc. v. Pharma Biotech Inc.*, 225 F.3d 1315, 1321-2 (Fed. Cir. 2000); see also *Oreck*
5 *Holdings, LLC v. Dyson, Inc.*, 434 F. Supp. 2d 385, 400 (E.D.Tex. 2006) (citing
6 *PerSeptive* and noting that “[i]nventorship is material for purposes of an inequitable
7 conduct analysis”). Had the PTO learned of the SimpleAir “inventors” multiple
8 false declarations during the prosecution of the ’914, ’433, ’279, ’154, ’048, ’838,
9 ’899, and ’106 Patents, it would have found those false statements to be material to
10 patentability and would have refused to issue the patents. Thus, each of these
11 patents is now rendered unenforceable as a result of the fraud that was perpetrated
12 on the PTO.

13 **SimpleAir Withheld Material Evidence Regarding The Appropriate**
14 **Scope of Its Invention And Patent Claims**

15 31. Not only did SimpleAir intentionally withhold information material to
16 the inventorship of the ’899 and ’106 Patents’ claims during prosecution, but it also
17 withheld material information regarding the appropriate claim scope.

18 32. For example, SimpleAir filed the application leading to the ’899 Patent
19 on July 23, 2014. On November 6, 2014, the Examiner rejected all claims of the
20 application for double patenting, in light of the ancestor patents, including the ’914
21 and ’279 patents discussed above. In response, on November 16, 2014, SimpleAir
22 filed a terminal disclaimer. Similarly, SimpleAir filed the application leading to the
23 ’106 Patent on February 6, 2014, and on May 13, 2014 the Examiner rejected all
24 claims for double patenting. In response, on October 9, 2014, SimpleAir filed a
25 terminal disclaimer. Throughout the prosecution of both the ’899 and ’106 Patents,
26 SimpleAir continued to submit prior art (including litigation material from all the
27 prior lawsuits and parallel PTO proceedings) to the PTO and make amendments to
28 its patent claims facially directed at undermining Google’s non-infringement and

1 invalidity positions from the ongoing district court litigation. In doing so,
2 SimpleAir attempted to modify the language of its pending claims so that it could
3 try to argue those new claims are distinct from the prior claims, which were found
4 by the Federal Circuit to be confined to the actual scope of SimpleAir’s original
5 invention (and not infringed by Google).

6 33. Despite its express attempt to broaden the scope of its claims through
7 amendments, SimpleAir failed to disclose the April 1, 2016 Federal Circuit opinion
8 in *SimpleAir I*. As discussed above, the Federal Circuit opinion expressly rejected
9 SimpleAir’s attempts to broaden the scope of its patents through creative drafting,
10 declined to give claim language SimpleAir added in 2004 (*i.e.*, eight years after the
11 1996 priority date) any meaning for the purpose of broadening SimpleAir’s patent
12 claims, and held that Google does not infringe and Google’s GCM services (which
13 only send messages over the Internet) do not meet the claim limitations as a matter
14 of law.

15 34. In its opinion, the Federal Circuit focused on the specification’s
16 disclosure of “the present invention” which “provides a system and method for
17 communication connection online networks with online **and off-line computers.**”
18 Ex. C (Slip Op. at 18) (emphasis in original). The Federal Circuit held that the
19 “patent’s description of the invention” must give meaning to the claims and thus,
20 foreclosed an interpretation of SimpleAir’s patent claims as reading on Google’s
21 GCM services, which “send[] messages over the same communication path as other
22 Internet data—it does not use a separate path”—and therefore a remote device that is
23 not connected to the Internet will not receive messages. *Id.* at 20. The Federal
24 Circuit further found that the written description of the patent was directed to the
25 “use of two distinct paths” for data and did not contemplate the system advocated by
26 SimpleAir in litigation, whereby data may transmitted over a single pathway (*i.e.*,
27 only over the Internet or an online service). *Id.* at 16, 20.

