

**IN THE UNITED STATES DISTRICT COURT
FOR THE EASTERN DISTRICT OF TEXAS
MARSHALL DIVISION**

CHARLES C. FREENY III, BRYAN E.
FREENY, and JAMES P. FREENY,

Plaintiffs,

v.

XEROX CORPORATION,

Defendant.

Case No. 2:17-cv-00188-JRG-RSP

JURY TRIAL DEMANDED

FIRST AMENDED COMPLAINT FOR PATENT INFRINGEMENT

Plaintiffs Charles C. Freeny III, Bryan E. Freeny, and James P. Freeny (collectively “Plaintiffs”), for their First Amended Complaint against Defendant Xerox Corporation, hereby allege as follows:

THE PARTIES

1. Plaintiff Charles C. Freeny III is an individual residing in Flower Mound, Texas.
2. Plaintiff Bryan E. Freeny is an individual residing in Ft. Worth, Texas.
3. Plaintiff James P. Freeny is an individual residing in Spring, Texas.
4. On information and belief, Defendant Xerox Corporation (“Xerox”) is a corporation duly organized and existing under the laws of the State of New York, having its principal place of business at 45 Glover Avenue, Norwalk, Connecticut 06856.
5. On information and belief, Xerox has offices and employees located within this judicial district. For example, Xerox has an office located at 1303 Ridgeview Drive, Lewisville, Texas 75057, which is located within this judicial district. On information and belief, Xerox has

a number of employees working in the Lewisville office, at least some of whom are involved in activities such as the sales and servicing of Xerox products in the Lewisville area.

JURISDICTION AND VENUE

6. This is an action for patent infringement arising under the Patent Act, 35 U.S.C. §§101 et seq. This Court has jurisdiction over Plaintiffs' federal law claims under 28 U.S.C. §§1331 and 1338(a).

7. This Court has specific and/or general personal jurisdiction over Xerox because it has committed acts giving rise to this action within this judicial district and/or has established minimum contacts within Texas and within this judicial district such that the exercise of jurisdiction over each would not offend traditional notions of fair play and substantial justice.

8. Venue is proper in this District pursuant to 28 U.S.C. § 1400(b) because Xerox has committed acts of patent infringement within this judicial district giving rise to this action, and Xerox has a regular and established place of business in this judicial district.

BACKGROUND OF THE INFRINGING PRODUCTS

9. Xerox manufactures and sells multifunction printers, including the Xerox WorkCentre 3655, 3655i, 5865, 5865i, 5875, 5875i, 5890, 5890i, 5945, 5945i, 5955, 5955i, 6655, 6655i, 7220, 7220i, 7225, 7225i, 7830, 7830i, 7835, 7835i, 7845, 7845i, 7855, 7855i, 7970, 7970i, and ColorQube 8700X, 8700XF, and 8900 printers ("the accused Xerox products"). The accused Xerox products provide a variety of document processing and reproduction functions, such as document copying, printing, scanning, and/or faxing functions. Xerox sells the accused Xerox products throughout the United States, including within this judicial district.

10. Xerox also manufactures and sells wireless adapter units that are designed to be combined with the accused Xerox products to enable the accused Xerox products to

communicate wirelessly with different types of wireless devices such as smartphones, tablets, and laptop computers, including for example the Xerox Wireless Print Solutions Adapter (“the accused Xerox wireless adapters”). Customers can purchase from Xerox any of the accused Xerox products bundled with one of these wireless adapter units, or they can purchase these items separately.

11. For example, in its product brochure for the Xerox Wireless Print Solutions Adapter, Xerox states:

Xerox® Wireless Print Solutions Adapter

Your modern workflow connector.

Add wireless connectivity to any Ethernet-compatible printer or multifunction printer (MFP) that needs it. The Xerox® Wireless Print Solutions Adapter seamlessly connects your Xerox® printer or MFP to modern mobile and desktop workflows, regardless of your office environment.

Easy to Install, Manage and Use

- Add wireless capability to any Ethernet-compatible print device. Just connect the Xerox® Wireless Print Solutions Adapter via the included Ethernet cable, plug in to a power source and follow the simple steps in the installation guide.
- True wireless bridging means no disrupting your current capabilities, such as network printing and scanning, LAN fax, fax forward to email, and web-based print-device management.
- Easily connect, configure and manage the Xerox® Wireless Print Solutions Adapter remotely from any Web browser.

