

**IN THE UNITED STATES DISTRICT COURT  
FOR THE DISTRICT OF DELAWARE**

**OPENPRINT LLC,**

Plaintiff,

v.

**BROTHER INTERNATIONAL  
CORPORATION,**

Defendant.

**CIVIL ACTION NO: \_\_:18-CV-\_\_**

**JURY TRIAL DEMANDED**

**ORIGINAL COMPLAINT**

This is an action for patent infringement in which OpenPrint LLC (“OpenPrint”) makes the following allegations against Brother International Corporation (“Defendant”):

**PARTIES**

1. OpenPrint LLC is a Texas limited liability company with a principle place of business located at 5068 W. Plano Parkway, Suite 300, Plano, TX 75093.
2. Upon information and belief, Brother International Corporation is a Delaware corporation, with its principal place of business at 200 Crossing Blvd., Bridgewater, NJ 08807.

**JURISDICTION AND VENUE**

3. This is an action for infringement of a United States patent arising under 35 U.S.C. §§ 271(a), 271(b), 281, and 284 - 85. This Court has subject matter jurisdiction over this action under 28 U.S.C. §1331 and §1338(a).
4. Venue is proper in this Court pursuant to 28 U.S.C. § 1400(b). Defendant is a corporation organized under the laws of the State of Delaware.
5. Defendant is subject to this Court’s specific and general personal jurisdiction pursuant to due process and/or the Delaware Long Arm Statute, due at least to Defendant’s substantial business in this forum, including: (i) at least a portion of the infringements alleged

herein; and (ii) regularly doing or soliciting business, engaging in other persistent courses of conduct, and/or deriving substantial revenue from goods and services provided to individuals in Delaware and in this district.

**THE OPENPRINT PATENTS**

1. On February 8, 2000, United States Patent No. 6,023,345 (the “’345 Patent”) was duly and legally issued by the United States Patent and Trademark Office for an invention titled “Facsimile to E-Mail Communication System with Local Interface.” A true and correct copy of the ’345 Patent is attached hereto as Exhibit A.

2. On November 4, 2008, United States Patent No. 7,446,906 (the “’906 Patent”) was duly and legally issued by the United States Patent and Trademark Office for an invention titled “Facsimile to E-Mail Communication System with Local Interface.” A true and correct copy of the ’906 Patent is attached hereto as Exhibit B.

3. On October 1, 2013, United States Patent No. 8,547,601 (the “’601 Patent”) was duly and legally issued by the United States Patent and Trademark Office for an invention titled “Facsimile to E-Mail Communication System.” A true and correct copy of the ’601 Patent is attached hereto as Exhibit C.

4. On January 27, 2015, United States Patent No. 8,941,888 (the “’888 Patent”) duly and legally issued by the United States Patent and Trademark Office for an invention titled “Facsimile to E-Mail Communication System with Local Interface.” A true and correct copy of the ’888 Patent is attached hereto as Exhibit D.

5. Upon information and belief, to the extent any marking was required by 35 U.S.C. § 287 with regards to the Asserted Patents, OpenPrint has complied with such requirements.

**COUNT I**  
**INFRINGEMENT OF U.S. PATENT NO. 6,023,345**

6. Defendant directly or through its intermediaries has been and is now infringing claim 13, of the '345 patent in the State of New Jersey, in this Judicial District, and elsewhere in the United States, by, among other things, directly or through intermediaries, making, using, importing, providing, selling and/or offering for sale products and/or systems (Fax-to-Email Devices, identified in the attached Exhibit 1 (the "Accused Instrumentalities")), covered by one or more claims of the '345 Patent to the injury of OpenPrint. Defendant is directly infringing, literally infringing, and/or infringing the '345 Patent under the doctrine of equivalents. Defendant is thus liable for infringement of the '345 Patent pursuant to 35 U.S.C. § 271(a).

7. Defendant directly or through its intermediaries, makes, uses, imports, sells, and/or offers for sale products and/or systems, *i.e.*, the Accused Instrumentalities, that infringe claim 13 of the '345 Patent. The Accused Instrumentalities are a communication system for communicating, with the assistance of a public communication network ("PN") (*e.g.*, a standard fax terminal connected to the telephone network) and a global computer communications network (*e.g.*, the internet), information found originally as an image on paper (*e.g.*, a fax), said system comprising: a server in communication with the PN and in communication with the computer network; a facsimile device for generating facsimile information from information found originally as an image on paper, said facsimile device communicating with PN (*e.g.*, it sends faxes over the phone lines); an interface device responsive to signals received at said interface device to facilitate communications between said facsimile device and said server and to facilitate delivery of facsimile information from said facsimile device to an e-mail address associated with the computer network (*e.g.*, when a user selects "Internet Fax" and adds a New Recipient or Selects a recipient

from the address book, the device sends the facsimile information to the selected e-mail address.)  
*See Ex. A-1, Figs. 1-10.*

8. As a result of Defendant's infringement of the '345 Patent, OpenPrint has suffered monetary damages and is entitled to a money judgment in an amount adequate to compensate for Defendant's infringement, but in no event less than a reasonable royalty for the use made of the invention by Defendant, together with interest and costs as fixed by the court.