28

1 35. Though the Federal Circuit opinion provides clear, material guidance
2 regarding the appropriate scope of SimpleAir’s invention, SimpleAir failed to
3 disclose the opinion to the PTO. SimpleAir’s failure to disclose the binding
4 *SimpleAir I* opinion was done with knowledge of its materiality. Throughout the
5 prosecution of its many continuation patents, SimpleAir has regularly disclosed
6 litigation material, including hundreds of documents from *SimpleAir I*, *SimpleAir*
7 *II/III*, and the parties’ parallel adversarial actions before the PTO. The Examiner
8 has taken the parallel district court proceedings into consideration in several
9 instances, including staying prosecution of SimpleAir’s applications pending
10 resolution of the *SimpleAir II/III* litigation. When it has been useful to SimpleAir,
11 SimpleAir has taken the opportunity of the ongoing prosecution to submit hundreds
12 of references and other litigation documents to the PTO in an effort to reduce the
13 impact of such materials in subsequent potential litigation. But when the Federal
14 Circuit issued an opinion expressly holding that SimpleAir’s “**present invention**”
15 must enable “remote computer 14 [to] receive information instantly—**even when it is**
16 **offline (i.e., not connected to the Internet** or some other online service”),
17 SimpleAir did not disclose this highly material evidence regarding its patent claims.
18 *Id.* at 17 (emphasis in original).

19 36. Had SimpleAir disclosed the Federal Circuit opinion, the Examiner
20 would either have rejected many, if not all, of the claims of the ’899 and ’106
21 Patents as lacking written description support, not enabled, indefinite, and/or invalid
22 over the plethora of cited prior art that discloses two-pathway systems (which,
23 notably, were not substantively examined by the Examiner during prosecution).

24

25

26

27

28

SimpleAir Is Barred From Re-Litigating Its Cause Of Action Again

37. The '899 and '106 Patents are also unenforceable as against Google because, as set forth above, Google has been exonerated of infringing patents from the same patent family at least twice—in decisions on the merits, which concluded in final judgments in Google’s favor (against SimpleAir). SimpleAir is precluded from re-litigating its cause of action for infringement of the patented invention any further.

COUNT ONE

(Declaration of Non-Infringement of One Or More Claims of the '899 Patent)

38. Google restates and incorporates by reference the allegations in paragraphs 1 through 37 of this Complaint as if fully set forth herein.

39. On information and belief, SimpleAir claims to own all rights, title, and interest in the '899 Patent. A true and correct copy of the '899 Patent is attached hereto as **Exhibit A**.

40. The '899 Patent has four independent claims: claims 1, 11, 21, and 31.

41. Claim 1 of the '899 Patent recites:
A server system for causing data to be transmitted to selected remote computing devices comprising:

a first gateway configured to receive data from plural information providers, wherein each information provider comprises a provider of one or more related categories or subcategories of information;

one or more parsers comprising computer software programs, routines or functions configured to break or divide at least some of the data received from the information providers into components whose content or format can be analyzed, processed, or acted upon;

a second gateway configured to build data blocks from the data, and to assign addresses to the data blocks, wherein the data blocks include sufficient information to be effectively communicated to a third gateway configured to prepare the data blocks for transmission as messages to the selected remote computing devices to be viewed by viewers specific to the information providers in each of the selected remote computing devices.

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

- 42. Claim 11 of the '899 Patent recites:
 - A method for causing data to be transmitted to selected remote computing devices comprising:
 - a first gateway receiving data from plural information providers, wherein each information provider comprises a provider of one or more related categories or subcategories of information;
 - one or more parsers breaking or dividing at least some of the data received from the information providers into components whose content or format can be analyzed, processed, or acted upon;
 - a second gateway building data blocks from the data and assigning addresses to the data blocks, wherein the data blocks include sufficient information to be effectively communicated to a third gateway configured to prepare the data blocks for transmission as messages to the selected remote computing devices to be viewed by viewers specific to the information providers in each of the selected remote computing devices.

- 43. Claim 21 of the '899 Patent recites:
 - A method for transmitting data to selected remote devices, comprising the steps of:
 - a central broadcast server receiving data from plural information sources;
 - preprocessing the data at the central broadcast server, further comprising the step of:
 - parsing at least some of the data with parsers corresponding to the central broadcast server;
 - transmitting the data to an information gateway for building data blocks and assigning addresses to the data blocks, wherein the data blocks include sufficient information to be effectively communicated to a first gateway configured to prepare the data blocks for transmission as messages to the selected remote devices whether the selected remote devices are online or offline from a data channel to the information source from which the data was received.