Source: <http://www.office.xerox.com/latest/XWPBR-02U.pdf>

12. The accused Xerox products combined with an accused Xerox wireless adapter can transmit and receive data wirelessly using different types of wireless signals. For example, in its product brochure for the Xerox Wireless Print Solutions Adapter, Xerox states that the adapter can communicate wirelessly using IEEE 802.11b, g, n, and ac communication protocols, which are transmitted in the 2.4 GHz and 5.0 GHz frequency bands, as well as Near Field Communication (“NFC”) signals:

Device Specifications	Xerox® Wireless Print Solutions Adapter
Mobile Printing Features	Apple® AirPrint®, Google Cloud Print™ v2.0, Mopria®
Connectivity	Ethernet 10/100/1000, Wi-Fi Dual Band b/g/n/ac, NFC, Wi-Fi Direct®

Source: <http://www.office.xerox.com/latest/XWPBR-02U.pdf>

13. The accused Xerox products include functionality for controlling access to the printer such that only authorized users and/or devices can access functions on the printer. This security feature requires that the device communicating with the printer transmit certain identifying information such as device identification data, user name, and/or password in order to authenticate and authorize the device to access functions on the printer. For example, in its “System Administrator Guide” for the WorkCentre 3655, Xerox states:

Authorization

Authorization is the function of specifying the features that users are allowed to access, and the process of approving or disapproving access. You can configure the printer to allow users to access the printer, but restrict access to certain features, tools, and services. For example, you can allow users to access copying but restrict access to scanning. You can also control access to features at specific times of the day. For example, you can restrict a group of users from printing during peak business hours.

There are two types of authorization:

- **Local Authorization** verifies user information on the printer to approve access.
- **Network Authorization** verifies user information stored externally in a network database, such as an LDAP directory, to approve access.

Source: http://download.support.xerox.com/pub/docs/WC3655/userdocs/any-os/en_GB/wc3655_sys_admin_guide_en-us.pdf

14. The accused Xerox products can also transmit data over a Local Area Network (“LAN”) and/ or the Internet via a wired connection such as an Ethernet connection. For example, in its product brochure for the WorkCentre 3655, Xerox states:

Device Specifications	WorkCentre 3655/S	WorkCentre 3655/X
Speed	Up to 47 ppm letter / Up to 45 ppm A4	
Duty Cycle	Up to 150,000 pages / month ¹	
Hard Drive / Processor / Memory	Minimum 250 GB / 1 GHz Dual-core / 2 GB	
Connectivity	10/100/1000Base-T Ethernet, High-Speed USB 2.0, Optional Wi-Fi (with Xerox® Wireless Networking Adapter)	

Source: <http://www.office.xerox.com/latest/W3ZBR-02U.PDF>

15. The accused Xerox products can also connect to the Internet. For example, in its “System Administrator Guide” for the WorkCentre 3655, Xerox states that users of the printer can download online technical support information from the Internet onto the printer:

Xerox Online Support

Xerox Online Support allows you to access and print help, maintenance, and troubleshooting information by touching an icon on the control panel touch screen.

Before you begin:

If your network uses a proxy server, configure the Proxy Server settings of the printer to ensure that the printer can connect to the Internet.

Source: http://download.support.xerox.com/pub/docs/WC3655/userdocs/any-os/en_GB/wc3655_sys_admin_guide_en-us.pdf

16. The accused Xerox products can also send and receive data in the format of email messages. For example, in its “System Administrator Guide” for the WorkCentre 3655, Xerox provides the following description of the scan-to-email functionality of the printer:

Scanning to an Email Address

The email feature allows you to scan a document and send it to an email address as an attachment.

Before you begin:

- Configure SMTP settings. Note the IP Address or host name of your SMTP server. For details, see [Configure SMTP Server Settings](#) on page 64.
- Create an email account for the printer. The printer uses this address as the default text in the From: field of the email.

For instructions on using this feature, see the *User Guide* for your printer model.

Email

Configure email settings on the Email Setup page in Xerox® CentreWare® Internet Services. Email settings apply to other services that use SMTP.

Source: http://download.support.xerox.com/pub/docs/WC3655/userdocs/any-os/en_GB/wc3655_sys_admin_guide_en-us.pdf

17. The accused Xerox products can also connect with, manage, and share resources with other devices within a computer network. For example, as advertised in Xerox's product brochure for the WorkCentre 3655, the printer can store and retrieve data in other networked locations such as remote servers and cloud services:

Extend Your Possibilities

Whether scanning and managing documents on your office network or a hosted cloud on the Internet, you can access scan workflow solutions right from any WorkCentre 3655 thanks to the power of Xerox® Workflow Solutions, built on our Xerox Extensible Interface Platform®.

- Xerox® ConnectKey® for SharePoint® or Xerox® ConnectKey® for DocuShare®.**
 Scan files directly into Microsoft® SharePoint or Xerox® DocuShare® and other Windows® folders. Plus, you'll go beyond basic file storage and PDF creation by automatically converting documents to intelligent, structured data with easy file naming and routing tools.
- Xerox® ConnectKey Share to Cloud.** Our cloud-based scanning solution provides easy, secure, scalable scanning to popular cloud-based repositories such as Google Docs™, Salesforce.com, Office 365 and Dropbox™, using custom-designed workflows that leverage our Xerox Extensible Interface Platform® technology.