**COUNT II**  
**INFRINGEMENT OF U.S. PATENT NO. 7,446,906**

9. Defendant directly or through its intermediaries has been and is now infringing claims 1, 2, 3, and 4 of the '906 patent in the State of New Jersey, in this Judicial District, and elsewhere in the United States, by, among other things, directly or through intermediaries, making, using, importing, providing, selling and/or offering for sale products and/or systems (*i.e.*, the Accused Instrumentalities), covered by one or more claims of the '906 Patent to the injury of OpenPrint. Defendant is directly infringing, literally infringing, and/or infringing the '906 Patent under the doctrine of equivalents. Defendant is thus liable for infringement of the '906 Patent pursuant to 35 U.S.C. § 271(a).

10. Defendant, its resellers, and end-user customers infringe claim 1 of the '906 Patent when they place the Accused Instrumentalities into operation. The Accused Instrumentalities perform a method of communicating information by a facsimile/e-mail server system, the method comprising the steps of: a) receiving an electronic mail address from an interface device (*i.e.*, the user enters a destination email address); b) receiving facsimile information from a scanning portion of a facsimile machine (*i.e.*, it receives a digital image from the scanner portion"); c) converting the received facsimile information into a computer readable image file (*i.e.*, the digital image is converted into a PDF, TIFF, JPEG file); d) composing an e-mail message with the computer

readable image file as an attachment (*i.e.*, an email message is created with a PDF, TIFF, JPEG file as an attachment); e) transmitting the composed e-mail message to an electronic mail server associated with the received electronic mail address (*i.e.*, the email message is transmitted to the mail server associated with the entered email address); f) receiving a report request from a user; g) generating a report based upon the received report request; and h) outputting the generated report (*i.e.*, the user can request a fax report which is generated). *See* Ex. B-1, Figs. 1-14.

11. Defendant, its resellers, and end-user customers infringe claim 2 of the '906 Patent when they place the Accused Instrumentalities into operation. The user introduces a hardcopy document into the scanning portion of the facsimile machine (*i.e.*, by placing the document on the scanner or into the auto-document feeder). *See Id.*

12. Defendant, its resellers, and end-user customers infringe claim 3 of the '906 Patent when they place the Accused Instrumentalities into operation. The user enters an email address via the touchscreen or keypad. *See Id.*

13. Defendant, its resellers, and end-user customers infringe claim 4 of the '906 Patent when they place the Accused Instrumentalities into operation. The user enters an email address via the touchscreen or keypad. *See Id.*

14. As a result of Defendant's infringement of the '906 Patent, OpenPrint has suffered monetary damages and is entitled to a money judgment in an amount adequate to compensate for Defendant's infringement, but in no event less than a reasonable royalty for the use made of the invention by Defendant, together with interest and costs as fixed by the court.

**COUNT III**  
**INFRINGEMENT OF U.S. PATENT NO. 8,547,601**

15. Defendant directly or through its intermediaries has been and is now infringing claim 1, 6, 8, and 9 of the '601 patent in the State of New Jersey, in this Judicial District, and

elsewhere in the United States, by, among other things, directly or through intermediaries, making, using, importing, providing, selling and/or offering for sale products and/or systems (*i.e.*, the Accused Instrumentalities), covered by one or more claims of the '601 Patent to the injury of OpenPrint. Defendant is directly infringing, literally infringing, and/or infringing the '601 Patent under the doctrine of equivalents. Defendant is thus liable for infringement of the '601 Patent pursuant to 35 U.S.C. § 271(a).

16. The Accused Instrumentalities infringe claim 1 of the '601 Patent. They are an Internet based server system, comprising: a facsimile-to-e-mail server (*e.g.*, gateway) in communication with at least one communication network (*e.g.*, the internet), wherein the facsimile-to-e-mail server is configured to receive facsimile information from a facsimile device in communication with the server (*e.g.*, the gateway receives facsimile information from the fax device); receive a destination e-mail address for the facsimile information from the facsimile device (*e.g.*, a user enters the recipient email address at the control panel and this information is transmitted to the server), wherein the destination e-mail address is received in and interpreted from an alphanumeric form (*e.g.*, entered with the touchscreen keypad); convert the received facsimile information into a computer readable image file (*e.g.*, PDF or TIFF); attach the computer readable image file to an e-mail message to be sent to the destination e-mail address (*e.g.*, the file is attached to an e-mail); and send the facsimile information to the destination e-mail address via the communication network (*e.g.*, the file containing the facsimile information is sent to the destination e-mail address). *See* Ex. C-1, Figs. 1-10.