- 44. Claim 31 of the '899 Patent recites:
 - A server system for causing data to be transmitted data to selected remote devices, comprising:
 - a central broadcast server configured to receive data from plural information sources;
 - one or more parsers at the central broadcast server comprising computer software programs, routines or functions configured to parse at least some of the data;

1 a first gateway configured to transmit the data to an information
2 gateway for building data blocks and assigning addresses to the
3 data blocks, wherein the data blocks include sufficient
4 information to be effectively communicated to a second gateway
5 configured to prepare the data blocks for transmission as
6 messages to the selected remote computing devices whether the
7 selected remote devices are online or offline from a data channel
8 to the information source from which the data was received.

9
10 45. Google does not directly or indirectly infringe the '899 Patent, either
11 literally or under the doctrine of equivalents, at least because its GCM services,
12 including the recently re-branded Firebase Cloud Messaging (collectively, the
13 "Declaratory Judgment GCM services"): (1) do not employ, incorporate, or
14 otherwise make use of "assign[ing] addresses" or "assign[ing] addresses to data
15 blocks," as required by every claim of the '899 Patent; (2) do not employ,
16 incorporate, or otherwise make use of "one or more parsers [] breaking or dividing
17 at least some of the data received from the information providers into components
18 whose content or format can be analyzed, processed, or acted upon" as required by
19 independent claims 1 and 11 of the '899 Patent; (3) do not employ, incorporate, or
20 otherwise make use of "viewers specific to the information providers" as required
21 by independent claims 1 and 11 of the '899 Patent; (4) do not employ, incorporate,
22 or otherwise make use of a transmission to "selected remote computing devices ...
23 whether the selected remote devices are online or offline from a data channel to the
24 information source from which the data was received," as required by independent
25 claims 21 and 31 of the '899 Patent.

26 46. A substantial, immediate, and real controversy exists between Google
27 and SimpleAir regarding whether Google infringes the '899 Patent by making,
28 using, selling, and/or offering for sale the Declaratory Judgment GCM services. A
judicial declaration is necessary to determine the parties' respective rights regarding
the '899 Patent.

47. Google seeks a judgment declaring that Google does not infringe, either
literally or under the doctrine of equivalents, one or more claims of the '899 Patent

1 by making, using, selling, and/or offering for sale the Declaratory Judgment GCM
2 services, either directly under 35 U.S.C. § 271(a), or indirectly under 35 U.S.C. §§
3 271(a) and (c).

4 **COUNT TWO**

5 **(Declaration of Unenforceability of the '899 Patent)**

6 **(Against All Defendants)**

7 48. Google restates and incorporates by reference the allegations in
8 paragraphs 1 through 47 of this Complaint as if fully set forth herein.

9 49. An immediate, real, and justiciable controversy exists between Google
10 and Defendants regarding the enforceability of the '899 Patent.

11 50. Google seeks a judgment declaring that the claims of the '899 Patent
12 are unenforceable under the doctrine of inequitable conduct. Though SimpleAir was
13 aware during its prosecution that it was including inventors who did not (and could
14 not have) jointly conceived of the claimed invention, it nonetheless included the
15 same inventors on the '899 Patent as in all Previously Asserted Patents and did not
16 make any effort to correct the inventorship issues or even apprise the Examiner that
17 an inventorship challenge had been raised. SimpleAir also withheld material
18 evidence during prosecution of the '899 Patent, including the Federal Circuit
19 opinion, which expressly held that SimpleAir's invention is circumscribed to a
20 "system and method for data communication connecting on-line networks with
21 online and *offline computers*." Ex. C at 18 (emphasis in original).

22 51. On information and belief, if the PTO had learned of the false
23 statements the named inventors submitted in support of the Previously Asserted
24 Patent applications and/or of the material evidence that SimpleAir withheld during
25 prosecution, the PTO would not have issued the '899 Patent. As a result, the
26 inventors obtained the patent by knowingly and willfully misrepresenting facts to
27 the PTO.
28

1 52. Google further seeks a judgment declaring that the claims of the '899
2 Patent are unenforceable against it due to SimpleAir's prior litigations against
3 Google and others including based on the doctrines of estoppel, waiver, res judicata,
4 *Kessler*, license and/or exhaustion.