Learn more about Xerox® Workflow Solutions at www.office.xerox.com/software-solutions.

* Optional solutions may vary by geography.

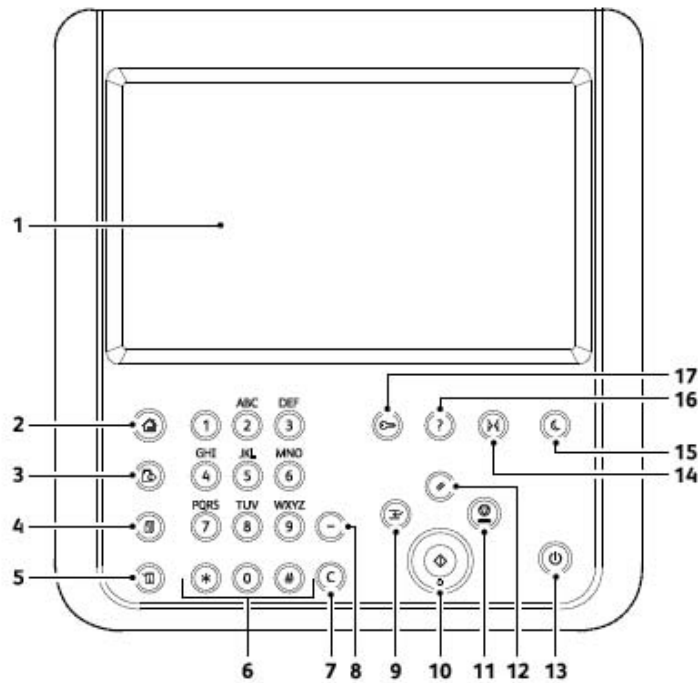
Source: <http://www.office.xerox.com/latest/W3ZBR-02U.PDF>

18. The accused Xerox products can be controlled from an LCD touchscreen on the printer. The touchscreen has a “Home” screen from which the user can select the different basic functions of the printer, such as faxing, copying, and scanning. For example, in its “User Guide” for the WorkCentre 3655, Xerox provides the following description of the control panel and touchscreen on the printer:

Control Panel

The control panel consists of a touch screen and buttons you press to control the functions available on the printer. The control panel:

- Displays the current operating status of the printer.
- Provides access to print features.
- Provides access to reference materials.
- Provides access to Tools and Setup menus.
- Provides access to Troubleshooting menus and videos.
- Prompts you to load paper, replace supplies, and clear jams.
- Displays errors and warnings.



Source: http://download.support.xerox.com/pub/docs/WC3655/userdocs/any-os/en_GB/wc3655_user_guide_en-us.pdf

19. Xerox's product brochure for the WorkCentre 3655 contains the following representative photo of the touchscreen in the WorkCentre 3655:



Source: <http://www.office.xerox.com/latest/W3ZBR-02U.PDF>

20. In the accused Xerox products, when a user selects a basic function through the touchscreen such as faxing, copying or scanning, the touchscreen then displays a submenu of functions for that basic function. Upon the user's selection of the particular task that the user wishes to be performed by printer within this submenu of functions, the printer will then perform that task using the appropriate combination of hardware and software components necessary to complete the task. For example, in its "User's Guide" for the WorkCentre 3655, Xerox shows that there are a number of submenu functions available for the basic function of sending faxes:

To send an embedded fax:

1. Load the original document in the document feeder or on the document glass.
2. Press the **Services Home** button, then touch **Fax**.
3. To enter recipient details, touch an option or touch **Skip**.
 - Touch **Enter Recipient**.
 - To enter the number, use the alphanumeric keypad. To add special dialing characters, at the point of insertion during number entry, touch the desired character.
 - Touch **Add**.
 - To add additional recipients, touch **Add Recipient**, then **Enter Recipient**. To enter the number, use the alphanumeric keypad, then touch **Add**.
 - **Note:** One or more dialing pauses can be required between the access number for an outside line and the fax number. When inserted, the dial pauses appear as commas in the fax number.
 - Touch **Device Address Book**.
 - Touch the down arrow, then from the menu select **Fax Contacts**, **Fax Groups**, **Fax Favorites**, or **All Contacts**.
 - Touch the desired contact, then select **Add to Recipients**.
 - To remove a contact from the list, touch the contact, then touch **Remove**.
 - Add additional contacts as needed, then touch **OK**.
 - Touch **Favorites**. Touch one or more favorites, then touch **OK**.
4. Touch **2-Sided Scanning**, select an option, then touch **OK**.
5. Touch **Original Type**, select an option, then touch **OK**.
6. Touch **Resolution**, select an option, then touch **OK**.
7. Touch **Original Size**, select an option, then touch **OK**.
8. Select more options as needed. For details, see [Selecting Fax Options](#) on page 160.
9. Press the green **Start** button. The printer scans the pages and transmits the document when all pages have been scanned.