17. The Accused Instrumentalities infringe claim 6 of the '601 Patent. They include a non-transitory computer-readable storage medium having instructions stored thereon which cause the device to perform operations, including: receiving facsimile information from a fact device ;

receiving in alphanumeric form from the facsimile device a destination email address which the facsimile information is to be sent (*e.g.*, the user enters an email address via an keypad or touchscreen keyboard); interpreting the destination e-mail address from the alphanumeric form; converting the received facsimile information into a computer readable file (*e.g.*, a TIFF file); comprising an e-mail message with the computer readable file as an attachment to be sent to the destination e-mail address (*e.g.*, it composes an email with the TIFF file attached); and transmitting the e-mail message to an e-mail server associated with the received destination e-mail address (*e.g.*, the e-mail message is transmitted to the appropriate domain, such as @hotmail.com). *See Id.*

18. The Accused Instrumentalities infringe claim 8 of the '601 Patent. They meet the limitations of claim 6 and further, receive a destination email address from a user interface including an alphanumeric keypad. *See Id.*

19. The Accused Instrumentalities infringe claim 9 of the '601 Patent. They meet the limitations of claim 6 and furthermore, convert the facsimile information into a TIFF format image file. *See Id.*

20. As a result of Defendant's infringement of the '601 Patent, OpenPrint has suffered monetary damages and is entitled to a money judgment in an amount adequate to compensate for Defendant's infringement, but in no event less than a reasonable royalty for the use made of the invention by Defendant, together with interest and costs as fixed by the court.

**COUNT IV**  
**INFRINGEMENT OF U.S. PATENT NO. 8,941,888**

21. Defendant has been and is now infringing claims 1, 2, 3, 4, 5, 7, 8, and 9 of the '888 Patent in the State of New Jersey, in this Judicial District, and elsewhere in the United States, by, among other things, directly or through intermediaries, making, using, importing, providing,

selling and/or offering for sale products and/or systems (*i.e.*, the Accused Instrumentalities), covered by one or more claims of the '888 Patent to the injury of OpenPrint. Defendant is directly infringing, literally infringing, and/or infringing the '888 Patent under the doctrine of equivalents. Defendant is thus liable for infringement of the '888 Patent pursuant to 35 U.S.C. § 271(a).

22. The Accused Instrumentalities infringe claim 1 of the '888 Patent. They are a communications apparatus, comprising: a facsimile component configured to generate facsimile information by scanning an image from a hard copy of a document (*i.e.*, the fax portion scans hard copies of documents); a user interface configured to receive an e-mail address from a user (*i.e.*, a touch pad or keypad); a facsimile-to-e-mail gateway comprising a facsimile-to-e-mail component configured to—in a first mode, convert the facsimile information into a computer readable image file (*e.g.*, a PDF, TIFF, JPEG file), attach the computer readable image file to an e-mail message, and transmit the e-mail message without additional user input to the received e-mail address, wherein the e-mail address is received in and interpreted from alphanumeric form (*e.g.*, the PDF, TIFF, JPEG file is attached to the email and sent to the email address entered); and in a second mode, transmit a facsimile device compatible file to a remote facsimile device (*i.e.*, a facsimile transmission); and a housing configured to carry the user interface. *See* Ex. D-1, Figs. 1-9.

23. The Accused Instrumentalities infringe claim 2 of the '888 Patent. They meet the limitations of claim 1, and further includes a facsimile component configured to transmit facsimile information over a first communications network (*e.g.*, a phone network) and an facsimile-to-email component configured to transmit e-mail messages over a second communications network (*e.g.*, a computer network). *See Id.*



24. The Accused Instrumentalities infringe claim 3 of the '888 Patent. They meet the limitations of claim 1, and further use a first network in the form of a telephone network and a packet switch network, e.g., a computer network such as a TCP/IP network. *See Id.*

25. The Accused Instrumentalities infringe claim 4 of the '888 Patent. They meet the limitations of claim 1 and include a second mode configured to receive data signals via the TCIP/IP network, e.g., receipt acknowledgement packets. *See Id.*

26. The Accused Instrumentalities infringe claim 5 of the '888 Patent. They meet the limitations of claim 1, and further include a facsimile-to-email component configured to transmit the file over the second network. *See Id.*

27. The Accused Instrumentalities infringe claim 7 of the '888 Patent. They meet the limitations of claim 1, and further, comprise a multi-function peripheral (e.g., a multi-function printer, scanner, copier, fax). *See Id.*

28. The Accused Instrumentalities infringe claim 8 of the '888 Patent. They meet the limitations of claim 1, and further include an alphanumeric keypad or touchscreen interface.