5 **COUNT THREE**

6 **(Declaration of Non-Infringement of One Or More Claims of the '106 Patent)**

7 53. Google restates and incorporates by reference the allegations in
8 paragraphs 1 through 52 of this Complaint as if fully set forth herein.

9 54. On information and belief, SimpleAir claims to own all rights, title, and
10 interest in the '106 Patent. A true and correct copy of the '106 Patent is attached
11 hereto as **Exhibit B**.

12 55. The '106 Patent has four independent claims: claims 1, 9, 16, and 17.

13 56. Claim 1 of the '106 Patent recites:

14 1. A method for transmitting data from an information provider
15 to selected remote computing devices, wherein the information
16 provider provides one or more categories or subcategories of
17 information to remote computing devices for viewing on the
18 selected remote computing devices, the method comprising:

19 the information provider communicating with a central broadcast
20 server;

21 the information provider providing data to the central broadcast
22 server for the central broadcast server to parse by one or more
23 parsers, build data blocks, assign addresses, and transmit data to
24 be viewed by a viewer specific to the information provider in
25 each of the selected remote computing devices.

26 57. Claim 9 of the '106 Patent recites:

27 A method for transmitting data from an information provider
28 comprising:

 the information provider providing one or more related
categories or subcategories of information as to selected remote
computing devices for viewing on the selected remote computing
devices;

 the information provider communicating with a central broadcast
server;

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

the information provider providing data of the one or more categories or subcategories of information to the central broadcast server for the central broadcast server to parse by one or more parsers, build data blocks, assign addresses, and transmit data to a viewer specific to the information provider in each of the selected remote computing devices, whether the selected remote computing devices are online or offline to the information provider.

58. Claim 16 of the '106 Patent recites:

A server system for causing data to be transmitted to selected remote computing devices comprising:

a first gateway configured to receive data from plural information providers, wherein each information provider comprises a provider of one or more related categories or subcategories of information;

one or more parsers configured to break or divide data into components whose content or format can be analyzed, processed, or acted upon;

a second gateway configured to build data blocks from data, and to assign addresses to the data blocks, wherein the data blocks include sufficient information to be effectively communicated to a third gateway configured to prepare the data blocks for transmission as messages to the selected remote computing devices to be viewed by viewers respectively specific to the information providers in each of the selected remote computing devices.

59. Claim 17 of the '106 Patent recites:

A system for transmitting data to selected remote computing devices comprising: a server system including:

a first gateway configured to receive data from plural information providers, wherein the information providers comprise providers of data for the selected remote computing devices for one or more related categories or subcategories of information;

one or more parsers configured to break or divide data into components whose content or format can be analyzed, processed, or acted upon;

a second gateway configured to build data blocks from data, and to assign addresses to the data blocks;

a third gateway configured to prepare the data blocks for transmission as messages to the selected remote computing devices;

1 a transmission gateway for transmitting the messages to the
2 selected remote computing devices for instantaneously notifying
3 the selected remote computing devices of receipt of data whether
4 the selected remote computing devices are online or offline to the
5 information providers of the data,

6 wherein the messages corresponding to the data received by the
7 first gateway are transmitted to the selected remote computing
8 devices identified by the content of the received data.

9 60. Google does not directly or indirectly infringe the '106 Patent, either
10 literally or under the doctrine of equivalents, at least because the Declaratory
11 Judgment GCM services: (1) do not employ, incorporate, or otherwise make use of
12 "assign[ing] addresses" or "assign[ing] addresses to data blocks," as required by
13 every claim of the '106 Patent; (2) do not employ, incorporate, or otherwise make
14 use of a "central broadcast server to parse by one or more parsers" "data" as
15 required by claims 1 and 9 of the '196 Patent; (3) do not employ, incorporate, or
16 otherwise make use of "one or more parsers [] breaking or dividing at least some of
17 the data received from the information providers into components whose content or
18 format can be analyzed, processed, or acted upon" as required by independent
19 claims 16 and 17 of the '106 Patent; (4) do not employ, incorporate, or otherwise
20 make use of "viewer[s] specific to the information providers" as required by
21 independent claims 1, 9, and 16 of the '106 Patent; (5) do not employ, incorporate,
22 or otherwise make use of a transmission to "selected remote computing devices ...
23 whether the selected remote devices are online or offline from a data channel to the
24 information source from which the data was received," as required by independent
25 claims 9 and 17 of the '106 Patent.