Source: http://download.support.xerox.com/pub/docs/WC3655/userdocs/any-os/en_GB/wc3655_user_guide_en-us.pdf

21. The accused Xerox products include an “Address Book” functionality for storing, organizing, and retrieving contact information for potential recipients of data transmitted from the printer. For example, in its “User’s Guide” for the WorkCentre 3655, Xerox provides the following information regarding the Address Book functionality in the printer:

Using the Address Book

This section includes:

- [Adding an Individual Entry to the Device Address Book](#) 185
- [Editing an Individual Address Book Entry](#) 185
- [Editing or Deleting Favorites in the Device Address Book](#) 186

Adding an Individual Entry to the Device Address Book

The Device Address Book can contain up to 5000 contacts. If the Create New Contact button is unavailable, the address book has reached its capacity.

Before you can use this feature, the system administrator must enable users to view and manage the Device Address Book.

To add a recipient to the Device Address Book:

1. Press the **Services Home** button, then touch **Email, Fax, or Internet Fax**.
2. Touch **Device Address Book**.
3. Touch **Create New Contact**.
4. Touch each of the fields required, then to enter information, use the touch screen keyboard. Touch **OK**.
5. To add name and company information for the new entry, to the right of the contact field, touch the **I** button.
 - a. Enter a name into the First Name, Last Name, or Company field, then touch **OK**.

Note: The first entry into one of the fields becomes the display name for the contact information.
 - b. Enter names into the remaining fields, then touch **OK** after each entry.
 - c. At the Additional Contact Information page, touch **OK**.
6. To mark any entered contact information as a favorite, touch the star icon.
7. To save the contact to the Device Address Book, touch **OK**.

Source: http://download.support.xerox.com/pub/docs/WC3655/userdocs/any-os/en_GB/wc3655_user_guide_en-us.pdf

22. The accused Xerox products are designed to be compact, lightweight printers with a small physical footprint so that they take up minimal space within a room or office and can be easily moved to different locations. For example, Xerox advertises the WorkCentre 3655 dimensions and weight as follows:

Dimensions (W x D x H)

22 x 21.3 x 22.7 in. / 560 x 541 x 577 mm,

Weight: WorkCentre 3655/S: 56 lb. / 25.4 kg;

Source: <http://www.office.xerox.com/latest/W3ZBR-02U.PDF>

**COUNT I
(INFRINGEMENT OF U.S. PATENT NO. 6,490,443)**

23. Plaintiffs re-allege and incorporate by reference the allegations set forth in the Paragraphs above as if fully set forth herein.

24. On December 3, 2002, the United States Patent and Trademark Office duly and lawfully issued United States Patent Number 6,490,443 (“the ’443 patent”), entitled “Communication and Proximity Authorization Systems.” A true and correct copy of the ’443 patent is attached hereto as **Exhibit A**.

25. The ’443 patent describes, among other things, novel systems in which electronic devices can communicate wirelessly to provide and/or receive services from other electronic devices when they are within proximity of each other. These communications can occur over multiple communication signals and with the use of authorization codes.

26. The named inventor of the ’443 patent is Charles C. Freeny, Jr., who is now deceased.

27. Plaintiffs are the sons of Charles C. Freeny, Jr., and Plaintiffs are the owners and assignees of all right, title and interest in and to the ’443 patent, including the right to assert all causes of action arising under said patent and the right to any remedies for infringement of it.

28. Plaintiffs have complied with the requirements of 35 U.S.C. § 287 with respect to the ’443 patent.

29. On information and belief, Xerox has directly infringed and continues to directly infringe one or more claims of the '443 patent, including at least claim 1 of the '443 patent, in the State of Texas, in this judicial district, and elsewhere in the United States by, among other things, making, using, selling, offering for sale, and/or importing into the United States multifunction printers with wireless adapters that embody one or more of the inventions claimed in the '443 patent, including but not limited to the accused Xerox products, and all reasonably similar products, in violation of 35 U.S.C. § 271(a).

30. For example, claim 1 of the '443 patent recites “[a] proximity service unit for providing at least one predetermined service for use with multiple types of wireless devices,” with the unit including “a multiple channel wireless transceiver capable of receiving at least two signal types” and the unit providing a service in response to receiving a “request authorization code” from the wireless devices.

31. The accused Xerox products combined with an accused Xerox wireless adapter constitute proximity service units that provide at least one predetermined service for use with multiple types of wireless devices. For example, the accused Xerox products provide services such as document copying, printing, scanning, and/or faxing services. In addition, the accused Xerox products with an accused Xerox wireless adapter can be used with multiple types of wireless devices such as smartphones, tablets, and laptop computers.