29. The Accused Instrumentalities infringe claim 9 of the '888 Patent. The Accused Instrumentalities attach a TIFF format image file to an e-mail. *See Id.*

30. As a result of Defendant's infringement of the '888 Patent, OpenPrint has suffered monetary damages and is entitled to a money judgment in an amount adequate to compensate for Defendant's infringement, but in no event less than a reasonable royalty for the use made of the invention by Defendant, together with interest and costs as fixed by the court.

**COUNT V**  
**INDUCED INFRINGEMENT**

31. Upon information and belief, Defendant has been and is now inducing the infringement by its resellers and end-use customers of claims 1, 2, 3, and 4 of the '906 Patent in

the State of New Jersey, in this Judicial District, and elsewhere in the United States, by, among other things, directly or through intermediaries, making, using, importing, selling and/or offering for sale the Accused Instrumentalities to the injury of OpenPrint. Defendant's resellers and end-use customers are directly infringing, literally infringing, and/or infringing the '906 Patent under the doctrine of equivalents. Defendant is thus liable for infringement of the '906 Patent pursuant to 35 U.S.C. § 271(b).

32. As shown above, Defendant has and continues to indirectly infringe the '906 Patent by inducing the infringement by its end-users and resellers of claims 1, 2, 3, and 4 of the '906 Patent in accordance with 35 U.S.C. 271(b).

33. As shown above, Defendant, its resellers, distributors, and end-users of the Accused Instrumentalities have engaged in and currently engage in activities that constitute direct infringement of claims 1, 2, 3, and 4 of the '906 Patent.

34. As shown above, the operation and use of the Accused Instrumentalities by Defendant, its resellers, or end-user customers constitutes a direct infringement of claims 1, 2, 3, and 4 of the '906 Patent.

35. Defendant's affirmative act of selling and/or offering for sale the Accused Instrumentalities and providing instruction manuals, advertisement of the infringing features, and support for the Accused Instrumentalities has induced and continues to induce Defendant's resellers and end users to use the Accused Instrumentalities in their normal and customary way to infringe claims 1, 2, 3, and 4 of the '906 Patent.

36. Through its making, selling, and/or offering for sale the Accused Instrumentalities, Defendant specifically intends that its resellers and end-users directly infringe claims 1, 2, 3, and 4 of the '906 Patent since the filing of the this complaint and actually induces others, such as

resellers and end-use customers, to directly infringe by using, selling, supplying, and or distributing the Accused Instrumentalities within the United States. Defendant is aware since at least the filing of this complaint that such actions would induce actual infringement. Furthermore, Defendant remains aware that these normal and customary activities would infringe the claims of the '906 Patent.

37. For example, in connection with the sale and/or offering for sale of the Accused Instrumentalities Defendant provides manuals and support to resellers and end-use customers regarding the use and operation of the Accused Instrumentalities. Specifically, Defendant provides manuals and support, *see e.g.*, [http://support.brother.com/g/s/id/html/doc/mfc/cv\\_mfcl6750dw/use/manual/index.html#GUID-1B05FE4E-F3FD-4757-BF19-3D123ABA80E3\\_267](http://support.brother.com/g/s/id/html/doc/mfc/cv_mfcl6750dw/use/manual/index.html#GUID-1B05FE4E-F3FD-4757-BF19-3D123ABA80E3_267).

When end-users follow such instructions and support, they directly infringe the '906 Patent. Defendant knew or should have known that by providing such instructions and support, resellers and end-use customers follow these instructions and support and directly infringe the '906 Patent.

38. Accordingly, Defendant has performed and continues to perform acts that constitute indirect infringement, and would induce actual infringement, with the knowledge of the '906 Patent and with the knowledge or willful blindness to the fact that the induced acts would constitute infringement.

#### **JURY DEMAND**

OpenPrint hereby requests a trial by jury on all issues so triable by right.

#### **PRAYER FOR RELIEF**

OpenPrint requests that the Court find in their favor and against Defendant, and that the Court grant OpenPrint the following relief:

- a. Judgment that one or more claims of the Asserted Patents have been infringed, either literally and/or under the doctrine of equivalents, by Defendant;
- b. Judgment that Defendant accounts for and pay to OpenPrint all damages and costs incurred by OpenPrint, caused by Defendant's infringing activities and other conduct complained of herein;
- c. That OpenPrint be granted pre-judgment and post-judgment interest on the damages caused by Defendant's infringing activities and other conduct complained of herein;
- d. That this Court declare this an exceptional case and award OpenPrint reasonable attorneys' fees and costs in accordance with 35 U.S.C. § 285; and
- e. That OpenPrint be granted such other and further relief as the Court may deem just and proper under the circumstances.

April 30, 2018

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