26 61. A substantial, immediate, and real controversy exists between Google
27 and SimpleAir regarding whether Google infringes the '106 Patent by making,
28 using, selling, and/or offering for sale the Declaratory Judgment GCM services. A
judicial declaration is necessary to determine the parties' respective rights regarding
the '106 Patent.

1 62. Google seeks a judgment declaring that Google does not infringe, either
 2 literally or under the doctrine of equivalents, one or more claims of the '106 Patent
 3 by making, using, selling, and/or offering for sale the Declaratory Judgment GCM
 4 services, either directly under 35 U.S.C. § 271(a), or indirectly under 35 U.S.C. §§
 5 271(a) and (c).

COUNT FOUR

(Declaration of Unenforceability of the '106 Patent)

(Against All Defendants)

6
 7
 8
 9
 10 63. Google restates and incorporates by reference the allegations in
 11 paragraphs 1 through 62 of this Complaint as if fully set forth herein.

12 64. An immediate, real, and justiciable controversy exists between Google
 13 and Defendants regarding the enforceability of the '106 Patent.

14 65. Google seeks a judgment declaring that the claims of the '106 Patent
 15 are unenforceable under the doctrine of inequitable conduct. Though SimpleAir was
 16 aware during its prosecution that it was including inventors who did not (and could
 17 not have) jointly conceived of the claimed invention, it nonetheless included the
 18 same inventors on the '106 Patent as in all Previously Asserted Patents and did not
 19 make any effort to correct the inventorship issues or even apprise the Examiner that
 20 an inventorship challenge had been raised. SimpleAir also withheld material
 21 evidence during prosecution of the '106 Patent, including the Federal Circuit
 22 opinion, which expressly held that SimpleAir's invention is circumscribed to a
 23 "system and method for data communication connecting on-line networks with
 24 online and *offline computers*." Ex. C at 18 (emphasis in original).

25 66. On information and belief, if the PTO had learned of the false
 26 statements the named inventors submitted in support of the Previously Asserted
 27 Patent applications and/or of the material evidence that SimpleAir withheld during
 28 prosecution, the PTO would not have issued the '106 Patent. As a result, the

1 inventors obtained the patent by knowingly and willfully misrepresenting facts to
2 the PTO.

3 67. Google further seeks a judgment declaring that the claims of the '106
4 Patent are unenforceable against it due to SimpleAir's prior litigations against
5 Google and others including based on the doctrines of estoppel, waiver, res judicata,
6 *Kessler*, license and/or exhaustion.

7 **PRAYER FOR RELIEF**

8 WHEREFORE, Google prays for judgment and relief as follows:

9 A. Declaring that Google does not directly or indirectly infringe the '899
10 or '106 Patents, either literally or under the doctrine of equivalents, and that it is not
11 liable for damages or injunctive relief based on any claim of the '899 or '106
12 Patents;

13 B. Declaring that the '899 and '106 Patents are unenforceable against
14 Google;

15 C. Declaring that judgment be entered in favor of Google and against
16 SimpleAir and/or all defendants on each of Google's claims;

17 D. Finding that this an exceptional case under 35 U.S.C. § 285;

18 E. Awarding Google its costs and attorneys' fees in connection with this
19 action; and

20 F. Such further and additional relief as the Court deems just and proper.
21
22
23
24
25
26
27
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

JURY DEMAND

Google demands a jury trial on all issues and claims so triable.

DATED: June 30, 2016

Respectfully submitted,

QUINN EMANUEL URQUHART & SULLIVAN,
LLP

By  _____

Michael D. Powell
Attorneys for Google Inc.