32. The accused Xerox products combined with an accused Xerox wireless adapter also include a multiple channel wireless transceiver capable of receiving at least two signal types, and provide a service in response to receiving a “request authorization code” from the wireless devices. For example, the accused Xerox products combined with an accused Xerox wireless adapter can receive multiple wireless signal types such as IEEE 802.11 b, g, n, and ac

communications transmitted in the 2.4 GHz and 5.0 GHz frequency bands, as well as NFC signals. In addition, the accused Xerox products include a security feature that requires a wireless device seeking to activate services such as printing functionality on the printer to transmit a request authorization code (such as device identification data, user name, and/or password) in order to activate those services.

33. On information and belief, Xerox is inducing and/or has induced infringement of one or more claims of the '443 patent, including at least claim 1, as a result of, among other activities, instructing, encouraging, and directing its customers on the use of the accused Xerox products in an infringing manner in violation of 35 U.S.C. § 271(b). On information and belief, Xerox has had knowledge of the '443 patent since at least the date of service of the original Complaint in this action. Despite this knowledge of the '443 patent, Xerox has continued to engage in activities to encourage and assist its customers in the use of the accused Xerox products.

34. For example, through its website at www.office.xerox.com, Xerox advertises the accused Xerox products and provides instructions and technical support on the use the accused Xerox products. The product brochures and user manuals discussed in the preceding paragraphs, for example, are available through Xerox's website.

35. On information and belief, by using the accused Xerox products as encouraged and assisted by Xerox, Xerox's customers have directly infringed and continue to directly infringe one or more claims of the '443 patent, including at least claim 1. On information and belief, Xerox knew or was willfully blind to the fact that its activities in encouraging and assisting customers in the use of the accused Xerox products, including but not limited to the activities set forth above, would induce its customers' direct infringement of the '443 patent.

36. On information and belief, Xerox will continue to infringe the '443 patent unless enjoined by this Court.

37. Xerox's acts of infringement have damaged Plaintiffs in an amount to be proven at trial, but in no event less than a reasonable royalty. Xerox's infringement of Plaintiffs' rights under the '443 patent will continue to damage Plaintiffs, causing irreparable harm for which there is no adequate remedy at law, unless enjoined by this Court.

COUNT II
(INFRINGEMENT OF U.S. PATENT NO. 7,110,744)

38. Plaintiffs re-allege and incorporate by reference the allegations set forth in the Paragraphs above as if fully set forth herein.

39. On September 19, 2006, the United States Patent and Trademark Office duly and lawfully issued United States Patent Number 7,110,744 ("the '744 patent") entitled "Communication and Proximity Authorization Systems." A true and correct copy of the '744 patent is attached hereto as **Exhibit B**.

40. The '744 patent describes, among other things, novel systems in which a diverse set of devices can communicate with one another through wireless signals when the devices are within a certain proximity distance to each other. One device within this system can be a "front end unit" that serves as an access point through which multiple end-user devices can be connected simultaneously to a larger network through different types of wireless signals.

41. The named inventor of the '744 patent is Charles C. Freeny, Jr., who is now deceased.

42. Plaintiffs are the sons of Charles C. Freeny, Jr., and Plaintiffs are the owners and assignees of all right, title and interest in and to the '744 patent, including the right to assert all causes of action arising under said patent and the right to any remedies for infringement of it.

43. Plaintiffs have complied with the requirements of 35 U.S.C. § 287 with respect to the '744 patent.

44. On information and belief, Xerox has directly infringed and continues to directly infringe one or more claims of the '744 patent, including at least claim 18 of the '744 patent, in the State of Texas, in this judicial district, and elsewhere in the United States by, among other things, making, using, selling, offering for sale, and/or importing into the United States multifunction printers with wireless adapters that embody one or more of the inventions claimed in the '744 patent, including but not limited to the accused Xerox products, and all reasonably similar products, in violation of 35 U.S.C. § 271(a).

45. For example, claim 18 of the '744 patent recites “[a] communication unit connected to a public communication system, the communication unit capable of detecting a plurality of wireless devices and servicing each of the plurality of wireless devices by providing access to the public communication system when the wireless devices are within a predetermined proximity distance from the communication unit,” and where the communication unit includes a “multiple channel wireless transceiver simultaneously communicating with at least two wireless devices with different types of low power communication signals.”

46. The accused Xerox products combined with an accused Xerox wireless adapter constitute a communication unit connected to a public communication system, the communication unit capable of detecting a plurality of wireless devices and servicing each of the plurality of wireless devices by providing access to the public communication system when the wireless devices are within a predetermined proximity distance from the communication unit. For example, the accused Xerox products combined with an accused Xerox wireless adapter can detect a plurality of wireless devices such as smartphones, tablets, and laptop computers and

communicate with these devices wirelessly when they are within range of the adapter's transceiver as well as transmit data from these devices to the Internet.

47. In addition, the accused Xerox products combined with an accused Xerox wireless adapter include a multiple channel wireless transceiver that can simultaneously communicate with at least two wireless devices with different types of low power communication signals. For example, the accused Xerox products combined with an accused Xerox wireless adapter can communicate with wireless devices such as smartphones, tablets, and laptop computers using multiple wireless signal types such as IEEE 802.11 b, g, n, and ac communications transmitted in the 2.4 GHz and 5.0 GHz frequency bands, as well as NFC signals, all of which are low power communication signals.

48. On information and belief, Xerox is inducing and/or has induced infringement of one or more claims of the '744 patent, including at least claim 18, as a result of, among other activities, instructing, encouraging, and directing its customers on the use of the accused Xerox products in an infringing manner in violation of 35 U.S.C. § 271(b). On information and belief, Xerox has had knowledge of the '744 patent since at least the date of service of the original Complaint in this action. Despite this knowledge of the '744 patent, Xerox has continued to engage in activities to encourage and assist its customers in the use of the accused Xerox products.

49. For example, through its website at www.office.xerox.com, Xerox advertises the accused Xerox products and provides instructions and technical support on the use the accused Xerox products. The product brochures and user manuals discussed in the preceding paragraphs, for example, are available through Xerox's website.

50. On information and belief, by using the accused Xerox products as encouraged

and assisted by Xerox, Xerox's customers have directly infringed and continue to directly infringe one or more claims of the '744 patent, including at least claim 18. On information and belief, Xerox knew or was willfully blind to the fact that its activities in encouraging and assisting customers in the use of the accused Xerox products, including but not limited to the activities set forth above, would induce its customers' direct infringement of the '744 patent.

51. On information and belief, Xerox will continue to infringe the '744 patent unless enjoined by this Court.

52. Xerox's acts of infringement have damaged Plaintiffs in an amount to be proven at trial, but in no event less than a reasonable royalty. Xerox's infringement of Plaintiffs' rights under the '744 patent will continue to damage Plaintiffs, causing irreparable harm for which there is no adequate remedy at law, unless enjoined by this Court.

**COUNT III
(INFRINGEMENT OF U.S. PATENT NO. 6,806,977)**

53. Plaintiffs re-allege and incorporate by reference the allegations set forth in the Paragraphs above as if fully set forth herein.

54. On October 19, 2004, the United States Patent and Trademark Office duly and lawfully issued United States Patent Number 6,806,977 ("the '977 patent"), entitled "Multiple Integrated Machine System." A true and correct copy of the '977 patent is attached hereto as **Exhibit C**.

55. The '977 patent describes, among other things, novel systems in which a single device can perform the functions of multiple different digital machines, such as the functions of a PC, a phone, a fax machine, a printer, a scanner, a copier, a networking device, and/or a personal digital assistant. The device controls all of these functions through the use of a modular design in which different functions rely on different combinations of hardware and software, with the

device including a grouping control unit as well as subgroup function control units to manage the different functions as they are selected by the user.

56. The named inventor of the '977 patent is Charles C. Freeny, Jr., who is now deceased.

57. Plaintiffs are the sons of Charles C. Freeny, Jr., and Plaintiffs are the owners and assignees of all right, title and interest in and to the '977 patent, including the right to assert all causes of action arising under said patent and the right to any remedies for infringement of it.

58. Plaintiffs have complied with the requirements of 35 U.S.C. § 287 with respect to the '977 patent.

59. On information and belief, Xerox has directly infringed one or more claims of the '977 patent, including at least claim 1 of the '977 patent, in the State of Texas, in this judicial district, and elsewhere in the United States by, among other things, making, using, selling, offering for sale, and/or importing into the United States multifunction printers that embody one or more of the inventions claimed in the '977 patent, including but not limited to the accused Xerox products, and all reasonably similar products, in violation of 35 U.S.C. § 271(a).

60. For example, claim 1 of the '977 patent recites “[a] multiple integrated machine system capable of performing as at least two or more digital machines” Claim 1 also recites that the “first digital machine” is “a small office home office digital machine having at least two of the function modes selected from the group comprising a message center mode, a storage center mode, a document center mode, and an internet center mode,” with at least one of these modes including “an email function.” Claim 1 further recites that the claimed system also has “a digital machine element grouping control unit” for combining different digital machine elements

to form different digital machines as well as at least two “subgroup function control units” for selecting different functions within each digital machine.

61. The accused Xerox products constitute multiple integrated machine systems that are capable of performing as at least two or more digital machines, with one of those digital machines being a small office home office digital machine. For example, the accused Xerox products are capable of performing as a small office home office digital machine with at least a message center and document center mode by providing document copying, printing, scanning, and faxing capabilities. In addition, the accused Xerox products have at least one email function such as the ability to send scanned documents as email attachments.

62. The accused Xerox products are also capable of performing as a networking machine by, for example, allowing the printer to connect with, manage, and share resources with other devices within a computer network. The accused Xerox products are also capable of performing as a personal digital assistant machine by, for example, storing and organizing contact information for users.

63. The accused Xerox products also include “a digital machine element grouping control unit” for combining different digital machine elements to form different digital machines as well as at least two “subgroup function control units” for selecting different functions within each digital machine. For example, the accused Xerox products include software that allows the user to switch between using the device as a small office home office machine, a network digital machine, and a personal digital assistant machine by selecting the desired function through the printer’s LCD touchscreen. The software in the accused Xerox products also provides to the user different submenus of functions for each digital machine upon the user’s selection of that digital machine through the LCD touchscreen.

64. On information and belief, Xerox has had knowledge of the '977 patent and its contents since at least around January 5, 2006, when the '977 patent was cited by the United States Patent and Trademark Office in the prosecution of U.S. Patent No. 7,441,003 (“the '003 patent”). On information and belief, Fuji Xerox Co., Ltd., which is a joint venture between Xerox and Fujifilm Holdings Corporation, is or was the owner of the '003 patent and was involved in the prosecution of the '003 patent. On information and belief, Fuji Xerox Co., Ltd. has shared and continues to share information with Xerox regarding the prosecution of its United States patents, including the '003 patent.

65. The '003 patent is entitled “Payment Based Electronic Mail Printing System Utilizing Search Criteria.” The specification of the '003 patent states that “[t]he present invention relates to an information output system in which electronic mail is utilized, and particularly, it relates to a system for receiving electronic mail from a terminal apparatus and outputting (particularly, printing) information included in the electronic mail.”

66. In an Office Action dated January 5, 2006 in the prosecution of the '003 patent, the patent examiner identified the '977 patent as relevant prior art to the '003 patent. Fuji Xerox Co., Ltd. responded to the Office Action on or about March 7, 2006.

67. On information and belief, based on Xerox’s knowledge of the '977 patent acquired from the prosecution of the '003 patent, Xerox knew or should have known that there was an objectively high risk that the accused Xerox products infringe the '977 patent.

68. On information and belief, Xerox has induced infringement of one or more claims of the '977 patent, including at least claim 1, as a result of, among other activities, instructing, encouraging, and directing its customers on the use of the accused Xerox products in an infringing manner in violation of 35 U.S.C. § 271(b). Despite its knowledge of the '977 patent

since at least around January 5, 2006, Xerox continued to engage in activities to encourage and assist its customers in the use of the accused Xerox products.

69. For example, through its website at www.office.xerox.com, Xerox advertises the accused Xerox products and provides instructions and technical support on the use the accused Xerox products. The product brochures and user manuals discussed in the preceding paragraphs, for example, are available through Xerox's website.

70. On information and belief, by using the accused Xerox products as encouraged and assisted by Xerox, Xerox's customers have directly infringed one or more claims of the '977 patent, including at least claim 1. On information and belief, Xerox knew or was willfully blind to the fact that its activities in encouraging and assisting customers in the use of the accused Xerox products, including but not limited to the activities set forth above, would induce its customers' direct infringement of the '977 patent.

71. Xerox's acts of infringement have damaged Plaintiffs in an amount to be proven at trial, but in no event less than a reasonable royalty.

72. On information and belief, Xerox's infringement of the '977 patent has been willful, thereby entitling Plaintiffs to increased damages under 35 U.S.C. § 284 and to attorneys' fees and costs incurred in litigating this action under 35 U.S.C. § 285.

**COUNT IV
(INFRINGEMENT OF U.S. PATENT NO. 7,301,664)**

73. Plaintiffs re-allege and incorporate by reference the allegations set forth in the Paragraphs above as if fully set forth herein.

74. On November 27, 2007, the United States Patent and Trademark Office duly and lawfully issued United States Patent Number 7,301,664 ("the '664 patent"), entitled "Multiple

Integrated Machine System.” A true and correct copy of the ’664 patent is attached hereto as **Exhibit D**.

75. The ’664 patent describes, among other things, novel systems in which a single device can perform the functions of multiple different digital machines, such as the functions of a PC, a phone, a fax machine, a printer, a scanner, a copier, and/or a personal digital assistant. The device controls all of these functions through the use of a modular design in which different functions rely on different combinations of hardware and software, with the device including a grouping control unit as well as subgroup function control units to manage the different functions as they are selected by the user.

76. The named inventor of the ’664 patent is Charles C. Freeny, Jr., who is now deceased.

77. Plaintiffs are the sons of Charles C. Freeny, Jr., and Plaintiffs are the owners and assignees of all right, title and interest in and to the ’664 patent, including the right to assert all causes of action arising under said patent and the right to any remedies for infringement of it.

78. Plaintiffs have complied with the requirements of 35 U.S.C. § 287 with respect to the ’664 patent.

79. On information and belief, Xerox has directly infringed one or more claims of the ’664 patent, including at least claim 1 of the ’664 patent, in the State of Texas, in this judicial district, and elsewhere in the United States by, among other things, making, using, selling, offering for sale, and/or importing into the United States multifunction printers that embody one or more of the inventions claimed in the ’664 patent, including but not limited to the accused Xerox products, and all reasonably similar products, in violation of 35 U.S.C. § 271(a).

80. For example, claim 1 of the '664 patent recites “[a] mobile multiple integrated machine system capable of performing as at least a communication machine and a personal digital assistant machine” Claim 1 also recites that the claimed system also has “a digital machine element grouping control unit” for combining different digital machine elements to form different digital machines as well as at least two “subgroup function control units” for selecting different functions within the communication machine and personal digital assistant machine.

81. The accused Xerox products constitute mobile multiple integrated machine systems that are capable of performing as at least two or more digital machines, with one of those digital machines being a communication machine. The accused Xerox products are capable of performing as a communication machine by, for example, providing data transmission functions such as faxing documents and sending scanned documents via email.

82. The accused Xerox products are also capable of performing as a personal digital assistant machine by, for example, storing and organizing contact information for users.

83. The accused Xerox products also include “a digital machine element grouping control unit” for combining different digital machine elements to form different digital machines as well as at least two “subgroup function control units” for selecting different functions within the communication machine and personal digital assistant machine. For example, the accused Xerox products include software that allows the user to switch between using the device as a communication machine and a personal digital assistant machine by selecting the desired function through the printer’s LCD touchscreen. The software in the accused Xerox products also provides to the user different submenus of functions for the communication machine and the

personal digital assistant machine upon the user's selection of that digital machine through the LCD touchscreen.

84. On information and belief, Xerox is inducing and/or has induced infringement of one or more claims of the '664 patent, including at least claim 1, as a result of, among other activities, instructing, encouraging, and directing its customers on the use of the accused Xerox products in an infringing manner in violation of 35 U.S.C. § 271(b). On information and belief, Xerox has had knowledge of the '664 patent since at least the date of service of the original Complaint in this action. Despite this knowledge of the '664 patent, Xerox has continued to engage in activities to encourage and assist its customers in the use of the accused Xerox products.

85. For example, through its website at www.office.xerox.com, Xerox advertises the accused Xerox products and provides instructions and technical support on the use the accused Xerox products. The product brochures and user manuals discussed in the preceding paragraphs, for example, are available through Xerox's website.

86. On information and belief, by using the accused Xerox products as encouraged and assisted by Xerox, Xerox's customers have directly infringed and continue to directly infringe one or more claims of the '664 patent, including at least claim 1. On information and belief, Xerox knew or was willfully blind to the fact that its activities in encouraging and assisting customers in the use of the accused Xerox products, including but not limited to the activities set forth above, would induce its customers' direct infringement of the '664 patent.

87. On information and belief, Xerox will continue to infringe the '664 patent unless enjoined by this Court.

88. Xerox's acts of infringement have damaged Plaintiffs in an amount to be proven at trial, but in no event less than a reasonable royalty. Xerox's infringement of Plaintiffs' rights under the '664 patent will continue to damage Plaintiffs, causing irreparable harm for which there is no adequate remedy at law, unless enjoined by this Court.

PRAYER FOR RELIEF

Wherefore, Plaintiffs respectfully request that this Court enter judgment against Xerox as follows:

- a. For judgment that Xerox has infringed and continues to infringe the claims of the '443, '744, '977, and '664 patents;
- b. For judgment that Xerox's infringement of the '977 patent has been willful;
- c. For a permanent injunction against Xerox and its respective officers, directors, agents, servants, affiliates, employees, divisions, branches, subsidiaries, parents, and all others acting in active concert therewith from infringement of the '443, '744, '977, and '664 patents;
- d. For an accounting of all damages caused by Xerox's acts of infringement;
- e. For a judgment and order requiring Xerox to pay Plaintiffs' damages, costs, expenses, and pre- and post-judgment interest for its infringement of the '443, '744, '977, and '664 patents as provided under 35 U.S.C. § 284;
- f. For a judgment and order finding that this is an exceptional case within the meaning of 35 U.S.C. § 285 and awarding to Plaintiffs their reasonable attorneys' fees; and
- g. For such other relief at law and in equity as the Court may deem just and proper.

DEMAND FOR A JURY TRIAL

Plaintiffs demand a trial by jury of all issues triable by a jury.

Dated: June 9, 2017

Respectfully submitted,

/s/ Christopher D. Banys
Christopher D. Banys - *Lead Attorney*

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CERTIFICATE OF SERVICE

I hereby certify that a copy of the foregoing document was filed electronically in compliance with Local Rule CV-5(a) on June 9, 2017. Therefore, this document was served on all counsel who are deemed to have consented to electronic service.

/s/ Tiffany Dang
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